



Standing Committee on Patents

Questionnaire on the Publication of Patent Applications

Introduction

Many of the world's national and regional patent systems provide a time limit by which a patent application is made public. This is commonly set at 18 months after the date of filing or priority.

In return for (possible) patent protection, the inventor(s) and/or any other entitled parties (collectively referred to as the "applicant") must disclose the alleged invention so that it can be made public. This allows third parties to be made aware of the (alleged) contribution to the state of the art.

The main purpose of the publication of patent applications is thus to strike a fair balance between the interests of the applicant and those of third parties. Specific considerations in relation to the legal principle of publicizing patent applications within a certain timeframe are set out below.

Background and discussion

The publication of patent applications allows third parties to take note of technological developments and to make informed decisions about their own strategy (and perhaps their own research and development efforts) in relation thereto.

By providing a timeframe for publication of applications after filing, an applicant can decide whether or not to pursue the application (so as to retain the possibility to protect the invention as a trade secret).

History

A discussion of the origin of the 18 month publication period can be found in the WIPO records of the 1970 Washington Conference on the PCT. On page 243 of the Conference Documents¹, reference is made to a 1956 preliminary

¹ Available at

report by a patent law revision committee in The Netherlands as a likely origin of the 18 month publication term. This report² suggested that patent applications be made public within eight months after completion of initial searching (which then took about 18 months), but in any event not earlier than 18 months after the date of filing or priority. The maximum term for making public patent applications would accordingly be 26 (18+8) months. It was also suggested that, prior to deciding on the term for publication, the practices of Germany and the Scandinavian countries in relation to pre-grant publication should be assessed.

The elements of the Dutch proposal were referenced by a joint patent law review committee of the Scandinavian (Nordic) countries in 1961. The Nordic report³ references an 18 month pre-grant publication period in The Netherlands (as opposed to the proposed 26 month publication period). Reference to the Dutch proposal was also made in the final report.⁴ After discussions between (committees of) The Netherlands, Germany and the Nordic countries, The Netherlands was the first country to include the 18 month term in its patent law in 1964.⁵ By the time of the WIPO conference in 1970, the 18 month term had been introduced into the patent laws of 7 European countries (The Netherlands, Denmark, Finland, Norway, Sweden, Germany and France).

Europe

Under the European Patent Convention (the "EPC"), (European) patent applications are published (as soon as possible) after expiry of 18 months from the filing or priority date. The applicant, however, may request early publication so that its application is part of the state of the art (this is relevant because under the EPC, patent applications filed but not published may comprise 'fictional' prior art that can only be invoked to attack the novelty of a patent).

<http://www.wipo.int/export/sites/www/pct/en/texts/pdf/washington_p171_to_538.pdf>

² Bijblad bij de Industriële Eigendom 1956, no. 5, p. 54 - 61

³ Preliminaer betenkning angående nordisk patentlovgivning. Avgitt av samarbeidende danske, finske, norske og svenske komitéer. (December 1961) p. 219

⁴ Betenkning angående nordisk patentlovgivning: Avgitt av samarbeidende danske, finske, norske og svenske komitéer. (NU 1963:6) p. 246 and p. 248-249.

⁵ Dutch Patent Act 1910, Article 22C (Stb. 1963, 260)

Under the EPC, the publication of a patent application also confers 'provisional' protection, which may not be less than that which the laws of the respective European Member State attaches to the compulsory publication of unexamined national patent applications (including the right to claim reasonable compensation from any party that makes use of the invention such that they would be liable under national law for infringing a national patent).

North America

Under the laws of the United States, pending utility applications are published promptly after the expiration of a period of 18 months from the earliest priority date unless subject to a secrecy order. The applicant can request that the utility application be published earlier than the 18 month date. The applicant can also file a non-publication request if "the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at 18 months after filing". Provisional and design applications are not published, but the provisional application is publicly available via the USPTO website after any utility application claiming priority from the provisional is published.

In the United States, the applicant is entitled to "provisional rights" based on the published patent application. Specifically, these "provisional rights" provide the applicant with a reasonable royalty for infringement of the published claims if: (i) the invention as claimed in the resulting patent is "substantially identical" to the invention as claimed in the published patent application; and (ii) the infringer had "actual notice" of the published patent application and, where this right arises from an international application that was published in a language other than English, a translation of the international application into English.

In Canada, pending applications are published after a confidentiality period of 18 months from the earliest priority date. The applicant can request early publication. An application will not be published if withdrawn by 16 months of the earliest priority date. The Minister of National Defense can request an application or patent to remain secret in the public interest (similar provisions are found in the United States and various other countries). Unpublished domestic applications are only considered for novelty, not obviousness. A person is liable to pay reasonable compensation to a patent owner for acts from the date of publication that would have constituted an infringement if the patent had been granted on the date of publication. The courts have clarified

that the issued claims must be essentially identical to the claims of the published application, and reasonable compensation is a reasonable royalty.

Asia

In Japan and Korea, for example, procedures have been adopted to address delay in examination of patent applications, such as patent applications that have not been made public for long term, redundant researches and investments by industries and destabilized industrial activities. A patent application is published after expiry of 18 months from the filing or priority date. It is said that the 18 month term was decided upon for equal treatment of both domestic and foreign applicants taking into consideration a 12 month priority period, a 4 month period for the submission of priority documents and a 2 month period for the preparation of publication. The applicant may request earlier publication. Patent applications relating to defense matters filed under the US-JP bilateral agreement remain secret until cancellation of secrecy. Further, parts of patent applications that contravene public morality or public order are excluded from publication.

Latin America

In the Andean legislation (Decision 486), applicable in Peru, Bolivia, Colombia and Ecuador for example, the term for publication of a patent application is set out in Article 40: within 18 months after the filing date in the Member Country concerned or, where priority is claimed, after the date of application, the file assumes a public nature and shall be open for consultation. The competent national office must order the publication of the application. The applicant may in any event request publication of the application at any time after the examination has been concluded, in which case, the competent national office must order publication. An application filed and not made public is kept confidential and may not be consulted other than by the applicant or persons authorized by the applicant.

Previous work

AIPPI

Publication of patent applications was studied in Q89 (Amsterdam ExCo of 1989), which is part of the series of resolutions related to a WIPO draft Patent Law Treaty concerning the harmonization of substantive provisions of patent law that never became final. Article 6 of the draft Patent Law Treaty *inter alia* provided that patent applications would automatically be made

public 18 months after the date of filing of the application or the priority date.

In the resolution on Q89, it was set out that AIPPI (in general) supported the WIPO draft. AIPPI also resolved that:

- the requirement of publication should also be considered fulfilled if the application is 'laid open' for public inspection;
- publication should not occur if there is no intent by the applicant to pursue the application;
- no publication should occur if the application is finally rejected without the possibility of an appeal;
- there should be a specific point in time up to which the applicant can withdraw its application without it being published, which period for withdrawal should be as long as possible (but no shorter than 17 months after filing or after the priority date);
- any deviations from these principles in relation to "national security" should be limited;
- if a patent is granted prior to the expiration of 18 months, the original application should be laid open for public inspection;
- in case of an internal priority or a continuation-in-part (hereinafter referred to as a "CIP") filed in time for publication at the expiration of 18 months, the completed, modified application should be published and the file should be made available for public inspection, so that third parties have access to the original application;
- in the case of a continuation in part (CIP) filed after the expiration of 18 months or so shortly before that it can no longer be taken into consideration, publication of the CIP should occur as soon as possible;
- rules should also be in place in relation to the publication of divisional applications; and
- information obtainable from the respective patent office should be possible by any technical means, but for the convenience of small- and medium-sized companies at least also on paper.

Objectives and Principles of the B+ Sub-Group

On 27 May 2015, the B+ Sub-Group (comprising representatives from the European Patent Office and the Patent Offices of Canada, Denmark, Germany, Japan, Korea, Spain and the United States of America) presented its Objectives and Principles, *inter alia* in relation to the issue of the publication of applications. In its report, the B+ Sub-Group stated the following principles:

- there should be a clear time limit by which information about a potentially patented invention will be made public;
- the timing of publication should provide for prompt dissemination of knowledge from all pending patent applications wherever filed;
- pending patent applications should be published promptly after the expiry of a globally agreed timeframe;
- the timeframe should balance the interests of inventors/applicants and those of third parties;
- Patent offices should be able to delay or suppress publication of a pending application in exceptional circumstances; and
- applicants should be able to request publication of an application prior to the globally agreed timeframe if they wish, as long as the requirements for publication under the applicable law are met.

The report noted that 18 months is an appropriate timeframe and that patent offices should be able to delay publication of a pending application beyond 18 months, or suppress publication of information within an application, in exceptional circumstances, namely (i) if publication would be prejudicial to public order, morality, or national security, (ii) if the application contains offensive or disparaging material and/or (iii) if a court order specifies that an application should not be published.

In its comments on these Objectives and Principles, AIPPI agreed with the above principles, noting that AIPPI in Q89 supported a proposal for extending the time limit for publication to 24 months. AIPPI also stated that publication should not occur when an application has lapsed due to failure to prosecute in a timely fashion (without a pending application to resume prosecution) or when the application is rejected (and no appeal of the decision to reject is pending). AIPPI also stated its opinion that the patent system should not be

an instrument for censorship and therefore questioned the use of vague concepts such as “morality” or “offensive or disparaging” material as the basis for suppressing the content of a patent application.

Tegernsee Group

During the second meeting of the “Tegernsee Group,” attended by heads of offices and representatives from Denmark, France, Germany, Japan, the UK, the USA and the EPO in April, 2011, the publication of patent applications was one of four topics identified as being key to harmonization (along with the grace period, prior user rights, and the treatment of conflicting applications). The Tegernsee Group mandated the Tegernsee experts group to prepare reports on each of these topics. The report on 18-month publication was published in September, 2012, and is available on the EPO website. The third meeting of the Tegernsee Group took place in October, 2012, during which it was agreed that the next step in the process would be to conduct broad surveys of stakeholders in each region. In September, 2013, at its fourth meeting, the Tegernsee Group approved the Reports on the Tegernsee User Consultation drawn up by the individual delegations. In April, 2014, the Tegernsee Group approved the Tegernsee Final Consolidated Report, concluding the work cycle of the Tegernsee Experts on the four topics including 18-month publication. The Final Consolidated Report is available on the EPO website.

In its report of 8 April 2014, the Tegernsee Group presented, *inter alia*, the following conclusions:

- the majority of the respondents agree that there should be no opt-out exception to the 18-month publication of applications and have not been negatively affected as a result of another party opting out;
- a large majority of the European and U.S. respondents agreed that if a jurisdiction requires publication at 18 months, the competent authority should also be required to provide the applicant with search and/or examination results sufficiently in advance of publication to allow the applicant to decide whether or not to withdraw the application prior to publication; and
- the majority of respondents also agree that 18 months is a reasonable period of secrecy from the standpoint of applicants.

Questions

Groups are invited to answer the following questions under their national laws:

I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

According to section 16 of the Patents Law, 1967 (“**the Patents Law**”), the Registrar of Patents shall publish online, as soon as possible after the filing of the patent application, the name of the invention, the name of the proprietor of the patent application, its number and date. In addition, if priority is claimed from another Convention State or a state which is a member of WTO, the name of that State, the priority date and the number (or other identification) of the patent application claiming priority will also be published. Subject to further approval by the Knesset Constitution, Law and Justice Committee (*i.e.*, the legislature in Israel), the Minister of Justice may order for the publication of additional details.

According to section 16A of the Patents Law, the Registrar of Patents shall publish online, as soon as possible after a period of 18 months has elapsed since the filing of the patent application, a notice containing a list of all patent applications whose file wrapper will be open for online inspection by the public.

Prior to amendment of the Patents Law (and the subsequent enactment of section 16A of the Patents Law), patent applications were published only following their acceptance, *i.e.*, once their examination has been concluded.

Please see our answers to questions 2 and 4 below for further details concerning the determining date.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

The publication of patent applications occurs automatically (in the sense that there are no special requirements for doing so), and takes place as soon as possible after a period of 18 months has elapsed since the filing of the patent application. If a patent application claims priority, the publication will take place as soon as possible after a period of 18 months has elapsed since the

filing of the priority patent application (whichever date is the earlier).

In the case of an international patent application, the patent application will be published automatically 45 days after the applicant has satisfied the requirements for entering the national phase as set out in the Patents Law, namely: (1) payment of the national fee, (2) submission of a copy of the international patent application (unless a copy has already been submitted according to the requirements of the relevant treaty), and (3) submission of a certified copy of the international patent application in English (if the international patent application was filed or published in English).

There are exceptions to this automatic publication rule as further explained in our answers to questions 9 and 10 below.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

If a patent application claims priority, then publication will occur as soon as possible after a period of 18 months has elapsed since the filing of the patent application on the basis of which the priority is claimed. If the claimed priority is based on more than a single earlier patent application, then the 18-month period will begin on the earliest date of those applications.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

Yes. The applicant may withdraw its application, without it being published, at any point before the "determining date", being the date falling 18 months after the date on which the patent application is filed, or a date falling 18 months after the priority date, whichever is the earlier ("**the determining date**").

In the case of acceptance, the patent application will be published, which may theoretically occur before the 18-month period has elapsed. Thus, the applicant's ability to avoid publication by withdrawing its patent application is relevant for so long as the patent application has not been accepted before the determining date.

5. What parts of a pending patent application are published?

All parts of a pending patent application are published, including the specification, the claims and the drawings.

6. Does a published pending patent application give rise to provisional rights (or

any type of interim protection) in your jurisdiction and, if so, to what extent?

According to section 179 of the Patents Law, an action for infringement may be brought only after grant of the patent; however, if an action for infringement is brought, then the court may –

- (1) grant *reasonable royalties* for an infringement committed after the date of publication under section 16A and before the date of publication under section 26, if the patent (as granted) is found to have been infringed and the claimed invention in the patent is substantially identical to that claimed in the patent application which was published under section 16A; or
- (2) grant relief for an infringement committed after the date of publication pursuant to section 26.

Thus, a patent owner may be entitled to retroactive damages.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

No. An unpublished pending patent application does not give rise to any such provisional rights.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

According to the Patent Laws, an applicant has no right to request early publication so that its application, when filed, forms part of the state of the art. It should be noted, however, that an applicant may request early examination of its patent application.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

A pending patent application cannot remain confidential after 18 months have elapsed from its date of filing (or the applicable priority date), unless the subject of the invention concerns matters of national security or issues related to nuclear energy which, in and of themselves, are sensitive, classified and confidential.

10. Will a lapsed, abandoned or withdrawn patent application be published? If

not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

A patent application will not be published if it is refused or withdrawn, or if the fact that it was accepted has already been published, before the determining date. In all those cases the applicant need not apply specifically requesting its non-publication. Avoidance of publication is "automatic".

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

Continuation and continuation-in-part (CIP) applications are not allowed under the current Israeli patent system (*see, inter alia*, decision of the Registrar of Patents in Opposition to Patent Application No. 136482 *Albemarle Corporation v. Bromine Compounds Ltd.* (published in "Nevo", 20.8.2007)). The position in Israel regarding the publication of divisional applications is the same as that taken with regard to the publication of a patent application in the ordinary course. No specific section of the Patents Law deals with the publication of divisional applications.

II. Policy considerations and proposals for improvements to your current system

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

The Patents Law as currently in effect has in place a provision specifically catering for this issue.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

No.

The publication of a patent application has a deterring effect in view of the fact that damages for infringement can be received retroactively. Such deterring effect can be perceived as *de facto* monopoly. If a right to request early publication is allowed, some manufacturers may decide not to take the risk of entering the market or to avoid it due to the costs associated with assessing such risk. This outcome can be viewed as an over-deterrence.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

N/A

15. Should there be a right for the patentee to withdraw the application before publication?

Yes. That right already exists under the Patents Law ([see](#) in this regard our response to question 4 above).

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

- a. with respect to the patentee's own subsequent patent applications; and
- b. with respect to third party patent applications?

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

We believe that, if possible, the Patent Office should be required to provide its initial assessment of the validity of the patent application before the applicant is required to decide whether to withdraw its patent application. In practice, the examination process does not yield an initial assessment prior to expiry of the 18 month period, so that the applicant does not have the necessary feedback concerning the validity of the claimed invention. In this context, it should be noted that the average waiting time for first examination was 30.4 months (at the end of 2015).

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:

- a. the patent office to provide the results of its initial assessment?;
- b. the applicant to decide whether to withdraw the application?; and
- c. the application to be published?

a. We are of the view that 12 months would be an appropriate time limit for the Patent Office to provide the results of its initial assessment. This would then allow the applicant to answer the first office action and presumably ascertain the position of the Patent Office which can still be considered as part of the initial assessment.

b. We are of the view that the current time limit – *i.e.*, prior to the expiry of the 18-month period – is appropriate.

- c. We are of the view that a patent application should not be published long before its acceptance. In this regard, we believe that a 24-month waiting period (instead of the current 18-month period) would be more appropriate.
19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:
- a. on the initiative of the patentee;
 - b. on the initiative of the patent office; or
 - c. on the initiative of third parties (such as other governmental agencies)?

We do not believe there should be any exceptions to the automatic publication of patent applications, other than for national security reasons (as set out in the Patents Law as currently in effect).

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

N/A

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

Continuation and continuation-in-part applications are not allowed in Israel.

22. What proposals would you make to improve your current system?

Retroactive damages should be allowed only if written notice is given to the infringer and the alleged infringement continues beyond a reasonable time after receipt of such notice by the infringer.

Complementary arrangements should be considered including, *inter alia*, anonymous third party observations which (unlike the current situation) should be allowed throughout the examination process until the patent is granted.

In addition, third party requests for early examination should be allowed, as well as compensation for groundless threats of infringement proceedings and compensation in cases where use of the invention was avoided because of the publication.

Finally, the applicant should not be allowed to request an extension of time before examination (*i.e.*, a request for delaying the examination process).

These complementary arrangements are all aimed to filter out, as early as possible, certain patent applications that are unjustified and in order to avoid unnecessary delays in the examination process of the pending application, which application was later found to be without basis.

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

Yes.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

We believe that an arrangement that allows the applicant to withdraw its patent application (and, thus, avoid its publication) is a balanced one.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

We hold the view that exceptional circumstances should be defined frugally – only when real national security issues are at stake. Otherwise, if "public order" or "morality" standards are used as grounds to delay or suppress publication, there is a significant risk of the law becoming arbitrary and unclear.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

Please see our answer to question 18(c) above.

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

We hold the view that the aspiration for harmonization in relation to the

publication of patent applications must take into consideration other factors which influence the overall effect of the patent system. These factors include the question as to whether damages are allowed from the date of publication (including the type of damages).

Procedure

It would be most helpful if the National Groups would fill out the Questionnaire and send in their answers to the General Secretariat of AIPPI (StandingCommittees@aippi.org) by 3 August 2016.

For inquiries, please contact either of the following members of the Standing Committee on Patents.

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