

AIPPI Study Question Q289 – Harmonization of Disclosure Requirements and Consequences of Non-Compliance

Report of the Swiss Group

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.

Yes: According to Art. 49a of the Swiss Federal Act on Patents for Inventions (hereinafter, «Patents Act»), information on the source of genetic resources and traditional knowledge must be given.

In particular, Art. 49a(1) of the Swiss Patents Act states that:

«The patent application must contain information on the source:

- a. of the genetic resource to which the inventor or the patent applicant had access, provided the invention is directly based on this resource;

In the context of this Study Question, the below terms have the following meaning:

«Related patent application»: means continuation-in-part applications, divisional applications, and/or continuation applications.

«Prior art»: Consistently with Resolution Q167 (Lisbon, 2002), means «all information which has been made available to the public anywhere in the world in any form before the filing date or, where applicable, the priority date».

«Post-grant proceedings»: means proceedings before the IP office after the grant of the patent, such as opposition, re-examination, reissue, post grant review, inter partes review, etc.

Members of the working group: Oliver Jeker, Thomas Kretschmer, Lorena Piticco, Martin Sperrle and Paul Georg Maué.

The english translation of the summary is included on Swissex and legalis only.

- b. of traditional knowledge of indigenous or local communities of genetic resources to which the inventor or the patent applicant had access, provided the invention is directly based on this knowledge.»

Article 49(a)(2) of the Swiss Patents Act states that:

«If the source is unknown to the inventor or the patent applicant, the patent applicant must confirm this in writing.»

This declaration is placed in the file of the Swiss Federal Institute of Intellectual Property (hereinafter, «IPI»).

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;

The disclosure requirement should be met at the time of filing a Swiss patent application. In particular, Art. 45a (1) of the Swiss Patent Ordinance states that «[t]he source of genetic resources or traditional knowledge within the meaning of Art. 49a of the Patents Act must be mentioned in the description of the invention».

Similar provisions apply for Swiss national phases from a PCT application. According to Art. 138(b) of the Swiss Patents Act, which specifies formal requirements of an international application published under the Patent Cooperation Treaty for which the IPI is the designated office, the applicant must provide information on the source of genetic resources or traditional knowledge within 30 months of the filing or priority date, i.e. upon entry to the Swiss national phase.

b) at the time of post-grant proceedings;

No such provisions.

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

No such provisions.

d) at any other time.

No such provisions.

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

Article 49a of the Swiss Patents Act states that the (Swiss national) patent application *must* contain the information on the source. In addition, Art. 138(b) of the Patents Act states that the (Swiss phase of an international) application *must* provide the information on the source. The disclosure therefore needs to be spontaneous and in all cases.

See Art. 59(3)b of the Swiss Patents Act and Art. 67(2) of the Swiss Patent Ordinance. If the applicant refuses to indicate the source of a genetic resource to the IPI in accordance with Art. 49a(1) of the Swiss Patents Act or to provide a declaration in accordance with Art. 49a(2) of the Swiss Patents Act, or if the application does not comply with Art. 49a of the Swiss Patents Act and the provisions of the Ordinance, the IPI will give the applicant the opportunity to rectify the deficiency and provide the missing information within a specified period. In the event that the time limit expires without being met, the IPI rejects the patent application.

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;

No such provisions.

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

No such provisions.

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

Yes: In the event of a divisional application, Art. 24(2)c of the Swiss Patent Ordinance requires that the request regarding the grant of the patent includes the number of the earlier application and the claimed filing date. If these provisions are not met, the applicant may rectify the deficiency within three months of filing the request, or the IPI requests the applicant to rectify the deficiency within said period, see Art. 48a(1) and (2) of the Swiss Patent Ordinance.

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);

No such provisions.

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

Yes, see above. Information on traditional knowledge and genetic resources must be provided.

f) any other information.

Yes. Article 7b of the Swiss Patents Act states that where the invention has been made available to the public in the six months prior to the application date or priority date, this disclosure does not form part of the state of the art when it is due to, or a consequence of:

- a. an evident abuse in relation to the patent applicant or his legal predecessor; or
- b. the fact that the patent applicant or his legal predecessor has displayed the invention at an official or officially recognised international exhibition falling

within the terms of the Convention on International Exhibitions of 22 November 1928, and he or she has declared the fact at the time of filing and has produced sufficient supporting evidence in due time.

According to Art. 44(1) of the Swiss Patent Ordinance, said declaration of immunity from exhibition consists of the following information:

- a. an exact designation of the exhibition;
- b. a declaration of the actual exhibition of the invention.

According to Art. 44(2) of the Swiss Patent Ordinance, the declaration must be submitted together with the request for the grant of the patent; if this is not done, the immunity from exhibition is forfeited.

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.?

No, as explained above, only information on the source, any parent application and/or a declaration of immunity from exhibition must be provided.

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)?

Not applicable.

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?

Not applicable.

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 such provisions.

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)?

In the event that the information on the genetic resource or traditional knowledge is contained in the patent application, said information will be published when the patent application is published. In the event of a declaration being filed, said declaration is placed in the file of the IPI (Art. 49(a)(2) of the Swiss Patents Act), which may be viewed by third parties.

According to Art. 94(1)h of the Swiss Patent Ordinance, information on immunity from exhibition is entered in the Swiss patent register.

Burden of disclosure

9. Who is required to disclose such information:

a. the inventor?

Yes, although in a sense indirectly as the burden of disclosure lies with the patent applicant. If the *inventor* had access to a genetic resource or traditional knowledge, this information must be included in the application. If the source is not known to the *inventor*, the *patent applicant* must confirm this in writing, see Art. 49(a)(1) and (2) of the Swiss Patents Act.

b. the applicant?

Yes: If the *applicant* had access to a genetic resource or traditional knowledge, this information must be included in the application. If the source is not known to the *applicant*, the *patent applicant* must confirm this in writing, see Art. 49(a)(1) and (2) of the Swiss Patents Act.

The applicant must also disclose information on any parent application and/or a declaration of immunity from exhibition.

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.)?

No

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?

Article 49(a)(1) of the Swiss Patents Act refers to having had access to the information on the source and Art. 49(2)(2) of the Swiss Patents Act refers to a source being unknown. This implies that the disclosure requirement concerns information on the source that is actually known by the applicant or the inventor.

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: The relevant Articles only refer to information on the source, any parent application, and/or declaration of immunity from exhibition.

According to Thomsen in Schweizer/Zecht (eds), PatG 49(a), N 16, the patent applicant only has to indicate the country of origin of the genetic resource. If the applicant does not know the country of origin, he or she may indicate the individual origin of the genetic resource to which the inventor actually had access (e.g. a strain collection). Further information is optional and does not need to be taken into account by the Patent Office, e.g. time of access to the genetic resource or whether prior informed consent has been obtained from the country of origin, etc.

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.

Yes, see above:

If the application does not comply with Art. 49a of the Swiss Patents Act and the provisions of the Ordinance, the IPI will give the applicant the opportunity to rectify the deficiency and provide the missing information within a specified period. If the time limit expires without being met, the Swiss Patent Office rejects the patent application (see Art. 59(3)b of the Swiss Patents Act and Art. 67(2) of the Swiss Patent Ordinance).

If information on any parent application is not provided, the applicant may rectify this deficiency within three months of filing the request, or the IPI requests the applicant to rectify the deficiency within said period (Art. 48a(1) and (2) of the Swiss Patent Ordinance).

The declaration of immunity from exhibition must be submitted with the request for the grant of the patent; if this is not done, the immunity from exhibition is forfeited (Art. 44(2) of the Swiss Patent Ordinance).

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.

Yes, this is done as part of the IPI's examination.

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

Yes. Article 81a(1) of the Swiss Patents Act states that «Any person who wilfully provides false information under Article 49a is liable to a fine of up to 100,000 Francs.» According to Art. 81a(2) of the Swiss Patents Act, the court may order the publication of the judgment.

Schweizer/Zech – Fiolka, Art. 81a PatG, N 3 states in this context that:

Article 81a of the Swiss Patents Act concerns a special offense; the offender can only be the patent applicant. According to the message (Botschaft), the offense under Art. 81a of the Swiss Patents Act is committed if the patent applicant intentionally indicates a source other than the one known to him or her in the declaration or declares that no source is known, although the applicant has the relevant information.

The patent applicant must expressly confirm lack of knowledge of the source by the applicant or inventor in accordance with Art. 49a(2) of the Swiss Patents Act.

Article 81a of the Swiss Patents Act refers to an intentional offense, whereby contingent intent is sufficient. The offense is committed by anyone who has knowledge of a source and indicates another source or confirms that they

do not know the source. However, Art. 81a of the Swiss Patents Act does not impose any obligation to find out about possible sources.

Legal consequences: Violation of Art. 81a of the Swiss Patents Act is punishable by fines of up to CHF 100,000.

Article 81a of the Swiss Patents Act refers to a criminal offense which must be prosecuted *ex officio*.

Thomsen in Schweizer/Zecht (eds), PatG 49(a), N 27 states with regard to legal consequences that:

Sanctions that interfere with the existence or enforceability of the patent, such as nullity of patent claims or forfeiture of injunctive relief under the patent, are not provided for. Such sanctions would destroy the basis for monetary benefit-sharing with the countries of origin of the genetic resources.

Not affected by these sanctions are possible sanctions resulting from a violation of the provisions of the Nagoya Protocol, as implemented in Switzerland by the Federal Act on the Protection of Nature and Cultural Heritage (NCHA), such as official or court orders to cease research and development activities with a particular genetic resource or to conclude a mutual agreement with the country of origin on benefit-sharing.

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. The Swiss Group is of the opinion that the current Swiss law relating to disclosure requirements, being limited to information on the source, any parent application and declaration of immunity from exhibition, is both adequate and sufficient. In the view of the Swiss Group, electronic exchange of prior art information between major patent offices is currently working well. The same applies to electronic file inspection. Efforts to improve transparency should rather strengthen these capabilities than encumber patent applicants with additional administrative burdens, such as filing information on prior art.

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.

Yes. The Swiss Group is of the opinion that disclosure requirements relating to genetic resources (GR) and traditional knowledge (TK) have been thoroughly implemented in the current Swiss law (see above Section I). These requirements are seen as both adequate and sufficient.

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. The Swiss Group is of the opinion that having a duty to disclose prior art in patent applications would not be beneficial and that such a duty would not provide a significant benefit to third parties. As mentioned above, prior art information is readily accessible nowadays through the electronic services provided by all major patent offices. The Swiss Group thus expects that a duty to disclose prior art in patent applications would be of little benefit to third parties. In any case, such a benefit would not outweigh the additional administrative burden encumbered upon patent applicants. Furthermore, patent applicants would suffer legal uncertainty when they have to decide which prior art is to be cited, and which is not.

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 harmonization

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

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

Yes

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?

Yes

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

No

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

No

d. at any other time.

No

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.)?

Spontaneous:

Information on any parent application (see below note 22. c.)

Information on genetic resources and traditional knowledge (see below note 22. e.)

Information on immunity from exhibition (see below note 22. e.)

Information on application of a grace period (see below note 22. f.)

Only under certain circumstances and only at the request of a competent authority:

Search results for any priority application (see below note 22. d.)

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.

Information on any parent application (see above Section I).

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)?

In the opinion of the Swiss Group, a competent authority should have the possibility to request from an applicant claiming the priority of a previous application the submission of a copy of the results of any search carried out by the authority with which the previous application was filed, if these results are not available to the competent authority by any other means. (E.g., electronic exchange of prior art information between patent offices. This would be similar to Art. 124 EPC and R. 141 EPC, but limited to priority applications, i.e. not (any) national or regional patent proceedings concerning an invention to which the patent application relates, and only at the request of the competent authority.) Preferably, the information regarding the search results of a priority application will be exchanged between the patent offices without the intervention of the applicant.

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

Information on genetic resources and traditional knowledge (see above Section I).

Information on immunity from exhibition (see above Section I).

f. any other information.

Furthermore, the proposal has been discussed in the Swiss Group according to which in jurisdictions providing for a grace period, i.e. a period of time prior to the filing or priority date of a patent application, during which an inventor or applicant can disclose an invention without nullifying the patentability of the invention, there should be a requirement for the applicant to provide information on any such disclose, which should be excluded from assessment of novelty and/or inventive step. Providing this information will benefit third parties in better evaluating the validity of a patent right at an early stage. This proposal has been met with some skepticism, as it would increase the administrative burden on the applicant and potentially even hamper its legitimate benefit of the grace period, in the event that the required information is not duly provided (see below note 32).

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.?

In any case, only novelty and/or inventive step; for the scope, see above note 22.

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?

No. Regarding the scope, see above note 22.

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)?

No (see above note 22.f.)

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?

Yes (however, see below note 28.)

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

No (however, see above note 27.)

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.)?

No

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 information that is actually known.

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 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)?

In case information on any parent application or search results for a priority application are not provided, at

the very latest upon the request of a competent authority, the patent application is deemed to be withdrawn (see above notes 22.c. and d.).

In case any information on immunity from exhibition or application of a grace period is not provided upon filing (or within a certain period from the filing date), these rights are forfeited by the applicant (see above notes 22.e. and f.).

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?

The Swiss Group is of the opinion that the sanction of any failure of an applicant to provide information on genetic resources and traditional knowledge (see above note 22.e.) should not interfere with the existence or enforceability of the patent, as this would eliminate the basis for monetary benefit-sharing with the countries or societies of origin. Penalizing the applicant in case of non-compliance with a fine thus seems a more adequate instrument (see above Section I).

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

None

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

The Swiss group was composed of four members working in private practice and one in-house counsel. No industry-sector views were provided by any of them.

Zusammenfassung

Das Schweizer Patentgesetz sieht mehrere Offenlegungspflichten vor.

Es verlangt insbesondere die Offenlegung der Quelle von genetischen Ressourcen und traditionellem Wissen, zu dem der Erfinder oder der Patentanmelder Zugang hatte, sofern die Erfindung unmittelbar auf diesem Wissen beruht. Ist die Quelle dem Erfinder oder dem Patentanmelder nicht bekannt, muss der Patentanmelder eine entsprechende Erklärung abgeben und dies schriftlich bestätigen. Weigert sich der Anmelder, die Quelle einer genetischen Ressource anzugeben oder eine Erklärung abzugeben, kann die Patentanmeldung zurückgewiesen werden. Jede Person, die vorsätzlich falsche Angaben macht, kann mit einer Geldstrafe belegt werden.

Eine weitere Offenlegungspflicht betrifft die Angabe der Nummer der früheren Anmeldung und des beanspruchten Anmeldedatums im Falle von Teilanmeldungen.

Ein weiteres Erfordernis besteht im Zusammenhang mit unschädlichen Offenbarungen, wobei eine Offenbarung der Erfindung innerhalb von sechs Monaten vor dem Anmelde- oder Prioritätstag nicht zum Stand der Technik gehört, wenn sie auf einen offensichtlichen Missbrauch zum Nachteil des Patentanmelders oder seines Rechtsvorgängers oder auf die Tatsache zurückzuführen ist, dass der Patentanmelder oder sein Rechtsvorgänger die Erfindung auf einer offiziellen bzw. anerkannten Ausstellung gezeigt hat.

Die Schweizer Gruppe ist der Ansicht, dass das geltende Schweizer Recht in Bezug auf die Offenlegungspflichten, das sich auf Angaben zur Quelle, auf die Erklärung über die Ausstellungsimmunität und auf Angaben zu etwaigen Stammanmeldung beschränkt, sowohl angemessen als auch ausreichend ist. Insbesondere in Bezug auf die Pflicht zur Offenlegung von Informationen über Anmeldungen, die dieselbe Erfindung in anderen Ländern betreffen, ist die Schweizer Gruppe der Ansicht, dass der elektronische Austausch von Informationen zum Stand der Technik zwischen den Patentämtern heutzutage gut funktioniert und dass derartige Informationen ohne Zutun des Anmelders zwischen den Patentämtern ausgetauscht werden sollten.

Résumé

La loi fédérale suisse sur les brevets d'invention prévoit plusieurs obligations de divulgation.

Elle exige notamment la divulgation de la source des ressources génétiques et des savoirs traditionnels auxquels l'inventeur ou le demandeur de brevet a eu accès, si l'invention repose directement sur ces savoirs. Si la source n'est pas connue de l'inventeur ou du demandeur du brevet, ce dernier doit faire une déclaration en ce sens et la confirmer par écrit. Si le demandeur refuse d'indiquer la source d'une ressource génétique ou de fournir une déclaration en ce sens, la demande de brevet sera sans doute rejetée. Toute personne faisant intentionnellement de fausses déclarations sera sanctionnée par une amende.

Une autre obligation de divulgation concerne l'indication du numéro d'une demande antérieure et de la date de dépôt revendiquée dans le cas de demandes divisionnaires.

Une autre exigence est liée aux divulgations non opposables, par exemple, d'une divulgation de l'invention dans les six mois précédant la date de dépôt ou de priorité ne faisant pas partie de l'état de la technique si elle résulte d'un abus manifeste au détriment du demandeur du brevet ou de son prédécesseur en droit, ou du fait que le demandeur de brevet ou son prédécesseur en droit a divulgué l'invention dans le cadre d'une exposition officielle ou officiellement reconnues.

Le Groupe suisse estime que la législation suisse actuelle est à la fois appropriée et suffisante en ce qui concerne les obligations de divulgation, qui se limitent à des indications de la source, à la déclaration concernant le privilège d'exposition et à des informations liées au dépôt de demandes antérieures. En particulier, en ce qui concerne l'obligation de divulguer des informations sur les demandes concernant la même invention dans d'autres pays, le Groupe suisse estime que l'échange électronique d'informations sur l'état de la technique entre les principaux offices de brevets fonctionne bien aujourd'hui et que de telles informations devraient être échangées entre ces offices sans aucune intervention du demandeur.