



Update on SPLH

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Grace Period

- Grace Period (GP) is a key component of the SPLH package
- A basic consideration, with broad consensus, is that GP should be kept as a « safety net » only
 - Balanced by Strong Prior User Rights and/or Statement
- More recently, development of another consideration : « early publication »



Early publication

- Not discussed in the JPO study, or in the EPO consultation
- Has been included in the positions and submissions of some organisations
- FICPI has considered this issue



Early publication

Benefits anticipated

- Early visibility of applications for third parties
 - Reducing uncertainty
 - Easier to clear Freedom to Operate
- An additional burden on the applicant and therefore reinforcement of the « safety net » only aim



Early publication

Challenges 1/2

- In some cases, early publication would occur during the priority period
 - Where a convention country has not adopted a grace period, this early publication generates prior art against any later application filed under priority
 - possibly deprive applicant from protection of improvements brought in the later application
- Significant risk of “Overpublication” - the patent application which is published early will likely include more subject matter than the Pre-filing disclosure (PFD)
 - For example, claims language, generalisations, additional examples
 - What benefit does this have in the patent system?



Early publication

Challenges 2/2

- How practical is early publication?
- Would require publication of “provisional applications”
- Results in moving forward of formality checks and deadlines for fixing, e.g. inventor details, drawings
- Results in publication deadlines just after filing, for example, a PCT



Early publication and statements

- Without a requirement for early publication, need for mandatory statement is alleviated
- We consider that a mandatory statement has drawbacks
- However, we consider that a voluntary statement remains a useful provision
 - after filing a statement there should be a presumption that the PFD is graced



Mandatory Statement Challenges

- What is a disclosure?
 - Not straightforward aside from real publication
 - Scope of Oral disclosure?
 - Was disclosure confidential?
 - Different rules in different jurisdictions, e.g. recent EPO Enlarged Board Referral G1/23
- “Overdeclaration” - declaring (and thus disclosing) information that would otherwise have been confidential
- “Trap” effect – what happens if an applicant inadvertently misses a declaration or misses a disclosure from a declaration
- More litigation – higher cost of IP system



Next steps for FICPI

- Substantive work still needed
 - i.e. on issues with divergence noted in the “Comparative Analysis of the Results of the National Consultations on Users proposals on SPLH”
- FICPI will continue its work on this front
- Survey to FICPI clients for their feedback on critical issues