

26 February 2015

Ref: 871-99-2015-001012

Re: C.8403

The following is the ILPO's response to the above-captioned circular in accordance with and order of the issues raised therein.

Inventive step

Section 5 of the Israel Patents Law 5727-1967 (hereinafter: "the Law") states that:

"An inventive step is a step which does not appear obvious to an average skilled person in the light of the knowledge published before the application date in ways said in section 4¹".

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

A Supreme Court Decision (*Hughes Aircraft Company vs. The State of Israel*, CA 345/87, (2.7.1990)) stated that the question of inventive step is addressed to the "average skilled person" who is a person (or, where appropriate, a team of people) proficient in the details of the relevant field but does not have inventive capabilities. He is a fictional figure that may possess different knowledge in different professional or scientific fields, depending on their technical or research nature.

Furthermore, the Examination Guidelines pertaining to Section 5 of the Patents Law specify that the average skilled person is familiar with everything published in the relevant technical field and is continuously updated with the latest developments in the field, and in the fields very close thereto, and with all acceptable methods in the same field. But, he has no inventive capabilities and is not used to exercise inventive skills.

The skilled person may represent a team of specialists working in various fields who are used to consult one another. But in order for a skilled person to be considered a team, it should be evident that the specialist in the main field of the invention is dealing with a technical problem that cannot be solved with his technical knowledge

¹ According to Section 4 of the Israel Patents Law *"An invention is deemed new if it was not published, in Israel or abroad, before the application date –*

- (1) *by written, visual, audible or any other description, in a manner that enables a skilled person to make it according to the particulars of the description;*
- (2) *by exploitation or exhibition, in a manner that enables a skilled person to make it according to the particulars thus made known".*

only and that he would have considered to get assisted by a specialist from another field.

(ii) Methodologies employed for evaluating the inventive step

Inventive step is evaluated, according to Section 5 of the Patents Law, based on the obviousness of the claimed invention in light of the knowledge published before the effective date (priority date, filing date or amendment date). According to the Examination Guidelines, a relevant prior art publication can be combined with other publication(s) or with the common general knowledge of the skilled person.

According to Regulation 41 of the Patents Regulations (Office Practice, Rules of Procedure, Documents and Fees) 5728-1968 (hereinafter: "*the Patents Regulations*") and the Examination Guidelines, an objection under Section 5 of the Patents Law should be raised for each claim of the claimed invention which is not considered to involve inventive step. The examiner should point out the difference(s) between the subject-matter of the claim(s) and the cited prior art and provide detailed reasoning why it is not considered to involve inventive step. The examiner should then carefully consider whether the applicant's arguments and any evidence supporting them overcome the lack of inventive step objection raised.

The following auxiliary tools have been provided in the Examination Guidelines for the patent examiners to assist them in determining the obviousness of the claimed invention in light of the published prior art. However, these tools should be carefully and correctly applied.

1. Obviousness to combine separate prior art publications

Upon raising an objection under Section 5 of the Patents Law the examiner may combine two or more prior art publications provided that these publications would have been combined by the skilled person. There are several considerations that apply in determining the obviousness to combine as summarized below:

1.1. Motivation to combine: it may be permissible to combine the teaching of different prior art publications in order to solve the problem posed *inter alia* in the following cases:

1.1.1. a prior art publication provides explicit reference to another publication,

1.1.2. a prior art publication provides hint to a certain element of the claimed invention that is missing in it but is disclosed in another publication, or

1.1.3. a prior art publication discloses in general terms a subject-matter which is similar to the claimed invention but the missing element is specifically disclosed in another publication.

- 1.2. The scope of prior art publications that is relevant to the assessment of inventive step may include different publications, covering scientific and technical knowledge relating to the claimed invention, that are available to skilled persons in different fields, even if they are not engaging in the same commercial branches as those of the invention at hand (*Akerstein et al. vs. Alumim et al.*, CA 21/83 (31.12.1983)).
- 1.3. A reasonable number of cited documents may be combined in order to prove obviousness of the claimed invention. The more publications needed to be combined to arrive to the claimed subject-matter the less evident is the obviousness of the claimed invention.
- 1.4. Aggregation of features, wherein each feature produces its regular technical effect with no functional interaction with the other feature(s), cannot contribute to an inventive step (Decision of the Commissioner of Patents re Patent Application no. 24862 *Hayoetz Inc et al* (13.11.1970)).
2. Obviousness to try: lack of inventive step may be evident if it would have been obvious for the skilled person to try to seek a solution with a reasonable expectation of success.
3. Doctrine of equivalents: lack of inventive step can be based on technical features of the claimed subject-matter which are not disclosed in a prior art publication but are equivalent to those features disclosed in it.
4. An unexpected effect (Decision of the Commissioner of Patents re Opposition to Patent Application no. 153109 *Teva Pharmaceutical Industries Ltd. vs. Merch & Co., Ltd.* (5.8.2010)), a synergistic effect (*Akerstein et al. vs. Alumim et al.*, CA 21/83 (31.12.1983)) or a new effect (*Lanplast Ltd. vs. Eliezer Berckman*, CA 804/89 (11.3.1992)), may provide evidence of non-obviousness of the claimed invention.
5. Teaching away by the prior art may support non-obviousness of the claimed invention.
6. Overcoming technical difficulties and the need for much time, resources and experimentation to arrive to the claimed invention may be supportive of an inventive step (Decision of the Commissioner of Patents re Opposition to Patent Application no. 105041 *Noga Engineering Ltd. vs. Vargus Ltd.* (10.8.2004)).

7. Long-felt need: a technical problem that has not been solved for a long time may be indicative of inventive step if the inventor is the first to solve it and others have not succeeded in solving it previously (*Hughes Aircraft Company vs. The State of Israel*, CA 345/87, (2.7.1990)).
8. Commercial success is acceptable as a secondary indicator of inventive step (*Akerstein et al. vs. Alumim et al.*, CA 21/83 (31.12.1983)). However, in some cases the commercial success may be misleading, especially when it is achieved by non-technical means pertaining to the invention, for example by marketing, advertisement, pricing, etc.
9. A new use of a known product which involves overcoming special difficulties may be supportive of inventive step (*L.M. Lipski Inc vs. Nathan Manor*, CA 314/77), provided that it is not analogical to a known use (*Lanplast Ltd. vs. Eliezer Berckman*, CA 804/89 (11.3.1992)).

(iii) Having regard to the prior art, the level of inventiveness (obviousness) to meet the inventive step requirement

A Supreme Court Decision (*Hughes Aircraft Company vs. The State of Israel*, CA 345/87, (2.7.1990)) stipulated that the requirement of inventive step under Section 5 of the Patents Law is broader than the requirement of novelty. It is not sufficient that the invention has not been disclosed to the public but it should be evident that it makes a significant contribution to the (technical) field, which justifies granting a patent. However, the same decision stated that the step required to be unobvious does not have to be big: while an inventive step is indeed required, it is sufficient to be modest and small. The simplicity of the invention does not necessarily deprive it of patentability.

The requirement of inventive step as set forth in this decision has been maintained by another Supreme Court Decision (*Unipharm Ltd vs. SmithKline Beecham PLC*, CA 8802/06 (18.5.2011)) that confirmed the need for an “inventive spark”.

Sufficiency of Disclosure

(i) Enabling disclosure requirement

Section 12(a) of Israel Patent Law states that:

"The specification shall include a title by which the invention can be identified, its description, with drawings as necessary, and also a description of the manner of performing the invention, as to enable the skilled person to perform said invention".

1. The Supreme Court ruled that the requirement for sufficiency of disclosure is intended to ensure that on the effective date the inventor indeed had possession of the claimed invention and to ensure the right of the interested public to know the scope of the invention and the manner and means of performing it. This allows exploiting the invention after patent expiration or under a license given by the patentee as well as or preventing discouragement research in the relevant field (*Hughes Aircraft Company vs. The State of Israel*, CA 345/87, (2.7.1990)); (*Akerstein et al. vs. Alumim et al.*, CA 21/83 (31.12.1983)).
2. The sufficiency of disclosure is assessed based on the whole professional knowledge in the field or the relevant fields on the effective date and the inventor does not have to detail what is included in this knowledge. The latter is interpreted in the Examination Guidelines (regarding Section 12 of the Israel Patent Law) as being related to the details which are well known to the skilled person and which are not essential to the invention. But if these details concern the inventive concept, then they have to be described in a manner that enables the skilled person to perform the invention based on the written description and his professional knowledge. In addition, the assessment of sufficiency of disclosure is related to the same "average skilled person" pertaining to Inventive step.
3. The inventor should act in good faith and provide all the necessary information. The description should be correct, clear, precise and complete. It should be as simple as possible and cannot include false or misleading statements. If only one manner of carrying out the invention is applicable, no additional inapplicable manners should be suggested.
4. Sufficiency of disclosure is considered to be determined by whether the skilled person is able to produce the claimed product based on the instructions mentioned in the specification. If the answer is positive, then the description complies with the requirements of Section 12 of the Patent Law (Commissioner of Patents Decision re Opposition to Patent 33746 *Aluminum Company of America vs. Mr. Haim Arazi* (4.11.1975)).
5. If the subject described in the specification for performing the invention is very simple and clear to the extent that the skilled person (or a team of specialists) is able to carry it out after a reasonable number of experiments, or if it requires trial and error to a reasonable extent then Section 12 of the Patents Law is complied with (Israel Supreme Court decisions: *Sanofi Ltd. vs. Unipharm Ltd.*, CA 665/84 (10.12.1987)); (*Lanplast Ltd. vs. Eliezer Berckman*, CA 804/89 (11.3.1992)).
6. The Examination Guidelines (relating to Section 12 of the Patents Law) state that if the specification mentions documents that can be helpful for the skilled person in understanding and performing the invention, these documents should be clearly identified (for example by a publication number) so that the public would have access to them.

(ii) Support requirement

Section 13(a) of the Israel Patent Law states that:

"The specifications shall conclude with a claim or claims that define the invention, provided that each of the aforesaid claims reasonably arises out of the subject described in the specification".

The term "*the subject described in the specification*" in Section 13(a) of the Patents Law is understood as defined in Section 12(a) of the Patents Law (see above) and Regulation 20(a) (see *paragraph iii* below).

1. Every claim should be supported in the description of the application and no subject matter may be claimed that is not part of the invention as described in the specification (*Shunia Rozental vs. the Commissioner of Patents*, CA 598/93 (21.11.1996)).
2. The Examination Guidelines state that identical wording between the claims and the description does not necessarily indicate that the claims reasonably arise from the subject described in the specification. There should be evidence that each embodiment of the claimed invention can be achieved as described in the specification (Commissioner of Patents Decisions re Opposition to Patent Application no. 158016 *Maron vs. Asher* (10.11.2010)). If there is a reason that the invention cannot be achieved, the subject-matter of the claims should be limited to those embodiments described in the examples and those that are equivalent to them in the same field of the invention. Prior art knowledge may be used as evidence for support or lack of support of the claimed subject-matter by the subject described in the specification.
3. The claims cannot be considered to define the invention and reasonably arise out of the subject described in the specification if an essential feature is absent from the claims.

(iii) Written description requirement

Section 12(a) of Israel Patent Law states that:

"The specification shall include a title by which the invention can be identified, its description, with drawings as necessary, and also a description of the manner of performing the invention, as to enable the skilled person to perform said invention".

(b) For purposes of subsection (a), where the subject of the invention is a biological material or a process for the production of a biological material or an invention that involves the use of a biological material, and where the biological material has been deposited in a depositary institution, then part of the description of the invention or of the manner of performance thereof may consist of referral to such deposit, all in accordance with the terms and conditions set forth by the Minister of Justice with approval by the Knesset Constitution, Law and Justice Committee."

Regulation 20(a) of the Patent Regulations states that:

"The specification shall include the following subjects, in the order in which they are here enumerated:

(1) an introduction, explaining the purpose of the invention, and a concise description of the state of prior art—as far as known to the applicant in view of the invention—in the technical field in which the invention was made;

(2) a description of the invention, with reference to drawings, examples or genetic sequences as necessary in order to understand the invention; If the applicant chose to refer to a deposit of a biological material in a depositary institution under Section 12(b) of the law, then the reference shall be conducted in accordance with subregulation (a1)²."

In addition please see "Sufficiency of disclosure", paragraph (i).1. above).

As to the relevance of prior art documents please see "Sufficiency of disclosure", paragraph (i).6. above).

² Regulation 20(a1) states that "A reference under subregulation (a)(2) shall be performed in the specified manner:

(1) When submitting the patent application, the institution and deposit number as well as the date in which the deposit was made shall be noted in the description of the invention. A certification from the depositary institution attesting to the reception of the biological material shall be attached to the application in accordance with the rules of the Budapest Treaty as published in the website of the World Intellectual Property Organization (WIPO) (in this regulation – certification of reception).

(2) The owner of an application or patent, as appropriate, shall notify the Office of the number of a new deposit and will attach the certification of reception within 3 months of the date given in case of a new deposit (as referred to under section 4 of the Budapest Treaty) subsisting of a biological material previously deposited. The provisions under sections 22, 29 and 65 of the Law shall apply to amendments of the application or patent, as appropriate."

Legal Information

The Israel patent legal texts; including, *inter alia*, Israel Patents Law 5727-1967, Israel Patents Regulations (Office Practice, Rules of Procedure, Documents and Fees) 5728-1968, Decisions of the Commissioner of Patents, Commissioner Circulars and the Examination Guidelines are available (in Hebrew) on the ILPO website and can be accessed by the following link (additional information in English can also be found):

<http://index.justice.gov.il/En/Units/ILPO/Pages/default.aspx>

Translations of the Israeli legal texts can be found on WIPO website:

<http://www.wipo.int/wipolex/en/profile.jsp?code=IL>