



Patent Harmonisation Activities

1. Introduction

There have been two main areas of activity concerning attempts to harmonise and improve the patent system in 2021: Substantive patent law harmonisation (SPLH) in conjunction with the B+ group of WIPO nations and procedural harmonisation before the IP5 group of Patent Offices.

2. SPLH

In my article for the *IP Federation Review* last year, I summarised the major points contained in the “Policy and Elements for a Possible Substantive Patent Harmonisation Package” submission (the Elements Paper) made by the Industry Trilateral (IT3, comprising American Intellectual Property Association, BusinessEurope, Intellectual Property Owners Association, and the Japan Intellectual Property Association) to the B+ group of WIPO nations (which was established to promote and facilitate progress on SPLH) in September 2020. This resulted in a number of questions from the B+ which the IT3 replied to at a meeting in May 2021. In addition, the B+ had requested the IT3 to produce a set of objective criteria to assist in clarifying the scope of prior user rights and the IT3 has done significant work on this in 2021. Finally, the IT3 agreed that the B+ Patent Offices should be free to publish the Elements Paper to aid in consultation and discussion on this important topic even though there are still items yet to be agreed upon by the IT3.

The questions from the B+ on the Elements Paper covered the major topics contained within it: grace period, conflicting applications and prior user rights (PUR). The major concerns were with the complexity of the paper and whether the Elements Paper provides sufficient safeguards to prevent the proposed system becoming a “first to publish system” (one of the stated objectives of the proposals put forward is that the new system should not become a first to publish one). The IT3 will consider the feedback from the B+ on these two issues further.

The objective criteria are intended to assist in determining the scope of prior user rights once these have accrued and to provide greater certainty for patent holders and third parties on these rights. The discussions include three main activities: (i) changes in the volume of the product produced from that which the third party produced when it established its prior user right, (ii) changes or modifications to the original embodiment produced by the third party and (iii) changes in the category or type of infringing act, for example importing a product rather than manufacturing it. It is hoped that the IT3 can make progress on potential improvements to the Elements Paper and the objective criteria on the scope of PUR in the near future. The publication of the Elements Paper should also enable further feedback to be obtained from other stakeholders benefitting the process.

3. IP5 discussions on procedural harmonisation

(i) Introduction

In February 2021 there were joint meetings of the IP5 (the Chinese, European, Japanese, Korean and US Patent Offices) with the IP5 Industry group (the IT3 plus Patent Public Advisory Committee (PPAC) and Korea Intellectual Property Association (KINPA) concerning the Industry Consultation Group (in February), the Global Dossier Task Force (March) and a meeting with the IP5 Heads in June.

(ii) IP5 Industry Consultation Group (ICG) meeting

Future IP5 Patent Harmonisation Expert Panel (PHEP) topics: IP5 Industry expressed its expectation for IP5 Offices to agree on electronic signature standards so that a global assignment form could be filed with electronic signatures. IP5 Industry also expressed their interest in the harmonisation of allowable features in drawings.

Measures taken by each IP5 Office that are beneficial to users: IP5 Industry representatives drew attention to specific and helpful measures implemented by individual Offices.

IP5 NET/AI Task Force: IP5 Offices provided an overview of the current status and next steps in the work of the IP5 NET/AI Task Force, highlighting that the Task Force members were currently evaluating possible project proposals from the IP5 Offices according to the Scoping Document, in order to develop an IP5 NET/AI roadmap for the endorsement by the IP5 Heads in June.

(iii) Global Dossier Task Force (GDTF) meeting

Feedback on current Global Dossier services: IP5 Industry gave favourable feedback on their experiences with the existing Global Dossier services being provided by the IP5 Offices stressing the importance of completeness, timeliness and availability of Global Dossier.

Prioritisation of five Global Dossier tasks: IP5 Industry suggested demand-based prioritisation for the five Global Dossier tasks, indicating that XMLization and Inter-office Document Sharing are seen as two top priorities. IP5 Industry also expects progress in relation to Alerting, Legal Status and Applicant Name Standardisation but these are seen as long-term initiatives.

NET/AI Utilisation: Each IP5 Office provided an update of the AI tools used in their own procedures. IP5 Industry expressed its hope that AI tools, after being developed and applied in the IP5 Offices, would become accessible to users as well.

(iv) IP5 Heads/IP5 Industry Meeting

The meeting was jointly chaired by JPO and JIPA.

Introductory remarks referred to a WIPO Green Event in Japan and its relevance to the Strategic Topic on the agenda.

1) Agenda Items

1. Patent Harmonization Expert Panel (PHEP) New Topics: It was announced by the Offices that the two topics, Global Assignment and Allowable Features in Drawings, were due to be approved at the formal closed Heads meeting the next day. KIPO and USPTO will take the lead on the Global Assignment project whilst the JPO will lead on the harmonisation of features in drawings.
2. NET/AI: A Roadmap has been produced by the Offices that focuses on both legal and IT aspects (this has now been published on the IP5 website), the European Patent Office (EPO) indicated that this is the foundation for Offices to excel, Offices now have to put it into practice.

IP5 Industry reported that it is setting up its own task force to assist the Offices.

2) Strategic Topic

IP5 Cooperation in a post-pandemic era

The IP5 Offices indicated that digitalisation transformation is key. Many Offices had introduced digital signatures during the pandemic but further work on this still needs to be done as well as introducing video interviews/hearings.

All seemed to be in agreement that there should be more study and discussion of the benefits of IP to society.

3) Next Meeting

The next IP5 Heads meeting will be organised by the EPO in collaboration with BusinessEurope in Munich the week of June 6–10th 2022. The EPO mentioned that the meeting would cover accessibility of IP system to users and generation of pro-IP culture as well as increasing IP visibility in general and how it can solve societal and economic issues.

Tony Rollins, Policy Advisor