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1. Inventive step

The requirement of inventive step is stipulated in Section 4 of the German Patent Act (*Patentgesetz*). It states that an invention shall be deemed to involve an inventive step if, having regard to the state of the art, it is not obvious to the person skilled in the art.

a) Definition of a person skilled in the art

The view of an average person skilled in the art is crucial when examining whether an invention involves an inventive step (German Federal Court of Justice, 24 March 1998 - X ZR 39/95 - *Leuchtstoff* - GRUR 1998, 1003, 1004).

The competent person skilled in the art is a person who is skilled in the field of technology of the invention and usually is assigned to solve the task. He is usually entrusted with the relevant development work in the respective field of technology, however, he is neither the user nor prospective customer nor purchaser nor contractor of the claimed subject matter (German Federal Court of Justice, 17 November 2009 - X ZR 49/08 - *Hundefutterbeutel*). However, the mentioned persons may make suggestions to the person skilled in the art.

The person skilled in the art working in the field of the invention is a fictitious normal expert (skilled practitioner) who has average knowledge, experience and abilities and is defined for each concrete individual case¹.

Since it is the average person skilled in the art that has to be taken into consideration, the person skilled in the art within the meaning of Section 4 of the Patent Act is neither an outstanding expert, nor a scientist of distinction nor an inventor².

If the problem to be solved refers to a second technical field, it can be expected that a specialist is consulted or becomes part of the team (German Federal Court of Justice, 15 September 1977 - X ZR 60/75 - *Börsenbügel* - GRUR 1978, 37)³.

b) Methodologies employed for evaluating the inventive step

The requirement of inventive step is an objective criterion whose assessment depends on three factors: the state of the art, the person skilled in the art and non-obviousness.

Before deciding whether the invention involves an inventive step the following must be identified: the relevant state of the art at the date of filing or date of priority, the competent skilled person and the ability/level of knowledge of the skilled person.⁴

¹ *Moufang*, in: Schulte, *Patentgesetz*, 9th edition, § 4 marginal number 37.

² *Moufang*, in: Schulte, *Patentgesetz*, 9th edition, § 4 marginal number 38.

³ *Moufang*, in: Schulte, *Patentgesetz*, 9th edition, § 4 marginal number 48

⁴ *Moufang*, in: Schulte, *Patentgesetz*, 9th edition, § 4 marginal number 8.



It is always a decision depending on the concrete circumstances of each individual case. There is no case law as to single universally applicable criteria that would allow drawing compelling conclusions about the presence of inventive step in other cases. Decisions in comparable cases can only serve as guidelines.

A quantum leap in the development, the overcoming of technical prejudices, prior futile efforts of experts, satisfaction of a long-standing need, a simple and low-cost way of manufacturing staple goods or the reduction of production costs may be indicative of an inventive step. (cf. Guidelines for the Examination Procedure⁵ at the German Patent and Trade Mark Office (DPMA), 3.3.3.2.4). According to the German Federal Court of Justice (German Federal Court of Justice, 30 July 2009 - Xa ZR 22/06 - *Dreinahtschlauchfolienbeutel* - GRUR 2010, 44) secondary indicia may merely in individual cases give an incentive to particularly critically consider known solutions as to whether, in view of common general knowledge, they provide sufficient evidence for obviousness of the invention and seem to contain, not only from an ex-post perspective, a suggestion leading to the invention.

For this purpose, the invention shall be assessed as a whole and must not be broken down into individual elements (German Federal Court of Justice, 15 May 2007 - X ZR 273/02 - *Papiermaschinengewebe* - GRUR 2007, 1055). The assessment of the claim shall always be based on the combined features. Isolated consideration of individual features is not admissible. In examining the inventive step of the subject matter of an invention that combines technical and non-technical features (for example, calculation rules, schemes for performing mental acts), the entire subject matter must be assessed including the non-technical features. It is not admissible to subdivide the subject matter of an invention and to restrict the examination of inventiveness to the part consisting of the technical features (cf. German Federal Court of Justice, 4 February 1992 - X ZR 43/91 - *Tauchcomputer* - GRUR 1992, 430).

Non-technical contents shall not be considered where they do not have any technical connection and do not even indirectly contribute to outlining a technical feature of the claimed subject matter (German Federal Patent Court, 24 May 2004 - X ZB 20/03 - *Elektronischer Zahlungsverkehr* - GRUR 2004, 664)⁶.

For the assessment of inventive step only those instructions shall be considered that determine or at least influence the solution of the technical problem by technical means (German Federal Court of Justice, 26 October 2010 - X ZR 47/07 - *Wiedergabe topografischer Informationen* - GRUR 2011, 125).

⁵ Available at: http://www.dpma.de/docs/service/formulare_eng/patent_eng/p2796_1.pdf.

⁶ Guidelines for the Examination Procedure (at the DPMA), 3.3.3.2.4, p. 9.



- c) Having regard to the prior art, the level of inventiveness (obviousness) to meet the inventive step requirement

As explained in item (b) for assessing whether an inventive step is involved it is indispensable to determine the state of the art and assess obviousness.

The invention is only considered to involve an inventive step if, having regard to the state of the art, it is not obvious. Doubts about whether the invention might have been obvious do not justify the denial of an inventive step (Federal Patent Court, 20 January 1997 - Ref. 20 W (pat) 55/95 - *Blatt für Patent-, Muster- und Zeichenwesen* 1997, 265). In the case “*Fischbissanzeiger*” (German Federal Court of Justice, 18 June 2009 - Xa ZR 138/05 - *Fischbissanzeiger* - GRUR 2009, 1039), the German Federal Court of Justice ruled that the “closest” prior art cannot always be taken as the sole starting point for assessing obviousness of a subject matter protected by a patent. Rather, the choice of the starting point (or also of several starting points) requires a particular justification which, as a rule, shall be derived from the skilled person’s efforts to find a better - or also just another - solution for a certain purpose than that provided by the state of the art.

As a rule, it is regarded as an indication of inventive step where an invention constitutes a leap forward in the improvement of the state of the art (German Federal Court of Justice, 18 September 1990 - X ZR 29/89 - *Elastische Bandage* - GRUR 1991, 120), a creative achievement exceeding average ability or a solution to a so far unsolved problem⁷. In the case “*Mikrotom*” (German Federal Court of Justice, 3 May 2006 - X ZR 24/03 - *Mikrotom* - GRUR 2006, 930), the German Federal Court of Justice ruled that it may support the presence of inventive step if the skilled person had to take several steps, which were not suggested by prior art, to find the subject matter of the invention. However, it is also relevant in this respect whether the work as a whole was routine or whether the skilled person met with difficulties, for example, because there were alternatives to one or several steps leading to different results.

The question of obviousness cannot be answered in the affirmative merely because the teaching of the invention could have been developed by an average person skilled in the art. Rather, the skilled person must also have suggested the solution/invention that means he must have had a motive for the invention (German Federal Court of Justice, 30 April 2009 - Xa ZR 92/05 - *Betrieb einer Sicherheitseinrichtung* - GRUR 2009, 746).

⁷ *Moufang*, in: Schulte, Patentgesetz, 9th edition, § 4 marginal number 56 et seq.



2. Sufficiency of disclosure

Pursuant to Section 34 (4) Patent Act the invention shall be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Furthermore, the subject matter of the application is defined by disclosure. Only what can be "directly and unambiguously" derived from the originally filed documents forms part of the disclosure of the patent application, not however any further knowledge at which the skilled person may arrive based on his common general knowledge or by modifying the disclosed teaching (German Federal Court of Justice, 8 July 2010 - Xa ZR 124/07 - *Fälschungssicheres Dokument* - GRUR 2010, 910).

a) Enabling disclosure requirement

A person skilled in the art can carry out the sufficiently disclosed invention if he, on the basis of the disclosure, is capable of performing the invention in practice without undue difficulties and without needing inventive skill (German Federal Court of Justice, 4 October 1979 - X ZR 3/76 - *Doppelachsaggregat* - GRUR 1980, 166) or is able to successfully bring about the aim of the invention without undue burden (German Federal Court of Justice, 16 June 1961 - I ZR 162/57 - *Rohrdichtung* - GRUR 1962, 80).

The average person skilled in the art has to be taken into consideration.⁸ Reproducibility must comprise the complete scope claimed for which protection is sought⁹ and the requirement of reproducibility must be fulfilled at the filing date or priority date (German Federal Court of Justice, 11 March 1975 - X ZB 4/74 - *Bäckerhefe* - GRUR 1975, 430). It is not possible to subsequently extend the subject matter beyond what has been disclosed in the application¹⁰.

The patent claim does not have to contain the indications necessary for the skilled person to carry out the protected teaching but it is sufficient that they result from the content of the patent specification as a whole (German Federal Court of Justice, 1 October 2002 - X ZR 112/99 - *Kupplungsvorrichtung II* - GRUR 2003, 223). It is only necessary to indicate the decisive direction in which the person skilled in the art may work of his own accord. Consequently, it is not necessary to describe the invention in every detail. However, generalisation must not go so far as to only state the problem and the result to be achieved. This is to prevent that IP rights are granted that cover all other ways and means to achieve the same result, which would be an obstacle to technical progress (cf. German Federal Court of Justice, 19 July 1984 - X ZB 18/83 -

⁸ *Moufang*, in: Schulte, Patentgesetz, 9. edition, § 34 marginal number 339.

⁹ *Moufang*, in: Schulte, Patentgesetz, 9. edition, § 34 marginal number 353.

¹⁰ Kraßer, Patentrecht, 6th edition, § 24 V. a).



Acrylfasern - GRUR 1985, 31). Moreover, scope and legal certainty of the IP right would not be clear.

It is not relevant for disclosure of the invention whether an item in the description has been mentioned as advantageous, useful or preferable compared to other simultaneously disclosed solutions. Special highlighting or emphasising, for instance as the subject matter of an embodiment or an example, or the marking as advantageous, useful or preferable simply make it easier to recognise that the corresponding feature or the teaching proper is disclosed as constituting a part of the invention claimed. However, the absence of such criteria does not exclude such disclosures (German Federal Court of Justice, 20 March 1990 - X ZB 10/88 - *Crackkatalysator* - GRUR 1990, 510)¹¹.

Pursuant to Section 10 (2) no. 7 of the Ordinance on Patent Procedures before the German Patent and Trade Mark Office (*Patentverordnung*),¹² the description shall provide at least one way of carrying out the invention claimed (see item 2 c)).

b) Support requirement

The requirement that the description and the claims must relate to the same invention results from Section 10 (2) no. 4 Patent Ordinance. It prescribes that the description shall indicate the invention for which protection is sought in the patent claims.

The extent of the claims and the description may differ but the claim must contain all essential features that are indispensable for carrying out the invention¹³ but does not have to contain all indications (German Federal Court of Justice, 24 September 2003 - X ZR 7/00 - *blasenfreie Gummibahn* - GRUR 2004, 47).

c) Written description requirement

The invention shall be disclosed in the patent application, Section 34 (4) Patent Act. Pursuant to Section 34 (3) Patent Act, this shall include the request, the description, the claims and the drawings, all parts of the disclosure being equivalent. If there are any inconsistencies between the individual parts of the disclosure, the disclosure as a whole is decisive (German Federal Court of Justice, 20 March 1990 - X ZB 10/88 - *Crackkatalysator* - GRUR 1990, 510).

However, usually, the disclosure can primarily be found in the description because it serves to represent the invention and shall be used to determine the scope of protection to interpret the patent claims according to Section 14, second sentence, Patent Act.

¹¹ Guidelines for the Examination Procedure (at the DPMA), 3.3.3.1, p. 7.

¹² Patent Ordinance available at: http://www.dpma.de/docs/service/formulare_eng/patent_eng/p2790_1a.pdf.

¹³ *Moufang*, in: Schulte, Patentgesetz, 9th edition, § 34 marginal number 106 et seq.



Pursuant to Section 3 Patent Ordinance, the patent application i.e. the request, the description, the claims and drawings (Sec. 34 (3) Patent Act) can be filed in writing or electronically with the German Patent and Trade Mark Office.

Further formal requirements are provided for in Section 10 Patent Ordinance. It states that the description shall:

- state the title of the invention;
- specify the technical field to which the invention relates unless it follows from the claims or the indications concerning the state of the art;
- indicate the state of the art together with the sources;
- describe the problem underlying the invention;
- indicate the invention for which protection is sought in the claims;
- indicate, unless it is obvious, one way in which the invention is capable of exploitation in industry;
- state any advantageous effects of the invention with reference to prior art and
- describe in detail at least one way of carrying out the invention claimed, using where appropriate, examples or drawings, indicating the respective reference signs.