

## **Working Guidelines**

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### **Question Q213**

#### **The person skilled in the art in the context of the inventive step requirement in patent law**

##### **1) Introduction:**

The 2010 Paris AIPPI Congress will deal with one of the most important issues in the patent law: the inventive step.

The Executive Committee of AIPPI decided, at its meeting in Buenos Aires in October 2009, to start a study on the inventive step requirement by the analysis of the current definition given in the national laws to the person skilled in the art.

Both the historical and contemporary reasons commend this study which concerns one of the most fundamental aspects of the patentability of new inventions.

##### **2) The previous work of the AIPPI:**

In its more than one hundred years history, AIPPI has not had many occasions to study the patentability criteria.

The question Q 35: “Method and preparation of a study on the unification of law on patents for invention”, which started at the London Congress in 1960 and gave place to the resolution at the Berlin Congress in 1963, treated the question of the inventive step.

This resolution gave birth to the first unified definition of the inventive step but didn't take care of the definition of the person skilled in the art.

The next questions related to the patentability criteria were:

- Q 69 concerning the sufficient description of the invention, which gave place to the adoption of the AIPPI resolution in the Munich Congress in 1978
- and Q126 concerning the methods and principles of novelty evaluation in the patent law, which was debated during the Montreal Congress in 1995.

More recently, AIPPI worked on the current standards for the prior art disclosure in assessing novelty and inventive step at the Lisbon EXCO in 2002 and adopted the resolution on this question under the number Q 167.

And, during the Geneva Congress in 2004, Berlin EXCO in 2005 and Gothenburg Congress in 2006, AIPPI worked on the resolutions related to the question Q 180: Content and relevance of industrial applicability and / or utility requirements for patentability.

Surprisingly, despite the fact that AIPPI, on several occasions, worked on the issues related to the patentability of the new fields of technology in which the human inventiveness could express its capacities, like biotechnology, software or business methods, the question of the inventive step and particularly the definition of the person skilled in the art has not been studied for a long time by the Association.

### **3) Discussion:**

- The need to re-examine the adequacy of the theoretical definition of the inventive step, and particularly of the person skilled in the art in relation to the inventive step, seems particularly important at this time.

Not only the various forms of economic development put periodically into question the adequacy and the relevance of the patent systems to the social needs, but also the apparition of the new fields of technology commands the need of the re-evaluation of the rules of the patent law.

And in the center of the patent law resides the notion of the inventive step which cannot be assessed without the reference to the person whose attitude or behavior establishes the standard to determine the existence or not of inventive step.

- It should be kept in mind that consideration of the person skilled in the art in relation to the assessment of the validity of the patent occurs at several stages.

At first, it will be considered during the stage of the examination of the application. It also may be considered in post grant proceedings in which the validity of the patent is challenged.

The concept of the person skilled in the art may also be used in the context of the claim construction, both in the assessment of the validity of the patent and in the determination of the scope of protection.

Besides the question of the patentability criteria, the concept of the person skilled in the art is also used in the assessment of the sufficiency of the disclosure in the specification.

Therefore, its role in the determination of the protection conferred by a patent is fundamental.

- It has also to be underlined that this theoretical construction of the person skilled in the art, which corresponds to other theoretical models used in law, like the reference to the *bonus pater familias* in civil law, may see its contours modified by the changes occurring in the way the inventions are achieved nowadays, where they are rarely the fruit of a single person's efforts, but more often the result of the common work of a team of people.

And it seems appropriate to take into consideration the various ways the inventions are made in the real way (like: joint research between enterprises and universities, research teams of the private investors collaborating with other enterprises in various fields of technology, but

also, even if they are rare, the single inventors taking advantage of the years of their experience, etc.) to adopt in consequence the definition of the person skilled in the art to those circumstances.

This re-evaluation may also put into the question the principle of defining the skilled person in the art as the theoretical standard, since it can be argued that the appreciation of the inventive step should be done *in concreto* assessing the factual situation in which the inventor put himself.

- In consequence the main question to investigate in the realm of Q213 will be whether the existing definition and characteristics of the person skilled in the art are still appropriate and suitable or whether they have to be adapted to the various developments outlined above, as well as to know if the methods and tools used to apply this definition are still appropriate.

The present working guidelines have as their objective to focus the contour of the study that should be undertaken by AIPPI.

And, after answering the questions related to the statutes of the current national laws, the Groups are asked to propose their ideas for the future solutions that could be used as a background for the harmonized rules.

#### **4) The situation in the national laws:**

The suggested questions will try to analyze and to understand the definition of the “person skilled in the art” in three steps: the notion of the “person”, the issue of its personal “skills” and finally the “technical field” in which these skills are exercised.

- 1) The study proposed by AIPPI starts with the consideration of the person as one of the elements of the definition of the person skilled in the art.

The Groups are therefore requested to indicate if the person skilled in the art is one, or more, person.

If a skilled person is a team of people, then are the team members all the same or may they be different in their various attributes, specifically if such a team may comprise persons from various disciplines or having different levels of qualifications?

- 2) Is the skilled person a real person (or team of persons) or a hypothetical person?
- 3) The person skilled in the art has to be analyzed in the frame of her/his personal capacities and attributes.

At first, it is necessary to know whether and if so to which extent this person has reasoning and/or creative capacities or if he/she has merely the capacity to perform or execute the orders or instructions from other people.

Another point that can be discussed is whether the personal attributes of the person skilled in the art are the same also for other circumstances in which the person skilled in the art may have a role, such as construction of the patent or for the consideration of the sufficiency of the disclosure in the specification, even if this last point goes beyond the scope of the present study.

Finally, the question that can be discussed is the issue of knowing if the personal attributes of the person skilled in the art are the same for different IP rights covering

technical creations, like patents or utility models, species, etc., if they exist in the national law.

- 4) Another important aspect of the question is to know what are the personal skills of the “person skilled in the art”?

At least, two important issues deserve to be analyzed:

- What is the level of the qualification or skills of the person?
- And what are the nature and the scope of his/her knowledge?

The second issue encompasses more precisely the question of the capacity to understand and to analyze the documents which are accessible to the person skilled in the art, this capacity being called “the general knowledge” and concerns the proof of the content of the “general knowledge”:

- a) what is the scope of such knowledge in general terms?
  - b) is such knowledge limited to the general technical training of such person?
  - c) to what extent is information in documents – articles or prior patents - considered to be included as part of such working knowledge?
  - d) can such knowledge include information which the person may not have memorized, but can readily look up?
- 5) The question of the person skilled in the art raises also the problem of the moment of the evaluation of those skills: should they be all evaluated at the moment of the appreciation of the validity of the patent, i.e. at the moment of the priority date, or could they be evaluated also at the date when the patent is assessed by the Judge, for example in the infringement proceedings, where the validity can be debated jointly with the infringement claim? This may conduct to the differences of appreciation in case the notion of the equivalence is used in relation to the prior art.
  - 6) The next issue related to the definition to the person skilled in the art is the technical domain or "the art" in which his or her skills are performed.

The first sub-question is to know if those skills are concentrated in one or several technical fields.

And the second one is related to the way the frontiers between different technical fields can be established: how this determination is assessed by the Judges or Patent Offices?

- 7) The question is also to know what is the nature of his/her competence in the technical field and particularly if this competence theoretical or practical?
- 8) The Groups are requested to indicate how in practice the assessment of the skills of the person skilled in the art is operated. What is the role of the opinion of the experts on this point?
- 9) Finally, the Groups are also invited to present all other questions which may appear in the context of the question of the person skilled in the art.

## 5) Future harmonization:

After assessing the national solutions, the Groups are invited to present their proposals for the possible harmonization and specifically the harmonized definition of the person skilled in the art. The object of this section is not to repeat all the questions related to the current statute of the national law, but to find the most fundamental points on which the international harmonization could be sought.

- 1) Specifically, the Groups are invited to precise on which points they see the particular need of the international harmonization on the issue of the person skilled in the art.
- 2) The Groups may indicate if the “person skilled in the art” standard should be assessed as a hypothetical model or on the contrary appreciated *in concreto*?
- 3) Should the skills of the “person skilled in the art” be only to execute other person orders or should they be creative and both practical and theoretical?
- 4) Should the art in which the skilled person intervene be of only one discipline, or should it cover several technical fields?
- 5) The Groups are also invited to present all other suggestions which may appear in the context of the possible international harmonization of the definition of the person skilled in the art.

**Note:** It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.