MAIN PREREQUISITES OF PATENTING

Source: extract from Best Practices Handbook, BIC project

A. Novelty

Novelty means that an invention is different from earlier solutions disclosed in prior art. An invention cannot be patented if it has already been published by anyone, anywhere at the date of filing the patent application.

Publishing, and thereby forming an obstacle for novelty, refers to abstracts, posters, oral presentations (elsewhere than in internal closed meetings), articles, electronic and printed news, patent applications as well as brochures and marketing materials. It needs also be ensured that the data is not published accidentally (e.g., as presentation slides posted on a website after a closed meeting) or by an external party.

Best practices:

- Performing a preliminary novelty search is important (also see chapters 5.1.1 and 5.2.2). A thorough novelty and patentability survey can be ordered from an external service provider once there is sufficient confidence based on an internal search.
- As the simplest first step, ask the researchers for their earlier publications (including abstracts, presentations etc.) as well as other closely related research by other groups. Search the researchers by name in the internet to find e.g. interviews or other public disclosures.

Pitfalls:

- In academia, novelty is often destroyed by own publications that may come up only after a patent application is searched for novelty by the patent authorities. The publications (articles, abstracts, posters, public presentations) by the research team would need to be disclosed and reviewed more closely at the time of handling the invention disclosures.

B. Inventiveness

Inventiveness means a non-obvious or even surprising (1 + 1 > 2) solution to a technical problem. An invention must not be evident for a person skilled in the art or be possible to achieve with basic optimization or routine trials.

Pitfalls:

- Abstracts submitted to conferences are not considered very dangerous by the researchers if they have censored or coded the details. However, from the perspective of inventiveness, such a publication proves that a similar technical effect has been accomplished earlier. A patent application describing the invention in full may then be considered only to provide alternative markers for achieving the same technical effect than described earlier without details. This so-called non-enabling prior art is known for not destroying novelty but destroying inventiveness.