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BUSINESSEUROPE COMMENTS ON CONSULTATION ON IP5 PATENT PRACTICES

BUSINESSEUROPE welcomes the publication by the IP5 Offices (EPO, USPTO, JPO, KIPO, SIPO) of the comprehensive reports outlining their relevant practices regarding unity of invention, citation of prior art and written description/sufficiency of disclosure (terminology list).

We welcome the efforts and progress made in the three prioritised harmonisation projects. It is positive that the IP5 Offices have taken into account proposals by BUSINESSEUROPE and its industry partners from U.S., Japan, Korea and China (Industry IP5). It is important that procedural harmonisation delivers a practical set of practices and standards. It should eliminate duplication of work and allow efficiency for applicants because they would not need to accommodate the differences between the patent offices.

1. Unity of invention

- a. All offices should adhere to the Patent Cooperation Treaty (PCT) standard for unity of invention as already suggested by Industry IP5.
- b. A unity of invention objection should only be applied in a narrow sense when two distinct inventive concepts are claimed.
- c. Unity of invention objections should not be raised on the base of a narrow, literal or academic approach.
- d. All offices should introduce measures to protest against an unfounded objection based on lack of unity.

2. Citation of prior art

- a. The need to cite any known relevant piece of prior art and the different criteria applied by the different offices puts a lot of unnecessary burden on the applicant and his backoffice. This should be resolved by implementing an electronic data exchange between the offices and mutual acceptance of the lists of cited prior art.
- b. A lot of efficiency could be gained on Citation of prior art if the patent offices developed an IT solution to share with each other all the prior art documents and interpretations of or comments on those documents. This should include not only the prior art cited in search reports, but also further publications that are sometimes cited in later communications with the applicant. When such a system has been put in place, it should be established that the applicants have met all its requirements vis-à-vis the associated patent offices in relation to prior art cited or discussed in records from the other patent office.



c. For the IP5 offices at present especially the disclosure demands in the U.S. (as they tend to be understood by U.S. practitioners) lead to enormous inefficiencies, even going as far as setting up special processes to scan not only all search reports for possible further prior art, but even all office actions from all the examining patent offices just in case a publication is mentioned in such office action. The IP5 offices should establish a practical and efficient IT system that makes it clear that such extra scanning and screening practices are no longer necessary. That would constitute a great step forward.

d. This still remains a long-term goal. For a short-term goal, we would suggest the following:

- No need to cite or submit any prior art documents cited in any of the search reports from any of the participating offices.
- No need to submit any prior art that is a patent publication. Or only by exception if there is a bona fide issue with the availability of the patent publication.
- No need to submit any translations, or at least not if there is an equivalent specification available in the English language. Allow machine translations in general and require better translation only by exception if there turns out to be a need for it.
- Even more short term: Harmonisation of the format of the search reports and responses to requests for information. That would make it easier to import the search reports from the patent offices into the applicants patent management system and similarly to create reports for the patent offices efficiently from the applicants patent management system.

3. List of terminology on written description

a. The report provided by the Japan Patent Office merely lists a selection of applicable articles of the different patent laws. A specific proposal for harmonisation is not made.

b. It will be useful to have a clear indication from the IP5 Offices how they plan to progress on this issue.
