

Standing Committee on the Law of Patents (SCP)

Information on the requirements of inventive step and sufficiency of disclosure

Comments from the Portuguese Office of Industrial Property

Inventive step (article 55° (2) Industrial Property Code):

i) The definition of a person skilled in the art

A person skilled in the art should be a usual practitioner in a field of technology aware of what was common general knowledge in the art at the relevant date, it is someone who has full access to the state of the art, normal ability for routine work but doesn't have inventive capability. The person skilled in the art might be a team and not just an individual (Portuguese guidelines and EPO guidelines).

ii) Methodologies employed for evaluating the inventive step

According to the Portuguese Industrial Property Code, article 55 (2), "*an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art*".

Related with inventive step criteria there are three important concepts:

- State of the art (article 56 Industrial Property Code):

"1- The state of the art shall be held to comprise everything made available to the public within the country or abroad by means of a description, by use, or in any other way, before the date of the patent application.

2- Additionally, the content of patent and utility model application filed prior to the patent application for effect in Portugal but not yet published shall also be considered as comprised in the state of the art."

- Person skilled in the art
- Obviousness

For evaluating the inventive step, the PT office uses the problem solution approach (PSA). The problem solution approach comprises 3 stages which allow a structured approach in 5 questions, which are:

- 1) What is the closest prior art?
- 2) What is the difference, in terms of the claimed technical features, between the claimed invention on the one hand and the closest prior art on the other?
- 3) What technical effect is caused by this difference?
- 4) What, therefore, is the objective technical problem underlying the claimed invention?
- 5) Would the skilled person solve this problem in the manner indicated on the basis of the totality of the prior art, without at any stage employing any inventive skill?

Consecutively to apply the problem-solution approach it is necessary to determine which document represents the closest prior art. The closest prior art should be the document which, since it belongs to the same or a closely related technical field, corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention (Portuguese guidelines).

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

According to the Portuguese Industrial Property Code, article 55 (2), "an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art".

The term “obvious” means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which do not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art (Portuguese guidelines).

However, even with this definition, what can seem “not obvious” to one person may seem quite obvious to another.

Therefore, article 55(2) stipulates that the question of inventive step must be judged from the standpoint of “a person skilled in the art” and the PT Office uses a deciding-making procedure, i.e PSA, to decide if an invention is obvious or not.

In the Portuguese legislation we also have utility models and according to the Portuguese Industrial Property Code, article 120 (2) *“an invention shall be considered as involving an inventive step, if it meets one of the following requirements: a) if it is not obvious to a person skilled in the art; b) if it offers a practical or technical advantage for the manufacture or use of the product or process in question”*.

In these cases the PT Office also applies the PSA to decide if the invention is obvious or not. However, if the invention is obvious but has a practical or technical advantage for the manufacture or use of the product or process in question, the invention shall be considered as involving an inventive step.

Sufficiency of disclosure (article 62 (4) Industrial Property Code):

According to the Portuguese Industrial Property Code, Article 62 number 4, *“the description shall give a brief, clear indication, with no reservations or omissions, of everything making up the invention and contain a detailed explanation of at least one way of making the invention, so that any person skilled in the art may carry it out”*.

A complete description of at least one way of carrying out the invention must be given in the application and the description must disclose any essential feature for carrying out the invention in sufficient detail for the skilled person the art put the invention into practice. One example could be enough, but if the claims cover a broad field, the

application should give a number of examples or describe alternative embodiments or variations extending over the area protected by the claims.

Also, claims shall define the object of the protection requested and shall be clear, concise, correctly written and supported by the description. 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.

When these criteria are not met, the applicant is invited to correct these irregularities.

The Portuguese Industrial Property Code in English can be found at:

<http://www.marcaspatentes.pt/index.php?section=337>

A manual on how to interpret the Industrial Property Code is also available at the INPI-PT website. It can be found, in Portuguese, at:

<http://www.marcaspatentes.pt/index.php?section=722>

Concerning our examination guidelines, we are currently up dating them and, consequently, they are not available online.