On the concepts of intrinsic novelty and originality in the new discipline for industrial inventions

1. – About forty years ago, in the pervious work, I excluded that the sale of a machine without an agreement of secrecy (and thus the communication by the previous discoverer to a third or the infringement of the obligation of secrecy by the person who had participated in it by the inventor) induced in itself the pre-disclosure of the invention that is a cause of nullity of industrial patent rights.

On the contrary, I concluded that investigations had to be carried out on the effective dimension taken on by the circulation of the inventive idea in society and that it should be considered divulged only when that invention has spread to such an extent that it can be considered as having become part of the cultural heritage of the class of operators interested in it.

In the final analysis, I observed that we should only be concerned about the divulgation in reality and not about that potential or virtual divulgation and thus the invention had to be shared by an undetermined number of people, whilst that limited to only one or a few third parties considered in isolation and remaining such, would have at the most allowed the purchase of the pre-use by them, obviously with the contribution of the suitable circumstances.

This opinion of the author of these lines remained isolated for the subsequent period and until the Presidential Decree no. 338 of 22nd June 1979, whilst both legal literature and case law continued to deem pre-divulged the invention that had been notified even to only a single third person due to specific information they had obtained or the purchase of a machine without the agreement of secrecy of the previous inventor. The article mentioned at the start outlined a picture of the then current opinions on the subject and it must be referred to for more information.

At the basis of this strongly rooted opinion, there is a concept of the extrinsic novelty that is so absolute and so individualistic as to appear in

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From « Rivista di diritto industriale » 1993 and from « L'Espressione monetaria nella responsabilità civile », Cedam 1994.

conflict with the very idea of divulgation (or awareness) as it is perceived by common sense.

From an equally absolute and individualistic point of view, authors and judges have also considered the other requisite of the intrinsic novelty or originality which has been deemed synonymous with a « contribution of technical progress, which objectifies a creative intellectual work ».

In this way, we have ended up (still at the time of law 1127/39 previously in force) not to understand in a perspicacious way the nexus between the two hypotheses of novelty (extrinsic and intrinsic) although there were those who intuited that they were in front of « coordinated and mutually integrating aspects of a complex and substantially unique requisite » (1).

This was made evident by the error of perspective, where the relationship between the two aspects of the novelty was summarized by legal literature and case law with the formula « what is original is not always new and what is new is not always original » (2).

Following that distant study, the author of these lines further studied in depth the concepts of originality, of divulgation and the respective relationships.

On that occasion, he realized that he had to attribute to them not an absolute meaning but a relative one, i.e. referred necessarily « to our culture » (Kohler) or better still, to the cultural heritage of the class of operators interested in the invention.

The logic of the legal system was, by its firm conviction, that of provoking divulgation of those inventive ideas that would otherwise have been destined to remain individual and reserved, thus procuring an enrichment of the common cultural heritage through the concession of exclusivity by way of an incentive reward.

From this point of view, the absence of public interest in protecting a well-known invention, i.e. already divulged, can be understood.

A divulged idea is synonymous with that belonging to the common cultural heritage. This concept postulates a widespread and not limited knowledge of the invention.

Similarly – in his opinion – originality was not to be understood with reference to the moral paternity or intellectual labour of the inventor, as a prize of his individual merit, as had been understood in the past. The invention was, on the other hand, to be considered original, even in the ab-

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(1) Eula, *Rassegna della Giurisprudenza della Corte Suprema in material di privative industriali*, in *Riv. dir. comm.*, 1946, I, 1, pp. 2 ff.

(2) Benedicenti, *Rassegna di giurisprudenza della Corte Suprema in materia di privativa industriale, (1957-1954)* in *Riv. dir. comm*,. 1956, I, pp. 470 ff., 472; Court of Civil Cassation, 20th May 1950, no. 1299.

sence of these requisites, where it did not appear as a rather obvious implication of the cultural heritage to which it referred.

At this stage, it will be understood how the previous formula which summarized the relationship between the two aspects (extrinsic and intrinsic) of the novelty, was not correct and the formula: « what is well-known is never original, what is not well-known may or may not be original » appeared to be more accurate.

The author of these lines matured this order of ideas at a period now far off in time, shortly after that far-off study and as a development of the same.

He subsequently had the fortune of seeing his ideas codified by articles 14 and 16 of Presidential Decree no. 338 of 22nd June 1979 in the context of the recent European standard (3).

2. – The new discipline continues to require, as in the past, novelty (in the two aspects of originality and lack of divulgation) so that the invention can be patented, but it fixes their concepts in very precise terms.

Art. 14, section 1, presidential Decree 339/79 establishes that the invention which is not divulged is that « which is not included in the state of the art ». Section 2 defines the context of this state of the art which is wording equivalent to that of the cultural heritage of the experts of the sector, Art. 16 further on in turns specifies that there is originality where « the invention is not evident from the state of the art ».

Both requisites not only appear as two aspects of the same concept of novelty, but they have the common reference to the state of the art.

What, must be seen is whether the invention was explicitly or implicitly part of the common cultural heritage when the application for patent was filed.

It is from this that the correctness of the conclusion that « the well-known invention is never original » and vice versa that the original invention presupposes that it is not well known » will be inferred.

3. – The innovative character of the recent standard shows however that it is not included where, as is the case of our case law, an invention continues to be considered pre-divulged of which only one example has been transferred to third parties, without any obligation of secrecy.

This shows the need to further examine in detail the subject and some of its premises of a general nature.

It must be pointed out that the progress of science (which makes up such a large part of humanity) is based on the circulation of products of

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(3) See art. 54. no. 1 and 2 Code of European patents.

the individual culture in the context of society and on the phenomenon of their absorption by the collective culture. Individual culture although very often is presented as backward with respect to the collective culture (and it will indicate the degree of ignorance of the individual) can sometimes overtake it (as is the case of geniuses or exceptional talents). The invention undoubtedly represents a product of individual culture.

The legal system, when it protects original works and thus reserves industrial patent rights for it, does not aim as its primary objective that of ensuring the property for its author, but rather to stimulate the enrichment of the collective culture through individual work and, in short, the osmosis between them. This explains the reasons why the patent is granted to the person who is the first to file the application and not the person who is the previous discoverer in absolute and why the requisites of extrinsic novelty and originality of the invention are essentially referred to the collective culture.

At this stage, it is opportune to analyse the phenomenon that goes by the name of the circulation of the inventive idea in society. This, as long as it is in the pure state of *res cogitate*, can be kept by the thinking subject, with that ephemeral medium which is the memory (where it is sufficient for the author to lose his memory for the idea to disappear) and is not susceptible, as such, to communication and divulgation to third parties (4).

It is all too obvious that the inventive idea, to be preserved by its author and so that it can circulate, must be fixed in a given object (the machine in which it materializes, a drawing, an oral or written speech, a formula etc.).

The inventive idea, like every idea, as it is fixed in a given object, acquires an autonomy including with regard to the thought that conceived it. The given object can provoke a creation of identical content, at a distance of time, in the same author and obviously in other subjects who were first unaware of and in this case it serves the function of a representative medium of the idea (5). This is the case of the industrial machine, of a manuscript, of a book, or a drawing or of a recorded tape.

The representative capacity of the medium can be adequate or not at all: thus some brief notes may rekindle the idea in the author or spark it off in third parties and, if incomplete, not show it at all in any of them. The case of a drawing or of a written or spoken speech is similar, of which the code of interpretation is more or less known or completely unknown.

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(4) A classic example of an inventor who took his inventive secret to the grave, without confiding it in others, was Gerolamo Segato, for the process of petrification of corpses.

(5) This is not the same idea of Tom who transfers to Dick so that the first no longer has it (as in the movable asset) but it is an idea conceived by Dick and with an identical content to that conceived by Tom which can be said to have been transferred from one to another only in a figurative way.

The possession of the representative medium and its circulation entails the same phenomenon for the inventive idea. The circulation of the idea, however, can be autonomous from the first: it is sufficient too read the drawing or the book and not necessarily its purchase as well (6).

The medium of representation, as it provokes a conception of identical content in subjects who were ignorant of it, absolves the function of the means of communication.

The inventive idea, once it has been objectified, as stated, is destined to leave the individual sphere of its author and spread to those who become aware of it and thus it enriches their cultural heritage (and not only that). They can even apply for the patent for that same invention if it has not already formed the object of any prior application.

The inventor can risk being receded by them as well as by an independent discoverer, who had the same idea come to mind (7). This explains the interest of the inventor in keeping for himself and not communicating to others the invention and the medium which represents it, i.e. keeping secret the invention he has discovered, at least until the time to which priority is referred.

4. – Depending on whether the invention is protected from the public knowledge of third parties, or has entered into circulation and the extent of this, it may be said to be at the stage of « secrecy » or be known to a narrow circle of individuals or enter the public domain, i.e. divulged.

Let's begin with some notes on the « secret ».

The invention that is kept for himself by the person who knows it and is concealed from strangers may be said to be « secret » (8). It is not sufficient for the invention to be kept secret: it must also not be other wise known (9).

The secret can be absolute (top secret) or relative.

It can end with its revelation to those who should not know or with the acquisition of its news by a stranger, due to an activity of espionage (10).

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(6) G.G.F. HEGEL, *Lineamenti di filosofia del diritto*, Bari, 1913, p. 74.

(7) The application for the patent right of the inventor may be preceded by that not only of an autonomous discoverer, but also by the person in whom the inventor confided the inventive idea.

(8) U. RUFFOLO, Segreto (in Dir. priv.) Enciclopedia del diritto, Milan, 1989, vol. 41, pp. 1015 ff. and Bibliography on pp. 1027 ff. The secret is the result of human conduct. i.e. of « keeping secret ».

(9) In this sense, keeping a known inventive secret is commonly called « an open secret ».

(10) Espionage does not imply divulgation because those who learn of it this way are normally interested that others, especially if competitors, do not learn of it.

The secret can be classified in different ways according to the base of interest it protects (11). It can also concern the means of communication between the initiated, such as a conventional language (secret code), the environment in which the protected commodity is kept (secret archives), the group of people (secret service) and so on.

Keeping the « secret » in itself excludes the invention becoming well known.

The case where the inventor (or the autonomous discoverer) reveals to a third party pr to a specific number of people the inventive idea, with a pact of secrecy or, on the contrary, without any limit of confidentiality, can be surmised.

In both cases, the effective dimensions reached by the diffusion of the news of the invention in society are to be sought together with the cultural heritage (individual or collective) which has been enriched by the information.

We have to consider that the communication with a pact of secrecy, in itself does not exclude the formation of a process of divulgation which is the cause of nullity of a patent.

A phenomenon of this kind was described in the past in a very expressive way in « The Betrothed » Chapter XI, by Manzonu, where he wrote: « One of the greatest consolations of this life is friendship and one of the consolations of friendship is that having someone in whom to confide a secret. Now, friends do not comes in twos like a bridal couple; each one, generally speaking has more than one friend, which forms a chain, the end of which nobody can find. So when a friend has that consolation of placing a secret in the breast of another, he gives him the desire to seek the same consolation as well. He begs him, *don't tell anyone: on such a condition, who took it in the strict sense of the word would immediately cut off the course of the consolations, But the general practice has wanted that you only oblige not to confide the secret, unless it is to an equally trusted friend and setting the same condition. Thus, from trusted friend to trusted friend, the secret travels down that immense chain, so that it reaches the ears that the first person who had spoken had not intended it ever to reach.* Normally, it would have been on a long journey, if each person had only two friends; the one who tells him and the one to who to tell the secret. But there are privileged men who have hundreds of friends and when the secret has reached one of these men, the journey of the secret travels quickly and multiplies, so that it is no longer possible to follow its trace ».

Similarly, communication by the inventor or an autonomous discovered, to a determined number of third parties, without any constraint of

(11) Therefore we have a secret of State, military secrecy, bank secrecy, company secrecy, professional secrecy etc.

confidentiality, is not enough in itself to hypothesize a state of pre-divulgation, unless it is followed by a diffusion of the news, such as to consider it has entered the public domain. In the case shown above, what must be considered enriched by the information is the individual cultural heritage and not the collective one.

On the contrary. where there will be effective and extensive diffusion of the news of the invention to an indeterminate number of people, it must be considered as having become accessible to the public, we will have divulgation and the idea must now be considered well known.

These concepts should have been fully applied under the Royal Decree of 29th June 1939 which required as a requisite for a valid patent, the absence of pre-divulgation (which is by definition a phenomenon of extensive diffusion) and not that the invention had been kept secret from everybody whatsoever.

On the contrary. as seen in the previous work, our legal literature and case law (12), under the influence of French literature (13), moving from an individualistic and absolute conception, identified divulgation with the failure of keeping it secret and denying importance to the dimensions of the diffusion of the information which, on the contrary, appears essential.

The disclosure of an invention, without a constraint of secrecy, according to this dominant orientation, was equivalent to divulgation.

In greater detail, it has to be said that the authors and judges distinguished the disclosure coming from the inventor, who had to be presumed by way of confidentiality and that from an autonomous discoverer, which must be presumed by way of advertising.

The first case excluded that the disclosure by the inventor was equivalent to divulgation, whilst on the contrary, this was asserted in the second case.

With regard to the hypothesis of the sale of even only one or very few examples, without the constraint of secrecy, case law, even in the last few years before the reform of 1979, confirmed, unfortunately, the unfavour-

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(12) Amongst the many works on this subject: BONELLI, *Privative per invenzione industriale, Noviss. Dig.*, Turin, 1957, XIII, p. 899 ff.; G. BAVETTA, *Invenzioni industriali* in *Encicl. del diritto*, Milan,. 1972, XXII, pp. 642 ff.; GRECO e VERCELLONE, *Le invenzioni ed i modelli industriali* in *Trattato di dir. civ.*, UTET 1968; ASCARELLI, *Teoria della concorrenza e dei beni immateriali*, Milan, 1960; R. CORRADO, *Opere dell'ingegno, Privative industriali*, Milan, 1061, p. 62, GHIRON, *Corso di diritto industriale*, Rome, 1948, II, p. 106; AULETTA MANGINI, *Opere dell'ingegno ed invenzioni industriali (Commentario* Scialoja and Branca) Bologna, 1987, p. 67. M. ROTONDI, *Diritto industriale*, Milan, 1942, pp. 182-183; RAMELLA, *Trattato della proprietà industriale*, Rome, 1909, I, p. 599.

(13) Amongst the most significant texts: BEDARRIDE, *Commentaire des lois sur les brevets d'invention*, Paris, 1878-94, no. 375, pp. 362-263; OUILLET, *Traité théorique ety pratique des brevets d'invention et de contrefaçon industrielle*, Paris, 1909, nos. 371-445; PICARD and OLIN, *Traité des brevets et de cotrefaçon industrielle*, Paris, 1869, no. 137.

able prior orientation, attributing to this sale the significance of a potential divulgation.

The following decisions are in this orientation: Court of Milan, 25th July 1977 in *Giur. annotate di dir. ind.*, 1980. 481; Court of Milan, 1st June 1973; Court of Bologna, 21st February 1973 in *Giur. Dir ind.*, 1973, 735, 440 as well as Court of Mantua, 27th March 1971, ibidem, 1972, 105, Court of Genoa, 29th April 1971; Court of Varese, 11th August 1971.

Only an isolated decision of the Court of Appeal of Catania of 15th July 1974 in Giur. Dir. ind., 1974, p. 1000 stated that the sale of only two examples did not represent divulgation.

Legal literature moved along the same line of thought as case law.

5. – Although a restrictive interpretation of the extrinsic novelty, as has been seen above, was not founded before the 1979 reform, it now appears in open contrast with the new European rule which came into force following the Presidential Decree no. 838 of 22nd June 1979 and the fundamental aspects of which were outlined at the beginning.

In particular, it has been said that article 14 refers to the « state of the art » which is synonymous with the common cultural heritage of the experts of the sector and the contents of which are described by the rule extensively and precisely.

We saw at the beginning that the logic underlying the extrinsic novelty of our legal system lies in the public interest in acquiring for the public domain what would otherwise be destined to belong exclusively to the reserved and individual sphere of the inventor.

It is only too obvious that such public interest does not exist in the case of a well known invention and this explains the nullity of a patent that had been granted to protect it.

The existence of the referred public interest is, on the other hand, undeniable in the case of those inventions in which the information has entered only the individual heritage of people other than the inventor and has remained in these individual spheres afterwards as well, without being well known, i.e. entering the heritage of the collective knowledge and utility.

It cannot be argued that the spirit and the letter of the new law are in this direction.

Between the oldest wording of article 3 of Royal Decree of 30th October 1859 which considered « new the invention that had not been divulged » and the present-day one of articles 14 and 15, according to which the invention is new that « is not comprised in the state of the art » there is a succession of wordings, each with a specific difference to be understood.

The « state of the art » compared with the previous one, cannot be understood other than as the epilogue and conclusion of the divulgation itself, admitted and not granted that the latter can be understood as the synonym

of a process of divulgation, existing. since the disclosure by the inventor. We will return shortly to the nearing of the new law.

However, it is worth saying straight away that the meaning of articles 14 and 15 of the 1979 reform, does not seem to me to have been understood by the present day legal literature and case law. It is possible to read in literature, where there is no radical correction of orientation with respect to the previous opinions (14) that « in general the problems that the concept of divulgation raised for the previous case law are proposed in the same terms, after the reform of 1979 » (15).

As for case law, the majority of the decisions move along the lines of the previous one and thus deems that the sale of a machine to a third party without the obligation of confidentiality, entails the divulgation no differently from the disclosure without the obligation of secrecy.

In this sense: Court of Milan, 19th November 1981; Court of Appeal of Milan, 21st June 1982; Court of Milan, 25th October 1984, in *Giur. annotate di dir. ind, Rep. sist.*, 1972-1987, 2, 1.1.2.

More recently, the Court of Milan with the decision of 6th October 1988 in *Giur. annotata di dir. ind.*, 1988, p. 773 textually wrote: « there exists predivulgation of the invention when before the filing of the application one example of the product has been sold which, although closed and very compact. can be, although not easily, seen. »

This order of ideas is – in my opinion – at the antipodes of articles 14 and 15 of Presidential Decree no. 838 of 22nd June 1979 considered jointly.

The new rule, mentioned above, has decidedly superseded the previous problems.

The « state of the art » concerns the invention belonging to the common heritage of knowledge and collective utility and this supposes that divulgation is now effective and present and no longer only potential and virtual.

Remarks on the danger of divulgation is to be excluded whilst the observations on effective divulgation are to be given exclusive importance. All the previous problems and the presumption on the revelations that would be to be classified by way of secret, if originating with the inventor or, on the contrary, advertising, if originating with the autonomous discoverer, must be understood as superseded. Article 14, where in detail it specifies

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(14) Even in the recent editions of books on the subject, legal literature still states that personal divulgation of the invention is sufficient, that it even only has to be disclosed to only one person and that the circulation of the idea with the obligation of secrecy does not give rise to divulgation. AULETTA-MANGINI, *loc. cit.*, p. 67. AMMENDOLA, *Invenzione, marchio, opera dell'ingegno*. Milan, 1977. p. 219; GRECO-VERCELLONE, *op. cit.*, 1, PP. 118, 355; SENA, *I diritti sulle invenzioni e sui modelli industriali*, Milan, 1984, p. 124, note 57.

(15) SENA, *op. cit.*, p. 123.

tat « the state of the art » is made up of everything that has been made accessible to the public. by means of an oral or written description or the use of one or more media in the territory of the state or abroad, establishes without a doubt that the dimensions of diffusion of the news of the invention take on importance.

There will be divulgation where the addressee of the revelation is n indeterminate number of people whilst at the opposite extreme, it is to be denied that it will concern a cultural circle of one or more people, individually considered and not the common cultural heritage of the operators of the sector. so as to be « accessible to the public ».

6. – We will now go on to the part that concerns the other requisite, i.e. the originality (or intrinsic novelty).

In the past it was considered from the point of view of an important contribution to technical progress, which objectifies the creative intellectual labour of the inventor (16). The subjective reference does not appear essential for the concept of originality, because the right to the patent is not so much for the person who proves that they are the father of the inventive idea, but who can prove the invention is in their hands. These are the cases of the heir of the inventor, the transferee, the employer for the invention by the employee, of who learnt of the invention by (licit or illicit) disclosure and, in the past, of the imported patent.

Moreover, the discovery may be the result of a difficult creative activity by the author who was unaware that it had previously been discovered by others or that was not other wise known.

Subsequently, a part of case law, reductively understood originality as the equivalent of merely contributing technical progress (17), whilst another part of case law and legal literature (18) unanimously identified it in the invention that an « average technician of the sector would not have been able to produce ». At a later date an orientation of synthesis became asserted at a later period (the so-called dualistic conception of originality) (19).

Lastly, following the new rule, in the context of the European one, article 16 of Presidential Decree no. 838 of 22nd June 1979 reached the con-

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(16) EULA, *op. loc. cit.*

(17) Court of Appeal, Milan, 29th September 1981; Court of Milan, 26th June 1975; Court of Rome, 5th November 1974; Court of Appeal, Milan, 29th May 1973; Court of Appeal, Bologna, 11th April 1973.

(18) Court of Milan, 23rd July 1974, Court of Milan 29th September 1980; Court of Vicenza 9th November 1974; Court of Appeal of Turin, 13th July 1972; Court of Milan, 23rd January 1972; and in literature SENA, op. cit., P. 139; AULETTA-MANGINI, *op. cit.*, p. 42, amongst the others.

(19) Court of Civil Cassation 83/6435; Court of Appeal Turin, 13th July 1972; Court of Milan, 23rd July 1984.

clusion of defining the original invention, as that which « is not evidence from the state of the art, for an expert of the sector ».

Only the value of « index of evidence » is attributed to mere technical progress, considered in itself and for itself.

The new legislator shows here that he understands originality as « a novelty relative to our culture » and more specifically in the sense which Kohler supported in his time.

He defined as « original » that discovery which does not entail logical implication or the development of pre-existing cognitions considered in themselves or due to their coordination. What comes under this heading cannot be called original.

The « start of the art » to which the new dictate refers, has been correctly deemed as « all the cognitions of the average technician in the sector to which the invention belongs. The invention which does not represent a logical implication or the development of the cognitions of the average operation in the sector under consideration must therefore be deemed « original » (20).

Case law, as a whole, correctly interprets the rule and this numerous decisions have deemed original that invention which represents an improvement to the pre-existing technique. a solution of a problem above the reach of the average technician (Court of Civil Cassation, 5th September 1990, no. 9143; Court of Civil Cassation, 14th April 1988, no. 2965; Court of Civil Cassation, 8th April 1982, no. 2168; Court of Civil Cassation, 16th October 1980, no. 5570; Court of Appeal of Rome, 1st February 1988; Court of Modena, 19th May 1988 etc.).

7. – As for the relationship between extrinsic novelty and intrinsic novelty, it was – as stated – erroneously summarized by the Court of Civil Cassation of 20th May 1950 no. 1209 in the wording « what is original is not always new and what is new is always original ». The author of these lines has observed above that this is relationship should have been correctly expressed with the words « what is known is never original, what is not known, may or may not be original ».

The relationship between the two types of novelty is still not understood and is misunderstood as in the case of the Court of Civil Cassation, 9th November 1987, no. 8263 where it states that « the requisite of extrinsic novelty is confirmed after the positive ascertainment of the intrinsic novelty » in the legal literature, according to Franzosi (21), according to whom the distinction between the two types of novelty is superfluous because « the extrinsic novelty is necessarily included in the intrinsic novelty ».

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(20) Di Castaldo, *L'originalità nell'invenzione*, pp. 69 ff.

(21) Franzosi, *L'invenzione*, pp. 46 ff.

These are erroneous statements, which reverse the correct relationship, because it does not appear questionable that the ascertainment of the extrinsic novelty is preliminary and priority compared to the intrinsic one, as the search for the original nature of a well known or pre-divulged invention appears pointless.

This shows, in my opinion, that the intimate essence of the two types of novelty that represent two subsequent degrees of differentiation of the discovery with respect to the technological capital have still not been understood.

Also by the author on the same subject:

– «*Se la vendita di una macchina senza patto di segretezza prima della domanda di privative induca alla divulgazione ex art. 1559 R.D. 29/07/1939 no. 127*», in *Foro Padano* 1954, III, p. 161 and in L'Espressione monetaria nella responsabilità civile» Cedam 1994, p. 484.