Question Q229

National Group: Turkish

Title: **The use of prosecution history in post-grant patent proceedings**

Contributors: Neşe DUYGU, Ayşe I. ERDEM, Gaye RAMAZANOGLU, Barış ATALAY, Güler A. DALMA, Selda ARKAN, Mine MANAP, Kerim YARDIMCI, Ayşe U. ERSONMEZ, Deniz COKICLI, Ekrem SOYLU

Reporter within Working Committee: **Kerim YARDIMCI**

Date: **09.03.2012**

Questions

The Groups are invited to answer the following questions under their national laws.

1) What types of post-grant proceedings are available in your jurisdiction? Are post-grant proceedings available both at a patent office and at a court?

   According to the Turkish Decree Law No. 551, Pertaining to the Protection of Patents (hereinafter referred as “DL 551”), the post-grant proceedings are not available before the Turkish Patent Institute (hereinafter referred as “TPI"). In the current status, infringement, invalidity cases are prosecuted before the court as the post-grant proceedings. However, the opposition proceedings are expected to come into force before the TPI by the proposed amendments in our legislation.

2) In your country or region, may the prosecution history be taken into account for purposes of interpreting claim scope during post-grant proceedings?

   Yes.

   The DL No.551 pertaining to the protection of patent rights, section five, Art.83 concerning scope of protection conferred by an application for patent or a patent and the interpretation of claim(s) paragraph 7 reads: In determining the extent of protection, due account shall be taken of any statement made by the applicant during the patent granting procedure or by the holder of the patent during the term of validity of the patent.

   There is no case law with regard to specific application of DL 551, Art. 83 paragraph 7 and there are post-grant challenges throughout Turkey and the information is not centralized (and mainly not public, thus only the concerned parties know the result). Therefore, the information about the judge approach to prosecution history is very limited. The patent file is convened before the court and the judge considers it.

If the answer to question 2 is yes, please answer the following questions:

a) Please explain the types of prosecution history that may be considered. For example:

i. Does applicable prosecution history include amendments, arguments, or both?

Both the arguments and amendments could be included in the applicable prosecution history.

ii. Could applicable prosecution history include a limiting interpretation that is *implied* through the applicant's arguments, or would it include only *explicit* definitional statements?

Only explicit statements are included. There is no case law implicit statements.

iii. Does applicable prosecution history include only amendments to the claims, or does it also include amendments to any aspect of the disclosure?

All the amendments including to the claims and to the disclosure could be included in the applicable prosecution history.

iv. Does it matter if the amendments and/or arguments are made to overcome prior art versus being made to address sufficiency or some other formal requirement?

Although not certain; Turkish Group believes that it does not matter if the amendments and/or arguments are made to overcome prior art versus being made to address sufficiency or some other formal requirement. Furthermore, there is no case law indicating this approach.

v. Does it matter if the prosecution history has the effect of broadening the interpretation of the claim, versus narrowing it?

In the motives of the DL 551, for the Article 83/7 it is defined that in determining the extent of protection, due account shall be taken of any statement made for the limiting of the claim(s) by the applicant during the patent granting procedure or by the holder of the patent during the term of validity of the patent.

b) Does the applicability of prosecution history depend on when the prosecution history occurred? For example, does it matter if a particular statement by an applicant was made during initial examination as opposed to during a later invalidity proceeding?

In Turkey invalidation action can only be instituted at the authorized courts. Therefore only the statements done during the entire prosecution before the relevant patent office can be taken into consideration.

c) Does the applicability of prosecution history depend on the type of post grant proceeding, or on the authority before which the proceeding is held? For

example, would prosecution history be more applicable in an infringement action at court than in a post-grant patent office invalidity proceeding?

The post grant procedures cannot be held at the patent office in Turkey therefore the applicability of prosecution history does not depend on the authority.

According to DL 551 Art.83/7, applicant's statements made during the patent grant procedure or during the term of validity are determinant to decide the scope of the claim. Therefore prosecution history can be used in the infringement actions held at the court.

Invalidation actions can also only be instituted at the courts. There is no limitation for the use of prosecution history in the invalidation actions.

d) Is the applicability of prosecution history limited to infringement proceedings where equivalents are an issue?

There is no limitation in DL 551 and there is no case law on the issue as to the applicability of prosecution history being limited to infringement proceedings where equivalents are an issue.

e) Could prosecution history from a corresponding foreign application be considered in a post-grant proceeding in your jurisdiction? If so, under what circumstances?

There is no statute or case law permitting/enabling the use of the prosecution history from a corresponding foreign application.

f) Is the use of prosecution history authorized by statute or by case law in your jurisdiction?

The use of prosecution history is authorized by statute according to Art.83/7 of DL 551.

g) Explain the policy reasons for considering prosecution history during the claim interpretation process.

In the motives of the DL 551, for the Art.83/7 it is defined that in determining the extent of protection, due account shall be taken of any statement made for the limiting of the claim(s) by the applicant during the patent granting procedure or by the holder of the patent during the term of validity of the patent. Accordingly, it can be deduced that the lawmaker aimed to prevent extending the scope of the invention beyond applicant's original intentions.

If the answer to question 2 is no, please answer the following questions:

h) Is the disallowance of use of prosecution history mandated by statute or by case law in your jurisdiction?

-

i) Explain the policy reasons for not considering prosecution history during the claim interpretation process.

-

3) Assuming that at least some countries will consider foreign prosecution history as part of claim interpretation in their jurisdictions, does this have implications for how you would handle prosecution of a patent application in your country? Is this problematic?

Yes.

4) In your country or region, may a patent be invalidated in post-grant proceedings on the basis of the same prior art which was taken into account by the examiner of the patent office during prosecution of the patent? If so, may the patent be invalidated on the basis of the same prior art and the same argument used by the examiner or may the same prior art only be used if it is shown that there is a new question based on some other teaching or aspect of that prior art?

The relevant specialized Intellectual Property court has the power to invalidate a granted patent document on the basis of a prior art document which was thoroughly considered during substantive examination of the subject patent. A patent application during prosecution of which was found to be novel and to involve an inventive step may be regarded as lacking these patentability criteria during post-grant proceedings in respect of the same and only prior art document. Although this occasion is not a common one and was not the case until date to the best of the knowledge of the writers, it is theoretically possible that a competent specialized Intellectual Property court adopts a view to set aside the patentability decision of the Examination Office and convicts to the nullity of the granted document based on the same prior art.

It is more probable that instead of lack of novelty, the specialized court finds that the document whose invalidation was requested by a third party does not involve an inventive step. Assessment of inventive step is generally subject to the problem-solution approach in Turkey. However, as even a specialized Intellectual Property court assigns and relies on technically and legally qualified experts to constitute an expert board and occasionally holds a view which was not supported by such a board, consistency of decisions of different specialized Intellectual Property courts can be subject to discussion in the sense that while some expert boards can opt for a literally strict application of problem solution approach and others not.

On the other hand, irrespective of the position different expert boards may take with regard to the strict application of the problem and solution approach, nullity of a granted patent may be adjudged and within the competence of a specialized Intellectual Property

court based on a prior art document already taken into account during examination before grant with or without similar arguments against patentability.

Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the use of prosecution history in post-grant proceedings. More specifically, the Groups are invited to answer the following questions *without* regard to their national laws:

1) Is harmonization of the applicability of prosecution history in post-grant proceedings desirable?

   Yes.

2) Is it possible to find a standard for the use of prosecution history that would be universally acceptable?

   It seems unlikely to find the standards.

3) Please propose a standard you would consider to be broadly acceptable for a) the types of prosecution history that should be considered, if any; and b) the type of proceeding and circumstances in which it should be considered.

   The Turkish Group considers that in current claim-writing practice claims as such are closed texts in which there are hidden semantic layers. Under these circumstances it is unrealistic to expect that the claim text alone would require no interpretation. Accordingly, the statements of the applicant regarding the interpretation of claims are valuable for third parties that are negatively affected by the patent and take active action to invalidate it.

   On the other hand patent as an asset should have its own concrete effect without requiring additional comments and explanations which render the claim as such insufficient as a material asset. Especially foreign prosecution history may become vast and variable.

National Groups are invited to comment on any additional issue concerning the use of prosecution history in post-grant proceedings that they deem relevant.

NOTE:
It will be helpful and appreciated if the following points could be taken into consideration when editing the Group Report:

- kindly follow the order of the questions and use the questions and numbers for each answer
- if possible type your answers in a different colour
- please send in a word document
- in case images need to be included high resolution (not less than 300 dpi) is required for good quality printing

SUMMARY

In conclusion, current legislation by statue, allow use of prosecution history to interpret a claim. However, post grant proceeding can only be executed before the courts. No case law has been established with regard to the specific application of the relevant article (Art. 83/7). Motives of the legislation provide a broad interpretation and applicability of prosecution history neither by being dependent on the authority nor by being limited in case of the equivalents. There is no statute or case law permitting/enabling the use of the prosecution history from a corresponding foreign application. Other foreign prosecution history will most probably be disregarded by board of technically qualified court appointed experts on a case. Current claim drafting practice might cause difficulties while interpretating claims. Prosecution history is valuable for third parties being negatively effected by the patent but incorporation of the foreign prosecution may lead to complexity and legal uncertainty"

ZUSAMMENFASSUNG

Infolgedessen erlauben die gegenwaertigen gesetzlichen Bestimmungen die Vergangenheit des Rechtsverfahrens um einen Anspruch zu interpretieren. Aber die Prozeduren nach der Erteilung des Patents können nur an den Gerichten durchgeführt werden. Kein Rechtsprechung hat im Hinblick auf die spezifische Anwendung des einschlägigen Artikels (Art. 83/7) nachgewiesen. Wenn bei aquivalenten Sachen Probleme auftreten können die Ursachen eines Rechtsverfahrens eine grobe Interpretation über die Vergangenheit des Rechtsverfahrens und der Anwendbarkeit sichern ohne an die Zustaendigen anzulehnen und ohne begrenzt zu werden. Es gibt kein Gesetz oder keine Rechtsprechung, das/die die Verwendung der Rechtsverfahrens-Vergangenheit von einer entsprechenden ausländischen Anwendung erlaubt/ermöglicht. Die andere auswaertige Rechtsverfahrens-Vergangenheit wird wahrscheinlich von den Gutachtern, die von der sachverstaendigen techniscen Gerichtskommission berufen worden sind und sich mit dem Rechtsverfahren befassen, nicht in Betracht genommen werden. Die gegenwaertige Art der Abfassung der Ansprüche kann bei der Interpretation einem Anspruch verwirrend sein. Die Vergangenheit des Rechtsverfahrens ist von der Sicht der dritten Personen die von dem Patent negativ beeinflusst werden bedeutend, aber die Inkorporation der auslaendischen Rechtsverfahren kann zur Komplexitaet und gesetzlicher Unbestimmheit führen.

RÉSUMÉ

Finalement, la courante législation légiférée, permet d'utilisation d'histoire de poursuite pour interpréter une revendication. Pourtant, procédure de post-délivrance ne peut être executée avant le tribunal. Il n'y a pas de droit jurisprudentiel concernant la demande spécifique de l'article pertinente (Art. 83/7). Motifs de la législation fournit une interprétation générale et une applicabilité d'histoire de poursuite ni dépendants de l'autorité ni limités quand les équivalents une question. Il n'existe pas de loi ou jurisprudence autorisant/permettant l'utilisation d'histoire de poursuite d'une demande étrangère correspondante. L'autre d'histoire de poursuite étrangère sera probablement meprise par le conseil du tribunal techniquement qualifié préposé des experts pour un litige. Le courant practice de rédiger une revendication peut amener à confusion durant l'interprétation d'une revendication. L'histoire de poursuite est précieuse pour les tierces personnes affectées négativement par le brevet, mais l'élargissement à la poursuite étrangère peut amener à complexité et incertitude légal.