

Harmonisation of Substantive Patent Law

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

The Federation supports the renewed efforts to find common ground for international agreement on a number of substantive aspects of patent law. We are content that the issues to be explored should be as outlined in EPO document SACEPO WPR 10/11.

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, including international applications, of earlier priority date but published subsequently to the application date.

Grace period

The Federation is strongly 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.

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. Provisions such as those of EPC Article 55 concerning non-prejudicial disclosure should be amended accordingly.

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 invention.

Onus

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

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 and/or process and/or manufacturing capacity. Prior use might start within the grace period. There should not be any consideration of whether the prior use was in "good faith".

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 and anti-self-collision

We do not want 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. Also, we do not favour an anti-self-collision provision.

Mandatory 18 month publication

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.

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.

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IP Federation members 2011

The IP Federation (formerly TMPDF), 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. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity no: 83549331760-12.

ARM Ltd
AstraZeneca plc
Babcock International Ltd
BAE Systems plc
BP p.l.c.
British Telecommunications plc
British-American Tobacco Co Ltd
BTG plc
Delphi Corp.
Dyson Technology Ltd
Eli Lilly & Co Ltd
ExxonMobil Chemical Europe Inc
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Hewlett-Packard Ltd
IBM UK Ltd
Infineum UK Ltd
Merck Sharp & Dohme Ltd
Microsoft Limited
Nokia UK Ltd
Nucletron Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
Procter & Gamble Ltd
QinetiQ Ltd
Rolls-Royce plc
Shell International Ltd
Smith & Nephew
Syngenta Ltd
The Linde Group
UCB Pharma plc
Unilever plc