



Alessandro Orsi
Senior IP Attorney
Hewlett-Packard

8 de abril 2002
La aproximación
‘problem solution’ como
alternativa a la
aproximación ‘problem &
solution’ para analizar la
presencia de actividad
inventiva

Problem & Solution approach

- Determining the closest prior art
- Establishing the technical problem to be solved
- Assessing if the claimed invention starting from the technical problem and the closest prior art would not have been obvious to the skilled person.
 - Application of known measures?
 - Obvious combination of features?
 - Obvious selection
 - Overcoming a technical prejudice
 - others

Problem invention

And what we can do if, given a problem, the solution is clearly obvious?

Problem invention

An invention may, for example, be based on [...] the formulation of an idea or of a problem to be solved (the solution being obvious once the problem is clearly stated). GL C.IV.9.4.(I)

The discovery of an unrecognised problem may, in certain circumstances, give rise to patentable subject-matter in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious. T2/83

T2/83

Reasons for the decision

- Unrecognised problems may give rise to patentable subject-matter.
- The question regarding the inventive step is not whether the skilled man could have [made such modification] but whether he would have done so in expectation of some improvement or advantage
- The outcome of the modification was not predictable and the claimed modification involve an inventive step on this basis
- Deficiency of the prior art product was not in the state of the art at the priority date of the application.

Limitations

- The posing of a new problem does not represent a contribution to the inventive merits of the solution if it could have been posed by the average person skilled in the art (T109/82, T566/91)
- It has to be taken into consideration that it is the normal task of the skilled person to be constantly occupied with the elimination of deficiencies, with the overcoming of drawbacks and with the achievement of improvements of known devices and/or products (T15/81)
- This technical problem shall be clearly and unambiguously disclosed in the application as filed (T971/92)

Specification

Try to identify the problem(s) which the application seeks to solve.

Explain how the inventors made the invention

List experiments and results, positive and negative

Conclusions

- Very powerful approach is some special cases. E.g when a new phenomenon (physical, chemical) is discovered.
- When the fight is on the problem side, it is harder to find art which can anticipate the problem (usually the art spends more details on solutions than on problems).
- The inventive test for problems is simpler to demonstrate than for solutions. A problem invention should not be
 - an obvious non-compliance with a obvious desideratum, or
 - a problem which **NECESSARILY** comes into light when an object is used (T566/91).