

Q289

Harmonisation of disclosure requirements and consequences of non-compliance

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Respondent

2

Anonymous

35:57

Time to complete

Contact details

Kindly submit your and your groups contact details below. Please also include the authors of the reports.

1. Name (*in English*) of contributing National/Regional Group or Independent Member: *

Hungarian Group of AIPLI

2. Contributor's name: *(Please note: name cannot be edited after the report submission)* *

Daisy MACHYTKA-FRANK

3. Contributor's email: *

daisy@godollepat.hu

4. Other Contributors / Authors:

Mónika BIACS; Zsuzsanna BUZÁS-NAGY; Dóra GEYER-HIRT; Bálint HALÁSZ; Laura JURECSKA; Hajnalka KOMPAGNE; Imre MOLNÁR; Miklós TAR

I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

In the context of this Study Question, the below terms have the following meaning:

"Related patent application": means continuation-in-part applications, divisional applications, and/or continuation applications.

"Prior art": Consistently with Resolution Q167 (Lisbon, 2002), means "all information which has been made available to the public anywhere in the world in any form before the filing date or, where applicable, the priority date".

"Post-grant proceedings": means proceedings before the IP office after the grant of the patent, such as opposition, re-examination, reissue, post grant review, inter partes review, etc.

5. **Disclosure requirement**

1. Does your Group's current law provide for a requirement to disclose information such as prior art and/or related patent application(s)?

Please answer YES or NO and you may provide an explanation.

☒ Yes

☐ No

6. 1. (continued) Please explain

The only disclosure requirement is set forth in the Formal Regulation referred to below. According to Art. 57(3a) of the Patents Act (Act No. XXXIII of 1995 on the Protection of Inventions by Patents), patent applications shall be filed in compliance with the detailed formal requirements laid down in the Formal Regulation.

Section 4 (1) c) of the Formal Regulation, i.e. Decree 20/2002 (XII.12) of the Hungarian Minister of Justice reads as follows:

„The patent description must include:

c) the presentation of the state of the art known to the applicant by describing solutions that are close to the invention - and, if possible, sources - that facilitate the understanding of the invention and the assessment of its patentability.”

The above regulation does not require to include any information on related patent application(s) into the patent description, neither at the filing nor during the prosecution. It is clear from the above rule of the Formal Regulation that the disclosure requirement should be met at the time of the patent application filing.

It is mentioned that the Guidelines for Patent Examination of the Hungarian Intellectual Property Office (HIPO), Chapter II (II.6.3.2.3. Presentation of the state of the art) also prescribes that the patent description must include the presentation of the state of the art known by the applicant, solutions that are close to the invention – and if possible, with a description of the sources – that enable the understanding of the invention and the assessment of its patentability.

7. 1. (continued) If you answer YES to question 1, please explain the context/time of such disclosure requirement:

☒ a. at the time of patent application filing and/or during prosecution of the patent application;

☐ b. at the time of post-grant proceedings;

☐ c. at the time of a proceeding before a court (infringement, nullity action, etc.);

☐ d. at any other time.

8. 1. (continued) Please add comments below

9. 2. Must the disclosure to be spontaneous and in all cases or only in certain circumstances (e.g., at the request of the IP Office or a judge, etc.)?

It follows from the above answer to Question 1 that the presentation of the state of the art at filing is an obligation in all cases and it should be spontaneous. However, in case of non-compliance the HIPO issues an invitation to rectify, i.e. to complete the patent description with the presentation of the state of the art.

10. 2. (continued) Please add comments below

11. **Scope of the disclosure requirement**

3. Please indicate which information is concerned by the disclosure requirement:

- ☒ a. all patent publication documents defined as prior art;
- ☒ b. All non-patent publication documents defined as prior art;
- ☐ c. related patent application filings, i.e. continuation-in-part applications, divisional applications, continuation applications;
- ☐ d. published or unpublished patent applications (and/or grant procedure documents, such as research reports, etc.) covering the same invention in other jurisdictions (whether claiming or not the associated priority benefit);
- ☒ e. any information other than a patent publication (products, photography, invoices, statements, information on internet, traditional knowledge, genetic resources, information concerning prior uses etc.);
- ☐ f. any other information.

12. 3. (continued) Please add comments below

a. YES;

b. YES;

c. NO, see the answer to Question 1;

d. NO, see the answer to Question 1;

e. YES. According to Art. 2 (2) of the Patents Act „The state of the art shall be held to comprise everything made available to the public by means of a written communication or oral description, by use, or in any other way, before the date of priority“. There may be cases when the way for becoming public of a highly relevant prior art document is other than a patent or non-patent publication;

f. NO.

13. 3. (continued) Please add comments below

14. 4. Does the disclosure requirement concern all information that may affect the validity of the patent application, e.g., novelty and/or inventive step, insufficiency/plausibility, etc.?

NO.

15. **4. (continued)** Please add comments below

The disclosure requirement relevant to the present study, see Question 1, concerns information that facilitates the understanding of the invention and the assessment of its novelty and inventive step. However, there is no obligation to inform the HIPO during prosecution on new pieces of relevant prior art and/or patentability objections that come to the knowledge of the applicant e.g. from foreign proceedings.

16. **5.** If the document is published in a language which is not one of the permitted languages in which applications can be filed, does your legislation require that a translation be provided (formal or informal translation)?

NO.
The state of the art has to be summarized, only, in the patent description in Hungarian. If possible, the relevant sources (typically documents), are also to be specified. In theory, it might happen that the HIPO requests a copy of a summarized document and a translation thereof, if it is not in English, German or French, however, in practice this does not happen.

17. **6.** What level of analysis is required to determine relevance of a document/prior art publication? For example, is a full legal opinion on relevance required, before a publication can be dismissed as irrelevant?

Full legal opinion is not required, the document/prior art publication should be discussed only to the extent that it is relevant to the invention. Among the features of the known solutions those should be emphasized, which are intended to be improved by the invention. Analysis of known solutions should be objective, moderate and factual.

18. **6. (continued)** Please add comments below

19. **7.** Does your Group's current law provide for exceptions to the disclosure requirement prior to filing a patent application, e.g., during a grace period?

The Patents Act defines two exclusions from the state of the art as follows: a publication of the invention that occurred not earlier than six months preceding the date of priority shall not be taken into consideration as part of the state of the art if it was due to an abuse of the rights of the applicant or his predecessors in title, or it was due to the fact that the applicant or his predecessors in title have displayed the invention at an exhibition specified in an announcement by the President of the HIPO published in the Hungarian Official Gazette. The disclosure requirement does not apply to the above-detailed publications excluded from the state of the art.

20. **7. (continued)** Please add comments below

21. **8.** Does your Group's current law provide for a publication of the information disclosed by the person on whom the disclosure requirement rests (e.g. by inclusion in the patent application as published)?

YES. As mentioned above, the information on the state of the art is to be included in the patent description as filed, or, if this requirement is not complied with, then during prosecution the HIPO invites the applicant to complete the patent description accordingly. If the information is present already in the description as filed or is included before the publication, then the information will be published in the published application (and also in the published granted patent). If the information is included at a later stage, then the information will be published in the published patent.

22. **Burden of disclosure**

9. Who is required to disclose such information:

- ☐ a. the inventor?
- ☒ b. the applicant?
- ☐ c. assignees of the patent?
- ☐ d. licensees of the patent?
- ☐ e. any other person (e.g., patent agent, employees, another patent office, etc.)?

23. **9. e) (continued)** Please add comments below

Comments to Question 9 instead of 9.e):

a. Only if the inventor is the applicant (see answer to b. below);

b. YES. As cited before in answer to Question 1, the applicant shall include in the patent description the presentation of the state of the art known to the applicant. As a general rule, the disclosure requirement is to be met at the time of filing, therefore, it is the obligation of the original applicant. If the presentation is to be supplemented during prosecution, and such supplementation takes place after an assignment, the assignee will have replaced the original applicant in the proceedings, who has the same rights and obligations as the original applicant used to have. Therefore, it is always the actual applicant's obligation to disclose such information, before grant;

c. NO. The description of a granted patent cannot be completed with the presentation of the state of the art;

d. NO. The disclosure of the state of the art shall be made in the patent description. Therefore, it is the applicant's obligation. See also c.;

e. NO.

24. **9. e) (continued)** Please add comments below

25. **10.** Does the disclosure requirement concern only information actually known by the person who has the burden of disclosure or also information that he/she should have known?

YES.

26. **10. (continued)** Please add comments below

According to the wording of the relevant legislation (see cited law in answer to Question 1, the applicant shall include the presentation of the state of the art known to the applicant [emphasis added]). Therefore, only the state of art actually known by the applicant is required to be disclosed by the applicant. In practice, however, it is recommended for the applicant to research the state of the art and disclose as full list of it as possible. Otherwise, if the HIPO finds the presentation insufficient (based on the HIPO's own research), the HIPO will invite the applicant to complete the presentation.

27. **11.** Is the person who has the burden of disclosure required to identify or describe which portions of the prior art are relevant or material?

NO.

28. **11. (continued)** Please add comments below

The applicant shall present the state of the art known to the applicant by describing solutions that are close to the invented solution. According to the Formal Regulation and the Guidelines of the HIPO (see the answer to Question 1 above), the sources are to be specified "if possible". Thus, it is preferable to identify the relevant portions of the prior art, i.e. the sources, that may influence the assessment of the novelty or inventiveness of the invention, but there is no obligation.

29. **Sanctions**

12. Does your Group's current law provide for an option to cure a failure to disclose, when disclosure requirement has not been met in a timely fashion? Please briefly explain.

YES.

30. **12. (continued)** Please add comments below

Until grant the applicant may voluntarily complete the presentation of the state of the art in the patent description, or such a completion can be carried out upon receiving a respective invitation from the HIPO.

31. **13.** Does your Group's current law provide for a way to ensure compliance with the disclosure requirement (e.g., how to ensure that the person who has the burden to disclose has complied with his/her obligation)? Please briefly explain.

YES.

32. **13. (continued)** Please add comments below

As mentioned in the answer to Question 1 above, the disclosure requirement is part of the formal requirements laid down in the Formal Regulation also referred to in Art. 57(3a) of the Patents Act. According to Art. 68(1) of the Patents Act, the HIPO shall also examine whether the formal requirements have been met. According to Art. 68(2), where the application does not comply with the requirements, the applicant shall be invited to rectify the irregularities. According to Art. 68(3), the patent application shall be rejected if, in spite of the rectification or a statement, it still does not comply with the requirements.

33. **14.** Does your Group's current law provide a consequence or penalty for non-compliance with the disclosure requirement? Please briefly explain.

A post-grant consequence or penalty for non-compliance is not provided by our law.

34. **14. (continued)** Please add comments below

II) Policy considerations and proposals for improvements of your Group's current law

35. **15.** According to the opinion of your Group, is your current law regarding the disclosure requirement adequate and/or sufficient? Please answer YES or NO and briefly explain, listing areas in which your current law is not sufficient/adequate.

☒ Yes

☐ No

36. **15. (continued)** Please add comments below

37. **15. (continued)** Please add comments below

38. **16.** According to the opinion of your Group, is your current law regarding its disclosure requirement, if any, relating to the GR/TK adequate and/or sufficient? Please answer YES or NO and briefly explain.

☒ Yes

☐ No

39. **16. (continued)** Please add comments below

Although GR/TK is not mentioned in individualized form in the regulation concerning the disclosure requirement for the state of the art detailed above in the answer to Question 1, in line with the discussion in the answer to Question 3 e. above, the disclosure requirement is understood as relating also to GR/TK.

40. **16. (continued)** Please add comments below

41. **17.** Please explain whether in your Group's view it would be beneficial for having a duty to disclose prior art in patent applications, and why the duty would provide / would not provide a benefit to third parties. In particular, what benefit do third parties gain from having access to a list of disclosed prior art for any given patent application?

In the view of the Hungarian Group, such a duty provides a benefit to third parties, as the presentation of the state of the art is included in the patent description, and, thus, after its publication it becomes an important source of technical information and facilitates the understanding of the invention.

42. **17. (continued)** Please add comments below

43. **18.** According to the opinion of your Group, 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?

In the view of the Hungarian Group a high quality of the granted patents is the responsibility of the patent granting authorities. While said high quality is also the interest of the applicants, this goal has to be achieved by careful search and examination by each patent granting authority, without putting too much burden of information disclosure on the applicants.

44. **18. (continued)** Please add comments below

III) Proposals for harmonisation

Please answer all questions in Part III without taking into consideration your Group's current law.

45. **19.** Do you consider harmonisation regarding a requirement/duty to disclose information as desirable in general?

☒ Yes

☐ No

46. If you answer YES to the question above, 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.

Disclosure requirement

20. What should be the context/time of such disclosure requirement:

- ☒ a. at the time of patent application filing and/or during prosecution of the patent application?
- ☐ b. at the time of post-grant proceedings (e.g., opposition, reexamination, reissue, post grant review, inter partes review)
- ☐ c. at the time of a proceeding before a court (infringement, nullity action, etc.)
- ☐ d. at any other time.

47. **21.** Should the disclosure be spontaneous and in all cases or only in certain circumstances (for example, at the request of the IP Office or if ordered by a Court, etc.)?

As for Question 19: An obligatory disclosure requirement at the time of the patent application filing could be worldwide useful not only for the patent granting authorities but after publication of the patent application for the public using said application as an important source of technical information;

As for Questions 20 and 21 our combined answer is: In the view of the Hungarian Group only the inclusion of the state of the art known to the applicant at the filing date in the patent description should be spontaneous and in all cases worldwide because such an obligation has a chance to be accepted internationally. At the same time, patent granting authorities should not be prohibited to require to complete the patent description with further pieces of the state of the art revealed by them by their novelty search. However, more rigorous requirements like informing patent granting authorities on new pieces of the state of the art revealed by other patent granting authorities or on even other objections raised by other patent granting authorities would be a too strong burden for the applicants and probably unacceptable on an international level. In addition, a piece of the state of the art or an objection relevant in a given jurisdiction may be completely irrelevant in another jurisdiction. The Hungarian Group does not suggest either to introduce an obligation to include additional prior art, if revealed, in the patent description, at the time of post-grant proceedings or of a proceeding before a court.

48. **21. (continued)** Please add comments below

49. **Scope of the disclosure requirement**

22. Please indicate which information should be subject to the disclosure requirement.

- a. all documentary patent prior art: YES;
- b. all documentary non-patent prior art: YES;
- c. related patent application filings, i.e. continuation-in-part application, divisional applications, continuation applications: NO;
- d. published or unpublished patent applications (and/or grant procedure document, such as research reports, etc.) covering the same invention in other jurisdictions (claiming or not the associated priority benefit): NO;
- e. any information other than a patent application (products, photography, invoices, statements, information on internet, traditional knowledge, genetic resources, information about prior uses etc.): YES;
- f. any other information: NO.

50. **Scope of the disclosure requirement**

22. Please indicate which information should be subject to the disclosure requirement.

For each of the following, please answer YES or NO and you may provide a brief explanation.

- ☐ a. all documentary patent prior art
- ☐ b. all documentary non-patent prior art
- ☐ c. related patent application filings, i.e. continuation-in-part application, divisional applications, continuation applications
- ☐ d. published or unpublished patent applications (and/or grant procedure document, such as research reports, etc.) covering the same invention in other jurisdictions (claiming or not the associated priority benefit)?
- ☐ e. any information other than a patent application (products, photography, invoices, statements, information on internet, traditional knowledge, genetic resources, information about prior uses etc.)
- ☐ f. any other information

51. **22. (continued)** Please add comments below

52. **22. (continued)** Please add comments below

53. **23.** Should the disclosure requirement concern all information that may affect the validity of the patent application, e.g., novelty and/or inventive step, insufficiency/plausibility etc.?

NO.

54. **23. (continued)** Please add comments below

See the answer to Questions 20 and 21.

55. **24.** What level of analysis should be required to satisfy the duty to disclose, e.g. should a formal legal opinion be required in the case of every potential disclosure?

Simply listing prior art already known in the same technical field should not be sufficient. It would be advisable to require for the applicant to locate and summarize the most relevant pieces of prior art and highlight also their drawbacks. It would help the Examiner during substantive examination. It is not necessary to require formal legal opinion in case of every potential disclosure within the framework of the duty of disclosure. The applicant should have an opportunity to express opinion on the relevance of a prior art document during prosecution of the patent application, in the reply to the objections raised by the Examiner.

56. **24. (continued)** Please add comments below

57. **25.** If the document is published in a language not permitted for patent applications, should a translation (formal or informal translation) be required?

It should be decided by the patent granting authority whether or not to require a translation.

58. **25. (continued)** Please add comments below

59. **26.** Should there be exceptions for disclosure requirement, for instance prior to filing a patent application (e.g., during the grace period)?

The disclosure requirement should not apply to publications excluded from the state of the art.

60. **26. (continued)** Please add comments below

61. **27.** Should the information communicated to the IP office and/or courts as regards the reason why the disclosure requirement applies or does not apply for a certain disclosure be available to the public?

YES.

62. **27. (continued)** Please add comments below

This information should be made available to the public, especially if the disclosure requirement does not apply for a certain publication, because the quality of patents can be increased by transparency. This should be done when the decision on applicability of the disclosure requirement is made but not later than the publication of the grant of the patent.

63. **28.** Should the reason why particular prior is disclosed as potentially relevant constitute a binding admission in all later proceedings as to the relevance of the prior art?

Not necessarily, because the relevancy may change in the later proceedings, e.g. due to claim amendments. In addition, if the question concerns also later foreign proceedings, then it is also to be mentioned that relevancy may vary from jurisdiction to jurisdiction.

64. **The person who should have the burden of disclosure**

29. Who should be required to disclose such information:

- ☐ a. the inventor?
- ☒ b. the applicant?
- ☐ c. assignees?
- ☐ d. licensees?

65. **30.** Should the disclosure requirement concern only information known by the person who has the burden of disclosure or also information that he/she should have known?

As mentioned above, the HIPO's current practice already extends the disclosure requirement to prior art revealed by the HIPO's search conducted within frameworks of examination. The Hungarian Group believes this practice is reasonable as the actual knowledge of the person having the burden of disclosure may vary from no knowledge of the prior art to deep knowledge of the entirety of the prior art. The Hungarian Group is of the view that this practice could be followed also in other countries. Thus, in the view of the Hungarian Group the disclosure requirement may concern also information that the person who has the burden of disclosure should have known, but said information is to be limited to the search results of the given patent granting authority.

66. **30. (continued)** Please add comments below

As for Question 29 our answer is as follows:

Who should be required to disclose such information:

- a. The inventor, only if the inventor is the applicant (see answer to b. below)
- b. The Hungarian Group believes the current legal provision sufficiently puts this obligation on the applicant, and this should be followed worldwide, as the disclosure is formulated during the preparation of the description and the examination procedure.
- c. As mentioned above, in the view of the Hungarian Group the disclosure should be made in the description, which circumstance clearly places the burden on the applicant. However, by virtue of an assignment, the assignee replaces the applicant in the procedure.
- d. As stated above, it is desirable to place the burden of disclosure on the applicant. As the licensee does not have the same rights and obligations as an applicant, no such burden should be placed on the licensee.
- e. No other person. Only the applicant should be required to disclose prior art.

67. **31.** Should the person who has the burden of disclosure required to identify or describe which portions of the prior art are relevant or material?

YES.

68. **31. (continued)** Please add comments below

The person who has the burden of disclosure should identify the relevant part of the prior art because (i) this may help to define better the goal and the field of invention and consequently to formulate more precisely the claims, and (ii) such requirement is not a real burden since the applicant (optionally with the assistance of the inventor) can be expected to know the technical fields in which the invention was made, taking also into consideration the easy access to information sources existing today.

69. **Sanctions**

32. How should the compliance with the disclosure requirement should be enforced (e.g., how to ensure that the person who has the burden to disclose has complied with his/her obligation, and what sanctions should follow if there is non-compliance)?

If the disclosure requirement is not met in the patent description as filed, the patent granting authority should issue an invitation to rectify. A failure to meet the disclosure requirement in spite of a respective invitation by the patent granting authority should be followed by a sanction, such as refusal.

70. **32. (continued)** Please add comments below

71. **33.** What should the consequence or penalty for non-compliance with the duty of disclosure be, and should an option to cure a failure to disclose be available?

No post-grant consequence or penalty for non-compliance with the duty of disclosure is necessary.

72. **33. (continued)** Please add comments below

73. **33. (continued)** Please add comments below

74. **34.** Please comment on any additional issues concerning any aspect that you consider relevant to this Study Question.

The Hungarian Group has no further comments.

75. **34. (continued)** Please add comments below

76. **34. (continued)** Please add further comments below

77. **35.** Please indicate which industry sector views provided by in-house counsels are included in your Group's answers to Part III.

Pharmaceutical industry.