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TURKEY: ARTICLE 138/3 OF EPC APPLIES DURING PENDING PROCEEDINGS

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As Turkey is a member of EPC, any provision of the EPC has the power of national law and can be directly applicable for European patents validated in Turkey. However as is well known, the EPC does not have many provisions binding the national courts. One of them is Article 138/3 which gives the European patent owner the right to limit the patent in the event of an invalidation action and orders the national court to take the limited version of the patent as the basis of invalidation proceedings.

This provision is inconsistent with the national patent law of Turkey. National law permits any kind of amendment in the patent document only during the proceedings before the Turkish Patent and Trademark Office (TPTO) and explicitly forbids any amendment – including limitation – after grant of the patent.

Therefore, the IP courts and the TPTO have rejected applying Article 138/3 in national invalidity proceedings until now. However very recently one of the IP courts in Istanbul applied Article 138/3 and accepted claim limitation in the national proceedings.

The invalidation action was filed right after the first grant decision set by the EPO; however the EPO continued with opposition and then appeal proceedings which are still pending. The patent was maintained on the basis of an auxiliary request, which limits the scope of the patent. However as an appeal is continuing the limitation has not been published in the official bulletin yet and therefore the limitation could not be validated in Turkey.

The patent owner first requested the court to wait for the outcome of the EPO proceedings and not to render a final decision until the end of the EPO proceedings. However although the Opposition Division (OD) maintained the patent on the basis of the auxiliary request the patent holder was of the opinion that the first granted claim set does meet the patentability criteria, and he also applied to appeal with other opponents.

Since the IP Court decided not to wait for the EPO proceedings and decided to render its final decision, as a last attempt to save the patent, the patent owner filed an application for the limitation of the claim set under Article 138/3 of the EPC. Limitation was based on the claim as allowed by the OD.

Surprisingly but fairly the Court and the TPTO accepted the claim limitation request of the patent holder. It was important to emphasise to the court that the claim set has become identical with the limited set of claims before the EPO.

This may lead us to a new era where there is parallelism between EPC and Turkish patent legislation and also the procedures to obtain a patent will complete each other resulting in consistency between the claims of Turkish and referred European patent.

The recent decision of the IP Court and TPTO may also reduce the number of invalidation cases and save patent holders in the same situation from the invalidation of their patents by limiting the claims of the patent before EPO proceedings were resulted or more importantly after EPO proceedings were already finalised.



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