



2018 AIPPI World Congress - Cancún
Adopted Resolution
September 26, 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](#)