

Reply from Norway on the Questionnaire on requirements of inventive step and sufficiency of disclosure.

Inventive Step

There are no legal provisions in the Norwegian Patents Act defining a person skilled in the art nor the methodologies imposed for evaluation of the inventive step nor the level of inventiveness. Definitions and guidance are provided in the Patent Examination Guidelines, Part C, Chapter IV. These Guidelines are in consistence with the EPO Patent Examination Guidelines.

The Norwegian Patent Examination Guidelines is not translated into English, but the relevant guidelines are explained below. Unofficial translations of the Norwegian Patents Act and the Norwegian Patents Regulations into English are available on the homepage of the [Norwegian Industrial Property Office](#)

- (i) the definition of a person skilled in the art

The Patent Examination Guidelines, Part C, Chapter IV Section 5.6 provides a description of "A person skilled in the art", according to which a person skilled in the art shall be presumed to be an average practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything included in the "state of the art", in particular the documents cited in the search report, and to have had at his disposal the normal means and capabilities for routine work and experimentation. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability, see T 32/81, OJ 6/1982, p225. There may be instances where it is more appropriate to think in terms of a group of people, for example, a research or production team, than a single person. This may for instance apply in certain advanced technology such as computers or telephone systems and in highly specialized processes such as the commercial production of integrated circuits or of complex chemical compounds. The person skilled in the art is considered to have the same skill level when assessing inventive step as when assessing whether the description is clear enough.

- (ii) Methodologies employed for evaluation the inventive step

According to the Patent Examination Guidelines the "Problem and Solution" approach should be used when assessing the inventive step.

In the "problem and solution" approach there are three main stages:

- a) Determine the closest prior art
- b) Establish the technical problem to be solved, and
- c) Consider whether or not the claimed invention, starting from the closest prior art art and the closest technical problem, would have been obvious to the skilled person.

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

According to the Patent Examination Guidelines, when determining a "person skilled in the art", it must be answered whether there is any teaching in the prior art as a whole that would (not simply could, but would) prompt the skilled person, faced with the technical problem, to modify or adapt the closest prior art while taking account of that teaching, thus arriving at something falling within the terms of the claim, and thus achieving what the invention achieves.

In other words, the point is not that a skilled person **could have** reached the present invention by modification or adaptation of the prior art, but rather **would have** done so because the teachings of the prior art lead them to that solution. All in the hope of solving the technical problem or achieving a beneficial effect (see T 2/83, OJ 6/1984, 265).

Sufficiency of Disclosure

(i) Enabling disclosure requirement

The Norwegian Patents Act, Section 8 second paragraph, third period states:

“The description shall be sufficiently clear to enable a person skilled in the art to carry out the invention on the basis thereof.

Further requirements are outlined in the Regulations to the Norwegian Patens Act, section 9.

“The description shall only contain information and specifications that contribute to an understanding of the invention.

Biological material shall be described in accordance with the guidelines laid down by the Norwegian Industrial Property Office. For generally available biological material, information must be provided of how it can be obtained. The description of biological material in accordance with section 8a of the Patents Act shall contain all information of importance to the characteristic features of the biological material to which the applicant has access. “

The Patent Examination Guidelines states that the specific part of the description shall provide further explanation of the invention, preferably illustrated by examples of embodiments, with reference to any drawings. The invention shall be exemplified to the extent that the claims are sufficiently supported.

A detailed description of at least one way of carrying out the invention must be provided. Since the application is addressed to a person skilled in the art, it is neither necessary nor desirable that details of well-known characteristics is provided, but the description must specify all characteristics that are essential for carrying out the invention in sufficient detail in order to make it obvious to the skilled person in the art how the invention can be put into practice.

(ii) support requirement

The Norwegian Patents Act, section 39 states that:

“The extent of the protection conferred by a patent shall be determined by the patent claims. The description may serve as a guide to the understanding of the patent claims.”

According to the Norwegian Patents Act, Section 8 second paragraph, it is presumed that the patent claims must be supported by the description.”

According to the Patent Examination Guidelines, Part C, Chapter III, this means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art, see (T 409/91, OJ 9/1994, 653).

(iii) Written description requirements

The Norwegian Patents Act, Section 8 provide the following provisions regarding written description requirements:

“An application for a patent shall be filed in writing with the Norwegian Industrial Property Office or, in the cases referred to in Chapter 3, with a patent authority or an international organization as referred to in section 28.

The application shall contain a description of the invention, including drawings where necessary, and a precise statement of the subject matter for which protection by the patent is sought (patent claims). The fact that the invention relates to a chemical compound shall not imply that a specific use must be disclosed in the claim. The description shall be sufficiently clear to enable a person skilled in the art to carry out the invention on the basis thereof. An invention which relates to or uses biological material, in the cases referred to in section 8a, only be considered to be disclosed in a sufficiently clear manner if the requirements of section 8a are also complied with.

The application shall also contain an abstract of the description and patent claims. The abstract shall merely serve as technical information and may not be taken into account for any other purpose.

The inventor shall be identified by name in the application. If a patent is applied for by someone other than the inventor, the application shall contain a declaration from the applicant stating his right to the invention. If the Norwegian Industrial Property Office finds reason to doubt the applicant's right to the invention, the right can be required proven.

The applicant shall pay the prescribed application fee. A prescribed annual fee shall also be paid for every fee year beginning before the application is finally decided upon.

A fee year in accordance with this Act comprises one year and shall be reckoned the first time from the day on which the application was filed and thereafter from the corresponding day of the calendar year.”