Questionnaire on Inventive Step and Sufficiency of Disclosure
C.8403

The answers to this questionnaire have been provided on behalf of:

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Inventive Step

(i) the definition of a person skilled in the art – article 6. and 7. section 2.6.2.3 Methodology of Patent Procedure – see http://www.indprop.gov.sk/swift_data/source/pdf/metodika_konania/text_vynalezy.pdf

6. If the task is complex in nature (e.g. complex chemical technologies), in evaluation of the inventive step (obviousness) the fictional person skilled in the art can be represented by a group of experts from various disciplines, who would under normal conditions solve the presented task.

7. It is obvious that the level of knowledge and professional skills of the fictitious person skilled in the art differs in individual cases, notably in regard to the technical field to which the invention pertains.

(ii) methodologies employed for evaluating the inventive step - sections 2.6.2.3 and 2.6.4.1.4 Methodology of Patent Procedure - see http://www.indprop.gov.sk/swift_data/source/pdf/metodika_konania/text_vynalezy.pdf

2.6.2.3 Inventive step

1. To grant a patent it is not sufficient that the subject-matter of the application is new. Patentable invention must be distinguished from the prior art not only with a novelty, it must also include a so-called inventive step.

2. Pursuant to Article 8(1) Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended, an invention shall be considered as a result of an inventive activity if it is not for a person skilled in the art obvious from the state of the art. When assessing inventive step, according to Article 8(2) Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended contents of patent applications, European patent applications and utility model applications which have not been published as by the day from which the applicant enjoys priority right shall not be taken into consideration.

3. The inclusion of "inventive step" as criteria of patentability is used to distinguish patentable invention from other formal new and beneficial inventions (not every formal new and useful invention is a result of an inventive activity). Patentable is an invention that contributes to the state of the art as a whole, or eventually enriches the state of the art.

4. Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended does not contain a definition of inventive step. It defines only the way of the practical evaluation of the inventive step, i. e. the invention contains an inventive step if it is not for a person skilled in the art obvious from the state of the art.

5. Everything that does not go beyond professional skills of the person skilled in the respective technical field is considered as being obvious from the state of the art. Patentable inventions thus lie beyond the normal routine engineering work.

6. If the task is complex in nature (e.g. complex chemical technologies), in evaluation of the inventive step (obviousness) the fictional person skilled in the art can be represented by a group of experts from various disciplines, who would under normal conditions solve the presented task.

7. It is obvious that the level of knowledge and professional skills of the fictitious person skilled in the art differs in individual cases, notably in regard to the technical field to which the invention pertains.

8. While the novelty can be evaluated only on the basis of a single source of information and a combination of multiple sources of information is inadmissible (except for the specific cases mentioned in Sec. 2.6.2.2), when assessing inventive step it is possible to apply two or more sources of information.

9. A restrictive condition is that the combination of different sources of the state of the art itself is obvious for the person skilled in the art. It is not sufficient to quote that the contents of two documents could have been combined, but the patent expert has to point out that the average skilled person in the art would inevitably come to the conclusion about the obviousness by the combination of information from two documents.

10. Clear and precise cross-references between documents, the neighborhood of technical fields and the similarity of the solved problem are examples of the types of mutual connection, which can be relied on as a part of an objective basis necessary when creating a properly reasoned argument. The general rule is, that the longer the chain of the number of information sources and mutual connection is, the weaker will be the final argument.

11. When assessing inventive step, i. e. non-obviousness, the decision is based on the presumption of non-obviousness. If a patent expert using clarity of evidence cannot show that the invention is obvious, the invention is considered to be the result of an inventive activity. Therefore, the non-obviousness objection must be duly justified in the course of the patent procedure (in the examination report).

12. The strong arguments favoring the conclusion that the invention is non-obvious are, for example:
- The task is has been known for a long time but the numerous attempts of experts to find solution of the task failed.

- There has been a widespread opinion among experts that the task can not be solved so as it is solved by the invention (i.e. overcoming the technical prejudice).
- The objective possibility to propose such a solution has existed long time before the filing of the application, since all prerequisites for the seemingly obvious conclusion have been long known, but nobody proposed such a conclusion, wherein the invention itself provided, thank to its use, significant technical-economic or commercial effect and fulfiled a long-felt need of public.

13. On the other hand, there are some indices indicating that the invention is obvious. The indices that indicate the obviousness of the invention are, for example:
- It concerns a specific solution that is fully and all ends up contained in a general solution which is generally known.
- It concerns a dimensioning of the known solution that represents only a simple concretization of a known principle (dependency).
- It concerns a kinematic reversal which is known in the theory of mechanisms or other known theories.
- The effect achieved by a new usage of a known object for a purpose for which it has not been used before results from the known characteristics of that subject (e.g. a simple replacement of a material).
- The effect achieved by transferring a method or a device to another technical field results from the already known characteristics of the method or device in question.
- It concerns a typical analogous procedure.
- The invention distinguishes from the prior art only by the technical equivalent of an element or relationship between the elements.
- The invention is merely an aggregate of the known technical means or operations.

14. The aforesaid indices indicating the obviousness of the invention can not be qualified as a presumption of obviousness and therefore in the cases where the invention in its nature falls into any of the above-mentioned indices it is required to carefully consider all arguments, that on the contrary, according to the opinion of the applicant, show evidence about the non-obviousness of the invention.

2.6.4.1.4 Inventive step in the case of nucleic and amino acid sequences

1. As mentioned in Sec. 2.6.4.1.3, in most cases, the novelty of a specific DNA fragment is recognized even if the full-length DNA sequence is known. However, in assessing the fulfillment of the condition of sufficient inventive step of such a fragment it is more complicated. In principle, obtaining a partial sequence of the DNA when the full-length sequence is known, represents for the person skilled in the art only a routine and prevailing method.

2. However, if this DNA fragment encodes a protein that has unexpected characteristics in comparison with the known protein, an inventive step of this partial DNA sequence can be acknowledged. It is similar with the mutant DNA sequences, where the naturally occuring sequence is known or even certain different mutants are known in the art. The novelty of the sequences is also recognized automatically, since the mutated DNA comprises novel features (new mutations), but as the mutation of DNA belongs in the given field among conventional methods, the inventive step for the new specific mutated DNA is recognized only when it has a qualitatively different effect that the person skilled in the art could not expect. The same rules apply when defining the amino acid sequences.

(iii) having regard to the prior art, the level of inventiveness (obviousness) to meet the inventive step requirement – article 7(2) and article 8(2) of the Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended http://www.upv.sk/swift_data/source/pdf/legislativa/platne_pravne_predpisy/pravo_01435.pdf

Article 7 Novelty
(2) State of the art shall be everything made available to public by any means of disclosure before the day from which an applicant enjoys priority right

Article 8 Inventive activity
(2) Contents of applications, European patent applications and utility model applications which have not been published as by the day from which an applicant enjoys priority right shall not be taken into consideration in determination of an inventive activity.

and articles 8, 9. and 10. section 2.6.2.3 Methodology of Patent Procedure - http://www.indprop.gov.sk/swift_data/source/pdf/metodika_konania/text_vynalezy.pdf

Sufficiency of Disclosure

(i) enabling disclosure requirement - article 37(4) of the Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended - http://www.upv.sk/swift_data/source/pdf/legislativa/platne_pravne_predpisy/pravo_01435.pdf

Article 37 Application
(4) An invention shall be described and explained in an application clearly and completely so that it can be carried out by a person skilled in the art.

(ii) Support requirement – article 5(1) Decree No. 223/2002 Coll. implementing the Act No. 435/2001 Coll. The Patent Act http://www.upv.sk/swift_data/source/pdf/legislativa/platne_pravne_predpisy/pravo_02223.pdf

Article 5
Patent claims
(1) The patent claims shall define the subject-matter for which the protection is sought, they must be clear, concise and supported by the description.

(iii) Written description requirement – N/A