



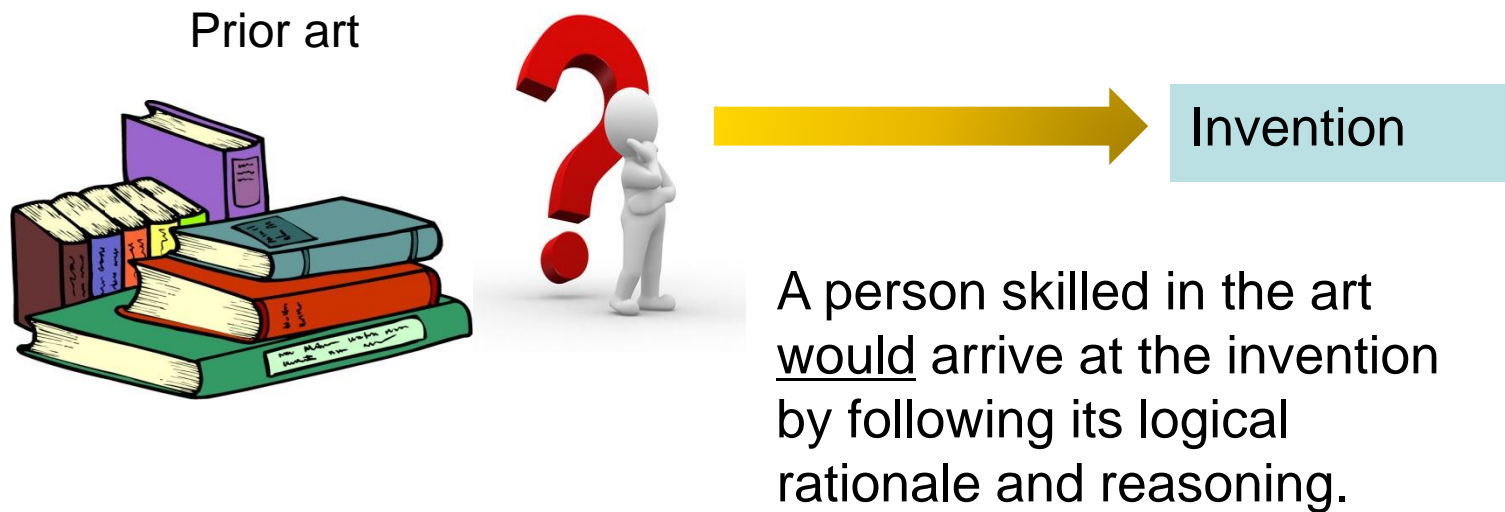
Further Study on Inventive Step

Standing Committee on the Law of Patents (SCP)
Twenty-second session (July 9 to 12, 2018)

Presentation by the Secretariat

SCP/22/3: Study on Inventive Step

- ❑ Definition of the person skilled in the art
- ❑ Methodologies employed for evaluating inventive step
- ❑ The level of inventive step (obviousness)



SCP/28/4: Further Study on Inventive Step (Part 1)

- ❑ Common General Knowledge: Its Combination with the State of the Art
 - ❑ Combination: Juxtaposition vs Synergetic Effects
 - ❑ Danger of Hindsight Analysis
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- Based on the information provided by MSs (available on the SCP electronic forum website: <http://www.wipo.int/scp/en/>)
 - A collection of factual information without analysis or recommendation



Common General Knowledge

Person skilled in the art

In general:

- a hypothetical person
- having ordinary skill in the art
- **being aware of, or possessing, common general knowledge in the relevant art on the relevant date**



What is Common General Knowledge?

- In general, background knowledge a man in the relevant art is expected to have
 - ex. basic handbooks and textbooks
 - Wide circulation of a paper alone does not make its content as common general knowledge
 - In general, knowledge commonly known to and generally accepted by the large majority of those in the art
- Come from various sources
- Knowledge available outside the country?



Combination: Juxtaposition vs Synergetic Effects

Combination of prior art

Inventive step determination

- Combination of teaching of prior art references and common general knowledge allowed

True combination inventions

Inventions having **synergetic effects**

= functional interactions among the features lead to a combined effect that is **different from (or bigger than) the mere sum** of the effect of each feature

→ Obviousness of the combined invention **as a whole** shall be determined to deny inventive step
[NOT obviousness of each individual element]

Juxtaposition / Aggregation

Mere juxtaposition/aggregation of features

= having **no synergetic effects**
= functioning independently

→ Obviousness of each individual feature is enough to deny inventive step

In some jurisdictions, results of mere juxtaposition or aggregation of known inventions are not “inventions”.

Person skilled in the art would combine prior art references?

Considerations are given to, e.g.,

- (i) Nature and contents of the teaching
- (ii) Amount of selections required to isolate the separate teaching (number of combines pieces of teaching)
- (iii) Teach away from combination
- (iv) General technical problems of the field; technical trends and demands
- (v) Age of the document
- (vi) Advantageous effects
- (vii) No more than yield predictable results (for combination of known elements according to known methods)

Part of the overall determination as to whether the claimed invention is obvious or not



Hindsight

Hindsight

Mental bias in evaluating past events, where the evaluator knows the outcome of the events.

- A patent examiner has information about a new invention (+how it works in comparison to prior art)
- Danger of underestimating inventiveness of the new invention

- Evaluation of inventive step from the level of knowledge of a person skilled in the art **at the time of filing (or the priority date)**
- Standard methodologies for assessing inventive step are considered useful to minimize the danger of hindsight.

Risk of hindsight

- Hindsight bias at the **different stages** of inventive step assessment
ex. determination of the closest prior art; technical problem to be solved; combination of prior art
- Combination of prior art is particularly vulnerable to hindsight
 - Search of prior art references and their combination is informed by the nature and features of the invention
- Guidance to avoid improper hindsight analysis

Thank you.