

Q289

Harmonisation of disclosure requirements and consequences of non-compliance

National Group

The Netherlands

Contributors

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I) Current law and practice

Please answer all questions in Part I on the basis of your Group's current law.

Disclosure requirement

1. Does your Group's current law provide for a requirement to disclose information such as prior art and/or related patent application(s)?

Please answer YES or NO and you may provide an explanation.

If you answer YES to question 1, please explain the context/time of such disclosure requirement:

- a. at the time of patent application filing and/or during prosecution of the patent application;

YES. By way of background, patents with validity in the Netherlands can be applied for at either (i) the Dutch Patent Office under the Dutch Patent Act (national applications) or (ii) the European Patent Office ("EPO") under the European Patent Convention (European applications). For national patent applications, there is no requirement to disclose information. A reduced search fee is available if a search report of a priority application is shared, at the time of filing. The EPO may invite an applicant to provide information on prior art considered in parallel proceedings.

- b. at the time of post-grant proceedings;

NO.

- c. at the time of a proceeding before a court (infringement, nullity action, etc.);

NO. At the same time, we note that there is a general obligation under Dutch procedural law obliging litigants to furnish facts relevant to the decision thoroughly

and truthfully pursuant to article 21 of the Dutch Code of Civil Procedure (DCCP, in Dutch 'Burgerlijke Rechtsvordering' or Rv). The general obligation also applies in IP related proceedings.¹ In ex parte proceedings the court furthermore requires the applicant to disclose all relevant facts with regard to the validity of the patent. The regulation for accelerated patent proceedings of the District Court in The Hague provides that the claimant presents all known defenses, including those presented in proceedings abroad. In ordinary patent proceedings there are no specific rules on the application of Article 21 DCCP. The Dutch group is therefore unfamiliar with applying this general rule to information as referred to in this questionnaire. Nonetheless, the Dutch group could imagine that the obligation mentioned above is considered to be breached, for instance, if a patentee is aware of novelty-destroying prior art but withholds such art from the court.

d. at any other time.

NO.

2. Must the disclosure to be spontaneous and in all cases or only in certain circumstances (e.g., at the request of the IP Office or a judge, etc.)?

The obligation to provide information during the European patent application phase only arises in certain circumstances (i.e. after an invitation thereto from the EPO).

Scope of the disclosure requirement

3. Please indicate which information is concerned by the disclosure requirement:

For each of the following, please answer YES or NO and you may provide a brief explanation.

- a. all patent publication documents defined as prior art;

YES. See 3d.

- b. all non-patent publication documents defined as prior art;

YES. See 3d.

- c. related patent application filings, i.e. continuation-in-part applications, divisional applications, continuation applications;

NO.

- d. published or unpublished patent applications (and/or grant procedure documents, such as research reports, etc.) covering the same invention in other jurisdictions (whether claiming or not the associated priority benefit);

YES. An applicant claiming priority within the meaning of Article 87 EPC must file a

¹ CoA The Hague 8 August 2023, ECLI:NL:GHDHA:2023:1598 ('Fabricated evidence of infringement').

copy of the results of any search carried out by the authority with which the previous application was filed.

- e. any information other than a patent publication (products, photography, invoices, statements, information on internet, traditional knowledge, genetic resources, information concerning prior uses etc.);

NO.

- f. any other information.

NO.

4. Does the disclosure requirement concern all information that may affect the validity of the patent application, e.g., novelty and/or inventive step, insufficiency/plausibility, etc.?

YES. The disclosure requirement concerns all information that may affect the validity. This is limited to information within the earlier search report mentioned in 3d.

5. If the document is published in a language which is not one of the permitted languages in which applications can be filed, does your legislation require that a translation be provided (formal or informal translation)?

NO. There is no requirement to provide a translation, but the European examiner may however ask for a translation.

6. What level of analysis is required to determine relevance of a document/prior art publication? For example, is a full legal opinion on relevance required, before a publication can be dismissed as irrelevant?

No opinion is required. Merely a copy of the earlier search report is required.

7. Does your Group's current law provide for exceptions to the disclosure requirement prior to filing a patent application, e.g., during a grace period?

NO.

8. Does your Group's current law provide for a publication of the information disclosed by the person on whom the disclosure requirement rests (e.g. by inclusion in the patent application as published)?

YES. The copy of the earlier search report is included in the file.

Burden of disclosure

9. Who is required to disclose such information:

a. the inventor?

NO.

b. the applicant?

YES.

c. assignees of the patent?

NO.

d. licensees of the patent?

NO.

e. any other person (e.g., patent agent, employees, another patent office, etc.)?

YES. In general, all parties in court proceedings are obligated to state the facts relevant to the decision fully and truthfully (Article 21 DCCP).

10. Does the disclosure requirement concern only information actually known by the person who has the burden of disclosure or also information that he/she should have known?

Only information actually known.

11. Is the person who has the burden of disclosure required to identify or describe which portions of the prior art are relevant or material?

NO. Generally this is indicated in the copy of the Search report by the earlier patent office.

Sanctions

12. Does your Group's current law provide for an option to cure a failure to disclose, when disclosure requirement has not been met in a timely fashion? Please briefly explain.

The patent applicant may ask for further processing or reinstatement of the European patent application if it is deemed withdrawn.

A court can order parties in any stage of the proceedings to clarify statements

or to produce documents relating to the proceedings (Article 22 DCCP).
Moreover, at the request of a party, a court can order another party to provide certain specific information, under payment of a penalty if the information is not provided (Article 843a DCCP).

13. Does your Group's current law provide for a way to ensure compliance with the disclosure requirement (e.g., how to ensure that the person who has the burden to disclose has complied with his/her obligation)? Please briefly explain.

NO. The EPO does not check a statement under Article 124(1) EPC that no search report is available.

See the answer under 20.d. In general, all parties in court proceedings are obligated to state the facts relevant to the decision fully and truthfully (Article 21 DCCP).

As pointed out in 1c (reference is also made to the answer there), a claimant in patent proceedings requesting to be allowed to conduct the proceedings in accordance with the 'accelerated regime' must state all known defenses, including those which have brought up in other countries, in the draft writ of summons to be filed with the request in order to get access to the accelerated regime. If this condition is not met, the case can be removed from the accelerated regime, which will cause a significant delay.

14. Does your Group's current law provide a consequence or penalty for non-compliance with the disclosure requirement? Please briefly explain.

If an applicant at the EPO fails to reply in due time to the invitation to provide information on prior art, the European patent application shall be deemed to be withdrawn (Article 124(2) EPC).

If in court proceedings the obligation to provide the court with all relevant facts is not met by a party, the court may draw the conclusions it deems necessary (Article 21 DCCP).

If a claimant in patent proceedings requesting to be allowed to conduct the proceedings in accordance with the 'accelerated regime' does not state the known defenses, including those which have been brought up in other countries, in the draft writ of summons, he/she will not be allowed access to the accelerated proceedings regime. If he/she has been allowed such access and later in the proceedings, it becomes apparent that not all known defenses were

presented in the writ, the claimant may e.g. not be allowed to present certain new statements in response to the statement of defense.

In ordinary patent proceedings there are no specific rules on the application of Article 21 DCCP. The courts have indicated that not providing all relevant facts, may have a consequence for the remuneration of legal costs of the party affected by such breach.

Additionally, a patent holder of a national (unexamined) patent is inadmissible in his legal claim in proceedings if he fails to present a novelty report at the first moment of a proceedings (Article 70(2) Dutch Patent Act).

II) Policy considerations and proposals for improvements of your Group's current law

15. According to the opinion of your Group, is your current law regarding the disclosure requirement adequate and/or sufficient? Please answer YES or NO and briefly explain, listing areas in which your current law is not sufficient/adequate.

YES.

16. According to the opinion of your Group, is your current law regarding its disclosure requirement, if any, relating to the GR/TK adequate and/or sufficient? Please answer YES or NO and briefly explain.

The Dutch Patent Law does not contain a requirement to disclose information relating to the origin of genetic resources and traditional knowledge associated with genetic resources. However, the Dutch Patent Act provides in article 3(1) (e) that no patent shall be issued for inventions that lead to an infringement of Articles 3, 8(j), 15(5) (access to genetic resources is subject to prior consent) and 16(5) of the Convention on Biological Diversity. The Nagoya Protocol has been implemented in the EU ABS Regulation and Dutch national laws, imposing a due diligence obligation on the user of genetic resources and traditional knowledge.

The European Patent Convention does not contain a mandatory requirement to disclose information relating to the origin of genetic resources and traditional knowledge associated with genetic resources. In the Guidelines it is provided that for inventions based on biological material of plant or animal origin or using such material, it is recommended that the application, where appropriate, includes information on the geographical origin of such material, if known.

However, this is without prejudice to the examination of European patent applications and European patents. In this respect, reference is made to the (EU Biotech Directive (98/44/EC) recital 27.

The current laws are adequate and sufficient. The disclosure requirement should be limited to information that is of relevance to determine the patentability of the invention.

17. Please explain whether in your Group's view it would be beneficial for having a duty to disclose prior art in patent applications, and why the duty would provide / would not provide a benefit to third parties. In particular, what benefit do third parties gain from having access to a list of disclosed prior art for any given patent application?

No benefit. Patent offices are excellently equipped to perform a search. A duty to disclose may cause an overload of less relevant information and is perceived as an unnecessary burden.

18. According to the opinion of your Group, 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.

III) Proposals for harmonisation

Please answer all questions in Part III without taking into consideration your Group's current law.

19. Do you consider harmonisation regarding a requirement/duty to disclose information as desirable in general?

YES, provided that the duty of disclosure is limited to an invitation to provide a copy of the prior art search report carried out by the authority with which the priority application was filed.

Ideally patent offices share information deemed relevant in a common file that is open to the public. This includes patent publication documents defined as prior art, non-patent publication documents defined as prior art, third party observations and the materials relied on, if any, and may include other information considered relevant (products, photography, invoices, statements, information on internet, traditional knowledge, genetic resources, information concerning prior uses etc.) Such information may for instance be made available with use of WIPO ST.27, the

international standard for the exchange of legal event and legal status information.

If you answer YES to the question above, 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.

Disclosure requirement

20. What should be the context/time of such disclosure requirement:

a. at the time of patent application filing and/or during prosecution of the patent application?

No change needed. Submit information upon request by the Examiner.

b. at the time of post-grant proceedings (e.g., opposition, reexamination, reissue, post grant review, inter partes review)

No change needed. Not applicable.

c. at the time of a proceeding before a court (infringement, nullity action, etc.)

No change needed. Relevant information (Article 21 DCCP) should be shared with the court in line with the current practice.

d. at any other time.

Not applicable.

21. Should the disclosure be spontaneous and in all cases or only in certain circumstances (for example, at the request of the IP Office or if ordered by a Court, etc.)?

Before the patent office upon request. Before the court this should be spontaneous.

Scope of the disclosure requirement

22. Please indicate which information should be subject to the disclosure requirement.

For each of the following, please answer YES or NO and you may provide a brief explanation.

a. all documentary patent prior art.

NO.

b. all documentary non-patent prior art.

NO.

c. related patent application filings, *i.e.* continuation-in-part application, divisional

applications, continuation applications.

NO.

- d. published or unpublished patent applications (and/or grant procedure document, such as research reports, etc.) covering the same invention in other jurisdictions (claiming or not the associated priority benefit)?

YES. Search report.

- e. any information other than a patent application (products, photography, invoices, statements, information on internet, traditional knowledge, genetic resources, information about prior uses etc.)

NO.

- f. any other information.

YES. Parallel court proceedings and other information relevant to the court.

23. Should the disclosure requirement concern all information that may affect the validity of the patent application, e.g., novelty and/or inventive step, insufficiency/plausibility etc.?

YES, information relevant to the court under Article 21 DCCP should be shared.

24. What level of analysis should be required to satisfy the duty to disclose, e.g. should a formal legal opinion be required in the case of every potential disclosure?

None.

25. If the document is published in a language not permitted for patent applications, should a translation (formal or informal translation) be required?

NO.

26. Should there be exceptions for disclosure requirement, for instance prior to filing a patent application (e.g., during the grace period)?

YES.

27. Should the information communicated to the IP office and/or courts as regards the reason why the disclosure requirement applies or does not apply for a certain disclosure be available to the public?

Not applicable.

28. Should the reason why particular prior is disclosed as potentially relevant constitute a binding admission in all later proceedings as to the relevance of the prior art?

NO.

The person who should have the burden of disclosure

29. Who should be required to disclose such information:

a. the inventor?

NO.

b. the applicant?

YES.

c. assignees?

NO.

d. licensees?

NO.

e. any other person (e.g., patent agent, employees, etc.)?

YES, Article 21 DCCP is (and should be) applicable to all parties in court proceedings.

30. Should the disclosure requirement concern only information known by the person who has the burden of disclosure or also information that he/she should have known?

Only known information.

31. Should the person who has the burden of disclosure required to identify or describe which portions of the prior art are relevant or material?

NO.

Sanctions

32. How should the compliance with the disclosure requirement should be enforced (e.g., how to ensure that the person who has the burden to disclose has complied with his/her obligation, and what sanctions should follow if there is non-compliance)?

No change. See the answer under Q12.

33. What should the consequence or penalty for non-compliance with the duty of disclosure be, and should an option to cure a failure to disclose be available?

No change. See the answer under Q13.

34. Please comment on any additional issues concerning any aspect that you consider relevant to this Study Question.

It should be noted that the requirements vis-à-vis the patent office (where Examiners



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generally take a pro-active role) are different from those that apply to parties in court proceedings.

35. Please indicate which industry sector views provided by in-house counsels are included in your Group's answers to Part III.

The questionnaire and its answers have been shared with representatives from large and small/medium sized companies.