Study Question

Submission date: April 30, 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

Yes, secret prior art is available against the claims of the later-filed application for novelty-defeating purposes in the Netherlands.

Background

Dutch patent law makes a distinction between European patents with a designation for the Netherlands and national patents. The stipulations covering both patents are similar, but not identical. European patents are generally governed by the European Patent Convention ("EPC") whereas national patents are governed by the Dutch Patent Act ("DPA").

European patents

Secret prior art is available against the claims of the later-filed application for novelty-defeating purposes. In particular, Article 54(3) EPC stipulates that the content of a European patent application shall be considered as comprised in the state of the art, provided that (i) the application has an earlier filing or valid date of priority and (ii) has been published on or after the date of the European patent application under examination. It is required that the conflicting earlier European patent application was still pending at its publication date (and has thus not been withdrawn or otherwise lost pendency before the date of publication). [1]

A conflicting international application under the Patent Cooperation Treaty ("PCT") will also constitute secret prior art once it has entered the European phase, which entry requires the fulfilment of the following conditions as laid down in Rule 165, being that (i) the European Patent Office ("EPO") has been designated in the international application and (ii) where necessary, the applicant has supplied to the EPO a translation of the international application into an official EPO language according to Art 153(4) and Rule 159(1)(1) and (iii) the applicant has paid the filing fee according to Rule 159(1)(c).

By contrast, national applications do not form part of secret prior art under the EPC. [2] However, once the grant of a European patent with a Dutch designation has been published by the European Patent Office ("EPO"), the patents have the same legal effect and the same rules apply to both patent types of patent (Article 49(1) DPA). Although as such applications are not a bar to the grant of a European patent, national rights of earlier dates can be invoked, after the grant of the European patent, in national proceedings as a ground for revocation. Pursuant to Article 139(2) EPC, a national patent application and a national patent in a contracting state shall have with regard to a European patent designating that contracting state the same prior right effect as if the European patent were a national patent.. Article 75(2) DPA provides that the Dutch part of a European patent may be revoked on the basis of secret prior art of an earlier national patent application in Dutch court proceedings.

National patents

Similarly, secret prior art is available against the claims of the later-filed application for novelty-defeating purposes in the context of national patents. Under Article 4(3) DPA, the content of national Dutch patent applications will form part of the state of the art, provided that (i) the application has an earlier filing or valid date of priority and (ii) has been registered on or after the date of the national Dutch patent application under examination.

Pursuant to Article 4(4) DPA, the state of the art also comprises the content of European patent applications and EURO-PCT applications (international PCT applications for which the European Patent Office is a designated or elected Office). It is noted that The Netherlands are automatically designated for every European patent application and EURO-PCT application by virtue of the European Patent Convention.

Footnotes

1. ^ *LBA 9 December 1981, J5/81, ECLI:EP:BA:1981:J000581.19811209 (Hörmann).*

2. ^ *TBA 27 March 1990, T550/88, ECLI:EP:BA:1990:T055088.19900327 (Mobil).*

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

European patents

The entire contents of the secret prior art are available. The "content" referred to in Article 54(3) EPC is to be interpreted as the whole disclosure, i.e. the claims but also the description and drawings. [1]

The content does not include any priority document (having the purpose to merely determine to what extent the priority date is valid for the disclosure of the European application) nor equivalents. [2]

National patents

Similarly, the entire contents of the secret prior art are available, as the DPA also follows the whole content approach

Footnotes

1. ^ *See e.g. District Court of The Hague 13 July 2003, ECLI:NL:RBSGR:2003:AP0274 (SmithKline Beecham/Synthon), but also TBA 7 July 1993, T447/92, ECLI:EP:BA:1993:T044792.19930707 (Mitsubishi Denki Kabushiki Kaisha).*

2. ^ *TBA 20 January 1987, T167/84, ECLI:EP:BA:1987:T016784.19870120 (Nissan).*

..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 applied for evaluation of novelty in the context of secret prior art is identical to the standard applied to publicly available prior art.

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

No, the secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness in the Netherlands.

European patents

Secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness. Pursuant to Art. 56 EPC, secret prior art (within the meaning of Art. 54(3) EPC) shall not be considered in deciding whether an invention involves an inventive step.

National patents

Likewise, secret prior art is not available against the claims of the later-filed application to show lack of inventive step / obviousness, as secret prior art is also explicitly excluded as prior art for the purpose of determining obviousness under Art. 6 DPA.

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

n.a.

..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.***

n.a.

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

n.a.

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, this does not change the answers to questions 1(a) and 1(b).

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

No

Please Explain

European patents

A conflicting international application under the PCT that entered the European phase will constitute prior art if the filing fee has been validly paid and, where applicable, the translation into one of the official languages has been filed (Rule 165 EPC).

National patents

The Netherlands can, at this point in time, not be designated directly for entry in the national phase; the Netherlands can only be entered by means of a European Patent Application. Should the possibility arise in the future that the Netherlands may be designated for direct entry in the National phase, this Group considers it to be likely that successful entry in the national phase is a condition to qualify as secret prior art.

1.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

Yes, see above under question 1(a).

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, see above under question 1(a)(i).

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?

See above under question 1(a)(ii).

1.a.ii 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?

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

No, see above under question 1(b).

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

n.a.

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

n.a.

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

n.a.

2.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?

n.a.

2.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

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

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

No

Please Explain

No, see above under question 1(a).

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

Yes

Please Explain

Yes, see above under question 1(c)(ii).

.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

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

Our group is of the opinion that the present legislation provides an appropriate definition of how to deal with secret prior art.

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

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

No

Please Explain

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

No

Please Explain

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

No

Please Explain

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

No

Please Explain

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

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

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.

Yes

If YES, please respond to the following questions without regard to your Group

Yes, our Group does consider that harmonisation is desirable for all areas. Patent law is already harmonised to a very high level, compared to for example copyright, but on this particular topic, practices diverge between jurisdictions.

To provide applicants, licensors and licensees with the legal certainty they require for doing successful business, harmonisation in this area is highly desirable. For the same reason, this group strives for a clear, small and simple set of rules for the assessment of a later-filed application in view of secret prior art, without the need of complex and expensive legal assessments on a per-country basis.

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 are unrelated.***

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

Yes

Please Explain

Preliminary note *from the Dutch group: the answers to question 7 are provided irrespective from whether the inventors and/or applicants are the same or different. This Group is of the opinion that there is no reason to distinguish cases having the same or different applicants/inventors. The Group realises that this may result in self-collision of patent applications having the same inventors and/or applicants. Therefore, the Dutch group proposes that part of the harmonisation efforts is directed at an advice to the effect that in cases where the later-filed application claims priority of the secret prior art, there can be no collision.*

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

Yes, in the view of the Dutch group, the entire contents of the secret prior art should be available. In other words, the "whole contents" approach should prevail over the "prior claim" approach. An important reason for this is that claims may be amended over the examination procedure. If subject-matter that may be claimed by a later application is to be dependent on claims of secret prior art, such later application can only be examined after abandonment or grant of the secret prior art application or any divisional application thereof (if the prior claim approach is strictly applied). Effectively, this may prevent the later application is ever examined, which is highly undesirable.
Such effect to novelty should only apply if there would be any realistic possibility of two patents in the same jurisdiction that would have exactly the same scope of protection (see c) for further details).
If there is no such realistic possibility, for example if the secret prior art related to jurisdiction X only and the later-filed application relates to jurisdiction Y only, the answer is no. Also, another reason for the Dutch group's preference of the "whole contents" approach is that the secret publication may describe aspects of the described invention which are not incorporated in the claims (e.g. as a consequence of the first-to-file system as implemented in Europe). Such described but not claimed aspects do form part of the disclosure of the secret prior art, and should therefore be taken into account for the evaluation of novelty of the later-filed application.

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?***

In the opinion of the Dutch group, there should a single standard for the evaluation of novelty; it has to be assessed what the skilled person is able to directly and unambiguously derive from the secret prior art as filed - and later published. So yes, the standard for evaluation of novelty of secret prior art 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

No, such secret prior art should not be available against the claims of the later-filed application to show lack of inventive step / obviousness. An important reason for this is that at the filing date or priority date of the later-filed application, the secret prior art is not available to the skilled person. Therefore, at the filing date or priority date of the later-filed application, the skilled person would not be able to use the information in the secret prior art to combine it with publically available prior art to arrive at subject-matter of the later-filed application. Taking secret prior art into account for assessment of inventive step or obviousness would therefore conflict with the general concept of how inventive and obviousness are defined and assessed. Such conflict is detrimental to the objectives of providing a clear, small and simple set of rules and it therefore highly undesired.

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

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

7.b.ii 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?

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

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

Yes

Please Explain

Yes, the concept of using secret prior art in the assessment of novelty of an invention is to offer a solution for a practical issue arising in the first-to-file system. Secret prior art is only to be used in jurisdictions where there is a realistic possibility that a later-filed application might result in a patent with the same scope of protection as the secret prior art may result in.

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

Yes

Please Explain

Yes, it certainly matters whether the international application actually enters the national phase in the applicable jurisdiction. Only if the international application actually enters the national phase, a realistic possibility exists that the secret prior art and the later-filed application may result in patents having the same scope of protection.

7.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

No, the date of entry of the international application in the national phase should not matter. If the secret prior art enters the national phase, it is presumed to have been filed at the earliest priority date of the secret prior art. Please note that with multiple priority dates, different parts of the secret prior art may have different priority dates.

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?***

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

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?***

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?***

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

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

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

8.b.ii ***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?***

8.b.iii ***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?***

8.b.iv ***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.)?***

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

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

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

8.c.ii *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?*

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:*

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

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

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

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

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?*

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

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:***

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:***

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

The Unitary Patent Regulation, which is expected to be enter into force in the future, also addresses the issue of secret prior art. In particular, Art. 3(1) of the Unitary Patent Regulation 1257/2012 (UPR) provides that "[a] European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection. A European patent granted with different sets of claims for different participating Member States shall not benefit from unitary effect." Unlike EU trade marks, Unitary patents (UPs) cannot be converted into national EPs. Since the CJEU has not yet interpreted this provision, it is not fully clear what will happen with a UP if after the grant of the unitary effect there is a collision with an earlier filed but later published application for a national patent under Art. 139(2) EPC. With respect to EPs, the EPs for all other countries are not affected, but for UPs the situation is not yet fully in view of the same set of claims rule of Article 3(1) (UPR).

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

n.a.