TMPDF

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TMPDF response to UKPO consultation on inventive step

General

We recognise that the UP Patent Office is bound by precedents set by the English courts. Within that constraint we believe they should attempt to follow the same standards, though not necessarily the same methodology, as the EPO.

When considering patent quality, we believe that current standards of inventive step are broadly acceptable, but availability of all relevant prior art to the UK examiner is at least as important. In this respect the breadth of search, especially in non-patent art, is vital.

It is important to focus on the test in Section 3 of the Patents Act 1977, namely "an invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art…". Any other test must be secondary and runs the risk of producing unexpected results in certain circumstances. We would not, therefore, wish to see any secondary test enshrined in the rules.

Question 1

Do you believe that the inventive step requirement can best serve innovation by steering a middle way between the hard/easy extremes with their attendant risks for innovation? Is it preferable for patent offices to tend (if at all) one way rather than the other?

Undoubtedly a "middle way" is correct, but is not easy to define. In *ex parte* proceedings, Patent Offices will seldom be in possession of all relevant facts. Although it could be argued that they will have heard only the applicant's position and so should be sceptical, we believe they should give the benefit of the doubt to the applicant. In *inter partes* proceedings (including Patent Office opinions) they should follow the precedent of the courts.

Question 2

To date have those extremes generally been avoided in the United Kingdom such that innovation has not been impeded? Or has an easy implementation of inventive step impaired patent quality and/or allowed trivial patents to issue, to an extent that innovation may be held back?

We believe the standard applied in the Patent Office has generally been about right. Whilst it is easy to see the risk of too low a standard, too high a standard can also be damaging, both investment and to patenting and hence publication. Every patent provides a spur to others to "invent around" the claims and/or develop the technology further. Without the prospect of patent protection filing and hence publication of developments will be discouraged.

Question 3

What change if any does the inventive step requirement in the United Kingdom need in order to help innovation across the board – in SMEs and academia as well as big industry?

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Innovation is best helped by a reasonable standard of inventive step, but above all by certainty. We are concerned that the standard of inventive step as applied by the UK courts may be substantially higher than that applied by the EPO resulting in grant of patents which may not in fact be valid in UK (but may be valid in other EU countries). SMEs in particular, but also big industry, may therefore be encouraged to invest in the unjustified reliance on patent cover.

Question 4

Do you think any change to the regulatory framework for inventive step (eg an addition to the Patents Rules) is necessary or advisable? If so, what change would you recommend and why? Could you accept the "European proposal" (para 2.5)?

We are have a major concern over the "European proposal" because we fell it lacks clarity. What is the meaning of "would have arrived at the claimed invention"? We are not sure this adds much to the base test of "not obvious". We are concerned that any secondary test may have problems when applied to different technology fields. For example in chemistry the "motivated to try with a reasonable prospect of success" test seems to us generally useful, but it is harder to apply in mechanical arts. For this reason we believe any secondary tests are a matter for practice guidance and should not be frozen in the Patents Rules. We believe that in all three tests the reference should be to any items of prior art and common general knowledge (rather than or)

Question 5

From your understanding of the way in which the UKPO assesses inventive step, and bearing in mind the methodologies set out in the legal precedents (Windsurfing, Haberman v Jackal), is there anything you feel that examiners should be doing differently in assessing the presence of inventive step?

We do not detect any systematic problems with assessment of inventive step in the UKPO.

Question 6

In your experience of examination reports from the UKPO and/or telephone conversations or interviews with examiners, do they explain and justify inventive step objections adequately?

Many of our members feel that examiners initially provide little more than a search report without clearly articulating an obviousness objection. Rather they seem to look to the applicant to both identify and refute the objection and sometimes seem to be merely seeking to get the applicant's argument on the file record to assist any third party challenge. However when approached by telephone or interview examiners are generally more helpful.

Question 7

Do we give fair consideration to observations from the applicant in response to an inventive step objection?

We believe the UK Patent Office should give the benefit of any genuine doubt to the applicant and within this constraint we believe fair consideration is given. We also believe the deadline for allowance of cases provides a useful spur to resolving differences.

Question 8

Do you have any comments on our approach to the other factors (combining documents, avoiding use of hindsight but adopting the view of the skilled man, onus, balance of evidence, benefit of doubt) we weigh as the application progresses?

We are generally happy with these areas.

Question 9

In your experience, have UKPO examiners been fair and consistent in the way that applications have been assessed for inventive step, across the Office, across different areas of technology and over time?

We have insufficient data to comment on this point.

Question 10

In your opinion is the level of inventive step appropriate in patents granted by the UKPO, in the sense that the interests of patentees and of third parties are fairly balanced?

We see the major problem as inadequate searches and lack of availability of other evidence to the examiner which may result in some patents being granted which do not pass the non-obviousness test. On the other hand the standard applied by the UK courts seems to us to be higher than that applied by the EPO in granting UK patents through the European route. This give the UK Patent Office the dilemma of which standard to apply. We believe the standard for securing a UK patent should be the same by either route.

Question 11

In your experience, how does the approach of the UKPO with regard to inventive step compare to other patent offices?

We have significant concerns with the often rigid application of problem/solution approach by the EPO and generally find the UK approach more flexible. There are undoubtedly differences of approach from the USPTO and JPO, but to a large degree these are due to differences in substantive law.

Question 12

Do you have any further comments regarding the inventive step requirement in the UKPO or in the UK generally?

As noted above we have concerns with the approach applied by the UK courts in terms of obvious to try without consideration of likely success. However as noted above, the application of this rule varies between arts and must ultimately be left to the courts in the light of the facts of each case.