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SUBSTANTIVE PATENT LAW TREATY Section 8(2)

Enlarged Concept of Novelty

TMPDF has carefully studied the draft document of 2 December 2004 prepared by the International Bureau of WIPO, concerned with an enlarged concept of novelty. In particular, we have considered whether the enlarged concept of novelty set out as model B in the document might be used in establishing whether an unpublished earlier application should be regarded as novelty destroying prior art in relation to a later application.

While we appreciate that model B has been proposed as a possible compromise in an effort to overcome problems in reaching agreement on SPLT draft article 8(2), concerning the prior art effect of earlier unpublished applications, we are unable to accept it. We do not consider that the model provides a reasonable basis for interpreting a single item of prior art, whether published or unpublished, in relation to a later application. We strongly support the approach under present UK law and EPC, i.e., that for a single item of prior art to destroy the novelty of a later application, it must contain an enabling disclosure of the invention claimed in the later application. We also strongly support the present provisions under the UK Patents Act (Section 2(3)) and EPC (Article 54(3)) whereby an unpublished earlier application can only be cited against a later application in connection with novelty, not inventive step, i.e., TMPDF supports only model A in the WIPO document.

We consider that the existing UK and EPC provisions strike the right balance, are fully justified and should be adopted internationally. The grant of the same patent to two different applicants should be avoided, but the unfairness involved in achieving this (i.e., that an earlier unpublished application is considered to be prior art as regards novelty) should not be exacerbated by considering the earlier unpublished application also in relation to inventive step. Most of our member companies accept that in many technical fields there will be complex interrelationships between patents in different ownership that have to be resolved. Patents granted under the approach required by UK Section 2(3) and EPC Article 54(3), on improvements that may not contain an inventive step relative to an earlier unpublished application, do not significantly add to the problems.

We consider that the arguments in favour of an enlarged concept of novelty are spurious. For an item of prior art to destroy novelty, it should contain clear instructions that will produce the later claimed invention. The requirement in patent law that an invention should be novel means that it has not been done before, per se. The enlarged concept requires that an earlier unpublished application, that does not contain instruction on the performance of the invention, should be considered on the basis of common general knowledge, especially of "equivalents", and on the basis of what a skilled person might envisage from the disclosure. What this might mean in any particular case would be controversial and inconsistent with the requirement of novelty. To establish the extent of common general knowledge, and what might be regarded as equivalents, in the particular circumstances of the application in suit, or what a skilled person might envisage from the undisclosed prior application, would call for extensive evidence and justification, which the applicant would be likely to dispute. Patent examiners would not have sufficiently broad experience to deal with such controversial matters reliably. The argument would inevitably turn into one concerning inventive step.

As regards an anti-self collision provision, TMPDF is opposed to this. There is no reason to give favourable treatment as regards later developments to the applicant, over others, while there is good reason to avoid the possibility that such a provision might be misused, e.g., to facilitate regular

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late filing of supposed developments or to extend patent life. In any event, under model A, there is no need for anti-self collision, since later applications concerning developments that can be distinguished on novelty grounds from the disclosure in an earlier application will be possible.

To conclude, TMPDF is opposed to any compromise on SPLT Article 8(2), which should be based on model A. If this cannot be agreed by all negotiating states, then it might have to be accepted, with great reluctance, that this is an issue on which agreement is not possible.

We consider that harmonisation that results in an unsatisfactory, fudged, compromise would be a seriously retrograde step. Our members would rather prefer to have two different systems (model A in Europe, C in the US), on the basis that the position would at least be clear.

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Note: TMPDF represents the views of UK industry in matters concerning intellectual property. It has close links with the CBI. Its members include many of the major innovative UK companies, which are represented at meetings of the governing Council and Committees of the Federation by their professional IP managers. Before the Federation takes a position on any issue, official consultation documents and other relevant papers are submitted to the members for debate and dialogue. An appropriate Committee and/or the Council, depending on the issue, then determines the position, taking account of comments.

The published views/opinions/submissions of the Federation are normally approved by consensus. In cases where there is a substantial majority view falling short of consensus, any significant disagreement will be indicated.

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