

**Discussion guide as to the policy intents of the items to be included in a reduced package for an international patent law harmonisation treaty**

**Submitted by the Chair of B+ Working Group 1**

## I. INTRODUCTION

1. Since the launch of the process within the Group B+, members have intensely worked on a set of issues (“limited package”) which - despite controversies as to their particular features - have always been regarded as viable outcomes of the harmonisation exercise. Negotiations have also addressed the question as to whether the limited package is as such coherent and balanced and can effectively promote international harmonisation of laws according to best practice. Additionally, albeit in different fora, considerable progress is being made in cooperation among patent offices regarding the development of framework for allowing one office to utilise work already performed by another office. Similar to harmonisation of substantive patent laws, utilisation is also meant to enhance efficiencies in the global patent system to the benefit of applicants and offices alike. Certainly, efforts to improve the international patent system are undertaken on various fronts.
2. Among the items currently considered for a possible limited package are\*:
  - (1) First-to-file
  - (2) Elimination of the Hilmer doctrine
  - (3) 12-month grace period with no formal declaration, and which applies to published applications only if erroneously published
  - (4) Third party rights for grace period disclosures, optional or partially optional
  - (5) Definitions of prior art (incl. prior art effect of certain applications), novelty and inventive step (text already agreed by the Working Group)
  - (6) The abstract does not form part of the “whole contents”
  - (7) Inclusion of PCT applications in the secret prior art as of the PCT filing/priority date
  - (8) Inventive step methodology is not included in the Articles.

Other items that have been discussed for inclusion in a possible limited package include mandatory 18-month publication, harmonisation of secret prior art, a definition of patentable subject matter eligibility, and a provision on anti-self collision.
3. The background document (Annex) demonstrates in a concise manner the implications of the individual items outlined above in practical as well as terms of normative scope.

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\* Chair’s Report Group B+ Plenary, Geneva, 26 September 2007.

4. On the basis of the present paper, the Group B+ would like to engage interested circles in a dialogue on the substance and, thus, the future direction of the international patent law harmonisation exercise. Essentially the consultation should focus on the definition of the content of a coherent and balanced limited package with particular reference to the contentious issues of the negotiations, such as the individual elements of the grace period and/or the issue of the 18 month publication.
5. Against this background, interested circles are invited to provide feedback with regard to the following points:

## **II. GENERAL ISSUES**

### **1. What are the benefits of harmonisation, and what are the costs of not harmonising?**

- 1.1 How do users regard harmonisation of substantive patent law vis-à-vis obtaining patent protection internationally, in terms of relative costs and benefits?
- 1.2 How do users regard harmonisation in terms of contributing to utilisation of work among offices and improving efficiencies in the international patent system?
- 1.3 Do users regard harmonisation of patent law as an urgent issue which should be resolved in the near future?
- 1.4 What effects would suspension of the harmonisation exercise have for the users of the system?

### **2. Is there a core set of items that are considered indispensable for harmonisation?**

- 2.1 First-to-file and grace period?
  - 2.1.1 Other?
- 2.2 Would it be worthwhile pursuing agreement on the basis of a further reduced set of issues and postpone resolution of others to a later stage?

### **3. What are the priorities from the users' perspective in terms of issues requiring immediate resolution?**

- 3.1 Which are the issues that if resolved are expected to increase efficiencies in the international patent system?
- 3.2 Which provisions currently under discussion include such elements and promote this goal?

### **4. How do users regard these core items and priorities, if assembled in a limited package, in terms of their interaction with each other?**

- 4.1 Do they achieve a sufficient balance?
- 4.2 Would a more limited or more expansive approach be preferable?

## **III. INDIVIDUAL ISSUES**

### **1. First-to-file**

- 1.1 How would users regard the worldwide implementation of first-to-file with regard to the circumstances within which they operate?

- 1.2 What type of first-to-file framework is preferred—one based solely on relative filing dates among conflicting applications, or one that makes an allowance for earlier disclosures by or on behalf of the inventor during the grace period?
- 1.3 How do users view the relationship between first-to-file and first-to-invent with respect to efficiency of the international patent system, legal certainty and risk management?
2. **Hilmer doctrine**
  - 2.1 What are the pros and cons of the Hilmer doctrine in the framework of an internationally harmonised patent system?
3. **Grace Period**
  - 3.1 What is the appropriate duration?
    - 3.1.1 6, 9 or 12 months? Other?
  - 3.2 Scope
    - 3.2.1 Should it include only erroneously published applications or apply generally to an applicant's own prior work, including prior published applications?
  - 3.3 Operation of grace period
    - 3.3.1 Is a declaration of entitlement to the grace period, whether formal or made on demand via request from a third party, necessary or appropriate?
    - 3.3.2 Is it preferable that the grace period arise from operation of law, without the need for a declaration?
4. **Third party rights**
  - 4.1 Should third party rights, as they relate to grace period disclosures, be mandatory, optional or left unmentioned?
5. **Effect of conflicting applications**
  - 5.1 Is it a best practice that earlier filed but later published applications be taken into account for determining novelty only, or both novelty and inventive step?
6. **Treatment of conflicting PCT applications**
  - 6.1 Is it a best practice that PCT applications should form part of the prior art as of their filing/priority date, or upon their entry into the regional/national phase?
7. **Mandatory 18 month publication of patent applications**
  - 7.1 How do users regard mandatory 18-month publication in relation to a globally harmonised framework and the circumstances in which they operate?