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Harmonisation of Substantive Patent Law The SPLT negotiations

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General

- Principle of **territoriality** in IP law

- **Global economy** and the **harmonisation** perspective
 - ▶ Improvement of costs for obtaining international patent protection
 - ▶ Reduction of economic risks
 - ▶ Increase of patent quality
 - ▶ Legal certainty
 - ▶ Workload implications for PTOs



Retrospective

- Harmonisation efforts in the 80's
 - ▶ Focus on grace period
 - ▶ Failure of the 1991 Diplomatic Conference
 - ▶ Elements of the draft treaty → GATT negotiations - Uruguay Round → TRIPS

- Conclusion of PLT
 - ▶ June 2000
 - ▶ Simplification of formalities of the patent granting procedure



Retrospective

- WIPO/SCP negotiations since November 2000
 - ▶ Objective: "deep" harmonisation of substantive patent law
 - ▶ Issues of direct relevance to the grant of patents
 - ▶ Almost six years later: no real progress
 - ▶ Obstacles
 - Working method of the SCP
 - Volume and complexity of issues
 - Varying practices
 - Political aspects
 - ↳ Opposition as to TRIPS-plus
 - ↳ Protection of GR/TK



Trilateral Efforts

- Tokyo 2003 Trilateral Conference MoU concludes that future harmonisation efforts should
 - ▶ Take a pragmatic approach aiming at early and realistic results
 - ▶ Aim towards a feasible package
 - ▶ Pursue best practice taking account of current practices
 - ▶ Address users' interests as much as possible
 - ▶ Promote discussion at the SCP



Trilateral Efforts

- Trilateral reduced package of priority items
 - ▶ Definition of prior art
 - ▶ Grace period*
 - ▶ Novelty
 - ▶ Non-obviousness/Inventive Step

* Since grace period and first-to-file are linked, grace period, although included in the first package for discussion, as subject to movement on first-to-invent



Trilateral Efforts

- **Failure** to adopt the trilateral proposal
- **Further attempts** to promote harmonisation
 - ▶ "Exploratory" meeting
 - Experts Groups I and II
 - ▶ Casablanca consultations
 - Proposal for a political compromise - two-track approach
 - ↳ Substantive issues → SCP
 - ↳ GR/TK → IGC
- **Deadlock?**



The individual elements of the reduced package



Where do we stand?

- Definition of (general) prior art
 - ▶ Trilateral agreement, except admissions by applicant
 - ▶ No loss-of-rights provision ("secret commercial use"-US)



Where do we stand?

- **Prior art effect of earlier applications**
 - ▶ Fundamental differences Europe/JP-US
 - ▶ Prior art effect for determining novelty only, excluding inventive step (\neq US), based on whole contents (excluding abstract)
 - ▶ No room for “Hilmer” doctrine
 - ▶ No anti-self-collision
 - ▶ No “terminal disclaimers”
 - ▶ Growing European support for prior art effect of PCT applications as at international publication (\neq national phase)



Where do we stand?

■ Novelty

- ▶ No major Trilateral differences (drafting)
- ▶ Enablement as of priority date
- ▶ “Enlarged” novelty concept as compromise solution to bridge different approaches regarding prior art effect of earlier applications?
 - Trilateral offices to exchange reports on practice in determining novelty

■ Non-obviousness/Inventive step

- ▶ Close to Trilateral agreement (drafting)



Grace period



Where do we stand?

- GP only in return for first-to-file
 - ▶ Strong opposition in Europe to any kind of GP
 - ▶ Any GP only as a safety net with clear limits
- Substantial differences as to
 - ▶ Term of GP: 6 months (EP, JP) or 12 months (US)
 - ▶ Obligation to invoke benefit of GP on filing (EP, JP)
- Prior user rights must not be affected by GP
- Experimental use exception (US) in addition to GP not required



Recent Legislative Developments in the U.S.

- Introduction into U.S. Congress of a **Bill on Patent Reform**
 - ▶ 8 June 2005
 - ▶ touches upon several elements of patent law harmonisation
 - First-to-file
 - Absolute novelty
 - Amendment of one-year GP
 - Elimination of Hilmer
 - Publication of patent applications at 18 months
- Difficult to predict which provisions will become "congressionable"



Perspective of the Developing Countries

■ Development Agenda

- ▶ Integration of development dimension into WIPO's policy and norm setting activities
- ▶ Concerns regarding raise of patent protection standards
- ▶ Support for comprehensive, all-inclusive SPLT
 - flexibilities in favour of
 - ➔ public interests
 - ➔ national policy

■ Protection of GR/TK



Protection of GR/TK

- Increased use of GBMR or TK

- DCs advocate the need for and realisation of measures that promote transparency in the context of
 - ▶ access to GR/TK
 - ▶ fair/equitable sharing of benefits
 - ▶ obligations of users of GR/TK



Protection of GR/TK

- Proposal for introduction of a **new disclosure requirement** applicable to patent applications relating to GBMR and TK as a condition to obtaining patent rights
 - ▶ disclosure of **source of origin** of GR/TK used
 - ▶ evidence of **prior informed consent (PIC)**
 - ▶ evidence of **fair and equitable benefit sharing**



Protection of GR/TK: EU Proposal

- Mandatory, yet **formal** requirement
- Disclosure of country of origin or source
- Sanctions
 - ▶ no declaration → application will not be further processed
 - ▶ false or incomplete information → sanctions outside the scope of patent law
- PTOs notify information disclosed to centralised body



Outlook

- Substantial progress on SPLT under current climate in SCP doubtful

- Three options
 - ▶ Find a solution within WIPO
 - ▶ Pursue harmonisation outside WIPO
 - ▶ Suspend harmonisation talks

- International harmonisation efforts must and will go on



Thank you!

