

Patent Harmonization Expert Panel (PHEP) – Candidate Topics Discussion

Industry Consultation Group Meeting
February 2021

UNITED STATES
PATENT AND TRADEMARK OFFICE



Candidate topics

List of Future PHEP Topics (in no order of priority)

1. Adoption of a Global assignment: the ability to file a global assignment in one location with effect worldwide - point 6 of the original 2013 Industry IP5 Harmonization Topics List
2. Patent Specification:
 - a. Harmonization of Claim formalities such as: (i) eliminating the need for two-part format and the standard wordings 'characterised in that', and (ii) multiple dependency requirements
 - b. Harmonization of allowable features in drawings (e.g., color, how it should look)
 - c. Harmonization and simplification of requirements for correspondence between claims and the specification - eliminating need to later amend a specification to include allowed claim text
 - d. Remove requirement in Europe to insert closest prior art in specification, and JP requirement for prior art in background.
3. Harmonization of how applicants can correct mistakes
4. Harmonization on reinstatement of rights (to unintentional standard)
5. Roadmap and facilitation for handling first-filing requirements in multinational inventorship situations



Background

- **IP5 offices and IP5 Industry agreed in principle that new topics should:**
 - Be procedural or administrative in nature, rather than requiring changes in substantive patenting requirements
 - Have a large impact on patent applicants
 - Be within the scope of the IP5 Office responsibilities
 - Allow for quick wins and long-term improvements

Selection process

- IP5 offices will consider the new PHEP topics according to:
 - The nature of the topics provided — focus on procedural/technical procedures
 - The complexity of the problem to be addressed and the complexity of the potential solution
 - The ability to deliver timely and meaningful results

Selection process (cont.)

- **Factors considered in determining if these principles could be accommodated for each topic included:**
 - whether and what legislative changes would be required to meet user expectations;
 - whether IT tools would need to be developed, improved, or modified in order to meet user expectations; and
 - whether the topic falls within the specific jurisdiction of the patent offices.
- **Those proposed topics that would necessarily require significant legislative changes, require major IT modifications, and/or fall outside the jurisdiction of the relevant offices were determined not to meet the agreed upon principles and have been excluded at this time.**

Excluded topics at this time

- 2(a) - Harmonization of Claim formalities such as: (i) eliminating the need for two-part format and the standard wordings 'characterised in that', and (ii) multiple dependency requirements
- 2(c) – Patent Specification: Harmonization and simplification of requirements for correspondence between claims and the specification - eliminating need to later amend a specification to include allowed claim text;
- 2(d) – Patent Specification: Remove requirement in Europe to insert closest prior art in specification, and JP requirement for prior art in background;
- 3 – Harmonization of how applicants correct mistakes;
- 4 – Harmonization of reinstatement of rights (to unintentional standard); and
- 5 – Roadmap and facilitation for handling first-filing requirements in multinational inventorship situations.

Topics still under consideration

- 1 Adoption of a global assignment; and
- 2(b) Harmonization of allowable features in drawings (e.g. color, how it should look).

Topic 1: Adoption of a Global assignment: the ability to file a global assignment in one location with effect worldwide

USER EXPECTATIONS:

A simplified universal form and process for registering ownership that will result in clearer situation on IPR ownership and cost savings (which will be even greater with the application of AI).

Notes from Industry:

- A single form should be acceptable by all offices
- The form should be in English, or dual-column format with English and one other language.
- No fees should be charged if electronically filed (note that machine translation is readily available to local language if electronically filed).
- The process within Offices should be simple and as uniform as possible.
- A centralised database to store assignment documents from IP5 that is text searchable and linked to Global Dossier record, should be introduced.
- Record linkage (e.g., in Global Dossier or CCD, so when you search for a particular patent and you want to check the assignment, you can click on the link and it will take you to the assignment document).

Discussion points provided to Industry

- **Suggested areas of cooperation:**
 - *The work of the IP5 PHEP could focus on identifying if and how the IP5 Offices could accept a common harmonized form provided by the IP5 Industry that could be filed at all IP5 Offices. Additionally, the Offices could explore the processes and fees associated with filing a global assignment document within the Offices. Industry should provide the Offices with additional details on envisioned mechanisms for how the assignment would be maintained throughout the Offices.*
- **Potential limitations:**
 - *Adoption of a uniform global assignment document filed in one location with worldwide legal effect involves certain substantive requirements, is not solely within the jurisdiction of any of the IP5 offices and it would require legal and IT changes for implementation.*
- ***Expected timeframe: 1-2 years for completion by the PHEP once IP5 Industry provides an agreed uniform document.***

Industry response to questions from IP5

- *Has IP5 Industry agreed on a single form? What are the next steps in that process?*
 - *IP5 Industry have analyzed and discussed a global assignment form and potential process for filing such a form in detail and have general consensus. They indicated that if the IP5 Offices take up Global Assignment as a PHEP topic, they expect they would be in a position to very promptly provide a proposed form and process for consideration*
- *What does IP5 Industry envision for how the assignment would be maintained throughout the Offices?*
 - *A global depository that when an assignment form is filed there by applicants, the IP5 Office should recognize. Offices could agree to recognize the form and process for filing the form in the global depository without providing an opinion on whether the form meets the substantive requirements of each designated jurisdiction.*
- *Would the suggested areas of cooperation meet user expectations and provide a quick win and long-term improvement?*
 - *Industry believes that the suggested areas of cooperation would meet users expectations and provide a quick win and long-term improvement*

Consideration of Industry response

- IP5 Offices evaluated and analyzed the responses from IP5 Industry regarding topic 1 – Adoption of a Global Assignment
- During the PHEP meeting in the fall, it was determined that additional information from IP5 Industry is needed for the IP5 Offices to finalize their analysis and evaluation of the candidate topic

Follow-up information request

- **Inquiries in relation to the universal assignment form.**
 - Has IP5 Industry developed or does IP5 Industry intend to develop a draft universal assignment form? If a draft form has been developed, please provide us with a copy with any relevant descriptions and explanations.
 - Does Industry expect that the form will have legal effect in all IP5 jurisdictions, including every EPO member state and all U.S. states and territories?
 - Does Industry expect that the form will be developed in compliance with currently applicable legal requirements in the IP5 jurisdictions or will it supersede these?

Information request (cont.)

- Please clarify how the Offices are expected to agree to recognize the form and the process for filing the form without providing an opinion on whether the form meets the substantive requirements of each designated jurisdiction. What would this entail in practice?
Inquiries in relation to the process.
 - Could the draft universal assignment form be used in the current administrative procedures at the Offices for the recording of assignments?
 - If yes, what advantages/improvements does the use of the universal assignment form offer for owners and Offices?
 - Explain how the form might be communicated to a number of IP Offices in the absence of a global repository with an active component.

Information request (cont.)

- **Inquiries in relation to a global repository and/or active component for exchange of assignments.**
 - Does the global repository and/or active component for exchange of assignments also suggest a deliverable of the project?
 - If yes, does the project stand or fall based on this component?
 - What specifically does Industry envision for the global repository/active component? Describe the relationship between global repository/active component and patent rights registered in each jurisdiction in terms of legal effect.
 - Has Industry evaluated this in relation to legal requirements at the IP5 Offices, for example the requirement in the U.S. under 35 U.S.C. 261 that "(t)he Patent and Trademark Office shall maintain a register of interests in patents and applications for patents and shall record any document related thereto upon request, and may require a fee therefor."

INDUSTRY RESPONSE

Topic 2(b): Harmonization of allowable features in drawings (e.g., color, how it should look)

USER EXPECTATIONS:

Greater uniformity in describing inventions, greater clarity for Examiners and the public, and greater predictability and work sharing.

Notes from Industry:

- With respect to drawings, patent Offices already accept the PCT standard drawings which is highly appreciated (see Rule 7 and Rule 11.13.).
- Then the problem occurs when an Applicant goes into the national phase and the examiner at the national phase starts imposing local requirements and restrictions.
- Harmonization should ensure consistency between national standards and PCT standards.
- Gray scale could also be considered.

Discussion points provided to Industry

- **Suggested areas of cooperation:**
 - *A focus on the future of advanced electronic document processing making global uniformity available, including partnering with industry to gain a better understanding of the future demands/needs of applicants for advanced electronic filing with regard to drawings.*
 - *The PHEP could consider engaging in a comparison of new drawing formats, including any potential benefits, as well as challenges to the application process by accepting alternate formats such as color, gray scale, 3D, etc. The work should be limited to gaining an initial understanding of where future drawing practices/formats may provide greater uniformity in describing inventions, greater clarity for Examiners and the public, and greater predictability and work sharing. The work should exclude any agreement of harmonized tools, the development of tools, or a commitment to change current practices, however, it may be decided to send the findings to WG2 for additional consideration.*
- **Potential limitations:**
 - *Harmonization of current drawing requirements will require legal and IT changes in each office. Both legal changes and IT developments can take at least several years, if they can be done at all.*
- ***Expected timeframe: 1-2 years for completion by the PHEP***

Industry responses to questions from IP5

- *Would IP5 Industry participate and support in identifying future demands/needs for advanced electronic filing with regard to drawings?*
 - *Industry did not specifically respond to this request, but instead provided short and long-term proposals*
 - *Short Term Goal*
 - *Matters of size (areas of figure, margin, line thickness, Ref. No. Size)*
 - *Long Term Goal*
 - *Others (Fig number, Gray-scale, color, photo)*
- *Would the suggested areas of cooperation meet user expectations and provide a quick win and long-term improvement?*
 - *Industry did not specifically respond to this request, but instead provided short and long-term proposals noted above*

Consideration of Industry response

- IP5 Offices evaluated and analyzed the responses from IP5 Industry regarding topic 2(b) – Harmonization of Allowable Features in Drawings
- During the PHEP meeting in the fall, it was determined that additional information from IP5 Industry is needed for the IP5 Offices to finalize their analysis and evaluation of the candidate topic

Follow-up information request

- **Inquiries in relation to the Short term goal: Matters of size (areas of figure, margin, line thickness, Ref. No. Size).**
 - Please explain in practical terms how the variations in these formal requirements at the Offices affect applicants taking into account the following:
 - There appears to be a lowest common denominator in matters of size that could be used when first preparing drawings that would be acceptable under the national law of the Offices and under the PCT.
 - IP Offices may not strictly enforce these formal requirements in view of electronic processing and publication.



Information request (cont.)

- **Inquiries in relation to the Long term goal: Others (Fig number, Gray-scale, color, photo)**
 - Please explain in what technologies or situations black and white drawings are not sufficient to adequately disclose of the invention. Why is gray-scale or color a necessity? Under what circumstances are photos needed as opposed to drawings?
 - In relation to use of color, gray-scale and photographs, please clarify Industry's needs/expectations in relation to processing thereof by the Offices. Does Industry expect full end-to-end processing of color, gray-scale or photographs (filing, examination, publication, display in search systems)? Also, what aspect of processing is most important?

Information request (cont.)

- What does IP5 Industry view as the root causes in the differences in practices, e.g. divergent regulations, IT requirements, etc.?

INDUSTRY RESPONSE

Next steps

- **IP5 PHEP meeting March 16-17, 2021**
 - Consider Industry feedback
 - Determine if topics should/can be taken up
- **IP5 Deputy Heads meeting – April 2021**
 - Present status of all candidate topics
 - Proposal to take up topic(s) as agreed at PHEP meeting
- **IP5 Heads meeting – June 2021**
 - Seek endorsement of topic(s) agreed to by Deputy Heads

THANK YOU

