NEEDS OF USERS IN RELATION TO THE WORLDWIDE TREND OF INCREASING PATENT APPLICATIONS

American Intellectual Property Law Association

Michael Kirk
Executive Director

THE PATENT LAW TREATY (PLT) WAS CONCLUDED IN JUNE 2000

THE STANDING COMMITTEE ON THE LAW OF PATENTS (SCP) HELD ITS 4TH SESSION IN NOVEMBER 2000 TO CONSIDER THE HARMONIZATION OF SUBSTANTIVE PATENT LAW

THE TOPICS DISCUSSED INCLUDED:

- Prior art
- Novelty
- Inventive step (non-obviousness)
- Industrial applicability (utility)
- Sufficiency of disclosure
- Drafting and interpretation of claims

AT THE END OF THE YEAR 2000

US Patent Applications Filed: 311,807

Pendency to Grant: 25 months

BY THE 9TH SCP IN MAY 2003, THE LIST OF TOPICS HAD GROWN TO MORE THAN 12 SUBSTANTIVE PROPOSALS:

Prior art effect of applications, Grace period, Best mode, “Technical” features, Doctrine of equivalents, Patentable subject matter, Industrial applicability/Non-obviousness, Grounds for refusal of a claimed invention, Grounds for revocation of a claim or a patent, Means plus function & use claims, Unity of invention

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AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

RESOLUTION

Substantive Patent Law Harmonization Treaty

The Industry Trilateral comprising representatives of industry from Europe, Japan, and the United States:

Desiring the negotiation and conclusion of an effective Substantive Patent Law Treaty (SPLT) that will reduce costs to applicants and industrial property offices, promote legal certainty, and reduce pendency;

Believing that far too many difficult and divisive issues have been introduced into the negotiations of the SPLT resulting in little progress toward the desired goal of an effective SPLT;

Recognizing that opinions of governmental and non-governmental representatives are widely divergent on these many issues, rendering the conclusion of negotiations on the entire set of issues currently under discussion unlikely in the foreseeable future;

Further recognizing that any package of issues to be negotiated should provide balance to the desires and needs of applicants from the Member States of the World Intellectual Property Organization, as well as address the desires and needs of industrial property offices in those Member States;

Therefore Recommends that the Standing Committee on Patents concentrate its efforts on a reduced set of provisions which will lead industrial property offices to the adoption of common search and examination standards and provide applicants with legal certainty regarding the patentability of their inventions; and

Specifically, Recommends that the harmonization of substantive patent laws in the SCP initially concentrate on achieving a reduced harmonization package containing the following provisions:

- a first-to-file system of priority,
- an international grace period for a first-to-file system,
- an agreed definition of prior art having no geographic limitations
- an agreed definition of how and when pending published patent applications, including PCT applications, are to be used as prior art, including any necessary solution for double patenting.

A NUMBER OF NGO’s RECOMMENDED THE SCP WORK ON A REDUCED PACKAGE:

First-to-file system of priority,
An international grace period for a first-to-file system,
A definition of prior art with no geographic limitations,
An agreed definition of how and when pending published patent applications should be prior art.

JPO AND THE USPTO PROPOSED A REDUCED PACKAGE TO THE WIPO GA IN AUGUST 2004

THE WIPO GA DECIDED IN 2004 THAT THE WIPO DIRECTOR GENERAL SHOULD HOLD "INFORMAL CONSULTATIONS"

THE CONSULTATIONS, HELD IN FEBRUARY 2005, AGREED TO CONSIDER, IN PARALLEL:

Prior Art, Grace Period, Novelty, and Inventive Step in the SCP, and
Sufficiency of Disclosure and Genetic Resources in the IGC

AN 11TH SESSION OF THE SCP IN JUNE 2005 AGAIN COULD NOT REACH A CONCLUSION ON A WORK PROGRAM AND AGAIN REFERRED TO THE WIPO GA

THE WIPO GA DECIDED IN 2005 TO HOLD AN "OPEN FORUM" EARLY IN 2006, FOLLOWED BY A 3-DAY INFORMAL SCP TO CONSIDER THE DISCUSSIONS OF THE OPEN FORUM, AND TO CONVENE A 12TH SESSION OF THE SCP IN JUNE TO BEGIN THE WORK PROGRAM

THE INFROMAL SCP SESSION IN APRIL 2006 CONCLUDED THAT IT WAS "PREMATURE" TO ESTABLISH A WORK PROGRAM FOR THE SCP

AS INFORMED BY WIPO IN JUNE, 2006:

"Sir,

"I wish to inform you that the twelfth session of the Standing Committee on the Law of Patents (SCP), which was scheduled to be held in Geneva from July 3 to 7, 2006, has been cancelled as decided by the SCP at its informal session that took place from April 10 to 12, 2006."

Sincerely yours,
Philippe Baechtold

THE MATTER WAS AGAIN SENT TO THE WIPO GA

LAST MONTH, THE WIPO GA DECIDED:

To submit proposals for the work program of the SCP by December 2006,
To circulate proposals to all member states,
Request the Chair of the WIPO GA to:
- hold informal consultations, and
- recommend a work plan for the SCP in **September 2007**.

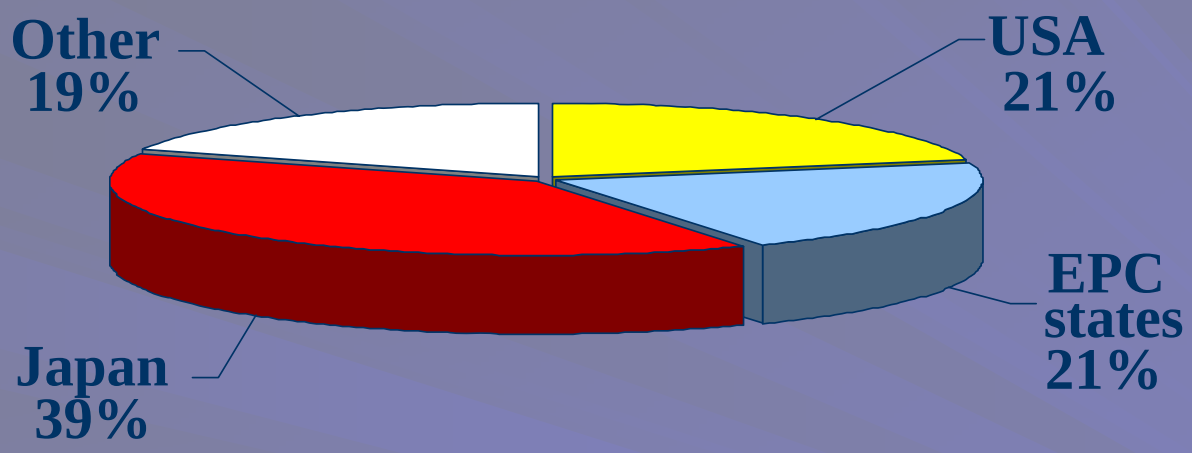
AT THE END OF THE YEAR 2005

US Patent Applications Filed: 409,532
Pendency to Grant: 26.3 to 43.5 months

(Presentation by former JPO Commissioner Hisamitsu Arai in March 2005)

Patent Explosion

Worldwide Patent Applications by Bloc of Origin



Resource: Trilateral Statistical Report 2002 edition

- Applicants → Increased Costs
- JPO/USPTO → Increased Burden of Examination

“ALEXANDRIA GROUP” or “GROUP B +”

In February 2005, the USPTO met with the EPO and its member states, JPO, Canada, Australia, and the EC.

Under Secretary Dudas stated at the time:

"Harmonization promises to bring substantial benefits such as consistent patent examination standards throughout the world, reduced patent office workloads and higher patent quality. The sooner we can agree on a basic framework, the sooner we can begin providing these benefits to all patents stakeholders - patent applicants, patent offices and the public alike."

Statement of Intent

1. The Participants of the Exploratory Meeting of Interested Parties Concerning the Future of Substantive Patent Law Harmonization … agree to convene future meetings to consider:

(i) substantive patent law harmonization issues, notably the Trilateral "first package," as … set forth in Document WO/GA/31/10; and
(ii) issues with regard to intellectual property and development…

with a view to seeking a common basis for further discussions in WIPO.

2. The Participants agree that the following parties will be invited to participate: all Members of WIPO Group B, member States of the European Union, the European Commission, Member States of the European Patent Organization, and the European Patent Office.

3. The Participants further agree to have regular, intersessional meetings of subgroups to address the issues ….

February 5, 2005

Working Group of Experts Holds Inaugural Meeting to Discuss Substantive Patent Law Harmonization Issues

On April 19 and 20, 2005, patent law experts … met at the European Patent Office … to begin discussions on the elements of the Trilateral "first package" concerning substantive patent law harmonization: definition of prior art, grace period, novelty and non-obviousness….

The Working Group conducted discussions … on provisions concerning novelty, inventive step, grace period and prior art drafted in the context of a first-to-file system. In particular, a preliminary consensus within the experts' Working Group was achieved for many provisions of the first package….

The delegations reaffirmed their support for the harmonization process and expressed the view that work … should resume within WIPO at the earliest appropriate moment.

“GROUP B +” CONTINUED ITS WORK ON DRAFT TEXTS IN NOVEMBER 2005 AND MARCH 2006.

AT A PLENARY SESSION OF GROUP B + ON THE MARGINS OF THE WIPO GA MEETING LAST MONTH, WE ARE INFORMED THAT AN AGREEMENT WAS REACHED TO USE A PROPOSAL OF THE CHAIR OF GROUP B + AS A “BASIS FOR WORK.”

CONSULTATIONS WILL CONTINUE NEXT WEEK (THE WEEK OF NOVEMBER 20) IN AN EFFORT TO REACH A NEAR TERM AGREEMENT ON THE PRIOR-ART-RELATED ITEMS OF THE “LIMITED PACKAGE.”

WE APPLAUD THIS AMBITION AND EFFORT.

AN AGREED “LIMITED PACKAGE” SHOULD BE PURSUED WITH THE GREATEST URGENCY BY GROUP B +

FURTHER, EVERY REASONABLE EFFORT SHOULD BE MADE TO INTRODUCE THE RESULT IN WIPO SO THAT IT CAN ACHIEVE AN “EARLY HARVEST” ON PATENT LAW HARMONIZATION.

BUT – CONTINUED OPPOSITION BY THE “FRIENDS OF DEVELOPMENT” TO ACHIEVING THE URGENTLY NEEDED HARMONIZATION IN WIPO THAT THE “LIMITED PACKAGE” WOULD PROVIDE SHOULD NOT BE PERMITTED TO FURTHER FRUSTRATE THIS GOAL.

THE DRAFTERS OF THE PARIS CONVENTION CONTEMPLATED THE NEED FOR FLEXIBILITY WHEN CONCLUDING THAT CONVENTION:

Article 19
[Special Agreements]

"It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention."

JUST AS EUROPEAN NATIONS TOOK ADVANTAGE OF ARTICLE 19 OF THE PARIS CONVENTION TO CONCLUDE THE EUROPEAN PATENT CONVENTION IN 1973, SO TOO SHOULD LIKE-MINDED COUNTRIES NOT FEAR AN ARTICLE 19 SPECIAL AGREEMENT TO ADOPT THE "LIMITED PACKAGE" OUTSIDE WIPO IF NECESSARY.

THANK YOU.