Inventive Step

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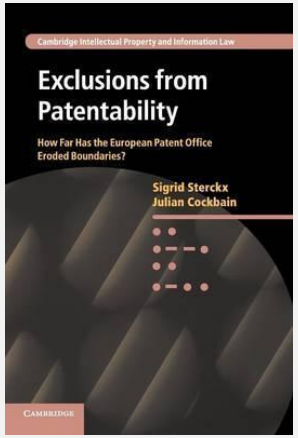
Inventive Step

- "An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art, such inventive step would not have been **obvious** to **a person having ordinary skill in the art**"

Source : Section 15 of Patent Act (P.A)

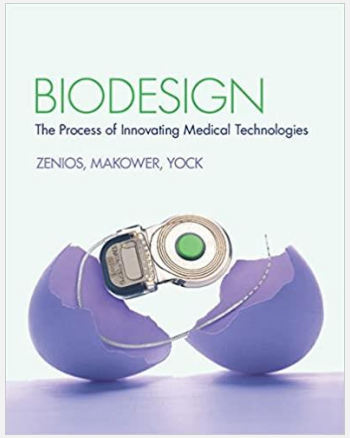
- "An invention shall be considered as based on inventive activity if, a skilled person cannot derive it in an obvious manner from the state of technology"

Source : Page 85 of Exclusions from Patentability



- **The invention must not be obvious to someone with knowledge and experience in the technological field** of the invention.

Source : Page 288 of Biodesign



Inventive Step

Prior art for inventive step

- A single source of information, or a prior art disclosure in combination with common general knowledge or with another prior art disclosure.

Source : Citius Minds

Inventive Step

The person having ordinary skilled in the art (PHOSITA) …

- A hypothetical non-inventive
- But skilled person in the field of the invention
- Who is aware of all that is commonly known in the art (common general knowledge - CGK)

Source : Patent Law by Naira Matevosyan

Inventive Step

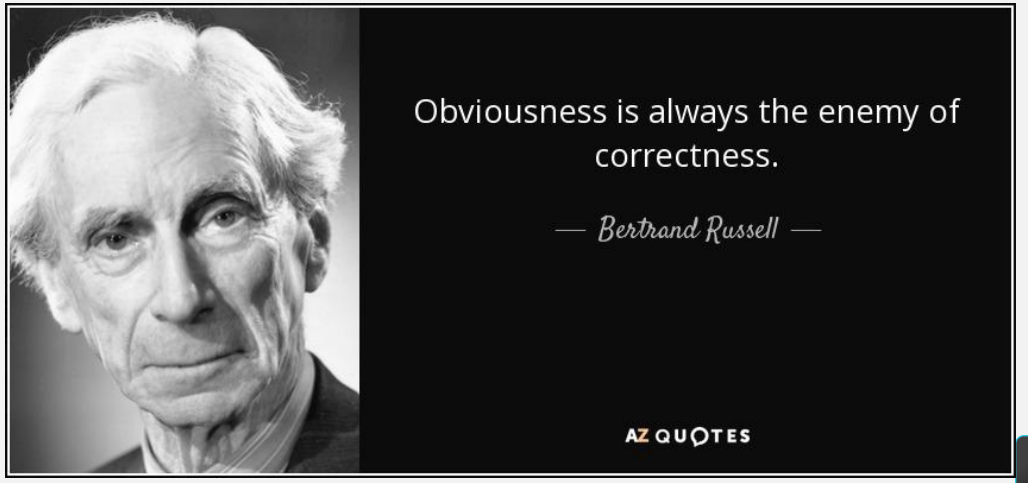
How do we decide on obviousness?

- Does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art.

  - Obvious or lack of inventive steps

- Does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.

  - Obvious or lack of inventive steps



Inventive Step

Step 1 – What is the closest prior art?

- This is the item of prior art belonging to the **same or closely related technical field** as the invention,
- Disclosing the **greatest number of technical features** in common with the invention as claimed,
- Directed to the **same or similar technical problem** as the invention
- The CPA is normally a **written disclosure**

Inventive Step

Step 2 – What are the difference with respect to the CPA?

- The features which make the subject-matter of the claim new with respect to the CPA only
- They are identified by comparing the combination of technical features defined in the claim with the content of the CPA
- The features of the claimed **which are not disclosed** in the CPA are the distinguishing features in question

Invention	CPA
A device for … comprising	X
Feature A	X
Feature B	X
Feature C	-

Inventive Step

Step 3 – What is the technical effect achieved?

- It is the **technical effect** achieved by the distinguishing features with respect to the CPA
- There may be **no technical effect** over the prior art i.e. the distinguishing feature of the invention provides a similar technical effect in CPA that is being provided by a different feature/element.

Inventive Step

Step 4 – What is the objective technical problem to be solved?

- If the CPA **does not provide all the effects** of the invention that relate to the distinguishing technical features, then the problem to be solved is :

  "How to **modify or adapt** the closest prior art **to achieve the technical effects** which the invention provides over the closest prior art"

- If there **is no technical effect** achieved with respect to the CPA, then the objective technical problem to be solved is:

  "How to **modify or adapt** the closest prior art to provide **an alternative way** of obtaining the technical effects that the closest prior art achieves"

Inventive Step

Step 5 – Is the solution as claimed obvious (not inventive)?

- IF the whole prior art (including the CPA) **does not provide an indication** that would prompt the skilled person to solve the problem in the way that the inventor solves it
  - THEN the solution is **not obvious (inventive)**
- IF the prior art (other than the closest prior art) **discloses the same way of solving the objective technical problem** as the invention, and indications in this item of prior art prompt the skilled person to combine the solution found with the CPA to achieve what the invention achieves
  - THEN the solution claimed is **obvious (not inventive)**
- IF the problem is to **"provide an alternative",** and indications in the prior art **prompt the skilled person** to adapt or modify the CPA to arrive at the subject matter of the claim
  - THEN the Invention is **obvious (not inventive)**
- IF the prior art discloses **several different ways** of solving the objective technical problem but **does not prompt the skilled person** to solve the technical problem in way claimed by the invention
  - THEN the Invention is **not obvious**

Inventive Step

Examples and Special Cases

- Example 1 : combination of prior art document

  Claim : Dining table having a wooden top and a number of legs, characterized in that the **number of legs is equal to three**

  Prior art:

  D1: Table with **four legs**

  D2: Milk stool with **three legs** for use on grazing land

D1

D2

Inventive Step

Feature Table Analysis

	Invention	D1	D2
	Dining Table having:	X	
1	A wooden top	X	X
2	A number of legs	X	X
3	**Characterized in that the number of legs is equal to three**		X

Inventive Step

Solution Example 1

1. **Closest prior art:** D1
2. **Distinguishing feature: three** instead of four legs
3. **Technical effect:** no wobbling on **uneven surfaces**
4. **Problem:** how to improve the table known from D1 such that it **does not wobble on an uneven surface?**
5. **Reasoning:** milk stool disclosed in D2 has three legs only. The grazing land is an indication for its suitability on **uneven surfaces.** The skilled person would therefore apply teaching of D2 to D1 in order to solve the problem of wobbling thereby **reducing** the number of legs to three
6. **Conclusion:** The claim is **not inventive**

Source : Patent Drafting Series, MyIPO

Inventive Step

Examples and Special Cases

- Example 2 : combination of prior art documents

  Claim : A process for producting a metal sheet in press comprising the steps of heating the sheet, coating the sheet with a coating material (A) and carrying out the pressing operation

  Prior art:

  D1: A process of forming a metal sheet in a press comprising the step of **heating** the sheet before forming

  D2: Formed metal sheet **coated** with material (A) whereby the coating provides good anti-corrosive properties, according to the problem to be solved by D2

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Solution Example 2

1. **Closest prior art:** D1
2. **Distinguishing feature:** The **sheet is coated** with (A) **before forming**
3. **Technical effect**: Formability grade is improved thereby reducing the risk of localized wrinkling and breaking of the metal
4. **Problem:** How to **improve the formability** of the metal sheet
5. **Reasoning:** D2 discloses a formed metal sheet which is coated with (A) and it mentions that the technical effect thereby achieved is better **anti-corrosive properties**. However D2 is silent about the fact that the coat (A) may further improve formability in a high temperature forming process, in particular if applied after heating the sheet. The person skilled in the art would therefore find no hint in D2 which would lead him/her in a obvious way to apply the coat (A) on the sheet after heating and before forming in the method of D1
6. **Conclusion:** The claim is **inventive**

Source : Patent Drafting Series, MyIPO

Thank You

No matter how different your invention is, you're not entitle to a patent on it unless it's difference(s) over the prior art is considered "unobvious"