

Standing Committee on the Law of Patents (SCP)

In response to the invitation contained in communication C. 8403 of December 15, 2014, we hereby submit our opinions on the topics listed below.

Inventive step

(i) Definition of skill in the art

In accordance with Article 2.5 of Law No. 6867 on patents, industrial designs and utility models, “an invention is considered to have an inventive step if, for a person with average skill in the relevant field, the invention is neither obvious nor obviously derived from the state of the relevant art” [emphasis added]. Meanwhile, the Regulations of the Law, set forth in Executive Order No. 15222-MIEM-J and its amendments, provide as follows in relation to the inventive step requirement:

To determine whether the invention has sufficient inventive step, each claim is compared to the prior art as a whole. For these purposes, a claim shall not only be compared to each existing element in the prior art, but also with those combinations and juxtapositions of elements that prove obvious or apparent to a person skilled in the relevant art [emphasis added].

The above regulation shows that Costa Rican law does not refer to a “person skilled in the art” but rather refers to a “person of average or ordinary skill in the relevant field”.

For its part, the Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic¹ states that “*a person skilled in the art is a person skilled in the technology to which the invention relates. His skill level is higher than the level of knowledge of the general public, but does not exceed that expected from a duly qualified person. He is a person with average skills, but not specialized* (page 33)”. It further states that “*the question for the examiner is whether the claimed invention is not obvious to a person skilled in the art*” (page 63).

Based on the doctrine in the matter at hand, we understand the person with average skills in the art to be a hypothetical person with ordinary skill, who is aware of what was common general knowledge in the art at the relevant date and has access to all the prior art. In some cases it is not a single person but a team of people.

(ii) Methods used for assessing inventive step

As provided in Article 19.4 of the above-mentioned Regulation, the examiner will use the Manual for the Organization and Review of Patent Applications mentioned above.

This manual advocates the problem-solution approach in assessing the requirement of inventive step (see pages 63-65), based on which three stages are followed:

¹ Accessible at:

http://www.rnp.go.cr/propiedad_industrial/Documentos/PI_Servicios_Formularios/PI_Manualpatentes.pdf

- identification of the closest prior art;
- identification of the technical characteristics of the invention that are different from the above; and
- definition of the technical problem to be solved on the basis of the state of the closest prior art.

(iii) In relation to the prior art, level of inventive step (evidence) needed to meet the inventive step requirement

In accordance with the aforementioned manual, “*the examiner shall not determine what “quantity” of inventiveness exists. The inventive step either exists or it does not; there are no intermediate answers*” (p. 63).

With the application of the problem-solution method to determine objectively the existence or otherwise of inventive step, there are no levels in fulfilling this requirement, only the result of an objective examination.

The manual also mentions that “*the examiner should not rely on personal assessments; any objection relating to the lack of inventive step of an invention must be tested from state of the art*”. (p. 63).

Sufficiency of disclosure

(i) Enabling disclosure requirement

Article 6.4 of the law on patents stipulates the following:

The description shall specify the invention in a sufficiently clear and comprehensive manner so that it can be evaluated and so that a person skilled in the relevant technical field can execute it and, in particular, the best way the applicant knows for executing the invention must be specifically indicated, providing one or more concrete examples when possible, and identifying, if any, which example would give the most satisfactory results in its industrial exploitation [emphasis added].

In the same vein, Article 7 of the Regulation stipulates the following:

1. *The description shall indicate the title of the invention and shall also:*

- (a) *Specify the technological sector to which reference is made or to which the invention is applied.*
- (b) *Indicate the prior art known to the applicant, which may be considered useful for the understanding, search and examination of the invention, identifying the previous documents and publications in which the technology is described or reflected.*
- (c) *Describe the invention in terms that allow understanding of the technical problem and the solution provided by the invention and show the advantages it would have over previous technology.*
- (d) *Briefly describe the drawings where relevant.*
- (e) *Describe the best mode provided by the applicant to execute or to put the invention into practice, using examples where appropriate and referring to the drawings.*

- (f) *Expressly indicate, when it is not obvious from the description or nature of the invention, how the invention is susceptible of industrial application and how it can be produced and used.*
- (g) *Indicate under which generic names, international nonproprietary name or common pharmaceutical name established by the World Health Organization, as applicable, the application was presented or the invention is known in other countries, where this is established.*

In this regard, the Manual for the Organization and Examination of Patent Applications states that the description performs the function of disclosure of the invention, which is why it must meet the requirements of clarity and sufficiency “... to make its understanding possible and for a person skilled in the relevant art to be able to execute it. These two requirements are complementary. The understanding of the invention allows the person skilled in the relevant field to assess the contribution of the invention to technology. Execution means to carry out the invention step by step” (p. 32).

According to the Manual, clarity in the disclosure of the invention makes it possible to understand the technical problem and the solution provided by the invention.

(ii) Support requirement

Article 6.5 of the aforementioned law states:

The text of the first claim shall determine the scope of protection. Subsequent claims shall be subordinate to the first and may relate to particular ways of implementing the invention. The description and the drawings may be used to interpret the claims, which must be clear and concise and be fully supported by the description [emphasis added].

The Manual for the Organization and Examination of Patent Applications further provides that claims “*must be clear and concise and entirely supported by the description, given that they define the invention to be protected and circumscribe the scope of that protection*” (p. 34). It adds that “*the claims must be supported by the description. This means that the object of each claim must have its basis in the description and its scope should not exceed what is warranted by the contents of the description and drawings*”(p. 43).

(iii) Written description requirement

Article 6.1 of Law No. 6867 states:

The patent application shall be filed with the Industrial Property Registry, accompanied by a description, claims, any drawings necessary for understanding the invention, and a summary of these documents.

Paragraph 5.7 of the relevant regulations states:

The application shall be accompanied by a description of the invention, claims, any corresponding drawings and a summary [...]

Attached is page 31 of the Manual for the Organization and Examination of Patent Applications, which sets forth the requirements to be met by the description of an invention.