



Resolution of the Executive Committee, Toronto, Canada, 3-5 & 8 June 2018 “Conflicting Applications”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Toronto, Canada from 3 to 5 and 8 June 2018, passed the following Resolution:

Agreeing that the International patent system would benefit from some harmonisation of substantive patent laws, particularly in relation to the treatment of earlier filed but later published applications (“conflicting applications”);

Supporting the efforts of Group B+ to achieve international harmonisation in relation to treatment of conflicting applications;

Considering the various proposals put forward to Group B+ by user groups including the Industry Trilateral, composed of IPO, AIPLA, BusinessEurope and JIPA, for potential approaches to achieve harmonisation in relation to the treatment of conflicting applications;

Appreciating that in a first-to-invent system the earlier filed application is treated as secret prior art against the later application (subject to protection against self-collision mechanisms) while in a first-to-file system the earlier application is not actual prior art, but can give rise to the potential for double patenting, which should be avoided;

Further appreciating that the alternatives of the so called “prior claiming” approach and the “whole of contents” novelty approach adopted in first-to-file countries recognise that both first and second applicants may make useful, albeit the same or similar, contributions over the actual state of the art, and to be equally deserving of patent protection, but avoid double patenting;

Understanding that while a “prior claiming” approach is sufficient to avoid double patenting, this approach is not preferred since it is often necessary to wait for the claims of the earlier application to be finalised before examination of a later application can be completed;

Observing that the problems associated with the “prior claiming” approach have been resolved within Europe and various other countries with first-to-file systems by adopting a “whole of contents” approach, according to which the whole disclosure of an earlier filed application is “deemed” to be part of the state of the art, requiring the later applicant to subtract from their claims the entire disclosure of the earlier application, such that any potential for double patenting is removed;

Further observing that although the “whole of contents” approach involves deeming the disclosure of the earlier application to be part of the state of the art, it is not an actual assessment of the novelty of the claims over the disclosure, but a tool for determining the subject matter that needs to be subtracted from the claims of the later application to avoid potential double patenting;

Acknowledging that the “whole of contents” approach to the treatment of conflicting applications has formed part of the European Patent Convention since its commencement and



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has provided a predictable and effective mechanism for resolving conflicts between applications filed on different dates since that time;

Further acknowledging that the “whole of contents” approach to the treatment of conflicting applications can be applied in the same manner to earlier applications filed by the same or different applicants with the result that no additional protection against self-collision or terminal disclaimers are required;

Believing that any harmonised approach to the treatment of conflicting applications must be relatively simple and easy to understand, based on well-established principles of patent law, and strike a proper balance between the interests of applicants, third parties and the general public, and also between large companies and small entities, including individual inventors; and

Additionally believing that requiring later applicants to subtract more from their claims than necessary to avoid the potential for double patenting without sufficient justification may extend the balance too far in favour of earlier applicants, and that the introduction of protection against self-collision and terminal disclaimers would introduce additional complexity which is not warranted given the successful operation of the “whole of contents” approach for many years;

Cautions Group B+ and Authorities against adopting a mechanism for the treatment of conflicting applications that has not been tried and tested within a first-to-file patent system of a major jurisdiction, including mechanisms that represent a hybrid or composite system comprising elements borrowed from a first-to-invent system; and

Urges and encourages Group B+ and Authorities to adopt the “whole of contents” novelty approach as a model system for international harmonisation of the treatment of conflicting applications.

For further information see FICPI Position Paper on Patent Law Harmonization / Group B+:
https://www.ficpi.org/_uploads/gonzo/FICPI-WP-2018-001-Patent_Law_Harmonization.pdf

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