

## How Inventive Must a Patentable Invention Be?

### It depends on where you are!

A basic requirement of a valid patent is that the invention involve an inventive step over previous knowledge (known as the "prior art"). That is, the invention must not have been obvious to the skilled worker in the relevant art given that previous knowledge. However, applying this tenet to particular circumstances so as to fairly reward innovation has often proved to be difficult. Rather inevitably then, a variety of pre-requisites (for inventiveness), tests and practices have now emerged around the world. This article looks at the "obviousness" laws in Australia and the United States.

As indicated above, assessing inventiveness requires a consideration of whether the invention embodies an inventive step or, in other words, is "non-obvious" over previous knowledge. The exact nature of this previous knowledge and the approach to how inventiveness should be assessed in the light of that knowledge, have been points of considerable recent debate. That is, just what information is the skilled worker expected to consult and/or be knowledgeable of when working in the relevant art of the invention? More particularly, should every possible document forming the prior art be considered, or is it only those documents from sources that the skilled worker would ordinarily be likely to consult that are relevant? Further, if the invention provides a

solution to a particular problem, should the skilled worker be aware of that problem and have known what they would have done had they been actually asked to solve the problem?

These questions have recently been addressed by the highest courts in Australia and the United States; the High Court of Australia decision in *Lockwood Security Products Pty Ltd v Doric Products Pty Ltd* (2007) 235 ALR 202 ("*Lockwood*"), and the United States Supreme Court decision in *KSR International Co v Teleflex Inc* (30 April 2007) ("*KSR*"). Notably, the two courts came to quite different conclusions.

In *Lockwood*, the High Court first confirmed previous decisions that in considering the question of whether an invention involves an inventive step, the patentee need only show that there was a "scintilla of invention" or that some barrier was crossed or some difficulty overcome. Secondly, the High Court expressed the view that the so-called "problem solution" approach to the question (wherein a technical problem over the closest prior art information is initially identified and then a consideration is made as to whether the claimed solution (i.e. the invention) would have been obvious to the skilled worker), favoured in Europe, was overly harsh, especially in relation to inventions involving combinations of known components. Thirdly, the High Court indicated that so-called

"secondary evidence" of inventiveness should not be lightly ignored. Such evidence includes commercial success, satisfying a "long-felt want" or need in the relevant art, the failure of others to find a solution to the problem at hand, and subsequent copying of the invention by others.

The *Patents Act 1990* requires that for assessing inventiveness, the previous knowledge, if not belonging to the skilled worker's "common general knowledge", must have been found in prior art information that could have been "ascertained, understood and regarded as relevant" by the skilled worker at the relevant date. Additionally, where the previous knowledge is found in multiple pieces of information, the provisions of the Act require that the skilled worker could have been reasonably expected to combine them. The High Court, in *Lockwood*, also looked at these requirements and found that the skilled worker ought to be regarded as a diligent searcher, who would be expected to perform a reasonable search for a solution to a problem at hand rather than a broad search in, for example, divergent and/or non-familiar arts (i.e. which might enable the identification of a solution from combinations of features from divergent sources). The High Court also considered that the diligent searcher would not be expected to find every relevant, publicly available document.

In contrast, the Supreme Court in *KSR* considered that broad searching would be the normal expectation of the skilled

worker. Further, while affirming that secondary evidence was crucial in assessing inventiveness, the Supreme Court also opined that the pool of prior art that is relevant is much broader than that of the particular problem at hand. Indeed, it was suggested that any prior art information belonging to a "field of endeavour" was relevant, thereby seemingly permitting, for example, the combination of information not clearly related to the invention with the knowledge of the skilled worker to render an invention as obvious. The Supreme Court also expressed the view that the skilled worker is *expected* to combine information from multiple documents like pieces of a puzzle to obtain a solution to a problem.

Many commentators on *KSR* have indicated that the findings in that decision represent a significant "raising of the bar" for inventiveness in the United States. On the other hand, the High Court decision in *Lockwood*, confirms that the threshold for inventiveness in Australia is low. Indeed, it appears that the High Court is of the view that where there is a need for wide searching for a solution to a problem, or where there is a need to combine multiple pieces of information, that need could itself represent, or at least indicate the presence of, an inventive step. The practical effect of the *Lockwood* decision is that Australian patents may be more likely to resist an attack for obviousness than their United States counterparts.