FICPI AUSTRALIA COMMENTS – TRUE NOVELTY

Australian Law

Under Australian law there is a clear distinction to be drawn between novelty and inventive step. This distinction is a fundamental tenet of Australian law after judicial consideration of the issue in a number of cases in the late 80's and early 90's[1]. More particularly, these cases conclude that the question of novelty is essentially one concerned with whether the invention claimed in the patent specification discloses something that the public did not know before. On the other hand, inventive step is essentially concerned with whether the invention as claimed in the patent specification is something that would not naturally suggest itself, or would not be obvious, to the skilled addressee in the light of what is already known.

Australia adopts a "whole of contents" approach to novelty, whereby earlier Australian patent applications that were unpublished at the priority date of a later application but that later become published form part of the prior art base only for novelty considerations of an invention claimed in the later application.

The principal test that is applied for ascertaining novelty, including "whole of contents" novelty, is the "reverse infringement" test, which asserts that the determination of novelty:

> "…is the same as that for infringement and generally one can probably ask oneself whether the alleged anticipation would, if the patent were valid, constitute an infringement." [2]

Although the reverse infringement test has been maintained by the courts as the seminal test for novelty in Australia, it is not considered by us to be an appropriate definition for true novelty internationally. Since there is no single international test for infringement, any True Novelty test using infringement as a basis is bound to have problems.

True Novelty

In arriving at a definition of True Novelty, we consider it important to maintain the notions of novelty and inventive step separate and distinct and to not merge considerations associated with one with the other.

Many of us consider a statement made in the old Australian case of *Griffin v Isaacs*[3], which addressed the question of whether a variation from a device previously published was novel, provided the most practical way of considering novelty in Australia. This statement asserts:

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[1] *R.D. Werner & Co. Inc v Bailey Aluminium Products Pty Ltd* (1989) AIPC ¶90-568; *Nicaro Holdings Pty Ltd & Ors v Martin Engineering Co. & Anor* (1990) AIPC ¶90-670
[2] *Meyers Taylor v Vicarr Industries Ltd* (1977) CLR 228
[3] *Griffin v Isaacs* (1942) 12 AOJP 739

> “Where variations from a device previously published consist in matters which make no substantial contribution to the working of the thing or involve no ingenuity or inventive step and the merit if any of the two things, considered as inventions, is the same, it is … impossible to treat the differences as giving novelty.”

If portions of this statement that refer to inventive step and ingenuity are excised, a simple novelty consideration of whether *the variation makes a substantial contribution to the working of the thing* is arrived at. This presents a concise test for novelty which deals with issues that arise when there is not a clear and unmistakable disclosure of the essential features of the claimed invention in the prior art. We believe that such a test could form the basis for a True Novelty Test.

One point apparently not raised by anyone so far is that novelty should generally be capable of determination by a person without the aid of an expert. On the other hand, inventive step is an issue that clearly needs experts to determine the inventive advance. Patent offices, in particular, need a test for novelty that is easily applied and that is less open to sweeping generalities. The public and the applicant also need a novelty test that is easy to apply and results in certainty. Any novelty test that includes inventive step considerations (even if somewhat short of a full inventive step analysis) is bound to give rise to uncertainties for patent offices, the public, and the applicant.

Thus, we consider that a True Novelty test should be one that enables a party to determine whether an invention is novel with minimal need for experts. Furthermore, we believe that novelty and inventive step are totally separate considerations.

The question of novelty should be "is the alleged invention NEW", and nothing more. Under our proposed test for True Novelty, if a later application and an earlier application or prior publication are for the same thing (albeit there may be trivial or irrelevant differences in the claims of the later application), there will be no novelty. On the other hand, if the claims in the later application include differences that make a substantial (as opposed to trivial) contribution to the working of the later invention, there will be novelty.

We consider that concerns of double patenting are more than adequately addressed by adopting sound principles for novelty, and that it is unnecessary to go to inventive step considerations.

If you require any further input, or clarification of any of the above, please let us know. Otherwise we wish the Working Group every success in establishing a common position as to the definition of True Novelty.

Stephen Krouzecky
FICPI Australia