IP

**IP Themes for Businessmen**

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**State of the art, novelty and what patent office reports mean / May 23, 2018**

In patent application procedure, an “*Examiner*” compares a new patent application with the “*state of the art”.* He then issues an official report listing earlier published documents (called “*citations*”). It’s at this point patent applicants can get nervous and misunderstandings can follow. Let’s explode some myths:

***“The Examiner lists lots of documents - it looks pretty hopeless”***

Not necessarily. In itself, an extensive list of citations doesn’t mean that much. You’d be surprised at the subtle amendments and intricate arguments patent attorneys come up with.

***“The documents are mostly American. Surely they don’t count*** ***- we have a UK patent application”***

No, they all count if they are “prior” to the relevant patent application date. American *state of the art* is as good as any other.

***“All the documents are patent documents. Should we assume the Examiner thinks we infringe?***

No. The most comprehensive structured technical document collection is the global patent publications collection. It’s often treated as representative of the state of the art and, simply to be practical, it’s where an Examiner usually concentrates efforts to find relevant prior documents.

He’s interested in their *technical personality* (what they disclose) and not their *legal personality* (the legal rights they claim). For example, a 2015-published patent P which discloses a paint made by adding an additive to an initial mixture will get his attention in examining a 2018-filed patent application A whose scope encompasses P’s initial mixture. P’s *technical personality* makes it an obstacle to A.

***“And P’s legal personality is relevant to infringement - is that right?”***

Yes, P may claim legal rights in the final paint and that affects third party freedom to operate***.*** Unlicensed making of the final formulation would infringe rights given by patent P, as would selling and other types of infringing activity such as using the formulation for some purpose.

But this assumes patent P is in force where that activity takes place. Legal rights a patent claims are geographically restricted and have a limited life (think 20 years maximum in Europe).

“***So ….”***

.… a patent document’s *technical personality* might obstruct you getting your own patent and its *legal personality* might prevent you commercialising your innovation in at least some places - or it could be that only one of these is true and not the other - or neither may apply (it all depends on the facts).

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