



UNITED STATES

Answer to Questionnaire on the Publication of Patent Applications

Prepared by: Andrew Meunier, Raymond Moser, and Daniel Brownstone

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

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

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.

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).

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)

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.

Under 35 U.S.C. § 122, 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. *Id.* The applicant can also file a non-publication request at the time of filing the application 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.” *Id.* Provisional and design applications are not published, *id.*, but the provisional application is publicly available via the USPTO website after any utility application claiming priority from the provisional is published.

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?

Yes, if a non-publication request has not been filed, publication occurs automatically in the US. It occurs on the Thursday after the expiration of the 18 month period from the earliest priority date. For applications filed after or near the 18 month period from the earliest priority date, it is noted that the publication process takes approximately 14 weeks and does not begin until the filing fee has been paid.

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?

Yes; the timing of publication is based on the earliest priority date.

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

An applicant can expressly abandon an application to avoid publication if a proper request for express abandonment is received by the U.S.

Patent and Trademark Office more than four weeks prior to the projected date of publication.

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

The complete application is published including the abstract, specification and claims.

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?

Under 35 U.S.C. § 154, 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, had a translation of the international application into English.

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?

Yes. The applicant has to pay a fee and file a request for early publication. The publication process takes approximately 14 weeks and does not begin until the filing fee has been paid.

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?

Yes, 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." 35 U.S.C. § 122. The applicant can file a non-publication request at the time of filing the application. As noted above, design and provisional applications are not published.

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?

If the filing fee was paid, a lapsed or abandoned patent application will publish unless the applicant expressly abandons the application more than four weeks prior to the projected date of publication as described in Question 4.

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

Continuation, continuation-in-part and divisional applications are published as regular utility applications on the Thursday after the expiration of the 18 month period from the earliest priority date. However, as these application are often filed after the 18 month period from the earliest priority date, publication generally occurs approximately 14 weeks after the filing fee has been paid.

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, and this is already the case under U.S. law.

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

Yes, and this is already the case under U.S. law. Consistent with U.S. law, it should be accompanied by an appropriate fee.

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; each application deriving the same priority application should publish early only upon the submission of a request for publication for a particular application and payment of a fee.

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

Yes, and U.S. law allows an applicant to withdraw an application before publication.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:
- with respect to the patentee's own subsequent patent applications; and
 - with respect to third party patent applications?

Under U.S. law, withdrawal from publication is the result of express abandonment so it has an effect on the particular application of the patentee and should not affect the patentee's own subsequent patent applications. An application that is withdrawn prior to publication is not prior art to third party patent applications.

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?

It should not be a requirement; however, the U.S. Patent and Trademark Office should make every effort to provide search and examination results at the time of first publication.

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:
- the patent office to provide the results of its initial assessment? **With reasonable dispatch and desirably before 18 months;**
 - the applicant to decide whether to withdraw the application? **Anytime prior to the time of publication as long as sufficient time is provided to the patent office to prevent publication;** and
 - the application to be published? **18 months**
19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:
- on the initiative of the patentee; **U.S. law allows for the applicant to request non-publication as long as the applicant has no intention of filing the application in another country or under a multilateral international agreement. However, some U.S. organizations, such as AIPLA support in principle removing this exception.**
 - on the initiative of the patent office; or **Yes; and U.S. law allows the patent office not to publish an application where the filing fee has not been paid.**
 - on the initiative of third parties (such as other governmental agencies)? **Yes; U.S. law allows a government defense agency to notify the Commissioner for Patents if publication would be detrimental to national security and the Commissioner for Patents will issue a secrecy**

order to the application.

20. If your answer to question 19 is yes, who should decide on whether such exception is applied? **It should be decided as provided in Question 19.**

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

No; U.S. law requires these applications to be published in the same manner as utility applications.

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

None.

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 required to provide search and examination results with reasonable dispatch to provide clarification of rights in a reasonable time period and should make every effort to provide the applicant with search and examination results in advance of publication.

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

As noted in our answer to Question 19, some U.S. organizations such as AIPLA have supported in principle the removal of certain exceptions to the automatic publication of applications and such a position may be desirable in the interest of harmonization.

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?

Each country should promulgate its own rules such as national security for determining when exceptional circumstances dictate that an application should not be published.

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

18 months is an appropriate period.

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

None