

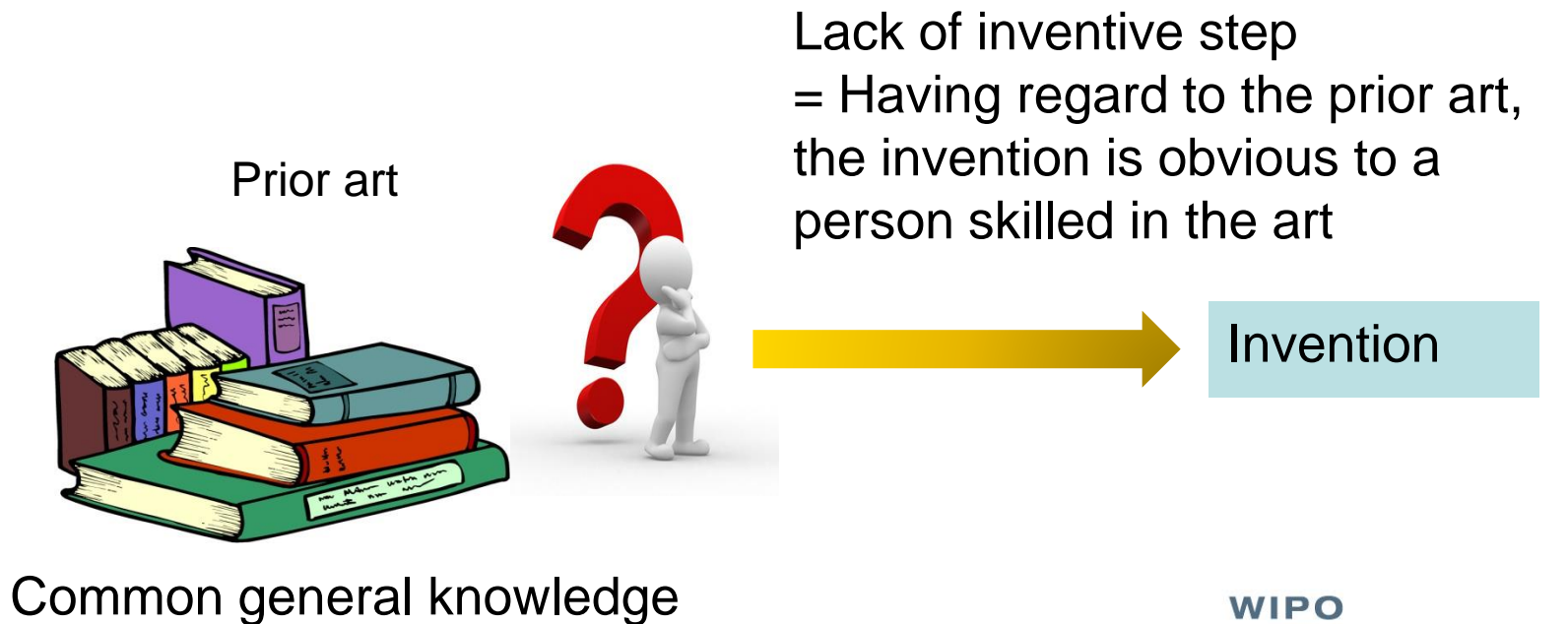
Further Study on Inventive Step (Part II)

Standing Committee on the Law of Patents (SCP)
Twenty-ninth session (December 3 to 6, 2018)

Presentation by the Secretariat

SCP/22/3: Study on Inventive Step

- ❑ Definition of the person skilled in the art
- ❑ Methodologies employed for evaluating inventive step
- ❑ The level of inventive step (obviousness)



SCP/28/4: Further Study on Inventive Step (Part I)

- ❑ Common General Knowledge: Its Combination with the State of the Art
- ❑ Combination: Juxtaposition vs Synergetic Effects
- ❑ Danger of Hindsight Analysis

SCP/29/4: Further Study on Inventive Step (Part II)

- ❑ Secondary indicia
- ❑ Selection inventions
- ❑ Problem inventions

- Based on the information provided by MSs (available on the SCP electronic forum website: <http://www.wipo.int/scp/en/>)
- A collection of factual information without analysis or recommendation



Secondary indicia

Secondary indicia

A number of secondary indicators have been developed through practice

- **Secondary or auxiliary character**
 - They may be taken into account for the inventive step assessment.
 - Their presence does not automatically establish the inventive step.
 - They can only be a persuasive evidence to support the inventive step on case-by-case basis.
- The effect of secondary indicators must **derived from the subject matter as claimed**.

Ex. “Commercial success” of the invention cannot be derived from successful advertisement, marketing strategy etc.

→ Always come back to the question as to whether the claimed invention as a whole would have been obvious, having regard to the prior art as a whole

Examples of “secondary indicia”

- Solving a long felt need; overcoming previously failed attempts;
- Having a particular commercial success;
- Competitors sought commercial implementation of the claimed invention (copied by others in preference to the prior art; seeking licenses)
- The prior art teaches way a person skilled in the art from the claimed invention;
- Originality of the solution brought by the claimed invention, which departs from the beaten path and opens a new path
- Overcoming technical prejudice
- Overcoming technical difficulties not solved by other means
- Offering a surprisingly simple solution

Similar concepts may be observed, but case law and guidelines vary from one country to another.



Selection inventions

Selection invention (1)

Selection of individual elements, sub-sets or sub-ranges, which are within the larger set or range in the prior art, but have not been specifically disclosed in the prior art

- Species of prior art genus
- Narrower range
- Selection from a bigger set of alternatives

How to apply the general principle of the inventive step analysis to selection inventions? - Elements considered in some countries

- Whether a special technical effect, characteristics or advantage is achieved by the selection invention, in comparison to the prior art;
- Such special technical effect, characteristics or advantage is unexpected or unpredictable from the prior art, by a person skilled in the art.

Selection invention (2)

Generally regarded as obvious selection

ex. a mere arbitrary selection; a mere choice from alternatives; a selection based on routine trial and error; a selection applying usual technical design procedures used by a person skilled in the art; a selection based on mere extrapolation from prior art.

- ❑ Explicit and implicit **teaching of the prior art reference and general common knowledge** considered (teach away? inevitably leading to the selection?)
- ❑ In countries where an unexpected technical effect, characteristics or advantage achieved by the selection is an important factor, such effect should be **identified in the application as of the filing date**.
 - **Evidence** to justify such effect may be submitted **after the filing date**.

Selection invention (3)

- ❑ Unexpected effect or advantage achieved by the selection must apply to **the entire range as claimed**.

US practice

- General obviousness test applies: Graham test
- MPEP: species of prior art genus
 - Examiners should consider all relevant prior art teachings, focusing on the following, where present: (i) size of the prior art genus; (ii) express teaching of the prior art; (iii) teachings of structural similarity; (iv) teachings of similar properties or utilities; (v) predictability of the technology.



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Problem inventions

Problem inventions

- The **technical contribution** of the invention lies in the **identification of the problem**.
- The **solution being obvious once the problem is identified**, but not being obvious from the prior art alone.

Case law developed by the EPO

- “The discovery of unrecognized problem may in certain circumstances give rise to patentable subject matter, in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious.”
- The **deficiency of the prior art** product was **not in the state of the art** at the priority date of the application.
- The outcome of the modification to the prior art was not predictable, and the claimed invention involved an inventive step.
- “Since the identification of the problem is not obvious, the **solution to the problem cannot be obvious either, even if it is retrospectively appears to be trivial in view of the identified problem.**”

Thank you.