

# Fordham 2008

# Comparative Obviousness

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# What is the purpose of the inventive step requirement?

1. Some subjective reward for brilliance
2. To prevent patents from being granted for what naturally lies in the road of development (ob via)
3. To cut down on the number of patents

# Early Days

- **Hotchkiss v Greenwood (U.S.1850)**
- unless more ingenuity and skill ... (is applied in the new invention) ... than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention.

- **Harwood v. Great Northern Railway**  
(England 1865 – Lord Westbury)
- I think the law is well and rightly settled, for there would be no end to the interference with trade and liberty of adopting any mechanical contrivance, if every slight difference in the application of a well-known thing should be held to constitute the ground for a patent."

# Cripps Question (Sharpe & Dohm v. Boots (England, 1928))

- Was it for all practical purposes obvious to [the skilled worker in the field concerned], in the state of knowledge existing at the date of the patent, which includes the literature then available to him and his general knowledge, that he could [make the invention claimed].

# UK Act 1932

Set out specific grounds of invalidity for the first time including the invention is obvious and does not involve any inventive step having regard to what was known or used prior to the date of the patent.

# Germany

- Imperial Patent Act of 1877 required only novelty and industrial applicability. But from an early date both the patent office and the court imposed additional requirements: an advance in the art (*technischer Fortschritt*) and a degree of inventivity (*Erfindungshöhe*). Originally these may have been alternatives but by the 1930's both were required.

# **Cuno Engineering v. Automatic Devices Corp (U.S. 1940)**

- Invention must "reveal the flash of creative genius not merely the skill of the calling."

# 35 USC 103(1952)

- A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

# Graham v. John Deere (U.S. 1966)

- While the ultimate question of patent validity is one of law, the section 103 condition lends itself to several basic factual enquiries. ... the scope and content of the prior art are to be determined; the differences between the prior art and the claims at issue is to be determined; and the level of ordinary skill in the pertinent art resolved.

- Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or non obviousness, these inquiries may have relevancy.

# EPC (1973) – effective 1978

- Under Article 52, to be patentable, an invention must be susceptible of industrial application, new and involve an inventive step.

Article 56 defines Inventive step in the following terms:

- An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art

- The German text uses the words “erfinderische Tätigkeit” and in the French “activité inventive” for the English “inventive step”. The choice of words in German was apparently deliberate to avoid using the old German term “Erfindungshöhe”, 1) to avoid implicit incorporation of specific national traditions into the interpretation of the EPC and 2) to avoid the possibility that literal translation of the term as “inventive height” would set the bar too high.

# European National Laws

- During the late 1970's European national laws were amended to conform with the language of the EPC. As will be seen later, however, this has not resulted in them all taking the same approach.

# The EPO's Problem and Solution Approach

- **Fibre reactive compounds/Bayer (T1059/95)**
- to assess inventive step on an objective basis, it is necessary to identify the closest state of the art as the starting point, to determine in the light thereof the technical problem which the invention addresses, to verify that the technical problem is solved by all embodiments encompassed within the claimed solution and to examine whether the claimed solution is obvious or not in view of the state of the art.

# What is the closest prior art?

## Guidelines C-IV 11.7.1

- The closest prior art is that combinations of features, disclosed in one single reference, which constitutes the most promising starting point for an obvious development leading to the invention. In selecting the closest prior art, the first consideration is that it should be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention.

- In practice, the closest prior art is generally that which corresponds to a similar use and requires minimum of structural and functional modifications to arrive at the claimed invention

# Who is the Person skilled in the art?

- Whilst ... generally accepted definitions of the notional "person skilled in the art " do not always use identical language to define the qualities of such a person, they do have one thing in common, namely that none of them suggests that he is possessed of any inventive capability. On the contrary, it is the presence of such a capability in the inventor which sets him apart from the notional skilled person.(T39/93)

# Guidelines C-IV 11.4

- The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.

# Germany

- Problem and solution approach similar to EPO, but with less emphasis on identifying a particular piece of prior art as the closest.
- A tendency to look for creative achievement as well as technical progress and other objective factors as primary indicia of inventive activity.

- German Supreme Court requests information on the steps the person skilled in the art had to do in order to get the solution of the patent, whether the person skilled in the art has a reason to start in the direction of the steps that are leading to the invention and what are the pros and cons that the person skilled in the art would evaluate in getting to the solution of the patent on the basis of these kind of considerations.

# England

## Manual of Office Practice

- Based on **Windsurfing v. Tabur Marine (1985)** and **Pozzoli v. BDMO (2007)** sets out test as
- 1(a) Identify the notional “person skilled in the art”;
- 1(b) Identify the relevant common general knowledge of that person;

- 2 Identify the inventive concept of the claim in question or if that cannot be done, construe it;
- 3 Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- 4 Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

- The test requires two different assessments of what has occurred prior to the filing of the patent application:
- a determination of what is common general knowledge forming part of the background against which obviousness is to be judged; and
- the prior art that is to be considered in making the definitive determination of obviousness,

- Expert evidence on what is common general knowledge is crucial;
- Once the common general knowledge is established the prior art (possibly including combinations if they can be put together by an unimaginative man with no inventive capacity, but often a single reference) is reviewed in the light of that common general knowledge.

# Japan –Patent Law Section 29(2)

- When an invention could easily have been made, prior to the filing of the patent application, by a person of ordinary skill in the art to which the invention pertains,, on the basis of an invention or inventions [in the prior art] a patent shall not be granted for such an invention ...

# JPO Guidelines

- One skilled in the art has:
  - 1. Common general knowledge;
  - 2. Ability to carry out ordinary technical means for research and development;
  - 3. Ability to exercise ordinary creativity in selecting materials and changing designs.

- Rejection is proper when
- 1) the invention is selection of an optimal material, workshop design modification or mere juxtaposition of features;
- 2) there is probable cause or motivation to make the invention
- **HOWEVER**
- Advantages set out in the specification can be used to substantiate inventivity.

- Little attention is paid to “objective indicia” of non-obviousness.

# U.S.A.

- Patent is presumed valid. Clear and convincing evidence needed for a court to hold it invalid.
- Contrary to Europe therefore the PTO has the burden of getting it right.

# KSR v Teleflex

Supreme Court April 30, 2007


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- “... as progress ... is expected in the normal course, the results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise, patents might stifle rather than promote the progress of the useful arts.”

# *Thank You!*

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