

QUESTION 98

Early publication and provisional protection of patent applications

Yearbook 1991/I, pages 289 - 290
Executive Committee of Barcelona, September 30 - October 5, 1990

Q98

Question Q98

Early publication and provisional protection of patent applications.

Resolution

A. Having regard to the fact that any governmental publication of the application makes available the technology of the invention to everyone, AIPPI recognizes that from the date of such publication the applicant should enjoy protection against acts falling within the extent of protection of the published application insofar as such acts also fall within the extent of protection of the ultimately granted patent, in particular including:

- 1) Right to initiate court proceedings before grant of the patent;
- 2) Right to seek an injunction in countries with a pre-grant opposition procedure, from the date of publication of acceptance of the application;
- 3) Right to the same monetary remedy as for infringement after grant from the date on which the defendant is given notice of the applicant's allegations against him;
- 4) Right for at least one year after date of patent grant to seek monetary remedy under point 3, notwithstanding any statute of limitation;
- 5) Right to obtain accelerated prosecution of the application where infringement is alleged;

B. The foregoing rights of the applicant shall be balanced by rights safeguarding the position of the defendant, in particular including:

- (a) Right to seek to stay court proceedings until grant or, in countries with a pregrant opposition procedure, until the date of publication of acceptance of the application,
- (b) Right to obtain accelerated prosecution of the application.

Comments to wording of Art. 23 paragraph 2 of Patent Law Harmonization (WIPO Documents HL/CE/VIII/3 and HL/CE/VIII/12)

Paragraph 2 a):

- Instead of a discussion on the meaning of "reasonable compensation" and "full damages" the same monetary remedies should be provided for the pre-grant stage as each of the Contracting Parties provides for an infringement of a granted patent. In accordance with (ii), such monetary remedy shall only be available from date of notice of infringement.
- All the formal conditions such as the requiring of translations should not be contained in the Treaty but left to National Law.

Paragraph 2 b):

- The wording in VIII/12 seems to be more appropriate than that of VIII/3.
- The following further minimum rights should be added:
 1. Countries should accept filing and serving of a court action already at the pregrant stage.
 2. Examining countries should introduce a system of truly accelerated prosecution of applications which are allegedly the subjects of infringement.

Paragraph 2 c):

- the wording of VIII/12 refers to all types of claims the court can decide upon and therefore is preferred.
- The term "grant of a patent", in countries with a pre-grant opposition procedure, should be changed to the earlier date of "publication of acceptance of the application".

Paragraph 2 d):

- While the first part of VIII/3 (to the words "patent granted" in line 4) will be evidently covered by national law, the last part (last line) seems to be dangerous because the rights should not be limited to identical claims but to the same invention being protected.
- The second sentence of the text of VIII/12 should be rejected because it covers any revocation procedure of any third party even 10 years after the court decision has become final. Here the principle of "res judicata" must apply.
- If something has to be said in this regard then it should be the opposite, namely that once a judgement has become final it should not be possible to reopen it at any future time. We believe in the wisdom of courts to stay proceedings or to make a thorough evaluation before letting a judgment become final.

- By "retroactive effect" it is usually meant that payments made have to be returned. We do not think that such obligation must be forced on countries since all countries have already in place a set of rules covering such circumstances (patent infringement action plus subsequent invalidation of the patent).

* * * * *