

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Harmonization Expert Panel (PHEP) – New Topics

IP5 Heads and IP5 Industry Meeting

June 2021

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Candidate topics

List of Future PHEP Topics (in no order of priority)

1. Adoption of a global assignment: the ability to file a global assignment in one location with effect worldwide - point 6 of the original 2013 Industry IP5 Harmonization Topics List
2. Patent Specification:
 - a. Harmonization of claim formalities such as: (i) eliminating the need for two-part format and the standard wordings 'characterised in that', and (ii) multiple dependency requirements
 - b. Harmonization of allowable features in drawings (e.g., color, how it should look)
 - c. Harmonization and simplification of requirements for correspondence between claims and the specification - eliminating need to later amend a specification to include allowed claim text
 - d. Remove requirement in Europe to insert closest prior art in specification, and JP requirement for prior art in background.
3. Harmonization of how applicants can correct mistakes
4. Harmonization on reinstatement of rights (to unintentional standard)
5. Roadmap and facilitation for handling first-filing requirements in multinational inventorship situations



Background

- IP5 offices and IP5 Industry agreed in principle that new topics should:
 - Be procedural or administrative in nature, rather than requiring changes in substantive patenting requirements
 - Have a large impact on patent applicants
 - Be within the scope of the IP5 office responsibilities
 - Allow for quick wins and long-term improvements

PHEP New topics

1. Adoption of a global assignment

(Lead Offices: KIPO/USPTO)

- Goal is to provide the ability to file a single assignment in one location with effect worldwide

2. Harmonization of allowable features in drawings

(Lead Office: JPO)

- Goal is to reduce the burden on users arising from the variation in formal requirements for drawings among offices

Next steps

- **IP5 Heads meeting – June 23, 2021**
 - Seek endorsement of the two topics
- **Summer 2021**
 - Begin phase one work

THANK YOU

