

Question Q233

National Group: Turkish Group

Title: **Grace period for patents**

Contributors: Ayşegül NALBANTOĞLU, Esin KARANKI, Neşe DUYGU, Ayşe İLDEŞ ERDEM, Gökçen GÖKÇE

Reporter within Working Committee: Esin Karanki

Date: 25.03.2013

Questions

Questions

The Groups are invited to answer the following questions under their national laws. If both national and regional laws apply to a question, please answer the question separately for each set of laws.

Please number your answers with the same numbers used for the corresponding questions.

I. Analysis of current law and case law

- 1) Does your country or region provide a grace period of any kind for patent applicants? As used in these questions, “grace period” includes any situation where a disclosure prior to a patent filing date that would normally qualify as prior art to the patent application is disqualified as or removed from the prior art.

Yes, In Turkey, a grace period for patent applications is provided.

During the grace period, disclosures of

a. the inventor,

b. an office when the information was contained

i. in another application filed by the inventor and which application should not have been disclosed by the office, or

ii. in an application filed without the knowledge or consent of the inventor by a third party which obtained the information directly or indirectly from the inventor or,

c. a third party which obtained the information directly or indirectly from the inventor, were done prior to the patent filing date are disregarded for patentability considerations.

2) If the answer to Question (1) is yes, please answer the following sub-questions:

a) What is the duration of the grace period?

In Turkey, the duration of the grace period is 12 months.

b) From what date is the grace period calculated? Please indicate the effect, if any, of an international filing date and/or a Paris Convention priority date.

The grace period is the period preceding from the date of filing or, where priority is claimed from the date of priority of the application

c) What types of intentional acts, disclosures, or exhibitions by the applicant (including the inventor or co-inventor) qualify for the grace period?

In Turkey, all types of intentional acts of the inventor qualify for the grace period. During the grace period of 12 months, the information disclosed by the inventor does not affect the patentability of that invention.

d) What types of unintentional acts, disclosures, or exhibitions by the applicant (including the inventor or co-inventor) qualify for the grace period?

All types of unintentional acts, disclosures or exhibitions of the inventor qualify for the grace period.

e) What types of acts, disclosures, or exhibitions by a third party who is not the applicant, inventor, or co-inventor qualify for the grace period?

In Turkey, acts, disclosures, or exhibitions by an office qualify for the grace period in the following situations:

- when the information was contained in another application filed by the inventor and which application should not have been disclosed by the office, or
- when the information was contained in an application filed without the knowledge or consent of the inventor by a third party who obtained the information directly or indirectly from the inventor.

Moreover, all types of disclosures by a third party who obtained the information directly or indirectly from the inventor qualify for the grace period.

f) To the extent not already answered in Question 2) e) above, is there any situation where a disclosure by a third party who did not learn of or derive the invention from the inventor(s) can be covered by the grace period?

No, In Turkey, this kind of disclosures by a third party (for example by a third party who invented the subject matter himself) cannot be covered by the grace period.

g) Is any type of statement or declaration by the applicant required to invoke the grace period? If yes:

What are the requirements for the statement/declaration?

The applicant invoking that the grace period must be applied, has the burden of proving that the conditions of grace period are fulfilled or are expected to be fulfilled.

When must the statement/declaration be filed?

The effects of grace period are not limited to a term and may be invoked at any time.

- h) Is the grace period defined by a statute or regulation? If so, please provide a copy of the relevant portion of the statute or regulation.

In Turkey the grace period is defined in the Turkish Decree Law No. 551, Pertaining to the Protection of Patents (hereinafter referred as “DL 551”), in section two, Article 8.

- i) Is there any special situation where only certain types of applicants/inventors are allowed to benefit from graced disclosures? (such applicants/inventors may include SMEs, universities, individuals, etc.)

No, in Turkey all types of inventors are allowed to benefit from grace period.

Policy

- 3) If your country or region provides a grace period for patents, please answer the following sub-questions:

- a) What are the policy reasons behind this grace period?

The legal grounds of DL 551 are not publicly available. According to popular belief, the probable policy reason behind the grace period is to support individuals, universities and SME's.

Filing patent applications can be expensive for an inventor, especially for individuals and SME's, before entering to market. After launching their products on the market, they might earn the money to afford patent application. Sometimes SME's would like to decide whether they will file a patent application or not, after following the sales trend. Sometimes academic people published their invention on the Journal before filing patent application. The grace period is indispensable for these cases.

- b) Is the grace period, as it currently exists in your country or region, considered useful?

Yes, it is considered useful especially for individuals, universities and SME's.

- c) Is the grace period considered more useful for a certain class of stakeholders (for example, individuals, universities, small businesses, or large businesses)?

According to DL 551, the grace period is not considered to be more useful for a certain class of stakeholders.

But it is obvious that it is more useful for individuals, universities and SME's.

- d) How often is the grace period used? If you are unable to provide a quantitative answer to this question, please indicate one of: often; occasionally; or almost never.

The exact number of the case is not notified by TPI (Turkish Patent Institute). Though the statistical data of how often grace period is used is not known, with a realistic assumption we have the knowledge that grace period is used occasionally in Turkey.

- 4) If your country or region does not provide a grace period for patents, please answer the following sub-questions:

- a) What are the policy reasons behind not providing a grace period?
- b) Would a grace period be useful for stakeholders in your country or region?
- c) Would a grace period be considered more useful for a certain class of stakeholders (for example, individuals, universities, small businesses, or large businesses)?

5) What are the positive aspects of the grace period law of your country or region?

The positive aspects can be listed as below:

- Inventors would not lose their rights through accidental disclosure especially in a grace period model including any type of inventor's own disclosures.
- Under the grace period system, academics have the freedom to share research results at seminars or conferences, through journals or on the internet without having to waive any benefit provided by patent rights. Therefore, early publication of academics' innovative activity is encouraged in accordance with the culture of the academic and scientific world. Hence, grace period facilitates quick circulation of confidential scientific studies to open science by allowing scientist to adjust timings of a patent procedure.
- Effectiveness and value of the invention must be estimated before making the decision of filing a patent application. Such a pre-filing procedure requires scientific and technical outside advices. This requirement increases the risks of disclosure. Owing to grace period, inventors could engage in field trials, prototyping and negotiating with potential distributors or customers without the need for every relationship to be covered by cumbersome confidentiality agreements. Using priority right by securing an early patent filing date before disclosing to third parties is another alternative, but often it is better to do more development work on the invention before lodging a patent application. Fewer or better patent filing would ease the job of patent examiners and contribute to reducing the increasing backlogs of patent offices worldwide.
- Grace period allows inventors better market screening without any expenditure before filing a patent application and might achieve financial support by drawing the attention of potential customer.
- Grace period would increase access to and use of patent system, with consequential improvements for the trend of innovation.
- It is often at the end of the clinical trials the final formulation of the medicine will be adopted. In most cases, the patent application will be filed later on. Therefore, grace period provides much easier and healthy flow of information without any restraint to keep them as a secret during the pre-market studies.
- Collaborations between Universities or Public or Academic Research Institutions and Industry, be established easier by courtesy of grace period. Therefore, grace period encourages the scientific collaborations.
- Grace period extends the uncertainty time from 18 months, time for publication of a patent application, up to 30 months, time for publication of a patent application plus grace period, for third party in favour of inventor.

6) What are the negative aspects of the grace period law of your country or region?

The negative aspects can be listed as below:

- An inventor might risk losing all rights unless he is ready to file a final application within the grace period after disclosing an early prototype relying on that grace period. An inventor might also risk directing third parties to make a patent application parallel

to his own invention within grace period by disclosing an early prototype relying on that grace period.

- A disclosure allowed under the grace period exception of a country or a region might still invalidate a patent application in other countries which do not recognize grace periods.
- As a consequence of the risk losing patent rights abroad, lack of harmonization causes the most restrictive law to prevail, regardless of the relative efficiency of the patent law in force in inventor's country.
- A grace period system might encourage people to delay filing patents and securing priority dates, thereby increasing the risk that intervening disclosures by third parties might invalidate or reduce the scope of patent applications.
- The number of inventions "lost" through premature disclosure might increase due to the results of complementary trials which redefines the inventions during ongoing researches and which do not always entirely confirmed by the experimentations at the disclosure date. Because, the grace period might be aimed at solving a problem that does not really exist.
- In order to benefit from the exception of grace period in view of indirect disclosures that are derived from the first disclosure issued from the inventor, it is clear that the person who shall claim this right will have to demonstrate the relationship between the derived disclosure and the first disclosure issued from the inventor. In case such a demonstration could not be undoubtedly shown, the exception would not be recognized.

- 7) As a practical matter, are the procedures and strategies of patent applicants in your jurisdiction affected by the grace period laws of other countries or regions? If so, in what way?

Taking into consideration the priority date, if a patent applicant benefiting from the right of grace period in Turkey applies to another country's or regional or international patent application system, laws relating to grace periods of these patent application systems affect procedures and strategies of the patent applicant.

If the applicant has intention of filing patent application in another country or regional or international patent application system using the priority right, the applicant should be aware of the grace period laws of other countries.

In this case, the applicant filing patent application in another country having no law of grace period should have additional information regarding the disclosed invention, in the patent document. Otherwise, patent examiners of such countries would reject the patent application because of the lack of novelty.

On the other hand, the applicant filing patent application in another country having law of grace period should consider the differences of these laws. Since there is no harmonized law in relation to grace periods, slightly changes exist regarding the time limit and the scope of the grace period.

Grace period laws of other countries are also considered during the national phase entrance from a regional or international patent application system.

II. Proposals for harmonisation

The Groups are invited to put forward proposals for the adoption of harmonized laws in relation to grace periods for patents. More specifically, the Groups are invited to answer the following questions *without* regard to their national laws.

- 8) In your view, and assuming a proper balance is struck between the rights of the applicant and the rights of the public at large, is a grace period for patents desirable?

Yes. It is desirable.

While the patent applicant has rights to disclose information regarding the subsequent patent application, receive monopoly, and gain rights to enforce patent; the public learns from disclosed information, makes sure that no patent infringement takes place, and be encouraged to overcome the state of art.

As long as the advantages of grace period for applicant do not outweigh disadvantages for public, grace period is desirable. It is important to hold the balance between the monopoly and stimulation of innovation.

9) Is harmonization of laws relating to grace periods for patents desirable?

Yes. Harmonization of patent laws concerning the grace period is highly desirable.

A worldwide grace period prior to the priority date is essential. Differences of national patent laws concerning the grace period or lack of grace period cause conflicts.

10) Please provide a standard that you consider to be best in each of the following areas relating to grace periods:

a) The duration of the grace period

The period considered to be applicable is 12 months.

b) The date from which the grace period is calculated

The date should be calculated beginning from filing date or where priority is claimed from the date of priority of the application.

c) The types of intentional acts or disclosures by the applicant (including the inventor or co-inventor) that should be covered by the grace period

All types of intentional acts or disclosures as regulated by the current national legislation.

d) The types of unintentional acts or disclosures by the applicant (including the inventor or co-inventor) that should be covered by the grace period

All types of unintentional acts or disclosures as regulated by the current national legislation.

e) The types of acts or disclosures by a third party who learned of or derived the invention from the applicant that should be covered by the grace period

All types of disclosures by a third party who learned of or derived the invention from the applicant that should be covered by the grace period as regulated by the current national legislation.

f) The types of acts or disclosures by a third party who did not learn of or derive the invention from the applicant that should be covered by the grace period

None of disclosures by a third party who did not learn of or derive the invention from the applicant that should be covered by the grace period as regulated by the current national legislation.

g) The requirement for and content of any statement/declaration by the applicant to invoke the grace period

The applicant should be able to prove the date of disclosure and it should also be proved that the disclosure is within the scope of the protection postulated by the claims of the invention in order to invoke the grace period.

- 11) The Groups are invited to comment on any additional issue concerning grace periods for patents that they deem relevant.

As a developing country in IP rights, the inventors should be supported in terms of patent applications in Turkey. For this reason, the grace period term should be long enough to encourage the inventors to protect their inventions. In accordingly, we believe that 12 months of grace period should be applied as regulated in our current national legislation.

However, an ongoing draft law might cause grace period in Turkey to be amended as precisely in similar way with EPO, Art.55 regarding non-prejudicial disclosures.

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 is required for good quality printing.

SUMMARY

Current national legislation provides 12-month grace period for patent applications. The group is of the opinion that grace period is very crucial for individuals, universities and SME's in terms of promoting the role of intellectual property rights in Turkey. Accordingly, the grace period term should be long enough so that the inventors can be supported to protect their ideas. The suggested term of grace period is 12 months as regulated by the current national legislation. The group also believes that there should be some requirements, such as ascertaining the date of disclosure and also proving that the disclosure is clearly defined within the scope of the protection postulated by the claims of the invention, in order to invoke the grace period. On the other hand, general harmonization of patent laws concerning the grace period is essential in order not to cause conflicts worldwide.

ZUSAMMENFASSUNG

Die aktuelle nationale Gesetzgebung bietet eine 12-Monats-Frist für Patentanmeldungen. Die Gruppe ist der Meinung, dass Nachfrist sehr entscheidend für Einzelpersonen, Universitäten und KMU im Hinblick auf die Förderung der Rolle der Rechte an geistigem Eigentum in der Türkei ist. Demnach sollte die Dauer der Nachfrist lang genug sein, so dass die Erfinder unterstützt werden können, um ihre Ideen zu schützen. Die vorgeschlagene Dauer, der von der geltenden nationalen Gesetzgebung geregelten Nachfrist beträgt 12 Monate. Die Gruppe glaubt auch, dass einige Anforderungen vorhanden sein sollen, wie z. B. die Ermittlung des Zeitpunkts der Offenlegung und auch der Nachweis, dass die Offenlegung eindeutig innerhalb des Schutzzumfangs postuliert durch die Ansprüche der Erfindung definiert ist, um die Nachfrist zu berufen. Auf der anderen Seite, ist eine allgemeine Harmonisierung des Patentrechts hinsichtlich der Nachfrist wichtig, um weltweit keine Konflikte zu verursachen.

RÉSUMÉ

La législation nationale en vigueur prévoit un délai de grâce de 12 mois pour les demandes de brevet. Le Groupe est d'avis que ce délai de grâce représente une période très critique pour les individus les universités et les PME du point de vue de faire la promotion du rôle des droits de la propriété intellectuelle en Turquie. Par voie de conséquence, la période de grâce doit être suffisamment longue pour permettre aux inventeurs d'être soutenus dans la protection de leurs idées. Le délai de grâce suggéré s'étale sur une période de 12 mois conformément aux dispositions de la législation nationale en vigueur. Le groupe pense également que certaines exigences, telles que la vérification de la date de divulgation et l'établissement de la preuve indiquant que ladite divulgation a été clairement définie dans le cadre de la protection postulée par les revendications de l'invention, doivent être formulées, afin d'invoquer la période de grâce. En revanche, l'harmonisation générale des législations sur le brevet concernant la période de grâce est déterminante afin d'écartier tout conflit à travers le monde.

