

Summary of the Trilateral Conference

Awajishima Island, Japan on November 2 and 3, 2000

The European Patent Office (EPO), the Japanese Patent Office (JPO), and the United States Patent and Trademark Office (USPTO), meeting for the eighteenth Trilateral Conference in Awajishima Island, Japan on November 2 and 3, 2000,

- Reconfirming the need for a global system of patent protection for the 21st Century, which was agreed in the Kyoto Action Plan of November 1997, in light of rising cost considerations, the increasing workload and redundancy of work being performed by the Offices, and greater expectations of the user community,
- Welcoming discussions held at WIPO and other international conferences on further harmonization of the substantive patent law and streamlining of the PCT system as an effort to establish a global system of patent protection,
- Recognizing the importance of the role of the Trilateral Offices as major International Authorities for search (ISAs) and examination (IPEAs) to make positive efforts to alleviate their workload situation, simplify the PCT system and produce highly reliable International Reports,
- Recognizing the benefit to the Trilateral Offices for mutual understanding of examination practices and exchange of information, taking into particular consideration the expected great influence of advanced technologies on the development of the world's science and technology,

Understanding the importance of concerted efforts by the Trilateral Offices to disseminate information and to establish an international network, which includes electronic filing system for patent applicants,

Have agreed as follows (conclusions and future prospects arranged by project number):

Project A1: Electronic Filing of Applications/Project D: Legal Issues

The Trilateral Offices agreed to continuously exchange information on the status of implementation of e-filing as well as on PCT Administrative Instructions Part 7 and Annex F. The Trilateral Offices noted the efforts of the WIPO TB for the earlier promulgation of PCT Administrative Instructions Part 7 and Annex F, and the implementation of the IMPACT project in order to allow Receiving Offices to receive electronic filings of PCT applications by December 2001.

The Trilateral Offices affirmed their commitment to ensure their electronic records meet the four requirements for data security: confidentiality, data integrity, authentication and non-repudiation.

The EPO and USPTO recognized that the JPO's non-PKI solution, i.e., existing ISDN solution, was a proven electronic filing system based on its ten years experience. The JPO agreed that it would work toward a PKI based electronic filing system. Until such a system would be realized at JPO, the Trilateral Offices agreed that the JPO's existing system should be incorporated in PCT Administrative Instructions and Annex F. The JPO also agreed to implement the Annex F standard for exchange of PCT applications, including PKI, between the JPO as RO/DO/ISA/IPEA and the IB.

The Trilateral Offices agreed to request the TB to implement PKI based e-filing software that would comply with a common Annex F Technical Standard. The Trilateral Offices agreed that offices, IB and authorities would use the Annex F Standard for data exchange between them using high-level PKI based certificates. The Trilateral Offices agreed to request the IB to redraft PCT Administrative Instruction section 704.

Project A2a: Networks and Network Standards

Project A2b: Exchange Standards

The Trilateral **Offices agreed, in principle, to** expand the TriNet to include

other JP Offices. The Trilateral Offices also agreed that they would target to establish an open-style network, using the Internet in the future, and that until then would expand the existing TriNet, using the technical solution of Frame Relay services with a hub-style architecture. The Trilateral Offices agreed to ongoing discussions regarding the details of the criteria for TriNet expansion.

The JPO and the EPO agreed on an upgrade of the TriNet Frame Relay circuit between JPO and EPO and agreed on continued active use of the TriNet.

Project A3: Management Information Exchange

The Trilateral Offices have revised the format of the Trilateral Statistical Report in order to add further relevant information. They also confirmed that they would strive to expand statistical information such as the number of PCT applications in the national phase and the number of applications apart from the number of designations. This data will contribute to the recognition of Offices workload and promotion of trilateral cooperation. (Project A3 (a) Trilateral Statistics)

The Trilateral Offices confirmed that a data file for forecasting patent filings will be established as a further step toward cooperative forecasting, and that the offices will also cooperate in preparing a joint applicant survey, which will be launched in 2003. They asked the working group to consider the operation of the survey and report **on** this matter at the 19th Trilateral Conference. (Project A3 (b) Factors Influencing the Filing Rate of Patents)

Project 112: Documentation Resources and Search Tools

The Trilateral Offices, being committed to common documentation resources for their examiners and to database tools necessary for the new technologies involving for example biological sequences, computer software and business methods, considered the following areas:

Project B2a: First Page Database

The future orientation of this database will be studied by the Working Group

“Data Exchange and Data Quality” before June 2001. In particular, the relevance of every component of the database for the work of the examiners will be examined, as well as the importance of the database for derivative products.

Project B2b: Biotechnology

The rapid growth of the number and size of applications containing DNA and Protein sequences was noted and the following was agreed:

- Development of the sequences database:

The coverage of the database will be extended. Sequence listings in POT applications should be extracted by the Trilateral Office acting as the ISA for the application.

- Cooperation with the databases public providers (EBI, NCBI, DDBJ) will be extended in order to optimize the exchange of data and the access for everyone to the sequences presented in patent documents.
- The project of a central Repository for biological sequences and its capabilities will be studied.
- The priority documents containing large volume of sequences will be exchanged. in electronic form.

Project B2c: Classification issues

The use of classification systems remains a major element in performing quality searches with electronic tools.

- The Trilateral Offices, with the objective of sharing their resources needed to classify the growing number of documents, decided to start to harmonize the three powerful classification systems that they presently use: the US classification
-(USPTO), the FJJF-term system (JPO), the ECLA classification (EPO).

- To This effect, a feasibility pilot project will be conducted on a selected number of technical fields in 2001.
- The Offices agreed to support the International Patent Classification Reform undertaken by WIPO: a core level will be easier to use in a harmonized way by all offices and will offer the stability needed to build up the advanced level. The advanced level could be prepared by the Trilateral Offices and made broadly available. Other IP offices could propose advanced level reclassification projects to the TOs.
- Japanese FI / F-terms:
 - A new delivery mechanism was agreed assuring monthly updates of the data for the USPTO and the EPO.
 - The costs of translation in English of the FI manual will be shared among the three offices.
 - The reference table between FI and F-term themes will be distributed by the end of November.

Project B2j: Data Exchange and Data Quality

On the basis of the comprehensive inventory of the resources available in the three offices, new data will be exchanged, particularly the “citation database”, the “NPL database”, and the US patents full text and facsimile images (1790-1975).

The coverage of the documentation in images and full text should be extended to countries like Canada, Australia, Russia, whose documentation belong to the PCT.

Minimum Documentation

The three offices will study how to establish a common trilateral bibliographic database on the basis of DOCDB.

The working group will prepare a common view on the impact of XML on the offices activities, and identify projects where a common approach will be

efficient.

An update of the present exchange standards will be studied.

The quality of the data included in the different databases is to be monitored and correction mechanisms were agreed. A new system will be developed to reduce the number of erroneous data.

The completeness of the databases will be checked on the basis of the "Authority list" of published documents provided by the three offices. And the missing data will be exchanged.

The working group will meet in Washington, DC early 2001.

Project B2g: Non Patent Literature

To expand their coverage of Non Patent Literature, The Three Offices approved the measures proposed by the Working Group, in particular:

- to promote development of shared NPL resources,
- to use the EPO NPL database: either by loading it (JPO) or accessing it (USPTO),
- to take into account the value of Defensive Publications, and
- to capture of relevant NPL sources in text searchable form will be pursued;
- specific projects may be developed on a cost sharing bases.

The use and efficiency of the NPL resources will be monitored.

Project B3: Cooperation in Search and Examination

The Trilateral Offices agreed to reinforce their cooperation in search/examination in order to:

- increase efficiency by improving the use of search results already available;

- achieve better understanding and promote harmonization of working practices and tools in the respective offices..

Project B3a: Exchange of Search Results

Paris-route pilot program

After completion of the remaining cases, the JPO will draft the formal report of the concurrent search pilot program using the Paris-route. Thereafter the project will be concluded.

Business method related patent applications

In order to compare the usefulness of the respective search tools in this area, the Trilateral Offices agreed on the details of a concurrent search program comprising up to 20 PCT business method related patent applications. This program will be started in January 2001.

Investigation of use of ISR

Based on the pilot experiments for “Investigation of the use of the TSR for entry into the national/regional phase” conducted during the past months, the JPO and EPO will perform yearly statistical analysis in order to monitor the usability of search results and to identify specific areas requiring more detailed evaluation, giving due consideration to the required workload. The USPTO will provide file history record for such analysis as needed.

Project B3b: Mutual Understanding in Search and Examination

Examiner Exchange

The EPO and JPO concluded that this year s program involving 15 EPO and 33 JPO examiners has been very successful by improving the mutual understanding of the. working methods and by promoting use of the search tools and methods available in the respective offices. These exchanges also allow improved cooperation in the design and development of the search tools, e.g. FI/ECLA concordance. They also contribute to a harmonization of the working practice and results produced in the two offices.

In view of the above, the EPO and JPO agreed to continue and extend the program and share their experience with the USPTO.

Comparative Study on Biotechnology

The Trilateral Offices adopted the report on the comparative study conducted by the three Offices on nucleic acid molecule-related inventions whose functions are inferred based on homology search. JPO will provide copies in electronic form so that each Office can make it available on the Trilateral Web site.

The Trilateral Offices recognized that differences in examination practices for nucleic acid molecule-related inventions revealed by this study stemmed mostly from differences in national/regional patent laws including relevant case laws. The Trilateral Offices noted that the G8 Summit Communique encourages further efforts in relevant international fora to achieve broad harmonization of patenting policies of biotechnological inventions. Therefore, the Trilateral Offices agreed to continue further cooperation for promoting clearer understanding of search and examination practices in the three Offices to contribute to the broad harmonization of patenting policies in this field.

Computer software related inventions

During the year the JPO and USPTO conducted a comparative study based on hypothetical cases. The EPO contributed a position paper on patentability of business methods in Europe that clearly shows there is agreement on certain aspects of patentability and disagreement on others.

Project C: Dissemination of Patent Information

The use of the three offices web sites has been very successful. The offices agree to continue a dialog with commercial information providers and to exchange information on the future impact of their information dissemination policy.

MIMOSA

The EPO reported that it had provided a copy to the JPO of the latest release of

MIMOSA application software Version 4.1. The JPO explained it had been testing the software in JPO.

GlobalPat

The EPO reported that discussions had taken place with WIPO in order to obtain a cofmancing of a continued GlobalPat production, and requested the continuation of the First Page Database product for the GlobalPat production.

PCT reform

The Trilateral Offices welcomed the decision of the **PCT** Union Assembly to enter into a PCT reform exercise that could ultimately provide the basis for a global patent system. The TOs recognized that, as major POT ROs and PCT authorities, they will have an important role to play in the reform process.

The TOs are concerned about the workload they have to face as a result (for a large part) of the huge success of the PCT system.

The TOs stressed the need to design as rapidly as possible contingency measures in order to alleviate the IS and the IPE workload. They consequently decided to establish a Working Group, with a primary mandate to develop ideas and methods to best cope with the most urgent problems.

Further, the Working Group could reflect on possible improvements to the PCT, with the intent to clarify the TO s positions and, where possible to present proposals in due time to the WJPO Special Body.