Dear Madam,
Sir

The Austrian Patent Office has the honor to submit its inputs for the Standing Committee on the Law of Patents (SCP) as requested.

The comments provided relate to topics (ii) and (iii) of the request:

(ii) assessment of inventive step in the chemical sector

In general, Austrian case law uses the problem-solution approach as developed by the EPO to determine the inventive step whereby the could/would approach is applied. In principle, this also applies to inventions in the field of chemistry, even if here the subject matter which determines the inventive step often differs in character from inventions in other fields (e.g. fight against certain diseases, dosage, identification of distinct patient groups). Jurisdiction recognizes that the formal application of the problem-solution approach according to the usual scheme can be problematic and therefore does not necessarily have to be applied in every case.

Selection inventions, cases in which inventiveness lies in the task, as well as combinaion inventions are in principle known to Austrian jurisprudence. In the case of a combination invention, for example, there must be a technical effect resulting from the combination. These cases are to be assessed on a case-by-case basis.
Of course, general expert knowledge plays a role as well as general facts but must be argued in a comprehensible way (see for example "Österreichisches Patentblatt" 2018, page 64: 133R7/18d (7. 5) and N 4/2015).
The definition of the "expert skilled in the art" depends on details of the subject-matter for which protection is sought (case law example: N 4/2015, PBl 2018, 64ff, in particular page 83).

Regarding the Markush claim the Supreme Patent and Trademark Senate in its decision of 29th June 2011 (Op 3/11, N 15/2007) has ruled as follows:

On the question of protectability of a compound for use in the manufacture of a medicament for the treatment of a central nervous system disorder: The assessment as to whether the subject-matter of a patent is prejudicial to novelty through prior publication requires the determination of the total content of the prior publication. The decisive factor is which technical information is clearly and unambiguously disclosed to the person skilled in the art. The harmfulness to novelty of a disclosure must therefore be measured by what it conveys to the average reader without demanding difficult deductions or even creative thought processes from him, but with full application of the information and knowledge expected of him at the time of priority and of general specialist knowledge. The question of inventive step is judged according to the problem-solution approach. In the interest of an objective assessment of the invention which is intended to prevent a retrospective approach, the first step is to determine the closest prior art, then to define the technical task and then to examine whether the claimed invention would have been obvious to a person skilled in the art in view of the closest prior art and the technical task.

(iii) confidentiality of communication between clients and their patent advisors

In Austria article 17 para. 2 of the law on patent attorneys (Patentanwaltsgesetz) contains the following provision regarding confidentiality:

Art. 1 (1) The patent attorney shall be obliged to act conscientiously in the representations taken over and to safeguard the interests of his party with zeal and loyalty. He is authorized to present openly all that he deems useful under the law for the representation of his party and to use all means of attack and defense in every way that does not contradict his mandate, his conscience and the laws.
(2) In particular, he shall be bound to secrecy with regard to the matters entrusted to him in his capacity as patent attorney and may also refuse to testify as a witness before the courts and administrative authorities with regard to such matters.
[supplemented by the current amendment (not yet in force): The same applies to the shareholders and members of the supervisory bodies of a patent attorney company provided for by law or the articles of association.]
(3) The provision of para. 2 shall apply mutatis mutandis also to patent attorney trainees and other employees of the patent attorney.

For the next amendment of this law further adjustments of this provision might be taken into consideration regarding further alignment with the relevant provisions of the Attorneys Act (RAO) on obligation of confidentiality (Art. 9 RAO), which currently reads as follows:

(2) The lawyer shall be obliged to maintain secrecy with regard to the matters entrusted to him and the facts otherwise disclosed to him in his professional capacity, the secrecy of which is in the interest of his party. He has the right to confidentiality in judicial and other official proceedings in accordance with the provisions of procedural law. The same applies to the shareholders and the members of the supervisory bodies of a law firm provided for by law or by the articles of association.
(3) The lawyer´s right to secrecy pursuant to para. 2 second sentence may not be circumvented by judicial or other official measures, in particular by questioning auxiliary staff of the lawyer or by ordering the surrender of documents, carriers of image, sound or data or by confiscating them; special provisions on the delimitation of this prohibition shall remain unaffected.
(3a) To the extent required by the lawyer´s right to confidentiality in order to ensure the protection of the party or the rights and freedoms of others or the enforcement of civil rights, the person concerned may not rely on the rights set out in Art. 12 to 22 and Art. 34 of Regulation (EU) 2016/679 on the protection of individuals with regard to the processing of personal data, on the free movement of such data and repealing Directive 95/46/EC and Para. 1 DSG.