



Standing Committee on Patents

Questionnaire on the Publication of Patent Applications

Introduction

1. Many of the world's national and regional patent systems provide a time limit by which a patent application is made public. This is commonly set at 18 months after the date of filing or priority.
2. In return for (possible) patent protection, the inventor(s) and/or any other entitled parties (collectively referred to as the "applicant") must disclose the alleged invention so that it can be made public. This allows third parties to be made aware of the (alleged) contribution to the state of the art.
3. The main purpose of the publication of patent applications is thus to strike a fair balance between the interests of the applicant and those of third parties. Specific considerations in relation to the legal principle of publicizing patent applications within a certain timeframe are set out below.

Background and discussion

4. The publication of patent applications allows third parties to take note of technological developments and to make informed decisions about their own strategy (and perhaps their own research and development efforts) in relation thereto.
5. By providing a timeframe for publication of applications after filing, an applicant can decide whether or not to pursue the application (so as to retain the possibility to protect the invention as a trade secret).

History

6. A discussion of the origin of the 18 month publication period can be found in the WIPO records of the 1970 Washington Conference on the PCT. On page 243 of the Conference Documents¹, reference is made to a 1956 preliminary report by a patent law revision committee in The Netherlands as a likely origin of the 18 month publication term. This report² suggested that patent

¹ Available at <http://www.wipo.int/export/sites/www/pct/en/texts/pdf/washington_p171_to_538.pdf>

² Bijblad bij de Industriële Eigendom 1956, no. 5, p. 54 - 61

applications be made public within eight months after completion of initial searching (which then took about 18 months), but in any event not earlier than 18 months after the date of filing or priority. The maximum term for making public patent applications would accordingly be 26 (18+8) months. It was also suggested that, prior to deciding on the term for publication, the practices of Germany and the Scandinavian countries in relation to pre-grant publication should be assessed.

7. The elements of the Dutch proposal were referenced by a joint patent law review committee of the Scandinavian (Nordic) countries in 1961. The Nordic report³ references an 18 month pre-grant publication period in The Netherlands (as opposed to the proposed 26 month publication period). Reference to the Dutch proposal was also made in the final report.⁴ After discussions between (committees of) The Netherlands, Germany and the Nordic countries, The Netherlands was the first country to include the 18 month term in its patent law in 1964.⁵ By the time of the WIPO conference in 1970, the 18 month term had been introduced into the patent laws of 7 European countries (The Netherlands, Denmark, Finland, Norway, Sweden, Germany and France).

Europe

8. Under the European Patent Convention (the "EPC"), (European) patent applications are published (as soon as possible) after expiry of 18 months from the filing or priority date. The applicant, however, may request early publication so that its application is part of the state of the art (this is relevant because under the EPC, patent applications filed but not published may comprise 'fictional' prior art that can only be invoked to attack the novelty of a patent).
9. Under the EPC, the publication of a patent application also confers 'provisional' protection, which may not be less than that which the laws of the respective European Member State attaches to the compulsory publication of unexamined national patent applications (including the right to claim reasonable compensation from any party that makes use of the invention such that they would be liable under national law for infringing a national patent).

³ Preliminaer betenkning angående nordisk patentlovgivning. Avgitt av samarbeidende danske, finske, norske og svenske komitéer. (December 1961) p. 219

⁴ Betenkning angående nordisk patentlovgivning: Avgitt av samarbeidende danske, finske, norske og svenske komitéer. (NU 1963:6) p. 246 and p. 248-249.

⁵ Dutch Patent Act 1910, Article 22C (Stb. 1963, 260)

North America

10. Under the laws of the United States, pending utility applications are published promptly after the expiration of a period of 18 months from the earliest priority date unless subject to a secrecy order. The applicant can request that the utility application be published earlier than the 18 month date. The applicant can also file a non-publication request if "the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at 18 months after filing". Provisional and design applications are not published, but the provisional application is publicly available via the USPTO website after any utility application claiming priority from the provisional is published.
11. In the United States, the applicant is entitled to "provisional rights" based on the published patent application. Specifically, these "provisional rights" provide the applicant with a reasonable royalty for infringement of the published claims if: (i) the invention as claimed in the resulting patent is "substantially identical" to the invention as claimed in the published patent application; and (ii) the infringer had "actual notice" of the published patent application and, where this right arises from an international application that was published in a language other than English, a translation of the international application into English.
12. In Canada, pending applications are published after a confidentiality period of 18 months from the earliest priority date. The applicant can request early publication. An application will not be published if withdrawn by 16 months of the earliest priority date. The Minister of National Defense can request an application or patent to remain secret in the public interest (similar provisions are found in the United States and various other countries). Unpublished domestic applications are only considered for novelty, not obviousness. A person is liable to pay reasonable compensation to a patent owner for acts from the date of publication that would have constituted an infringement if the patent had been granted on the date of publication. The courts have clarified that the issued claims must be essentially identical to the claims of the published application, and reasonable compensation is a reasonable royalty.

Asia

13. In Japan and Korea, for example, procedures have been adopted to address delay in examination of patent applications, such as patent applications that have not been made public for long term, redundant researches and investments by industries and destabilized industrial activities. A patent

application is published after expiry of 18 months from the filing or priority date. It is said that the 18 month term was decided upon for equal treatment of both domestic and foreign applicants taking into consideration a 12 month priority period, a 4 month period for the submission of priority documents and a 2 month period for the preparation of publication. The applicant may request earlier publication. Patent applications relating to defense matters filed under the US-JP bilateral agreement remain secret until cancellation of secrecy. Further, parts of patent applications that contravene public morality or public order are excluded from publication.

Latin America

14. In the Andean legislation (Decision 486), applicable in Peru, Bolivia, Colombia and Ecuador for example, the term for publication of a patent application is set out in Article 40: within 18 months after the filing date in the Member Country concerned or, where priority is claimed, after the date of application, the file assumes a public nature and shall be open for consultation. The competent national office must order the publication of the application. The applicant may in any event request publication of the application at any time after the examination has been concluded, in which case, the competent national office must order publication. An application filed and not made public is kept confidential and may not be consulted other than by the applicant or persons authorized by the applicant.

Previous work

AIPPI

15. Publication of patent applications was studied in Q89 (Amsterdam ExCo of 1989), which is part of the series of resolutions related to a WIPO draft Patent Law Treaty concerning the harmonization of substantive provisions of patent law that never became final. Article 6 of the draft Patent Law Treaty *inter alia* provided that patent applications would automatically be made public 18 months after the date of filing of the application or the priority date.
16. In the resolution on Q89, it was set out that AIPPI (in general) supported the WIPO draft. AIPPI also resolved that:
 - the requirement of publication should also be considered fulfilled if the application is 'laid open' for public inspection;
 - publication should not occur if there is no intent by the applicant to pursue the application;

- no publication should occur if the application is finally rejected without the possibility of an appeal;
- there should be a specific point in time up to which the applicant can withdraw its application without it being published, which period for withdrawal should be as long as possible (but no shorter than 17 months after filing or after the priority date);
- any deviations from these principles in relation to "national security" should be limited;
- if a patent is granted prior to the expiration of 18 months, the original application should be laid open for public inspection;
- in case of an internal priority or a continuation-in-part (hereinafter referred to as a "CIP") filed in time for publication at the expiration of 18 months, the completed, modified application should be published and the file should be made available for public inspection, so that third parties have access to the original application;
- in the case of a continuation in part (CIP) filed after the expiration of 18 months or so shortly before that it can no longer be taken into consideration, publication of the CIP should occur as soon as possible;
- rules should also be in place in relation to the publication of divisional applications; and
- information obtainable from the respective patent office should be possible by any technical means, but for the convenience of small- and medium-sized companies at least also on paper.

Objectives and Principles of the B+ Sub-Group

17. On 27 May 2015, the B+ Sub-Group (comprising representatives from the European Patent Office and the Patent Offices of Canada, Denmark, Germany, Japan, Korea, Spain and the United States of America) presented its Objectives and Principles, *inter alia* in relation to the issue of the publication of applications. In its report, the B+ Sub-Group stated the following principles:
 - there should be a clear time limit by which information about a potentially patented invention will be made public;

- the timing of publication should provide for prompt dissemination of knowledge from all pending patent applications wherever filed;
 - pending patent applications should be published promptly after the expiry of a globally agreed timeframe;
 - the timeframe should balance the interests of inventors/applicants and those of third parties;
 - Patent offices should be able to delay or suppress publication of a pending application in exceptional circumstances; and
 - applicants should be able to request publication of an application prior to the globally agreed timeframe if they wish, as long as the requirements for publication under the applicable law are met.
18. The report noted that 18 months is an appropriate timeframe and that patent offices should be able to delay publication of a pending application beyond 18 months, or suppress publication of information within an application, in exceptional circumstances, namely (i) if publication would be prejudicial to public order, morality, or national security, (ii) if the application contains offensive or disparaging material and/or (iii) if a court order specifies that an application should not be published.
 19. In its comments on these Objectives and Principles, AIPPI agreed with the above principles, noting that AIPPI in Q89 supported a proposal for extending the time limit for publication to 24 months. AIPPI also stated that publication should not occur when an application has lapsed due to failure to prosecute in a timely fashion (without a pending application to resume prosecution) or when the application is rejected (and no appeal of the decision to reject is pending). AIPPI also stated its opinion that the patent system should not be an instrument for censorship and therefore questioned the use of vague concepts such as “morality” or “offensive or disparaging” material as the basis for suppressing the content of a patent application.

Tegernsee Group

20. During the second meeting of the “Tegernsee Group,” attended by heads of offices and representatives from Denmark, France, Germany, Japan, the UK, the USA and the EPO in April, 2011, the publication of patent applications was one of four topics identified as being key to harmonization (along with the grace period, prior user rights, and the treatment of conflicting applications). The Tegernsee Group mandated the Tegernsee experts group

to prepare reports on each of these topics. The report on 18-month publication was published in September, 2012, and is available on the EPO website. The third meeting of the Tegernsee Group took place in October, 2012, during which it was agreed that the next step in the process would be to conduct broad surveys of stakeholders in each region. In September, 2013, at its fourth meeting, the Tegernsee Group approved the Reports on the Tegernsee User Consultation drawn up by the individual delegations. In April, 2014, the Tegernsee Group approved the Tegernsee Final Consolidated Report, concluding the work cycle of the Tegernsee Experts on the four topics including 18-month publication. The Final Consolidated Report is available on the EPO website.

21. In its report of 8 April 2014, the Tegernsee Group presented, *inter alia*, the following conclusions:

- the majority of the respondents agree that there should be no opt-out exception to the 18-month publication of applications and have not been negatively affected as a result of another party opting out;
- a large majority of the European and U.S. respondents agreed that if a jurisdiction requires publication at 18 months, the competent authority should also be required to provide the applicant with search and/or examination results sufficiently in advance of publication to allow the applicant to decide whether or not to withdraw the application prior to publication; and
- the majority of respondents also agree that 18 months is a reasonable period of secrecy from the standpoint of applicants.

Questions

Groups are invited to answer the following questions under their national laws:

I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

Pursuant to Art 11 of the Law of Patents, Layout Designs of Integrated Circuits, Plant Varieties, and Industrial Designs, the Patent Office shall publish applications for patents on invention and plant varieties within eighteen months from the date of filing the application.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

No. Publication is made following payment of the specified fees. The Patent Office will notify the applicant once the formality examination is complete to pay the specified fees within 3 months from said notification.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

The law does not provision for this distinction and the filing date is considered to be the filing date when the application is filed or entered in Saudi Arabia.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

It is possible for the applicant to withdraw a patent application at any point prior to the end of the period for paying the specified fees. In case the applicant does not withdraw the application and fails to pay the fees, the application will be rejected and said rejection will be published in the Gazette. (Art. 35(1) of the implementing regulations)

5. What parts of a pending patent application are published?

The first page of the application for patents which includes the bibliography and title.

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

No.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

No.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

There are no provisions in the law or any mechanisms in the regulations for requesting 'early publication'.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

Withdrawal of an application is the only possible route for non-publication.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

As stated in point 4 above, a rejected application will be published unless actively withdrawn.

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

Saudi Arabia does not have a system of CON or CIP. With regards to divisional applications, the same laws and regulations apply as to the parent patent application and as discussed herein above.

II. Policy considerations and proposals for improvements to your current system

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

Not applicable as this law and practice are already in place.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

Yes. As Saudi develops and different local industries expand their offerings, an early publication would dissuade such companies from investing and developing new products which may eventually be protected by a patent.

Early publication could also result in licensing opportunities in Saudi Arabia by local companies, especially for products or processes where know how and quality are requisite.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

No; this should be at the discretion of the patent owner.

15. Should there be a right for the patentee to withdraw the application before publication?

Yes, this should always be the case.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

- a. with respect to the patentee's own subsequent patent applications; and
- b. with respect to third party patent applications?

Since the application is not made public, then there should not be consequences, on either party. It will be the responsibility of the patentee to maintain any trade secret which may relate to the withdrawn application.

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

No. The withdrawal should be for reasons other than the final decision of the examining authority.

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:
- a. the patent office to provide the results of its initial assessment?;
 - b. the applicant to decide whether to withdraw the application?; and
 - c. the application to be published?

The patent office should provide its initial assessment within an acceptable time frame and consistently so, i.e. 16-20 months post filing. The applicant should have the ability to withdraw at any time regardless of the stage of prosecution, up to the issuance of the decision. To be consistent with international practice, the patent office should publish around 18 months from the earliest claimed priority.

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:
- a. on the initiative of the patentee;
 - b. on the initiative of the patent office; or
 - c. on the initiative of third parties (such as other governmental agencies)?

Yes; on the initiative of the patentee if withdrawal is requested prior to publication and on the initiative of governmental agencies which might perceive a threat to public morality or national security.

The patent office should not be able to prevent publication unless instructed by the applicant or by one of the Ministries.

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

Such a question should be stated clearly in the implementing regulations and in case of exceptions or deviations; jurisprudence should develop around this topic for good legal practices.

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

No. In the case of Saudi Arabia, since divisional applications claim priority from the same date as the parent application, then publication of a divisional

should be scheduled for the next issue of the Gazette.

22. What proposals would you make to improve your current system?

Amend the current law and related regulations to provision for:

- *Publications to be made at a fixed period from the earliest priority;*
- *Enable early publications at the request of the patentee;*
- *Allow a request for accelerated examination (such as PPH);*

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

Such practice would certainly benefit the local applicants who utilize the Saudi Arabia Patent Office as a first filing office. This would help secure and protect their business as well as help promote further innovation, investment and development.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

Yes. The applicant should have the option to opt out based on new teachings uncovered between the filing date and the publication date.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

Exceptional circumstances should be defined as stated by the law and the examples provided in the question itself. If an invention is subsequently deemed to go against one of these definitions, then the applicant should have the possibility of maintaining a trade secret and if the invention cannot be used in the country of origin, at least it may be developed for use in countries where the exceptional circumstances are different.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

If the applicant is to have an opportunity to withdraw and prevent publication depending on the search or patentability opinion, or as a result of the aforementioned exceptional circumstances, then it would be more advantageous to define the publication period on the basis of the issuance of the search/opinion (i.e. 3 months from issuance of the search report); but possibly put a plateau (i.e. 24 months from priority) to force patent offices to perform search and/or examination early on and not delay.

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

Since except for the first filing, all subsequent filings of an application are based on the first filing which they claim as priority, and since most patent offices tend to collect the same publicly disclosed information when performing prior art searches, it would be both economical and efficient to harmonize examination processes and allow applicants to align the allowed claims from one country for all applications in the same patent family without having to undergo country level examinations. A due diligence process should still be required in order to ensure compliance with each country's laws, but novelty and inventiveness should no longer be an issue of these have been overcome in at least one country. Accordingly, when it comes to publication, the issue becomes moot as one publication in one country would be the equivalent of country specific publications. Except in cases where the applicant withdrew the first filing, then the invention becomes part of the prior art and amenable to further development anywhere where such development is sought.

Procedure

It would be most helpful if the National Groups would fill out the Questionnaire and send in their answers to the General Secretariat of AIPPI (StandingCommittees@aippi.org) by 3 August 2016.

For inquiries, please contact either of the following members of the Standing Committee on Patents.

Tim Iserief

NautaDutilh N.V.
Strawinskylaan 1999
1077XV Amsterdam
The Netherlands
T +31 20 7171 460
F +31 20 7171 335

E: tim.iserief@nautadutilh.com

Andrew Meunier

Meunier Carlin & Curfman LLC
999 Peachtree Street NE, Suite 1300
Atlanta, GA 30309
United States of America
T + 1 404 645 7700
F + 1 404 645 7707

E: dmeunier@mcciplaw.com