

Question Q213

National Group: Turkish National Group

Title: **The person skilled in the art in the context of the inventive step requirement in patent law**

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Date: March 8, 2010

Questions

The suggested questions will try to analyze and to understand the definition of the “person skilled in the art” in three steps: the notion of the “person”, the issue of its personal “skills” and finally the “technical field” in which these skills are exercised.

- 1) The study proposed by AIPPI starts with the consideration of the person as one of the elements of the definition of the person skilled in the art. The Groups are therefore requested to indicate if the person skilled in the art is one, or more, person. If a skilled person is a team of people, then are the team members all the same or may they be different in their various attributes, specifically if such a team may comprise persons from various disciplines or having different levels of qualifications?

The person skilled in the art and/or his/her qualifications are not defined in Decree Law No. 551 pertaining to the protection of patent rights in Turkey or in the Implementing Regulations. There are no court decisions in Turkey providing a definition of the person skilled in the art, either. The person skilled in the art has been briefly discussed in the Turkish doctrine. Accordingly, the questions have not been answered according to how the person skilled in the art is perceived in Turkish Patent Law, the answers here rather represent the Turkish Group's opinion as to how the relative issue should be regarded in Turkish Patent Law.

The person skilled in the art, who functions as a reference to ascertain whether an invention involves an inventive step, is generally considered to have ordinary skills and knowledge in a certain technical field. On the other hand, there is no strict definition for ordinary skills nor a norm for the skilled person's level of ability/qualifications, which rather relates to the nature and complexity of the relative technical field. The level of ability/qualifications of skilled person in a complex technological field will be different from the level of ability/qualifications in a simpler technological field.

Accordingly, the person skilled in the art may be one, or more, person, depending on the relevant technical field. If the invention involves several technologies or if the invention belongs to an advanced technical field, the person skilled in the art may consist of a team of various specialists/experts, such as a research or production

group, from different technical fields. When a skilled person is considered to be team of people, specialists/experts from different technical fields may naturally have differing levels of ability/qualifications, as explained above, depending on the complexity of the field of technology that the specialist/expert belongs.

- 2) Is the skilled person a real person (or team of persons) or a hypothetical person?
The skilled person is a hypothetical person as shaped in a patent application examiner's or a court appointed expert's mind to ascertain if an invention involves an inventive step. He/she is assumed to possess certain attributes/capacities/skills (which will be further discussed hereunder) at the time of fulfilling this duty.
- 3) The person skilled in the art has to be analyzed in the frame of her/his personal capacities and attributes.

At first, it is necessary to know whether and if so to which extent this person has reasoning and/or creative capacities or if he/she has merely the capacity to perform or execute the orders or instructions from other people.

The person skilled in the art does not merely have the capacity to perform or execute the orders or instructions from other people but has also reasoning capacities. However it is almost sure that the person skilled in the art has no creative capacity since otherwise said person could take a further step and create or invent, which is not the case since he or she then will fall within the definition of the inventor.

Another point that can be discussed is whether the personal attributes of the person skilled in the art are the same also for other circumstances in which the person skilled in the art may have a role, such as construction of the patent or for the consideration of the sufficiency of the disclosure in the specification, even if this last point goes beyond the scope of the present study.

The personal attributes of the person skilled in the art should be the same for other circumstances like for the consideration of the sufficiency of the disclosure in the specification

Finally, the question that can be discussed is the issue of knowing if the personal attributes of the person skilled in the art are the same for different IP rights covering technical creations, like patents or utility models, species, etc., if they exist in the national law.

The Decree Law No. 551 pertaining to the protection of patent rights in Turkey does not require an inventive step for utility models and therefore there is no personal attributes of the person skilled in the art. However this may change with the new law since the draft requires a certain degree of inventive step for utility models.

The personal attributes of the person skilled in the art are unfortunately not precised in the present national law either. Nevertheless a definition can be found in the leading motives of the draft law, namely in Art. 9 concerning inventive step which reads: "What is meant with the specialist in the technical field in this Article is a careful practitioner who has general knowledge in the relevant technical field and who can reach everything in the state of the art, who has a capacity to make routine searches and practices but who has no ability to make inventions.

- 4) Another important aspect of the question is to know what are the personal skills of the "person skilled in the art"?

At least, two important issues deserve to be analyzed:

- What is the level of the qualification or skills of the person?

In principle, the skilled person being an ordinary practitioner in the relevant technical field should not be limited to access information. This skilled person must not be presumed to have inventive ability, but he/she is expected to be capable of finding a reasonable connection between information of all prior art references and the

technical problem posed by the respective invention. The skilled person should not be a scientist oriented to perform studies to make scientific discoveries, which would inevitably raise the level of inventive step requirement, which would in turn not encourage inventors who should not be rewarded by patents, otherwise. However, the level of skills of such person should not be lower than some extent that would give rise to unreasonable increase in the number of patents, which would increase the likelihood of legal disputes.

The group takes the view that what makes the skills of such person ordinary, should not be deemed to be invariable and can be applicable to every circumstance with the same rationale as practiced in certain instances. The level of ordinary skills of a person skilled in the art may be expected, as we believe, to be relatively higher for some advanced technical fields than that of fields to have been acquainted in some certain sense.

- And what are the nature and the scope of his/her knowledge?

The second issue encompasses more precisely the question of the capacity to understand and to analyze the documents which are accessible to the person skilled in the art, this capacity being called “the general knowledge” and concerns the proof of the content of the “general knowledge”:

a) what is the scope of such knowledge in general terms?

Nature of general knowledge of a skilled person should be expected to base on experience of a practitioner and/or general technical training of such person in the relevant field. General knowledge that the skilled person should have may be a combination of knowledge of reference books, technical publications, patents or information that may even not be available in printed form. As indicated above, the group is of the opinion that the skilled person should not be limited to access the relevant information. This hypothetical and “superior” ability of the skilled person allows him/her to access all available information, on the other hand he/she does not have an inventive capacity.

b) is such knowledge limited to the general technical training of such person?

Knowledge acquired by technical training is significant, and it may even be so critical in some certain instances, in identifying the level of skills of such person. Having technical training should not be a pre-requisite qualifying such person to be skilled. Indeed, some technical solutions may be of a kind that should by no means require technical training of a skilled person.

c) to what extent is information in documents – articles or prior patents - considered to be included as part of such working knowledge?

As pointed out in foregoing section, a person skilled in the art should not be limited in accessing all information available in the relevant art. Therefore, information in articles or prior patents should be included as part of such knowledge. What the group believes is essential in this respect that whether a skilled person having “ordinary” skills is able to sufficiently understand the content of such knowledge. This latter issue should necessitate a well-established case law, which is available neither before the administrative nor legal authorities under the local jurisdiction.

d) can such knowledge include information which the person may not have memorized, but can readily look up?

The person skilled in the art is a hypothetical person and having extraordinary capabilities in accessing information. If for some reason this hypothetical person cannot memorize the relevant information, there should be no restriction to readily look such information up from other information sources.

- 5) The question of the person skilled in the art raises also the problem of the moment of the evaluation of those skills: should they be all evaluated at the moment of the appreciation of the validity of the patent, i.e. at the moment of the priority date, or could they be evaluated also at the date when the patent is assessed by the Judge, for example in the infringement proceedings, where the validity can be debated jointly with the infringement claim? This may conduct to the differences of appreciation in case the notion of the equivalence is used in relation to the prior art.

When the validity of the patent is evaluated for example in the infringement proceedings, the person skilled in the art should be considered to be a hypothetical person at the moment of the priority date since otherwise something which did not exist at the priority date will be taken as equivalent and secondly an evaluation at the date when the patent is assessed by the Judge will lead to an ex-post analysis concerning the inventive step.

- 6) The next issue related to the definition to the person skilled in the art is the technical domain or "the art" in which his or her skills are performed.

The first sub-question is to know if those skills are concentrated in one or several technical fields.

The skills of the person skilled in the art are concentrated in one or several technical fields, depending on the case. If the case is simple, the skills of the person skilled in the art may be considered to be concentrated in one technical field, and if the case is complicated, the skills may be concentrated in several technical fields.

And the second one is related to the way the frontiers between different technical fields can be established: how this determination is assessed by the Judges or Patent Offices?

In patent litigation cases, if appointed, the team of experts is considered to presume the place of the person skilled in the art. The team is appointed by the Judge and usually is comprised of 3 people; one person with a patent background (a patent attorney or a patent official), one practitioner from the related technical field and one academic person from the related technical field. The Judges dictate who should be in the team of experts and the issue that should be discussed by the team of experts.

- 7) The question is also to know what is the nature of his/her competence in the technical field and particularly if this competence theoretical or practical?

The skilled person is expected to have both practical and theoretical competence. We may not impart a generalization as to which competence should prevail, since the nature of the instance may require the skilled person to have relatively much theoretical competence in comparison with the practical.

- 8) The Groups are requested to indicate how in practice the assessment of the skills of the person skilled in the art is operated. What is the role of the opinion of the experts on this point?

The skills of a skilled person are presumed to change according to the complexity of the case as explained above. Accordingly, the skills may be in accordance with the International Patent Classification Code of the relevant patent application. As the experts are appointed by the Judge, they do not have much say in the assessment of the skills of the person skilled in the art. On the other hand, an appointed expert may decline providing this service, claiming that he/she lacks the necessary skills.

- 9) Finally, the Groups are also invited to present all other questions which may appear in the context of the question of the person skilled in the art.

5) Future harmonization:

After assessing the national solutions, the Groups are invited to present their proposals for the possible harmonization and specifically the harmonized definition of the person skilled in the art. The object of this section is not to repeat all the questions related to the current statute of the national law, but to find the most fundamental points on which the international harmonization could be sought.

- 1) Specifically, the Groups are invited to precise on which points they see the particular need of the international harmonization on the issue of the person skilled in the art.

The Turkish Group sees particular need of the international harmonization on the skills/the capacities of the skilled person in the art. Considering that the person skilled in the art functions as a reference to ascertain whether an invention involves an inventive step, the capacities/skills attributed to the skilled person will unavoidably affect the results of the inventive step test applied to a patent application. This point becomes quite important in the filing of national applications, which are examined separately in each and every country where the application is filed. If the skills of a skilled person is considered to be more extensive (may be even to the point of having an inventive ability) in a certain country compared to other countries, then the scope of the patent granted in that country (if a patent is granted at all) will be much more limited compared to the patents granted in other countries. This will result in patents with different scopes under the same patent family.

- 2) The Groups may indicate if the “person skilled in the art” standard should be assessed as a hypothetical model or on the contrary appreciated *in concreto*?

The Turkish Group is of the opinion that the “person skilled in the art” standard should be assessed as a hypothetical model, as the person skilled in the art is presumed to have access to and understand all available information, however has no inventive capacity.

- 3) Should the skills of the “person skilled in the art” be only to execute other person orders or should they be creative and both practical and theoretical?

The person skilled in the art does not have inventive skills. This model person should not however be presumed to merely execute orders of other persons. Indeed, skills of such person should allow him/her to be “practically creative”, which may enable the skilled person to make “technical improvements”, but not inventions. This reasoning should suggest that the skilled person not be “theoretically creative”.

- 4) Should the art in which the skilled person intervene be of only one discipline, or should it cover several technical fields?

The art in which the skilled person intervene should be one or several technical fields depending on the complexity of the case.

- 5) The Groups are also invited to present all other suggestions which may appear in the context of the possible international harmonization of the definition of the person skilled in the art.

Note: It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.

SUMMARY

Current Decree Law or the case law does not specify the qualifications, skills or personal attributes that a skilled person should have within the context and the assessment of inventive step requirement. The group, therefore, believes that a skilled person should be a hypothetical person having access to all available information, but having no inventive capacity. Depending on the circumstances of the case, the person skilled in the art may well be a team of people having differing levels of ability/qualifications, rather than a single person. Likewise, skills of the person skilled in the art should be expected to be concentrated on several technical fields as the case may require.

RESUME

Les qualifications, les compétences ou les attributs personnels que l'homme du métier doit posséder dans le contexte de l'activité inventive requise et lors de sa détermination ne sont précisés ni dans la législation actuellement en vigueur ni dans les normes casuistiques. Donc, le groupe est d'avis que l'homme du métier doit être une personne hypothétique ayant les moyens d'accès à toutes les informations disponibles, mais par contre n'ayant aucune capacité inventive. Suivant le cas, plutôt que d'être une seule personne, l'homme du métier pourrait être une équipe d'hommes du métier ayant des niveaux d'habiletés ou de qualifications différents. De même, suivant le cas, il faudrait s'attendre à ce que les compétences de l'homme du métier soient concentrées sur plusieurs disciplines techniques.

ZUSAMMENFASSUNG

Die Qualifikationen, die Fähigkeiten oder persönlichen Eigenschaften, die ein Fachmann im Rahmen und in der Bewertung der erfinderischen Tätigkeit voraussetzen sollte, sind im aktuell geltenden Recht oder in der Rechtsprechung nicht definiert. Darum ist die Gruppe der Auffassung, dass ein Fachmann eine hypothetische Person sein sollte, die Zugriff auf alle verfügbaren Informationen hat, aber keine innovativen Fähigkeiten besitzt. Nach den Umständen des Falles kann, statt des einzelnen Fachmanns, eine Gruppe von Personen mit unterschiedlich ausgebauten Fähigkeiten/Qualifikationen benötigt werden. Ebenso, könnte man erwarten, dass die Fähigkeiten des Fachmannes, je nach Fall, auf mehrere technische Bereiche konzentriert seien.