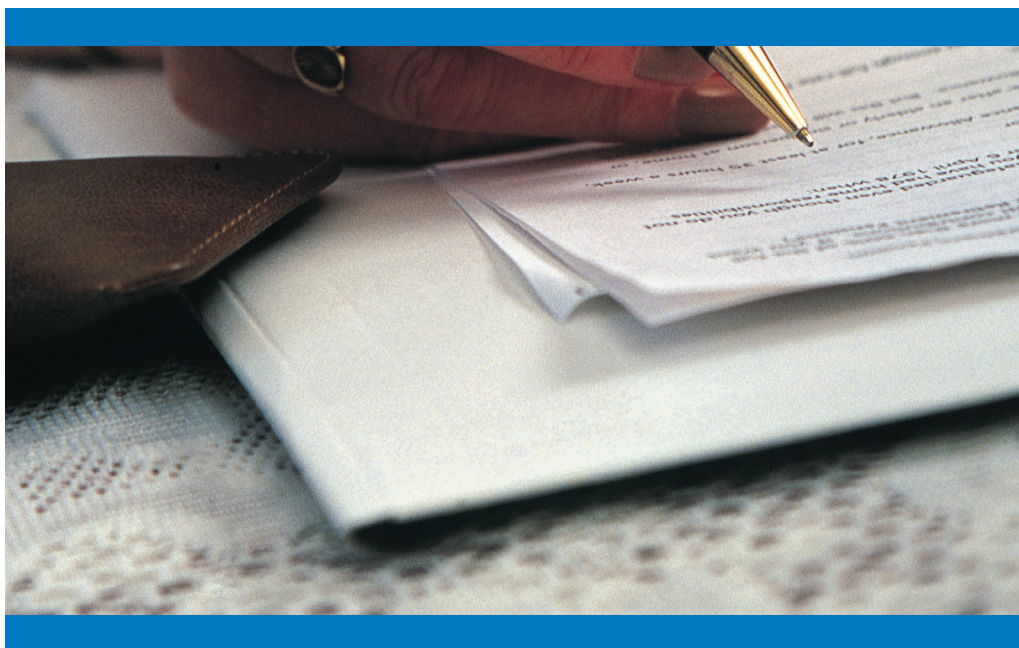




For Innovation

# The Inventive Step Requirement in United Kingdom Patent Law and Practice

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# The inventive step requirement in United Kingdom patent law and practice

## A review by the UK Patent Office

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### 1 Introduction

- Is the inventive step requirement for patentable inventions in the United Kingdom right for inventors, the public at large, and the UK economy?
- Are too many "trivial patents" being granted?
- Or are innovation and competitiveness best served by easy patenting with low hurdles?

1.1 Any questions which probe how well a patent system is operating inevitably raise the larger question "What is the patent system for?". This can be considered at different levels: the patent system influences not only individual inventions and inventors, but also – because of the cumulative effect on users and society across the country – the general propensity of inventors to patent, and the ability of others to live with those patents. Hence **at one level** the patent system sets the criteria which determine whether an invention meets the requirements for a patent. But at **the macro level** the effect of multiplying those individual experiences is to create a climate within which inventors and innovators operate, and which will inevitably influence them at all stages of their work. It is clear that a patent system can be an economic force that influences competition, innovation and competitiveness at large: it is thus the job of those responsible for patent policy to ensure that the system is designed and operated to deliver at both these levels.

1.2 The criteria that determine whether an invention is worthy of patent protection will have a critical influence at both these levels and thus should be kept under review if we are to be certain that the patent system brings maximum gain for our country. This review focuses on one such criterion: the requirement that an invention is only patentable if it involves *an inventive step* over what was known. This is of particular interest for review because it is perhaps the most challenging to define appropriately and to apply uniformly and objectively. Also, at the macro level the general level of inventive step may link to patenting activity and to innovation more generally.

1.3 The United Kingdom Patent Office (UKPO), **having policy responsibility for the patent system in the United Kingdom**, wishes by this review to re-evaluate the inventive step requirement and its **influence** at all levels. The requirement has been a central feature of UK patent law since the introduction of the Patents Act 1977, but it is timely to review it now not only because considerable time has elapsed, but also because more recently it has been the subject of some debate and investigation **abroad**: these have raised serious issues of patent quality, and concerns over the issue of so-called "trivial" patents. The UKPO therefore wishes to gather evidence as to the situation in the United Kingdom so that it can consider the need for change.

1.4 The objectives of this review are:

- to gather information as to the inventive step requirement in the UK, and how it compares with other countries
- to assess whether the level for inventive step in the UK is set at an appropriate point having regard to the underlying objectives of the legislation, to the role of the patents system in the economy of the country, to the knock-on effects on third-parties, to consistency and harmonisation with other countries, and to quality generally
- if any aspect should be modified, to set out proposals

1.5 In the initial information-gathering phase evidence will be sought:

- from users of the patent system and other interested stakeholders, in reply to the public enquiry introduced below
- from examiners in the UKPO, who will be invited to answer a separate questionnaire on their experience of the inventive step requirement
- from a survey of patents granted by the UKPO.

1.6 The results of the enquiry will be published in a further document. We will then make whatever recommendations for change seem necessary. Further copies including large print of the present document may be obtained from the Patent Office website at [www.patent.gov.uk](http://www.patent.gov.uk) or by contacting Matthew Cope on 01633 813778.

## 2 *The enquiry*

2.1 In the following paragraphs we deal with the central issues surrounding the inventive step requirement, and the questions posed are intended to prompt views and experience as to how well it works. Those who would like a more detailed consideration of the background to this enquiry should refer to the primer which is in Annex A. We welcome responses from anyone interested in the patents system and its relationship with innovation and competition, including those who have been, or expect to be users of the system. Although we are unable to comment on the details of any specific cases, you should feel free to include examples in your responses. Responses are to be returned by 31<sup>st</sup> May 2006 and for convenience a response form which lists the questions is provided in Annex B.

### **The wider significance of the level of inventive step, and the need for change**

2.2 The wider question: "What is a patent system for?" has lain at the root of a number of comments and reviews over recent years, and these have often touched on the question of the level of inventive step. Perhaps the most significant of these reviews have been two comprehensive reports that have issued in the USA. **Firstly**, the report of the Federal Trade Commission "*To promote innovation: the proper balance of competition and patent law and policy*" (October 2003)<sup>1</sup>. This report takes as a given the influence that patent policy, as well as competition, can have on innovation, and seeks to establish the correct balance between those two influences. More significantly, in Chapter 4 of the report the substantive standards of patentability are examined from a competition perspective. The inventive step requirement is said to be *prima facie* well suited to achieve the desired policy objectives of the patent system, but what is considered more important is how it is applied. The dangers of too lax and too strict an application are set out, and it is recommended that two areas of current US practice (concerning commercial success, and what is suggested by the prior art) be modified to avoid the extremes. **Secondly**, the report of the National Research Council of the National Academies "*A patent system for the 21<sup>st</sup> century*" (2004)<sup>2</sup> identifies seven criteria for evaluating what a patent system should do, of which one confirms the need for inventions to comply with the usual statutory requirements such as inventive step. Noting considerable circumstantial evidence of a drop in patent quality in the USA, which might partly be due to difficulties in applying the inventive step requirement to technologies such as biotechnology and business methods (although trivial patents are also identified in other areas), the report recommends that this requirement be "reinvigorated": the discussion on this does however focus on addressing specific difficulties in the areas of business methods and gene sequences.

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<sup>1</sup> Available at <http://www.ftc.gov/os/2003/10/innovationrpt.pdf>

<sup>2</sup> Available at <http://www.nap.edu/html/patentsystem/>

2.3 The UKPO recognises the significance of the patent system for innovation, and the risks for innovation in having an overly hard or overly easy application of the inventive step requirement. These risks can be briefly summarised as follows. The risk attached to having an easy application of the inventive step requirement is that patents can be obtained for small improvements or changes to an extent that the legitimate activities of third parties can be restricted. The risk attached to having a hard application is that meritorious inventions do not get patent protection, or get restricted protection, and that research and investment are impeded. It can be concluded from studies such as the American ones that the easy scenario is a more immediate concern. But it is unclear whether these risks are real or theoretical in the United Kingdom, whether one is preferable over the other, whether major concerns exist about patent quality in the United Kingdom, and whether the specifically American issues that are examined in these reports have any counterpart in the United Kingdom (clearly those relating to business methods do not, as such subject matter is not patentable in the United Kingdom). In assessing the general need for change we also wish to probe how sensitive innovation here might be to variations in the level of inventive step that might reasonably be expected in the United Kingdom on the track record of, say, the last ten years.

*Q1. 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?*

*Q2. 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?*

*Q3. 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?*

#### **Possibilities for refining the inventive step requirement: the law**

2.4 The need for the inventive step requirement to serve innovation in this country is a prime policy objective; but there are other objectives that it should satisfy, and these concern achieving a fair balance between the interests of each patentee and those of the public at large; and consistency and harmonisation. For these reasons, even if the inventive step requirement in the United Kingdom seems to be serving innovation as well as it can, it should nevertheless be considered whether it might be refined to improve the determination of the level of inventive step, and to improve confidence in that determination. This needs a more detailed consideration of the inventive step requirement.

2.5 The inventive step requirement is determined by both the definition of the requirement in law, and the implementation of that law. The law is implemented both pre-grant – by examiners in the UKPO who vet each application for a patent – and post-grant for that small proportion of patents whose validity is challenged, before the courts or before a UKPO hearing officer. In reviewing the inventive step requirement as a whole it should be asked whether any of the legal constraints could or should be changed. In more detail the constraints are:

- **Primary legislation.** Primary legislation (in other words section 3 of the Patents Act 1977) essentially sets out an objective test for the presence of inventive step, that is **whether the invention is obvious to a person skilled in the art.** There appears to be a wide measure of international agreement that this is the appropriate basic requirement.
- **Secondary legislation.** It is a role of secondary legislation to lay down more detailed requirements for the implementation of the primary requirements. An example is Rule 22 of the Patents Rules 1995 which was modified to explain how the unity of invention requirement is to be interpreted. To date the UK and Europe have not had a rule relating to the implementation of inventive step, but several possible texts have emerged in international discussions on harmonisation, and they would require that:
  - The person skilled in the art, having regard to any item(s) of prior art or common general knowledge would have arrived at the claimed invention (*the European proposal*).
  - Any item(s) of prior art or common general knowledge would have motivated a person skilled in the art to reach the claimed invention (*the Japanese proposal*).
  - Any item(s) of prior art or common general knowledge would have motivated, with a reasonable expectation of success, a person skilled in the art to reach the claimed invention (*the American proposal*).
- **Case law from the courts and the European Patent Office.** Proceedings in the UKPO where we examine for inventive step have a different character from proceedings in the courts where validity is under challenge, but the UKPO is nevertheless bound to adopt the same analysis of inventive step as the courts, and decisions of the Boards of Appeal of the European Patent Office on the same subject are also persuasive. The precedent effects of case law cannot however be effectively changed other than by a change in the law itself.

2.6 In summary therefore we would like to know whether stakeholders believe that a change to the regulatory framework within which the courts and the UKPO operate is necessary or advisable – **a change to the Patent Rules being the most feasible option.**

Q4. *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)?*

### **Possibilities for refining the inventive step requirement: the UKPO**

2.7 The UKPO has an important role pre-grant as “gatekeeper” of inventions entering into the patents system. Within the legal framework outlined above the UKPO operates according to examination guidelines that are set out in the Manual of Patent Practice<sup>3</sup> (MPP), in which section 3 reflects court precedents and other matters affecting examination for inventive step. The first, key step carried out by the examiner is to assess the presence or absence of inventive step and a variety of approaches may be used here. The key legal precedent in the UK is the four-step Windsurfing test set out by the Court of Appeal in *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*, [1985] RPC 59. Further questions to be taken into account were laid out in *Haberman v Jackal* [1999] FSR 685 (at 699 to 701). Annex A has more details of this guidance.

Q5. *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?*

### **Communicating inventive step objections**

2.8 Framing an inventive step objection involves many factors, starting with the identification of the relevant prior art (including the appropriate combination of documents or common general knowledge), the assessment of their significance, the identification of the relevant art and the attributes of the skilled man, and finally the assessment of any advance in the light of those factors.

Q6. *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?*

### **Evaluating relevant factors, including the applicant's arguments**

2.9 The examiner (or any other person) who is considering the question of whether or not an invention is obvious must be aware of many factors. In considering a prior publication the examiner must avoid looking at the document under the influence of the application he is examining, and should attempt to place himself in the shoes of the **skilled person faced with the problem at hand**. The way in which documents are

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<sup>3</sup> Available at <http://www.patent.gov.uk/patent/reference/mpp/index.htm>

combined must also be considered carefully and an assessment made regarding the breadth of knowledge of the notional man skilled in the art. Where an examiner considers that there is *prima facie* a strong case for obviousness, it is up to the applicant to put convincing material in front of the examiner<sup>4</sup>. As the examination proceeds due consideration must be given to the arguments presented by the applicant in response to the objections raised. It is important to ensure that arguments raised by the applicant satisfactorily address the issues before granting of a patent, if necessary by sustaining the objection in a further examination report. However, where the objection is adequately addressed or overcome, grant should proceed.

2.10 The point of view is sometimes advanced that it is necessary for examiners, who may not fully possess the attributes of the notional person skilled in the art, and who will not have access to expert evidence, to grant borderline cases so that patents can emerge and be subject to challenge after grant with full evidence concerning the view of the skilled man. The UKPO recognises that this may place a burden on third parties to monitor and challenge dubious patent rights, and advises its examiners in current guidance (MPP 18.34) to give benefit of the doubt only where the examiner feels his/her lack of expertise prevents proper consideration of technical argument. Examiners will otherwise evaluate inventive step on the balance of the evidence available (MPP 18.36).

*Q7. Do we give fair consideration to observations from the applicant in response to an inventive step objection?*

*Q8. 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?*

## **Objective and consistent standards**

2.11 The test for obviousness should, as far as possible, be an objective one. The question is whether the invention would have been obvious to a person skilled in the relevant art, and not whether it was or would have been obvious to the inventor or to some other particular worker. Clearly however there are many factors that vary between patent applications and the fields of technology to which they apply. It is also the case that the assessment of inventive step requires the exercise of personal judgment on the part of the examiner, and subjective variations may creep in here. It has furthermore been suggested that the assessment of inventive step in any particular area of technology may change as that field of technology matures.

*Q9. 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?*

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<sup>4</sup> As held in *Degussa-Huls AG v The Comptroller-General of Patents* [2005] RPC 29

## **Level of inventive step in patents granted by UKPO**

2.12 It is clearly critical that the right judgment is made as to exactly what sort of difference over the prior art constitutes an inventive step. Just as an invention will lack novelty if the claim to it would re-monopolise something already disclosed (the so-called "post-infringement test"), so an invention should be regarded as obvious, according to current case law, if a claim to it would inhibit the rights of a skilled workman to carry out routine modifications of what is already in the public domain.

*Q10. 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?*

## **Comparison of UKPO with other offices**

2.13 The Patents Act 1977 and the European Patent Convention contain analogous provisions for inventive step. While jurisprudence in the UK and before the EPO varies in some areas of patent law, in the area of inventive step the legal principles followed by the two offices are closely similar. The EPO does however have a preference for analysing inventive step according to the problem-and-solution approach. Other national patent offices have varying requirements relating to inventive step, and various approaches have evolved in those countries in order to assess applications with regard to those requirements.

*Q11. In your experience, how does the approach of the UKPO with regard to inventive step compare to other patent offices?*

*Q12. Do you have any further comments regarding the inventive step requirement in the UKPO or in the UK generally?*

## **3 How and when to respond**

Please send your responses by 31<sup>st</sup> May 2006 to:

Matthew Cope  
Room 1.G40  
The Patent Office  
Concept House  
Cardiff Road  
Newport  
NP10 8QQ  
Fax: +44 (0) 1633 814444  
Tel: +44 (0) 1633 813778  
Email: [isreview@patent.gov.uk](mailto:isreview@patent.gov.uk)

If you are responding on behalf of a representative group, please give a summary of the people and organisations you represent.

If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Coordinator, whose details are included in Annex C.

#### **4 Openness/Confidentiality**

4.1 This is part of a review exercise, the results or conclusions of which may be published. As such, your response may be made public. If you do not want all or part of your response or name made public, please state this clearly in the response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in your fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.

4.2 Information provided in response to this review, including personal information, may be subject to publication or disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want other information that you provide to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals, amongst other things, with obligations of confidence.

4.3 In view of this it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. An automatic confidentiality disclaimer generated by your IT system will not, of itself, be regarded as binding.

4.4 The Patent Office will process your personal data in accordance with the DPA and in the majority of circumstances this will mean that your personal data will not be disclosed to third parties.

## **Annex A - A primer on the background issues**

A1 A semantic point should first be made as to the phrase "level of inventive step" which is used in this document. It should be understood that the law, here and abroad, requires only the presence of an inventive step in any particular case, and this step does not have to be of a certain size or level. Across many cases however there may emerge a perception that a certain level (or standard) is required, and this will be connected with how ready examiners or judges are seen to be to recognise the existence of the inventive step. This review is concerned with the level of inventive step in this more general sense.

### **The international scene**

A2 The inventive step requirement as we know it in our primary legislation is an almost universal feature of patent law, and it is one of a range of legal requirements that fall on examining patent offices and on courts to enforce relative to patent applications and patents. The effect is that an invention must not be merely different from what has gone before, but must be sufficiently different to justify the grant and maintenance of a patent. The difference is sufficient if it can be said to constitute an inventive step. To avoid subjectivity in the determination of what amounts to an inventive step, the perception of a notional person skilled in the art as to the obviousness of the invention is used as a determinant.

A3 So far as primary legislation goes the inventive step requirement is common ground between most patent systems. Divergence between countries on the level of inventive step in their patents should thus be attributable to different implementation of this provision, and a comparison of practice in the UK with that in other countries – particularly as between the UKPO and the European Patent Office (EPO) and other examining offices in Europe – will be an important point of interest for this review. There are however other factors at work, which have more to do with the types of subject matter that patent offices may in the first place admit as patentable. Notably, the United States Patents and Trademarks Office (USPTO) allows the patenting of business methods and software that would not be patentable elsewhere. These types of subject matter raise their own problems when it comes to identifying prior art and defining the inventive step over the relevant art.

A4 There have recently been many allegations made about the granting of "trivial" patents. In some cases the subject matter involved has fallen into a category, such as a business method, that would not be patentable in this country in any case, but examples have been quoted in areas where the patenting of small incremental improvements allows the creation of patent thickets and portfolios designed to exclude competition to an unfair extent. The adverse effects of such situations are not limited to the constriction of competition in the home market, but are also particularly felt in developing countries that need access to patented medicines.

A5 Another feature of the international scene has been the widespread acknowledgement of the vital importance that quality has within patent systems. Many patent offices are now moving towards the adoption of quality management systems that will ensure that their processes are documented, monitored and continually improved. The wider concept of “patent quality”, which relates to the validity and other attributes of the end product, the granted patent, is also spoken of. It is clear that patent quality can best be assured by monitoring the processes of search and examination that precede the patent grant. The assessment of inventive step is a key process that can influence patent quality in a significant way, and the possibility of improving patent quality in the UK is thus a major driver for this review.

### **The European scene**

A7 National law within Europe on inventive step is harmonised with the provisions of the European Patent Convention (EPC) (see Articles 52(1) and 56). This means that examiners in the EPO are applying the same law to applications for European patents as examiners in the UKPO are to national UK applications. There are however differences in methodology between the offices when it comes to the assessment of the presence of inventive step. The EPO examiner will, wherever appropriate, adopt an analysis of the problem and the solution underlying the invention (see the *Guidelines for Examination in the European Patent Office*, Part C, Chapter IV, section 9.8<sup>5</sup>). The UKPO examiner is more likely to support an inventive step objection by reference to the guidance that has emerged from UK case law, which is described below. This review seeks to explore whether these methodologies produce different levels for the inventive step requirement.

### **The UK scene**

A8 The statutory provisions on inventive step are to be found in the Patents Act 1977. Section 1(1)(b) states that a patent may be granted only if it involves an inventive step. Section 3 states that an invention should be considered to involve an inventive step if it is not obvious to a person skilled in the art, having regard to matter which was in the state of art, i.e. was available to the public, before the priority date of the invention. Accordingly it is a part of the prosecution of every patent application at the UKPO that it must be assessed for the presence of an inventive step by a patent examiner. Even after the grant of a patent it is possible for the court or the UKPO to revoke a patent for lack of inventive step (section 72(1)(a)).

A9 Section 130(7) also emphasizes that these provisions for inventive step were framed to have, as nearly as practicable, the same effect in the United Kingdom as the corresponding provisions of the European Patent Convention. It follows that decisions of the EPO on inventive step are thus relevant and persuasive in the UK.

A10 The question of whether or not an invention is obvious is a matter which can often be assessed by the examiner on the facts of the particular case and without recourse to any specific method of analysis, but when a more detailed argument is called for there is

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<sup>5</sup> Available at [http://www.european-patent-office.org/legal/guidelines/pdf\\_2005/part\\_c\\_e.pdf](http://www.european-patent-office.org/legal/guidelines/pdf_2005/part_c_e.pdf)

guidance available from various precedent judgments of the UK courts. The practice of the UKPO and the precedent cases relevant thereto are set out in detail in Section 3 of the MPP.

A11 The judiciary has given general guidance as to what the appropriate level for the inventive step requirement should be:

- the *CIPA Guide to the Patents Act* (Sweet & Maxwell, fifth edition, page 83) cites the following statement by an American judge, Judge G S Rich, as a practical test of obviousness:

"The good patent gives the world something that it did not truly have before, whereas the bad patent has the effect of trying to take away from the world something which it effectively already had."

- the Court of Appeal in *PLG Research v Ardon* [1995] RPC 287 said:

"The philosophy behind the doctrine of obviousness is that the public should not be prevented from doing anything which was merely an obvious extension or workshop variation of what was already known at the priority date."

- in *Philips' (Bosgra's) Application* [1974] RPC 241 it was pointed out that the source of the word "obvious" is the Latin "*ob via*", literally "lying in the road", and it was said:

"These (emulsifying) agents were obvious in this sense, indeed in the true sense of the word, that they were lying in the road, they were there for the research worker to use, and it is quite wrong that he should be stopped from using them."

A12 The more detailed guidance that has emerged from the UK courts on the assessment of inventive step is summarized in the following paragraphs. In *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*, [1985] RPC 59, the Court of Appeal held that the question of obviousness "has to be answered, not by looking with the benefit of hindsight at what is known now and what was known at the priority date and asking whether the former flows naturally and obviously from the latter, but by hypothesizing what would have been obvious at the priority date to a person skilled in the art to which the patent in suit relates".

A13 Thus the court formulated a four-step approach to assessing obviousness:

1. Identify the claimed inventive concept.
2. Identify the common general knowledge known to a skilled but unimaginative addressee in the art at the priority date.

3. Identify the differences, if any, between the matters identified as known or used and the alleged invention.
4. Decide whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.

A14 In *Haberman v Jackal* [1999] FSR 685 (at 699 to 701), Laddie J considered the following non-exhaustive list of relevant questions:

- (a) What was the problem which the patented development addressed?
- (b) How long had that problem existed?
- (c) How significant was the problem seen to be?
- (d) How widely known was the problem and how many were likely to be seeking a solution?
- (e) What prior art would have been likely to be known to all or most of those who would have been expected to be involved in finding a solution?
- (f) What other solutions were put forward in the period leading up to the publication of the patentee's development?
- (g) To what extent were there factors which would have held back the exploitation of the solution even if it was technically obvious?
- (h) How well had the patentee's development been received?
- (i) To what extent could it be shown that the whole or much of the commercial success was due to the technical merits of the development?

A15 What constitutes an inventive step may depend on the nature of the invention. The matter was considered by Lord Hoffmann in *Biogen Inc v Medeva plc* [1997] RPC 1 (at page 34) as follows:

"Whenever anything inventive is done for the first time it is the result of the addition of a new idea to the existing stock of knowledge. Sometimes, it is the idea of using established techniques to do something which no one had previously thought of doing. In that case the inventive idea will be doing the new thing. Sometimes it is finding a way of doing something which people had wanted to do but could not think how. The inventive idea would be the way of achieving the goal. In yet other cases, many people may have a general idea of how they might achieve a goal but not know how to solve a particular problem which stands in their way. If someone devises a way of solving the problem, his

inventive step will be that solution, but not the goal itself or the general method of achieving it."

## Annex B – Response form

Please send your responses by 31<sup>st</sup> May 2006 to:

Matthew Cope

Room 1.G40

The Patent Office

Concept House

Cardiff Road

Newport

NP10 8QQ

Fax: +44 (0) 1633 814444

Tel: +44 (0) 1633 813778

Email: [isreview@patent.gov.uk](mailto:isreview@patent.gov.uk)

Name:

Organisation:

Address:

Country:

Post/Zip Code:

Phone:

Email Address:

If you are replying on behalf of a representative body, please tell us in a few words what your organisation does:

Q1. 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?

Q2. 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?

Q3. 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?

Q4. 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)?

Q5. 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?

Q6. 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?

Q7. Do we give fair consideration to observations from the applicant in response to an inventive step objection?

Q8. 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?

Q9. 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?

Q10. 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?

Q11. In your experience, how does the approach of the UKPO with regard to inventive step compare to other patent offices?

Q12. Do you have any further comments regarding the inventive step requirement in the UKPO or in the UK generally?

## **Annex C - Government Code of Practice on Written Consultations**

### ***General Principles of Consultation***

This consultation is being conducted according to the Code of Practice on Written Consultations issued by the Cabinet Office. This recommends the following criteria:

1. Consult widely throughout the process, allowing a minimum of 12 weeks for written consultation at least once during the development of the policy.
2. Be clear about what your proposals are, who may be affected, what questions are being asked and the timescale for responses.
3. Ensure that your consultation is clear, concise and widely accessible.
4. Give feedback regarding the responses received and how the consultation process influenced the policy.
5. Monitor your effectiveness at consultation, including through the use of a designated consultation co-ordinator. Ensure your consultation follows better regulation best practice, including carrying out a Regulatory Impact Assessment if appropriate.

### ***Comments about the consultation process***

If you have any comments or complaints about how this consultation process is being handled, please tell the Patent Office's Consultation Co-ordinator, who is:

Maria Ciavatta  
Consultation Co-ordinator  
The Patent Office  
Concept House  
Cardiff Road  
Newport NP10 8QQ

Tel: +44 (0)1633 814796  
Fax: +44 (0)1633 814509  
E-mail: [Maria.Ciavatta@patent.gov.uk](mailto:Maria.Ciavatta@patent.gov.uk)

## **Annex D - Individuals and organisations which have initially been sent this consultation document**

***Copies of this consultation document have been sent to the following organisations. Copies have also been sent to a number of individuals.***

### **Member organisations of the former Standing Advisory Committee on Industrial Property (SACIP):**

The Law Society  
The Law Society of Scotland  
The Bar Council  
The Institute of Patentees and Inventors  
Trade Marks, Patents and Designs Federation  
Confederation of British Industry  
University of London, Queen Mary and Westfield College  
British Retail Consortium  
Incorporated Society of British Advertisers  
Chartered Society of Designers  
Chartered Institute of Patent Agents  
Institute of Trade Mark Attorneys  
Association of British Chambers of Commerce  
Consumer's Association  
National Consumers Council  
Federation of Small Businesses  
Licensing Executives Society

### **Organisations which formerly received SACIP papers:**

International Federation of Industrial Property Attorneys  
International Chambers of Commerce  
Association of the British Pharmaceutical Industry  
Intellectual Property Institute  
London Chamber of Commerce and Industry  
Institute of Practitioners in Advertising  
Anti-Counterfeiting Group  
Intellectual Property Lawyers Association  
British Brands Group  
Patent and Trade Mark Group, Institute of Information Scientists  
The Patent Judges  
The Intellectual Property Sub-Committee of the City of London Law Society

British Pharma Group  
 The British Agrochemicals Association Limited  
 British Generics Manufacturers Association

**Patent Offices including:**

Patent Offices of the EPC contracting states  
 European Patent Office  
 United States Patent Office  
 World Intellectual Property Organisation  
 Japanese Patent Office  
 Singapore Patent Office  
 Australian Patent office  
 New Zealand Patent Office  
 Canadian Patent Office

<b>Organisation</b>	<b>Organisation</b>
ABPI	Gallafent & Co
ACID	Gill Jennings & Every
Agricultural Engineers Association	Harbottle & Lewis
Allvoice	HM Treasury
Arnander Irvine & Zietman	Home Office
Ashurst Morris Crisp	Intellectual Property Advisory Committee members
Association Of British Insurers	Intellectual Property and Innovation Directorate
AURIL	Inventorslink Inc
Babcock International Limited	Linklaters & Paines
Baker & Mckenzie	Linux User Magazine
Berwin Leighton	Litigation Focus Group members
Bharat Electronics Limited	Lovells
Bioindustry Association	Magister Limited
Biotechnology And BSRC	Marketforce Communications
BLWA	Marks & Clerk
Boult Wade Tennant	Medical Research Council Technology
British Association Representing Breeders	Mewburn Ellis

British Generics Manufacturers Association Limited	Ministry Of Defence
British Library	NASPM
British Potato Council	NI Court Service
British Poultry & Meat Federation	Norton Rose
Cardiff Law School	Olswang
Chemical Industries Association	Pfizer Limited
International Maize and Wheat Improvement Center (CIMMYT)	Pilkington Technology Centre
Compassion in World Farming	Preventative Medicines Tech Inc.
Conde Limited	Processors & Growers Research Association
Council on Tribunals	RWS Group
Crafts Council	Scottish Executive Justice Dept
Cranfield University	SIBLE University Of Sheffield
Crop Protection Association	Simmons & Simmons
Cruikshank & Fairweather	Society of Motor Manufacturers and Traders
DEFRA	Society Of Numismatic Artists & Designers
Department for Constitutional Affairs	Software Focus Group members
DTI (BRCII1)	The British Society Of Plant Breeders Limited
DTI (BRCII2)	The Centre of Research for Intellectual Property and Technology (SCRIPT)
DTI (BRCII5)	UKASTA (Scottish Council)
DTI (BRCII7)	UKASTA Ltd
DTI (CCP4)	UKREP – Foreign and Commonwealth Office
DTI (Consumer Goods Unit)	University Of Alicante
DTI (EWT)	University Of Cambridge
EC Laws Committee - LES Britain & Ireland	University Of Oxford

Enforcement Focus Group members	Visteon Global Technologies
Eureka Manufacturing Co. Limited	
Federation Of The Electronics Industry	
Frank B Dehn	
Freshfields	

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