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Re Tegernsee Study

At the meeting on March 13, 2013, comments on the Tegernsee study were asked for by April 12. We have discussed the main questions within SIPF and have the following comments:

1. *Grace Period:*

The US is used to have a grace period of 12 months and has been asking that other countries also should adopt this practice as the US now has changed from first to invent to first inventor to file. Although inventors would like to have a grace period, it also provides problems determining when a publication actually has taken place and when the time for grace period starts to run. Further, the application filed during the grace period has, at least not earlier, been seen as a normal priority application having a priority time of 12 months. Thus, the application filed during the grace period could only be used as a priority application for further filing during a more limited time period and additionally the inventor might only obtain protection in countries having a grace period, if the filing is very late within the grace period. The conclusion is that a grace period system should be avoided as it gives more uncertainty than certainty to the inventors.

If there would be interest in having a grace period in more countries, said period should be shorter, e.g. 3 months. Then there is still time left, 9 months in this example, of the priority year and the applicant would have the possibility to have a thorough search performed and to obtain a substantive office action, from at least some patent offices, which could provide the applicant with a better ground to decide on the geographical and claim scope of further filings.

2. *Publication at 18 months*

It is considered that publication should take place at 18 months. It is however important that the applicant well before that time limit obtain a search report and preferably also a substantial office action from a patent office which carries out a search on all available documents from patent offices in the IP5 group. With such information the applicant will have sufficient information to decide whether to publish the application or to stop it from being published. For other applicants, it is also important to become aware of what have

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been filed close to the filing day of their applications in order for them to decide whether to continue the prosecution with the application and whether to publish the application or not.

3. Treatment of conflicting applications

The proposal to create a pool of international secret prior art under the PCT would probably lead to difficulties for the applicants in the future. If a parallel application filed shortly before a second application is citable also for inventive step it will lead to more problems for the applicants. From the applicants side it is understandable that an application filed before their applications is novelty destroying, it is however not understandable that it can be cited against inventive step as it was not published in any way and hence it was not possible to form any grounds for arguing against it when filing the applications.

Further, if a pool of secret prior art is being formed under the PCT, it could lead to problems regarding how this pool should be monitored and used in a transparent way within all the different PCT authorities.

4. Prior users right

Prior users right is at present a national right. It is a very limited right and does not provide the possibility to broaden the production within the first country or to move the production to another country. If it should be broader and encompasses all of Europe, it would be difficult to decide, if it then should apply to the countries which are signatories to the unitary patent or to the countries that are signatories to the EPC. Further, it could then be discussed whether a use in one country within another region should be interpreted in a similar way and also encompass more countries.

Although, it is understandable that companies want to move production to other countries, it is still possible to do so, if the production is moved to a country without patent protection. Thus, it would be better to keep the definition of prior users right to the now limited definition.

Regarding the date of prior use defence according to section 273 of AIA, which is one year before filing of the application describing the prior use, this must be seen as too long a period. The prior use should have occurred not later than the day before the filing of the application in the country where the prior use takes place, but not earlier. At the same time, the use should not be more extensive than what it was before the filing of the patent application claiming the use.

On behalf of

SIPF

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