

International report - Supreme Court overturns IP court decision declaring second medical use patent null and void

21
OCT 15

Gün + Partners - Turkey

The Supreme Court recently issued its first decision on the patentability of second medical use claims in Turkey, marking a milestone for patent holders.

In 2014 the Istanbul IP Court held that the second medical use claims granted by the European Patent Office (EPO) under the European Patent Convention (EPC) 1973 (ie, before the EPC 2000 entered into force) were null and void, as the legal grounds to support such claims were introduced to the EPC only in new Article 54(4) of the EPC 2000 (for further details please see "[IP court finds second medical use claims to be medical treatment methods](#)").

The patent holder immediately appealed to the Supreme Court, which overruled the decision of the first-instance court.

The Supreme Court's reasoning marks a milestone in Turkish patent law as it removes the ambiguity surrounding the legitimacy of second medical use patents following the Istanbul IP Court's decision and upholds the legitimacy of such patents under Turkish patent law.

The Supreme Court acknowledged that there was no explicit provision for second medical use in the EPC 1973 and that this was first introduced to the EPC in 2007. However, second medical use claims were protected as per Decision G05/83 of the EPO Enlarged Board of Appeal.

The Supreme Court held that the dispute centred on an invalidity argument which had to be evaluated as per Article 129 of the Patent Decree-Law. Therefore, the Supreme Court focused on the decree-law and stated that the decree-law has not been amended since the

GÜN+PARTNERS



**Selin Sinem
Erciyas**



**Aysel
Korkmaz**

EPC (1973 and 2000) became effective in Turkey. In this respect, the patentability requirements and non-patentable inventions defined in the decree-law have remained the same and are still the same today.

Further, the Supreme Court stated that as there was no specific provision relating to the patentability of second medical use claims when the patent was granted, the validity of the patent should be evaluated according to the general requirements of novelty, inventive step and industrial applicability. Accordingly, the first-instance court should have evaluated whether the patent in question had novelty over the prior art, irrespective of whether it was a second medical use patent.

The Supreme Court emphasised that Turkish law does not exclude second medical use patents from patentability. It ruled that there is no difference between the EPC 1973 and the EPC 2000 in terms of second medical use patentability, thereby essentially allowing second medical use patents granted before the entry into force of the EPC 2000.

Finally, the Supreme Court stated that in cases where the dispute is in a technical field, the IP court must conduct a court expert examination. In the case at hand, the IP court should not have ruled on whether the subject matter of the patent was a medical treatment method or a process for manufacturing a pharmaceutical product, but rather should have deferred to an expert panel.

The case will now be returned to the Istanbul IP Court. The IP courts usually follow Supreme Court rulings. If this happens in the case at hand, the first-instance court will conduct a court expert examination on the case and defer to the expert panel's evaluation of patentability. However, given the IP court's earlier ruling, it may decide to rule against the Supreme Court's decision, which could lead to a further appeal.

For further information please contact:

Selin Sinem Erciyas

Gün + Partners

www.gun.av.tr

Email: selin.yalincakli@gun.av.tr

Tel: +90 212 354 00 00