

Sweden
Suède
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Report Q 167

in the name of the Swedish Group
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Current standards for prior art disclosures in assessing novelty and non-obviousness requirements

1. Determination of prior art

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

According to Swedish law, the granting of a patent requires that the invention is (i) new and (ii) non-obvious to a person skilled in the art, in view of prior art. Lack of novelty and/or non-obviousness has the effect that a patent applied for will not be granted or, if granted, that the patent can be revoked.

In the field of patents, Swedish practice in these aspects, in the Patent Office as well as in the courts, follows the EPO practice.

A prior art disclosure that does not completely anticipate the invention may very well be considered so close to the invention that the invention fails inventive merits.

In one respect though, there is a difference in the effect of a disclosure on novelty and on non-obviousness, respectively. The contents of a patent application filed in Sweden or for Sweden via EPO shall be considered as known if that application becomes available to the public. The published application will be relevant for determining novelty, but not non-obviousness of a subsequent Swedish patent application filed prior to said publication (cf. EPC Art. 54 and 56)

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

In the Swedish Patents Act there is a broad definition of prior art disclosures: “everything that is publicly available, be it in writing, by speech, by use or in any other way before the date of filing of the application” (Section 2, paragraph 2). Thus, there are no restrictions as to how the disclosure took place.

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

Other guidelines than those given by law or decisions by the registration office and the courts, are the EPO case law and EPO Guidelines as well as Guidelines published by the Swedish Patent Office (www.prv.se). As a general rule, decisions rendered by the Swedish Patent Office follow EPO practice. This is in accordance with decision 4586-1986 of the Swedish Supreme Administrative Court (Regeringsrätten). Nowadays less important, but for a long time influential on the practice were the preparatory works of the Patents Act, in particular the report of a joint Nordic commission (NU 1963:6) which was the basis for similar patent acts that were enacted in the late 60-ties in the Nordic countries. To the extent these preparatory works are in line with the development of patent law on a European level, they are still considered useful for the interpretation and application of the patents acts.

2. Criteria for disclosure

2.1 Means of disclosure

As indicated above (1.2), under Swedish law there are no limitations as to the means of disclosure. All kinds of means are equally relevant.

In many cases the information will be immediately apparent, e.g. when presented in a sufficiently clear way (cf. EPO decision T 206/83) in a written document. In other cases though, e.g. when the invention is not visually available when used in public, but implemented in an apparatus, third party may have to spend much time and effort to disseminate it. However, such practical difficulties for third parties trying reverse engineering, are in principle not considered. Here, Swedish courts seem to apply the same view as the Enlarged Board of Appeal in G 1/92, see the decision of May 10, 1995 by the Patent Court of Appeal (Patentbesvärsträtten), reported in PATENTEYE no. 6/1995.

2.2 Time of disclosure

Time of disclosure is not relevant for the assessment of novelty under EPO and Swedish practice. This means that if a prior disclosure destroys the novelty of an invention it will have the same effect irrespective of time. The same applies in principle as regards non-obviousness.

However, one aspect of time is that it could reflect the difficulty for the person skilled in the art to find the solution according to the patent and thereby in certain cases be used as an indicator of non-obviousness when assessing non-obviousness.

2.3 Place of disclosure

The requirement for novelty and non-obviousness is absolute. Thus, the place of disclosure is not relevant.

2.4 Personal elements

An exception in the effect of a disclosure as prior art is made for cases of evident abuse of information in relation to the inventor (cf. art. 55(1)(a) EPC) and for cases where the exhibition exemption (art. 55(1)(b) EPC) applies.

If the person who discloses the information was bound by a confidentiality agreement (the abuse case) the disclosure will not have any prejudicial effect on the novelty of the invention if the inventor files a patent application within a 6 months period. Here, it may be pointed out that in EPC and the corresponding Swedish regulation (2 §, 5 paragraph 1. of the Patents Act) there is qualification by the word "evident", which is a subjective requisite. In order to be an evident abuse, it is required that the abuser has acted *mala fide*, i.e. that he had an intent to destroy the novelty of the invention or at least that he was aware of the fact that his measures could lead to such result, see e.g. decision of July 17, 2001 in case nr 99-282 by the Patents Appeal Court (Patentbesvärsträtten).

Although the requirement for novelty and non-obviousness is absolute in Sweden and in spite of the attitude mentioned in 2.1., the last paragraph, as regards commercially available objects containing the invention, it is accepted that inventors may wish to carry out tests of the invention before the filing of their patent applications in a public environment. In the preparatory works (NU 1963:6 p. 125) there is an example of a snow-plow. The testing of such a device on public roads is not considered to destroy the novelty under certain conditions, namely (i) that such tests are necessary to finish the invention, (ii) that all reasonable measures are taken to restrict the possibilities of the public to get information about the invention and (iii) that the tests are not carried out for a longer time and to a larger extent than what is considered defensible with regard to the character of the invention.

2.5 Recipient of the information

Whether the disclosure is public or not has to be determined *in casu*. Relevant aspects are i.a. the number of people who received the information, the relation between the persons who received the disclosure and the inventor and whether there is any explicit or at least implicit agreement on confidentiality. A generally applied rule is that, if a large or indefinite group of persons have had an opportunity to receive the information, then the disclosure has taken place. It is irrelevant whether anybody did actually make use of that possibility, it being sufficient that the opportunity has existed.

Thus, the critical question is whether or not the inventor controls the information.

The ability of the recipient to understand the information is in principle without importance. Here, the same principle applies as in the case of reverse engineering (see 2.1). The mere fact that the recipient of the information theoretically can comprehend the invention is enough for destroying the novelty.

3. Disclosure through new media

3.1 General rules

There are no statutory law, guidelines or court cases in Sweden specifically concerning the effect of information in electronic networks or communications as prior art disclosures. However, it seems reasonable that the same rules and principles should apply, whatever the media are, in view of the contribution-reward motives for the patent system, which are the same, irrespective of media.

3.2 *Questions of confidentiality*

Whereas the technical difficulty of finding certain information may not be a reason in itself to consider such information not to be publicly available, the fact that the information is accessible only for a limited and identified number of receivers because of the use of encryptions and/or passwords should satisfy the requirement of confidentiality. Certainly, inventors and their successors in title should be allowed to use electronic means for communications where normal and proper precautions are taken to preserve the confidentiality nature of the information.

3.3 *Place of disclosure*

In the view of the Swedish group the requirement for novelty should have general application, i.e. it should be universal. Geographical limitations in this respect do not seem suitable for today's society, with easy communication both physically and electronically world-wide.

3.4 *Timing of disclosure*

Although the use of electronic means raises some questions as to evidence (see 3.5), the Swedish group is not in favour of introducing any specific rules regarding restrictions of time when disclosures are relevant. Again, the same rules should apply for all kinds of disclosing media.

In the legal debate (NIR 2001, p. 381-386) it has been questioned whether *the duration* of a disclosure on Internet should have any effect per se. In this respect there are no rules laid down in the Patents Act or precedents. In the view of the Swedish group, from a practical point of view it does not seem possible to qualify a disclosure as having prejudicial effect or not depending on the duration, as long as it is sufficient for a skilled person to understand the information according to the disclosure. However, it is an open question whether the time needed for understanding the information could be replaced by the time necessary for downloading the time (which would allow third party to disseminate the information afterwards).

3.5 *Questions of evidence*

Electronic information is by nature not permanent unless it is specifically saved (electronically or in printed form). However, in the view of the Swedish group, this fact does not give reason to change the principles of the burden of proof. The burden of proof that a prior disclosure is in fact a prior art disclosure will fall on the party seeking to apply such disclosure as prior art. Any party that has an interest in assessing the state of the art can do so by collecting information and save it in a permanent form with adequate evidence of the date of disclosure. The possibility of manipulating electronic information should be considered similarly to the possibility of manipulating other means of evidence, i.e. by evaluation of the evidence with regard to its reliability. A Swedish court is generally free to evaluate evidence at its discretion. Since the technique for manipulations may vary and change over time, it does not seem efficient to apply a specific different standard for new media disclosures.

4. Conclusions and summary

The requirements for novelty and non-obviousness are by far the most frequent issues dealt with in examination proceedings and in patent litigations. For this reason they are of great importance. In the view of the Swedish group it is highly desirable that the concept of novelty be harmonised worldwide, preferably within the framework of the Standing Committee on the Law of Patents.

EPO as well as the Swedish Patent Office and Swedish courts have established principles that to some extent could be debated but nevertheless provide over-all reasonable solutions. New media have brought certain new elements into the picture, in particular from an evidence point of view. However, it is the opinion of the Swedish group that these new aspects do not justify the introduction of different standards for assessing novelty and non-obviousness since basically, the well-established standards should work well also in these cases and further that it will probably be difficult to find the proper conditions for applying a different standard for certain cases in view of the fact that the technology for new media will continue to develop rapidly and make legal solutions obsolete.