

**Question Q209**

**National Group:** Finland  
Finlande  
Finnland

**Title:** Selection Inventions – the Inventive Step Requirement, other Patentability Criteria and Scope of Protection

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**General**

**1) Legal developments on selection inventions**

*What specific types of inventions are recognized under the concept of selection invention and are patentable in your jurisdiction?*

As a general remark the Finnish AIPPI Group notes that there are neither specific provisions of law nor established case law on selection inventions in Finland. Therefore, it is not possible to make any absolute conclusions on their scope.

In Finland there are two types of selection inventions:

- 1) inventions that are identical to a prior art invention except for at least one feature that is expressed as a species, while the corresponding feature in the prior art invention is expressed as a genus, and
- 2) inventions where certain embodiments are selected from a broader range of numeric features and which claim a limited numeric range.

According to the Finnish Patents Decree, Section 14, inventions shall relate to one of the following categories: product, apparatus, process or use. Although a new use of a known embodiment could be considered in some cases as a selection invention, use claims as such are not treated as selection inventions in Finland, but as a separate invention category. However, second medical uses can be considered as exceptions to this rule as they are selection inventions from first medical uses.

**Do you have any examples of selection inventions in a field other than chemical, pharmaceutical or material science fields?**

Selection inventions are not limited to chemical inventions, but there is a limited number of examples from other fields. Generally it can be said that selection from a broader range of numeric features can relate to any technical field.

**2) Novelty**

*Issues that should be considered with respect to the novelty of selection inventions:*

In general Finland follows the practice recognized by the EPO. Thus, an individual element or a sub-set selected from a known set of elements is novel if the selected elements are not

disclosed in an individualized form in the prior art (EPO BOA decision T 12/81) and selection of a sub-range from a numerical range must fulfill the three requirements disclosed in the EPO BOA decision T 279/89:

- 1) the selected sub-range is narrow;
- 2) the selected sub-range is sufficiently far removed from the preferred embodiments of the known range; and
- 3) the selected range is not an arbitrary sub-range of the known range, but another invention, i.e. the technical effect on the sub-range must be different from the technical effect in the broad range (purposive selection).

Further, it is said in the guidelines for Examination in the National Board of Patents and Registration of Finland that a mere selection of equal alternatives is not allowed. However, it is not absolutely clear whether a different advantage or the same advantage with an unpredictable improvement is required for a selection invention to be novel or is it only a question of inventive step.

### **3) Inventive step or non-obviousness**

A different advantage or the same advantage with an unpredictable improvement is required for a selection invention to be non-obvious. According to the Guidelines for Examination, the selection should provide a new and surprising effect in order to it be considered to involve an inventive step.

Further, a selection is may be considered as non-obvious, if person skilled in the art would not have found the solution by a reasonable amount of routine experimentation.

**If experimental data is used to back up the inventive step or non-obviousness requirement can it be submitted after initial patent filing?**

Yes.

**Are there any prerequisites or limitations on the late submission of data?**

No.

### **4) Sufficiency and/or written description requirements**

- 1) In general, the Finnish Patents Act section 8 discloses that the description shall be sufficiently clear to enable a person skilled in the art, with the guidance thereof, to carry out the invention. It is not an absolute requirement that all members of the class selected by the patentee should possess the requisite advantage. Thus, the patentee is excused if one or two examples fall short. However, in selection invention this requirement is or at least should be stricter than with normal inventions.
- 2) During the prosecution of the patent application applicants are allowed to file additional experimental data in order to support inventive step. Thus, applicants can support their argumentation with additional experimental data of the different advantage or the same advantage with an unpredictable improvement that is required for a selection invention to be non-obvious.
- 3) Sufficiency and written description requirements must be satisfied on filing the application. Late filed documents cannot be used for these purposes.
- 4) In general broad claims can be supported by a limited number of examples of asserted or proven advantages.

If a new utility is asserted as a selection invention, it would not suffice to claim a particular range or selection of components which have been found to be associated with such a new utility. As mentioned above, the selection should provide a new and surprising effect in order

to it be considered to involve an inventive step. However, it would be possible to formulate such claim as use claim.

## 5) Infringement

*If a certain advantage or superior results were the reasons for the grant of a patent on a selection invention, does such advantage or superior result have to be implicitly or explicitly utilized by a third party for an infringement to be established?*

No, there is no general requirement that the advantage or the superior result would have to be utilized by a third party for an infringement to be established.

*If a selection invention is claimed as a new use, what are the requirements to establish infringement? Would a manufacturer of a product that may be used for the new use infringe the patent? Does the intention of an alleged infringer play any role in the determination of infringement?*

To establish infringement of a use claim, the alleged infringer should either use the product for the claimed purpose or offer it for said purpose, in which case the intention of an alleged infringer would play a role.

## 6) Policy

*Groups are asked to give a short commentary as to the policy that lies behind the law on selection inventions in their jurisdictions, and then to consider whether or not such policy considerations are still valid today as technology continues to advance.*

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## With Reference to the Examples

### 7) Novelty

*In example 1 would the prior disclosure of the compounds containing the generic class of radicals anticipate any claim to a specific compound having a particular radical, or group of specific compounds having a selection of particular radicals in your jurisdiction?*

No, if the selected particular radical, or the group of specific compounds is not disclosed in an individualized form in the prior art. However, in a new patent application it would not be allowable to claim the group of specific compounds broadly and only disclaim those compounds that are specifically disclosed in the prior art document.

*In the analysis, does it matter how wide the prior disclosed generic class of compounds is – i.e. would the analysis be different if the prior disclosed generic class consisted of 1,000,000 possible compounds (very few of which were specifically disclosed) as opposed to merely, say, 10?*

Yes, it may matter. The selection may be considered less obvious the more compounds the prior disclosed generic class would contain.

### 8) Inventive step or non-obviousness

*In example 2 would any of the three possibilities constitute an inventive step over the prior art in your jurisdiction?*

(i) no, (ii) no, (iii) possibly yes.

*Further, if, say, scenario (iii) does constitute an inventive step over the prior art, what scope of protection should the inventor be able to obtain? Should the inventor be able to obtain protection for the products per se (that happen to have this advantageous property), or should any patent protection available be limited to the use of the products for the advantageous property (as an adhesive) not possessed by, and not obvious over the prior art?*

If in scenario (iii) all or most of the compounds disclosed in the prior art would possess adhesive properties, then there would not be selection but only an invention relating to a new use, which would have to be protected with use claims.

## **9) Sufficiency and/or written description requirements**

*To what extent are all members of the class selected by the patentee required to possess the requisite advantage in your jurisdiction? Is there an absolute requirement that all of the selected class possess the relevant advantage, or is the patentee excused if one or two examples fall short?*

No specific rules or case law for this question.

However, for selection inventions there should be an absolute requirement that all of the selected class should possess the relevant advantage, because this property has been the reason for accepting the claims.

## **10) Infringement**

*By reference to example 3 to what extent is evidence of the knowledge of the advantageous property of the selection, or intention of the infringer as to its supply, required to find infringement in your jurisdiction?*

The knowledge of the patent or any advantageous property disclosed therein is not required to find infringement. However, to establish infringement of a use claim, the alleged infringer should either use the product for the claimed purpose or offer it for said purpose.

## **11) Policy**

*Groups are asked to consider, in respect of example 1/2, whether it matters how much effort the inventor has invested in arriving at his selection in order to found a valid selection patent. The answer to this question is closely related to the policy considerations that underpin the grant of selection patents and the incentive / reward equation involved. The inventor may have expended considerable time and money in trawling through the whole host of possible compounds encompassed by the prior disclosed generic class, and the particular selection that he has made may constitute a leap-forward in the field. Surely the inventor should be rewarded for his efforts and obtain protection? On the other hand, it could be argued that such considerations may have been relevant in an age when the inventor's efforts actually involved many man-years of careful and painstaking laboratory work, but are now increasingly irrelevant in an age of combinatorial synthesis when large varieties of different compounds can be manufactured in a fraction of the time. Are such considerations relevant?*

Although the inventor should be rewarded for his efforts and obtain protection, the time and money spent to make the invention should not automatically be relevant when considering patentability of the results. Especially, if the invention has been made by lucky chance, it should not be automatically considered as less important than an invention that has been made by hard work. This kind of considerations should not necessarily be controlling, because many times inventions are formulated as selection inventions only after the patent

application has been filed and the patent Examiner has found novelty destroying prior art for the broad claims. In this respect selection inventions are no different from other inventions.

## **Harmonization**

**12) Groups are asked to analyze what should be the harmonized standards for the patentability of selection inventions. In particular, the items discussed in Q1-Q6 and the examples discussed in Q7-Q10 above should be referred to.**

The acceptance of use claims in general should be harmonized. Also the novelty criteria needs harmonization, at the moment it is not absolutely clear whether an unpredictable improvement is required for a selection invention to be novel or is it only a question of inventive step. Because novelty in selection inventions manifests itself in somewhat unusual ways, it would be good to combine novelty and inventive step criteria when assessing selection inventions.

**13) Groups are also asked to recommend any issues for harmonization not referred to in Q11 above.**

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**14) Groups are asked to outline any other potential issues that merit discussion within AIPPI as regards selection inventions.**

The question of equivalence: should those features that define the selection be interpreted based on equivalence or should equivalence in selection inventions relate only to those features that do not form part of the selection. For example, if the invention relates to coated glass and it is the specific coating that is selected from a general class of glass coatings, could equivalence interpretation relate only to the glass material but not to the coating?

## **Summary**

The Finnish AIPPI Group notes that there are neither specific provisions of law nor established case law on selection inventions in Finland. It is proposed that the acceptance of use claims in general should be harmonized. Also the novelty criteria need harmonization. At the moment it is not absolutely clear whether an unpredictable improvement is required for a selection invention to be novel or is it only a question of inventive step. It would be good to combine novelty and inventive step criteria when assessing selection inventions. Further discussion within AIPPI is needed regarding equivalence and selection inventions.

## **Zusammenfassung**

Die finnische AIPPI stellt fest, dass es weder spezifische Gesetzbestimmungen noch eine eingebürgerte Rechtsprechung betreffend Auswählerfindungen in Finnland gibt. Es wurde vorgeschlagen, dass die Gewährung von Anwendungsansprüchen im allgemeinen harmonisiert werden sollte. Auch die Neuheitskriterien bedürfen Harmonisierung. Zur Zeit ist es nicht unbedingt klar, ob ein unvorhersehbarer Fortschritt erforderlich ist, damit eine Auswählerfindung neu ist, oder ob es dabei nur um die Frage der erfinderischen Leistung geht. Es wäre gut, bei der Beurteilung von Auswählerfindungen die Kriterien der Neuheit und der Erfindungshöhe zu verbinden. Eine weitere Diskussion betreffend die Äquivalenz und Auswählerfindungen ist erforderlich.

## **Sommair**

La Groupe AIPPI finlandaise notifie que il n'y a ni provisions de loi spécifiques ni loi de cause établie sur des inventions de sélection en Finlande. Il est proposé que l'acceptation des revendications de utilisation devrait en général être harmonisée. Aussi des critères de nouveauté ont besoin de l'harmonisation. Pour le moment il n'est pas absolument clair si une amélioration imprévisible est nécessaire pour une invention de sélection pour être nouvelle, ou s'agit-il seulement d'une étape inventive. Il serait bien de combiner des critères de nouveauté et de l'étape inventive pour l'évaluation des inventions de sélection. Discussion supplémentaire sur équivalence et des inventions de sélection est nécessaire.