Study Question

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Conflicting patent applications

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For all of the questions:

a) secret prior art means an earlier-filed patent application that was published on or after the effective filing date of a later-filed patent application.

b) effective filing date means the earlier of: 1) the actual filing date of the application; and 2) the filing date of an application from which priority is claimed that provides adequate support for the subject matter at issue.

The standard for what constitutes adequate support is outside the scope of this Study Question.

I. Current law and practice

Please answer all the below questions in Part I on the basis of your Group's current law and practice.

1 **For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are unrelated.**

1.a **Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain

1.a. **If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?**

Yes, except for the abstract. According to Art. 2(3) of the Hungarian Patent Act (HUPA), the whole contents approach is followed in Hungary.

1.a.i **If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?**

The standard for evaluation of novelty is this the same as the standard applied to publicly available prior art.

1.b **Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?**

No

Please Explain

1.b. **If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?**

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1.b.i **If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness? * *** ***The standard for combination of prior art is outside the scope of this Study Question. This question seeks to determine only if such a combination ispossible in the scenario presented.***

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1.b.i **If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?**

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1.c **If the secret prior art is an international application filed designating your jurisdiction:**

1.c. **Does this change any of your answers to questions 1(a) and 1(b) above? If YES, please explain.**

Yes

Please Explain

See below.

..c.i **Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

Yes

Please Explain

Yes. According to the general rule, the content of such an international application is only considered as available against the claims of the later-filed Hungarian application for novelty-defeating purposes, if the international application validly enters the Hungarian national phase (Art. 2(3) and 84/T(2) HUPA).

On the other hand, there exists a bypass exception to this rule as follows. The content of a European patent application is considered as available against the claims of a later-filed Hungarian application for novelty-defeating purposes, if the European patent application is published by the European Patent Office or a publication takes the place this publication (Art. 2(3) and 84/D(2) HUPA). There are no further requirements to this effect, e.g. no validation of the granted European patent in Hungary is required. In case of a Euro-PCT application, if the international publication was in an official language of the European Patent Office (i.e. English German or French), the international publication takes the place of the publication of the European patent application (Art. 153(3) EPC). Accordingly, in such situations the content of the international application is considered as available against the claims of the later-filed Hungarian application for novelty-defeating purposes, even if the Hungarian national phase is not entered.

.c.i **Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

No

Please Explain

2 **For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application are the same.**

2.a **Is the secret prior art available against the claims of the later-filed application for novelty-defeating purposes?**

Yes

Please Explain

2.a. **If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?**

Yes, except for the abstract.

.a.i **If YES, what is the standard for evaluation of novelty? Is this the same as the standard applied to publicly available prior art?**

The standard for evaluation of novelty is this the same as the standard applied to publicly available prior art.

.a.i **If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?**

No.

2.b Is the secret prior art available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

2.b. If YES, are the entire contents of the secret prior art available, or only a portion such as the claims?

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.b.i If YES, can the secret prior art be combined with another prior art reference to show lack of inventive step / obviousness?

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.b.ii If YES, is the standard for evaluation of lack of inventive step / obviousness the same as the standard applied to publicly available prior art?

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.b.iii If YES, is there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

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.b.v If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

2.c If the secret prior art is an international application filed designating your jurisdiction:

2.c. Does this change any of your answers to questions 2(a) and 2(b) above? If YES, please explain.

No

Please Explain

1.c.i **Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.**

Yes

Please Explain

See 1.c.ii

1.c.i **Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?**

No

Please Explain

3 **Question 1 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are unrelated. Question 2 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are the same. For each of the following scenarios, please indicate whether your answers would be the same as those under Question 1, or those under Question 2. If your answers are different from your answers to both Question 1 and Question 2, please explain.**

3.a **Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

same as Question 1

Please Explain

3.b **Same applicant on the dates of filing, no common inventor:**

same as Question 1

Please Explain

3.c **Different applicants on the dates of filing, same inventors:**

same as Question 1

Please Explain

3.c. **Would the answers change if the different applicants were part of a joint industry or industry-university research project?**

No

Please Explain

3.d **Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:**

same as Question 1

Please Explain

3.d. Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?

No

Please Explain

3.d.i Would the answers change if the different applicants were part of a joint industry or industry-university research project?

No

Please Explain

II. Policy considerations and proposals for improvements of your current law

4 Could any of the following aspects of your Group's current law be improved? If YES, please explain.

4.a The definition of when secret prior art is applicable to defeat patentability of a later-filed application.

No

Please Explain

4.b The patentablility standard (novelty, enlarged novelty, inventive step / obviousness) applied to distinguish the claims of the later-filed application from the secret prior art.

No

Please Explain

4.c The treatment of international applications as secret prior art.

No

Please Explain

4.d The treatment of total and partial identity of applicants as it relates to secret prior art.

No

Please Explain

4.e The treatment of inventive entities (same, common, or different inventorship) as it relates to secret prior art.

No

Please Explain

4.f **Provisions for avoiding self-collision.**

No

Please Explain

4.g **Provisions for limiting an applicantâ€™s right to obtain patent claims in the later-filed application on inventions that are incremental with respect to the same applicantâ€™s earlier-filed application.**

No

Please Explain

5 **Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?**

No

Please Explain

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

6 **Does your Group consider that harmonisation in any or all areas in Section II desirable?**

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

Yes

If YES, please respond to the following questions without regard to your Group

7 ***For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application areunrelated.***

7.a ***Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?***

Yes

Please Explain

7.a. ***If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?***

Yes, except for the abstract.

If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?

The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art.

Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?

No

Please Explain

If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?

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If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

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If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

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If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 7(a) and 7(b) above? If YES, please explain.

Yes

Please Explain

See below.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

If the national phase is not entered in a country, no double patenting can occur in that country. Therefore, the content of such an international application should only be considered as available against the claims of the later-filed application for novelty-defeating purposes, if the international application validly enters the national phase in the particular country.

7.c.i ***Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?***

No

Please Explain

8 ***For the purposes of this question, assume the applicant and inventors of the secret prior art and the applicant and inventors of the later-filed application arethe same.***

8.a ***Should the secret prior art be available against the claims of the later-filed application for novelty-defeating purposes?***

Yes

Please Explain

8.a.i ***If YES, should the entire contents of the secret prior art available, or only a portion such as the claims?***

Yes, except for the abstract.

8.a.ii ***If YES, what should the standard for evaluation of novelty be? Should this be the same as the standard applied to publicly available prior art?***

The standard for evaluation of novelty should be the same as the standard applied to publicly available prior art.

8.a.iii ***If YES, should there be any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?***

No.

8.b ***Should the secret prior art be available against the claims of the later-filed application to show lack of inventive step / obviousness?***

No

Please Explain

8.b.i ***If YES, should the entire contents of the secret prior art be available, or only a portion such as the claims?***

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If YES, should the secret prior art be combinable with another prior art reference to show lack of inventive step / obviousness?

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If YES, should the standard for evaluation of lack of inventive step / obviousness be the same as the standard applied to publicly available prior art?

–

If YES, should there any anti-self collision time period during which the secret prior art is not available against the claims of the later-filed application for novelty-defeating purposes? What should that time period be?

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If anti-self collision is applied, are there any additional restrictions to avoid double patenting (e.g., requiring common ownership, terminal disclaimer, litigating all patents together, etc.)?

If the secret prior art is an international application filed designating your jurisdiction:

Does this change any of your answers to questions 8(a) and 8(b) above? If YES, please explain.

Yes

Please Explain

See below.

Does it matter whether the international application actually enters the national phase in your jurisdiction? If YES, please explain.

Yes

Please Explain

If the national phase is not entered in a country, no double patenting can occur in that country. Therefore, the content of such an international application should only be considered as available against the claims of the later-filed application for novelty-defeating purposes, if the international application validly enters the national phase in the particular country.

.c.i ***Does the date from which the international application is available as secret prior art depend on the date of national phase entry in your jurisdiction?***

No

Please Explain

9 ***Question 7 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application areunrelated. Question 8 considered the situation where both the inventors and the applicant of the secret prior art and the later-filed application are thesame. For each of the following scenarios, please indicate whether the answers would be the same as those under Question 7, or those under Question 8. If your proposals are different from your answers to both Question 7 and Question 8, please explain.***

9.a ***Same applicant on the dates of filing, one common inventor, one additional inventor on the later-filed application:***

same as Question 7

Please Explain

9.b ***Same applicant on the dates of filing, no common inventor:***

same as Question 7

Please Explain

9.c ***Different applicants on the dates of filing, same inventors:***

same as Question 7

Please Explain

9.c. ***Would the answers change if the different applicants were part of a joint industry or industry-university research project?***

No

Please Explain

9.d ***Different applicants on the dates of filing, one common inventor, one additional inventor on the later-filed application:***

same as Question 7

Please Explain

9.d. ***Would the answers change if all inventors had an obligation to assign the invention to the same applicant as of the dates of filing?***

No

Please Explain

.d.i ***Would the answers change if the different applicants were part of a joint industry or industry-university research project?***

No

Please Explain

9.e ***Different applicants on the dates of filing, no common inventor, but all inventors had an obligation to assign the invention to the same applicant as of the dates of filing:***

same as Question 7

Please Explain

9.f ***Different applicants on the dates of filing, no common inventor, but the different applicants were part of a joint industry or industry-university research project:***

same as Question 7

Please Explain

10 ***Please comment on any additional issues concerning conflicting applications you consider relevant to this Study Question.***

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11 ***Please indicate which industry sector views are included in your Group's answers to Part III.***

Pharmaceutical industry.