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Patent requirements & Prior Art Searches: Novelty

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Legal Basis

- **European Patent Convention EPC**
 - **Articles & Rules**
- **Guidelines for Examination**
- **Case law**
 - **Board of Appeals (BOA's) decisions**
 - **Enlarged BOA decisions**

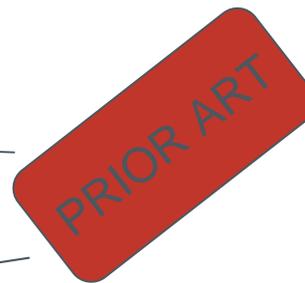
Requirements for Patentability: Art. 52 (1) EPC

European patents shall be granted for any inventions

- which are susceptible of industrial application
- which are new and
- which involve an inventive step

Article 52 (1) EPC Requirements

- **industrial applicability:**
 - rarely used, Art. 52(4)
- **novelty:**
 - Article 54
- **inventive step:**
 - Article 56
- **Invention:**
 - no positive definition; definition by exclusion (Art. 52(2))
 - implicit requirement: technical character



Novelty

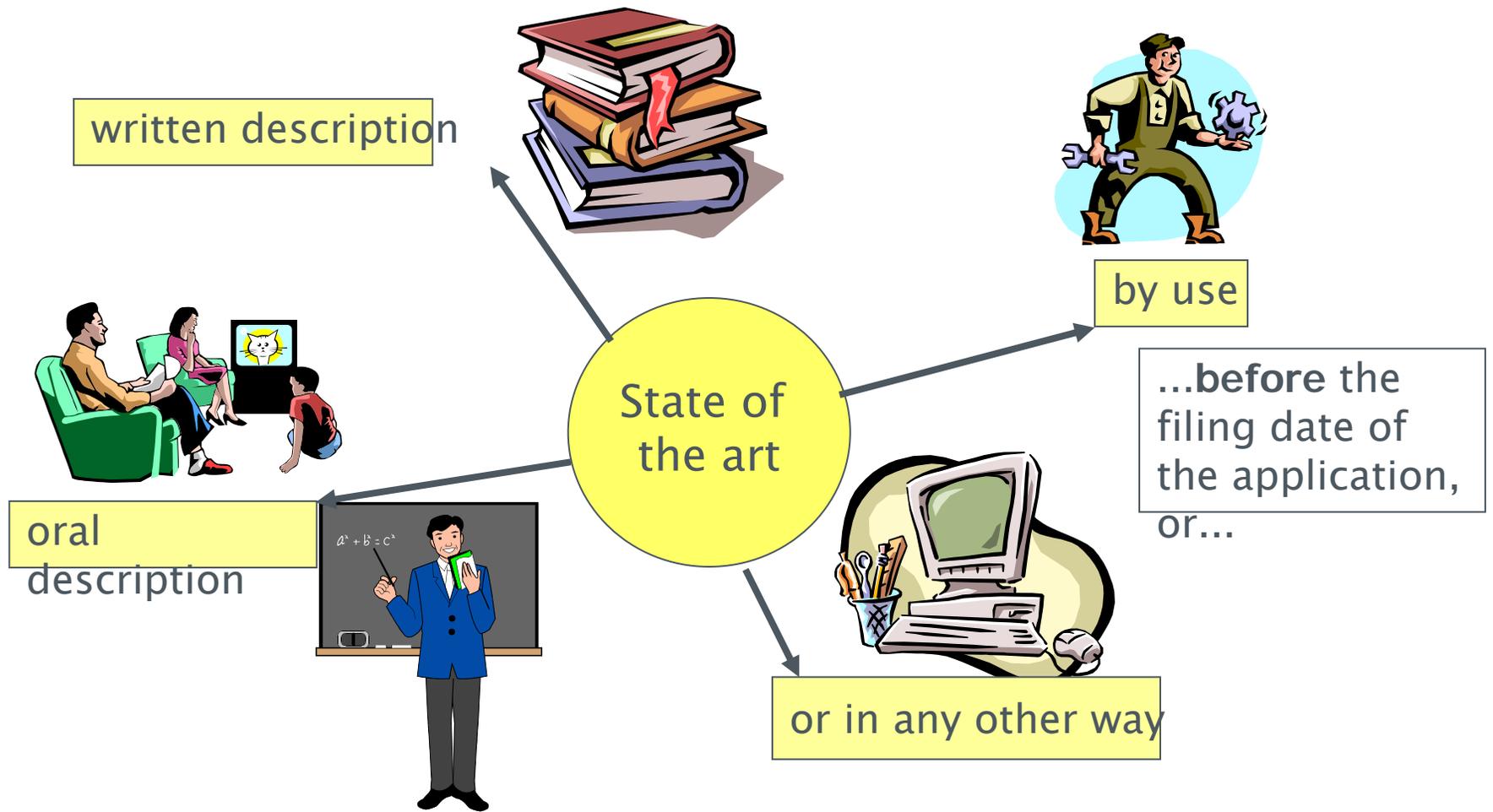
- self-evident requirement of IP law
 - ”You can not take from the public what is already theirs”
 - Also in copyright and trademark law
 - Historically undisputed, unlike inventive step!
- an absolute requirement
 - No such thing as ‘a little bit novel...’
- a straightforward requirement
 - Normally easily established ... and easily overcome!

Novelty: Article 54 EPC

- Art. 54 (1) defines what is considered to be "new"
 - something which does not form part of the state of the art
- What is the State of the Art?
 - defined by Art. 54 (2)
 - also Art. 54(3) & (4) for EP applications

What is the "State of the Art"?

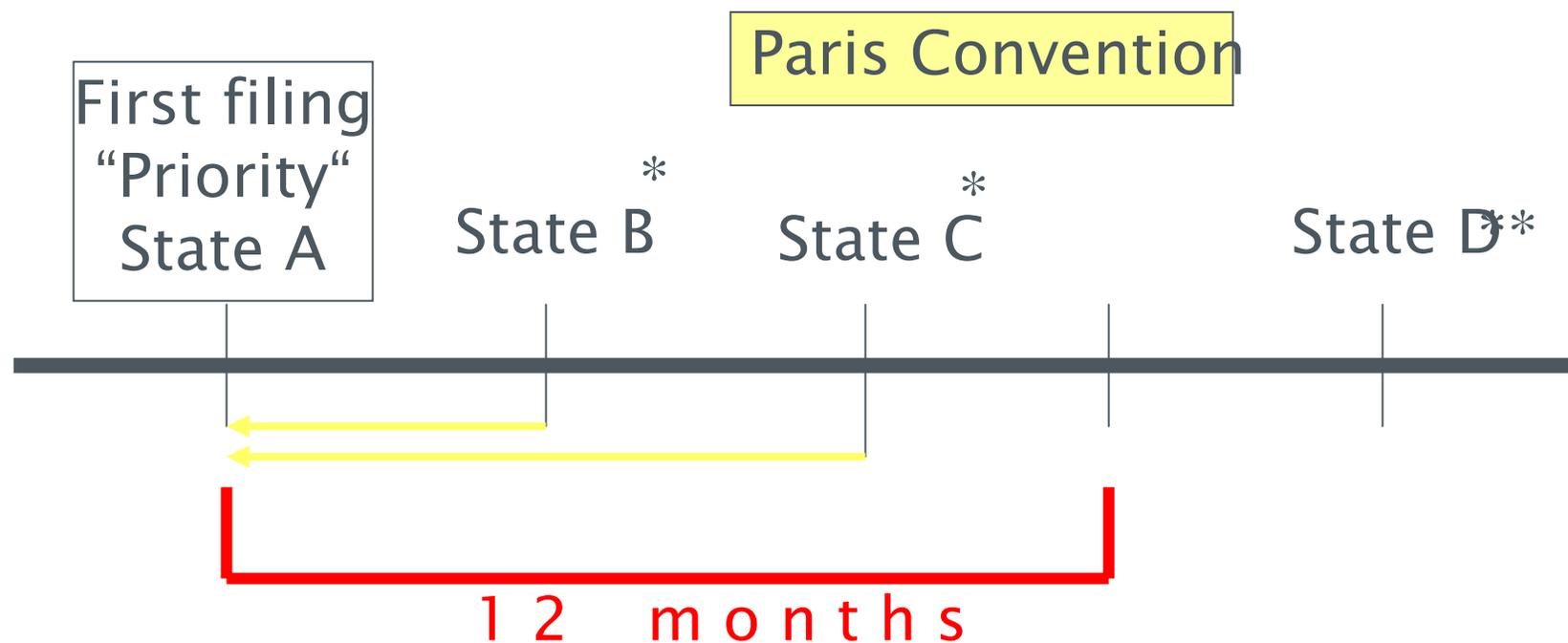
- Everything made available to the public by means of:



What is the "State of the Art"?

- or....
- Conflicting applications
 - Art. 54 (3) EPC ... European patent applications [filed] prior to the date referred to in paragraph 2 [filing/priority date of application] and ... published ... on or after that date, shall be considered as comprised in the state of the art.
 - Art. 54 (4) EPC [Paragraph (3) only for overlapping states]
 - Against double patenting
 - Also for PCT applications
 - For novelty only. Not for inventive step!
 - Must be pending

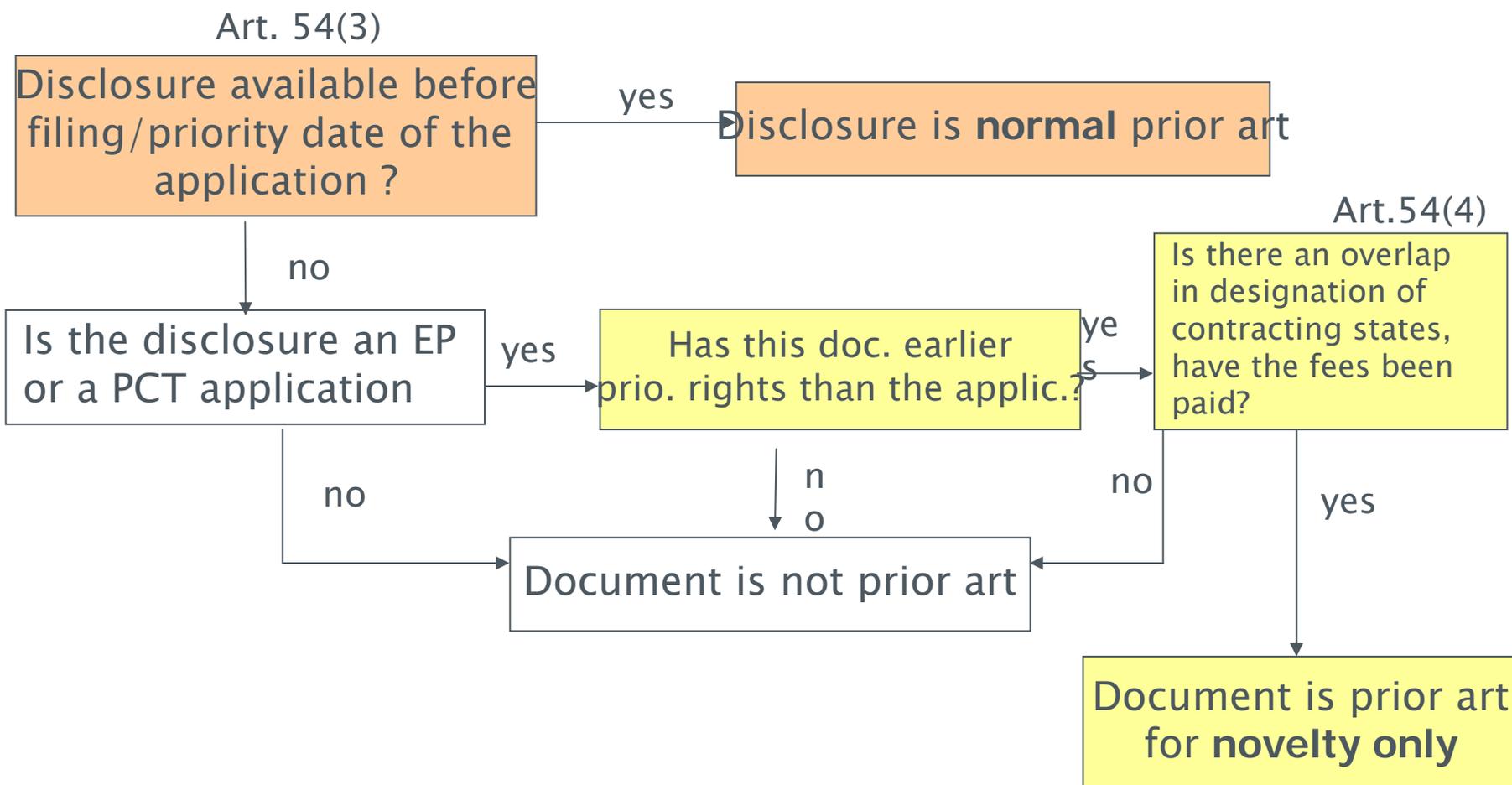
Filing & Priority



* Entitled to use the "priority date" as the first filing date

** **NOT** entitled to use the "priority date as the first filing

Prior Art



Examining Novelty

- Reading of the claim
 - widest interpretation, but...
 - include narrowing features implicit for skilled person (eg. comprising/consisting)
 - technical problem doesn't matter
- Effective date of documents
 - non-prejudicial disclosures
 - evident abuse
 - display at recognised international exhibition
 - not more than 6 months before EP filing

Examining Novelty (cont.)

- Correct reading of prior art (cont.)
 - implicit nature of disclosure
(eg. rubber takes away novelty of elastic materials if elastic properties of rubber are implicitly used)
 - equivalents to be considered as not disclosed
 - no combination of documents (even embodiments)
....except
 - primary document explicitly refers to other source
 - dictionary or similar
 - generic versus specific
 - specific takes away novelty of generic

Examining Novelty (cont.)

- Particular cases
 - ranges of values
 - Selection inventions
 - ... relate to subject-matter which is **selected** from within subject-matter already known from the prior art
 - selection of sub-ranges, new iff
 - **narrow** compared to the known range
 - sufficiently **remote** from the exemplified and the end points of the range
 - **not an arbitrary** specimen of the prior art (**purposive selection**)

Examining Novelty (cont.)

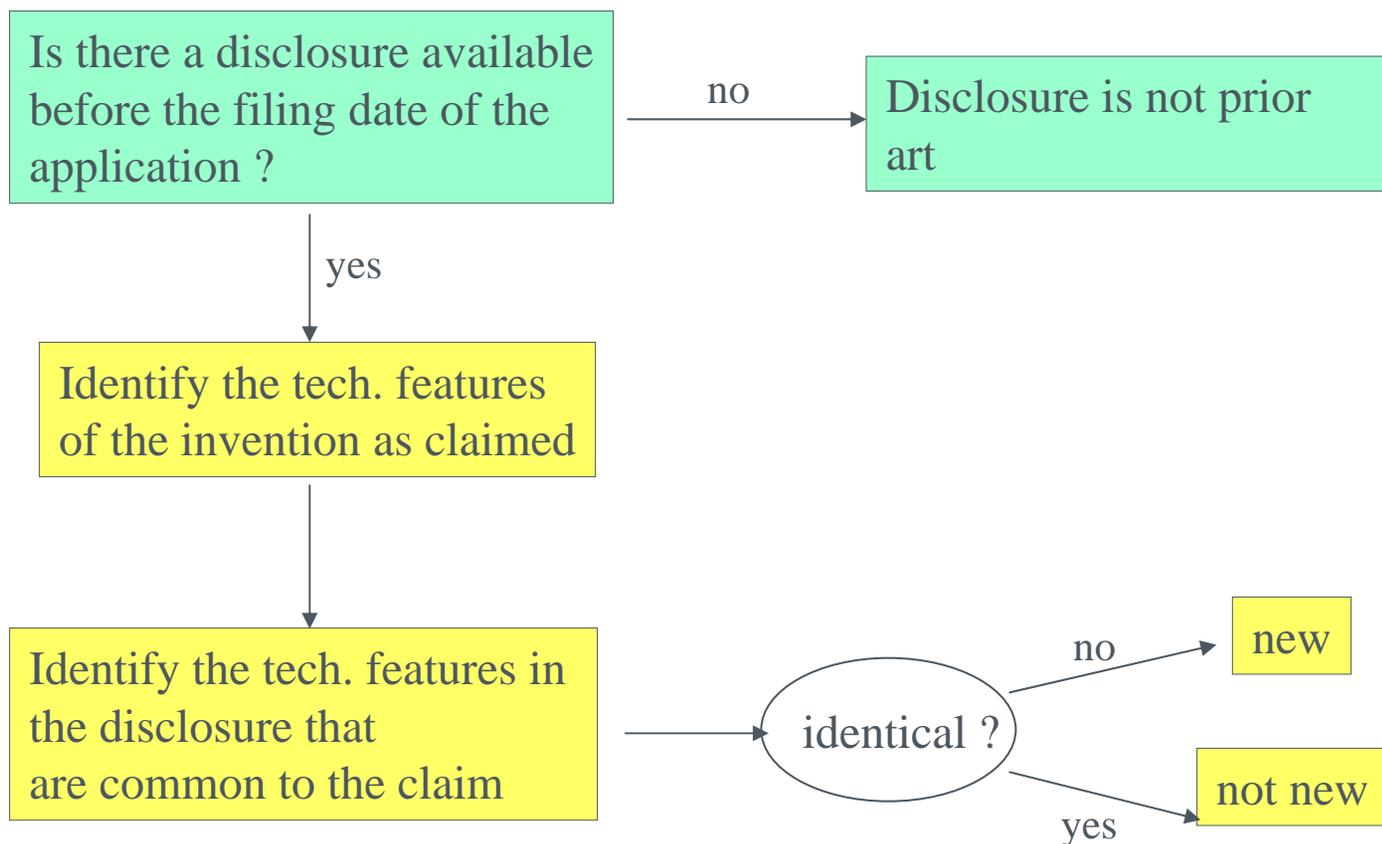


- overlapping numerical ranges, then: the overlap range is considered new iff
 - the skilled person would not **seriously contemplate** applying the technical teaching of the prior art in the range of overlap
 - the end value „A“ (or any other disclosed value) is **disclaimed**

Examining Novelty (cont.)

- Selection out of two or more lists
 - An arbitrary combination of elements of two or more lists **both having a certain length** is not considered to have been disclosed

Is the invention new?



Novelty and Computer Implemented Inventions

- Fundamental problem:

which features to consider for assessing novelty

- only technical features?
- all, ie. technical and non-technical (business) features?
- Open issue, second approach taken
- Essentially different from inventive step
- Rarely used since easy to overcome

Novelty and Computer Implemented Inventions

Thank you for your attention

For more information

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