

# Summary of the 23rd Trilateral Conference

**Munich, 18 November 2005**

The European Patent Office (EPO), the Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the 23rd Trilateral Conference in Munich, Germany on 18 November 2005.

## The Trilateral Offices

- reconfirming their commitments to Trilateral co-operation based on common recognition of the role of industrial property as a basic system supporting the progress of industry, technology, and international social and economic growth,
- identifying timely processing of increased workloads of patent applications and high-quality examination processes as common concerns of the Trilateral Offices and its user communities,
- recognising the benefits of promoting reduction of processing times and avoiding duplication of work through a co-ordinated Trilateral approach, including exploitation of search and examination results,
- understanding the benefits of harmonising substantive patent law and standardisation of formal patent applications,
- recognising the benefits of developing common infrastructure and compatible data for electronic business systems and search tools in order to facilitate co-operative activities,

understand as follows:

## **Strategic Issues**

The Trilateral Offices recognise that exploitation of search and examination results is an important element in reducing workload and duplication of work among the Offices and note the need to identify new areas of strategic co-operation.

They accept the first recommendation of the Trilateral Strategic Working Group, namely to improve communication with users. In particular, taking into account the suggestions of Trilateral Industry, they have created a working group for the standardisation of formal aspects of patent applications.

## **Re-use of Work Results**

### **(a) Pilot Project on Exchange of Search History**

Progress has been made on the pilot project for the sharing of search history data. The first phase will be finalised next year. The Trilateral Offices will make further efforts towards improving exploitation of work results and enhancing mutual understanding through examiner exchange and technical projects such as harmonisation of classification, and look for ways to move forward on using each Office's search results, including search histories.

### **(b) Patent Prosecution Highway**

The Patent Prosecution Highway (PPH) is a JPO proposal aiming to utilise accelerated examination in each Office to ensure the timely obtaining of search and examination results so as to improve quality and promote the mutual exploitation of work results between patent offices.

The Trilateral Offices take a positive view of "The Outline of the Patent Prosecution Highway" proposal, noting that the PPH could enable participating offices to take advantage of work results provided by the Office of First Filing, if appropriate.

The USPTO and the JPO confirm that they plan to implement the PPH on a trial basis, provided all remaining issues and details are resolved. The EPO will present the PPH to its users and member states in a positive manner and explore the possibility of participating in a pilot project.

### **(c) Tri-Way Proposal**

The USPTO introduced a proposal for a "Patent Prosecution Tri-Way" based on the PPH for addressing outstanding issues of timing and correspondence of applications. The Trilateral Offices confirm that the Tri-Way proposal will be considered in parallel with the PPH, and the JPO and the EPO will provide the USPTO with written comments on the new Tri-Way proposal.

### **(d) Import Guidelines**

The Trilateral Offices confirm that the proposed Import Guidelines as annexed to the Memorandum of Understanding are ready to be adopted. The Trilateral Offices will continue to discuss the possibility that importation be expanded. The JPO indicated that approaches aiming to facilitate the satisfaction of IDS obligations should be considered. The EPO and the USPTO note this suggestion.

## **Trilateral Patent Examiner Exchange**

The Trilateral Offices will pursue the Trilateral patent examiner exchange programme. Four specific technical areas have been identified for the first exchange in 2006. Based on the experiences of the past year, the Trilateral Offices will agree on a methodology to prepare candidates. This methodology will take harmonisation of classification into account.

## **Electronic Access to Patent Application File Contents**

The Trilateral Offices are developing a system (Trilateral Document Access, "TDA") to enable electronic access to, and viewing of, patent application file contents in the Trilateral Offices as well as electronic exchange of priority documents. The Trilateral Offices will develop guidelines for providing the technical specifications for this system to non-Trilateral Offices and confirm that development of specifications will remain within the control of the Trilateral Offices.

## **Exchange of Priority Documents**

The EPO and the USPTO have signed an agreement on priority document exchange which is expected to take effect from April 2006. This agreement, which will result in considerable cost savings for patent applicants, covers the transfer, in electronic form using TDA, of certified copies of priority documents contained in the electronic files of the EPO and the USPTO. This exchange will not include priority documents claimed under the PCT. The JPO and USPTO are planning to sign a Memorandum of Agreement on priority document exchange in Autumn 2006. The EPO and JPO have been exchanging priority documents using other electronic media since 1999.

## **Biotechnology**

The report on "Application Filing Trends related to Biotechnology Applications" was presented, and it indicates that filing figures are now stable. The number of applications for 3D sequences remains at a low level. The Trilateral Offices confirm that they will continue to monitor the technical trends in the field.

Work is progressing on a Trilateral Search Guidebook in Biotechnology recording the resources and methods used by the three Offices. It is confirmed that the first version will be completed by May 2006.

The development of a new standard for submission of sequences in XML format is underway.

The Trilateral Offices agree to continue efforts to complete the sequence

databases and to avoid duplication.

### **Non-Patent Literature**

The Trilateral Offices are continuing to co-operate to improve the use of non-patent literature in prior art searching and exploitation of search results.

The possibility of extending current agreements with publishers in a way which would allow exchange of non-patent literature between Trilateral Offices in the context of a common Trilateral Office subscription will be explored.

The Trilateral Offices will explore the use of Digital Object Identifier (DOI) technology to access NPL documents.

### **Linguistic Tools**

The development of linguistic tools, particularly automated translation tools, is of key importance to further facilitate widespread access to the technical content of patent documents.

The Trilateral Offices acknowledge the efficiency of the Advanced Industrial Property Network (AIPN), which includes a translation system developed by the JPO. The EPO and JPO reported a growing usage of the system by their examiners. The Trilateral Offices are co-operating to further develop the system.

The rapid progress being made on the European Machine Translation Programme (EMTP) is noted. By the end of 2005, the first versions of the translation system (German/English and Spanish/English) will be available. Work on new language pairs will start in 2006.

### **Harmonisation of Classification**

The Trilateral Offices notes that harmonisation of the three Offices' classification systems will help to increase the efficiency and quality of examiners' work and exploitation of search results.

The Trilateral Offices are harmonising their classification systems step by step and will recommend that the amendments are introduced into the advanced level of the International Patent Classification (IPC).

The Trilateral Offices note that the exchange of examiners has contributed significantly to the harmonisation process.

As the new IPC (version 8) will enter into force 2006, the Trilateral Offices intend to co-operate in organising events to present the benefits of the IPC 8 to the public.

## **Information Dissemination Policies**

The Trilateral Offices will participate jointly at fairs or events organised in the three regions. The focus will be on presenting the results of Trilateral co-operation.

The launch of the Japanese interface of *esp@cenet*<sup>®</sup> is noted; it will provide easier access for Japanese-speaking users.

In response to the letter of the Trilateral Alliance of Intellectual Property Information Services Companies, the Trilateral Offices appreciate the efforts of private sector organisations that share and support their objective to achieve maximum dissemination of patent information. The Offices look forward to continuing their discussions and sharing ideas that will assist in improving intellectual property systems around the world.

## **PCT Minimum Documentation**

PCT minimum documentation is the documentation that International Search Authorities (ISA) under the PCT must consult when performing a prior art search. The Trilateral Offices will review the documentation and intend to harmonise their proposals in this respect for the next relevant WIPO meeting in December 2005.

## **Time of Publication**

Aiming at the resolution of difficulties arising from publication of documents constituting prior art in different time zones around the world, the Trilateral Offices confirm their intention to explore various concepts for the development of a harmonised approach in this area.

## **Legal Issues**

### **(a) New Route Proposal**

The Trilateral Offices confirm that they will pursue discussions on the JPO proposal for a New Route, which is intended to complement the currently available filing routes for the benefit of applicants worldwide. The Trilateral Offices will consult their users and consider the proposal further in the light of these consultations.

### **(b) Standardisation of Formal Aspects of Patent Applications/ Patent Law Treaty**

Building on the impetus provided by the Industry Trilateral and in response to the needs of users, the Trilateral Offices confirm that they will proceed with a

project on common patent application format and establish a working group for this purpose. In this regard, the Trilateral Offices recognise the importance of the Patent Law Treaty.

### **Exchange of Information regarding International Co-operation with Developing Countries**

The Trilateral Offices stress the importance of a continuous exchange of information regarding technical co-operation.

Co-ordination of activities will be initiated on a case-by-case basis, taking into consideration the various policies under which each Office operates.

One possible area of co-operation identified by the USPTO and the EPO is the administration and examination of patents in the SIPO.

### **New Trilateral Website**

The Trilateral Offices have established a new Trilateral website at [www.trilateral.net](http://www.trilateral.net).

## **Annex**

**Guidelines for viewing, printing and importing  
the file wrapper documents and information of  
other offices through the Dossier Access System**

Guidelines for viewing, printing and importing the file wrapper documents and  
information of other offices through the Dossier Access System

**(Applicable to Post-Publication Dossiers)**

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## **I. Introduction**

These guidelines define the rules that Trilateral Offices must observe when they view, print or import file wrapper documents or information<sup>1</sup> from other offices using the Dossier Access System for the purpose of performing tasks including search and examination.

These guidelines define the rules for importing documents from applications **that have been opened to the public**. For the applications that have not been opened to the public, the rules will be defined in a future document. Although a dossier has been made public due to publication or other reasons, certain documents contained in the dossier may remain closed to public view. Each office reserves the right to maintain documents as private<sup>2</sup>. An office may choose not to share private documents, or may choose to share them with limitations on their use, as described below.

These guidelines define general policies. When there are specific agreements between two offices, they precede the guidelines. It should be understood that these policies are a maximum of what may be imported, and that recipient TOs may impose on their employees additional restrictions concerning which documents from those available may be imported, and under what conditions.

## **II. Definition of terms**

### (1) Viewing

“Viewing” means to view Donor office’s file wrapper documents or other information relevant to an application retrieved through the Dossier Access System on a computer at the Recipient office.

### (2) Printing

“Printing” means to print Donor office’s file wrapper documents or other information relevant to an application retrieved through the Dossier Access System on a printer at the Recipient office.

### (3) Importing

“Importing” means to include documents or other information acquired from a Donor office through the Dossier Access System into an electronic or paper file

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<sup>1</sup> The information includes the bibliographic data, for example.

<sup>2</sup> for example because they contain financial information or are pre-decisional drafts

wrapper of the Recipient office.

(4) Donor office

“Donor office” indicates an office, which holds the file wrapper or other information that is viewed, printed and/or imported by a Recipient office.

(5) Recipient office

“Recipient office” indicates an office, which views, prints or imports file wrapper documents or other information from other offices.

### **III. Matters to be concerned with regard to “Viewing” and “Printing”**

Employees of Trilateral Offices agreeing with these Guidelines may view all the documents and information from Donor offices that can be accessed through the Dossier Access System. The viewable documents and information may be printed at the Recipient office. However, it must be cautioned that the viewable documents and information may include matter that has not been made open to the public and is limited to internal office use. As any viewed document is physically capable of being imported into a Recipient office’s file wrapper, the Recipient office must strictly enforce this policy in order to prevent documents and information that are limited to internal use from being wrongly made open to the public.

### **IV. Rules for Importing**

#### **(A) Documents and information which may be imported and must not be imported with respect to the applications that were made open to the public**

For documents and information that may be imported, the decision whether or not to import them is left to each Recipient office.

The imported documents and information, except those limited to internal use, may be made open to the public inspection after the application of the Recipient office is made open to the public<sup>3</sup>.

#### **1. Documents and information that may be imported from applications that have been made open to public**

##### **(1) Documents and information that may be imported**

Recipient offices may import the documents and information listed below in the original language (without translation) into the file wrapper of the Recipient office as long as the Donor office has not declared different treatment.<sup>4</sup>

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<sup>3</sup> These documents have already been made open to the public at the Donor offices

<sup>4</sup> For example, NPL or other copyrighted works may be restricted by policies of the Donor office from distribution.

- Ø Application As Filed (Request, Claims, Description, Drawings, etc)
- Ø List of cited references
- Ø References cited by an examiner
- Ø Search reports<sup>5</sup>

(2) Translations that may be imported

Translations of documents that may be imported as described in (1) above may be imported if the following requirements are satisfied.

- (a) Translations must be imported simultaneously with the original documents.
- (b) The type of translation (machine translation or manual translation) must be indicated.
- (c) If it is a machine translation, detailed information, such as the date on which the machine translation was made, version of the translation software and translation software settings must be provided.
- (d) If it is a manual translation, the information relevant to its translator (the name of the translation company or translator) must be provided.

**2. Documents and information that must not be imported**

Documents and information other than those described above in Section 1. (1) and (2) must not be imported.<sup>6</sup>

**(B) Other rules with regard to importing**

When a document or information is imported, the origin of the imported document or other information must be documented in the files at the Recipient office<sup>7</sup>.

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<sup>5</sup> Search reports are defined as documents similar to search reports used in the PCT, where the references are cited, and applied to specific claims. Arguments such as appear in USPTO office actions or EPO Reasons for Refusal are not included in this definition. For documents from the USPTO, the lists of cited documents (e.g. form 892 or SB-8) would suffice without the office action that contains such arguments.

<sup>6</sup> The Trilateral Offices will continue to discuss the possibility of allowing the importation of office actions (including Japanese Kyozeitsu Riyu Tsuchi) and the issue of prosecution history estoppel.

<sup>7</sup> Imported documents become part of the application file of the Recipient office, as they are relied upon in that office as relevant to the prosecution. They are subject to being made public or being shared with other offices in accordance with the policy of the Recipient office. Currently importing is limited to only references, lists of references, search reports and the application as filed (see § IV (A) 1. (1)). In the

Applicants may request that a Recipient office of a country which requires applicants to disclose information relevant to patentability import specific documents of the types listed in Section 1 (1) and (2) above from a dossier in a donor Patent Office. In this case, the Office concerned may import the documents. These documents would be treated as if they were supplied by the applicant. Offices will undertake not to import documents of types other than those listed in Section 1 (1) and (2) above.

In the course of prosecution of the application in the Recipient office, when documents other than the types listed in Section 1 (1) and (2) above are required of the applicant, the applicant may provide copies of those documents to the Recipient office directly.

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future, should any other document types be added to the list of documents that may be imported, the rules for importing documents from a Recipient office to a subsequent Recipient office (i.e. re-importing) must be reconsidered.