



Comments from AIPPI
on the Industry IP5 Consensus Proposals to the
IP5 Patent Harmonization Experts Panel (PHEP)
dated 10 October 2014

The International Association for the Protection of Intellectual Property, generally known under the abbreviated name AIPPI, is the world's leading International Organization dedicated to the development and improvement of the regimes for the protection of intellectual property. It is a politically neutral, non-profit organization, domiciled in Switzerland, which currently has almost 9000 Members representing more than 100 countries. AIPPI dates back to 1897, shortly following the signature of the Paris Convention for the Protection of Industrial Property in the year 1883.

The objective of AIPPI is to improve and promote the protection of intellectual property on both an international and national basis. It pursues this objective by working for the development, expansion and improvement of international and regional treaties and agreements and also of national laws relating to intellectual property. It operates by conducting studies of existing national laws and proposes measures to achieve harmonization of these laws on an international basis.

The Members of AIPPI are people actively interested in intellectual property protection on a national or international level. They include lawyers, patent attorneys and trademark agents as well as judges, scientists and engineers. They also include corporations. AIPPI is organized into 64 National and 2 Regional Groups and membership is obtained by joining one of these Groups. In countries where no Group exists, membership is obtained as an Independent Member in the international organization.

Under the supervision of the Reporter General and the Chairman of the Program Committee AIPPI conducts its scientific work, namely the study of issues of topical concern in the IP world. Once the working program is established, Working Committees are formed to study each

pending Question. The Reporters General team prepares Working Guidelines that the Groups follow in preparing their individual reports. The Group Reports are then concentrated or synthesized by the Reporter General team into a Summary Report. These studies are the basis for the Working Committees in the preparation of draft Resolutions and Reports that are then discussed at Congresses and Executive Committee Meetings. When a consensus is achieved, a final Report and Resolution are prepared for adoption by the Executive Committee.

Over 700 Resolutions have been passed by AIPPI. By those Resolutions AIPPI seeks to influence the development of International Intellectual Property Law. AIPPI's Resolutions are published in English, French, German and Spanish and supplied to WIPO, WTO and national and regional patent and trade mark offices around the world.

AIPPI welcomes the initiatives of the IP5 to further promote harmonization of patent practices and procedures. AIPPI has taken note of the IP5 reports on unity of invention, citation of prior art and terminology on written description. AIPPI has also taken note of the Consensus Proposals formulated by six Industry IP5 Associations: AIPLA, IPO, JIPA, BE, KINPA and PPAC and would like to provide following comments. The AIPPI Resolutions referred to in these comments reflect AIPPI's current views on their subject-matter.

General comment

In the context of efforts undertaken by WIPO aimed at the signing of a treaty on the harmonization of substantive issues of patent law, known as the Substantive Patent Law Treaty, AIPPI adopted its Resolution Q170, "Substantive Patent Law Treaty" at the meeting of the Executive Committee in Lucerne in 2003. In Resolution Q170, AIPPI noted that the growth in the number of patent applications worldwide requires a reduction in the amount of duplicated work carried out by the different patent offices of the world, particularly in connection with search and examination; that duplication cannot be reduced without a greater harmonization of certain aspects of substantive patent law; that duplication of work combined with the increasing number of patent applications is causing a collapse in the work of some patent offices and is increasing considerably the time needed to grant patents; that the quality of work performed by patent offices risks deteriorating as a consequence of the backlogs; and that experience shows that it is difficult to reach an international consensus in all the subjects proposed for harmonization in a single step. In view of this, AIPPI resolved that it is in the interest of users to adopt a harmonization treaty on at least some substantive patent aspects, including unity of invention and enabling disclosure. In addition, AIPPI resolved that the harmonization process should be a continuous exercise.

AIPPI considers that the initiatives of the IP5 are a welcome effort in the ongoing process of harmonization of patent practices and substantive patent law.

Unity of invention

In its Resolution Q89, “Harmonization of certain provisions of the legal systems for protecting inventions”, adopted by the Executive Committee in Amsterdam in 1989, AIPPI studied the requirement of unity of invention. AIPPI is in favor of the introduction of the adoption of the PCT standard for assessing unity of invention and thus agrees with the Industry IP5 Consensus Proposal. In the same Resolution, AIPPI expressed the view that whenever a finding of lack of unity is made, the applicant should be given the opportunity to make a selection for which of the inventions identified is to be pursued in the application or to pay an additional search fee for the other invention or inventions. Additionally, a definite date should be announced to the applicant so that they can determine whether they want to file a divisional application.

Although AIPPI’s Resolution Q89 did not go into the same level of detail as the Industry IP5 Consensus Proposal, it follows from this Resolution that the Offices should, as much as possible, adopt a uniform standard and study each other’s cases to achieve uniformity. It also follows that coordination efforts among the Offices to implement standard and uniform guidelines are to be encouraged.

Whether or not the determination of unity of invention made by the first Office that performs a search or establishes a written opinion on an application should be followed by the other Offices has not previously been debated within AIPPI. Noting that there may not be consensus on this matter within the Executive Committee of AIPPI, after receiving input from AIPPI’s Standing Committee on Patents, the Bureau of AIPPI is of the opinion that adopting the principle of following the unity of invention determination made by the first Office would greatly streamline the patent application process for applicants pursuing patents in multiple Offices and would increase legal certainty both for applicants and the public.

The Industry IP5 Consensus Proposal further proposes that a determination of unity of invention should be rebuttable and that appropriate procedures for rebutting the initial determination should be adopted, with the goal of minimizing the financial burden for applicants. While this proposal too would enhance the efficiency of international patent procedures, AIPPI notes that frequently the first determination of unity of invention will be made either in respect of a first filing during the priority year or in respect of a PCT-application. In both situations, the timeframe for conducting a procedure to evaluate the correctness of a determination of unity of invention is extremely limited. In respect of a PCT-application, it will

have to be concluded before the time limit for entering the application into the national/regional phase, i.e. before 30 months calculated from the first priority date. Experiences with the former protest procedure under the provisions of the PCT teach that this is in practice often not feasible.

A more practical solution may be to create a procedure for rebuttal of the finding of the first Office to be conducted during the national/regional phase. In order to avoid having to conduct such procedures before all Offices where the application enters the national/regional phase, it should be conducted before the first Office that made the determination of unity of invention. If the applicant wishes to rebut the determination of unity of invention, they should indicate this at the moment they enter their application into the national/regional phase. The procedural step of a rebuttal of the finding of lack of unity should not reduce the number of procedural opportunities that the applicant has to react to objections raised in substantive examination. The other Offices where the application enters the national/regional phase could then postpone examination of the application until after the Office seized with the rebuttal procedure has made a final determination of unity of invention.

Citation of prior art

AIPPI has not studied the question of requirements imposed on the applicant to cite prior art and consequently has not adopted any Resolutions on this topic. After receiving input from AIPPI's Standing Committee on Patents, the Bureau of AIPPI observes that existing differences in these requirements are not likely to be easily harmonized. AIPPI is in favor of the IP5 adopting procedures that reduce the administrative and financial burdens on applicants as much as possible. Therefore, AIPPI agrees with the Industry IP5 Consensus Proposal that the IP5 Offices should adopt an automatic, electronic prior art citation practice whereby prior art that is cited with respect to an application by any IP5 Office or in a third party submission before any IP5 Office is automatically made available to other Offices without any further obligations of disclosure on the applicant. In addition to reducing the administrative burden on applicants, this will enhance legal certainty for the public as the likelihood of differences in scope of granted patents in different jurisdictions in view of some prior art not having been taken into account will be reduced. AIPPI further agrees that there should not be an obligation to separately cite prior art to an Office if that prior art is properly referred to in the specification of the application.

Written description

During its Congress in Munich in 1978, AIPPI adopted Resolution Q69, "Sufficient description of the invention". AIPPI resolved that the description of a patent application should disclose

the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art. The person skilled in the art is skilled in the art corresponding to the technology with which the invention is concerned. He is one of average knowledge and average ability. They do not have the whole technology at his fingertips but they know the state of the art which is part of the average knowledge required in their professional work. Additionally, they know the state of the art revealed in the patent.

In Resolution Q69, AIPPI further resolved that the assessment of whether the description is clear and complete is a qualitative one wherein the description must be considered as a whole. Consequently, the complete and clear character of the description must not be considered as deficient for the sole reason that one of the formal indications required to constitute its content has been omitted. In order to be complete, the description shall supply all which is necessary, not only to understand the invention, but also to carry it out or implement it. It is not enough that the description be complete. It must also be clear, i.e. it should not include any obscurity or ambiguity. Difficulty in carrying out the invention may not be confused with obscurity, and the capacity of the person skilled in the art must correspond to the nature and the degree of the invention.

AIPPI noted in Resolution Q69 that a description is sufficient when it discloses the constituent elements of the invention and the instructions adequate to enable a person skilled in the art to put the invention into effect by the application of his skill and knowledge. However, the patent needs only disclose the means making it possible to carry out the invention; it cannot be required that the patent should contain all indications for the practical realization of the invention, which constitutes the know-how for carrying it out. The realm of the invention, which is a matter for patents, and the realm of implementation, which includes questions of know-how relating to the industrial exploitation of the invention, should not be confused. It must be emphasized that an invention cannot be considered as inadequately described on the sole ground that it is difficult or imperfect.

AIPPI further noted in Resolution Q69 that the assessment of sufficiency must be made in the light of the knowledge and abilities of a person skilled in the art at the date of the patent application or at the date of the priority claim. For supporting a priority claim, it is only necessary for the relevant claim to read on the priority document. The local criteria applicable to the determination of sufficiency of description are relevant only to the patent description in that country, and not to the priority documents.

AIPPI agrees with the Industry IP5 Consensus Proposal that there is an interest that the description be presented in a fairly uniform manner and that the Offices adopt as much as possible a uniform standard for assessing whether the description of the invention is sufficient. In Resolution Q69, AIPPI adopted a number of rules that could serve as part of a guideline for such uniform standards. These rules are the following:

1. It is necessary for the patent to site the invention in the state of the art. To this effect, the description must indicate:

- the title of the invention, i.e. its technical designation;
- the technical field which it concerns;
- the state of the prior art, but only for the elements necessary for understanding the scope of the invention.

The description must then define the invention. The invention is first of all defined in the form of a problem stated and of a solution proposed. The essential means and the concrete modalities of its implementation must then be described.

2. In general, there is no reason to require that the description lists the advantages procured by the invention, unless this listing gives a sense to the solution brought about by the invention. At least one example (detailed embodiment) should normally be given.

3. There is no reason to require that the description should supply the best mode of carrying out the invention. It is indeed often impossible to determine the best mode and in any case, it does not depend on the invention or the patent but on the industrial technology concerned with making use of the invention.

4. Furthermore, there is no reason to require that the description should contain indications concerning the possible detrimental effects of the invention on the environment. These indications, whatever their merits in respect to the protection of the environment may be, are not in the realm of the patent; they are in the realm of the control of the exploitation of the invention.

5. It is desirable that drawings should be an integral part of the description. As such, they should be covered by the patent.

6. In addition to the correction of purely immaterial faults, the description of the invention may be amended in the course of the grant procedure, under the control of the examiner, and on the essential condition that this modification adds no new inventive matter to the description. Consequently, modifications of the description are permissible, for example: to eliminate elements which have become irrelevant after the applicant has renounced certain claimed subject matter; to add indications relative to the prior public domain which the applicant may not have known about but which it would be desirable to add, or to introduce explanations or clarifications in the relevant documents.

7. It must be possible to furnish further examples of implementation within the scope of the claims, e.g. for support purposes, providing that the further examples are not actually included in the patent specification itself: these further examples could be published in an Appendix to the patent specification.

September 15, 2015
