



Claim Drafting Seminar

Patentability Requirements

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Patentability Requirements

- **Novelty**
 - Definition
 - Novelty : an example
 - Specific cases

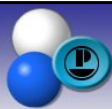
- **Inventive Step**
 - Problem Solution Approach
 - Examples



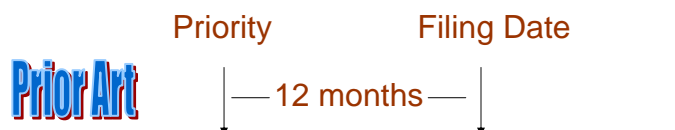
Novelty - Definition

- Art. 54(2) EPC
 - “An invention shall be considered new if it does not form part of the state of the art.”
- What is “state of the art” or “prior art”?

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Priority



- Art. 87 - 89 EPC
- Art 89 EPC: Priority has the effect that the date of priority counts as the date of filing of the EP application for the purpose of novelty

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Novelty - Interpretation of the prior art

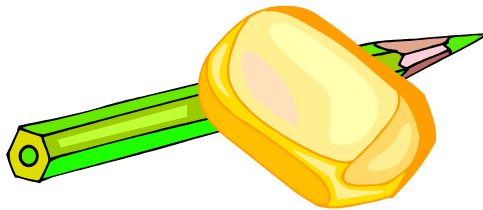
- An invention is novel if it is not directly and unambiguously derivable from the prior art (an equivalent is not novelty destroying! An implicit disclosure can be)
- relevant date: publication date of prior art (priority date of Art. 54(3) document)
- Do not combine separate items of prior art together!

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Novelty - an example

The Prior Art – what was known




The Invention

Novelty - Yes

Inventive Step –
????




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Specific Cases

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Generic - Specific

- invention: copper - prior art : metal
- invention : metal - prior art : copper

specific is novelty destroying for generic
but not vice versa

- Guidelines C-IV, 7.4.
- Decision : T508/91

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selection invention - subrange

Claim A : "...at a T between 40 and 45°C..."

Claim B : "...at a T between 20 and 90°C..."

Prior Art : "...at a T between 10 and 100°C..."

Novelty is accepted if the sub-range is

1. narrow,
2. sufficiently far from values known in prior art,
3. and not an arbitrary selection

- Decision: T198/84, also: T12/81

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new parameter or different name

1. New parameter:

claim: "substance X with specific T_m"

prior art : "substance X"

2. different name for the same object

claim: "car"

prior art: "automobile"

**A new parameter (different characterisation)
or a different name of a known object does
not confer novelty**

- Guidelines : C-III; 4.7a
- Decision : T114/86

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Product - by - Process Claim

claim : "substance X producible by process Y"

- the product as such must be new
- the product is not rendered new by an alternative process
- Only if the process leads to a new product is such a claim novel

- Guidelines : C-III, 4.7b
- Decision : T815/93, T 141/93

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Disclaimer = negative feature G 1/03, G 2/03

Example : Lamp, with the exception of a street lamp, characterized in that.....

Disclaimer can be introduced after the filing date if:

1. restore novelty against 54(3) prior art
2. restore novelty against 54(2) prior art if anticipation is accidental
3. disclaim subject matter which is excluded from patentability

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Disclaimer II, G 1/03, G 2/03

- The disclaimer should not remove more than necessary
- If the disclaimer is or becomes relevant for the assessment of inventive step or sufficiency of disclosure, it adds subject matter contrary to Art. 123(2)
- A claim containing the disclaimer must meet the requirements of clarity and conciseness of Art. 84 EPC.
 - Guidelines: C-III, 4.12
 - Decisions: T 4/80, T 1050/93

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Inventive Step

- Art 56 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.

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is this inventive ?



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or this?



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Inventive Step

Problem Solution Approach

1. Determine the "closest prior art"
2. Establish the "objective technical problem" to be solved, and
3. consider whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person

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1st step : closest prior art

1. one single reference (document)
2. the same or closely related technical field
3. directed to a similar purpose or effect
4. most promising starting point for arguing obviousness

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2nd step : objective technical problem

1. differences between prior art and invention
2. technical effect associated with the difference
3. objective technical problem
4. is the objective technical problem solved by the invention?

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3rd step : obvious?

1. Combine closest prior art with 2nd prior art which discloses the solution to the objective technical problem
2. Would the combination be obvious to person skilled in the art?
3. Person Skilled in the Art
4. Could-Would-Approach

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Summary

- **Novelty :**
 - absolute!
 - Only 1 document

- **Inventive Step:**
 - combine 2 or more documents
 - problem solution approach!