

properties help to solve a different problem apart from what is disclosed or promoted by the prior art, the invention should be in a better position to be considered new and patentable.

#### 4. *The inherent properties*

An invention may be anticipated not only by its explicit characteristics but also by the intrinsic or inherent particularities disclosed in the prior art. This premise has been applied in many cases at the EPO.<sup>115</sup>

One of the most relevant cases for the problem of inherent properties is the Mobil Oil III case.<sup>116</sup> Here, the TBA analyzed the relevance in assessing novelty of a prior publication disclosing the use of a compound for a defined purpose (lubricant) on a patent protecting a new use of such compound, where the compound is performing a new purpose (anticorrosive).<sup>117</sup> The court faced the question if the use of the substance inherently anticipated the use as a lubricant.<sup>118</sup> The court ruled that “[...] such new use may reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a functional technical feature of the claim. If that technical feature has not been previously made available to the public by any of the means as set out in Article 54(2) EPC, then the claimed invention is novel, even though such technical effect may have inherently taken place in the course of carrying out what has previously been made available to the public.”<sup>119</sup>

According to this decision, to invalidate a patent based on the presence of inherent properties, the plaintiff needs not only to demonstrate the existence of such inherent property, but also to prove the “availability to the public” of it, according to the definition of Article 54(2) of EPC. In order to be novelty destroying, the prior art must provide a clear, unambiguous and enabling disclosure of the inherent properties.<sup>120</sup> In this way, an inherent feature is considered made available to the public if the feature per se has become part of the state of the art or can be derived by a person skilled in the art.<sup>121</sup> Nevertheless, this is not usually the case with

115 See, for example, T 059/87.

116 G 02/88.

117 *Id.*

118 *Id.*

119 *Id.*

120 T 179/01

121 Caroline Pallard, Nederlandsch Octrooibureau, *Novelty of biotechnological inventions and further therapeutic use in Europe*, IP in the life sciences industries 2008, IAM Magazine, 2008, p 35-36.

nanotechnological inventions, as inherent properties present in materials belonging to the state of the art may not be used to attack novelty of new uses of such materials, provided that both, the new use involves a new technical purpose and the inherent property was not available to the public.

Another important aspect of the *Mobil III* decision, upon the question whether the modification of the claims of a patent during an opposition from a product type to a claim of a particular use of such product—action intended to avoid invalidity of the patent when anticipated by inherent properties in the prior art—the TBA defined that “An amendment of a European patent during opposition proceedings simply by way of change of category from a claim to a physical entity per se (e.g. a compound or composition), so as to include a claim to a physical activity involving the use of such physical entity, therefore does not extend the protection conferred by the patent, and is admissible.”<sup>122</sup> In this way, in opposition proceedings or during the prosecution of the patent, the strategy of modifying the scope of the claims from a *product* type to a *use* type may be a good alternative to avoid the prior art and get protection for the nanotechnological invention.

As we can see, anticipation of inherent properties is not considered a bar for patentability in all cases. The discovery of new properties even when they were inherently present in the prior art, can provide the basis for patentability, as a second use, of the known material.<sup>123</sup>

The issue may be particularly relevant in assessing patentability of materials with functionalities in the electronic or optical field. Even when some of these materials may be already patented, the understanding, control and manipulation of structures and fillers at nanometer level can give a new world of possibilities to the field. Although these properties were present in those materials from the very beginning, it is now the understanding and control of the relationship among the properties and the matter what generates the new technological development. Nevertheless, patenting a material for a second time because it is possible now to describe the mechanism making those properties possible may not be allowed as those characteristics were implicitly or inherently present in the material since it was used for the first time. Again, the success of the applicant in getting protection on the invention will depend on her ability to draft a claim limited to the new use, the manufacturing process or the method to control such properties.<sup>124</sup>

122 *Id.*

123 *Id.*

124 Note the similarities that US case law has with the EPO decisions. The Federal Circuit, in the case *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed.Cir.1987), considered that “A prior art reference anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim”. In other example, case *Cf., Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003), the court indicated “Upon proof that the missing description is inherent in the prior art, that single