

INVENTIVE STEP

From a commercial point of view

INVENTIVE STEP/NON-OBVIOUSNESS

Whether an invention is inventive or not is assessed differently in EPO and US

EP : inventive step

problem solution approach

- i. Identify closest prior art
- ii. Define problem to be solved
- iii. Does another prior art document disclosed a solution to the problem ?

US: obviousness

Graham factors:

- i. the scope and content of the prior art;
- ii. the level of ordinary skill in the art;
- iii. the differences between the claimed invention and the prior art; and
- iv. objective evidence of non-obviousness.

KSR vs. teleflex decision by the Supreme court: “person skilled in the art” no longer need to be motivated by one prior reference to combine it with another prior art reference

ARGUING FOR INVENTIVE STEP/NON-OBVIOUSNESS

A rejection based on inventive step may very often be questioned

Even when the Examiner has identified prior art documents that together disclose all features of the invention, the invention may still be inventive/non-obvious.

Evaluate the cost vs. benefit

Is the scope of the patent application sufficiently important to justify the cost relating to arguing against the Examiner.

ARGUING FOR INVENTIVE STEP/NON-OBVIOUSNESS

US and EP:

Impermissible hindsight: Examiner not allowed to use hindsight. The knowledge of the skilled person must be evaluated at the date of filing.

Teaching away: One prior art document may teach away from combining it with another prior art document

Incompatible documents: The prior art documents may present technologies that cannot be combined (see example next page)

US:

objective evidence of non-obviousness:

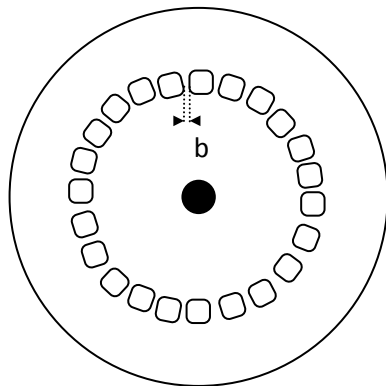
- i. commercial success;
- ii. long-felt but unsolved needs;
- iii. and failure of others

ARGUING FOR INVENTIVE STEP/NON-OBVIOUSNESS

Example:

US, optical fiber with air holes separated by silica regions of width $b < 600\text{nm}$

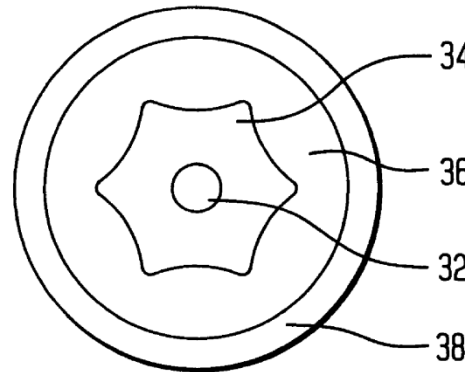
Invention



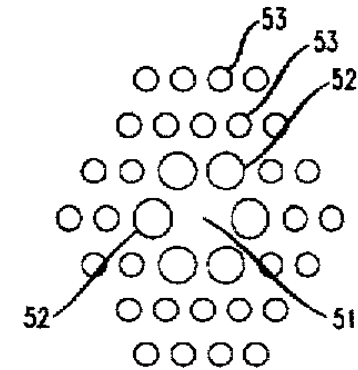
?

=

Prior art



+



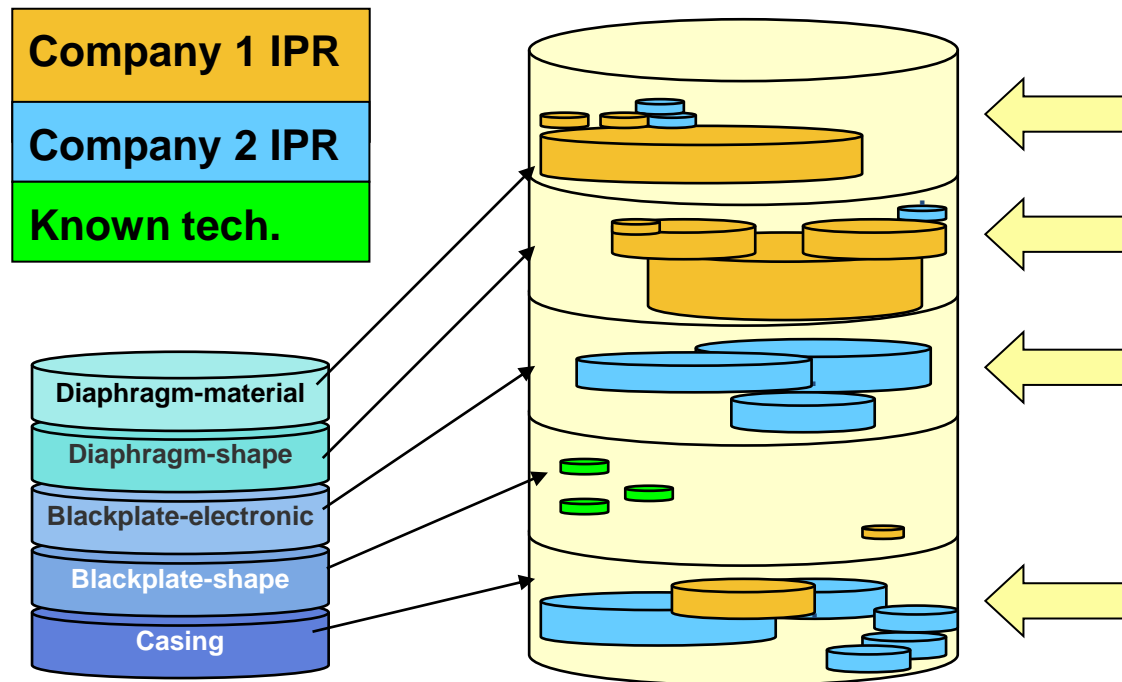
Together, the prior art documents disclose all features of the optical fiber according to the invention. However:

Paragraph VI of § 2143.01 of the Manual of Patent Examining Procedure prohibits an obviousness rejection if the proposed modification changes the principle of operation of a reference.

INVENTIVE STEP VS. COMMERCIAL VALUE

Commercial value not proportional to height of inventive step

Inventions with small inventive step often have a large commercial value



INTERNATIONAL TREATIES

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Paris Convention



1883

173 countries

Priority rights

Equal rights for all

Scope of protection for process patents

Unfair competition

INTERNATIONAL TREATIES

WIPO Convention

World Intellectual Property
Organization



1967

Ratified by 184 countries

To promote protection of IP in the whole world through cooperation.

To secure administrative cooperation between member states

Administrate the PCT system, the Paris Convention, the Patent law treaty.

INTERNATIONAL TREATIES

PCT

Patent Cooperation Treaty



1970

Ratified by 142 countries

Basis for whole PCT system.

A PCT application can cover all PCT countries for a limited period.

Only open for members of the Paris Convention.

INTERNATIONAL TREATIES

EPC

European Patent Convention



1973

36 member states + 3 Extension states

Basis for whole EP system

An EP application can cover all member states for the period up to grant and including opposition period.

Only open for members of the Paris convention

INTERNATIONAL TREATIES

London Agreement



2008

Ratified by 10 EPC member states
DK,FR,DE,LI, LU, MO, NL,SE, CH, UK

Reducing translation cost for applicants of EP patents

Members can only require translation of claims if the patent text is in a selected language of DE, FR or GB

In case of enforcement – whole patent should be translated

INTERNATIONAL TREATIES

TRIPS (WTO)

Trade-Related Aspects of IPR



1994

All WTO countries: 153 and 29
on observation list

Superior rules such as.

- Length of patent(20 Years)
- Rules for what minimum should be patentable.
- Minimum rules for scope.
- Compulsory license
- Enforcement
- Misuse of patents

INTERNATIONAL TREATIES

PLT

Patent Law Treaty



2005

Signed by 61 Countries Ratified by 22 Countries

To harmonizes administrative rules

- formal rules
- basis for 'filing date'
- invalidating of rights
- reestablishment
- form and content of a patent application
- representation

CURRENT WORK ON THE TREATIES AND IMPLEMENTATION

EPC: Divisional applications

Time limit for filing divisional applications (2 years)

April 2010

Europe: EU patent

EU patents will be European patents having unitary effect in the territory of the European Union

US, EPO, JP, UK, DK, DE, KR, CA: Prosecution highway

Accelerated patent prosecution procedures by sharing information between

Initiatives to limit the number of Claims/inventions

EPC: 15 claims included in basic filing fee. Further claims 200Euro each

US: 5/25 limit