



**FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INDUSTRIELLE
COMMISSION D'ÉTUDE ET DE TRAVAIL (CET)**

6 October 2002

**JULIAN CRUMP
RAPPORTEUR CET GROUP 3**

**Report of a Brainstorming meeting held in Prague on 5 October 2002 at 9:30 am
"Practical patent matters"**

Chairman David Bannerman (President, CET)
Reporter Julian Crump (Reporter, CET Group 3)

Present

Malcolm Royal President
Francis Ahner Vice President

Heinz Bardehle President of Honour, Member Group 3, CET
John Orange Past President, Reporter, CET Group 6

David Bannerman President, CET
Kazuaki Takami Vice President, CET

Jan Modin Chair, CET Group 3
Julian Crump Reporter, CET Group 3

It was agreed that formal minutes of the meeting would not be drawn up. Following is a summary of the discussion.

1 Information disclosure statements

More countries were introducing requirements for applicants to provide information on prior art known to them, e.g. Australia and Japan. Whilst it was acknowledged that all prior art available to one patent office should be made available to all patent offices, the way in which the requirements were being introduced unilaterally by the countries was creating greater disharmony in the patent system, contrary to current trends to harmonise patent laws.

Moreover the requirement in some countries to provide actual copies of patent publications was thought to be unnecessary.

The questions were what information should applicants be required to supply to patent offices and what penalties should apply in the event of a failure to provide the information. Whilst



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recognising an over-arching duty of good faith on applicants not to pursue knowingly invalid claims, it was thought to be unpractical to require applicants to supply information on all prior art known to them. In the case of a large corporation, for example, who would be the 'applicant' for this purpose? The in-house libraries of many large corporations, housing commercially valuable collections of prior art, would often be considered to be secret. There would also be problems of timing, since the prosecution of individual members of a patent family were not synchronised and, in general, patent attorneys' office systems were not geared-up to relate prior art on one family to another family covering similar subject-matter.

It was thought therefore that prior art made available to one patent office should be deemed to be made of record in all patent offices - it would be up to the patent offices to work out how best this could be achieved - and the maximum requirement on applicants should be to provide copies of official search reports, established either by or on behalf of patent offices. Any further requirements on applicants could quickly become burdensome, particularly in the case of relative large patent families.

It was noted that the US information disclosure requirement is already wider than this and that it would not be feasible to persuade the US to change its position. In this respect, it was felt that there should be a balance between the onus on applicants and the penalties that would apply if the information disclosure requirements were not met. Thus, for a straightforward obligation to file copies of official searches, the penalty could be quite severe, i.e. revocation of a patent. However, if the obligation was wider than this, e.g. a requirement to file details of all prior art known to an applicant, then penalties should not apply if the applicant could be seen to have acted in good faith and to have made best endeavours to comply with the requirement.

The discussion highlighted the need for good quality searches to be available to applicants as early as possible in the course of prosecution of applications, and it was noted that FICPI's previous proposals for a supplementary search as part of the PCT procedure would alleviate at least some of the problem. An electronic library could be established, preferably by WIPO, to ensure that all official search reports are actually available to all patent offices.

Furthermore, patentees should have an opportunity to amend their patents post-grant, and a patentee's diligence in meeting any obligations to disclose prior art should always be considered in any enforcement proceedings where there is a need to amend the patent.

It was agreed to draft a resolution for possible consideration by the Executive Committee. However, it was felt that no resolution should be presented to the Committee without an



opportunity to debate the issues.

2 Unity of invention, claim structures and fees

The discussion under these headings was wide-ranging, but in principle it was agreed that:

- An objection of lack of unity of invention should never be raised where further significant searching is not needed in respect of two or more independent claims, and
- It is a misconception that the presence of a plurality of independent claims in the same category would necessarily result in a lack of clarity, and accordingly a plurality of independent claims in the same category should not be considered objectionable as such.

The definition of unity of invention in PCTr.13 was generally approved, provided it is properly applied, and in this respect it was felt that the present practice of the EPO is unacceptable. In particular, it was noted that whilst PCTr.13.1 in theory allows an application to contain claims directed to a **group of inventions so linked to form a single general inventive concept**, the approach of EPO is too restrictive, perhaps as a result of an unwarranted linkage of the concepts of the 'special technical features' in PCTr.13.2 and the 'technical effect' that is deemed by the Technical Boards of Appeal to be needed for an invention to involve an inventive step, with the result that in practice patent applications are only allowed to proceed in respect of one invention, other than where the narrow circumstances of new EPCr.29(2) obtain. It was felt that formal rules should not be used when considering the issue of unity. There is however a need for harmonisation of practice under PCTr.13.

It was also agreed that multiply dependent claims do not in general give rise to any practical difficulties in searching or examining an application or in determining the scope of protection afforded by a patent. In this connection, it was felt that examiners should be required to search, examine and give an opinion on each and every claim where there is unity of invention and that applicants would be prepared to meet patent offices' costs in this respect by paying extra fees for excess claims in proportion to any extra work involved.

There was sympathy for the position of patent offices having to deal with 'mega applications' and it was felt that FICPI should support the offices in this respect, perhaps even by declaring that some such applications are inappropriate and should not be filed. The patent system has to remain workable and any change of practice to accommodate 'mega applications' should not adversely affect the treatment of normal applications. It was suggested that there might be a fee



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for printing excess pages of an application in order to discourage applicants and their advisers from filing 'mega applications'. However for applications containing biotechnological sequence listings, which are only useful in electronic form, the sequence listings should not count as excess pages.

Another suggestion was to introduce fees for excess claims into the PCT. However, the level of excess claims fees would have to be carefully considered, since the amount of extra work for processing - particularly searching - multiple independent claims was thought to be of a different order of magnitude than the amount of extra work for processing excess dependent claims.

3 Support in original disclosure for amendments

There is currently disharmony in the approaches taken by different patent offices as to what constitutes added subject-matter and this leads to higher costs for preparing patent applications.

It was felt that in the EPO the problem, at least in part, stems from the 'inescapable trap' which arises from the combined effects of EPCa.123(2) and EPCa.123(3). It was agreed to work on a resolution urging that unavoidable revocation of a patent under these circumstances is too severe a penalty. It was reported that the EPO's Enlarged Board of Appeal are presently working on a question concerning the position of disclaimers as added content.

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