



## Is the “closest prior art” a misleading concept?

### The Board of Appeal’s judgment in T 694/15 and T 405/14

It comes as something of a surprise when one of the EPO’s Technical Boards of Appeal finds that “the terminology “closest prior art” is somewhat misleading”, as stated by Board 3.4.01 in T 694/15 & T 405/14. In fact, almost no discussion at the EPO about inventive step is complete without mentioning the “Problem-Solution approach” and the “closest prior art”. Indeed, in combination, the White Book and the Guidelines for Examination refer to the “closest prior art” no fewer than 196 times. In this article we investigate whether the view of Board 3.4.01 in T 694/15 and T 405/14 is widely held, and consider its consequences.

#### The Problem-Solution approach

There are three stages to the EPO’s Problem-Solution approach for assessing inventive step:

1. determine the “closest prior art”;
2. establish the “objective technical problem” that has been solved by claim 1 [which is determined based on the technical effect of the differences between the claim and the closest prior art]; and
3. consider whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

What does the term “closest prior art” actually mean?

There is a wide body of case law (e.g. T 656/90, T 824/05, T 1755/07 and T 698/10) that supports the view that the closest prior art is the document “which provides the skilled person with the *most* promising springboard to the invention, i.e. the one starting from which the subject-matter of the invention is rendered *most* obvious”. The superlative language “closest” and “most” produces the impression that different prior art documents can be ranked such that one is closer to the claimed invention than all of the others. This idea that there is a *closest* document leads some patentees to rank the documents and argue that a concept is inventive because, although obvious in view of a first document, it is not obvious in view of a second document, the second document being ostensibly closer to the invention than the first document. These arguments are tantamount to stating that it is not valid to start from the first document because it is not the “closest” prior art — a semantic rather than substantive argument.



Although superficially attractive, such arguments rarely work in practice. In many cases (e.g. T 1742/12 and T 824/05) it has been held that if the invention is obvious in view of the first document, then the second document cannot be “closer” than it. Instead, Boards have suggested that the relevant question is the *feasibility* of the document as a starting point, rather than closeness (e.g. T 967/97, T 558/00, T 21/08, T 308/09 and T 1289/09). Board 3.4.01 in T 694/15 and T 405/14 seems to strongly agree with this position.

For a while there has been some unease about what is meant by the “closest prior art” amongst the Boards. In spite of this, the Boards of Appeal have remained wedded to this terminology. However, it is not until very recently that Board 3.4.01 has acknowledged that this ubiquitous phrase is misleading. That Board proposes instead that the language “starting point (in the prior art)” should be used and states “what is decisive for establishing obviousness is not the closeness of the starting point but the overall likelihood of the path, given the starting point”.

So how should the starting point be chosen?

At first sight it might appear that a corollary of moving away from the idea of a “closest” document is that the choice of starting point requires no justification. In an extreme case it might be possible to establish a lack of inventive step starting from a document in a remote technical field (perhaps even one that a real inventor would never have considered) as long as the skilled person merely has to take a straightforward, obvious step from that starting point to arrive at the claimed invention. Whilst the language “closest prior art” suggests it is important to work out which document is the closest, in practice this may end up being irrelevant — an opponent/examiner just needs to find a document from which the claim is obvious.

Is this truly allowable or does it amount to a use of hindsight, by choosing an unrealistic starting point that happens to work to show a lack of an inventive step?

Board 3.4.01 appears alive to the hindsight issue. Indeed, that the generally accepted considerations for choosing the starting point (such as whether the documents share a common or similar purpose with the claimed invention) introduces a lack of objectivity is a reason that the Board gives for moving away from the idea of a “closest prior art”. Board 3.4.01 proposes instead that the question to be answered when selecting a starting point is whether that starting point “allows... a realistic objection of lack of inventive step to be raised”, in other words “on the basis of an evaluation of the likelihood of the existence of an obvious path to the claimed subject-matter”. Despite this requirement for a “realistic objection” or likelihood of an obvious path, the Board expressly mentions that it can still be possible to show a lack of inventive step from starting points that are “not even limited to items of prior art dealing with the same or similar problem so long as hindsight is avoided”. One way to rationalise these seemingly contradictory statements by this Board is that there may be cases where it would be realistic for the skilled person to start from a document in an unrelated field. But how is “realism” measured?

One possible answer is that it is the perspective of the skilled person that provides the metric by which “realism” is assessed. Many cases, including one very early Problem-Solution approach case, T 24/81, support the view that the skilled person plays a role in choosing the starting point. Board 3.4.01 in a previous case, T 2057/12, appears to agree with this solution and added that “arguments or evidence should be provided as to why the skilled person in a specific technical field would have indeed envisaged selecting a document in a remote field of technology as closest prior art”.



Conversely, Board 3.5.03 in case T 1450/16 was concerned that allowing the skilled person to choose the starting point interfered with the objectivity of the approach, and decided that “the respective deciding body”, rather than the skilled person, should determine the closest prior art. Hence, another possible answer is that the respective deciding body is responsible for assessing realism.

Both Board 3.4.01 and Board 3.5.03 seem concerned with preserving objectivity and a lack of hindsight in the Problem-Solution approach. However, their conflicting methods of resolving the issue illustrate an inherent tension within the Problem-Solution approach. On the one hand, flexibility in selecting the starting point renders the first step of the approach completely objective, but permits hindsight into the analysis by enabling an opponent to choose the unrealistic starting point that happens to establish an invention is obvious. On the other hand, considering the perspectives of the skilled person may come at the cost of a lack of objectivity in the first step of the approach.

If one thing is clear, it is that the Boards are yet to be completely aligned in their approach to the starting point question, and we may find ourselves in receipt of more surprising suggestions before a truly common approach is found. For now and faced with some future uncertainty, there are a couple of practice points to bear in mind:

- arguments that claim subject-matter is inventive because a second document might be closer than a first one are highly unlikely to be successful.
- opponents may not need to justify a choice of starting point: it merely needs to be feasible. However, if the starting point is more far-fetched, some justification may be required.
- proprietors can argue that a far-fetched starting point is not realistic.

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