



Summary Report

Standing Committee on Patents

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Questionnaire on the Publication of Patent Applications

Introduction

The Standing Committee on Patents has received Reports in response to the above-mentioned questionnaire from the following Groups: Argentina, Australia, Austria, Belarus, Belgium, Bulgaria, Brazil, Chile, China, the Czech Republic, Denmark, Estonia, France, Hungary, India, Indonesia, Italy, Israel, Japan, Malaysia, Mexico, the Netherlands, New Zealand, Panama, Peru, the Philippines, the Republic of Korea, Saudi Arabia, Singapore, South Africa, Sweden, Switzerland, Turkey, the United Kingdom, the United States of America, Ukraine, Uruguay, and Vietnam. All the reports provide a comprehensive overview of the national and regional law and practice on the topic of publication of patent applications.

This Summary Report does not attempt to reproduce the detailed responses given by each Group. If any question arises as to the exact position in a particular jurisdiction, or for a detailed account of any particular answer, reference should be made to the original Reports. See <https://www.aippi.org>.

The answers as reported by the various Groups under their national/regional laws in response to the below questions can be summarized as follows:

Questions

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.

It follows from the Reports that the vast majority of the national/regional legal systems around the world provides (a) statutory provision(s) concerning the publication of patent applications (by publication in a journal/Gazette, e.g. in Australia; by means of the patent file being laid open for public inspection, e.g. in the Netherlands; or both, e.g. in Sweden).

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?

In the majority of the Reports, it is mentioned that publication occurs automatically after lapse of the publication term. In some jurisdictions (e.g. Turkey, Chile, Uruguay, Vietnam, Saudi Arabia, Panama and Romania), there are requirements to be met (e.g. a request for publication must have been submitted or publication fees must have been paid). Many jurisdictions provide that secret patent applications (e.g. in relation to national security, see below) are not published automatically. The Report covering Brazil mentions that due to the workload of its Patent Office, some delays may be expected.

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?

In most jurisdictions encompassed by the Reports, patent applications are made public within a certain term starting from the (earliest) priority date. In e.g. Argentina, South Africa, Chile and Panama, a priority claim does not affect the timing of publication.

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

In many Reports, it is mentioned that there is no specific point in time up to which the applicant can withdraw its application without it being published,

but that the applicant can withdraw before the lapse of the publication term. In some Reports, it is mentioned that the applicant must withdraw at an earlier stage if it wants the application to remain unpublished (e.g. in Belgium: before expiration of 17 months from the filing or priority date; Hungary: ultimately by the 5th day before the expected publication date; in India, ultimately three months prior to the lapse of the 18 month term; in the United States: ultimately 4 weeks prior to the expected publication date; in Estonia, ultimately 16 days before lapse of the 18 month term; in Romania: ultimately one month before the expected publication date; in Switzerland: within 17 months from the filing/priority date. In some Reports, it is stated that there is no set date, but an indication is given based on practice (e.g. at least three weeks prior to the mechanism for publication being commenced in Australia, at least 16 months and 3 weeks from the filing/priority date in the United Kingdom, before the technical preparation for publication or 2-3 months before the expected publication date in the Philippines and ultimately 17 months from the filing/priority date in the Netherlands).

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

The complete application (bibliographical data, description, claims and drawings) is published in many jurisdictions. Other jurisdictions only require certain information to be published (e.g. title, name of the applicant(s) and inventor(s), priority data and/or an abstract). In some Reports, it is mentioned that there is a difference between the information that is published in the Gazette and the information that becomes accessible in the (online) patent file (see e.g. those from Hungary, India, Peru and Romania). In the Philippines, the application is published together with a search document.

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?

This question is answered positively in the majority of the Reports. In several jurisdictions (e.g. the Republic of Korea, Turkey, Japan, the United States of America, the Philippines and the Netherlands), it is mentioned that the alleged infringer must be made aware of the published application (e.g. by enclosing it with a cease and desist letter, or by means of a bailiff notification). In e.g. the Czech Republic, Switzerland, India, Hungary, Sweden, Singapore and New Zealand, enforcement in relation to alleged infringement between filing and the application being published is only possible after grant. In the Israeli report, it is mentioned that the holder of a granted patent may be entitled to retroactive damages. In some of the Reports, it is mentioned that provisional protection on the basis of a published application is not possible (see e.g. those from Saudi Arabia,

Uruguay, Australia, Indonesia and Argentina - although a draft law on this topic may be reconsidered in Argentina in the future).

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?

This question is answered negatively in the majority of the Reports. In Chile, France, Peru, Italy, Turkey, Belgium, Brazil and Estonia however, it is possible to act against alleged infringement of an unpublished application, as long as the other side has been made aware of such application. In the Romanian Report, it is mentioned that the applicant is able to obtain an injunction for the remainder of the prosecution of the patent (subject to a duty to notify the alleged infringer). In the Ukrainian Report, it is set out that the applicant's rights are protected from the filing 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?

It is stated in nearly all Reports that early publication is possible under the respective national/regional laws. In some Reports, it is mentioned that the applicant may choose to do so in order to obtain interim protection and/or for the 'prior art effect' in relation to other applications. In the Reports covering Saudi Arabia and Israel, it is mentioned that the law does not provide for early publication (although in the Israeli Report, it is mentioned that the applicant may request early examination).

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?

In roughly one third of the Reports, it is mentioned that non-publication is not possible (see e.g. those from India, Switzerland, Argentina, Malaysia, Austria, Peru, Uruguay, and Vietnam). In the other Reports, it is mentioned that such is possible under certain conditions (e.g. when national defense/security is at stake, if the applicant provides sufficient reasons, or sometimes more generally on the basis of an order from a governmental body). In the Swedish Report, it is set out that applications for defense-inventions that are to remain confidential cannot be granted. In the United States, non-publication is allowed by request of the applicant 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.

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?

In many Reports, it is mentioned that non-publication is automatic if the application is abandoned or withdrawn (see e.g. those from China, Denmark, Panama, the Czech Republic, Malaysia, Peru, the Republic of Korea, Singapore and New Zealand). In many other Reports, it is mentioned that non-publication occurs when an application is withdrawn within a certain timeframe (i) before the intended date of publication or (ii) within a set period from the priority/filing date (see e.g. those from Japan, Switzerland and Australia) and in some Reports it is explicitly mentioned that such occurs automatically, unless the (technical) process of publication was already initiated or completed (see e.g. those from the United Kingdom, the Philippines and Austria). In the Indian report, it is mentioned that abandoned or lapsed applications will be published, unless a request by the applicant not to publish the application is accepted. It is noted in the Brazilian Report that lapsed, abandoned or withdrawn applications will be published and the applicant cannot request non-publication.

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

Due to the nature of this question, the responses diverge (also given the number of countries involved and the different principles that apply); therefore, reference is made to the various Reports in this respect. It is noted that in many jurisdictions, continuation or continuation-in-part applications do not exist. In several Reports, it is mentioned that divisional applications are generally published as soon as possible after the parent application is published.

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?

In the vast majority of the Reports, it is stated that such a requirement should

indeed be in place and/or that such a mechanism is already in place in the respective jurisdictions.

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

In the vast majority of the Reports, it is stated that such a requirement should indeed be in place and/or that such a mechanism is already in place in the respective jurisdictions.

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?

Some Reports state that this should be the case (see e.g. the Mexican, Estonian, Czech and New Zealand Reports) whereas some state this should not be the case (see e.g. the Danish, Swiss, Ukrainian, Hungarian, Singaporean, Philippine and American Reports). The majority of the National Groups seems to be of the opinion that such should be an option for the applicant and not mandatory (because different applications may contain different subject matter and the applicant should be free to decide what is published early, see e.g. the Chinese and Chilean Reports).

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

In the vast majority of the Reports, it is stated that such a requirement should indeed be in place and/or that such a mechanism is already in place in the respective jurisdictions. Reasons for such a mechanism to be in place are described as the desirability for the applicant to choose whether to obtain a patent or to keep the invention secret (e.g. if there are risks that the application will be dismissed or limited) and usefulness in relation for preventing self-collision (see e.g. the French report).

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?**

In many of the Reports it is stated that subsequent applications (either third party applications or the applicant's own applications) should not be affected

by the withdrawal of an application that has not been published (or otherwise made available to the public), see e.g. the Romanian, American, Brazilian, Chinese, Mexican, Peruvian, Indonesian, Australian, Danish, Philippine and Vietnamese Reports. In the Turkish Report, it is mentioned that an unpublished application should be regarded as novelty destroying in relation to a third party application. The French Report mentions that there should be consequences only in relation to priority.

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?

In roughly half of the Reports, this question is answered positively (see e.g. those from the Dutch, Danish, Italian, Belarus, Estonian, Czech, Indonesian, Chilean, Austrian, Belgian, Philippine (where the search report may be considered such initial assessment) and Peruvian Reports, whereas in the other half of the Reports (see e.g. the Korean, Australian, Ukrainian, Argentinian, Indian and Swiss Reports) it is answered negatively. In the Report covering New Zealand, it is mentioned that this should not necessarily be required because although the information may be useful, as applications are more often withdrawn due to commercial reasons than the likely validity of the patent. In the Report concerning the United Kingdom, it is mentioned that although such a requirement could be desirable for applicants, the balance between the interests of the public and the interests of the applicant may be distorted. The Reports concerning Bulgaria, Japan, Brazil and Mexico note that such a requirement may not be desirable in view of the Patent Offices' workload (possibly jeopardizing the term for publication), whereas the Swedish Report states that such a requirement may be unrealistic in relation to divisional applications and applications that claim priority. The Israeli Report notes that in practice, the applicant does not have the necessary feedback concerning the validity before the end of the publication term. The Report covering the United States mentions this should not be a requirement, but the Patent Office should strive to provide its opinion at the time of publication. In the Report covering Chile, it is mentioned that the patentee should be able to choose whether it would like to receive an opinion on patentability (and not necessarily validity). In Singapore, the applicant is able to request for a search and examination after filing and before the publication of the application, allowing the applicant to establish the patentability of the application before publication.

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?**

Due to the nature of this question, the responses diverge (also given the number of countries involved). In general however, it can be said that it follows from the Reports that the time limit mentioned under (b) should be as long as possible but sufficient time should be provided to the Patent Office to prevent publication. Also, most Reports mention 18 months from the date of priority/filing as an appropriate time limit for an application to be published (c). In relation to the time limit under (a), it is noted that responses were extremely varied, so reference is made to the Group Reports in this regard.

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)?**

National security is frequently mentioned in the Reports as a reason for deviating from the principle of automatic publication. In some Reports (see e.g. those concerning Mexico and the Republic of Korea), public order and morality are also mentioned. In the majority of the Reports, it is stated that governmental bodies (including the respective Patent Offices), government officials (such as Ministers) or the courts (see the Reports covering Australia, Malaysia and Saudi Arabia) should decide on this, while other Reports (see e.g. the Reports covering Panama, Chile and China) state that (also) the applicant should be able to decide on such exceptions. In the Report concerning the United States, it is noted that publication may be deferred until issuance of the patent if the applicant does not have an intention to file in another country or under an international multilateral agreement; however, that some U.S. organizations support removing this exception. The Bulgarian Report mentions that there should be no exceptions at all, referring to legal certainty for third parties.

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

The answers of the Groups are in line with the answers to question 19 as summarized above.

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

Most Reports note that such applications should not be treated differently, and that the term for publication should apply to these applications as well (if such an application is filed after expiration of the term however, publication should occur as soon as possible, see e.g. the Dutch Report). In e.g. the Reports concerning Belarus and India, however, it is stated that there is no need for automatic publication of such applications (since the particulars of the invention have already been disclosed in the initial application).

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

Although many Groups state that they are happy with their systems as they are, *inter alia* the following proposals for improvement were made (categorized):

- there should be a clear indication of the time period until when an application can be withdrawn with prevention of its publication (see the Dutch, Korean and Japanese Reports); withdrawal right up until the day before publication may be helpful but could be difficult from a practical point of view (see the Report covering the United Kingdom);

- for PCT applications entering National Phase which were not published in English, the PCT publication date should be adopted as the local publication date on the submission of the verified English translation of the PCT application upon entry, and there should not be an additional fee for requesting publication of the English translation of the PCT application after entering National Phase (see the report covering Singapore).

- there should be more detailed provisions concerning the provisional protection derived from published application (Chinese Report); the passing of a draft law concerning provisional protection derived from a published application (Argentinian Report);

- retroactive damages should be allowed only if written notice is given to the infringer and the alleged infringement continues beyond a reasonable time after receipt of such notice (Israeli Report).
- enable early publication at the request of the patentee and allow for requests for accelerated examination (Saudi Arabia);
- the novelty report and written should be provided timely so that the applicant can make an informed decision on whether or not to pursue the application before publication thereof (Belgium); and
- the possibility for the applicant to avoid publication (Brazilian Report).

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?

The majority of the Reports answer this question positively. Some of these Reports, however, express concerns in relation to the workload of the Patent Offices. On the other hand, the Chilean Report suggests that Patent Offices could at least issue a preliminary search report before publication, so that the workload of the Patent Offices is reduced (as applications that have no expectation whatsoever of being granted are taken out of the examiner's hands). In the Italian Report, it is proposed to provide the search results and a preliminary assessment on patentability before the priority deadline. The Swedish Report states that such a requirement is unrealistic and proposes other means of hastening search and examination, such as informing the applicants on what may be expected in terms of prosecution time and reliability of search results.

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

Most Groups that answered this question positively, refer to (national) security/safety as a valid exception to the principle of publication, as well as

public order, morality and public health (although less frequently, see e.g. the Bulgarian Report, where these definitions are described as vague, the Israeli Report, where it is stated that use of these definitions is a significant risk of the law becoming arbitrary and unclear and the Australian Report). Otherwise, the majority of the Groups considered that pending applications should be published in order to make third parties aware of the technical contribution to the state of the art in return for possible patent protection.

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?

Many Reports state that these should explicitly be defined (see e.g. the Reports concerning New Zealand and Italy) and/or that the applicability of an exception should be assessed in each case (see e.g. the Reports concerning the Netherlands, Mexico and Belarus). Furthermore, many Reports state that definitions should be interpreted narrowly (see e.g. the French and Danish Reports). The Singaporean Report argues that the exceptional circumstances should not be further defined, as the appropriate definitions may depend on the current social mores and security issues. The Japanese Report mentions that interpretation of the exceptions should be given in accordance with social norms in each country. National considerations are also mentioned in the American, Hungarian and Chinese Reports. The Report concerning the United Kingdom notes that formal rules should not be in place, but that guidance from the Patent Office could be helpful. The Philippine Report states that “exceptional circumstances” should not be given a narrow definition, but the Patent Office should lay down rules on the effect of non-publication, especially if such non-publication is not due to the applicant’s initiative.

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

In the vast majority of the Reports, it is set out that 18 months is an appropriate period. The Bulgarian Group however, notes that this period is too long and makes the procedure slow. In the Turkish Report, it is stated that although the 18 month term is accepted to be reasonable, the publication period may be shorter than 18 months. In the Report covering Saudi Arabia, it is suggested to define the publication period on the basis of issuance of the search/opinion (maintaining a maximum term of 24 months from the priority date), in order to force Patent Offices to perform their examination timely.

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

The Chinese Report suggests to set the date of publication at 18 months throughout the world. Both the Japanese and New Zealand Reports indicate that all countries should adhere to the same term of 18 months. The Japanese Group approves the 18-month period and disapproves a longer term, fearing a delay in examination. The Dutch Group considers that it would be an improvement if there is a harmonized indication of the time period until when an application can be withdrawn with prevention of its publication. The Italian Report states that harmonization of the effects of a published application is desirable in terms of the publication date and the possibility of interim measures. Also the Israeli Report notes that the question whether damages are allowed from the date of publication (and the type of damages) should be harmonized. The Report concerning Panama states that the principle of early publication should be harmonized. The Chilean Report mentions that the complete application (including drawings) should be made public, and not just an abstract from which it is hard to derive the alleged invention. In the Romanian Report, it is noted that easy online access to the patent file would allow an easier transfer of information between applicants and third parties and thus provide transparency. The Report covering Saudi Arabia in general mentions that it would be economical and efficient to harmonize examination processes, as applications (except for the first filing) are based on the first filing and Patent Offices tend to use the same publicly disclosed information in their examination. The Malaysian Group proposes a uniform syntax to distinguish published applications from unpublished applications
