

FICPI 15° OPEN FORUM – BARCELLONA

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INVENTIVE STEP

The European Patent Office Practice and Case Law

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Art. 56 EPC

“An invention shall be considered as involving an inventive step if,

1. having regard to the state of the art,

2. it is not obvious

3. to a person skilled in the art.

.....

THE STATE OF THE ART

Art. 54(2) EPC

*(2) The state of the art shall be held to comprise everything **made available** to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.*

“AVAILABLE TO THE PUBLIC”

Art 54(3) EPC (interfering applications)

Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

Art. 56 EPC

“If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents shall not be considered in deciding whether there has been an inventive step”.

EPO versus US/AIA (I)

Art 54(3) EPC vs 35 USC § 102(a)(2) AIA

New 35 USC § 102(a)(2) provides that:

*“...prior filed and later published applications and patents **may be used to establish that a claim is obvious.***”

EPO versus US/AIA (II)

**A second difference is that “the state of the art”
under the EPC comprises ..**

.. no grace period as under US-AIA.

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- 2. it is not obvious***

3. to a person skilled in the art.

PERSON SKILLED IN THE ART

Assessing the level of ability of the “skilled person” **is not an abstract, academic issue.**

The higher the level of competence attributed to the skilled person, the lower the recognizable inventive contribution of the claimed subject-matter.

All the more when the “person skilled in the art” is replaced by “a team of persons skilled in different aspects of the art”. **It means: raising the bar.**

The person skilled in the art is not an inventor and has a low professional profile

T 39/93 (OJ 1997, 134)

*“..**No definitions** of the notional person skilled in the art, suggested he was possessed of any **inventive capability**.*

It was the presence of such capability in the inventor which set him (the inventor) apart from the definition of “notional skilled person..”.

PERSON SKILLED IN THE ART

T 1464/05:

*“... the notional person skilled in the art [...] was **assumed to be aware of the totality of the prior art pertinent to the relevant area** of technology and in particular of everything made available to the public [...]”.*

*Yet, the general knowledge of the skilled person **does not suffice to fill in the gap in technical information..** T0241/08.*

PERSON SKILLED IN THE ART

T1396/09 “*the skilled person **knows everything, but has no imagination, ...***”

T0207/94 “*...It has to be assumed that the average skilled person **would not engage in creative thinking***”

PERSON SKILLED IN THE ART

T1030/06 “...a person of ordinary skill in the art has [...] **the capability to perform routine work and experimentation.**”

T 500/91 “..the notional skilled person [...] **is oriented towards practicalities, [...]** and the development of the art normally expected by him **does not include solving technical problems by performing scientific research in areas not yet explored.**”

PERSON SKILLED IN THE ART

*T 455/91: The skilled person .. would neither have gone **against any established prejudice nor have tried to enter into any unpredictable area.** He would therefore adopt a **conservative attitude.** ...*

T 32/81, T 141/87, T 604/89, T 321/92.

*Yet, he/she can be expected to **look for suggestions in neighbouring fields** if he is aware of such fields or if the same or similar problems arise in such fields.*

Advanced Technical Fields

biotechnology, bio-informatics, nanotechnology, computer-implemented processes

The competent "skilled person" could be taken to be a **“team of experts”**.

In these cases for assessing the common technical knowledge, **the knowledge of a team** consisting of persons having different areas of expertise could be taken into account (T141/87, T 99/89).

In Nanotechnology,

the board stated (T 424/90), that the semiconductor expert would consult a plasma specialist if his problem concerned providing a technical improvement to an ion-generating plasma apparatus.

In Computer-Implemented Inventions (T 164/92)

*...it was observed that sometimes the average
skilled person in electronics, [...] might be
expected to consult a **computer programmer**.*

T 57/86, T 222/86: In advanced laser **technology**, the board identified the skilled person as a *production team of three experts in physics, electronics and chemistry respectively.*

In T 412/93: Production of Erythropoietin.

*“... the skilled person should be a **team of three**, composed of:*

- **one PhD researcher with several years' experience in the aspects of gene technology or biochemistry**, assisted by*
- **two laboratory technicians fully acquainted with the known techniques relevant to that aspect.**”*

“Person skilled in the art” (EPC)

versus

“Person having ordinary skill in the art” (US-Patent Law)

From a practical point of view, the “**ordinary skilled person**” in the US practice...

...is not at all “**ordinary**” in his/her **huge ability to combine different teachings and different pieces of the prior art**, ability absent in the skilled person under the EPO practice.

Art. 56 EPC

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The Problem-solution Approach

- a) establishing the closest prior art;
- b) defining the (objective) problem in the light of that prior art;
- c) identifying the solution;
- d) *demonstrating the success of the solution;***
- e) optionally reformulating the problem;
- f) examining the obviousness of the solution in view of the state of the art.

d) demonstrating the success of the solution:

In the pharmaceutical field, before the EPO, the US «prophetical examples», or

***“a vague [verbal] indication of a possible medical use for a chemical compound”
(T609/02)***

are NOT sufficient to make plausible that the technical problem has really been solved.

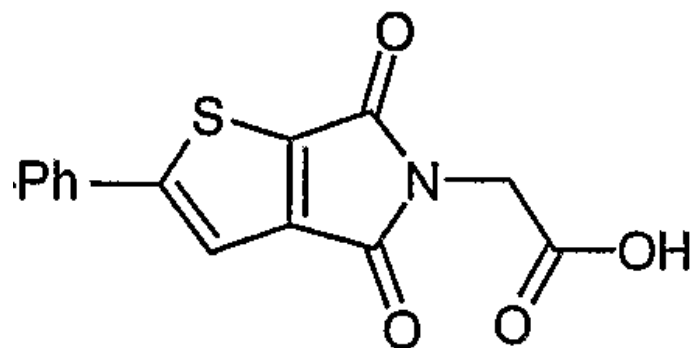
***Is the problem-solution approach based
on **hindsight** of the invention ?***

YES !!

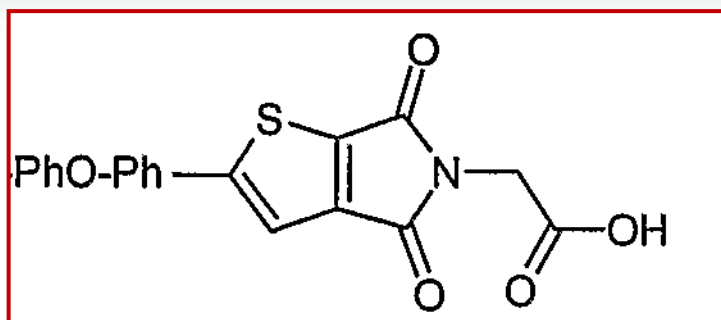
The identification of the closest prior art

1. The search-examiner reads the text of the application under examination,
2. based on the **hindsight of the invention**, performs the prior art search.

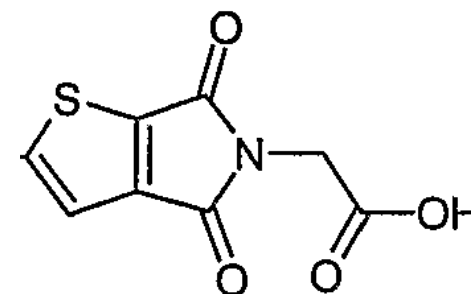
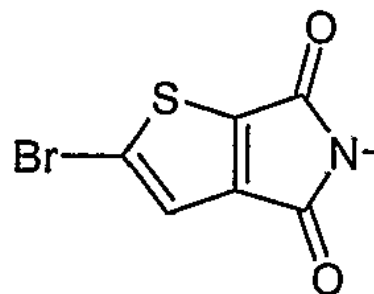
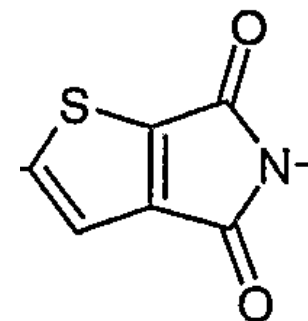
Therefore, the starting step of the p-s-a, namely the selection of the “***closest prior art***” is in itself the result of a typical “***a posteriori purposive selection***”.



INVENTION



closest compound



closest prior art

The identification of the technical problem

DEFINITION OF TECHNICAL PROBLEM

“The task (in German die Aufgabe) of modifying the closest prior art teaching in order to obtaining the same effect obtained by the invention”.

Actually the skilled person expected to modify the closest prior art would get lost if not assisted by the hindsight of the invention.

COUNTERBALANCING EX POST FACTO ANALYSIS BY THE EPO

The motivation = could/would principle

The EPO system fixed a crucial condition:

**The need of a *plausible motivation*, for the skilled person,
to be legitimated to modify the c.p.a. or to combine
whatever prior art teachings.**

The Guidelines for examination at the EPO (Part G, VII-5 – § 5.3 “Could-would approach” - September 2013) affirm:

*“...the question to be answered is whether there is any teaching in the prior art as a whole that **would** (not simply could [..]) have **prompted the skilled person, [...] to modify or adapt the closest prior art [...]**,.”*

*“... the point is [...] whether the skilled person [...] would have adapted or modified the closest prior art **because the prior art incited him to do so [...]**.*

Even an implicit prompting or implicitly recognisable incentive is sufficient to show that the skilled person would have combined the elements from the prior art (see T 257/98 and T 35/04).

T 1014/07 - The Board affirmed:

“8. Since this question involves determining whether or not the skilled person would [...] have made a particular modification, it is necessary for answering the question to identify conclusive reasons on the basis of tangible evidence that would have prompted the skilled person to act in one way or the other.”

T 1317/08 (point 2.10-2.11) :

“2.10 Technical feasibility and the absence of obstacles [...] were not sufficient to render obvious what was actually achievable for the skilled person. [...].

For affirming obviousness [...] it was necessary to show that there was a recognisable pointer (..ein Anhaltspunkt erkennbar sein..) in the state of the art which would have prompted him to combine the known means

T 715/09:

“*IPC classification alone is no reason for determining whether or not two pieces of prior art can be combined. The mere fact that two documents have the same classification is no reason for saying the combination of the teachings is obvious*”

From the foregoing, we can draw the general rule:

*“Under the EPC case-law, the skilled person is **NOT** expected to combine prior teachings unless there is a plausible **reason** or **motivation** to do so.”*

EPO system versus US system

According to my practical experience the rule followed by the USPTO is exactly the opposite of that used by the EPO:

*“The person having ordinary skill in the art is expected to combine **whatever prior teaching, unless there is a plausible reason/motivation NOT to do so**”.*

Legal basis in the US model for assessing obviousness:

The system of **four *Graham inquires*** formulated by the Supreme Court in case *Graham vs John Deer Co*, corroborated by

the ***TSM-test*** (Teaching-suggestion-motivation-test), as confirmed by Supreme Court in case *KSR International Co. v. Teleflex Inc.*

TSM-test (Teaching-suggestion-motivation)

There are three possible sources of motivation to combine prior teachings and establish a *prima facie* case of obviousness:

- 1. A teaching or suggestion to combine found in the prior art;**
- 2. The nature of the problem to be solved;**
- 3. The knowledge of the person having ordinary skill in the art.**

3. The knowledge of the person having ordinary skill in the art

By definition, the PHOSITA knows everything in the technical field of reference.

Therefore, according to the TSM-test, the **skilled person is expected and legitimated to combine all documents** for the sole reason that they belong to the same technical field of reference and PHOSITA is aware of their existence.

THANK YOU FOR YOUR ATTENTION

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