

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

Industry Harmonization List for Patent Harmonization Experts Panel (PHEP)

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Industry IP5, Busan, Republic of Korea, June 4 & 5, 2014

Cupertino, CA, June 2013

An Industry List of priority topics for procedural patent harmonization was proposed at the IP5 meeting in Cupertino, and welcomed by the Offices.

September 2013

**Our “Industry IP5 Harmonization
Topics List: High Priority Topics”
was submitted to the Offices
in September 2013**

Industry Priority List (i)

- **Common Patent Procedures**
 - **Methodology for Applying Nonobviousness/
Inventive Step**
 - **Citation of Prior Art**
 - **Unity of Invention**
 - **Written Description and Sufficiency of Disclosure**
 - **Claim Drafting and Structure**
 - **Patent Assignment and License Recordal**
 - **Claim Interpretation**

Industry Priority List (ii)

- **Global Dossier-related Patent Procedures**
 - **Global assignments, transfers and changes to powers of attorney**
 - **Electronic Priority Document**
 - **Accept electronic existence of a priority document without need to have a copy in each patent office**
 - **Using CCD to meet prior art citation requirements**
 - **Harmonize written description requirements**
 - **Harmonize standards of patentability**

A Reduced List to Start With

- **At the Trilateral meetings in Trieste, Italy, April 2014, Industry and Offices came up with a shortened list of three priority issues to propose to IP5, for initial consideration by PHEP:**
 - **Citation of Prior Art**
 - **Written Description and Sufficiency of Disclosure**
 - **Unity of Invention**
- **These will be discussed today.**

Citation of Prior Art of IP5

	USPTO	KIPO	EPO	SIPO	JPO
Current Citation System	IDS (Anytime when relevant art is discovered)	At the time of filing it is necessary to insert into the background of the invention all related prior art	Invite the applicant to provide information on prior art	At the time of filing it is necessary to insert into the background of the invention all related prior art Require to submit document	At the time of filing it is necessary to insert into the background of the invention all related prior art.
Burden on Applicants	Submitting IDS for prior art cited from co-pending family applications in other patent offices Dumping prior art in order to avoid inequitable conduct Requiring unique application of US	Requiring unique application of Korea and requiring time and the agent to revise the background of the application before filing in Korea. However, no inequitable conduct issue	Modifying the application to recite the closest prior art	No inequitable conduct	Requiring unique application of Japan and requiring time and the agent to revise the background of the application before filing in Japan. However, no inequitable conduct issue.