

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 Trilateral¹, and the Group B+ sub-group on patent harmonisation. The Industry Trilateral's June 1, 2017 paper, "Policy and Elements for a Possible Substantive Patent Harmonization Package" is available here:

[http://documents.epo.org/projects/babylon/eponet.nsf/0/AB72B3B9AD31E894C125816F0036344E/\\$FILE/B%2B_policy_and_elements_2017.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/AB72B3B9AD31E894C125816F0036344E/$FILE/B%2B_policy_and_elements_2017.pdf).

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

[http://documents.epo.org/projects/babylon/eponet.nsf/0/EE17D8639B308D81C12581BF005365E3/\\$File/group_b+_response_document_to_the_it3_elements_paper_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/EE17D8639B308D81C12581BF005365E3/$File/group_b+_response_document_to_the_it3_elements_paper_en.pdf).

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*

¹ Comprising AIPLA, IPO (Intellectual Property Owners Association), BE (Business Europe) and JIPA (Japan Intellectual Property Association).

the time of filing the subsequent application (Sydney 1988, Question 89C, Yearbook 1988/II).

- 7) 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

- 8) 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

- 9) 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.² 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 29*bis* 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-

² See, e.g., “Navigating the Patent Thicket: Cross Licenses, Patent Pools, and Standard-Setting,” Carl Shapiro, University of California, Berkley, March, 2001.

obviousness for later-filed applications by a different applicant. For the same 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
 - 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?

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.

- 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 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 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.