

Substantive Patent Harmonization: Recent Developments

March 1, 2018

36th Trilateral Conference

Meeting of Trilateral heads of Office with Trilateral
Industry

Hakone, Japan

Recent Patent Harmonization Efforts

◆ Governments

- **2012-2014** – a Trilateral-sponsored **Tegernsee Study** of four key harmonization issues in 2012 and Report in 2014 led to a new initiative.
- **2014-Present** – Group B+ assumes responsibility for the initiative among governments on the **4 Tegernsee topics**: grace period, prior user rights, conflicting applications and 18 month publication
 - Prepares an **Objectives and Principles Paper** (2015)
 - Establishes separate **Work Streams** (2016)
 - Holds Industry/Government **Symposium and Meetings** (2017)
 - Begins planning for a **Global Consultation** (2018)

Recent Patent Harmonization Efforts

◆ Industry Trilateral

- **2014-Present** – IT3 meets frequently concerning the **4 Tegernsee topics**:
 - Prepares a comprehensive **Elements Paper** with recommendations on 4 topics plus the definition of "prior art"
 - Participates in the **B+ Symposium and Meetings (2017)**
 - Discussed IT3's **Elements Paper** and gathered stakeholder's responses thereto
 - Holds weekly teleconferences among discussion leaders
 - Schedules face-to-face meetings in January, February, June 2018
 - Supplements face-to-face meetings with substantive WebEx discussions
 - Aim to reach consensus and issue a final package by early September 2018

Industry Trilateral Harmonization Principles

- ◆ **Policy Must be Fair and Balanced**
- ◆ **Policy Must Consider Interests of Patent Owners, Third Parties and the Public**
- ◆ **Many Existing Laws Must Change to Some Extent**
- ◆ **Harmonization Must be Based on an Agreement as to an Entire Package Rather Than Individual Elements**

Engagement with other stakeholders

Industry Trilateral has/will organize events in members/non-members countries.

- Presentation to B+ users symposium**
- Presentation to the Industry IP5 (ICG)**
- Global Network of National IP Practitioner Associations**
- Organization meetings**

Outreach to representatives of individual inventors, SMEs, universities, national/international law societies/associations, including China.

- ◆ This Presentation is meant to reflect the Industry Trilateral’s positions provided in the “**Policy and Elements for a Possible Substantive Harmonization Package,**” dated June 1, 2017, which is a work in progress and remains subject to approval by each organization’s relevant bodies.

- ◆ Group B+ Patent Harmonization web page
<https://www.epo.org/news-issues/issues/harmonisation/group-b-plus.html>

Grace Period

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◆ Policy Issues

- **Balance Interests** of Applicants, Third Parties and the Public
- **IT3** (including *European Industry*) accepts the "**Safety Net**" Grace Period **that discourages a Publish- First Policy.**

◆ Elements - including **issues under discussion**

- Duration (**6/12** months) & Scope (**any** pre filing disclosure [PFD] in any form that is **by/for/from** the Inventor or Applicant)
- Prejudicial Effect of Intervening Disclosures; **independent PFD** is always prejudicial; the burden to show derivation of an intervening disclosure is on (**Applicant/third party**)
- **Statement** identifying PFD(s) to be graced is to be submitted during prosecution and (**up to/after**) grant.
- Possible Incentives for Statement Submission - Administrative Fees, **Accelerated Publication** and **Defense for Intervening Users (DIUs)**

Prior User Rights (PUR) Defense

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Policy Issues

◆ Fairly Balance Competing Interests of:

- 1) **a Third Party** who has made (a) commercial use of the invention* or (b) at least serious and effective preparation for commercial use of the invention without timely seeking patent protection prior to the Applicant's filing date**, and
- 2) **an Independent Innovator (patent owner)** who later files for a patent on the same invention.

◆ Elements – including issues under discussion

- ◆ Availability and Qualification for the PUR Defense – geographically limited to jurisdiction of commercial use
- ◆ Relation between Third Party Activity and the Patent Owner activity or PFD (Derivation **does/does not disqualify**)
- ◆ Scope of PUR Defense (limited right to continue commercial activity – **scope under discussion**)
- ◆ Transferability of PUR Defense

* covered by claim(s) of granted patent

** the actual filing date or the priority date, whichever occurs first

Conflicting Applications

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Policy Issues

- ◆ **To permit** an appropriate scope of **protection for incremental inventions**
- ◆ **To prevent** the grant of **multiple patents on substantially the same or identical invention** in the same jurisdiction
- ◆ **To minimize the risk** to third parties of **multiple enforcement proceedings in the same jurisdiction**

Elements - including issues under discussion

- ◆ Use of an Unpublished Work as Secret Prior Art (**SPA**)
- ◆ Use of SPA against Third Parties and Appropriate "Distance" Between SPA and Third Party's Application
- ◆ Anti-Self collision: Unpublished applications by the same Applicant *[should][should not]* have prior art effect against Applicant's later applications.
- ◆ **Further Measures to Deal With Double Patenting** – e.g., common ownership and concurrent expiration, as in the US
- ◆ Treatment of PCT Applications as SPA – **merely on active designation vs requirement for entry into the National Stage**

Definition of “Prior Art”

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Policy Issues

- ◆ **A global agreement** on what is "**prior art**" against the subject matter claimed in a patent or patent application is needed.
- ◆ A fundamental requirement is that the "prior art" must be "public" thereby making it available on an unrestricted basis prior to the filing/priority date of an application.
- ◆ An issue is whether "secret" or confidential disclosures, or uses or sales that cannot reveal relevant subject matter, are prior art.

Elements - **including issues under discussion**

- ◆ **IT3 agreed** on a definition, based on a modification of one in SCP/10/4:
 - *The prior art with respect to a claimed invention shall consist of all information which has been made available to the public anywhere in the world in any form, before the filing/priority date of the claimed invention.*
- ◆ **IT3 agreed** there is no limitation on the criterion based on medium, language or geographical location of a disclosure.
- ◆ **An issue under discussion is whether graced PFDs are technically “prior art.”**