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**PATENT PARTIAL INVALIDATION DECISIONS HAVING EFFECTS DIFFERENT FROM  
THE INTENDED ONES AND RESULTING LEGAL UNCERTAINTY IN THE TURKISH  
PATENT AND JUDICIAL PRACTICE**

As is known, the Decree-Law No. 551 on patents and utility models does not provide for opposition. Therefore the nationally filed patents/utility models are not subject to opposition whereas European patents extended to Turkey may be opposed before the European Patent Office.

On the other hand the Decree-Law No. 551 provides for a total or partial invalidation of the patent/utility model by court decision. The problem lies principally at this level because the Turkish patent and judicial practice do not foresee and organize the amendment of the claim(s) in the course of a court action with the involvement/decision of the judge.

Partial invalidation upon a court decision is effected by simply excluding the concerned claim(s) from the set of claims without any amendments. The resulting claim(s) may be totally meaningless and practically unenforceable especially when the main or independent claim(s) is/are invalidated leaving some of the dependent claim(s) valid. In such a scenario the patent would remain partially valid but practically without effect for the simple reason that the remaining (dependent) claims are hardly understandable and applicable without the main/independent claim of which they were dependent.

As a result even if the court decided to invalidate the patent partially, the remaining valid (dependant) claim(s) of the patent may not be effectively enforceable.

In case, the remaining valid (dependant) claim(s) are understandable/applicable then they will have to be enforced only as of the features they cover without being limited with the features of the invalidated main/independent claim of which they were dependant. In such case, the rule that the (dependant) claim(s) is also to contain all the features of the main/dependant claim would not be respected, thus rendering the patent enforceable for a wider coverage than the originally granted claim(s).

Enforcing the remaining valid (dependant) claim(s) as of the feature(s) they cover, without the feature(s) of the invalidated main/independent claim will extend the scope of the (dependant) claim(s), which is exactly the contrary of the intended effect. In other words, under such a scenario, the relation between the main/independent claim and the dependant claim(s) existing in the granted (original) version of the patent will be corrupted.

In either case, the effects of the decision will be different from and beyond the effects intended by the court. It has to be acknowledged that such a situation constitutes a basic cause of legal uncertainty.

An analysis of the decision No. 2006/686 E., 2010/200 K. of the Istanbul 3<sup>rd</sup> Civil Court of Intellectual and Industrial Rights reveals such legal uncertainty in a concrete way. In this decision which was upheld by the Supreme Court and has become finalized the utility model no. TR 2004/02462 Y was partially invalidated by cancelling/excluding claims 1 and 3 whereas the invalidation request for claims 2 and 4 was rejected. The claims of the utility model no. TR 2004/02462 Y subject to this decision are as follows:

**Claim 1:** Our invention, i.e. Unilateral Panel consists of three main parts that are joined together. **(invalidated)**

**Claim 2:** Invention as stated in Claim1, characterized in that there is an involuted portion in the top and middle sections of the upper main part.

**Claim 3:** Invention as stated in Claim 1, characterized in that there is a lower part that enables the panel to remain standing and maintain balance. **(invalidated)**

**Claim 4:** Invention as stated in Claim 1, characterized in that there is a part (11) that bends forward in order keep the two flanks still.

With regard to the maintained claims 2 and 4, it will be possible to assume that all utility model applications or actual uses that involve “an involuted portion in the top and middle sections of the upper main part” or “a part (11) that bends forward in order keep the two flanks still” infringe the utility model no. TR 2004/02462 Y according to Decree-Law No. 551.

The litigation becomes trickier and subject to increased uncertainty when we have a corresponding European patent and a court action is initiated against the nationally filed corresponding Turkish

application. In case an opposition is lodged against the European patent application and the claim(s) are amended as a result, it is anybody's guess how the claim amendment(s) of the corresponding European patent could be reflected to the nationally filed patent in Turkey through the ongoing court action necessitating the initiative of the judge.

The situation is likewise subject to uncertainty when the protection of a European patent is requested in Turkey and when a litigation is initiated in this country before the European patent opposition procedure is concluded. The amendment of claim(s) effected during the European patent opposition procedure should be extended to Turkey through the Turkish Patent Institute before they are brought to the Turkish court.

In such a situation, a court action in Turkey having been instituted on the basis of the originally granted claim(s) can be negatively impacted by the later restricted claim(s) amended during the European patent opposition procedure. Namely, the practice of our courts to maintain or invalidate the concerned claim(s) in their entirety constitutes a major shortcoming in terms of the protection scope of patents and legal certainty.

The legal uncertainty resulting from the above outlined scenarios is self-explanatory. The draft law which contains also provisions on patent protection and expected to be enacted does not include any detailed provisions to clarify this matter. Accordingly, it is of utmost importance that the draft expected to be enacted also covers this matter in order to overcome the aforementioned uncertainty to the extent possible.

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