

Standing Committee on the Law of Patents

Twenty-Fourth Session
Geneva, June 27 to 30, 2016

PROPOSAL BY THE DELEGATION OF SPAIN

Document prepared by the Secretariat

1. The Annex to this document contains a proposal submitted by the Delegation of Spain, entitled “Additional Studies on the Assessment of Inventive Step”, for consideration under item 6 of the draft agenda: Quality of patents, including opposition systems.
2. *The members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

PROPOSAL: ADDITIONAL STUDIES ON THE ASSESSMENT OF INVENTIVE STEP

INTRODUCTION

1. The topic of “Quality of Patents, including Opposition Systems” has remained on the agenda of the Standing Committee on the Law of Patents (SCP) since the 16th session.
2. The first proposal on this topic was presented by the delegations from Canada and the United Kingdom (document SCP/16/5).
3. This document is intended to be a sub-item under the component “Process improvement” as outlined in document SCP/16/5. Later, the Spanish proposal SCP/19/5 aimed at “improving the knowledge of the requirement of inventive step” was approved by the Committee.
4. As a result of the approval of that proposal SCP/19/5, the Secretariat drew up a study SCP/22/3, that focused on the figure of the person skilled in the art, on the methods used for the assessment of inventive step and on the concept of evidence.
5. As a follow up to this study on inventive step, during the 23rd session of the Committee, representatives from several States (United Kingdom, Colombia, USA and Spain) gave presentations on the assessment of inventive step in their respective Patent Offices.
6. It would be desirable to study in greater depth the concept of inventive step and its evaluation, since patent professionals agree that this is the patentability requirement of most difficult assessment.
7. This delegation considers that it would be highly useful for Member States if the Secretariat carried out a study or a series of studies on the most difficult aspects of “assessment of inventive step”. The study or studies would tackle their definition, and the way they are addressed in the different regions and/or the most relevant patent offices, including examples and case law if possible.
8. For instance, these could be some of the topics to be included in the study or studies:
 - Common general knowledge: Its combination with the State of the Art;
 - Combination: juxtaposition vs synergic effects;
 - The danger of hindsight analysis;
 - Secondary indicia;
 - Selection inventions;
 - Problem invention; and
 - The assessment of inventive step in the chemical sector (Markush claims, enantiomers. etc.).
9. Once the study or studies are completed, there could be an exchange session where experts from the different regional groups would provide presentations on some of those issues with examples illustrating their examination practices.

10. In the opinion of the Spanish Patent and Trademark Office (OEPM), improving the knowledge about the requisite of inventive step is a question of interest to all Member States, no matter their level of development. Likewise, it would be of interest to users and society in general. A correct assessment of inventive step will help granting patents to inventions that really deserve them.

[End of Annex and of document]