

## **TRIPS—Article 27—Patentable Subject Matter**

1. Subject to the provisions of paragraphs 2 and 3, **patents shall be available for any inventions**, whether products or processes, in all fields of technology, **provided that they are new, involve an inventive step** and are capable of industrial application. Subject to [the transitional provisions relating to developing countries and patent protection for pharmaceutical and agricultural products], patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.

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### **Statement of the U.S.A.**

In the TRIPS Agreement there is “no prescription as to how WTO Members define what inventions are to be considered ‘new’ within their domestic systems.”

## EPC—Article 54—Novelty

- (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** 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.
- (3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 93 on or after that date, shall be considered as comprised in the state of the art.

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## U.S. Code, 35 U.S.C. § 102

Conditions for patentability: novelty and loss of right to patent:

A person shall be 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 patent . . . .

### **Problem 3–14**

Gil filed a patent application in Germany on November 30, 2004. Gil filed a second patent application in Country X, also a Paris Union country with a first-to-file system, for the same invention on December 1, 2005.

Meanwhile, Lorena has independently invented the same invention and then filed a patent application for the invention in Country X on February 1, 2005. Lorena eventually obtained a patent.

Lorena believes it is now being infringed by Thurman. Thurman argues, however, that Lorena's patent is invalid because it was disclosed in the prior art contained in Gil's German patent application.

What result under the following circumstances?

- (1) Country X is Japan or an EU country.
- (2) Country X is the United States.

## U.S. Code, 35 U.S.C. § 103

§ 103. Conditions for patentability; non-obvious subject matter.

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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## **EPC—Article 56—Inventive Step**

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

## **EPC—Article 54—Novelty**

- (3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 93 on or after that date, shall be considered as comprised in the state of the art.