Should it be graced?

A review of the current Patent Harmonisation Initiatives

We are in a unique position where there are several patent harmonisation initiatives being pursued by the larger Patent Offices. There is an active industry participation in these activities and it is to be hoped that major changes that are beneficial to the users and the Offices result.

The Industry Trilateral (representatives from BUSINESSEUROPE, the Japan Intellectual Property Association (JIPA), the Intellectual Property Owners Association (IPO) and the American Intellectual Property Law Association (AIPLA)) have been meeting with the Trilateral Offices for over ten years in attempts to harmonise procedures to the joint benefit of the Offices and users. Two notable successes originating from ideas proposed by the Industry Trilateral are the Common Application Format and the Common Citation Document.

Since 2008 the IP5 Offices (the EPO, JPO, KIPO, SIPO and USPTO) have been working progressively more closely together so that they have now subsumed most of the Industry Trilateral projects (including CAF, CCD and work on patent quality) and in addition have set up a classification working group (WG1), the Global Dossier and patent information working group (WG2), the work sharing and quality working group (WG3) and a Patent Harmonisation Expert Panel (PHEP) looking at potential procedural harmonisation topics. All three of the working groups and the PHEP should lead to major harmonisation advances to the benefits of users as well as the IP5 Offices themselves.

The Classification Working Group

WG1 is concerned with harmonising the classification systems of the Offices by expanding on the Cooperative Patent Classification System initiated between the USPTO and the EPO in 2010 by bringing in the other IP5 members as much as possible and revising the International Patent Classification where the classification schemes match.

Global Dossier

The Global Dossier project is a joint IP5 project with industry. The first joint taskforce meeting was held at the EPO in The Hague in January 2013. At the end of this meeting the industry representatives agreed that the Global Dossier taskforce should work towards a set of business services including an integrated online web portal / interface allowing users to access all available information about patents / applications in the offices; confidential information to be limited to authorised persons. In addition, it was agreed that the Global Dossier should 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.

In relation to the passive (dossier information) component of the Global Dossier service, information is now available on the European Patent Register of Chinese equivalents of European Patent Applications. Access is also possible through the Register to the Chinese file wrapper (and a translation!) of that equivalent application. Korean and Japanese data are hoped to be available during the first quarter of 2015 and US data in the second quarter. The other IP5 Offices will prepare their own versions of the Global Dossier. The next stage of the Global Dossier is the active phase which will be concerned with real time access to information held by the IP5 Offices and hopefully some standardisation of the forms required by the Offices and how these can be submitted electronically.

Patent Harmonisation Expert Panel

The three topics proposed by industry representatives for consideration by the PHEP are unity of invention (lead EPO & SIPO), citation of prior art (lead KIPO & USPTO) and written description / clarity / enablement / sufficiency requirements (lead JPO). Each group is preparing a comparative table / report and it is hoped that these can be analysed and proposals made at the IP5 Heads meeting in May 2015.

Substantive Patent Law Harmonisation

The Tegernsee process was an opportunity for the Trilateral Offices (and the UK, Danish, French and German Patent Offices) to look at more substantive matters of patent harmonisation, specifically grace periods, conflicting applications, prior user rights and the 18 month publication of all pending applications. Whilst there were significant differences in the preferred outcomes, depending on the nationality of the Office conducting the consultation, there was an overall desire for harmonisation and some flexibility expressed on this. At a meeting the Industry Trilateral held with the Trilateral Offices in September 2013, it was suggested by the Offices that harmonisation should be user driven and that a suitable forum for considering harmonisation further was the WIPO B+ group of nations. John Alty of the UK IPO is the current chair of the B+ group and a subgroup has been set up to work on these issues under his leadership. In the meantime, Industry Trilateral representatives are in detailed discussions to see if differences in their laws can be reconciled and a proposal acceptable to all agreed upon.

It is the view of the IP Federation, and probably the other industry federations across Europe, that agreement has to be reached on all four issues and that one cannot have, for example, simply an agreement on a grace period.

The IP Federation position paper (PP06/14) on the four issues is summarised below:

Grace period

The Federation is in favour of introducing a grace period during which the disclosure of an invention by the inventor will not invalidate a subsequent patent application for the invention, provided that certain conditions[1] are met, as outlined below.

1) The benefit of grace should only be given to the inventor's own earlier disclosure. Information disclosed by a third party should not be graced relative to the inventor's patent application, except where the information disclosed by the third party is a straightforward reproduction of all or part of the inventor's disclosure.
2) The grace period should be for twelve months before the priority date of the corresponding patent application.
3) A declaration / statement should be made at the time of filing a corresponding patent application which should itemise the inventor's own disclosures and any other known disclosures that should be graced. This declaration will be essential to interested third parties, patent examiners and the courts when assessing the scope and validity of the patent.
4) The onus must be on the inventor / applicant to justify any claim for grace in respect of any prior disclosure.

No rights from the graced disclosure

A graced disclosure will be part of the prior art as regards patent applications of later date by third parties, but should not establish any right to prevent the use or development of products or processes by others.

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[1] In relation to the conditions, the position expressed does not represent the view of all members, but represents the view of the majority.

A patent application for the invention in the graced disclosure should not have any right over an application for an independently made invention of earlier priority date, even where this date is within the grace period.

Prior user rights

In first to file systems, prior user rights are essential to safeguard the interests of those who have invented and made preparations to manufacture or use a product or process, without applying for a patent on it. (Prior user rights should be mandatory, not optional, and should permit the prior user to develop his/her product, process and/or manufacturing capacity.) Prior use might start within the grace period.

Co-pending applications

The Federation does not support double patenting, whether the two applications are from the same or different applicants. A simple novelty approach as between co-pending applications is the fair way to ensure there is no double patenting.

Mandatory 18 month publication for unclassified applications

The Federation considers that publication of applications at 18 months from their priority dates should be a very important feature of a harmonisation treaty. 18 month publication ensures that “submarine” applications do not remain unpublished for several years following filing.

Tony Rollins, 17 December 2014