Editorial

The so-called 'person skilled in the art': a donkey or a genius?

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Patent laws frequently call on the services of the 'person skilled in the art'. But that person has a split personality: at first, he[1] is a donkey; later on, he becomes a genius. Depending on the circumstances (or on mere convenience), this fictional person knows everything or knows nothing.

The Italian Industrial Property Code is representative of this confusion. Article 48, on inventive step, states:

> An invention shall be considered as involving an inventive step if, for the person skilled in the art, it is not evident from the state of the art.

The person skilled in the art re-emerges in Article 51.2, on sufficiency of disclosure:

> The invention must be described in a sufficiently clear and complete manner so that any person who is skilled in the art can implement it.

And then again in Article 76.1, on nullity of a patent:

> … if the invention is not described in a sufficiently clear and complete manner as to allow an expert person to implement it.

The European Patent Convention (EPC) takes a similar approach to the relevance of the person skilled in the art in the assessment of inventive step (Article 56), sufficiency of disclosure (Article 83) and nullity of the patent for insufficient disclosure (Article 138 (b)). But in the EPC the person skilled in the art makes one further appearance.

In the Protocol on the Interpretation of Article 69 EPC, the person skilled in the art is used to determine the extent of protection of a patent, as Article 1 tries to find a satisfactory ground between (a) the literal meaning of the claims and (b) the broader range of protection offered by 'what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated'. The Protocol then sets out that the extent of protection conferred by a European patent:

> … is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

The different sides of the split personality of the 'person skilled in the art' can perhaps be best seen in litigation. Here, the infringer challenges the patent, appealing to either side of this personality. First, the person skilled in the art has the expertise, knowledge and aptitude to find that the patented innovation was obvious based on prior art; thus, the patent is invalid. Second, when the same person looks at the patent claims and the description and drawings, he is dumbstruck and, asserting that the patent is unclear and incomplete, finds himself wholly incapable of implementing the invention; thus, the patent is invalid. This two-fold approach can also be used by the patent examiner when reviewing the application during patent prosecution.

To better understand this complex situation, we must first acknowledge that the confusion stems from the origin of the notion of 'patent' itself, which is inspired in part by an agreement between public and private. As opposed to the confidentiality of an industrial or trade secret, a patent requires a detailed public description of how to implement the invention. In addition, according to the validity requirements (encompassing novelty and inventive step), the exclusive right conferred by a patent is granted only for non-trivial inventions. Thus, the two different sides of the personality of the person skilled in the art are aimed at achieving different objectives: one is to ensure that the patent respects the agreement between public and private sectors; the other is to protect valuable inventions and not trivial innovations.

While these principles—sufficient disclosure and inventive step—are at the foundation of the notion of

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1 *He* includes *she* (but not when *he* is presented as a donkey!).

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'patent', their application can result in confusion and erroneous outcomes. In the process of granting a patent, as well as in the steps followed to assess in court whether a patent meets the validity requirements, the person skilled in the art is often used in a distorted way. For example, in the assessment of the inventive step, the person skilled in the art is not only perceived as an expert in the field, but more as a super expert, a 'genius'. But this 'genius' status is a false accolade: for him, it is sufficient to read the patent—and therefore know from the patent itself how to solve a certain technical problem—when it would be difficult, without the text of the patent, to combine prior art documents to arrive independently at the patented invention. Instead of this common practice, the assessment of the inventive step should be undertaken by the person skilled in the art only if he does not include in his review the patent under examination.

With the patent available for his consultation, the person skilled in the art has the means to discover sufficient prior art, leading to the conclusion that the patented innovation is obvious. But then, to assess the sufficiency of disclosure, he suddenly becomes as ignorant as a donkey and, driven by too much severity (not to mention blindness), he is unable to find sufficient indications in the description to implement the invention. Thus, the genius who previously knew how to combine all human knowledge soon becomes a donkey, unable to combine the simplest information obtained from the patent description.

How should we then remedy this situation and finally reconcile the two personalities of the person skilled in the art?

Inventive step

To allow the person skilled in the art to fulfil his role in a fair and reasonable manner, he should be provided only with the technical problem underlying the invention and some general prior art related to the technical problem for which he is assessing the inventive level of the patented solution. In fact, providing the person skilled in the art with the prior art found after reading the claims of the patent (*specific* for the invention under consideration) does not place him in the same unfavourable situation in which the inventor found himself at the moment he conceived the invention. The inventor only knew a *generic* prior art derived from his knowledge related to the technical problem, but not the prior art found with cherry-picking after reading the patent.

This problem-solution approach is the method used for example by the European Patent Office to evaluate inventive step. If the person skilled in the art, operating under the same conditions as the inventor, manages to develop a technical solution equal or equivalent to the patented one, then it can be said without any doubt that the patented invention lacks an inventive step compared to the prior art.

For this reason, we feel that the practice today of providing to the person skilled in the art not only with specific prior art, but also with the description of the patent, is not fair and reasonable. As a practical matter, it is impossible for the person skilled in the art not to be influenced in his reasoning by the inventive solution disclosed to him through the patent description. Instead, he should find himself in the same mental conditions as the inventor from whom the non-obvious solution has originated. Thus, the practice of providing the person skilled in the art with the description of the patent in addition to the specific prior art is, in our view, completely wrong, as he cannot be expected to exclude the patented solution from his consideration. In other words, the person skilled in the art is in the position of joining the poker game late: the inventor plays and knows only the cards he has been dealt; the expert enters the game knowing all his opponent's cards.[2]

Sufficiency of disclosure

Often the description of a patent includes different, but similar, solutions that arise from the same technical problem. It may happen that, compared to the prior art, the general inventive idea that is common to all the embodiments is anticipated. The combination of practical examples, where inventive solutions are used, should be the subject of a valid patent even if these practical examples are found in two or more different implementations of the invention.

At this point, the person skilled in the art suddenly becomes a donkey, because he is unable to combine what is described in several practical examples to arrive at a full disclosure of the invention that is new and inventive with respect to the prior art. It must be kept in mind that patents are often (or better, always!) the combination of different known elements, and that the combination of certain elements that make the solution inventive may have been described in relation to more than one embodiment within the patent description. Inventions made up of practically one single element (a typical example is the Biro pen) are no longer conceivable in today's world, given the sophistication achieved by technical progress.

2 Similar considerations apply to the 'common general knowledge', as the specific piece of knowledge used to combine all the elements of the prior art was not necessarily available to the inventor at the time he generated the invention.

Faced with this ignorance surprisingly attributed to the person skilled in the art in assessing the sufficiency of disclosure of a patent, patent attorneys, who safeguard the interests of the patentee when describing the invention, sometimes rely on a purely formal tool. To enunciate in a valid claim constructional elements taken from different embodiments (forms of embodiment), they write a sentence like this: 'all the embodiments that describe below are not independent of each other but can also be combined between them'.

But this is just an emergency solution to 'save' the patent from an attack on its validity carried out in an inadequate manner, distorting the figure of the person skilled in the art (worthy of the utmost respect) and reducing him to a donkey. The person skilled in the art must be able to combine the various embodiments present in the description even when an automatic, convenient formula is not present. Thus, the only effective solution requires the patent to be evaluated taking into account the real inventive spirit that inspired it and that distinguishes it from the prior art, without having to resort to useless formalities. It is only by embracing this approach that we will finally be able to cure the split personality of the person skilled in the art.

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