



Standing Committee on Patents

Questionnaire on the Publication of Patent Applications

Introduction

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.

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.

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

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.

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

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

¹ Available at

patent law revision committee in The Netherlands as a likely origin of the 18 month publication term. This report² suggested that patent 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.

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

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).

Under the EPC, the publication of a patent application also confers 'provisional'

<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

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)

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).

North America

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.

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.

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

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

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

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.

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

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.

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.

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

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.

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 Article 55 of the **Decree Law Numbered 551 (hereinafter referred as DL 551)**, “the application shall be open to public inspection upon its publication, in accordance with the provisions of the Regulation, **after the elapsing of a period of eighteen months from the date of filing of the application or, if any, from the date of the priority claimed.**”

However, according to Article 55/3, the applicant has a right to request “**early publication**”, even when the period of eighteen months mentioned has not expired.

In addition, according to Article 57/7, if an application for patent had not been published earlier, at the time when the Search Report is established, the Search Report shall be published together with the application for patent.

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?

A. No.

Pursuant to Article 55 of the DL 551, “the application is published subsequent to the conclusion by the Institute of the examination pertaining to the compliance with the formal requirements as of the provisions of Article 54 and subsequent to the filing, according to Article 56, **of the request for conducting the Search on the State-of-the-Art.**”

Pursuant to Article 56 of the Decree, within 15 months from the date of filing of the application or from the date of priority, if any, the applicant shall file before the Institute the request to conduct the Search on the State-of-the-Art and shall pay the relevant fee.

Hence, it can be concluded that there three requirements which shall be fulfilled to effect publication.

1. The completion of the formal examination
2. The request to conduct State of the Art search report within 15 months
3. Paying the appropriate fee

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?

Pursuant to Article 55, the application shall be open to public inspection upon its publication, after the elapsing of a period of eighteen months from the date of the priority claimed.

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

Before the elapsing of a period of eighteen months from the date of filing of the application or, if any, from the date of the priority claimed, if early application is not requested.

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

The documents published include the description, claim(s), drawing (s) and abstract.

In addition, Pursuant to Article 57, paragraph 5, "Following its notification to the applicant, **the Search Report shall be published by the Institute**, after the elapsing of a period of three-months as recognized to the applicant under the provision of Article 59. "

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?

Yes.

Pursuant to Article 82 of the DL 551 “The protection accorded to the right holders of patents granted under the provisions of this present Decree-Law shall be accorded likewise to the applicant of an application for patent as from the date of publication of the application for patent in the relevant bulletin and for as long as said application remains in the effect.”

In addition, according to Article 136, paragraph 3, “where the application for patent is published in accordance to Article 55 of this present Decree-Law, **the applicant is entitled to institute before the courts, civil and criminal, proceedings, on grounds of infringement of the invention.**” Hence, the proprietor of the published patent application entitled to appeal for precautionary measures for preventing the continued infringement of rights, pursuant to Article 137/l-e and Article 151 of the DL 551.

However, the court shall not decide on the validity of the infringement claims prior to the publication of the notices on the bulletin regarding the granted patent.

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?

Yes.

Pursuant to Article 82, Paragraph 2, “Where the person making use, without the permission of an applicant for patent, of the invention that is the subject matter of the application for patent, **is informed of the (existence of) application for patent or of the scope of said application for patent, the protection shall be valid for the period preceding the date of publication of the application for patent.**”

According to Article 136 Paragraph 3, “**Where the infringer is notified of the existence of the application or of its scope, the application needs not to have been published. Where the court rules that the infringer is in bad faith, the infringement shall be deemed to have existed even prior to the publication.**”

Hence, the proprietor of the unpublished pending patent application entitled to appeal for precautionary measures, as well, for preventing the continued infringement of rights, pursuant to Article 137/I-e and Article 151 of the Decree Law.

However, the court shall not decide on the validity of the infringement claims prior to the publication of the notices on the bulletin regarding the granted patent.

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?

Yes.

Pursuant to Article 55, Paragraph 3, "At the request of the applicant, the application is published in accordance with the conditions set forth in this present Article, even when the period of eighteen months mentioned under paragraph one of this present Article has not expired. " Moreover, pursuant to Article 56, paragraph 1, the application must fulfill the formal requirements, the request for conducting the Search on the State-of-the- Art must be submitted in written to the Institute, and the relevant fee must be paid.

Pursuant to Article 82 of the DL 551, the protection accorded to the right holders of patents granted under the provisions of this present Decree-Law shall be accorded likewise **to the applicant of an application for patent as from the date of publication of the application for patent in the relevant bulletin and for as long as said application remains in the effect. Hence, the right holders can benefit from the rights conferred by the registration after the publication of the patent application.**

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?

The Turkish Law contains non-publication only for the patents that are decided to keep secret. Turkish Patent Institute is competent to decide whether it should remain confidential or not.

Pursuant to Article 125 and 126 of DL 551, the contents of an application for patent shall be kept secret, for a time-period of two months, as from the date of filing of the

application unless the Institute decides to disclose same earlier. if the subject matter of the application is of importance for national defense.

In other words, The Turkish Law does not contain any rule concerning a pending patent application to remain confidential at the request of the applicant who does not wish to seek patent protection. However, if the files concerning applications for patent have been refused or withdrawn before publication, third parties shall not inspect the file so the application may remain confidential in the case of refuse or withdrawn.

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?

Not necessarily.

If the right holder lapses, abandons or withdraws the patent application before **the elapsing of a period of eighteen months from the date of filing of the application or, if any, from the date of the priority claimed**, the application will not be published..

However, third parties who can prove that the applicant intends to enforce against them the rights originating from his application for patent, may inspect the file of the application for patent, not yet published, without the consent of the applicant.

It is automatic since if the requirements are not fulfilled, the application will not be published. The applicant is not entitled to request non-publication.

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

Turkish law does not provide for continuation or continuation-in-part applications.

According to Article 67, paragraph 3, "Where a divisional application filed according to Article 45, an application filed anew according to Article 12 or an application converted according to Article 65 is published, **the file of the original application may**

be inspected by third parties before its publication and without the applicant's consent.”

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. The deadline requirement for automatic publication will give a chance to applicant to decide on the publication to pursue the application or to abandon/withdraw the application.

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

Yes. The applicant may pay relevant fee for "early publication", and obtain provisional protection conferred from the publication earlier. In addition, an earlier publication provides a stronger prior art effect for inventive step.

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.

The applicant can have the liberty to decide which application deriving from the same priority is subject to be published earlier.

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

Yes. Since the applicant should be able to maintain his rights in newly discovered technology.

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?

- a. Where an application for patent that has not been published is withdrawn, the first applicant may file a new an application for patent or for the improved one.
- b. An unpublished earlier application should be regarded as novelty destroying with respect to the 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?

If an opt-out option is not provided for the applicants, prior search results and examination results may be provided before making publication of pending patent applications **after the elapsing of a period of eighteen months from the date of filing of the application.**

Moreover, if a patent is decided to be withdrawn before publication, generally it is done even before the search procedure has been started in order to take back the search fee in EPC. There can be such a procedure the patent office can provide and such an assessment should be open to applicant's choice . It shouldn't be a must.

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?

They can be harmonized with the EPC time limits.

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.

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

Patent office may decide but should be on the side of patentee.

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

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

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?

Yes. If an opt-out option is not provided for the applicants, prior search results and examination results should be provided before the publication of pending patent applications at 18 months after the initial application filing is done.

24. Should there be any exception to publication of applications, for example by

the applicant's opt-out?

Yes. Since new technological innovations are emerged to our world in a short span of time, the applicants should have a right to decide whether pursue their patent applications or withdraw their patent applications to protect the contents claimed in their applications as trade secrets.

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

Although 18 months is accepted to be a reasonable period of time for both the inventor and the third parties, to make an assessment whether to pursue the application or to withdraw or abandon it and to wait to obtain information about a new technology, respectively, technologies that are stuck in examination backlogs may provide competitors the opportunity to copy or design when the application is still pending.

We believe that publication period may be shorter than 18 months to comply with new technologies.

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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