



Question Q213

National Group: Sweden/Suède/Schweden

Title: The person skilled in the art in the context of the inventive step requirement in patent law

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Questions

The suggested questions will try to analyze and to understand the definition of the “person skilled in the art” in three steps:
the notion of the “person”;
the issue of the person’s personal “skills”; and, finally,
the “technical field” in which these skills are exercised.

- 1) The study proposed by AIPPI starts with the consideration of the person as one of the elements of the definition of the person skilled in the art.

As a general background to the answers set forth below the following can be said about the state of Swedish law on the concept of the skilled person.

The Swedish Patents Act (SFS 1967:837) does not contain any specific rules on this subject matter.

Sweden is a party to the European Patent Convention (“EPC”) and the Patents Act is generally harmonised with the EPC. Through case law from both the administrative (grant/opposition) and the general courts (infringement/validity) it has been established that the Swedish Patents Act shall, as far as possible, be interpreted and applied in conformity with the EPC as interpreted by the European Patent Office (“EPO”). The EPC and case law from the EPO are thus important sources of information for the understanding and application of the Patents Act.

The above means that EPO Guidelines and case law from the EPO are also highly relevant for defining the skilled person under Swedish law (cf. current EPO Guidelines

C-IV, 11(3) and publication of EPO case law, e.g. “Case Law of the Boards of Appeal of the EPO (5th ed, 2005) Chapter 7, Section 7.1.1 through 7.1.4).

The Swedish Patent Office (“PTO”) has also issued corresponding guidelines in respect of the characteristics of the skilled person (PTO Guidelines for Examination, Section B5:2.3).

Further comments on the skilled person can also be found in the legislative history of the Patents Act and its amendments (see e.g. Committee Reports NU 1963:6, p. 126 – 128 and SOU 2008:20, Section 5.2.2)

Case law from the general courts dealing with infringement and invalidation of patents, and from the administrative courts handling opposition and appeal of rejected applications, also provides a source of information in respect of the actual application of the principles expressed in the above-mentioned guidelines and legislative comments.

The Groups are therefore requested to indicate if the person skilled in the art is one, or more, person.

The starting point is that the skilled person is one individual. However, applicable guidelines from the EPO and the Swedish PTO, confirmed by case law from general and administrative courts, provide that there may be instances where it is more appropriate to think in terms of a group of skilled persons with expertise in different technical areas, e.g. a research or production team, rather than a single person. This may apply, for example, in certain advanced technologies such as pharmaceuticals, computers or telephone systems and in highly specialised processes such as the commercial production of integrated circuits or complex chemical substances.

If a skilled person is a team of people, then are the team members all the same or may they be different in their various attributes, specifically if such a team may comprise persons from various disciplines or having different levels of qualifications?

As noted above, the purpose of the concept of a team of skilled persons is to provide knowledge and experience in several technical areas which are relevant for the development of a product or process. An example of this is the team of skilled persons used for purposes of assessing inventions relating to pharmaceuticals, which can consist of e.g. an organic chemist, a pharmacologist, a formulation scientist and a physician with clinical experience.

2) Is the skilled person a real person (or team of persons) or a hypothetical person?

The skilled person is hypothetical in the sense that he is defined by certain principles aimed at capturing his general level of education and experience, his abilities to: be aware of information in the state of the art; combine information from different sources (documents) and technical areas; perform certain work in respect of e.g. experiments in order to verify or establish certain facts; and, make minor adjustments to existing solutions based on specific needs.

An important aspect of this hypothetical skilled person is that his/her knowledge of information in the state of the art exceeds that of the average real skilled person, while his/her ability to use such information is more limited than the corresponding real person. Most importantly the hypothetical skilled person does not possess the potential for creativeness/inventiveness that can be expected in the real skilled person.

However, when the concept of the skilled person is used in a specific situation the principles defining the hypothetical skilled person are complemented by the facts and circumstances pertaining to the actual skilled person in the technical field.

- 3) The person skilled in the art has to be analyzed in the frame of her/his personal capacities and attributes.

At first, it is necessary to know whether and if so to which extent this person has reasoning and/or creative capacities or if he/she has merely the capacity to perform or execute the orders or instructions from other people.

As noted above the skilled person typically does not possess creative capacities.

On the other hand, his/her ability is not limited to only performing or executing instructions from other people.

In legal commentaries this has been expressed as that the skilled person shall have a complete knowledge of the state of the art, the ability to use said information in a professional manner, the ability to make adjustments to the existing solutions that are near at hand (obvious) and a certain ability to combine different parts of the information, but the skilled person shall not be able to create inventions.

Another point that can be discussed is whether the personal attributes of the person skilled in the art are the same also for other circumstances in which the person skilled in the art may have a role, such as construction of the patent or for the consideration of the sufficiency of the disclosure in the specification, even if this last point goes beyond the scope of the present study.

A basic principle in the application of patent law is that a patent shall be construed in the same manner both when examining the issue of validity (inventive step) and the scope of protection afforded by the claims. This principle would imply that it is not possible to use different standards in respect of the qualities and capabilities of the skilled person in respect of e.g. what the skilled person would be able to derive from a study of prior art versus the content of the patent on the one hand, and in respect of how he understands the content of the patent in relation to the allegedly infringing product or process on the other hand.

An exception is of course where there are further limiting principles in respect of how clearly information shall be disclosed, e.g. in the context of novelty or priority where the relevant features shall be directly and unambiguously derivable from the relevant document (cf. Enlarged Board of Appeal G2/98).

Finally, the question that can be discussed is the issue of knowing if the personal attributes of the person skilled in the art are the same for different IP rights covering technical creations, like patents or utility models, species, etc., if they exist in the national law.

Sweden does not have legislation concerning utility models. The notion of the skilled person for plant variety rights is less developed in Swedish law and it is also based on different criteria for grant in relation to patents.

- 4) Another important aspect of the question is to know what are the personal skills of the "person skilled in the art"?

At least, two important issues deserve to be analyzed:

- What is the level of the qualification or skills of the person?

The starting point is that the general level of the skilled person is that of the real technician in the relevant field. In case law this has been stated to normally correspond to a university degree in the relevant technical area followed by a couple of years of work experience in the industry or academia.

- And what are the nature and the scope of his/her knowledge?

The second issue encompasses more precisely the question of the capacity to understand and to analyze the documents which are accessible to the person skilled in the art, this capacity being called "the general knowledge" and concerns the proof of the content of the "general knowledge":

- a) what is the scope of such knowledge in general terms?
- b) is such knowledge limited to the general technical training of such person?
- c) to what extent is information in documents – articles or prior patents - considered to be included as part of such working knowledge?
- d) can such knowledge include information which the person may not have memorized, but can readily look up?

The nature and scope of the skilled person's knowledge ("the general knowledge") mainly comprises the contents of handbooks, study books and reference books, but not necessarily the complete contents of any book. The skilled person may however look up required information in these publications. Individual patent documents, specialised articles and the like may be considered part of the general knowledge in newly developed technical areas. Otherwise, for an article to be part of said knowledge, it is required that it is widely known and recognised among the technicians in the relevant field.

- 5) The question of the person skilled in the art raises also the problem of the moment of the evaluation of those skills: should they be all evaluated at the moment of the appreciation of the validity of the patent, i.e. at the moment of the priority date, or could they be evaluated also at the date when the patent is assessed by the Judge, for example in the infringement proceedings, where the validity can be debated jointly with the infringement claim? This may conduct to the differences of appreciation in case the notion of the equivalence is used in relation to the prior art.

It is recognised in Swedish law that in a patentability or invalidity case, that when determining e.g. inventive step or sufficient disclosure, the skilled person's knowledge is to be assessed on the basis of the situation on the application date, or if a priority is claimed, the priority date. This follows from Section 2 and 6 of the Swedish Patents Act. It is debatable if the skilled persons capacity in an infringement case should be determined on the date of infringement (see below regarding future harmonization), but if that is the case, this should not affect the date of the skilled person's capacities in a simultaneous invalidity case.

- 6) The next issue related to the definition to the person skilled in the art is the technical domain or "the art" in which his or her skills are performed.

The first sub-question is to know if those skills are concentrated in one or several technical fields.

The skilled person is, with certain exceptions, presumed to be focused on one specific technical area with some knowledge of the technical fields bordering his own. One exception noted above is that the skilled person in some instances can be a team of skilled persons, each with special knowledge in different technical areas. If the problem could be expected to occur in bordering or similar technical fields, then the skilled person can be expected to look for the solution in those fields. However, if the solution is to be found in a completely different technical field, then the skilled person must be guided, by, for example, a reference, to find the solution there. Furthermore, if the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem.

Apart from the specialist skills in different technical fields described above, the skilled person is expected to have a certain amount of general, basic, technical knowledge.

And the second one is related to the way the frontiers between different technical fields can be established: how this determination is assessed by the Judges or Patent Offices?

There is very little explicit reasoning in case law regarding the determination of the relevant technical field, thus giving only limited guidance to the courts' assessment. The relevant technical field is generally identified based on the technical nature of the problem that the invention is considered to resolve. Hence, the frontiers between different technical fields have to be established on a case-by-case basis and there is no strictly objective way of determining the skilled person's area of expertise. In order to identify distinguishable technical fields, guidance is sought from how education, academia and industry are organised in respect of different lines of specialisation. The technical field of previously published patents and patent applications within the relevant patent classes may also be used as a means to define the skilled person's technical domain.

- 7) The question is also to know what is the nature of his/her competence in the technical field and particularly if this competence theoretical or practical?

It appears from the answers to previous questions that the skilled person's competence is both theoretical and practical. Hence, he/she can e.g. combine information from different sources (both different documents and different technical areas), make minor, near at hand adjustments to existing solutions, and perform certain practical work in respect of e.g. experiments in order to verify or establish certain facts.

- 8) The Groups are requested to indicate how in practice the assessment of the skills of the person skilled in the art is operated. What is the role of the opinion of the experts on this point?

The general character and level of skills of the skilled person are rather well-defined in applicable guidelines and case law (cf. above). The parties to the proceedings normally adduce evidence in respect of what would be the specific knowledge of the skilled person at the priority date in respect of textbooks and other scientific literature, patent documentation etc.

Experts are specifically relied on in order to comment on;

- i. **what would be part of the skilled persons general knowledge at the priority date;**

- ii. **how the skilled person would understand (or not understand) the technical teachings of the patent-in-dispute and prior art documents; and,**
 - iii. **what kind of practical measures, e.g. routine experiments, would be available to the skilled person in order to practice the invention of the patent-in-dispute or obtain more information from prior art.**
- 9) Finally, the Groups are also invited to present all other questions which may appear in the context of the question of the person skilled in the art.

The Swedish group has noted that there will always be room for subjective considerations in connection with the application of the principles of the skilled person in the individual case. It is then important that the persons responsible for this assessment have the right qualifications and experience. Hence, the Swedish group suggests that the structure of the system for legal and administrative review of patents and patent applications, the composition of panels/judiciary bodies and positions within said system and the qualifications of individuals serving on such panels/bodies/positions, should also be considered in connection with the AIPPI harmonization efforts.

5) Future harmonization:

After assessing the national solutions, the Groups are invited to present their proposals for the possible harmonization and specifically the harmonized definition of the person skilled in the art. The object of this section is not to repeat all the questions related to the current statute of the national law, but to find the most fundamental points on which the international harmonization could be sought.

- 1) Specifically, the Groups are invited to precise on which points they see the particular need of the international harmonization on the issue of the person skilled in the art.

The Swedish Group suggests that the work on further development and harmonization includes the following.

1. A prerequisite for harmonization is that the material available to be used for establishing what is general knowledge in the relevant technical field is the same across different jurisdictions, and thus is not dependent on possible special national/regional rules which set conditions for how such material is to be considered available.

2. The principles for the establishing the boundaries of the skilled person's ability to know, find and combine information and do certain work e.g. in respect of:

- a. **The quality of documents (from peer-reviewed scientific articles to manufacturer information material) that shall be deemed to represent the general knowledge of the skilled person, including the existence of prejudice. In respect of the latter, the conservative attitude of the EPO can be noted (cf. T 1212/01).**
- b. **How many documents the skilled person can use and combine in order to arrive at the invention.**
- c. **Circumstances that motivate the skilled person to look at documents outside the directly relevant technical field.**
- d. **When, and how far, the skilled person is expected to pursue experiments.**
- e. **Adapting a certain solution in prior art, in order to make it work in a specific situation/application.**

3. The use of secondary considerations in order to establish inventive step, such as the existence of a long-felt need for a solution to the problem solved by an alleged invention and the commercial success of products according to the patent-in-dispute. Since these considerations complete or substitute the direct application of the concept of the skilled person they should also be included in the harmonization efforts.

4. The point of time that is relevant for the determination of the skilled person's general knowledge when applying the doctrine of equivalence (priority date, application date, date of infringement, etc.).

The date on which the skilled person's general knowledge is to be assessed in an infringement situation has been debated in the Scandinavian IP literature, however, it has not been decided by courts. It has been argued that the point of time for the equivalence assessment is the priority date. The patent's scope of protection covers what could be held to have the same effect at said point in time. However, it has also been held that at the end a competitor could not be allowed to circumvent the patent's protection just because he has used a solution that was not known at the priority date. The advantage of the priority date is that it is judicially and technically a more simple solution. Then there would be no need to determine the point in time at which the infringement occurred. The priority date is easily verified from the documents. In addition, the patent protection remains – at least in principle – the same during the whole term of the patent. However, the patent holder's right to reasonable protection requires that technological development is taken into account. The value of patent protection would clearly be diminished if minor changes to the patented invention that only became available after the priority date could never infringe the patent. From the arguments it can be seen that there is a need for further harmonization, but it is not evident what the better rule is. The Swedish group suggests that AIPPI performs additional research into the question of the point of time that is relevant for the determination of the skilled person's general knowledge in claim interpretation and in the doctrine of equivalence.

5. The structure of the system in which the concept of the skilled person is used and then specifically the qualifications and experience of the persons who are responsible for the application of said concept.

- 2) The Groups may indicate if the “person skilled in the art” standard should be assessed as a hypothetical model or on the contrary appreciated *in concreto*?

The skilled person must be a hypothetical person in order to allow for general and foreseeable rules, which can be harmonized.

However, the precise content of the general knowledge and results of the skilled person's considerations and work must be assessed ad hoc where the specific facts of the matter are allowed to expand and complete the hypothetical concept of the skilled person.

- 3) Should the skills of the “person skilled in the art” be only to execute other person orders or should they be creative and both practical and theoretical?

The introduction of the word “creative” should be avoided since this is the typical trait of an inventor and it would therefore risk confusing the entire issue of inventive step.

However, the skilled person should be more than a person who just follows orders, as is the current situation in respect of Sweden. The rules for what the skilled person would and would not know and do in respect of e.g. finding and combining

information in different documents and pursuing experimental work, should instead be developed further and be subject to harmonization.

- 4) Should the art in which the skilled person intervene be of only one discipline, or should it cover several technical fields?

The rules for the skilled person should to a certain degree reflect the reality of research and development, and in areas where such work is normally or by necessity performed in groups then this should also be reflected in the concept of the skilled person.

- 5) The Groups are also invited to present all other suggestions which may appear in the context of the possible international harmonization of the definition of the person skilled in the art.

Considering the difficulties and time aspects involved in seeking harmonization on a higher legislative level (i.e. based on the adoption of new legislation containing specific rules on the skilled person) it should be considered to firstly focus on the possibility to seek harmonization in guidelines and other “soft law” regulations adopted by the administrative authorities for the purposes of assessing novelty and inventive step in connection with the prosecution and grant of patents. There are certain cooperative initiatives among the Patent Offices of the countries/regions having the largest number of applications, which could possibly serve as a platform for such harmonization work (see e.g. www.fiveipoffices.org).

It is finally noted that the concept of the skilled person can be considered as a tool for dealing with the underlying concepts of obviousness and inventive step and that it could be motivated to also deal directly with the latter in connection with harmonization.

Summary

The Swedish concept of the skilled person is linked to and generally harmonized with the European Patent Convention and guidelines and case law from the European Patent Office and the Swedish group considers this to be a good starting point for further development and harmonization efforts. The quality of the systems and the individuals that shall deal with i.a. the concept of the skilled person should also be considered in connection with such efforts.

Résumé

Le concept suédois de l'homme du métier est lié à, et de manière générale en concordance avec, la Convention sur le brevet européen et les directives et la jurisprudence de l'Office européen des brevets. Le groupe suédois considère ceci comme un bon point de départ en vue d'efforts additionnels de développement et d'harmonisation. La qualité des systèmes et des individus qui devront traiter, entre autres, du concept de l'homme du métier devra aussi être considérée lors de tels efforts.

Zusammenfassung

Der schwedische Fachmannsbegriff steht in Zusammenhang mit dem Europäischen Patentübereinkommen und ist hauptsächlich damit und mit den Richtlinien und den herrschenden Rechtsprechung des Europäischen Patentamts harmonisiert. Die Schwedische Gruppe betrachtet das als einen guten Ausgangspunkt für weitere Entwicklung und Harmonisierungsanstrengungen. Die Qualität von den Systemen och von den Personen, die unter anderem den Fachmannsbegriff weiterbehandeln werden, muss in Verbindung mit diesen Anstrengungen berücksichtigt werden