CORNERSTONES FOR HARMONISATION
A B+ SUB-GROUP / INDUSTRY SYMPOSIUM

RECORD OF THE PROCEEDINGS

Drawn up by the European Patent Office as Symposium Secretariat

Tuesday 20th June 2017
Munich, Germany

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"Cornerstones for harmonisation: A B+ Sub-Group / Industry Symposium"

Munich, Tuesday, 20th June 2017

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I. INTRODUCTION

1. Work on substantive patent law harmonisation is currently taking place in two fora: within the Group B+, and more particularly, the B+ Sub-Group and Workstreams, involving officials from patent offices and associated ministries, as well as the European Commission; and within the Industry Trilateral, propelled by users of the patent system.

2. In April 2014, the Industry Trilateral (formed of representatives from AIPLA, IPO, BusinessEurope and JIPA) created a harmonisation working group with the aim of reaching a consensus on a package of norms relating to the substantive issues of prior art, grace period, 18-month publication, conflicting applications and prior user rights, which could possibly form the basis for an international agreement.

3. The Group B+ and the Industry Trilateral ("IT3") are not geographically co-extensive: whereas the Group B+ encompasses all industrialised countries, only the U.S. Japanese and European users are represented within the IT3.

4. Thus, when the Group B+ decided at its Plenary meeting in October 2016 to mandate the B+ Sub-Group to organise a Users' Symposium which would be hosted by the EPO, it had two goals in mind: (1) inject momentum into the process, by providing a deadline for the IT3 to make the status of its work public; and (2) allowing users from other jurisdictions outside the IT3 to be informed of the progress made and, most importantly, be given an opportunity to provide input into the discussions.

5. From the outset, it was decided that the Symposium would not be an information event, but an attempt to foster dialogue amongst users, focused on the package proposed by the IT3.

6. Thus, the IT3 was requested to provide documents setting out the outcome of their work in advance of the Symposium. In early June, a paper entitled *Policy and Elements for a Possible Substantive Patent Harmonization Package ("*Elements paper*")* was issued, accompanied by 3 "Exhibits", on grace period, conflicting applications and prior user rights respectively. In parallel, the B+ Sub-Group drew up a Background Document based on its past work, providing additional information for participants to prepare for the discussions. Industry delegations from Australia (having liaised with colleagues in New Zealand), Canada and Korea were invited to prepare presentations outlining their reactions to the IT3 proposals. Representatives from *epi*, JPAA, KPAA, AIPPI and FICPI were also invited, and the B+ Sub-Group delegations (Australia, Canada, Denmark, the European Patent Office, Germany, Hungary, Japan, the Korean Republic, Spain, the United Kingdom and the United States of America), additional B+ Workstream delegations (France, Switzerland, and the European Union) and PPAC attended in an observer capacity.

7. The following is a Record of the Proceedings of the Symposium, where contributions to the discussions have been anonymised. The IT3 documents, B+ background Document and PPT presentations associated with this event are all

available on the B+ dedicated website: http://www.epo.org/news-issues/issues/harmonisation/group-b-plus.html

II. WELCOMING ADDRESSES

A. MR RAIMUND LUTZ, VICE-PRESIDENT, LEGAL AND INTERNATIONAL AFFAIRS, EPO

8. *Ladies and Gentlemen, it is a great pleasure for the European Patent Office to welcome you all here in Munich on the occasion of this Symposium. Substantive patent law harmonisation has been an ongoing project for over 35 years now, and whilst it has migrated from forum to forum and the approaches have varied, at no time have the users been at the forefront of progress as they are today.*

9. *The EPO's role in matters of harmonisation is to act as a facilitator, and we firmly believe that users should be driving the process. Thus, we are delighted to host this Symposium on behalf of the B+ Sub-Group. This event will focus on a draft proposal for a package of internationally harmonised norms, a work in progress, drawn up by the Industry Trilateral. This event will allow stakeholders from other regions of the B+ Sub-Group to provide input into the process.*

10. *The Industry Trilateral has been working hard on SPLH and we would like to extend our warmest thanks to them for agreeing to participate in this Symposium and present a current snapshot of the outcomes of their work. It has been a complex and difficult task, and the documents they have produced show that great strides have been made, with creative approaches and a degree of flexibility on all sides, and this achievement should be celebrated. Thus, we would like to extend our congratulations to the Industry Trilateral harmonization working group for their progress so far.*

11. *On the other hand, a number of square brackets indicate that agreement on a complete and coherent package of norms has not yet been reached, and thus, we hope that this Symposium may provide impetus and inspiration for further solutions to be considered, in order to address the issues which remain.*

12. *We from the European Patent Office would also like to extend a warm welcome to representatives from user groups and industry from Australia, Canada and Korea as well as to observers from Chinese Industry. We are grateful that you have made the long trip, and have also probably invested a considerable amount of time preparing for this Symposium.*

13. *Finally, we welcome the B+ Sub-Group delegations, and hope that they too will be inspired and guided by the discussions today in their further substantive work.*

14. *You will notice that the numbers of participants have been kept small: this is intended to enable a fruitful and dynamic dialogue to take place between users. Many of you represent associations, but you must also have personal opinions. In that respect, we wish to emphasise that a record of proceedings will be produced,*

but only in anonymised format, in order to increase the comfort factor for the participants. Consequently, we would like to encourage all participants to be spontaneous and engage in the discussion, bringing in their own voices where they feel they may constructively and creatively contribute to the dialogue.

15. *Thanking you all once again for having travelled so far and worked so hard in order to join us today and make this event possible, I wish you all an interesting, productive and enjoyable day.*

B. MS PATRICIA KELLY, DIRECTOR GENERAL OF IP AUSTRALIA, CHAIR OF THE SYMPOSIUM

16. *To begin, I would like to extend my thanks to the EPO for hosting this Symposium, looking after the logistics, co-ordinating preparation of the background documents, and for the substantial work they have undertaken over recent months to prepare for today's Symposium. I would also like to thank all delegations that have travelled from all parts of the globe to be here today.*

17. *As you know, our current patent system is underpinned by a number of treaties that establish the basic parameters for uniform patent administration across jurisdictions. Of course, patent rights are granted by sovereign nations, each with their own legal framework, but the parameters established by patent treaties set some basic rules for the international protection of inventions. They form a key part of the world trading system.*

18. *In a world where it is estimated that 87% of company values are made up of intangibles (up from 17% in 1975), the importance of IP is clear. A consistent set of rules around patent rights is an important contributor to efficient global trade and technology transfer.*

19. *I say this to remind us of the purpose behind today's Symposium. The patent harmonisation agenda has a significant history. Many of the people in this room have been involved, over many years, in efforts to progress patent harmonisation. The objective of those efforts is to benefit users of the patent system globally, to establish a more consistent and efficient system to facilitate global trade, investment and technology transfer.*

20. *Over recent years, there has been a renewed momentum for patent harmonisation. Fact-finding work by the Tegernsee Group provided a platform for further progress. My predecessor as Group B+ Chair, John Alty, sought to develop a constructive dialogue with users and industry groups. The aim was to work towards a consensus around key outstanding areas of jurisdictional difference in patent administration and policy.*

21. *The efforts of the B+ Sub-Group on patent Harmonisation and its various work streams, plus the work undertaken by the Industry Trilateral has engendered an optimistic mood, where there is a real sense that we may be able to find common ground.*

22. *The work of the B+ Sub Group seeks to culminate in release of a user consultation document which would feature a set of proposals for patent harmonisation as a basis for engagement with the broader user community.*

23. *The Workstreams did a tremendous amount of work to prepare a draft consultation document, which was considered at our last Group B+ plenary meeting in October 2016. However, that meeting recognised that there was value in providing further time and encouragement to the Industry Trilateral to develop common positions before embarking on consultation with the wider community.*

24. *The Industry Trilateral has put in concerted efforts over the last eight months to refine options and to seek common positions on the key issues.*

25. *Today's Symposium has before it a background paper prepared by the B+ Workstreams to inform our deliberations. I would like to thank the USPTO, the JPO, and the EPO for summarising their various Workstream documents. We also have a paper which summarises the status of work by the Industry Trilateral and I would like to acknowledge and thank that group for the substantial work they have put into preparation of this position paper.*

26. *Today presents an opportunity to engage with a broader group of users, to expose to them the issues and options under consideration. In addition to the Industry Trilateral Group representing users in the U.S., Japan and Europe, I am pleased to welcome industry representatives from Korea, Canada and Australia. We are also pleased to be joined today by industry representatives from China, which is the largest and fastest growing IP jurisdiction in the world and we look forward to engaging with China on these important issues.*

27. *Today's Symposium presents an opportunity not only to engage with a broader group of industry users but also with the key international IP-orientated organisations that have a keen interest and substantial experience and expertise in these issues and I also welcome them.*

28. *Our task today is a challenging one. In looking at three key areas for potential patent harmonisation, we are seeking to shape a package of proposals that could deliver a more consistent and effective system of patent administration across jurisdictions.*

29. *The papers before us today outline a range of options. To make progress, we need to narrow those options, to look at what might be broadly acceptable and find common ground. We need to approach today's discussions with that objective firmly in view. By seeking a clear and consistent set of rules across jurisdictions, we are also seeking to simplify the system for users. As we examine options today and look for compromise, I think we should also resist the temptation to add layers of complexity to the system in an attempt to accommodate a wide range of positions. There is a danger here that we could work against our own purpose.*

30. *Success today would be to see progress towards a broad consensus on preferred options for harmonisation. I am confident that with the wealth of*

knowledge and experience we have assembled in this room we have the ingredients for the rich consultation and constructive engagement that can facilitate positive outcomes. Thank you.

III. PRESENTATION BY THE INDUSTRY TRILATERAL

A. INTRODUCTION

31. The IT3 thanked the EPO and the Group B+ for providing an opportunity to present the status of their work and engage in discussions with stakeholders. The Trilateral Cooperation was initiated by the EPO, USPTO and JPO in 1983, and the Industry Trilateral was set up in 2003, composed of representatives from AIPLA, IPO, JIPA and BusinessEurope. The purpose of the IT3 was to set up a common agenda for discussions on policy matters. In 2014, work had been taken up on substantive patent law harmonisation ("SPLH") and since then, they had been working intensively to reach consensus on a limited package of SPLH issues that fairly balanced the interests of all entities (e.g. large, small, individuals, universities), in a patent system which encouraged innovation and protected innovators and third parties as well.

32. Achieving such a package was not easy, but the goal was that participants put their own laws aside and think out of the box, looking forward to a system in the future which was not necessarily tied to the laws currently in existence.

33. This meant that in some cases, one had to look at new ideas which would benefit all participants in the global market place, a uniform set of clear, fair and balanced principles applicable in all jurisdictions, without giving preference to any particular set of interests. The IT3 was attempting to do this through reaching compromises guided by best practices, in a consideration of a fair balance of the interests of applicants, third parties and society.

34. The Elements paper on a possible substantive patent harmonisation package showed where consensus had been reached with respect to the four main Tegernsee issues, as well as open issues where different alternatives were being explored. The IT3 was looking forward to the results of this Symposium in the furtherance of their efforts. This was a long-term project and the IT3 needed all the input it could get to achieve success.

35. The Elements paper issued in early June reflected a work in progress. The outcomes presented were subject to the caveat that the consensus achieved within the working group remained to be approved by the governing bodies of the respective associations. Square brackets and italics appearing in the IT3 documents indicated areas where there was disagreement or the lack of a solid consensus on the issue.

B. GRACE PERIOD

a) Policy considerations

36. The IT3 presented the outcome of their work, as consigned in their Elements paper and Exhibits. It was remarked that within the IT3, the majority of discussions had been spent on the grace period ("GP"). The GP highlighted an important conclusion in terms of trying to achieve a good harmonisation package: many jurisdictions had practices which prioritised different policies. Picking one jurisdiction's approach could not necessarily optimise all the policy considerations. This led the IT3 to look at modifying practices, and adopting new approaches which could meld and accommodate a variety of policies.

37. First, the high level policy considerations which were drivers for the GP proposal were mentioned. A consensus had been reached that there was a need for a GP to protect inventors and applicants against loss of rights resulting from pre-filing disclosures. This would be helpful for encouraging innovation. Additionally, it was agreed that unauthorised, unintentional as well as intentional disclosures should be graced. Intentional disclosures should be graced to avoid the need for patent offices and courts to assess the state of mind of the applicant, as to why a disclosure was made, which would create uncertainty for all users of the system. In addition, in many jurisdictions, discovery was not available, which would be necessary to assess the state of mind of the discloser. Another reason was that in some cases, smaller businesses and individual inventors might need to disclose their invention prior to filing to see the level of interest it would elicit, before investing in a patent application.

38. A number of benefits from a GP were listed: a pre-filing disclosure ("PFD") could accelerate innovation. Where there was early disclosure of the invention, without waiting for an application to be filed, the invention was publicised and people could build upon it immediately. Additionally, should a PFD preclude the grant of a patent, the innovator most excited about the invention and willing to invest and further work on commercialising it might be lost. In large companies, it was drilled into inventors to be very careful about the first-to-file system and not to disclose their inventions. On the other hand, individual inventors or smaller entities and universities had employees which might not be as well trained, so that they might inadvertently disclose an invention. The GP could be a safety net for that. Many large companies engaged in collaborations with less sophisticated smaller partners, such as smaller entities or universities. Again, the GP provided a safety net to preserve the investments made within these types of collaborations. Finally, it was recognised that the GP helped address the fact of the digital age and social media, so that many inadvertent or illicit communications could occur which might jeopardise patent rights.

39. With a GP system, there was a real need for legal certainty for third parties. They needed to be able to assess whether a PFD was prior art or a graced disclosure, to do product clearances, to assess whether to continue to practice an invention, get a license, design around it, or whether the invention was in the public domain.

40. For the public, in building an international GP, great care needed to be taken not to create a first-to-publish system. The GP was an exception to absolute novelty, and should contain mechanisms to either encourage the inventor to file first or promptly after a PFD, and discourage intentional PFDs from becoming the norm. Additionally, it was recognised that no additional patent rights should arise from the PFD.

41. There were a lot of competing interests, and it was hard to satisfy them all, but the IT3 had tried to prioritise and capture the elements which were the most important.

42. Within a global economy, a GP could only be successful if it was completely harmonised across all jurisdictions. In that respect, it was recognised that in order to create an international GP, all laws in all jurisdictions would have to change, at least to some degree.

b) Substantive elements

43. Regarding the recommended elements of a GP system, it was agreed that there should be a GP, extending from the PFD to the priority or filing date, whichever was earlier.

44. Discussions on the optimal duration of the grace period were ongoing. A period of 12 months was preferred by individual inventors, small entities and universities, whilst a shorter period of 6 months was preferred by jurisdictions which currently did not have a GP.

45. The GP should be limited to PFDs which originated from the patent applicant, but should also include derived disclosures or “re-publications” of a PFD by a third party.

46. With respect to the type of disclosure, it was decided that there should be no discrimination based on the type of media or form of the disclosure. A graced PFD could be in the form of a printed publication, a speech, a PPT presentation in a conference, etc. As to the scope of the GP, the PFD had to either originate from the inventor, or it could have been stolen or disclosed by a third party in breach of contract.

47. It was agreed that independent disclosures “always could be prejudicial”.

48. Third party disclosures were also addressed. If there was a portion of that disclosure which was re-published, that portion would be non-prejudicial. However, if there was a portion which was based on independent developments, then that portion would be potentially prejudicial, depending on how significant the difference was over the PFD.

49. In terms of dealing with intervening disclosures, it could be difficult to determine whether they were derived, or not, particularly in jurisdictions without discovery. Thus, certain presumptions were proposed, subject to rebuttal. Patent offices or third parties would always have the opportunity to challenge these presumptions.

50. In addition, it was agreed that a Statement should be filed, in order to claim the benefit of the GP. Exactly how often that Statement would need to be filed was subject to further discussion, which explained the presence of the word “unique” in brackets on the slide.

51. The IT3 wanted to encourage the filing of the Statement, and built in some incentives. One was a sliding scale of administrative fees, increasing the longer the applicant delayed filing the Statement.

52. Finally, discussions were ongoing on another benefit for third parties, namely that when a Statement was filed, the publication of the application would be accelerated to take place at 18 months from the first PFD, so that third parties would be on notice that the applicant was claiming the benefit of the GP. In the normal course of affairs, if publication of the application were not accelerated, there could be a delay of up to 24 to 30 months (depending on whether the GP was 6 or 12 months) before it could be assessed whether the PFD was a graced disclosure.

C. PRIOR USER RIGHTS

a) Policy considerations

53. The Objectives and Principles, agreed by the B+ Sub-Group and quoted in the B+ Background Document, mentioned that (1) *A third party who has started to use an invention in good faith prior to the filing of the patent application for the invention by another party, should have the right to continue to use that invention*; and (2) *The circumstances under which the prior user rights arise, including the extent to which they rely on actual use having taken place, should balance the interests of third parties to protect their investments with the interests of the inventor/applicant*.

54. It was agreed amongst the IT3 that the objective of a prior user right (“PUR”) defence was to balance fairly the interests of a third party who had made commercial use or serious and effective preparations for the commercial use of the invention, involving significant investment, without seeking patent protection of the invention (keeping it as trade secret), and those of an independent innovator (patent owner) who later sought to patent the same invention. It was agreed that third parties should not be penalized for selecting trade secret protection, and should be permitted to continue to use the invention, to the extent commercial use or serious and effective preparations had occurred before the effective filing date of the patent application.

55. The IT3 believed that a limited PUR defence to a charge of infringement should fairly and equitably balance the interests of third parties and patent owners. It should not go beyond what was necessary for the entitlement to or the proper scope of the PUR defence.

b) Substantive elements

56. The requirements regarding third party activities needed to be defined. A fundamental qualification was that the third party had to have actually used or made serious and effective preparations to use the invention covered by the claim of the subsequent patent prior to the effective filing date. The IT3 believed that the magnitude of the investment based on the activity conducted prior to the effective filing date should also be considered. Such investment had to be directed to the commercialization of the invention, not to basic research or the acquisition and preservation of knowledge about the invention. The qualifying activities had to be directed to the entire invention as set forth in one or more claims of the patent, not only part of a claim. The qualifying activity could also be conducted through various business arrangements. A third party who asserted the PUR defence would bear the burden of proof.

57. It was clarified that third party activities occurring after the effective filing date, ie priority or filing date, would not qualify for the PUR defence.

58. Regarding the qualification of the activities by the third party, activities which were independent of any disclosure by/for/from the patent owner or inventor would qualify for a PUR defence. It was agreed, however, that activities based on an abuse of or a breach of confidence against the patent owner would not qualify.

59. Discussions were ongoing regarding whether as a general rule, activities based on a PFD by/for/from the patent owner or inventor accessed in good faith would entitle the third party to the PUR defence or not.

60. As far as the geographical scope was concerned, the qualifying activity had to occur in the same jurisdiction as that covered by the granted patent against which the PUR would be asserted.

61. The scope of the PUR should be limited to what was reasonable to protect the investment in the use or serious and effective preparations made by the third party.

62. The IT3 proposed that further issues going to the scope of the defence provided to a third party should be determined by the Courts on an individual basis. However, the IT3 had listed several practical factors which should be considered to determine the scope of the right, such as design changes and improvements, changed sales or production volumes and abandonment. The PUR defence should permit continued use of the invention on a limited basis, and should not extend to embodiments which were not the subject of the preparations.

63. All patent rights should be subject to a PUR defence without exceptions.

64. In principle, the PUR defence was not transferable by assignment or licence, other than to the patent owner, or to a purchaser of the entire business of the third party, or the relevant portion of the third parties' business in which the invention was being used.

65. The IT3 wished to have a discussion on the situation where the activities of the third party were based on information derived from the applicant: a PFD was made by the patent owner, and qualifying activities of the third party began after this, and the third party could have had access to a graced PFD. Some members of the IT3 believed that the third party who derived knowledge of the invention innocently and in good faith, including through access to the PFD, should be able to claim a PUR based on his activities. Others did not. A third option would be to require that the third party show activities which included independent development to be able to qualify for the defence. Some believed that third parties should know that the innovator having made a PFD might seek patent protection, and that only a third party who both did not know about the PFD and did not rely upon it should be considered to be in good faith.

D. CONFLICTING APPLICATIONS

a) Policy considerations

66. The treatment of conflicting applications was a technically difficult topic, with a number of unresolved issues still under discussion within the IT3. However, a consensus existed on fundamental objectives and principles. The IT3 saw a need to prevent the grant of multiple patents on substantially the same or identical inventions in the same jurisdiction and to minimize the risk for third parties of multiple enforcement proceedings, while acknowledging the need to permit protection for incremental inventions of an appropriate scope.

67. Consistent with a first-to-file policy, where there were two co-pending conflicting applications, one filed earlier than the other, but not published at the effective filing date of the later application, the earlier application didn’t fall into the normal prior art categories, but still needed to be taken into account during examination. Where the claimed invention in the two applications was identical, claims could be rejected for "double patenting”.

68. However, where there were incremental differences between the claimed inventions, the IT3 acknowledged a need for a clear and uniform standard to determine whether both could be patented in the same jurisdiction. Here, the IT3 had drawn up alternatives which needed further discussion.

b) Substantive elements

69. Looking at the situation where both applications had been filed by the same applicant, the IT3 were still discussing whether one should have prior art effect against the other or not. Should they have prior art effect, applications by the same applicant would be available as prior art at least for novelty purposes, so the aim of not having multiple patents for the same invention would be achieved.

70. If the scenario of unpublished applications not having prior art effect for subsequent applications by the same applicant were adopted, anti-self-collision would apply. That period for anti-self-collision would be 12 or 18 months after filing, a matter still under discussion.

71. In the case of an unpublished application by an applicant and a third party's later application, the earlier application should be prior art. The following alternatives were being discussed: whether (a) there should actually be a higher standard or distance for patentability for the second application, between a first application and a later one by a third party, or (b) there should be equal treatment when considering two applications either from the same applicant, or one from one applicant, and another from a third party.

72. However, there was agreement that the distance for patentability should go beyond common general knowledge based on the earlier application. In shorthand form, the patentability difference would be "novelty + common general knowledge".

73. Further measures needed to avoid double-patenting were still under discussion. Areas of discussion currently included terminal disclaimers, which would bring a need for common ownership requirements between the two applications. Whether an explicit double-patenting prohibition should be included was also being discussed.

74. Another area under discussion was the treatment of PCT applications. There were two options: PCT Applications being treated as prior art in all offices for which there was an active designation, at the time of publication of the PCT application; or treated as prior art only in offices in which there had been entry into the national or regional phase. To conclude, much remained to be discussed by the IT3 in the area of conflicting applications.

E. PRIOR ART

75. In the Elements paper, the prior art section was entirely in italics. The IT3 agreed that it was an important topic which should be considered by both industry and offices, but had not yet come to a final conclusion on the content of that element.

F. DEFENCE OF INTERVENING USER

a) Policy elements

76. The IT3 was considering the Defence of Intervening User ("DIU"), which was an attempt to think outside the box, to identify potential solutions taking care of concerns for applicants as well as third parties.

77. An important issue which arose with the adoption of an international GP was the manner in which legal uncertainty could be reduced for third parties. This was a consistent theme throughout both the B+ Workstream and IT3 papers on the matter. The uncertainty in this case was mostly for third parties who wanted to know whether a PFD was graced or not.

78. There were different approaches. Under the EPC, the situation was very simple. There was no GP, which definitely afforded legal certainty. Once an application was published, one could look at the date of an item of potential prior art and determine whether it was published before the filing date and was thus prior art,

or not. In the U.S., which had a 12-month GP, where a publication occurred prior to the GP, there was legal certainty because at the application's publication one could determine that it was prior art. However, there was uncertainty in the U.S. with regard to anything published within the GP. Japan, which had a 6-month GP, took a different approach again: a declaration had to be filed at the time of the application. If the PFD was not listed, the application was lost. The result was that at the time of publication of the application in Japan, there was legal certainty.

79. The IT3 was proposing a system which did not result in loss of rights, but preserved legal uncertainty for third parties. Thus, the goal was to attempt to reduce that legal uncertainty, by encouraging applicants to provide notice of a graced PFD. One of the ways to reduce legal uncertainty was to ensure that the applicant would file an application promptly after the PFD, allowing third parties to know very quickly after publication of that application, whether a PFD was graced or not. It was proposed that applicants file a Statement giving notice that a PFD was graced.

80. It was important to recognise that not all PFDs needed to be graced. For example, where an invention comprised ABC, but the PFD comprised only A+B, it didn't anticipate, and it was argued that in all likelihood it would not be combined with another element of prior art to be relevant for inventive step. Thus, the proposed system provided some flexibility in that regard. It was also proposed to provide limited rights to third parties who might be disadvantaged by the lack of notice of a graced PFD through this DIU, a defence similar to the PUR. Unlike the PUR, however, it would become available after filing, and the Statement would be accompanied by an administrative fee to encourage early filing and disclosure.

b) Substantive elements

81. The key requirements for the proposed DIU were: the applicant (a) made a PFD within the GP; (b) failed to provide timely public notice that the PFD was graced; (c) later claimed the benefit of the GP, but the third party had begun serious and effective preparations for commercialisation of the invention during the critical period, i.e. 18 months after the disclosure date of PFD (preferred approach), and prior to the publication of the Statement. There was an alternative: that the critical date would begin upon the filing date of the application. The applicant could shorten this period for third parties to qualify for the DIU by filing the application as soon as possible after the PFD, by filing a Statement along with the application and/or by requesting early publication. If there was a filing immediately after the PFD, or accelerated publication was requested and the Statement filed, the likelihood that a third party could perform an activity which would qualify for a DIU within the critical period became very small to non-existent. Thus, this system would encourage early filing of the application after a PFD.

82. The legal principles to qualify for a DIU were fairly simple. One approach under discussion was that the PFD would not need to have been seen by the third party, since subjective factors should be avoided. An alternative was that there would have to be reliance on the PFD. The third party activity during the critical period qualified the third party to benefit from the DIU. But the DIU would not

accrue for the third party unless the applicant claimed the benefit of the GP, tso that the DIU was perfected only if the applicant gave notice that the PFD was graced.

83. The third party benefited because he enjoyed rights which were similar to the PUR. It was essentially a licence to continue using the invention without any royalty. The limitations were also very similar: the DIU was personal and not transferable, limited to the jurisdiction of the patent right against which it was being invoked, and limited by the claimed invention that defined the right.

84. Nevertheless, even if the third party qualified for the DIU through activity in the critical period, legal uncertainty remained until the publication of the application took place. The publication provided "time certainty", i.e., any PFD made more than 12 months before filing, constituted prior art. However, it did not provide "GP certainty", unless a Statement was filed and published, and the GP was claimed.

85. Thus, GP certainty was obtained only when a third party saw a Statement by the applicant identifying a PFD as graced, an examiner cited a PFD and the applicant claimed the benefit of the GP, or when a third party filed a third party observation during prosecution citing the PFD or a third party filed a request after grant to remove uncertainty as to a PFD. Here, there were two issues: qualifying for the DIU and the DIU being perfected by the applicant's claiming the benefit of the GP.

86. To conclude, the DIU provided a strong incentive for applicants to: (1) file an application quickly after a PFD; (2) file a Statement; and (3) request accelerated publication of applications. It thus provided protection for third parties who invested in a newly published technology and took the risk after 18 months that the technology was not being patented.

87. Discussions were ongoing within the IT3 regarding: (a) the beginning and end of the critical period; (b) the duration of the GP, and (c) the requirement that the third party must have relied on the PFD to qualify for the DIU.

IV. PRESENTATION FROM AUSTRALIAN / NEW-ZEALAND INDUSTRY

88. Drawing on their experience with the patent system, the Australian industry representatives emphasised that an aspect spanning all three areas discussed was that from a users' point of view, excessive complexity of the system could make it difficult to understand and might amount to a disincentive to use the patent system at all. Thus, there might be some benefit to scrutinising the various options and, where possible, to shear away some complexity.

A. GRACE PERIOD

a) Duration

89. A 12-month GP was preferred, which, according to their experience under the Australian law was an appropriate period, especially considering that SMEs and individual inventors did not have at their disposal sophisticated systems in place

for controlling disclosures, for recording PFDs or filing patents in a timely fashion. In their view, if the aim of the GP was to provide a safety net for those types of users, 6 months would not be sufficient.

b) Statement

90. This raised the issue of not unfairly prejudicing third parties in relation to those disclosures. First, reservations were expressed from a practical point of view about the use of a Statement, which, depending on the degree of detail required, might be onerous for applicants. Moreover, in a litigation context, a Statement might be used as a trigger for speculative discoveries or perhaps be deployed as an admission.

91. However, a practical and simple way to implement a disclosure Statement would be on filing of the priority document: the applicant could be required to tick a box to indicate whether the GP was being relied upon and, if this was the case, to specify the date of the disclosure and the geographic location. This basic information provided by the applicant could form part of bibliographic data and perhaps be associated with an INID code. This solution would provide a prompt to applicants not having a due diligence system in place to ascertain PFDs. It would also provide third parties with a certain level of information permitting searches to be conducted within 12 months of the PFD. It was however important for the Statement not to be prejudicial or lead to loss of rights: the representatives referred to a case experienced in practice where a patentee assumed that a disclosure was confidential but full records were not kept and much later in a litigation context after a full forensic discovery exercise, there were doubts as to whether the disclosure was confidential or not. Since the purpose of the GP was to protect applicants in such circumstances, it would be unreasonable to expect them to submit a complete Statement at the filing date in the absence of a full forensic discovery exercise. Accordingly, in the Australian representatives' view, a Statement should not be taken as an admission that the disclosure occurred publicly and the applicant should be able to identify and list other disclosures if they emerged following a more rigorous discovery exercise.

92. Amendments to the Statement or late Statements should however be subject to the imposition of administrative fees, even significant ones, to incentivise a full and a proper disclosure at the time of filing of the priority document.

c) Accelerated publication

93. In the context of that approach, doubts were expressed about accelerated publication, which was considered to introduce a layer of complexity and a potential source of publication errors. Additionally, the advantages might not be significant in circumstances where the 18-month period did not run from the earliest disclosure because the earlier PFD was omitted from the Statement due to the absence of a full forensic discovery exercise.

B. PRIOR USER RIGHTS

94. However, there was another aspect to the protection of third parties: protection prior to the filing of the application, under PURs. The GP was only a safety net and did not affect PURs. It was important that PURs be recognised in a realistic fashion including during the GP and for uses derived from graced disclosures. Third parties might make a re-disclosure which was derived in part from the graced disclosures and in part from the third parties' own work. The representatives had doubts about the suggested approach that a disclosure of that kind should only be partly graced. That disclosure would indeed not be a truly independent disclosure: it might not have happened, but for the graced disclosure, and this was an example where increased complexity was unnecessary and possibly even undesirable. The representatives however stated that they had no experience with this particular scenario, since in Australia third parties in that case would in any event benefit from PURs.

95. With regard to the PUR protection, two matters were highlighted: (1) the question of whether the use could be based on derived knowledge and (2) the extent to which the embodiment put into practice by prior users could be varied.

96. As to the first point, PURs were an important counterbalance to the GP: while the GP provided a safety net for applicants, PURs provided certainty for third parties who acted in good faith on the strength of those disclosures. PURs were therefore an important part of the package to make the GP palatable for third parties.

97. As to variations of embodiments, cases had been seen in Australia where prior users in the natural and ordinary pursuit of their business considerably varied their production or process. Many years might pass between prior use and a court action for infringement and that in that time frame technology did not stand still. The representatives further urged participants to be open to principles permitting variations of embodiments, such as the ones recognised in the UK and DE, which were mentioned in the B+ Background Document. The enquiry should be guided by the question of what was the nature of the invention in possession of the prior user. On the one hand, the natural development of that invention should be permitted as it stood in the possession of the prior user. On the other, a line should be drawn against a development which owed its existence to disclosures by the patentee or in the form possessed by the patentee. The representatives emphasised firmly that they were not advocating a subjective test, or a subjective factor in the test.

98. One methodological difficulty with a factorial approach to a question of this kind was that there was no method for weighing the factors, and a factorial approach was not a particularly certain one. That was exacerbated when one of the factors was subjective. There could be an enquiry as to whether the prior user subjectively borrowed from the patentee's disclosure. Once there was an enquiry of that kind, there was a quantum of difference from a litigation point of view because it opened up a substantial prospect of discovery and evidence which perhaps was unlikely to benefit from the resolution of the question commensurately with its costs.

C. CONFLICTING APPLICATIONS

99. The principal issue addressed was the interplay between on the one hand the question of whether the secret prior art ("SPA") was available for novelty purposes only or included inventive step and on the other hand the use of anti-self-collision and terminal disclaimer mechanisms. There was a relationship between those questions: assuming that SPA was available for novelty only, incremental inventions, whether filed by the same applicant or by a third party, would not be blocked by the SPA. Thus anti-self-collision did not seem to be required. By contrast, if SPA was relevant for inventive step purposes, then potentially an applicant's own SPA could block protection for a later incremental invention. On that basis, the novelty only approach offered the advantage of simplicity since it did not require any corrective mechanism (anti-self-collision) and it appeared to provide acceptably fair results.

100. A potential disadvantage was that it might allow for multiple incremental inventions held by different parties which were not separated in distance by any inventive step, which was contrary to the inventive step requirement as a guarantee of patent quality. Nevertheless, such an approach applied fairly because it was to the benefit of both applicants and third parties. Furthermore, it also recognised a practical reality: the patent drafter was not able to draft the specification and claims appropriately without knowledge of the prior art. Thus, from a user point of view, a full inventive step test was not entirely fair. However, the same might not apply to an enlarged novelty test and in theory at least, the representatives saw potential scope to accommodate that. There was some merit in an approach to SPA which was confined to novelty or perhaps enlarged novelty, thereby alleviating the need for anti-self-collision or terminal disclaimers.

101. Finally, with regard to PCT applications, a preference was expressed for PCT applications becoming SPA only upon entry in the national phase, but it was recognised that there were arguments for the alternative, which was that PCT applications became SPA upon their publication for all countries with active designations. The delegation was open to discussion on that point.

102. To conclude, there were ways to achieve a system which was not prohibitively complex for users but rather simple enough to provide an incentive to use the system rather than a disincentive to use the system and which also delivered a fair approach. With regard to the GP, a trimmed-down disclosure Statement provided upon filing the priority document and incorporated in the bibliographic data would be workable but would need not to be prejudicial, so as to avoid "ambit drafting" which might be an inevitable consequence in practice, and also to ensure it did not fall into the traps of a bait for discovery or unforeseen admissions in litigation.

103. As a counterbalance to the GP, PURs should apply where third parties derived knowledge from the applicant in good faith. The challenge was to formulate the right to vary embodiments to distinguish a legitimate development of the invention from the variations which were due to the patentee's technological contribution.

104. Finally, with regard to conflicting applications, if the use of prior art was limited to novelty only or perhaps enlarged novelty, it provided the advantage that the anti-self-collision and the terminal disclaimers mechanisms would probably not be necessary.

V. PRESENTATION FROM CANADIAN INDUSTRY

105. The Canadian industry representatives represented a broad spectrum of users, were new at this harmonisation process and the time had been short to canvass the members of their associations on the issues, so that their presentation contained preliminary considerations and that a number of issues required further reflection and discussion. They thanked the B+ Sub-Group and the Industry Trilateral for the quality of the documents which had been circulated prior to the Symposium. While they were in general agreement with IT3's stated objectives and principles, their silence on specific points should not be taken as either agreement or disagreement with the underlying point. Moreover, it was emphasised that all elements of the package should be aligned and fit together coherently at the end of the process, given the level of interconnection between the three topics. The representatives expressed the hope that they would be part of the discussion going forward, so as to engage in deeper thought on these issues.

A. GRACE PERIOD

106. Canada had a long experience with the GP. It was originally 24 months, but was now 12 months, calculated from the filing date of the patent application. In their experience, litigation had focused in particular on two concepts: (1) whether the disclosure had become publicly available in Canada or elsewhere; and (2) who had made the disclosure. Under the Canadian statute, the disclosure had to be made by the applicant or by anyone deriving knowledge directly or indirectly from him. It was important to create a system which provided legal certainty for all users, and remove as much subjectivity as possible from these elements, ensuring that there was as much objectivity as possible in the resulting norms.

107. The representatives found coming to a consensus on several issues to be a challenge, so that further reflection was needed. One such issue was that of the Statement. In Canada, a Statement was not required: further information was needed to understand whether the Statement was an appropriate mechanism or the only mechanism to provide the legal certainty all users craved. In particular, the following issues were still under discussion: (1) the content of the Statement; (2) the timing of its filing; (3) its impact; and (4) the consequences in case a PFD was omitted from the Statement. Would the Statement have a prejudicial impact or not? All this needed to be balanced against the potential administrative burden for applicants. The concern was not so much for large multinational corporations already dealing with a patchwork of systems around the world, which usually had communication disclosure policies and standard operating procedures already in place, but rather for smaller users. The importance of ensuring that smaller users

retained the ability to access the GP and the patent system without added administrative burden was emphasised.

B. CONFLICTING APPLICATIONS

108. The Canadian industry representatives generally agreed with the objectives and principles stated by the IT3, subject to further consideration of some specific points. They agreed that unpublished applications by the same applicant should have prior art effect against their later applications, subject to some sort of an anti-self-collision exception. These two objects might appear to be in conflict and to a certain extent they were: the balance was to have an initial time period from which the anti-self-collision would apply and subsequent to that time period it would be treated as any other application, assuming that the first filed application was not yet published.

109. There was no agreement for the moment on the duration of the anti-self-collision (12 or 18 months): further consideration was required to assess the full parameters of anti-self-collision, including how prior art would be applied consistently across jurisdictions (for example whether for novelty only or also for inventive step or how novelty plus common general knowledge would be applied).

110. Moreover, while published applications generally should be available as prior art against the applicant and third parties, it was necessary to carefully assess the impact of data publication, including the effect of any accelerated publication, on the anti-self-collision time period.

111. Furthermore, either a terminal disclaimer or an anti-double patenting provision should be present. Even if in Canada an anti-double patenting scheme existed, practitioners were also familiar with the U.S. terminal disclaimer scheme due to the high number of Canadian applicants filing in the U.S. In their preliminary view, the terminal disclaimer scheme was preferable since it appeared to provide more clarity than a test for anti-double patenting. However, further consideration was to be given to the terminal disclaimer mechanism, to identify and better understand which aspects could be used in harmonisation.

112. Finally, with regard to the treatment of PCT applications, they considered the “active designation” alternative less problematic than the “national stage entry” option, as it reduced the chances to have the same or substantially the same invention granted to different individuals.

C. PRIOR USER RIGHTS

113. The objectives and principles stated in the IT3 paper were generally agreed with. With regard to PURs, the importance of creating a balanced and fair system which met the basic objectives of the patent system was emphasised. The importance of predictability and certainty were stressed. The determinations which should be made in establishing a PURs regime should be objective in nature, not subjective, or requiring resort to the courts for users to determine

where they stood. The importance of examining the norms here as a package and not as individual elements was recalled.

114. The PURs were described as accruing for third parties acting “innocently” and “in good faith”. Barring any situation of illegality, such as theft of information, or breach of confidence, an assessment of good faith seemed to import an element of subjectivity.

115. As to the requirements for accrual of PURs, the definition used in s.56 of the Patent Act in Canada, where something was “purchased, constructed or acquired” appeared more objective than if it had to be determined whether “serious and effective preparations for commercial use” had been made. In any event, it was important that it be possible to have a black-and-white determination of whether there was a PUR or not without having to head to court.

116. It was agreed that PURs should only apply when the third party obtained or used the relevant knowledge of the invention in a legal way. Further consideration was necessary to decide whether PURs should apply where the third party derived knowledge of the invention from a PFD of the patentee in good faith.

117. The Canadian industry representatives shared the IT3 view that where the use of the invention was abandoned, the PUR should be lost. The critical date for accrual of PURs should be any time before the actual filing date or the priority date, whichever was first. With regard to the territorial scope, PURs should only be effective within the jurisdiction in which the rights had accrued. Moreover, there should be no exceptions to PURs: they should apply without discrimination as to the type of patentee or subject matter. Finally, it was agreed that the third party should have the burden of proof, as long as this was assessed on an objective basis. There was a need for attorneys to be able to give meaningful advice to their clients, and it was not helpful to state that one had to head to court to determine the rights of the prior user. Third parties should be able to make that determination on a set of principles which were as objective as possible. Further consideration was needed with regard to the transfer of the PUR.

118. Regarding the scope of the right, the Canadian provision seemed to be relatively narrow, and could probably benefit from being expanded to be a more general clause. Within the harmonisation exercise, the Canadian representatives did not believe that it should be left up to the courts to determine the factors which determined the scope of the PUR. The factors should be enumerated in order for parties to be able to identify where they stood. The possible weighting of these factors might be a further interesting enquiry as well. Moreover, PURs should be limited to the patent claims on the product or process covering the invention used by the third party, for which the PUR accrued, and should not necessarily extend to the entire scope of the patent. Finally, further consideration was required with regard to whether the third party should not be permitted to modify the underlying nature of its business, as it was not altogether clear what was meant by that clause.

VI. PRESENTATION FROM KOREAN INDUSTRY

119. The KINPA representative stated that the presentation was to be considered as a starting point and that some issues were still under debate. A more formal document would be provided in the future. KINPA was a non-governmental organisation formed in 2008, which worked to improve IP competitiveness though collaboration and sharing of expertise among its members. It was composed of seven committees and last year, it had formed a task force for IP5 matters. KINPA had more than 140 members (both large companies and SMEs) representing a wide spectrum of technologies.

120. The KINPA representative stated that his association was basically in agreement with KIPO with regard to all major points.

A. PRIOR ART

121. KINPA was willing to accept WIPO's SCP 10/4 definition of prior art as a starting point, with the modification to the text concerning the filing/priority date. However, further discussion was needed with regard to the definition of "made available to the public anywhere in the world in any form".

122. KINPA believed that disclosures made in secret or covered by a confidentiality agreement should not be prior art. It further opined that there should be no limitations as to the medium, language or geographical location for how the disclosures were made, as this made matters simpler.

B. CONFLICTING APPLICATIONS

123. KINPA believed that the first applicant and a subsequent third party should be treated differently. With regard to the distance between the SPA and the application subsequently filed either by a third party, or by the same applicant: where there was no distance, a double patenting issue had to be addressed. In Korea, an anti-double patenting provision applied. In case of a short distance between applications, KINPA supported anti-self-collision being available to the first applicant. Finally, for third parties, a greater distance should apply. In Korea and in Japan, an "enhanced novelty" standard applied. The representative understood that many jurisdictions were uncomfortable with this standard, and that it was hard to define. In this regard, KINPA was willing to discuss and agree on a more global standard for measuring distance. With regard to the treatment of PCT applications, KINPA preferred the "active designation" option, just from a practical standpoint, but was open to discuss the details regarding this matter.

C. GRACE PERIOD

124. The KINPA position on the GP was that a 12-month duration would represent a better safety net, especially for SMEs, universities and sole inventors. The GP should cover all types of documents to better ensure policy objectives (with no exclusion of patent publications, unlike what was currently done in Korea). KINPA was moreover in favour of a Statement for a global GP, which would certainly represent a burden for applicants but would better balance the various interests. In particular, KINPA showed appreciation for the proposal of the representatives

of the Australia and New-Zealand industry with regard to the check box, but believed that having the Statement was better for the balancing of interests, as long as the burden could somehow be minimised. Administrative fees, accelerated publication and the DIU were still being debated within KINPA.

D. PRIOR USER RIGHTS

125. KINPA was comfortable with the inclusion of the concept of "serious and effective preparations" giving rise to PURs. As to the condition relative to whether the activities were independent or occurred in good faith, or both, further discussion was necessary. No special exceptions should be made, not even for patents owned by universities.

126. Finally, KINPA would be in favour of a mandatory publication of patent applications at 18 months, subject to certain exceptions (e.g. national security, public order etc.). As to the possibility for an applicant to request early publication, no position had been agreed.

127. The Chair concluded that a good indication of the issues and approaches in the broader community had been provided and welcomed the indications from the various groups that they were willing to discuss and consider a range of options which might not be reflected in their jurisdictions.

VII. USER DISCUSSION

128. The Chair welcomed participants back to the second session which was intended to allow free flowing discussion on the issues presented in the morning, and questions and answers regarding the proposals presented. However, first, the Chair wished to allow the other associations represented the opportunity to present their views.

129. One participant made a personal observation that, when reading the B+ Background Document, detailed arguments were presented for and against the GP. Yet so far, no one had spoken against the GP in principle, although clearly, many issues needed to be addressed and philosophical differences navigated.

A. AIPPI

130. The AIPPI representative recalled that in 2013, the AIPPI had passed a resolution on the GP. It was in favour of a 12-month safety-net GP, covering disclosures by the inventor or his successor in title, regardless of whether the disclosures were intentional or not. AIPPI's position was that no Statement should be required, but it was noted that this was a very finely balanced position. Having heard the positions and explanations in this forum, AIPPI would be happy to go back and consider it as part of an overall package. The reason that AIPPI concluded that no declaration should be required, was that there were detailed discussions about what it should contain, when it should be filed and what the sanctions should be, and those issues had been well canvassed by the B+ Workstreams and the IT3. Provided the requirement was reasonable and the

sanction was not unduly harsh, the AIPPI might be able to consider the Statement as part of a compromise package.

131. On PURs, the AIPPI position was largely in agreement with the IT3 position. A personal observation was that the DIU seemed quite complicated. It was understood that it could be an attractive balancing concept, but a concern was that it was quite a complicated system which would receive quite limited application. The Australian industry delegation's approach was endorsed: a harmonised system should be simpler, rather than more complicated.

132. At its recent June meeting, the AIPPI Executive Committee had selected conflicting applications as one of its case studies, which would lead to a resolution at its Cancun Congress in 2018. One of the reasons for this choice was that the AIPPI was well aware of the discussions in the B+ and IT3 fora, and wished to contribute an established position, based on the input of all its member groups. All the work which had come out of the B+ Workstream and IT3 was expected to be extremely useful in helping shape that study and move towards a harmonised position. The AIPPI was grateful for all work which had been done, which would give it a head start in studying this issue.

B. FICPI

133. The FICPI representative thanked the organisations which had produced impressive work in a very limited time. Whilst unable to give the FICPI position on all aspects of the proposals, the FICPI position on the GP expressed in its White Paper of 2013 was recalled, and in particular the fact that FICPI was in favour of a GP which should be an exception to the regime of prior art. This entailed a GP designed as a safety net, a strictly limited exception. For FIPCI, the GP and PURs worked together and were two elements which could not be separated. The fact that the GP existed could not prevent third parties from obtaining PURs, including during the GP. According to the FICPI position, the duration of the GP should be 12 months. The White Paper still left the issue of the reference date open, (i.e. whether the grace period should be calculated from the filing date, or, from the priority date, if applicable). It was recognised that there were arguments for and against both approaches. Any PFD under any form caused by the applicant or derived from the applicant should be graced. FICPI generally recognised the merits of the Statement but considered that generally, the system should be simple and directly reliable, and thus did not particularly endorse a Statement, and believed that it should not be mandatory.

134. FICPI still had work in progress on a draft position paper on PURs, which it viewed as a necessary complement to the GP. Regarding the features of PURs: either the actual person or the business unit having engaged in the prior use should qualify for PURs. FICPI did not endorse the French approach requiring mere intellectual possession of the invention. Actual use or at least effective preparations should be required, and a standard for effective preparations should be defined. At the priority/filing date, the prior use or preparations should be ongoing. A sporadic exploitation should not be adequate to generate PURs. PURs could be acquired through activity based on an independently developed invention, or on knowledge of the invention derived from the original PFD of the

applicant, as long as there was there was no breach of confidentiality. Regarding the scope of the right, only minor modifications should be permitted. There was room for further work to define a standard, whether relative to standards of patentability or other standards. Here there was a question of distance to the original use, and FICPI's view was that such distance should be very small. It was expected that the FICPI position paper on PURs would soon be published.

135. FICPI currently had work in progress regarding conflicting applications within a Working Group and thus, the representative could not provide any substantive input or a FICPI position on these matters.

136. Finally, regarding the DIU, a personal observation was that while this approach seemed to be very relevant and a provision which fitted into the general scheme proposed, it could potentially increase complexity, and although it was too early to express any official opinions on this point, it was recalled that FICPI generally favoured solutions which offered simplicity.

C. EPI

137. **Epi** was the Institute of Professional Representatives before the EPO, founded by the Administrative Council of the European Patent Organisation in 1977. The **epi** had always been in favour of international patent law harmonisation: this was natural, as the Institute itself resulted from a harmonisation in Europe. When the **epi**'s fathers thought of creating a European patent after WWII, they quickly realised that harmonisation was a prerequisite.

138. The IT3 position had been promised long ago. It was not available when the **epi** Council met, and was received only half an hour before the end of the meeting of its Harmonisation Committee. Thus, **epi's** comments today had to be taken as provisional. In this vein, the **epi** representatives were impressed by the quality of the presentations from the Australian, Canadian and Korean representatives.

139. Basically, **epi** had always inclined to a harmonisation that led to the prior art being identical in all States and with respect to all applicants, thus aiming at the same patent being granted to the same applicant in as many States as possible. Thus, **epi** favoured a harmonised whole contents approach, with no provision for anti-self-collision.

140. Also, **epi** always preferred the options that offered the highest level of legal certainty for third parties. In particular, its view was that the introduction of a GP would complicate the procedure and lead to legal uncertainty.

141. Also, **epi** supported the view that conflicting applications should be prior art for novelty only, because this option offered better legal certainty; whether the approach to novelty was sometimes too strict at the EPO was another debate. The Institute further supported international applications being prior art as from their date of priority/filing, as soon as they were published, without requiring entry in a national phase or, *a fortiori,* publication of a translation. International applications were published after 18 months, and **epi** supported the position that

publication should take place at 18 months worldwide, as much as possible associated with provisional protection.

142. Thus, whilst **epi** remained opposed to the introduction of a GP, it had long indicated that it could consider a GP as a *true* safety net, as part of a harmonised system comprising a *true* first-to-file system with the following features: (a) a duration of 6 months preceding the priority date, the shortest possible duration; (b) a mandatory formal declaration; (c) mandatory third party rights; and (d) the wrongful publication of an application by a patent office should be graced.

143. Regarding the IT3 position, the representative noted that there appeared to be no agreement on a definition of prior art, although the definition in WIPO's document SCP/10/4 was an obvious starting point: it was clear that what was important was the definition of non-prejudicial disclosures (in other words, whether and to what extent disclosures should be graced).

144. Regarding Exhibit 1, the **epi** could basically support the objectives and principles, which included to "Provide a Safety-Net Grace Period that Discourages a Publish-First Priority". However, it was noted that the individual elements proposed were far from resulting from this principle. The Institute's understanding of Exhibit 1 was that the proposed system was engineered to work to the advantage of the inventor/applicant disclosing his invention, leading away from the very principle of a safety net. To cite one example, certain presumptions were made in case of third party disclosures, but the third party in question was by definition not a party to the proceedings, and other third parties even less.

145. As far as Exhibit 3 was concerned, PURs needed to be provided as a balance, as explained in that Exhibit. The Institute believed that PURs were what characterised a GP as being a safety net: the mere possibility of third parties acquiring rights encouraged the filing of an application at the earliest possible date. Thus, increasing PURs would favour the use of a GP only as a safety net. Experience showed that they had limited use. More detailed comments were saved for the afternoon sessions.

D. JPAA

146. The JPAA representative commented that technical inventions had no borders, just like art had no borders. Thus, patent protection should accrue globally and evenly under the system of absolute novelty. This was considered to eventually contribute to the establishment of an effective international patent portfolio for users. However, in reality, patent protection for one technical idea, differed from one country to another, depending not only on differences in language and requirements for patentability, such as the level of inventive step or the description requirements, but also on differences in the system of the GP and conflicting applications. Accordingly, in order to eliminate more of these causes of differences in patent protection, a higher level of harmonisation of these systems was desirable.

147. The Chair opened the floor for general discussions.

E. GENERAL DISCUSSION

148. One European IT3 member recalled the comment which had been made by one participant that there had been no positions taken against the GP, and observed that this had now taken place with **epi**'s intervention. He emphasised that the documents presented by the IT3 did not reflect all the details of the very intense underlying discussions which had taken place. Germany and the German IP community saw some serious disadvantages to the GP, particularly regarding legal uncertainty for third parties. But as a compromise, Germany accepted the negotiation of a GP, provided it was a safety-net.

149. An Australian industry participant wished to revisit the proposal put forward by the Australian delegation centred on the principle of a safety net for a GP. In their view, the GP could be triggered by the applicants themselves, and this was best done by creating a date of disclosure. The GP duration proposed was 12 months, but 6 months would also be workable. However, the reason for choosing 12 months was that it applied in parallel with the priority period, within which a complete application could be filed [in the Australian system – *Ed. Note*]. So in effect, by having the two periods parallel each other, it was believed that third parties were not any further disadvantaged than under the current 18-month publication system. The quid pro quo was that applicants would realise that it was in their interest to file an application as soon as possible, in order to minimise the chance of third parties using the invention prior to filing or filing applications ahead of them. The declared date of the earliest disclosure would trigger an earlier publication at 18 months from that first disclosure. It was hoped that this proposal could be discussed. As for the declaration, it could be made on the first document in any office, i.e. the priority document, which would have a box which could be ticked if the benefit of the GP was being claimed, the date would be included, which was the date of the beginning of the GP, and the country in which the PFD took place would be indicated. Each of those boxes would have INIDs, so that when the application was published, this searchable information would be available to the public. Third parties interested in the activity of a competitor would include such INIDs in their search strategies.

150. Another Australian industry representative added that the idea was that there was no additional advantage given to the applicant.

151. A U.S. IT3 member addressed the requirement for a Statement proposed by the IT3 and referred to the statistics contained in the B+ Background Document. The instances in which the GP was likely to be claimed were quite small. The statistics from Japan and Korea showed that at most 3% of filings actually involved the GP, statistics rendered possible by the declaration requirement. It was surmised that the number of cases in which a PFD was not identifiable with the applicant then became vanishingly small, for a number of reasons, such as the similarity of named authors and applicants. If one assumed that this system would be implemented in ten years, the searching capabilities which would then be available with artificial intelligence to identify that a PFD had been produced by the inventor or applicant would be extremely high. Thus, the burden placed on the system would be really quite small. With regard to the suggestion of the Australian delegation that a Statement requirement could be satisfied by a

system whereby a box would merely have to be ticked, this would simply mean that the box would always be ticked. It was suggested that some decision had to be made as to whether the GP was going to be claimed or not, and some consequences would have to apply for improperly invoking the GP. In this regard, further reflection would be needed.

152. The Australian participant replied that, in regard to the decision to create that date, the applicant would be advised that by doing so, they chose the date from which they would have 18-month publication of their application. So that “tick box” was not without ramifications, it indicated to third parties at the time of publication of the application, that a date has been created by the applicant, and the country in which the disclosure had been made.

153. A European IT3 member stated that it was not totally clear as of when the GP would apply from, in the system described by the previous participant, who seemed to be talking about a parallel period between filing a provisional application and a complete application. Did the GP apply 12 months from the priority date, or the actual filing date?

154. Another European IT3 member stated that about two centuries ago, the first element of international harmonisation had been created: the priority date. It would be interesting to know whether the GP was linked to the priority or the filing date. This was important, because when an applicant filed abroad, could he claim the benefit of the GP for a disclosure 12 months prior to the priority date and file all subsequent applications within the priority period, or did he have to file all subsequent applications within the GP?

155. The Australian participant responded that this needed to be thought through.

156. A U.S. IT3 member commented that a GP was commonly conceived of as extending backwards from the priority or filing date. According to the Australian proposal, it would seem to extend 12 months forward from the earliest known PFD. He was not sure he saw a difference. In any instance, an application would be filed, and one would check what had been published beforehand. If it was published 12 months prior to the priority or filing date, it was prior art, if it was less than 12 months, it was graced as a matter of law. The proposal for publication of the application 18 months after the PFD date was part of the proposal of the IT3 and was considered to reduce uncertainty, because effectively it gave users the same 18 months of legal uncertainty which now existed in Europe. This was argued to be one way of incentivising early filing in order to minimise the risk of a third party filing. The DIU provided further incentive to do so.

157. An Australian industry representative referred back to the Canadian presentation and expressed sympathy for the idea of having objective tests for the various issues, and PUR was the obvious one where it would be particularly good to have some objective criteria. It seemed that it would be quite difficult to move away from a discretionary test if there had to be a balancing of interests. Were there any ideas about what the objective parameters might be, for instance in terms of changes in activity?

158. A Canadian representative stated that the Canadian Patent Act listed acts such as “purchased, constructed or acquired” the invention. “Serious and effective preparations”, on its face did not seem to be as objective, but maybe the case law in countries in which this standard existed could shed further light on the concept.

159. A U.S. IT3 member observed that US law required actual use for PURs to arise. Originally, serious and effective preparations were proposed during the legislative history of the AIA and rejected. Subsequently, after the passing of the AIA, there were Congressional hearings, in which Congress heard from industry, academia, and its own members, that they favoured “serious and effective preparations” as a standard. Thus, the AIA created in a stricter standard, but there was widespread support for the more lenient ”serious and effective preparations” to give rise to rights. That phrase encompassed a wide spectrum of activity, and legislative history mentioned, for example, purchasing computer software to monitor or regulate a chemical process. Typically, an invention giving rise to PURs was secret, held internally within a company. The things which would form evidence would be similar to what was mentioned in the Canadian Patent Act, a product produced or purchased, or something which one would be able to show objectively would form the basis for a PUR, based on serious and effective preparations.

160. A European IT3 member picked up on another point made earlier, that of ticking a box to claim the GP, but not giving any detailed information. He reported that one of the major concerns within the IT3 has been what happened if the applicant did not know about a PFD, which was heavily discussed. However, it was believed that if the applicant was aware of the PFD, then providing detail in relation to the PFD, as opposed to ticking a box, was not a major effort. The major effort was to keep track of PFDs in first place. From the point of view of the third party, it was considered how much work industry patent departments invested in freedom-to-operate searches, and about 50% of their work these days was evaluating competitors’ patents. Just ticking a box stating that a PFD had occurred just created more work for third parties. The IT3 wanted to minimise work for third parties as well as for the applicant.

161. The Australian representative argued that a Statement purely by way of a tick box and a date allowed the applicant to preserve confidential information which might be quite important. An example was given of two companies liaising with each other for a new product or service, although they were not seen by competitors to be working together. That information alone could be competitively quite important and best kept confidential, as it was intended to be. In the circumstances described, there was likely to be an offer for sale, or a use of the invention which could be prejudicial in the future. He was of the opinion that maintaining confidentialities of this nature should override the interests of third parties. As a compromise, it might be sufficient to know the IPC of the invention.

162. A U.S. IT3 member explained that if an applicant ticked a box and the examiner saw it, he would request details, to make the information public. If a box was ticked and the information was not disclosed, how would third parties find it? Identification of the disclosure at least by title or even by content should be

required, as it would give the both examiner and third parties involved in an FTO process, the information they critically needed to make their decisions.

163. The Australian participant agreed that there would be a disadvantage for third parties, but that the provisional filing would have been filed, and there would be a title associated with that. He queried whether it really was necessary for the examiner to know more, since the disclosure was graced in any event, and argued that opposition or post-grant challenges were the best fora for these investigations to be made.

164. A European IT3 member was not sure he understood this view of the grace period. If after the date inserted, a truly independent inventor made a disclosure, was that disclosure prior art? Within the IT3, the understanding was that under a safety-net approach, an independent disclosure was always prior art. This was agreed by other participants to be correct.

165. Another European IT3 member returned to the issue of just ticking a box or not. There might be an interest of applicants and third parties to negotiate in secret and in exchange documents, and there was no interest for the applicant to make that public. However, the IT3 was examining the issue from the perspective of the third party who found a patent application or patent and found prior art against it, and wanted to know whether it was graced or not. There had to be a means for the third party to identify the graced publication with what he had found as prior art, otherwise, there was no way to assess whether the patent was valid or not. The intention was to give third parties the possibility to clarify the situation.

166. The Australian representative emphasised that the declared date was 18 months prior to publication. The situation was no different than if several provisional applications were filed in succession, all slightly improving the disclosure and claims in the specification. The prior art might have an effect on the first provisional, and not on the second. This didn’t become clear until they were all published at 18 months, so this did not disadvantage the third party.

167. A European IT3 member clarified that the uncertainty did not concern the content of the disclosure, but the linkage to the applicant.

168. The Australian participant countered that third parties had that uncertainty today when they were looking at instances of use prior to the priority date.

169. Another Australian representative queried whether the provision of a date might not provide information which could help the third party in determining whether the PFD date matched that disclosed on the application. The European IT3 member was not sure that this would be enough.

170. The Australian representative queried whether applicants could game the system by misrepresenting a date, or file the date later in the proceedings. If so, maybe there should be a penalty and it might be best that they be forced to file the Statement well before the date of publication.

171. A U.S. IT3 member pointed out that the vast majority of IT3 members did not want loss of rights as a sanction for not listing a disclosure.

172. Another U.S. IT3 member thought a good point was raised about disclosures which were not written publications. Written publications were easy to disclose. However, where there was a secret sale, or an offer to sell something to somebody, would it be sufficient to state that an offer was made on a given date, without disclosing what and to whom? This resembled “concise statements of relevance” in the IDS in the U.S.

173. A European IT3 member had sympathy with what was just said, but thought that the whole disclosure system was being distorted for a situation in which it might be that nothing needed to be declared or listed at all, as confidential occurrences did not need to be graced. There had to be ways to include more detail in the Statement. If the applicant knew about the disclosure, why not include the details?

174. The Australian participant remarked that the devil was in the details, and with any declaration, clever attorneys would be working out how to give the least amount of information to third party searchers.

175. A U.S. IT3 member stated that the IT3 had focused on situations where there was a publication. To do a clearance, the third party might need to be able to compare the original publication with a publication a month later by a third party on the same subject-matter, to discover whether it was derived or not. The problem was to discover the source of the disclosure. With a prior secret sale, the situation was different. Another issue was whether only the first PFD needed to be disclosed in the Statement, or whether subsequent disclosures by the applicant also needed to be listed. If there was a later publication and it was not possible to determine its source, and whether it emanated from the applicant, that was a problem which happened on the internet all the time, where three websites use exactly the same words to describe the same technology. They obviously all came from the same source, but who was the originator? Where the source was clear, there was no problem.

176. The Australian participant emphasised the simplicity of their proposal: a single form with the date from which the GP was claimed being the important element. Only the first disclosure should be listed. Listing all subsequent disclosures prior to filing would become administratively impossible and likely to be inaccurate.

177. The U.S. IT3 member responded that one of the scenarios considered within the IT3 was that for written disclosures, the applicant might only be required to list only the first one. Third parties would then compare any subsequent publications with that listed first one. If the subsequent disclosure actually named the applicant, then all was clear, the difficulty was when they did not.

178. Another Australian representative agreed that there could be a difficulty figuring out whether a subsequent disclosure was a disclosure emanating from the applicant or an independent disclosure, and this could be further considered.

179. One office representative raised an issue regarding the determination of the origin of PFDs. Where there was a first PFD made by the applicant, and a number of re-disclosures which were copied-and-pasted, or the charts or the data were the same, it might be fairly clear that they came from the same source. However, where a PFD looked significantly different, then, third parties needed to know the source, because if it originated from an independent inventor, it would not be graced. Just as a point of clarification, did the presumption apply when an intervening disclosure was made but was framed completely differently from the original PFD of the applicant? Did the presumption apply based on similarities in form and presentation or was it based on identity or insignificant differences in the subject-matter of the disclosure? In other words, if there was absolutely nothing in common between the two disclosures, but they referred to similar subject-matter, would the presumption apply?

180. A U.S. IT3 member replied that they were struggling with that issue. If it was very similar, there was a rebuttable presumption that it was a re-disclosure of the applicant's PFD. If it was very different, the examiner would then cite the second reference and reject, and the applicant could rebut the presumption that it was prior art by stating that it was his disclosure. Likewise, a third party could submit a piece of prior art to the office and the applicant or patentee would be requested to state whether it was derived.

181. The office representative's understanding was that the presumption worked in the direction that the intervening disclosure was graced. It was true that if the form was entirely different, the applicant might not know whether it was derived or not, so the motivation behind the presumption was understood. But from a systemic point of view, if it was assumed that an intervening disclosure containing the same subject-matter was inspired by the first disclosure, then this ran counter to the principle that an intervening disclosure of an independent source formed part of the prior art. The other question was how could a presumption be rebutted in practice when the person who had the relevant information was not a party to the proceedings? A further issue was: how did one rebut a presumption by proving a negative, that one had not seen the PFD, and was not inspired by it? It was suggested that this was not possible. So in effect, the concern would be that if there was a presumption based on similarity of subject-matter, this would result in an "AIA minus" approach, because at least under the AIA, one had legal certainty: if it was the same subject-matter, it was graced, although that was a completely different policy approach. However, if the presumptions were allowed to stand as they were, it could lead to a worst case, in which an intervening disclosure would be presumed to be graced, but at the end of the day, its status might not be known until after grant, during opposition or litigation.

182. In concluding the session, the Chair noted that it had been heavily focused on the GP and the Statement in particular, and suggested that the other issues be taken up in the afternoon sessions.

VIII. USER DISCUSSION ON CONFLICTING APPLICATIONS

183. The session was chaired by Mr Charles Eloshway, USPTO.

184. The Chair stated that, continuing the work carried out within the framework of the Tegernsee Group, the Conflicting Applications Workstream had pursued additional work on comparative practices and on an assessment of the degree of usage of conflicting applications in examination in different offices. The study had confirmed that the practices adopted differed and showed that the rate of use of conflicting applications was not insignificant (around 1-3%, up to 10-20%). However, those percentages, when scaled, represented a significant bulk of potential SPA. It was reasonable to expect that the trend would continue as cross-filings were likely to rise at an increasing rate.

185. The Chair took note of the IT3 proposal on page 8 of the Elements paper, suggested that the discussion be focused on the open issues in bracketed language contained the IT3 paper, and opened the floor.

186. A U.S. IT3 member invited the Chair to provide further information on the rationale behind the conclusions drawn in the Workstream paper, focusing in particular on the work done by the Workstream to achieve convergence in each of the different areas, on the problems encountered and on possible solutions.

187. The Chair explained that there was a spectrum of existing practices, ranging from novelty only at the EPO to novelty and inventive step at the USPTO, with enhanced novelty in Korea and Japan falling between those two poles. These practices represented different policy choices, regarding how far an applicant had to get from an earlier application in order to be able to obtain a patent for the second application, taking into account incremental innovation, whether the parties were the same or not, and whether the first applicant should have a relative advantage. Some of these practices were viewed as addressing patent thickets. Some jurisdictions had anti-self-collision. First of all, it had to be considered that Offices were wedded to their own established practices and that any change would introduce a degree of legal uncertainty, especially with regard to the interpretation and application of the new language by the courts. Moreover, the overhaul of examination practices would represent an administrative challenge for Offices, especially those receiving large numbers of applications. That said, he recalled that the U.S. had gone through the AIA process with good results, which showed that administratively, Offices could cope with this challenge. Other issues were the bigger policy concerns: stakeholders tended to favour their own system, as borne out by the Tegernsee Survey. One of the reasons for the harmonisation of prior art-related issues was to facilitate work-sharing. The more aligned laws and practices were with regard to prior art and how it was applied, the more efficient work sharing became. Studies showed a high degree of commonality of filings amongst major jurisdictions. Claims were frequently similar. Since conflicting applications were often filed in multiple jurisdictions, it would be advantageous if the practices were better aligned, so that work sharing could proceed more efficiently. The counterargument had always been that conflicting applications rules applied only to applications filed in the same office, so this effort might not be necessary. The Chair believed that this was an antiquated argument which did not reflect reality today, which was characterised by global filings, global prosecution, and global patent portfolios, so that conflicting applications would become an issue of increasing importance.

The Chair did not consider the problems mentioned to be insurmountable but they reflected policy choices, and political obstacles would need to be overcome.

A. ANTI-SELF-COLLISION

188. An Australian industry representative asked whether the proposition put forward by his delegation that in case of the adoption of the novelty-only approach, there would no need for anti-self-collision, was correct. This might be the basis for a system which was simple and fair.

189. The Chair observed that anti-self-collision went hand in hand with other elements. Even the novelty-only practice could be viewed as a form of anti-self-collision (even if of a different nature) since the first applicant knew when the application was filed and would be published, and had 18 months to decide whether to file divisional applications.

190. A European IT3 member replied that this option was considered, and was reflected in bracketed text in the IT3 paper. The goal was to facilitate the protection of incremental innovation and, at the same time, to support competition. It was difficult to determine which of the existing systems was the most successful in this regard.

191. Another European IT3 member agreed that there was a form of anti-self-collision in the novelty-only approach in Europe and suggested that the use of the term “anti-self-collision” be avoided, since it inevitably established a link with existing systems. The main concern in Europe was the relationship between competition law and a system that might favour one applicant over another. It was one thing to change patent law in Europe, but harmonising competition law was another altogether.

192. An Australian industry delegate queried whether a novelty-only approach without an additional anti-self-collision measure would be acceptable as this system would treat applicants equally. This was affirmed by the IT3 member.

193. Another European IT3 member further noted that all approaches could lead to patent thickets, the difference being that in the pure novelty approach, the thickets might not end up all in the same hands.

194. The Chair thought this was an important point. When studies were started, in the U.S., it was assumed that the novelty-only approach would encourage patent thickets. However, by the same token, there were arguments that in fact, the US system led to more thickets, if thickets were viewed as patents very close in scope owned by the same person or entity. Thus, if the issue was framed in terms of addressing the problem of patent thickets, it depended on the type of thicket considered. In the Chair’s view, the US system represented a balance, and the same principle applied here as in the context of the GP: generally, the applicant’s own work should not be used against him.

B. DISTANCE BETWEEN APPLICATIONS

195. The Chair invited participants to provide their opinion on the middle ground approach explored by the IT3 paper. Could the solution proposed – novelty plus, or enhanced novelty – be considered a possible way forward?

196. A European IT3 member explained that the IT3 examined the different systems existing in Japan and elsewhere which were termed “enlarged novelty” and found that there were different forms of enlarged novelty, and some of them were not easy to understand in terms of what the enlargement was. The IT3 concluded that novelty plus common general knowledge gave some latitude around the exact wording of an earlier application, so that one was not considering photographic novelty only, but also how that earlier application was read by the skilled person. Any system which added an element of obviousness, whether that be by establishment of a technical effect which was different to that of the earlier application as it was the case in some forms of enlarged novelty, or a full obviousness gap, creates a difficulty for the third party who has not seen the earlier application and cannot do further tests to examine an obviousness difference for his subsequent filing, especially if this was combined with practices in certain offices that do not allow the submission of data after the date of filing. This skewed the balance against third parties. Expressing a personal view, the IT3 member believed that extending the requirement to non-obviousness was unfair to the third party. However, novelty plus common general knowledge seemed to represent a good balance. The enlarged novelty as applied in some offices was difficult to pin down to a test.

197. In response to the Chair’s query of what was the scope of common general knowledge, the European IT3 member further explained that it was defined by how the skilled person read the document and understood its disclosures. The IT3 explored what that meant in terms of identifying what the skilled person knew. Traditionally, reference was made to fundamental encyclopaedias and dictionaries. In the modern world, that might not work for some technologies. However, this was a concept that had had to be explored throughout the patent world.

198. The Chair observed that this created a burden of proof problem – how did one prove that something constituted common general knowledge, who had the burden of proof, and what evidence could be adduced in what form.

199. The European IT3 member replied that traditionally, evidence was adduced by showing the technology as documented in traditional texts, books, journals or encyclopaedias. There were a few technologies (biotechnology was probably one of them) in which there could be fundamental disclosures of what a skilled person would know which would not lie within a traditional text. However, practitioners were used to provide proof of what a skilled person understood when obviousness was being assessed during examination, so it was not an alien concept.

200. The Chair pointed out that the concept of common general knowledge, as explained by the IT3, appeared to be similar to obviousness. The European IT3

member replied that it depended on the jurisdiction in which obviousness was being established, there were differences in practice. Within the US, the person had to be motivated to modify but in European practice, there were different tests for inventive step. It was easy to mention novelty plus non-obviousness, but that actually meant different things to different people.

201. A Japanese IT3 member pointed out that the examination guidelines published by the JPO, contained examples on how enlarged novelty was tested which were helpful.

202. The Chair concluded that irrespective of the wording used (novelty plus common general knowledge, novelty plus obviousness etc.), several issues still had to be addressed with regard to the different practices/approaches and subsidiary issues such as the burden of proof. The novelty-only approach seemed to have a certain attraction in terms of simplicity, but there were policy issues which had to be wrestled with.

C. ANTI-DOUBLE-PATENTING AND TERMINAL DISCLAIMER

203. The Chair recalled that the view was expressed that a novelty only standard did not require anti-self-collision, all applicants were treated equally. The original applicant had the opportunity to avoid his own application by filing claims which were slightly different. On the other hand, the U.S. practice required the filing of a terminal disclaimer with the benefit that all applications had to be kept in the same hands and were subject to the same expiration date, which was not the case with the novelty-only form of anti-self-collision. Various studies on this had shown that responses were split along jurisdictional lines: U.S. users preferred terminal disclaimers; those supporting the novelty-only approach did not want to be faced with additional legal issues like terminal disclaimers. The Chair asked whether there was an approach which seemed to prevail.

204. The Australian delegation reiterated that they were broadly in favour of a novelty-only approach, which did not require a specific provision on anti-self-collision or terminal disclaimer.

205. A representative of an office asked whether anti-double-patenting and terminal disclaimer provisions were considered mutually exclusive or whether they could be cumulative.

206. A U.S. IT3 member clarified that in the case of double patenting a comparison of the claims of two different applications was carried out in order to assess whether the invention was identical, and thus only one patent could issue. As to terminal disclaimer, it arose primarily because a standard other than the novelty standard was used and something was added to the original document: therefore the examiner required a terminal disclaimer to avoid overlapping of inventions by virtue of obviousness or enhanced novelty or novelty plus common general knowledge. It was emphasised that under U.S. law, subsidiary requirements existed in case of a terminal disclaimer, such as the linked applications expiring on the same date and remaining commonly owned for their entire life.

D. WHOLE CONTENTS / PRIOR CLAIMING APPROACH

207. The Chair raised the issue of the whole contents/prior claiming approaches. Under the novelty-only approach, as applied in Europe, the whole contents of the applications were compared, not only the claims. If the applicant disclosed A + B, and only claimed A, the application published, and in a subsequent application, he claimed B, there was self-collision. Under the U.S. approach, the applicant still had the possibility to get a patent on B by filing a terminal disclaimer.

208. A U.S. IT3 member confirmed that this situation was frequent in U.S. practice, for instance, in the case of start-ups, which generally had a spectrum of innovation in their hands, but were not in a position to identify what the valuable innovation was. To file as soon as possible, they therefore included everything in the application but drafted the claims only for one invention, in compliance with U.S. law. Under the novelty-only approach, an applicant would not be allowed to file another application at a later stage that enhanced some of the other features contained in the first application. He would never be able to claim protection for the core of a separate invention. For that reason, some IT3 members were very reluctant to consider a novelty-only approach. An anti-self-collision approach prevented traps for the applicant due to prior disclosures he had made, provided him with more flexibility, and was thus preferable.

209. A European IT3 member countered this by recalling that in Europe, whilst the original application was still pending, the scenario mentioned could be remedied by filing a divisional. The member further queried how the terminal disclaimer and the common ownership system functioned where there was collaboration between users but not open research collaboration, to split the costs of research in an expensive technology area. For instance, in Europe, two companies could decide to coordinate the filing of their applications with different claim scope such that one did not conflict with the other: in that case, there was no common ownership, only a common understanding on the commercialisation of the inventions.

210. A U.S. IT3 member replied that in that case, one party would have to own the patents to that technology and a licencing agreement could be concluded to resolve the problem. At the USPTO, where a double-patenting or obviousness double-patenting issue was raised, a terminal disclaimer would be required and consequently would require common ownership of the applications/patents.

E. ENHANCED NOVELTY AND ANTI-SELF-COLLISION

211. The Chair asked whether in case of “novelty plus common general knowledge”, an anti-self-collision provision would be necessary and, if so, why.

212. A European IT3 member replied that from a European perspective the major concern was the equal treatment of applicants. The Europeans within the IT3 were less wedded to novelty only, as opposed to enlarged novelty in some form, but at the moment, could not see a way around the issue of equality of treatment of parties.

213. An Australian representative reiterated that the attraction of the novelty-only approach was that it did not require an additional anti-self-collision provision. He doubted that this would be the case for the concept of novelty plus common general knowledge, although it seemed a bit imprecisely formulated. However, if the enlarged novelty norm meant “substantially identical”, then anti-self-collision would not be needed, because the applicant would know what was in his earlier application and thus arguably no protection would be required.

214. The Chair concluded that the middle ground approach of “novelty plus” would require some additional thought to resolve the issue of divergent practices, and then, depending on the definition adopted, whether an anti-self-collision provision would be necessary. He suggested that this issue be further analysed adopting the same approach as that which would be used for the discussion of multilateral treaties, where Treaty texts, Rules and Practice Guidelines were worked out and would be used as a support to resolve interpretation issues.

F. TREATMENT OF PCT APPLICATIONS

215. The Chair requested comments on the treatment of PCT applications.

216. A U.S. IT3 member recalled that the issue was whether PCT applications should enter the SPA upon publication in those offices where there were active designations or only upon entry into the national phase and reported that AIPLA tended to favour the option of “active designation”.

217. A European IT3 member reported there was no consensus in Europe on this issue at that time.

218. The Australian industry delegates had not adopted a final position, and although they had a slight preference for the national phase option, but they were open to both options.

219. A Canadian industry representative declared that currently in Canada, PCT applications entered the SPA as of the entry into the national phase, but discussions had led them to conclude that both options had implications which were less than ideal, and that perhaps the “active designation” approach might be less problematic. In the case of an active designation, an applicant might not get a patent granted in a jurisdiction because of another pending PCT application, which finally did not enter the national phase. As to the national phase approach, the risk was to have two patents granted with substantially similar subject matter to two parties. The situation where one person was denied a patent because of a PCT pending application which never entered the national phase was nevertheless less problematic than two patentees holding patents on the same subject-matter, one of which eventually could get invalidated by a court.

220. The Chair enquired whether the adoption of a harmonised “active designation” rule would encourage greater use of the PCT, or would it remain stable? In that case, the pool of potential SPA would increase, and that could foster some offensive as well as defensive uses. Obviously, an increased volume of PCT applications would have administrative implications for Offices, and particularly

the USPTO, where for many years the main route of entry into the US was via the Paris route. The PCT volume was high relative to other offices, but relative to the U.S. volume of filings, it still remained fractional.

221. One Canadian industry representative opined that larger corporations would use the PCT anyway for larger portfolios, and smaller entities either could not afford or wouldn't use the PCT in the first place, so no great difference would be expected. Perhaps larger companies might change their strategy and start using the PCT for first filings. He thought that there might not be much of an increase in volume, but perhaps the PCT applications would be filed sooner.

222. A European IT3 member pointed out that a small proportion of applications were filed for defensive reasons, to create freedom to operate. Such a rule would encourage that such applications be filed via the PCT.

223. The **epi** expressed its preference for the active designation approach because it provided earlier certainty. The postponement of entry into the national phase to 30-31 months in most countries had extended the period of uncertainty, and in Europe, even later, until publication of the translation, where the international application was not published in English, French or German. As for an increase in filings, the PCT already appeared to be best practice.

224. Another European IT3 member commented that the "active designation" option led to the PCT application entering the prior art in more countries, and harmonised the SPA, an effect which should be a common goal.

225. In summary, the Chair observed that there was still a considerable amount of work ahead, although it seemed that some discussions were focusing on a middle ground approach, but some details need to be worked out, and the outcome of these discussions would influence the issue of anti-self-collision. On the treatment of PCT applications, there seemed to be an emerging view towards "active designation" as a preferred option. Nevertheless, further discussion was needed.

IX. USER DISCUSSION ON THE GRACE PERIOD

226. The session was chaired by Mr Michael Fröhlich, EPO.

227. The Chair stated that the GP might not be as intellectually challenging as conflicting applications, but it was nevertheless also a complex and difficult issue, and one which had a central importance in harmonisation efforts. The Chair proposed to focus on a few core issues in relation to the IT3 proposals with regard to the GP, some of which were pointed out by the IT3 in its paper, as well as others which were not but were nevertheless crucial.

A. RE-DISCLOSURES BY THIRD PARTIES AND PRESUMPTIONS

228. The Chair raised the issue of the treatment of independent intervening disclosures by a third party, which was one of the pillars of the GP. In the

Elements paper, the IT3 recognized that it might be difficult to prove that a third party intervening disclosure was derived from a prior PFD of an applicant, particularly in a context where there was no discovery. As a consequence, the IT3 proposed that where the subject-matter of an intervening disclosure by a third party was the same or had insignificant differences over the prior PFD of the applicant, there would be a presumption that the intervening disclosure was derived from the applicant, and absent a rebuttal, it would be graced. Regarding the IT3 presentation earlier, there was a potential tension between this approach and the indication on slide 11 of the IT3 presentation that there would be "no grace period for independently developed and published subject-matter." The Chair queried whether participants believed that the proposal for a rebuttable presumption was compatible with the principle that independent third party disclosures would always form part of the prior art.

229. A U.S. IT3 member stated that in balancing things, in a case where the content was the same, having the presumption that it was derived was expedient. It could always be rebutted by a third party coming forward and submitting a third party observation to contest the application moving forward. Likewise, in litigation, the third party could raise that they had independently created that work and it was prior art against that application.

230. An Australian industry representative recalled that there were two issues raised in the morning. One was that the discloser was not a party to the proceedings, and this may have been addressed just now. The second was the suggestion that the third party could not prove a negative, and the representative was not sure he agreed with that. It was the kind of thing which was done from time to time, and the third party could explain how he came to invent the subject-matter. If the third party stated that he had never read the PFD, that sort of evidence was seen in practice. It was argued that it would be much easier for the third party to prove that he independently developed the subject-matter than for the other party to prove the positive.

231. A U.S. IT3 member recalled that in the past, in the U.S., under the first-to-invent system, a person had to show that they were the first one in possession of the invention, and they produced evidence that they had achieved that before the applicant.

232. Another U.S. IT3 member opined that the present discussion would reap fruit in 10 years. There were tools today to discover plagiarism. With developments in artificial intelligence, in 10 years, it would be possible to make a comparison between documents, based on a proven algorithm. If the phrasing, organisation, headings or drawings were the same, a conclusion could be drawn that more than likely, this was a derived document, or more than likely it was not. Examiners would be the most likely to use this kind of tool. Offices would inform the applicant that the disclosure was derived and thus graced, or it was not graced, and the applicant would then have to show the chain of authors in order to claim the benefit of the GP.

233. The Chair remarked that reversing the burden of proof was fine if there was a direct link or a reference to the prior disclosure. For instance, where the second

disclosure was a report of the first, a copy-paste job, or there was similarity of presentation, charts, graphs or other data. However, the situation might be different if the presumption applied to similarities which went to the disclosures' content, substance or subject-matter. Did it make a difference if this presumption were to be applied only where the similarities or insignificant differences were considered only from the point of view of the form or presentation of the disclosures, so that a clear link with the prior PFD would be recognizable?

234. A European delegate stated that these presumptions were incompatible with a safety net approach to the GP, particularly if there was no mandatory declaration. That could lead to the applicant hiding his own disclosure, and obtaining a patent without challenge. As for examiners using artificial intelligence, that could only occur if they were aware of the PFD. In addition, where the third party did not become aware of the PFD during the granting procedure, this would force third parties to litigate after grant. This would be a very significant argument against those presumptions.

235. A U.S. IT3 member suggested that competitors would monitor the prosecution, and there would be an opportunity for third parties to file observations and raise a known piece of prior art, forcing the applicant to comment. Even afterwards, it was proposed that once the patent issued, the third party could require the applicant to answer whether the prior publication was in fact to be graced. Thus, whilst there was no mandatory Statement, it was a question of when the GP was claimed, and this could be done in response to a query from the examiner or a third party or post-grant. Moreover, if one adhered to a rule that the PFDs had to be formally the same, and used that as a litmus test, it would become the policy of some companies to take PFDs, change them in some way, and re-publish them immediately to create an intervening piece of prior art. That type of behaviour should not be encouraged.

236. Another U.S. IT3 member added that in this day and age, with prolific blogging, content might not be photographic in any shape or form. In terms of fairness, the presumption should be reversed if there was enough of a difference between the two disclosures, but the IT3 was struggling with the issue of how much of a difference was needed for that shift to occur.

237. The Chair commented that where a link was recognizable, and the origin could be identified, that made the situation easier to deal with. The IT3 member agreed, but when re-publication occurred and one could not determine the origin other than looking at the substance, the presumption should apply that it was derived.

238. The Chair followed up: it was not clear how one could assume that a third party could actually know that his publication was being cited against an application, given that he would not be a party to the proceedings. At the end of the day, if he didn't rebut it, the patent would be granted, even if that intervening disclosure was that of an independent inventor which should constitute prior art.

239. A U.S. IT3 member stated that obviously, it would not happen in all cases, but if there was accelerated publication and a Statement was filed in a timely

manner, the application would be published and there would be public knowledge that such a PFD was asserted as a graced disclosure. In some circumstances, a PFD might not be known to the applicant, and the issue would not arise until later, in post-grant opposition or litigation. This was not ideal, but the IT3 had tried to make reliance on the GP as expeditious and transparent to third parties as possible.

240. The Chair asked how the built-in risk that validity issues could surface years later, at a very late stage, was reconciled with principles relating to predictability and legal certainty.

241. A U.S. IT3 member reiterated that there could be a procedure whereby after grant, a third party could request that the office contact the patent owner and receive an answer as to whether a PFD was graced or not, along with details as to why the applicant thought it was graced. That might not be used very frequently, but it would give legal certainty to the third party. It was suggested that in the event the patentee did not respond, there would be the guarantee of a FRAND licence for the third party in the event of later litigation.

242. One office representative queried whether this did not begin to resemble an additional benefit to the applicant who has made a PFD. Was this really compatible with a safety-net grace period?

243. A U.S. IT3 member replied that the IT3 had considered all the parties as well as the patent system's function in encouraging innovation. Providing that safety net might have some risks, but it also had benefits.

244. The Chair asked whether the FRAND licence did not constitute an invitation to continue to litigate. A U.S. IT3 member responded that the FRAND license might be royalty-free and thus closely resemble a PUR.

B. PRIOR USER RIGHTS – KNOWLEDGE DERIVED FROM INVENTOR/APPLICANT

245. The Chair addressed the issue of PURs as an integral part of the safety-net grace period. In the IT3 Elements paper, there were repeated references to a "safety-net" grace period, yet there appeared to be no agreement on whether PURs should be able to accrue if the inventor was not an independent inventor. So the GP and PURs being two sides of the same coin, in protecting the applicant from PURs accruing where the prior use was based on knowledge of the invention derived from a PFD of the applicant, and thus removing the risk which would otherwise exist where a PFD was made, wasn't the GP giving the applicant an additional benefit as a consequence of his PFD? Would this still be in line with the policy principle that no separate or additional benefit should arise from the GP?

246. A U.S. IT3 member stated that if PURs were to be granted to someone who copied a PFD, this was just taking away the GP. Further, some members within the IT3 were concerned that a lot of companies were using so-called "efficient infringement". If it were allowed to take information derived from an inventor to

acquire PURs, this would encourage disregarding patent rights and the patent system.

247. A European IT3 member remarked that there was no consensus within the IT3 on this issue, and explained his personal view, which he understood was also the position of BusinessEurope on this issue. If a PFD occurred, voluntarily or not, it should be at the full risk of the future patent applicant. PURs were not created to balance the GP, but to balance the interests of those who kept their inventions secret and of those who patent. So expanding PURs was an important aspect of the package, to integrate some form of a GP. It was important even in the very particular situation where a third party gained knowledge of the invention from the PFD and began activities that would qualify for PURs. Also, the term "right" was misleading: it was not really a right in terms of ownership, but it was a defence against potential litigation launched by the future applicant. To sum up, it should be perfectly acceptable for a third party to base an activity on knowledge derived from a PFD and obtain PURs.

248. An Australian industry delegate firmly expressed the same view, that PURs were an appropriate balancing mechanism. He did not believe that it was accurate to say that it constituted either a disregard of patent rights or denuding the GP of its purpose, because the applicant still got his patent rights.

249. A U.S. IT3 member believed that one of the problems was that the discussion was taking place at a very high level, where the PFD fully disclosed the invention, fully enabled, comprising all the elements claimed in the ultimate resulting patent. In fact, most often, this was not the case. The PFD represented only part of the invention. It was still graced, although it was only a disclosure of the skeleton of the invention, which was not enabling. Often, industries were moving in a wave. There was not only one actor, but 5-10 competitors working on the same thing and suddenly, there was a publication, related to their common R&D activity. To deprive a third party of a PUR if the knowledge of the invention was derived from a PFD disregarded the real investments that had been made and disregarded reality. The member and his association supported the position that if knowledge of the invention was derived from a PFD, it should still be eligible for PURs.

250. A Japanese IT3 member stated that their organisation was still discussing the issue internally, but in light of the current law applicable in their jurisdiction, they suggested that the third party should independently develop the invention for PURs to accrue.

251. A U.S. IT3 member observed that the factual situation described above was that of independent development and that his association disagreed that PURs should accrue from derived knowledge of the invention. Currently, third parties did not get PURs if they took an invention which had been disclosed and implemented it, if an application had already been filed for the invention, even though that fact did not become apparent for 18 months. It was odd, in his view, that a PFD made the day before the disclosure would "flip things around".

252. An office representative responded that legally, there was a difference between information which was in the public domain and had not been

appropriated, where the status of the information was that people were free to use it, and information which was the object of a pending patent application, which was why the filing date was the cut-off point of the critical date for PURs. It was true that the applicant did not know whether an invention was in the process of being appropriated, whether the disclosure of the invention was made prior or after the filing of the application, until the application had been published. However, the status of that information was very different once an application had been filed, which was an important element in terms of the coherence of the system.

253. A U.S. IT3 member from the US remarked that it was a matter of policy: if there was a grace period, should people be encouraged to roll the dice and potentially infringe, or not. Going back to the PUR as a balance against GP, one could say that providing a PUR was one way of encouraging prompt filing after a PFD. The IT3 worked hard to find other incentives for people to promptly file, and he believed that some proposals provided that. But he did not want to have a policy of encouraging potential infringement, when a person didn't know whether the inventor was going to be claiming a graced disclosure, or had already filed a patent application, and walked into a law suit and dispute.

254. The Chair asked the member whether a GP would still qualify as a safety-net if PURs were denied if knowledge was derived from a PFD, or should the effect of the GP not be confined just to the removal of the PFD from the prior art, and nothing else? The member replied that he did not know the Chair's definition of a safety-net. As the IT3 proposal included intentional disclosures, some people might say that was not a safety-net. This was done for policy reasons, otherwise it could be difficult for both offices and courts to determine whether a disclosure was intentional or not.

255. A European IT3 member replied that it should be borne in mind that the system needed to be in the interest of society, and thus also serve the interests of third parties. There was a world of difference between reading the PFD and investing in activities which could qualify for a PUR. The system the IT3 were imagining was very different than that in France. It was important to protect an entity which was making investments, something concrete, so that society might ultimately benefit from these investments. He believed it was important to allow these activities as part of a safety-net approach, to build a patent system which would be supported by society as a whole.

256. A European user observed that, to be clear, if an inventor decided to publish without applying for a patent and a third party started using the invention, but could not get PURs, that meant that the inventor was given an additional advantage from the publication. It was impossible to understand it in any other way.

257. A U.S. IT3 member argued that it was very difficult to prove without discovery that someone saw a PFD and started to do their work, or that they were in the process of doing their work and the PFD incentivised them to work further in this direction. As a subjective free standard, it would be very difficult to have an exception for something which was derived for PURs.

258. Another U.S. IT3 member returned to the policy statement: companies should not be encouraged to look at publications and immediately invest in copying those publications. Those companies might not know that there had been a patent application. The application might have been filed the day before the disclosure, and they wouldn't know for another 18 months whether the product they had copied was going to be patented. In order to address this situation, the IT3 had included the option of early publication, so that if there was a graced disclosure, the publication date would be 18 months after the graced disclosure. Thus, a sensible company waiting 18 months after the disclosure to do their patent search, would be no worse off with a PFD, assuming a Statement had been filed in a timely manner, than if the application had been filed the day before the disclosure.

259. A European IT3 member responded that he could not imagine that a decision to engage in activities which could qualify for PURs would be only driven by seeing a PFD. There were many other elements before reaching the decision to engage in activities, knowing that there was the risk of the 18-month period of "darkness".

C. ACCELERATED PUBLICATION

260. The Chair asked participants whether they believed the proposed accelerated publication at 18 months from the first PFD should be considered to be a practical and effective component of a GP.

261. Two European IT3 members who had attended a UK Users' Round Table reported that UK constituents considered accelerated publication as the most exciting proposal to come out in regard to the GP. It really helped third parties and was considered a very good proposal.

262. The IPO had proposed accelerated publication and were very supportive of it, but their greatest concern was that patent offices would push back on the administration of it.

263. One office representative confirmed that this proposal would create a lot of administrative difficulties. One issue which had been raised in a different context was whether any thought had been given to the implications for conflicting applications. What would be the prior art effective date? What were the implications of shortening the date from filing until publication? These issues needed to be thought through.

264. A representative from another office stated that although there were implications for offices, he didn't see offices opposing this. Over time, offices had significantly reduced periods for preparations for publication and he did not foresee procedural difficulties for accelerating publication on the basis of a PFD.

265. The representative from JIPA stated that the association could not yet agree to accelerated publication. At a hearing held by JIPA, an argument was made that the PFD might not have the full contents of the later application. As patent

attorneys prepared patent applications, they worked with inventors, and at times, additional experiments were made to be incorporated into the patent application. It was queried whether accelerated publication might not be detrimental to applicants.

266. A U.S. IT3 member supported accelerated publication, and pointed out that it reduced the timeframe in which there could be problems with that issue.

267. Another U.S. IT3 member queried which problems would arise which did not already exist under the current system of accelerated publication in Japan and the U.S.? A representative from JIPA responded that early publication was not frequently used in Japan. Moreover, in that case, accelerated publication was the applicant's choice, not an automatic consequence of the system, which was a fundamental difference.

268. An Australian industry representative stated that regarding the interrelationship with conflicting applications, accelerated publication narrowed the window within which SPA was secret. This led to the question of whether enlarged novelty should be preferred over simple novelty. The main reason for doing so would be to avoid patent thickets. However, these were not thereby avoided. There were just different kinds of thickets. If the window was narrowed, this became even less of a practical problem, so there was no real reason to depart from the novelty-only approach, which brought the benefit that differential treatment between applicants (anti-self-collision) was no longer required.

269. The representative of the USPTO pointed out that his office administered a complicated publication system, as unlike in other offices, applicants could choose to opt out of publication, which was problematic to administer. Early publication was also offered, but not frequently used. There was some information which offices would need to receive in a timely fashion in order to trigger earlier publication, and there might be difficulties in dealing with that information. Coming back to the issue of SPA, it was assumed that the filing date would be the effective prior art date, as it currently was in all jurisdictions. If earlier publication was tied to an enabling PFD, the filing itself had to be enabling, and this raised the issue of whether the applicant should get the advantage of the earlier publication date for SPA purposes, if the applicant had already disclosed his invention.

D. RELIANCE ON THE PFD AS A REQUIREMENT FOR THE DIU

270. The Chair turned to the Defence of Intervening User (DIU), another novel and interesting proposal, which was there to protect third parties, and provide an incentive to the applicant to file a Statement in a timely manner. Participants were asked whether DIUs should accrue only where there was reliance on the PFD by the third party, combined with the absence of a timely filed Statement, leading to the absence of accelerated publication.

271. A European IT3 member recalled that in Europe, after grant of the patent, because of the translations required, a similar concept existed. If the claim scope as translated was narrower than claim scope in the official language of the grant,

and a third party began activity, that person was allowed to continue even after a correction of the translation.

272. A U.S. IT3 member stated that the DIU was still under discussion within the IT3. It was intended as a mechanism to address concerns regarding the protection of third parties. With respect to reliance, the discussion had been that there should be reliance, it should be a narrow exception to protect a third party who had relied on that PFD, believing it to be the public domain, because of the fact that no publication of an application claiming the subject matter was made at the 18-month mark.

273. The Chair queried whether, where an application had been published without a Statement, and the PFD was not readily identifiable as originating from the applicant, would a DIU accrue in this situation?

274. The U.S. IT3 member responded that this was a situation where the third party could see that this might be a graced publication, they could file a third party observation, bringing a piece of potential prior art to the patent office's attention. That would bring to light whether someone was claiming the PFD as a graced disclosure and provide transparency for the public.

275. The Chair recalled that the IT3 proposal contained a requirement that the applicant file a Statement to avail himself of the GP, in order to increase legal certainty for third parties and queried whether participants believed that the Statement reflected best practice, and be a necessary part of the package.

276. A Canadian industry representative reported that their delegation was divided on the issue. Some felt that a Statement might be helpful, and eliminate a lot of discussions regarding the DIU and PURs if Statements were mandatory. Others did not share this view. Personally, he felt that it would be helpful, but did not agree to the "nebulous Statement" concept proposed by the Australian delegation. The Statement should point to the PFD in question.

277. A U.S. IT3 member remarked that it had to be considered what PFDs were. Some originated from applicant, some were secondary disclosures, some PFDs went viral, and PFDs might not disclose the invention itself but only bits and pieces of it, calculated to be a partial disclosure. All were subject to the GP. It would be overwhelming if the burden were on the applicant to cite all these references. Corporations would not even try. Under the DIU, the applicant had a choice. He could decide whether something was relevant, and file a Statement, either with the application, or later. If so, this could trigger the DIU. The applicant could also deal with disclosures during the prosecution, by arguing that they did not disclose the invention.

278. The Chair then queried which of the various incentives were considered essential for the timely filing of the Statement: fees, accelerated publication, DIU, loss of rights?

279. A U.S. IT3 member emphasised that the IT3 did not agree with loss of rights as an option, but "that would certainly do it".

280. The Chair asked whether a sliding scale of administrative fees would be a workable mechanism and who should be setting such fees.

281. A U.S. IT3 member stated that it would be necessary to have a uniform fee structure across jurisdictions. There might need to be a separate fee structure for universities and SMEs, but the fee amounts had to be sufficient to incentivise the timely filing of the Statement. A European IT3 member agreed, stating that the IT3 did not want any forum shopping on the basis of the fee structure.

282. A European user pointed out that since the GP was mainly for SMEs and micro-entities, the first thing they would ask for was a fee reduction, which could largely neutralise the incentive effect of the fee.

E. DURATION OF THE GRACE PERIOD

283. Finally, the Chair asked for a show of hands on the duration of the grace period. There was overwhelming support for a 12-months duration, with some European users supporting a 6-month grace period. A European IT3 member opined that this was the wrong question, as the optimal duration would depend on the package agreed.

284. The Chair concluded that significant progress had been made on the GP, but that several issues remained to be worked out. He thanked the participants for the lively discussion and closed the session.

X. USER DISCUSSION ON PRIOR USER RIGHTS

285. The session was chaired by Mr Tatsuo Takeshige, JPO

286. The Chair suggested that the discussion be divided into two different issues: (1) the PUR as an element of the safety-net grace period; and (2) the PUR as a defence of inventors themselves, removing obstacles which stem from the first-to-file system, where the first to file obtained patent rights and those who did not file might avail themselves of this defence. This might be useful to decide on the scope of the rights granted to those who were inventors and those who were prior users, and whether they should be treated in a completely equal manner.

287. It was objected that as their name indicated, PURs protected prior users, not necessarily prior inventors, and several members of the IT3 mentioned that the PUR should be the same for all and that the status of the prior user as an inventor or a licensee, for instance, should make no difference. Moreover, a Japanese IT3 member stated that the DIU and the PUR were different. The Chair withdrew his proposal, which nonetheless was very useful as it had given rise to some interesting policy statements. The issues were discussed all together.

288. At the outset, a U.S. IT3 member specified that where the invention was stolen, there should be no PURs. The Chair replied that good faith was a pre-condition for PURs to accrue, and there was a broad consensus on this point.

A. TERRITORIAL SCOPE OF THE PUR

289. The Chair noted that there seemed to be a consensus within the B+ Workstream that the territorial scope of PURs should be limited to the jurisdiction in which the qualifying activities took place, in line with the proposal of the IT3. The Australian and Canadian industry delegations also agreed with this principle.

290. The AIPPI representative pointed out that AIPPI's resolution did, in principle, agree with limiting PURs to the country where the prior use took place. There was a caveat to that, which was the case of a regional patent with unitary effect. Then, PURs should apply in all territories covered by the patent. A European IT3 member responded that the Unitary Patent Court Agreement provided that PURs were treated on a national basis, not on an EU-wide basis, so the policy position might be correct, but was not reflected in the law at this time, as PURs were not harmonised throughout Europe.

B. FREQUENCY OF PURS

291. A Korean user pointed out that PURs issues were not very common in Korea. He was unaware of case law on PURs in Korea, and asked whether PUR disputes were common in other countries and whether they could act as a counterbalance to the GP.

292. A European IT3 member commented that often prior use was done in secret, so it was not visible, and that meant there were no large numbers of court cases on PURs. It depended on the area of technology, but in certain areas, advice and FTO opinions often included a review of PURs. In looking at innovations in conventional technologies or in evaluating third-party rights when they came up for screening or in a freedom-to-operate context, in-house industry attorneys frequently had to evaluate whether their company had PURs. This process was not visible from outside the company.

293. Another European IT3 member warned that the importance of PURs should not be underestimated as a result of the low number of cases. They were very important. Personally, as a company attorney, because business did not like diversity around the world and because there was a lot of variety in the scope of the rights from country to country, ideally, he believed that the PUR should have an international effect.

294. A U.S. IT3 member added that PURs often came up in the context of litigation and were often offered as a defence that did not go to trial and resulted in a settlement. In his practice, he had even had cases involving Korean companies that asserted a PUR defence. Another U.S. IT3 member referred to the Tegernsee Report[1] which gave a great deal of detail on the use of PURs in negotiations and percentages in different countries.

[1] Report available at: http://documents.epo.org/projects/babylon/eponet.nsf/0/C3407F28C924DA5CC1257CD80036DB61/$File/Tegernsee_user_consultation_consolidated_report_en.pdf, see p. 77-81.

295. The representative of the USPTO added that his office had produced a report for Congress[2] in 2012 on the PURs in the AIA, which went into all aspects of the practice and gave empirical information on questions asked in the Federal Register Notice as well as input received in town-hall meetings on the subject.

296. A Japanese IT3 member opined that in Japan, the PUR defence was one solution to the potential risk of a patent issuing, especially for industries in which technology was protected by trade secret rather than by patents. In those situations, very often, the company prepared evidence to be ready to assert a PUR defence. There was quite a bit of case law in Japan.

297. The Chair agreed, emphasising that participants appeared to all share the understanding that PURs were important and that they should be territorially limited to the country in which the PUR accrued. Concerning the PUR in Japan, his office had been entrusted with creating guidelines for the PUR and had analysed 150 cases in the process. He noted that the PUR was used in many different ways in Japan.

C. REQUIREMENT OF GOOD FAITH

298. The Chair raised the topic of the requirements for the PUR to accrue. There appeared to be a consensus both within the B+ Workstream and the IT3 that PURs should not arise where the prior use was based on abuse or breach of confidence or of a contractual obligation, which meant that the prior user had to be of good faith. He understood that this was also the case in Australia.

299. A member of the Canadian industry delegation pointed out that in Canada, the determination as to whether a PUR accrued was based on an objective determination of whether an act had been carried out, something which could be measured with invoices, actual machinery, and so on. However, even in Canada, there was a concept of good faith which formed part of the requirements for PUR accrual under s. 56 of the Canadian Patent Act.

D. ACTS FOR PURS TO ACCRUE

300. The Chair noted that within the B+ Workstream, there was a consensus that mere possession or knowledge of the invention should not suffice to ground PURs. However, beyond that, there were two positions: one which would recognise PURs where serious and effective preparations to use the invention had been carried out, and a second position, which would require actual use of the invention to take place for PURs to accrue. Within the IT3, consensus appeared to have been reached on the first position. Industry representatives from Australia and Korea and FICPI appeared to be aligned on this position.

301. The Chair observed that in the U.S., PURs only arose if there was an actual use one year prior to the filing date, or one year prior to the first disclosure of the invention, whichever was earlier. However, he recalled that there had been

[2] Report available at: https://www.uspto.gov/sites/default/files/aia_implementation/20120113-pur_report.pdf

reports of possible reform in the US during the morning session, which would be very positive from a harmonisation perspective.

302. One office representative noted that the Elements paper stated that there might be no bright line possible to determine whether there were serious and effective preparations, but observed that the case-law in some countries with a long experience of PURs showed that it was quite possible to have tests which objectively determined whether serious and effective preparations occurred so that rights could accrue.

303. A U.S. IT3 member agreed that the more objective the requirements were, the better. The IT3 would need more time to come up with proposals on this issue.

304. The Chair concluded that the definition of serious and effective preparations would need to be discussed further in the future.

E. CRITICAL DATE FOR ACCRUAL OF PURS

305. The Chair recalled that the IT3 proposal showed a consensus that the critical date for accrual of PURs should be the effective filing date, ie, the filing date, or, if applicable, the priority date. The Australian and Canadian Industry representatives this morning appeared to endorse this approach, and he recalled that this also reflected the majority opinion within the B+ Workstream, adding that he believed that this approach was aligned with Art. 4B of the Paris Convention.

306. A European IT3 member stated that his understanding was that the Paris Convention did not allow PURs to arise past the priority date until a subsequent filing had been made, and opined that choosing the filing date as a critical date, aside from requiring an amendment of the Paris Convention, would be contrary to the spirit of harmonisation.

307. There were no comments regarding the third option, represented by the US system requiring that prior use occur either one year prior to the filing date, or one year prior to the earliest disclosure of the invention, so that the Chair concluded that there was a consensus that the critical date should be the effective filing date as proposed by the IT3.

F. DERIVATION OF KNOWLEDGE OF THE INVENTION FROM THE APPLICANT

308. The Chair stated that the issue of PURs arising where activities were based on knowledge derived from the applicant was one of the most difficult issues but recalled that it had been discussed at length within the context of the GP.

G. EXCEPTIONS FOR CERTAIN TYPES OF PATENT HOLDERS

309. The issue was whether exceptions should be made to the accrual of PURs for some types of patent holders, such as universities, which was an exception provided for under the AIA. The Chair noted that the IT3 proposal was that "Prior user rights apply without discrimination of the type or patentee or subject-matter

of the claimed invention" and that this was a consensus position, supported by the Australian, Canadian and Korean industry representatives. A U.S. IT3 member emphasised that this would clearly require a change to US law, but that the users would try to achieve this.

H. SCOPE OF THE PURS

310. The Chair remarked that the IT3 approached the issue of scope very differently from the B+ Workstream, which had focused on whether or not to allow for changes in terms of the volume of use, the embodiments and the types of acts of exploitation of the invention. The IT3's view appeared to be that this should be determined by the courts on a case by case basis, with a discussion as to a list of factual elements which would be relevant for courts to determine the scope of the PUR in a given case.

311. One office representative made a general observation that the whole reason PURs were even brought into this discussion in the first place many years ago was because of the perceived link between whatever it was that a safety-net GP was and how PURs functioned in terms of making sure the GP served as a safety net, nothing more. So while a lot of the features discussed with regard to PURs had to do with the conditions under which they could accrue, there was a direct relationship between those and how the GP functioned. Thus, he queried whether it was necessary to attain consensus on the scope of the PUR once acquired. He argued that there was not much of a link with the GP, and perhaps this did not need to be dwelt upon.

312. A U.S. IT3 member emphasised that PURs did not just come up within the context of the GP, but also simply because some people decided to keep their inventions as trade secrets and practised those before another inventor filed a patent application. This situation could not be ignored. Moreover, having harmonisation on the ramifications of that defence would be helpful to users across the globe.

313. Another office representative supported this last intervention, stating that it coincided with positions espoused by some European users, who had expressly stated that they were very much in favour of harmonising not just the conditions for acquiring PURs, but also their scope.

314. It was further observed that the IT3 proposal was that courts should determine whether rights accrue and then the scope of these rights based on a balancing of the applicant's interest and the interest of the third party. In Europe, where these rights had a long history, the balancing of the interests between the applicants/patent holders and the prior users had been done at a statutory level. The courts did not balance the interests in every case, but in some jurisdictions, had developed tests which made it predictable for parties to determine whether the statutory requirements were met or not, where they stood, without having to go to court. To give a concrete example, German courts had held that for serious and effective preparations to exist, the prior user must have had "possession" of the invention. Moreover, he must have conducted activities which were suitable for the commercial exploitation of the invention. From these activities, it had to be

possible to deduce a decision to actually use the invention in the immediate future. Thus, the preparations were an ongoing process during which the critical date just happened to fall. A set of tests of this nature in terms of the accrual of rights and activities which could be engaged in by the prior user allowed parties to determine their respective positions, and settle. Thus, PURs actually prevented parties from going to court. Finally, if courts should have the discretion to determine the scope of the right in each individual case, it was questioned whether this could be considered harmonisation, since discretion exercised by judges in different jurisdictions would most likely result in different outcomes.

315. A U.S. IT3 member pointed out that the IT3 had not yet decided on whether a hard rule or an equitable rule was more appropriate.

316. A Japanese IT3 member added that in the IT3 Elements paper, some factors were listed which could be considered in terms of the scope of the PUR. The IT3 had had many discussions on changes in volume of use, embodiments and changes in the types of acts of use of inventions. Some of the factors considered were included in the paper, and the chart contained common positions regarding changes in third party activity. This was an ongoing discussion.

317. A European IT3 member, clarifying that this was a more personal comment, stated that the group had run out of time in IT3 to further explore those issues that were very important. It was agreed that in the spirit of harmonisation, it was really helpful if not critical to elaborate more objective elements and not to leave assessments to the judges. In those discussions, there was a momentum, notably on the particular topic of PURs and the group needed more time to further close the gap amongst them.

318. Adding a further personal comment, the member stated that ideally, there should be no limit on the volume of use. As far as change of embodiments were concerned, alluding to the German element of possession of the invention, some limits should be set, for instance, only those embodiments which the third party possessed and for which it accrued rights should be allowed. Issues going to changes in acts of use of the invention would also require further clarification in order to be harmonised.

319. An Australian industry representative expressed the view that the questions going to the scope of the right shouldn't be left at large if one wished to have any effective PUR at all. So, for example, if it was left completely up to judges to determine whether or not volume or embodiment changes were permitted or not, then it would be open for a judge to decide that there was no volume or embodiment changes permitted at all. The result of this would be that there would be no effective PUR at all in substance. This explained why one might want to provide some principles for dealing with those particular topics. As to what these principles might be, the representative agreed that there should not be any volume limit. There should be some principle applied to permit some variation of embodiments along similar lines to those just suggested and likewise, the B+ Background Document provided some suggestions as to the manner in which such principles might be approached, so that it shouldn’t be beyond the abilities of delegations to work out some of these principles.

320. A Canadian industry representative emphasised that anything which was left up to the courts was poorly done, and it was not believed that the courts could be trusted to come up with consistent guidelines. It was believed that the job of harmonisation would not be done if a manner was not found to deal with these issues more objectively. Attorneys needed to give their clients advice and they couldn’t simply say "Wait for the lawsuit; the court will decide." If there were limitations, there needed to be a way to determine objectively what they might be. However, parties needed to be able to know where they stood without winding up in court on the receiving end of a law suit.

321. A U.S. IT3 member reminded participants that there was a list in the IT3 Elements paper on p. 21 under scope of third-party activity: "selecting and purchasing manufacturing, integration or testing equipment or system components specifically suited to practise the invention, developing software that will control manufacturing" and so on. There was a list of five items. It was non-exhaustive and the IT3 could come up with more, but these were objective items.

322. An office representative stated that there was a difference between tests to be used by the courts and the factors which were listed in the IT3 document. This could be illustrated by a German case in which a company had carried out extensive field-testing. Based on a list of activities, one would conclude that this would constitute a serious and effective preparation. The problem in that case was that the court found that the purpose of those tests was to determine the dosage and effectiveness of the compound. Consequently, the court concluded that no PUR had accrued, because there hadn't actually been a decision made to exploit the invention. The third party was actually more in the stage of perfecting the invention and therefore there was no decision to use the invention in an immediate fashion, as per the tests related earlier today. Thus, it was thought that although it was excellent to have a list to give guidance to the courts regarding activities which might be considered to be appropriate as serious and effective preparations, articulating objective tests should also be considered by the IT3 in their efforts, because it gave the courts criteria in dealing with the factors listed. A final point was that the IT3 believed that the amount of investment should be considered a criterion. It was remarked that this criterion had been rejected by German courts. Some widgets were cheap and yet produced big effects; other activities might be very expensive, but due to the application of the tests mentioned, it might still not appropriate for PURs to accrue.

323. A U.S. IT3 member stated that at least in the conversations within the IT3 on the factors listed in the paper, they did not believe that any tests from any specific jurisdictions had been discussed. It was suggested that if some jurisdictions had elaborated detailed tests, it would be appreciated if the people living in those jurisdictions could provide the IT3 with input on those. An office representative noted that some of them were included in the B+ Background Paper, but further information could be provided at a later date.

324. A U.S. IT3 member pointed out that as far as the list of factors were concerned, if there was a mandatory set of items and one was left out, the PUR

would be lost. Thus, it was necessary to have a non-exhaustive list of examples, as there were too many possible options.

325. The Chair noted with satisfaction that the discussion had been very positive and useful. It had been clearly understood that the users had expressed the wish for further guidance in regard to PURs, so further discussions on these issues would be pursued. The Chair thanked the participants for their input and closed the session.

XI. CLOSING STATEMENTS

A. THE CHAIR

326. The Chair of the Group B+ resumed chairing the Symposium, and thanked the chairs of the Workstreams for taking participants through the key issues in a comprehensive fashion.

327. Summing up, the Chair stated that the Symposium had given participants a timely reminder of the principles and the objectives that the delegations were trying to achieve. Areas of agreement had been explored, as well as the extent of the existing differences. She believed that the B+ Sub-Group and Workstreams now had a clear understanding of the status of work within the IT3 and a much better understanding of the reasons for which some positions were favoured, and also of the areas where there was no consensus and what the reasons were for divergent views.

328. She also felt that very useful exchanges had taken place on how some of the IT3 proposals as well as some alternative suggestions could work. Some proposals had been tested by working through some examples, which had thrown light on what might be practical and workable, which was what the harmonisation solutions needed to be.

329. In some areas, she sensed that the delegations might be coming closer together, but further refinement of concepts was needed as well as clear definitions ensuring shared meaning, for example, in terms of what would constitute a Statement for the GP, or in terms of the test regarding the distance to be applied to conflicting applications. Most useful, she thought, in a number of cases, some delegations had indicated where they saw scope for flexibility. One area for example, was that there appeared to be emerging agreement that early publication might be a real positive and solve some of the problems with the GP which were sought to be addressed. There had certainly been huge value in discussing alternative approaches and in including colleagues from industry groups from other countries in addition to the IT3, and it was very positive that new ideas were still being explored and presented. In her view, the square brackets in the IT3 Proposal which indicated the absence of consensus should not be considered to be a glass half empty, but a glass half full and filling up.

330. The issue for the B+ Sub-Group's perspective and from the Group B+ more generally, was to consider how to continue facilitating ongoing exploration of the issues and options and maintain the momentum to achieve common ground.

331. Responding to some participants' requests, the AIPPI and **epi** in particular, who were keen to have the opportunity to have some internal consultation within their membership and come back with more considered, written comments on the IT3 papers, the Chair proposed that all Symposium participants feel welcome to provide considered written responses to the IT3 paper by the end of August, and a number of participants agreed to do this.

332. Obviously this was an on-going dialogue, but this would be the last opportunity for participants to give input for consideration in time for the next Group B+ Plenary meeting in October. In response to a query from the IT3, the Chair stated that the IT3 would have an opportunity to respond to that input, but perhaps not before October.

333. The Chair believed that the Symposium has been extremely worthwhile and had moved matters forward, although clearly, harmonisation remained unfinished business. Participants were invited to make some closing remarks.

B. INDUSTRY TRILATERAL

334. Speaking on behalf of the IT3, a member stated that the group felt that the Symposium had been very intensive, thought-provoking and fruitful. The IT3 had advanced considerably since the last status report given to the Group B+ in Geneva. Their purpose, of course, had been to put their proposal to the test, test their ideas, receive feedback from their own regions, and they were particularly pleased that users from other regions had also come forward with considered comments to what they had presented, and thanked them for their efforts. As indicated earlier, the IT3 was very happy to continue this discussion with all organisations and delegations that were interested to go into more details on the IT3 Elements paper and ways could certainly be found to organise and facilitate such an exercise. The IT3 wished to thank the Chair, the B+ Sub-Group and the EPO for the Symposium today and wished a safe return to all participants. For the IT3, certainly the road ahead would be filled with a great deal more work.

C. FRANCE

335. The French delegation was grateful for the opportunity to attend the Symposium as observers and gladly accepted the offer voiced by the IT3 to exchange with organisations interested in going deeper into discussions on details of their proposal.

D. CANADIAN INDUSTRY REPRESENTATIVES

336. The Canadian representatives also expressed their gratitude for being invited to participate in the Symposium. This was their first foray into discussions that had been ongoing for a very long time, so it was as much a learning process for them as it was an opportunity to consider some of these issues which they were

invigorated by and wanted to go back and think about more thoroughly and on which they wished to reach more consensus. They looked forward to the path ahead and would endeavour to provide the IT3 with some more meaningful comments through the summer months, keeping in mind that summers were short in Canada. The delegation also thanked their colleagues from the Canadian Intellectual Property Office who had been a tremendous resource for the delegation and other users who were part of their working group in Canada.

E. KINPA

337. The representative of the Korean Patent Attorneys' Association stated that the Symposium had definitely been very interesting and helpful. (Actually, while taking notes, he had run out of ink from his first pen...) He would have a lot of material to take back to his colleagues in Korea and would have some interesting discussions and looked forward to providing further feedback and comments in the future. He thanked the B+ Sub-Group/Industry Trilateral for the invitation to the Symposium and signalled that he looked forward to continued co-operation and participation.

F. AUSTRALIAN INDUSTRY REPRESENTATIVES

338. The Australian delegation thanked the B+ Sub-Group/IT3 for the opportunity to make a presentation and get some different perspectives on a number of important issues. The delegation also thanked the representatives from IP Australia for working closely with the Australian Industry delegates in preparing for the Symposium. The Australian Industry delegation would produce further comments in writing by August.

G. CONCLUSION

339. The Chair concluded that it had been a fairly intensive day, and thanked all the participants for their contributions, as well as the EPO for hosting the Symposium in such a magnificent room, which certainly looked like the sort of room in which breakthroughs could be made! She also thanked the interpreters for a sterling job, particularly in the last session.

340. Clearly, this was a challenging set of issues and the focus and determination of the delegations to make progress would be what got them over the line, bearing in mind the rugby analogy that the last 10 yards were always the hardest! So the B+ Sub-Group and the IT3 would continue to work for those last 10 yards. The Chair stated that the B+ Sub-Group looked forward to continuing to work with the IT3 and broader industry groups as they made progress on these issues. She wished all participants a safe trip home and closed the Symposium.

ANNEXE 1

Cornerstones for Harmonisation –
a B+ Sub-Group / Industry Symposium

Munich, Tuesday 20th June 2017

List of participants

AIPLA – US

Ms Lisa JORGENSON	Executive Director
Mr Tony VENTURINO	Chair, Harmonization Task Force
Mr David HILL	Vice-Chair, Harmonization Task Force
Mr Alan KASPER	Member, Harmonization Task Force
Mr John OSHA	Member, Harmonization Task Force

BUSINESSEUROPE

Ms Carol ARNOLD	Immediate Past President, IP Federation
Mr Jacques BAUVIR	Chef du service Propriété Intellectuelle, MFP Michelin
Mr Roman BONN	Vice-President Intellectual Property, Continental Automotive Gmbh
Mr Ilias KONTEAS	Chief Intellectual Property Officer, BUSINESSEUROPE
Mr Tony ROLLINS	Strategic IP Adviser
Mr Uwe SCHRIEK	Division IP Counsel, Siemens
Mr Thierry SUEUR	Chairman of BUSINESSEUROPE Patents Working Group, Vice-President European and International Affairs, Air Liquide

IPO

Mr Mark LAUROESCH	IPO Executive Director
Mr Tim LOOMIS	Qualcomm, IPO Executive Committee
Ms Vanessa PIERCE ROLLINS	IPO Senior Counsel, International Affairs

JIPA

Mr Tomoko MIYASHITA	International Policy and Strategy Project Leader, JIPA
Mr Akihiro YOSHIOKA	Second International Affair Committee, Chair and International Policy and Strategy project member

AUSTRALIAN INDUSTRY/USERS

Mr Richard BADDELEY	Vice President IPTA
Mr Angus LANG	Australian Law Council
Mr Bill McFARLANE	FICPI Australia, Secretary

CANADIAN INDUSTRY/USERS

Ms Kamleh NICOLA	Canadian Bar Association (CBA)
Mr Fred BARBIERI	Canadian National Group of AIPPI
Mr Jeffrey ASTLE	Pratt & Whitney Canada Corp.

KINPA

Mr Albert LEE	Senior IP Counsel, LG Display

PPAC

Mr Ming DENG	Chief Representative, China Patent Agent (H.K.) Ltd.
Mr Albert ZHANGWEI	Senior Patent Counsel, Huawei Technologies Co., Ltd

epi

Mr Francis LEYDER	President, **epi**
Mr Chris MERCER	Past President, **epi**

JPAA

Mr Satoru DENO	Executive Director, JPAA

KPAA

Mr Tae Jun SUH	Vice-President, KPAA

AIPPI

Ms Sarah MATHESON	Reporter General, AIPPI

FICPI

Mr Jérôme COLLIN	Partner, Regimbeau

WIPO

Mr. Marco ALEMAN	Director, Patent Law Division, WIPO

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IP AUSTRALIA

Ms Patricia KELLY	Director-General, IP Australia, Chair of the Group B+
Ms Alison GREEN	Assistant Director, International Policy and Cooperation
Mr George VUCKOVIC	General Manager of Patents Mechanical, Opposition and Hearing Group

CIPO

Mr Scott VASUDEV	Director, Patent Policy and International Affairs Division, CIPO
Mr Craig MACMILLAN	Program Manager, International, Patent Policy and International Affairs Division, CIPO

IPI

Mr Nicolas GUYOT	Avocat, Division Droit et Affaires Internationales

German Ministry of Justice and Consumer Affairs (BMJV)

Mr Klaus SCHUSTER	Judge, Staff Counsel, Division for Patent Law, BMJV

DPMA

Mr Oliver WERNER	Patent Examiner, DPMA

DKPTO

Mr Flemming KØNIG MEJL	Chief Technical Adviser, DKPTO

EPO

Mr Michael FRÖHLICH,	Director, European and International Affairs, PCT, EPO
Ms Paola GIANCANE	Lawyer, European and International Affairs, PCT, EPO
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Ms Sylvie STROBEL	Lawyer, European and International Affairs, PCT, EPO

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Mr Leopoldo BELDA SORIANO	Head of Patent Division, OEPM
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EUROPEAN COMMISSION

Ms Anne VON ZUKOWSKI	Policy Officer, DG for Internal Market, Industry, Entrepreneurship and SMEs, Intellectual property and Fight against Counterfeiting

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Mr Jonathan WITT	Examinateur brevet et chargé de mission au sein du pôle international, INPI

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Mr Andrew BARTLETT	Divisional Director, UK IPO
Ms Sarah WHITEHEAD	Senior Policy Advisor, UK IPO

USPTO

Mr Charles ELOSHWAY	Senior Patent Counsel, USPTO