

EAPO Comments on WIPO Circular C.8403

The Eurasian standard-setting instruments referred to in this letter are as follows:

Patent Regulations under the Eurasian Patent Convention (hereinafter referred to as “the Regulations”) - http://www.eapo.org/ru/documents/norm/instrconv_txt.html

The rules for compiling, filing and examining Eurasian applications at the Eurasian Patent Office (hereinafter referred to as “the Rules”) - http://www.eapo.org/ru/documents/norm/zayavki2012_txt.html

Inventive step

In accordance with Rule 3(1) of the Regulations, an invention shall be considered to involve an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art.

(i) definition of a person skilled in the art

Paragraph 5.8 of the Rules

For the purposes of determining an inventive step, “a person skilled in the art” shall mean any person whose qualifications, corresponding to the average level of skill in the art, would enable him to carry out the claimed invention.

When examining applications relating to several technical areas, “a person skilled in the art” shall mean a group of individuals that collectively possess these qualities.

(ii) methodology used to determine the inventive step

Paragraph 5.8 of the Rules

Verifying the compliance of the invention with the patentability criteria relating to “inventive step” shall include the following stages of analysis of the invention in light of the prior art:

- identification of the closest solution to the claimed invention (prototype);
- identification of those characteristics which distinguish the claimed invention from the closest solution (distinguishing characteristics);
- identification of the prior art solutions whose features coincide with the distinguishing characteristics of the invention under examination;
- analysis of the prior art in order to establish the extent to which the features coinciding with the distinguishing characteristics of the claimed invention had influenced the technical result specified by the applicant.

As a result of analyzing the independent claims of the invention, it may be established that:

- all of the invention’s features relate to the achievement of the claimed technical result. In this case, establishment of the invention’s compliance under these claims with the criteria of patentability relating to “novelty” typically shall also mean compliance of the invention with the patentability criteria relating to “inventive step”.
- some of the characteristics relate to the claimed technical result, while the other characteristics relate to obtaining a different technical result, or a technical result associated with the characteristics in question has not been found.

Where a technical result has been achieved due to a set of characteristics functionally unrelated to the other characteristics, the renown of the set of characteristics and the achieved technical result shall be established.

Where awareness of the indicated set of features and/or its connection with the achieved technical result have/has not been established, then it shall be concluded that the invention involves an inventive step.

Where awareness of the solution in question has been established, then it shall additionally be determined to what extent the possibility of using this known solution is obvious to a person skilled in the art to solve a particular problem formulated in the application.

Awareness of the influence of the distinguishing features of the claimed invention on the technical result may be confirmed both by a single or multiple sources of information. Arguments based on general knowledge in the technical field shall be permissible, without specifying the information sources.

The features distinguishing the invention from the closest solution (prototype) that are unrelated to the expected technical result specified in the description, shall be analyzed in relation to said technical result obtained by using the invention, which shall be pre-determined by them on the basis of the functionality thereof.

When assessing an inventive step, the following factors, which indirectly demonstrate an invention's obviousness or non-obviousness, may also be used:

- long-term satisfaction of existing demand;
- complexity of the problem to be resolved;
- making significant improvements in technical progress;
- overcoming the distrust and scepticism of persons skilled in the art;
- duration of research leading to a positive result;
- simplicity of a claimed invention which resolves a long-standing problem, bearing testimony to the originality of the invention;
- significant economic importance of the invention;
- use by the examiner of multiple references relating to various time periods and/or various areas of technology;
- pioneering nature of the invention.

(iii) level of non-obviousness required to recognize an inventive step based on the prior art

Rule 47(2) Regulations

When verifying compliance of the claimed invention with the patentability criteria relating to "inventive step", it shall be determined whether, having regard to the prior art, the claimed invention is obvious to a person skilled in the art.

Paragraph 5.8 of the Rules

An invention shall be deemed not to derive in a manner obvious to a person skilled in the art from the prior art where solutions with features coinciding with the distinguishing features thereof have not been disclosed in the prior art, or, where such solutions have been disclosed, awareness of the influence of the distinguishing features on the technical result specified by the applicant has not been established.

Compliance with these requirements shall be verified according to the procedure set out above in paragraph (ii).

In particular, inventions based on the following shall be deemed as failing to comply with the inventive step:

- addition of a known means by any known part attached thereto in accordance with certain rules in order to achieve a technical result, in respect of which the influence of said additions has been established;
- replacement of any part of the known means with another known part in order to achieve a technical result, in respect of which the influence of said replacement has been established;
- exclusion of any part (elements or operations), with simultaneous exclusion of a function caused by the presence thereof, and achievement of the usual result for such an exclusion (simplification, and reduction in weight or dimensions);
- executing a known means or part thereof from a known material in order to achieve a technical result caused by the known properties of the material in question;
- creating a means consisting of known parts, the choice and relationship between which has been made on the basis of known rules and recommendations, and the achieved technical result is due solely to the known properties of the parts in question and the relationships between them;
- using the known device, method, substance, or biotechnological product for a specific purpose, where the ability to carry out said purpose is due to known properties (structure or performance), and it is known that these properties are necessary in order to carry out said purpose.

Likewise, inventions based on amendments to a quantitative feature(s) may be deemed not to comply with the inventive step where the influence of each on the technical result and new values thereof is known.

The following shall comply with the patentability criteria relating to “inventive step”, in particular:

- a method for obtaining known individual compounds (class or group) with an established structure, where it is based on a new reaction for the class or group of compounds, or on a known reaction for the class or group of compounds, the conditions of which are not known;
- a composition consisting of at least two known ingredients providing a synergistic effect, which is not possible to achieve from the prior art (i.e. exhibiting the properties of both ingredients, but the quantitative indicators of at least one of the properties in question exceed the indicators of the properties of the individual ingredients);
- an individual compound, falling within the general structural formula of a group of known compounds, but not described as specifically obtained or researched, and at the same time exhibiting new, unknown, qualitative and/or quantitative group properties.

Decisions of judicial authorities.

It should be noted that the majority of the Eurasian patents revoked both under the EAPO administrative revocation procedure, and in the territories of States party to the Eurasian Patent Convention (EAPC), were revoked on the grounds of non-compliance with the patentability criteria relating to “inventive step”:

- 71 per cent under the EAPO administrative revocation procedure (Rule 53 of the Regulations);
- 57 per cent in the territories of States party to the EAPC (Rule 54 of the Regulations).

Adequacy of disclosure

(i) requirement of sufficiency of disclosure

Rule 11 of the Regulations

The Eurasian application shall disclose the subject matter of the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

Where the Eurasian application relates to a biotechnology product or a process involving the use of such a biotechnology product that cannot be disclosed in the application in a manner such that the invention can be carried out by a person skilled in the art and there is no free access to such a biotechnology product, the application shall contain information or a document evidencing the deposit of such a biotechnology product with a competent depositary authority in accordance with the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of April 28, 1977, or with any other depositary institution recognized by the Administrative Council. The deposit shall be effected no later than on the filing date of the Eurasian application.

(ii) requirement of basis

Rule 21¹(4) of the Regulations

The claims shall define the subject matter of the invention and express its essential features. Claims shall be clear and concise and shall be based on the description.

Paragraph 2.6 of the Rules

The claims shall be deemed to go above and beyond the description, in particular, where:

- features and concepts included in the claims are missing from the description, and cannot be derived in a manner obvious to a person skilled in the art from the information available in the description;
- the contents of the claims and the description are incompatible.

Paragraph 5.2 of the Rules

In verifying the compliance of the claimed invention or group of inventions with the patentability criteria, the possibility of grant of a Eurasian patent with the claims proposed by the applicant shall be determined. During said verification:

- compliance of the claims with the description of the invention in terms of scope and content of the concepts used to describe the invention, shall be established.

Thus, if the claims include a feature expressed by a general concept, the legality of using this concept with regard to the description of the invention shall be established. Where the examination reveals such particular forms of implementing the feature in question, which do not provide (in conjunction with the other essential features) the possibility of carrying out the invention to obtain the claimed technical result, the applicant shall be provided with the relevant arguments and shall be invited, based on the description of the invention, to amend the claims or refute the conclusions of the examination.

(iii) requirements relating to the description

Rule 21¹(3) of the Regulations

The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

Rule 23(1) of the Regulations

The description of the invention shall include information supporting the possibility of carrying out the invention.

In particular, the description shall include the following information:

- an indication of the purpose of the invention, i.e. the ability to perform functions meeting a specific public need;
- information on the means and methods, the use of which allows the invention to be carried out in the form in which it is characterized in the claims, implementing the said purpose, and achieving the expected technical result.

Rule 47(2) of the Regulations, paragraph 5.5 of the Rules

Information on these means shall either be included in the description of the invention, or, if not disclosed in the description, then it shall include an indication of awareness of them and awareness of their use in conjunction with other means that characterize the invention, as well as a reference to the information source available as at the priority date of the invention, in which the means in question are described in sufficient detail to be carried out by a person skilled in the art.

In the section of the description, “Information supporting the possibility of carrying out the invention”, the ability of the invention to carry out the stated purpose and obtain a technical result shall be demonstrated, if it is not readily apparent from the nature of the invention.

Where in the claims any features are presented in the form of generalized concepts, this section shall provide information on the specific means used to carry out the invention. These means shall either be described in this section, or known in the art prior to the application filing date, and where priority is claimed, prior to the priority of the invention, which shall be validated by reference to the information source.

Paragraph 2.5.6 of the Rules

Where creation of the invention or use thereof is based on processes not anticipated by the prior art, then accurate information disclosing the possibility of carrying out the processes in question shall be provided in the description.

Further, paragraphs 2.5.6.1-2.5.6.5 of the Rules set out the requirements relating to the information to be disclosed in the application in order to confirm the possibility of carrying out inventions relating to miscellaneous subject matter (devices, methods, substances, biological products, etc.)

It should be noted that insufficient disclosure of an invention does not in itself constitute grounds to revoke a Eurasian patent; where, as a result of insufficient disclosure, it is found to be impossible to carry out the invention, it shall be deemed not to comply with the criteria of patentability relating to “industrial applicability”.