

QUESTION 126

Methods and principles of novelty evaluation in patent law

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Q126

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Resolution

AIPPI

- CONSIDERING that novelty is a basic requirement of all states for the patenting of an invention;
- CONSIDERING that the criteria for determining novelty are not uniform for all states;
- CONSIDERING that different criteria for determining novelty in different states may mean that an invention is patentable in one state and not in another and that this leads to uncertainty;
- CONSIDERING the past efforts by AIPPI to promote the harmonization of patent legislations;
- ACKNOWLEDGING that perfect harmonization is not always possible and that certain situations of prior rights in one state as opposed to another may permit the patenting of an invention in one but not another of the states;
- CONSIDERING past resolutions of AIPPI and in particular the Question 89C Resolution regarding self-collision (Sydney, 1988 - Yearbook 1988/II, pages 212-213);

- CONSIDERING the work of AIPPI regarding Question 89 relating to harmonization and guidelines with respect thereto for presentation to WIPO (Yearbook 1991/I, pages 280 and following); and
- CONFIRMING its position favourable to a more comprehensive grace period of uniform duration at an international level (Moscow 1982, Question 75, Yearbook 1982/III).

TAKES THE FOLLOWING POSITION:

1. Novelty should be absolute whereby, without prejudice to the adoption of a grace period, any disclosure accessible to the public anywhere before the priority date of a patent application, or any other critical date for the assessment of novelty determined by national or regional laws, should be a basis for questioning the novelty of the invention claimed.
 - 1.1 A disclosure should be considered accessible to the public when any person has the possibility of gaining knowledge from the disclosure without any explicit or implied confidentiality;
 - 1.2 A disclosure should be deemed to comprise any information in written or oral form or knowledge resulting from an act of use, independently of the language and of the form, whether material or immaterial. However, AIPPI recommends that national or regional laws provide for at least limited exceptions in the case of experimental use accessible to the public by the inventor, his assignees or successors, always taking into account the particular nature of such use, the necessity for their being carried out in a manner accessible to the public and the precautions taken to limit accessibility to third parties.
2. The requirement of absolute novelty reflects the reality of modern technology which permits and promotes the rapid worldwide dissemination of information. It is no longer reasonable to consider that information available in one country is necessarily less available in another and consequently it is no longer realistic for an invention lacking novelty in one country to be held novel and patentable in another.
3. The recognition of any disclosure as defined above to serve as a basis for contesting the novelty of a later application is fully in accordance with the spirit of the TRIPS Agreement which prohibits discrimination between countries with respect to the recognition of inventions made in other member countries. Absolute novelty is wholly non-discriminatory.
4. For the purpose of determining novelty the combination of more than one disclosure should not be permitted.
 - 4.1 When a disclosure specifically refers to or relies upon any other disclosure in such a way that consideration of such other disclosure is essential for a full understanding thereof, such other disclosure should be deemed to be incorporated therein.

- 4.2 Should a disclosure set forth different features without specifically or implicitly providing for combinations thereof, it should not be considered to destroy the novelty of such combinations.
- 4.3 A single prior art disclosure may be proved by a number of documents or acts in order to determine the date and content of the disclosure.
- 4.4 The appreciation of novelty should be considered separately from that of inventive step or obviousness.
- 4.5 The interpretation of a disclosure must take into account the understanding of a person skilled in the art.

Such interpretation should extend to what the person skilled in the art, on considering the disclosure, would understand as implicitly or inherently disclosed. It should not extend to technical equivalents not covered by such an interpretation, nor should it extend to the realm of inventive activity.

- 4.6 In determining the understanding of the person skilled in the art, it should be permitted to rely upon his general knowledge.
 - 4.7 In order to destroy the novelty of an invention, a prior disclosure should be enabling to the extent that it must make all features of the invention as claimed accessible to the public in such a manner that those features may be discerned by a person skilled in the art.
- 5. AIPPI, in recognizing the necessity to avoid double patenting, considers that the disclosure contained in an unpublished earlier patent application, which is later published in the same jurisdiction, should be taken into account for the purpose of determining novelty of an invention claimed in a subsequent patent application. The assessment of novelty in such circumstances should not differ from the general rule with respect to other disclosures that are accessible to the public as defined in Item 4 above.
 - 5.1 AIPPI confirms the Sydney resolution which recommends an express provision for preventing "self-collision" whereby, excluding the possibility of double patenting, the disclosure of the unpublished prior patent application should not affect the novelty of the subsequent patent application where there is total or partial identity between the applicants at the time of filing the subsequent application (Sydney 1988, Question 89C, Yearbook 1988/II).
 - 6. While recognizing that inventions in certain new areas of technology may give rise to specific difficulties in the application of the criteria for appreciating novelty, AIPPI considers that such criteria do not require alteration which would represent undesirable exceptions from the general rule.

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