

# 2018 Global Network of National IP Practitioner Associations Summit

September 27, 2018

10th Summit of the Global Network

## Minutes

Start of the Summit meeting at about 9:30.

### **Agenda item 1 – Welcome, introductions and approval of the agenda**

Tony Rollins, President of the Global Network extends greetings to the attendees of the meeting. He further thanks the sponsors, especially Patent Seekers for their contribution in support of the Global Network.

At the President's request, the meeting begins with a round of introductions of all participants.

Thereafter, the President introduces the Summit Agenda which is approved unanimously.

### **Agenda Item 2 – Report on the 9th Summit**

Brigitte Böhm, the Secretary of the Global Network, provides a short report on the 2017 Summit in Venice.

### **Agenda Item 3 – Treasurer's report**

Steven Beney, the Treasurer of the Global Network, provides a report on the financial situation of the Global Network and on the Financing of the website update.

In this context, Tony Rollins already provides a short presentation of the new website. He informs the attendees that a password is provided to the registered members. The website has the address: [www.gnipa.com](http://www.gnipa.com). He also urgently requests the member associations to visit the website and to update the information provided thereon, as required.

Alan Kasper, Past President of the Global Network, asks whether presentations and reports provided on the previous website have been transferred to the new address. Tony Rollins responds that this has not been effected, yet, but is planned for the near future.

Alan Kasper also urges the members to update the website and especially relevant contact information. He also recommends to include information on the observer associations, possibly on a private part of the website.

### **Agenda item 4 – Update on statutes**

The President informs the participants that, at the last meeting, the Global Network approved new statutes. He further informs the attendees that no new members have acceded the Network lately, however, he recommends to try to attract further institutions to join the Network. He is going to continue to advertise membership within Europe.

Alan Kasper explains about the officers of the Network, the President and the ExCo members from the various regions. He points out that elections for these offices are taking place every other year (the terms are two years).

He further summarizes the purposes of the Association, especially informing the members about ongoing or intended legislative changes in the various countries or regions.

### **Agenda item 5 - Introduction of the new website**

This topic was already discussed in connection with the treasurer's report, agenda item 3.

### **Agenda item 6 – IP Harmonisation Activities (Substantive patent law harmonisation and procedural IP harmonisation)**

Alan Kasper provides an update on efforts regarding patent harmonisation and reports that a meeting of the B+ group discussing Substantive Patent Law Harmonization had taken place the day before. While he didn't have detailed information about the meeting, obviously user groups including the Industry Trilateral and also FICPI had given presentations.

Alan Kasper provides also information on the history and the 4 major topics of the harmonisation efforts. Obviously, it was the goal of the B+ group to arrive at an understanding by 2018, nevertheless, there is a lot of work ahead. He summarises the harmonisation principles and the feedback of the stakeholders which was gathered by the Trilateral cooperation of the EPO, JPO and USPTO.

The essential elements are:

a) Definition of prior art:

In this context obviously some consensus had already been achieved.

b) Grace period:

There is obviously agreement that this should be a „real“ grace period, e.g. in cases of universities and a publication has happened inadvertently not considering patent protection. Thus the grace period should provide a safety net for the inventor's direct or indirect disclosure; a pre-filing declaration should be mandatory with penalties for late filing. Intervening disclosures will be prejudicial if independent from the inventor.

There are still open issues, like:

- i) whether a pre-filing disclosure statement should be required (probably yes, but when to be filed?)
- ii) accelerated publication in case of using the grace period
- iii) burden of proof whether the prior disclosure was by the applicant/inventor
- iv) duration of the grace period (6 or 12 months)
- v) self-collision problems.

c) Prior user rights:

There remains at least an open issue concerning cases of a pre-filing disclosure and its effect on prior user rights.

d) Conflicting applications:

There is a period of uncertainty and some discussions are still underway.

Next steps: IP Trilateral will complete work by March 2019, the B+ group would take the lead in further actions, IP Trilateral will provide support. The next meeting of the IP Trilateral was yet to be scheduled.

Kay Konishi (APAA) remarks that AIPPI decided on a resolution in favour of no self-collision.

Kim Finnilä (FICPI) also provides comments and refers to the June FICPI resolution. He votes for a straightforward system without complex procedures.

**Break – 11:00 to 11.30**

## **Agenda Item 7 – Patentable Subject Matter (including software implemented inventions)**

For this topic, several detailed presentations are provided.

Firstly, Saiful Khan (Potter Clarkson LLP) introduced the subject and the challenges in protection AI. He refers to the already present real life impact in e.g. driverless cars, adapting spam filters or research in general. Concerning business awareness and interrelated possibly interruptive threats, AI has the highest ranking. He further explains the EPO view, especially subjects excluded from patentability and inventive step issues. He also mentions that the UK IPO adopts a more holistic view than the EPO.

Kay Konishi presents the views of the JPO in this context. She covers patent eligibility questions as well as novelty and inventive step in detail in her presentation.

Seung Yong Lee (KPAA) present the situation in Korea and provides examples for the various patentability requirements in this context in his presentation.

Alan Kasper summarizes the current situation in the United States and informs that newly appointed Director Iancu of the USPTO announced recently a new roadmap for dealing with abstract inventions and §101 issues. He also explains that AIPLA and IPO presented a legislative proposal. He mentions that the US PTO also contemplates issuing amended guidelines.

### **Lunch Break - 13:00 – 14:00**

## **Agenda item 8 – Law updates**

### **b) Latin America update**

Ivan Poli (AAAPI, and Vice President of the Global Network) provided information regarding recent developments in Argentina. A new opposition procedure was introduced including a 3 months period for settling a case and, thereafter a new procedure. For trademarks, the use requirement cannot be satisfied anymore by use in one class only. The TMO also has a broadened authority. For patents, no major changes were reported and, unfortunately, the limited protection for pharma inventions has not been changed. This is due to the fact that generic manufacturers for pharmaceuticals are very strong in Argentina. Unfortunately, the prizes for medicaments do not decrease and the public does not benefit.

Utility models are available since 1995, but the grant of the protective rights takes about as long as for patents and thus they are considered a failure. For designs, there is a simplified procedure. Reinstatements are allowed. Accession to the Madrid protocol is open, might depend on the respective decision in Brazil.

Concerning other countries in Latin America, he mentioned partly restrictive new administrative regulations and astronomical fees (e.g. in Ecuador). In Chile and Peru, however, the systems work well.

Ricardo Cardosa Costa Boclin (ABPI) reports on the situation in Brazil. He anticipates accession to the MMA in 2020 or even 2019. New Industrial Design Guidelines create problems for claiming priority.

The backlog for trademarks decreases, currently about 20 months, no backlog for designs. For patents, on the other hand, there is a huge backlog of 10 years. As a resolution for this problem it is currently discussed to grant patents without examination. Such proposal included a possibility to apply for an examination after grant, however, without the option to change claims. Currently, applicants benefit from a patent term of 10 years after grant. If the patent is granted 19 years after the application date, the patent term will be 29 years. He also reports on the grant of the Gilead patent for which even ANVISA intervened favourably. However, a presidential election candidate initiated a law suit against the grant which is currently stayed.

#### **a) effect of Brexit**

Brigitte Böhm informs the attendees about the status of the ratification process concerning the UPC agreement in Germany. The constitutional complaint which was filed by a German individual person has not yet been decided by the Constitutional Court and it is at present not clear when a decision will be available. Before the Court issues a decision, Germany will not ratify and the Unified Patent Court will not be able to start operations.

The complaint questions that the UPC agreement can be reconciled with several principles of the German constitution and with principles of autonomy of EU laws and the principle of completeness of legal remedies in the AEUV. It also raises the question whether the fact that the EU is not a party to the agreement is reconcilable with the AEUV. Further, the provisions regarding applicable language during proceedings are criticized and, finally, the lack of competence against decisions of the EPO, especially a rejection of a request to grant a EP patent is brought forward as another critical issue. It is thus not only requested to issue a decision taking into account the German constitution but also to refer questions concerning EU law to the ECJ.

Tony Rollins explains that even after the Brexit, the UK will most probably want to remain a member of the system and that CIPA has lobbied in favour of this position. The EPC membership is not affected at all, but for the UPC membership there are opinions in favour and but also objecting opinions on such possibility. He is in favour of the UK remaining in the system and informs the participants about a new communication of the UK government in this regards. SPCs should remain valid in the UK and an marketing authorization issued by the EEA will most probably also in the future be a basis for SPC in the UK.

He further sees no immediate effect of Brexit on the address of service mandates, whereas concerning the EUIPO, the UK will have to leave the community system after Brexit unless some deal is closed. TMs and designs will most likely continue to be protected by future UK TMs and designs. Patent exhaustion might become an issue depending on the actual future status of the UK.

#### **Break – 15:00 to 15:30**

#### **Agenda item 9 – Patent Office Update**

Maria Holtmann (USPTO) introduces the new USPTO director Iancu who is expected to achieve a lot over the next years and who has confirmed that the US will not draw back from international activities in the patent field. A high number of new patent applications from Japan is a challenge to the USPTO and further targets for the future are shown in her presentation. As patent eligibility has been discussed a lot, she refrains from talking about this subject. She, however, mentions that the USPTO provides new trainings for the examiners and monthly quality chats are conducted. The interview practice is encouraged with over 28.000 interviews in 2018 already.

Search is a priority to Mr Lancu, thus a task force has been set up. Also access to prior art is an important topic. International work sharing, e.g. via the PPH program will also be continued. Within the context of the IP5 cooperation there are some IT issues, e.g. for exchange of prepublished information. She also provides information on patent classification in her presentation.

Grant Lynd (IPIC) asks how the mentioned 15 months of pendency of patent applications is determined, which is answered by Alan Kasper that a mean value has been calculated from the data of the last few years.

Kim Finnilä asks about harmonization with the PCT standards and application thereof by the USPTO examiners. Alan Kasper replies that the USPTO monitors whether the examiners apply the right standards for PCT cases and, if necessary, provides further education for the examiners.

Information exchange between patent offices was also mentioned in the presentation and the fact that an opt out for applicants is available with a box to be selected in the application form.

Myra McCormack (AIPLA) provides a presentation on new developments in patent legislation and copyright legislation as well as other topics. She also reports on AIPLA activities regarding the developments, like a patent fee proposal, or AIPLA closely follows the overall situation at the PTO, e.g. with regard to open PTO positions and the PTAB development. AIPLA has commented on various aspects like claim construction standards but also other important topics. She also reports that the rates of petitions to the PTAB remain high whereas post grant review proceedings numbers continue to drop. Some other aspects are subjects to a discussion following Ms McCormack's presentation.

### **Agenda item 10 – Planning for the 11th Summit**

As the venue for the next meeting, the President suggests London. The next AIPPI world congress is going to take place in London on Sept. 15 to 18, 2019. Holding the Global Network Summit is proposed for Sept. 19, 2019. As everyone agrees, the President announces that corresponding planning will be initiated.

The President thanks the attendees for participating in the meeting and the speakers for their contribution and the very valuable information provided. Then he closes the 10th Summit of the Global Network and invites everybody to join in at the Drinks reception.

The reporter: Brigitte Böhm

