YEARBOOK 2018 / I

2018 AIPPI WORLD CONGRESS – CANCUN
SEPTEMBER 23 - 16, 2018
CONFLICTING PATENT APPLICATIONS
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Study Guidelines

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2018 – Study Question

Conflicting patent applications

Introduction

1) This Study Question concerns patent applications that conflict with earlier-filed but not yet published patent applications by the same or a different applicant (referred to herein as conflicting applications).

2) A first patent application that is filed prior to a second patent application falls within a standard definition of publicly available prior art if it is published prior to the effective filing date of the second patent application. In most jurisdictions, patent applications are published at 18 months from filing or the earliest priority date, meaning that there is an 18-month window during which conflicting applications may arise. If the second patent application is filed within that 18-month window, the examining patent office must determine if and to what extent the first patent application may preclude patentability of the claims in the second patent application. The first patent application in this situation will be referred to herein as secret prior art.

Why AIPPI considers this an important area of study

3) Due to different approaches to treatment of conflicting applications in different jurisdictions, it is a common occurrence that a claim considered patentable in one jurisdiction is unpatentable in another. This leads to situations where multiple patents may be amassed in one country while adequate protection cannot be obtained in another. Multinational inventorship, joint industry and university-industry research collaborations, and globalization in general all further complicate this situation. Thus, this issue is both important and ripe for study by AIPPI.

4) Treatment of secret prior art has been a fixture in prior attempts to harmonise international patent law. Conflicting applications are currently one of the substantive harmonisation topics being considered by the Industry Trilateral\(^1\), and the Group B+ sub-group on patent harmonisation. The Industry Trilateral's June 1, 2017 paper,

\(^1\) Comprising AIPLA, IPO (Intellectual Property Owners Association), BE (Business Europe) and JIPA (Japan Intellectual Property Association).
“Policy and Elements for a Possible Substantive Patent Harmonization Package” is available here:

The Group B+ sub-group’s response to the IT3 paper is available here:

As this work is ongoing at a high level, AIPPI’s input on this issue will be timely and relevant.

Previous work of AIPPI

5) In the Resolution on Q89C - “Self-collision” (Sydney, 1988), in consideration of the draft WIPO treaty on harmonization of patent law, AIPPI resolved in favour of excluding self-collision in cases of at least partial identity of the applicants:

1. In the draft WIPO Treaty on Harmonization of certain provisions in laws for the protection of inventions, there should be a provision in Art. 202 on Prior Effect of Applications which excludes “self-collision” between applications in which there is at least partial identity of the applicants for the respective applications at the date of filing the later application.

2. The Treaty should exclude the possibility of double patenting in these circumstances.

6) In the Resolution on Q126 - "Methods and principles of novelty evaluation in patent law” (Montreal, 1995), AIPPI resolved that secret prior art should be available for novelty purposes under the same standard as applied to published disclosures, but also confirmed the Resolution Q89C that anti-self collision should apply in the case of total or partial identity between the applicants at the time of filing:

5. AIPPI, in recognizing the necessity to avoid double patenting, considers that the disclosure contained in an unpublished earlier patent application, which is later published in the same jurisdiction, should be taken into account for the purpose of determining novelty of an invention claimed in a subsequent patent application. The assessment of novelty in such circumstances should not differ from the general rule with respect to other disclosures that are accessible to the public as defined in Item 4 above.

5.1 AIPPI confirms the Sydney resolution which recommends an express provision for preventing "self-collision" whereby, excluding the possibility of double patenting, the disclosure of the unpublished prior patent application should not affect the novelty of the subsequent patent application where there is total or partial identity between the applicants at the time of filing the subsequent application (Sydney 1988, Question 89C, Yearbook 1988/II).
In the Resolution on Q167 – “Current standards for prior art disclosure in assessing novelty and inventive step requirements” (Lisbon, 2002), AIPPI resolved that secret prior art should be available for novelty only, and not for inventive step:

2. If the filing date or, where applicable, the priority date, of a patent application filed in, or with effect for, a country ("earlier application") is earlier than the filing date or, where applicable, the priority date of another patent application filed in, or with effect for, the same country ("later application") and if the earlier application is made publicly available on or after the filing date, or where applicable, the priority date of the later application, the whole contents of the earlier application excluding the abstract, if any, shall be considered to form part of the prior art with regard only to the novelty of an invention claimed in the later application, but not with regard to the inventive step.

Scope of this Study Question

This Study Question seeks to establish under what conditions secret prior should be applicable to a later-filed application and what standard for patentability should be applied to the claims of the later-filed application. See further definitions and instructions as to the scope of this Study Question under the heading "Questions" on page 5 below.

Discussion

Determining whether secret prior art should preclude patentability of claims of a later-filed patent application raises a number of considerations:

a) If the secret prior art is to be considered applicable as prior art to the later-filed application, what patentability standard should be applied? Is it sufficient if the claims of the later-filed application are novel over the secret prior art, or must they distinguish based on an inventive step or non-obviousness standard? This concept will be referred to herein as distance, where a small distance means that a claim of the later-filed application is only slightly different from the secret prior art and a larger distance indicates more differences between the claim of the later-filed application and the secret prior art. In the case of identical claims in the earlier and later applications (zero distance), the claims may be rejected for “double patenting.” However, where there is at least some distance between the earlier and later claims, a standard is needed to determine when both may be patented.

b) Should all secret prior art be treated equally? Or, should the patentability standard discussed in (a) above be different depending on whether the applicant of the later-filed application is the same as the applicant of the secret prior art?

c) If an earlier application is used as prior art against a later application by the same applicant, and if there is at least some distance between the claims of the earlier and later applications, should the applicant’s right to obtain claims on incremental inventions be limited by a mechanism such as a “terminal
disclaimer” that would require the applications to remain commonly owned and expire on the same date?

d) What portion of the secret prior art is available as prior art? The entire disclosure (i.e., whole contents), or only the claims?

e) If the secret prior art is not available against the same applicant (“anti-self collision”), for what period of time should that be effective (e.g., 12 or 18 months)?

f) If anti-self collision is applied, should there be additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

g) What constitutes the “same applicant”? Can different applicants participating in a joint research project or other mutual research collaboration be considered the “same applicant”? Does it matter if the inventors are different but the applicants are the same, or vice-versa?

h) Should secret prior art filed as an international application under the PCT be prior art as of its effective filing date for all designated offices, or only offices where the application enters national stage?

10) Conflicting applications raise opposing policy considerations. On one hand, protection of incremental inventions is important to promotion of innovation. Thus, it is desirable to provide a reasonable scope of protection for legitimate incremental inventions. It is also generally considered desirable to provide reasonable means for protection of incremental inventions made by different applicant entities jointly working on a common research project. On the other hand, it is desirable to avoid issuance of many very closely related patents as this may result in “patent thickets” including multiple patents with overlapping claims. Such patent thickets, by pure number and density of claims, may create an unreasonable barrier to commercialization of new technology. This is considered to be particularly problematic when the patents are owned by multiple parties, thus requiring a willing licensor to negotiate with multiple parties to license the same or closely related technology or potentially be subject to enforcement actions by multiple patent owners. Accordingly, the six considerations mentioned above, and others, must be carefully balanced to optimize the effectiveness of the patent system.

11) Approaches to treatment of secret prior art and conflicting applications vary greatly from jurisdiction to jurisdiction. Japanese Patent Law Article 29bis provides that if the inventor is the same or the applicant is the same at the time of filing, the later-filed application will not be rejected over the secret prior art. If the applicant and inventor are different, the secret prior art is available as prior art using essentially a novelty plus common general knowledge standard (“enlarged novelty”). In Europe, the secret prior art is always available as prior art to the later-filed application, but for novelty only. In the United States, secret prior art is available for both novelty and non-obviousness for later-filed applications by a different applicant. For the same

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applicant (or applicants having an obligation to assign to the same party at the date of filing, or participating in a joint research project) the secret prior art is not available as prior art ("anti-self collision") but is available only to prevent "same invention-type double patenting" and "obviousness-type double patenting" (based only on the claims, not the whole contents). Obviousness-type double patenting can be overcome by filing a “terminal disclaimer” limiting the term of the later-filed application to the term of the earlier application and committing the patents issuing from the two applications to remain commonly owned.

You are invited to submit a Report addressing the questions below. Please refer to the ‘Protocol for the preparation of Reports’.

Questions

For all of the questions:

a) **secret prior art** means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) **effective filing date** means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1) For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

a) Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

i) If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

ii) If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

b) Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

i) If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

ii) If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?³

³ The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.
iii) If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

c) If the secret prior art is an international application filed designating your jurisdiction:

i) Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

ii) Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

iii) Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

2) For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

a) Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

i) If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

ii) If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

iii) If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

b) Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

i) If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

ii) If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

iii) If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

iv) If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
v) If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

c) If the secret prior art is an international application filed designating your jurisdiction:

i) Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

ii) Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

iii) Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

3) Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

a) Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

☐ same as Question 1

☐ same as Question 2

☐ different (please explain)

b) Same applicant on the dates of filing, no common inventor:

☐ same as Question 1

☐ same as Question 2

☐ different (please explain)

c) Different applicants on the dates of filing, same inventors:

☐ same as Question 1

☐ same as Question 2

☐ different (please explain)

i) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

d) Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
☐ same as Question 1
☐ same as Question 2
☐ different (please explain)

i) Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

ii) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

II. Policy considerations and proposals for improvements of your current law

4) Could any of the following aspects of your Group's current law be improved? If YES, please explain.
   a) The definition of when secret prior art is applicable to defeat patentability of a later-filed application.
   b) The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.
   c) The treatment of international applications as secret prior art.
   d) The treatment of total and partial identity of applicants as it relates to secret prior art.
   e) The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.
   f) Provisions for avoiding self-collision.
   g) Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

5) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6) Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.
7) For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

a) Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?
   i) If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
   ii) If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

b) Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?
   i) If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
   ii) If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?
   iii) If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

c) If the secret prior art is an international application filed designating your jurisdiction:
   i) Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.
   ii) Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.
   iii) Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

8) For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

a) Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?
   i) If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
   ii) If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?
   iii) If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
b) Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

i) If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

ii) If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

iii) If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

iv) If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

v) If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

c) If the secret prior art is an international application filed designating your jurisdiction:

i) Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

ii) Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

iii) Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

9) Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

a) Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

- □ same as Question 7
- □ same as Question 8
- □ different (please explain)

b) Same applicant on the dates of filing, no common inventor:
☐ same as Question 7
☐ same as Question 8
☐ different (please explain)

c) Different applicants on the dates of filing, same inventors:

☐ same as Question 7
☐ same as Question 8
☐ different (please explain)

i) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

d) Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

☐ same as Question 7
☐ same as Question 8
☐ different (please explain)

i) Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

ii) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

e) Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

☐ same as Question 7
☐ same as Question 8
☐ different (please explain)

f) Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

☐ same as Question 7
☐ same as Question 8
☐ different (please explain)

10) Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.
11) Please indicate which industry sector views are included in your Group's answers to Part III.
For all of the questions:

a) **secret prior art** means an earlier-filed patent application that was published on or after the **effective filing date** of a later-filed patent application.

b) **effective filing date** means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

*The standard for what constitutes adequate support is outside the scope of this Study Question.*

**I. Current law and practice**

*Please answer all the below questions in Part I on the basis of your Group's current law and practice.*
<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.a</td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td>1.a.i</td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td>1.a.ii</td>
<td>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
<td></td>
</tr>
<tr>
<td>1.b</td>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
</tr>
<tr>
<td>1.b.i</td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td>1.b.ii</td>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * &lt;br&gt;The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.</td>
<td></td>
</tr>
<tr>
<td>1.b.iii</td>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
<td></td>
</tr>
<tr>
<td>1.c</td>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
</tr>
<tr>
<td>1.c.i</td>
<td>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td>1.c.ii</td>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td>1.c.iii</td>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
<td></td>
</tr>
</tbody>
</table>
2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

There is no secret prior art under the Argentine Patent Law. However, this case would be rejected based on double patenting.

2.a.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

For double patenting issues, only the claims will be taken into consideration.

2.a.ii. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

For double patenting issues, yes.

2.a.iii. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

N/A.

2.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

As mentioned above, there is no secret prior art in Argentina.

2.b.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

For double patenting issues, yes.
### 2.b.ii
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

N/A.

### 2.b.iii
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

N/A.

### 2.b.iv
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

N/A.

### 2.b.v
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

N/A.

### 2.c
If the secret prior art is an international application filed designating your jurisdiction:

#### 2.c.i
Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

N/A. Argentina is not yet a PCT member.

#### 2.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

### 2.c.

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

N/A. Argentina is not yet a PCT member.

### 2.c.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

N/A.

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

Different applicants on the dates of filing, same inventors:

same as Question 2

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain
Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes

Please Explain

In that case, it could be a double patenting case.

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

### II. Policy considerations and proposals for improvements of your current law

Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<p>| | |</p>
<table>
<thead>
<tr>
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<tbody>
<tr>
<td>1.</td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
</tr>
<tr>
<td></td>
<td>Yes</td>
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<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>The Argentine Patent Law and its regulations do not specifically regulate secret prior art. However, the Patent Law expressly requires prior art to be publicly available. Thus, the Patent Office currently considers that prior art cannot be secret.</td>
</tr>
<tr>
<td></td>
<td>In any event, we consider that it would be advisable to expressly include a provision prohibiting secret prior art.</td>
</tr>
<tr>
<td>2.</td>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
</tr>
<tr>
<td></td>
<td>No</td>
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<td>Please Explain</td>
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<td></td>
<td>N/A.</td>
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<tr>
<td>3.</td>
<td>The treatment of international applications as secret prior art.</td>
</tr>
<tr>
<td></td>
<td>No</td>
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<td>Please Explain</td>
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<td></td>
<td>N/A.</td>
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</tbody>
</table>
### III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.
**Does your Group consider that harmonisation in any or all areas in Section II desirable?**

*If YES, please respond to the following questions without regard to your Group's current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

**Yes**

*If YES, please respond to the following questions without regard to your Group*

<table>
<thead>
<tr>
<th>7</th>
<th>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.</th>
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<thead>
<tr>
<th>7.a</th>
<th>Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</th>
</tr>
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</table>

| No |

| Please Explain |

<table>
<thead>
<tr>
<th>7.a.i</th>
<th>If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</th>
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</table>

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<tr>
<th>7.a.ii</th>
<th>If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</th>
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<thead>
<tr>
<th>7.a.iii</th>
<th>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
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</table>

| No |

| Please Explain |

<table>
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<tr>
<th>7.b</th>
<th>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
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<tr>
<th>7.b.i</th>
<th>If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</th>
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<tr>
<th>7.b.ii</th>
<th>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</th>
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<tr>
<th>7.b.iii</th>
<th>If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
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<tr>
<th>7.c</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
</table>
7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

N/A.

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

N/A.

7.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

N/A.

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content of the secret prior art.

8.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes.
8.a.iii If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes

Please Explain

8.b.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire content of the secret prior art.

8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Yes.

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Yes.

8.b.iv If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

N/A.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

N/A.

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 7

Please Explain

9.b Same applicant on the dates of filing, no common inventor: same as Question 7

Please Explain

9.c Different applicants on the dates of filing, same inventors: same as Question 8

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No

9.d
Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 8

Please Explain

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

In that case, it should be a double patenting case.

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e
Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:
same as Question 7

Please Explain

9.f
Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:
same as Question 7

Please Explain

Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

Please indicate which industry sector views are included in your Group’s answers to Part III.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Yes. The Patents Act 1990 contains a definition of the prior art base for novelty, which includes the following:

't information contained in a published specification filed in respect of a complete application where:

(A) if the information is, or were to be, the subject of a claim of the specification, the claim has, or would have, a priority date earlier than that of the claim under consideration; and

(B) the specification was published on or after the priority date of the claim under consideration; and

(C) the information was contained in the specification on its filing date.'

1.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents are available in principle. However, it is necessary to be able to construct a valid notional claim including the relevant information to be used in the novelty attack. See *El du Pont de Nemours Co v ICI Chemicals & Polymers Ltd* [2005] FCA 892 [http://classic.austlii.edu.au/cgi-bin/sinodisp/au/cases/cth/FCA/2005/892.html?stem=0&synonyms=0&query=title(%222005%20FCA%20892%22), 66 IPR 462 and *Danisco A/S v Novozymes A/S* (No 2) [http://classic.austlii.edu.au/cgi-bin/sinodisp/au/cases/cth/FCA/2011/282.html?stem=0&synonyms=0&query=title(%222011%20FCA%20282%22)[2011] FCA 282; 91 IPR 209.

1.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Subject to the construction of a notional claim, it is the same as the standard for novelty for any other prior art reference. This is the reverse infringement test as articulated in *Meyers Taylor Pty Ltd v Vicarr Industries Ltd* (1977) CLR 228 at page 235; 13 ALR 605 at page 611:

"The basic test for anticipation or want of novelty is the same as that for infringement and generally one can properly ask oneself whether the alleged anticipation would, if the patent were valid, constitute an infringement."

The effect of the provision is to make this information from the secret prior art part of the novelty prior art base.

1.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

1.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

1.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

No. Secret prior art in a PCT application, provided it designates Australia, has identical effect to Australian filed secret prior art.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents, subject to the construction of a notional claim, as noted above.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?
AIPPI 2018 - Study Question - Conflicting patent applications

The standard is the same as for other prior art.

a. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

The normal grace period applicable to disclosures derived from or by the same applicant, of up to 12 months before the Australian complete filing date (or PCT filing date), applies to secret prior art. This has been confirmed in a recent decision.

b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

b. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2c. If the secret prior art is an international application filed designating your jurisdiction:

c. Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Same applicant on the dates of filing, no common inventor:

same as Question 2

Different applicants on the dates of filing, same inventors:

same as Question 2

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

Yes

Please Explain

Yes. The current provisions have been interpreted by the Federal Court to mean that the information has to be constructed into a notional claim, which while arguably correct on the present wording of the legislation, is not consistent with the intention of the enquiry (IPAC) that preceded the introduction of the relevant provision. The references in the current provision to claims should be removed. It is enough that the prior application has an earlier filing or priority date, that the relevant information was there at that date, and that the application has subsequently been published.

4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

4.c. The treatment of international applications as secret prior art.

No

Please Explain

4.d. The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

4.e. The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain


No

Please Explain
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No
Please Explain

5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No
Please Explain

III. Proposals for harmonisation

Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes
If YES, please respond to the following questions without regard to your Group

Yes. There are no necessary policy differences in this area, and it would be efficient and practical to have a common set of rules operating internationally. The present situation gives rise in some cases to disparate outcomes in different countries on identical facts, and this does not promote a fair and efficient system, where stakeholders have a consistent set of expected outcomes.

7 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes
Please Explain

7.a.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

It should be exactly the same.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

No. We consider that this would be inequitable to the later applicant. It is not reasonable to hold them to exhibiting an inventive step relative to prior art that they have not and could not see.

In a first to invent system, there is an argument that the inventor of the secret prior art was the first inventor, and so it is reasonable to impose an obviousness / inventive step test on the later filed application. However, in a first inventor to file system, where the date of filing has primacy, the question is not what the inventor of the secret prior art invented; it is what they have disclosed, relative to novelty of the later filed application. As the skilled worker in the art did not have access to the secret prior art, it is not equitable (or even strictly logical) to have them consider whether there is an inventive step from the secret prior art. An useful discussion appears in the following article:


If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain
7.c.
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

No – it is any case an application. Entry into national phase should not be a precondition.

7.c.
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8.
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a.
Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a.i.
If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents.

8.a.ii.
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

It should be exactly the same as for other prior art.

8.a.iii.
If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

We consider that, consistent with prior AIPPI resolutions, a grace period should be applicable to all disclosures by or derived from the applicant for a period of 12 months before the filing date. This includes secret prior art, but only for a period of 12 months from the effective filing date of the secret prior art, not the publication date of the secret prior art. We do not favour any special or additional grace period for self-collision, noting particularly that consistent with the position adopted above, secret prior art is not available to attack a subsequent application on the ground of lack of inventive step.
### 8.b

**Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

<table>
<thead>
<tr>
<th>Answer</th>
<th>Explain</th>
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<tr>
<td>No</td>
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</table>

### 8.b.i

**If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

<table>
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<tbody>
<tr>
<td>No</td>
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</table>

### 8.b.ii

**If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?**

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<tbody>
<tr>
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### 8.b.iii

**If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?**

<table>
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<tbody>
<tr>
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### 8.b.iv

**If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?**

<table>
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<tr>
<th>Answer</th>
<th>Explain</th>
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<tbody>
<tr>
<td>No</td>
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</table>

### 8.b.v

**If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?**

<table>
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<th>Answer</th>
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<tbody>
<tr>
<td>No</td>
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### 8.c

**If the secret prior art is an international application filed designating your jurisdiction:**

### 8.c.i

**Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.**

<table>
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### 8.c.ii

**Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

<table>
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</table>

### 8.c.iii

**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

<table>
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Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 8
Please Explain

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 8
Please Explain

9.b Same applicant on the dates of filing, no common inventor:
same as Question 8
Please Explain

9.c Different applicants on the dates of filing, same inventors:
same as Question 8
Please Explain

9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 8
Please Explain

9.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
No
Please Explain

9.d.ii Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain

9.e Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain
9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 8

Please Explain

9.f Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 8

Please Explain

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

We have given some consideration to the need for anti-self-collision provisions. We firstly note that if a grace period of 12 months applies, then there is at most a period of 6 months in which this issue has any significance. Our position is that secret prior art should only be applied to novelty, not inventive step. If the subsequent filing is not even novel over the earlier secret prior art by the same applicant, then we have difficulty seeing why some special provision is justified in a policy sense.

In any case, the issue of the secret prior art and the subsequent filing ending up in different ownership has the potential to create complexity for all stakeholders. This is not in our view justified, given the 6 month timeframe and limited application of the secret prior art to inventive step.

11 Please indicate which industry sector views are included in your Group’s answers to Part III.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
### 1.a
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content of the secret prior art is available.

### 1.a.ii
If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is the same as the standard applied to publicly available prior art.

### 1.b
Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

### 1.b.i
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

### 1.b.ii
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *

*The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.*

### 1.b.iii
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

### 1.c
If the secret prior art is an international application filed designating your jurisdiction:

#### 1.c.i
Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

Please Explain

#### 1.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain
Yes, if the Austrian Patent Office is not the receiving office, the secret prior art is only available against the claims of the later-filed application for novelty-defeating purposes if the fee for entering the national phase has been paid within 30 months from the priority date and – if the application is not in German – a German translation has been submitted within the same time limit.

<table>
<thead>
<tr>
<th>1.c.iii</th>
<th>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
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<tr>
<td>Please Explain</td>
<td></td>
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</table>

<table>
<thead>
<tr>
<th>2</th>
<th>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</th>
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<table>
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<tr>
<th>2.a</th>
<th>Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?</th>
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<tr>
<td>Yes</td>
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<tr>
<td>Please Explain</td>
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</table>

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<th>2.a.i</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
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<td>The entire content of the secret prior art is available.</td>
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<td>Please Explain</td>
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<tr>
<th>Question</th>
<th>Text</th>
</tr>
</thead>
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<tr>
<td><strong>2.b.</strong></td>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</td>
</tr>
<tr>
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<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
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<tr>
<td><strong>2.b.</strong></td>
<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
</tr>
<tr>
<td><strong>2.c.</strong></td>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
</tr>
<tr>
<td><strong>2.c.i</strong></td>
<td>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>2.c.ii</strong></td>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Yes, if the Austrian Patent Office is not the receiving office, the secret prior art is only available against the claims of the later-filed application for novelty-defeating purposes if the fee for entering the national phase has been paid within 30 months from the priority date and – if the application is not in German – a German translation has been submitted within the same time limit</td>
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<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>3</strong></td>
<td>Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.</td>
</tr>
</tbody>
</table>
3. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

3. Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

3. Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.
### III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

| 4.b | The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art. |
| 4.c | The treatment of international applications as secret prior art. |
| 4.d | The treatment of total and partial identity of applicants as it relates to secret prior art. |
| 4.e | The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art. |
| 4.f | Provisions for avoiding self-collision. |
| 4.g | Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application. |

#### 5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

**Please Explain**

---

### III. Proposals for harmonisation

**Please consult with relevant in-house / industry members of your Group in responding to Part III.**

#### 6 Does your Group consider that harmonisation in any or all areas in Section II desirable?

**If YES, please respond to the following questions without regard to your Group’s current law or practice.**

**Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.**

Yes

**If YES, please respond to the following questions without regard to your Group**

#### 7 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.
### Study Question - Conflicting patent applications

**7.a.** Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

**7.a.i.** If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire content of the secret prior art should be available.

**7.a.ii.** If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

It should be the same as the standard applied to publicly available prior art.

**7.b.** Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

**7.b.i.** If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

**7.b.ii.** If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

**7.b.iii.** If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

**7.c.** If the secret prior art is an international application filed designating your jurisdiction:

**7.c.i.** Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

**7.c.ii.** Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.
AIPPI 2018 - Study Question - Conflicting patent applications

Yes

Please Explain

Yes, if the respective patent office is not the receiving office, the secret prior art is only available against the claims of the later-filed application for novelty-defeating purposes if the fee for entering the national phase has been paid within 30 months from the priority date and – if the application is not in the respective patent office’s language – a translation has been submitted within the same time limit.

7.c.iii

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content of the secret prior art should be available.

8.a.i

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content of the secret prior art should be available.

8.a.ii

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

It should be the same as the standard applied to publicly available prior art.

8.a.iii

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

8.b

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Yes, if the respective patent office is not the receiving office, the secret prior art is only available against the claims of the later-filed application for novelty-defeating purposes if the fee for entering the national phase has been paid within 30 months from the priority date and – if the application is not in the respective patent office’s language – a translation has been submitted within the same time limit.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain
Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.b

Same applicant on the dates of filing, no common inventor:

same as Question 7

Please Explain

9.c

Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9.c.i

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.d

Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d.i

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

9.d.ii

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain
9.e  Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f  Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10  Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

There are no additional issues we consider relevant to this Study Question.

11  Please indicate which industry sector views are included in your Group’s answers to Part III.

The Austrian Chamber of Commerce (which represents the full range of industry sectors) was involved in answering the questionnaire.
Conflicting patent applications

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Belarusian Patent Law:

An invention shall be considered **novel** if it does not form part of the prior art. The prior art shall consist of any kind of information which has been made available to the public anywhere in the world before the priority date of the claimed invention. When determining the **novelty** of an invention, the prior art shall likewise include all **applications** for the protection of inventions and utility models that have been filed **by other persons** in the Republic of Belarus, that enjoy earlier priority and that have not been withdrawn, and also inventions and utility models that have been patented in the Republic of Belarus.

**1.a.i** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Entire contents of the secret prior art seem to be available against the claims of the later-filed application for novelty-defeating purposes.

**1.a.ii** If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard is the same as the standard applied to publicly available prior art.

**1.b** Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Belarusian Patent Law:

An invention shall be considered to involve an **inventive step** if, having regard to the prior art, it is not obvious to a person skilled in the art. The prior art shall consist of any kind of information which has been made available to the public anywhere in the world before the priority date of the claimed invention.

**1.b.i** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

**1.b.ii** If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * *

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

**1.b.iii** If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

**1.c** If the secret prior art is an international application filed designating your jurisdiction:

**1.c.i** Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

After entering the national phase the application is treated as national application and thus according to the Belarusian Patent Law:

An invention shall be considered novel if it does not form part of the prior art. The prior art shall consist of any kind of information which has been made available to the public anywhere in the world before the priority date of the claimed invention. When determining the novelty of an invention, the prior art shall likewise include all applications for the protection of inventions and utility models that have been filed by other persons in the Republic of Belarus, that enjoy earlier priority and that have not been withdrawn, and also inventions and utility models that have been patented in the Republic of Belarus.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

An invention shall be considered novel if it does not form part of the prior art. The prior art shall consist of any kind of information which has been made available to the public anywhere in the world before the priority date of the claimed invention. When determining the novelty of an invention, the prior art shall likewise include all applications for the protection of inventions and utility models that have been filed by other persons in the Republic of Belarus, that enjoy earlier priority and that have not been withdrawn, and also inventions and utility models that have been patented in the Republic of Belarus.

Disclosure of information concerning the invention shall not adversely affect its patentability where it has the effect of making information on the invention generally accessible, where such disclosure is made by the applicant (or author) or by any other person who has obtained such information directly or indirectly from them and where such disclosure occurred during the 12 months preceding the filing of the application with the Patent Office.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

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<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
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<tbody>
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</table>
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

3.b. Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

3.c. Different applicants on the dates of filing, same inventors:

same as Question 2

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain
### Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

**Please Explain**

### II. Policy considerations and proposals for improvements of your current law

#### 4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<p>| | |</p>
<table>
<thead>
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<tbody>
<tr>
<td><strong>4.a.</strong></td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
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<tr>
<td></td>
<td>Yes</td>
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<td></td>
<td>Please Explain</td>
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<tr>
<td><strong>4.b.</strong></td>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
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<td></td>
<td>Yes</td>
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<td>Please Explain</td>
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<tr>
<td><strong>4.c.</strong></td>
<td>The treatment of international applications as secret prior art.</td>
</tr>
<tr>
<td></td>
<td>No</td>
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<td></td>
<td>Please Explain</td>
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<td><strong>4.d.</strong></td>
<td>The treatment of total and partial identity of applicants as it relates to secret prior art.</td>
</tr>
<tr>
<td></td>
<td>Yes</td>
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<td>Please Explain</td>
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<tr>
<td><strong>4.e.</strong></td>
<td>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</td>
</tr>
<tr>
<td></td>
<td>Yes</td>
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<td>Please Explain</td>
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<tr>
<td><strong>4.f.</strong></td>
<td>Provisions for avoiding self-collision.</td>
</tr>
<tr>
<td></td>
<td>Yes</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

   If YES, please respond to the following questions without regard to your Group’s current law or practice.

   Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Only the claims of the secret prior art should be available.

7.a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

...
The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art.

7.a Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

7.b If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

7.b.i If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b.ii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c If the secret prior art is an international application filed designating your jurisdiction:

7.c.i Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

7.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

7.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.
8.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The claims of the secret prior art should be available.

8.a If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art.

8.a If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

The anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes should be 12 months.

8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

8.b If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

8.b If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

8.b If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

Yes

Please Explain

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

Same applicant on the dates of filing, no common inventor:

same as Question 7

Please Explain

Different applicants on the dates of filing, same inventors:
Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

We have no answer.
Please indicate which industry sector views are included in your Group’s answers to Part III.

Instrument engineering, building, pharmaceutical.
For all of the questions:

\[ a) \text{secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.} \]

\[ b) \text{effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.} \]

\textbf{The standard for what constitutes adequate support is outside the scope of this Study Question.}

\section*{I. Current law and practice}

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

\begin{itemize}
  \item For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.
  \item Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?
  \begin{itemize}
    \item Yes
    \item Please Explain
  \end{itemize}
\end{itemize}
introductory remark: The questions below seem to be inspired mainly by the US jurisdiction, where different rules apply for conflicting applications having same or different applicants/inventors. These issues are of no or little importance in most other jurisdictions. Hence many of the questions below will have identical answers.

Secret prior art is available against the claims of a later filed application provided that certain criteria are fulfilled. The requirements depend on whether the later filed application is a Belgian patent application (hereafter BE) or a European patent application (i.e. a direct European patent application, hereafter EP, or a PCT application which has entered the European phase, hereafter PCT-EP). An overview of the secret prior art available against BE, EP or PCT-EP applications for novelty-defeating purposes is given in the overview below:

1) Belgian patents/applications are considered to be secret prior art against direct Belgian patents/applications (Art. XI.6, §3, 1° Code Economic Law (CEL)).

2) Belgian patents/applications are NOT considered to be secret prior art against European patents/applications and PCT-EP patent applications (Belgian patents/applications are not European applications under Art. 54(3) EPC. However, under Article 139(2) EPC, once an EP application is granted, the secret BE patents/applications are prior art (Art 2(2) and 139(2) EPC) in Belgium).

3) European patent applications are considered to be secret prior art against direct Belgian patents/applications (Art. XI.6, §3, 2° CEL).

4) European patent applications are considered to be secret prior art against European patents/applications and PCT patent applications (Art. 54(3) EPC).

5) PCT-EP applications are considered to be secret prior art against direct Belgian patents/applications provided the following requirements are fulfilled: Art. XI.6, §3, 3° CEL combined with Art. 153(3) - (4) EPC. and Rule 159(1)(a to h) EPC.

6) PCT-EP applications are considered to be secret prior art against European patents/applications and PCT-EP patent applications provided the following requirements are fulfilled: Art. 54(3) EPC combined with Art.153 (5) EPC; Art. 153(3)(4) EPC; Rule 165 EPC; Rule 159(1)(c) EPC only.

**If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?**

BE: Yes, the entire contents as filed, excluding the abstract (cf. Art. XI.18 §4 CEL)
EP: Yes, the entire contents as filed, excluding the abstract including the title (cf. Art. 85 EPC and Rule 42 EPC)
PCT applications: Yes, the entire contents as filed, excluding the abstract. Note that the title forms part of the description (cf. Rule 5 PCT).

**If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?**

The same standard as to publicly available prior art under Art. 54(2) EPC is applied.

**Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?**

No

BE: No, in accordance with Art. XI.7 CEL.
EP and PCT-EP: No, in accordance with Art. 56 EPC.
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *  

* The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

Please Explain

cf. answer 1 above, where the differences between EP, PCT-EP and their influence on Belgian patents vs. European patents is outlined.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

No. An international application has to enter into the European phase (i.e. certain acts related to the entry have to be fulfilled, see below and line 1c in the table above), i.e. the regional phase, but it does not matter whether the application is validated in Belgium.

The formal requirements are slightly different for BE applications and EP or PCT-EP applications. In short, the requirements for PCT applications to become prior art under the CEL is that all requirements of Rule 159(1) need to be fulfilled, while in the EPC, only Rule 159(1)(c) needs to be complied with (cf. Rule 165 EPC)

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No, only the filing and publication dates are important. Although in order to qualify as prior art a number of requirements need to be fulfilled,
the date at which the entry happened (provided it is within the required timeline) is irrelevant.

<table>
<thead>
<tr>
<th>Question</th>
<th>Details</th>
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<tbody>
<tr>
<td>2</td>
<td>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</td>
</tr>
<tr>
<td>2.a</td>
<td>Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
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<tr>
<td></td>
<td>Same answer as under question 1a(i) above.</td>
</tr>
<tr>
<td>2.a.i</td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
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<tr>
<td></td>
<td>Same answer as under question 1a(i) above.</td>
</tr>
<tr>
<td>2.a.ii</td>
<td>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
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<tr>
<td></td>
<td>Same answer as under question 1a(i) above.</td>
</tr>
<tr>
<td>2.a.iii</td>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
</tr>
<tr>
<td>No</td>
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<tr>
<td>2.b</td>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
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<tr>
<td></td>
<td>No, see question 1b above.</td>
</tr>
<tr>
<td>2.b.i</td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
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<tr>
<td>N.A.</td>
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<td>Section</td>
<td>Question</td>
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<tr>
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<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</td>
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<td>2.b.iii</td>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
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<tr>
<td>2.b.iv</td>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
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</table>
| 2.b.v   | If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)? | No
Please Explain|
| 2.c.i   | Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain. | Yes
Please Explain|
| cf. answer 1 above, where the differences between EP, PCT-EP and their influence on Belgian patents vs. European patents is outlined. There is no difference in the answer when the applicant is the same or different. |
| 2.c.ii  | Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain. | Yes
Please Explain|
| cf. answer 1 above regarding the formal requirements in the different situations |
2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No, only the filing and publication dates are important. Although in order to qualify as prior art a number of requirements need to be fulfilled, the date at which the entry happened (provided it is within the required timeline) is irrelevant.

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

No difference in any of the above answers in our jurisdiction

3.b Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

No difference in any of the above answers in our jurisdiction

3.c Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

No difference in any of the above answers in our jurisdiction

3.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

No difference in any of the above answers in our jurisdiction
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group's current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

The definition is clear, but it might be advisable to align the Belgian CEL with the EPC. Direct BE patents/applications have a strange peculiarity regarding admissibility of PCT applications as secret prior art, but the definition is clear.

4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

The standards are clear.
### The treatment of international applications as secret prior art.

No

Please Explain

The treatment is clear, but it is advisable to align the Belgian CEL with the EPC as explained above for question 4a.

### The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

No difference in treatment, provided priority rights are correctly and timely assigned.

### The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

No difference in treatment.

### Provisions for avoiding self-collision.

No

Please Explain

Anti self collision is currently not applied in Belgium or Europe, i.e. prior art is treated the same whether or not applicants/inventors are the same or not. It may be good to make it as simple as possible in the interest of the public.

### Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

Anti self collision is currently not applied in Belgium or Europe, i.e. prior art is treated the same whether or not applicants/inventors are the same or not. It may be good to make it as simple as possible in the interest of the public.
### III. Proposals for harmonisation

Please consult with relevant *in-house / industry members of your Group* in responding to Part III.

### 6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

<table>
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<th>Yes</th>
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If YES, please respond to the following questions without regard to your Group

### 7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

#### 7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

<table>
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<th>Yes</th>
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Please Explain

Yes, the whole content, except for the abstract and title (see above)

#### 7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

<table>
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<th>Yes</th>
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Yes, the whole content, except for the abstract and title (see above)

#### 7.a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

| Same standard should be applied |

#### 7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

| Same standard should be applied |

#### 7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

| Same standard should be applied |

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AIPPI 2018 - Study Question - Conflicting patent applications

No

Please Explain

Since in Europe there is no anti self collision, novelty should be the only ground on which secret prior art could be used

<table>
<thead>
<tr>
<th>7.b.</th>
<th>If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</th>
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<td>N.A.</td>
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<tr>
<th>7.b.</th>
<th>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</th>
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<td>N.A.</td>
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<tr>
<th>7.b.</th>
<th>If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
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<tr>
<th>7.c</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
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<thead>
<tr>
<th>7.c.i</th>
<th>Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.</th>
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<tbody>
<tr>
<td>No</td>
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<tr>
<td>Please Explain</td>
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It should not change our answers, but it does at the moment due to a strange difference in formality requirements of e.g. PCT applications citeable against BE or PCT/EP-BE applications, which should be changed

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<tr>
<th>7.c.ii</th>
<th>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</th>
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<td>Yes</td>
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<td>Please Explain</td>
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See above under point I.1.c.ii

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<tr>
<th>7.c.iii</th>
<th>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</th>
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</table>
No

Please Explain

See above point I.1.c.iii, the requirements for entry need to be fulfilled

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

9. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

See above in question 7 for different applicants, as it should be the same

8.a. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

Yes, the whole content, except for the abstract and title (see above)

8.a.i. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Same standard

8.a.ii. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No

8.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Anti self collision and use of secret prior art against inventive step go hand in hand. Lack of anti self collision hence precludes the use of secret prior art for attacking inventive step.

8.b. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
### b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

<table>
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<tr>
<th>N.A.</th>
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### b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

<table>
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<tr>
<th>N.A.</th>
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### b. If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

<table>
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<th>see above</th>
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</table>

### b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

<table>
<thead>
<tr>
<th>No</th>
</tr>
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</table>

Please Explain

One should avoid very cumbersome procedures such as in e.g. US where bundles of patents are required in case of terminal disclaimers etc.

### c. If the secret prior art is an international application filed designating your jurisdiction:

### c.1. Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

<table>
<thead>
<tr>
<th>No</th>
</tr>
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</table>

Please Explain

See above

### c.2. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

<table>
<thead>
<tr>
<th>Yes</th>
</tr>
</thead>
</table>

Please Explain
An international application has to enter the European phase, i.e. the regional phase, but it does not matter whether the application is validated in Belgium. See above.

**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

No

Please Explain

no, only its filing/priority date and publication date

**Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.**

**9.a**

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

no difference

**9.b**

Same applicant on the dates of filing, no common inventor:

same as Question 7

Please Explain

no difference

**9.c**

Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

no difference

**9.c.i**

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

73
no difference

9.d. **Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

Same as Question 7

Please Explain

no difference

9.d. **Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?**

No

Please Explain

no difference

9.d. **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain

no difference

9.e. **Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:**

Same as Question 7

Please Explain

no difference

9.f. **Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:**

Same as Question 7

Please Explain

no difference

10. **Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.**
Generally, there are two possible ways of looking at international applications as being secret prior art:

1) a horizontal approach, wherein publication of an international patent application automatically results in said application being considered as secret prior art in a given country or region, regardless of fulfilling certain formal requirements for entry into said country or region, or

2) a vertical approach wherein an international patent application is only considered as secret prior art in a given country or region when the formal requirements of entry into said country or region are fulfilled.

There are pro’s and con’s for both situations of course. The horizontal approach offers more certainty for the public since the publication of an international application is sufficient and there is no need to check whether or not certain requirements have been fulfilled. For smaller players, this approach enables avoiding others from patenting their exact technology hence creating some sort of (limited) freedom to operate, while avoiding the costs for national/regional entry. The drawback is that in certain cases self-collision can occur in Europe since we do not have a possibility to ignore own self-created prior art as e.g. the US has.

The vertical approach has the advantage of allowing certain jurisdictions to set their own rules for prior art that can or cannot be considered as secret prior art. Issues with self-collision can be avoided simply by not fulfilling the requirements of entry, which in Europe is an advantage due to the lack of other anti-self-collision measures. A disadvantage is that it becomes less transparent for the public to evaluate patentability of a given application/patent, since one has to check whether or not the formal requirements have been fulfilled.

The Belgian Advisory Council for Intellectual Property (Raad Intellectuele Eigendom - Conseil de la Propriété Intellectuelle) adopted a view on this back in 2006 (Annex 2), pleading for a harmonized horizontal approach. This would imply that the content of any published international application would be prior art for novelty as from its filing/priority date, regardless of any fulfilment of national or regional requirements such as those laid down in the EPC. Such a "horizontal" effect was seen as beneficial to applicants who cannot afford to enter in the national phase, and also beneficial to international harmonisation because it allows the prior art itself to be harmonised (not just the definition of the prior art).

Indeed, the America Invents Act (AIA) also adopted the "horizontal" approach in the sense that it does not require entry of a PCT application in the US national phase for it to be regarded as prior art for assessing both novelty and obviousness. Of course the AIA does provide exceptions for applications having the "same" inventors/applicants (anti-self-collision).

In order to harmonise the situation, a horizontal approach could be envisaged in Europe, but whereby the secret prior art applications are only to be used for assessing novelty. Within the Belgian group there is currently no consensus regarding potential anti-self-collision measures that could be put in place for Europe.

Please indicate which industry sector views are included in your Group’s answers to Part III.

Pharma,

Semiconductor,

Petrochemistry
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I. Mission et composition du groupe de travail ad hoc

Lors de la réunion du 14 septembre 2006 de la section “Propriété industrielle” du Conseil de la Propriété intellectuelle, il a été décidé, en application de l'article 6, § 1er, de l'arrêté royal du 5 juillet 2004¹, de créer un groupe de travail ad hoc sous la présidence de M. Theunis afin d'élaborer une proposition d'avis relative aux propositions d'harmonisation du droit matériel des brevets.

Ont fait partie de ce groupe de travail ad hoc: MM. F. de Visscher (avocat), P. Theunis (Agfa-Gevaert), F. Leyder (Total Petrochemicals) et A. Pilate (Umicore). M. C. Quintelier (mandataire en brevets) a également participé à ce groupe de travail en application de l'article 9 de l'arrêté royal précité du 5 juillet 2004.

Conformément à l'article 8 du même arrêté royal, l'Office de la Propriété intellectuelle a assuré le secrétariat de ce groupe de travail ad hoc.

II. Calendrier des travaux

Ce groupe de travail ad hoc s'est réuni pour la première fois le 3 octobre 2006 à 9 heures. La seconde réunion a eu lieu le 13 octobre 2006 à 8h30.

III. Avis

Les discussions ont eu lieu sur la base de la proposition de compromis, rédigée par la présidente du groupe de travail 1 du groupe B+ (harmonisation du droit matériel des brevets). Cette proposition n'est pas rédigée sous la forme d’un texte de traité, mais elle reprend les principes qui seront ensuite transposés en texte de traité.

Lors de sa réunion du 29 novembre 2006 de la Section "Propriété industrielle" du Conseil de la Propriété intellectuelle, le projet d'avis du groupe ad hoc a été présenté par M. Theunis en sa qualité de président du groupe ad hoc et discuté par les membres de la Section. Le projet d'avis du groupe ad hoc a été approuvé par la Section "Propriété industrielle" du Conseil de la Propriété intellectuelle moyennant certaines adaptations apportées au point A (période de grâce) et à la conclusion du point B (demandes PCT concurrentes).

A. LA PERIODE DE GRACE

1. La proposition de compromis se lit comme suit :

"Concerning Art. 9 Grace Period
1. The length of the grace period is 12 months
2. An applicant’s own previously published applications shall only be covered by the grace period only if published erroneously by the office
3. No formal requirements shall be included in order to invoke the Grace period, i.e., no declaration requirement
4. A mandatory scheme for the protection of 3rd party rights covering acts done completely independently from the applicant’s claimed invention and performed prior to and continued during the Grace period. Further, an optional clause allowing 3rd party rights in the situation where a 3rd party in good faith, used the information derived from the use of the grace period by the applicant, for the purpose of his business. However, a grandfathering clause shall be included allowing the current practice to continue for the time being for parties not providing or providing a different form of 3rd party rights."

Les éléments suivants sont repris dans la proposition de compromis:

- une période de grâce de 12 mois;
- la demande antérieure du déposant ne sera couverte que si la demande a été publiée faussement par l'office de brevets;
- aucune exigence formelle ne sera introduite pour se prévaloir de la période de grâce, c'est-à-dire aucune obligation de déclaration ;
- un régime obligatoire de protection des droits des tiers qui couvre les actes exécutés de manière totalement indépendante de l'invention revendiquée avant et pendant la période de grâce;
- un régime facultatif des droits des tiers dans le cas où le tiers utilise, de bonne foi, pour son commerce, l'information qu'il a retirée de l'utilisation de la période de grâce par le demandeur de brevet;
- une clause dite du grand-père permettant aux pratiques actuelles de continuer ou permettant une autre forme de droits pour les tiers.

La période de grâce donne à l'inventeur le droit de publier l'invention sans que cette publication n'ait d'influence sur l'évaluation de la nouveauté, pour autant que la demande de brevet correspondante soit déposée dans le laps de temps déterminé.
Le système européen des brevets ne prévoit aucune période de grâce. Les cas prévus à l'article 55 de la Convention sur le brevet européen² (CBE) - à savoir l'abus et une exposition officielle reconnue au sens de la Convention du 22 novembre 1928³ - ne sont pas considérés comme une période de grâce. Dans le cadre des discussions trilatérales, l'introduction de la période de grâce est considérée comme le prix à payer par les pays européens pour l'harmonisation du droit des brevets (en échange du first to file et de la suppression de la doctrine Hilmer).

Deux questions doivent être examinées: d'une part, l'opportunité d'introduire une période de grâce et d'autre part, les modalités concrètes de cette mesure.

2. Remarques générales de la Section "Propriété industrielle"

La question sur l'introduction ou non de la période de grâce est l'objet d'un débat depuis déjà des années. Cette question n'est toujours pas tranchée car un système de brevets prévoyant une période de grâce compte à la fois des avantages et des inconvénients. Du point de vue de l'équité, l'introduction de la période de grâce peut être justifiée (par exemple, parce que l'on veut épargner des personnes qui n'ont pas conscience à temps des conséquences de la publication de leur invention). La période de grâce peut également être utile pour les universités compte tenu de la pression à la quelle elles sont soumises de publier le plus rapidement possible le résultat de leurs recherches. Mais la période grâce entraîne cependant des difficultés supplémentaires et une insécurité juridique. On peut se demander si les tiers sont satisfaits de l'introduction de la période de grâce et s'il n'est pas préférable d'introduire des règles de droit qui soient les mêmes pour tous.

Le problème principal de la période de grâce est l'augmentation de l'insécurité juridique. En outre, il est actuellement très aisé d'obtenir une date de priorité. Il n'est pas nécessaire de payer une taxe au moment du dépôt de la demande de brevet. Après l'entrée en vigueur du PLT, une date d'introduction peut être obtenue même lorsque la demande est déposée dans n'importe quelle langue et sans revendication. Dans cette situation, il est préférable d'informer les inventeurs afin qu'ils introduisent leur demande de brevet avant de publier leur invention.

3 L'article 55 de la Convention sur la délivrance de brevets européens (Convention sur le brevet européen) prévoit que: “Divulgations non opposables 1. Pour l'application de l'article 54, une divulgation de l'invention n'est pas prise en considération si elle n'est pas intervenue plus tôt que six mois avant le dépôt de la demande de brevet européen et si elle résulte directement ou indirectement : a. d'un abus évident à l'égard du demandeur ou de son prédécesseur en droit ou b. du fait que le demandeur ou son prédécesseur en droit a exposé l'invention dans des expositions officielles ou officiellement reconnues au sens de la Convention concernant les expositions internationales, signée à Paris le 22 novembre 1928 et révisée en dernier lieu le 30 novembre 1972.” La loi du 28 mars 1984 sur les brevets d'invention a repris cette disposition à l'article 5, § 5.
La Section "Propriété industrielle" estime que l'introduction de la période de grâce comporte de nombreux inconvénients qui l'emportent largement sur les avantages qui en découlent.

Néanmoins, il est clair que les Etats-Unis n'accepteront pas le principe “first to file” sans la période de grâce. Par conséquent, il est important d'encadrer le plus possible la période de grâce et d'en limiter les conséquences négatives.

En outre, il est insensé de vouloir parvenir à un compromis à tout prix pour harmoniser malgré tout si cela doit déboucher sur un système incohérent.

3. Dans la proposition de compromis, il faut distinguer différents aspects de la période de grâce :

3.1. La durée de la période de grâce

3.1.1. La proposition de compromis se lit comme suit :

“The length of the grace period is 12 months”

Les Etats Unis (un an), le Canada (jusqu'à 1 an), le Japon (six mois), la Corée (six mois) et d'autres pays, au total environ 40 pays au monde, connaissent une forme de période de grâce, dont la grande majorité une période de grâce de 6 mois. Le point de vue coordonné de l'UE4 prévoit une période de grâce de maximum 6 mois en raison de la sécurité juridique. Les pays de l'UE ne sont pas d'accord jusqu'à présent sur la durée de la période de grâce reprise dans la proposition de compromis. Ce point peut éventuellement être décidé lors d'une conférence diplomatique.

3.1.2. Remarques de la Section "Propriété industrielle" concernant la durée de la période de grâce

La Section "Propriété industrielle" estime qu'il est important de limiter les effets de la période de grâce si elle doit être introduite. Par conséquent, s'il le faut, la préférence va à un délai de 6 mois qui statistiquement permet de générer moins de problèmes.

3.2. Un filet de sécurité pour une publication fautive de la demande de brevet par un office de brevets

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4 Document de la présidence du Conseil européen du 12 décembre 2005 (Document 15645/05) “Coordination on strategy regarding international patent law harmonisation discussions”, p. 2. The existing position of EU/MS is that the introduction of a grace period can only be in the context of an international harmonised system within the framework of a first-to-file system. Furthermore, the grace period should have the following features: a. it should constitute a safety net only, b. it should be limited to minimize uncertainty (maximum 6 months), c. priority rights under the Paris convention should not be affected, d. third party rights should not be affected, e. it should cover all disclosures of information prior to filing; and f. it should be claimed by the applicant where possible.”
3.2.1. La proposition de compromis se lit comme suit :

"An applicant's own previously published applications shall only be covered by the grace period only if published erroneously by an office."

Le point de vue européen coordonné\(^5\) comporte une solution prévoyant un filet de sécurité ("safety net"). La publication de sa propre demande de brevet sera couverte par la période de grâce mais uniquement si la demande a été publiée fautivement par l'office de brevets. Toutefois, différents pays ne donnent pas le même contenu à cette notion.

Il faut ici également déterminer ce que l'on entend par publication. Doit-il s'agir d'une publication de la propre demande de brevet du demandeur de brevet ou de toutes les formes de publication ? Ce dernier point a été critiqué car il déboucherait sur un système "first to publish".

3.2.2. Remarques de la Section "Propriété industrielle"

Si un article est publié dans un périodique, l'invention qui y est reprise (dans notre système actuel) fait partie de l'état de la technique. En introduisant la période de grâce, la notion du principe de nouveauté absolue qui a été introduite par la Convention de 1963\(^6\) est abandonnée.

Le cas où la publication est effectuée par l'inventeur même n'est pas expressément repris dans la proposition de compromis mais bien dans la dernière version officielle de la proposition SPLT de l'OMPI\(^7\). Dans ce cas, l'inventeur ne pourra se prévaloir de la période de grâce que s'il prouve que la publication a été faite par lui.

La proposition de compromis ne reprend pas le cas où la publication a été faite par un tiers. Ce cas pourrait porter sur un abus évident, ce qui est couvert par l'article 55 de la Convention sur la délivrance de brevets européens (CBE) et est aussi repris dans la dernière version officielle de la proposition SPLT de l'OMPI\(^8\).

Dans sa décision J5/81, la Chambre de Recours a indiqué qu'une demande publiée de brevet européen fait partie de l'état de la technique tel que visé à l'article 54(3) de la CBE

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\(^5\) Idem note en bas de page 4.


\(^7\) Document SCP/10/4 du 30 septembre 2003, art. 9 (1) (i): "An item of prior art with respect to a claimed invention shall not affect the patentability of that claimed invention, in so far as that item was included in the prior art on a date during the [12] [six] months preceding the priority date of the claimed invention, (i) by the inventor, (…)".

\(^8\) Document SCP/10/4 du 30 septembre 2003, art. 9 (1) (ii): “An item of prior art with respect to a claimed invention shall not affect the patentability of that claimed invention, in so far as that item was included in the prior art on a date during the [12] [six] months preceding the priority date of the claimed invention, (ii) by the Office and the item of prior art was contained (…) (b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information contained in the item of prior art directly or indirectly from the inventor".
dans la mesure où il s'agit toujours d'une demande existante de brevet au moment de la publication. Cela implique donc que lorsque le jour de la publication, la demande de brevet était retirée ou considérée comme retirée, elle ne fait pas partie de l'état de la technique tel que visé à l'article 54 (3).

La Section "Propriété industrielle" conclut que la proposition de compromis ne comporte pas de véritable période de grâce. En effet, la publication fautive éventuelle par l'office de brevets ne dépend pas de la volonté du demandeur de brevets. Cette règle est en tout cas déjà couverte par l'article 55 de la CBE et par la dernière version officielle de la proposition SPLT de l'OMPI. Une véritable période de grâce existe uniquement lorsque la publication émane de l'inventeur.

La dernière version officielle de la proposition SPLT de l'OMPI couvre toutefois le cas où la publication est effectuée par un tiers qui a obtenu l'information directement ou indirectement de l'inventeur (sans qu'il s'agisse d'un abus). Cette dernière forme de publication n'est pas suffisamment précise, ce qui est dangereux pour la sécurité juridique.

3.3. Obligation de déclaration

3.3.1. La proposition de compromis se lit comme suit :

“No formal requirements shall be included in order to invoke the Grace period, i.e., no declaration requirement”.

La proposition de compromis n'impose aucune obligation pour l'inventeur ou le demandeur de faire connaître les divulgations antérieures. Dans le passé, l'exigence de déclaration a été jugée primordiale par l'UE pour veiller à ce que la période de grâce soit uniquement un filet de sécurité et pour assurer aux tiers une certaine transparence.

3.3.2. Remarques de la Section "Propriété industrielle" sur l'obligation de déclaration

La Section "Propriété industrielle" estime que l'inventeur doit faire une déclaration, car cela augmente la sécurité juridique pour les tiers. En effet, il est très difficile pour les tiers de savoir si une publication a eu lieu et si elle vient du demandeur. L'intention est que le demandeur doive prouver que les conditions d'application de la période de grâce sont

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9 Document SCP/10/4 du 30 septembre 2003, art. 9 (1) (ii): “An item of prior art with respect to a claimed invention shall not affect the patentability of that claimed invention, in so far as that item was included in the prior art on a date during the [6] months preceding the priority date of the claimed invention, (ii) by an Office and the item of prior art was contained (a) in another application filed by the inventor [and should not have been made available to the public by the Office](...)”.

10 Document SCP/10/4 du 30 septembre 2003, art. 9 (1) (ii): “An item of prior art with respect to a claimed invention shall not affect the patentability of that claimed invention, in so far as that item was included in the prior art on a date during the [6] months preceding the priority date of the claimed invention, (...) (iii) by a third party which obtained the information contained in the item of prior art directly or indirectly from the inventor ”.
remplies et d'éviter ainsi qu'un tiers ne doive œuvrer à cet effet. Les données relatives à la publication, à sa date et au lieu doivent être communiquées. Il doit donc s'agir d'une déclaration très stricte et tout à fait complète. Une formulation analogue à celle de la Règle 23 de la CBE pourrait servir de fil conducteur pour cette exigence de déclaration.

La Section "Propriété industrielle" demande donc une adaptation: “A declaration requirement shall be included in order to invoke the Grace period”.

3.4. Les droits des tiers

3.4.1. La proposition de compromis se lit comme suit :

“A mandatory scheme for the protection of 3rd party rights covering acts done completely independently from the applicant’s claimed invention and performed prior to and continued during the Grace period. Further, an optional clause allowing 3rd party rights in the situation where a 3rd party in good faith, used the information derived from the use of the grace period by the applicant, for the purpose of his business. However, a grandfathering clause shall be included allowing the current practice to continue for the time being for parties not providing or providing a different form of 3rd party rights.”

La proposition de compromis prévoit en fait une double protection des droits des tiers:

3.4.2. Remarques de la Section "Propriété industrielle"

3.4.2.1. Une protection obligatoire des droits des tiers pour les actes exécutés de manière entièrement indépendante, avant et pendant la période de grâce.

La Section "Propriété industrielle" signale que cette disposition porte sur la “prior use exception” 12. La proposition est en ce sens ambiguë puisqu'il s'agit d'actes qui ont été exécutés de manière entièrement indépendante, avant et durant la période de grâce, par des tiers de bonne foi. Ce cas ne porte donc pas sur la période de grâce.

La « prior use exception » doit également viser des actes qui ont commencé durant la période de grâce. A défaut, la période de grâce devient un droit de priorité ce qui n'est pas admissible.

11 La règle 23 CBE dispose que: “Attestation d’exposition - Le demandeur doit, dans un délai de quatre mois à compter du dépôt de la demande de brevet européen, produire l’attestation visée à l’article 55, paragraphe 2, délivrée au cours de l’exposition par l’autorité chargée d’assurer la protection de la propriété industrielle dans cette exposition et constatant que l’invention y a été réellement exposée. Cette attestation doit, en outre, mentionner la date d’ouverture de l’exposition et, le cas échéant, celle de la première divulgation de l’invention si ces deux dates ne coïncident pas. L’attestation doit être accompagnée des pièces permettant d’identifier l’invention, revêtues d’une mention d’authenticité par l’autorité susvisée”.

12 L’article 30 de la loi du 28 mars 1984 sur les brevets d’invention est libellé comme suit: “§ 1. Toute personne qui avant la date de dépôt ou de priorité d’un brevet, utilisait ou possédait de bonne foi sur le territoire belge l’invention, objet du brevet, a le droit, à titre personnel, d’exploiter l’invention malgré l’existence du brevet.”
3.4.2.2. Un régime facultatif des droits des tiers dans le cas où le tiers utilise, de bonne foi, uniquement pour son commerce, l'information dérivée de l'utilisation de la période de grâce par le demandeur de brevet.

La Section "Propriété industrielle" signale que cette règle insère une forme de protection au bénéfice des tiers de bonne foi. Cela pourrait cependant encourager des concurrents à prendre des mesures préparatoires lorsque l'on soupçonne que le concurrent va déposer une demande de brevet.

La demande de brevet (européen) est seulement publiée après un délai de 18 mois suivant la date de dépôt/priorité, après quoi les tiers ont accès au contenu du dossier. Vu l'introduction de la période de grâce, les tiers doivent attendre 6 mois ou un an de plus.

La Section "Propriété industrielle" souligne l'importance de l'identification de la personne qui a commencé le commerce ou qui a fait des préparatifs. Actuellement, la structure juridique des entreprises n'est plus la même durant 20 ans. La règle actuelle a été insérée à une période de stabilité industrielle. La possibilité de transfert doit être examinée.

La Section "Propriété industrielle" estime cependant qu'une telle disposition devrait être obligatoire et pas uniquement facultative.

3.4.2.3. Les parties qui ne prévoient pas de période de grâce ou une autre forme de période de grâce pourront continuer cette pratique (clause dite du grand-père).

4. Conclusion concernant la période de grâce

En principe, la Section "Propriété industrielle" n'est pas favorable à l'introduction de la période de grâce.

Si, en vue de l'harmonisation internationale du droit matériel des brevets, une période de grâce devait malgré tout être insérée, les conditions de la période de grâce devraient être stipulées de la manière la plus stricte possible:

4.1 une période de grâce de 6 mois maximum;

4.2 les conditions de la publication doivent être déterminées clairement;

4.3 une déclaration obligatoire doit être insérée pour se prévaloir de la période de grâce;

4.4 droits des tiers:
- la "prior use exception" n'est pas l'objet d'une véritable période de grâce;
- la protection facultative doit être développée, notamment en ce qui concerne l'obtention des informations durant la période de grâce, et rendue obligatoire.
B. Demandes PCT concurrentes (Article 8 (2) (b))

1. La proposition de compromis se lit comme suit :

"Concerning Art. 8 (2) (b) 
Treatment of conflicting PCT applications  
PCT applications shall form part of the secret prior art from the filing/priority date upon designation".

La demande internationale est, si elle est prise en considération, considérée comme faisant partie de l’état de la technique à partir de sa date de dépôt ou de priorité.

Cette question concerne les conditions dans lesquelles la demande internationale (toujours avec effet rétroactif jusqu’à la date de priorité) fera partie de l’état de la technique.

Soit, c’est le cas par le seul fait de la publication internationale. Dans ce cas, la demande internationale fera partie de l’état de la technique dans tous les pays désignés, sans qu’aucune formalité ne soit exigée à cet effet. Soit, elle fera partie de l’état de la technique si elle entre régulièrement dans la phase nationale, c’est-à-dire lorsque toutes les formalités ont été effectuées. Dans cette deuxième hypothèse, il est possible qu’un deuxième demandeur reçoive un brevet dans un autre pays, c’est-à-dire dans un pays où la demande internationale n’est pas entrée en phase nationale.  

2. Le système actuel

Dans le système selon la CBE, le déposant doit avoir effectué au moins un ou plusieurs actes déterminés (selon la version de la CBE applicable) pour que sa demande internationale soit prise en compte dans l’état de la technique (avec sa date de priorité). Lorsque la CBE2000 entrera en vigueur, il suffira de payer la taxe de dépôt visée à la règle 159, paragraphe 1 c), soit celle prévue par l’article 78, paragraphe 2.

Le système actuel a les conséquences suivantes:

(i) l’état de la technique est différent d’un pays à l’autre;
(ii) le second déposant conserve alors la possibilité d’obtenir dans un autre pays un brevet européen;
(iii) mais la procédure d’examen est retardée, parce que l’état de la technique ne peut être déterminé avant qu’il puisse être définitivement vérifié pour toutes les demandes internationales concernées si et où les actes requis ont (ou n’ont pas) été accomplis; le retard est d’au moins 13 mois (et peut aller jusqu’à 18 mois selon les actes requis).

13 La nature des formalités exigées varie d’un Etat membre à l’autre mais en principe le demandeur doit au moins effectuer une formalité (CBE: taxe nationale et traduction éventuelle; CBE 2000: taxe de dépôt).
3. Le système proposé par l'article 8(2)(b)

Dans le système proposé par l'article 8(2)(b) du projet de SPLT et repris dans la proposition de compromis de la présidente du groupe de travail 1 du groupe B+, il suffit que la demande internationale soit publiée en vertu de l'article 21 PCT pour être prise en compte dans l'état de la technique (avec sa date de priorité, et dans tous les Etats contractants du PCT vu la désignation automatique).

Reprenant la subdivision ci-dessus, l'article 8(2)(b) a les conséquences suivantes:

(i) l'état de la technique est harmonisé (dans les Etats membres du PCT, mais il est en principe prévu que les Etats adhèrent au SPLT s'ils sont déjà membres du PCT);
(ii) le second déposant n'a plus la possibilité d'obtenir un brevet; et
(iii) la procédure d'examen n'est pas retardée.

Il est clair que cette solution renforce les droits du premier déposant (principe de base d'un SPLT).

4. Point de vue de la minorité des membres de la Section "Propriété industrielle"

Si l'on opte pour une approche globale uniformisée au niveau mondial (approche horizontale), le contenu de demandes PCT antérieures déterminera la nouveauté des demandes ultérieures, sans l'exigence d'indication effective de pays.

Il est crucial que l'assimilation à l'état de la technique des demandes de brevets antérieures mais pas encore publiées ne se pose que dans un cadre juridique relatif aux brevets qui applique comme principes de base la nouveauté absolue et le "first to file". Le droit européen a opté pour ces deux principes de base.

Si l'on optait également au niveau mondial pour ces deux principes de base du droit des brevets, la solution d'un effet global mondial des demandes PCT antérieures est envisageable. Cependant, tant que ce n'est pas le cas, concrètement, tant que les Etats-Unis maintiennent le "first to invent", et une forme complexe de nouveauté, le problème de la double brevetabilité se pose d'une toute autre manière. Transposer la solution à ce problème, comme nous la connaissions dans la Convention actuelle sur le brevet européen ou la CBE 2000, dans un contexte juridique tout à fait différent, concrètement un contexte sans nouveauté absolue et "first to file", est un non-sens.

Dans la situation actuelle, une approche verticale est défendable selon laquelle la demande PCT doit être entrée en phase nationale et ne fera partie de l’état de la technique que pour les pays dans lesquelles elle est entrée en phase nationale.

5. Point de vue de la majorité des membres de la Section "Propriété industrielle"
5.1. La question du délai souffert le cas échéant par la procédure d'examen n'est pas anodine. Les demandeurs ont droit à ce que leurs demandes soient examinées dans un délai raisonnable, ce qui ne peut être fait (même en cas de requête en accélération, PACE) tant que l'état de la technique n'est pas connu. Les tiers aussi ont un intérêt indéniable à ce qu'une décision, positive ou négative, soit prise dans un délai raisonnable. Statistiquement, l'industrie belge est le plus souvent un tiers, ce qui fait pencher la balance en faveur de l'article 8(2)(b).

5.2. Accepter volontairement que pour une demande internationale donnée l'état de la technique soit différent d'un État désigné à l'autre serait contraire à l'esprit d'une harmonisation internationale: en quoi, par exemple, l'harmonisation de la définition de la nouveauté sert-elle l'harmonisation si l'état de la technique est différent ? Les déposants ont un grand intérêt à l'harmonisation, et l'intérêt des tiers n'est pas négligeable non plus (ils ne sont plus confrontés à des demandeurs/propriétaires différents ayant des droits différents). Ceci joue également en faveur de l'article 8(2)(b).

5.3. Pour une partie importante des entreprises, l'article 8(2)(b) est acceptable car elles n'ont pas besoin d'obtenir de brevet si la liberté d'exploitation est acquise. C'est d'autant plus vrai qu'aujourd'hui quasiment aucune entreprise ne valide dans tous les États membres de l'Union européenne, a fortiori dans tous les États contractants de la CBE.

Par contre, un nombre limité d'entreprises préférera la situation actuelle, et renoncera à l'exploitation si le monopole ne peut être garanti pendant une durée suffisante pour amortir d'importants frais fixes. A priori, il semble que ce soit exclusivement le cas pour l'industrie pharmaceutique, hors génériques.

Toutefois, il faut envisager la situation à l'échelon mondial. Dans un monde harmonisé, c'est-à-dire où cette matière serait harmonisée, il faut envisager la situation globale.

La seconde différence essentielle tient dans la nature des actes que le premier déposant doit accomplir pour que sa demande entre dans l'état technique, et donc qu'elle fasse obstacle à l'obtention d'un brevet par un second déposant.

Avec l'article 8(2)(b), il suffit au premier déposant de déposer une demande internationale pour que sa publication en vertu de l'article 21 PCT (qui n'entraîne pas de frais) empêche le second déposant d'obtenir un brevet. Le premier déposant s'est assuré à moindres frais qu'aucune demande de brevet postérieure dans aucun État contractant du PCT (et du SPLT) ne peut l'empêcher d'exploiter son invention.

Dans la situation actuelle, le premier déposant doit accomplir, dans la plupart des États contractants du PCT, une ou plusieurs des formalités d'entrée en phase nationale, voire poursuivre l'examen jusqu'à la délivrance, s'il veut atteindre le même résultat.
5.4 En conclusion, il semble qu'il faille donc mettre en balance
- l'avantage conféré à un certain type d'industrie par une possibilité supplémentaire d'obtenir un brevet
  
avec
  
- l'avantage conféré par l'harmonisation de l'état de la technique,
- l'avantage conféré par la connaissance précoce de l'état de la technique, et
- l'avantage conféré aux entreprises exportant en dehors des Etats contractants de la CBE, par la possibilité d'empêcher à moindre coût l'obtention d'un brevet par le second déposant, le tout dans un monde harmonisé (premier déposant, abandon de la doctrine Hilmer, etc...).

6. Conclusion sur la proposition de compromis concernant les demandes PCT concurrents

Il n'y a pas de consensus au sein de la Section "Propriété industrielle" concernant cet aspect de la proposition de compromis.

La minorité des membres de la Section "Propriété industrielle" estime que l’état de la technique doit être pris en considération à partir de la date de priorité ou de la date de dépôt à condition que le brevet soit entré de manière régulière dans la phase régionale.

La modification de texte suivante est proposée par la minorité des membres de la Section "Propriété industrielle":

"Concerning Art. 8 (2) (b)
Treatment of conflicting PCT applications
PCT applications shall form part of the secret prior art from the filing/priority date provided that the PCT application is entered valid in the designated territory”.

Une large majorité des membres de la Section "Propriété industrielle" considère que l’équilibre entre les avantages et les inconvénients démontre que telle qu’elle est présentée dans la proposition de compromis, la version de l’article 8 (2) (b) est préférable en ce qu’elle renforce les droits du premier déposant au niveau mondial. En plus, il ne convient pas de recommander une version de l’article 8 (2) (b) qui exige plus que ce que n'exigera la CBE 2000 dès son entrée en vigueur (sans doute le 13.12.2007), à savoir le simple paiement d'une taxe de dépôt.

C. DEMANDES ANTERIEURES NON PUBLIEES ET ANTI-SELF-COLLISION (Article 8 (2), 12 (3) et Règle 9 (3))

1. La proposition de compromis se lit comme suit :

"Provisions Concerning Prior Published Applications
Art. 8 (2) and 12 (3) Inventive step/non-obviousness

A mandatory provision introducing a concept where secret prior art is taken into account for both novelty and inventive steps. However, for inventive step the parties to this agreement will be free to determine the extent to which a single item of secret prior art may be combined with other items of secret or public prior art. Secret prior art would be included for the purpose of evaluating inventive step, but there are a number of options as to how that art is applied. That is, excluding any combination of documents, i.e. no “mosaicing”, excluding a combination with other items of secret prior art but allowing combination with public prior art or allowing combination with any secret prior art. Consideration of secret prior art for inventive step would be a significant step toward harmonisation but in the absence of agreement on a single approach to combining documents it may be preferable to allow some flexibility in approach until a best practice is agreed.

Concerning Rule 9 (3) Anti-self-collision

A mandatory provision on anti-self-collision. However, any application benefiting from anti-self-collision with respect to another application may be subject to a requirement of common ownership and limitation of term to that of the other application. It is recognised that anti-self-collision is subject to right of offices to grant only one patent with respect to two or more applications to the extent they claim identical subject matter.”

La proposition de compromis implique que les demandes précédentes seront considérées comme état secret de la technique pour l'évaluation tant de la nouveauté que de l'activité inventive.

Dans la plupart des systèmes de brevets, une demande de brevet est tenue secrète durant la période entre le dépôt et la publication. Cette demande ne fait pas partie de l'état de la technique accessible au public par rapport à une demande ultérieure pour la même invention ou une invention similaire. La demande antérieure est un “prior right”. Une double brevetabilité est évitée en prenant en compte la demande antérieure lors de l'évaluation de la brevetabilité de la demande ultérieure.

Il existe deux systèmes: d'une part, l'approche “prior claim” et d'autre part, le “whole content”. Dans l'approche “prior claim”, seul le contenu revendiqué (revendications) de la demande antérieure est pris en considération. Dans la Convention sur brevet européen, le
“whole content approach” est appliqué. Selon ce système, l'ensemble du contenu de la demande antérieure fait partie de l'état de la technique à partir de l'introduction ou de la date de priorité. L'effet de cette approche de l'ensemble du contenu est tempéré en limitant son application à l'évaluation de la nouveauté et en ne l'utilisant pas pour l'évaluation de l'activité inventive.

Il existe un fossé entre le système des États-Unis où les demandes antérieures sont prises en considération pour évaluer tant la nouveauté que l'activité inventive et les autres pays qui tiennent uniquement compte des demandes antérieures secrètes pour l'évaluation de la nouveauté.

La proposition de compromis est approuvée par plusieurs pays car elle déboucherait sur des brevets plus forts et de meilleure qualité, vu la diminution des “patent thickets”, une protection étant uniquement conférée aux inventions véritablement nouvelles et inventives. Il est illogique que différentes normes soient utilisées pour évaluer la nouveauté et l'activité inventive.

Les arguments contre la proposition sont que le problème de la qualité n’est pas résolu en examinant l’état secret de la technique lors de l’évaluation de l’activité inventive, ce qui déboucherait sur une pratique selon laquelle des demandes de brevets trop larges seraient introduites à l’office des brevets. Si cette mesure est encore combinée à "l’anti-self collision", le premier inventeur se trouve dans une situation où il dispose d’un monopole dans l’ensemble du domaine décrit dans la première demande/domaine de la recherche. Cela entraînerait un désavantage concurrentiel pour les autres opérateurs de marché.

« L’anti-self-collision » est une exigence des États-Unis et peut uniquement être considérée en même temps que « l’inventive step/non obviousness ». Cette problématique est mise en rapport avec la problématique des « patent thickets ».

2. Remarques de la Section "Propriété industrielle" sur les demandes préalables non publiées et « l’anti-self-collision »

La Section "Propriété industrielle" fait remarquer que la proposition ne résout pas le problème de la qualité. Il s’agit de cas exceptionnels car, dans la grande majorité des demandes, il n’y a pas de conflit.

Toutefois, si l’invention diffère quelque peu de la demande précédente, il n’y a en réalité aucune raison de ne pas y avoir droit. En effet, une nouveauté a été pensée. Des problèmes se présentent dans certains secteurs où la nouveauté est “photographique”2. La stratégie de certaines entreprises est de déposer une nouvelle invention et ensuite d’ajouter de légères améliorations basées sur la première invention. Mais seul le déposant peut le faire, pas les tiers. Il s’agit donc de “patent thickets”. En réalité, 25 brevets sont demandés pour la même invention. La présente proposition est faite pour éviter cette stratégie.
En outre, dans le cadre des inventions de sélection, la jurisprudence de l'OEB est fortement en faveur du deuxième dépositaire (brevet de perfectionnement). Le problème doit donc être vu dans une plus large perspective, à savoir la position concurrentielle de l'Europe vis-à-vis des États-Unis et du Japon où le titulaire de brevet est en général mieux protégé. Les entreprises européennes utilisent le système européen à leur avantage. Il n'y a aucun problème avec les brevets d'amélioration car cela n'est pas considéré comme un abus. En raison des possibilités limitées, des “patent thickets” sont utilisés en pratique. Si cet avantage disparaît, tout le reste doit être harmonisé. Mais nous ne vivons pas dans un système harmonisé.

Les États-Unis sont en outre isolés dans leur point de vue. Les raisons d’être du système européen sont le principe du first to file et le principe de la nouveauté absolue. Aucun élément ne peut être harmonisé si nous sommes confrontés à système juridique tout à fait différent. Nous devons harmoniser la nouveauté absolue et le “first to file” et ensuite harmoniser éventuellement les détails.

3. Conclusion de la Section "Propriété industrielle" concernant les demandes non publiées et « l'anti-self-collision »

3.1. La Section "Propriété industrielle" conclut que le principe de l’état secret de la technique ne peut pas être pris en considération pour l’évaluation de l’activité inventive, mais uniquement pour évaluer la nouveauté.

La proposition de compromis sur ce point n'est pas acceptable, pour les raisons suivantes:

- la raison de l'augmentation de la qualité du brevet n'est pas pertinente;

- l'inconvénient des “patent thickets” n'est pas proportionnel aux désavantages de la solution proposée;

- une véritable solution consiste en une adaptation de l'interprétation de l'expert (homme de métier) appliquée par l'OEB, sur la base de la connaissance de son métier.;

- on ne peut pas affaiblir le système européen.

3.2. Si, dans le cadre d'une solution de compromis, on acceptait malgré tout la proposition sur ce point, des conditions très strictes devraient être appliquées. De toute façon, cette option ne peut être soutenue que dans la supposition d'un droit matériel des brevets harmonisé au niveau mondial.

3.3. En outre, l'intérêt d'harmoniser l'interprétation de la nouveauté est souligné. Le principe d’"enlarged novelty” est complètement rejeté par tous les États membres car un nouveau concept juridique peut entraîner des interprétations contradictoires.
3.4. Le concept de l'homme de métier a évolué avec la jurisprudence de l'Office européen des brevets, celle-ci étant maintenant assimilée au spécialiste du laboratoire (T 26/85 et T 677/91). Le concept de l'expert devrait être mieux défini.

D. Abrégé et contenu complet (Règle 9 (1) (a))

1. La proposition de compromis se lit comme suit :

   "Concerning Rule 9(1)(a)
   Abstract and Whole content
   The abstract shall not form part of the “whole Contents”. Furthermore the content of the secret prior art shall be defined as the content of the application at the filing date”.

Selon cette proposition, l'abrégé ne fera pas partie du “whole content”. Le contenu de l'état secret de la technique sera considéré comme le contenu de la demande à la date d'introduction.

L’abrégé a une fonction d'information et ne peut pas faire partie de la partie juridique contraignante (“whole content”) de la demande de brevet puisque cela aurait des conséquences négatives. En outre, cette prise de position est conforme à l'article 3 (3) PCT. D'un point de vue pratique, il est aussi beaucoup plus simple que l'abrégé ne fasse pas partie du "whole content".

2. Avis de la Section "Propriété industrielle":

La Section "Propriété industrielle" estime que l'abrégé n'est pas important en pratique. Il serait compliqué de regarder dans le dossier ce qu'était "l'abrégé" tel qu'il était initialement introduit car il peut ensuite être modifié par le demandeur de brevet ou l'office de brevet.

E. UTILISATION EXPERIMENTALE (Article 9 (4))

1. La proposition de compromis se lit comme suit :

   "Concerning Art. 9 (4)
   Experimental use
   No provision on experimental use14."

Il est proposé de ne pas insérer de disposition sur l'utilisation expérimentale.

Ce point concerne la question de savoir si une exception à l'état de la technique doit être prévue, uniquement sur base de la nature de l'invention (parce que l'invention doit être testée).

14 “Use of the claimed invention by the applicant that would otherwise affect the patentability of the claimed invention shall not affect the patentability of that invention, in so far as the use of the claimed invention by the applicant was experimental” (Source: USPTO Trilateral Proposal, p. 29).
Dans ce domaine, aucune concession ne devrait être faite. Cette proposition peut donc être soutenue.

2. L’avis de la Section "Propriété industrielle" est le suivant :

Les règles générales relatives à la définition de la nouveauté sont suffisantes. Soit parce que l'expérience est secrète et qu'elle ne fait pas partie de l'état de la technique. Soit parce qu'elle a été exécutée publiquement et détruit alors la nouveauté de l’invention.

F. DEFINITION DE L’ETAT DE LA TECHNIQUE – UTILISATION SECRÈTE PREALABLE À DES FINS COMMERCIALES

1. La proposition de compromis se lit comme suit :

“Concerning Art. 8
Definition of prior art – Secret commercial prior use
No provision on secret commercial prior use.”

Il est proposé de ne pas introduire de disposition sur l'utilisation secrète antérieure à des fins commerciales. Cette proposition peut aussi être soutenue.

2. L’avis de la Section "Propriété industrielle" est le suivant :

Si l'utilisation n'est pas accessible au public, elle ne fait pas partie de l'état de la technique. Si elle est rendue accessible au public, elle porte préjudice au caractère de nouveauté. Il faut éviter que des dispositions spécifiques définissent ce qui fait partie ou non de l'état de la technique.

G. ACTIVITÉ INVENTIVE

1. La proposition de compromis se lit comme suit :

“Concerning Art. 12 (3)
Inventive step/non-obviousness
No elements of methodology shall be included at the article level, and thus the term “the differences between the claimed inventions” shall be removed from the draft.”

Il est proposé de ne pas insérer de méthode d'évaluation de l'activité inventive dans le projet de texte de traité. Les mots “the differences between the claimed inventions” seront retirés du projet.

15 “An invention that was placed on sale by the inventor, the successor in title, or the applicant or was secretly used in a commercial manner by the inventor, successor in title or the applicant more than 12 months preceding the priority date of the claimed invention shall form part of the prior art with respect to the claimed invention, even if the invention was not, by virtue of being so placed on sale or secretly used, made available to the public”.

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2. L’avis de la Section "Propriété industrielle" est le suivant :

Si l’on doit décider d’une méthode, il est peut-être préférable de reprendre une méthode de l’OEB. Il sera difficile d’harmoniser cette question au niveau mondial. La Section "Propriété industrielle" estime que des éléments de méthodologie ne doivent pas être repris dans le projet de texte de traité.

H. AVIS GENERAL DE LA SECTION "PROPRIETE INDUSTRIELLE" :

La Section "Propriété industrielle" estime que les principes exposés dans la proposition actuelle en vue des discussions futures de la présidente du groupe de travail 1 du groupe B+ (harmonisation droit des brevets) sont un ensemble déséquilibré et que le prix à payer par les pays européens pour que les États-Unis passent à un système “first to file” est trop élevé. Il faut éviter d’atteindre une harmonisation qui introduit en fait un système mixte et incohérent.

La Section "Propriété industrielle" estime que la proposition actuelle de la présidente n’est pas acceptable comme compromis global.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
a. Yes, provided that the secret prior art is an application filed in the Brazilian National Institute of Industrial Property (INPI/BR) or a national phase of an international application filed in accordance with a treaty or convention in force in Brazil and published, even if subsequently, by the INPI/BR.

### a.

<table>
<thead>
<tr>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
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<tr>
<td>The entire contents of the secret prior art.</td>
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<th>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</th>
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<td>Yes, the standard for evaluation of novelty is the same applied to publicly available prior art.</td>
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<tr>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
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<td>No</td>
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<th>Please Explain</th>
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<tr>
<td>Not applicable.</td>
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<tr>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
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<td>Not applicable.</td>
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<tr>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *</th>
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<tr>
<td>Not applicable.</td>
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The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only * if such a combination is possible in the scenario presented. * * |

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<th>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
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<tr>
<td>Not applicable.</td>
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### c.

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<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
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<th>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</th>
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<td>No</td>
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Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Yes. The Art. 11 § 3º of the Brazilian Industrial Property Law (LPI – Law No. 9.279/1996) states that the entire content of the secret prior art from an international application shall be considered for novelty purposes as long as the national phase has entered and published, even if subsequently, by the INPI/BR.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Yes, provided that the secret prior art is an application filed in the Brazilian National Institute of Industrial Property (INPI/BR) or a national phase of an international application filed in accordance with a treaty or convention in force in Brazil and published, even if subsequently, by the INPI/BR.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content of the secret prior art.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The entire content of the secret prior art.

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
There is no anti-self collision time of period.

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
</tr>
<tr>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td>Not applicable.</td>
</tr>
<tr>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</td>
<td>Not applicable.</td>
</tr>
<tr>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
<td>Not applicable.</td>
</tr>
<tr>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td>Not applicable.</td>
</tr>
<tr>
<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
<td>No</td>
</tr>
</tbody>
</table>

If the secret prior art is an international application filed designating your jurisdiction:

<table>
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<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</td>
<td>Not applicable.</td>
</tr>
</tbody>
</table>
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes. The Art. 11 § 3º of the Brazilian Industrial Property Law (LPI – Law No. 9.279/1996) states that the entire content of the secret prior art from an international application shall be considered for novelty purposes as long as the national phase has entered and published, even if subsequently, by the INPI/BR.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a
Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
different

Please Explain

- same as Question 1 X
- same as Question 2 X

3.b
Same applicant on the dates of filing, no common inventor:
different

Please Explain

- same as Question 1 X
- same as Question 2 X

3.c
Different applicants on the dates of filing, same inventors:
different
II. Policy considerations and proposals for improvements of your current law

Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

1. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

2. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

3. The treatment of international applications as secret prior art.
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

4.d The treatment of total and partial identity of applicants as it relates to secret prior art.

4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

4.f Provisions for avoiding self-collision.

4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

III. Proposals for harmonisation

Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

7 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire content of the secret prior art.
7.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, the standard for evaluation of novelty shall the same applied to publicly available prior art.

7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

7.b. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

Not applicable.

7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Not applicable.

7.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Not applicable.

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain
For the purpose of determining novelty we understand that a good harmonization statute is that:

The entire content of a national phase of an international application filed in one country shall be considered as state of art from the international filing date or the earliest claimed priority, as long as it is published, even if subsequently, in said country.

7.c.iii
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a
Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a.i
If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content.

8.a.ii
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, the standard for evaluation of novelty shall be is the same applied to publicly available prior art.

8.a.iii
If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There would be no anti-self collision time of period.

8.b
Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain
If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Not applicable.

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Not applicable.

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Not applicable.

If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Not applicable.

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain
For the purpose of determining novelty we understand that a good harmonization statute is that:

The entire content of a national phase of an international application filed in one country shall be considered as state of art from the international filing date or the earliest claimed priority, as long as it is published, even if subsequently, in said country.

8.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

different

Please Explain

o same as Question 7 X

o same as Question 8 X

9.b Same applicant on the dates of filing, no common inventor:

different

Please Explain

o same as Question 7 X

o same as Question 8 X

9.c Different applicants on the dates of filing, same inventors:

different

Please Explain

o same as Question 7 X

o same as Question 8 X

9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?
9.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
different
Please Explain
- same as Question 7
- same as Question 8

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
No
Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain

9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:
different
Please Explain
- same as Question 7
- same as Question 8

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:
different
Please Explain
- same as Question 7
- same as Question 8

Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.
Please indicate which industry sector views are included in your Group’s answers to Part III.
Study Question
Submission date: April 30, 2018
Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Bulgaria
Contributors name(s): Silviya Todorova and Valentina Nesheva
e-Mail contact: ystrateva@sabevandpartners.com

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

According to Art. 8(1)(3) of Law on Patents and Registration of Utility Models (LPRUM) such secret prior art includes only the content of the
national patent applications, European patent applications and international patent applications for which Bulgaria is a designated country and only if they are published. Moreover the state of art includes as well the content of the national utility model applications if they are published.

**1.a.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Entire contents will be available after the publication of the application.

**1.a.** If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

According to Art. 8. (1) An invention shall be considered to be new if it does not form part of the state of the art. (2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, anywhere in the world, before the filing date or the priority date, as appropriate, of the patent application.

**1.b.** Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

**1.b.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

**1.b.** If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * 

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

**1.b.** If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

**1.c.** If the secret prior art is an international application filed designating your jurisdiction:

**1.c.** Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

The state of the art shall comprise also the content of all national patent applications, the European and international patent applications designating the Republic of Bulgaria, of which the filing date or priority date is earlier than the filing or priority date of the subject patent
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application, provided that after that they are published in the Official Bulletin of the Patent Office.

1.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Concerning inventive step, it does not matter if the international patent application enters the national phase in Bulgaria. Only the publication of this international application matters because the publication makes a document to be a prior art or not.

Concerning novelty, it matters if the international patent application enters the national phase in Bulgaria. The international applications should be published in the Official Bulletin of the Patent Office.

1.c.ii

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Concerning inventive step, it does not matter if the international patent application enters the national phase in Bulgaria. Only the publication of this international application matters because the publication makes a document to be a prior art or not.

Concerning novelty, it matters if the international patent application enters the national phase in Bulgaria. The international applications should be published in the Official Bulletin of the Patent Office.

1.c.iii

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

According to art. 70 (2) of LPRUM the international application may entry into the national phase within 31 months of the priority date.

2

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

For the examination of the novelty of a patent application only the fact of publication of a secret prior art matters and not to whom belongs this secret prior art. There are only two cases where the disclosure does not affect the novelty and these are:

1. Obvious abuse with regard to the applicant or the owner of the right to file the patent application.

2. Displaying the invention at an officially recognized exhibition by the applicant or the owner of the right to file the patent application.

However this disclosure must have been made not earlier than six months before the filing or priority date of the subject patent application.

2.a.i

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The whole content.
<table>
<thead>
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<tbody>
<tr>
<td>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
<td>Same as answer No 1.ii</td>
</tr>
<tr>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td>No. Only in case of obvious abuse there is such anti-collision period of six months but the abuse needs to be proved.</td>
</tr>
<tr>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
</tr>
<tr>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</td>
<td></td>
</tr>
<tr>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
<td></td>
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<tr>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
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<tr>
<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
<td>Yes</td>
</tr>
<tr>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
</tr>
<tr>
<td>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</td>
<td></td>
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<tbody>
<tr>
<td><strong>Yes</strong></td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>Same as 1.c.ii</td>
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<tbody>
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<td><strong>No</strong></td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>Same as 1.c.iii</td>
</tr>
</tbody>
</table>

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

### 3.a
Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain

It does not matter if the applicant(s) or inventor(s) are the same or different. Only the contents of both examined patent applications matter.

### 3.b
Same applicant on the dates of filing, no common inventor:

same as Question 2

Please Explain

### 3.c
Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain
## II. Policy considerations and proposals for improvements of your current law

### 4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

#### 4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

- No
  - Please Explain

#### 4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

- No
  - Please Explain

#### 4.c. The treatment of international applications as secret prior art.

- No
  - Please Explain
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

   If YES, please respond to the following questions without regard to your Group’s current law or practice.
   
   Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

   No

   Even if NO, please address the following questions to the extent your Group considers your Group

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.
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7.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

The purpose of a patent is to reserve an exclusive right to the person who has invented a solution to a technical problem. This solution has to be novel and inventive. If a secret prior art is not available for novel defeating purposes it will contradict the whole idea of granting a patent.

7.a If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents should be available because claims can cover only part of the disclosure and the originally filed claims can be changed later.

7.a If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, it should be the same

7.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The concept of inventive step necessarily includes the figure of the skilled person. How can the skilled person possibly arrive at the solution of the subject patent application combining two or more documents of the prior art if one or more of these documents was secret at the date of filing or priority of the subject patent application.

7.b If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

7.b If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c If the secret prior art is an international application filed designating your jurisdiction:
7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Concerning inventive step, it does not matter if the international patent application enters the national phase in Bulgaria. Only the publication of this international application matters because the publication makes a document to be a prior art or not.

Concerning novelty, it matters if the international patent application enters the national phase in Bulgaria. The international applications should be published in the Official Bulletin of the Patent Office.

7.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a.i. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents.

8.a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

It should be the same.
If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

The anti-self collision time period during which the secret prior art is not available is until the publication of the patent application.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

Yes

Please Explain

According to Art. 72g. (1) In the case of an invention disclosed in both a national patent and a European patent designating the Republic of Bulgaria, both patents having the same filing date, respectively the same priority date, and belonging to the same person or his successor in title, the national patent effect shall cease.

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain
8.c. **Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

Yes

Please Explain

Concerning inventive step, it does not matter if the international patent application enters the national phase in Bulgaria. Only the publication of this international application matters because the publication makes a document to be a prior art or not.

Concerning novelty, it matters if the international patent application enters the national phase in Bulgaria. The international applications should be published in the Official Bulletin of the Patent Office.

8.c. **Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

No

Please Explain

9. **Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.**

9.a **Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

same as Question 8

Please Explain

9.b **Same applicant on the dates of filing, no common inventor:**

same as Question 8

Please Explain

9.c **Different applicants on the dates of filing, same inventors:**

same as Question 7

Please Explain

9.d **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain
9.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

9.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

11. Please indicate which industry sector views are included in your Group’s answers to Part III.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
The answers to the below questions are based on Guatemalan law

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</tr>
</thead>
<tbody>
<tr>
<td><strong>1.a.i</strong></td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td></td>
<td>The entire contents of the secret prior art are available</td>
<td></td>
</tr>
<tr>
<td><strong>1.a.ii</strong></td>
<td>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Yes, it is the same. It comprises every divulged or accessible information to the public in any place of the world, any language and by any means, before the filing date or priority date.</td>
<td></td>
</tr>
<tr>
<td><strong>1.b</strong></td>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>Yes</td>
</tr>
<tr>
<td><strong>1.b.i</strong></td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td>The entire contents of the secret prior art are available.</td>
</tr>
<tr>
<td><strong>1.b.ii</strong></td>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *</td>
<td>The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.</td>
</tr>
<tr>
<td></td>
<td>Yes.</td>
<td></td>
</tr>
<tr>
<td><strong>1.b.iii</strong></td>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
<td>Yes.</td>
</tr>
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<td></td>
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<tr>
<td><strong>1.c</strong></td>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
</tr>
<tr>
<td><strong>1.c.i</strong></td>
<td>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td>Question</td>
<td>Answer</td>
<td>Explanation</td>
</tr>
<tr>
<td>-------------------------------------------------------------------------</td>
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</tr>
<tr>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?</td>
<td>Yes</td>
<td></td>
</tr>
<tr>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td>Yes. The entire contents of the secret prior art are available.</td>
<td></td>
</tr>
<tr>
<td>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
<td>Yes, it is the same. It comprises every divulged or accessible information to the public in any place of the world, any language and by any means, before the filing date or priority date.</td>
<td></td>
</tr>
<tr>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td>Yes, there is an anti-self collision time period; the time period is 1 year and comprises any divulgation made by the inventor, their successor in title; if said divulgation is a consequence of a breach of contract made by a third party or an unlawful/wrongful act committed against them.</td>
<td></td>
</tr>
<tr>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>Yes</td>
<td></td>
</tr>
</tbody>
</table>
2.b.ii
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

Yes.

2.b.iii
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

Yes

2.b.iv
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Yes, there is an anti-self collision time period; the time period is 1 year and comprises any divulgation made by the inventor, their successor in title; if said divulgation is a consequence of a breach of contract made by a third party or an unlawful/wrongful act committed against them.

2.b.v
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

Yes

The law only indicates that the divulgation must be made by the inventor or the inventor’s successor in title.

2.c
If the secret prior art is an international application filed designating your jurisdiction:

2.c.i
Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

2.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.
3. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

3. Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

The contribution of the additional inventor would be affected by the secret prior art of the previous application.

3.b. Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

The secret prior art would affect the later-filed application.

3.c. Different applicants on the dates of filing, same inventors:

same as Question 2

Please Explain

Regarding Question 1, the anti-self-collision rules apply.

3.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3.e. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1

Please Explain

The contribution of the additional inventor would be affected by the secret prior art of the previous application.

<table>
<thead>
<tr>
<th>3.d.i</th>
<th>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain

<table>
<thead>
<tr>
<th>3.d.ii</th>
<th>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain

II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

Yes

Please Explain

Yes. The standard should not be the same standard for the evaluation of novelty.

4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

4.c. The treatment of international applications as secret prior art.

No

Please Explain

4.d. The treatment of total and partial identity of applicants as it relates to secret prior art.

Yes

Please Explain

---

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In order to avoid inequalities and to promote collaboration of new joint industry or industry-university research projects reforms should be introduced to apply reasonable exceptions considering such cases.

### 4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

Yes

Please Explain

In order to avoid inequalities and to promote collaboration of new joint industry or industry-university research projects reforms should be introduced to apply reasonable exceptions considering such cases.

### 4.f Provisions for avoiding self-collision.

Yes

Please Explain

In order to avoid inequalities and to promote collaboration of new joint industry or industry-university research projects reforms should be introduced to apply reasonable exceptions considering such cases.

### 4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

Yes

Please Explain

In order to avoid abuses of anti self-collision practices said limitations should include factors to determine when incremental inventions cannot seek protection in connection with same applicant’s earlier-filed application, e.g. affecting the unity of invention.

### 5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain

III. Proposals for harmonisation

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*

### 6 Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*
7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Yes, the entire contents of the secret prior art should be available.

7.a.i. If YES, should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, it should be the same standard applied to publicly available prior art.

7.a.ii. Should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Yes

Please Explain

7.a.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Yes, it should be combinable.

7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes

Please Explain

7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

7.b.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Yes. The entire contents of the secret prior art should be available.

7.b.ii. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Yes, it should be combinable.

7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?
Yes, it should be the same.

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c.i. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

7.c.ii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

7.c.iii. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a.i. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents should be available.

8.a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes.
**8.a.iii** If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Yes. It should be at least one year.

**8.b**

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
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<tbody>
<tr>
<td>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>Yes.</td>
</tr>
<tr>
<td>If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</td>
<td>The entire contents should be available.</td>
</tr>
<tr>
<td>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</td>
<td>Yes, it should be combinable with another prior art reference.</td>
</tr>
<tr>
<td>If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</td>
<td>Yes.</td>
</tr>
<tr>
<td>If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td>Yes; the time period should be at least 1 year prior to the later-filed application.</td>
</tr>
<tr>
<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
<td>Yes. Please Explain. Yes, and should include the above-mentioned to avoid double patenting e.g. using as reference the unity of invention of previous application.</td>
</tr>
</tbody>
</table>
### Question 3.6
If the secret prior art is an international application filed designating your jurisdiction:

- **Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.**
  - No
  - Please Explain

- **Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**
  - No
  - Please Explain

- **Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**
  - No
  - Please Explain

### Question 9
Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

- **Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:**
  - Same as Question 8
  - Please Explain

- **Same applicant on the dates of filing, no common inventor:**
  - Same as Question 7
  - Please Explain

- **Different applicants on the dates of filing, same inventors:**
  - Same as Question 8
  - Please Explain

- **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**
Yes

Please Explain

Answer b would change to same as Question 8.

9. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 8

Please Explain

9. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes

Please Explain

Depending on some factors to be determined on a case-by-case basis, answer b) could change to same as Question 8.

9. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

Yes

Please Explain

Yes. Answer b) would change to same as Question 8.

9. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 8

Please Explain

9. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 8

Please Explain

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

11. Please indicate which industry sector views are included in your Group’s answers to Part III.
Joint industry or industry-university R&D projects.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Section 28.2(1)(c) of the Canadian Patent Act states that the claimed subject matter in an application must not have been disclosed in “an application for a patent that is filed in Canada by a person other than the applicant, and has a filing date that is before the claim date.”

1.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available.

1.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is set out in Sanofi, 2008 SCC 61, and it is the same standard as publicly available prior art.

1.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

1.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

1.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

1.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

1.c If the secret prior art is an international application filed designating your jurisdiction:

1.c.i Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

1.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes
Please Explain

Yes, pursuant to Rule 59.1 of the Patent Rules, “an international application is deemed to be an instrument of record in the Patent Office when it becomes a PCT national phase application.” Emphasis added. So in order to apply Section 28.2(1)(c) of the Patent Act, the international application must have entered national phase in Canada.

Also, Rule 63 explicitly recites that “[a]n international application in which Canada is designated, or in which Canada is designated and elected, shall not be considered to be an application mentioned in paragraph 28.2(1)(c) of the Act… unless it has become a PCT national phase application.”

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Once a PCT application enters the national phase in Canada, the international filing date becomes the Canadian filing date. As noted above, secret prior art is available as prior art if its filing date is earlier than the claim date of the application.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Although Section 28.2 of the Patent Act requires that secret prior art be filed “by a person other than the applicant”, a judicial doctrine of double-patenting exists. This doctrine allows the secret prior art to be available against the claims in a limited scope, as discussed below.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Only the claims of an earlier issued patent are secret prior art against a pending application or later issued patent to the same applicant. Note that it is the earlier issue of the patent that makes its claims secret prior art against the pending application or later issued patent.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Each element in the claims of the pending application must be present in the claims of the earlier issued secret prior art. The same standard as publicly available prior art is used to evaluate novelty. The claim comparison is not done on a literal construction of the claims. Rather, Section 15.06 of the Manual of Patent Office Practice states “the claims are to be given a purposive construction based on a reading of the specification through the eyes of the skilled person, taking into account their common general knowledge.”

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes

Please Explain

Although Section 28.3 of the Patent Act requires that the claimed subject matter must not have been obvious having regard to “information disclosed before the claim date… in such a manner that the information became available to the public in Canada or elsewhere, a judicial doctrine of double-patenting exists. This doctrine allows the secret prior art to be available against the claims in a limited scope, as discussed below.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Only the claims of an earlier issued patent are secret prior art against a pending application or later issued patent to the same applicant. As with novelty, it is the earlier issue of the patent that makes its claims secret prior art against the pending application or later issued patent. In practice, however, Examiners will often cite a co-pending application as the basis for a “provisional” double patenting rejection. Such an objection serves as a warning of a likely double patenting objection should one of the applications issue to patent.

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

Yes

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

Yes

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

There are no terminal disclaimers or other restrictions that could be applied to avoid self-collision. When a rejection for double patenting is raised, under the same invention double patenting branch of the doctrine, the claims of identical scope must be deleted in all but one of the co-
pending applications. Under the obviousness-type double patenting branch of the doctrine, the claims of a pending application must be inventive over the claims of any earlier issued patent by the same applicant, unless the claims are divided out of the same original application in response to a unity of invention objection by the Patent Office.

2.c If the secret prior art is an international application filed designating your jurisdiction:

<table>
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<tr>
<th>Question</th>
<th>Answer</th>
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<tbody>
<tr>
<td>2.c.i</td>
<td>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</td>
</tr>
<tr>
<td>2.c.ii</td>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
</tr>
<tr>
<td>2.c.iii</td>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
</tr>
</tbody>
</table>

Pursuant to Rule 59.1 of the *Patent Rules*, “an international application is deemed to be an instrument of record in the Patent Office only when it becomes a PCT national phase application.” Emphasis added. Accordingly, if the international application does not enter the national phase it will never become a Canadian patent, and could not be used for double-patenting purposes.

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 2

Same as Question 2. In accordance with div 28.2 of the Patent Act, secret prior art is defined as an application “by a person other than the applicant”, emphasis added. Therefore, the same inventive entity is not required.

3.b Same applicant on the dates of filing, no common inventor: same as Question 2
Please Explain

See above.

3.c Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

Same as Question 1. See above. However, there is some ambiguity regarding the definition of Applicant in such a fact scenario. Section 2 of the Patent Act defines “applicant” as including an inventor and the legal representatives of an applicant or inventor.” Thus, although it is likely that the Patent Office will consider the Applicants to be different in this case, an argument can be made that because of the same inventors the Applicants are the same.

There is limited case law that suggests that the applicant contemplated in the divs 28 and 23 of the Patent Act may not any applicant who would fit the definition of “applicant” in div 2 of the Act but rather the applicant who actually filed the application. See Vita-Herb Nutriceuticals Inc. v. Canada (Attorney General), 2010 FC 1203. However, the law is far from settled in this area.

3.c. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

See answer to Question 3c.

3.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes

Please Explain

If there is an obligation to assign, then both applications could be filed in the name of the same Applicant, which would result in the same situation as Question 3a. Alternatively, as assignment could be filed after filing with a request to correct the applicant.

3.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

II. Policy considerations and proposals for improvements of your current law
<table>
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<tr>
<th>4</th>
<th>Could any of the following aspects of your Group’s current law be improved? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>4.a</td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

The definition itself, as provided in paragraphs 28.2(1)(c) and 28.2(1)(d) of the Patent Act is quite clear and unambiguous: Secret prior art is applicable to defeat patentability of a later-filed application where (a) it is pertinent to novelty and (b) it is filed in Canada. The effective Canadian filing date of the secret prior art may have an earlier priority date due to a foreign priority and/or a PCT filing.

However, when the secret prior art and the later-filed application share a common applicant, a further set of circumstances exist: namely, Canada’s “same invention” and “obviousness-type” double patenting limitations, are not codified, and create some lack of clarity in the Act. This could be improved. The Patent Act should also be amended to provide for a Terminal Disclaimer practice to address the “obviousness-type” double patenting issue.

| 4.b | The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art. |
| Yes | Please Explain |

Where the earlier filed application is that of a different applicant, the patentability standard is novelty. This is appropriate.

Where the earlier filed application has a common applicant, the patentability standard is obviousness. There is no provision for terminal disclaimer. This may be too onerous.

| 4.c | The treatment of international applications as secret prior art. |
| No | Please Explain |

International applications are not considered secret prior art. The application must have been filed in Canada, but the pertinent date may be based on an earlier foreign or international priority date.

See discussion with respect to Question 4a as to whether, from a policy perspective, this is appropriate.

| 4.d | The treatment of total and partial identity of applicants as it relates to secret prior art. |
| Yes | Please Explain |

To the extent that a “partial applicant” is intended to account for a situation where the secret prior art and the later-filed application share a common applicant, but different inventors, the definition in div in div 28.2 of the Patent Act should be clarified.

Specifically, div 2 of the Patent Act defines “applicant” as including an inventor and the legal representatives of an applicant or inventor. Section 15.06 of the Manual of Patent Office Practice states that the Patent Office will treat applicants as the “same” for double-patenting, regardless of the persons listed as inventors. It is unclear how applications having overlapping, but not identical, applicants, are to be treated.
4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

Section 2 of the Patent Act defines an "applicant" as including an inventor or a legal representative of the inventor. It is believed that this definition is adequate.

4.f Provisions for avoiding self-collision.

Yes

Please Explain

As discussed above, divs 28.2 and 28.3 of the Patent Act include provisions that are believed to be intended to avoid self-collision for novelty and obviousness, respectively. However, the purpose of the provisions have been seriously undermined by the judicial doctrine against double patenting.

A terminal disclaimer practice would overcome many of the shortcomings of the double patenting doctrine. Such shortcomings include the risk of incurring a double patenting objection to a "voluntary" divisional application. A voluntary divisional is a divisional application containing claims that were not subject to a lack of unity objection in the parent application.

Applicants should be able to file divisional applications without fear of double patenting, as it streamlines patent prosecution. For example, currently, applicants in Canada cannot simply accept the allowed claims, then fight for broader or different claims in a subsequent application. It may also be worthwhile considering the viability of continuation and continuations in part (CIP) applications, although that is beyond the scope of this question.

The current practice of deliberately triggering a restriction requirement in order to minimize the risk of an obviousness-type double patenting rejection in a divisional adds expense and removes timeliness from Canadian patent prosecution. As noted above, a terminal disclaimer practice is desirable.

4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

Yes

Please Explain

Such incremental inventions would be at risk of “double patenting” rejections. A terminal disclaimer as well as a CIP practice would be desirable.
Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

Yes

Please Explain

The law and practice on double-patenting could be improved to reduce self-collision under the obviousness-type double patenting doctrine. One proposal is to permit a terminal disclaimer, particularly with regard to divisional applications where self-collision is more likely. Another proposal is to clarify the circumstances where “same” or “different” applicants/inventors do not give rise to double-patenting, or to remove obviousness-type double patenting entirely. It is yet uncertain how the proposed changes to the Patent Act and Rules will address these issues.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Yes

If YES, please respond to the following questions without regard to your Group’s current law or practice could be improved.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

The issue of conflicting applications can be looked at through different policy lenses. In a first-to-file regime, it is clear that an applicant should not be able to obtain patent protection if another applicant filed an earlier application describing that invention. This suggests at least a novelty standard for third party secret prior art.

The Canadian group considers that an important policy objective of the patent system is to incentivize inventive activity and the disclosure of new inventions. An applicant that has legitimately engaged in inventive activity and has filed an application, where they could not have accessed the secret prior art, has in good faith met the prerequisites for patent protection in circumstances where they could not have discovered the earlier patentee’s similar work. Patents can also be viewed through a natural rights lens to take into account the interests of the applicant/inventor. There is an inherent unfairness in denying an applicant patent protection when the applicant has engaged in legitimate inventive activity and they could not have had access to the secret prior art of a third party. It would be unfair to that applicant to deny them patent protection since their decision to seek it was made in good faith and the inventive activity was genuine. This consideration justifies restricting the applicability of secret prior art to a novelty or perhaps an enhanced novelty standard. Note that this consideration may not apply where the earlier filing is by the same applicant.

A minority of the Canadian Group believes that another important policy objective is to ensure that an applicant’s contribution to public knowledge is meaningful; it cannot be a mere trivial change or difference from what is already known or no enrichment of public knowledge will occur that would give rise to a patent. In the case of secret prior art, considering it solely from the point-of-view of the public, it would seem that an obviousness standard could be applied to later filings over secret prior art. A later filing that makes only a non-inventive contribution over an earlier filing does not (once published) provide the quid-pro-quo to justify grant of a patent since publication of the secret prior art filing will provide disclosure of the invention. Moreover, if a second patent were issued for an obvious variant to a first patent on the secret prior art it may lead to a possible patent thicket. It can also be considered unfair to the earlier patentee as a second patent on an obvious variant to the earlier invention may devalue the first patent. This rationale was not found to be compelling by the majority of the Canadian Group.

The Canadian Group believes that only a novelty standard should be applied in connection with secret prior art. Although there may be a sense that it is unfair to the first applicant to allow a patent for an subsequently filed invention that would have been obvious based on the secret prior art, the first applicant can still obviate this issue by publishing the invention at the same time as filing the application.

Terminal disclaimers can be used to provide an anti-self-collision mechanism to overcome obviousness-type double patenting objections in view of applicant’s own pre-publication or parent filings.
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

**Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

**Yes**

*Please Explain*

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents should be available.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The same standard should apply.

**Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

**No**

*Please Explain*

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

*Please Explain*
7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

As discussed with respect to Question 1(c)(ii), an application that does not enter the national phase in Canada is not considered to be filed in Canada and cannot be considered for novelty purposes.

7.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

Same applicant secret prior art should be addressed through same-invention and obviousness-type double patenting instead.

8.a. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

8.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

8.a. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

See above.
### If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

**No**

**Please Explain**

To avoid ever-greening and packet thickets, obviousness-type double-patenting should apply; however, an obviousness-type double patenting objection should be overcome through use of a terminal disclaimer and a requirement to maintain common ownership of the patents.

### If the secret prior art is an international application filed designating your jurisdiction:

**Yes**

**Please Explain**

As discussed with respect to Question 1(c)(ii), an application that does not enter the national phase in Canada is not considered to be filed in Canada and cannot/should not be considered for novelty purposes.

**Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.**

**No**

**Please Explain**

**Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

**Yes**

**Please Explain**

As discussed with respect to Question 1(c)(ii), an application that does not enter the national phase in Canada is not considered to be filed in Canada and cannot/should not be considered for novelty purposes.

**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

**No**
Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 8

Please Explain

9.b Same applicant on the dates of filing, no common inventor:

same as Question 8

Please Explain

Common inventorship should not be required to benefit from anti-self-collision when applicant is the same.

9.c Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

The joint collaborators can coordinate patent activity and negotiate to ensure this issue does not arise.

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes

Please Explain
If there is an obligation to assign, then both applications could be filed in the name of the same Applicant.

9.d.ii Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

11 Please indicate which industry sector views are included in your Group’s answers to Part III.
For all of the questions:

a) **secret prior art** means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) **effective filing date** means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

**I. Current law and practice**

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

### 1.a

**Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain
The secret prior art is available against the claims of the later-filed application for novelty-defeating purposes.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available against the claims of the later-filed application for novelty-defeating purposes.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Comparing the claimed invention or utility model with the relevant contents of the secret art, if their technical fields, technical problems to be solved, technical solutions, and their expected effects are substantially the same, they shall be regarded as identical inventions or utility models and the claimed invention or utility model does not possess novelty. The standard is the same as the standard applied to publicly available prior art.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? ** The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

This does not change any of the answers to questions 1(a) and 1(b) above.
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The international application is available against the claims of the later-filed application for novelty-defeating purposes ONLY if it enters the Chinese national phase and is published by the Patent Office of SIPO on or after the effective filing date of the later-filed patent application.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

The date from which the international application is available as secret prior art does not depend on the date of national phase entry in China.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

The secret prior art is available against the claims of the later-filed application for novelty-defeating purposes. The entire contents of the secret prior art are available against the claims of the later-filed application for novelty-defeating purposes.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Comparing the claimed invention or utility model with the relevant contents of the secret art, if their technical fields, technical problems to be solved, technical solutions, and their expected effects are substantially the same, they shall be regarded as identical inventions or utility models and the claimed invention or utility model does not possess novelty. The standard is the same as the standard applied to publicly available prior art.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

There is no anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes.
AIPPI 2018 - Study Question - Conflicting patent applications

2.a.iii
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There is no anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes.

2.b
Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

2.b.i
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

2.b.ii
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

2.b.iii
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

2.b.iv
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.b.v
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.c
If the secret prior art is an international application filed designating your jurisdiction:

2.c.i
Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

This does not change any of the answers to questions 2(a) and 2(b) above.

2.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes
The international application is available against the claims of the later-filed application for novelty-defeating purposes ONLY if it enters the Chinese national phase and is published by the Patent Office of SIPO on or after the effective filing date of the later-filed patent application.

**2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

No

**Please Explain**

The date from which the international application is available as secret prior art does not depend on the date of national phase entry in China.

**3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.**

<table>
<thead>
<tr>
<th>Scenario</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 1</td>
<td></td>
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<td></td>
<td>Please Explain</td>
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<td></td>
<td>Also the same as Question 2</td>
<td></td>
</tr>
<tr>
<td>Same applicant on the dates of filing, no common inventor:</td>
<td>same as Question 1</td>
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<td></td>
<td>Please Explain</td>
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<tr>
<td>Different applicants on the dates of filing, same inventors:</td>
<td>same as Question 1</td>
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<td>Please Explain</td>
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<td></td>
<td>Also the same as Question 2</td>
<td></td>
</tr>
<tr>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
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<tr>
<td></td>
<td>The answers will not change if the different applicants were part of a joint industry or industry-university research project.</td>
<td></td>
</tr>
</tbody>
</table>
### II. Policy considerations and proposals for improvements of your current law

#### 4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<table>
<thead>
<tr>
<th>Yes</th>
<th>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
</table>

**A patent application is kept secret during the period between filing and publication. In China the period is normally 18 months for invention application, and 3-6 months for utility model and design application. Thus, it is possible that two or more applications having the same subject matter or claiming the same invention get filed in between the period of the filing date and publication date of a first filed application.**

At the filing stage, the applicant of a later-filed application may be not aware of the earlier-filed application. Nevertheless, the earlier-filed application will have patent defeating effect and can act as an applicable prior art for the later-filed application.

It is necessary to distinguish such earlier-filed application from normal prior art documents which are both filed and published before the filing date of the later-filed application. Such earlier-filed application is called secret prior art or conflicting application in China.
Under current practice of Patent Law in China, secret prior art (also called conflicting application) refers to, with respect to a later-filed application, an application relating to identical invention-creation (including invention, utility model and design in China) which has been filed in China by any entity or individual prior to (but not on) the (effective) filing date of the later application but published on or after the (effective) filing date. The conflicting application can also be an international application entering the Chinese national phase that was filed previously by any entity or individual, published by the Chinese Patent Office on or after the (effective) filing date of the later application.

**Filing Date**

The filing date refers to effective filing date (including priority date). A conflicting application may be either a Chinese application or a Patent Cooperation Treaty (PCT) application that enters the national phase and is published in China. There is, however, no explicit provision, in the context of a conflicting application, as to the filing date of a PCT application that enters the national phase in China, claiming priority on the basis of a foreign application. On the other hand, when a Chinese application claims priority on the basis of a foreign application, the application is deemed to have been filed on the date the foreign application was filed. It is, therefore, likely that, in the context of a conflicting application, a PCT application that enters the national phase in China, claiming priority on the basis of a foreign application, will be deemed to have been filed on the date the foreign application was filed.

**Publication**

A conflicting application can be applicable only when it is published in Chinese. Any earlier application published in any other language is not qualified as conflicting application. Further, if an application has been filed with the Chinese Patent Office before the filing date of a later application, but withdrawn prior to publication, it cannot be used as a conflicting application to render the later application non-patentable for lack of novelty.

In light of the above, the timing of a conflicting application contributes to its uniqueness unlike normal prior art documents. The current definition of when a conflicting application is applicable to defeat patentability of a later-filed application in China is in accordance with the flow of patent system in China and also consistent with those of most jurisdictions. Currently no improvement is recommended.

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| The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

Yes

**Please Explain**

A conflicting application can be applicable only when it is published in Chinese. Any earlier application published in any other language is not qualified as conflicting application. Further, if an application has been filed with the Chinese Patent Office before the filing date of a later application, but withdrawn prior to publication, it cannot be used as a conflicting application to render the later application non-patentable for lack of novelty.

In light of the above, the timing of a conflicting application contributes to its uniqueness unlike normal prior art documents. The current definition of when a conflicting application is applicable to defeat patentability of a later-filed application in China is in accordance with the flow of patent system in China and also consistent with those of most jurisdictions. Currently no improvement is recommended.

Criterion for judging whether an invention is novel includes:

1. The claimed invention is completely identical with the technical contents disclosed in a reference document. The meaning of "technical contents" shall be construed as including the technical content directly and unambiguously derivable from the reference document;

2. If, when the claimed invention is compared with a reference document, the difference between them lies merely in the fact that a technical feature of the same nature is defined in a generic term in the former and in a specific term in the latter, then the disclosure in the specific term takes away the novelty of the invention claimed in the generic term;

3. If the difference between the claimed invention and a reference document is merely a direct substitution of customary means employed in the art, the claimed invention is not novel.

It can be seen that novelty examination in China takes into account not only completely identical contents but also simple modification of the contents in the reference document (e.g., a conflicting application). To some extent, the novelty in China already covers enlarged novelty. This can effectively avoid patenting an already disclosed subject matter and double patenting.

**Proposal**

Supposing a situation where the conflicting application discloses and claims a method for processing data, but does not explicitly disclose or
claim a device or system for performing the method. The later application claims the device or system for performing the method, for example, a processor plus a memory. Under current practice of the conflicting application, the later application might be granted. Consequently, the applicant of the conflicting application might not carry out his or her claimed method.

To prevent the above situation, and to prevent the first applicant from being alleged as infringer, it is proposed that a conflicting application may be used an obviousness bar (with lower level) to defeat a later-filed application. For example, a conflicting application could be combined with customary means or common knowledge in the art to defeat a later application. Accordingly in the above example, the later application might not be patented because combination of the disclosed method of the conflicting application with customary means (processor and memory) could render the claimed subject matter of the later application obvious.

The treatment of international applications as secret prior art.

Yes

Under current practice of the Patent Law in China, a conflicting application can also be an international application (e.g., PCT application) entering the Chinese national phase that was filed previously by any entity or individual, published by the Chinese Patent Office on or after the filing date of the later application. An international application which does not enter the Chinese national phase cannot be used as a conflicting application. This is consistent with the principle that patent rights are jurisdiction-specific.

There is, however, no explicit provision, in the context of a conflicting application, as to the filing date of a PCT application that enters the national phase in China, claiming priority on the basis of a foreign application. On the other hand, when a Chinese application claims priority on the basis of a foreign application, the application is deemed to have been filed on the date the foreign application was filed. It is, therefore, that, in the context of a conflicting application, a PCT application that enters the national phase in China, claiming priority on the basis of a foreign application, will be deemed to have been filed on the date the foreign application was filed.

Proposal

An explicit provision may be added to specify that a conflicting application can be an international application entering the Chinese national phase that was filed previously by any entity or individual, published by the Chinese Patent Office on or after the filing date of the later application, and the international application entering the Chinese national phase is deemed to have the same filing date as its priority application either in China or in foreign countries or regions.

The treatment of total and partial identity of applicants as it relates to secret prior art.

No

One major change made to the Chinese Patent Law in the Third Amendment was the expansion of the scope of conflicting applications. Prior to October 1, 2009, when the new Chinese Patent Law became effective, a ‘conflicting application’ referred to an invention or utility model application filed before the filing date of an identical later application made by ‘any other applicant’ and published after the filing date of the later application. In the Third Amendment, ‘any other applicant’ was changed to ‘any applicant’; with the result that an earlier application filed by the same applicant may also constitute a ‘conflicting application’. Accordingly, whether a later application is filed by the same, partially the same or different applicants, the earlier application can serve as a conflicting application.

There is no concern in China regarding treatment of total and partial identity of applicants as it relates to conflicting application.

The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Whether a later application is associated with the same, common or different inventors, the earlier application can serve as a conflicting application.
There is no concern in China regarding treatment of inventive entities as it relates to conflicting application.


No

Please Explain

China adopts self-collision policy after the Third Amendment of the Patent Law was effected. That is, in China, an earlier-filed later-published application may become a conflicting application against the applicant/inventor himself. There is no explicit provision for avoiding self-collision.

### 5. Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

There is no explicit provision, in the context of a conflicting application, as to limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

However, the entire disclosure (i.e., whole contents), instead of only the claims, of the conflicting application is available as prior art to serve as a novelty bar against the later-filed application even by the same applicant. As a result, claims in the later-filed application on inventions that are incremental with respect to and have been disclosed in the same applicant’s earlier-filed application may not be allowed. This limits an applicant’s right to obtain patent claims in the later-filed application on incremental inventions.

Under such circumstance, applicants should carefully monitor disclosure and timing when filing multiple applications in relation to similar technologies. Care should be taken to make no unnecessary disclosures in such applications, or to ensure that the applications are filed on the same day to avoid any conflicting application problems.

### Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

Yes

Please Explain

The concept of ‘conflicting application’ is discussed mainly in the patent application examination phase after filing and before grant or rejection. There is no explicit provision as to whether a conflicting application can be employed in a prior art defence in patent infringement proceedings. Now this topic remains controversial. While some practitioners advocate the use of a conflicting application in a prior art defence, at least where the application has been published and thus becomes prior art, or in determining novelty in the context of infringement proceedings, others believe that a conflicting application is not prior art as defined in the Patent Law and therefore cannot be used in a prior art defence.

**Proposals**

Explicit provisions or policies may be expected to specify whether a conflicting application can be employed in a prior art defence in patent infringement proceedings.

### III. Proposals for harmonisation

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*
6 Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

No

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

We believe that there is no particular need to harmonize any or all areas in Section II. In fact, different jurisdictions have had the same or similar treatments of secret prior art or conflicting application in some of the areas in Section II. On the other hand, differences in the treatments of secret prior art mainly originate from differences in patenting systems and policies of different jurisdictions. Since patenting system, policy and patent itself are all jurisdiction-specific, it would be appropriate for each jurisdiction to have freedom in defining “secret prior art” within its own patenting system. Besides, it might be infeasible to achieve harmonisation in some areas in Section II, due to distinctions in each jurisdiction’s patent practice.

7 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

The secrete prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

7.a.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents of the secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

7.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

If the secrete prior art discloses the same invention or model utility as that of the later-filed application, the later-filed application is not novel.

The standard for evaluation of novelty is same as the standard applied to publicly available prior art.

7.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain
The secrete prior art should NOT be available against the claims of the later filed application to show lack of inventive step / obviousness.

7.b. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

This does not change any of the answer to questions 1(a) and 1(b) above.

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The international application is available against the claims of the later-filed application for novelty-defeating purposes ONLY if it enters the Chinese national phase and is published by the Patent Office of SIPO on or after the effective filing date of the later-filed patent application.

7.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

The date from which the international application is available as secrete prior art does NOT depend on the date of national phase entry into our jurisdiction.

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.
8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

The secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

8.a.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

8.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

If the secret prior art discloses the same invention or utility model as that of the later-filed application, the later-filed application is not novel. The standard for evaluation of novelty is same as the standard applied to publicly available prior art.

8.a.iii If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purpose? What should that time period be?

There should NOT be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purpose.

8.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art should NOT be available against the claims of the later filed application to show lack of inventive step / obviousness.

8.b.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?
8.b.iv If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

This does NOT change any of our answers to questions 2(a) and 2(b) above.

8.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The international application is available against the claims of the later-filed application for novelty-defeating purposes ONLY if it enters the Chinese national phase and is published by the Patent Office of SIPO on or after the effective filing date of the later-filed patent application.

8.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

The date from which the international application is available as secrete prior art does NOT depend on the date of national phase entry into our jurisdiction.

9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application areunrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.
<table>
<thead>
<tr>
<th>Scenario</th>
<th>Question Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>9.a</strong></td>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
</tr>
<tr>
<td></td>
<td>same as Question 7</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>Also the same as Question 8</td>
</tr>
</tbody>
</table>

| **9.b**  | Same applicant on the dates of filing, no common inventor: |
|          | same as Question 7   |
|          | Please Explain       |
|          | Also the same as Question 8 |

| **9.c**  | Different applicants on the dates of filing, same inventors: |
|          | same as Question 7   |
|          | Please Explain       |
|          | Also the same as Question 8 |

| **9.c.i** | Would the answers change if the different applicants were part of a joint industry or industry-university research project? |
|           | No                  |
|           | Please Explain      |
|           | The answers will NOT change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing. |

| **9.d**  | Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application: |
|          | same as Question 7   |
|          | Please Explain       |
|          | Also the same as Question 8 |

| **9.d.i** | Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing? |
|           | No                  |
|           | Please Explain      |
The answers will NOT change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing.

9.d.ii Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

The answers will NOT change if the different applicants were part of a joint industry or industry-university research project.

9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

Also the same as Question 8

9.f Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

Also the same as Question 8

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

None

11 Please indicate which industry sector views are included in your Group’s answers to Part III.

Our Group’s answer to Part III include views from industry sectors of electronic engineering, Internet technology, computing science, communication, microelectronics, software, mechanics, automatic control, chemistry, biotech, and medical science.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
The Danish Group notes that it will refer to both the Danish Patents Act and the EPC. Yes, the secret prior art is available for novelty-defeating purposes, see Section 2(2) second sentence of the Danish Patents Act and Article 54(3) of the EPC.

<table>
<thead>
<tr>
<th>a.</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>The entire contents of the secret prior art are available.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>a.</th>
<th>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>It is the same as the standard applied to publicly available prior art.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>b.</th>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>No, see Section 2(2) last sentence of the Danish Patents Act and Article 56 second sentence of the EPC.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>b.</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>N/A</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>b.</th>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>N/A</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>b.</th>
<th>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>N/A</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>c.</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
</table>
### 1.c.i
**Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.**

No

**Please Explain**

### 1.c.ii
**Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

Yes

**Please Explain**

Yes, in relation to novelty.

In order for an international application to become secret prior art, it will have to enter the national phase in Denmark, see Section 22, 29 and 31 of the Danish Patents Act.

Correspondingly, a Euro-PCT application is only secret prior art for Denmark if it enters the regional phase before the EPO, see Section 82 (2) of the Danish Patents Act and Art. 93 EPC, Art. 153(5) EPC and Art. 54(3) EPC and Rule 165 EPC.

### 1.c.iii
**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

No

**Please Explain**

No. If the international application enters the national phase in Denmark or the regional phase before the EPO, then it will be considered secret prior art from the effective filing date of the subject matter citeable against the later filed patent application and not the date of the national phase entry, see Section 29 of the Danish Patents Act and Art. 153 (2) and (5) EPC.

### 2
**For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.**

### 2.a
**Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

**Please Explain**

### 2.a.i
**If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?**

The entire contents of the secret prior art are available.

### 2.a.ii
**If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?**
It is the same as the standard applied to publicly available prior art.

<table>
<thead>
<tr>
<th>a.</th>
<th>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No, there is no anti-self collision time period foreseen neither in the EPC nor in the Danish Patents Act. The Danish Group does not consider it advantageous to introduce an anti-self collision provision beyond the general right to claim multiple priorities in a later filed combined patent application, filed within the priority year.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b</th>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
<tr>
<td>No, see Section 2(2) last sentence of the Danish Patents Act and Article 56 second sentence of the EPC.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b.i</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>N/A</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b.ii</th>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td>N/A</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b.iii</th>
<th>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td>N/A</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b.iv</th>
<th>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
</thead>
<tbody>
<tr>
<td>N/A</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b.v</th>
<th>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>
2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Yes, in relation to novelty.

In order for an international application to become secret prior art, it will have to enter the national phase in Denmark, see Section 22, 29 and 31 of the Danish Patents Act.

Correspondingly, a Euro-PCT application is only secret prior art for Denmark if it enters the regional phase before the EPO, see Section 82 (2) of the Danish Patents Act and Art. 93 EPC, Art. 153(5) EPC and Art. 54(3) EPC and Rule 165 EPC.

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No. If the international application enters the national phase in Denmark or the regional phase before the EPO, then it will be considered secret prior art from the effective filing date of the subject matter citeable against the later filed patent application and not the date of the national phase entry, see Section 29 of the Danish Patents Act and Art. 153 (2) and (5) EPC.

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain
### II. Policy considerations and proposals for improvements of your current law

#### 4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<table>
<thead>
<tr>
<th>4.a.</th>
<th>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Yes</td>
<td>Yes.</td>
</tr>
</tbody>
</table>
The current statutory rules distinguish between prior art based on filing days. A timescale of days may be insufficient or outdated in light of modern technology and instant publication, as witnessed by the recent decision from the British court of appeal in Huawei v. Unwired Planet, [2017] EWCA Civ 266 confirming the first instance decision on novelty over published prior art. In this case it was stated that filings made within the same 24 hour period of the publication date but after actual publication on the internet (i.e. the same publication and filing date), by reference to the time zone of the patent office of filing, is novel over this same, published state of the art.

Reference is also made to two recent decisions by the European Patent Office (EPO) regarding the revoked patents EP1448009 and EP2234303, both considering whether specific documents were published within the same date as the application.

1. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

2. The treatment of international applications as secret prior art.

No

Please Explain

3. The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

4. The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain


No

Please Explain

No, the right to claim multiple priorities is sufficient remedy.

6. Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

N/A
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

Yes

Please Explain

Recent technological developments regarding electronic filing and advent of the Internet has made it actually feasible to circumvent the same date/day before requirement enshrined in the EPC and the Danish Patents Act.

Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

No

Even if NO, please address the following questions to the extent your Group considers your Group

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

YES, the entire contents

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

YES
### AIPPI 2018 - Study Question - Conflicting patent applications

#### 7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

#### 7.b.i. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

<table>
<thead>
<tr>
<th>N/A</th>
</tr>
</thead>
</table>

#### 7.b.ii. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

<table>
<thead>
<tr>
<th>N/A</th>
</tr>
</thead>
</table>

#### 7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

<table>
<thead>
<tr>
<th>N/A</th>
</tr>
</thead>
</table>

### 7.c. If the secret prior art is an international application filed designating your jurisdiction:

#### 7.c.i. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

#### 7.c.ii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

<table>
<thead>
<tr>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

YES, only patent applications with validity for Denmark should be citable in Denmark

#### 7.c.iii. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

NO, the effective filing date of the patent application is suitable for use.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

YES, the entire contents

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

YES

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

NO, the possibility to claim multiple priorities is sufficient protection against self-collision.

The Danish Group does not consider it advantageous to introduce an anti-self collision provision beyond the general right to claim multiple priorities in a later filed combined patent application, filed within the priority year.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

N/A
If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

N/A

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

N/A

If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

N/A

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

YES, only patent applications with validity for Denmark should be citable in Denmark.
### 9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

<table>
<thead>
<tr>
<th>Scenario</th>
<th>Same as Question 7</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
<td></td>
</tr>
<tr>
<td>Same applicant on the dates of filing, no common inventor:</td>
<td>same as Question 7</td>
<td></td>
</tr>
<tr>
<td>Different applicants on the dates of filing, same inventors:</td>
<td>same as Question 7</td>
<td></td>
</tr>
<tr>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
<td></td>
</tr>
<tr>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>
### Question 9.d.ii

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

### Question 9.e

Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

### Question 9.f

Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

### Question 10

Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

N/A

### Question 11

Please indicate which industry sector views are included in your Group’s answers to Part III.

None
Study Question

Submission date: June 15, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Ecuador
Contributors name(s): Francisco Pérez G. Hugo López Jijón
E-mail contact: mromero@romerocorral.ec

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Article 269 of the current IP applicable provisions in Ecuador, determines that regarding the novelty analysis of a patent application, the
contents of a pending and prior filed patent application, must be considered within the prior art. The Andean IP applicable provisions regulate this matter in the same way.

**a.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Considering the secret prior art will still be private, only an abstract will be available, not even the claims will be public.

**a.** If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for the evaluation of novelty will be the same as applied to publicly available prior art, depending on the filing date of both applications.

**b.** Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes

Please Explain

YES, but only for the resolving Authority within the Patent Office, because the complete claims and details will still be confidential. The secret prior art will be considered, along with the public state of the art, for the analysis of inventive step.

**b.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art will only be available for the resolving Authority, considering confidentiality.

**b.** If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

YES, the resolving Authority will consider and evaluate all the elements of the prior state of the art related to the specific case, as a part of the corresponding complete patentability analysis.

**b.** If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

YES, the standard will be the same as applied to publicly available prior art. Only the resolving Authorities will have access to the complete contents of the secret prior art and the evaluation will consider the filing date of each patent application.

**c.** If the secret prior art is an international application filed designating your jurisdiction:
1.c.i
Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

Unless the information of the international application with a designation to Ecuador, and the corresponding secret prior art documents are specifically handled to the national resolving Authorities of the Patent Office, they will not be able to find such information on a regular international search, for it will be confidential and private.

1.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

YES, because with the entrance to the national phase of an international application, the Patent Office will have the secret prior art documents and the international filing date, being able to perform the patent examination report.

1.c.iii
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

YES, because the Patent Office will only be able to consider the secret prior art documents from the date in which the national phase entry is filed in Ecuador. Nevertheless, once the national phase entry has been filed in Ecuador, within 12 months from the first international filing date, the patent application claiming an international priority will take the same international filing date. Therefore, the secret prior art will depend on the international application filing date, once the national phase entry is performed.

2
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a
Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

YES, article 269 of the current IP applicable provisions in Ecuador, determines that regarding the novelty analysis of a patent application, the contents of a pending and prior filed patent application, must be considered within the prior art.

2.a.i
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?
Considering the secret prior art will still be private, only an abstract will be available, not even the claims will be public.

**a.** If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for the evaluation of novelty will be the same as applied to publicly available prior art, depending on the filing date of both applications.

**a.** If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

NO.

**b.** Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes

**Please Explain**

YES, but only for the resolving Authority within the Patent Office, because the complete claims and details will still be confidential. The secret prior art will be considered, along with the public state of the art, for the analysis of inventive step.

**b.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art will only be available for the resolving Authority, considering confidentiality.

**b.** If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

YES, the resolving Authority will consider and evaluate all the elements of the prior state of the art related to the specific case, as a part of the corresponding complete patentability analysis.

**b.** If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

YES, the standard will be the same as applied to publicly available prior art. Only the resolving Authorities will have access to the complete contents of the secret prior art and the evaluation will consider the filing date of each patent application.

**b.** If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

It is not applicable.

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

Unless the information of the international application with a designation to Ecuador, and the corresponding secret prior art documents are specifically handled to the national resolving Authorities of the Patent Office, they will not be able to find such information on a regular international search, for it will be confidential and private.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

YES, because with the entrance to the national phase of an international application, the Patent Office will have the secret prior art documents and the international filing date, being able to perform the patent examination report.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

YES, because the Patent Office will only be able to consider the secret prior art documents from the date in which the national phase entry is filed in Ecuador.

Nevertheless, once the national phase entry has been filed in Ecuador, within 12 months from the first international filing date, the patent application claiming an international priority will take the same international filing date. Therefore, the secret prior art will depend on the international application filing date, once the national phase entry is performed.
Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a
Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1
Please Explain

3.b
Same applicant on the dates of filing, no common inventor:
same as Question 1
Please Explain

3.c
Different applicants on the dates of filing, same inventors:
same as Question 1
Please Explain

3.c.i
Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain

NO. Considering that the Ecuadorian Patent Office is highly focused on formal elements, any conflicting application for a patent with the same or similar contents and claims, will be denied on the basis of lack of novelty and inventive step.

3.d
Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1
Please Explain

3.d.i
Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
No
Please Explain

NO. If both patent applications protect the same of similar claims, the first filed application will be allowed for patentability examination and the second filed application will be denied on the basis of lack of novelty and inventive step, regarding the secret prior art.
II. Policy considerations and proposals for improvements of your current law

<table>
<thead>
<tr>
<th>4</th>
<th>Could any of the following aspects of your Group’s current law be improved? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>4.a</td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
</tr>
<tr>
<td>No</td>
<td>No, because the applicable provisions clearly state that regarding the novelty analysis of a patent application, the contents of a pending and prior filed patent application, must be considered within the prior art.</td>
</tr>
<tr>
<td>4.b</td>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
</tr>
<tr>
<td>Yes</td>
<td>Yes, this could be improved with a clearer policy of information transparency between Patent Offices, granting the confidentiality of secret prior art related to unpublished applications.</td>
</tr>
<tr>
<td>4.c</td>
<td>The treatment of international applications as secret prior art.</td>
</tr>
<tr>
<td>Yes</td>
<td>Yes, this could be improved with a clearer policy of information transparency between Patent Offices, granting the confidentiality of secret prior art related to unpublished applications.</td>
</tr>
<tr>
<td>4.d</td>
<td>The treatment of total and partial identity of applicants as it relates to secret prior art.</td>
</tr>
<tr>
<td>No</td>
<td>No, because the applicable provisions clearly state that regarding the novelty analysis of a patent application, the contents of a pending and prior filed patent application, must be considered within the prior art.</td>
</tr>
</tbody>
</table>
Normally, the Patent Office does not arrive to the analysis of the identity of applicants related to secret prior art, because if the object and claims of an application are the same, the denial will be based on the lack of novelty.

<table>
<thead>
<tr>
<th>4.e</th>
<th>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

Normally, the Patent Office does not arrive to the analysis of the identity of applicants related to secret prior art, because if the object and claims of an application are the same, the denial will be based on the lack of novelty.

<table>
<thead>
<tr>
<th>4.f</th>
<th>Provisions for avoiding self-collision.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

The current IP provisions do not regulate the self-collision issue.

<table>
<thead>
<tr>
<th>4.g</th>
<th>Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

The current IP provisions determine that the first filed application will effectively protect the set of claims included, and if a second application is filed, the related claims will not be accepted by virtue of the claims previously protected. If the second filed application is incremental, the applicant should abandon the first application and obtain a complete protection with the second application.

<table>
<thead>
<tr>
<th>5</th>
<th>Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

We consider that complete policy considerations regarding conflicting applications should be included in our current law, because the Ecuadorian Patent Office is strictly formal and a second application will be denied ex officio if it conflict with a prior filed application. Currently, there is no consideration the conflicting application, despite the contents and claims of a prior filed application are secret for the second filing.

III. Proposals for harmonisation

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*
AIPPI 2018 - Study Question - Conflicting patent applications

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

   If YES, please respond to the following questions without regard to your Group's current law or practice.

   Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

   If YES, please respond to the following questions without regard to your Group

YES, harmonisation of the policy considerations in the current applicable Law is always desirable. Currently, the countries of the Andean Pact have a common decision (Decision 486 of the Andean Pact), which effectively regulates the Patent applicable Policy. Nevertheless, it is from 2001 and could be updated.

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

   Yes

   Please Explain

   YES, it is important that the secret prior art, along with the general prior art, is available for the examiner to perform a correct patentability examination and determine the novelty of the later-filed application. Nevertheless, it is important to maintain the confidentiality of the information, until the application is published.

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

   YES, the entire contents of the secret prior art should be available for the examiner at the Patent Office, and considering their confidentiality, should be considered in order to determine the relation with the later-filed application.

7.a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

   We consider that the standard for the correct evaluation of novelty regarding secret prior art should be higher than the standard applied to publicly available prior art, because both applications are legitimate and the later-filed application could not know that a prior application had been filed. Therefore, a strongest standard allows the application to be thoroughly analysed and the patentability examination of the later filed application will be more objective.

7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

   Yes
**AIPPI 2018 - Study Question - Conflicting patent applications**

Yes

**Please Explain**

YES, the secret prior art must be available against claims of the later-filed application, to analyse novelty and inventive step, according to the applicable IP Provisions. This allows the examiner to determine if the applications complies with the minimum elements required for a patent application, and proceed with the full patentability examination.

<table>
<thead>
<tr>
<th>7.b. i</th>
<th>If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>YES, the entire contents of the secret prior art should be available for the resolving Authority, considering confidentiality.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>7.b. ii</th>
<th>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td>YES, the resolving Authority will consider and evaluate all the elements of the prior state of the art related to the specific case, including the secret prior art, as a part of the corresponding complete patentability analysis.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>7.b. iii</th>
<th>If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td>We consider that the standard for the correct evaluation of lack of inventive step regarding secret prior art should be higher than the standard applied to publicly available prior art, because both applications are legitimate and the second applicant could not know that a prior application had been filed. Therefore, a strongest standard allows the application to be thoroughly analysed and the patentability examination of the later filed application will be more objective.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>7.c</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>7.c. i</th>
<th>Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

Unless the information of the international application with a designation to Ecuador, and the corresponding secret prior art documents are specifically handled to the national resolving Authorities of the Patent Office, they will not be able to find such information on a regular international search, for it will be confidential and private.

<table>
<thead>
<tr>
<th>7.c. ii</th>
<th>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

184
YES, because with the entrance to the national phase of an international application, the Patent Office will have the secret prior art documents and the international filing date, being able to issue a resolution regarding conflicting applications.

**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

Yes

**Please Explain**

YES, because the Patent Office will only be able to consider the secret prior art documents from the date in which the national phase entry is filed in Ecuador. Nevertheless, once the national phase entry has been filed in Ecuador, within 12 months from the first international filing date, the patent application claiming an international priority will take the same international filing date. Therefore, the secret prior art will depend on the international application filing date, once the national phase entry is performed.

**For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.**

**Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

**Please Explain**

YES, it is important that the secret prior art, along with the general prior art, is available for the examiner to perform a correct patentability examination and determine the novelty of the later-filed application. Nevertheless, it is important to maintain the confidentiality of the information, until the application is published. Considering that both applications are supposedly filed by the same applicants, the Patent Office will review both applications to determine that they are different. If they are identical or highly similar, the second application should be denied.

**If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?**

YES, the entire contents of the secret prior art should be available for the examiner at the Patent Office, and considering their confidentiality,

**If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?**

We consider that the standard for the correct evaluation of novelty regarding secret prior art should be higher than the standard applied to publicly available prior art, because both applications are legitimate and the later-filed application could not know that a prior application had been filed. Therefore, a strongest standard allows the application to be thoroughly analysed and the patentability examination of the later filed application will be more objective.
### 8.a.iii

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

NO, the secret prior art should always be available for the patentability examination performed by Patent Office, in order to prevent identical applications.

### 8.b

**Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

Yes

Please Explain

YES, the secret prior art must be available against claims of the later-filed application, to analyse novelty and inventive step, according to the applicable IP Provisions. This allows the examiner to determine if the applications comply with the minimum elements required for a patent application, and proceed with the full patentability examination.

### 8.b.i

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

YES, the entire contents of the secret prior art should be available for the resolving Authority, considering confidentiality.

### 8.b.ii

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

YES, the resolving Authority will consider and evaluate all the elements of the prior state of the art related to the specific case, including the secret prior art, as a part of the corresponding complete patentability analysis.

### 8.b.iii

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

We consider that the standard for the correct evaluation of lack of inventive step regarding secret prior art should be higher than the standard applied to publicly available prior art, because both applications are legitimate and the second applicant could not know that a prior application had been filed. Therefore, a strongest standard allows the application to be thoroughly analysed and the patentability examination of the later filed application will be more objective.

### 8.b.iv

If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

NO, the secret prior art should always be available for the patentability examination performed by Patent Office, in order to prevent identical applications.
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

Unless the information of the international application with a designation to Ecuador, and the corresponding secret prior art documents are specifically handled to the national resolving Authorities of the Patent Office, they will not be able to find such information on a regular international search, for it will be confidential and private.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

YES, because with the entrance to the national phase of an international application, the Patent Office will have the secret prior art documents and the international filing date, being able to issue a resolution regarding conflicting applications.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

YES, because the Patent Office will only be able to consider the secret prior art documents from the date in which the national phase entry is filed in Ecuador. Nevertheless, once the national phase entry has been filed in Ecuador, within 12 months from the first international filing date, the patent application claiming an international priority will take the same international filing date. Therefore, the secret prior art will depend on the international application filing date, once the national phase entry is performed.

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.
9.a  **Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

same as Question 7

Please Explain

9.b  **Same applicant on the dates of filing, no common inventor:**

same as Question 7

Please Explain

9.c  **Different applicants on the dates of filing, same inventors:**

same as Question 7

Please Explain

9.c.i  **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain

NO. Unless there are significant differences between both patent applications, the first-filed patent application should be granted over the second filed application, considering both have the required patentability requirements.

9.d  **Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

same as Question 7

Please Explain

9.d.i  **Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?**

No

Please Explain

9.d.ii  **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain

9.e  **Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:**

same as Question 7

Please Explain
Please Explain

9.f Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

We consider that this Study is important to develop the harmonization of common practices regarding conflicting applications, because the main goal of the protection of an invention through a patent application is to protect all the elements of the invention from any third party. Therefore, the filing date is extremely important and the national patent offices should protect the right of the first applicant over the next applicants, without considering if the applications has been published or not, for it is already subject to protection.

11 Please indicate which industry sector views are included in your Group’s answers to Part III.

Legal Industry – legal services.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
AIPPI 2018 - Study Question - Conflicting patent applications

1.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Entire content.

1.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Yes.

1.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

1.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

1.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

1.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

1.c If the secret prior art is an international application filed designating your jurisdiction:

1.c.i Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

1.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

International patent application actually entered into national phase will be published according to Estonian Patent Act § 24. If the international patent application is not entered into national phase said application will lose the effect.
<table>
<thead>
<tr>
<th>1.c.iii</th>
<th>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
</tbody>
</table>

2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

<table>
<thead>
<tr>
<th>2.a</th>
<th>Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td></td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.a.i</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Entire content.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.a.ii</th>
<th>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.a.iii</th>
<th>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes, 12 months, considering that a corresponding request is submitted by applicant.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b</th>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b.i</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>2.b.ii</th>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</th>
</tr>
</thead>
</table>
2.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

2.b.iv If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

International patent application actually entered into national phase will be published according to Estonian Patent Act §24. If the international patent application is not entered into national phase said application will lose the effect.

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain
### II. Policy considerations and proposals for improvements of your current law

#### 4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

#### 4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

---

#### 3.b. Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

#### 3.c. Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

#### 3.c.i. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

#### 3.c.ii. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

#### 3.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

#### 3.d.i. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

---
Please consult with relevant in-house / industry members of your Group in responding to Part III.
### 6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

<table>
<thead>
<tr>
<th>Yes</th>
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</table>

If YES, please respond to the following questions without regard to your Group

<table>
<thead>
<tr>
<th>7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.</th>
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<tbody>
<tr>
<td>Yes</td>
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</table>

<table>
<thead>
<tr>
<th>7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</th>
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<tbody>
<tr>
<td>Yes</td>
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</table>

Please Explain

<table>
<thead>
<tr>
<th>7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Entire content.</td>
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</table>

<table>
<thead>
<tr>
<th>7.a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</th>
</tr>
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<tbody>
<tr>
<td>Yes.</td>
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<table>
<thead>
<tr>
<th>7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
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</table>

Please Explain

<table>
<thead>
<tr>
<th>7.b.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</th>
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<tr>
<th>7.b.ii. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</th>
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<table>
<thead>
<tr>
<th>7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
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<table>
<thead>
<tr>
<th>7.b.iv. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
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<table>
<thead>
<tr>
<th>7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
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<table>
<thead>
<tr>
<th>7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
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</table>

<table>
<thead>
<tr>
<th>7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
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<tr>
<td></td>
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</tbody>
</table>
7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The international application should enter actually into national phase and only then said international patent application can be taken as secret prior art.

7.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

Entire content.

8.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Same as the standard applied to publicly available prior art.
### 8.a.iii
**If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?**

Yes, 12 months, but we are in opinion that to have such possibility the applicant must submit the request that subject matter of an invention disclosed by applicant prior to the filing date of the first application should not be taken into account. Without such a request and evidences filed by applicant during the examination the secret prior art should be taken into account.

### 8.b
**Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

No

**Please Explain**

### 8.b.i
**If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

No

**Please Explain**

### 8.b.ii
**If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?**

No

**Please Explain**

### 8.b.iii
**If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?**

No

**Please Explain**

### 8.b.iv
**If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?**

Yes

**Please Explain**

### 8.b.v
**If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?**

No

**Please Explain**

### 8.c
**If the secret prior art is an international application filed designating your jurisdiction:**

**Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.**

No

**Please Explain**

**Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

Yes

**Please Explain**
### Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

---

**Question 7** considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. **Question 8** considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

<table>
<thead>
<tr>
<th>Scenario</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td>Same applicant on the dates of filing, no common inventor:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td>Different applicants on the dates of filing, same inventors:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
</tr>
<tr>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
</tr>
</tbody>
</table>
### AIPPI 2018 - Study Question - Conflicting patent applications

<table>
<thead>
<tr>
<th>Question</th>
<th>Description</th>
<th>Answer</th>
<th>Additional Information</th>
</tr>
</thead>
<tbody>
<tr>
<td>9.d.</td>
<td><em>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</em></td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>9.e.</td>
<td><em>Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:</em></td>
<td>Same as Question 7</td>
<td></td>
</tr>
<tr>
<td>9.f.</td>
<td><em>Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:</em></td>
<td>Same as Question 7</td>
<td></td>
</tr>
</tbody>
</table>

### 10
Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

### 11
Please indicate which industry sector views are included in your Group’s answers to Part III.
Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group Finland
Contributors name(s) Kim Finnilä (Chair), Karri Leskinen, Marjukka Nuppola, Tomi Salter
e-Mail contact esa.korkeamaki@hhpartners.fi

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
AIPPI 2018 - Study Question - Conflicting patent applications

1.a If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?


Similarly, this applies to the contents of an utility model application filed in this country (FI) before the filing date of the patent application, if said application becomes available to the public pursuant to Section 18 of the Utility Model Right Act - https://www.prh.fi/en/hyodyllisyysmallit/lainsaadantoa/hyodyllisyysmallilaki.html.

1.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Yes, it is the same standard.

1.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

1.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

1.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

1.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

1.c If the secret prior art is an international application filed designating your jurisdiction:

1.c.i Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

202
### Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

<table>
<thead>
<tr>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>YES. If a previously filed international application is not pursued in Finland, the application is considered a possible bar against patenting only from the date it is published.</td>
</tr>
</tbody>
</table>

### Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

### For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

### Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

<table>
<thead>
<tr>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>Same answers as for question 1 above. No distinction is made regarding applicant(s) or inventor(s). Finnish legislation does not recognize any anti-self collision considerations.</td>
</tr>
</tbody>
</table>

### If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

### If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

### If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

### Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

### If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?
2.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

2.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

2.b.iv If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 1

Please Explain

Same answers as for question 1 above. No distinction is made regarding applicant(s) or inventor(s). Finnish legislation does not recognize any anti-self-collision considerations.

3.b Same applicant on the dates of filing, no common inventor:
### II. Policy considerations and proposals for improvements of your current law

#### 3. Different applicants on the dates of filing, same inventors:

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

#### 3.c. Different applicants on the dates of filing, same inventors:

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

#### 3.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

#### 4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

- **4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.**
  - No
  - Please Explain
  
  The present system is clear and easy to apply without any complicating exceptions to consider. However, kindly see below for particular comments regarding international applications as secret prior art.

- **4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.**
  - No
  - Please Explain

- **4.c. The treatment of international applications as secret prior art.**
  - Yes
  - Please Explain
  
  The Finnish Group considers that secret prior art filed as an international application under the PCT should be prior art as of its effective filing date.
date.

Although it may not become a “conflicting application” in any of the potential jurisdictions, national or regional, the contribution to technical
development has been made and is published. Consequently, considering the global economy of today, why should a later filed, completely
identical application result in protection of subject matter already disclosed by another party?

The whole contents approach should apply in this case as well.

---

**III. Proposals for harmonisation**

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*

---

**4. d**

The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

**4. e**

The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

**4. f**

Provisions for avoiding self-collision.

No

Please Explain

**4. g**

Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are
incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

---

**5**

Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the
scope of this Study Question?

No

Please Explain

---

**III. Proposals for harmonisation**

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*

---

**6**

Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice
could be improved.*

Yes
If YES, please respond to the following questions without regard to your Group

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

No distinction should be made regarding applicant(s) or inventor(s).

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents should be available.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as applied for publicly available prior art.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:
### 7.c Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

### 7.c Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

### 7.c Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

---

### 8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

### 8.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

<table>
<thead>
<tr>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

No distinction should be made regarding applicant(s) or inventor(s).

### 8.a If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents should be available

### 8.a If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as applied for publicly available prior art.

### 8.a If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

---

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NO. There should be no anti-self-collision considerations at all.

8.b
Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

8.b.i
If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

8.b.ii
If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b.iii
If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

8.b.iv
If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b.v
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

8.c
If the secret prior art is an international application filed designating your jurisdiction:

8.c.i
Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

8.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain
### AIPPI 2018 - Study Question - Conflicting patent applications

**c.** Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

### Question 9

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

<table>
<thead>
<tr>
<th>Scenario</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>Same applicant on the dates of filing, no common inventor:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>Different applicants on the dates of filing, same inventors:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>
9.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

Also same as Question 8

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

11. Please indicate which industry sector views are included in your Group’s answers to Part III.

Only one response was received from an Industry Member of our Group. This response supported the views expressed above.
AIPPI 2018 - Study Question - Conflicting patent applications

Study Question
Submission date: May 2, 2018
Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group France
Contributors name(s) Jacques Bauvir, President Sabine Agé, Reporter Members: Lonni Bas, Gaëlle Bourout, Agathe Caillé, Camillo Cerredo, Hélène Corret, Matthieu Dhenne, Colin Devinant, Frédérique Durieux, Alain Gallochat, Francis Hagel, Virginie Lehoux, Caroline Levesque, Estelle Marchant, Claire Mouget Goniot, Marc Nevant, Marianne Schaffner, Corinne Vedel (with the help of Candice Dupin, trainee)
e-Mail contact sabine.age@veron.com

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

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It is recalled that, under French law, only a patent application **having effect in France** is taken into account as secret prior art.

The answers given below are therefore in line with positive French law.

In addition, only the impact of conflicting applications on French patent applications and patents filed by the national route is discussed. The case for French parts of European patents (the latter deriving if applicable from Euro-PCT applications) is not specifically discussed; the specific rules provided by the EPC in respect of these cases will only be mentioned briefly.

An application for a (i) French patent, (ii) European patent designating France, or (iii) PCT designating France, is secret prior art that can be relied upon with regard to novelty against a French patent application filed between its effective filing date (i.e. its filing date or its priority date) and its publication.

This results directly from the provisions of Article L. 611-11, paragraph 3, of the French Intellectual Property Code (CPI):

> “Additionally, the content of French patent applications and of European or international patent applications designating France, as filed, the dates of filing of which are prior to the date referred to in paragraph 2 of this article and which were published on or after that date, shall be considered as comprised in the state of the art.”

The corresponding provision of the EPC is Article 54(3) EPC:

> “Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.”

**1.a.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art can be relied upon (“whole content approach”: claims, description and drawings), as filed, except for the abstract (Article R. 612-20 CPI, 1st paragraph).

This results directly from the wording of the third paragraph of Article L. 611-11 of the French Intellectual Property Code.

This “whole content approach” is consistent with the case law of the Board of Appeal of the EPO, as stated in decision T 167/84, which specified that conflicting applications within the meaning of Article 54(3) EPC are part of the state of the art and are considered in their “whole contents”.

With respect to the exception relating to the abstract, the corresponding provision of the EPC is Article 85 EPC:

> “The abstract shall serve the purpose of technical information only; it may not be taken into account for any other purpose, in particular for interpreting the scope of the protection sought or applying Article 54, paragraph 3.”

**1.a.** If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The method for assessing the novelty of an application with respect to secret prior art is the same as that used when assessing the novelty of an application with respect to a prior art document that has been the subject of disclosure before the effective filing date (non-secret prior art).

**1.b.** Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

A conflicting application of this kind, that has not yet been published on the filing date of the second application, cannot be relied upon with regard to inventive step.

This results directly from the provisions of Article L. 611-14 of the French Intellectual Property Code:
“An invention is considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art includes the documents mentioned in the third paragraph of Article L. 611-11, these documents shall not be considered in deciding whether there has been an inventive step.”

The corresponding provision of the EPC is Article 56 EPC:

“An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents shall not be considered for the assessment of the inventive step.”

1.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

1.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

1.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

1.c If the secret prior art is an international application filed designating your jurisdiction:

1.c.i Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

1.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

In France, an international application is considered to be an application that can be relied upon with regard to novelty only if it designates France (since France has closed off the strictly national route as permitted by PCT Article 45(2), this will therefore be an application that necessarily designates Europe) and only, in accordance with PCT Article 11(3), as from the time when it has been accorded an international filing date.

As soon as a conflicting international application has been published, it does not matter whether or not it enters the European phase or leads to a European patent designating France being granted; it remains capable of being relied upon with regard to novelty in relation to a subsequent French patent application, simply as a result of its publication.

Article L. 611-11 paragraph 3 CPI, and more generally the CPI as a whole, unlike the equivalent situation within the meaning of the Munich Convention (Article 54(3) EPC and Rule 165 EPC), in fact does not involve any requirements other than those of earlier filing and later publication:

“Additionally, the content of French patent applications and of European or international patent applications designating France, as filed, the dates of filing of which are prior to the date referred to in paragraph 2 of this article and which were published on or after that date, shall be considered as comprised in the state of the art.”
1.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

The relevant date for determining whether an international application is conflicting, and thus comprised in the state of the art for the assessment of novelty, is the filing date of that application, regardless of the date of any possible entry into the European phase. The phase entry (or non-entry) is not taken into account for the secret prior art classification. The date of such phase entry is therefore not relevant.

In this respect, Rule 165 EPC provides that a Euro?PCT application shall be considered as comprised in the state of the art under Article 54(3) EPC only from the publication of the international application or of the translation thereof (Article 153(3) or (4) EPC) and when the filing fee has been paid (Rule 159(1)(c) EPC).

2 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

2.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The application can be relied upon in its entirety, except for the abstract.

2.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

There is no specificity in the assessment of novelty.

2.a.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There is no anti-self collision grace period.

2.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain
### 2.B.I
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

### 2.B.II
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

### 2.B.III
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

### 2.B.IV
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

### 2.B.V
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

### 2.C
If the secret prior art is an international application filed designating your jurisdiction:

#### 2.C.I
Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

<table>
<thead>
<tr>
<th>No</th>
<th>Please Explain</th>
</tr>
</thead>
</table>

#### 2.C.II
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

<table>
<thead>
<tr>
<th>No</th>
<th>Please Explain</th>
</tr>
</thead>
</table>

#### 2.C.III
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

<table>
<thead>
<tr>
<th>No</th>
<th>Please Explain</th>
</tr>
</thead>
</table>

### 3
Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.
### II. Policy considerations and proposals for improvements of your current law

#### 3.

<table>
<thead>
<tr>
<th>Scenario</th>
<th>Additional Information</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>3.a</strong> Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>Same as Question 1</td>
</tr>
<tr>
<td><strong>3.b</strong> Same applicant on the dates of filing, no common inventor:</td>
<td>Same as Question 1</td>
</tr>
<tr>
<td><strong>3.c</strong> Different applicants on the dates of filing, same inventors:</td>
<td>Same as Question 1</td>
</tr>
<tr>
<td><strong>3.c.i</strong> Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
</tr>
<tr>
<td><strong>3.d</strong> Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>Same as Question 1</td>
</tr>
<tr>
<td><strong>3.d.i</strong> Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
</tr>
<tr>
<td><strong>3.d.ii</strong> Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
</tr>
</tbody>
</table>

#### 4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.
The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

The definition of prior art that can be relied upon against a later application, when the former was published after the second, does not require any amendments with regard to French patent law.

However, this definition could be refined with regard to earlier PCT applications that can be relied upon against European patent applications or European patents, so that such earlier PCT applications are not limited to applications that have entered the European phase, as explained below in point II. 4) c).

The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

Only the novelty of the claims of a later patent application should be assessed with regard to an unpublished earlier application, as is currently the case for patents in force in France.

The concept of "enlarged novelty", which is applied in particular in Japan, is not desirable because it involves determining whether the later application is novel in relation to the content of the unpublished earlier application and "general knowledge". However, this notion of general knowledge, used in France in the context of the assessment of inventive step, may give rise to legal uncertainty in a number of respects, relating in particular to the definition of this general knowledge (for an explanation of these difficulties, see the EPO Examination Guidelines G.VII.3.1) or the definition of the person skilled in the art in relation to whom this knowledge is defined, but also relating to the determination of the obviousness (or non-obviousness) of the claimed invention in relation to the earlier unpublished application in combination with this knowledge. Such a determination would raise the problems inherent to the assessment of inventive step, with the additional difficulty of not being able to draw upon the usual methods, such as the problem/solution approach in force at the EPO. The notion of "general knowledge of a person skilled in the art" (and the issue of non-obviousness resulting therefrom) is moreover assessed in different ways by the patent offices (Japan, EPO, USA).

In addition, the French Group believes that the application of the concepts of "distance" or "legitimate incremental invention" mentioned in the guidelines would lead to a significant accentuation of the advantage of the applicant of the first application with respect to the applicant of the second application. The French Group therefore opposes a development of this kind.

The treatment of international applications as secret prior art.

No

Please Explain

With regard to the explanations given in point I. 1) c) ii), there is no need to make amendments to French patent law.

As far as European patent law is concerned, an international application that does not enter the European phase is not considered to be a conflicting application, even though it may have been published after the filing (and before the publication) of a later application.

Two positions have emerged within the French Group in relation to the processing of international applications:

- according to the majority position, an international application should be considered as comprised in the state of the art within the meaning of Article 54(3) EPC as soon as it is published;

- according to the minority position, such an application should be considered as comprised in the state of the art within the meaning of Article 54(3) EPC only if it has entered the European phase, as provided for in Rule 165 EPC.
For the majority of members in the French Group, it would be preferable for these international applications to be processed on an equal footing with French and European patent applications, for the purposes of harmonisation and simplification.

Indeed, even if there is no longer a risk of double patenting in the event of an international application not entering into the European phase, the same treatment is required for French or European patent applications that are abandoned in the course of the examination procedure, after publication of the application, even though those applications are taken into consideration as conflicting applications.

In principle, there is no reason to distinguish between these various rights.

An international application should therefore be taken into account in the state of the art within the meaning of Article 54(3) EPC without it being useful to wait until its entry into the European phase.

A minority of the members of the French Group do not share this view and advocate for the provisions of Rule 165 EPC to be maintained, with regard to the following arguments:

- as from their publication, international applications create an option for a national or European application; in the absence of entry into the national/European phase, this option disappears upon expiry of a period of 30 months from filing, avoiding any risk of double patenting;

- no longer requiring the entry into the European phase to consider an international application as being part of the state of the art within the meaning of Article 54(3) EPC could lead to a reduction in the number of such applications entering the European phase.

### The treatment of total and partial identity of applicants as it relates to secret prior art.

Yes

Please Explain

French law should draw a distinction depending on whether or not the later application was filed by the same applicant (in whole or in part, in the event of co-ownership) as the applicant for the earlier application. If the unpublished earlier application was filed by the same applicant as the later application, it should not be taken into consideration as a prior art document, even when assessing the novelty of this later application.

This mechanism for anti-self collision should apply only to the same applicant in the strict sense. Thus, on the filing date of the second application, cases of transfer or assignment of a patent should be excluded.

However, the mechanism for anti-self collision should apply:

- in cases of co-ownership of the unpublished earlier application, if at least one of the applicants is also the applicant (or one of the applicants) of the later application; and in cases of co-ownership of the later application, if one of the applicants is identical to the applicant for the unpublished earlier application;

- in cases of change of company name of the applicant.

Anti-self collision should apply during the period of 18 months following the filing of the earlier application, without drawing a distinction between the first 12 months (during which the first application may be cited as priority) and the following 6 months.

The anti-self collision mechanism cannot circumvent the double patenting prohibition.

### The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

Yes

Please Explain
As stated above in point II. 4) d), for the application of an anti-self collision provision, it would be preferable for the applicant to be understood as identical in a strict sense (cases of transfer or assignment must therefore be excluded, but not the case of a change of name, since the legal person remains the same).

There is no need to draw a distinction depending on whether or not the inventors are identical. Nonetheless, the fact that the inventors are identical could be an indication of the proximity of the inventions within the context of double patenting.

### 4.f
**Provisions for avoiding self-collision.**

Yes

**Please Explain**

French law should be amended to provide for an anti-self collision period under the terms set forth above in point II. 4) d).

### 4.g
**Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.**

No

**Please Explain**

The French Group is not in favour of a mechanism for limiting the possibility for the same applicant to obtain protection for an invention that improves one of its earlier inventions.

### 5
**Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?**

No

**Please Explain**

### III. Proposals for harmonisation

**Please consult with relevant in-house / industry members of your Group in responding to Part III.**

### 6
**Does your Group consider that harmonisation in any or all areas in Section II desirable?**

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

Yes

*If YES, please respond to the following questions without regard to your Group*

### 7
**For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.**
7.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The French Group of the AIPPI is of the opinion that, from the perspective of harmonisation, the entire contents of the unpublished earlier application should be able to be relied upon when assessing the patentability of the invention that is the subject of a later application.

7.a.ii If YES, should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The unpublished earlier application should be assessed, with regard to novelty, in the same way as any earlier document or use that is publicly available before the priority or filing date of a later application.

7.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

7.b.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

7.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c If the secret prior art is an international application filed designating your jurisdiction:

7.c.i Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain
The French Group is of the opinion that an international application should be taken into consideration in assessing the novelty of the invention covered by a later application on the same basis as any other unpublished earlier application, insofar as that international application designates, *at the time of filing*, the State in which the later application has effect.

**7.c.ii** Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

The French Group is of the opinion that the entry into the European phase of an unpublished international application should not be a criterion for it to be able to be relied upon when assessing the patentability of a later application.

**7.c.iii** Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

An international application that has not been published before the filing date of a later French patent application is taken into consideration when assessing the novelty of that application without considering whether this international application has entered the European phase.

By contrast, an international application that has not been published before the filing date of a later European patent application (designating France) is taken into consideration when assessing the novelty of that application only if this international application has entered the European phase.

**8** For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

**9** Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

The French Group is of the opinion that, from the perspective of harmonisation, an unpublished earlier application should not be able to be relied upon against a later application when the applicants are the same or partially the same.

This anti-self collision mechanism should apply during the period of 18 months following the filing of the earlier application.

**10.** If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

**11.** If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?
### 8.a.iii
If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

### 8.b
Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

- **No**
- **Please Explain**

### 8.b.i
If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

### 8.b.ii
If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

### 8.b.iii
If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

### 8.b.iv
If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

### 8.b.v
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

- **Yes**
- **Please Explain**

The anti-self collision mechanism should apply only to the same applicant in the strict sense, on the filing date of the second application. If one of the applications (whether earlier or later) was the subject of a transfer or an assignment in full, on the filing date of the later application, the anti-self collision mechanism should not apply.

However, the mechanism for anti-self collision should apply:

- in cases of co-ownership of the unpublished earlier application, if at least one of the applicants is also the applicant (or one of the applicants) of the later application; and in cases of co-ownership of the later application, if one of the applicants is identical to the applicant for the unpublished earlier application;

- in cases of change of company name of the applicant.

In order to prevent anti-self collision from allowing the prohibition on double patenting to be circumvented, this mechanism should not apply in the event that the earlier and later applications relate to the same invention.

### 8.c
If the secret prior art is an international application filed designating your jurisdiction:
### 8.c.i

*Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.*

- **No**

- **Please Explain**

As stated in response to question 7) c) i), the French Group is of the opinion that an international application should be taken into consideration when assessing the patentability of a later application, on the same basis as any other unpublished earlier application, insofar as that international application designates, at the time of filing, the State in which the later application has effect.

### 8.c.ii

*Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.*

- **No**

- **Please Explain**

See question 4 c.

### 8.c.iii

*Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?*

- **No**

- **Please Explain**

See question 4 c.

### 9

*Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.*

#### 9.a

*Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:*

- same as Question 8

- **Please Explain**

#### 9.b

*Same applicant on the dates of filing, no common inventor:*

- same as Question 8

- **Please Explain**

#### 9.c

*Different applicants on the dates of filing, same inventors:*

- same as Question 7
9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

Yes

Please Explain

As the French Group is of the opinion that the anti-self collision mechanism should apply only to the same applicant in the strict sense, it should not be applicable when the applicants are merely part of a joint industry collaboration or an industry-university collaboration, in the context of a research project.

9.d Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

As the French Group is of the opinion that the anti-self collision mechanism should apply only to the same applicant in the strict sense, it should not be applicable when the applicants are merely part of a joint industry collaboration or an industry-university collaboration, in the context of a research project.

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.
Please indicate which industry sector views are included in your Group’s answers to Part III.

The members of the French Group involved in answering this question include representatives from the following industrial sectors: pharmacy, biotechnology, automotive, petrol and gas, nuclear.
AIPPI 2018 - Study Question - Conflicting patent applications

Study Question

Submission date: June 19, 2018

Sarah MATHESON, Reporter General
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Conflicting patent applications

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For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

2. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Both the European Patent Convention ("EPC") and the German Patent Act ("PatG") include provisions regarding the availability of secret prior art against the claims of the later-filed application for novelty-defeating purposes.

According to the EPC, secret prior art is available against the claims of a later-filed European patent application for novelty-defeating purposes if the secret prior art is

- a European patent application (Art. 54 (3) EPC) [1] that was pending on the day of its publication, [2]

or

- an international patent application according to the Patent Cooperation Treaty ("PCT") under further conditions presented as answer to question 1) c).

An earlier-filed national patent application does neither form secret prior art against the claims of the later-filed European patent application for novelty-defeating purposes in examination proceedings nor for the claims of the European patent granted on the later-filed European patent application in opposition proceedings before the European Patent Office ("EPO"). [3] The earlier-filed national patent application can, however, according to Art. 139 (2) EPC, form secret prior art against the claims of the European patent granted on the later-filed European patent application for novelty-defeating purposes in national proceedings of a Contracting State of the EPC, e.g. in a patent nullity suit in Germany. [4]

Therefore, the European patent granted on the later-filed European patent application has to designate that Contracting State and the earlier-filed patent application needs to form secret prior art against the claims of this European patent for novelty-defeating purposes according to the national provisions of the Contracting State under the condition that this European patent is treated as if it was a national patent.

According to § 3 (2) PatG, secret prior art is available against the claims of a later-filed German patent application for novelty-defeating purposes if the secret prior art is

- a German patent application,

- a European patent application under the conditions that protection is sought for Germany and the designation fee for Germany has been paid,[5]

or

- an international patent application under further conditions presented as answer to question 1) c).

Therefore, § 3 (2) PatG contains a legal fiction in favour of German, European and international applications and extends the types of prior art available for novelty-defeating purposes to include secret prior art as well.

In addition to the EPC and PatG with regard to patent applications, the German Utility Model Act ("GebrMG") includes provisions regarding the availability of secret prior art against the claims of a later-filed German utility model. German utility models are registered without an examination procedure. [6] Therefore, the secret prior art is only considered in utility model cancellation proceedings [7] or as defense in utility model infringement proceedings. [8]

According to § 15 (1) No 2 GebrMG, secret prior art is available against the claims of the later-filed German utility model in utility model cancellation proceedings if the secret prior art is a granted German patent, a granted European patent designating Germany, [9] or a registered German utility model, which is based on an earlier-filed application.

Footnotes

1. ^ Note that under Art. 54 (3) EPC 2000, which entered into force on 13 December 2007, any earlier European patent application is available for novelty-defeating purposes against a later-filed European application, regardless of which contracting states are designated in the earlier European application, and regardless of whether the corresponding designation fees have been paid. In contrast thereto, under the former regime of Arts. 54 (3), (4) EPC 1973 and Rule 23a EPC 1973, an earlier European patent application was available for novelty-defeating purposes against a later-filed European patent application only insofar as a contracting state designated in the later-filed European application was also designated in the earlier European application and the corresponding designation fee was paid. This former regime is still applicable to all European patents granted before 13 December 2007 as well as all European patent applications that were filed before 13 December 2007 and any European patents resulting therefrom.

2. ^ EPO, decision J 5/81 of 9 December 1981; BGH, decision X ZR 113/13 of 8 September 2015 – PALplus, ref. 29.


5. See also Art. 139 (1) EPC. Note that these conditions requiring that protection is sought for Germany and that the designation fee for Germany has been paid, correspond essentially to those under the former regime of Art. 54 (3), (4) EPC 1973 and Rule 23a EPC 1973 (see earlier footnote) and are thus stricter than the conditions under the current regime of Art. 54 (3) EPC 2000.

6. § 8 (1) GebrMG.

7. §§13 (1), 15 (1) No 2 GebrMG.


9. Arts. 140, 139 (1) EPC.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The secret prior art consists of the entire contents of the earlier-filed patent application.[1] The use of the entire contents of the secret prior art for defeating novelty of the claims of the later-filed German or European patent application is called “whole contents” approach. [2] The entire contents of the secret prior art include the description, drawings and claims (but not the abstract which forms only publicly available prior art once it is published), as well as any matter explicitly disclaimed (with the exception of disclaimers for unworkable embodiments), any matter for which an allowable reference to other documents is made, and prior art insofar as explicitly described. [3]

However, this situation is different in the special case in which only a portion of the subject-matter disclosed in the earlier-filed patent application has an effective filing date before the effective filing date of the later-filed patent application. In this case only the contents of the earlier-filed application having an earlier effective filing date is available against the claims of the later-filed European patent application and the later-filed German patent application.[4]

As regards utility models, if the secret prior art is a German, European or international patent application, only the claims granted on this application are available against the claims of the later-filed utility model. If the secret prior art is a utility model, the registered claims of the earlier utility model are available against the later-filed German utility model. This approach is called “prior claim” approach.

Footnotes

1. EPO, decision G 1/03 of 8 April 2004 –Disclaimer, reasons 2.1.1; BGH, decision X ZR 113/13 of 8 September 2015 –PALplus, ref. 29.

2. EPO, decision G 1/03 of 8 April 2004, Abl. EPA 2004, 413 –Disclaimer; Busse/Keukenschrijver/Keukenschrijver, PatG, 8th Ed., § 3, para. 147; Schulte/Moufang, PatG, 10th Ed., § 3 para. 80.


4. EPO, decision T 0382/07 of 26 September 2008, reasons 10; § 3 (2), sentence 2 PatG.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The subject matter of the later-filed European patent application is not new (Art. 54 (1), (3) EPC) if the subject matter can be directly and unambiguously derived from the secret prior art, i.e., if the secret prior art discloses all features of the claimed invention of the later-filed European patent application in a single embodiment. It is not permissible to combine features disclosed separately and incoherently in a single document, unless the document itself suggests such a combination of features. [1] The claimed subject matter of the later-filed European patent application is new if the claimed subject matter is distinguished from the secret prior art by at least one claim feature.

Technical equivalents not specifically disclosed in the secret prior art are not considered to form part of the disclosure of the secret prior art. [2]

The subject matter of the later-filed German patent application is considered to be disclosed in the secret prior art if the secret prior art directly and unambiguously discloses all features of the subject matter of the later-filed German patent application. [3] The skilled person interprets the disclosure of the secret prior art based on his common technical knowledge without considering further findings or modifications of the secret prior art by his technical knowledge.[4]

While secret prior art would not fall under the definitions set forth in Art. 54 (1) EPC and § 3 (1) PatG, respectively, Art. 54 (3) EPC and § 3 (2)
PatG both extend the types of prior art available for novelty-defeating purposes to include secret prior art. The standard for evaluation of novelty remains the same for both secret prior art and publicly available prior art. Publicly available prior art, however, in contrast to secret prior art, is any prior art that has been publicly disclosed, viz. anywhere, anyhow, and at any time before the effective filing date of the later-filed application. Therefore, publicly available prior art includes any oral and written disclosure publicly available anywhere in the world while secret prior art is limited to earlier-filed patent applications only as described above.

The subject matter of the later-filed German utility model is new in view of the secret prior art if the claims of the later-filed German utility model and the granted or registered claims of the secret prior art are not identical (“prior claim” approach). The types of publicly available prior art which may defeat novelty of the later-filed German utility model are different from the types of publicly available prior art which may be novelty-defeating for German and European patent applications in that publicly available prior art for the German utility model includes, according to § 3 (1) GebrMG, written disclosures (no oral disclosures) and public use of the subject matter in Germany before the effective filing date of the German utility model. Moreover, according to § 3 (1) sentence 3 GebrMG, a description or use of the subject matter of the German utility model is not novelty-defeating if such description or use was available to the public within six months prior to the effective filing date of the German utility model and the description or use is based upon the work of the applicant or his/her predecessor in title of the German utility model (“grace period”). For the consideration of such limited public prior art for German utility models the same standard for the evaluation of novelty is applied as for German and European patent applications.

Footnotes

1. ^ EPO, decision T 0305/87 of 1 September 1989 -Shear catalogue.
3. ^ BGH, decision X ZR 35/12 of 18 June 2013 -Halbleiterdotierung, reasons III. 2. a) aa).
4. ^ BGH, decision X ZR 89/07 of 16 December 2008 -Olanzapin, reasons II. 2.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Art. 56 S. 2 EPC for the later-filed European patent application and § 4 S. 2 PatG for the later-filed German patent application state that secret prior art is not available to show lack of inventive step.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:
Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

Please Explain

Further conditions have to be fulfilled in order for the international patent application to be available as secret prior art compared to the earlier-filed European patent application or the earlier-filed German patent application.

An international patent application according to the PCT is available as secret prior art against the claims of the later-filed European patent application for novelty-defeating purposes under the conditions that the EPO is designated office (“DO”) or elected office (“EO”), that the international patent application has been accorded an international date of filing, that the filing fee has been paid, and that either the international publication of the international patent application was published in one of the official languages of the EPO (English, French or German) or a translation in one of the official languages of the EPO has been filed with and published by the EPO. [1]

An international patent application according to the PCT is available as secret prior art against the claims of the later-filed German patent application for novelty-defeating purposes under the conditions

- that the German Patent and Trademark Office (“DPMA”) is DO, that a translation in German language is provided to the DPMA if the international application was not filed in German language, and that the filing fee has been paid, [2]

or

- that the EPO is DO or EO, that the international patent application has been accorded an international date of filing, that the filing fee has been paid, that protection is sought for Germany, that the designation fee for Germany has been paid, and that either the international publication of the international patent application was published in one of the languages of the EPO or a translation in one of the languages of the EPO has been filed with and published by the EPO. [3]

Footnotes

1. Arts. 153 (5), (2), (3), (4) EPC, Rules 165, 159 (1) c) EPC.

2. § 3 (2) No 3 PatG, Art III §§ 8 (3), 4 (2), 4 (1) IntPatÜbkG, Art. 22 (1), 21 PCT.

3. § 3 (2) No 2 PatG, Arts. 153 (5), (2), (3), (4) EPC, Rules 165, 159 (1) c) EPC.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

In order for the international application to enter into the national phase the requirements of Art. 22 (1) PCT need to be fulfilled for the international application. Art. 22 (1) PCT requires the applicant to furnish a copy of the international application and a translation thereof (as prescribed), and to pay the national fee (if any), to each DO not later than at the expiration of 30 months from the priority date. Art. 22 (3) PCT permits national law to fix time limits which expire later than 30 months from the priority date for performing the acts for entering the national phase.

For the international application to be available as secret prior art against the claims of the later-filed European patent application, payment of the national fee (filing fee according to Rule 159 (1) c) EPC) and a translation of the international application (either the international application published in the language of the EPO according to Art. 153 (3) EPC or a translation is filed with and published by the EPO according to Art. 153 (4) EPC) are required within 31 months of the earliest priority date of the international application. [1] Further requirements for entering the European phase according to Rule 159 (1) EPC, however, do not have to be fulfilled in order for the international application to be available as secret prior art.

The international application has to enter the German national phase in order to be available as secret prior art against the claims of the later-filed German patent application. In particular according to Art III §§ 8 (3), 4 (2) International Patent Law Treaty (“IntPatÜbkG”), the International application is only available as secret prior art for novelty-defeating purposes against the claims of the later-filed German patent application under the conditions that the DPMA is DO, that the national fee (filing fee according to No 311 150 or No 311 160 of the Annex to § 2 (1) of the Patent Costs Law (“PatKostG“)) was paid, [2] and that a translation in German language is provided to the DPMA, if the
international application was not filed in German language. These conditions have to be fulfilled within 30 months from the earliest priority date of the international application. [3]

Footnotes

1. ^ Art. 153 (5) EPC, Rules 165, 159 (1) c) EPC.

2. ^ In case that the DPMA is also EO, the filing fee is considered to be paid with payment of the transmittal fee (No 313 900 of the Annex to § 2 (1) PatKostG) according to Art III § 4 (2) S. 2 IntPatÜbkG.

3. ^ Art. 22 (1) PCT, Art III § 4 (2) IntPatÜbkG.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

The international application is available as secret prior art from its effective filing date regardless of the date of the national or regional phase entry. However, the international application is available only as secret prior art upon fulfilment of the requirements as presented in the answer to question 1) c) ii).

Footnotes

1. ^ EPO, decision T 0447/92 of 7 July 1993.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Please refer to the answer given above to question I. 1) a). Neither the EPC nor the PatG discriminates between later-filed applications by different inventors and/or applicants, and those filed by the same inventors and/or applicants.

§ 3 (2) PatG refers generally to “the following patent applications” without differentiation of the applicant. Art. 54 (3) EPC, too, refers generally to the “content of European patent applications” without further differentiation. An exception or different treatment depending on the applicant and/or inventor of the earlier-filed application can also not be derived from any other provision of the PatG or the EPC. Moreover, German and European case law assumes that there is a risk of self-collision.

The Boards of Appeal of the EPO, however, have consistently applied a very restrictive interpretation of disclosure, in order to reduce the risk of self-collision [1].

Footnotes

1. ^ EPO, decision T 0447/92 of 7 July 1993.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the earlier applications are available as prior art. Art. 54 (3) EPC and § 3 (2) PatG refer to “the content” of the earlier
applications as-filed. For more details including the definition of the “entire contents” please refer to the answer given for question I. 1) a) i) above.

**a.** If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard is the same for secret prior art and publicly available prior art. This is true for both European and German patent applications and patents under the EPC and the PatG. For more details, please refer to the answer to question I. 1) a) ii) above.

**a.** If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There is no such period, neither under the EPC for European patent applications and patents nor under the PatG for German patent applications and German patents, and European patents designating Germany.

**b.** Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art is not available to show lack of inventive step. This is stipulated in § 4 PatG for Germany and in Art. 56 EPC for European patent applications.

**b.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

**b.** If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

**b.** If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

**b.** If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

**b.** If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain
2. If the secret prior art is an international application filed designating your jurisdiction:

2.c. Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

Yes

Please Explain

Please refer to the answer given to question 1. 1) c) i) above.

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

Yes

Please Explain

Please refer to the answer to question 1. 1) c) ii) above.

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Please refer to the answer to question 1. 1) c) iii) above.

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Please refer to the answer to question 1. 1) c) iii) above.

3. Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

X same as Question 2

3.b Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group's current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain
The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

The treatment of international applications as secret prior art.

No

Please Explain

The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

Provisions for avoiding self-collision.

Yes

Currently there is no specific anti-self collision provision available in the written European or German law. However, there is case law concerning the admissibility of so-called “undisclosed disclaimers”.

A “disclaimer” is an amendment made to a claim after filing of the application, which results in the incorporation of a negative feature. The case law considers an amendment in the form of a disclaimer allowable if the disclaimer is used to excise from the claim subject-matter disclosed in a secret prior art document that would otherwise anticipate the subject-matter of the claim (e.g. “not including subject-matter X”). The wording of the disclaimer need not be originally disclosed in the later filed patent application, but must have a basis in the secret prior art. Thereby, an applicant can distinguish the subject-matter in his patent application from a secret prior art document. An undisclosed disclaimer is available to any applicant regardless of whether or not the applicant of the secret prior art and that of the later-filed application are the same, thus effectively providing anti-self collision.

Unfortunately, there was a lot of discussion about whether such undisclosed disclaimers are permissible under German and European patent law. Recently, the EPO’s Enlarged Board of Appeal confirmed again that undisclosed disclaimers are available to the applicant of a later-filed application. Thereby, the Enlarged Board of Appeal ended a discussion that was going on for years about whether or not such disclaimers were allowable. The discussion created significant uncertainty and there were decisions that held undisclosed disclaimers to be unallowable. Thus, there is a need for improvement in the form of written law that grants every applicant the right to use undisclosed disclaimers against secret prior art. We suggest to add a respective paragraph to the written law which could be based on the headnotes of one of the fundamental EPO Enlarged Board of Appeal decisions G 1/03, e.g.:

“A disclaimer may be allowable in order to

- restore novelty by delimiting a claim against state of the art under Article 54 (3) and (4) EPC (i.e. secret prior art);
- restore novelty by delimiting a claim against accidental anticipation under Art. 54 (2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention;
Please consult with relevant in-house / industry members of your Group in responding to Part III.

1. Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

Please Explain

5. Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

Please Explain

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents should be available.
7.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art. According to this standard the subject matter is new if it cannot be directly and unambiguously derived from any other single disclosure, i.e., if there is no disclosure that discloses all features of the invention in a single embodiment. The skilled person interprets the disclosure based on his common technical knowledge without considering further findings or modifications of the disclosure by his technical knowledge. Technical equivalents not specifically disclosed in the disclosure are not considered to be part of the disclosure.

7.a. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

7.b. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

7.b. Should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

Yes

Please Explain

If the secret prior art is an international application, it shall only be available for novelty-defeating purposes if it enters the national phase, as a risk of double patenting is given only in this case.

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Only if it enters the national phase it shall be available for novelty-defeating purposes.
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents should be available.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The same standard for evaluation of novelty as for publicly available prior art should be applied.

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There should be no such time period as the applicant knows his own applications and has to manage his filing strategy accordingly in order to avoid self collisions.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
8.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness? 

8.c. If the secret prior art is an international application filed designating your jurisdiction:

8.c.i. Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

Yes 

Please Explain 

If the secret prior art is an international application, it shall only be available for novelty-defeating purposes if it enters the national phase, as a risk of double patenting is given only in this case.

8.c.ii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes 

Please Explain 

Only if it enters the national phase it shall be available for novelty-defeating purposes.

8.c.iii. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No 

Please Explain
<table>
<thead>
<tr>
<th>Scenario</th>
<th>Question 7</th>
<th>Question 8</th>
</tr>
</thead>
<tbody>
<tr>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application</td>
<td>same as Question 7</td>
<td>same as Question 8</td>
</tr>
<tr>
<td>Same applicant on the dates of filing, no common inventor</td>
<td>same as Question 7</td>
<td>same as Question 8</td>
</tr>
<tr>
<td>Different applicants on the dates of filing, same inventors</td>
<td>same as Question 7</td>
<td>same as Question 8</td>
</tr>
<tr>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application</td>
<td>same as Question 7</td>
<td>same as Question 8</td>
</tr>
<tr>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
<td>No</td>
</tr>
</tbody>
</table>
Please Explain

9.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No

Please Explain

9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:
same as Question 7

Please Explain

X same as Question 8

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:
same as Question 7

Please Explain

X same as Question 8

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

No additional issues are considered to be relevant.

11. Please indicate which industry sector views are included in your Group’s answers to Part III.

The answers do not reflect any specific industry sector view. The Group consisted of practicing Patent Attorneys from all technical fields (inter alia mechanical engineers, electrical engineers, physicists, chemists, biologists, pharmacists) and Attorneys-at-law.
Study Question

Submission date: April 26, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group

Hungary

Contributors name(s)

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kereszty@godollepat.hu

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

243
1.a. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Yes, except for the abstract. According to Art. 2(3) of the Hungarian Patent Act (HUPA), the whole contents approach is followed in Hungary.

1.a.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Yes, except for the abstract. According to Art. 2(3) of the Hungarian Patent Act (HUPA), the whole contents approach is followed in Hungary.

1.a.ii. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is this the same as the standard applied to publicly available prior art.

1.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

1.b.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

–

1.b.ii. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * 

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

–

1.b.iii. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

–

1.c. If the secret prior art is an international application filed designating your jurisdiction:

1.c.i. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

Please Explain

See below.
1.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Yes. According to the general rule, the content of such an international application is only considered as available against the claims of the later-filed Hungarian application for novelty-defeating purposes, if the international application validly enters the Hungarian national phase (Art. 2(3) and 84/T(2) HUPA).

On the other hand, there exists a bypass exception to this rule as follows. The content of a European patent application is considered as available against the claims of a later-filed Hungarian application for novelty-defeating purposes, if the European patent application is published by the European Patent Office or a publication takes the place this publication (Art. 2(3) and 84/D(2) HUPA). There are no further requirements to this effect, e.g. no validation of the granted European patent in Hungary is required. In case of a Euro-PCT application, if the international publication was in an official language of the European Patent Office (i.e. English German or French), the international publication takes the place of the publication of the European patent application (Art. 153(3) EPC). Accordingly, in such situations the content of the international application is considered as available against the claims of the later-filed Hungarian application for novelty-defeating purposes, even if the Hungarian national phase is not entered.

1.c.ii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

2.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Yes, except for the abstract.

2.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is this the same as the standard applied to publicly available prior art.

2.a.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
### 2.b

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

### 2.c

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</td>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>
2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes
Please Explain

See 1.c.ii

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No
Please Explain

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1
Please Explain

3.b Same applicant on the dates of filing, no common inventor:
same as Question 1
Please Explain

3.c Different applicants on the dates of filing, same inventors:
same as Question 1
Please Explain

3.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No
Please Explain

3.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1
II. Policy considerations and proposals for improvements of your current law

<table>
<thead>
<tr>
<th>4.</th>
<th>Could any of the following aspects of your Group’s current law be improved? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>4.a</td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.b</td>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.c</td>
<td>The treatment of international applications as secret prior art.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.d</td>
<td>The treatment of total and partial identity of applicants as it relates to secret prior art.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.e</td>
<td>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>
### III. Proposals for harmonisation

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*


No

Please Explain

#### 1.c. Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

#### 5. Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain

---

**III. Proposals for harmonisation**

---

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

Yes

*If YES, please respond to the following questions without regard to your Group*

---

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Yes, except for the abstract.
7.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art.

7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

7.b.i. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

–

7.b.ii. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

–

7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

–

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c.i. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

Yes

Please Explain

See below.

7.c.ii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

7.c.iii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.
If the national phase is not entered in a country, no double patenting can occur in that country. Therefore, the content of such an international application should only be considered as available against the claims of the later-filed application for novelty-defeating purposes, if the international application validly enters the national phase in the particular country.

7.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

9 Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

Yes, except for the abstract.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art.

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

8.b.iv If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

Yes

Please Explain

See below.

8.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

If the national phase is not entered in a country, no double patenting can occur in that country. Therefore, the content of such an international application should only be considered as available against the claims of the later-filed application for novelty-defeating purposes, if the international application validly enters the national phase in the particular country.
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.b Same applicant on the dates of filing, no common inventor:

same as Question 7

Please Explain

9.c Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain
9.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

---

11. Please indicate which industry sector views are included in your Group’s answers to Part III.

Pharmaceutical industry.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
1.a.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available against the claims of the later-filed application for novelty-defeating purposes.

1.a.ii. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of lack of novelty applied to secret prior art is as follows:

1. completely identical
2. difference merely lies in the formalities or the technical feature that is derivable directly and unambiguously
3. difference merely lies in generic and specific concepts of a corresponding technical feature, suggesting that a specific term disclosed in secret prior art bars novelty of a generic term in invention
4. difference merely lies in technical feature that can be directly substituted according to the common general knowledge by a person having ordinary skills in the art

This standard applied to secret prior art is not completely the same as the standard applied to publicly available prior art. The standard applied to secret prior art as stated in (4) above is not applied to publicly available prior art.

1.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

1.b.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

1.b.ii. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

1.b.iii. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

1.c. If the secret prior art is an international application filed designating your jurisdiction:

1.c.i. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

N/A (There is no such secret prior art in our jurisdiction since it is not available for an international application to be filed designating a non-PCT member. Taiwan, or known in AIPPI's directory as Chinese Taipei, is not a PCT member.)
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

No. The secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes due to "anti-self collision" but is available for prohibiting "double patenting" based only on the claims rather than the whole contents of the secret prior art.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

N/A (There is no such secret prior art in our jurisdiction since it is not available for an international application to be filed designating a non-PCT member. Taiwan, or known in AIPPI’s directory as Chinese Taipei, is not a PCT member.)

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 2

Please Explain

Same applicant on the dates of filing, no common inventor:
same as Question 2

Please Explain

Different applicants on the dates of filing, same inventors:
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

Yes

Please Explain

4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

Yes

Please Explain

According to our current law and practice in aspect (b), the standard for evaluation of lack of novelty applied to distinguish the claims of the later-filed application from the secret prior art is slightly different from that applied to distinguish the claims of the later-filed application from the publicly available prior art. Specifically, for evaluation of lack of novelty, the standard applied to secret prior art but not applied to publicly available prior art is “direct substitution”. However, the boundary of “direct substitution” in assessing novelty applied to secret prior art and “substitution” in assessing inventive step applied to publicly available prior art is unclear. It is suggested that the standard for evaluation of


lack of novelty applied to secret prior art should be the same as that applied to publicly available prior art by eliminating the standard of “direct substitution”.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.
Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents of the secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of lack of novelty applied to secret prior art should be the same as the standard applied to publicly available prior art, which is follows:

1. completely identical
2. difference merely lies in the formalities or the technical feature that is derivable directly and unambiguously
3. difference merely lies in generic and specific concepts of a corresponding technical feature, suggesting that a specific term disclosed in secret prior art bars novelty of a generic term in invention

As said, the boundary of “direct substitution” in assessing novelty applied to secret prior art is unclear, and therefore “direct substitution” is better removed from the current evaluation standard. “Substitution” of element is believed to be a matter of inventive step (as in many other jurisdictions); thus it is supposed not included in the stage for assessing novelty.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?
7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c If the secret prior art is an international application filed designating your jurisdiction:

7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

7.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

No

8.a. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

No. The secret prior art should not be available against the claims of the later-filed application for novelty-defeating purposes due to "anti-self collision" but should be available for prohibiting "double patenting" based only on the claims rather than the whole contents of the secret prior art.
<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>b. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>c. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>d. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>e. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>f. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>g. If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>h. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>i. If the secret prior art is an international application filed designating your jurisdiction:</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>j. Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>k. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a) Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 8

9.b) Same applicant on the dates of filing, no common inventor:
same as Question 8

9.c) Different applicants on the dates of filing, same inventors:
same as Question 8

9.d) Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 7

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes
9.d. **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain

9.e. **Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:**

Same as Question 8

Please Explain

9.f. **Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:**

Same as Question 7

Please Explain

10. **Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.**

N/A

11. **Please indicate which industry sector views are included in your Group’s answers to Part III.**

Industry sector views from Information Technology (i.e. computer hardware, software, and communication device) and Telecommunication are included.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

2. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
According to article 46, no. 3 of the Italian IP Code. However, the secret prior art is available for these purposes only when it is constituted either by Italian patent applications or by European patent applications designating Italy.

a.
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

There is no case law on this point. Prevailing legal opinion maintains that the whole content of the secret prior art would be available (“whole content approach”). Other Authors maintain instead that the “prior claim approach” should be applied.

b.
If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

It is the same as the standard applied to publicly available prior art.

c.
Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

According to article 48 of the Italian IP Code the secret prior art should not be taken into consideration for the evaluation of inventive step/obviousness.

d.
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

e.
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

f.
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

g.
If the secret prior art is an international application filed designating your jurisdiction:

h.
Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

Nothing changes, because an international application constitutes a designation of Italy (Rule 4.9(a) PCT) and hence (Rule 45 PCT) also a valid European Patent Application (Art. 153(2) EPC). According to the Italian IP Code- see Question 1)a - an European Patent Application can
<table>
<thead>
<tr>
<th>Study Question - Conflicting patent applications</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>1.c.</strong> Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
</tr>
<tr>
<td>No</td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>Since, according to article 153 of the European Patent Convention, a PCT application is equivalent to an EP patent application (no direct route is available to enter a PCT national phase in Italy).</td>
</tr>
<tr>
<td><strong>1.c.ii</strong> Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
</tr>
<tr>
<td>No</td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>Because entering the national phase is irrelevant [see the above answer under c) ii]].</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Study Question - Conflicting patent applications</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>2.</strong> For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</td>
</tr>
<tr>
<td><strong>2.a.</strong> Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?</td>
</tr>
<tr>
<td>Yes</td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>See the above answer under 1) a).</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Study Question - Conflicting patent applications</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>2.a.i</strong> If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
</tr>
<tr>
<td>See the above answer under 1) a) i).</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Study Question - Conflicting patent applications</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>2.a.ii</strong> If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
</tr>
<tr>
<td>See the above answer under 1) a) ii).</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Study Question - Conflicting patent applications</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>2.a.iii</strong> If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
</tr>
</tbody>
</table>

There is not any anti-self collision time period during which the secret prior art is *not* available against the claims of the later-filed application for novelty-defeating purposes.

**2.b**

<table>
<thead>
<tr>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain

N/A

**2.b.i**

<table>
<thead>
<tr>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
</table>

**2.b.ii**

<table>
<thead>
<tr>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</th>
</tr>
</thead>
</table>

**2.b.iii**

<table>
<thead>
<tr>
<th>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
</table>

**2.b.iv**

<table>
<thead>
<tr>
<th>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
</thead>
</table>

**2.b.v**

<table>
<thead>
<tr>
<th>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</th>
</tr>
</thead>
</table>

**2.c**

<table>
<thead>
<tr>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
</table>

**2.c.i**

<table>
<thead>
<tr>
<th>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain

See the above answer under 1) c).

**2.c.ii**

<table>
<thead>
<tr>
<th>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain
See the above answer under 1) c) i).

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

See the above answer under 1) c) ii).

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

3.b Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

3.c Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

3.d Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3.e Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain
### II. Policy considerations and proposals for improvements of your current law

#### 4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<p>| | |</p>
<table>
<thead>
<tr>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>4.a</strong></td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>4.b</strong></td>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>4.c</strong></td>
<td>The treatment of international applications as secret prior art.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>4.d</strong></td>
<td>The treatment of total and partial identity of applicants as it relates to secret prior art.</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td><a href="#">The requisite of the identity of applicants should be considered for avoiding self-collision. However, in this case it could be advisable to introduce a terminal disclaimer</a></td>
<td></td>
</tr>
<tr>
<td><strong>4.e</strong></td>
<td>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</td>
</tr>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

4  Provisions for avoiding self-collision.

Yes

Please Explain

See the above answer under point d).

4  Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

5  Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

Yes

Please Explain

The Group considers that a clearer definition of secret prior art would advisable, in particular in order to clarify whether the "whole content approach" or the "prior claim approach" should apply.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6  Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

No

Even if NO, please address the following questions to the extent your Group considers your Group

7  For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7  Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?
### 7.a
If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

### 7.a.i
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

### 7.a.ii
Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

### 7.a.iii
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

### 7.b
Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

### 7.b.i
If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

### 7.b.ii
If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

### 7.b.iii
If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

### 7.c
If the secret prior art is an international application filed designating your jurisdiction:

#### 7.c.i
Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

#### 7.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

#### 7.c.iii
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

### 8
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

### 8.a
Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

### 8.a.i
If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?
Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

### 9. a
Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

### 9. b
Same applicant on the dates of filing, no common inventor:

### 9. c
Different applicants on the dates of filing, same inventors:

#### 9. c. i
Would the answers change if the different applicants were part of a joint industry or industry-university research project?

### 9. d
Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

#### 9. d. i
Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

#### 9. d. ii
Would the answers change if the different applicants were part of a joint industry or industry-university research project?

### 9. e
Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

### 9. f
Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

### 10
Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

### 11
Please indicate which industry sector views are included in your Group’s answers to Part III.
Study Question

Submission date: May 14, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAHKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Japan
Contributors name(s): Hirohito KATSUNUMA, Sumiko KOBAYASHI, Saeko Aketani, Kei KONISHI, Yoshinori SIMIZU, Hiroshi SORIMACHI, Masafumi NAKAMURA, Nobushige Furuhashi, Tomoko MIYASHITA

e-Mail contact: masatoshi.abe@aippi.or.jp

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

No.

The applicable standards are different.

(1) If the cited invention is described in secret prior art:

The claims of the later application are found to lack novelty if there is no difference between the claims and the cited invention or if there is difference but they are substantially the same. Being “substantially the same” means that, between the claims and the cited invention, there is only a minor difference in specific means for solving technical problems (such as the addition, removal or change of well-known / conventional art, provided that it does not bring about a new effect.)

(2) If the cited invention is publicly available prior art:

The claims of the later application are found to lack novelty if there is no difference between the claims and the cited invention, i.e. they are regarded as "an invention described in a publication." "An invention described in a publication" refers to an invention that is perceived from what is described in a publication or from an equivalent to what is described in a publication. "An equivalent to what is described in a publication" refers to things that the person skilled in the art can derive from what is described in a publication by taking into account common technical knowledge at the time of filing the application. "Common technical knowledge" refers to techniques generally known to the person skilled in the art, including well-known and conventional art as well as things considered evident based on experience.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:
Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

Please Explain

- Our answer to 1) b) does not change.
- Our answer to 1) a) changes if the international application is written in a foreign language, but does not change if written in Japanese.

If the international application in a foreign language has already been published internationally but not yet entered the national phase (or it is considered withdrawn because of failure to submit a translation of the application), it is cannot be used for novelty-defeating purposes. Therefore, our answer to 1) a) changes.

If the international application in a foreign language has already entered the national phase, it can be used for novelty-defeating purposes and therefore, our answer to 1) a) does not change.

If the international application in Japanese has already been published internationally, it can be used for novelty-defeating purposes, and therefore, our answer to 1) a) does not change. Our answer to 1) a) does not change regardless of whether or not the international application in Japanese has already entered the national phase, as asked in ii) below.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

This is important in relation to whether an international application in a foreign language is available for novelty-defeating purposes.

As mentioned in our answer to i), in order for an international application in a foreign language to be used for novelty-defeating purposes, it needs to enter the national phase. If the international application in a foreign language has already been published internationally but not yet entered the national phase (or it is considered withdrawn because of failure to submit a translation of the application), it cannot be used for novelty-defeating purposes. When it enters the national phase, it becomes available for novelty-defeating purposes.

On the other hand, the entry into the national phase is not important in relation to whether an international application can be used to show lack of inventive step / obviousness. It cannot be used for this purpose anyway.

The entry into the national phase does not make a difference to whether an international application in Japanese is available for novelty-defeating purposes. This is because it can be used for such purposes if it has already published internationally, regardless of whether it has entered the national phase.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

**2.** Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

**2.b** Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

**2.c** If the secret prior art is an international application filed designating your jurisdiction:
AIPPI 2018 - Study Question - Conflicting patent applications

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

2.c(ii) Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain

3.b Same applicant on the dates of filing, no common inventor:

same as Question 2

Please Explain

3.c Different applicants on the dates of filing, same inventors:

same as Question 2

Please Explain

3.c Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4.a The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

We see no need for improvement to the patentability standard itself applied to distinguishing of the claims of the later application from secret prior art. However, the relevant practice could be improved. In the following paragraphs, we will explain the practice of the Examination Guidelines in accordance with fundamental concept adopted in the Guidelines:

Firstly, we have to touch on the term "enlarged novelty" shown in parentheses in Question 4) b). This question does not explain why it lists the three categories of standard in parentheses, nor does it give a definition to each of them. For this reason, instead of these categories "applied to distinguish," we will explain specifically how the claims are distinguished from secret prior art. Secondly, as explained in Note 1 below, we will use the Japanese term kakudai-sengan, as needed, when talking about our current law in our answer, instead of "enlarged novelty."

We think that fundamental concept adopted in the Examination Guidelines explained below need to be adequately reflected in the practice of the Guidelines:

4.b The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain
Fundamental concept adopted in the Examination Guidelines in Japan:

In Japan, the claims of the later application may be found unpatentable based on secret prior art, at the one end, not only when the claims and secret prior art are exactly "the same," but also they are "substantially the same." At the other end, the scope of "substantially the same" extends only up to the level where the claims of the later application does not need to have inventive step relative to secret prior art in order to be found patentable.

More specifically, according to the standard applied to secret prior art (referring to "kakudai-sengan" in Japan; see Note 1 below), the scope of grounds for unpatentability of the claims of the later application extends beyond an invention that is "the same" as that described in said secret prior art, to an invention that is "substantially the same," meaning that there is difference between them but it is a minor difference in specific means for solving technical problems (such as the addition, removal or change of well-known / conventional art, provided that it does not bring about a new effect), as described in our answer (1) to Question 1 a) ii) above. Therefore, within the scope of grounds for unpatentability based on secret prior art, not only things described in said secret prior art, but also some different means are permissible, i.e. "such as the addition, removal or change of well-known / conventional art in specific means for solving technical problems," but this scope is limited by the condition "provided that it does not bring about a new effect."

What is the significance of this condition ("provided that ...")? The applicable standard for evaluation of novelty is different in a literal sense between secret prior art and publicly available prior art (for the latter, see our answer (2) to Question 1 a) ii) above). Anyway, it would be unreasonable to expand the scope of secret prior art, as grounds for denying novelty, to such an extent that the claims of the later application would need to have inventive step, because the inventor of the later application could not see secret prior art. Therefore, the above-mentioned condition is intended to ensure the reasonability of the standard for unpatentability.

Actual practice of the Examination Guidelines in Japan:

In light of the fundamental concept adopted in the Guidelines explained above, it is recognized that such practice could be improved in relation to the applicability of kakudai-sengan in examination and litigation. According to a report, there is variability in the assessment of whether a minor difference "brings about a new effect." For example, the invention in the later application is sometimes found to be "substantially the same" if the effect is not significant enough to have "inventive step," especially when inventions are different from each other only in numerical limitations, or it is difficult to predict an effect based on the material structure in certain technical fields (chemistry, biotechnology, etc.).

It is hoped in the future that reasonable decisions like one mentioned below will be rendered, leading to an accumulation of cases that are acceptable to practitioners:

When assessing whether or not an invention is substantially the same, well-known / conventional art should be available for taking into consideration in perceiving something stated in the specification of the earlier application only when it is clearly and concretely stated therein. If well-known / conventional art were available for taking into consideration for perceiving even when something is mentioned in an extremely abstract way, the scope of technical matters stated in the earlier application could be excessively extended, which would be unreasonably advantageous to the earlier applicant, in relation to the later applicant (1983 (Gyo Ke) No.95, decision dated 30 September 1985).

Note 1:

In Question 4) b), you include the term "enlarged novelty" in the parenthesized list of patentability standards.

Since this question is about our current law, we will explain why an invention in secret prior art that serves as grounds for unpatentability as provided by the statutory basis is called kakudai-sengan ("kakudai" means enlargement and "sengan" means an earlier application).

In Japan, secret prior art is available against the claims of the later application only for novelty-defeating purposes. In this regards, while before 1976 the scope of inventions in secret prior art available as grounds for denying novelty was limited to inventions described in the claims of the earlier application.
In 1976, this scope was "enlarged" to include inventions described in the specification of the earlier application, on condition that neither inventors nor applicants of the earlier application are the same as those of the later applications.

Under the current law of Japan, secret prior art, whose specification as a whole is available against the claims of the later application for novelty-defeating purposes, is commonly called *kakudai-sengan*.

In our answer to this question, we do not use "enlarged novelty" but the Japanese term *kakudai-sengan*, as needed, for the following reasons:

(i) The term "enlarged novelty" is confusing because it does not truly represent the actual provision in a literal sense. (ii) According to fundamental concept in many countries, both publicly available prior art and secret prior art should be available for novelty-defeating purposes, not only when the claims of later applications are "exactly the same" but also they are "substantially the same" and therefore, the three categories listed in parentheses are not really useful when we explain how the fundamental concept in Japan are different between the novelty defeating based on the publicly available prior art and that based on secret prior art.

### 4.c The treatment of international applications as secret prior art.

No

Please Explain

### 4.d The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

### 4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

### 4.f Provisions for avoiding self-collision.

No

Please Explain

### 4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

### 5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

Harmonization is desirable. The difference in laws between countries may prevent an invention from being patented in some of the countries but not in other countries. As a result, the applicant will inevitably be forced to adjust their strategies specifically to each country.

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

If the later application includes the same invention as that in secret prior art, the later application does not disclose any new invention on its date of filing. Therefore, the claims of the later application should not be patentable based on the theory that exclusive rights should be granted in exchange for disclosure of a new invention.

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The contents of the secret prior art as a whole should be available, because this is the scope of contents to be published and is also the broadest possible scope of contents that would be claimed.

7.a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes.
We agree with reservation. It depends: if the standard for evaluation of novelty applied to publicly available prior art is adequate, our answer is Yes, if not, our answer is No.

As a standard for requirement for defeating novelty, "photographic novelty" is not adequate. This is because, to meet this standard, the invention of the earlier application needs to be the same as that of the later application even in wording. As a result, the applicant of the later application will be able to easily avoid rejection on the grounds of lack of novelty through change of the word at issue to different language by amendment, in response to a notice. This would unduly limit prior art effect of the earlier application that should be protected in accordance with the first-to-file principle.

As a solution, the claims of the later application should be found to lack novelty as the claims of the later application and the cited inventions are substantially the same in the case where the difference between them is a minor difference in the means for solving technical problems (such as the addition, removal or change of well-known / conventional art, provided that it does not bring about a new effect). If such a standard is adopted, the standards for evaluation of novelty will be different in a literal sense between secret prior art and publicly available prior art. In the case of Japan, it seems easier to show lack of novelty when using secret prior art than publicly available prior art. However, the condition "the difference must not bring about a new effect" raises the bar to denial of novelty based on secret prior art, and therefore, both standards can be actually set at the same level of difficulty in practice.

As to inventive step, it is difficult to manage standard in such a manner as to be acceptable to all types of interested parties, even if the authority makes its best in preparation of the standard as objective as possible. Nevertheless, there has never been a debate on whether to abolish inventive step; on the contrary, efforts have been made to carry out the assessment of inventive step in as stable a manner as possible. The relevant patent practice has been continuously improved by those who ask for decisions and those who make decisions in examination / litigation, working on specific cases in a competitive and cooperative environment.

Given the nature of evaluation standards in the patent system, it is hoped that the practice related to novelty will also be improved if the ground of being "substantially the same" is adopted in the standard for evaluation of novelty.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Showing lack of inventive step / obviousness means establishing that the invention in the later application could be easily made by the person skilled in the art at the time of filing. However, as long as the invention in secret prior art was unpublished at the time of filing, it was impossible for the inventor / applicant to recognize it through a search, and therefore the inventor / applicant cannot be the person skilled in the art who knew the invention in secret prior art at the time of filing.

In this situation, it would be illogical to answer the question of whether it could be easily invented by the person skilled in the art at the time of filing. If secret prior art were allowed to be "used" in a situation where there is a need to make an illogical decision, it would become unpredictable as to whether secret prior art will be found to be available for the purpose of denying inventive step. Moreover, this could lead to a decline in stability of the rights that have already been granted.

In other words, it would be against the purpose of invention protection to deny creativity that is outside the scope of secret prior art, which was not yet disclosed.

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?
7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

Yes

Please Explain

• Our answer to 7) b) should not change.

• Our answer to 7) a) should change if the international application is written in a foreign language, but should not change if written in Japanese.

If the international application in a foreign language has already been published internationally but not yet entered the national phase (or it is considered withdrawn because of failure to submit a translation of the application), it should not be available for novelty-defeating purposes. Therefore, our answer to 7) a) should change.

If the international application in a foreign language has already entered the national phase, it should be available for novelty-defeating purposes and therefore, our answer to 7) a) should not change.

If the international application written in the language of the designated state has already been published internationally, it should be available for novelty-defeating purposes, and therefore, our answer to 7) a) should not change. Our answer to 7) a) should not change regardless of whether or not the international application in the language of the designated state has already entered the national phase, as asked in ii) below.

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

This should be important in relation to whether an international application in a foreign language is available for novelty-defeating purposes.

As mentioned in our answer to i), in order for an international application in a foreign language to be used for novelty-defeating purposes, it should be required to enter the national phase. If the international application in a foreign language has already been published internationally but not yet entered the national phase (or it is considered withdrawn because of failure to submit a translation of the application), it should not be available for novelty-defeating purposes. When it enters the national phase, it should become available for novelty-defeating purposes.
On the other hand, the entry into the national phase should not be important in relation to whether an international application can be used to show lack of inventive step / obviousness. This is because it should not be available for this purpose anyway.

According to the provision for Designation of States introduced by the revision to the Regulations under the PCT in 2003, if the entry into the national phase is not required of an international application in a foreign language for use as secret prior art, this application will have a prior art effect in all Contracting States including those countries where the earlier applicant does not intend to enter the application in the national phase or to obtain a patent. As a result of this, the later applicants would suffer lack of predictability, and third parties would have a greater burden of monitoring.

7.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

The international application becomes available after it is internationally published, provided that it enters the national phase.

8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

To make it possible to grant patents to incremental inventions, self-collision should be avoided when either the applicants are the same or the inventors are the same. If there are two or more applicants and inventors, anti-self collision should apply in the case of total identity between the applicants or the inventors.

8.a If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

8.a.i If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

8.a.ii If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain
<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>8.b.1</strong> If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td><strong>8.b.2</strong> If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</td>
<td></td>
</tr>
<tr>
<td><strong>8.b.3</strong> If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</td>
<td></td>
</tr>
<tr>
<td><strong>8.b.4</strong> If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td></td>
</tr>
<tr>
<td><strong>8.b.5</strong> If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
<td>No</td>
</tr>
<tr>
<td><strong>8.c.1</strong> If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
</tr>
<tr>
<td><strong>8.c.2</strong> Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td><strong>8.c.3</strong> Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td><strong>8.c.4</strong> Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
<td>No</td>
</tr>
</tbody>
</table>
Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
   Same as Question 8
   Please Explain

9. Same applicant on the dates of filing, no common inventor:
   Same as Question 8
   Please Explain

9. Different applicants on the dates of filing, same inventors:
   Same as Question 8
   Please Explain

9.c. Would the answers change if the different applicants were part of a joint industry or industry-university research project?
   No
   Please Explain
   The answers should not change as long as the applicants or the inventors are the same.

9.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
   Same as Question 7
   Please Explain

9.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
   No
   Please Explain
   The answers would not change (because the applicants are different on the dates of filing).

9.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain
The answers would not change (because the applicants are different on the dates of filing).

Please Explain

9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

11 Please indicate which industry sector views are included in your Group’s answers to Part III.

Electrical Sector, Chemical Sector, Machinery Sector.
Study Question

Submission date: May 15, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Malaysia
Contributors name(s): Christopher HEMINGWAY, Joshinae WONG
E-mail contact: debbie@advanz.com.my

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Please note that under div 14(2)(b) of the Malaysian Patents Act, the ‘secret prior art’ is effective ‘to the extent that such contents are included...
in the patent granted on the basis of the said domestic patent application’ – note granted not just published. Therefore for the purposes of this report we will assume that the ‘secret prior art’ is also granted.

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>a. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td>YES, the entire contents can be available but only to the extent that these are included in the patent granted.</td>
</tr>
<tr>
<td>a. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
<td>Yes.</td>
</tr>
<tr>
<td>b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No.</td>
</tr>
<tr>
<td>b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td>b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</td>
<td>The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.</td>
</tr>
<tr>
<td>b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
<td></td>
</tr>
<tr>
<td>c. If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
</tr>
<tr>
<td>c. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</td>
<td>Yes. Only domestic applications are considered, so the international application would have had to have entered the national phase (and subsequently been granted), not being secret prior art itself.</td>
</tr>
<tr>
<td>c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td></td>
</tr>
</tbody>
</table>
1. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

2.a.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

YES, the entire contents can be available but only to the extent that these are included in the patent granted

2.a.ii. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Yes.

2.a.iii. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

2.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No
2.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

2.b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

2.b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

2.b. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.c. If the secret prior art is an international application filed designating your jurisdiction:

2.c.1. Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

Yes

Please Explain

YES. Only domestic applications are considered, so the international application would have had to have entered the national phase (and subsequently been granted), not being secret prior art itself

2.c.2. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Yes, see (i)

2.c.3. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

NO. It depends on the date of grant of the national phase
Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 1

Please Explain

3.b Same applicant on the dates of filing, no common inventor: same as Question 1

Please Explain

3.c Different applicants on the dates of filing, same inventors: same as Question 1

Please Explain

3.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project? No

Please Explain

3.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 1

Please Explain

3.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing? No

Please Explain

3.d.ii Would the answers change if the different applicants were part of a joint industry or industry-university research project? No

Please Explain

II. Policy considerations and proposals for improvements of your current law
Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<table>
<thead>
<tr>
<th>Question</th>
<th>Improvement</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
<td>Yes</td>
<td>Please Explain. YES. It should be available as of publication, not grant (the current position is probably due to an omission when the law was changed from publication on grant to publication at 18 months)</td>
</tr>
<tr>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>The treatment of international applications as secret prior art.</td>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>The treatment of total and partial identity of applicants as it relates to secret prior art.</td>
<td>Yes</td>
<td>Please Explain. YES. Where there is total and partial identity of applicants the secret prior art should be excluded</td>
</tr>
<tr>
<td>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</td>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Provisions for avoiding self-collision.</td>
<td>Yes</td>
<td>Please Explain. Yes, see (d)</td>
</tr>
</tbody>
</table>
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

   If YES, please respond to the following questions without regard to your Group’s current law or practice.
   Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Entire contents.
<table>
<thead>
<tr>
<th>Question</th>
<th>Response</th>
</tr>
</thead>
<tbody>
<tr>
<td>7.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</td>
<td>Yes</td>
</tr>
<tr>
<td>7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
<tr>
<td>7.b.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td>7.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</td>
<td></td>
</tr>
<tr>
<td>7.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</td>
<td></td>
</tr>
<tr>
<td>7.c If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
</tr>
<tr>
<td>7.c.i Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
<tr>
<td>7.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td>Yes</td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
<tr>
<td>YES, it should have entered the national phase</td>
<td></td>
</tr>
<tr>
<td>7.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
<td>No</td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
</tbody>
</table>
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

### 8. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

**Yes**

Please Explain

### 8.a. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

Entire.

### 8.a.1. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes

### 8.a.2. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No

### 8.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

**No**

Please Explain

### 8.b.1. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

### 8.b.2. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

### 8.b.3. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?
If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

YES, it should have entered the national phase

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

Same applicant on the dates of filing, no common inventor:

same as Question 7
9.c Different applicants on the dates of filing, same inventors:

same as Question 7

9.c Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

9.d Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

9.d Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

9.f Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.
Please indicate which industry sector views are included in your Group’s answers to Part III.
**For all of the questions:**

*a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.*

*b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.*

*The standard for what constitutes adequate support is outside the scope of this Study Question.*

## I. Current law and practice

*Please answer all the below questions in Part I on the basis of your Group's current law and practice.*

### 1. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

<table>
<thead>
<tr>
<th>Yes</th>
</tr>
</thead>
</table>

*Please Explain*

Only if the secret prior art is a patent application that is still pending or has been published even if is later abandoned, as regulated by Articles
17 of the Mexican Industrial Property Law and Article 22 of its regulations.

<table>
<thead>
<tr>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>The entire contents of the secret prior art are available.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</th>
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<tbody>
<tr>
<td>It is the same as the standard applied to publicly available prior art.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Not applicable.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *</th>
</tr>
</thead>
<tbody>
<tr>
<td>Not applicable.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Not applicable.</td>
</tr>
</tbody>
</table>

| If the secret prior art is an international application filed designating your jurisdiction: |

<table>
<thead>
<tr>
<th>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain
1.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Currently, the practice shows that only if the application enters the national phase in Mexico the international application is cited as secret prior art to another later-filed application. However, the Mexican law does not contain express provisions specifically regulating this matter.

1.c.ii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Since the international application is considered as secret prior art only if it enters the national phase, theoretically, for later-filed applications examined before the national phase entry, the international application would not be cited as secret prior art. However, the Mexican law does not contain express provisions specifically regulating this matter.

2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Only if the secret prior art is a patent application that is still pending or has been published even if is later abandoned, as regulated by Articles 17 of the Mexican Industrial Property Law and Article 22 of its regulations.

2.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available.

2.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

It is the same as the standard applied to publicly available prior art.

2.a.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Only if the secret prior art is a patent application that is still pending or has been published even if is later abandoned, as regulated by Articles 17 of the Mexican Industrial Property Law and Article 22 of its regulations.

2.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available.

2.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

It is the same as the standard applied to publicly available prior art.

2.a.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
2.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

2.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Not applicable.

2.b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

Not applicable.

2.b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

Not applicable.

2.b. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Not applicable.

2.b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

No anti-self collision is applied in Mexico.

2.c. If the secret prior art is an international application filed designating your jurisdiction:

2.c. Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No
No

Please Explain

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Currently, the practice shows that only if the application enters the national phase in Mexico the international application is cited as secret prior art to another later-filed application. However, the Mexican law does not contain express provisions specifically regulating this matter.

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

Since the international application is considered as secret prior art only if it enters the national phase, theoretically, for later-filed applications examined before the national phase entry, the international application would not be cited as secret prior art. However, the Mexican law does not contain express provisions specifically regulating this matter.

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1

Please Explain

3.b Same applicant on the dates of filing, no common inventor:
same as Question 1

Please Explain

3.c Different applicants on the dates of filing, same inventors:
same as Question 1

Please Explain

3.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?
**II. Policy considerations and proposals for improvements of your current law**

4. Could any of the following aspects of your Group's current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

Yes

Please Explain

The law should be updated to clearly contemplate the PCT provisions and give certainty to the patent system because the Mexican law does not contain express provisions specifically regulating the effects of the international stage of PCT as secret prior art.

4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

4.c. The treatment of international applications as secret prior art.

Yes

Please Explain
It should be clear that an international application should be considered as secret prior art only if it enters into national phase in Mexico.

In principle it must be recognized that "secret" prior art is a theoretical definition that is useful to avoid double patenting because it is impossible for any inventor to have knowledge of such prior art possibly anticipating his invention at the time of filing his patent application.

This is why the provision on article 17 of the Mexican IPL is to avoid the possibility of granting two patents with the same subject matter filed independently very close in time. Thus, the first filed application would have the best right for obtaining a patent.

Accordingly, if an international application designating Mexico, unpublished at the date of filing of the later-filed patent application in Mexico, in the end does not enter into national phase, it would be affecting the rights of obtaining a patent in Mexico of a third party that could not have used the unpublished application to obtain the invention. Therefore, it should not be considered as (secret) prior art for the later-filed patent application since the expectation of obtaining a right in Mexico is lost at the time of not entering into national phase.

However, because this is typically an issue that is determined by each local law and both the international filing date and the international publication are deemed to have the same effects than those of each designated office, the PCT would need to be modified in order to establish clearly this issue also for the purposes of examination in the PCT so that this is managed from the treaty and not left to local law if a true harmonization is sought.

### 4.d The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

### 4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

### 4.f Provisions for avoiding self-collision.

No

Please Explain

### 4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

### 5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

Yes

Please Explain

Express prohibition of double patenting does not exist under Mexican law and it could further help interpreting the law and even avoid the need of considering secret prior art.

Moreover, the current law is not clear to define the effective filing date for secret prior art in the same sense as that of this question work, i.e. the underlined passage in point 2) below does not seem to be taken into account:
the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for
the subject matter at issue.

It is considered that such a clarification is desirable and needed.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6 Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice
could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

7 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors
of the later-filed application are unrelated.

7.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents of the secret prior art should be available.

7.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly
available prior art?

The standard should be the same as the standard applied to publicly available prior art.

7.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step /
obviousness?

No

Please Explain
### 7.b. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

Not applicable.

### 7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Not applicable.

### 7.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Not applicable.

### 7.c. If the secret prior art is an international application filed designating your jurisdiction:

#### 7.c.1. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

#### 7.c.2. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

#### 7.c.3. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

### 8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

#### 8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes
AIPPI 2018 - Study Question - Conflicting patent applications

Please Explain

a. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art should be available.

b. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard should be the same as the standard applied to publicly available prior art.

c. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

d. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

a. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Not applicable.

b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Not applicable.

c. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Not applicable.
### Question 8

#### 8.b. iv

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

**Not applicable.**

#### 8.b.v

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

**No**

Please Explain

*Anti-self collision should not be applied.*

#### 8.c

If the secret prior art is an international application filed designating your jurisdiction:

#### 8.c.i

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

**No**

Please Explain

#### 8.c.ii

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

**No**

Please Explain

#### 8.c.iii

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

**No**

Please Explain

### Question 9

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

#### 9.a

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

**same as Question 7**

Please Explain
9.b  Same applicant on the dates of filing, no common inventor:

same as Question 7

Please Explain

9.c  Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9.c.i  Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.d  Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d.i  Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

9.d.ii  Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e  Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f  Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain
Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

Secret prior art provisions are aimed mainly to avoid double patenting issues. Considering this, it would be convenient for the jurisdictions to discuss the feasibility to include the disposition contained in the Mexican legal framework by which the effective filing date of applications also takes into account the specific time (hour, minute, second) of filing, so that even in the case of two or more applications filed in the same day, secret prior art provisions can be also applied, thus completely avoiding double patenting possibilities. For these purposes, proper regard of the international nature of patent filings, particularly for PCT, must be taken considering time zone changes.

Please indicate which industry sector views are included in your Group’s answers to Part III.

No industry sector views are included in the answers of this questionnaire because no industry member of the local AIPPI Chapter (AMPPI) showed interest in participating.
Study Question

Submission date: April 30, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group
Netherlands
Contributors name(s)
Jeroen Boelens (Chairman); Liselotte Bekke; Ricardo Dijkstra; Mark Groen; Jasper Groot Koerkamp; William Jackman; Martin Klok; Maurits Westerik; Henk-Jan Zonneveld

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Yes, secret prior art is available against the claims of the later-filed application for novelty-defeating purposes in the Netherlands.

**Background**

Dutch patent law makes a distinction between European patents with a designation for the Netherlands and national patents. The stipulations covering both patents are similar, but not identical. European patents are generally governed by the European Patent Convention ("EPC") whereas national patents are governed by the Dutch Patent Act ("DPA").

**European patents**

Secret prior art is available against the claims of the later-filed application for novelty-defeating purposes. In particular, Article 54(3) EPC stipulates that the content of a European patent application shall be considered as comprised in the state of the art, provided that (i) the application has an earlier filing or valid date of priority and (ii) has been published on or after the date of the European patent application under examination. It is required that the conflicting earlier European patent application was still pending at its publication date (and has thus not been withdrawn or otherwise lost pendency before the date of publication).

A conflicting international application under the Patent Cooperation Treaty ("PCT") will also constitute secret prior art once it has entered the European phase, which entry requires the fulfillment of the following conditions as laid down in Rule 165, being that (i) the European Patent Office ("EPO") has been designated in the international application and (ii) where necessary, the applicant has supplied to the EPO a translation of the international application into an official EPO language according to Art 153(4) and Rule 159(1)(1) and (iii) the applicant has paid the filing fee according to Rule 159(1)(c).

By contrast, national applications do not form part of secret prior art under the EPC. However, once the grant of a European patent with a Dutch designation has been published by the European Patent Office ("EPO"), the patents have the same legal effect and the same rules apply to both patent types of patent (Article 49(1) DPA). Although as such applications are not a bar to the grant of a European patent, national rights of earlier dates can be invoked, after the grant of the European patent, in national proceedings as a ground for revocation. Pursuant to Article 139(2) EPC, a national patent application and a national patent in a contracting state shall have with regard to a European patent designating that contracting state the same prior right effect as if the European patent were a national patent. Article 75(2) DPA provides that the Dutch part of a European patent may be revoked on the basis of secret prior art of an earlier national patent application in Dutch court proceedings.

**National patents**

Similarly, secret prior art is available against the claims of the later-filed application for novelty-defeating purposes in the context of national patents. Under Article 4(3) DPA, the content of national Dutch patent applications will form part of the state of the art, provided that (i) the application has an earlier filing or valid date of priority and (ii) has been registered on or after the date of the national Dutch patent application under examination.

Pursuant to Article 4(4) DPA, the state of the art also comprises the content of European patent applications and EURO-PCT applications (international PCT applications for which the European Patent Office is a designated or elected Office). It is noted that The Netherlands are automatically designated for every European patent application and EURO-PCT application by virtue of the European Patent Convention.

**Footnotes**


**If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?**

European patents

The entire contents of the secret prior art are available. The "content" referred to in Article 54(3) EPC is to be interpreted as the whole disclosure, i.e. the claims but also the description and drawings.

The content does not include any priority document (having the purpose to merely determine to what extent the priority date is valid for the disclosure of the European application) nor equivalents.

National patents

Similarly, the entire contents of the secret prior art are available, as the DPA also follows the whole content approach.
AIPPI 2018 - Study Question - Conflicting patent applications

Footnotes


If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard applied for evaluation of novelty in the context of secret prior art is identical to the standard applied to publicly available prior art.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

No, the secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness in the Netherlands.

European patents
Secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness. Pursuant to Art. 56 EPC, secret prior art (within the meaning of Art. 54(3) EPC) shall not be considered in deciding whether an invention involves an inventive step.

National patents
Likewise, secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness, as secret prior art is also explicitly excluded as prior art for the purpose of determining obviousness under Art. 6 DPA.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

n.a.

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

n.a.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

n.a.
If the secret prior art is an international application filed designating your jurisdiction:

1.c Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

No, this does not change the answers to questions 1(a) and 1(b).

1.c Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

European patents

A conflicting international application under the PCT that entered the European phase will constitute prior art if the filing fee has been validly paid and, where applicable, the translation into one of the official languages has been filed (Rule 165 EPC).

National patents

The Netherlands can, at this point in time, not be designated directly for entry in the national phase; the Netherlands can only be entered by means of a European Patent Application. Should the possibility arise in the future that the Netherlands may be designated for direct entry in the National phase, this Group considers it to be likely that successful entry in the national phase is a condition to qualify as secret prior art.

1.c Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

2 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Yes, see above under question 1(a).

2.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?
The entire contents of the secret prior art are available, see above under question 1(a)(i).

<table>
<thead>
<tr>
<th>2.a.</th>
<th>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</th>
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<tbody>
<tr>
<td></td>
<td>See above under question 1(a)(ii).</td>
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<tr>
<th>2.b.</th>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
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<tbody>
<tr>
<td>Yes</td>
<td>No</td>
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<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>No, see above under question 1(b).</td>
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</table>

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<thead>
<tr>
<th>2.b.i</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
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<td></td>
<td>n.a.</td>
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</table>

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<thead>
<tr>
<th>2.b.ii</th>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</th>
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<tbody>
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<td></td>
<td>n.a.</td>
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<tr>
<th>2.b.iii</th>
<th>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
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<td></td>
<td>n.a.</td>
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<tr>
<th>2.b.iv</th>
<th>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
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<tbody>
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<td></td>
<td>n.a.</td>
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<tr>
<th>2.b.v</th>
<th>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</th>
</tr>
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<tbody>
<tr>
<td></td>
<td>n.a.</td>
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</table>
No

Please Explain

<table>
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<tr>
<th>2.c</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
</table>

<table>
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<tr>
<th>2.c</th>
<th>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>No, see above under question 1(a).</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.c.i</th>
<th>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Yes, see above under question 1(c)(ii).</td>
</tr>
</tbody>
</table>

<table>
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<tr>
<th>2.c.ii</th>
<th>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</th>
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</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Yes, see above under question 1(c)(ii).</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.c.iii</th>
<th>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</th>
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<tbody>
<tr>
<td>No</td>
<td>No</td>
</tr>
</tbody>
</table>

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a | Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application: |
<table>
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<tr>
<th></th>
<th></th>
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<tbody>
<tr>
<td></td>
<td>same as Question 1</td>
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</tbody>
</table>

3.b | Same applicant on the dates of filing, no common inventor: |
<table>
<thead>
<tr>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>same as Question 1</td>
</tr>
</tbody>
</table>
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

Our group is of the opinion that the present legislation provides an appropriate definition of how to deal with secret prior art.

4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group
Yes, our Group does consider that harmonisation is desirable for all areas. Patent law is already harmonised to a very high level, compared to for example copyright, but on this particular topic, practices diverge between jurisdictions.

To provide applicants, licensors and licensees with the legal certainty they require for doing successful business, harmonisation in this area is highly desirable. For the same reason, this group strives for a clear, small and simple set of rules for the assessment of a later-filed application in view of secret prior art, without the need of complex and expensive legal assessments on a per-country basis.

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Preliminary note from the Dutch group: the answers to question 7 are provided irrespective from whether the inventors and/or applicants are the same or different. This Group is of the opinion that there is no reason to distinguish cases having the same or different applicants/inventors. The Group realises that this may result in self-collision of patent applications having the same inventors and/or applicants. Therefore, the Dutch group proposes that part of the harmonisation efforts is directed at an advice to the effect that in cases where the later-filed application claims priority of the secret prior art, there can be no collision.

7a.1. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Yes, in the view of the Dutch group, the entire contents of the secret prior art should be available. In other words, the "whole contents" approach should prevail over the "prior claim" approach. An important reason for this is that claims may be amended over the examination procedure. If subject-matter that may be claimed by a later application is to be dependent on claims of secret prior art, such later application can only be examined after abandonment or grant of the secret prior art application or any divisional application thereof (if the prior claim approach is strictly applied). Effectively, this may prevent the later application is ever examined, which is highly undesirable. Such effect to novelty should only apply if there would be any realistic possibility of two patents in the same jurisdiction that would have exactly the same scope of protection (see c) for further details).

If there is no such realistic possibility, for example if the secret prior art related to jurisdiction X only and the later-filed application relates to jurisdiction Y only, the answer is no. Also, another reason for the Dutch group’s preference of the "whole contents" approach is that the secret publication may describe aspects of the described invention which are not incorporated in the claims (e.g. as a consequence of the first-to-file system as implemented in Europe). Such described but not claimed aspects do form part of the disclosure of the secret prior art, and should therefore be taken into account for the evaluation of novelty of the later-filed application.

7a.2. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

In the opinion of the Dutch group, there should a single standard for the evaluation of novelty; it has to be assessed what the skilled person is able to directly and unambiguously derive from the secret prior art as filed - and later published. So yes, the standard for evaluation of novelty of secret prior art should be the same as the standard applied to publicly available prior art.

7b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain
No, such secret prior art should not be available against the claims of the later-filed application to show lack of inventive step / obviousness. An important reason for this is that at the filing date or priority date of the later-filed application, the secret prior art is not available to the skilled person. Therefore, at the filing date or priority date of the later-filed application, the skilled person would not be able to use the information in the secret prior art to combine it with publically available prior art to arrive at subject-matter of the later-filed application. Taking secret prior art into account for assessment of inventive step or obviousness would therefore conflict with the general concept of how inventive and obviousness are defined and assessed. Such conflict is detrimental to the objectives of providing a clear, small and simple set of rules and it therefore highly undesired.

| 7.b. | If YES, should the entire contents of the secret prior art available, or only a portion such as the claims? |
| 7.b. | If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness? |
| 7.b. | If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art? |
| 7.c. | If the secret prior art is an international application filed designating your jurisdiction: |
| 7.c.i | Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain. |
| Yes |
| Please Explain |

Yes, the concept of using secret prior art in the assessment of novelty of an invention is to offer a solution for a practical issue arising in the first-to-file system. Secret prior art is only to be used in jurisdictions where there is a realistic possibility that a later-filed application might result in a patent with the same scope of protection as the secret prior art may result in.

| 7.c. | Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain. |
| Yes |
| Please Explain |

Yes, it certainly matters whether the international application actually enters the national phase in the applicable jurisdiction. Only if the international application actually enters the national phase, a realistic possibility exists that the secret prior art and the later-filed application may result in patents having the same scope of protection.

| 7.c. | Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction? |
| No |
| Please Explain |
No, the date of entry of the international application in the national phase should not matter. If the secret prior art enters the national phase, it is presumed to have been filed at the earliest priority date of the secret prior art. Please note that with multiple priority dates, different parts of the secret prior art may have different priority dates.

**For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.**

8. **Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

8.a. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

8.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

8.a. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b. **Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

8.b. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

8.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

8.b. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?
### 9.3
If the secret prior art is an international application filed designating your jurisdiction:

**9.c** Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

**9.6** Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

**9.6** Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

### 9
Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

#### 9.a
Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

#### 9.b
Same applicant on the dates of filing, no common inventor:

#### 9.c
Different applicants on the dates of filing, same inventors:

**9.c.i** Would the answers change if the different applicants were part of a joint industry or industry-university research project?

**9.d** Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

**9.d.i** Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

**9.d.ii** Would the answers change if the different applicants were part of a joint industry or industry-university research project?
9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

9.f Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

The Unitary Patent Regulation, which is expected to be enter into force in the future, also addresses the issue of secret prior art. In particular, Art. 3(1) of the Unitary Patent Regulation 1257/2012 (UPR) provides that "[a] European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection. A European patent granted with different sets of claims for different participating Member States shall not benefit from unitary effect." Unlike EU trade marks, Unitary patents (UPs) cannot be converted into national EPs. Since the CJEU has not yet interpreted this provision, it is not fully clear what will happen with a UP if after the grant of the unitary effect there is a collision with an earlier filed but later published application for a national patent under Art. 139(2) EPC. With respect to EPs, the EPs for all other countries are not affected, but for UPs the situation is not yet fully in view of the same set of claims rule of Article 3(1) (UPR).

11 Please indicate which industry sector views are included in your Group’s answers to Part III.

n.a.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
**AIPPI 2018 - Study Question - Conflicting patent applications**

Yes, as per div 8(2) of Patents Act 2013

<table>
<thead>
<tr>
<th>Q</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>a.</td>
<td>Whole of contents of specification</td>
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</tbody>
</table>

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<thead>
<tr>
<th>Q</th>
<th>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</th>
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</thead>
<tbody>
<tr>
<td>a.i</td>
<td>The standard for novelty is the same for &quot;secret prior art&quot; as for published prior art. The test for novelty in New Zealand is as per General Tire &amp; Rubber Company v The Firestone Tyre and Rubber Company and other [1972] RPC 457 – “clear and unmistakable directions”</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Q</th>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
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</thead>
<tbody>
<tr>
<td>b.</td>
<td>No</td>
</tr>
</tbody>
</table>

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</thead>
<tbody>
<tr>
<td>b.i</td>
<td>No</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Q</th>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *</th>
</tr>
</thead>
<tbody>
<tr>
<td>b.ii</td>
<td>The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Q</th>
<th>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td>b.iii</td>
<td>No</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Q</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
<tbody>
<tr>
<td>c.</td>
<td>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Q</th>
<th>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>c.</td>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain
1.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

2 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Yes, no anti-self collision for patent prior art in New Zealand

2.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Entire contents, same as Q1

2.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Same as Q1

2.a.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No

2.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

2.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

No
<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>2.b.iii</td>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
</tr>
<tr>
<td>2.b.iv</td>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
</tr>
<tr>
<td>2.b.v</td>
<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
</tr>
<tr>
<td>2.c</td>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
</tr>
<tr>
<td>2.c.i</td>
<td>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>2.c.ii</td>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>2.c.iii</td>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>3</td>
<td>Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.</td>
</tr>
<tr>
<td>3.a</td>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
</tr>
<tr>
<td></td>
<td>same as Question 1</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>3.b</td>
<td>Same applicant on the dates of filing, no common inventor:</td>
</tr>
</tbody>
</table>
II. Policy considerations and proposals for improvements of your current law

<table>
<thead>
<tr>
<th>Question</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>3.a</td>
<td>Different applicants on the dates of filing, same inventors:</td>
</tr>
<tr>
<td>3.b</td>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
</tr>
<tr>
<td>3.c</td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
</tr>
<tr>
<td>3.d</td>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
</tr>
<tr>
<td>3.d.i</td>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
</tr>
<tr>
<td>3.d.ii</td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
</tr>
</tbody>
</table>

4. Could any of the following aspects of your Group's current law be improved? If YES, please explain.

<table>
<thead>
<tr>
<th>Question</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>4.a</td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
</tr>
<tr>
<td>4.b</td>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
</tr>
<tr>
<td>4.c</td>
<td></td>
</tr>
</tbody>
</table>
### III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

<table>
<thead>
<tr>
<th>4.c</th>
<th>The treatment of international applications as secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>

**Please Explain**

<table>
<thead>
<tr>
<th>4.c</th>
<th>The treatment of total and partial identity of applicants as it relates to secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>

**Please Explain**

<table>
<thead>
<tr>
<th>4.c</th>
<th>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>

**Please Explain**

<table>
<thead>
<tr>
<th>4.f</th>
<th>Provisions for avoiding self-collision.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>

**Please Explain**

<table>
<thead>
<tr>
<th>4.g</th>
<th>Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>

**Please Explain**

<table>
<thead>
<tr>
<th>5</th>
<th>Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>

**Please Explain**

---

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

---
Yes

If YES, please respond to the following questions without regard to your Group

7. **For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.**

7.a. **Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Entire contents

7.a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Sanes as publicly available prior art

7.b. **Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

No

Please Explain

7.b.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

7.b.ii. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c. If the secret prior art is an international application filed designating your jurisdiction:

...
7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

7.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

Entire contents

8.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Same standard

8.a. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No
### 8.b
Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

**Please Explain**

### 8.b.i
If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

### 8.b.ii
If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

### 8.b.iii
If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

### 8.b.iv
If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

### 8.b.v
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

### 8.c
If the secret prior art is an international application filed designating your jurisdiction:

#### 8.c.i
Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

**Please Explain**

#### 8.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

**Please Explain**

#### 8.c.iii
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

**Please Explain**
Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

<table>
<thead>
<tr>
<th>Scenario</th>
<th>Same as Question 7</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>Same as Question 7</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Same applicant on the dates of filing, no common inventor:</td>
<td>Same as Question 7</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Different applicants on the dates of filing, same inventors:</td>
<td>Same as Question 7</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>Same as Question 7</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

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9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

11. Please indicate which industry sector views are included in your Group’s answers to Part III.
Study Question

Submission date: April 30, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Norway
Contributors name(s): Harald TAFJORD
E-Mail contact: amsv@grette.no

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

In Norway, the secret prior art is always available as prior art to a later-filed application, for novelty only, cf. Norwegian Patents Act div 2.
second paragraph.

The European Patent Convention (EPC)—to which Norway is a Contracting State has near identical provisions, see EPC Art. 54(3) and Art. 56.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art, except the abstract, which is not considered a part of the application as such, are available, cf. Norwegian Patents Act div 2, second paragraph.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

YES, the same novelty standard is applied to secret prior art as to publicly available prior art. This is implied in div 2 of the Norwegian Patents Act.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

A secret prior art international patent application designating Norway and entering national phase in Norway shall be considered as prior art for later filed applications with respect to novelty, cf. Norwegian Patents Act div 29, but is not available against the claims of the later filed application to show lack of inventive step.
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Yes, see answer to 1 c) i) above. Cf. Norwegian Patents Act divs 29 and 31. The secret prior art must be a valid patent application on the filing date for the later filed application.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

An international patent application to which the receiving Office has accorded an international filing date shall have the same effect as a patent application filed in Norway on the same date. However, this applies only if the application enters the national phase and fulfils formal criteria to be a valid application. International patent applications which are withdrawn before or on the filing date of the later filed application shall not be considered secret prior art. Cf. Patents Act divs 29 and 31.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

The Norwegian Patents Act does not distinguish between related or unrelated applicants. However, in the rare situation where two or more applications from the same applicant have the same effective date and relate to same subject matter, the applicant is requested to amend one or more of the applications or to withdraw applications to prevent double patenting. Cf. Examiner Guidelines Part C, chapter IV, item 4.2.5.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art is available except the abstract which is not considered a part of the application as such, Patent Guidelines Part C, chapter IV, Item 4.2.1.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Yes, the standard for evaluation of novelty is the same for secret prior art as it is for publicly available prior art, see the answer to Q 1) a) ii).
AIPPI 2018 - Study Question - Conflicting patent applications

2.a.iii
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There is no anti-self collision time period available.

2.b 
Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

According to the Norwegian Patents Act only novelty shall be considered with respect to secret prior art, cf. Norwegian Patents Act div 2 second paragraph, last sentence.

The European Patent Convention (EPC)—to which Norway is a Contracting State, has near identical provisions, see EPC Art. 54(3) and Art. 56.

2.b.i
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

2.b.ii
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

2.b.iii
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

2.b.iv
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.b.v
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.c 
If the secret prior art is an international application filed designating your jurisdiction:

2.c.i
Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

No, as long as the international application is alive on the filing date of the later application and is not withdrawn before the publishing date.
3.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The international application must enter national phase in Norway and it must be alive on the filing date of the later application, see div 29, cp. div 31, Patents Act.

3.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

An international patent application to which the receiving Office has accorded an international filing date shall have the same effect as a patent application filed in Norway on the same date. However, this applies only if the application enters the national phase and fulfills formal criteria to be a valid application. International patent applications which are withdrawn before the filing date or on the filing date of the later filed application shall not be considered secret prior art, see divs 29 and 31 Patents Act.

3. Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain

In Norway no distinction is made between related and unrelated applicants in this regard.

3.b. Same applicant on the dates of filing, no common inventor:

same as Question 2

Please Explain

3.c. Different applicants on the dates of filing, same inventors:

same as Question 2

Please Explain

3.c. Would the answers change if the different applicants were part of a joint industry or industry-university research project?
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

The Norwegian Group does not believe that amendments to the definition are called for.

4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

Applying the same novelty standard as for other patent applications works well in practice. Inventive step is too strict, taking into account that the secret prior art does not fall within what is normally considered publicly available prior art. Novelty is however necessary to avoid double patenting and to avoid that applicants file several applications relating to the same subject matter and thereby extend the time of protection.

4.c. The treatment of international applications as secret prior art.

No
III. Proposals for harmonisation

Please Explain

International patent application shall in principle have the same effect as national applications provided that formal requirements are met. There is no reason to treat international applications differently, compared to national applications.

4.d The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

No amendments required

4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

No amendments required

4.f Provisions for avoiding self-collision.

No

Please Explain

No amendments required

4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

No need to amend the law, i.e. secret prior art shall only be assessed with respect to novelty.

5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain

III. Proposals for harmonisation
Please consult with relevant in-house / industry members of your Group in responding to Part III.

6
Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

Full harmonisation is desirable in all areas of Section II

7
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a
Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i
If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The whole content of an application should be available as secret prior art, except the abstract.

7.a.ii
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, it should be the same standard.

7.b
Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art should not be available against claims in a later-filed application to show lack of inventive step.
### 7.b.  If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

**If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?**

### 7.b.ii  If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

**If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?**

### 7.b.iii  If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

### 7.c.  If the secret prior art is an international application filed designating your jurisdiction:

**Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.**

- **No**

**Please Explain**

### 7.c.ii  Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

- **Yes**

**Please Explain**

Only applications that enter national phase and fulfill the formal requirement pursuant to Norwegian Patents Act should be considered secret prior art, see divs 29 and 31 Patents Act. According to EPC the same applies, cf. Art. 54(3) EPC, Art. 153 EPC in conjunction with Rule 165.

### 7.c.iii  Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

- **Yes**

**Please Explain**

An international patent application to which the receiving Office has accorded an international filing date shall have the same effect as a patent application filed in Norway on the same date. However, this applies only if the application enters the national phase and fulfills the formal criteria to be a valid application. International patent applications which are withdrawn before the filing date or on the filing date of the later filed application shall not be considered secret prior art. Cf. Patents Act div 29 and 31.

The same applies according to the EPC.

### 8  For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.
### Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

**Yes**

**Please Explain**

#### If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Yes, the entire contents of the secret prior art should be available.

#### If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, it should.

#### If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No, there should not be an anti-self collision time period.

### Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

**No**

**Please Explain**

The novelty assessment is sufficient to avoid double patenting while also ensuring that incremental inventions may be patentable secret prior art notwithstanding.

#### If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

#### If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

#### If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?
b. If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

c. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

d. If the secret prior art is an international application filed designating your jurisdiction:

d.i. Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

d.ii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Please see Section I no. 1c) i) and ii), Section I no. 2c) ii) and Section III 7c) ii) above.

d.iii. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

1. Please see Section III 7c) iii) above.

9. Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

a. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 8

Please Explain
9.b Same applicant on the dates of filing, no common inventor:
same as Question 8
Please Explain

9.c Different applicants on the dates of filing, same inventors:
same as Question 8
Please Explain

9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 8
Please Explain

9.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
No
Please Explain

9.d.ii Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain

9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:
same as Question 8
Please Explain

9.f Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

10 Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.
No comments on any additional issues concerning conflicting applications.

Please indicate which industry sector views are included in your Group’s answers to Part III.

Only IP advisers/EPA/lawyers
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Yes, it is. In effect, the Paraguayan Patent Law, in its Article 7th – NOVELTY – stipulates that in order to determine the novelty of an invention, the contents of any patent application which is being processed before the Office of Industrial Property which application date or priority date is previous to the subsequent patent application concerned is considered prior art and studied for the purposes of determining the novelty of the subsequent patent application.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Only a portion of the claims of the previous patent application is available as prior art, given that the Patent Law sets forth that such prior art is available only to the extent to which the contents of the subsequent patent application is included in the previous patent application.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation is the same; the only limitation refers to the extent of the availability of the claims; the secret prior art is analysed only as far as it refers or relates to the claims of the subsequent patent application.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No. The Paraguayan Patent Law stipulates that the inventive step or obviousness is determined on the basis of:

a. Whether the invention is not obvious for a person who is an expert in the field concerned; and/or

b. Whether the invention can be considered as derived – evidently – from prior art. With respect to prior art, the Patent Law considers that: “Prior Art does not include what has been disclosed within the year which predates the application in Paraguay or, where applicable, within the year that predates the date of the application which priority is being claimed.”

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? *

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:
### 1.c.i
Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

Paraguay is not a party to the PCT nor any other Patent Cooperation Treaty.

### 1.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

Not applicable according to the Paraguayan Legislation. Please refer to 1.c.i above.

### 1.c.iii
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Not applicable according to the Paraguayan Legislation. Please refer to 1.c.i above.

### 2
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

### 2.a
Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Yes. The responses given for question 1 are also applicable for the present question, given that the Paraguayan Patent Law does not differentiate between patent applications filed by different applicants or by the same applicant nor if such patents were invented by different inventors or the same inventors.

### 2.a.i
If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Only a portion of the claims of the previous patent application is available as prior art, given that the Patent Law sets forth that such prior art is available only to the extent to which the contents of the subsequent patent application is included in the previous patent application.
If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation is the same; the only limitation refers to the extent of the availability of the claims; the secret prior art is analysed only as far as it refers or relates to the claims of the subsequent patent application.

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No, there isn’t.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

No. The Paraguayan Patent Law stipulates that the inventive step or obviousness is determined on the basis of:

a. Whether the invention is not obvious for a person who is an expert in the field concerned; and/or

b. Whether the invention can be considered as derived – evidently – from prior art. With respect to prior art, the Patent Law considers that: “Prior Art does not include what has been disclosed within the year which predates the application in Paraguay or, where applicable, within the year that predates the date of the application which priority is being claimed.”

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain
There are no anti-self collision rules in Paraguay and hence there are no restrictions as far as the possibility of double patenting is concerned.

2. If the secret prior art is an international application filed designating your jurisdiction:

2.c Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

3.b Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

3.c Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain
AIPPI 2018 - Study Question - Conflicting patent applications

II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

- The definition of when secret prior art is applicable to defeat patentability of a later-filed application.
  
  No

- The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.
  
  No

- The treatment of international applications as secret prior art.
  
  No
### III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

<table>
<thead>
<tr>
<th>4.d</th>
<th>The treatment of total and partial identity of applicants as it relates to secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.e</td>
<td>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.f</td>
<td>Provisions for avoiding self-collision.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.g</td>
<td>Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>5</th>
<th>Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
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</tbody>
</table>

Yes. This Study Group considers that a set of rules or standards for defining the level of similarity/identity or connection between the conflicting applications should be established in order to determine the novelty and possible lack of inventiveness/obviousness of the later-filed patent application.

<table>
<thead>
<tr>
<th>6</th>
<th>Does your Group consider that harmonisation in any or all areas in Section II desirable?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>If YES, please respond to the following questions without regard to your Group’s current law or practice.</td>
</tr>
<tr>
<td></td>
<td>Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.</td>
</tr>
<tr>
<td>Yes</td>
<td>If YES, please respond to the following questions without regard to your Group</td>
</tr>
</tbody>
</table>
Yes, this Group considers that harmonisation in at least some of the areas in Section II is desirable.

7 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7 Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Yes. This Group considers that the secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes, but only to the extent to which the later-filed application is related or comprehended within the claims of the previously-filed application.

7 If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

As mentioned above, hat the secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes, but only to the extent to which the later-filed application is related or comprehended within the claims of the previously-filed application.

7 If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, the standard applied should be the same as the publicly available prior art.

7 Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes

Please Explain

It is this Study Group's opinion that secret prior art should be available not only for determining the novelty of a later-filed patent application, but also to determine its inventive step/obviousness.

7 If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Only a portion of the claims, namely, the claims that refer specifically to the later-filed patent application.
<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</td>
<td>Yes.</td>
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<td>If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</td>
<td>Yes.</td>
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<tr>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
</tr>
<tr>
<td>Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
<td>No</td>
</tr>
<tr>
<td>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</td>
<td></td>
</tr>
<tr>
<td>Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</td>
<td>Yes</td>
</tr>
</tbody>
</table>

Yes. This Group considers that the secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes, but only to the extent to which the later-filed application is related or comprehended within the claims of the previously-filed application.
If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

As mentioned above, secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes, but only to the extent to which the later-filed application is related or comprehended within the claims of the previously-filed application.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, the standard applied should be the same as the publicly available prior art.

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No, this Group considers that there shouldn’t be a time period during which secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes.

Please Explain

Yes. This Group considers that the secret prior art should be available against the claims of the later-filed application for demonstrating the lack of inventive step or obviousness, but only to the extent to which the later-filed application is related or comprehended within the claims of the previously-filed application.

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Yes.

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Yes.

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?
Yes.

8.b.iv
If YES, should there be an anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No, this Group considers that there shouldn’t be a time period during which secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes.

8.b.v
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

8.c
If the secret prior art is an international application filed designating your jurisdiction:

8.c.i
Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

8.c.ii
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

8.c.iii
Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

9
Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.
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<tr>
<td><strong>9.a</strong> Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
</tr>
<tr>
<td>same as Question 7</td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>9.b</strong> Same applicant on the dates of filing, no common inventor:</td>
</tr>
<tr>
<td>same as Question 7</td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>9.c</strong> Different applicants on the dates of filing, same inventors:</td>
</tr>
<tr>
<td>same as Question 7</td>
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<tr>
<td>Please Explain</td>
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<tr>
<td><strong>9.c.i</strong> Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
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<tr>
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</tr>
<tr>
<td>Please Explain</td>
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<tr>
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<tr>
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</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>9.d.ii</strong> Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
</tr>
<tr>
<td>No</td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td><strong>9.e</strong> Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:</td>
</tr>
<tr>
<td>same as Question 7</td>
</tr>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>
9.f. **Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:**

same as Question 7

Please Explain

10. **Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.**

No additional issues.

11. **Please indicate which industry sector views are included in your Group’s answers to Part III.**

The Group’s answers refer to agrochemical, engineering and pharmaceutical industries.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Yes, under the First to File rule.

**a.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available for novelty-defeating purposes.

**a.** If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard of evaluation on novelty is the same as applied to public available prior art.

**b.** Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

No, because until the publication of the application, it cannot be known by a person skilled in the art who for this reason cannot make any judgment on the issue.

**b.** If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

N/A

**b.** If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

N/A

**b.** If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

N/A

**c.** If the secret prior art is an international application filed designating your jurisdiction:


### 1. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

No, same treatment.

### 1. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

No, same treatment.

### 1. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No, same treatment.

### 2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

### 2. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

No. But during the formality stage, i.e., before the 18th month publication, the applicant is notified to amend the claims of either one of the two applications. If applicant fails to amend the claims of any of the two applications after the notification to amend before the 18th month publication of the applications, the entire content of the earlier filed application (secret prior art) becomes a novelty-destroying prior art after the 18th month publication.

### 3. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

N/A

### 4. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?
<table>
<thead>
<tr>
<th>Q</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>2.a.iii</strong></td>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
</tr>
<tr>
<td>N/A</td>
<td></td>
</tr>
<tr>
<td><strong>2.b</strong></td>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
</tr>
<tr>
<td>No</td>
<td>No, for the same reasons explained in 1(b) above.</td>
</tr>
<tr>
<td><strong>2.b.i</strong></td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
</tr>
<tr>
<td>N/A</td>
<td></td>
</tr>
<tr>
<td><strong>2.b.ii</strong></td>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</td>
</tr>
<tr>
<td>N/A</td>
<td></td>
</tr>
<tr>
<td><strong>2.b.iii</strong></td>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
</tr>
<tr>
<td>N/A</td>
<td></td>
</tr>
<tr>
<td><strong>2.b.iv</strong></td>
<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
</tr>
<tr>
<td>N/A</td>
<td></td>
</tr>
<tr>
<td><strong>2.b.v</strong></td>
<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>
Yes, an example would be the requirement for the amendment of claims as explained in the answer to Question 2(a), supra.

2.c  If the secret prior art is an international application filed designating your jurisdiction:

2.c Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

No, same treatment.

2.c Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

No, same treatment.

2.c Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No, same treatment.

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain

3.b Same applicant on the dates of filing, no common inventor:

same as Question 2
### II. Policy considerations and proposals for improvements of your current law

#### 4 Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<table>
<thead>
<tr>
<th>4.a</th>
<th>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>
No, we have no law on this subject at present. The enactment of a clear cut law on this is desirable.

The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

No, same as 4(a) above.

The treatment of international applications as secret prior art.

No

Please Explain

No, same as 4(a) above.

The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

No, same as 4(a) above.

The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

No, same as 4(a) above.

Provisions for avoiding self-collision.

No

Please Explain

No current law on the subject. However, there are provisions on the subject in the Manual for Patent Examination Practice that is followed in the IPOPhil.
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?
   If YES, please respond to the following questions without regard to your Group’s current law or practice.
   Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

   Yes

   If YES, please respond to the following questions without regard to your Group

   Yes, harmonisation is desirable.

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

   Yes

   Please Explain

7.b. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
Yes, the entire contents of the secret prior art should be made available. This is the most widely accepted approach in patent systems all over the world. This approach gives maximum range of the scope of claims of the prior application.

### 7.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes, same standard for uniformity.

### 7.b.

#### 7.b.i. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

N/A

#### 7.b.ii. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

N/A

#### 7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

N/A

### 7.c.

If the secret prior art is an international application filed designating your jurisdiction:

#### 7.c.i. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

No. This is the less accepted approach in patent systems all over the world. This would be unfair to the second applicant because at the time of the filing of the first application, it is still unknown to a person skilled in the art.
### AIPPI 2018 - Study Question - Conflicting patent applications

<table>
<thead>
<tr>
<th>7.c</th>
<th>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>7.c</th>
<th>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8</th>
<th>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>8.a</th>
<th>Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Yes</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8.a.i</th>
<th>If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Yes, the entire contents of the secret prior art.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8.a.ii</th>
<th>If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Yes, the same standard to publicly prior art should apply for uniformity.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8.a.iii</th>
<th>If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Yes, there should be a time period say two months from notification of existence of collision.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8.b</th>
<th>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>
No, the determination of whether the later-filed application lacks inventive step or is obvious is made by the patent examiner based on his general knowledge and expertise in the field of science under which the two applications in question fall. It appears that the secret prior art may not have anything to do with it.

8.b.i  If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
N/A

8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?
N/A

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?
N/A

8.b.iv If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
N/A

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?
Yes

Please Explain
Yes, please see our answer to Question 2)a). Also the period of publication of both applications should be made co-terminous.

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.
No

Please Explain
8.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

No, same treatment.

8.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No, same treatment.

9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 8

Please Explain

9.b Same applicant on the dates of filing, no common inventor:

same as Question 8

Please Explain

9.c Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9.d Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain
9.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes

Please Explain

9.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 8

Please Explain

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

No additional issues in mind as our primordial concern at the moment is for our legislature to enact a clear cut law on secret prior art.

11. Please indicate which industry sector views are included in your Group’s answers to Part III.

Philippine-patent-law practitioners were consulted.
Study Question

Submission date: June 18, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAKKONEN and Ralph NACK, Assistants to the Reporter General
Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Poland
Contributors name(s): Katarzyna Karcz
e-Mail contact: marcin.fijalkowski@bakermckenzie.com

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

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1.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art available.

1.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is the same as the standard applied to publicly available prior art.

1.b If YES, is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

1.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness.

1.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

The secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness.

1.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

The secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness.

1.c If the secret prior art is an international application filed designating your jurisdiction:

1.c.i Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.
1.c.ii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The international application must enter the national phase in Poland and a relevant information must be published by the Bulletin of the Polish Patent Office.

1.c.iii. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

It depends on the date of publication of the information about the national phase entry by the Bulletin of the Polish Patent Office.

2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

- 

2.a.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available

2.a.ii. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is the same as the standard applied to publicly available prior art.
2.a.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

2.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

-  

2.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

-  

2.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

-  

2.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

-  

2.b.iv If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

-  

2.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

-  

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### Question 2

If the secret prior art is an international application filed designating your jurisdiction:

#### 2.c

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

<table>
<thead>
<tr>
<th>No</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
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</tbody>
</table>

#### 2.c.i

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

<table>
<thead>
<tr>
<th>No</th>
<th>Please Explain</th>
</tr>
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<tbody>
<tr>
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<td></td>
</tr>
</tbody>
</table>

#### 2.c.ii

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

<table>
<thead>
<tr>
<th>Yes</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>The international application must enter the national phase in Poland and the information about the national phase entry must be published by the Bulletin of the Polish Patent Office.</td>
</tr>
</tbody>
</table>

#### 2.c.iii

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

<table>
<thead>
<tr>
<th>No</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>It depends on the date of publication of the information about the national phase entry by the Bulletin of the Polish Patent Office.</td>
</tr>
</tbody>
</table>

### Question 3

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

#### 3.a

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

<table>
<thead>
<tr>
<th>same as Question 1</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td></td>
</tr>
</tbody>
</table>

#### 3.b

Same applicant on the dates of filing, no common inventor:

<table>
<thead>
<tr>
<th>same as Question 1</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td></td>
</tr>
</tbody>
</table>
II. Policy considerations and proposals for improvements of your current law

3.c
Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

3.c.i
Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3.d
Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

3.d.i
Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

3.d.ii
Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain
Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<table>
<thead>
<tr>
<th>4.</th>
<th>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>The definition of when secret prior art is applicable is provided by art. 25.3 of the Industrial Property Law. However, literal interpretation of this article may seem to suggest that it only refers to the applications filed with the Polish Patent Office as direct national applications. Hence, the question whether art. 25.3 applies to the applications filed as PCT national phase applications is not clear. According to the current Polish Patent Office practice, art. 25.3 is interpreted as applying as well to the PCT national phase applications, but the law should be made more explicit in this respect.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>4.b</th>
<th>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>4.c</th>
<th>The treatment of international applications as secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>4.d</th>
<th>The treatment of total and partial identity of applicants as it relates to secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>4.e</th>
<th>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>
### III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.


<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>There are no provisions in the Polish law for avoiding self-collision. Existence of such provisions could constitute an incentive for obtaining patents for incremental inventions by the same applicant which would be welcome by many applicants. It seems that the anti self-collision provisions in the case where the applicants of both applications are the same should be introduced. However, additional restriction requiring common ownership and terminal disclaimer should be foreseen in order to avoid existence of multiple patents for the same invention belonging to different parties.</td>
</tr>
</tbody>
</table>

### 4. Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

<table>
<thead>
<tr>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
<tr>
<td>Such limitation is provided by art. 25.3 of the Industrial Property Law stipulating that: “25.3. The content of any patent applications or utility model applications which enjoy the earlier priority, not made available to the public, shall also be considered as comprised in the state of the art, provided that they were published in the manner as specified in this Law.”</td>
</tr>
</tbody>
</table>

This provision should be amended so as to exclude the situation when the conflicting applications are filed by the same applicant, i.e. to introduce the anti self-collision provisions as outlined in item f) above.

### 5. Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

<table>
<thead>
<tr>
<th>No</th>
</tr>
</thead>
<tbody>
<tr>
<td>Please Explain</td>
</tr>
</tbody>
</table>

- 

### III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

### 6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

**If YES, please respond to the following questions without regard to your Group’s current law or practice.**

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

<table>
<thead>
<tr>
<th>Yes</th>
</tr>
</thead>
<tbody>
<tr>
<td>If YES, please respond to the following questions without regard to your Group</td>
</tr>
</tbody>
</table>

- 

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386
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</td>
<td>Yes</td>
</tr>
<tr>
<td>Please Explain</td>
<td></td>
</tr>
<tr>
<td>If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</td>
<td>Entire contents. Availability of only a part such as the claims could lead to the situations of potential double patenting e.g. when the claims of the earlier application (SPA) would be eventually amended basing on the description and granted.</td>
</tr>
<tr>
<td>If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</td>
<td>Yes, the standard applied to publicly available prior art.</td>
</tr>
<tr>
<td>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
</tr>
<tr>
<td>Please Explain</td>
<td>The secret prior art should not be available against the claims of the later-filed application to show lack of inventive step / obviousness.</td>
</tr>
<tr>
<td>If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</td>
<td></td>
</tr>
</tbody>
</table>
If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

This does not change any of our answers to questions 1(a) and 1(b) above.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

If the international application does not enter the national phase Poland, there is no risk of double patenting (granting two Polish patents for the same invention).

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

It depends on the date of publication of the information about the national phase entry by the Bulletin of the Polish Patent Office.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain
The secret prior art should not be available against the claims of the later-filed application for novelty-defeating purposes in order to avoid self-collision.

8.a.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

8.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

8.a.iii If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art should not be available against the claims of the later-filed application to show lack of inventive step / obviousness.

8.b.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?
If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Yes

Please Explain

The restrictions of common ownership and terminal disclaimer should be foreseen. The restriction of common ownership seems reasonable because the anti-self collision is by definition meant as an incentive for the same applicant for obtaining patents for incremental inventions. On the other hand the terminal disclaimer is necessary in order to avoid a possible abuse of the system by prolonging protection over 20 years by filing the same invention again at a later date (before publication of the earlier application).

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

Yes

Please Explain

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

If the international application does not enter the national phase in Poland, there is no risk of double patenting (granting two Polish patents for the same invention).

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain
It depends on the date of publication of the information about the national phase entry by the Bulletin of the Polish Patent Office.

9. Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9. a. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 8

Please Explain

9. b. Same applicant on the dates of filing, no common inventor:

same as Question 8

Please Explain

9. c. Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9. c. i. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9. d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain
Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 8

Please Explain

Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

We have no comments on any additional issues concerning conflicting applications we consider relevant to this Study Question.

Please indicate which industry sector views are included in your Group’s answers to Part III.

Industrial machinery.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Art. 56 (2) of the Industrial Property Code (CPI) provides that the content of patent and utility model applications filed before the date of filing
of a patent application, for taking effect in Portugal and not yet published, are also part of prior art. The term “not yet published” is considered as indicating that the secret prior art has to be published, in practice.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

i. The referred legal provision (Art. 56 (2) CPI) explicitly states that it is the contents of the secret prior art that is made available, thus perceived in practice as the “entire contents of the secret prior art”. Under Art. 62 (6) (b) CPI, the abstract has the single purpose of “technical information”, being “not taken into consideration for any other purpose”, hence also being understood in practice as excluded for the present case.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

i. It is the same standard as applied to the publicly available prior art, as there is no restriction in Art. 56 (2) CPI with regard to novelty. In fact, the Portuguese Institute of Industrial Property (INPI) applies the standard of the EPO, thus not restricting the secret prior art with regard to novelty.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes

Please Explain

a. As referred, the practice of the INPI follows the practice of the EPO, thus the legal provision of Art. 56 EPC, excluding secret prior art from evaluation of inventive step. However, no such restriction exists in the CPI, for there may be legal basis for making these documents available. No relevant case law is known.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

NA

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? **

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

NA

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

NA
<table>
<thead>
<tr>
<th>Q1</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
<tbody>
<tr>
<td>Q1.c</td>
<td>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>The provision of Art. 56 (2) CPI does not provide restrictions on the type of application, further stating that it is applicable to any patent or utility model application “for taking effect” in Portugal, thus also PCT applications.</td>
<td></td>
</tr>
<tr>
<td>Q1.c.i</td>
<td>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>In practice, the “for taking effect” provision is considered as a PCT application merely designating or electing Portugal, with no requirement of actually entering the Portuguese or European national/regional phase.</td>
<td></td>
</tr>
<tr>
<td>Q1.c.ii</td>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>In practice, the “for taking effect” provision is considered as a PCT application merely designating or electing Portugal, with no requirement of actually entering the Portuguese or European national/regional phase.</td>
<td></td>
</tr>
<tr>
<td>Q1.c.iii</td>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

**For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.**

| Q2 | Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes? |
| Yes | Please Explain |
| as there is no restriction on the applicant/inventors with regard to novelty analysis. |
| Q2.a.i | If YES, are the entire contents of the secret prior art available, or only a portion such as the claims? |
| as for 1.a.i. |
If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

as for 1. a) i.

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

i. No, there is no such period. However, secret prior art should only be cited during examination, thus after 18 months from the date of filing or priority of the later filed application.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

what was referred for 1. b) is also applicable for the present case.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Yes, as for 1. b) i

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

i. Yes, as for 1. b) ii.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

i. Yes, as for 1. b) iii.

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
i. No, as for 2. a) iii.

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

i. No anti-self collision is applied. A mere comment: a double patenting provision exists for the case where a European patent is validated in Portugal while a Portuguese patent or patent application (also applicable for utility models) is pending / in force, where the date of filing or priority of the two applications is the same and the inventor is the same. However, such is not a case of possible self-collision / secret prior art.

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

i. The actions of ii. should be fulfilled within the time limit for entering in the respective jurisdiction.

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group's current law be improved? If YES, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
   
same as Question 1
   
Please Explain

3.b Same applicant on the dates of filing, no common inventor:
   
same as Question 1
   
Please Explain

3.c Different applicants on the dates of filing, same inventors:
   
same as Question 1
   
Please Explain

3.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?
   
No
   
Please Explain

3.c.ii Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
   
No
   
Please Explain

3.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
   
same as Question 1
   
Please Explain

3.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
   
No
   
Please Explain

3.d.ii Would the answers change if the different applicants were part of a joint industry or industry-university research project?
   
No
   
Please Explain
4.a The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

Yes

Please Explain

by amending Art. 56 (2) CPI so that that publication of a prior application is explicitly required so that such application is secret prior art. An Industry sector view different to that of the undersigned was obtained, in particular with regard to the portion of the secret prior art which should be available as prior art, considering that only the claims of the secret prior should be taken into consideration.

4.b The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

4.c The treatment of international applications as secret prior art.

Yes

Please Explain

by amending Art. 56 CPI so that secret prior art is excluded from the analysis of inventive step, aligning with the current practice, only being taken into consideration for novelty. Inclusion of such amendment could be simple, by following Art. 56 EPC, 2nd paragraph.

4.d The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

In the case of total identify of applicants, the additional possibility of claiming priority in the subsequent application – even though only for the priority year –, as well as priority and entitlement provisions in case of partial identity, also provide additional safety nets.

4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

4.f Provisions for avoiding self-collision.

No

Please Explain

We find that the referred novelty standard would be enough.

4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.


III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

5. Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

Yes

Please Explain

1. There is no explicit legal provision that – in the way of Art. 89 EPC – changes the date of priority to the date of filing for the purposes of Art. 56 (2) CPI, thereby providing that a claim of priority has effect on secret prior art. We find it would be quite relevant that the legal provision relating to priority (Art. 12 CPI) would make such effect explicit.

Furthermore, the inclusion of another explicit provision that priority may be claimed from a Portuguese patent application – which is currently prohibited by the INPI although no legal provision supports such practice – would also help in reducing the number of secret prior art applications in the case of same applicants, as a subsequent application could claim priority from a prior application.

III. Proposals for harmonisation

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

as it addresses the issue of double patenting.

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
since an application may be amended during prosecution, and subject matter which was only in the description as filed introduced into the claims. The abstract should be excluded.

7.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

to provide higher certainty in the analysis of such cases.

7.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

as it would be a too high hurdle (even if enlarged novelty), considering it is secret prior art. The novelty standard already addresses double patenting.

7.b.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

NA

7.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

NA

7.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

NA

7.c If the secret prior art is an international application filed designating your jurisdiction:

7.c Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

We find that the optimal solution would be the entry of the application into the national phase. However, since a diverse number of requirements exist throughout the several jurisdictions, a minimum number of requirements should be defined including, at least, a translation into a prescribed language(s) (not needed if the PCT is already in such language), in order for the content of the secret prior art to be perceivable, and the payment of a fee, to clearly mark the secret prior art effect into such jurisdiction.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

The actions of ii. should be fulfilled within the time limit for entering in the respective jurisdiction.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

As referred for 7. a). We find that the ability to claim priority already provides a safety net for further elaborations of a main inventive concept (at least during the priority year). Furthermore, entitlement provisions provide an ability to recover a first application where a first application is not filed by the several entitled entities.

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

As for 7. a) i.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

As for 7. a) ii.
<table>
<thead>
<tr>
<th>8.a.iii</th>
<th>If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>NO</strong></td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8.b</th>
<th>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>No</strong></td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>same considerations as for 7. b).</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8.b.i</th>
<th>If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</th>
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<table>
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<tr>
<th>8.b.ii</th>
<th>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</th>
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<table>
<thead>
<tr>
<th>8.b.iii</th>
<th>If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
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</table>

<table>
<thead>
<tr>
<th>8.b.iv</th>
<th>If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
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<tbody>
<tr>
<td><strong>NA</strong></td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8.b.v</th>
<th>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>8.c</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
</table>

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### Question 8.

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

**No**

**Please Explain**

### Question 8.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

**Yes**

**Please Explain**

same as for 7. c) ii. Furthermore, being the same applicant, there is the ability to decide if a certain application should enter a respective national phase or fulfill the minimum requirements.

### Question 8.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

**Yes**

**Please Explain**

same as for 7. c) iii.

---

### Question 9.

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:  

**same as Question 7**

**Please Explain**

9.b Same applicant on the dates of filing, no common inventor:  

**same as Question 7**

**Please Explain**

9.c Different applicants on the dates of filing, same inventors:  

**same as Question 7**

**Please Explain**
Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

as we find there should be no difference in the case of different inventors.

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

NO

Please indicate which industry sector views are included in your Group’s answers to Part III.
1. Pharmaceutical and Automation industries.
Study Question

Submission date: April 29, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

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For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
1.a. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available.

1.a. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

It is the same as the standard applied to publicly available prior art.

1.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

1.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

1.b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * 
* The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

1.b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

1.c. If the secret prior art is an international application filed designating your jurisdiction:

1.c. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

Please Explain

If the international application does not enter the national phase in Korea, it cannot be available against the claims of the later-filed application for novelty-defeating purposes.

1.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain
Only when the international application actually enters the national phase in Korea, it can be available against the claims of the later-filed application for novelty-defeating purposes.

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?</td>
<td>No</td>
<td></td>
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<td>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td></td>
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</tr>
<tr>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
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<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
<td></td>
<td></td>
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</tbody>
</table>
2.b.iv If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain

3.b Same applicant on the dates of filing, no common inventor:

same as Question 2

Please Explain
<table>
<thead>
<tr>
<th>3.c</th>
<th>Different applicants on the dates of filing, same inventors:</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>same as Question 2</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>3.c</td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>3.c</td>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
</tr>
<tr>
<td></td>
<td>same as Question 1</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>3.d</td>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
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</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

**II. Policy considerations and proposals for improvements of your current law**

<table>
<thead>
<tr>
<th>4</th>
<th>Could any of the following aspects of your Group’s current law be improved? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>4.a</td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
</tr>
<tr>
<td>4.b</td>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
</tr>
<tr>
<td>4.c</td>
<td>The treatment of international applications as secret prior art.</td>
</tr>
<tr>
<td>4.d</td>
<td>The treatment of total and partial identity of applicants as it relates to secret prior art.</td>
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</table>
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

4.f Provisions for avoiding self-collision.

4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain

III. Proposals for harmonisation

6 Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

No

Even if NO, please address the following questions to the extent your Group considers your Group

7 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire contents of the secret prior art should be available.
7.a If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

It should be the same as the standard applied to publicly available prior art.

7.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

7.c If the secret prior art is an international application filed designating your jurisdiction:

7.c.i Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

Yes

Please Explain

If the international application does not enter the national phase in Korea, it should not be available against the claims of the later-filed application for novelty-defeating purposes.

7.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Only when the international application actually enters the national phase in Korea, it should be available against the claims of the later-filed application for novelty-defeating purposes.
c. **Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

No

Please Explain

---

8. **For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.**

---

8. **Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

No

Please Explain

---

8.a. **If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?**

---

8.a. **If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?**

---

8.a. **If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?**

---

8.b. **Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

No

Please Explain

---

8.b. **If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

---

8.b. **If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?**

---

8.b. **If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?**
If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 8

Same applicant on the dates of filing, no common inventor: same as Question 8
9.c. Different applicants on the dates of filing, same inventors:

same as Question 8

Please Explain

9.c. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

9.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

Nothing.
Please indicate which industry sector views are included in your Group’s answers to Part III.

Metallurgy, electronic components, telecommunication, biology and pharmaceutical industries.
Study Question

Submission date: April 26, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Russian Federation
Contributors name(s): Aleksey Zalesov
E-Mail contact: ozolina@azalesov.com

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

418
Yes, it is. The secret prior art is available against the claims of the later-filed application for novelty-defeating purposes only (Civil Code, Article 1350 part 2 para 3).

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content of the secret prior art is available for novelty judgement.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for novelty evaluation based on secret prior art is the same as for the publicly available prior art.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

The answer is Yes, it does change the above to certain extent.
### 1. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

**Yes**

**Please Explain**

Yes, it does matter. Only international application which actually has been entered into the Russian national phase is to be taken into account for the above mentioned estimations.

### 2. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

**No**

**Please Explain**

No, it does not. The date from which the international application is available as secret prior art does not depend on the date of actual national phase entry since the filing date (or priority date if PCT application claims earlier e.g. conventional priority) is the date which gives the ground for novelty rejection on post filed application. But as it is mentioned above the international application should be entered into Russian national phase and only after that it can be considered as secret prior art. Since international application is to be

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### 2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

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### 3. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

**No**

**Please Explain**

No, it is not available. In this case such secret prior art cannot be cited against the later-filed application for novelty-defeating purposes. Only patents of the same inventors/applicants having earlier priority can be cited against

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### 4. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

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### 5. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

---

### 6. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

---

### 7. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?
No

Please Explain

No, it is not available. In this case such secret prior art cannot be cited against the later-filed application to show lack of inventive step / obviousness.

2.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

2.b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

2.b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

2.b. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

Yes

Please Explain

The direct prohibition on double patenting is provided in the Russian Civil Code by the means that rejection on novelty can be based on any patented object (invention, utility model or design) having earlier priority (Civil Code, Article 1350 part 2 para 4) irrespective who is owner of such patent with earlier priority. So patented object (i.e. object described in the claims of a granted patent and construed using patent specification and general knowledge) irrespective who is the patent owner can be used to rejected later patent application.

2.c. If the secret prior art is an international application filed designating your jurisdiction:

2.c. Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

The rationale on inventive step is the same.

2.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes
Yes, it does matter. Only the international application which actually enters the Russian national phase is to be taken into account for the above mentioned estimations. But as it is mentioned above the Russian law does not provide possibility to reject on inventive step based on secret prior art which includes such international application.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

As it is mentioned above the Russian law does not provide possibility to reject on inventive step based on secret prior art which includes such international application.

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 2

Same applicant on the dates of filing, no common inventor:
same as Question 2

Different applicants on the dates of filing, same inventors:
same as Question 1

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1
AIPPI 2018 - Study Question - Conflicting patent applications

Please Explain

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

II. Policy considerations and proposals for improvements of your current law

Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

No, it is reflected correctly.

The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

No, it is reflected correctly.

The treatment of international applications as secret prior art.

No

Please Explain

No, it is reflected correctly.

The treatment of total and partial identity of applicants as it relates to secret prior art.

Yes
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

Yes

Please Explain

Yes, it can be amended by including definition of the different cases of interconnected applicants.

4.f Provisions for avoiding self-collision.

No

Please Explain

No, it is reflected correctly.

4.g Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

Yes

Please Explain

Yes, it can be amended.

5 Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6 Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes
### AIPPI 2018 - Study Question - Conflicting patent applications

If YES, please respond to the following questions without regard to your Group

<table>
<thead>
<tr>
<th>Question</th>
<th>Response</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>7.</strong> For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.</td>
<td></td>
</tr>
<tr>
<td><strong>7a.</strong> Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</td>
<td>Yes</td>
</tr>
<tr>
<td><strong>7a.i</strong> If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</td>
<td>The entire content of prior art should be available for novelty-defeating purposes.</td>
</tr>
<tr>
<td><strong>7a.ii</strong> If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</td>
<td>It should be standard novelty criterion.</td>
</tr>
<tr>
<td><strong>7b.</strong> Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
</tr>
<tr>
<td><strong>7b.i</strong> If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
</tr>
<tr>
<td><strong>7b.ii</strong> If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</td>
<td></td>
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<tr>
<td><strong>7b.iii</strong> If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</td>
<td></td>
</tr>
<tr>
<td><strong>7c.</strong> If the secret prior art is an international application filed designating your jurisdiction:</td>
<td></td>
</tr>
<tr>
<td><strong>7c.</strong> Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.</td>
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<td>Question</td>
<td>Answer</td>
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<tr>
<td>7.c.ii</td>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
</tr>
<tr>
<td>7.c.iii</td>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
</tr>
<tr>
<td>8</td>
<td>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</td>
</tr>
<tr>
<td>8.a</td>
<td>Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</td>
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<td>If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</td>
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<td>8.a.ii</td>
<td>If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</td>
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<td>8.a.iii</td>
<td>If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
</tr>
<tr>
<td>8.b</td>
<td>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
</tr>
<tr>
<td>8.b.i</td>
<td>If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</td>
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</tbody>
</table>
### AIPPI 2018 - Study Question - Conflicting patent applications

**8.b.ii** If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

**8.b.iii** If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

**8.b.iv** If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

**8.b.v** If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

**8.c** If the secret prior art is an international application filed designating your jurisdiction:

**8.c.i** Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

**8.c.ii** Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

**8.c.iii** Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

**9** Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

**9.a** Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 8
<table>
<thead>
<tr>
<th>Question</th>
<th>Description</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>9.b</td>
<td>Same applicant on the dates of filing, no common inventor:</td>
<td>same as Question 8</td>
<td>Please Explain</td>
</tr>
<tr>
<td>9.c</td>
<td>Different applicants on the dates of filing, same inventors:</td>
<td>same as Question 7</td>
<td>Please Explain</td>
</tr>
<tr>
<td>9.c.i</td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>9.c.ii</td>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>9.d</td>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
<td>Please Explain</td>
</tr>
<tr>
<td>9.d.i</td>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>9.d.ii</td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>9.e</td>
<td>Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:</td>
<td>same as Question 7</td>
<td>Please Explain</td>
</tr>
<tr>
<td>9.f</td>
<td>Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:</td>
<td>same as Question 7</td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.</td>
<td></td>
<td></td>
</tr>
<tr>
<td>---</td>
<td>---------------------------------------------------------------------------------------------------------------</td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td>Please indicate which industry sector views are included in your Group’s answers to Part III.</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Pharmaceuticals, Oil&Gaz, Railway Construction
Study Question

Submission date: May 30, 2018

Sarah MATHERSON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Singapore
Contributors name(s): Winnie Tham, Gerald Koh, Soh Kar Liang, Patsy Koh, Kevin Theseira
e-Mail contact: winnie.tham@amicalaw.com

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Yes, under div 14(3) of the Singapore Patents Act (“the Act”). The text of the provision is as follows:

14(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied:

(a) that matter was contained in the application for that other patent both as filed and as published; and
(b) the priority date of that matter is earlier than that of the invention.

1.a.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

On a plain reading of the Act, which provides that “… state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application…”, the entire contents of the secret prior art are available. There is no Singapore judicial decision to date which suggests otherwise.

1.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Yes, the same standard is applied.

1.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

This is provided under Section 15 of the Act.

15. An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of div 14(2) and without having regard to div 14(3).

1.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

1.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *

* * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

1.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

1.c If the secret prior art is an international application filed designating your jurisdiction:

1.c.i Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

431
No

Please Explain

No it does not. Under div 85(1) of the Act, an international application for a patent designating Singapore for which a date of filing has been accorded under the Patent Co-operation Treaty shall, subject to certain regulations concerning proper entry into the Singapore national phase, be treated as an application for a patent under the Act.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Yes, see above for 1(c)(i)

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Subject to the possible effect of revised grace period exceptions which commenced on 31 October 2017. Among other things, self-disclosure by the inventor or by a person who obtained the matter directly or indirectly from the inventor (which could conceivably encompass the publication of the secret prior art) shall be disregarded if occurring later than the beginning of the period of 12 months immediately preceding the date of filing the application for the patent.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Same answer as for Qn 1(a)(i)

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?
### AIPPI 2018 - Study Question - Conflicting patent applications

**Same answer as for Qn 1(a)(ii)**

<table>
<thead>
<tr>
<th>a.</th>
<th>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>There is no general anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes. However, the grace period exceptions referred to at Ans 2(a) above would be noteworthy.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>b.</th>
<th>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>b.</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
</table>

<table>
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<tr>
<th>b.</th>
<th>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</th>
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</thead>
</table>

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<tr>
<th>b.</th>
<th>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
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</thead>
</table>

<table>
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<th>If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
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</thead>
</table>

<table>
<thead>
<tr>
<th>b.</th>
<th>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Not applicable</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>c.</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>c.</th>
<th>Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
</tbody>
</table>
2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No, it is governed by the date of publication.

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1

Please Explain

3.b Same applicant on the dates of filing, no common inventor:
same as Question 1

Please Explain

3.c Different applicants on the dates of filing, same inventors:
same as Question 1

Please Explain

3.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3.c.ii Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1
II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

4.b. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

4.c. The treatment of international applications as secret prior art.

No

Please Explain

4.d. The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

4.e. The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

   If YES, please respond to the following questions without regard to your Group’s current law or practice.

   Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

   If YES, please respond to the following questions without regard to your Group

Harmonisation is desirable to avoid self collision where the identity of Applicants may be the the same.

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.
### Question 7.a
**Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

**Yes**

**Please Explain**

It should be available where the Applicants/inventors are unrelated to avoid conflicts in the marketplace.

### Question 7.a.i
**If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

Should be the entire contents

### Question 7.a.ii
**If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?**

Should be the same standard as applied to other publicly available prior art to avoid complication

### Question 7.b
**Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

**No**

**Please Explain**

Since the prior art is not available and secret, its effect should be limited to novelty.

### Question 7.b.i
**If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?**

### Question 7.b.ii
**If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?**

### Question 7.b.iii
**If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?**

### Question 7.c
**If the secret prior art is an international application filed designating your jurisdiction:**

### Question 7.c.i
**Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.**

**No**
<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>7.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td>Yes</td>
<td>Yes it should enter national phase in order to qualify as an application filed under the jurisdiction.</td>
</tr>
<tr>
<td>7.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</td>
<td></td>
<td></td>
</tr>
<tr>
<td>8.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>8.a.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>8.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>8.a.iii If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>8.b.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

8.b.iv If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)? No

Please Explain

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

8.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

8.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.
### 9.a
**Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

Same as Question 8

**Please Explain**

### 9.b
**Same applicant on the dates of filing, no common inventor:**

Same as Question 8

**Please Explain**

### 9.c
**Different applicants on the dates of filing, same inventors:**

Same as Question 7

**Please Explain**

### 9.c.i
**Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

**Please Explain**

**Yes, in that case our answers to Q 8 would apply.**

### 9.d
**Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

Same as Question 7

**Please Explain**

### 9.d.i
**Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?**

Yes

**Please Explain**

### 9.e
**Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:**

Same as Question 8

**Please Explain**

**Yes, in that case our answers to Q 8 would apply.**
Yes if there is common ownership then the scenario in Q8 would apply.

<table>
<thead>
<tr>
<th>Question</th>
<th>Scenario Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>9f</td>
<td>Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:</td>
</tr>
<tr>
<td></td>
<td>same as Question 7</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
</tbody>
</table>

Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

Please indicate which industry sector views are included in your Group’s answers to Part III.

Industry sector views were sought but no express views are included in the above answers. Our observation is that where the Applicant is the same, it would be useful to have provisions to avoid self-collision.
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Article 6.3 of the currently in-force Patent Law 24/2015 of 24 July (“PL”) provides as follow:
“The content of Spanish patent or utility model applications, European patent applications designating Spain, and PCT international patent applications that have entered the national phase in Spain, as they were originally filed, the filing date of which is prior to the date referred to in the preceding paragraph and which were published in Spanish on or after that date, shall also be considered as comprised in the state of the art.”

The aforementioned Article 6.3 PL is similar mutatis mutandis to Article 54.3 of the European Patent Convention (EPC).

“Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.”

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content. In fact, Article 6.3 PL reproduced above provides that the content of Spanish patent or utility model applications, etc., will form part of the secret prior art. “The content” must be understood as the entire content, and not just a part of it. In other words, the same approach, i.e., the “whole content” or “entire content approach”, applies in Spain as in the European Patent Office (EPO). For this reason, Article 6.3 PL uses the same wording as Article 54.3 EPC.

The Guidelines for Examination of EPO dictate along the same line, indicating the inclusion of the entire content in accordance with Part G - Patentability, Chapter IV - State of the Art, Section 5.1 which states verbatim: “By the "content" of a European application is meant the whole disclosure, i.e., the description, drawings, and claims.”

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

There is no difference whatsoever in terms of the criteria for evaluation of novelty between secret prior art and publicly available prior art in the Spanish legislation and in the EPC.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Article 8.2 PL provides as follow:
“Where the state of the art includes documents such as those mentioned in Article 6.3, they shall not be taken into consideration when deciding upon the existence of the inventive step.”

Article 8.2 PL reproduces Article 56 EPC, paragraph 2.

“These documents shall not be considered in deciding whether there has been an inventive step.”

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

N/A

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *

*The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.*
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

N/A

If the secret prior art is an international application filed designating your jurisdiction:

1.c.i Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

Article 6.3 PL reproduced above expressly includes international applications as part of the secret prior art, provided that they have entered the Spanish national phase and have been published in Spanish. In Europe, the EPC recognizes international applications in Article 153.5, also provided that they have entered the European regional phase and have been published in an official language of the EPO (Article 153.3 and 153.4).

1.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

As set forth in div 1.a), Article 6.3 of the currently in-force patent law literally provides that a PCT international application designating Spain shall only be considered as comprised in the state of the art if it actually enters the national phase in Spain (and has been published in Spanish).

In Europe, Article 153.5 established that “the Euro-PCT application shall be treated as a European patent application and shall be considered as comprised in the state of the art under Article 54, paragraph 3.”

1.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

The relevant date is the PCT application date (or the priority date), not the date of national phase entry in Spain. Same situation in the EPC.
### 2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

#### 2.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

- **Yes**

  Please Explain

  See div 1 a) above.

#### 2.a.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

- **Yes.** See div 1 a) i) above

#### 2.a.ii. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

- **Yes.** See div 1 a) ii) above

#### 2.a.iii. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

- **No.** There is no such time period.

#### 2.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

- **No**

  Please Explain

  See div 1 b) above.

#### 2.b.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

- **N/A**

#### 2.b.ii. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

- **N/A**
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

N/A

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

N/A

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

See div 1 c) ii) above.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain
The relevant date is the PCT filing date (or priority date), not the date of national phase entry in Spain.

3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1
Please Explain

3.b Same applicant on the dates of filing, no common inventor:
same as Question 1
Please Explain

3.c Different applicants on the dates of filing, same inventors:
same as Question 1
Please Explain

3.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?
No
Please Explain
NO, the answers would be the same as in divs 1 and 2

3.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 1
Please Explain

3.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
No
Please Explain
NO, the answers would be the same as in divs 1 and 2.
The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

Yes

Please Explain

Spanish legislation (PL):

Article 6.3 PL introduces the secret prior art, in the context of the novelty requirement:

“The content of Spanish patent or utility model applications, European patent applications designating Spain, and PCT international patent applications that have entered the national phase in Spain, as they were originally filed, the filing date of which is prior to the date referred to in the preceding paragraph and which were published in Spanish on or after that date, shall also be considered as comprised in the state of the art.”

- Following the most plausible interpretation of the wording of Article 6.3 PL with respect to national applications, PCT applications, and European patent applications, it is understood that they must have been published in Spanish. Although it is evident that a double patenting situation will not occur if these applications are not ultimately granted (and validated in the case of a European patent application), it is understood that this condition is not required for the contents of the applications to be considered part of secret prior art (as regards the novelty requirement). There is consensus that the current definition provides greater legal certainty to users because: [a] the determination of what constitutes and does not constitute the state of the art takes place earlier, and [b] it is not reversible (granted patent can always be revoked).

- In accordance with the referred interpretation the following issues must be discussed with respect to the condition that the earlier applications must be published in Spanish:
  i) The availability of a text published in Spanish does not necessarily contribute to making the eventual novelty examination easier since, according to Article 6.3 PL, it is the text of the earlier applications “as they were originally filed”, and not the published text, that will form part of the state of the art Therefore, the Spanish publication of a European patent application or a PCT application filed in a language other than Spanish will not overcome the need to analyze the text as filed to evaluate the impact of these earlier applications.
  ii) The current definition of Article 6.3 PL, and particularly the interpretation previously referred, may lead to European Patents validated in Spain (for which a secret prior art may be taken into consideration independent of its language of publication, be it English, German, or French) being treated differently from Spanish patents that are not derived from a European patent (for which the same secret prior art may only be contemplated if there is a text published in Spanish).

On the other hand, even in the case of a European patent application Article 6.3 PL may provide that said application “must have been published in Spanish”. This, however, may not be the case as a European patent application would not be published in Spanish as such. Only the text of the claims in the event of a provisional protection, or the granted text, may be published in Spanish. If the expression “published in Spanish” of current Article 6.3 PL refers to the “T3” publication of a validation in Spain (because only in this case will the earlier application take definitive effects in Spain and give rise to a double patenting situation), this would be a condition that is imposed on a secret prior art that originates from a European patent application, but not imposed on a PCT entering the national phase (which may become a secret prior art for a subsequent European patent application [which after its grant ends up being validated in Spain] merely due to publication of the application regardless of whether or not it is ultimately granted).

For all this, Article 6.3 PL should be interpreted in the sense that the condition of the publication in the Spanish language only applies to PCT international applications (Spanish patents and utility models applications are always published in Spanish), and that European patents applications designating Spain belong to the prior art if they are published in any of the official languages of the EPC. However PCT international applications, should be necessarily published in Spanish when they initiate the Spanish national phase. Therefore it is proposed to study the removal from Article 6.3 PL of the condition referring to publication of the earlier patent application in the Spanish language as a requirement for the content of this earlier patent application to be considered as forming part of the state of the art, as a secret prior art, as it does seems to be a condition which has to be expressly set and because the current wording can be interpreted in a way leading to discrimination.

EPC:
There is no aspect of the current Article 54(3) EPC that has been identified as requiring amendment in order to improve the definition of a secret prior art.

4.b  The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

Yes

Please Explain

Yes, the provisions of the Spanish legislation and those of the EPC are susceptible to improvement. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

4.c  The treatment of international applications as secret prior art.

No

Please Explain

There is no aspect of the current Article 6.3 PL and Article 54(3) EPC that has been identified as requiring amendment in order to improve the treatment of PCT applications. See answer in div a).

4.d  The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

It is not considered an aspect susceptible to improvement in the Spanish legislation or in the EPC. By default, neither one makes any distinction between secret prior art according to whether or not they have inventors/applicants in common with the later application.

4.e  The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

There is no aspect of the current Article 54(3) EPC that has been identified as requiring amendment in order to improve the definition of a secret prior art.
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

4) Provisions for avoiding self-collision.

No

Please Explain

It is not considered an aspect susceptible to improvement in the Spanish legislation or in the EPC. There are currently no such provisions in either, and it is considered that it must remain so.

4) Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

It is not considered an aspect susceptible to improvement in the Spanish legislation or in the EPC.

5) Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain

Reducing the term for patent application publication (18 months from the priority date) would shorten the window of time in which this type of secret prior art is generated. Notwithstanding the foregoing, most members of the work group would prefer to not reduce the term for publication so as to not forego other advantages associated with this deferred publication. It must be highlighted among other aspects that, as regards the impact of a first patent application on other applications that may follow, the applicant of this first application can always choose to disclose the content of the application or to request for an earlier publication of the application, such that it would take place before the 18 months. This disclosed content will belong, for all intents and purposes, to the state of the art of the later application.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6) Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes
If YES, please respond to the following questions without regard to your Group

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

The entire content for both Spanish and European patent applications. (Remark: Hereinafter the expression “for both Spanish and European patent applications” shall be abbreviated as “ES/EP”)

7a.ii. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

We believe that applying a strict novelty criterion may give rise to double patenting situations de facto even when the claims of the later patent are considered novel. In this sense, the addition of a technical element that does not contribute to the inventive step in a later patent may be sufficient for said later patent to meet the novelty requirement. This allows the creation of patent thickets, for example.

For this reason and taking inspiration from the Japanese system, we propose replacing the strict novelty criterion with the enlarged novelty criterion.

In this sense, the invention defined by the wording of the claims of the later application must not be obvious in view of a combination of the content of the earlier application (secret prior art) and of the common general knowledge.

There are guidelines and case-law available today to help sufficiently narrow down in each case this common general knowledge so as to apply the enlarged novelty criterion in a reasonably objective manner.

This would apply both to the EPC and to the PL.

7b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain


7b.1. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

7b.2. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?


7.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c If the secret prior art is an international application filed designating your jurisdiction:

7.c.i Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

7.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

In Spain, if the secret prior art is an international application, for said state of the art to be taken into account the international application must have already entered the Spanish national phase and must have been published in Spanish. Equivalent situation for EP.

7.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

It depends on whether or not the international application enters the Spanish national phase and whether or not a translation is submitted. However, once it has entered the national phase and published in Spanish, the relevant date for the purpose of determining whether or not it constitutes a secret prior art in Spain is the international application filing date (or priority date). The same applies for EP.

8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?
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The entire content ES/EP

\[8.a.ii\] If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Enlarged novelty (see div 7 a ii)) – ES/EP

\[8.a.ii\] If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

No - ES/EP

\[8.b.ii\] Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

ES/EP (see div 7 a ii))

\[8.b.i\] If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

\[8.b.ii\] If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

\[8.b.iii\] If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

\[8.b.iv\] If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No - ES/EP

\[8.b.v\] If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

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If the secret prior art is an international application filed designating your jurisdiction:

8.c. Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

No - ES/EP

8.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

In Spain, if the secret prior art is an international application, for said state of the art to be taken into account the international application must have already entered the Spanish national phase and have been published in Spanish.

Equivalent situation for EP.

8.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Yes

Please Explain

Once the international application has entered the national phase and published in Spanish, the relevant date for the purpose of determining whether or not it constitutes a secret prior art in Spain is the international application filing date (or priority date).

Same situation for EP.

9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.b Same applicant on the dates of filing, no common inventor:
9.c Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9.c Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

ES/EP

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

ES/EP

9.d Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

ES/EP

9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain
Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

Same as Question 7

Please Explain

Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

We propose a study to amend the wording of Article 6.3 PL (Spain) to avoid the interpretation of the existence of the condition referring to publication of the earlier patent application in the Spanish language as a requirement for the content of this earlier patent application to be considered as forming part of the state of the art, as a secret prior art (see div 4a).

Please indicate which industry sector views are included in your Group’s answers to Part III.

Pharmaceutical industry.
Study Question

Submission date: April 27, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
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Conflicting patent applications

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For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Swedish Patent Law does not distinguish secret prior art based on the identity of the applicant(s) or the inventor(s).

Some initial general remarks

Initially, the Swedish group wishes to provide some general remarks of relevance to our answers provided below.

The European Patent Convention ("EPC") and the development within the European Patent Office (EPO) have been given particular weight by the Swedish Supreme Administrative Court and the Swedish Supreme Court. Sweden became a party to the EPC in 1978 and the Swedish Patents Act is highly harmonized with the PCT and the EPC. Also, practice in Sweden develops in conformity with the EPC as interpreted by the European Patent Office. Furthermore in this regard, patents valid in Sweden may either have been granted by the Swedish Patent and Registration Office (PRV) or by the EPO.

Naturally, Swedish patent law is based on international agreements, such as the Paris Convention for the Protection of Industrial Property (Paris Convention), the Patent Cooperation Treaty (PCT), the European Patent Convention (EPC), the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), and the Patent Law Treaty (PLT).

The answers to questions 1, 2 and 3 below find legal basis in Sections 2, 29, 38 and 87 of the Swedish Patents Act. Further guidance, particularly with regards to the relevance of an International or European Patent Application validly having entered and designated Sweden to be citable as secret prior art, can be found in the Swedish Guidelines for Examination, (RL); Part C1: 4.1 to 4.2.4. These Guidelines however are not legally binding and only serve as guidance to Office Examiners.

Section 2, 1st paragraph of the Patents Act states that patents shall only be granted for an invention that is new in relation to what was known before the filing date[1] of the patent application and which also differs essentially therefrom. Section 2, 2nd paragraph states that the contents of an earlier patent application filed in Sweden before the said date shall be considered as known if that application becomes available to the public in accordance with div 22 of the Patents Act. The condition that the invention must differ essentially from what was known before the filing date of the patent application does however not apply to Section 2, 2nd paragraph.

From Section 29 it can be derived that Section 2, 2nd paragraph also applies to published international patent applications pursued in Sweden according to Section 31, i.e. completed national phase entry into Sweden.

According to Section 38 of the Swedish Patent Act, Section 2, 2nd paragraph also applies if the PRV shall continue processing of an application after finding that a decision of the receiving Office or International Bureau to refuse to accord an international filing date for an international patent application or to declare that the application shall be deemed to be withdrawn was incorrect.

Section 87 of the Patents Act includes published European patent applications validly designating Sweden in the contents of prior art pursuant to Section 2, 2nd paragraph. A European patent application is considered published (Section 22) if it is published pursuant to Article 93 or Articles 153(3) or 153(4) of the EPC.

[1] Or date of priority if applicable. Everything made available to the public, regardless of whether this has been made in writing, by lectures, by use or otherwise, shall be considered as known (applicable to 1st paragraph).

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Yes, the entire contents of the secret prior art are available (see div 2, 1st paragraph of the Patents Act "content of an earlier patent application").

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is “new in relation to what was known before the filing date of the patent application” (Section 2, 1st paragraph).

The standard for evaluation of novelty is the same for secret and publicly available prior art. Section 2, 1st paragraph, applies to Section 2, 2nd paragraph in this regard.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?
No

Please Explain

The secret prior art is not available to show a lack of inventive step of the later-filed application.

Section 2, 2nd paragraph of the Patents Act specifically states that the criteria “and which also differs essentially therefrom” of Section 2, 1st paragraph does not apply to

Section 2, 2nd paragraph.

b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Not applicable

b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *

The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

Not applicable

b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

Not applicable

c. If the secret prior art is an international application filed designating your jurisdiction:

c. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

No, but the international application must validly have entered national phase in Sweden.

c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain
The provisions of Section 2, 2nd paragraph applies only if the international application has entered Sweden nationally either by (1) direct national entry in Sweden (RL C1:4.2.3), or (2) by regional entry before the European Patent Office, (RL C1:4.2.2).

(1) National entry before the Swedish Patent Office:
For the international application to qualify as secret prior art, a copy or translation of the international application (if not in English or Swedish) must be filed along with the payment of the appropriate official fees (Section 31 of the Patents Act).

(2) Regional entry before the European Patent Office:
For the international application to qualify as secret prior art the European designation fee must be paid and Sweden must be designated (Rule 39(1) EPC; R.159(1) EPC).

In both above mentioned cases, the international application is not citeable as a secret prior art if the designation of Sweden is withdrawn or if the designation fee is not paid in due time.

On a further note, regular European patent applications validly designating Sweden are also citeable as secret prior art.

1. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

3. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Swedish Patent Law does not distinguish secret prior art based on the identity of the applicant(s) or the inventor(s).

4. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art are available.

5. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is “new in relation to what was known before the filing date of the patent application” (Section 2, 1st paragraph).

The standard for evaluation of novelty is the same for secret and publicly available prior art. Section 2, 1st paragraph, applies to Section 2, 2nd paragraph in this regard.
2.a.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No, not applicable. There are no anti-self collision provisions under Swedish patent law.

2.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art is not available to show a lack of inventive step of the later-filed application.

Section 2, 2nd paragraph of the Patents Act specifically states that the criteria “and which also differs essentially therefrom” of Section 2, 1st paragraph does not apply to Section 2, 2nd paragraph.

2.b.i If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Not applicable.

2.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

Not applicable.

2.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

Not applicable.

2.b.iv If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No, not applicable. There are no anti-self collision provisions under Swedish patent law.

2.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain
Not applicable, but please note that pursuant to general legal bases enforced by the relevant courts, and as expressed in RL C1:4.4, double patenting is not allowed in Sweden in the event of two national applications filed by the same applicant, claiming the same invention and the same effective filing or priority date.

However, notably, if the applicant has obtained a granted European patent validated in Sweden this will not prevent the same applicant from obtaining a national patent concerning the same invention. In such a situation, double patenting is not prohibited.

2.c. If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

No, but the international application must validly have entered national phase in Sweden.

2.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The provisions of Section 2, 2nd paragraph applies only if the international application has entered Sweden nationally either by (1) direct national entry in Sweden (RL C1:4.2.3), or (2) by regional entry before the European Patent Office, (RL C1:4.2.2).

(1) National entry before the Swedish Patent Office:

For the international application to qualify as secret prior art, a copy or translation of the international application (if not in English or Swedish) must be filed along with the payment of the appropriate official fees (Section 31 of the Patents Act).

(2) Regional entry before the European Patent Office:

For the international application to qualify as secret prior art the European designation fee must be paid and Sweden must be designated (Rule 39(1) EPC; R.159(1) EPC).

In both above mentioned cases, the international application is not citeable as a secret prior art if the designation of Sweden is withdrawn or if the designation fee is not paid in due time.

On a further note, regular European patent applications validly designating Sweden are also citeable as secret prior art.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain
Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 1 Please Explain

3.b Same applicant on the dates of filing, no common inventor: same as Question 1 Please Explain

3.c Different applicants on the dates of filing, same inventors: same as Question 1 Please Explain

3.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project? No Please Explain

3.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 1 Please Explain

3.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing? No Please Explain

3.d.ii Would the answers change if the different applicants were part of a joint industry or industry-university research project? No Please Explain
Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

1. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

The Swedish group is of the opinion that the definition of when secret prior art is applicable to defeat patentability is clear and need not be improved. No changes should be made to current practice.

2. The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

The Swedish group is of the opinion that applying novelty only as the patentability standard to distinguish the claims of the later-filed application from the secret prior art should remain and that no improvements are needed.

3. The treatment of international applications as secret prior art.

No

Please Explain

The Swedish group is, in line with current Swedish practice, of the opinion that it should be required for a patent application to validly have entered national phase to qualify as secret prior art for a later-filed patent application.

4. The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

No changes should be made to current practice.

5. The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

No changes should be made to current practice.
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

4. f

Provisions for avoiding self-collision.

No

Please Explain

There are no anti-self collision provisions under Swedish patent law. No changes should be made to current practice.

4. g

Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

The general novelty requirement in relation to secret prior art may limit an applicant’s right to obtain patent claims on so-called incremental inventions in a later-filed application. No changes should be made to current practice.

5

Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain

No, we do not have any other policy considerations and/or proposals for improvement to the current law falling within this Study Question. The Swedish group is of the opinion that current national practise applying to conflicting applications is satisfactory and supports applying European practise as a basis for harmonisation of the treatment of conflicting applications.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6

Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

No

Even if NO, please address the extent your Group considers your Group

In general, the Swedish group considers harmonisation in this area to be desirable. However, we see that “conflicting applications” cannot be singled out of its legal context involving many other legal parameters which interact. Please refer to our response to question 10 for further elaboration on this subject and on the Harmonization Package of which conflicting applications forms part of.
For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

**Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain

The secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

**If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

Yes, the entire contents of the secret prior art should be available.

**If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?**

Yes, the standard for evaluation should be the same as the standard applied to publicly available prior art.

**Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

No

Please Explain

The secret prior art should not be available against the claims of the later-filed application to show lack of inventive step / obviousness.

**If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?**

Not applicable.

**If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?**

Not applicable.
If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Not applicable.

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

The international application should validly enter national phase in the jurisdiction to qualify as secret prior art.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

The secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art should be available.
a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be “new in relation to what was known before the filing date of the patent application” (Section 2, 1st paragraph).

The novelty standard applied to secret prior art should be the same as the standard applied to publicly available prior art.

b. If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There should be no anti-self collision provisions and therefore no anti-self collision time period.

c. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art should not be available against the claims of the later-filed application to show lack of inventive step / obviousness.

b. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Not applicable.

b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Not applicable.

b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Not applicable.

b. If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?
If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The international application should validly enter national phase in the jurisdiction to qualify as secret prior art.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

Same as Question 7

Please Explain
<table>
<thead>
<tr>
<th>9.b</th>
<th><strong>Same applicant on the dates of filing, no common inventor:</strong></th>
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<tbody>
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<td>same as Question 7</td>
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<tr>
<th>9.c</th>
<th><strong>Different applicants on the dates of filing, same inventors:</strong></th>
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<td>same as Question 7</td>
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<tr>
<th>9.c.i</th>
<th><strong>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</strong></th>
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<th>9.c.ii</th>
<th><strong>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</strong></th>
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<th>9.d</th>
<th><strong>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</strong></th>
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<td>same as Question 7</td>
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<td>Please Explain</td>
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<th><strong>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</strong></th>
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<td>No</td>
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<td>Please Explain</td>
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<td>Please Explain</td>
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<tr>
<th>9.e</th>
<th><strong>Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:</strong></th>
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<td>Please Explain</td>
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Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

A basic principle of the patent system is to provide incentives for commercialization of technical knowledge by providing innovators with limited exclusive rights giving the inventors possibility to receive appropriate returns of their investments. Thus, for example, if the secret prior art would be handled differently depending on whether the secret prior art and the applicant and inventors of the later-filed application are unrelated or the same, the patent system would favour the party being first to file. Thus, there would be a risk that the basic principles of the patent system would be set aside.

Further, the Study Guidelines refer to the work since 2015 by the Industry Trilateral and the Group B+ sub-group on patent harmonization aiming at a Possible Substantive Patent Harmonization Package. The work includes conflicting applications, which is a controversial issue where no consensus on a harmonized solution has so far been reached. The difficulty in reaching such consensus reflects differences in basic policy considerations related particularly to remaining differences between the first-to-file system according to the EPC and the US first-inventor-to-file system. Therefore, an agreement on the issue of conflicting applications does not seem forthcoming.

The work on a Harmonization Package implies that the benefits and disadvantages of harmonization will be evaluated for all the issues included and not separately for conflicting applications or for other parts of the package. A harmonization of conflicting applications may thus be agreeable as part of the package worked on by Industry Tri-lateral and the Group B+ sub-group though it cannot be agreed on separately.

A consensus on harmonization of conflicting applications having been difficult to reach in the work of the Industry Trilateral, it will not be easier to reach in the Study Question. The Study will, however, provide a survey of the harmonization solutions desired and the support thereof and will provide a basis for positions to be taken by AIPPI in the further work on Substantive Patent Law Harmonization.

To contribute to this important work, AIPPI needs also to refresh its study of the other issues included in the Harmonization Package of the Group B+ sub-group and to take position on this harmonization and in particular the issue of a grace period.

The present state of play of the work on this Package does not seem to offer an appropriate basis for the envisaged broader consultation by Group B+. At the next meeting, AIPPI should therefore support further such work being done before the consultation, which would later allow AIPPI to contribute a comprehensive up-to-date position on the result then achieved.

Please indicate which industry sector views are included in your Group’s answers to Part III.

Patent professionals from the telecom and vehicle industry have been involved in the discussions concerning all aspects of Part III.
Study Question

Submission date: April 30, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group: Switzerland
Contributors name(s): Jürgen Dressel, Nicolas Guyot Youn, Thomas Kretschmer, Birgit Matl, Sébastien Ragot, Joseph Schmitz, Hannes Spillmann, Michael Stoerzbach, Paul Pliska, Marco Zardi
E-mail contact: tkip@hispeed.ch

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Jurisdiction: EP
Yes

Please Explain
Switzerland is a member of the European Patent Convention (EPC), and the European Patent Office (EPO) grants patents with effect in Switzerland under the EPC. However, a complete detailed report for this regional law appears not necessary: Art 54(2) and (3) EPC are substantially identical to Art. 7(1) and (2) of the Swiss Federal Act on Patents for Inventions (PatA), and treatment and importance of secret prior art according to the EPC and the PatA are consistent. Hence, this Report refers to Swiss national law, which applies mutatis mutandis to European patent applications as well.

A substantial difference between the EPC and the PatA resides in the origin of secret prior art: Art 54(3) EPC restricts secret prior art to earlier filed European patent applications, and Art. 153(4) EPC adds Patent Cooperation Treaty (PCT) applications of earlier priority date provided they are published by the EPO which is substantially equivalent to be validly entered into the regional phase before the EPO. National secret prior art (national patent applications having an earlier priority and corresponding national phase of PCT applications) is dealt with on a national level after grant only according to Art. 139(2) EPC as if the national part of a European patent was a national patent.

Jurisdiction: Switzerland

Yes

Please Explain

Yes, according to Art. 7(3) PatA, the Swiss Federal Act on Patents for Inventions.

With regard to novelty, the state of the art also includes the content of an earlier application or application with earlier priority designating Switzerland in the version originally filed, and with a filing or priority date that precedes the filing or priority date (Art. 7(2) PatA) of the later-filed application, and which was only made available to the public on or after that date, provided that the following requirements are fulfilled:

in the case of an international application: designation of inventor in writing, remarks concerning the source, payment of the filing fee, translation in an official language (Art. 138 PatA);

in the case of a European application based on an international application: filing fee paid at the EPO, translation in an official language if published in a non-official language of the EPO (Art. 153(5) EPC);

in the case of a European application: the designation fees for Switzerland have been paid (Art. 79(2) EPC).

Secret prior art constituted by national Swiss patent applications is prior art as well according to Art. 7(3) PatA.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The former "prior claim approach" has been replaced by the “whole content approach” for assessing novelty in view of secret prior art. Since July 1, 2008 the “whole content approach” is applied in Switzerland, which means that additionally to the claims, the description and the drawings of the secret prior art are relevant for the assessment of novelty.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Art. 7(3) PatA does not make any distinction between publicly available prior art and secret prior art for the purpose of evaluating novelty. Thus, the standard to be applied is the same as for publicly available prior art.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

No, Art. 7(3) PatA refers to novelty only.
<table>
<thead>
<tr>
<th>Question</th>
<th>Description</th>
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<tbody>
<tr>
<td>1.b.i</td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
</tr>
<tr>
<td>1.b.ii</td>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.</td>
</tr>
<tr>
<td>1.b.iii</td>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
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<tr>
<td>1.c</td>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
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<tr>
<td>1.c.i</td>
<td>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</td>
</tr>
<tr>
<td>1.c.ii</td>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
</tr>
<tr>
<td>1.c.iii</td>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
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No, provided that the international application fulfils the requirements given under 1) a).

Yes, the international application must fulfil the requirements given under 1) a).

No, according to Art. 7(2),(3) PatA it does not depend on the date of the national phase entry.
2. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Yes, it is irrelevant whether the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same. The Swiss Patent Act is silent in this regard.

2.a.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The "whole content approach" is applied and, therefore, the entire contents of the secret prior art are available, see the response to question 1) a) i).

2.a.ii. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Art. 7(3) PatA does not make any distinction; see response to question 1) a) ii).

2.a.iii. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No, the Swiss Patent Act does not have any provision relating to anti-self collision.

2.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

No, for the same reasons as mentioned in response to question 1) b).

2.b.i. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

-

2.b.ii. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

-
2.b.iii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

- 

2.b.iv If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

- 

2.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

Anti-self collision is not applied in Switzerland.

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

No, see the response to question 1) c) i).

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Yes, see the response to question 1) c) ii).

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?
No

Please Explain

No, see the response to question 1) c) iii).

3. Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain

Art. 7(3) PatA does not make any difference between the situation where the applicant and/or the inventor(s) of the secret prior art and the later-filed application are the same and the situation where the applicant and/or the inventor(s) of the secret prior art and the later-filed application are different.

Therefore, the answers for the scenarios of Question 3, wherein either the applicant or the inventor(s) of the later-filed application is different, are identical to those set forth in the previous questions.

3. Same applicant on the dates of filing, no common inventor:

same as Question 2

Please Explain

3. Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

3. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

The answers to sub-question i) for scenario c) and sub-questions i) - ii) for scenario d) are negative, since the aspects of applicants being part of a joint-industry or industry-university research project and of inventors having an obligation to assign the invention to the same applicant are not dealt with in the Swiss Patent Act.

3. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain
Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

II. Policy considerations and proposals for improvements of your current law

Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

No, Art. 7(3) PatA defines appropriately the “when”.

The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

Switzerland applies the “novelty-only” standard. The Study Group does not see any reason to deviate from this standard.

The treatment of international applications as secret prior art.

No

Please Explain

No, according to the current Art. 7(3)(a)-(b) PatA, an international or a European patent application has prior art effect when it enters the national phase or when Switzerland is designated (cf. 1 c)). The Study Group does not see any reason to deviate from this provision.
### III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.
**Does your Group consider that harmonisation in any or all areas in Section II desirable?**

*If YES, please respond to the following questions without regard to your Group's current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

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If YES, please respond to the following questions without regard to your Group

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<tr>
<th>7</th>
<th>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.</th>
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<th>7.a</th>
<th>Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</th>
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<th>If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</th>
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| The entire contents (as with publicly available prior art). |
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<th>7.a.ii</th>
<th>If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?</th>
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| The same as the standard applied to publicly available prior art. |
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<th>7.b</th>
<th>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</th>
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7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c If the secret prior art is an international application filed designating your jurisdiction:

7.c Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

7.c Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Yes, for the purpose of secret prior art only international patent applications that have validly entered the national phase should be taken into account to avoid double patenting.

7.c.ii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain
No, as stated in 4) f) the Study Group is in principle open for an exception for applicant’s own patent application.

8.a.i If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

- 

8.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

- 

8.a.iii If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

- 

8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

8.b.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

- 

8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

- 

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

- 

-
8.b.iv If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

8.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Cf. 7) c) ii)

8.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Cf. 7) c) iii)

9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.
9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 8

Please Explain

9.b Same applicant on the dates of filing, no common inventor:

same as Question 8

Please Explain

9.c Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.d.i Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

9.d.ii Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.e Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain
9.f  Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

10  Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

-

11  Please indicate which industry sector views are included in your Group’s answers to Part III.

None
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain
There is no specific provision of the secret prior art under the current Patent Act B.E. 2522 (as amended).

<table>
<thead>
<tr>
<th>a.</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>a.</td>
<td>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
</tr>
<tr>
<td>c</td>
<td>Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>There is no specific provision of the secret prior art under the current Patent Act.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>b.</th>
<th>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>b.</td>
<td>If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.</td>
</tr>
<tr>
<td></td>
<td>If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
</tr>
<tr>
<td>c</td>
<td>If the secret prior art is an international application filed designating your jurisdiction:</td>
</tr>
<tr>
<td></td>
<td>Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</td>
</tr>
<tr>
<td></td>
<td>No</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>There is no specific provision under the current Patent Act.</td>
</tr>
</tbody>
</table>

| c. | Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain. |
|    | No |
|    | Please Explain |

487
There is no specific provision under the current Patent Act.

### Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

There is no specific provision under the current Patent Act.

### For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

### Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

There is no specific provision under the current Patent Act.

### If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

### If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

### If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

### Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

There is no specific provision under the current Patent Act.

### If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?
### b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

### b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

### b. If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

### b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

Please Explain

There is no restriction to avoid double patenting under the current Patent Act. However, under the draft patent law amendment, a double patenting is proposed to be used for a novelty bar.

### c. If the secret prior art is an international application filed designating your jurisdiction:

If the secret prior art is an international application filed designating your jurisdiction:

### c. i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

There is no specific provision under the current Patent Act.

### c. ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

There is no specific provision under the current Patent Act.

### c. iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain
AIPPI 2018 - Study Question - Conflicting patent applications

There is no specific provision under the current Patent Act.

3. Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.3. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain

There is no specific provision of the secret prior art.

3.3. Same applicant on the dates of filing, no common inventor:

same as Question 1

Please Explain

There is no specific provision of the secret prior art.

3.3. Different applicants on the dates of filing, same inventors:

same as Question 1

Please Explain

There is no specific provision of the secret prior art.

3.3. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

There is no specific provision of the secret prior art.

3.3. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1

Please Explain
II. Policy considerations and proposals for improvements of your current law

Could any of the following aspects of your Group's current law be improved? If YES, please explain.

4.a The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

Under the draft patent law amendment, the secret prior art can be used for the novelty bar.

4.b The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

Yes

Please Explain

The international application should not be used as the secret prior art unless the application enters the national phase.

4.c The treatment of international applications as secret prior art.

Yes

Please Explain

There is no specific provision of the secret prior art.

Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

There is no specific provision of the secret prior art.

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

There is no specific provision.
### III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

#### 4.d

The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

#### 4.e

The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

#### 4.f

Provisions for avoiding self-collision.

No

Please Explain

#### 4.g

Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

No

Please Explain

#### 5

Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

No

Please Explain

---

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

#### 6

Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

*If YES, please respond to the following questions without regard to your Group*

#### 7

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.
### 7.a

**Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

**Yes**

**Please Explain**

To avoid the double patenting.

### 7.a.i

**If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

The entire contents of the secret prior art should be available.

### 7.a.ii

**If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?**

The standard for evaluation should be the same as the standard applied to publicly available prior art.

### 7.b

**Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

**No**

**Please Explain**

### 7.b.i

**If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

### 7.b.ii

**If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?**

### 7.b.iii

**If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?**

### 7.c

**If the secret prior art is an international application filed designating your jurisdiction:**

### 7.c.i

**Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.**

**Yes**

**Please Explain**
If the international application has not actually entered the national phase in Thailand, the international application should not be used as the secret prior art.

**Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

Yes

Please Explain

The international application which entered the national phase can be used as the novelty bar.

**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

Yes

Please Explain

**For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.**

**Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain

To avoid double patenting

---

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art should be available.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation should be the same as the standard applied to publicly available prior art.

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

---
8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

8.b. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

8.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

8.b. If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

8.b. If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

Yes

Please Explain

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c. Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

Yes

Please Explain

If the international application has not actually entered the national phase in Thailand, the international application should not be used for the novelty bar.

8.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes
<table>
<thead>
<tr>
<th>Question</th>
<th>Scenario</th>
<th>Answer</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td>8.c.iii</td>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>9</td>
<td>Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.</td>
<td>Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
</tr>
<tr>
<td></td>
<td>Same applicant on the dates of filing, no common inventor:</td>
<td>same as Question 7</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Different applicants on the dates of filing, same inventors:</td>
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<td></td>
</tr>
<tr>
<td></td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
<td></td>
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<tr>
<td></td>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>Question</td>
<td>Description</td>
<td>Answer</td>
<td>Explanation</td>
</tr>
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<tr>
<td>9.d.</td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>9.e.</td>
<td>Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:</td>
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<td></td>
</tr>
<tr>
<td>9.f.</td>
<td>Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:</td>
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<td></td>
</tr>
<tr>
<td>10</td>
<td>Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.</td>
<td>none</td>
<td></td>
</tr>
<tr>
<td>11</td>
<td>Please indicate which industry sector views are included in your Group’s answers to Part III.</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
Study Question

For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Yes. In accordance with the Art. 83(3) Industrial Property Law, unpublished national patent and utility models are included to the prior art for novelty assessment purposes.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Pursuant to Industrial Property Law Nr. 6769, content of the first application belongs to the prior art. It is interpreted that the entire content of the first application is considered secret prior art.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Legalization does not include any different standard to be applied for novelty assessment. Therefore, it was assumed that the same assessment standard applies to secret or publicly available prior art.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

No. Art. 83(4) clearly states that the secret prior art according to Art. 83(3) is not used to evaluate inventive step.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain
AIPPI 2018 - Study Question - Conflicting patent applications

No. An international application wherein the Turkey is a designated state will be considered a part of the prior art according to the current legalization and same answers apply to the above questions.

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
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</thead>
<tbody>
<tr>
<td>1.c.1</td>
<td>Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Yes</td>
<td>Pursuant to the Art. 83(3)(a) international applications enter into the national phase under Art. 22 and 39 PCT after fulfilling the national requirements will be considered as secret prior art.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.c.1</td>
<td>Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>No</td>
<td>Effective date of the international patent application applies when assessing the novelty.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>2</td>
<td>For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>2.a</td>
<td>Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Yes</td>
<td>There is no change if the applicant is the same for novelty-defeating purposes. Secret prior art will be used against the novelty of later application.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>2.a.i</td>
<td>If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
</tr>
<tr>
<td>Answer to the Question 1(a) applies. Entire content is used.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td>2.a.ii</td>
<td>If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?</td>
</tr>
<tr>
<td>Answer to the Question 1(a)(ii) applies</td>
<td></td>
</tr>
</tbody>
</table>
### AIPPI 2018 - Study Question - Conflicting patent applications

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>2.a.iii</strong> If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td>No.</td>
</tr>
<tr>
<td><strong>2.b</strong> Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
</tr>
<tr>
<td><strong>2.b.i</strong> If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td>No</td>
</tr>
<tr>
<td><strong>2.b.ii</strong> If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?</td>
<td>No</td>
</tr>
<tr>
<td><strong>2.b.iii</strong> If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</td>
<td>No</td>
</tr>
<tr>
<td><strong>2.b.iv</strong> If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td>No</td>
</tr>
<tr>
<td><strong>2.b.v</strong> If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
<td>No</td>
</tr>
<tr>
<td><strong>2.c</strong> If the secret prior art is an international application filed designating your jurisdiction:</td>
<td>No</td>
</tr>
<tr>
<td><strong>2.c.i</strong> Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.</td>
<td>No</td>
</tr>
<tr>
<td><strong>2.c.ii</strong> Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</td>
<td>No</td>
</tr>
</tbody>
</table>

---

**Please Explain**

No. Answer to the Question 1(b) applies.
Yes

Please Explain

Yes. Pursuant to Art. 83(a) of Industrial Property Law, there is a clear condition of actually entering the national phase by fulfilment of national requirements.

**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

Yes

Please Explain

Yes. Answer to Question 1(c)(3)2 applies.

**Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.**

**3.**

**Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

different

Please Explain

Above answers apply.

**3.a.**

**Same applicant on the dates of filing, no common inventor:**

different

Please Explain

Above answers apply.

**3.c.**

**Different applicants on the dates of filing, same inventors:**

different

Please Explain

Above answers apply.

**3.c.i.**

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No
II. Policy considerations and proposals for improvements of your current law

### 3. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

<table>
<thead>
<tr>
<th><strong>3.a</strong></th>
<th>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Yes, it can be improved. For international applications, a more explicit provision can be added on which date will be taken as basis.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th><strong>3.b</strong></th>
<th>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Legislation is believed to be improved in such a way that in an instance where an entity having been a partial owner of a first application which</td>
<td></td>
</tr>
</tbody>
</table>
qualifies as a “secret” prior art for a second application is a partial or a full owner of said second application (or the entity has had ownership
for the second application at the of filing same); and where the other owners of the first application does not have a direct or indirect consent,
the merits of grant should include inventive step/non-obviousness criterion in addition to novelty relative to prior art domain including the first
application. Yet, the ownership aspect for an invention which is relevant to preceding inventions as a subject-matter may be claimed pursuant
to an upper legal norm, it is considered that special provisions are necessary with a view to prevent legal disputes.

### The treatment of international applications as secret prior art.

<table>
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<tr>
<th>Yes</th>
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<tbody>
<tr>
<td>Please Explain</td>
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</table>

Yes, it can be improved. Based on the current law, the international (PCT) application is regarded as secret prior art when the PCT
application enters the national phase (Art 83.3a). As an improvement to this law, the PCT application can be regarded as a secret prior art
when Turkey is designated and the Turkish translation of the PCT application is provided.

### The treatment of total and partial identity of applicants as it relates to secret prior art.

<table>
<thead>
<tr>
<th>Yes</th>
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<tbody>
<tr>
<td>Please Explain</td>
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</table>

Yes, the current law should be improved so as to comprise clear provisions regarding the evaluation of the secret prior art in case of total and
partial identity of applicants.
In case of partial identity of the applicant(s) of the first and second patent application and in the absence of direct or indirect consent of the
prior right owners, the current law can be amended in accordance with our explanations under question 4(b).
In case of partial identity of the applicant(s) of the first and second patent application and in the presence of direct or indirect consent of the
prior right owners, the law should clearly state that, when examining the second patent application, the content of the first application as filed
will be considered as comprised in the state of the art, but the content of the first application as filed will not be taken into consideration when
examining inventive step.
In case of total identity of the applicant(s) of the first and second patent application, the law should clearly state that, when examining the
second patent application, the content of the first application as filed will be considered as comprised in the state of the art, but the content of the
first application as filed will not be taken into consideration when examining inventive step.

### The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

<table>
<thead>
<tr>
<th>Yes</th>
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<tbody>
<tr>
<td>Please Explain</td>
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</table>

Above considerations apply.

### Provisions for avoiding self-collision.

<table>
<thead>
<tr>
<th>Yes</th>
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<tbody>
<tr>
<td>Please Explain</td>
</tr>
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</table>

Yes, it can be improved for the later-filled application of same applicant.
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

5. Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

No

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

No

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Yes.

7.b. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Standard novelty evaluation should be performed.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

No.

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

No.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain
Yes. It actually has to enter the national phase to be considered a secret prior art document (Art. 83.3a).
(same recommendation as in question 4c) As an improvement to this law, the PCT application can be regarded as a secret prior art when Turkey is designated and the Turkish translation of the PCT application is provided.

7.c.iii.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No it does not. It depends on the filing date of the international application. However article 83 does not explicitly describe the date from which the international application is available as secret prior art. Therefore it can be added as a new paragraph to the article 83.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Yes, anti-self collision time period may be 12 months for applications with the same applicant.

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content should be taken into consideration.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Standard novelty evaluation should be performed.

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.
8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Anti-self collision time period may be 12 months for application with the same applicant.

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Additional restrictions may be applied to avoid double patenting. Such as litigating all patents together.

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

Yes

Please Explain

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain

8.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain
Yes. It actually has to enter the national phase to be considered a secret prior art document (Art. 83.3a). As an improvement to this law, the PCT application may not be regarded as a secret prior art when the applicant and inventors of the later-filed application are the same.

8.c.iii

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

No it does not. It depends on the filing date of the international application. However article 83 does not explicitly describe the date from which the international application is available as secret prior art. In addition, the PCT application may not be regarded as a secret prior art when the applicant and inventors of the later-filed application are the same. Therefore there may be no need for the date from which the international application is available as secret prior.

9

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 8

Please Explain

9.b

Same applicant on the dates of filing, no common inventor:
same as Question 8

Please Explain

9.c

Different applicants on the dates of filing, same inventors:
same as Question 7

Please Explain

9.c.i

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

9.d

Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:
same as Question 7
Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes

Please Explain

Yes. Then inventive step is also be checked.

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

Yes

Please Explain

Answer to Question 4d applies. If there is no consent, inventive step should be evaluated.

Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

different

Please Explain

Answer to Question 4d applies. If there is no consent, inventive step should be evaluated otherwise, same as Question 7.

Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

Please indicate which industry sector views are included in your Group’s answers to Part III.

Pharmaceutical industry, home appliances industry.
Study Question

Submission date: May 2, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAKKONEN and Ralph NACK, Assistants to the Reporter General

Conflicting patent applications

Responsible Reporter(s): Jonathan P. OSHA

National/Regional Group United Kingdom
Contributors name(s) Claire BALDOCK, Trevor COOK, Ed CRONIN, Matthew HOYLES, Mike JENNINGS, Oliver LAM, Rachel MUMBY, Michael NEWTON, Justin WATTS, Daniel WOOD
e-Mail contact sara.ashby@wiggin.co.uk

For all of the questions:

\textit{a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.}

\textit{b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.}

\textit{The standard for what constitutes adequate support is outside the scope of this Study Question.}

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain
Yes. [1][2]

For an EP patent application, where the secret prior art is a national right, the secret prior art is relevant only for that designation. Where a national right of an earlier date exists in a contracting state designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the contracting state of the national right of earlier date. Second, for that state, he may file claims which are different from the claims for the other designated states. Third, the applicant can limit his existing set of claims so that the national right of earlier date is no longer relevant[3]. This point is repeated below.

[1] s. 2(3) Patents Act 1977 (Save for the caveat expressed at 4(a) below whereby an application that is withdrawn, but still subsequently published by the UKIPO (due to error or insufficient notice), will not act as Secret Prior Art.)

[2] Art. 54(3) EPC


If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Entire contents.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard is the same as applied to publicly available prior art.

Under UK law, the standard for evaluation of novelty can be summarised as: secret prior art is novelty-destroying if it provides sufficient information for the invention to be reproduced from the total information content of that prior disclosure when this is received by the person skilled in the art and understood by him in the light of his common general knowledge at the time.[1]

Under EP law, a document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document. [2]

[1] Commentary on Section 2, CIPA Guide to the Patents Acts


Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?
If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

Yes

Please Explain

For UK patent applications, only the following applications may be relied on as secret prior art:

- UK applications which have been published;
- International applications for patents designating the UK, published by WIPO which have entered the UK national phase;
- applications for European patents (UK) published by the EPO; and
- International applications for European patents (UK) published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office). [1]

For EP patent applications, the following applications may be relied on as secret prior art:

- applications for European patents published by the EPO and designating any EPC countries; and
- International applications for European patents published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office).

To repeat the point made at 1(a), above: For an EP patent application, where the secret prior art is a national right, the secret prior art is relevant only for that designation. That is, where a national right of an earlier date exists in a contracting state designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the contracting state of the national right of earlier date. Second, for that state, he may file claims which are different from the claims for the other designated states. Third, the applicant can limit his existing set of claims so that the national right of earlier date is no longer relevant[2].

---

[1] Commentary on Section 2, CIPA Guide to the Patents Acts

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.
The answer to (1)(c)(i), above, is repeated here in its entirety.

For UK patent applications, only the following applications may be relied on as secret prior art:

- UK applications which have been published;
- International applications for patents designating the UK, published by WIPO which have entered the UK national phase;
- applications for European patents (UK) published by the EPO; and
- International applications for European patents (UK) published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office). [1]

For EP patent applications, the following applications may be relied on as secret prior art:

- applications for European patents published by the EPO and designating any EPC countries; and
- International applications for European patents published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office).

To repeat the point made at 1(a), above: For an EP patent application, where the secret prior art is a national right, the secret prior art is relevant only for that designation. That is, where a national right of an earlier date exists in a contracting state designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the contracting state of the national right of earlier date. Second, for that state, he may file claims which are different from the claims for the other designated states. Third, the applicant can limit his existing set of claims so that the national right of earlier date is no longer relevant. [2]

[1] Commentary on Section 2, CIPA Guide to the Patents Acts
The applicant and inventor of the secret prior art is irrelevant.\textsuperscript{[1][2]}

\begin{itemize}
\item [1] s. 2(3) Patents Act 1977
\item [2] Art. 54(3) EPC
\end{itemize}

\begin{tabular}{|p{1\textwidth}|}
\hline
\textbf{If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?} \\
\hline
\textbf{Entire contents.} \\
\hline
\end{tabular}

\begin{tabular}{|p{1\textwidth}|}
\hline
\textbf{If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?} \\
\hline
\textbf{The standard is the same as applied to publicly available prior art.} \\
\hline
\begin{itemize}
\item In the UK, the standard for evaluation of novelty can be summarised as: secret prior art is novelty-destroying if it provides sufficient information for the invention to be reproduced from the total information content of that prior disclosure when this is received by the person skilled in the art and understood by him in the light of his common general knowledge at the time.\textsuperscript{[1]}
\item Before the EPO, a document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document.\textsuperscript{[2]}
\end{itemize}
\hline
\end{tabular}

\begin{itemize}
\item [1] Commentary on Section 2, CIPA Guide to the Patents Acts
\end{itemize}

\begin{tabular}{|p{1\textwidth}|}
\hline
\textbf{If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?} \\
\hline
\textbf{No.} \\
\hline
\textbf{Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?} \\
\hline
\textbf{No} \\
\hline
\textbf{Please Explain} \\
\hline
\textbf{If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?} \\
\hline
\textbf{If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?} \\
\hline
\end{tabular}
If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

Yes

The answer to (1)(c)(i) and (ii), above, is repeated here in its entirety.

For UK patent applications, only the following applications may be relied on as secret prior art:

- UK applications which have been published;
- International applications for patents designating the UK, published by WIPO which have entered the UK national phase;
- applications for European patents (UK) published by the EPO; and
- International applications for European patents (UK) published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office). [1]

For EP patent applications, the following applications may be relied on as secret prior art:

- applications for European patents published by the EPO and designating any EPC countries; and
- International applications for European patents published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office).

To repeat the point made at 1(a), above: For an EP patent application, where the secret prior art is a national right, the secret prior art is relevant only for that designation. That is, where a national right of an earlier date exists in a contracting state designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the contracting state of the national right of earlier date. Second, for that state, he may file claims which are different from the claims for the other designated states. Third, the applicant can limit his existing set of claims so that the national right of earlier date is no longer relevant. [2]

[1] Commentary on Section 2, CIPA Guide to the Patents Acts
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The answer to (1)(c)(i) and (ii), and (2)(c)(i), above, is repeated here in its entirety.

For UK patent applications, only the following applications may be relied on as secret prior art:

- UK applications which have been published;
- International applications for patents designating the UK, published by WIPO which have entered the UK national phase;
- applications for European patents (UK) published by the EPO; and
- International applications for European patents (UK) published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office). [1]

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To repeat the point made at 1(a), above: For an EP patent application, where the secret prior art is a national right, the secret prior art is relevant only for that designation. That is, where a national right of an earlier date exists in a contracting state designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the contracting state of the national right of earlier date. Second, for that state, he may file claims which are different from the claims for the other designated states. Third, the applicant can limit his existing set of claims so that the national right of earlier date is no longer relevant. [2]

[1] Commentary on Section 2, CIPA Guide to the Patents Acts
Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain

See answer to Questions 1 and 2

3.b Same applicant on the dates of filing, no common inventor:

same as Question 2

Please Explain

See answer to Questions 1 and 2

3.c Different applicants on the dates of filing, same inventors:

same as Question 2

Please Explain

See answer to Questions 1 and 2

3.d Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

3.d Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain
Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

Yes

Please Explain

We do not identify a need for a change that would be beneficial if done in isolation, but there are changes that, if made as part of international harmonization, would be beneficial. There is a benefit for instance to a single international standard of novelty-destroying prior art and in that context it would make sense for a PCT application once published to be treated as prior art in all parties to the PCT.

Is the prevention of double patenting the only reason for conflicting applications to be novelty destroying? If so there would not appear to be any need for withdrawn applications to act as Secret Prior Art. Arguments regarding difficulties in implementing a rule that states withdrawn applications should not be Secret Prior Art do not have good support: A similar problem is regularly overcome by the UKIPO and EPO in checking national phase entry by PCT applications. There is also a rule in the UKIPO Manual of Patent Practice that states where a request to withdraw an application is sent to the UKIPO immediately before publication, and publication is not prevented, that published application will not become prior art under s.2(3) of the Patents Act.

There are however other factors that make it less attractive to prevent withdrawn applications from being Secret Prior Art. First, there is no clearly described need for separate rules for withdrawn applications. Second, such a change may encourage patentees to behave in unwanted ways, as it would reward delay in prosecution. Patentees could delay assessment of novelty[1] in the hope or expectation that published applications no longer proceeding to grant would no longer be relevant (whether through refusal or withdrawal or otherwise).

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[1] Up to the point this is possible under local procedural rules. In the UK an applicant has “four years and six months calculated from the declared priority date or, where there is none, from the filing date of the application; or (ii) twelve months calculated from the date that the first substantive examination report is sent to the applicant, whichever expires the later. Where the first substantive examination report is not sent to the applicant before the expiry of the period set out at (i) above, that period is extended to such date as that report is sent to the applicant and the period set out at (ii) then applies.” – UKIPO on Rule 30 of the Patents Rules 2007

The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

Yes

Please Explain

The current test is restricted to novelty and in principle we consider that that is the correct test. However, it is also necessary to consider not just what the test is in principle, but how that test is applied in practice. The UK group
considers it to be important to apply a test for novelty consistently and based on the enabling disclosure test. This means considering what, to a skilled addressee (equipped with the common general knowledge), a document discloses and enables.

International attempts to harmonise the standard of novelty applied to conflicting applications may be premature because there are currently substantial international differences in the law on novelty in general. If a lack of distance between patent applications is a substantial international issue, we need to investigate the differences in the law on novelty between countries before we can decide which standard of novelty should be applied to conflicting applications. For example, enlarged novelty in one country may give results that are more like 'normal' novelty in another.

The treatment of international applications as secret prior art.

Yes

Please Explain

We do not identify a need for a change that would be beneficial if done in isolation, but there are changes that, if made as part of international harmonization, would be beneficial. There is a benefit for instance to a single international standard of novelty-destroying prior art and in that context it would make sense for a PCT application once published to be treated as prior art in all parties to the PCT.

The treatment of international applications as relevant prior art, in the same way as national applications, is desirable and in line with the ambitions of the Paris Convention. Currently our policy is based on the need to avoid double patenting, and barriers to the translation and discovery of international filings. Because of this PCT applications are not Secret Prior Art until they enter the national phase.

There is now improved technology for machine translation of technical documents. We are also now more interested in increasing the efficiency and reducing the cost of work at intellectual property offices: This can be encouraged by applying a common body of secret prior art when considering parallel applications in different national offices, so that the work of each office can be shared. These factors should be considered when deciding if the requirement for national phase entry remains the best policy.

Should PCT applications designating a country or office be available as Secret Prior Art regardless of entry into the national phase? This proposal would remove issues regarding payment of fees or satisfaction of timing requirements (that are not obvious from the face of a patent).

Is preventing double patenting still the key policy objective? If so there is no need for change in the treatment of international applications. Though there are potential savings from the sharing of work between patent offices, by increasing the potential pool of prior art we could actually increase work load at national offices, if sharing of work was not effective. A policy of PCT applications being Secret Prior Art without national phase entry would also have much less effect on those offices that see the most applications in national phase entry. The needs of all Paris Convention signatories need to be considered so that harmonised policy is not unfair.

[1] As recommended in paragraph 180 of the 2012 Tegernsee Report

[2] National phase entries: USPTO: 137,331; EPO: 98,278; SIPO: 81,866. These three offices accounted for slightly more than half (51.3%) of all NPEs initiated in 2015 (WIPO "PCT Yearly Review 2017 – Executive Summary")

The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No
Please Explain

4.f. **Provisions for avoiding self-collision.**

No

Please Explain

4.g. **Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.**

No

Please Explain

NO, apart from the comments on the current application of the law on novelty above at 4(b).

5. Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

Yes

Please Explain

The study question provides examples of several policy areas that are relevant to the law on conflicting applications. These policy considerations and others are assessed below.

a. **Patent Thickets**

Paragraph 10 of the guide to the study question states that patent thickets “may create an unreasonable barrier to commercialization of new technology”. Carl Shapiro’s 2001 paper “Navigating the Patent Thicket: Cross Licenses, Patent Pools, and Standard-Setting” is cited in the study question. Shapiro’s paper is a very highly regarded contribution to the debate on the economics of patenting [1], but care needs to be taken in directly linking economics and policy development. Patent thickets are challenging to quantify. There is no accepted definition. The problem is also substantially older than current news articles indicate: in his 2013 paper on the subject [2] Professor Sir Robin Jacob cited the following passage, written in 1947:

“There is ... a way in which a monopoly in an important invention may be kept alive after the patent has come to an end, and that is by patenting large numbers of minor improvements to the original invention. ... Provided the patented improvements represent genuine development over the period during which the original patent is in force, and provided they are patented with determination and persistence, by the time the original patent expires a would-be imitator should be faced with this situation: that the article described in the original specification is too inferior to contemporary designs to be commercially saleable, while he cannot imitate the newer models without risking an action for infringement of so many of the improvement patents, that he would almost certainly lose in respect of some patent or other”

In fact, more recent literature on patent thickets recognises that it is not possible to draw clear conclusions from the available data. Even papers that determine smaller companies may be deterred from patenting by patent thickets do not conclude that the welfare of those companies is reduced [3]. A meta-review of patent thicket literature in 2015 [4] concluded from a review of 164 papers that use of the term “patent thicket” in different literature actually referred to one or more of seven separate economic issues. The same paper concluded that loss of economic efficiency due to overlapping patents can be addressed by private arrangements such as patent pooling or licensing obligations.

One of the criticisms stated in that paper is that "those engaged in industry commentary and advocating intellectual property rights reform, appear to have improvised their definition of a patent thicket". Any policy response to the concept of patent thickets should therefore be a response not to perceived policy need but to evidence of negative economic effects. Then we can collect the data necessary to demonstrate that the policy proposed improves the situation.

US, Japanese and European bodies have reported issues with patent thickets. It is therefore not obvious how adoption of, or harmonisation between, existing patent law in this area can address, even theoretically, the perceived problem of patent
The prevention of double patenting is a key policy objective for intellectual property offices and the AIPPI. In 2012 the Tegernsee Experts Group produced a substantial study on the treatment of conflicting applications [5] (the “2012 Tegernsee Report”). That report contained empirical data on conflicting applications across jurisdictions. In that report it was stated:

“The main purpose of the provisions governing the effect of co-pending prior applications which are later published is to prevent double patenting. However, how these provisions are formulated plays a role in determining the manner in which incremental innovative developments may be appropriated, and by whom”

If the purpose of the law on conflicting applications is to prevent double patenting two anomalies are relevant:

i. Secret Prior Art EP applications not designating a member state can be used to challenge novelty in that member state; and

ii. withdrawn applications can be valid Secret Prior Art.

The explanation for these points might be just that it is more efficient for patent offices to treat applications in this way. While the prevention of double patenting is an important policy, it is also important that the patent office can operate as efficiently as possible. This may prevent more complex rules to prevent double patenting than are already in place.

The current application of the law as to novelty at the EPO and UKIPO, as addressed in Section I, may also be responsible for any lack of distance between applications, rather than the law on conflicting applications.

a. Uncertainty: Differences in patentability

The study guidelines describe a situation where "multiple patents may be amassed in one country while adequate protection cannot be obtained in another”. Differences between place of filing are normal for territorial rights (particularly where countries value their ability to decide on public policy), however harmonisation of international law can reduce transaction costs for multinational enterprises. This in turn can promote international trade and development. The positive value of harmonisation has to be compared against local uncertainty and implementation costs that harmonisation could cause in the short term. In addition, international harmonisation can create increased polarisation of risk, leading to ‘all-or-nothing’ situations. This is one reason why many multinational companies have stated they would not seek to rely entirely on Unitary Patents following their (possible) introduction, preferring in the near term to rely instead a bundle of separate European rights.

Many countries have their own checks and balances to control patentability. While patentability of any individual invention may vary between countries, on a larger scale each patent office may accept or reject a reasonable number of applications. This is an additional reason why harmonisation efforts based on a single area of patent law (such as conflicting applications) cause issues for some national offices, as happened at the 2005 Casablanca consultations on the SPLT where a number of national delegations (particularly those in developing countries) refused to support the program of prioritisation of harmonisation issues put forward by the states of the trilateral offices, because they were concerned about the erosion of their ability to decide their own national public policy [6].

a. Prosecution efficiency

All the users of the patenting system would like the patent prosecution process to be (or, more likely, become) as efficient as possible. Harmonisation of the law on conflicting applications and patent office efficiency may be related:

i. How can the effects of altered or harmonised measures on any given patent office be minimised?

ii. Can improvements in the efficiency of patent processing render current issues regarding conflicting applications irrelevant?

For (i), the best solution is that harmonised measures must remain as simple as possible. Compromise solutions between the laws of different countries are highly unlikely to allow efficient processing of applications. In particular, measures that require multiple standards of novelty are undesirable, in particular if assessment of entitlement is needed to determine the applicable standard, due to different treatment of similar or related parties. This is a particular issue because of divergent national laws on ownership of inventions. A key benefit of any common harmonised standard would be that it might allow greater work sharing between patent offices in relation to co-pending applications, and this might compensate to some extent for inefficiencies resulting from change in practice.

For (ii), it is highly likely that in the near future there will be a large increase in the availability of technologies that can
AIPPI 2018 - Study Question - Conflicting patent applications

improve patent prosecution[7]. These include; machine assisted prior art search[8]; artificial intelligence processing of patent claims language; and improved technology in automatic translation [9], many of which are already in use in private practice[10].

a. Fairness

In some circumstances current arrangements could to procedural unfairness. For example, if a small US company files in the US, and a second company then files in the UK, and the US company is not in a financial position to file a PCT application. The US company is then unable to get a patent in the UK, but it is also prevented from working its invention there for the following 20 years.

This may feel unfair, but it is a result of the territoriality of intellectual property rights and the costs of funding a system for registering intellectual property rights. This issue is really economic or practical in nature and should be addressed by reducing fees, private arrangements for access to finance, and other commercial solutions. Changing the law on conflicting applications to deal with situations like this is not necessary. One currently available way of avoiding this issue is for applicants to self-publish their invention following their application, thereby keeping open the markets in which they have not filed.

a. Self-Publication

There are already practical actions patentees can do that are relevant to the study question:

When a patentee has filed an application for their invention, there is no reason they cannot publicly disclose their application the following day. The patentee then gains the ability to use their invention as prior art for both novelty and obviousness against any later filed application. In many cases this is not done due to uncertainty over the patent’s journey to grant; the inability to accrue damages until the application is published by the patent office; and the inability to commence infringement proceedings until grant.

Because patentees do not publish their inventions after filing their application, the public and more importantly the community working in the field of the invention lose the ability to carry out non-infringing acts of development in the period before publication of the application (for example, s.60(5)(b) of the Patents Act 1977 which allows otherwise infringing acts if they are for experimental purposes relating to the subject matter of the invention). This holds up the pace of development. Because of this earlier filed post-published applications should not be allowed in law to act as prior art for obviousness as this removes any incentive for a patentee to publish their invention after making their application.

a. Differences Between Industries

There are likely to be significant differences in preferences between industries due to differences in research and development practice, and the different type of inventions they want to protect. In the pharmaceutical industry for example there is a clear desire for the maximum protection to be available for new chemicals or uses thereof, and therefore there is a corresponding desire for prior art to operate on a global basis at a high novelty threshold (large distance to prior art). In contrast, due to the sometimes less clear or harder to define inventions in the telecommunications sector, for example, there may be less desire for the application of a global body of prior art or a high distance requirement in assessing novelty.

Therefore when considering whether withdrawn applications, non-designating international applications, or applications not available in a local language, the pharmaceutical sector might be more likely to support availability of these documents as prior art than the telecommunications sector. Any attempts at harmonisation should account for variation in the needs of the different sectors that depend on the global intellectual property system.

Policy Proposals

While unlikely to be an option regularly taken up by patentees, it should be possible for a Patentee to choose early publication of an application, so that their right to damages begins from that point (subject to existing law regarding the need for similarity between the application as published and the patent as granted).

In the same way as international applications only become secret prior art following national designation, it is sensible that European patent applications that do not designate the UK should not act as secret prior art in the UK. On that basis consideration could be given to amending s.2(3) and/or s.78(5) of the Patents Act 1977 to prevent recognition of EPs where the UK designation is removed before publication. Because published EP applications form a prior right in EPC Contracting states because of Articles 79(1) and 139(1) EPC, any proposed policy change of this type would likely require amendment of the EPC as well as the Patents Act 1977.
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

7.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

7.a.i. If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?
If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes. The same as that applied to publicly available prior art.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No.

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Yes. The same as that applied to publicly available prior art.

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

No.

If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

No.

If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

No.

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The answer to (1)(c)(i), above, is repeated here in its entirety.

For UK patent applications, only the following applications may be relied on as secret prior art:

- UK applications which have been published;
International applications for patents designating the UK, published by WIPO which have entered the UK national phase;

applications for European patents (UK) published by the EPO; and

International applications for European patents (UK) published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office). [1]

For EP patent applications, the following applications may be relied on as secret prior art:

applications for European patents published by the EPO and designating any EPC countries; and

International applications for European patents published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office).

To repeat the point made at 1(a), above: For an EP patent application, where the secret prior art is a national right, the secret prior art is relevant only for that designation. That is, where a national right of an earlier date exists in a contracting state designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the contracting state of the national right of earlier date. Second, for that state, he may file claims which are different from the claims for the other designated states. Third, the applicant can limit his existing set of claims so that the national right of earlier date is no longer relevant. [2]

[1] Commentary on Section 2, CIPA Guide to the Patents Acts


**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

No

Please Explain

**For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.**

**Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain

**If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?**

Entire contents
8.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes.

8.a.ii If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

Yes.

8.a.iii If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

8.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

8.b.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Please Explain

8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Please Explain

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Please Explain

8.b.iv If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Please Explain

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

Please Explain

8.c. If the secret prior art is an international application filed designating your jurisdiction:

Please Explain

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Please Explain
Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

Yes. The answer to (1)(c)(i), above, is repeated here in its entirety.

For UK patent applications, only the following applications may be relied on as secret prior art:

- UK applications which have been published;
- International applications for patents designating the UK, published by WIPO which have entered the UK national phase;
- applications for European patents (UK) published by the EPO; and
- International applications for European patents (UK) published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office).

For EP patent applications, the following applications may be relied on as secret prior art:

- applications for European patents published by the EPO and designating any EPC countries; and
- International applications for European patents published by WIPO which have entered the European regional phase (i.e. the relevant fee has been paid and if the application is in a language other than English, French or German a translation into one of these languages has been filed at the European Patent Office).

To repeat the point made at 1(a), above: For an EP patent application, where the secret prior art is a national right, the secret prior art is relevant only for that designation. That is, where a national right of an earlier date exists in a contracting state designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the contracting state of the national right of earlier date. Second, for that state, he may file claims which are different from the claims for the other designated states. Third, the applicant can limit his existing set of claims so that the national right of earlier date is no longer relevant.

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[1] Commentary on Section 2, CIPA Guide to the Patents Acts

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.
<table>
<thead>
<tr>
<th>Question</th>
<th>Description</th>
</tr>
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</table>
| 9.a      | Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:  
same as Question 8  
Please Explain |
| 9.b      | Same applicant on the dates of filing, no common inventor:  
same as Question 8  
Please Explain |
| 9.c      | Different applicants on the dates of filing, same inventors:  
same as Question 8  
Please Explain |
| 9.c.i    | Would the answers change if the different applicants were part of a joint industry or industry-university research project?  
No  
Please Explain |
| 9.c.ii   | Would the answers change if the different applicants were part of a joint industry or industry-university research project?  
No  
Please Explain |
| 9.d      | Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:  
same as Question 8  
Please Explain |
| 9.d.i    | Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?  
No  
Please Explain |
| 9.d.ii   | Would the answers change if the different applicants were part of a joint industry or industry-university research project?  
No  
Please Explain |
| 9.e      | Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:  
same as Question 8  
Please Explain |
9. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 8

Please Explain

10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

The key difficulty regarding the international harmonisation of the law on conflicting applications is the lack of information on the differences between application outcomes under the law of different states.

The 2012 Tegernsee Report suggested an empirical study on the effects of existing provisions on conflicting applications between the trilateral offices, in order to compare the impact of the different rules in practice. The report also suggested investigating the effect of the removal of the requirement for national phase entry, so that there would be a common international body of Secret Prior Art.

These two suggestions could be combined in a WIPO trial, with help from the trilateral offices, in order to provide a practical route forward in efforts to harmonise international law on conflicting applications, the main issue being uncertainty regarding the effect of importing the law of other jurisdictions.

The pilot program would involve the WIPO training artificial intelligence software on common families of applications assessed by the JPO, EPO and USPTO. This process would allow creation of a comparative database of the effects of the practice of the different offices, without interfering with practice at any national office. Objective measures of distance between applications could then be made, allowing patent practitioners to investigate the effects of any hypothetical adoption of harmonised practice in each jurisdiction.

Collected data could also then be used to assess the independent effects of the individual elements of the law on conflicting applications e.g. anti-self-collision; shared inventorship; inventive step assessment; and differences in standards of novelty. Comparison of relative standards of novelty should be done before determination of whether a harmonised standard should be based on regular or enlarged novelty.

11. Please indicate which industry sector views are included in your Group’s answers to Part III.

Pharmaceuticals / Life Sciences

Industry consultations suggest that industry would prefer a system in which, in all PCT member states, a PCT application was treated at least for novelty purposes as prior art as from its priority date, regardless of whether it subsequently entered any national phase.

While not adopting that proposal as its most preferred outcome, AIPPI UK believes that this is a workable proposal which would achieve a welcome degree of harmonization and certainty for all parties.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

The answers for this Section I focus on the current U.S. patent laws provided by the America Invents Act (AIA), which went into effect on September 16, 2012. However, given that some applications with effective filing dates before September 16,
2012 are still pending at the USPTO, brief answers are also given analysing the questions under the pre-AIA statutes where the answer may be different. Also, many if not most current patent litigations are based on patents that issued under the pre-AIA statutes. The earlier-filed patent application is available as prior art under 35 USC §102(a)(2), even though it had not yet published as of the filing date of the later-filed application (defined above as "secret prior art"). The earlier-filed application cannot be used as prior art unless and until it is made public through either publication or patenting (35 USC §102(a)(2), see also §122(a)-(b)); however, during the intervening period a patent examiner can raise a provisional rejection if there is a basis in the record that the identification and content of the earlier-filed application is known to the applicant of the later-filed application. One example of such a situation can occur when the applicant cited and provided a copy of the earlier filed application to the USPTO. In this instance, the examiner should be able to raise a provisional rejection based on the earlier filed application. Also notable is that a secret prior art reference cannot be cited as prior art, even though the applicant and inventors are unrelated, if it is shown that information contained in the reference was obtained or derived from an inventor of the later-filed application (35 USC §102(b)(2)(A), see also 35 USC §135 regarding derivation). Derivation proceedings are uncommon, and the USPTO instituted the very first such proceeding on March 21, 2018.

Pre-AIA: The earlier-filed patent application is available as prior art under pre-AIA 35 USC §102(e) once it has been published or issued as a patent.

1.a. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire reference is available as prior art unless there is an exemption under 35 USC §102(b)(2)(A) triggered by subject matter publicly disclosed before the prior art date by, for or from an inventor, in which case the exemption would apply to only that portion of the prior art that is effectively identical to the subject matter publicly disclosed.

1.a. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Yes, the same standard applies to secret prior art as to published prior art.

1.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

Yes

Please Explain

Yes. The earlier-filed patent application is available as prior art under 35 USC §103. Any reference that meets the definition of prior art under 35 USC §102 can be used to show obviousness under 35 USC §103.

Pre-AIA: The earlier-filed patent application is available as prior art under pre-AIA 35 USC §103(c).

1.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire reference is available as prior art unless there is an exemption under 35 USC §102(b)(2)(A) triggered by subject matter publicly disclosed before the prior art date by, for or from an inventor, in which case the exemption would apply to only that portion of the prior art that is effectively identical to the subject matter publicly disclosed.

1.b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is impossible in the scenario presented.
**AIPPI 2018 - Study Question - Conflicting patent applications**

Yes.

<table>
<thead>
<tr>
<th><strong>b.</strong> If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes, the same standard applies to secret prior art as to published prior art.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th><strong>c.</strong> If the secret prior art is an international application filed designating your jurisdiction:</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th><strong>c.i</strong> Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain

No. The same statutory provisions and standards apply to international applications designating the U.S.

Pre-AIA: The same pre-AIA statutory provisions and standards apply to international applications designating the U.S., provided that the international application was published in English.

<table>
<thead>
<tr>
<th><strong>c.ii</strong> Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain

<table>
<thead>
<tr>
<th><strong>c.iii</strong> Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain

<table>
<thead>
<tr>
<th><strong>2</strong> For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th><strong>2.a</strong> Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
</tr>
</tbody>
</table>

Please Explain

The earlier-filed application may not be relied upon as prior art if it has identical inventors and was not yet published as of the filing date of the later-filed application (i.e., the earlier-filed application does not “name another inventor” as required by 35 USC §102(a)(2)). Moreover, the earlier-application may be exempted as prior art against the later-filed application if the two applications...
were owned by the same person or subject to an obligation of assignment to the same person as of the effective filing date of the later-filed application (35 USC §102(b)(2)(C)). Thus, assuming that the applicant is the owner, this div provides additional grounds for exempting the earlier-filed application from being relied upon as prior art.

Pre-AIA: The same result is achieved under pre-AIA 35 USC §102(e), which does not classify the earlier-filed application as prior art because it has identical inventors (same inventive entity and thus not “of another”) with the later-filed application.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If YES, is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No. The inventors’ or owner’s earlier-filed application is not considered prior art. Under the current statutes, the same definition of prior art applies for both novelty and obviousness analysis (see Answer 2(a) above).

Pre-AIA: The same result is achieved under pre-AIA 35 USC §102(e), which excludes the earlier-filed application from being relied upon as prior art because it has identical inventors with the later-filed application, and also under 35 USC §103(c), which disallows rejections based on secret prior art references that were “commonly owned at the time the claimed invention was made.”

Yes.
U.S. patent law prohibits double patenting. Statutory double patenting under 35 USC §101 (also referred to as same invention-type double patenting) limits an applicant to obtaining a single patent for an invention. Nonstatutory-type double patenting (also referred to as obviousness-type double patenting) is a judicial doctrine applied to prevent the applicant from obtaining two patents with patentably indistinct claims—e.g., claims that are obvious variants of one another. Obviousness-type double patenting rejections can be overcome by filing a terminal disclaimer, which requires that the patents be maintained by a common owner and that both patents expire on the date of the earlier-expiring patent. While courts have recognized the doctrine of non-statutory double patenting under pre-AIA law, the language of the AIA may give rise in the future to challenges to this judicially created doctrine, at least where two applications are filed on the same day or have the same effective filing date.

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

No. The same statutory provisions and standards apply to international applications designating the U.S. Pre-AIA: The same pre-AIA statutory provisions and standards apply to international applications designating the U.S., provided that the international application was published in English.

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.

3. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2

Please Explain

The earlier-filed application may be exempted as prior art provided that the applicant is the “owner” of
both applications, or both applications are otherwise owned by, or subject to an obligation of assignment to, the same person (35 USC §102(b)(2)(C)). Additionally, even if common ownership does not exist, the earlier-filed application may be exempted as prior art to the later-filed application as to subject matter obtained directly or indirectly from the common inventor (35 USC §102(b)(2)(A)) or if there is an exemption under 35 USC §102(b)(2)(B) triggered by subject matter that was publicly disclosed before the prior art date by, for or from an inventor.

Pre-AIA: The answer is different under the pre-AIA statutes. While secret prior art that was “commonly owned at the time the claimed invention was made” cannot not be relied upon as prior art for obviousness purposes (pre-AIA 35 USC §103(c)), the earlier-filed reference can still be used to refute novelty, since the two applications do not have identical inventorship (pre-AIA 35 USC §102(e)).

3.b

Same applicant on the dates of filing, no common inventor:

same as Question 2

Please Explain

The earlier-filed application may be exempted as prior art provided that the applicant is the “owner” of both applications, or both applications are otherwise owned by, or subject to an obligation of assignment to, the same person. Additionally, even if common ownership does not exist, the earlier-filed application may be exempted as prior art to the later-filed application as to subject matter obtained directly or indirectly from the common inventor (35 USC §102(b)(2)(A)) or if there is an exemption under 35 USC §102(b)(2)(B) triggered by subject matter that was publicly disclosed before the prior art date by, for or from an inventor.

Pre-AIA: The answer is different under the pre-AIA statutes. While secret prior art that was “commonly owned at the time the claimed invention was made” may not be relied upon for obviousness purposes (pre-AIA 35 USC §103(c)), the earlier-filed reference can still be used to refute novelty, since the two applications do not have identical inventorship (pre-AIA 35 USC §102(e)).

3.c

Different applicants on the dates of filing, same inventors:

same as Question 2

Please Explain

The earlier-filed application may not be relied upon as prior art because it has identical inventors with the later-filed application (i.e., the earlier-filed application does not “name another inventor” as required by 35 USC §102(a)(2)). The earlier-filed application also may be exempted as prior art to the later-filed application as to subject matter obtained directly or indirectly from the common inventor (35 USC §102(b)(2)(A)) or if there is an exemption under 35 USC §102(b)(2)(B) triggered by subject matter that was publicly disclosed before the prior art date by, for or from an inventor.

Pre-AIA: The same result is achieved under pre-AIA 35 USC §102(e).

3.c.i

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

The inventors’ earlier-filed application may not be relied upon as prior art. But, the existence of a joint research agreement would provide another ground for exempting the earlier application from being relied upon as prior art.
3. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

Please Explain

The earlier application may be exempted as prior art under 35 USC §102(b)(2)(A) for subject matter obtained directly or indirectly from the common inventor. However, the earlier application may be relied upon as prior art based on subject matter that was the contribution of an additional inventor not named on the later-filed application (unless the applications are exempted because they were both owned by, or subject to an obligation to assign to, the same person as of the effective filing date, or the two different applicants were parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention (35 USC §§102(b)(2)(C) and 102(c))).

Pre-AIA: The earlier application may be relied upon as prior art under pre-AIA 35 USC §§102(e) and 103(c).

3.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

Yes

Please Explain

Yes. The earlier application could be exempted as prior art based on common ownership on or before the effective filing date of the claimed invention (35 USC §§102(b)(2)(C)).

Pre-AIA: Yes. The earlier application could not be relied upon as prior art for obviousness purposes based on common ownership (pre-AIA 35 USC §103(c)) but could be relied upon for novelty purposes (pre-AIA 35 USC §102(e)).

3.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

Yes

Please Explain

Yes. The earlier application could be exempted as prior art to the later-filed application if the two applicants were both parties to a joint research agreement (JRA), as long as the claimed invention resulted from activities within the scope of the JRA and the JRA was in effect on or before the effective filing date of the claimed invention (35 USC §§102(b)(2)(C) and 102(c)).

Pre-AIA: Yes. The earlier application could not be relied upon as prior art for obviousness purposes based on the JRA (pre-AIA 35 USC §103(c)(2)) but could be cited for novelty purposes (pre-AIA 35 USC §102(e)).

II. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

4.a. The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No
**AIPPI 2018 - Study Question - Conflicting patent applications**

<table>
<thead>
<tr>
<th>4. <strong>a</strong></th>
<th>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
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<tr>
<th>4. <strong>b</strong></th>
<th>The treatment of international applications as secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
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</table>

<table>
<thead>
<tr>
<th>4. <strong>c</strong></th>
<th>The treatment of total and partial identity of applicants as it relates to secret prior art.</th>
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</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
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</tbody>
</table>

<table>
<thead>
<tr>
<th>4. <strong>d</strong></th>
<th>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
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</table>

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<thead>
<tr>
<th>4. <strong>e</strong></th>
<th>Provisions for avoiding self-collision.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
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</table>

<table>
<thead>
<tr>
<th>4. <strong>f</strong></th>
<th>Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
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</table>

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<tr>
<th>5</th>
<th>Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td></td>
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</tbody>
</table>

| 538 |
The only potential proposal for improvement to our Group’s current law would be with respect to whether the secret prior art should be combinable with another prior art reference to show lack of inventive step / obviousness. We would consider a possible improvement to be continuing to allow this practice, but only if those references are cited prior art contained in the published application or patent. Under this proposal, the secret prior art should not otherwise be combinable with other prior art references to show lack of inventive step / obviousness.

### III. Proposals for harmonisation

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

   *If YES, please respond to the following questions without regard to your Group’s current law or practice.*

   *Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

   **Yes**

   If YES, please respond to the following questions without regard to your Group’s current law or practice.

7. **For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.**

7.a. **Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

   **Yes**

   *Please Explain*

   **If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

   The entire content of the prior art should be available.

   **If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?**

   It should be the same as the standard applied to publicly available prior art.

7.b. **Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?**

   **Yes**

   *Please Explain*
7.b. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire content of the prior art should be available.

7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

Yes, but only if those references are cited in the published application or patent. The secret prior art should not otherwise be combinable with other prior art references to show lack of inventive step / obviousness.

7.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Yes.

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c.i. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

7.c.ii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

7.c.iii. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

8. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.
### AIPPI 2018 - Study Question - Conflicting patent applications

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td>If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</td>
<td></td>
<td></td>
</tr>
<tr>
<td>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</td>
<td>Yes</td>
<td>To avoid double patenting, (1) the secret prior art and later-filed application should be commonly owned at the time of filing or there should be an obligation to assign both applications to the same assignee at the time of filing, and (2) if the claims in the later-filed application are not novel and inventive / non-obvious in view of the</td>
</tr>
</tbody>
</table>
If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 8

Same applicant on the dates of filing, no common inventor:

same as Question 8
<table>
<thead>
<tr>
<th>Question</th>
<th>Description</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>9.c</td>
<td>Different applicants on the dates of filing, same inventors:</td>
<td>same as Question 7</td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td>Please Explain</td>
<td></td>
</tr>
<tr>
<td>9.c.i</td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>Yes</td>
<td>In this case, the response would be the same as Question 8.</td>
</tr>
<tr>
<td>9.d</td>
<td>Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:</td>
<td>same as Question 7</td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td>Please Explain</td>
<td></td>
</tr>
<tr>
<td>9.d.i</td>
<td>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</td>
<td>Yes</td>
<td>In this case, the response would be treated the same as Question 8.</td>
</tr>
<tr>
<td>9.d.ii</td>
<td>Would the answers change if the different applicants were part of a joint industry or industry-university research project?</td>
<td>Yes</td>
<td>In this case, the response would be treated the same as Question 8.</td>
</tr>
<tr>
<td>9.e</td>
<td>Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:</td>
<td>same as Question 8</td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td>Please Explain</td>
<td></td>
</tr>
<tr>
<td>9.f</td>
<td>Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:</td>
<td>same as Question 8</td>
<td></td>
</tr>
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<td></td>
<td></td>
<td>Please Explain</td>
<td></td>
</tr>
</tbody>
</table>
Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

None.

Please indicate which industry sector views are included in your Group’s answers to Part III.

Our answers are based on an overall view of applicants.
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

1.a. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

Although the Venezuelan Industrial Property is not specific in this regard; Examination is carry out by using the guidelines of the Andean.
Community patent examination.

1.a. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art is available

1.a. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is the same as applies to publicly available prior art.

1.b. Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Although the Venezuelan Industrial Property is not specific in this regard; Examination is carried out by using the guidelines of the Andean Community patent examination.

1.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

N/A

1.b. If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

N/A

1.b. If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

N/A

1.c. If the secret prior art is an international application filed designating your jurisdiction:

1.c. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

546
No
Please Explain
Venezuela is not member of the PCT agreement.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No
Please Explain
Venezuela is not member of the PCT agreement.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No
Please Explain
Venezuela is not member of the PCT agreement.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes
Please Explain
Although the Venezuelan Industrial Property is not specific in this regard; Examination is carried out by using the guidelines of the Andean Community patent examination.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art is available.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty is the same as applies to publicly available prior art.
If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There is not anti-self-collision time period.

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Although the Venezuelan Industrial Property is not specific in this regard; Examination is carried out by using the guidelines of the Andean Community patent examination.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

N/A

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

N/A

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

N/A

If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No
Venezuela is not a member of the PCT agreement.

**Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

**Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

**Question 1** considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. **Question 2** considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under **Question 1**, or those under **Question 2**. If your answers are different from your answers to both **Question 1** and **Question 2**, please explain.

**3.a** Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as **Question 1**

Please Explain

**3.b** Same applicant on the dates of filing, no common inventor:

same as **Question 1**

Please Explain

**3.c** Different applicants on the dates of filing, same inventors:

same as **Question 1**

Please Explain

**3.d** Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as **Question 1**

Please Explain

Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

**Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

same as **Question 1**

Please Explain
### II. Policy considerations and proposals for improvements of your current law

<table>
<thead>
<tr>
<th>4</th>
<th>Could any of the following aspects of your Group’s current law be improved? If YES, please explain.</th>
</tr>
</thead>
<tbody>
<tr>
<td>4.a</td>
<td>The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.b</td>
<td>The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
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<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.c</td>
<td>The treatment of international applications as secret prior art.</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.d</td>
<td>The treatment of total and partial identity of applicants as it relates to secret prior art.</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>4.e</td>
<td>The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</td>
</tr>
<tr>
<td>Yes</td>
<td>Please Explain</td>
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</tbody>
</table>
### III. Proposals for harmonisation

**Please consult with relevant in-house / industry members of your Group in responding to Part III.**


<table>
<thead>
<tr>
<th>Yes</th>
<th>Please Explain</th>
</tr>
</thead>
</table>

#### 4.6 Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.

<table>
<thead>
<tr>
<th>Yes</th>
<th>Please Explain</th>
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</thead>
</table>

#### 5. Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

<table>
<thead>
<tr>
<th>No</th>
<th>Please Explain</th>
</tr>
</thead>
</table>

#### III. Proposals for harmonisation

---

**Please consult with relevant in-house / industry members of your Group in responding to Part III.**

#### 6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group’s current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

<table>
<thead>
<tr>
<th>Yes</th>
<th>If YES, please respond to the following questions without regard to your Group</th>
</tr>
</thead>
</table>

#### 7. For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

**Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**

<table>
<thead>
<tr>
<th>Yes</th>
<th>Please Explain</th>
</tr>
</thead>
</table>

**If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?**

*The entire contents of the secret prior art should be available.*
7.a. If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as the standard applies to publicly available prior art.

7.b. Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

7.b.i. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

N/A

7.b.ii. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

N/A

7.b.iii. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

N/A

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c.i. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Venezuela is not a member of the PCT.

7.c.ii. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain
Venezuela is not a member of the PCT.

Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Venezuela is not a member of the PCT.

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art should be available.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art.

If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

There should not be an anti-self collision time period.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain
<table>
<thead>
<tr>
<th>8.b.i</th>
<th>If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?</th>
</tr>
</thead>
<tbody>
<tr>
<td>N/A</td>
<td></td>
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<table>
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<tr>
<th>8.b.ii</th>
<th>If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?</th>
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<td>N/A</td>
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</table>

<table>
<thead>
<tr>
<th>8.b.iii</th>
<th>If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?</th>
</tr>
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<tbody>
<tr>
<td>N/A</td>
<td></td>
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</table>

<table>
<thead>
<tr>
<th>8.b.iv</th>
<th>If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?</th>
</tr>
</thead>
<tbody>
<tr>
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<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8.b.v</th>
<th>If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>N/A</td>
<td></td>
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</tbody>
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<table>
<thead>
<tr>
<th>8.c</th>
<th>If the secret prior art is an international application filed designating your jurisdiction:</th>
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</thead>
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<tr>
<td>8.c.i</td>
<td>Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.</td>
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<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>N/A</td>
<td></td>
</tr>
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Venezuela is not a member of the PCT.
8.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

Venezuela is not a member of the PCT.

8.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

Venezuela is not a member of the PCT.

9. Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 7

Please Explain

9.b Same applicant on the dates of filing, no common inventor:

same as Question 8

Please Explain

9.c Different applicants on the dates of filing, same inventors:

same as Question 7

Please Explain

9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain
9.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

`same as Question 7`

**Please Explain**

<table>
<thead>
<tr>
<th>9.d.</th>
<th>Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?</th>
</tr>
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<tr>
<td>No</td>
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<td><strong>Please Explain</strong></td>
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<td>No</td>
<td></td>
</tr>
<tr>
<td><strong>Please Explain</strong></td>
<td></td>
</tr>
</tbody>
</table>

9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

`same as Question 7`

**Please Explain**

<table>
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<tr>
<th>9.e.</th>
<th>Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:</th>
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</tr>
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<td><strong>Please Explain</strong></td>
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</tr>
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</table>

9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

`same as Question 7`

**Please Explain**

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<th>Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:</th>
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<td></td>
</tr>
<tr>
<td><strong>Please Explain</strong></td>
<td></td>
</tr>
</tbody>
</table>

10. **Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.**

No comment

11. **Please indicate which industry sector views are included in your Group’s answers to Part III.**

*All industry sectors are included.*
For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group’s current law and practice.

1. Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

Under the Vietnam IP Law and Regulations, the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes.
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defeating purposes. In practice, the secret prior art is used in the consideration of “first-to-file” principle only.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Similar to the above, under the Vietnam IP Law and Regulations, the secret prior art is not available against the claims of the later-filed application to show lack of inventive step/obviousness.

If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * * The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination is possible in the scenario presented.

If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain
1.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

As said above, under the Vietnam IP Law and Regulations, the secret prior art is not available against the claims of the later-filed application for both novelty and inventive step defeating purposes. So, there is no concept of secret prior art in the process of examination as to novelty and inventive step for the Vietnam applications.

However, for the purposes of considering the “first to file” principle, of course, the date from which the international application is available as secret prior art depends on the date of national phase entry in Vietnam.

2 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

2.a Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

Under the Vietnam IP Law and Regulations, the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes, regardless of whether the applicants/inventors are the same or unrelated.

2.a.ii If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

2.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Similar to the above, under the Vietnam IP Law and Regulations, the secret prior art is not available against the claims of the later-filed application to show lack of inventive step, regardless of whether the applicants/inventors are the same or unrelated.

2.b.ii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.c Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

Similar to the above, under the Vietnam IP Law and Regulations, the secret prior art is not available against the claims of the later-filed application to show lack of inventive step, regardless of whether the applicants/inventors are the same or unrelated.

2.c ii If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?
2.b.ii If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

2.b.ii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

2.b.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

2.b.iv If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

2.c.iii Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

As said above, under the Vietnam IP Law and Regulations, the secret prior art is not available against the claims of the later-filed application for both novelty and inventive step defeating purposes. So, there is no concept of secret prior art in the process of examination as to novelty and inventive step for the Vietnam applications.

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3 Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.
III. Policy considerations and proposals for improvements of your current law

4. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.

3.a. Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 2
Please Explain

3.b. Same applicant on the dates of filing, no common inventor:

same as Question 2
Please Explain

3.c. Different applicants on the dates of filing, same inventors:

same as Question 1
Please Explain

3.c.i. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No
Please Explain

3.d. Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

same as Question 1
Please Explain

3.d.i. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No
Please Explain

3.d.ii. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No
Please Explain
<table>
<thead>
<tr>
<th>Study Question</th>
<th>Answer</th>
<th>Please Explain</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>4.a</strong> The definition of when secret prior art is applicable to defeat patentability of a later-filed application.</td>
<td>Yes</td>
<td></td>
</tr>
<tr>
<td><strong>4.b</strong> The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.</td>
<td>Yes</td>
<td></td>
</tr>
<tr>
<td><strong>4.c</strong> The treatment of international applications as secret prior art.</td>
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<td></td>
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<tr>
<td><strong>4.d</strong> The treatment of total and partial identity of applicants as it relates to secret prior art.</td>
<td>No</td>
<td></td>
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<tr>
<td><strong>4.e</strong> The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td><strong>4.f</strong> Provisions for avoiding self-collision.</td>
<td>No</td>
<td></td>
</tr>
<tr>
<td><strong>4.g</strong> Provisions for limiting an applicant’s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant’s earlier-filed application.</td>
<td>No</td>
<td></td>
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</table>
Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

No

Please Explain

---

**III. Proposals for harmonisation**

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*

---

**6**

Does your Group consider that harmonisation in any or all areas in Section II desirable?

*If YES, please respond to the following questions without regard to your Group's current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.*

Yes

If YES, please respond to the following questions without regard to your Group

---

**7**

For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.

---

**7.a**

Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

No

Please Explain

---

If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

---

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

---

If YES, should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

---

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?
7.b. If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

7.b. If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

7.c. If the secret prior art is an international application filed designating your jurisdiction:

7.c. Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

No

Please Explain

7.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

7.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

8 For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

8.a. Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?

Yes

Please Explain

8.a. If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

The entire contents of the secret prior art should be available.
8.a If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

This should be the same as the standard applied to publicly available prior art.

8.a If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No.

8.b Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

8.b.i If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?

8.b.ii If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

8.b.iii If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

8.b.iv If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

No

Please Explain

8.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

No

8.c If the secret prior art is an international application filed designating your jurisdiction:

8.c.i Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

No
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Please Explain

8.c. Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

No

Please Explain

8.c. Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

No

Please Explain

9. Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.

9.a Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 8

Please Explain

9.b Same applicant on the dates of filing, no common inventor: same as Question 8

Please Explain

9.c Different applicants on the dates of filing, same inventors: same as Question 7

Please Explain

9.c.i Would the answers change if the different applicants were part of a joint industry or industry-university research project? No

Please Explain

9.d Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application: same as Question 7

Please Explain
### 9.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

### 9.d. Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

### 9.e. Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

same as Question 7

Please Explain

### 9.f. Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

same as Question 7

Please Explain

### 10. Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

We have no further comments.

### 11. Please indicate which industry sector views are included in your Group’s answers to Part III.

Our answers to Part III are stated without referring to any specific industry sector.
Summary Report

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2018 – Study Question – Patents

Conflicting patent applications

Introduction

This Study Question concerns patent applications that conflict with earlier-filed but not yet published patent applications by the same or a different applicant (conflicting applications). A first patent application that is filed prior to a second patent application falls within a standard definition of publicly available prior art if it is published prior to the effective filing date of the second patent application. In most jurisdictions, patent applications are published at 18 months from filing or the earliest priority date, meaning that there is an 18-month window during which conflicting applications may arise. If the second patent application is filed within that 18-month window, the examining patent office must determine if and to what extent the first patent application may preclude patentability of the claims in the second patent application. The first patent application in this situation will be referred to herein as secret prior art.

Self-collision refers to the situation where secret prior art “collides” with a later-filed application by the same (or partially the same) applicant. Anti-self collision refers generally to rules that act to prevent self-collision.

AIPPI has three prior Resolutions that relate to conflicting applications.

- In the Resolution on Q89C - “Self-collision” (Sydney, 1988), in consideration of the draft WIPO treaty on harmonization of patent law, AIPPI resolved in favour of excluding self-collision in cases of at least partial identity of the applicants (Resolution Q89C).

- In the Resolution on Q126 - "Methods and principles of novelty evaluation in patent law" (Montreal, 1995), AIPPI resolved that secret prior art should be available for novelty purposes under the same standard as applied to
published disclosures, but also confirmed Resolution Q89C that anti-self collision should apply in the case of total or partial identity between the applicants at the time of filing.

- In the Resolution on Q167 – “Current standards for prior art disclosure in assessing novelty and inventive step requirements” (Lisbon, 2002), AIPPI resolved that secret prior art should be available for novelty only, and not for inventive step.

Due to different approaches to treatment of conflicting applications in different jurisdictions, it is a common occurrence that a claim considered patentable in one jurisdiction is unpatentable in another. This leads to situations where multiple patents may be amassed in one country while adequate protection cannot be obtained in another. Multinational inventorship, joint industry and university-industry research collaborations, and globalization in general all further complicate this situation.

Some of the key issues arising in relation to conflicting applications are:

a) If the secret prior art is to be considered applicable as prior art to the later-filed application, what patentability standard should be applied? Is it sufficient if the claims of the later-filed application are novel over the secret prior art, or must they distinguish based on an inventive step or non-obviousness standard? This concept will be referred to herein as distance, where a small distance means that a claim of the later-filed application is only slightly different from the secret prior art and a larger distance indicates more differences between the claim of the later-filed application and the secret prior art. In the case of identical claims in the earlier and later applications (zero distance), the claims may be rejected for “double patenting.” However, where there is at least some distance between the earlier and later claims, a standard is needed to determine when both may be patented.

b) Should all secret prior art be treated equally? Or, should the patentability standard discussed in (a) above be different depending on whether the applicant of the later-filed application is the same as the applicant of the secret prior art?

c) If an earlier application is used as prior art against a later application by the same applicant, and if there is at least some distance between the claims of the earlier and later applications, should the applicant’s right to obtain claims on incremental inventions be limited by a mechanism such as a “terminal disclaimer” that would require the applications to remain commonly owned and expire on the same date?

d) What portion of the secret prior art is available as prior art? The entire disclosure (i.e., whole contents), or only the claims?
e) If the secret prior art is not available against the same applicant (anti-self collision), for what period of time should that be effective (e.g., 12 or 18 months)?

f) If anti-self collision is applied, should there be additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

g) What constitutes the “same applicant”? Can different applicants participating in a joint research project or other mutual research collaboration be considered the “same applicant”? Does it matter if the inventors are different but the applicants are the same, or vice-versa?

h) Should secret prior art filed as an international application under the PCT be prior art as of its effective filing date for all designated offices, or only offices where the application enters national stage?

The Reporter General has received Reports from the following Groups and Independent Members in alphabetical order: Argentina, Australia, Austria, Belarus, Belgium, Brazil, Bulgaria, Canada, Caribbean Regional Group, China, Denmark, Ecuador, Estonia, Finland, France, Germany, Hungary, Italy, Japan, Malaysia, Mexico, the Netherlands, New Zealand, Norway, Pakistan, Panama, Paraguay, the Philippines, Poland, Portugal, the Republic of Korea, the Russian Federation, Singapore, Spain, Sweden, Switzerland, Taiwan (Independent Members), Thailand, Turkey, the United Kingdom (UK), the United States of America (U.S.), Uruguay, Venezuela, and Vietnam.

44 Reports were received in total. The Reporter General thanks the Groups and Independent Members for their helpful and informative Reports. All Reports may be accessed here: http://aippi.org/committee-publications/?committee-id=54299

The Reports provide a comprehensive overview of national and regional laws and policies relating to conflicting applications set out in three parts:

- Part I – Current law and practice
- Part II – Policy considerations and proposals for improvement of the current state of the law
- Part III – Proposals for harmonisation.

This Summary Report does not summarise Part I of the Reports received. Part I of any Report is the definitive source for an accurate description of the current state of the law in the jurisdiction in question.

This Summary Report has been prepared on the basis of a detailed review of all Reports (including Part I) but focuses on Parts II and III, given AIPPI’s objective of proposing improvements to, and promoting the harmonisation of, existing laws. As it
is a summary, if any question arises as to the exact position of a particular Group in relation to Parts II or III, please refer to the relevant Report directly.

In this Summary Report:

- references to Reports of or responses by one or more "Groups" may include references to Independent Members;
- where percentages of responses are given, they are to the nearest 5%; and
- in Part IV below, some conclusions have been drawn in order to provide guidance to the Study Committee for this Question.

I. Current law and practice

For the replies to Questions 1) - 3) set out in the Study Guidelines for this Study Question, reference is made to the full Reports. The Study Guidelines may be accessed here:


II. Policy considerations and proposals for improvement of your current law

4) Could any of the following aspects of your Group's current law be improved? If YES, please explain.

a) The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

55% of answering Groups responded NO to this question, indicating they do not believe improvement is needed to their current standard for applicability of secret prior art. Of the groups that answered YES to this question, areas where improvement might be sought include:

- An adjustment of the current timescale based on “days” because this scale may not be adequate to meet current needs (for example, multiple electronic filings within a 24 hour period);
- Provisions relating to secret prior art are needed in jurisdictions where they do not currently exist;
- Clarification with regard to treatment of PCT applications in general, and specifically with regard to the effective date of PCT applications as secret prior art;
– Removal of requirements for applicability of secret prior art tied to publication in a particular language;
– Consideration of proper handling of withdrawn or unpublished applications;
– Removal of requirements that the relevant information in the secret prior art must be in a claim;
– Clarification of the laws in common-applicant situations; and
– Ensuring secret prior art is available as of publication, not grant.

b) **The patentability standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.**

70% of answering Groups responded NO to this question, indicating they do not believe improvement is needed to their current standard for patentability over secret prior art. Of the groups that answered YES to this question, areas where improvement might be sought include:

– Using the same novelty standard for secret prior art as for published prior art;
– Increasing the “distance” requirement by using enlarged novelty, a novelty plus common general knowledge standard or a lowered obviousness standard;
– Improving clarity in partial-identity of applicant situations;
– Reducing the “distance” in same-applicant situation, and/or using terminal disclaimers; and
– Making secret prior art available for novelty only, not inventive step.

c) **The treatment of international applications as secret prior art.**

70% of answering Groups responded NO to this question, indicating they do not believe improvement is needed to their current standard for treatment of international applications as secret prior art. Of the groups that answered YES to this question, areas where improvement might be sought include:

– Ensuring the effective date of an international application (upon publication) as prior art is the priority date, regardless of the country of filing of the priority application;
- Removing the requirement for entry of national stage in a jurisdiction, provided that jurisdiction was designated in the international application; or
- Conversely, clarifying that an international application must enter the national stage to be considered secret prior art in that jurisdiction.

d) The treatment of total and partial identity of applicants as it relates to secret prior art.

75% of answering Groups responded NO to this question, indicating they do not believe improvement is needed to their current standard for treatment of total and partial identity of applicants as it relates to secret prior art. Of the groups that answered YES to this question, areas where improvement might be sought include:

- Introducing terminal disclaimers;
- Excluding secret prior art in cases of total and partial identity of applicants; and
- General clarification of interconnected applicant situations, including:
  - Joint industry and industry-research collaboration situations;
  - Common co-applicant and change of applicant name situations; and
  - Common co-applicant but different inventorship situations.

e) The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

80% of answering Groups responded NO to this question, indicating they do not believe improvement is needed to their current standard for treatment of inventive entities. Of the groups that answered YES to this question, areas where improvement might be sought include:

- Adding consideration of same inventive entity in the case where law currently addresses only same applicant situation.

f) Provisions for avoiding self-collision.

70% of answering Groups responded NO to this question, indicating they do not believe improvement is needed to their current provisions for avoiding self-collision. Of the groups that answered YES to this question, areas where improvement might be sought include:

- Considering inventive entities as well as applicants;
– Introducing an exception for applicant’s own patent application;

– Adding provisions to promote collaboration in joint industry and industry-university research situations;

– Granting every applicant the right to use undisclosed disclaimers against secret prior art; and

– Introducing a terminal disclaimer practice.

g) Provisions for limiting an Applicant's right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same Applicant’s earlier-filed application.

85% of answering Groups responded NO to this question, indicating they do not believe improvement is needed to their current standard for treatment of claims to incremental inventions. Of the groups that answered YES to this question, areas where improvement might be sought include:

– Implementation of anti-self collision where none currently exists; and

– Including provisions to ensure against abuse of anti-self collision rules.

5) Are there any other policy considerations and/or proposals for improvement to your Group’s current law falling within the scope of this Study Question?

70% of answering Groups responded NO to this question. Of the groups that answered YES to this question, other policy considerations and proposals include:

– The Danish Group suggests considering the same day versus day before requirement in light of technological advancements including electronic filing and the internet;

– The Italian Group suggests consideration of the “whole content” versus “prior claim” approach in the definition of secret prior art;

– The Chinese Group suggests considering whether secret prior art is limited to the examination phase, or whether it can be used as a prior art defense in patent infringement proceedings;

– The U.S. Group indicates that secret prior art should be combinable with other references for inventive step / non-obviousness, but suggests this ability might be limited only to cited prior art contained in the published application or patent;
The UK Group raises a number of issues for consideration:

- Patent thickets: caution is needed in setting policy based upon the notion of “patent thickets” given that there are different opinions as to the actual problems these may or may not create. Any policy setting should thus be evidence-based not based on mere perceptions.

- Double patenting: the UK Group notes that prevention of double patenting must be balanced with efficient operation of patent offices, which may prevent use of more complex systems than those currently in place. In addition, it is necessary consider proper application of the law of novelty as this may be responsible for any lack of distance between application, rather than the law on conflicting applications.

- Uncertainty and differences in patentability: the UK Group notes that the positive value of harmonisation must be weighed against uncertainty and implementation costs at the local level in the short term.

- Prosecution efficiency: noting that harmonised measures should be as simple as possible and ideally should act to facilitate work-sharing.

- Fairness: the territorial reality of the patent system should be balanced against economic practicalities.

- Self-publication: consideration should be given to the patentee’s ability to self-publish after filing an application, thus creating their own prior art against third parties for both novelty and inventive step.

- Differences between industries: the needs of different industry sectors should be taken into account in a balanced international system.

### III. Proposals for harmonisation

6) **Does your Group consider that harmonisation in any or all areas in Section II desirable?**

85% of answering Groups responded that harmonisation in this area is desirable.

7) **For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.**

   a) **Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?**
95% of answering Groups responded YES the secret prior art should be available for novelty purposes. The Finnish and Dutch Groups note that no distinction should be made regarding applicant(s) and inventor(s) while the Singaporean Group suggests it should be available where the applicants/inventors are unrelated to avoid conflicts in the marketplace.

i) If yes, should the entire contents of the secret prior art be available, or only a portion such as the claims?

90% of answering Groups believe the entire contents should be available. Three Groups (Belgium, Portugal, Hungary) believe the entire contents except for the Abstract (and in the case of Belgium the title) should be available. The Groups of Belarus and Paraguay believe only the claims should be available.

ii) If yes, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

90% of answering Groups believe the standard should be the same as the standard applied to publicly available prior art. The Groups of Spain and Ecuador believe the standard should be higher, such as enhanced novelty. The Japanese Group notes that the answer to this question would depend on whether the novelty standard applied to publicly available prior art is sufficient, i.e., is broader than photographic novelty.

b) Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

85% of answering Groups believe the secret prior art should not be available to show lack of inventive step / obviousness. The Caribbean Regional Group and the Groups from the US, Ecuador, Panama, Paraguay, and Pakistan responded that the secret prior art should be available for inventive step / non-obviousness.

i) If yes, should the entire contents of the secret prior art be available, or only a portion such as the claims?

Four of the five responding Groups believe the entire contents should be available. The Group from Paraguay believes only the claims should be available.

ii) If yes, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?
Four of the five responding Groups answered this question in the affirmative. The U.S. Group qualified its answer by noting that it should be combinable only with prior art cited in the published application or patent.

iii) If yes, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

Four of the five responding Groups believe the standard should be the same. The Group from Ecuador believes the standard applied to prior art should be higher than that applied to publicly available prior art.

c) If the secret prior art is an international application filed designating your jurisdiction:

i) Does this change any of your answers to questions 7(a) and 7(b) above? If yes, please explain.

85% of answering Groups answered NO to this question. The Spanish and Japanese Groups indicate that the language of publication should also be a factor.

ii) Does it matter whether the international application actually enters the national phase in your jurisdiction? If yes, please explain.

65% of answering Groups believe that actual entry into the national phase does matter. Generally, these Groups believe secret prior art should enter the prior art only in jurisdictions where the national phase has been entered and the application has been published. The Groups that believe entry into the national phase does not matter consider that secret prior art should enter the prior art globally once published, regardless of national phase entry and of where the publication occurred.

iii) Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

85% of answering Groups answered NO to this question.

8) For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.

a) Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?
75% of answering Groups answered YES to this question.

i) If yes, should the entire contents of the secret prior art available, or only a portion such as the claims?

85% of answering Groups indicate the entire contents should be available. Three Groups believe the entire contents excluding the Abstract should be available. One Group believes only the claims should be available.

ii) If yes, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

95% of answering Groups believe the standard should be the same as that applied to publicly available prior art. Two Groups believe the standard should be an enhanced novelty standard.

iii) If yes, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

75% of answering Groups believe there should be no anti-self collision time period. Of the Groups that support anti-self collision, four Groups suggest 12 months, one Group suggests at least 12 months, one Group suggests 6 months, and one Group suggests 2 months.

b) Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

85% of the Groups answered NO to this question, indicating they believe the secret prior art should not be available to show lack of inventive step / obviousness.

i) If yes, should the entire contents of the secret prior art be available, or only a portion such as the claims?

All answering Groups responded that the entire contents should be available.

ii) If yes, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?
All answering Groups responded that the secret prior art should be combinable with another prior art reference.

iii) If yes, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

All but one Group replied that the standard should be the same. One group replied that the standard should be higher for secret prior art relative to publicly available prior art.

iv) If yes, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

Of the relatively few Groups that answered this question, 55% believe there should not be any anti-self collision time period. Of the Groups that support anti-self collision in this situation, suggested time periods are 6 months, 12 months, and at least 12 months.

v) If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

40% of answering Groups believe additional measures such as a terminal disclaimer or requirement to litigate all patents together would be appropriate. The majority of Groups (60%) believe that such additional measure are not necessary.

c) If the secret prior art is an international application filed designating your jurisdiction:

i) Does this change any of your answers to questions 8(a) and 8(b) above? If yes, please explain.

95% of the Groups answered this question in the negative.

ii) Does it matter whether the international application actually enters the national phase in your jurisdiction? If yes, please explain.
55% of the Groups indicate that actual entry into the national phase matters in this situation. The explanations track those of Question 7(c)(ii) above.

iii) Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?

90% of Groups answered NO to this question.

9) Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether the answers should be the same as those under Question 7, or those under Question 8. If your proposals would be different from your answers to both Question 7 and Question 8, please explain.

a) Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

☐ same as Question 7
  • 22 Groups selected this option

☐ same as Question 8
  • 18 Groups selected this option

☐ different (please explain)
  • 1 Group selected this option.

The Brazilian, Chinese and German Groups noted that their answer would be the same for both Question 7 and Question 8.

b) Same applicant on the dates of filing, no common inventor:

☐ same as Question 7
  • 22 Groups selected this option

☐ same as Question 8
  • 18 Groups selected this option

☐ different (please explain)
  • 1 Group selected this option.
The Brazilian, Chinese and German Groups noted that their answer would be the same for both Question 7 and Question 8.

c) Different applicants on the dates of filing, same inventors:

- same as Question 7
  - 32 Groups selected this option

- same as Question 8
  - 8 Groups selected this option

- different (please explain)
  - 1 Group selected this option.

The Brazilian, Chinese and German Groups noted that their answer would be the same for both Question 7 and Question 8.

i) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

More than 90% of the Groups indicate that this would make no difference to their answers. The U.S. Group notes that this would change their answer to that of Question 8.

d) Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:

- same as Question 7
  - 35 Groups selected this option

- same as Question 8
  - 5 Groups selected this option

- different (please explain)
  - 1 Group selected this option.

The Brazilian, Chinese and German Groups noted that their answer would be the same for both Question 7 and Question 8.

i) Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?
80% of answering Groups indicate the obligation to assign would not change the answers. The U.S. and Singaporean Groups note that in this situation their answers would change to that of Question 8.

ii) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

90% of Groups indicate that participation in joint industry or industry-university research project would not change the answers.

e) Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:

- same as Question 7
  - 30 Groups selected this option
- same as Question 8
  - 9 Groups selected this option
- different (please explain)
  - 1 Group selected this option.

The Brazilian, Chinese and German Groups noted that their answer would be the same for both Question 7 and Question 8.

f) Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:

- same as Question 7
  - 34 Groups selected this option
- same as Question 8
  - 4 Groups selected this option
- different (please explain)
  - 1 Group selected this option.

The Brazilian, Chinese and German Groups noted that their answer would be the same for both Question 7 and Question 8.
10) Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.

The Spanish Group writes:

We propose a study to amend the wording of Article 6.3 PL (Spain) to avoid the interpretation of the existence of the condition referring to publication of the earlier patent application in the Spanish language as a requirement for the content of this earlier patent application to be considered as forming part of the state of the art, as a secret prior art (see section 4a).

The Swedish Group writes:

A consensus on harmonization of conflicting applications having been difficult to reach in the work of the Industry Trilateral, it will not be easier to reach in the Study Question. The Study will, however, provide a survey of the harmonization solutions desired and the support therefor and will provide a basis for positions to be taken by AIPPI in the further work on Substantive Patent Law Harmonization.

To contribute to this important work, AIPPI needs also to refresh its study of the other issues included in the Harmonization Package of the Group B+ sub-group and to take position on this harmonization and in particular the issue of a grace period.

The present state of play of the work on this Package does not seem to offer an appropriate basis for the envisaged broader consultation by Group B+. At the next meeting, AIPPI should therefore support further such work being done before the consultation, which would later allow AIPPI to contribute a comprehensive up-to-date position on the result then achieved.

The UK Group writes:

The key difficulty regarding the international harmonisation of the law on conflicting applications is the lack of information on the differences between application outcomes under the law of different states.

The 2012 Tegernsee Report suggested an empirical study on the effects of existing provisions on conflicting applications between the trilateral offices, in order to compare the impact of the different rules in practice. The report also suggested investigating the effect of the removal of the requirement for
national phase entry, so that there would be a common international body of Secret Prior Art.

These two suggestions could be combined in a WIPO trial, with help from the trilateral offices, in order to provide a practical route forward in efforts to harmonise international law on conflicting applications, the main issue being uncertainty regarding the effect of importing the law of other jurisdictions.

The pilot program would involve the WIPO training artificial intelligence software on common families of applications assessed by the JPO, EPO and USPTO. This process would allow creation of a comparative database of the effects of the practice of the different offices, without interfering with practice at any national office. Objective measures of distance between applications could then be made, allowing patent practitioners to investigate the effects of any hypothetical adoption of harmonised practice in each jurisdiction.

Collected data could also then be used to assess the independent effects of the individual elements of the law on conflicting applications e.g. anti-self-collision; shared inventorship; inventive step assessment; and differences in standards of novelty. Comparison of relative standards of novelty should be done before determination of whether a harmonised standard should be based on regular or enlarged novelty.

The Belgian Group writes:

Generally, there are two possible ways of looking at international applications as being secret prior art:

1) a horizontal approach, wherein publication of an international patent application automatically results in said application being considered as secret prior art in a given country or region, regardless of fulfilling certain formal requirements for entry into said country or region, or

2) a vertical approach wherein an international patent application is only considered as secret prior art in a given country or region when the formal requirements of entry into said country or region are fulfilled.
There are pro's and con's for both situations of course. The horizontal approach offers more certainty for the public since the publication of an international application is sufficient and there is no need to check whether or not certain requirements have been fulfilled. For smaller players, this approach enables avoiding others from patenting their exact technology hence creating some sort of (limited) freedom to operate, while avoiding the costs for national/regional entry. The drawback is that in certain cases self-collision can occur in Europe since we do not have a possibility to ignore own self-created prior art as e.g. the US has.

The vertical approach has the advantage of allowing certain jurisdictions to set their own rules for prior art that can or cannot be considered as secret prior art. Issues with self-collision can be avoided simply by not fulfilling the requirements of entry, which in Europe is an advantage due to the lack of other anti-self-collision measures. A disadvantage is that it becomes less transparent for the public to evaluate patentability of a given application/patent, since one has to check whether or not the formal requirements have been fulfilled.

The Belgian Advisory Council for Intellectual Property (Raad Intellectuele Eigendom - Conseil de la Propriété Intellectuelle) adopted a view on this back in 2006 (Annex 2), pleading for a harmonized horizontal approach. This would imply that the content of any published international application would be prior art for novelty as from its filing/priority date, regardless of any fulfilment of national or regional requirements such as those laid down in the EPC. Such a "horizontal" effect was seen as beneficial to applicants who cannot afford to enter in the national phase, and also beneficial to international harmonisation because it allows the prior art itself to be harmonised (not just the definition of the prior art).

Indeed, the America Invents Act (AIA) also adopted the "horizontal" approach in the sense that it does not require entry of a PCT application in the US national phase for it to be regarded as prior art for assessing both novelty and obviousness. Of course the AIA does provide exceptions for applications having the “same” inventors/applicants (anti-self-collision).
In order to harmonise the situation, a horizontal approach could be envisaged in Europe, but whereby the secret prior art applications are only to be used for assessing novelty. Within the Belgian group there is currently no consensus regarding potential anti-self-collision measures that could be put in place for Europe.

The Dutch Group comments:

The Unitary Patent Regulation, which is expected to be enter into force in the future, also addresses the issue of secret prior art. In particular, Art. 3(1) of the Unitary Patent Regulation 1257/2012 (UPR) provides that "[a] European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection. A European patent granted with different sets of claims for different participating Member States shall not benefit from unitary effect." Unlike EU trade marks, Unitary patents (UPs) cannot be converted into national EPs. Since the CJEU has not yet interpreted this provision, it is not fully clear what will happen with a UP if after the grant of the unitary effect there is a collision with an earlier filed but later published application for a national patent under Art. 139(2) EPC. With respect to EPs, the EPs for all other countries are not affected, but for UPs the situation is not yet fully in view of the same set of claims rule of Article 3(1) (UPR).

The Mexican Group notes:

Secret prior art provisions are aimed mainly to avoid double patenting issues. Considering this, it would be convenient for the jurisdictions to discuss the feasibility to include the disposition contained in the Mexican legal framework by which the effective filing date of applications also takes into account the specific time (hour, minute, second) of filing, so that even in the case of two or more applications filed in the same day, secret prior art provisions can be also applied, thus completely avoiding double patenting possibilities. For these purposes, proper regard of the international nature of patent filings, particularly for PCT, must be taken considering time zone changes.
The Group from Panama suggests setting standards to define “similar” claims is critical to avoid misinterpretations.

11) **Please indicate which industry sector views are included in your Group’s answers to Part III.**

The following consultation with industry was reported:

**China:** Industry sectors of electronic engineering, Internet technology, computing science, communication, microelectronics, software, mechanics, automatic control, chemistry, biotech, and medical science.

**Republic of Korea:** Metallurgy, electronic components, telecommunication, biology and pharmaceutical industries.

**Austria:** The Austrian Chamber of Commerce (which represents the full range of industry sectors) was involved in answering the questionnaire.

**Sweden:** Patent professionals from the telecom and vehicle industry have been involved in the discussions concerning all aspects of Part III.

**Belgium:** Pharma, semiconductor, petrochemistry.

**Poland:** Industrial Machinery.

**Portugal:** Pharmaceutical and Automation industries.

**Hungary:** Pharmaceutical industry.

**Panama:** Shoes and apparel.

**Paraguay:** Agrochemical, engineering and pharmaceutical industries.

**IV. Conclusions**

At the outset it is important to recognize, as noted by a number of Groups in their reports, that consideration of the subject of conflicting applications in isolation is a very different exercise from consideration of conflicting applications as part of an overall harmonisation package. Other elements of an overall package, such as grace period and prior user rights, may act to adjust the balance of the interests of the rights holders, the interests of third parties, and public interest considerations in such a way that would affect the consensus on conflicting applications. For the purpose of this Study Question, the focus is indeed on best practices for a harmonised approach to conflicting applications when considered as part of the existing international IP system. However, the significant body of information found in the Group Reports will certainly be invaluable to consideration of this topic within an overall harmonisation package framework as well.
A strong majority of Groups (85%) consider harmonisation in this area to be desirable. Reasonable consensus exists for availability of the whole contents of secret prior art for novelty-defeating purposes and for use of the same standard of novelty that is applied to public prior art. Relatively few Groups support use of secret prior art for the inventive step / non-obviousness analysis, and relatively few Groups support the concept of anti-self collision. Reasonable consensus exists for the applicability of secret prior art in the same inventor/applicant and unrelated inventor/applicant situations. However, views diverge in the various partial identity/research collaboration scenarios. Significant divergence of views also exists on the issue of whether an international application must enter the national phase in a jurisdiction to be applicable as secret prior art in that jurisdiction.

Date: 10 August 2018
Resolution

2018 – Study Question (Patents)

Conflicting patent applications

Background:

1) This Resolution concerns patent applications that conflict with earlier-filed but later published patent applications by the same or a different applicant (conflicting applications).

2) For the purpose of this Resolution:

- A first patent application that is filed prior to a later-filed patent application falls within a standard definition of publicly available prior art if it is published prior to the effective filing date of the later-filed patent application. In most jurisdictions, patent applications are published at a publication date after the filing date, meaning that there is a window during which later filed applications may be filed prior to publication of the first application. If the later-filed patent application is filed before the first patent application is published, the examining patent office must determine if and to what extent the first patent application may preclude patentability of the claims in the later-filed patent application. The first patent application in this situation will be referred to herein as secret prior art.

- Self-collision refers to the situation where secret prior art “collides” with a later-filed application by the same (or partially the same) applicant(s) and/or inventor(s).
3) Due to different approaches to treatment of conflicting applications in different jurisdictions, it is a common occurrence that a claim considered patentable in one jurisdiction is unpatentable in another. This leads to situations where multiple patents may be amassed in one country while the same or similar protection cannot be obtained in another. Multinational inventorship, joint industry and university-industry research collaborations, and globalization in general all further complicate this situation.

4) 44 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).

5) At the AIPPI World Congress in Cancun in September 2018, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

### AIPPI resolves that:

1) As a matter of principle, it would be beneficial to harmonize the treatment of conflicting patent applications.

2) Secret prior art should be available against the claims of a later-filed application, after the secret prior art is published, for examining novelty only. With respect to this secret prior art, its entire contents other than the abstract, should be considered.

3) The applicable standard for the examination of novelty in the case of secret prior art should be identical to the standard for the examination of novelty in the case of non-secret prior art.

4) Secret prior art should not be available against the claims of the later-filed application for examining inventive step/obviousness.

5) There should not be provisions to avoid self-collision for examining novelty, but only provided that there is full recognition of multiple and partial priority rights for individual claims.

6) International applications should be treated as secret prior art as of the earlier of the international filing date or the effective priority date of the relevant disclosure.

7) An international application should be considered as secret prior art only in jurisdictions where the national/regional phase has been entered.
Links:

- Study Guidelines
- Summary Report
- Reports of National and Regional Groups and Independent Members
2018 AIPPI Congrès mondial - Cancún
Résolution adoptée
26 septembre 2018

Résolution

2018 – Question

Demandes de brevet intercalaires ou interférentes

Contexte :

1) Cette résolution se rapporte aux demandes de brevet qui viennent en conflit avec des demandes déposées avant mais publiées après la date de dépôt des secondes demandes par le même déposant ou un déposant différent (« demandes intercalaires ou interférentes »)

2) Pour les besoins de cette résolution :

- Une première demande de brevet qui est déposée avant une seconde demande de brevet est considérée comme un document de l’art antérieur si elle est publiée avant la date de dépôt de cette seconde demande de brevet. Dans la plupart des pays, les demandes de brevet sont publiées à une date de publication postérieure à leur date de dépôt, ce qui signifie que, pendant un laps de temps, des demandes de brevets peuvent être déposées avant que la première demande soit publiée. Si la seconde demande de brevet est déposée avant que la première demande soit publiée, l’office qui en entreprend l’examen doit déterminer si et dans quelle mesure la première demande fait obstacle à la brevetabilité des revendications de la demande de brevet postérieure. Dans une telle situation, la première demande de brevet sera désignée ci-après « demande secrète antérieure ».

- L’auto-collision se réfère à la situation dans laquelle la demande secrète antérieure entre en conflit avec une demande postérieure déposée par le(s) même(s) demandeur(s) (ou partiellement le(s) même(s)) et/ou inventeur(s).
3) Certains pays ayant des approches différentes dans le traitement de demandes intercalaires ou interférentes, il arrive communément qu’une revendication considérée comme brevetable dans un pays soit non-brevetable dans un autre. En conséquence, de nombreux brevets pourraient être obtenus dans un pays alors que la même protection ou une protection similaire ne pourrait être obtenue dans une autre. Les inventions mises au point par des inventeurs de nationalité différente, les coopérations entre industriels, les collaborations de recherche entre universités et industriels et la mondialisation rendent cette situation plus complexe.


5) Lors du Congrès Mondial de l’AIPPI de Cancun en septembre 2018, la question faisant l’objet de cette Résolution a encore été étudiée par un Comité d’Étude dédié, puis à nouveau lors d’une Session Plénière, à la suite de laquelle la présente Résolution a été adoptée par le Comité Exécutif de l’AIPPI.

L’AIPPI adopte la Résolution suivante :

1) Par principe, il serait souhaitable d’harmoniser le traitement des demandes de brevet intercalaires ou interférentes.

2) Une demande secrète antérieure devrait être opposable, après sa publication, seulement pour examiner la nouveauté des revendications d’une demande déposée postérieurement. L’ensemble du contenu de cette demande secrète antérieure doit être prise en considération, à l’exclusion de son abrégé.

3) Les règles applicables pour l’examen de la nouveauté au regard d’une demande secrète antérieure devraient être identiques à celles qui sont appliquées pour l’examen de la nouveauté au regard d’un document de l’art antérieur non-secret.

4) Une demande secrète antérieure ne devrait pas être opposable pour examiner l’activité inventive d’une demande postérieure.

5) Il ne devrait pas exister de dispositions pour éviter l’auto-collision dans le cadre de l’examen de la nouveauté, mais seulement sous réserve qu’il y ait pleine reconnaissance des droits de priorité multiples et partiels pour chaque revendication.

6) Les demandes internationales de brevet devraient être considérées comme des demandes secrètes antérieures à compter de la date la plus ancienne entre la date de dépôt et la date de priorité pertinente pour la divulgation considérée.
7) Une demande internationale de brevet devrait être considérée comme demande secrète antérieure dans les seuls pays pour lesquels elle est entrée en phase nationale/régionale.

Liens:

- [Orientations de travail](anglais)
- [Rapport de synthèse](anglais)
- [Rapports des groupes nationaux et régionaux et des membres indépendants](anglais)
Resolution

2018 – Arbeitsfrage (Patente)

Kollidierende Patentanmeldungen

Hintergrund:

1) Diese Resolution betrifft Patentanmeldungen, die mit früher eingereichten, aber später veröffentlichten Patentanmeldungen desselben oder eines anderen Anmelders kollidieren (kollidierende Anmeldungen).

2) Für die Zwecke dieser Resolution:

- Eine erste Patentanmeldung, die vor einer später eingereichten Patentanmeldung eingereicht wird, fällt unter eine Standarddefinition des öffentlich verfügbaren Stands der Technik, wenn sie vor dem effektiven Anmeldetag der später eingereichten Patentanmeldung veröffentlicht wird. In den meisten Rechtsordnungen werden Patentanmeldungen an einem Veröffentlichungstag nach dem Anmeldetag veröffentlicht, was bedeutet, dass es ein Zeitfenster gibt, in dem später eingereichte Anmeldungen vor der Veröffentlichung der ersten Anmeldung eingereicht werden können. Wird die später eingereichte Patentanmeldung vor der Veröffentlichung der ersten Patentanmeldung eingereicht, muss das prüfende Patentamt feststellen, ob und in welchem Umfang die erste Patentanmeldung die Patentierbarkeit der Ansprüche in der späteren Patentanmeldung ausschließen kann. Die erste Patentanmeldung in dieser Situation wird hierin als unveröffentlichter („geheimer“) Stand der Technik bezeichnet.

- Selbstkollision bezieht sich auf die Situation, in der der unveröffentlichte Stand der Technik mit einer später eingereichten Anmeldung des gleichen (oder teilweise gleichen) Anmelders kollidiert.


5) Auf dem AIPPI-Weltkongress in Cancún im September 2018 wurde der Gegenstand dieser Resolution mit einem spezialisierten Fachausschuss und nochmals in einer Vollversammlung weiter erörtert, was zur Verabschiedung der vorliegenden Resolution durch den Geschäftsführenden Ausschuss der AIPPI führte.

AIPPI beschließt:

1) Grundsätzlich wäre es sinnvoll, die Behandlung kollidierenden Patentanmeldungen zu harmonisieren.

2) Unveröffentlichter Stand der Technik sollte gegen die Ansprüche einer später eingereichten Anmeldung, nachdem der unveröffentlichte Stand der Technik veröffentlicht wurde, nur zur Prüfung der Neuheit verfügbar sein. In Bezug auf diesen unveröffentlichten Stand der Technik sollte sein gesamter Inhalt, ausser der Zusammenfassung, berücksichtigt werden.

3) Der anzuwendende Standard für die Bewertung der Neuheit beim unveröffentlichten Stand der Technik sollte identisch mit dem Standard für die Bewertung der Neuheit im Fall des veröffentlichten Stands der Technik sein.

4) Unveröffentlichter Stand der Technik sollte nicht gegen die Ansprüche der später eingereichten Anmeldung für Zwecke der erfinderischen Tätigkeit/des Naheliegens verfügbar sein.

5) Es sollte keine Bestimmungen geben, die eine Selbstkollision zur Prüfung der Neuheit vermeiden, sondern nur unter der Voraussetzung, dass es eine vollständige Anerkennung von Mehrfach- und Teilprioritätsrechten für individuelle Ansprüche gibt.

6) Internationale Anmeldungen sollten als unveröffentlichter Stand der Technik vom jeweils früheren internationalen Anmeldetag oder effektiven Prioritätstag der betreffenden Offenbarung an gelten.
7) Eine internationale Anmeldung sollte nur in den Rechtsordnungen, in denen die nationale/regionale Phase eingeleitet wurde, als unveröffentlichter Stand der Technik berücksichtigt werden.

Links:

- Richtlinien für Berichte (englisch)
- Zusammenfassender Bericht (englisch)
- Berichte von Landes- und Regionalgruppen sowie von unabhängigen Mitgliedern (englisch)
Resolución

2018 – Cuestión de estudio (Patentes)

Solicitudes de patente en conflicto

Antecedentes:

1) Esta Resolución se refiere a solicitudes de patente que entran en conflicto con solicitudes de patente presentadas con anterioridad pero publicadas con posterioridad por el mismo solicitante o un solicitante diferente (solicitudes en conflicto).

2) Para los fines de esta Resolución:

- Una primera solicitud de patente que se presenta antes que una solicitud de patente presentada posteriormente se encuentra dentro de la definición convencional de estado de la técnica disponible para el público si se publica antes de la fecha de presentación efectiva de la solicitud de patente presentada posteriormente. En la mayoría de las jurisdicciones, las solicitudes de patente se publican en una fecha de publicación posterior a la fecha de presentación, lo que significa que hay un intervalo durante el cual pueden presentarse, antes de la publicación de la primera solicitud, solicitudes presentadas posteriormente. Si la solicitud de patente presentada posteriormente se presenta antes de que la primera solicitud de patente sea publicada, la oficina de patentes examinadora debe determinar si, y en qué medida, la primera solicitud de patente puede impedir la patentabilidad de las reivindicaciones en solicitud de patente presentada posteriormente. La primera solicitud de patente en esta situación se denominará aquí estado de la técnica secreto.

- Auto-colisión se refiere a la situación en la que el estado de la técnica secreto “colisiona” con una solicitud presentada posteriormente por el mismo (o parcialmente el mismo) solicitante.

3) Debido a diferentes enfoques para el tratamiento de solicitudes en conflicto en diferentes jurisdicciones, sucede habitualmente que una reivindicación
considerada patentable en una jurisdicción no sea patentable en otra. Esto conduce a situaciones en las que pueden acumularse múltiples patentes en un país mientras que en otro no puede obtenerse una protección igual o similar. La inventaría multinacional, colaboraciones de investigación de industrias y universidad-industria y la globalización en general complican aún más esta situación.

4) Se recibieron 44 Informes de Grupos nacionales y regionales de AIPPI y de Miembros independientes proporcionando información detallada y análisis con respecto a leyes nacionales y regionales referentes a esta Resolución. Estos Informes los revisó el Equipo de notificación general de AIPPI y los sintetizó en un Informe resumido (véanse los enlaces más abajo).

5) En el congreso mundial de AIPPI en Cancún en septiembre de 2018, se analizó adicionalmente el objeto de esta Resolución en un Comité de estudio específico, y de nuevo en una Sesión plenaria completa, tras la cual el Comité ejecutivo de AIPPI adoptó la presente Resolución.

**AIPPI resuelve que:**

1) Por cuestión de principios, sería beneficioso armonizar el tratamiento de solicitudes de patente en conflicto.

2) El estado de la técnica secreto debería estar disponible frente a las reivindicaciones de una solicitud presentada posteriormente, tras haberse publicado dicho estado de la técnica secreto, únicamente para examinar la novedad. Con respecto a este estado de la técnica secreto, debería tenerse en cuenta todo su contenido excepto el resumen.

3) El estándar aplicable para el examen de novedad en el caso de estado de la técnica secreto debería ser idéntico al estándar para el examen de novedad en el caso de estado de técnica no secreto.

4) El estado de la técnica secreto no debería estar disponible frente a las reivindicaciones de la solicitud presentada posteriormente para examinar la actividad inventiva/obviedad.

5) No debería haber disposiciones para evitar la auto-collision para el examen de novedad, pero solo siempre y cuando haya un reconocimiento pleno de derechos de prioridad múltiple y parcial para cada reivindicación de forma individualizada.
6) Las solicitudes internacionales deberían tratarse como estado de la técnica secreto a partir de la más temprana de la fecha de presentación internacional o la fecha de prioridad efectiva de la divulgación relevante.

7) Una solicitud internacional únicamente debería considerarse estado de la técnica secreto en jurisdicciones en las que se haya iniciado la fase nacional/regional.

Enlaces:

- Directrices de estudio (inglés)
- Informe de síntesis (inglés)
- Informes de grupos nacionales / regionales y miembros independientes (inglés)