

# Patent Quality

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# Patentability Criteria

- **Novelty**
- **Inventive Step**
- **Industrial Application**
- **Clear and concise claims shall define the matter for which protection is sought**
- **Sufficiency of Disclosure**
  - Sufficiently clear and complete to be carried out by the skilled man
- **Exceptions from Patentability**
  - Discoveries, scientific theories, mathematical methods
  - Aesthetic creations
  - Schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers
  - Presentations of information

# Inventive Step

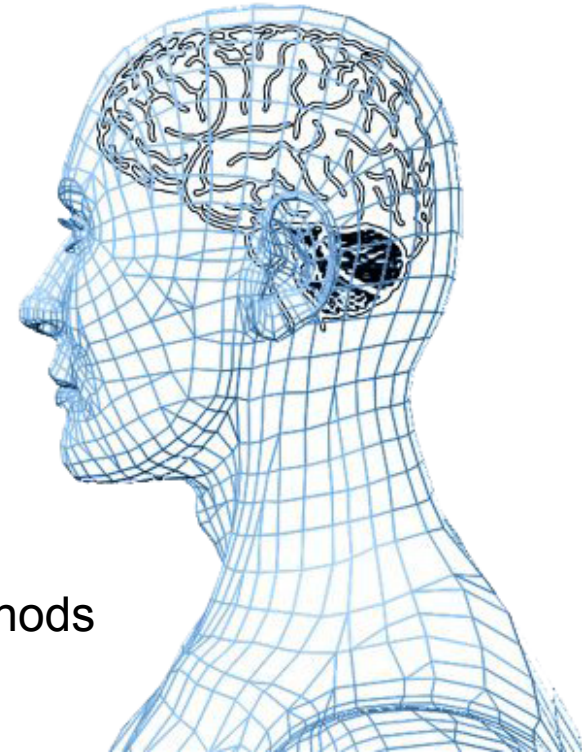
- **An invention shall be considered as involving an inventive step,**
  - if having regard to the state of the art,
- **it is not obvious to a person skilled in the art. (Art 56 EPC)**
  
- **Predicated on high quality search for prior art**
- **“Obvious” means?**
  - That which does not go beyond the normal progress of technology but follows plainly or logically from the prior art –something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art
  - More than merely novel?

## The Skilled Man

- **Who is the skilled person?**
- **An invention is obvious if it is something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art**
- **Is there a hint or pointer in the state of the art which would lead the skilled person to the claimed invention?**
- **Would the skilled person, having regard to the choices available to him, address the particular problem under consideration and arrive at the claimed solution with a reasonable expectation of success?**

# Improving patent quality & reducing uncertainty

- **Patent Quality Initiatives happening globally**
  - Peer to Patent community patent review
  - Open Source As Prior Art
  - Patent Quality Index
- **Amicus (friend of the court) Activity**
  - Phillips – precision in claim interpretation
  - eBay – balance in awarding injunctions
  - Metabollite – technicity requirement for business methods
  - KSR – raising the bar on non-obviousness
- **Patent Holder's Code of Conduct**
  - Upholding the patentee's side of the shared responsibility



# Global Collaborative Examination

- **Multiple searches by different Patent Offices collated and used by all examiners to do substantive examination**
- **Concept:**
- A secure workspace for examiners worldwide to share search results and analysis
  - Each examiner at least searches in own area of own expertise and language
  - Combined with third party submitted prior art
- Accessible to patent offices worldwide
  - Secured
- Search results shared to other examiners
- Applicability of prior art discussed among examiners
- Office actions written separately after discussion is closed