Turkey
Turquie
Türkei

Report Q209

in the name of the Turkish Group
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Selection Inventions – the Inventive Step Requirement, other Patentability Criteria and Scope of Protection

Questions

General

Groups are asked to give a summary of the legal position as regards a patent for a purported selection invention in their jurisdiction in relation to the following:

1) *Legal developments on selection inventions*

What specific types of inventions are recognized under the concept of selection invention and are patentable in your jurisdiction? Do you have any examples of selection inventions in a field other than chemical, pharmaceutical or material science fields?

There is no specific referral to selection inventions in the Turkish patent law DL 551, its regulations or the case law. However, Turkey is a member state to the EPC (European Patent Convention) since Nov. 2000 and already ratified EPC2000. In principle, articles from the EPC supersede corresponding articles of the national law, should any conflict arise. As a consequence of eight years of implementation, there is no litigation about selection inventions in Turkey yet. All the following questions are replied in this respect.

All applications, that cover selections from prior art, no matter which field they belong to, are examined according to the selection invention criteria of EPO Examination guidelines.

2) *Novelty*

Groups are asked to discuss any issues that should be considered with respect to the novelty of selection inventions. For example, is merely carving a range out of a broad prior art disclosure sufficient to make a selection invention novel? Is a different advantage or use, or the same advantage with an unpredictable improvement required for a selection invention to be novel?

There is no specific referral to the novelty requirements of selection inventions in the Turkish patent law DL 551. Nevertheless, it is believed that EPO Guidelines for selection inventions clearly define novelty aspect of the same. These inventions shall be considered novel if

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 sub-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).

3) *Inventive step or non-obviousness*

Groups are asked to discuss the inventive step or non-obviousness requirements in their jurisdiction. If experimental data is used to back up the inventive step or non-obviousness requirement can it be submitted after initial patent filing? Are there any prerequisites or limitations on the late submission of data?

There is no specific referral to non-obviousness of selection inventions in the Turkish patent law DL 551, its regulations or the case law. In general, if the selection is connected to a particular technical effect, and if no hints exist leading the skilled person to the selection, then an inventive step is accepted (this technical effect occurring within the selected range may also be the same effect as attained with the broader known range, but to an unexpected degree). If experimental data is used to back up the inventive step requirement, it shall be submitted at initial filing. Late submission of data may be allowed only for experimental data that might be required by the Examiner.

4) *Sufficiency and/or written description requirements*

Groups are asked to discuss the sufficiency or written description requirements in their jurisdiction. There may be several aspects to this question:

1) *the threshold for sufficiency;*
2) *the allowable timing for submission of experimental data;*
3) *the time frame within which sufficiency or written description requirements must be satisfied; and*
4) *the breadth of claim scope that can be supported by a limited number of examples of asserted or proven advantages.*

With respect to item 1), please discuss to what extent all members of the class selected by the patentee are required to possess the requisite advantage in your jurisdiction. Is there an absolute requirement that all of the selected class possess the relevant advantage, or is the patentee excused if one or two examples fall short? Also, with respect to item 4) above, if a new utility is asserted as a selection invention, would it suffice to claim a particular range or selection of components which have been found to be associated with such a new utility or would it be necessary to recite such a new utility in the claims?

There are neither explicit provisions in Turkish Patent Law nor the case law concerning the sufficiency or written description requirements in selection inventions.

5) *Infringement*

If a certain advantage or superior results were the reasons for the grant of a patent on a selection invention, does such advantage or superior result have to be implicitly or explicitly utilised by a third party for an infringement to be established?

If a selection invention is claimed as a new use, what are the requirements to establish infringement? Would a manufacturer of a product that may be used for the new use infringe the patent? Does the intention of an alleged infringer play any role in the determination of infringement?

There is no specific referral to the patentability or infringement requirements of selection inventions in the Turkish patent law DL 551. However, selection patents are dealt in the same way with other patents.

If such advantages or superior results are explicitly utilized by a third party, then infringement shall be established. While infringement alleges shall be dealt with in a case-by-case basis,

even an implicit referral to said advantages or superior results may also lead to establishment of infringement.

In particular, if such selection pertains to a new use of a particular selection of broader range of materials (e.g. compounds), any party manufacturing said product shall not be immediately rendered as an infringer as long as said manufacturer, does not indicate -implicitly or explicitly- an intention or does not offer a benefit in the same way as the advantages or superior results mentioned in the selection patent. The intention or offer is likely to be sought in e.g. instructions on packaging of the product, prospectus, user manual, commercials etc.

In case the selection relates to a method, and more specifically a parameter (e.g. temperature, pressure etc.) implemented in such method, alleged infringers intention is sought whether he has purposively selected the range or he has unavoidably and/or unintentionally selected such sub-range in his process. If the selection is unavoidably used, this might lead to revocation of the selection patent due to the "one way street" (so called bonus effect) situation, which renders the selection invention not involving inventive step. On the other hand, if such selection is purposive, infringement shall be established against the user of said selection.

6) Policy

Groups are asked to give a short commentary as to the policy that lies behind the law on selection inventions in their jurisdictions, and then to consider whether or not such policy considerations are still valid today as technology continues to advance.

There is no policy that could be mentioned for selection inventions in the Turkish patent law DL 551.

7) Novelty

In example 1 would the prior disclosure of the compounds containing the generic class of radicals anticipate any claim to a specific compound having a particular radical, or group of specific compounds having a selection of particular radicals in your jurisdiction? In the analysis, does it matter how wide the prior disclosed generic class of compounds is – i.e. would the analysis be different if the prior disclosed generic class consisted of 1,000,000 possible compounds (very few of which were specifically disclosed) as opposed to merely, say, 10?

In the view of the absence of any legal ground within the Turkish patent law DL 551, or any jurisprudence or doctrinal opinion in this regard, the question of whether general prior disclosure of a class of radicals would be regarded as a specific disclosure is to be decided by the Courts. In this regard, although, the Court might be willing to take into consideration EP Law as well as its jurisprudence, it is nevertheless not bound by EP decisions. On the other hand, the question of wideness of the prior disclosed generic class will be analyzed in view of the EP Law and jurisprudence as well.

8) Inventive step or non-obviousness

In example 2 would any of the three possibilities constitute an inventive step over the prior art in your jurisdiction? Further, if, say, scenario (iii) does constitute an inventive step over the prior art, what scope of protection should the inventor be able to obtain? Should the inventor be able to obtain protection for the products per se (that happen to have this advantageous property), or should any patent protection available be limited to the use of the products for the advantageous property (as an adhesive) not possessed by, and not obvious over the prior art?

Among the three possibilities;

i) would not be considered as constituting an inventive step

ii) would not be considered as constituting an inventive step

iii) would be considered as constituting an inventive step as there are no implicit or explicit indications or additional justifiable data which would lead the person skilled in the art to the advantageous property.

Scenario (iii) does constitute an inventive step over the prior art, however the inventor shall not be able to obtain protection for the products per se. The protection shall be limited to the use of the products for the advantageous property (i.e. as an adhesive) not possessed by, and not obvious over the prior art.

9) Sufficiency and/or written description requirements

To what extent are all members of the class selected by the patentee required to possess the requisite advantage in your jurisdiction? Is there an absolute requirement that all of the selected class possess the relevant advantage, or is the patentee excused if one or two examples fall short?

There is no specific referral to such an issue in the case law.

10) Infringement

By reference to example 3 to what extent is evidence of the knowledge of the advantageous property of the selection, or intention of the infringer as to its supply, required to find infringement in your jurisdiction?

The compound itself mentioned in example 3 is selected from a generic list of compounds and found to be useful as an adhesive as a new use. A juridical prosecution shall most likely seek for evidence proving that the alleged infringer addresses the compound's use as an adhesive or an additional ingredient used widely for preparation of adhesives. Such evidence may be any indication such as instructions on packaging of the product, catalogues or any public disclosure such as commercials or prospectus. Jurisdiction shall be of the opinion that product is directed to a use for utilizing the alleged advantages of the claimed selection and establish the infringement against that manufacturer.

On the other hand, commercial activities of the purchaser mentioned above may also be subject to establishment of infringement even though said purchaser is not the manufacturer of the compound. The preconditions for the manufacturer, such as evidence for intention of using said compound as an adhesive, shall apply mutatis mutandis to the purchaser for establishing infringement judicium under Art. 136(b) of the DL 551 which reads:

Art. 136. The following acts shall be considered infringement of rights conferred by a/ Patent...

b/ Selling, distributing or commercializing in any other way, or importing for such purposes of products or keeping them in possession for commercial purposes or using by applying such products, manufactured as a result of an infringement, where the person concerned knows or should know that such products are imitations in whole or, in part..

11) Policy

Groups are asked to consider, in respect of example 1 / 2, whether it matters how much effort the inventor has invested in arriving at his selection in order to found a valid selection patent. The answer to this question is closely related to the policy considerations that underpin the grant of selection patents and the incentive / reward equation involved. The inventor may have expended considerable time and money in trawling through the whole host of possible compounds encompassed by the prior disclosed generic class, and the particular selection that he has made may constitute a leap-forward in the field. Surely the inventor should be

rewarded for his efforts and obtain protection? On the other hand, it could be argued that such considerations may have been relevant in an age when the inventor's efforts actually involved many man-years of careful and painstaking laboratory work, but are now increasingly irrelevant in an age of combinatorial synthesis when large varieties of different compounds can be manufactured in a fraction of the time. Are such considerations relevant?

While there is no specific reference or otherwise referral to selection inventions in the Turkish patent law DL 551, it is believed that how much effort the inventor has spent shall be irrelevant in terms of patentability. Criteria on patentability of inventions have been well defined in the law and no such exclusion or privilege shall be granted to selection inventions. The Patent Office or the Courts shall consider experimental data sufficient to prove inventiveness of subject matter rather than considering the efforts, time or money spent by the inventor.

Harmonisation

12) *Groups are asked to analyse what should be the harmonised standards for the patentability of selection inventions. In particular, the items discussed in Q1-Q6 and the examples discussed in Q7-Q10 above should be referred to.*

With regards to the patentability of selection inventions, Turkish group is of the opinion that selected sub-range should be sufficiently narrow compared to the known range and be sufficiently far removed from any specific examples disclosed in the prior art and also from the end-points of the known range. The selection shall be a purposive selection.

13) *Groups are also asked to recommend any issues for harmonisation not referred to in Q11 above.*

While patentability of selection inventions is subject to special terms, conditions for establishing infringement to selection patents shall be clearly mentioned in respective laws.

14) *Groups are asked to outline any other potential issues that merit discussion within AIPPI as regards selection inventions.*

N/A.

Summary

There is no specific referral to selection inventions in the Turkish patent law DL 551, its regulations or the case law. On the other hand, Turkey is a member state to the European Patent Convention. Hence, the European practice applies at least for patents that enter through EPC in terms of patentability of selection inventions. For granted patents on selection inventions, the protection shall be limited to the new use of the products for the advantageous property not possessed by, and not obvious over the prior art. On the other hand, it is further believed that criteria on patentability of inventions have been well defined in the law and no privilege shall be granted to selection inventions. A Patent Office or a Court shall consider experimental data sufficient to prove inventiveness of subject matter rather than considering the efforts, time or money spent by the inventor. Finally, while patentability of selection inventions is subject to special terms, it is believed that conditions for establishing infringement to selection patents shall also be clearly mentioned in respective laws.

Résumé

Il n'y a pas référence spécifique aux inventions de sélection dans la loi turque sur les brevets DL 551, ses règlements ou la jurisprudence. D'autre part, la Turquie est un Etat membre de la Convention sur le Brevet Européen. D'où, la pratique européenne s'applique au moins pour les brevets d'invention

qui entrent par le biais de la CBE en terme de brevetabilité des inventions de sélection. Pour les brevets d'invention accordés sur les inventions de sélection, la protection sera limitée à la nouvelle utilisation des produits pour la propriété avantageuse non possédée par, et non évidente par rapport à l'art antérieur. D'autre part, on pense que les critères sur la brevetabilité des inventions ont été bien définis dans la loi et aucun privilège ne sera accordé aux inventions de sélection. Un Office des Brevets ou une Cour considéreront des données expérimentales suffisantes pour prouver le niveau inventif du sujet plutôt que considérer les efforts, le temps ou l'argent dépensé par l'inventeur. Finalement, tandis que la brevetabilité des inventions de sélection est soumise à des termes spéciaux, on pense que les conditions pour établir une violation des brevets de sélection seront également clairement spécifiées dans les lois respectives.

Zusammenfassung

Im Türkischen Patentrecht (DL 551), den bezüglichen Verordnungen bzw. der bisherigen Rechtsprechung gibt es keine spezielle Bezugnahme auf Auswahlerfindungen. Andererseits ist die Türkei aber ein Mitgliedstaat des Europäischen Patentübereinkommens. Daher wird bezüglich der Patentierbarkeit von Auswahlerfindungen, zumindest bei auf Grund des EPÜ eingereichten Patenten, die europäische Praxis angewandt. Bei auf Auswahlerfindungen erteilten Patenten sollte sich der Schutz auf die, im vorliegenden Stand der Technik nicht vorhandene und nicht im vorliegenden Stand der Technik als vorteilhafte Eigenschaft offensichtliche, neue Verwendung der Produkte beschränken. Weiterhin wird die Ansicht vertreten, dass die Kriterien bezüglich der Patentierbarkeit der Erfindungen im Gesetz deutlich definiert werden müssen und dabei den Auswahlerfindungen keinerlei Privilegien gewährt werden darf. Ein Patentamt oder ein Gericht hat nicht die vom Erfinder aufgewendete Arbeit, Zeit und Geld zu berücksichtigen, sondern sollte vielmehr das auf Versuchen aufgebaute Datenmaterial zum Beweis der Erfingungshöhe des Gegenstandes der Erfindung zur Kenntnis nehmen. Trotz der Tatsache dass die Patentierbarkeit der Auswahlerfindungen besonderen Bedingungen unterliegt, wird schliesslich der Standpunkt verteten, dass die Gegebenheiten einer Verletzung einer Auswahlerfindung offen und deutlich in den bezüglichen Gesetzen niedergeschrieben werden sollen.