

Submission to the Canadian Intellectual Property Office

Consultation: Principles Guiding
The Harmonization of Substantive Patent Law

March 23, 2016



INTELLECTUAL PROPERTY INSTITUTE OF CANADA
INSTITUT DE LA PROPRIÉTÉ INTELLECTUELLE DU CANADA

Introduction

The Intellectual Property Institute of Canada (IPIC) is the professional association of patent agents, trade-mark agents and lawyers practising in all areas of intellectual property law. Our membership totals over 1,700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g. patents, trademarks, copyrights and industrial designs) in Canada or elsewhere, and also foreign companies who hold intellectual property rights in Canada.

IPIC is pleased to submit its comments to the Consultation on Principles Guiding the Harmonization of Substantive Patent Law. IPIC's International Patent Issues Committee and Patent Legislation Committee carefully prepared this document.

This consultation is to the Group B+ effort on Patent Harmonization. In the document prepared by CIPO Objectives of the Global Patent System are stated. In particular, the global patent system should:

1. Be coherent and balanced:
 1. offering a fair level of protection to inventors/applicants from all backgrounds
 2. providing a fair balance between the rights of inventors/applicants and third parties
2. Provide legal certainty to inventors/applicants and third parties alike
3. Promote high quality patents by ensuring that patent protection is provided only to inventions that are new, involve an inventive step and are capable of industrial application
4. Support economic growth:
 1. enabling global patent rights to be acquired in an efficient manner
 2. promoting consistent results in multiple jurisdictions
 3. promoting innovation and competition

Harmonization of patent law globally is admirable, and should be pursued to the extent they benefit applicants; provide certainty; and support economic growth.

Striving for a global patent system with uniform legal standards and uniform procedure may not yet be possible until national patent laws have further converged. For example, given existing differences in national laws whose substantive view of patentability should govern: the EPO's; the US's; the UK's; Canada's?

Generally, Canada's current laws are consistent with Group B+ topics and harmonization efforts set out below. However, in each case further study is recommended.

1. Recommendations re. Grace Period

In Canada, the grace period is provided in the *Patent Act*, at paragraph 28.2 (1):

The subject-matter defined by a claim in an application for a patent in Canada ... must not have been disclosed

- (a) more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere ...

Section 2 of the *Patent Act* defines certain terms as follows:

“applicant” includes an inventor and the legal representatives of an applicant or inventor;

“legal representatives” includes heirs, executors, administrators, guardians, curators, tutors, assigns and all other persons claiming through or under applicants for patents and patentees of inventions.

Canada’s *Patent Act* has always provided a grace period. Current Canadian law affords applicants a one year grace period for applicant derived disclosures. This grace period is believed to address the objectives set out in the discussion document.

Adoption of a grace period at least as similar to Canada’s in other jurisdictions would be encouraged.

1.1 Type of Disclosure:

It is believed that the policy reason for the grace period is to provide applicants who have publicly disclosed their inventions (inadvertently or otherwise) with an opportunity to file a patent application within the grace period.

In practice, the grace period is utilized relatively often. There are many different reasons why an applicant may fail to file a patent application prior to a public disclosure.

Accordingly, there would seem to be no policy reason for limiting the grace period to only certain types of public disclosures.

Not only is the scope of a public disclosure sometimes difficult to assess, it is often also difficult to determine even whether a public disclosure has taken place.

1.2 Duration – Start of the Grace Period (Filing or Priority):

The grace period is one year. In paragraph 28.2(1) of the *Patent Act*, the grace period is determined from the filing date. IPIC believes this should be the minimum term of the grace period.

Current U.S. legislation provides for a one-year grace period calculated relative to a priority date, whether the priority filing is in the U.S. or not. Harmonization to make a grace period dependent on a priority claim would make sense. If adopted in Canada, for example, a grace period dependent on a priority claim would probably result in more patent applications filed in Canada by U.S. applicants. This is an applicant-friendly provision, because it gives the applicant more time to determine whether to proceed with filing patent applications elsewhere within the priority period. Accordingly, there are good policy reasons for making the Canadian grace period consistent with the U.S. grace period.

1.3 Declaration (No Declaration, Optional or Mandatory Declaration):

At present, the applicant is not required to provide a statement or declaration regarding a public disclosure that may or may not affect a grace period.

There would seem to be no policy reason for requiring an applicant to provide such a statement or declaration. In effect, the applicant currently bears the burden of determining the effect of any pre-filing public disclosures on a subsequently-filed patent application. It is up to the applicant to ensure that any filings are within the grace period, and the consequences of improperly filing outside the grace period are believed to be sufficient to enforce compliance.

A requirement to provide a statement or declaration regarding a public disclosure would impose a significant burden on an applicant. In practice, the scope of a public disclosure, or even whether a public disclosure has actually taken place, is sometimes difficult to determine. Also, in many cases, it would be difficult to provide a useable statement describing the extent of the public disclosure, if any. In general, complexities introduced through declaration requirements of declarations, and/or limited types of disclosures are believed to detract from the above objectives.

In practice, the grace period is frequently important to Canadian inventors. It would be helpful to applicants if similar grace periods were available in more countries.

1.4. Rights of Third Parties:

The interplay between the grace period and prior user rights merits further study.

2. Recommendations re. Publication of Applications:

2.1 Canadian Law:

In Canada, in accordance with subsections 10(2) and (3) of the *Patent Act*, an application is published eighteen months from its filing date or, when a request for priority has been made for the application, from its priority date.

Moreover, the exceptions found under the Canadian *Patent Act* which may lead to the non-publication of an application are limited. Namely, the Governor in Council may decide to keep an application secret (subsection 20(17) of the *Patent Act*) when the application relates to a munition or instrument of war, is vital to the defense of Canada and publication should be prevented in order to preserve the safety of the State.

2.2 Policy Considerations:

A global publication regime would take into account the two following policy considerations:

A) Allowing third parties to have timely notice of new patent applications and patent rights, promoting better allocation of research funds and avoiding costly litigation;

B) Providing an inventor with sufficient time to decide to pursue the obtaining of a patent, or opting instead to withdraw the application and keeping the information as a trade secret.

2.3. Position with respect to the principles prepared by the B+ Sub-group:

A) An 18 month window, calculated from the filing or priority date, is an adequate period to balance the interests of the applicant and third parties alike, in light of the policy considerations mentioned above.

B) The period of non-publication needs to be clearly defined and consistent between countries such that the intellectual property risk and uncertainty for third parties inherent to this period of confidentiality can be reliably mitigated. A consistent 18-month window of confidentiality also provides an applicant with a reasonable opportunity to conduct research and business inquiries prior to making a decision to withdraw his application if the applicant wishes to keep it secret. Furthermore, this period of eighteen months should be certain. In Canada, IPIC notes that the applicant only has a 16 month window (see Rule 146 of the *Patent Rules*) during which the applicant is certain that abandoning the application will lead to non-publication. From the sixteenth to the eighteenth month, the application will not be published only "if the Commissioner is able to stop technical preparations to open the application to public inspection at a subsequent date".

Recommendation: There needs to be a clear, consistent and certain period defined during which the applicant may withdraw the application while avoiding publication.

C) In order to allow the applicant to assess the patentability of a proposed invention prior to publication of its application, the applicant should be allowed to obtain some degree of examination, within the 18 month time frame, without having to first publish the application. In Canada, an applicant is currently able to request accelerated examination, but examination will not commence until the application is published. There is currently no opportunity for a Canadian applicant to have his or her patent application examined prior to publication. Many jurisdictions, such as in Europe or in the UK, provide a first search report / examination report, or at least allow for this option, within the 18 month non-publication period, without the application having to be published. However, IPIC notes that if an applicant has the option of receiving an examination report prior to publication and formal examination commences, this presents the possibility of an application being allowed before publication. This is

problematic with regard to allowing interested third parties, unaware of unpublished applications, to have the opportunity to challenge the application before it is granted. There are some mechanisms already in place in some jurisdictions to balance the opportunity to receive examination prior to publication, and allowing third parties to challenge patentability. For example, UK law and practice provides that in a case where a patent application is ready for grant before publication, there is a mandatory three month period, between publication and grant, allowing for third parties to file their observations.

Recommendation: providing an option for early examination or for receiving a search report without having to publish the application. This would allow an applicant, if he so chooses, to better assess the patentability of a given application without risking publication.

The patent system should consider a third party's right to challenge the application before the patent is granted if such an option for early examination were to be included. Further considerations would need to be evaluated before arriving at an adequate procedure for doing so. Such a procedure may include:

- i) publishing the application once it is allowed and permitting third parties to challenge the application after allowance;
- ii) requiring that the applicant request publication of the application as a condition prior to *responding* to an examination report; or
- iii) providing the applicant with an opportunity to withdraw the application prior to publication within a time period dating from the first examination report.

D) Regarding patent offices' ability to suppress information in an application in exceptional circumstances, it is unclear how such applications would be identified, given that Canadian applications are not examined until after publication. A preliminary step, prior to examination, may therefore be required for such identification. IPIC is of the opinion that if any exceptions are to be included at all, they should be narrowly defined, such that:

- i. inclusion of vague terms, such as "offensive or disparaging", "morality", should be discouraged;
- ii. a classification system, identifying narrow categories of potentially problematic subject matter (e.g. relating to nuclear matters) should be adopted, providing objective guidelines for patent offices to identify applications that require review prior to publication;
- iii. the patent system should not become a vehicle for censorship.

A system notifying the public of the presence of a ban and allowing third parties to challenge the ban may also be required. In addition to the applicant's rights, a third party's right to have access to a published application may be jeopardized by such a ban.

2.4. Other considerations:

A) The US is the only jurisdiction to provide for an "opt-out from publication" option for applicants only filing in the U.S. IPIC takes the position that an opt-out provision would give the applicant an unfair advantage, not having to disclose the invention until much later, but still being entitled to a patent if the requirements are met. This reality goes against the purpose of the patent system: granting a monopoly of rights for a given period in exchange for disclosure.

In summary:

1. Canada has published ("laid-open") pending applications since 1989. The PCT similarly provides for such publication.
2. Publication provides for public certainty.
3. There is no need to conflate the availability of patent protection (i.e., the availability of a search) with publication.
4. Early withdrawal of applications from publications by applicants should be available.
5. Early publication at the request of applicants should also be available, if beneficial to the applicant.
6. Greater clarity between the interplay of provisional pre-grant provisional rights (e.g. *Patent Act* s. 55.1) and publication should be sought.
7. Patent Offices should not act as keepers of public morality or national security. Both concerns can be addressed by other forms of legislation.

3. Recommendations re. Conflicting Applications

The comments provided in this section deal mainly with issues of conflicting applications as they relate to double patenting. Questions relating to "secret prior art", i.e. the citability of unpublished applications having an earlier effective date (filing or priority), are discussed under Section 5: Recommendations re. Prior Art.

3.1. The present law in Canada respecting "double patenting" is governed by s. 36 of the *Patent Act*, which states "A patent shall be granted for one invention only..." This has been interpreted by the courts and CIPO to constitute a blanket prohibition against "double patenting". An exception arises if during prosecution, the examiner requires the applicant to cancel claims due to lack of unity of invention, in which case the subject matter of those claims can be placed in a divisional application.

3.2. It is our understanding that Canada applies a stricter prohibition against double patenting than many other jurisdictions. IPIC understands that the laws in EPO, Japan, Australia and possibly elsewhere are less restrictive and generally permit an applicant to file a “voluntary” divisional application even if there has been no “unity of invention” objection. Furthermore, the United States has a “terminal disclaimer” rule that provides a similar result. If the examiner believes that the claims of an application overlap claims of another application by the same applicant, the applicant agrees to “disclaim” any part of the patent term of a patent that extends beyond the term of the cited case. Also, ownership cannot be divided between the patents. This approach can be cumbersome but it achieves a generally good result in that it provides flexibility to inventors.

3.3. The present law in Canada is unfavorable to inventors. There are a number of reasons why an inventor may wish to have multiple patents. Most commonly, this is a strategy that allows the inventor to obtain an issued patent initially for narrow subject matter (or other easily patented aspects), while continuing to pursue more difficult subject matter. IPIC recognizes that there could be drawbacks to competitors, in that there may be uncertainty while an application remains pending. However, in practice this is probably not a frequent occurrence since the alternative for the inventor is to keep the entire application pending while all claims are pursued, which can result in more uncertainty all round. In general, a less restrictive “double patenting” rule is favorable to inventors and innovation. If we want to encourage innovation and to remain competitive with our trading partners, we should make our patent system more flexible and user-friendly.

3.4. As well, if the objective of CIPO is to harmonize our laws with our major trading partners (group B+) then our laws should permit greater scope for allowing multiple patents for a single inventive concept. That allows for generally similar patent coverage between countries, which is good for inventors and also reduces uncertainty for third parties. It avoids the “patchwork” scenario that presents difficulties for everyone.

3.5. A distinction must be drawn between “double patenting” arising from a common parent (or, in rare cases, two separate applications filed on the same day) vs. arising from applications filed at different times. In the first case, all of the patents would normally expire on the same day and so there is no “evergreening” of patent term. IPIC propose that double patenting rules be relaxed for applications having the same filing date. As we discuss below, the situation becomes a bit complicated if Canada adopts patent term adjustments (PTA), but that aspect could be addressed if and when PTA becomes the rule in Canada.

3.6. There are potential drawbacks to the “terminal disclaimer” approach. These include the uncertainty as to whether the divisional patent could still be invalidated for double patenting. As well, there is the problem that an examiner may fail to require a terminal disclaimer during prosecution, leaving the divisional patent open to a future expungement. Any change in our law should contemplate these situations.

3.7. One approach IPIC considered was an alternative to terminal disclaimers that would minimize some of the above issues. For example, the law could be changed to state that an applicant may be granted

multiple patents for the same invention, provided the applications share a common filing date. Presumably, these would also have to be published at the same time to minimize prejudice to third parties.

3.8. If Canada adopts PTA pursuant to the Trans Pacific Partnership Agreement (TPP), this makes multiple patents a bit complex. One can envision a situation in which the term of one patent is extended, but the term of a divisional of that patent is not extended. Under US-style “terminal disclaimer” rules, it would seem that the owner must either drop the shorter-term patent or not receive the PTA for the first patent. This places the owner in an unfair situation and seems contrary to the intent of PTA. Our suggestion in paragraph 7 above might minimize this conflict in that it would allow multiple patents for applications sharing a common filing date, regardless of any possible PTA of one of these patents.

3.9. IPIC was also asked to consider sections 28.2(1)(c) and (d) of the *Patent Act*, which relate to conflicting applications under the “first to file” regime. Based on our understanding, Canada seems to be closely aligned with other countries and no particular “harmonization” of these provisions is required. One thorny issue arises when an application is expedited and ends up being prosecuted before a competing application having an earlier claim date is filed in Canada. For example, an application winding its way through the PCT route could effectively be a “submarine” that could torpedo an issued patent. However, short of dramatically slowing down prosecution of all cases, there seems to be no reasonable way to prevent this situation. This situation seems rare since none of us had ever actually experienced it. In general, these provisions seem to work well.

In summary:

1. Canadian law as it relates to conflicting applications/double patenting in Canada requires clarification. Harmonization as set out in the discussion document may be premature. Further study is encouraged.
2. Canada’s *Patent Act*, on the one hand, codifies a first-to-file patent system, that nevertheless prevents “self-collision” of co-pending applications by the same applicant. At the same time, the *Patent Act* does not distinguish “incremental inventions” from other “inventions”. On the other hand, judge made law has created a prohibition against “double patenting” that clouds some of the foregoing principles as codified in the *Patent Act*.
3. PCT applications published in English or French are treated the same as co-pending Canadian applications, only once nationalized in Canada. This seems sensible.
4. Domestic law should be holistically reviewed and clarified. For example, the Canadian *Patent Act*’s definition of “Applicant” for purposes of determining whether co-pending applications can be cited should be clarified.
5. When exactly does the law of double patenting apply? Only to the same inventors? Applicants? To divisional applications? How can risks of double patenting be assessed and avoided *a priori*?

4. Recommendations re. Prior User Rights

In respect of prior uses, IPIC has assumed for present purposes that any prior use is a use that was not made publicly available such that they could be reverse engineered and could be cited as novelty destroying prior art. Canada's *Patent Act* provides limited prior user rights (see *Patent Act* s. 56 below). However, Canada's domestic law is largely undeveloped in some respects. For example, what is the territorial limitation on the prior user rights? Are there limits on how prior-acquired inventions may be used? How do prior-user rights apply to processes? Further study/revision is encouraged.

4.1. Canadian Law

Section 56.(1) of the Canadian *Patent Act* makes an exemption for people who have acquired, as in purchased or constructed, a "specific article, machine, manufacture or composition of matter" prior to the relevant claim date of the patent at issue and allows them to continue to use and sell to others the specific article, machine, manufacture or composition without being liable to the patentee. While this section does not specifically set out whether "method" claims would be captured by this exemption, there is case law that prior user rights to a method claim are present if the method is performed by an apparatus that is covered by the patent and the apparatus was obtained prior to the relevant claim date (*Libbey-Owens-Ford Glass Co v Ford Motor Co of Canada Ltd*, [1970] S.C.R. 833). It is unclear whether a prior use relevant to a patent covering only method claims would benefit from this exemption.

4.2. Comments

Generally, IPIC support the notion of affording prior use rights and more particularly, IPIC believes that prior use rights should be afforded to both apparatus and method claims. While method claims may be more difficult than apparatus claims to determine infringement, the group does not believe that creating a distinction between the types of claims with respect to prior use rights is fair as some modern day inventions can only be claimed using method type claims.

It is believed that the concept of prior use would most often come up in the case of a secret use. This can often occur when Party A decides for whatever purpose to maintain a particular invention as a trade secret and then another unrelated Party B, develops the invention independently and files for, and obtains a patent. The question being that whether Party A should be entitled to prior use rights?

It is believed that a careful balance should be maintained between the right of Party A to continue to practice what they developed and Party B who disclosed their invention to the world as part of the bargain to

obtain a patent. Party A for example in some scenarios made a business decision to keep a device/method as a trade secret in the hopes that not making it publicly available would offer them some advantage. The purpose of the patent system is to foster innovation by encouraging parties to file applications which provide knowledge to the state of the art. This would not be achieved by rewarding the secrecy of Party A in the above scenario.

It is believed that a proper balance may be achieved if the rights of Party A to benefit from a prior use exemption are limited in some manner and that this exemption should be (i) somewhat narrow but (ii) well defined prior user rights with a strong requirement of supporting the bona fide prior use for inventions that were independently developed by Party A. The limitations could include the level of output, repairs, the rebuilding of equipment and geographical spread of distribution and a clear demonstration of creation and usage of the invention in some manner before the claim date for Party B's patent. This would allow the fairness among the parties and encourage companies to factor in the benefits and/or drawbacks of seeking/not seeking patent protection in their business decisions.

As to the specific question or whether a "graced disclosure" should be granted a prior use exemption, it is generally believed that it should be not. Assuming that any proposed grace period would not exceed 12 months, the time limit between a disclosure and a follow-up patent application is already quite limited. It is believed that granting a prior use exemption for a graced disclosure would be viewed by Applicants as essentially being the same as requiring an absolute novelty standard which would be counterproductive to the reasoning and purpose of implementing the proposed grace period in the first place.

4.3. Additional Points to Consider/Summary

- 4.3.1 Activities to trigger the right – an actual use is required, as opposed to mere possession or knowledge of the invention or "preparations" to use the invention; the US requires actual use but other countries require only varying degrees of preparation.
- 4.3.2 A good faith requirement – s. 56(1) does not explicitly include this, but the statutes of other countries (including the US and UK) do; Canadian jurisprudence has required some level of good faith in any case, so that may be sufficient
- 4.3.3 Territorial restrictions – most agree that the prior user rights are limited to the territory in which the use (or preparations, if a jurisdiction allows that) has taken place, and some jurisdictions have statutes that expressly say that, though Canada does not; there is some debate as to the scope of territory in the EU; as Canada is currently unofficially harmonized with the rest of the world, this is not a major issue

- 4.3.4 Critical date – generally believed by most to be the priority date of the application, but others (notably the US, which requires use more than a year before the effective filing date or the inventor’s grace period disclosure) differ. IPIC favours the usage of the priority date, which should be harmonized.
- 4.3.5 Source of the knowledge – while some take the opinion that prior user rights should be derived from a grace period disclosure, IPIC believes that it should not.
- 4.3.6 Ability to transfer or license the right – our understanding is that in Canada neither assignment nor license of any prior user right is allowed, but other jurisdictions allow the right to be transferred, usually with some restrictions, such as only along with the entirety of the business; I’ve seen a reference that says Canadian case law exists that suggests transfer under those restrictions would be reasonable but nothing actually deciding the matter; it might be a useful topic for the B+ subgroup, or it might just be something that Canada needs to settle for itself
- 4.3.7 What further activities are permitted – most countries are similar to Canada, which allows essentially the same scope of activities that gave rise to the right, but others (such as the US and UK) allow slightly broader activities while German law apparently can have the effect of narrowing the scope of future activities; IPIC doesn’t think Canada needs to change anything, as it appears to be harmonized with most of the world, though not with the US.
- 4.3.8 Post abandoned, but reinstated application/patent –Another possible issue is to the effect of whether any prior user rights can stem from use that commences during the time that an application is considered abandoned but is later reinstated, or a patent is lapsed but is later restored. The UK apparently allows such rights. Given Canada’s relatively relaxed reinstatement system, consideration should go into determining whether such a scenario should be accounted for in any proposed change in law or regulation.

5. Recommendations re. Prior Art

5.1 Overview

As noted in the consultation document, patents should only be granted for contributions that place in the hands of the public information that had not been previously known. This contribution is measured against the “Prior art”, which is necessarily defined by the novelty provision in any patent law, which may vary between jurisdictions. The harmonization efforts in the consultation document appear consistent with current Canadian patent law. Canada’s *Patent Act* includes novelty and non-obviousness requirements over “(b) information disclosed before the claim date ... in such a manner that the information became available to the public in

Canada or elsewhere” (s. 28(3)). This “information” needs to be viewed through the eyes of the skilled person. The lens of the skilled person is used to assess how the information is to be interpreted. Any exceptions to this definition should be consistent with the handling of the grace period, and conflicting applications (discussed above).

The topic of “Prior Art” is understood to encompass two separate considerations:

(i) harmonization of the definition of what constitutes prior art as provided by a particular novelty standard;

(ii) for any given novelty standard, exactly what does or should “Prior Art” encompass?

5.2 Basic definition of “Prior Art”

Harmonization of the basic definition of what constitutes prior art in Canada in relation to the standards found in other jurisdictions may not be an overly controversial topic, as the current Canadian novelty standard shares basic elements those foreign standards.

In the SPLT, the following definition is proposed for prior art:

“Prior art with respect to a claimed invention shall consist of all information which has been made available to the public anywhere in the world in any form, before the filing date, or where priority is claimed, the priority date of the claimed invention”

It is also now a common standard that “Prior Art” must provide an ‘enabling’ disclosure

The above basic definitions for prior art are aligned with the requirements already applied in Canada, and harmonization on this aspect should be achievable without substantially altering the requirements presently found under Canadian patent law and practice.

5.3 Particular implementations / things to consider

While consensus on the basic definition of what constitutes prior art under a novelty standard may be achievable, there are a number of differences between jurisdictions regarding how this basic definition is applied.

The following discusses a few potential issues to consider:

5.3.1. Treatment of unpublished applications as prior art

Under a first to file system, a later filed patent application can be defeated by an earlier filed patent application that discloses the invention even when that earlier filed application was not published when the later

application was filed. This prior application is therefore temporarily "secret". Such secret prior art can defeat the later filed patent application whose applicant did not and could not have known the "complete" state of the prior art.

In Canada, a claim can be deemed anticipated if it is disclosed by a third party in an unpublished application in Canada that has a relevant date (filing or priority) that precedes the relevant date of the claim in question. Obviousness, however, is only assessed against prior art that was published prior to the filing/priority date. This differs from some other jurisdictions, where the same unpublished application that has an earlier relevant date may be citable for both anticipation and obviousness.

There are pros and cons to both frameworks that require further study.

The present Canadian model, where an unpublished application cannot be cited for obviousness, makes internal sense as an invention could not have been obvious to a skilled person in view of reference that was not publically available at the time of filing/priority.

However, using a single standard for determining if an unpublished application qualifies as prior art, and the considering that document for both anticipation and obviousness may facilitate the assessment of patentability, and may be a more readily accepted framework for harmonization.

Other possibilities include frameworks where the secret art is citable for obviousness, but it cannot be combined with any other reference.

Further, if unpublished applications are not to qualify as prior art for determining obviousness, should the prior art effect of a later published application, with an earlier effective date, extend to trivial or minor variations of the disclosure in the earlier application? Otherwise a later applicant could have claims allowed to trivial variations from the application with the earlier effective date.

In addition to the above, there are further questions tied with the citability of prior unpublished applications as prior art. IPIC doesn't have particular recommendations on these topics at this time:

- i) Should a PCT application be treated as prior art only in the offices in which the PCT application undergoes national entry, as is the present case in Canada? Should a PCT application instead be citable as of its application/priority date, even if it never enters the national stage in Canada? In order to place PCT applications on the same footing as national applications, should they have a prior art effect in all countries for which the application has active designations as of the publication date?
- ii) Should an applicant's own applications be treated differently from those of others, to avoid self-collision, as found under current Canadian law? If the applicant's own applications are to be treated differently, does this require complete identity between the applicants, or is just some overlap sufficient? Is it acceptable for an applicant to acquire a cited, competing application, to

remove it as “Prior Art”? There may also be an interplay between self-collision and double patenting not explored in this document.

5.3.2 Transitory/internet publications

A major hurdle today is the vast amount of information published on the internet.

- i) How do you establish a date for any internet publication?
- ii) Does it matter if a disclosure is very transient, e.g. it is on a website for a very short period of time and is taken down? If a short period of time is accepted, this could be abused by those who deliberately publish for a short period of time, which no one effectively notices, but who then keep a record of the publication to use as prior art at later date. It is noted that in Europe, the decision in T1134/06 discusses the concept of proving public prior use beyond any reasonable doubt or "up to the hilt".

IPIC International Patent Issues committee / Patent Legislation Committee

March 18, 2016