



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Resolution of the Executive Committee, Seoul, Republic of Korea, 1 to 3 May 2005

“Unpublished Prior Art”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Seoul, Republic of Korea, 1-3 May 2005, resolved that:

Whereas the work on Patent Law Harmonization executed in the Standing Committee on the Law of Patents (SCP) of WIPO deals, among other issues, with the problem of the prior art effect of applications having an earlier filing or priority date than an application under consideration, but being published after the filing date of that latter application (unpublished prior art). While in many countries these so-called earlier applications have a prior art effect for novelty only, in other countries they have a prior art effect on both novelty and inventive step (non-obviousness). Both approaches having their merits, the discussion at the international level on what is “best practice” is continuing;

Noting that these different approaches should be harmonized, but that the number of cases of colliding applications in the above-mentioned way is relatively small (according to the EPO only 6%) and that the different effects are not so serious that they need immediate harmonization;

Noting too that this problem should be studied in cooperation with the users to find out what really is “Best Practice”;

Declares that in this situation, it is recommended to follow the solution of the Basic Proposal submitted by WIPO to the Diplomatic Conference on the Harmonization of Patent Laws in 1991 in which the basic rule for the above cases was laid down with the reservation in its Article 13(a):

“Any Contracting Party may consider the whole contents of the former application to be prior art also for the purpose of determining whether the invention satisfies the requirement of inventive step (non-obviousness)”

FICPI therefore supports this solution in order to avoid efforts towards Patent Harmonization being stopped for an unforeseeably long time.