

Speech Open Forum March 1 – 3, 2006

Subject: Prior Art-related Issues (definition of prior art, novelty and inventive steps)

Ladies and gentlemen, Extinctive delegates, Director General and Mr. Chairman. I am very pleased to be given the opportunity to present my views on Prior Art-related issues. I also want to express my thanks to WIPO for organising this Open Forum.

I am speaking to you today, as a contributor to the substantive discussion on Prior art-related issues and I have decided to spend my allotted time to give you some examples on the importance of prior art-related issues and why I believe, the definition of prior art, novelty and inventive steps should be a part of the future work plan of the SCP.

It is my hope and wish that this Open Forum will help putting the discussions in SCP back on track and thus allow for a well balanced agreement in a foreseeable future. If we fail to reach an agreement or even to get the discussions in SCP back on track, the impact will be detrimental, not for us as government officials, but for our users; this is especially true for small companies with limited resources. Large international companies usually have the resources to navigate in a complex IPR system but this is often not the case for smaller companies. In particular not those located in developing countries. At the Danish Patent and Trademark Office we are almost every day confronted with users who are frustrated with the complexity and dissimilarities of the various patent systems in the world. Therefore one of the major steps towards making the patent system easily available to small companies anywhere in the world is to harmonize the patent systems at a global scale.

Turning now to a more substantive part of patent law, namely the issue of prior art, novelty and inventive steps, it is my belief that harmonisation in these areas are crucial in order to be successful in our work on patent law harmonisation, and thus

should without doubt remain as key issues in our future work towards harmonisation. I would like all delegates to note the importance of this issue.

Why is this you may ask?

Everyone involved in patent law being agents, user groups or offices use the term prior art. The major problem in this context is that, even though we all use the same terms we do not have a common interpretation of the terms, in this case the term prior art. This is true although the definition of prior art forms the foundation of any patent system. The definition of prior art determines the basis on which novelty and inventive steps are assessed and thus sets the standards of the quality of our patents. Therefore, it is detrimental that we find a common ground on this subject matter.

Definition of Prior Art.

The SPLT provides us with a good basic suggestion for a definition of Prior Art. Article 8, 1 states that: "The prior art with respect to a claimed invention shall consist of all information which has been made available to the public anywhere in the world in any form [as prescribed in the Regulations,] before the priority date of the claimed invention."

At first glance the definition may look very clear and precise. However, albeit the evident meaning of the definition of prior art in this article it still raises a number of issues and questions. I would like to draw your attention in particular to the following elements of the definition:

The first element I would like to elaborate a bit on is the phrase: "All information"

"All information" encompasses written, oral or any other kind or form or media in which can contain the information. This broad interpretation of the phrase includes of course the use information or in other words traditional and indigenous knowledge. All information does in fact include ALL INFORMATION. That being the case, our challenge in deciding how to understand the definition of prior art is not related to this part of the definition, but rather to the next part of the definition.

“Made available to the public”

What is required before the information described above is considered as available to the public? Under the EPO board of appeal case law, the mere theoretical possibility of having access to the information is enough for the information to be considered as part of the prior art. A publication does not have to fulfil any specific criteria with regard to form or layout in order to be considered as made available to the public¹.

Furthermore the EPO board of appeal case law provides that the availability criteria is fulfilled if only a single member of the public is in a position to gain access to and understand the information, provided the person is not bound to secrecy². This may however not be the case in all patent systems. Under US law for instance material from outside the US, is only considered to be a part of the prior art if the information is in written form. Other patent systems may have other practices when it comes to the discussion on availability to the public and thus creates uncertainty and difficulties for our users when filing for patents in more than one patent system.

Furthermore, in some cases the establishing of time and date of the availability to the public may turn out to be a difficult task. Luckily this is not a major problem in practice; however, I still see a need to find a common ground on how to approach this issue even though it may only concern very few cases on a global scale.

The need for harmonisation can further be illustrated by the following examples:

What is considered as prior art with regard to digital media and the Internet?

The role of digital media should be addressed in the definition of prior art. As stated above the current definition of prior art includes all information no matter form or shape. Nevertheless digital medias is a separate issue in this regard. Is a digital picture to be regarded as a physical picture when addressing prior art? The same question goes for digital texts, recordings etc. And how do we determine the date of availability of the digital media when assessing the prior art? Another issue in relation to digital media is the amount of information available. Every year the patent documentation material increases with approximately 850.000 documents on top of this you

¹ See EPO Board of Appeal cases T 444/88 and T 165/96

² See EPO Board of Appeal case T 482/89

may add an indefinite number of documents from non patent literature. Therefore, we need to find a workable solution on this matter and whether the material should or should not be included in the search.

All in all the importance of a common definition on prior art in my opinion, is not to be overlooked. A common definition of prior art will be of benefit to all parties whether you are a large or small company, a patent office or an agent, developed, developing or least developed country. The definition of prior art is the foundation of our patent system and without common ground and definition on this matter we will not be able to reach a sufficient level of harmonisation in other areas. Some of these issues should be dealt with in the Guidelines.

Definition of novelty

With regard to the definition of novelty, I find the timeframe to be the most interesting issue. According to PCT regulations Rule 34, the minimum documentation with regard to national patent documents includes searches in patent documents issued in a number of countries from 1920 and forward. This time limit is of course a practical measure, but maybe we should consider the possibility of addressing the time limit in a different way. For instance when searching for material regarding novelty to be considered in the field of wind mills the timeframe of 1920 is not sufficient, the same goes for other areas patent activity where the technology used have roots back in time. A different approach to the novelty issue in this regard would also allow or even dictate the inclusion of any traditional knowledge existing in the field of interest.

When addressing novelty today the practice of some offices is an almost word to word comparison of the prior art and the invention. The benefit of this practice may be questioned and should be discussed further in terms of future harmonisation.

Definition of inventive step

Turning to the issue of inventive step, patents must in my opinion be reserved for real creative achievements. Therefore, patent protection should only be provided for inventions that are truly innovative inventions and will enrich the present state of the art beyond the obvious.

The legal patent requirements which we establish in relation to inventive step plays a decisive role. If protection is granted for trivial developments or for inventions where the patent claims are inappropriately broad, such patents would impede rather than support new developments. Such an inflation of industrial property rights will lead to increased research costs and obstruct competition unnecessarily. At an advanced stage it could even lead to a collapse of the entire patent system. In my view it is clear that a further steady increase in the number of applications cannot represent a desirable target. Mere quantity cannot be regarded as a sign of increasing innovative power. It is the quality of new applications that is decisive.

This message must be communicated clearly to the public. The governments of the member states of WIPO can assist in creating a new awareness among applicants in clearly stating their commitment to more quality, even if this is to the detriment of quantity.

Securing a sufficient level of inventive step is in my view also essential for developing countries since this would minimize patent strategies aimed at blocking real competition and follow on innovation. These strategies can be especially harmful to new and growing economies.

But how do we ensure a sufficient inventive step requirement? This does in my view require a two step approach. Firstly we need to have harmonized rules on inventive step which are sufficiently strict. Secondly we need to establish patent offices around the world that have the necessary resources to enforce such an inventive step requirement. This is indeed not an easy task since many patent offices have been overwhelmed and overburdened by an ever increasing amount of applications. In response to this you could say that Patent offices therefore need to become more efficient. Again this points in the direction of harmonization. Why? Because not only could a harmonized patent system via a strict inventive step requirement halt the present increase in the number of applications it could also provide a better ground for patent offices to utilize the work done by other offices thereby avoiding the present duplication of work.

Another area which cries for harmonisation is the prior art effect of earlier applications, the so called secret prior art. There is strong disagreement among members of SCP, whether earlier non published patent applications should apply to novelty only or should apply to both novelty and inventive steps. Again, the need for harmonisation in the area is evident.

Conclusion

The definition of prior art, novelty and inventive steps have always played an important role when determining the required threshold in order to ensure a high quality of the issued patents. In addition prior art-related issues have a significant impact on the double patenting discussion.

This is why harmonisation in this area is crucial if we want to provide our users with the best possible conditions. It goes without saying that, in all of the above mentioned considerations it is imperative to strike a fair balance between the interests of all parties involved. Only when doing so will we be able to take this patent law harmonisation forward.

We have already made good progress in this area; however we still need to solve a lot of Prior Art related issues. Therefore I am convinced that the already achieved results and the remaining issues need to be a part of an adoptable agreement.

It is a huge and difficult task to harmonise patent law and perhaps a binding treaty is not the best way forward. Any kind of harmonisation instruments including best practice and opt out clauses should be carefully considered, thus allowing all parties to adhere to the instrument, when they feel ready to do so.

Ladies and gentlemen in all of our discussions and debates, we must not forget why we are here; we are here to take care of and to nurse the interests of our users! Let me repeat that; we are here to take care of and to nurse the interests of our users not our own! Our users are not bound by geographical borders nor do they belong to a certain political faction and we owe it to our users to make sure, that we have an effective patent regime in WIPO. Therefore I strongly encourage all delegates to keep

the needs of our users in mind, when deciding the future work plan of the SCP and patent law harmonisation.

Thank you very much for your attention!