



## Patent law harmonisation

### Substantive patent law harmonisation (SPLH)

Since last year's Review, there has been considerable activity in substantive patent law harmonisation (SPLH) .

In early 2023, the EPO carried out a consultation amongst user organisations, including hosting two seminars at the EPO. The IP Federation provided a response to the consultation and was represented at the seminars. .

In July, a plenary session of the B+ Group of nations' patent experts was held.

The EPO gave a short summary of the results of its earlier consultation process. 79% were in favour of a grace period provided this was part of a balanced package with a "safety net" for third parties. There was support for "deep" harmonisation of prior user rights with objective criteria for these. From the EPO's perspective the takeaways from the consultation process were that Europe was interested in SPLH and that there was a readiness and momentum in Europe to accept a grace period as part of an SPLH package.

The UK IPO then reported on its comparative analysis of 22 national offices' consultations on SPLH. The key features were:

- strong support for SPLH
- consensus that this should contain provisions on the 18-month publication of all patent applications (other than those containing security matters)
- in relation to a grace period, consensus on types of disclosure, burden of proof and rejection of the proposed Defence of Intervening User
- on prior user rights there was a large degree of consensus but differences on details including its integration with the grace period and the need for good faith

The UK IPO concluded that this was a useful exercise that showed that there was support for SPLH, there were many areas where there was agreement and that going forward, B+ should prioritise its discussions on areas of divergence. Further work on these areas of divergence is anticipated in early 2024 with the aim of preparing a report to be presented at the 2024 plenary session of B+.

The IP Federation was given the opportunity to present its position on SPLH (which it had agreed with CIPA) at the B+ meeting and it was asked by the Chair to provide this in writing; which it has done. In summary, the IP Federation's position is that it supports a balanced harmonised package such as that contained in the Industry Trilateral Elements Paper.

#### *Grace Period*

On grace periods, there was support for a 12-month grace period calculated from the priority date. It should cover intentional and non-intentional disclosures. In order to claim the grace period, the patent applicant should file a statement within 16 months of the pre-filing disclosure

and preferably when filing the patent application to be graced. The filing of the statement will trigger early publication of the patent application at 18 months from the pre-filing disclosure (PFD).

The early publication of the patent application (18 months from the PFD), other than for those patent applications classified for security purposes, is one of the most important achievements of the Elements Paper; it means that the uncertainty to third parties as to whether patent protection has been sought for the subject matter of a pre-filing disclosure is the same as it is in the present EPC system. The IP Federation believes that normally the statement should be filed within 16 months of the PFD. This is an important safeguard to ensure that we are not moving to a first-to-publish system. However, if the applicant is not aware of the PFD then it is felt that some flexibility should be allowed on when the statement is filed.

Intervening disclosures of independent inventions by third parties should form prior art to an application claiming the benefit of a grace period. This is an important safeguard against the system becoming a first-to-publish one. In addition, the burden of proof to show that a PFD is graced should rest on the applicant. Again, this is a safeguard against the system becoming a first-to-publish one.

Intentional and unintentional disclosures are both believed to be suitable subject-matter for a grace period as it is sometimes necessary to disclose trials of the invention in public before a patent application is filed, or in order to obtain funding for the development of the invention.

#### *Prior User Rights*

The IP Federation supports fully derived prior user rights (PURs), i.e. a third party may acquire PURs based on making serious and effective preparations for use, or use itself, of the invention disclosed in the pre-filing disclosure if this activity occurred before the patent application was filed. Again, this is an important safeguard to ensure we are not moving to a first-to-publish system. Details of the scope of PURs should be agreed as part of the SPLH process.

#### *Conflicting Applications*

On conflicting applications, views have been expressed that it would be better to support either the EPC system or the US system as attorneys are familiar with these rather than to construct something new. However, some compromise between the two systems, for example the proposals contained in the Elements Paper, will probably be needed and the IP Federation would support such compromise as part of a balanced package.

The IP Federation supports PCT applications becoming conflicting applications upon their publication at 18 months, regardless of whether they enter the national/regional phase.

Finally, BusinessEurope (BE) has come up with a position on SPLH after two and a half years of internal discussions. Unfortunately, this is significantly different from the Industry Trilateral and IP Federation positions. It is very close to the position that BE started off with at the beginning of the Industry Trilateral SPLH process which through negotiation (in which BE including the IP Federation actively participated) led to the Elements Paper.

#### **Procedural patent law harmonisation**

In March, there were meetings of the IP5 Patent Harmonisation Expert Panel and Global Dossier Task Force and a joint IP5 Offices' Heads and Industry IP5 Meeting in June. The IP5 Heads/Industry meeting considered future work concerning NET/AI and an update on the IP5 NET/AI Roadmap, efforts to improve e-signature requirements (a project to consider this was approved at the meeting),

progress on global assignment forms including a proposal from Industry IP5 that an optional modifiable standard short form assignment be prepared that could be completed with e-signatures and filed at a central depository (such as WIPO), enhancements to Global Dossier in which XMLisation was discussed and the harmonisation of allowable features in drawings.

Tony Rollins  
Policy advisor