WIPO

STANDING COMMITTEE ON THE LAW OF PATENTS
Sixth Session
Geneva, November 5 to 9, 2001

INFORMATION PROVIDED BY MEMBERS OF THE STANDING COMMITTEE ON THE LAW OF PATENTS (SCP) CONCERNING THE DEFINITION OF PRIOR ART BRIEF SUMMARY

Prepared by the International Bureau

INTRODUCTION

1. During the fifth session of the Standing Committee on the Law of Patents (SCP), held in Geneva from May 14 to 19, 2001, the SCP requested the International Bureau to prepare a questionnaire concerning the definition of prior art in order to collect information regarding national and regional practices, and to receive suggestions for the redrafting of the draft Substantive Patent Law Treaty (SPLT) (see paragraph 84 of document SCP/5/6 Prov. 2). Pursuant to the conclusion of the Standing Committee, a questionnaire concerning the definition of prior art was sent to all States party to the Paris Union and/or Member of the World Intellectual Property Organization as well as to the regional patent offices observers of the SCP.

2. As of October 20, 2001, replies had been received from the following States and regional offices: Algeria, Australia, Austria, Barbados, Belarus, Belize, Burkina Faso, Canada, Congo, Costa Rica, Croatia, Cuba, Cyprus, Czech Republic, Estonia, Finland, France, Germany, Ghana, Greece, Hungary, Ireland, Japan, Kyrgyz Republic, Lithuania, Mauritius, Mexico, Morocco, New Zealand, Norway, Panama, Philippines, Portugal, Republic of Korea, Republic of Moldova, Republic of Slovenia, Romania, Russian Federation, Senegal, Slovakia, Spain, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, Turkey, United States of America, Eurasian Patent Office, European Patent Office (48).

3. The present informal paper summarizes the answers received to the questionnaire without reproducing all the comments made in the responses.

SUMMARY OF THE ANSWERS RECEIVED

Definition of prior art

Q1. What is the definition of prior art under your national/regional law?

[Summary of responses]

4. As it was pointed out by one country, the term "prior art" or "state of the art" is used in a different sense in different national laws. In some countries, as in Article 8 of the draft SPLT, these terms are used in a general sense, i.e., the entire sphere of information or art one (or more than one) of the items of which may be taken into account for the determination of novelty (inventive step/non-obviousness). On the other hand, in other countries, these terms are used in the sense of "usable prior art," i.e., the information or the art which can be used to defeat the patentability of a particular invention claimed in an application. This difference is highlighted, in particular, in the responses under Question 6 (see paragraph 18 below). In Article 8 of the draft SPLT, the International Bureau's intention is to give the term the broad meaning explained above.

5. According to almost all the responses received, prior art can be characterized by the following:

(i) Prior art must be accessible to the public.
(ii) Prior art is any information available in written form, as an oral presentation or in connection with any use. In some national legislation, the words "or in any other form" are added in order to cover all possible forms of disclosure.
(iii) Prior art must be accessible to the public before the filing date of the application concerned, or, where priority is claimed, before the priority date of that application.

6. Further, as regards the place of disclosure of prior art, a large majority of the responses expressly indicated that any form of disclosure anywhere in the world constitutes prior art. Some others did not specify the conditions as regards the place of disclosure of the information. One country indicated that, as far as inventions publicly known or carried out are concerned, those inventions constituted prior art only where they were publicly known or used in that country. Another country replied that a prior use outside that country would not form part of prior art, unless it was documented.

7. One country mentioned that the following four categories of prior art existed:

(i) Situations where the invention was invented by another before the invention thereof by the applicant;
(ii) Situations where an activity took place before the defined period of time (one year) preceding the filing of the application;
(iii) Special statutory situations where the applicant did not invent the subject matter sought to be patented;
(iv) Other non–statutory sources of prior art, including admissions by the applicant.

8. A number of countries also mentioned the prior art effect of an earlier application which was filed before, but published after, the filing date of the application in question. Only five countries explicitly mentioned the treatment of international applications under the Patent Cooperation Treaty (PCT) filed before, but published after, the filing date of the application concerned, though this does not necessarily mean that PCT international applications are not considered as earlier applications. Two countries indicated that the contents of a PCT international application formed part of prior art as from the international filing date (or priority date, where applicable) if the requirements in respect of entering the national phase were met. Three countries referred to the designation of the country concerned with respect to prior art effect of PCT international applications as earlier applications.

Availability to the public

Q2–1. *What does "availability to the public" mean? If a "reasonable possibility" to access the information is enough to qualify the information as being prior art, how is the term "reasonable possibility" interpreted?*
Q2–2. *What does "the public" mean? Could it be only one person? Is it a person skilled in the art or could it be any person?*

[Summary of responses]

9. The level of availability of the information to the public varies from a pure theoretical possibility of obtaining the information to an actual access to the information. The responses showed different levels of availability, though no response required an actual access to the information. The following illustrates various interpretations of the term "available to the public" collected from the responses:

- A theoretical possibility exists in the sense that there are no factors that severely restrict the access;

- The public has the possibility to learn about the content of the information;
- Objective circumstances exist that the information would be consulted by any person using the means put in place;
- The public has the possibility to acquire the information by consulting sources open to it;
- The disclosure must be a deliberate one on the part of the patent holder.

10. It appears from the responses that the availability of the information to the public means there is no bar of confidentiality restricting the use or dissemination of the information acquired. One country indicated that the information was considered to be accessible to the public once a group of persons could not be controlled by the information holder any longer because of the size, the character or the composition of such group.

11. As regards the term "public," a majority of countries considered that the information was made available to the public if an unspecified person, who could be a single person and not necessarily a person skilled in the art, had the possibility to access the information. However, a minority indicated that it was "a fairly large or a not precisely defined group of people," "any person who understands what has been disclosed," or "a circle of persons to whom the information concerned might be of interest."

12. One country indicated that the availability to the public was construed differently where the information was contained in a printed publication and where the information was publicly known or publicly used. In the context of a printed publication, the term "public" refers either to the public as a whole or to a portion of the general public that is interested in the subject matter contained in the document. On the other hand, if the information is used without limitation or restriction, or injunction or secrecy, such use is public, even if that use and the knowledge of it are confined to one person. Thus, in the latter case, public availability is determined by the extent of control placed on the access.

13. Reference is also made to the responses to the hypothetical cases Q8–1 to Q8–8 (see paragraphs 20 to 28 below).

Evidence of non–documentary disclosure

Q3. *Where a disclosure was made in non–documentary form, such as by oral communication, by display or through use, what degree of evidence is required to prove the timing and the contents of such non–documentary disclosure? What are the standards applied under the applicable law?*

[Summary of responses]

14. From the responses, it appears that, in general, the authorities must be convinced as regards the timing and contents of the non–written disclosure. However, the admissible evidence to prove the timing and contents of such disclosure is different from one country to another. Some countries require that the non–documentary disclosure be substantiated by a written document such as a written statement, a subsequent document reproducing the date and the contents of the non–documentary disclosure or any other documentary proof which is accepted under the applicable law. In some other countries, any kind of evidence that conveys the information necessary for determining the date and the scope of the disclosure, including oral testimonies, is accepted.

15. Many countries indicated that the general laws of administrative procedures and civil procedures are applicable. However, one country explained that a different standard of evidence would be applicable in Court proceedings and in office proceedings, or in *inter partes* proceedings and *ex parte* proceedings

before the office. Another country said that non–documentary disclosures could not be cited during the examination procedure. They could, however, be raised in pre–grant opposition and revocation proceedings if supported by sufficient evidence.

Determination of the date of publication

Q4. *If the date of publication is not specified, which would be the relevant date on which the publication is considered to have been made available to the public in the following cases?*

> ***Q4–1:*** *Only the year of the publication is specified;*
> ***Q4–2:*** *Only the year and the month of the publication are specified.*

[Summary of responses]

16. A majority of the responses said that, if only the year or the month, but not the specific date, of publication was available, the publication was presumed to have been available at least on the last day of the year or the month. However, some countries indicated that their law did not provide any provision for such assumption and that publications which did not adequately specify the date of publication were not used as a basis for determination of novelty/inventive step (non–obviousness). Two countries replied that the first day of the specified year or month should be considered as the relevant date.

Q5. *Where the publication itself does not provide any information regarding the date of publication, would it be possible to establish the date on which a publication became available to the public by submitting evidence? If so, what kind of evidence is required? Is the degree of evidence in this case the same as the one required under Q3?*

[Summary of responses]

17. The responses unanimously indicated that it was possible to establish a date on which a publication became available to the public by way of submitting sufficient evidence. The nature and degree of evidence required are the same as those required under Q.3 concerning oral disclosures.

Enabling prior art

Q6. *Are there any qualitative conditions for information to become prior art? For example, does prior art have to enable a person skilled in the art to make or use the invention?*

[Summary of responses]

18. As mentioned in paragraph 4 above, the answer to this question might be different depending on how the term "prior art" is characterized under the applicable law. Most of the countries which responded positively to the above question referred to the prior art for the purpose of determining novelty. Therefore, as regards prior art in the sense of Article 8 of the draft SPLT, the responses suggest, as a general statement, that no qualitative condition is required for information to become prior art. With respect to the determination of novelty, it should be noted that draft Rule 14(1)(ii) of the Regulations under the SPLT provides that, for the determination of lack of novelty, the prior art must enable a person skilled in the art to make and use the claimed invention.

Multiple priority claims

Q7. *Can a claim have more than one priority date? For example, where each of several alternative embodiments (X, Y, Z) within one claim has been disclosed in a different earlier application on which a multiple priority is based (X in the earlier application A, Y in the earlier application B and Z in the earlier application C), for the purposes of determining prior art, which would be the relevant date for the determination of prior art?*

[Summary of responses]

19. A majority of the countries indicated that, where each of several alternative embodiments within one claim had been disclosed in a different earlier application on which a multiple priority was based, such a claim might have multiple priority dates, and that the prior art with respect to each embodiment should be examined versus each relevant priority date. However, some countries considered that a single claim could not have more than one priority date. One of them replied that the latest priority date was applicable in such a case. It should be noted that nine countries responded that the earliest priority date was applicable in this case, though it appears that there might have been some confusion between the relevant date for the purposes of the determination of prior art and the relevant date for the purposes of the calculation of the priority period with respect to multiple priority claims.

Hypothetical cases

20. The text of the questionnaire showing the number of replies given to the various questions is reproduced below together with a summary of the responses.

Q8. *Are the following examples considered as disclosures that constitute prior art? Please indicate why they are considered/not considered to form part of the prior art.*

Q8–1: *A doctoral thesis (only one copy exists in the world) is shelved in a library open to the public. It is not indexed or catalogued. Does the disclosure of the thesis constitute prior art?*

Yes: 28 **No: 8** **Others: 0**

21. One country indicated that the thesis formed part of prior art provided the "library open to the public" meant a reading room open to the public with an open–shelf library system. The reasoning of the negative responses is that, since the thesis is not indexed or catalogued, it can be accessed only by chance and there are no means to locate it. One office mentioned that if the thesis was the only technical document placed together with literature or children's books, it would not form part of prior art.

Q8–2: *A doctoral thesis (only one copy exists in the world) is shelved in a library open to a limited group of researchers. It is not indexed or catalogued. Does the disclosure of the thesis constitute prior art?*

Yes: 21 **No: 13** **Others: 2**

22. Many of the positive responses are subject to the condition that the limited group of researchers is not bound by confidentiality. Some of the negative responses are based on the fact that the thesis is not indexed or catalogued. Other negative responses indicated that the thesis does not constitute prior art because the access was restricted to a limited group of persons. Some others based their negative answers on both grounds. One country said that if the limitation was, for example, a group consisting of researchers from different universities and was bigger than just a couple of researchers, the thesis constituted prior art, while if the group, for example, was small and consisted of identified persons, it was not prior art.

Q8–3: *A doctoral thesis (only one copy exists in the world) is shelved in a library open to the public. It is indexed by index cards filed alphabetically by the name of the author. The index cards contain the names of the authors and the titles of the thesis. Does the disclosure of the thesis constitute prior art?*

Yes: 35 **No: 1** **Others: 0**

23. One country indicated that the thesis did not form part of the prior art because it was not indexed or catalogued in a meaningful way, or could not be located by means of the customary research aids available in the library.

Q8–4: *A doctoral thesis (only one copy exists in the world) is shelved in a library open to a limited group of researchers. It is indexed by index cards filed alphabetically by the name of author. The index cards contain the names of the authors and the titles of the thesis. Does the disclosure of the thesis constitute prior art?*

Yes: 23 **No: 11** **Others: 2**

24. As in the case of Q8–2, many of the positive responses are subject to the condition that the limited group of researchers is not bound by confidentiality. Most of the negative responses are based on the fact that the access is restricted to a limited group of persons. One country responded negatively because the thesis was not indexed or catalogued in a meaningful way, or could not be located by means of the customary research aids available in the library. One country said that, as in the case of Q8–2, if the limitation was, for example, a group consisting of researchers from different universities and was bigger than just a couple of researchers, the thesis constituted prior art, while if the group, for example, was small and consisted of identified persons, it was not prior art.

Q8–5: *A car is displayed at a factory for visitors. Although an engine inside the car was not exhibited, the guide would show the engine and explain the technical details to the visitors if they request him to do so. Does the engine constitute prior art?*

Yes: 33 **No: 4** **Others: 0**

25. Many of the positive answers were coupled to certain conditions that were different from one country to another, for example, that the guide and the visitors were not bound by confidentiality, that the timing and the contents of the oral disclosure could be proved, or that the oral disclosure was enabling. Three countries explained that the simple possibility of the guide answering the question was not sufficient for the engine to constitute prior art. One office indicated that the engine could be part of the prior art if documentary evidence showing that the presentation was available to any person was established.

Q8–6: *A ship is displayed at a quay for sale. Does a screw propeller of the ship, which is under water, constitute prior art?*

Yes: 29 **No: 6** **Others: 2**

26. Some of the countries that responded positively indicated that the screw propeller formed part of the prior art provided the visitors were able to see the screw propeller or they could be given any explanation about the screw propeller. Three countries that responded negatively expressly mentioned that it was not considered prior art because of the concealed feature of the object. Three countries considered that the fact that the ship was for sale would satisfy the requirement of "accessibility to the public." Further, two countries replied that if the quay was accessible to the public, for example in a public harbor, the screw propeller would constitute prior art. One country explained that, even if the screw propeller was hidden from view, as long as its use was without limitation, restriction or obligation of secrecy, it would be considered public use.

Q8–7: *One new portable phone is handed over from a manufacturer to a retailer, who is familiar with the technology of portable telephones, for a trial. The retailer is not bound by a confidentiality agreement. Does the technology used in the portable phone constitute prior art?*

Yes: 28 **No: 9** **Others: 2**

27. The countries that did not consider the technology used in the portable phone to constitute prior art questioned the fact that the phone was handed over to one chosen retailer. One country indicated that the answer would be negative provided the retailer did not show the phone to others. Another country explained that, according to its case law, if the retailer was considered as a necessary agent for the required experiment and if necessary arrangements had been taken to prevent third parties from acquiring the information, the technology was not considered prior art. One another country observed that if one had to dismantle or destroy the phone in order to decipher its internal technical features, these technologies would not form part of the prior art since the retailer did not have unlimited possession of the phone.

Q8–8: *One new portable phone is handed over from a manufacturer to his neighbor, who knows nothing about the technology of portable telephones, for a trial. The neighbor is not bound by a confidentiality agreement. Does the technology used in the portable phone constitute prior art?*

Yes: 21 **No: 13** **Others: 2**

28. Many of the negative responses were based on the fact that the neighbor did not understand the technology. One country mentioned that if the neighbor kept the phone to himself and tried it himself only, the answer would be negative. If, however, the neighbor took it to several persons who were capable to understand the technology, the answer would be positive.