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The problem with the problem – or: the difficulty to evaluate Inventive Step

Thorsten Bausch (Hoffmann Eitle) · Thursday, June 6th, 2013

One of the big difficulties in the everyday evaluation of inventive step revolves around the role that the problem underlying the invention should play in such evaluation. Two examples of more recent decisions of the German Federal Court of Justice are provided here to illustrate “the problem”.

In its decision Kosmetisches Sonnenschutzmittel III (X ZR 72/08), discussed here, the Federal Court of Justice (FCJ) decided that the „Problem“ derivable from the description of the patent in suit is not the sole starting point for the evaluation of inventive step; rather must it also be considered whether the solution of any (another) problem with which the skilled person would usually be entrusted would have rendered its solution obvious. In the case at stake the FCJ confirmed the revocation of a patent directed to a cosmetic sunscreen composition containing two components A and B which, together, provided an arguably unexpected synergistic effect. The FCJ found that the invention was nevertheless obvious, since the skilled person was motivated to at least try out such a combination for other reasons. The problem stated in the description is only a starting point for the evaluation of inventive step, but it has to be checked whether it actually reflects the technical problem underlying the invention correctly. Moreover, even a correctly stated problem is not necessarily the only consideration which can be used to evaluate inventive step, rather it is also necessary to consider whether the tackling of a (different) problem associated with the (routine) tasks of the expert rendered its solution obvious. On the whole, it might appear from this decision that the impact of the problem underlying the invention on the evaluation of inventive step is quite limited.

However, a more recent decision by the Federal Court of Justice “Trenn-Erderschalter” (X ZR 160/11) seems to assign a more prominent role to the problem underlying the invention. The invention at stake related to a combined disconnector and earthing switch for a high voltage switchgear assembly. Core of the invention was a moving, sliding contact piece in a T-shape casing, with the movement path of the sliding contact piece running at an angle alpha to the first and second inner conductor. Parallel high voltage switchgear assemblies containing a movable, sliding contact piece which was arranged perpendicular to the parallel conductors were known. T-shape high voltage switchgear assemblies were also known, but contained a rotary contact piece. However, such rotary switches consumed relatively much space. The problem underlying the invention was therefore defined to provide a simple and space-saving construction for such a high voltage switchgear solution.

The FCJ confirmed the decision of the first instance and affirmed novelty and inventive step. The

court held that there was no motivation for a skilled person to replace the rotary switch by the known linear switch containing a movable, sliding contact piece in perpendicular direction, since he would have expected this to be impossible in a T-shape casing. The fact alone that both types of switches and casings, respectively, were known to the skilled person does not provide a sufficient motivation to replace one type by the other.

Nullity plaintiff further argued that a motivation for using movable, sliding switches resulted from the known fact that they would allow to conduct higher electric currents. The FCJ, however, dismissed this argument briefly, arguing that "the skilled person did not obtain a *sufficiently concrete motivation* to solve the problems associated with sliding high voltage switches as discussed above in the way realized by the patent in suit".

Unfortunately, the FCJ did not discuss in its decision whether the fact that an advantage of linear switches was known (conducting higher currents) might have motivated the skilled person to go one step further and to modify the existing linear switches that were in perpendicular direction to the two conductors, by placing them in an angular, oblique direction to the conductors. Then he would have arrived at the invention. So it seems that the definition of the problem in the patent, i.e. to provide a space-saving solution, played quite an important role for the confirmation of inventive step, in that it excluded the known perpendicular arrangement of sliding switches and provided an advantage over the known rotary switches. So it seems that the problem of how to correctly define the problem might still sometimes decide your case on inventive step.

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