# Notes reg. SCP/21/00 REV, § 24.

Sweden

*Inventive Step*

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

(ii) Methodologies employed for evaluation the inventive step

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

Comments:

(i) The person skilled in the art, "fackmannen" in Swedish, is defined in our guidelines, and can be either one person or a group, considered to have the normal skills and knowledge in a particular technical field, see our guidelines, ref. 3) below, and specifically, RL B5:2.3.

(ii) To evaluate inventive step, the problem-solution approach is commonly used, see our guidelines, ref. 3), and specifically RL B5:2.5.2. The inventive step requirement is according to Section 2 of the Patents Act, see 1). Please see 2) for unofficial translation into English.

(iii) In the last step in the problem-solution approach, it is determined whether there is any teaching in the prior art as a whole that would (not simply could, but would) have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves, see 3) and specifically RL B5:2.5.2.

*Sufficiency of Disclosure*

(i) Enabling disclosure requirement

(ii) Support requirement

(iii) Written description requirement

Comments:

(i) The requirements of the description regarding enablement and support are found in Section 8 of the Patents Act, see 1), and see 2) for an unofficial translation into English. Here it is stated that the description shall be sufficiently clear for it to be carried out by a person skilled in the art with the guidance thereof. The guidelines, ref 3) part RL B1:1.5.1, give further guidance regarding enablement.

(ii) In Section 6, Paragraph 4 of the Swedish Patent Regulations is found, in addition to what is stated in Section 8 of the Patents Act, that the invention shall be exemplified in such a way that the claims are sufficiently supported. Also in the Guidelines, ref 3), part RLB1:1.5.1 give further guidance regarding the requirements for support.

(iii) The requirements regarding the description is found in Section 2 of the Patents Decree which states that a Swedish patent application shall consist of a written communication with annexes, see 5) below.

References:


1) The Patents Act:
http://www.riksdagen.se/sv/Dokument-Lagar/Lagar/Svenskforfattningssamling/Patentlag-1967837_sfs-1967-837/?bet=1967:837

2) Unofficial translation of the Patents Act:
http://www.prv.se/globalassets/dokument/patent/informationsmaterial/the-patents-act---unofficial-translation.pdf

3) PRV Guidelines for search and examination, (only available in Swedish):
http://www.prv.se/sv/patent/lagar-och-regler/riktlinjer/

4) Patents Decree
http://www.riksdagen.se/sv/Dokument-Lagar/Lagar/Svenskforfattningssamling/Patentkungorelsen-1967838_sfs-1967-838/?bet=1967:838

5) Patent Regulations
http://www.prv.se/globalassets/dokument/om-prv/prvfs/pb_konsoliderad_140701.pdf

# Translation of guidelines etc.

Guidelines (RL= Riktlinjer)

RL B5:2.5.2.

RL B5:2.5.3.

RL B1:1.5.1

Section 2 of the Patents Decree

Section 6, Paragraph 4 of the Swedish Patent Regulations

**RL B5:2.5.2.**

The problem / solution method is described in the following steps, which also must be stated in the notice:

a. Determine the problem or problems which the applicant indicates in the application

b. Determine the closest prior art as it appears after the novelty search

c. Determine what the difference is between the claimed subject matter and the closest prior art

d. Analyse and put forward technical effects achieved with the help of these differences.

e. Formulate the objective problem, namely the problem solved by the difference between what is specified in claim and what appears in the closest prior art.

f. If the solution to that objective problem is found in another document, explain why it considered obvious for the skilled person to combine the two documents

g. Describe how the skilled person would go about solving the objective problem starting from the closest prior art

Comment to step a
To state the problem according to the applicant is not a part of the problem / solution approach. As a preamble to a discussion of inventive step the problem that is solved according to the applicant can be summed up. This can be done briefly with own words.

Comment to step b
The closest prior art is what can be deduced from a single document that relates to the technical field of the invention or a related technical field. It is not permitted to combine sections of the descriptions belonging to different embodiments, even if these are described in the same document, unless such combination is not specifically mentioned in the document. The closest prior art should constitute the most logical starting point for the skilled person.

The problem or the properties as shown in this document should be the same as, or at least very similar to those found in the application.
The documents most relevant for assessing novelty do not necessarily indicate the most relevant prior art for assessing inventive step. It is not primarily the largest number of common features that are crucial in determining whether a document is the most logical starting point for the skilled person. The crucial question is whether the skilled person would have chosen the document as its starting point to reach the solution to the stated problem.
If there are multiple documents, where each one individually could constitute closest prior art, it is often appropriate to test each of them with the help of problem / solution method.

Comment to step c
When identifying the characteristics that distinguish the invention according to the claim from the closest prior art, it is important that all differences are taken up, although not all will be able to contribute to the formulation of the objective problem.

Comment to step d
Identify the function or the technical effects of the differences. This technical effect has to be derived from the application, either directly or via the common knowledge of the skilled person. The difference between the invention of claim and the closest prior art may consist of both structural and functional technical features.

Comment to step e
The technical effect achieved by the features that are the difference between the claimed invention and the closest prior art is used as a base for formulating the objective problem. Most often the problem is formulated as the problem that provides the effect identified in”d" above. If the differences between the claim and the closest prior art do not entail any additional effects, in addition to that of the closest prior art, the problem is formulated as finding an alternative solution.
Here one should also put forward the question whether the objective problem is known or obvious to the skilled person. Some inventions lie in identifying a problem and at the time the problem is known, the solution then is obvious. Such inventions called "problem inventions" and they often indicate that the difference is a functional definition.
Sometimes there are several differences, which carry more than one technical effect and the objective problem can then be composed of several problems. If the differences do not entail any additional effect, it is possible to assess the problems individually. This should then be commented upon in the notice.
The objective problem can not contain parts of the solution according to the claims, as it will then seem obvious to the skilled person to solve it.
In this context, the word "problem" is not interpreted as an ingenuity that stimulates the imagination of the skilled person. It should rather be interpreted as a task the skilled person is facing.

Comment to step f
Where the objective problem is formulated the question is if, somewhere in the prior art, there is a solution to it. The solution, or a suggestion of the solution need not be in the closest prior art. It might as well be in another document or in the common knowledge of the skilled person.
If the solution to the problem is in another document, you should explain why the skilled person would combine the two documents. If the two documents belong to the same or related

fields of technology, it is enough to note just that. The farther apart the documents are, in terms of technology, the more important it is that the reasoning is clear and detailed.

Comment to step g
In this step it is determined whether the claimed invention involves an inventive step in relation to the closest prior art. This is determined by investigating whether the prior art as a whole contains information that would (it is not enough that he could) lead the skilled person to solve the problem. Starting from the closest prior art should it shall be accounted for how the skilled person would go about solving the objective problem. The description of the approach of the skilled person should be coherent and credible. In other cases it may be an indication that the invention is inventive.
Please also refer to RL B5:2.3 about the skilled person.

**RL B5:2.5.3.**
The skilled person, who is referred to, is familiar with everything that was known before the date of the patent application in the art. This skilled person may be considered to have access to all information in the prior art, particularly the documents that have been put forward in connection with the novelty search. The common knowledge of the skilled person includes such things as seen from textbooks and manuals, and insights that a person skilled in the relevant field has acquired through their work. In some cases, also reference in the form of databases can be included in the common knowledge of the skilled person.

The skilled person is in disposal of normal tools/aids and has the ability to perform routine construction work and routine trials. The skilled person is expected to perform experiments in order to clarify ambiguities on known technology but has no inventiveness. If the problem is such that its solution is to be found in another area of technology, it is the person skilled in that other area of technology whose knowledge and abilities must be taken into account when assessing inventive step. If the problem could be expected to occur in neighboring or similar technology it is considered that the skilled person also will seek the solution to the problem in these areas. In order that the skilled person would find the solution in the technology areas that do not belong to his own area of technology, and nor do belong to neighboring fields of technology, he shall be led to find the solution there through, for example, an instruction or another for it to be considered obvious.

There may be times when it is more appropriate to think of the skilled person as a group of people, for example, a research or production team, rather than a single person. Examples are some advanced technologies such as computers, telephone systems and very specialized processes of the production of integrated circuits or complex chemical substances.

Characteristic for the skilled person is that he is not questioning the established views.

**RL B1:1.5.1**

The applicant must formulate his application so that it fulfills the conditions of Section 8 in the Patents Act and Section 6 of the Patents Decree:

a) that the invention is sufficiently clear to the skilled person for performing and
b) the claims are fully supported in the description.

These requirements are important because if a patent is granted where the skilled person cannot perform the inventions; this can lead to the patent being revoked or invalidated, see Sections 25 and 52 in the Patents Act.

*a) Suffiency of disclosure*

The requirement that the invention is sufficiently clearly described is met if the description indicates at least one way for the skilled person to perform the invention.
The skilled person should not have to perform extravagant experiments to find out how the invention is to be performed. However, a certain amount of experimentation is accepted. The skilled person must be given such instructions so that without inventiveness and undue burden and with the help of common knowledge can person the claimed invention.
It may be necessary not only to describe the invention with structural terms, but also to indicate its function, unless this is absolutely obvious.

*b) Support of the claims in the description*

The scope of the protection to be assigned to a claimed invention shall correspond to the contribution to current technology that the applicant has provided with the application. The invention within the whole claimed scope shall therefore be made available to the public. The description must thus make it possible to carry out the invention throughout the whole area of the claims, see Section 6, paragraph 4 of the Patents Regulations.

To what extent embodiments or examples must be included in the description is determined in the light of that the skilled person shall be able to perform the subject matter that is claimed. A single embodiment may be sufficient but if the patent claims are broad in relation to this single embodiment shown, normally the requirements of Section 6, fourth paragraph of the Patents Regulations are not considered to be fulfilled. In the case of broader claim it is therefore required that the applicant presents further embodiments or in connection with the sole embodiments describes the various options and variants thereof.

In exceptional cases, a broader requirement is considered sufficiently substantiated with just one exemplary embodiment. This applies if the skilled person, in the application, in addition to the described example, receives such sufficient and clear instructions to him and using his common knowledge to perform the invention over the claimed scope.
When claims containing functional definitions, such as parameters, the information provided in the description must enable the skilled person to without undue burden achieve the desired function within the entire scope defined by claim.

If the claims contain several independent claims, the inventions according to those shall be accounted for in the description. Also the embodiments that are claimed in the dependent claim shall be stated in the description to the extent necessary for the assessment of the claim (Section 6, second and fourth paragraph of the Patents Regulations).

**Section 2 of the Patents Decree**
A Swedish patent application shall consist of a written communication (application document) with annexes.

> The application document shall be signed by the applicant or the applicant's representative and shall contain:

1. the applicant´s name and address and, if the applicant is represented by an agent, with the agent´s name and address,
2. the inventor´s name and address,
3. a short and concise title of the claimed invention,
4. when claimed by several persons jointly, information on which person is designated to receive messages from the Patent Office,
5. where appropriate, an indication that the application includes a deposit of a biological material referred to in 8 b § Patents Act (1967: 837), and
6. A note on the annexes that come with the application document.

The following annexes must be included with the application:

7. A description of the invention including drawings necessary to clarify the description, one or more claims and summary,
8. if the applicant is represented by agents who are not duly authorized in the application form, a power of attorney, and
9. if the invention is made by someone other than the applicant, stating the basis for the applicant's right.
10.

The application fee prescribed in § 45 shall be paid in connection with the application.

Regulation (2014: 435).

**Section 2 a of the Patents decree**

A patent application may be transmitted electronically to the Patent Office. It shall then be signed with an electronic signature. The Patent Office may issue regulations on electronic transfer of patent applications to the Patent Office Regulation (2008:368)

**Section 6, Paragraph 4 of the Swedish Patent Regulations**

The description shall, if not justified by special circumstances, be designed in accordance with the provisions of this section.

In a general part information about the field of the invention shall be included, as well as the technology underlying the invention (prior art). When accounting for prior art the applicant should refer to prior art literature as is known, of which the specified technology is clear. It should also be indicated what in the light of the prior art, what is achieved by the invention. This information/data data shall comply with what is stated in the claims and can consist of references to them.

The general part shall state how the invention is susceptible of industrial application if it does not follow of the nature of the invention or is otherwise clear in the application.

In a special part the explanation of the inventions should be included, if necessary with the exemplary embodiment or embodiments, with reference to the drawing. If drawings are filed, the specific part shall begin with a list of the drawings. The invention shall be exemplified so as to support the claims.