

**Report Q167**  
**by the UK Group**

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

**Introduction**

There is no provision, at present, in the UK for utility models and the report therefore concentrates on the effect of novelty and inventive step requirements for Patents. Our answers are principally confined to the position under the UK Patents Act 1977 and the European Patent Convention as interpreted by the English Courts and the Technical Boards of Appeal of the European Patent Office.

**1. Determination of prior art**

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

The current situation in the UK (under the EPC and the UK Patent Act) is that any disclosure made available to the public anywhere in the world prior to the priority date is relevant to novelty and inventive step.

*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 no difference in the relevance of a piece of prior art for novelty and inventive step considerations except in relation to certain copending patent applications in the UK (including European and PCT patent applications designating the UK). Co-pending patent applications which have an earlier priority date and which are eventually published (but are not published at the priority date of the patent application in question) are relevant for novelty consideration. Co-pending patent applications which are not eventually published are not relevant either for novelty or inventive step.

Under the proposals for the Community Patent Convention an unpublished UK patent application (which eventually publishes) will be relevant to the novelty of a CPC application. However, an unpublished UK national patent application is only relevant to the novelty of the UK designation of a European application (although the EPO does not examine the effect of such copending national applications) or to another UK application.

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

This is defined in Section 2 (2) of the UK Patents Act:

The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

1.3 *Which guidelines are used to determine whether a piece of prior art has been disclosed?*

Information is disclosed when its disclosure from one party to another is unfettered by confidentiality obligations. The disclosure must be enabling. A disclosure is enabling if a skilled person can reproduce its teaching.

This is supported by the EPO and UKPO guidelines and case law (Milliken [1996] FSR 292, Asahi [1991] RPC 485).

## **2. Criteria for Disclosure**

### 2.1 Means of disclosure

*What are recognised means of disclosure?*

Written or oral disclosure or use in any way

*Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents?*

The only difference in relation to the types of disclosure is the requirement for proof (see 3.5). Oral disclosure is more difficult to prove, particularly before the EPO, see for example, T1212/97, as is proof of prior use where the EPO require what occurred to be proved “beyond reasonable doubt”. The obscurity of a piece of prior art is not relevant although this could affect whether it is part of the common general knowledge and consequently can reasonably be read with another document (T206/83), Windsurfing v Tabur Marine, [1985] RPC 59 and Hoechst-Celanese v BP, [1997] FSR 547.

*If certain means of disclosure are not recognised either by law or in practice, what are the reasons?*

Not relevant.

### 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?*

See the answer to Q2.1. When the disclosure took place is irrelevant, except if its age affects whether it can be considered as part of the common general knowledge.

### 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)?*

See the answers to Q1.1 and 1.3. What constitutes a disclosure unfettered by confidentiality obligations may be dependent on contract/employment law in the country where that disclosure took place, *Lux Traffic v Pike Signals* [1993] RPC 107. Disclosure at an international exhibition falling within the terms of the Convention on International Exhibitions is permitted under Section 2(4)(c) of the UK Patents Act provided a patent application is filed within six months of the Exhibition.

### 2.4 Personal elements

*What differences do the Groups observe with regard to the person who discloses the prior art?*

There are very limited provisions in Section 2(4) of the UK Patent Act in relation to exceptions to what constitutes a disclosure as outlined in the answer to Q1.1. Primarily, these relate to disclosed information that was illegally acquired from the applicant (or otherwise published in breach of confidence).

*Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement?*

See the answer to Q2.3 above.

*How are errors in the disclosed information treated?*

When it is clear from contemporaneous evidence that the literal disclosure of a document is erroneous, then the erroneous disclosure is not part of the state of the art (T77/87).

### 2.5 Recipient of 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?*

Oral disclosure to an audience that is not in a position to understand the invention does not constitute a disclosure to that audience prejudicial to patentability, as outlined in Q1.1 , (T877/90).

If the invention is provided to a third party in such a manner that its nature can be determined by disassembly of elements or reverse engineering then this constitutes a prejudicial disclosure (G1/92), although the date of disclosure is the date at which this reverse engineering could have taken place, (T461/88).

*Are there general rules providing for the effect of confidentiality or implied confidentiality?*

See the answer to Q2.3 above. Mere encryption of information of itself does not make this information confidential, Mars UK v Teknowledge [2000] FSR 138.

### **3. Disclosure through new media**

#### **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 World-wide Web, chat groups or forums, e-mail and others?*

The key criterion is whether the information is made available to the public (e.g. as in Q1.1). Whether disclosure has taken place will depend on the individual facts. Information sent by letter is considered to be not available to the public whilst that on a postcard is. It is believed that e-mail correspondence is closer to the former but there is not yet case law on this.

Information on the world-wide web is considered published unless the information is protected in some way (e.g. by restricting access).

#### **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?*

See Q3.1 and Q1.3 also Q2.5

#### **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 certain place sufficient for a disclosure in that place or should there be additional conditions or requirements?*

The place of disclosure is irrelevant, see Q2.3. There are no 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?*

The issue is one of evidence, if it is possible to prove that the information was available, however temporarily, then it is a prejudicial disclosure. It is no different from a book appearing on library shelves even though nobody may have known it was there (T381/87).

### 3.5 Questions of evidence

*Who should have the burden of proof that a specific piece of information was disclosed on the internet?*

The party attempting to invalidate a patent should bear the burden of proof.

Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways?

The outcome of the Court's attitude in relation to Q3.1 may be relevant here but the answer is probably no.

*Should there be different levels of evidence for different ways of disclosure?*

No.

*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?*

No.

## 4. Conclusion

The current definition of prior art (prejudicial disclosure) applied in the UK is simple, straightforward and supported by case law, and consistent with that applied by other members of the EPC. In addition, it is believed that the standards applied by the EPC signatories and Japan are moving closer together. Consequently, it is felt that any harmonisation should be to the standard applied by the EPO.

The question of what constitutes an “enabling” disclosure is an important one which merits further study by AIPPI.

### **Summary**

UK law on novelty and inventive step is in accordance with that of the other member states of the European Patent Convention. Decisions from the UK Courts are consistent with those from the Boards of Appeal of the European Patent Office.

Any enabling disclosure, be it written or oral or in electronic form, is relevant to novelty and inventive step. Information is not disclosed if it is in breach of confidentiality obligations. There are no fundamental differences between written and oral disclosures and those through new media although the evidence required to prove disclosure may differ.

Any international harmonisation in this area should be to the standard applied by the EPO.

### **Résumé**

La législation britannique sur la nouveauté et l'activité inventive est en conformité avec celle des autres états membres de la Convention sur le brevet européen. Les décisions des tribunaux britanniques sont conformes à celles des Boards of Appeal de l'Office européen des brevets (OEB).

Toute “enabling disclosure” (divulgation en vue de réaliser l'invention), qu'elle se présente sous forme écrite ou orale ou électronique, se rapporte à la nouveauté et l'activité inventive. Les informations ne sont pas divulguées si elles sont en rupture des obligations en matière de confidentialité. Il n'y a pas de différences fondamentales entre les divulgations écrites et orales et celles faites par l'intermédiaire de nouveaux moyens, bien que les preuves requises pour prouver la divulgation puissent être différentes.

Toute harmonisation internationale dans ce domaine devrait être suivant la norme appliquée par l'OEB.

### **Zusammenfassung**

Das englische Recht bezüglich Neuheit und erfinderischer Tätigkeit stimmt mit dem der übrigen Mitgliedsstaaten des Europäischen Patentübereinkommens überein. Die Urteile der englischen Gerichtshöfe stehen mit denen der Beschwerdekammern des Europäischen Patentamtes in Einklang.

Für jede ausführbare Offenbarung, gleich ob sie schriftlich, mündlich oder in elektronischer Form vorliegt, sind Neuheit und erfinderische Tätigkeit maßgeblich. Informationen werden nicht offenbart, wenn dies eine Verletzung der Geheimhaltungspflicht bedeuten würde. Es bestehen keine grundlegenden Unterschiede zwischen schriftlichen und mündlichen

Offenbarungen sowie denen, die mittels neuzeitlicher Medien vorliegen, jedoch können die erforderlichen Beweismittel für die Prüfung der Offenbarung variieren.

Jede internationale Harmonisierung auf diesem Gebiet sollte dem Standard entsprechen, der vom EPA angewendet wird.