

Comparative Foreign Patent Procedure

Introduction

In the last few years, there has been increasing pressure, due to ever-increasing world trade, to update the United States Patent System and to unify international patent procedures. The result of this pressure was the Report of the President's Commission on the Patent System, released on December 2, 1966. This Report was followed by the transmission to the Congress of the Patent Reform Act of 1967, incorporating most of the Commission's proposals to bring the United States Patent System closer to the patent systems of major foreign countries. The Report and the hearings on the bills accompanying the Act have been widely discussed. The passage of the bills, even with many modifications, is not yet in sight. This clearly illustrates the great difficulties encountered in attempting to introduce significant changes in a Patent System.

A broad, a "Patent Cooperation Treaty" has been drafted by BIRPI (United International Bureaux for the Protection of Intellectual Property) in Geneva. The object of the proposed treaty is to facilitate the filing and examination of patent applications for the protection of the same invention in a number of countries. Briefly, the treaty proposes the establishment of a single, international patent application to be filed in, and examined by, the national patent office of the State of which the applicant is a resident. One international filing date would thus be common to all applications, and a single worldwide search would form the basis for examining applications, instead of multiple, national searches. The draft treaty also proposes a second, optional phase involving an international preliminary examination report. The draft treaty, which is still under review by a committee of experts, will eventually be submitted to the nations

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adhering to the International Convention of 1883. Efforts are underway toward the establishment of a European Patent System.

The trend toward unification of international patent procedures is believed to be irreversible. In the meantime, however, patent lawyers have to accept and live with the fact of all the different national patent systems.

Patent practice abroad is quite different from patent practice in the United States. It is, therefore, essential to know as much as possible about the comparative patent systems of foreign countries in order to take full advantage of the patent protections available. Also, one cannot work on a case as part of an efficient team with a foreign patent agent, without having at least a general knowledge of the patent practice in the foreign country.

Patentwise, the various countries of the world may be divided into two main groups: the examining countries and the non-examining or registration countries. The present article will follow this division. The first part will deal with the examining countries and the second with the non-examining countries. The third part will deal with the questions of procedure abroad with the subject matter of continuation-in-part applications and of patents of addition. The subject of petty patents and Utility Models, which provide a limited protection for mechanical devices or articles in some countries, such as, Germany, Japan and Spain, will not be discussed in the present article; nor will that of patents of importation.

It must be stressed that only general outlines will be found in this article, and that frequently broad statements will be made covering the practice in several countries, without going into explanations as to how these statements should be modified to conform more nearly to the particular patent practice of one or another of the countries.

Also, the present article will not deal with the Sino-Soviet bloc countries, because of the small volume of patent work done with them by patent lawyers in the United States. Comparative treatment will be given to only those countries in which patent applications are more usually made.

I. Examining Countries

Each country, of course, has its own patent law. However, the different concepts of patent protection may be classified broadly into three main systems, and each of the examining countries may be said

to adhere to one or another of these systems, naturally not without many variations which make it, in every case, a national system.

For the sake of clarity, the three main systems will be designated as follows:

1. THE AMERICAN SYSTEM
2. THE BRITISH SYSTEM
3. THE GERMAN SYSTEM.

Canada, the Philippines and the United States adhere to the American system.

Adhering to the British system are: Australia, Great Britain, India, Ireland, Israel, New Zealand, South Africa and, generally speaking, the "Commonwealth countries" except Canada.

The following countries have adopted the German system: Argentina, Austria, Brazil, Chile, Denmark, Finland, Germany, Iceland, Japan, Mexico, the Netherlands, Norway, Sweden and Switzerland. (In this latter country only the applications directed to inventions relating to the textile and watch-making industries are examined as to novelty for the time being).

The American System

Little will be said here of the American system, since the present article is written for American patent lawyers. With this objective in mind, the following general comments may be made when comparing this system to the other two:

(a) *The description*: in general, the description of an American patent is much more detailed than that of foreign patents. For example, in a chemical patent, it is not necessary abroad to list exhaustively all the chemical compounds belonging to the same generic class; it is enough to enumerate a few preferred compounds as examples of the generic category. Also, a multiplicity of specific examples illustrating the use of the same compounds, with minor variations in the amounts, will be considered repetitious and unacceptable abroad. On the other hand, if a broad range is disclosed and claimed, it must be supported fully by the examples, in order to be patentable abroad. For example, in the case of a composition comprising homo- and copolymers of mono-alpha-olefins having from 2 to 10 carbon atoms, the description must not only mention several polymers having different numbers of carbon atoms within this range, but there should be one example for each composition containing one of these different polymers.

In mechanical cases, lengthy descriptions and/or drawings relating to known parts of an apparatus will not be accepted, for example, a known electric or pneumatic circuit actuating a novel part of the apparatus.

Another essential difference is that in the American system, the description cannot be amended except in the case of requirements of form or of obvious clerical mistakes. "New matter" cannot be added to the specification, and the United States Patent Office is very strict in interpreting this rule. Thus, if "new matter" has to be added, the only recourse is the filing of a continuation-in-part application or of another independent application. This procedure is strictly American. By contrast, in other examining countries, because the description must be in complete agreement with the wording as well as with the scope of the allowed claims, amendments in the description, sometimes quite substantial, such as the insertion of additional examples, inevitably follow amendments in the claims during the examination of the application. This procedure will be explained later in some detail.

It must be stressed again that the division of the examining countries into three main concepts or systems is very broad. For example, in the American system, while both the United States and the Philippines have interference proceedings, Canada does not have such proceedings, but does have conflict proceedings. However, these different proceedings stem from the same concept: that an inventor, within certain limits, is entitled to priority for his invention as of the date of conception or reduction to practice thereof, provided he can prove it. By contrast, in the other countries, either examining or non-examining, the only priority which an inventor may claim for patent protection for his invention is that of the date of filing a patent application describing it.

Continuation-in-part (CIP) applications may be filed in the United States and in the Philippines, but not in Canada where patent practice allows filing of a supplementary disclosure which is not quite the equivalent of a CIP application. On the other hand, more amendments in the description are permitted in Canada than in the United States or in the Philippines.

(b) *The claims:* the wording, the presentation, the numbering and the dependency of the claims are similar in the three countries. A multiplicity of independent claims, each one of them either followed or not by a set of subclaims dependent thereon, is permitted, each subclaim being dependent on one claim only. (Although there have

been indications recently that the attitude of the United States Patent Office toward the dependency of the claims might change, dependency on several claims is now permitted, as an experimentation.)

For example, in an application claiming a process and an apparatus, an American-type set of claims may contain several independent process and apparatus claims. Such a set of claims will invariably be rejected by the examiners in the countries adhering to the other systems, on the ground of lack of unity of the invention; and some of them will request the filing of divisional applications corresponding to the "separate inventions" claimed in the independent claims. This rejection is easily overcome by drafting a new set of claims according to the patent practice of the foreign country.

The claims in the countries which have adopted either the British or German system have this common characteristic: there can be no more than one independent or main claim per invention. In the case of an application covering an article for example, a process for producing the article, and an apparatus for carrying out the process, only one main or independent claim will be allowed for the article, for the process and for the apparatus.

Each claim may be followed by a set of subclaims which may be dependent on the main and/or on one or several of the subclaims. Each set of claims should be somewhat like an inverted pyramid, the first claim being the broadest and the subclaims becoming narrower and narrower in scope.

Another characteristic common to the claims of the British and German patent systems is that the wording should generally be more specific than the wording of American claims. For example, expressions such as "about" may not be used. In article or product claims, statements as to the improved characteristics of the products are unacceptable, such as "A high strength, high temperature refractory . . . article . . . having an increased Young's Modulus and breaking strength . . ." These characteristics belong to the description, among the objects achieved by the invention. An acceptable foreign-article claim should read, for example: "An improved . . . article . . . having a Young's Modulus of more than . . . (specific figure) and a breaking strength of more than . . . (specific figure)."

The same rules apply to process or method and apparatus claims. Process claims should not contain any structural terms; this is especially true when an application contains both process and

apparatus claims. Many examiners will then reject such process claims on the ground that they are no more than instructions for operating the apparatus, or at best that the invention resides solely in the apparatus, since it seems to be the only means of carrying out the process as claimed.

(c) *The statement of invention:* this important matter will be dealt with in the present chapter because the same general rules apply to British-type as well as to German-type systems.

In American-type patent applications, there are frequently, in the preamble of the description, several short paragraphs stating in detail the objects of the invention. These statements of objects of the invention are then usually followed by a statement of the invention itself. There seems to be no specific rule as to how this statement of invention should be worded. Sometimes it is expressed in very broad, general terms; sometimes it paraphrases the broadest claim.

It is quite different in the other types of patent practice. After a brief acknowledgement of the prior art, the object of the invention is stated in concise terms, in one or two clear sentences. Preferably, there is one object only; for example, "It is the object of the present invention to provide a method for . . . (or an article so and so) which eliminates the disadvantages of the prior art".

Then comes the statement of invention. The wording of this statement should be the same as the wording of the main claim. It follows that when an application has more than one main claim, the preamble of the description should have as many statements of invention. For example, when an application covers a product, a process and an apparatus, it has three main claims and, therefore, must have three statements of invention worded like the main claims:

"Accordingly, the present invention provides . . . (a product) . . . claim 1.

The present invention also provides a process for producing . . . (the product) . . . which comprises . . . main apparatus claim.

The present invention further provides an apparatus for producing . . . (the product) . . . which comprises . . . main apparatus claim".

The scope of the invention is thus clearly defined. In case of litigation, there will be no doubt that patent protection extends to the product as well as to the process and apparatus. This is extremely important, particularly in non-examining countries like France, for example, where there are no claims, and where the patentee gets protection for whatever is in the description of the invention.

The British System

The British system is closer to the American system than the German system in the sense that extensive amendments in the description, such as the incorporation therein of additional examples, are rarely permitted, the claims do not have a characterizing clause, and several independent main claims are permitted. This latter remark means that in an application claiming a product and a process, the product will, for example, be claimed in a first set, with the main claim followed, or not, by one or more subclaims, then the process will be claimed in a second set, with a main claim followed, or not, with subclaims, and the main process claim does not have to be dependent on the preceding product claims.

When a patent application is sent to foreign agents for filing abroad, it should not be sent in its original United States form. The reasons for this statement are very simple. It should be kept in mind that when a foreign agent receives from a United States attorney an application, all he knows about the invention is what is in the application. He has no background on the invention and no possibility to discuss it with the United States attorney or with the inventor. He can write for some explanations, but usually there is no time for correspondence before the application is due for filing in his country. Therefore, the application should clearly describe and claim the invention. United States claims, to foreign agents, seem obscure most of the time and fail to indicate clearly to them the scope of patent protection sought.

When preparing an application for foreign filing, one has the choice of rewriting the claims in either the British manner or the German manner. Both types of claims are easily adaptable, with a few minor changes, to the patent practices of all the foreign countries. It is probably easier for United States attorneys to draft British-type claims.

As previously explained, the claims must be clearly worded, without functional statements. One skilled in the art is supposed to be able to understand the invention just by reading the claims. The subclaims usually are dependent not only on the main claim but also on one or more of the preceding subclaims, with the consequence that the scope of the last subclaim is usually narrower than the scope of the preceding ones. A British-type set of claims terminates with one or more, as the case may be, omnibus claims: for example: "A

process for . . . (preamble of the main claim) substantially as herein-before described with particular reference to the Examples."

Then the description must be brought into agreement with the claims. The wording of the first paragraph of the description, i.e., "The present invention relates to . . ." etc., should be in agreement with the wording of the preamble of the main claim or main claims. The wording of the title should also be in agreement with the wording of the opening sentence of the description.

The detailed "objects of the invention" are replaced with one or two short sentences.

Then comes the statement (or statements) of invention. The following story will illustrate the importance of the statement of invention:

A United States application described a new process for producing synthetic fibers. The claims were directed both to the process and to the fibers. This United States application, without any amendment, was sent to a British agent for filing in the United Kingdom. The British agent rewrote the claims, British style, with two sets of claims, respectively, directed to the process and to the fibers, in that order, which was also the order of the original United States claims. The agent did not amend the description at all. In the preamble of the description there was a paragraph corresponding to a statement of invention, but worded in very broad terms and referring only to "a novel process." In his first official action, the British examiner cited only one reference which could easily be argued and overcome by amending claim 1, the main process claim. But he raised an objection against the product claims, stating that they should be cancelled, since there was no support for them in the description. In his letter enclosing the official action, the British agent commented on all the objections in the usual manner, suggesting various amendments in the description and claims. Concerning the objection to the product claims, his comment was "may we delete claims so and so. . . ."

The United States attorney responsible for the case merely answered him, to argue the prior art and amend the application as proposed by him. The agent then cancelled the product claims and replaced them with an omnibus product by process claim. The application thereafter duly proceeded to allowance and publication. It was opposed by a competitor. The invention was commercially important. The fibers described and originally claimed in the applica-

tion were novel as well as the process for producing them. The opposer had found a different method of producing the same fibers. The applicant then tried to have product claims *per se* reinstated in the application on the ground that there was support in the description for such claims. The description contained sentences such as "The novel fibers obtained by the process of the invention . . . ". But it was too late because the application had already been published. The applicant had to restrict his process claims in view of the art cited by the opposer and ended up with a valueless patent which left his competitor free to produce the fibers without infringement.

If the application had been correctly prepared for foreign filing, this would not have happened. Both the agent and the examiner would have understood from the description that the fibers *per se* were novel. But after the first official action, the applicant could still remedy the faulty description by instructing his agent not to delete the product claims but to insert in the preamble of the description a second statement of invention corresponding to the main product claim, thereby providing the description with a clear support for these claims.

The agent in this case did his duty. He knew nothing about the invention, except what was described in the application.

One should constantly remember that in the foreign examining countries the scope of the description must be brought into agreement with the scope of the allowed claims, whereas in United States practice only the claims may be amended. This foreign practice seems to me more logical than United States practice.

During the examination of the application, it must be kept in mind that the foreign agent has no background at all about the invention. All he knows about it is what is disclosed in the application. Therefore, unless the prior art cited by the examiner is not pertinent (a very remote possibility), he cannot be expected to handle the case successfully without considerable help from the United States attorney. The latter should not only argue the prior art in detail but should also propose amended claims in his instructions to the agent. Even if the wording of those claims does not quite comply with the patent practice of the country in question, they will indicate to the agent the scope of patent protection desired by the applicant in view of the prior art. The agent will then amend those claims. Preferably only amendments of editorial nature should be left to the discretion of the foreign agent, again not because he is not fully competent, but because he never has the opportunity of discussing the invention with

the inventor and, therefore, is seriously handicapped in fighting for the case.

In preparing a response to an official action, the originally filed foreign claims are amended and renumbered. For example: claims 1 to 3 and 6 will be deleted and replaced with a new claim 1, claims 4 and 5 becoming new claims 2 and 3, respectively.

The examiner may request amendments in the description, such as deletion of unnecessary parts of the description. The initial statement of invention must be brought into agreement with the new main claim, etc. Frequently, the foreign examiner will require clarification of a sentence or of a whole paragraph. This kind of request should always be complied with, even if the foreign examiner could be called "finicky" by American standards.

Once the application has been allowed, it is published and open for public inspection and opposition. The question of opposition will be dealt with in a separate chapter.

The German System

The preparation of an application for filing in the German system countries is basically the same as that for filing in a "British system" country.

The only real difference lies in the claims. If the application covers several "inventions," i.e., process, product and/or apparatus, as in the British system, one main claim will be allowed per invention, with a set of subclaims dependent therefrom. However, there is a very important difference: contrary to a British-type set of claims, the main claims are not independent from each other. All the claims, whether main claims or subclaims, are dependent on claim 1. Consequently, claim 1 should always claim the invention in its broadest form. For example, if the main product claim gives the broadest scope of patent protection, then claim 1 should be the main product claim because the main process claim and/or main apparatus claim will be dependent thereon. The preamble of the main process claim will read: "Process for producing a product (whatever it is called in the preamble of claim 1) as claimed in claims 1 to . . . (whatever the number of product claims is)." The apparatus, if it is claimed, will be dependent on the product and process claims. If the process gives the broadest scope of patent protection, it should be claimed first, and the apparatus and/or product will be tied down to it.

Independent sets of claims within the same application are not

permitted, on the ground that a plurality of inventions is claimed. Obviously, this is another reason why United States claims should always be rewritten before the application is mailed abroad. Otherwise, if the foreign agent is left on his own to prepare the application, he will automatically take the subject matter of the first United States claim as the subject matter of his claim 1. If the first United States claim happens to be an apparatus claim and, if, for example, a process is also claimed, the process will be tied down to the apparatus since the process claims will be dependent on the preceding apparatus claims.

For that reason, even if the United States application is prepared British style, with the possibility of having several independent sets of claims, it is better to begin with the claim giving the invention the broadest scope of protection.

When the German or Swedish agent, for example, receives his copy of the British style application, he will only have to introduce into the claims a characterizing clause and will safely make all the claims dependent on claim 1.

What is the characterizing clause or, rather, how does one write a claim with a characterizing clause?

A German type main claim is comprised of two parts: the preamble in which the prior art is broadly acknowledged, and the characterizing clause, which clearly defines the invention and at the same time differentiates it from the prior art. For example, the invention relates to a process for producing a dyeable linear polyester. The production of the polyester *per se* is known, i.e., for example, by reacting an aromatic dicarboxylic acid and an aliphatic glycol. The invention resides in the addition of a specific compound to the known reaction mixture in order to obtain a dyeable polyester. An American or a British type claim will read:

A process for producing a dyeable linear polyester, which comprises reacting an aromatic dicarboxylic acid, an aliphatic glycol containing . . . carbon atoms and from . . . to . . . mole per cent of a . . . X compound, based on the amount of dicarboxylic acid compound present, said X compound having the formula . . .

A German type claim will read:

A process for producing a dyeable linear polyester by reacting an aromatic dicarboxylic acid and an aliphatic glycol containing from . . . to . . . carbon atoms, characterized by adding to the reaction mixture an . . . X compound in an amount of from . . . to . . . mole per cent based on the amount of dicarboxylic acid compound present, said . . . X compound having the formula . . .

It can be seen that the scope of both types of claims is identical. The same rule applies to product and apparatus claims.

The subclaims also have a characterizing clause. They will read: "A process as claimed in claim 1, characterized in that . . .". The subject matter of the subclaims should relate to the subject matter of the characterizing part of the main claim only, and not to the subject matter of the preamble of the main claim. The examiners in Holland and Denmark are particularly strict in this respect.

During the examination, the original main claim usually has to be restricted in view of the prior art cited by the examiners. In Germany and in the other countries having a similar patent system, the cited prior art is broadly acknowledged in the preamble of the main claim.

Then, the preamble of the application is amended by introducing thereinto one or more, short paragraphs briefly describing every one of the references cited by the examiner, with their disadvantages, which are now overcome by the invention. The original statement, or statements, of invention are reworded to be in agreement with the amended claims. If requested by the examiner, unnecessary parts of the description are deleted or, alternatively, additional examples are inserted into the description and/or additional explanations or clarifications. It must be kept in mind that contrary to United States practice, the scope and wording of the description must be amended and be brought into agreement with the scope and wording of the allowable claims.

With respect to the kind of patent protection afforded by the subclaims, a distinction should be made between the so-called "true subclaims" which relate to a direct development of the subject matter of the main claim, i.e., a preferred material or a specific range, for example, and the subclaims directed to a subject matter independent from that of the main claim, i.e., the apparatus claims, when the main claim is directed to a process. The invalidity of the main claim usually results also in the invalidity of the "true subclaims", while the second type of subclaims is not necessarily invalidated.

In Japan, there are no "true subclaims." If, for example, the main claim (claim 1) is directed to a product, one process claim and/or one apparatus claim are permitted. However, the scope of protection provided by such a limited number of claims is the same as that obtained in other countries where subclaims are allowed. The scope of the claims, in case of litigation, is determined by the scope of the whole disclosure. This is why it is so important for the description to

give full and clear support to the subject matter of the claims, as previously explained.

Oppositions

In most of the countries having adopted the British type or the German type of patent system, the law provides for oppositions to the grant of a patent.

In these countries, upon termination of the novelty examination proceedings and allowance of an application, the complete specification is published in its allowed form and the application is then laid open to public inspection for the purpose of enabling third parties to oppose the grant of a patent on the grounds of lack of novelty, lack of patentability or misappropriation of the invention. The term for filing an opposition varies in each country. It is usually two or three months from the date of publication of the application. In the absence of an opposition within the term, a patent is finally granted.

The grounds on which the opposition is based must be specifically and fully stated within the term. The most usual ground is that of lack of novelty, and it is the only one which will be discussed here. The lack of novelty might be based on prior public use, but more often it is based on obviousness and prior publication, i.e., before the priority date of the application, the invention had already been described in print either in a patent or a published patent application, or in any other publication available to the public. The term "publication" is usually interpreted in a broad sense and will cover documents such as theses, mimeographed scientific papers distributed to a large audience, etc. Also, a patent published after the priority date of the allowed application, but filed in that country before said priority date, constitutes a valid prior publication in that country.

Oppositions to British and German published applications, respectively, will now be discussed in more details. The principle is the same in both patent systems, i.e., the opposition procedure gives interested people the opportunity of seeing that patents are not mistakenly granted; it also gives them, in some cases, an opportunity of defending themselves in advance. For example, there may be two conflicting applications in the name of two competitors, respectively, where the other side has already filed an opposition or will very likely do so. In that case, one may file an opposition, or a cross-opposition, in self defense. However, the procedures in the United Kingdom and

in Germany present several essential differences. Therefore, for the sake of clarity, the two opposition procedures will be considered separately.

1. United Kingdom:

One has the option of filing either an opposition before the Comptroller within three months of the publication (Section 14 of the Patents Act), or an application for revocation, also before the Comptroller, within one year of sealing of the patent, on exactly the same grounds (Section 33). In other words, an application for revocation before the Comptroller (under Section 33) is like a belated opposition. The advantage of the latter is that it gives you more time to prepare your case. This is very important. Before filing an opposition, one should always carefully consider whether the material available is likely to bring about a decision of final rejection or of revocation, as the case may be, or to force the applicant to amend his specification in such a manner that it will leave the opponent free to do what he wants. One must bear in mind the limited grounds of opposition or revocation in British patent law (under Sections 14 and 33) and the fact that in the Comptroller's Court (the Patent Office), the applicant must be given the benefit of the doubt. Unless your case is strong enough, you run the risk that the Hearing Officer, if he decides not to refuse the patent, will give the applicant, or the patentee, leave to submit amendments which would only result in improving his specification. This obviously would make it more difficult to obtain revocation of the thus strengthened patent in the High Court.

In the United Kingdom, if the invention is of enough importance to warrant the expenditure, it is better in many cases not to file an opposition and, instead, to take patent revocation proceedings directly in the High Court (Section 32 of the Patents Act), where one can use all the arguments available in the Patent Office and others besides. Proceedings in the High Court will not be discussed here. It will only be pointed out that although proceedings may be initiated in the High Court by filing a petition for revocation of a patent, it may not always be the best course of action, and before deciding on whether or not to take these proceedings, the merits of the case and the material available for attack must be carefully considered. One

must remember that under British law, the patentee is not required to take immediate action against an infringer. Therefore, in some cases it might be advisable to stop a patent either before grant (opposition) or at the beginning of its life (revocation), especially if you feel your case is strong. On the other hand, it might be better to leave the patent alone and to wait for the patentee to start an infringement action (in the High Court) for the following reasons: in a petition for revocation, the burden is on the petitioner to construe the patent and establish the case against it on that construction. In waiting for the patentee to start an infringement action after the grant of the patent, the alleged infringer may then file a counterclaim for revocation, but in this case the burden is on the patentee to construe his patent, and this is made particularly difficult for him by the fact that his construction must include the alleged infringement, and he has to show how the patent, when so construed, is still valid in the light of the material brought forward in the counterclaim.

Turning back to the opposition proceedings, "prior publication" in British patent practice means prior publication in the United Kingdom. For example, a patent is issued, i.e., published, in the United States on the day before the priority date of a British specification, it does not constitute a valid prior publication. And a British or foreign prior patent is not a valid reference if it has been applied for more than fifty years before the filing date of the applicant's complete specification. "Prior public use" is prior public use in the United Kingdom.

There are several other important points to keep in mind in the preparation of an opposition in the British Patent Office:

1. It is inadmissible in British patent practice to combine documents in attacking a patent on prior publication;
2. It is inadmissible (except under special circumstances) to combine two documents when attacking a British patent on the ground of obviousness; but
3. It is permissible to combine a prior publication with common general knowledge when attacking on the ground of obviousness;
4. One can only allege that the invention is clearly obvious in view of a publication available to the public in the United Kingdom before the priority date of the opposed application. One cannot allege that an invention is clearly obvious in view of common general knowledge or of what was known before the priority date in the general sense.

One should not rely too much on the grounds of obviousness and prior use in an opposition in the United Kingdom, but rather on the ground of prior publication. The reason is that the evidence is in the form of a Statutory Declaration (affidavit). Oral evidence is rarely given in the Comptroller's Court. Declarants can be called for cross-examination but rarely are. In High Court proceedings, on the other hand, all of the evidence is given by experts in the witness box and they are always cross-examined. There is no doubt that *viva voce* evidence with cross-examination is more telling in the case of alleged obviousness, and that, moreover, it is usually necessary in cases of alleged prior use.

An opposition which has the greatest chance of success is one based on published documents whose meaning is generally apparent with very little explanation by means of evidence from Statutory Declarations. Because the British Examiner's search is rather limited, it is often possible to file an opposition on such grounds.

The final form of the initial, and of the complete, Statements of Opposition may be left to the patent agent. For obvious reasons, it is not enough to merely send him a list of references to cite in the opposition. The agent must be provided with a complete and detailed argumentation. As already explained in the chapter dealing with the straight prosecution of applications, he has per force an insufficient technological background of the invention and knows nothing of the opposer's commercial interests in his country. Under those circumstances, he cannot be expected to build up a really good case. The complete Statement of Opposition must be as strong and convincing as possible for in such cases it is often the weight of the first blow which counts the most.

How to draft a Statement of Opposition

Since in an opposition one attacks the claims, they should be taken apart, one after the other, and demolished systematically. For example, let us take a hypothetical case:

Claim 1 claims a process for producing a thermoplastic, tubular film having improved properties, in which, after extrusion, the film is contacted by a gas stream at a temperature below the extrusion temperature of the film while the extruded film is stretched.

Claim 2 is dependent on claim 1 and specifies that the film is extruded at a temperature of from . . . X°C. to . . . Y°C.

Claim 3 is dependent on claim 1 or 2 and specifies the type of gas forming the gas stream.

Claim 4 is dependent on any one of claims 1 to 2 and specifies that the film is contacted by the gas stream at a velocity of from . . . A to . . . B feet per minute.

Claim 5 is dependent on any one of claims 1 to 4 and specifies that the gas stream is at a temperature of from . . . X°C. to . . . Y°C.

Claim 6 is a claim to the film which has been produced by the process claimed in any one of the preceding claims.

Claim 7 claims an apparatus for producing a thermoplastic film having improved properties, said apparatus comprising a chamber . . .

Now each reference is analyzed and cited separately against one or several of the claims of the opposed application; For example: British Patent No. . . . describes a process for producing a tubular thermoplastic film by doing . . . such and . . . such. One of the features of this invention is to contact the tubular film, as it emerges from the die, with a stream of air. (If possible, quote largely from the cited patent.) The tubular film is extruded at . . . such . . . temperature. It is, therefore, submitted that the invention claimed in claims 1 to 4 and 6 of . . . (the opposed application) has been published in the United Kingdom before the priority date thereof in British Patent No. . . .

United States Patent No. . . . describes a process for producing a tubular plastic film wherein the film is reheated after extrusion to a temperature of from . . . X°C. to . . . Y°C. while being stretched . . . etc. It is, therefore, submitted that the invention claimed in claims 1, 2, 5 and 6 of the opposed application has been published in the United Kingdom . . .

Same procedure for the apparatus claims.

It is somewhat like an official action from the United States Patent Office but in much greater detail and with the essential difference that one cannot combine two or more references.

The grounds of common general knowledge or prior public use are later substantiated in the form of affidavits signed by an expert and called Statutory Declarations. Obviously, it is more preferable, whenever possible, to select a British expert since he will testify to common general knowledge in the United Kingdom. Prior public use must have taken place in the United Kingdom.

After the opposer has filed his Statement of Opposition, the

applicant files a Counterstatement in which he refutes the opposer's arguments, in detail. Then, if necessary, the opposer and then the applicant file Statutory Declarations from their experts. Then, finally, the Patent Office informs both parties that the case is in order for a hearing. Before the hearing, the applicant frequently writes to the Comptroller to request leave to amend the opposed application and lists all the proposed amendments. After the hearing, a decision of grant or of rejection is issued by the Comptroller's Court. Appeal lies to the Appeal Tribunal.

2. Germany:

Within a period of three months following publication of an application, any person may file an opposition against the grant of a patent. Contrary to British practice, there is no possibility of filing a belated opposition. However, nullity and revocation proceedings may be initiated against the patentee at any time after grant of a patent. These proceedings are before the Patent Tribunal which has its seat at the Patent Office.

As explained in the beginning of this chapter, only the ground of lack of novelty will be discussed here.

In German patent practice, "prior publication" means prior publications anywhere in the world within the last hundred years. "Prior public use" means prior public use in Germany. Any printed description anywhere or use in Germany having taken place within six months prior to the filing date of the application in Germany are not taken into consideration if they are attributable to the applicant or to his legal predecessor. This six month period has nothing to do with the one year priority period afforded to the nationals of the countries having joined the Union and signed the International Convention. It cannot be added to the convention year.

One may combine several documents when attacking a patent on the ground of prior publication and/or of obviousness. This is one of the essential differences from British patent practice. Also, one can allege that an invention is clearly obvious in view of common general knowledge or of what was known in the general sense before the priority date.

The grounds upon which the opposition is based must be fully set forth in the initial Statement of Opposition which has to be filed

within the three month term. The initial statement may be supplemented and amplified at a later date with a detailed brief.

As soon as the opposition has been lodged, the procedure passes from the Examination Department to the Patent Division. Contrary to the usual British procedure, the Patent Division may, at any time, summon and hear interested parties, examine witnesses, experts and interested parties either on oath or not and undertake any other inquiries which may be necessary to establish the facts in a case.

Like his British counterpart, and for the same reasons, the German agent should be provided by the United States attorney with a detailed argumentation against the opposed application. Several references may be cited in combination against the same claim. One must also remember that the doctrine of equivalents is liberally applied in Germany. This is why, sometimes, an opposition against a German application has more chances of success than an opposition filed against the corresponding British application based on the same prior art.

As in British practice, the applicant may ask for permission to amend his specification. Usually, at least, the main claim and corresponding statement of invention have to be restricted in view of the art cited by the opposer. An allowed published application can only be restricted; it cannot be broadened. For instance, if a claim is attacked on the ground that it is too broad in view of the disclosure, the applicant can no longer file any additional Example to support the scope of his claim. He can only do it during the examination proceedings, before the allowance of the application.

After the opposer has filed his full brief of opposition, the Patent Office sends a copy of said brief to the applicant who is given the opportunity of filing a counterbrief, within a specified period of time, to refute the opposer's arguments. After this first exchange of briefs, the Board members (three of them) may have already been convinced by the arguments of one or the other of the parties and decide at that stage to grant or to refuse a patent. On the other hand, they may give the opposer and the applicant one more opportunity of filing a second brief. Then the Patent Division issues its decision, wherein the grounds upon which it is based are set forth in detail. This decision is communicated to all parties (there may very well be more than one opposer). In many cases, there has been no hearing. An appeal lies to the Board of Appeal of the Patent Tribunal within one month following the service of the decision.

The appeal is like a de novo trial. However, unless an opposer has some additional prior art and fresh arguments to present in his brief of appeal, he does not have much chance of success. The applicant, if he appeals, should also present fresh arguments, or at least strengthen the arguments he has used in the first instance with the help, for example, of specific comparative data between the art cited by the opposer and his invention and showing a definite technical advance achieved by his invention over the prior art. Actually, if an applicant can submit such specific comparative data to support his arguments in reply to the first brief of opposition, he is practically sure to win his case. In Germany, and in the countries having a German type of patent system, it is as important to show a technical progress in the art as to show novelty.

A hearing is more likely to take place in appeal proceedings, but not necessarily. It will take place if: (a) it is requested by one of the parties, (b) evidence is to be given before the Patent Tribunal, or (c) the Patent Tribunal considers a hearing to be necessary. Finally, the Board of Appeal (three members) issues its Decision containing the grounds upon which it is based. Appeal proceedings are very slow; they usually last for several years. One must keep in mind that the life of a patent begins on its filing date; this is also true in British Patent Law.

Actions for infringement will not be discussed here; however, the following observations may be made:

There is nothing in British law which requires the patentee to take immediate action against an infringer. He can wait until he has a prospect, if successful, of obtaining substantial damages. In German law, it is quite different. Section 48 states:

Any claims based on an infringement of the rights in a patent shall lapse at the end of three years from the date on which the claimant obtained knowledge of the infringement and of the identity of the infringer; irrespective of such knowledge, claims shall lapse at the end of thirty years from the date of the infringement.

As long as the opposition proceedings last, the published application cannot become a patent. However, it is possible to initiate an action for infringement based on a patent application which has been published but has not yet matured into a patent. Thus, in the case of slow opposition proceedings, it might be to the advantage of the applicant to initiate an action for infringement if he feels that the opposition will be dismissed and a patent granted to him.

An appeal from the Decision of the Board of Appeal of the Patent Tribunal lies to the Federal Supreme Court, but only on a point of law.

3. Conclusion:

The possibility offered to third parties of opposing the grant of a patent present two major advantages. First, it constitutes for the public a further guarantee that a monopoly will not be granted to an applicant who does not truly deserve it. Second, from an industrial and commercial point of view, it is a powerful weapon to use against competitors. The threat of an opposition is enough, sometimes, to bring the parties to a licensing, or a cross-licensing, agreement.

Abroad, since a patent is granted to the first one to file, as opposed to the American practice of granting it to the first inventor, there are no interference proceedings. One of the most controversial recommendations of the Report of the President's Commission on the Patent System is precisely the one which would grant the patent to the first to file, thus eliminating interference proceedings and bringing United States patent practice much closer to foreign patent practices. This country stands alone in its practice of granting the patent to the first inventor which is a significant fact. It is to be hoped that this recommendation will be adopted and that opposition proceedings, instead, will be instituted in this country.

II. The Non-Examining or Registration Countries

These countries are, roughly, the countries all around the Mediterranean, plus Belgium, Portugal and Switzerland (except for the applications describing inventions in the textile and watch-making fields), the Middle East countries, and countries of Central America and South America. Regarding the countries of Central and South America, the law in many of them, such as Colombia, Costa Rica, Cuba, Ecuador, Guatemala, Honduras or Nicaragua, provides for an examination as to novelty, but there is rarely an objection to the grant of a patent. Argentina, Brazil and Chile have been listed in the examining countries because official actions resulting from examination as to novelty are more likely to be issued in these three countries than in the others. Bolivia, Panama, Peru, El Salvador and Venezuela are definitely non-examining countries.

The countries of Africa are non-examining countries, including South Africa for the time being. Thirteen African States out of the former French colonies have formed the "African and Malagasy Union" (AMU), also known as the "Brazzaville Group."

The countries belonging to said Union are: Cameroon, Central African Republic, Congo (Brazzaville), Dahomey, Gabon, Ivory Coast, Malagasy Republic, Mauretania, Niger, Senegal, Tchad Republic, the Republic of Togo and Upper-Volta.

On September 13, 1962, twelve of the above States signed the "Libreville Agreement" tending to the creation of a common Patent Office and to the promulgation of a common law for the protection of inventions, trade marks and designs. The Agreement was ratified by all twelve countries which founded the AMU and came into effect as from January 1, 1964. The Republic of Togo joined the Union with effect as from June 28, 1967.

The common Patent Office, called "Office Africain et Malgache de la Propriete Industrielle" (OAMPI), is established at Yaounde in the Cameroon Republic.

The unified legislation on industrial property protection is mainly similar to the present French laws.

Provisions are made for the filing of patent, trade mark and design applications with the common Patent Office covering the whole territory of the AMU countries. These countries must be commended for the establishment of their common patent system.

In keeping with the object of this article to provide a general outline only, it is sufficient to state that a patent application in British or German form should be sent to the Patent Agents in all these countries. It will then be very easy for them to effect in the application the amendments of formal nature necessary to comply with the patent practice in their country.

Although the requirements as to novelty of an invention might be very strict in many of these countries, patent applications are not examined as to novelty, only as to the questions of form, of unity of invention and of subject matter. The time taken for this examination varies widely from one country to another. Unless required by the Patent Office, no amendments may be made in an application after filing, in most of the non-examining countries. But before grant of a patent, it is permitted to correct clerical mistakes.

Normally, there are no problems with patent applications filed in non-examining or registration countries. They duly issue within terms

which vary widely from one country to another, from one month to more than one year.

In many of these countries, the law does not provide for opposition to the grant of a patent, but nullity or invalidation proceedings may be instituted in the civil courts.

In some countries, the specification ends up with a set of claims, either British type or German type of claims; in other countries, such as France, for example, the specification ends up with a "resume" which sets forth the main features of the invention. A resume is not the equivalent of a claim since it is not meant to define the scope of patent protection applied for, but simply to summarize the invention. In Belgium, the specification may end either with a set of claims or with a resume; in Italy, it winds up with a set of claims. However, in the last two countries, the wording of the claims has little weight in establishing the scope of the patent. As in France, the scope is ascertained by an examination of the whole patent (description, drawings and claims or resume) in the light of the state of the art. Hence, the importance of a good description, with clear statements of invention and enough Examples to fully support the scope of protection applied for.

A new French patent law, dated January 1, 1968, will come into force in 1969. It greatly modifies the existing laws and may be summarized as follows:

Inventions will be protected, at the option of the applicant, either:

1. *by* patents having a duration of 20 years (as under the existing laws) but examined as to novelty, or
2. *by* certificates of utility having a duration of 6 years and not examined as to novelty, or
3. *by* patents of addition, already provided for by the existing laws, but examined as to novelty.

The applications for a patent, a patent of addition or a certificate of utility will comprise claims defining the scope of protection solicited.

From what has been published this new patent system will probably place France with the countries having adopted what is called in this article "the German system." Until more is known about the application of the new Law, patent applications in British or German form should be sent to the French Patent Agents.

The establishment of the new French patent system is a major step toward the goal of a European patent system.

III. What to do Abroad with the Subject Matter of Continuation-in-Part Applications

Patents of Addition Abroad

This, to all American patent lawyers, is an important problem. With the exception of the Philippines, the law in foreign countries does not provide for continuation-in-part applications. Fortunately, there are several ways of obtaining the equivalent scope of patent protection abroad.

Difficulties arise only when one wants to claim the priority of a CIP application when no priority can be claimed on the original United States application because more than 12 months have elapsed since it was filed. Of course, there is no problem when both the original application and the CIP have been filed within less than 12 months; foreign applications containing the combined subject matter of the two United States applications may be filed with claim to the priority of both basic United States applications provided, of course, that the foreign applications are filed within less than 12 months of the filing date of the parent or original United States application.

The course of action to follow depends on the difference between the subject matter of the parent application and the subject matter of the CIP application.

1. When a CIP has been filed in order to restrict the scope of the original disclosure because of prior art, for example.

If patent applications have already been filed abroad, based on the parent application, it is easy to accordingly restrict the scope of the still pending foreign applications in the examining countries. If the foreign applications have been filed in non-examining countries, it is not possible to amend them, even if they are still pending. One has the choice of either letting them mature into patents covering the original broad disclosure, or to withdraw them and to refile fresh, narrower applications provided none of the applications had yet been published. But the newly filed applications would not be entitled to the priority date of the parent United States application and no priority can be claimed for the subject matter of the CIP because the CIP application is not the first filed application describing the invention, as defined in Article IV, paragraph 2 of the International Convention. Therefore, it is better to let the already filed foreign applications in non-examining countries mature into patents.

2. When a CIP has been filed to merely clarify the description or

to submit improved claims, but its disclosure is substantially the same as the original disclosure.

If the patent applications based on the parent application have already been filed abroad, the remarks of the preceding paragraph also apply in this case.

If no foreign applications had been filed based on the parent application, there is no problem. Patent applications based on the CIP application may be filed anywhere, but non-Convention. No priority at all can be claimed since the CIP not the first application within the meaning of the International Convention.

The text of the International Convention is quite clear in this respect. Article IV, paragraph 4, states:

“A subsequent application for the same subject matter as a previous first filed application within the meaning of paragraph 2 above and filed in the same country of the Union, shall be considered as the first application, the filing date of which shall be the starting point of the priority period, *provided that*, at the time of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without having been open to public inspection and without leaving any rights outstanding, and has not yet served as a basis for claiming the right of priority. The previous application may thereafter not serve as a basis for claiming a right of priority.”

Inasmuch as the United States parent application is still pending when the CIP is filed, the parent application confers rights on the applicant at that time and the CIP therefore, is not a “first application.”

3. When a CIP has been filed to broaden the disclosure of the original application and, therefore, contains additional subject matter.

a. If patent applications have already been filed abroad, based on the original United States application:

Patent applications restricted to the additional subject matter may be filed abroad with claim to the priority date of the CIP application. (Of course, this is the case whether or not earlier foreign applications were filed claiming priority from the original United States application.) These later filed patent applications may either be filed as independent patent applications, or be filed as applications for a patent of addition to the earlier filed applications, or earlier patents, based on the parent United States application.

An application for a patent of addition should be filed whenever possible, rather than an independent patent application, for a very good reason: the main application, or patent as the case may be,

cannot be cited as prior art against the application for patent of addition. Also, in most countries, either the taxes paid to maintain the main patent cover the addition, or at least the taxes to maintain the patent of addition are reduced. Should the main patent be revoked or declared invalid, the patent of addition survives the main patent. The only disadvantage is that the life of a patent of addition does not extend beyond the life of the main patent.

The law of most of the foreign countries provides for patents of addition. As long as an application for a patent of addition has not been allowed, it can be converted into one for an independent patent of the same date.

What may be the subject matter of an application for a patent of addition? A further improvement, or improvements, constituting a direct development of the invention described in the main application or patent. This is why the additional disclosure of a CIP usually makes an ideal subject matter for a patent of addition application.

How does one prepare an application for a patent of addition? It should not contain anything of what is already disclosed in the main patent, except what is necessary for a clear understanding of the improvement described in the patent of addition application. There usually are very few claims in a patent of addition; generally, only one claim is enough and it will be limited like the statement of invention. If there are subclaims, the main claim would anyway be strictly limited to the additional subject matter. It is drafted somewhat like a Jepson type claim. The claims must be strictly restricted to the additional subject matter. In an application for a patent of addition, any claim based on the disclosure of the original application will be rejected.

This brings us to another possible situation:

b. If no patent applications have been filed abroad based on the original United States application:

One has the choice between three courses of action.

The first one is the easiest one: to abandon Convention priority for the additional subject matter and to file non-Convention applications covering the original as well as the additional disclosure, with claims directed to both disclosures.

In order to be able to do this, however, one must first ascertain that there has been no printed disclosure of the invention and no public use of the invention prior to filing the foreign applications. Printed disclosure of the invention is a statutory bar for filing the

non-Convention applications. In some countries, printed disclosure must have taken place in those particular countries (like those having British-type of patent practice, for example) but in most countries printed disclosure anywhere is a bar. The same kind of remark applies for public use where, for some countries, prior public use anywhere is a bar as in France, Italy, Holland or the four Scandinavian countries, for example, although for most countries prior public use must have taken place in those particular countries.

The second course of action is to file two applications respectively covering the original subject matter and the additional subject matter, the first application being filed non-Convention and the second one claiming the priority date of the CIP. One of these two applications may be one for a patent of addition to the other, provided the application for a patent of addition is filed in the foreign country no earlier than the other application. This means that the application for a patent of addition, although filed at the same time or later than the main application, may enjoy the benefit of the Convention priority when the main application does not.

The third course of action is only possible in countries accepting claim to partial priority such as in Denmark, Finland, Norway and Sweden, for example: that of filing a single application covering and claiming both the original subject matter and the additional subject matter and specifying which ones of the claims are entitled to the priority date of the CIP and which ones of the claims will stand on their foreign filing date.

Partial priority is different from multiple priorities. For example, a foreign application contains the combined subject matter of two or more United States applications. If these United States applications have been filed on the same date, or if they have been filed within less than twelve months from each other, the Convention priority may be claimed for the foreign application when it is filed within twelve months from the first filed of the United States applications. But it must be specified which claims of the foreign application are entitled to the priority date of which United States application, even when the United States applications were filed on the same date.

It should be added that the subject matter of an application for a patent of addition is not at all restricted to the additional subject matter contained in a CIP application. Any novel subject matter may be annexed to the main patent by the owner of the main patent as long as it relates to further improvements constituting a direct

development of the subject matter of the main patent. It follows that the inventors may be different, as long as the applicant for the patent of addition is the same as the owner or the holder of record of the main patent, or as the applicant of the main patent application. This latter statement is rather general and it is advisable to check the specific requirements of each country. For example, in France patents of addition may be applied for only by the holder of record of the main patent or by his assignees and licensees of record.

Furthermore, an independent patent application may, as long as it has not been allowed, be converted into one for a patent of addition to an earlier patent or patent application. Attention must be called at this point to the new Patents Acts of 1967 in Denmark, Finland, Norway and Sweden, which considerably restrict the possibility of either filing an application for a patent of addition, or converting an independent patent application into one for a patent of addition. The new Swedish Patents Act, Section 7, first paragraph, states:

The patentee may obtain a patent of addition for a development of the invention provided that such an application is filed before the application for the main patent has become accessible to the public according to Section 22.

The first two paragraphs of Section 22 read:

From the day the application is published, the documents in the case shall be available to any one.

When eighteen months have elapsed from the filing date of the application or if Convention priority has been claimed from the date the priority of which is claimed, the documents shall be accessible to the public even if the application has not yet been published. However, if it has been decided to dismiss or reject the application, the documents shall be made accessible to the public only if the applicant requests that the application be revived or if he lodges an appeal.

The same rules apply in the other three Nordic countries.

Attention should be called here to the great efforts accomplished by the four above-mentioned Nordic countries toward unification of their patent systems which provide for Nordic patents upon conclusion of an agreement between these countries.

Conclusion

The constantly expanding dimensions of world trade and the tremendous developments in technology all over the world call for revolutionary changes in the structure of national patent systems and of the existing international legal systems for the protection of

industrial property. Step-by-step, the nations are progressing toward the ultimate goal of a universal patent system. This article is an attempt to show how difficult it will be to reach this goal, but also how interesting because it will require as a premise a full understanding of each other's patent systems and, therefore, a better understanding of the people of the other nations.