

DATE: June 2, 2007  
REF: EXCO/NL07/CET/1301  
MEETING: EXCO IN AMSTERDAM  
MEETING DATE: JUNE 2007  
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SUBJECT: **Secret Prior Art : report on discussions**  
PURPOSE: INFORMATION

In the EXCO in Santiago two alternative proposals were discussed as to how to define prior art as far as the "secret prior art" is concerned. Secret prior art or unpublished prior art refers to a patent application filed in the same jurisdiction earlier than a later patent application, but only published later.

Possible alternatives

### **1) Secret prior art is applied only for novelty purposes (not inventive step)**

Advantages

- possibly the prevailing situation in most legislations
- taken to constitute a fair solution for the later inventor, since he/she could not be aware of the secret prior art at the filing date of the later application
- encourages first applicant to disclose as early as possible [seldom used; disadvantage for first applicant]

Disadvantages

- results in granting of patent (later patent) not fulfilling the inventive step requirement with respect to the earlier patent
- raises issues as to whether "novelty" should also include some degree of non-obviousness [enlarged novelty]
- mitigates the effects of a first-to-file system (since "second-to-file" will get some protection for substantially the same invention even though he is not the first inventor to file)

### **2) Secret prior art is applied for novelty and inventive step**

Advantages

- same approach is used for all types of prior art
- novelty concept can be simple [photographic novelty]
- better protection for first inventor to file
- less conflicts between patentees
- less trivial patents granted

Disadvantages

- unfair to second applicant who could not be aware of first application
- raises issues on anti-self collision and terminal disclaimer
- if no anti-self collision exists, possibility to protect improvements by the same applicant diminishes [from 18 months to 1 year]
- no incentive for first applicant to disclose invention earlier [but it is an advantage for the first applicant]