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Patentability – what will a Patent Office allow?

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Requirements for patentability

- Novelty
- Inventive step
- Industrially applicable
- Not excluded from patentability

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US Health Warning

The requirements for patentability in the USA have some similarities to other jurisdictions, but the way they work in practice is very different from virtually every other country

Most of what follows is based on European practice, but applies more-or-less to most other countries **except the USA**

Excluded from patentability

- Not inventions:
- Methods for performing mental acts, doing business, and programs for computers

- Patents shall not be granted for:
- Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body

Industrially applicable

- Methods of contraception are not industrially applicable

Novelty

An invention shall be considered new if it does not form part of the state of the art

State of the art

Everything made available to the public by means of a written or oral description, by use, or in any other way, before the [filing date]

Also, earlier filed but later published patent applications in the same jurisdiction

Includes:

Any publication, however obscure

Public (but not private) use, and everything that can be discerned from that use

Disclosures by anyone, including the inventor(s), including lectures at conferences!

State of the art in practice

Examiners usually search patent publications and journals

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Novelty in practice

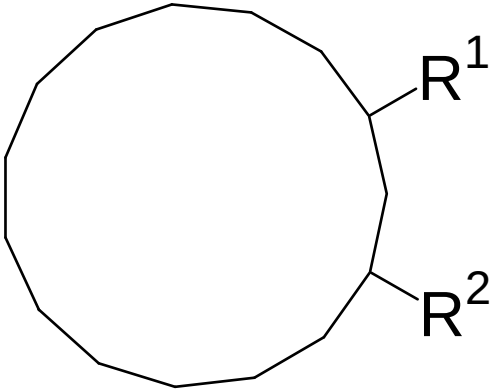
A disclosure is typically novelty-destroying only if it discloses all the features of a claim, in combination, in a single document, or another document that it explicitly refers to

Novelty in practice

A generic disclosure does not destroy the novelty of any of the specific possibilities falling within the disclosure

A specific disclosure destroys the novelty of any generic feature that encompasses the specific, but not of another specific alternative (but another specific alternative may lack inventive step)

Example



A compound of the above formula, wherein R^1 is…..

Example

Claim	Prior Art Document	Novel?
Ethyl group	Alkyl group	Yes
Ethyl group	C_1 to C_6 Alkyl group	Yes
Ethyl group	Methyl group	Yes
Alkyl group	Ethyl group	No
C_1 to C_6 Alkyl group	Ethyl group	No

Conclusion

Repeat the analysis for every claimed feature, and only if there is a novelty-destroying disclosure of all features does the claim lack novelty

AND SOMETIMES:

Even if there is a disclosure that is in principle novelty-destroying for each claimed feature individually, there can still be novelty for a *combination* of features that is not disclosed: this is the basis of the “selection invention”

Inventive step

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.

The state of the art for inventive step does not include prior-filed, later published, patent applications.

Person skilled in the art

Has all the necessary technical knowledge and skill in the technical field of the invention, but is unimaginative and cannot invent

There is scope for argument about what such an imaginary person should be considered to know

What is obvious?

- Different jurisdictions have different tests
- All in the end involve:
    A. Identify difference(s) between prior art disclosure and invention
    B. Decide whether it would have been obvious to modify the prior art in order to arrive at the invention
- Determined at the filing date of the application/patent being considered
- Hindsight must be avoided, which is difficult since step A. is based on retrospective analysis

Could/Would

The test is not “could the skilled person have arrived at the invention” but **would** the skilled person have arrived at the invention”

A similar consideration is “would the skilled person have had an expectation of success”

Unexpected advantage

Often, an unexpected advantage, that could not have been predicted from the prior art, is taken as evidence of an inventive step

Particularly relevant to “selection inventions”

However, if the invention is already sufficiently obvious, then an unexpected advantage can sometimes be considered a “bonus effect”, which does not confer inventive step

Conclusion

Inventive step is somewhat subjective, and there is a lot of scope for argument and different conclusions from the same facts

During the application process, the fact that it is a two-way dialogue between the applicant and the examiner means that the applicant does get the benefit of the doubt, to some extent

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