

# WIPO



WIPO/GRTKF/IC/9/INF/6

ORIGINAL: English

DATE: February 27, 2006

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**INTERGOVERNMENTAL COMMITTEE ON  
INTELLECTUAL PROPERTY AND GENETIC RESOURCES,  
TRADITIONAL KNOWLEDGE AND FOLKLORE**

**Ninth Session**  
**Geneva, April 24 to 29, 2006**

FIRST COLLATION OF RESPONSES TO THE QUESTIONNAIRE ON RECOGNITION  
OF TRADITIONAL KNOWLEDGE AND GENETIC RESOURCES IN THE PATENT  
SYSTEM

*Document prepared by the Secretariat*

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## SUMMARY

1. There have been many calls for legal and practical steps to reduce the likelihood that patents are improperly or inaccurately granted on claimed inventions that contain traditional knowledge (TK) or genetic resources; for WIPO, this stems from its first consultations with TK holders in 1998 and 1999, and has developed in subsequent work on the international plane. In particular, the Intergovernmental Committee on Intellectual Property and Genetic Resources and Folklore ('the Committee') has overseen several developments to this end; these have now been taken up in key elements of the international patent system. The Committee has continued to consider how to enhance patent search and examination to take better account of relevant TK and genetic resources. This work has covered a range of substantive and procedural questions. Commissioned by the Committee itself, the present document serves as a basic resource for this continuing work, providing information on national and regional practice on matters such as:

- When and how are search and examination undertaken?
- What forms of TK are taken into account as prior art, in principle and in practice?
- What issues arise in assessing the validity of inventions in the light of relevant TK or genetic resources?
- What is the role of the patent office in checking inventorship and entitlement to apply for a patent?
- Are there any specific guidelines or lessons from practical experience in assessing patent applications for inventions linked to TK or genetic resources?

## BACKGROUND TO THE QUESTIONNAIRE

2. Among the needs expressed by holders of traditional knowledge (TK) consulted by WIPO during fact-finding missions in 1998 and 1999 were “an analysis of how prior art is established for purposes of patent examinations in the context of TK” and “the prevention of the unauthorized acquisition of IPRs (particularly patents) over TK by documenting and publishing TK as searchable prior art, where so desired by the relevant TK holders.”<sup>1</sup>

3. The Committee has initiated and overseen several developments concerning the recognition of TK within the patent system. These have focussed on defensive protection – that is, measures aimed at preventing the acquisition of intellectual property (IP) rights over TK or genetic resources by parties other than the customary custodians of the knowledge or resources.<sup>2</sup> An overview of defensive protection measures produced by the Committee is contained in Annex I of document WIPO/GRTKF/IC/5/6, and a further update and clarification is provided in document WIPO/GRTKF/IC/6/8. These include a range of steps

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<sup>1</sup> See *Intellectual Property Needs and Expectations of Traditional Knowledge Holders: WIPO Report on Fact-finding Missions on Intellectual Property and Traditional Knowledge (1998-1999)*. Geneva: WIPO, 2001: page 281.

<sup>2</sup> See the overview of forms of legal protection provided in document WIPO/GRTKF/IC/5/12, from paragraph 17, and the discussion of defensive protection from paragraph 28.

that have now been taken within the Patent Cooperation Treaty system and the International Patent Classification to take greater account of TK.

4. In order to advance its work in this area, the Committee decided at its sixth session to develop a questionnaire on prior art criteria and draft recommendations to authorities responsible for patent search and examination to take greater account of TK systems (on the basis of document WIPO/GRTKF/IC/6/8 and the previous proposals set out in that document). Between the Committee's sixth and seventh sessions, a questionnaire on recognition of TK in the patent system (WIPO/GRTKF/IC/Q.5) was prepared and circulated to all WIPO Member States, as well as other stakeholders. The contents of this questionnaire were drawn from previous Committee work on these issues, including a series of Member State and regional group proposals (as outlined in WIPO/GRTKF/IC/6/8).

5. The questionnaire covered both legal and practical aspects of the recognition of prior art, including the legal characteristics of relevant prior art used in determinations of novelty and non-obviousness (inventive step), the actual sources of prior art that are used in search and examination, other aspects of search and examination procedures, and provisions or case studies specifically concerning the recognition of TK and genetic resources during search and examination.

6. This document is a collation of responses to the questionnaire received up to November 2005. It includes responses from Argentina, Armenia, Australia, Austria, Azerbaijan, Bangladesh, Bolivia, Brazil, Bulgaria, Burundi, Chad, China, Colombia, Congo, Croatia, Czech Republic, Denmark, Egypt, Eurasian Patent Office, European Patent Office, Fiji, Finland, France, Georgia, Germany, Ghana, Iceland, Ireland, Italy, Japan, Kenya, the Republic of Korea, Lithuania, Malaysia, Mauritius, Mexico, the Republic of Moldova, Monaco, the Netherlands, Norway, Panama, the Philippines, Poland, Portugal, Romania, the Russian Federation, Senegal, Singapore, Spain, Sweden, Thailand, Tonga, Trinidad and Tobago, Turkey, Ukraine, Venezuela and Viet Nam.

7. The following text provides the text of the original introduction to the questionnaire, and the questions from the questionnaire. The country responses are then gathered under each question. To save space, where no response was received to a question, that country is not listed under that question.

8. This material should provide a broad empirical basis for the development of the proposed draft recommendations on taking account of TK during search and examination. Successive versions of these draft recommendations have been provided in documents WIPO/GRTKF/IC/7/8, WIPO/GRTKF/IC/8/8 and WIPO/GRTKF/IC/9/8.

[Questionnaire and responses follow]

## INTRODUCTION TO THE QUESTIONNAIRE

(from document WIPO/GRTKF/IC/Q.5)

## I. OVERVIEW

1. This questionnaire aims to collect information on legal and practical issues concerning the recognition of traditional knowledge (TK) and genetic resources in the examination of patent applications. It advances the work of the Committee on defensive protection measures aimed at pre-empting the erroneous grant of patents which wrongly claim certain TK or genetic resources as inventions. Responses are sought especially from patent search and examination authorities.

## II. BACKGROUND: TRADITIONAL KNOWLEDGE AS PRIOR ART

2. There is a wide-ranging debate about the relationship between patents and genetic resources and TK, covering such issues as the role of patents within regimes governing access to and benefit sharing from genetic resources and associated TK, as well as the legitimacy of patents on genetic materials. This questionnaire is intended only to have limited scope; it does not address these important broader issues: these are being debated in the Committee and in other fora within WIPO and other international organizations and processes.

3. This questionnaire concentrates on specific aspects of patent law and procedure that arise about the status of TK and associated genetic resources in relation to claimed inventions. TK about the beneficial properties of a genetic resource may help an inventor to derive an invention from that genetic resource. But there are also concerns that patent claims may be drafted to cover inventions that consist directly of existing TK or genetic resources, or that are obvious adaptations or applications of existing TK or genetic resources. Such patents may be invalid, in principle, due to lack of novelty or obviousness (or because the applicant does not derive the right to apply from the true inventor). But there may be practical obstacles that mean that relevant TK and genetic resources are not taken into account during examination.

*What is defensive protection?*

4. Various defensive protection strategies have been employed to prevent the acquisition of intellectual property rights over TK or genetic resources by parties other than the customary custodians of the knowledge or resources. The Committee has developed and implemented several practical mechanisms for defensive protection. It has also referred proposals for improved defensive protection to other WIPO bodies for action. (A recent summary is provided in document WIPO/GRTKF/IC/6/8).

5. Defensive protection strategies focussed on the patent system have a legal and a practical aspect. The legal aspect entails ensuring that information is published or documented in such a way as to meet the legal criteria to be counted as prior art in the jurisdiction concerned (this may include, for instance, ensuring that there is a clear date of publication, and that the disclosure enables the reader to put the technology into effect). The practical

aspect entails ensuring that the information is actually available to search authorities and patent examiners, and is effectively accessible to patent authorities (such as being indexed or classified), so that it is much more likely to be found in a search for relevant prior art. These two aspects were elaborated fully in document WIPO/GRTKF/IC/5/6. This questionnaire seeks information on both aspects.

#### *Limitations of defensive protection*

6. It is often stressed that protection of TK should be comprehensive, exploring both positive and defensive options. Defensive protection only aims to prevent other parties from gaining IP rights, and it does not in itself prevent others from using this material. Often, the active assertion of rights (positive protection) is necessary to prevent undesirable use of TK by third parties. In some scenarios, defensive protection may actually undermine the interests of TK holders, particularly when this involves giving the public access to TK which is otherwise undisclosed, secret or inaccessible. In the absence of positive rights, public disclosure of TK may actually facilitate the unauthorized use of TK which the community wishes to protect. Accordingly, no work on defensive protection (including this questionnaire) should be construed as encouraging TK holders to disclose, document or publish any element of their TK, or to give consent to their TK to be published or otherwise disseminated, unless they have had the opportunity to consider fully the consequences of doing so and have given their prior informed consent.

### III. OVERVIEW OF THIS QUESTIONNAIRE

7. In March 2004, the Committee reviewed the work completed on defensive protection (WIPO/GRTKF/IC/5/6 and WIPO/GRTKF/IC/6/8) and commissioned a questionnaire to clarify the status of TK as prior art, and approved the development of draft recommendations to authorities responsible for patent search and examination to take greater account of TK systems (WIPO/GRTKF/IC/6/14, para. 110). The present document contains the questionnaire requested by the Committee.

#### *What will the questionnaire be used for?*

8. Responses to the questionnaire will help illustrate how TK and genetic resources may be taken into account during patent procedures. This information, once collated, may help improve the effectiveness of any defensive protection strategies that custodians of TK and genetic resources choose to use. It will also help inform and focus the proposed draft recommendations to patent authorities. It is not intended to have any legal implications, and any comments on applicable laws are not intended to be definitive or authoritative. It is, rather, intended to promote the flow of practical information and the development of practical recommendations.

#### *Who should answer this questionnaire?*

9. To give a comprehensive picture of the current situation, input is sought from patent authorities responsible for search and substantive examination of patent applications. Other

participants in the Committee's work are also invited to answer on the basis of their experience.

*What sources are relevant?*

10. As this questionnaire has a practical focus, responses should draw on as wide a range of sources as possible to document the actual practice of patent authorities. Relevant sources may include national or regional laws and regulations, office practice guidelines and examination manuals, office determinations and policy statements, and specific judicial or administrative decisions.

[...]

*Scope and definitions*

13. While there is no formal international definition, TK can be characterized in general as knowledge which is:

- generated, preserved and transmitted in a traditional context;
- distinctively associated with the traditional or Indigenous culture or community which preserves and transmits it between generations;
- linked to a local or Indigenous community through a sense of custodianship, guardianship or cultural responsibility, such as a sense of obligation to preserve the knowledge or a sense that to permit misappropriation or demeaning usage would be harmful or offensive; this relationship may be expressed formally or informally by customary law or practices;
- 'knowledge' in the sense that it originates from intellectual activity in a wide range of social, cultural, environmental and technological contexts; and
- identified by the source community as being TK (see WIPO/GRTKF/IC/6/4, paragraph 58).

Genetic resources are defined in the Convention on Biological Diversity as "genetic material of actual or potential value;" and genetic material is in turn defined as "any material of plant, animal, microbial or other origin containing functional units of heredity.

*Some illustrative scenarios*

14. The status of TK can be very diverse when considered from the perspective of standard patent principles. TK need not be 'old' or 'ancient,' and may itself be novel or innovative. It may be held confidentially within a community or a smaller group, or it may be public knowledge. A TK holder may be the actual inventor (or one of several inventors) of a claimed invention. The following imaginary scenarios should help illustrate the context for this work. They refer to the kind of practical situation in which questions can arise as to the prior art status of TK, and the practicalities of locating it during the course of examination:

- TK has been openly used, non-commercially, within a remote, relatively small traditional community in a foreign country; it has been extensively used in that community, but has never been fully documented; there is no indication it has been known or used outside the community;

- TK has been used secretly within a traditional community, in part to produce a medical cure, and some products of this use have been sold beyond the community; the users are under an obligation through customary law to limit the dissemination of the knowledge as such to certain authorized members of the community;
- TK has been recorded in an ancient language on a fragile and valuable parchment, which is now in a public collection; this parchment is cited in a public catalogue but can only be accessed by bona fide historical scholars upon request;
- a claimed invention concerns an innovation essentially within an established TK system in one country, which would be obvious to a practitioner in that system, but may not be obvious to a researcher in the country where the patent is applied for.

[Questions and responses follow]



## PART I: ROLE OF THE OFFICE

*The questions in Part I seek to clarify the role of the patent authority in your jurisdiction, to give a basic context to the remainder of the questionnaire. If the patent authority does not conduct search and substantive examination, then you need only answer Parts I, II and V.*

**Q1. PRIOR ART SEARCHING**

In your jurisdiction, is a search conducted for relevant prior art during the prosecution of a patent application? If so, when is the search conducted? What triggers the search (e.g. a routine step during patent procedure, at the request of patent applicants, or at the request of third parties)?

Argentina

Q 1, 2 and 3: Article 27 (LP) – Subject to payment of the fee established in the Decree-Regulation, the National Patent Authority will conduct a substantive examination, in order to verify compliance with the requirements stipulated in Title II, Chapter I of this Law.

The National Patent Authority may request a copy of the substantive examination conducted by foreign examining offices under the terms of the Decree-Regulation and may also request reports from researchers working in universities or national science and technology institutes, who will be remunerated in each case, in accordance with the Decree-Regulation.

If the patent applicant considers it necessary, he may request that the Authority conduct the examination on his premises.

Once three (3) years have elapsed after the filing of a patent application without the applicant paying the appropriate fee for the substantive examination, the application shall be considered to have been withdrawn.

Article 27 (RLP) – The substantive examination of an application will not be carried out, if the preliminary examination has not been previously completed and approved. II – Once the filing procedures have been completed, the applicant may request the substantive examination. The Patent Officer will, within fifteen (15) days, assign the application to an examiner.

The substantive examination will be carried out within one hundred and eighty (180) days of the payment of the fee and will include the following phases:

(a) Prior art search. The examiner will endeavor to identify, insofar as he considers reasonable and feasible, the documents he considers necessary to determine whether the invention is novel and involves an inventive step. His search must cover all the technical sectors which may contain elements relevant to the invention, and the following documentation must be consulted:

1. national patent documents (patents and utility models granted and patent and utility model applications in progress).
2. published patent applications and patents from other countries.

3. technical literature other than that indicated in the above subparagraphs which may be relevant to the search.

(b) Examination. The examiner will investigate, insofar as he considers necessary and taking into account the results of the preliminary examination and the prior art search, whether the application fully satisfies the requirements of the Law and the associated Regulations.

III. – If he considers it necessary, the examiner may request:

(a) the applicant to submit, within ninety (90) days of receiving the request notification, a copy of the substantive examination conducted for the same invention by foreign patent offices where available, pursuant to Article 28 of the Law;

(b) specific reports relating to the subject matter of the invention from researchers working in universities or science or technology research institutes.

Article 28 (RLP) – The examiner will include among his observations those which were submitted by third parties, based on the data emerging from the publication issued in accordance with Article 28 of the Law, and which are based on the lack of novelty, industrial applicability or inventive step, or unlawful nature of the subject matter of the application, unless they are clearly incorrect and are declared as such.

Within sixty (60) days of the notification, the applicant must:

(a) amend the application so that it satisfies the legal and regulatory requirements; or

(b) express his opinion on the observations, refute them or make such clarifications as he considers relevant and expedient;

(c) If the applicant does not satisfy the requirements within the period indicated, his application will be considered to have been withdrawn.

#### Armenia

In our jurisdiction a search is a routine step during patent procedure.

#### Australia

Yes. However, if there is an International Search Report or the search results from another patent office, such as the EPO, USPTO, JPO or UK Patent Office, are available then IP Australia will use these results and will not necessarily conduct its own search. IP Australia will always conduct a search if these search results are not available.

Identifying and considering other search results and conducting original searches are the first step of examining a patent application. Additional searches may also be conducted during examination if needed. Conducting a prior art search or considering the search results from another patent office is a routine step of the patent examination process.

#### Austria

A prior art search is a routine stage which is carried out between six and eight months after a patent or utility model application has been filed. No request is necessary. The search is a routine and compulsory stage.

Azerbaijan

Search is carried out during examination. Apart from the applicant or other interested person, the petition for carrying out of the international search can be sent during 18 months from the date of application.

Bangladesh

Yes, during the prosecution of a patent application the examiner of patents conducts a novelty search for relevant prior art. It is to be noted here that in the department examination procedure is undertaken after receiving patent applications within the statutory time limit i.e. within 18 months and extendable up to 21 months as a routine steps.

Bolivia

Decision 486 of the Andean Community on a Common Intellectual Property Regime, a set of rules governing activities in Bolivia, states that patents shall be granted for inventions that are novel, i.e. which are not included in the prior art.

The prior art search is conducted for all applications during the substantive examination of patent applications. The search referred to is part of the routine procedure within the substantive examination.

Brazil

Prior art search is conducted during the technical examination stage of the patent application.

According to article 33 of the Brazilian Industrial Property Act (Lei 9,279/96), examination of the patent application shall be requested by the applicant or by a third party within 36 months from deposit date, under pain of shelving the application.

The search is triggered by a request for technical examination of the application, from either the patent applicant or a third party.

Bulgaria

Yes, a search is conducted. The search for relevant prior art could be conducted up to 15 months before the first publication of application, but more often the search is conducted as a routine step during patent procedure. Additional search for relevant prior art could be conducted at disputes concerning decisions of the Examination Department before the Disputes (Appeals) Department or before court or arbitration procedures.

Burundi

No prior art searching is conducted during the processing of patent applications.

Chad

A prior art search is conducted during the processing of patent documents and is a routine stage of the patent procedure.

### China

According to Chinese Patent Law, there are three kinds of patents, which are invention patent, utility model patent and design patent. Only invention patent application is subject to substantive examination. The answers in this questionnaire are all for invention patent applications.

Search for relevant prior art is conducted after the application enters the procedure of substantive examination. It is at the request of patent applicants. However, if necessary, the State Intellectual Property Office of China (SIPO) may, on its own initiative, conduct the search.

### Colombia

Yes, in Colombia a prior art search is conducted during the processing of a patent application. More exactly, this search is conducted during the substantive examination.

The search is carried out once the applicant has requested a patentability examination to be conducted. In accordance with the provisions of Article 44 of Decision 486, the industrial property standard in force in Colombia, “within six months of the publication of the application, irrespective of whether objections have been raised, the applicant shall request an examination as to whether the invention is patentable”.

### Congo

Our authority does not conduct substantive examinations. Nevertheless, an examination of form does exist so as to establish whether the subject matter of an invention does not form part of the subjects excluded from patentability.

### Croatia

According to our jurisdiction, prior art searching is conducted on a Request for the Granting of a Patent, made by applicant.

Other possibility is on the request of the third party, who is filing Opposition to the grant of a consensual patent.

### Czech Republic

The prior art search is carried out by an examiner of the office.

### Denmark

Prior art searching is a routine step during patent procedure. No specific request from the applicant is required. The search is conducted within 8 months from the filing date of the application.

### Egypt

In our Jurisdiction, a search has to be conducted for relevant prior art during prosecution of patent application.

The search is conducted as a routine step during patent procedure, which is relevant to Article (16) of the Law on the protection of intellectual property rights.

### Eurasian Patent Office

A patent search is a compulsory stage of the patent procedure. As a rule, the patent search is carried out at the formal examination stage or following completion of that stage, without a special request by the applicant or third parties.

### European Patent Office

The procedure for the grant of European patents is an examination procedure beginning with a formalities examination and a mandatory search report. If a European patent application has been accorded a date of filing and is not deemed to be withdrawn by virtue of Article 90(3) European Patent Convention (hereinafter "EPC"), a European search report is drawn up on the basis of the claims, with due regard to the description and any drawings, in the form prescribed in the Implementing Regulations (Art. 92(1) EPC in conjunction with Rule 44-47 EPC) and dispatched to the applicant along with a preliminary, non-binding opinion on whether the application meets the requirements of the EPC (as of 01.07.2005).

### Fiji

Prior art searching: The principal legislation in Fiji that governs patents is the Patents Act (the Act), which was last revised in 1978 and is currently being reviewed. In our jurisdiction a search is conducted before letters patent are granted and all patent applications are sent to IP Australia in Canberra. If IP Australia states that the invention has already been registered, that is sufficient for Fiji and no registration occurs on our side. Where there is no record of registration, IP Australia conducts its own search and makes recommendations and we decide whether to register the patent or not. If letters patent are granted then it is provisional for six months only and any interested party may petition the High Court and seek certain declarations concerning the provisional patent granted.

### Finland

We do the search after checking the formalities; the search is a routine step during patent procedure for all applications which fulfil the formal requirements.

### France

Any application which has received a filing date and whose content allows a search report to be drawn up is the subject of a document search, the result of which is presented in the form of a preliminary search report.

Article L. 612-14 of the Intellectual Property Code (CPI) provides in that regard that "subject to the provisions of Article L. 612-15 and provided it has received a filing date, a patent application shall give rise to a search report on the prior art which may be taken into consideration in order to assess, pursuant to Articles L. 611-1 and L. 611-14, the patentability of the invention. This report is drawn up subject to conditions fixed by decree".

This search procedure is launched only if the applicant has paid the search report fee (cf. guidelines relating to the examination of patent applications Section B, Chapter II, 1, 2 and 3 heading 8) within one month of the patent application being filed, if he has requested a search report to be drawn up immediately. The applicant may postpone the drawing-up of the search report.

The document search is not carried out directly by INPI. It is conducted by the European Patent Office (EPO) on INPI's behalf.

### Georgia

According to Patent law of Georgia our office conducts the search to determine the prior art for the invention described in the application (Art. 35.1 Patent Law of Georgia). It is a routine step during patent procedure.

### Germany

In the patent system of the Federal Republic of Germany, a prior art search is conducted under Sec. 44 Patent Law during the examination procedure or as an isolated search under Sec. 43 Patent Law.

The German Patent and Trade Mark Office (DPMA), upon request (examination request or search request), identifies those publications which have to be taken into consideration in assessing patentability of the invention in respect of which an application has been filed. The request may be filed by the patent applicant and by any other person within seven years after the date of filing. Any person is entitled to inform the Patent Office of publications which might oppose the grant of a patent. Those will be taken into consideration during the examination.

### Ghana

Yes, in our jurisdictions a search for prior art is relevant during the prosecution of a patent application. This is because it helps in arriving at facts about the existing invention. The searches are sometimes conducted on our own initiative while other times, it is on the request of third parties when there are disputes in finding about the new inventions and its functions.

### Iceland

The Icelandic patent office relies on the Danish patent office for search and examination of Icelandic first filings. In Iceland the results of other patent offices, e.g. the EPO are sometimes used as ground for granting a patent and in some cases just the IPER is sufficient. The Icelandic patent office though has to check the Icelandic material as the Icelandic patent register is not accessible on the Internet. This is done after the application has gone through examination in the Danish patent office or other offices and before the patent is issued.

### Ireland

The Irish patent law makes provision whereby the patent office, upon request of the applicant, will have a search report on the invention prepared. Currently, the search is conducted by the UK Patent Office at the request of the Irish Office. A search report must be requested by the applicant within 21 months from the applicant's filing date or the priority date claimed.

There is an alternative to requesting the preparation by the patent office of a search report. An applicant who has applied for a patent for the invention to the United Kingdom, German or European Patent Office (EPO), or who has applied under the PCT, can submit a statement to that effect to the Irish Patent Office. In this situation, a copy of the search report prepared in respect of the foreign application, or a copy of the published specification of the

patent granted by either of these outside offices, must be submitted within two months of publication.

Ireland is a Contracting State to the European Patent Convention (EPC) and the patents granted by the EPO has, subject to validation procedures, the same effect as if it were granted by the Irish Patent Office.

#### Italy

In our jurisdiction a search is not conducted for relevant prior art during the prosecution of a patent application.

#### Japan

Yes. We conduct a prior art search in the examination process. Upon receipt of a request for examination filed by the applicant or any third party, a JPO examiner will start conducting a substantive examination and, at the same stage, searching prior art will be started.

#### Kenya

Yes, the search for relevant prior art during the prosecution of a patent is conducted. This is done as soon as the application is found to comply with the formal requirements and at the instruction of the Managing Director.

#### Republic of Korea

We conduct prior art searches in the examination process, and there are no special requests for prior art searches other than examination requests. As a rule, we examine only cases for which an examination has been requested. A third party, including the applicant, can request an examination.

In some cases, we are unable to conduct a prior art search or we can only conduct a limited search. Searches may be limited, for example, when there is an addition of a new matter, a violation of good public order and customs, an incomplete invention, an invention that has no industrial applicability, a failure to meet the requirements of unity of invention, and when the meaning of an invention is unclear because of a grossly inadequate statement in the specification.

#### Lithuania

The Office does not provide any search of a patent application.

#### Malaysia

Search is conducted as a routine step during patent procedure.

#### Mauritius

Yes. Search is conducted after according a filing date as a routine step during patent procedure.

## Mexico

Yes. The search is conducted when a user requests a prior art search report in a specific area of technology, and the user pays the relevant fee for the service performed or, as appropriate, where a patent application is substantively examined by the Institute.

In order to express a substantive opinion on an invention, firstly a prior art document search must be carried out. From this search, documents are derived which relate to the technical field of the invention and which may affect the novelty or inventive step; these documents should be retrieved from patent or industrial design document databases and analyzed from a technical/scientific point of view.

The search examination may be conducted in a number of different ways:

1. PCT patent applications. — In this case, the search report issued by WIPO is used and an additional search is carried out in the National Patent Bank (BANAPA).
2. Patent applications with priority. — In this case, if a search report exists issued by a particular international office for applications from the family of patents, with the character of a search authority, the report is used and an additional search is conducted in BANAPA.
3. National patent applications or applications without priority. — In this case, the full search examination is carried out in patent document databases, scientific document databases and gene banks (where appropriate), by chemical structure (where required) and in BANAPA.

During the substantive examination of a patent application, the search is conducted in order to determine the documents closest to the prior art, so as to examine subsequently the novelty and inventive step of the claims relating to the invention.

The examiner must read the invention carefully in order to determine the essential elements which he will use in order to carry out a search examination and the substantive examination: definition of the technical problem and the solution thereto in the prior art, the technical features of the invention (technical effect) and its contribution to the solution to the technical problem, and also the clarity of the description and the claims and the support therefor in the description.

This may also be based on the request made by a user in order to determine the prior art relevant to a specific technological development, with the possibility of a future patent application.

As already mentioned in the previous part of the question, a full search is carried out in the case of applications without priority, and always whatever the case in BANAPA.

## Republic of Moldova

The office (AGEPI) conducts the search for filed applications. The search is conducted after the filing by the applicant or a third party of the request for substantive examination, that can be sought on filing of the application or within 30 months following the filing date of the application. (Art. 16(8); Art. 16(10); Art. 16(12) of the Law No. 461-XIII of May 18, 1995 on Patent for Inventions, hereinafter the Law).



Monaco

As the procedure for granting patents currently stands, no prior art search is conducted (cf. Q2).

The Netherlands

Questions 1 to 18: On the questions 1 to 18 we would like to inform you that the practice of the Netherlands Intellectual Property Office is consistent with the guidelines of the EPO regarding search and examination. Because the EPO practice is very well known we have concluded that a one on one response to these questions is not necessary.

Norway

Yes. For an application where no priority is claimed, search is conducted within seven (7) months after filing of the application. For an application where priority is claimed from a previous application, search is conducted approximately three (3) to four (4) years after filing of the application.

Search is a routine step during patent procedure.

Panama

Yes. A prior art report is produced as part of the patent grant procedure. This report is requested by the applicant at the latest 14 months after the application filing or claimed priority date.

The Philippines

Yes. After the applicant has complied with the formal requirements, the application shall be classified and a search conducted to determine prior art.

Poland

In our jurisdiction prior art searching is conducted, by the same patent expert, during patent procedure before substantive examination. Prior art searching is a routine stage of patent procedure.

Portugal

Yes. A preliminary search is conducted 8 months after the patent application and is repeated during substantive examination, using electronic databases such as Internet, EPOQUE and internal PT Office's databases.

A search for prior art could also be performed when a person requests it.

Romania

Yes. The documentary search is conducted with a view to determining the prior art. It is carried on during the substantive examination, as a compulsory step thereof.

Upon request by the applicant, a search report is drawn up and published simultaneously with the patent application, right after the expiry of 18 months from the date of filing the application, or after the publication of the application, until a decision is taken.

### The Russian Federation

Applications are searched following the submission of a request by an applicant or a third party for the conduct of a substantive examination on an application (Article 21(7) of the 1992 Patent Law of the Russian Federation, with the amendments and updates of 2003 — hereinafter the Law) or the conduct of an information search for the prior art base (Article 21(10) of the Law). A search is conducted only after an examination of form has been completed with a positive result.

### Senegal

No.

### Singapore

In Singapore, a search for relevant prior art is conducted during the prosecution of a patent application. Several options, to which this search can be achieved, are available to patent applicants to choose from. In brief, patent applicants can rely on the search results of their corresponding applications or corresponding international applications, or they can request IPOS to conduct the search. When a request to IPOS for a search is sought, IPOS would forward the request to one of her Examiners (IP Australia, Austrian Patent Office, Danish Patent & Trade Mark Office). For PCT (SG) national phase entry applications, the option to rely on the International Search Reports is also available.

The search process in Singapore is triggered by the patent applicant himself after receipt of a notice from IPOS stating that the patent application complies with the formal requirements. Depending on the option chosen, the corresponding requirements (e.g. furnishing of fees, prescribed documents, meeting prescribed time periods) apply.

[Reference is made to section 29 of the SG Patents Act<sup>3</sup> & its corresponding rules.]

After a patent is granted, any person may request for a search and examination to be conducted in respect of any claim or claims in the specification of a patent. The grounds for making such requests however must be satisfied, and the Registrar of Patents, IPOS, shall not grant the request if he is of the view that it is frivolous, vexatious or an abuse of the process.

[Reference is made to section 38A of the SG Patents Act & its corresponding rules.]

### Spain

Yes. A prior art search is always conducted during the routine procedure for processing patent applications.

### Sweden

Q1 and Q2: In Sweden, a prior art search and a substantive examination are performed as routine steps during patent procedure.<sup>4</sup> The search and examination are conducted at the same time, normally six months after filing of the patent application.

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<sup>3</sup> [Internet access to the Patents Act is available at http://www.ecitizen.gov.sg/frame\\_law.htm](http://www.ecitizen.gov.sg/frame_law.htm)

<sup>4</sup> Swedish Patents Decree (PK) Section 26

A third party has the possibility during the patent procedure to make an objection and put forward documents relevant to the patent procedure.<sup>5</sup> The third party may file an opposition to the patent office against the validity of the patent, within nine months from the granting of the patent, if the patent<sup>6</sup>:

1. does not fulfil fundamental criteria for patentability i.e. novelty, inventive step or industrial applicability, or is directed to non-patentable subject matter<sup>7</sup>.
2. does not describe the invention sufficiently for a person skilled in the art to perform the invention.
3. if it contains matter that was not in the application as originally filed.

Moreover, after this nine-month period of opposition it is possible in a court to revoke or limit the patent on grounds 1-3 above or if the patent protected scope has been extended after the grant<sup>8</sup>

### Thailand

Yes, we will search prior art after the request of patent applicants.

### Tonga

Searching for prior art is not possible at this stage since we do not have the facility to do so. We however limit our service to “Examination as to Formality”, as part of routine step during patent procedure.

### Trinidad and Tobago

Searches are conducted in the relevant prior art, disclosed in print, speech and any other means as a routine step in the prosecution of the application. The administrative trigger is the payment of the search and examination fee by the applicant or their representatives.

### Turkey

Within 15 months from the date of filing of application, the applicant shall request to conduct the search on the State of the Art file before the Institute and shall pay the relevant fee. The search report is established in consideration of the specification, the drawing(s) and the claim(s) by the Search Authority to be designated by the Institute from amongst the internationally recognized search authorities such as the EPO, the Russian Patent Office, the Danish Patent Office and the Swedish Patent Office.

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<sup>5</sup> Swedish Patents Decree Section 36

<sup>6</sup> Swedish Patents Act (PL) Section 25.

<sup>7</sup> Non-patentable matters such as:

- methods of treatment of the human or animal by therapy or surgery or diagnostic methods performed on humans or animals
- plant variety or animal race
- an essentially biological process to produce a plant or an animal
- the human body at various stages of its formation and development and the simple discovery of one of its elements
- inventions where commercial use is contrary to *ordre public*

<sup>8</sup> Swedish Patents Act Section 52

The state of the art Search Report foreseen to be established by the Institute in respect of patents shall not be established for utility model certificates. However, upon filing the private request of the applicant or registrant of the utility model certificate, before the Institute for establishment of the Search Report on the state of the art, such report shall also be established for the Utility Model Certificate.

#### Ukraine

In accordance with the legislation of Ukraine, a search is conducted in order to determine the relevant prior art after the examination of form at the substantive examination stage (qualifying examination). The search is a standard part of the patent procedure.

#### Venezuela

Yes, prior to the grant, since the content of a patent application being processed by the competent national office is considered part of the prior art.

A routine stage during the grant procedure triggers the search, at the request of the applicant.

#### Viet Nam

According to Viet Nam's jurisdiction, prior art searching of invention is conducted during substantive examination of an invention/utility solution application upon a search request (Article 22 Decree 63/CP) and/or a substantive examination request filed by the applicant or a third party.

## Q2. SUBSTANTIVE EXAMINATION

In your jurisdiction, are patent applications given substantive examination? If so, when is the examination conducted, and what triggers the examination (e.g. a routine step during patent procedure, at the request of patent applicants, or at the request of third parties)? Is examination conducted at the same time as searching, or separately? What procedures exist for third parties to challenge the validity of a patent application or a granted patent?

### Argentina

Q 1, 2 and 3: Article 27 (LP) – Subject to payment of the fee established in the Decree-Regulation, the National Patent Authority will conduct a substantive examination, in order to verify compliance with the requirements stipulated in Title II, Chapter I of this Law.

The National Patent Authority may request a copy of the substantive examination conducted by foreign examining offices under the terms of the Decree-Regulation and may also request reports from researchers working in universities or national science and technology institutes, who will be remunerated in each case, in accordance with the Decree-Regulation.

If the patent applicant considers it necessary, he may request that the Authority conduct the examination on his premises.

Once three (3) years have elapsed after the filing of a patent application without the applicant paying the appropriate fee for the substantive examination, the application shall be considered to have been withdrawn.

Article 27 (RLP) – The substantive examination of an application will not be carried out, if the preliminary examination has not been previously completed and approved. II – Once the filing procedures have been completed, the applicant may request the substantive examination. The Patent Officer will, within fifteen (15) days, assign the application to an examiner.

The substantive examination will be carried out within one hundred and eighty (180) days of the payment of the fee and will include the following phases:

(a) Prior art search. The examiner will endeavor to identify, insofar as he considers reasonable and feasible, the documents he considers necessary to determine whether the invention is novel and involves an inventive step. His search must cover all the technical sectors which may contain elements relevant to the invention, and the following documentation must be consulted:

1. national patent documents (patents and utility models granted and patent and utility model applications in progress).
2. published patent applications and patents from other countries.
3. technical literature other than that indicated in the above subparagraphs which may be relevant to the search.

(b) Examination. The examiner will investigate, insofar as he considers necessary and taking into account the results of the preliminary examination and the prior art search, whether the application fully satisfies the requirements of the Law and the associated Regulations.

If he considers it necessary, the examiner may request:

(a) the applicant to submit, within ninety (90) days of receiving the request notification, a copy of the substantive examination conducted for the same invention by foreign patent offices where available, pursuant to Article 28 of the Law;

(b) specific reports relating to the subject matter of the invention from researchers working in universities or science or technology research institutes.

Article 28 (RLP) – The examiner will include among his observations those which were submitted by third parties, based on the data emerging from the publication issued in accordance with Article 28 of the Law, and which are based on the lack of novelty, industrial applicability or inventive step, or unlawful nature of the subject matter of the application, unless they are clearly incorrect and are declared as such.

Within sixty (60) days of the notification, the applicant must:

(a) amend the application so that it satisfies the legal and regulatory requirements; or

(b) express his opinion on the observations, refute them or make such clarifications as he considers relevant and expedient;

(c) If the applicant does not satisfy the requirements within the period indicated, his application will be considered to have been withdrawn.

### Armenia

In our jurisdiction on the basis of a request by an applicant, which may be submitted up to seven years after the application has been received, the Office will carry out a substantive examination.

### Australia

Yes. IP Australia operates under a deferred examination system, where the applicant must ask for examination. A request for examination must be filed within 5 years of filing a complete application or the application will lapse. The *Patents Act 1990* also provides that the Commissioner of Patents may issue a direction to a patent applicant before this date. This is a direction to the applicant to request examination and most requests for examination are filed as a result of this direction. Currently this direction is given at approximately 40 months after the priority date of the application. Applicants then have six months in which to request examination or the application will lapse. The patent applications of patent applicants who request examination are then examined. If an applicant would like to request their application be examined before the Commissioner of Patents issues a direction to request examination, they can do so.

Searching and examination are conducted at the same time.

Before or during examination a third party may supply the Commissioner of Patents with a notice stating that an invention is not novel or lacks an inventive step and supply

copies of documents to support the statements in the notice. This notice and any associated documents are considered during examination of the patent application.

Once a patent application has been examined and accepted, a third party may oppose the grant of a patent before the Commissioner of Patents. When this occurs a hearing is conducted during which both the patent applicant and the third party have an opportunity to present evidence and be heard.

The grounds on which a patent can be opposed are set out in section 59 of the Patents Act 1990 and are:

- (a) the nominated person is not entitled to the grant of the patent or is only entitled to the grant of the patent in conjunction with another person;
- (b) the invention is not a patentable invention (that is, is not novel, is obvious, is not useful, or was secretly used);
- (c) the specification does not describe the invention fully;
- (d) the claims are not:
  - (i) clear and succinct; or
  - (ii) fairly based on the matter described in the specification.

After a patent has been granted a third party may seek revocation of the patent by applying to a prescribed court. In these circumstances the court can hear evidence from both the patent owner and the third party.

Alternatively, a third party may seek re-examination of a patent at any time after the patent has been granted. The grounds on which a third party may seek re-examination are limited to questions of novelty and inventive step. When a patent is re-examined only prior art documents are considered.

Information that is made publicly available by doing an act is not considered. (See Question 3 for an explanation of the prior art base in Australia.) If a third party would like information that is made publicly available by doing an act to be considered, then they must either oppose the granting of the patent or if the patent has already been granted, seek revocation of the patent.

### Austria

For patent applications, the examination is carried out at the same time as the search and by the same technical examiner. This is a routine and compulsory stage.

As regards utility models, no provision is made for an examination.

(Only the search is compulsory).

### *Procedures for third parties to challenge validity:*

<u>Information office</u>	In person or by telephone	Bibliographical data (applications or patents or utility models granted)
Register of patents and utility models	In person or by telephone	Bibliographical data Valid or expired

Service section (fee-paying)	In writing	Extract from the certified register (only for patents or utility models granted)
On line (free of charge)	Bibliographical data (applications or patents and utility models granted) Non-certified extracts from the register	Only according to the application or registration number
On line (fee-paying)	Bibliographical data (patents and utility models – applications or those granted) Non-certified extracts from the register	According to the application or registration number According to the IPC According to the title and the applicant
Gazette (paper edition – fee paying) or on line (free of charge)	list of applications for public inspection list of patents granted list of registered utility models list of applications withdrawn or rejected	List of bibliographical data
CD-ROM (fee paying)	Full text of applications available for public inspection	Available in the Office library, for free consultation

No information is given on the content of an application.

#### Azerbaijan

Examination is preceded in essence with search, in some cases search proceeds and during carrying out of examination and revealing of patentability of the application. During usual procedure, in case of the positive decision of examination, the application is subject to publications (item 30), and after 6 months (item 32) is granted a patent. On demand of the applicant or other interested person under the application sent within 18 months from the date of application, examination in essence can be reserved at the international patent office (e.g. Rospatent) (item 29, item 10).

Any interested person within 6 months from the moment of the publication of data on the application (item 31), and also within 6 months from the moment of the publication of data on the patent (item 34) can address with the proved objection which goes to the applicant obliged during 2 months from the date of its reception to present the answer in the Appeal commission (item 31).

#### Bangladesh

Yes, substantive examinations are done for the patent applications in the department. After the patent application is filed in the department, it is published in the Bangladesh Gazette for general information.

(a) When there is no opposition, the application is transmitted to the examiner of patents for substantive examination;



(b) At first novelty search is done. If there appears no anticipation, then patent examination starts;

(c) The third parties can challenge the validity of patent application before examination of the patent application or after grant of patent and within four months after the date of its publication in the Bangladesh Gazette.

### Bolivia

Yes, our legislation provides for the conduct of a substantive examination, in the sense that it is a stage of the patent procedure in accordance with Article 44 of Decision 486 of the Andean Community, which states:

Article 44. – The applicant shall request that an examination of the patentability of the invention be conducted within six months of publication of the application, regardless of whether any objections have been filed. Member Countries may charge a fee for conducting the examination. If that period elapses without the applicant having requested the examination, the application shall be considered to have been abandoned.

This examination is conducted at the same time as the search.

The challenge procedures are at the Objection (Article 42 of Decision 486) and the Invalidation of the Patent (Article 75 of the same Decision) stages.

Article 42. – Within a period of 60 days following the date of publication, any person with a legitimate interest may, on one occasion only, submit valid reasons for contesting the patentability of the invention.

The competent national office shall grant once, upon request, a sixty-day extension in which to provide valid reasons for that opposition.

Reckless objections may be sanctioned if so stipulated by domestic law.

Article 75. – The competent national authority may, either ex officio or at the request of a party, and at any time, declare a patent null and void, where:

(a) the subject matter of the patent is not an invention according to the requirements stipulated in Article 15;

(b) the invention fails to comply with the requirements for patentability set out in Article 14;

(c) the patent was granted for an invention covered by Article 20;

(d) the patent fails to disclose the invention, as required by Article 28 and, where relevant, Article 29;

(e) the claims included in the patent are not fully substantiated by the description provided;

(f) use of the patent granted has been broader than was indicated in the original application and requires having to extend its scope of protection;

(g) where relevant, the products or processes in respect of which the patent is being filed have been obtained and developed on the basis of genetic resources or their byproducts originating in one of the Member Countries, if the applicant failed to submit a copy of the contract for access to that genetic material;

(h) where relevant, the products or processes whose protection is being requested have been obtained or developed on the basis of TK belonging to indigenous, African American, or local communities in the Member Countries, if the applicant has failed to submit a copy of the document certifying the existence of a license or authorization for use of that knowledge originating in any one of the Member Countries; or,

(i) there are grounds for absolute invalidation according to domestic legislation covering administrative acts.

Where the grounds specified above are applicable only to some of the claims or some parts of a claim, invalidation shall be pronounced only in respect of those claims or those parts of the said claim, as the case may be.

The patent, claim, or part of a claim that has been invalidated shall be deemed null and void as from the filing date of the patent application.

### Brazil

A substantive examination is a prerequisite for the granting of a patent. It is initiated 60 (sixty) days from the publication of the application and it is triggered by a request with this purpose, from either the patent applicant or a third party.

Prior art searching is part of the technical examination of the patent application.

Interested parties may present documents and information with a view to challenge the validity of a patent during the technical examination of the patent application.

Interested parties may also apply for administrative nullification of a patent within 6 (six) months from the date the patent was granted.

Interested parties may bring judicial action for nullification of a patent during the entire period of its validity. A respondent in a judicial process may invoke nullification falling upon an expired patent as an argument for defense, when it applies.

### Bulgaria

Yes, patent applications are given substantive examination. Concerning the Patent Law of the Republic of Bulgaria the examination is conducted as a routine step during patent procedure. Third parties may appeal before the Disputes Department of the Patent Office the following decisions of the Examination Departments: 1. complete or partial refusal to grant a patent; 2. suspension of the patent application procedure; 3. determination of priority; 4. refusal to renew time limits.

### Burundi

Our Authority does not conduct a search or substantive examination of patent applications. Article 35 of the above-mentioned draft law stipulates that “a patent shall be granted without prior substantive examination, i.e. with no guarantee either of the reality, novelty or merit of the invention, or of the accuracy of the description, at the risk of the applicants and without prejudice to the rights of third parties”.

### Chad

A substantive examination is conducted by the African Intellectual Property Organization (OAPI) after the patent application has been filed.

After the filing record has been produced using the appropriate form, the Ministry of Industrial Property forwards the application to the OAPI in Yaoundé (Cameroon) within five working days of the filing date; the substantive examination is conducted by the OAPI and is a routine procedure.

The procedures available to third parties for challenging the validity of a patent application are as follows: action may be taken by any interested person in any competent authority, which must take a decision in accordance with Articles 34 and 39.1(b).

### China

In the State Intellectual Property Office of China (SIPO), invention patent applications are subject to substantive examination. Upon the request of the applicant, made at any time within three years from the date of filing, and after the publication of the application, SIPO will conduct a substantive examination. The examination is conducted at the same time as the search by the same examiner. There is no special procedure for the third party to challenge the validity of a patent application, but the public can supply opinions or proof to be considered by the examiners. The third party can challenge the validity of a granted patent through Invalidation Declaration procedure.

### Colombia

Yes, patent applications are given substantive examination.

The substantive examination is conducted once the application publication phase has been exhausted, at the patent applicant's request, pursuant to Article 44 above of the Andean rules governing the matter.

The substantive examination is conducted at the same time as the prior art search.

The Andean rules establish, within the patent application process, the opportunity for interested third parties to raise objections to the patent application. Article 42 states that "within the period of sixty days following the publication date, any person who has a legitimate interest may raise, on one occasion only, a justified objection which may impair the patentability of the invention".

Furthermore, once a patent has been granted, the competent national authority may decree, *ex officio*, or at the request of any person and at any time, the absolute nullity of a patent where one of the causes provided for in Article 75 of Decision 486 mentioned above arises (for example: where the subject matter of the patent does not constitute an invention, is excluded from the patent or did not satisfy the legal requirements provided for its grant; where the access contract has not been submitted, and the products or procedures for which a patent is applied for have been obtained or developed from genetic resources or from their derived products which originate from any of the member countries of the Andean Community; or, where the copy of the document validating the license or authorization for use of the TK of indigenous Afro-American or local communities of the member countries of the Andean Community has not been submitted, where the products or procedures for which protection is requested have been obtained or developed from said knowledge).

Similarly, the competent national authority may revoke a patent where it has been granted to a person who did not have the right to obtain it. This action of nullity may be brought only by the person to whom the right to obtain the patent belongs.

### Congo

The Bangui Agreement of March 2, 1977, to which the Republic of Congo has acceded, provides in Annex I, Article 20 for a search report in order to establish whether at the time a patent application is filed, a similar patent application has been filed previously for the same subject matter, and whether the invention is novel, involves an inventive step and is industrially applicable.

However, to date this provision has not yet been the subject of an implementing regulation to be enforced by the OAPI Administrative Council in order to determine the priority areas.

### Croatia

According to our jurisdiction there are two possibilities for patent granting in the respect of substantive examination.

There is a possibility for granting a patent without substantive examination procedure. This patent is called consensual patent.

During the whole period of duration of consensual patent there is a possibility to conduct substantive examination, on the request of the third party, who is filing opposition to the grant of a consensual patent.

Substantive examination is conducted after the request of the patent applicant for the Grant of a patent on the basis of a substantive examination of a patent application.

According to our legislation, the Office may carry out the substantive examination of a patent application completely or partially, through one of the national patent offices of other countries with which it has concluded a cooperation agreement. If there is a need for additional examination of a patent application, if search is necessary, they are conducted at the same time.

The following procedures exist for third parties to challenge the validity of a patent application or a granted patent:

- opposition to the grant of a consensual patent.
- proposal for the cancellation of the decision on the grant of a patent.
- proposal for the declaration of nullity of a patent.
- an action for the establishment of the patent protection right.
- action for the infringement of the inventor's moral right.

### Czech Republic

Examination of the invention is conducted by the same examiner within the full examination of the patent application after the prior art search is carried out.

The full examination is conducted, in accordance with Section 33, Paragraph 2 of the Act 527/1990 Coll., as amended (hereinafter only the “Act”) at the request of the patent applicant, it can however be conducted at the request of another person or *ex officio*.

The application for conducting full examination must be filed at the latest within 36 months from the filing date.

Once the patent application is made public, any third party can file written observations on the patentability to the office to challenge the validity of the patent application in accordance with Section 32 of the Act.

Once the patent is granted, it is possible to file a proposal for its revocation in accordance with Section 23 of the Act.

### Denmark

Substantive examination is performed. The examination is conducted in connection (at the same time) with the search as a routine step during patent procedure. After grant the patents validity may be challenged by third parties through an administrative procedure performed at the Danish Patent and Trademark Office or the patent can be challenged in a trial at the civil courts.

### Egypt

Yes, the patent applications are given substantive examination. The examination is a routine step during patent procedure. The examination is conducted at the same time as the search.

### Eurasian Patent Office

A substantive examination is a compulsory stage of the examination of a patent application. An examination is conducted only at the applicant’s request, which must be filed within eight months of the publication date of the patent search report (i.e. after the patent search has been conducted).

The validity of a patent application may be terminated based on the entry into force of a decision taken by a court or other competent authority of a Contracting State, if it is acknowledged that the inventor or person authorized to file a Eurasian application is a person who is not the applicant and has not transferred the right to obtain a Eurasian patent to the applicant.

If a decision taken by a court or other competent authority of a Contracting State recognizes another person as the patent owner, that person may request the grant of a Eurasian patent in his name.

A Eurasian patent may be revoked in full or in part on an objection raised against the grant of a Eurasian patent, filed with the Eurasian Patent Office in accordance with the administrative revocation procedure, in cases where:

- an Eurasian patent is granted unlawfully as a result of non-compliance of an invention with the patentability requirements.
- the claims contain features missing from original Eurasian application documents.

Also, during the whole of the period of its validity a Eurasian patent may be recognized as invalid either in full or in part on the territory of a Contracting State, in accordance with the procedure provided for in that State, in cases where:

- an Eurasian patent is granted unlawfully as a result of non-compliance of an invention with the patentability requirements.
- the claims contain features missing from original application documents.
- the name of the inventor or patent owner is incorrectly stated in a Eurasian patent.

### European Patent Office

Substantive examination to establish whether a European patent application and the invention to which it relates meet the requirements of the EPC can only be performed after a written request for examination has been filed and the requisite fee has been paid. The request for examination can be filed by the applicant up to the end of a period of six months after the date on which the European Patent Bulletin mentions the publication of the European search report (see Art. 94 EPC). If no request for examination has been filed by the end of that period, the application is deemed to be withdrawn. Chronologically speaking, examination is thus not conducted at the same time as searching.

Following the publication of the European patent application, any person may present observations concerning the patentability of the invention in respect of which the application has been filed. Such observation must be filed in writing and must include a statement of the grounds on which they are based. That person shall not be a party to the proceedings before the European Patent Office (see Art. 115 EPC).

Within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the European Patent Office of opposition to the European patent granted (see Art. 99 EPC). European patent law does not require the opponent to have any specific interest in the success of his opposition, be it a legal interest or of any other nature. Opposition can only be filed on the grounds that:

- the subject matter of the patent is not patentable within the terms of Article 52 to 57 EPC (Patentability).
- the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 83 EPC).
- the subject-matter of the European patent extends beyond the content of the application as filed (Article 123(2) EPC).

Moreover, an appeal shall lie from decisions of the Receiving Section, Examining Divisions, Oppositions Divisions and the Legal Division (see Art. 106 EPC).

### Fiji

When a patent application is made, the relevant documents are sent to AIPO for clearance and a response is forthcoming within two months. This is a routine procedure for all applications and the rights and privileges granted are conferred by letters patent under Fiji's seal. Third parties can challenge the validity of a patent by giving notice in writing of their opposition to the Administrator General within three months of the date of the first

notice of the application for the letters patent. The Administrator General is required to hear the parties and any witness they may call intimate this to the Attorney General who will inform the parties within three months after notification from the Administrator General of his decision. Where the answer is favorable to the person holding a provisional certificate, the letters patent is issued with certain reservations, provisos and conditions that may be necessary. Should the decision be against the provisional certificate holder then he or she can appeal to the High Court within three months from the Attorney General's decision.

### Finland

Yes, we give substantive examination to patent applications as a routine step during the prosecution. Examination is conducted at the same time as searching and an official action stating the results is then sent to the applicant.

Third parties have the possibility to file an opposition against a granted patent within nine months of the date of the grant of the patent. Third parties may also present observations concerning the patentability of an invention during the prosecution of the patent application. Third parties can also bring an action for invalidation of a patent before the court.

### France

In France, applications are the subject of an examination of form and a substantive examination, without, however, being able to be rejected on the basis of a lack of inventive step. As noted above, a search report is drawn up.

This report "cites the documents which may be taken into consideration in order to assess the novelty of the invention, subject matter of the patent application and inventive step" (Article R. 612-57 CPI).

The applicant is notified immediately. Within a regulatory deadline, if he so wishes the applicant may respond in all cases, even where the preliminary search report does not cite any documents. The applicant must respond when the preliminary search report makes prior art citations. A final report is then drawn up on the basis of the applicant's response to the search report, and possible observations made by third parties and attached to the granted patent.

The examination is therefore a routine stage of the patent procedure. It is separate from the search stage. Unless the application does not relate to an invention or if the invention is clearly devoid of novelty, the examination cannot be concluded with the application being rejected. Any third party may appeal against a decision to grant a patent in the competent court of appeal. The courts may annul a patent granted.

### Georgia

In our jurisdiction patent applications are given substantive examination. If it is proved that an application for an invention meets the requirements of the examination as to form, then Sakpatenti conducts the examination on novelty on the basis of the search for prior art and makes a documentary conclusion (Art. 35.1, Patent Law of Georgia).

The examination is a routine step during patent procedure. The examination conducts at the same time as searching.

Within three months from the data publication in the Official Bulletin the interested person can furnish the motivated protest on granting of the patent, which may reject the

criteria of patentability, and has the right to oppose the patent examination decision at Sakpatenti Chamber of Appeals (Art. 37.2 and 68, Patent Law of Georgia).

### Germany

Patent examination under Sec. 44 Patent Law.

The DPMA examines on request whether the application complies with the requirements of Section 34 (patent application, patent claims, description, drawings, disclosure, unity of the invention), Section 37 (naming the inventor) and Section 38 Patent Law (amending the application, inadmissible extension) and whether the subject-matter of the application is patentable under Sections 1 to 5 Patent Law. The request may be filed by the applicant or by any other person, prior to the expiration of seven years after the filing of the application. The examination procedure is continued even if the request for examination is withdrawn. If the legal requirements are fulfilled the patent will be granted.

Within three months of the publication of grant, any person may give notice of opposition to the patent. As a rule, the decision on opposition is dealt with at first instance by the DPMA and at second instance by the Federal Patent Court. The responsibility of deciding on oppositions filed after 1 January 2002 has temporarily been transferred to the Federal Patent Court in order to relieve the workload of the DPMA.

At a later date, the patent may be challenged by an action for a declaration of nullity. Cases concerning nullity actions are dealt with at first instance by the Federal Patent Court and at second instance by the Federal Court of Justice.

### Ghana

Yes, examination is sometimes carried out at the request of third parties, when they have disputes on the legality of the approved patent, or the invention being used by others. Substantive examination makes the valuation real and understandable.

The search is separately done to confirm the validity. The Ghanaian parliament has passed certain laws for third parties to challenge the validity through the required authority.

### Iceland

The examination is conducted if the search described in Q1 gives any results. A granted patent may be opposed for 9 months after mentioning of the grant in the gazette. It is also possible for a third party to hand in notes or comments on the subject of a patent application but it is only regarded as information and will not be processed as an opposition case.

### Ireland

No substantive examination carried out.

Challenge to validity of a patent application: The right to a patent belongs to the inventor or his successor in title. It is assumed that the applicant is entitled to exercise the right to a patent. The applicant's right to obtain may be challenged by any other person entitled to the grant of the patent.

Challenge to validity of a granted patent: Any person may apply to the court or the Controller of the Patent Office for revocation of the patent on certain grounds specified in the



Patents Act. The validity of a patent may also be challenged by way of defense in proceedings in the Court for infringement of the patent.

### Italy

A substantive examination is conducted during the patent procedure only on the basis of the state of the art described by the same applicant.

Third parties can challenge the validity of a patent application but the Office is not obliged to justify its decisions to the challenger. Both the validity of a patent application and a granted patent may be challenged by appealing to the Court.

### Japan

A substantive examination will be carried out only for those applications for which the applicant or a third party has filed a request for examination (see A-1). Third parties are allowed to challenge the validity of a granted patent by filing an invalidation appeal.

### Kenya

In Kenya patent applications are examined as to substance. This is a routine step and is done after the search and under the direction of Managing director by notice in industrial property journal specifying field or technical fields that shall be subject of examination as to substance<sup>9</sup>. Where the application does not fall within any of the fields specified in the Managing Director's notice the applicant is notified to request for substantive examination before the expiry of three years from the filing date or if priority is claimed three years from the first validly claimed priority<sup>10</sup>. There are no procedures for third parties to challenge the validity of an application. However third parties can institute proceedings against the owner of a patent and request the Tribunal to revoke or invalidate the patent. Further it is provided that within a period of nine months from the date of the publication of the grant of a patent, any interested party may request the industrial property to revoke or invalidate the patent.<sup>11</sup>

### Republic of Korea

A substantive examination is conducted only when the applicant or a third party has requested an examination. Anyone can request an examination within 5 years of the application date. We conduct examinations and prior art searches at the same time.

When an application has been laid open to the public, anyone can give information about it. In addition, after a patent has been granted, an opposition or invalidation trial is possible.

### Lithuania

The Office does not exercise any substantive examination of a patent application.

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<sup>9</sup> Section 44(1)(a) of the IPA

<sup>10</sup> Section 44(2) of the IPA

<sup>11</sup> Section 103(1) & (2) of the IPA

Malaysia

Yes. Examination is conducted at the same time as prior art searching at the request of patent applicants.

Mauritius

Yes. Examination is conducted as a routine step procedure, at the same time as searching. Any interested person may request the Industrial Property Tribunal to invalidate a patent.

Mexico

Yes. The substantive examination is carried out once the patent application is published, since it is one of the stages of the patent processing procedure, in which it is analyzed whether the invention satisfies the requirements of novelty, inventive step and industrial applicability) or which is not found in one of the exception clauses contained in the Industrial Property Law (Articles 16, 19 and 53).

The substantive examination procedure may be carried out according to the following methods:

1. Examination of applications with a patent granted abroad. — Articles 54 and 55 of the Intellectual Property Law (LPI) and Articles 43, 44 and 45 of its Regulations grant IMPI the power to use a patent granted abroad for the same subject matter as claimed in a Mexican application, provided this was granted by a recognized office in accordance with the Patent Cooperation Treaty and to recognize, where appropriate, the substantive examination conducted thereby. If the examiner determines that the claims granted abroad satisfy the patentability requirements established by the national legislation (LPI), he shall grant for the Mexican application the subject matter granted in the foreign patent.
2. Examination of applications with no patent granted abroad. — Where a patent application has a prior art search report for the same subject matter claimed in Mexico, produced by a foreign office, as recognized by the Patent Cooperation Treaty, the examiner retrieves the search report in question and requests the applicant to submit to him the documents cited in the report in order to carry out the corresponding substantive examination.
3. For patent applications without a search report abroad, or for national applications, the examiner carries out the search examination and determines the prior art documents which are relevant to the examination of the invention.

The search examination is carried out by the Office (IMPI) during the substantive examination procedure by the same examiner as is responsible for the substantive examination.

Our system does not envisage opposition, for which reason the resources available for challenging the validity of a granted patent are the remedy of review by the authority itself (in accordance with the Federal Law on Administrative Procedure), the action of nullity in the Federal Court of Fiscal and Administrative Justice or, where appropriate, the remedy of protection afforded by the Collegiate Circuit Administrative Court.

### Republic of Moldova

At the request of the applicant or a third party AGEPI conducts the substantive examination (see also Q1). The search is conducted in the framework of substantive examination, being carried out by the same examiner.

Any interested person can give a notice to the AGEPI of opposition to any decision to grant a patent within 6 months from the publication of the mention of the grant of the patent (Art. 19(1) of the Law). Any person can also challenge the validity of a granted patent at any time throughout its term of validity on the grounds under Art. 28 of the Law. The oppositions are heard by the Appeals Board of the AGEPI; any person who disagrees with the decision taken by the Appeals Board may appeal to a court or arbitration tribunal (Art. 36 of the Law).

### Monaco

Article 11 of Law No. 606 on Patents, dated June 20, 1955 and amended by the Law of November 5, 1956, provides that “patents that have been applied for in accordance with legal procedure shall be granted without prior examination, at the applicant’s risk and with no guarantee either of the reality, novelty or merit of the invention, or of the faithfulness or accuracy of the description”. Consequently, under these provisions no substantive examination is conducted for patent applications. Patents are granted with no Government guarantee.

No kind of opposition proceedings challenging patent applications exists in the law of Monaco, since such applications are not published in the Official Gazette. By contrast, since the patents granted are published any interested person may bring a case for nullity or disentanglement in the Monaco Court of First Instance.

### Norway

Yes. The substantive examination follows immediately after finishing of the search and is a routine step during patent procedure.

Examination is conducted at the same time as searching.

It is possible for third parties to file informal observations/oppositions during the patent procedure. The validity of a patent can be challenged by filing an opposition during the first nine (9) months after grant and correspondingly, for oppositions regarding ethical issues/ordre public up to three (3) years. After the opposition periods the opponent must take the matter to court.

### Panama

Yes. The substantive examination is conducted in two stages, one to assess whether the examination subject matter is patentable or not and the other at the time the prior art report is drawn up (novelty, inventive step and industrial applicability). Third parties have only the possibility to make observations on the prior art during the two months following publication thereof in the Official Industrial Property Gazette. For patents granted, the remedy of nullity exists in the competent courts.

### The Philippines

Within six (6) months from the date of the publication of the application, the applicant must request a substantive examination. The substantive examination would determine whether the application meets the requirements of novelty, inventive step and industrial applicability. Any interested person may upon payment of the required fee, petition to cancel the patent or any claim thereof, or parts of the claim.

### Poland

Substantive examination is a routine stage of patent procedure conducted directly after prior art searching or after a certain lapse of time.

Within 6 months from the date of publication of the patent application, third parties can make their comments. It is advantageous when these comments include documentation marked with the date, which is prejudicial to novelty or non-obviousness (inventive step).

Within 6 months from the date, on which patent was granted, everyone may file a motivated notice of opposition against the patent granted.

A patent may be declared invalid in whole or in part at the request of any person having a legitimate interest therein, who is able to prove that the statutory requirements for the grant of a patent have not been satisfied.

### Portugal

Yes, substantive examination is part of the granting of a patent. Substantive examination is conducted by patent examiners at the same time as the search procedure, even when there has been a Preliminary Search for a patent application.

### Romania

The office usually performs the substantive examination of the patent application upon request by the applicant. For the published patent applications, the substantive examination may be requested by any person. The search is a step of the substantive examination.

The legal procedure for the third parties to appeal against the validity of a patent application is the revocation to be solved by a Board of Appeal within the Appeals Department of the State Office for Inventions and Trademarks, while for a granted patent, the legal procedure is the patent cancellation which is carried on before the Law Court.

### The Russian Federation

An application is substantively examined at the request of an applicant or third parties, and said request may be submitted to the federal executive authority for intellectual property within three years of the filing date of an application for an invention, provided that an examination of form has been completed. The substantive examination of an application for an invention must necessarily include an information search, where this has not been conducted earlier at the request of an applicant or third party.

Where patent applications are submitted by different applicants for identical inventions with one and the same priority date and those applicants have not submitted an agreement on the choice of a single applicant within the prescribed deadline, all the applications shall be recognized as having been withdrawn.

A patent may be recognized as invalid either in full or in part (Article 29 of the Law) during the whole of its term of validity, on the basis of a decision taken on an appeal to the patent disputes chamber, or a court decision, in cases of:

- non-compliance with patentability requirements;
- the presence in the claims of features not corresponding to the type of patented industrial property subject matter;
- the presence in the claims of features not contained in the original application documents;
- the grant of a patent in the case of identical applications bearing one and the same priority date; and
- the grant of a patent with an incorrect indication of or the failure to indicate the author or patent owner.

A patent recognized as invalid either in full or in part shall be revoked. Where a patent is recognized as partially invalid, a new patent shall be granted.

### Senegal

In Senegal a patent application is filed with the competent ministry. This ministry verifies the conformity of the documents and simply forwards them. It is not authorized to carry out a substantive examination.

### Singapore

In Singapore, as in search (see Ans1), a substantive examination is conducted during the prosecution of a patent application. Several options, to which this examination can be achieved, are available to patent applicants to choose from. In brief, patent applicants can rely on the examination results of their corresponding applications or corresponding international applications, or they can request IPOS to conduct the examination. When a request to IPOS for an examination is sought, IPOS would forward the request to one of her Examiners (IP Australia, Austrian Patent Office, Danish Patent & Trade Mark Office). Patent applicants can choose to file a separate search request followed by an examination request or a combined search & examination process. For PCT (SG) national phase entry applications, the option to rely on the International Preliminary Reports on Patentability (Chapters I or II) is also available.

The examination process in Singapore is triggered by the patent applicant himself and depending on the search and examination option chosen, the corresponding requirements (e.g. furnishing of fees, prescribed documents, meeting prescribed time periods) apply.

[Reference is made to section 29 of the SG Patents Act & its corresponding rules.]

After a patent is granted, any person may request for a search and examination to be conducted in respect of any claim or claims in the specification of a patent. The grounds for making such requests however must be satisfied, and the Registrar of Patents, IPOS, shall not grant the request if he is of the view that it is frivolous, vexatious or an abuse of the process.

[Reference is made to section 38A of the SG Patents Act & its corresponding rules.]

Provisions are available for challenging of patents. The grounds and procedures to revoke patents or to challenge the validity of patents are stipulated in Sections 80-82 of Patents Act.

[Reference is made to sections 80-82 of the SG Patents Act & its corresponding rules.]

### Spain

The substantive examination is conducted optionally, only if the applicant so requests and after a report on the prior art has been drawn up.

If the substantive examination is conducted there is an opposition phase. The possibility also exists of appealing the grant of a patent.

### Sweden

Q1 and Q2: In Sweden, a prior art search and a substantive examination are performed as routine steps during patent procedure.<sup>12</sup> The search and examination are conducted at the same time, normally six months after filing of the patent application.

A third party has the possibility during the patent procedure to make an objection and put forward documents relevant to the patent procedure.<sup>13</sup> The third party may file an opposition to the patent office against the validity of the patent, within nine months from the granting of the patent, if the patent<sup>14</sup>:

1. does not fulfil fundamental criteria for patentability i.e. novelty, inventive step or industrial applicability, or is directed to non-patentable subject matter<sup>15</sup>
2. does not describe the invention sufficiently for a person skilled in the art to perform the invention
3. if it contains matter that was not in the application as originally filed.

Moreover, after this nine month period of opposition it is possible in a court to revoke or limit the patent on grounds 1-3 above or if the patent protected scope has been extended after the grant.<sup>16</sup>

### Thailand

Yes, we will exam patent application after the request of patent applicants and at the same time as searching.

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<sup>12</sup> Swedish Patents Decree (PK) Section 26

<sup>13</sup> Swedish Patents Decree Section 36

<sup>14</sup> Swedish Patents Act (PL) Section 25.

<sup>15</sup> Non-patentable matters such as:

- methods of treatment of the human or animal by therapy or surgery or diagnostic methods performed on humans or animals
- plant variety or animal race
- an essentially biological process to produce a plant or an animal
- the human body at various stages of its formation and development and the simple discovery of one of its elements
- inventions where commercial use is contrary to *ordre public*

<sup>16</sup> Swedish Patents Act Section 52

Opposition procedures exist for third parties to challenge the validity of a patent application.

### Tonga

As part of routine step, all patent applications are sent to an international examination body, (IP Australia) for both “Prior Art Search” and “Substantive Examination”. Third parties can challenge the patent application and/or granted patent when they are advertised in the Gazette.

### Trinidad and Tobago

Patent applications are subject to substantive examination as a routine step in the prosecution of the application. The administrative trigger is the payment of the search and examination fee by the applicant or their representatives. The examination is conducted right after the search in the light of the available prior art cited. The results remain secret to third parties until publication of the notice of grant in periodicals. Third parties can approach the courts for redress to challenge the validity of the granted patent. Challenges to applications can be addressed to the office and the courts.

### Turkey

Within six months following the publication of the State of the Art search report, with a view to obtaining a patent with substantive examination the applicant shall request the Institute to conduct the examination; in that the subject of the invention is comprehensively described, the invention is novel and involves inventive activity/step. For conducting such an examination, the time period of six months allowing third parties to raise objections shall expire and examination fee foreseen in the Regulation shall be paid. The examination report established by the examination Authority to be designated by the Institute from amongst the internationally recognized examination authorities such as the Russian Patent Office, Danish Patent Office and Sweden Patent Office.

Submitting to substantive examination the patent granted without (substantive) examination necessitates the filing of a request to this effect. This request shall be filed, by the patentee or by third parties, within seven years, at the latest, from the date of filing of the application. The (substantive) examination fee shall be paid by the party having filed the request for substantive examination.

### Ukraine

The substantive examination is carried out together with the search once an application has been filed for a substantive examination and the appropriate fee has been paid.

The application in question may be filed by:

- the applicant for the purposes of obtaining a patent for an invention.
- the owner of a patent for a utility model in order to convert that patent into a patent for an invention.
- third parties for the purposes of obtaining an expert opinion on the patentability of the claimed invention.

For the purposes indicated, at the request of third parties the following may be conducted:

- in relation to an application filed for an invention – a substantive examination, based on the results of which a decision to refuse to grant a patent may be taken.
- in relation to a patent granted for a utility model – an examination of the utility model in terms of its compliance with the patentability criteria, based on the results of which a patent for the utility model or part thereof may be recognized as invalid by a court.

### Venezuela

Examination is a routine step during the patent grant procedure.

Examination is conducted at the same time as searching.

Post-grant defense mechanisms exist for third parties to challenge the validity of a patent application with effects which may be retroactive, starting from the time when an application is published.

### Viet Nam

According to Viet Nam's jurisdiction, invention/utility solution applications are subject to substantive examination at the request of applicants or third parties.

- Substantive examination is only carried out when result of prior art searching is available.
- The applicant or third party who requests for substantive examination must pay the due fees.
- In order to know the legal status of an application or patent, a third party may file a search request with the NOIP (it only applies to applications which are already published).



## PART II: LEGAL CHARACTERISTICS OF PRIOR ART

*The questions in Part II concern the legal standards that define what material is eligible for consideration as prior art, and can therefore be considered when assessing the novelty and non-obviousness (inventive step) of a claimed invention. The sources of these standards may include legislation, regulations, judicial and administrative decisions, and office guidelines.*

**Q3. GENERAL SCOPE OF PRIOR ART RELEVANT TO NOVELTY**

What is defined in your jurisdiction as prior art that is relevant to the determination of an invention's novelty? Does it include:

- (i) information that is published in written form locally or in foreign countries?
- (ii) information that is orally disclosed locally or in foreign countries?
- (iii) other information, such as public working of invention, secret use of the invention? If so, please specify.

Argentina

Q 1, 2 and 3: Article 27 (LP) – Subject to payment of the fee established in the Decree-Regulation, the National Patent Authority will conduct a substantive examination, in order to verify compliance with the requirements stipulated in Title II, Chapter I of this Law.

The National Patent Authority may request a copy of the substantive examination conducted by foreign examining offices under the terms of the Decree-Regulation and may also request reports from researchers working in universities or national science and technology institutes, who will be remunerated in each case, in accordance with the Decree-Regulation.

If the patent applicant considers it necessary, he may request that the Authority conduct the examination on his premises.

Once three (3) years have elapsed after the filing of a patent application without the applicant paying the appropriate fee for the substantive examination, the application shall be considered to have been withdrawn.

Article 27 (RLP) – The substantive examination of an application will not be carried out, if the preliminary examination has not been previously completed and approved. II – Once the filing procedures have been completed, the applicant may request the substantive examination. The Patent Officer will, within fifteen (15) days, assign the application to an examiner.

The substantive examination will be carried out within one hundred and eighty (180) days of the payment of the fee and will include the following phases:

- (a) Prior art search. The examiner will endeavor to identify, insofar as he considers reasonable and feasible, the documents he considers necessary to determine whether the invention is novel and involves an inventive step. His search must cover all the technical sectors which may contain elements relevant to the invention, and the following documentation must be consulted:

(i) national patent documents (patents and utility models granted and patent and utility model applications in progress).

(ii) published patent applications and patents from other countries.

(iii) technical literature other than that indicated in the above subparagraphs which may be relevant to the search.

(b) Examination. The examiner will investigate, insofar as he considers necessary and taking into account the results of the preliminary examination and the prior art search, whether the application fully satisfies the requirements of the Law and the associated Regulations.

III. – If he considers it necessary, the examiner may request:

(a) the applicant to submit, within ninety (90) days of receiving the request notification, a copy of the substantive examination conducted for the same invention by foreign patent offices where available, pursuant to Article 28 of the Law;

(b) specific reports relating to the subject matter of the invention from researchers working in universities or science or technology research institutes.

Article 28 (RLP) – The examiner will include among his observations those which were submitted by third parties, based on the data emerging from the publication issued in accordance with Article 28 of the Law, and which are based on the lack of novelty, industrial applicability or inventive step, or unlawful nature of the subject matter of the application, unless they are clearly incorrect and are declared as such.

Within sixty (60) days of the notification, the applicant must:

(a) amend the application so that it satisfies the legal and regulatory requirements; or

(b) express his opinion on the observations, refute them or make such clarifications as he considers relevant and expedient;

(c) if the applicant does not satisfy the requirements within the period indicated, his application will be considered to have been withdrawn.

### Armenia

In our jurisdiction a prior art that is relevant to the determination of an invention's novelty includes:

(a) information available to the public because it is published in written form locally and in foreign countries;

(b) information available to the public because it is orally disclosed locally and in foreign countries;

(c) other information, such as public working of invention.

### Australia

Prior art is information that is available in a document that has been published anywhere in the world or that is made available publicly by doing an act anywhere in the world before the priority date of the patent application. Where two or more documents or acts may be treated as a single source of information by a person skilled in the relevant art in Australia,

then those documents may be treated as a single disclosure in the determination of an invention's novelty.

The prior art for determination of novelty also includes Australian patent applications that have an earlier priority date than the priority date of the patent application being examined but a publication date after the priority date of the patent application that is being examined. Note that these applications can only be used if there is an Australian application. If there is no Australian application these earlier documents do not form part of the prior art base.

Prior art includes:

(a) Information that is published in written form locally or in foreign countries.

(b) Information that is orally disclosed locally or in foreign countries. Oral disclosure is considered to be "doing an act" for the purpose of defining the prior art base. Provided the oral disclosure is public, i.e. not made under conditions of confidentiality, then it forms part of the prior art base no matter where in the world the oral disclosure was made. Oral disclosures can only be considered during opposition or revocation proceedings. Oral disclosures are not considered during examination of patent applications.

(c) Public working of an invention forms part of the prior art base.

Secret use of an invention by a third party does not form part of the prior art, however, a patent may be invalidated if the invention was secretly used by the patentee or a predecessor in title before the priority date. Under the Australian Patents Act secret use of an invention does not include use of the invention:

- for the purpose of reasonable trial or experimentation,
- during the course of a confidential disclosure,
- for any purpose that is not trade or commerce, or
- by the Commonwealth, a State or Territory (see section 9 of the Patents Act).

### Austria

The relevant prior art includes:

(a) information published in written form (in any country);

- (i) books
- (ii) dictionaries
- (iii) patents
- (iv) protocols
- (v) conference
- (vi) reports
- (vii) magazines
- (viii) etc.

(b) information published on CDs, DVDs, films or cassettes;

(c) information disclosed orally in any country;

(d) public use;

(e) models in a museum (for example, an abacus from Egypt or China);

(f) presentation at a conference which is open to the public (even fee-paying);

- (g) presentation at an exhibition;
- (h) presentation on radio or television.

*The Austrian Patent Law:*

§ 3. An invention shall be considered to be novel, if it is not included in the prior art. The prior art shall comprise everything which has been made available to the public before the priority date of the application through a written or oral description, use or any other means. The prior art also includes Austrian patent and utility model applications as well as European or PCT applications whose priority date is before the priority date of the application being processed and which (European or PCT applications) are published after the priority date of the most recent application.

Azerbaijan

It includes:

- (a) information that is published in written form locally or in foreign countries;
- (b) information that is orally disclosed locally or in foreign countries, but particularly at a local scale.

Bangladesh

According to the existing Patents and Designs Act and Rules, prior art means:

- (a) publicly used or publicly known in Bangladesh prior to the date of the patent;
- (b) a prior publication to which public has access;
- (c) a patent would also be invalidated if the invention is shown to have been the subject of a valid prior grant.

It includes:

- (a) information that is published in written form locally or in foreign countries;
- (b) information that is orally disclosed locally or in foreign countries;
- (c) other information, such as public working of invention, secret use of the invention e.g. if an invention has been put into practice in Bangladesh publicly, it would constitute a public use of the invention and would prejudice the novelty of the invention. The working of an invention by a person secretly would not invalidate a patent of subsequent date granted in respect of the same invention, unless such secret working was on a commercial scale.

Bolivia

In Bolivia, the first two options are used:

- (a) the information that is published in written form locally or in foreign countries;
- (b) the information that is orally disclosed locally or in foreign countries.

Article 16 of Decision 486 states: An invention shall be deemed novel when not included in the state of the art. The state of the art shall comprise everything that has been made available to the public by written or oral description, use, marketing, or any other means prior to the filing date of the patent or, where appropriate, of the priority claimed. Solely for the purpose of determining novelty, the contents of a patent application pending

before the competent national office and having a filing date or priority application date earlier than the date of the patent or patent priority application under examination, shall likewise be considered part of the state of the art, provided that said contents are included in the earlier application when published or that the period stipulated in Article 40 has concluded.

### Bulgaria

The Bulgarian Patent Law in force as of 01.06.1993, amended by Law No. 66/09.07.2002, in force as of 09.07.2002, is harmonized with the European Patent Convention.

Concerning the definition: the state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, anywhere in the world, before the filing date or the priority date, as appropriate, of the application.

The state of the art shall comprise also the content of all national, European and international patent applications designating the Republic of Bulgaria, of which the filing date or priority date, as appropriate, which are published in the Official Bulletin of the Patent Office after that date. Other document concerning this matter is the Regulation of Forming, Filling and Examination of Patent Applications (RFFE). In Article 32 of RFFE the cases of relevant prior art are described. Article 37 (3) shows that the document is relevant if at the date of filling or priority date it was available to the public and there was not any additional negative requirements, which was a limitation for its use. Written document is publicly available from the publication date. Article 37(4) shows that oral disclosure, use and disclosure by other means may be included in the prior art only if the disclosure was summarized in a way which enables repeated use of the invention. Article 37(6) and (7) of RFFE show that the applicant or third parties could despite the legality of the document.

### Burundi

Article 5 of the draft law to which we refer stipulates that “an invention shall be novel if the prior art does not contain any antecedents. This shall include everything which has been disclosed, in any place in the world, by a publication in tangible form, oral disclosure, use or any other means, prior to the filing date or, where appropriate, the priority date of the application in which the invention is claimed”.

### Chad

In Chad, the relevant prior art is defined by:

- information published in written form in Chad or abroad,
- information disclosed orally in Chad or abroad.

### China

In our jurisdiction, “prior art that is relevant to the determination of an invention’s novelty” is understood as “any technology which has been disclosed in publications in the country or abroad, or has been publicly used or made known to the public by any other means in the country, before the date of filling (or the priority date where priority is claimed), including any application which described the identical invention filed by any other person

with SIPO before the date of filing (or the priority date where priority is claimed) and which was published after the said date of filing (or the priority date where priority is claimed)". It includes information that is published in written form locally and in foreign countries, information that is orally disclosed locally and disclosed through use.

### Colombia

Article 16 of the rules in force states that prior art includes everything that has been made accessible to the public by a written or oral description, use, marketing or by any other means prior to the patent application filing date or, where appropriate, the recognized priority date.

The Article also states that only for the purposes of determining novelty shall the content of a patent application being processed by the competent national authority, the filing or priority date of which is prior to the filing or priority date of the patent application being examined, be considered part of the prior art, provided that said content is included in the application with the earlier date, where it is published or the period of eighteen months from the filing date or, where appropriate, the validly claimed priority date has elapsed.

Prior art includes:

- (a) information that is published in written form locally or in foreign countries;
- (b) information that is orally disclosed locally or in foreign countries.

As already noted, the industrial application of an invention is considered to be part of the prior art by our domestic legislation, provided that where an invention is being used or exploited this is because it has already been patented or is in the public domain.

However, the secret use of the invention is not considered to be part of the prior art, since this implies that the invention has not been made accessible to the public.

### Congo

Under one of the provisions of the Bangui Agreement, the prior art is everything that has been made available to the public in any place, by any means or in any manner prior to the patent application being filed with the OAPI or abroad (Annex II, Article 3).

However, this novelty is not adversely affected if the filing is made within a period of 12 months from the date of disclosure.

As far as we are concerned, the relevant prior art contains all the items in points (i), (ii) and (iii) of Q3.

As regards point (iii), Article 3 Annex II of our Agreement, as referred to above, is perfectly clear, since it does not limit the form or scope of the disclosure.

### Croatia

The state of the art shall comprise everything made available to the public on the world level by means of written or oral description, by use, or in any other way, prior to the filing date of the patent application

For the purpose of determining novelty, the state of the art shall also include the content of all patent applications as filed with the effect for the Republic of Croatia, the filing dates of

which are earlier than the date of application and which were made available to the public only on, or after the date of filing the patent application.

In the case when, not more than six months prior to the filing date of the patent application it has formed part of the state of the art due to, or in consequence of:

- an evident abuse in relation to the patent applicant or his legal predecessor, or
- the display at an official or officially recognized international exhibition, provided that the applicant indicates in the patent application, at the time of its filing, that the invention has been so displayed,

The subject matter of that application will be considered as a new invention. It will not be considered as a prior art.

### Czech Republic

The general scope of prior art relevant to the novelty follows Section 5 of the Act.

The prior art is information published or disclosed to the general public in written form, orally, by way of use or in another way prior to the priority date.

In this case the prior art also comprises the contents of patent applications with effect for the Czech Republic, with the former priority right, provided they are disclosed (later).

Therefore all information sources specified in Points (i) to (ii), that is all printed publications, oral information (workshops, conferences, etc), public presentation of the invention, etc., are used to find the prior art.

### Denmark

Prior art is defined as everything that has become commonly known anywhere in the world through written material, oral presentation, actual use or by other means in such a manner that a person skilled in the art is able to perform the invention. Example (i)-(ii) is therefore included while example (iii) is included when the public use of the invention enables a person skilled in the art to perform the invention. It naturally follows that secret use rarely constitutes prior art.

### Egypt

Information that is published in written form locally or in foreign countries is defined in our Jurisdiction as prior art that is relevant to the determination of an invention's novelty.

### Eurasian Patent Office

Prior art includes any information published in writing in any country.

Prior art includes information disclosed orally, provided that it is confirmed in writing.

Prior art includes information on the open (non-secret) public use of an invention.

### European Patent Office

It is the concept of absolute novelty that has been adopted for European patent law. An invention shall be considered to be new if it does not form part of the state of the art. The state of the art shall be held to comprise everything made available to the public by means of

a written or oral description, by use, or in any other way, before the date of filing of the European patent application (see Art.54 (1) and (2) EPC).

The width of this definition should be noted. There are no restrictions whatsoever as to the geographical location or the language or manner in which the relevant information was made available to the public; also no age limit is stipulated for the documents or other sources of the information. The term “available” clearly goes beyond literal or diagrammatical description and implies any means of disclosure to the public.

Under European patent law, information is not deemed to have been made available to the public if its disclosure is subject to an obligation to maintain secrecy, provided the obligation has not been breached.

The state of the art is made available to the public by oral description when facts are unconditionally brought to the knowledge of members of the public in the course of a conversation or a lecture or by means of radio, television or sound reproduction equipment (tapes and records) or any other means. Use may be constituted by producing, offering, marketing or otherwise exploiting as product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange. The state of the art may also be made available to the public in any other way, as for example by demonstrating an object or process in specialist training courses or on television. Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer for making available the state of the art concerned.

### Fiji

Fiji’s Act is outdated and was last reviewed in 1978; therefore it is inadequate, as it does not contain any definition of prior art relevant to the determination of an invention’s novelty.

Given that IP Australia conducts a search on our behalf we are unaware on what procedures they adhere to, but it could include information published locally in a written form or in foreign countries as well as information orally disclosed locally or in foreign countries. Even though most applicants are foreign based, should it concern local prior art then specifications would have to include reference to the local prior art.

### Finland

Prior art includes:

- (a) information that is published in written form locally or in foreign countries;
- (b) information that is orally disclosed locally or in foreign countries;
- (c) other information, such as public working of invention but not secret use of the invention

### France

As regards the assessment of novelty by the French courts, reference should be made to Article L. 611-11 (para. 2), CPI, which provides that:



*“Prior art shall consist of everything which has been made accessible to the public before the patent application filing date by a written or oral description, use or any other means”.*

The relevant prior art may include information published in written form (for example magazines, journals, patents and so on) in France or abroad and also information disclosed orally (at conferences or seminars) in France or abroad. The prior art may also include public use of an invention (this may consist for example of the use or presentation of the invention). By contrast, secret use of an invention cannot constitute relevant prior art insofar as there is no public accessibility.

### Georgia

Prior art includes:

- (a) information that is published in written form locally and in foreign countries;
- (b) information that is orally disclosed locally and in foreign countries;
- (c) other information, such as public working of invention.

### Germany

Section 3 of the Patent Law defines the prior art which has to be considered in novelty examination:

Section 3 of the Patent Law – Novelty, prior applications, non-prejudicial disclosures:

(a) an invention shall be considered to be new if it does not form part of the state of the art. The state of the art comprises all knowledge made available to the public by means of a written or oral description, by use or in any other way, before the date relevant for the priority of the application.

(b) additionally, the content of the following patent applications, which have an earlier priority and which were published only on or after the date relevant for the priority of the later application, shall be considered to be comprised in the state of the art:

1. national applications, as originally filed with the German Patent Office;
2. European applications, as originally filed with the competent authority, in which protection is sought in the Federal Republic of Germany and for which the designation fee for the Federal Republic of Germany has been paid in accordance with Article 79(2) of the European Patent Convention, unless the application for a European patent is based on an international application and does not fulfil the conditions set out in Article 158(2) of the European Patent Convention;
3. international applications under the Patent Cooperation Treaty, as originally filed with the receiving Office, where the German Patent Office is the designated Office with respect to the application.

If the earlier priority of an application is based on a claim to the priority of an earlier application, the first sentence of the present subsection shall be applicable only to the extent that the contents of the application in question do not go beyond the contents of the earlier application. Patent applications under item 1 of the first sentence of the present subsection which have been subject to a decision under Section 50(1) or (4) of the Patent Law shall be

considered to have been made available to the public on expiry of the eighteenth month following their filing:

(i) any information published by means of a written description before the date relevant for the priority of the application has to be considered as prior art relevant to novelty. All countries and all languages must be taken into consideration;

(ii) any information made available to the public by means of an oral description before the date relevant for the priority of the application also constitutes prior art relevant to novelty. All countries and all languages must be taken into consideration;

(iii) any information made available to the public by use or in any other way is regarded as prior art relevant to novelty. All countries and all languages must be taken into consideration.

### Ghana

In our jurisdiction, prior art that is relevant for the determination of an invention novelty has to do with the search and their documentation to the requisite materials.

Information must include published written documents from locally and foreign countries for different ideas or comparability.

### Iceland

Iceland uses a similar approach as the other Nordic countries. In Article 2 in the Icelandic patent law it says: "Everything made available to the public in writing, in lectures, by public use or otherwise shall be considered as known." This means material worldwide. Secret use is not considered as prior art.

### Ireland

The published prior art in relation to an application includes all information that has been "made available to the public" anywhere in the world at the filing date of the application. Information may become part of the published prior art by any means (by written or oral description, by use or any other way). Information that has been made available to one or more third parties, in confidence, is secret and has not been made available "to the public".

### Italy

In our jurisdiction, prior art that is relevant to the determination of an invention's novelty is defined as follows:

1. The state of the art shall include everything made available to the public in Italy and abroad by means of a written or oral description, by use, or in any other way before the date of filing of the national application.
2. Additionally the content of national patent applications or European and international patent applications designating Italy as filed, of which the dates of filing are prior to the date referred to in paragraph 1 and which were published or made available to the public on or after that date."

### Japan

Under the Japanese Patent Law article 29.1, the following three types of inventions are to be regarded as falling under the scope of prior arts:

- Inventions which were publicly known in Japan or elsewhere prior to the filing of the patent application.
- Inventions which were publicly worked in Japan or elsewhere prior to the filing of the patent application.
- Inventions which were described in a distributed publication or made available to the public through electric telecommunication lines in Japan or elsewhere prior to the filing of the patent application.

Therefore, conditions of (i), (ii), and (iii) public working of invention, mentioned in your Q3 are met by the definitions.

### Kenya

Everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) or, by oral disclosure, use, exhibition or other non written means shall be considered as prior art provided that such disclosure occurred before the date of filing of the application or, if priority is claimed, before the validly claimed priority date<sup>17</sup>.

### Republic of Korea

In Article 29 of the Patent Act, prior art searches are defined as follows:

- Inventions publicly known or worked in the Republic of Korea before the filing of the patent application.
- Inventions described in a publication distributed in the Republic of Korea or in a foreign country before the filing of the patent application or inventions published through electric telecommunication lines as prescribed by Presidential Decree.
- Information that is published in written form in the Republic of Korea or in foreign countries is considered prior art
- Information that is orally disclosed locally or in foreign countries is not considered prior art.
- Within the confines of the Republic of Korea, the public use of an invention is considered prior art but confidential use is not.

### Lithuania

Prior art includes:

- (i) information that is published in written form locally or in foreign countries;
- (ii) information that is orally disclosed locally or in foreign countries;

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<sup>17</sup> Section 23(2) IPA 2001

(iii) under the Patent Law “the state of the art shall consist of everything which, before the filing date of patent application or where priority is claimed, before the priority date, has been published or was in public use in the Republic of Lithuania or abroad.”

#### Malaysia

Yes, prior art is relevant to determine an invention’s novelty. See Answer 4.

#### Mauritius

Prior art consists of anything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing or, where applicable, the priority date, of the application claiming the invention.

#### Mexico

In accordance with Article 12 of the Industrial Property Law, the prior art shall be considered to include all the technical knowledge which has been made public through an oral or written description, use or by any other means of dissemination or information in the country or abroad.

Similarly, Article 17 of the Law itself provides that in order to determine that an invention is novel and involves an inventive step, the prior art shall be considered on the patent application filing date or, where appropriate, the recognized priority date. Furthermore, in order to determine whether the invention is novel the prior art shall include all the patent applications filed in Mexico prior to that date, which are being processed, although publication in the Industrial Property Gazette is made subsequently.

In conjunction with the previous article, Article 22(1) of the Regulations under the Industrial Property Law states the following: “For the purposes of Article 17 of the Law, the prior art shall also include the patent and utility model registration applications being processed by the Institute, the date and time of which are prior to those subject to substantive examination”.

(i) Prior art includes information that is published in written form locally or in foreign countries. Article 12(II) of the Industrial Property Law defines prior art as all the technical knowledge which has been made public through a written description or by any other means of dissemination or information in the country or abroad.

However, Article 18 of the Industrial Property Law establishes that the disclosure of an invention shall not affect the fact that it continues to be considered novel where, within the 12 months preceding the patent application filing date or, where appropriate, the recognized priority date, the inventor or his lawful successor has made the invention known, by any means of communication, by putting the invention into practice, or because it has been displayed at a national or international exhibition.

In turn, the said article provides that the publication of an invention contained in a patent application or in a patent granted by a foreign office shall not be considered covered by this assumption.

(ii) Prior art includes information that is orally disclosed locally or in foreign countries. As mentioned in the previous remarks, Article 12 of the relevant Law envisages, in turn, that the prior art includes the disclosure orally or by any other means of dissemination or communication locally or in foreign countries.

However, as indicated in the previous subparagraph Article 18 of the Industrial Property Law establishes that the disclosure of an invention by the inventor or his beneficiary by any means of communication, or at a national or international exhibition, shall not affect the requirement of novelty of the invention, where this occurs within the 12 months prior to the patent application filing date or, where appropriate, the recognized priority date.

(iii) Prior art includes as well other information, such as public working of invention, secret use of the invention. It should be emphasized that as part of the assumption referred to above (Article 12(II) of the Industrial Property Law), it is provided that the prior art contains all the technical knowledge which has been made public through the use of the patent or by any other means of dissemination or communication locally or in foreign countries, just as in relation to the assumption established in Article 18 of the same Law it is provided that the carrying out of the invention within the 12 months prior to the filing date of the patent application or, where appropriate, the recognized priority date shall not be envisaged as a circumstance giving rise to the loss of the requirement of novelty.

Similarly, the secret use of an invention would constitute an industrial secret and therefore its disclosure to third parties is dependent on the fact that the invention is not disclosed, for which reason it would remain outside the prior art.

#### Republic of Moldova

The prior art, according to Art. 5(2) of the Law, comprises everything made available to the public in any part of the world before the date of filing, if a priority has been claimed, before the priority date of the patent application. The Guidelines for the Substantive Examination in the AGEPI (hereinafter the Guidelines) define the prior art as “everything made available to the public by means of a written or oral disclosure, by use of in any way, before the filing date of the application or, where a priority was claimed, before the priority date of that application” (Chapter IV, paragraph 5.1).

Thus, the prior art should include all information mentioned to p. (i)-(iii), irrespective of the geographical location of disclosure, excepting the secret use of the invention that is considered as had not been made available to the public. The state of the art also comprises the content of patent and utility model applications filed with the office earlier than, but published on or after the date of filing of the application being examined. Such applications form part of the state of the art when considering novelty and not when considering inventive step.

#### Norway

Prior art includes everything made available to the public by means of a written or oral description, by use, or in any other way before the date of filing of the patent application. Patent applications filed in Norway before the filing date of the application under examination, but which are not published on the filing date of the application under examination, are also relevant prior art assumed that they become published later on.

Prior art includes:

(i) in principle, information that is published in written form locally or in foreign countries;

- (ii) in principle, information that is orally disclosed locally or in foreign countries;
- (iii) public working of an invention but not secret use of the invention.

### Panama

The prior art includes everything that has been disclosed or made accessible to the public, in any place in the world, by means of a tangible publication, oral disclosure, sale or marketing, use or any other means, prior to the patent application filing date in Panama or, where appropriate, the recognized priority date where this is claimed in accordance with this Law. The prior art will also include the content of a patent application being processed in Panama, whose filing date or, as appropriate, priority date, is before that of the application being examined, provided that the content is included in the earlier application where this is published.

Prior art includes:

- (i) information that is published in written form locally or in foreign countries;
- (ii) information that is orally disclosed locally or in foreign countries;
- (iii) other information, such as public working of invention but not secret use of the invention. Our Law does not specify how use is effected, it simply establishes use as a way in which information becomes part of the prior art.

### The Philippines

Prior art shall consist of:

1. Everything which has been made available to the public anywhere in the world, before the filing date or the priority date of the application claiming the invention; and
2. The whole contents of an application for a patent, utility model, or industrial design registration, published in accordance with the Intellectual Property Code of the Philippines, filed or effective in the Philippines, with a filing or priority date that is earlier than the filing or priority date of the application claiming the invention.

### Poland

Under Article 25(2) of the Polish Industrial Property Law (PIPL) “the state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, displaying or disclosure in any other way, before the date according to which priority to obtain a patent is determined”.

### Portugal

Prior art is the information available to the public, in any part of the world, disclosed by written or oral means or by use. Additionally are considered, as prior art and for the purpose of evaluation of novelty of patent applications, the national patent applications that are not already published.

### Romania

According to the national patent law, there is taken into consideration a prior art comprising all knowledge made available to the public by a written or oral description, by use

or by any other means, before the filing date of the patent application or the date of the recognized priority, provided that the date of its being rendered available to the public is identifiable.

For the purpose of determining whether the invention is new, the prior art comprises the content of all patent applications filed with the State Office for Inventions and Trademarks and the content of international or European patent applications having Romania as a designated State, whose filing date or recognized priority date is earlier than the filing date of the patent application to be examined and which have been published on or after this date.

There are considered as relevant documents and there are analyzed in the search report, with a view to considering the fulfillment of the novelty condition, those documents in the prior art whose content covers, partially or totally, the extent of protection claimed by the applicant.

The relevant prior art comprises:

- (i) information that is published in written form locally or in foreign countries;
- (ii) information that is orally disclosed locally or in foreign countries;
- (iii) any information rendered available to the public by use or by any other means.

#### The Russian Federation

When determining prior art, the information contained in an information source which any person may consult, or the content of which may be lawfully communicated to him or her, shall be considered publicly available.

When establishing the novelty of an invention, the prior art shall also include, provided they have earlier priority, all the applications filed in the Russian Federation by other persons for inventions and utility models, the documents for which any person may consult.

The prior art includes any information published in written form.

The prior art includes any information disclosed orally, provided that it is confirmed in writing.

The prior art includes information on the open (non-secret) use of an invention.

#### Senegal

This search is carried out in Yaoundé where the competent body for this kind of search is based. Here in Senegal the ministry cannot know whether novelty exists.

#### Singapore

In Singapore, section 14(1) of the Patents Act states that “An invention shall be taken to be new if it does not form part of the state of the art.” Further sub provisions under section 14 of Patents Act elaborate on what amounts to the state of the art and under what circumstances can the disclosure of matter constituting an invention, be disregarded.

[Reference is made to section 14 of the SG Patents Act & its corresponding rules.]

### Spain

Everything that is publicly available up to the application date is defined as prior art relevant to the determination of an invention's novelty.

The prior art includes:

- (i) information that is published in written form locally or in foreign countries;
- (ii) information orally disclosed is only taken into account if a written back-up copy exists (for example, if it is disclosed at a conference, if the conference records exist);
- (iii) industrial use, if it also exists in catalog form and so on.

### Sweden

Prior art comprises all information made available to a large or indefinite group of people, in writing, orally or by other means the day before the filing of the patent application (or the priority date).<sup>18</sup> Consequently, the novelty criterion is global and not limited to any languages. The secret use of an invention is not a part of the prior art since such use is limited to a definite group of people.

### Thailand

General scope of prior art relevant to novelty: Patent Act, section 6:

1. an invention which was widely known or used by others in the country before the date of application for the patent.
2. an invention the subject matter of which was described in a document or printed publication, displayed or otherwise disclosed to the public, in this or a foreign country before the date of the application for a patent.
3. an invention for which a patent was granted in this or a foreign country before the date of application.
4. an invention for which a patent was applied in a foreign country more than eighteen months before the date of the application and a patent has not been granted for such invention.
5. an invention for which a patent was applied for in this or a foreign country and the application was published before the date of application.

A disclosure which was due to, or made in consequence of, the subject matter having been obtained unlawfully, or a disclosure which was made by the inventor, or made in consequence of, the inventor displaying the invention at an international exhibition or an official exhibition if such disclosure was done within twelve months before the filing of an application for the patent, shall not be deemed to be a disclosure under 2. above.

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<sup>18</sup> Swedish Patents Act Section 2 second paragraph and Guideline of Swedish Patent and Registration Office RL VII - 3.7.1: available from [http://www.prv.se/pdf/riktlinjer\\_patent.pdf](http://www.prv.se/pdf/riktlinjer_patent.pdf)



### Tonga

“Prior Art” includes “everything disclosed to the public anywhere in the world, by publication in tangible form, or in Tonga by oral disclosure, by use or in any other way”.

### Trinidad and Tobago

Prior art, in Trinidad and Tobago, is defined as comprising all matter (whether product, process, information about either, or anything else) which has, at any time before the priority date, been made available to the public (in Trinidad and Tobago or anywhere else) by written or oral description or use of in any other way.

There is a provision where the applicant can ask the office not to take into consideration disclosures made by themselves or their predecessors in title or abuses by third parties for up to one year before the filing date.

Undisclosed information and trade secrets would not normally form part of the prior art.

### Turkey

Prior art includes:

- (i) information that is published in written form locally or in foreign countries;
- (ii) information that is orally disclosed locally or in foreign countries;
- (iii) other information, such as public working of invention, secret use of the invention.

According to our Decree-Law No. 551 pertaining to the protection of a patent right and implementing Regulation, prior art is defined as “The State of the art shall be held to comprise information/data pertaining to the subject matter of the invention, accessible to the public in any part of the world, before the date of filing of the application for the patent by disclosure whether in writing or orally, by use of any other way.”

### Ukraine

Prior art includes all the information that has become publicly available in the world prior to the date of filing an application with the Office and, if priority is claimed, before its priority date.

Prior art includes:

- information that is published in written form in a given country or in foreign countries.
- information that is disclosed orally in a given country or in foreign countries, if it is fixed by sound recording apparatus or stenographically, in accordance with the established procedure.
- information on technical means that have become known as a result of their use.

For the purposes of verifying novelty, prior art also includes the content of any application for the grant of a patent in Ukraine (including that of an international application), according to the wording with which this application was first filed, provided that it was or will be published and its filing date (or where priority is claimed, priority date) precedes the

filing date (or where priority is claimed, priority date) of an application in relation to which the prior art is determined.

### Venezuela

An invention shall be considered novel where it is not included in the prior art.

The prior art shall include everything that has been made accessible to the public by means of a written or oral description, use, marketing or any other means before the patent application filing date or, where appropriate, recognized priority date.

Solely for the purpose of determining novelty, the prior art shall also be considered to include the content of a patent application being processed by the competent national office, whose filing or priority date is prior to the filing or priority date of the patent application being examined, provided that said content is included in the earlier application where this is published or the deadline provided for in Article 40 of Decision 486 has passed.

Prior art includes industrial application of the product which is the subject matter of a patent or complete use of a patented procedure, together with the distribution and marketing of the results obtained.

It shall be considered that an invention involves an inventive step if, for a person skilled in the art, that invention would not have been obvious from the prior art.

An invention shall be considered industrially applicable, where its subject matter may be produced or used in any type of industry, whereby the industry concerned shall refer to any production activity, including services.

### Viet Nam

According to Viet Nam's jurisdiction, the prior art relevant to an invention's novelty is considered upon requirements provided for in Article 4.1 Decree 63/CP. In detail, the following information sources will be included when searching:

- Sources related to inventions/utility solutions abroad.
- other sources with any information carrier (printed matters, film, magnetic tape, magnetic disc, optical disc, etc.).
- mass media sources (radio, broadcasting, television).
- scientific reports, lectures etc., if recorded by any means.
- exhibitions.

**Q4. NATURE OF DISCLOSURE**

Are there any established standards or criteria for determining the content that a prior art reference must disclose in order to be relevant (e.g. sufficient information to enable a person skilled in the art to carry out the claimed invention)?

- If this entails reference to a person skilled in the art, how is that concept defined?

**Argentina**

**Q 4 and 5:** Article 4 (LP) – Inventions for goods or procedures shall be patentable, provided that they are novel, involve an inventive step and are industrially applicable.

(a) For the purposes of this Law, an invention shall be considered to be any human creation which allows subject matter or energy to be transformed for the benefit of humanity;

(b) similarly, any invention which is not included in the prior art shall be considered novel;

(c) prior art shall mean all the technical knowledge which has been made public prior to the patent application filing date or, where appropriate, the recognized priority date, by means of an oral or written description, use, or any other means of dissemination or information, in the country or abroad;

(d) an inventive step will be involved where the creative process or its results are not obvious from the prior art for a person with average skills in the technical field concerned;

(e) an invention will be industrially applicable where the subject matter of the invention leads to a result or an industrial product being obtained, the term industry including agriculture, forestry, cattle breeding, fishing, mining, actual conversion industries and services.

Part C, Chapter IV, Point 5 (DP) – In accordance with Article 4(b) of the LP, any invention not included in the prior art shall be considered novel.

5.1. Article 4(c) of the LP states that: “prior art shall include all the technical knowledge that has been made public prior to the patent application filing date or, where appropriate, recognized priority date, by means of an oral or written description, use, or any other means of dissemination or information, in the country or abroad”. There is no restriction on the geographical location, language or manner in which the relevant information was made available to the public; nor is there any stipulation as to an age limit for the documents or other information sources. However, given that “the prior art” which the examiner possesses will consist mainly of patent documents and other types of publications (scientific, textbooks and so on), this section deals with the subject of public availability, only in relation to the written description (be it alone or in combination with a previous oral description or one relating to use).

5.2. A written description, i.e. a document, shall be considered available to the public if, on the relevant date, it was possible for the public to familiarize themselves with the content of the document and there was no obstacle pertaining to confidentiality which restricted the use or disclosure of such knowledge.

In the search report, documents may be cited in relation to which there exist doubts relating to the fact that they have been made public or in respect of their exact date of publication. If the applicant produces strong reasons to doubt whether the document referred to actually belongs to the prior art in relation to his application and the investigations that can be conducted in that regard do not generate sufficient evidence to eliminate these doubts, the examiner will not pursue the investigation.

Other problems which may arise at the time of the prior art search relate to:

1. Documents reproduced in an oral description (for example, a public conference) or information provided from previous use (for example: a sample at a public exhibition).
2. The fact that only the oral description or the conference was made available to the public before the Argentinean application filing date, but the document in itself was published after said date.

In those cases, the examiner will base his judgment on the presumption that the document provides precise information as to the date on which the conference, exhibition or other previous event took place, for which reason said event shall be considered to belong to the prior art.

Once again, if the applicant provides strong reasons to doubt the truth of the information given in the cited document, the examiner will not pursue his investigation of the application. Part C, Chapter IV, Para. 0.3 (DP) — This means a person with average skills in the technical field concerned and possessing general common knowledge of the state of the art on the relevant date. It should be assumed also that he has had access to everything that is included in the “prior art”, in particular to those documents cited in the search made by the examiner and that he has had at his disposal the usual means, capacity and experience to carry out his routine work. If the problem induces the person with average skills in the field to seek a solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of the inventive merit of the solution must therefore be based on the knowledge and skill of such a specialist. There may be cases in which it is more appropriate to think in terms of a group of persons, for example, a research or production team than of a single person. This may be put into practice, for example, in certain advanced technologies such as computer or telephone systems and in highly specialized processes such as the commercial production of integrated circuits or very complex chemical substances.

### Armenia

In our jurisdiction a description should set out the invention in sufficient detail for it to be carried out.

### Australia

When assessing a patent application for novelty there are a number of established criteria for determining the content that a prior art reference must disclose in order to be relevant. However, for many of these criteria there are qualifications to allow for differences in how the same invention may be described and claimed by different people.

When considering a prior art document as a novelty citation, it is read as if it were being read when it was first published. That is, the document is to be read with the knowledge and skills that a person skilled in the art would have had at the date the document was published,

not the skills and knowledge that a person skilled in the art would have had at the priority date of the invention in question.

A prior art disclosure being used as a novelty citation must disclose each and every feature of the claimed invention. However, in determining the features of an invention, some features that have been claimed may be considered inessential if they do not contribute to the working of the invention.

There must be sufficient directions in the prior art document for the skilled addressee to recognize the invention and to put it into practice. In assessing the teaching of the prior art, the reader has to consider what the skilled addressee is being taught. In other words, the reader has to ask what the skilled addressee would have done on reading the citation. It follows that a prior disclosure will only invalidate a claim if, after having read it, the skilled addressee would rather than could have produced all the essential integers of the claim.

There has to be sufficient disclosure in the prior art document to enable the skilled addressee to put the invention into practice. That is, the disclosure must be an “enabling” disclosure.

The prior art document must enable the skilled addressee at once to perceive and understand and be able practically to apply the discovery without undue experimentation. Whatever is essential to the invention must be read out of or gleaned from the publication. If that generic disclosure is broad, vague, and/or speculative, then that disclosure will not deprive a claim of its novelty.

In Australia, the person skilled in the art (for novelty or inventive step assessments) is considered to:

- (a) be a skilled but non-inventive worker in the relevant field of technology in Australia;
- (b) know the common general knowledge in the art in Australia;
- (c) be anyone from a tradesman in some arts to a highly qualified scientist in others depending on the nature of the problem;
- (d) be one or more people.

Where a publication is a broad generic disclosure, it may be possible for subsequent researchers to obtain a “selection” patent. Most common in the chemistry field, selection patents apply to a group of compounds that have particular previously unsuspected properties not seen in other compounds of the broader group.

Selection patents are aimed at not only providing protection to the original inventor, but to also encourage other researchers by allowing the patenting of selected members of the original group or class which show special advantages over the original broad disclosure.

The criteria for a valid selection patent are:

- (a) the selection must be based on some substantial advantage gained or some substantial disadvantage avoided;
- (b) the whole of the selected members must possess the advantage in question; and
- (c) the selection must be in respect of a quality of a special character which may fairly be said to be peculiar to the selected group.

The question of “selection” arises when the invention claimed lies within a known field. Before an invention may be regarded as a selection, there must exist a single prior disclosure against which the claimed invention is compared. It is not necessary for the prior disclosure to encompass all of the claim under consideration. Only that portion of the claim which falls within the prior disclosure can have the selection test applied to it. Any portion of the claim which falls outside the prior disclosure is subject to the normal tests for lack of novelty and inventive step.

The basic level of disclosure required to anticipate a claim to a selection is the same as for any other claim. The law of selection operates to exclude an objection to lack of novelty in those circumstances where a class of compounds or things in a citation has not been made — and thus their properties not known. Thus:

- (a) if the citation does not provide an enabling disclosure, there is no anticipation; and
- (b) if any of the selected compounds have actually been made previously, a claim to that selection lacks novelty.

If a claim is a valid selection, it will be novel over the relevant prior art. However the mere fact that it is a selection does not render the claim inventive — the examiner must still consider whether there is an inventive step in making the selection.

#### Austria

The disclosure of each reference to the prior art may be taken into consideration when the search and examination are conducted. For the prior art, the disclosure must not be sufficient to carry out the invention.

#### Azerbaijan

An invention shall be considered new if it does not form part of the entire sum of knowledge (state of the art). The entire sum of knowledge (state of the art) shall be held to comprise any information, which has become available for everybody in the world before the filing date of the application. The entire sum of knowledge (state of the art) shall also comprise applications filed to the respective executive body and which were published in the official bulletin (item 3 of article 7 of the Patent Law).

#### Bangladesh

There is no established standard or criterion for determining the content that a prior art reference must be disclosed in order to be relevant.

#### Bolivia

No relevant specific standards exist. Decision 486 does not establish any restriction or limit on the concept of disclosure and its content.

#### Brazil

Disclosure of an invention must comply with the following: a) certainty as to its existence and to the date; b) sufficiency that allows an expert to understand the content of the subject and to reproduce it; c) publicity, meaning that information must be available or possible to be known by third parties.

A person skilled in the art is one having experience and average knowledge in the subject-matter.

### Bulgaria

The legal documents cited previously are the only standards in the practice of the Bulgarian Patent Office.

### Burundi

No standards or criteria are established for determining the content that a prior art reference must disclose in order to be relevant.

### Chad

Established standards or criteria exist such as: an invention is considered to involve an inventive step if, for a person skilled in the art with average knowledge and skills, it is not obvious from the prior art on the patent application filing date or, if priority has been claimed, on the priority date validly claimed for the application.

### China

Yes, we have established standards for the content that a prior art reference must disclose in order to be relevant, i.e. “in a manner sufficiently clear and complete so as to enable a person skilled in the relevant field of technology to carry it out”. “The person skilled in the relevant field of technology” who is also known as the person skilled in the art refers to a fictional “person” who is presumed to be aware of all of the common technical field to which the invention pertains. He should also be presumed to have had access to everything in the state of art and have had the normal means and capacity for routine experiment before the date. However, he does not have creative capacity. If the technical problem prompts the person skilled in the art to seek its solution in another technical field, he shall have had access to the relevant technologies, common technical knowledge, existing before the date of filing or date of priority and have the capacity for routine experiment in that field.

### Colombia

The general criterion exists whereby in order for the reference to be relevant, it must disclose the subject matter in a sufficiently clear and complete manner so as to be understood and for an average person skilled in the corresponding art to be able to carry it out.

In the case of the analysis of novelty, the prior art reference must explicitly contain all the essential technical features claimed in the invention being examined for it to be appropriate. Differences in the wording of the claims or the incorporation of results of laboratory tests are not relevant to the dismissal of a reference.

In the case of analysis of inventive step, the closest prior art is considered, i.e. the references closest in terms of their content to the invention being examined, and if in the opinion of the person “skilled in the art” the knowledge forming part of the prior art, prior to the patent application filing date, may lead to the invention, i.e. the application does not involve an inventive step.

The *person skilled in the art* “is a fictitious person to whom recourse is had for the purpose of obtaining an objective parameter allowing a truly inventive step to be

distinguished from that which is not inventive. Such a person will be one with average knowledge of the technical sphere to which the claimed invention refers. His level of knowledge is higher than the level of knowledge of the general public, but does not exceed what may be expected of a duly qualified person. A person with average, but not specialized, technical knowledge is sought” (Court of Justice of the Andean Community. Judgement No. 26-IP-99 of July 23, 1999).

#### Congo

Annex II, Article 14(d)(i), of the Agreement stipulates that the description of the invention forming the subject matter of the patent application shall be clear and complete so that a person skilled in the art with knowledge and average ability may carry it out.

#### Croatia

Prior art references must be relevant for the purpose of determining whether, and if so to what extent, an invention to which the application relates is new and involves an inventive step.

#### Czech Republic

As regards the relevant content of data on prior art no special criteria are determined that could restrict the use of facts found. With information acquired during use or orally it may be considered whether a person skilled in the art can recognize the heart of the invention on the basis of information acquired in this way.

#### Denmark

A person skilled in the art is usually defined as an average specialist with the knowledge that such a person had at the time the application was filed.

#### Egypt

Yes, there are many standards and criteria for determining the content that a prior art reference must disclose and sufficient information to enable a person skilled in the art to carry out the claimed invention.

#### Eurasian Patent Office

Eurasian legislation does not contain any established standard or criterion for determining the content that a prior art reference must disclose in order to be relevant. It is specified that the prior art must contain information comprehensible to a “person skilled in the art”.

#### European Patent Office

Subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1) EPC, if the information given therein is sufficient to enable the skilled person to practice the technical teaching of the document, taking into account the general knowledge at the relevant date. In other words, the teaching in question must be reproducible.

The “person skilled in the art” should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be



presumed to have had access to everything in the “state of the art” and to have had at his disposal the normal means and capacity for routine work and experimentation. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem.

There may be instances where it is more appropriate to think of the “person skilled in the art” in terms of a group of persons, e.g. a research or production team, than a single person. This may apply, for example, in certain advanced technologies such as computers or telephone systems and in highly specialized processes such as the commercial production of integrated circuits or of complex chemical substances.

### Fiji

Under Fiji’s Act there are no established standards or criteria for determining the content that a prior art needs to disclose, however, when an application is made it must include a specification. This specification or instrument in writing should describe and ascertain the nature of the said invention and the manner in which it has been produced or performed. A drawing has to be made to elucidate the said invention. The discretion to issue letters patent rests with the Attorney General and if need be he could require the applicant to provide proof that they are skilled in the art, especially since prior art is collectively owned in Fiji.

### Finland

Prior art must be available to the public.

The technical information must be understandable to a person skilled in the art. The person skilled in the art would be assessed as being a person having common knowledge in the art but no special knowledge like knowledge in the TK. The skills available only in the original community that holds the TK would not be counted in the skills of the person skilled in the art.

### France

The French CPI does not contain any article which determines the content that a prior art reference must disclose in order to be relevant.

However, according to several case law systems the essential condition of public accessibility is the bringing within its scope not only of the product but also of the means to carry out the invention and to generate the product. If the public referred to by the law is understood to mean any person not bound by secrecy, information is part of the prior art only if it has been disclosed in a sufficiently complete manner in order to be reproduced by a person skilled in the art (Paris Regional Court, December 8, 1993, PIBD 1994, III, p. 145; Paris July 6, 1993, PIBD 1993 III, p. 669).

No legal definition of a person skilled in the art exists. However, in general terms a person skilled in the art may be considered to be a person in the technical field to which an invention belongs.

### Georgia

In the information the idea should be disclosed up to a degree which allows the idea to be carried out.

Germany

The person skilled in the art assesses the information in the respective field. This skilled person determines whether or not the identified information is relevant in the particular field with regard to subject-matter of the application. The appropriate skilled person is defined above all by the technical field to which the invention belongs. The skilled person has average general knowledge. However, in his field he knows the state of the art as a whole, has good knowledge of the neighboring fields and thorough general technical knowledge.

Ghana

Yes, in Ghana certain standards are set for determining the content of a prior art reference. Like the invention of certain new ideas. Well if skilled in the art depends on the invention or the prior art being defined. By the information available.

Iceland

No

Ireland

The national law on prior art corresponds to Article 54 (2) of EPC. Generally speaking, the Irish Patent Office follows the EPO guidelines and jurisprudence.

Japan

For an invention disclosed on a publication to be regarded as holding a validity to exclude later-filed applications, there is the criterion that the invention is required to be described in detail to the extent that a person skilled in the art may easily understand and reproduce the invention.

Under the guidelines, “a person skilled in the art” is defined as “a person with ordinary skill in the art to which the invention pertains.”

Kenya

There are no established standards or criteria for determining the content that a prior art reference must disclose in order to be relevant. However, the standard practice of the office is that the disclosure needs to be sufficient enough to enable a person with skilled in the art to which the disclosure relates to work the invention.

Republic of Korea

There are no established standards or criteria for determining the content of a prior art reference that must be disclosed in order to be relevant. In other words, to meet the conditions of specification for a patent, there is no requirement for the disclosure of the content of a prior art reference.

However, according to our examination standards, prior art can be the basis for rejecting a patent application if there is no doubt that the invention is publicly known or that it has been worked or distributed.

Furthermore, the recognitive scope of prior art extends to the disclosure of sufficient information that would enable a person with ordinary skill in the art to understand the basic techniques and knowledge of the invention.

In the Patent Act, “a person with skill in the art” refers to a hypothetical person who has mastered the knowledge and skill of experts in a relevant technical field. That is, the person has basic technical knowledge of the field and can freely use ordinary means and capabilities for R&D. The person can also obtain everything on a technical level at the time of the application and is able to appropriate the knowledge and techniques of the relevant invention.

#### Lithuania

Under Article 4 of the Patent Law “the state of the art shall consist of everything which, before the filing date of the patent application or where priority is claimed, before the priority date, has been published or was in public use in the Republic of Lithuania or abroad.”

#### Malaysia

Yes, Prior art shall consist of everything disclosed to the public, anywhere in the world by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application.

#### Mauritius

There are no established standards.

#### Mexico

The criteria in the substantive examination procedure establish that the novelty of an invention must be absolute, therefore the disclosure in the prior art must be for each and every one of the components of the claimed invention. This implies that an “expert with average knowledge in the field of the invention” may carry out the same invention claimed with the information disclosed in the prior art.

#### Republic of Moldova

For determining the novelty, the content of the reference text (document) comprising the subject-matter expressly stated and the subject-matter derivable directly and unambiguously from that document are considered to be relevant, including any features implicit to a person skilled in the art in what is expressly mentioned in the document. This prior document should be read as it would have been read by the person skilled in the art on the effective date of the document. For effective date see Q6.

If the prior document refers explicitly to another document as providing more detailed information on certain features, the disclosure of the latter should be regarded as forming part of the content of the prior document, if the document referred to was available to the public on the publication date of the prior document containing such reference.

#### Norway

The subject matter described in a document, can only be regarded as relevant if the information given is sufficient, at the relevant date of the document, to enable a person skilled in the art to carry out the claimed invention.

A person skilled in the art is meant to be an ordinary practitioner aware of what was common general knowledge in the art at the filing date of the application.

#### Panama

No. It is sufficient for prior art to be accessible to the public in any place in the world.

#### The Philippines

The person skilled in the art is presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He is presumed to have knowledge of all references that are sufficiently related to one another and to the pertinent art and to have knowledge of all arts reasonably pertinent to the particular problems with which the inventor was involved. He is presumed also to have had at his disposal the normal means and capacity for routine work and experimentation.

#### Poland

According to the “Commentary to PIPL”, in case of apparatus it is important to collate all technical features or its integral parts and their connections or, in case of chemical substance — its chemical structure or content and, in case of process — particular activities and conditions of their performance. Such collocation should be compared with prior art.

Furthermore we apply the criterion of the effect, which says, that it is forbidden to grant a patent which would result in prohibiting use of new solutions known from prior art.

#### Portugal

To grant a patent it is necessary that the invention should be sufficiently disclosed, enough for a person skilled in the art to be able to perform it.

The concept of “person skilled in the art” is not defined in PT legislation.

#### Romania

Yes. The Implementing Regulations of the patent law stating the conditions to be fulfilled by the documents in the prior art for being considered as relevant for the novelty and inventive step purposes. The reference to the person skilled in the art is made as regards the inventive step.

The Implementing Regulations of the patent law refers to the person skilled in the art, defining the same in the section “General Provisions; Definitions” as: “the person deemed to have access to the whole prior art, having normal abilities and general knowledge in the technical field to which the technical problem solved by the invention at the relevant date belongs.”

#### The Russian Federation

There are no established standards or criteria for determining which information constitutes prior art. For an invention to comply with the criterion of inventive step, it must not be obvious to a person skilled in the art from the prior art, i.e. in the case in question the basis used is the knowledge of a person able to understand both an invention itself and also information from the prior art relating to the invention.

Senegal

Disclosure is a counter indication to novelty. The filing which is the subject of a patent application must not be disclosed beforehand, since this will impede the criterion of novelty which is fundamental to the grant of a patent.

Singapore

Case law in UK on “a person skilled in the art” and “enabling disclosures” is persuasive and has been referred to in our local judgments e.g. Merck & Co Inc v Pharmaforte Singapore Pte Ltd [2000] 3 SLR 717 [Singapore Court of Appeal] and Genelabs Diagnostics Pte Ltd v Institut Pasteur & anor [2001] SLR 121 [Singapore Court of Appeal].

Spain

No, there is no established standard or criteria.

A person skilled in the art is considered to be an expert who does not specialize in the specific sector of the invention (for example, for a biology-related patent the expert is a biologist but not necessarily a specialist in said sector).

Sweden

No particular standards, criteria or specific conditions, apart from what has been stated in Q3, are normally applied to prior art references.

In one case the Swedish Court of Patent Appeals has concluded that a feature can be novelty destroying even if the feature is not explicitly described if a person skilled in the art understands that said feature must be included in a cited document.<sup>19</sup>

Thailand

Yes. A person skilled in the art means a person who has a basic knowledge in the art.

Tonga

Not applicable.

Trinidad and Tobago

The nature of the prior art must pertain to the scope of the patent claims in question. Sufficiency of the disclosure in a patent document must allow a person with average skill in the art to carry out the claimed invention. The hypothetical person is neither an expert nor a novice.

Turkey

Prior art has to enable a person skilled in the art to make or use the invention and disclose it in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

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<sup>19</sup> Swedish Court of Patent Appeals (Patentbesvärsträtten), 02-208, 2003-06-19, SE 9500268-9

Ukraine

No provision is made for the criteria in question.

Venezuela

Yes, to disclose the invention in a sufficiently clear and complete manner for it to be understood and to define the subject matter for which protection is sought by means of a patent.

Viet Nam

Information is considered to be disclosed if based on that disclosure, a person with average skill in the art would be able to carry out such technical solution described in the application.

Viet Nam's jurisdiction does not contain detailed definition of "a person with average skill in the art". However, in practice, patent examiners of our Office apply the definition of this term set forth in the Guidelines for Examination in the European Patent Office (paragraph 9.6, page 48, Chapter IV, Part C).

**Q5. SPECIFIC CONDITIONS FOR RECOGNITION OF PRIOR ART.**

What other specific conditions apply in determining whether a certain piece of prior art has been sufficiently disclosed to be taken into account?

(i) *Public availability:* If the prior art must be available to the public to be relevant, how has the relevant public been defined – e.g. what is a public setting, and what form of disclosure amounts to availability? Alternatively, what kinds of semi-public disclosure or disclosure within a private setting have not been counted as relevant disclosure of prior art?

(ii) *Languages:* Is prior art counted if it is only available in foreign languages (including dead languages), or minority languages?

(iii) *Publication:* If prior art must be “published” to be taken into account, what criteria apply for prior art to be an eligible form of publication?

(iv) *Internet or electronic publication:* What counts as publication or public availability on the Internet or on other digital networks?

– Is there a requirement for networks to be publicly accessible?

– Is material on proprietary (pay for use) databases or digital networks included as potential prior art? Does this apply to databases or networks that are private, for example accessible only by members of a particular community, or employees of a particular company, university or research institute?

– What conditions apply for material uploaded on the Internet to be taken into account as prior art?

(v) *Other conditions:* Are there any other conditions that can determine whether certain information can be taken into account as relevant prior art?

**Argentina**

Part C; Chapter IV, Para. 7 (DP)

7.2 A document affects the novelty of any subject matter claimed in the application under consideration, if the subject matter is derived directly and unambiguously from that document, including any characteristic which, for a person skilled in the art, is implicit in what is clearly stated in the document, for example the description of the use of a type of rubber in circumstances where its elastic properties are clearly used, even where this is not stated explicitly, affects the novelty of the use of an elastic material.

The delimitation of the subject matter derived directly and unambiguously from the document is important. Thus, where novelty is considered, it is not correct to interpret the teachings of a document as involving well-known equivalents which are not described in the document; this question relates to obviousness (inventive step).

7.3 In the analysis of novelty, a prior art document should be read as it would have been read by a person in the trade on the date of publication of said document.

However, it should be noted that, in the case of a chemical compound, if a document only mentions the name or formula of said compound, it will not be considered known, unless the information in the document, together with the knowledge generally available on the effective date of the document (publication date) allows the person in the trade to prepare and separate said compound and, in the case of a natural product, only to separate it.

7.4 When considering novelty, it should be borne in mind that a generic description of the prior art does not normally affect the novelty of a specific example of the invention which comes within the terms of that disclosure; nevertheless, a specific description affects the novelty of a generic claim which covers that disclosure, for example: a description of “copper” affects the novelty of “metal” as a generic concept, but not the novelty of any metal other than copper, and a description of rivets affects the novelty of fastening means as a general concept but not the novelty of any other fastening means distinct from rivets.

7.5 In the case of a previous document, the lack of novelty may be manifested by means of an explicit disclosure in the document itself. Alternatively, the disclosure may be implicit in the sense that, by applying the teaching contained in the prior art document, the person skilled in the art would obviously arrive at the result which comes within the terms of the subject matter claimed in the application. An objection regarding a lack of novelty of this kind should be expressed by the examiner where he has no reasonable doubt concerning the practical effect of the previous teaching. Similar situations may also occur when the claims define the invention, or a characteristic thereof, in terms of parameters. It may be that, in a relevant prior art document, a different parameter, or no parameter at all, is mentioned. If the prior art teachings and the claimed product are identical in all other respects (a situation which might be expected for example if the base products and the manufactured products are identical), it will therefore be necessary, in the first instance, to raise an objection regarding lack of novelty. If the applicant can demonstrate, for example, by means of appropriate proof providing a comparison with the prior art, that differences exist in respect of the parameters, the examiner must consider to what extent the application describes all the essential features for manufacturing the products possessing the parameters specified in the claims (sufficiency of disclosure, Article 20, LP).

Part C, Chapter IV, Para. 8.2 (DP) - There are three specific cases in which a previous disclosure of the invention will not be taken into consideration as part of the prior art; this is when the disclosure is due to, or a result of:

- (i) An obvious abuse in respect of the applicant or his beneficiaries; for example, the invention stemmed from the applicant and was disclosed against his wishes; or
- (ii) The disclosure of the invention by the applicant or his beneficiaries by any means of communication or display in a national or international exhibition, within the terms of Article 5 of the LP and RLP as referred to; or
- (iii) The publication by the ANP of an application abandoned or withdrawn before the publication date, owing to the fact that the publication process could not be delayed.

Part B, Chapter VI, Para. 5 (DP) - Content of the prior art disclosure.

5.1 As a general rule, only documents that are present in the search archives or those which are accessible in one way or another are selected for citation, such that there is no



doubt as to the content of the cited documents, since the examiner has generally inspected each cited document physically.

5.2 However, under certain circumstances a document whose content has not been verified may be cited, on the assumption that the content can be identified with that of another document which the examiner has inspected; in which case, both documents must be mentioned in the search report, as identified at the end of IX, 2.1.2. For example, instead of the document published prior to the filing date in an inaccessible language, and selected for citation, the examiner may have inspected a corresponding document (for example, another member of the same patent family, or a translation of an article) in an accessible language, and possibly published after the filing date; the examiner may also assume that, in the absence of explicit indications to the contrary, what is disclosed in a summary corresponds to the content of the original document.

5.3 Before citing documents in a language with which he is not familiar, the examiner must ensure that the document is relevant (for example, through the translation done by a colleague, a corresponding document or summary in a familiar language, or a drawing or chemical formula present in the document).

Comments: Although Argentinean legislation does not establish specific conditions for the general standard according to which a previous publication is considered to be a valid and relevant disclosure of the prior art, the following requirements must be satisfied: (1) it must be accessible (verifiable), (2) be sufficient and clear, and (3) bear a particular date.

In the specific case of electronic (Internet) publications, in addition to satisfying the above requirements, they must belong to recognized institutions.

### Armenia

(i) The prior art shall consist of any kind of information on technical solutions (individual parts) that has become generally available anywhere in the world prior to the day, month and year of priority of the invention concerned. The prior art shall also include the subject matter of inventions and utility models with the earliest possible priority, and disclosed applications filed with the Office, provided that the Office subsequently publishes the applications in question or the patents granted on the basis thereof.

(ii) Prior art is recognized if it is available in foreign languages.

(iii) Paper and electronic publications are taken into account.

(iv) The operative database is considered as available to an uncertain circle of persons even if access to it demands the password if anyone can get the password through non discriminatory procedures (independently, free-of-charge or through a payment). The operative database, access to which is provided simply with payment, is considered as a website, accessible to an uncertain circle of persons.

(v) There are no other conditions.

### Australia

In Australia a disclosure is looked at in terms of it being either a public or a confidential disclosure — there is no semi-public disclosure. If a disclosure is not made in confidence, then it is a public disclosure. The number of people the disclosure is made to is irrelevant. If

the disclosure was a public disclosure, then it is part of the prior art and can be used in patent proceedings.

Provided a document is published or information has been made available by publicly doing an act, then the language of the communication is not relevant to the consideration of whether it is prior art. IP Australia has English, French and German language skills and therefore only routinely searches, finds and cites documents in these languages including translations from certain languages (for example Japanese and Russian). Although, if a third party provided a certified English translation of a document in another language, then this document would be considered by IP Australia as part of the examination process.

In Australia “publish” is given its ordinary dictionary meaning and there are no special criteria for determining whether something has been published. Therefore any method of issuing to the public the works of an author or making something publicly or generally known is considered to be an act of publishing. This includes publication on the Internet or a radio broadcast etc.

Publication on the Internet or other digital networks is treated no differently from any other form of publication in Australia. The question in Australia is whether or not the disclosure was a public or confidential disclosure. Determining the date of publication may in some cases be a problem however (see the answer to Question 6 below).

There is no requirement that a network be publicly accessible. Provided a document is not disclosed in a confidential manner, then it is published. So the question in Australia is not whether a database or network is private or only accessible by a restricted user base, or only accessible on a subscription or pay-per-view basis, but whether access to that database has express or implied terms of confidentiality. Therefore material on proprietary databases or digital networks, and private databases or networks such as those accessible only by members of a particular community, or employees of a particular company, university or research institute may or may not count as a publication.

Determining the publication date for a document on the Internet may be more difficult than for a paper document. However, there are no special conditions for material that is uploaded on the Internet to be taken into account as prior art.

There are no other conditions that can determine whether certain information can be taken into account as relevant prior art.

Note: During examination only documents can be considered. During opposition and judicial proceedings the entire prior art base is considered — that is both information in published documents and information that has been made publicly available by doing an act (for example, an oral disclosure) anywhere in the world.

### Austria

Secret disclosures and disclosures in a private setting or a conference with personal invitations (which are not open to the general public) are not considered to be prior art.

Firstly, publications in English, French and German are taken into consideration.

Each publication in whatever language is taken into consideration, provided that there are figures which are sufficiently meaningful or there are abstracts in English (For the

examination, it is often sufficient to look at the figures. Automatic translation tools are used such as Babel Fish and so on).

In order to be taken into consideration as prior art, the following must be available to the public:

- information published in written form (in any country);
- information published on CDs, DVDs, films or cassettes;
- information disclosed orally in any country;
- public use;
- models in a museum (for example, an abacus from Egypt or China);
- presentation at a conference which is open to the public (even fee-paying);
- presentation at an exhibition;
- presentation on radio or television;
- paintings (even rock paintings).

Digital networks must be accessible to the public. A publication on the Intranet of a company, which is secret, is not taken into consideration.

Publications on a private network are not taken into consideration if they are not accessible to the public.

Information from fee-paying databases (for example chemical databases) is taken into consideration.

In order to prove that an Internet site was available before an application was filed, the site [www.archive.org](http://www.archive.org) is used. The sites found are cited during the examination procedure, but they are not taken into consideration when an application is rejected.

In nullity or opposition proceedings, witnesses may be appointed.

In order to prove that something (for example a leaflet) was printed with a certain date or that a machine or device was sold before a particular date, the invoice may be shown (also during nullity or opposition proceedings).

### Azerbaijan

Prior art is counted if it is only available in foreign languages (including dead languages), or minority languages if it is translated into the languages used at the patent office.

Any shared form of the publication for familiarization and concepts of its essence can be considered as prior art.

Particularly database of patents and libraries counts as publication.

There is no requirement for networks to be publicly accessible.

Material on proprietary (pay for use) databases or digital networks are included as potential prior art if they contain data on the official publication in a case.

Material uploaded on the Internet should contain the link to the full-published document with the indication of its bibliographic data in order to be taken into account.

There are no other conditions that can determine whether certain information can be taken into account as relevant prior art.

### Bangladesh

There is no established standard or criterion for determining the public availability.

We do not consider any foreign language except English.

We consider both local and foreign documents published in English.

Internet or electronic publication is considered but there is no established standard available in this respect.

No other conditions can be taken into account as prior art.

### Bolivia

In Bolivia, the analysis of the state of the art applies subparagraphs (i), (iii) and (iv) in practice, despite the difficulties as to the availability of many patents owing to the language and a lack of resources for access to fee-paying digital networks. However, no limitation exists restricting the means of disclosure through which the state of the art is known. In other words, any means of disclosure may be acceptable, since no precise regulation exists for its classification or definition.

### Brazil

“Prior art” is present when the outcome reached, on the whole, is obvious or evident to a person skilled in the art.

As previously stated, disclosure of an invention must comply with the following: a) certainty as to its existence and to the date; b) sufficiency that allows an expert to understand the content of the subject and to reproduce it; c) publicity, meaning that information must be available or possible to be known by third parties.

The concept of “prior art” comprises whatever is made available to the public prior to the deposit of the patent application — by oral or written description in any language, by usage or any other means, in Brazil or abroad.

As previously noted, the concept of “prior art” comprises whatever is made available to the public prior to the deposit of the patent application. Besides being available to third parties, publication must comply with the following: a) certainty as to its existence and to the date; b) sufficiency that allows an expert to understand the content of the subject and to reproduce it.

Material uploaded on the Internet is subject to the same requirements as mentioned above with respect to conditions that publication must comply with — certainty, sufficiency and availability to third parties.

There are no other conditions that can determine whether certain information can be taken into account as relevant prior art.

### Bulgaria

According to Art.11. (1) of the Bulgarian Patent Law, a disclosure of the invention shall not be prejudicial to novelty if it occurred within six months preceding the filing date or the priority date, as appropriate, of the patent application and if it was in consequence of: 1. an evident abuse in relation to the applicant or his legal predecessor; 2. the fact that the applicant

or his legal predecessor has displayed the invention at an official, or officially recognized, international exhibition. (2) The disclosure referred to in paragraph 1, item 2 shall not be prejudicial to novelty, if the applicant states, when filing the application, that the invention has been so displayed and presents evidence of that within three months following the filing date of the application.

Prior art is counted when it is available in foreign languages (including dead languages) and minority languages.

Document could be taken into account concerning criteria of publicity showed in Article 37(3) of RFFE.

In the RFFE there are requirements about publication and public availability on Internet or other digital networks, but they are not exact enough. In the patent practice the examiners avoid to cite such documents.

### Chad

Regarding Internet or electronic publication, the network must be accessible to the public and, above all, accessible to the centralized WIPO databases.

### China

In the State Intellectual Property Office of China (SIPO), the means for disclosure of the prior art include disclosure by publications, disclosure by use and disclosure by other means. With regards to Internet and electronic publication, the network shall be publicly accessible. Material on proprietary (pay for use) databases or digital networks is included as potential prior art. This does not apply to databases or networks that are private and not publicly accessible. Material uploaded on the Internet will be taken into account as prior art if the Internet is publicly accessible and there is evidence for the publication date (upload date).

### Colombia

In addition to the conditions referred to in Part II, Q3, no other specific conditions exist that are established for determining whether the prior art has been sufficiently disclosed to be taken into account.

It is therefore reiterated that the disclosure may be oral or written, may result from use or exploitation, or be produced by any other means. This disclosure must be detailed and, in any case, sufficient for a person in the trade to be able to use that information to carry out or exploit the invention.

Relevant public has been understood as the group of persons, or sole person, who are not obliged to maintain confidentiality or who are physically able to understand the disclosure and disseminate it. No matter the number of persons who have become familiar with the disclosure, it may be a group of experts, or only one person who, at least potentially, is able to transfer the knowledge to any person showing an interest in becoming familiar with the technical rule in question.

In accordance with the Andean rules, the disclosure occurring within the year preceding the application filing date or within the year preceding the priority date, where this has been invoked, is not considered to be relevant disclosure, provided that such disclosure has been made by:

- (a) the inventor or his successor in title;
- (b) a competent national authority which, contrary to the standard governing the matter, publishes the content of the patent application filed by the inventor or his successor in title; or
- (c) a third party who has obtained the information directly or indirectly from the inventor or his successor in title.

Any document in any language is considered to be prior art.

As already mentioned, the *prior art* is all the technical elements which have been made public prior to the patent application filing date. Since the knowledge must belong to the prior art before the application filing date, it is important that clear evidence can be provided of the date on which the respective disclosure was made.

Possibility of disclosure of documents which may be retrieved via connection to the Internet or other digital networks are taken into consideration.

There is no requirement for networks to be publicly accessible. Any person may access the networks.

Material on proprietary (pay for use) databases or digital networks is included as potential prior art. It applies to databases or networks that are private, for example accessible only by members of a particular community, or employees of a particular company, university or research institute.

If through the Internet or other digital networks documents are found with relevant technical content and from which it is clear that they were published on a date prior to the application filing and/or priority date, according to the case in question, said documents may be considered to be part of the prior art.

Regarding other conditions that can determine whether certain information are taken into account as relevant prior art, as already established, the ideal is that the disclosure must be detailed and, in any case, sufficient for a person in the trade to be able to use that information to carry out or exploit the invention.

### Congo

Annex II, Article 3, of the Bangui Agreement brings together all the elements contained in (i), (ii) (iii) and (iv) which occur in any place, by any means or in any manner.

### Croatia

Prior art is counted in all languages, including minority languages.

There is a requirement for networks to be publicly accessible.

Material on proprietary (pay for use) databases or digital networks is included as potential prior art.

This applies to databases or networks that are private, for example accessible only by members of a particular community, or employees of a particular company, university or research institute.

### Czech Republic

What is decisive for including information into the prior art is the way of acquiring the information, that is its public availability:

(i) public availability means that an unlimited circle of people (that is anybody) must be able to become acquainted with the information; it does not matter whether they have really become acquainted with it, mere existence of the possibility is sufficient;

(ii) such information is also relevant if it is provided in another country or in another language; however there must be a reliable way of translating the information into the national language;

(iii) when condition (i) is met it is necessary that the date (time) of publication be provable;

(iv) information acquired from the Internet is assessed with a pinch of salt; in general the Internet is not considered a reliable source of information. Such information considered reliable is based for instance on bibliographical citation (mostly articles from professional magazines). Information provided to a limited community (company, university, workshops, etc) is not relevant to the prior art;

(v) the prior art is not publication of invention within six months prior to the submission of the patent application if the applicant presented the invention at an officially recognized exposition or the publication was evident misuse in connection with the applicant.

### Denmark

There are no specific requirements. Any information that is potentially available to the public or a "larger or undefined" group of people is relevant prior art.

(i) A public setting is defined as a "larger or undefined" group of people;

(ii) all languages are in principle relevant is so far as the language grants access to the information by a group as defined above;

(iii) no answer;

(iv) no specific requirements for Internet publication has been laid down. The prior art status of material on a concrete network must be judged in accordance with the standard as mentioned above;

(v) no.

### Egypt

The specific conditions that apply in determining whether a certain piece of prior art has been sufficiently disclosed to be taken into account are (i), (ii), (iii) and (iv).

### Eurasian Patent Office

The basic condition for a certain piece of prior art to be sufficiently disclosed, which must be taken into account, is public availability.

Public availability is defined as the official practical possibility for any person to familiarize him or herself with the content of prior art in which information is disclosed.

If information is received unofficially, such information relates to the prior art not from the date on which it is received but from the date of publication.

The official disclosure of information to a restricted group of people with no limitation on their right to disseminate (publish) the information received is considered to be the date of publication of this information, irrespective of the number of people to whom this information was disclosed.

Prior art is considered to be available to the public irrespective of the language in which it is available.

Information contained in prior art must be published prior to the filing (priority) date of an application.

The same requirements of public availability are applied to this kind of prior art as for any other prior art. If a community that has the right and technical capability to disclose the content of information is restricted (defined), such information is not considered to be publicly available and does not relate to the prior art.

The requirement for payment for receiving information does not limit the relevance of an information source to prior art. The possibility of access to such information for a limited community excludes the relevance of such information to prior art.

Such conditions include documentary evidence of the fact that such information has been obtained from the Internet, and proof of its content and date of receipt.

Other conditions determining whether certain information, obtained using electronic means, can be taken into account as relevant prior art include: the possibility of supplying a copy of this information on a material carrier containing information on the date of its appearance by electronic means, or written verification of this information by an authorized person.

#### European Patent Office

Over the years, the EPO boards of appeal have arrived at a clear definition of “the public”. Information is said to be “available” to the public if only a single member of the public is in a position to gain access to it and understand it, and if there is no obligation to maintain secrecy. According to the case law of the boards of appeal, the word “public” in Article 54(2) EPC does not necessarily mean the skilled person. Moreover, the word “public” within the meaning of Article 54(2) EPC does not presuppose a minimum number of people or specific educational qualifications. Nor does the word “public” in Article 54(2) EPC necessarily refer to the man in the street: a disclosure before a skilled person makes it “public” in the sense that the skilled person is able to understand the disclosure and is potentially able to distribute it further to other skilled members of the public. If the person who was able to gain knowledge of the invention was under an obligation to maintain secrecy, the invention cannot be said to have been made available to the public, provided the person did not breach that obligation.

Concerning languages, see answer to Q. 3.

Concerning publications, see answer to Q. 3.

Concerning Internet or electronic publication, see answers to Q. 3 and 5.



Material on proprietary databases or digital networks is included as potential prior art as far as the information is considered as having been made available to the public (in the sense of answers to Q. 3 and Q. 5 (i)), i.e. as far as a single member of the public was in a position to gain access to it and understand it, and if there was no obligation to maintain secrecy. This principle also applies to databases or networks that are private.

Since the state of the art comprises everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application, examiners may retrieve relevant disclosures from the Internet (see answers to Q. 3 and Q. 5). However, while for conventional written disclosures (e.g. articles, books) the date of availability to the public is clearly identifiable, generally coinciding with the publication date, there is no reliably identifiable publication date of information appearing only on the Internet. It is in particular difficult to determine the actual date on which information has been made available to the public on the Internet. Moreover, information present on the Internet may be frequently updated or moved to another server. The lack of permanency and the lack of means to ensure the reliability of information appearing only on the Internet means that establishing what was published and when may be difficult. Internet disclosures are therefore to be treated with particular care. A certified copy of an Internet disclosure restores the evidential value of public availability.

Concerning other conditions, see answers to Q. 3.

### Fiji

Under Fiji's current law there are no specific conditions laid down to determine whether a certain piece of prior art has been sufficiently disclosed. If this was the case then it should be detected by the AIPO or in the United Kingdom since all patents registered there are automatically registered in Fiji.

The prior art does not have to be available to the public to be relevant. In most cases a notice is put in the Gazette and a local newspaper of the applicant's invention and of their desire to have it registered. If no opposition is made three months after such notice then the Attorney General shall issue letters patent to the applicant.

There is no express provision in Fiji's laws but languages should not be a problem as long as it has been cleared by AIPO or if registered in the United Kingdom then it is registered in Fiji too and language might not be a barrier here.

In Fiji prior art is unwritten and passed down from generation to generation and there are no specifications on whether it be published and if so in what form. For foreign applications though, the AIPO could be requested to give an account on the issue of publication.

Concerning Internet or electronic publication, here again we rely solely on the recommendations made by the AIPO and do not have provisions in our Act to cater for this.

Regarding other conditions, in Fiji's case we may need to consider calling the elders of a particular community to verify whether the art in question is prior art or not and this may be the only practical way to achieve this.

## Finland

Prior art is considered to be public, if a fairly large or undefined number of persons have had an opportunity to learn to know the prior art well enough to be understandable for a person skilled in the art.

Prior art is counted if it is available in foreign languages or minority languages but not in dead languages.

Networks must be publicly accessible (see paragraph 1). The publicity and the existence of the text must be substantiated.

## France

(i) The Paris Court of Appeal considered that the public could be understood as “*any person not bound by secrecy and able to understand and reproduce the invention simply by seeing the result generated by the process or product*” (Paris Court of Appeal, July 6, 1993, PIBD 1993, 555, III 669).

For example, according to a decision an invention formed part of the prior art when its prototype was presented, before the filing date, to customers, whereas they were not bound by a confidentiality obligation (Rennes Regional Court, February 10, 2003, PIBD 770, III 412).

By contrast, in another decision a number of documents relating to the invention supplied to companies were not considered to be a public disclosure, insofar as these documents “*were expressly covered by a confidentiality clause excluding any disclosure of their content to the public*” (Limoges Regional Court, May 16, 2002, PIBD 2002 749 III 397, see also Paris Regional Court, September 4, 2001, PIBD III 156). In this decision the invention was not considered to be accessible to the public.

In certain cases the disclosure of an invention will not be able, according to the courts, to destroy novelty. This is the case for example where an invention in the medical field has been tested on patients not subject to a confidentiality clause. The Paris Regional Court considered that there had been no disclosure, since in the case in question it was a matter of “*necessary agents for required tests*” (Paris Regional Court, September 1, 1999).

Similarly, in the decision cited above from the Rennes Regional Court, the court recognized that there had been a disclosure of the invention where its prototype had been presented to customers of the company owning the patent before the filing date. By contrast, the Court does not recognize the disclosure where this has been made to the distributors of the company holding the patent. The court specifies that “*although it can be validly sustained that, as regards the network of distributors of company X, there was a tacit confidentiality obligation, resulting from their reciprocal business affairs, by contrast this obligation did not bind the customers of the company Y making the request*” (Rennes Regional Court, February 10, 2003, PIBD 770, III 412).

(ii) Pursuant to Article L. 611-11 CPI, “the prior art consists of everything that has been made accessible to the public before the filing date of the patent application by a written or oral description, use or any other means”. In absolute terms, it may be considered that a disclosure in any country (either abroad or in France) or that documents, irrespective of the language in which they are written, may be taken into consideration as prior art. However, as regards the production of documents in a foreign language, a problem may arise in terms of the proof of prior art: for example, a court dismissed from the discussions

documents produced as prior art, since they were foreign documents and no translation had been supplied “(...)whereas there is a need to dismiss from discussions the documents which do not have a certain date or are in a foreign language (...)” (Paris Regional Court, May 9, 1990, PIBD 1990 485, III, 538);

(iii) as provided for by Article L 611-11 CPI, a prior art publication is not compulsory for the purposes of consideration;

(iv) it happens that documents published electronically are cited in preliminary search reports. However, no patent application has, to the best of our knowledge, been rejected as a result of a clear lack of novelty on the basis of an electronic publication.

### Georgia

(i) Public availability: the definition “relevant public” is not disclosed in our Patent Law, but it means a unimpeded access of the third persons to the data contained in a source of the information;

(ii) languages: any language is taken into consideration.

(iii) publication: There are no criteria; any form of the publication.

(iv) internet or electronic publication: Yes/Yes

Usual requirements to the usual publication.

(v) other conditions: No.

### Germany

(i) The state of the art comprises all knowledge made available to the public by means of a written or oral description, by use or in any other way, before the date relevant for the priority of the application. Information presented at an event is said to be available to the public in spite of the fact that the event was attended only by a limited circle of people if there was no obligation to maintain secrecy so that it was possible to pass on the information to other skilled persons;

(ii) information available to the public covers information in any translatable language;

(iii) publication does not only cover the written form or printable documents with identifiable date of issue, but also oral description of the subject-matter of the application;

(iv) any information with an identifiable date of issue must be considered, including electronic information with an identifiable date from the Internet or from other publicly accessible databases. Company in-house databases are usually subject to secrecy restrictions and not accessible to the public;

(v) see (i).

### Ghana

Recognition of prior art has to do with the impact it has on the public, and their readiness for the art.

- (i) Public availability “readiness of the art being accepted by the public and it use”;
- (ii) language. Yes, sometimes. For further consideration so that the art would be relevant in later years.
- (iii) publication: it must raise awareness, through the media, newspapers and workshops for the prior art to be introduced;
- (iv) Internet or electronic publication. They count for international recognitions:
  - Yes payment for public accessibility.
  - Yes, for certain information only to members of the community, employees of a particular company, universities or research institutes.

Valid information and good art are needed for the art in the community or company.

Yes, they can set up a test committee or a board for this purpose.

### Iceland

- (i) There are no established rules on this;
- (ii) no established rules but being in the Icelandic language is not a necessary condition;
- (iii) every form of publication, in speech, writing, in picture or by the use of the invention can destroy the novelty of an invention;
- (iv) no established rules on this but being published on the internet can destroy the novelty of an invention;
- (v) no.

### Ireland

The national law on prior art corresponds to Article 54 (2) of EPC. Generally speaking, the Irish Patent Office follows the EPO guidelines and jurisprudence.

### Italy

- (ii) Prior art is counted in any languages that is written.

### Japan

The word “public” refers to “unspecified persons.” Any piece of information which is available to unspecified persons is to be regarded as being publicly available.

Prior arts that are available only in a foreign language are treated equally as those written in Japanese.

A “publication” is a document, a drawing or other similar medium for the communication of information, duplicated for the purpose of disclosing the contents to the public through distribution.

Regarding the Internet or electronic publication, any network that can be seen by any unspecified person is to be regarded as being publicly accessible.

Any materials on databases/digital networks which can be made accessible to any person just by paying certain fees are to be included as potential prior arts. However, this does not apply to private databases/networks.

Our examination guidelines stipulates as follows:

The question of whether or not the information was made available before the filing of the application is judged based on the time of publication indicated in the cited electronic technical information. Therefore, electronic technical information without an indication of the time of publication cannot be cited, in principle.

No, there are no other conditions that can determine whether certain information can be taken into account as relevant prior art.

### Kenya

Apparently under the Kenyan jurisdiction there are no other specific conditions provided in law or available in any case decisions. In practice the possibility of anybody having free access to the disclosure is taken to mean that the same was publicly available irrespective of whether or not somebody has accessed or not.

### Republic of Korea

The relevant public refers to a situation in which an unspecified person can put prior art to use, though usage of the prior art is not a requirement.

Prior art is counted as long as it has been published, regardless of the language.

There are no established standards or criteria for the publication of prior art.

- That is, the content of prior art is not required to meet the condition of specification for a patent application.
- To acknowledge that a device has been described in a publication, we need to at least see a picture of the entire composition of the device. If only the external features of the device are shown, and not the internal features, we do not consider this an adequate description.

According to Article 1bis of the Enforcement Ordinance of the Patent Act, inventions that are made available to the public through electronic telecommunication lines are regarded the same as prior art published in other forms. However, inventions that are made available to the public through other electronic telecommunication lines are regarded the same as publicly known prior art or prior art that has been worked.

To ensure that inventions disclosed through electronic telecommunication lines are treated the same as prior art published in a publication, they must comply with the following requirements:

- (i) be open to the public through other electronic telecommunication lines.
- (ii) be available to the public.
- (iii) be open to the public through other electronic telecommunication lines managed by one of the following institutions prescribed in Article 1bis of the Enforcement Ordinance of the Patent Act:

- a Korean government and local government entity, a foreign government and local government entity or an international organization.
- Korean national and public school or a foreign national and public university.
- a Korean or foreign national and public research institution.
- a corporation established for the purpose of conducting business related to a patent information and designated by the Commissioner of the Korean Intellectual Property Office.

### Lithuania

There are no specific conditions in the Patent Law for recognition of prior art.

### Malaysia

If the Malaysian public can obtain copies of the documents, therefore the documents are “disclosed to the public in Malaysia” within the meaning of Malaysian Patent Law.

Prior art is counted if it is only available in foreign languages (including dead languages), or minority languages, as long as people can understand the invention disclosed.

The criteria that apply for prior art to be an eligible form of publication are the date and the number of the publication.

Any document published on the Internet can be considered as a prior art provided that the applicant, number and date of publication as well as the source of the information are known.

There are no other conditions that can determine whether certain information can be taken into account as relevant prior art.

### Mauritius

Given that the Industrial Property Office has recently started to implement the Patents, Industrial Designs & Trademarks Act 2002 and Regulations 2004, the mechanism used during patent procedures under the different provisions of the Act, is still to be improved and fine tuned in the light of future judicial and administrative decisions.

### Mexico

The expression “made available to the public” refers to establishing, with respect to a relevant date, the possibility that at least one member of the public obtains knowledge of the content of a document or is familiar with the subject matter, by any means of dissemination or information without having to comply with any confidentiality requirement in respect of the use or dissemination of the said knowledge.

Public access was possible, although there would be no requirement to demonstrate that a person was actually familiar with the content of the document, or familiarized himself with the subject matter.

Prior art is counted if it is only available in foreign languages (including dead languages), or minority languages.

For prior art to be an eligible form of publication, the publication must have a publication date prior to the patent application filing date or its recognized priority date.

Regarding Internet or electronic publication, there is no requirement for networks to be publicly accessible.

Material on proprietary (pay for use) databases or digital networks is included as potential prior art. This applies to databases or networks that are private, for example accessible only by members of a particular community, or employees of a particular company, university or research institute provided that the users are not obliged to respect confidentiality of information.

For material uploaded on the Internet to be taken into account as prior art, it must have a publication date and the origin or document source must be identifiable.

The legislation governing the patent system in Mexico does not contain any provision in which specific requirements are established for recognizing the prior art, in other words neither the manner in which or features via which the public accesses the information are qualified or analyzed, other than the evidence that the information has been disclosed by any means of dissemination or communication before the deadlines established by the Law is sufficient.

There are no other conditions that can determine whether certain information can be taken into account as relevant prior art.

#### Republic of Moldova

The information is considered made available to the public if it is contained in an information source, to which any person has access or if its content was communicated to them (Rule 2.8 of the Implementing Regulation to Law No. 561/1995). “Any person” means that the public may be one or more than one person who does not necessarily need to be a person skilled in the art and does not have necessarily the capability of understanding the teaching of the prior art. It is sufficient if the relevant information was accessed by such a person (public) or if there is reasonable possibility that this information could be accessed by the public.

However, where the disclosure had been made to a limited circle of persons, as long as these persons are free to disclose the information and are not bound by an explicit or implicit obligation of confidentiality to maintain the information secret, such disclosure is considered having been made available to the public.

The office Guidelines does not contain any restrictions concerning the language of, or the geographical location where, the disclosure was made available to the public.

Regarding publication, it must be a written description with an identifiable date of publication, which must be earlier than the priority date of the application, except the applications filed with the office earlier but published subsequently.

For publications made on the Internet or reproducing an oral disclosure, see also p. (iv) and Q. 6.

The availability of information disclosed via the Internet or electronic databases is considered in the same manner as other forms of disclosure (see Q4 and Q5 (i) above), being applied the same principle of availability whether it was reasonably possible for the public to gain knowledge of the content of the disclosure. In this context, the question of availability to the public of the URL arises, which is considered to be available to the public irrespective of

if it is free-access or pay for use. Does not form part of the prior art the information which could be accessed only by a restricted circle of public on a registration basis under an authorization.

Thus, the following conditions are applied for material uploaded on the Internet to be taken into account as prior art:

- public availability of the URL.
- possibility of search by search engine.
- credibility of the web site.
- identifiable date of printed material, which should anticipate the priority date of the application. For electronic issues of newspapers and other material published also on paper, the date of publication should be considered the date of paper edition.

### Norway

The public is a person or a group of persons not bound by an explicit or implicit obligation of confidentiality to maintain information secret, independent of whether they understand the information or not.

Prior art is counted if it is only available in foreign languages (including dead languages), or minority languages.

Prior art must have been available to the public in a period of time sufficient to give the public at least a theoretical possibility for access.

Material on proprietary (pay for use) databases or digital networks is included as potential prior art.

This applies to databases or networks that are private, for example accessible only by members of a particular community, or employees of a particular company, university or research institute provided that the persons who have accessibility to the databases or networks are not bound by confidentiality.

Information on the Internet is part of prior art if the information has been available to the public in a period of time sufficient to give the public at least a theoretical possibility for a direct and free access.

### Panama

The conditions established by the Law refer only to disclosure as such and do not specify the characteristics which it must have, other than being prior to the application date in Panama or to the claimed priority date.

Since our legislation does not specify any language for the assessment of prior art, in practice examiners consider all the documents included in the searches in a language known to them or which can be translated into Spanish.

In order for prior art to be taken into account, it must be published in the Official Gazette of the Intellectual Property Registry (BORPI), published by the Directorate General of the Industrial Property Registry.

Any publication on the Internet or on any electronic carrier from which a certain and verifiable date can be obtained counts as publication.



Our legislation does not envisage Internet accessibility requirements.

Since our legislation establishes prior art as being “everything that has been disclosed or made accessible to the public”, although we consider fee-paying databases patent examiners do not currently have access to such databases.

In order to consider material downloaded from the Internet, it must have a clear publication date in addition to all the data concerning the publisher. The publication must be made one day before the patent application date in Panama or the claimed priority date, as appropriate.

Apart from those referred to above no other factor exists for determining prior art.

### The Philippines

Prior art comprises of everything made available to the public by means of a written or oral disclosure, by use, or in any other way, before the filing date or the priority date of the application claiming the invention. Prior use which is not present in the Philippines, even if widespread in a foreign country, cannot form part of the prior art if such prior use is not disclosed in printed documents or in any tangible form.

### Poland

Public availability of prior art means, that it is available by means of a written or oral form, by use in different forms of description, image, or by any other forms or by displaying at certain exhibitions. Therefore, above does not mean that the availability is easy to obtain. It is sufficient when it is potentially available. In practice it applies to written publications — marked, for instance in books or periodicals or at exhibitions, with a certain date.

There are no restrictions regarding languages, in which prior art must be published.

Published prior art means that it can be attributed to a certain date.

The Internet may be used for prior art search only if gained information is marked with the publication date. In the Polish Patent Office we use free of charge databases, for instance *Espacenet* for inventions or *Medline* for medical inventions. Within the scope of Traditional Knowledge (TK) we do not use any specific databases.

There are no other conditions that can determine whether certain information can be taken into account as relevant prior art.

### Portugal

It should not be considered confidential by the owners of the information, i.e. anyone can, at least on a theoretical level, have access to that specific information. Semi-disclosure is not considered in PT legislation: it is either a public disclosure or a confidential disclosure.

Prior art is counted if it is available in foreign languages (including dead languages), or minority languages as far as it is available to public who knows, or has the possibility of knowing those languages.

It is not needed to be published in order to be considered prior art. The expression “published” has the meaning of “being available to the public by any means”.

Regarding Internet or electronic publication, networks have to be accessible to anyone. This kind of publication is dealt with in the same manner as the others.

Material on proprietary (pay for use) databases or digital networks is included as potential prior art, as long as the information is not disclosed as confidential, i.e. anyone can have access to it if they accomplish the requirements to do so.

This does not apply to databases or networks that are private. In this case, the information may be treated as confidential or not depending on the terms of confidentiality it has been accorded, i.e. if the relevant information is to be treated as confidential, by the entity who rules the database, it cannot be considered as published or publicly available.

In order to be taken into account, material uploaded on the Internet should have a publication date and if this date should be challenged it must be certified by the person who have published it, i.e. the person responsible for the information could be asked to prove the date of publication in order to be certified.

There are no other conditions to determine the relevant prior art.

### Romania

Availability to the public: to be considered as relevant, the prior art must be available to the public. According to the law, “public” means “one or more persons not restricted by confidentiality and which could disseminate information; the public may be any person, not necessarily a person skilled in the art”;

languages: Yes. Any element of the prior art is to be taken into account, if it is available in a foreign language;

publication: According to the patent law and to its implementing regulations, there is considered as knowledge available to the public the information available to the public, anywhere in the world; by:

presentation on various carriers or on various information channels;

oral presentation of information that was not subject to any restriction of confidentiality concerning the use or dissemination.

publication on the Internet or electronic publication: According to the law, the prior art comprises all knowledge made available to the public orally, by use or by any other means. “Any other means” signifies electronic means, particularly electronic databases or the Internet.

Yes. Networks have to be accessible by the public.

Yes. The information elements belonging to proprietary databases may be included in the prior art.

No. Information contained in private databases is not ordinarily considered as a part of the prior art.

The existence of printed matter with an identifiable date.

other conditions : The knowledge made available to the public orally, by use or by any other means is considered to belong to the prior art only if it is confirmed by a document containing it and proving the date of its being rendered available to the public.

### The Russian Federation

- (i) Public availability is determined on the basis of the requirement to gain access to particular information without infringing the legislative restrictions imposed;
- (ii) information is publicly available irrespective of the language in which it is produced.
- (iii) information contained in an information source must be published prior to the filing (priority) date of an application;
- (iv) the same rules of public availability apply to electronic information sources as to any other sources.

The requirement of payment for obtaining information does not limit the determination of an information source as prior art.

The possibility of access to this information for a limited circle of people excludes the determination of such information as prior art.

The compulsory requirement for electronic means is the publication date of documents or, where this date is missing, the date on which information is stored in electronic form, provided that it is supported by documentary evidence.

- (v) In relation to the requirement of novelty, the prior art also includes information which does not satisfy the requirement of public availability, i.e. information not published at the time in question — firstly, inventions and utility models patented in the Russian Federation provided that they have earlier priority, but only within the scope of their claims, and secondly all the applications for inventions and utility models with earlier priority, filed in the Russian Federation by other persons.

### Senegal

A patent application is filed with the competent authorities, in this case the OAPI. However, the inventor makes prior searches of websites so as to see whether what he believes he has invented has not been invented by someone else in a different country or continent. If, after these searches, the inventor is sure that his invention is original, he files his application with the OAPI which, in turn, carries out the same search in Africa and throughout the world. If, however, the invention already exists, the application is rejected.

### Singapore

Section 14 (2) of the Patents Act explains that: The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in Singapore or elsewhere) by written or oral description, by use or in any other way.

Section 14 (2) of the Patents Act is silent on any language requirement.

State of the art of an invention as defined in Section 14 (2) of the Patents Act shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made

available to the public (whether in Singapore or elsewhere) by written or oral description, by use or in any other way.

It is open to judicial interpretation as to whether Internet or electronic publication fall within the ambit of section 14 of the Patents Act.

It is open to judicial interpretation as to whether there are other conditions falling within the ambit of section 14 of the Patents Act.

### Sweden

Q4-Q5: No particular standards, criteria or specific conditions, apart from what has been stated in Q3, are normally applied to prior art references.

In one case the Swedish Court of Patent Appeals has concluded that a feature can be novelty destroying even if the feature is not explicitly described if a person skilled in the art understands that said feature must be included in a cited document.<sup>20</sup>

Q5(iv) Information that is or has been available electronically (e.g. via Internet) may be considered prior art if for instance:

- links are available to or from another web-site, or
- the web-site is registered at a search engine, or
- the web-sites address (URL) is made publicly available or seems obvious (e.g. www.company name.top domain)

Coded information that needs to be deciphered and the need for payment are not regarded as limitations to public availability (analogous with e.g. a book in a book store). Moreover, the information must have been available long enough to make it possible to be downloaded.<sup>21</sup>

### Thailand

- (i) Concerning public availability, see answer Q3;
- (ii) prior art should be in Thai or English.
- (iii) bibliographic data, Claims, Abstract and drawing (if any) will be filled in publication form;
- (iv) yes, there is a requirement for networks to be publicly accessible.  
No. Everybody can access search Patent free of charge;
  - Application which is published will be taken into account as prior art.
- (v) no.

### Tonga

Specific conditions for recognition of Prior Art: (not applicable)

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<sup>20</sup> Swedish Court of Patent Appeals (Patentbesvärsträtten), 02-208, 2003-06-19, SE 9500268-9

<sup>21</sup> Guidelines of Swedish Patent and Registration Office RL VII - 3.7.1

### Trinidad and Tobago

Trinidad and Tobago Patent Law does not specify conditions to validate prior art other than what can be construed under “made available to the public (in Trinidad and Tobago or anywhere else) by written or oral description or use or in any other way”. This will include Internet and electronic publication, historical date and oral traditions.

### Turkey

There is no wide definition for the availability to the public in the Decree Law but, in Article 7 it is mentioned as “before the date of filing of the application for patent by disclosure whether in writing, or orally by use or in any other way. Public could be only one person and it could be any person;

if any prior art is not in foreign languages (including dead languages), or minority languages and the individuals subject to the duty to disclose have a complete or partial translation, this should also be provided. So that, if prior art is available in any languages, it shall be counted;

any indication in a document of the date of its publication should be accepted as correct unless there is proof of the contrary;

regarding Internet or electronic publication, there is a requirement for networks to be publicly accessible.

Like this material is open to the limited group of searches and disclosure is available to anyone via this limited group of searches, it constitutes prior art.

It makes it impossible to determine whether the invention was published on the Internet before the date of filing;

no answer.

### Ukraine

Information is publicly available if it is contained in information sources that may be disclosed to any person.

There are no restrictions on the language in which the information used to determine prior art is drafted.

The criterion for the inclusion of information in prior art is the date, confirmed by documentary evidence, from which this information became publicly available.

No legislative provision is made for the inclusion in prior art of information from the Internet or electronic publications, although in practice when a search is conducted the Internet is used to identify information on legitimate sources containing information that is included in prior art.

### Venezuela

Any disclosure which is made, excluding the provisions of Article 17, means that novelty is lost (Article 17 of Decision 486). For the purposes of determining patentability, disclosure occurring within the year preceding the application filing date in the member country, or in the year preceding the priority date, where appropriate, shall not be taken into consideration, provided that such a disclosure has been made by:

- (a) the inventor or his beneficiary;
- (b) a competent national office which, in contravention of the relevant standard, publishes the content of the patent application filed by the inventor or his beneficiary; or
- (c) a third party who has obtained the information directly or indirectly from the inventor or his beneficiary.

Everything contained in the prior art, irrespective of the language in which it is written, shall be considered disclosed.

There is no requirement for networks to be publicly accessible.

### Viet Nam

If the prior art must be available to the public to be relevant, the relevant public shall be considered when this information is published before priority date (filing date) of the invention/utility solution application. Forms of information disclosures are indicated in the answer to Q3 above.

Information shall not be deemed publicly disclosed if only a limited number of related persons are aware of such information. A technical solution shall not be deemed lacking novelty if it is published by another person without the authorization of the applicant and if the publication dates back no further than 6 months prior to the filing date.

During substantive examination process of invention/utility solution applications, information sources which are published abroad shall be included for prior art searching. Therefore, it can be understood that in Viet Nam, information accepted for prior art searching could be available in any languages. In Viet Nam, there is no specific provision concerning information which is available in dead languages and minority languages.

Before the priority date of an invention/utility solution application, any information source, which is indicated in the answer to Q3 above, will be deemed relevant prior art used for substantive examination if that information has the nearest technical nature to the technical solution described in the disclosure (published) application and based on that disclosure, a person with average skill in the art would be able to carry out such technical solution.

Internet or electronic publication is also considered as an information source for prior art searching of an invention/utility solution. However, Viet Nam has no specific provision on using this source as prior art.

There are no other conditions that determine whether certain information can be taken into account as relevant prior art.

**Q6. ESTABLISHING THE EFFECTIVE DATE OF PRIOR ART.**

What determines the effective date for prior art to be cited against a patent application?

What standards of evidence are required to demonstrate that a written disclosure was published on or by a certain date?

What standards of evidence are required to demonstrate that an oral disclosure was made on or by a certain date?

What standards of evidence proof are required to demonstrate that material was published on-line?

For a patent document, is the effective date the priority date, filing date or publication date?

**Argentina**

This question has been answered partly in Q5.

As a comment referring to the proof necessary to demonstrate a publication on the Internet, and in order to complement the general requirements for any publication, as indicated above, at least a copy of the relevant parts of the prior art document is supplied during the search and substantive examination.

For the establishment of the effective date of the prior art in relation to a patent document, the publication date is adopted for all purposes; in other words, from the time when the material contained in the document becomes public.

**Armenia**

The effective date for written disclosure is the date of publication.

The effective date for oral disclosure is the date of oral communication, for example, of lecture or report, provided that they are taken down shorthand or sound recording is made.

The effective date for material, which is published on-line, is the date of placing on the Internet.

The effective date for patent document is the date of publication.

**Australia**

Provided a document is published or information is made publicly available by doing an act before the priority date of the patent application, then it forms part of the prior art.

The prior art for determination of novelty also includes Australian patent applications that have an earlier priority date than the priority date of the patent application being examined but a publication date after the priority date of the patent application that is being examined. These documents form part of the prior art even though they have been published after the priority date of the patent application in question. These documents are called “whole of contents” citations. They must be an Australian application to qualify as a whole of contents citation. If there is no Australian equivalent of the application, then it does not form part of the prior art base.

For an objection based on “whole of contents” to apply, the examiner must be satisfied that:

- (a) the citation is a published Australian complete specification at the time it is being considered;
- (b) the publication must have occurred after the priority date of the claim under consideration;
- (c) the relevant information referred to must have been contained in the specification on its date of publication; and
- (d) the relevant information referred to must have been contained in the specification when it was filed.

All of these conditions must be satisfied before an objection based on “whole of contents” can be taken.

In addition there is no provision to treat two or more related documents as a single disclosure where the documents are being cited for a “whole of contents” objection. That is, when considering a citation for “whole of contents” the citation for whole of contents must stand on its own, without reference to any documents referred to therein.

It is possible to establish that a written disclosure was published on or by a certain date by:

- A publication date on a document.
- A statement by the publisher or author as to when a document was published.
- A statement by a library as to when they received a document.
- A statement by anybody as to when they accessed or saw a document.

A publication date published on the document will normally be taken as the date of its publication.

However it is open to a person to supply evidence to establish that the document was in fact published on a different date.

A statutory declaration or evidence given under oath is sufficient to demonstrate that an oral disclosure was made on or by a certain date. However, typically the issue is not the date of the disclosure, but establishing exactly what was disclosed.

It is possible to establish that a document was published on-line by:

- A publication date or other evidence on a copy of the document that shows it was published on-line.
- A statement by the publisher or author that a document was published on-line.
- A statement by anybody as to when and how they accessed or saw a document.

The standard of proof required in making these decisions is the normal standard of proof required in civil litigation — the balance of probabilities. That is, on balance, whether something is “more likely than not” having regard to the credibility of the evidence. An important factor is the nature of the site where the publication occurred — and in particular whether there is a presumption that the information would not have been changed over the period between publication and access.



For patent documents the effective date for them to form part of the prior art base is the publication date.

In addition to this, Australian patent applications may be considered as part of the prior art base for determining novelty of an Australian patent application if the patent application has an earlier priority date than the priority date of the patent application being examined, but a publication date later than the priority date of the patent application under examination (see the explanation of “whole of contents” citations above). If this is the case, the effective date is the priority date.

### Austria

- For a patent or utility model document the publication date is taken into consideration.
- European patent application (provided that Austria is designated), an international patent application or a national (Austrian) patent or utility model application (filed before the application in question – but published later after the filing of the application in question) is treated as prior art. In this case, the filing date is taken into consideration (in accordance with Article 139 of the Convention on the Grant of European Patents (European Patent Convention)).
- Books, catalogs, magazines, newspapers, monthly periodicals: printing reference.
- Only in the case of nullity or opposition proceedings is there the possibility to question witnesses concerning documents with no printing reference.
- An oral disclosure of the witnesses who are questioned during opposition proceedings (after making a document available for public inspection) or during nullity proceedings.
- In order to prove that an Internet site was available before an application is filed, the site [www.archive.org](http://www.archive.org) is used. The sites found are cited during the examination proceedings but they are not taken into consideration when an application is rejected.

### Azerbaijan

- The date of its public disclosing determines the effective date for prior art to be cited against a patent application.
- Official publications are required to demonstrate that a written disclosure was published on or by a certain date.
- Materials established on audio or video carriers are required to demonstrate that an oral disclosure was made on or by a certain date.
- There are no standards of evidence required to demonstrate that material was published on-line.
- For a patent document, the effective date is the priority date.

### Bangladesh

There is no well-defined provision in the Patents and Designs Act and Rules followed presently.

For a patent document, the effective date is the publication date.

### Bolivia

For patent applications originating from Bolivia, the effective date is considered to be the date of registration in Bolivia although, in the case of dispute, the priority date will be used where it exists. For foreign patent applications, the date taken into account is that of priority, as indicated in Decision 486.

For written disclosure, documentary evidence is required proving a particular date able to be verified by means of newspapers, i.e. the press or scientific publications, legal publications such as the Gazette and other written media used by commercial enterprises or research institutes.

For oral disclosure, the principle of “the good faith of individuals” is applied in relation to precise dates. The means of proof are limited to evidence, physical means which show the product of the oral disclosure and bibliographical references which document its existence.

As regards material published on the Internet, no rules exist for verifying how old it is.

As stated, the effective date is that of “priority”.

### Brazil

Effective date with respect to “prior art” is the date of divulgation, except for a patent application deposited in Brazil that remains undisclosed, in which case “prior art” is to be considered as existent, for what concerns novelty, as from the date of the deposit or from a claimed priority date, as long as it is published, even if this takes place at a later moment.

Written disclosure must comply with the requirements mentioned earlier - certainty, sufficiency and availability to third parties.

This applies to oral disclosure as well.

Effective date with respect to “prior art” is the date of publication, except for a patent application deposited in Brazil that remains undisclosed, in which case “prior art” is to be considered as existent, for what concerns novelty, as from the date of the deposit or from a claimed priority date, as long as it is published, even if this takes place at a later moment.

### Bulgaria

Only written documents are considered before the Disputes Department of BPO but any other kind of evidence is taken into account before the court.

There are no specific standards about material published on-line.

The effective date is the publication date.

### Chad

- The required level of proof is that a written disclosure has been published on a certain date.
- The level of proof required is that an oral disclosure has been made before a certain date.
- The level of proof required is that information has been published on line.

- The date to be taken into consideration for a patent document is the filing date.

### China

The effective date for prior art is the date that the relevant technology is under the condition of public accessible, e.g. publication date. For a patent document, the effective date is the publication date.

### Colombia

- The determining factor is the validly claimed filing date or priority date, according to the case in question, of the application being examined.
- In any case, the right of evidence using the means of proof allowed by domestic legislation may be invoked.
- In a patent document, the effective date is the publication date.

### Congo

The official date of exhibition or publication by the media acts as proof in establishing the effective date of the prior art.

The burden of proof provided for in Annex II, Article 66, of the Agreement does not deal especially with this issue, but concerns only the infringement of the patent owner's rights.

For an OAPI patent, the date to be taken into consideration is the filing date.

### Croatia

For a patent documentation the effective date of prior art is the publication date, except for the patent applications as filed with effect in the Republic of Croatia; for those, the effective date is the date of filing in the Republic of Croatia.

### Czech Republic

The content of the published information as well as the time of its publication must be plausibly provable:

- printed materials (publications, magazines...) are considered as available to the public on the day they are put up for sale, in other cases (leaflets without dates, research reports ...) on the day they are accessible in a public library.
- no similar standards are worked out for oral and on-line information, in particular cases it is assessed whether the information is reliable also as regards its contents (for instance proceedings from a lecture).

As regards the patent document the decisive date is the date of publication of the invention contained in it. As regards the assessment of novelty the date of the patent application with effect in the Czech Republic has priority with respect to the inclusion into the prior art.

### Denmark

The assessment of evidence in the Danish administration and in the Danish courts is not bound by any formal requirement whatsoever. The courts and administrative bodies can thus freely evaluate any piece of evidence. Nothing definitive can therefore be said about the evaluation of pieces of evidence in patent disputes. In relation to patent documents the priority date is relevant for assessing novelty but not inventive step in later filed applications. The publication date is relevant for assessing inventive step in later filed applications.

### Egypt

The effective date is the published date.

### Eurasian Patent Office

The prior art must contain information on the date from which it became available to the public.

For printed editions, this date is the date of their publication and for deposited manuscripts, articles and so on — the date of their deposit.

For oral reports, lectures and speeches — the date of the report, lecture or speech fixed by sound recording apparatus or stenographically.

Copies of the information on a material carrier providing documentary evidence of the date on which these materials appeared by electronic information means.

For published specifications relating to documents providing protection - the date of publication indicated on them; and for published application specifications: the date of publication indicated on them.

### European Patent Office

A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. For instance, German utility models (“Gebrauchsmuster”) are already publicly available as of their date of entry in the Register of utility models (“Eintragungstag”), which precedes the date of announcement in the Patent Bulletin (“Bekanntmachung in Patentblatt”).

The European search report includes documentation relating to written or oral disclosures in which doubts with regard to public availability and the precise date of publication have not, or not fully, been removed. If the applicant provides sound reasons for doubting the public availability or assumed date of publication of a cited document and further investigation by the examiner does not produce evidence sufficient to remove that doubt, then the contested document is not considered as comprised in the state of the art.

The state of the art is made available to the public by *oral description* when facts are unconditionally brought to the knowledge of members of the public in the course of a conversation or a lecture or by means of radio, television or sound reproduction equipment (tapes and records) or any other means. In cases of oral descriptions, the following matters will have to be determined:

(i) when the oral description took place; (ii) what was described orally; and (iii) whether the oral description was made available to the public; this will also depend on the type of oral description (conversation, lecture) and on the place at which the description was given (public meeting, factory hall).

Likewise, when dealing with an allegation that an object or process has been used in such a way that is comprised in the state of the art (see answer to Q. 3), the following details will have to be determined:

(a) the date on which the alleged use occurred, i.e. whether there was any instance of use before the relevant date (prior use);

(b) what has been used, in order to determine the degree of similarity between the object used and the subject-matter of the European patent; and

(c) all the circumstances relating to the use, in order to determine whether and to what extent it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, the details of a demonstration of a manufacturing process in a factory or of the delivery and sale of a product may well provide information as regards the possibility of the subject matter having become available to the public.

Concerning the standards of evidence required to demonstrate that material was published on line, see answers to Q. 3 and Q. 5(iv).

In general, the effective date of a patent document as prior art is the date when the patent document was made available to the public, i.e. the publication date (see also answers to Q. 3-Q. 6).

Under European patent law, the state of the art also comprises the content of other European application (Conflicting applications) filed earlier than – but published under Art. 93 EPC on or after – the date of filing of the application under examination. This only applies to the extent that the earlier and later applications validly designate the same State or States (State of the art pursuant to Art. 54(3) and (4) EPC). Whether a published European application can be a conflicting application under Art. 54(3) and (4) is therefore determined firstly by its relevant filing date (i.e. filing or valid priority date) and the date of its publication; the former must be before the relevant filing date of the application under examination, the latter must be on or after that date. Such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step (see Art. 56 EPC).

### Fiji

In Fiji's case the effective date for prior art to be cited against a patent application would be when the provisional period of six months expires after which a patent then remains in effect for a period of fourteen years from the date of registration. This would be the case unless the specifications made during the application elaborate on whether any prior art was involved.

### Finland

The date of publishing noted on the publication are required.

The evidence given by the person in question.

Presentation of detailed written evidence of the action taken by the examiner. The examiner proves that he or she has seen and printed out the prior art material concerned.

For a patent document, the effective date is in most cases the publication date, in case of conflicting applications the priority date.

### France

It is the obligation of the person citing the nullity of a patent to provide proof of the lack of novelty. The prior art placed in opposition must be certain and the benefit of the doubt is given to the patent owner. For a written disclosure, the certainty of a date is easier to prove. According to the common law system as regards proof, this can be done by any means. It is within the sovereign judgement of the judges of the substance of a case to assess the evidential value of a document. If a written document is not dated, it can be dismissed from the discussions since it does not have sufficient evidential value.

There may be difficulties in determining the date of a written document. In a decision, the Paris Regional Court, examining a case concerning the lack of novelty of a patent, expressed an opinion on the evidential value of certain magazines. It dismissed from the discussions two magazines for which doubt existed in relation to the exact date on which they appeared. By contrast, the court recognized the evidential value of a third magazine for which it had been proven that it was accessible to the public before the patent application filing date: “whereas, by contrast, it is established that the October 1994 edition was published on October 15, 1994; that it had been received by the National Parliament Library on October 17, 1994, as is clear from the stamp appearing on one of the copies presented for discussion; and that its content was therefore made accessible from that date” (Paris Regional Court, April 25, 2001).

Similarly, in another decision the court dismissed from the discussions a catalogue which did not have any date and which, moreover, did not sufficiently disclose the invention (Paris Regional Court, March 20, 2002).

In similar vein, the Court of Cassation rejected an appeal against a decision of the Paris Court of Appeal which had dismissed certificates, the content and date of which was uncertain. It based its decision on the following grounds: “however, whereas after examining the certificates produced, the Court of Appeal discussed their value and observed *inter alia* that no written document contemporary to the alleged facts corroborates the content of the certificates; and noted also that the invention whose importance was accepted by all parties to the trial was not, prior to the filing of the disputed patent application, the subject of any measure designed to protect it, or of any scientific publication or use; the decision adds that nothing allows a certain date to be attached to the claimed disclosure and its actual existence is not proven. Whereas through these grounds the Court of Appeal gave its sovereign assessment on non-hypothetical grounds; it was not established that the invention had been the subject of a disclosure” (Court of Cassation, January 26, 1976, PIBD 169, III 198).

As regards proof of oral disclosures, the same rules of evidence apply. In practice, sometimes it will perhaps be much more difficult to provide proof of a certain date of an oral disclosure. However, an oral disclosure, proof of the certain date of which and of that of the content is provided, may readily be taken into consideration.

In a decision, the Paris Regional Court had to assess the evidential value of documents (articles and journals). These documents were dismissed from the discussions since the proof

of their date and certain content had not been provided. By contrast, the court granted evidential value to a work published after the filing date but which contained an oral communication made at a colloquium held prior to that date (Paris Regional Court, June 6, 1997, PIBD 1997 644 III 641). This decision was, however, revised by the Paris Court of Appeal which considered that proof of the certain content of the publication had not been provided. It provided that “there exists a doubt as to the identity between the content of the 1985 publication and that of the 1982 communication; the doubt should benefit the patent owner, since the burden of proof is placed on those who cite the disclosure (whereas the patent benefits from a presumption of validity and the patent owner could not be asked to provide negative proof of a non-disclosure)” (Paris Court of Appeal, May 28, 1999).

To the best of our knowledge, no case law exists in relation to the evidential value of information published on line in the field of patent law.

To the best of our knowledge, there is no case law which determines the date to be taken into account for a patent document but reference may be made to the case law of the appeal chambers of the EPO, which take into account the publication date of a patent document when assessing its content. However, the content of French patent applications, or European or international patent applications designating France, filed but not published on the filing date of the application being examined is included in the prior art.

### Georgia

The effective date for prior art is defined by all those data that have become commonly known on the basis of written or verbal descriptions, public use or other sources before the filing date of application for a patent, or if the Convention priority is claimed before the date of this priority (Art. 12.5 Patent Law).

For written disclosure - for printed editions from the date of signing in a seal if last is not specified - from the date of their issue, and in the absence of an opportunity of its establishment - the last day of month or on December, 31 the year specified in the edition, for deposited materials - from the date of deposit, scientific and technical reports and normative and technical materials - from the date of their registration in the organization, dissertations - from the date of reception by libraries, the visual information - from the date of its exhibiting.

For an oral disclosure - from the day it was disclosed orally if it is fixed on the equipment of sound record or stenography method.

For material published on line - from the date of accommodation of materials on line.

For a patent document - from the publication date.

### Germany

If the printed document bears a date of publication, its date can be established exactly. For undated publications and other prior art the date to be taken into consideration must be proved to the satisfaction of the office by other means (e.g. evidence by witnesses in combination with documentary evidence). For Internet documents see Q5.

In case of patent documents, the priority date or the date of filing, as the case may be, must be taken into consideration in novelty examination, or the date of publication be considered in examination of the inventive step.

### Ghana

The importance its influence has on the community or the company when the art is being pirated.

The standard of evidence should be a certificate, or an identification like a “trade mark”.

In fact, there is no evidence required but voice recording could be considered.

Evidence from the host or the web page designer or the service provider for the said institution, or who ever introduced the prior art. In fact, the institution has to document it through legal means to make it evident.

For a patent document, the effective date should be the priority date.

### Ireland

The national law on prior art corresponds to Article 54 (2) of EPC. Generally speaking, the Irish Patent Office follows the EPO guidelines and jurisprudence.

### Italy

For a patent document, the filing date determines the effective date for prior art to be cited against a patent application (we are speaking about prior art relevant to novelty).

### Japan

Our examination guidelines stipulates as follows:

1. When the time of publication is indicated in a publication, it is presumed as follows:
  - (i) in the case where only the year of a publication is indicated, the last day of that year; in the case where a month and a year of a publication is indicated, the last day of the month of the year; and
  - (ii) in the case where a day, a month and a year of a publication is indicated, that date.
2. In the case where the date of publication is not indicated in a publication:
  - (i) The distribution date of a foreign publication is presumed in the light of the period normally required to reach Japan from the country of the publication, as far as the date of its receipt in Japan is clear;
  - (ii) in the case where there is a derivative publication such as a book review, an extraction or a catalog, the date of distribution of the publication in question is presumed based on the publication date of the derivative publication;
  - (iii) in the case where there is a second edition or a second print of the publication, the date of distribution is presumed to be the publication date of the first edition indicated therein;
  - (iv) in the case where other appropriate information is available, the date of distribution is presumed or estimated therefrom.

There is no specific standard of evidence required to demonstrate that an oral disclosure was made on or by a certain date.



Regarding the standards of evidence proof required to demonstrate that material was published on-line, our examination guidelines stipulates as follows:

The question of whether or not the information was made available before the filing of the application is judged based on the time of publication indicated in the cited electronic technical information. Therefore, electronic technical information without an indication of the time of publication cannot be cited, in principle.

For a patent document, the effective date is the priority date.

### Kenya

In Kenya, for prior art to be cited against a patent application its publication date must be at a date earlier than the filing date of the patent application and if priority is claimed, at a date earlier than the validly claimed priority date. The publication has to bear enough information as to be able to establish the publication date and place of publication. For oral disclosure, evidence of the activity or activities, the date and venue of disclosure will suffice to demonstrate that the oral disclosure took place.

### Republic of Korea

Whenever the date of publication is indicated in a publication, we determine the effective date for prior art to be cited against a patent application as follows:

- When only the year of a publication is indicated, the last day of that year.
- When only a month and year of a publication are indicated, the last day of the month in that year.
- When a day, month and year of publication are indicated, that date.

When the date of publication is not indicated in a publication, we determine the distribution date as follows:

- For a foreign publication, the distribution date is based on the time the publication would normally take to reach Korea from the country of publication, provided the date of receipt in Korea is clear.
- For a derivative publication, such as a book review, an extraction or a catalog, the distribution date is based on the publication date of the derivative publication.
- For a second edition or a second print of the publication, the date of distribution is the publication date indicated in the first edition. However, if the second edition or the second print has any new or modified contents, the contents of the cited part must be the same as the contents of the second edition or second print of the publication.
- For other appropriate information, the date of distribution is based on a presumption or estimation.

When the date of disclosure of prior art can be determined through electronic telecommunication lines, as prescribed in Article 1bis of the Enforcement Ordinance of the Patent Act, we determine the date of disclosure as follows:

- Without a special validating formality, the date of invention is considered the effective date of disclosure. A person who contends the date should prove that the date of disclosure cannot be determined.
- The date of disclosure through electronic means refers to the date on which a related technique is published electronically.

When the date of disclosure for prior art cannot be determined through electronic telecommunication lines, as prescribed in Article 1bis of the Enforcement Ordinance of the Patent Act, we determine the date of disclosure as follows: an examiner should use prior art after making clear by additional examination that the prior art was disclosed before the priority date of the application.

According to WIPO Standard 14, in the examination process an examiner who cites art that has been disclosed through electronic telecommunication lines should state details of the art such as the author's name, the title, the name of the publication, the page of the cited art (or picture, chart and so on), and the disclosure date.

For a patent document, the effective date is the publication date when it can be made available to the public in relation to novelty and inventive step, and the priority date in relation to an earlier application and the prior art effect of certain application.

#### Lithuania

For a patent document, the effective date is the filing date if this document was published.

#### Malaysia

There is no standard evidence, based on publication document with the publication date.

There is no standard evidence, based on the knowledge of the examiner at the time of examining the application.

There is no standard of evidence proof required to demonstrate that material was published on-line.

For a patent document, the effective date is the publication date.

#### Mauritius

Establishing the effective date of prior art. The filing date or where applicable, the priority date of the application determines the effective date. No standards of evidence have been established yet.

#### Mexico

In accordance with Article 17 of the Industrial Property Law, the prior art shall be considered on the patent application filing date or, where appropriate, the recognized priority date, and the prior art will also include all the patent applications filed in Mexico prior to that date, which are being processed, although those applications are published in the Industrial Property Gazette at a later date, as well as those patent and utility model registration applications being processed, filed with the Institute at a time and on a date prior to those subject to substantive examination.

- Any proof providing evidence of publication is considered.
- Any proof referring to a particular oral disclosure is considered.
- Any proof containing evidence of publication is considered.
- The publication date of a patent document is the relevant date for establishing what the prior art contains in relation to an application being examined.

#### Republic of Moldova

The effective date is understood to be the publication date in the case of previously published document or the date on which the information had been made available to the public in another way (e.g. by display at a public exhibition or by an oral disclosure).

The effective date determines the date on which the information had been made available to the public, even if the written description reproducing such information was published after the priority date of the application.

*For a written disclosure* the evidence is always the publication date. Where the exact date cannot be established it is applied the following provision: if the date is not specified, it is presumed that the publication had been made on the last day of the month; if it is not specified the month it is presumed that the publication had been made on the last month of the year.

For written disclosure it is considered that they had been made available to the public from the following date (Rule 67.2 of the Regulations):

- Patent documents, from the date of publication thereof.
- Manuscripts of articles, monographs, reviews and other materials, from the date of the public accessibility, provided that the date is identifiable.
- Reports of research, explanatory notes to experimental work and other documents which are in a competent body for scientific and technical information, from the date of reception thereof in this body.
- Standards and other technical prescriptions, from the date of registration thereof in the authorized bodies.
- Documents and author's reports of thesis of doctor degree issued as manuscripts, from the date of receipt in the library.
- Papers submitted to competition, from the date of public exposure thereof, confirmed by documents relating to the competition.
- Sources of visual information (posters, drawings, schema, pictures, models, articles etc.), from the date of display thereof, confirmed by official documents.

#### *For oral disclosure:*

- Reports, lectures, oral presentations, from the date of public presentation thereof, provided that they are fixed by devices of sound record or stenography adequately to requirements having the effect on the specified date.

- communications by means of radio, TV, cinema, etc., from the date of such communication if it was recorded on the corresponding information carrier adequately to requirements having the effect on the specified date.

Where the document reproducing an oral disclosure which have been made available to the public before the priority date of the application but was published on or after that date, it will be considered as destroying the novelty, because it will be presumed that the document gives a true account of the earlier oral disclosure, with the exception of proof of contrary.

*For on-line publications:* The printed material with the specification of the website and the date of printing. See also Q. 5 (iv).

*For a patent document* the effective date is the publication date for previously published documents and the filing date (or priority date, where appropriate) for patent document filed before with the office but published after the filing date of application being examined.

### Norway

A specification of the publication date on the disclosure or eventually the date of the printout from the Internet or a database.

The examiner can use oral disclosures as prior art from the date of the oral disclosure, but if the applicant has evidence that gives grounds for reasonable doubts about the date or the subject matter, the examiner should not pursue the matter further.

For patent applications and patents not filed in Norway the effective date as prior art is the date of publication. For patent applications filed in Norway, but not published before the filing date of the application under examination, the effective date is the priority date/filing date (but only for assessment of novelty).

### Panama

The effective date of prior art is established one day before the patent application date in Panama or the claimed priority date, as appropriate.

In order to demonstrate that a written disclosure is public on a certain date or before a certain date, it is necessary to consult a document (original or copy) where the exact publication date of said publication is shown.

As proof of an oral disclosure a written document supporting the date of such disclosure is required.

### The Philippines

The date of publication. A patent document forms part of the prior art on the date it was published.

### Poland

The date of the publication of information on relevant occurrence is the date which specifies prior art.

There are no specific standards defining requirements regarding publication. Nevertheless such information must be placed in a commonly accessible place.

There are no specific standards concerning oral disclosure.

There are no specific standards concerning on-line publication.

The date of publication while assessing the non-obviousness, and the priority date while assessing the novelty is deemed to be the entry date to prior art for applications claiming priority.

#### Portugal

The standards of evidence required to demonstrate that a written disclosure was published on or by a certain date are recognized institutions or any guaranty that the date cannot be changed or faked.

Written support (e.g. abstracts) or personal testimonies are required to demonstrate that an oral disclosure was made at a certain date and that material was published on-line.

For a patent document the effective date is the publication date. However, national patent applications filed before the priority date of a patent application may constitute prior art even if they are not already published. In this case the priority date is the one which is effective for the evaluation of novelty.

The date taken into account for opposing a document of the prior art is the filing date of the patent application to be examined or the date of recognized priority of said application.

In the substantive examination, the accepted standard of evidence comprises documents containing and proving the date when the information has become available to the public.

#### The Russian Federation

The date for determining the inclusion of an information source in prior art is as follows:

- For domestic printed editions and USSR printed editions — the date of signature for printing indicated thereon.
- For domestic printed editions and USSR printed editions on which the date of signature for printing is not indicated, and also for other printed editions — the date of their publication and, where this cannot be established, the last day of the month or December 31 of the year indicated in the publication, where the time of publication is determined accordingly only by the month or year.
- For deposited manuscripts of articles, reviews, monographs and other materials — the date of their deposit;
- For reports on scientific research work, explanatory notes on developmental work and other design, technological and project documentation held by scientific and technical information bodies — the date of their receipt by these bodies.
- For standard-setting technical documentation — the date of its registration with the relevant authorized body.
- For dissertation materials and authors' abstracts of dissertations published in manuscript form — the date of their acquisition by libraries.
- For works accepted for competitions — the date of their submission for consultation, confirmed by documents relating to the conduct of the competition.
- For oral reports, lectures and speeches — the date of the report, lecture or speech, where they are fixed by sound recording apparatus or stenographically in accordance with the procedure established by the rules in force on the date in question for the conduct of the corresponding events.

- For radio, television and cinema broadcasts — the date of such broadcast, where this is fixed on an appropriate information carrier in accordance with the established procedure in force on the date in question.
- For information obtained in electronic form — through the Internet, online access separate from the Internet, CD and DVD-ROM — either the date of publication of the documents made available by means of the electronic medium in question, where the date is displayed thereon or, where this date is missing, the date on which the information is stored in the electronic medium, provided that it is supported by documentary evidence.
- For published patent documents — the date of publication indicated thereon and for unpublished patent documents (for the determination of compliance with the criterion of novelty) — the priority date (filing date).

### Senegal

The patent application filing date or priority date determines the date to be taken into consideration.

An oral disclosure cannot have a priority date since, up to the present time, oral works have not been protected. There is no law or similar text, either within the OAPI or WIPO, to protect oral works. It is the priority date of a written filing which gives an invention its validity.

### Singapore

Section 14 (2) of the Patents Act is referred to as it explains that: The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has *at any time before the priority date of that invention* been made available to the public (whether in Singapore or elsewhere) by written or oral description, by use or in any other way.

### Sweden

Normally, the publication date provided by the publisher, or the like, is accepted unless it is called into question. Regarding orally disclosed information, normally later published abstracts of what was initially orally disclosed are put forward by the patent office. However, in court other evidence may be used to verify what has been made available orally. For a patent document that is detrimental to novelty and which may have legal effect in Sweden, i.e. a national application or an international or European application designating Sweden, the effective date is the priority or filing date.<sup>22</sup>

### Thailand

The subject matter of invention which is written disclosure was published on or by a certain date before the filing date.

The subject matter of invention which is oral disclosure was published on or by a certain date before the filing date (such as report, paper).

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<sup>22</sup> Guidelines of Swedish Patent and Registration Office RL VII - 3.2

The subject matter of invention was published on-line before the filing date.

The publication date (before the filing date) is the effective date.

### Tonga

Not applicable.

### Trinidad and Tobago

Trinidad and Tobago patent law does not specify conditions to establish the effective date of prior art other than what can be construed under “made available to the public (in Trinidad and Tobago or anywhere else) by written or oral description or use or in any other way”. This will include Internet and electronic publication, historical data and oral traditions. This would assume that the information emerged from under a secret, embargo or from within a closed circle of collaborators.

### Turkey

The publication date determines the effective date for prior art to be cited against a patent application. In addition, our Decree Law specifies “Patent and Utility model applications filed in Turkey prior art the date of filing of the application for patent and published on or after that date are considered to be comprised in the state of the art as of their first disclosed contents/texts.”

### Ukraine

The provision of a copy (photocopy) of a document bearing the date from which the information contained in the document became publicly available:

- For printed editions – the date of publication;
- for standard-setting and technical documentation – the date of registration with the authorized body;
- for deposited documents – the date of their deposit;
- for scientific research, technological, design and project-related documentation – the date of its receipt by scientific and technical information bodies;
- for dissertation-related documents – the date of their library acquisition;
- for works submitted for competitions – the date when they were made available for consultation, confirmed by documentary evidence relating to the competition;
- for oral reports, lectures, speeches and the like – the date, confirmed by documentary evidence, of the report, lecture or speech, if they are fixed by sound recording means or stenographically, in accordance with the established procedure valid on the date in question;
- for communications by radio, television and in the cinema – the date, confirmed by documentary evidence, of such communication, if it is fixed on the appropriate information carrier, in accordance with the established procedure valid on the date in question;

No provision is made to prove that material was published on-line.

The date which determines whether a patent document is included in prior art is its date of publication.

#### Venezuela

The prior art is determined in accordance with whether the filing or priority date is before the filing date of the patent application being examined.

In order to demonstrate that a written disclosure was published on or by a certain date, it is sufficient to compare dates between the application and the date of the published information.

In order to demonstrate that an oral disclosure was made on or by a certain date, any document or recording with the corresponding information is sufficient and the nature of the certifying document is of no importance.

In order to demonstrate that material was published online, any document or recording with the corresponding information is sufficient and the nature of the certifying document is of no importance.

For a patent document, the filing date is the effective date unless priority has been claimed.

#### Viet Nam

If the publication date of an information source, which has the nearest technical nature to the technical solution described in the invention/utility solution application, is prior to the priority date of that application, that date shall be considered as effective date of prior art. This requirement is described in detail in Article 4.1 Decree 63/CP.

Before the priority date of an invention/utility solution application, the technical solution described in the application has not been publicity disclosed domestically and/or abroad by way of the use or description in any of the information sources listed below to the extent that, based on that disclosure, a person with average skill in the art would be able to carry out such a technical solution:

- sources related to inventions/utility solutions abroad, as of the publication date;
- other sources with any information carrier (printed matters, film, magnetic tape, magnetic disc, optical disc etc.) as of the date the information carrier has first been circulated;
- mass media sources (radio, broadcasting, television), as of the publication date;
- scientific reports, lectures etc., if recorded by any means, as of the date of report or lecture;
- exhibitions, as of the date the exhibit have first been presented.

Information shall not be deemed publicity disclosed if only a limited number of related persons are aware of such information.

With respect to patent information, the publication date is considered as the effective date.



## Q7. CONTINUITY OF PUBLICATION

Does material have to be continuously available to be relevant as prior art, or does it remain valid even if it has been withdrawn from circulation or made inaccessible to the public for a certain period?

- Does a published disclosure have to be continuously publicly available to be counted as prior art?
- Does material published on the Internet or other publication have to be demonstrated to be continuously available to be counted as prior art?

### Argentina

As established for Q5, the disclosure will be valid insofar as it is accessible (verifiable), sufficient and clear, and has a particular date at the time the search and substantive examination are conducted; in the case of the Internet, said publication must, in addition, belong to a public institution.

### Armenia

Any material has to be continuously available to be relevant as prior art.

### Australia

Provided material has been made publicly available at some point in time it forms part of the prior art. Therefore provided the relevant material was publicly available at some point before the priority date, it forms part of the prior art base even if it has subsequently been withdrawn from circulation, made inaccessible to the public for a certain period, or not been continuously available.

Material on the Internet does not have to be continuously available to be part of the prior art.

However, determination of the publication date of Internet material can be difficult at times.

### Austria

Information remains valid even after it has been withdrawn from circulation.

- Either printed publications.
- Or online publications.

### Azerbaijan

To be relevant as prior art, material remain valid even if it has been withdrawn from circulation or made inaccessible to the public for a certain period, if it proves to be true from other sources.

A published disclosure does not have to be continuously publicly available to be counted as prior art, in view of the answer to the previous question.

Material published on the Internet or other publication have to be demonstrated to be continuously available to be counted as prior art, and thus contain, at least bibliographic data on the official publication according to which it would be possible to familiarize with the document outside of the Internet.

#### Bangladesh

No specific established standard is available in this respect, but only supplied published documents are considered.

#### Bolivia

The only requirement is that the information has been published once, although it may also have been withdrawn from public circulation.

#### Brazil

There is no need for the material to remain continuously available to be relevant as prior art, if its disclosure has complied with the requirements of certainty and sufficiency.

A published disclosure does not have to be continuously publicly available to be counted as prior art.

Material published on the Internet or other publication do not have to be demonstrated to be continuously available to be counted as prior art.

#### Bulgaria

There has not been any specific regulation about this matter and the patent practice depends on legal standards.

#### Chad

The information must be continuously available to the public in order to be considered part of the prior art.

#### China

Material does not have to be continuously available to be relevant as prior art, it remains valid even if it has been withdrawn from circulation or made inaccessible to the public for a certain period.

#### Colombia

It is not necessary for material to be continuously published to be relevant as prior art, its validity remains even in the case where it has been withdrawn from circulation.

Disclosure must not necessarily be published continuously and available to the public in order to be considered part of the prior art.

It is not necessary to demonstrate that material published on the Internet or by another means is always available for it to be considered prior art.

Congo

In order to establish the prior art, the information must, in our opinion, be available and accessible by any means.

The availability of the information is the proof of its existence.

Accessibility is possible through the means provided for its compilation, preservation and dissemination. If there is no availability and accessibility, there is no prior art.

Czech Republic

Inclusion into the prior art does not require continuity of material publication. This applies to any way of publication, namely both to printed materials and to publications on the Internet.

The contents of the application with the former priority right is the prior art and it is also the case if the patent is not granted (on condition of its publication).

Denmark

No demand of continuity of publication exists in Danish law.

Egypt

A published disclosure has to be continuously published to be counted as prior art.

Material published on the Internet or other publication also has to be demonstrated to be continuously available to be counted as prior art.

Eurasian Patent Office

A published disclosure does not have to be continuously publicly available to be counted as prior art. If information was publicly available prior to the filing (priority) date of an application for a specific period of time, the periodic nature of its availability or the fact that it is withdrawn from circulation subsequently are of no importance in terms of the possibility of including this information in prior art.

This also relates to the information obtained using electronic means.

European Patent Office

A published disclosure does not have to be continuously publicly available to be counted as prior art where it is considered as having being made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application (see Art. 54 (1) and (2) EPC) (see answers to Q.3 - Q.6).

Material published on the Internet does not have to be demonstrated to be continuously available to be counted as prior art where it is considered as having being made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application (see Art. 54 (1) and (2) EPC) (see answers to Q.3 - Q.6).

Fiji

As mentioned earlier the life of a patent is 14 years from the date of registration and once this period lapses an application may be made to have this period extended. Moreover, in Fiji's case there is no need for the material to be continuously available to be relevant for prior art as in most cases it is unwritten and could be used on a seasonal basis from time to time. The fact that prior art becomes dormant for a while and resurfaces does not mean that it becomes irrelevant.

Finland

A published disclosure does not have to be continuously publicly available to be counted as prior art; it must, however, be possible to show that the disclosure has been available to the public, for example at a public fair.

Material published on the Internet or other publication does not have to be demonstrated to be continuously available to be counted as prior art; as above, it must, however, be possible to show that the publication has been publicly available.

France

We do not have any case law on this subject.

Georgia

It is sufficient to have the fact of the publication.

It is sufficient to have the fact of the demonstration on the Internet or other publication.

Germany

It is not necessary that the disclosure is continuously available to the public. The possibility for an unlimited circle of people of gaining access to the information at a proven date is sufficient. This fact must be provable by evidence. A document with an identifiable date of issue which has been printed out from the Internet will forever form part of the state of the art. Evidence by witnesses allows to later prove the existence of the information although the Internet page does no longer exist.

Ghana

Yes, it sometimes has great impact even if it has been withdrawn from circulation.

– Yes, a published disclosure should be continuously available to be counted as prior art, so that its influence would still be relevant.

– Yes, it must also still be available on the Internet, but for continuous upgrade and changes for prior art to be counted.

Iceland

There are no established rules on this.

Ireland

The national law on prior art corresponds to Article 54 (2) of EPC. Generally speaking, the Irish Patent Office follows the EPO guidelines and jurisprudence.

Japan

Any material which has/had been made publicly available for a certain period of time to unspecified persons can be used as a prior art.

Kenya

The material does not have to be continuously available provided there is enough evidence to indicate that at a certain point in time the material was available and accessible to the public.

Republic of Korea

It is sufficient that original material be disclosed only once and that it be initially available to the public. It is not necessary that the original material be reproduced in abundance to satisfy public demand or that it be constantly available to the general public.

Therefore, once the material has been made available to the public, there is no other requirement. It is not necessary for this state to be kept up.

Lithuania

There are no definitions.

Malaysia

A published disclosure does not have to be continuously publicly available to be counted as prior art.

Material published on the Internet or other publication do not have to be demonstrated to be continuously available to be counted as prior art.

Mauritius

See answer to Q. 3.

Mexico

Material must be continuously available to be relevant as prior art.

A published disclosure does not have to be continuously publicly available to be counted as prior art.

Material published on the Internet or other publication do not have to be demonstrated to be continuously available to be counted as prior art.

Republic of Moldova

Once published and therefore having been made available to the public such material remain to be relevant as prior art, even if it has been subsequently withdrawn from circulation or made inaccessible to the public for a certain period.

For the material published on the Internet, the question about how long should such material be available on the Internet to be considered relevant as prior art is under discussion. There is no problem for material for which it can be demonstrated that it is continuously available on the Internet, the problem arise *in absentia* of such evidence. This is a question that needs to be discussed.

#### Norway

A published disclosure does not have to be continuously publicly available to be counted as prior art. A published disclosure is part of prior art if the disclosure has been available to the public in a period of time sufficient to give the public at least a theoretical possibility for access.

Material published on the Internet or other publication do not have to be demonstrated to be continuously available to be counted as prior art. Information on the Internet is part of prior art if the information has been available to the public in a period of time sufficient to give the public at least a theoretical possibility for a direct and free access.

#### Panama

A published disclosure does not have to be continuously publicly available to be counted as prior art.

Material published on the Internet or other publication do not have to be demonstrated to be continuously available to be counted as prior art.

#### The Philippines

Our patent law does not mention that prior art material must be continuously available.

#### Poland

Material continuously available as prior art stays as prior art even when it is crossed later on, but it is not deemed to be prior art when it is not available to the public.

A published disclosure, to be counted as prior art, has to be continuously publicly available (potentially).

Documentation published on the Internet, to be counted as prior art, must be potentially available.

#### Portugal

A published disclosure does not have to be continuously publicly available to be counted as prior art.

Material published on the Internet or other publication do not have to be demonstrated to be continuously available to be counted as prior art.

#### Romania

A published disclosure does not have to be continuously publicly available to be counted as prior art.

Material published on the Internet or other publication do not have to be demonstrated to be continuously available to be counted as prior art. The information must have been recorded on a physical carrier wherefrom the relevant date results.

#### The Russian Federation

It is sufficient to prove that information was publicly available prior to the application filing (priority) date. The continuity of its availability has no meaning in relation to its inclusion in the prior art.

#### Senegal

A patent application may be published under cover of the priority date. The publication allows verification of whether the invention is claimed elsewhere or brought into question in relation to its priority. In no way does the grant of a patent overshadow its publication at the international level. Annual fees over a 20-year period protect the patent before it enters the public domain. Thus, African countries could, for example, without requesting authorization manufacture certain cars belonging to the company Peugeot, for which the patents would have entered the public domain.

#### Singapore

It is open to judicial interpretation as to whether such publication falls within the ambit of section 14 of Patents Act.

#### Sweden

There is no demand for continuous publication of the prior art, it is enough to show that the information has been available. In practice, the patent office will in its normal procedure retrieve documents that are available at the time of the search. A publication no longer available is usually provided at a later stage, such as during an opposition procedure or action for invalidation.

#### Thailand

Yes, it should be continuously published even if it has been withdrawn, it can be counted as prior art.

#### Tonga

Not specifically stated.

#### Trinidad and Tobago

Trinidad and Tobago Patent law does not specify conditions for continuity of publication of prior art other than what can be construed under “made available to the public (in Trinidad and Tobago or anywhere else) by written or oral description or use or in any other way”. There are no provisions invalidating static publications, historical evidence and out-of-print prior art. Prior art needs to be available at least once to the public.

Turkey

A published disclosure has to be continuously publicly available to be counted as prior art. Material published on the Internet or other publication have to be demonstrated to be continuously available to be counted as prior art.

Ukraine

Legislation does not provide for the need to take account of the period of accessibility of information in relation to its possible inclusion in prior art.

Venezuela

Material does not have to be continuously available to be relevant as prior art.

A published disclosure has to be disclosed irrespective of whether it is accessible to the public.

Material published on the Internet or other publication do not have to be demonstrated to be continuously available to be counted as prior art.

Viet Nam

In Viet Nam, there is no specific provision on continuity of publication using as prior art.



**Q8. SPECIFIC DECISIONS OR GUIDELINES.**

In your jurisdiction, have there been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty? If so, please give details.

**Argentina**

To date, no specific judicial or administrative decision has been taken in which TK or genetic resources are considered to be prior art for the determination of novelty, nor in which professionals working in the sphere of TK are considered to be persons skilled in the art.

**Armenia**

Our jurisdiction hasn't any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources.

**Australia**

There are no examination guidelines specific to TK or genetic resources.

There have been no judicial decisions in Australia which considered the relevance of TK or genetic resources as prior art. However, TK was potential prior art in two administrative decisions issued by the Australian Patent Office — *Vincent Joseph Collins and Maryann Collins v William Robert McGilvray* [2002] APO 23 (see Annex 1) and *Frank D'Amelio and Graeme A. Close v Australian All Natural Pty Ltd* [2003] APO 25 (see Annex 2). The first application concerned a method for producing a blue colored oil from a mixture of the bark and wood from the Australian native Northern Cypress Pine, (*Callitris intratropica*). The second application involved a topical composition comprising an aqueous alcoholic extract from the plant *Centipeda cunninghamii* (commonly known as old man weed).

While both administrative decisions actually relied on conventionally published documents for the purposes of novelty and inventive step, TK was clearly important background prior art. In the first decision, one of the documents in the former case referring to the traditional use of the bark resins of the native pine by the native Tiwi people of Northern Australia. In the second decision, the specification itself acknowledged the traditional medicinal use of old man weed. Note that both applications were found to be novel and inventive in light of the prior art provided at the hearing.

**Austrā**

There are no judicial or administrative decisions relating to examination, which refer specifically to the consideration of TK or genetic resources in the prior art. Examination guidelines, which refer specifically to the consideration of genetic resources and biotechnology in the prior art, are currently being drawn up.

Azerbaijan

In our jurisdiction, there have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty.

Bangladesh

There is no specific established standard and guideline in this respect.

Bolivia

In Bolivia, the rules in force do not allude specifically to this subject. Nor has there been a specific judicial or administrative decision which has established guidelines.

Brazil

There are no specific administrative guidelines concerning TK and genetic resources as prior art under INPI procedures.

Bulgaria

No, there have not been any specific juridical or administrative decisions that refer to the status of TK or genetic resources as prior art.

China

No, but it is under consideration.

Colombia

No specific judicial or administrative decision or guideline exists in this area. However, Article 3 of Decision 486 states that: “the Member Countries shall ensure that the protection granted for industrial property subject matter shall safeguard and respect their biological and genetic heritage, as well as the TK of their Afro-American or local indigenous communities. In that connection, the grant of patents for inventions developed from material forming part of said heritage or said knowledge shall be subject to the material having been acquired in accordance with international, community and national legislation”. Similarly, it provides that: “the Member Countries shall recognize the right and capacity to make decisions on the part of the indigenous, Afro-American or local communities regarding their collective knowledge”.

For its part, Article 29 specifies that “where the invention refers to a product or a procedure relating to a biological material and the invention cannot be described so as to be understood and carried out by a person skilled in the art, the description shall be complemented by a deposit of said material”. Likewise, the standard provides that: “the deposit of the biological material shall be valid only for the purposes of granting a patent, where this is done in conditions allowing any interested party to obtain samples of said material, at the latest following the expiry date of the period provided for in Article 40”.

Congo

No information on a court decision relating to this matter is known.

Croatia

There have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty.

Czech Republic

We do not have any.

Denmark

No such decisions exist.

Egypt

Yes, Article (13) of the Law on the Protection of Intellectual Property Rights, No. 82/2002.

Eurasian Patent Office

No, there have been no such decisions or guidelines.

European Patent Office

As of September 2004, there have been neither case law by the boards of appeal nor examination guidelines pertaining specifically to the status of TK or GR as prior art. These issues are thus far being treated under the general provisions relating to prior art. For first instance decisions see answers to Q 20.

Fiji

There have been no cases in Fiji as yet, however, given the utilization of TK and genetic resources as a means of stirring commercial development Fiji should expect a hive of activity in this area in future.

Finland

There have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty.

France

To the best of our knowledge, no.

Georgia

There have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty.

Germany

If it is found during examination that the claimed subject matter of a patent application is based on TK, that application is treated in the same way as all other patent applications. Methods for the treatment (of an illness) are excluded from patentability under Section 5 (2), first sentence, Patent Law. However, products for use in any of these methods are patentable (Sec. 5(2), second sentence, Patent Law). Usually, there are no particular difficulties with regard to the examination. The DPMA has great experience particularly in the field concerning the use of plants or plant products for the treatment of the human or animal body. The DPMA possesses a comprehensive collection of scientific works regarding the traditional use of medicinal plants in all of the world's continents.

Ghana

Yes, in Ghana, reform for institutional change has brought the attention for TK or genetic resource as prior art for the determination of novelty. This has brought the change by traditional leaders to team their society through education for TK to be protected.

Iceland

No.

Ireland

The national law on prior art corresponds to Article 54 (2) of EPC. Generally speaking, the Irish Patent Office follows the EPO guidelines and jurisprudence.

Japan

No. There have not been any.

Kenya

As yet there have not been any judicial or administrative decisions that refer to the status of TK or genetic resources as prior art for the determination of novelty. Plans are underway to develop examination guidelines that hopefully will address this question.

Republic of Korea

There are no specific judicial or administrative decisions. However, regarding novelty, we examine related inventions according to the examination guidelines of each industrial field (pharmaceuticals, food, and biotechnology).

Novelty is not acknowledged if previously known TK or the use of genetic resources is described without any modification or is simply modified without any technical invention.

Novelty is acknowledged if the application relates to a new usage of known TK or genetic resources. However, it is not novel if the assessed new usage is novel only in expression but is substantially the same as the usage of known TK or genetic resources, or is based on an affinitive performing system.

Lithuania

No legislation.

Malaysia

There have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty.

Mauritius

There are no guidelines that refer to the status of TK or genetic resources as prior art for the determination of novelty.

Mexico

No, to date there have been no relevant specific judicial or administrative decisions.

Republic of Moldova

There are no provisions.

Norway

No. TK is, however, part of prior art.

Panama

Yes. Article 8(j) of the Convention on Biological Diversity, to which Panama has acceded, Law No. 20 of June 26, 2000 and Executive Decree No. 117 of May 9, 2003.

The Philippines

There are no decisions or guidelines.

Poland

There are no special administrative regulations in Poland referring to Traditional Knowledge and genetic resources (TK). Furthermore there are no relevant guidelines regarding the status of TK.

The only statutory regulation relates to the implementation of Biotechnological Directive of the European Union into the Polish Industrial Property Law (PIPL).

Furthermore, with respect to PIPL, patents shall not be granted for scientific invention, plant or animal varieties or pure biological processes of plants or animals production.

A kind of clue, while examining applications within the scope of TK, might be Article 77 §1 of the Code of the Administrative Procedure, under which “facts which are commonly known [...] do not need to be proven”. Therefore when the application concerns the solution which is commonly known, it is possible to refer to this Article with respect to Article 252 PIPL, which refers to relationships between both acts.

Portugal

There are no established decisions or guidelines for those issues. They have been dealt like any other information for the purposes of determination of novelty.

Romania

Concerning the presentation of the prior art considered as useful for the understanding, the search and examination of the claimed invention, the Implementing Regulations of the patent law state the following: “when the prior art also comprises traditional knowledge, the description of the invention shall comprise explicit indications concerning it, including its source, if known”.

The Russian Federation

No such decisions or guidelines exist.

Senegal

In Senegal, no.

Singapore

There have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty.

Spain

No answer.

Sweden

There are no specific decisions or guidelines relevant particularly to TK.

Thailand

We do not have Guidelines for TK and GR.

Tonga

Not applicable.

Trinidad and Tobago

No specific judicial or administrative decisions or examination guidelines referring to genetic resources and TK as prior art in determining novelty

Turkey

There have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty.

Ukraine

There are no such decisions or guidelines.

Venezuela

There have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK or genetic resources as prior art for the determination of novelty.

Viet Nam

In Viet Nam, there are no specific legal provisions or examination guidelines that refer to TK or genetic resource applications. However, the substantive examination (novelty, inventive step, and industrial applicability), which is conducted to this kind of application, shall be the same methods conducted to other kinds of invention/utility solution application.

**Q9. PRIOR ART BASE FOR NON-OBVIOUSNESS.**

Please describe in general terms the prior art that may be taken into account when determining whether an invention is non-obvious (or involves an inventive step).

In what respects does it differ from the standard that applies to prior art for the assessment of novelty (with reference to the issues raised in questions 3 to 6)?

**Argentina**

Part C, Chapter IV, Para. 7.1 (DP) – It should be noted that in the analysis of novelty (contrary to inventive step), separate prior art documents should not be combined. However, if a (primary) document refers explicitly to another document in order to provide more detailed information on certain aspects, the disclosure of the latter may be considered to be incorporated in the document containing the reference, insofar as the cited document is available to the public on the publication date of the document containing the reference.

**Armenia**

In our jurisdiction the state of the art for the purposes considering inventive step does not include Armenian applications, which are published after the expiry of a period of two months from the date of filing.

**Australia**

Prior art is information that is available in a document that has been published anywhere in the world or that is made available publicly by doing an act anywhere in the world before the priority date of the patent application.

The prior art base for inventive step assessments includes patent documents that are published on or before the priority date of the patent application in question.

For the purposes of assessing inventive step, the prior art base *does not* include Australian patent documents with a priority date before the priority date of the patent application in question but a publication date after the priority date of the patent application in question that is, whole of contents citations. Consequently, the prior art for inventive step assessments is slightly smaller than that for novelty as whole of contents citations are not considered.

For applications filed on or after 1 April 2002, for inventive step it is permissible to consider any two or more pieces of prior art information that the person skilled in the relevant art in Australia could be reasonably expected to have combined (in contrast to novelty where pieces of prior art information can only be combined if the person skilled in the relevant art would treat them as a single source of information).

Inventive step objections may also be based on common general knowledge considered separately or together with information from the prior art base.

**Austria**

If all the features of the first claim or of an independent claim are contained in a single written document or in a single disclosure, the invention is considered not to be novel.



If all the features of the first claim or an independent claim are contained in two different documents or two different disclosures, the invention is considered to be novel but not to involve an inventive step.

If more than two different documents or disclosures are necessary to show all the features of an independent claim, this claim is considered to be novel and to involve an inventive step.

#### Azerbaijan

The invention is non-obvious if for the expert it is evident that it does not follow from the state of the art.

#### Bangladesh

- (i) Publicly used or publicly known in Bangladesh;
- (ii) prior publication i.e. printing, writing or publishing of some documents to which the public has access, would also prejudice the novelty of the invention;
- (iii) a patent would also be invalidated if the invention is shown to have been the subject of a valid prior grant. Prior art is also relevant for non-obviousness since by describing the same an inventor can describe the limitation of the prior art and seek patent protection.

#### Bolivia

In order to determine whether an invention is non-obvious and involves an inventive step, the opinion of a person in the trade with average skills in the technical field concerned is used and that person must clarify whether the invention which may be derived from the prior art is non-obvious. This is stipulated by Article 18 of Decision 486, which states:

An invention shall be regarded as involving an inventive step if, for a person in the trade with average skills in the technical field concerned, said invention is neither obvious nor obviously derived from the state of the art.

The opinion of the person skilled in the art should not necessarily be published. Similarly, it is not relevant to demonstrate that this opinion was formed either before or after the prior art is gathered together. No priority therefore exists in this regard.

#### Brazil

An inventive step is to be considered present whenever, from the perspective of a person skilled in the art, the invention does not stem as an evident or obvious conclusion from prior art.

As outlined above, the concept of “prior art” comprises whatever is made available to the public prior to the deposit of the patent application — by oral or written description, by usage or any other means, in Brazil or abroad — with the exception of the patent application disclosed by the inventor or third parties, based on information obtained directly or indirectly from the inventor, or by an official INPI publication of the patent application without the consent of the inventor, within the 12 (twelve) months preceding deposit or priority date.

An invention fulfils the novelty requirement when it is not part of prior art.

As mentioned above, the concept of “prior art” comprises whatever is made available to the public prior to the deposit of the patent application — by oral or written description, by usage or any other means, in Brazil or abroad — with the exception of the patent application disclosed by the inventor or third parties, based on information obtained directly or indirectly from the inventor, or by an official INPI publication of the patent application without the consent of the inventor, within the 12 (twelve) months preceding deposit or priority date.

Concerning novelty, a patent application filed in Brazil and not yet published will also be considered “prior art” from the filing date or the claimed priority date, once it is published, even later in time.

### Bulgaria

To evaluate inventive step or obviousness, the examiner would consider whether the disclosed matter would have made the claimed invention obvious to a person of ordinary skill in the art at the time the claimed invention was made.

### China

Prior art relevant for non-obviousness is similar to that for novelty. The difference is that prior art relevant for non-obviousness need not be disclosed in a manner sufficiently clear and complete so as to enable a person skilled in the relevant field to carry it out, it can only give special inspiration to the invention. Specially, prior art for novelty includes the content in contradiction applications.

### Colombia

The prior art base for non-obviousness is the same prior art as is considered for novelty. However, all the previous patent applications which are unpublished or are published after the submission of the application may not be considered, since the Andean rules and the doctrine have stated that although the said applications are assimilated to the prior art in order to examine novelty, this assimilation shall not be done in relation to the assessment of inventive step.

With reference to the issues raised in questions 3 to 6, the prior art base for non-obviousness is the same prior art as is considered for novelty, apart from in relation to the assimilation to prior art.

What is taken into account is the fact that, since they are different criteria, novelty and inventive step give rise to a different analysis at the time the patentability of an application is considered. In considering whether an invention does not involve an inventive step, the differences between the invention and the closest prior art are considered, and the closest prior art is normally to be found in the same field as the invention or in a field where an attempt is made to solve the same or a similar problem.

### Congo

The disclosure of an invention prior to filing, which exceeds the deadline fixed by the Bangui Agreement, destroys novelty.

Croatia

The state of the art has to be relevant for the purpose of determining whether the subject matter of the invention is or is not obvious to the person skilled in the art. See answer on Q6 and Q3.

According to our legislation in deciding whether an invention involves an inventive step, the effective date of prior art is the publication date.

Czech Republic

It is regulated by Section 6 of the Act. Unlike the determination of novelty the content of unpublished patent application with the former priority right is not relevant.

Denmark

See Q 3. The prior art base for non-obviousness is the same standard that applies to prior art for the assessment of novelty.

Egypt

The standard that applies to prior art for the assessment of novelty is the search on database.

To determine that an invention is non-obvious (or involves an inventive step), the office refers to experts in different fields of technology.

Eurasian Patent Office

When determining whether an invention satisfies the patentability requirement of “inventive step”, all the information contained in the prior art that is understood by “a person skilled in the art” is used. The difference with cases where it is established whether an invention meets the patentability requirement of “novelty” lies in that, when determining inventive step, the prior art does not include Eurasian applications with an earlier filing (priority) date, but applications published later than the filing (priority) date of the application examined.

European Patent Office

See answers to Q.3-Q6: the prior art that is taken into account when determining whether an invention involves an inventive step does not differ from the standard that applies to prior art for the assessment of novelty. However, the examination of novelty, as opposed to the examination of inventive step, does not take account of well known — but not specifically disclosed — equivalents. Thus, when considering novelty, the teaching of a document is not interpreted beyond its literal meaning: this is a matter of inventive step.

Fiji

The requirement in Fiji’s Act is that the invention has to be new and this contradicts prior art, which has been around for sometime and may have only been used on a nominal basis in the invention or patent concerned.

Finland

In case of conflicting applications, the criterion of patentability is novelty.

For any other situation, the criteria of patentability are novelty and inventive step.

### France

In accordance with Article L. 611-14 CPI, “an invention is considered to involve an inventive step if, for a person skilled in the art, it is not obvious from the prior art. If the prior art includes documents mentioned in the third subparagraph of Article L. 611-11 CPI, they are not taken into consideration when assessing inventive step”.

The prior art relevant to the assessment of novelty and that relevant to the assessment of inventive step do not differ other than as regards the documents mentioned in the second sentence of Article L. 611-14 CPI. Thus, “the content of French patent applications and European or international patent applications designating France, as they have been filed, which have a filing date prior to that mentioned in the second subparagraph of this Article and which have been published only on that date or a subsequent date” (Article L. 611-11 CPI) is not taken into consideration for the assessment of inventive step, whereas they are for the assessment of novelty.

Furthermore, according to the Office guidelines relating to the examination of patent applications (Title I, Section C, Chapter VII p.26), which refer to the EPO guidelines, “the use of the terms “obvious from” shows that the prior art must be taken as a whole; contrary to the assessment of novelty, it is not forbidden to combine documents or parts of the same document”.

### Georgia

Regarding estimation of inventive step comparison is conducted with several objects, and regarding definition of novelty with one object.

### Germany

Section 4 of the Patent Law specifies whether an invention involves an inventive step:

*An invention shall be considered to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Section 3(2), these documents shall not be considered in deciding whether there has been an inventive step.*

When examining for inventive step, all knowledge is taken into consideration that has been made available to the public by means of a written or oral description, by use or in any other way, before the date relevant for the priority of the application. It is followed by an assessment of whether the technical teaching of the application is well within or beyond the average capability of the person skilled in the art in view of the relevant state of the art as a whole. In contrast, when assessing novelty, only an individual comparison is made between the subject matter of the application and each individual subject matter of prior art.

### Ghana

The general term for determining whether an invention is non-obvious should be the source of the material for invention.

The relevance of the prior art to the organization, society and the country as a whole. Its usefulness for the purpose of the invention and time.

Ireland

The national law on prior art corresponds to Article 54 (2) of EPC. Generally speaking, the Irish Patent Office follows the EPO guidelines and jurisprudence.

Italy

See only paragraph 1 in question 3.

For the assessment of novelty, see paragraph 1 and 2 in question 3.

Japan

The standard, which applies to the prior art, is not different between the assessment of novelty, and the assessment of inventive step.

Kenya

By considering the prior art somebody can easily come up with the invention especially without substantial intellectual input.

Republic of Korea

The standard for prior art is the same as the standard for assessing novelty and inventive step.

Lithuania

See answer to Q. 4.

Malaysia

An invention shall be considered as involving an inventive step if, having regard to prior art, such inventive step would not have been obvious to a person having ordinary skill in the art.

Mauritius

An invention shall be considered as involving an inventive step where, having regard to the prior art relevant to the application claiming the invention, it would have been obvious to a person having ordinary skill in the art.

(a) for the assessment of novelty, an invention is new where it is not anticipated by prior art (to refer to A3).

Mexico

The prior art that may be taken into account consists of all the knowledge that has been made public by any means of communication and the results of which, from the information disclosed, are obvious for a person skilled in the art (lack of inventive step).

For the assessment of inventive step, the same prior art is considered as for assessing novelty, apart from the patent applications being processed which are not considered for the assessment of inventive step, only for assessing novelty.

### Republic of Moldova

According to Article 6 of the Law, “an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art”.

For the state of the art for the purpose of inventive step it is applied the same standard that applies for the assessment of novelty described above, with one difference: the prior art does not include the later published applications filed with the office before the filing date of the application being examined. In considering the non-obviousness, as distinct from novelty, it is possible to interpret any prior document in the light of subsequent knowledge generally available to the person skilled in the art at the priority date of the application.

### Norway

Prior art for assessment of inventive step does not include patent applications filed in Norway, which are not published before the filing date of the application under examination.

### Panama

Our Law does not distinguish with regard to what constitutes prior art for assessing novelty or inventive step, for which reason the same parameters established in Article 12 of Law No. 35 of May 10, 1996, which were included as the answer to question 3, are considered.

### The Philippines

Only prior art made available to the public before the filing date or priority date of the invention shall be considered in assessing inventive step.

### Poland

An invention is deemed to have prior art, when an invention does not result, for a person skilled in the art, in obvious way, from known prior art. The inventive step is assessed by comparison with the most approximate solution (solutions) of prior art. If an expert in the given subject is able to, on the basis of prior art, replicate the invention, it means that such a solution is obvious.

Unlike the novelty examination while assessing the inventive step, information included in patent applications claiming earlier priority, if they were not disclosed earlier (before the priority date of the examined application), are not taken into account.

### Portugal

For the assessment of inventive step the prior art does not include Portuguese patent documents not yet published.

### Romania

The prior art which may be taken into account for evaluating the inventive step is represented by the knowledge made available to the public by any means, contained in various documents, in parts of documents which may be combined in a mosaic system or in a single document, as the case may be.

According to the law, although the prior art comprises all patent applications mentioned at Q3, second paragraph, they are still not taken into account for evaluating the inventive step.

In order to be considered a novelty-destroying document, a single document from the prior art should contain all the essential characteristics of the claimed invention. On the other hand, for assessing the inventive step, the claimed invention as a whole is considered as obvious if, taking into account the general knowledge of a person skilled in the art, one or more characteristics contained in the prior art would have allowed the said person to obtain the claimed invention by replacing, combining or modifying one or several characteristics of the prior art. Technical equivalents of said characteristics may also be taken into account.

As an alternative provided by the law, the inventive step can also be examined by using a “problem-solution” approach, specific to the European Patent Office, which is based mainly on the closest prior art, only one reference being taken into account.

For a patent document, the date taken into account for opposing the prior art depends on the patentability condition to be assessed, and can be either the filing date of the patent application or the date of the recognized priority, in the case of novelty, or the publication date, in the case of the inventive step.

#### The Russian Federation

For the determination of compliance of an invention with the patentability requirement of inventive step, the prior art includes any publicly available (published on the application priority date) information comprehensible to a “person skilled in the art”. For determination of compliance of an invention with the patentability requirement of novelty, the prior art also includes patents and invention and utility model applications with an earlier priority date.

#### Senegal

In traditional medicine a plant cannot be protected since the plant belongs to everyone. However, a method of using a plant for a particular action or for a given effect can be protected. The problem of evidence arises where the same plant is used with the same method for two different infections. However, such a situation is explained by the fact that a single plant has several possible benefits. For example, the same plant may treat asthma and bronchitis. In this case, evidence can be established by means of additional studies (clinical, pharmacological, toxicological, pharmacognosic and so on) carried out on a sample of patients. Clinical study allows the evidence to be established.

#### Singapore

Section 15 of the Patents Act states that: “An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 14 (2) and without having regard to section 14 (3).”

#### Sweden

Normally, a search is performed by the office, see Q1. Other information may be used if provided by the applicant or third party. In the case where the applicant has applied for the patent in another country, the Swedish application has to be furnished with information from

the said foreign application.<sup>23</sup> Obviously, for PCT applications entered into the national phase, the international search is of importance.

#### Thailand

Non-obvious means that a person skilled in the art can not carry out the invention without reading, researching.

Inventive step is different from novelty in the sense that it can solve the old technical problem.

#### Tonga

Not applicable.

#### Trinidad and Tobago

The simple test for novelty is the mere existence of the invention in the prior art on a claim-by-claim basis. The consideration for non-obviousness can combine all relevant disclosures across the span of time before the priority date. Even if an invention is novel over the prior art, the person with average skill in the art just after the priority date would be expected to have access to all the prior art available before the priority date and extending back to known antiquity for purposes of combination or new uses as the case may be. Therefore, something can prove to be novel but yet lack inventive step.

#### Turkey

Documents found during the search are often referred to as prior art. If the publication or disclosure was made before the day of filing, it counts as prior art.

An invention shall be deemed to surpass the state of the art (to involve inventive activity/step) when it is the result of an activity which is not obviously realizable from the state of the art, by a person skilled in the concerned technical field.

Any invention which is not part of/comprised in the state of the art shall be deemed to be novel.

#### Ukraine

In relation to non-obviousness, in the same way as for novelty, the prior art includes all the information that has become publicly available in the world prior to the application filing date in Ukraine and, where priority is claimed, before its filing date. Contrary to the assessment of novelty, for the assessment of non-obviousness the prior art includes the content only of those applications filed in Ukraine, on which information is published prior to the filing date (or where priority is claimed, the priority date) of an application in relation to which the prior art is determined.

Contrary to the assessment of novelty, when assessing non-obviousness for the purposes of a comparison with the features of a claimed invention information may be used that is obtained from various information sources, provided that the possibility of combining such information is obvious for a person skilled in the art.

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<sup>23</sup> Swedish Patents Decree Section 29



Venezuela

No, there are no specific judicial or administrative decisions or guidelines.

Viet Nam

The examination of inventive step of technical solutions is conducted upon requirements set forth in Article 4.2 Decree 63/CP. Specifically, a technical solution shall be deemed to involve an inventive step, if it is the result of creative activity, and, based on the available domestic and foreign technology at the priority date of the application of a Protection Title for an invention or utility solution, it is not obvious to a person with average skill in the art.

**Q10. PERSON SKILLED IN THE ART.**

What standards apply to determining the person skilled in the art (or equivalent test) when assessing non-obviousness (inventive step) in your jurisdiction?

If an element of TK (including TK associated with certain genetic resources) is considered available to or accessible by the public outside the original community that holds the TK, but the skills to interpret or practice the art of TK are limited to the community only, how would the person skilled in the art be assessed for the determination of inventive step?

Argentina

Article 4 (LP) - (d) Inventive step will exist where the creative process or its results are not obvious from the state of the art for a person with average skills in the technical field concerned.

Part C, Chapter IV, Para. 9.3 (DP) — The question to be considered with respect to any claim defining the invention is whether on the priority date of that claim and considering the prior art up to that time, it would have been obvious for a person with average skills in the field concerned to reach a conclusion covered by the terms of the claim. In that case, the claim will not be inventive. The term “obvious” refers to that which does not go beyond normal technological progress, but simply or logically emerges from the prior art. It is the case, for example, with regard to something that does not involve the exercise of some skill above and beyond that expected of a person with average skills in the field concerned. When considering inventive step, and contrary to the requirement of novelty, it is correct to interpret any published document in the light of the knowledge generally available to a person with average skills in the field concerned on the filing date or, as appropriate, the priority date of the invention.

9.4 The claimed invention should normally be considered as a whole. As a general rule, in the case of a claim which combines technical characteristics, it is incorrect to argue that each of the technical characteristics of the combination considered separately are known or obvious and that therefore the whole of the claimed subject matter is obvious.

10.4 When assessing inventive step (contrary to novelty), the examiner may combine the disclosure of two or more documents or parts of documents, different parts of the same document or other prior art information, but only where such a combination would have been obvious for a person with average skills in the field concerned on the effective date for the claim being examined. When determining if the combination of two or more different disclosures is obvious, the examiner must consider the following:

(i) whether the content of the documents is such that it is probable or not that a person skilled in the art could have combined them when encountering the problem solved by the invention. For example, if two descriptions considered as a whole would not, in practice, have been combined, owing to the incompatibility inherent in the essential features of the invention, the combination of those features would not normally have been considered to be obvious;

(ii) whether the documents come from similar or unrelated technical fields;

(iii) the combination of two or more parts of the same document could be obvious if a reasonable basis exists for a person with average skills in the field concerned to connect these parts with each other. The combination of a document belonging to the prior art with a well-known textbook or a standard dictionary is normally obvious; this is only a special case within the general possibilities of obvious combinations of the teachings of one or more documents with the general knowledge common to the art.

In general terms, it may also be obvious to combine two documents, one of which contains a clear and unambiguous reference to the other one. Similar considerations will apply to determining whether it is acceptable to combine a document with a prior art article made public in some other way, for example through use.

#### Armenia

In our jurisdiction, a person skilled in the art is a specialist skilled in the present art.

#### Australia

For inventive step assessments, the person skilled in the art should be identified in light of the problem the invention is directed at solving and *not* in light of the claimed solution. The art also includes any related field of technology where the skilled person would be expected to look for a solution to the problem. That is, in Australia, the person skilled in the art is considered to:

- (a) be a skilled but non-inventive worker in the relevant field of technology in Australia;
- (b) know the common general knowledge in the art in Australia;
- (c) be anyone from a tradesman in some arts to a highly qualified scientist in others depending on the nature of the problem;
- (d) be one or more people.

When assessing the common general knowledge used by the person skilled in the art in an inventive step assessment, the person skilled in the art has the common general knowledge as of the priority date of the patent application being examined. This is different from novelty assessments. Common general knowledge for novelty assessments is determined at the publication date of the citation, rather than the priority date of the patent application being examined.

In Australia there are no specific rules which apply regarding the assessment of the person skilled in the art for the determination of inventive step when an element of TK is involved. An objection of lack of inventive step only arises where it can be shown that a person skilled in the art would, in solving the problem, have taken the necessary steps to reach the claimed invention.

In addition, problems may arise in the circumstances set out above, as the only common general knowledge that can be used in objections of lack of inventive step is the common general knowledge in Australia. Thus if the situation described in the question arises and the TK is TK in a community of indigenous Australians, then that common general knowledge will be common general knowledge in Australia and is potentially accessible to the relevant person skilled in the art.

However, if the community which holds the TK is not in Australia, then this may cause a problem as the common general knowledge available to the relevant person skilled in the art is not going to be the common general knowledge in Australia. Consequently an examiner may have difficulties in identifying the relevant person skilled in the art and taking inventive step objections in these circumstances.

Note: If the knowledge is confidential to the community, especially the elders, then it does not form part of the common general knowledge and so is not available to be used in any assessment of inventiveness.

#### Austria

See the European Patent Convention.

#### Azerbaijan

The expert is the person skilled in the particular area of art (or equivalent test) at the present stage and capable of using its own knowledge completely.

If an element of TK (including TK associated with certain genetic resources) is considered available to the public outside the original community that holds the TK, but the skills to interpret or practice the art of TK are limited to the community only, the person skilled in the art is assessed similarly.

#### Bangladesh

No established standards and guideline are available in this respect.

#### Bolivia

In accordance with Article 18 of Decision 486, the person called upon to produce an opinion as to the non-obviousness (inventive step) is someone in the trade with average skills in the technical field concerned. As to inventions with elements of TK, the same criterion contained in Article 18 will be applied in order to determine the person skilled in the art.

#### Brazil

A person skilled in the art is one having experience and average knowledge in the subject matter.

#### Bulgaria

There have not been any standards to determine the person skilled in the art in the field of TK associated with certain genetic resources.

#### China

The definition of “the person skilled in the art” is the same as the answer to Q4. If an element of TK (including TK associated with certain genetic resources) is considered available to or accessible by the public outside the original community that holds the TK, i.e. shall be considered as prior art, but the skills to interpret or practice the art of TK are limited to the community only, our practice now is: if the relevant TK is systemic e.g. our Zang Medicine, then the person skilled in the art shall have the basic idea of that TK, which means that the examiner shall learn some basic knowledge of that TK system; if the relevant TK is

scattered and the examiner feels it difficult to learn, the examiner may ask the applicant to supply background information to make the application sufficiently clear. However, we feel this question shall be discussed further.

### Colombia

The *person skilled in the art* “is a fictitious person to whom recourse is had for the purpose of obtaining an objective parameter allowing a truly inventive step to be distinguished from that which is not inventive. Such a person will be one with average knowledge of the technical sphere to which the claimed invention refers. His level of knowledge is higher than the level of knowledge of the general public, but does not exceed what may be expected of a duly qualified person. A person with average, but not specialized, technical knowledge is sought” (Court of Justice of the Andean Community. Judgement No. 26-IP-99 of July 23, 1999).

For the determination of inventive step, the person skilled in the art would be the person with average knowledge or knowledge close to the culture of TK.

### Congo

A person skilled in the art is defined by the Bangui Agreement as a person with knowledge and average ability to carry out an invention.

### Croatia

According to our jurisdiction there is no official statement on this matter.

### Czech Republic

A person skilled in the art is a person with the qualification that is usually necessary to deal with similar tasks in the given field of technology.

If the character of the task is complex the skilled person can be represented by a group of skilled persons of various qualifications who would be entrusted with the given task under normal conditions.

### Denmark

See Q. 4. The definition of a skilled person in TK does not differ from the definition of the skilled person in any other specific technical field.

### Egypt

The person skilled in the art would be assessed for the determination of inventive step by using a good archive system based on all information concerning the TK and genetic resources.

### Eurasian Patent Office

A “person skilled in the art” is understood to be a person whose qualifications are equivalent to an average level in a given field of technology and which allow him to carry out an invention.

EAPO standard-setting documents do not contain a direct answer to the second question. However, these documents allow the conclusion to be drawn that the concept of “a person skilled in the art” should be understood as such a person who will be able to use an invention irrespective of the community for which it will be used.

#### European Patent Office

See Q. 4.

If an element of TK (including TK associated with certain genetic resources) is considered available to or accessible by the public outside the original community that holds the TK, but the skills to interpret or practice the art of TK are limited to the community only, the person skilled in the art would probably be considered as having the knowledge of one or several members of the community holding the TK.

#### Fiji

Under Fiji’s current laws no letters of patent will be granted if the invention has no utility; was not new when presented for registration; the petitioner is not the true and first inventor; or if the petition or specifications contains a willfully false statement. They are no set standards available to determine the level of skill required.

#### Finland

The person skilled in the art would be assessed as being a person having common knowledge in the art but no special knowledge like knowledge in the TK. The skills available only in the original community that holds the TK would not be counted in the skills of the person skilled in the art.

#### France

No legal definition of a person skilled in the art exists. However, in general terms a person skilled in the art may be considered to be a person in the technical field to which the invention belongs.

According to the Office guidelines relating to the examination of patent applications (Title I, Section C, Chapter VII, p. 27), “*in general this is a technical field to which the claim in question belongs and, more precisely, the preamble of the claim. Thus, if a claim concerns a glass fibre fishing rod, a person skilled in the art will, in principle, be a fishing rod specialist and not a glass fibre specialist. However, in certain particular cases the wording of the claim and the prior art will be such that a person skilled in the art will be the person named in the characterizing portion, or will even be constituted by a multidisciplinary team involving specialists from various fields. The determination of a person skilled in the art is essential, since the level of such a person is not the same according to different specialities: of a modest level in simple or undeveloped techniques, he will be at a high level in cutting-edge technologies or those being developed. Similarly, the way in which a person skilled in the art approaches the prior art varies according to whether it is his own technical field — which he knows perfectly — neighboring fields — which he is able to understand without, however, mastering them —, or remote fields — which he can penetrate only with difficulty and where he can access only general information.*”

*In all cases, the person skilled in the art is the implementor: he knows how to implement perfectly, but he may raise only simple problems and he does not know how to create. Finally, a person skilled in the art is the victim of the prejudices of his discipline and his era. It is clear that such a person who is supposed to know everything but to have no imagination is a purely abstract entity. Although fictitious, a person skilled in the art is, however, a key figure”.*

As regards TK, to the best of our knowledge no decisions exist providing a definition of a person skilled in the art in this context.

#### Georgia

There are no applications in this area.

#### Germany

The person skilled in the art is a specialist possessing average knowledge and capability. He is defined by the technical field to which the invention belongs. If the invention belongs to a field in which TK plays a role, or to a neighboring field, that knowledge has to be considered as forming part of the knowledge of the skilled person.

#### Ghana

They should have personal skills because, in Ghana, most TK experts are not educated but perform to test their research and objectives. Also if assessed by the person skilled in the art they should be tested for practicality of the invention since the non-skilled person does that with the invention.

If it is outside the community, the person skilled in the art should be assessed, based on how he is able to translate the TK into the new community and how they are accepted by the other communities as to put them into practice, and understanding of the art of the TK.

#### Ireland

The national law on prior art corresponds to Article 54 (2) of EPC. Generally speaking, the Irish Patent Office follows the EPO guidelines and jurisprudence.

#### Japan

In our examination guidelines “a person skilled in the art” is defined as follows, which does not include any description on TK.

“A person with ordinary skill in the art to which the invention pertains” (referred to as “a person skilled in the art” hereinafter) provides a hypothetical person:

who has the common general knowledge in the art to which the invention pertains at the time of filing an application, and has ability to use ordinary technical means for research and development;

who has ability to exercise ordinary creativity in selecting materials and changing designs;

who is able to comprehend as his/her own knowledge all technical matters in the state of the art in the field to which a claimed invention pertains at the time of filing a patent application.

In addition, a person skilled in the art is supposed to be able to comprehend as his/her own knowledge all technical matters in the field of technology relevant to a problem to be solved by an invention.

Further, there may be cases where it is more appropriate to think in terms of “a group of persons” than a single person.

In the case of TK where the skills to interpret or practice the art of TK are limited to the community only, it is not appropriate to consider that a person skilled in the art belongs to a certain community. The inventive step of such TK will be determined through a process to make clear the scope that a person skilled in the art (e.g. a person with common general knowledge in traditional medicine) can regard as a prior art based on the information on disclosed TK.

#### Kenya

One of the standard is consideration of the technical qualification in the field of the invention.

#### Republic of Korea

The standard for determining the person skilled in the art of TK is the same as the standard in other technical fields. If the art of using TK is held only in the original community, then, outside of the original community, any member of the public that can access the TK may be regarded as the person skilled in the art.

#### Lithuania

Concerning the definition of the person skilled in the art, we would follow the European Patent Office’s case law. It means that the person skilled in the art should be presumed to be an ordinary practitioner aware of the common general knowledge in the art at the relevant date.

#### Malaysia

The person skilled in the art means the knowledge is within the person having ordinary knowledge in that said field.

If the information is already within the knowledge of the public, therefore the person skilled in the art also refers to the general public.

#### Mauritius

No standards have been established yet.

#### Mexico

“A person skilled in the art” is a person who possesses average technical knowledge in the technical field of the invention.

Under Mexican legislation, “traditional knowledge per se” is not patentable, nor is a genetic resource in its own right (e.g. a plant). In the assessment of an invention derived from “traditional knowledge”, a person skilled in the art is one who possesses average knowledge in the field of the invention, for which reason for example: in an invention in the



pharmaceutical field, this is a chemist who has average knowledge in relation to the development of a drug (extract or drug with pharmacological effect).

#### Republic of Moldova

When assessing the non-obviousness it is to be considered whether at the priority date of the invention, having regard to the art known at that time, it would have been obvious to the person skilled in the art to arrive at something falling within the term of the claimed invention. The person skilled in the art should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have access to everything in the state of the art and to have the ability for carrying out the routine work and experimentation.

Concerning TK, in our opinion, the person skilled in the art would be assessed in the same manner; and such an element of TK as presented in the example would be considered as non-obvious for the reason of lack of common general knowledge on how to apply or to use a known available element of TK.

#### Norway

A person skilled in the art is meant to be an ordinary practitioner aware of what was common general knowledge in the art at the filing date of the application.

If the persons within the original community are not bound by confidentiality these persons are the persons skilled in the art. If they are bound by confidentiality, however, it will not be possible for the person skilled in the art to carry out the invention.

#### Panama

Persons skilled in the art are those who possess TK and the Department of Traditional Knowledge, set up by Law No. 20 of June 26, 2000, the National Commission of Traditional Indigenous Medicine and the Technical Secretariat for Traditional Knowledge of Indigenous Peoples are also consulted.

#### The Philippines

Please refer to our answer on Question No. 4.

#### Poland

The person skilled in the art is considered to be an expert, who has the knowledge in the field which applies to the given invention, to the degree which allows him for practical use of prior art within this scope.

Within the scope of TK, there is no special definition determining the person skilled in the art.

#### Portugal

The concept of person skilled in the art is not defined in PT legislation.

#### Romania

See Q 4, second paragraph. There are neither applicable norms, nor acquired experience to establish equivalent criteria for TK.

### The Russian Federation

The concept of a “person skilled in the art” is not defined in standard-setting documents. In the case in question, the basis used is the knowledge of a person able to understand both an invention itself and also information from the prior art, which relates to the invention.

### Senegal

Where knowledge is held by a community, the ownership or protection right should go to those with moral responsibility for the community. Otherwise, the community should organize itself in the form of an association, legally recognized by the competent authorities, and therefore claim the ownership right in the TK.

For example, the Malango Association of Fatick healers in Senegal finds a solution to treat psychiatric illnesses using Lup (a group ethnopsychiatric ritual). This knowledge is held only by the elders of the Seereer ethnic group. To whom does the invention license belong? One of two things: either the community organizes itself as a legal association and claims the benefit from the license as a Lupkat seereer community. Or the community responds in the name of a leader, a legal person to whom the patent would belong, even if this means that he shares in return the income gained from the invention with the members of his community. There is no reason for this knowledge, which belongs to the community, to be pirated by others. Even if this knowledge is known afterwards, the community should be allowed to benefit from it for a minimum of 20 years.

A person skilled in the art is an expert who has received training allowing him to determine the scientific nature of the invention in question. If the person skilled in the art is not convinced of the scientific nature of the invention, he or she may propose a counter-examination for validation purposes.

For example, PROMETRA International monitors 100 patients who, after undergoing Lup treatment, are completely cured in 80 per cent of cases with no recurrence for ten years. Therefore, a patent application for the Lupkat community is filed in order to protect their knowledge and the genetic resources of the plants used. The application may be credible to OAPI or WIPO. In the opposite case, the OAPI and WIPO can call on a technician who will conduct the clinical studies required for validation purposes.

### Singapore

This issue is open to judicial interpretation.

### Sweden

A person skilled in the art is, according to this office, a fictive person having common general knowledge in the technical field of an application<sup>24</sup>. The person skilled in the art is further aware of all relevant prior art documents made publicly available before the filing/priority date of the application. The person skilled in the art further makes use of normal means and has the capacity for routine work and experimentation<sup>25</sup>.

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<sup>24</sup> Guidelines of the Swedish Patent and Registration Office,; RL VII, 4.3

<sup>25</sup> Nordisk Utredningsserie 1963:6, page 126, 1:st column, 3:rd paragraph

The person skilled in the art possesses an average ability to reach conclusions from the facts found in the prior art and has the ability to use known technology for its normal purpose and to follow instructions taught by the prior art. However, technical prejudice will not be put into question by the skilled person, who rather endeavors to apply conventional solutions. Neither will the skilled person try to include a solution from a remote field of technology, unless it is commonly well known. The person skilled in the art could be said to lack imagination, in contrast to an inventor.

In certain fields of technology, the person skilled in the art could be a group of people, such as a research or production team.

When assessing inventive step, our office applies the problem-solution approach.<sup>26,27</sup>

#### Thailand

We do not have any Guidelines for TK and GR.

#### Tonga

Not applicable.

#### Trinidad and Tobago

In Trinidad and Tobago, a person with average skill in the art is specified. The skills to interpret or practice the art of TK could only be considered limited to a community only if the knowledge remains tacit i.e. not disclosed in detail to external society. Once the knowledge becomes explicit it can be assumed that any person with average skill in the art with access to the explicit knowledge can utilize the art. If the knowledge remains tacit i.e. limited to a community, the knowledge is still considered public domain even if within a more limited public. It most likely cannot be considered secret. The persons within the community with the knowledge can also be assumed to have access to other explicit knowledge revealed outside of their community thereby adding another dimension to non-obviousness, which is often viewed as relative to an external person with average skill in the art.

#### Turkey

There are no standards in our jurisdiction.

#### Ukraine

Legislation does not provide for such standards, although in practice a person skilled in the art is assumed to be a person whose qualifications are defined by an average level of knowledge in the corresponding sphere of technology, and benefiting from which that person may assess the possibility of carrying out a claimed invention.

In cases where an application examined relates to several spheres of technology, a person skilled in the art is assumed to be a group of people who together satisfy the characteristic detailed above.

In accordance with the above definition, a person skilled in the art is a person who possesses knowledge allowing him to interpret or apply the TK referred to in practice.

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<sup>26</sup> Guidelines of Swedish Patent and Registration Office RL VII 4.5

<sup>27</sup> PCT Guidelines appendix to chapter 13

Venezuela

The person concerned must be well versed in the area which is subject to his consideration for assessment purposes. For the determination of inventive step, consideration has been given to seeking support in the indigenous communities directly, where necessary, or from their representatives.

Viet Nam

As answered above, Viet Nam's jurisdiction does not contain detailed definition of "who shall be considered to be a person with average skill in the art". However, in practice, patent examiners of our Office apply the definition of this term set forth in the Guidelines for Examination in the European Patent Office (paragraph 9.6, page 48, Chapter IV, Part C).

**Q11. SPECIFIC DECISIONS OR GUIDELINES.**

In your jurisdiction, have there been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK as prior art for the determination of non-obviousness (inventive step), or concerning practitioners of TK as persons skilled in the art? If so, please give details.

Armenia

In our jurisdiction, there are no specific judicial or administrative decisions, or examination guidelines, which refer to TK.

Australia

There are no examination guidelines specific to TK or genetic resources.

As noted in Q8, there have been no judicial decisions in Australia which considered the issue of TK as prior art. While there have been two administrative decisions where TK was a potential issue (see above), neither decision considered the question of status of TK as prior art relying instead on conventionally published material.

Austria

There have not been any specific judicial or administrative decisions or examination guidelines which refer to the consideration of TK in the prior art for the determination of non-obviousness or which concern the taking into account of practitioners of TK as persons skilled in the art.

Azerbaijan

In our jurisdiction, there are no specific judicial or administrative decisions, or examination guidelines, which refer to TK.

Bangladesh

There are no specific policy or guidelines available for this purpose.

Bolivia

To date, no relevant specific judicial or administrative decision exist.

Brazil

There are no specific administrative guidelines concerning TK as prior art under INPI procedures.

Bulgaria

There are no specific judicial or administrative decisions.

China

No, but it is under consideration.

Colombia

No specific judicial or administrative decision or examination guidelines exist in which TK is taken into consideration as the prior art base for non-obviousness.

Congo

There is no information.

Czech Republic

There are none.

Denmark

No such decisions or guidelines exist.

Egypt

Yes, in our jurisdiction, there have been many decisions in Article 1 and 2 of the Egyptian Law on the Protection of Intellectual Property Rights, No. 82/2002.

Eurasian Patent Office

No, there have been no such decisions or guidelines.

European Patent Office

As of September 2004, there have been neither case law by the boards of appeal nor examination guidelines pertaining specifically to the status of TK or GR as prior art for the determination of non-obviousness. These issues are thus far being treated under the general provisions relating to prior art. For first instance decisions see answers to Q. 20.

Fiji

In Fiji, while TK has been around for centuries passed down from one generation to another there is no legislative framework in place to address this and we only have the Act. While there has been a dearth of judicial pronouncements in this area the setting up of Fiji's Cultural Department could mean that TK as prior art would need to be determined first before any patent is granted.

Finland

No, there have been no specific judicial or administrative decision.

France

To the best of our knowledge, no.

Georgia

No, there have been no specific judicial or administrative decision.

Germany

Whether or not the subject matter involves an inventive step depends on the individual case. The decision on the inventive step must be based on the criteria “claimed teaching”, “state of the art” (including TK, if appropriate, cf. Q8) and “appropriate skilled person”. It is true that certain principles for this assessment have been developed by the courts, but the courts have not established any fixed rules that would be absolutely conclusive of an inventive step. Nevertheless, court decisions may provide some guidance. An essential point is whether there is anything in the prior art that would have prompted or induced the skilled person to make a development in the direction of the subject matter claimed.

Ghana

Yes, in Ghana, efforts are being made to make prior art of any TK accepted for all through the center for scientific research for plants and TK.

Iceland

No, there have been no specific judicial or administrative decision.

Ireland

There are none.

Japan

No, there have not been any.

Kenya

No, there have not been any.

Republic of Korea

There are no specific judicial or administrative decisions that correspond to A8. However, for inventive step, we examine related inventions according to the examination guidelines of each industrial field (pharmaceuticals, food, and biotechnology).

Inventive step is acknowledged when we determine that a person skilled in the art could not easily arrive at a certain invention by applying TK or genetic resources.

Lithuania

No, there have not been any.

Malaysia

No, there have not been any.

Mauritius

There are no specific judicial or administrative decisions yet.

Mexico

No, to date there have been no relevant specific judicial or administrative decisions. In the case of the substantive examination of inventions relating to TK, the relevant prior art, which can be consulted through TK databases currently available, is assessed.

Republic of Moldova

There are no provisions.

Norway

No, there have not been any.

The Philippines

No, there have not been any.

Poland

See answer to question No 8.

Portugal

No, there are no specific guidelines regarding this issue. The procedures for determination of novelty and inventive step are the same as any other area of inventions.

Romania

No, there have not been any.

The Russian Federation

No such decisions or guidelines exist.

Senegal

There are no guidelines. By contrast, seminars and workshops on the subject of TK take place in Senegal.

Singapore

There are none.

Sweden

There are no specific decisions or guidelines particularly relevant to TK.

Thailand

We do not have any Guidelines for TK and GR.

Tonga

Not applicable.



Trinidad and Tobago

There are no specific judicial or administrative decisions or examination guidelines referring to genetic resources and TK as prior art in determining non-obviousness or concerning practitioners of TK as persons skilled in the art.

Turkey

In our jurisdiction, there have not been any specific judicial or administrative decisions, or examination guidelines, that refer to the status of TK as prior art for the determination of non-obviousness (inventive step), or concerning practitioners of TK as persons skilled in the art.

Ukraine

There are no such decisions or guidelines.

Venezuela

There are no such decisions or guidelines.

Viet Nam

In Viet Nam, we have no specific decisions or guidelines on novelty examination to invention/utility solution applications referring to TK.

## PART III: SOURCES OF PRIOR ART IN PATENT PROCEDURES

*The questions in Part III concern the actual mechanisms that are used during patent procedures to locate potentially relevant prior art.*

Q12. GENERAL SOURCES OF PRIOR ART

What are the sources of prior art that are considered during patent procedures:

- (i) Voluntary disclosure by applicants within patent specifications?
- (ii) Mandatory disclosure by applicants? If so, how is the obligation defined?
  - disclosure must be within the patent specification?
  - disclosure must be separately submitted to the patent authorities?
- (iii) Searching within your office?
- (iv) International searches (under the PCT)?
- (v) Searches from other sources (such as from other patent offices)?

Argentina

Q 12 and 13: As indicated, the Argentina LP and the Regulations under the LP do not stipulate any restrictions for the establishment of the prior art, for which reason all the sources indicated in the questionnaire may be considered. For such purposes, the following are normally used: (a) patent documents, (b) a range of technical literature, (c) international searches and/or substantive examinations available on the Internet (mainly the European Patent Office (EPO), WIPO and so on), (d) specific international searches on request (via WIPO), (e) observations by third parties, (f) catalogs or advertising information which has been made public, etc.

Armenia

Mandatory disclosure by applicants, which must be within the patent specification.  
Searching within our office.

Australia

The prior art that may be considered during patent examination procedure includes prior art:

- supplied voluntarily within a patent specification;
- obtained as a result of a search conducted as part of patent procedure;
- obtained from International Search Reports;
- obtained from searches produced by other patent offices;
- supplied by third parties under section 28.

Under subsection 45(3) of the *Patents Act 1990* and associated regulations (regulations 3.17A and 3.17B of the *Patents Regulations 1991*) applicants are required to inform the Commissioner of Patents of the results of any documentary searches by or on behalf of a foreign patent office within a prescribed period. Exceptions apply to applications made under the PCT, searches that produce a nil result or if the application is a divisional application and

any relevant searches have been previously supplied (regulation 3.17B of the Patents Regulations).

#### Austria

The following sources (published previously) are taken into consideration:

- (i) Each voluntary disclosure by applicants either within patent specifications or otherwise.
- (ii) Mandatory disclosure by applicants is not required.
- (iii) Searching within the office (which is mandatory).
- (iv) International searches (for example under the PCT) are taken into consideration, but an additional search within the office is compulsory.
- (v) Searches from other sources, in particular from other patent offices, are taken into consideration, but an additional search within the office is mandatory.

#### Azerbaijan

- (i) Yes.
- (ii) . Yes.
- . Yes.
- (iii) Yes.
- (iv) Yes.
- (v) Yes.

#### Bangladesh

- (i) Voluntary disclosure by applicants within patent specification.
- (ii) Within available information in the office.

#### Bolivia

In Bolivia, the following options are used as sources of prior art:

- (i) The voluntary disclosure of applicants is used regularly.
- (ii) Compulsory disclosure is used, since it exists in accordance with Article 40 of Decision 486, which states: "Within eighteen months after the filing date in the Member Country concerned or, where priority is claimed, after the date of application, the file shall assume a public nature and shall be open for consultation. The competent national office shall accordingly order the publication of that application in conformity with pertinent domestic provisions. The applicant may request the publication of the application at any time after the examination of its form has been concluded, notwithstanding the stipulation of the previous paragraph. In that case, the competent national office shall order its publication.
- (iii) The searches in SENAPI offices are collected in databases which are used to determine the prior art.

- (iv) International searches are conducted.
- (v) A search is also performed in cooperation with patent offices of other countries.

### Brazil

- (i) Yes, as long as the patent application is disclosed.
- (ii) This obligation must be complied with by the patent applicant in order to be in line with the legal standard of descriptive sufficiency (Lei 9,279/96, article 24).

Disclosure is to be performed in the application itself.

- (iii) Yes.
- (iv) Yes.
- (v) Yes.

### Bulgaria

Requirements concerning the actual mechanisms that are used during patent procedures are Article 37 of The Patent Law and Article 4(2) and Article 30 of the RFFE. They insist on mandatory disclosure by applicants and the disclosure must be written within the patent specification.

Patent procedure includes searching on the database of BPO and international search under PCT as well as searches from other sources (such as from other patent offices).

### China

The sources of prior art that are considered during patent procedures in my office are mainly from the search result of the examiners, but also make reference to the voluntary disclosure by applicants within patent specifications, pct international searches and search result of other patent offices.

### Colombia

- (i) Yes
- (ii) Yes.

In accordance with the provisions of Article 28 of Decision 486, in the description the invention must disclose “in a manner sufficiently clear and complete to be understood and so that a person skilled in the corresponding art may carry it out”, and should include the following information: the prior art of use in understanding and examining the invention, and the references to previous documents and publications relating to said technology; a description of the invention in terms allowing the technical problem and the solution provided by the invention to be understood, with an explanation of the differences and possible advantages with respect to the previous technology; an outline of the drawings, where applicable; a description of the method best known to the applicant for carrying out or putting into practice the invention, using examples and references to the drawings, where these are relevant.

As already stated, in the description the disclosure of the invention must be made “in a manner sufficiently clear and complete to be understood and so that a person skilled in the art

may carry it out". The same is true of the disclosure of the previous technology known to the applicant and the previous documents and publications relating to the invention.

Where the applicant wishes to submit his disclosure to other patent authorities, he must ensure that such authorities make provision for this subject.

(iii) Yes

(iv) Yes

(v) Yes

### Croatia

Voluntary disclosure by applicants within patent specifications

Searches from other sources (from other patent offices)

### Czech Republic

The applicant must involve in the description part of the invention application the Chapter "Prior art". The prior art documents which were the basis of the applicant when solving the problem should be specified. If during the patent procedure other documents are found, which are closer to the particular invention, it is required that the applicant should complete the prior art and discuss the particular documents (if these documents are not to the detriment to challenge the validity of invention patent). Insufficient description of the objective prior art is not by itself the reason for imposition of any sanctions against the applicant.

The requirements concerning clearness and completeness of clarification of the invention is regulated by Section 26, Paragraph 2 of the Act.

(iii) Yes.

(iv) Yes.

(v) Yes (if available).

### Denmark

The sources of prior art that are considered during patent procedures are from definition Q12 (i), (iii) and (iv).

### Egypt

The sources of prior art that are considered during patent procedures are: (i), (ii), (iii), (iv) and (v).

### Eurasian Patent Office

In accordance with Rule 3(1) of the Patent Regulations Under the Eurasian Patent Convention, prior art includes all information that has become publicly available in the world prior to the Eurasian application filing date and, if priority is requested, before its priority date.

In accordance with Rule 23(4) of the above Regulations, the section of the specifications entitled "Prior art" contains information on the inventions similar to the invention known to the applicant, preferably with the identification therein of the similar

invention closest to the invention or combination of features. The documents reflecting the prior art are cited with the widest possible scope and an indication of the information sources.

A patent search is conducted on the basis of the claims, taking into account the specifications and drawings (where they exist), to the extent appropriate in relation to the international requirements provided for in Article 15(4) of the Patent Cooperation Treaty and Rule 34 of the Regulations Under that Treaty.

The Eurasian Office also takes account of the results of the international search conducted by the international searching authorities. In such a case, an additional search may be carried out by EAPO examiners if, for some reason, the Office is not completely satisfied with the international search results.

#### European Patent Office

(i) Yes. Such documents, if considered relevant for examination, are reiterated in the search report as documents cited by the applicant.

(ii) No, there is no explicit duty of disclosure under European patent law. However, pursuant to Rule 27(1)(b) EPC, the description shall indicate the background art which, as far as known to the applicant, can be regarded as useful for understanding the invention, for drawing up the European search report and for the examination, and, preferably, cite the documents reflecting such art. According to the case law, the expression “background art” of Rule 27(1)(b) is to be interpreted as referring to prior art within the meaning of Article 54(2) EPC.

(iii) Yes.

(iv) Yes. In addition to point (iii), the EPO also acts as an international Searching Authority under the PCT (see Art. 154 EPC).

(v) Yes.

#### Fiji

In Fiji’s case this would have to be made by the Applicant within the given patent specifications and it would also depend on the search made by the AIPO.

#### Finland

(i) Yes

(ii) No

(iii) Yes

(iv) Yes.

(v) Yes, if available

#### Georgia

(i) Yes.

(ii) Disclosure must be within the patent specification.

(iii) Yes.

- (iv) Yes.
- (v) Yes, such as from other patent offices.

### Germany

The DPMA uses all sources mentioned in items (i) to (v) for the patent search. Searches from other patent offices are taken into consideration for the patent search and supplemented, if appropriate.

(ii) Upon request by the patent office, the applicant must completely and truthfully indicate the state of the art, to the best of his knowledge, and incorporate it into the description.

### Iceland

- (iii) Only searches within the office.

### Italy

During the patent procedure the Office takes into account the prior art described by the same applicant when assessing non obviousness.

### Japan

As regards your question items 12 (i) and (ii), we consider mandatory disclosure by applicants. Applicants are required to make disclosure within the patent specification.

Section 36(4) of the Japanese Patent Law stipulates as follows:

“The detailed explanation of the invention” “shall comply with the following:”

“(ii) where there is an invention relating to the invention described in publication (meaning the invention referred to in Section 29(1)(iii) — hereinafter the same in this paragraph), of which the person desiring a patent is aware at the time of filing an application for patent, it describes the title of the publication disclosing such invention described in a publication and other source of information on the invention described in a publication.”

We use both searches of (iii) Searching within your office, and (iv) International searches (under the PCT). Regarding (v): Searches from other sources (such as from other patent offices), we use it as a source of the prior art if we can use the searching/substantive examination result of other patent office.

We also send out searches to registration research institutes and use search results obtained through them.

### Kenya

Prior patent documents within our Office, other patent Offices, international searches. Scientific journals through international searches.

### Republic of Korea

The discovery of prior art for estimating patentability occurs when an examiner searches the documents of patentable and unpatentable inventions. In addition, whenever

possible, the examiner refers to international search reports of the PCT or foreign search materials.

### Malaysia

Sources of prior art are searched within the office, International searches and from other patent offices.

### Mauritius

Note: not applicable in view of the fact that our office does not itself conduct search and substantive examination but takes into account international search and examination reports during decision making process.

### Mexico

(i) Yes, however the disclosure of an invention will not affect it continuing to be considered novel where, within the 12 months prior to the patent application filing date or, where appropriate, recognized priority date, the inventor or his beneficiary has made known the invention by any means of communication, putting the invention into practice, or because it has been displayed at a national or international exhibition.

(ii) No

- Disclosure must be within the patent specification?

Yes, Article 47(I) of the Industrial Property Law provides for the obligation, on the part of an applicant, to attach to a patent application a description of the invention, which must be sufficiently clear and complete to allow appropriate understanding of the invention. Similarly, it must include the best method known to the applicant for putting the invention into practice, where this is not clear from the description of the invention.

- Disclosure must be separately submitted to the patent authorities?

Yes, Article 24 of the Regulations under the Industrial Property Law provides that the patent application shall indicate the date on which the invention was the subject of previous disclosure and shall identify the means of communication by which it has been made known, the information referring to the exhibition at which the invention has been displayed, or that relating to the first time when the invention was put into practice.

(iii) Yes.

(iv) Yes, 75% of the applications received by IMPI are applications filed through the PCT.

(v) Yes, since in accordance with Article 54 of the Industrial Property Law, the Institute may accept or request the result of the substantive examination or its equivalent carried out by foreign patent offices or, where appropriate, a simple copy of the patent granted by one of said foreign offices.

### Republic of Moldova

(i) It is mandatory to disclosure within patent application the known for the applicant background art.



(ii) The applicant must disclose in the description any background art of which he is aware and which can be regarded as useful for understanding the invention and its relationship to the prior art and for conducting the search and the examination; the identification of documents reflecting such prior art must be included.

(iii) Yes

(iv) Yes

(v) Only as informal background information.

#### Norway

(i) Yes.

(ii) Yes. The applicant should disclose all the relevant art known to him.

- disclosure must be within the patent specification?

Yes, but limited to relevant art.

- disclosure must be separately submitted to the patent authorities?

On request search results from other patent offices must be submitted by the applicant.

(iii) Yes

(iv) Yes, if available.

(v) Yes, if available.

#### Panama

In our office the following are considered as general sources of prior art:

(i) information submitted voluntarily by applicants

(ii) mandatory disclosure by applicants and which our law requires as prior art for the invention for which protection is sought.

- One of the features which a patent application possesses is the prior art which the applicant must describe at the beginning of the description of the invention, which must be submitted at the time of the application.

- No, as defined above this information is part of the description.

(iii) Yes, patent examiners must make searches for the purposes of establishing the prior art.

(iv) Yes, in our office we use PCT and EPO search reports for drawing up prior art reports.

(v) Yes, for the drawing up of the prior art report our legislation allows us to use both the reports of other offices and the services of national and international bodies or equivalent offices.

#### The Philippines

All of the above.

Poland

While assessing prior art, prior art cited by an applicant, search conducted during patent procedure in the Office and outcomes of the international search for PCT are taken into account. We do not make use of examinations done by other patent offices. An applicant is not obliged to state prior art in case an application does not include it.

Portugal

- (i) Yes
- (ii) No.
- (iii) Yes.
- (iv) Yes.
- (v) Yes.

Romania

- (i) Yes.
- (ii) Yes. The disclosure must be included within the patent specification.
- (iii) Yes.
- (iv) Yes.
- (v) Yes.

Russian Federation

(i) In the “prior art” section of the description an applicant may indicate any publicly available information known to him or her.

(ii) A description compiled by an applicant may contain a “prior art” section which cites information on analogues of an invention known to the applicant, whereby the analogue closest to the invention (prototype) is separated. This section is included by the applicant in the description only if the closest analogues are known to him. A specific document for submission to the patent office, containing prior art, is not envisaged. In his request an examiner may ask an applicant to clarify certain information or update it, and shall subsequently include information from the applicant’s response in the patent description.

(iii) In the case of searching by an examiner, the prior art includes any information made publicly available in the world prior to the invention priority date. Where the novelty of an invention is established, provided they have earlier priority the prior art also includes all the applications filed in the Russian Federation for inventions and utility models, the documents for which any person may consult in accordance with Article 21(6) or Part II of Article 25 of the Law, and inventions and utility models patented in the Russian Federation.

(iv) As an International Searching Authority, the Russian Patent Office determines prior art and conducts patent searches on international applications filed within the PCT system, in accordance with the international requirements provided for by the Patent

Cooperation Treaty (PCT), the Regulations thereunder, the Administrative Instructions and the PCT International Search and Preliminary Examination Guidelines.

(v) When conducting a patent search at the national stage, examiners from the Russian Patent Office take into account the results of an international search conducted by the International Searching Authority and determine the relevance of the information sources submitted in accordance with national patent legislation.

#### Sweden

The primary source of prior art is the result of searches performed at the patent office, see Q1. If provided, international searches or searches from other patent offices may complement the search within the office

#### Thailand

(i) Yes.

(ii) Yes, it should be in the patent specification.

(iii)-(v) Also searching in my office, international search and search from other sources such as University.

#### Trinidad And Tobago

(i) Voluntary disclosure by applicants.

(ii) Mandatory disclosure to the office (not necessarily within the specification) with respect to disclosures made by themselves or abuses of third parties up to one year before the filing date, if these disclosures are to be discounted in examination. The implication is that if they are not declared by the applicant and subsequently discovered in examination, novelty can be destroyed.

(iii) Searches by the office.

(iv) International search reports (Patent Cooperation Treaty).

(v) Searches from other patent offices and commercial patent searching authorities.

#### Ukraine

During patent procedures when a substantive examination is conducted, the following information concerning prior art is taken into account:

- that which is contained in the invention specification, where the applicant must disclose the prior art known to him;
- the results of the search that is carried out using the Office's patent information database;
- the international search report, international-type search report or European search report, where such a report is submitted by the applicant.

#### Venezuela

In particular databases of patent collections held by industrial property offices for example, USA, Japan, EPO, ESP@CENET.

- (i) This is considered part of the prior art, as indicated in Article 16 of Decision 486.
- (ii) The same as for the previous response.
  - disclosure must be within the patent specification? Yes.
  - disclosure must be separately submitted to the patent authorities? This is a separate document which accompanies the patent application.
- (iii) Prior art searches are conducted.
- (iv) Yes.
- (v) Yes.

Viet Nam

In Viet Nam, all sources set out in points (i), (ii), (iii), (iv) and (v) above are used as general sources of prior art.

**Q13. IN-HOUSE SEARCHING**

If searching is undertaken in your office during patent procedures, what are the sources searched:

- patent documents?
- non-patent literature (printed)?
- non-patent information (electronic/on-line)?

Do searches regularly make use of any sources (databases, journals, textbooks, etc) that relate specifically to TK (e.g. the TK Digital Library) or genetic resources (e.g. the IPGRA Singer database)?

Argentina

As indicated, the Argentina LP and the Regulations under the LP do not stipulate any restrictions for the establishment of the prior art, for which reason all the sources indicated in the questionnaire may be considered. For such purposes, the following are normally used: (a) patent documents, (b) a range of technical literature, (c) international searches and/or substantive examinations available on the Internet (mainly the European Patent Office (EPO), WIPO and so on), (d) specific international searches on request (via WIPO), (e) observations by third parties, (f) catalogs or advertising information which has been made public, etc.

Armenia

In our jurisdiction the sources searching are:

- patent documents
- non-patent literature (printed)
- non-patent information (electronic/on-line)

Our office does not use any sources that relate specifically to TK or genetic resources.

Australia

Searches conducted by IP Australia consider all the above sources.

Yes. Where the subject matter of the invention relates to TK the following databases are consulted:

- Traditional Ecological Knowledge\* Prior Art Database (T.E.K. \*P.A.D.)
- Agricultural Research Service: Phytochemical and Ethnobotanical Databases
- NAPRALERT
- WIPO Portal of Online Databases and Registries of Traditional Knowledge and Genetic Resources.

Yes. Where the subject matter of the invention relates to genetic resources the Australian Plant Breeder's Rights Database is consulted.

Austra

The sources used are:

Patent documents: (i) in databases; (ii) printed (collections within the office); (iii) CD-ROMs (collections within the office).

Non-patent literature: (i) printed (magazines, specialized reviews), manuals, special glossaries, dictionaries, books etc.); (ii) printed catalogs, leaflets, prospectuses; (iii) non-printed (online, specialized databases such as MEDLINE, cases etc.); (iv) non-printed dictionaries and specialized online dictionaries; (v) non-printed online: Internet sites.

Sources relating specifically to TK or genetic resources are not regularly used.

### Azerbaijan

While there is no formal international definition, TK can be characterized in general as knowledge which is:

- generated, preserved and transmitted in a traditional context;
- distinctively associated with the traditional or Indigenous culture or community which preserves and transmits it between generations;
- linked to a local or Indigenous community through a sense of custodianship, guardianship or cultural responsibility, such as a sense of obligation to preserve the knowledge or a sense that to permit misappropriation or demeaning usage would be harmful or offensive;
- this relationship may be expressed formally or informally by customary law or practices;
- ‘knowledge’ in the sense that it originates from intellectual activity in a wide range of social, cultural, environmental and technological contexts; and
- identified by the source community as being TK (see WIPO/GRTKF/IC/6/4, paragraph 58).

Genetic resources are defined in the Convention on Biological Diversity as "genetic material of actual or potential value;" and genetic material is in turn defined as "any material of plant, animal, microbial or other origin containing functional units of heredity.

### Bangladesh

- (i) Available patent documents, available non-patent literature.
- (ii) Non-patent information from the Internet.

### Bolivia

As regards patent searches, all the sources mentioned are used, as well as others which may be required in the case of TK.

### Brazil

Yes. All of the above sources are searched.

Brazil understands that databases with information on TK could potentially work as a useful tool of defensive protection, as long as the registration of such information on TK in

databases is not constitutive of any rights. No databases have been established in Brazil so far with information on TK held by custodians within the Brazilian territory.

INPI search procedures do not require regular searches of sources that relate specifically to TK and genetic resources. Brazilian authorities are currently discussing the issue.

#### Bulgaria

Searches make use of any sources (patent documents, non-patent literature, on-line databases including literature that relates to TK or genetic resources).

#### China

In my office, the sources searched include patent documents and non-patent literature and non-patent information. In special fields, such as TMC, we search “Chinese TMC patent database” and other relevant non-patent database. In biotechnology, we also search Genbank.

#### Colombia

Patent documents, non-patent literature (printed) and non-patent information (electronic/online).

#### Croatia

Patent documents. Non-patent literature.

#### Czech Republic

We use all available sources for searches, namely patent documents, non-patent literature, both printed and electronic.

For searches we use databases from the field of biotechnology which are part of the EPOQUE system. Special databases for searches focused on TK and genetic resources are not used.

#### Denmark

The in-house searching done during patent procedure in our office is within patent documents and non-patent information (electronic/on line).

#### Egypt

Yes, search is undertaken in our office during patent procedures. These sources searched are: patent documents; non-patent literature; non-patent information (electronic-online).

#### Eurasian Patent Office

At the EAPO a patent search may be carried out on the basis of the following information sources:

- patent documents;
- non-patent literature in any form (printed, electronic).

A non-patent literature search is carried out based on the publication of the leading world scientific and technical editions, according to the list recommended by the WIPO International Bureau, dating back at least five years.

When a search is conducted, any available online databases may be used, containing information relating to a claimed invention, including that relating to TK or genetic resources.

#### European Patent Office

The search is carried out in the whole documentation available to the EPO, i.e. in internal or external collections of documents or databases. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature. The Internet is also routinely searched for both printed and on-line disclosures. For details concerning the search documentation see the Guidelines for Examination in the EPO, Part B, Chapter IX available under: <http://www.european-patent-office.org/legal/guidelines/index.htm>.

Yes, the search documentation includes the PCT Minimum Documentation and extends beyond these minimum requirements.

Non-patent literature and non-patent information are also searched.

The searches regularly make use of sources (databases, journals, textbooks, etc) that relate specifically to TK and genetic resources. The search is either directed to sources that specifically relate to TK or genetic resources or to more general sources. Specific to TK is the systematic international patent classification (IPC) A61K 35/78 sqq., the database NAPRALERT accessed through STN, the Traditional Ecological Knowledge Prior Art Database and the Chinese Herb Database available on the Internet. Specific journals pertaining to TK that are available in-house in electronic form include but are not limited to: Australian Journal of Rural Health, Crop Protection, Chinese Journal of Digestive Diseases, Health Promotion International, Journal of Rural Studies, Tropical Medicine and International Health.

#### Fiji

Again we refer to IP Australia and the United Kingdom as well as our Cultural & Heritage Depart which comes under the ambit of the Ministry of Fijian Affairs.

#### Finland

Our sources comprise all the sources mentioned in the question. We make use of any source useful in examining novelty and inventive step.

#### Georgia

We use as the sources of search patents documents, non-patent literature, non-patent information (electronic/on-line).

There is no practice for work with any sources that relate specifically to TK or genetic resources.



### Germany

The following three information sources are always used in patent searches: patent documents, non-patent literature and non-patent information. Every patent examiner has access to the relevant in-house and external databases. In addition, the DPMA has one of the largest technical libraries in Germany. This book collection which – as mentioned before – also contains extensive documentation on TK is regularly used for patent search. The DPMA patent examiners always use these means of information for the search.

Presently, the TK Digital Library is still being established. After its completion, it will also be used by the examiners of the DPMA for the search just as any other accessible database on genetic resources.

Information on the search in the SINGER system of CGIAR (Consultative Group on International Agricultural Research) of the IPGRI (International Plant Genetic Resources Institute) is accessible to all examiners on the Internet at:

[www.singer.cgiar.org/Search/SINGER/search.htm](http://www.singer.cgiar.org/Search/SINGER/search.htm). Any accessible information on the Internet is covered by search engines as for example, Google, which are routinely used.

### Iceland

Sources searched are patent documents, as well as printed and electronic information. TK is not considered as a special issue.

### Japan

We use all the sources mentioned above: patent documents, non-patent literature (printed), and non-patent information (electronic/online).

JPO examiners have access to prior art information about TK and genetic resources. For example, examiners can access “journals” using commercial databases available within our Office which has come to be regarded as a PCT minimum document.

### Kenya

Patent documents, non-patent literature if available and patent information both electronic and online.

For the time being there are NO searches that regularly make use of any sources (databases, journals, textbooks, etc) that relate specifically to TK (e.g. the TK digital library) or genetic resources (e.g. the IPGRA Singer database).

### Republic of Korea

The prior art databases and search engines are as follows :

- (a) Patent documents :
  - eKIPASS (KIPO Patent Search System)
  - DELPHION
  - [ESP@CENETD](#)
  - Databases of the USPTO, the EPO and the JPO.
- (b) Non-patent literature (printed) :

- Journals, books, theses, and so on.
- (c) Non-patent information (electronic/on-line) :
  - The Korea Institute of Science and Technology Information:  
<http://www.kisti.re.kr>
  - The Drug Research Information Center: <http://dric.sookmyung.ac.kr>
  - The National Digital Library: <http://www.dlibrary.go.kr>
  - The Biological Research Information Center: <http://bric.postech.ac.kr>
  - The National Center for Biotechnology Information:  
<http://www.ncbi.nlm.nih.gov>

### Malaysia

Patent documents and non-patent literature such as journals and textbooks.

Searches do not regularly make use of sources that relate specifically to TK or GR.

### Mauritius

Note: not applicable in view of the fact that our office does not itself conduct search and substantive examination but takes into account international search and examination reports during decision making process.

### Mexico

Patent documents, non-patent literature and non-patent information.

Yes.

### Republic of Moldova

Patent documents, non-patent literature and non-patent information.

Concerning the sources related to TK or genetic resources, they are used in the searches only if the application relates to one of this field, for example for inventions related to pharmaceuticals based on plant compositions.

### Norway

Patent documents are searched.

Non-patent literature are searched but usually only for applications which do not claim priority from previous applications.

Non-patent information (electronic/on-line) are also searched, but usually only for applications which do not claim priority from previous applications

Searches do not regularly make use of databases that relate *specifically* to TK or genetic resources. Searches are, however, regularly made in databases that, to some extent, cover TK and genetic resources, such as dGene, CAPlus and WPI.

Panama

Yes, the national database; paper documents held by our Office, Internet databases and any other publications bearing a specific publication date are consulted.

Patent documents, non-patent literature and non-patent information.

Searches do not regularly make use of any sources that relate specifically to TK or genetic resources, although our office is currently establishing a TK database.

The Philippines

All available sources. We have no TK Digital Library.

Poland

While conducting the patent examination within the Office, all information deriving from patents and patent literature (publications, books) which are published or included into special on-line database, are taken into account.

Other information obtained via Internet is not taken into account because of lack of the relevant publication date.

We have not used, so far, databases referring to TK.

Portugal

Patent documents, non-patent literature and non-patent information.

Searches do not regularly make use of sources that relate specifically to TK or GR.

Romania

Patent documents, non-patent literature and non-patent information.

At present, there are no regularly employed information sources specifically related to TK or genetic resources (specific databases).

Russian Federation

Searching is conducted in the Russian Patent Office of patent documents, printed non-patent literature and non-patent information (oral and on electronic support), including in relation to TK and genetic resources.

Spain

The following sources are used: patent documents, non-patent literature (magazine and book articles), and also the Internet. To date no specific searches have been made in TK databases such as those mentioned.

### Sweden

As a general section, the search is performed in patent documentation and in addition to that other available sources may be used.<sup>28</sup> Moreover, the PCT minimum documentation shall be searched. All of the material need not be searched if documents are found sufficient to establish the patentability of the invention.<sup>29</sup> In practice, in the field of genetic resources and TK, the search always covers patents and non-patent literature both in printed and electronic (on-line) form.

### Thailand

The sources searched are patent documents, non-patent literature and non-patent information (electronic/on-line).

### Trinidad and Tobago

Searches are undertaken in-house, typically in patent documents both printed and electronic. However, leads may prompt queries of non-patent literature both printed and electronic. Searches do not typically make use of TK/folklore (TKF) databases unless there is cause to believe or suspect the source. Sometimes the patent examination community receives notices from NGOs and other agencies when a patent embodying genetic resources, TK and folklore (GRTKF) is filed internationally, perhaps using the PCT system. Our office makes note of the application in question and maintains an alert for its possible entry into the national phase.

### Ukraine

For the purposes of a search carried out by the Office, the following sources are used:

- patent documentation, be it printed or stored on electronic carriers and also in electronic online databases such as esp@cenet;
- non-patent printed literature held in the Office library or in other accessible storage areas;
- non-patent information held in electronic online databases such as PabMed and MEDLINE.

Sources that relate directly to TK or genetic resources are not used for search purposes.

### Venezuela

Yes, collections of CDs or DVDs belonging to industrial property offices.

Patent documents, non-patent literature and non-patent information.

Searches do not regularly make use of any sources (databases, journals, textbooks, etc.) that relate specifically to TK (e.g. the TK Digital Library) or genetic resources (e.g. the IPGRA Singer database).

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<sup>28</sup> Swedish Patents Decree Section 26

<sup>29</sup> Swedish Patents Provisions (PB) Section 35

Viet Nam

In our Office, the following information sources will be used during the substantive examination:

- patent documents;
- non-patent literature;
- non-patent information (Internet/electronic publication).

**Q14. SCOPE OF SEARCH AND SEARCH STRATEGIES**

What is the scope of the regular search for prior art (e.g. in terms of classification of subject matter)? What are the standard search strategies or guidelines that are employed? Under what conditions are searches broadened or extended beyond the standard procedures?

Argentina

## Part B, Chapter III, Point 1 (DP) — Scope of the search

1.1 The prior art search must essentially be of high quality and comprehensive. Nevertheless, it should be understood that in a search of this kind 100% effectiveness cannot always be achieved, owing to factors such as the obvious imperfections of any classification system and its implementation, since such effectiveness cannot be justified in economic terms if the cost is to be kept within reasonable limits. Consequently, the examiner must organize his efforts and use his time so as to reduce to a minimum the possibility of failure, by finding relevant prior art documents, such as documents which anticipate fully the subject matter of any claim.

1.2 This means that the examiner must, in principle, consult all the documents in the relevant classification units of the search archives, irrespective of the language in which they are written or their age, or of the type of document. Nevertheless, the examiner must, for reasons of economy, exercise his opinion, based on his knowledge of the technology in question and the documentation involved, in order to omit sections of the documentation in which the probability of finding any document relevant to the search is negligible, for example documents which fall within a period preceding the time when the technology in question began to be developed. Similarly, the examiner must consult a single document from a patent family, unless he has good reasons to suppose that, in a particular case, there are substantial differences in the content of different documents of the same family.

1.3 The search is carried out on the basis of the search archives which may contain material relevant to the invention. It should cover firstly all the directly relevant technical fields and can then be extended to similar fields, although the need for this must be judged by the examiner in each individual case, taking into account the result of the search in the initial fields.

1.4 The question as to which fields within the prior art may, in a given case, be considered similar must be considered in the light of what appears to be the essential technical contribution of the invention and not only the specific functions expressly indicated in the application.

1.5 The decision to extend the search to fields not mentioned in the application must be taken by the examiner who must not place himself in the inventor's position and must try to imagine all the types of possible applications of the invention. The principle to be considered in determining the extension of the search to similar fields must be the probability that a reasonable objection owing to lack of inventive step could be established on the basis of what is likely to be found by the search in these fields.

1.6 For reasons of economy, in order to accelerate the procedures and subject to the current limits of international harmonization which are sought in this area through respect for

the intellectual property rights emerging from the application of the international treaties, the examiner may use the search documents issued by foreign offices, insofar as:

- (a) said offices have broad documentation collections for the prior art search.
- (b) the National Patent Authority (ANP) has access to the publication at the international level of the prior art search done in another country.

It is possible that in cases where said Offices carry out substantive examinations with criteria similar to those of the ANP, and the examinations were accessible, the examiner may assess their use. Similarly, said documentation may also be submitted at the discretion of the holder of the application, so as to be taken into account by the examiner when the substantive examination is conducted, or also requested by the examiner in accordance with Article 27 of the LP.

In the same way as in the previous paragraph, the examiner may assess the use of equivalent patents granted abroad by these Offices.

At all times, the examiner must complement the search with the prior art that may emerge from the national documentation collection which includes the documentation listed in Article 27 II (a) of the RLP. All the documents resulting from the prior art search will be classified with the corresponding degree of relevance and cited by the examiner in the corresponding substantive examination.

#### Part B, Chapter IV, Para. 2 (DP) — Search strategy

2.1 Once the subject matter of the invention has been determined, as indicated in IV, 1.1, it may be desirable for the examiner to prepare a first draft search, defining the subject matter of the search as precisely as possible. In many cases, one or more of the claims may be used in their own right for this purpose, although they may need to be generalized in order to cover all the aspects and embodiments of the invention. At this moment, the considerations which refer to subject matter excluded from patentability and lack unity of invention must be borne in mind.

2.2 The examiner must then select the classification codes to be consulted for the search, in all the directly relevant and similar fields. The selection of classification units in related fields must be limited to:

higher subgroups which allow the search by means of generalization, insofar as this is justified from a technical point of view, and

parallel subgroups, bearing in mind that the fields in question will become continuously less specific to the subject matter in question.

2.3 Often various search strategies are possible and the examiner must exercise his judgment based on his experience and knowledge of the search archives in order to select the most appropriate search strategy for the case under consideration, and establish the order in which the different classification units will be consulted. Preference should be given to the units in which the probability of finding relevant documents is higher. Preference will normally be given to the main technical field of the application and the classification units closest to the specific examples of the claimed invention will be dealt with first.

2.4 The examiner must carry out the search, paying attention mainly to the assessment of the requirements of novelty but, at the same time, to any prior art document which may be

useful for the assessment of inventive step. Also, any document which may be important for other reasons should be considered, such as disputed applications or documents which call into question the validity of any priority claimed, thereby contributing to a better or more correct interpretation of the claimed invention, or which illustrates the technological precedents.

2.5 The examiner must concentrate his search efforts on the international classification codes in which the probability of finding the most relevant documents is highest and consider that, in order to extend the search to other less relevant areas, he must always bear in mind the results of the search already obtained.

2.6 The examiner must assess the results of his search continuously and, if necessary, reformulate the subjects of the search as a result. The selection of the classification codes to be searched, or the order of the search, may also need to be altered during the search as a result of intermediate results obtained. The examiner must also use his judgment, taking into account the results obtained, and decide at any time during or after the systematic search, whether he should approach the search documentation in a different manner, for example by consulting documents cited in the description of documents produced by the search or in a list of references of said documents.

2.7 If it were not possible to detect any document of relevance in assessing the novelty and inventive step, the examiner must cite any “prior art” document closer to the invention, which he may have noted during the search. In general, no special search effort must be made for this purpose. However, the examiner may exercise his discretion in special cases. It is possible for a search to be completed without any relevant document being found.

For reasons of economy, the examiner must use his judgment as to whether his search is complete, where the probability of finding relevant prior becomes very small in comparison with the effort required to find it. The search may also be delayed where documents have been found which clearly demonstrate the lack of novelty of the whole of the subject matter proposed in the claimed invention and its embodiments in the description, apart from characteristics which are generally or commonly known in the field being examined, and that would not involve an inventive step. The search for disputed applications being processed should, however, be conducted for the whole of the archive corresponding to the subclasses in which the application has been classified.

### Armenia

The search is carried out by the information materials, having at the disposal of the Agency, as well as the corresponding libraries of RA. In case of need the works of search can be ordered to any international search body. Advanced search is decided according to the developed period of the corresponding field of technics.

### Australia

An abridged version of IP Australia’s searching guidelines is attached.

Databases routinely consulted where the subject matter of the invention relates to chemistry or biochemistry include (depending on the subject matter of the particular application):

- Derwent World Patent Index



- Chemical Abstracts
- Chemical Abstracts Registry file
- Medline
- DGENE
- JAPIO
- China Patents
- BIOSIS
- Gene Sequence databases such as GENBANK.

Other databases may be consulted if the subject matter indicated this was appropriate.

Database commonly consulted where the subject matter of the invention relates to a plant variety: Australian Plant Breeder's Rights Database.

### Austria

Search strategies:

- IPC and ECLA (in particular EPOQUE) classification;
- keywords in databases with abstracts (in particular EPODOC, WPI, PAJ...);
- keywords in databases in full text;
- FI and F-terms (Japanese classification);
- USCLA (American classification);
- Internet – in general;
- Internet – websites of different patent offices (if necessary), for example the sites of the Chinese, Japanese or Korean offices for the purposes of looking at whole documents;
- specialized databases (CAS, STN, NCB...in particular for the chemistry/pharmaceuticals field);
- paper patent documents;
- specialized literature;
- non-patent databases – according to the field (for example, MEDLINE).

The use of the search strategy and the choice of means depend on the field and the subject matter of the application. Even an Internet search is part of the standard strategy. During the ordinary procedures, searches cover a very large area, use many search tools and are not extended further.

### Azerbaijan

The standard strategy of search is used including classification and realization of search by all accessible means and in all accessible sources.

### Bangladesh

We do search within patent documents and non-patent information available in the office and through the Internet.

### Bolivia

The scope of the search carried out in Bolivia is based on the International Patent Classification (IPC). As regards search strategies, these are carried out via the Internet and by

digital means, taking into account the name, applicant, title and other relevant data. This is established in Article 49 of Decision 486:

*“Article 49. — For organizing and classifying their patents, the Member Countries shall use the International Patent Classification established by the 1971 Strasbourg Agreement Concerning the International Patent Classification, together with its effective amendments”.*

Searches would be broadened in terms of their usual procedures where a patent application includes elements indicating the presence of TK or genetic resources originating from Bolivia.

### Brazil

Search strategy is performed taking into account the International Patent Classification as well as keywords. Strategies for searches conducted on electronic bases varies according to the base/system in question (EPOQUE, STN and DIALOG).

### Bulgaria

There have not been any specific search strategies and guidelines beyond the standards procedures.

### Chad

Although no definition of TK exists which is accepted at the international level, this could be defined, in general terms, as knowledge:

- linked to a local or indigenous community which considers itself to be the depository or guardian of this knowledge, or is entrusted with cultural responsibility in that regard (obligation to preserve knowledge or awareness of the fact that any unlawful appropriation or degrading use of the knowledge would be prejudicial or offensive); this link could be established officially or informally by means of customary law or practice.

### China

For patent documents, in terms of classification of subject matter; for non-patent literature, in terms of keywords, and will think of using the new classification system for TK which is under discussion in WIPO. In cross technical field, search need to be broadened.

### Colombia

In principle, in order to carry out the search the following sequence is followed:

- Determining exactly the subject matter of the application, for which reason the claims filed are taken into account in the light of the description and the drawings where appropriate.
- Once the subject matter of the invention has been identified, the examiner determines the international classification of the application.
- A first search is carried out using key words or combinations thereof.
- Analyzing from the results obtained within the first search the most frequently used international classification, which will give us another starting point and comparing

that classification with that granted initially by the examiner in choosing which classification is most appropriate to the technical field sought.

- A further search is carried out combining the most relevant international classification and the key words relating to the title, summary and complete texts where possible.
- In accordance with the results, it is probable that the search will be carried out once again using other key words, synonyms and so on.
- The search of all the prior art up to the filing or priority date is carried out.
- The search is carried out with the international, European and American classifications.
- The main databases to be taken into account are the national, European, American, Spanish, German and WIPO databases; this list is not exhaustive.

### Czech Republic

Combinations of IPC and ECL classifications, key words on the basis of the subject of protection.

The search minimum – classification retrospection from IPC (2) to IPC currently valid, at present IPC (7).

Scope – PCT, EP, DE, RU/SU, US, GB, CZ/CS.

Possible extension or narrowing of the search question depends especially on the search worker, his/her qualifications and experience.

The scope of searches and the search strategy depends on the complexity of the examined matter, to define search questions both key words and IPC symbols are used while using operators of Boolean algebra, proximity and relational operators.

### Denmark

The searching is performed using the EPOQUE database. This database is fulfilling the PCT minimum requirement. Extended search using STN and for example Chemical Abstract is done in the technical area of chemistry.

### Egypt

The scope of search for prior art is using classification of subject matter according to IPC.

### Eurasian Patent Office

The answer to the first question is contained in A12. The standard search strategy is a search for key words.

### European Patent Office

The scope of a regular search is the widest possible. Relevant classification can be used as a search tool but is by no means an exclusive source of documents.

The objective of the search is to discover the state of the art which is relevant for the purpose of determining whether, and if so to what extent, the invention to which the application relates is new and involves an inventive step. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by economic

considerations. Each case has its own merits and the examiner will define the search strategy *ad hoc*, generally in the systematically classified documentation, in specialized databases through key-words or full-text search and on the Internet. The European search is essentially a thorough, high-quality, all-embracing search. Nevertheless, it must be realized that in a search of this kind, 100 % completeness cannot always be obtained, because of such factors as the inevitable imperfections of any information retrieval system and its implementation. The search should be made on the basis of the claims, with due regard to the description and drawings (if any), (Art. 92(1) EPC). For details concerning the general search strategy at the EPO see the Guidelines for Examination in the EPO, Part B, Chapter IV, 2. available under <http://www.european-patent-office.org/legal/guidelines/index.htm>

Since in the filed of genetic resources and TK the closest prior art is not necessarily to be found in conventional prior art sources, the search strategy is adapted and extended accordingly (see answer to Q.13).

### Fiji

The scope of our search is limited since we do not have a national database up and running from which to make definite identifications and would need to rely on public knowledge to substantiate prior art.

### Finland

The purpose of the search is to find everything useful for assessing novelty and inventive step. The search strategies depend on the field of technology and we make use of any material and any sources available for us.

### Georgia

The scope of the regular search for prior art is in the terms of classification of subject matter. The standard search is determined in Rules on drafting, filing and examining of inventions, importation patent, utility models and industrial designs and in the Annex to it. The search may be broadened or extended beyond the standard procedures, depending on a concrete case.

### Germany

The searches are comprehensive. The examining section must use all available technical means and information sources available by these means for the searches as far as it seems to accomplish success and can be done without undue effort.

### Iceland

Searched in classes and subclasses.

### Japan

(1) In principle, the relevant technical fields with respect to the respective claimed inventions should be set to the scope of the prior art search. The relevant technical fields include 1) the industrial field of application of the claimed invention, and the technical field determined by taking account of the problems to be solved and matters defining the invention,

and 2) the technical field determined by taking account of the use, operation, function, etc of the claimed invention.

(2) However, a part of the scope of the prior art search may be excluded because of reasons of economy, unless it is judged to have the high probability of finding the relevant prior art documents based on the knowledge and expertise of the examiner himself skilled in the art.

#### Republic of Korea

All of the databases and search engines disclosed in A13 come within the scope of searching for prior art.

#### Malaysia

Key words and International Patent Classification(IPC). Broaden the search strategies by key words.

#### Mauritius

Note: not applicable in view of the fact that our office does not itself conduct search and substantive examination but takes into account international search and examination reports during decision making process.

#### Mexico

One of the main elements for conducting a prior art search is the patent classification in which the invention to be assessed falls.

The prior art is determined which will be used to assess whether the invention complies with the patentability requirements and whether or not it is one of the exceptions provided for by the Industrial Property Law.

Searches are broadened or extended beyond the standard procedures in cases where the international search report (PCT) is only a partial report for some reason, for example unity of invention and in Mexico a different invention is claimed. Or where sufficient technical evidence exists to carry out an additional search.

#### Republic of Moldova

The scope of the regular search is defined in the Regulations, Rule 67.4, and includes at least the following patent document collections:

- (a) patent and published applications of MD, FR, DE, CH, CB, US, RU, SU, WO, EP, EA;
- (b) utility model certificated and published applications of MD, RU, FR;
- (c) author certificate of SU.

The search is conducted in terms of IPC allotted symbols and keywords.

The search strategies are defined in the office Guidelines, chapter III, and are identical to the same described in the Guidelines for Examination in the EPO, B III, 3 and B IV, 2.

The search first cover all directly relevant fields, but taking account of the obtained search results the examiner may extend the search to other relevant areas where it is expected to be highly probable to find relevant documents.

The international search reports under the PCT are formally recognized, but a supplementary search is always conducted for MD and EA patents; the search reports from other patent offices could be used as informal background information.

#### Norway

The searches are carried out on the basis of materials which may contain documents which concern the invention. The searches are primarily directed to the most relevant technical fields, but could be broadened or extended to analogue technical fields.

#### Panama

In the case of filed patent applications claiming priority, we try to locate the search reports of national or international offices of the countries where the applications have been filed. In the case of applications which do not claim priority or where a search report is not located, searches are conducted as follows: by classification, keyword, inventors or owners. Searches are broadened beyond the traditional procedures where we consider that the resources within our reach are not sufficient to exhaust the search and, in such cases, we request WIPO's assistance.

#### The Philippines

In terms of classification of the subject matter. Use of "catch words".

#### Poland

There is no, strictly stated, scope of prior art search. It is up to the examiner to decide in which classes the examination will be conducted. Bases for the search report are available, in English, German and French, at the PPO's collection of patent literature. All applications and patents granted are also available in the Polish language.

#### Portugal

Portuguese examiners use electronic databases such as internet. EPOQUE and internal PT Offices' databases that can be consulted by keywords and international patent classification.

#### Romania

The search fields usually used in documentary search are the key-words or the international classification.

The search strategies currently employed are indicated in the OSIM Guidelines for examination, in the Section "Norms regarding the documentary search", and for the purposes of establishing the prior art the EPOQUE strategy for example is used.

The documentary search is extended when there is a doubt regarding the fulfilment of the patentability conditions.

### Russian Federation

In order to characterize the information search field (all the areas of science and technology for which information is covered when establishing prior art for a particular application), the index headings of the International Patent Classification (IPC) are used.

When defining the field of an information search, the subject matter of an invention is taken into account as a whole together with its functionally independent features, distinct from the closest analogue. When determining the field of an information search the functionally independent features common to the invention and the closest analogue are also taken into account, where distinguishing features relating thereto exist but which are not functionally independent. A search of these features is conducted in both well-known subject matter and also in parts which bear no relation to the purpose of such subject matter and the components thereof.

An information search is conducted at least within the scope of the following documents, backdated where possible to 1920:

- Official Gazettes of the federal executive intellectual property authority and also of the former USSR Patent Office;
- descriptions relating to documents providing protection in the USSR and the Russian Federation;
- descriptions relating to Eurasian patents;
- applications for the grant of Russian Federation patents for inventions and Russian Federation patents and certificates for utility models, available for consultation by third parties;
- published applications for the grant of Eurasian patents;
- patent documentation from the United States of America, United Kingdom, Germany, the former West Germany, France, Japan (within the scope of abstracts in Russian and English), Switzerland (in French and German), Austria, Australia and Canada, and also patent documentation from the European Patent Office (EPO), WIPO, the African Intellectual Property Organization (OAPI) and the African Regional Intellectual Property Organization (ARIPO);
- non-patent literature according to the list published by the WIPO International Bureau, backdated at least five years.

Any publicly available documents may be included within the scope of an information search.

When conducting an information search within an information search for the purposes of verifying the novelty of a claimed invention, provided they have earlier priority all the applications filed in the Russian Federation by other persons for inventions and utility models are also included. Equivalent to applications filed in the Russian Federation are applications for the grant of USSR authors' certificates or patents for inventions, according to which requests for the grant of Russian Federation patents are submitted in accordance with the established procedure. Also taken into account are international applications for which the international filing date is established and in which reference is made to the USSR or Russian Federation as the State in which the applicant intends to obtain a patent, and also Eurasian applications converted into Russian national applications with the exclusion of those withdrawn by the applicant. Also included are inventions and utility models patented in the Russian Federation together with inventions patented in accordance with the European Patent

Convention, irrespective of whether information has been published on them at the priority date of the application on which the information search is being carried out.

The information search does not cease and is fully completed, even if in the process of the information search a means with the same purpose is discovered, characterized by features identical to all the features of the invention in relation to which the information search is carried out. The quantity of analogues identified in the process of an information search must be determined on the basis that full and meaningful information on the prior art is provided, without clear repetition and unnecessary duplication of information.

### Spain

A search is made using key words and crossed classification in patent databases, and key words in other databases.

### Sweden

The object of the search is to provide the state of the prior art in order to assess patentability, primary novelty and inventive step; the scope and strategy are determined on a case-to-case basis, see also Q13.

### Thailand

Claims, IPC, abstract, subject matter of invention are the scope of the regular search for prior art.

### Trinidad and Tobago

As many of the applications arrive already searched, there is very little extra searching that needs to be done. Most of our applications entail natural gas and petroleum exploration and production, related heavy downstream and energy intensive industries and pharmaceuticals. Typically searches are conducted in the online databases of the trilateral offices (USPTO, EPO, JPO). If prompted by suspicion, we may search online for commercial applications and notices that may give clues to GRTKF connections.

### Ukraine

A search is conducted on the basis of claims, taking into account the description and drawings (where they exist), and covers all those spheres of technology in relation to which the classification indices of the claimed invention are established; it may also be extended, where appropriate, to other spheres of technology to which the invention relates, taking into account its functions or field of application.

In order to relate an invention to a particular sphere of technology, it is classified in accordance with the latest version of the International Patent Classification (IPC). If an invention relates to several spheres of technology, all the appropriate classification indices are established.

For the purposes of carrying out a search, “key words” are also used, the presence of which is assumed in the information sought, the names of applicant firms and firms that own patents, and also the surnames of inventors.

The depth of a search is limited, as a rule, by the years beginning from which the corresponding sphere of technology began to be developed.



Venezuela

The prior art is classified by the industrial property office not by the applicant.

The standard search strategies or guidelines that are employed are national and international prior art searches.

Searches are broadened or extended beyond the standard procedures only for cases in which objections are raised and where there is merit.

Viet Nam

The scope of the regular search of prior art is mainly based on the International Patent Classification (IPC) and traditional medicine books published in Viet Nam.

- The substantive examination conducted to applications refers to TK in the same way as to other kinds of invention/utility solution applications.
- The broadened or extended searches beyond the standard procedures will be undertaken when examiners have doubt of the contents or the industrial applicability of the technical solution.

**Q15. WORK-SHARING AND TECHNOLOGICAL FOCUS**

Due to resource constraints or other practical limitations, does search or examination in your office concentrate on any specific areas of technology? Does your office make use of external search or examination results in any areas of technology, either as informal background information or through formal recognition?

Argentina

Not conducted. Only the studies envisaged in Article 27 of the RLP, referred to above, may be conducted.

Armenia

The search is carried out by the information materials, having at the disposal of the Agency, as well as the corresponding libraries of RA. In case of need the works of search can be ordered to an any international search body.

Advanced search is decided according to the developed period of the corresponding field of technics.

Australia

IP Australia examines all in areas of technology.

Although there is no formal recognition of external search results in Australia, IP Australia routinely considers external search and examination results, such as ISRs, IPERs, IPRPs, and foreign granted patents during examination of an Australian patent application. If these other searches have produced good citations, then IP Australia will not necessarily undertake further searches. In addition, Australia has a long standing modified examination system. Under this system, if there is a patent granted (in English) by the USPTO, Canadian Patent Office, New Zealand Patent Office, the European Patent Office, or a patent office who is a member of the European Patent Convention, and the Australian patent application is identical to the foreign granted patent, then the Australian patent application is only examined for novelty and inventive step. Patent applicants must specifically request that their application go through the modified examination process. The patentee of a patent that has undergone modified examination has the same rights in their invention as the patentee of a patent that has undergone full examination.

Austria

The search does not focus on a specific technological sector. There are no restrictions and each application will be processed. Search or external examination results are used only for additional information purposes.

Azerbaijan

Search or examination does concentrate on specific areas of technology. Our office makes use of external search or examination results in any areas of technology, either as informal background information or through formal recognition.

### Bangladesh

(i) No, we undergo patent examination in all areas of patents filing in the office according to the Patents and Designs Act, 1911 and Rules 1933.

(ii) No, we do the search and examine the documents and resources available in the office.

### Bolivia

In Bolivia, search concentrates on information via the Internet, owing to the aspects referred to. As regards the second question, Bolivia gives careful consideration to searches and examinations carried out in other offices, such as those of Spain, the United States and so on.

### Brazil

The INPI may occasionally use, as a support data, search and examination results from other patent offices.

### Bulgaria

Our office makes use of searching and examination in any areas of technology. Information of external search and examination results make use as informal background information not through formal recognition.

### China

No, the search in my office does not concentrate on any specific areas of technology. We only make use of external search or examination results as informal background information.

### Colombia

Search or examination in our office does not concentrate on any specific areas of technology.

Our office makes use of external search or examination results in any areas of technology, either as informal background information or through formal recognition.

### Croatia

According to our legislation there is a possibility to make use, in all areas of technology, of external search or/and examination results, from the national patent offices of other countries with which a cooperation agreement was concluded.

### Czech Republic

IPO CZ conducts search and examination within the whole spectrum of technology. IPO CZ does not assign any examinations or searches to be conducted externally. IPO CZ takes into account search reports worked out by other search bodies (such as EPO).

Denmark

The Danish Patent Office is searching and examining in all areas of technology. If available we use the PCT search result as informal background information.

Egypt

The search and examination, in our office, concentrate on all areas of technology.

Eurasian Patent Office

The Eurasian Patent Office examines inventions in any field of technology. A search may therefore be carried out in any field. In its work, the Office may use the results of an international or international-type search, as laid down in the established procedure. During an examination information may be disclosed on patents granted in accordance with an application examined by other regional patent offices and/or national offices.

European Patent Office

No. The Office treats applications from all fields of technology equally.

No, the Office does not make use of external search or examination results. All search requests are treated in house (see also answers to Q.14).

Fiji

In Fiji we rely mainly on the information provided by the AIPO, the United Kingdom and would be challenged to ascertain local applications.

Finland

Search or examination in our office does not concentrate on any specific areas of technology.

We make use of external search and examination results as background information.

France

The search report is drawn up in all areas of technology. The Office does not use the search or external examination results.

Georgia

No.

Germany

The DPMA has experts in all fields of technology. Consequently, the searches can be conducted in all areas of technology. Searches from other patent offices will be taken into consideration by the patent examiners in the patent search and supplemented, if appropriate.

Italy

In our Office there are two teams dealing with patent subject matters classified according to the International Patent Classification (Strasbourg Agreement of 1971): the first

one deals with matters belonging to classes A, C, and D; the second one with matters belonging to Classes B, D, E, F G, and H.

Third parties, on the ground of any evident interest in the patent application can supply the Office with external search, but the Office is not obliged to justify its decision to the same third parties.

#### Japan

We conduct searches and examinations for all technological areas. Under formal recognition, we use external search results in many technological areas.

#### Kenya

No.

Yes

#### Republic of Korea

In conducting searches or examinations, we do not concentrate on any specific areas of technology.

To determine the patentability of a particular invention, we use as a reference the results of external examinations such as international search reports. We also conduct special searches and examinations for any prior art in the Republic Korea or in foreign countries.

#### Malaysia

No. Yes, we make use of external search or examination results as informal background information.

#### Mauritius

Note: not applicable in view of the fact that our office does not itself conduct search and substantive examination but takes into account international search and examination reports during decision making process.

#### Norway

No.

No, but search reports from other patent offices is used routinely independent of technology.

#### Panama

No, searches are made in CD-ROM databases held by our Office, paper documents, the national database and databases available free of charge on the Internet.

Yes, we frequently use the search reports published by the PCT, EPO and the Spanish Patent and Trademark Office (OEPM).

#### The Philippines

Yes. We use external search or examination results.

Poland

There are no restrictions regarding conducting the patent procedure with reference to, for instance, special field of technique.

For the time being the Polish Patent Office does not outsource searches.

Portugal

No. The Portuguese office does search and examination in all areas of technology. Search reports published by the EPO and IPERS are used as informal background information.

Romania

No, examination and search are not restricted.

Yes, external documentary search results, in any technical fields, are used as evaluation elements.

Russian Federation

Search and examination of inventions are carried out in all fields of technology. The results of an international search or international-type search are made known during an examination as ordinary information.

The Office has specialists working on the different headings and classes of the IPC.

Spain

No.

Sweden

There are no limitations regarding technology searched and examined at our office. We rely solely on searches performed at our office except for cases as mentioned in Q9.

Thailand

Yes, my office makes use of external search or examination results (Patent from foreign countries) in any areas of technology as informal background information and through formal recognition.

Trinidad and Tobago

The search and examination of this office is not concentrated on any particular area. It does make use of external search and examination results as part of the formal process. The legislation also allows the Controller to have any application examined by an external examination authority with which the office has arrangements to conduct such examinations.

Ukraine

No provision is made for the limitation of a search to particular fields of technology.

For the purposes of a substantive examination of an application filed in Ukraine, provision is made for using the results of an international search, an international-type search

and also a European search, if a report on any of these searches relating to the same application is submitted in timely fashion by the applicant.

The results of all the other searches conducted outside the Office may be used only as informal auxiliary information and are subject to verification.

Venezuela

No.

Yes.

Viet Nam

Recently, searches or examinations conducted within NOIP mainly focus on the area of herb medicines.

## PART IV: OTHER ISSUES CONCERNING PATENT PROCEDURE

*The questions in Part IV concern other procedural and practical issues that have arisen in discussion on improved search and examination procedures relating to TK and genetic resources.*

**Q16. INVENTORSHIP AND ENTITLEMENT TO APPLY**

Is inventorship or the applicant's entitlement to apply substantively considered during patent examination, either routinely or exceptionally? If it is done exceptionally, what triggers this consideration?

(i) If a prior art publication, document (such as a legal agreement) or other information is available to your office which appears to provide evidence that a patent application:

- incorrectly names the inventor(s); or
- is submitted by an applicant who is not entitled to apply for or be granted a patent;

is this an adequate basis for your office to reject the application?

(ii) Would your answer differ if the information is publicly available or not?

(iii) If there is substantive consideration of inventorship and entitlement to apply, and there are grounds to believe that a person other than the applicant would be entitled to receive a patent (or a share of a patent), is it possible for the patent to be issued in the name of that party, or to be transferred to that party?

Argentina

(i) When a patent application is filed, the formal data concerning the applicants is analyzed but no attempt is made to ascertain whether the person named in the application is actually the inventor. It is presumed that the person mentioned as such is the inventor, unless evidence to the contrary is provided as the result of a process which the real inventor must initiate.

Article 9 of the Patent Law establishes: "Unless otherwise proven, the inventor shall be presumed to be the natural person(s) who is (are) designated as such in the patent application or utility model certificate...".

- Incorrect naming of inventor and/or inventors:
- Where the name of the inventor is incorrectly recorded, formal correction will be made by means of justified rectification in the corresponding documentation.
- Where an invention is applied for or a patent granted for an invention, and a person is named in the application as the inventor without actually being such, the real inventor may initiate relevant legal proceedings so that he is recognized as such.

Applicant who does not have the right to file an application:

Should a patent be applied for by an inventor who is not actually the inventor, the application will be accepted and processed accordingly, until such time as the real inventor proves the opposite.



Where the matter is corroborated by the established procedure, the office will change the name of the inventor.

(ii) No, the answers are always given with information that is publicly available.

(iii) According to the answer given in (i), no examination is conducted with regard to the inventor. Where a patent is granted in the name of a person who is not the inventor, if the opposite is proven by means of due process a change is made to the name in favor of the real inventor.

#### Armenia

Inventorship or the applicant's entitlement to apply is not considered during patent examination. It is considered in legal form.

#### Australia

No. The patent applicant must supply a "Notice of Entitlement" that is, a document stating their entitlement to apply for the patent. Examiners will ensure that a Notice of Entitlement has been filed, but do not do a substantive consideration of the veracity of the statements in the Notice. However, if an examiner becomes aware of evidence to the contrary, the examiner will report on this issue.

Although there is no substantive consideration of entitlement during the examination process, the Patents Act does have a mechanism that allows third parties to dispute ownership of a patent application or a patent. If a person disputes ownership and is able to demonstrate their entitlement to the invention, the Commissioner of Patents or courts may either decide that the application proceeds in the third party's name or that the third party may file a new application retaining the priority date of the disputed patent application or patent.

#### Austria

Inventorship and the applicant's entitlement to apply for a patent are examined only in exceptional cases.

It is not mandatory to designate an inventor.

If the inventor who is designated on the application is identical to the applicant, this matter is not examined.

The applicant's entitlement to apply for a patent is not examined regularly (apart from in the case of nullity or opposition proceedings — at the request of a person who is entitled to obtain the patent).

If priority is claimed in which the owner differs from the current applicant, the applicant's entitlement to apply for the patent is examined substantively. However, this is not used as a basis for rejecting an application.

As regards the designation of an inventor, it is mandatory to supply an official reference to the inventor, if the applicant and the inventor are not identical or if there is more than one inventor. In this case, the official designation must be signed by each inventor and each applicant.

(i) in cases where a document appears to prove that a false inventor is designated, or the application is filed by an applicant who is not entitled to apply or to obtain a patent, a substantive examination is conducted but this is not used as a basis for a rejection.

(ii) If the information concerning a false inventor is not made available to the public, the substance of this detail is not examined. This matter may be decided only during nullity or opposition proceedings.

If the information is such that an applicant is not entitled to apply for a patent, this matter will be dealt with during nullity or opposition proceedings. However, in this case it is mandatory to submit a request to that effect. The opposition proceedings may be instituted only after the information has been made available to the public.

#### Azerbaijan

(i) Yes.

(ii) Yes.

(iii) No. According to norms of prior use.

#### Bangladesh

Inventorship or the applicant's entitlement to apply substantively is considered during patent examination routinely.

#### Bolivia

There is no routine substantive examination of inventorship or of the right of an applicant to apply for a patent. Only in exceptional cases is this procedure carried out where an objection is raised to the patent.

(i) Through the examination of form, an initial request is made to correct the application and, where this is not possible, the patent is rejected directly.

(ii) Yes, since public documentation is required to justify the rejection of a patent application.

(iii) This substantive examination is not carried out.

#### Brazil

At the administrative level, there is no substantive examination of the inventorship or the applicant's entitlement to apply, due to a legal presumption that the applicant is entitled to be granted a patent.

Notwithstanding, Brazil believes that the question of the applicant's entitlement to apply is an important one in respect of claimed inventions relating to TK and genetic resources. Brazil is of the view that prior informed consent and disclosure by the patent applicant of the origin of the genetic resources and associated TK involved in the claimed invention is useful in supplying information that is relevant to cases relating, *inter alia*, to challenges to patent grants or disputes on entitlement to a claimed invention, as well as infringement cases.

(i) It is not a sufficient basis at the administrative level.

(ii) No.

(iii) It is not possible at the administrative level. Nevertheless, the issue is under discussion by Brazilian authorities.

### Bulgaria

The right to file an application shall belong to the inventor or to his successor in title. Where the right to file belongs to two or more persons it shall be exercised by them jointly. The refusal of one or more such persons to participate in the filing procedure or in the patent granting procedure shall not prevent the others from carrying out the acts set out in this Law. The applicant shall be considered to have the right to file unless otherwise decided in court proceedings. Where an invention is made on a contractual basis, the right to file shall belong to the commissioning person, unless otherwise provided in the contract. (Art. 13 of BPL).

The right to a patent shall belong to the person who has the right to file an application in accordance with Article 13.( Art. 14 of BBL )

Disputes to determine the true inventor shall be heard by the Sofia City Court.

The Patent Office shall enter the name of the inventor or inventors on the granted patent in accordance with the final court order. ( according Art. 60 of Patent Law )

Disputes concerning the right to file an application under Article 13 shall be heard in court proceedings or in arbitration proceedings. The Sofia City Court shall be competent to hear those disputes (Art. 62. of The Patent Law)

### China

Inventorship or the applicant's entitlement to apply substantively is not considered during patent examination in my office, any of such dispute is settled by the court or patent administrative authorities.

### Colombia

No consideration is given to what a substantive examination does: the examination is formal and routine in nature for each application filed, since it is verified whether the application contains the copy of the document recording the assignment of rights to the patent of an inventor to the applicant or his successor in title.

(i) The Office may, within the opportunities afforded by the Andean rules, request the applicant to clarify the inconsistencies found by the Office. Should the applicant not reply within the legal periods, the application shall be considered abandoned.

(ii) No.

(iii) Article 237 of Decision 486 establishes, in such cases, that: "where a patent or industrial design registration has been applied for and obtained by a person who did not have the right to obtain it, or with prejudice to another person who also had such a right, the affected person may claim it from the competent national authority, by requesting that the application being processed or the right granted be transferred to him, or that he be recognized as the joint applicant or joint rights holder". It should be pointed out that the competent national authority is the Justice Authority.

### Croatia

The inventor or his successor in title are entitled to require, through an action before the competent court, establishment of the right to patent protection of the invention, if a patent application has been filed by the person not entitled to such right or in the case of jointly created invention, by the person who is not the sole person entitled to such right. An action for the establishment of the patent protection rights may be brought up to the decision on the grant of a patent.

The inventor is entitled to require through a civil action before the civil court the ordering of the entry of his name into the patent application and all the documents issued for a patent as well as into the appropriate office registers, if the person mentioned as such in the application is not the inventor.

The same right belongs to the inventor of the joint invention who is not mentioned in the patent application. This is an action for the infringement of the inventor's moral right, and there is no time limit for that action. After the death of the inventor this right belongs to his heirs.

### Czech Republic

If the applicant is not the inventor or some of the inventors are not applicants, or if the applicant is not entitled to the patent in accordance with Section 9 of the Act, the application must be supported with the document on the acquisition of the right to the patent (for the purpose of submitting the patent application). The document on acquisition of the right to the patent is part of the patent application, if not, its submission is required within the preliminary examination before publication.

Name(s) of inventor(s) provided incorrectly are dealt with before publication through an application for data change. This data must be supported with a particular document, for instance a document on the acquisition of the right to the patent. Data provided incorrectly are definitely not a reason for rejection of the application. The right to the patent is regulated by Section 8 of the Act, the issue of the joint ownership of the patent by Section 16 of the Act.

Disputes concerning the right to the patent are settled by courts (Section 75, paragraph 3 of the Act).

### Denmark

The applicant's entitlement to apply is not considered substantively. If the applicant's identity differs from the inventor's identity the applicant is required to state that he has acquired a right to file the application. If the Office for any reasons has grounds for questioning the applicant's rights the Office can demand that the applicant substantiates his right to the invention.

(i) Should the office receive information which indicates that there exist doubts about the right of application, either by an incorrectly named inventor or by an applicant who is not entitled to apply for or be granted a patent, the office will request a document of title within a given time limit. It is thus a requirement that the applicant can prove the accuracy of the information given on the application form.

If the applicant does not succeed in proving or making probable the accuracy of the information given, the application will be rejected.

(ii) No.

(iii) The Office only transfers an application to a third party if it is proven that the third party has the right to the application.

This does in practice mean that the third party has to present a court decision whereby the right of the application/invention is transferred to him. The office can stop the handling of the case until a court dispute regarding the right to the invention has been settled.

### Egypt

The inventorship or the applicant's entitlement to apply is substantively considered during patent examination routinely.

### Eurasian Patent Office

The Eurasian Office does not give substantive consideration to questions of inventorship or the entitlement to be an applicant.

The Eurasian Patent Convention contains a direct standard whereby, for the purposes of Eurasian Patent Office procedure the applicant, i.e. the person filing an application, is considered to be entitled to file the application (and to be granted a patent).

Where disputes occur in relation to inventorship or the entitlement to file a Eurasian application or be granted a Eurasian patent, following the indications given by the inventors, applicant and patent owner the Eurasian Office is guided by the decisions of the courts and other competent bodies of Contracting States, in accordance with the national laws providing authority to examine such disputes.

### European Patent Office

According to the European Patent Convention, the right to a European patent shall belong to the inventor or his successor in title (Art. 60(1) EPC). Article 60(3) EPC contains a legal fiction of the applicant's entitlement: for the purposes of proceedings before the EPO, the applicant shall be deemed to be entitled to exercise the right to the European patent. This substantive entitlement is thus not being examined by the EPO. Any person, and not only the "de jure" entitled person pursuant to Art. 60(1) and (2) EPC can file a European patent application. It is however the responsibility of the party actually entitled pursuant to Art. 60(1) EPC to assert his right (see Art. 61 EPC: European patent applications by persons not having the right to a European patent and answer below).

(i) Prior art publication available appearing to provide evidence that a patent application:

- incorrectly names the inventor:

The EPC prescribes mandatory designation of the inventor (see Art. 81 EPC.). If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the European Patent. In accordance with Art. 62 EPC, the inventor has the right, vis-à-vis the applicant or the patent proprietor, to be designated as the inventor before the EPO. This right is executed by way of the mandatory provision under Art. 81 EPC even if the inventor himself does not assert the right. Art.

91(1)(f) and (5) EPC renders the failure to designate the inventor liable to a loss of the application.

- is submitted by an applicant who is not entitled to apply for or be granted a patent:

If a third party provides proof to the European Patent Office that he has opened proceedings against the applicant for the purpose of seeking a judgment that he is entitled to the grant of the European patent, the European Patent Office shall stay the proceedings for grant unless the third party consents to the continuation of such proceedings (Rule 13(1) EPC (see also answer to Q.16 (iii) below).

- (ii) No.

(iii) As already mentioned, it is the responsibility of the party actually entitled pursuant to Art 60 (1) EPC to assert his right. The EPO is therefore not involved in disputes concerning substantive entitlement to patent and such decisions are left to the competent national judicial bodies. Pursuant to Art. 61 EPC, if by a final decision it is adjudged that a person referred to in Art. 60(1) EPC, other than the applicant, is entitled to the grant of a European patent, that person may, within a period of three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognized, or has to be recognized on the basis of the Protocol on Recognition annexed to the EPC:

- (a) prosecute the application as his own application in place of the applicant,
- (b) file a new European patent application in respect of the same invention, or
- (c) request that the application be refused.

### Fiji

At present, the Act requires that the invention must be new and the applicant must be the true and first inventor thereof.

- (i) In Fiji, yes, since the Act provides that if the application contains any willfully false or misleading statement then letters of patent will not be granted. Any person aggrieved by the grant may seek redress in the High Court, which has the power to amend, cancel or revoke any letters of patent already granted.
- (ii) Even if the information is publicly available, our answer remains the same.
- (iii) All patents granted will only be issued in the name of the person who made the application however they can assign this right to others who may then apply to the Administrator General for such assignment to be entered in the registry.

### Finland

The entitlement to apply is not considered during patent examination. According to the Finnish Patents Act, anyone who wishes to have a patent application transferred to him or her, shall bring an action in court of law. If such action is brought, we will interrupt the prosecution of the application and continue it after the court has taken its decision in the matter.

France

INPI does not carry out a substantive examination of inventorship.

However, according to Article L. 611-9 CPI, “*the inventor, whether a paid employee or not, is mentioned as such in the patent; he may also oppose such a reference*”.

According to Article R. 611-17 CPI, “*the designation of the inventor may be rectified only on request, accompanied by the consent of the person wrongly designated and, if the request is not submitted by the applicant or patent owner, the consent of one or the other*”.

In all cases, INPI does not verify the accuracy of the designation of the inventor (Article R. 611-15 CPI). INPI does not examine either whether the applicant is entitled to the patent. If the application does not designate the correct inventor or if it is filed by an applicant who does not have the right to apply for or to be granted a patent, INPI cannot reject the application for these reasons since it does not verify the accuracy of the designations.

As regards the applicant’s right to apply for a patent in cases where the applicant has priority and is not the holder of the earlier application, the applicant must supply written authorization allowing priority to be claimed (Article R. 612-24(3)).

Georgia

- (i) in case there is a decision of Chamber of Appeals or court;
- (ii) in case there is a decision of Chamber of Appeals or court;
- (iii) in case there is a decision of court.

Germany

It is mandatory that the patent application contain the name of the applicant. Under Section 37 Patent Law, it is a legal obligation for the applicant to name the inventor or inventors and affirm that no other person has contributed to the invention. However, this requirement is not examined by the Patent Office during substantive examination under Section 7 (1) Patent Law. If a patent is granted to a person without entitlement, an opposition may be filed due to usurpation, which may lead to the revocation of the patent under Section 21 (1), item 3, Patent Law and give the opponent himself the opportunity to file an application in respect of the invention under Section 7 (2) Patent Law.

Iceland

Routine check. The Applicant has to inform on how he got the right to the invention but does not have to prove it in writing unless specially asked for.

(i) The application can be rejected if the applicant is not entitled to the invention. If the question arises that the inventors are incorrectly named, the applicant would have to give evidence of his right to the invention with handwritten statements from the inventors. If he can not provide this, the application might be rejected.

- (ii) No.
- (iii) Yes.

Italy

Inventorship and entitlement to apply are not substantively considered during patent examination.

Whoever it may concern can appeal the Court.

Japan

Inventorship or the applicant's entitlement to apply is substantively considered during patent examination routinely.

(i) When an examiner finds such information reliable, the information will be recognized as providing grounds to refuse the application.

(ii) No. Regardless of whether or not the information is publicly available, such information mentioned in item (i) above will be recognized as providing grounds to refuse the application.

(iii) If the applicant of the application concerned carries out the procedure to add an amendment to change the name of the applicant into the person, other than the applicant himself, who is justifiably entitled to receive a patent, a patent will be issued in the name of that person. If the procedure is not followed by the applicant, the application will be refused.

Kenya

(i) Yes.

(ii) No.

(iii) Ordinarily the first to file principle gets the patent invalidation is only allowed after grant.

Routinely Rule 34.

Republic of Korea

Although a misappropriated application comes under the legal reasons for refusal or grounds for invalidation, the judgment on the application is conducted only in special cases; for example, when a third party offers information.

We can use a misappropriated application as grounds for refusal regardless of whether the information for proving that the application was misappropriated is open to the public.

The determination of whether an application was misappropriated comes under the standard of judgment for the patentability of an applied art. However, whenever an application is determined to have been misappropriated, the right of the application is not naturally transferred. The proper applicant should separately apply for a patent to get the right.

Malaysia

No.

(i) No.



- (ii) No.
- (iii) Any person can request to the Court to transfer the rights of the patent owner.

### Mexico

No. In the application form the name of the inventor and that of the owner of the invention is requested. Where the inventor is not the owner, the transfer of rights is requested.

- (i) No.
- (ii) No.
- (iii) No.

### Republic of Moldova

It is mandatory that the application designate the inventors. If the applicant is not the inventor or is not the sole inventor, the request for the grant of a patent must contain a statement indicating the origin of the applicant's entitlement to apply.

(i) The national legislation provide only the situation where by a final decision it is adjudged that the applicant who has the right to the patent is other than the applicant who has applied for, such person may, as one of alternative acts, request that the application be refused.

(ii) The public availability of information is not a condition for proof of right to a patent.

(iii) It is a similar situation as described above (see Q. 16 (i)); the two other alternatives are the following:

- to prosecute the application as his own application in place of the applicant;
- file a new application in respect of the same invention; in such case the application takes the date of the original application.

In both cases the patent should be issued in the name of the person who was recognized as having right to the application.

### Norway

Exceptionally.

(i) No, the application may instead of being refused, be transferred to the person entitled to the invention if he so requests. However, if the question is found doubtful, the party concerned is invited to bring the matter before the court.

- (ii) No.
- (iii) Yes (see above).

### Panama

Our legislation routinely includes, among the requirements for filing a patent application, the fact that when the owner and the inventor are not the same person, the owner must supply the respective transfer document or any document sustaining his entitlement to apply for a patent.

(i) these are not rejection criteria, since our legislation envisages that nullity is within the competence of the courts of justice.

Where it is demonstrated that a grant was made in contravention of legal provisions and where a grant has been made to a person who is not entitled to obtain a patent.

(ii) No, the response would be the same.

(iii) No, the patent is granted to the person who applied for it.

### The Philippines

In our law, no patent may be granted unless the application identifies the inventor. If the applicant is not the inventor, the Office may require him to submit said authority.

### Poland

If the Office has reasonable doubts for instance, under the available documentation, it can ask an administrative authority or a juridical authority to ascertain the proper name of the inventor.

Under §22 of the Prime Minister Regulation of 17<sup>th</sup> September 2001 (OJ 2001, No. 102, text 1119) on lodging and processing of patent and utility models applications, the Office can invite an applicant to provide the Office with proofs, inter alia regarding rights to the patent.

Under Article 78 PIPL “where a patent application has been filed or a patent obtained by a person not entitled thereto, the entitled person may demand that the patent granting proceeding be discontinued or the patent granted be revoked. He may also demand that a patent be granted in his favor or that the patent already granted be transferred to him against reimbursement of the incurred costs of filing of the application or of granting the patent”.

Under Article 284 PIPL “ascertainment of the authorship of an inventive project and ascertainment of the right to a patent, a right of protection or a right in registration, shall be decided in civil law procedure in accordance with the general principles of law”.

Under Article 11 PIPL “the right to obtain a patent for an invention shall belong to the creator”. When an applicant is not a creator, he should present the legal basis for patent. If an applicant will not do it, according to §32(2) pt. 3 of the Regulation, the Office will deny granting the patent.

In case of serious doubts the Office itself can refer to the Public Prosecutor’s Office, while suspending the processing of the application at the same time.

### Portugal

Yes, exceptionally in case of opposition.

(i) Yes.

(ii) No.

(iii) Yes.

### Romania

Yes. During the preliminary examination of the patent application, there are examined both the inventorship and the applicant’s right in the patent are examined, when the applicant

is not the same person as the inventor.

(i) No, it is not. If the inventors have assigned the right to be granted the patent before the filing of the patent application, the applicant shall file with the office the document proving said transfer, in order to prove that he/she is the person entitled to be granted the patent. If the document is not filed within the time limit notified by the office, the patent application shall be rejected.

(ii) No.

(iii) Yes. If the right to be granted the patent has been transferred after the filing date and the transfer document is filed according to the law, the patent shall be granted to the person which has acquired the right in the patent. If said document is not filed, the patent shall be granted to the applicant.

### Russian Federation

The Patent Office shall accept in good faith the naming of any natural persons in a claim as the authors of an invention. Disputes on the true authorship of an invention, where they arise, are not examined by the Patent Office but are settled in the courts.

### Spain

The applicant must declare in the application his right to the patent. If the applicant is not the inventor he should mention the name(s) of the inventor(s). The incorrect naming of an inventor would be dealt with by the courts.

### Sweden

There are two regulations in the Swedish Patent Act concerning inventorship and entitlement of patent applications namely:

If anybody claims before the Patent Authority that the proper title to the invention rests with him and not with the applicant, and if the case is deemed uncertain, the Patent Authority may direct him to bring action before a Court of law.<sup>30</sup>

If anybody proves to the satisfaction of the Patent Authority that the proper title to the invention rests with him and not with the applicant, the Patent Authority shall transfer the application to him, if he so requests.<sup>31</sup>

If a patent has been granted to a party other than the one who is entitled to the patent, the Court, upon an action brought by the one who is entitled to the patent, shall transfer the patent to him.

Moreover, if after a patent has been granted, and another person is entitled to the patent, the court, upon an action brought by the one who is entitled shall transfer the patent to the entitled.<sup>32</sup> If this patent has been granted to a person and the said proprietor has acted in good

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<sup>30</sup> Swedish Patents Act Section 17

<sup>31</sup> Swedish Patents Act Section 18

<sup>32</sup> Swedish Patents Act Section 53

faith, the action to transfer the right of the patent must be started within three years from the granting of said patent.<sup>33</sup>

#### Thailand

(i) Yes, if there is enough evidence that an applicant is not entitled to apply for or be granted a patent.

(ii) No.

(iii) Yes, it is possible.

#### Trinidad and Tobago

Applications or inventors are required to submit statutory declarations of ownership or inventorship, as the case may be. These statutory declarations are subject to their own criminal sanctions. As the effect of the statutory declaration is as if one swore an oath before the courts, a false declaration also has the effect on invalidating every document that preceded or accompanied it before the office, in addition to the aforementioned criminal sanctions. The office, in essence, would then be unable to rely on the evidence or documents before it and would have to reject the application.

Ownership would not be transferred on the basis of false declarations of inventorship alone. This would have to be done subsequently possibly by order of the courts.

#### Ukraine

At the formal examination stage, it is verified whether the application documents, including the request for the grant of a patent, contain information on the inventor(s) and applicant(s), whether their signatures are contained in the request, and whether the signature(s) of the applicant(s) are underneath the claims and the description of the invention.

The absence of such information, or its incomplete or contradictory nature may be the cause of a refusal to grant a patent if, in response to a request by the Office, the applicant has not eliminated this shortcoming within the prescribed deadline.

If the inventor and applicant are different people, during the formal examination process it is verified whether the request for the grant of a patent indicates the grounds for the establishment of the right to file an application and to obtain a patent. The absence of such an indication serves as grounds for sending to the applicant a preliminary opinion concerning the refusal to grant a patent. If the shortcoming in question is not eliminated within the established period, a decision is taken to refuse to grant a patent.

The authenticity of information is not verified.

Disputes relating to the authorship of an invention are settled in the courts.

If an application is filed in violation of the rights of third parties, the patent granted for such an application may be recognized as invalid by the courts.

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<sup>33</sup> Swedish Patents Act Section 52, fourth paragraph

Venezuela

Routinely.

- (i) If there is evidence of a lack of novelty.
- (ii) Yes, since if absolute novelty is not destroyed, nothing happens.
- (iii) No.

Viet Nam

The inventorship and the applicant's entitlement will be considered during the substantive examination. An invention/utility solution may be rejected if the author's name of this invention/utility solution is not correct or the applicant has no right to apply this application. With respect to an invention/utility solution application, if it is fully verified that a person has the rights to obtain the patent (or the rights over a part of the patent) other than the applicant of this application, the patent shall be granted or transferred to that person if he/she desires and fulfils all the obligations concerning this application/patent.

**Q17. SUPPLY OF PRIOR ART CITATION TO APPLICANT**

When prior art information is relied upon to reject a patent application is a copy of this information supplied to the applicant?

Argentina

Where a patent application is rejected on the basis of a prior art document, the applicant is supplied with a copy of said document.

Armenia

A copy of this information is supplied to the applicant in case of need.

Australia

IP Australia always identifies the documents that form the basis of an inventive step or novelty objection during examination of a patent application. IP Australia does not routinely supply copies of these prior art documents to patent applicants during examination of a patent. However, IP Australia does sell copies of patent literature and may supply a copy of a non-patent literature document to a patent applicant where that non-patent literature document is difficult to obtain.

Austria

During the examination, the applicant may be supplied with a copy of each document on request. An application is never rejected instantaneously, but only after an examination and an exchange of official letters to which the applicant may respond. Rejection occurs only after an examination.

Azerbaijan

Yes, on his requirement.

Bangladesh

Yes, an information copy causing prior art is supplied to the patent applicant stating the reasons of rejection.

Bolivia

Yes, the applicant is supplied with a copy or the source of the document containing the prior art, in accordance with Article 6 of Decision 486.

Brazil

Yes.

Bulgaria

Yes, a copy of this information is supplied to the applicant.

China

Yes.

Colombia

Yes.

Croatia

Yes.

Czech Republic

During the substantive (full) examination the applicant becomes acquainted, in the form of a report, with documents (numbers of files, or bibliographical citations) and their contents, which are relevant for the purpose of determining the novelty and inventive step.

Denmark

A copy of prior art information is always sent to the applicant in a letter together with the result of the search.

Egypt

Yes.

Eurasian Patent Office

Yes.

European Patent Office

Yes. According to Art. 92 EPC, a search report is prepared containing the results of the search. Immediately after it has been drawn up, the European search report is to be transmitted to the applicant together with copies of any cited documents (Art. 92(2) EPC).

Fiji

Yes it would and the applicant has the right to challenge this rejection in the High Court within one month after the Attorney General's decision.

Finland

The applicant can order copies of possible prior art citations already when filing the application, in which case the copies are automatically sent to him. He can also order them later during the prosecution of the application.

No new material is presented to the applicant in connection with rejection; all material has already been disclosed during the prosecution of the application.

France

As we have pointed out, the search report “*cites the documents which may be taken into consideration when assessing the novelty of an invention, subject matter of a patent application and inventive step*” (Article R. 612-57 CPI). A copy of the prior art is supplied.

Georgia

Yes.

Germany

The DPMA will supply the identified relevant prior art to the applicant.

Iceland

Yes.

Italy

Yes it is.

Japan

No, a copy will not be supplied to the applicant because specific information on prior art(s) will be contained in the written reasons for refusal which will be notified to the applicant.

Kenya

Yes.

Republic of Korea

Yes. We supply applicants with information on prior art that has been cited as a reason for refusal. We enclose the information in the notification of application.

Malaysia

Not applicable. Any rejected application is considered confidential and cannot be disclosed to the public.

Mexico

Yes.

Republic of Moldova

Yes.

Norway

Yes.



Panama

Once the prior art report has been produced, it is forwarded to the applicant so that he may make the observations and changes he considers relevant; the documents are only named in the report and copies are not supplied to the applicant.

In Panamanian law, patents are granted irrespective of the result of the prior art report, although they may be subject to a request for nullity in the ordinary judicial sphere.

The Philippines

The examiner cites prior art information.

Poland

The report, drawn up at the Office, is supplied to an applicant (without any copies of the colliding documentation).

Portugal

Yes.

Romania

Yes.

Russian Federation

At the applicant's request, he or she is provided with copies of reference materials.

Spain

Yes. The applicant is given a printed copy of each document cited in the prior art report.

Sweden

All prior art put forward by the patent office during search and examination, or by third party e.g. during an opposition procedure is supplied to the applicant.

Thailand

Yes.

Trinidad and Tobago

Prior art information used in the rejection of a patent application may be supplied to the applicant upon request.

Ukraine

An applicant has the right, within one month of receiving the corresponding Office notification, to request from the Office copies of the documents used in opposition to the application and serving as grounds for a refusal to grant a patent.

Venezuela

A reasoned decision is issued.

Viet Nam

The prior art information may be provided to the applicant upon his/her request.

**Q18. INFORMATION NOT AVAILABLE TO APPLICANT**

Can information available to an examiner but not necessarily available to an applicant (e.g. in a restricted database) be relied upon to reject a patent application?

**Argentina**

Information not available to the public may not be used as a basis for rejecting an application.

**Armenia**

Yes.

**Australia**

Yes, provided the document is publicly available. Note: We take the reference to “restricted database” to be a reference to a database that may not be freely accessible, for example only accessible on a subscription or pay-per-view basis (see response to Question 5(iv) above. If the document was truly unavailable to the applicant under any conditions, there would be a question of whether it was in fact publicly available.

**Austria**

The information taken from a restricted-access database (for example a fee-paying database) or literature which is no longer accessible may serve as a basis for rejecting an application. During the examination, the applicant may be supplied with a copy of each document on request.

**Azerbaijan**

Yes. However, in this case, the opposed material is not given to the applicant, and only accessible data is used and the information, which he can independently address to the holder of a database.

**Bangladesh**

Yes, rejections of patent application is done on the basis of the information available to the examiner.

**Bolivia**

Yes, because the information is considered to have been disclosed.

**Brazil**

Yes.

**Bulgaria**

No. Information should be available to an applicant to be relied upon to reject a patent application.

China

It is decided by whether the information is available to the public. If it is available to the public, but, for any reason not available to the applicant, it can be relied upon to reject a patent application.

Colombia

Yes and a copy is sent to the applicant.

Croatia

There is such a possibility in the case of refusal of a patent on the basis of lack of novelty [see answer Q3 (i),(ii)].

Czech Republic

If a particular document/particular documents is/are not available, the particular texts can be sent at the request of the applicant. Unavailability of documents for the applicant should not be a reason for rejecting the application.

Denmark

Insofar that this database is open to a larger or undefined group of people the answer is yes.

Egypt

All information is available to the examiners but not necessarily available to an applicant. We have restricted database.

Eurasian Patent Office

Yes, it can, because:

- (1) Eurasian Patent Office examiners use only information sources publicly available in the world and contained in databases with the possibility of official access;
- (2) Copies of references are supplied to the applicant, should he so request.

European Patent Office

Yes, provided that documentation of that information is supplied to the applicant.

Fiji

In Fiji's case yes, but this can be challenged in the High Court.

Finland

Any citation that may cause the rejection of an application must be publicly available information.

France

A response may be provided to the question on the basis of the assessment made of the “public nature” of the prior art (see question 5) and not on the basis of the open or restricted nature of the source.

Georgia

No.

Germany

Section 3 Patent Law is based on the premise that novelty is an absolute concept. That means that a patentable invention must be new compared to any technical teaching which has been made available to the public anywhere, at any time, in any way, before the relevant date of filing the application. It is irrelevant whether the individual inventor actually had knowledge of the relevant state of the art. That means that an application may be rejected on the basis of documents which the applicant did not know before filing the application, but could have known because they were available to the public. Of course, this does not apply to documents that have only been available on a secret, e.g. company in-house database.

Japan

A material should be available to unspecified persons to be used as a prior art. Therefore, any information inaccessible to an applicant by any means will not be used as a ground to refuse a patent application.

Kenya

Yes.

Republic of Korea

Although we encourage examiners to enclose prior art information in the notification of application, this practice is not obligatory.

Malaysia

No. Any restricted information cannot be used to reject patent application because that information is not available to the public.

Mexico

Said information may not be made known to the applicant until such time as it has been made public; therefore the possibility exists that said information is made public by some means and may be taken into account for a possible rejection of the application by the examiner and if said information is confidential, it may not be considered part of the prior art.

Republic of Moldova

Yes, with the exception where the database is restricted only for internal examiner's use.

Norway

Yes, if the information itself is available to the public.

Panama

No, as was mentioned in the response to question 17, in Panamanian law patents are granted irrespective of the result of the prior art report, although they may be subject to a request for nullity in the ordinary judicial sphere.

The Philippines

Yes.

Poland

All information which could constitute basis for refusal to grant a patent is provided to the applicant. If the applicant signals the lack of access to some documents, it is possible to provide him with copies of the document, drawn up at the Office.

Portugal

Yes.

Romania

Yes.

Russian Federation

Yes.

Spain

Yes.

Sweden

Only information that is or has been publicly available can be used as prior art.

Thailand

Yes.

Trinidad and Tobago

Only if it is an unpublished or ungranted patent application. Granted patents are public document.

Ukraine

Yes. A copy of a document containing such information must be submitted to the applicant, should he so request.

Venezuela

No.

Viet Nam

When refusing an invention/utility solution application, the examiner has to provide the applicant with all relevant details of the information source (title of documents, publication date, name of publishing house, etc.) as grounds for refusal.

## PART V: INVENTIONS BASED ON TK AND GENETIC RESOURCES

*The questions in Part V concern specific guidelines or mechanisms that are used during patent procedures; for example, one patent office has a division of specialists working on examination of patents concerning traditional medicine.*

**Q19. SPECIALIZATION ON TK AND GENETIC RESOURCES**

To what extent is a distinct or specialized approach taken for search and examination of inventions which are based on any area of TK or use certain genetic resources? In particular:

- (i) Are there any specific search guidelines or regular search strategies that are required or are employed for patent applications that include subject matter relating to or based upon TK or genetic resources? If so, please provide details.
- (ii) Are there specialist searchers or examiners, or search and examination groups, that concentrate on certain areas of TK (e.g. traditional medicine systems) or technologies based on or making use of genetic resources in a specific area (e.g. agricultural biotechnology)?

Argentina

- (i) No specific guideline or regular search strategy exists which is required or used in patent applications relating to subject matter based on TK or genetic resources.
- (ii) No specialist staff exist for search or examination procedures, or search and examination groups which focus on specific spheres of TK (for example, traditional medicine systems), or technologies based on genetic resources in a specific sphere (for example, agricultural biotechnology).

Armenia

There are no specific search guidelines or regular search strategies.

Australia

- (i) IP Australia has no specific search guidelines or regular search strategies that are required or are employed for patent applications relating to or based on TK or genetic resources.
- (ii) No.

Azerbaijan

- (i) No.
- (ii) There are experts.

Bangladesh

At present there is no specific search guidelines or regular search strategies that are required for protection of TK and genetic resources applied for patent application.



Bolivia

In accordance with the SENAPI Annual Operating Plan for 2004 and 2005, work is currently being done to devise the guidelines and strategies used to regulate the searches concerned with TK. Similarly, profiles are being drawn up for staff who will take charge of the searches referred to at the SENAPI National Office.

Brazil

The issue is under discussion by Brazilian authorities.

Bulgaria

No, there are no specific search guidelines and search strategies.

There are examiners that concentrate on certain areas of TK especially traditional medicine.

China

In my office, search for TMC patent applications must make use of the special database — “Chinese TMC patent database” and relevant non-patent literature databases. Up to now, there is no special guidelines for TK, but it is under consideration. We have special divisions in the area of Chinese traditional medicine, gene engineer and agriculture chemistry.

Colombia

No specific guideline or regular search strategy, either personal or specialized, exist in this area.

Congo

(i) No.

(ii) No.

Croatia

(i) No.

(ii) No.

Czech Republic

IPO CZ does not have any specific guidelines for conducting searches and examination in relation to TK and genetic resources. It does not have specialist searchers or examiners concentrating only on TK (traditional medicine). In IPO CZ the applications are allocated to particular searchers or examiners depending on their qualifications on the basis of IPC.

Denmark

No searcher or examiner is specifically concentrated on TK. Furthermore, we do not have any specific search guidelines or specific search strategies that apply to TK.

Egypt

- (i) No.
- (ii) No.

Eurasian Patent Office

During an examination on general grounds information constituting TK or genetic resources is taken into account and compared in the assessment of patentability, if the information is publicly available in the world, i.e. it relates to prior art.

- (i) The Eurasian Office does not have special guidelines relating to patent searches or a standard search strategy concerning subject matter relating to or based on TK or genetic resources;
- (ii) There are no such specialists.

European Patent Office

- (i) No. The general thorough, high-quality and all embracing search guidelines and strategies (see answer to Q.14) equally apply to all technical fields, including patent applications pertaining to TK or genetic resources.
- (ii) No, the EPO does not in principle foresee any specialization within the allocated competent technical departments.

Fiji

Fiji's work on TK and genetic resources is still at an infant stage and we have just began collating information to ascertain ownership so we do not have the capabilities to conduct a distinct or specialized approach for search and examination based on TK or the use of genetic resources.

Finland

- (i) Examination of patentability is in principle conducted in the same manner for all applications.
- (ii) In all technological fields the examiners are specialists in their particular fields.

France

There is no distinct or specialized search or examination process in the case of inventions based on TK or the use of certain genetic resources. The general guidelines are applicable. Examiners specialize in the field of biotechnologies.

Georgia

- (i) No.
- (ii) No.

Germany

(i) For the assessment of patent law aspects of inventions concerning TK or genetic resources the same examination guidelines for patent applications are applied as to all other inventions.

(ii) Each examiner carries out comprehensive searches, naturally taking into consideration TK insofar as it is available and relevant in his area of technology.

Ghana

These are based on the purpose and result to which the approach is to achieve its objective: being cured or methodology.

In particular:

(i) There are no specific search guidelines to be employed for patent application.

(ii) Yes in Ghana, we have two centers for research in plant medicine that are required to approve the authenticity of any TK (medicine) for societal group. It is with this that the local government has embraced.

Iceland

(i) No.

(ii) No.

Ireland

Please note that Irish Patent Office does not carry out search and substantive examination

Japan

(i) JPO has been preparing the files in each fields of the IPC for search strategies, which includes key words and databases often used for searching prior art. Therefore, we do not prepare the specific files in the fields of TK or Genetic Resources.

(ii) In the JPO, examiners are staffed by the field of technology according to the IPC. For example, we have examiners exclusively dealing with traditional medicine (ex: IPC A61K35/78, 35/00) and agricultural biotechnology (ex: IPC C12N9/, 15/, A01H1/00, 5/00). There are groups of examiners by the field of technology and they exchange information with each other.

Kenya

In our jurisdiction we do not have databases for TK therefore no experience.

Republic of Korea

There are no specific search guidelines for patent applications that include the subject matter of TK or genetic resources. Instead, if an invention is based on the TK of traditional medicines, we search for information on the prescription and usage of these medicines in documents and dictionaries of oriental medicine.

We have an abundance of specialist examiners who examine the fields of TK, such as traditional medicines and food, and the fields of genetic resources, such as biotechnology. These examiners work in divisions of our office such as the Pharmaceutical Examination Division, the Genetic Engineering Examination Division, and the Agriculture, Forestry and Fishery Examination Division.

#### Malaysia

- (i) Not applicable
- (ii) No.

#### Mauritius

Even if there are no specific search guidelines or regular search strategies which have been devised for patent search and examination, the Industrial Property Office would be in a position to refer patent applications whose subject matter relates to TK and/or use of genetic resources to the following bodies: The University of Mauritius — Faculty of Science; The Mauritius Research Council; The Ministry of Health. The above authorities are able to use databases/registries for searching and retrieving information which cover TK, Plant genetic resources, biological resources.

#### Mexico

- (i) Yes. The prior art search is conducted as a routine step for all inventions and in the TK databases available.
- (ii) Yes.

#### Republic of Moldova

- (i) No.
- (ii) No.

#### Monaco

Search and examination are not subject to any distinct or specialized approach for this type of invention.

- (i) No.
- (ii) No.

#### The Netherlands

(i) For applications relating to TK no specific search guidelines are currently in use. Searches are performed according to EPO current practice for applications in all technical fields.

(ii) No. Applications dealing with TK are dealt with by examiners within the chemistry division.

Norway

- (i) No.
- (ii) No.

Panama

- (i) No.
- (ii) No.

The Philippines

We have no specialized examination for patent applications that include subject matter relating to or based upon TK or genetic resources.

Poland

At the Polish Patent Office we do not have any special guidelines regarding examining the application within TK field and there is no special strategy on this matter. Furthermore, there are no experts in this field. There are, however, biotechnological and pharmaceutical sections with biologists, pharmacists and chemists which could examine such application. The rule is that a *patent for the solutions commonly known can not be granted*.

Portugal

- (i) No.
- (ii) No.

Romania

Traditional knowledge and genetic resources are not the object of a distinct or specialized procedure.

- (i) No.
- (ii) No.

Russian Federation

There is no special approach to the search and examination of inventions relating to TK and genetic resources. Such inventions are examined in the usual way.

- (i) No specific guidelines exist.
- (ii) The Office has specialists working on the different headings and classes of the IPC. Accordingly, inventions relating to TK and genetic resources pertaining to particular headings are examined by one and the same specialists.

Senegal

On subject matter, no, because in terms of current knowledge based on the Cartesian system, no method can yet protect subject matter linked to TK.

Very obvious knowledge and practices exist among wearers of ritual masks and night watchmen such as the Zangbéto in Benin. However, there is no way of protecting this knowledge or these practices, and their existence is merely noted, nothing more.

Our body PROMETRA International, which has subsidiaries in Africa, is fully able to create new foundations to protect TK and, above all, folklore. This is the case because not only is our office a scientific research body but also a body which conducts research applied to TK linked or directed to health and prevention, as well as being linked to cultural riches located at a horizontal (real world) or vertical (virtual world) level.

Our body is able to create the bases required by OAPI or WIPO in order to produce a census of TK and folklore in Africa or in indigenous societies. We have possibilities available, as well as researchers and resources, for validating and creating a validation framework for such TK.

#### Singapore

- (i) None.
- (ii) In Singapore, we do not have any in-house patent examiners.

#### Spain

(i) Yes, a specific guideline is used in relation to the clarity of the description; based on this requirement said information is requested if the description does not disclose the origin of the resource. Within the search strategies a search is made of non-patent literature databases.

- (ii) Yes.

#### Sweden

The search and examination of TK or genetic resources do not have any specific approach. When applicable, sequence databases are used or databases known to encompass TK, such as NAPRAAlert. As with other types of applications, the search and examination are performed by an examiner experienced in the particular field of technology of an application. Applications related to TK or genetic resources would often be classified in the field of pharmaceutical science or genetic engineering.

#### Tonga

Although TK has existed for years, it is not yet developed to be a subject for protection. Due consideration is however taken towards identification, maintenance and protection of TK and genetic resources.

#### Trinidad and Tobago

There are no special guidelines or specialist examiners to concentrate on TKF. However, examiners are sensitized to the need to confer when faced with such applications.

Turkey

(i) There are no specific search guidelines or regular search strategies that are required or employed for patent applications that include subject matter relating to or based upon TK or genetic resources.

(ii) A working group relating to Biotechnological invention, TK and Folklore is established in the Turkish Patent Institute. The Turkish Patent Institute has been working on disclosure of the geographical origin of biological material in the patent application.

Ukraine

The Office has had no experience of examining applications for inventions based on TK and genetic resources.

Venezuela

(i) Only a copy of the access contract is requested.

(ii) No.

Viet Nam

In Viet Nam, there is no specific legal provisions or specialist examiners that concentrate on certain areas of TK and genetic resources. We need:

- to have a specific examination guideline on TK;
- to build TK databases (electronic/on-line).

**Q20. PRACTICAL LESSONS**

Can you supply details of any cases in your jurisdiction that have illustrated:

- (i) significant legal issues concerning the status of certain TK as prior art; or
- (ii) problems concerning the practical availability for search and examination purposes of potentially relevant TK?

Please advise of any practical lessons or insights that can be derived from these cases.

**Argentina**

There have been no cases relating to the subjects referred to.

**Armenia**

No.

**Australia**

There are no cases that IP Australia is aware of that have illustrated any significant legal issues concerning the status of certain TK as prior art. The only decisions where TK was an issue (see Question 8) did not actually use TK to argue novelty and inventive step. As a consequence, no significant legal issues were identified in the decisions. There are no cases that IP Australia is aware of that have illustrated any problems concerning the practical availability for search and examination purposes of potentially relevant TK.

**Azerbaijan**

(i) No.

(ii) No.

**Bangladesh**

At present there is no such patent application concerning TK and genetic resources filed in the office.

**Bolivia**

As yet there have been no relevant cases in Bolivia. However, it should be pointed out that Bolivia uses Decision 391 of the Andean Community which establishes the protection of TK. Within that framework, legal mechanisms exist allowing holders of these intellectual property rights to claim, where appropriate, their best proprietary right in the patent procedure.

**Bulgaria**

There are no cases relating to problems with protection of TK and genetic resources in Bulgarian Patent Office.



China

With regards to the recognition of TK in patent procedure, the main problems are the following: there are few literature and database and only a small part of TK is recorded; no standard terms and uniform theories.

My office suggests that the recognition shall reflect the requirement of TK right holders, and shall also take account of the practical requirement of patent authorities, i.e. no extra and heavy burden; this kind of recognition shall support other means of TK protection.

Colombia

To date, no experience has been acquired in this field.

Congo

(i) No practical provision exists regarding the consideration of certain TK as prior art.

(ii) Yes, no TK database exists in the Republic of Congo. However, a certain amount of sectoral information does exist.

It is appropriate to specify that on a legal level, no law exists in the Republic of Congo to protect the holders or depositaries of TK. Article 68(2)(b), (c), (d), (e) and (f) refers to certain aspects of folklore, which are close to TK. This categorization facilitates the introduction of a legal instrument in the Republic of Congo. This is the case since the Bangui Agreement forms part of the legal texts which protect the cultural heritage in the Republic of Congo (see document relating to the Republic of Congo's contribution to the second session of the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore).

Croatia

(i) No.

(ii) No.

Czech Republic

None.

Denmark

No such case law exists.

Egypt

In our Jurisdiction Article (13) of Law No. 82 of 2002 concerns the status of certain TK as prior art.

Eurasian Patent Office

There are no such cases.

European Patent Office

All of the following files can be inspected via Online Public File Inspection under <http://ofi.epoline.org/view/GetDossier?dosnum=&lang=EN>

I. *Example of a patent revoked in opposition proceedings on the basis of a public prior use: NEEM OIL: EP 0436257 (application number 90 250 319.2): "Method for controlling fungi on plants by the aid of a hydrophobic extracted neem oil"*

European patent application 90 250 319.2 was filed on 20.12.1990. The European search report was dispatched on 17.5.1991 containing citations from patent and non-patent literature. For a full list of the documents cited in the European search report see the Online European Patent Register under <http://register.epoline.org/espacenet/regviewer?AP=EP19900250319&PN=&CY=ep&LG=en&DB=REG>

The initial claim 1 of the European patent application as filed read as follows:

"An insecticide and foliar fungicide comprising neem oil which is substantially free of azadirachtin and salannin, said neem oil prepared by:

- (a) extracting dried, coarsely ground neem seeds with a non-polar, hydrophobic solvent to obtain a neem oil extract,
- (b) removing the solvent to obtain the neem oil product."

During the examination procedure, following novelty objections of the examining division based on prior art citations from the search report (Art. 54(1) and (2) EPC), the applicant restricted the scope of the application to the fungicidal use of neem oil obtained by hydrophobic extraction of neem seed by amending the claims. The subject-matter was then considered to meet the requirements of the European Patent Convention (EPC) and a European patent was granted on 14.9.1994. In particular, in the prior art, azadirachtin was considered to be the antifungal component of neem oil. The examining division regarded as surprising that an extract free of this component was also active. Claim 1 as granted reads as follows: "A method of controlling fungi on plants comprising contacting the fungi with a neem oil formulation containing 0.1 to 10 % of a hydrophobic extracted neem oil which is substantially free of azadirachtin, 0.005 to 5.0 % of emulsifying surfactant and 0 to 99 % water".

The patent was jointly opposed by three opponents requesting revocation of the patent in its entirety on grounds of lack of novelty (Art. 54(1)(2) EPC), lack of inventive step (Art. 56 EPC), insufficient disclosure (Art. 83 EPC) and because it would be contrary to morality (Art. 53a EPC). The Opponents essentially argued that the patent in suit would threaten the livelihood of millions of gatherers of the neem tree. They further argued that the Indian people have used the neem tree for millennia in various fields of applications. In their opinion, using this free knowledge, would immorally exploit these known methods. In its written decision dated 13.2.2001, the opposition division (hereinafter "OD") stated that no direct connection could be established between the livelihood of a part of the people of India and method for controlling fungi by a special hydrophobic extract of the neem oil since neither the neem tree or the neem seeds as such nor the neem oil in general was claimed in the patent in suit. In addition, the OD pointed out that a European patent does not give to its proprietor any right to prohibit acts done in India, due to the principle of territoriality of patent

law. Moreover, the OD expressly agreed with the Opponents that no patents should be granted for anything which was known previously, for example as part of common TK. The OD indicated that under the EPC this was not a matter of Article 53(a) EPC (morality and ordre public), but a question of novelty, i.e. public prior use.

As regards the issue of public prior use, an affidavit from an Indian agricultural scientist had been produced as evidence by the opponents during the opposition procedure. Furthermore, during oral proceedings which were held on 9<sup>th</sup> and 10<sup>th</sup> May 2000 at the EPO, the author of said affidavit was heard as a witness. The basis statement of the Indian agricultural scientist both in the affidavit and his testimony was that field trials had taken place in summer 1985 and 1986 in the Pune and Sangli districts of Maharashtra, Western India, which were open to an unlimited number of local farmers and that a hexane extract (hexane is a hydrophobic solvent) of neem together with an emulsifying surfactant from Acida Consina or Tween®, a synthetic emulsifying surfactant, had been used for these field trials. In the testimony he further specified that the fungicidal effect under discussion had been observed essentially in the months of November and December and presented a list of 16 farmers plus their telephone numbers who were present at the trials, but also that he himself carried out some of the tests together with two farmers. Additionally, he stated that the farmers did not only watch the trials, but were given samples of the various extracts and the recipes to prepare.

The OD considered that it had been clearly established when and where the prior use took place and made clear that the trials were in fact made available to the public. The subject-matter of the main request was therefore considered clearly not novel over the prior art as represented by the affidavit submitted by the opponents and the testimony made during oral proceedings. The auxiliary request was considered novel over the prior art as represented the public prior use as the quantities of neem oil and emulsifier now claimed lied outside the ranges of this prior use. However, over the prior art as documented by the public prior use, the auxiliary request was found not to involve an inventive step. The patent was therefore revoked.

The decision is not final since an appeal was lodged against it. The case is pending before the Technical Boards of Appeal under file number T 416/01.

II. *Example of a patent application which was refused in examination on the basis of a written disclosure of TK: WO 98/46243 (EP 98917372.9): “Pharmaceutical compositions having appetite suppressant activity”.*

Application EP 19980917372 (EP 98917372.9) was filed on 15.04.1998. The international search report was dispatched on 11.1999 citing both patent and non-patent literature. For a full list of the documents cited in the International search report see the Online European Patent Register under <http://register.epoline.org/espacenet/regviewer?AP=EP19980917372&PN=WO9846243&CY=ep&LG=en&DB=REG>

This patent application claims the use of an extract obtained from a plant of the genus *Trichocaulon* or *Hoodia*, and of certain compounds isolated from these plants, as an appetite suppressant. The active ingredient in *Hoodia gordonii*, a South African succulent plant, is a steroid triglycoside named “P57”. The application pertaining to extracts of *Hoodia* and *Trichocaulon* useful as appetite suppressants was refused with decision of the examining division dated 3.12.2003 due to novelty and inventive step objections based on *inter alia* a

scientific publication (document D1 cited in the Search Report) describing traditional Knowledge and medicinal practice relating to *Hoodia* and *Trichocaulon*. The succulent in question was known to “quench thirst and hunger for extended periods”. It was known from prior art that the claimed genera contain ingredients which are appetite suppressing and the preparation of a sap or an extract having appetite suppressant activity was obvious for the person skilled in phytochemistry/phytopharmacology.

The decision is not final since an appeal was lodged against it. The case is pending before the Technical Boards of Appeal under file number T 543/04.

### Fiji

Our Courts have not been petitioned yet to adjudicate on this matter.

### Georgia

We do not have offers for lack of practice.

### Germany

(i) No.

(ii) No.

### Ghana

Yes the establishment of the center in Ghana that all traditional (medicines) knowledge be tested by the center for Traditional research in plant medicine for approval. Then given value to the TK in Ghana. E.g. Mampong Center for traditional (medicines) knowledge, in the Ashanti region of Ghana.

(i) There are enormous problem, i.e. the method of research conducted, lack of fund for the purpose to be researched into, physical equipment to test objective. The research in itself has a great tone on some experts in Ghana who are not financially equipped for the purpose.

(ii) There should be access to fund for the researchers in TK, so that the value we fight to protect will be worth. There should also be a way to improve TK in all aspects of the community, to improve the life of the local people.

### Iceland

No.

### Ireland

Please note that Irish Patent Office does not carry out search and substantive examination.

### Japan

In searches and examinations, examiners equally treat TK and other technologies as prior arts. Examiners can more easily conduct searches/examinations for TK recorded on written documents than that orally disclosed.

Kenya

None is available.

Republic of Korea

(ii) The main limitation in searching prior art concerns unpublished inventions based on foreign TK or genetic resources.

Malaysia

None.

Mauritius

The Industrial Property Office has only recently embarked in the implementation of the newly proclaimed Act dealing with Patents namely the Patents, Industrial Designs & Trademarks Act 2002. Consequently, it has no specific cases which illustrate significant legal issues concerning the status of certain TK as prior art.

Mexico

No information is available on these points.

Republic of Moldova

No cases in our jurisdiction.

Monaco

To date, no such problems have arisen for the Intellectual Property Division.

The Netherlands

- (i) No. To our knowledge there are no cases reported.
- (ii) Practically, searching TK patent applications will be problematic, since information on TK is generally hard to find in the public domain.

Norway

- (i) No.
- (ii) No.

Panama

- (i) No.
- (i) No.

The Philippines

No case yet that raises significant legal issue on the status of a certain TK as prior art.

Poland

There are no legal regulations on the status of TK. As mentioned above, only Article 77§ 1 of the Code of the Administrative Procedure states that the fact commonly known does not need to be proven.

“Guidelines for examining patent applications” under the former Law on Inventive Activity states, that the condition of applicability (the equivalent of the industrial applicability) is based on repeatability. Thus the invention, which would be based on the use of unique environmental conditions accessible only to the applicant, could not fulfil the requirement of the repeatability.

Portugal

No, there are no cases related to problems with protection of TK and GR in PT Patent Office.

Romania

- (i) No.
- (ii) No.

Senegal

In legal terms, certain TK is relevant. In certain communities, a court under the palaver tree, which takes place in the public square (penc in Wolof language, O Ngel in Seereer language) continues to exist. In case of dispute, one of the participants is seated on a perch over which hangs a beam that comes close to the participant’s head. If the participant angrily rejects an accusation and manifests this by wishing to stand up, he knocks against the beam for as long as he remains agitated and thus gradually regains his composure, imposed by his own will. There are traditional case law methods which are extremely rich.

Xoy is a community divination ceremony where the Saltigi, as grand visionary masters, excel. Xoy has a practical side since predictions are made as shown. As regards health, preventive measures are decreed to avoid epidemics.

Singapore

Nil.

Spain

No.

Sweden

No such illustrative examples exist in Sweden.

Tonga

Although TK has existed for years, it is not yet developed to be a subject for protection. Due consideration is however taken towards identification, maintenance and protection of TK and genetic resources.

### Trinidad and Tobago

This office has had no specific GRTKF cases as yet to examine. The Intellectual Property Office has been notified by South American NGOs of the existence of PCT applications embodying certain GRTKF information and extensive research, copies of which were provided to the office to serve as prior art if the application entered the national phase. However, there are some US patents that embody prior art related to the national instrument of Trinidad and Tobago, the steelpan. These patents are being considered for formal legal challenge before the USPTO and perhaps the US courts if necessary. It became apparent that the US examiners were unaware of where to find the relevant prior art. Compounding the issue was the dearth of published literature for searching purposes.

### Turkey

Assessment for databases and registries related to TK is an important problem.

Geographical origin of biological material shall be disclosed in the patent application.

### Ukraine

The Office has had no experience of examining applications for inventions based on TK and genetic resources.

### Venezuela

No such cases exist.

No compilation or defined authority exists.

### Viet Nam

In practice, during the examination of applications concerning TK, we are aware that most of these applications are involved in medicine containing pharmacological plant extraction.

As the examiner does not know the exact ingredients (on medical, for example) of this kind of medicine, he/she will consider the integrations of ingredients having that pharmacological character. Thus, this medicine will be considered as invention concerning a new substance (new product) and be examined carefully for novelty, inventive step, etc. (as herb medicine, medicine's effectiveness, steps of extracting or refining process, etc.). Therefore, the practical lessons resulted from the examination in this case are that in order to make precisely the prior art search, it is necessary to make classification of extracts in traditional medicines. In this case, there may be 3 kinds of extract:

- All the extract is made by regular extract methods (for example, by water or sloven, by temperature or at normal temperature).
- A part of the extract is made by specific extracting or defining methods (unusual).
- The extract is almost pure or all active elements are separated almost fully.

**Q21. SUGGESTIONS FOR GUIDELINES**

Based on the practical experience of your office, or based on other experiences and cases, do you have any suggestions for possible guidelines or practical recommendations for search and examination procedures concerning inventions based on or derived from TK or genetic resources?

Australia

Based on the experience of IP Australia, we do not have any suggestions for possible guidelines or recommendations for search and examination procedures concerning inventions based on or derived from TK or genetic resources.

As no judicial or administrative decisions have considered or identified any particular legal issues related to TK, there have been no suggestions for guidelines as a result of judicial or administrative decisions.

Azerbaijan

No.

Bangladesh

The Government of the People's Republic of Bangladesh has taken the issue of the protection of TK and genetic resources under active consideration and for that purpose, already a high powered technical committee has been formed to formulate the necessary rules and guidelines.

Bolivia

We can suggest the following:

Creation of a specific database on TK which contains contributions from other public and private bodies such as the Ministries of Environment, Agriculture, Indigenous Affairs, Health and Culture. It may also include contributions from territorial organizations of the originating peoples, and other organizations and sectors involved in the field.

Technical training for examiners conducting substantive patent examinations relating to TK.

Identification of official information channels on TK.

Establishment of promotion mechanisms and public disclosure of TK.

Brazil

The Government of Brazil believes that the establishment in all patent jurisdictions of a mandatory mechanism whereby patent applicants are obliged to disclose the origin of genetic resources and/or associated TK as well as prior informed consent and benefit-sharing will be of significant assistance to avoid misappropriation of genetic resources and/or TK.



## Bulgaria

There is no register of inventions concerning TK and genetic resources in Bulgarian Patent Office. Instead there are about 700 applications and patents which could be included in this field.

The Bulgarian Patent Office had always supported all efforts of WIPO to develop protection of IP in TK and genetic resources. Bulgaria is a country with a lot of genetic resources and many books concerning traditional medicine. We appreciate the need of national IP mechanisms for protection of genetic resources and TK and assume that it is very useful to clear the terms positive and defensive protection, effective date of TK, content of the disclosure, management of rights from defensive protection in the international dimensions

The Patent Office accepts the definition that “TK has been used secretly within a traditional community, in part to produce a medical cure, and some products of this use have been sold beyond the community; the users are under an obligation through customary law to limit the dissemination of the knowledge as such to certain authorized members of the community”.

## China

The possible guidelines shall be established on comprehensive analysis of opinions of TK right holders, patent authorities, patent applicants, and shall establish an international cooperation system. Furthermore, the possible guidelines shall also take the PCT system into account and give special suggestions for PCT reform.

## Colombia

The aims of search and examination procedures must tend towards the protection of TK and genetic resources. For this reason, the patent grant processes must be based on *sui generis* systems which retain a correlation with the specific conditions and contexts of each of the ethnic groups

## Congo

Suggestions concerning the guidelines: it is our hope that recommendations will be taken to support:

- the training of specialized examiners;
- the introduction of databases on TK;
- the drafting of relevant international legislation which will serve as a foundation for national legislation;
- the taking into account of the *disclosure* dimension as an element of the prior art in order to assess the novelty of TK;
- the setting-up, within intellectual property offices, of bodies responsible for examining patent applications relating to TK.

**NB:** We believe that the oral *disclosure* of TK should not be taken into consideration in the prior art, unless the knowledge has been made available to the public in a document, through an official conference or in the media. The oral channel refers to the verbal

transmission of knowledge from generation to generation. This point of view is explained by the fact that in developing countries, particularly in the Republic of Congo, a certain amount of knowledge has been handed down orally. If we consider that the knowledge handed down orally is included in the prior art, no title will be granted to our depositaries.

#### Egypt

All suggestions are under study and after that we will forward it to WIPO in advance.

#### Eurasian Patent Office

We do not have any suggestions on this subject.

#### European Patent Office

The practice of the European Patent Office adheres strictly to the legal principles and high standards laid down by the European Patent Convention. The European Patent Office is in particular performing high quality prior art searches thereby covering the maximum scope of prior art documentation. These searches are the prerequisite for the consequent examination of patentability which in turn, due to the very high patenting standards as regards novelty, inventive step and sufficiency of disclosure, ensures that genuine inventions are granted patent protection.

The EPO provides for a maximum of transparency and information on its activities. Patent applications are published 18 months after filing or after the priority date. Once a European Patent Application has been published, the file relating to it is open to inspection. This means that any member of the public can view the communications between the Office, its instances and the parties involved in the procedure. Such file inspections can be made online and are free of charge. Furthermore, all European patent applications and patents can be accessed on the Internet at [www.espacenet.com](http://www.espacenet.com), while any legal and procedural status information can be obtained from the EPO's epoline® server at [www.epoline.org](http://www.epoline.org) free of charge. Procedural information on any patent can be retrieved in the Online European Patent Register.

European patent law also provides for a highly developed system of legal remedies. Any person may present observations concerning the patentability of the invention in respect of which the application has been filed. In addition, any third party can file an opposition to a granted patent, without having to prove a direct interest in the case. The possibility of appeal exists both against the decisions of the examining and opposition divisions. Furthermore, proceedings to revoke the patent, even if its validity has been upheld in opposition proceedings and/or subsequent appeal proceedings, can be instituted in any designated Contracting State. It would be hard to imagine a more rigorous system of European and national controls and checks on European Patents.

This rigorous system of high quality search and examination in combination with the European and national controls and checks on European patents appears to be the most effective means to ensure that only genuine inventions are granted patent protection. Emphasis on any or — preferably — all of the above should be given top priority when dealing with inventions pertaining to TK and GR.

Fiji

One of the major problems that may exist at the moment is the extensiveness of the search and examination procedures carried out. For example in Fiji, we rely solely on the AIPO, however, we are not privy to the thoroughness of the checks they do. Would this entail considering records or specifications of all inventions based or derived from TK or genetic resources or is a search only made to ascertain whether they have been registered. If a search is done though, how thorough is it to detect any TK or genetic resources ingredient?

Germany

Special guidelines for the evaluation of patent law aspects of applications concerning TK or genetic resources do not seem to be required for the territory of the Federal Republic of Germany, since the assessment of patent law aspects regarding TK or genetic resources are already taken into account appropriately by the applicable guidelines.

Ghana

Based on recent calls, there should be appropriate systems for the promotions of traditional medicine, for it has been proven in Ghana that certain skin diseases have been eradicated through the use of traditional medicine.

All inventions should have a mechanism to be tested as in Ghana, for the purpose of TK.

What has also been set up in Ghana needs legal and government backing for promotion. As some universities in Ghana have introduced courses on TK, it should be done worldwide.

Japan

Even for inventions based on/deriving from TK/genetic resources, examiners should carry out search/examination processes under the standards applicable to all the technological fields (e.g: definition of a person skilled in the art and concept of prior arts).

Concerning the reference about the searching materials on TK, you may refer to the TK minimum documentation issues at the “Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA)”.

Kenya

No practical experiences.

Republic of Korea

The construction of well-defined databases of TK and genetic resources of each country is urgently required for more authoritative searches and examinations.

Malaysia

Databases of TK must be made available to the patent office.

Mauritius

No comments *pro tem*.

Republic of Moldova

No suggestions due to lack of experience in this field.

The Netherlands

The way TK is defined renders it virtually impossible to search for TK prior art, since prior art is defined as knowledge which is publicly available, whereas TK is often not publicly available and may be confined or kept secret among a specific group of people, tribe or community. Basically, if patent offices are forced to conduct searches on a TK aspect in particular, similar problems will arise as are already encountered by the USPTO when searching patent applications relating to business methods.

Panama

Recommendation: establishment of TK databases which are available for consultation and conduct of searches for the prior art report. Inclusion, in the search strategies and tools, of the TK and genetic resources databases which are available.

The Philippines

1. Availability of database/register of TK or genetic resources.
2. Disclosure of the source or origin of the genetic resources used in the invention.

Poland

It would be useful to prepare the practical guidelines for the examination within the field of TK, which would give the answers to the question posed in point 14 of the covering letter to this questionnaire.

Portugal

Creating a database with all genetic endemic species either of plants or animals that can be accessible by Internet or EPO Databases.

Romania

The office does not have sufficient experience yet, as the legal provisions according to which the prior art shall include TK are still recent (2003).

Senegal

Traditional knowledge is based mainly on indigenous science. Unfortunately, such TK has been affected by laws, after the Cartesian system, above all in relation to countries which were formally colonized and where repressive laws still exist.

The systems are a fundamental reality and must allow real human development. They must be protected within a new framework which is not that currently used by the Cartesian system, both within OAPI and WIPO.

A body should be created which can bring together, around a table and for a specified period, workshops allowing different groups to produce new legal frameworks which can enable the truthfulness and scientific nature of TK to be assessed.

A process such as  $A + B = C$  is called science, irrespective of the situation where this is repeated. If for example a given practice causes rain, whatever the place where this practice is carried out, it must rain.

With a scientific or technical process, based on Cartesian logic, it is impossible to find a legal framework to protect TK and folklore, since such knowledge is based on a different kind of logic, a different truth and a different rationality.

In order to create a legal framework and protect the other science it would be necessary to:

- prove that the other science is verified irrespective of the place where the same condition recurs,
- bring together around the same table intellectual property experts and experts who have worked in the field of TK for several decades, so that they may try to create a new system based on a precise scientific logic albeit different, in order to put in place appropriate legal frameworks allowing this TK, genetic resources and folklore to be protected.

Once such a framework is created, the beneficiaries will be determined according to the specific nature of the holder of the knowledge. Either he is individual or belongs to a community, or he is both. It is also necessary to strive to protect the ethnic group from which the knowledge comes.

### Spain

The examiners of these patents must be familiar with global issues and the aims of the Convention on Biological Diversity (CBD) in order to take account of such matters when examining patents. Database distributors, such as STN and Orbit, should include TK databases so that examiners use them when making searches.

### Sweden

To assist search and examination in this field it would be valuable for databases presently used by searching patent authorities to incorporate more journals and databases devoted to TK and genetic resources, thus creating a familiar interface for searching authorities, enabling an effective coverage of TK and genetic resources in the “normal” patent procedure and minimizing the risk of rights granted based on incomplete information.

### Tonga

Although TK has existed for years, it is not yet developed to be a subject for protection. Due consideration is however taken towards identification, maintenance and protection of TK and genetic resources.

### Trinidad and Tobago

Perhaps certain offices can offer their expertise in certain areas of GRTKF where their personnel may have better access to more obscure items of prior art and the relevant experts in those fields. For example, the Trinidad and Tobago Intellectual Property Office intends to make a similar offer to the USPTO regarding steelpan related patent applications in the future.

A list of the relevant expert bodies or offices can then be posted at a central point such as WIPO as to which authorities exist in certain areas of GRTKF prior art.

### Turkey

Search and examination report shall be conducted taking account of the TK and genetic resources. But it works only if all the member states of EPC and PCT revise their law taking account of TK and genetic resources.

### Venezuela

In accordance with the remarks made in the questionnaire, the procedure for TK or genetic resources is not well established and, for the time being, only compliance with the regime contained in Decision 391 is verified. In that connection, as regards patents relating to this subject, to the best of our knowledge to date a system for the exchange of information on authorized access contracts and intellectual property rights granted has been established.

An examination and study of TK or genetic resources should be made in order to establish which patents would be granted in each jurisdiction, in accordance with the laws in force and the relevant international agreements.

Specialized staff should be trained in this area, since that would greatly assist and improve the handling of the subject.

### Viet Nam

Based on the practical experience of our office, we have the following suggestions:

Patentability: The process of examination which applies to invention/utility solution applications concerning TK or genetic resources, is conducted as the process which applies to regular invention/utility solution applications. However, the examination of novelty, inventive step has to be considered taking into account the following:

- It is lack of novelty if an invention refers to a TK that just follows instructions in traditional medicine books or popular traditional medicines.
- If the new use of extract from herb is considered to have inventive step, the invention refers to this new use shall be deemed having novelty.
- If the use of extracts is already known, invention will be considered to grant patent only when it has strong pharmacological effects enough to be deemed non-obvious.

Specification: With reference to invention/utility solution applications relating to TK, the specification is made in the same way as other normal invention/utility solution applications. However, it is necessary to include some additional conditions, such as: pharmacological effects; quantity of useful active elements; direction of use; description of preparing methods; results of toxin tests.

Claims: The followings are some possible types of claims:

- Claims concerning “extracts”: it can be described as terms of “extract get by methods”, “extract is considered to have its compositions”, “extract with the consideration of its pharmacological use”.
- Preparing method (process) of the extract: the method used for preparing the extract is not normal method.
- Claims refer to medicine containing the extract.

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