



Date: 7th June 2015

## Q244

### Inventorship of multinational inventions

**Responsible Reporters: by Sarah MATHESON, Reporter General John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General Yusuke INUI, Ari LAAKKONEN and Ralph NACK Assistants to the Reporter General**

National/Regional Group	Turkey
Contributors name(s)	Kadriye AKDAG, Nese DUYGU, Ezgi BAKLACI, Leman TANDOGAN, Ekrem SOYLU, Murat BASMACI, Olgac NACA KCI, Neriman Dilek YILDIRIM, Nevin ONER, Aysel KORKMAZ and Kadriye AKDAG
e-Mail contact	kadriye.akdag@abdiibrahim.com.tr
Date	12-05-2015

#### I. Current law and practice

1) Please describe your law defining inventorship and identify the statute, rule or other authority that establishes this law.

a) If person A, located outside your country, directs the efforts of person B, located in your country, for making an invention in your country, under what circumstances would person A and/or person B be considered an inventor under your law?

**It is stated in Art. 11 of the Patent Decree Law No. 551 that the right to a patent shall belong to the inventor (natural person) or to his successor in title. Therefore, the provision does not directly define the inventor and the concept of invention and has left this matter to the practice and doctrine.**

**There is no legal obstacle for A from abroad and B mentioned in the example to be the inventors of the same invention. Also the Decree Law does not make a mention of under which conditions A and B shall be the inventors; instead, it is stated in Article 11 that more than one person may be the inventor. Thus, it can be noted that no limitation applies with regard to nationality, citizenship or residency.**

**That being said, the Turkish doctrine containing references to the international doctrine points out the following points: That A being manager of B in Turkey will not be sufficient for establishing a joint inventorship. The provided contribution is required to**

**affect the obtained result. Likewise, even if A is only a financier of B or someone providing aid in laboratory and in terms of equipments or only giving ideas or only providing information about the completed experiments, or only carrying out laboratory measurements, or only suggesting a technical problem, A shall not be the inventor.**

b) Does your law defining inventorship rely on or look to a particular part of the patent application? For example, is inventorship under your law determined on a claim by claim basis, determined based on the content of the drawings or the examples, or determined on some other, and if so, what basis?

no

Please comment:

**No. As noted in the question, the Decree Law does not require someone to have made a percentage of the invention or to have written a certain number of claims down, and there also is no prerequisite for making a distinction of which claims and drawings shall belong to and those details are required to be expressed. According to Art. 85 of the Decree Law, it is provided that the ownership regarding an invention shall be governed by the agreement between the parties if there is such agreement, or in the absence of such agreement, by the provisions of the Civil Code concerning Joint Ownership.**

2) Does your law of inventorship depend on the citizenship of the inventor(s)?

no

Please comment:

**No. There is no discrimination in our legislation.**

3) Does your law of inventorship depend on where the invention was made (e.g. on the residency of the inventor(s))?

no

Please comment:

**No. There is no rule found about this matter in our legislation. Only in Art. 128 of the Decree Law No. 551, where the inventor of a secret patent is domiciled in Turkey, the invention shall be deemed to have been realized in Turkey.**

4) Can the inventorship of a patent application be corrected after the filing date in your country?

yes

If yes, what are the requirements and time limits for such correction?:

**In accordance with our legislation, you can add a new inventor in connection with a patent while the patent application process is in progress and after the patent certificate is issued. However, there is no way to remove the name of an existing inventor from the application.**

**There is not a time limit in our legislation. In order to add a new inventor to an invention, it is necessary to submit a petition to the Turkish Patent Institute and to specify whether the invention was made under contract or independently.**

5) What are the possible consequences of an error in the stated inventorship on a patent application in your country? Can a patent issued from such an application be invalidated or rendered not enforceable on that basis? Does it matter whether the error was intentional or unintentional?

**Incorrectly identifying an inventor in a patent and its consequences are stipulated in Article 12 of the Patent Decree Law No. 551 which discusses "Usurpation of the Right to a Patent". According to this article, incorrectly identifying an inventor shall result in invalidation of the patent.**

**The consequences of initiating an invalidation action pursuant to Article 129 for such purpose are specified in Article 12 of the Patent Decree Law. Where the invalidation action initiated on the basis of this provision is resolved in favour of the plaintiff claiming to be the inventor, the plaintiff is entitled to request one of the following courses of action within three months after the judgement has become res judicata. Those rights are;**

- i. Right to request that the prior application for patent be accepted as his application and be further prosecuted as such,**
- ii. Right to file a new application for the same invention (Such an application shall be prosecuted as of the date of filing of the first application and in such case, the application subject to usurpation shall be invalid),**
- iii. Or right to request that the application subject to usurpation be rejected.**

**As regards the faith of the applicant, it will not be incorrect to say that the law deems the applicant here as acting in bad-faith in consideration that the title of the relevant article is identified as "usurpation" of the right to a patent.**

6) Does your law require that an application for a patent claiming an invention made in your country, whether in only one technical area or in all technical areas, be filed first in your country?

no

If no please comment:

**Our legislation does not contain such a practice.**

a) Is the law requiring first filing in your country limited to a specific area of technology or otherwise limited such that it does not apply to all inventions made in your country? If yes, please explain.

7) Does your law require that a patent application claiming an invention made, at least in part, in your country undergo a secrecy review or similar process before it can be filed in another country?

yes

If yes please answer the following questions::

a) Does this law depend on the area of technology that is disclosed and claimed in the patent application?

**All of the national applications filed at the Turkish Patent Institute and the international applications filed through the Turkish Patent Institute are examined whether they are related to national defense or not. If the application concerns national defense, it is necessary to get a permission from the Ministry of National Defense in order to file the application in foreign countries as well.**

**All of the applications are checked in terms of national defense.**

b) Describe this aspect of your law as well as the procedure, timing, and cost of compliance with it.

**Pursuant to Art. 125 of the Patent Decree Law in which secret patents are discussed, the contents of an application for patent shall be kept secret, for a time period of two months, as of the date of filing of the application unless the Institute decides to disclose same earlier, and the Institute may decide to extend this term up to five months as of the date of filing of the application.**

**The Institute may consider that the invention is important for national defense in cooperation with the Ministry of National Defense. The Ministry of National Defense is entitled to examine all of the patent applications under the conditions of secrecy provision beforehand. If it is a matter of national defense interests, the Ministry of National Defense may request, before the expiration of the 5 month period, the Institute to examine the patent application in accordance with the criteria of secrecy and to notify the applicant of this situation.**

**The Ministry of National Defense may permit the applicant to use the application in part or full within the frame of the specified rules upon request of the applicant.**

**There is no liability to pay annuity fees (Art. 127 of the Decree Law).**

- c) Describe the possible consequences of failing to comply with this law. Does it matter whether the error was intentional or inadvertent?

**Our legislation does not contain such a practice.**

## II. Policy considerations and proposals for improvements of the current law

- 8) If your law defines inventorship, is this definition sufficient to provide patent applicants with clear guidance as to who should be named as the inventor(s) of a patent application? Are there aspects of this definition that could be improved?

**Our legislation does not contain a direct and clear definition of inventorship. The only description regarding the inventorship in the Turkish patent legislation is given among the descriptions which do not affect grant of patent to an application, which reads as "any person who, at the date of filing the application, has the right to the patent shall be deemed an "inventor" according to Art. 8/2 of the Patent Decree Law. Also, according to Art. 11 the right to a patent shall belong to the person who makes the invention (inventor).**

- 9) If you have laws requiring first filing of patent applications directed to inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

**There is no limitation on this matter in our legislation.**

- 10) If you have laws requiring a secrecy review of patent applications directed to some or all types of inventions made in your country, are there aspects of these laws that could be improved to address multinational inventions?

**The Patent Decree Law No. 551 does not contain any provision in relation with regard to the secrecy of multinational inventions. Therefore, we do not have any suggestion of**

**improvement on this matter**

- 11) Are there other aspects of your law that could be improved to facilitate filing of patent applications having multinational inventorship? If yes, please explain.

**There is no article defined in regard to multinational inventorship in the Decree Law.**

**III. Proposals for harmonisation**

- 12) Is harmonisation in this area desirable?

yes

Please comment.:

**The practices in this field must be harmonized by bringing international regulations. We are in the opinion that "First filing" necessity which is applied in some countries should be removed and restrictions should not be done in the definition of inventorship by adopting a liberal perspective. Otherwise, we believe that it will cause the spread of the "First filing" necessity in many countries, including Turkey**

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

- 13) Please provide a definition of inventorship that you believe would be an appropriate international standard.

**Any person who contributes to the creation of an invention, including the owner of the idea should be entitled to be inventor.**

- 14) Please propose a standard for correction of inventorship after a patent application is filed, together with any requirements necessary to invoke this standard (e.g. intentional versus unintentional error) and any timing requirements (e.g. during pendency of the application).

**In case of unintentional faults and as long as an agreement is reached between the parties, any correction should be able to be made on the details of the inventor and new inventor should be able to be added for an application at any phase of the application process.**

- 15) If you believe such a requirement is appropriate, please propose an international standard for first filing requirements that would take into account multinational inventions.

**Our legislation does not impose a first filing requirement and we believe that such limitation should not apply in any country. An application should be able to be made in a desired country depending on the consensus of the inventors.**

- 16) If you believe such a requirement is appropriate, please propose an international standard for secrecy review requirements that would take into account multinational inventions.

**Since the Patent Decree Law does not make a distinction of national or multinational invention in terms of secrecy review, there is no need to adopt a new provision with regard to multinational inventions.**

17) If you believe such a requirement is appropriate, please propose an international standard for obtaining a foreign filing license.

**Since the Patent Decree Law does not impose a first filing requirement, foreign filing license is not a matter in question**

18) Please propose an international standard for an ability to cure or repair an inadvertent failure to comply with a first filing requirement or a security review requirement.

**We think that first filing requirement should not be imposed.**

19) Please propose any other standards relating to multinational inventions (excluding those related to inventor remuneration or ownership of the invention) that you feel would be appropriate.

No.

#### Summary

The concept of the inventor or invention does not directly defined in the Patent Decree Law No. 551 or in the doctrine. According to our legislation, all of the contributors can be defined as inventor. Besides, a new inventor can be added in connection with a patent while the patent application process is in progress and after the patent certificate is issued. However, an inventor cannot be withdrawn after the application process is started. If there is incorrect declaration of an inventor, correction can be done before Turkish Patent Institute if the parties are in agreement. If the parties are not in agreement, it will deemed to be usurpation and the disagreement will be settled by courts. According to our legislation there is no first filing obligation. We are in the opinion that an harmonization in this area is desirable. We believe that "First filing" necessity which is applied in some countries should be removed and restrictions should not be done in the definition of inventorship by adopting a liberal perspective. Otherwise, we believe that it will cause the spread of the "First filing" necessity in many countries, including Turkey.

Please comment on any additional issues concerning the multinational inventions you consider relevant to this Working Question.

No.