

Harmonization: WIPO, the Trilateral and Beyond



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Overview

- **Substantive Patent Law Harmonization**
 - Background
 - WIPO controversies lead to slowdown
 - Trilateral efforts to reinvigorate the process
 - WIPO—one more time?
 - Beyond the Trilateral
 - Other options?
- **Conclusions**



Background

- Optimism following success of the Patent Law Treaty in 2000
- Need to harmonize substantive aspects of patent law
- Most recent work has been ongoing since 2000
- Building upon efforts going back to 1983



Background

- **Original Goals**
 - “Deep harmonization” of both law and underlying practice
 - Focus on “best practices” for drafting, filing and examination of patent applications
- **Intended Results**
 - Single application
 - Consistent world-wide examination results
 - Costs reductions for applicants and workload reductions for offices



WIPO Controversies

- A few of the more controversial issues:
 - Patent-eligible subject matter
 - Exceptions to patentability
 - Disclosure of origin of genetic resources and traditional knowledge
 - “Social development” and public health
 - Appropriateness of norm-setting at WIPO
- Needless to say, progress has slowed



Emergence of Efforts Outside WIPO

- Between May 2003 and May 2004 SCP meetings, many groups met outside WIPO
 - Trilateral
 - Industry/user group meetings – AIPLA, FICPI, CIPA, AIPPI
- Goal of all is to find a way forward
- Consensus - focus on a “**first package**” of near-term achievable results – early harvest



Harmonization: Trilateral Efforts

- **Trilateral provides a pragmatic context for harmonization talks**
 - Well-developed patent systems
 - Many common understandings
 - Fewer politically charged issues
 - History of cooperation



Harmonization: Trilateral Efforts

• **Benefits**

- Trilateral offices handle almost all patent applications filed in the world
- Tremendous potential for workload reduction
- Applicants benefit-fewer burdens, lower costs
- Public benefits-improved patent quality



Harmonization: Trilateral Efforts

- **November 2003 MOU set forth basic approach:**
 - Pragmatic approach aimed at early and realistic results
 - No rigid framework
 - Pursue best practices taking into account current practices
 - Address users' interests as much as possible
 - Promote the discussion at WIPO/SCP



Harmonization: Trilateral Efforts

- Working Group met in February 2004
- Discussion limited to “**first package**” of prior art-related items:
 - *Definition of prior art*
 - *Grace period*
 - *Novelty*
 - *Inventive Step*
- Framework - current SPLT language and text of 1991 proposed harmonization treaty
- Considerable progress made



Harmonization: Trilateral “First Package” Proposal

- Trilateral Offices introduced “first package” proposal at May 2004 SCP meeting
- **Justifications**
 - Issues most mature for near-term success
 - Would promote work sharing/mutual recognition
 - Addresses substantive issues for overwhelming number of patent applications



Harmonization: Trilateral ‘First Package’ Proposal

• Justifications

- Consistent examination
- Improved patent quality
- Flexibility to allow countries to proceed at appropriate pace
- Addresses traditional knowledge



2004 SCP and General Assemblies

- **“First Package” not adopted by SCP**
 - No agreement in SCP as to future work
 - No real progress from May 2003 meeting
- **US and Japan co-sponsored proposal to adopt the “first package” as SCP work plan at September 2004 WIPO Assemblies**
 - Proposal was not adopted
 - WIPO DG to undertake “informal consultations”



Casablanca Consultations— WIPO one more time?

- WIPO DG held informal consultations in Casablanca in February 2005
- Only certain member states and organizations were invited
- Capital-based vs. Geneva-based
- India chaired



Casablanca—The Proposal

- SCP should take up work on the “first package” provisions
- Issues of disclosure of origin of genetic resources and sufficiency of disclosure to be discussed in parallel in the IGC
- Agreement by all present, except Brazil, which did not associate itself with the proposal



Casablanca—The Fallout

- Immediate criticism of the meeting by the “Friends of Development”
- India distanced itself from its representative’s position
- Proposal unlikely to achieve consensus at the June 2005 SCP
- Future of harmonization at WIPO uncertain



Harmonization: Beyond the Trilateral

- **“Exploratory” Meeting**
 - February 2005 at USPTO
 - US, JP, EPC member countries, EC, CA, AU, EPO
 - **Purpose**
 - Assess state of harmonization
 - Discuss how to proceed



Harmonization: Beyond the Trilateral

- **“Statement of Intent”**
 - WIPO Group B coordination on key WIPO issues
 - Substantive patent law harmonization
 - Issues related to IP and development
 - Establishment of working groups
 - Plenary coordination/strategy meeting
- **Big Issue: Political will if harmonization at WIPO is shelved**



Other Options and Issues

- **30-month Priority Period**
 - Longer period to evaluate need for foreign filing
 - Will reduce workloads for offices
 - Will facilitate work-sharing
- **Maintain 12 month priority period with processing at 30 months**
- **Focus on first-filed applications**



Conclusions

- **Protecting patent rights internationally is essential in the global, knowledge-based economy**
- ***Status quo* is unacceptable – costs, redundancy**
- **Substantive Harmonization**
 - Prospects appear dim at WIPO
 - Group B coordination shows promise, but questions remain
 - “First package” should continue to be the focus to achieve near-term results
- **Other options?**

Thank you, for further information, please

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