

Request for information on “*inventive step*” and “*sufficiency of disclosure*”, pursuant to the decision adopted at the last meeting of the Standing Committee on the Law of Patents (SCP) of the World Intellectual Property Organization

Information from Ecuador

The information provided in this document refers to national legislation (Publication No. 2006–013 in the Addendum to Official Journal No. 426, Volume 28-XII-2006, of the Intellectual Property Law); to regional legislation (Andean Community Decision No. 486 establishing the Common Industrial Property Regime, hereinafter “Decision 486”); and to the Common Patent Processing Manual for the Andean Region (hereinafter “Andean Patent Manual” or “Manual”), a practical guide to conducting examinations of patent applications filed in any of the Andean Community countries (Bolivia, Colombia, Ecuador and Peru). NB. The directives for the Manual were established pursuant to Decision 486.

INVENTIVE STEP

i. Definition of person skilled in the art

Article 18 of Decision 486 states that “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, the invention is neither obvious nor obviously derived from the state of the art.”

According to the Andean Patent Manual, a person skilled in the art is a person with average skills in the technical field concerned. His level of knowledge is higher than that of the general public, but no greater than that expected of a duly qualified person. It refers to a person with average knowledge, not someone who is specialized.

The glossary of the Manual states that a technician with average knowledge of the field refers to a hypothetical person/s with average knowledge in the field who has access to all the technical information related to his/her field that was available to the public on the filing date of the first application but who has no inventive skill. A technician in the field is neither the inventor nor an expert in the field.

ii. Methods used for assessing the inventive step

Paragraph 13.2.g of the Andean Patent Manual details the strategy and procedures that the examiner must follow to assess the level of inventiveness: (1) define the closest prior art. This shall be done taking into account any prior art resolving the same problem, and where none exists, of the elements of the prior art sharing the most common technical characteristics; (2) identify the aspects different to the closest prior art; (3) assess whether the introduction of the differentiating technical characteristic to solve the problem is obvious for a person skilled in the art; and (4) assess whether there is an indication in another document that suggests to the ordinary technician in the field the possibility of combining the findings of the two documents to arrive at the same proposed solution.

The glossary of the Manual defines *obvious*, or *evident*, and states that it is “that which goes no further than normal progress in the state of the art and that which cannot simply be deduced from it.”

iii. In light of the state of the art, the level of inventive step (obviousness) necessary to fulfil the requirement for inventive step

Paragraph 10.4 of the Andean Patent Manual sets out the guidelines for determining the presence of the level of inventive step:

- an unexpected result;
- overcoming a prior technical preconception;
- a surprisingly simple solution;
- overcoming real technical difficulties;
- an original solution, which leaves the beaten track of common knowledge and opens a new way forward; and,
- fulfilling a long-standing, permanent and as yet unsatisfied need.

SUFFICIENCY OF DISCLOSURE

i. Enabling disclosure requirement

According to Article 28 of Decision 486, “the description shall disclose the invention in a manner sufficiently clear and complete to be understood and for a person skilled in the corresponding technical field to be able to execute it. The description of an invention shall state the name of the invention and include the following information:

- (a) the technological sector to which the invention relates or applies;
- (b) the previous technology known to the applicant that may be useful for understanding and examining the invention, and references to earlier documents and publications relating to that technology;
- (c) a description of the invention in terms enabling understanding of the technical problem and the solution provided by the invention, with an explanation of the differences and possible advantages in relation to the earlier technology;
- (d) an account of the drawings, if any have been filed;
- (e) a description of the best method known to the applicant of executing the invention or putting it into practice, with the use of examples and references to the drawings, where applicable; and
- (f) how the invention is susceptible of industrial application, if this is not clear from the description or the nature of the invention.

ii. Support requirement

Paragraph 3.2 of the Andean Patent Manual states that the disclosure of the invention must use terms that allow an understanding of the technical problem and the solution provided by the invention.

Paragraph 3.3 of the Manual states that the purpose of the description is to ensure that, firstly, the application contains sufficient technical information for a person with average knowledge of the art to be able to execute the invention, and secondly, that the disclosure is sufficient to understand the contribution of the invention to the field of technology.

iii. Written description requirement

According to the Andean Patent Manual, the description of the invention plays an important role in that it discloses the invention, i.e. the invention must be described in a manner sufficiently clear and complete for it to be understood and for a person skilled in the relevant technical field to be able to execute it. These two requirements complement each other, given that the comprehension of the invention is what the person skilled in the art understands about the invention and uses to evaluate the advance in the technology, whereas the execution entails the ability to carry out the invention step-by-step.

Paragraph 13.2.b details the strategy for analyzing the description and states that the examiner must:

- 1) verify that the information contained in the description complies with the provisions of Article 28 of Decision 486;
- 2) verify that units belong to the International System of Units;
- 3) verify that the description of the drawings is related directly to the description;
- 4) verify that the description either uses the common technical terminology of the relevant field or defines correctly any terms not widely known;
- 5) identify the technical characteristics of the invention;
- 6) verify that the subject of the claims is stated in the description;
- 7) when examining requests in the field of biotechnology that refer to amino acids or nucleotide sequences, verify that the application contains a list thereof, which must be displayed separately from the description and entitled “List of Sequences”;
- 8) verify whether there are indications that the invention is related to genetic resources or traditional knowledge, and whether it complies with the provisions of Article 26 of Decision 486; and
- 9) in instances of biological material, verify whether a certificate of deposit is needed to substantiate the description.