

Outside Perspectives on International Patent Cooperation

*USPTO Biotechnology, Chemical and Pharmaceutical (BCP)
Partnership Meeting (April 26, 2016)*

Presented By:

Anthony P. Venturino

*Vorys, Sater, Seymour and Pease LLP
202.467.8848 | apventurino@vorys.com*

VORYS

Patent Offices Involved in Patent Harmonization

- Trilateral Patent Offices – the USPTO, EPO and JPO.
- The IP5 – Trilateral Patent Offices, plus the Chinese Patent Office (SIPO) and the Korean Patent Office (KIPO).
- The Sub-Group on Patent Harmonization of the Group B+ countries (Group B+).
 - Group B+ follows WIPO structure, where developed nations act collectively as Group B. The sub-group includes the Offices of the Group B countries plus additional countries represented at the European Patent Office and KIPO.
- There have been and probably will be other combinations.

Industry Groups Involved in Patent Harmonization

- Industry Trilateral
 - The American Intellectual Property Law Association (AIPLA) and Intellectual Property Owner's (IPO) for the US
 - Business Europe (BE), and
 - Japanese Intellectual Property Law Association (JIPA)
- The Industry Five
 - The Industry Trilateral members
 - plus the Patent Protection Association of China (PPAC) and Korean Intellectual Property Law Association (KINPA)
 - AIPLA is the founding association of the IT and Industry IP5

Harmonization Underway on Multiple Fronts

- Information Technology
 - Common citation document (CCD)
 - Global Dossier (also known as One Portal Dossier)

IT Efforts Driving Harmonization – CCD

- Common Citation Document (CCD)
 - The Common Citation Document (CCD) aims to provide single-point access to citation data for the patent applications of the five IP offices (IP5). Access at <http://ccd.fiveipoffices.org/CCD-2.0.8/>
 - The CCD consolidates prior art cited by all participating offices for the family members of a patent application.
 - It enables viewing the search results for the same invention from several offices on a single page. See <http://www.epo.org/searching/free/citation.html> and <http://www.fiveipoffices.org/material/ccd.html>

Number: 8000000 Search examples: EP1612402, US2006000447A1, JP20090214944

US20070874690²

Hide CCD viewer Double Inspector Timeline

CCD Viewer

Citations only view Compact view Sort by country Filter Classifications & fields searched

#	CC	Cat.	Citation details	Claims
1	US		Application N° US201213707984 (US13707984) - 7 December 2012 National Search Report	
			US4561440 A (MATSUSHITA ELECTRIC IND CO LTD [JP], et al) - 31 December 1985	
			US2004030383 A1 (HAVEY GARY DAVID, , et al) - 12 February 2004	
			US4612934 A (BORKAN WILLIAM N) - 23 September 1986	
			US2006003803 A1 (IPVENTURE, INC) - 5 January 2006	
			US2010110368 A1 - 6 May 2010	
			US6493154 B1 (HUMPHREY JOHN M) - 10 December 2002	
			Application N° US201113168653 (US13168653) - 24 June 2011 National Search Report	
			US7529587 B2 (COCHLEAR LTD [AU]) - 5 May 2009	
			US7529587 B2 (COCHLEAR LTD [AU]) - 5 May 2009	
2	US		Applicant	
			US4573481 A (HUNTINGTON INST OF APPLIED RES [US]) - 4 March 1986	
			US4628933 A (MICHELSON ROBIN P) - 16 December 1986	
			US4837049 A (MANN ALFRED E FOUND SCIENT RES [US]) - 6 June 1989	
			US5109844 A (UNIV DUKE [US]) - 5 May 1992	
			US5215088 A (UNIV UTAH [US]) - 1 June 1993	
			US5935155 A (UNIV JOHNS HOPKINS [US]) - 10 August 1999	
			US6400989 B1 (INTELLIGENT IMPLANTS GMBH [DE]) - 4 June 2002	
			US6458157 B1 (SUANING GREGG JOERGEN) - 1 October 2002	
			US2006247754 A1 (SECOND SIGHT MEDICAL PRODUCTS, INC) - 2 November 2006	
WO0240095 A1 (POLYVALOR S E C [CA], et al) - 23 May 2002				
Non-patent literature				
- Eugene de Juan, Retinal Tacks, American Journal of Ophthalmology 99: pp. 272-274, Mar. 1985				
3	AU		Application N° AU20070309232 (AU2007309232) - 18 October 2007 National Search Report	
			US6458157 B1 (SUANING GREGG JOERGEN) - 1 October 2002	
			US2005078846 A1 (SINGLE PETER SCOTT, et al) - 14 April 2005	

Simple families: 1

Total family members: 7

US2004030383.A1 (US201213707984)

[also published as]

Biblio Description Claims Original document

Bibliographic data: US 2004030383 (A1)

Method and apparatus for sensory substitution, vision prosthesis, or low-vision enhancement utilizing thermal sensing

Publication date: 12 February 2004

Inventor(s): HAVEY GARY DAVID [US]; GIBSON PAUL LORN [US]; SEIFERT GREGORY JOHN [US]; KALPIN SCOTT [US]

Classifications: International: A61F9/08; A61N1/36

Cooperative: A61F9/08; A61N1/36046

Application number: US20030454295 20030604

Priority number(s): US20030454295 20030604

US20020386036P 20020606

Abstract of US 2004030383 (A1)

A sensory substitution device according to an embodiment of the invention includes a thermal imaging array for sensing thermal characteristics of an external scene. The device includes a visual prosthesis adapted to receive input based on the scene sensed by the thermal imaging array and to convey information based on the scene to a user of the sensing device. The visual prosthesis is adapted to simultaneously convey to the user different visual information corresponding to portions of the scene having different thermal characteristics. One type of thermal imaging array includes a microbolometer imaging array, and one type of visual prosthesis includes a retinal implant. According to additional embodiments, an apparatus for obtaining thermal data includes a thermal detector adapted to sense thermal characteristics of an environment using a plurality of pixels.; The apparatus also includes a pixel translator, operably coupled with the thermal detector, adapted to translate pixel data of the thermal detector to a lower resolution. The apparatus also includes an interface, operably coupled with the pixel translator, adapted to communicate the thermal characteristics of the environment to a user of the apparatus at a lower resolution than sensed by the thermal detector.

Citations only view

Compact view

Sort by country

Filter ▼

#	CC	Cat.	Citation details
1	US		Application N° US201213707984 (US13707984) - 7 December 2012
			National Search Report
			US4561440 A (MATSUSHITA ELECTRIC IND CO LTD [JP], et al) - 31 December 1985
			US2004030383 A1 (HAVEY GARY DAVID, , et al) - 12 February 2004
			US4612934 A (BORKAN WILLIAM N) - 23 September 1986
			US2006003803 A1 (IPVENTURE, INC) - 5 January 2006
			US2010110368 A1 - 6 May 2010
2	US		US6493154 B1 (HUMPHREY JOHN M) - 10 December 2002
			Application N° US201113168653 (US13168653) - 24 June 2011
			National Search Report
			US7529587 B2 (COCHLEAR LTD [AU]) - 5 May 2009
			US7529587 B2 (COCHLEAR LTD [AU]) - 5 May 2009
			Applicant
		US4573481 A (HUNTINGTON INST OF APPLIED RES [US]) - 4 March 1986	



« < **Biblio** Description Claims Original document > »

Bibliographic data: US 2004030383 (A1)

Method and apparatus for sensory substitution, vision prosthesis, or low-vision enhancement utilizing thermal sensing

Publication date: 12 February 2004

Inventor(s): HAVEY GARY DAVID [US]; GIBSON PAUL LORN [US]; SEIFERT GREGORY JOHN [US]; KALPIN SCOTT [US]

Classifications: **International:** A61F9/08; A61N1/36

Cooperative: A61F9/08; A61N1/36046

Application number: US20030454295 20030604

Priority number(s): US20030454295 20030604

US20020386036P 20020606

Abstract of US 2004030383 (A1)

A sensory substitution device according to an embodiment of the invention includes a thermal imaging array for sensing thermal characteristics of an external scene. The device includes a visual prosthesis adapted to receive input based on the scene sensed by the thermal imaging array and to convey information based on the scene to a user of the sensing device. The visual prosthesis is adapted to simultaneously convey to the user different visual information corresponding to portions of the scene having different thermal characteristics. One type of thermal imaging array includes a microbolometer imaging array, and one type of visual prosthesis includes a retinal implant. According to additional embodiments, an apparatus for obtaining thermal data includes a thermal detector adapted to sense thermal characteristics of an environment using a plurality of pixels.; The apparatus also includes a pixel translator, operably coupled with the thermal detector, adapted to translate pixel data of the thermal detector to a lower resolution. The apparatus also includes an interface, operably coupled with the pixel translator, adapted to communicate the thermal characteristics of the environment to a user of the apparatus at a lower resolution than sensed by the thermal detector.

IT Efforts Driving Harmonization Global Dossier

- The Global Dossier is a information technology system of the IP5 that can be used by Applicants, Third Parties, and Examiners.
- It is mainly driven by the IP5 but started at the Trilateral level
- Access the Global Dossier
 - at the USPTO website <http://globaldossier.uspto.gov/#/> or
 - at the EPO via Espacenet and the European Patent Register <http://www.epo.org/news-issues/news/2015/20150626.html>

IT Efforts Driving Harmonization Global Dossier

- Global Dossier benefits
 - One Stop Viewing
 - Portfolio Management, monitor an international portfolio as easily as using PAIR
 - Facilitates maintaining more uniform claims
 - Facilitates making consistent arguments globally to avoid inequitable conduct
 - Avoid IDS problems since it is easier to see and obtain what was cited in corresponding applications

IT Efforts Driving Harmonization Global Dossier

- Global Dossier benefits
 - Get Office actions as fast as the foreign patent office issues it. This can help applicants respond quicker
 - Get machine translations of Office actions and cited references (almost as fast as the foreign patent office issues the Office action). This reduces translation costs.
 - Applicants can monitor their foreign agents
 - US outside counsel can monitor their clients
 - Support for due diligence for acquisitions, licensing, appeals, and litigation
 - Litigators can use it to find uncited art and inconsistent arguments in prosecutions of corresponding applications

IT Efforts Driving Harmonization Global Dossier

- Maybe in the not too distant future the Global Dossier will support the following functions
 - Real-time collaboration of examiner-applicant, examiner-examiner, and third-party
 - Work sharing between Offices
 - Promote using applicant names consistently at the various offices
 - Provide easier access to legal status (Live/Dead) of family members

IT Efforts Driving Harmonization Global Dossier

- Maybe in the more distant future the Global Dossier will support the following functions
 - Automatically meet IDS requirements
 - Handle assignments, name changes, or other ownership documents in one stop
 - Cross Filing
 - Increase Prosecution Harmonization— as Examiners and applicants are more easily able to view corresponding foreign prosecutions this could lead to greater understanding of foreign practices and eventually more uniform practices among examiners worldwide

Procedural Harmonization Topics of the PHEP

- Procedural Harmonization Topics at the IP5 Patent Harmonization Experts Panel (PHEP)
 - Unity of Invention
 - Citation of Prior Art
 - Written Description and Sufficiency of Disclosure
- Industry IP5 submitted Consensus Proposals to the IP5 Patent Harmonization Experts Panel (PHEP)
Oct. 10, 2014
 - Industry IP5 members in October 2015 submitted further comments

Procedural Harmonization Topics of the PHEP (cont'd)

- Unity of Invention
 - Industry IP5 position: all IP5 Offices should use unity of invention.
 - IP5 Offices position: use unity of invention but the USPTO will only use it for PCT International and National Stage applications.
- Citation of Prior Art
 - Industry IP5 position: the IP5 Offices adopt automatic, electronic Prior Art Citation practice, whereby art cited with respect to the application or a related application in any IP5 Office, and available to an Office, need not be further cited to that Office, all duties of disclosure deemed fulfilled and the prior art deemed considered.
 - IP5 Offices position: open issue.

Procedural Harmonization Topics of the PHEP (cont'd)

- Written Description and Sufficiency of Disclosure
 - Industry IP5 position: the IP5 Offices take an initial narrow approach, such as a pilot project and office-specific analysis, as described in the Industry IP5 Proposals.
 - IP Offices position: open issue.

Harmonization Topics at the Group B+ (cont'd)

- Industry Trilateral submitted a Patent Harmonization Policy and Elements Paper to the IP5 and Group B+ May 2015.

See

http://www.aipla.org/committees/committee_pages/HarmonizationTF/Committee%20Documents/Industry%20Trilateral%20Policy%20and%20Elements%20for%20a%20Possible%20Substantive%20Patent%20Harmonization%20Package-Subject%20to%20approval.pdf

Harmonization Topics at the Group B+ (cont'd)

- Summarizes issues of
 - Definition of prior art
 - Conflicting applications
 - Non-Prejudicial Disclosures (Grace Period)
 - Mandatory publication of patent applications
 - Prior user rights for potential harmonization
 - Unity of Invention
- Puts forward points of consensus, if any, and alternative solutions discussed among the associations.

Harmonization Topics at the Group B+ (cont'd)

- Group B+ released its own paper May 27, 2015 followed up by June 2015 additional notes from the Chair of the Group B+ Sub-Group on patent harmonization. See <http://www.epo.org/news-issues/issues/harmonisation/group-b-plus.html>
- The Group B+ paper summarizes different office's positions on
 - Definition of prior art
 - Conflicting applications
 - Non-Prejudicial Disclosures (Grace Period)
 - Mandatory Publication of Patent Applications
 - Prior user rights
- It highlights where there is consensus and where there is disagreement amongst its members

Harmonization Topics at the Group B+

Definition of Prior Art

- Industry Trilateral position
 - Everything (or all information) before the filing date, or where priority is claimed the priority date.
- Group B+ paper position
 - “Subject to agreed exceptions, prior art should consist of all information that has been made available to the public anywhere in the world before the earliest effective filing date of the claimed invention.”
- Common consensus
 - Prior art should consist of all information (everything) that has been made available to the public anywhere in the world before the filing date.

Harmonization Topics at the Group B+ Conflicting Applications

- Industry Trilateral Elements Paper
 - Policy Objective - No multiple patents on substantially the same or identical invention, including those resulting from earlier filed but later published applications
 - Open issue – How do we use the first filed application for novelty and/or Inventive step?
 - [Anti] Self-Collision – Can an applicant's/inventor's own prior-filed, later-published application be used against a subsequent application by the same applicant
 - Should a PCT Application be prior art everywhere as of its publication date in any language, and effective as of its priority date, or only where it enters national stage?

Harmonization Topics at the Group B+ Conflicting Applications

- Group B+ Paper Position
 - Rules for conflicting applications should permit patenting of incremental innovations with balancing of interests of inventors, third parties, promoting innovation, and promoting competition.
 - No agreement on patentability criteria
 - Treatment of PCT Applications - May be benefits of treating PCT applications as secret prior art upon international publication in any language
- Consensus comparison to the IT Paper: No consensus

Harmonization Topics at the Group B+ Non-Prejudicial Disclosures (Grace Period)

- IT Consensus Highlights:
 - Grace Period Should Apply
 - Disclosures by Inventor/Applicant during Grace Period Are Non-Prejudicial
 - Disclosures by 3rd Parties During Grace Period
 - Independently invented is Prejudicial
 - Disclosed based upon evident abuse is Non-Prejudicial

Harmonization Topics at the Group B+ Non-Prejudicial Disclosures (Grace Period)

- Consensus Highlights:
 - The Group B+ Paper had no consensus on grace period beyond breach/theft (though most support grace period covering inadvertent disclosures by applicant).
 - The Group B+ Paper had consensus for using the priority date (where claimed) as the starting point for the grace period.

Harmonization Topics at the Group B+ Non-Prejudicial Disclosures (Grace Period)

ISSUES	Group B+		Industry Trilateral	
	Consensus	Open Issue	Consensus	Open Issue
1) Disclosures based upon abuse (improperly obtained/derived) are not prejudicial	✓	✓	✓	
2) Disclosures by inventor/applicant during grace period are non-prejudicial		✓	✓	
3) Independently invented disclosures are always prejudicial	✓	✓	✓	
4) Using priority date (if claimed) as grace period starting point	✓		not addressed	
5) Should innocently derived 3d parties disclosures be prejudicial		✓		✓

Harmonization Topics at the Group B+ Non-Prejudicial Disclosures (Grace Period)

ISSUES	Group B+		Industry Trilateral	
	Consensus	Open Issue	Consensus	Open Issue
6) Any prior user rights arising to third parties		✓		✓
7) Duration of the grace period		✓		✓
8) Declaration/submission including timing and formalities		✓		✓
9) Consequences of Non-Compliance with Declaration/Submission disclosing event that occurred during grace period	not addressed			✓
10) Grace period on 18-month publication of applicant/inventor	not addressed			✓

Harmonization Topics at the Group B+ Publication of Applications

- The Industry Trilateral Elements Paper consensus:
 - All patent publications will be published at 18 months, with no opt-out
 - Exceptions
 - applications withdrawn, refused or deemed to be refused prior to publication, and
 - applications subject to national security.

Harmonization Topics at the Group B+ Publication of Applications (cont'd)

- The Group B+ Paper: consensus
 - All patents should be published at 18 months from priority date
 - Exceptions
 - prejudicial to public order, morality,
 - national security
 - contains offensive or disparaging material
 - court order specifies it should not be published
 - open to considering additional exceptional reasons which can be justified
- Consensus comparison
 - The Industry Trilateral Paper did not address as many exceptions as did the Group B+ Paper

Harmonization Topics at the Group B+ (Prior User Rights)

- Industry Trilateral Elements Paper and B+ Paper consensus
 - Independent invention coupled with actual use by third party gives rise to prior user rights
- B+ Paper consensus
 - Place territorial limitations on PURs
 - Open issue for Industry Trilateral

Harmonization Topics at the Group B+ Prior User Rights (cont'd)

- Industry Trilateral Elements Paper consensus
 - Effective and serious business preparations for such use gives PURs
 - Open issue for B+
 - Such effective and serious business preparations must be before the priority date
 - Open issue for B+
- Question – Does a third party that reads an article by the inventor disclosing an invention and performs effective and serious business preparations before the filing date get PURs?

Harmonization Topics at the Group B+ Next Steps

- The B+ Subgroup divided the main harmonization issues among four patent offices to study the following issues in more detail and report to the Subgroup.
 1. Non-Prejudicial Disclosures/Grace Period - EPO
 2. Conflicting Applications - USPTO
 3. Prior User Rights - JPO
 4. Implementation Options - Hungarian Intellectual Property Office
- Each of the workstream groups asked the Industry Trilateral to comment on initial draft workstream reports.
- The B+ Subgroup will meet again in London on May 17-18, at which time the draft workstream reports will be presented.

THANK YOU!

Anthony P. Venturino

Vorys, Sater, Seymour and Pease LLP
202.467.8848 | apventurino@vorys.com