

Patent Harmonization Expert Panel (PHEP) New Topics

Industry IP5 Update

Industry IP5 Meeting with IP5 Heads of Offices June 13, 2018

Selection Factors Considered

- Procedural or administrative in nature, rather than requiring change in substantive patenting requirements
- Large impact on patent applicant
- Within scope of IP5 Office responsibilities
- Quick wins and long-term improvements

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 Harmonisation 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 (see next slide)

More on Topic 5

5. Roadmap and facilitation for handling first-filing requirements in multinational inventorship situations

Minimum objective:

Prepare guidance for applicants on how to comply simultaneously with first filing /foreign filing license requirements for all possible permutations of multinational inventorship in the five offices.

Possible additional considerations:

- 1) limiting first filing / foreign filing license requirement to instances where there are no international inventors;
- 2) limiting first filing / foreign filing license requirement to defined areas of technology
- 3) availability of user-friendly, expedited foreign filing license at all offices and a process for requesting such license without violating a requirement of another jurisdiction.