

Response to C.8403 from the Danish Patent and Trademark Office (DKPTO) regarding Inventive Step and Sufficiency of Disclosure

	Legislation	Guidelines	Court decisions	Other inform.
Inventive step:				
(i) definition of a person skilled in the art	No definition in legislation	See http://paguidelines.dkpto.dk/aa/betingelser-for-patenterbarhed/vaesentlig-adskillelse/fagmand.aspx Definition of person skilled in the art identical to the European Patent Office (EPO): The "person skilled in the art" for this purpose is considered to be the skilled practitioner in the relevant field aware not only of the teaching of the application itself and the references therein, but also of what was common general knowledge in the art at the date of filing the application.	-	-
(ii) methodologies employed for evaluating inventive step	No method in legislation	See http://paguidelines.dkpto.dk/aa/betingelser-for-patenterbarhed/vaesentlig-adskillelse/problem-and-solution-approach-(psa).aspx The Problem-and-Solution-Approach method (PSA) as developed by the European Patent Office (EPO).	-	-
(iii) having regard to the prior art, the level of inventiveness to meet the inventive step requirement	See http://www.dkpto.org/ip-law--policy/law.aspx <u>Consolidate Patents Act, Section 2(1):</u> Patents shall be granted only for inventions, which <i>differ essentially</i> from the prior art.	See http://paguidelines.dkpto.dk/aa/betingelser-for-patenterbarhed/vaesentlig-adskillelse.aspx Definition of inventiveness/obviousness identical to the European Patent Office (EPO): The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty, it is fair to construe any published document in the light of knowledge up to and including the day before the filing or priority date valid for the claimed	-	-

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		invention and to have regard to all the knowledge generally available to the person skilled in the art up to and including that day.		
Sufficiency of Disclosure:				
(i) enabling disclosure requirement	<p>See http://www.dkpto.org/ip-law--policy/law.aspx</p> <p><u>Consolidate Patents Act, Section 8(2):</u> The description shall be sufficiently clear to enable a person skilled in the art to carry out the invention. An invention which relates to or involves the use of biological material shall, in the cases specified in section 8a, only be regarded as disclosed in a sufficiently clear manner if also the requirements of section 8a are fulfilled.</p> <p><u>Consolidate Patents Act, Section 8(a)(1):</u> If carrying out the invention involves the use of biological material which is not available to the public or which cannot be described in the documents of the application in such a manner as to enable a person skilled in the art to carry out the invention, a sample of the biological material shall be deposited not later than on the date of</p>	<p>See http://paguidelines.dkpto.dk/aa/danske-patenter/indlevering-af-nationale-patentansoegninger/beskrivelse.aspx</p> <p>The application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.</p> <p>See also below (ii) and (iii).</p>	-	-

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	filing of the application.			
(ii) support requirement	<p><u>Order on Patents and Supplementary Protection Certificates, Section 16(1)(4):</u></p> <p>Illustrate the invention by means of examples or embodiments, referring to drawings or photographs, where appropriate, so that the claims may be deemed to be sufficiently substantiated.</p>	<p>See http://paguidelines.dkpto.dk/aa/danske-patenter/indlevering-af-nationale-patentansoegninger/beskrivelse/underbygning-af-krav-i-beskrivelsen.aspx</p> <p>Procedures similar to those of the European Patent Office (EPO):</p> <p>The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art. Regarding the support of dependent claims by the description.</p> <p>As a general rule, a claim should be regarded as supported by the description unless there are well-founded reasons for believing that the skilled person would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis. Support must, however, be of a technical character; vague statements or assertions having no technical content provide no basis. The examiner should raise an objection of lack of support only if he has well-founded reasons. Once the examiner has set out a reasoned case that, for example, a broad claim is not supported over the whole of its breadth, the onus of demonstrating that the claim is fully supported lies with the applicant. Where an objection is raised, the reasons should, where possible, be supported specifically by a published document.</p> <p>A claim in generic form, i.e. relating to a whole class, e.g. of materials or machines, may be acceptable even if of broad scope, if there is fair</p>	-	-

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		<p>support in the description and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where the information given appears insufficient to enable a person skilled in the art to extend the teaching of the description to parts of the field claimed but not explicitly described by using routine methods of experimentation or analysis, the examiner should raise a reasoned objection, and invite the applicant to establish, by suitable response, that the invention can in fact be readily applied on the basis of the information given over the whole field claimed or, failing this, to restrict the claim accordingly.</p>		
(iii) written description requirement	<p>See http://www.dkpto.org/ip-law--policy/law.aspx</p> <p><u>Order on Patents and Supplementary Protection Certificates, Section 16(1):</u> The description shall:</p> <p>(i) Start by giving a brief and factual title of the invention. (ii) Specify the technical field to which the invention relates and indicate the technology on which the invention is based, supplemented, if possible, by reference to known literature illustrating the said technology. (iii) Disclose the technical problem and the solution comprised by the invention. (iv) Illustrate the invention by means</p>	<p>See http://paguidelines.dkpto.dk/aa/danske-patenter/indlevering-af-nationale-patentansoegninger/beskrivelse/tilstraekkelig-angivelse-af-opfindelsen.aspx</p> <p>Procedures similar to those of the European Patent Office (EPO):</p> <p>A detailed description of at least one way of carrying out the invention must be given. Since the application is addressed to the person skilled in the art, it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it apparent to the skilled person how to put the invention into practice. A single example may suffice, but where the claims cover a broad field, the application should not usually be regarded as satisfying the requirements unless the description gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims. However, regard must be had to the facts and evidence of the particular case. There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even</p>	-	-

	<p>of examples or embodiments, referring to drawings or photographs, where appropriate, so that the claims may be deemed to be sufficiently substantiated.</p> <p>(v) State expressly how the invention may be exploited commercially if that does not appear clearly from the nature of the invention. If the invention relates to a gene, it shall be disclosed expressly how a sequence or part of a sequence of the gene may be exploited commercially.</p> <p>(vi) If the invention relates to a change of the genetic identity of an animal, indicate whether the invention may cause pain to the animal and, if so, whether the working of the invention will result in a considerable medical utility value to humans or animals.</p> <p>(2) If the claims comprise several independent claims, the inventions according to those claims shall be disclosed in the description.</p> <p>(3) The description of the invention shall only contain subject-matter which contributes to the</p>	<p>one example. In these latter cases the application must contain, in addition to the examples, sufficient information to allow the person skilled in the art, using his common general knowledge, to perform the invention over the whole area claimed without undue burden and without needing inventive skill. In this context, the "<i>whole area claimed</i>" is to be understood as substantially any embodiment falling within the ambit of a claim, even though a limited amount of trial and error may be permissible, e.g. in an unexplored field or when there are many technical difficulties.</p> <p>An objection of lack of sufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts.</p> <p>It is necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.</p>		
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	<p>understanding of the invention. In general such technical expressions, signs and symbols as are generally accepted in the field in question shall be employed. If newly coined terms or terms which are not in general use are employed, their meanings shall be explained. Physical values shall be expressed in units which are recognised in international practice, preferably according to the metric system using SI units. In mathematical formulas symbols in general use shall be employed. In chemical formulas symbols, atomic weights and molecular or structural formulas in general use shall be employed.</p> <p>(4) If the patent application comprises the deposit of a sample of biological material, cf. section 8a of the Patents Act, the application shall at the filing contain all such relevant information on the characteristics of the biological material as is known to the applicant.</p>			