

Information provided by Austria on the requirements of inventive step and sufficiency of disclosure

Inventive Step

(i) the definition of a person skilled in the art

The person skilled in the art has a long lasting experience in the specified field of technology and has an average overview on the present and continuing developments in this specified field of technology.

The person skilled in the art is able to solve technological tasks/duties/problems based on his/her experience, knowledge and the principles of logical, rational reasons and decisions.

(ii) methodologies employed for evaluating the inventive step.

Questions which must be answered negative for having an indication for an inventive step:

1. Would the person skilled in the art have classified/chosen the proposed technological invention to solve the technological tasks/duties/problems of the application as self-evident?
2. Is the chosen technology method of the solution within the possible solution space/solution portfolio of the person skilled in the art in this specific technological field?
3. Would the person skilled in the art be able to find/invent the chosen technology method of the disclosed solution of the application easily/without circumstances by the principles of logical, rational reasons and decisions based on his/her experience and knowledge?

(iii) having regard to the prior art, the level of inventiveness (obviousness) to meet the invention step requirement.

The level of inventiveness is distinguished from the prior art in this way that the invention step deviates spontaneous from the broad path of possible technological solutions or is a change of paradigms in the specific technological field and tread a new path beyond the ordinary ways which would have been found/chosen/selected by the person skilled in the art.

Sufficient Disclosure

(i) enabling the disclosure requirement

The invention must be described in such a detailed way that the person skilled in the art is able to understand and to realise this invention based on his/her experience, knowledge and the principles of logical, rational reasons and decisions.

(ii) support requirement

If an application contains figures/drawings, the contained technological features of these figures/drawings - being clear, easy visible and comprehensible disclosed to the person skilled in the art - will be treated equally to the technological features disclosed in the description of the application.

If an invention involves the use of or concerns biological material, which is not available to the public and which cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall be regarded as disclosed only:

1. if the biological material has been deposited with a recognized depository institution as defined by the Budapest Treaty not later than on the day of filing,
2. if the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material deposited, and
3. if the name of the depository institution and the accession number of the deposit have been stated in the application.

(iii) written description requirement

The technological features and the meaning of the text and the description itself have to follow these mandatory regulations:

1. written in our national official language,
2. according to the latest published grammar and dictionary standard of it,
3. clear in the meaning/unambiguous/without any chance of interpret or doubt,
4. the sentences and subordinate clause are clear in the order and easy comprehensible/without any nested sentences,
5. uses common/known technical terms and expressions for the technological features in the field of technology of the invention/application,
6. uses the International System of Units (accepted SI-Units),
7. do not contain trademarks or fancy names,
8. the length of the description has to be in certain relation to the complexity of the invention/application – in anyway brief!

The relevant **legal provisions** regarding inventive step and sufficiency of disclosure are the following:

Austrian Patent Law 1970

Patentable Inventions

Art 1. (1) On request, patents shall be granted for inventions in all fields of technology, provided that they are new (section 3), not obvious to the person skilled in the art from the state of the art, and susceptible of industrial application.

Novelty

Art 3. (1) An invention shall be considered to be new if it does not form part of the state of the art. The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the priority date of the application.

(2) Additionally, the contents of earlier priority date

1. patent applications based on this Federal Law,

2. utility model applications based on the Utility Model Law, Federal Law Gazette No. 211/1994,

3. international applications within the meaning of section 1 no.6 of the Law Introducing Patent Treaties, Federal Law Gazette No. 52/1979, if the conditions pursuant to section 16 (2) of the aforementioned law are fulfilled,

4. European patent applications within the meaning of section 1 no.4 of the Law Introducing Patent Treaties, and

5. European patent applications within the meaning of section 1 no.4 of the Law Introducing Patent Treaties, if the European patent application emerged from an international patent application, but only insofar as the conditions of Article 153 (5) of the European Patent Convention, Federal Law Gazette No. 350/1979 are fulfilled,

in the originally filed version, whose contents was officially published only on the priority date of the later application or thereafter, shall also be considered as comprised in the state of the art. Such earlier applications shall not be taken into account when assessing the question, whether the invention was not obvious from the state of the art to a person skilled in the art.

Disclosure

Art. 87a. (1) The patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

(2) If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall be regarded as disclosed under subsection 1 only, if

1. the biological material has been deposited with a recognized depository institution as defined by the Budapest Treaty not later than on the day of filing,

2. the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material deposited, and

3. the name of the depository institution and the accession number of the deposit have been stated in the application.

(3) The information referred to in subsection 2 no.3 may be submitted

1. within sixteen months after the day of filing or, if a priority has been claimed, after the priority date, or

2. up to the day of submission of a request for an earlier publication of the application, or

3. within one month after the Patent Office has informed the applicant that the right to inspect the files under section 81 (3) exists,

whereas the ruling period shall be the one which is the first to expire.

Art 91. (1) The patent claims shall, in a clear and distinguishing manner, define the matter for which protection is sought. They shall be supported by the description.

(2) The abstract shall contain a concise summary of the disclosure contained in the application. It shall merely serve as a technical information and shall not be used for any other purpose, in particular not for determining the scope of protection.

Furthermore the following link <http://www.patentamt.at/Media/PA144.pdf> provides for a **guide for applicants of patents or utility models** (available just in German being the only accepted national official language). Information regarding inventive step and disclosure requirement can be found on pages 11f and 20f.