

Circular C8728 – Response from the UK IPO

Secretariat study on inventive step

Relevant information on the UK's practice and case law is provide below:

Common general knowledge: Its combination with the State of the Art;

- Combination: juxtaposition vs synergic effects;
- The danger of hindsight analysis;
- Secondary indicia;
- Selection inventions;
- Problem invention; and
- The assessment of inventive step in the chemical sector (Markush claims, enantiomers. etc.).

UK practice with regard to inventive step in chemistry, including discussion of selection inventions, enantiomers, Markush claims etc, is primarily covered in the UK IPO guidelines on Examining Patent Applications Relating to Chemical Inventions at paragraphs 48-90 (see <https://www.gov.uk/government/publications/examining-patent-applications-relating-to-chemical-inventions/examining-patent-applications-relating-to-chemical-inventions-may-2017#inventive-step>).

UK practice with regard to inventive step can be found in Section 3 of the Manual of Patent Practice. This can be found here: <https://www.gov.uk/guidance/manual-of-patent-practice-mopp/section-3-inventive-step>

Practice with regard to comment general knowledge and its combination with the state of the art can be found in paragraphs 3.29-3.33.2. Practice with regard to juxtaposition vs synergic effects can be found in paragraph 3.17. Practice with regard to the dangers of hindsight can be found in 3.10. Practice with regard to secondary indicia can be found in paragraphs 3.75-3.87.2, this includes indicia such as the Haberman questions. Practice with regard to selection inventions can be found in paragraphs 3.88-3.93. Practice with regard to problem inventions can be found in paragraph 3.79.