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MEETING : EXCO Meeting in Amsterdam, The Netherlands

MEETING DATE : June 3-6, 2007

DRAWN UP BY : Bill Edgar, Reporter of Workshop 1

SUBJECT : Prior User's Rights

PURPOSE: For information

TABLED TO: All attendees

<b>WORKSHOP 1</b>		<b>Prior User's Rights</b>
1 FA	<b>Chair</b>	<b>Francis Ahner</b>
1 CA	<b>Reporter</b>	<b>Bill Edgar</b>
1 AU	<b>Peter</b>	<b>Huntsman</b>
1 BR	<b>Ivan</b>	<b>Ahlert</b>
1 BR	<b>Gustavo</b>	<b>Barbosa</b>
1 CA	<b>Robert</b>	<b>Katz</b>
1 CN	<b>GE</b>	<b>Bo</b>
1 CZ	<b>Michal</b>	<b>Guttman</b>
1 ES	<b>Marcelino</b>	<b>Curell-Suñol</b>
1 FI	<b>Klaus</b>	<b>Roitto</b>
1 FR	<b>Jean-Jacques</b>	<b>Joly</b>
1 GB	<b>Simon</b>	<b>Rees</b>
1 GB	<b>David</b>	<b>Bannerman</b>
1 GR	<b>Constantinos</b>	<b>Kilimiris</b>
1 JP	<b>Ichio</b>	<b>Shamoto</b>
1 JP	<b>Kazuaki</b>	<b>Takami</b>
1 KR	<b>Jang Won</b>	<b>Park</b>
1 MX	<b>José Antonio</b>	<b>Miranda</b>
1 NL	<b>Hendrik Jan</b>	<b>Brookhuis</b>
1 NO	<b>Jon</b>	<b>Heggstad</b>
1 NO	<b>Arild</b>	<b>Tofting</b>
1 PT	<b>Cesar</b>	<b>Bessa Monteiro</b>
1 SE	<b>Jan</b>	<b>Modin</b>
1 US	<b>Danny</b>	<b>Huntington</b>
1 US	<b>Charles</b>	<b>Elderkin</b>
1 US	<b>Mike</b>	<b>Kirk</b>
1 ZA	<b>Willem (At)</b>	<b>van Rooy</b>
	<b>Total</b>	<b>27</b>



## Report on Workshop 1 - Prior User Rights

The workshop was attended by people from a broad range of countries.

The Chair opened the discussion with a brief review of the issues which arise in a consideration of prior user rights (PUR).

Those which were touched upon include:

- (1) How is a PUR obtained? What level of activity is required to give rise to a PUR?
- (2) What is the meaning of "good faith", and how is it applied to a real life situation?
- (3) What is the extent of the right?
- (4) Can the right be extended from the original activity?
- (5) What is the territorial scope of the PUR?
- (6) What is the meaning of grace period?
- (7) Does the existence of a grace period have any impact on PUR?
- (8) Does a PUR (or intervening right) arise where the person claiming the right obtained the invention from a disclosure which gave rise to a grace period?
- (9) In what situations do intervening rights arise?...and hence all the questions arising relative to PUR also arise relative to intervening rights.

The discussion was lively and interesting, but was much in the nature of informational material, and there was little consensus, or, indeed, seeking of consensus, on any of these issues.

The general nature of the discussion was of two types. First, many participants supplied information as to how PUR arise in their countries, and referred to the manner in which one or more of the issues noted above would be addressed in those countries. A few members advocated the adoption of their national practices.

Second, a number of participants referred to the theoretical, philosophical or political bases for PUR. It is significant that no conclusions were offered on these matters, but were raised as matters which must be considered.

In the course of discussion, reference was made to an earlier FICPI resolution, and to PLT Article 20 and Community Patent Regulation 12. The last two provisions did not find acceptance among participants.

It was evident that national regimes differ greatly, ranging from actual use as a requirement for creation of a PUR, even then giving rise to a very restricted PUR (Brazil); to others where an extensive PUR may be obtained without actual use but based primarily on level of investment, considering what is fair and reasonable in the circumstances (Norway). In between are wide variations on all of the issues in the list.



It became evident in the course of discussion that much more detailed study was required regarding the philosophical, public policy and political considerations forming the bases for PUR; and in respect of each of the specific issues. Only after such a study can the tension be resolved between a user in secret who shuns the patent system to the disadvantage of society and the inventor who wishes to participate fully in the patent system, to the general advantage of society. Where does the balance lie, and how can the balance be achieved in practice.

The Chair concluded that the discussion could not profitably progress without such study and thus proposed that the subject be broken into its component parts for that purpose. It was proposed that a survey questionnaire be prepared to consult FICPI members as to law and practice in their countries.

A resolution was proposed and presented in draft form to extend FICPI's position on grace period to affirm that PUR ought not to be defeated by a grace period.

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