



Patent Harmonisation – What is happening?

There are a number of patent harmonisation initiatives ongoing, some driven by the IP5 Offices and some through WIPO and the informal B+ subgroup. Most of these initiatives are concerned with procedural improvements aimed at making the patent prosecution process simpler to the benefit of the offices and users. However, since 2013 there has been a major push towards substantive patent law harmonisation driven by the chair of the Group B+, John Alty.

Procedural Harmonisation

Global Dossier

The Global Dossier (GD) project arose out of work initiated by the Trilateral Offices including that on the Common Application Format (CAF) and Common Citation Document (CCD), with the purpose of agreeing common procedures between the Offices. Both CAF and CCD have subsequently been taken over by the IP5 Heads.

The Global Dossier has been defined as a set of business services including an integrated on-line web portal / interface allowing users to access all available information about patents / applications in the offices; with confidential information to be limited to authorised persons.

The aim of the Global Dossier project is to enable communication and collaboration between applicants and examiners and between examiners in different offices, facilitating increased quality, harmonisation of office procedures, work sharing and acceleration of examination.

At the first meeting of the Global Dossier task force in January 2013 the industry representatives pushed for there to be more uniform formal documents that could be filed across the offices and a one portal access to enable simpler filing. The One Portal Dossier (OPD) arose out of this and has both “passive” and “active” components. So far, progress has only been made on the passive parts.

The EPO OPD interface is the most advanced and it is now possible to get, for example, Office Actions from the corresponding Chinese Application through the EPO website (together with machine translations). The last IP5 meeting discussed how to get alerts on change of status of an application at any of the IP5 Offices. The meeting also discussed whether it would be possible to achieve name standardisation across the Offices, perhaps by using a number system related to the English and local name of the company. One of the issues is how to deal with the same company having different names in different countries.

The USPTO have suggested exchanging documents that do not require review by local agents, for example in relation to the Patent Prosecution Highway (PPH), and proposed a “lockbox” system accessible by the agent for where local agent involvement is required. A pilot proof of concept of cross filing between the Offices has been proposed.

Patent Harmonisation Expert Panel (PHEP)

This is again an IP5 initiative, in this case a group of experts from the five offices looking at three areas where industry proposed that useful procedural harmonisation could occur to the benefit of both the users and the offices themselves.

1) Unity of invention

This is a contentious issue as the Offices have only agreed to apply a common standard for PCT applications, because of US concerns in relation to applying it to non-PCT applications. The USPTO has indicated that it needs time to see how the Cooperative Patent Classification (CPC) system works out and what potential reorganisation is required before committing to implement the PCT standard to non-PCT applications. IP5 Industry has suggested that Unity should be determined by the first Office examining the application and this should then be binding on the other Offices (with suitable provisions for appealing against an unfavourable decision of the first Office). JIPA have provided considerable research data on how the different offices handle unity of invention.

2) Citation of prior art

Citations are now being added to the CCD from all the IP5 countries although not all countries are yet adding information on whether the document is cited for novelty or inventive step. Industry is pushing for CCD and the GD to be used to fulfil the US information disclosure statement (IDS) requirement. The USPTO has agreed that IT solutions should be adopted to streamline citation practice but have indicated that it would take time to consider and implement this. The question of amending EP applications before grant to acknowledge the closest prior art was also raised again by industry representatives at the last IP5 meeting (these two issues were first raised at least five years ago!).

3) Written description / sufficiency

JIPA have carried out considerable research in this area and outlined differences in practice, for example SIPO appears to have a strict standard when it comes to supporting examples. JIPA will continue its work on this study. The EPO feels that the issue of written description / sufficiency is a complex one which requires further study.

Substantive Patent Law Harmonisation

The Tegernsee process initiated by the EPO, JPO and USPTO looked at four issues of substantive patent law that would benefit from harmonisation: grace period, conflicting applications, 18 month publication and prior user rights. A number of user meetings / consultations were carried out and the general conclusion was reached that it would be beneficial to achieve harmonisation in these areas. The IP Federation's position on these topics is to be found in its policy paper PP05/15, and CIPA has published a summary of the issues and positions on the four Tegernsee issues.

The project has been handed over to the informal B+ group of countries. It is encouraging that the Group B+ has taken over the responsibility for this project, under the chairmanship of the UK IPO's John Alty, and that it is making progress. This is bound to be slow; the users of each of the current systems often feel that their system is best, and finding a way to combine the optimal features of them all is difficult. However, the analysis of the different systems has enabled the principles and objectives behind them to be established and a number of common positions on the principles to be agreed.

From a European user's perspective, it is important that harmonisation of all four Tegernsee topics be achieved as a package rather than dealing with them piecemeal. In addition, sub-optimal harmonisation would be worse for applicants and the patent system than no harmonisation. For example, the increased certainty on assessing the validity / invalidity of a patent application in relation to third party disclosures provided by not having a grace period has been an important part of the EPC since it was set up. European users need reassurance that there are real benefits in moving to a new harmonised system that incorporates a grace period, and the package approach assists with this.

However, even in Europe, there is a wide spectrum of opinion on how far one should change the EPC, particularly on the details of any grace period and even on whether prior user rights should be limited to the country / region where use / planned use took place or should be worldwide (or at least as extensive as the countries that sign up to the agreement). This makes life challenging for Mr Alty and his colleagues to put it mildly!

Industry groups from Europe, Japan and the US (the Industry Trilateral), and more recently

also Korea, have been looking at these issues in parallel to the Patent Offices and have experienced the same challenges in achieving a common position. Fortunately, as with the discussions between the Offices themselves, there is a desire to make progress, and considerable common positions have been agreed on many topics. It is hoped that other user groups will become increasingly involved in the discussions in the future supporting progress towards agreement on a harmonised position.

The following is a summary on the current positions of the Group B+ and the Industry Tri-lateral (IT3) based on a table prepared by M. Jacques Combeau of Air Liquide (to whom many thanks).

1) Non-prejudicial disclosures / grace period

Amongst the Group B+ there is no consensus on whether applicants should be given an opportunity to patent their invention where they have disclosed it themselves, although there is more support, though not unanimity, for the opportunity to patent an invention which had been inadvertently disclosed. There is agreement that, if such a system were to be introduced:

- It should be simple, with the same rules applying to all applicants and all types of disclosure deriving from the applicant, regardless of the intention or characteristics of the applicant.
- Encouraging transparency of the fact that the grace period has been invoked, for example some form of declaration requirement, would increase legal certainty but place a burden on the applicant, and therefore further work should be conducted to explore how these factors could best be balanced.
- The duration of the grace period should be harmonised, and calculated from the priority date (some support 12 months others 6 months).

The Industry Trilateral position is that a grace period could be a component of a globally harmonised approach provided that it is endorsed by all. Furthermore, any solution should be sufficiently clearly defined to guarantee a uniform implementation in the different regions. In such circumstances, there is consensus: that a grace period should apply to disclosures by the inventor / applicant during the grace period; that disclosures by third parties that are independently invented are prejudicial; and that disclosures by third parties based on evident abuse are non-prejudicial. There is not yet consensus within the IT3 on the duration of a grace period or on the need for a declaration or how this would operate.

2) Conflicting applications

The Group B+ is agreed that:

- (i) The grant of multiple patents for the same invention in the same jurisdiction should be prevented
- (ii) The patent system should allow for the protection of incremental inventions while ensuring that patent rights are not unjustifiably extended
- (iii) Any system which allows incremental inventions to be patented should:
 - a) balance the interests of inventors to protect incremental improvements on their own inventions with the interests of third parties to operate in the same field; and
 - b) promote innovation and competition.

Furthermore, there may be benefits to a harmonised system on how PCT applications apply as secret prior art, i.e. either upon international publication in any language or only in those jurisdictions where they are or have been pending.

The IT3 has so far also been unable to reach consensus on the two main issues here, namely the prior art effect of conflicting applications (i.e. whether the prior application should be used for novelty and/or inventive step) and the "no self-collision" approach. On both issues a wide list of alternatives has been prepared for further discussions.

3) 18 month publication of patent applications

The Group B+ is agreed that applications should be published 18 months from the earliest priority date with the ability to suppress publication:

- if publication would be prejudicial to public order, morality, or national security;
- if the application contains offensive or disparaging material;
- if a court order specifies that an application should not be published.

The IT3 is agreed that all patent publications should be published at 18 months, with no opt-out, except for applications withdrawn, refused or deemed to be refused prior to publication, and those subject to national security.

4) Prior user rights

The Group B+ is agreed that a third party who has started using an invention in good faith prior to the filing of a patent application for that invention by another party should have a right to continue to use that invention and that the circumstances under which 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. There is also consensus within the Group B+ that prior user rights should be limited to the territory in which the activity giving rise to prior user rights has taken place.

The IT3 also agrees on the principles behind prior user rights but there is no consensus yet on whether or not prior user rights should be limited to only those countries / regions where prior use has (or effective preparations have) taken place.

The IT3 will be meeting informally to consider the unresolved issues further in London in December and then again, as part of the Trilateral meetings, in Washington in February 2016. The Group B+ has set up four work streams tasked with developing proposals on the three major unresolved topics and on the eventual implementation of any agreement. These work streams will consult more widely than to date and will be reporting initially in May 2016 with the aim of presenting concrete proposals at the next B+ plenary meeting in October 2016. This is an ambitious timetable. However, Mr Alty and his team have done an excellent job to date and I have every confidence that they will continue to push the harmonisation agenda forward constructively. There is no doubt that this is a worthwhile and important topic both for the users and for the Offices themselves.

Tony Rollins, Rollins IP Strategies Ltd, 30 November 2015