



UKIPO consultation on patent harmonisation

About the Chartered Institute of Patent Attorneys (CIPA)

The Chartered Institute of Patent Attorneys is the UK's largest intellectual property organisation. We are the professional and examining body for patent attorneys in the UK, representing virtually all the 2,400 registered patent attorneys in the UK, whether employed in industry or private practice. Total membership is over 4,000 and includes trainee patent attorneys, judges, barristers and other professionals with an interest in protecting innovation through the use of intellectual property rights (patents, trade marks, designs and copyright). We represent members' interests to government and a wide range of stakeholders at home and abroad. The profession is one of the UK's most export intensive technical / legal services, generating around £1 billion for the economy in gross value added, and approaching £750 million in exports.

Introduction

CIPA supports Substantive Patent Law Harmonisation (SPLH). CIPA has monitored the progress of the Industry Trilateral (IT3) discussions on SPLH, and the publication of the increasingly more refined versions of the Elements Paper arising from these, since the IT3 discussions started at the end of the Trilateral Offices Tegensee process. The AIPPI and FICPI proposals also cover three of the Tegensee topics: grace period, conflicting applications and prior user rights (PUR).

CIPA's support for SPLH is based on the assumption that any harmonisation enacted would be to the benefit of the users of the system and to society as a whole. The Elements Paper is a package and one part should not be considered in isolation from the others. This is because there are parts that one regional/national group are bound not to like (preferring their own system) but are prepared to accept in the context of an overall agreement.

In this context, it should be noted that a significant number of CIPA members do not support a grace period, seeing it as contrary to a well-balanced and self-consistent system. That is why, if there is to be a grace period, it should only be accepted as part of a balanced, globally harmonised package.

It is also important that the system does not become a first-to-publish system. A first-to-publish system is one that encourages potential applicants routinely to publish first and then file patent applications later. Current US law has been described in that way. In this respect, there should be sufficient safeguards to discourage applicants publishing their invention first which could include: the ability of third parties who had been working independently to file patent applications, intervening publications being prior art and robust prior user rights. It is also important that legal certainty is maintained.



There are pressures on the present systems from inter-governmental discussions and particularly discussions on Free Trade Agreements (FTAs). FTA discussions with the EU or non-EU countries that are members of the EPC, such as the UK, often involve requests for the adoption of a substantive grace period. It is much better if proposals for such provisions come from those who have studied this issue in detail rather than through a compromise/trade off at the 11th hour in an FTA negotiation. There is also the real concern that rather than achieving harmonisation, provisions agreed through FTAs could lead to grace periods with different requirements in different parts of the world.

General Comments

It is believed by CIPA that SPLH could provide beneficial economic benefits to European patent applicants and particularly those from Universities and SMEs.

CIPA prefers the Elements Paper to the AIPPI and FICPI proposals in relation to a grace period. For example, the proposal for publication of applications at 18 months from any pre-filing disclosure (PFD) is a key innovation of the Elements Paper. This is of major benefit to third parties by providing the same amount of legal certainty for third parties as they have at the present time in Europe in relation to public disclosures and whether these are related to patent applications. The AIPPI and FICPI proposals do not contain this (although FICPI suggests that a voluntary statement could be filed) and for this reason the Elements paper proposals are preferred.

CIPA does however prefer the proposals on derived prior user rights (PUR) in the AIPPI and FICPI papers to those in the Elements Paper. It is felt that these help ensure the system does not become a first-to-publish one.

The Elements Paper is more detailed than the AIPPI and FICPI proposals and is complex in places, one of the disadvantages in dealing with issues in detail, and CIPA would welcome some of the more complex sections being simplified.

Specific Comments

Grace Period:

Duration: Existing substantive Grace Periods are 12 months and it is anticipated that this would be acceptable if sufficient safeguards are in place to prevent a first-to-publish system developing.

Calculated from: There are differing views. A grace period prior to the priority or effective filing date would be most useful for applicants. A grace period prior to the filing date shifts the burden in favour of third parties, though with a risk that different countries could adopt different procedures.



Disclosures of independent inventions: the Elements Paper is more sophisticated in its approach in that it attempts to grace simple re-disclosures (which of course are not disclosures of independent inventions) of the original disclosure. This is accompanied by certain presumptions that are made depending on the closeness of the re-disclosure to the original one. This feeds into the section on burden of proof; CIPA supports the burden of proof initially being on the applicant.

Statement required: The mandatory filing of a Statement is a key feature of the Elements Paper (it triggers the early publication of the patent application) and is not a feature of the AIPPI/FICPI proposals. The early publication of the patent application (18 months from the PFD) is one of the most important aspect of the Elements Paper; it means that the uncertainty to third parties as to whether patent protection has been sought to the subject matter of a PFD is the same as it is in the present EPC system. It is not a feature of the AIPPI paper whilst the FICPI paper only requires publication of bibliographic data 6 months from filing the patent application and a voluntary statement of a PFD). CIPA believes that the Statement should be filed within 16 months of the PFD and that a grace period cannot be claimed if this is not done. This is another important safeguard to ensure that we are not moving to a first-to-publish system.

A Defence of Intervening User has been proposed (similar to PUR but taking effect if the Statement is not filed in time). This would not be required if the Statement was not permitted to be filed after 16 months and is certainly complicated. AIPPI and FICPI appear to support a grace period throughout the life of the patent (note in JP and KR systems there are time limits for filing the Statement which are the latest dates at which the grace period can be invoked - in Japan this is 30 days after the application is filed).

Burden of Proof: see above

Defence of Intervening User: This is discussed above in the context of a Statement having to be filed at the latest at 16 months from the PFD. If it is decided that the Statement can be filed after 16 months from the PFD then DIU is an important safeguard for third parties who start or make preparations to use the subject matter of a PFD on the basis that no Statement has been published at 18 months from the PFD. The current proposals are too complicated and require simplification.

Accelerated publication of the graced application to 18 months from the PFD: This has been discussed above

Prior User Rights (PURs):

The proposals on this are broadly similar except that for when the PUR concerns activities based on derived knowledge from a PFD the Elements Paper only permits PUR when the Statement is filed late. CIPA prefers the AIPPI/FICPI proposal that there is no such restriction to a PUR when this is based on derived knowledge. It is felt that this provides a powerful safeguard against moving to a first-to-publish system.



Territoriality: some have expressed concern that the PUR proposals are limited territorially to the country where prior use preparations took place but should have the same territorial scope as the patent. This is a complicated political issue which may require further study.

Conflicting Applications:

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The Elements Paper is more generous to the first patent applicant than the EPC system preferred by AIPPI and FICPI. This is the case when the applications come from the same applicant or different applicants. The proposal that there be distance between a first application and a second application from a third party is similar to the Japanese enhanced novelty system. The proposals for applications from the same applicant are similar to the current US system. The proposals are an incentive for an applicant to file earlier as (i) the applicant has an area around his application that a third party cannot patent and (ii) he can include small incremental improvements in further applications (provided these are filed before publication of the first one).

Many CIPA members would prefer the current EPC system for conflicting applications, but the US is very resistant in this respect. Some compromise will have to be made if global consensus is to be achieved.