Question Q217

National Group:	**Hungary**
Title:	**The patentability criterion of inventive step / non-obviousness**
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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

The standard and definition of inventive step are given in Art. 4(1) of Act XXXIII of 1995 on the protection of inventions by patents (in the following: HPA) as follows:
"An invention shall be considered to involve an inventive activity if, having regard to the state of the art, it is not obvious to a person skilled in the art."

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

No. (The Hungarian Group notes that the present HPA entered into force on 1 January 1996. Although the definition of the standard for inventive step was formulated in a different way in the earlier HPA (in fact it was included in the standard for novelty), the level of the required inventiveness was not changed by the new law.)

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Yes. The Hungarian Group considers the guidelines of the Hungarian Intellectual Property Office to be quite useful and effective. At the same time the Hungarian Group is of the opinion that these guidelines should be updated as they were published shortly after the entering into force of the present HPA on January 1, 1996.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

No. In Hungary the principle of bifurcation exists, which means that during litigation (for example to establish infringement) the issue of inventive step does not arise. This issue can be raised in separate invalidity proceedings, started before the Hungarian Intellectual Property Office as the first instance, so the same standards and practice apply for examination and invalidity proceedings. Our answers to the following questions mentioning "litigation" relate to invalidity proceedings.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

"The claims shall be interpreted on the basis of the description and the drawings." "The terms of the claims shall not be confined to their strict literal wording; neither shall the claims be considered mere guidelines for a person skilled in the art to determine the claimed invention." [Art. 24(1) and (3) HPA]
On this basis, the claims are construed in Hungary as would be understood by a person skilled in the art in the light of the description and the drawings.

6. Is it possible to read embodiments from the body of the specification into the claims?

Yes.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

Prior art is interpreted as would be understood by a person skilled in the art. Reliance on inherent disclosures is permitted.

8. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Yes. The missing teaching can be provided by arguments but the argumentation must be detailed and well founded. In such cases, the level of the common general knowledge is an issue to be considered. The level must be set according to the relevant technical field.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

Combination of two or more prior art references is allowed to find lack of inventive step, if such combination was obvious to a skilled person at the priority date. An explicit teaching or motivation to combine is not required.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

The closeness of the technical fields is highly relevant in a combination of prior art references. The more close those technical fields are, the more evident is the combination. The problem to be solved is another highly relevant factor. As long as the problem itself is not recognized, the combination simply can't arise for a skilled person.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

Yes, more than two references can be combined to show lack of inventive step. However, the more references are considered, the less obvious is their combination.

13. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

It is a sign of inventive step if the problem to be solved itself was not recognized in the prior art.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The Hungarian formality provisions stipulate that the technical problem is only to be disclosed in the description, if it is not evident from the solution and from the disclosure of the effects of the invention [c.f. Decree of the Ministry of Justice No. 20/2002. (XII.12.) IM on the detailed formalities for patent applications].

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Unforeseeable (non-obvious) advantageous effects are clear signs of inventive step.

17. Must the advantageous effects be disclosed in the as-filed specification?

At least one advantageous effect must be disclosed.

18. Is it possible to have later-submitted data considered by the Examiner?

Yes, especially in the case of inventions in the field of chemistry and pharmaceuticals, but these data can't be incorporated in the description, they form a part of the official file, only.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

There are technical fields where paper or hypothetical examples may be sufficient. However, such an approach is at the risk of the applicant in invalidation proceedings.

20. Do the answers to any of the questions above differ during examination versus during litigation?

No, except for paper or hypothetical examples.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

An explicit teaching away is a decisive factor in favor of inventive step / non-obviousness. Non-explicit teaching away may also support inventive step.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Teaching away representing a general prejudice in the art is a decisive factor in favor of inventive step / non-obviousness.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Basically yes, but they are in the majority of the cases themselves not decisive. In some cases secondary considerations, like meeting a “long-felt want”, may support inventive step.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

For example market success, long-felt want or failure of others to solve the problem are accepted secondary considerations. They must be well substantiated. A close connection between the claimed invention and the secondary considerations is required.

26. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

A further important factor in favor of inventive step is the breakthrough or pioneer character of an invention.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and , if so, provide a brief summary of such interpretation.

The published examination guidelines of the Hungarian Intellectual Property Office do not mention any specific statement for a test for inventive step. However, the Hungarian Intellectual Property Office follows the problem-solution approach of the EPO. The interpretation of the test is the same as that of the EPO.

29. Does such test differ during examination versus during litigation?

No.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

There are no differences. See our answer to point 4 above.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

No.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

A Hungarian patent can be obtained via the national route or, since 1 January 2003, the European Patent Office. The HPA of 1995 was harmonized with the European Patent Convention, so theoretically there should be no divergences between the approaches of the Hungarian Intellectual Property Office and the European Patent Office.

33. If yes, is this problematic?

No.

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the patentability criteria for inventive step / non-obviousness. More

specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Yes.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

Yes.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art, it is not obvious to a person skilled in the art at the filing date or, where priority is claimed, the priority date of the application claiming the invention.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

The Hungarian Group is in favor of the following steps of the application of the above definition:
(1) Identifying the notional person skilled in the art and the relevant common general knowledge of that person.
(2) Applying the problem-solution approach (as of the EPO), i.e.:

a) Identifying the closest prior art;
b) Establishing the objective technical problem to be solved;
c) Considering whether the invention, starting from the technical problem and the closest prior art, would have been obvious to the skilled person identified in step (1).

Summary

The standard and definition of inventive step in Hungary are as follows: “An invention shall be considered to involve an inventive activity if, having regard to the state of the art, it is not obvious to a person skilled in the art.” All the factors mentioned in the Working Guidelines may play a role in determining inventive step / non-obviousness.

As to the test determining inventive step / non-obviousness, the Hungarian Group is in favor of a combination of the steps of
- identifying the notional person skilled in the art and the relevant common general knowledge of that person, and
- applying the problem-solution approach as of the EPO.

Zusammenfassung

Der Maßstab und die Definition für die erfinderische Tätigkeit (den erfinderischen Schritt) lauten in Ungarn wie folgt: „Eine Erfindung beruht auf einer erfinderischen Tätigkeit, wenn sie sich für den Fachmann nicht in naheliegender Weise aus dem Stand der Technik ergibt." Alle in den „Working Guidelines“ erwähnten Faktoren können eine Rolle bei der Bestimmung des erfinderischen Schrittes/der Nicht-Offensichtlichkeit spielen.

Was den Test zur Bestimmung des erfinderischen Schrittes/der Nicht-Offensichtlichkeit anbelangt, bevorzugt die Ungarische Landesgruppe eine Kombination der folgenden Schritte:
- Identifizierung des fiktiven Fachmanns und seines relevanten allgemeinen Fachwissens und
- Anwendung der Annäherung "Problem-Lösung", verwendet durch das EPA.

Résumé

La norme et la définition de l'activité inventive sont les suivantes en Hongrie : « Une invention doit être considérée comme impliquant une activité inventive si, au regard de l'état de la technique, elle n'est pas évidente pour un homme du métier. » Tous les facteurs mentionnés dans les lignes directrices de travail peuvent jouer un rôle pour déterminer l'activité inventive / l'évidence.

Quant à l'examen qui détermine l'activité inventive / la non-évidence, le Groupe Hongrois est favorable à une combinaison des procédés consistant à
- identifier la notion d'homme du métier et les connaissances générales communes pertinentes de cette personne, et
- appliquer l'approche « problème-solution » telle que définie par l'OEB.