



Patent Harmonization Expert Panel (PHEP) – Future topics

June 2019

UNITED STATES
PATENT AND TRADEMARK OFFICE



Background

- **April 2018 — ad hoc PHEP on the margins of the IP5 Deputy Heads Meeting**
 - EPO introduced the topic of the future work of the PHEP
 - All IP5 offices agreed to:
 - Liaise with each of their domestic/regional associations prior to the June 2018 meeting on potential topics for future work of the PHEP (April) and share the results of their discussion with the IP5 offices (end of May)
 - Develop a preliminary list of potential topics before June 2018
- **June 2018 — Heads with Industry Meeting**
 - Industry met to discuss candidate topics and subsequently presented five new topics to the IP5 heads

Background (cont.)

- 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

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 (cont.)

- **November 2018 - ad hoc PHEP on the margins of the WG3 meeting**
 - PHEP discussed the proposed candidate topics and agreed additional information was necessary to engage in a meaningful discussion in December 2018
 - USPTO provided a detailed questionnaire to IP5 Industry with the expectation of engaging in additional discussions and furthering the development of a new consensus proposal
- **January 2019 – Industry Consultation Group (ICG) on the margins of the WG2 meeting**
 - Offices and Industry discussed at length the need for having a common understanding of the issues related to the candidate topics
 - Industry indicated a need for additional time to provide a response to the detailed questionnaire

Background (cont.)

- **April 2019**
 - IP5 Industry submitted a response to the detailed questionnaire on their proposed candidate topics
- **April 2019 — ad hoc PHEP on the margins of the IP5 Deputy Heads Meeting**
 - IP5 offices agreed to review the detailed IP5 Industry response to the questionnaire to determine if additional IP5 Industry feedback is necessary and continue discussion towards a decision on new topics in the October PHEP meeting

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

Next steps

- **PHEP is continuing the review and analysis of IP5 Industry's response to the questionnaire**
 - Identifying the scope of each of the proposed topics to understand the complexity of the problem
 - Identifying the types of information that will be needed from the IP5 offices for comparative purposes
 - Considering what, if any, meaningful and timely results can be achieved via the PHEP
- **Considering additional topics that may be identified throughout the discussion**
- **PHEP will meet during WG3 in October 2019 with the goal of identifying the new PHEP topics**



THANK YOU