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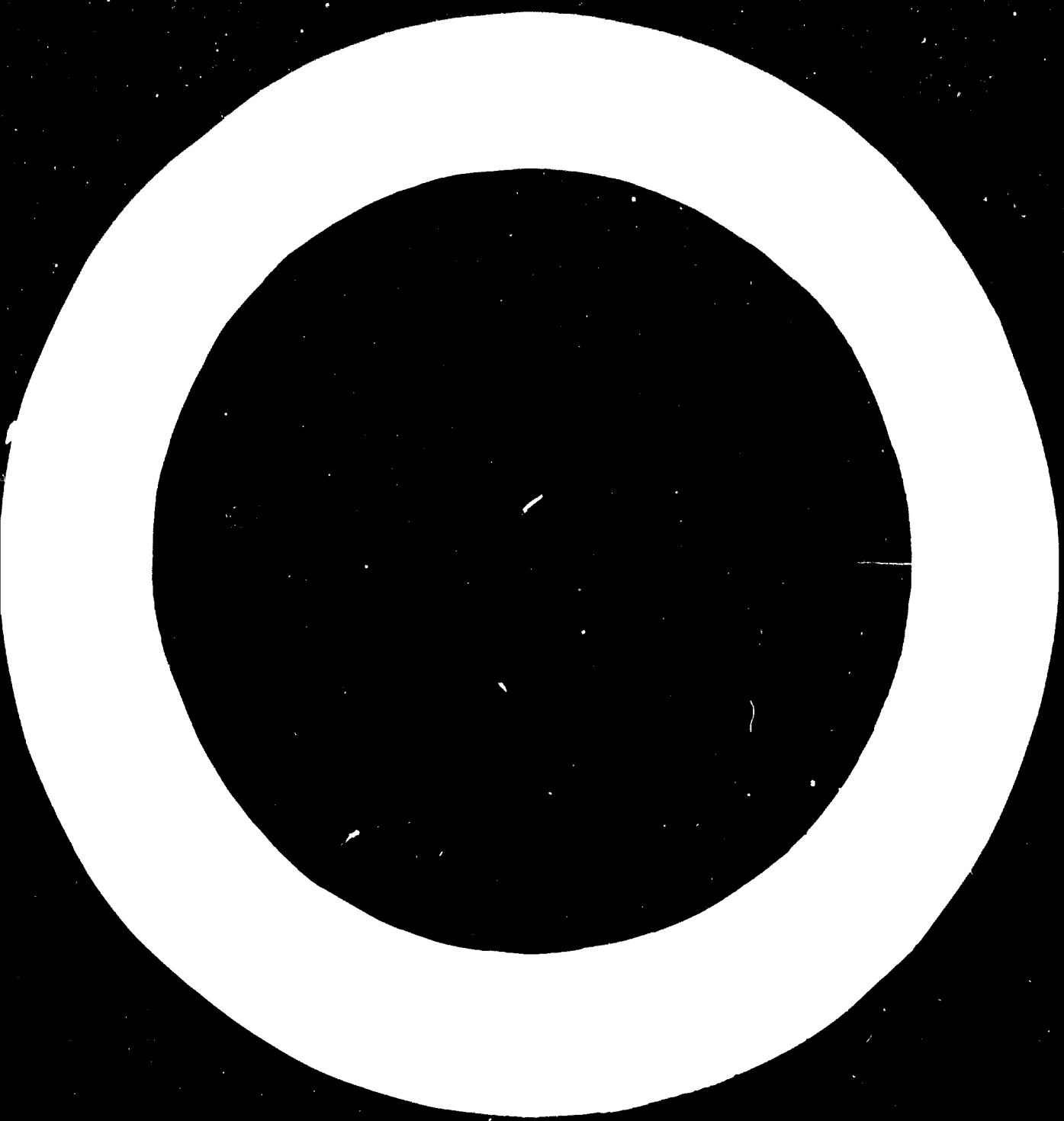
NOVELTY EXAMINATION OF INVENTIONS^{2/}

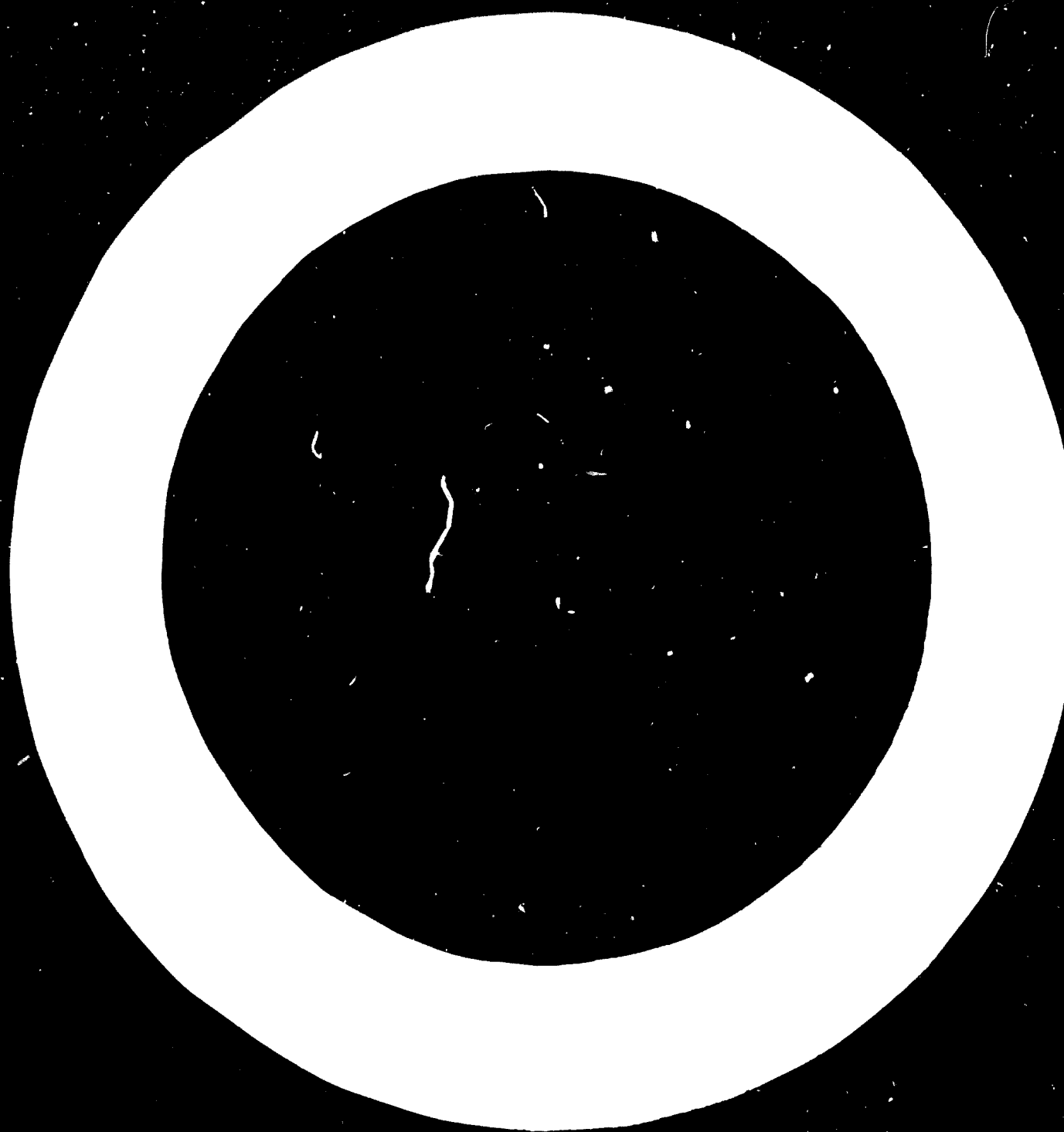
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^{1/} Organized jointly by UNIDO and BIRPI (United International Bureaux for the Protection of Intellectual Property, Geneva).

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I. LEGAL BASIS

It follows from the topic of this meeting - the organization and administration of industrial property offices - that the problems involved in the novelty examination of inventions must be studied with reference to a legal basis - the law which the industrial property offices are called upon to apply. As the problems to be considered are primarily those faced by the developing countries, it is appropriate to base oneself on the Model Law suggested by and for such countries as published by WIPO in 1965. This Model Law is particularly well suited to the discussion as it sets out the principal examination systems in the form of alternatives under section 18.

As well as patents, the Model Law covers (in annex B) inventors' certificates. So far as the novelty examination is concerned, patents and inventors' certificates are governed by the same provisions. For simplicity therefore, reference will be made only to patents, it being understood that the remarks apply equally to inventors' certificates.

Before the practical problems raised in novelty examination are considered, three points of a legal nature should be mentioned: the purpose, timing and procedure of the examination.

II. PURPOSE OF THE NOVELTY EXAMINATION OF INVENTIONS

A. Two essential points are covered by the title:

- That of novelty, to which section 2 of the Model Law gives a definition (universal novelty). The definition obviously may vary as between one law and another, according to whether it is limited territorially (local novelty) or as to time, especially as regards publications by the inventor.

- That of inventions:

The essential element is "inventive activity", defined in section 3 of the Model Law. This concept varies according to country and according to the terms employed: "Erfindungshöhe" (inventive level) in Germany, "non-obviousness" in the Anglo-Saxon countries, "creative idea", etc. The common ground is that novelty, even objective and absolute (universal) novelty, is not sufficient: something more is required: an invention must constitute a step forward in technique in contrast to a mere innovation which simply implies a logical deduction in the course of technical development.

The idea of "invention" usually includes another element, the idea of technical progress, which is not dealt with or even mentioned in the Model Law: it is obvious enough, however, being inherent in the mere idea of invention, which can only be a step forward, at least in relation to the nearest point in the state of the art - a movement forward on an ascending branch of technique.

B. The novelty examination may also cover the following closely related points:

- The technical examination of priority, i.e. examination of the priority document to ascertain the operative date (cf. alternative B, section 18 (3), of the Model Law);
- Examination of prior rights when not covered by "the state of the art", which seems logical enough but is nevertheless not applied everywhere; this examination is likewise covered in section 18 of the Model Law (cf. sub-section 1(c), alternative B, and sub-section 1(c), alternative A);
- The examination of the invention for unity, since in the absence of a novelty examination the unity of the invention can only be examined from the point of view of form (sections 14 and 17 of the Model Law), whereas in the course of a novelty examination it is possible to arrive at an objective judgement as to whether the technical advance is unique and unitary. It may be noted, however, that in both cases unity is not a question affecting patentability but a matter of payment of fees, since the "non-unitary" invention can be fully protected by application for more than one patent.

C. On the other hand, points relating to the following are not covered by the novelty examination (because they can be examined without documentary research):

- industrial application (section 4);
- exceptions to patentability (section 5);
- sufficiently clear description of the invention (section 13 (1)).

III. TIMING OF THE NOVELTY EXAMINATION

The novelty examination may take place at any of a number of different stages in the procedure:

- (a) A preliminary examination may be made at the request of the applicant, before filing of the application, whether it is a first application or a subsequent application taking into account the result of the investigation made in connexion with the first application. At this stage, the industrial property offices do not intervene.
- (b) The preliminary examination properly so-called, in the convention meaning of the term, is a compulsory examination taking place as a matter of course as soon as possible after filing of the application. There is always a certain interval between the date of filing and the examination, in view of the time allowed for submission of the declarations and priority documents, the bringing up to date of the records, etc. In several countries where the preliminary examination is normal, this interval has steadily lengthened in recent years, as a result of the work load and the shortage of personnel. This examination undoubtedly helps to validate the patents issued, but it is time-consuming and costly; for a great many patents, it is out of proportion to their real importance and, in the case of really important patents, it does not absolutely guarantee their validity.
- (c) Deferred examination is based on the principle that the application for the patent is to be published after a specified period, as such or in the form of a provisional patent, without novelty examination; such examination is only performed later, at the request of either the owner of the patent or a third party. Obviously this procedure prolongs the period of legal uncertainty, but it does lighten the workload of the offices, to an extent which cannot at present, in the absence of sufficiently long experience, be precisely estimated.

- (d) In countries having a system of registration after more or less thorough examination as to form only, provision is made for examination after the issue of the patent, to take place only in the event of litigation. Some points connected with such examination will be referred to later, under VIII.

IV. PROCEDURE

A. It seems worth while to refer in passing to three variants of the novelty examination which might be described as "simplified":

1. The first variant consists in handing over the search to third parties: once an application for a patent is received in the prescribed form, it is published, to give third parties the opportunity to oppose the application, and grant of the patent is refused if opposition is made on adequate grounds. This system has more drawbacks than advantages: the industrial properties office certainly saves on the cost of research, but it must still have a qualified staff. The outcome is affected by contingencies and depends on the cogency of the opponent's argument. Absence of opposition may be due to chance (absence of competition, failure to meet a dead-line, etc.): it in no way guarantees the validity of a patent granted without opposition.
2. The second variant is to have the examination carried out by other offices: for example, a limited search may be made for parallel patents granted after novelty examination in other countries. Such research may be entrusted to the International Patent Institute (IPI) at the Hague: the procedure is quick and inexpensive. In so far as it makes it possible to bring to light one or more parallel applications with the same operative date, in the form of published applications or issued patents, and to take note of the documentation considered and of the extent of the claims allowed, this procedure provides a basis for a certain presumption of validity. If, on the other hand, the results are negative, no conclusion can be drawn, as the rejection of a parallel application and the reasons for it do not normally come to light in the course of such a search. It must also be admitted that this method is somewhat "parasitic".
3. The third variant consists in requiring the applicant to supply the results of an investigation into parallel applications in other countries, or, in their absence, an investigation in connexion with the application under consideration, but at the request and the expense of the applicant. In the first case, the

results are comparable with those of the second variant, but more complete since they include the precedents involving a rejection; the chief drawback is still the delay. In the second case, the outcome is equivalent to a novelty examination of the normal kind, with the expenses borne by the applicant.

B. The novelty examination properly so-called necessarily pre-supposes an investigation of earlier claims, both in relation to the claim itself and the operative date. Such an investigation may perfectly well take place separately (in time and place) from the novelty examination itself, which implies a judgment and, normally, a decision. The outcome of such a separate investigation is a written opinion, which is sometimes called a "novelty opinion", but which is really more a summary of the state of the art, since a "novelty opinion" implies a certain element of judgment in the shape of denial or recognition of novelty, total or partial, even when it is silent as to the value of the differences recognized.

The examination itself may be broken down into two stages: first the preparation of a reasoned opinion on patentability, intended either for the applicant alone or for general publication, but not of any immediate legal effect; then the decision to refuse or grant the patent.

Any sub-division of the work (investigation - opinion - decision) makes it possible to internationalize a portion of the procedure only and to safeguard national prerogatives in the matter of decision. It must not be forgotten, however, that while any sub-division of the work facilitates a degree of rationalization, through specialization, it also means that part of the work, perhaps a very important part, must be done at least twice: thus the papers relating to the patent application and the background documents must be examined not only by the investigator and by whoever draws up the opinion, but also by the persons who make the decision. In the same way, the process of reasoning towards conclusions has to be performed both by those who prepare the opinion and those who decide.

V. RESEARCH AS TO NOVELTY

In practice, research as to novelty is usually limited to publications in writing or illustrations; it only rarely covers oral forms of publication (such as lectures) or silent forms (exhibition, offer for sale, etc.). Written material therefore plays the main part. It must be admitted that, faced with the present volume of such documentation and their exponential growth, the expenditure incurred in obtaining the

information, keeping it up to date and, especially, classifying it, the unknown factors involved in the future development of mechanized data retrieval and information processing in general, the difficulty of recruiting dozens or even hundreds of qualified specialist engineers and technicians, in a country which needs them more directly for the development of its industries, it is scarcely possible for an office which has not so far undertaken research as to novelty as part of its regular practice seriously to contemplate introducing it. On the contrary, some countries which have carried out such research for a long time are tending gradually to abandon it in favour of relying on an international centre, and even the big offices which carry out preliminary examinations are endeavouring to solve their growing difficulties by international co-operation within the Centre for International Co-operation in Information Retrieval among Examining Patent Offices (ICIIRPAT). International or at least interregional arrangements are therefore the only solution that can be contemplated with any prospect of success for the small industrialized countries - still more, in the case of the developing countries. Such a course **has**, moreover, the advantage of ensuring both economy and high standards, since it enables the specialization of the examiners and their number to be increased, and allows more to be spent on dealing with the ever-growing problem of documentation.

There is at present only one such centre, the International Patent Institute (IIP) at The Hague. Its twenty years of experience, its world-wide reputation, the fact that the four member countries (France, the Netherlands, Switzerland and Turkey) rely on it more and more for research connected with their patent applications, apart from work commissioned privately, and finally the clearly expressed intention to rely on its services for the PCT plan and the proposed "European patent", are evidence that IIP is in a position to guarantee research of a sustained high standard performed within a reasonable lapse of time. The fees and terms of co-operation between the Institute and individual countries can and should be negotiated separately for each case. The future expansion of IIP, which in a few years will have at its disposal a very large building and a staff of several hundred examiners, together with the possibility, under the 1961 agreement, when it comes into force, of setting up local branch offices, should make it possible to find an acceptable solution for the developing countries' problems, especially if they co-operate in regional groups.

On the other hand, the PCT plan can offer only a partial solution to the problem of research as to novelty, since selection of this procedure will be a matter for the applicant alone.

VI. THE EXAMINERS

- A. If we accept the principle of centralized research, the chief problem regarding the novelty examination is that of staff. Only a good examiner can produce a satisfactory result in any given case. There are two aspects to the problem:
1. First, there is recruitment and selection, still conducted in a highly empirical fashion, through competition, perusal of the usual application data (education, diplomas, etc., curriculum vitae), followed by probationary appointment. It would seem reasonable to take advantage of modern, scientific methods of vocational guidance to work out internationally a series of quick tests for the aptitudes looked for in a candidate: the capacity for analytical and abstract reasoning, clear and logical thinking, facility in written expression and a capacity to understand legal problems. These are basic aptitudes which in the long run take precedence over professional specialization. Any mechanical engineer, for example, will be capable of acquiring and developing the special technical knowledge and legal knowledge in time for patent relations. It is only in the selection of the examiner that the country needs an experienced examiner. For developing countries interested in setting up a novelty examination system for inventions, it would for that matter be impossible to recruit a full corps of examiners each qualified by previous experience in the field of work allocated to him.
 2. The second problem is that of examiner training. On top of a general (secondary-level) education and technical studies, involving the same problems as in connexion with other graduate careers, the examiner should have practical and legal training. Here too it must be admitted that many Offices still rely too much on rule-of-thumb methods, leaving the trainees' instruction to a single examiner or group chief. It is essential to ensure basic training in the form of courses, especially on the legal notions which the trainee has not had the opportunity of acquiring at the university and which may well be quite outside the range of his previous mainly or even exclusively technical studies. Language courses must also be

provided; for any novelty examination worthy of the name, every examiner should be capable of understanding technical papers in English, French or German. The practical training should begin with a few hypothetical cases devised for the purpose and graded in difficulty, before leading on to actual cases dealt with under the supervision of an experienced examiner capable of communicating his experience and specialist technical knowledge but not necessarily gifted for teaching.

B. Technical assistance for developing countries might include:

- The provision of internationally organized training courses for examiners, similar to but more concise than those given at the "Centre d'études internationale de la propriété industrielle" (CEIPI) at Strasbourg, covering only the patent law of some particular country and that portion of it relating to the granting of patents;
- The provision of in-service courses for trainee examiners, after this theoretical training, in Offices using the system of preliminary examination (some such in-service courses already exist and they could be developed);
- Expert missions to countries preparing to introduce the novelty examination system, in order to help and advise the cadres already appointed and the personnel to be instructed.

C. Obviously any interregional scheme for setting up a central novelty examination office for a group of countries (especially where there is a common language) would make it much easier to build up a corps of examiners: there would be a wider field for recruiting candidates and the combining of human resources would make it possible for examiners to specialize more and so raise their productivity. It would also, in so far as an international office enjoys tax exemption, be in a position to offer more favourable salaries, which would facilitate recruitment of staff and promote stability.

VII. NOVELTY EXAMINATION PRACTICE

As a general rule, the examiner can follow a fairly straight-forward logical procedure, consisting in asking himself in turn the following three questions:

- (a) Do the claims made in the application for examination define something new in relation to the state of the art as revealed by the investigation into antecedents?

Writers and case-law agree that, on this point, each earlier claim must be compared separately with the subject of the patent application.

- (b) If the reply to the first question is in the affirmative - i.e. the new features of the subject of the application give it the character of an invention - i.e., in the first place, are they the result of inventive activity or do they follow from the state of the art (cf. Model Law, Section 3), and, secondly, will they make possible a technical advance?

- The question of inventive activity is the most difficult and controversial point in the novelty examination and may readily be criticized as subjective. The examiner usually proceeds by analogy, endeavouring to assimilate the application to some standard type of case (invention involving transposition, combination or consolidation; selection, omission or simplification; substitution of equivalent elements, etc.), for which criteria have been laid down in case-law. For an objective judgment on whether or not inventive activity is evident, the examiner must answer - equally objectively - the following question:

Could an ordinary person skilled in the field concerned (as defined in relation to the particular case) and knowing the state of the art have understood the problem dealt with in the application and solved it in the way proposed? If the answer is in the affirmative, the application does not justify the grant of a patent, since it could equally well have been discovered by any person skilled in the art.

- The question of technical progress should be neither over-estimated nor under-estimated as a criterion of patentability: since the examiner's means of investigation and checking are necessarily limited and his technical knowledge not exhaustive he will not always be in a position to take into consideration all the relevant factors; on the other hand, there are fields - particularly chemistry - in which technical progress often becomes the decisive criterion.

In conclusion, it must always be remembered that these two aspects of the concept of invention are often complementary, in the sense that unexpected technical progress is a sign of inventive activity, and conversely that an inspired idea may be the source of an advance not yet fully accomplished.

- (c) If the answers to the two preceding questions are affirmative: is there any prior right? Is the invention which is defined in the claim the subject of a national patent or patent application which is earlier in terms of the date of filing of the application or of a priority right?

The point to be examined in this case is whether two successive inventions for which a patent is applied for in the same country are wholly or partly identical.

VIII. RELATED POINTS

1. Examination on application for nullity

In the case of patents issued without preliminary or deferred examination, where the validity is considered (either as a matter of course or upon request) only in the event of litigation, examination is usually the sole responsibility of the courts and so falls outside the scope of the industrial property office. The point is, however, mentioned here in order to refer to the example of the new French Act, which in article 71 (last paragraph), requires the patentee to "produce a statement as to novelty ... referring to those aspects of the state of the art which may be relevant to the novelty". This approach deserves to be considered by countries which do not use the system of novelty examination for patent applications. The preparation of such a statement presupposes an ad hoc investigation which could be entrusted to the International Patent Institute (IPI) (specially commissioned, in the case of countries not members of IPI), and the preparation of a substantiated opinion on the validity of the patent. The latter task might be entrusted either to industrial property offices or to the experts referred to in section 58 (3) of the Model Law. Obviously such an opinion would have the status only of an expert opinion and would not bind the court.

By way of assistance to developing countries, consideration might be given to the preparation by some international organization of a list of specialists in particular fields of technology, with at least a **basic** knowledge of patent law; the developing countries could call upon the services of such experts in the event of need, perhaps (for example) selecting one of the two experts from such a list and the other from the country concerned.

2. Usefulness of the invention to industry

This point, included in the provisional agenda, is only partly connected with the novelty examination, i.e. in so far as it concerns consideration of

- the question whether the invention is capable of being used in industry (section 4 of the "Model Law") and
- whether it constitutes a technical advance.

Both these points have been referred to above.

The question whether in any given country a validly patented invention is or is not useful to that country's industry is a point that has nothing to do with the issuing or validity of the patent, but only concerns its utilization. It therefore falls outside the scope of the industrial property offices and is a matter either for private industry or some other administrative (governmental) agency, according to the economic system of the country concerned; it depends then on some auxiliary department, quite separate from the industrial property office, which has to take into account the particular conditions prevailing in the country concerned and the current position of the particular branch of industry. The department's decision may be sometimes affirmative and sometimes negative, during the currency of the patent, according to the economic or technical conditions prevailing at the time. It goes without saying that such considerations as these are in no way connected with patent law.



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