

# Patent Public Advisory Committee Quarterly Meeting

## International Patent Activities (User Perspective)



Sam Helfgott

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November 20, 2014

- Substantive Harmonization Activities (LEGAL)
- Procedural Harmonization Activities
- Global Dossier Project

# **ORGANIZATIONS**

- **Trilateral Patent Offices**
  - United States Patent Office (USPTO), European Patent Office (EPO), and Japanese Patent Office (JPO)
  - Began in 1983
  - Exchange of Examiners, Other Joint Projects
  
- **Industrial Trilateral**
  - Provides industry and user input to the discussions among the Trilateral Offices
  - Began in 2003
  - Includes American Intellectual Property Association (AIPAA), Intellectual Property Owners Assoc. (IPO), Business Europe (BE) and Japan Intellectual Property Assoc. (JIPA)

- **Some Joint Accomplishments**
  - Common Application Format (CAF) – a patent application format using XML and tagging and acceptable to all 3 patent offices
  - Common Citation Document (CCD) – database having collection of all references cited against a family of patents  
<http://ccd.fiveipoffices.org/CCD-2.0.4/>

The screenshot displays the fiveIPoffices - CCD web application. The browser address bar shows the URL <http://ccd.fiveipoffices.org/CCD-2.0.4/>. The search bar contains the number **EP1612402**. Below the search bar, the application ID **EP20040425480** is visible. The interface is divided into two main sections: the **CCD Viewer** on the left and the **Inspector: classifications and fields searched** on the right.

**CCD Viewer:** This section displays search results for the application. It includes a table with columns for #, CC, Cat., Citation details, and Claims. Two results are shown:

#	CC	Cat.	Citation details	Claims
1	JP		<b>Application N° JP20090214944</b> (JP2009214944) - 16 September 2009 National Examination JP2004011448 A (NIPPON SOKEN, et al) - 15 January 2004 JP2004124727 A (DENSO CORP) - 22 April 2004 JPH01160164 U JPH11230005 A (NIPPON SOKEN, et al) - 24 August 1999 JPH10299611 A (NIPPON SOKEN) - 10 November 1998 JP2001107776 A (NISSAN MOTOR) - 17 April 2001 JP2000130288 A (TOYOTA MOTOR CORP) - 9 May 2000	
2	US		<b>Application N° US20050095425</b> (US11095425) - 31 March 2005 National Search Report US4501246 A (BOSCH GMBH ROBERT [DE]) - 26 February 1985 US4884545 A (IVECO FIAT [IT], et al) - 5 December 1989 US4957084 A (BOSCH GMBH ROBERT [DE]) - 18 September 1990 US5619970 A (LUCAS IND PLC [GB]) - 15 April 1997 US6234148 B1 (SIEMENS AG [US]) - 22 May 2001 US6253734 B1 (BOSCH GMBH ROBERT [US]) - 3 July 2001 US6311674 B1 (DENSO CORP [US]) - 6 November 2001	

At the bottom of the CCD Viewer, it indicates "Simple families: 1" and "Total family members: 7".

**Inspector: classifications and fields searched:** This section displays the classifications for the search results. It is organized by country:

- JP:**
  - IPC: F02M55/02, F02M47/00, F02M47/02, F02M59/36, F02M37/00, F02M51/02, F02M59/20
  - CPC: F02D41/3845, F02M59/06, F02M59/102, F02M59/366, F02M63/0225
  - FTERM: 3G066/BA12, 3G066/CB16, 3G066/CE02, 3G066/DC04, 3G066/DC09, 3G066/DC18, 3G066/AC09, 3G066/AD04, 3G066/BA29, 3G066/CA04U, 3G066/CB07U, 3G066/CE22, 3G066/DA01, 3G066/DB08
  - FI: F02M37/00&311A, F02M51/02&R, F02M59/20&D, F02M59/36
- US:**
  - IPC: F02M63/00, F04B19/00
  - CPC: F02M59/102, F02D41/3845, F02M59/06, F02M59/366, F02M63/0225
  - UC: 123/446, 123/447, 123/456, 123/458, 417/487
- ES:**
  - IPC: F02M59/36, F02M59/20, F02M63/02
  - CPC: F02M59/102, F02D41/3845, F02M59/06, F02M59/366, F02M63/0225
- DE:**
  - IPC: F02M59/36, F02M59/20, F02M63/02
  - CPC: F02M59/102, F02D41/3845, F02M59/06, F02M59/366, F02M63/0225
- AT:**
  - CPC: F02M59/102, F02D41/3845, F02M59/06, F02M59/366, F02M63/0225

- **IP5 – The Five IP Offices**
  - Trilateral Patent Offices and Korea Intellectual Property Office (KIPO) and the State Intellectual Property Office of China (SIPO)
  - Accounts for over 80% of all patent applications filed worldwide
  - Formed in 2008
  
- **Industry IP5**
  - Industry Trilateral and Korea Intellectual Property Assoc. (KINPA) and Patent Protection Assoc. of China (PPAC)
  - Formed in 2012

- **Activities**
  - Took over most of the projects of the Trilateral Patent Offices, although Trilateral Patent Offices still meet annually
  - Working on the Global Dossier
  - Established the Patent Harmonization Experts Panel (PHEP) and addressing Procedural Harmonization Issues
  - Many other projects, Classification, Quality, etc.
  - It is suggested that more successful projects result from User participation

# **PATENT HARMONIZATION (LEGAL)**

# **PATENT HARMONIZATION**

- **WIPO**
  - Began discussions in 1990's
  - Prepared a Substantive Patent Law Treaty (SPLT) in early 2000's
  - When substantive talks broke down, passed the Patent Law Treaty (PLT) on non-substantive issues
- **B+ Working Group on Patent Harmonization**
  - Tried to follow up harmonization with Industrialized countries without success
  - No User participation in B+ meetings

- Tegernsee Group
  - USPTO, JPO, 4 European Countries (UK, FR, DE, DK) and EPO as “convener”
  - Addressed harmonization of 4 issues: 18 mo. Publication, grace period, secret prior art and prior user rights
  - Prepared Questionnaires and gathered public input on the 4 topics
  - Issued Final Report
- Final Message to Industry from Tegernsee, B+ and Trilateral
  - “the ball is in your court”

# **INDUSTRY TRILATERAL ACTIVITIES**

- Industry Trilateral has picked up the ball
- Initial discussions at meeting in Trieste, Italy in April, 2014
- IPO & AIPLA coordinating the process and prepared a “discussion draft” using WIPO, B+ and other previous treaty drafts
- Subsequent meetings in Tokyo and Brussels
- Europe is splintered – no unitary position. They all disagree with each other. Germany is the most negative on Grace Period.

- Substantive Issues: Not yet approved by either Boards of AIPLA or IPO, but a set of Principles approved by AIPLA and being reviewed by IPO for use in discussions
- Drafting group being formed in Industry Trilateral

# **ISSUES THAT MUST BE ADDRESSED**

- Grace Period
  - 6 mos./12 mos.
  - Declarations/Disclosures
  - Mandatory/Voluntary
  - Filing Date/Priority Date
  - PCT Applications
  - Grace period on 18 month publication
  - Abuse/Accidental Disclosure/Strategic Disclosure/Safety Net/AIA Grace Period

- Secret Prior Art
  - Novelty/Obviousness
  - Self-collision
  - Terminal Disclaimers
  - Permit Separate Laws or Compromise Position (e.g., Obviousness from 1 reference only)
- Prior User Rights
  - US type with exclusions and prior to Grace Period/International PUR
  - Good faith derivation from Grace Period Disclosure
  - Commercial sale or use, secret prior use, preparation to use
  - How much preparation to use
  - How far does it extend, i.e. just to specific use or to modifications
- Industry Trilateral Meeting with Trilateral Heads in March, 2015 in Yokohama

# PROCEDURAL HARMONIZATION

# **PROCEDURAL HARMONIZATION**

- Patent Harmonization Experts Panel (PHEP)
  - Established by IP5 to address harmonization issues
  - Asked Industry IP5 to recommend subjects
  - Industry IP5 suggested procedural harmonization issues
  - Submitted about 17 topics and prioritized them
  - Three chosen by Associations & Offices
    - Citation of Prior Art
    - Unity of Invention
    - Written Description
  - Industry prepared a consensus position and presented it to IP5 patent offices before their last PHEP meeting in October, 2014

# **INDUSTRY IP5 CONCENSUS PROPOSALS**

- Unity of Invention
  - All IP5 offices should use PCT Unity of Invention standard
  - IP5 Offices should study relationship of Unity of Invention to uniform CPC Classification System
  - At later stage, the first Patent Office that performs search/written opinion makes a rebuttable determination on Unity of Invention and possibly classification

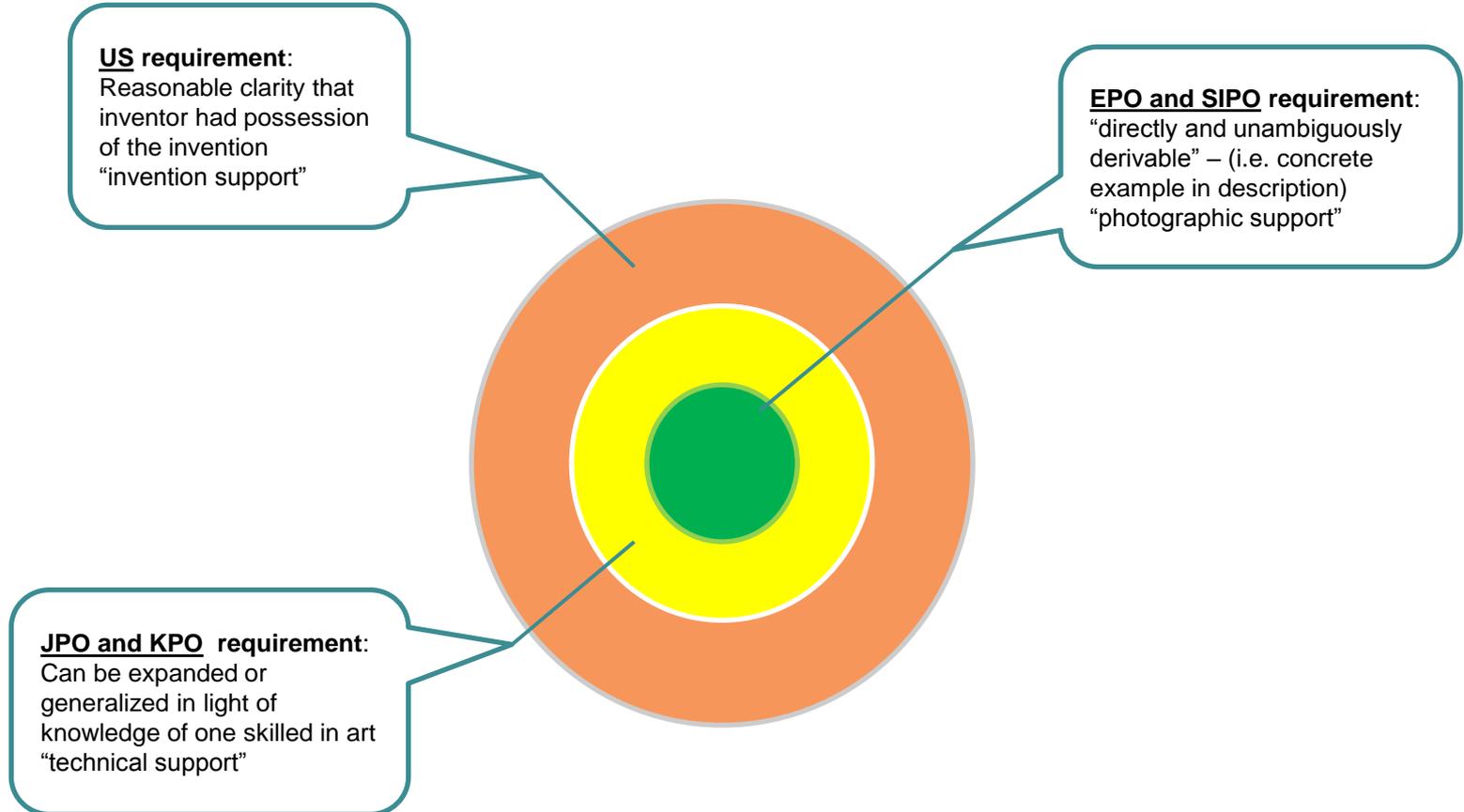
- Citation of Prior Art
  - USPTO to modify IDS requirements to minimize burdens on applicants. Prior art available to Examiners through GD/CCD, or in their own office on family members, should be regarded as having been submitted and a presumption that the cited prior art was reviewed by the Examiner.
  - References mentioned in specification should be presumed cited and considered.
  - EPO should eliminate requirement of incorporating prior art reference in application before grant.
  - JPD & KIPO should eliminate requirement of incorporating prior art citations into the patent application.
  - Offices should consider a common citation form similar to the PCT Search Report, which would be used by Examiners, third party submissions and applicants. Possibly this form can be uploaded and shared among IP5 offices.

- Written Description
  - Although this may be the most difficult to harmonize, it may be the most important. However should consider an initial narrow approach.
  - Should study how written description is handled by the Offices and what problems exist.
  - Need clarification of various terminologies used by the Patent Offices and how they are applied in actual practice, e.g., written description, enablement, support, sufficiency of disclosure, clarity, etc. Ultimately clear and uniform requirements should be worked out by all IP5 Offices.
  - Major differences can be noted in various areas, for example:
    - Limiting claims to examples shown vs. rely on description of entire specification
    - Claims reciting known structure with new function
    - Requiring showing in drawing every element claimed, even if understood

- Amount of scientific data required in a specification to provide support for a claim.
- Requiring direct and unambiguous support for claim amendments.
- IP5 Meeting in October, 2014
  - 3 topics each assigned to 1 or 2 patent offices
  - Will analyze and prepare recommendations
  - To be presented at IP5 Heads meeting with Industry in May in China

# MY PERSONA

## COMPARISON OF SUPPORT REQUIREMENT



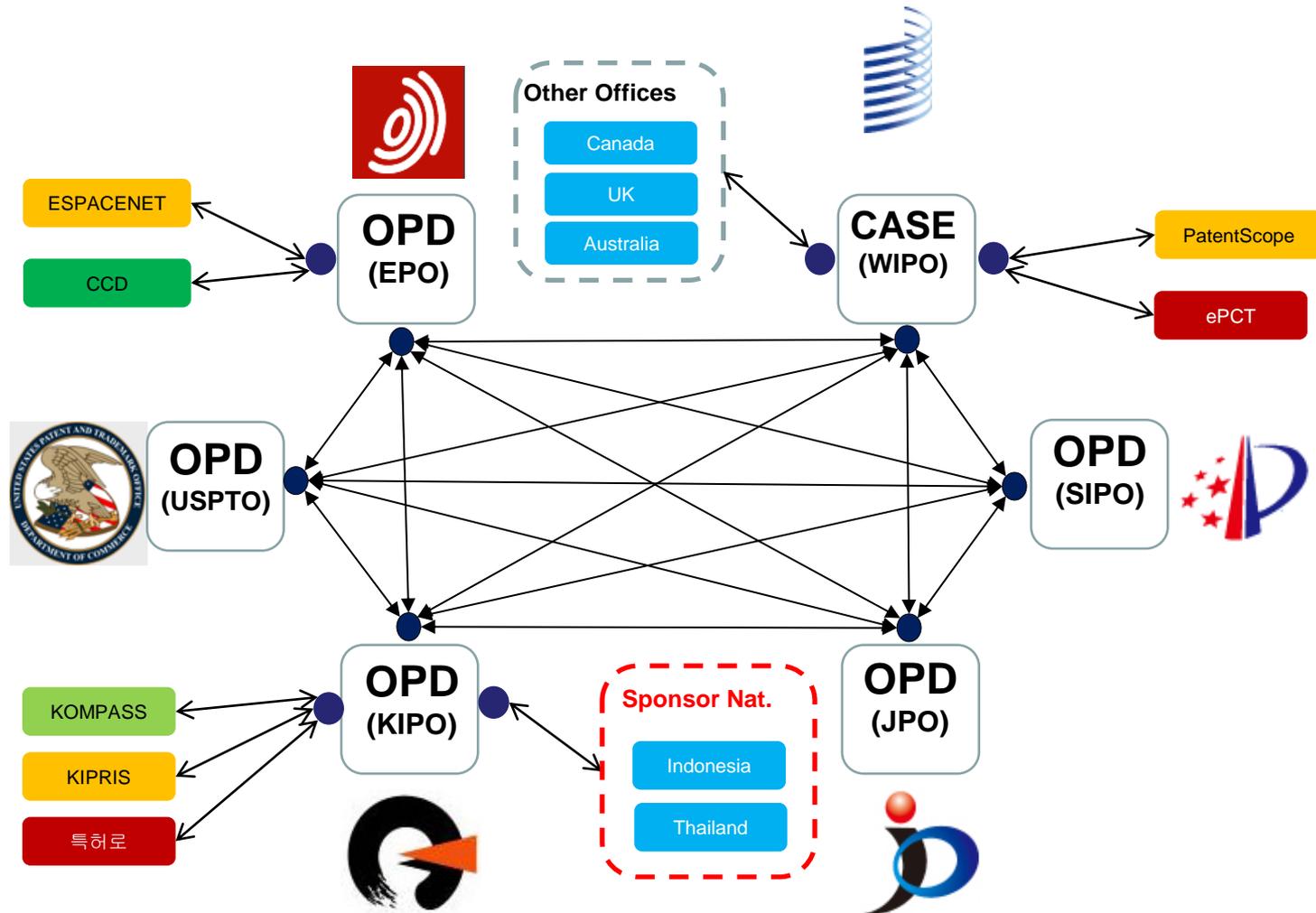
# GLOBAL DOSSIER

# **GLOBAL DOSSIER**

- Joint project of IP5 Patent Offices and IP5 Industry through a Global Dossier Task Force
- An integrated on-line web portal/user interface between users and all participating offices
- It will allow users to access all available information about all applications and patents in the participating offices, and to utilize the electronic services of the offices
- Each country will have a portal in that country through which users will gain access into the patent data bases of the other participating offices and permit 2-way communication with that participating office
- All information of each Patent office remains on their own server. No single owner of data base. Only access from each portal
- Will included IP5, plus access to WIPO-CASE, and other countries wanting to participate

- Working to make all Country Portals to be able to access same information. No difference which portal you enter
- At each country portal the information will be translated into the language of that country. In US, entering the GD, all information will be available from all patent offices in English
- Will ultimately be available for Examiners, Applicants and third parties. Currently only post publication information will be available. Working on pre-publication information for use by Examiners and Applicants, and only post-publication information available for third parties

# Concept Diagram of Global Dossier



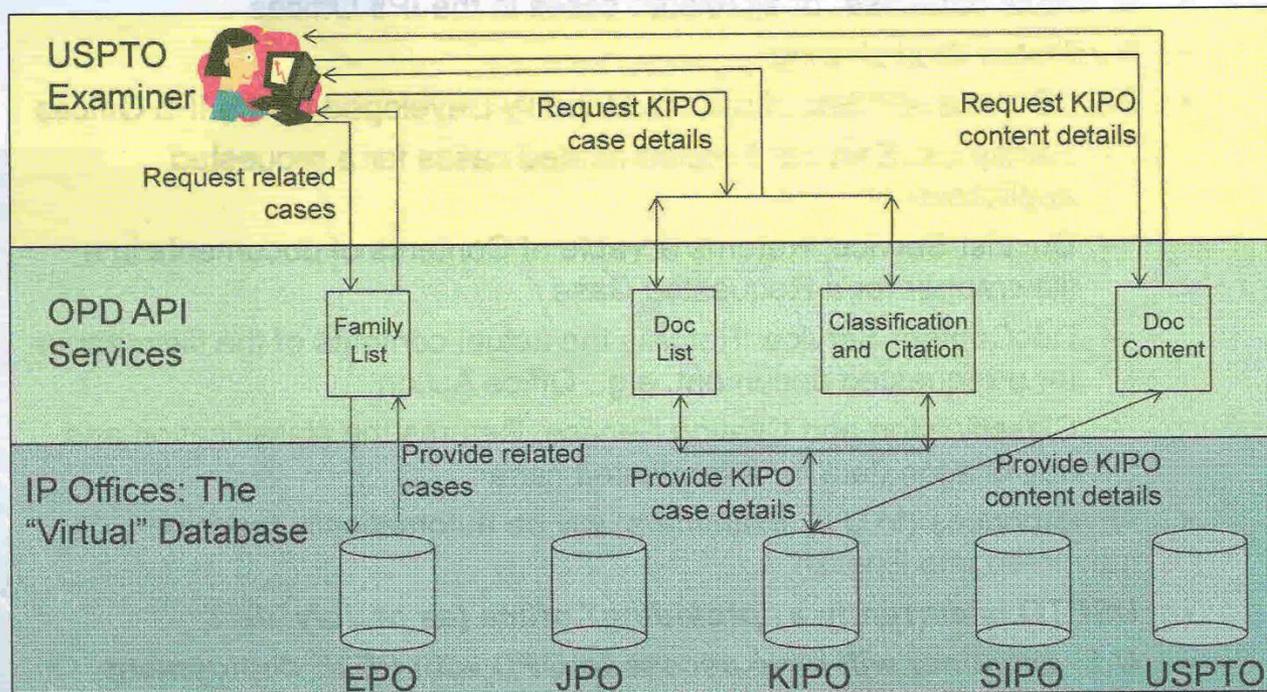
- GD will have two parts
  - Passive part for Global File accessibility
  - Active part for one portal document submission (e.g. cross filings)
  - Both Integrated using “one portal”
  - Currently Passive part is developed for Examiner are in JP, KR, CN and EP. US will have it available for Examiners by April/May 2015
  - Public deployment by FY 2015

# USAGE OF PASSIVE PART

- Enter number
- Get family of patents/applications (of participating offices)
- Select one country (if part of GD)
- Get Table of Contents of documents in filewrapper of that country
- Select document(s) and get actual contents of filewrapper e.g. Office Action
  - Provides classification information, and all citations
  - All translated into portal country language

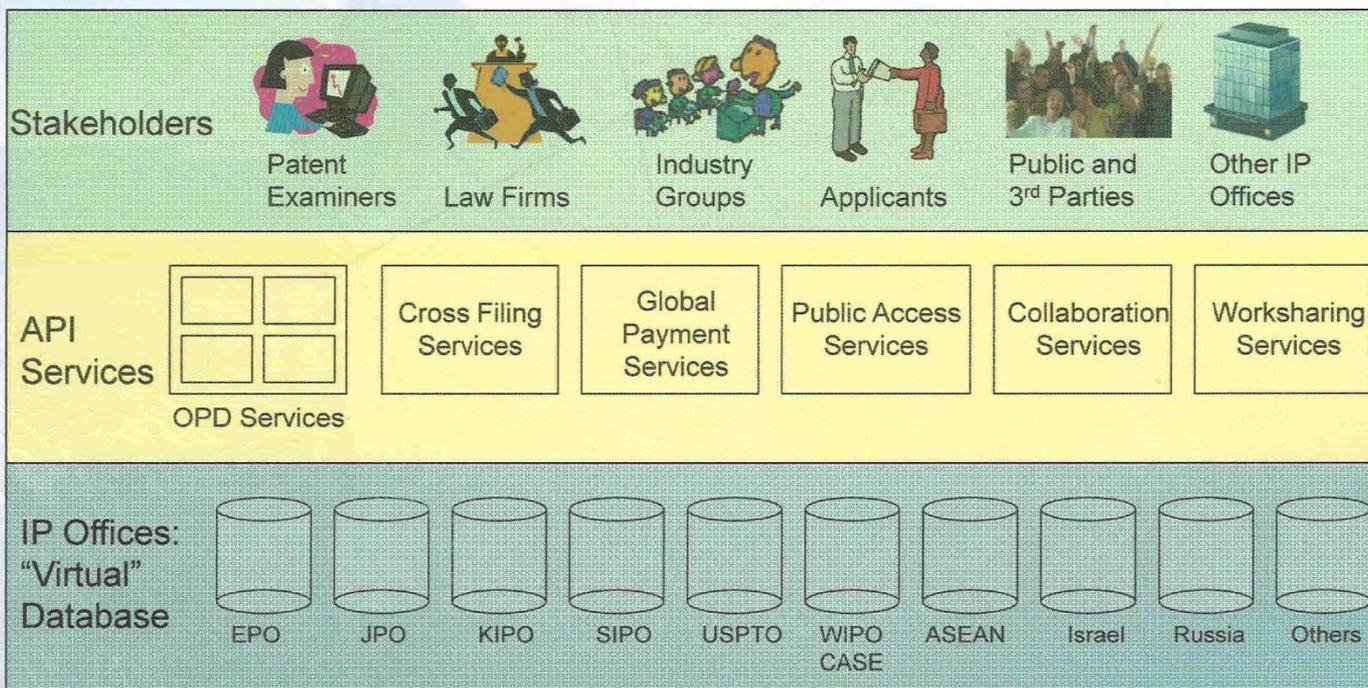


## OPD Example Workflow





## From OPD to Global Dossier





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- + What kind of information can be found under "Status"?
- + What do the digits in square brackets refer to?
- + What does NP stand for?
- + What does the letter in square brackets stand for in the "Documents cited" part?
- + Is it possible to navigate in the result list?

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### About this file: EP2346077

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#### EP2346077 - DRAM memory cell having a vertical bipolar injector and method of operating the same [ Right-click to bookmark this link ]

Status	Examination is in progress Database last updated on 03.09.2014	
Most recent event	28.10.2013	New entry: Renewal fee paid
Applicant(s)	For all designated states Soitec Parc Technologique des Fontaines, Chemin des Franques 38190 Bérnin / FR [2012/19]	
Inventor(s)	D1 / Mazure, Carlos 143 Chemin du Bas Bernin Résidence Cidex 64a 38190 Bérnin / FR D2 / Ferrant, Richard Village de Suguensou 29770 Esquibien / FR [2011/29]	
Representative(s)	Regimbeau 20, rue de Chazelles 75847 Paris Cedex 17 / FR [2012/49]	
Application number, filing date	10187682.9	15.10.2010 [2011/29]
Priority number, date	FR20100050241	14.01.2010 Original published format: FR 1050241 [2011/29]
Filing language	EN	
Procedural language	EN	
Publication	Type :	A1 Application with search report
	No. :	EP2346077
	Date :	20.07.2011
	Language :	EN



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- What does "patent family" mean?
- What are "equivalents"?
- What is Global dossier?
- Which types of document will I find under "Patent family"?
- What does A1, A2, A3 and B stand for after a publication number?

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### Patent family: EP2346077

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Type	Publication No.	Date	Type
<input checked="" type="checkbox"/> Equivalent			
	→ <a href="#">CN102130128B</a> <span style="color: red;">!</span> Global dossier	08.01.2014	B
	CN102130128	20.07.2011	A
	Priority number	Date	
	FR1050241	14.01.2010	
Type	Publication No.	Date	Type
<input checked="" type="checkbox"/> Equivalent			
	→ <a href="#">EP2346077</a> <span style="color: red;">!</span> Global dossier	20.07.2011	A1
	Priority number	Date	
	FR1050241	14.01.2010	
Type	Publication No.	Date	Type
<input checked="" type="checkbox"/> Equivalent			
	→ <a href="#">FR2955204</a>	20.07.2012	B1
	FR2955204	15.07.2011	A1
	Priority number	Date	
	FR1050241	14.01.2010	
Type	Publication No.	Date	Type
<input checked="" type="checkbox"/> Equivalent			
	→ <a href="#">JP5420517B</a>	19.02.2014	B2
	JP2011146685	28.07.2011	A



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### Maintenance news

#### Scheduled maintenance

Owing to technical maintenance work the European Patent Register will be temporarily unavailable from 19.00 hrs CET on Friday, 27 June 2014: until Sunday 29th June

We apologise for any inconvenience

26.06.2014

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#### News flashes

#### Related links

### EPO Global Dossier

File wrapper data provided courtesy of SIPO, for family member with application no. CN201080038496

Date	Description	Pages
29.10.2012	<a href="#">First Office Action(PCT) (ORIGINAL)</a>	-
29.10.2012	<a href="#">First Office Action(PCT) (TRANSLATED)</a>	-
30.05.2012	<a href="#">Invention Publication (ORIGINAL)</a>	-



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2 items in my patents list

Sort by  Sort order

### 1. Treatment and prevention of secondary injury after trauma or damage to the central nervous system

Inventor: SCHNEIDER ERIC B	Applicant: SCHNEIDER ERIC B	CPC: <a href="#">A61K31/36</a> <a href="#">A61K31/365</a> <a href="#">A61K31/40</a>	IPC: A61K31/36 A61K31/365 A61K31/40 (+2)	Publication info: CN102481283 (A) 2012-05-30	Priority date: 2009-08-31
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### 2. TREATMENT AND PREVENTION OF SECONDARY INJURY AFTER TRAUMA OR DAMAGE TO THE CENTRAL NERVOUS SYSTEM

Inventor: SCHNEIDER ERIC B [US]	Applicant: SCHNEIDER ERIC B [US]	CPC: <a href="#">A61K31/36</a> <a href="#">A61K31/365</a> <a href="#">A61K31/40</a>	IPC: A61K31/36 A61K31/365 A61K31/40 (+2)	Publication info: EP2473166 (A2) 2012-07-11	Priority date: 2009-08-31
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# **POTENTIAL ADVANTAGES**

- To Examiners
  - Facilitated Worksharing
  - Improve Quality
  - Increased uniformity and potential harmonization
- To Applicants
  - Monitor portfolio
  - More uniformity in patent coverage
  - Reduce litigation risk of inconsistent arguments
  - Reduce ID5 burdens
  - Reduce costs
- To Third Parties
  - Facilitate searching
  - Reduce litigation costs
  - Ease due diligence opinions
  - Reduce translation burdens

# **ACTIVE (Document Submission) PART**

- Must balance cost effective use of GD vs. risk of losing legal input from local practitioners when filing documents.
- Possibly use for automatically populating user information.
- Use for administrative documents such as powers of attorney, assignments, change of name or address.
- Can reduce administrative costs and costs resulting from entry errors; in some countries loss of rights.
- Use of information already in the passive part of the GD to submit to the other IP5 offices, e.g., assignment, changes of name/address, or indicate a new filling form.
- Applicant/local counsel receives notification of filing (e.g., serial number) and then local counsel submits legal documents (translations, amendments to claims, etc.) to get filling date.
- GD Task Force meeting with Industry/Patent Offices scheduled for end of Jan. 2015 in China.

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# Questions and Comments?

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