QUESTION 167

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

Yearbook 2002/I, pages 273 - 274 Q167
Executive Committee of Lisbon, June 16 - 22, 2002

Question Q167

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

Resolution

AIPPI

Considering that:

a) The patent system is designed to protect inventions which, amongst other requirements, are new and involve an inventive step with respect to the prior art.

b) Standards for prior art disclosure in assessing novelty and inventive step (non-obviousness) requirements are of primary importance regarding patentability of inventions and validity of patents.

c) The emergence of new media, such as the Internet, raised the issue as to whether the standards for prior art disclosure in assessing novelty and inventive step should be reassessed.

d) A common definition for prior art disclosure is also being addressed by WIPO in their Draft Substantive Patent Law Treaty (SPLT).

And whereas:

e) Only a minority of countries having a patent system provide for additional intellectual property rights, such as utility models, for inventions which are new and involve an inventive step, and, therefore, the following resolution is directed to patents and patent applications only and not to utility models and other intellectual property rights,

f) Since its origins patent law has adapted to new means of prior art disclosure,

g) Problems resulting from this expansion have been resolved without substantially modifying the standards of prior art disclosure,

h) Additional, heretofore unknown means of prior art disclosure may emerge as technical progress advances,

i) The questions of a grace period and of the impact of abusive disclosure or the breaching of confidentiality agreements which are closely related to a prior art disclosure not affecting patentability are exempt from the following resolution,

Adopts the following Resolution:

1. The prior art with respect to an invention claimed in a patent or patent application shall consist of all information which has been made available to the public anywhere in the world in any form before the filing date or, where applicable, the priority date.

2. If the filing date or, where applicable, the priority date, of a patent application filed in, or with effect for, a country ("earlier application") is earlier than the filing date or, where applicable, the priority date of another patent application filed in, or with effect for, the same country (“later application”) and if the earlier application is made publicly available on or after the filing date, or where applicable, the priority date of the later application, the whole contents of the earlier application excluding the abstract, if any, shall be considered to form part of the prior art with regard only to the novelty of an invention claimed in the later application, but not with regard to the inventive step. Where such earlier application has been made publicly available in spite of the fact that, before the date of becoming publicly available, it was withdrawn or abandoned, was considered withdrawn or abandoned, or was rejected, it shall not be considered as prior art with regard to such later application.

3. To qualify as prior art under item 1, information may be made available to the public in any form, such as in written form, by oral communication, by display, by telecommunication means or through use.

4. The public means any person who is free to disclose the information.

5. Information shall be deemed to have been made available to the public, if there is a reasonable possibility that it could have been accessed by the public.

6. With regard to new media the same principles should apply which have been developed for the assessment of a disclosure to the public through other means. Since the place and means of a disclosure are not determinative, the Internet or other new media do not require a treatment different from other forms of disclosure. It has to be evaluated on a case-by-case basis whether passwords or other means restrict the access so that information is not public.

7. Because a disclosure through new media can lead to specific evidentiary issues, the relevant authorities, such as patent offices or (inter-) governmental bodies, are urged to investigate new means for providing evidence. However, the existing principles regarding the burden of proof should remain applicable.

8. As a result of the present resolution, further harmonization of the standards for prior art disclosure in assessing novelty and inventive step requirements in the various countries is desirable.