

# CATALOGUE OF DIFFERING PRACTICES

## REDRAFTED SECTION ON PRIOR ART DISCLOSURES (SEPTEMBER 2012)

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### 1 Special terminology

**Confidentiality agreement (CA):** legal contract between at least two parties outlining confidential material, knowledge, or information that the parties wish to share with one another for certain purposes, but wish to restrict access to or by third parties.

**Conflicting application, interfering document, enlarged concept of novelty:** patent application or document filed before the earliest priority date or filing date of the current patent application, published after said date and disclosing relevant subject-matter.

**Standards:** established technical norms or requirements usually set up and defined by regulatory bodies (e.g. IEEE, ETSI, 3GPP etc.), corporations, other professional bodies, standardization organizations and available in form of e.g. technical specifications or contribution to meetings.

	EPO	JPO	KIPO	SIPO	USPTO
<b>Legal basis</b>	Article 54 EPC.	Article 29(1) Patent Act.	Article 29(1) Patent Act.	Article 22.5 Patent Law.	Title 35 U.S.C. 102.
<b>Legal definition</b>	<ul style="list-style-type: none"> <li>• An invention shall be considered to be new if it does not form part of the state of the art.</li> <li>• The state of the art shall be held to comprise 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.</li> </ul>	<p>An inventor of an invention that is industrially applicable is entitled to obtain a patent for said invention except for the following cases:</p> <ul style="list-style-type: none"> <li>• Inventions that were publicly known in Japan or a foreign country, prior to the filing of the patent application;</li> <li>• Inventions that were publicly worked in Japan or a foreign country, prior to the filing of the patent applications; or</li> <li>• Inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the patent application.</li> </ul>	<p>Inventions that have industrial applicability are patentable unless they fall under either of the following cases:</p> <ul style="list-style-type: none"> <li>• Inventions publicly known or worked in the Republic of Korea or a foreign country before the filing of the patent application;</li> <li>• Inventions described in a publication distributed in the Republic of Korea or a foreign country, or inventions publicly available through telecommunication lines, before the filing of the patent application.</li> </ul>	<ul style="list-style-type: none"> <li>• Any technology known to the public before the date of filing in China or abroad.</li> </ul>	<p>Entitlement to a patent unless:</p> <ul style="list-style-type: none"> <li>• The invention was known or used by others in the United States, or patented or described in a printed publication in the United States or a foreign country, before the invention thereof by the applicant;</li> <li>• The invention was patented or described in a printed publication in the United States or a foreign country or in public use or on sale in the United States, more than one year prior to the date of the application for a patent in the United States.</li> </ul> <p>Other more detailed restrictions apply.</p>
<b>Relevant date of application for applying prior art</b>	<ul style="list-style-type: none"> <li>• The valid priority date (day) or the filing date for a first filing.</li> </ul>	<ul style="list-style-type: none"> <li>• The valid priority date or the filing time (hours and minutes) for the Japanese filing.</li> </ul>	<ul style="list-style-type: none"> <li>• The valid priority date or the filing time (hours and minutes) for the Korean filing.</li> </ul>	<ul style="list-style-type: none"> <li>• The valid priority date (day) or the filing date for a first filing.</li> </ul>	<ul style="list-style-type: none"> <li>• There are three relevant dates:               <ol style="list-style-type: none"> <li>(1) The actual filing date;</li> <li>(2) the U.S. effective filing date which is the filing date of the earliest prior-filed U.S. application or international (PCT) application designating the U.S. that is identified in a valid domestic benefit claim;</li> <li>(3) Foreign priority date where the application may be entitled to the benefit of the filing date of an earlier foreign application if certain conditions are met.</li> </ol> </li> </ul>
<b>Availability to the public</b>	<ul style="list-style-type: none"> <li>• Potential availability is sufficient, not the actual consultation of the knowledge by members of the public.</li> </ul>	<ul style="list-style-type: none"> <li>• An invention the content of which is known to unspecified persons without an obligation of secrecy or which has</li> </ul>	<ul style="list-style-type: none"> <li>• Potential availability is sufficient, not the actual consultation of the knowledge by members of the public.</li> </ul>	<ul style="list-style-type: none"> <li>• The prior art must be available to the public before the date of filing and must contain such contents from</li> </ul>	<ul style="list-style-type: none"> <li>• A patent or printed publication is sufficiently available to the public if it is laid open for public inspection or</li> </ul>

		<p>been worked in a situation where its content could be publicly known.</p> <ul style="list-style-type: none"> <li>• Regarding "distributed publications", "distribution" means that unspecified persons could potentially read a publication, regardless of whether someone actually did read it.</li> </ul>		<p>which the public can obtain substantial technical knowledge.</p> <ul style="list-style-type: none"> <li>• Technology known to the public means that the relevant technical content is placed in such a state that persons can know it if they wish regardless of whether the public had actually known it.</li> </ul>	<p>dissemination in printed form to the extent that persons interested and ordinarily skilled in the subject matter, exercising reasonable diligence, can locate it.</p> <ul style="list-style-type: none"> <li>• When a publication is accessible through a library or a patent office actual consultation is not needed.</li> </ul>
<b>Geographical limitations</b>	None.	None.	None.	None.	<ul style="list-style-type: none"> <li>• There are no geographical limitations for relying on patents or printed publications as prior art.</li> <li>• Prior art based on knowledge, use, public use, or on sale must be in the United States.</li> </ul>
<b>Non-availability to the public</b>	<ul style="list-style-type: none"> <li>• Use on non-public properties.</li> <li>• Manufacturing at a third company as sub-contractor.</li> <li>• Products made available for test purposes.</li> </ul>	<ul style="list-style-type: none"> <li>• Knowledge shared under confidentiality.</li> <li>• Making or using of an invention where persons skilled in the art may not understand the content of the invention.</li> </ul>	<ul style="list-style-type: none"> <li>• Use on non-public properties.</li> <li>• Products kept (partially) secret.</li> </ul>	<ul style="list-style-type: none"> <li>• Technical contents in the state of secrecy; publications distributed in a restricted scope and required to be kept confidential.</li> <li>• If at an exhibition or demonstration of a product no explanation of the technical contents is provided, the exhibition or demonstration is not a disclosure by use.</li> </ul>	<ul style="list-style-type: none"> <li>• Secret disclosures, also secret patents.</li> <li>• Documents and items only distributed internally within an organization which are intended to remain confidential.</li> <li>• Knowledge for which there is deliberate attempt to keep it or its use secret.</li> </ul>
<b>The public</b>	<ul style="list-style-type: none"> <li>• Persons having access to the disclosure if there is no confidentiality agreement.</li> </ul>	<ul style="list-style-type: none"> <li>• Unspecified persons: any person not bound by confidentiality obligation.</li> </ul>	<ul style="list-style-type: none"> <li>• Anyone having access to the disclosure if there is no confidentiality agreement.</li> </ul>		<ul style="list-style-type: none"> <li>• Persons not bound by secrecy.</li> </ul>
<b>Not the public</b>	<ul style="list-style-type: none"> <li>• Persons having privileged knowledge by employment or membership of an association, and/or are bound by explicit or implicit confidentiality agreements.</li> <li>• Contracted suppliers/client or business partners are not members of the public.</li> </ul>	<ul style="list-style-type: none"> <li>• Persons bound by confidentiality obligation.</li> </ul>	<ul style="list-style-type: none"> <li>• Persons having privileged knowledge by employment or membership of an association, and/or are bound by explicit or implicit confidentiality agreements.</li> <li>• Contracted suppliers/client or business partners are not members of the public.</li> </ul>	<ul style="list-style-type: none"> <li>• Persons having the obligation to keep secret.</li> </ul>	<ul style="list-style-type: none"> <li>• Persons bound by any kind of confidentiality agreement.</li> </ul>
<b>Written disclosures</b>	<ul style="list-style-type: none"> <li>• Any written publication.</li> </ul>	<ul style="list-style-type: none"> <li>• Any distributed publication.</li> </ul>	<ul style="list-style-type: none"> <li>• Any written publication.</li> </ul>	<ul style="list-style-type: none"> <li>• Any written publication.</li> </ul>	<ul style="list-style-type: none"> <li>• Any publication laid open for public inspection or disseminated in printed form.</li> </ul>

<b>Standards</b>	<ul style="list-style-type: none"> <li>• A standard is prior art if it fulfils certain criteria concerning secrecy and availability.</li> <li>• A standard is not prior art when there is no clear publication and there is sufficient evidence of a confidentiality agreement.</li> <li>• Standardization discussions are assumed to be public where there is no clear evidence to the contrary.</li> </ul>	<ul style="list-style-type: none"> <li>• There is no special provision for technical standards.</li> </ul>	<ul style="list-style-type: none"> <li>• Standards are regarded as common general knowledge.</li> </ul>	<ul style="list-style-type: none"> <li>• There is no special provision for technical standards.</li> </ul>	<ul style="list-style-type: none"> <li>• There is no special provision for technical standards.</li> </ul>
<b>Oral disclosures</b>	<ul style="list-style-type: none"> <li>• A lecture belongs to the state of the art; testimony from only the lecturer is not sufficient to prove disclosure.</li> <li>• If there are no transcripts or handouts, then sworn statements from the lecturer and members of the audience are taken into account.</li> <li>• Radio or television broadcasts, audio or video recordings, with or without the corresponding transcript.</li> </ul>	<ul style="list-style-type: none"> <li>• Inventions that are "publicly known" are, in most of the cases, known through lectures and presentations. They are identified based on the factual details explained in lectures and presentations.</li> </ul>	<ul style="list-style-type: none"> <li>• Oral disclosures are prior art. An affidavit or a written summary is needed to verify the oral disclosure.</li> </ul>	<ul style="list-style-type: none"> <li>• Contents of talking, reporting, or speaking at symposia.</li> <li>• Contents of broadcasting, televising, or cinematographing that can be received by the public.</li> </ul>	<ul style="list-style-type: none"> <li>• An oral disclosure presented in a forum open to all interested persons constitutes a printed publication if written copies thereof are disseminated without restriction.</li> </ul>
<b>Internet disclosures</b>	<ul style="list-style-type: none"> <li>• All types of Internet disclosures are part of the state of the art.</li> <li>• When the date is not evident, examiners are advised to investigate reputable Internet archives.</li> <li>• Unless there are specific indications to the contrary, or unless the applicant provides some, the date and content are accepted as being correct.</li> </ul>	<ul style="list-style-type: none"> <li>• All types of Internet disclosures are part of the state of the art.</li> <li>• In principle, examiners should not cite information lacking an indication of the time/date of publication, unless a person with responsibility for the publication or maintenance of said published information produces a certificate about the time/date of publication together with the content thereof.</li> </ul>	<ul style="list-style-type: none"> <li>• Internet disclosures prescribed by a Presidential Decree constitute the state of the art.</li> </ul>	<ul style="list-style-type: none"> <li>• Treated as written disclosures.</li> </ul>	<ul style="list-style-type: none"> <li>• An electronic publication, including an on-line database or Internet publication, is considered to be a printed publication as of the date the item was publicly posted.</li> <li>• If there is no evidence of the date that the disclosure was publicly posted, it can not be relied upon as prior art.</li> </ul>
<b>Disclosure by use</b>	<ul style="list-style-type: none"> <li>• Evidence of use usually requires written evidence (affidavits, sworn statements) or testimony.</li> </ul>	<ul style="list-style-type: none"> <li>• "Working" of an invention includes "using" of the invention.</li> </ul>	<ul style="list-style-type: none"> <li>• Sale of the product is regarded as "public working".</li> </ul>	<ul style="list-style-type: none"> <li>• Disclosure by use means that by use the technical solution is disclosed or placed in the state of being available to the public.</li> </ul>	<ul style="list-style-type: none"> <li>• Public use or on sale, only in the United States of America.</li> <li>• There is a public use even if the inventor puts the invention on display, or sells it, completely hidden from view as part of a larger</li> </ul>

					<p>machine, if the invention is otherwise used in its natural and intended way and said machine is accessible to the public.</p> <ul style="list-style-type: none"> <li>• Experimental use or sale is not considered to be prior art.</li> </ul>
<p><b>Conflicting applications and prior art based on effective filing dates</b></p>	<ul style="list-style-type: none"> <li>• The prior art only for novelty assessment also includes the whole disclosure of European and PCT patent applications, not national applications, filed before the valid priority date of the application and published on or after the priority date of the application.</li> </ul>	<ul style="list-style-type: none"> <li>• If an invention claimed in a later application is identical or substantially identical to an invention indicated in a prior application, the latter application cannot be patented.</li> <li>• Conflicting applications can be Japanese applications and PCT applications when they designated Japan and either they are in Japanese or a translation into Japanese is filed.</li> </ul>	<ul style="list-style-type: none"> <li>• Inventions described in a prior application for a patent or a utility model registration, which have been filed before the filing date of a later patent application and laid open or published after the filing of the later patent application, which are identical to an invention claimed in a later application.</li> <li>• Conflicting applications can also be PCT applications which are in Korean or a translation into Korean is filed.</li> </ul>	<ul style="list-style-type: none"> <li>• For novelty assessment only: Chinese applications or PCT applications that enter the national phase in China filed prior to the filing date of the application being examined by the Patent Office and published or announced on or after the filing date.</li> </ul>	<ul style="list-style-type: none"> <li>• A U.S. patent or published U.S. patent application can be relied upon as prior art as of its application/effective filing date even though the document was likely not available to the public on the effective filing date of the application being examined.</li> <li>• An international filing date which is on or after 29 November 2000 can be relied on as a U.S. filing date if the international application designated the United States and was published in English.</li> </ul>
<p><b>Grace period</b></p>	<ul style="list-style-type: none"> <li>• A grace period of six months before the actual filing date (not the priority date) of the application is granted under only two specific cases: if the disclosure was due to an evident abuse in relation to the applicant or if the disclosure was done by the applicant in an international exhibition recognized by the EPO.</li> </ul>	<ul style="list-style-type: none"> <li>• A disclosure is not to be taken into consideration in determining novelty and inventive step if it has been accomplished within six months before the filing date when the disclosure has been accomplished against the will of the person having the right to obtain a patent or when the disclosure has been accomplished as a result of an act of the person having the right to obtain a patent.</li> </ul>	<ul style="list-style-type: none"> <li>• When a public disclosure of an invention made by a person who has a right to obtain a patent falls under any of the following paragraphs and the person files a patent application within twelve months from the date of disclosure, the invention is not to be taken into consideration in determining novelty and inventive step: <ul style="list-style-type: none"> <li>(i) Where an invention is laid open by a person with the right to obtain a patent prior to the filing of the application;</li> <li>(ii) When an invention is publicly known, against the intention of a person with the right to obtain a patent.</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• A period of six month before the filing date (or the priority date if applicable) if the disclosure was first exhibited at an international exhibition sponsored or recognized by the Chinese Government or first made public at a prescribed academic or technological meeting or disclosed by any person without the consent of the applicant.</li> </ul>	<ul style="list-style-type: none"> <li>• Applicants are given a one year grace period measured from the U.S. effective filing date. It does not matter how the public came into possession of the invention: it could occur by a public use, public sale, a publication, a patent or any combination of these.</li> </ul>

## 2 Legal basis for determining prior art disclosures

### 2.1 Legal definition

#### 2.1.1 EPO

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.

#### 2.1.2 JPO

An inventor of an invention that is industrially applicable may be entitled to obtain a patent for the said invention except for the following cases:

- (i) inventions that were publicly known in Japan or a foreign country, prior to the filing of the patent applications;
- (ii) inventions that were publicly worked in Japan or a foreign country, prior to the filing of the patent applications; or
- (iii) inventions that were described in a distributed publication, or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country, prior to the filing of the patent applications.

#### 2.1.3 KIPO

Inventions that have industrial applicability are patentable unless they fall under either of the following paragraphs:

- (i) inventions publicly known or worked in the Republic of Korea or a foreign country before the filing of the patent application;
- (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.

#### 2.1.4 SIPO

Any technology known to the public before the date of filing in China or abroad.

#### 2.1.5 USPTO

A person is entitled to a patent unless

- (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 a patent;
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States;
- (e) the invention was described in: (1) an published application for patent, by another person, filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another person filed in the United States before the invention by the applicant for patent, except that an international PCT application has the effects of an application filed in the United States only if said international application designated the United States and was published in the English language.

### 2.2 Interpretation of legal authority

#### 2.2.1 EPO

"State of the art" corresponds to "state of technology".

"Everything": any kind of information relevant to some fields of technology.

#### 2.2.2 JPO

"Inventions that were publicly known": an invention the content of which becomes known to unspecified persons without an obligation of secrecy.

"Inventions that were publicly worked": an invention which has been worked in a situation where the content of the invention is or could be publicly known.

"Inventions that were described in a distributed publication": inventions recognized from the descriptions in the publications or equivalents to such descriptions in the publication.

"Inventions that were made publicly available through an electric telecommunication line": inventions made available via a two-way transmission line, mainly Internet.

#### 2.2.3 KIPO

"Inventions publicly known": an invention which is known or to be known to the public if there has been no deliberate attempt to keep it secret in the Republic of Korea or a foreign country prior to the filing of the application.

"Inventions publicly worked": an invention which has been worked under the conditions where the contents of the invention are to be publicly known or can potentially be publicly known in the Republic of Korea or a foreign country.

"Inventions described in a publication": an invention identified by knowledge which is directly and clearly described or considered to be essentially described, though not explicitly, in a publication.

"Inventions published through electric telecommunication lines": an invention that is or could be publicly known to an unspecified person prior to the patent filing.

#### 2.2.4 SIPO

"Any technology": the prior art includes any technology which has been disclosed in a publication in China or abroad, or has been publicly used or made known to the public by any other means in China or abroad, before the date of filing, or the priority date where priority is claimed.

"Before the date of filing": the temporal demarcation of prior art is the filing date, or the priority date where applicable, of the concerned application. All the technical contents disclosed before the filing date are within the scope of prior art; those disclosed on the same filing date are not.

#### 2.2.5 USPTO

"Known or used by others in this country": an invention is known or used if the knowledge is accessible to the public ,i.e. there has been no deliberate attempt to keep the knowledge or use secret. The knowledge or use needs to be by others and must be in the United States. i.e. any entity which is different from the inventive entity. The entity needs only differ from the inventive entity by one person.

"Patented or described in a printed publication in this or a foreign country": a patent or printed publication must be at least minimally available to the public to constitute prior art; the patent or printed publication can be from the United States or a foreign country.

"Public in this country": when a purported use was accessible to the public or commercially exploited in the United States.

"On sale in this country": when there is a definite sale or offer to sell in the United States. No requirement that the on sale activity be public.

### 2.3 Practice governing prior art search

#### 2.3.1 EPO

Prior art is sought in the technical fields related to the invention and in those analogous fields in view of what appears to constitute the essential technical contribution of the invention taking into consideration whether it is probable that a reasonable objection of lack of inventive step could be established on the basis of what is likely to be found by the search in said analogous fields.

#### 2.3.2 JPO

Among all documents falling in the technical fields to which the claimed invention pertains, the examiner shall, because of reasons of economy, search a certain range of documents in which the he/she, based on his/her knowledge and experience, considers it highly probable to find relevant prior art documents.

The examiner shall first search the technical fields in which it is most probable to find relevant prior art documents. In general, it is appropriate for an examiner to start the prior art search from the most closely relevant technical fields to the embodiments disclosed in the detailed description of the invention and gradually extends to less relevant fields.

#### 2.3.3 KIPO

The search is carried out in collections of documents or databases containing materials in all those technical fields pertinent to the invention. The search strategy should determine the sections of the documentation to be consulted covering all directly relevant technical fields, and may then have to be extended to sections of the documentation covering analogous fields. The need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the sections of the documentation initially consulted.

#### 2.3.4 SIPO

The examiner shall usually carry out the search in the technical field to which the subject matter of the application pertains. When necessary, the scope of the search shall be extended to the analogous technical fields.

#### 2.3.5 USPTO

When determining the fields of search, three reference sources must be considered: domestic patent documents (including patents and patent applications), foreign patent documents, and non-patent literature.

### 2.4 Common general knowledge of the skilled person

#### 2.4.1 EPO

It is normally represented by encyclopaedias, textbooks, dictionaries and handbooks on the subject in question.

When a field of research is so new that technical knowledge is not yet available from textbooks:

- (i) the skills of the skilled person include not only having basic general knowledge of the particular prior art, but also knowing where to find such information;
- (ii) it could not be expected that the skilled person would carry out a comprehensive search of the literature covering virtually the whole state of the art;
- (iii) the information found had to be unambiguous and usable in a direct and straightforward manner without doubts or further investigation.

#### 2.4.2 JPO

"Common general knowledge" means obvious knowledge derived from the general knowledge or experience of a person skilled in the art, including well-known arts or commonly used arts.

"Well-known arts" means the arts generally known in the technical field, such as those published in a significant number of documents and known in the field widely enough that it is not necessary to submit any example of the arts.

"Commonly used arts" means the arts well-known and commonly used.

#### 2.4.3 KIPO

The common general knowledge means technologies generally known to a person skilled in the art (e.g., well known art or commonly used art).

"Well-known art" means technologies generally known in the relevant technical field, e.g., those appeared in many prior art documents, those widely known in the industry, those well-known enough that it is not necessary to submit any example.

"Commonly used art" means well-known art which is used widely.

#### 2.4.4 SIPO

It is normally a customary means in the art, or a technical means disclosed in a textbook or reference book.

#### 2.4.5 USPTO

A person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention.

### 3 What does "made available" mean?

#### 3.1 Interpretation

##### 3.1.1 EPO

At the relevant date it was possible for members of the public to gain knowledge and there was no bar of confidentiality restricting the use or dissemination thereof. Theoretical/potential availability is sufficient, not the actual consultation of the knowledge by members of the public.

Disclosures which took place on the same day of the relevant date are not prior art.

If only a month or a year is indicated in a publication, then there are two possibilities: either to find out the exact publication date by e.g. making an enquiry to the publisher, or to take the earliest possible date, i.e. the first day of the month or the first day of the year.

A publication does not have to fulfil any specific criteria of form or layout in order to qualify as a citable disclosure.

A single sale makes a product available to the public if the buyer is not bound to secrecy.

In general a mere offer to sell a product is not considered to render the invention available to the public. However, if the essential features of the invention were mentioned e.g. in the data sheets of the offer, then it is considered as made available to the public.

Listing a book in a library's catalogue is sufficient for the book to be considered made available, even if nobody has ever accessed the book itself.

Knowledge can be made available to the public in any geographical location (i.e. there is no territorial limitation to the disclosure), in any language, at any time i.e. there is no age limit.

##### 3.1.2 JPO

The expression "inventions that were publicly known" represents an invention the content of which becomes known to unspecified persons as an art without an obligation of secrecy.

When persons who have confidentiality disclose an invention to other persons who are not aware of its secrecy, that invention is included in "inventions that were publicly known" irrespective of the inventor's or applicant's intent to keep it secret.

For example, an invention published in an article, such as in an academic journal, is not included in inventions that were publicly known even after it has been submitted to the journal, until the article is publicly disclosed, since such article is hardly disclosed to unspecified persons when submitted.

The expression "inventions that were publicly worked" represents an invention which has been worked in a situation where the content of the invention is or could be publicly known.

The term "publications" includes documents, drawings or other similar media for the communication of information, which are duplicated to disclose the content to the public through the distribution of the publications.

The term "distribution" means a situation where unspecified persons could read such publications regardless of whether or not someone actually does read the publications.

"Available to the public" means situations where information can be seen by an unspecified person, and it does not necessarily require that the information has actually been accessed.

##### 3.1.3 KIPO

A distributed publication is "a document, a drawing or other similar medium for the communication of information, duplicated by printing, mechanical or chemical methods, etc. for the purpose of disclosing the contents to the public through distribution".

"Distribution" means placing a publication where the public have the possibility to read or see it; no actual access to the publication is necessary. Patent gazettes such as microfilm or CD-ROM are considered as distributed publications as is e.g. non-patent literature stored on floppy discs, slides.



"Matters essentially described, though not explicitly, in a publication" includes common general knowledge and standards. Regarding the time of publication, if only a month or a year is indicated in a publication, then the date is taken to be the earliest possible date, i.e. the first day of the month or the first day of the year. When the time of publication is not indicated, the distribution date of a foreign publication is the period normally required to reach the Republic of Korea from the country of the publication, when the date of reception in the Republic of Korea is clear. In the case of a publication such as a book review/catalogue, the date of distribution of the publication is the publication date. For a second edition/print of a publication, the date of distribution is the publication date of the first edition, provided that the cited contents in the second edition correspond to those in the first edition. An invention is known to the public if there has been no deliberate attempt to keep it secret in the Republic of Korea or a foreign country prior to the filing of the application, regardless of language. An invention has been publicly worked where its contents are publicly known in the Republic of Korea or a foreign country, i.e. when the invention is no longer kept secret. The sale of the product of the invention is regarded as "public working".

#### 3.1.4 SIPO

Technology known to the public means that the relevant technical content is in such a state that the public can know it if they wish; it is of no relevance whether the public had actually known it. The prior art includes the technical contents available to the public before the date of filing. In other words, the prior art shall be in such a state that it is available to the public before the date of filing and shall contain such contents from which the public can obtain substantial technical knowledge. Where disclosure by use of a product is concerned, it can be established even if the product or device used needs to be destroyed to get its structure and function known. If a person having an obligation to keep secrecy breaches the regulation, agreement, or implicit understanding, making the technical contents disclosed and the technologies available to the public, these technologies form part of the prior art. If the relevant technical content that can be obtained from an offer to sell is placed in such a state that the public can know it if they wish, it then constitutes prior art.

#### 3.1.5 USPTO

As a general rule for public availability, it is not necessary to prove that someone actually looked at a publication when that publication is accessible to the public through a library of patent office, nor is availability free of charge a prerequisite. An invention is known or used if the knowledge is accessible to the public if there has been no deliberate attempt to keep the knowledge or use secret. A patent or printed publication is sufficiently available to the public if it is laid open for public inspection or dissemination in printed form or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it. An electronic publication, including an on-line database or Internet publication, is considered to be a printed publication as of the date the item was publicly posted. A paper which is orally presented in a forum open to all interested persons constitutes a printed publication if written copies thereof are disseminated without restriction. Even if access to the document is restricted, it constitutes a printed publication as long as a presumption is raised that the portion of the public concerned with the art would know of the invention.

### 3.2 Cases when a disclosure is considered not made available

#### 3.2.1 EPO

Use on non-public properties (e.g. factories, barracks), because company employees and soldiers are usually bound to secrecy. When objects or processes used are exhibited, explained or shown to the public in such places, or when specialists (a skilled person who is specialised in the objects or processes which are exhibited) not bound to secrecy are able to recognise their essential features from the outside, this knowledge is then considered made available. Manufacturing at a third company as sub-contractor. A product made available for test purposes, e.g. in small quantities. Diploma thesis at the arrival date in the archive of a department library of a university. Further handling (e.g. listing in the library catalogue) is required to make it available to the public.

#### 3.2.2 JPO

Knowledge shared under confidentiality. Working of an invention in the situation where persons skilled in the art may not understand the content of the invention is not included in inventions that were publicly worked. An invention published in an article, such as in an academic journal, is not included in inventions that were publicly known even after it has been submitted to the journal, until the article is publicly disclosed, since such article is hardly disclosed to unspecified persons when submitted.

### 3.2.3 KIPO

Publicly worked or publicly known under confidentiality.

When part of an invention is kept secret, it is not considered to be publicly worked.

Even if an invention is published through an electric telecommunication line prescribed by Presidential Decree, the invention is not considered as being available to the public when the invention is only accessible by a specific person who is bound to secrecy, not by the general public.

### 3.2.4 SIPO

Technical contents in the state of secrecy are not part of the prior art. The state of secrecy includes not only the situation where the obligation to keep secret arises from regulations or agreements regarding confidences, but also the situation where the obligation arises from social customs or commercial practices i.e. from implicit agreements or understandings.

As for the publications characterized by the expressions "Internal materials" or "Restricted publication" or other similar wording, if they were really distributed in a restricted scope and required to be kept confidential, they are not regarded as valid publications.

If at an exhibition or demonstration of a product no explanation of the technical contents thereof is provided so that the structure and function or composition of the product is not known to a person skilled in the art, the exhibition or demonstration does not constitute a disclosure by use.

Experimentations to test or perfect the invention that are not available to the public do not constitute prior art.

### 3.2.5 USPTO

Secret patents are not prior art until they are available to the public.

Electronic publications, including on-line databases or Internet publications are not considered as belonging to the prior art if they do not include a publication date (or retrieval date).

A publication disseminated by mail is not prior art unless and until it is received by at least one member of the public.

## 4 What is the "public"?

### 4.1 Interpretation

#### 4.1.1 EPO

The public is generally not defined in a positive sense; rather it is defined indirectly by reference to who is not the public. Boundaries between public and non-public disclosures are often decided on a case-by-case basis.

#### 4.1.2 JPO

The public means an unspecified person in the society not bound by secrecy.

#### 4.1.3 SIPO

The public does not include persons having the obligation to keep secret. The sort and number of persons who can obtain technical information are different when using different technical information dissemination means.

There is no threshold concerning the number of persons and their background..

### 4.2 The public

#### 4.2.1 EPO

Persons having access to the disclosure are the public if there is no clear confidentiality agreement.

Matter may be considered to be available to the public even if the actual disclosure was confined to a limited circle of persons.

Documents are available to the public even if they are not free of charge.

#### 4.2.2 JPO

Persons having access to the disclosure are the public if there is no confidentiality obligation. When persons who have confidentiality disclose an invention to other persons who are not aware of its secrecy, that invention is included in "inventions that were publicly known" irrespective of the inventor's or applicant's intent to keep it secret.

#### 4.2.3 KIPO

Persons having no secrecy obligations.

#### 4.2.4 USPTO

A patent or printed publication is sufficiently available to the public if it is laid open for public inspection or dissemination in printed form or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.

### 4.3 Not the public

#### 4.3.1 EPO

Persons having privileged knowledge by employment or membership of an association, and/or are bound by explicit or implicit (tacit) confidentiality agreements.

Persons bound by an express or tacit agreement on secrecy, which has not been broken ; secrecy can be derived from a relationship of good faith and trust; a business meeting is secret if understood so by parties.

If there is a special relationship to the donor of the information, then the recipient of the information may be considered as not being a member of the public; a special relationship applies to a contracted supplier/client or a business partner.

Information subject to a confidentiality agreement does not automatically become available to the public when the obligation to keep it confidential expires: some separate act of making it available to the public is needed.

#### 4.3.2 JPO

Persons bound by an express or tacit obligation on secrecy, which has not been broken.

An invention published in an article, such as in an academic journal, is not included in inventions that were publicly known even after it has been submitted to the journal, until the article is publicly disclosed, since such article is hardly disclosed to unspecified persons when submitted.

#### 4.3.3 SIPO

Persons having the obligation to keep secret.

#### 4.3.4 USPTO

Persons bound by any kind of confidentiality agreement.

## 5 Form of availability

### 5.1 Written descriptions

#### 5.1.1 EPO

Any written publication, i.e. document, is considered to be state of the art provided its date and content is ascertainable with confidence.

#### 5.1.2 JPO

The term "publications" includes documents, drawings or other similar media for the communication of information, which are duplicated to disclose the content to the public through the distribution of the publications.

The term "distribution" means a situation where unspecified persons could read a publication regardless of whether or not someone actually does read it.

#### 5.1.3 KIPO

A distributed publication is a document, a drawing or other similar medium for the communication of information, duplicated by printing, mechanical or chemical methods, etc. for the purpose of disclosing the contents to the public through distribution.

"Distribution" means placing a publication as defined above in the condition where unspecified persons can read or see it. It does not necessitate the fact of a certain person's actual access to such a publication.

#### 5.1.4 SIPO

Publications mean the independently existing disseminating carriers of technical or designing contents, which indicate or have other evidence to prove the date of public issue or publication.

The determination of whether a document is a publication is not affected by the place or language of issue, the manner of acquisition or its age. The amount of distribution, whether it has been read, or whether the applicant is aware of it, is of no relevance.

The printing date of a publication is regarded as the date of disclosure, unless the date of disclosure can be evidenced otherwise. Where only a specific month or year is indicated as the printing date, the last day of the month or year is regarded as the date of disclosure.

If the examiner doubts the date of disclosure of a publication, he may invite the person who submitted the publication to furnish evidence.

#### 5.1.5 USPTO

Any patent or printed publication that is at least minimally available to the public constitutes prior art.

### 5.2 Standards

#### 5.2.1 EPO

A standard is prior art in the following cases: final published versions without confidentiality or secrecy; preparatory meetings/discussions where members are not bound by secrecy; publication on a website open to the public with a reliable posting date and/or date stamp; publication on a website not open to the general public, e.g. password protected, and available to all members of the standardization body.

Preparatory documents for standardization meetings may be prior art even if there is a limited number of recipients. Although there is no clear jurisprudence, the current policy is generally to consider MPEG preparatory documents as public.

A standard is not prior art when there is no clear publication and there is sufficient evidence of a confidentiality agreement.

In the absence of clear evidence to the contrary, standardization discussions are assumed to be public since standards rely on broad consensus.

#### 5.2.2 **KIPO**

Technical and national standards in the field of the art to which the subject matter pertains are evidential materials with regard to a well-known art and a commonly-used art.

### 5.3 **Oral descriptions**

#### 5.3.1 **EPO**

A lecture, with or without a written transcript published later, belongs to the state of the art. It is desirable to have written notes from at least two members of the audience attending a lecture; testimony from only the lecturer is not sufficient to prove disclosure. Handouts provide a more reliable form of evidence. If there are no transcripts or handouts then sworn statements from the lecturer and members of the audience are taken into account if available.

Radio or television broadcasts, audio or video recordings are state of the art.

#### 5.3.2 **JPO**

Inventions that were publicly known are inventions that are actually known by unspecified persons through certain persons. Most of them are generally publicly known through lectures or presentations. The inventions are identified based on the factual details explained in lectures or presentations. The details explained in lectures or presentations are interpreted based on the common general knowledge.

#### 5.3.3 **KIPO**

Oral disclosures are prior art. An affidavit or a written summary is needed to verify the oral disclosure.

#### 5.3.4 **SIPO**

The contents of talking, reporting, or speaking at symposium is prior art and the date of action is regarded as the date of disclosure. The contents of broadcasting, televising, cinematographing that can be received by the public is prior art and the date of broadcast or showing is regarded as the date of disclosure.

#### 5.3.5 **USPTO**

A paper which is orally presented in a forum open to interested persons constitutes a printed publication if written copies are disseminated without restriction.

### 5.4 **Use**

#### 5.4.1 **EPO**

Evidence of use usually requires written evidence (affidavits, sworn statements) or testimony e.g. taking of evidence from witnesses in oral hearings.

#### 5.4.2 **JPO**

"Working" of an invention includes the use of the invention.

#### 5.4.3 **KIPO**

The sale or use of the product is regarded as "public worked", meaning that the invention has been worked under the conditions where the contents of the invention are to be publicly known or can potentially be publicly known.

#### 5.4.4 **SIPO**

Using a technical solution disclosed or placed in the state of being available to the public is prior art. If a product is displayed or demonstrated and its technical contents are not explained, but a person skilled in the art could easily understand them, this constitutes disclosure by use. The date on which the product or process is available to the public is regarded as the date of disclosure by use.

#### 5.4.5 **USPTO**

Knowledge or use must be in the United States, otherwise it is not considered even if the knowledge or use is widespread in a foreign country.

Secret use of a process by another, even if the product is commercially sold, is not prior art if an examination of the product would not reveal the process. If the invention is put on display or sold by the inventor or someone connected to the inventor, it is considered accessible to the public even if the invention is completely hidden from view as a part of a larger machine or article.

If the use or sale is experimental, there is no bar if it represents a bona fide effort to perfect the invention or to ascertain whether it answers its intended purpose; if any commercial exploitation does occur, it must be merely incidental to the primary purpose of the experimentation to perfect the invention.

For "on sale" disclosures public availability is conceded even if there is a single sale or offer to sale, whether conditional or of non-profit character, if the offer or sale was made in the United States. Where parties to an alleged sale are related, availability to the public depends on whether the seller so controls the purchaser that the invention remains out of the public's hands.

## 5.5 Internet disclosures

### 5.5.1 EPO

All types of Internet disclosures are part of the state of the art. The main issue is the determination of a reliable publication date. In problematical cases examiners are advised to investigate reputable Internet archives. Unless there are specific indications to the contrary or unless the applicant provides some, the date and content are accepted as being correct.

### 5.5.2 JPO

Disclosures by all means that provide technical information through electric telecommunication lines, including the Internet, commercial databases, and mailing lists, are part of the state of the art.

In order to cite technical information made available to the public through electric telecommunication lines as prior art as in the case of the printed publications, it is required that said cited electronic technical information was published as before the filing of the application concerned. The question of whether or not the information was made available before the filing of the application is judged based on the time of publication indicated in the cited electronic technical information.

Examiners should not cite information on web sites when there is not indication of the time/date of publication; they can cite such information if a certificate on the time/date of its publication as well as content thereof is provided by a person with authority or responsibility for the publication, maintenance etc. of the published information.

### 5.5.3 KIPO

Prior art included the content of public bulletin boards, e-mails, web pages, and any content distributed through future telecommunication methods. The date of posting must be clear.

### 5.5.4 SIPO

The materials on the Internet or in online databases are available as prior art and are treated as publications.

### 5.5.5 USPTO

An electronic publication, including an on-line database or Internet publication, is considered to be a printed publication as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art.

## 5.6 Enabling disclosures

### 5.6.1 EPO

Subject-matter is only regarded as comprised in the state of the art if the information given to the skilled person is sufficient to enable, at the relevant date, to practise the technical teaching which is the subject of the disclosure, taking into account also the general knowledge at that time in the technical fields of competence.

### 5.6.2 JPO

"Inventions described in publications" means inventions that a person skilled in the art is able to understand based on the descriptions in publications or equivalents to such descriptions.

When an invention of a product or process is not clearly described enough for the person skilled in the art to be able to manufacture the product or use the process based on the descriptions of the publications and the common general knowledge as of the filing, the invention is not included in "cited inventions."

### 5.6.3 KIPO

An "invention described in a publication" means an invention identified by the matters which are directly and clearly described or considered to be essentially described, though not explicitly, in a publication, i.e. those directly derivable from the matters described when the common general knowledge in the field of technology is taken into consideration.

### 5.6.4 SIPO

The disclosure contains such contents from which the public can obtain substantial technical knowledge. It includes those technical contents expressly described and also those implied technical contents that a person skilled in the art can derive directly and unambiguously from the disclosure.

### 5.6.5 USPTO

A disclosure is enabling if the public was in possession of the claimed invention before the date of invention; such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his/her own knowledge to make the claimed invention.

## 6 Relevant date of the application for applying prior art

### 6.1.1 EPO

The relevant date is the valid priority date, i.e. the filing date for a first filing. The validity of a priority claim can be put under discussion during the examination phase by the examining division; this might lead to a priority deemed to be not valid.

If the priority claim is abandoned or lost, then the filing date becomes the relevant date.

### 6.1.2 JPO

The expression "prior to the filing of the patent application" represents the exact time of filing, to the hour and minute, of the filing, which is different from the expression "prior to the date of filing of a patent application". The applicant can also rely on the priority date of previously filed applications.

### 6.1.3 KIPO

The expression "prior to the filing of the application" represents the exact time of filing, to the hour and minute, of the filing. If the invention is publicly known in a foreign country, the time is converted into Korean time.

### 6.1.4 SIPO

All the technical contents disclosed before the filing date are within the scope of prior art; those disclosed on the filing date are not.

### 6.1.5 USPTO

There are three relevant dates: (1) The actual filing date; (2) the U.S. effective filing date which is the filing date of the earliest prior-filed U.S. application or international (PCT) application designating the U.S. that is identified in a valid domestic benefit claim; (3) Foreign priority date where the application may be entitled to the benefit of the filing date of an earlier foreign application if certain conditions are met.

## 7 Conflicting applications and prior art based on effective filing dates

### 7.1 National/regional and PCT applications

#### 7.1.1 EPO

The prior art only for novelty assessment also includes the whole disclosure of European and PCT patent applications –not national applications – filed before the valid priority date of the application and published on or after the priority date of the application. For a first European filing the priority date is the filing date.

The conflicting application must still be pending at its publication date.

PCT applications are only included in the prior art for novelty assessment if the appropriate filing fees have been paid and the translation into English, French or German has been supplied to the European Patent Office.

#### 7.1.2 JPO

Conflicting applications can be Japanese applications and PCT applications when they designate Japan and they are in Japanese or a translation into Japanese is filed.

#### 7.1.3 KIPO

When a patent application is filed for an invention that is identical to an invention or device described in the description or drawings of another application for a patent or utility model registration that has been filed before the filing date of the patent application and laid open or published after the filing of the patent application, a patent shall not be granted. This does not apply where the inventor of the concerned patent application and the inventor of the other application for a patent or utility model registration are the same person; a similar restriction applies to applicants at the time of file the concerned application.

#### 7.1.4 SIPO

When novelty of an invention is examined, the applications relating to the identical invention which have been filed by any entity or individual prior to the filing date of the application being examined with the Patent Office and published or announced on or after said filing date, take away the novelty of the application being examined. Conflicting applications are limited to applications filed in China and PCT applications that enter the national phase of China. The applications can be both for inventions and utility models.

#### 7.1.5 USPTO

A U.S. patent or published U.S. patent application can be considered prior art as of its application/effective filing date and be relied upon as prior art even though the document was likely not available to the public on the effective filing date of the application being examined.

A PCT filing date on or after 29 November 2000 can be relied on as a U.S. filing date if the PCT application designated the U.S. and is published in English.

## 8 Grace Period

### 8.1 Definition

Specific period of time prior to the filing of an application in which a disclosure of the invention is not to be taken into account as prior art.

## 8.2 Interpretation

### 8.2.1 EPO

A grace period of six months before the actual filing date (not the priority date) of the application is granted under only two specific cases:

- (i) if the disclosure, of any kind, was due to an evident abuse in relation to the applicant or his legal predecessor; evident abuse is proven when there is actual intent to harm or actual knowledge that harm would or could be expected e.g. breach of confidentiality;
- (ii) if the disclosure was done by the applicant or his legal predecessor in an international exhibition recognized by the European Patent Office; at the time of filing, a statement about the display and a certificate by the authority of the exhibition should be provided to the European Patent Office.

Other applicant's own disclosures are prior art.

### 8.2.2 JPO

A disclosure is not to be taken into consideration in determining novelty and inventive step if it has been accomplished within six months before the filing date when:

- (i) the disclosure has been accomplished against the will of the person having the right to obtain a patent;
- (ii) the disclosure has been accomplished as a result of an act of the person having the right to obtain a patent (excluding the case which has been accomplished through the publication in the bulletin pertaining to inventions, utility models, designs or trademarks).

The applicant must submit a document stating that the applicant is seeking to take advantage of the above provision, at the time of filing of the patent application, and a document for certification that the disclosure meets the above case (ii) within thirty days of the filing date.

### 8.2.3 KIPO

A disclosure is not to be taken into consideration in determining novelty and inventive step when is made by a person within twelve months before the first filing date when:

- (i) the disclosure has been accomplished against the intention of the person having the right to obtain a patent;
- (ii) the disclosure has been accomplished as a result of an act of the person having the right to obtain a patent (this provision does not apply where a patent application or a patent registration is published in the Republic of Korea or a foreign country in accordance with a treaty or law).

### 8.2.4 SIPO

A grace period of six months before the filing date (or the priority date, if applicable) of the application is granted if one of the following events occurred:

- (i) where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;
- (ii) where it was first made public at a prescribed academic or technological meeting;
- (iii) where it was disclosed by any person without the consent of the applicant.

### 8.2.5 USPTO

A one-year time bar is measured from the U.S. effective filing date. An applicant is barred from obtaining a patent if the public came into possession of the invention on a date before the one-year grace period ending with the U.S. effective filing date. Public possession can occur by public use, public sale, publication, patent or any combination of these. How the public came into possession of the invention is irrelevant.

Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her. Where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, the applicant. A rejection can be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work.