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international
IP attorneys



Disclosures in the grey area

The European perspective

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The movie



General principles

- Art. 54(2) EPC - The state of the art: 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 of the European patent application.
- Disclosed subject-matter is only comprised in the state of the art if the information is sufficient to enable a POSITA **to practise** the technical teaching taking into account the CGK at the filing date (see T 26/85, T 206/83, T 491/99).

Prior art and sufficiency

- *A disclosure in a prior art document is novelty-destroying only if the teaching it contains is reproducible. This need for an enabling disclosure is in conformity with the principle expressed in Article 83 EPC. Thus, **the requirements of sufficiency of disclosure are identical for a prior art document and a patent** (T 1437/07).*

Sufficiency

- A document that discloses a chemical compound (identified by name or structural formula), indicating that it may be produced by a process defined in the document itself, is considered to be part of the state of the art only if:
 - it indicates how to obtain starting materials and reagents; or
 - the POSITA can obtain them on the basis of CGK.

Prior use

- To be clarified to determine whether an invention has been made available to the public by prior use:
 - I. **when** the prior use occurred,
 - II. **what** was made available to the public through that use and
 - III. the circumstances of the use, i.e.
 - **where**,
 - **how**
 - **by whom** the subject-matter was made public through that use.

Plausibility (inventive step)

- *The definition of an invention as being a contribution to the art, i.e. as solving a technical problem and not merely putting forward one, requires that it is **at least made plausible** by the disclosure in the application that its teaching solves indeed the problem it purports to solve (T1329/04)*
- *There is no requirement in the EPC ... that a patent application should include experimental evidence in support of patentability or a claimed technical effect ...**that the disclosure in a patent application is merely theoretical and not supported by experimental data is in itself no bar to patentability** (T 1642/07).*

Plausibility (sufficiency)

- *For a sufficient disclosure of a **therapeutic application**, it is **not** always **necessary that results** of applying the claimed composition in clinical trials, or at least to animals **are reported**...*
- *..this does not mean that **a simple verbal statement ... is enough**..*
- *It is required that the patent provides **some information in the form of**, for example, **experimental tests**, to the avail that the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease*
- *Showing a pharmaceutical effect **in vitro** may be sufficient (T 609/02).*

Internet disclosures (SOJEPO 4/2016 March)

- Establishing the publication date:
 - whether a given date is indicated correctly
 - whether the content of the disclosure was indeed made available to the public as of that date.
- The nature of internet can make it difficult to establish the actual date on which information was made available:
 - not all web pages mention when they were published;
 - websites are easily and frequently updated;
 - most do not provide any archive of previously displayed material.

- Neither restricting access to a limited circle of people (e.g. by password protection);
- nor requiring payment for access
 - prevents a web page from forming part of the state of the art
- it is sufficient if the web page is **in principle** available without any bar of confidentiality.

Standard of proof

- The standard is the balance of probabilities:
 - it is not sufficient that the alleged fact (e.g. the publication date) is *merely probable*;
 - the ED/OD must be convinced that it is correct;
 - proof beyond reasonable doubt (*up to the hilt*) **not required**
 - relied upon by EPO when only one party has access to the information

Burden of proof

- Lies initially with the examiner/opponent: objections must be reasoned, substantiated and must show, on the balance of probabilities to be well-founded;
- if this is done, burden shifts to the applicant/patentee, that must provide reasons for questioning the alleged publication date;
- minimal weight given if publication date contested with no reasoning or merely with generic statements about the reliability of internet disclosures

Reliability of internet disclosures

- Technical journals: the same as that of traditional paper journals, i.e. very high
 - beware of pre-publications
- University e-print archives: contain reports in electronic form on research results before they are submitted or accepted for publication by a conference or journal
- Non-traditional publications, such as Usenet discussion groups, blogs, e-mail archives of mailing lists, wiki pages: also constitute prior art, although it may be more difficult to establish their publication date

- Beware of indexing dates given to the web page by search engines: they will be later than the actual publication date
- Computer-generated time stamps



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Fifty Shades of Grey

From Wikipedia, the free encyclopedia

*This article is about the novel. For its film adaptation, see *Fifty Shades of Grey (film)*. For the novel series, see *Fifty Shades trilogy*.*

Fifty Shades of Grey is a 2011 erotic romance novel by British author E. L. James. It is the first instalment in the *Fifty Shades trilogy* that traces the deepening relationship between a college graduate, Anastasia Steele, and a young business magnate, Christian Grey. It is notable for its explicitly erotic scenes featuring elements of sexual practices involving bondage/discipline, dominance/submission, and sadism/masochism (BDSM). Originally self-published as an ebook and a print-on-demand, publishing rights were acquired by Vintage Books in March 2012.

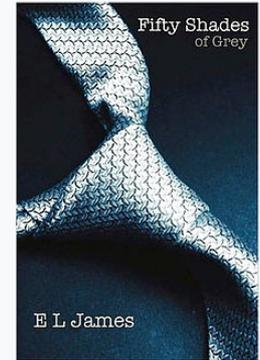
Fifty Shades of Grey has topped best-seller lists around the world, selling over 125 million copies worldwide by June 2015. It has been translated into 52 languages, and set a record in the United Kingdom as the fastest-selling paperback of all time. Critical reception of the book, however, has tended towards the negative, with the quality of its prose generally seen as poor. Universal Pictures and Focus Features produced a film adaptation, which was released on 13 February 2015^[1] and also received generally unfavourable reviews.

The second and third volumes of the trilogy, *Fifty Shades Darker* and *Fifty Shades Freed*, were published in 2012. *Grey: Fifty Shades of Grey as Told by Christian*, a version of *Fifty Shades of Grey* being told from Christian's point of view, was published in June 2015.

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Fifty Shades of Grey



2012 paperback cover

Author	E. L. James
Country	United Kingdom
Language	English
Series	<i>Fifty Shades trilogy</i>
Genre	Erotic romance
Published	20 June 2011 (Vintage Books)
Media type	Print (Hardcover, paperback)
Pages	514
ISBN	978-1-61213-028-6
OCLC	780307033
Followed by	<i>Fifty Shades Darker</i>

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Internet archiving services

- What if an internet disclosure is relevant but does not give any explicit indication of the publication date?
- The evidence may come from an internet archiving service, such as the "Wayback Machine"
 - www.archive.org
 - www.pagefreezer.com
 - <http://pandora.nla.gov.au>
- The wayback machine makes it possible to surf more than 305 billion web pages saved over time
- It assigns a URL which contains the date in which the HTML file was archived (yyymmddhhmmss)

Wayback Machine

Wayback Machine

Fifty Shades of Grey Fan / fiftyshadesofgrey.org / Your best source on Jamie Dornan...

91 captures
11 Nov 2013 - 6 Jun 2017

Go

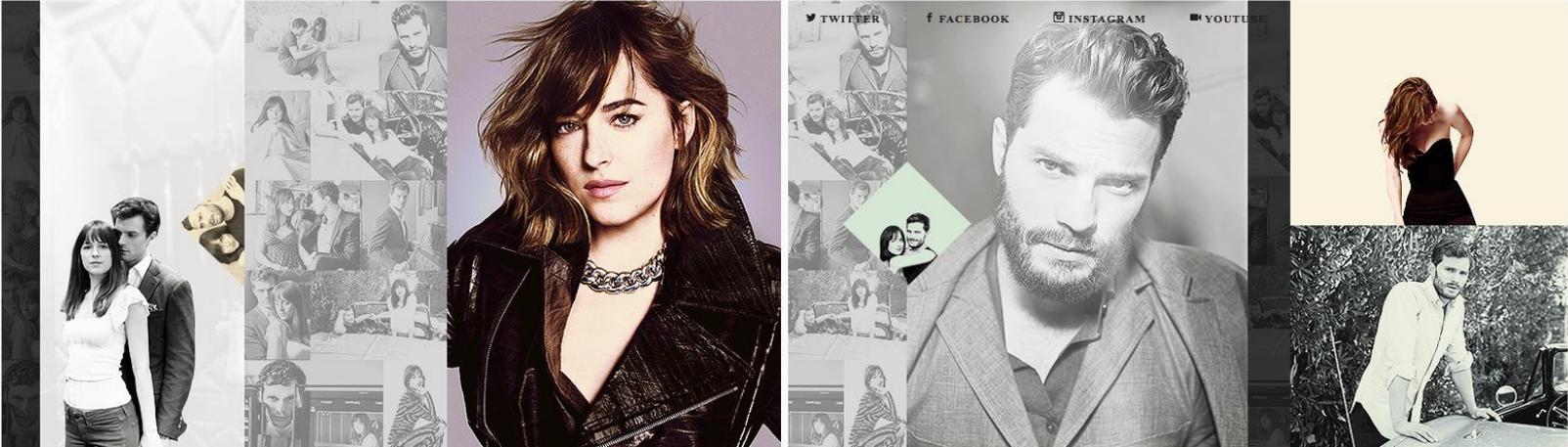
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Welcome on **Fifty Shades of Grey Fan**, your best and largest Source on the two leading stars of Fifty Shades of Grey Adaptation **Jamie Dornan** and **Dakota Johnson** since 2013. You'll find everything about the movies and the actors on the site, news, high quality pictures, videos and much more. We are members of Official Fifty and we bring you **exclusives News** from Fifty Shades. For any questions you could have, you can **email me**. I hope you'll have a wonderful time on the site. Later, Baby. **Céline**

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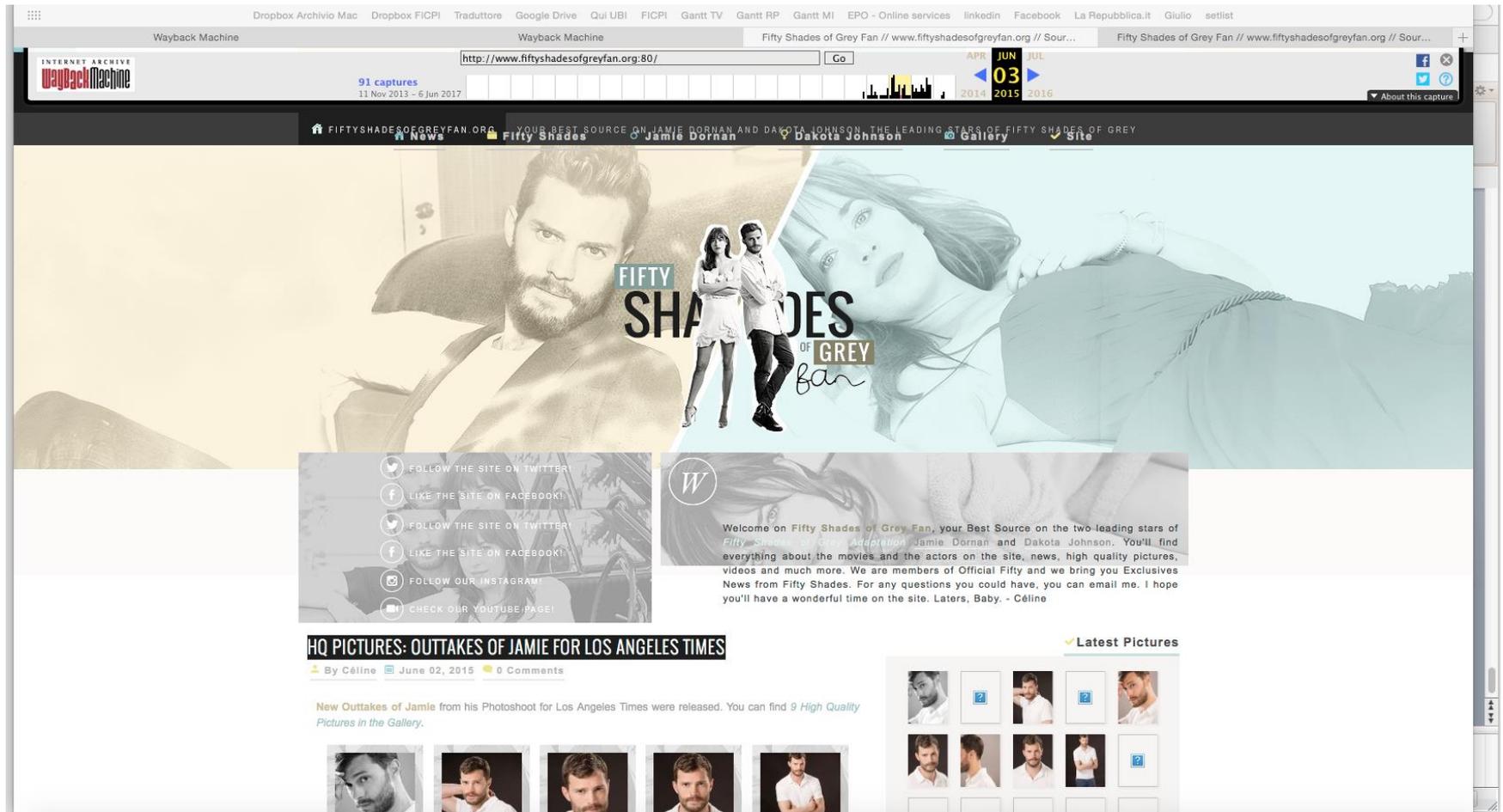
CÉLINE - MARCH 15, 2016 - 0 COMMENTS

HQ PICTURES: DAKOTA FILMS FIFTY SHADES DARKER (MARCH, 14)

110,029 Followers

193,833 Likes

97,049 Followers



T 1134/06 of 16.01.2007 (BoA 3.2.04)

- *The "images" are not necessarily instantaneous snapshots of a website ... Links may not be preserved, or, if intact, may connect to different material than at the time of capture.*
- *that an Internet disclosure is state of the art ... should be proved "**beyond any reasonable doubt**". The particular facts and evidence required will depend on each individual case, but will normally have to meet the criteria established by the jurisprudence of the Boards of Appeal in respect of a prior use or a prior oral disclosure*
 - *i.e. when, what and under which circumstances*

T 1553/06 of 12.03.2012 (BoA 3.5.04)

If, before the filing or priority date ... a document stored on the World Wide Web and accessible via a specific URL

*1.could be found with the help of a public web search engine by using one or more keywords **all related to the essence** of the content of that document and*

*2.remained accessible at that URL for **a period of time long enough** for a member of the public, i.e. someone under no obligation to keep the content of the document secret, to have direct and unambiguous access to the document,*

then the document was made available to the public...

- Period of time long enough:
 - *to be assessed on a case-by-case basis, taking into account all the circumstances of the case*
- *two and a half months: YES*
- *nearly three weeks: YES*
- *20 minutes: NO*

T 02/09 of 12.03.12 (BoA 3.5.04)

- *Even assuming that it might have been possible, along the route that an e-mail takes, to retrieve it as a whole in the absence of an existing equivalent to a public web search engine...*
- *The content of an e-mail did not become available to the public for the sole reason that the e-mail was transmitted via the Internet before the filing date ...*
- *The board rather is of the opinion that the differences between webpages and such e-mails make a strong prima facie case against public availability of the latter*

Generation of virtual chemical substances

- No BoA case law available
- No 1st instance decisions known
- EPO examiners:
 - check whether the virtual chemical substance can be obtained based on CGK
 - in case of use claims would apply the *plausibility test*
 - simple verbal statement not enough

- Based on an initial set of patent claims, a software employing automated drafting techniques can create tens of thousands of alternative patent claims.
- May serve as prior art to help invalidate other patents.
- Companies can use them to saturate the space around their own patents to prevent competitors from obtaining improvement patents in the same area.
- Companies can also saturate the space around competitors' patents to prevent the competitors from subsequently patenting improvements.

- Press release of 20.08.2016
 - *More than 100 billions cloems are now made accessible to the public.*
 - *The Cloem database is now the largest database for prior art on the planet.*
 - *Cloem will use variants in third party observations any time soon.*

So what?

- Check for earlier versions of the web page
- Use archiving services
- Check whether BoA is 3.2.04
- Check whether internet disclosure is
 - reproducible
 - merely theoretical

That's all folks!