

World Intellectual Property Organization (WIPO)
34, chemin des Colombettes
1211 Geneva 20
Switzerland

Reykjavik, 2 March 2015

Your ref: C.8403
Our ref: nr. 6.2 WIPO Ýmislegt 2015

Dear Sir/Madam,

Reference is made to a letter dated December 15, 2014 concerning the request for submission of information on requirements of inventive step and sufficiency of disclosure.

Following is the reply of the Icelandic Patent Office (IPO):

In Article 2(1) of the Icelandic Patent Act No. 17/1991, the requirements of novelty and inventive step are set forth. The provision reads as follows:

Patents may only be granted for inventions which are new in relation to what was known before the filing date of the patent application and which also differ essentially therefrom.

According to Article 8 a patent application shall be filed in writing, containing claims, description, abstract and drawings, if necessary. Paragraphs 1-3 of the provision read as follows:

An application for a patent must be made in writing and filed with the Patent Authority, or in the case referred to in Part III, with a patent authority in a foreign country or with an international organization.

The application shall contain a description of the invention, also comprising drawings if such are necessary, and a distinct statement of what is sought to be protected by the patent (patent claims).

The description shall be so clear as to enable a person skilled in the art to carry out the invention with the guidance thereof. If an invention concerns or requires the use of biological material, it shall be considered inadequately described unless the requirements according to Paragraph 6 are fulfilled. The application shall also contain an abstract of the description and claims. The abstract shall merely serve as technical information and it may not be taken into account for any other purpose.

In Article 8 (2) of the Act it is stated that the description shall be so clear as to enable a person skilled in the art to carry out the invention with the guidance thereof. The person skilled in the art is further defined in the Patent bill: *a person who has good knowledge and specialization in the field*. This person is thus not necessarily an expert in the field.

The grant of a patent may be opposed, according to Art. 21 of the Act, if it's considered that an invention is not described clearly enough to enable a person skilled in the art to carry out the invention. Article 21 reads as follows:

Anyone may file an opposition against the patent granted with the Patent Authority. Opposition shall be made in writing and reasoned and must be filed with the Patent Authority within nine months from the date the granting of the patent was advertised.

Opposition may only be based on the contention that the patent was granted despite the following:

1. the conditions of Articles 1 and 2 were not fulfilled,
2. the invention is not described clearly enough to enable a person skilled in the art to carry out the invention on the base of the description,
3. the subject of the patent is more extensive than the application in the form in which it was filed.

The Patent Authority shall advertise that an opposition has been filed.]

Art. 21(2)(2) has been applied in two opposition cases before the IPO, case No. 1758/2002 and No. 1774/2004¹. In the former case the claim was accepted. Clarifications were considered clearly to be missing in the description in order for a person skilled in the art to carry out the invention. The IPO suggested some alterations to the description which the holder approved, but claims as to lack of novelty and inventive step were rejected. The Patent was re-published with further clarifications in the description. The decision of the IPO was appealed, but the Board of Appeal confirmed the IPO's decision.² Later on the case was brought to courts, but the case only concerned novelty and inventive step and possible breach of the plaintiff's patent rights.³ The claims in the latter case were rejected.

With regard to other issues, the IPO has a contract with the Danish Patent and Trademark Office (DKPTO) concerning examination. DKPTO thus examines Icelandic applications both with regard to novelty and inventive step, based on the DKPTO guidelines but in line with the Icelandic legislation.

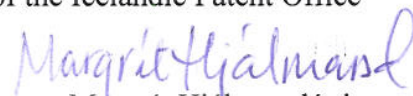
The Icelandic Patent Act No. 17/1991 is available here: <http://www.els.is/media/skjol/Patents-Act-w-126-2011.pdf>

The Regulation on Patents No. 477/2012 is available here:

http://www.els.is/media/skjol/ENS_B_nr_477_2012_mbr_938_2013.pdf

Please do not hesitate to contact the IPO, should further information be required.

Yours sincerely,
on behalf of the Icelandic Patent Office


Margrét Hjálmarsson
Head of Legal Affairs

¹ Available here (in Icelandic): <http://www.els.is/urskurdir/einkaleyfi/>

² The decision of the BoA is available here (in Icelandic):
<http://www.els.is/media/skjol/pdf/akvardanir/urskurdir/2004/2004-15%20flokunarbunadur%20fiska%20-%20ursk%20LOKA.pdf>

³ The Supreme Court case No. 57/2006 is available here (in Icelandic):
<http://www.haestirettur.is/domar?nr=4207&leit=t>