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RESULTS OF THE QUESTIONNAIRES CONCERNING DISCLOSURE OF INFORMATION ON THE INTERNET AND OTHER ISSUES RELATING TO THE INTERNET

Document prepared by the International Bureau

INTRODUCTION

1. During the fourth session of the Standing Committee on the Law of Patents (SCP), held in Geneva from November 6 to 10, 2000, the SCP asked the International Bureau to prepare a questionnaire on current national and regional practices in Internet-related issues, in particular with regard to publications on the Internet, and including questions regarding the infringement of patents on the Internet.
2. Pursuant to the conclusion of the Standing Committee, two questionnaires, one concerning the prior art effect on patentability of information disclosed on the Internet and the other concerning the Internet and enforcement of patents, were sent to all States party to the Paris Union and/or Member of the World Intellectual Property Organization. The purpose of circulating the questionnaires was to collect information regarding the national practices of Member States of WIPO and to identify issues which the SCP may wish to address at the international level.

3. As of April 2, 2001, replies had been received from the following States: Argentina, Australia, Austria, Azerbaijan, Belarus, Belgium, Bosnia and Herzegovina, Croatia, Denmark, El Salvador, Estonia, Finland, Germany, Hungary, Ireland, Japan, Kazakhstan, Lithuania, Peru, Portugal, Republic of Moldova, Romania, Russian Federation, Saint Lucia, Singapore, Slovakia, Slovenia, Spain, Sweden, Tajikistan, Turkey, United Kingdom, United States of America, Uzbekistan and Venezuela (35). In addition, a response was received from the Brazilian Intellectual Property Association (ABPI) concerning the laws and practices in Brazil.

4. The present document summarizes the answers received to the questionnaires without reproducing all the comments made in the responses.

SUMMARY OF THE ANSWERS RECEIVED

I. Prior Art Effect on Patentability of Information Disclosed on the Internet

5. The text of the questionnaire showing the number of replies given to the various questions is reproduced in the Annex.¹

6. Almost all the countries indicated that information disclosed on the Internet constituted prior art, where such disclosure met general requirements on prior art. It is noteworthy that one country considered that the notion of “printed publication” or “written document” that meets the conditions of prior art was broad enough to include computer or machine readable records stored in an electronic memory, on magnetic media or in optical devices. Another country considered that problems derived from a Internet disclosure were often the same as those related to “oral disclosure” or “disclosure by use.”

7. Most of the countries replied that they do not have any special rules, guidelines or laws (including case law) which are exclusively applicable to the prior art effect on patentability of information disclosed on the Internet. However, one country stated that it was in the process of establishing a specific guideline.

8. With regard to the desirability of harmonization at the international level, almost all the countries seemed to support some form of international harmonization of the applicable rules in this respect. A majority of replies indicated that the question could be examined in the context of the discussion concerning the draft Substantive Patent Law Treaty (SPLT). However, many countries considered that efforts should be made to harmonize the general definition of prior art in a manner that would be also applicable to the information disclosed on the Internet, or at least, that general principles should be established first, and then a special treatment of Internet related issues could be discussed later, if necessary. Other replies concerning desirable instruments for international harmonization include a Recommendation, a Memorandum of the Director General of WIPO, the PCT Regulations and the WIPO Standard under the Standing Committee on Information Technologies (SCIT).

¹ The number of replies given to a particular question is not always equivalent to the total number of replies received, since, in some cases, no reply was given.

(1) Availability/Accessibility

Determination of availability/accessibility

9. It was found that a number of replies given to Question 4 did not reflect the intention of the respondent accurately. For example, when replying to the question “Is the ability to search [the web page] by search engine relevant to the determination of availability/accessibility of Internet disclosures?,” some countries seemed to reply “no” to that question, meaning that, regardless to the ability to search by search engines, the information on the Internet was considered as prior art if other conditions for the determination of prior art were met. On the contrary, some countries replied “no” to the same question because they did not consider the information on the Internet as prior art if it was not searchable by search engines. Therefore, the analysis of Question 4 should be made in conjunction with the explanations given in the responses.

10. In general, for the information disclosed on the Internet, many countries responded that the test to determine “public availability” or “public accessibility” to the information concerned should be the same as the test applicable to other types of disclosures. Therefore, it should be considered in connection with all specific circumstances of each single case.

11. A great majority of countries considered the public availability of the URL to be relevant to the determination of availability/accessibility. One country stated that, even without any public availability of the URL, the information could be considered accessible with the situation being analogous to the case of inter-library loans from corporate or private libraries.

12. A majority of replies indicated that the possibility of search by a search engine should be taken into account when determining the availability of/accessibility to the information on the Internet. One country replied that a home page designed for public dissemination were likely to be considered as available to the public even if it was not locatable by any search engine. However, one response stated that the degree of difficulty to access the content of any disclosure should not affect the accessibility to the disclosure, and therefore, this criterion was not relevant for the determination of accessibility.

13. Concerning password protection and encryption, a majority considered that they were relevant criteria. The key factor for the determination was whether the password or the decryption tool was available to the public without any limitation or discrimination.

14. For a majority, a web site that required payment for access was considered prior art if the access through payment was available to any person. One country pointed out that this was analogous to buying a book.

15. Further, one response noted that if particular software, which was not available to the public, was required to access the information disclosed on the Internet, that information would not constitute prior art.

Duration of disclosure

16. Concerning the duration of the disclosure of the information on the Internet, there was a general understanding that the information should appear on the Internet long enough so that it could be available to public. Whether the information is available to the public or not is determined in the same way as prior art in relation to other means. Therefore, the sufficient duration of appearance on the Internet would be determined on a case by case basis. One country stated that, as an example, the necessary time period might be short if the web site was visited frequently and well publicized, but in other circumstances, a longer period might apply. Some countries replied that the information should need to appear on the Internet at least as long as it was necessary for the public to download or print the information. More than one country said that, once the information was posted on the web site, it formed part of the prior art irrespective of the length of the appearance on the Internet, while another country replied that the information should be on the Internet for five to seven years for the purposes of constituting prior art.

17. A majority of replies showed that the fact that the information disappeared from the web site before the filing date was not relevant to the determination of the prior art effect, provided that there was evidence showing the public availability/accessibility before the filing date, for example a copy of the web page with the posting date. One country commented that everything that once had become prior art continued to be prior art.

18. A great majority of replies indicated that new information added to a web page on the same date as the filing date of an application did not constitute prior art to that application. Some countries commented additionally that this situation was treated in the same manner as the case where the information was disclosed to the public on the filing date.

E-mails; Discussion groups

19. As regards the question whether e-mails could constitute prior art, replies showed almost unanimously that, in general, a private e-mail, regardless of being encrypted or not, would not be regarded as prior art. On the other hand, a great majority of replies indicated that a publicly distributed e-mail and the information disclosed in a “discussion group” or a “chat room” could form part of prior art. However, many countries pointed out that the general rule above is applicable provided the recipient could use the information without any restraint or without any obligation of confidentiality. One country mentioned that, if a private e-mail was not encrypted, the e-mail could be forwarded to an endless number of persons, all having free access.

(2) Time and Content of Publication

20. Many countries indicated that, due to the absence of experience and legal precedents, it was not possible to fully answer how the Office determined the contents and timing of the disclosure on the Internet. The replies showed that the practices of the Offices with respect to the use of the Internet as a search tool varied very much.

21. For the purposes of searching prior art, some Offices limit the use of the Internet to searching web sites and databases which have a higher degree of credibility. These include, for example, a database of patent applications and issued patents, or a database the contents

and the timing of the disclosure of which could be supported by a paper publication. Other Offices categorized the web sites depending on the credibility of the sites, and required higher caution when using the information disclosed on the web site with low credibility. In the case of doubt, one country allowed an examiner to contact a so-called web master to investigate, for example, the date of publication, while another Office replied that, if there was no date of publication on the web page, an examiner should not seek for further information and, consequently, should not cite that web page. Another Office was of the opinion that, in the case of web sites of renowned publishers, even if there was no publication date on the web page, it could be cited provided a certificate concerning the contents and publication date was obtained from the publisher. Another Office indicated that patent documents as well as Non-Patent Literatures (NPL) found on the Internet must be verified as to the reliability of their source. If the verification needed could not be thus obtained, the examiner only notified the applicant of the disclosure. In any event, it seemed that the Offices kept a paper printout of the web page as evidence.

Hyperlinks

22. With regard to the question concerning hyperlinks, a majority of replies indicated that the information contained in the hyperlink web page could be considered as a part of the information disclosed in the initial web page which led to the linked page. However, a number of countries considered that this question should be answered on a case by case basis. One country pointed out that, in general, the mere existence of the link would be insufficient unless it was apparent that the skilled person in the particular field would consider the various documents to be a single source of information. For example, the way the links were presented on the source page should be taken into account. Another country indicated that the answer to the question depended on the character of the hyperlink. For example, compared with a "HREF link," an "inlining/embedded link" or "framing" might provide a stronger connection between two pages, and therefore, the information on the linked page could be considered to be included in the disclosure of the initial page.

Certification service

23. Concerning a certification service for the contents and the publication date of a web page, many countries replied that such a service would be useful to guarantee the contents and the timing of the disclosure on the Internet. However, as regards the desirability and feasibility of the establishment and use of such service, a number of countries cast doubts in term of practicability, efficiency and costs. One country mentioned that, although such a setup might be useful for inventions concerning the Internet itself or electronic commerce, the prior art relating to these technical fields was more and more collected and documented in reliable sources, such as paper publications or credible databases.

(3) Burden of Proof

24. A majority of the replies indicated that the Office had the responsibility to prove the contents of the disclosure on the Internet on or before the filing date of the application, which would constitute prior art. One country stated that, in case of less credible web sites, it could be easier to reverse the burden of proof to applicants.

25. Although a majority of Offices considered that the level of proof for Internet disclosures did not need to be different from the principles established for paper publications, some Offices were of the opinion that, where the information disclosed on the Internet was cited to reject a patent application, the availability of that information should be either confirmed through documents or certified, and that the simple indication of the URL was not sufficient. Another Office indicated that, where a reference was made to a document published on paper, the applicant had to prove that the information to which the reference had been made did not constitute prior art. However, in the case of information published on the Internet, the interested party might request that proof be supplied that the information in question was prior art, and only where this was proven would the interested party have to submit evidence.

26. Another country pointed out that, if *prima facie* documentary proof of the disclosure on the Internet, such as a copy of the web page with the date of disclosure, could not be established, it could be treated as an information made available to the public by lecture or by public use

(4) Citation

27. As regards the format of citation of electronic documents, it was found that WIPO Standard ST.14 (Recommendation for the Inclusion of References Cited in Patent Documents) was well accepted. According to the experience of one Office, a highly complex URL was not always useful to retrieve certain information, since that information could be re-located in the same web site. The relevant information could be found more easily if a person was directed to the main page of the web site in question, and was left to navigate the site by his own.

II. Internet and Enforcement of Patents

28. Compared with the questionnaire concerning prior art effect on patentability of information disclosed on the Internet, the number of replies to the questionnaire concerning Internet and enforcement of patent was very limited. One reason may be that the questions concerning infringements of patents used or sold on the Internet, or any other questions relating to the enforcement of patents on the Internet have not been widely encountered in practice yet. Another reason might be that, as some countries mentioned in the questionnaire, many of these issues would only be clarified in, or fall in the competence of, the courts.

29. However, the following issues requiring clarification at the international level were suggested by the member States:

- General period of grace;
- International private law;
- Infringement of patent rights jointly committed across national borders;
- Evaluation of the indirect infringement in the infringement of patent rights jointly committed across national borders;
- Involvement of nations with different levels of patent protection in the distribution of services/programs via the Internet;

- Definition of the scope of terms such as “making,” “using,” “offering for sale,” “selling,” and “importing” in the distribution of services/programs via the Internet;
- Whether the term “product” also covers intangibles or not. Clarification of definitions of “product” and “process”;
- Application of the doctrine of equivalents in the case where not all elements of the claim are physically located in one country;
- Legal and conceptual definition of “product” and “process” with respect to software-related inventions and conditions of patentability concerning software-related inventions (process and product) on the Internet;
- Patentability of data transfer via the Internet.

30. In view of the very limited number of responses given to the hypothetical cases under Questions 2 to 5, it may not be appropriate to draw any conclusions at this stage. The difficulties encountered by the Offices to respond to this questionnaire might reflect the fact that there are more questions than answers in connection with the Internet and enforcement of patents. Noting that more and more economic activities utilize information technologies and are connected globally, at a certain point, it may be appropriate to re-examine the territorial nature governing the enforcement of patent rights.

CONCLUSION

31. As regards the disclosure of information on the Internet and its impact on patentability, many countries seem to be in favor of, firstly, establishing general principles concerning prior art that would also cover disclosures on the Internet under the draft SPLT, and then considering the necessity of special provisions specific to Internet disclosures, possibly, under the practice guidelines.

32. With regard to the questions concerning the Internet and enforcement of patents, the SCP is invited to express in what way work should be continued with a view to supplementing the existing international legal framework. In particular, comments are welcome on the issues suggested by the member States, which appear in paragraph 29 above.

[Annex follows]

ANNEX

Questions Concerning Prior Art Effect on Patentability of Information
Disclosed on the Internet

Q. 1 Does information disclosed on the Internet constitute prior art? If yes, are additional/different conditions provided for Internet disclosures as compared with disclosures in other form?

Yes	28	No	1
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See paragraph 6 of the main document.

Q. 2 In your country, are there any specific rules or laws (including case law) relating to prior art effect on patentability of information disclosed on the Internet? If yes, please specify.

Yes	2	No	30
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See paragraph 7 of the main document.

Q. 3 Should the prior art effect of information disclosed on the Internet be harmonized at the international level? If yes, what kind of instrument would be desirable?

Yes	27	No	3
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See paragraph 8 of the main document.

[Availability/accessibility]

Q. 4 Are the following conditions relevant to the determination of availability/accessibility of Internet disclosures? If yes, how are they taken into account for that determination?

(i) publicity of the URL	Yes	23	No	5
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See paragraph 11 of the main document.

(ii) ability to search by search engines	Yes	17	No	5
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See paragraph 12 of the main document.

(iii) password protection	Yes	17	No	9
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See paragraph 13 of the main document.

(iv) encryption Yes **15** No **10**

See paragraph 13 of the main document.

(v) web site that requires payment for an access Yes **11** No **13**

See paragraph 14 of the main document.

(vi) others (please specify)

See paragraph 15 of the main document.

Q. 5 Duration of appearance of the information on the Internet may be relevant to determine whether that information is available/accessible to the public and, therefore, constitutes prior art. Please reply to the following questions relating to the length and timing of the information appearing on the Internet.

(i) How long should the information be on the Internet to become prior art?

See paragraph 16 of the main document.

(ii) If the information on the Internet disappeared before the filing date of an application, does such information constitute prior art to that application?

Yes **17** No **4** Other (please specify) **5**

See paragraph 17 of the main document.

(iii) If new information was added on the Internet web page on the filing date of an application, does such added information constitute prior art to that application?

Yes **5** No **19** Other (please specify) **4**

See paragraph 18 of the main document.

Q. 6 Does the information disclosed in an e-mail in the following ways constitute prior art?

(i) in a private¹ e-mail using encryption Yes **0** No **27**

(ii) in a private e-mail not using encryption Yes **0** No **25**

¹ The term “private” is used in a sense that an addressor of the e-mail intends to send his message to a particular person (or persons). On the other hand, the term “publicly” in item (iii) means that the addressor intends, or at least does not object, to disclose his message to an unrestricted number of persons.

(iii) in a publicly¹ distributed e-mail **Yes 25 No 3**
(i.e., e-mail to a public discussion group)

Q. 7 Does the information disclosed in a “discussion group” or a “chat room” constitute prior art? If yes, under which conditions?

Yes 23 No 5

See paragraph 19 of the main document.

[Time and contents of publication]

Q. 8 How does your Office determine the contents and timing of Internet disclosures? What are the criteria for that determination? Does the author or the source of the web site influence such determination?

See paragraphs 20 and 21 of the main document.

Q. 9 Where hyperlinks are made in a web page, can the information contained in the linked web page (and further linked web pages) be considered to be information disclosed in the initial web page which leads to other pages?

Yes 15 No 8

See paragraph 22 of the main document.

Q. 10 In order to ensure the timing and contents of Internet disclosure, would the establishment and use of “archival services” that certify the time and contents of web pages be desirable? What kind of mechanism could be envisaged?

See paragraph 23 of the main document.

[Burden of proof]

Q. 11 Who has the burden of proof for the contents of disclosure on the Internet on or before the filing date of an application?

Office 18 Applicant 11

See paragraph 24 of the main document.

Q. 12 Does the level of proof for Internet disclosures need to be different from the principles established for paper publications? If yes, what are the differences?

Yes **8** No **19**

See paragraphs 25 and 26 of the main document.

[Citation]

Q. 13 WIPO Standard ST.14 (Recommendation for the Inclusion of References Cited in Patent Documents) provides the format of citation of electronic documents, including web pages. Does your Office use any other format of citation in order to make a reference to a web page? If yes, please specify.

Yes **3** No **22**

See paragraph 27 of the main document.

[End of Annex and of document]