

Summary of Industry Trilateral Discussions on Substantive Patent Harmonization

Report of Industry Trilateral to Trilateral Heads of Office

February 23, 2016

Washington D.C.

Grace Period

1. Start of Grace Period is a fundamental issue
 - Industry Trilateral is looking for progress with further discussions
 - There is recognition that harmonization can only be achieved with the priority date as the start of the measurement for grace period
2. Grace Period should provide a Balance of interests of Third Parties and of Applicant/Inventor
3. Consequence of failure to make Statement/Identification of a known disclosure
 - Need to define “known”
 - Statement/identification to be made in time for publication of the patent application
 - Further discussion on penalties for failure to timely file statement
 - Financial penalty may be appropriate in certain circumstances

Prior User Rights

- Conditions for Rights Accruing
 - Activities based on information independently developed or information derived from the applicant without breach of any duty or agreement (i.e., innocently) may qualify for PUR or a similar right.
- Industry Trilateral agree that there needs to be a proper Balance of third party PURs versus patentee's rights

Conflicting Applications

- Distance and time difference discussions have now been linked in Industry Trilateral Discussions
- Industry Trilateral agrees that published PCT Applications are prior art as of priority date

Negotiated Elements have *not* Received Final Approval

Alignment resulting from the Industry Trilateral are subject to review of all elements as a full package, and subject to the final approval by the competent bodies of each Industry Group organization.

PHEP issues

- Industry Trilateral supports JPO proposed engagement on practical implications of Written Description issues with the use of hypothetical cases
- Industry Trilateral looks forward to seeing significant progress on all 3 PHEP issues (unity of invention, citation of prior art, written description):
 - Please set detailed timeline for progress, possibly after the March 22-23 meeting of the Deputy Heads of Offices
 - How are the Offices following up with each other and coordinate with the Industry Group on each of the topics?



Thank You!