

# FICPI WORLD CONGRESS

**BREAKING NEWS –**  
ALL THE LATEST DEVELOPMENTS YOU NEED TO KNOW



# OUR SPEAKERS

Mariana Mostardeiro

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Dragon IP

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Rothwell Figg Ernst & Manbeck, PC

DANNEMANN  
SIEMSEN

dragon IP

WINTER · BRANDL · FÜRNISS · HÜBNER  
RÖSS · KAISER · POLTE ■ PARTNERSCHAFT MBB  
PATENT- UND RECHTSANWALTSKANZLEI

RF ROTHWELL FIGG  
IP Professionals



# OUR COUNTRIES/REGIONS

- BRAZIL
- PROSUR
- PEOPLE'S REPUBLIC OF CHINA
- SOUTH KOREA
- EUROPEAN UNION
- GERMANY
- UNITED KINGDOM
- DENMARK
- UNITED STATES
- CANADA



# AUTOMATIC ALLOWANCE OF PATENTS

Mariana Mostardeiro

**DANNEMANN  
SIEMSEN**



# AUTOMATIC ALLOWANCE OF PATENTS

## Admission requirements

APPLICATIONS FILED UNTIL THE PUBLICATION OF THE RESOLUTION.

CERTIFICATE OF INVENTION, DIVISIONALS, AND PHAMACEUTICAL PRODUCTS AND PROCESS ARE NOT PERMITTED.

REQUEST EXAMINATION AND ANNUITIES PAID.



PCT and non-PCT applications<sup>1</sup>  
filed at the Brazilian PTO

Return to  
regular examination **ALLOWANCE**

-----  
Publication of the  
new regulation

30 days

Formal  
requirements

YES

NO

- annuities up-to-date
- application published/BR  
national phase initiated
- examination requested
- no office action issued

Formalities should be  
complied with

YES

NO

Voluntary  
exclusion  
procedure  
filed by  
the  
Applicant?  
request  
from  
the  
Applicant?

90 days

Notice of  
admissibility in  
the IP Journal

# AUTOMATIC ALLOWANCE OF PATENTS

## Good Strategy

IDENTIFY YOUR OWN CASES THAT SHOULD BE EXCLUDED FROM THE AUTOMATIC ALLOWANCE.

IDENTIFY ANY APPLICATION FROM THIRD PARTIES THAT SHOULD BE EXCLUDED FROM THE AUTOMATIC ALLOWANCE.



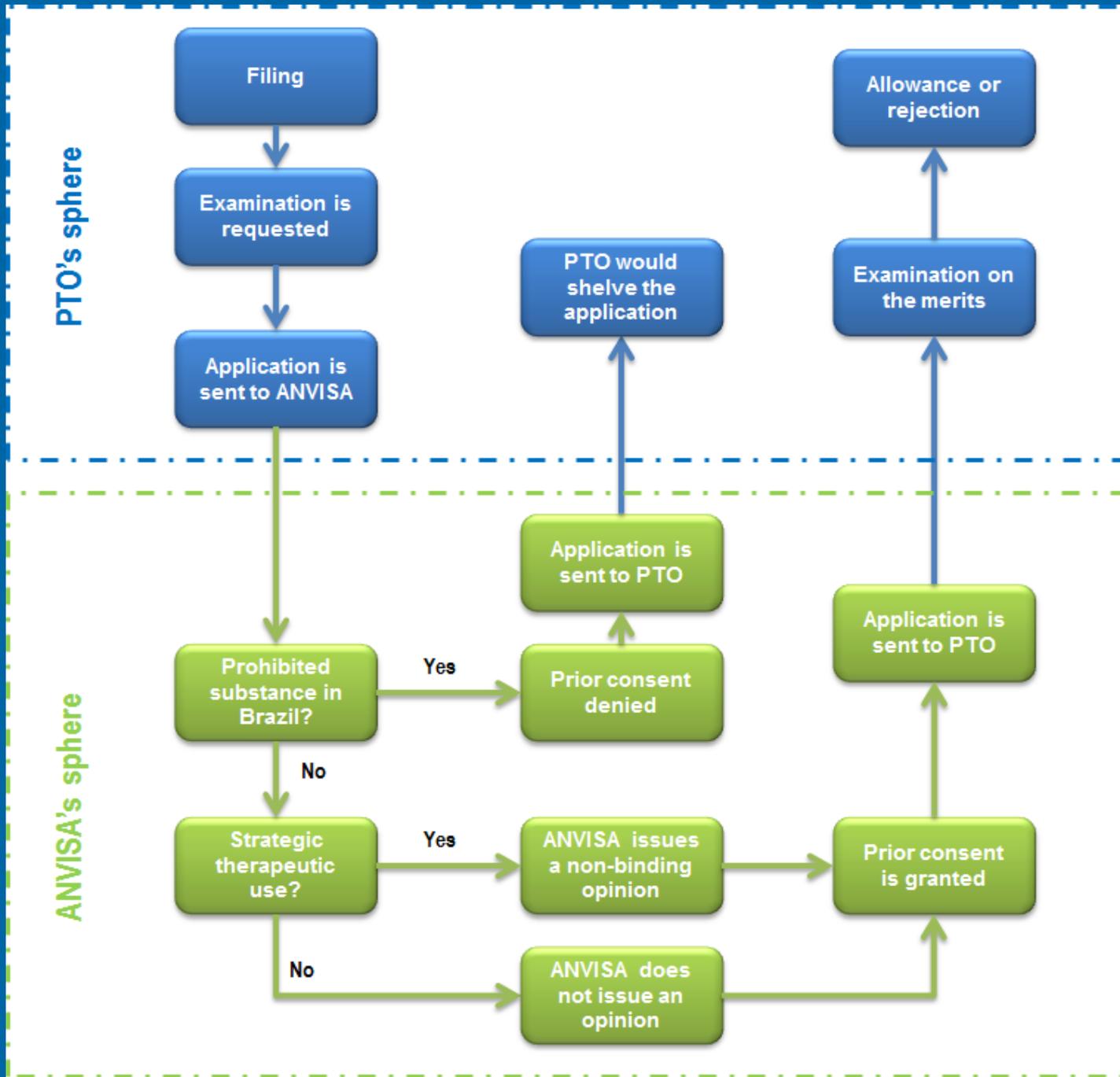
# ANVISA'S INTERFERENCE - NEW RULES



# ANVISA'S INTERFERENCE

- **PRIOR CONSENT SHALL BE DENIED ONLY IF PATENT APPLICATION IS RELATED TO A PROHIBITED SUBSTANCE IN BRAZIL.**
- **FOR STRATEGIC INVENTIONS, ANVISA SHALL ISSUE A NON-BINDING PATENTABILITY OPINION.**
  - **IF INVENTION IS NOT RELATED TO A PROHIBITED SUBSTANCE, PRIOR CONSENT SHALL BE GIVEN EVEN IF ANVISA UNDERSTANDS THAT INVENTION WOULD NOT BE PATENTABLE.**
  - **IF BPO CONSIDERS THAT INVENTION IS PATENTABLE, PATENT SHALL BE GRANTED REGARDLESS OF ANVISA'S OPINION.**
- **NEW RULES WILL BE APPLIED TO PATENT APPLICATIONS THAT HAVE ALREADY BEEN SUBJECTED TO ANVISA'S ANALYSIS.**
  - **ANVISA PRIOR CONSENT DENIAL DECISION BASED ON PATENTABILITY CRITERIA WILL BE CONSIDERED AS AN OPINION BY BPO.**

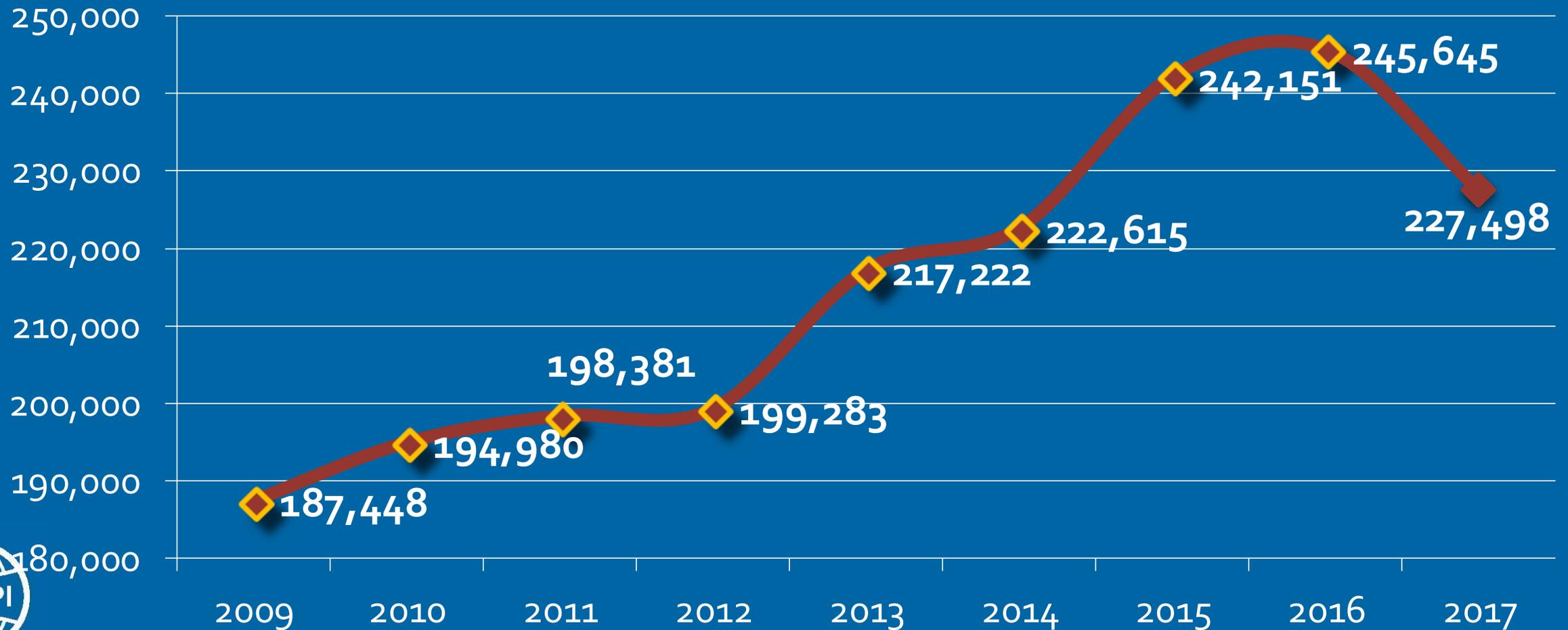




# NEW MEASURES TO REDUCE THE BACKLOG



# PENDING PATENT APPLICATIONS



# HOW TO OVERCOME BPO'S DELAY

## ALTERNATIVES TO ANTICIPATE START OF BPO'S EXAMINATION.

FAST TRACK.

PATENT PROSECUTION  
HIGHWAY – PPH.

WRIT OF MANDAMUS.



# FASTTRACK

LIKELIHOOD OF  
INFRINGEMENT

NOTICE  
LETTER.

INFRINGEMENT  
EVIDENCE.

ONCOLOGY,  
HIV,  
NEGLECTED  
DISEASES, OR  
RARE  
DISEASES.

FINANCIAL  
FROM  
BRAZILIAN  
CREDIT  
INSTITUTIONS.

GREEN INVENTION

ALTERNATIVE  
ENERGY

TRANSPORTATION

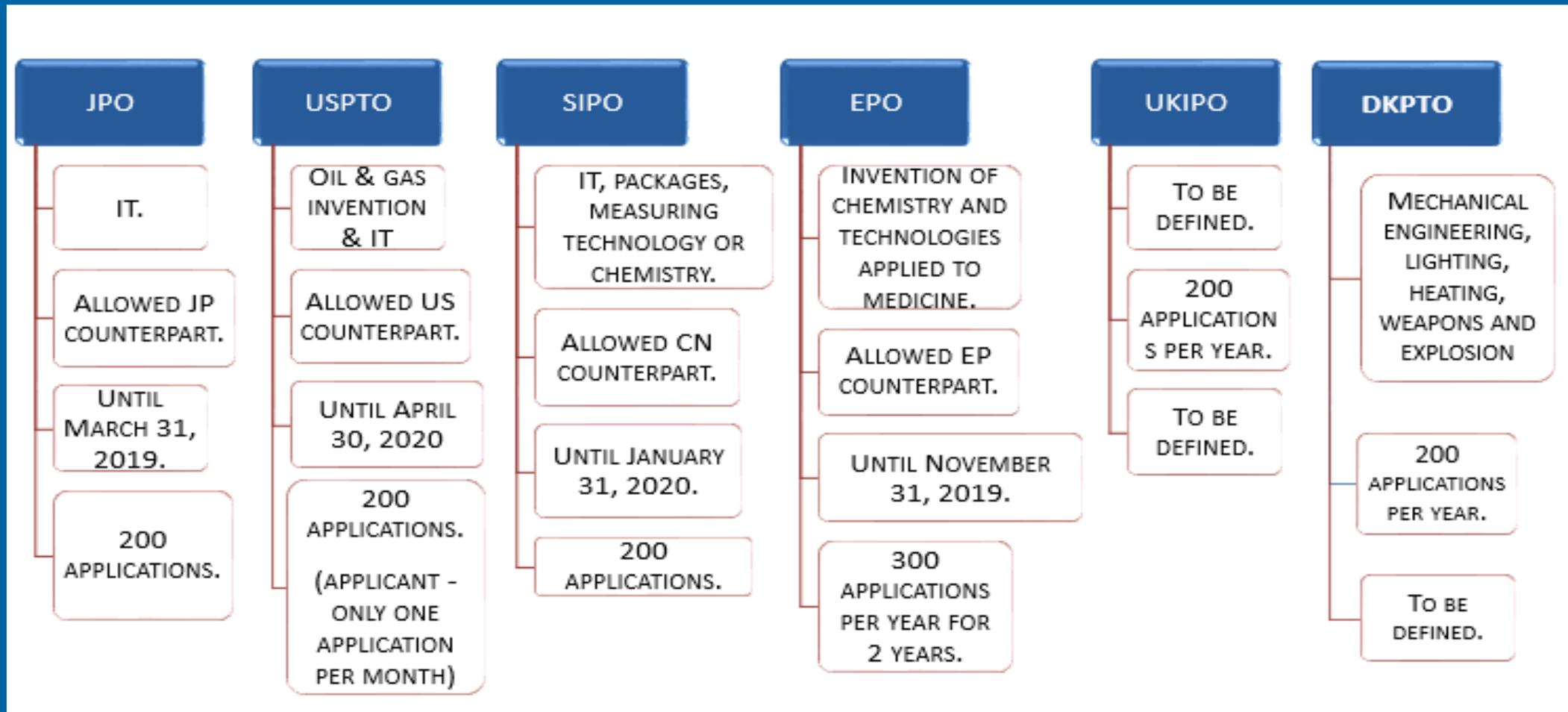
ENERGY CONSERVATION

WASTE MANAGEMENT

SUSTAINABLE AGRICULTURE



# PPH



# WRIT OF MANDAMUS

## INJUNCTION ORDERING BPO

TO IMMEDIATELY START  
ITS EXAMINATION.

TO TAKE EACH STEP – E.G.,  
TO ISSUE AN OFFICE  
ACTION OR A DECISION –  
WITHIN A 60-DAY TERM.

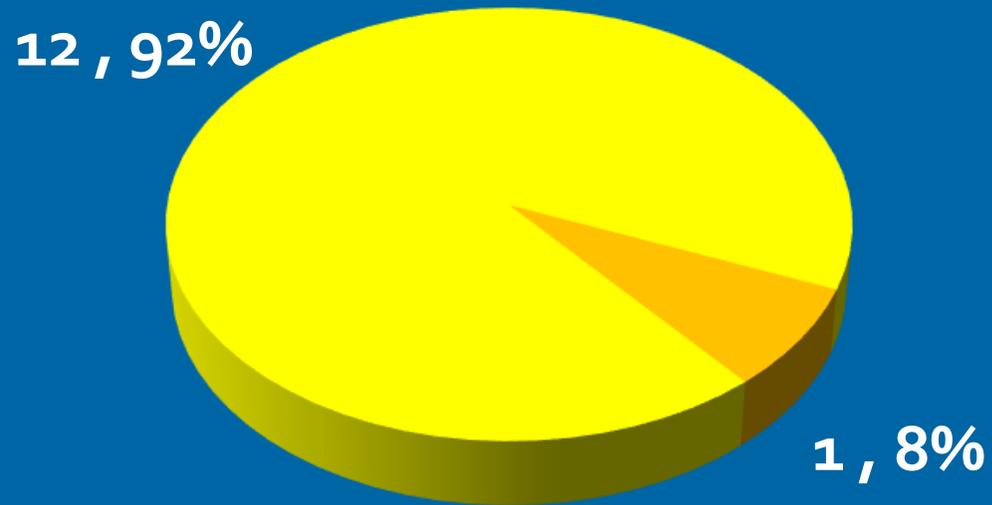
IT IS POSSIBLE TO OBTAIN A  
PRELIMINARY INJUNCTION.

REASON WHY THE  
PENDING APPLICATION  
SHOULD “CUT THE LINE OF  
PATENT APPLICATIONS TO  
BE EXAMINED”



# WRIT OF MANDAMUS (2013-2017)

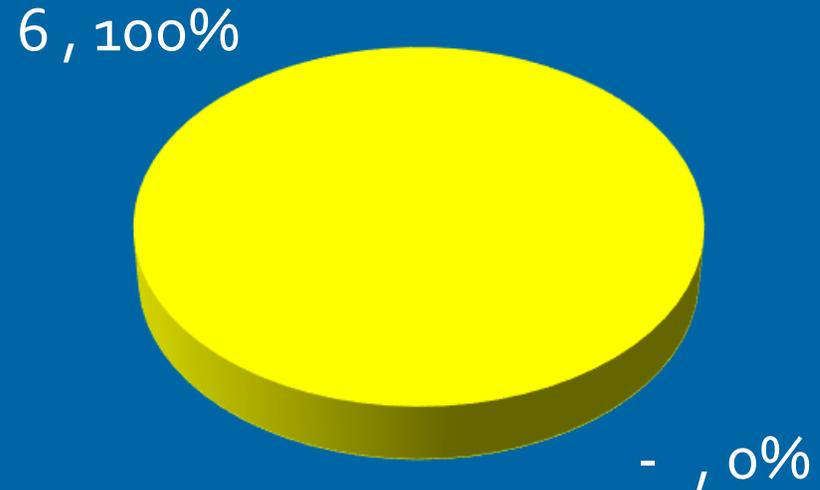
## 1st Instance



- BPO's delay is unreasonable
- BPO's delay is NOT unreasonable

# of cases; percentage

## 2nd Instance



- BPO's delay is unreasonable
- BPO's delay is NOT unreasonable

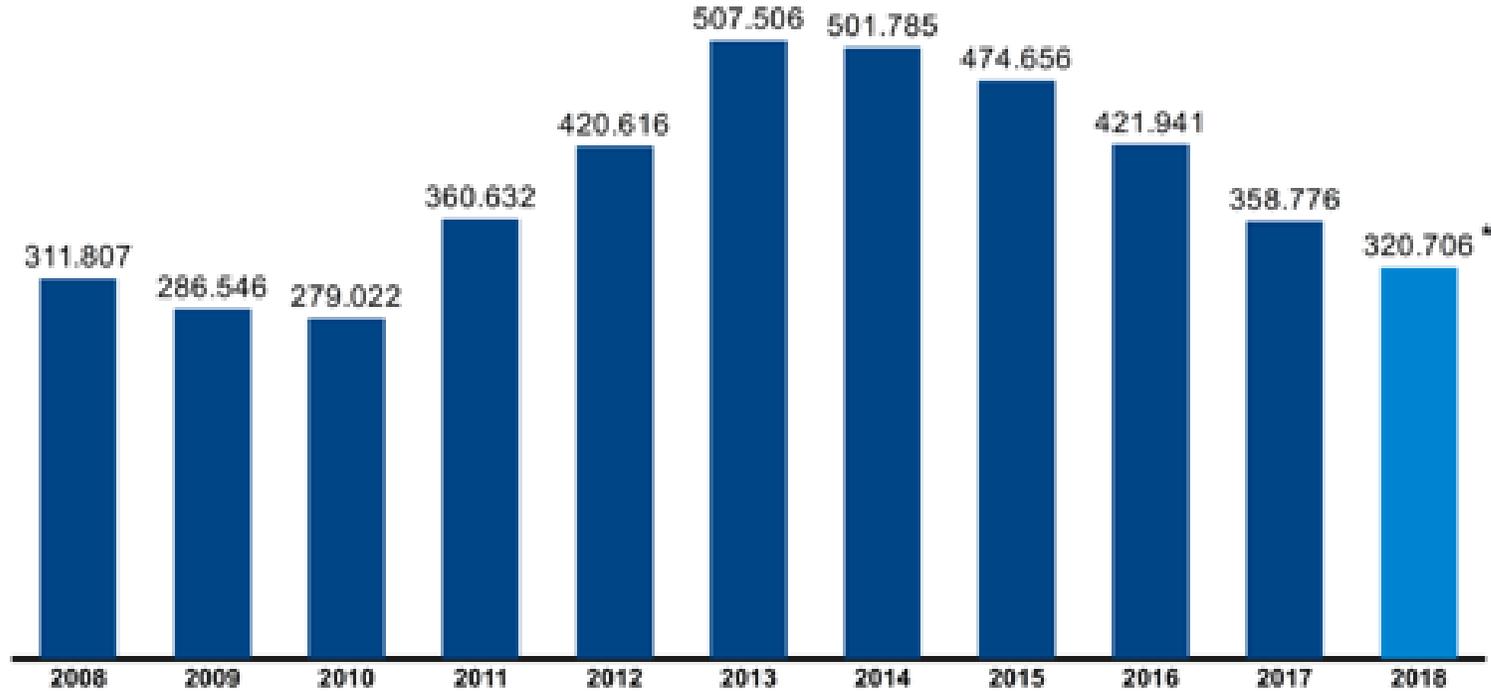
# of cases; percentage



# TRADEMARKS



# APPLICATIONS PENDING FIRST OFFICE ACTION



# MADRID PROTOCOL



- ACCESSION TO THE PROTOCOL HAS BEEN POSTPONED SO FAR MAINLY DUE TO THE BPTO'S BACKLOG FOR EXAMINING APPLICATIONS.
- BPTO EXPECTS TO ACHIEVE THE 18 MONTHS EXAMINATION PERIOD DEMANDED BY THE MADRID PROTOCOL IN 2019.



# MADRID PROTOCOL CHALLENGES



- ACCEPT MULTIPLE-CLASS APPLICATION IN A SINGLE APPLICATION.
- INTERNAL STRUCTURE OF THE BRAZILIAN PTO: TRANSLATION, NEW DIVISION, ETC.
- THE REQUIREMENT OF LOCAL ATTORNEY OF RECORD WITH POWER TO RECEIVE SUMMONS AND SUBPOENAS.
- THE LOCAL NEED OF LAWFUL ACTIVITY IN RELATION TO THE GOODS/SERVICES CLAIMED.



# PROSUR - COOPERATION SYSTEM ON MANAGEMENT INFORMATION AND INDUSTRIAL PROPERTY



# PROSUR



- PROSUR is a joint initiative of certain countries to support and harmonize Industrial Property rights in their jurisdictions, which now encompass **Argentina, Brazil, Chile, Colombia, Ecuador, Paraguay, Peru, Uruguay, Costa Rica, Nicaragua, Panama and the Dominican Republic.**
- Objective: Data and information exchange between the different Offices of Industrial Property of Latin America (<http://prosur.org/en/>).



# PPH-PROSUR



- Patent Prosecution Highway – PROSUL consists of a cooperative patent examination procedure covering patent applications filed in **Brazil, Argentina, Chile, Colombia, Ecuador, Paraguay, Peru, Costa Rica and Uruguay.**
- The patent family of the application should have at least the first patent application filed in any of the participating countries and there are **no limitations as to the technical field** of the invention and the respective filing date of the patent application.



Home / [Search engine for patents](#)

Búsqueda:

### Opciones Avanzadas

ONAPI

<input type="checkbox"/>												
Argentina	Brasil	Chile	Colombia	Ecuador	Paraguay	Perú	Uruguay	Panamá	Costa Rica	Nicaragua	El Salvador	Republica Dominicana

No. Solicitud:

Fecha de presentación :

 (período) 

Fecha de publicación nacional:

 (período) 

Estados

<input type="checkbox"/>	Concedida	<input type="checkbox"/>	En Trámite	<input type="checkbox"/>	Negada	<input type="checkbox"/>	Caducada	<input type="checkbox"/>	No Vigente
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# AMENDMENTS OF GUIDELINES FOR PATENT EXAMINATION IN CHINA

Rita Zhang



# INTRODUCTION

- Background
  - Enhancing the patent protection in the fields of business modes, Internet, E-business, big data and so on
  - Optimizing amendments for a granted patent and information disclosure.
- Time schedule
  - Starting from October 2015, and after about one and half year's discussions and modification, finally coming into effect from April 1, 2017.



# AMENDED CHAPTERS

- Part II Chapter 1, Inventions-Creations for which No Patent Right shall be Granted
- Part II Chapter 9, Some Provisions on Examination of Invention Application Relating to Computer Programs
- Part II Chapter 10, Some Provisions on Examination of Invention Application in the Field of Chemistry
- Part IV Chapter 3, Examination of Requests for Invalidation
- Part V Chapter 4, Patent Application Files
- Part V Chapter 7, Time limit, Restoration of Right and Suspension of Procedure



## PART II CHAPTER 1

# Inventions-Creations for which No Patent Right shall be Granted



# UNPATENTABLE SUBJECT MATTER

- Article 25, Patent Law of PRC
  - For any of the following, no patent right shall be granted:
    - (1) Scientific discoveries;
    - (2) Rules and methods for mental activities;
    - (3) Methods for diagnosis or for the treatment of diseases.....
  - Regarding the above item (2), the guideline is amended to make it clear that if a claim related to a business mode includes both business rules/methods and technical features, such claim shall not be rejected by item (2) of Article 25 of Chinese Patent law.



# CASE 1

1. A transaction method, comprising:

A: reading, by a Point of Sale terminal, card information of a transaction card;

B: transmitting, by the POS terminal, the card information to a mobile terminal in communication connection with the POS terminal; transmitting, by the mobile terminal, the card information to a POS sever; receiving, by the POS terminal, a verification result from POS server through the mobile terminal and implementing verification;

C: transmitting, by the POS terminal, transaction information to the mobile terminal, transmitting, by the mobile terminal, the transaction information to the POS server and fulfilling transaction; receiving, by the POS terminal, a transaction result from POS server through the mobile terminal.



# CASE 2

1. A cell phone recycling and pricing method, comprising:
  - observing a brand and a service life of the cell phone;
  - observing an appearance of the cell phone;
  - determining prices of elements to be replaced based on a price list of the elements;
  - determining a recycling price of the cell phone.



The subject matter of claim 1 does not include any technical feature, and substantially belongs to rules and methods for mental activities, thus shall be rejected based on item (2) of Article 25 of the Patent Law.

# PART II CHAPTER 9

## Some Provisions on Examination of Invention Application Relating to Computer Programs



# COMPUTER PROGRAM RELATED PATENT APPLICATIONS

- A computer program per se shall be rejected based on item (2) of Article 25 of the Patent Law.
- Invention related to computer programs  $\neq$  computer program per se
- Before Amendments: if a computer program related claim is drafted as an apparatus claim, it must be drafted to only include functional modules strictly corresponding to the steps of a method.
- After Amendments: computer program related claims may be drafted to include hardware, software and improvements thereof



# NEW ACCEPTABLE DRAFTING WAYS

Two new acceptable drafting ways after amendments of Guidelines for Patent Examination are as follows.

**Way 1:** A computer readable storage medium, on which computer programs (instructions) are stored, wherein the computer programs (instructions) are executed by a processor to implement the following steps... (or the method according to claim X).

**Way 2:** A computer device, comprising a memory, a processor and computer programs stored on the memory and executed by the processor, wherein the processor executes the computer programs to implement the steps of .....



## PART II CHAPTER 10

# Some Provisions on Examination of Invention Application in the Field of Chemistry



# EXPERIMENTAL DATA

**Before Amendments :** any experimental data submitted after the date of filing shall not be taken into consideration.

**After Amendments:** The examiner shall examine the experimental data submitted after the date of filing. A technical effect proved by the experimental data submitted after the date of filing should be a technical effect that could be obtained by a person skilled in the art based on the disclosed contents contained in the initial description and claims.



## PART IV CHAPTER 3

# Examination of Requests for Invalidation



# MORE FLEXIBLE AMENDMENTS ON CLAIMS

**Before:** Subject to the above principle of amendments, the specific manners of amendment are generally limited to deletion of a claim, combination of claims, and deletion of a technical solution.

**After :** Subject to the above principle of amendments, the specific manners of amendment are generally limited to deletion of a claim, ~~combination of claims,~~ and deletion of a technical solution, further limitation of a claim and correction of an obvious error.



# MORE FLEXIBLE AMENDMENTS ON CLAIMS

Further limitation of a claim means adding one or more technical features defined in other claims to the claim , so as to narrow the protection scope of the claim.

Further limitation of a claim by adding contents disclosed in the description or drawings, but not defined in other claims to the claim is NOT acceptable.

According to patent practice, obvious errors in claims could be corrected after amendments of Guideline.



# ADDING NEW INVALIDATION CAUSES

**Before :** For claims amended by way of combination by the patentee, addition of causes for invalidation is made within the time limit specified by the Patent Reexamination Board.

**After:** For claims amended by ways other than deletion by the patentee , addition of causes for the amended content is made within the time limit specified by the Patent Reexamination Board.



# EXAMPLE

1. A device, comprising A and B.
  2. The device according to claim 1, further comprising C and D.
  3. The device according to claim 1, further comprising E and F.
- During invalidation, claim 1 is amended to:
    1. A device, comprising A, B, C and F.
  - Reason 1: the amended claim 1 goes beyond the initial scope.
  - Reason 2: the amended claim 1 cannot be supported by the description.
  - Reason 3: some term in feature F is not clear.



## PART V CHAPTER 4

# Patent Application Files



# CONTENTS ALLOWED FOR PHOTOCOPYING

- For the file of a patent application for invention which has been published and whose grant of patent right has not been announced, the contents in the file which may be consulted and copied ~~relate to those before the date of publication~~, including the application documents, formality documents directly relating to the application, publication documents, notification and decisions sent to the applicant in the preliminary examination procedure and the text of the observations submitted by the applicant in response to the notifications, and notification, search reports and decisions sent to the applicant in the substantial examination.
- For a granted patent, its priority documents and search reports can be consulted and copied.



## PART IV CHAPTER 7

# Time limit, Restoration of Right and Suspension of Procedure



# ASSISTANCE OF PROPERTY PRESERVATION

- For the suspension due to execution assistance of property preservation asked by the People's Court, ~~the suspension period is generally six months. The suspension shall cease six months after the date of receiving the civil order.~~ the suspension is implemented based on the time limit recorded in the civil order and notification on Assistance in Execution.
- The suspension may be extended ~~six months~~ if the Notification on Assistance in Execution complies with the regulations set forth in Section 7.3.2.4. ~~The time limit for suspension shall not exceed 12 months for a preservation verdict made during the execution procedure by the same court for the same case. If the preservation verdict is made during the trial procedure, the time limit for preservation can be extended accordingly.~~



# INVALIDATION PROCEDURE

With respect to patents in the invalidation procedure, the duration for suspension are requested by the party concerned in a dispute over the ownership of right ~~or asked by the People's Court~~ to assist in execution of property preservation shall not exceed one year.

After the time limit for suspension expires, where there is no request of the people's court to continue the preservation, the examiner shall issue a Notification of Cessation of Suspension to notify the People's Court and the applicant (or patentee), resume the relevant procedure, and announce the discharging of preservation of the patent right. The one on the top of a waiting list in turn of the preservation request shall be executed from the date on which the previous preservation comes to an end. The duration of the preservation is ~~6 months~~ recorded in the civil order and notification on Assistance in Execution.



# SOUTH KOREA



# KIPO INITIATIVES TO DEAL WITH THE FOURTH INDUSTRIAL REVOLUTION (“4IR”)

- New technology classification system by Korea Intellectual Property Office (“KIPO”)
  - Seven core 4IR technologies – AI, Big Data, IoT, 3D printing, autonomous driving, intelligent robots, and cloud computing
- Expedited examination
  - By filing a request, can shorten examination period from more than five months to two months
- Patents
  - Can receive a patent in fewer than six months rather than the normal average of about 16 months.
  - Will use a three-examiner consultation system for examination
- Updated examination guidelines
  - Include 14 example cases for determining inventive step



# UNFAIR COMPETITION

- Legislature has recently passed amendments to:
  - Unfair Competition and Trade Secret Protection Act
  - Fair Transactions in Subcontracting Act
- New regulations will soon go into effect to protect small and medium size entities (“SMEs”) from pressure by large companies
- Provides that taking ideas, such as trade secrets, during business negotiations or in the course of business transactions is a new form of unfair competition
- Authorizes the chairman of KIPO to investigate the taking of ideas and recommend remedies against such taking
- KIPO and various government agencies are preparing to investigate violations and enforce the amendments
- Result is that companies, including those from outside South Korea, need to be careful when requesting information from SMEs, and need to have procedures in place to obtain consent for transfer and use of information and to maintain records of communications



# JAPAN



# REVISION OF EXAMINATION GUIDELINES FOR PATENT AND UTILITY MODEL RELATED TO THE COMPUTER SOFTWARE-RELATED INVENTIONS – EFFECTIVE 1 APRIL 2018

- **JPO Summary** – [https://www.jpo.go.jp/iken\\_e/back\\_20180314\\_guide.htm](https://www.jpo.go.jp/iken_e/back_20180314_guide.htm)
- “With the emergence of new technologies such as IoT related technology and AI, software-related inventions are created in many technical fields, so that it is desired that the basic concept is clearly understandable concerning eligibility for patent and inventive step, since it is increasingly necessary for examiners and users in these various technical fields to examine with sufficient understanding of the contents of the examination guidelines related to software-related inventions concerning eligibility for patent and inventive step.”
- “Based on these circumstances, the contents of eligibility for patent have been clarified without changing basic concept about examination guidelines related to software-related inventions.”



# REVISION OF EXAMINATION GUIDELINES FOR PATENT AND UTILITY MODEL RELATED TO THE COMPUTER SOFTWARE-RELATED INVENTIONS. (CONTINUED)

- “Since the pre-revision examination guidelines do not describe definitions of terms such as "program", "equivalent to programs", "software", "data structure" and the like, and do not describe the meaning to consider eligibility of patent from the viewpoint of computer software (the invention complies with the requirements of eligibility for patent if "information processing by the software is concretely realized by using hardware resources"), These definitions and meanings have been added to understand the basic concept only from the description of the examination guidelines.”
- “According to the pre-revision examination guidelines, it is described to examine eligibility for patent from "a viewpoint of computer software", and then it is described that those concretely performing control of an apparatus or processing with respect to the control or those concretely performing information processing based on the technical properties of an object is the statutory invention. Since the order of description and order of examination did not correspond, the order of description has replaced and corresponded the order of description and order of examination.”



# BREAKING NEWS: EUROPEAN PART

... is there any news in those about 46 countries of that region?

Dr. Alexander Wyrwoll



# STRUCTURE

1. Unitary Patent in the EU
2. European Patent Office
  - a) Fees
    - i. Search and Examination Fees
    - ii. Filing and Grant Fees
    - iii. Appeal Fees
    - iv. Refund of Search or Examination Fee
  - b) Proceedings
  - c) Priority
  - d) Disclaimer
3. DE
4. UK
5. DK



# 1. UNITARY PATENT IN THE EU

- The EU regulations establishing the Unitary Patent system (No 1257/2012 and No 1260/2012) entered into force on 20 January 2013, but they will only apply as from the date of entry into force of the UPC Agreement, that is, on the first day of the fourth month following the deposit of the 13th instrument of ratification or accession Ratification necessary by **at least 13 countries**,
  - including FR,  16
  - UK,  (13/03/2014)
  - and DE  (26/04/2018)
  -  -----
- Constitutional complaint filed in Germany and declared acceptable but decision pending (possibility of delay due to evolvement of European Court of Justice; timeline undefined)
- Renewed discussion on 15/03/2018 at the German Parliament with following deferral to Committees for further deliberation



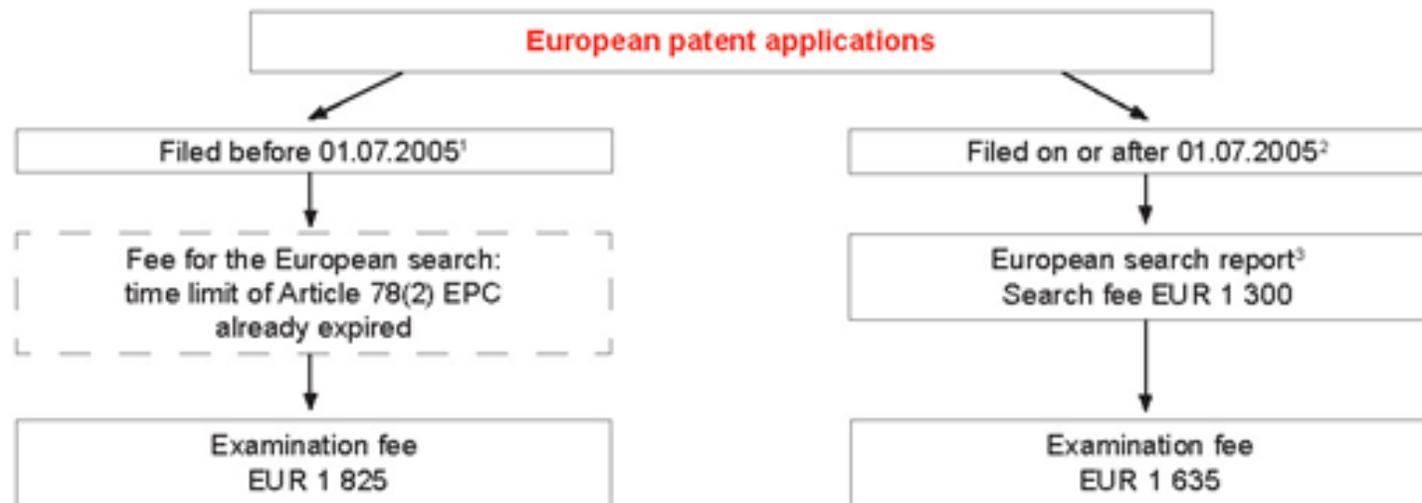
## 2. EPO – A) FEES

- For PCT applications filed using the EPO as Receiving Office and/or International Searching Authority (ISA) on or after 1<sup>st</sup> April 2018:
  - reduction of the fee for an international search/a supplementary international search by € 100, from € 1,875 to € 1,775
  - reduction of the fee for preliminary examination by 100 EUR, from € 1,930 EUR to € 1,830
- For PCT applications entering the European Regional Phase on or after 1st April 2018:
  - reduction of the examination fee from € 912.50 (50% of the regular examination fee (currently € 1825)) to € 456.25 (75% of the regular examination fee), if the EPO has drawn up the **IPER**
  - abrogation of the reduction in the European search fee where the international search was performed by any of the following offices: USPTO, JPO, KIPO, SIPO, RosPat, Australian Patent Office

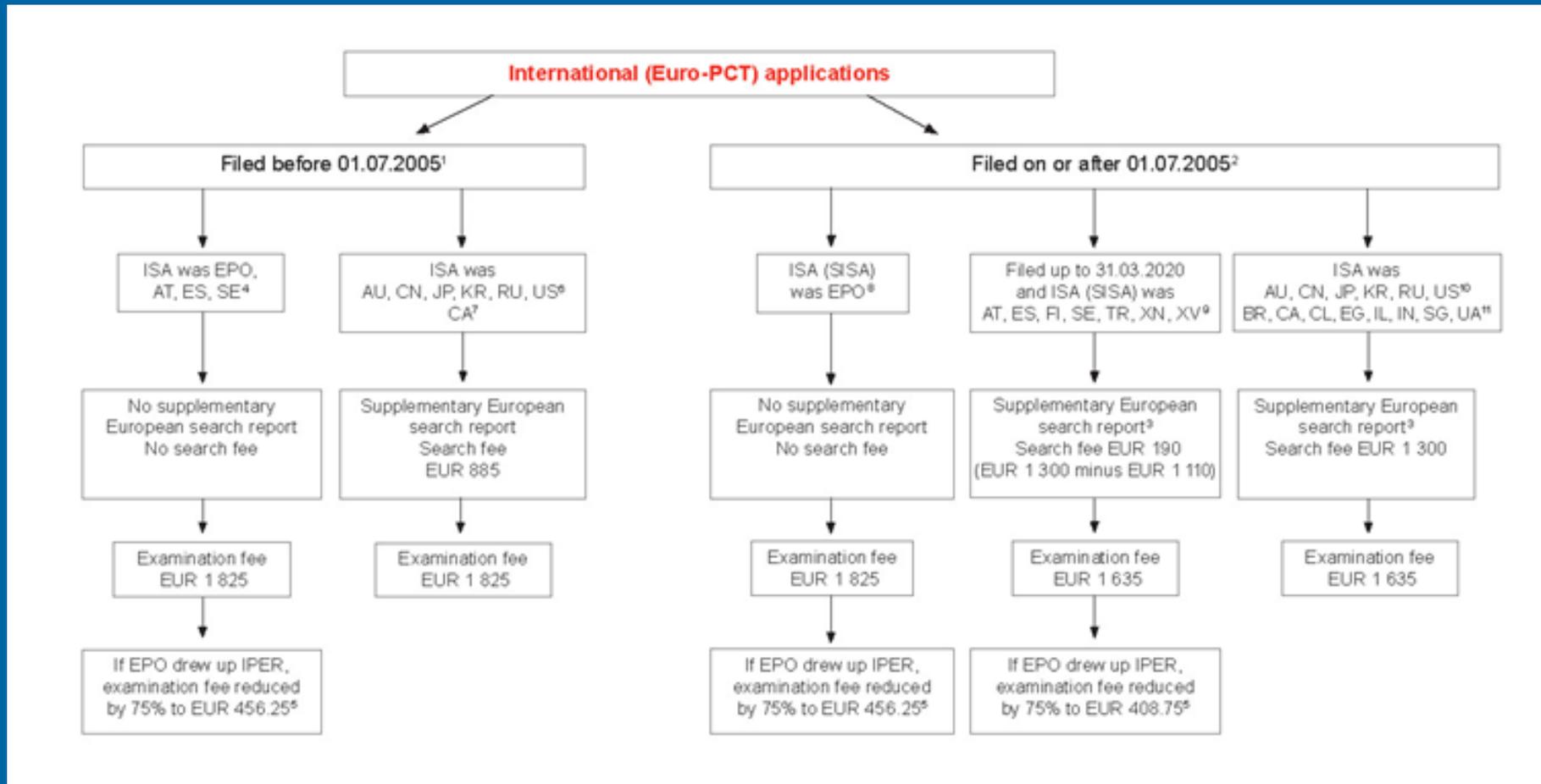


## 2. EPO – A) FEES

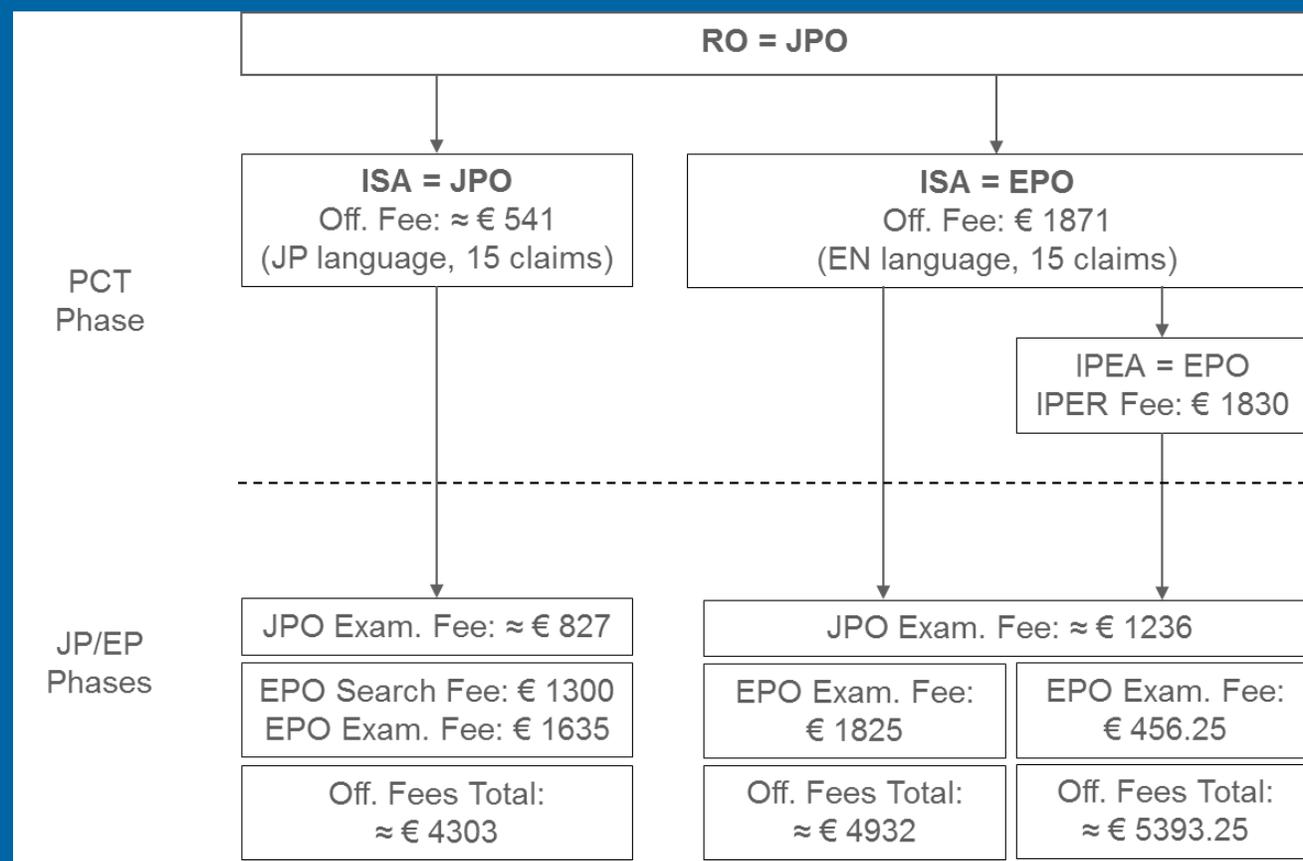
Amounts of search and examination fees applicable to payments made from 1 April 2018



## 2. EPO – A) FEES



## 2. EPO – A) FEES



## 2. EPO – A) FEES

- Since 1st April 2018, there are two levels of appeal fee:
  - for appellants that are either (a) a natural person, or (b) a small- or medium-sized enterprise (SME), a non-profit organisation, a university or a public research organisation, the appeal fee is € 1,880
  - for all other entities, the appeal fee has been increased to € 2,255
  - SME = (fewer than 250 employees) +  
(annual turnover not exceeding EUR 50 million and/or annual balance sheet total not exceeding EUR 43 million) +  
(no more than 25% of the capital is held directly or indirectly by another company that is not an SME)



## 2. EPO – A) FEES

- Refund of the search fee (effective as of 1st December 2017):

Type of earlier search	Benefit for current search and refund (expressed as percentage of fee paid for current search)
European search on a European patent application	100%, if the EPO can make full use of the earlier search report  25 %, if the EPO can make partial use of the earlier search report
International search on an international application	84 %, if the EPO can make full use of the earlier search report  21 %, if the EPO can make partial use of the earlier search report

## 2. EPO – A) FEES

- Since 1st April 2018, there are two levels of appeal fee:
  - for appellants that are either (a) a natural person, or (b) a small- or medium-sized enterprise (SME), a non-profit organisation, a university or a public research organisation, the appeal fee is € 1,880
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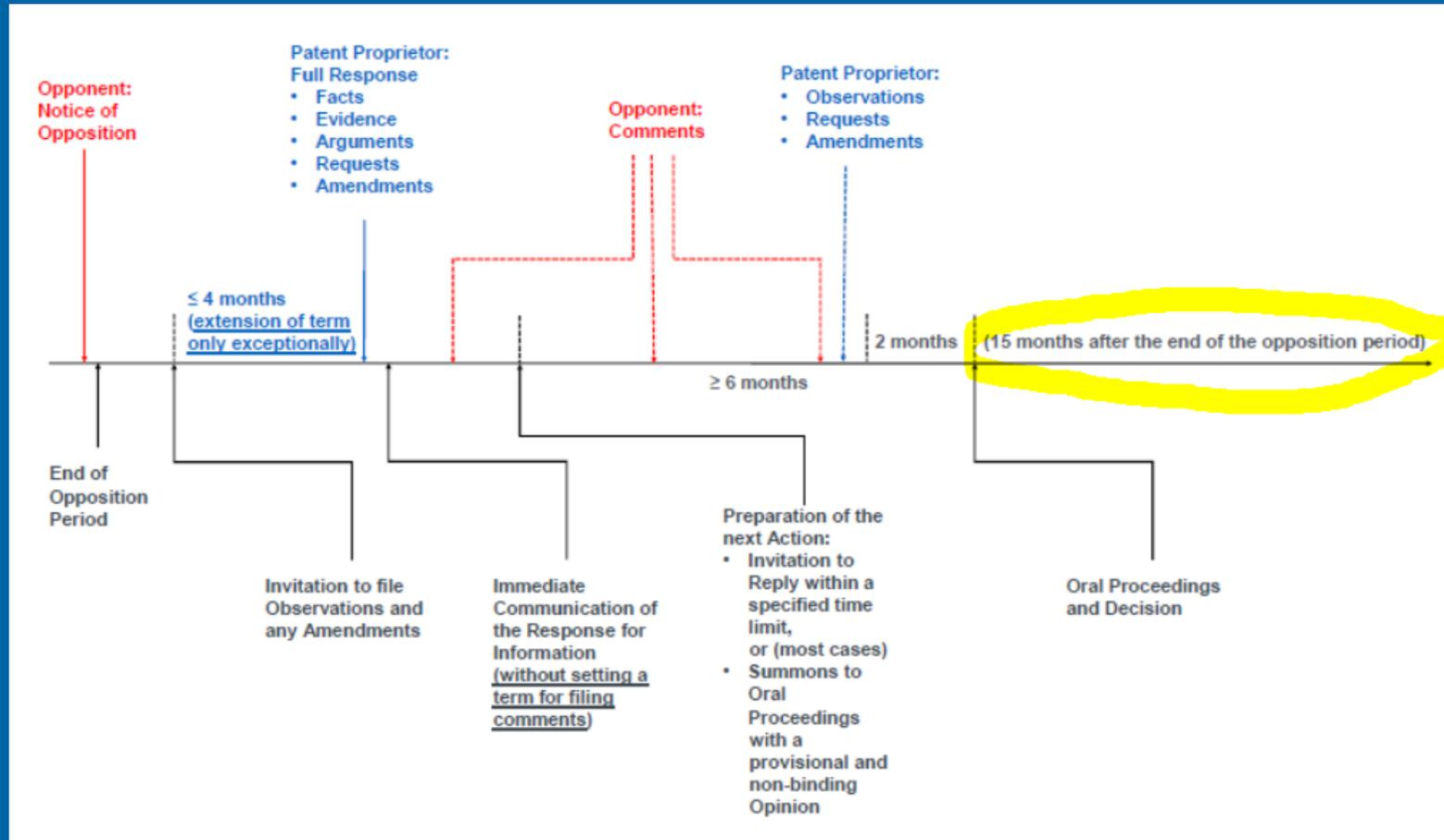


## 2. EPO – A) FEES

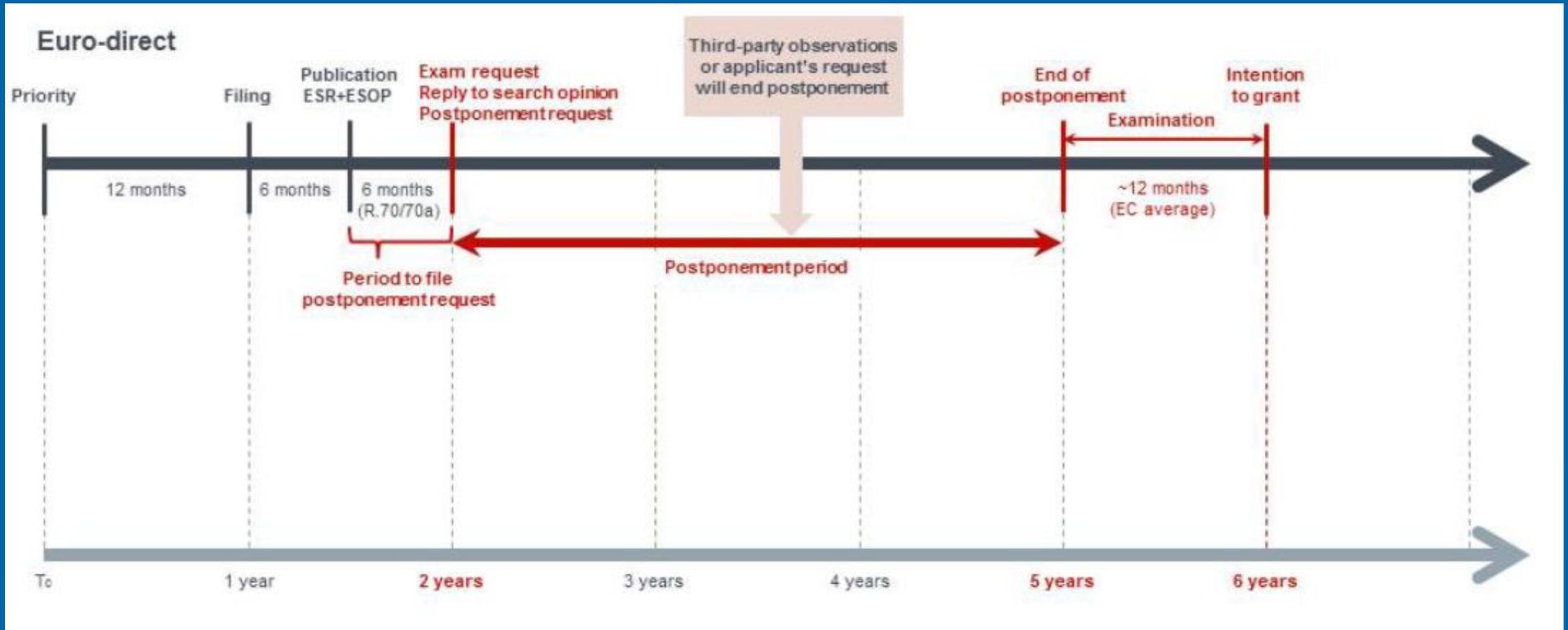
- Refund of the examination fee (effective as of 1st November 2016) :
  - in full, if the European patent application is withdrawn, refused or deemed to be withdrawn before substantive examination has begun;
  - at a rate of 50%, if the European patent application is withdrawn after substantive examination has begun and
    - before expiry of the time limit for replying to the first invitation under Art. 94(3) EPC or,
    - if no such invitation has been issued by the Examining Division, before the date of the communication under Rule 71(3) EPC



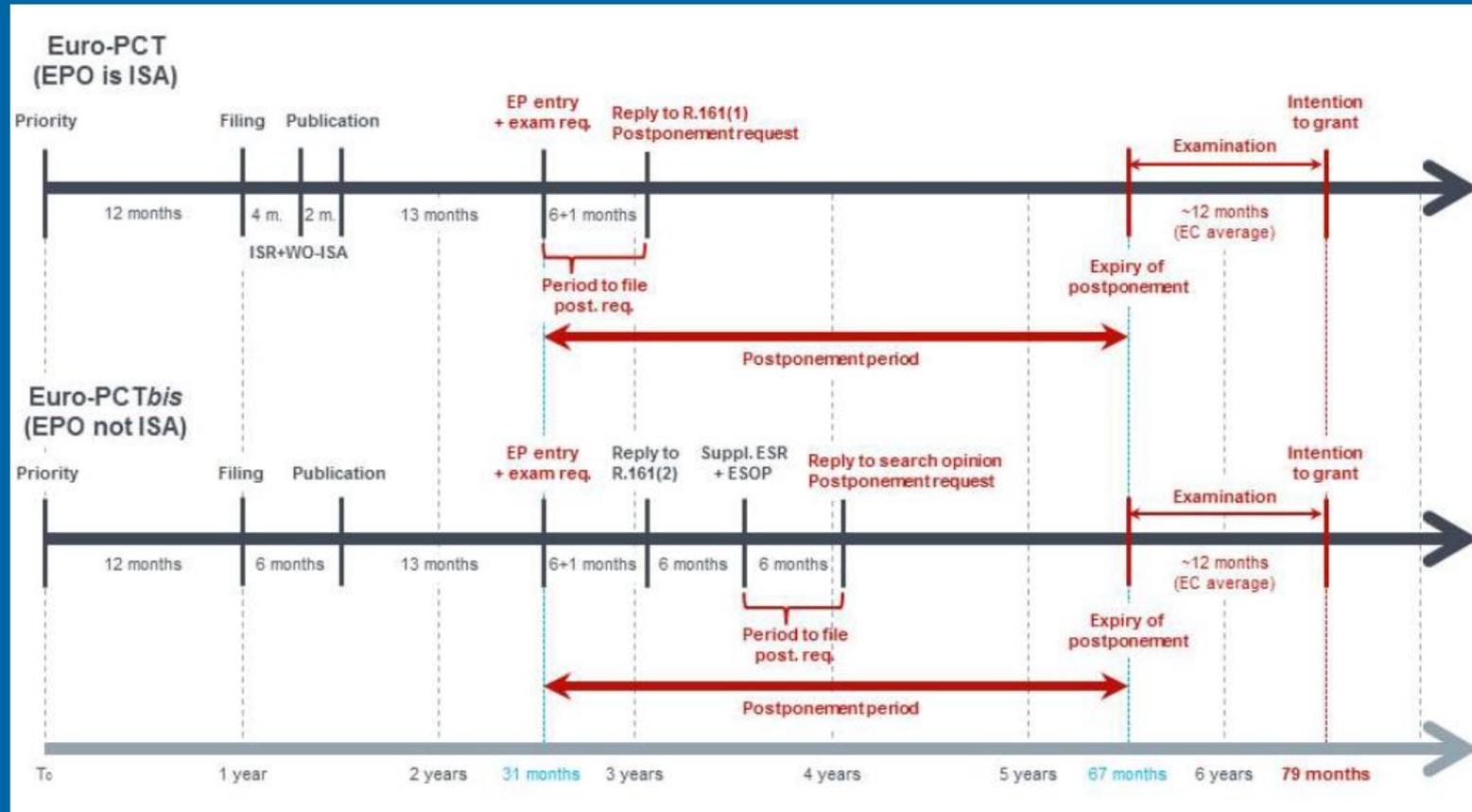
## 2. EPO – B) PROCEEDINGS



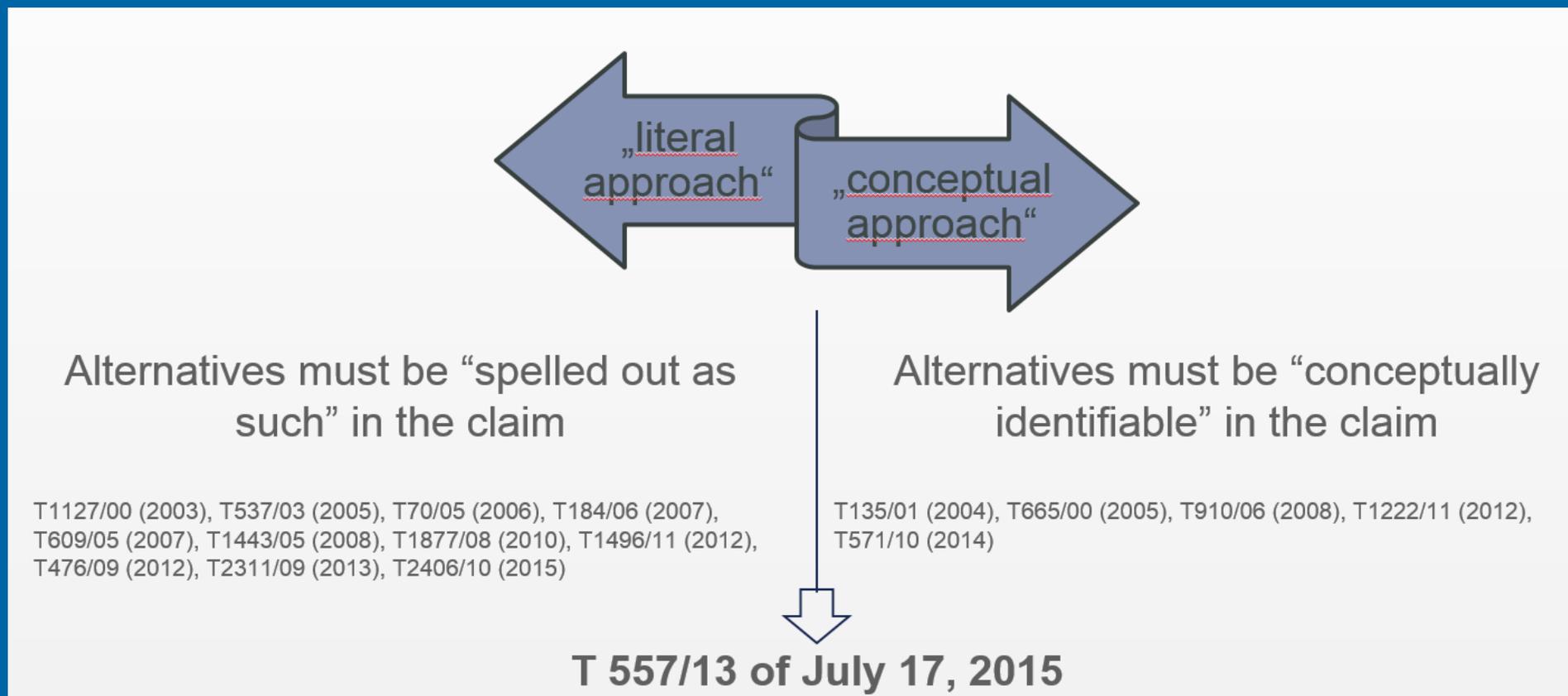
## 2. EPO – B) PROCEEDINGS



# 2. EPO – B) PROCEEDINGS

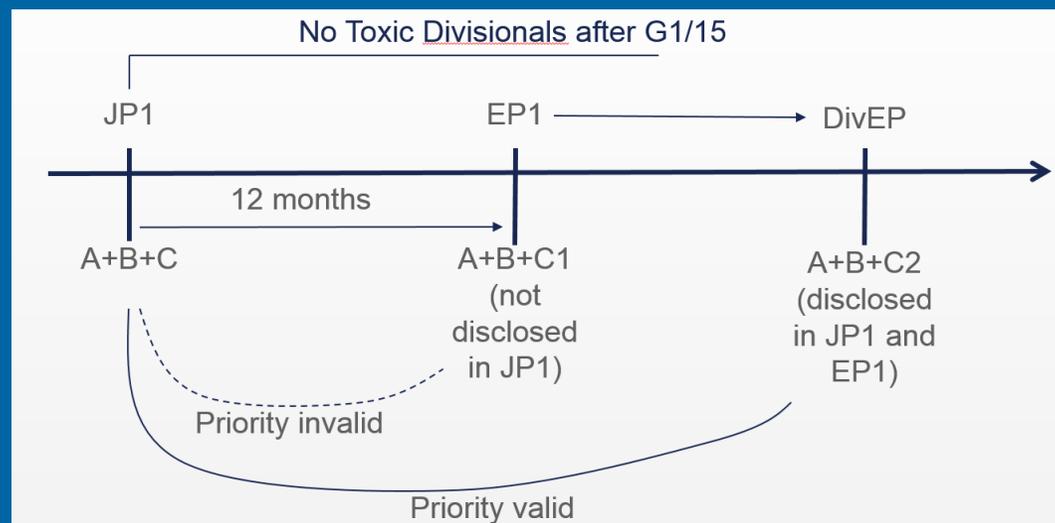


## 2. EPO – C) PRIORITY

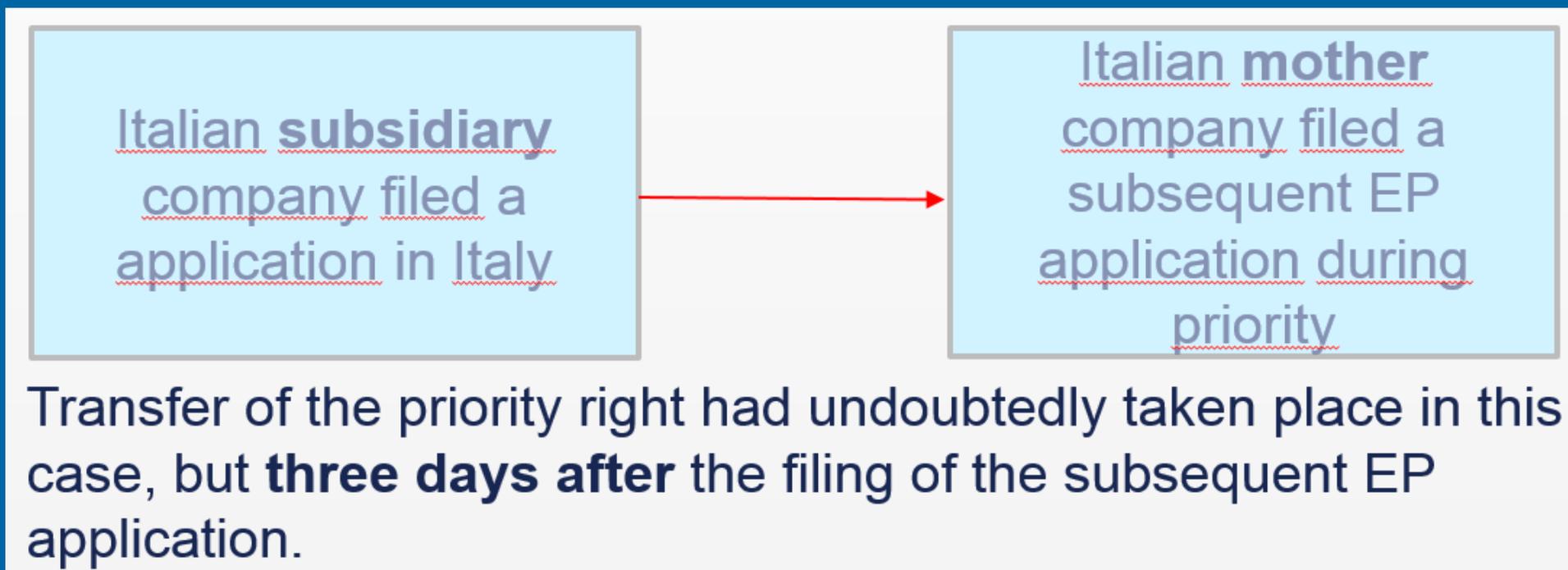


## 2. EPO – C) PRIORITY

*G1/15: “Under the EPC, entitlement to **partial priority** may **not be refused** for a claim encompassing alternative subject-matter by virtue of one or more **generic expressions** or otherwise (generic “OR”-claim) provided that said **alternative subject-matter** has been disclosed for the first time, directly, or at least implicitly, **unambiguously** and in an **enabling manner** in the **priority document**. No other substantive conditions or limitations apply in this respect.”*



## 2. EPO – C) PRIORITY



T 577/11: “A **succession in title** that occurs **after** the **filing date** of the subsequent application is **not sufficient** to comply with the requirements of Article 87(1) EPC.”

## 2. EPO – C) PRIORITY

- **EP 2 771 468 (currently in appeal):**

- An EPO requirement for a valid priority claim is that all applicants (or successors in title) of the first application are listed as applicants in the subsequent application (T788/05 r.2, Guidelines A III 6.1). EPO case law is consistent in the interpretation of "any person" in A 87(1) EPC (PC Article 4 also uses "any person"), i.e. "any person" means "all applicants" and not "any applicant".
- The proprietor argued that no assignment for one inventor was needed as the priority document disclosed more than one invention and since said inventor did not contribute to the subject-matter to which the subsequent application is directed, he thus has no rights to assign. However, consistent with EPO case law the Opposition Division found the priority claim to P1 invalid.
- Ensure that all applicants of the first filing (or their successors in title) are named in the application claiming priority. A first filing (e.g. US provisional) disclosing multiple inventions might have different applicant/inventors for each invention, but in that case excluding any of these applicant/inventors from a later application before the EPO which claims priority from the earlier filing risks invalidating the priority claim.



## 2. EPO – D) DISCLAIMER

- A. Disclaimers disclosed as such in the original application
- B. „Disclosed“ disclaimers: disclaiming subject-matter / feature(s) which are positively disclosed in the original application => G 2/10
- C. „Undisclosed“ disclaimers: disclaiming subject-matter / features which are not disclosed in the original application => G 1/16



## 2. EPO – D) DISCLAIMER

- G 1/16:
    - For the purpose of considering whether a claim amended by the introduction of an undisclosed disclaimer is allowable under Article 123(2) EPC, the disclaimer must fulfil one of the criteria set out in point 2.1 of the order of decision G 1/03.
    - The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. The disclaimer may not remove more than necessary either to restore novelty or to disclaim subject-matter excluded from patentability for nontechnical reasons.
- The „gold standard“ as defined in G 2/10 remains the relevant disclosure test for assessing the allowability of a claim amendment by the introduction of a disclosed disclaimer.

The principles for allowability of „undisclosed disclaimers“ of G 1/03 are upheld with the clarification that such a disclaimer may not qualitatively change the original teaching of the application.



# 3. GERMANY

- In trademark opposition proceedings a first extension of time (normally 2 months) will be given only if sufficient grounds are given. For further extension of time legitimate interest has to be shown AND the accordancy of the other party established by prima facie evidence
- PPH between the GPTO and SIPO is continued
- Usage of trademark names in meta-search-text has been referred back to Higher Regional Court Munich (OLG), as no determination was made how the internet-user understands the hit list (I ZR 138/16), however in a comparable case (I ZR 201/16) same usage has been banned by the Federal Court Court of Justice (BGH)
- Chinese FRAND-decision is harmonized with German View
- Hot-Sox "(judgment of 19/11/2015 - I ZR 109/14)," RESCUE-Tropfen "(decision of 29.09.2016 - I ZB 34/15) and" air-dehumidifier "(Urt 04.05.2017 - I ZR 208/15) are both from the literature and courts of appeal much criticized decisions in which the BGH clarifies the competition law, that a cease and desist also includes the recall of the already delivered products. In the recent decision "Products for Wound Care" (resolution of 11.10.2017 - I ZB 96/16), the BGH extends the scope of the custody obligation to intellectual property law



## 4. UK

- The UK Intellectual Property Office introduced a new fee structure on 6 April
- Excess claims fee
  - £20 for each claim over 25
- Excess page fee
  - £10 for each page over 35
- Grant fee
  - Will balance any excess claim/page fees not paid earlier
- Application fee rising from £20 to £60
  - With a 25% surcharge if not paid on filing



## 4. UK

- Search fee increasing
  - Direct from £130 to £150
  - PCT(NP) from £100 to £120
- Exam fee increasing from £80 to £100
- Renewal fees increasing for years 12 to 20
  - E.g. Year 12 from £210 to £220
  - E.g. Year 20 from £600 to £610
- Fee increases to offset rising costs and much greater demand
- Also element of improving applicant behavior (claim fees)



## 5. DK

- **European patent attorneys receive legal privilege before the Danish courts**
- A proposition to amend the Administration of Justice Act passed in the Danish parliament (Folketinget) on 17 May 2018. The proposition introduces a legal privilege for European patent attorneys before the Danish courts.
- European patent attorneys have been included in the act alongside lawyers so the legal privilege for European patent attorneys is identical or very similar to that of lawyers. Notably, there is no requirement of the nationality of the European patent attorney in order to benefit from the legal privilege.
- The amended act enters into force on 1 July 2018, and the legal privilege is retroactive. So, from this date, a European patent attorney may, as the general rule, not be called as a witness before the Danish courts, and his or her written advice may not be used as evidence.
- The amended act was passed in parliament unanimously, which reflects the unconditional support gained by the proposal from all political parties in the parliament.



# UNITED STATES

R. Danny Huntington



# PROVISIONAL PATENT APPLICATIONS AS PRIOR ART IN PRE-AIA APPLICATIONS

Guidance to examiners issued at the beginning of April relating to the date a reference is entitled to under pre-AIA 35 U.S.C. § 102(e) of a U.S. patent or U.S. published application claiming the benefit of a prior U.S. provisional application during examination of an application.<sup>1</sup>

- The U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) had already decided that for a U.S. patent that claims benefit of a prior U.S. provisional application, the critical reference date under pre-AIA 35 U.S.C. § 102(e) of the patent may be the filing date of the provisional application **only if at least one of the claims in the patent is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph.** *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015).

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<sup>1</sup>[https://www.uspto.gov/sites/default/files/documents/dynamic\\_memo\\_05apr2018.pdf](https://www.uspto.gov/sites/default/files/documents/dynamic_memo_05apr2018.pdf)



# PROVISIONAL PATENT APPLICATIONS AS PRIOR ART IN PRE-AIA APPLICATIONS

- The (Federal Circuit) recently extended this principle to published patent applications that have a prior art effect under pre-AIA 35 U.S.C. § 102(e). See *Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).
- Thus, the critical reference date under pre-AIA 35 U.S.C. § 102(e) of a U.S. patent, a U.S. patent application publication, as well as an international application publication having prior art effect under pre-AIA 35 U.S.C. § 102(e), may be the filing date of a relied upon provisional application **only if at least one of the claims** in the reference patent, patent application publication, or international application publication **is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph**.
- Consistent with prior guidance, the provisional application must also describe the subject matter relied upon in the patent, patent application publication, or international application publication to make the rejection.



# PROVISIONAL PATENT APPLICATIONS AS PRIOR ART IN PRE-AIA APPLICATIONS

- So it is important when you are preparing or amending the claims in a pre-AIA patent, patent application publication, or international application publication that you make certain you have at least one claim that is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph.
- Note that this only applies to applications being examined as pre-AIA applications. For first-inventor-to-file applications under the AIA, such prior art is effective under 35 U.S.C. 102(a)(2) as of its date of filing regardless of what the claims are.



# INTER PARTES PROCEEDINGS AT THE USPTO

- As a result of the recent decision in *SAS Institute Inc. v. Iancu*, 2018 WL 1914661, (U.S. Apr. 24, 2018) by the United States Supreme Court, the Patent Trial and Appeal Board (“PTAB”):
  - Only needs to find that a single claim may not be patentable to institute a proceeding.
  - If a proceeding is instituted, will decide patentability of all challenged claims.
  - As a result of the decision, approximately half of all pending proceedings needed to be modified.
- Guidance from the USPTO can be found at -  
[https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_the\\_impact\\_of\\_sas\\_on\\_aia\\_trial\\_proceedings\\_%20%28april\\_26%2C\\_2018%29.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_the_impact_of_sas_on_aia_trial_proceedings_%20%28april_26%2C_2018%29.pdf)



# INTER PARTES PROCEEDINGS AT THE USPTO

- The USPTO has proposed to change the claim construction standard used in America Invents Act (AIA) inter partes review, post grant review, and covered business method patent proceedings:
  - Currently “broadest reasonable interpretation”.
  - New standard would be the narrower one used by federal courts and the U.S. International Trade Commission (“ITC”) - to construe unexpired and proposed claims “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.”
  - Proposed rule would also specify that they will consider prior claim construction determinations made by federal courts or the ITC that are entered into the record.
  - Would make the USPTO an alternative to litigation rather than being more likely to find claims unpatentable.
  - <https://www.federalregister.gov/documents/2018/05/09/2018-09821/changes-to-the-claim-construction-standard-for-interpreting-claims-in-trial-proceedings-before-the>



# INTER PARTES PROCEEDINGS AT THE USPTO

- New guidance regarding motions to amend in proceeding before the PTAB -  
<https://content.govdelivery.com/accounts/USPTO/bulletins/1f442f5> -  
(Paper No. 13, April 25, 2018, WESTERN DIGITAL CORPORATION v. SPEX TECHNOLOGIES, INC., IPR2018-00082 and IPR2018-00084)



# CANADA



# PROPOSALS

- Proposed amendments to Canada's *Trademarks Act* would allow Canada to accede to the Singapore Treaty, the Madrid Protocol and the Nice Agreement. The Canadian Government asserts "this will modernize the trademark regime and enable Canada to keep pace with leading international standards and benchmarks. A second objective is to modernize Canada's trademark regime by updating, clarifying, codifying and improving aspects of the regulatory framework. Together, these objectives will better serve clients, lower costs and improve the ease of doing business."
- Proposed amendments to Canada's *Patent Rules* to provide applicants more flexibility in filings and to join the Patent Law Treaty. However, the amendments reduce the national phase entry deadline from 42 months to 30 months from the priority date. They also shorten prosecution deadlines.
- Proposed amendments to Canada's *Industrial Designs Regulations* to allow Canada to join the Hague Agreement. The proposed Regulations provide applicants more flexibility in their industrial design filing strategy, but are not expected to come into force before early 2019.



# THANK YOU!

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EN PROPRIÉTÉ INTELLECTUELLE

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VON PATENTANWÄLTEN