



Report Q228

Patents

Names and Functions of Committee Members

Chair	Ralph Nack	(Germany)
Co-Chair	Allain Gallochat	(France)
Secretary	tbd	
Members	David Tadgell Beat Rauber Jonas Westerberg Andrew Meunier Gaye Ramazanoglu Lamberto Liuzzo Koen Bijvank Maria del Carmen Arana Martin Bensadón Tatjana Kukshina Rogelio C. Nicandro João Luis Vianna Takashi Fujita Yusuke Inui Sascha Salomonowitz Patricia Koch Sabine Agé Marc Richards Karsten Koeniger	(Australia) (Switzerland) (Sweden) (USA) (Turkey) (Italy) (Netherlands) (Peru) (Argentina) (Ukraine) (Philippines) (Brazil) (Japan) (Japan) (Austria) (Spain) (France) (United States) (Germany)
Responsible Reporter	John Osha	(United States)

1. **Annual Report of Special Committee Q228 “Patents”**
by Ralph Nack (Germany)

2. **Summary:**

2.1. Based on a survey sent to the national and regional groups of AIPPI, the Committee has prepared a draft AIPPI Resolution on the question of “prior user rights” which will be voted on at the Toronto Congress.

- 2.2. The Committee will continue to establish an interesting series of patent-related questions for AIPPI in the next years, in particular related to the scope of patentability (abstract ideas exception), patent monetization, patent-based financing solutions, and availability of injunctive relieve.

3. Introduction

A prior user right is the right of a third party to continue the use of an invention where that use began before a patent application was filed for the same invention.

The issue of prior user rights has been touched upon the prior work of APPI such as in

- Q75, Prior disclosure and prior use of the invention by the inventor (Buenos Aires Congress of 1980, Moscow ExCo of 1982),
- Q89D, Prior Use (Amsterdam ExCo of 1989),
- Q170, Substantive Patent Law Treaty (Lucerne ExCo of 2003) and in
- Q233, Grace period for patents (Helsinki ExCo of 2013).

During the second meeting of the “Tegernsee Group,” attended by heads of offices and representatives from Denmark, France, Germany, Japan, the UK, the USA and the EPO in April, 2011, prior user rights was one of four topics identified as being key to harmonization (along with the grace period, 18-month publication, and the treatment of conflicting applications).

In view of the importance of the prior user rights issue, the Committee has undertaken a study process to research this issue and to lay the proper foundation for debate and possible passage of a resolution at the Toronto Congress in 2014.

4. Report of Committee’s activities

- 4.1 The Committee prepared a detailed questionnaire to study the question of “prior user rights”. This questionnaire was distributed to all national and regional groups in February of 2014, requesting responses by the end of April.
- 4.2 32 national groups responded (in alphabetical order): Argentina, Australia, Austria, Belarus, Belgium, Brazil, Canada, China, Denmark, Egypt, France, Greece, Hungary, India, Indonesia, Italy, Japan, Mexico, the Netherlands, Peru, Philippines, Poland, Portugal, Romania, South Africa, Spain, Sri Lanka, Sweden, Switzerland, Turkey, the United Kingdom (UK) and the United States of America (USA). All responses are published on the AIPPI website.
- 4.3 Based on these national group reports, the Committee prepared a Summary Report. The Summary Report was approved by the Reporter General Team and is published on the AIPPI website. Finally, the Committee prepared a draft AIPPI Resolution which will be circulated with the national and regional groups and voted on at the Toronto Congress.

5. Recommendations

- 5.1 The Committee recommends to adopt its draft resolution for the reasons explained in the Summary Report and the draft resolution itself.
- 5.2 The Committee recommends to continue its work on patent-related questions which are subject to ongoing, controversial debate and on which AIPPI should take a position, in particular:

- scope of patentability (abstract ideas exception vs. “technological invention” requirement)
- patent monetization trends
- patent-based financing solutions
- availability of injunctive relieve.

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