

# Summary of the **22nd Trilateral Conference**

## **Alexandria, Virginia**

**November 19, 2004**

The European Patent Office (EPO), the Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the 22nd Trilateral Conference in Alexandria, Virginia on November 19, 2004,

- 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 concerns of the Trilateral Offices and its user communities,
- Recognizing the benefits of promoting reduction of processing times and avoiding duplication of work through a coordinated Trilateral approach,
- Understanding the benefits of harmonizing substantive patent law,
- Recognizing the benefits of developing common infrastructure and compatible data for electronic business systems and search tools,

understand as follows:

### **Project WM1/Strategic: Effective Access and Use of Work Results/Strategic Issues**

The Trilateral Offices reaffirm their expectations that the exploitation of the search results of other Trilateral offices would have the potential to reduce the workload and contribute to the improvement of the quality of the examination.

The Trilateral Offices deepen the recognition that it is desirable that the search/examination result of the Trilateral Offices of first filing be provided in a timely manner to be used by the other Trilateral Offices of second filing in order that the other Trilateral Offices of second filing achieve high quality examination and work reduction.

The EPO and the USPTO point out the challenge of searching Japanese language patent documents particularly those that do not have English family members. Both offices confirm that enhanced patent quality may result from exploiting the search results of the

JPO of Japanese language patent documents. They express interest in receiving the search results of the JPO in a timely manner.

The EPO and the USPTO acknowledge the efforts made by the JPO and the Japanese private industry to promote utilization of the PCT route and accelerated examination.

The Trilateral Offices' evaluation of the bilateral search exchange projects has shown potential benefit for reduction of workload, avoiding duplication of effort, and improving quality by exploiting the search results from another office. The Trilateral Offices recognize that the timely availability of the search results from the Office of First Filing is critical.

Efforts should be made to provide timely access of the search data of the Office of First Filing to the Office of Second Filing.

The Offices recognize there are currently gaps between each Office's search results. To narrow the gaps, the Trilateral Offices will promote programs such as examiner exchanges, patent law harmonization, automated system development, classification harmonization, and the exchange of search strategy information;

Furthermore, the Trilateral Offices recognize there is a need for effective translation tools;

The Trilateral Offices identify the following next steps for accelerating work sharing progress in the short term:

1. Introduce where necessary possible modifications to the legal system, the technical infrastructure and/or measures influencing applicant behavior to allow timely access to the OFF search information;
2. Provide technical solutions to make the OFF search history available to OSF in readily accessible form;
3. Improve the acceptance of the OFF search results to OSF examiners by utilizing an examiner exchange program and identifying additional efficient ways to accomplish this acceptance;
4. Continue to improve current machine translations and work towards a comprehensive machine translation infrastructure.

The Trilateral Offices will consider the "Patent Prosecution Highway Project" prepared by the JPO. The USPTO will study the proposal to determine what impact this will have on the USPTO and send comments on the proposals to the other Trilateral Offices.

For the long term, the Trilateral Offices will work on procedures and law changes to achieve benefits from work exchange. The Offices will address timing of work so that work sharing provides benefits to the office of second filing to the greatest extent possible.

The USPTO and the JPO will postpone reviewing fee policy changes that would provide applicants with a benefit for the use of search and examination results from another Trilateral Office.

The Trilateral Offices will cooperate to define the requirements for the JPO Dossier Access System for the satisfaction of the IDS (Information Disclosure Statement) requirement in order to reduce the procedural burden of applicants when applicants receive office actions from the JPO. The USPTO will identify the requirements needed for system developments with cooperation by the other Trilateral Offices at the next Strategic Working Group meeting.

The Trilateral Offices will continue to review the legal and technical issues related to import guidelines. The Trilateral Offices will review import requirements and provide preliminary comments, if possible, by the middle of December 2004 with the goal of establishing guidelines by Spring 2005. The guidelines are to address types of documents and conditions for importing.

The Trilateral Offices believe that in order to maximize work sharing it is important to access complete information on search history, strategy and results. The Offices will continue discussions in this regard.

In order to continue making progress on the Trilateral projects identified within this document, a strategic working group meeting will be held in late February or early March 2005. The USPTO will draft a proposed agenda and circulate for comments.

### **Project WM3: Examiner Exchange**

Using the Examiner Exchange program as a tool for enhancing understanding and effectiveness of the exchange of work results, the Trilateral Offices will continue to utilize the current examiner exchange program to improve acceptance and reduce any gaps identified within the search exchange project.

The current Trilateral Examiner Exchange program includes a final Spring 2005 visit at the JPO. The Trilateral Offices will to develop a detailed evaluation of the current program after this visit before deciding to renew the program. The JPO will identify the technical fields for inclusion in the Spring examiner exchange program by early December 2004.

As to the bilateral examiner exchange, the JPO expressed its intention to dispatch its examiners at the same magnitude as that of recent years and willing to receive examiners at the same magnitude as that of recent years.

The Trilateral Offices will better identify and define the mandates/objectives prior to any future examiner exchanges. The three Offices recognize that there is need for clarity and a determination of scope on the technical areas selected, a need to identify the mandate, stipulate the nature of the results to be gained, and a need for broadening the dissemination of the results and information gained by the examiners.

#### **Project WM4: Comparative Studies in New Technologies**

Based on the ongoing activities on Nanotechnology, the Trilateral Offices will form a Trilateral Emerging Technologies Working Group. The Working Group will identify trends in emerging technologies and exchange information between the Trilateral Offices in regard to these emerging technologies. This exchange will include sharing trends in new technologies, sharing information on definitions and initial classification efforts and sharing ideas on best practices for effective and efficient examination of emerging technologies.

#### **Project EB1: Electronic Business Systems**

The Trilateral Offices support the concept of interoperable tools for all IP Offices. Therefore, the Trilateral Offices recognize the value of the EPTOS project and note the progress made in the Netherlands, Denmark, and Sweden.

To achieve the goal of author-once-file-anywhere in an operational electronic filing environment, the Trilateral Offices will develop an interoperability issue paper for e-filing data compatibility which prioritizes the issues and proposes initial targets for best practices by Spring 2005. Each office will produce a resource and implementation schedule in order to achieve the goal of interoperability.

#### **Project EB3: Dossier Access**

In order to achieve the goal of effective access to each Office's dossier, the Trilateral Offices commit to the Trilateral dossier access standard for dossier access.

The EPO-USPTO will begin a limited production pilot of Trilateral Data Access for published dossier and dossier document access at the end of November 2004. The USPTO and the EPO will continue working with the JPO to provide dossier access using the Trilateral dossier access standard.

The Trilateral Offices will prepare an inventory of all data and document exchanges between the Offices for consideration of using Trilateral Data Access as a progressive replacement for other exchange mechanisms. The Trilateral Offices also will extend

the Trilateral Document Access (TDA) to support the machine translation possibilities coming from Project WT1.

### **Project IT3: TRINet**

The Trilateral Offices support the revised Protocol for adding new members to TRINet. The three Offices will move forward with completing the next steps for adding IP Australia to the TRINet. The Trilateral Offices note that the contract to allow the interconnection of TRINet, PATNet, and WIPONet has now been signed by the Trilateral Offices.

### **Project DTR3: Priority Documents**

The USPTO and the EPO will pilot a limited exchange of electronic priority document in December 2004, using the asynchronous method for delivery, with the intention of moving to production mode in 2005. The EPO and the USPTO will work with the JPO to adopt the Trilateral Data Access services for electronic exchange of Priority Documents.

The Trilateral Offices will further work on a technical standard (i.e., TDA Interface Specification-Trilateral dossier access standard) for Trilateral Office exchange of Priority Documents. The standard will be finalized during the coming EPO/USPTO pilot project and presented for adoption at the May Trilateral Meeting in 2005 in order to achieve benefits from electronic exchange.

The Trilateral Offices believe that the format of the priority document should be specified in bilateral or multilateral agreements between the participating offices.

### **Project DR2: Biotechnology**

The Trilateral Offices will continue to work within the Biotechnology Working Group to develop tracking mechanisms to follow trends pertaining to SNP applications and to study the impact of any new XML standard as a replacement for WIPO standard ST.25 on each Office's procedures and thereafter decide whether it is possible to implement such a standard. The Offices will also make efforts to improve database completeness by inviting WIPO to establish a mechanism for delivering sequences to public database providers and by encouraging other ISAs to do the same.

The JPO will select the technical field where chemical compound structure search is frequently done as one of the fields of the examiner exchange program to be held in Tokyo in April considering its finds of Chemical Compound Structure Search Study.

#### **Project DR4: Non-Patent Literature**

The Trilateral Offices will exchange information on the use of Digital Object Identifiers (DOIs) as a means for providing access to the full text of NPL. Each Office will continue to study the issue of NPL exchange and report to the Trilateral Offices the results of such studies. The JPO will participate in the current pilot program between the USPTO and EPO to eliminate the exchange of copies of cited documents in the ISR exchange program.

#### **Project WT1: Linguistic Tools**

The Trilateral Offices welcomed the JPO release of the Advanced Industrial Property Network on October 12 as Phase 2 of the English-Japanese Machine Translation System.

In order to advance progress in the use of search and examination results, the Trilateral Offices will work toward improving machine translation of dossier contents in English. To this end, the Trilateral Offices will establish a Trilateral Machine Translation Working Group.

#### **Project WT2: Harmonization of Classification**

The Trilateral Offices reaffirm the importance to development and implementation of IPC Reform as a necessary tool to achieve harmonization of the classification systems of the three Offices. The Trilateral Offices will continue development in this area for a January 2006 implementation date.

The Trilateral Offices recognize the importance of harmonizing classification as the basic infrastructure to facilitate harmonization in search and enhanced usability of other offices search results, reduction of redundancies and increased mutual exploitation of search results.

The EPO proposed to accelerate the Harmony project and the JPO is requested to enhance its contribution in the harmonizing classification by dispatching its examiners to engage in the harmonizing classification project.

The JPO will provide a whole data file of its Alloys database to the EPO on a regular basis.

#### **Project WT3: F-I/F-Terms**

The JPO will start producing the English translation of F-term manuals and provide them to the EPO and the USPTO.

The Trilateral Offices recognize that the English translation of F-term manuals will assist the EPO and the USPTO in the use of the F-term system. The JPO will investigate the possibility of sharing information regarding discrepancies found between the use of their machine translation tools and human translation.

### **Project PI1: Information Dissemination Policies**

The Trilateral Offices reinforce its commitment to use the Internet as the key dissemination tool for patent information in the future. Each office will use the internet in ways that are appropriate in light of individual legal, technological, and data requirements. One of the projects in this respect is the Japanese interface for esp@cenet which is being developed by the EPO in cooperation with the JPO and will be launched in 2005. Further projects can be a Japanese interface to epoline and the implementation of linguistic tools in these applications.

The Trilateral Offices appreciate the contribution of the private sector in their information dissemination efforts and will each encourage a continuing dialog with these organizations.

### **Project LEG: Legal Issues**

The Trilateral Offices recognize the importance of patent law harmonization and note that harmonization of prior art issues will likely improve quality and contribute to reduction of workloads in the three Offices and reduce costs for applicants. With this in mind and in order to advance discussions on patent law harmonization, the Trilateral Offices will base further harmonization work on a limited package of issues and work toward harmonizing on that basis.

The USPTO is planning to convene a meeting, outside of the context of the Trilateral, to explore next steps in patent law harmonization. The USPTO and the JPO encourage the EPO's participation in such a meeting and the EPO will address the issue at the December 2004 meeting of the EPO Administrative Council.

The Trilateral Offices will conduct a comparative study on their respective novelty practices with a view to further developing the enlarged novelty concept. Such study will employ example fact patterns from each office. The USPTO will take the lead in drafting examples. The USPTO will continue its current study on enlarged novelty involving the review of file histories of applications and will provide the results to the Trilateral Patent Harmonization Working Group.

The Trilateral Offices will continue discussions on the adoption of a 30-month priority period as an additional system to the international filing systems under the PCT and the Paris Convention. The JPO will also propose a system that may include a transitional period of 30-months before filing a national application in an office of second filing. The USPTO will continue to refine its discussion paper taking into consideration the

concerns (for example the Hilmer doctrine and 35USC 102(e)) raised by the EPO and the JPO and request that any further comments be submitted in writing within the next couple of months.

### **Other Issues**

The Trilateral Offices will continue, with respect to the PCT, the discussions on streamlining PCT operations, including usefulness of capturing applications in electronic form at the Receiving Office in order to enhance processing of applications at WIPO.

The Trilateral Offices also will continue consulting with one another on patent law issues concerning genetic resources and traditional knowledge, particularly with respect to proposed new disclosure requirements in patent applications.

The USPTO and the JPO support the concept of not duplicating work in the creation of a Worldwide Patent Statistical Database. The EPO will meet with WIPO to start cooperation for the creation of such a database.

The Trilateral Offices recognize that quality standards are an important priority to consider when establishing new International Search and Examination Authorities under the PCT. The JPO and the EPO suggest that the number of the domestic/international applications might be further criteria to be considered. In this regard, the USPTO will elaborate appropriate proposals and will circulate the proposals to the other Trilateral Offices for comment.