

Question Q217 - Report

***The patentability criterion of inventive step
/ non-obviousness***

Frage Q217 - Berichterstattung

***Das Patentierbarkeitskriterium der
erfinderischen Tätigkeit***

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➤ Draft Process

- Swiss National Group
- Committee Meeting Discussion

➤ Resolution

➤ Relevance

National Group:

- Working Guidelines with 37 questions
 - EPO standard for inventive step applied
 - Swiss patent law Art. 1 par. 2: reference to "*person skilled in the art*" missing
 - Claims and prior art interpreted as understood by a person skilled in the art
 - EPO "problem-solution approach" used for assessing inventive step
 - Advantageous effects/secondary considerations can play a role
 - Harmonization of inventive step desirable

Draft Process (international)

Q217

Working Committee:

- 39 Group reports and Summary Report
- Leadership of Committee from 4 corners of the globe. US, AR, DK, JP
- Identified areas of commonality, consensus and divergence
- Recognized support for harmonization
- Concerns given divergence of approaches

Working Committee Meeting Discussion:

- 1.5 h for definition of inventive step / non-obviousness
- Framework for evaluation reduced to one (instead of with/without problem-solution approach)
- Hindsight became a separate point 7)

Resolution

Q217

- Points 1 and 2 express the common definition
- Points 3 and 4 express the common framework for both administrative and judicial proceedings
- Points 5 through 10 express additional considerations:
 - (5) from the perspective of the person skilled in the art
 - (6) the number of references
 - (7) avoidance of hindsight
 - (8) the closeness of the technical field of the prior art
 - (9) data of advantageous results or technical effects
 - (10) use of secondary considerations
- Point 11 usefulness of examination guidelines

Def.: inventive step / non-obviousness

- 2) A claimed invention shall be considered to involve an inventive step (“be no-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.

- Definition is more comprehensive, but in line with local law
- Evaluation of inventive step more likely with technical problem and problem-solution approach
- Commercial success will probably not be considered
- Rest of Resolution is almost in line with local practice