

Public consultation on level of the inventive step required for obtaining patents – the Government’s response

1. Introduction

Patent offices around the world examine patent applications for compliance with a number of criteria. The Patents Act 1977 introduced routine examination for inventive step (obviousness) to the UK examination process for the first time.

Inventive step is one of the most difficult issues that a patent examiner must decide. Having read the patent application and the documents cited against it, they must then put themselves in the shoes of a hypothetical skilled man, who knows everything but does not have the slightest spark of inventive ingenuity, and decide if he would make the step from the prior art to the invention claimed in the application without any knowledge of that application. In one sense this is a question to which an objective “yes or no” answer can be given; in reality, however, it is one which is fraught with difficulty, in which a conclusion must be reached on the basis of evidence which is sometimes inadequate, and in which a great deal of subjective judgement and experience must be exercised. The examiner is usually arguing against skilled advocates (patent agents), who will seek to counter the examiner’s arguments and thereby to demonstrate or suggest that their client’s invention is inventive.

From time to time there are suggestions that it is too easy to obtain a patent, in the sense that the inventive step requirement is too easily satisfied. Although these suggestions often turn out to relate to patents granted in the USA, and in particular to business methods and software, for which patents are easier to obtain than in Europe, it was decided to carry out a survey of stakeholders’ views concerning the way in which inventive step is examined in the UK, in order to ascertain whether there are improvements that can be made in this important area.

A more wide-ranging review¹ of the intellectual property framework in the UK has recently been carried out by Andrew Gowers. It is reassuring to note that the conclusions below are fully consistent with those of the larger review.

2. Methodology

Customers of the Patent Office and others have been consulted by means of a questionnaire placed on the Patent Office website; copies were also sent to a number of interested parties. The questions are reproduced with an overview of responses in the accompanying document. Whilst the consultation did not give rise to a very large volume of replies, a number of the responses that were received were from significant bodies and companies representing the views of many professionals in the field.

¹ http://www.hm-treasury.gov.uk/independent_reviews/gowers_review_intellectual_property/gowersreview_index.cfm

3. Summary and discussion of results

The overall message of the responses is that respondents are happy with current law and practice. Where there are difficulties, these are mostly confined to specific situations rather than ‘across the board’ failings. For example the ‘obvious to try’ formulation used recently by the UK courts when refusing some biotechnology patents caused concern to some respondents involved in that sector.

There were also some suggestions that it is too easy to obtain a patent for software (computer implemented inventions), although it may be that, rather than this being an issue relating specifically to inventive step, it was part of a more general opposition to patents in this field.

The consultation confirmed the desirability of a balanced approach – neither too strict nor too relaxed - when examining for inventive step. The responses showed that the level of inventive step applied by the Office is felt by most respondents to be appropriate. The majority of respondents (including the main organisations representing patent professionals) were of the opinion that the office should steer a middle way between the interests of patentees and those of third parties, and the overwhelming majority of respondents felt that the Office had successfully avoided the damaging effects of a too strict or too lax implementation of inventive step.

The Office is seen as slightly more generous in what it will allow than are the courts. To some extent this will be due to the greater wealth of evidence that is usually available in adversarial litigation, possibly including testimony of expert witnesses. Moreover, at the application stage, the Office gives the benefit of reasonable doubt to applicants where debatable questions of fact arise. This approach does not appear to give rise to problems in most areas and most respondents were satisfied with the approach. Generally, examiners are seen as responsive to arguments from the applicant to an appropriate degree.

The consultation document offered suggestions for potential amendments to the patent rules, but most respondents showed little enthusiasm for changing the law of inventive step. The opinion from all of the collective groups of patent professionals who responded to the consultation was that change to statute or rules was neither necessary nor likely to be helpful.

Respondents also showed little enthusiasm for changing the way in which inventive step is analysed in practice. What users do however expect from the Office is a rigorous application of the existing law and legal precedents provided by the courts. In particular, where documents are combined to justify an objection to obviousness, an explanation should usually be given as to why it is considered that the skilled man would make such a combination.

Some responses also underline the importance to a high-quality examination for inventive step of the search, and of the assessment of what is common general knowledge and features that are commonplace in the art. To this end it is important that within the cadre of examining staff, in addition to knowledge of patent law, a high standard of awareness is maintained across all areas of technology and searching skills are continuously developed and honed.

Another issue that the external consultation highlighted was a lack of public awareness of the provisions of Section 21 of the Patents Act. These provisions enable anyone to submit arguments and evidence on the patentability of an invention, including on the question of whether or not it involves an inventive step. This facility has previously been publicised on the Office website, but clearly the message is not getting across to all users and interested parties. When used constructively, this feature of the law allows the Office to benefit from expert views on the presence, or absence, of inventive step and can greatly enhance the identification of relevant prior art. This aspect has also been discussed in the Gowers Review (see paragraphs 5.26-5.26 and recommendation 22).

There is no evidence of any serious disparity between the UK Patent Office and the European Patent Office (EPO) when dealing with inventive step. It appears that, bar some minor variations, the UK and EPO are seen to be broadly equivalent in the 'level' of inventive step applied. This is reassuring given that both offices examine patents under (essentially) the same law. On the other hand, the United States Patent and Trademark Office (USPTO), which operates under a different legal framework, was felt by many to require a lower level of inventive step. Interestingly the Scandinavian countries (which operate within the European system) were felt to be somewhat stricter than the either UK or the EPO.

4. Conclusions and key actions

These conclusions follow directly from responses to the public consultation exercise and are fully consistent with recommendations made by the Gowers review. Follow-up actions indicated will be undertaken during 2007.

1. There is no need for any change to the basic law as it relates to inventive step.
2. There is a possible problem in the consistency of application of the inventive step test in high technology fields, and work will be carried out to investigate this further.
3. Continuing professional development for examining staff at the Patent Office will emphasise the need to maintain technological knowledge up to date, and to continually refine searching skills. This echoes recommendations made by the Gowers review.
4. Use of the facility to make third party observations on patentability under s.21 of the Act will be encouraged, such efforts already being in line with the recommendations of the Gowers review.

Annex A

Consultation on the inventive step requirement in United Kingdom patent law and practice

Overview

The formal consultation document entitled "Consultation on the inventive step requirement in United Kingdom patent law and practice" included a set of 12 questions (reproduced below), and this was placed on the Patent Office website on 3rd February 2006 for a period of just under 4 months (closing on 31st May 2006).

As some responses were received in the form of general comment, rather than answers to specific questions, the following document gives an overview of the explicit answers and any free text comments which appear to be relevant to a particular topic.

Information regarding respondents.

During the consultation period, the HTML document was accessed by users 5,749 times and the PDF version of the document was downloaded 1,938 times. Paper copies or electronic mails were sent to all of the organisations and individuals listed at Annex C. A total of 26 responses were received, 6 of these being on behalf of representative bodies such as The Chartered Institute of Patent Agents (CIPA), The Licensing Executives Society (LES) and The Trade Marks Patents and Designs Federation (TMPDF) (see Annex B for further details of the collective respondents).

The breakdown of respondents is as follows;

Technology companies	6
Technology consultancy	1
Trade association/professional body	6
Private individuals (UK):	9
Patent Attorney, as individual (UK):	1
Patent Attorney on behalf of firm	1
Other Patent Offices	1
Lobby groups	1
Total responses	26

Useful comments were also received from the Portuguese Patent Office, although this was in response to a paper presented at EuroTab (the European Patent Practice Round Table meeting) rather than a direct response to the consultation.

The mode of response was as follows;

Web site:	8
Mail:	1
Electronic mail:	15
Facsimile:	2

Question by question breakdown.

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?*

Number of respondents	Background of respondent	Explicit answers to questions
3	Software Lobby	The office should create a harder hurdle for IS.
1	Technology Company or Consultancy	The office should create a harder hurdle for IS.
2	Individual	Err on side of strictness
Assoc. (AIPPI)	Patent Professional	The benefit of the doubt should not be given to applicants as pre grant examination is effectively ex parte giving an inherent advantage to the applicant.
1	Patent Professional	High enough to give credibility to valuable right
Assoc. (TMPDF)	Patent Professional	The office should steer a middle way.
Assoc. (CIPA)	Patent Professional	The office should steer a middle way.
Assoc. (Marks & Clerk)	Patent Professional	The office should steer a middle way
Assoc. (BIA)	Pharmaceutical	The office should steer a middle way
1	Technology Company or Consultancy	The office should steer a middle way
Assoc. (LES)	Patent Professional	The office should steer a middle way
1	Patent Professional	Neither hard or easy, IS either exists or not, diligent application of the law will result in the correct assessment.
2	Pharmaceutical	Tend to easy and rely on post grant remedies for invalid patents

Related comments:

“What may seem trivial may be the culmination of many years’ work and the breakthrough that allows a technology to finally become commercial.

Therefore extreme care must be taken not to fail to grant such patents.”

“My contention is that, if software is to be patentable at all, the level of inventiveness required should be set very high indeed. Otherwise it will do far more harm than good.”

“...it would preferable for patent offices to tend towards the easy rather than the hard extreme...”

“...patents should be granted only when and always when the state of the art has been enriched by the invention in that something is proposed that was outside the reach of a person of ordinary skill in the art.”

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?*

Number of respondents	Background of respondent	Explicit answers to questions
1	Individual	Innovation has been impeded by patents with little or no inventiveness
3	Software Lobby	Innovation has been impeded by patents with little or no inventiveness
2	Technology Company or Consultancy	Innovation has been impeded by patents with little or no inventiveness
Assoc. (AIPPI)	Patent Professional	Broadly speaking no complaint.
1	Pharmaceutical	Those extremes have been avoided in the UK so innovation has not been impeded.
3	Patent Professional	Those extremes have been avoided in the UK so innovation has not been impeded.
Assoc. (Marks & Clerk)	Patent Professional	Those extremes have been avoided in the UK so innovation has not been impeded.
Assoc. (TMPDF)	Patent Professional	Those extremes have been avoided in the UK so innovation has not been impeded.
Assoc. (CIPA)	Patent Professional	Those extremes have been avoided in the UK so innovation has not been impeded.
1	Technology Company or Consultancy	Those extremes have been avoided in the UK so innovation has not been impeded.
Assoc. (LES)	Patent Professional	UK has tended towards 'easy' but this has not caused significant problems.
1	Patent Professional	UK has tended towards 'easy' but this has not caused significant problems.
1	Pharmaceutical	Office seems ok, but courts too strict.
Assoc. (BIA)	Pharmaceutical	Office seems ok, but courts too strict.

Related comments:

One respondent stated that the JPEG patent, GIF patent and MP3 patent were all kept quiet and only 'monetised' when a sufficient user base had grown to deter entry for other technologies. It is not clear if these comments

are directed to the actions of UK rights holders, or the widely publicised US equivalents.

“However, we are concerned that the UK courts are applying a threshold of inventive step which is too high. More specifically, the application of the ‘obvious to try’ test by the UK courts (see, for example, the decisions in Pfizer’s Patent BL C/2/02, CIPLE v Glaxo Gp Ltd [2004] RPC 43 etc) thereby an invention may be rendered obvious, even if it displays an unexpected technical advantage, if such an invention was obvious to try in the first place.”
 “Often the issue is clouded because prior art has been missed.”

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?*

Number of respondents	Background of respondent	Explicit answers to questions
2	Technology Company or Consultancy	No change required
1	Pharmaceutical	No change required
Assoc. (CIPA)	Patent Professional	No change to IS requirement needed
1	Patent Professional	No change required, but level of common general knowledge should be revisited
Assoc. (BIA)	Pharmaceutical	More consistency between UKPO, EPO & UK
1	Pharmaceutical	More consistency between UKPO, EPO & UK Courts
Assoc. (TMPDF)	Patent Professional	UK Courts should harmonise with EPO
Assoc. (LES)	Patent Professional	No change, but bias towards ‘easy’. Improvement of 3 rd party observations would help.
Assoc. (Marks & Clerk)	Patent Professional	No change to law, though application may benefit from cautious change
Assoc. (EPI)	Patent Professional	Re-assessment of actions likely to be taken by a person skilled in the art to include those with a reasonable expectation of success would be beneficial
1	Individual	Skilled man should be imbued with a ‘normal or average level of imagination’.
Assoc. (AIPPI)	Patent Professional	Not for UKPO to make policy, but application of same law to different technological fields (such as biotech) leads to problems; a review of this would help
1	Technology	Inventive step should be made harder with

	Company or Consultancy	more thorough assessment
1	Patent Professional	UKPO should adopt problem/solution approach and abandon Windsurfer
1	Patent Professional	Inventive step should be 'tightened up'
1	Software Lobby	A working prototype should be required.
1	Software Lobby	Language of applications should be simplified
1	Technology Company or Consultancy	The language of patent applications should be changed to plain English with each sub clause of a claim representing an essential feature of the invention.

Related comments:

"...all patent applications should be more thoroughly assessed, even if the patents office needs to commission outside experts to assist in their judgment."

"Finally the patent office should use a system of external referees skilled in a particular art to check validity, especially claim 1."

"The inventive step must be shown to be and appreciated as such by not just the examiner of the UKPO but also to academics and others working within that field."

"We are concerned that the standard of inventive step as applied by the UK courts may be substantially higher than that applied by either the EPO or the UK Patent Office."

"...I would argue there is a normal or average level of imagination, which leads to a concomitant average rate of innovation. This would then mean that the inventive step requirement must be shown to significantly exceed this average innovation, which can be done by considering the person skilled in the art to have an average level of imagination."

"...an examiner remuneration system should acknowledge that it requires more work to reject an application than to allow a patent."

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)?

Number of respondents	Background of respondent	Explicit answers to questions
2	Technology Company or Consultancy	No change required
Assoc. (CIPA)	Patent Professional	No change required

Assoc. (LES)	Patent Professional	No change required
1	Pharmaceutical	European proposal too tough, should stick with present (analogous to American proposal)
Assoc. (EPI)	Patent Professional	No change necessary or useful, should concentrate on better application of current framework
Assoc. (Marks & Clerk)	Patent Professional	No change required, though proposals could be embodied in secondary legislation as non-exclusive interpretations for guidance
Assoc. (AIPPI)	Patent Professional	No change helpful, though guidelines for practice in areas like Biotech could be useful.
Assoc. (TMPDF)	Patent Professional	European proposal too vague.
1	Software Lobby	European proposal too vague.
1	Patent Professional	Time has come to align Patent Rules with Rule 27 EPC
1	Patent Professional	Matter published after the priority date but before publication should be taken into account as simultaneous invention is an indicator of a lack of inventive step.
1	Software Lobby	European proposal is acceptable
1	Pharmaceutical	European proposal not helpful, new rule to assist in interpretation of section 3 suggested (with special reference to 'obvious to try' type situations).
1	Technology Company or Consultancy	Man skilled in the art should be reassessed
1	Individual	Change should be made to allow skilled man to have imagination, and more detail added to regulatory framework to minimise the effect/role of case law.

Related comments:

"The definition of a person skilled in art is key here...the definition of person skilled in the art should reflect the high level of general knowledge of a professional with that type of experience"

"...the patent office should demand that patents be written clearly, be unambiguous and exclude/limit irrelevant detail already known in the art...Patents must be referred to independent experts for checking validity."

"I would like to see a firmly stated industrial application for the claimed patent that benefits society (maybe the provision that a patent lapses if no application of it is made within a defined time limit – a way of preventing blocking or submarine patenting)."

"We believe that in all three tests the reference should be to any items of prior art and common general knowledge (rather than or)."

“Section 1(5) gives the Secretary of State power to vary provisions as to what constitutes excluded inventions under section 1(2), that does not give the power to define what is or is not inventive.”

“...any secondary tests are a matter for practice guidance and should not be frozen in the Patents Rules.”

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?*

Number of respondents	Background of respondent	Explicit answers to questions
1	Individual	In cases where the examiner is uncertain, outside assistance should be sought
1	Technology Company or Consultancy	In cases where the examiner is uncertain, outside assistance should be sought
1	Software Lobby	If the examiner doesn't understand the invention it should be rejected
1	Technology Company or Consultancy	More rigorous application needed
1	Software Lobby	There should be a database of prior works
1	Software Lobby	Make an assessment of whether the patent solves a problem or creates one to which it is the claimed solution.
1	Patent Professional	Examiners accepting any prima facie argument for existence of an inventive step may be harmful to third parties, there should be more willingness to follow up valid objections.
Assoc. (AIPPI)	Patent Professional	UKPO must follow UK law, though perhaps needs to be more willing to consider a step from the prior art 'obvious to try'
Assoc. (CIPA)	Patent Professional	No change required, but applicants should be given benefit of any credible doubt
Assoc. (Marks & Clerk)	Patent Professional	No change required
Assoc. (LES)	Patent Professional	Problem is not in how examiners apply procedures, but how they derive the 'evidence' (i.e. search is less exhaustive pre-grant than those used before court proceedings)
Assoc.	Patent	No change required

(TMPDF)	Professional	
Assoc. (EPI)	Patent Professional	No change required, just more rigorous application
2	Technology Company or Consultancy	No change required.
1	Patent Professional	Problem solution approach from EPO would be beneficial
1	Pharmaceutical	EPO technical problem approach should be used.
1	Patent Professional	Different methods could be used to ascertain how easy it is to come up with the claimed solution given the problem, i.e. the examiner could be set the problem and asked to solve it with no knowledge of the invention.
1	Pharmaceutical	In antibody cases (Pharmaceutical) the value of the products should be recognised and the idea that routine technology is used to lead to an inevitable result should be avoided.

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?*

Number of respondents	Background of respondent	Explicit answers to questions
2	Technology Company or Consultancy	Yes
1	Pharmaceutical	Yes
Assoc. (CIPA)	Patent Professional	Yes
Assoc. (LES)	Patent Professional	Yes
Assoc. (AIPPI)	Patent Professional	Yes
1	Patent Professional	Yes
1	Pharmaceutical	Not always, use of 'boilerplate' or barebones objections sometimes evident.
Assoc. (TMPDF)	Patent Professional	First exam sometimes contains too little explanation of objections
Assoc. (Marks & Clerk)	Patent Professional	First exam sometimes contains too little explanation of objections
1	Patent Professional	Examiners sometimes merely raise the objection, should engage more thoroughly and cross examiner arguments from applicant

1	Software Lobby	No
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Related comments:

"I have been content with the approach of the UK patent office, and my remarks are more directed to the theoretical basis of the work done, than on the quality of the UK examination, which I consider to be excellent."

"A fully justified obviousness objection can be of great assistance to the applicant in the long run and can help to hold down costs."

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

Number of respondents	Background of respondent	Explicit answers to questions
Assoc. (CIPA)	Patent Professional	Yes
Assoc. (LES)	Patent Professional	Yes
Assoc. (AIPPI)	Patent Professional	Yes
2	Technology Company or Consultancy	Yes
2	Pharmaceutical	Yes
Assoc. (Marks & Clerk)	Patent Professional	Yes
2	Patent Professional	Yes
Assoc. (TMPDF)	Patent Professional	The Office should give the benefit of any genuine doubt to the applicant and within this constraint we believe fair consideration is given
1	Individual	Too much consideration given to applicant as pre-grant proceedings are uncontested

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?*

Number of respondents	Background of respondent	Explicit answers to questions
1	Technology Company or Consultancy	When adopting the view of the skilled man, examiners should actually consult with a man skilled in a particular art.

1	Software Lobby	Patents seem to be awarded on “if we get it wrong the courts will sort it out” but the courts rule on “if the PO awarded, then we assume they think it valid. Prove otherwise.”
1	Software Lobby	If there is any doubt, the application should fail.
1	Individual	If there is any doubt, the application should fail.
1	Pharmaceutical	Onus should be on the UKPO to show a lack of IS, rather than the applicant to show the presence of IS.

Related comments:

“There seems to be little or no analysis in some cases of how or why particular documents would combine to give the invention. More detailed objections will lead to more focussed responses, with all round benefit.”

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?

Number of respondents	Background of respondent	Explicit answers to questions
Assoc. (AIPPI)	Patent Professional	Yes, fair and consistent
1	Pharmaceutical	Yes, generally fair and consistent
Assoc. (Marks & Clerk)	Patent Professional	Consistency more evident in mature technologies, but examiners try to take a sensible approach in developing fields.
1	Technology Company or Consultancy	Examiner’s expertise with CII and quality of prior art examinations (searching) have improved over time, otherwise consistent.
Assoc. (LES)	Patent Professional	IS has become slightly stricter recently, but private applicants appear to receive more lenient treatment.
1	Individual	Some lack of consistency.
1	Technology Company or Consultancy	Some lack of consistency.
Assoc. (CIPA)	Patent Professional	Some lack of consistency across different technologies
1	Patent Professional	Potential for inconsistency where examiners accept prima facie arguments against IS objections without cross examination
1	Pharmaceutical	Antibody claims treated inconsistently
1	Software	No, new technology moves much faster and

	Lobby	obsolescence of an idea arrives before the patent expires, unfair.
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Related comment:

“As stated, I am unqualified to answer this question having had no direct contact with the patents office. I should imagine that it would be impossible to absolutely consistent given the rapid changes in certain areas of technology over the last three decades.”

“There is potential for inconsistency where examiners are liable to accept any prima facie argument for the existence of inventive step without the cross examination of such arguments”

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?*

Number of respondents	Background of respondent	Explicit answers to questions
2	Technology Company or Consultancy	Yes
Assoc. (AIPPI)	Patent Professional	Yes
Assoc. (CIPA)	Patent Professional	Broadly, yes
Assoc. (Marks & Clerk)	Patent Professional	Broadly, yes
Assoc. (TMPDF)	Patent Professional	Quality of search is critical, UK courts applying higher standard than that used by EPO to assess EP(GB) patents
1	Pharmaceutical	Level of granted patents appropriate, but courts setting too high a hurdle
1	Pharmaceutical	There is concern that IS requirement for antibodies may deny valuable protection to innovators in Europe.
Assoc. (LES)	Patent Professional	Level not entirely appropriate, too strict in some regards
1	Individual	Third parties not fully represented as pre-grant is effectively uncontested
1	Technology Company or Consultancy	Level too low, trivial patents being granted.
1	Software Lobby	The public are often given nothing for the promise not to infringe on the patent
1	Software Lobby	There can be no inventive step in regard to software

Related comments:

“The interests of patentees and third parties should be assessed objectively by using external experts.”

“The interests of all parties could be more fairly balanced if the application for a patent was published, in relevant publications, some time prior to the actual assessment...”

“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.”

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

Number of respondents	Background of respondent	Explicit answers to questions
Assoc. (CIPA)	Patent Professional	UKPO practice is probably at least as good as that in any other Patent Office. It can be tougher than the USA. It is not as tough as that in the Scandinavian countries.
1	Technology Company or Consultancy	UK examiners are pragmatic and knowledgeable. EP and US examiners are often ignorant and obtuse.
1	Pharmaceutical	For antibody inventions it is possible to get narrow protection in the US, but none in the UK.
Assoc. (TMPDF)	Patent Professional	Problem/solution too rigid, USPTO and JPO different but due to substantive differences in law.
1	Patent Professional	No evidence as to differing levels, research would be useful.
Assoc. (LES)	Patent Professional	IS applied less rigorously than USA, EPO and Japan.
1	Technology Company or Consultancy	EPO and other European offices generally come to same result, even if by different routes.
Assoc. (Marks & Clerk)	Patent Professional	UK examiners deal with IS in a 'common sense' manner. EPO analysis sometimes too rigid. Result of different methodologies often similar
Assoc. (AIPPI)	Patent Professional	UK easier to overcome than EPO
1	Individual	The inventive step appears to be even lower in the USA
1	Technology Company or Consultancy	The inventive step appears to be even lower in the USA
1	Technology Company or	There is evidence that both the USPTO and EPO are approving trivial patents in the same

	Consultancy	way as the UK office.
1	Software Lobby	UKPO more rigid in approach than EPO
1	Software Lobby	Practice better than US, but bad in absolute terms

Related comments:

“On a largely subjective basis, and just listing patent offices of which we have some experience, we would say the Australian and South Korean level is about the same as the British level, that the European Patent Office level is slightly higher, that the level in the Netherlands, Japan, Germany, Thailand and Taiwan is somewhat higher and that the level in Austria and Canada is somewhat lower. The level in the United States is very variable and is also judged on somewhat different criteria when two or more documents are considered as prior art.”

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

Number of respondents	Background of respondent	Explicit answers to questions
Assoc. (CIPA)	Patent Professional	Cost of contested proceedings should be reduced, otherwise allow harmonisation to happen by evolution
1	Technology Company or Consultancy	Long may it continue as it is.
Assoc. (Marks & Clerk)	Patent Professional	Office should always give benefit of doubt to applicant, and concentrate on improving searching.
Assoc. (LES)	Patent Professional	Better (online) file inspection and pre-grant opposition would help assist third party observations and improve the system.
1	Pharmaceutical	UKPO should err on the side of leniency, and accept that innovation may be found in the identification of antibodies.
1	Software Lobby	Applicant should be forced to identify the inventive step and the problem it solves (with benefits, industrial application etc).
1	Individual	Language should be standardised to remove jargon
1	Technology Company or Consultancy	Office should take a tougher line.
1	Software Lobby	The UKPO is exceeding its remit and seeking to innovate methods of expanding its universe without due concern to users and country. In regard to software there is no inventive step

		as such because it is a set of instructions given by the manufacturer of the microprocessor or microcontroller
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Related comments:

“Whatever criticism may be levelled in individual cases, we are persuaded that the UK standards are as good as any, and better than some.”

Annex B - Further information regarding respondents

AIPPI – International Association for the Protection of Intellectual Property. AIPPI UK has some 300 members drawn from practitioners, academics and owners of intellectual property and is the UK arm of AIPPI.

CIPA – Chartered Institute of Patent Agents. CIPA represent the majority of qualified and registered patent agents in the United Kingdom. Members may be employed in private practice or in specific industrial enterprises (working in-house).

EPI – Institute of Professional representatives before the European Patent Office. The EPI is a professional organisation representing European patent attorneys, with 8000 members in the various member states.

LES – Licensing Executives Society. LES Britain and Ireland is the local chapter of the Licensing Executives Society International (LESI). LESI is an association of licensing and technology transfer professionals with over 11,000 members worldwide. Members include business people, lawyers, accountants, patent agents and academics from a broad range of industrial sectors. LES Britain and Ireland has over 600 members locally.

Marks & Clerk – Marks & Clerk is firm of Patent and Trademark attorneys with experience in all fields of UK patent prosecution. As well as prosecuting patent applications at the UK Patent Office on behalf of clients, they also advise clients on the validity of granted UK patents.

TMPDF – Trade Marks Patents and Designs Federation. The TMPDF is a pan-industry intellectual property trade association established to represent member companies nationally and internationally.

Annex C - Individuals and organisations which were initially sent this consultation document

Copies of this consultation document have been sent 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

ABPI Frank B Dehn
ACID Freshfields
Agricultural Engineers Association Gallafent & Co
Allvoice Gill Jennings & Every
Arnander Irvine & Zietman Harbottle & Lewis
Ashurst Morris Crisp HM Treasury
Association Of British Insurers Home Office
AURIL Intellectual Property Advisory Committee members
Babcock International Limited Intellectual Property and Innovation Directorate
Baker & Mckenzie Inventorslink Inc
Berwin Leighton Linklaters & Paines
Bharat Electronics Limited Linux User Magazine
Bioindustry Association Litigation Focus Group members
Biotechnology and BSRC Lovells
BLWA Magister Limited
Boult Wade Tennant Marketforce Communications
British Association Representing Breeders Marks & Clerk
British Generics Manufacturers Association Limited Medical Research Council
Technology
British Library Mewburn Ellis
British Potato Council Ministry Of Defence
British Poultry & Meat Federation NASPM
Cardiff Law School NI Court Service
Chemical Industries Association Norton Rose
International Maize and Wheat Improvement Center (CIMMYT) Olswang
Compassion in World Farming Pfizer Limited
Conde Limited Pilkington Technology Centre
Council on Tribunals Preventative Medicines Tech Inc.
Crafts Council Processors & Growers Research Association
Cranfield University RWS Group
Crop Protection Association Scottish Executive Justice Dept
Cruikshank & Fairweather SIBLE University Of Sheffield
DEFRA Simmons & Simmons
Department for Constitutional Affairs Society of Motor Manufacturers and
Traders
Department for Culture, Media and Sport Society Of Numismatic Artists &
Designers
DTI (BRCII1) Software Focus Group members
DTI (BRCII2) The British Society Of Plant Breeders Limited
DTI (BRCII5) The Centre of Research for Intellectual Property and
Technology (SCRIPT)
DTI (BRCII7) UKASTA (Scottish Council)
DTI (CCP4) UKASTA Ltd

DTI (Consumer Goods Unit) UKREP – Foreign and Commonwealth Office
DTI (EWT) University of Alicante
EC Laws Committee - LES Britain & Ireland University of Cambridge
Enforcement Focus Group members University of Oxford
Eureka Manufacturing Co. Limited Visteon Global Technologies
Federation Of The Electronics Industry
Gallafent & Co
Gill Jennings & Every
Harbottle & Lewis
HM Treasury
Home Office
Intellectual Property Advisory Committee members
Intellectual Property and Innovation Directorate
Inventorslink Inc
Linklaters & Paines
Linux User Magazine
Litigation Focus Group members
Lovells
Magister Limited
Marketforce Communications
Marks & Clerk
Medical Research Council Technology
Mewburn Ellis
Ministry Of Defence
NASPM
NI Court Service
Norton Rose
Olswang
Pfizer Limited
Pilkington Technology Centre
Preventative Medicines Tech Inc.
Processors & Growers Research Association
RWS Group
Scottish Executive Justice Dept
SIBLE University Of Sheffield
Simmons & Simmons
Society of Motor Manufacturers and Traders
Society Of Numismatic Artists & Designers
Software Focus Group members
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UKASTA Ltd
UKREP – Foreign and Commonwealth Office
University Of Alicante
University Of Cambridge
University Of Oxford
University of Strathclyde
Visteon Global Technologies