

Sweden – Report Q 170

II) Art. 8 (2) SPLT ("Secret Prior Art")

1. What are the contents of the earlier application which should be considered?

As a matter of principle the "whole contents" approach is supported by the Swedish AIPPI Group. Regarding the question of how this notion is to be understood, the following remarks may be pertinent.

Basically the abstract of a patent application, or of a patent specification, should not confer any legal effect but serve for information purposes only. From this perspective it would seem appropriate not to consider an abstract for the assessment of prior art under Article 8 (2) and Rule 9 (1) SPLT.

However it should be borne in mind that, pursuant to Article 5 (1) of the Patent Law Treaty (PLT) the original content of a patent application does not have to be presented under specific headings in order to allow for a filing date. Indeed a part indicated as "summary" or "abstract" might be sufficient to constitute a valid application in this respect.

In view of this it may not be feasible to entirely disregard an abstract for the purposes of Article 8 (2) SPLT. Rather than defining the principle of "Whole contents" in terms of "description, claims and drawings" Rule 9 SPLT should be drafted as to reflect the wider concept of Article 5 PLT.

2. What should be the effect of such an earlier application?

The Swedish Group favours the present practice under the EPC, according to which prior filed but later published applications are considered with regard to novelty only.

In fact there is experience in Sweden from a patent practice where a prior filed but later published application was a reference not only against novelty but also against inventive step. This followed from the Swedish Patent Act as applicable from 1967 to 1978. It is fair to say that there was widespread discontent with that system. The law in this respect was also changed when Sweden joined the EPC.

The so-called "enlarged novelty" concept has come up as a possible middle way. It was agreed at the SPLT meeting May 10-14, 2004 that the International Bureau would undertake a study on that concept. The Swedish Group will

await that study. Among significant questions to be analysed is e.g. if/how such enlarged novelty concept would be applied against "normal" prior art: would "enlarged novelty" be used only in the context of prior filed but later published applications, or would it be a concept to use universally in all novelty assessments? In the latter case there would obviously be profound implications.

In the opinion of the Swedish Group the envisaged study should be broadened so as to explore to what extent the present European mode of dealing with prior filed but later published applications has caused difficulties in commercial practice of the possible situations referred to in the explanation to this question: double patenting or parallel patents on obvious modifications.

3. What date should be considered as the date of forming prior art of an earlier application?

Article 8 (2) (a) (ii) of the draft SPLT would impose binding obligations on the USA to abandon the "Hilmer doctrine". The Swedish AIPPI Group would like to express its whole-hearted support for this approach. The proposed language is accepted.

4. Does the origin of the earlier application play a role?

Obviously the heading relates to the distinction between purely national applications, on the one side, and international/regional applications, on the other side.

The mere designation of Contracting States in a PCT application should not be sufficient for the purpose of considering its contents as prior art relative national applications. It should be further required that an international application has reached the national – or regional – phase. Consequently the preference of the Swedish AIPPI Group is for Alternative A of draft Article 8 (2) (b).

5. Does it make a difference if the earlier application was not made by a third party?

The Swedish Group favours that prior filed but later published applications are applied universally as to their effect as references against novelty, that is irrespective of the identity of the applicant or inventor.

To try to introduce exceptions would in the opinion of the Swedish Group risk to create new problems, not only for applicants but also to third parties. For example: What should be understood with the "applicant" being "one and the same person"? What is "the same person"? Would the answer depend on company law? At what time should this apply? What would apply in cases with joint applicants or inventors? In a business context with frequent reorganisations of commercial companies and other applicant entities it is easy to see considerable difficulties and subsequent uncertainties

III) Article 9 SPLT (Grace Period)

General remarks

Within the Swedish AIPPI Group there are differing opinions as to the justification of a grace period in patent law. While most members hold that the concept of grace period has fundamental disadvantages, others believe that a set of well-defined provisions in this respect could merit its inclusion in a harmonised SPLT framework.

Nevertheless, there is broad consensus that any concessions in the SPLT negotiations, regarding the introduction of grace period, should be made only subject to global acceptance of the first-to-file system, as laid out in binding treaty provisions. The Swedish AIPPI Group appreciates that this approach is also reflected in a foot-note to the proposal from USA, Japan and the European Patent Office (document SCP/10/9, Annex, page 2).

Consequently, the following comments by the Swedish AIPPI Group should be understood to be conditional upon a package deal including first-to-file. At this stage the Group refrains from taking any stand whether, or on what terms, grace period should be accepted in the absence of a satisfactory settlement of the first-to-file issue.

Answers on specific questions (questionnaire page 8)

1) The term for grace period should be as short as possible, but still allow most inventors, or their successors in title, in need of the grace period an effective opportunity to benefit from it. Regarding the length of the period opinions are divided within the Swedish Group. According to the majority the grace period should not exceed 6 (six) months preceding the filing date or the priority date, whereas some members of the Group accept 12 months.

2) For reasons of legal certainty the right to invoke grace period should be subject to an express declaration by the applicant (except for abusive cases where the applicant could not have been aware of the prior disclosure).

3) The declaration should preferably be produced upon filing of the application. However, since the declaration requirement is primarily designed to ensure legal certainty for third parties, it may be argued that the declaration would only have to be filed so as to make it possible for the Patent Office to include the declaration in the first publication of the application. The Swedish AIPPI Group is in favour of SPLT Articles providing for mandatory publication 18 months from filing date or priority date. Given such harmonisation arrangements, it might be sufficient to have the declaration filed as late as 16 months from filing date or priority date.

4. In order to serve its purpose the declaration should contain details on the prior disclosure.