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Self-Collision in patent applications

How to Avoid Shooting Your Client in the Foot

A European perspective with some thoughts on the global situation, including other jurisdictions

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Only one patent for an invention

In Europe (EPC) no explicit provision against double patenting

**In practice, double patenting is avoided by Art 52(1) EPC
"European patents shall be granted for any inventions, in all fields of technology, provided they are new, involve an inventive step and are susceptible to industrial application"**

No anti-self-collision provision in the EPC – novelty is required even for applicant's later applications

Novelty requirements in EPC

Art 54 (1) Novelty

“An invention shall be considered to be new if it does not form part of the state of the art”

Art 54 (2)

“The state of the art shall be held to comprise everything made available by means of a written or an oral description, by use, or in any other way, before the date of filing the European patent application”

Novelty requirements in EPC, cont.

Art 54 (3)

”Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.”

So, in Europe, even “secret prior art” is applied when determining whether a claimed invention is new – this is applied even for an applicant’s own earlier, still unpublished patent applications

Inventive Step requirement in EPC

Art 56

“An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also included documents within the meaning of Art 54 (3), these documents shall not be considered in deciding whether there has been an inventive step.”

So, under EPC, “secret prior art” cannot be applied when determining inventive step.

Requirements for a 2nd application

Accordingly, all subsequent or 2nd applications filed within 18 months from a first application have to concern an invention that is new in relation to the relevant prior art, including "secret prior art".

There is no exception for the same applicant, i.e. there is no anti-self collision provision.

Considerations when drafting (1)

Novelty considerations:

satisfy EPC requirements

claims have to relate to subject matter being novel, even in relation to your own earlier non-published applications (unfortunately, you cannot find out whether there is other novelty destroying "secret prior art")

Identify available prior art

If possible and affordable, conduct a pre-filing search, so that you can focus on essential features that are new

Considerations when drafting (2)

Novelty considerations for possible improvements:

Because of the whole contents novelty requirements of possible later patent applications concerning improvements and further developments of a basic invention, avoid speculative features that cannot be claimed, e.g. because of unity considerations, or insufficient disclosure, so as to prevent that your patent application is cited against you as a novelty bar in a later patent application on similar subject matter.

Considerations when drafting (3)

Unity requirements, Art 82 EPC

Analyse unity of invention

Only one independent claim in each category (Rule 43(2), only a few specific exceptions)

Identify the essential technical features which distinguish invention A over the closest example of prior art

Considerations when drafting (4)

Outline an enabling disclosure Art. 83

Draft an outline of preferred embodiments falling within scope A and consider sufficiency of disclosure for the basic embodiments. Each embodiment has to be fully described so that it can be used separately in an independent claim, possibly in a divisional application. Beware of the strict rules for amendments, including "unambiguous" support and a prohibition of generalisations, even "intermediate generalisations". You must include clear language that fully supports each embodiment to be claimed later during the prosecution.

Considerations when drafting (5)

“Gold” standard for e.g. priority rights and amendments, Art 123(2) EPC and G2/10:

Any amendment to the description, claims and drawings may only be made within the limits of what a skilled person would **derive directly and unambiguously**, using common general knowledge, and seen objectively and relative to the date of filing, from the **whole** of these documents as filed... The skilled person may not be presented with new technical information.

Considerations when drafting (6)

Case law concerning permissible amendments:

T 648/10: a feature presented as an essential feature, cannot be deleted from an independent claim – this would be considered to add subject matter

There is no particular test that is generally applicable, various tests may be used as tools

T 1853/13: An application must not be considered as a reservoir from which features can be combined to artificially create a particular embodiment. There must be some "pointer".

Considerations when drafting (7)

Case law concerning permissible amendments, cont:

T 416/86:

- The fact that a technical means was known did not take away the novelty of its equivalents, even if the equivalents were known,
- The equivalents are considered new and are not disclosed
- It is inadmissible to replace a specific feature with a general feature containing the equivalents,
- T 653/03: it was not permitted to replace "diesel engine" by "combustion engine".

Considerations when drafting (8)

Case law concerning permissible amendments, cont:

Because of the strict golden rule - the other side of the coin – later applicants, second filers, even third parties, may obtain patents on equivalent technical means, both when filing within the secret 18 months period, and after this period (provided that there is an inventive step).

Therefore, be sure to use both general and specific definitions in your specification.

Second filing within 12 months

Inventions are most often improved even after a first filing.

Consider a possible second application B within 12 months, covering a set of features, defining a second independent invention. More subject matter is added to meet the standards of clarity, Art 84 EPC, and sufficiency of disclosure, Art 83 EPC.

At 12 months, you may file a PCT application including one or more inventions that MAY be considered unitary in other jurisdictions, claiming priority from the technically related applications filed during the first 12 months period.

Check at 18 months

Before the critical date 18 months after the first filing of invention A, check with the inventor/applicant whether the invention has been developed further.

Possibly, a minor (incremental) improvement has been made that warrants the filing of a further patent application, on another independent invention C, defined by a further set of essential features. If this set is novel but lacks an inventive step over the applicant's own secret prior art, it is crucial that the further patent application be filed before the first application is published at 18 months. However, because of the whole contents approach, there must not be any suggestion in the first application of the set of essential features constituting the further invention C.

PCT application

A PCT application should normally be filed within 12 months. Then you do not have to bother about the applicant's possible disclosure to third parties after filing.

Also, at 12 months, or at least within 18 months, you should consider filing in non-PCT jurisdictions, e.g. Taiwan, GCC, Argentina and some further states. Check with WIPO who keeps updated records on all jurisdictions.

PCT application, international phase

If your client intends to file in many jurisdictions (national and regional), it is advantageous to use Chapter II and try to obtain a positive patentability report. Of course, the PCT IPER (International Preliminary Examination Report) is not binding, but you have a better chance to get a swift grant if you have a positive PCT report (Chapter I or Chapter II).

FICPI has supported regarding the PCT preliminary report as a basis for accelerated grant under the Patent Prosecution Highway, but this has not yet been recognized by all major jurisdictions (e.g. EPO).

PCT appln, national/regional phase

The PCT provisions do not cover substantive examination during the national or regional phase of a PCT application. National and regional provisions are generally decisive.

So, the PCT application will be handled quite differently in the various jurisdictions.

PCT national/regional phase, cont.

In China, the same unity requirements apply as under EPC, so two or more applications have to be filed there in case there is a lack of unity under EPC practice.

In Japan and the US, it may be possible to enter the national phase including the various embodiments A, B,C. The Examiner will assess and decide whether a single novelty search can be made for the various inventions included in the PCT application. However, one or more divisional applications may have to be filed in order to cover the whole scope of the inventions A,B,C. In the end, national law and practice will determine whether one application can cover inventions A, B and C.

Non-European Applicants

Of course, all those who file European applications, even as subsequent applications after filing a first application in their domestic jurisdiction (e.g. US or JP) have to consider the novelty requirements even for the same applicant (no anti-self-collision under EPC).

A trap is that a possible divisional application can only include subject matter which is fully supported, in an unambiguous way, by the application as filed. This provision is very strict.

Non-European Applicants, cont

Non-European filers of EP applications also have to consider the consequence of the lack of anti-self-collision provisions under EPC.

A second application, having a later priority date than a first application, may be rejected because of a novelty bar arising from the whole contents of the disclosure of the first application, even if the second filing occurs within 18 months. In other words, an applicant can create secret prior art that will be held against the same applicant.

Other aspects of self-collision (1)

When is an invention "the same"?

Because of the Gold Rule (G2/10), an invention is considered to be the same if and only if the skilled person will be able to unambiguously and directly assess that the inventions are the same. Even small differences can make the inventions different, even if the difference only pertains to equivalent technical means.

Other aspects of self-collision (2)

When is an applicant the same "applicant"?

Under EPC, it does not really matter, when considering conflicting applications, whether the applicant is the same or not. Generally, the same rules apply for the same applicant and for different applicants. There is no anti-self-collision provision.

Also, it does not matter if the inventors are the same or not in two conflicting applications.

Other aspects of self-collision (3)

When does a first application anticipate the claims of a second application?

Because of the whole contents approach, even parts of the first application that are not claimed will form part of the state of the art and will be taken into account when assessing the novelty of the claims in a second application. "Prior claiming" is no longer relevant in Europe.

Other aspects of self-collision (4)

What if a PCT application is filed but not lodged in a country?

If a PCT application is not entered as a regional phase application, the PCT application will only be novelty-destroying for a later EP application as from its publication date, not from its priority or filing date.

Other aspects of self-collision (5)

General experience from filing first in Europe and thereafter in other jurisdictions:

If you observe the provisions under EPC, you do not have any serious problems in other jurisdictions.

It is another matter how to make optimum use of the laws and practice in other jurisdictions, e.g. in the US.

Thanks for your attention

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