

AIPPI - Question Q 167
BRAZIL

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

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?

1.1. The effect of a prior art disclosure regarding novelty and inventive step can be adverse on the patentability of a Brazilian application.

There are differences between prior art regarding novelty and inventive step. As a general rule, in order to prove lack of novelty it is necessary that all the elements of the claimed invention be disclosed in a single document of the prior art. As to inventive step, it is possible to submit several pieces of prior art to prove non-obviousness.

For the purpose of determining novelty only - i.e., not of an inventive step, Brazilian Law states that the whole contents of an application filed in Brazil but yet unpublished shall be regarded as comprised within the state of the art either from the filing date or from the priority date, provided that it is published, even if subsequently.

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

1.2 Article 11 of the Brazilian Industrial Property Law defines what is considered comprised by the state of the art. The state of the art encompasses everything made accessible to the public prior to the filing date of a patent application, by written or oral description, by use or any other way, in Brazil or abroad.

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.

1.3 The Brazilian Patent Office still has not issued guidelines for examination, and the regulations do not specifically address this issue. Nevertheless, in order to determine whether a certain document is part of the prior art it is necessary to provide evidence that its

content was made accessible to the public in general before the date of filing or of the priority if any. Available administrative decisions reveal that documents with restricted circulation – e.g., inside a factory or even between two companies – are not considered as being accessible to the public.

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?

2.1 Recognized means of disclosure can comprise written or oral description, use or any other means, in Brazil or abroad.

However, the Brazilian Patent Office traditionally only accepts documentary evidences. Such behavior bars the assessment of novelty/inventive step based in oral disclosures. As far as judicial procedures are concerned, a testimonial evidence about previous oral disclosures is only admissible in hearings and under oath. Nevertheless, a testimonial evidence alone will likely not be accepted unless they are supplemented by documentary evidences which provide concrete proof of date of its occurrence and its content.

Undated pamphlets and blue print, per se, are unacceptable since there is no clear evidence that the contents have been made available to the public, before the filing or the priority dates.

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?

2.2 No matters if the disclosure was recent or old (the grace period is not being considered in this answer, concerning the introduction guidelines given about Q 167). What is relevant is that the disclosure should have taken place prior to the filing date of the application or to the earliest priority.

With specific regard to documents that will evidence lack of inventive step, although there are no fixed guidelines in this respect, if the prior art was published a long time ago, this constitutes a primary evidence that the invention does not derive in an obvious manner from such document. However, such aspect must be analyzed in a case by case basis.

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)?

2.3 No, the place of disclosure is irrelevant as Article 11 of Brazilian law states that the state of the art is everything made available to the public in Brazil or abroad. Therefore it is also irrelevant to determine the place of the disclosure, unless this is necessary to prove that the document was indeed made accessible to the public.

With respect to accidental or intentional disclosures, law makes no difference. The applicable law is 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?

2.4 Brazilian law provides a grace period of 12 months for the disclosure, which shall not be regarded as part of the state of the art, when made (i) by the inventor, (ii) by the PTO, regarding an application filed without the inventor's consent and based on information obtained from him or as a result of his acts; or (iii) by third parties, on the basis of information received directly or indirectly from the inventor or as the result of his acts.

The person bound by a confidential agreement will be liable for having disrespected the contract. Nevertheless, the effect of the disclosure depends on the time span between the unauthorized disclosure and the filing date of the respective patent application: (a) if it is comprised by the 12-month grace period, the novelty and inventive step of the invention shall not be affected; (b) if the disclosure happened more than 12 months before the filing date, it will destroy novelty.

If the disclosed information has errors, the effects of such disclosure will depend on the materiality of the error. If the error jeopardizes the appropriate identification of the subject matter, then it may not be considered as prior art disclosure and it will not affect the novelty of the claimed invention.

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?

2.5 In general, there are no requirements concerning ability or difficulty to understand the information. Nevertheless, the assessment of an inventive step is made considering what a skilled person would obviously infer from the state of the art.

Neither the Brazilian legislation nor the regulations establish the degree of effort needed to consider that a certain information is available to the public. However, since “public” must be broadly understood, it encompasses any person. Thus, if additional steps requiring a certain degree of expertise – such as that involved in a reverse engineering - are necessary to access the information, then this information will probably not be considered “accessible to the public”. If the additional step, such as disassembling a product, does not require particular skills, then e.g. an internal component of a device available in the commerce can be regarded as being accessible to the public.

As to the effect of confidentiality or implied confidentiality, as inferred from decisions issued by the Brazilian Patent Office, an information passed to a certain recipient will possibly not be admitted as comprised by the prior art – i.e. as being accessible to the public - if it is made under a condition of express 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?

3.1 In principle, a paperless information, e.g. in an electronic network or through the Internet, constitutes a sufficient disclosure to affect novelty or inventive step. The law does not specifically address Internet disclosures but as in the case of any paperless disclosures, the true difficulty lies in obtaining documentary proof of the disclosure. In the event the communications are regarded to be public then they would constitute prior art. Likewise e-mails messages sent to an unlimited number of persons constitute prior art. One possible manner of establishing the date and content of a certain disclosure by electronic means relies in accessing the information (e.g. website) in the presence of a notary public, printing a hard copy and obtaining a declaration from the notary public to the effect that the content of the printed copy was accessible to the public at the date in which he has accessed it.

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?

3.2 Yes, if the information is encrypted, in principle it would not be accessible to the public. If accessibility to information depends on password protection, and if there are restrictions to obtain the password, then, in principle, the information is not accessible to the "public", but merely to a limited group of persons.

If access through payment is provided to the public, then in principle the information has been made accessible to the public, presuming that the cost is not so high as to create a true obstacle to the access.

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?

3.3 Since Brazil's novelty requirements are absolute, with the exception of the grace period provisions, the place of disclosure will not be relevant for the assessment of novelty or inventive step.

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?

3.4 If information is available during a certain period of time to enable the public to produce evidence, this information (disclosure) shall be treated as being part of the state of the art.

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?

3.5 Interested third parties challenging novelty/inventive step should have the burden of proof that a specific piece of information was disclosed in the Internet. There are no specific legal rules related to prior art disclosure in the Internet, and such particular rules are unnecessary. The level of evidence should be the same, irrespective as to the source of the disclosure, i.e., in any case there should be clear evidence as to content and date of the disclosure. As in all cases of documentary evidence, the veracity of the disclosure will have to be attested.

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.

4. The Brazilian group does not agree with PLT terms at all. However, with respect to a future and partial harmonization, the Brazilian group accepts the definition of prior art in Article 8 of the current draft of the SPLT (document SCP/6/2 of September 24, 2001) as to the fact that “the prior art with respect to the subject matter of a particular claim shall consist of all information which has been made available to the public anywhere in the world in any form before the claim date”.

The Brazilian group also agrees with SPLT’s rules on lack of novelty, in which items of prior art (i) may only be taken into account individually and may not be combined, and (ii) must enable a person skilled in the art to make and use the claimed invention. The group does not foresee the need of special rules with respect to non-conventional forms of disclosure.

José Antonio B.L. Faria Correa

President
ABPI – Brazilian Intellectual Property Association

Esther M. Flesch
General Reporter
ABPI - Brazilian Intellectual Property Association

Lélio D. Schmidt
Assistant Reporter
ABPI - Brazilian Intellectual Property Association

Rana Gosain
Chairperson – Patent Committee - ABPI

Antonio Mauricio Pedras Arnaud
Vice Chairperson – Patent Committee – ABPI