



Study Question

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Conflicting patent applications

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For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Both the European Patent Convention (“EPC”) and the German Patent Act (“PatG”) include provisions regarding the availability of secret prior art against the claims of the later-filed application for novelty-defeating purposes.

According to the EPC, secret prior art is available against the claims of a later-filed European patent application for novelty-defeating purposes if the secret prior art is

- a European patent application (Art. 54 (3) EPC) [1] that was pending on the day of its publication, [2]

or

- an international patent application according to the Patent Cooperation Treaty (“PCT”) under further conditions presented as answer to question 1) c).

An earlier-filed national patent application does neither form secret prior art against the claims of the later-filed European patent application for novelty-defeating purposes in examination proceedings nor for the claims of the European patent granted on the later-filed European patent application in opposition proceedings before the European Patent Office (“EPO”). [3] The earlier-filed national patent application can, however, according to Art. 139 (2) EPC, form secret prior art against the claims of the European patent granted on the later-filed European patent application for novelty-defeating purposes in national proceedings of a Contracting State of the EPC, e.g. in a patent nullity suit in Germany. [4] Therefore, the European patent granted on the later-filed European patent application has to designate that Contracting State and the earlier-filed patent application needs to form secret prior art against the claims of this European patent for novelty-defeating purposes according to the national provisions of the Contracting State under the condition that this European patent is treated as if it was a national patent.

According to § 3 (2) PatG, secret prior art is available against the claims of a later-filed German patent application for novelty-defeating purposes if the secret prior art is

- a German patent application,
- a European patent application under the conditions that protection is sought for Germany and the designation fee for Germany has been paid, [5]

or

- an international patent application under further conditions presented as answer to question 1) c).

Therefore, § 3 (2) PatG contains a legal fiction in favour of German, European and international applications and extends the types of prior art available for novelty-defeating purposes to include secret prior art as well.

In addition to the EPC and PatG with regard to patent applications, the German Utility Model Act (“GebrMG”) includes provisions regarding the availability of secret prior art against the claims of a later-filed German utility model. German utility models are registered without an examination procedure. [6] Therefore, the secret prior art is only considered in utility model cancellation proceedings [7] or as defense in utility model infringement proceedings. [8]

According to § 15 (1) No 2 GebrMG, secret prior art is available against the claims of the later-filed German utility model in utility model cancellation proceedings if the secret prior art is a granted German patent, a granted European patent designating Germany, [9] or a registered German utility model, which is based on an earlier-filed application.

Footnotes

1. [^] Note that under Art. 54 (3) EPC 2000, which entered into force on 13 December 2007, any earlier European patent application is available for novelty-defeating purposes against a later-filed European application, regardless of which contracting states are designated in the earlier European application, and regardless of whether the corresponding designation fees have been paid. In contrast thereto, under the former regime of Arts. 54 (3), (4) EPC 1973 and Rule 23a EPC 1973, an earlier European patent application was available for novelty-defeating purposes against a later-filed European patent application only insofar as a contracting state designated in the later-filed European application was also designated in the earlier European application and the corresponding designation fee was paid. This former regime is still applicable to all European patents granted before 13 December 2007 as well as all European patent applications that were filed before 13 December 2007 and any European patents resulting therefrom.
2. [^] EPO, decision [J 5/81](#) of 9 December 1981; BGH, decision [X ZR 113/13](#) of 8 September 2015 –PALplus, ref. 29..
3. [^] Guidelines for Examination in the European Patent Office November 2017 edition, H-III, 4.4.
4. [^] Guidelines for Examination in the European Patent Office November 2017 edition, H-III, 4.4

5. ¹ See also Art. 139 (1) EPC; Note that these conditions requiring that protection is sought for Germany and that the designation fee for Germany has been paid, correspond essentially to those under the former regime of Art. 54 (3), (4) EPC 1973 and Rule 23a EPC 1973 (see earlier footnote) and are thus stricter than the conditions under the current regime of Art. 54 (3) EPC 2000.
6. ² § 8 (1) GebrMG.
7. ³ §§13 (1), 15 (1) No 2 GebrMG.
8. ⁴ BGH, decision [Ia ZB 19/65](#) of 26 January 1967 -UHF-Empfänger II, reasons III. 2. a).
9. ⁵ Arts. 140, 139 (1) EPC.

.a.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The secret prior art consists of the entire contents of the earlier-filed patent application. ^[1] The use of the entire contents of the secret prior art for defeating novelty of the claims of the later-filed German or European patent application is called “whole contents” approach. ^[2] The entire contents of the secret prior art include the description, drawings and claims (but not the abstract which forms only publicly available prior art once it is published), as well as any matter explicitly disclaimed (with the exception of disclaimers for unworkable embodiments), any matter for which an allowable reference to other documents is made, and prior art insofar as explicitly described. ^[3]

However, this situation is different in the special case in which only a portion of the subject-matter disclosed in the earlier-filed patent application has an effective filing date before the effective filing date of the later-filed patent application. In this case only the contents of the earlier-filed application having an earlier effective filing date is available against the claims of the later-filed European patent application and the later-filed German patent application. ^[4]

As regards utility models, if the secret prior art is a German, European or international patent application, only the claims granted on this application are available against the claims of the later-filed utility model. If the secret prior art is a utility model, the registered claims of the earlier utility model are available against the later-filed German utility model. This approach is called “prior claim” approach.

Footnotes

1. ¹ EPO, decision [G 1/03](#) of 8 April 2004 –Disclaimer, reasons 2.1.1; BGH, decision [X ZR 113/13](#) of 8 September 2015 –PALplus, ref. 29.
2. ² EPO, decision [G 1/03](#) of 8 April 2004, *Abl. EPA* 2004, 413 –Disclaimer; *Busse/Keukenschrijver/Keukenschrijver, PatG, 8th Ed., § 3, para. 147; Schulte/Moufang, PatG, 10th Ed., § 3 para. 80.*
3. ³ *Guidelines for Examination in the European Patent Office November 2017 edition, G-IV, 5.1.*
4. ⁴ EPO, decision [T 0382/07](#) of 26 September 2008, reasons 10; § 3 (2), sentence 2 PatG.

.a.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The subject matter of the later-filed European patent application is not new (Art. 54 (1), (3) EPC) if the subject matter can be directly and unambiguously derived from the secret prior art, i.e., if the secret prior art discloses all features of the claimed invention of the later-filed European patent application in a single embodiment. It is not permissible to combine features disclosed separately and incoherently in a single document, unless the document itself suggests such a combination of features. ^[1] The claimed subject matter of the later-filed European patent application is new if the claimed subject matter is distinguished from the secret prior art by at least one claim feature.

Technical equivalents not specifically disclosed in the secret prior art are not considered to form part of the disclosure of the secret prior art. ^[2]

The subject matter of the later-filed German patent application is considered to be disclosed in the secret prior art if the secret prior art directly and unambiguously discloses all features of the subject matter of the later-filed German patent application. ^[3] The skilled person interprets the disclosure of the secret prior art based on his common technical knowledge without considering further findings or modifications of the secret prior art by his technical knowledge. ^[4]

While secret prior art would not fall under the definitions set forth in Art. 54 (1) EPC and § 3 (1) PatG, respectively, Art. 54 (3) EPC and § 3 (2)

PatG both extend the types of prior art available for novelty-defeating purposes to include secret prior art. [5] The standard for evaluation of novelty remains the same for both secret prior art and publicly available prior art. Publicly available prior art, however, in contrast to secret prior art, is any prior art that has been publicly disclosed, viz. anywhere, anyhow, and at any time before the effective filing date of the later-filed application. Therefore, publicly available prior art includes any oral and written disclosure publicly available anywhere in the world while secret prior art is limited to earlier-filed patent applications only as described above.

The subject matter of the later-filed German utility model is new in view of the secret prior art if the claims of the later-filed German utility model and the granted or registered claims of the secret prior art are not identical ("prior claim" approach). The types of publicly available prior art which may defeat novelty of the later-filed German utility model are different from the types of publicly available prior art which may be novelty-defeating for German and European patent applications in that publicly available prior art for the German utility model includes, according to § 3 (1) GebrMG, written disclosures (no oral disclosures) and public use of the subject matter in Germany before the effective filing date of the German utility model. Moreover, according to § 3 (1) sentence 3 GebrMG, a description or use of the subject matter of the German utility model is not novelty-defeating if such description or use was available to the public within six months prior to the effective filing date of the German utility model and the description or use is based upon the work of the applicant or his/her predecessor in title of the German utility model ("grace period"). For the consideration of such limited public prior art for German utility models the same standard for the evaluation of novelty is applied as for German and European patent applications.

Footnotes

1. [EPO, decision T 0305/87](#) of 1 September 1989 -Shear catalogue.
2. [Guidelines for Examination in the European Patent Office November 2017 edition, G-VI, 2.](#)
3. [BGH, decision X ZR 35/12](#) of 18 June 2013 -Halbleiterdotierung, reasons III. 2. a) aa).
4. [BGH, decision X ZR 89/07](#) of 16 December 2008 -Olanzapin, reasons II. 2.
5. [Extended novelty-defeating prior art \(„erweiterter Neuheitsbegriff“\) cf. Busse/Keukenschrijver/ Keukenschrijver, PatG, § 3, para. 145.](#)

1.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Art. 56 S. 2 EPC for the later-filed European patent application and § 4 S. 2 PatG for the later-filed German patent application state that secret prior art is not available to show lack of inventive step.

.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

.b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? **
The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

.b.i If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

1.c If the secret prior art is an international application filed designating your jurisdiction:

.c.

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

Please Explain

Further conditions have to be fulfilled in order for the international patent application to be available as secret prior art compared to the earlier-filed European patent application or the earlier-filed German patent application.

An international patent application according to the PCT is available as secret prior art against the claims of the later-filed European patent application for novelty-defeating purposes under the conditions that the EPO is designated office ("DO") or elected office ("EO"), that the international patent application has been accorded an international date of filing, that the filing fee has been paid, and that either the international publication of the international patent application was published in one of the official languages of the EPO (English, French or German) or a translation in one of the official languages of the EPO has been filed with and published by the EPO. [1]

An international patent application according to the PCT is available as secret prior art against the claims of the later-filed German patent application for novelty-defeating purposes under the conditions

- that the German Patent and Trademark Office ("DPMA") is DO, that a translation in German language is provided to the DPMA if the international application was not filed in German language, and that the filing fee has been paid, [2]

or

- that the EPO is DO or EO, that the international patent application has been accorded an international date of filing, that the filing fee has been paid, that protection is sought for Germany, that the designation fee for Germany has been paid, and that either the international publication of the international patent application was published in one of the languages of the EPO or a translation in one of the languages of the EPO has been filed with and published by the EPO. [3]

Footnotes

1. [^](#) Arts. 153 (5), (2), (3), (4) EPC, Rules 165, 159 (1) c) EPC.
2. [^](#) § 3 (2) No 3 PatG, Art III §§ 8 (3), 4 (2), 4 (1) IntPatÜbkG, Art. 22 (1), 21 PCT.
3. [^](#) § 3 (2) No 2 PatG, Arts. 153 (5), (2), (3), (4) EPC, Rules 165, 159 (1) c) EPC.

.c.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

In order for the international application to enter into the national phase the requirements of Art. 22 (1) PCT need to be fulfilled for the international application. Art. 22 (1) PCT requires the applicant to furnish a copy of the international application and a translation thereof (as prescribed), and to pay the national fee (if any), to each DO not later than at the expiration of 30 months from the priority date. Art. 22 (3) PCT permits national law to fix time limits which expire later than 30 months from the priority date for performing the acts for entering the national phase.

For the international application to be available as secret prior art against the claims of the later-filed European patent application, payment of the national fee (filing fee according to Rule 159 (1) c) EPC) and a translation of the international application (either the international application published in the language of the EPO according to Art. 153 (3) EPC or a translation is filed with and published by the EPO according to Art. 153 (4) EPC) are required within 31 months of the earliest priority date of the international application. [1] Further requirements for entering the European phase according to Rule 159 (1) EPC, however, do not have to be fulfilled in order for the international application to be available as secret prior art.

The international application has to enter the German national phase in order to be available as secret prior art against the claims of the later-filed German patent application. In particular according to Art III §§ 8 (3), 4 (2) International Patent Law Treaty ("IntPatÜbkG"), the International application is only available as secret prior art for novelty-defeating purposes against the claims of the later-filed German patent application under the conditions that the DPMA is DO, that the national fee (filing fee according to No 311 150 or No 311 160 of the Annex to § 2 (1) of the Patent Costs Law ("PatKostG")) was paid, [2] and that a translation in German language is provided to the DPMA, if the

international application was not filed in German language. These conditions have to be fulfilled within 30 months from the earliest priority date of the international application.^[3]

Footnotes

1. [^] [Art. 153 \(5\) EPC, Rules 165, 159 \(1\) c\) EPC.](#)
2. [^] [In case that the DPMA is also EO, the filing fee is considered to be paid with payment of the transmittal fee \(No 313 900 of the Annex to § 2 \(1\) PatKostG\) according to Art III § 4 \(2\) S. 2 IntPatÜbkG.](#)
3. [^] [Art. 22 \(1\) PCT, Art III § 4 \(2\) IntPatÜbkG.](#)

c.i

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

The international application is available as secret prior art from its effective filing date regardless of the date of the national or regional phase entry. However, the international application is available only as secret prior art upon fulfilment of the requirements as presented in the answer to question 1) c) ii).

2

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Please refer to the answer given above to question I. 1) a). Neither the EPC nor the PatG discriminates between later-filed applications by different inventors and/or applicants, and those filed by the same inventors and/or applicants.

§ 3 (2) PatG refers generally to “the following patent applications” without differentiation of the applicant. Art. 54 (3) EPC, too, refers generally to the “content of European patent applications” without further differentiation. An exception or different treatment depending on the applicant and/or inventor of the earlier-filed application can also not be derived from any other provision of the PatG or the EPC. Moreover, German and European case law assumes that there is a risk of self-collision.

The Boards of Appeal of the EPO, however, have consistently applied a very restrictive interpretation of disclosure, in order to reduce the risk of self-collision.^[1]

Footnotes

1. [^] [EPO, decision T 0447/92 of 7 July 1993.](#)

2.a.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the earlier applications are available as prior art. Art. 54 (3) EPC and § 3 (2) PatG refer to “the content” of the earlier

applications as-filed. For more details including the definition of the “entire contents” please refer to the answer given for question I. 1) a) i) above.

.a.i If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard is the same for secret prior art and publicly available prior art. This is true for both European and German patent applications and patents under the EPC and the PatG. For more details, please refer to the answer to question I. 1) a) ii) above.

.a.i If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There is no such period, neither under the EPC for European patent applications and patents nor under the PatG for German patent applications and German patents, and European patents designating Germany.

2.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art is not available to show lack of inventive step. This is stipulated in § 4 PatG for Germany and in Art. 56 EPC for European patent applications.

2.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

.b.i If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

.b.i If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

.b.i If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

.b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c. Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

Yes

Please Explain

Please refer to the answer given to question I. 1) c) i) above.

.c.i Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Please refer to the answer to question I. 1) c) ii) above.

.c.i Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Please refer to the answer to question I. 1) c) iii) above.

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

X same as Question 2

3.b Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

X same as Question 2

3.c. Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

X same as Question 2

3.c. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

X same as Question 2

3.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

3.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group's current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

4.b The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

4.c The treatment of international applications as secret prior art.

No

Please Explain

4.d The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

4.f Provisions for avoiding self-collision.

Yes

Please Explain

Currently there is no specific anti-self collision provision available in the written European or German law. However, there is case law concerning the admissibility of so-called "undisclosed disclaimers".

A "disclaimer" is an amendment made to a claim after filing of the application, which results in the incorporation of a negative feature. The case law considers an amendment in the form of a disclaimer allowable if the disclaimer is used to excise from the claim subject-matter disclosed in a secret prior art document that would otherwise anticipate the subject-matter of the claim (e.g. "not including subject-matter X"). The wording of the disclaimer need not be originally disclosed in the later filed patent application, but must have a basis in the secret prior art. Thereby, an applicant can distinguish the subject-matter in his patent application from a secret prior art document. An undisclosed disclaimer is available to any applicant regardless of whether or not the applicant of the secret prior art and that of the later-filed application are the same, thus effectively providing anti-self collision.

Unfortunately, there was a lot of discussion about whether such undisclosed disclaimers are permissible under German and European patent law. Recently, the EPO's Enlarged Board of Appeal confirmed again that undisclosed disclaimers are available to the applicant of a later-filed application. Thereby, the Enlarged Board of Appeal ended a discussion that was going on for years about whether or not such disclaimers were allowable. The discussion created significant uncertainty and there were decisions that held undisclosed disclaimers to be unallowable. Thus, there is a need for improvement in the form of written law that grants every applicant the right to use undisclosed disclaimers against secret prior art. We suggest to add a respective paragraph to the written law which could be based on the headnotes of one of the fundamental EPO Enlarged Board of Appeal decisions G 1/03, e.g.:

"A disclaimer may be allowable in order to

- **restore novelty by delimiting a claim against state of the art under Article 54 (3) and (4) EPC (i.e. secret prior art);**
- *restore novelty by delimiting a claim against accidental anticipation under Art. 54 (2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention;*

- *disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.*

A disclaimer may not remove more than is necessary to restore novelty."

4.g Provisions for limiting an applicant's right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant's earlier-filed application.

No

Please Explain

5 Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

No

Please Explain

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6 Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

7 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents should be available.

7.a. **If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?**

The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art. According to this standard the subject matter is new if it cannot be directly and unambiguously derived from any other single disclosure, i.e., if there is no disclosure that discloses all features of the invention in a single embodiment. The skilled person interprets the disclosure based on his common technical knowledge without considering further findings or modifications of the disclosure by his technical knowledge. Technical equivalents not specifically disclosed in the disclosure are not considered to be part of the disclosure.

7.b. **Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

No

Please Explain

7.b. **If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?**

7.b. **If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?**

7.b. **If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?**

7.c. **If the secret prior art is an international application filed designating your jurisdiction:**

7.c. **Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.**

Yes

Please Explain

If the secret prior art is an international application, it shall only be available for novelty-defeating purposes if it enters the national phase, as a risk of double patenting is given only in this case.

7.c. **Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

Yes

Please Explain

Only if it enters the national phase it shall be available for novelty-defeating purposes.

3.c.i Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents should be available.

8.a If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The same standard for evaluation of novelty as for publicly available prior art should be applied.

8.a.i If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There should be no such time period as the applicant knows his own applications and has to manage his filing strategy accordingly in order to avoid self collisions.

8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

8.b If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

.b. *If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?*

.b.i *If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?*

.b. *If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?*

.b. *If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?*

8.c *If the secret prior art is an international application filed designating your jurisdiction:*

3.c. *Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.*

Yes

Please Explain

If the secret prior art is an international application, it shall only be available for novelty-defeating purposes if it enters the national phase, as a risk of double patenting is given only in this case.

.c. *Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.*

Yes

Please Explain

Only if it enters the national phase it shall be available for novelty-defeating purposes.

.c.i *Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?*

No

Please Explain

9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

same as Question 8

9.b Same applicant on the dates of filing, no common inventor:

same as Question 7

Please Explain

same as Questions 8

9.c Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

same as Question 8

9.c. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

same as Question 8

9.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

9.d. **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain

9.e. **Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:**

same as Question 7

Please Explain

X same as Question 8

9.f. **Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:**

same as Question 7

Please Explain

X same as Question 8

10 **Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.**

No additional issues are considered to be relevant.

11 **Please indicate which industry sector views are included in your Group's answers to Part III.**

The answers do not reflect any specific industry sector view. The Group consisted of practicing Patent Attorneys from all technical fields (inter alia mechanical engineers, electrical engineers, physicists, chemists, biologists, pharmacists) and Attorneys-at-law.