

Congress Milan 2016
Adopted Resolution
September 20, 2016

Resolution

Publication of Patent Applications

Background:

- 1) This Resolution concerns the issue of publication of patent applications.
- 2) AIPPI studied the publication of patent applications in Q89 – "Harmonisation of certain provisions of the legal systems for protecting inventions" (Amsterdam, 1989) in connection with a series of resolutions related to a WIPO draft Patent Law Treaty concerning the harmonization of substantive provisions of patent law that never became final. AIPPI also studied early publication and provisional protection of patent applications in Q98 (Barcelona, 1990).
- 3) Due to, *inter alia*, the international nature of patent law, legal certainty, and the practical functioning of the patent system, it is important that the procedures concerning publication of patent applications and the impacts thereof are uniform in different jurisdictions.
- 4) The Standing Committee on Patents circulated a questionnaire leading to this Resolution which focused on automatic publication of patent applications; the impact of withdrawal, abandonment, or rejection of patent applications prior to publication; and the possibility of early publication of patent applications and exceptions to publication.
- 5) For the purposes of this Resolution:
 - a) **proposed publication date** means the date on which the patent application is intended to be published as notified by the patent authorities to the patent applicant;
 - b) **publication preparation due date** means the latest date before the proposed publication date on which it is practically possible for the applicable patent authorities – taking into consideration the technical requirements for publication – to accept amendments to the information concerning patent applications in order for such information to be included in the publication to be published on the proposed publication date;

- c) **withdrawn**, with respect to a patent application, means that the patent applicant has submitted a request for final withdrawal to the applicable patent authorities;
 - d) **abandoned**, with respect to a patent application, means that the patent application has been abandoned and the abandonment has become final; and
 - e) **rejected**, with respect to a patent application, means that the patent application has been rejected and the rejection has become final.
- 6) 39 Reports were received from AIPPI's National and Regional Groups providing detailed information and analysis regarding national and regional laws relating to this publication of patent applications. These Reports were reviewed by a Working Group of the Standing Committee on Patents and distilled into a Summary Report. See below links.
- 7) At the AIPPI World Congress in Milan, the subject matter of this Resolution was further discussed in a full Plenary Session, which led to the adoption of the present Resolution by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) As a general rule, a patent application should be published 18 months after the date of priority or the date of filing the patent application (hereinafter, the **general 18-month publication date**). When an application is derived from an earlier application, such as a divisional or a continuation application, the application should be published as soon as possible after filing if the earliest parent application has already been published, and if not, then concurrently with the earliest parent application or as soon as possible after the earliest parent application is published.
- 2) The patent applicant should be entitled to request that their patent application be published earlier than the general 18-month publication date. In the event such request is made, early publication should apply only to the patent application in question unless the patent applicant requests that early publication apply to all the patent applications deriving from the same priority application. The date of early publication should have the same legal effect as the general 18-month publication date, including without limitation with respect to provisional protection.
- 3) Patent offices should notify the proposed publication date to the patent applicant at least two months in advance, save in cases where early publication is requested. The publication preparation due date should be no earlier than one month prior to the proposed publication date and no earlier than 17 months after the date of priority of the patent application. A patent application should not be published if it is withdrawn, abandoned, or rejected prior to the publication preparation due date. However, if such patent application serves as priority for a subsequent application, it should in any

case be made available to the public in the file of the subsequent application once it is published.

- 4) If requested by the patent applicant at the time of filing the application and insofar as the patent office of the respective jurisdiction has the practice of providing a search report and a preliminary assessment of patentability, the patent office should provide a search report and a preliminary assessment of patentability:
 - (i) if no request for early publication has been made, prior to, or at the same time as, notifying the proposed publication date; or
 - (ii) if a request for early publication has been made, no later than two months prior to the date which would have been the general 18-month publication date absent the request for early publication.
- 5) Acknowledging the requirements for legal certainty, patent offices should have the right to defer the publication of a patent application beyond the general 18-month publication date if the relevant national governmental officials are reasonably of the opinion that such publication would cause a threat to national security.

Links:

- Summary Report
http://aippi.org/wp-content/uploads/2016/09/SummaryReport_Publication-of-Patent-Applications_NEW_150916.pdf
- Reports of National and Regional Groups and Independent Members
http://aippi.org/committee/?committee_type%5B0%5D=19&status&keyword=patents&search_post_type=committee