

SIC (SUPERINTENDENCE OF TRADE AND COMMENRCE) COMMENTS

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LEGISLATION AND GUIDELINES

1. Inventive Step:

Topic	<u>Legislation</u> Decision 486 of the Andean Community, 2000	<u>Manual and Test Guidelines for patent applications</u> Informative review of form and content of patents applications and utility models. PI02-I06 of SIC
(i) Definition of person skilled in the field	<p>Article 18.</p> <p><i>An invention shall be regarded as involving an inventive step if, for <u>a person in the trade with average skills in the technical field concerned</u>, the said invention is neither obvious nor obviously derived from the state of the art.</i></p>	<p>2.13.4 Person in the trade with average skills in the field</p> <p><i>“The person in the trade with average skills in the field” is a fiction that is used to designate a person whose knowledge and skills will provide a basis for assessing whether the claimed solution involves an inventive step. It is assumed that a person with normal skills in the art has the average knowledge in the specific technical field of the invention, but is not specialized, performs his duties normally, has the average skills and is aware of the common general knowledge in the art (information contained in monographs, dictionaries, textbooks, etc.), on the date of filing or priority of the</i></p>



		<p>application. Such a person also has access to the knowledge of the “state of the art”, in particular the documents cited in the international search report, and has had at his disposal the normal means and capacity for routine experimentation.”</p>
<p>(ii) Methodologies employed for evaluating inventive step</p>	<p>Article 28(c) “a description of the invention in such a way that the technical problem and the solution provided by the invention may be understood, explaining the differences and possible advantages with respect to previous technology”;</p>	<p>2.13.5.1 Problem-solution method: “During the examination of inventive step, a value judgment should be made and an objective analysis of previous disclosures of the prior art, not influenced by the knowledge already acquired of the invention being evaluated. Therefore, in order to minimize subjectivity and prevent a retrospective analysis (“hindsight” or “a posteriori”), the examination must relate the invention with the solving of a technical problem, through the “problem-solution method.” This consists of the following stages:</p> <ul style="list-style-type: none"> - identifying the state of the prior art closest to the claimed invention; - determining the difference between the invention and close prior art; - defining the

		<p><i>technical effect caused and attributable to the differential element;</i></p> <ul style="list-style-type: none"> - <i>deducing the objective technical problem; and</i> - <i>assessing whether, starting from the close prior art and objective technical problem, the claimed invention, would have been obvious to a person of ordinary skill in the art.</i> <p><i>If the answer is yes, the invention is considered obvious and therefore it is concluded that there is no inventive step. But if the answer is no, the invention is not obvious and is considered to have an inventive step.”</i></p>
<p>(iii) Having regard to the prior art, the level of inventiveness (obviousness) to meet the inventive step requirement</p>	<p>Article 18</p> <p><i>An invention shall be regarded as involving an inventive step if, for a person in the trade with average skills in the technical field concerned, <u>the said invention is neither obvious nor obviously derived from the state of the art.</u></i></p>	<p>2.13.3. Obviousness</p> <p><i>The term “obvious” means that something is not beyond the progress of technology, but simply and logically follows the normal progress of technology, for example, something that does not involve the exercise of any skill beyond that which would be expected of a person with normal skills in the art.”</i></p>

Sufficiency of disclosure

Topic	<p align="center"><u>Legislation</u> Decision 486 of the Andean Community, 2000</p>	<p align="center"><u>Manual and Test Guidelines for patent applications</u> Informative review of form and content of patents applications and utility models. PI02- 106 of SIC</p>
	<p>Article 28.</p> <p><i>The description of the invention shall be sufficiently clear and complete to be understood and for the invention to be carried out by a person skilled in the art.</i></p> <p>Decree No. 728 of 2012, regulating Decision 486 of the Andean Community, includes a paragraph in Article 28, which provides a clearer idea of how the significance of sufficient disclosure is construed:</p> <p>Article 28(e)</p> <p>“a description of the best method known to the applicant for carrying out the invention, using examples and references to the drawings, if relevant”</p>	<p>2.7 Description</p> <p>“... The examiner should be aware that the patent application should include a description of the invention that is clear, <u>so that a person with normal skills in the art can understand what the technical problem to be solved and what the solution offered by the application are, so that it can be put into practice.</u>”</p>

(ii) Support requirement	<p><u>The description of the invention shall be sufficiently clear and complete to be understood</u> and for the invention to be carried out by a person skilled in the art.</p>	<p>2.7.1 Clarity The rationale or purpose of the invention shall be described clearly in the application. To comply with the clarity requirement, “... the description should include only those details that are really necessary to define and understand the invention and its various forms.”</p>
(iii) Written description requirement	<p>Article 28. “a description of the invention in such a way that the technical problem and the solution provided by the invention may be understood, explaining the differences and possible advantages with respect to previous technology;”</p>	<p>2.7.1 Clarity “<u>The description should be written in the common language of the technical field to which the invention pertains.</u> If a term has a meaning than is different from the one commonly understood in the technical field, this must be indicated, and signs and symbols accepted in the field in question should be used for mathematical and chemical formulas</p>

LEGAL PROVISIONS

1. Inventive Step

Court of Justice of the Andean Community. Case No. 43-IP-2014

Inventive step

1. *In accordance with Article 18 of Decision 486, an invention has novelty if it is neither obviously derived from the prior art nor is obvious to a person skilled in the art. This requirement affords*



the examiner the leeway to determine whether, with the expertise that existed at the time of the invention, it could have been possible to arrive at the invention by obvious means, or whether the result would have been obvious to one of ordinary skill in the art in question, that is, for a person with normal skills in the corresponding technical field.

2. Accordingly, the Court of Justice of the Andean Community has held as follows:

“With the inventive step requirement, the aim is to provide the technical examiner with an element that allows him to state whether or not the invention under examination would not have been possible from the expertise that existed at that time within the prior art [...]. At this point, it should be noted that one is the examination by the average technician of the novelty and another concerns the inventive step; although both use the 'state of the art' as the benchmark, the former compares the invention with the “prior art” existing within that invention, each (sic) separately, while the latter (inventive step) requires that the average technician performing the test must start from his general knowledge of the state of the art and perform a comparison with his overall assessment, determining whether, with such existing expertise, this invention has or has not occurred”. (Case No. 12-IP-98. Preliminary Interpretation of May 20, 1998, published in the Official Gazette of the Cartagena Agreement No. 428 of April 16, 1999).

3. However, for the purposes of Article 18 of Decision 486, it is worthwhile to define what is meant by “obvious” or “evident” and, consequently, determine what is meant by inventive step.
4. What is obvious is “found or placed before the eyes; clear or without difficulty. What is evident is “clear and manifest certainty which cannot be doubted.”¹ As is apparent, what is obvious is not necessarily evident; however, what is evident is also obvious.
5. In this vein, it can be concluded that an invention has an inventive step when the eyes of an average expert in the field, it requires more than simply applying expertise in the field to achieve it, namely, that in accordance with the state of the art, the invention is not the clear and direct consequence of this

¹ Dictionary of Spanish, 22nd ed. Madrid, Spain, 2001. DEFINITIONS OF EVIDENT, EVIDENCE AND OBVIOUS, pp. 686 and 1089.

state, it represents a step or qualitative leap in the development of the technical rule.

6. *The Manual for the Examination of Patents Applications in Industrial Property Offices of Andean Community Countries establishes certain criteria to determine inventive step which are well worth recalling:*

“Inventiveness is considered to be a creative process whose results are not obviously deduced from prior art in the view of a person with average skill in the art at the date of filing of the application or the recognized priority.

The question the examiner must answer is whether the claimed invention is not obvious to a skilled person. The existence or lack of any technical advantage is not an absolute criterion for recognizing or not recognizing inventiveness. The examiner should not determine which “quantity” of inventiveness exists. The inventive step either exists or does not, there are no intermediate answers.

The examiner should not rely on personal assessments; any objection concerning the lack of inventiveness of an invention must be tested from the prior art.

To judge whether the invention defined by the claims actually derives in an obvious manner from the state of the art, it is essential to determine whether there is a lack of inventiveness when considering the differences between it and the state of the closest prior art. The examiner has the burden of proving that the invention lacks inventiveness and should not merely confine his examination to the differences between the patent application and said prior art.

When lack of novelty of the invention is established, it is not necessary to evaluate its inventiveness, since there are no differences between the invention and the prior art.

Normally, the state of the closest prior art is in the same field as the invention or seeks to solve the same problem or a similar one. For example, in chemistry the closest prior art may be that

which describes a structurally similar product to the product of the invention or a similar activity or use for the invented product.

10.2 Method for the evaluation of inventive step

10.2.1 Problem-solution analysis

To determine if the object of the claim is obvious or obviously derived from the prior art, whenever possible, the problem-solution method should be used.

To this end, the following steps must be followed:

- Identification of the state of the closest prior art;*
- Identification of the technical characteristics of the invention that are different with respect to the above; and*
- Definition of the technical problem to be solved based on the state of the closest prior art.*

The question is: what problems are solved by the technical differences between the invention and the closest prior art?

These differences, in terms of technical features, between the invention and the closest prior art represent the solution to the technical problem.

The problem must be defined without including elements of the solution, because then the solution would be obvious.

The technical problem is not always indicated on the application and sometimes has to be re-expressed based on search results. The closest prior art, on whose basis he began his work, may differ from that known to the applicant.

The task is therefore to evaluate, starting from the closest state of the art and the technical problem, whether the claimed invention is obvious to a person skilled in the art.

The question then is whether, considering the prior art as a whole, there is any indication that leads the person skilled in the art to modify or adapt the closest prior art to solve the technical problem, such that he achieves a result that was included in the wording of the claim(s).

Technical information must always be considered in context; it should not be extracted or interpreted out of context. This means that the technical features being analyzed should be

sought in the same technical field, or in one which the person skilled in the art would consider in any case.

It should be noted that the prior art search is done a posteriori, taking as starting point the same invention. Therefore, the examiner should make the intellectual effort to place himself in the situation that a technician skilled in the art has had to face when the invention was unknown, that is, before the invention.

The claimed invention must be considered as a whole. If it consists of a combination of elements, it is not arguable that each, considered separately, is obvious, since the invention may be found in the relationship (technical features) between them. The exception to this rule is the case of juxtaposition, in which elements are combined with no technical relationship between distinct features.

A novel composition of AB, where A and B are independently known, will be inventive if there is an unexpected effect. If the effect is reduced to the sum of the effects of A and B, there is no inventive step.

In summary, the examiner should ask the following questions:

- *Was a technician with ordinary skill in the art in a position to pose the problem;*
- *To solve it in the way claimed; and*
- *To anticipate the outcome?*

If the answer is yes in all three cases, there is no inventive step.

[...]”²

7. *The consulting court shall determine whether claims 21 and 24 meet the requirement of inventiveness, and if possible, are consistent with the stipulations of subsection D of this judgment, analyze this requirement in connection with the fresh statement of claims, as expressed herein.*
8. *Now, in addition to the issue of inventive step, it is appropriate to restate the provisions of the Preliminary Interpretation of April 2, 2004, in a decision by*

² Manual for the Examination of Patents Applications in Industrial Property Offices of Andean Community Countries, World Intellectual Property Organization and European Patent Office, pp 76-78, available at <http://www.comunidadandina.org/public/patentes.pdf>

judge Leonor Perdomo Perdomo, issued in the context of Case No. 238-IP-2013:

9. *“The Court considers it important to highlight the role of technician with ordinary skill in the art, or a person trained in a technical area with ordinary or current skill in the field at issue. This presupposes the following for proper analysis of inventive level:*
 - *Analysis of inventive level should not start from the activity that a genius or a character with knowledge and instruction beyond the “normal average” would have in the subject concerned. There is an important reason for this: the point is that there should be no “obviousness” and this can only be achieved if the starting point is the standard knowledge held by an ordinary person in the respective technical field.*
 - *Analysis of inventive level in relation to a person with ordinary skill in the art, imposes the “construct” by which the examiner places himself in phase with the prior art that existed at the time of the patent application or the priority date. This is paramount, since a suitable mechanism must be generated for this to be achieved, viz., it is imperative for system efficiency to establish any appropriate setting consistent with the state of art at the time of application, so that a technician of “today” can easily go back to that time. Therefore, the patentability analysis must clearly show the above-mentioned retrospective analysis of inventive level.*

10. *In the case in point, the patentability analysis conducted by the trademark registration office must show these two elements, that is to say, it must analyze the inventiveness of the patent applied for; the concept of a person with ordinary skill in the art was used, and a retrospective inventiveness analysis was conducted.”*