

Industry IP5 Consensus Proposals to the IP5 Patent Harmonization Experts Panel (PHEP)

October 10, 2014

The six Industry IP5 Associations have approved in principle and hereby present the following consensus proposals to the IP5 Offices, concerning the three procedural harmonization issues that will initially be taken up by the IP5 Patent Harmonization Experts Panel (PHEP):

American Intellectual Property Law Association (AIPLA)

Intellectual Property Owners (IPO)

Japan Intellectual Property Association (JIPA)

BusinessEurope (BE)

Korean Intellectual Property Association (KINPA)

Patent Protection Association of China (PPAC)

Proposal 1. Unity of Invention

The above-mentioned Industry IP5 Association propose that the IP5 Offices adopt the following principles concerning Unity of Invention:

BASIC PRINCIPLES:

- All IP5 Offices should use Unity of Invention.
 - In applying Unity the Offices should adhere to the PCT standard for Unity.
 - In applying the PCT standard the Offices should adopt uniform guidelines:
 - The Offices should study actual cases to determine if they are currently making different determinations, and how to achieve uniformity.
- The IP5 Offices should consider studying the relationship of Unity of Invention to the uniform CPC classification system.

- There should be coordination opportunities among the Offices to implement the PCT standard and the uniform guidelines.

SECOND STAGE

- Under conditions where all the Offices have implemented the above-mentioned standard and the guidelines for a sufficient time, a preferred future step would be for the first Patent Office that performs a search / written opinion on an application to be the patent office that makes a rebuttable determination on Unity of Invention.
- The following proposals to achieve this future step are hereby shared with the IP5 Offices, to be taken into account in future discussions:
 - 1) The rebuttable determination by the first Office should be followed, if at all possible, by the other Offices.
 - 2) The Office that performs the determination could be, e.g., the Office of priority filing; if the priority application is a “non-searched” application, it could be the PCT searching authority.
 - 3) If the first Office determines that there is a lack of Unity, it shall clearly state and define the group(s) of inventions that are found to lack Unity, i.e. that are seen as not being based on a common inventive concept.
 - Once lack of Unity is established, the applicant should have the opportunity to select one or more inventions, in regard to which the search is finalized and which is then the “searched” invention.
 - 4) The IP5 Offices should consider appropriate procedures for rebutting the initial Unity determination. Procedural details, e.g. timing, scope, etc., should be carefully considered, with the goal of minimal financial burden for applicants.
 - 5) Time limits should be set for the first search / written opinion and Unity determination; it should be considered whether the time limit should include appeal within the first Office.
 - 6) There should be coordination among the Offices to maintain uniformity of determinations.
 - 7) There could also possibly be a rebuttable classification determination made by that Office at the same time.

Proposal 2. Citation of Prior Art

The above-mentioned Industry IP5 Association propose that the IP5 Offices adopt the following principles concerning Citation of Prior Art:

BASIC PRINCIPLES:

- The IP5 Offices should adopt an automatic, electronic Prior Art Citation practice, whereby prior art that is already cited with respect to the application or a related application in any IP5 Office, and is available to an Office, does not need to be further cited to that Office, and all duties and obligations of disclosure shall be deemed automatically fulfilled. Examiners will be deemed to have considered any such prior art.
 - The Offices should consider procedures whereby the applicant can become aware of what prior art has been made available to the Office, and consequently does not need to be further submitted.
- The Offices should maximize use of CCD and Global Dossier to fulfill disclosure requirements.
- The Offices should also clarify parameters for acceptance of machine translations of prior art references.

OFFICE-SPECIFIC:

- USPTO should modify IDS requirements, in order to minimize burdens on applicants.
- EPO should eliminate the requirement of incorporating prior art reference(s) in an application before grant. This would eliminate cost burden.
- JPO and KIPO should eliminate the requirement of incorporating prior art citations into the patent application. This would ease the burden of revising applications.

ADDITIONAL DETAILS:

- Cited prior art available to Examiners through the Global Dossier/CCD or in their own Office relating to the family of an application should be regarded as having been submitted.
 - There would be a presumption that the cited prior art was reviewed by the Examiner.

- This would ease the burden of prior art submissions and citations, etc.
- The Offices should consider procedures to assure that only references already entered into GD/CCD prior to the relevant action of the Office (e.g., issuance of an Office Action, Notice of Allowance, etc.) will be presumed to have been reviewed by the Examiner.
 - One possible procedure could be, for example, the date stamping of information entered into GD/CCD, provided that this does not create an additional monitoring burden on the applicant.
- For references that are entered into GD/CCD on or after the date of the relevant action, the Offices should consider whether the applicant's duties and obligations of disclosure shall be deemed fulfilled.
- References that are properly mentioned in the specification should be presumed adequately cited and considered, provided they are available to the Office (possibly not including non-patent literature, except, for example, documents such as publicly available standards documents).
- The Offices might consider to adopt a common citation form similar to the PCT Search Report, which would be used by Examiners, third party submissions and applicants (e.g., as a replacement for IDS form and in any forms in Offices requiring citation of references).
 - Applicants would not have to fill in "x" or "y", and possibly not identify relevant claims or relevant portions of citations.
 - Perhaps the common form can be uploaded and shared among the IP5 Offices.

Proposal 3. Written Description

The above-mentioned Industry IP5 Association propose that the IP5 Offices adopt the following principles concerning Written Description:

BASIC PRINCIPLES:

- Although this may be the most difficult issue to harmonize overall, it may be the most important. It would also be meaningful to consider an initial narrow approach, such as a pilot project and office-specific analysis, as described below.

- PHEP in conjunction with Industry IP5 should study how written description and other disclosure and claim requirements are handled by each of the IP5 Offices, and what problems exist.
- PHEP in conjunction with Industry IP5 should clarify the meaning of various terminology used by the different IP5 Offices, and how the terms are applied in actual practice.
 - E.g., written description, enablement, support, sufficiency of disclosure, clarity, etc.
 - The meaning of the terms may be dependent on different technical fields.
- Ultimately, clear and uniform requirements for clarity, enablement, written description, support and sufficiency of disclosure should be worked out and adhered to by all IP5 Offices.
 - A pilot might be set up by selecting certain fields of technology in which to apply common rules.
 - Uniform requirements should be set up by the Offices for original claims and for new/amended claims.
 - The relationship between new/amended claims and introduction of new matter should be addressed.
 - The Offices should consider developing guidelines for interpreting the definitions of these terms, for example taking into consideration glossaries, the closeness of the prior art, etc.

OFFICE-SPECIFIC:

- Some areas of major differences among the Offices may include:
 - Limit of claims to examples shown vs. rely on description of entire specification.
 - Claims reciting known structure with new function.
 - Claiming an essential component where examples all include secondary components.
 - Requiring showing in a drawing every element claimed, even if the element is understood.

- Amount of scientific data required in a patent specification to support patent claims.
- Requiring direct and unambiguous support for claim amendments.

[END]