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

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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
  - 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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