

The European Patent Office (EPO), the Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the 28th Trilateral Conference in Alexandria, Virginia, on November 19, 2010:

- Reconfirming their commitments to Trilateral cooperation based on common recognition of the role of industrial property as a basic system supporting the progress of industry, technology, and international economic growth,
- Identifying timely processing of increased workloads of patent applications and high quality examination processes as common objectives of the Trilateral Offices and its user communities,
- Acknowledging the benefits of promoting reduction of processing times and reducing or eliminating redundant work through a coordinated Trilateral approach,
- Reaffirming the significance of the IP5 Co-operation and its foundation projects,
- Noting the importance of enhancement of the cooperation between the Trilateral Offices and its user communities,
- Understanding the benefits of harmonizing patent law and procedures,
- Recognising the benefits of developing common infrastructure and compatible data for electronic business systems and search tools,
- Reaffirming the value of patent information as means for raising the quality of applications filed,

Highlight the following as major achievements of the common efforts of the three Offices this year:

- Agreed on the extension of the scope of the PPH pilot utilizing PCT work products by inviting KIPO and SIPO also with a view to expanding the potential of work sharing cooperation and to promoting the PCT
- Implemented pilots or programs within the Trilateral framework to balance and prioritize workloads to maximize re-use of search and examination results
- Implemented a pilot for use of a Trilateral common citation document with a view toward facilitating the efficient access and reuse of search and disclosure efforts for related applications
- Compiled a Catalog of Differing Examination Practices to facilitate work sharing by providing examiners with an enhanced

understanding of the similarities and differences in each Office's laws and practices

- EPO and USPTO commenced a limited PCT collaborative search and examination pilot to allow for the production of a single search report to increase understanding and trust among examiners and provide a means for studying reusability of work results
- Completed migration of Trinet to the new IPsec devices

Furthermore, understand as follows:

### **1. Work Sharing (Project WM1)**

The Trilateral Offices reaffirmed their commitment to further development of the various work sharing initiatives in order to maximize reuse of each offices' work product to increase the efficiency and effectiveness of their own search and examination. The Trilateral Offices will continue to explore methodologies thereof.

#### **(a) Patent Prosecution Highway**

The Trilateral Offices agreed to continue work on the Patent Prosecution Highway as an important element of Trilateral worksharing activities and for strengthening the PCT. The Offices will continue the PCT-PPH pilot and will evaluate the pilot with an interest toward expanding the pilot to the IP5 Offices.

The EPO and the USPTO have extended the period for the bilateral pilot program until January 28, 2012. The EPO and the JPO commenced a two year bilateral pilot program in 2010. The JPO and the USPTO have implemented the PPH on a permanent basis since January, 2008.

The JPO and the USPTO will promote usage of the PPH through cooperation on outreach and education and will work toward expanding the PPH program to other intellectual property offices.

#### **(b) SHARE**

Whereas prioritization of first filings is standard practice for the EPO, the JPO has realized the concept of SHARE in the JP-FIRST initiative. The USPTO has commenced a pilot project known as FLASH to test the feasibility of balancing and prioritizing workloads to maximize re-use of search and examination results according to the SHARE concept.

The Trilateral Offices agreed to adopt and utilize where feasible work sharing surveys having common content for use by examiners. This survey will assist in measuring the benefits of the programs and will provide the offices with feedback to improve procedures.

### **(c) Common Citation Document**

The Trilateral Offices agreed to implement a pilot program to evaluate the use and format of the Common Citation Document for sixty (60) patented files. The EPO will host the data for the Common Citation Documents. The Trilateral Offices agreed to look closely at their internal processes for the production of timely and enhanced citation data. Agreement was reached that following a period of capturing feedback from the Offices and Trilateral Industry, Version 1 of the product, which will include available citation data from each of the Trilateral Offices, would be deployed to the public at the Trilateral Conference in 2011.

### **2. Examiner Exchange (Project WM3)**

The Trilateral Offices agreed that examiner exchange programs have been an effective means to build confidence among the Offices. Accordingly, the Offices agreed to continue this work through IP5 cooperation to advance this objective and to make more efficient use of resources.

### **3. E-learning (Project WM3)**

The Trilateral Offices agreed to fully integrate this project into IP5 cooperation within the purview of WG3.

### **4. Using the PCT**

The Trilateral Offices recognized the importance of continuing efforts on using the PCT system to its full potential and agreed to continue to explore, and implement, where feasible, various proposals to advance the PCT Roadmap.

The three Offices agreed to strive toward improving the PCT process in order to optimize reuse of PCT work within the national stage in the Trilateral Offices.

The EPO and the USPTO have implemented a limited PCT collaborative international search and preliminary examination pilot as one component of the Roadmap.

### **5. Examination Practices and Quality Issues (Project LEG)**

The Trilateral Offices compiled the first draft of a Catalogue of Differing Examination Practices. The Trilateral Offices recognized that the Catalogue could be beneficial for examiners utilizing the work results in other Offices, provide a basis for improving quality, as well as, serve as a valuable tool for applicants. Having shared the draft catalogue with the Trilateral users, the Offices agreed to integrate the Catalogue into the IP5 Foundation Project 9 and extend it to KIPO and SIPO with a view to having it be made publicly available after evaluation with a restricted group of examiners of the five Offices. The Offices further agreed to discuss in parallel, additional topics that could be added to the Catalogue.

The Trilateral Offices agreed to enhance quality management and investigate measures for improving quality. The three Offices agreed to undertake a study of the quality of International Search Reports, and propose improvements, with an expected completion date of November 2011. As part of this effort, the Offices agreed to participate in a pilot collaborative study on quality metrics. This study will be moved to the IP5 upon conclusion of the study.

Recognizing the importance of patent quality to the global intellectual property community, the Trilateral Offices agreed to explore development of composite metrics including statistical data and stakeholder perception information.

## **6. Enhancement of IT Collaboration**

The Trilateral Offices agreed to continue developing and supporting the IP5 Foundation projects to support work sharing.

The Offices agree to continue existing work under the Trilateral Technical Data Standards Area Working Group with the aim of completing the work of this group by the end of 2011.

### **(a) Priority Document Exchange (Project DTR3)**

The Trilateral Offices reaffirmed the importance of conducting on-going discussions on security of the Priority Document Exchange (PDX) System.

The Trilateral Offices agreed to take a new measure to improve the security of the current TDA-PDX scheme as early as this year. The Trilateral Offices will continue to cooperate in working with WIPO to improve the usability and security of the WIPO Digital Access Service (DAS).

### **(b) Electronic Filing, Data Standards (Project EB1, STD1)**

Aiming toward realization of the use of XML in all three Offices, the Trilateral Offices will continuously exchange information on the status of enhancing XML based e-filing and processing in each of the Offices.

The Trilateral Offices will promote the use of the Common Application Format with its users.

Recognizing the efficiencies that may be gained from developing common standards, the Trilateral offices agreed to work toward standardizing XML format for PCT forms, define business requirements for data exchange standards, and work toward fulfilling those requirements.

The Trilateral Offices agreed to work with WIPO towards developing a revised standard for the presentation of sequence listings with the aim of having the revision ready for the adoption process at WIPO by the end of 2011

### **(c) Paper Zero Emission**

The Trilateral Offices will continue to consider legal and technical issues to positively support the IB's goals of digitization. The Trilateral Offices will continue to develop the "Paper Zero Emission" project which handles PCT documents in electronic form.

#### **(d) TRINet (Project IT3)**

The Trilateral Offices adopted a revised Security Policy for Trinet in order to implement standards for Trinet security controls.

The Trilateral Offices have agreed that it is important to assess what types of documents and information are exchanged, and how secure the exchange of different types of information needs to be, in order to determine the best method of exchanging information in each case. Accordingly the Trilateral Offices will carry out a study with the aim of using the most suitable networking for each type of application with the intention of having secure exchange open to all IPOs in the future

### **7. Classification (Project WT2)**

The Trilateral Offices will continue their work on the outstanding Harmony projects and will finalize the existing Harmony projects in 2011. The three Offices will work towards a smooth transition of the Harmony projects into the IP5 cooperation framework.

### **8. Information Dissemination/Public Awareness (Project PI)**

The Trilateral Offices agreed on a revised "TRILATERAL POLICY ON THE USE OF EXCHANGED ELECTRONIC INDUSTRIAL PROPERTY INFORMATION DATA". The policy is contained in Annex 1 of this MOU. The intention of this revised policy is to enhance and expand access of exchanged data in order to improve dissemination of information to the patent information user community.

The Trilateral Offices agreed to consult and provide advanced notice of changes in format and media for exchanging data in order to minimize processing disruptions to the Trilateral Offices and external customers.

The Trilateral Offices agreed to continue discussions with industry and to raise awareness of activities of Trilateral cooperation.

### **9. Statistics (Project MAN)**

The Trilateral Offices agreed to change the name of the "Trilateral Statistical Working Group" to the "Four Office Statistics Working Group" to reflect the status of the Korean Intellectual Property Office as a full member of this Working Group. The Trilateral Offices will work towards transitioning the Four Office Statistics Working Group into the IP5 framework.

## Annex 1

# **TRILATERAL POLICY ON THE USE OF EXCHANGED ELECTRONIC INDUSTRIAL PROPERTY INFORMATION DATA (TRILATERAL INFORMATION DISSEMINATION POLICY 2010)**

## **1. PREAMBLE**

The Trilateral Offices exchange industrial property information data (e.g., document images, text data, bibliographic information, etc.) for the mutual benefit of the Offices and the public. This data may be provided on various electronic data carriers, e.g. optical discs, magnetic tapes, the Internet, FTP, etc. These are free exchanges and result from agreements between the Offices involved in the exchange. The policy on the use of this data is set forth in this document to provide uniform minimum guidelines for using the data exchanged under this agreement.

This agreement supersedes the previous Trilateral Office Policy on the Use of Exchanged Electronic Industrial Property Information as agreed among the Trilateral offices in Annex 1 to the Memorandum of Understanding, dated November 9, 2001. The intention of this agreement is to implement a liberal view and rules on exchanged data in order to improve support of the patent information user community.

## **2. DEFINITIONS**

### **2.1. INSTITUTIONAL DEFINITIONS**

#### **2.1.1. Libraries**

- “**Libraries**” shall be understood to cover institutions governed directly by Offices or operated as non-commercial institutions authorized to disseminate industrial property information, and established or controlled by public or semi-public bodies (for example, depository libraries) for the dissemination of information to the public.

#### **2.1.2. Member offices**

- A “**member office**” is an individual industrial property office belonging to an organization of industrial property offices, e.g., the European Patent Office (EPO).

### 2.1.3. Third parties

- A “**third party**” is any industrial property office, organization, academic institution, individual or enterprise, which is neither the data providing Office nor the data receiving Office (or its Libraries or Member States).

## 2.2. USE OF DATA

### 2.2.1. External use

“**External use**” of data means the use, the processing, and the provision of the exchanged data to third parties (which are not patent offices) for personal use, for company use and for commercial use.

### 2.2.2. Internal use

“**Internal use**” of data consists of “official use”, “library use” and “data exchange use” by the receiving office as provided for below:

#### 2.2.2.1. Official use

“**Official use**” is the use of data by officials of a receiving Office or, where applicable, by an official of a library:

1. in the course of official procedures for the grant of industrial property titles, including search, examination, maintenance and appeal procedures;
2. for the purpose of statistical and technical analyses in the framework of the official business of the Office;
3. to provide an inquiry service for the public to meet specific requirements of individual and corporate users based on their own needs;
4. for the purpose of providing systematic training activities, provided that the use of the data is compatible with fair practice and does not exceed the extent justified by the purpose; or
5. for the purpose of providing copies of the data for the use of the receiving Office or library.
6. for the use in any existing or future public services of the receiving office such as IPDL, esp@cenet etc.
7. for the purpose to provide tools in order to support the users community in using industrial property information more efficiently

#### **2.2.2.2. Library use**

“**Library use**” is the use of data by members of the public in search rooms of Industrial Property Offices or in libraries.

#### **2.2.2.3. Data exchange use**

"Data exchange use" is the use of exchanged data for provision to third party patent offices (under the condition of mutual acceptance of the reciprocity principle).

### **2.3. DATA TYPES**

The policy laid down in this document applies to all types of exchanged data, i.e. bibliographic data, coded data, image data, abstracts data, translated data, classification data, statistical data etc. as set or subset of data of the receiving or providing office, further also as subset or as database containing data from several offices.

## **3. BASIC PRINCIPLES**

The Trilateral Offices share the common understanding that industrial property information shall be provided to the public and to any third party based on the existing principle of marginal cost or free of charge. In order to support a barrier free flow of information among patent offices, data exchanged by the trilateral offices may be provided to third party patent offices in accordance with these guidelines and under the condition that the reciprocity principle is accepted by the third party patent office.

## **4. POLICY**

Industrial property information data provided as part of a free exchange by the Trilateral Offices is provided by the originating Office for the internal and external use of the receiving Offices.

This means in detail:

### **4.1. AUTHORISATION FOR INTERNAL USE**

1. Receiving offices are allowed to use exchanged data internally without any restrictions for 'official use' and 'library use'.
2. Receiving offices are allowed to provide exchanged data to third party patent offices under the provision that in accordance with these guidelines the reciprocity principle is respected by the third party patent office.

#### **4.2. AUTHORISATION FOR EXTERNAL USE**

1. Receiving offices are allowed to provide exchanged data in any form (including bulk form) to third parties (which are not patent offices) for external and commercial use.

#### **4.3. AUTHORISATION TO DISSEMINATE AS A PUBLIC SERVICE**

1. Offices, having received exchanged data may provide public access to all or parts of these data as part of a public service, for example, using the Internet.
2. The provision of such data underlies no restrictions, neither in volume nor in functionality.

The Trilateral Offices share the view that exemptions to any of these principles laid down above shall be restricted to the absolutely necessary minimum and shall be communicated to the receiving Offices in written form.

#### **5. COPYING AND SHIPPING COSTS**

The costs of copying, shipping or any other technical way of data provision for exchanged data shall be borne by the Office providing the data.

#### **6. WARRANTY AND DATA QUALITY**

The originating Office will be the authoritative source for data provided directly to receiving Offices.

Third party recipients of Trilateral exchanged data shall hold free the original originating Office of any liabilities for any reason, including defects of the provided data (.e .g. re. the completeness , accuracy and correctness of the data made available or supplied to a third party). Third party recipients waive all rights to claims against the originating Office.

Claims from third parties are to be dealt exclusively with the Office directly providing the data for internal or external use. In any case the Office providing the original data is not responsible for data provided by the receiving Office to any third party.

Any questions, issues, or support, and costs associated therewith, arising from the data provided to the third party shall be handled by the Office directly providing the data and not the originating Office.

Alexandria, November 2010