

**GROUP B+ WORKING GROUP ON SPLH
QUESTIONNAIRE
USER ASSOCIATION CONSULTATION 2024**

The format of the Group B+ Working Group user consultations entails two rounds of regional meetings on outstanding issues identified by the Working Group in its report of 2023. At the first user consultation meetings held in March 2024, these issues were addressed and stakeholders were informed that a survey would be circulated after the meeting.

Participating stakeholder associations are kindly requested to engage in consensus-building within their associations on remaining contentious issues on the basis of the following questionnaire, which should serve as a guide to internal discussions. The concepts themselves are not explained here, users are referred to the Background Document distributed prior to the consultation.

Every **stakeholder association** is kindly requested to fill out the questionnaire, **on behalf of the association**, and return it to the Chair of the B+ Working Group on SPLH, at the UK IPO, by **24 May 2024 at the latest**. At the second round of consultations, the B+ Working Group will collate the results of this questionnaire, and present the outcomes, both according to region and globally, which will then be further discussed by participants.

In answering these questions, participant associations are urged to consider the issues from the point of view of the patentee as well as the point of view of third parties.

Please click only one box per question, except where otherwise indicated. (To click a box, hover over it, and left-click your mouse)

NAME OF THE ASSOCIATION: _____ The Chartered Institute of Patent Attorneys

GENERAL

1. Does your association support the goal of substantive patent law harmonisation (SPLH)?

- ☒ Yes
- ☐ No
- ☐ No consensus
- ☐ Do not wish to answer

2. How flexible are you in relation to SPLH?

- ☐ We do not want SPLH. Our law represents best practice and it should not be changed
- ☐ We want SPLH, but only provided our own law does not have to change. Otherwise, we prefer the status quo
- ☒ We want SPLH, and realise that to achieve international harmonisation, compromises will be necessary. We are prepared to be flexible and change our own law, as part of a balanced harmonisation package (on definition of prior art, grace period, 18-month publication, conflicting applications and prior user rights), to be able to enjoy the benefits of harmonisation.
- ☐ No consensus
- ☐ Do not wish to answer

GRACE PERIOD

3. Is your association in favour of an internationally harmonised grace period?

- ☒ Yes
- ☐ No
- ☐ No consensus
- ☐ Do not wish to answer

4. Should the internationally harmonised grace period be calculated from:

- ☐ The filing date only
- ☒ The filing date, or, if applicable, the priority date
- ☐ No consensus
- ☐ Do not wish to answer

5. Should there be a statement requirement?

- ☒ Yes, a mandatory statement requirement with a time limit
- ☐ Yes, a voluntary statement with a presumption that items listed are graced
- ☐ No, there should be no statement requirement
- ☐ No consensus
- ☐ Do not wish to answer

6. Assuming that there is a statement requirement and it is provided that the grace period should be invoked upon filing, with supporting documents filed within a month or two of filing, how strict should these time limits be?

[Where a statement is required, if filed early enough in the patent granting procedure, it will both provide procedural efficiencies and reduce costs for both applicants and patent offices.]

- ☐ These time limits should be strict
- ☐ The statement and supporting documents should be able to be filed, amended or completed up until the grant of the patent, subject to an additional fee
- ☒ The statement that the grace period is claimed and the supporting documents may be filed, amended or completed up until 16 months from the priority or filing date, subject to an additional fee, ensuring that the statement is complete prior to the publication of the application
- ☐ No consensus
- ☐ Do not wish to answer

7. *Some argue that if a grace period becomes internationally harmonised, safeguards (a statement requirement and/or robust prior user rights) are required to preserve the “file first, disclose later” paradigm to promote stability within patent systems and ensure that the grace period will be used as a “safety net” rather than as a strategic option.*

Please indicate the grace period safeguards you would prefer. A grace period with:

- ☐ A statement requirement
- ☐ “Robust prior user rights”, where third parties may obtain prior user rights if they have derived knowledge of the invention from a pre-filing disclosure made during the grace period by the applicant or their predecessor, or with their consent
- ☒ Both a statement requirement and robust prior user rights
- ☐ No statement requirement, no robust prior user rights
- ☐ Other, namely _____
- ☐ No consensus
- ☐ Do not wish to answer

8. **You have indicated your preferred grace period safeguards in question 7. Should these safeguards not be a feasible outcome in an international negotiation, please indicate the other concept(s) which would be acceptable to your association as a compromise. A grace period with:** (Should more than one concept be acceptable, please rank the concepts in order of preference by placing a number in the applicable boxes e.g. 1, 2)

- ☐ 2 A statement requirement
- ☐ 2 “Robust prior user rights”, where third parties may obtain prior user rights if they have derived knowledge of the invention from a pre-filing disclosure made during the grace period by the applicant or their predecessor, or with their consent
- ☐ 1 Both a statement requirement and robust prior user rights
- ☐ No statement requirement, no robust prior user rights
- ☐ Other, namely _____
- ☐ No consensus
- ☐ Do not wish to answer

9. **Do you agree with the following statement: intervening disclosures of independent inventions by third parties form prior art?**

- ☒ Yes
- ☐ No
- ☐ No consensus
- ☐ Do not wish to answer

10. Do you agree with the following statement: the burden of proof to show that a pre-filing disclosure is graced should rest on the applicant?

- ☒ Yes
- ☐ No
- ☐ No consensus
- ☐ Do not wish to answer

11. Would your association support accelerated publication?

[Some users have proposed a system of accelerated publication, so that when the grace period is invoked for a patent application, the application would be published 18 months from the date of the first pre-filing disclosure. This pre-supposes a statement requirement in order to invoke the grace period.]

- ☒ Yes
- ☐ No
- ☐ No consensus
- ☐ Do not wish to answer

12. In the following circumstances, how often would you choose to use the grace period:

a. If an international grace period were to contain a statement requirement?

- ☐ Very often
- ☐ Often
- ☐ Rarely, only if there is a compelling reason
- ☐ Only in case of a problem, if a disclosure has already taken place
- ☐ Never
- ☒ No consensus
- ☐ Do not wish to answer

b. If an international grace period were to allow third parties to acquire prior user rights based on knowledge of the invention derived from a pre-filing disclosure made during the grace period by the applicant or their predecessor, or with their consent ("robust prior user rights")

- ☐ Very often
- ☐ Often
- ☐ Rarely, only if there is a compelling reason
- ☐ Only in case of a problem, if a disclosure has already taken place
- ☐ Never
- ☒ No consensus
- ☐ Do not wish to answer

c. If an international grace period comprised both a statement requirement and robust prior user rights

- ☐ Very often
- ☐ Often
- ☐ Rarely, only if there is a compelling reason
- ☐ Only in case of a problem, if a disclosure has already taken place
- ☐ Never
- ☒ No consensus
- ☐ Do not wish to answer

d. If an international grace period did not require a statement and prohibited prior user rights from arising where knowledge of the invention has been derived from the applicant

- ☐ Very often
- ☐ Often
- ☐ Rarely, only if there is a compelling reason
- ☐ Only in case of a problem, if a disclosure has already taken place
- ☐ Never
- ☒ No consensus
- ☐ Do not wish to answer

CONFLICTING APPLICATIONS

13. Which system do you believe represents best practice?

- ☒ Conflicting applications are relevant for the examination of novelty only, without anti-self-collision
- ☐ Conflicting applications are relevant for novelty only, with anti-self-collision, but where the applicant must choose which application shall proceed to grant
- ☐ Conflicting applications are relevant for enhanced novelty, with anti-self-collision
- ☐ Conflicting applications are relevant for both novelty and inventive step, with anti-self-collision
- ☐ Other, namely _____
- ☐ No consensus
- ☐ Do not wish to answer

14. You have indicated your preferred system in question 13. Assuming that your first choice is not a feasible outcome in an international negotiation, please indicate the system(s) which would be acceptable to your association as a compromise. (Should more than one system be acceptable, please rank the systems in order of preference by placing a number in the applicable boxes e.g. 1, 2)

☐ Conflicting applications are relevant for the examination of novelty only, without anti-self-collision

☐ Conflicting applications are relevant for novelty only, with anti-self-collision, but where the applicant must choose which application shall proceed to grant

☐ Conflicting applications are relevant for enhanced novelty, with anti-self-collision

☐ Conflicting applications are relevant for both novelty and inventive step, with anti-self-collision

☐ Other, namely _____

☒ No consensus

☐ Do not wish to answer

15. Regarding the “distance” between applications, please indicate the concept which is preferred by your association.

☐ Novelty only

☐ Enhanced novelty

☐ Novelty and inventive step

☐ Other, namely _____

☒ No consensus

☐ Do not wish to answer

16. You have indicated your preferred “distance” between applications in question 15. Assuming that your first choice is not a feasible outcome in an international negotiation, please indicate the concept(s) which would be acceptable to your association as a compromise. (Should more than one concept be acceptable, please rank the concepts in order of preference by placing a number in the applicable boxes e.g. 1, 2)

☐ Novelty only

☐ 1 Enhanced novelty

☐ Novelty and inventive step

☐ Other, namely _____

☐ No consensus

☐ Do not wish to answer

17. Do you support the principle of anti-self-collision?

- ☐ Yes
- ☐ No
- ☐ No consensus
- ☐ Do not wish to answer

18. You have indicated your preference with regard to the principle of anti-self-collision in question 17. Assuming your preference is not a feasible outcome in an international negotiation, would the opposite alternative be acceptable to your association as a compromise? *[it being understood that the resulting approach would in any event allow incremental inventions to be protected.]*

- ☐ Yes
- ☐ No
- ☐ No consensus
- ☐ Do not wish to answer

19. Please answer either question 19A or 19B, depending on the law in your own jurisdiction.

A. If your jurisdiction at present has a rule on anti-self-collision, and it were to change to a system without anti-self-collision, how would this impact the patent system? (Tick all the boxes which apply.)

- | | | |
|---|---|---|
| Patent thickets would: | ☐ increase | ☐ decrease |
| Obtaining protection for incremental improvements would become: | ☐ more difficult | ☐ less difficult |
| Opportunities to obtain patents would: | ☐ decrease | ☐ increase |
| Patenting outcomes would become: | ☐ less predictable | ☐ more predictable |
| Licensing would become: | ☐ more complex and expensive | ☐ less complex and expensive |
| Freedom-to-operate opinions would become: | ☐ more complex and expensive | ☐ less complex and expensive |
- ☐ It would not significantly change the patent system
 - ☐ No consensus
 - ☐ Do not wish to answer

B. If your jurisdiction at present has no rule on anti-self-collision, and it were to change to a system with anti-self-collision, how would this impact the patent system? (Tick all the boxes which apply.)

- | | | |
|---|---|---|
| Patent thickets would: | ☐ increase | ☐ decrease |
| Obtaining protection for incremental improvements would become: | ☐ more difficult | ☐ less difficult |
| Opportunities to obtain patents would: | ☐ decrease | ☐ increase |
| Patenting outcomes would become: | ☐ less predictable | ☐ more predictable |
| Licensing would become: | ☐ more complex and expensive | ☐ less complex and expensive |
| Freedom-to-operate opinions would become: | ☐ more complex and expensive | ☐ less complex and expensive |
- ☒ It would not significantly change the patent system
- ☐ No consensus
- ☐ Do not wish to answer

20. If an international package contained an anti-self-collision clause, would you support the adoption of terminal disclaimers?

- ☒ Yes
- ☐ No
- ☐ No consensus
- ☐ Do not wish to answer

21. If an international package contained an anti-self-collision clause, would you support the feature of a single patent issuing to the same applicant, where the applicant must choose which of the two applications shall proceed to grant?

- ☐ Yes
- ☐ No
- ☐ No consensus
- ☒ Do not wish to answer

22. PCT applications should become conflicting applications:

- ☒ Upon their publication at 18 months, regardless of whether they enter the national/regional phase or not
- ☐ Only upon entry in the national/regional phase
- ☐ No consensus
- ☐ Do not wish to answer

PRIOR USER RIGHTS

23. In a grace period context, the issue of derivation of the knowledge of the invention from the applicant by third parties arises. Please check the statement you agree with.

- ☐ Prior user rights should be prohibited from arising where knowledge of the invention is derived from the applicant
- ☒ Prior user rights should be able to arise where the knowledge of the invention has been derived from a pre-filing disclosure made by the applicant or their predecessor, or with their consent, during the grace period, but not if it was derived from the applicant otherwise
- ☐ No consensus
- ☐ Do not wish to answer

24. Where a prior user has acquired knowledge of the invention from another person (i.e. the applicant or a third party), should there be a standard of behaviour for prior user rights to arise, which, by its nature, would apply to the prior user's dealings with any third party, not just the applicant?

- ☒ Yes, there should be a standard of behaviour for prior user rights to arise e.g. to prevent prior user rights from arising where the invention has been obtained in breach of confidence from a third party who made the invention but is not the applicant
- ☐ No, a prohibition on derivation of the invention from the applicant would suffice
- ☐ No standard of behaviour should be required
- ☐ No consensus
- ☐ Do not wish to answer

25. If a general standard of behaviour were to be imposed on the prior user, it should be a requirement that the prior user has acted:

- ☐ in good faith, with that concept being left up to each jurisdiction to define
- ☐ in good faith, with guidelines defining that concept for the purposes of the provision
- ☒ "legitimately", i.e. not contrary to law, or in breach of confidence or any other contractual obligation
- ☐ Other, namely _____
- ☐ No consensus
- ☐ Do not wish to answer

ADDITIONAL COMMENTS

26. Please include any comments you wish to add below.

In relation to Question 6, we believe that there needs to be a safety net for unintentional disclosure, providing the applicant can substantiate why the disclosure was unintentional.

We found no consensus on Question 12 a), b), c) and d) because our members may hold different positions and their answers may differ depending on their technical field.

On Question 14, we believe compromise will be needed between the present systems.

In relation to Questions 17 and 18, we would support anti-self-collision as a compromise.

In relation to Question 19 B. if our jurisdiction was to change to a system with anti-self-collision we believe it would benefit the patentee and would be pro-innovation.

Regarding Prior Users Rights, we feel that there should be a clear definition of the scope of PURs, including expansion of volume and expansion of type of use.