Common Consultation Document
Re: User proposals for substantive patent law harmonisation
Industry Trilateral / FICPI / AIPPI
2022

The Industry Trilateral and the Group B+ are engaged in work on substantive patent law harmonisation. In the autumn of 2021, the Industry Trilateral released their "Elements Paper" of September 2020, a work in progress proposing a package of norms which could serve as a basis for achieving global substantive patent law harmonisation, and it was decided that the Group B+ delegations would consult their users on the package. Within Europe, it was decided that such a consultation should be carried out in a concerted manner, based on a Common Consultation Document, and also encompass other existing user proposals emanating from FICPI and AIPPI.

The present Common Consultation Document aims to collect feedback from European stakeholders with regard to proposed norms governing the grace period, prior user rights and conflicting applications.

BACKGROUND

I. Introduction

In the 21st century, globally, national patent systems present a fragmented landscape. International harmonisation of substantive patent law is an effort which has been ongoing for several decades, on and off. It is a challenging endeavour, but one which remains high on the list of priorities of stakeholders. Users of the system in particular often state that they need harmonisation, and many users have understood that for it to be achieved, change must be embraced by all.

The Group B+ is an informal forum composed of around 45 industrialised countries, as well as the European Commission and the EPO, which has been working on substantive patent law harmonisation.

Since 2014, the Industry Trilateral (composed of representatives from the American Intellectual Property Law Association (AIPLA), the Intellectual Property Owners Association (IPO), BusinessEurope and the Japan Intellectual Property Association (JIPA)) has been working on a proposal for a package of norms which could form the basis for international substantive patent law harmonisation, through a working group which has been meeting regularly in person and online.

In September 2020, the Industry Trilateral presented to the Group B+ delegations an updated version of their “Elements Paper”, but placed it under an embargo. This embargo was lifted in October 2021, releasing the document for public distribution. It contains their unfinished and not-yet-agreed draft proposal for a package of norms. Nevertheless, given the considerable investment of the Industry Trilateral in their paper and the innovations which the paper contains, it was considered appropriate and helpful to the process to consult stakeholders on their views at this juncture.

In November 2021, at a meeting of the Patent Law Committee of the European Patent Organisation, the member states agreed that there should be a concerted consultation of stakeholders in Europe, based on an agreed common consultation document, so as to be able to (i) compare the data yielded in each of the EPO member states, across jurisdictions, as well as across technical sectors, user size and activity profiles, and (ii) consolidate the results, to have a European overview of stakeholder positions.

However, the Elements Paper is not the only user input on the table. In 2018, in response to developments within the Industry Trilateral/Group B+, the International Federation of Intellectual Property Attorneys (FICPI) issued a paper entitled “FICPI Position on Patent Law Harmonization (Group B+)”, encompassing proposed norms on the grace period, conflicting applications and prior user rights.

Finally, over the years, and also partly in response to developments within the Industry Trilateral/Group B+, the International Association for the Protection of Intellectual Property (AIPPI) has produced a set of relevant Resolutions on: the grace period (2013); prior user rights (2014); publication of patent applications (2016); and conflicting applications (2018). The European delegations took the view that, although these Resolutions were not formally consolidated, considered together, they formed a coherent package.

The European delegations thus decided to extend the consultation beyond the Industry Trilateral package to both the FICPI Proposal and the AIPPI Resolutions. These user proposals are detailed and voluminous. All are appended in their integrity in Annexes I-III to this document. To facilitate the consultation of users, however, it was decided that the proposals would be summarised in table form, focused on the individual issues and proposed norms.

II. Scope of the consultation

The Industry Trilateral Elements Paper contains norms governing five areas: the definition of prior art, the grace period, 18-month publication of applications, conflicting applications and prior user rights. Of these areas, the definition of prior art and the rules governing the mandatory publication of applications at 18 months are arguably already harmonised throughout the world (with the exception of the United States), and the Industry Trilateral paper is essentially aligned on these points with the European Patent Convention (EPC). The FICPI and AIPPI proposals do not suggest any changes to these norms. Thus, in an

attempt to streamline and simplify, it has been decided to consult European users only on the norms relative to the **grace period**, **conflicting applications** and **prior user rights** contained in these user proposals. However, it should be remembered that these proposed norms would be part of a package including a harmonised definition of prior art and mandatory 18-month publication aligned with the EPC.

III. Background on the issues

Grace period

A grace period can be defined as a period of time prior to the filing of an application, during which an applicant can disclose their invention without losing the possibility of obtaining patent protection in that jurisdiction. Many countries have grace periods, which can be defined in different ways with different scopes. Japan and Korea have grace periods subject to strict statement requirements: if the applicant does not list a disclosure, it will not be graced. Australia does not have a statement requirement, but provides that prior user rights may be acquired by any third party who uses an invention prior to the filing or priority date, at a time when the invention was in the public domain, even if this is as a result of obtaining knowledge of the invention through a pre-filing disclosure by the applicant. The US has a broad grace period without a statement, and prohibits the acquisition of prior user rights throughout the grace period.

Europe currently operates under a strict novelty requirement, so that any disclosure of the invention prior to the filing date results in the invention no longer being considered new, and thus not being patentable. This is subject to two narrow exceptions found in Article 55 EPC: (a) the invention was disclosed as a result of an evident abuse of the applicant or their legal predecessor; or (b) the invention was displayed at an officially recognised international exhibition (i.e. an exhibition falling within the terms of the Convention on international exhibitions, and listed as such, which is extremely rare). Under this novelty requirement, whether a document forms prior art against an application or not can be simply assessed, often on the face of the document. If the disclosure date is known and prior to the filing date, the disclosure is prior art regardless of who published the item, so that drawing up validity and freedom-to-operate opinions is correspondingly simple and cost-effective, promoting legal certainty.

Conflicting applications

All patent systems must address the issue of an application having been filed before the filing or priority date of the application being examined, but published later, where both applications disclose common subject-matter. Such applications are said to “conflict” because the content of the earlier-filed application only becomes publicly available as prior art after the filing or priority date of the application being examined. In the absence of a rule giving prior art effect to the earlier-filed application as of its filing or priority date, it would thus be possible for two or more patents to be granted covering the same or similar subject-matter.

The treatment of conflicting applications is different under the legal regimes in Europe, the United States and Japan. In Europe, under the EPC, as well as under the national law of the EPC contracting states, earlier-filed, later-published applications (“secret prior art”) are relevant to the examination of novelty only. All applicants are treated the same and there is no anti-self-collision.

In the US, secret prior art is relevant to the examination of both novelty and inventive step, and “anti-self-collision” is provided for, advantaging the first mover by ensuring that their own prior applications will not constitute secret prior art against subsequent applications filed by them, although their prior applications will constitute secret prior art for any subsequent applications filed by third parties.

In Japan, secret prior art is relevant to the examination of a sort of “enhanced novelty”, so that the earlier application can destroy the novelty of the subsequent one even if there are minor differences, provided the inventions are "substantially the same", but earlier applications are not relevant for examination of inventive step, with anti-self-collision also applying.

There are likewise differences among the jurisdictions as to the conditions under which PCT international applications become secret prior art. In Japan and under the EPC, such applications become secret prior art as of the international filing or priority date only if they enter into the respective national/regional phase, which also entails that they have been translated into the prescribed language(s). In the US, PCT applications form secret prior art as of their international filing or priority date merely upon designation of the United States in the international application, i.e. at the date of their publication after 18 months.

Prior user rights

A prior user right is the right of a party to continue the use of an invention where that use began before a patent application was filed for the same invention. The main purpose of prior user rights is to strike a balance between the effects of the first-to-file principle on the one hand and the interests of third parties who have knowledge of the invention and have begun investing in the invention with the intention of commercially exploiting it on the other.

Prior user rights are provided for by the different national patent legislations and such provisions thus only have national effect. However, whilst the national provisions on prior user rights may have common ground, there are also differences in the conditions under which they may be acquired and the definition of their scope depending on the jurisdiction.

Prior user rights do not fall under the purview of the EPC, as they are a post-grant mechanism. They are nevertheless included in the harmonisation process as they are deemed by some to be relevant to the definition of a balanced grace period. The possibility of prior user rights arising where use of an invention has been made as a result of it having

been put in the public domain by an applicant's pre-filing disclosure may create a risk curbing the use of the grace period by applicants, which then increases legal certainty. If the grace period is invoked only exceptionally and not strategically, arguably, the patent system continues to operate on a file-first, disclose-later principle, as under the current EPC.

IV. Background on the user associations

The Industry Trilateral

The Industry Trilateral (IT3) was formed in 2003 for stakeholders to engage with the Trilateral Offices (EPO, JPO and USPTO) on substantive and procedural issues of patent law. As mentioned above, it is composed of representatives from four associations: AIPLA, IPO, BusinessEurope and JIPA.

AIPLA (American Intellectual Property Association) is a US national bar association of approximately 8 500 members (August 2021) who are engaged in private or corporate practice, in government service and in the academic community, representing both owners and users of intellectual property.

IPO (Intellectual Property Owners' Association) is a US-based international trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12 000 individuals (April 2021) who are involved in the association either through their companies or as inventor, author, executive, law firm or attorney members.

BusinessEurope is a federation of 40 national business federations from 35 European countries representing some 20 million enterprises of various sizes throughout Europe.

JIPA (Japan Intellectual Property Association) is a non-profit, non-governmental organisation which has 1 346 company members. It represents industries and users of the intellectual property system.

FICPI

Founded over 100 years ago, FIPCI (International Federation of Intellectual Property Attorneys) is a Switzerland-based international representative association for patent attorneys in private practice throughout the world, with about 5 500 members in 86 countries and regions, across six continents. For many years, FICPI has been engaged in an ongoing analysis of the grace period and related harmonisation topics. More recently, a FICPI Working Group was created to study specifically the harmonisation issues raised by the Industry Trilateral/B+ Sub-Group. The core FICPI Working Group comprised members from 11 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, resulting in the paper appended to this consultation document.

AIPPI

AIPPI (International Association for the Protection of Intellectual Property) is a not-for-profit, politically neutral international association based in Switzerland with about 8 000 members worldwide from more than 131 countries. Members of AIPPI are individuals interested in intellectual property protection on a national or international level and include lawyers, patent attorneys, patent agents and trade mark agents, as well as judges, scientists, engineers and corporations. AIPPI is organised into 68 National and two Regional Groups and membership is obtained by joining one of these groups. In countries where no group exists, membership is obtained as an independent member in the international organisation. Working method: a questionnaire on a specific topic is sent to all the country groups, which then produce a country report. All the country reports are then sent to the Reporting General Team, made up of one delegate from all the country associations, who draw up a draft resolution, which then gets amended and adopted in a plenary meeting.

Summary table of Industry Trilateral/FICPI/AIPPI proposals

Note:
"IT3"= Industry Trilateral
"N/A" = The issue has Not been specifically Addressed.
"PFD" = Pre-Filing Disclosure: a disclosure of the invention made by or for the applicant before the filing or priority date of their application.
"PUR" = Prior User Right
"EPC" = European Patent Convention
"PCT" = Patent Cooperation Treaty
Page numbers refer to the respective user association proposals annexed to this document.
Additional explanations are added in red text.

ISSUES	IT3	FICPI	AIPPI
Introductory comments	The IT3 harmonized package is intended to fairly balance the interests of all entities, large and small, individuals and universities, in a patent system that encourages innovation and protects the rights of innovators and third parties. (p. 3) A globally accepted set of principles would make patent rights more predictable, reduce costs and improve the efficiency of the patenting process. This objective could only be achieved through compromise, guided by best practices and fairly balancing the interests of applicants, third parties and society. (p.4)	FICPI has formulated positions on the three topics which would constitute a package solution which: - Is relatively simple and easy to understand - Is based on well-established principles of patent law, and - Strikes 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. (p.7)	Relevant AIPPI Resolutions are considered here although they have not been collated by the association into a consolidated proposal.

ISSUES	IT3	FICPI	AIPPI
GRACE PERIOD / NON-PREJUDICIAL DISCLOSURES	IT3 Elements Paper (2020)	FICPI Position on Patent Law Harmonisation (2018) (+Annex 1: FICPI/WP/2013/01)	AIPPI Resolution Q 233 (2013)
Statements of principle	A grace period is an exception to the absolute novelty standard and as such, should be established with criteria and qualifications that encourage inventors and applicants to "file first", while discouraging the adoption of a "publish first" policy that leads to uncertainty and unpredictability. (p.13) The grace period should be internationally harmonised and its application should be uniform and predictable in all jurisdictions. (p.13)	The grace period is provided as a strictly limited exception to the novelty requirement. (Annex 1, p.8) A PFD does not constitute a priority right; (p. 3) a first-to-disclose system should be avoided. (p. 7) FICPI characterises its grace period as "a safety net type, with incentives for those who disclose an invention to file a patent application as soon as possible", "in the interest of third parties and the public at large". (p. 3; Annex 1, p.1))The proposal contains two incentives to file an application as soon as possible after a PFD: independent disclosures by third parties in the interval between a pre-filing disclosure and the filing of the application form prior art; and prior user rights may accrue during that interval. (Annex 1, p.8)	"A grace period shall not establish a right of priority but rather shall enable to exclude from the state of the art as against the inventor or his successor in title, disclosures which occurred within the grace period." (p.2) An internationally harmonized law on grace period should establish a fair balance between the interests of patent applicants and the public. (p.3)
Duration	Not agreed. 6 or 12 months (See pp.15 and 18)	12 months (p. 2)	12 months (p.4)

ISSUES	IT3	FICPI	AIPPI
Calculated from *For reference, the period under Art. 55 EPC is calculated from the filing date only.	Priority or filing date, whichever is earlier (pp. 15 and 18)	The issue remains open. (See discussion in Annex 1, pp. 6-8.)	Priority or filing date, whichever is earlier (p.4)
Covering all types of disclosures by, for or derived from the inventor or their successor in title, regardless of medium or forum, and regardless of whether intentional or not	Yes (p.13 and 18)	Yes (Annex 1, p.6)	Yes (p.3)
Disclosures resulting from the proper publication of an application by an office at 18 months are not graced	Yes (p.18)	Yes (Implied)	Yes (p.3)
Disclosures of independent inventions made by a third party form part of the prior art (i.e. are not graced)	Yes* (p. 14 and 18) (*But see presumptions below under "burden of proof")	Yes (Annex 1, p.6 and 8)	Yes (p.3)
Burden of proof	The IT3 innovates by providing presumptions in certain cases: Where the content (i.e. subject-matter) of a third party intervening disclosure is the same or involves insignificant differences over the earlier PFD by the inventor/ applicant, the third party disclosure is presumed derived from the original applicant/inventor and	The burden of proof that a disclosure should be graced should initially rest on the applicant/ patentee (p. 3; Annex 1, p.6) and will in general be on the person who will benefit from or contests the benefit of the grace period. (Annex 1, p.6)	The burden of proof is on the party claiming benefit of the grace period to prove that the disclosure shall be excluded from the prior art (p.4)

ISSUES	IT3	FICPI	AIPPI
	would be graced (i.e. not form part of the prior art). If a part of the content of the third party intervening disclosure is the same or involves insignificant differences over the earlier PFD by the inventor/ applicant, that part of the disclosure is presumed derived from the original applicant/inventor and would be graced. Conversely, where the whole or a part of the third party disclosure involves more than insignificant differences over an earlier inventor/applicant disclosure, the whole disclosure, or that part, is presumed not derived from the original applicant/inventor and would thus not be graced but form prior art. All presumptions can be rebutted by further evidentiary submissions by the applicant or any third party. If the status of an intervening disclosure to be graced is challenged by an office or a third party (through a third party observation), the inventor/ applicant bears the burden of proving that the disclosure meets the requirements for it to be graced. If the applicant/inventor shows that there are only insignificant differences over an earlier disclosure by the inventor/ applicant, the office must find that they have met their burden.		

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	Thereafter, third parties may submit their own evidence through third party observations to show that the disclosure has not been derived from the inventor/ applicant. (See pp.14 and 18-19)		
Statement or declaration requirement	Statement required Obligation: Applicants are required to file a statement identifying the PFDs of the applicant which are to be graced, to provide notice to third parties. Not all disclosures must be listed: re-disclosures by the applicant of earlier PFDs already listed in the statement do not need to be listed separately if there are only insignificant differences between the re-disclosure and the prior PFD referenced in the Statement. (pp.16 and 19) The statement will indicate the nature of the PFD, when and where it occurred. Where the PFD is a written disclosure, a copy or means of accessing the document will be included. There is no agreement on the information to be produced if the PFD is a non-written disclosure. (p.16) For PFDs made (i) by the applicant or (ii) by another person acting for or from the applicant, the statement should be	A statement should not be mandatory (p.8) A voluntary statement could be filed, providing certain advantages to the applicant: there would be a presumption that PFDs listed in the statement are graced unless a third party proves otherwise. This would provide a strong incentive to file a statement where the applicant is aware of a PFD, without imposing a burden on the applicant. (p. 8)	No declaration requirement (p.4)

ISSUES	IT3	FICPI	AIPPI
	filed with the patent application or within 16 months of the PFD. (p.16) Where the statement is not filed in due time, it may be submitted later along with a declaration of unintentionality supported by further evidence if appropriate. (p.16) The listing of a PFD in a statement may be challenged by offices and third parties, in which case the applicant would bear the burden of proof that the PFD meets the requirements to be graced. (p.17) If no statement is filed, the grace period will not apply. <u>Measures to ensure the timely filing of the Statement</u>: An increasing sliding scale of administrative fees is proposed, to be set by the Offices. The fee for failure to file the statement in a timely manner would be at a level high enough to incentivise the applicant to exercise due diligence in identifying all relevant PFDs and file in a timely manner. (pp.17 and 19) For further measures, see the entries below on: (i) the Defence of Intervening User (DIU), and (ii) PURs, where knowledge of the invention has been derived from the applicant.		

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Publication of the application for which the grace period has been invoked	A further IT3 innovation: As a component of third party protection, the publication of the application would be accelerated to take place 18 months from the date of the earliest graced disclosure identified in the Statement. Accelerated publication gives the same notice to third parties as if the application had been filed on the date of the disclosure. (p.17)	No early publication of the application. Proposal: that offices be required issue a "Public filing notice" within 6 months of filing, containing bibliographic data, title of invention, IPC classification, priority claim, and any voluntary statement of a PFD, which would include the earliest date of publication and the type of disclosure (document, trials, oral presentation, exhibition, etc.) disclosing the contents of the PFD only. (pp. 8-9)	Invoking the grace period shall have no effect on the date of publication of the patent application (p.4)
Grace period may be invoked throughout the life of the patent In Japan and Korea, where there is a statement requirement, there are time limits for filing the statement, which also constitute time limits for invoking the grace period for disclosures by or for the applicant.	Not agreed. (See p.17)	Yes (Annex 1, p. 28)	N/A, this appears to be assumed.
Defence of Intervening User (DIU)	The IT3 proposes a new concept to incentivise the timely filing of the statement listing PFDs under the grace period:	N/A	N/A

ISSUES	IT3	FICPI	AIPPI
	A DIU would provide a defence for a third party who reasonably relied on a PFD being prior art because it was not identified in the statement or no statement was filed in a timely manner, but the applicant later claimed the benefit of the grace period. (p.26) The DIU would allow the third party to continue any activities begun as a result of such reliance. The third party's qualifying activities for the DIU and its scope would be the same as those for the PUR. (p.28) In order to obtain the benefit of the DIU, the third party would have to inform the office(s) of the PFD within a period to be determined, who would in turn inform the applicant. (p.26) The applicant would lose the right to grace the PFD if they did not file the statement in a timely manner after being informed of the PFD. (p.27) In order to ensure compliance with Art. 4B of the Paris Convention, while qualifying activities could begin prior to the end of the priority period, the DIU would not accrue until after the priority period expired. (p. 28) Thus, a gap would exist during which third party investment and activities could take place without a DIU arising.		

ISSUES	IT3	FICPI	AIPPI
PRIOR USER RIGHTS (PURs)	IT3 Elements Paper (2020)	FICPI Position on Patent Law Harmonisation (2018) (+Annex 3: FICPI/WP/2015/001)	Res. 228 – Patents (2014)
Statements of principle	Limited PURs affording a defence to infringement should be provided to fairly balance (1) the interests of a third party, who in good faith has used or made serious and effective preparations to commercially exploit an invention involving significant investment and (2) the interests of an independent innovator, who later seeks to patent that same invention. (p.20)	FICPI supports PURs as an essential element in a first-to-file or first-inventor-to-file patent system, and is often considered a necessary supplement to the grace period. (Annex 3, p. 1 and 5) Third parties may acquire prior user rights irrespective of a disclosure made by the inventor before the filing date under the grace period, provided that all other criteria for obtaining prior user rights are met. (p.3, Annex 3, p.2) The grace period should not affect the prior user rights of third parties. (Annex 1, p.6) The universal adoption of a grace period of a safety-net type wherein prior user rights may be acquired during the grace period does not change the basic principle of how a first-to-file system operates and motivates the applicant not to delay the filing of a patent application after a pre-filing disclosure beyond the necessary time to prepare proper application documents. (p.10)	Prior user rights are rarely invoked, but are nevertheless considered an important part of a balanced patent law system (p.4) The PUR should be recognised as an exception to the exclusive rights of the patent holder afforded by the patent (p.4) The three main justifications for PURs are balancing the effects of a first-to-file system with the right to lawfully continue an activity carried out in good faith, providing incentive for innovation and dissemination of information without unduly restricting investment, and preserving the freedom to choose between patent protection and secret use. (p.4) The issue merits further study, particularly with regard to the scope of the right. (p.4)

ISSUES	IT3	FICPI	AIPPI
Commercial use or serious and effective preparations to use may give rise to PURs	Yes (p.20)	Yes (pp. 9-10; Annex 3, p.3)	Yes (p.4)
Conditions for the PUR to arise	For example, the third party made a significant investment in the invention that is covered by a claim of the patent, including commercial use or serious and effective preparations for commercial use. The investment must be directed to the commercialisation of the patented invention, and must be more than activity directed to basic research or the acquisition and preservation of knowledge about the invention. At a minimum, the qualifying activity must be directed to the invention as set forth in one or more claims in the patent, and not simply a part thereof. (p.20) (See further explanations pp. 20-23) One view is that the court should use equitable rules that provide the court with discretion to fashion a fair scope of defence on a case by case basis. (p.22) Another view is that the court should use objective criteria to determine whether there is a PUR defence, to enhance predictability. (p.23).	Activities must be ongoing immediately before the critical date for PURs to accrue. (Annex 3, p. 3) The prior activities must be directed to subject-matter similar to that of the patent. (Annex 3, p. 3)	A PUR should be recognized when a party has used or made preparations to use an embodiment falling within the scope of the patent. (p.4)

ISSUES	IT3	FICPI	AIPPI
Critical date: qualifying activities must take place prior to earliest of the filing or priority date	Yes (p.20)	Yes (Annex 3, p.3)	Yes (p.4)
PURs when use based on non-public information derived from the applicant without his consent	No (If based on abuse or breach of confidence, p.21)	No (Annex 3, pp.4-5)	No
Use based on independent invention by the third party gives rise to rights	Yes (p.21)	Yes (Annex 3, p.4)	Yes (Not specifically mentioned, but derived from the good faith requirement, p.5)
Good faith requirement for PURs to accrue	No good faith requirement per se, but no PURs will accrue if the activities are based on "an abuse or breach of confidence".	Prior activities must be "legitimate" (Annex 3, p.4) See also entry below re: derivation.	Yes (p.5)
Prior user rights if the third party has derived his knowledge of the invention from the applicant, e.g. through a PFD.	In a nutshell, no activities based on derived knowledge from a PFD of the applicant give rise to a PUR unless (i) the prior use or preparations took place more than 18 months prior to the publication of the application, and (ii) the statement was filed late. (Please see explanations, pp.22 and 24.) No PUR accrues for activities conducted during the 18 months prior to the publication of the application. If the statement is filed with the application, publication of the	Yes, qualifying activities may be based on knowledge in the public domain at the time they started their activities, e.g. based on knowledge derived from a PFD made with the applicant/patentee's consent. (Annex 3, p.4) This is an essential component of the characterisation of a "safety-net" grace period, as it gives an incentive to file an application quickly once a PFD has been made. (p.10)	A PUR should only arise if the prior user has acted in good faith. Thus, it would appear that provided the prior user is in good faith, the answer would be yes. (Derived from the good faith requirement, p.5)

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	application is accelerated to 18 months from the first PFD, so that in practice, no PUR could be based on knowledge derived from a PFD. PURs would be available only for activities conducted prior to a date 18 months prior to publication of the application, i.e. where the statement was filed late, impacting upon the acceleration of the publication of the application, leaving a gap between the earliest PFD and the beginning of the 18-month period prior to the publication of the application barring accrual of PURs. (p.24) Thus, in case of derivation, the policy behind the PUR is not to preserve the investments of the third party, and balance the grace period, but to provide an incentive for applicants to file their statement (not their application) in a timely manner.	PURs can also be based on non-public knowledge derived from applicant, provided use started with the direct or implicit consent of the applicant ("implied licence"), without abuse, in particular where no contractual or implicit obligation prohibits the prior user from using or disclosing the invention. (Annex 3, p.4)	
Exceptions to the principle of PURs based on the nature of the entity holding the patent or the field of technology	No (p.25)	N/A	No PURs should be available in any field of technology and for any type of entity (p.5).
Burden of proof that prior activities justify a PUR	On prior user claiming the PUR (p.24)	On prior user claiming the PUR (Annex 3, p.3)	N/A

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Scope of PURs Change in embodiments	To the extent that a third party qualifies for the PUR defence against specific claims of a patent, the defence should allow for the continued practice of the inventions covered by these claims.(p.22) The defence does not extend to embodiments which were not the subject of the qualifying activities and otherwise infringe claims of the patent. (p.25)	Only minor modifications should be permitted but they must not affect the essence of the invention being exploited. All embodiments within the scope of the patent may not necessarily be permitted to be exploited by the prior user, only embodiments or modes of use that the prior user had used or made preparations to use at the critical date can continue to be used. (Annex 3, p.3)	A prior user right would be limited to embodiments within the scope of the patent which were used prior to the critical date, or "to substantially similar embodiments", and should not extend to the entire scope of the patent, beyond what was used or prepared for. (p.5) The issue merits further study. (p.5)
Loss of rights	Yes, if use of the invention is abandoned by the prior user. (p.23)	N/A	The PUR should lapse upon the abandonment of the use or of the preparations to use the invention. (p.4)
Transfer of PURs permitted only if transferred together with the related business within which it accrued	Yes (pp. 23 and 25)	Yes (Annex 3, p.3)	Yes (p.5)
Licensing under the PUR permitted?	No (pp. 23 and 25)	No (Annex 3, p.3)	No (p.5)
Territorial scope of PURs limited to the country in which the prior use/ preparations took place.	Yes (p. 22)	Yes (p. 4 and Annex 3, p. 5)	Yes (p.4) *In the case of a regional Unitary patent, the PUR should apply as an exception

ISSUES	IT3	FICPI	AIPPI
			to patentee's rights in all territories covered by the Unitary patent (p.4)
CONFLICTING APPLICATIONS	IT3 Elements Paper	FICPI Position on Patent Law Harmonisation (2018) (+ Annexes 4, 5 and 6)	AIPPI Res. Conflicting patent applications (2018)
Statements of principle	A coherent set of rules with regard to conflicting applications is needed to prevent the grant of multiple patents on substantially the same or identical inventions in the same jurisdiction and minimize the risk to third parties of multiple enforcement proceedings in the same jurisdictions; and to permit an appropriate scope of protection for incremental inventions. (p.7)	An applicant should not be favoured and given a dominant position just because they filed first: the second filer should have a fair chance of protecting their invention, provided it is patentable over the prior art and does not claim exactly the same subject-matter as the prior filer (p.7) In a first-to-file system, the only issue which needs to be addressed between first and second filers is the avoidance of double patenting. (p.10)	Due to differences in approach to the treatment of conflicting applications, it is common that a claim considered patentable in one jurisdiction is unpatentable in another. As a matter of principle, it would be beneficial to harmonise the treatment of conflicting patent applications (p.2)
"Distance" between the two applications, i.e. difference in content between the first and the second application.	Second application "must go beyond" novelty + "common general knowledge to one of ordinary skill in the technical field". (p.10) Common general knowledge encompasses, but is not limited to, information contained in textbooks. (p.11)	Applications are relevant for the examination of novelty only, as per the EPC (p.10).* FICPI considers this approach to be the simplest and fairest (p.10), and also considers it inappropriate to consider inventive step or enlarge the novelty assessment with reference to the common general knowledge in the art. (p. 11)	Applications are relevant for the examination of novelty only.* (p.2) The applicable standard for the examination of novelty should be identical for both secret and published prior art. (p.2) * I.e. under both FICPI and the AIPPI proposals, the matter of the second application must be new over the first, as per the EPC.

ISSUES	IT3	FICPI	AIPPI
Whole contents approach* *Reflects current EPO practice.	Yes (indicated by IT3 since September 2020)	Yes (p.11)	Yes The whole contents of the earlier application, other than the abstract, should be considered to form prior art against the second application. (p.2)
Anti-self-collision applies *Note that this is the case in Europe, the EPO's practice on this point was satisfactorily settled in case G1/15 by the EPO Enlarged Board of Appeal.	Yes (p.10) Anti-self-collision ensures that an applicant's own prior application will not constitute secret prior art against a subsequent application filed by them, although their prior application will constitute secret prior art for any subsequent application filed by a third party.	No All applicants should be treated the same. No need for anti-self-collision if multiple and partial priorities can be recognised within a single claim.* (p.10, 12 and Annex 5, p. 15)	No (p.2) Provided there is full recognition of multiple and partial priority rights for individual claims.* (p.2)
Anti-double-patenting	No two patents shall issue with claims that are of identical scope. (p.9)	Anti-double patenting should be limited to claims having identical scope in co-pending applications filed by same applicants with the same filing/priority date. (Annex 4, p.2)	N/A
PCT applications should form conflicting applications and become secret prior art at:	The date of publication of the application, as is the case for all other co-pending applications. (pp.10 and 11)	The date of entry into the national/ regional phase. (Annex 6, p.1) If the PCT application does not enter the national/regional phase, there is no need to avoid double patenting.	The date of entry into the national/ regional phase. (p.3)

Common Consultation Document

Re: User proposals for substantive patent law harmonisation
Industry Trilateral / FICPI / AIPPI
2022

QUESTIONNAIRE

PART I – Identification of the respondent

Name and surname: Weibel, Beat
Email address: beat.weibel@siemens.com
Phone number (optional):

Are you replying as:
- the representative of an entity filing patent applications either at the EPO or with your national office? If so please go to PART II.
- a representative or member of a user or stakeholder association? If so please indicate which association: VPP and go to PART III.

All information identifying the respondent will be kept confidential. The results of the questionnaire will be anonymous, and no comment received within the framework of this questionnaire will be attributed.

PART II – Information about the respondent

1. Please indicate your status/affiliation:

☐ Corporation
☐ University/research institution
☐ SME*
☐ Individual inventor
☐ Patent attorney/firm
☐ Lawyer/firm
☐ Other – please specify: _____

* As per the EU definition: having up to 249 employees and an annual turnover not exceeding €50 million or a balance sheet total not exceeding €43 million.

2. What is your primary area of technology or industry?

☐ Mechanics
☐ Electrical/electronics
☐ Telecommunications
☐ Computers
☐ Chemistry
☐ Biotechnology
☐ Pharmaceuticals
☐ Other – please specify: _____

3. Please indicate the EPC contracting state in which you have your residence or principal place of business:

_____

4. A. Please indicate how many patent applications (national, European or PCT) you have/your employer has filed in the last five years.

☐ None
☐ 5 or less
☐ More than 5 but less than 49
☐ More than 50

B. How many of those were PCT or European patent applications?

☐ None
☐ 5 or less
☐ More than 5 but less than 49
☐ More than 50

PART III – Survey

Prior to responding to the survey, please read carefully at least the introduction to this document and the table containing the summaries of the harmonisation proposals of the Industry Trilateral, FICPI and AIPPI. Please consult the Annexes containing the full proposals if you would like additional information to understand the issues.

1. **In your view, how important is international substantive patent law harmonisation for users of the European patent system?**

☐ Not important, as I am against harmonisation
☐ Not important
☐ Slightly important
☐ Neutral
☒ Important
☐ Very important
☐ Do not know / do not wish to answer

2. **In principle, are you in favour of a grace period?** *[More than one box may be checked]*

☐ Yes, regardless of its definition
☒ Yes, but only if it is defined as a "safety-net" grace period*
☒ Yes, but only if the grace period is itself internationally harmonised
☐ No, regardless of its definition
☐ Do not know / do not wish to answer

**A "safety-net" grace period can be generally defined as a grace period which provides measures balancing the advantages of the grace period for applicants with protections for third parties, such as a statement and/or prior user rights, so as to provide disincentives to the use of the grace period, thus discouraging a strategic use of the grace period and enhancing legal certainty.*

Please explain the reasons for your answer.

```
- legal certainty
- grace period as a ver limited exception to first to file
principle
- no support for publish first patent second approach
```

3. Please rate each of the three packages from 1-6, as defined below :

1. Would support as a way forward
2. Rather positive opinion
3. Neutral
4. Rather negative opinion
5. Unacceptable
6. Do not know / do not wish to answer

	IT3 Elements Paper	FICPI Proposal	AIPPI Resolutions
Rating	2/4	5	5

4. If you have answered "4. Rather negative opinion" or "5. Unacceptable" for any of the packages, please indicate below the main reason(s) for this rating for each of the packages.

1. IT3 Elements Paper

anti self collision if conflicting applications

2. FICPI Proposal

- no statement needed for GP
- GP may be involved throughout the life of the patent
- good faith needed for PUR

3. AIPPI Resolutions

see before

5. Please indicate which package you would prefer to see form the basis for future work on substantive patent law harmonisation:

☒ IT3 Elements Paper
☐ FICPI Proposal of 2018
☐ AIPPI Resolutions

6. Please identify the main reason(s) for your preference under question 5.

7. Please rate on a scale from 1 to 6 the norms relating to the grace period as proposed in the three packages considered:

1. Would support as a way forward
2. Rather positive opinion
3. Neutral
4. Rather negative opinion
5. Unacceptable
6. Do not know/do not wish to answer

Issue	IT3 Elements Paper	FICPI Proposal	AIPPI Resolutions
Grace period	2	5	5

8. **Please rate on a scale from 1 to 6 the norms relating to conflicting applications as proposed in the three packages considered:**

    1. Would support as a way forward
    2. Rather positive opinion
    3. Neutral
    4. Rather negative opinion
    5. Unacceptable
    6. Do not know/do not wish to answer

Issue	IT3 Elements Paper	FICPI Proposal	AIPPI Resolutions
Conflicting applications	4	2	2

9. **Please rate on a scale from 1 to 6 the norms relating to prior user rights as proposed in the three packages considered:**

    1. Would support as a way forward
    2. Rather positive opinion
    3. Neutral
    4. Rather negative opinion
    5. Unacceptable
    6. Do not know/do not wish to answer

Issue	IT3 Elements Paper	FICPI Proposal	AIPPI Resolutions
Prior user rights	2	5	5

10. **Do you have any comments with regard to the proposals which you would like to share ?** *[Include possibility to upload a document]*

End of Questionnaire