

ExCo Hyderabad 2011
Adopted Resolution
October 18, 2011

Resolution

Question Q217

The patentability criterion of inventive step / non-obviousness

AIPPI

Noting that:

- 1) AIPPI has decided to study inventive step / non-obviousness as it relates to patentability. This study commenced with examination of selection inventions, then followed with the definition of the person of ordinary skill in the art, and now is examining the larger issue of the definition and criteria of inventive step / non-obviousness in general.
- 2) AIPPI considered inventive step / non-obviousness among other issues with Q209 in Buenos Aires, but limited the inquiry into inventive step / non-obviousness to the specific context of selection inventions.
- 3) AIPPI followed this up by considering the definition of the person of ordinary skill in the art in the context of the inventive step requirement with Q213 in Paris, which specifically excluded the broader question of inventive step / non-obviousness in general.
- 4) Despite the importance of this question, AIPPI has not had many opportunities to study inventive step / non-obviousness. Q35, "Method and preparation of a study on the unification of law on patents," which included treatment of inventive step, was considered at the 1960 London Congress and resulted in a resolution at the Berlin Congress of 1963.
- 5) The resolution reached on Q35 relating to patentability requirements was brief on the subject of inventive step:

An invention is patentable provided:

...

c) It constitutes an invention. For example, there cannot be invention if the subject of the patent is obvious having regard to the state of the art.

Considering that:

- 1) There is almost unanimous indication by the Groups of the desirability of harmonization on the definition and criteria for inventive step / non-obviousness.
- 2) There is a reasonable degree of commonality among the Groups with respect to the definition of inventive step / non-obviousness.
- 3) There is considerable divergence among the Groups in terms of how the definition is applied in practice. However, the Groups fall predominantly into two categories: those that apply the problem-solution approach, and those that apply a general approach. Nonetheless, most Groups expressed a desire for a harmonized approach.
- 4) A cornerstone in the determination of inventive step / non-obviousness is the fictitious "person skilled in the art." AIPPI takes note of the position taken in the Q213 resolution, in particular that:
 - "a) This person possesses common general knowledge as well as knowledge in the field (or fields) to which the invention relates that the average person in that field (or fields) would be expected to have or which would be readily available to that average person through routine searches;*
 - b) This person possesses the skills that are expected from the average person in the field (or fields) to which the invention relates; and*
 - c) This person is able to perform routine experimentation and research and can be expected to obtain predictable solutions as compared to the prior art."*

Further, AIPPI takes note of the position taken in the Q213 resolution, in particular that:

"The assessment of the person skilled in the art should be made as of the priority date or other relevant date under applicable law for the purposes of assessing patentability."

- 5) There is a reasonable degree of commonality found on the issues of examination guidelines (found to be useful), interpretation of prior art and claims should be through the eyes of the person skilled in the art, lack of limitation of the number of prior art references included in a combination (provided requirements are met), relevance of technical field and technical problem to the inventive step inquiry (to varying degrees), allowance of late submission of data supporting non-obviousness, and use of secondary considerations.
- 6) There is considerable divergence of views among the Groups on a number of issues, including the use and definition of the technical problem, the requirements for teaching, motivation or reason to combine references, and disclosure of the technical problem in the specification.

Resolves that:

- 1) There should be a common definition of inventive step / non-obviousness accepted across all jurisdictions worldwide.
- 2) A claimed invention shall be considered to involve an inventive step ("be non-obvious"), if, having regard to the differences between the claimed invention and the prior art, the claimed invention as a whole would not have been obvious to a person

skilled in the art at the filing date or, where priority is claimed, the priority date, of the application claiming the invention.

- 3) In all administrative and judicial proceedings within a relevant jurisdiction, the definition of inventive step / non-obviousness should be applied in a consistent and uniform manner.
- 4) For evaluating inventive step / non-obviousness, the following framework is useful:
 - a) Identify the relevant prior art bearing in mind the nature of the invention;
 - b) Identify the difference(s) that distinguish the claimed invention from the relevant prior art;
 - c) Consider whether or not it would have been obvious for a person skilled in the art to have modified the relevant prior art to obtain the invention as a whole based on factors such as, but not limited to, common general knowledge, disclosures in the prior art, the technical problem to be solved and/or technical effects.
- 5) When evaluating inventive step / non-obviousness of the claimed invention:
 - a) the prior art should be interpreted as understood by the person skilled in the art; and
 - b) a prior art reference should be interpreted in the context of the reference as a whole.
- 6)
 - a) Lack of inventive step / obviousness of a claimed invention may be shown over a single prior art reference missing one or more elements of the claimed invention, if such one or more elements were within the common general knowledge of a person skilled in the art.
 - b) Two or more prior art references may be combined to prove lack of inventive step / obviousness. A reason to combine the references is required, but does not need to be explicit or implicit in the references. The reason to combine the references may come, for instance, from the common general knowledge of the person skilled in the art, from consideration of the problem to be solved by the invention, or from the closeness of the art.
- 7) Hindsight should not be used in evaluating whether it would have been obvious for a person skilled in the art to have modified the relevant prior art to obtain the invention.
- 8) The closeness of the technical field of the invention and the technical field of the prior art is relevant to the inventive step / non-obviousness inquiry.

The nature of the invention may permit consideration of prior art in fields not as close to the invention or not as close to the other prior art references.

- 9) Technical effects or advantageous results may be considered in determining inventive step / non-obviousness. The effects or results relied upon should be included in, or at least derivable from, the application as filed.

Data submitted later as well as data included in the application as filed should be considered as evidence of such technical effects or advantageous results during the inventive step / non-obviousness inquiry.

- 10) Evidence of secondary considerations may be considered to support the inventive step / non-obviousness of an invention.

Such secondary considerations may include unexpected / surprising or advantageous technical effects or results, evidence of commercial success, satisfaction of a long-felt need or unsolved problem, failure of others, copying by competitors, wide-spread licensing and overcoming technical skepticism.

A close connection between the claimed invention and the secondary considerations is required.

- 11) Examination guidelines for determining inventive step / non-obviousness should be established by national and regional patent offices. The guidelines may be helpful to examiners and applicants in order that examinations may be conducted in a fair, consistent, reasonable and efficient manner.

Such guidelines should be publicly available and explain the application of relevant laws and the procedural and analytical framework under which the inventions are examined.