
Newsletter 1/2010

Internet as a Source of Prior Art in European and German Patent Procedures

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1. Introduction

The prior art cited against a patent (application) has hitherto usually consisted of earlier patent documents and non-patent printed publications. However, since the internet continues to penetrate our every day life, also internet documents are increasingly cited as prior art in patent procedures.

While, in principle, it is agreed that internet documents may form part of the state of the art, considerations regarding reliability and security of the internet have repeatedly prevented the relevant Examining/Opposition Divisions or Patent Courts of admitting internet citations as evidence.

In order to ensure consistency in its procedures, the European Patent Office (EPO) has now issued applicable Guidelines concerning the use of internet citations. These Guidelines are essentially based on the findings of the Board of Appeal Decision T 1134/06. Consequences for applicants or, more generally, for participants of patent procedures at the EPO are highlighted in the following sections.

In this Newsletter we also discuss the

German national practice regarding the use of internet citations.

2. Internet disclosures

As a matter of principle, disclosures on the internet can form part of the state of the art for novelty and inventive step. Certain information, especially in fields related to information technology or software technology, may even only be available on the internet. This includes, for example, online manuals, tutorials for software products or other products with a short life cycle.

Neither restricting access e. g. by password protection, nor requiring payment for access (analogous to purchasing a book or subscribing to a journal) prevent a web page from forming a part of the state of the art. It is sufficient if the web page is in principle available without any bar of confidentiality.

3. Establishing the publication date

In its decision T 1134/06 the EPO Board of Appeal holds that the criteria to be applied for establishing a disclosure made available to the public through the internet should be the same as those introduced

by the jurisprudence of the Boards of Appeal for establishing a prior use or a prior oral disclosure. Thus, in assessing whether an internet citation constitutes relevant prior art, the questions “when”, “what” and “under which circumstances” the alleged prior art document has been published, must be answered. While the requirement of public availability is usually fulfilled, it must be assessed separately whether a given date is indicated correctly and whether the content in question was indeed made available to the public as of that date.

However, there are recognized reliability and security issues concerning the internet and the World Wide Web and information retrieved from them. Internet and the World Wide Web are in continuous fluctuations with data easily added, modified and removed. Websites are frequently updated and are notoriously insecure against unauthorized access. It is thus at the present state of affairs often very difficult to establish with a high degree of reliability what exactly appeared on a website and when. Often the only certainty is the real time certainty of the availability and content of a website in the particular moment it is viewed or downloaded.

4. Standard of proof

When an internet document is cited against an application or patent, its probative value is evaluated in view of the particular circumstances of each case. For assessing these circumstances, the balance of probabilities will be used as the standard of proof. According to the standard, it is not sufficient that the alleged fact (e. g. the publication date) is merely probable, but the Examining/Opposition Division must be convinced that it is correct. However, proof beyond reasonable doubt (“up to the hilt”) usually is not required.

5. The burden of proof

The burden of proof lies initially with the person citing the internet disclosure, e. g. the Examiner or the Opponent. He/She must show that, on the balance of probabilities, the citation has been publicly

available on the alleged publication date. If the internet disclosure contains an explicit publication date, such dates are usually accepted at face value and the burden of proof shifts to the applicant/proprietor.

If an applicant provides reasons for questioning the alleged publication date, Examiners will have to take these reasons into account and will have to decide, on the balance of probabilities, whether the disputed publication date is to be maintained.

6. Categories of internet sources

While the dates and the content of internet disclosures can, in principle, be taken at face value, there are of course different degrees of reliability. The more reliable a disclosure, the harder it will be for the applicant/proprietor to prove that the indicated publication date is incorrect. In its notice concerning internet citations the EPO discusses the reliability of various popular types of internet disclosures.

a) technical journals and “print equivalent” publications

The most reliable type of internet disclosures are online technical journals from scientific publishers and other “print equivalent” publications, like the websites of newspapers, periodicals, television and radio stations, academic institutions or international organizations.

Companies, organizations or individuals use the internet to publish documents that had previously been or that will later on be published on paper. Evidently, most of these documents address the public and are thus meant for publication. Hence, the date given can be taken as the date of publication.

E-print databases like “arXiv” from Cornell University (www.arxiv.org) and defensive publication services like “Research Disclosure” (www.researchdisclosure.com) should be considered to fall within this category.

b) non-traditional publications

The internet also offers new ways to exchange and publish information, for exam-

ple, usenet discussion groups, blogs, e-mail archives of mailing list or wiki pages. These so-called non-traditional publications also constitute prior art. However, in some cases it may be rather difficult to establish their exact publication date and their reliability may vary. Computer-generated timestamps or the frequently used “last modified” date contained in such publications can be considered as reliable publication dates.

c) other internet sources

Internet disclosures not giving any explicit indication of the publication date are considered to be least reliable and can usually not be cited as prior art against an application or patent. However, in these cases further evidence to establish or confirm the publication date may be obtained by an internet archiving service, e. g. so-called “wayback machine” (www.archive.org). Although such services may be incomplete, the EPO now generally acknowledges the credibility and reliability of the archived data.

In order to make sure that a web document is accepted as prior art, for example in potential opposition cases, we would advise that the respective web page is printed out, date-stamped and signed by hand immediately. In case a publication date comprised in that web document is not accepted, you can at least make sure that the content of your printout will be taken into account as prior art for any future patent applications, i.e. for any patent applications filed after the date indicated by the date-stamp of your print out.

7. German case law

German case law regarding the internet as a source of prior art is rather sparse. In general, German authorities consider internet disclosures to be less reliable compared to the EPO. The Federal Patent Court ruled in decision 17W (pat) 1/02 of October 17, 2002 that the internet is not a suitable source for determining the state of

the art. In this context, it is explicitly mentioned that web archives such as the Internet Archive are not sufficiently reliable to be treated as prior art. Information retrieved from the internet at the present time does not allow to conclude that this information has been published at an alleged publication date and that its content has remained unchanged.

In trademark procedures, however, the Federal Patent Court is less strict regarding internet citations. Web pages are usually accepted as proof of, for example, the public use of certain signs, symbols or expressions. In its “escapulario”-Decision, in which the publication date of such internet citations was crucial, the court even considered the internet service “www.archive.org” to be a sufficiently reliable source of prior art.

Summary

Internet citations will be considered as prior art by the EPO, if – on the balance of probabilities – an exact publication date can be established.

Online technical journals from scientific publishers and other “print equivalent” publications containing an explicit publication date are taken at face value. Non-traditional publications carrying computer-generated timestamps or using a “last modified” date are also considered reliable.

Other disclosures having no or an unreliable publication date will usually not be considered as prior art, unless further evidence concerning their publication date (e. g. by www.archive.org) is provided.

Under German patent law similar considerations apply, however, the bar for internet disclosures being regarded as prior art is considerably higher. This does not apply for trademark procedures, in which internet citations are regularly accepted.