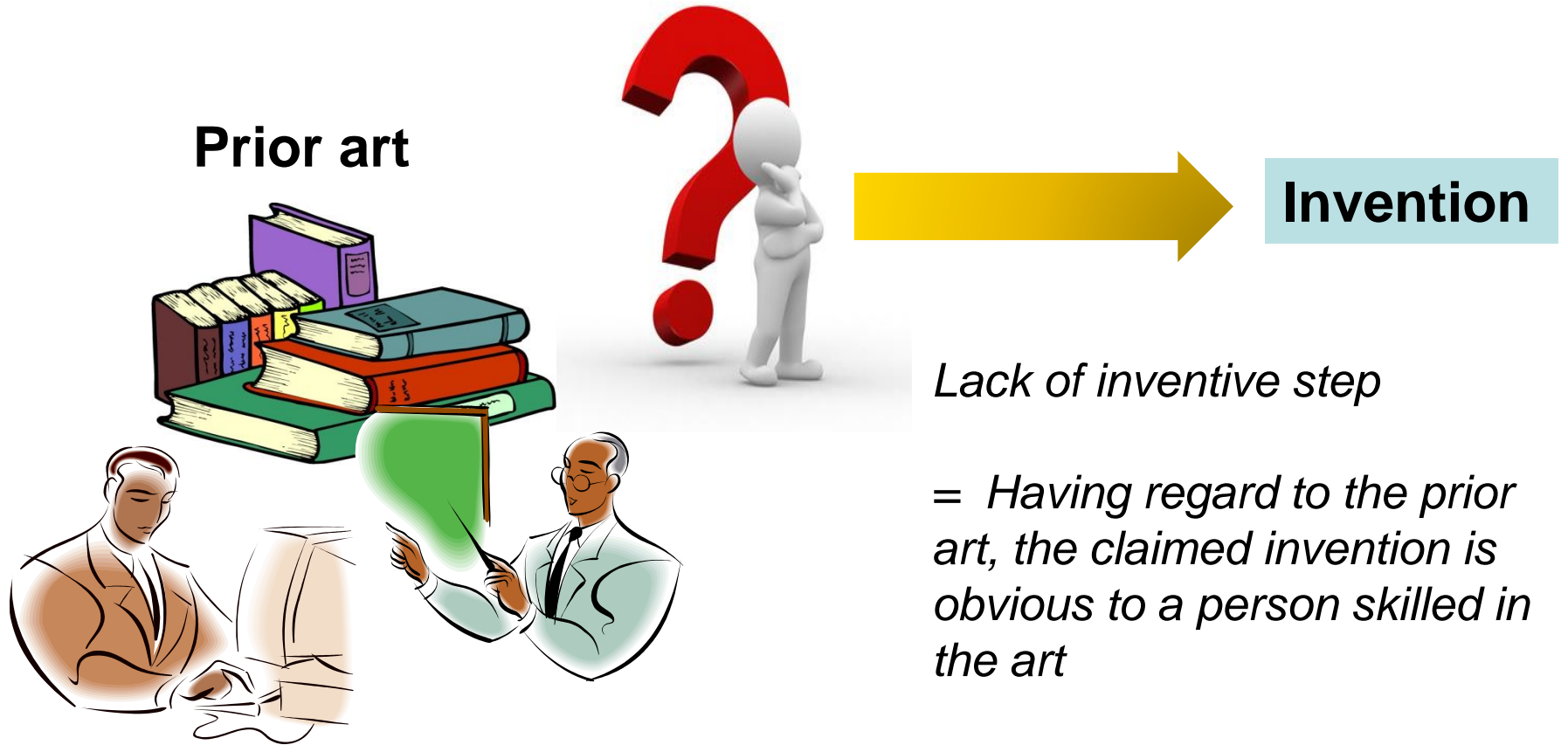


# **Further Study on Inventive Step (Part III)**

Standing Committee on the Law of Patents (SCP)  
Thirtieth session (June 24 to 27, 2019)

**Presentation by the Secretariat**

# Inventive Step



# Recent studies on inventive step

## Study on inventive step (SCP/22/3)

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

## Further study on inventive step (Part I) (SCP/28/4)

- Common general knowledge: its combination with the state of the art
- Combination: juxtaposition vs synergetic effects
- Danger of hindsight analysis

## Further study on inventive step (Part II) (SCP/29/4)

- Secondary indicia
- Selection inventions
- Problem inventions

# SCP/30/4: Further Study on Inventive Step (Part III)

## Assessment of inventive step in the chemical sector

- ❑ Taking the information provided by MSs into account (available on the SCP electronic forum website: <http://www.wipo.int/scp/en/>)
- ❑ A collection of factual information without analysis or recommendation
- ❑ Examples of inventive step assessment relating to chemistry inventions

# Assessment of inventive step in the chemical sector

- ❑ General principles, guidance and methodologies applicable to chemistry inventions
  - ❑ Adaptation of general guidance to chemistry inventions
- ❑ Supplementary guidance by some IP offices
  - ❑ Compilation of examples relating to chemistry inventions

## *Chemistry*

- *Experimental art*
- *Technical characteristics and utility is not always predictable.*
- *A manufacturing/synthesizing process is not always anticipated from a (chemical) structure only.*

# Assessment of inventive step in the chemical sector

*Perspective from inventive step methodologies and general guiding principles*

- The claimed invention as a whole would have been obvious by a person skilled in the art [Part A]
- Enabling prior art [Part B and C]
- Obvious to try (whether a person skilled in the art would carry out certain steps with reasonable expectation of success) [Part D]
- Combination and synergetic effects [Part G]
- Selection of species, a range, a size etc. [Part M, Part I]

# Assessment of inventive step in the chemical sector

## *Perspective from the claimed chemical inventions*

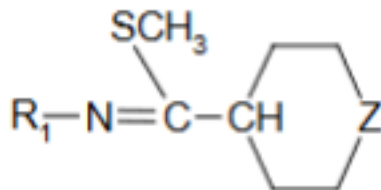
- ❑ A new chemical compound having a structural similarity with a prior art compound [Part E]
  - ❑ Consideration given to predictability of chemical property, utility, advantages, technical effects of the claimed invention
  - ❑ Isomers, enantiomers, esters...
- ❑ New polymorphic forms and crystalline of a known compound [Part F]
- ❑ New dosage and formulation of a known medicine [Part H]
- ❑ New use of a known compound [Part J]
- ❑ Use of catalyst [Part K]
- ❑ Intermediates [Part L]

# Assessment of inventive step in the chemical sector

## □ Markush claims [Part L]

- A single claim covering a list of alternatives  
“X selected from the group consisting of a, b, c and d”

ex. Claim 1. A compound of the formula:



wherein R<sub>1</sub> is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy and methyl; Z is selected from the group consisting of oxygen (O), sulfur (S), imino (NH) and methylene (-CH<sub>2</sub>-).

- One type of claiming format



Thank you.