

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Outreach: International update

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November 18, 2021

Patent Public Advisory Committee quarterly meeting

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Overview

- Recap of WIPO assemblies
- ID5 annual meeting
- International legal updates
- Update on legalizations of documents to support foreign patent filing

# WIPO leadership and assemblies

- Daren Tang assumed his functions as WIPO Director General (DG) on October 1, 2020.
- The Assemblies of the Member States of WIPO: Sixty-Second Series of Meetings took place October 4 to 8, 2021.

# WIPO Strategic Plan 2022-2026

- Vision

- “A world where innovation and creativity from anywhere are supported by intellectual property, for the good of everyone.”

- Mission

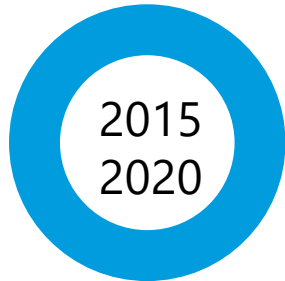
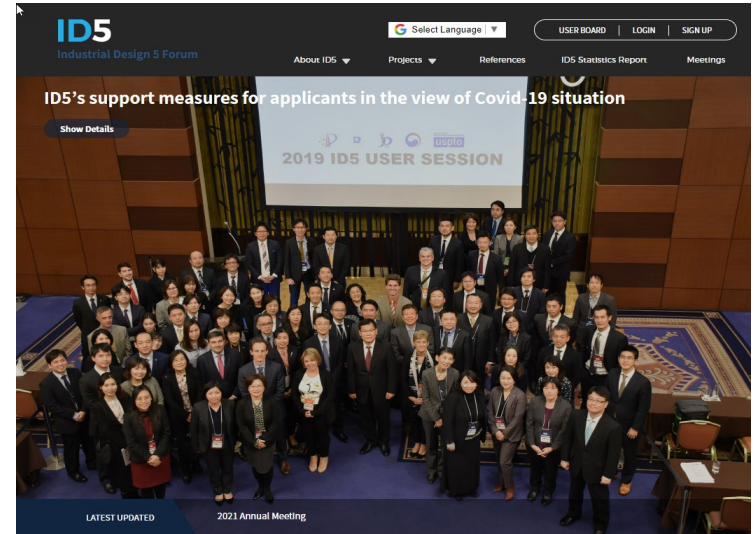
- “WIPO leads the development of a balanced and effective global intellectual property ecosystem to promote innovation and creativity for a better and more sustainable future.”

# Notable outcomes of assemblies

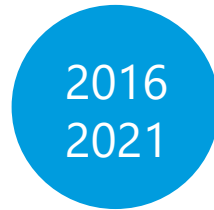
- The Patent Cooperation Treaty (PCT) Union, the Hague Union, and the Madrid Union agreed to amend their rules.
- The Assembly of the PCT Union approved a draft agreement between the Eurasian Patent Organization and the International Bureau and appointed the Eurasian Patent Office as an International Searching Authority and International Preliminary Examining Authority.
- The General Assembly approved the new implementation date of WIPO Standard ST.26 of July 1, 2022, at national, regional, and international levels.
- The General Assembly renewed the mandate of the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge, and Folklore (IGC).
- The General Assembly decided that at its next session, it will continue to consider whether to convene a diplomatic conference on the Design Law Treaty (DLT).

# ID5 Annual Meeting

- Industrial Design forum launched in 2015 at the USPTO



USPTO



CNIPA



EUIPO



KIPO



JPO

**Virtually | November 1-2**

Website: <http://id-five.org/>



# ID5 annual meeting

- Studies and analysis of design protections related to grace period, partial designs, and new and emerging technologies.
  - Since 2015, 4 of 5 partner offices have achieved a 12 month grace period for designs.
  - All 5 partners now provide protections for less than the whole product and practices continue to evolve.
  - All 5 partners provide protections in digital environments and practices are changing.
    - Divergences in interplay between design and articles/products and in associated requirements.
    - Divergences in file formats.
- All five offices implemented WIPO DAS.
- ID5 joint recommendation on design formality practices.





# ID5 annual meeting

- Highlighted USPTO-led projects:
  - Remedies and Relief for Industrial Design Infringement
  - Term of Protection
  - Deferment of Publication\*
  - 5 Year Review

\* *Designates co-lead on project with KIPO*



# Legal updates - Brazil

- Removal of Brazil's "Prior Consent" regime
  - "Prior consent" mandated Brazil's regulatory authority to review all pharmaceutical patents before examination could begin at Brazil's IP office.
  - Removal of this requirement addresses a long-standing concern for USG and industry.
- Compulsory licensing reform law

# Legal updates - China

- Fourth Amendment to the Chinese patent law (Effective June 1, 2021)
  - Pharma-related patents
    - Introduces an early dispute resolution system for pharma-related patents
    - Patentee can initiate infringement actions against generics/biosimilars at court or CNIPA
    - Establishes a drug patent registration platform at the NMPA (National Medical Products Administration)
  - Patent term compensation for patent office and regulatory approval delays
  - Design patents
    - Allows protection of partial designs
    - Lengthens term of protect from 10 years to 15 years
  - Damages for infringement
    - Increases statutory damages (from RMB 10,000-1,000,000 to RMB 30,000-5,000,000)(approximately \$1500 - \$150,000 to \$4500 - \$750,000) - provides for punitive damages, up to five times the damages determined
    - Shifts the burden of proving damages in patent infringement actions if infringer fails to cooperate in providing certain evidence



# Legal updates - Germany

- Reformed patent injunction law
  - Effective August 18, 2021
  - Injunctions no longer automatic
  - The party sought to be enjoined may now move the court to deny the injunction on the grounds that an injunction would cause them a disproportionate level of harm. If the court agrees, it can limit its decision to monetary compensation for the infringement of the patent, with the potential for damages on top.

# Legal updates - Japan

- Amicus brief system
  - Will allow third parties to submit amicus briefs in patent infringement litigations
  - Amendment will be effective April 1, 2022
- Revisions to the Patent Act concerning digitization procedures and other enhancements to the IP system amid the pandemic
  - Amendments will be effective April 1, 2022



# Thank you!

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