

# **COMMENTS TO THE PROBLEM-SOLUTION APPROACH**

by Dr. József MARKÓ

## **1. INTRODUCTION**

It is obvious that the evaluation of the inventive step requirement is one of the most difficult and complex tasks in the patent practice, because this value judgement is established upon a fine balance of legal fictions and probabilities.

A few tests for more objective assessment of inventive step have been developed in the last decades, among others the so-called "Problem-Solution Approach" which is applied in the proceedings in the EPO)

## **2. THE PROBLEM-SOLUTION TEST**

It comprises three main steps:

- (1) determining the closest prior art;
- (2) establishing the technical problem to be solved, and
- (3) considering whether or not the claimed invention, starting from the closest prior art (1) and the technical problem (2), would have been obvious to the skilled person.

Mr. G. Knesch (EPO-DG2) published a remarkable article (in EPI Information No. 3/94) stating a. o. that the problem-solution approach "is now generally applied" in the EPO, so this approach is used as a "standard method for assessing inventive step", that is applicable to all cases. On the other hand, in his view "the basic consideration is that every invention is the solution to a technical problem..." and referred in this respect to Rule 27 (1)(C) EPC.

## **3. REMARKS AND OTHER ASPECTS**

I think these statements are to be reconsidered in view of the followings:

- EPC Rule 27 (1) (C) contains provisions to the formulation of the description only, but, I am afraid, these provisions cannot provide legal basis for assessment of the inventive step requirement under Art.56 EPC,

as well as for the "problem-solution approach". According to this rule the description shall disclose the claimed invention in terms such that the technical problem and its solution can be understood.

- Mr. R. Jehan (GB) pointed out in his article (in EPI Information No. 2/95) that the problem-solution test tried to set additional patentability requirements (selecting the closest prior art, determining the objective technical problem to be solved) which cannot be accepted.
- The former chairman of EPO-Board of Appeal, G. Szabó noted in his paper (in EPI Information No. 1/95), that the "ex post facto" analysis is to be avoided, but sometimes it is not too easy, because the objective problem has to be defined - when using the problem-solution test after the most relevant prior art is identified by the differences between the claimed subject matter and the most relevant art, that is, in the knowledge of the invention.
- A further aspect of this issue is that there are inventions, which have not any relevant prior art, at all, so the first step of the problem-solution test cannot be performed. In this respect I would refer to the so-called "pioneer inventions". Furthermore, what could I do with the second step in such a case, according to which I should have to formulate a sophisticated technical problem, on the basis of the differences between the claimed subject matter and a non-existing relevant prior art, but it seems to be a nonsense. I believe that in these cases the problem-solution test cannot be used.
- In an article of Mr. F. Hagel and C. Menes (FR) (published in EPI Information No, 1/95) it is pointed out that in the chemical field a novel product, such as a new molecule can be protected per se. Product inventions can be described as inventions of pure structure, that is, they are solutions without any problems. So the problem-solution approach is not suitable for this category.

Finally, I would call your attention to a very interesting decision (No. T465/92) of the Technical Board of EPO, with the following head note:

*"The problem and solution approach is no more than one possible route for the assessment of inventiveness. Accordingly, its use it not a sine qua non when deciding inventiveness under Art.56 EPC."*

In the reasoning the board made it clear that no legal basis for imposing on the organs of EPO one particular method for the assessment of inventive step under Art.56 EPC, which article had left the methods open.

In the given case 7 references were cited by the opponent, they represented different solutions to exactly the same problem as that solved by the patent. So the board decided to avoid the use of the problem-solution analysis in this case, saying that

*"...the investigation of inventiveness should avoid formulating artificial and unrealistic technical problems, and should normally start from the technical problem identified in the patent in suit."*

### 3. CONCLUSION

Summing up, it must be admitted that the "Problem-Solution Test" is one of the well proved methods for assessment of the inventive step requirement in many cases, but I also think that its fetishism would be a mistake.

That is why I like the discussed decision of the EPO-Board very much.

#### **References & Notes:**

- 1) *Guidelines for Examination in the EPO;*
  - 2) *G. Knesch: Assessing Inventive Step in Examination and Opposition Proceedings in the EPO (EPI Information 3/1994);*
  - 3) *R. Jehan: The Problem and Solution Test in the Assessment of Inventive Step (EPI Information 2/1995);*
  - 4) *G. S. A. Szabó: Clarifying Addendum to the Problem-Solution Approach (EPI Information 1/1995);*
  - 5) *F. Hagel and C. Menes: Making Proper Use of the Problem-Solution Approach (EPI Information 1/1995);*
- *Presented by the Author at the Patent Workshop of the UNION Congress in Porto Hydra (GR), May 24, 1996;*
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