Study Question

Submission date: April 27, 2018

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Conflicting patent applications

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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.**

1.a **Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain

Swedish Patent Law does not distinguish secret prior art based on the identity of the applicant(s) or the inventor(s).

Some inital general remarks

Initially, the Swedish group wishes to provide some general remarks of relevance to our answers provided below.

The European Patent Convention ("EPC") and the development within the European Patent Office (EPO) have been given particular weight by the Swedish Supreme Administrative Court and the Swedish Supreme Court. Sweden became a party to the EPC in 1978 and the Swedish Patents Act is highly harmonized with the PCT and the EPC. Also, practise in Sweden develops in conformity with the EPC as interpreted by the European Patent Office. Furthermore in this regard, patents valid in Sweden may either have been granted by the Swedish Patent and Registration Office (PRV) or by the EPO.

Naturally, Swedish patent law is based on international agreements, such as the Paris Convention for the Protection of Industrial Property (Paris Convention), the Patent Cooperation Treaty (PCT), the European Patent Convention (EPC), the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), and the Patent Law Treaty (PLT).

The answers to questions 1, 2 and 3 below find legal basis in Sections 2, 29, 38 and 87 of the Swedish Patents Act. Further guidance, particularly with regards to the relevance of an International or European Patent Application validly having entered and designated Sweden to be citeable as secret prior art, can be found in the Swedish Guidelines for Examination, (RL); Part C1: 4.1 to 4.2.4. These Guidelines however are not legally binding and only serve as guidance to Office Examiners.

Section 2, 1st paragraph of the Patents Act states that patents shall only be granted for an invention that is new in relation to what was known before the filing date[1] of the patent application and which also differs essentially therefrom. Section 2, 2 nd paragraph states that the contents of an earlier patent application filed in Sweden before the said date shall be considered as known if that application becomes available to the public in accordance with div 22 of the Patents Act. The condition that the invention must differ essentially from what was known before the filing date of the patent application does however not apply to Section 2, 2 nd paragraph.

FromSection 29 it can be derived that Section 2, 2nd paragraph also applies to published international patent applications pursued in Sweden according to Section 31, i.e. completed national phase entry into Sweden.

According toSection 38 of the Swedish Patent Act, Section 2, 2nd paragraph also applies if the PRV shall continue processing of an application after finding that a decision of the receiving Office or International Bureau to refuse to accord an international filing date for an international patent application or to declare that the application shall be deemed to be withdrawn was incorrect.

Section 87 of the Patents Act includes published European patent applications validly designating Sweden in the contents of prior art pursuant to Section 2, 2nd paragraph. A European patent application is considered published (Section 22) if it is published pursuant to Article 93 or Articles 153(3) or 153(4) of the EPC.

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[1]*Or date of priority if applicable. Everything made available to the public, regardless of whether this has been made in writing, by lectures, by use or otherwise, shall be considered as known (applicable to 1 st paragraph).*

1.a. **If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?**

Yes, the entire contents of the secret prior art are available (see div 2, 1 st paragraph of the Patents Act "content of an earlier patent application").

1.a.i **If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?**

The standard for evaluation of novelty is "new in relation to what was known before the filing date of the patent application" (Section 2, 1 st paragraph).

The standard for evaluation of novelty is the same for secret and publicly available prior art. Section 2, 1 st paragraph, applies to Section 2, 2nd paragraph in this regard.

1.b **Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?**

No

Please Explain

The secret prior art is not available to show a lack of inventive step of the later-filed application.

Section 2, 2nd paragraph of the Patents Act specifically states that the criteria “and which also differs essentially therefrom” of Section 2, 1 st paragraph does not apply to

Section 2, 2nd paragraph.

1.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Not applicable

1.b.i If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * * ***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 ispossible in the scenario presented.***

Not applicable

1.b.ii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

Not applicable

1.c If the secret prior art is an international application filed designating your jurisdiction:

1.c. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

No, but the international application must validly have entered national phase in Sweden.

1.c.i Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The provisions of Section 2, 2nd paragraph applies only if the international application has entered Sweden nationally either by (1) direct national entry in Sweden (RL C1:4.2.3), or (2) by regional entry before the European Patent Office, (RL C1:4.2.2).

(1) National entry before the Swedish Patent Office:

For the international application to qualify as secret prior art, a copy or translation of the international application (if not in English or Swedish)

must be filed along with the payment of the appropriate official fees (Section 31 of the Patents Act).

(2) Regional entry before the European Patent Office:

For the international application to qualify as secret prior art the European designation fee must be paid and Sweden must be designated (Rule 39(1) EPC; R.159(1) EPC).

In both above mentioned cases, the international application is not citeable as a secret prior art if the designation of Sweden is withdrawn or if the designation fee is not paid in due time.

On a further note, regular European patent applications validly designating Sweden are also citeable as secret prior art.

.c.i **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?**

No

Please Explain

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.**

2.a **Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain

Swedish Patent Law does not distinguish secret prior art based on the identity of the applicant(s) or the inventor(s).

2.a. **If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?**

The entire contents of the secret prior art are available.

.a.i **If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?**

The standard for evaluation of novelty is “new in relation to what was known before the filing date of the patent application” (Section 2, 1 st paragraph).

The standard for evaluation of novelty is the same for secret and publicly available prior art. Section 2, 1 st paragraph, applies to Section 2, 2nd paragraph in this regard.

.a.i 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?

No, not applicable. There are no anti-self collision provisions under Swedish patent law.

2.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

The secret prior art is not available to show a lack of inventive step of the later-filed application.

Section 2, 2nd paragraph of the Patents Act specifically states that the criteria “and which also differs essentially therefrom” of Section 2, 1st paragraph does not apply to Section 2, 2nd paragraph.

2.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

Not applicable.

.b.i If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

Not applicable.

.b.ii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

Not applicable.

.b.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?

No, not applicable. There are no anti-self collision provisions under Swedish patent law.

.b.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.)?

No

Please Explain

Not applicable, but please note that pursuant to general legal bases enforced by the relevant courts, and as expressed in RL C1:4.4, double patenting is not allowed in Sweden in the event of two national applications filed by the same applicant, claiming the same invention and the same effective filing or priority date.

However, notably, if the applicant has obtained a granted European patent validated in Sweden this will not prevent the same applicant from obtaining a national patent concerning the same invention. In such a situation, double patenting is not prohibited.

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c.i Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

No, but the international application must validly have entered national phase in Sweden.

2.c.ii Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

The provisions of Section 2, 2nd paragraph applies only if the international application has entered Sweden nationally either by (1) direct national entry in Sweden (RL C1:4.2.3), or (2) by regional entry before the European Patent Office, (RL C1:4.2.2).

(1) National entry before the Swedish Patent Office:

For the international application to qualify as secret prior art, a copy or translation of the international application (if not in English or Swedish) must be filed along with the payment of the appropriate official fees (Section 31 of the Patents Act).

(2) Regional entry before the European Patent Office:

For the international application to qualify as secret prior art the European designation fee must be paid and Sweden must be designated (Rule 39(1) EPC; R.159(1) EPC).

In both above mentioned cases, the international application is not citeable as a secret prior art if the designation of Sweden is withdrawn or if the designation fee is not paid in due time.

On a further note, regular European patent applications validly designating Sweden are also citeable as secret prior art.

2.c.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?

No

Please Explain

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.**

3.a **Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

same as Question 1

Please Explain

3.b **Same applicant on the dates of filing, no common inventor:**

same as Question 1

Please Explain

3.c **Different applicants on the dates of filing, same inventors:**

same as Question 1

Please Explain

3.c. **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain

3.d **Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

same as Question 1

Please Explain

3.d. **Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?**

No

Please Explain

3.d.i **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain

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.**

4.a **The definition of when secret prior art is applicable to defeat patentability of a later-filed application.**

No

Please Explain

The Swedish group is of the opinion that the definition of when secret prior art is applicable to defeat patentability is clear and need not be improved. No changes should be made to current practice.

4.b **The patentablility standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.**

No

Please Explain

The Swedish group is of the opinion that applying novelty only as the patentability standard to distinguish the claims of the later-filed application from the secret prior art should remain and that no improvements are needed.

4.c **The treatment of international applications as secret prior art.**

No

Please Explain

The Swedish group is, in line with current Swedish practice, of the opinion that it should be required for a patent application to validly have entered national phase to qualify as secret prior art for a later-filed patent application.

4.d **The treatment of total and partial identity of applicants as it relates to secret prior art.**

No

Please Explain

No changes should be made to current practice.

4.e **The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.**

No

Please Explain

No changes should be made to current practice.

4.f **Provisions for avoiding self-collision.**

No

Please Explain

There are no anti-self collision provisions under Swedish patent law. No changes should be made to current practice.

4.g **Provisions for limiting an applicantâ€™s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicantâ€™s earlier-filed application.**

No

Please Explain

The general novelty requirement in relation to secret prior art may limit an applicant's right to obtain patent claims on so-called incremental inventions in a later-filed application. No changes should be made to current practice.

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?**

No

Please Explain

No, we do not have any other policy considerations and/or proposals for improvement to the current law falling within this Study Question. The Swedish group is of the opinion that current national practise applying to conflicting applications is satisfactory and supports applying European practise as a basis for harmonisation of the treatment of conflicting applications.

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.

No

Even if NO, please address the following questions to the extent your Group considers your Group

In general, the Swedish group considers harmonisation in this area to be desirable. However, we see that "conflicting applications" cannot be singled out of its legal context involving many other legal parameters which interact. Please refer to our response to question 10 for further elaboration on this subject and on the Harmonization Package of which conflicting applications forms part of.

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 areunrelated.***

7.a ***Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?***

Yes

Please Explain

The secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

7.a. ***If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?***

Yes, the entire contents of the secret prior art should be available.

7.a.i ***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?***

Yes, the standard for evaluation should be the same as the standard applied to publicly available prior art.

7.b ***Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?***

No

Please Explain

The secret prior art should not be available against the claims of the later-filed application to show lack of inventive step / obviousness.

7.b. ***If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?***

Not applicable.

7.b.i ***If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?***

Not applicable.

.b.i ***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?***

Not applicable.

7.c ***If the secret prior art is an international application filed designating your jurisdiction:***

7.c. ***Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.***

No

Please Explain

.c.i ***Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.***

Yes

Please Explain

The international application should validly enter national phase in the jurisdiction to qualify as secret prior art.

.c.i ***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?***

No

Please Explain

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 arethe same.***

8.a ***Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?***

Yes

Please Explain

The secret prior art should be available against the claims of the later-filed application for novelty-defeating purposes.

8.a. ***If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?***

The entire contents of the secret prior art should be available.

8.a.i ***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?***

The standard for evaluation of novelty should be "new in relation to what was known before the filing date of the patent application" (Section 2, 1st paragraph).

The novelty standard applied to secret prior art should be the same as the standard applied to publicly available prior art.

8.a.ii ***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?***

There should be no anti-self collision provisions and therefore no anti-self collision time period.

8.b ***Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?***

No

Please Explain

The secret prior art should not be available against the claims of the later-filed application to show lack of inventive step / obviousness.

8.b.i ***If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?***

Not applicable.

8.b.ii ***If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?***

Not applicable.

8.b.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?***

Not applicable.

8.b.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?***

Not applicable.

8.b.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.)?***

No

Please Explain

Not applicable.

8.c ***If the secret prior art is an international application filed designating your jurisdiction:***

8.c.i ***Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.***

No

Please Explain

8.c.ii ***Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.***

Yes

Please Explain

The international application should validly enter national phase in the jurisdiction to qualify as secret prior art.

8.c.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?***

No

Please Explain

9 ***Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application areunrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are thesame. 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.***

9.a ***Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:***

same as Question 7

Please Explain

9.b ***Same applicant on the dates of filing, no common inventor:***

same as Question 7

Please Explain

9.c ***Different applicants on the dates of filing, same inventors:***

same as Question 7

Please Explain

9.c. ***Would the answers change if the different applicants were part of a joint industry or industry-university research project?***

No

Please Explain

9.d ***Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:***

same as Question 7

Please Explain

9.d. ***Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?***

No

Please Explain

.d.I ***Would the answers change if the different applicants were part of a joint industry or industry-university research project?***

No

Please Explain

9.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

Please Explain

9.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

Please Explain

10 ***Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.***

A basic principle of the patent system is to provide incentives for commercialization of technical knowledge by providing innovators with limited exclusive rights giving the inventors possibility to receive appropriate returns of their investments. Thus, for example, if the secret prior art would be handled differently depending on whether the secret prior art and the applicant and inventors of the later-filed application are unrelated or the same, the patent system would favour the party being first to file. Thus, there would be a risk that the basic principles of the patent system would be set aside

Further, the Study Guidelines refer to the work since 2015 by the Industry Trilateral and the Group B+ sub-group on patent harmonization aiming at a Possible Substantive Patent Harmonization Package. The work includes conflicting applications, which is a controversial issue where no consensus on a harmonized solution has so far been reached. The difficulty in reaching such consensus reflects differences in basic policy considerations related particularly to remaining differences between the first-to file system according to the EPC and the US first-inventor-to-file system. Therefore, an agreement on the issue of conflicting applications does not seem forthcoming.

The work on a Harmonization Package implies that the benefits and disadvantages of harmonization will be evaluated for all the issues included and not separately for conflicting applications or for other parts of the package. A harmonization of conflicting applications may thus be agreeable as part of the package worked on by Industry Tri-lateral and the Group B+ sub-group though it cannot be agreed on separately.

A consensus on harmonization of conflicting applications having been difficult to reach in the work of the Industry Trilateral, it will not be easier to reach in the Study Question. The Study will, however, provide a survey of the harmonization solutions desired and the support therefor and will provide a basis for positions to be taken by AIPPI in the further work on Substantive Patent Law Harmonization.

To contribute to this important work, AIPPI needs also to refresh its study of the other issues included in the Harmonization Package of the Group B+ sub-group and to take position on this harmonization and in particular the issue of a grace period.

The present state of play of the work on this Package does not seem to offer an appropriate basis for the envisaged broader consultation by Group B+. At the next meeting, AIPPI should therefore support further such work being done before the consultation, which would later allow AIPPI to contribute a comprehensive up-to-date position on the result then achieved.

11 ***Please indicate which industry sector views are included in your Group's answers to Part III.***

Patent professionals from the telecom and vehicle industry have been involved in the discussions concerning all aspects of Part III.