

Information on the requirements of inventive step and sufficiency of disclosure in Ukraine

As concerns **Inventive step**:

(i) the definition of a person skilled in the art the Ukrainian side would like to inform that National legislation does not provide for the definition of a 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;

Under Article 7 of the Law of Ukraine “On the Protection of Rights to Inventions and Utility Models”:

1. An invention meets the patentability requirements provided that it is new, involves an inventive step and is industrially applicable.

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3. An invention (utility model) shall be considered to be new provided that it does not form part of the state of the art. Objects that are a part of the state of the art shall be considered only separately when determining the novelty of an invention.

4. The state of the art comprises everything made available to the public throughout the world before the date of filing of the application with the Office or, if the priority has been claimed, before the date of its priority.

5. The state of the art also includes a content of any application for granting a patent in Ukraine (including an international application, in which Ukraine is designated) in the wording, in which this application has been primarily filed, provided that the date of its filing (if the priority has been claimed, the date of the priority) is prior to the date referred to in Paragraph 4 of this Article, and that the application has been already published on or after this date.

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7. An invention shall be considered as involving an inventive step provided that it is not obvious to a person skilled in the art, i.e. an invention does not proceed obviously from the state of the art. The content of applications mentioned in Paragraph 5 of this Article shall not be taken into consideration while estimating the invention level.

Rules Of Processing An Application For Invention And An Application For Utility Model

6.5.3. Checking of inventive step

6.5.3.1. An invention has an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. When assessing the inventive step, the claimed invention is compared not only with separate documents or their parts, but with combination of documents and their parts

(so called composite prototype), when the possibility of combining the documents or their parts is obvious for a person skilled in the art.

When checking the inventive step the contents of the applications filed with the State Service is taken into consideration from the date of publication of information about them in the Bulletin.

6.5.3.2. When inventive step is checked, it is established whether the influence of the combination of the features of the claimed invention on obtaining the technical result indicated by the applicant is known from the state of the art. If this fact is not established, the invention is considered to meet the criterion of inventive step.

6.5.3.3. The following, in particular, meet the criteria of inventive step:

- an individual compound falling into the general structural formula of a group of known compounds, but not described as specially obtained and explored and at the same time demonstrating new features unknown for this group of compounds in quantitative and (or) qualitative respect (invention by selection);

- a composition consisting at least of two known ingredients ensuring synergetic effect, the possibility of obtaining which does not follow from the state of the art (i.e. which demonstrates the features of both ingredients, but qualitative indicators of at least one of these features are higher than the indicators of the same feature of separate ingredients);

- methods of obtaining new individual compounds (class, group) with a definite structure;

- methods of obtaining known individual compounds (class, group) with a definite structure, if a new reaction for this class or group of compounds or unknown conditions of conducting a reaction known for this class or group of compounds underlie these methods.

6.5.3.4. An invention meets the criteria of inventive step in spite of apparent simplicity and disclosure of the indicated in the application materials mechanism of obtaining the technical result, if such disclosure has become known not from the state of the art, but only from the application materials.

6.5.3.5. The claimed invention is as a rule recognized as one not meeting the criteria of inventive step if it has as its basis:

- supplementation of a known preparation by any known part (parts) added to it by known rules, in order to obtain a technical result for which the influence of such supplementations is established;

- replacement of any part (parts) of a known preparation by other known part (parts) in order to obtain a technical result for which the influence of such replacement is established;

- removal of any preparation (element, action) with simultaneous removal of the function conditioned by its presence and obtaining a technical result common for such removal (simplification, reduction of mass, dimensions, materials consumption, reliability growth, reduction of process duration etc.);

- increasing the number of homogeneous elements or actions in order to enhance a technical result conditioned by the presence in the preparation of such elements or actions;
- execution of a known preparation or its part (parts) from a known material in order to obtain a technical result conditioned by known features of this material;
- generation of a preparation consisting of known parts, the choice of which and the connection between which is made by known rules and recommendations and the technical result obtained in this case is only conditioned by known features of the mentioned parts and connections between them;
- use of a previously known product (device, substance, microorganism strain etc.) or method with a new purpose, if the new purpose is conditioned by its known features, structure, execution and it is known that such features, structure, execution are needed to implement the mentioned purpose;
- alteration of the quantitative feature (features), demonstration of such features in their interrelation or in the change of its kind under the condition that the fact of the influence of each of the features on the indicated technical result is known and new values of these features or their interrelation may have been obtained on the based upon known dependences and regularities.

6.5.3.6. The fact that influence of combination of features of the claimed invention on the technical result is known may be proved by combining two or more information sources or their parts, different excerpts from one and the same source or from any different information sources. Involvement of arguments based on knowledge well-known in a specific art without indication to any specific information sources is permissible. In the course of further examination of the application the applicant is informed about such information sources if he/she insists on that.

6.5.3.7. The proof of the fact that the influence of combination of features of the claimed invention on the technical result is known is not needed, if the technical result is not indicated by the applicant for such features or if it is established that the technical result indicated by the applicant is not obtainable.

6.5.3.8. If the claimed invention meets the criterion of inventive step with regard to the independent claims, the dependent claims are not further checked.

6.5.3.9. If the claimed invention characterized by a single-claim claims does not meet the criterion of inventive step, the applicant is sent a provisional decision on refusal giving grounds and inviting to express his/her opinion on these arguments and, in case of necessity, to submit edited claims with due account of the original application materials.

6.5.3.10. If the claimed invention characterized by multi-claim claims with one or several independent claims does not meet the criterion of inventive step in any of the independent claims, the application is further examined according to paragraph 6.5.4. of these Rules.

As concerns **sufficiency of Disclosure** the Ukrainian side would like to inform that under Article 12. of the Law of Ukraine “On the Protection of Rights to Inventions and Utility Models”:

7. The description of an invention (utility model) shall be represented in the defined order and shall disclose the subject-matter of an invention (utility model) in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

8. Invention (utility model) claims shall disclose the subject-matter of an invention (utility model), shall be based on the description and shall be clearly and concisely represented in the defined order.

9. The abstract is prepared only for information purposes. It may not be taken into consideration for other purpose, in particular for interpreting invention (utility model) claims and determining the state of the art.

Patent Rules

3.2. Requirements to application documents

3.2.1. The application documents, namely a request for the grant of a patent, description and claims, drawings and abstract shall be furnished in triplicate. The document to be further translated may be filed in the original language in one copy, and their translation shall be filed in triplicate.

3.2.2. All documents of the application for the grant of a patent for an invention (utility model) shall be made in such a way that they could be stored within a long period of time and reproduced in an unlimited number of copies.

3.2.3. The application documents shall be printed on white paper sheets of 210 x 297 mm format. Each document shall commence from a new page, the second and subsequent pages of each document being numbered in Arabic numerals.

Each sheet shall contain print on one side only, and the lines on it shall be placed in parallel to the shorter side of the sheet.

The minimum margins of the sheets containing the description, claims and abstract shall be, mm:

Left side – 25;

Top – 20

Right side and bottom – 20

The drawings shall be made on white paper sheets of the 210 x 297 mm format.

The minimum margins of the sheets containing the drawings shall be as follows, mm:

Left side – 25;

Top – 25;

Right side - 10;

Bottom – 15.

3.2.4. All documents shall be printed in black. The typing in the text of the description of an invention (utility model), claims and abstract shall be 2-spaced, or 1,5-spaced in the case of computer print-out with the characters being not less than 2,1 mm high.

3.2.5. Latin names, Latin and Greek characters, graphic symbols, mathematical and chemical formulae may be written in black ink, paste, drawing ink.

3.2.6. Bibliographic particulars of information sources in the application documents shall be referred to so that these information sources might be readily found.

6. Specification of the invention (utility model)

6.6. Disclosure of the invention (utility model)

6.6.1. The subject of the invention (utility model) shall be disclosed through the description of its substantial features sufficient for the attaining of the technical effect provided by the invention (utility model).

The features are substantial if they cause attaining of technical effect, namely if there is a cause-and-effect relation between these features and the technical effect.

6.6.2. In this section, the problem solved by the invention (utility model), as well as the technical effect attained by the invention (utility model) shall be described in details.

The technical problem, as a rule, lies in the creation of an object whose characteristics meet the specified requirements. This object may be a device, process, etc.

6.6.3. The technical effect shall mean detection of new properties or improvement of known properties of the subject matter of an invention (utility model), achieved in the course of carrying out the invention (utility model).

The technical effect may be manifested, for example, in the decrease or increase of torque, friction coefficient, oscillation frequency or amplitude, in decrease of signal distortion, in the structural modification in the process of crystallization, in the improvement of the contact of the operational unit with the medium, etc.

The technical effect may be obtaining of the technical means with a certain purpose for the first time.

It is also recommended to mention other technical effects attained by the invention (utility model), including certain modes for carrying out the invention (utility model), known to the applicant. In the case of the group of invention, the said information, including the information concerning the technical effect, shall be provided in respect of each invention.

If possible, the cause-and-effect relation between the features of the invention (utility model) and the attained technical effect shall be shown in this section.