

Summary Report

Question Q167

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

The focus of Q167 is to evaluate whether the various standards applied in the countries to assess novelty and inventive step need further harmonization. This is of particular interest with regard to the Internet which is accessible worldwide at the same time and may create additional problems compared to the situation in the past.

According to the Working Guidelines, the question was not limited to patents. However, the answers have shown that there is no need to discuss the problems in the context of designs or other intellectual property rights. The further work of the Committee will therefore be directed towards patents and - where applicable - to utility models. In this context, reference should be made to the activities of WIPO and their plans for a Substantive Patent Law Treaty (SPLT). Art. 8 of the Draft SPLT¹ contains a provision for the definition of prior art and the prior art effect of former applications. These provisions are accompanied by Rules 8 and 9 and the respective Practice Guideline under Rule 8 which explicitly refers to publication through communication by electronic means, in particular, the Internet.²

The Reporter General has received 32 reports from the following countries (in alphabetical order): Argentina, Australia, Brazil, Bulgaria, Canada, Czech Republic, Denmark, Egypt, Finland, France, Germany, Hungary, India, Israel, Italy, Japan, The Netherlands, Norway, Paraguay, Poland, Portugal, Republic of Korea, Romania, Singapore, South Africa, Spain, Sweden, Switzerland, United Kingdom, United States of America, Uruguay and Venezuela.

There seems to be little controversy about the main principles. Differences can mainly be found when it comes to details. A distinction is also necessary between patents and utility models in some countries (e.g. Germany, Hungary and Spain). The EPO and the JPO have set up Guidelines for the examination of patent applications which also comprise the assessment of novelty and inventive step. The Danish and the Japanese Reports have pointed out that the JPO has issued Operational Guidelines on Treatment of Technical information disclosed on the Internet as Prior Art.³

1. Determination of prior art

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?

There is a unanimous understanding among the Groups that a prior art disclosure may affect novelty and inventive step (the US Group mentions "obviousness"). Differences can be found with regard to the kind of intellectual property right (patents or utility models) and to the relevance of pending applications which are published after the filing date of the application to be assessed. In this connection, the Dutch, the French and the Swiss reports mention that there is no examination before the grant of the patent, so that the questions of novelty and inventive step are dealt with solely by the courts.

¹ The latest version of the SPLT (Draft) and the accompanying Regulations can be found as Documents SCP/6/2 and SCP/6/3 of the Standing Committee on the Law of Patents of WIPO.

² see also Document SCP/6/4 „Notes“

³ see www.jpo.go.jp

A minority of the countries know utility models. The Dutch and the UK Groups specifically state that there are no utility models in their countries. However, in The Netherlands, a short-term patent can be granted if the applicant does not request a search for prior art. According to the Egyptian Group utility models will be introduced in the new law in the future. They will follow the same rules as patents. The same situation occurs in Denmark. On the contrary, the Spanish and the German Groups mention that utility models are treated differently from patents.

In general, the Group reports observe no difference between prior art considered for the assessment of novelty and the assessment of inventive step. It should, however, be pointed out that novelty and inventive step are assessed in different ways. For the requirement of novelty the pieces of prior art and the invention are compared one to one whereas for the assessment of an inventive step prior art as a whole is considered (see explicitly the reports of Australia and Brazil).

With the exception of Israel, also pending applications which have not yet been published at the date of application or the priority date of the younger application are considered as prior art under various circumstances. For instance, according to Art. 54 (4) EPC, an earlier pending application is only relevant if a country designated for the younger application has also been designated for the older application. In most countries, such prior art only affects novelty but not the inventive step. The Portuguese report states that pending applications which are published later affect the assessment of novelty and inventive step, given the fact that they are included in the prior art according to the Portuguese Industrial Property Code. Some countries have additional requirements as to when pending applications are taken into account. The US report states that they are only considered when prior art is published later or when a US patent is granted. According to the Swiss report, their national law also requires that a patent has been granted for the earlier application in order to be considered prior art.

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

The vast majority of the countries applies absolute novelty in the sense that everything which has been made available to the public anywhere in the world in any way is taken into consideration for the assessment of novelty. Certain exceptions are in most cases allowed in extraordinary situations. These comprise disclosures which constitute an abuse of the knowledge of the applicant, disclosures on the occasion of exhibitions according to the 1928 Convention on International Exhibitions or disclosures before scientific societies (Australia and Israel). Another exception is the grace period which, according to the Working Guidelines, will not be dealt with in the context of Q167.

In some cases, the use or the oral description of prior art is only relevant if it occurred in the country in which novelty and inventive step have to be assessed. The Australian Group states that oral description has to be made in Australia if it shall be considered. The German, the Hungarian (both for utility models only) and the Korean reports observe that use in the country only is relevant. The Group of South Africa mentions that the secret use of an invention on a commercial scale in the Republic is considered prior art for the purposes of assessing novelty. The strictest rules can be found in Egypt. Descriptions, drawings and the public use must have occurred in Egypt during the past 50 years before the application of the younger patent. The Korean Group states that prior art also comprises information which was available to the general public through electronic communication means such as the Internet.

1.3 *Which guidelines other than those given by law are used to determine whether a piece of prior art has been disclosed?*

Most countries do not know specific guidelines which could serve for the assessment of novelty and inventive step. The European Patent Office has issued guidelines for the examination proceedings. These guidelines are also followed by examiners in Argentina. In general, one can state that the accessibility by the public is sufficient for a disclosure and

that no actual access is required (e.g. explicitly mentioned by the Spanish and the Israeli report). The Dutch Group refers to Art. 39 TRIPS. A general definition is given by the UK report: a disclosure means passing on information from one party to another unfettered by confidentiality obligations. Furthermore, the disclosure has to be enabling to work the invention. As mentioned earlier, the JPO has issued Operational Guidelines on Treatment of Technical Information disclosed on the Internet as Prior Art.

2. Criteria for disclosure

2.1 Means of disclosure

What are recognized means of disclosure? Are there additional requirements for certain ways, such as oral disclosure or disclosure by use, compared to disclosure through written documents?

It is unanimously stated by the Groups that, in general, every means can lead to a disclosure. This includes, among others, written descriptions, drawings, photographs, oral descriptions, electronic documents or the use of a technology. In most cases, there are no additional requirements for oral disclosures. In some countries (Bulgaria, Egypt, the US) oral disclosure must be corroborated by other means of evidence. The Brazilian Group points out that the Brazilian Patent Office only accepts documentary evidence. The Australian, the French and the UK Groups explicitly observe that oral disclosure may lead to problems of evidence, but that this does not affect the quality of oral disclosures as such.

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?

The time of disclosure has various facets. One aspect relates to time limits during which an application has to be filed after a disclosure. This does not only touch upon questions of the grace period but concerns also exceptions from novelty destroying disclosures such as exhibitions or the abuse of third parties to the disadvantage of the applicant. In these cases, novelty is not affected if the abuse has occurred no later than 6 or 12 months before the application. Similar rules are applicable for disclosing the invention at a recognized exhibition according to the 1928 Convention on International Exhibitions. The Spanish Group also mentions that trials carried out by the applicant are not detrimental to novelty either, as long as they do not involve operation or a commercial offer of the invention.

Notwithstanding the foregoing, it is the almost unanimous observation of the Groups that there are no time limits for a disclosure prior to the application. An exception is reported from the Egypt Group. A disclosure which dates back for more than 50 years prior to the application is irrelevant if it has not been used or described in Egypt during that period of time.

A number of reports state that the fact that information has been disclosed only a long time ago may be an indication for an inventive step (Brazil, Canada, France, Germany, Israel, The Netherlands, Norway, Spain). According to the Italian report, very old prior art may be relevant if, at the time of disclosure, adequate means were available to carry out the invention. The Swiss Group reports that prior art is not considered if it has not affected the technological progress and if it has been forgotten. The US Group mentions the concept of "lost art". This term refers to prior knowledge or prior use which has become unavailable due to a lack of evidence.

2.3 Place of disclosure

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)?

With regard to patents the vast majority of the Group reports state that the place of disclosure is irrelevant. Again the Egyptian report mentions that only disclosure in Egypt may be considered as prior art. However, this also refers to disclosure on the Internet so that in fact any information placed on the Internet worldwide will be considered also in Egypt. According to the Korean report a disclosure by use is only relevant if it occurred in Republic of Korea. By US standards prior art from outside the US is only relevant if it is embodied in a patent or a printed publication.

As far as utility models are concerned prior art by use may in some countries only be considered if it occurred in that respective country (Germany, Hungary, Argentina).

Some of the Groups have given a statement to the question whether the disclosure must be intentional or whether an accidental disclosure constitutes prior art as well. The Brazilian, Canadian, Danish, Finnish, German, Hungarian, Paraguayan, Romanian, Spanish and US Groups state that the intention to disclose is not required. These countries apply an objective standard of disclosure. On the contrary, a subjective standard can be found in India where an accidental use does not constitute prior art.

Another aspect is the applicable law for determination whether a disclosure has occurred. This touches upon the rules of International Private Law (conflict of laws). Various Groups suggest to apply the law of the country where novelty is assessed also for the determination of a disclosure (Canada, Denmark, Finland, Germany, Hungary, Israel, Italy, Norway, Paraguay, Poland, Romania, Singapore, South Africa, Spain and Venezuela). On the contrary, the Indian report states that the law of that country should be applicable where the publication occurred. According to the Dutch Group the rules of International Private Law may lead to a situation where a court has to apply different sets of rules in different cases. The UK Group observes that what constitutes a disclosure unfettered by confidentiality obligations may be dependent on contract law or employment law in the country where that disclosure took place.

2.4 *Personal elements*

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?

With regard to disclosures made by the applicant one distinction from third party disclosures has to be made in those countries which provide for a grace period. As mentioned in section 1.2 above this topic should be excluded from the discussion. The Swedish Group observes that - although Swedish law requires absolute novelty - a test performed by the applicant even in a public environment may exceptionally not be harmful for novelty under certain conditions. The conditions are that such tests are necessary to complete the invention, that all reasonable measures are taken to restrict public access and that the tests are not carried out for a longer time and to a larger extent than what is considered defensible with regard to the character of the invention.

It is the general view of the Groups that a disclosure also takes place if the disclosing party was bound by a confidentiality agreement. This is part of the concept of absolute novelty. Various Groups observe that an exception is made when the disclosure constitutes an abuse according to the national laws (Finland, France, Germany, Hungary, Israel, Italy, The Netherlands, Norway, South Africa, Singapore, Spain, Sweden, Switzerland, the UK). The Argentinian Group is of the opinion that a disclosure should not be considered as prior art if the disclosing party was bound by a confidentiality agreement.

With regard to errors, one has to distinguish between errors in the disclosed information and errors in the disclosure itself. In this context, only errors in the information should be considered. Such errors are not reported to have been the subject of detailed case law. There is quite a split view among the Groups as to the treatment of errors in this context. The Australian Group points out that it is merely a question of fact. The Argentinian and the Finnish Groups state that a decision has to be made on a case-by-case basis. Some

Groups find that errors should not be taken into account as prior art (Paraguay, Switzerland, Venezuela). According to the Danish, the French, the Dutch and the UK Groups, obvious errors are disregarded as a prior art disclosure whereas otherwise errors are considered prior art based on the practice of the EPO. The Canadian, the German, the Hungarian and the Korean Groups hold errors in the disclosure irrelevant. The German Group observes that errors do not establish prior art if they make the disclosure not understandable.

2.5 *Recipient of the information*

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

It is the common view of the Groups that the answers to this question are based on the principle that a disclosure only establishes prior art if the information is accessible by the public. The Australian Group again makes reference to the “common general knowledge”.

The vast majority of the Groups state that it is irrelevant if the recipient of the information understands it as long as the ordinary (average) person skilled in the art can understand the information. The Dutch, the South African and the US Groups observe in different words that the information must enable the public to reproduce the information (“enabling disclosure”). With regard to oral disclosures the Danish Group finds that information is also disclosed if the recipient is able to pass on the information to a third person who understands it even if the recipient himself/herself does not understand it. According to the UK Group an oral disclosure only affects novelty if the audience is capable to understand the information.

Additional steps such as disassembly or reverse engineering do not prevent a public disclosure in the view of most Groups. The Dutch Group states that every feasible method is allowed to obtain further information. The German Group observes that an exception from this principle is made if the reverse engineering requires unreasonable efforts which are unlikely to be taken. According to the Japanese Group the question should be answered on a case-by-case basis. If the additional steps of reverse engineering or disassembly are simple and well-known to the ordinary skilled person in the art, this will be detrimental to novelty as opposed to cases in which the embodiment is destroyed or the invention cannot be understood despite reverse engineering or disassembly. The Swiss Group has a similar view. Novelty is not affected if the invention can only be detected by means of reverse engineering or disassembly if they lead to a destruction of the device.

On the other hand, the Argentinian, the Brazilian, the Portuguese and the Venezuelan Groups express the general opinion that no public disclosure has occurred if additional steps are necessary to obtain the information.

Most Groups state that there is no public disclosure if the information is revealed to a person bound by a confidentiality agreement. The Groups of Bulgaria, Finland, Portugal and Venezuela observe that no general rules concerning confidentiality exist. The Italian report refers to the guidelines of the EPO. Implied confidentiality is specifically mentioned by the reports of the Brazilian and the Israeli Groups.

3. **Disclosure through new media**

3.1 *General notes*

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 world-wide web, chat groups or forums, e-mail and others?

It is the common observation of the Groups that a paperless information, e.g. in an electronic network or through the Internet, constitutes a sufficient disclosure to affect novelty or

inventive step. The medium is not a limiting factor as long as the information is made publicly available. The Bulgarian and Romanian Groups point out that for a paperless information to constitute a sufficient disclosure it is required that the date of disclosure is available. The Italian Group further requires that the source of disclosure is identifiable.

Most of the Groups which answered the question, save Brazil, Denmark, Japan and Spain, find that there are no specific requirements compared to other forms of disclosure. None of the Groups suggests that a disclosure through new media has to be considered as a separate kind of disclosure. While the Finnish Group observes that such a disclosure should be treated in the same way as an oral disclosure, the Hungarian, Swiss and the US Groups compare a disclosure through an electronic network to a printed publication. In connection with utility models the German Group mentions the relevance of this distinction due to the limited definition of prior art which only comprises written descriptions or the use in Germany. The Brazilian, Danish and Spanish Groups state that due to the peculiarities of electronic networks proof of disclosure is required. As one possible manner of establishing proof the Brazilian Group proposes to print out a hard copy in the presence of a notary public. Denmark suggests to obtain a certificate from the publisher concerning the contents and the publication date of the paperless information.

Only three Groups (Canada, Paraguay, Portugal) find (without giving an explanation) that there are no differences with regard to various forms of networks or communications, such as the world-wide web, chat groups or forums, e-mail and others. The majority of the Groups sees differences with regard to the various forms of these communications. Some Groups (Argentina, Japan, Norway, Singapore) emphasise that the crucial question is to take into account in each case the level of accessibility of the network and to determine whether the information has been made available to the public as required under the law.

Concerning the world-wide web and chat groups or forums there is a consensus among the Danish, French, German, Hungarian, Norwegian, Spanish, Swiss and US Groups that they are generally open and unrestricted and that disclosures through the Internet thus qualify as being accessible to the public. Only one Group (Egypt) is of the opinion that chat groups are not public. The Finnish Group points out that the access to some web sites and chat groups or forums may be restricted by passwords or payment requirements. With regard to intranets and extranets the Finnish Group mentions that they are by definition networks which are limited with respect to access by use of passwords and other technical solutions.

Regarding private e-mail communications some Groups (Denmark, Egypt, Germany, Hungary, Spain, Switzerland, UK, USA) believe that they are not publicly accessible and should thus not constitute sufficient disclosure to affect novelty or inventive step. The Dutch, Finnish and Japanese Groups point out that e-mail communications may only be considered private if they are addressed to specified recipients. Denmark and Finland stress that communication between private individuals is protected by the constitutional right of privacy. If e-mails are addressed to an unspecified group of recipients (mailing lists) however the information would be regarded as publicly accessible. In some cases the employer by virtue of the law may be allowed to access the e-mail communications of an employee and this might also lead to a disclosure beyond the perimeters of private personal communications. Some Groups (Argentina, France, The Netherlands) find that e-mails should not be considered publicly accessible if the sender takes specific measures to prevent disclosure, e.g. by use of encryption, passwords or confidentiality limitations imposed on the recipient. The Norwegian Group points out that sending a private e-mail to an incorrect address may damage novelty. The Finnish Group mentions that further distributing of a private e-mail by the recipient may possibly constitute evident abuse and hence not affect novelty.

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?

Three Groups (Italy, Paraguay, Romania) are of the opinion that encrypted information does not constitute a prior art disclosure. Many Groups (Brazil, Denmark, Germany, The

Netherlands, Poland, Spain, USA) recognise that encryption constitutes an a priori assumption that the information is not publicly available. The Australian Group points out that, practically speaking, encrypted information is more likely to avoid accidental disclosure. Depending on the circumstances, however, encrypted information may nevertheless constitute a disclosure. The Canadian, Danish, Finnish, Hungarian, Indian, Israeli and Japanese Groups point out that if a decryption tool is publicly available or the relevant public knows how to decipher the encrypted information it becomes publicly accessible. The Swiss Group states that intentionally decoding encrypted information may constitute evident abuse and hence not affect novelty. According to the French Group report the question of whether the encrypted information is publicly accessible depends on whether the recipient is bound by a confidentiality obligation. The Finnish, South African and Swedish Groups are of the opinion that encryption in itself may be used as evidence of the obligation of confidentiality imposed on the recipient of information.

Only the Groups of Portugal and Venezuela believe that passwords, search engines and payment requirements have no relevance. The majority of the Groups finds that passwords, search engines and payment requirements may have a significance in determining whether information has been available to the public. With regard to passwords some Groups (Germany, The Netherlands, South Africa, Spain, Sweden) are of the opinion that the object of a password is to restrict access and that it thus entails an obligation of confidentiality. On the other hand, the Group reports of Brazil, Denmark, Finland, India, Italy, Japan and Switzerland point out that if there are no restrictions to obtain a password the information is publicly available. According to the Group report of France the question again depends on whether the recipient is bound by a confidentiality obligation.

Concerning search engines and payment requirements the general view among the Groups is that if information can be found with the help of a search engine this constitutes an a priori assumption that the information is public. Payment requirements do not hinder a public disclosure. The Brazilian Group observes that payment requirements may nevertheless prevent information from becoming public if the cost is so high as to create a true obstacle to the access. One Group (South Africa) is of the opinion that payment requirements provide evidence that the use of such information is intended to be restricted to the parties concerned.

3.3 *Place of disclosure*

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?

Every country which answered this question, save Egypt and the United States, states that the geographical place is irrelevant. The Groups of Australia and Finland point out that information made available through the Internet may be considered available world-wide. The German Group states that for the assessment of novelty and inventive step for utility models one has to determine whether a disclosure over the Internet is considered as a written description or as a use. Only in the latter case the place of disclosure is relevant, since the use has to happen in Germany. The Dutch and the Swedish Group reports mention that the place of disclosure may be relevant for determining the date at which the disclosure became part of the state of the art. When in New Zealand a disclosure is put on the Internet in the morning, then it may be downloaded from the Internet the day before in Europe and in the United States owing to the time difference. The Dutch Group is of the opinion that the effective date is the local date the material was put on the Internet at the place of disclosure.

The Australian, Canadian, Egyptian, Hungarian, Japanese, Portuguese, Spanish and US Groups find that the place of disclosure is the place where the information can be accessed. The Indian Group however is of the opinion that the place of disclosure is the place where the server is located.

It is the common observation of most Groups which answered the question (Argentina, Australia, Denmark, Finland, Hungary, Paraguay, Portugal, Romania, Spain, Switzerland, UK) that the mere fact that a web site can be accessed in a certain place is sufficient for a disclosure in that place and that there should be no additional conditions or requirements.

3.4 *Timing of disclosure*

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

Some Groups (Argentina, Egypt, Norway, Portugal, Paraguay, South Africa, Sweden) find that there are no requirements for the timing and duration of information available through electronic means. The Australian, Finnish, German, Spanish and Swiss Groups emphasise that timing is essential as the date of the disclosure has to be prior to the filing date. Four Groups (Argentina, Canada, Switzerland, UK) also observe that proof of date is critical in the Internet. Regarding duration the views are split. Some Groups (France, Germany, Spain, Switzerland) believe that the duration of information available through electronic means is not relevant. The other Groups which answered the question find that a very short period of availability might render the disclosure not public. Among these Groups there are two views. The Groups of Argentina, Australia, India, Republic of Korea, Sweden and USA state that the duration should be long enough for a skilled person to be able to access and understand information. On the other hand, the Groups of Brazil, Canada, Hungary, Paraguay and Singapore consider that the duration should be long enough for the public to be able to download or print the information in order to establish evidence.

With regard to archives four Groups (Egypt, Japan, Portugal, Republic of Korea) are of the opinion that archives are not necessary. The Groups of Australia, India, Paraguay and Romania however find archives necessary to provide evidence. The Australian Group mentions that the Australian Patent Office rejects electronic material if the form of the material at the relevant priority date cannot be established. The Groups of Canada, Finland, Germany, Hungary, Italy, Norway, Switzerland and USA find archives desirable to provide evidence. The Swiss Group stresses that certified archives would be desirable. The Groups of Argentina and Canada mention that archives are difficult and expensive to establish.

3.5 *Questions of evidence*

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?

It is the common view of most Groups (Argentina, Australia, Brazil, Canada, Denmark, Finland, France, Germany, Hungary, India, Israel, Japan, The Netherlands, Norway, Paraguay, Portugal, Republic of Korea, Singapore, South Africa, Sweden, Switzerland, UK, USA, Venezuela) that the party claiming that a specific piece of information was disclosed on the Internet should have the burden of proof. It is thus the patent office in patent prosecution and the party seeking to invalidate the patent in opposition and nullity proceedings that have the burden of proof. The Group of Argentina states that if the applicant (in prosecution) or patentee (in nullity proceedings) has information easily available to him burden of proof could shift to him.

The majority of the Groups which answered the question (Argentina, Australia, Brazil, Canada, Denmark, Finland, France, Germany, India, Norway, Portugal, Republic of Korea, Spain, Sweden, Switzerland, UK) finds that the Internet does not require rules different from those already existing for oral disclosure or the disclosure in other ways. Two Groups (France, Sweden) emphasise that although the traditional rules are applicable the peculiarities of the Internet should be taken into consideration. Four Groups (Hungary, Uruguay, Romania, Venezuela) note that the Internet requires more stringent rules than those al-

ready existing for oral disclosure or the disclosure in other ways because of the particularities posed by Internet, namely because of likely manipulation.

There is also consensus among most Groups which answered the question (Australia, Brazil, Canada, Finland, Germany, Hungary, Paraguay, Switzerland, UK, USA, Venezuela) that there should be no different levels of evidence for different ways of disclosure.

Some Groups (Hungary, Japan, Paraguay, Romania, Venezuela) believe that the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosures. The Japanese Patent Office has issued guidelines for minimising the possibility of manipulation of information available through the Internet. Information which was obtained from a web site of an official or quasi-official organisation which is not likely to be manipulated is presumed to be original. If the examiner suspects possible manipulation of the content of the web site he may contact the responsible operator of the web site to confirm the reliability of the information. Once the examiner decides to cite the information he prints out the information and inscribes necessary information such as name of the examiner, time and date of the access and URL of the web site on to the printed document. The paperless information cited in the Office Action is thereafter stored in the database of the Japanese Patent Office.

The Groups of Italy and Spain propose creating special means of evidence (e.g. certificates from institutions managing media) to warrant the authenticity of Internet disclosures. The Groups of Argentina, Australia, Canada, Finland, Germany, India, Sweden, Switzerland and UK find that there are no specific rules required for this kind of disclosure. The Group of Canada points out that an oral prior art disclosure is even less tangible than a prior art disclosure through new media. The Groups of Australia, Finland, Germany, Sweden, Switzerland and UK recognise however that digital information may be easily manipulated and thus propose that this should be taken into account when estimating the evidential value of the information.

4. Miscellaneous

Some Groups (Australia, Finland, France, Italy, UK) stress their support of the current principles of prior art disclosure. On the other hand, the Group of Paraguay calls for the development of specific rules relating to disclosures through the Internet. The Group of Finland notes the need for practical measures to address manipulation, e.g. by use of third party services for the purpose of storing and verifying Internet disclosures.

Various reports (Australia, Brazil, Denmark, Germany, Italy, Norway, Republic of Korea, Romania, Sweden, Switzerland, UK) call for a harmonisation in this field. The Groups of Brazil, Germany, Korea and Romania call for a common definition of the standards of prior art disclosure, namely for a common definition of prior art regardless of place and means of disclosure. For that purpose, Brazil proposes to adopt Article 8 of the draft SPLT of September 24, 2001. The Group reports of Australia, Germany and Switzerland stress the need for harmonisation of the substantive requirements of novelty and inventive step and the adoption of a grace period. The Groups of Denmark, Germany, Switzerland and UK suggest that a harmonisation should in any event be to the standard of the EPO.

The Group report of UK proposes that the question of what constitutes an enabling disclosure be further studied in the context of AIPPI.

Conclusions

The reports submitted by the Groups show that - at least with regard to patents - there is already unanimity to a great extent as to what constitutes a disclosure of prior art. It should be determined whether the proposal of WIPO in the SPLT can be taken as a basis for a definition of relevant prior art and its disclosure, i.e. an information made available to the public in any form anywhere in the world.

Personal elements are important. They comprise criteria of the person who discloses the information as well as of the recipient of the information. Not every distribution of information may lead to a novelty destroying disclosure to the public depending on the circumstances. Questions of abuse and of confidentiality obligations have to be considered.

The disclosure through new media touches on problems of paperless information. One crucial question is how such a disclosure has to be treated, namely as an oral disclosure, as a disclosure through a printed publication or as a disclosure by use. Questions of evidence also play an important role in this context. It should be considered whether the existing principles can be applied also for disclosure through new media or whether new principles have to be developed.

Finally, AIPPI should question whether the criteria for an enabling disclosure require further studies.