

Question Q213

National Group: BRAZIL

Title: The person skilled in the art in the context of the inventive step requirement in patent law

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Representative within Working Committee: [please insert name]

Date: [please insert date]

Questions

4. The situation in the national laws:

The suggested questions will try to analyze and to understand the definition of the “person skilled in the art” in three steps: the notion of the “person”, the issue of its personal “skills” and finally the “technical field” in which these skills are exercised.

4.1) The study proposed by AIPPI starts with the consideration of the person as one of the elements of the definition of the person skilled in the art. The Groups are therefore requested to indicate if the person skilled in the art is one, or more, person. If a skilled person is a team of people, then are the team members all the same or may they be different in their various attributes, specifically if such a team may comprise persons from various disciplines or having different levels of qualifications?

The Brazilian patent Law does not present any definition of a person skilled in the art, actually a literally translation of person skilled in the art used by our national law is “*a technician in the subject matter*”.

Nevertheless, the parameter of a person skilled in the art is necessary for evaluating the inventive step of an invention and its sufficient description in the specification, according to articles 13 and 24 of the Brazilian patent Law (Law 9.279):

Art. 13 – An invention is endowed with inventive activity whenever to a technician in the matter it is not derived in an evident o obvious way from the state of the art.

Art. 24 – The specification must clearly and sufficiently describe the subject matter, so as to enable a technician in the matter to execute it, and indicate when applicable the best embodiment of execution.

It is the opinion of the Brazilian group that as for today, taking into account a strict literal interpretation of the Brazilian patent law, the term “*technician in the field*”, in principle, could be understood as a single individual. There are those who sustain the point of view that the evaluation of the inventive step is precisely in the perception of the obviousness or non-obviousness for this single person skilled in the art, taking into account, of course, the relevant prior art.

The fact of the matter is that this specific point haven’t been broadly discussed in the country and in light of the considerations of the present studies, other aspect of the issue must be addressed.

It is important to point out that the Patent Law does not provide the definition of a person skilled in the art, and does not expressly contemplate the possibility of more than one individual being a person skilled in the art for the evaluation of complex inventions, for example. However, there is no express prohibition of an evaluation by more than one person.

In the judicial process questioning the validity of a patent, the Brazilian Civil Procedural Law (Article 431 b) allows the judge assessment by more than one expert, and the parties to present more than one assistant, when the invention encompasses more than one field of technology. Case law stresses the application of such provision in order to allow the full assessment of the invention (process n° 200351015182410, 39th federal courts of Rio de Janeiro).

Thus, if the various fields of technologies encompassed by the invention requires, it would be possible for a team with capacities in different fields to evaluate the inventiveness criteria. Please refer to question 4.2.

As for other attributes of the team members, will be clear for the answer of the following questions.

4.2) Is the skilled person a real person (or team of persons) or a hypothetical person?

It is the opinion of the Brazilian group that someone skilled in the art for legal purposes is a hypothetical reference of one ordinary skilled in the art and presenting other attributes discussed in this study. Important to point out that in case of complexly inventions, this hypothetical figure would have competence in various fields of technology, which is easier translated as a team of persons.

This hypothetical reference is to be considered by the real person, i.e. by the person that will evaluate the inventive step of an invention or its sufficient description, whether during the examination or appeal procedure before the patent office, or during the expert assessment in a judicial procedure.

4.3) The person skilled in the art has to be analyzed in the frame of her/his personal capacities and attributes.

At first, it is necessary to know whether and if so to which extent this person has reasoning and/or creative capacities or if he/she has merely the capacity to perform or execute the orders or instructions from other people.

Another point that can be discussed is whether the personal attributes of the person skilled in the art are the same also for other circumstances in which the person skilled in the art may have a role, such as construction of the patent or for the consideration of the sufficiency of the disclosure in the specification, even if this last point goes beyond the scope of the present study.

Finally, the question that can be discussed is the issue of knowing if the personal attributes of the person skilled in the art are the same for different IP rights covering technical creations, like patents or utility models, species, etc., if they exist in the national law.

Few of the personal attribute of a person skilled in the art has been discussed by scholars in Brazil or even by the Brazilian patent office.

Some parameters must be taken into account:

- 1 – The analysis must be objective, i.e. it must be evaluated whether the state of the art gives all the elements that would naturally lead to the invention;
- 2 – In this sense, the teachings of the state of the art shall mention or suggest the proposed invention, or show the elements of the invention, and its combination to not lead to a unexpected technical effect;
- 3 – On the other hand, even if the invention seems to be a natural combination of the state of the art, but the same art discourages the combination or the solution proposed by the invention, inventive step must be given. In this sense, there have been cases where the Brazilian patent office positively decided in such way;
- 4 – The relevant prior art considered for the evaluation of the person skilled in the art must be close or in the same field of the invention. In other words, even if the invention seems to be the combination of teachings given by the prior art, but the prior art documents are of distant fields of technology, such “natural” combination shall be disregarded, since the main parameter that shall be taken into account is a person skilled in a specific field of the art, and not all possible fields of human knowledge;

It is the opinion of the Brazilian group that the figure of someone skilled in the art does not have to have a creative capacity, and is not to be compared to an inventor. On the other hand, is not someone that merely executes the orders from other people. Someone skilled in the art has knowledge and experience in the field of the invention and is capable of reasoning, making connections and relations between the technological aspects involved.

The same applies for analyses regarding the sufficient disclosure of the invention.

The person who drafts the specification may have a different degree of knowledge in relation to those who will appreciate the patentability. Indeed, the drafter must be careful to give all elements as possible to clearly disclose the invention, preferably including a detailed description of particular embodiments, as requested by the Brazilian law, and examples where the case may be.

Subjective skills, which are difficult to measure in an objective analysis, such as creativity, must not be considered both for inventive step and sufficient disclosure.

The epiphany effect, i.e. the proposed solution (invention) for a given problem being obvious after it is disclosed in the specification may also be avoided, if the prior art does not objectively give elements for the invention.

Regarding the personal attributes of the person skilled in the art for different IP rights covering technical creation, as mentioned above, Brazilian patent Law does not give any definition regarding the person skilled in the art (or the “technician in the subject matter”). Nevertheless, the Brazilian patent Law gives two definitions for non-evidence, depending on the type of protection sought:

For inventions, the existence of inventive step (or inventive activity, as a literal translation of our law), is defined as “*to a technician in the matter, is not derived in an **evident** or **obvious** way from the state of the art*”.

Regarding the protection for utility models, the non-evidence is defined by the law as “inventive act”, instead of inventive activity for inventions, and is present when “*for a technician in the matter, it is not derived in a **common** or **ordinary** way from the state of the art*”

Therefore, for inventions the non-evidence is defined as “*inventive activity*” versus “*inventive act*” for utility models. The differences in the terms used to define the inventiveness, **evident** v. **common**, and **obvious** v. **ordinary**, suggests that different levels of inventiveness is required for inventions and for utility models, although it is quite difficult to objectively measure such different degrees of inventiveness.

4.4) Another important aspect of the question is to know what are the personal skills of the “person skilled in the art”?

At least, two important issues deserve to be analyzed:

- What is the level of the qualification or skills of the person?
- And what are the nature and the scope of his/her knowledge?

The second issue encompasses more precisely the question of the capacity to understand and to analyze the documents which are accessible to the person skilled in the art, this capacity being called “the general knowledge” and concerns the proof of the content of the “general knowledge”:

- a) what is the scope of such knowledge in general terms?
- b) is such knowledge limited to the general technical training of such person?
- c) to what extent is information in documents – articles or prior patents - considered to be included as part of such working knowledge?
- d) can such knowledge include information which the person may not have memorized, but can readily look up?

- **What is the level of the qualification or skills of the person?**

Brazilian authors mainly agree that someone skilled in the art is:

- 1 – graduated or operate in the same field of the invention under analysis;
- 2 – with *average* knowledge and skills in the same field of the invention under analysis;
- 3 – is not a specialist or a highly graduated individual in that field.

In summary, someone skilled in the art is one with ordinary knowledge in the field of the invention.

The Brazilian PTO also does not provide any definition regarding the person skilled in the art, but its examination directives merely recites the articles 13 and 24 of our patent law.

On the other hand, also in its examination directives¹, the Brazilian PTO brings some examples of what may be considered not to involve an inventive step (i.e., the obviousness of an “invention” for a person skilled in the art) and what may be considered non-obvious, such as:

Obviousness:

¹ Examination Directives of the Brazilian PTO – available at http://www.inpi.gov.br/menu-esquerdo/patente/pasta_manual. Accessed on February 2010.

- Change of materials or election of a new material with known mechanical properties;
- Change of form and/or proportions of a product;
- The mere juxtaposition of known means of a process or product.

Non-obviousness:

- Comparative data of the invention in relation the state of the art, showing the superior or better technical effect of the invention, or the solution for a given problem;
- The solution proposed by the invention is not common for the ordinary skills of a person skilled in the art;
- The commercial success of the invention due to its technical character (and not only due to a good marketing campaign).

Thus, the Brazilian PTO directives seem to be of commonsense that the person skilled in the art has ordinary knowledge in the field of the invention.

Of course, the complexity of the inventions may vary, and the skills or the person skilled in the art may also vary. Therefore, the evaluation shall be done taking into account the ordinary skills for a person who works or has a degree in such field of the problem, and whether the state of the art already discloses, suggests or mentions the solution for the problem.

- **And what is the nature and the scope of his/her knowledge.**

As mentioned above, the nature and scope of the knowledge must be taken into account based on the complexity of the given problem and the solution proposed.

For simpler kinds of inventions, it would not be necessary the evaluation by an engineer, maybe an ordinary technician without college would be able to evaluate to non-evidence of an invention. For other more complex technologies, it is expected that

the obviousness is evaluated by a person with certain degree to understand the problem and solution involved in the invention.

As mentioned in answer to question 4.3, it is the opinion of the Brazilian group that the figure of someone skilled in the art has knowledge and experience in the field of the invention and is capable of reasoning, making connections and relations between the technological aspects involved.

In this sense, the one skilled in the art could have access and consult the prior art, without haven to know it by heart, and evaluate if is there any lesson or indication of the technical aspect under evaluation.

Therefore, the evaluation shall be done taking into account the ordinary skills for a person who works or has a degree in such field of the problem, and whether the state of the art already discloses, suggests or mentions the solution for the problem.

4.5) The question of the person skilled in the art raises also the problem of the moment of the evaluation of those skills: should they be all evaluated at the moment of the appreciation of the validity of the patent, i.e. at the moment of the priority date, or could they be evaluated also at the date when the patent is assessed by the Judge, for example in the infringement proceedings, where the validity can be debated jointly with the infringement claim? This may conduct to the differences of appreciation in case the notion of the equivalence is used in relation to the prior art.

As a rule, and according to the Brazilian patent Law, the moment of evaluation to be considered is that of when the application or the priority claimed was filed:

Art. 13 – An invention is endowed with inventive activity whenever to a technician in the matter, is not derived in an evident o obvious way from the state of the art.

Art. 11 – (...)

§ 1º - The state of the art consists of everything that became accessible to the public prior to the filing date of the patent application, [or of the claimed] by means of written or oral descriptions, by use or any other means, in Brazil or abroad (...)

So, it must be taken into account that the ordinary skills of someone skilled in the art at the time the application or the priority claimed was filed, and as mentioned above, the analysis of non-evidence shall be objective based on the teachings of the state of the art, and if such teachings would lead to the completion of the invention.

4.6) The next issue related to the definition to the person skilled in the art is the technical domain or "the art" in which his or her skills are performed.

The first sub-question is to know if those skills are concentrated in one or several technical fields.

And the second one is related to the way the frontiers between different technical fields can be established: how this determination is assessed by the Judges or Patent Offices?

In principle, the technical domain of the person skilled in the art shall be determined by the problem and solution (invention) under evaluation. Therefore, the field of knowledge shall be the one where the solution is being applied, and of course, the surrounding fields encompassing the main field of that solution, as it is natural in the technical fields, e.g. a chemical engineering does not study only chemistry, but also the mechanical properties of materials, calculus, geometry, thermodynamics etc.

The technical field, in principle, could be determined in the same way it is academically organized – inventions related to engineering, the person skilled in the art shall be an engineer; in biotech, biologists or geneticists etc.

Indeed, in some specific kind of complex inventions, several fields may be involved. The questions whether such kind of inventions shall be analyzed by more than one person skilled in the art is discussed in answer to question 4.1.

4.7) The question is also to know what is the nature of his/her competence in the technical field and particularly if this competence theoretical or practical?

The law does not provide any element that would determine whether the person skilled in the art would have only theoretical or practical technical knowledge, or even both.

It is the opinion of the Brazilian group that the hypothetical figure of one skilled in the art would have theoretical and practical technical knowledge, such as to allow the complete assessment of the invention. Thus, it is a case dependent definition.

As discussed above, this hypothetical reference is to be considered by the real person, i.e. by the person that will evaluate the inventive step of an invention or its sufficient description, whether during the examination or appeal procedure before the patent office, or during the expert assessment in a judicial procedure.

4.8) The Groups are requested to indicate how in practice the assessment of the skills of the person skilled in the art is operated. What is the role of the opinion of the experts on this point?

It is the opinion of the Brazilian group that the one skilled in the art, as mentioned above is the one with ordinary knowledge in the field of the invention, who works or has a degree in such field, which shall be determined by the problem and solution (invention) under evaluation.

This hypothetical reference is to be considered by the real person, i.e. by the person that will evaluate the inventive step of an invention or its sufficient description, is basically taken as a minimum and also maximum parameter for the evaluation.

The experts, as the real person evaluating the patentability requirement shall act the same way – referring to this hypothetical parameter in order to achieve the proper conclusion.

4.9) Finally, the Groups are also invited to present all other questions which may appear in the context of the question of the person skilled in the art.

5) Future harmonization:

After assessing the national solutions, the Groups are invited to present their proposals for the possible harmonization and specifically the harmonized definition of the person skilled in the art. The object of this section is not to repeat all the questions related to the current statute of the national law, but to find the most fundamental points on which the international harmonization could be sought.

- 1) Specifically, the Groups are invited to precise on which points they see the particular need of the international harmonization on the issue of the person skilled in the art.
- 2) The Groups may indicate if the “person skilled in the art” standard should be assessed as a hypothetical model or on the contrary appreciated in concreto?
- 3) Should the skills of the “person skilled in the art” be only to execute other person orders or should they be creative and both practical and theoretical?
- 4) Should the art in which the skilled person intervene be of only one discipline, or should it cover several technical fields?
- 5) The Groups are also invited to present all other suggestions which may appear in the context of the possible international harmonization of the definition of the person skilled in the art.

Note: It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.

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