



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÉDÉRATION  
VON PATENTANWÄLTEN

## SESSION 2.1 INVENTIVE STEP

The longer patent attorneys practice, the more they understand that non-obviousness or inventiveness is an undefined legal term. The answer to the question whether something is inventive or not depends on the point of view of an entirely fictitious person, the skilled person.

The approaches in the US, Europe and Asia seem to be similar, at least on paper. However, there are real issues between different technical fields as well as jurisdictions.

The panel will explore the points of view used in assessing inventive step.

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Arild Tofting (NO)

Claudio Germinario (IT)

William Y. "Corky" Klett III (US)

Tomokatsu Tsukahara (JP)

## SESSION 2.1 INVENTIVE STEP

### ARILD TOFTING (NO) – MODERATOR

Arild Tofting is a graduate engineer (M.Sc.) in mechanics. He has about 25 years' experience as a patent attorney. He is one of the founding fathers of Protector IP Consultants. He has drafted several hundred patent applications in a variety of technical fields such as medical technologies, fisheries, wind power, tidal power and offshore technologies.

Before becoming a patent attorney, Arild worked as an Examiner at the Norwegian Industrial Property Office for 4 years.

On several occasions, he has assisted clients with legal proceedings and has worked as a lay judge in some patent cases. He is also a board member of the Norwegian Board of Appeal for Industrial Property Rights.

Arild has been involved in FICPI for more than 12 years. He is currently Reporter General for the CET. He has held several speeches at FICPI Fora and Congresses as well as various seminars both in Norway and in other countries.



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## SESSION 2.1 INVENTIVE STEP

### CLAUDIO GERMINARIO (IT) – SPEAKER

Claudio is an Italian and European Patent Attorney with chemical-pharmaceutical formation.

Claudio's clients include primary multinational pharmaceutical companies, biotech companies, public research institutions and SMEs developing classic, biotech, and nanotech medicaments.

Claudio spends most of his time providing technical counsel in patent litigation. He represents pharmaceutical originator companies in infringement and nullity proceedings before Italian tribunals and courts.

As a member of SIB's Nanotech-Team, Claudio is involved in drafting, filing and prosecuting patent applications in the nanotechnology platform.

Before joining SIB's Rome office in 2001, Claudio spent over 20 years with the European Patent Office in Munich, first as a biotechnology examiner and later as a member of the board of appeal competent for pharmaceuticals. He acted as rapporteur or chairman in many decisions on key points of law such as interpretation of a medicament's second therapeutic application, definition of and interaction between medical and non-medical treatments, limit of a reach-through claim, meaning of a functional claim, applicability of non-supported disclaimers, anticipating effect of speculative prior art, inventiveness and many others.

Claudio is enrolled with the Register of Court-Appointed Experts on Industrial Property of the Court of Rome, which is the Italian Court with the largest specialised IP section.



*FICPI  
CET 5 – Inventions*

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## SESSION 2.1 INVENTIVE STEP

### WILLIAM Y. "CORKY" KLETT III (US) – SPEAKER

Corky Klett practices with Nexsen Pruet in Columbia, South Carolina, and has a broad and diverse intellectual property practice. His practice focuses primarily on intellectual property litigation of all types, and he has litigated patent, trademark, and copyright infringement cases in courts across the United States. He is also routinely involved in the intellectual property aspects of corporate transactions including due diligence for mergers and acquisitions, technology transfer and licensing, as well as intellectual property portfolio creation, management, and enforcement.

Corky is also intellectual property counsel to the Estate of James Brown.

- *Best Lawyers in America*® - Intellectual Property (2006-2011); Copyright Law (2012-Present); Trademark Law (2012-Present); Patent Law (2012-Present); Patent Litigation (2012-Present); Intellectual Property Litigation (2012-Present)
- Listed in *Managing Intellectual Property* magazine's "IP Stars"
- Martindale-Hubbell - AV-rated

Corky holds a Bachelor of Science degree in Geological Engineering from the Colorado School of Mines (1987) and a Juris Doctorate degree from the University of Nebraska (1990). He is registered to practice before the United States Patent and Trademark Office.



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## SESSION 2.1 INVENTIVE STEP

### TOMOKATSU TSUKAHARA (JP) – SPEAKER

Mr. Tsukahara received his B.S. from Hitotsubashi University. He passed the BAR Examination and entered the Legal Training Institute in 1968. He was appointed Judge in 1970. He sat on various benches at the District Courts of Osaka, Tokyo, Chiba, Sendai.

In January 2003 he was appointed Presiding Judge at the Tokyo High Court 18th Civil Division (IP Division). When the IP High Court was established in 2005, he became Presiding Judge of the Fourth Division. In 2007 he was appointed Chief Judge of the Intellectual Property High Court and retired in 2010.

After retirement, he was a Professor at Waseda Law School until 2013. During this time, he was also a special advisor at TMI Associates. In June 2013 he became Chairman of Soei Patent & Law Firm.

Publications written in English:

*“Current Situations and Activation of Patent Infringement Lawsuits in Japan”* – Published by Journal of The Japanese Group of AIPPI in January, 2011

*“Intellectual Property High Court of Japan”* – Published by Japan Patent Office, Asia-Pacific Industrial Property Center, JIPII in 2013



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