

AIPPI
REPORT OF THE NETHERLANDS GROUP ON QUESTION 167

**‘CURRENT STANDARDS FOR PRIOR ART DISCLOSURE IN ASSESSING
NOVELTY AND INVENTIVE STEP REQUIREMENTS’**

This report is based on a draft prepared for the Netherlands group by a working group. The working group consisted of: D.J.B. Bosscher, J.L. Lobatto, H.A.M. Marsman, C.S.M. Morel, L. Oosting, H.W. Prins (chairman), F.I.S.A.L. van Velsen, R.E. Weening, and M. van Wijngaarden.

I LEGAL FRAME WORK

1. The Netherlands Kingdom Patent Act (ROW 1995) does not provide for specific protection of (the technical features of) utility models¹, nor does other Netherlands legislation. Utility models will not be dealt with further in this report.
2. As of the entry into force of the ROW 1995 on 1 April 1995, no substantive examination of Dutch patent applications takes place by the national Patent Office ("*Bureau voor de Industriële Eigendom*"). Until that time, applications were subject to detailed examination as to their compliance with the material requirements for patentability (primarily novelty and inventiveness). Material examination of patents granted under the ROW 1995 shall take place retro-actively by civil courts.
3. The ROW 1995 draws a distinction between patents for which the applicant requests the Office to perform a search of the state of the art with respect to the subject matter of the patent application prior to grant of the patent, and patents for which no such request is made. These latter patents are defined as so-called ‘short-term’ patents.
4. A ‘short-term’ patent shall be granted by signing and affixing the date to the application in the form of a patent specification. The short-term patent shall remain in force until the expiry of six years from the date of filing.
5. If a search of the state of the art is performed, the applicant is informed of the results by the Office prior to grant. There is no obligation for the patentee to take account of the results of the search. Patents for which a state of the art search has been performed shall remain in force until the expiry of twenty years from the date of filing.

¹ The aesthetic forms of an article model are protected on the basis of the Netherlands Copyrights Act or the Benelux Drawings and Designs Act and the doctrine of so-called shameless imitations.

6. A claim of the proprietor for infringement of a Dutch patent is only admissible in a court proceeding if the proprietor submits a search report on the state of the art with regard to the subject matter of the patent. This means that the proprietor of a short term patent has to obtain a search report before his claim is admissible in court proceedings.
7. Patent rights extending to the Netherlands territory can also be obtained via PCT and European Patent Office (EPC) applications.
8. In the Netherlands there can thus exist four kinds of patents: (1) a Dutch “short term patent” with a maximal duration of six years, (2) a Dutch patent with a maximal duration of twenty years which is the same for (3) a European patent where the Netherlands is designated, and (4) a patent filed via the PCT route in which the Netherlands is designated as part of the European patent region.
9. In a recent decision the Court of Appeal of The Hague held that patents granted pursuant to the ROW 1995 have the same legal significance as patents which have undergone substantive examination, such as European patents or patents granted under the previous Netherlands Patent Act 1910².
10. The ROW 1995 provides that inventions which are novel, inventive and susceptible of industrial application are patentable. Its provisions are applicable to all four types of patents mentioned above. A European patent – which has been subjected to substantive examination – designating the Netherlands has the same legal consequences as patents granted under the ROW 1995 and is governed by the same legal provisions. As far as nullity grounds are concerned, however, the ROW 1995 provides that patents shall be nullified if they do not comply with the material requirements listed in the ROW 1995, or, if it concerns European patents, with the requirements from articles 52–57 EPC. According to some this implies that case law from the European Patent Office (EPO) on issues such as novelty and inventive step should play a different role in Dutch legal proceedings dependant on whether a Dutch or European patent is at stake. In practice, however, the working group is not aware of substantial differences in approach in legal proceedings. EPO case law often plays an important role in Dutch legal proceedings, although it will not be discussed separately in this report.

² Court of Appeal of The Hague, 20 September 2001, Koppert/Boekestein. In The Netherlands all patent litigation is concentrated before the District Court of The Hague (first instance) and the Court of Appeal of The Hague (appeal). A final appeal before the Supreme Court is possible on issues of law only.

II. ANSWERS TO THE PROPOSED QUESTIONS

II.1 DETERMINATION OF PRIOR ART

Introduction

11. The Netherlands working group defined novelty, disclosure and inventive step as follows:

- (a) **Novelty:** “ Subject matter that is not directly, explicitly or implicitly derivable from the state of the art.”
- (b) **Inventive Step:** “The non-obvious solution of a problem given the closest state of the art in respect of said problem.”
- (c) **Prior art disclosure:** “Anything made available to the public by whatever means.”

The working group is of the opinion that the individual knowledge and capacities of the recipient are to a certain extent relevant to the question whether something has become available to the public. There is lower case law indicating that “made available to the public” means that random third parties must have had access to the information concerned and must have been able to realize what the invention consists of³. The working group takes the position that the information concerned should be reproducible by the recipient.

Question 1.1⁴

What is the effect of a prior art disclosure on novelty and inventive steps? Are there differences between prior art regarding novelty on the one hand and inventive step on the other hand? Do pending applications that have not yet been published affect the assessment of novelty and inventive step?

12. Each piece of prior art can be detrimental for the required novelty. For the establishment of inventive step, only prior art in the same or neighbouring technical fields (and addressing or relating to the same problem as the invention claimed) will be taken into account when examining the subject-matter of the patent or the patent-application. Prior art disclosures will not affect the inventive step when the prior art is in a remote field of the art or is in a neighbouring field, yet deals with a completely different objective (or problem.)

³ District Court of The Hague, 28 June 2000 and 14 February 2001, Texincare Sales/Deltex (currently being appealed).

⁴ The questions are numbered following the sequence and numbering of the Working Guidelines for Questions 167.

13. Article 4 (3) ROW 1995 provides that the state of the art shall also comprise the contents of previously filed applications that have been entered in the Dutch patent register on or after the date of application. Article 4 (4) ROW 1995 states that the state of the art also comprises the contents of European and international applications wherein the Netherlands is designated and have been published on or after the date of application⁵.
14. Pending applications that have not been published can thus affect the assessment of novelty .
15. Article 6 ROW 1995 states that such pending applications (whether national or international) belonging to the state of the art shall not be taken into consideration in assessing inventive step.

Question 1.2

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

16. Article 4 (2) ROW 1995 states that “*the state of art shall 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 the application*”.

Question 1.3

Which guidelines are used to determine whether a piece of prior art has been disclosed? This question focuses on guidelines other than those given by law, which have been developed in various countries for determining a disclosure.

17. There are no guidelines in the ROW 1995 other than the legal definition and the exception as set forth in Article 5(1) ROW 1995, namely the situation of abuse and the international exhibition exception.
18. From case law it appears that a piece of prior art is generally considered to have been disclosed if a random third party could have (had) access to the prior art. It is not relevant whether the third party has indeed noticed the prior art; essential is that the possibility existed. Hence, inclusion in a library makes a document publicly available, while submission to an individual who is not free to redistribute the document does normally not.
19. As set out above (paragraph 11(c)) the working group is of the opinion that the individual knowledge and capacities of the recipient and the ability to reproduce the information are relevant to the question whether something has become available to the public.

⁵ This corresponds to Article 54(3) EPC, which will however be changed following the Diplomatic Conference

20. There is first instance case law implying that the material of which a product (bed cover) was made that had been tested in a public area (a hospital), was not made publicly available because the users (medical personnel, patients) and visitors would not normally cut the cover open to investigate its contents⁶. Furthermore in another first instance decision it has been decided that an unknown process or product that is inherent to a known process is only considered to be part of the state of the art if the skilled person would have a reason to search for the process or product concerned and he could find the process without undue burden⁷. There is an ongoing discussion amongst legal practitioners in the Netherlands whether these interpretations of the state of the art definition are correct.
21. An example of an exception is the situation in which the applicant and a second party are contractually bound to keep a document or specific information confidential and this second party discloses the subject matter in breach of his contractual obligation. It is clear that such disclosure establishes an evident⁸ abuse as stated in Article 5 (1) ROW 1995 (corresponding to Article 55 (1) EPC). Consequently the disclosure is disregarded. If there is no written agreement, an implied confidentiality obligation can under circumstances be accepted if the existence of this obligation is made sufficiently plausible.
22. It is the working group's impression that the EPO is somewhat less strict than the Netherlands courts given that the EPO more quickly accepts the notion of implied secrecy. For example, results of a meeting between the boards of two USA companies were assumed to be confidential, though it will be hard to prove that parties meant to keep a discussed specific piece of information confidential⁹.
23. In this respect the Netherlands working group believes that Article 39 of the TRIPs Agreements may serve as guidance. Article 39 grants protection to undisclosed information. Article 39 (2) identifies when information is considered to be 'undisclosed'. Information is undisclosed as long as such information is secret in the sense that it is not, as a body or in the precise configuration of its components, generally known among or readily accessible to persons within the circles that normally deal with this kind of information and reasonable steps have been taken by the person lawfully in control of such information, to keep it secret.

of November 2000.

⁶ And thus, could not have realized what the invention consisted of; District Court of The Hague, 28 June 2000 and 14 February 2001, Texincare Sales/Deltex.

⁷ District Court of The Hague, 17 January 2001, Kirin Amgen / Genetics Institute.

⁸ In the Group there was discussion whether the right word is *evident*, and not *clear*. E.g. the different authentic versions and translations of the EPC give rise to this question. The Group did not come to unanimous decision whether evident vs clear implies a heavier burden of proof.

⁹ Case law: decision of the Opposition Division (Cordis / Terumo and Boston Scientific) of September 22, 2000 in view of EP 03362826.

II.2 CRITERIA FOR DISCLOSURE

Question 2.1 Means of disclosure

What are the recognized means of disclosure? Are there additional requirements for certain types of disclosure, such as oral disclosure or disclosure by use, when compared to disclosure through written documents? If certain means of disclosure are not recognized either by law or in practice, what are the reasons?

24. Article 4 (2) ROW 1995 indicates that disclosure can take place by a written or oral description, by use or in any other way. The means of disclosure are unlimited. The Netherlands working group is of the opinion that the means of disclosure are not relevant in order to determine whether information is disclosed. The definition of Article 4 (2) ROW 1995 implies that the disclosed information should be perceptible by sense. This should be taken literally: by hearing, vision, smell, taste etc. Any disclosure that is unrestrictedly perceptible or accessible by whatever means can be considered to be a disclosure in the legal sense. Thus the information derivable from an article sunk to the bottom of the ocean belongs to the state of the art if it can be reached and observed by any known diving technique.
25. It is further not relevant whether the proprietor of the information had an intention to disclose it. However, the Netherlands working group is of the opinion that it is relevant to what extent the proprietor of the information takes steps to protect confidential information (see also Article 39 TRIPS). Reference is made to a decision of the Netherlands Patent Board ("*Nederlandse Octrooiraad*") with respect to a potato machine. The construction and functioning of this machine could be seen from the public road (through a fence) and it was therefore considered disclosed (taking away the patentability of a claimed invention), although the proprietor had placed a no entrance sign. The Netherlands working group feels that the situation would be judged differently if the machine was invisible from outside, e.g. placed in a private garage.

Question 2.2 Time of disclosure

Does it matter if a disclosure has been made recently or a long time ago? Are there limits beyond which the publication of a piece of information, although it constitutes a prior art disclosure, is no longer relevant for the assessment of novelty and inventive step?

26. The period of time lapsed between the moment on which a disclosure became publicly available for the first time and the filing date of a patent is not relevant for the assessment

of novelty. A publication of a piece of information, irrespective of its form, constitutes a prior art disclosure, when it is perceptible to the senses. Such a public disclosure should be given the meaning that it has on the priority date of the claimed invention for which it is considered state of the art¹⁰. This means that the question which implied information is contained in a disclosure is also to be assessed at the priority date.

27. The period of time lapsed between the publication of a piece of information may be relevant for the assessment of inventive step. Experience learns that the seniority of the document affects the inventive step assessment in the way that it is less likely that such old document is relevant for the required inventive activity.

Question 2.3 Place of disclosure

Is the place of disclosure relevant? How is the place of disclosure determined? Does it make a difference if the disclosure has happened in that country accidentally as opposed to intentionally? Which is the applicable law for determining whether a disclosure occurred (the law of the country in which the information was disclosed or the law of the country in which novelty and inventive step are assessed)?

28. Once it has been established that information has been disclosed, it is not relevant where in the world the disclosure has taken place. The place is not relevant in this respect.
29. Whether information is considered to be disclosed, however, is dependent on the law applied to assess the supposed act of disclosure. Under Dutch international private law rules (conflict of law rules) a Dutch court should assess by applying Dutch law where an act has taken place. Subsequently the Dutch court should apply the law applicable to the alleged disclosure to the question whether something was indeed disclosed (which law is to be applied should be assessed under the law of the place of disclosure as determined by the Dutch court; this assessment may lead to applicability of yet a different set of rules). Thus, the question whether information provided during a foreign shareholders' meeting should be considered confidential or not could e.g. be assessed under the law of the corporate statute of the corporation concerned. Whether a confidentiality agreement governed by foreign law has been breached or not should be assessed under the law applicable to the agreement. In the event of a publication it will generally be assumed that the contents thereof could be known to third parties without restrictions.

¹⁰ One of the members of the Group and practitioners defended the opinion that a document should be given the meaning of its statements at the time of publication of the document when deciding novelty. A particular statement or term used in a document only has the meaning given by the author at the moment of writing and not necessarily at a later date.

Question 2.4 Personal elements

What differences do the Groups observe with regard to the person who discloses the prior art? Is the disclosure treated differently if the disclosing person was bound by a confidentiality agreement? How are errors in the disclosed information treated?

30. There are no differences other than the legal exceptions as stated in Article 5 (1) ROW 1995 (see also question 1.3). Article 5 (1) ROW provides that a disclosure shall be disregarded if it occurred no earlier than six months prior to the filing of the patent application as a direct or indirect consequence of an evident abuse¹¹.
31. Information obtained from a party breaching a confidentiality agreement will constitute evident abuse and shall be disregarded¹².
32. Errors in disclosed information are not harmful for the requirement of novelty, if it is clear from the whole context that an error has been made. If this is not clear to a skilled person, then errors in disclosed information may harm the novelty of the claimed invention. Errors in a summary will constitute prior art that may affect the presence of an inventive step, even if that article is a summary of another disclosure not containing the error.

Question 2.5 Recipient of information

What requirements are there with regard to the ability to understand the information? Is the possibility that a person might obtain the information through additional steps, such as disassembly of embodiments or reverse engineering sufficient to constitute a disclosure? Are there general rules providing for the effect of confidentiality or implied confidentiality?

33. The Netherlands Patent Act does not contain any legal requirements regarding the ability to understand the information other than the level of understanding as presumed by the so-called skilled person. As identified above, case law requires that the recipient must have been able to realize what the invention consists of. The Netherlands working group is of the opinion that the recipient should be able to reproduce the information in some form.

¹¹ In a decision dated 23 June 1995 (ARS / Organon), the Netherlands Supreme Court held that under Article 5(1) ROW 1995 the priority date rather than the date of the application should be taken as the starting point for the calculation of the six months' term. However, in G 3/98 the Enlarged Board of Appeal of the EPO held that for the corresponding Article 55(1) EPC the actual filing date of the application is the relevant date.

¹² Whether confidential information that is forwarded by a breaching party to a third party which further discloses this information in good faith shall be disregarded or not under the legal exception of evident abuse is open to discussion. Within the working group there was no consensus.

34. The Netherlands working group further believes that at the moment something has been made public, every feasible method of analysis, including but without limitation disassembly and reverse engineering, will be allowed to obtain (further) information therefrom.
35. The effect of an express or implied confidentiality obligation (if sufficiently evidenced) has been discussed above. Information provided under an obligation of confidentiality is not considered to have been made available to the public.

II.2 DISCLOSURE THROUGH NEW MEDIA

Question 3.1 General rules

Does paperless information, e.g. in an electronic network or through the Internet, constitute a sufficient disclosure to affect novelty or inventive step? Are there specific requirements compared to other forms of disclosure? Are there differences with regard to various forms of network or communications such as the World Wide web, chatgroups or forums, e-mail and others?

36. There are as of yet no specific rules nor case law on the effect of disclosures in an electronic network or through the internet. In general, the Netherlands working group is of the opinion that the same rules apply in an electronic or internet environment as would apply in a paper environment. This is in line with the position generally taken by legal practitioners in related fields of intellectual property.
37. As stated in the response to question 2.1, the means by which the information is disclosed are not relevant for the assessment whether the information has been disclosed. The decisive factor is whether the information has been disclosed and whether a recipient is able to reproduce this piece of information.
38. The intention of the proprietor of the information to disclose the information is not decisive. More important is whether and to what extent the proprietor of the information has taken steps to protect confidential information. This basic rule leads to the following opinion of the Netherlands working group.
39. The information that circulates within a chatgroup should be considered as disclosed and therefore affects the novelty unless the members of the chatgroup are bound to keep this information confidential. The same applies to forums.
40. The situation with respect to e-mails may be different. The Netherlands working group feels that e-mails can only be considered as not disclosed when they fall within the protection of Article 13 of the Netherlands Constitution / Article 8 of the European Convention on Human Rights (privacy of correspondence) or when the sender took

sufficient measures to prevent disclosure, for example by means of passwords and decoding or encryption. Until there is case law to the contrary, it is assumed that information provided by means of regular email (unprotected) cannot be considered comparable to a "sealed" letter, because of the theoretic electronic availability of such information for those seeking to find it.

41. Article 13 of the Dutch Constitution regulates the privacy of correspondence. As the interpretation of privacy of correspondence is very strict, new forms of digital communication (e.g. fax and e-mail) are currently excluded. In a proposed amendment to Article 13 of the Constitution, it is suggested to replace the existing privacy of correspondence, telephone and telegraph by "confidential communication".
42. By Royal Decree of 23 February 1999, the Committee for "Fundamental Rights in the Digital Era" was charged with advising the government on (1) the adaptation of the fundamental rights in Chapter 1 of the Constitution and (2) the desirability of establishing new fundamental rights. In its report, the Committee suggested a technology-independent transformation of Article 13 Constitution into a general right to confidential communication, which comprises all forms of communication that are "objectively speaking" eligible for confidentiality.

Question 3.2 Questions of confidentiality

Does it make a difference if the information is encrypted? What relevant do password, search engines and payment requirements have?

43. There is no case law as of yet. The Netherlands working group is of the opinion that encrypted information is not by nature publicly available, which holds for information which is only accessible with a secret combination of a login and password as well. If such information can subsequently be freely distributed by the recipient, however, it may be considered as disclosed (like any other communication of information not accompanied by a confidentiality obligation). If information can be found with a search engine or can be obtained through payment this constitutes an a priori assumption that the information is not confidential and/or is publicly available.

Question 3.3 Place of disclosure

What is the place of disclosure if the information is put on the Internet? Is the mere fact that a web-site can be assessed in a certain place sufficient for a disclosure in that place or should there be additional conditions requirements?

44. There is no case law as of yet. The place of disclosure may be relevant for determining the day at which the disclosure became part of the state of the art. When in New Zealand a disclosure is put on the internet in the morning, then it may be downloaded from the internet "the day (date) before" in Europe and the United States. The Netherlands working group is of the opinion that the effective day on which this disclosure entered the state of the art is the local date it was put on the internet on the place of disclosure.

Question 3.4 Timing of disclosure

Are there certain requirements for the timing and the duration of information available through electronic means? Are archives necessary or desirable?

45. There is no case law as of yet. The Netherlands working group is of the opinion that the transience of the medium is not relevant for the question whether information has been made available to the public. However, the nature of the medium will have effect on the ability of a party to present reasonable evidence to support its claim that this piece of information has been made public through the internet.

Question 3.5 Questions of evidence

Who should have the burden of proof that a specific piece of information was disclosed on the Internet? Does the internet require rules different from those already existing for oral disclosure or the disclosure in other ways? Should there be different levels of evidence for different ways of disclosure? Does the potential manipulation of information disclosed through new media require different standards for the recognition of such disclosure and are there specific rules for this kind of disclosure?

46. On the basis of the Netherlands Code of Civil Procedure (Article 177) the burden of proof as to the correctness of a claim rests with the party that makes the claim. This party should submit sufficient evidence to support its claim that the information was disclosed on the Internet.

Bestandsnaam: Q 167 (1)
Map: C:\TEMP
Sjabloon: \\PAULIANA\AppsData\Microsoft
Office\Office\Templates\Contract.DOT
Titel: AIPPI
Onderwerp:
Auteur: Reina Weening
Trefwoorden:
Opmerkingen:
Aanmaakdatum: 10-12-01 12:34
Wijzigingsnummer: 2
Laatst opgeslagen op: 10-12-01 12:34
Laatst opgeslagen door: wijnvof
Totale bewerkingstijd: 2 minuten
Laatst afgedrukt op: 22-02-02 14:46
Vanaf laatste volledige afdruk
Aantal pagina's: 11
Aantal woorden: 3.624 (ong.)
Aantal tekens: 20.661 (ong.)