

## Standing Committee on the Law of Patents

**Nineteenth Session**  
**Geneva, February 25 to 28, 2013**

### PROPOSAL OF THE DELEGATION OF SPAIN FOR THE IMPROVEMENT OF UNDERSTANDING OF THE REQUIREMENT OF INVENTIVE STEP

*Document prepared by the Secretariat*

1. The Annex to this document contains a proposal submitted by the Delegation of Spain concerning the improvement of understanding of the requirement of inventive step, for consideration under item 6 of the draft agenda: Quality of patents, including opposition systems.

2. *The members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

## **PROPOSAL OF THE DELEGATION OF SPAIN FOR THE IMPROVEMENT OF UNDERSTANDING OF THE REQUIREMENT OF INVENTIVE STEP**

### INTRODUCTION

1. Ever since the 16th session of the Standing Committee on the Law of Patents (SCP), the topic “Quality of Patents, including Opposition Systems” has remained on the agenda of the Committee.
2. The first proposal relating to this topic was submitted by the Delegations of Canada and the United Kingdom (SCP/16/5).
3. This proposal is being submitted under the sub-item entitled “Process improvement” contained in document SCP/17/8, more specifically in paragraph 17 thereof.
4. The subject of this document is a proposal concerning the carrying-out of a series of studies, coordinated by the WIPO Secretariat and in cooperation with experts and/or Member States of the Committee, designed to improve understanding of inventive step as a patentability requirement.
5. Most professionals in the world of patents agree that the evaluation of inventive step is the most controversial and arduous aspect of the patentability requirement evaluation process.
6. Within this Committee, a significant number of Member States have reiterated their opposition to the harmonization of patent legislation. However, bar a few minor differences, the definition of the requirement of inventive step is very similar in most legislations. Therefore, there would not seem to be a pressing need to harmonize national and regional patent legislations in this regard. This proposal is not in any way whatsoever an attempt to achieve harmonization concerning any aspect of inventive step, be it the definition of the requirement itself or of a number of the elements involved in its evaluation, such as the figure of the ‘person skilled in the art’ or the ‘state of the art’, the level of inventive step or the methods of evaluation employed in the various Member States. Rather, the aim of the proposal is to improve knowledge of inventive step.
7. This document will focus on the following aspects:
  - I. Introduction to the concept of inventive step and its evaluation.
  - II. Differences in terms of the levels of inventive step.
  - III. Study proposal.

### I. INTRODUCTION TO THE CONCEPT OF INVENTIVE STEP AND ITS EVALUATION

8. Inventive step is one of the three patentability requirements employed in the majority of the States with regard to inventions for which patents are being sought by their owners. In the United States of America, inventive step is known as “non-obviousness”.
9. Unlike the other patentability requirements, ‘inventive step’ has not always been contained in the various national patent legislations, being incorporated therein during the course of the twentieth century.

10. Of all the patentability requirements, it is inventive step that is the most complicated to evaluate. This is because of the very nature of the requirement: essentially, evaluation of inventive step involves attempting to determine whether a given invention is obvious to a person skilled in the art having regard to the state of the art at the filing date of the relevant patent application.

11. The evaluation of the requirement of inventive step is determined by the definition of 'person skilled in the art' and 'state of the art'. The 'state of the art' is also employed when determining the requirement of novelty, although, in certain states, its content varies according to whether one requirement or another is being evaluated. However, the figure of the 'person skilled in the art' may be deemed to be almost exclusive to the requirement of inventive step and its definition is a determining factor in the evaluation of the requirement. In certain states, the person skilled in the art is deemed not to possess any inventive capacity whatsoever, whereas the legislations of other countries allow for him to have a certain level of capacity.

12. The outcome of the evaluation of inventive step depends on the definition of the hypothetical figure of the 'person skilled in the art'. Thus, there is a need for a study on the definitions of 'person skilled in the art' employed in the various Member States, be it in legislation, guidelines or case law.

13. Various methods of evaluating the requirement of inventive step in as objective a manner as possible have been developed. Examples of methods include the 'problem-and-solution approach' of the European Patent Office (EPO), the so-called 'Graham factors', defined by the case law of the United States of America, and a number of other systems developed in the examination guidelines and legal rulings of various countries.

14. It would be interesting to see a detailed analysis of the various methods employed in the evaluation of inventive step. Such a study should not be carried out with a view to harmonization but rather in order to set out the advantages and disadvantages of each method. Thus, the various national patent offices would be able to determine which method should be employed, depending on the circumstances of each invention. Consequently, the methods by which offices grant patents could be improved, with the aim of ensuring appropriate levels of quality.

## II. DIFFERENCES IN TERMS OF THE LEVELS OF INVENTIVE STEP

15. Of the three patentability requirements traditionally applied to inventions for which a patent has been applied, it is inventive step that allows states and their national patent offices the greatest room for maneuver. In fact, the process of obtaining a patent may be rendered easier or more difficult by the definition of the requirement, intervening elements and their methods of evaluation, either through legislation or examination guidelines.

16. A low level of inventive activity means that exclusive rights over small improvements may be obtained at the risk of limiting the business activities of third parties.

17. A very high level of inventive activity means that exclusive rights might not be granted concerning potentially deserving inventions, or that only extremely limited exclusive rights might be granted, blocking investment and research.

18. Certain national offices adopt the approach of granting patents in cases where doubt exists concerning inventive step and leaving it to the courts to make the final decision as to the validity of the patent in cases in which a third party has submitted a complaint.

19. A comparative study on the different existing levels of inventive step would be of interest. Such a study should not be carried out with a view to harmonization but should, rather, have a very practical focus, providing a large number of examples and examining cases in which the evaluation of inventive step has led to differing outcomes in various Member States.

### III. STUDY PROPOSAL

20. In the view of the Spanish Patent and Trademark Office (OEPM), all Member States, regardless of their level of development, have an interest in improving knowledge concerning the requirement of inventive step, as do users and society in general.

21. In order to be effective, patents must meet the patentability requirements and must only be granted for deserving inventions.

22. In order to improve knowledge concerning the requirement of inventive step among the Member States, the Spanish Patent and Trademark Office (OEPM) proposes that studies coordinated by the WIPO Secretariat should be carried out in cooperation with the Member States and/or experts on:

- the definition of the person skilled in the art as a key figure in the evaluation of inventive step;
- the methods employed to evaluate inventive step;
- differences in terms of the level of inventive step required.

If deemed to be appropriate, a single study could be envisaged that would cover all the various aspects. As a part of said study, a questionnaire could be approved in which the representatives of the various Member States would respond to questions relating to the way in which these issues are dealt with in their respective countries.

[End of Annex and of document]