



Industrial property in a national and globalized framework. Protection and information: the Internet role

**Internet disclosure in the field of patents:
does it constitute prior art ?
does it affect the determination of patentability ?**

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A few introductory remarks

What is the Internet ? a new space or “cyber space”
a new territory
a new environment
the “World Wide Web” (www)

Where is it ? at the end of a wire
at the end of a signal or a wave
almost ... “in the air”
in no particular geographical location

As individuals, we have a great sense of freedom,
we are all navigators, surfers, worldwide travelers,
we like the convenience, the low cost, and ...

.... there are no speed limits ...



A few more introductory remarks

But, if we are inventors, companies, attorneys, examiners, judges, etc.,
we are **dealing with patents** and we must be concerned with ...

... everything, or some things,
made available to the public
anywhere, or somewhere, in the world....

(the inevitable “prior art”)

Therefore, with the Internet,

.... **we are ... in big trouble, today !**



Numerous questions are raised by the growing development of the Internet

- ◆ **unlimited** flow of information
(current estimate: + 1 billion documents)
 - ◆ ◆ especially, **technical** and **scientific** information
- ◆ **public accessibility**
- ◆ **anonymity** of the source of the information
- ◆ **vulnerability** of the alteration of the information
- ◆ **credibility** of the information



IP Offices are facing challenges

The Internet affect their **IP policies**, and therefore, their legislation:

- ◆ **electronic filing** of applications
questions of date, content, signature, authenticity,
veracity, integrity, evidence, etc.
- ◆ **dissemination** of IP information
- ◆ **enforcement** of trademarks used on the Internet
and of software patents used on the Internet
- ◆ in the **patent** field:
Internet disclosure **as prior art** and
its effect on the determination of **patentability**



Why is the issue of Internet disclosure so important in the context of patents ?

Because, under most patent laws,

- ◆ novelty and inventive step of an invention are examined by **comparison** with “**the state of the art**” (“prior art”)
- ◆ ◆ therefore, identifying the **relevant prior art** is **essential** to the determination of **patentability** (i.e., whether or not a patent will be granted)
- ◆ **after grant** of the patent, prior art will be considered in order to evaluate **validity or invalidity** of the patent



Coming back to an introductory remark ...

the inevitable “prior art”

**... everything, or some things,
made available to the public
anywhere, or somewhere, in the world....**

must be redefined

**since both the Internet
and inventive activity, therefore patents,**

**will continue and develop themselves
in ways we cannot even imagine yet**



Traditional forms of disclosure of the knowledge that becomes part of the prior art

- ◆ **published writing, i.e., in tangible form**
- ◆ **oral disclosure, i.e., description in spoken words in public**
- ◆ **disclosure by use**
 - use, sale or display in public**
 - or enabling the public to use the knowledge**

All of which can be traced with some certainty

as to what, when and where



“published” on the Internet ?

- ◆ ◆ Contents: **what** is published ?
- ◆ ◆ Timing: **when** is it published ?
- ◆ ◆ **Maybe**, information is :
 - ◆ published on the Internet **before** being published on paper
 - ◆ published **only** on the Internet (i.e., never on paper)
 - ◆ published **today but gone** tomorrow
 - ◆ published today **but modified** tomorrow and **again** later



Forum for discussion in the context of WIPO (since 1998)

- ◆ ◆ In May 2001, WIPO presented the results of a survey it conducted amongst its Member States
- ◆ ◆ The SCP agreed to the following:
 - ◆ **recognition of prior art effect of Internet disclosure**
(under general rules and practices applicable to determination of prior art)
 - ◆ **necessity to establish general principles** concerning prior art
(under the future SPLT)
 - ◆ **consider inclusion of special provisions**
in the future “Practice Guidelines” under the SPLT

(SCP: Standing Committee on the Law of Patents)
(SPLT: Substantive Patent Law Treaty)



Some of the specific issues for future consideration

- ◆ Introducing the **necessary legal basis** in national and regional laws today, generally, no special laws, rules, guidelines, case law (Japan and US have specific rules)

- ◆ **Availability** to the public
 - ◆ ◆ private e-mails, encrypted or not ?
 - ◆ ◆ discussions groups, chat rooms or news groups ?
 - ◆ ◆ duration of disclosure ?
 - ◆ ◆ contents and timing ?
 - ◆ ◆ citations, hyperlinks ?

- ◆ **Security**

- ◆ **Confidentiality**, esp. before publication of information



In conclusion

It is **essential** that

the prior art effect of Internet disclosures
be recognized in an harmonized manner

so as to **ensure**

a more **predictable** and **cost-effective**
international patent system

in the era of information technology.