

# Key Patent Harmonization Issues

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# Governmental Efforts

- **2011-2014** –Trilateral Offices (USPTO, EPO, JPO) and others form Tegernsee Group to study four key harmonization issues in 2012 and Report in 2014 led to a new initiative:
  - Prior User Rights, Grace Period, Conflicting Applications, 18-month Publication
- **2014-Present** – Group B+ assumes responsibility for the initiative among governments on the 4 Tegernsee Topics
  - Prepared an **Objectives and Principles Paper** (2015)
  - Established separate **Work Streams** (2016)
  - Held Industry/Government **Symposium and Meetings** (2017)
  - B+ Subgroup Meeting and IT Met in Geneva (9/26/18)
  - B+ Comment on IT3 Proposals (12/10/18)

# Industry Trilateral (IT3) Efforts

- **2014-Present** – IT3 comprises AIPLA and IPO, Business Europe (BE), and the Japan Intellectual Property Association (JIPA)
  - IT3’s aim is to reach consensus and issue a final package that fairly balances interests of all entities and encourages innovation
    - Prepared a comprehensive **Elements Paper** (2017) with recommendations on the 4 topics plus a definition of "prior art."
    - Participated in the **B+ Symposium and Meetings** (2017)
      - Discussed IT3’s **Elements Paper** and gathered stakeholder’s responses thereto
      - Included Summary Charts
  - Held weekly teleconferences among discussion leaders
  - Conducted face-to-face meetings in January, February, June 2018
  - Six Substantive WebEx meetings in March-Sept. 2018
  - **Reported to B+ Subgroup Meeting** (9/26/18) based on Revised Summary Charts with open issues bracketed

## Engagement with Stakeholders

- Industry Trilateral organized events in members/non-members countries.
  - Global Network of National IP Practitioner Associations
  - Organization meetings
- Outreach to representatives of individual inventors, SMEs, universities, national/international law societies/associations, including China.
- Engagement ongoing

## Goals of this presentation

- Show present status of harmonization positions to experts.
- Identify concerns regarding any of the proposed positions
- Identify alternatives.

# Industry Trilateral Harmonization Principles

- Policy must be **fair and balanced**
  - Policy must consider interests of Patent Owners, Third Parties and the Public, including individuals, SME's and Universities
- Policy must implement **best practices** to encourage innovation
- Many **existing laws must change** to some extent
- Harmonization must be based on an agreement as to an **entire package** rather than individual elements
- Harmonization must consider **technological advances in AI and Big Data** over the next 10 years

# Overview of Elements Under Discussion

- **Prior Art:** Achieved Consensus on Definition
- **Grace Period:** Open items include those relating to
  - Duration (6 vs 12 months)
  - Mandatory Statement identifying the graced PFD to the Patent Office
  - Accelerated Publication of application to 18 months after PFD date
  - Penalties for late filing or not filing the PFD Statement
- **Prior User Rights (PUR)**
  - Open items: Derivation
- **Conflicting Applications** - use of an unpublished application against a later application
  - Substantial Consensus in IT3
  - Open item: Treatment of PCT Applications
  - FICPI advocates EP novelty type system – no anti-self collision
- **18 Month Publication** – all applications are published
  - National security exception

# GRACE PERIOD

- **Mandatory Filing of a Statement** to claim benefit of a Grace Period – as a balanced and best practice in 10 years:
  - **Up to Publication of the Application**
    - **What Penalties** for not filing with the application but up to publication?
  - **Up to Grant**
    - **What Penalties** for not filing before publication but during prosecution?
  - **Post Grant**
    - Should there be an opportunity to claim Grace Period after grant
    - **What Penalties** for not filing with the application but up to publication? Different from Penalties up to grant?

# GRACE PERIOD - Accelerated Publication

- **CONSENSUS**

- **Accelerated publication** - Upon timely filing of Statement, or on request, publication will be accelerated to occur 18 months after date of PFD

- **ISSUE**

- **Content of the publication** - what is a balanced and best practice in 10 years for the content of the accelerated publication of a Statement
- With the entire application
- With bibliographic data and claims only



# Prior User Rights

- **Underlying Policy** - Protect interests of an independent inventor who develops an invention that is later patented by another inventor.
- **Requirement for PURs** - PURs accrue to a third party with respect to a later patented invention:
  - (i) where such invention is **commercially used** by the 3d party or
  - (ii) where **serious and effective preparations** for commercial use have been made by the 3d party

**prior to the actual filing date or the priority date, whichever is earlier.** .
- Burden of proving entitlement to the PUR is on the 3d party.
- PUR is limited geographically
- Transferability is limited

- **CONSENSUS**

- PURs always apply where the 3rd party developed the invention independent of a graced PFD by/for/from the inventor.
- PURs do not apply when the 3rd party obtained or used the relevant knowledge of the invention in an illegal way.

- **ISSUE:** as a balanced and best practice in 10 years:

- Should PURs apply where the 3d party legitimately derived knowledge of the invention from a patentee's pre-filing disclosure (PFD)?
- Does the comprehensiveness of the PFD accessed by the third party have an impact on the availability of the PUR defense?

**Scenario** - A 3d party had the benefit of knowledge of the invention from a pre-filing disclosure (PFD) of the patentee and made substantial preparation for commercialization before the application was filed

- If the 3d party copies an **enabling** PFD **without any independent contribution** should they get or not get a PUR? Is this theft of the invention?
- If a 3d party sees a **non-enabling** PFD disclosure and then reduces it to practice, should they get or not get a PUR?
  - **Non-enabling**: Incomplete, partial or high level description of the invention
  - Additional independent effort necessarily required!

# Thank You!

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