

The Patent Dossier

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Filing for and getting a US patent on an invention was easier - but riskier - before the *Movement*...

The Movement - a global effort to coordinate the various national patent systems - started in 1883. It then went dormant during the two world wars. Yet it somehow survived to blossom in the latter half of the 20th Century. In the first two decades of the 21st Century, the Movement seemed at first to have lost steam, but the force behind the Movement could not be stopped, as the rising tide of innovation spread to all major countries.

Beginning in 1883, international treaties removed impediments to obtaining patents in other countries. In that year, the first such treaty -- The Paris Convention -- was signed. Stimulus for this treaty arose from the global industrialization then underway in the world. At international exhibitions, new products were featured to show progress in the useful arts and sciences. However, an exhibitor who did not have patent applications already filed outside its own country would be unable to file them after publicly exhibiting a new invention.

The Paris Convention gave inventors one year after filing that first patent application in any of the "Paris Convention" countries to file the same patent application in any other Convention country without losing the inventors first priority date. That one-year grace period gave inventors a chance to test the market before committing the time and resources to expand their patent position into other markets in other countries.

Subsequent treaties extended the time for inventors to assess the business case for filing patent applications in other countries. The Patent Cooperation Treaty in 1970, for example, established an international entity that receives and examines patent applications, and issues an opinion on whether the invention claimed is useful, novel, and constitutes an "inventive step" over the prior art but cannot grant a "worldwide patent." Nonetheless, as important as the review and opinion is to the inventors, more importantly, the Patent Cooperation Treaty further adds 18 months to the delay between first filing and subsequent applications.

Now the “Patent Dossier” is the current major phase of this Movement that began almost 150 years ago, a globalization movement to a coordinated global patent system.

The term “globalization” is widely used but its meaning is unclear. The Oxford Universal Dictionary (OED) defines globalization as “the act of globalizing.” (Well, one must start somewhere.) The term itself was first used, according to the OED, in 1959 in the publication *The Economist*, from which we can infer that its meaning is associated with “economics.” The OED then characterizes the Globalization as “a unification of information, of processes, rules, behaviors” to provide another word for contrast: “[b]etween globalization and isolation there exists extensive middle ground.” Could this be British humor? The Patent Dossier certainly represents a unification of sources of information. The direction of it *implies* a future unification of patent processes, rules and behaviors.

The US Patent Office characterizes the Dossier as “a set of business services that provides IP [Intellectual Property] stakeholders free, secure, one-stop access to the dossier information of all [patent] related applications that have been filed in participating IP offices. It represents a significant move [the Movement continues!] towards “technical harmonization” [my quotation marks] by enabling the exchange of patent information between foreign patent offices, patent examiners, and the public worldwide.” The phrase “Business services” is undefined but appears to be services available to anyone.

“Dossier” seems both literal and international in this context.

The word “dossier” originally referred to a folder with words written on the cover to indicate its contents. If you read spy novels, you will be familiar with the tantalizing aspects of this word – “dossier” is not applied to your mom’s recipe file, but to information involving intrigue. The term Dossier in its original meaning is on target.

Making prosecution histories for patents available is a large undertaking notwithstanding the pre-existence of such records in individual country patent offices, where patent applications are filed originally. Providing machine translations and patent drawings on an easily-navigable, digital platform is miraculous.

The importance of the Patent Dossier may not be readily apparent to many. Businesses who depend on exclusive rights to their technology in a competitive world understand the value of patents depends on whether they are valid and enforceable. A better tool for finding prior art relevant to a patent application is essential to assessing validity and enforceability.

The Patent Dossier improves the ability of applicants and examiners (and opposing counsel) to find better prior art, and to find it more quickly and easily as the application is being prepared, examined, and enforced. Having a firm grasp of all relevant prior art reduces a patent owner’s uncertainty and increases patent value.

The Patent Dossier can improve patent quality, and thus increase confidence that an issued patent is more likely valid than not. The applicant today is better able to prepare patent claims, and an examiner has more and better prior art to limit the scope of the patent claims.

Abraham Lincoln, himself a patentee, is quoted as saying “the patent system adds the fuel of interest to the fires of genius.” The better the system for examining patent claims, the more likely those fires will be to find reward for the particular genius who invents in a world of over 120 million patents.

The Patent Dossier will not rival Angry Birds for family fun, but it will make examination of patent applications and the enforcement of patents more rigorous - and more efficient.

“[The Patent Dossier] represents a significant move towards technical harmonization...” The move toward “technical harmonization” on the issue of *patentability* is pregnant with implications the Movement is not stopping with the Patent Dossier but may continue with a convergence of the tests of patentability, the clarity of the written description of the invention, and the completeness of applications. The Globalization Movement continues.