

## **Substantive Patent Law Harmonisation [SPLH]**

### ***Introduction***

The Federation represents IP intensive companies in the United Kingdom - a list of members is attached. Our member companies are extensively involved with IP in Europe and internationally. Not only do our companies own considerable numbers of IP rights, both in Europe and elsewhere, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions, here and elsewhere.

### ***Preliminary***

In our policy papers [PP14/11](#) and [PP06/14](#), we indicated that the Federation supported the renewed efforts to find common ground for international agreement on a number of substantive aspects of patent law. The present policy paper is a restatement of the IP Federation position, with clarification of some issues.

It would be highly desirable to reach agreement, at the least, on the prior art to be considered in relation to novelty, on the principle that the patent on a given invention should be awarded to the first inventor to file and on a grace period.

### ***First to file***

The patent for a given invention should be awarded to the first inventor to file or the successor in title of that inventor. This would include the inventor's employer (a) where the inventor is employed on research and development, subject to the contract of employment, and (b) where the inventor is otherwise under lawful contract to cede ownership of inventions to the employer. (*Subsequent references in this paper to the inventor include any successor in title.*)

First to file is a clear and straightforward way to decide between two inventors who have invented the same thing. Someone who is not the inventor should not be entitled to apply.

### ***Prior art / Novelty requirement***

Absolute novelty should be a basic requirement when assessing patentability, subject to limited exceptions for prior disclosure by the inventor at an international exhibition or within a grace period, or for breach of confidence. Thus any information made available to the public before the (valid) priority date of the patent application under consideration, in any form, in any place and in any language, unless covered by the limited exceptions, is prior art relative to the application under consideration.

The question of whether the information was available to the public at the

relevant date should be tested as a matter of fact in the circumstances of each case. Searches should consider prior art before the application date rather than the priority date, in case the claim to priority is invalid.

Secret commercial use does not make the information available to the public and should be excluded. As regards prior sale, the question must always be what was available to the public on the relevant date. If there is no enabling disclosure there is no prior art.

The prior art should also include applications of earlier priority date but published subsequently to the application date, including international applications under the Patent Cooperation Treaty (PCT) where the application has entered the relevant national or regional phase. There are diverging views among our members on when PCT applications should become citable prior art.

### ***Grace period***

The Federation is in favour of introducing a grace period during which the disclosure of an invention by the inventor will not invalidate a subsequent patent application for the invention, provided that certain conditions\* are met, as outlined below.

#### ***What is to be removed from prior art?***

The benefit of grace should only be given to the inventor's own earlier disclosure. Information disclosed by a third party should not be graced relative to the inventor's patent application, except where the information disclosed by the third party is a straightforward reproduction of all or part of the inventor's disclosure.

The inventor's application should **not** enjoy the benefit of grace in relation to **independent** disclosures published during the grace period, even where they concern very similar subject matter.

#### ***Length of grace period***

We consider that the period should be twelve months before the priority date of the corresponding patent application.

#### ***Declaring a claim to the benefit of a grace period***

We consider that a declaration should be made at the time of filing a corresponding patent application. The declaration should itemise the inventor's own disclosures and any others known to him/her that should be graced. This declaration will be essential to interested third parties, patent examiners and the courts when assessing the scope and validity of the patent.

#### ***Onus***

The onus must be on the inventor/applicant to justify any claim for grace in respect of any prior disclosure.

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\* In relation to the conditions, the position expressed does not represent the view of all members, but represents the view of the majority.

### ***Prior user rights***

In first to file systems, prior user rights are essential to safeguard the interests of those who have invented and made preparations to manufacture or use a product or process, without applying for a patent on it. (The need for prior user rights does not generally arise in “first to invent” systems, where an earlier inventor cannot be shut out by a later one.) Prior user rights should be mandatory, not optional, and should permit the prior user to develop his/her product, process and/or manufacturing capacity. Prior use might start within the grace period.

There are diverging views among our members on whether prior user rights should be local or global.

### ***No rights from the graced disclosure***

A graced disclosure will be part of the prior art as regards patent applications of later date by third parties, but should not establish any right to prevent the use or development of products or processes by others.

A patent application for the invention in the graced disclosure should not have any right over an application for an independently made invention of earlier priority date, even where this date is within the grace period. (The graced disclosure might be prior art in this situation, of course.)

Information made public in a graced disclosure before the filing of a corresponding patent application (the “grace” application) might be used by third parties in developing their own inventions. The possibility will exist that those third parties might file applications for those inventions ahead of the grace application.

### ***Co-pending applications***

We do not support double patenting, whether the two applications are from the same or different applicants. A simple novelty approach as between co-pending applications is the fair way to ensure there is no double patenting.

Thus we consider that an application of earlier priority should be prior art as regards novelty, but not the inventive step, in relation to an application of later priority but filed before the publication of the earlier.

We wish to avoid conflict between divisional applications and their parents, the so called ‘toxic divisionals’ issue. We would like to see the position clarified so that, irrespective of any question of entitlement to priority, a divisional application cannot be cited against its parent as prior art, or vice versa.

### ***Mandatory 18 month publication for unclassified applications***

We consider that publication of applications at 18 months from their priority dates should be a very important feature of a harmonisation treaty. 18 month publication ensures that “submarine” applications do not remain unpublished for several years following filing. Competitors and third parties will be made aware of what is being applied for at a reasonably early date, e.g. before too much effort is expended on the same line of development. Moreover, there should be no discrimination between “national” and foreign applications.

***Other policy papers on harmonisation***

Attention is also drawn to the following IP Federation policy papers, which our members continue to support:

- Policy Paper [PP22/12](#) Collaborative Search and Examination Project
- Policy Paper [PP2/13](#) Proposal for harmonisation of claim formats

***Conclusion***

The members of the IP Federation trust that agreement may be made on the above topics, in a move towards international harmonisation of substantive patent law.

IP Federation  
22 April 2015



## **IP Federation members 2015**

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. The CBI, although not a member, is represented on the Federation Council, and the Council is supported by a number of leading law firms which attend its meetings as observers. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd  
Airbus  
ARM Ltd  
AstraZeneca plc  
Babcock International Ltd  
BAE Systems plc  
BP p.l.c.  
British Telecommunications plc  
British-American Tobacco Co Ltd  
BTG plc  
Caterpillar U.K. Ltd  
Dyson Technology Ltd  
Element Six Ltd  
Eli Lilly & Co Ltd  
Ericsson Limited  
ExxonMobil Chemical Europe Inc.  
Ford of Europe  
Fujitsu Services Ltd  
GE Healthcare  
GKN plc  
GlaxoSmithKline plc  
Glory Global Solutions Ltd  
Hewlett-Packard Ltd  
IBM UK Ltd  
Infineum UK Ltd  
Johnson Matthey PLC  
Merck Sharp & Dohme Ltd  
Nokia UK Ltd  
Pfizer Ltd  
Philips Electronics UK Ltd  
Pilkington Group Ltd  
Procter & Gamble Ltd  
Renishaw plc  
Rolls-Royce plc  
Shell International Ltd  
Smith & Nephew  
Syngenta Ltd  
The Linde Group  
UCB Pharma plc  
Unilever plc  
Vectura Limited