



# FICPI position on Patent Law Harmonisation

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# Guiding principles (1)

- A first applicant and a second applicant, claiming similar subject matter and facing the same prior art, should both be entitled to patent protection as long as they do not claim exactly the same subject matter (double patenting must be avoided) - **the first applicant should not be given a dominant position just because he filed first.**
- Patent applicants **who have inadvertently disclosed the invention before the patent filing still deserve a patent on their contribution** as long as the invention is patentable in relation to the prior art (except for the inventor's pre-filing disclosure) and nobody else has independently disclosed the invention before the priority or filing date.



# Guiding principles (2)

- **Prior user rights** should be recognized for third parties who have started commercial use, or have made significant preparations for such use before the patent filing. – **strong incentive to file asap for inventors having made a PFD**
- There should be an incentive for inventors to file a patent application as soon as possible after disclosing a patentable invention – this is in the interest of third parties and the public at large.
- Consistent with a first-to-file system, prior art should include only information made available to the public – there should be no “secret prior art”.



# FICPI perspective

- Our opinions are rooted in a **wide range** of different experiences and knowledge of the business needs of the IP system.
- We gather the experience of the entire free profession, and speak in support of an effective IP system for **all users**, IP owners and third parties alike.
- Our members represent clients ranging from individuals and SMEs to multi-national industries, as well as universities, governmental and non-governmental organisations and other institutions.
- Our members come from 86 countries and regions of the world.
- Our contribution embraces this variety of perspectives in a well balanced manner.



# FICPI and Harmonisation

- For many years, an ongoing analysis of Grace Period and related harmonisation topics. Repeated support for a well balanced Grace Period
  - Reference papers on Grace Period FICPI/WP/2013/01, and Prior User Rights FICPI/2015/WP/001
- FICPI Working Group assembled to study specifically Harmonisation issues raised at B+ Sub-Group
  - The core FICPI Working Group : members from eleven countries
  - Australia, Brazil, Canada, China, France, Germany, Israel, Japan, Sweden, the United Kingdom and the United States
- Beyond this core group, extensive discussions within FICPI led to an international consensus at the Executive Committee in Toronto, June 2018
  - EXCO/CA18/RES/001 (Conflicting applications)
  - [FICPI-WP-2018-001-Patent\\_Law\\_Harmonization](#)



# A balanced package should..

- Be relatively **simple** and easy to understand;
- Be based on well-established principles of patent law, as much as possible;
- Strike a proper **balance**
  - between the interests of applicants, third parties and the general public,
  - and also between large companies and small entities, including individual inventors.



# Guiding principles (1)

- A first applicant and a second applicant, claiming similar subject matter and facing the same prior art, should both be entitled to patent protection as long as they do not claim exactly the same subject matter (double patenting must be avoided) - the **first applicant should not be given a dominant position just because he filed first.**
- Patent applicants **who have inadvertently disclosed the invention before the patent filing still deserve a patent** on their contribution as long as the invention is patentable in relation to the prior art (except for the inventor's pre-filing disclosure) and nobody else has independently disclosed the invention before the priority or filing date.



# Guiding principles (2)

- **Prior user rights should be recognized** for third parties who have started commercial use, or have made significant preparations for such use before the patent filing.
- There should be an **incentive for inventors to file a patent application as soon as possible after disclosing** a patentable invention – this is in the interest of third parties and the public at large.
- Consistent with **a first-to-file system, prior art should include only information made available to the public** – there should be no “secret prior art”.





# Grace Period

- GP up to 12 months after applicant's own PFD
  - information disclosed by third parties, being directly or indirectly derived from a PFD from the inventor, should be graced
- GP remains a safety net - inventor to file an application asap after PFD
  - Strong PUR + Third parties independent (non-derived) disclosures not graced + possibly, Statement
- Additional transparency through notice from Patent Offices :
  - Offices should give notice of filing activities to the public (“public filing notice”) no later than 6 months from the filing date
- Notice should contain :
  - Bibliographic data of the application including the IPC classification,
  - Any priority claim
  - Any voluntary statement of a PFD (corresponding to the contents of the PFD only, not the entire contents of the application)



# Grace Period - statement

- Incentivize patent applicant to voluntarily file a statement giving details of any PFD :
  - after filing a statement there should be a presumption that the PFD is graced
  - if no statement is filed and a PFD is cited as a bar, the applicant will have to check all his / the inventor's prior activities
- Statement should not be mandatory
  - Trap effect if PFD, or statement, inadvertently missed
  - Date of PFD may be difficult or impossible to determine
  - PFD may be ignored by applicant, especially SMEs, Universities, etc.
  - Risk of additional litigation (e.g. nullity proceedings) if applicant has not filed statement
  - Administrative burden on Patent Offices (tracking declarations, adjusting publication dates if early publication is associated to statement, ..)



# Prior User Rights

- Strong PUR : essential to the “safety net” approach
  - PUR may be acquired during the GP
  - PUR may be acquired even if derived – in a legitimate way – from a PFD made by the applicant
    - Strong incentive for applicant to file an application ASAP after a PFD
- Need commercial use or significant preparations
- Limited to the party having acquired PUR



# Conflicting applications

## Background – early stages and up to Prior Claiming

- In the UK, before 1883, patents were awarded to first to obtain grant
  - Once that patent was granted, a patent for same invention could not be granted to earlier filer
- Prior Claiming was introduced to avoid this situation
  - Prior Claiming acknowledged that both first and second applicants had made inventions over the true prior art and were entitled to a patent, subject to avoiding double patenting (DP)
  - Problem with Prior Claiming : examination of later application could not be concluded until fate of earlier claims is known
- To overcome the problem associated with Prior Claiming, the Whole of Contents Novelty (WCN) approach was adopted for the EPC (1977)
  - WCN required later claims to exclude all subject matter that could be claimed in earlier application
  - This is achieved by deeming earlier disclosure to be part of the prior art and applying a “novelty test”
  - But WCN is not a true test of novelty over “prior art”, it is a **test to identify subject matter to be subtracted from later claims**, for avoiding **double patenting**



# Conflicting applications

## Background – content of « Prior art »

- FICPI also considered fundamental differences between treatment of Conflicting Applications in first to invent (FTI) system relative to first to file (FTF) system : Conflicting Applications are prior art in FTI system but not in FTF system
- In FTF system under WCN : an earlier, conflicting, disclosure is **deemed** to be part of the prior art. The earlier conflicting disclosure is not actual prior art
- EPC Diplomatic Conference :
  - “The problem which Article 52 [54], paragraph 3, sets out to cover does not relate to the assessment of novelty but to a conflict between two applications; it is as such that it should be dealt with.”



# Conflicting applications

## Need for a « distance » ?

- Is there a need for a “distance” or gap (beyond novelty) between first and second applications ?
  - e.g. “go beyond common general knowledge to one of ordinary skill in the technical field”
- Such gap would face issues
  - Which “distance” ? How should it be defined ? A new standard ?
  - in FTF system, no need for any analysis of what second applicant has added or contributed over first applicant – just need to avoid potential DP by subtracting earlier disclosure : with WCN, there is no need for any “gap”
- Preferably there is no “distance” requirement
  - No need in a FTF approach
  - The “gap” would represent subject matter second applicant has enabled, but could not claim



# Conflicting applications

## WCN

- WCN developed from prior claiming as an improved approach to avoid double patenting
  - Like Prior Claiming, WCN acknowledges that later applicant has made an invention over the prior art and deserves a patent subject to avoiding potential for Double Patenting
  - Contrary to Prior Claiming, WCN is predictable
- Today WCN is the preferred approach in first to file jurisdictions, where it has been implemented for many years now
- This approach is well understood by practitioners world wide



# Conflicting applications

## FICPI supports WCN

- Simple and predictable
- Efficiently deals with double patenting between CAs
- A solid system having been tested in practice for some 40 years
- Fully consistent with other components of the Harmonisation package proposed by FICPI (GP, PUR)
- Balances interests of first and second filer
  - equal rights to early and later filers when assessing novelty and inventive step, in relation to actual prior art
- No need for anti-self-collision provisions
  - Same rules apply whether or not the second filer is the same person as the first filer
- No need for special provisions (such as terminal disclaimers ..)





# PCT applications

- WCN aims at avoiding Double patenting
- Earlier filed international patent applications cannot give rise to patents in jurisdictions in which national phase has not been entered
- Accordingly, no sound basis for treating such earlier applications under the whole of contents novelty approach



# Thank you !

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