



Patents – Option 1

Explanatory Note for proposed Study Question – Cancun 2018

Conflicting patent applications

How do applications that have an earlier filing or priority date, but which have not been published, affect patentability of a later filed application? In some jurisdictions, such as the US, a prior filed, later published application is relevant both for considerations of novelty and obviousness or inventive step. In others, such an application is relevant for novelty only. The EPO follows this standard. Some jurisdictions take a middle ground: such applications are relevant for novelty and “enlarged novelty,” ie applications for inventions that differ from the prior application in a manner which does not go beyond common general knowledge may be rejected. This is similar to the test applied in Japan.

Further, some jurisdictions will reject later filed applications filed by the same applicant over their own prior filed, later published applications. This “self-collision” principal applies in Europe, but not in the US.

Yet another class of conflicting applications are PCT applications. A published PCT application that designates all states will potentially cover applications in up to 152 countries if the applicant chooses to enter the national phase in all countries. Under Article 11 of the PCT, a PCT application is the legal equivalent of filing in each designated state. However, some countries will only consider a PCT application as prior art when the national phase is entered, while other countries will treat this as prior art from the PCT filing date once the PCT application is published.

In short, there is wide variation in how prior filed, later published applications are treated for prior art purposes, leading to very disparate results with the same prior references depending on the jurisdiction.

The Trilateral Patent Offices, and the Trilateral Industry User group, as well as the Group B+ Sub Group of WIPO countries, are seeking to find common ground to harmonize the law on several topics, including laws relating to grace period, prior user rights, 18-month publication, and treatment of conflicting applications.

In its Resolution on Q89C – “Self-collision” (Sydney, 1988), AIPPI supported a provision in the draft WIPO Treaty on Harmonization that would exclude self-collision between applications in which there is at least partial identity of the applicants for the respective applications at the date of filing the later application. Given the renewed efforts directed at harmonization of certain aspects of substantive patent law described above, it is timely AIPPI revisit this issue and update its position.

Questions that may be considered as part of this possible Study Question include an analysis of the current laws and practices as to the prior art status of prior filed, later

published applications for novelty or inventive step; whether PCT applications are treated differently from national applications; whether special consideration is or should be given to prior filed applications by the same applicant; and what standards should be applied in a harmonized system.