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

<table>
<thead>
<tr>
<th>Current Citation System</th>
<th>USPTO</th>
<th>KIPO</th>
<th>EPO</th>
<th>SIPO</th>
<th>JPO</th>
</tr>
</thead>
<tbody>
<tr>
<td>IDS (Anytime when relevant art is discovered)</td>
<td>At the time of filing it is necessary to insert into the background of the invention all related prior art</td>
<td>Invite the applicant to provide information on prior art</td>
<td>At the time of filing it is necessary to insert into the background of the invention all related prior art</td>
<td>Require to submit document</td>
<td>At the time of filing it is necessary to insert into the background of the invention all related prior art.</td>
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</tbody>
</table>

| Burden on Applicants | Submitting IDS for prior art cited from co-pending family applications in other patent offices | Requiring unique application of Korea and requiring time and the agent to revise the background of the application before filing in Korea. | 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 |