

Patent Working Requirements

Historical and Comparative Perspectives

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- **Definition of Working Requirements**
- **History of Working Requirements**
- **Functions of Working Requirements**
- **Relationship of Working Requirements and Other Components of National Patent Systems**
- **Conclusions**

Definition of Working Requirements

- An owner of a patent must practice his or her patented invention (meaning manufacture or import the invention) within the country that granted the patent.
- The remedy (vis-à-vis society) and the sanction (vis-à-vis the patent owner) for non-working is either forfeiture or a compulsory license.
- National working requirements have differed throughout history.
- The United States had a working requirement only between 1832 and 1836, and only for foreigners.
- However, features in U.S. patent law exist that encourage patent working.

History of Working Requirements I

- **Early predecessors**
 - Old English patents
- **Protectionist period**
 - Benefit to local industry
 - In some countries patents were denied to foreigners
 - In some countries importation was insufficient to satisfy the requirement
 - In the United States in 1832 – 1836 there was a working requirement, but only for foreign patent owners

History of Working Requirements II

- **International negotiations**
 - 1883 Paris Convention
 - Working requirements were a matter of national law
 - No forfeiture for importation from one of the Paris Union countries into another
 - Revision Conferences
 - U.K. statutes from 1902 and 1907 were in reaction to the expansion of the German chemical industry
 - Germany concluded bilateral treaties with other nations, including with the United States
 - In the late 1970s and into the 1980s there was a proposal discussed that was submitted by the developing countries

History of Working Requirements III

- **Developments after the Convention Paris Revisions**
 - European Commission challenged the Italian (1989) and U.K. (1990) requirements – the 1992 ECJ decision
 - TRIPS Agreement
 - U.S.-Brazil WTO dispute

Functions of Working Requirements

- **Disclosure**
 - “Teaching” an invention v. a field of technology
 - Informational function
- **Protection of domestic industry**
 - Local production, building of infrastructure
 - Employment
- **Access**
 - Access to an invention
 - Protection against blocking monopolies
- **Strategic/national security considerations**
 - Preserving and/or developing a field of science or technology

Relationship of Working Requirements and Other Components of National Patent Systems I

- **Patentability**
 - Chemical inventions
 - Pharmaceutical inventions
- **Disclosure requirements**
 - Informational function through patent applications
 - Remnants of the requirements in disclosure requirements
- **Exhaustion doctrine**
 - Principle of national v. international exhaustion

Relationship of Working Requirements and Other Components of National Patent Systems II

- **Injunctive relief**
 - Court discretion to grant or deny injunctive relief v. the lack of discretion
- **Competition law**
 - Standard essential patents
 - “License of right”

Conclusions

- **Greater importance of the working requirement in some legal systems than in others**
- **Comparisons need to be performed at the functional level rather than word by word**
- **Problems that arise when international harmonization mandates specific provisions (rather than a general framework)**
- **To the extent that international law still permits working requirements, some countries may use working requirements to address issues that other countries may solve through other mechanisms**

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