

## Section 8: The meaning of prior art base

- (1) For the purpose of deciding whether or not an invention is novel and for the purpose of deciding whether or not an invention involves an inventive step, the **prior art base**, in relation to an invention so far as claimed in a claim, means all matter (whether a product, a process, information about a product or process, or anything else) that has at any time before the priority date of that claim been made available to the public (whether in New Zealand or elsewhere) by written or oral description, by use, or in any other way.
- (2) For the purpose of deciding whether or not an invention is novel, the **prior art base**, in relation to an invention so far as claimed in a claim, also includes the information contained in a complete specification filed in respect of another patent application if all of the following circumstances apply:
  - (a) if the information is, or were to be, the subject of a claim of that complete specification, the claim has, or would have, a priority date earlier than that of the claim under consideration; and
  - (b) that complete specification became open to public inspection after the priority date of the claim under consideration; and
  - (c) the information was contained in that complete specification on its filing date and when it became open to public inspection.

Compare: Patents Act 1977 s 2(2) (UK)

### Prior art base – general

1. For an invention to be patentable it must be novel over what is already known from the prior art base. Assessment of novelty of a claimed invention is based on whether all of the features of that claim are known from a single prior art document, see for example *Ammonia's Application*, 49 RPC 409. A mosaic of more than one document to find lack of novelty is not permissible, see for example *British Ore Concentration Syndicate v Mineral Separation Ltd*, 26 RPC 124 at page 147, and *Lowndes' Patent* 45 RPC 48 at page 57. Where it appears that a combination of more than one document would anticipate a claimed invention, then it is possible that these documents could be combined to find a lack of inventiveness i.e. the invention is obvious.
2. The prior art base includes all matter including products, use, information about a product or process or 'anything else' made available by written or oral description, by use, or in any other way at any time, anywhere and in any language. Novelty is assessed strictly as at the date of publication of the document which is purported to be novelty destroying, or the date of the alleged prior use *Yeda Research & Development Company v Rhone-Poulenc Rorer* [2007] UKHL 43. The date of publication or date of alleged prior use must be earlier than the priority date of the claimed invention to be citable as a prior publication or use.
3. The majority of the prior art will be written disclosures in books, journals and patent specifications. There is no time limit on the age of the matter which may be considered as prior art. This is a change from the Patents Act 1953, section 59(1)(a) & (b) which placed a 50

year time limit on patent specifications which may be used to anticipate a later claimed invention.

4. The prior art base also includes non-written disclosures such as use and oral disclosure. Examples of non-written disclosures include sound recordings, videos, and public use (such as demonstrations, displays and trial samples of a product).
5. The definition of "made available to the public" was determined in *Bristol Myers* [1969] RPC 146 to be whether the document was communicated to a member of the public who was then free to do what they wished with it. Communication to a single member of the public without inhibition was considered to be sufficient to amount to making the material available to the public.
6. On the other hand, if the disclosure was made to a person who knew that the design invention was confidential, then this may be considered secret use and would not form part of the prior art base and cannot be used as anticipation. Employees ~~would were~~ deemed to be under an obligation of confidentiality in *J Lucas (Batteries) Ltd v Gaedor Ltd* [1978] RPC 297.
7. The disclosure of the document should be construed as it would have been read by a person at the date of publication of the document *SmithKline Beecham Plc v Apotex Europe* [2005] FSR 23 ~~of that document~~.
8. For documents to be considered to form part of the prior art base, the document does not need to be accessible without cost. For example, a journal article available on the internet for a fee would constitute prior art as long as it was made available before the priority date of the claimed invention.

#### **Application with an earlier priority date Section 8(2) – ‘whole of contents’ lack of novelty**

9. ~~The complete specification of patent application which is published after the priority date of a claimed invention may form part of the prior art base if the criteria of section 8(2)(a) to 8(2)(c) are fulfilled. The other specification must have an earlier priority date that the claim that is being examined (section 8(2)(a)) and the information relevant to the claimed invention must have been contained in the earlier complete specification on its filing date and when it became open to the public (section 8(2)(c)).~~
10. ~~The complete specification must have been published after the priority date of the claimed invention to meet section 8(2)(b). If the complete specification was open to the public before the priority date of the claimed invention, then the document would be considered as part of the prior art base under section 8(1).~~
11. ~~The documents considered in section 8(2) are not limited to patent applications in New Zealand.~~
9. Section 8(2) reflects the so-called whole of contents approach to identification of the prior art base for the purpose of assessing novelty in light of the content of ‘another patent application’. The prior art base under section 8(2) includes the whole content of the specification of ‘another patent application’. There is no requirement that the other patent application actually contain a claim for the same subject matter of the application under examination.

10. Three criteria (section 8(2)(a)(b) & (c)) must be satisfied before raising a 'whole of contents' lack of novelty objection:
- a. The claim based upon the information contained in another patent application would have (if formulated), or has, an earlier priority date than the claim of the application under examination; and
  - b. The complete specification of the other patent application is laid open for public inspection after the priority date of the claim under examination; and
  - c. The information (see (a) above) must have been present within the specification of the other patent application on its filing date and when it became open to public inspection.
11. Documents being another patent application which form the prior art base under section 8(2) are:
- a. A patent application made under the Act (see section 5 'patent application') and published under section 76; and
  - b. A published international PCT application which designates New Zealand whether or not it enters the national phase in New Zealand.
12. The prior art base under section 8(1) and 8(2) may be ~~used for~~applied when examining for novelty.
13. The prior art base under section 8(1) may be ~~used~~applied when examining for inventive step. ~~Prior~~The prior art base under section 8(2) cannot be ~~used~~applied for inventive step purposes.

#### Prior Use

14. Prior use must be enabling if it is to be considered anticipatory. In *Quantel Ltd v Spaceward Microsystems Ltd* [1990] RPC 83, ~~it was decided that a demonstration~~prior use of a machine where no-one was allowed access to the machine and where no information about the machine was made available was considered to be a non-enabling disclosure. Anticipation by prior use requires consideration of two factors: what was actually used, and what was then made available to the public through that use.
15. ~~An invention may be anticipated by a single occurrence of an earlier use. For prior use to be considered an anticipatory disclosure, the nature of the use should be taken into consideration.~~ For example if the public was able to only look at ~~it~~a device on display, ~~then~~ it is possible that a person skilled in the art ~~may~~would not have all the necessary information to perform the invention (*Lux Traffic Controls Ltd v Pike Signals Ltd and Faronwise Ltd* [1993] RPC 107) ~~it would all depend on whether a person skilled in the art would be able to determine the operation and construction with relation to the amount of information they could obtain from their interaction with the invention.~~ On the other hand ~~if~~if a free sample of the product ~~was~~ given to a member of the public (and it need only be one person) without any obligation of confidentiality may be sufficient for the sample to constitute an enabling disclosure ~~and they could then do what they wanted with it, they would be able to gather enough information~~ to perform the invention (*Fomento Industrial S.A., Biro Swan Limited and another v Mantmore Manufacturing Company Limited* [1956] RPC 87). As long as the prior use is not "secret use", it will form part of the prior art base.

16. Prior commercial demonstration or sale of the invention can be considered prior use. A single instance of use of the invention is also sufficient to constitute prior use providing it meets the requirements of enabling disclosure.

~~16-17.~~ In *W.L.Gore & Assoc. Inc. v Kimal Scientific Products Ltd* [1988] RPC 137 it was held that public distribution of a product in the course of trade (sending trade samples manufactured by the claimed process) before the priority date was prior use (of the process) even though it would not have been possible to determine which process was used to make the product. This decision was made under the UK Patents Act 1949.

### **Prior Secret Use**

~~17-18.~~ In *Bristol Myers (Johnson's) Application* [1975] RPC 127, "secret" was held to mean deliberate concealment and if it was concealed from the public it would not generally be considered to be an anticipatory disclosure. A deliberate concealment would be one where the person involved knew the invention was being used and took steps to ensure that it was not known about, rather than a person unwittingly performing the invention. ~~Secret use includes not only trading and selling the invention but any use that was deliberately concealed and the user derived a practical benefit from it.~~