



FICPI Turkey - Roundtable Meeting on Inventive Steps for Patents

13th October, 2018

FICPI-Turkey arranged its fourth roundtable meeting regarding the rules for determining the closest state of the art document in the light of the Problem-Solution Approach used for the inventive step examination of a claim, and the definition of the objective technical problem solved by the claim. The issue of inventive step was reviewed based on the closest state of the art document and the effect of an examiner's view with regard to inventive step based on the objective technical problem.

Ms. Selda Arkan, a Member of the Board of FICPI –TURKEY and a European Patent Attorney, moderated the meeting. There were 25 participants, including FICPI-TURKEY members. Following an opening speech by Mr. Uğur Aktekin, President of FICPI Turkey, Ms. Arkan started the discussion by pointing out factors which should be considered for determining the inventive step, namely, the identity of the person skilled in the art, the technical field of the subject, and the prior art of the invention at the application or priority date. There ensued a discussion regarding who should be considered the person skilled in the art, the circumstances under which the technical field should be determined, and what should be considered as prior art. Ms. Arkan pointed out that problem-solution approach of the EPO would be used at this stage to determine the problem which the invention tries to solve, with resort to the description of the patent.

Later, there was discussion on the clarity issue. Mr. Barış Atalay, also a Member of FICPI -TURKEY and a European Patent Attorney, took the floor and stated that in a case where a claim consists of several elements, and the technical problem is solved using elements that are not mentioned in the description, if the elements can be understood implicitly from the description, even though the solution using the elements is not mentioned, there will be no clarity issue. The examiner might apply the problem-solution approach at this point. Ms. Arkan stated that after determining the problem, we should determine the closest state of the art document at the time of the invention and consider whether the person skilled in the art would combine, as of the date of the invention, that document with one completing the deficiencies of this document.

There followed a discussion about when one cannot arrive at a decision whether an invention has an inventive step. Ms. Arkan stated that secondary elements or considerations are taken into account and that one of those secondary elements is generally accepted technical prejudice, namely, whether there is any prejudice saying that “this cannot be made” on the date the invention was made. She mentioned that the other secondary elements are a surprising effect, unexpected results, long felt need, commercial success, simple solution, and situations where a simple machine is used to do what a more complex machine does.

Finally, there was a discussion regarding how the examiners should evaluate the inventive step, taking into account all of the above elements.

Most participants actively participated through questioning and in engaging in discussion, both during the meeting and at the closing cocktail. FICPI-Turkey has finalised its roundtable meetings for the year with this fourth meeting and is happy to have conducted the meetings. Useful feedback has been received. FICPI-Turkey will continue to arrange roundtable meetings on various subjects over the coming year, with the aim of achieving continuity for the meetings and providing high-quality discussion platforms for patent and trademark attorneys.