

## Question Q217



**National Group:** Sweden/Suède/Schweden

**Title:** The patentability criteria for inventive step / non-obviousness

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### I. Analysis of current law and case law

#### Level of inventive step / non-obviousness

##### 1. What is the standard for inventive step / non obviousness in your jurisdiction? How is it defined?

Section 2 of the Swedish Patents Act gives the following standard for inventive step: “A patent may be granted only for an invention which is novel in relation to what was known before the application date, and which also **differs significantly** therefrom.”

Sweden became a party to the European Patent Convention (“EPC”) in 1978, and in the bill to parliament the same year the Government proposed an amended Patents Act, harmonized with the PCT and the EPC. Moreover, the Government stated its expectation that practise in Sweden should develop in conformity with the EPC as interpreted by the European Patent Office. Parliament agreed and the new law was enacted.

More specifically, the described legislative process in 1978 laid down that the said section 2 shall be construed to be fully compatible with article 56 of the EPC: “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.**”

This was later confirmed by the Supreme Administrative Court and the Supreme Court, ruling that the Swedish accession to the EPC necessitates that Sweden in its internal application of its patent law, within the limits of Swedish law, considers the jurisprudence as established by the EPO.

Today, the internal examination guidelines of the Swedish PTO (Swe. Patent- och Registreringsverket - “PRV”) explicitly state that for the inventive step analysis, the problem-solution approach of the EPO and related case law are to be followed.

The Guidelines for Examination of the EPO, section C-IV, 11.4 states:

*“Thus the question to consider, in relation to any claim defining the invention, is whether at the priority date of that claim, having regard to the art known at that time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is not allowable for lack of inventive step. 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 does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.”*

In assessing the inventive step the so-called "problem-and-solution approach" is applied. Said approach involves the following main steps:

- i. determining the closest prior art (“CPA”);
- ii. assessing the technical effect achieved by the claimed invention as compared to the CPA;
- iii. establishing the objective technical problem to be solved; and
- iv. considering whether or not the claimed invention, starting from the closest prior art and in view of the objective technical problem, would have been obvious to the skilled person at the effective date (in other words, the date of filing or, when priority is claimed, the priority date).

The CPA is determined as the prior art document which is deemed to be the most promising springboard for an obvious development resulting in the claimed subject-matter.

The objective technical problem to be solved is arrived at by firstly comparing the claimed subject-matter with the CPA to establish any distinguishing features. These distinguishing features can be structural or functional. Thereafter, the technical effect that the distinguishing features impart on the claimed subject-matter is identified. In other words: what can the claimed subject-matter do that the closest prior art cannot? The thus-derived effect is then transposed into a statement of problem – the objective technical problem to be solved. The statement of objective problem must, however, be so formulated as not to contain pointers to the solution.

Whether the claimed subject-matter involves an inventive step depends on whether the skilled person, when starting from the closest prior art and being faced with the objective problem to be solved, would be motivated (be it on the basis of his common general knowledge or other prior art) to modify the closest prior art in such a manner as to arrive within the ambit of the claim.

The **objective technical problem** must not be confused with the **subjective problem**, i.e. the problem allegedly solved by the invention as described in the application. Although the objective problem is stated to be “technical” (and often is since it is a result of a comparison between the technical features and effect of the claimed invention with the corresponding aspects of the CPA) this concept is interpreted broadly and there is no formal requirement in this respect.

## **2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?**

In general, the standard has remained unchanged. The application of the standard has only evolved as a consequence of developing EPO jurisprudence.

One example of such evolution is the EPO project called “Raising the bar”, introduced some two years ago and calling to extend the knowledge of the skilled person into fields further away from the particular technical field of the claimed invention. It remains to be seen, however, what impact this initiative will have in practice.

Another example is to be found within the field of computer implemented inventions. Here, the patentability analysis of a particular invention has shifted from the question of the limits of the field of patentable subject-matter to that of inventive step, where non-technical features are ignored when analyzing the inventive step of a certain claim. See also question 32.

**3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?**

Yes, such guidelines are published and available at [www.prv.se](http://www.prv.se) (in Swedish). They are in general useful but need to be read in connection with Swedish and EPO case law.

EPO case law regarding inventive step is well summarized in the Guidelines for Examination in the EPO, Part C, Chapter IV, section 11. This section is very useful and effective in that examples are given to illustrate how the theory is put into practice.

**4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?**

The standard for inventive step is the same during examination and litigation concerning invalidity. But the fact that the litigation before the general court is an adversarial procedure normally results in that all aspects of inventive step or lack thereof are better researched and argued. Hence, the court often obtains a deeper understanding of these issues.

**Construction of claims and interpretation of prior art**

**5. How are the claims to be construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?**

According to section 39 of the Patents Act each claim should be read giving the words the meaning and scope which they normally have in the relevant art. The application of said section is subject to the Protocol on the Interpretation of Article 69 EPC.

The reading of the claims can involve a departure from the strict literal meaning of the wording of the claims in order to make technical sense. The claims, both as a whole and in its individual features, are to be understood as they would be by a skilled person within the relevant technical field. The general principle when interpreting a claim is that the skilled person should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity (i.e. building up rather than tearing down), to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent. The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding.

However, although a claim must not be interpreted in a way which is illogical or which does not make sense, the description may not be used to give a different meaning to a claim feature which in itself imparts a clear, credible technical teaching to the skilled reader.

This is reflected in EPC case law but also, for example, in the internal Guidelines of PRV.

When applying the problem-solution approach, the description will mainly be used for "clarification", among other things to determine who the skilled person is. If the description gives the words a special meaning, by explicit definition or otherwise, the examiner will ask the applicant to amend the claim so that the meaning is clear from the wording of the claim alone. If the meaning of a term in a claim can be interpreted in several ways in addition to what the applicant might have intended, PRV will interpret the term in its broadest sense when determining the scope of the claim for the purpose of search and examination.

**6. Is it possible to read embodiments from the body of the specification into the claims?**

An embodiment of the invention set forth in the specification does not involve a limitation of the claims. However, described embodiments not explicitly covered by the claims can in general not be read into the claims but the Protocol on the Interpretation of Article 69 EPC gives some room for interpreting claim language broadly. Specifically, the description can be used for interpretation of ambiguities and of specific features or terms used in claim language. If claims are not supported by the description they will in general – especially in the field of chemistry – have to be limited to supported embodiments.

When applying the problem-solution approach during examination, only features stated in the claim will be taken into account when establishing differences with respect to the closest prior art.

Furthermore, according to Swedish case law from the general courts it is not possible to read embodiments from the specification into the claims in order to widen the scope of protection in relation to how the scope is defined by the skilled person construing the claims (with due regard to the specification).

**7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?**

The disclosure of a prior art document is determined by what knowledge and understanding can and may be expected of the skilled person in the technical field in question. No part of a prior art document is to be construed in isolation from the remainder of the document: rather, each part of such a document has to be construed in the context of the contents of the document as a whole.

Reliance on inherent disclosures is permitted, because such disclosures are equally available to the skilled person as explicit disclosures. Hence, any prior art disclosure is novelty-destroying if the subject-matter claimed can be inferred directly and unequivocally from that disclosure, including features which for the skilled person are implicit in what is explicitly disclosed.

**8. Do the answers to any of the questions above differ during examination versus during litigation?**

No.

**Combination or modification of prior art**

**9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?**

Lack of inventive step may be found over one single prior art reference. In such a case the missing teaching would be a part of the toolbox of common general knowledge of a person skilled in the particular field or consist of non-inventive modifications of the CAP.

The question of whether certain subject-matter forms part of the common general knowledge could be settled by way of argument only, but in the case of any dispute, the extent of the

relevant common general knowledge has to be proven, for example by referring to basic handbooks and textbooks on the topic in question.

The skilled person also has at his disposal the means of carrying out normal, routine work such as optimization, experimentation and the like, for finding optimal ranges or parameters, etc. If he has a reasonable expectation of success, he will modify a single prior art reference using these means.

**10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?**

Starting from the CPA, if it can be shown that the skilled person would be expected to turn to a second prior art reference when being faced with the objective problem to be solved, for example because it deals with the same or a similar problem, then such a combination is allowable. The second prior art reference must disclose technical subject-matter which the skilled person realizes can work in synergy with the first prior art disclosed. The second prior art reference can be a document found in the same, an adjacent or broader technical field. There must however not be an inherent incompatibility between the two references.

An explicit teaching to combine is not required. In fact, such a teaching might even render the claimed subject-matter not novel since the teaching of the second piece of prior art could then be considered to have been incorporated by reference into the first piece of prior art.

There must, however, be some motivation for the skilled person to modify the CPA in the claimed manner. The answer to the question what a skilled person would have done depends to a large extent on the technical result he sets out to achieve. In other words, the notional skilled person is assumed to act not out of idle curiosity but rather with a specific technical purpose in mind.

See also question 12 regarding the case of more than two prior art references.

**11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?**

When looking for solutions to the objective problem, the skilled person will look for suggestions in not only the technical field of the claimed subject-matter, but also in neighboring and broader fields of which he could be expected to be aware and in which the same or similar problems arise. During examination the closeness of technical fields, whether the documents come from the same, neighboring or remote ones, will always be considered.

In practice the analysis normally starts from the problem described in the application. Only if examination shows that this problem needs to be reformulated, for example in light of more relevant prior art, this will be done in order to arrive at the objective technical problem.

**12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?**

It is allowed to combine more than two references.

One example of when this is the case is when the features or sets of features of a claim are a mere aggregation of features or sets of features which are not functionally interdependent, i.e. do not mutually influence each other to achieve a technical effect over and above the sum of their respective individual effects. For such a claim, the technical effect of each

feature or set of features is to be examined separately. Since in this case the technical effect of each feature or set of features is to be examined separately, the standard is no different from when only two references are combined.

In other cases, it may be allowable to combine more than two prior art references depending on the specific circumstances. The need to combine more than two prior art documents, however, may in itself constitute an indicator of the presence of inventive step. Again, there is no difference in the standard applied in respect of assessing inventive step as compared to the combination of merely two prior art documents.

**13. Do the answers to any of the questions above differ during examination versus during litigation?**

No.

**Technical Problem**

**14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?**

In answering this question, it should be noted that it is not a formal requirement that the subjective or objective problem are of a technical nature, see answer to question 1 above.

The objective problem to be solved is a cornerstone in the assessment of inventive step under the problem-solution approach, and is therefore highly relevant. The subjective problem, on the other hand, is primarily used in the prior art search, and is therefore in practice relevant in determining the CPA in relation to which the objective problem will be formulated.

Moreover, it ought to be pointed out that Sweden recognizes the potential patentability of so-called "problem inventions". Thus, the discovery of an unrecognized problem may, under certain circumstances, give rise to patentable subject-matter in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious.

**15. To what degree, if any, must the technical problem be disclosed or identified in the specification?**

According to the Swedish Patent Regulations (Swe. Patentbestämmelserna ("PB") 6 §) and EPC Rule 42(1)(c), the description must specify what is particularly attained by the invention in relation to prior art. The specification must disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood. Accordingly, the technical problem must be derivable from the specification.

The subjective problem (cf. answer to question 1) is per definition disclosed in the application. Regarding the objective problem, it must, according to the above, be derivable from the application as filed.

In other words, the extent to which a reformulation to a certain objective problem in light of new prior art is possible depends on the contents of the application and is assessed on the merits of each particular case. As a matter of principle, any effect provided by the invention may be used as a basis for formulating the objective problem, as long as that effect is derivable from the application as filed.

It is also possible to rely on new effects submitted subsequently during the prosecution by the applicant, provided that the skilled person would have recognized these effects as implied by or related to the technical problem initially suggested.

It must have been evident to the skilled person from a comparison of the claimed subject-matter with the CPA that the claimed subject-matter provides the technical effect upon which the reformulation of the problem is based, even if that effect is not disclosed as such in the specification.

### **Advantageous effects**

#### **16. What role, if any, do advantageous effects play in determining inventive step of non-obviousness?**

Technical progress is not a requirement for patentability under the EPC or Swedish patent law. Thus, for an inventive step to be present, it is not necessary to show improvement over the prior art. Alternative solutions to a known problem are patentable provided that such solutions are, in themselves, non-obvious. For this reason our answers to questions 17 through 20 below are not limited to advantageous effects but concern the claimed effect in general of the invention in question.

Nevertheless, being able to demonstrate an advantageous effect that the claimed subject-matter provides over the CPA can facilitate the finding of an inventive step. For example, the existence of **surprising** advantageous effect is an important factor when analyzing inventive step in combination and selection inventions.

#### **17. Must the [advantageous] effects be disclosed in the as-filed specification?**

No. It is sufficient that any effect used to support an inventive step is derivable from the application as filed. Accordingly, any effect which the applicant wishes to rely on must have been evident to the skilled person from a comparison of the claimed subject-matter with the CPA, and must be implied by or related to the technical problem initially suggested (cf. answer to question 15).

Furthermore, the patentee may present new and other effects in connection with invalidity proceedings.

#### **18. Is it possible to have later-submitted data considered by the Examiner?**

Yes, provided that such data supports an effect that is derivable from the application as filed. For example, test results comparing the claimed invention with the CPA are typically allowed, and may facilitate the determination that an inventive step is present.

#### **19. How "real" must the [advantageous] effects be? Are paper or hypothetical examples sufficient?**

The claimed effects must be plausible. The EPO and PRV will ask for evidence only if it doubts that the alleged effects are actually achieved.

#### **20. Do the answers to any of the questions above differ during examination versus during litigation?**

The lack of technical effect is a basis for invalidation of a patent before the general courts. If the plaintiff makes it probable that such effect is missing the patentee has to prove that it actually exists.

### **Teaching away**

**21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?**

Teaching away is recognized as a factor in favor of inventive step.

In its broadest form, teaching away can be asserted if the most obvious solution to the objective problem differs from that claimed. However, for an inventive step to be recognized, it still has to be shown that the claimed solution is not suggested by the prior art.

If a prior art reference includes information discouraging the skilled person to combine the teaching with that of another piece of prior art, this may be considered by the examiner. Implicit teachings away, such as implicitly inherent incompatibilities between prior art teachings, can also be considered.

That the prior art teaches away from the claimed subject-matter does not need to be explicitly mentioned in the application as filed. It is sufficient that the skilled person is able to deduce that the prior art leads the skilled person in a direction different to that of the claimed solution.

The strongest form of teaching away is the demonstration of a known technical prejudice. A prejudice in any particular field relates to an opinion or preconceived idea widely or universally held by experts in the field. The burden is on the applicant to demonstrate, for example by reference to suitable technical literature, that the alleged prejudice really existed at the effective filing date of the application.

**22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?**

Teaching away is one argument, among several others, of the presence of an inventive step, used when determining whether the skilled person would have been prompted by the prior art to modify the CPA in the claimed manner to solve the objective problem (cf. answer to question 1).

Teaching away is typically of secondary importance. However, in the form of a general prejudice, sufficiently supported by evidence, it is a very strong argument.

**23. Is there any difference in how teaching away is applied during examination versus in litigation?**

No.

**Secondary considerations**

**24. Are secondary considerations recognized in your jurisdiction?**

Yes, but normally only as supporting arguments. One example of this is that when the problem-solution analysis (cf. answer to question 1) has shown that there are prior art items that, in isolation or when combined, seem to render the invention obvious, secondary considerations might be used as arguments to the contrary.

**25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?**

Accepted secondary considerations include:



- overcoming a technical prejudice (see question 23 above)
- age of documents
- satisfaction of a long-felt need
- commercial success
- market competitors
- simple solution
- surprising effect – bonus effect
- comparative tests

Secondary considerations are only of importance in cases of doubt, i.e. when an objective evaluation of the prior art teachings has yet to provide a clear picture. Regarding how and to what degree they must be proven the following can be noted:

**Technical prejudice:** The standards for recognizing the existence of a prejudice are very strict. A solution put forward as overcoming a prejudice must clash with the prevailing teaching of experts in the field, i.e. their unanimous experience and notions, rather than merely citing its rejection by individual specialists or firms. The existence of a prejudice is normally demonstrated by reference to the literature or to encyclopedias published before the effective date of the claim under consideration.

**Age of documents:** The fact that invoked prior art documents date back from long before the filing date of the application in question can constitute an indication of inventive step but only if the claimed invention represents a solution to an unsolved problem that has existed during the entire period between the date of the documents and the priority date of the application considered. The required time span will depend on the level of activity in the particular technical field.

**Satisfaction of a long-felt need:** The fact that the state of the art has been inactive over a long period prior to the invention may be an indication of an inventive step if, during that time, an urgent need for improvement has demonstrably existed. This indication is closely linked to the positive indications of the time factor and age of the cited documents.

**Commercial success:** In principle, commercial success alone is not to be regarded as indicative of inventive step. The following requirements must first be met:

- A long-felt need must have been fulfilled by the invention; and
- the commercial success must derive from the technical features of the invention and not from other influences, such as marketing or advertising.

**Market competitors:** The efforts of market competitors to obtain rights of joint use constitute further secondary indicia, closely related to commercial success.

**Simple solution:** The difficulty of creating a simple solution without sacrificing quality or level of performance may indicate inventive step.

**Surprising effect – bonus effect:** A surprising effect may be indicative of inventive step. However, it must be borne in mind that an unexpected effect does not confer inventiveness on an obvious solution. If it is obvious for the skilled person to combine prior art teachings in order to solve a particular problem, the presence of an unexpected extra effect is irrelevant.

**Comparative tests:** An advantageous effect demonstrated in a comparative test can in certain situations be taken as an indication of inventive step. The nature of the comparison with the CPA must be such that the alleged advantage or effect is convincingly shown to have its origin in the distinguishing features of the invention compared with the CPA.

Regarding the final question, a very close connection between the claimed invention and the secondary considerations is required.

**26. Do the answers to any of the questions above differ during examination versus during litigation?**

No

**Other considerations**

**27. In addition to the subjects discussed in questions 4 – 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?**

Yes, a plurality of factors plays different roles in the determination of inventive step under the problem-solution approach (cf answer to question 1). Some of the most important ones are identified in the following.

Many decisions of the EPO boards of appeal warn against an **ex-post facto** approach when assessing inventive step. Correct application of the problem and solution approach is meant to avoid this inadmissible ex post facto analysis which draws on knowledge of the invention.

Furthermore, in the problem-solution approach, the “**could-would approach**” is key. In other words, the question is not whether the skilled person could have carried out the invention, but whether he would have done so in the hope of solving the objective problem or in the expectation of some improvement or advantage.

Regarding so-called **selection inventions**, a claimed sub-range selected from a broader range involves an inventive step if a special technical effect is obtained in the selected range and the prior art provides no indication that would lead the skilled person to the selected range in order to achieve advantageous properties.

When considering inventive step, only **technical features** of the claimed invention are taken into consideration. Features making no technical contribution cannot support the presence of an inventive step. Specifically, any features relating to a non-invention within the meaning of Article 52(2) EPC cannot support the presence of inventive step.

**Test**

**28. What is the specific statement of the test for inventive step / non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.**

As explained in the answer to question 1 above, PRV uses the following test:

*An invention must **differ significantly** from the prior art in order to involve an inventive step.*

However, the analysis is explicitly meant to be identical to the EPC test:

*An invention must not have been **obvious to the skilled person** in light of the prior art.*

As also described in the answer to question 1, the jurisprudence of the EPO has clearly laid out that the problem-solution approach is to be applied for the analysis of inventive step.

**29. Does such tests differ during examination versus during litigation?**

No.

### **Patent granting authorities versus courts**

**30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.**

No.

**31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?**

See answer to question 30 above.

### **Regional and national patent granting authorities**

**32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?**

Although the PRV follows the approach and practice of the EPO (cf. answer to question 1), they do diverge from time to time in specific matters. This is due to time lag in the application of new EPO jurisprudence. An example is the recent development regarding computer-implemented inventions, where the focus for patentability analyses has shifted from the “patentable subject matter” to the “inventive step” domain where it took some time before PRV had fully adapted itself to this development.

**33. If yes, is this problematic?**

Yes, as it decreases legal security and reduces predictability.

## **II. Proposals for harmonization**

**The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:**

**34. Is harmonization of inventive step / non-obviousness desirable?**

Yes. In the opinion of the Swedish Group this is desirable, indeed necessary, from several perspectives, such as:

- i. The globalisation of markets and economies, which leads to increased trade and hence global competition. Countries and companies increasingly look to the patent system for creating an edge in the market struggle. An international patent system which is unwieldy and difficult to grasp puts an unnecessary burden on the global economy;
- ii. Increased predictability in respect of which patent applications will be granted as valid patents which are upheld in courts would reduce the legal uncertainties for applicants as well as third parties;
- iii. The strong emphasis on the importance of intellectual property rights, especially patents, in national innovation strategies in industrialised countries as well as in emerging economies, with China as the lead example;

- iv. The increasing backlogs and consequent need for more effective work-sharing on patent office level between the major patent offices, notably USPTO, JPO, EPO, KIPO and SIPO;
- v. The discussion on patent quality which, with regard to inventive step / non-obviousness, translates into a harmonized approach of requirements, aiming to achieve the necessary balance between the interests of patent applicants, third parties and society.

**35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?**

As the Swedish Group understands it, a standard with universal applicability for inventive step / non-obviousness would mean a standard that is accepted across the different country groups in WIPO. However, against the background of the failed efforts to agree on international substantive patent law harmonisation in WIPO, initiated already in 1983 and with its most recent project, SPLT, initiated in 2000 but stalled since a number of years, to achieve agreement on such a standard must be considered a very distant goal. Indeed, political realities seem to make treaty-bound harmonisation, including provisions related to inventive step / non-obviousness, a rather unlikely event for the foreseeable future.

However, in the opinion of the Swedish Group the failure of the normative harmonisation process at the world level ought not to prevent pragmatic cooperation between interested parties. The increasing backlogs of pending applications in the major Patent Offices have, as noted above, led to need of and increased efforts for cooperation and work-sharing between these Offices. This is manifested both in the long-standing trilateral cooperation between USPTO, JPO and EPO, and in the IP5 cooperation involving also KIPO and SIPO. While substantial research and comparative work has been undertaken and reported on different aspects of the patent grant procedure, it seems that this work remains to result in a common approach for the evaluation of inventive step / non-obviousness.

A further factor to keep in mind in discussions on universal harmonisation of the patent system is the increasing number of PPH ("Patent Prosecution Highway") bilateral agreements which also aim at better work-sharing and reduced back-logs between the Patent Offices participating in such agreements. As the Swedish Group understands it, from the limited practical experience available from such agreements, it must be taken as inevitable that some form of agreed principles on inventive step / non-obviousness must result in practice, even if not in explicit terms, between the parties to such a PPH agreement.

In the opinion of the Swedish Group, considering these different developments, AIPPI must continue to work towards the long term goal of achieving an international patent infrastructure operating under a harmonised body of laws, regulations and practises, including a standard for inventive step / non-obviousness. AIPPI should continue to support WIPO, in spite of the current political difficulties, as the main forum for this work. Especially, AIPPI should continue to support the PCT – and ongoing work to improve the PCT – as the primary system for global patent work-sharing.

At the same time, in the shorter term, AIPPI should monitor developments regarding the harmonisation of practises and practical cooperation schemes, seeking to provide input in the said trilateral and IP5 work, as well as in PPH negotiations and agreements. It also seems as though some harmonisation can be achieved through developing case law (an example of this is the recent US Supreme Court judgment in *KSR Int'l Co. v. Teleflex, Inc.* which appears to have slightly closed the gap between the US and Europe on the issue of inventive step / non-obviousness).

**36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.**

A possible broadly acceptable definition for inventive step may be the following:

“An invention shall be considered as involving an inventive step unless the differences between the claimed subject-matter and the closest prior art would have been evident to a skilled person at the effective filing date of the claimed subject-matter on the basis of the common general knowledge and/or disclosures in prior art that are considered relevant because of the nature of the invention.”

This definition does not require a technical effect or a specific statement of a technical problem. Rather, the expression “nature of the invention” is intended to cover both technical and non-technical subject-matter and is also intended to allow the skilled person’s search for prior art to be limited to fields of relevance for the invention.

**37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.**

For harmonization to have effect it is important that not only general principles and definitions are harmonized, but that harmonization is brought all the way down to the practical approach to the daily work. A possible generally applicable approach to the application of the proposed definition in 36 may be the “ABC approach”, which could be based on using the following main steps:

- A. Determining the "closest prior art" bearing in mind the nature of the invention.
- B. Identifying the "difference/s", i.e. the feature or set of features that distinguish the claim from the “closest prior art”.
- C. Considering whether or not the skilled person would have added the claimed difference(s) due to common general knowledge and/or disclosures in prior art.

The suggested approach provides a good adaptability of the skilled person, i.e. to the “nature of the invention”. It would of course be preferable if the concept of the skilled person could be harmonized alongside the definition of inventive step. Reference is made to AIPPI Q213 regarding the skilled person, where the Swedish Group in its report discussed the need for harmonization of e.g. the material available to be used for establishing what is general knowledge in the relevant technical field, the principles for establishing the boundaries of the skilled person’s ability to know, find and combine information, the quality of documents that shall be deemed to represent the general knowledge of the skilled person (including the existence of prejudice), how many documents the skilled person can use and combine in order to arrive at the invention and circumstances that motivate the skilled person to look at documents outside the directly relevant technical field. All these factors are relevant for the practical use of the suggested “ABC approach”.

This approach also eliminates difficulties related to problems in establishing “technicality” in jurisdictions where this notion is essential.

## SUMMARY

Swedish patent law on inventive step / non-obviousness is harmonized on a European level through the European Patent Convention and its impact on national law.

The group has not identified any difference in principle in respect of how the concept of inventive step/non-obviousness is defined and applied by the relevant patent granting authorities (the European Patent Office and the Swedish Patent Office) and the Swedish administrative and general courts

Global harmonisation is definitively desirable but obviously more difficult to achieve. Nevertheless AIPPI could and should play a role in this respect. AIPPI's efforts should be focused on supporting WIPO's long term work, especially within the framework of the PCT, and on monitoring and providing input to the existing cooperation between major Patent Offices.

A conceptual definition of inventive step / non-obviousness and an approach for its application that could be used as a basis for global harmonization efforts have been suggested by the group.

## Résumé

Le droit des brevets suédois sur « l'activité inventive » est harmonisé sur un niveau européen par la Convention du brevet européen et son impact sur le droit national.

Le groupe n'a pas identifié de différence de principe concernant la façon dont la notion « d'activité inventive » est définie et appliquée par le brevet en question qui donne sa procuration aux autorités (l'Office européen des brevets et l'Office suédois des brevets) ainsi qu'aux tribunaux suédois administratifs et de grande instance.

Une harmonisation mondiale est certainement souhaitable, mais évidemment plus difficile à réaliser. Néanmoins l'AIPPI pourrait et devrait jouer un rôle à cet égard. Les efforts de l'AIPPI devraient être axés sur le soutien à long terme du travail de WIPO, en particulier dans le cadre du PCT, et sur le contrôle et la contribution à la coopération existante entre les offices de brevets majeurs.

Une définition conceptuelle de « l'activité inventive » et une approche sur son application qui pourraient être utilisées comme base pour les efforts d'harmonisation mondiale ont été suggérées par le groupe.

## ZUSAMMENFASSUNG

Das schwedische Patentrecht betreffend Erfindungshöhe wurde auf europäischer Ebene durch das Europäische Patentübereinkommen und dessen Einwirkung auf Nationales Recht harmonisiert.

Die Gruppe hat im Prinzip keine Unterschiede in Bezug darauf, wie der Begriff der Erfindungshöhe von den einschlägigen Patentämtern (dem Europäischen Patentamt und dem Schwedischen Patentamt) einerseits, und von den schwedischen Verwaltungsgerichten und den Gerichten der allgemeinen Zuständigkeit, andererseits, definiert und angewandt wird, gefunden.

Eine weltumfassende Harmonisierung ist definitiv begehrenswert, aber erscheint auch schwerer zu erreichen. Nichtsdestoweniger könnte und auch sollte AIPPI eine

wichtige Rolle in dieser Hinsicht spielen. Die Bemühungen von AIPPI sollte sich auf die Unterstützung der langfristigen Arbeit von WIPO, besonders im Rahmen des Patentszusammenarbeitsvertrages (PCT), als auch auf die Überwachung und das Anbieten von Beratung in Bezug auf die schon existierende Zusammenarbeit zwischen den führenden Patentämtern konzentrieren.

Eine Begriffsdefinition der Erfindungshöhe und eine Leitung zu deren Anwendung, die als Grundlage für die Bemühungen für eine weltumfassende Harmonisierung benutzen werden könnte, ist von der Gruppe vorgeschlagen worden.

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