

FICPI Position on Prior User Rights

Intervention at SCP/33, 6 to 9 December 2021

FICPI has generally supported the concept of Prior User Rights (PUR) as an essential element of a patent system based on a first-to-file or first-inventor-to-file system. We have studied this issue in connection with other questions, especially in connection with a novelty grace period for patents. A PUR is often considered to be a necessary complement to a novelty Grace Period (GP)¹.

- FICPI emphasizes that any patent system must provide a fair balance between the rights of patent owners and third parties.
- Also, it is generally agreed that innovators should not be forced to use the patent system in order to allow them to use what they have started to do legitimately.
- Further, it is considered fair that a commercial enterprise that has made investments in an innovation of a new technology, should be allowed to pursue its efforts, and that it should have a right to carry on with its business, based on its innovation, irrespective of the subsequent activities of third parties who may file patent applications at a later stage.

Kindly allow us to finalize this intervention by three conclusions.

- FICPI considers PURs - the right to continue exploiting an invention after having started exploitation without infringing any patents held by others - to constitute an essential element of any patent system based on the first-to-file or first-inventor-to-file principle. This is especially important in case the patent system includes an effective GP provision of the “safety net” type. In such a system, the existence of PUR will provide a proper balance.
- However, the PUR should be limited to preserve the balance by providing conditions for the prior user. Primarily, PUR should be acknowledged for independently created inventions. On certain conditions, however, even derived knowledge may form the basis of a right to start and continue the use of an innovation for which another party subsequently files a patent application, but the prior user may not exploit the invention on the basis of non-public information, derived from another party, without the consent of the latter party.
- A party claiming PUR has the burden of proof regarding its prior activities to justify a continued exploitation, within a territory being geographically limited to the particular jurisdiction where the activity took place.
- If prior user rights are available in the territory concerned, then these should also be available to persons who have become aware legitimately of an invention as a result of a disclosure excused by such a grace period.

¹ (1) Resolution of the Executive Committee, Amsterdam, Netherlands, 3 to 6 June 2007; (2) FICPI Position on Prior User Rights, 2015; (3) FICPI Position on Patent Law Harmonization, 2018



Encls.

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Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including Europe, China, Japan, South Korea and USA.

FICPI aims to study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security, and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI** strives to offer well balanced opinions on proposed international, regional and national legislation based on its member' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.