INVENTIVE LEVEL
WHERE IS THE THRESHOLD?

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INVENTIVENESS CHALLENGE

What we hear and read:

- Basis of patent system
- Most subjective criterion
- Tough or even impossible for harmonizing
- Almost unpredictable in world-wide patenting
- etc.

QUESTIONS TO DISCUSS

- **Legal definition**
- **Definition of “One skilled in the art”**
- **Starting point in prior art**
- **Scheme of inventiveness examination**
- **Expected changes in law/practice**

LEGAL DEFINITION - CHINA

Article 22, third paragraph of the Patent Law

Inventiveness means that, as compared with the prior art, the invention has prominent substantive features and represents a notable progress, …..

Prominent substantive feature is interpreted as “the invention is non-obvious to a skilled person”.

Notable progress is interpreted as “the invention can produce advantageous technical effect as compared with the prior art”.

LEGAL DEFINITION - INDIA

Sections 2(1)(j) and 2(1)(ja) of the Patents Act, 1970

”(j) "invention" means a new product or process involving an inventive step and capable of industrial application;

(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;

LEGAL DEFINITION - RUSSIA

Article 1350 of the Civil Code

"Invention has inventive level if for a specialist it does not clearly follow from the state of art"

LEGAL DEFINITION – SOUTH AFRICA

”An invention shall be deemed to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms, immediately before the priority date of the invention, part of the state of the art ...”

“ONE SKILLED IN THE ART”

Who is that?

- any legal definition?
- model (imaginable) or person (e.g. examiner)
    - a single or a group?
    - locally or broadly knowledgeable in art?
    - skilled enough to select?
- capable of creativity or knowledge combiner?

“ONE SKILLED IN THE ART”

Law and *Patent Regulations* – ***no definition***

Interpretation attempt:

refers to a fictional “person”, who is presumed:

- to be aware of common knowledge and have access to prior art in the same field
- to have capacity to apply all the routine experimental means before the filing date
- not to have creativity
- if the problem to be solved impels that person to seek technical means in other field, he should also be presumed to have access to the relevant prior art, common knowledge and routine experimental means in the other field before the filing date

CHINA

"ONE SKILLED IN THE ART"

Law and Patent Regulations – no definition

Current Interpretation:

- Is a person of same or related industry
- Capable of reading the prior art and allows himself to be taught by what is contained therein (*Sankalp Rehabilitation* case - IPAB)
- Capable of carrying out only the basic instructions – unimaginative (*Aloys Wobben* case – IPAB)
- Presumed to know the state of that art at that time, and to have the knowledge that is publicly available (*Roche v Cipla* – Delhi High Court)

INDIA

“ONE SKILLED IN THE ART”

Law and Patent Regulations – no definition

Interpretation attempt:

- Is assumed to be associated with a field of art

- Capable of understanding meaning contents of invention features basing on the prior art

- Capable of generalizing the features to understand whether such generalizing is justified basing on particular embodiments

- Capable of understanding technical result of invention

- Capable of understanding apparent nature of a mistake if correction of latter is requested

RUSSIA

"ONE SKILLED IN THE ART"

Law and Patent Regulations –

Definition:

The hypothetical skilled addressee:

-is someone of *ordinary* skill in the art who conducts routine experiments/investigations and does not have a particularly inventive or inquiring mind

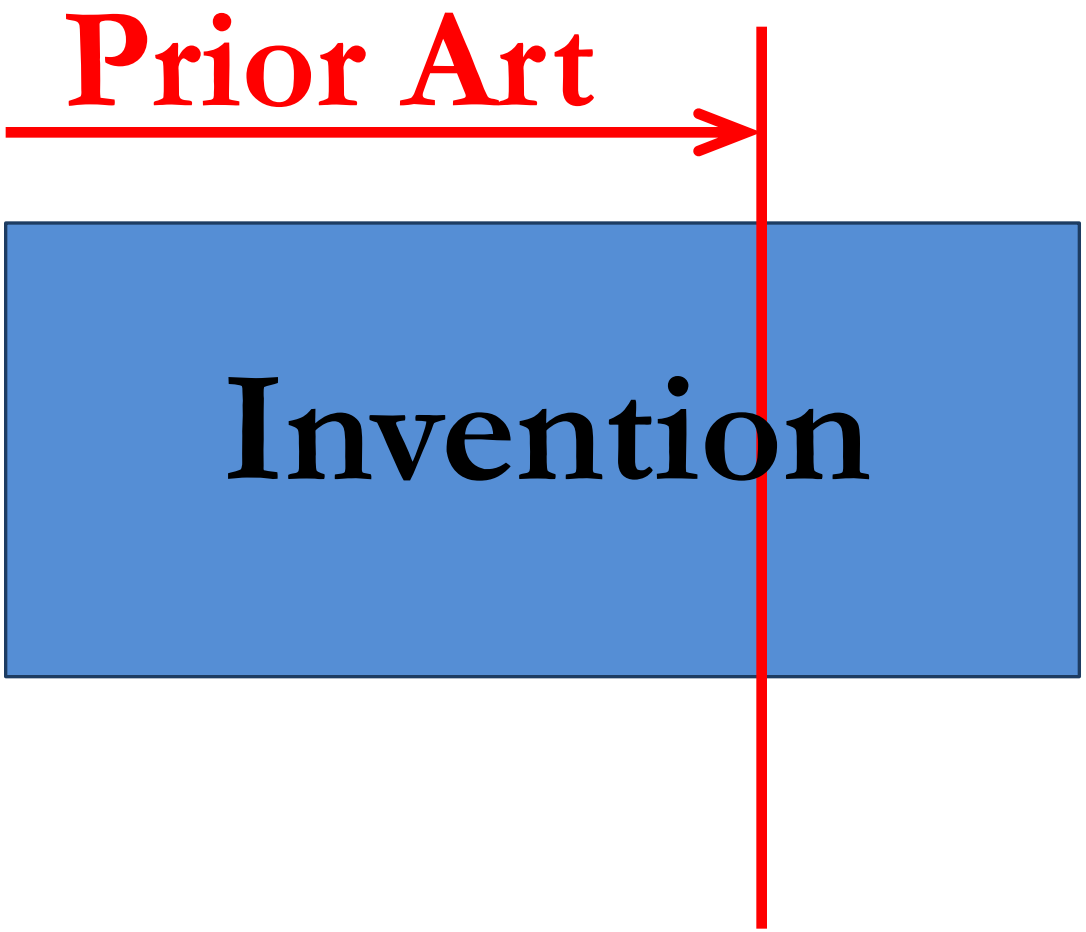
- is a person with *practical* experience in the field to which the invention relates

- can be a team of persons, for example, a drug development team

- will bring reasonable intelligence to bear on the meaning of the specification and will not adopt an attitude of "studied obtuseness"

SOUTH AFRICA

STARTING POINT IN PRIOR ART



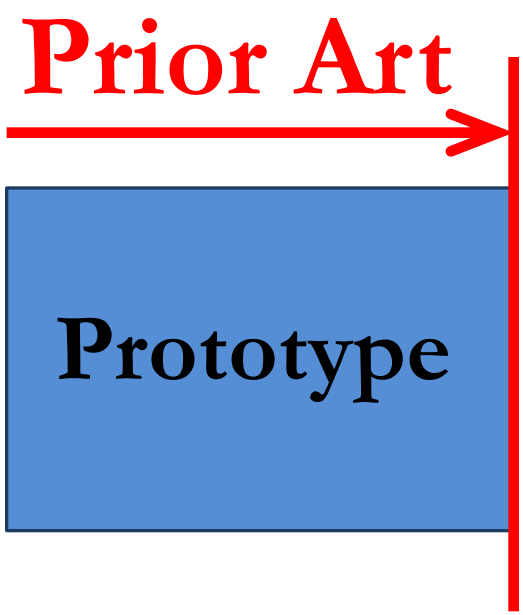
CLOSEST PRIOR ART

The art most closely related to the claimed invention,

- be a technology in the same field
- its technical problem to be solved, technical effects, or intended use are the closest to the claimed invention
- and/or disclosed the greatest number of technical features of the claimed invention
- or a technology despite being in different field, capable of performing the function of the invention and disclosed the greatest number of features of the invention
- when determining the closest, prior art in the same or similar field should be first taken into account

CHINA

CLOSEST PRIOR ART

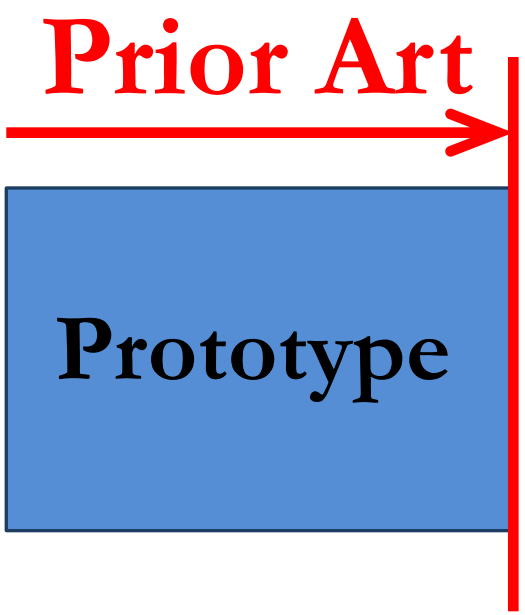


Closest Prior Art (Prototype)

- Disclose all features either in explicit or implicit manner (Draft Patent Manual)
- Generic disclosure ***incapable*** of anticipating, however specific disclosure ***anticipates*** (Draft Patent Manual)
- **Practice –** Prior art disadvantages to be disclosed in the background art section

INDIA

CLOSEST PRIOR ART



Closest Prior Art (Prototype)

- Same purpose means
- Same structure solution

- Disclosed in a written document
  - Patent Regulations: "…specification shall include ***bibliographic data*** of information source disclosing the closest art
- Has the closest combination of features to invention

RUSSIA

CLOSEST PRIOR ART

Although the test for inventiveness is a structured inquiry the test ***is not structured*** in a way that requires:

- application of a closest prior art starting point

- problem-solution approach

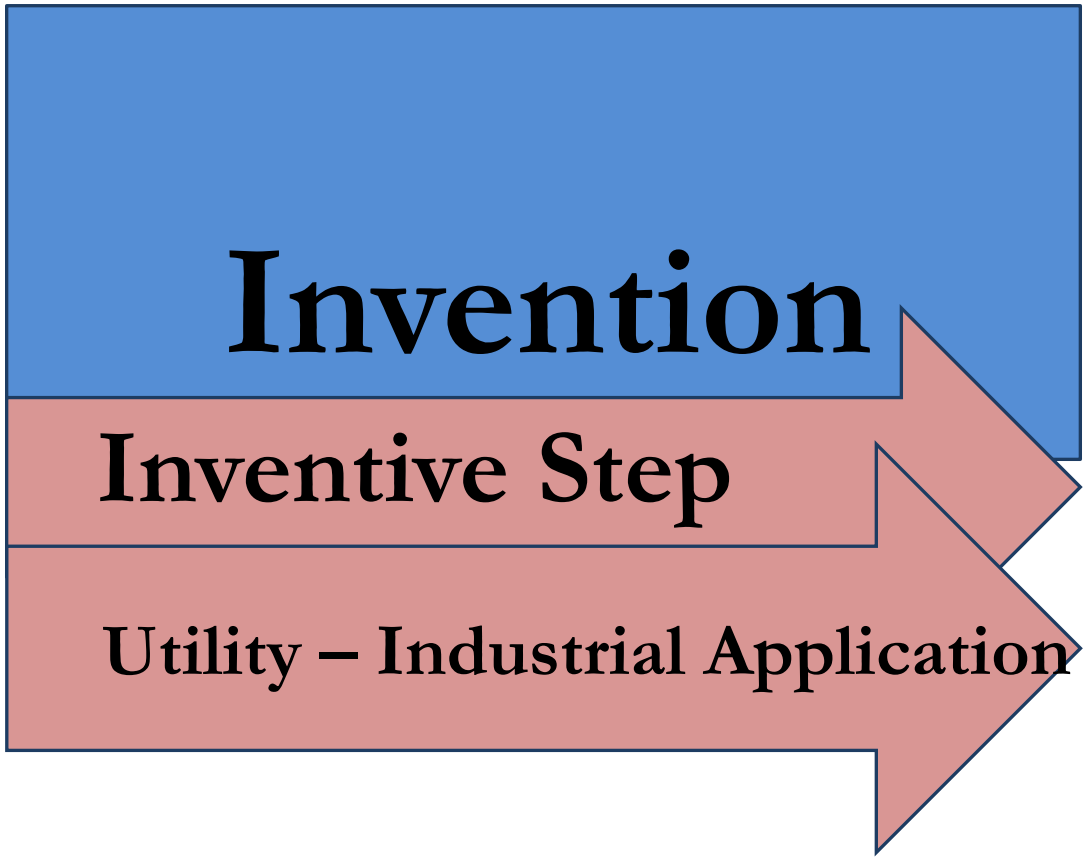
SOUTH AFRICA

SCHEMES OF INVENTIVE STEP EXAMINATION

INDIA

GENERAL IDEA

"Invention" means a new product or process involving an *inventive step* and capable of *industrial application*



INVENTIVE STEP

Inventive Step is defined as a *non-obvious* technical advancement or economic significance

INVENTIVE LEVEL EXAMINATION

(i) Consider the invention as a whole

(ii) Determine the closest prior art or a mosaic of enabling prior arts

(iii) Select the features differing from the closest art

(iv) Determine whether combination of different features is possible

(v) Consider whether the features in solutions at *(iii) and (iv)* provide for reaching the same technical result as invention

INVENTIVE OR NOT INVENTIVE?

Inventive

Features characterizing invention ***are not known*** from prior

Features characterizing invention are known from prior art but ***invention shows enabling technical advance***

Not Inventive

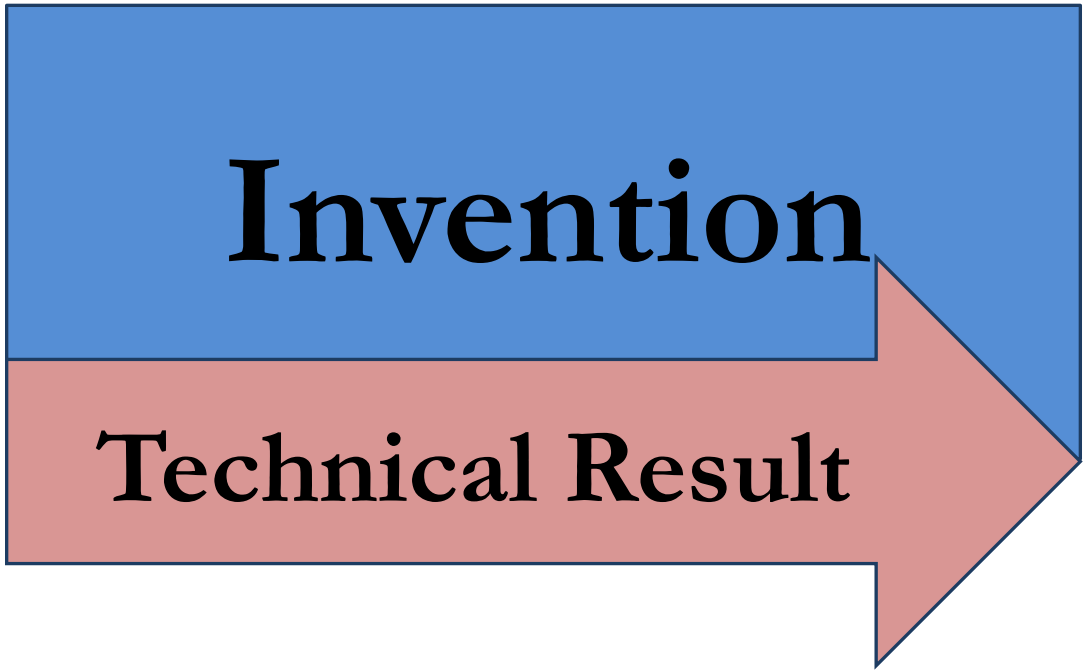
Features characterizing invention are known from prior art and ***no technical advance***

Features characterizing invention are known from prior art ***and merely verify previous knowledge without any technical advance***

RUSSIA

GENERAL IDEA

Invention shall be always associated with technical result(s) it provides



TECHNICAL RESULT IS…

…a characteristic of technical effect, phenomenon, property etc. ***objectively exhibited*** *when a method is executed or a product is made or used …*

INVENTIVE LEVEL EXAMINATION

(i) determining the closest prior art

(ii) selecting the features differing from the closest art

(iii) determining the prior art solutions having same features as the differing

(iv) considering whether the features in solutions at **(iii)** provide for reaching the same technical result as invention

INVENTIVE OR NOT INVENTIVE?

Inventive

Features characterizing invention ***are not known*** from prior

Features characterizing invention are known from prior art but ***invention technical result is different***

Not Inventive

Features characterizing invention are known from prior and ***invention technical result is same***

Features characterizing invention are known from prior art ***and invention technical result is not mentioned or irrelevant***

RECOMMENDATIONS ON EXAMINATION

- “Recommendations on Questions of Invention and Utility Model Applications Examination”
  - Not a legal act
  - Not a Guidelines

Russian PTO internal document containing exemplary approaches and situations

ANOTHER APPROACH

- **Section “Examples of Inventiveness Assessment”**

  - Inventiveness may be examined ***without*** “technical result” algorithm

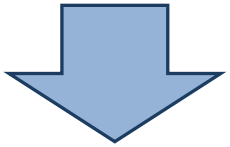
    Mainly – when closest prior art cannot be defined

    Example: very narrow definition of the purpose in generic concept

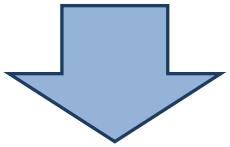
    e.g. *“Method for transporting flat paper pieces in the zone of their stacking, wherein …”*

INVENTIVENESS EXAMINATION

Did the problem exist?



How it was solved?



What does closets art contain?

HOWEVER …

The last paragraph of the

“Examples of Inventiveness Assessment”:

“The described method of inventiveness examination is more difficult comparing to the “traditional” and does not exclude certain prejudication …”

NON-ADMISSIBLE AMENDMENTS

Starting from October 01, 2014:

Introducing *new* technical result *not associated* with mentioned in the original application

RUSSIA

NOT INVENTIVE!

Inventive

Features characterizing invention ***are not known*** from prior

Features characterizing invention are known from prior art but ***invention technical result is different***

Not Inventive

Features characterizing invention are known from prior and ***invention technical result is same***

Features characterizing invention are known from prior art ***and invention technical result is not mentioned or irrelevant***

RUSSIA

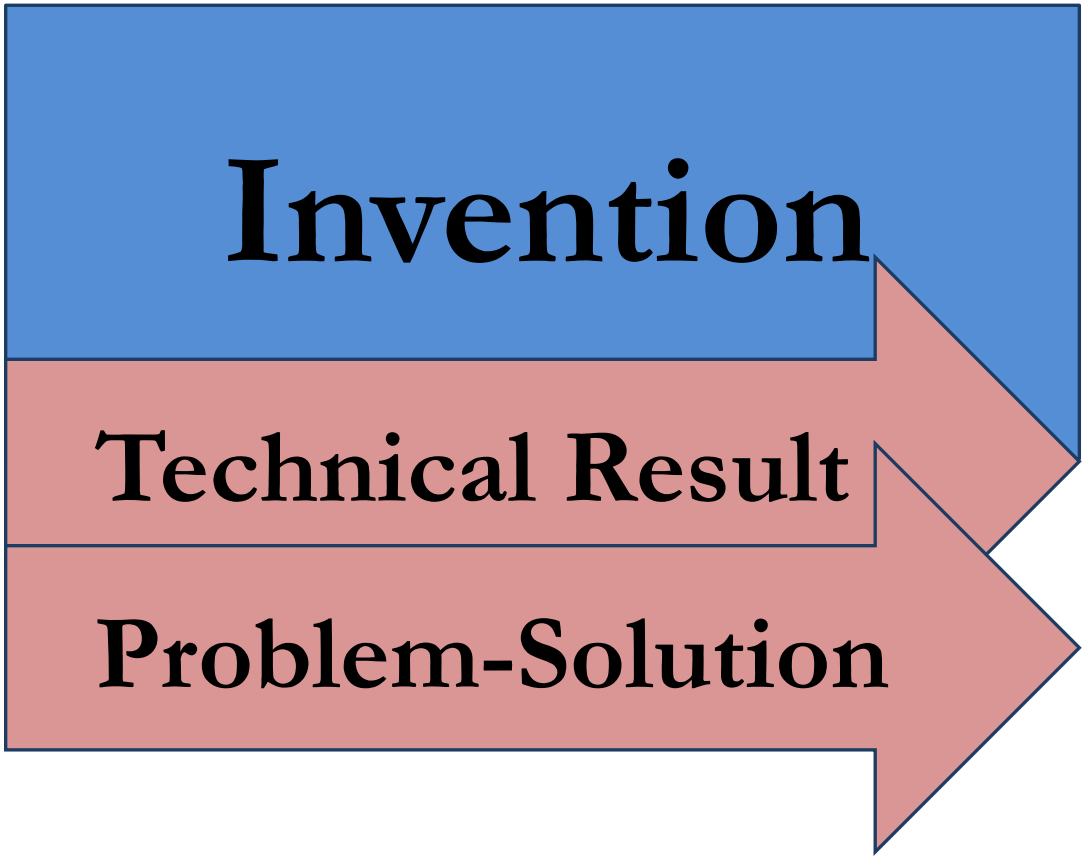
CHINA

SCHEME OF CONSIDERATION

Approach to assess inventiveness

- Determining the closest prior art
- Determining the distinguishing features of the invention and the technical problem actually solved by the invention
- Determining whether or not the claimed invention is obvious to a person skilled in the art

GENERAL IDEA ?



SOUTH AFRICA

THE ADJUDICATION FORUM

- No substantive examination

- Inventive step determined in Court proceedings where witnesses are subjected to cross examination

- Onus rests on objector to prove lack of inventive step

THE TEST

(1) What is the inventive step said to be involved in the patent in suit?

(2) What was, at the priority date, the state of the art (as statutorily defined) relevant to that step?

(3) In what respect does the step go beyond, or differ from, that state of the art?

(4) Having regard to such development or difference, would the taking of the step be obvious to the skilled man? ”

TEST CONTINUED

- Inventive step determined in relation to claim not the stated inventive step in the body of the specification

- “Obvious to try” test in UK part of our law (prejudice)

- Problem-solution approach not part of our law

SUMMARIZING – WHAT TYPE?

"Problem-Solution"

- Result-Problem-Solution or
  - Problem and Result-Solution

- Attempt to fix on some objective "key tool" – more relying on regulatory routines

"Apparent Difference"

- More relying on personalities: "skilled in art" and examiner?

SCARY AND LUCKY STORIES

1) Can invention rejected on lack of inventiveness in other jurisdiction be validly granted basing on same prior art?

2) Can invention granted in another jurisdiction be rejected basing on same prior art?

3) What if the jurisdiction in 1) and 2) is EPO?

CONCLUDING

- Despite ongoing harmonization – still local
- Legal acts only attempting to define in detail
- As such subjective and can hardly be another
- Requires broad knowledge of local practice
- May bring surprises (of “+” and “–” kind)

THANK YOU FOR ATTENTION!