



2024 AIPPI World Congress – Hangzhou
Adopted Resolution
22 October 2024

Resolution

2024 – Study Question – Patents

Harmonisation of disclosure requirements and consequences of non-compliance

Background:

- 1) This Resolution concerns the harmonisation of disclosure requirements and consequences of non-compliance.
- 2) The laws of some jurisdictions require patent applicants to disclose Prior Art to the Patent Office, such as prior art that might be viewed as relevant to the assessment of the novelty and/or inventive step of a patent's claims. On the one hand, such an obligation increases the work involved in and therefore also, the costs of filing patent applications. On the other hand, such an obligation can serve the efficiency of the system because it provides for a more effective patent application examination if the Patent Office has the opportunity to consider and evaluate more information relevant or potentially relevant to patentability.
- 3) This Resolution determines if, and to what extent, a Disclosure Requirement should be mandated during the prosecution of a patent

application and after the patent is granted, and what sanctions should apply for non-compliance with such obligations.

- 4) 40 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (which can be found at www.aippi.org).
- 5) At the AIPPI World Congress in Hangzhou in 2024, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.
- 6) This Resolution does not address any special disclosure issues related to genetic resources/traditional knowledge (GRTK), which are outside the scope of the Resolution.

AIPPI resolves that:

- 1) Harmonisation of Disclosure Requirements is desirable.
- 2) The term "Disclosure Requirement" as used herein means, "a requirement to disclose Prior Art to the Patent Office". The term "Prior Art" as used herein means, "all information which has been made available to the public anywhere in the world in any form before the filing date or, where applicable, the priority date".
- 3) There should be no requirement for the applicant, or any other person involved with the preparation or prosecution of the patent application, to disclose any Prior Art to the Patent Office.
- 4) There shall be no requirement for the applicant to search for Prior Art.

- 5) Notwithstanding paragraph 3 above, if the National Law provides for a Disclosure Requirement, the Disclosure Requirement should be limited to Prior Art cited by Patent Offices for the same invention and applied only upon request by the Patent Office.
- 6) AIPPI recommends that all Patent Offices share information on Prior Art by way of a common, publicly accessible database or common portal to such database (e.g., Global Dossier or Common Citation Document - CCD).
- 7) Notwithstanding paragraph 3 above, if the National Law provides for a Disclosure Requirement, the submission of the Prior Art documents alone should satisfy the Disclosure Requirement, without the need for any analysis or reference to specific parts thereof. In proceedings before a Patent Office, submission of such Prior Art document that can easily be retrieved by that Patent Office should not be required.
- 8) Any Prior Art information communicated to a Patent Office in writing should be made available to the public once the patent application is made available to the public.
- 9) Submitting Prior Art under the Disclosure Requirement should not be taken as any kind of an admission regarding the relevance of that Prior Art to any of the claims of the patent or patent application in any proceeding.
- 10) Further to paragraph 5 above, and notwithstanding paragraph 3 above, if a jurisdiction has a Disclosure Requirement in their National Law and it is discovered at any time after patent grant that there has been an intentional failure to comply with the Disclosure Requirement, the relevant administrative or judicial body should have the authority to partially revoke the patent on that ground, but only to the extent that the undisclosed Prior Art is detrimental to the validity of the subject matter of one or more claims of the patent.
- 11) AIPPI recommends further study of special disclosure requirements relating to GRTK in view of the Disclosure Requirement.