



Electronic disclosure as a source of prior art and infringement

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Electronic disclosure

Internet

World Wide Web,
Electronic-mails,
Social Networks;

Television

Broadcast Television
Cable Television



Internet: media and interactivity

- telephone
- television
- newspaper
- book
- film
- music
- company brochures
- product adv
- instruction manuals
- instant messaging
- Internet forums
- social networking
- online shop
- auction site



E-disclosure and prior art

Critical issues

- Authenticity, veracity and integrity of information
- The information may change without notice, or even disappear without leaving any trace
- Retrieval of information
- Determination of the time of disclosure



Japan – Patent Law

Impact on national Patent Law - Japan

Section 29(1) of the Patent Law provides that:

(1) Any person who has made an invention which is industrially applicable may obtain a patent therefor, except in the case of the following inventions:

...

(iii) inventions which have been described in a publication distributed in Japan or elsewhere or **inventions which became available to the general public through telecommunication lines in such places prior to the filing of the patent application.**”



Japan - Guidelines

“The examiner should not cite information on web sites etc. for which neither points of contact nor time of publication thereof is clearly indicated, because there is only a small possibility of clearing the doubt.”

Exclusions from prior art

- ① Web sites accessible by chance - the URL is not public
- ② Intranet
- ③ Web sites with information which is encoded in such a way that it cannot generally be read
- ④ Information that is not published for long enough as to be accessed by the public (e.g. information which is published on the Internet for a short period of time).



US Patent Law

Impact on national Patent Law - USA

35 USC § 102. Conditions for patentability; novelty

(a) the invention was known or used by others in this country, or patented or described in a **printed publication** in this or a foreign country, before the invention thereof by the applicant for patent, or

...

Leahy-Smith America Invents Act”.

(a). A person shall be entitled to a patent unless

(1) the claimed invention was patented, described in a **printed publication**, or in **public use**, on **sale**, or **otherwise available to the public** before the effective filing date of the claimed invention; or



US MPEP 2128

Date of Availability

Absent evidence of the date that the disclosure was publicly posted, if the publication itself does not include a publication date (or retrieval date), it cannot be relied upon as prior art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication or posting.

Extent of Teachings Relied Upon

In situations where the electronic version and the published paper version of the same or a corresponding patent or printed publication differ appreciably, each may need to be cited and relied upon as independent references based on what they disclose.



Korean Patent Law

Impact on national Patent Law - Republic of Korea

Article 29

Requirements for Patent Registration

(1) Inventions that have industrial applicability are patentable unless they fall under either of the following subparagraphs:

- (i) inventions publicly known or worked in the Republic of Korea or a foreign country before the filing of the patent application; or
- (ii) inventions described in a publication distributed in the Republic of Korea or a foreign country, **or inventions publicly available through telecommunication lines as prescribed by Presidential Decree**, before the filing of the patent application.



KR Presidential Decree

Telecommunication lines prescribed by Presidential Decree include telecommunication lines operated by:

governmental bodies

international organization

public school provided for in Article 3 of Higher Education Act or **foreign public university**;

research institutes;

a juridical person set up for the purpose of **conducting patent information related task** and designated and announced by the Commissioner of KIPO.

Information published through telecommunication lines other than those prescribed by Presidential Decree is not prior art as provided for in Article 29.1.2 of the Act but can be prior art of publicly known technology as provided for in Article 29.1.1 of the Act, if its **content and publication date are proved.**

Invention available to the public for use is an invention which is open to the general public. Thus, invention inaccessible through common search engines or which has a password for login can be prior art only if the general public has access.



Chinese Patent Law

Conditions for Granting Patent Rights Article 22

Inventions and utility models for which patent rights are to be granted shall be ones which are novel, creative and of practical use.

Novelty means that the invention or utility model concerned is not an **existing technology**; ...

For the purposes of this Law, **existing technologies mean the technologies known to the public both domestically and abroad before the date of application.**



Chinese Guidelines

Part II Chapter 3 Novelty

2.1 Prior art

... The prior art includes any technology which has been disclosed in publications in China or abroad, or has been publicly used or made know to the **public by any other means** in China or Abroad, before the date of filing ...

2.1.2 Means of Disclosure

Publication

(typed paper documents, patents documents, scientific technical magazines – books, academic theses, specialized documents, textbook, technical manuals officially published proceedings, technical reports, newspapers, sample books, products catalogues, advertisement brochures,)
Audio video made by electric, optic, magnetic, protographic means - **Internet and database -**

PART IV Chapter 8 provision of evidence in invalidation procedure

Producing evidence by the party concerned

Burden of proof on the party challenging the validity

Cross examination of evidence

5.1 Publication time of Evidence in Internet

The earliest time when the public can find the information on the Internet is the publication time of the information, usually the issuance time of the information on the Internet is deemed as the publication time of the information



E-disclosure and prior art

EP Art 54 EPC

- (1) An invention shall be considered to be new if it does not form part of the state of the art.
- (2) The state of the art shall be held to comprise everything made available to the public before the date of filing of the European patent application by means of:
 - written or oral description
 - use
 - **or in any other way**

The Enlarged Board of Appeal has emphasised in G1/92 (OJ 1993 277) that:

“... Article 54(2) EPC does not make any distinction between the different means by which any information is made available to the public...”



EPO Burden and standard of proof

The burden of proof lies initially with the examiner.

This means that objections must be reasoned and substantiated, and must show that, on the **balance of probabilities**, the objection is well-founded.

If this is done, it is then up to the applicant to prove otherwise - the burden of proof shifts to the applicant.

(Guidelines C, IV, 6.2.3)



EPO no publication date

Information relating to a web page available from an internet archiving service. The most prominent service is the **Internet Archive** accessible through the so-called "**Wayback Machine**" (www.archive.org).

Timestamp information relating to the history of modifications applied to a file or web page

Computer-generated timestamp information as available from file directories or other repositories, or as automatically appended to content (e.g. forum messages and blogs).

Indexing dates given to the web page by search engines (e.g. from the Google cache).

Information relating to the **publication date embedded in the internet disclosure** itself. Date information is sometimes hidden in the programming used to create the website but is not visible in the web page as it appears in the browser. Examiners may, for example, consider the use of **computer forensic tools** to retrieve such dates.

Information about **replication of the disclosure at several sites** (mirror sites) or in several versions.

Enquiries with the owner or the author of the website when trying to establish the publication date to a sufficient degree of certainty. The probative value of statements so obtained will have to be assessed separately.

If no date can be obtained (other than the date of retrieval by the examiner, which will be too late for the application in question), the disclosure cannot be used as prior art during examination.

(Guidelines C, IV, 6.2.4)



Judicial bodies

Standard of proof of the Board of appeal of the EPO

- Beyond any reasonable doubt **T 1134/06; T 1875/06**
- Beyond any reasonable doubt EPO opposition proceedings **EP 1,597,138**, Wayback Machine results corroborated by the testimony of a witness.
- The German Patent Court judged the Wayback machine unreliable for the purpose of establishing the date when a web page has been made available to the public. **W 17 (pat) 01/02.**



Judicial bodies

OHIM Invalidity Division of OHIM for RCD

ICD 3184 The “excerpt” of the Applicant’s website was not admitted as prior art. The Invalidity division asserted that the Applicant could have for instance provided a more convincing evidence where the “excerpt” had been produced by the Wayback Machine.

ICD 4570 The printouts of the web pages in D1 contain a date of printout. Taking into account the way the contents of the web pages are made available on the Internet and the way the printouts of the web pages are dated when being printed on computer printers, it is considered that the contents of the printouts have been publicly disclosed at least on the date of the printout.

ICD 7178 The publication appeared on a blog with an exact indication of the date, as well as the time when it was put on the blog. It lies in the nature of a blog that it is addressed to the public and that the contributions published on a blog are dated.



Enclosure in a patent

Examination proceedings at the EPO

Prior patent application including a reference to URL addresses of websites for indicating preferred form of embodiments of an implement cooperating with the subject matter of the invention.

The examiner held that the combined disclosure of the prior patent application and the content of an undated website anticipates the invention.

In my reply, I challenged the fact there was no specific reference to a device by a mere reference to company addresses and URL addresses; there were no dates in the website; the examiner failed to enclose a printout to show at least what he meant in his opinion and failed to show what the applicant meant when the application was drafted.

The case is pending and questions arise with respect to the enablement of disclosure and consolidated prior art.

The examiner could ask the technical Information center to clarify how the website looked like at the time the patent application was drafted (or published).



Internet Archive

Wayback Machine (available since 2001)

This service allows to see archived versions of web pages of millions of websites and their associated data (images, source code, documents, etc.) stored in a database.

The service can be used to see what previous versions of websites used to look like, to grab original source code from websites that may no longer be directly available, or to visit websites that no longer exist.

Many website owners choose to exclude their sites.

Robots.txt is used as part of the Robots Exclusion Standard, a voluntary protocol the Internet Archive respects that disallows bots from indexing certain pages delineated by the creator as off-limits.

Currently, the Internet Archive applies robots.txt rules retroactively. In cases of blocked sites, only the robots.txt file is archived.

Snapshots usually take at least 6–18 months to be added.



Internet Archive

The screenshot shows the Internet Archive homepage in a web browser. The browser's address bar displays <http://www.archive.org/index.php>. The page features a navigation menu with links for [Web](#), [Moving Images](#), [Texts](#), [Audio](#), [Software](#), [Education](#), [Patron Info](#), and [About IA](#). Below this, there are links for [Forums](#), [FAQs](#), [Contributions](#), [Jobs](#), and [Donate](#). A search bar is present with the text "Search:" and a dropdown menu set to "All Media Types", followed by a "GO!" button. The main content area is divided into several sections:

- Announcements (more)**: Contains links for [Internet Archive Helps](#), [Secure Exemption To The Digital Millennium Copyright Act](#), [Tech Award to the Internet Archive](#), and [Try the new Archive Blog](#).
- Web**: Features the **Wayback Machine** logo, a search input field containing "http://", and buttons for [Take Me Back](#) and [Advanced Search](#). It also displays "55 billion pages".
- Welcome to the Archive**: Includes an **RSS** icon and a paragraph: "The Internet Archive is building a digital library of Internet sites and other cultural artifacts in digital form. Like a paper library, we provide free access to researchers, historians, scholars, and the general public."
- Moving Images**: Shows "46,143 movies" and icons for a camera and a film strip. It includes links for [Browse \(by keyword\)](#) and [Upload your own movie](#).
- Live Music Archive**: Shows "40,341 concerts" and a speaker icon. It includes links for [Browse \(by band\)](#) and [Upload your own concert](#).
- Audio**: Shows "107,467 recordings" and a speaker icon. It includes links for [Browse \(by keyword\)](#) and [Upload your own recording](#).
- Texts**: Shows "57,766 texts" and a document icon. It includes links for [Browse \(by keyword\)](#) and [Upload your own text](#).

At the top right, the slogan "Universal access to human knowledge" is displayed. The user is identified as "Anonymous User" with links for [login](#) or [join us](#).



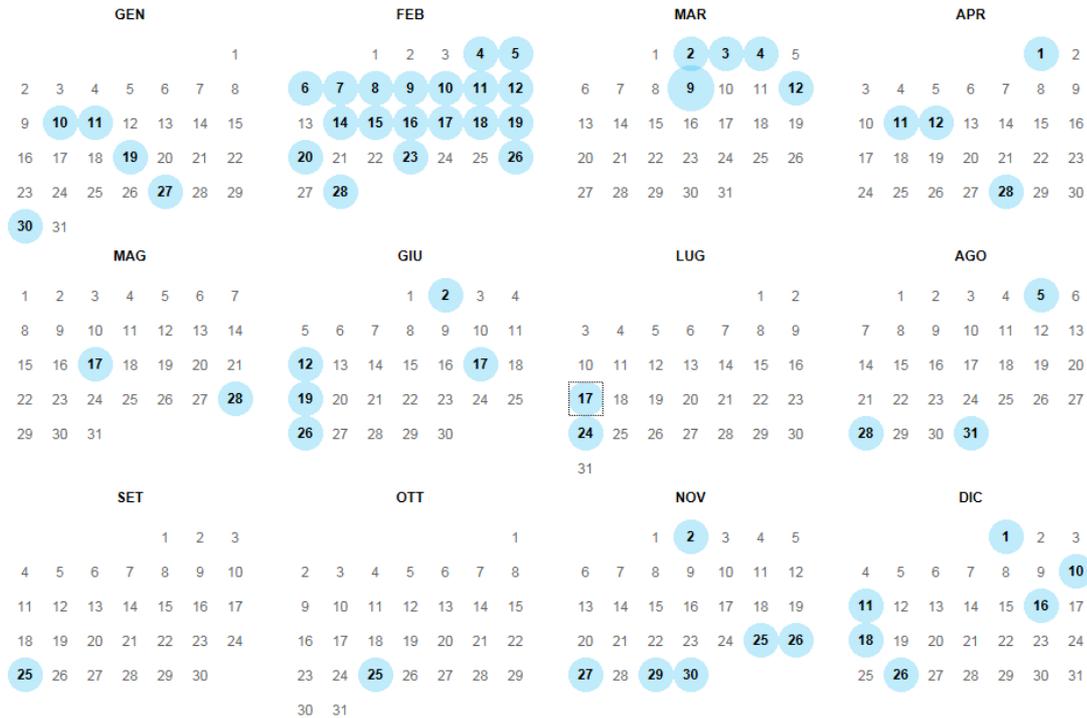
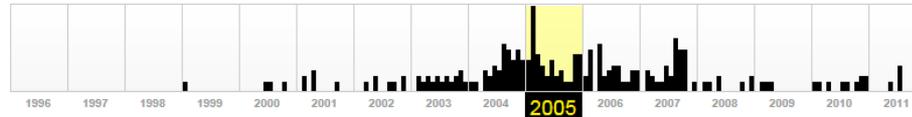
Internet Archive



<http://www.ficpi.org>

Go Wayback!

<http://www.ficpi.org> has been crawled 241 times going all the way back to [gennaio 25, 1999](#).
A crawl can be a duplicate of the last one. It happens about 25% of the time across 420,000,000 websites. [FAQ](#)



Internet Archive



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a non-political,
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Internet Archive



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E-disclosures – Prior art

Concluding remarks

Electronic disclosures are prior art for patents and designs provided that their publication dates and their contents satisfy the standard of proof of the relevant Examination Authority or Judicial Body.

Judicial Bodies often apply higher standard of proof than Examining Authorities.

Care should be taken not to self-anticipate an invention because many countries do not have provisions granting a grace period.

In the trademark field, a prior art is a prior registered trademark or, in some countries, an unregistered trademark. However, a website showing a sign is insufficient to, alone, prove the prior use of an unregistered trademark.



E-disclosure and infringement

When does infringement occur?

Who has jurisdiction to assess liability?

Is mere accessibility of a website enough to find jurisdiction in the location of website access?

Are online auctions liable for IP infringement committed by users?

Can users book a third party mark as a keyword?

Is a Search Engine liable for the sale of third party marks as keywords?



Cyberspace and national Law

- Borderless nature of Internet

- National IP laws
- Statutory law regulating electronic commerce
- Enforcement of IP rights

WIPO Joint Recommendation concerning provisions on the protection of Marks and other industrial property rights in signs on the internet

Commercial effect in a member state

Non exhaustive list of factors to be evaluated in order to determine the commercial effect

Customers

Disclaimer for certain member states

Languages

Telephone / address

Post sale services

Official currency

Interactive contact

Adopted by the Paris Union and WIPO on October 3, 2001



E-disclosure and infringement

Liability of intermediaries

The safe harbor provision of Article 14 of 2000/31/EC (E-Commerce Directive)

1. Where an information society service is provided that consists of the storage of information provided by a recipient of the service, Member States shall ensure **that the service provider is not liable for the information stored at the request of a recipient of the service**, on condition that:

(a) **the provider does not have actual knowledge of illegal activity** or information and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent; or

(b) the provider, **upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.**



E-disclosure and infringement

Liability of intermediaries

Tiffany v eBay (2010) United States of America,

US

The U.S. Court of Appeals for the Second Circuit rejected the claim of direct infringement on the basis that eBay used the mark to describe accurately the genuine Tiffany goods offered for sale on the site.

An auction site may be liable if it “continues to supply its service to one whom it knows or has reason to know is engaging in trademark infringement”.

Because eBay, upon acquiring specific knowledge of infringements, removed those listings and suspended repeat offenders, eBay had not failed to uphold this legal standard and was held not liable for contributory trademark infringement.

Principle

Willful blindness is equivalent to actual knowledge



E-disclosure and infringement

Liability of intermediaries

L'Oréal vs eBay France SA Case RG 07/11365 May 2009.

FR

According to the Court, eBay had fulfilled its obligation in good faith and had done its due diligence to prevent infringing goods being sold through its site. In order to ground liability, the case would require evidenced knowledge on the part of eBay of infringing content and a failure to remedy it.

In Lancôme Parfums v eBay Case A/07/06032. Brussels Commercial Court Belgium
August 2008

BE

The court found that eBay was not liable because it “did not have actual knowledge of illegal information it hosted, or it was not aware of any facts or circumstances suggesting such illegal nature, and upon obtaining such knowledge or awareness, it had acted promptly to remove the information or render it inaccessible”.



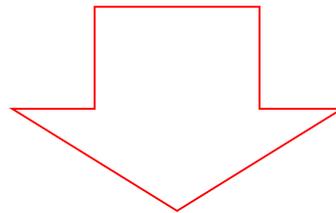
E-disclosure and infringement

ECJ L'Oreal v. eBay 12 July 2011

UE

The ECJ indicates that when the operator of an online marketplace provides assistance which entails, in particular, optimizing the presentation of the offers for sale in question or promoting them is not within the safe harbor of Art. 14 of the E-commerce directive.

The ECJ indicates that the third sentence of Article 11 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights must be interpreted as requiring the Member States to ensure that the national courts are able to order the operator to preventing further infringements of the same kind of occurred infringements irrespective of their liability.



Effective, proportionate, and dissuasive injunctions



E-disclosure and infringement

Liability of Search Engines and keywords advertisers

Rescuecom Corp. v Google Inc.(2d Cir. 2009).

US

The Second Circuit recently handed down a landmark verdict in the case of RescueCom v Google, holding that Google’s sale of plaintiff’s trademark as a keyword to competitors, which caused competitor’s advertisements to appear on user’s screens whenever a user searched for the term “Rescuecom”, was sufficient to constitute a **“use in commerce”**.

UE

In Google France SARL v Louis Vuitton Malletier SA (C-236/08, C-237/08 & C-238/08) [2010] the ECJ held that “an internet referencing service provider which stores, as a keyword, a sign identical with a trademark and organizes the display of advertisements on the basis of that **keyword does not use that sign within the meaning of the Trademark Directive**”.



E-disclosure and infringement

Liability of Search Engines and keywords advertisers

Google v Guangdong Gangyi Electrical Appliance Co Ltd

CN

Google China linked NEDFON, the registered trademark of Gangyi, to the homepage of Third Electrical who purchased the NEDFON mark as a keyword through Google's AdWords service. The Guangzhou Court held Third Electrical liable for infringement and Google not liable for trademark infringement because Google was not in the position to control information submitted by Third Electrical, and it had no obligation to examine the legality of the information. In addition, Google discontinued the keyword advertising service provided to Third Electrical after the lawsuit was initiated.

Baidu v Shanghai Dazhong House-moving Logistics Co Ltd

CN

Baidu is a Chinese language search engine that was sued by Dazhong in the Shanghai Court because Baidu linked the keywords 'Dazhong Banchang' to the web pages of other moving companies using Baidu's bid ranking service. The Shanghai court held that Baidu had infringed the trademark rights of Dazhong.



E-disclosure and infringement

Liability of Search Engines and keywords advertisers

13-01-2011 BBY Vertriebsgesellschaft vs. Eis.deEis.de

DE

The Bundesgerichtshof confirmed that users can book a third party trade mark as a keyword, for example as a Google Adword, as long as the resulting sponsored link is shown in a specially marked advertising block that is visually set apart from the list of “normal” search results.

What is not allowed is any reference in the sponsored link to the trademark, the trade mark proprietor or the trade mark proprietor’s products.

Further, the URL of the sponsored link must indicate a different economic origin.

In other words, the internet users looking at the sponsored link shall be able to understand that the sponsored link is not the trade mark proprietor offering its goods or services but another player.



E-disclosure and infringement

Liability of Search Engines and keywords advertisers

NETWORK AUTOMATION INC v. ADVANCED SYSTEMS CONCEPTS INC No. 10-55840. March 08, 2011 **US**

The Ninth Circuit clarified that the use of another's trademark as a search engine keyword to trigger one's own product advertisement is "use in commerce" and may violate the Lanham Act. Prior to its decision in this case, the Ninth Circuit assumed without expressly deciding that the use of a trademark as a search engine keyword that triggers the display of a competitor's advertisement is a "use in commerce."

In Case C-323/09, Inteflora v M&S 22 September 2011 **UE**

The ECJ indicated that the key question for the English Court will be: first, whether the **reasonably well-informed and reasonably observant internet user** is deemed to be aware, on the basis of general knowledge of the market, that M & S's flower-delivery service is not part of the Interflora network but is, on the contrary, in competition with it and, second, should it become apparent that that is not generally known, whether M & S's advertisement enabled that internet user to tell that the service concerned does not belong to the Interflora network.



E-disclosure and infringement

Concluding remarks

Brand owners feel concerned about the dilution of their marks because of the Adwords market. Probably a more clearly identified area for the sponsored links could be of some help.

The fastest growing area of counterfeit trade is online.

On the one side, the current legal framework seems not to provide adequate tools for the brand owners to fight online IP infringement.

On the other side, brand owners can better detect infringements by monitoring the web and in particular auction sites.

Do we need another law?



**Thank you for your
attention!**