



Question Q213 (Group Report)

National Group: AIPPI Switzerland

Title: **The person skilled in the art in the context of the inventive step requirement in patent law**

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1) Analysis of current law and case law

The suggested questions will try to analyze and to understand the definition of the “person skilled in the art” (hereinafter PSITA) in three steps: the notion of the “person”, the issue of its personal “skills” and finally the “technical field” in which these skills are exercised.

- 1) The study proposed by AIPPI starts with the consideration of the person as one of the elements of the definition of the person skilled in the art.*

The Groups are therefore requested to indicate if the person skilled in the art is one, or more, person.

A preliminary remark: According to the Swiss patent law, the inventive step requirement is not explicitly linked to the concept of the “person skilled in the art” as can be seen from Article 1, paragraph 2 - which is in contrast to the EPC (Article 56) - but the practice of the courts in Switzerland is very much influenced by the decisions of German courts and of the Boards of Appeal in the EPO. The leading decision of the Swiss Federal Supreme Court in this respect was released in 1994 (BGE 120 II 71) and made it clear that the PSITA is not always a single person with knowledge from only one field but can be a

group of persons from different technical fields, depending on the circumstances of the case to be decided.

At that time, the decision was revolutionary for the IP specialists but it is now generally accepted by the doctrine because the Boards of Appeal in the EPO have decided in the same sense, e.g. in T 0223/92.

If a skilled person is a team of people, then are the team members all the same or may they be different in their various attributes, specifically if such a team may comprise persons from various disciplines or having different levels of qualifications?

The team members can be from various disciplines (closely related fields or fields where it would be obvious to look for a solution of the identified problem). Except for specific situations, the members of a team would not have different levels of qualification.

A second preliminary remark: according to European practice, the first step in the analysis of the requirement of inventive step would be to study the prior art and to formulate the problem to be solved by the invention in light of the closest prior art.

Accordingly, the formulated problem will determine in which technical field (or fields) the solution has to be looked for.

2) *Is the skilled person a real person (or team of persons) or a hypothetical person?*

The PSITA is a hypothetical person. He is assumed to know the relevant state of the art but to have no imagination (T 0039/93).

3) *The person skilled in the art has to be analyzed in the frame of her/his personal capacities and attributes.*

At first, it is necessary to know whether and if so to which extent this person has reasoning and/or creative capacities or if he/she has merely the capacity to perform or execute the orders or instructions from other people.

As already indicated, the PSITA has no creative capacities and can only perform the obvious tasks given to him in a research project, i.e. he does not solve problems for which not already routine methods exist (see again T 0223/92). Although he can be expected to take account of solutions to the individual problems proposed in different secondary documents in the same or

neighbouring technical fields (T 0552/89), he would not try to overcome an established prejudice or take risks in unknown fields in order to find a solution of the problem to be solved (T 0455/91). See also Guidelines for Examination in the EPO, Part C, IV 11.3.

Another point that can be discussed is whether the personal attributes of the person skilled in the art are the same also for other circumstances in which the person skilled in the art may have a role, such as construction of the patent or for the consideration of the sufficiency of the disclosure in the specification, even if this last point goes beyond the scope of the present study.

The attributes of the PSITA are the same for all tasks where such person is supposed to give an opinion with the exception that, for the consideration of sufficiency of the disclosure, the PSITA has only general knowledge and skills.

Finally, the question that can be discussed is the issue of knowing if the personal attributes of the person skilled in the art are the same for different IP rights covering technical creations, like patents or utility models, species, etc., if they exist in the national law.

As there is no possibility to file applications for utility models in Switzerland or at the EPO, we cannot really answer the question but we think that the attributes of the PSITA would be the same.

4) *Another important aspect of the question is to know what are the personal skills of the “person skilled in the art”?*

At least, two important issues deserve to be analyzed:

- *What is the level of the qualification or skills of the person?*

The level of qualification of the PSITA depends on the technical field of the invention to be judged. He is neither an expert of the corresponding technical field nor a specialist with extraordinary knowledge (BGE 120 II 71).

- *And what are the nature and the scope of his/her knowledge?*

The nature and the scope of his knowledge is, in principle, not limited, with the understanding that this knowledge is confined by the technical field of the invention and of neighbouring fields where it would be

obvious to look for solutions. This knowledge can be acquired by normal searching in the prior art, whereby collaborators can also bring in their support (D. Grassi in sic! 5/1999). However, materials provided by an extensive search cannot be regarded to be common general knowledge (T 0206/83). When assessing inventive step during examination of a patent or patent application, an "ex post facto" analysis has to be avoided.

The second issue encompasses more precisely the question of the capacity to understand and to analyze the documents which are accessible to the person skilled in the art, this capacity being called "the general knowledge" and concerns the proof of the content of the "general knowledge":

a) what is the scope of such knowledge in general terms?

see above

b) is such knowledge limited to the general technical training of such person?

Yes, such knowledge should be limited to the general training of the PSITA (see above with citations of decisions)

c) to what extent is information in documents – articles or prior patents -considered to be included as part of such working knowledge?

In principle, there is no limitation - the PSITA knows everything in his field but has no imagination to further develop this knowledge - as long as this knowledge is relevant to the technical field of the invention as well as to related fields (T 0176/84 and BGE 120 II 71).

d) can such knowledge include information which the person may not have memorized, but can readily look up?

Yes, of course (e.g. D. Grassi)

5) *The question of the person skilled in the art raises also the problem of the moment of the evaluation of those skills: should they be all evaluated at the moment of the appreciation of the validity of the patent, i.e. at the moment of the priority date, or could they be evaluated also at the date when the patent is assessed by the Judge, for example in the infringement*

proceedings, where the validity can be debated jointly with the infringement claim? This may conduct to the differences of appreciation in case the notion of the equivalence is used in relation to the prior art.

The normal principle of evaluation shall be applied which is the moment of the priority or the filing date (if no priority is claimed) (see Guidelines for examination in the EPO, Part C IV, 11.7.1). In our opinion, this evaluation should not be mixed up with the consideration of equivalency.

- 6) *The next issue related to the definition to the person skilled in the art is the technical domain or "the art" in which his or her skills are performed. The first sub-question is to know if those skills are concentrated in one or several technical fields.*

Depending on the nature of the invention, the skills of the PSITA are concentrated in only one or in several technical fields which are related to the invention.

And the second one is related to the way the frontiers between different technical fields can be established: how this determination is assessed by the Judges or Patent Offices?

In Switzerland, there is no case law for this determination, apart from the general requirement that it is obvious - the PSITA has no imagination - to look for a solution of the problem in different technical fields. According to D. Grassi (see above), the nature of the invention – product, process or use – determines the frontiers. In practice, the frontiers are determined on the basis of the actually existing professions at the relevant point in time.

- 7) *The question is also to know what is the nature of his/her competence in the technical field and particularly if this competence theoretical or practical?*

This competence is theoretical as well as practical.

- 8) *The Groups are requested to indicate how in practice the assessment of the skills of the person skilled in the art is operated. What is the role of the opinion of the experts on this point?*

As already indicated, the skills of the experts in the technical field of the invention are normally above the level of the PSITA. The assessment of the

skills of the PSITA is made by the judge, usually after having heard the court expert.

- 9) *Finally, the Groups are also invited to present all other questions which may appear in the context of the question of the person skilled in the art.*

In our opinion, the practical question to be raised in the context of Q213 is probably not so much the definition of the PSITA but rather how realistic the practice of examiners is who have to determine what is the "**relevant**" prior art and who have to decide which document is the closest for the formulation of the problem to be solved by the invention. As mentioned before, the PSITA is supposed to know everything in his field with the consequence that the result of the search for prior art will determine the scope of his "knowledge" with the already indicated danger of an "ex post facto" analysis.

Another issue that might appear in the context of Q213 is the question what information is disclosed to the PSITA by a specific piece of prior art. We understand that there are different approaches among the different jurisdictions which range from a narrow interpretation sticking to the exact wording of the piece of prior art to an extensive understanding that encompasses equivalent solutions of the piece of prior art as well.

II) Future harmonization:

After assessing the national solutions, the Groups are invited to present their proposals for the possible harmonization and specifically the harmonized definition of the person skilled in the art. The object of this section is not to repeat all the questions related to the current statute of the national law, but to find the most fundamental points on which the international harmonization could be sought.

- 1) *Specifically, the Groups are invited to precise on which points they see the particular need of the international harmonization on the issue of the person skilled in the art.*

Although we have the impression that the attributes of the PSITA are quite comparable in all countries of the world, the terminology used for this hypothetical person is not unified. The expressions used in the EPO and in continental European countries are slightly different from those in Anglo-Saxon countries and in the USA the expression PHOSITA (person **having**

ordinary skill in the art) is becoming more popular. The differences may be only of a linguistic nature but could lead to misunderstandings.

- 2) *The Groups may indicate if the “person skilled in the art” standard should be assessed as a hypothetical model or on the contrary appreciated in concreto?*

It would be nice to get away from the well known hypothetical model but we see no alternative. The discrepancies between different instances and in different legislations could be much more important if the PSITA has to be defined "in concreto" in each individual case. A real person would have problems in restricting his knowledge to the one at the relevant point in time. How should we imagine this model to work?

- 3) *Should the skills of the “person skilled in the art” be only to execute other person orders or should they be creative and both practical and theoretical?*

Clearly, the PSITA should not be creative but he should possess both practical and theoretical skills.

- 4) *Should the art in which the skilled person intervene be of only one discipline, or should it cover several technical fields?*

The art should cover several technical fields if the invention is related to more than one field.

- 5) *The Groups are also invited to present all other suggestions which may appear in the context of the possible international harmonization of the definition of the person skilled in the art.*

We suggest picking up the problems raised in point 9 above.

Question Q213 (English Summary)

According to established practice of Swiss courts and of the European Patent Office, the "person skilled in the art" is not a real but a hypothetical person who is assumed to know the complete state of the art in the technical field of the invention but has no creative capacities. This person can also be a team of qualified persons from different technical fields, depending on the circumstances. The level of qualification depends on the technical field of the invention and the scope of his knowledge at the priority date is not necessarily limited by his technical field if it is obvious to look for solutions of the problem in a neighbouring field.

The Swiss group sees no alternative to this approach but suggests to look for a unified definition/terminology to be used, and to review the practice of patent office examiners in determining the "relevant" prior art (danger of "Ex post facto" analysis).

Further, the Swiss group is of the opinion that Q213 should not only emphasise on the knowledge and expertise of the person skilled in the art but also on the question of interpretation of the prior art by the person skilled in the art.

Question Q213 (French Summary)

Selon la pratique établie des tribunaux suisses et de l'Office européen des brevets, l'homme du métier n'est pas une personne réelle mais une personne fictive qui est présumée connaître l'art antérieur complet dans le domaine technique de l'invention, mais qui ne dispose pas de capacités créatives. Cette personne peut aussi être un groupe de personnes qualifiées issues de domaines techniques différents, si les circonstances le demandent. Son niveau de formation dépend du domaine technique de l'invention et l'étendue de son savoir au jour de priorité ne se limite pas nécessairement à son domaine technique, lorsqu'il serait évident de chercher des solutions au problème dans un domaine technique voisin.

Le groupe suisse ne voit pas d'alternative à cette pratique, mais suggère de viser une définition/terminologie unifiée et de réexaminer la pratique des examinateurs des offices de brevets lors de l'identification de l'art antérieur "pertinent" (danger d'analyse ex post facto).

Le groupe suisse estime aussi que Q213 ne doit pas seulement mettre en évidence les connaissances et compétences de l'homme du métier mais également traiter la question de l'interprétation de l'art antérieur par l'homme du métier

Question Q213 (German Summary)

Entsprechend der ständigen Praxis von Schweizerischen Gerichten und des Europäischen Patentamtes ist der "Durchschnittsfachmann" keine reale sondern eine hypothetische Person, der unterstellt wird, den gesamten Stand der Technik auf dem technischen Gebiet der Erfindung zu kennen, aber über keine kreativen Fähigkeiten verfügt. Diese Person kann auch eine Gruppe von qualifizierten Personen aus verschiedenen technischen Gebieten sein, wenn es die Umstände erfordern. Das Ausbildungsniveau hängt vom technischen Gebiet der Erfindung ab und der Umfang seines Wissens am Prioritätstag ist nicht notwendigerweise beschränkt auf sein technisches Gebiet, wenn es nahe liegen würde, für Lösungen des Problems in ein Nachbargebiet zu suchen.

Die Schweizer Gruppe sieht keine Alternative zu dieser Praxis, möchte aber vorschlagen, eine vereinheitlichte Definition/Terminologie anzustreben, und die Praxis der Prüfer in den Patentämtern bei der Feststellung des "relevanten" Standes der Technik zu überprüfen (Gefahr der "Ex post facto" Analyse).

Die Schweizer Gruppe vertritt ausserdem die Ansicht, dass die Q213 nicht nur das Fachwissen und die Fachkompetenz des Durchschnittsfachmanns in den Vordergrund stellen sollte, sondern auch die Frage der Interpretation des Standes der Technik durch den Durchschnittsfachmann beleuchten sollte.