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Turkey: A Battle to Benefit from EPC 138/3

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The IP Law of Turkey prohibits any kind of amendment/limitation of claims or patent documents after the patent has been granted. The only exceptions to this rule are the amendment/limitations made by the patentee during the national post-grant opposition phase, which was introduced to Turkish law in 2017.

As per the introduction of a national post-grant opposition procedure, the Law also prohibits any ruling to be made in a revocation action against a national patent, while the post-grant opposition phase is ongoing before the Turkish Patent and Trademark Office (“TPTO”). However, the IP Law allows revocation actions to be heard and ruled against national validation of European patents, while post-grant oppositions or appeal phases are ongoing before the European Patent Office (“EPO”). Likewise, the local court is not obliged to deem the EPO proceedings as a prejudicial matter and this is entirely at the discretion of the judge.

In practice, some IP Courts consider the ongoing opposition or appeal process before the EPO as a prejudicial matter in view of the principle of procedural economy. This principle is one of the principles that dominates civil proceedings and is regulated under Article 30 of the Code of Civil Procedures (“CCP”). Based on this principle national proceedings are delayed in order not to undertake unnecessary investigations, as the patent may be revoked by the EPO.

On the other hand, some IP Courts consider that EPO proceedings may take too much time, and they may decide not to delay revocation proceedings in order to avoid a serious loss of rights of the plaintiff.

In cases where the IP Court refuses to delay revocation proceedings, the patentee may consider limitation of claims in order to survive from a revocation action, which is not possible for national patents granted upon national applications or PCT applications. However, for European patents validated in Turkey, the patentee may - in principle - benefit from EPC 138/3, which orders the national courts to take limited claims into consideration for ongoing national revocation actions.

EPC 138/3 is a well thought-out provision, which also aims to prevent a rush revocation of a European patent at the national level; whereas, it could be kept valid before the EPO after claim limitations in the opposition or appeal procedures.

However, until recently, most of the Turkish IP Courts have refused to apply EPC 138/3 in the revocation actions against European patents, and did not allow the patentee to limit the claims in view of the national law provision that “a national patent cannot be amended after a grant decision.” The IP Courts refrained from explicitly refusing to apply EPC 138/3 in a Turkish procedure. They based their decisions on the fact that the IP Courts are bound by the set of claims that are granted before the TPTO, while the TPTO did not accept any claim limitation on a European patent before such limitation was published in the official EPO Bulletin and a Turkish translation was filed before the TPTO.

In a recent revocation action filed against the Turkish validation of a European patent, the patentee filed an Auxiliary request with a limited set of claims in the also pending EPO proceedings. As the Court could not be convinced to delay the revocation proceedings until the end of the EPO proceedings, and did not allow the patentee to amend the claims by limitation as per EPC 138/3, another way had to be found to benefit from EPC 138/3. It was decided to inform the TPTO of the limited set of claims filed before the EPO, and requested the TPTO to limit the Turkish claims in the same way as they were asked to be limited before the EPO, without awaiting a final decision publication of the EPO.

It is important to note that at the filing date of this request before the TPTO, the revocation action had completed the first expert examination phase, and the court experts opined that the patent was invalid as per the granted (not limited) claim set.

Interestingly, the TPTO accepted the request on the claim limitation by applying EPC 138/3, and sent the limited claim set to the IP court, informing the Court of the current scope of the claims. Based on the information given by the TPTO, the court agreed to take the limited set of claims into consideration for the rest of the revocation action, and referred the case to a new court expert panel to have the limited set of claims examined in view of the nullity allegations made by the plaintiff.

Although, both the EPC and national IP Law allow limitation of claims for revocation action purposes, the patentee practically battled to win this result. The approach of the TPTO and the decision of the court is important for any European patent owner who may fight against a revocation action in Turkey, and who may need to benefit from the EPC 138/3.

Disclaimer: Gün + Partners represented the patentee in this case.

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