

Standing Committee on the Law of Patents

Thirtieth Session
Geneva, June 24 to 27, 2019

ADDENDUM: FURTHER STUDY ON INVENTIVE STEP (PART III)

Document prepared by the Secretariat

In document SCP/30/4:

- (i) between paragraphs 53 and 54, a new paragraph should be added, as follows:

“Portugal

When a new chemical compound has a similar structure to known chemical compounds, the new chemical compound is considered obvious, if the skilled person knew, either from common general knowledge or from some specific disclosure, that the existing structural differences of the chemical compounds concerned were so small that they would have no essential influence on those properties, which were responsible for the unexpected technical effect and for solving said technical problem and could be ignored.”

- (ii) between paragraphs 79 and 80, the following new paragraph should be inserted:

“Portugal

If an enantiomer has the same pharmacological activity as the already known racemic mixture and does not exhibit an unexpected effect, the enantiomer invention lacks inventive step.”

(iii) between paragraphs 106 and 107, a new paragraph should be added, as follows:

“Portugal

In the absence of any unexpected property, the simple provision of a crystalline form of a pharmaceutically active compound already known could not be regarded as involving an inventive step.”

(iv) at the end of paragraph 198, the following sentences should be inserted:

“The submission by Portugal to the SCP notes that in Markush claims, the unexpected technical effect could only be taken into account in the assessment of inventive step, if it is achieved by all the chemical compounds claimed. If only some compounds claimed (and not all) exhibit a particular technical effect, the alleged technical effect of some of the claimed compounds is ignored when determining the objective problem underlying the invention and thus when assessing inventive step.”

[End of document]