

In accordance with the decision of the Standing Committee on the Law of Patents (SCP), at its twenty-ninth session from December 3 to 6, 2018, (document SCP/29/7, paragraph 22), Turkey kindly submit following additional inputs to the International Bureau of the WIPO:

(ii) a further study on inventive step (part 3), giving a particular attention to the topics suggested in paragraph 8 of Annex to document SCP/24/3 (proposal by Spain), in particular , assessment of inventive step in the chemical sector:

The TURKPATENT Patent Examination Guidelines gives following instructions on the practice and procedure to be followed in the topics suggested in paragraph 8 of Annex to document SCP/24/3, in particular, assessment of inventive step in the chemical sector:

Common general knowledge: Its combination with the State of the Art;

The person skilled in the art should be presumed to be a hypothetical person having ordinary skill in the art and being aware of what was common general knowledge in the art at the relevant date. It is presumed that the person skilled in the art is possessed the ability to understand the subject matter of invention, everything disclosed in the prior art (patents, patent applications, documents and also other facts trainings available to the public, public use, etc.), the claims in which the protection is defined. The person skilled in the art is presumed to be an ordinary practitioner in the relevant field of technology, who is being aware of disclosures in the patent document and the disclosure in the references cited in this document. This skilled person has knowledge, experience, capacity regarding the means which are normally used in the routine work and experimental knowledge for the field of technology in question. There may be instances where it is more appropriate to think in terms of a group of persons, for example, a research or production team, than a single person. General knowledge of the person skilled in the art comprises the knowledge available in the hand books, guides and text books basically used in the relevant field of technology.

Common general knowledge of the person skilled in the art, comprises knowledge which may be disclosed in basic references such as the text books or hand books which are commonly accepted in the relevant field of technology. There is no precise line in determining the general knowledge of the person skilled in the art and is evaluated according to the characteristics of the subject matter concerned. Generally, if a technical information is disclosed, for example, in a patent document or a technical journal, it cannot be said that this information is the general knowledge of the person skilled in the art. However, in some special cases, the information described in the technical journal may also be considered as common general knowledge (For the details Turkpatent Patent Examination Guidelines refers to "Guidelines for Examination in the EPO, Part G - Chapter VII-2, 3.1 Common general knowledge of the skilled person")

- **Combination: juxtaposition vs synergic effects;**

When examining inventive step of the subject of the invention which carry both technical and non-technical properties (e.g. calculation rules, mental activities), the entire subject of the invention should be examined (since it may contribute to a common technical impact, non-technical features are also be included). Non-technical properties, which do not have any technical connection and do not contribute to the outlines of the technical aspects of the subject matter, are not taken into consideration when examining the inventive step.

- **The danger of hindsight analysis;**

When assessing whether the invention is obvious or not at the date of application or priority date, patent examiner should bear in mind that the invention is already within its knowledge. While evaluating, the approach of “ex post facto” is not appropriate.

- **Secondary indicia;**

For example; issues such as achieving significant breakthrough in development, overcoming technical prejudices, remain inconclusive studies of experts, meeting a long-term need, producing basic needs product at a simple and low cost or reducing production costs etc. can be indicators of the inventive step. The indicators of this inventive step must be taken into consideration when deciding on the inventive step. These points should be addressed during the preparation of grounds for appeal. If these points are not be interested, significant shortcomings can be encountered in the examination process

- **Selection inventions;**

Inventions selection of a narrow range from a broader range (For the details TURKPATENT Patent Examination Guidelines refers to PCT International Search and Preliminary Examination Guidelines, 12.10 and EPO Guidelines for Examination Part G – Chapter VI – 8.)

Inventions which are selection of individual elements, sub-sets, or sub-ranges, which have not been explicitly mentioned, within a larger known set or range are called as “Selection inventions”. Such kind of inventions are especially common in chemical literature. There are different cases in the assessment of novelty of such inventions.

- i. In determining the novelty of a selection, it has to be decided, whether the selected elements are disclosed in an individualised (concrete) form in the prior art. A selection from a single list of specifically disclosed elements does not confer novelty (the "single-list principle"). However, if a selection from two or more lists of a certain length has to be made in order to arrive at a specific combination of features then the resulting combination of features, not specifically disclosed in the prior art, confers novelty (the "two-lists principle"). Examples of such selections from two or more lists are the selection of:
 - a) individual chemical compounds from a known generic formula whereby the compound selected results from the selection of specific substituents from two or more "lists" of substituents given in the known generic formula. The same applies to specific mixtures resulting from the selection of individual components from lists of components making up the prior art mixture;
 - b) starting materials for the manufacture of a final product;
 - c) sub-ranges of several parameters from corresponding known ranges.
- ii. A sub-range selected from a broader numerical range of the prior art is considered novel, if each of the following three criteria is satisfied:
 - a) the selected sub-range is narrow compared to the known range;
 - b) the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end-points of the known range;
 - c) the selected range is not an arbitrary specimen of the prior art, i.e. not a mere embodiment of the prior art, but another invention (purposive selection, new technical teaching).

An effect occurring only in the claimed sub-range cannot in itself confer novelty on that sub-range. In order to confirm the criterion of novelty is met, it is required that, such a technical effect occurring in the selected sub-range, but not in the whole of the known range.

- **Problem invention;**
- **The assessment of inventive step in the chemical sector (Markush claims, enantiomers. etc.).**

The current TURKPATENT Patent Examination Guidelines has no specific reference to the topics; “Problem invention” and “The assessment of inventive step in the chemical sector”. However, as a national office of the member state of the European Patent Convention (EPC), TURKPATENT follows the practices of European Patent Office (EPO) and adopts the similar approaches in the assessment of whole patentability criteria, including the inventive step. TURKPATENT Search & Examination Guideline is revised and updated according to i) change in the regulations and laws, ii) previous year’s quality check results, iii) decisions of the internal discussion platform of the TURKPATENT and decisions of the courts. Within the scope of the regular revision procedure of Patent Examination Guidelines, inclusion of these topics to the Guidelines would be considered.