

Question Q 167

Current standards for prior art disclosure in assessing novelty
and inventive step requirements

National/Regional Group Report Guidelines

The majority of the National Groups follows the guidelines for the arrangement of their reports and thereby contributes to a quicker and cheaper printing. We are grateful for this support and would like to draw your attention to the guidelines once again:

1. The National and Regional Groups are responsible for the contents, spelling and trilingual summaries in their reports. The texts will normally be printed without further correction.
2. Drafts cannot be accepted.
3. Please deliver your reports in the form of computer printouts and, whenever possible, by e-mail or on computer diskettes (DOS or Windows). Our address is:
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4. If you cannot provide such data files, we will try to machine-read the report. For such purpose we will need the original text (no copies or fax transmissions), without corrections, underlines or footnotes.

Please make sure that your reports are sent before **November 30, 2001**.

AIPPI General Secretariat

Introduction

Novelty and inventive step are central elements of the system of intellectual property rights. Novelty is required mainly for technical rights, but can also found as a requirement for other IPR, such as designs. The inventive step (in other words: non-obviousness) constitutes a requirement for patents and utility models. With the help of these elements a distinction from prior art can be achieved or determined. What has been disclosed can in general not be new or inventive. However, the details of these elements vary from country to country. There is no common definition as to the term “disclosure”. The TRIPS agreement does not give a definition either, but contains the requirements of novelty (Article 25, 27) and inventive step (Article 27). Article 39 TRIPS mentions without definition “un-disclosed information” in the context of unfair competition.

In the past, the most common ways of disclosure comprised printed or written documents or the use of certain embodiments in public. Oral disclosure is also possible. With new technologies and in particular with the internet new ways of disclosure appear which have to be taken into account. The internet creates specific problems, since information is not permanent and access may be unlimited. This leads to questions of evidence, confidentiality and accessibility.

At the ExCo Meeting in Vienna 1997 AIPPI has passed a Resolution Q 138 A which dealt with confidentiality, disclosure and publication of data in information networks. Concerning disclosure AIPPI considered that the mere fact of transmitting information by means of a computerised network will not result in the information becoming available to the public, and in consequence being disclosed. Account should be taken of the level of accessibility to the network, which is determined by, inter alia, the technical characteristics of the network, the method of communication and the access and security provisions (see AIPPI Yearbook 1997/III, p. 311). Reference is also made to Resolution Q 126 about methods and principles of novelty evaluation in patent law which was adopted in Montreal 1995 (see AIPPI Yearbook 1995/VIII, p. 383). This resolution contained general rules about disclosure and the effects of disclosure on novelty.

In this context it should be mentioned that WIPO’s Standing Committee on the Law of Patents (SCP) has given various reports on the disclosure of technical information on the internet and its impact on patentability.[1] The reports deal with specific problems with regard to the disclosure on the internet.

The question of disclosure always has an impact also on the grace period. This topic should be left out from the scope of this question Q 167. Reference is made instead to previous resolutions of AIPPI, namely to Resolution Q 75.

The title of the question implies that the main focus of Q 167 is on patents and utility models. The Group Reports should concentrate on these rights. Designs have a special requirement of novelty due to their different character as an IPR which is much more related to copyrights. Therefore, they are excluded from Q 167, unless the Group Reports show a real need to discuss issues related to these rights in the context of this question.

1. Determination of prior art

As the title of the question indicates, the question deals with prior art disclosure. Its goal is not to deal with specific questions arising from disclosure in the context of the scope of protection or the formalities of patent applications. In order to determine criteria for prior art disclosure it should be stated at first, what the main principles are with regard to the relationship between disclosure, novelty and inventive step and how this is reflected in the various national laws.

1.1 What is the effect of a prior art disclosure on novelty and inventive steps?

Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications which have not yet been published affect the assessment of novelty and inventive step?

1.2 Do the national laws give definitions or indications as to what constitutes a prior art disclosure?

1.3 Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law which have been developed in the various countries for determining a disclosure.

2. Criteria for disclosure

The determination of a disclosure has to consider various criteria. These criteria comprise the means of information (written, oral or otherwise), the time of information (recently or a long time ago), the place of information (domestic or abroad), the person who discloses the information (the applicant of an IPR or a third person) and the recipient of the information.

2.1 Means of disclosure

It should be stated in the Group Reports which form of disclosure has an impact on novelty and inventive step. In particular it will be interesting to hear if disclosure is limited to certain means of information or rather unlimited. This includes oral disclosure as well as new ways of information, such as the internet, which will also be covered in the next question.

What are recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

2.3 Place of disclosure

In some countries only a disclosure of a piece of information in that specific country may affect novelty whereas a disclosure abroad will not be taken into consideration. As an example, one can mention the publication of printed materials which are published in one country and of which only a few copies will cross the border to another country by accident or unintentionally.

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure has occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

2.4 Personal elements

It may make a difference whether a piece of information is disclosed by the applicant for an IPR or by a third person. This concerns also the protection for exhibitions and the grace period.

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

2.5 Recipient of the information

In general, the concept of disclosure requires that information be disclosed to the public. There may be differences with regard to the definition of the public. This concerns, among others, confidentiality obligations or the ability to understand the information.

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

3. Disclosure through new media

Modern technologies and in particular the introduction of the internet have made access to information world-wide much easier in a much shorter time. At the same time, the life of the information seems to be getting shorter. Information is visible and maybe also reproducible for a short time. This also leads to the danger of manipulating the disclosed information which can be done either by the author or by

third parties. With regard to new media this danger seems significantly higher than in other forms of disclosure, such as written documents. The world-wide web raises questions as to the place of disclosure. Merely the fact that information can be accessed all over the world may not lead to a disclosure in the legal sense in every country. Problems arise which are similar to those in connection with oral disclosure, such as questions of evidence, accessibility and duration of the information.

3.1 General rules

Does a paperless information, e.g. in an electronic network or through the internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of networks or communications, such as the Worldwide Web, chat groups or forums, e-mail and others?

3.2 Questions of confidentiality

Does it make a difference if the information is encrypted? What relevance do passwords, search engines and payment requirements have?

3.3 Place of disclosure

As explained earlier, in some cases the place of disclosure may be relevant for the assessment of novelty or the inventive step.

What is the place of disclosure if information is put on the internet? Is the mere fact that a web-site can be accessed in a certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?

3.4 Timing of disclosure

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

3.5 Questions of evidence

The fact that information on the internet may not be as permanent as a written document may result in a loss of that document or problems of evidence or manipulation. Such problems may arise during the prosecution of a patent application as well as in infringement cases.

Who should have the burden of proof that a specific piece of information was disclosed on the internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

4. Conclusion

The Groups are invited

- on all of the foregoing questions, to express their opinion as to the current situation, including their experience from practice with the national and regional patent authorities (such as the EPO) and courts
- to suggest the essential requirements for a common definition or standard of prior art disclosure and
- to put forward any proposal for future harmonisation of such definitions and standards.

The Groups are also invited to comment on any additional aspect which they find relevant with regard to the question and specific aspects of disclosure.

Note: It will be helpful and appreciated if the Groups follow the order of the questions in their reports and cite the questions and numbers for each answer.

[1] See WIPO Reports SCP/5/2 and SCP/5/4 of April 4, 2001