



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

**EUROTAB 2/2000**

Orig.: German

Munich, 17.02.2000

---

## **EUROPEAN ROUND-TABLE ON PATENT PRACTICE**

9th meeting, Lyons, 25 and 26 May 2000

**SUBJECT:** The concept of novelty - differences between EPO and German practice

**DRAWN UP BY:** German Patent and Trade Mark Office

**ADDRESSEES:** Central industrial property offices of the contracting states

## The concept of novelty - differences between EPO and German practice

### 1. Legal provisions

The definitions of novelty in Article 3 of the German Patent Law (PatG) and Article 54 EPC are almost identical.

According to Article 3(1) PatG and Article 54(2) EPC, an invention is considered to be new if it does not form part of the state of the art. The state of the art is held to comprise 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. According to Article 3(2) PatG and Article 54(3) EPC, the content of earlier patent applications not published prior to the relevant date (implied state of the art) is considered as comprised in the state of the art. This provision can be found in the patent laws of all West European countries (Strasbourg Patent Convention, Article 4, BGBl. 7611, 658). A corresponding legal definition can also be found in Article 3 of the German Utility Models Act (GbmG).

### 2. Average skilled person

Technical teachings (inventions, technical disclosures and solutions to problems) are aimed at the relevant skilled person, who is defined on the basis of the technical field concerned and, as far as his qualifications are concerned, the technical problem which the invention aims to solve (German Federal Court of Justice (BGH), *Börsenbügel*, GRUR 78, 37; Luminescent security fibres/JALON, OJ EPO 1997, 24).

The average skilled person is able to clarify any confusion caused by disclosures using widely differing terminology, and to correct any inconsistencies or errors on the basis of the overall context (BGH, *Spannschraube*, Mit. 99, 304; *Stromversorgungseinrichtung*, GRUR 74, 149).

For an average skilled person, what is actually disclosed by a technical document is not only the actual information given therein, but also the information he can readily obtain from the document without any additional effort, that is what he can deduce from it on the basis of his assumed technical expertise, without taking individual details out of context. In other words, in addition to the actual information presented in a document, a skilled person also derives the information which he himself adds as a matter of course when reading it (BGH, *Neuheit*, Mit. 86, 69; *Cholinsalicylat*, GRUR 74, 332; EPO, Shear/GREHAL, GRUR Int. 91, H 11).

The European and German systems are based on what was actually known, ie on what the average skilled person actually knew, thought or did. When it comes to examining novelty, both systems take account only of the information directly and clearly imparted (see Guidelines for examination in the DPMA, C-IV, 7.2; BGHZ 76, 97, 103 - *Terephthalsäure*; BGHZ 103, 150, 156 - *Fluoran*).

Although the "skilled person" is not mentioned in the legal provisions relating to novelty, the legal definition of a skilled person is essentially that used in both older and more recent German case law. In other words, in the examination as to novelty, the skilled person is both the addressee and the reference point for the prior art disclosed to the public and for the industrial property rights filed with the various offices (BGH, *Elektrische Steckverbindung*, GRUR 95, 330; Rogge, "*Gedanken zum Neuheitsbegriff*", GRUR 96, 931). Because of this dual function, a uniform concept of disclosure must logically be used for both the invention and the state of the art (BGH, *Etikettiermaschine*, GRUR 81, 812; *Neuheit*, loc. cit.).

### 3. Prior art

From the legal definition of novelty it follows that any conceivable medium may be deemed to be a means for disclosing the state of the art, including all printed or other publications which can be perceived by sight, sound, touch, taste or smell. These citations must have been accessible for the public and perceivable in some way prior to the date of first filing of the application (for public prior use, see BGH, *Sortiergerät*, PMZ 72, 173; *Streichgarn*, PMZ 87, 203; *Lichtbogen-Plasma ...*, Mit. 96, 892; *Leiterplattennutzen*, GRUR 97, 892; EPO, 2 January 1991, Mit. 94, 16; Powered vehicle for operation of ladles, OJ EPO 1998, 421). In the case of joint projects involving several parties, both the German and European instances normally assume that there has been an implied agreement to maintain secrecy (BGH, *Hydraul. Kettenbandantrieb*, PMZ 78, 57; *Herzklappenprothese*, Mit. 99, 362; Power supply unit, OJ EPO 1992, 646; Secrecy agreement, OJ EPO 94, 713; Joint venture, OJ EPO 98, 161). A product which has been sold is state of the art if the skilled person can analyse and reproduce its composition or internal structure without undue burden (Availability to the public, OJ EPO 1993, 277).

4. Comparison for the purposes of novelty

The examination as to novelty is in practice defined by very clear principles. For example, individual comparisons are made with each citation. The subject-matter of an application is novel over a known embodiment even if only one of its features is different (see BGH, Bl.f.PMZ 1984, 332, 333 - *Zinkenkreisel*).

When the content of a single document is examined, the said content may not be treated as something in the nature of a reservoir from which it would be permissible to draw features pertaining to separate embodiments in order to create artificially a particular embodiment which would destroy novelty (EPO, Shear/GREHAL, GRUR Int. 91, H 11).

An interdependence of features exists where a teaching with variants whose broad disclosure in the state of the art signifies varied use, but which can destroy the novelty of the subject-matter of the claim if only one of its variants is known. A systematic range of variants may, like a dimensioning rule, be designated by means of a formula. Even if only one known subject-matter complies with this formula, such a claim is then no longer new (RG, *Sprengkammer*, PMZ 07, 107 and BPatG Mit. 80, 16). A dimensioning rule is considered new if its range represents a section of a previously published, undifferentiated overall range with no specific parameters (BGH, *Etikettiermaschine*, GRUR 81, 812). The same applies to ranges open at one end, which are defined by "at least", "at most", and so on, under certain circumstances, at their open end. Inventions lying significantly outside such a range may usually be seen as new (T 366/90, OJ EPO 1993, special edition - EPO Board of Appeal Case Law in 1992, 19).

In general it can be said that a general disclosure does not necessarily destroy the novelty of a subordinate, specific example. However, a general disclosure may regularly be used to mean only one specific embodiment. On the other hand, a general disclosure may describe a limited number of sub-definitions which are undoubtedly known in full to the skilled person.

The EPO does not base its examination as to novelty on photographic identity, but, for a subject-matter to be considered prejudicial to novelty, it does require a direct and clear description (explicit disclosure) of it which must be sufficiently clear and complete for it to be carried out by a skilled person (T 81/87, OJ EPO 1990, 250). Thus a merely implicit prior description cannot destroy novelty, for example in the case of unnamed equivalents (T 167/84, OJ EPO 1987, 369),

a specific definition in a general disclosure (Guidelines for examination in the EPO, C-IV, 7), chemical substances not mentioned by name, or substances connected by type but not named (see T 572/88, GRUR Int. 1991, 816).

According to Article 54(2) EPC, the state of the art comprises only that which was made "available". This may be seen in the context of Article 56 EPC (Inventive step), according to which an invention is 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, that is it is not readily available from the state of the art. "Available" in this case means that all the technical features of the claimed invention have to have been made available to the public in conjunction with one another in order for lack of novelty to be recognised. As far as the determination of the concept of novelty is concerned, reference should also be made to Article 54(3) EPC, the purpose of which is to prevent something being patented which already is, or could become, the subject-matter of another European patent (see Rogge, *"Gedanken zum Neuheitsbegriff nach geltendem Patentrecht"*, GRUR 1996, 931-940).

## 5. Differences

In Germany, comparisons for the purposes of novelty are undertaken by a skilled person as defined in section 2. Any differences arising from the examination as to novelty are compensated for in the examination as to inventive step when the differences between the subject-matter being examined and the prior published art identified as a result of the narrow interpretation in the novelty examination prove, in the examination as to inventive step, not to be inventive. However, this cannot happen where the citation is an earlier application (Article 3(2) PatG and Article 54(3) EPC), as such earlier applications are not to be taken into consideration when examining for inventive step (Article 4(2) PatG and Article 56, second sentence, EPC). As there cannot be different degrees of novelty examination depending on the type of citation, such examination must be uniform. The criteria applied when carrying out comparisons with earlier applications must, sensibly and logically, be in line with strict requirements in order to prevent double patenting. If a narrow definition of novelty were to be applied to earlier applications, this implied state of the art would be virtually meaningless, as the subject-matters of earlier applications are very seldom identical to those of an invention, and there are generally differences between them.

The stipulation in Article 3(2) PatG and Article 54(3) EPC is largely ineffective if inventions which differ little from the state of the art are deemed to be new.

On the other hand, when earlier applications are interpreted it should be ensured that specialist knowledge and skills are not overemphasised and that, in place of a precise examination as to novelty, considerations are actually made relating to inventive step (BGH, *Hüftgelenkprothese*, Mit. 86, 51).

In Germany (see BGH, GRUR 1995, 330 - *Elektrische Steckverbindung*), more prominence is given to the speculative element, as it is more likely that the general knowledge and know-how of the skilled person would be used as a substitute for what is explicitly and indisputably disclosed by the evidence available. In place of expert interpretation the EPO uses a straightforward comparison of text. Both approaches have advantages and disadvantages. It should be borne in mind that speculation as to the knowledge of the skilled person will always be subject to a certain amount of interpretation.

The EPO excludes speculative elements and reduces the consideration of the state of the art to a straightforward comparison of text. The know-how of the public beyond the simple noting of what is explicitly disclosed is irrelevant. In extreme cases the EPO requires a skilled person in an examination as to novelty only to ensure that the examination does not fail as a result of a lack of knowledge of the technical terms used. In Germany, on the other hand, the skilled person upon whose state of the art the determination of the missing features depends is the key factor in the determination of novelty.

## 6. Summary

In the interests of legal certainty, which is a very important factor for businesses in investment planning, European and German decisions should be uniform. European patents which may have been granted more readily not infrequently have difficulty surviving German revocation actions. A strict examination as to novelty according to statutory provisions is more likely to lead to stronger patents.

For the sake of completeness, it should be pointed out that German utility model law provides for a period of grace, for which there is no equivalent in the EPC.