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Prior Rights

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Since the US changed their patent law in 2013, the first-to-apply principle applies virtually all throughout world. That is, if two inventors independently invent the same thing, the one to first deposit the invention at the office receives the patent; it does not matter who conceived of it first.

If one application is filed very shortly after the other, a special situation may arise which involves a socalled "prior right".

Example: Mr Early applies for a patent for his invention on January 1, 2020, and keeps the innovation secret from then on until he finally goes public with a product one year later. In his application, he discloses the general idea but does not describe how to implement the invention in an economically efficient way.

Mr. Late discovers the same invention independently of Mr Early. However, he still elaborates a more advanced embodiment of the invention before applying for a patent in June 2020. Unlike Early, he describes his embodiment in the application document.

The obvious question is: who receives a patent and for what?

In principle, of course, the same invention should be prevented from being the subject of two distinct patents. To uphold said principle, there are different approaches at the legal level. As a result, the consequences for Mr Early and Mr Late may differ from country to country.

Werner A. Roshardt

"You think of yourself as the first, the only one. If you are the only one, how could you be first? If you are the first, how could you be the only one?"
Moritz Gottlieb Saphir (1795-1885)

Two Distinct Approaches

	Prior Claim Approach	Key Points
How does the „prior claim“ approach prevent double patenting?	In this approach, the earlier claim is determinant: Mr Late can no longer protect what Mr Early has claimed his application. But features Early has only described, but not named in the claims, may still be claimed by Late. This approach seems to be a perfectly fitting solution to the problem of double patenting. However, in practice it is often difficult to determine what exactly is contained in the description but not in the claims of Mr Early’s application. A fundamental disadvantage of the prior claim approach results from the fact that the examination of Mr Late‘s claim cannot be carried out until the examination proceedings for Early’s application have been completed and his patent has been granted. This may take several years.	> Mr Late cannot protect the same combination of features as Mr Early > If Mr Early withdraws his application before the patent is granted, Mr Late may receive full protection of his invention > In any case Late can protect his particular embodiment

	Whole Content Approach	Key Points
How does the “whole content” approach, where the entire content is considered, work?	In the case of the „whole content” approach, the examination of Mr Late‘s application considers the entire content of Mr Early‘s published application. What Mr Early has disclosed in any way, Mr Late can no longer protect for himself. However, if Early’s application does not reach publication in the first place, Mr Late can protect the invention for himself. When applying the “whole content” approach, the examination of Mr Late‘s application can be carried out immediately after Mr Early‘s application has been published, meaning Late’s application is not stalled until the completion of Early’s grant proceedings. This approach also ensures that the same invention cannot be patented twice. In addition, however, this approach has the effect that nothing disclosed in Mr Early’s application can subsequently patented by Mr Late, even if Mr Early did not want to protect everything he disclosed.	> Mr Late cannot protect the same combination of features as Mr Early > Mr Late cannot protect features described by Mr Early either, even if the latter didn’t claim them

Particualirities of the “Whole Content” Approach

Exception “Examination of Novelty”

Is the prior right cited to the later applicant just like prior art?

Since Mr Late could not have possibly known about the unpublished application of Mr Early, it seems unfair to treat Early‘s application like prior art.

One of the compromises envisaged in certain countries is that Mr Late’s claims must be novel, but not necessarily inventive, compared to the overall content of Mr Early’s application.

Late’s patent claim is therefore only rejected if its technical features are contained in identical form in Mr Early‘s application. Even a slight difference is enough to uphold Late’s claim. Again, this difference does not need to be inventive.

The above approach is applied by the European Patent Office. The US Patent Act on the other hand states that the earlier application must also be taken into account when examining the inventive step. This means that Mr Late’s claims must keep an “inventive distance” from Mr Early’s pre-existing patent rights.

Key Points

- Prior right is only considered for the examination of novelty of the second application
- A non-inventive difference is enough to distinguish the second application from the first one
- Examination approach applied by the European Patent Office

Exception “Identity of Applicant”

Is there protection against one’s own prior rights?

The „whole content“ approach favours Mr Early depending on how comprehensively he discloses his ideas in the application. The more embodiments are included, the tighter the gaps for Mr Late become.

However, this is a double-edged sword. If Mr Early files his application in the course of active development and after a few months comes up with an additional feature, his own application could be his downfall.

Such a situation is remedied by the provision: „prior rights are only cited if they are not from the same applicant“, which is applied e.g. in the US.

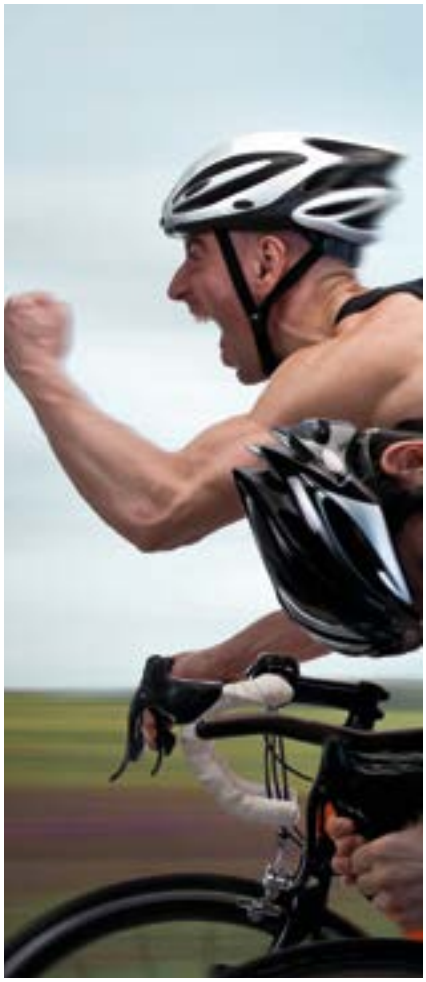
Key Points

- US and various other countries apply the “identity of applicant” exception
- No such exception exists in European patent law
- The exception has different characteristics depending on country

Practical Tips

Strategies

Which strategies lead to success involving prior rights?



In most cases it is valuable to have an application that not only has a broad scope, but also includes a lot of detail. A few thoughts on our example:

In Europe, Mr Late may obtain a patent that bears great similarity to the one held by Mr Early. The more banal details he includes, the greater the chance that Early has not described one of them. A single trivial detail can be used by Mr Late to distinguish his application from the earlier one. His patent can be a problem for Mr Early if this banal feature is needed in all reasonable implementations, it would give rise to a stalemate: Mr Early cannot use his invention because Mr Late has protected the indispensable „detail". And Mr Late is prevented from using his invention because Mr Early holds the rights to the foundational idea. On the flipside,

if Mr Early not only includes his envisioned embodiment, but also a diverse set of variants in his application, he makes it more difficult for Mr Late (especially in the USA) to achieve anything with a subsequent application. This is because Mr Late must be an inventive step away from all the embodiments disclosed by Mr Early.

The prior claim approach is relatively rarely used today. One of the notable exceptions is prior right in German utility models. In the kind of parallel application scenario we've described previously, it is often possible to break through the legal blockade by "splitting off" parts of the model.

Key Points

- Protect against "subsequent patenting" by providing many different embodiments
- Protection from prior right through "banal details"

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Keller & Partner Patentanwälte AG

Eigerstrasse 2
CH-3007 Bern
Phone: +41 31 310 80 80

Bahnhofplatz 18
CH-8400 Winterthur
Phone: +41 52 209 02 80

info@kellerpatent.ch
www.kellerpatent.ch

K&P Patentanwaltsges. mbH

Ludwigstrasse 8
DE-80539 München
Phone: +49 89 54 80 3737

info@kppat.com
www.kppat.com