

World Intellectual Property Office (WIPO) Note C. 8403

Information on the requirements of inventive step and sufficiency of disclosure as requested by the Standing Committee on the Law of Patents (SCP). Response by the Finnish Patent and Registration Office (PRH), February 28, 2015.

Inventive step

(i) *the definition of a person skilled in the art*

The Finnish **Patents Act** refers to the concept of “person skilled in the art” as follows:

Section 8, subsection 2:

The application shall contain a description of the invention, together with drawings where necessary, and a precise statement of the subject matter for which patent protection is sought (one or more claims). The fact that the invention relates to a chemical compound shall not mean that a specific use must be disclosed in the claim. **The description shall be sufficiently clear to enable a person skilled in the art, with the guidance thereof, to carry out the invention.** An invention relating to a biological material or involving the use of biological material when being carried out shall be regarded, in the cases referred to in section 8a, as disclosed with sufficient clarity only if the requirements set out in that section are also satisfied.

Section 8a, subsection 1:

Where an invention concerns biological material or the carrying out thereof involves the use of a biological material which neither is available to the public nor can be described in the application documents 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 no later than on the date the application was filed. The biological material shall be continuously on deposit thereafter so that any person entitled under this Act to a sample of the deposited material may have the sample furnished in Finland. The Government shall decree where deposits may be made.

Section 25, subsection 1:

The Patent Authority shall revoke a patent on account of an opposition:

- (1) if the patent relates to an invention that does not satisfy the requirements of Sections 1, 1 a, 1 b or 2;
- (2) if the patent relates to an invention the description of which is not sufficiently clear to **enable a person skilled in the art** to carry out the invention;
- (3) if the patent contains subject matter not included in the application as filed; or
- (4) if the scope of protection was extended after the notice referred to in section 19 (1), was given.

Section 52, subsection 1:

The court shall declare a patent invalid, in a relevant action:

- (1) if the patent relates to an invention that does not satisfy the requirements of sections 1, 1 a, 1 b, or 2;
- (2) if the patent relates to an invention the description of which is not sufficiently clear to enable **a person skilled in the art** to carry out the invention;
- (3) if the patent contains subject matter not included in the application as filed; or
- (4) if the scope of protection was extended after the notice referred to in section 19 (1) was given.

Section 53b:

The condition for acceptance of a request to limit a patent before a Patent Authority or a Court is that the patent to be limited in accordance with the request meets the following conditions:

- (1) the patent refers to an invention which is presented with sufficient clarity **for a person skilled in the art** to use the invention;
- (2) the patent does not involve anything that does not appear from the application when it was filed; and
- (3) the scope of protection of the patent has not been extended from the scope of protection of the patent granted or from the previously taken decision of the scope of protection.

Finnish Patent and Registration Office (PRH) **Search and Examination Guidelines (Patenttikäsikirja**, available only in Finnish) defines the concept of “person skilled in the art” as follows:

E.3.5.1 Person skilled in the art (page 80)

In Finnish patent practice, a model of explanation based on the knowledge and skill of an average person skilled in the art is used as a way to assess whether the invention disclosed in the application involves an inventive step.

The average person skilled in the art is considered to be an ordinary skilled practitioner who is aware of prior art at the date of filing the application (priority date). They also have the knowledge of the state of the art and have at their disposal the ordinary means and capacity to carry out routine work and experimentation, as well as the capacity to use prior art as is usual for the technical field in question. They are also able to combine information disclosed in cited documents with common general knowledge in their technical field, for instance with a well-known technical teaching of a handbook.

Please note that the average person skilled in the art is not seen as a highly skilled expert. If this model of explanation is used, the patent examiner must be careful with their subjective point of view when assessing inventive step. The patent examiner is not the person skilled in the art referred to in the model.

In some cases, it is more appropriate to see the person skilled in the art as a group of persons, for instance a research or working group, rather than a single person. This way of thinking can be used for example in high-tech (computing) or in highly developed processes (integrated circuits, combinations of chemical compounds).

An invention involves an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. When the patent examiner is assessing inventive step, the question is whether it would have been obvious to a person skilled in the art, at the date of filing and when compared with the state of the art at that time, to arrive at a result falling within the scope of protection of the claim describing the invention. If the answer is 'yes', the invention disclosed in the claim does not involve an inventive step. The term 'obvious' means something that does not go beyond the normal progress of technology but follows plainly or logically from the prior art, in other words, something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.

- (ii) *Methodologies employed for evaluating the inventive step*
- (iii) *Having regard to the prior art, the level of inventiveness (obviousness) to meet the inventive step requirement*

These questions are covered in the following sections of the Finnish Patent and Registration Office (PRH) **Search and Examination Guidelines**:

E.3.5 Inventiveness (Keksinnöllisyys), pages 79-85

Especially sections:

E.3.5.2 Problem-solution approach (Ongelma ja ratkaisu -periaate), pages 80-83

E.3.5.5 Aspects supporting the inventiveness (Keksinnöllisyyttä puoltavia seikkoja), page 85

The Finnish Office predominantly applies the problem-solution approach of the European Patent Office in order to assess and decide whether an invention involves an inventive step

Sufficiency of disclosure

- (i) *enabling disclosure requirement*
- (ii) *support requirement*
- (iii) *written description requirement*

The **Finnish Patents Act** and **Patent Regulations** refer to the different aspects of sufficiency of disclosure as follows:

Patents Act, Section 8, subsection 2:

The application shall contain a description of the invention, together with drawings where necessary, and **a precise statement of the subject matter for which patent protection is sought** (one or more claims). The fact that the invention relates to a chemical compound shall not mean that a specific use must be disclosed in the claim. The description shall be sufficiently clear to enable a person skilled in the art, with the guidance thereof, to carry out the invention. An invention relating to a biological material or involving the use of biological material when being carried out shall be regarded, in the cases referred to in section 8a, as disclosed with sufficient clarity only if the requirements set out in that section are also satisfied.

Patent Regulations, Section 4:

The description must begin with a brief and factual title of the invention. The description must comprise:

1) A general part, which illustrates the scope of application of the invention and the technique upon which the invention is based, i.e. the state of the art. The presentation of the state of the art must include references to literature, known to the applicant, which discloses the technique. It must also present the special features of the invention over the state of the art, as well as the means necessary for achieving them. The last-mentioned presentation must conform to the presentation given in the claims and it may consist of a reference to the claims. If the invention in itself does not disclose how it can be exploited industrially, this is to be stated in the description.

2) A specific part in which the invention is described in detail, primarily by giving examples or embodiments and possibly by referring to a drawing. The invention must be illustrated with examples in such a way that the claims can be considered as substantiated. If the description contains a drawing, generally a list of all the figures in the drawing must be presented as an introduction to the specific part of the description.

Patent Regulations, Section 5

If the claims contain several independent claims, the inventions corresponding to them are to be presented in the description in the way specified in section 4. Also the subject matter for which protection is requested in a dependent claim (embodiment) must be presented in the description to such extent as is necessary for the claim to be understood. The inclusion of the last-mentioned in the specific part of the description is to be considered sufficient.

Patent Regulations, Section 13

Each claim must disclose those special characteristics that are necessary for achieving the intended effect.

These questions are also covered in the following sections of the Finnish Patent and Registration Office (PRH) **Search and Examination Guidelines**:

C.1.3 Clarity of the claims / searchable claims (Patenttivaatimusten selkeys ja tutkittavuus), pages 28-29

E.1.2 Reproducibility (Toistettavuus), page 71

Links

The Finnish **Patents Act** and **Patent Regulations**

<http://www.prh.fi/en/patentit/lainsaadantoa.html>

Finnish Patent and Registration Office (PRH) **Search and Examination Guidelines** (2015) (**Patenttikäsikirja**, available only in Finnish)

http://www.prh.fi/stc/attachments/patenttiinliitteet/Patenttikasikirja_2015.pdf