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FICPI Position on Patent Law Harmonisation

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FICPI was invited to a recent B+ Sub-Group meeting on 26 September 2018 to present its position on the three main patent law harmonisation topics currently under consideration: grace period, prior user rights, and conflicting applications. The presentation given by FICPI at this meeting can be found at <https://www.ficpi.org>.

In June, 2018 FICPI passed a resolution on conflicting applications and adopted an extensive position paper on these key harmonisation topics.

This article provides a brief background to FICPI's consideration of these topics and summarises the positions reached.

Background

A constructive dialogue between patent law practitioners and users from various jurisdictions is of great importance to the international IP system. Such discussions facilitate an understanding of various national or regional systems and can be of great assistance in finding common ground for harmonisation. The Patent Law Treaty (PLT) made significant progress on harmonising procedural aspects encountered in securing patent protection. While WIPO carried out work for a number of years on harmonising substantial patent law after the signing of the PLT, these efforts failed to achieve any harmonised positions. Group B+ is now taking steps to move forward with substantive patent law harmonisation within the dedicated B+ Sub-Group.

Grace period, prior user rights and conflicting applications have been identified as key topics that are linked together. These topics have been discussed for some years now within Group B+. Within this forum it has been recognised that by balancing the metes and bounds of a grace period, prior user rights and conflicting applications, a potential "harmonisation package" could be developed. This would be a substantial step forward on the road to substantive patent law harmonisation.

FICPI, one of the major international IP organisations, has studied key aspects of substantive patent law har-

monisation for many years. With practitioners representing 86 countries and regions around the world, FICPI members represent a diverse range of experiences and possess deep knowledge of the business needs of the IP system (both users of the system as well as intellectual property offices which effectively administer the system). FICPI members represent clients ranging from individuals and SMEs to multi-national industries, as well as universities, governmental and non-governmental organisations and other institutions. By drawing on the learning of this broad range of professionals, FICPI is able to speak in support of an IP system that is fair and balanced for all who are affected by IP rights, including IP owners and third parties.

Over the years, FICPI has carried out an ongoing analysis of the grace period and related harmonisation topics. More recently, a FICPI working group was assembled to study the harmonisation issues raised by the B+ Sub-Group. A core working group was established consisting of 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 consensus at the last Executive Committee in Toronto in June 2018, and adoption of a comprehensive position paper (see FICPI Position on Patent Law Harmonisation).

Guiding principles

In reaching its position, FICPI considered that a well-balanced harmonisation package should:

- be relatively simple and easy to understand;
- be based on well-established principles of patent law; and,
- strike an appropriate balance between the interests of different kinds of users of the patent system (large and small entities, as well as individuals, all of whom can in different situations be applicants, third parties or the general public).

FICPI's work was guided by the following principles:

- 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 should be avoided) – the second applicant should not lose out completely just because he filed second.
- For a reasonable period of time, applicants who disclose their invention before filing a patent application still deserve a patent as long as their invention is patentable in relation to the rest of the prior art (i.e. except for their own pre-filing disclosure) and nobody else has independently disclosed the invention before the priority or filing date.
- Prior user rights should be recognised for third parties who have started commercial use, or have made significant preparations for such use, before the filing date of the patent application, even if such use originates from the applicant's pre-filing disclosure.
- Inventors should be encouraged to file a patent application as soon as possible after making a patentable invention in the interest of third parties and the public at large.
- Consistent with a first-to-file system, prior art that is used for an assessment of novelty and inventive step should only include information that has been made available to the public prior to the filing or priority date of a patent application, i.e. there should be no "secret prior art".
- A "first-to-disclose" system should be avoided.
- disclosures to be "graced" may take any mode of disclosure by the inventor or derived from the inventor's disclosure by a third party. (Independent disclosures by third parties before the filing date of a patent application should not be graced);
- a pre-filing disclosure made by an inventor should not constitute a quasi-priority right in relation to third party disclosures;
- third parties may acquire prior user rights irrespective of a disclosure made by the inventor before the filing date but within the grace period, provided that all other criteria for obtaining prior user rights are met. This should contribute to limiting the effect of the grace period to a "safety net" and incentivise those who disclose an invention to file a patent application as soon as possible thereafter;
- any declaration or statement to invoke a grace period should not be mandatory at the time of filing a patent application. On the other hand, FICPI would not be opposed to a system that affords applicants an opportunity to make a voluntary statement giving details of pre-filing disclosures to obtain certain advantages. For example, after the filing of a voluntary statement, there could be a presumption that a pre-filing disclosure mentioned in the statement is to be excluded from the prior art when assessing novelty and inventive step unless and until a third party proves otherwise;
- in order to afford further transparency, FICPI also proposes that Patent Offices should give notice of new patent applications to the public ("public filing notice") no later than, say, 6 months after the filing date. Such notice would provide bibliographic data of the application including details of any priority claim and any voluntary statement concerning a pre-filing disclosure.

With these principles in mind, FICPI developed its position on the three components of a possible harmonisation package: grace period, prior user rights and conflicting applications.

Grace period

FICPI has repeated its long-standing support for a well-balanced grace period. The most recent and comprehensive statement of FICPI's position on grace periods can be found in 2013's White Paper on Grace period, and this is further discussed in a 2016 Briefing Paper on Grace Period.

In short, FICPI considers that key features of a grace period should be:

- a term of 12 months running up to the priority date or filing date (FICPI recognises good arguments for both alternatives);

Prior user rights

Prior user rights are seen by FICPI as an important component for balancing the effect of a grace period according to the concept that the grace period is a "safety net" for applicants and nothing more.

According to FICPI's position, prior user rights should be acknowledged for a party ("prior user") despite the existence of a patent or patent application owned by another party (a patentee/applicant) if:

- 1) the prior user legitimately started commercial use or had made significant preparations for such use before the priority date of the other party's patent application, even where the other party, relying on the grace period, had already publicly disclosed the invention before the priority date, provided that at least one of the conditions

2a, 2b or 2c below is also met:

2a) the prior user conceived the invention independently of the patentee/applicant;

2b) the prior user exploited the invention based on knowledge that was in the public domain at the time the prior user started commercial use or had completed significant preparations for such use;

2c) the prior user had obtained knowledge of the invention from the patentee/applicant and begun the prior use with the explicit or implicit consent of the patentee/applicant (“implied licence”), there being no abuse in relation to the latter, and in particular no contractual or implicit requirement for the prior user to refrain from using the invention or from disclosing it to third parties or to the public. (Conversely, prior user rights should not be recognised in situations where a prior user began exploitation of an invention on the basis of information derived from the applicant that was not in the public domain and without the applicant’s consent.)

Other details of FICPI’s position on Prior user rights are described in a 2015 FICPI White Paper on Prior user rights.

Conflicting applications

In its resolution of June 2018 FICPI supported a “Whole of Contents Novelty” (WCN) approach for determining the relationship between an earlier and later filed applications, where the later application is filed before the earlier one has been published.

In situations where an earlier filed patent application is unpublished at the time of filing of a later patent application, there is a possible conflict between the two applications. Resolving such a conflict is critical not only in determining which applicant has the better right to a patent for the invention, but also is in the public interest in avoiding double-patenting, i.e. two different patents protecting exactly the same subject matter. This type of conflict has been treated differently over the years by various the patent systems and a brief recap of the historical development of patent law on this issue might be of assistance in appreciating how FICPI reached its position.

In the UK, before 1883, patents were awarded to first person to achieve grant. Once a first patent had been granted, another patent for the same invention could not be granted, even to an applicant who had filed his application earlier. A system of “Prior Claiming” was thus devised to avoid this inequitable situation. Prior Claiming acknowledged that both first and second applicants had made inventions over the prior art and were equally entitled to a patent, subject to the need to avoid double patenting. Prior Claiming efficiently avoided double patenting by giving precedence to the earlier filed application thereby pre-

venting the later applicant from securing claims to subject matter claimed in the patent granted on the earlier filed application. However, an intrinsic problem with the Prior Claiming approach was that examination of the later application could not be concluded until the fate of the claims of the earlier application was known.

To overcome this problem, the WCN approach was adopted in the European Patent Convention (EPC) in 1977 (which started to operate in 1978). WCN effectively required the later claims to exclude all subject matter that could potentially be claimed in the earlier application. This is achieved by **deeming** all of the contents of the earlier application to form part of the state of the art in relation to an application that is filed later but before the first is published, and applying the novelty test.

It is important to appreciate that under this approach, the contents of the earlier application are not actually part of the state of the art for the purpose of novelty or inventive step, but they are “considered” to be comprised within the state of the art to avoid double patenting. This is reflected in the wording of Article 54(3) EPC. It is also confirmed by the Travaux Préparatoires of the 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”.¹

WCN is therefore a test to identify subject matter that should be “subtracted” from the claims of the later application in order to avoid double patenting. WCN is not a true novelty test over traditional “prior art”. The earlier, unpublished application is not true prior art in the sense that it has been made available to the public – it is considered to be part of the state of the art purely for the purposes of applying the subtraction called for by WCN.

When considering the problem of conflicting applications, the notion of “distance” between an earlier unpublished application and the claims of a later application has been discussed within the B+ Sub-Group. Such “distance” would arguably define a standard applicable for determining the patentability of the claims of a later filed application in view of the contents of an earlier filed application that is unpublished at the time of the later filing. FICPI notes however that any definition of such “distance” would encounter serious difficulties: what “distance” should be used? How should it be defined? Should this “distance” be a new standard?

FICPI also notes that with WCN there is no need for any “distance” or gap (beyond novelty) between an earlier

¹ See Comments on the preparatory documents to the Travaux préparatoires to the EPC, Art. 54

and later applications. By applying WCN, double patenting is successfully avoided without the need for additional “distance” between the disclosure of the earlier application and the claims of the later one.

FICPI views WCN favourably as a simple yet efficient solution for avoiding double patenting, which moreover provides:

- equal rights to early and later filers when assessing novelty and inventive step over the state of the art;
- no need for anti-self-collision provisions;
- no need for terminal disclaimers;
- a solid predictable system that has been tested in practice (EPC) for some 40 years.

FICPI’s position is explained in detail in its 2018 Resolution on Conflicting applications, and a full explanation with a historical perspective of “secret” prior art can be found in an article by Michael Caine : “The problem with secret prior art”.

Conclusions : FICPI’s proposal for a package solution for substantive patent law harmonisation

FICPI proposes a straightforward package solution which fairly balances the interests of different stakeholders in the patent system as follows:

- A Grace period which is a safety-net for applicants, as detailed in FICPI’s 2013 White Paper on Grace period and 2016’s Briefing Paper on Grace Period, that gives applicants the possibility of filing a voluntary statement of pre-filing disclosures and involves Patent Offices publishing basic details of new patent applications within 6 months of their filing date. Such a regime would strike an appropriate balance between the competing interests of different stakeholders and will provide an incentive for inventors to file patent applications promptly after a pre-filing disclosure, thereby limiting the period of uncertainty for third parties to an acceptable level. A pre-filing disclosure should not give rise to any priority-type rights in relation to disclosures made by others.
- Prior user rights as described in FICPI’s 2015 White Paper on Prior user rights. Prior user rights should be available to third parties who have independently made an invention or acquired knowledge of an invention in a legitimate way from the inventor within a qualifying period running up the filing date or priority date of the patent application.
- A whole of contents approach to the treatment of conflicting applications as described in FICPI’s 2018 Resolution on Conflicting applications and summarised above.

FICPI looks forward to a continued participation and related discussions in the process of developing a harmonised, well-balanced global patent system.

Patenting Emerging Computing Technologies before the EPO – 20 Decisions You Should Have Heard Of

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Emerging computing technologies, such as Artificial Intelligence¹ (AI), Machine Learning (ML), Blockchain Technology, Big Data, Self-Driving Vehicles (SDV) have become a “hot topic” within – but of course also well beyond – the patent community. The EPO with its well-established and stable jurisdiction regarding computer-implemented inventions (CII) and its ambition to be the

worldwide benchmark in patenting CII has placed special emphasis on patenting emerging computing technologies by, for example, organizing conferences on patenting AI and Blockchain Technology. It updated its Guidelines for Examination to provide more guidance on the patentability of CII in general and inventions in the field of AI, Machine Learning, Big Data, etc. in particular (see sections F-IV, 3.9.3; G-II, 3.3, 3.3.1, 3.3.2 etc.) and has published a study on Self-Driving Vehicles. The following article explicitly does not want to dwell on the basics of patenting CII, such as the COMVIK approach, but intends to shed light on a compilation of decisions that may be helpful in arguing why an invention is patentable or not before the EPO. Although some of the emerging

¹ The term “Artificial Intelligence” was coined in 1956 by John McCarthy at the Dartmouth Conference which is considered by many as the birth of AI as a research field. The field did not grow organically and had to cope with setbacks. Since AI could not hold the enthusiastic promises it initially made, the field entered into a depression at least twice (called “AI winters”) – periods during which AI research did not get a lot of funding and research facilities were closed down. Possibly, the current boom period should therefore also be regarded in a realistic manner against this backdrop.