

Section G-VII, 5.2, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5.3 Could-would approach

In the third stage the question to be answered is whether there is any teaching in the prior art as a whole that **would** (not simply could, but would) have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves.

GL/ISPE A13.08.8,

GL/ISPE A13.08.9

5.4 Claims comprising technical and non-technical features

Section G-VII, 5.4, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5.4.1 Formulation of the objective technical problem for claims comprising technical and non-technical features

Section G-VII, 5.4.1, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

5.4.2 Examples of applying the steps listed in GL/EPO G-VII, 5.4

Illustrative examples can be found in section G-VII, 5.4.2, and subsections G-VII, 5.4.2.1 to G-VII, 5.4.2.4, in the Guidelines for Examination in the EPO.

6. Combining pieces of prior art

In the context of the problem-solution approach, it is permissible to combine the disclosure of one or more documents, parts of documents or other pieces of prior art (e.g. a public prior use or unwritten general technical knowledge) with the closest prior art. However, the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be an indication of the presence of an inventive step, e.g. if the claimed invention is not a mere aggregation of features.

Rule 65.1

GL/ISPE 13.12,

GL/ISPE 13.13

Section G-VII, 6, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

7. Combination vs. juxtaposition or aggregation

The invention claimed must normally be considered as a whole. When a claim consists of a "combination of features", it is not correct to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. However, where the claim is merely an "aggregation or juxtaposition of features" and not a true combination, it is enough to show that the individual features are obvious to prove that the aggregation of features does not involve an inventive step.

GL/ISPE 13.05,

GL/ISPE 13.14(c),
(d).

8. *Ex post facto* analysis

It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been

GL/ISPE 13.15