

## 1. INVENTIVE STEP

### **a. Decree-Law No.551 Pertaining To The Protection Of Patent Rights**

#### **Article 9 Surpassing the State-of-the-Art (involving inventive level/step):**

An invention shall be deemed to surpass the State-of-the-Art (to involve inventive activity/step) when it is the result of an activity which is not obviously realizable from the State-of-the-Art, by a person skilled in the concerned technical field.

#### **Article 7 Novelty:**

Any invention which is not part of/comprised in the State-of-the-Art shall be deemed to be novel.

**The State-of-the-Art shall be held to comprise information/data pertaining to the subject matter of the invention, accessible to the public in any part of the world, before the date of filing of the application for patent by disclosure whether in writing, or orally, by use or in any other way.**

Patent and Utility Model applications filed in Turkey prior to the date of filing of the application for patent and published on or after that date are considered to be comprised in the State-of-the-Art as of their first disclosed contents/texts.

### **b. Draft Guidelines for Patent Examination Procedure of the Turkish Patent Institute (TPI)**

Inventive step has a key role particularly while drafting the examination report. An invention that is patentable – besides the criterion of novelty as priority – has to contain an inventive step. An invention shall have an inventive step if it is not obvious for the person skilled in the art, considering the state of the art. (Article 9 of the Decree-Law 551). In other words, if the invention has emerged as a result of an activity that is not obvious to a person skilled in the art, it is deemed to have an inventive step.

Patent and utility model applications filed in Turkey prior to the date of filing of the application for patent and published on or after that date are considered to be comprised in the State-of-the-Art as of their first disclosed contents/texts. Such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step.

Above all, the patent examiner must determine the information that is accessible to the public and therefore to the person skilled in the art, before the priority date of the application. In the assessment whether the subject matter is obvious to the average person skilled in the art, the state of the art on that date and the expertise of the person skilled in the art shall be considered.

If the document on the state of the art is in another technical field, it is doubtful whether the person skilled in the art has this information. This is generally encountered in the neighbouring technical fields. Moreover, it should be kept in mind that a group consisting of persons skilled in different arts may be assumed as person skilled in the art, as well.

The decision whether there is an inventive step or not is taken in the circumstances of each case. Decision should be taken considering the elements such as “technical teaching claiming protection”, “state of the art” and “person skilled in the relevant art”.

For instance; the points such as, an important improvement in the development, overcoming the technical prejudices, the studies of experts that proved no results, meeting a long lasting need, production of a basic need product for simple and low costs or reducing the production costs, may be the indications of an inventive step. These indications of inventive step should be taken into account when determining the inventive step. These subjects should be mentioned in the drafting of grounds for objection. Should these matters not pointed out, important deficiencies may occur.

The claim should always be examined as a whole. That is, in the examination of the inventive step, each characteristic constituting the claim shall not be examined separately, but the claim is taken as a whole.

In the examination of the inventive step of an invention that contains both technical and non-technical characteristics (i.e. rules of calculation, mental activities); entire subject matter (including non-technical characters, since they may have a contribution to a common technical effect) should be examined.

Non-technical characteristics that do not have a technical relation and do not even indirectly contribute to the main lines of the technical characteristics of the invention that claims protection, shall not be taken into account in the examination of the inventive step.

**i) The definition of a person skilled in the art:**

Section 5.3.1.2.3. Person Skilled in the Art:

The person skilled in the art that will compare the invention claiming for protection and the state of the art related to the invention shall be deemed to be capable of comprehending all the claims and all present information in the field (patent, patent applications, documents and all other relevant data, teachings open to public, use of public etc.). The person skilled in the art in question shall be assumed to have the general knowledge on the related technical field and an average skill. The person skilled in the art may have different points of view on the problem and difficulties in the relevant technical field since he is not an inactive person in the related technical field, like a scientist, judge or patent examiner. The person skilled in the art shall deal with the problems to be solved rather than the inventor and what the inventor says. For instance, if the invention is a shampoo, the person skilled in the art shall be a chemist not a barber.

A group consisting of person skilled in different arts may be assessed as the person skilled in the art. This is generally the case when a person skilled averagely in an art needs the support of another person skilled averagely in another art. Medical technologies (such as X-ray devices) that need the physics knowledge and medicine together maybe given as example. The expected competence from the person skilled in the art shall be generally specified depending on the problem to be solved (“What kind of persons

skilled in the art would be interested in the problems the invention finds an objective solution for”). In accordance the traders, engineers, scientists from technical high schools or universities that have been educated in the related field, have a general knowledge and years of experience may be within this scope.

**ii) methodologies employed for evaluating the inventive step:**

Section 5.3.1.2.5. Inventive Step:

In order to examine the inventive step in an objective and predictable way **“problem and solution approach”** should be applied. It should be exceptional not to apply this approach.

There are three main steps in the problem and solution approach:

- 1) specification of “closest state of the art”,
- 2) specification of “objective technical problem” that is to be solved, and
- 3) determining whether the subject matter is obvious to the person skilled in the art, starting from the closest state of the art and objective technical problem.

Patent examiner should keep in mind that he already knows about the invention, while examining the obviousness of the invention on the filing or priority date. An ex post facto approach shall not be appropriate in the examination.

**iii) having regard to the prior art, the level of inventiveness (obviousness) to meet the inventive step requirement:**

An invention shall have an inventive step if it is not obvious for the person skilled in the art, considering the state of the art. (Article 9 of the Decree-Law 551). In other words, if the invention has emerged as a result of an activity that is not obvious to a person skilled in the art, it is deemed to have an inventive step. The decision whether there is an inventive step or not is taken in the circumstances of each case. Decision should be taken considering the elements such as “technical teaching claiming protection”, “state of the art” and “person skilled in the relevant art”.

**c. Court Decisions:**

Although, there is no definitely established test or examination method regarding the evaluation of inventive step in Turkish jurisdiction accepted by the Supreme Court, as a member of EPC, the so-called "problem-and-solution approach" is predominantly accepted in order to assess inventive step in an objective and predictable manner. "problem-and-solution approach" is applied by specialized IP courts throughout Turkey in many decisions which are approved by 11th Civil Chamber of the Supreme Court. For example, the decision in which the "problem-and-solution approach" is applied by Istanbul 4<sup>th</sup> Civil Court of Intellectual and Industrial Property Rights is approved by 11th Civil Chamber of the Supreme Court's decision dated 15.12.2011, No 2009/15129 E., 2011/17113 K. However, the "problem-and-solution approach" is not a legal necessity.

## **2. SUFFICIENCY OF DISCLOSURE**

### **a. Decree-Law No.551 Pertaining To The Protection Of Patent Rights**

#### **Article 43(2) Fixing the Date of Application:**

Where during the examination of the application for patent, the subject matter of the invention for which patent is requested is amended/changed, whether in whole or in part, **so as to expand out of the contents of the application as initially filed** the date of application shall be deemed to be the date when the petition for such amendment/change is filed.

#### **Article 46(1) Explicitness of the Description:**

The description must be written in a sufficiently explicit and comprehensive manner so as to enable a person skilled in the technical field of the subject matter to implement the invention.

#### **Article 47(2) Patent Claims**

The claim(s) shall define the elements of the invention for which protection is sought. Each claim shall be explicit and concise to the point. The claim(s) shall be based on the application. The claim(s) may not extend beyond the subject matter of the invention as specified in the description. The claim(s) shall be written/prepared in compliance with the provisions of the Regulation.

#### **Article 64(3) Amendment of Claims:**

The scope of the application may not be widened through the amendments in the claim(s).

#### **Article 83(1) Scope of Protection Conferred by an Application for Patent or a Patent and the Interpretation of Claim(s):**

The scope of protection conferred by an application for patent or a patent shall be determined according to the claim(s). Claims shall be interpreted in consideration of the description and drawings.

#### **Article 129(1) Invalidity:**

A patent shall be declared invalid by the court in following situations :

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- b) where evidence is brought in that the subject matter of the invention has not been described in a sufficiently explicit and comprehensive manner so as to enable a person skilled in the concerned technical field to implement same;
- c) where evidence is brought in that the subject matter of the patent exceeds the scope of the application or is based on a divisional application filed in compliance with Article 45 or on an application filed in compliance with Article 12 and exceeds the scope of same;

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## **b. Draft Guidelines for Patent Examination Procedure of the TPI**

### **i) enabling disclosure requirement:**

#### Section 5.3.1.1. Disclosure of the Invention:

Pursuant to Article 46 of the Decree Law, the application shall be written explicitly and completely, which would provide the person skilled in the art to apply. Invention (technical teaching) can be described in any part of the application documents, apart from the abstract that exclusively provides information to the public Article 48 of the Decree Law).

If the person skilled in the art can apply the technical teaching that comprises the invention in practice, the invention has been clearly and explicitly defined.

It is sufficient that only the definitive framework is described in a manner that to allow the person skilled in the art to work with his own methods. Thus it shall not be necessary to explain the invention with all the technical details. However, the generalizations should not be as general as just defining the problem and the expected result. The purpose here is to prevent the possibility of an obstacle in the technical developments since if the generalisation covers all the methods and tools to reach the same result that the later registered industrial property rights the results would be that way. Furthermore in such a case, the scope and legal absoluteness of the Industrial Property Rights shall not be clear.

The advantageousness, usefulness or profitableness of an element in the description compared to other solutions shall have no relevance to the sufficient explanation. To emphasize or underline a feature or a technical teaching in particular, for instance submitting a structuring or an example of a subject matter of an invention or stating that it would be more advantageous, useful or preferable, shall make it more comprehensible that this feature or technical teaching is a part of the invention. However, not to make size emphasizes shall not exclude these kind of definitions.

All the content of the first documents should be evaluated from the point of view of the person skilled in the art who examines the patentability.

The information submitted to the examiner should be examined in an objective and direct manner. Furthermore, the person skilled in the art should not appreciate the documents not only in the way they are drafted but also take into account the purpose of the invention and the recommended results in a manner to consider the disadvantageous in the state of the art.

### **ii) support requirement:**

#### Section 2.1.1. Filing Date:

The filing date shall be deemed to be the date on which the amendments are submitted to the Institute, in case there are amendments during the examination, which are out of the scope of the application.

If there is deficiency in the drawings mentioned in the description or claims, or a later amendment/addition is done, an amendment that is out of the scope of the initial application is done in the additional drawing (for instance, if some elements are submitted in the later drawing pages that are not explained/presented in the drawing pages in the initial application) it shall be deemed that the scope of application is surpassed.

Section 2.2.1. Examination of the elements of the Application and subject Matter of the Invention

It shall not be possible to complete the missing elements of the application later (even by changing the filing date. For instance the application shall be refused if the drawings referred to in the description and claims are not submitted during the initial application. It shall not be possible to proceed with the application through omitting the references to the drawings from the description or the claims. The application shall not be refused if there is missing drawing pages that are referred to in the description or claims during the application, it shall be evaluated during the formal deficiency examination. In case new drawing pages are added, if there is an amendment done in the drawings that would go beyond the scope of the initial application (for instance, if there are elements that are not presented/explained in the drawing pages of the initial application), the proceedings shall continue with the new filing date, which would be the filing date of the redrafted drawing pages in consideration that the scope of application is surpassed.

Section 5.3.2. Amendments in Documents:

Descriptions may be amended according to the decision of granting the patent, without any expansion of the scope. Only the amendments in obvious deficiencies, eliminating the deficiencies the examiner has found and amendments in the claims shall be accepted.

**iii) written description requirement:**

Section 5.3.1.1. Disclosure of the Invention

Pursuant to Article 46 of the Decree Law, the application shall be written explicitly and completely, which would provide the person skilled in the art to apply. Invention (technical teaching) can be described in any part of the application documents, apart from the abstract that exclusively provides information to the public Article 48 of the Decree Law).