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Hope or no hope in inventive step, that is the question

Gemma Wooden, Matthew Blaseby, Derk Visser (EIP) · Tuesday, December 24th, 2019

One of the key questions in the assessment of inventive step within the EPO is whether or not the skilled person will adapt or modify the teaching of the closest prior art and arrive at the invention. The EPO answers this question using the so-called could-would approach developed in the early decision T2/83 of a technical board of appeal. Until recently, the Guidelines for examination in the EPO summarised the could-would approach as follows (see Guidelines 2018 G-VII, 5.3):

"In other words, the point is not whether the skilled person could have arrived at the invention by adapting or modifying the closest prior art, but whether he would have done so because the prior art incited him to do so in the hope of solving the objective technical problem or in expectation of some improvement or advantage (see T 2/83)."

The book Case Law of the Boards of Appeal of the EPO used the same summary of T2/83 as the Guidelines, also using 'hope' (see chapter I.D.5 in the July 2016 edition). However, the word 'hope' does not occur in T2/83.

The usual interpretation of T2/83 is that the skilled person must have a reasonable expectation of success to arrive at the invention, otherwise he will not adapt or modify the closest prior art. If he does have such a reasonable expectation of success and he does arrive at the invention, the invention is obvious within the meaning of Article 56 EPC. The reasonable expectation must be based on technical reasons.

The above-cited passage of the Guidelines suggests that 'hope of solving the objective technical problem' is an alternative to 'expectation of some improvement or advantage'. Hence, an invention should also be obvious if the skilled person hopes to solve the objective technical problem when adapting or modifying the closest prior art.

However, 'hope' should not be confused with a reasonable expectation of success, according to EPO case law. Using 'hope', an examiner could argue that an invention is obvious, because the skilled person would adapt the closest prior art in the mere hope of success, without giving technical reasons why he would adapt the closest prior art. Such an approach would undermine the inventive step assessment in the EPO.

In October 2017 Gemma Wooden, Matthew Blaseby and Derk Visser, all of EIP, London, wrote an article 'A hope to succeed' in the Journal of Intellectual Property Law & Practice, 2017, Vol. 12, No. 12, page 959, setting out the above problem of 'hope' in the inventive step assessment.

The authors approached the editors of the Guidelines and of the Case Law book with the request to revise the summary of T2/83 in the could-would approach.

In the latest edition of the Case Law book of July 2019 the EPO has removed ‘hope’ from the could-would approach (see chapter I.D.5 in the July 2019 edition). Similarly, the November 2019 edition of the Guidelines also deleted ‘hope’ from the could-would approach (see G-VII, 5.3).

An EPO examiner must now show that the skilled person has a reasonable expectation of some improvement or advantage by giving technical reasons. He cannot anymore refer to the hope of the skilled person and refrain from giving technical reasons.

The same three authors have recently published a second article on the topic to show that the hope has disappeared from the could-would approach. See ‘There is no hope in inventive step’ Journal of Intellectual Property Law & Practice, 2019.

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