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Internet disclosures

Guidelines G-IV 7.5

EPO Guidelines G-IV 7.5

- New section of Guidelines from 2015

- *"Certain information may even be available only on the internet from such websites. This includes, for example, online manuals and tutorials for software products (such as video games) or other products with a short life cycle."*

- Perhaps relevant:
  - Product datasheets/brochures
  - Conference proceedings
  - Pre-publications of scientific articles
  - Webpages

Establishing the publication date *G-IV 7.5.1*

- *It must be assessed separately whether a given date is indicated correctly and whether the content in question was indeed made available to the public as of that date*
  - e.g. “revision date”

- *The nature of the internet can make it difficult to establish the actual date on which information was made available to the public: for instance, not all web pages mention when they were published.*

- *…it is considered very unlikely that an internet disclosure discovered by an examiner has been manipulated. Consequently, unless there are specific indications to the contrary, the date can be accepted as being correct*

Issues of Proof G-IV 7.5.2 and 7.5.3

- free evaluation of evidence
- not *"up to the hilt"* – mere *"balance of probabilities"*
- Initial burden lies on examiner/opponent
- If an applicant provides reasons for questioning the alleged publication date of an internet disclosure, the examiner will have to take these reasons into account
- An examiner/opponent will either have to present further evidence to maintain the disputed publication date or will not use this disclosure further as prior art against the application.

Examples of burden of proof

- Online scientific journals – usually very reliable
  - Remember the online version may differ from the version actually published
- Other ”print equivalents” – usually quite reliable
  - Time Magazine online edition
  - NASA website
  - Manuals/handbooks
- Other
  - Weblogs, discussion groups, YouTube, wiki pages
  - If in doubt, use the ”last modified” date

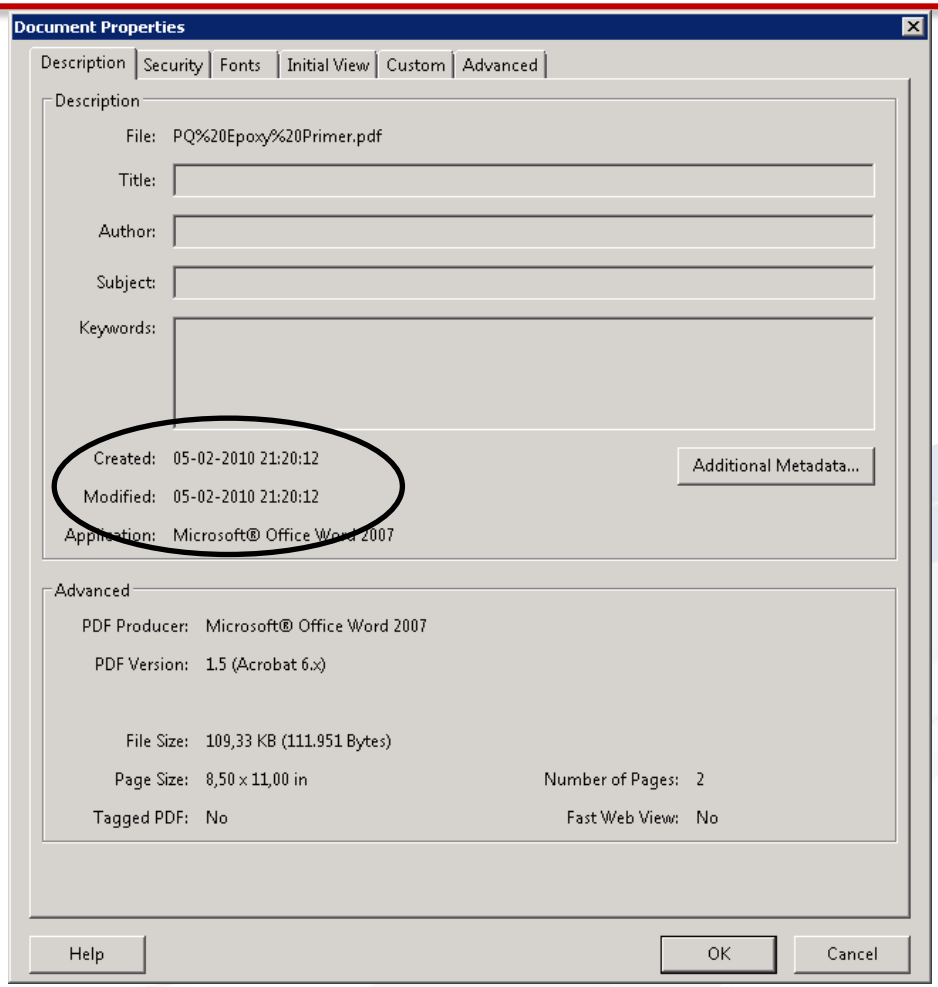
How to establish a publication date?

- Google archives, Wayback machine
- Website or document ”last modified” timestamp
- A ”Revision date” or ”Copyright date” is not the same as a publication date (cf. T915/12)

Example

- D13 was a datasheet containing a “revision date = 03/2008”
- Was located online at the producer’s website
- Right-click, show document properties:

Example:



Example:

Example:

UPDATE ON SOFTWARE AND BUSINESS METHODS IN EUROPE

Recap of the basics...

- Patent eligibility
  - Exemption for ‘programs for computers’ (Article 52(2)(c) and 52(3) EPC) plays no practical role
- So why is it so hard to obtain patents for software and business method related inventions in Europe?
- Answer: the case law relating to inventive step
  - in particular since landmark decisions T 931/95 and T 641/00
  - following which ‘non-technical’ features are disregarded for the assessment of non-obviousness; and
  - an inventive is only acknowledged if the invention solves a technical problem, or if its implementation requires technical considerations

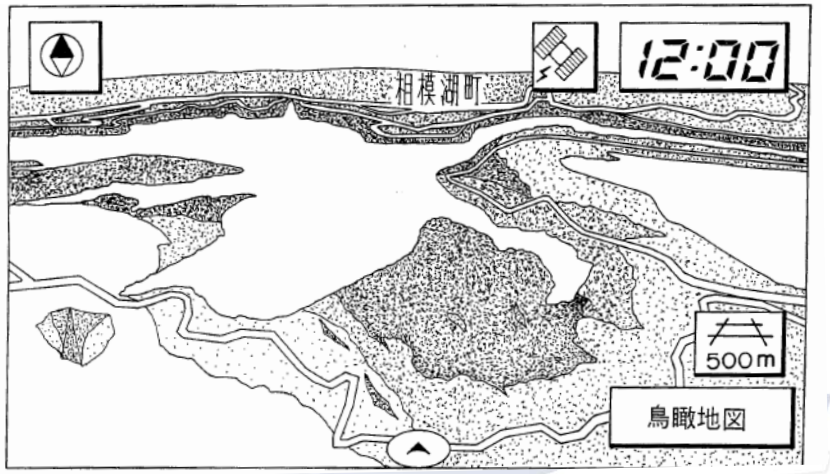
Typical rejection...

The only identifiable technical aspects of the claimed invention relate to the use of conventional, general-purpose data processing technology for processing data of an inherently non-technical nature. The information technology employed is considered to have been generally known as it was widely available to everyone at the date of filing/priority of the present application. The notoriety of such prior art cannot reasonably be contested.

Display of a bird's eye view map T 651/12

A map display apparatus comprising

- a database that includes altitudes in respect of areas in a two-dimensional map
- a calculation means for generating a bird's eye view map on the basis of the 2D map and altitude data



- Bird's eye view provides a more realistic view, and adds to ergonomics and safety.
- The invention provides a technical solution to a technical problem
- No fundamental difference between this invention and a method of operating a computer-controlled machine which is generally considered technical in all aspects.

Haptic feedback in interacting with virtual pets, T 339/13

- A method for providing haptic feedback in interacting with a virtual pet
  - wherein the virtual pet is a cat;
  - receiving a signal from a software application relating to a biological status of the virtual pet;
  - outputting, to a user-interface object, the associated haptic effect based on the received signal;
  - receiving user input by the user moving a cursor back and forth over the display of the virtual pet; and
  - triggering, in response to the input, a purring sensation in the form of a periodic vibration.
- Closest prior art:
  - No haptic feedback.
  - No direct interaction between the user and the display pet in a way physically resembling an interaction with a real pet.
- Inventive step?

The board accepts as a technical problem in the context of virtual pets that of achieving the reliable and reproducible perception of a physical interaction with the real pet. Moreover, the board finds that the invention solves this problem with technical means, more specifically in terms of technical features of the device interface, namely a reciprocating cursor movement and haptic feedback.

Current trends

- The Boards of Appeal generally tend to allow patents for software that interacts with a human being (user) and/or controls a process in the real, physical world
- Patent applications related to inventions for administrative, financial, or business-related purposes are generally considered non-favourably by the EPO
- Drafting advice: disclose technical means, and discuss technical problems solved as well as technical effects thoroughly in the description
- Include test results in the description

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A true Catch 22

The curse(s) of national security provisions in a global world

Peter Koefoed

Catch 22

- A paradoxical situation from which one cannot escape because of contradictory rules
- Often the result of rules, regulations, or procedures that you are subject to but has no control over because to fight the rule is to accept it…

National first filing requirements

- A surprisingly large number of nations require that patent applications for (at least some) invention are filed locally, e.g. when
  - The invention is made in the nation,
  - The inventor is a national of the nation (more rare),
  - The inventor is employed under a contract governed by the nation's laws (very rare)

Multinational inventions

- Inventions made by inventors of different nationality or residency
- A special, and problematic, case arises when at least two such inventors have to comply with different national first filing requirements.
- Where – if at all – to file then?

Why all the fuss?

- Illogical, that an invention, which is inherently made by inventors in more than one of the problematic jurisdictions, must be patented first in any country.
- After all, the idea behind the provisions is to avoid dissemination of knowledge of the invention abroad
  - But dissemination has already taken place as part of the inventive process.

Really problematic countries

- The national first filing requirement is *absolute* in Italy, the Russian Federation, Singapore, Spain, and the USA.
  - Well, Spain not really problematic after all since no sanctions exist for not complying with the law(!)

Less problematic countries

- A national first filing requirement for certain inventions exists in Belgium, Denmark, France, Indonesia, Israel, Netherlands, Norway, and United Kingdom
  - Certain inventions: national security-related inventions
  - Applicants have to assess themselves whether an invention falls under the national first filing requirement

Notable national first filing requirements

- USA: A patent filing must be made in the USA if the claimed invention was made in the USA
  - Unless a foreign filing license is obtained
    - Can be obtained prior to filing
- China: More or less the same as in the USA
  - But no express prohibition against filing a petition for a FFL in e.g. USA prior to filing patent application in China
- Russia: First filing must be made in Russia, if invention made in Russia. After 3 months, applicant may decide to file abroad (or a petition can be filed after filing but before 3 months)
  - Again, no express prohibition against filing a petition for a FFL abroad

Ways out (1)

- Invention made in US and China/Russia
  - Obtain an FFL in the USA and file in China/Russia
  - Only “safe” approach if reading express wording of the national laws

- But: no guarantee that the national courts in China or Russia will interpret their national laws (which only consider where to file first) as allowing the USPTO to study the invention to issue a FFL...

Ways out (2)

- If possible, divide the invention into contributions made in the different countries and file priority applications where needed.
- At the end of priority year, compile everything into one application.

- Unfortunately not always possible...

Ways out (3) – only a suggestion...

- If the invention relates to a technical field, which is not national security-related, draft an invention disclosure, which is not novel/inventive, but which generically relates to the exact same technical field as the invention (e.g. corresponding to the preamble of an EP claim) – obtain an FFL in the USA, and file the generic disclosure in Russia or China together with the addition of the novel and inventive contributions...
  - Do, however, carefully tailor this approach with a US attorney – it may be dangerous...

Ways out (4) – to difficult

- Do not rely on contributions from inventors living in one of the problematic countries…
- Or – make sure that they make their inventions in unproblematic territories…

All the other cases

- Where only one inventor is problematic, the problem is less of a burden
  - Only fiscal because translation into non-English of the application may be necessary