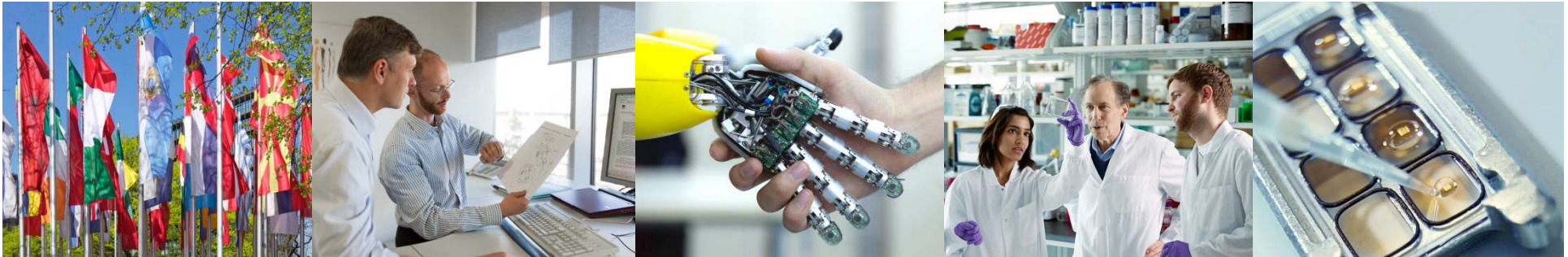




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# Discussion on the future work of the IP5 PHEP

IP5 ICG, The Hague, 16 January 2019



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16 January 2019

## Procedural patent harmonisation – IP5 PHEP

- IP5 PHEP
  - established in 2012
  - promote alignment of practices among the IP5
  - impetus provided by IP5 Industry

<http://www.fiveipoffices.org/activities/harmonisation.html>

# Procedural patent harmonisation – IP5 PHEP

- Industry IP5 Harmonisation Topics List, September 2013
- 1. Methodology for Applying non-obviousness / Inventive Step
- 2. Citation of prior art (KIPO/USPTO)
- 3. Unity of invention (EPO/CNIPA)
- 4. Written description and sufficiency of disclosure (JPO)
- 5. Claim Drafting and Structure
- 6. Patent Assignment and License Recordal
- 7. Claim Interpretation

# Procedural patent harmonisation – IP5 PHEP

## 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 Harmonisation 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 (see next slide)

Industry IP5 Meeting with IP5 Heads of Offices, June 13, 2018

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## Future work of PHEP

- Industry IP5 remains interested in the work of the PHEP
- Focus on **procedural** issues
- IP5 PHEP “**lessons learned**”
  - acknowledge **constraints**, e.g. nature of harmonisation work and availability of resources
- **Set realistic, manageable goals**
  - topics clearly defined
  - meaningful, achievable results

## Future work of PHEP

- Selection of PHEP topics: **priority for 2019**
  - Continue discussions with Industry IP5 re future **PHEP work plan**
  - USPTO outreach to IP5 Industry December 2018
  - Better understand the **June 2018 proposal**
    - specific issues to be tackled
    - direction to follow
    - envisaged tangible outcomes/benefits
  - Carry out feasibility assessment

## Next steps

- Continue discussion
  - ad hoc PHEP April 2019 (tbc)
  - IP5 Heads and Industry meeting June 2019
  
- Consider other possible candidate topics
  - AI legal issues
  - other topics?



Thank you for your attention!