

## PATENTABILITY?

Theis P. Hansen

### WHAT IS PATENTABLE:

#### US

- Anything under the sun made by man



#### Europe

- concepts which involve a technical aspect, with exceptions (theoretically)



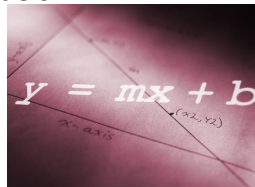
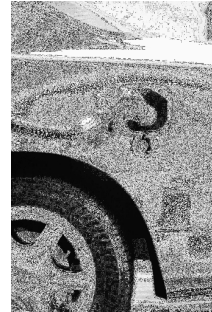
WHAT IS **NOT** PATENTABLE:

New and better understanding

New effects

Physical/mathematical models

EP: Software (as such...)



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17. Januar 2011

A PATENTABLE IDEA/INVENTION MUST PASS THREE TESTS:

New (novel)

- Novelty is "exact" and "anything" is valid....-almost

Involve an inventive step

- The invention must be "substantial" and "non obvious"

Enablement

- You must be able to make it.



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## NOVELTY IS DESTROYED BY

- prior publication in a single document/event **anywhere**
  - Lectures
  - Comic books
  - TV/movies
  - Papers/patents
  - products
  - All languages



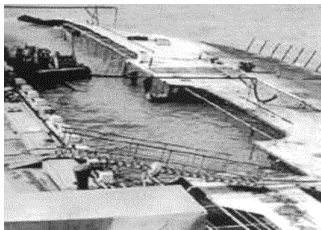
- Unpublished patent applications in the same country

- US has 1 year grace period!

## NOVELTY



**Anders And 11/1957**



**Kuwait City, 1964**

Ing. Karl Krøyer raised Al-Kuwait  
(2000 tons incl. Load of dead  
animals)

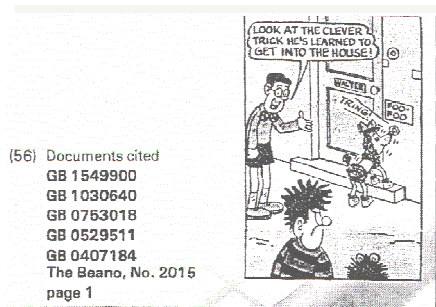
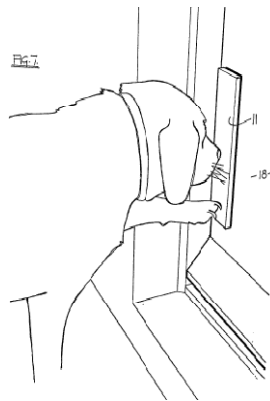
Rejected: Novelty ☹

NOVELTY

**AA19/1956 Originalt:** Harmless Vanilla-Icecream-gun.  
**Today:** Splattergun.



NOVELTY

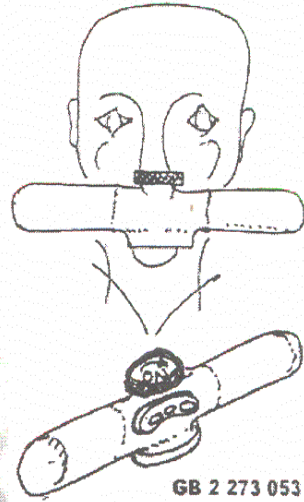


## NOVELTY

## (56) Documents Cited

GB 1438757 A    GB 0783565 A    GB 0615415 A  
 EP 0158498 A2    US 4996982 A    US 4573463 A  
 US 2610624 A    US 2428425 A

Film or video titled "THUNDERBALL", United Artist,  
 and featuring the fictitious character James Bond  
 particularly the scenes depicted in the video at  
 approx. 65, 90 and 125 minutes after the start



GB 2 273 053

## INVENTIVE STEP

From a commercial point of view

## INVENTIVE STEP/NON-OBVIOUSNESS

Whether an invention is inventive or not is assessed differently in EPO and US

EP : inventive step

problem solution approach

- i. Identify closest prior art
- ii. Define problem to be solved
- iii. Does another prior art document disclosed a solution to the problem ?

US: obviousness

Graham factors:

- i. the scope and content of the prior art;
- ii. the level of ordinary skill in the art;
- iii. the differences between the claimed invention and the prior art; and
- iv. objective evidence of non-obviousness.

KSR vs. teleflex decision by the Supreme court: "person skilled in the art" no longer need to be motivated by one prior reference to combine it with another prior art reference

## ARGUING FOR INVENTIVE STEP/NON-OBVIOUSNESS

A rejection based on inventive step may very often be questioned

Even when the Examiner has identified prior art documents that together disclose all features of the invention, the invention may still be inventive/non-obvious.

Evaluate the cost vs. benefit

Is the scope of the patent application sufficiently important to justify the cost relating to arguing against the Examiner.

## ARGUING FOR INVENTIVE STEP/NON-OBVIOUSNESS

US and EP:

Impermissible hindsight: Examiner not allowed to use hindsight. The knowledge of the skilled person must be evaluated at the date of filing.

Teaching away: One prior art document may teach away from combining it with another prior art document

Incompatible documents: The prior art documents may present technologies that cannot be combined (see example next page)

US:

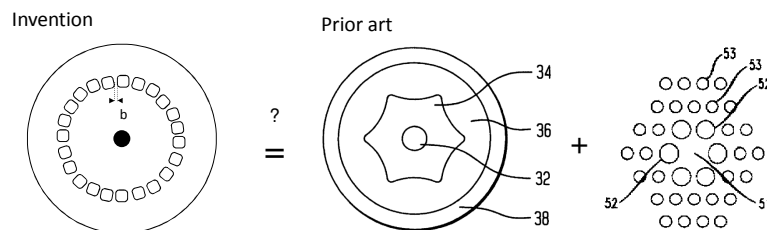
objective evidence of non-obviousness:

- i. commercial success;
- ii. long-felt but unsolved needs;
- iii. and failure of others

## ARGUING FOR INVENTIVE STEP/NON-OBVIOUSNESS

Example:

US, optical fiber with air holes separated by silica regions of width  $b < 600\text{nm}$



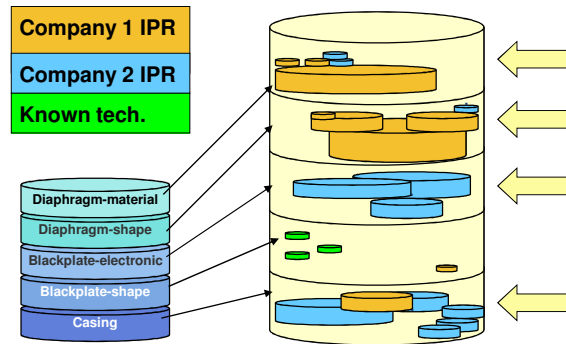
Together, the prior art documents disclose all features of the optical fiber according to the invention. However:

Paragraph VI of § 2143.01 of the Manual of Patent Examining Procedure prohibits an obviousness rejection if the proposed modification changes the principle of operation of a reference.

## INVENTIVE STEP VS. COMMERCIAL VALUE

Commercial value not proportional to height of inventive step

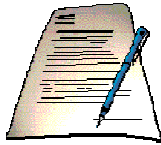
Inventions with small inventive step often have a large commercial value



## INTERNATIONAL TREATIES

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## Paris Convention



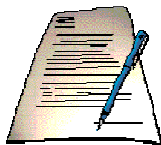
1883  
173 countries

Priority rights  
Equal rights for all  
Scope of protection for process patents  
Unfair competition

## INTERNATIONAL TREATIES

## PCT

Patent Cooperation Treaty



1970  
Ratified by 142 countries

Basis for whole PCT system.

A PCT application can cover all PCT countries for a limited period.

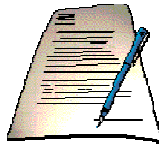
Only open for members of the Paris Convention.

Applicant must be in a PCT contracting state

## INTERNATIONAL TREATIES

## EPC

European Patent Convention



1973

36 member states + 3 Extension states

Basis for whole EP system

An EP application can cover all member states for the period up to grant and including opposition period.

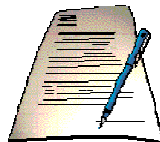
Only open for members of the Paris convention

Anyone may file

## INTERNATIONAL TREATIES

## WIPO Convention

World Intellectual Property Organization



1967

Ratified by 184 countries

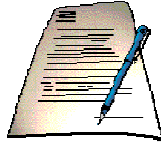
To promote protection of IP in the whole world through cooperation.

To secure administrative cooperation between member states

Administrate the PCT system, the Paris Convention, the Patent law treaty.

## INTERNATIONAL TREATIES

## London Agreement



2008  
 Ratified by 10 EPC member states  
 DK,FR,DE,LI, LU, MO, NL,SE, CH, UK

Reducing translation cost for applicants of EP patents

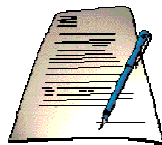
Members can only require translation of claims if the patent text is in a selected language of DE, FR or GB

In case of enforcement – whole patent should be translated

## INTERNATIONAL TREATIES

## TRIPS (WTO)

Trade-Related Aspects of IPR



1994  
 All WTO countries: 153 and 29  
 on observation list

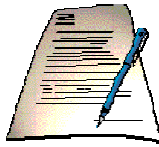
Superior rules such as.

- Length of patent(20 Years)
- Rules for what minimum should be patentable.
- Minimum rules for scope.
- Compulsory license
- Enforcement
- Misuse of patents

## INTERNATIONAL TREATIES

## PLT

Patent Law Treaty



2005

Signed by 61 Countries Ratified by 22 Countries

To harmonizes administrative rules

- formal rules
- basis for 'filing date'
- invalidating of rights
- reestablishment
- form and content of a patent application
- representation

## CURRENT WORK ON THE TREATIES AND IMPLEMENTATION

EPC: Divisional applications

Time limit for filing divisional applications (2 years)

April 2010

Europe: EU patent

EU patents will be European patents having unitary effect in the territory of the European Union

US, EPO, JP, UK, DK, DE, KR, CA: Prosecution highway

Accelerated patent prosecution procedures by sharing information between

Initiatives to limit the number of Claims/inventions

EPC: 15 claims included in basic filing fee. Further claims 200Euro each

US: 5/25 limit