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AMERICAN BAR ASSOCIATION

February 28, 2013

Via Electronic Mail: IP.Policy@uspto.gov

The Honorable Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property
and Acting Director of the United States Patent and Trademark Office
Mail Stop OPEA
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Bijou Mgbojikwe

**Re: Comments on Notice of Public Hearing and Request for
Comments on Matters Related to the Harmonization of
Substantive Patent Law (Federal Register / Vol. 78, No. 22 /
Friday, February 1, 2013/ Notices)**

Dear Acting Under Secretary Rea:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to provide comments in response to the request of the United States Patent and Trademark Office ("the Office") Notice of Public Hearing and Request for Comments on Matters Related to the Harmonization of Substantive Patent Law (Federal Register / Vol. 78, No. 22 / Friday, February 1, 2013 / Notices). In particular, the Section submits the following comments in response to the Office's request for public comment regarding international harmonization of substantive patent law. Additionally, we request an opportunity to present oral testimony on the Section's comments at the public hearing on the international harmonization to be held on March 21, 2013. The American Bar Association is the largest voluntary professional association in the world and the ABA-IPL Section is the largest intellectual property law association with over 24,000 members. These comments have not been approved by the American Bar Association's House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

The Section appreciates the opportunity to provide input via written comments to the Office on international harmonization of substantive patent law. Like many organizations, in an effort to determine the views of our members, the Section conducted a survey based on four areas of patent law: eighteen-month publication of applications, prior user rights, conflicting applications, and the grace period.

We attach a copy of our survey questions and the results for your information. The following comments reflect the majority views of the survey respondents, and in many instances, explain how these current views relate to previously held positions of the Section.

For many years, the Section has favored early publication of patent applications as an appropriate balance between the interests of the applicant and the public. We believe that publishing the application eighteen months from the earliest filing date or priority date serves as adequate timing to provide this balance of interests. Further, we support the elimination of the opt-out from publication that is currently allowed under U.S. law, particularly if it were part of an international harmonization effort. Requiring publication of all patent applications which are not withdrawn prior to the eighteen-month date improves transparency, allowing inventors to see more of the art in the field.

Similarly, the Section has long supported prior user rights as a defense to alleged patent infringement in a first inventor to file patent system. As early as 1993, the Section supported prior use before the earliest filing date of a patent, alleged to cover the activities of the prior user as a personal defense for the alleged infringer. Additionally, the Section's position has been that the use could not be based on information obtained or derived from the patentee or those in privity with the patentee, that the use demonstrated operability of the invention and the user took significant steps toward commercialization.

The Section continues its support for the prior user rights defense. We recommend that the current requirement of the America Invents Act—that the prior use be established more than one year before the effective filing date of the patent—be revised to require that the prior use be established anytime before the effective filing date of the patent alleged to be infringed by the prior user's activities.

Harmonization of conflicting applications begins by defining which disclosures qualify as prior art. To be prior art, a disclosure must be reasonably and effectively accessible: reasonably accessible meaning that undue burden is not needed to locate or obtain the disclosure, and effectively accessible meaning that, once located, undue burden is not required to interpret or comprehend it. The disclosure must also be enabled.

The Section believes that a patent application should be considered prior art whenever it is reasonably and effectively accessible—no matter the language or the geographic location of disclosure, no matter whether the application is an international or national application or whether the application has entered the national phase in a certain country—if the application is reasonably and effectively accessible, it should qualify as prior art from its effective filing date.

Consistent with the Section's previously-held position, the majority of survey respondents favor examining conflicting applications under novelty and obviousness / inventive step standards. Using both standards diminishes the patenting of nearly identical inventions as well as obvious variations of an invention.

However, a few exceptions do apply to the general rule. The Section believes that self-collision must be avoided, but not through an anti-self-collision provision. Rather, this is a grace period issue; self-collision can be avoided through a grace period—a limited time frame during which the inventor's own disclosures cannot be used as prior art against him for either anticipation or obviousness purposes.

Another exception to the basic “reasonably and effectively accessible” rule for prior art is when a conflicting application, which would normally qualify as prior art, and the application being examined are commonly owned or subject to an obligation of assignment to the same entity at the effective filing date of the application being examined. This exception is needed to promote earlier, more detailed disclosure of inventions, including incremental improvements and collaborative efforts. However, the Section favors the requirement for a terminal disclaimer in the case of newly claimed subject matter that is obvious or lacks inventive step over a commonly-owned prior patent.

As noted above, the Section believes that a harmonized patent system should contain a grace period. A twelve-month grace period is preferred. This period provides a reasonable time frame for the inventor to discover fraudulent actions, derivation, or other abusive acts on an invention by third parties or to realize accidental disclosure by the inventor, but it also avoids excessive delay in disclosure of the invention. The twelve-month grace period should be calculated from the effective filing date of the application.

In general, the Section opposes requiring a declaration notifying the patent office of a prior disclosure. However, a requirement for a declaration may be acceptable as part of harmonization if certain limitations are placed on the allowed use and substantive requirements in the declaration. Such declarations should not be usable to imply inequitable conduct or another defense to infringement, or to argue invalidity of a patent. Further, such declarations should not require any explanation of what the disclosure means or why it was disclosed, but should only require citation to the disclosure. Additionally, it is preferred that submission of such a declaration be allowed for a set period after the filing of the application or for some period after an applicant learns of a previously unknown disclosure, and that an application cannot be rejected for failure to submit a declaration.

Many different types of disclosures should trigger the grace period. Some triggers envisioned by the Section include: errors on the part of the inventor or applicant, breach of confidence, and disclosures at trade shows, during business negotiations or to potential investors, during public experiments or in academia. The Section supports the inclusion of verbal as well as written disclosures.

To summarize, the Section supports harmonization on the eighteen-month publication of applications, including the elimination of the currently available opt-out provision. We support the prior user rights defense and recommend elimination of the current requirement for use one

year prior to the effective filing date of the patent application. We support harmonization of the treatment of conflicting applications, preferring examination of such art using both novelty and obviousness / inventive step standards, and excepting from prior art the inventor's own disclosures and inventions which are commonly owned, provided a terminal disclaimer is submitted. Finally, we support a twelve-month grace period, triggered by numerous types of disclosures, which may be verbal or written and calculated from the effective filing date of the application. We generally oppose the requirement for a declaration, unless it is highly limited in use.

In conclusion, the Section wishes to thank the Office for requesting feedback from stakeholders in the form of surveys and written comments, and we ask that we may represent the Section's views at the public hearing. We appreciate your efforts to work with the international community seeking harmonization on these important substantive patent law issues. If you have any questions regarding our comments or wish further explanation of any of our comments, please feel free to contact me. Either I or another leader of the membership of the Section will respond to any inquiry.

Sincerely,



Joseph M. Potenza
Section Chairperson
ABA Section of Intellectual Property Law

ABA-IPL Survey on International Patent Harmonization in Four Areas

A. Questions regarding 18-month publication

Commonality / actual use of publication opt-out

A1. Have you / your client ever opted out of publication at 18 months?



If yes, how often?



If yes, did you do so to avoid others copying or designing around?



A2. Has a third party ever copied or designed around an invention that you / your client published at 18 months?

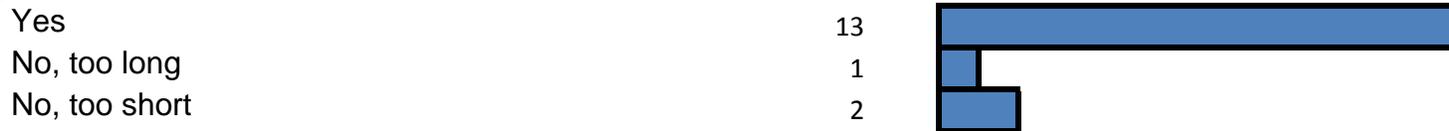


A3. Have you / your client ever sought trade secret protection in order to avoid publication in a jurisdiction which did not have an opt-out?



Timing of publication

A4. For the purpose of public notification / disclosure, is 18 months from the earliest of the filing date or the priority date the proper timing for publication?



A5. Does this timing change if viewed from the applicant's needs as opposed to the public's need for disclosure?



Harmonization of 18-month publication

A6. How important to you is international harmonization of publication?



A7. Would you be in favor of eliminating the current U.S. publication opt-out option?



A8. Would you agree to changes in the current U.S. publication opt-out if it were part of an international harmonization treaty?



A9. Would you agree to changes in the current U.S. publication opt-out if it were part of international harmonization but not part of a treaty?



A10. Should all applications that are not withdrawn be published at some reasonable time (e.g., 18 months)?



If yes, should the competent authority be required to provide search results at a reasonable time before publication in order to allow the applicant to withdraw the application before publication?



If yes, should the competent authority be required to provide examination results at a reasonable time before publication in order to allow the applicant to withdraw the application before publication?



A11. Does harmonization on grace period affect how important harmonization on publication is to you?



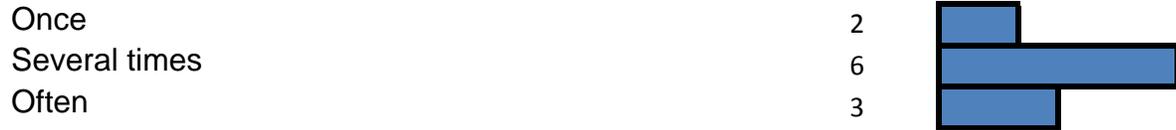
B. Questions regarding prior user rights

Commonality / actual use of prior user rights

B1. Have you ever considered using or counseled clients regarding prior user rights?



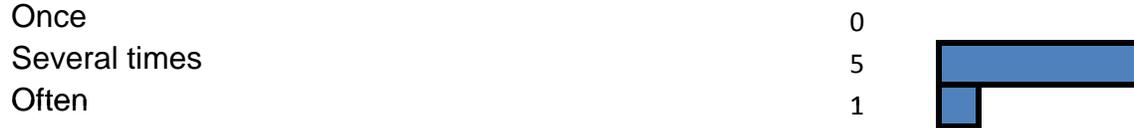
If yes, how often?



B2. Have you / your clients ever asserted prior user rights?



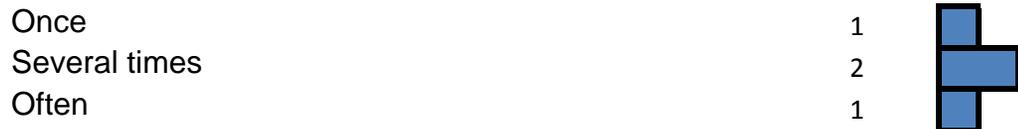
If yes, how often?



B3. Have you / your clients ever had prior user rights asserted against you?



If yes, how often?



Timing of / activities giving rise to prior user rights

B4. Should the U.S. requirement of commercial use for at least one year prior to the effective filing date be eliminated?



If so, what date should be used:

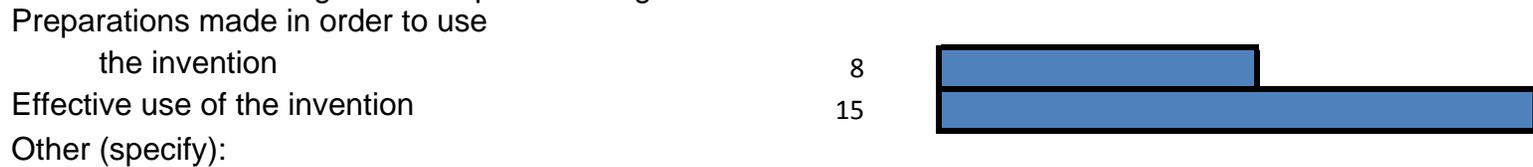


Other (specify):

B5. Should the timing be different if there is a grace period in the jurisdiction?



B6. What types of activities should give rise to prior user rights?



B7. Should the exception to the defense for patents owned by or assigned to universities or affiliated technology transfer organizations be eliminated?



Harmonization of prior user rights

B8. How important to you is international harmonization of prior user rights?



B9. Would you agree to changes in the current U.S. prior user rights if it were part of an international harmonization treaty?



B10. Would you agree to changes in the current U.S. prior user rights if it were part of international harmonization but not part of a treaty?



C. Questions regarding grace period

Commonality / actual use of grace period

C1. Have you / your clients ever filed an application AFTER disclosure of the invention?



If yes, how often?



C2. Have you / your clients ever relied on the grace period?



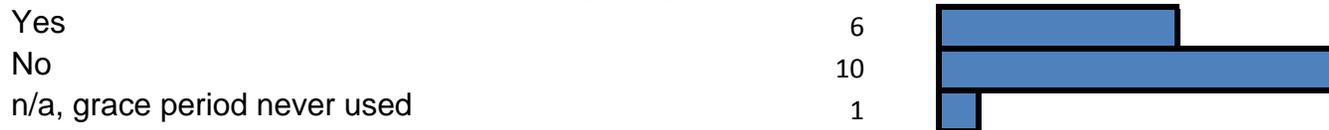
If yes, how often?



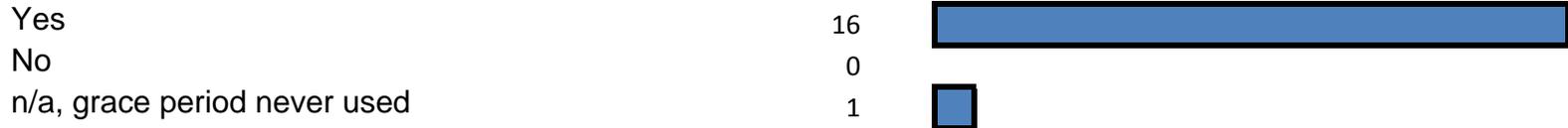
C3. If you / your clients have relied on the grace period, was the grace period responsible for the success of your invention (success not possible without the grace period)?



C4. Have you / your clients ever had problems invoking the grace period anywhere?



C5. Have you / your clients ever been unable to obtain a patent because no grace period was available in a certain jurisdiction?



C6. Has the unavailability of a grace period ever been a factor in business / research decisions for you / your client?



C7. Has the reliance by another on a grace period negatively affected you / your client?



Types of grace periods

C8. Should a grace period protect inventors from fraud and/or similar acts?



C9. Should a grace period protect inventors from third party derivation?



C10. Should a grace period protect inventors from their own accidental disclosures or disclosures without intent (e.g., not done to market the product but instead disclosed because the applicant didn't know the application had not yet been filed)?



C11. Should a grace period protect inventors from independent inventions or disclosures by third parties in good faith?



C12. Should a grace period be based on the needs of applicants to test marketability of their product?

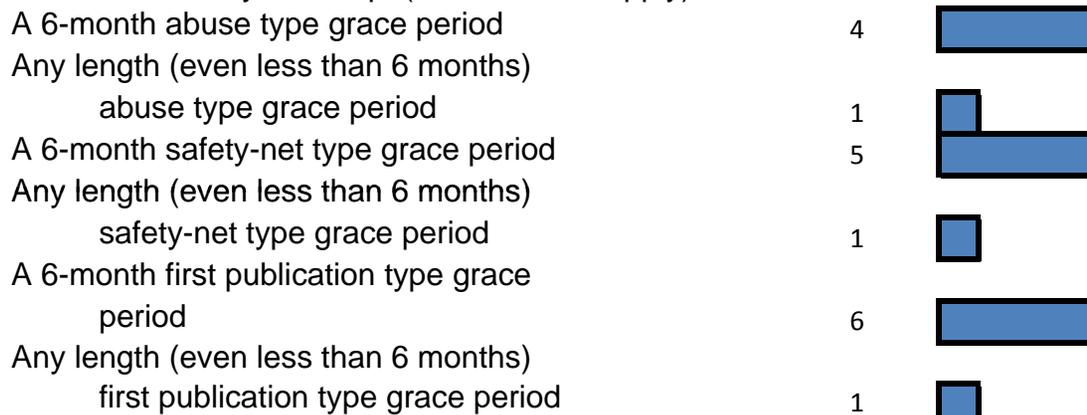


Length of grace period

C13. Would you reject all grace period types which are not 12 months in length?



If no, then which would you accept (check all that apply):



Does your answer above change if the grace period were part of an international harmonization treaty?

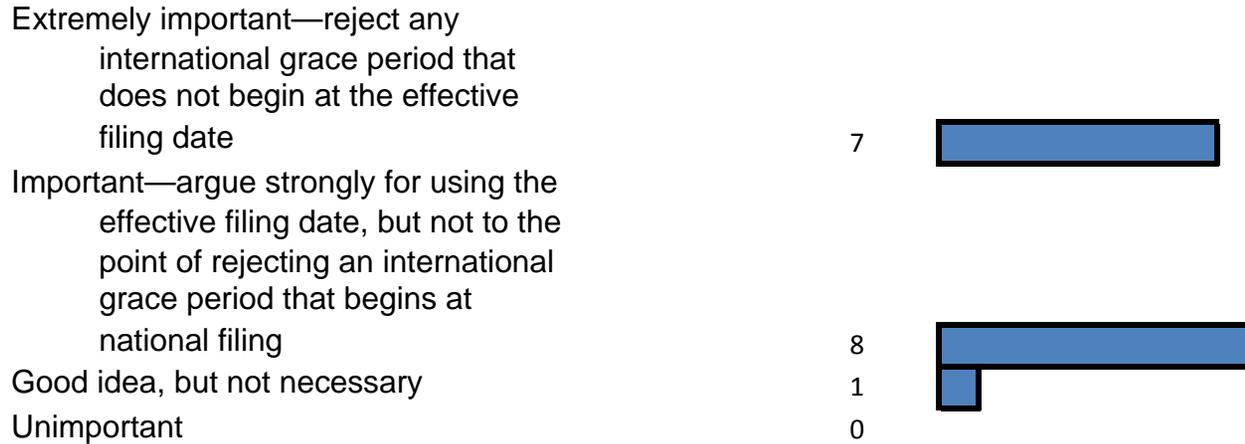


C14. Do you prefer a 12-month abuse type grace period over a 6-month safety net type?



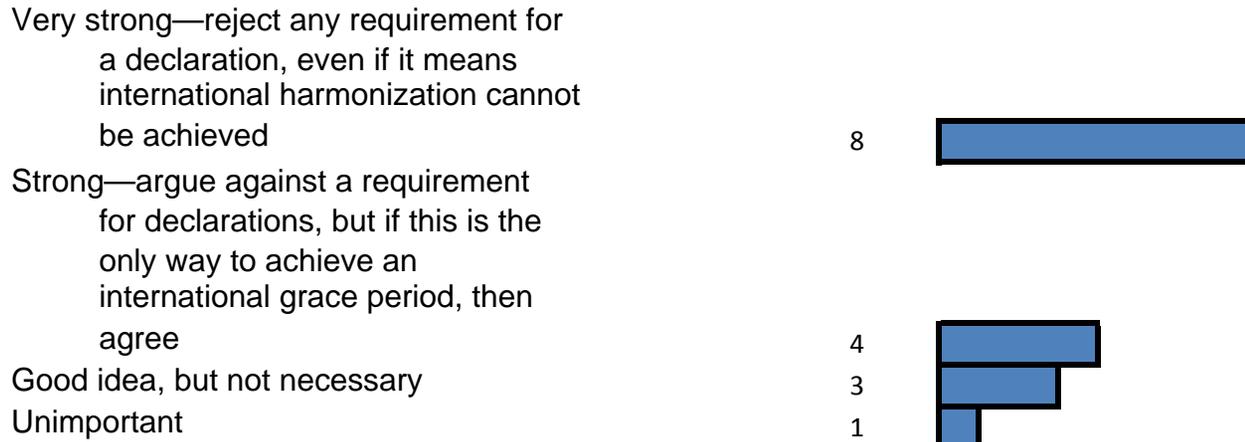
Date from which grace period is calculated

C15. How important is it to you that the effective filing date (e.g., any priority date) be used as the starting date for calculation of the grace period?



Need for a declaration

C16. How strongly do you feel about maintaining the current provision that a declaration notifying the USPTO of a prior disclosure is not required?



C17. If it would result in the failure to reach an international harmonization treaty on grace period, would you reject any and all requirements that a declaration be filed to identify publications known to you or of which you become aware?



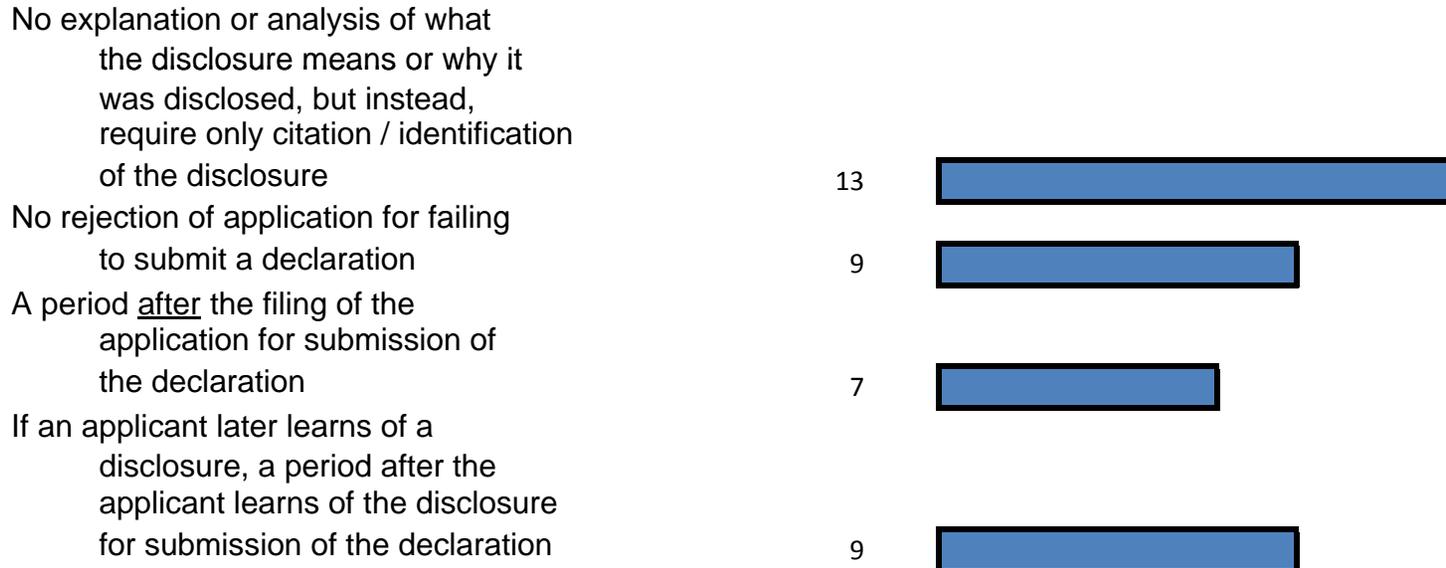
If yes, does your answer change if limitations are placed on the uses of that declaration?



If yes, to which uses would you object (check all that apply)?

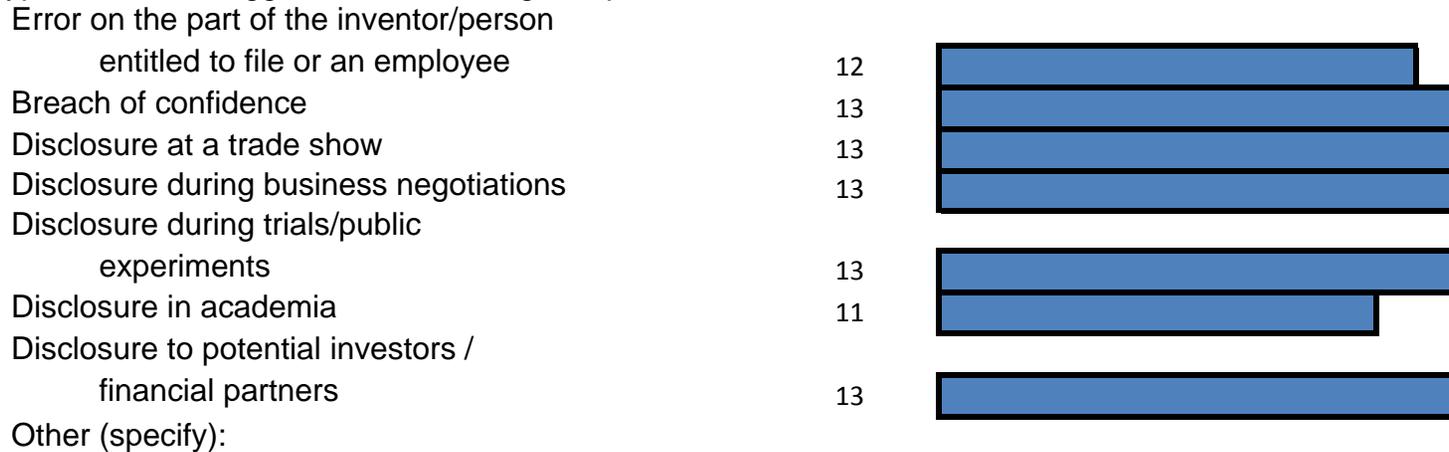


C18. If an international harmonization treaty could be reached only with the agreement to require declarations, which of these other limitations would you require (that is, without this limitation, you would not agree to harmonization) (check all that apply)?

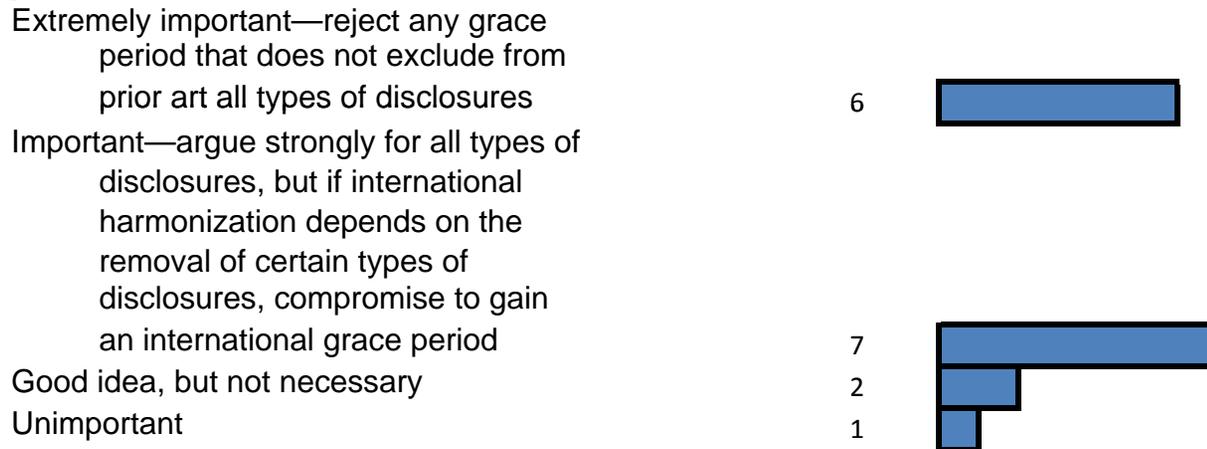


Types of disclosures trigger the need for a grace period

C19. Which types of events trigger the need for a grace period?



C20. How important to you is it that all forms of disclosure—whether verbal or written—be excluded as prior art under an international grace period?



Does your answer above change if it were part of international harmonization but not part of a treaty?



Harmonization of grace period

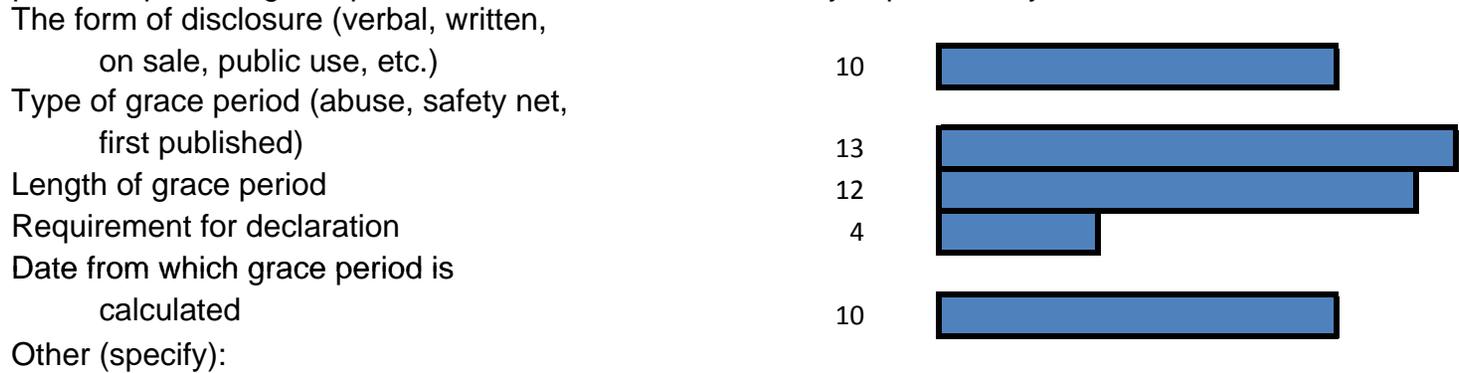
C21. Are you personally in favor of having a grace period in a jurisdiction's patent law?



C22. How important to you is international harmonization of grace periods?



C23. Which specific aspects of grace period harmonization are extremely important to you?



C24. Would you agree to changes in the current U.S. grace period if it were part of international harmonization but not part of a treaty?



D. Questions relating to conflicting applications

Commonality / occurrence of conflicting applications

D1. How often are “conflicting applications” cited against you / your clients?



D2. How often have the “conflicting applications” cited against you / your clients been filed by you / your clients?



D3. Have different rules been applied to the same conflicting applications in different jurisdictions?



If yes, was the outcome different in any jurisdictions?

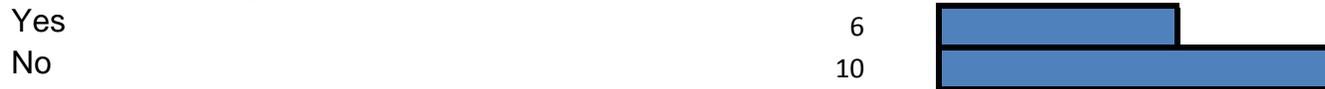


Applicable patent law provisions

D4. Do you believe that conflicting applications should be examined using novelty and obviousness / inventive step standards or simply for novelty?



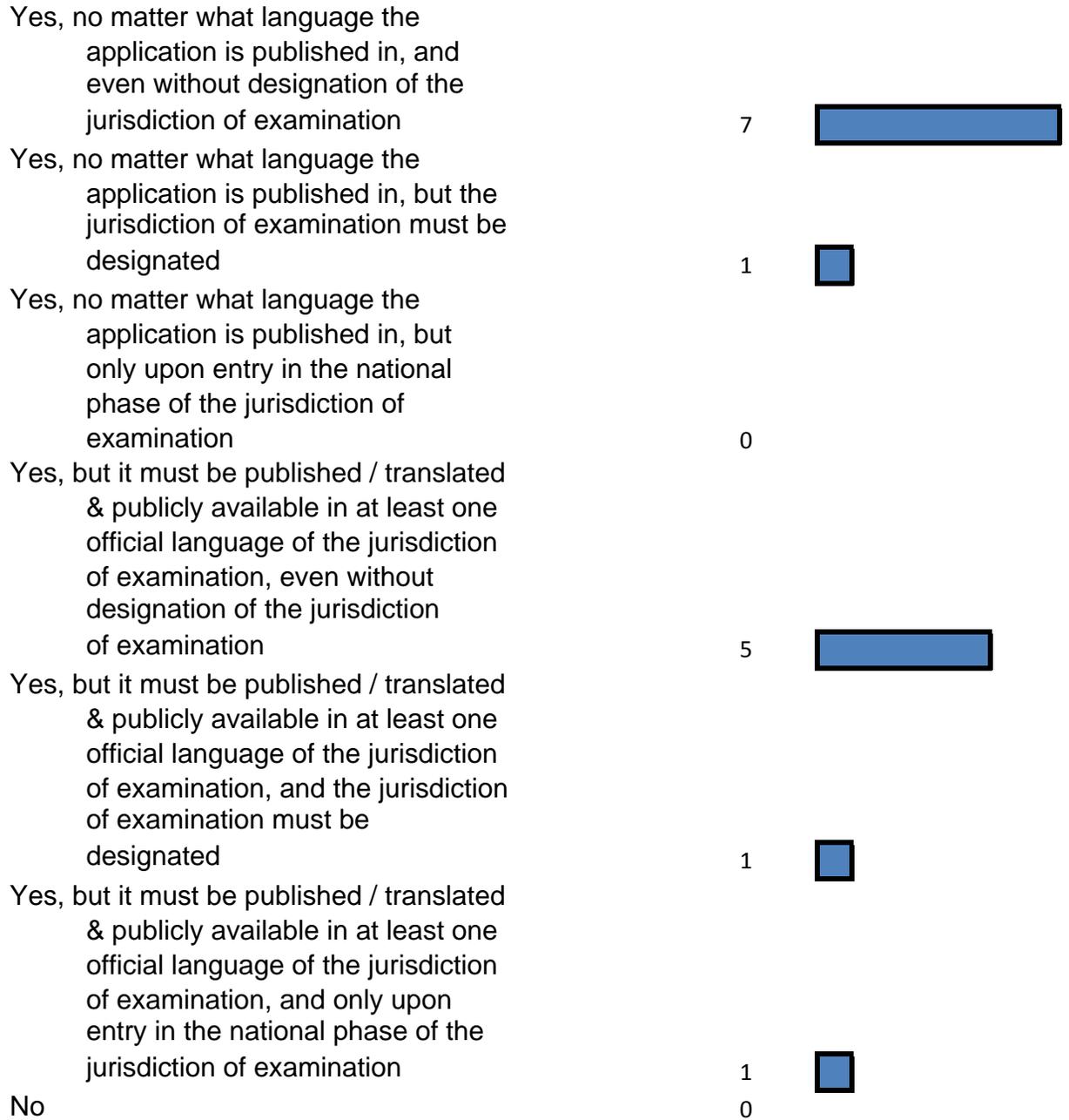
D5. Do you believe that self-collision should be permitted (should an applicant's first application be eligible as prior art over the applicant's own second, closely-related application)?



If no, would you require a terminal disclaimer, even if it means international harmonization cannot be reached?



D6. Should PCT applications be treated as conflicting prior art?



Harmonization for treatment of conflicting applications

D7. How important to you is international harmonization for treatment of conflicting applications?



D8. If it were part of an international harmonization treaty, would you agree to changes in the current U.S. treatment of conflicting applications whereby the application is considered for novelty and obviousness / inventive step of what the application teaches or implies, but the conflicting application cannot be combined with another of the applicant's applications for obviousness / inventive step?



Does your answer change if the conflicting application is a third party's application rather than the applicant's own application?



ABA Survey on International Patent Harmonization in Four Areas

Please respond by Friday, **February 15, 2013.**

Attached is a set of questions covering four areas of patent law in which opportunities for international harmonization are being reviewed. An international working group—called the Tegernsee Group—has been analyzing four particular areas: the 18-month publication of applications; prior user rights; grace periods; and conflicting applications as prior art. Many groups and organizations have been surveying practitioners in an effort to establish their views to input into future discussions. See <http://www.ipo.gov.uk/consult-2013-tegernsee.htm%20> and http://www.uspto.gov/ip/global/patents/tegernsee_survey/index.jsp. The USPTO has requested input by February 28, 2013, in preparation for a public hearing on March 21, 2013. See <http://www.gpo.gov/fdsys/pkg/FR-2013-02-01/pdf/2013-01966.pdf>.

The attached survey is based on the Tegernsee survey. A task force consisting of members of ABA-IPL Committees 101 and 102 in coordination with the International Law Section is working on a position paper. **WE NEED YOUR INPUT.**

Please respond to the following survey by Friday, February 15. The survey is written in Word format for ease of use. You may add comments, examples, or ideas below any of the questions. Send your completed survey to paula.davis@lilly.com.

Thank you for taking time to provide your views!

A. Questions regarding 18-month publication

Commonality / actual use of publication opt-out

A1. Have you / your client ever opted out of publication at 18 months?

Yes No

If yes, how often?

Once Several times Often

If yes, did you do so to avoid others copying or designing around?

Yes No

A2. Has a third party ever copied or designed around an invention that you / your client published at 18 months?

Yes No Don't know

A3. Have you / your client ever sought trade secret protection in order to avoid publication in a jurisdiction which did not have an opt-out?

Yes No

Timing of publication

A4. For the purpose of public notification / disclosure, is 18 months from the earliest of the filing date or the priority date the proper timing for publication?

Yes No, too long No, too short

A5. Does this timing change if viewed from the applicant's needs as opposed to the public's need for disclosure?

Yes No

Harmonization of 18-month publication

A6. How important to you is international harmonization of publication?

Extremely important
 Important
 Good idea, but not necessary
 Unimportant

A7. Would you be in favor of eliminating the current U.S. publication opt-out option?

Yes No

A8. Would you agree to changes in the current U.S. publication opt-out if it were part of an international harmonization treaty?

Yes No

A9. Would you agree to changes in the current U.S. publication opt-out if it were part of international harmonization but not part of a treaty?

Yes No

A10. Should all applications that are not withdrawn be published at some reasonable time (e.g., 18 months)?

Yes No

If yes, should the competent authority be required to provide search results at a reasonable time before publication in order to allow the applicant to withdraw the application before publication?

Yes No

If yes, should the competent authority be required to provide examination results at a reasonable time before publication in order to allow the applicant to withdraw the application before publication?

Yes No

A11. Does harmonization on grace period affect how important harmonization on publication is to you?

Yes No

B. Questions regarding prior user rights

Commonality / actual use of prior user rights

B1. Have you ever considered using or counseled clients regarding prior user rights?

Yes No

If yes, how often?

Once Several times Often

B2. Have you / your clients ever asserted prior user rights?

Yes No

If yes, how often?

Once Several times Often

B3. Have you / your clients ever had prior user rights asserted against you?

Yes No

If yes, how often?

Once Several times Often

Timing of / activities giving rise to prior user rights

B4. Should the U.S. requirement of commercial use for at least one year prior to the effective filing date be eliminated?

Yes No

If so, what date should be used:

Anytime before the effective filing date?

Other (specify):

B5. Should the timing be different if there is a grace period in the jurisdiction?

Yes No

B6. What types of activities should give rise to prior user rights?

Preparations made in order to use the invention

Effective use of the invention

Other (specify):

B7. Should the exception to the defense for patents owned by or assigned to universities or affiliated technology transfer organizations be eliminated?

Yes No

Harmonization of prior user rights

B8. How important to you is international harmonization of prior user rights?

- Extremely important
 Important
 Good idea, but not necessary
 Unimportant

B9. Would you agree to changes in the current U.S. prior user rights if it were part of an international harmonization treaty?

- Yes No

B10. Would you agree to changes in the current U.S. prior user rights if it were part of international harmonization but not part of a treaty?

- Yes No

C. Questions regarding grace period

Commonality / actual use of grace period

C1. Have you / your clients ever filed an application AFTER disclosure of the invention?

- Yes No

If yes, how often?

- Once Several times Often

C2. Have you / your clients ever relied on the grace period?

- Yes No

If yes, how often?

- Once Several times Often

C3. If you / your clients have relied on the grace period, was the grace period responsible for the success of your invention (success not possible without the grace period)?

- Yes No n/a, grace period never used

C4. Have you / your clients ever had problems invoking the grace period anywhere?

- Yes No n/a, grace period never used

C5. Have you / your clients ever been unable to obtain a patent because no grace period was available in a certain jurisdiction?

- Yes No n/a, grace period never used

C6. Has the unavailability of a grace period ever been a factor in business / research decisions for you / your client?

- Yes No n/a, grace period never used

C7. Has the reliance by another on a grace period negatively affected you / your client?
 Yes No n/a, grace period never used

Types of grace periods

Many countries do not have a grace period in their patent laws. Of those who do, the grace periods vary. There are at least three distinct types of grace period—based on the types of disclosures which they exclude. In the first type, only disclosures that result from “abuse” are excluded. This type excludes from prior art all publications that are derived from the applicant’s work or published without the applicant’s knowledge. The second type is the “safety net” type. This type excludes from prior art all disclosures by the applicant which are accidental or without intent. The safety net does not exclude from prior art disclosures by independent third parties. The third type of grace period is the “first publication” type. This would exclude from prior art all disclosures, whether done by accident or on purpose, by the applicant as well as disclosures by independent parties.

C8. Should a grace period protect inventors from fraud and/or similar acts?
 Yes No

C9. Should a grace period protect inventors from third party derivation?
 Yes No

C10. Should a grace period protect inventors from their own accidental disclosures or disclosures without intent (e.g., not done to market the product but instead disclosed because the applicant didn’t know the application had not yet been filed)?
 Yes No

C11. Should a grace period protect inventors from independent inventions or disclosures by third parties in good faith?
 Yes No

C12. Should a grace period be based on the needs of applicants to test marketability of their product?
 Yes No

Length of grace period

C13. Would you reject all grace period types which are not 12 months in length?
 Yes No

If no, then which would you accept (check all that apply):

- A 6-month abuse type grace period
- Any length (even less than 6 months) abuse type grace period
- A 6-month safety-net type grace period
- Any length (even less than 6 months) safety-net type grace period
- A 6-month first publication type grace period
- Any length (even less than 6 months) first publication type grace period

Does your answer above change if the grace period were part of an international harmonization treaty?

Yes No

C14. Do you prefer a 12-month abuse type grace period over a 6-month safety net type?

Yes No

Date from which grace period is calculated

The U.S. grace period currently uses the effective filing date of the application, which includes any priority date, as the date from which the grace period is calculated. Many other countries use the date of their national filing as the starting date for grace period calculations. Arguably, using the national filing date does not have international effect.

C15. How important is it to you that the effective filing date (e.g., any priority date) be used as the starting date for calculation of the grace period?

- Extremely important—reject any international grace period that does not begin at the effective filing date
- Important—argue strongly for using the effective filing date, but not to the point of rejecting an international grace period that begins at national filing
- Good idea, but not necessary
- Unimportant

Need for a declaration

The U.S. does not require a declaration notifying the USPTO of a prior disclosure. However, some argue that having a grace period leads to uncertainty in one's rights at the time of filing an application, and that this lack of requirement for notification via declaration adds to that uncertainty. Thus, this may be an area for compromise among the international patent community.

The main concern against the requirement for a declaration seems to be the severity associated with failure to meet the requirement. In at least one jurisdiction, failure to file such a declaration with the application can result in invalidity of the patent. Additional concerns relate to the threat of inequitable conduct or other defense to infringement or validity challenges. Many practitioners feel that limitations must be placed on any declaration requirement that is put in place.

C16. How strongly do you feel about maintaining the current provision that a declaration notifying the USPTO of a prior disclosure is not required?

- Very strong—reject any requirement for a declaration, even if it means international harmonization cannot be achieved
- Strong—argue against a requirement for declarations, but if this is the only way to achieve an international grace period, then agree
- Good idea, but not necessary
- Unimportant

C17. If it would result in the failure to reach an international harmonization treaty on grace period, would you reject any and all requirements that a declaration be filed to identify publications known to you or of which you become aware?

Yes No

If yes, does your answer change if limitations are placed on the uses of that declaration?

Yes No

If yes, to which uses would you object (check all that apply)?

Use to imply inequitable conduct

Use as another defense to infringement or to argue invalidity

C18. If an international harmonization treaty could be reached only with the agreement to require declarations, which of these other limitations would you require (that is, without this limitation, you would not agree to harmonization) (check all that apply)?

No explanation or analysis of what the disclosure means or why it was disclosed, but instead, require only citation / identification of the disclosure

No rejection of application for failing to submit a declaration

A period after the filing of the application for submission of the declaration

If an applicant later learns of a disclosure, a period after the applicant learns of the disclosure for submission of the declaration

Types of disclosures trigger the need for a grace period

C19. Which types of events trigger the need for a grace period?

Error on the part of the inventor/person entitled to file or an employee

Breach of confidence

Disclosure at a trade show

Disclosure during business negotiations

Disclosure during trials/public experiments

Disclosure in academia

Disclosure to potential investors / financial partners

Other (specify):

C20. How important to you is it that all forms of disclosure—whether verbal or written—be excluded as prior art under an international grace period?

Extremely important—reject any grace period that does not exclude from prior art all types of disclosures

Important—argue strongly for all types of disclosures, but if international harmonization depends on the removal of certain types of disclosures, compromise to gain an international grace period

Good idea, but not necessary

Unimportant

Does your answer above change if it were part of international harmonization but not part of a treaty?

Yes No

Harmonization of grace period

C21. Are you personally in favor of having a grace period in a jurisdiction's patent law?

Yes No

C22. How important to you is international harmonization of grace periods?

Extremely important
 Important
 Good idea, but not necessary
 Unimportant

C23. Which specific aspects of grace period harmonization are extremely important to you?

The form of disclosure (verbal, written, on sale, public use, etc.)
 Type of grace period (abuse, safety net, first published)
 Length of grace period
 Requirement for declaration
 Date from which grace period is calculated
 Other (specify):

C24. Would you agree to changes in the current U.S. grace period if it were part of international harmonization but not part of a treaty?

Yes No

[D. Questions relating to conflicting applications](#)

The term "conflicting applications" here refers to applications which disclose common subject matter and are filed relatively close in time. In this situation, a first application is filed, and then a second application is filed before the first application publishes. The second applicant may be completely unaware of the first filed application ("secret"). Alternatively, the first and second applications may be filed by the same applicant, creating "self-collision." Jurisdictions vary on how they treat the first application as prior art.

The European Patent Convention only considers the first application for novelty purposes, not inventive step. A small difference between the inventions can mean that both are patentable. EPC allows self-collision, meaning that an applicant's first filing can be treated as prior art against the same applicant's second filing, as if the second were filed by a third party.

Japan also uses novelty only, but the differences must be more substantial. Japan has an anti-self-collision law, but two identical inventions cannot both be patented. Some difference must be evident in order for the applicant to receive two patents.

The U.S. considers the first filed application as prior art under novelty as well as obviousness standards. Conflicting applications may be combined for obviousness purposes. The U.S. also provides protection against self-collision, but will require a terminal disclaimer for conflicting applications owned by the same applicant. Furthermore, PCT applications are treated differently among the various jurisdictions. Europe treats a PCT application as prior art only if it is published in an official language of EPO or has been translated into an official EPO language and has entered the national phase at the EPO. Japan treats PCT applications as prior art so long as Japan is designated by the applicant; national phase entry is not required. Yet, the application only becomes prior art once Japanese translations are submitted. PCT applications designating the U.S. are considered by the U.S. as conflicting applications as of their effective filing date, no matter the language of the application.

Commonality / occurrence of conflicting applications

D1. How often are “conflicting applications” cited against you / your clients?

Never A few times Often

D2. How often have the “conflicting applications” cited against you / your clients been filed by you / your clients?

Never A few times Often

D3. Have different rules been applied to the same conflicting applications in different jurisdictions?

Yes No

If yes, was the outcome different in any jurisdictions?

Yes No

Applicable patent law provisions

D4. Do you believe that conflicting applications should be examined using novelty and obviousness / inventive step standards or simply for novelty?

Novelty and obviousness / inventive step
 Novelty only

D5. Do you believe that self-collision should be permitted (should an applicant’s first application be eligible as prior art over the applicant’s own second, closely-related application)?

Yes No

If no, would you require a terminal disclaimer, even if it means international harmonization cannot be reached?

Yes No

D6. Should PCT applications be treated as conflicting prior art?

- Yes, no matter what language the application is published in, and even without designation of the jurisdiction of examination
- Yes, no matter what language the application is published in, but the jurisdiction of examination must be designated
- Yes, no matter what language the application is published in, but only upon entry in the national phase of the jurisdiction of examination
- Yes, but it must be published / translated & publicly available in at least one official language of the jurisdiction of examination, even without designation of the jurisdiction of examination
- Yes, but it must be published / translated & publicly available in at least one official language of the jurisdiction of examination, and the jurisdiction of examination must be designated
- Yes, but it must be published / translated & publicly available in at least one official language of the jurisdiction of examination, and only upon entry in the national phase of the jurisdiction of examination
- No

Harmonization for treatment of conflicting applications

D7. How important to you is international harmonization for treatment of conflicting applications?

- Extremely important
- Important
- Good idea, but not necessary
- Unimportant

D8. If it were part of an international harmonization treaty, would you agree to changes in the current U.S. treatment of conflicting applications whereby the application is considered for novelty and obviousness / inventive step of what the application teaches or implies, but the conflicting application cannot be combined with another of the applicant's applications for obviousness / inventive step?

- Yes
- No

Does your answer change if the conflicting application is a third party's application rather than the applicant's own application?

- Yes
- No

This completes the survey.
Thank you, again, for providing your viewpoints!