Resolution

Question 209

Selection inventions – the inventive step requirement, other patentability criteria and scope of protection

AIPPI

Noting that:

1)   Some jurisdictions have special rules or regimes for selection inventions, whereas other jurisdictions apply usual patentability criteria.

2)   The substantive requirements for patentability for selection inventions are similar in a broad sense in the majority of jurisdictions, irrespective of whether or not there are special rules or regimes.

3)   Although there are in general no specific limitations on the types of protectable selection inventions, in practice selection inventions appear, with few exceptions, only in the chemical, pharmaceutical or material science fields.

4)   There is a considerable discrepancy among various jurisdictions as to the approach of requirements for novelty, inventive step or non-obviousness and scope of protection with regard to selection inventions.

5)   AIPPI Q81 considered "protection of groups of chemical substances and selection inventions" without passing a resolution on the subject.

Considering that:

1)   The general concept of selection inventions is well established and is broadly recognised in most jurisdictions.

2)   Protection of selection inventions promote further research and development of new technology.

3)   There is a need for harmonisation of the rules and application of law regarding selection inventions in particular with respect to requirements for patentability and any restrictions on the submission of experimental data or other evidence after the initial filing of an application.

4)   The question of late submission of data with regard to selection inventions necessarily raises a broader question of rules or policies governing late submission of data in other contexts.

Resolves that:

1)   It should be possible to obtain a patent for an invention, that is a selection from a previous disclosure.

2)   Selection inventions should be patentable in all technical fields.

3)   Usual patentability criteria should apply to selection inventions.

4)   In order to be novel a selection invention must not be disclosed as a species and enabled in the prior art. A different property or advantage, or a similar advantage of unpredictable extent, should not be required to establish novelty.

5)   In order to be inventive, a selection invention should display unexpected or surprising properties not apparent from the previous disclosure from which it is selected in view of other prior art.

6)   Substantially the whole of the claimed selection must display such unexpected or surprising properties.

7)   For the purpose of achieving a clear and objective distinction of a selection invention over prior art, guidelines may be a helpful instrument for examiners and applicants.

8)   It is recommended that an assessment of novelty takes into account:
- how broad or generic the prior disclosure is,
- how narrowly the selection invention is defined,
- how far removed from any specific examples disclosed in the prior art the selection invention is,
- whether the features of the selection invention have been explicitly or implicitly described in the prior art.

9)   If the applicant relies upon unexpected or surprising properties to support inventive step, then such unexpected or surprising properties must be derivable from the application as filed.

10)   The principles applying to the further submission of factual evidence should apply equally to selection inventions (including evidence of experiments in support of such unexpected and surprising properties).

11)   It should not be a requirement for finding infringement of a selection invention that any unclaimed unexpected or surprising properties be utilised by the alleged infringer.

12)   The intent of a third party to use a selection invention should not be relevant for finding infringement.

13)   Because the question of late submission of data in the context of selection inventions raises a broader question of late submission of data in other contexts, it is recommended that AIPPI further study this broader question.