HOLLY IP

European Patent Office (EPO) Board Of Appeal Decisions T2/09 and T1553/06 On Whether Emails Represent A Public Disclosure And Under What Circumstances Disclosure On A Web Page Is Public

Summary

This circular is about two parallel decisions which have issued from the EPO. In T2/09 the Board decided that sending an email does not represent public disclosure of the contents of the email. T1553/06 concerned the circumstances in which material on a website is publically disclosed. The Board provided a two-part test as part of its decision. According to the test, material on a website is publically disclosed if the website could be found by a search engine using keywords related to its contents and if the material was on the website long enough for it to be accessed.

Background

Emails are apparently not difficult to intercept, and so this raises the question of whether or not sending an unencrypted email represents a public disclosure of its content. Given the widespread use of email to send confidential information the assumption by most people was that it does not represent a public disclosure. The circumstances in which material on a website is a public disclosure is probably of less significance to most organisations. However there was clearly a need for guidance on how accessible (easy to find) a website needs to be before its contents can be deemed available to the public.

EPO View of Novelty

Existing case law of the EPO takes a very broad view of public disclosure. If the relevant information is accessible it is generally deemed to be publically disclosed, irrespective of whether or not anyone has actually accessed the information. Thus all the books in a library would be considered as being publically disclosed (T381/87). However the EPO has also decided that an uncatalogued document in a library, whose existence was not known, was not public (T314/99). G1/92 held that the composition of a product is disclosed if the product is publically available, irrespective of whether or not there is a motivation to ascertain its composition. Thus according to G1/92 there should be no element of subjectivity in determining what is disclosed, it only being dependent on whether the means for analysis is available. G1/92 also considered undue burden as part of the test for whether something was disclosed.

The EPO has previously provided guidance in the form of a Notice on internet citations[1]. However this was mainly concerned with how to establish the publication date of an internet disclosure and did not address the accessibility of websites.

[1] Notice From the European Patent Office Concerning Internet Citations. EPO Journal 8/9, 2009

T2/09 Email disclosure

The Board essentially approached the question of whether or not emails represent a public disclosure on the basis of whether or not the information in the email would be considered to be confidential. Confidentiality could either be determined by (i) whether the sender intended for the email to be confidential, or by (ii) whether an intercepted email could be lawfully disclosed to the public. The Board decided to reject looking at the sender's intention since this would introduce a subjective criterion which G1/92 sought to avoid. Thus the Board instead looked at whether the contents of an intercepted email could be lawfully disclosed. It took the view that in Europe and the US the contents of an intercepted email could not be lawfully disclosed and therefore emails must be considered confidential. It was acknowledged that in other territories that might not be the position, but to avoid the need to have any subjective criteria, the Board decided that emails in any territory would not be considered public.

T1553/06 Websites

In deciding on the circumstances in which a disclosure on a website was public, the Board took the view that 'direct and unambiguous access' to the website would be required, and this would only be possible if the site could be located using a search engine. Although in theory every website can be accessed, the Board took the view it was not deemed public if its URL address needed to be known for it to be found. The Board compared that situation to having to know a password to access a site. The Board provided a test to determine whether a given website is public. The test requires that the website can be found by a search engine using keywords that relate to the content of the website and that material would have to be on a website long enough to be accessed. The test is set out below:

"If, before the filing or priority date of the patent or patent application, a document stored on the World Wide Web and accessible via a specific URL

(1) could be found with the help of a public web search engine by using one or more keywords all related to the essence of the content of that document and

(2) remained accessible at that URL for a period of time long enough for a member of the public, i.e. someone under no obligation to keep the content of the document secret, to have direct and unambiguous access to the document,

then the document was made available to the public in the sense of Article 54(2) EPC 1973."

Contrived Test Situation

The present decisions arise from oppositions in which DSM and Philips cooperated to set up the situations which led to the decisions. Philips was the patent proprietor and DSM was the opponent. Prior to filing, disclosures relevant to the two cases were sent in encrypted and unencrypted emails and were placed on websites with different levels of accessibility. The situations were engineered so that the outcomes of the decisions would only depend on which of the emails or websites represented a public disclosure. The Board briefly considered the collaboration between the parties to ensure that the situations complied with the need for the proceedings to be contentious, as required by G3/97 (which decided that proceedings were not contentious if the opponent was acting on behalf of the patent proprietor).

Conclusions

The outcomes of the two decisions are as most people would have expected, and they will probably have little impact on the way emails and the internet are used. The fact that test cases were set up to derive the decisions shows that companies felt there was a need for guidance from the EPO on the issues of emails and the internet disclosures. One could ask whether the EPO should have taken the initiative to provide guidance, perhaps via a referral of relevant questions from the President of the EPO to the Enlarged Board. However, the EPO seems to prefer deriving decisions from contentious proceedings in which different parties put across the different facts and arguments that support their cases. That probably provides a better framework for good quality decisions to be produced.