Reply from the French Delegation to circular C.8403 on inventive step and sufficiency of disclosure with reference to the 22nd Session of the Standing Committee on Patents (27 - 31 July 2015)

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At the 21st session of the Standing Committee on Patents (SCP) it was agreed that the International Bureau would prepare a study on the concept of'« inventive step » (particularly the definition of the term « a person skilled in the art », the methods used to assess inventive step, and the degree of inventiveness required to meet the criterion of inventive step), in addition to sufficiency of disclosure. Within this framework, the WIPO International Bureau has requested member states to provide information on national or regional legislation, manuals or guidelines relating to patent examination, court orders or other sources with regard to these two issues.

In order to reply to circular C.8403, the French Delegation would like to provide the following information:

1) *Inventive step :*

Legal provisions :

In France, the concept of inventive step is governed by article L. 611-14 of the Intellectual Property Code (IPC). According to this article, «*An invention shall be considered to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents referred to in the third paragraph of Article L-611-11*[1]*, such documents shall not be considered in deciding whether there has been an inventive step*».

These provisions correspond to Article 56 of the European Patent Convention.

In order to appreciate the criterion of inventive step, the key date is the filing date of the application or the priority date of the application, if priority has been claimed.

An opinion on the novelty and inventive step of each patent application is provided in a written opinion on patentability accompanying a preliminary search report. As such the patent examination guidelines of the National Institute of Industrial Property (INPI) provide

[1] *According to Article L611-11 paragraph 3, state of the art also includes patent applications that have a filing date prior to the filing date of the patent and which have not yet been published*

information on the notion of inventive step. However, a lack of inventive step does not lead to a rejection by the patent filing office; it is a matter for the courts.

French courts are thus called upon to rule on nullity actions against national patents or European patents that designate France. The inventive step of an invention can be the subject of a primary examination by the court in which the nullity action is conducted or the subject of an incidental examination or counterclaim when it primarily deals with an infringement action for example.

In order to find out if a claimed invention involves an active step or not, the judge has to ask himself if a person skilled in the art would have managed to arrive, in an obvious manner, at a result corresponding to the terms of the claim on the filing date, considering the state of the art on that date. Three criteria need to be taken into account in order to appreciate the inventive step of an application: the state of the art, a person skilled in the art and non-obviousness.

Definition of the term « a person skilled in the art» :

French legislation does not provide a definition of a person skilled in the art. However, French case law has provided clarifications on what is meant by « a person skilled in the art ».

The person skilled in the art is a person skilled in the technical field that is linked to the invention. According to doctrine and case law in France, the person skilled in the art needs to be defined in precise terms and is a person skilled in the technical field in which the problem is posed and in which the invention seeks to solve.

(Cf. in particular the Court of Cassation, Civil Division, Commercial Division dated November 20, 2012 N.11-18.440[2]).

The Court of Cassation has affirmed on several occasions that *« A person skilled in the art is a person who possesses normal knowledge of the technique in question and is capable, with the aid of his professional knowledge alone, of understanding a solution to the problem which the invention seeks to solve»* (see decisions of the Court of Cassation, Commercial Division dated October 17, 1995 and November 20, 2012[3]). In other words we are dealing with a specialist who has « average » qualifications and who possesses normal knowledge of the field that is concerned by the technical problem that the invention proposes to solve.

The skills of a person skilled in the art will depend upon the sector and the nature of the invention. He shall have the level of an average technician in a technical field that is relatively simple: He shall be a «qualified specialist» for a more complex technical field.

According to French case law, a person skilled in the state of the art does not possess any professional knowledge with regard to an area of specialization other than his own (see decision of the Court of Cassation, Commercial Division, dated February 26, 2008[4]). It admits that a person skilled in the art may possess knowledge that is more general in nature and not

[2] http://www.legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte=JURITEXT000026672975&fastReqId=1441822042&fastPos=1

[3] http://www.legifrance.gouv.fr/affichJuriJudi.do?idTexte=JURITEXT000007034660
http://www.legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte=JURITEXT000026672975&fastReqId=1441822042&fastPos=1

[4] http://www.legifrance.gouv.fr/affichJuriJudi.do?idTexte=JURITEXT000018204497

necessarily linked to the specific field in question, or knowledge of neighboring fields posing identical or similar technical problems.

ii)-iii) Method applied to assess inventive step and required degree of inventiveness (obviousness) to meet the criterion of inventive step :

French legislation does not define the methods used to assess inventive step or the threshold for inventive step. Assessment of inventive step must be as objective as possible.

Most of the time, the courts adopt a « problem and solution » approach and use secondary indications or criteria of inventive step (or non-obviousness) :

● The « problem and solution » approach comprises three stages: identification of the closest prior art[5] of the examined invention, formulation of the technical problem that is to be solved in order to arrive at the invention starting from the closest prior art, and obviousness of the solution that the invention brings to the problem for a person skilled in the art. If the technical problem is new or has never been posed, inventive step is characterized (since the invention is not obvious from the state of the art). If the problem is known to a person skilled in the art, it will be searched if, starting from a known problem and the state of the art available to the person skilled in the art, the solution to the invention is obvious for him (there will be inventive step if the provided solution is not obvious from prior art and processes known to a person skilled in the art or if a combination of known means leads to a result that is distinct from that obtained by each means).

● secondary indications or criteria of inventive step: certain secondary indications of non-obviousness can enhance assessment of the criterion of inventive step, in particular :

→ Prejudice overcome : The French courts recognize that prejudice overcome is an indication in favor of inventive step if that prejudice is technical in nature and goes beyond the technical habits of a person skilled in the art. The prejudice does not need to be formulated explicitly as such, neither in the patent nor in the prior documents. If the state of the art dissuades a person skilled in the art from using such and such a means in order to arrive at such a result and the invention overcomes this technical prejudice, inventive step is characterized.

→ Amount of time required to carry out an invention: if a significant amount of time elapses between the moment a problem is posed and the time it takes to carry out the invention in order to solve that problem, judges can take this indication into account when determining non-obviousness of the invention.

For examples of other indications or criteria, please refer to INPI guidelines on the examination of patent applications, which provide a chart listing a certain number of favorable or unfavorable indications relating to the existence of inventive step[6].

[5] Article L. 611-14 of the Intellectual Property Code excludes previously filed patents and those published after the claimed invention from the state of the art when considering inventive step.
[6] Guidelines – Heading No. I - Section C - Chapter VII page 13 :
http://www.inpi.fr/fileadmin/mediatheque/pdf/Directives_examen_brevet/TITRE_1.section_C.ch7.pdf

2) Sufficiency of Disclosure :

Article R 612-3 of the Intellectual Property Code stipulates that a patent application shall comprise a request for the grant of a patent, **a description of the invention**, accompanied where appropriate by drawings, one or more claims, an abstract of the technical content of the invention, and where appropriate, a copy of any earlier filings of which elements are reproduced.

The description of the invention plays a key role in the application for a patent. It discloses the invention, classifies the technical field in which it lies with regard to the prior art, and provides indications allowing a person skilled in the art to carry out the invention.

Article R 612-12 of the Intellectual Property Code lists the contents of the description:

1. A statement of the technical field to which the invention relates;

2. A statement of the background art known to the applicant and which can be regarded as useful for understanding the invention and drawing up the search report; the documents reflecting the prior art shall be cited wherever possible;

3. Disclosure of the invention, as claimed, in such terms that the technical problem and the solution proposed can be understood; where appropriate, any advantageous effects of the invention with reference to the prior art shall be stated;

4. A brief description of the drawings, if any;

5. A detailed description of at least one way of carrying out the invention; the description should normally be accompanied by examples and references to the drawings, if any;

6. A statement of the way in which the invention is capable of exploitation in industry if such exploitation is not obvious from the description or the nature of the invention.

i) Condition relating to sufficiency of disclosure :

The principle of sufficiency of disclosure is described in Article L 612-5 of the Intellectual Property Code: « *"The patent application must disclose the invention in a manner sufficiently clear and complete for it to be performed by a person skilled in the art ».*

Article R 612-12 of the Intellectual Property Code states that the description of the invention must allow understanding of the technical problem and the solution proposed by the invention. The description should comprise a detailed description at least one way of carrying out the invention.

Sufficiency of disclosure is evaluated in relation to a person skilled in the art. The person skilled in the art who acts as a reference for the evaluation of sufficiency of disclosure is the same person who is selected to assess inventive step (cf. the French Delegation's reply to question 1). The latter should be able to carry out the invention with the aid of the description and the drawings that he finds in the patent application, and by virtue of his basic general knowledge.

The Court of Cassation, in its ruling of November 13, 2013[7], confirmed that « *an invention is sufficiently disclosed when a person skilled in the art can perform the invention by reading the description and using his normal professional, theoretical and practical knowledge*». The

[7] Cf. attached copy of ruling

description should be sufficiently clear for a person skilled in the art and contain all necessary information to carry out the invention, wherein the latter does not need to prove that inventive step is required in order to carry it out.

Insufficiency of disclosure is grounds for nullity of a granted patent. Article L 613-25 of the Intellectual Property Code (IPC) states that : « *A patent shall be revoked by court decision*: […] *b) if it does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art ; […]».*The monopoly to exploit a patent is only granted to the applicant if the latter enriches the state of the art by providing full disclosure of his invention.

According to case law, disclosure is insufficient if it does not allow a person skilled in the state of the art to carry out the subject-matter of the invention or arrive at the expected result using his professional knowledge alone and by carrying out simple operations that do not involve excessive difficulty.

Insufficiency of disclosure can thus be recognized by trial judges when the description is imprecise, ambiguous or contains errors [8] or approximative elements that make reading insufficient for a person skilled in the art to carry out the invention or when the described invention cannot be carried out technically by a person skilled in the art[9] and it affects a fundamental characteristic required to carry out that invention.

Case law recognizes, however, that when evaluating sufficiency of disclosure, it is necessary to take into account not only essential technical information mentioned in the text of the patent application but also secondary information which can be deduced therefrom and which a person skilled in the art can find himself when reading prior art documents [10]. Drawing from prior art can therefore mitigate apparent insufficiency of disclosure.

Sufficiency of disclosure must therefore be evaluated with respect to the claims.

ii) Condition on which the claims must be supported by the description :

Article L 612-6 of the Intellectual Property Code stipulates that the claims shall define the matter for which protection is sought, and must be clear and concise and be supported by the description.

According to Article L 613-2 of the Intellectual Property Code, the extent of protection afforded by a patent shall be determined by the terms of the claims and the latter shall be interpreted in the light of the description and drawings.

Each of the claims must be based on the description, i.e. supported by the description, and cannot therefore be based on something that is not described. In the absence thereof, a patent application will be rejected by INPI, in accordance with Article L 612-12 8° of the Intellectual Property Code and a patent will be revoked under Article L 613-25 c) of the Code.

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[8] However, the Court of Cassation, in its decision of March 22, 2005, found that an error in the description of a traditional production method (mascara brush) did not nullify the patent on the grounds of insufficiency of disclosure since a person skilled in the art was easily able to rectify the error : http://www.legifrance.gouv.fr/affichJuriJudi.do?idTexte=JURITEXT000007487215

[9] See the attached copy of the decision of the Appeal Court of Paris, 4th Division B, of May 20, 2005, in which the Judge nullified Claim No.1 of a patent for insufficiency of disclosure on the grounds that it did not indicate certain technical conditions that were essential to carry out the invention by a person skilled in the art.

[10] See attached copy of the decision of the Appeal Court of Paris, 4th Division B, May 20 ,2005

The claim must correspond to the description and be able to be understood in itself, yet the applicant is not authorized to proceed with simple references. Article R 612-16 of the Code stipulates that « *the claims shall define the matter for which protection is sought in terms of the technical features of the invention. The claim may not, except where absolutely necessary, rely in respect of the technical features of the invention on simple references to the description or drawings*».

When a claim is ambiguous or badly worded, it is necessary to seek the exact meaning of the claim by resorting to the description or, where applicable, the drawings.

The Court of Cassation considered that insufficiency of clarity and precision in the claims of a patent is characterized when a person skilled in the art cannot carry out the invention with the aid of the description and the drawings (cf. decision of the Court of Cassation, Commercial Division, dated March 20, 2007[11]).

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[11] http://www.legifrance.gouv.fr/affichJuriJudi.do?idTexte=JURITEXT000017779486