



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

- 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.

The Australian Patents Act 1990 and the Australian Patents Regulations 1991 establish the law and rules surrounding publication of patent applications. Chapter 4 of the Australian Patents Act 1990 along with Chapter 4 of the Patents Regulations 1991 set out the basis on which patent applications are published. These Chapters describe the information that is required to be published along with the timing for publication.
- 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?

A standard Australian patent application is automatically published 18 months after the earliest priority date of the application. Publication is not necessarily exactly 18 months after the earliest priority date, but coincides with the next Official Journal issued by the Australian Patent Office after the 18 month period has expired. Automatic publication takes place unless a patent application is withdrawn prior to publication (see item 4 below), or if an early request for publication is not received. The great majority of Australian patent applications are published through automatic publication 18 months after their earliest priority date.

A standard Australian patent application is published if it is accepted prior to the deadline for automatic publication.

An innovation patent application is published soon after grant. Because an innovation patent application is granted soon after filing, publication of the granted innovation patent occurs soon after filing and normally within six weeks of filing.

The requirements to effect publication are that the required information is available at the Australian Patent Office (as set out in Chapters 4 of the Australian Patents Act 1990 and the Patents Regulations 1991) and includes details required at filing and the patent specification.
- 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 timing of publication is dependent on the earliest priority date of a patent application. Accordingly, if a patent application claims priority from or the benefit on an earlier application, the timing of automatic publication will be determined on the basis of that claim for priority or benefit.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?
An applicant can withdraw a patent application without it being published if the application for withdrawal is made prior to the mechanism of publication being commenced. Past experience indicates that an application for withdrawal is required at least three weeks in advance of the automatic 18 month publication date to ensure the publication does not take place. An application for withdrawal can be made closer to the automatic 18 month publication date, but the likelihood of the patent application not being published will be reduced.

5. What parts of a pending patent application are published?
The parts of the pending application that are published included the bibliographic data, the full specification including description, claims and drawings, and an abstract. Upon publication of a patent application, any associated provisional application (an Australian priority application), will also be published.

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?
Publication of a pending patent application does not give rise to any provisional rights in Australia except that section 57(1) provides that a patent applicant has the same rights to publication as would apply if a patent had been granted on the application at the date of publication. This means that in infringement proceedings, the infringement can be found back to the date of publication of the patent application but not earlier.

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?
An unpublished pending patent application does not give rise to provisional rights in Australia except in terms of securing a priority date.

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?
Early publication is allowed in Australia upon a request made by the patent applicant. In order for publication to be made, all of the information that is

required to be published (as defined in Regulation 4.1), must be available to the Australian Patent Office.

A request for early publication is made by writing to the Australian Patent Office and simply requests that publication proceed.

The effect of early publication is to provide the rights identified in Item 6 above in relation to infringement proceedings.

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?
Section 173, 174 and 175 cover non-publication of information relating to a patent application. Section 173 limits the category of patent applications that can remain unpublished to those that the Commissioner considers necessary to keep secret in the interests of the defense of the Commonwealth of Australia.

Once the Commissioner has determined that a patent application should not be published, the relevant Minister will produce a written Order to prohibit or restrict the publication. That Order can remain in place for any period of time and prevents the patent application from being granted. The patent application can proceed through examination to the point at which it is accepted, but no further while the Order remains in place.

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?
A lapsed, abandoned or withdrawn patent application will not be published if a request to withdraw the patent application is made at least three weeks in advance of the automatic publication period (see Item 4 above).

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?
Divisional applications made in Australia are published soon after filing as long as the parent is already published.

Filing (and therefore) publication of a divisional innovation patent application cannot occur if the innovation patent application is filed from an international PCT patent application which itself is not published. In this case, the innovation patent application will be rejected unless the PCT specification is to be published very shortly (within two months) or a request for early publication of the PCT application is made (again publication must occur within two months).

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?

Yes. Based on the current global patent system, the requirement for automatic publication of pending applications is appropriate and the 18 months period from the initial filing or earliest priority claim should apply. However, if globally there was an ability to dramatically reduce the period in which applications remained pending, an automatic publication deadline might be abolished. The **Australian Group** is of the view that the older patents systems that did not publish until a patent was granted provided a fairer outcome to a patent applicant, because the subject matter of the application was only published if a monopoly right was granted. However, because examination delays in some jurisdictions are upwards of 4 years, maintaining an application unpublished for that time would be undesirable in relation to the effect it could have on competition.

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

Yes. The **Australian Group** is of the view that the patent applicant should have the right to request early application as a matter of choice and does not believe that there should be limited prescribed circumstances under which a patent applicant should be allowed to request early publication.

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. Only those applications that the patent applicant wishes to publish early should be published early.

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

Yes.

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

The **Australian Group** considers that there should be no consequence of the

withdrawal of one patent application on subsequent patent applications for the same patent applicant.

b. with respect to third party patent applications?

The **Australian Group** considers that a withdrawn patent application should have no consequences in relation to a third party patent 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 **Australian Group** is of the view that the Patent Office should have the facility to offer to conduct an initial assessment, but only on request by the patent applicant and the patent applicant should have to pay a fee for the assessment to be made.

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?;

Ideally patent offices would provide an initial assessment of the validity of a patent application prior to its publication. This would allow the applicant to withdraw the application prior to publication if required. However, with respect to the PCT procedure this is impractical as national offices do not receive for examination a patent application until well after the 18 months publication date. Also, the initial assessment made by the PCT Receiving Office, which is often made prior to the publication date, is not binding on any national patent offices.

With respect to Convention patent applications, national offices could provide an initial assessment prior to the current 18 month publication date, but only if they were consistently able to make that assessment within a six month period after the Convention filing. For most patent offices, this would currently be too onerous a requirement.

b. the applicant to decide whether to withdraw the application?; and

The **Australian Group** is of the view that the appropriate time limit for the applicant to decide whether to withdraw an application is prior to the automatic publication date currently in place. Under the current system, it is incumbent on the patent applicant to make its own assessment of the likelihood of patentability prior to the publication date and to make its own decision as to whether to allow the application to be published or not.

c. the application to be published?

As indicated above, the **Australian Group** is of the view that the current 18 month automatic publication date which is calculated from the initial filing date or earliest priority claim is appropriate.

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;

The competing motivations for publishing or not publishing appear on the one hand to relate to the ability for retrospective compensation back to the publication date, and on the other hand to the competitive advantage gained by maintaining a patent application unpublished. Given that patent applicants will exercise their right if given to allow or prevent publication based on their own commercial needs at the time, it seems inappropriate to allow the patent applicant to decide on whether an application is to be published or not. The **Australian Group** considers that in most cases, if the patent applicant was allowed to prevent publication for some period, most patent applicants would take that option. Accordingly, the **Australian Group** does not support providing the patentee with the initiative to delay or prevent automatic publication.

b. on the initiative of the patent office; or

c. on the initiative of third parties (such as other governmental agencies)?

The **Australian Group** is of the view that if either the Patent Office or relevant government agencies assess that a patent application is of sufficient sensitivity, based perhaps on national security or national health, that an Order should be available to maintain the application unpublished. The **Australian Group** is of the view however, that the patent applicant should be allowed to be heard in relation to a proposal to maintain a patent application unpublished, and should be able to seek compensation where any infringement of the patent applicant's rights occur and cannot be remedied given the unpublished state of the patent application.

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?
Ultimately it should be up to the government and/or Courts whether an exception is applied.
21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?
No.
22. What proposals would you make to improve your current system?

The **Australian Group** is of the view that patent applications in general should be published at a point during their pendency and that unless requested early, publication should be automatic and not interfered with by the patent applicant. The **Australian Group** notes that under older patent systems whereby publication only occurred upon patent grant (the previous US and New Zealand systems for example), is a better system given that a patent applicant has certainty that the patent right will be granted prior to disclosing the invention of the patent application globally, but in the current circumstances, the time frames for examination globally would not make this an appropriate system to adopt.

The current system of publication 18 months after the initial filing or the earliest priority claim is therefore supported by the **Australian Group** along with early publication requested by the patent applicant.

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?

Patent Offices should be in a position to provide examination results or at least search results prior to publication in the jurisdiction in which an initial filing is made. The **Australian Group** is of the view that this should be an option arrangement whereby the patent applicant will incur the cost for the results which would allow applicants who are not interested in receiving results early to proceed under the normal examination provisions whereby examination generally occurs well after publication has occurred.

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

Yes. The applicant should be able to withdraw an application prior to publication on any basis they see fit.

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 relate to national security and order and would include issues relating to public health.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?
Yes.
27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

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.

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