THE INVENTIVE STEP REQUIREMENT [1]

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PREAMBLE

In the Patent literature, as well as in the decisions of Patent Offices and Courts various statements have been made about the correct approach to the issue of "inventive step" or "obviousness" requirement, but the opinions differ from each other and they are still subjects of debate.

The evaluation of the inventive step seems to be one of the most difficult and complex tasks in Patent practice. This is so because, *inter alia*, this judgement is to be established upon a fine balance of legal fictions and probabilities. The onus of proof lies upon the competent examiner in a Patent Office or the Judge in a Court who decides whether an invention involves an inventive step, or not.

Prior to answering the ultimate question, whether the claimed invention involves any inventive step, some important legal issues are to be examined, such as:

- What prior art is to be considered?
- How is this prior art to be applied at all?
- What is the subject matter to be examined?
- What is the relevant date of the above examinations?
- Who is the competent person for answering these questions?

The above and other questions have been discussed in detail and many approaches have been published [2] [3] but in international practice a lot of controversies can be found.

The initial object of this presentation is to analyse the method of decisions on the basis of three famous inventive step tests briefly and, on the other hand, to make an attempt at formulating a new approach to the inventive step requirement.

STATUTORY BASIS IN HUNGARY

Although there is no provision in the prevailing Hungarian Patent Act [4] dealing expressly with the inventive step, this requirement is included in the requirement "novelty" (Art. 2). This will change, however, under the proposed new Patent Law. Accordingly, lack of novelty is established if the prior art would render the technical

solution obvious for a person having skill in the relevant art, that is, if the claimed invention could be realised without any creative activity that could be expected from a skilled person.

While the statutory basis in Hungary is not explicit, the inventive step requirement has been acknowledged to be essential for patentability in the case law since about the 1950's. The Hungarian Patent Office and the courts distinguish between the requirements of "novelty" and "inventive step" (which is additional to novelty), but studying the reasoning of the decisions in the individual cases the legal practice in evaluation of the inventive step requirement cannot be characterised as "unified".

BRIEF REVIEW OF THREE KNOWN TESTS

A) The GRAHAM-Test:

The United States Supreme Court applied this test in 1966 in order to make an objective assessment of obviousness in Graham v. John Deere Co. case ~5~ which essentially consists of the following steps:

1. The *scope and content of the prior art* to be determined;
2. *Differences* between the prior art and the claims at issue are to be ascertained;
3. *The level or ordinary* skill in the pertinent art is to be resolved;
4. Against this background, the *obviousness* or *non-obviousness* of the subject matter is determined;
5. *Secondary considerations* such as commercial success, long felt but unsolved needs, failure of others, etc., might be utilised to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

B) The OLIVER-Test:

In the United Kingdom the Chief Justice Oliver made another statement in the Windsurfing case in 1985[6] which was composed of the following steps:

1. The first is to identify *the inventive concept* embodied in the patent in suit;
2. The court has to assume the mantle of a normally *skilled* but unimaginative *addressee* in the art at the priority date and to impute to him what was, at that date common knowledge in the art in question;
3. The third step is to identify what, if any*, differences* exist between the matter cited as being "known or used" and the alleged invention;
4. Finally, the court has to ask itself whether, viewed without any knowledge of the alleged invention, these differences constitute steps, which would have been *obvious* to the skilled man or whether they require any degree of invention.

C) The BOCHNOVIC-Test:

The Canadian Lawyer and Patent Agent, J. Bochnovic formulated the following test in 1982[3]:

1. The first step must involve *construing the claims* of the Patent at issue;
2. The *prior art* against which each claim defining the alleged invention is to be compared must be established clearly;
3. The third consideration involves a comparative analysis of the claimed invention and the prior art to determine at least one *difference;*
4. *The background of the field of art:* this consideration involves a determination of the background against which the "difference" is to be evaluated. The field of art consideration will necessarily involve a modern-day construction of the "skilled workman in the workshop";
5. The evaluation of the difference - *inventive step;*
6. *Secondary considerations* may also be applied.

CONSIDERATIONS BEFORE FORMULATING A NEW TEST

After studying the above mentioned three tests, I conceived the idea that the first step of the test can be neither the determination of the prior art (see GRAHAM-Test), nor construing the inventive concept or claims (see OLIVER-Test and BOCHNOVIC-Test), respectively.

In this respect I have to point out that the above approaches are to be reconsidered for many reasons, which are as follows:

In the GRAHAM-Test the first step was "to determine the prior art" and it was suggested only as the third step to resolve "the level of ordinary skill in the pertinent art".

This sequence of the proposed steps may be misleading because the evaluation of the relevant prior art should be done from the viewpoint of the notionally skilled person, that is, it always depends on his or her *level of knowledge and ability for combinations.*

So in my view the first step to be taken is what was described as the third step in the GRAHAM-Test (that is: determining the level or ordinary skill), and the second step is the determination of the relevant prior art.

Another significant problem is that the first step suggested by the OLIVER-Test was "to identify the inventive concept", or according to the BOCHNOVIC-Test: "construing the claims".

In my opinion there is a problem with this approach in that how could one start with the identification of the inventive concept when that is one of the main questions of the test. Furthermore, the inventor even the Patent Agent sometimes - cannot be

expected to have identified in a clear and correct manner what he thinks to be the inventive idea at the priority date.

On the other hand, for construing the claims, first it is to be decided *who is the competent skilled person* because the prior art at the relevant date, the disclosure and the claims are to be considered through his eyes. It is to be noted that he is the addressee of the description and claims too, and that is why my conclusion is the following: *the* first *step* must involve t*he determination of the person having ordinary skill in the art.*

THE PROPOSED LEGAL TEST

For the evaluation of the inventive step requirement I would propose the following approach:

1. *The skilled person:* The first step is to determine the level and the ordinary skill in the relevant art of a fictitious person depending on the subject matter, furthermore his common general knowledge (is it that of a workman or a technician or an engineer or a researcher?).
2. *The Prior Art:* In the second step the prior art is to be established dearly and unambiguously. This step must also involve the determination of the relevant publications) which - together with the common general knowledge of said "skilled person' - form a general "basis" or "background" for assessment of the inventive step requirement. At the same time it is also to be presumed what a teaching said "skilled person" (item 1) could have got from this "background" at the material date, which is the priority date (except in the USA, where it is the date of the invention).
3. *The Claimed Invention:* The third step is to construe the claim (claims) of the Patent or Patent Application in question on the basis of the description an drawings, if any. The claims are considered as of the relevant date (see item 2). The examiner or judge has to put himself in the place of said fictitious "skilled person' (item 1) when interpreting the claimed invention.
4. *The Difference:* The fourth step involves a comparative analysis of the "claimed invention' (item 3) and "the prior art" (item 2) in order to define the existing difference or differences (in structure and/or in function).
5. *Secondary Considerations:* The fifth step may be to take the secondary considerations into account, such as "commercial success", "long-felt want satisfied", "unsuccessful attempts by others to solve the problem", "unexpected effect", "prejudice against the invention', "synergism", etc.
6. *The Ultimate Conclusion:* Inventive or obvious? In the last step of the test the examiner or judge has to put himself in place of the "skilled person' (item 1) and has to make a decision whether "the difference" (item 4) - in view of at least

one of the secondary considerations (item 5) - would have been obvious to said skilled person at the relevant date or comprises an inventive step.

CONCLUSIONS

I am convinced that the adoption of the above discussed legal tests at the Patent Offices and Courts would make easier and more objective the decision in the very complex and complicated problem of the inventive step requirement but, of course, even then it is to be considered as a serious intellectual task of the competent judge or examiner in every individual case.

In practice the selected legal test should always be adapted to any particular case to be decided.

The objectivity and standardisation of the inventive step requirement has been helped by the fiction of the "person having skill in the art", as well as by the secondary considerations. Said "skilled person' provides some external "measure" for this difficult decision.

In order *to* maintain t*he notional character* of the "skilled person" computer simulation of the inventive step evaluation test should be considered. In this case the relevant prior art references together with the common general knowledge of the predetermined skilled person, and the possible combinations thereof expected from him, could be input into a computer as a known "mass of information". On the other hand, the data of the secondary considerations should also be input. After running appropriate software, the computer would make the most objective decision.

Because recently the courts and Patent Offices have been quipped with computer systems, the possibility of the above simulation - at least for controlling the decision of a judge or examiner - seems to be useful, thereby reducing the burden on the Patent Offices and courts.

Such an approach is, of course, far from resolving all the difficulties concerning the assessment of the inventive step requirements, but it may provide some methodological support thereto.

It is hoped that with the international harmonisation of Patent laws the method for evaluation of the inventive step requirement will become more standardised and that thereby the Patent Offices and courts will have a chance to adopt amore unified practice in this respect.

Notes and Cited References:

[1] Presented firstly at the Meeting of the Hungarian Association for the Protection of Industrial Property (MIE) in Sopron, Hungary, May 28,1992;

[2] W.L. Hayhurst : "Obviousness: The Art of Second Guessing" Canadian Intellectual Property Review, Vol. 5, 1988, p. 7;

[3] J. Bochnovic: "The Inventive Step" IIC Studies, Vol. 5, Max Planck Institute, Munich, 1982;

[4] Hungarian Patent Law No. II of 1969, as amended by Decree-Law No. 5 of 1983, and Patent Rules according to Joint Decree No. 4/1969 (XII. 28) OMFB-IM, as amended by Decree No. 4/1983 of the Minister of Justice;

[5] Graham v. John Deere 383 U.S.1; 148 USPQ 459 (1966);

[6] Windsurfing International Inc. v. Tabor Marine (Great Britain) Ltd. (1985) RPC 59 at 80 (CA).

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