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Conflicting applications

REPORT OF SWISS GROUP*

I. Current law and practice

Switzerland is a member of the EPC, and the European Patent Office grants patents with effect in Switzerland under the EPC. However, a complete detailed report for this regional law appears not necessary: Art 54(2) and (3) EPC are substantially identical to Art. 7(1) and (2) (Swiss Federal Act on Patents for Inventions [PatA]), and treatment and importance of secret prior art according to the EPC and the PatA are consistent. Hence, this Report refers to Swiss national law, which applies mutatis mutandis to European patent applications as well.[1]

A substantial difference between the EPC and the PatA resides in the origin of secret prior art: Art 54(3) EPC restricts secret prior art to earlier filed European patent applications, and Art. 153(4) EPC adds PCT applications of earlier priority date provided they are published by the EPO which is substantially equivalent to be validly entered into the regional phase before the EPO. National secret prior art (national patent applications having an earlier priority and corresponding to a national phase of PCT applications) is dealt with on a national level after grant only according to Art. 139(2) EPC as if the national part of a European patent was a national patent.

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.

a) Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes, according to Art. 7(3) PatA.

With regard to novelty, the state of the art also includes the content of an earlier application or application with earlier priority designating Switzerland in the version originally filed, and with a filing or priority date that precedes the filing or priority date (Art. 7[2]PatA) of the later-filed application, and which was only made available to the public on or after that date, provided that the following requirements are fulfilled:

– in the case of an international application: designation of inventor in writing, remarks concerning the source, payment of the filing fee, translation in an official language (Art. 138 PatA);

– in the case of a European application based on an international application: filing fee paid at the EPO, translation in an official language if published in a non-official language of the EPO (Art. 153[5] EPC);

– in the case of a European application: the designation fees for Switzerland have been paid (Art.79[2]EPC).

Secret prior art constituted by national Swiss patent applications is prior art as well according to Art. 7(3) PatA.

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1 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.

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

The former “prior claim approach” has been replaced by the “whole content approach” for assessing novelty in view of secret prior art. Since July 1, 2008, the “whole content approach” is applied in Switzerland, which means that additionally to the claims, the description and the drawings of the secret prior art are relevant for the assessment of novelty.

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

Art. 7(3) PatA does not make any distinction between publicly available prior art and secret prior art for the purpose of evaluating novelty. Thus, the standard to be applied is the same as for publicly available prior art.

b) Is the secret prior art available against the claims of the later-filed application to show lack of inventive step/obviousness?

No, Art. 7(3) PatA refers to novelty only.

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

aa) Does this change any of your answers to Questions 1.a. and 1.b. above? If yes, please explain.

No, provided that the international application fulfils the requirements given under 1.a.

bb) Does it matter whether the international application actually enters the national phase in your jurisdiction? If yes, please explain.

Yes, the international application must fulfil the requirements given under 1.a.

cc) 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, according to Art. 7(2),(3) PatA, it does not depend on the date of the national phase entry.

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.

a) Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?

Yes, it is irrelevant whether the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same. The Swiss Patent Act is silent in this regard.

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

The “whole content approach” is applied and, therefore, the entire contents of the secret prior art are available, see the response to question 1.a.aa.

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

Art. 7(3) PatA does not make any distinction; see response to question 1.a.bb.

cc) 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, the Swiss Patent Act does not have any provision relating to anti-self collision.

b) Is the secret prior art available against the claims of the later-filed application to show lack of inventive step/obviousness?

No, for the same reasons as mentioned in response to question 1.b.

aa) 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.)?

Anti-self collision is not applied in Switzerland.

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

aa) Does this change any of your answers to questions 2.a. and 2.b. above? If yes, please explain.

No, see the response to question 1.c.aa.

bb) Does it matter whether the international application actually enters the national phase in your jurisdiction? If yes, please explain.

Yes, see the response to question 1.c.bb.

cc) 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, see the response to question 1.c.cc.

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.

Art. 7(3) PatA does not make any difference between the situation where the applicant and/or the inventor(s) of the secret prior art and the later-filed application are the same and the situation where the applicant and/or the inventor(s) of the secret prior art and the later-filed application are different.

Therefore, the answers for the scenarios of Question 3, wherein either the applicant or the inventor(s) of the later-filed application is different, are identical to those set forth in the previous questions.

The answers to sub-question aa) for scenario c) and sub-questions aa)–bb) for scenario d) are negative, since the aspects of applicants being part of a joint-industry or industry-university research project and of inventors having an obligation to assign the invention to the same applicant are not dealt with in the Swiss Patent Act.

a) Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

☐ same as Question 1

☒ same as Question 2

☐ different (please explain)

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

☐ same as Question 1

☒ same as Question 2

☐ different (please explain)

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

☒ same as Question 1

☐ same as Question 2

☐ different (please explain)

aa) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No.

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

☒ same as Question 1

☐ same as Question 2

☐ different (please explain)

aa) 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.

bb) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No.

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.

a) The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No, Art. 7(3) PatA defines appropriately the "when".

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.

Switzerland applies the "novelty-only" standard. The Study Group does not see any reason to deviate from this standard.

c) The treatment of international applications as secret prior art.

No, according to the current Art. 7(3)(a)–(b) PatA, an international or a European patent application has prior art effect when it enters the national phase or when Switzerland is designated (cf. 1. c.). The Study Group does not see any reason to deviate from this provision.

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

Currently, Art. 7(3) PatA does not treat the applicant and third parties differently with regard to applications that are filed after the filing of the first application. The Study Group considers that the treatment of total and partial identity of applicants as it relates to secret prior art should be the same.

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

No.

f) Provisions for avoiding self-collision.

An exception for applicant's own patent application could be an option for an anti-self collision clause.

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.

The Study Group does not see any reason to introduce provisions for further limiting an applicant's right to obtain patent claims in the later-filed application in addition to the existing provisions.

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.

III. Proposals for harmonisation

6. Does your Group consider that harmonisation in any or all areas in Section II desirable?

Yes.

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.

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

Yes.

aa) If yes, should the entire contents of the secret prior art be available, or only a portion, such as the claims?

The entire contents (as with publicly available prior art).

bb) 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?

The same as the standard applied to publicly available prior art.

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

No, there should be a difference between secret prior art and publicly available prior art when assessing patentability.

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

No.

bb) Does it matter whether the international application actually enters the national phase in your jurisdiction? If yes, please explain.

Yes, for the purpose of secret prior art only international patent applications that have validly entered the national phase should be taken into account to avoid double patenting.

cc) 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.

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.*

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

No, as stated in 4.f. the Study Group is in principle open for an exception for applicant's own patent application.

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

No.

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

aa) Does this change any of your answers to questions 2.a. and 2.b. above? If yes, please explain.

No.

bb) Does it matter whether the international application actually enters the national phase in your jurisdiction? If yes, please explain.

Cf. 7.c.bb.

cc) 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?

Cf. 7.c.cc.

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.

a) Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:

☐ same as Question 7

☒ same as Question 8

☐ different (please explain)

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

☐ same as Question 7

☒ same as Question 8

☐ different (please explain)

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

☒ same as Question 7

☐ same as Question 8

☐ different (please explain)

aa) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No.

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

☒ same as Question 7

☐ same as Question 8

☐ different (please explain)

aa) 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.

bb) Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No.

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

☐ same as Question 8

☐ different (please explain)

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

☐ same as Question 8

☐ different (please explain)

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

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

None.

Summary

Secret prior art is available in Switzerland against the claims of a later-filed application for novelty-defeating purposes. An international patent application, a European patent application based on an international patent application, a European patent application, and a national Swiss patent application can become such prior art if certain requirements are fulfilled. Since July 1, 2008, the "whole content approach" is applied in Switzerland. All parts of a patent application including the claims, the description and the drawings are relevant for assessing novelty in view of secret prior art. Swiss patent law does not make a distinction between publicly available prior art and secret prior art for the purpose of evaluating novelty. Secret prior art in Switzerland is not taken into account for the assessment of inventive step. Further, the approach of anti-self-collision is not known in the Swiss Patent Act. Whether the applicant and inventors of the secret prior art and the applicant and inventors of the later filed application are the same or not is irrelevant. The Swiss Group considers harmonisation in the area of secret prior art desirable.

Zusammenfassung

Unveröffentlichter («geheimer») Stand der Technik wird in der Schweiz gegen die Neuheit von Ansprüchen einer späteren Anmeldung verwendet. Eine internationale Patentanmeldung, eine auf einer internationalen Patentanmeldung basierende europäische («Euro-PCT») Patentanmeldung, eine europäische Patentanmeldung und eine nationale Schweizer Patentanmeldung können solchen Stand der Technik bilden, falls gewisse Voraussetzungen erfüllt sind. Seit dem 1. Juli 2008 wird in der Schweiz der «Whole-content-Approach» angewendet. Alle Teile einer Patentanmeldung, einschliesslich der Ansprüche, der Beschreibung und der Zeichnungen, sind für die Beurteilung der Neuheit in Bezug auf unveröffentlichten Stand der Technik relevant. Das Schweizer Patentgesetz unterscheidet bei der Beurteilung der Neuheit nicht zwischen veröffentlichtem und unveröffentlichtem Stand der Technik. Bei der Beurteilung der erfinderischen Tätigkeit wird unveröffentlichter Stand der Technik in der Schweiz nicht berücksichtigt. Der Ansatz, der eine Selbstkollision ausschliesst («anti-self collision»), ist dem Schweizer Patentgesetz unbekannt. Es ist unerheblich, ob die Anmelderin und die Erfinder des unveröffentlichten Stands der Technik einerseits und die Anmelderin und die Erfinder der späteren Anmeldung andererseits dieselben sind oder nicht. Die Schweizer Arbeitsgruppe hält eine Harmonisierung auf dem Gebiet des unveröffentlichten Stands der Technik für wünschenswert.

Résumé

L'état de la technique secret est utilisable en Suisse contre les revendications de demandes publiées à une date postérieure en ce qui concerne l'examen quant à la nouveauté. Les demandes internationales de brevet, les demandes de brevet européen basées sur une demande internationale de brevet, les demandes de brevet européen ainsi que les demandes de brevet suisse peuvent constituer un tel état de la technique secret si certaines conditions sont remplies. Depuis le 1er juillet 2008, l'approche du contenu complet est appliquée en Suisse. Toutes les parties de la demande de brevet, y compris

les revendications, la description et les dessins sont considérés dans un éventuel examen de la nouveauté par rapport à l'état de la technique secret. La loi fédérale sur les brevets d'invention ne fait pas de distinction entre l'état de la technique publiquement accessible avant la date effective et l'état de la technique secret en ce qui concerne l'examen quant à la nouveauté. En revanche, l'état de la technique secret n'est pas considéré pour l'examen quant à l'activité inventive en Suisse. La loi fédérale sur les brevets d'invention ne contient pas de dispositions anti-auto-collision et par conséquent, la question de l'identité de la demanderesse ou des inventeurs entre l'état de la technique secret et la demande en question n'est pas pertinente dans le cadre de l'examen quant à la brevetabilité. Cependant, le groupe suisse considère qu'une harmonisation dans le domaine de l'état de la technique secret est désirable.