

formulated, it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner should be wary of *ex post facto* analysis of this kind. When combining documents cited in the search report, he should always bear in mind that the documents produced in the search have, of necessity, been obtained with foreknowledge of what matter constitutes the alleged invention. In all cases he should attempt to visualise the overall state of the art confronting the skilled person before the applicant's contribution, and he should seek to make a "real-life" assessment of this and other relevant factors. He should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant, without the benefit of hindsight.

## **9. Origin of an invention**

While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that an invention may, for example, be based on the following:

- (i) the devising of a solution to a known problem;
- (ii) the arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious).

Many inventions are of course based on a combination of the above possibilities - e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

## **10. Secondary indicators**

### **10.1 Predictable disadvantage; non-functional modification; arbitrary choice**

Section G-VII, 10.1, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

### **10.2 Unexpected technical effect; bonus effect**

Section G-VII, 10.2, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

### **10.3 Long felt need; commercial success**

See ISPE Guidelines 13.16-13.18.

## **11. Arguments and evidence submitted by the applicant**

Section G-VII, 11, in the Guidelines for Examination in the EPO applies *mutatis mutandis*.

## **12. Selection inventions**

Generally, the principles laid down in section G-VII, 12, in the Guidelines for Examination in the EPO apply *mutatis mutandis*. The subject-matter of selection inventions differs from the closest prior art in that it represents selected sub-sets or sub-ranges. If this selection is connected to a