Disclosures in the grey area
The European perspective

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Venice, 27 October 2017
The movie

FIFTY SHADES OF GREY
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).
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
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 explicit 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.
Fifty Shades of Grey: Revision history

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(cur) = difference from current version, (prev) = difference from preceding version, m = minor edit, → = section edit, ← = automatic edit summary

(newest ↓ oldest) View (newer 50 | older 50) (20 | 50 | 100 | 250 | 500)

Compare selected revisions

- (cur) | 14:57, 30 May 2017 | Firmomson (talk | contribs) | 47,970 bytes (+35) | Media: Showing Grey in grey colors is cute but color pictures are better
- (cur) | 21:55, 19 May 2017 | InternetArchiveBot (talk | contribs) | 47,935 bytes (+183) | (Rescuing 2 sources and tagging 0 as dead. #ABot (v1.3.2) (Feminist))
- (cur) | 08:58, 4 March 2017 | Ambiguously (talk | contribs) | 47,742 bytes (+80) | (→Reception: Removed Christian Science Monitor misquote, clarified text (CSM refers to only 2 publications - LA Times, NY Daily News. [Neither appear to be a central part of the literary world] though this is more a criticism of the GSI.)
- (cur) | 13:48, 26 February 2017 | Bender the Bot (talk | contribs) | 47,582 bytes (+3) | (HTTP→HTTPS for The New York Times. using AWB)
- (cur) | 15:17, 8 February 2017 | NinjaRobotPirate (talk | contribs) | 47,679 bytes (+2) | (→External links: fix template)
- (cur) | 21:52, 3 February 2017 | GreenC bot (talk | contribs) | 47,681 bytes (+133) | (Reformat 3 archive links. Wayback Medic 2.1)
- (cur) | 18:46, 31 January 2017 | Erev at (talk | contribs) | 47,548 bytes (+3) | (→Plot: where she works)
- (cur) | 18:55, 31 January 2017 | Erev at (talk | contribs) | 47,545 bytes (+1) | (→Plot: poorly
- (cur) | 05:37, 2 January 2017 | Curly Turkey (talk | contribs) | 47,544 bytes (-4) | (→Reception: No reason for this! (Tags: Mobile edit, Mobile web edit)
- (cur) | 05:36, 2 January 2017 | Curly Turkey (talk | contribs) | 47,548 bytes (0) | (→Reception: Mobile edit, Mobile web edit)
- (cur) | 11:19, 31 December 2016 | InternetArchiveBot (talk | contribs) | 47,548 bytes (+122) | (Rescuing 1 sources and tagging 0 as dead. #ABot (v1.2.7, 1))
- (cur) | 16:38, 20 December 2016 | Chaheel Riens (talk | contribs) | 47,426 bytes (-2) | (→to remove duplication of "which")
- (cur) | 22:59, 15 December 2016 | Treyblen (talk | contribs) | 47,426 bytes (-4) | (→Issues)
- (cur) | 15:33, 11 December 2016 | Bender the Bot (talk | contribs) | 47,424 bytes (+8) | (→Reception: clean up; http://https for The Guardian using AWB)
- (cur) | 13:38, 9 December 2016 | Chaheel Riens (talk | contribs) | 47,418 bytes (+25) | (Undid revision 739331328 by Piggy/nawiggy (talk) WP:ENGVAR applies, as shown by the template at the top of the editing window.)
- (cur) | 13:10, 9 December 2016 | Piggy/nawiggy (talk | contribs) | 47,383 bytes (-25) | (→Plot: Added several commas and modified/simplified some sentences for grammar. Corrected a few misspellings. Changed the spelling of a few other words from the British-English variants to their American-English variants. (Tags: Visual edit)
- (cur) | 13:01, 9 December 2016 | Piggy/nawiggy (talk | contribs) | 47,418 bytes (+137) | (→Background and publication: Sleeping Beauty is trilogy (not quartet). Edited impact to better match article cited to.) (Tags:
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
- 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 (yyyyymmddhhmmss)
Welcome on Fifty Shades of Grey Fan, your best and largest source on the two leading stars of Fifty Shades of Grey, Jamie Dornan and Dakota Johnson. Since 2013, the site is all about Fifty Shades and the movies and the actors on the site, news, high quality pictures, videos and much more. We are members of Official Fifty and we are happy to welcome you on Fifty Shades Fan. For any questions you could have, you can email me. I hope you'll have a wonderful time on the site. Laters, Baby!
• The "images" are not necessarily instantaneous snap
shots 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
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
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!