



Study Question

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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

The Danish Group notes that it will refer to both the Danish Patents Act and the EPC.

Yes, the secret prior art is available for novelty-defeating purposes, see Section 2(2) second sentence of the Danish Patents Act and Article 54(3) of the EPC.

.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.

.a.

If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

It is the same as 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, see Section 2(2) last sentence of the Danish Patents Act and Article 56 second sentence of the EPC.

.b.

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

N/A

.b.

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 is possible 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:

.c. Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.

No

Please Explain

.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, in relation to novelty.

In order for an international application to become secret prior art, it will have to enter the national phase in Denmark, see Section 22, 29 and 31 of the Danish Patents Act.

Correspondingly, a Euro-PCT application is only secret prior art for Denmark if it enters the regional phase before the EPO, see Section 82 (2) of the Danish Patents Act and Art. 93 EPC, Art. 153(5) EPC and Art. 54(3) EPC and Rule 165 EPC.

.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

No. If the international application enters the national phase in Denmark or the regional phase before the EPO, then it will be considered secret prior art from the effective filing date of the subject matter citeable against the later filed patent application and not the date of the national phase entry, see Section 29 of the Danish Patents Act and Art. 153 (2) and (5) EPC.

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

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.

.a. If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?

It is the same as the standard applied to publicly available prior art.

.a.i 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?

No, there is no anti-self collision time period foreseen neither in the EPC nor in the Danish Patents Act.

The Danish Group does not consider it advantageous to introduce an anti-self collision provision beyond the general right to claim multiple priorities in a later filed combined patent application, filed within the priority year.

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 Section 2(2) last sentence of the Danish Patents Act and Article 56 second sentence of the EPC.

.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?

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

.b.i 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

.b. 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

N/A

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

2.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, in relation to novelty.

In order for an international application to become secret prior art, it will have to enter the national phase in Denmark, see Section 22, 29 and 31 of the Danish Patents Act.

Correspondingly, a Euro-PCT application is only secret prior art for Denmark if it enters the regional phase before the EPO, see Section 82 (2) of the Danish Patents Act and Art. 93 EPC, Art. 153(5) EPC and Art. 54(3) EPC and Rule 165 EPC.

2.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?

No

Please Explain

No. If the international application enters the national phase in Denmark or the regional phase before the EPO, then it will be considered secret prior art from the effective filing date of the subject matter citeable against the later filed patent application and not the date of the national phase entry, see Section 29 of the Danish Patents Act and Art. 153 (2) and (5) EPC.

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. 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.

Yes

Please Explain

Yes.

The current statutory rules distinguish between prior art based on filing *days*. A timescale of days may be insufficient or outdated in light of modern technology and instant publication, as witnessed by the recent decision from the British court of appeal in *Huawei v. Unwired Planet*, [2017] EWCA Civ 266 confirming the 1st instance decision on novelty over published prior art. In this case it was stated that filings made within the same 24 hour period of the publication date but after actual publication on the internet (i.e. the same publication and filing date), by reference to the time zone of the patent office of filing, is novel over this same, published state of the art.

Reference is also made to two recent decisions by the European Patent Office (EPO) regarding the revoked patents EP1448009 and EP2234303, both considering whether specific documents were published within the same date as the application.

4.b The patentability 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

No, the right to claim multiple priorities is sufficient remedy.

4.g Provisions for limiting an applicant's right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicant's earlier-filed application.

No

Please Explain

N/A

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?

Yes

Please Explain

Recent technological developments regarding electronic filing and advent of the Internet has made it actually feasible to circumvent the same date/ day before requirement enshrined in the EPC and the Danish Patents Act.

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.

No

Even if NO, please address the following questions to the extent your Group considers your Group

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

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

YES, the entire contents

7.a. 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?

YES

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

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

N/A

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

N/A

7.b. *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?*

N/A

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

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

No

Please Explain

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

Yes

Please Explain

YES, only patent applications with validity for Denmark should be citable in Denmark

7.c. *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 effective filing date of the patent application is suitable for use.

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 are the same.

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

Yes

Please Explain

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

YES, the entire contents

8.a. 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?

YES

8.a.i 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?

NO, the possibility to claim multiple priorities is sufficient protection against self-collision.

The Danish Group does not consider it advantageous to introduce an anti-self collision provision beyond the general right to claim multiple priorities in a later filed combined patent application, filed within the priority year.

8.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

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

N/A

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

N/A

8.b. *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?*

N/A

8.b. *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?*

N/A

8.b. *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

N/A

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.*

No

Please Explain

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

Yes

Please Explain

YES, only patent applications with validity for Denmark should be citable in Denmark.

9.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

NO, the effective filing date of the patent application is suitable for use.

9 Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 8 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 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:

same as Question 7

Please Explain

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

same as Question 7

Please Explain

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

same as Question 7

Please Explain

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

No

Please Explain

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

same as Question 7

Please Explain

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?

No

Please Explain

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

No

Please Explain

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:*

same as Question 7

Please Explain

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:*

same as Question 7

Please Explain

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

N/A

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

None