



RESOLUTION FOR A PATH FORWARD IN WIPO HARMONIZATION TALKS

FROM THE INDUSTRY TRILATERAL

Organizations representing intellectual property interests of industry in the regions of the Trilateral Patent Offices agreed at their first meeting in Nice, France, in 2003, to form an “Industry Trilateral” to cooperate in developing and expressing a coordinated view of industry on intellectual property matters.

At its second meeting, held in Tokyo in February, 2004, the Industry Trilateral discussed and adopted the attached resolution favoring a reduced scope for the patent law harmonization talks being held under the auspices of the World Intellectual Property Organization in the Standing Committee on Patents. It is believed that by focusing on the adoption of common search and examination standards that the discussions in WIPO will have the best chance to provide applicants with legal certainty regarding the patentability of their inventions and to relieve the pressures of the growing workloads of the EPO, JPO, and USPTO.

We commend your consideration of the attached resolution.

Philippe de Buck
UNICE Secretary General

J. Jeffrey Hawley
President of IPO

Y. Sakuta
President of JIPA

Rick Nydegger
President of AIPLA

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 these 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.