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generic', and one that therefore effectively adds nothing. He, however, did not feel that the third hurdle had been overcome. In other words, NWU had not established that the registration **propuk.co.za** was abusive in the hands of the registrant. The mere fact that the registrant must have known of the university's rights to the name PUK was not determinative.

There were a number of factors that influenced the adjudicator. One was the fact that the domain name was being used in a non-commercial manner. Another was the fact that the objective was not to disrupt the business of the university in any way, but

rather to protect the Afrikaans language on the campus. A third was the fact that there was unlikely to be confusion, because it was quite clear from the site that it was not an official university site, but rather the site of a group of alumni concerned about the status of the Afrikaans language at the university. A final factor mentioned by the adjudicator was that international domain name cases tend to lean in favour of allowing the use of trade marks as part of domain names for the purposes of criticism, provided that 'the use is fair and non-commercial'.

This is a rare, interesting example of how politics and IP can overlap.

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# Interpretation of force of EPC and institutions of EPO by Turkish IP courts

**T**he European Patent Convention (EPC) is a part of Turkish national domestic law and is enforced in Turkey under Article 90 of the Turkish Constitution. Furthermore, it was formed under international agreement and as a result cannot be claimed as unconstitutional.

The EPC law can be applied directly in Turkey and therefore it is legally binding. Alongside other member states, Turkey also declared and signed the EPC and as such recognises the competence and the decisions of the institutions which have been introduced in the convention. It is assumed that the member states are not able to declare their commitment for certain bodies of the European Patent Office (EPO), such as decisions only made by the examination division or appeal board. This may seem an unusual statement, however, it should be stressed as it is one of the most important proceedings in Turkey, it has been argued by IP courts that EPO decisions are only binding for Turkey if the decision can be grounded on an explicit provision in the EPC.

However, in some situations IP courts interpret the EPC in such a way that renders it ineffective. For example, in an invalidation

action filed against a European patent, the IP court did not conduct any examination on patentability requirements and decided that this patent is null and void as the independent claim is a second medical use claim, however, the patent was granted before EPC 2000 revisions, that is, before Article 54/4 and 54/5 on second medical use claims were introduced in the EPC.

Since it is known as a party to the EPC, Turkey transfers its authority on patentability examination and grant decisions of the European patent applications to the EPO. Accordingly, European patents granted by the examination division of the EPO enter into the national phase before the Turkish Patent Institute (TPI). Furthermore, with regard to the filing of the Turkish translation of the official bulletin, the European patent is granted by the TPI as a final granted national patent.

However, the European patent, validated and granted in Turkey via this route, is situated somewhere in between the EPC and Turkish national law due to the differences between two systems. Unfortunately the interpretation of the IP courts cannot be used to help a European patent to be in a more justified position.



The main reason for this is that Turkish patent law introduces a pre-grant opposition system and therefore it does not allow any amendment of the patent after the grant decision has been made, with the exception of material mistakes made in the patent. Whereas the opposition procedure starts after the grant decision before the EPO and the opportunity is given to amend/limit the European patent during this period.

As an international agreement, the EPC is applied with priority in Turkey and therefore the European patent is allowed to make amendments/limitations due to the amendments carried out before the EPO, although the same right is not given for national applications. This exists as a form of conflict in the system however the outcome of this is mostly experienced in invalidation actions which are filed against European patents validated in Turkey.

According to Turkish Law, only a patent that is ultimately granted can be subject to an invalidation action. In other words, patent applications are not considered as concluded and therefore they cannot be subject to an invalidation action. Our interpretation is that the legislator has hereby foreseen the effects of the 'pre-grant' opposition system in Turkish Law and the possibility to amend the patent until the final grant decision is made. This would result in uncertainties emerging in the scope of protection of the patent in the case of a court action, which means an invalidation action is filed against a pending application.

On the other hand, the European patents which were granted in Turkey right after the first grant decision of the EPO become immediately subject to invalidation actions. This is because although first grant decisions made by the EPO seem to be final, the final scope of protection is still not determined due to the ongoing opposition/appeal procedure that takes place before they reach the EPO.

In these actions, the European patent holder refers the ongoing procedure before the EPO and demands for the delay of the invalidation proceedings. However, in most cases such a demand is rejected, without considering what will happen if the patent is maintained in an amended form by the EPO after the national court orders for invalidation of the Turkish validation of the same patent. We are of the opinion that the patent maintained before the EPO is entitled to be re-validated in Turkey which therefore means that the IP court trial on the ex-version

of the patent will be entirely useless. The same would apply if the patent is revoked by the EPO before the national invalidation action is concluded.

In a similar case where the European patent was prematurely made subject to an invalidation action, the Supreme Court finally considered our arguments and overruled the court of first instance decision on the grounds that the Court should have asked the TPI whether a European patent subject to an invalidity action in Turkey should be deemed in the application stage or granted status if the opposition/appeal procedure before the EPO is still ongoing at the date of the action.

The court of first instance has not set a decision on this yet, however the matter has been discussed at an international conference in Istanbul by one of the most experienced IP court judges. Upon query whether it is necessary for the judge to consult this matter with the TPI as ordered in the Supreme Court decision, the judge stated that he can decide about this issue by himself and moreover he is of the opinion that European patents which are under the EPO process should not be made subject to invalidity actions. In other words, the conclusion of the EPO process should be awaited with regards to these actions.

However, the same judge stated that the decision to wait for the conclusion of the EPO procedure may prove problematic due to the lengthy opposition and appeal processes which, in some cases, can take between four and six years. A very important comment made by the judge was on the balance provided in the German system for such situations. Since there is not a 'bifurcated' system in Turkey unlike in Germany, delaying the invalidation action may provide the patent holder with an unfair advantage since the same patent can be enforced against third parties in the form of a finally granted patent.

Although there may be timing issues in applying the EPO decision or delaying a national decision on a European patent until the EPO's final decision, the IP courts and the Supreme Court is of the same opinion that the EPO is the decision maker regarding the European patents and the decision of the EPO is binding for Turkey.

This clearance is nonetheless vital and should be emphasised; however, this point of view is not adopted by one of the IP judges in Istanbul in relation with the decisions of the EPO EBoA and the European patents granted by the EPO in light of the case law of EBoA.

This particular IP court judge ruled on an infringement action depending on a second medical use claim of a European patent that this European patent granted before EPC 2000 amendments has ‘Swiss-type’ claims and therefore it is essentially related to a medical treatment method, and methods for treatment are not patentable inventions according to Article 52(4) of EPC 1973, however, the EPO had granted patents to such medical treatment methods relying on G5/83 decision of EBoA, established by by-passing the provisions of the EPC. According to the court decision, ‘even if Turkey was a party to EPC, EBoA decisions were not binding for Turkey’. Therefore the European patent in question was considered to be related to a ‘medical treatment method’ and should be declared null and void in Turkey.

The IP court evaluated that paragraphs 4 and 5, brought to Article 54, with EPC 2000 revisions, constituted an exception to Article 52(4) of EPC 1973 and opined that only after the EPC 2000 revisions had it become possible to protect such ‘medical treatment methods’ with a patent.

At this point, it is beneficial to mention that the same point of view has not been adopted by the other IP judges or by the Supreme Court in Turkey. In fact the reasoning of the Supreme Court is a milestone in Turkish patent law as it bars the legal ambiguity about legitimacy of the second medical use patents and acknowledges the legitimacy of such patents in Turkish patent law.

A rather noteworthy interpretation in the IP court decision was related to the legitimacy of the European patents granted due to case law of EBoA. The IP court is of the opinion that Turkey is only bound with the EPC not with the EBoA. EBoA decisions are binding on BoA, which hears appeal proceedings and BoA decisions are binding on the department, whose decision is appealed. As long as the facts, constituting grounds for decision are the same, a dissenting decision may only be given by providing grounds. In this respect, it cannot be said that the decision of an EPO examination and/or opposition division, which resulted with the grant of a patent in line with EBoA decision, was from a

lack of legal basis and therefore the patent in question was null and void.

On the other hand, the EBoA case law on second medical use claims clearly has its grounds in the EPC of 1973. This was also touched upon in the Supreme Court’s decision. The Supreme Court acknowledged that there was no explicit provision for second medical use in EPC 1973 and it was first introduced to EPC in 2007. However, second medical use claims were protected as per G05/83 of EBoA.

The Supreme Court, very cleverly, argued that the root of the issue was that it was an invalidity argument in dispute and it needed to be evaluated as per Article 129 of the Patent Decree Law in Turkey. Therefore, the Supreme Court focused on the provisions of the Decree Law and noted that the Decree Law has not been amended during EPC 1973 and EPC 2000. In this respect the patentability requirements and non-patentable inventions defined in Decree Law have not been changed and remain the same today.

Finally, the Supreme Court stated that as there was no explicit provision at the date of grant of the patent in discussion related with the patentability of the second medical use claims, the validity of the patent should be evaluated as per usual to general requirements of novelty, inventive step and industrial applicability. In accordance with this, the first instance court should have evaluated if the patent in question possesses novelty over prior art irrespective of whether it is a second medical use patent or not.

The Supreme Court has apparently emphasised that Turkish law does not exclude second medical use patents from patentability. In fact, it remarkably ruled that there was no actual difference between the EPC 1973 and 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.

Although there appears to be a discrepancy in interpretation of the force of the EPC by different IP courts, our experience indicates that mostly by help of Supreme Court’s ruling, the EPC still very much holds an international position and maintains power over national law.