

QUESTION 89 C

Self-Collision

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Q89 C

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„Self-Collision“

RESOLUTION

Art. 202 of the draft WIPO Treaty on harmonization of patent law is concerned with the prior art effect of an earlier but unpublished application on the novelty of an invention in a later application, i.e. the „whole contents“ approach.

The article tentatively provides for an exception in the case of identity of the applicants or inventors in the two applications, i.e. an exception for “self-collision”.

AIPPI has been considering the desirability of such an exception and the detailed provisions which might be made.

AIPPI is wholly in favour of an exception for “self-collision”.

In considering the details, AIPPI concluded that the exception should arise when there is identity of applicants and that this identity could be partial, i.e. the exception should arise if one application is in the names A & B and the other in the names A & C.

AIPPI discussed the possibility of creating the exception by assignment of one application to an applicant in the other application, but decided that the exception should depend on identity of the applicants at the date of filing the later application. AIPPI also considered the possibility of arguing for „identity“ when one applicant is an owned or controlled associate company of the other applicant. In both cases, AIPPI was of the opinion that these were complicating considerations which might reduce the possibility of the “self-collision“ exception being incorporated in the Treaty.

In considering the possibility of the „self-collision“ exception arising from identity of inventors, AIPPI was fairly evenly divided. Bearing in mind the not-infrequent problem of determining the true inventors at the time of filing, the greater difficulty there may be in making corrections to inventorship after filing, movement of inventors from one company to another and the possibility of inventors not wishing to be named at all, it was felt that, on balance, it would be better to restrict the exception to identity of applicants.

AIPPI is of the opinion that the „self-collision“ exception should be accompanied by a provision against double patenting.

AIPPI recognizes that internal priority is a necessary complement to the self collision exception.

RESOLUTION

1. In the draft WIPO Treaty on Harmonization of certain provisions in laws for the protection of inventions, there should be a provision in Art. 202 on Prior Effect of Applications which excludes „self-collision“ between applications in which there is at least partial identity of the applicants for the respective applications at the date of filing the later application.
2. The Treaty should exclude the possibility of double patenting in these circumstances.
3. In the Treaty, internal priority should also be provided for.

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