



# Summary of Industry Trilateral Discussions on Substantive Patent Harmonization

*Report of Industry Trilateral to Trilateral Heads of Office*

*February 23, 2016*

*Washington D.C.*

# Grace Period

1. Start of Grace Period is a fundamental issue
  - Industry Trilateral is looking for progress with further discussions
  - There is recognition that harmonization can only be achieved with the priority date as the start of the measurement for grace period
2. Grace Period should provide a Balance of interests of Third Parties and of Applicant/Inventor
3. Consequence of failure to make Statement/ Identification of a known disclosure
  - Need to define “known”
  - Statement/identification to be made in time for publication of the patent application
  - Further discussion on penalties for failure to timely file statement
  - Financial penalty may be appropriate in certain circumstances

# Prior User Rights

- Conditions for Rights Accruing
  - Activities based on information independently developed or information derived from the applicant without breach of any duty or agreement (i.e., innocently) may qualify for PUR or a similar right.
- Industry Trilateral agree that there needs to be a proper Balance of third party PURs versus patentee's rights

# Conflicting Applications

- Distance and time difference discussions have now been linked in Industry Trilateral Discussions
- Industry Trilateral agrees that published PCT Applications are prior art as of priority date

# Negotiated Elements have *not* Received Final Approval

Alignment resulting from the Industry Trilateral are subject to review of all elements as a full package, and subject to the final approval by the competent bodies of each Industry Group organization.

# PHEP issues

- Industry Trilateral supports JPO proposed engagement on practical implications of Written Description issues with the use of hypothetical cases
- Industry Trilateral looks forward to seeing significant progress on all 3 PHEP issues (unity of invention, citation of prior art, written description):
  - Please set detailed timeline for progress, possibly after the March 22-23 meeting of the Deputy Heads of Offices
  - How are the Offices following up with each other and coordinate with the Industry Group on each of the topics?

Thank You!