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Inventive step at the UPC – much ado about nothing (new)?

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One of the most highly debated issues at the UPC before its commencement was the question, how the UPC would deal with validity of patents – would it essentially take over the EPO's course? Or would it deviate from that?

From the first judgments, many commentators drew the conclusion that at least when it comes to inventive step, the UPC would take a different approach than the EPO (cf e.g. here, here, here and also here).

However, there seems to be disagreement about exactly what this different approach looks like. Some commentators believe that the UPC is taking the German approach, while others have left this open. This does not really help in practice when faced with the task of assessing whether the patent in question is sufficiently legally valid or whether it will be declared invalid due to inventive step in the event of a possible patent infringement.

Frankly speaking: I beg to differ. If you try to assess the validity of a given patent against an attack on inventive step, an application of the 'problem-solution' approach is still the best option and will probably remain so.

How do I arrive at this conclusion? For four different reasons:

First, Klaus Grabinski, President of the UPC, confirmed that he does not see any fundamental difference between the approach of the EPO and the UPC – at least that is what he said in his presentation on 16 December 2024 at the Düsseldorf Industrieclub, where I was in the audience.

Dr Grabinski explained that, in his opinion, the perception of possible differences was mainly due to the fact that the EPO assesses inventive step 'proactively', whereas the UPC always assesses it 'retroactively'. Whereas the EPO, according to Grabinski, has to assess inventive step in examination proceedings, where the scope of protection of a patent has not yet been determined and where (only) an examining division is involved in the application, in proceedings before the UPC there is always a defendant, who naturally has to put all possible attacks on the table right at the beginning due to the 'front-loaded approach' of proceedings before the UPC.

(Of course, at this point I immediately remembered that the EPO also has opposition proceedings, where a two-sided 'retroactive' and to some extent front-loaded examination also takes place, and that important EPO decisions concerning inventive step were taken in opposition proceedings. But who am I to criticise one of the most brilliant and – as I can confirm from my own experience –

nicest person in intellectual property worldwide?)

Second, the "problem-solution" approach needs a closer look.

This approach was developed in order to somehow get to grips with the problem of inventive step, which had been a problem for a long time – to quote from the New Yorker ("*The Flash of Genius*", Article by John Seabrook, 3 January 1993"), which tackles the problem from an US perspective:

"The Doctrine of Nonobviousness is the current solution to the problem that confounded Jefferson: how to define invention. Over the last two centuries, many people have tried to define it. Learned Hand, whom patent lawyers revere as one of the great patent judges of all time, wrote that the definition of invention was "as fugitive, impalpable, wayward, and vague a phantom as exists in the whole paraphernalia of legal concepts." The 1929 edition of "Walker on Patents," the standard patent textbook, stated, "What constitutes invention is a very perplexing question." In 1937, this was revised to read "An invention is the result of an inventive act." An inventive act was generally considered to be a flash of insight that comes when the inventor is not striving for it, as in the case of Nikola Tesla, who was strolling through a park in Budapest and reciting some lines from Goethe when the concept of alternating current suddenly came into his mind and he diagrammed it in the dust with a stick […] The invention story was an important part of the invention itself."

The need to find a rule-based approach was especially necessary for the European Patent Office because it initially recruited its examiners primarily from members of national patent offices and these brought with them very different traditions of how inventive step should be assessed. However, it should make no difference which nationality an examiner belonged to; applicants should be able to rely on all applications being treated equally.

This 'problem-solution approach' finally developed by the EPO is – contrary to what has often been portrayed – not a law or a commandment engraved on a stone tablet. The EPO itself has changed its practice from time to time, although this has never been stated so openly. Essentially, however, the 'problem-solution approach' is based on the following concepts:

Firstly, novelty and inventive activity are two different things. Lack of novelty is given if all integers of a claim are disclosed in a document. In the absence of inventive step, it is a matter of necessity that a document discloses many features but lacks at least one.

Lack of inventive step thus requires the combination of two documents (or the combination of a document with the common general knowledge, which, however, since this is usually also evidenced by documents, almost always amounts to the same thing in practice).

One aspect of the 'problem-solution approach' is that this 'two' is usually not read as 'at least two' – if three documents are needed to arrive at the subject-matter of a particular claim, inventive step is almost always given in practice.

However, it is also an essential basic idea of the 'problem-solution approach' that even if the features of a certain claim can be found in two documents, this does not automatically lead to a lack of inventive step. An impetus is needed for this to happen – or a pointer. Or as the Court of Appeal has put it here: *"The mere chance that the skilled person could choose [the needed feature] is insufficient for a finding of lack of inventive step."*

This is – summarized – the essence of the problem-solution approach.

However, it is important to understand that this approach is not a mathematical formula that always delivers the same result if you put in the same variables. Like all rules or approaches in the legal field, it requires interpretation, be it of documents, knowledge or the motivation of the skilled person in the art, and here, depending on who you ask, you sometimes arrive at different results.

My thesis now is that the variability within the problem-solution approach is greater than that which would result if one were to assume that the UPC chooses a different approach than the EPO.

Looking at the first substantive decision of the appeals court of the UPC (UPC_CoA_335/2023), the Court of Appeal followed exactly the approach of the first instance – except for the interpretation of a document, which then led to the inventive step no longer being assumed to be sufficiently certain. This could have happened at the EPO in exactly the same fashion.

Thus if you need to give an estimation whether your patent will survive at the UPC, there is no need to speculate about different approaches, leave that to the academics. Rather focus on what the documents teach and what the general knowledge in your technical field is, instead of asking yourself whether the UPC would require a “closest prior art” or would allow a “general overview”, especially when at the moment there is case law that supports the first or the latter .

This even more so when taking into account that some commentators (e.g. here and here) now think that the German approach is the one used by the UPC – as someone who has practised German and EPO law for quite a while now, I can confirm that when it comes to the results the differences are marginal at best. (If you do not believe me, maybe the LD Munich may convince you, cf. here on p.68)

Third, one has to take the reality into account.

There are two boundary conditions that influence the UPC (whether it likes that or not) and will not change as long as the UPCA exists:

- Firstly, the UPC is not a patent granting authority. All patents judged by the UPC were previously granted by the EPO.
- Secondly, the UPC is not the only court in Europe to rule on patent infringements. There are still the national courts – even if, in the long term, a national patent will be required to seize the national courts in a UPC member state. However, there is always an alternative to the UPC.

It follows from the first condition that the UPC can only take a stricter view of validity than the EPO if it wishes to distance itself from the case law of the EPO. Otherwise, it would amount to a game of chance for the applicants – they would have to hope that the EPO (for whatever reason) does not apply its own case law in a given patent application and once that application was granted and no opposition filed that they are then on safe territory with the UPC. Competitors, however, would surely be willing, by filing oppositions or Third-Party-Observations, to remind the EPO about its jurisdiction.

Biblically speaking, the UPC, should it want to deviate from the EPO, is in the situation of King Rehoboam, who, when asked whether he wanted to depart from the rule of his father Solomon, replied: *’ And now whereas my father did lade you with a heavy yoke, I will add to your yoke: my father hath chastised you with whips, but I will chastise you with scorpions*.” (1 Kings 12:11). This

simply because the other feasible alternative pointed out in the bible – to make the yoke more lighter – is not given.

On the other hand, it follows from the second condition that the UPC cannot actually judge more strictly than the EPO in a broad way, because it would then run the risk of the patent proprietors 'voting with their feet'. This especially until 2030, since then for classically validated patents the "opt-out" is still given.

If one reads the bible, then you can see what happened with Rehoboam – he lost his power over Israel and the two kingdoms were divided "*unto this day*". In terms of the UPC this would mean that only the unitary patents would be under the UPC jurisdiction, all other patents would be opted-out – and in the future the national patent offices will see rising numbers of applications.

If you look at the UPC, nobody there wants to suffer that tragic fate. This means that the UPC actually has no choice but to adopt the EPO's case law as a result – differences will therefore be of a semantic rather than factual nature.

Finally, the UPC has a clear incentive to use the problem-solution approach, simply because this leads to more legal certainty, in the words of the LD Munich:

"For assessing whether an invention shall be considered obvious having regard to the state of the art, the problem-solution approach developed by the European Patent Office shall primarily be applied as a tool to the extent feasible to enhance legal certainty and further align the jurisprudence of the Unified Patent Court with the jurisprudence of the European Patent Office and the Boards of Appeal."

Although not stated in that decision, it is apparent that legal certainty will increase the attractiveness of a court as a venue, so this is a final reason for the UPC to stick to the problem-solution approach.

So summarizing: As a result, using the problem-solution approach is and will be the best way to try to predict whether a patent will survive an attack for lack of inventive step.

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