

Summary Report

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2024 – Study Question

Harmonisation of disclosure requirements and consequences of non-compliance

Introduction

This Study Question aims to assess the need to harmonize disclosure requirements and consequences of non-compliance.

Disclosure requirements can occur in a number of different contexts. For example, prior art will need to be disclosed to the US PTO and other patent offices as part of the application process (and such prior art disclosures may or may not need to include publications alleged to be covered by a grace period and are therefore not “prior art” as such). Questions will arise as to what kinds of documents or other material is subject to such disclosure requirements, how the relevance of various disclosures is determined, whether determinations of relevance are binding, etc.

Where prior art is known to exist in the form of traditional knowledge or genetic resources, it may need to be disclosed during the application process, in those countries that have entered into the WIPO treaty on Intellectual Property Genetic Resources and Associated Traditional Knowledge (2024).

Ultimately the need for a disclosure requirement should be justified, *i.e.* that the requirement has a legitimate purpose and is not an arbitrary requirement. Furthermore, the consequences of a failure to comply with a disclosure requirement will need to be defined and this is likely one of the most challenging aspects of disclosure requirements, since only a very small proportion of patents granted are in fact litigated later where non-compliance with disclosure requirements could be an issue. It may be disproportionate to burden the application process for all patents with onerous disclosure requirements for the sake of litigating a small proportion of those patents. However, even some disclosure during the application process may be a useful contribution for the patent office examiner who will need information to establish what the state of the art in the field comprised.

The Reporter General has received Reports from the following Groups and Independent Members in alphabetical order: Argentina, Australia, Belgium, Brazil, Bulgaria, Canada, Chile, China, Chinese Taipei (Independent Member), Croatia, Denmark, Ecuador, Finland, France,



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Germany, Hungary, India, Indonesia, Israel, Italy, Japan, Latvia, Malaysia, Mexico, Netherlands, Paraguay, Peru, Philippines, Poland, Portugal, Russian Federation, Singapore, Spain, Sweden, Switzerland, Thailand, Turkey, the United Kingdom (UK), the United States of America (USA) and Vietnam.

40 Reports were received in total¹. The Reporter General Team thanks the Groups and Independent Members for their helpful and informative Reports. All Reports may be accessed here: [\[link\]](#).

The Reports provide a comprehensive overview of national and regional laws, practices, and policies relating to disclosure requirements and consequences of non-compliance, set out in three parts:

- Part I – Current law and practice
- Part II – Policy considerations and proposals for improvements of your Group's current law
- Part III – Proposals for harmonisation.

This Summary Report does not summarize Part I of the Reports received. Part I of any Report is the definitive source for an accurate description of the current state of the law in the jurisdiction in question.

This Summary Report has been prepared on the basis of a detailed review of all Reports (including Part I) but focuses on Parts II and III, given AIPPI's objective of proposing improvements to, and promoting the harmonisation of, existing laws. As it is a summary, if any question arises as to the exact position of a particular Group in relation to Parts II or III, please refer to the relevant Report directly.

In this Summary Report:

- references to Reports of or responses by one or more "Groups" may include references to Independent Members;
- where percentages of responses are given, they are rounded to the nearest 5%; and
- in Part IV below, some conclusions have been drawn in order to provide guidance to the Study Committee for this Study Question.

I. Current law and practice

For the replies to Questions 1) – 14) set out in the Study Guidelines for this Study Question, reference is made to the full Reports. The Study Guidelines may be accessed here: [\[link\]](#).

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

- 15) According to the opinion of your Group, is your current law regarding the disclosure requirement adequate and/or sufficient? Please answer YES or**

¹ Reports received after 30 June 2024 are listed above if received by the date of completion of this summary report, but their content is not included in the summary in Parts II and III.

NO and briefly explain, listing areas in which your current law is not sufficient/adequate.

The Groups that answered this general question (36 Groups) overwhelmingly answered YES, *i.e.* that current law is adequate and/or sufficient (33 Groups, *i.e.* 90%), while only 3 Groups (10%) answered NO.

Among the Groups that answered YES to this question, the Japanese Group indicates that: *“in Japan, the applicant is only required to disclose prior art he/she actually knows at the time of filing the patent application. We think that this is a well-balanced system because it contributes to an increase in quality and effectiveness of the examination and does not place an excessive burden on the applicant. Moreover, no sanction is imposed after the grant because non-compliance with the disclosure requirement is not a substantive defect of the patent application itself”.*

The French Group observes that *“[under French law] even if the applicant does not specifically identify the entire state of the art in his application, he drafts it and defines its scope according to the prior art known to him. Otherwise, he takes a higher risk of the patent being limited or cancelled, depending on the quality of the search and examination by the offices, and the ability of third parties to identify elements of the prior art. There is therefore already an incentive for the applicant (i) to only claim elements that are not part of the state of the art and (ii) not to conceal the existence of relevant elements concerning the state of the art”.*

In the same vein, Australian Group considers that: *“the current position in Australia – there being no mandatory duty to disclose prior art or related patent applications to the Australian Patent Office – is sufficient and appropriate”,* and observes that *“adding a requirement for patent applicants to disclose all relevant prior art of which they are aware would introduce unnecessary complexity and increase costs associated with the patent application process in Australia”.*

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.

The 35 Groups that answered this more specific question are divided: 60% (21 Groups) answered YES, compared with 40% (14 Groups) answered NO.

The UK Group, which answered YES, states that: *“[under UK law] there is currently no specific disclosure requirement relating to GR/TK”* and the UK Group does not consider that *“the current requirements need change. The goal of ensuring proper sharing of benefits arising from the use of GR/TK is subject to a different legislative/regulatory regime, particularly the 1992 Convention on Biological Diversity (which lists 196 states as parties, including the UK). Arguably it is not the job of national patent law to seek to amend that regime. Further, the introduction of such measures brings with it the risk that applicants prefer to rely on trade secrets, thereby potentially negating the goals of the pre-existing regime. Additionally, increasing the disclosure burden has the potential to create complications. For example, in an examiner appreciating the particular nuances of foreign, local communities' behaviour or use of particular genetic material in the*

context of a patent specification. For a similar reason it is not clear that such disclosure would in fact result in additional relevant prior art being located, and therefore the possible improvement in patent quality may not come to light”.

In contrast, the Polish Group, responding NO, explains that “[under Polish law] there is no obligation to disclose additional information regarding GR/TK like the country of origin of the GR, the source of the GR nor the indigenous peoples or local community that provided the Associated TK, or the source of the Associated TK. In our opinion it is not sufficient. We believe that this requirement should be harmonised, and each applicant should provide such information in the patent application or if not possible, to make a declaration that none of the information is known to the applicant. We agree with the conditions set forth in (recently adopted) WIPO treaty on Intellectual Property Genetic Resources and Associated Traditional Knowledge”.

- 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?**

All Groups answered this question.

- Many Groups consider that a duty to disclose prior art in patent applications would provide a benefit to third parties.

The US Group notes that “*there is currently a duty to disclose prior art in patent applications in the US*” and explains that “[t]his “*duty to disclose*” is beneficial to all stakeholders in the patenting process, including third parties. Such benefits include assurance, to the extent possible, that relevant prior art was considered during examination, resulting in a stronger patent; increases the chance that the Examiner has all important information during examination; and a list of relevant prior art to assist in making and/or using the claimed invention.”

Other Groups consider that a duty to disclose prior art in patent applications would provide a benefit to third parties, in particular “*to understand the background of the invention and to what extent the patent application is different from the prior art*” according to the Chinese Group, to “*gain certainty about prior art related to a patent application*” according to the Italian Group, to “*become acquainted with the prior art and the contribution of the proposed invention to this prior art which will help them in practising the invention*” according to the Bulgarian Group, or to “*help the patenting process of third parties and would make it easier for potential inventors to assess if their inventions may potentially comply with the patentability requirements before deciding whether to pursue the patenting process*” according to the Chilean Group.

However, many Groups believe the potential benefits do not outweigh the costs incurred by a duty to disclose prior art.

In particular, the Brazilian Group explains that “*in [its] opinion such an obligation would increase the workload and costs of filing patent applications without offering a direct benefit to the applicant. However, if implemented in Brazil as a voluntary system, it could significantly improve patent application examination efficiency from the PTO’s perspective. Since our PTO lacks sufficient examiners, voluntary disclosure could expedite the prosecution process*”.

The Danish Group recognizes that “*such a duty probably would provide a benefit to third parties in terms of providing for a more effective patent application examination, but [...] these potential benefits do not, in the Danish Group’s view, outweigh the extra burden and work this would entail for the applicant as well as the difficult considerations regarding legal rights and certainty that follows from such a disclosure requirement, not least in relation to the difficult question of assessing whether or when a particular piece of prior art should have been filed with the patent authority. As a basic consideration, it is the Danish Group’s view that it would be wrong to involve the applicant in considerations concerning which prior art it would be relevant to highlight and evaluate as part of assessing the patentability of a patent application (or a granted patent). It is only the patent authority that can grant a patent and therefore it is by definition only the patent authority that knows what may be patented and therefore what prior art it would be relevant to include as part of this assessment.*”

The Malaysian Group indicates that “*such duty is burdensome and may hinder or even penalise patent applicants who do not have the means to conduct extensive and comprehensive prior art searches. Other than having the list of the disclosed prior art provided by the applicant or a potential ground to sanction the patent application for failure of compliance, the third parties would not enjoy other benefit arising from such duty.*”

The French Group underlines that “*drawbacks include the cost of the work required to analyze the prior art disclosed, in particular that in written in languages that are difficult and/or costly to translate.*”

The Spanish group mentions that “*the obligation to disclose the state of the art beyond what is known to him [the applicant] at the date of application implies an increase in bureaucracy, and thus undue costs, which translates into a less attractive system. In addition, such a system would become more unbalanced, since the additional economic burden associated with increased responsibility and bureaucracy falling on the applicant may be more easily assimilated by large companies than by SMEs or individual inventors.*”

Moreover, several Groups consider that it is the role of national patent offices to identify relevant prior art, not that of the applicants, and that examination is therefore sufficient.

The Finnish Group indicates that “[t]he Patent Office searches and examines each patent application and takes into account search results from other Patent Offices according to the current duty of disclosure requirement”.

The Polish Group considers that regarding “*the standard prior art (patent and scientific literature)*”, “*it should be the obligation of the Patent Office to do the*

screening for relevant prior art and include it in their search report”, and that “Patent Offices have [...] much better resources to do searches of patent and scientific literature than entrepreneurs”.

The Australian Group mentions that *“As part of its examination process, IP Australia already conducts comprehensive searches for relevant prior art, including search results and examination reports from IP5 offices. Therefore, requiring applicants to do the same is unnecessarily duplicative”.*

The Danish Group mentions that *“it would be wrong to involve the applicant in considerations concerning which prior art it would be relevant to highlight and evaluate as part of assessing the patentability of a patent application (or a granted patent). It is only the patent authority that can grant a patent and therefore it is by definition only the patent authority that knows what may be patented and therefore what prior art it would be relevant to include as part of this assessment. Obviously, a line must be drawn in relation to actual defrauding of the patent authority (by misrepresentation etc.), but this would already be covered by existing criminal laws.”*

The Portuguese Group mentions that *“[a]s the INPI performs examination to all patent applications and utility models, a prior art check is already made.”*

The Spanish group mentions that *“it should also be considered that applicants already pay fees to patent offices that have the necessary expertise, means and experience to identify the potentially relevant information for the purposes of patentability of a given invention. That is why we understand that the burden on the need to identify and describe the most relevant prior art should fall primarily and eminently on the patent offices, being nevertheless demandable to the applicant an active collaboration with such offices for the referral of certain documents of parallel proceedings in other jurisdictions as long as those documents are not easily accessible to the patent offices.”*

However, the Latvian Group underlines that *“[t]he absence of examination for novelty and inventive step by the Patent Office might make a duty to disclose prior art even more critical for Latvia. Such a duty could serve as a form of self-regulation by applicants, encouraging them to ensure their inventions truly are novel and inventive.”*

- 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?**

15 Groups answers YES to this question (35%).

The Spanish Group suggests that IP offices should consider the creation of a worldwide database, in which they could share the results of the searches they perform, making them available for other IP offices. The development of such database is also supported by the Finnish Group.

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The US Group makes proposals in order to improve and enhance the duty of disclosure, such as (i) to make clear which employees of an applicant should have a duty to disclose, or (ii) to clarify the definition of the expression “prior art that the applicant *should have known*”. The Turkish Group also underlines the need of Guidelines defining the formal requirements regarding disclosure of prior art.

The UK Group suggests that *“upon application to the Comptroller and with consent of the patentee, third parties could be permitted to submit prior art not previously considered in support of an opinion on validity. Such opinion could be privileged and confidential, and therefore not disclosable in subsequent litigation”*. This proposal aims *“at giving third parties the opportunity to settle potential validity disputes outside litigation. Such policy reverses the onus of disclosing prior art onto third parties who wish to dispute the validity of an application without burdening patent applicants”*.

Several Groups, such as the Indonesian, Belgian and Brazilian Groups, suggest introducing a disclosure obligation for companies seeking to apply for patents for inventions that are “materially/directly based on” genetic resources (GRs) and/or associated traditional knowledge (TN). However, the Japanese Group is opposed to the implementation of such an obligation.

III. Proposals for harmonisation

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

All Groups answered this question.

An overwhelming majority of the Groups (32 Groups, 80%) considers that harmonisation is desirable in general.

The vast majority of the Groups (33 Groups, 85%) considers that a disclosure requirement is desirable, but only at the time of the patent application filing.

The majority of the Groups indicates that a broader disclosure requirement would be excessive and put too much burden of information disclosure on the applicant.

For instance, the Japanese Group indicates that *“if it is necessary to disclose information spontaneously and, in all cases, an excessive burden will be placed on the applicant/patentee. For example, the applicant/patentee will be required to collect (and, if needed translate) prior art references, at any time when he/she becomes aware of such information disclosed during prosecution in other countries. Thanks to the development of the internet environment in the information society, the IP offices have sufficient capacity to collect such information”*.

- A minority of Groups considers that no disclosure requirement is desirable.

For instance, the Australian Group considers that such requirement would introduce unnecessary complexity and would increase costs associated with the patent application process, for the following reasons:

- Identifying relevant prior art can be challenging for applicants.
- The obligation to search and disclose all relevant prior art would impose an additional burden on applicants in terms of time and financial resources.
- IP offices already conduct comprehensive searches for relevant prior art.

Furthermore, several Groups, such as the German or Swedish Groups, see more benefit in increased collaboration and data sharing among patent offices, in order to conduct efficient prior art research. In the same vein, the Belgian Group indicates that *“one can explore the possibility of developing an AI-powered patent prior art global search engine. This tool could be administrated by WIPO”*.

Some Groups advocate for a broader disclosure requirement, such as the US Group which states that *“material information known by the inventor/applicant should be provided to the patent office to ensure thorough examination and quality patents. Efficiency and quality would be improved if the same standards were applied in all jurisdictions”*.

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?**

An overwhelming majority of the Groups (33 Groups, 85%) answered YES to this question.

- b. **at the time of post-grant proceedings (e.g., opposition, re-examination, reissue, post grant review, *inter partes* review)**

A minority of the Groups, albeit a significant one, (9 Groups, 25%) are in favour of a disclosure requirement at the time of post-grant proceedings.

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

A minority of the Groups, albeit a significant one, (9 Groups, 25%) supports a disclosure requirement at the time of a proceeding before a court, e.g. where discovery exists. For instance, the UK group considers that *“in litigation, we consider that all relevant information, whichever form it takes, should be made available if it falls within the relevant disclosure requirement, which should be reasonable and proportionate and relevant to the issues in dispute so that parties not be*

unreasonably burdened by disclosure requirement.” The US group considers that “a duty of candor should apply to representatives who appear before a court.”

The French group considers that *“an obligation to disclose should only exist in application of (i) a court decision or injunction, or (ii) existing principles of civil procedure, such as the duty of loyalty or the prohibition on contracting oneself to the detriment of others (estoppel), assessed on a case-by-case basis (in concreto)”*.

d. at any other time.

Two Groups answered yes to this question, but without giving concrete examples.

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.)?

Half of the Groups (20 Groups, 50%) considers that the disclosure requirement should be spontaneous.

However, almost the other half of the Groups (18 Groups, 45%) advocate that the disclosure should be only in certain circumstances, e.g., when ordered by an IP Office or Court.

Some Groups (6 Groups, 15%) expressed the view that they would prefer disclosures be made only voluntarily. For example, the Australian Group proposes that voluntary disclosure would effectively streamline the patent application process, reduce the burden on applicants, and avoid situations of unintentional/intentional omissions and inaccuracies in such disclosures.

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 common view expressed by multiple Groups is that disclosed materials should only include that which is public, relevant to the invention, and known to the person who bears the burden to disclose.

Many Groups indicate that the patent offices should be entitled to request the applicant to submit information on prior art cited by other IP offices or by third parties during the examination of applications in other jurisdictions (see for instance the French, German, Spanish, Swedish Groups).

a. all documentary patent prior art.

The majority of Groups (23 Groups, 60%) considers that all documentary patent prior art should be disclosed.

b. all documentary non-patent prior art.

Almost half of the Groups (17 Groups, 45%) considers that all documentary non-patent prior art should be disclosed.

c. related patent application filings, *i.e.* continuation-in-part application, divisional applications, continuation applications.

A minority of Groups, albeit a significant one (13 Groups, 35%), considers that related patent application should be disclosed.

Some Groups raise the consideration of whether the filings were related but not part of the same family, and whether the filings were by part or all members of the inventive entity.

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)?

A minority of Groups, albeit a significant one (11 Groups, 30%), considers that patents applications covering the same invention in other jurisdictions should be disclosed. For instance, the Dutch Group indicates that the duty to disclosure should be *“limited to an invitation to provide a copy of the prior art search report carried out by the authority with which the priority application was filed”*.

The US Group raises the distinction that published applications that do not share the same priority claim and would qualify as prior art should be disclosed.

e. any information other than a patent application (products, photography, invoices, statements, information on internet, traditional knowledge, genetic resources, information about prior uses etc.)

A minority of Groups, albeit a significant one (10 Groups, 25%), considers that any information other than a patent application should be disclosed.

f. any other information.

Eleven Groups (30%) state that other information may need to be considered, *e.g.*, in the case of broadened scope of the patent application claims.

Some Groups are concerned about potential for inadvertent disclosures of trade secrets and unpublished materials.

- 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.?**

A large majority of the 36 Groups answering (25 Groups, 70%) considers that the disclosure requirement should concern all information that may affect the validity of the patent application.

Some of the Groups agreeing qualify their answers stating that the disclosure should qualify as prior art (date, relevancy, *et al.*), known to the applicant (at the time of filing, at all times), and/or not be unduly burdensome to the Examiner (*e.g.* a large amount of cumulative material).

Some Groups distinguish the need for disclosure to patent office vs. court, expressing that the disclosure requirements to a patent office should be limited in scope, whereas the disclosure requirements to a court should be broader. For example, the UK Group proposes that the disclosure requirement to a court should encompass all information that could affect validity, where invalidity is pleaded and disclosure would be reasonable and proportionate.

- 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?**

Of the 34 Groups answering, a large majority (26 Groups, 75%) state that **no** level of analysis should be required to satisfy the duty to disclose. The Groups explain that the applicant should be exercising due care to submit only those documents which they **subjectively consider** are **potentially relevant**.

Placing the bar at the level of **subjective potential relevance, i.e. an arbitrary decision by the applicant**, has a number of consequences:

- It is very difficult to sanction non-compliance with subjective disclosure requirements, because the applicant can always say that subjectively they did not think that documents were relevant.
- It is very difficult for the applicant to later argue that documents disclosed were not in fact published, and are not prior art, because at the time they were disclosed the applicant subjectively considered them to be prior art.
- The public benefit of subjective disclosure is unclear. Some patentees may disclose no documents whatsoever and others might disclose more, but there is no reliable consistent basis on which the examiner's understanding of the state of the art can be improved.
- When there cannot be any sanctions for non-compliance, applicants will be incentivised to spend as little as possible on disclosure of prior art, and consequently the objective of improving the examiner's understanding of the state of the art may not be achieved.
- Even requiring disclosure of publicly available documents within the actual knowledge of the inventor(s) at the time the invention is sought is not entirely problem-free, since it will also be necessary to subjectively decide if those

documents are potentially relevant.

A minority of the Groups (7 Groups, 20%) propose that **some** level of analysis should be required but were not in agreement as to what level of analysis should be required. However, setting an objective level of analysis also has consequences:

- It obliges applicants to commit more resources to the patent application process, when arguably the patent office examination should identify the documents relevant to the state of the art (and usually this is done very well by patent offices, rendering the applicant's expenditure on this aspect potentially unnecessary).
- It is very difficult to define exactly what objective test should be applied, and this may be the reason why the 20% of Groups that attempted to do so were not in agreement.
- Sanctions for non-compliance will be very difficult to apply since non-compliance may only come to light several years later when prior art is discovered that should have been disclosed during the application stage.

Accordingly, finding a balance between these two extremes will be a key aspect to be considered.

Some Groups propose that an applicant explains the features in common between the claimed invention and the prior art, while others propose that entire prior art documents be summarized with a highlight of the similarities and differences, and another suggests limiting the requirement for a formal legal opinion to litigation proceedings. For instance, the US Group proposes that the level of analysis should be *"sufficient for the decision-maker to make a good faith determination that the information need not be disclosed."*

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

A majority of the Groups (21 Groups, 60%) considers that a translation should be required.

Some Groups consider that the translation should only be provided if requested by a patent office or a court.

Other Groups emphasize that the translation should be done of only the relevant portions of the document and be provided as an informal translation.

A significant minority of the Groups (15 Groups, 40%) argues that no translation need be required. Reasonings for such stance include the consideration that (i) the patent offices and courts are able to produce their own machine-translations of documents, and (ii) requiring translations may create an undue burden on applicants, and increase costs.

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

A majority of Groups (25 Groups, 70%) state that there *should be* exceptions to disclosure requirements.

The exceptions most commonly proposed were:

- publications and any other disclosures made during a grace period;
- publications after the claimed priority date;
- publications excluded from state of the art; and
- trade secrets.

- 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?**

A large majority of the 36 Groups responding (27 Groups, 75%) considers that the information communicated to the IP office and/or courts should be made available to the public.

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

An overwhelming majority of the 36 Groups responding (29 Groups, 80%) considers that the reason why a particular piece of art is disclosed should NOT be binding.

Since a majority of Groups consider (see 26 above) that grace period publications should be exempted from disclosure requirements, and a majority of Groups also consider that the disclosure of a document is not binding later in relation to its relevance, it would appear that a majority of Groups take the view that even if a document is disclosed and therefore ostensibly does not benefit from a grace period, an applicant should be permitted to claim later that the disclosed document does benefit from a grace period.

There are obvious issues with legal certainty in the above example, if third parties rely on the disclosure of a document as an indication that there will not be a later claim that the document benefits from a grace period.

The person who should have the burden of disclosure

- 29) **Who should be required to disclose such information:**

- a. **the inventor?**

Only a very small minority of the 36 Groups responding (2 Groups, 5%) agrees

that the inventor should be required to disclose such information.

b. the applicant?

An overwhelming majority of the Groups responding (34 Groups, 95%) agrees that the applicant should be required to disclose such information.

c. assignees?

No Groups appear to agree that assignees should be required to disclose such information.

d. licensees?

No Groups appear to agree that licensees should be required to disclose such information.

e. any other person (e.g., patent agent, employees, etc.)?

Without directly answering c., and d. above, some Groups express that the person having the duty should be the person substantively involved in the preparation or prosecution of the application – otherwise, creates undue burden for the applicant to enquire as to the knowledge of multiple entities.

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?

An overwhelming majority of the 36 Groups responding (31 Groups, 85%) advocate that only actually known information should be disclosed, not information that the person should have known. Consequently, the person having the burden of disclosure should not have a duty to conduct a prior art search.

Five Groups (15%) responding differentiated when the “should have known” level is to be imposed, e.g., in litigation, or when equivalent to gross negligence.

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

A large majority of the 36 Groups responding (26 Groups, 70%) considers that the person who has the burden of disclosure should NOT be required to identify or describe relevant or material portions of the document that is disclosed.

Indeed, such requirement is believed by many Groups to create undue burden on applicant, while other Groups believe that the patent offices and courts should carry out such determinations.

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)?

A vast majority of Groups agrees that if there is a requirement for disclosure, then there should be clear, objective regulations identifying the exact parameters of the requirement.

It is generally considered that in case of non-compliance, the patent office should request the applicant to comply with disclosure requirement, *i.e.* there should be at least an opportunity to cure the breach.

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?

The Groups differ in identifying consequences for non-compliance.

The consequence supported by a slim majority of Groups (22 Groups, 55%) for non-compliance with the duty of disclosure - after an opportunity to cure the breach - is the discontinuation of prosecution, *i.e.*, the application should be deemed to be withdrawn. For example, when an IP Office requests prior art disclosure by an applicant, and the applicant fails to comply with the request, then the application should be deemed withdrawn.

For instance, the Indian Group states that *“the consequence of non-disclosure may be revocation of patent or failure to grant an application”*. The Turkish Group considers that *“the application should be deemed to be withdrawn”*.

The US and Israeli Groups consider that the patent should be unenforceable if there is an intentional failure to comply with disclosure requirement.

The Brazilian Group considers that the consequence should be *“(1) precluding the applicant or practitioner from submitting documents and/or arguments contesting the prior art in question; (2) affecting the weight given to the prior art in question; or (3) terminating the proceeding in the Patent Office”*.

IV. Conclusions

An overwhelming majority of the Groups (80%) considers that harmonisation regarding a requirement to disclose information is desirable. However, a majority of Groups consider that disclosures should only be made during the patent application process, *i.e.*, in prosecution with the respective IP Office.

Whilst there is significant agreement on which prior art documents should be covered (the consensus appears to be that at least *actually known patent documents* should be disclosed), there is less consensus on how “relevance” should be determined. This is a key point: the Groups stress the importance of maintaining a balance between the burden placed on the applicant having to



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assess the relevance of documents vs. the amount of information regarding the state of the art that is made available to patent offices. The majority supported exempting publications during a grace period from disclosure requirements.

A key issue that emerged is that a balance needs to be struck between a disclosure requirement based on solely subjective assessments of relevance vs. an objective but difficult to define standard.

The Groups were relatively evenly split on whether translations of disclosed documents should be furnished (the accuracy of the translation becomes an issue if translations are required).

In relation to sanctions for non-compliance, there was broad support for an opportunity for the patent applicant to cure non-compliance with further disclosures. Non-compliance with such requests to cure should, in the opinion of a slim majority of Groups, result in a deemed withdrawal of the application.

There was no majority support amongst the Groups for the approach to disclosure taken in the recent WIPO Treaty on GRTK.