

Rule 33, Rule 64
GL/ISPE 12.02

4. Enabling disclosure of a prior document

Subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the prior art pursuant to Rules 33 and 64, if the information given therein to the skilled person is sufficient to enable him, at the relevant date of the document, to practise the technical teaching which is the subject of the document, taking into account also the general knowledge at that time in the field to be expected of him.

Similarly, it should be noted that a chemical compound, the name or formula of which is mentioned in a prior-art document, is not thereby considered as known, unless the information in the document, together, where appropriate, with knowledge generally available on the relevant date of the document, enables it to be prepared and separated or, for instance in the case of a product of nature, only to be separated.

The EPO applies option A12.02[1] of the Appendix to Chapter 12 of the ISPE Guidelines.

GL/ISPE 12.08, 12.09

5. Generic disclosure and specific examples

In considering novelty, it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and one of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets.

GL/ISPE 12.04

6. Implicit disclosure and parameters

In the case of a prior document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching. Situations of this kind may also occur when the claims define the invention, or a feature thereof, by parameters. It may happen that in the relevant prior art a different parameter, or no parameter at all, is mentioned. If the known and the claimed products are identical in all other respects (which is to be expected if, for example, the starting products and the manufacturing processes are identical), then in the first place an objection of lack of novelty arises. The burden of proof for an alleged distinguishing feature lies with the applicant. No benefit of doubt can be accorded if the applicant does not provide evidence in support of the allegations. If, on the other hand, the applicant is able to show, e.g. by appropriate comparison tests, that differences do exist with respect to the parameters, it is questionable whether the application discloses all the features essential to manufacture products having the parameters specified in the claims (Art. 5).