



Patent Law Harmonisation Review

This review, as in previous years, is concerned with progress on procedural patent law harmonisation at the IP5 Offices and discussions on substantive patent law harmonisation (SPLH) taking place before the B+ group of developed countries.

Procedural Patent Law Harmonisation

A virtual meeting between the Heads of the IP5 Offices and industry was held on 8 June 2022 and jointly chaired by the EPO and BusinessEurope. It was the 10th anniversary of such meetings.

The meeting was split into two: a celebration of 10 years of the Offices working with industry (with an update of recent achievements) and a strategic topic: “sustainability”. There were short videos on both topics prepared by the EPO.

Update of Recent Achievements by the Offices

- 1) Interested parties can now subscribe to an e-mail alerting service to be notified of data changes in relation to specified applications as a result of the Global Dossier Alerting Project. It is hoped that all the Offices can complete their planned work on the Global Dossier Project.
- 2) Project briefs have been issued for work on classification of AI inventions, AI assisted CPC, the collection of existing materials on examination of AI inventions and a comparative study on examination practices at the Offices in relation to AI inventions. The Offices agreed to collaborate with the industry task force on this topic and it was suggested that a catalogue of terms and definitions used would assist.
- 3) A key issue to be resolved in the IP5 Collaboration and Search Project is how this should be financed. IT resource is also required. A detailed progress report on this work would be welcome.
- 4) In the Global Assignment Project, the Offices are looking at: using common forms, alignment of the Offices’ requirements and a repository for Global Assignments (WIPO had been suggested in the past).
- 5) Allowable features in drawings: There has been good progress on this, and industry looks forward to an “IP5 Safe Format” brochure.

Feedback was provided that it was hoped that the IP5 Offices would use harmonisation as a tool to reduce the administrative burden on applicants. The US Information Disclosure Statement and documents sharing (through Global Dossier) were given as examples. The Offices should promote digitalisation and machine translation; digital signatures was given as an example of where cooperation would be beneficial.

The Strategic Topic: sustainability

EPO President Campinos introduced this topic, and the EPO Chief Sustainability Officer Roberta Romano-Götsch spoke about the establishment of the EPO Observatory. How can the IP5 Offices/Industry collaboration promote sustainability?.

Thierry Sueur (BusinessEurope) responded on behalf of industry that it was important to stress the inter-relationship between innovation, sustainability and IP. The Offices and industry should exchange information on this and how to promote greater understanding of it.

The following were mentioned:

- The JPO work with WIPO on WIPO Green, the use of licensing to stimulate innovation and enable new technologies to be developed and exploited, patent landscape information needs to be more widely available and the USPTO's report on IP Intensive Industries (published on March 17th) which, amongst other things, showed a lack of diversity and inclusion amongst patent inventors. The EPO/EUIPO report on IP Intensive Industries and economic performance in the EU was published in October 2022.
- BusinessEurope is leading an IP5 Industry working group tasked with providing a proposal to the Offices by the end of quarter one of 2022 on the increased use of e-signatures.

Substantive Patent Law Harmonisation

A virtual meeting of the IP Offices of the B+ group and the Industry Trilateral, AIPPI and FICPI was held on 21 September 2022 and chaired by the head of the French INPI, Pascal Faure.

The Australian, Canadian and Japanese Patent Offices and the EPO reported on their surveys/consultations on the grace period. There was overwhelming support for SPLH and for a grace period (Europe 62% for, 25% against). The Australian and Canadian Offices specifically mentioned their support for a 12-month grace period based on the national filing date. The EPO and Japanese reports were the more detailed.

In the EPO consultation, the IT3 Elements Paper was preferred over the AIPPI/FICPI proposals as a whole, but AIPPI/FICPI were preferred on Conflicting Applications and prior user rights (PURs). The accelerated publication proposal in the Elements Paper was seen as a big positive. The EPO felt that modifications were required in the Elements Paper on PURs and for when the Statement (identifying the pre-filing disclosures of the applicant which are to be graced) needs to be filed; these would assist in ensuring that the new system would be a first-to-file one. The EPO also reviewed its survey carried out earlier in the year which showed that SMEs and universities would favour a grace period. The JPO reviewed its study showing the benefits of the grace period to SMEs and universities. It is understood that the B+ is continuing its work on this topic and has set up a number of working groups to report back at the 2023 B+ meeting.

Attorney Client Privilege

This was also discussed at the B+ meeting. A revised version of the proposal was presented by the Swiss IPI. There are still some concerns over whether this adequately covers in-house IP staff and these are being considered by the IP Federation and BusinessEurope.

Trilateral Heads Meeting with Industry

The Industry Trilateral held a face-to-face meeting with the Trilateral Offices in North Carolina on 8 November 2022. Topics under discussion included: digitalisation efforts and initiatives before the Offices that support innovation and business communities and promote the use of the IP system; reports by the Offices on IP-intensive industries and

how these support the economy; ways that the Offices and industry can engage and support small and medium-sized enterprises and encourage them to participate in the IP ecosystem; and how to make the innovation system more inclusive. The Offices referred to a number of reports they had published over the last year on the topics and outlined what they propose to do in the future. Industry provided feedback - for example it would be useful if the Offices used consistent methodology in preparing reports - and suggested how the message that IP is good for society could reach a wider audience. There was also a discussion on how the Office/Industry cooperation could create further efficiencies in the IP system in the future and the Industry Trilateral proposed a number of specific projects in this respect.

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