

## **Summary of the Trilateral Conference**

**Berlin, 12 November 1999**

The European Patent Office (EPO), the Japanese Patent Office (JPO) and the United States Patent and Trademark Office (USPTO), meeting for the seventeenth Trilateral Conference in Berlin, Germany on 12 November 1999,

- Pursuing implementation of the Kyoto Action Plan (November 1 1997), including the long-term objective of a worldwide patent granting system, by deepening mutual understanding in search and examination and fostering the exchange of search results among the Trilateral Offices through the Trilateral Network and examiner exchange,
- Recognising the importance of the role of the Trilateral Offices as major International Search Authorities and the necessity of ensuring the high reliability of International Search Reports,
- Recognising the increasing importance of new technologies for economic growth and the need for a co-operative approach on patent searching and examination in these fields,
- Underlining the importance of electronic filing for patent applicants and the Trilateral Offices' wish to be able to offer a standardised system to the patent community, in co-operation with WIPO,
- Emphasising more generally their efforts to develop their electronic business activities in order to facilitate the patent grant procedure and dialogue with applicants and to promote dissemination of patent information,

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

### **Project A1-A2: Electronic Filing of Applications; Networks and Data Exchange**

The Trilateral Offices agreed on common technical standards for the electronic filing and discussed the processing, storage and record management of patent applications, including certification, encryption and electronic signatures as well as the data content of digital documents. The Offices will implement these standards (starting with interoperability pilots from the beginning of 2000) and will start accepting electronic filing of patent applications when their implementing rules have been amended (between 2000 and 2002). WIPO indicated its willingness to move forward on the proposed standards.

The Trilateral Offices will present these standards to the WIPO Standing Committee on Information Technology (SCIT) for discussion at its meeting in December 1999 for adoption as the standards for the electronic filing, processing, storage and record management of national and regional applications. They also expect them to form part of the future Administrative Instructions under the PCT and thus become the standards for the electronic filing of international applications. These standards are attached as Annex F (legal and

technical principles for PCT filings), Appendices I and II (trilateral technical standard) to the Pre-conference report. The proposed calendar is in Annex 1.

The POT Administrative Instructions and the SCIT technical standards will then become applicable to PCT applications and, under the Patent Law Treaty (P LI), to national and regional filings, once the Treaty comes into force.

As regards the network, the Trilateral Offices anticipate the increased use of the Trilateral Network (TSVPN) between the Trilateral Offices and WIPO. As regards electronic exchange of priority documents, EPO agreed to eliminate its backlog of documents to be sent by CD-R to JPO. The EPO and JPO agreed to complete an online data transfer test on application level by December 1999 while continuing the CD-R exchange as a back-up. The USPTO agreed to join this exchange in the near future. There was also a common understanding to initiate the exchange of data in the field of search and examination. This exchange will be progressively extended.

For exchange of other types of documents, the Trilateral Offices agreed to set up an appropriate common infrastructure for online file transfer.

### **Project A3: Management Information Exchange**

The Trilateral Offices have revised the format of the Trilateral Statistical Report and will continue to review the presentation format of the data (Project A3a: Trilateral statistics). They also took note of the exchange of information and forecasting methodology on filing projections (Project A3b: Factors affecting patent filings) and asked the working group to report at the 18th Trilateral Conference.

### **B2: Database Production and Tools**

The Trilateral Offices agreed to intensify their co-operation to improve and harmonise their search environments with respect both to documentation coverage and to search tools. Three difficulties have been identified:

- Lack of harmonised search tools
- Growth in patent and non-patent documentation
- Fast emergence of new technologies

With this in mind, they made the following statement:

Locating the most relevant prior art is critical to the patent examination process. The Trilateral partners have established a co-operative framework over many years to improve the quality and quantity of prior art data and search tools available to their examiners.

The emergence of the Internet and growth in electronic publication from non-traditional sources of prior art provide new challenges and opportunities for the Trilateral Offices. In this respect, the Offices will be joining efforts to:

- (1) improve the comprehensiveness in coverage and integrity of their electronic databases; -
- (2) strengthen access to published literature beyond patent documents, while respecting copyright requirements;
- (3) develop common internal databases, and search tools and techniques in specialized areas of patentable subject matter; and,
- (4) co-operate in supporting IPC reform in WIPO for the new millennium.

These efforts will not only benefit the proficiencies of the Offices, but also strengthen the patent system for the user community.

### **B2a: First Page Database**

The Trilateral Offices reaffirmed their commitment to produce the First Page database (EPO and USPTO part; PAJ), considering their internal needs and the interest within the scientific community.

### **B2b: Gene Sequence Database**

The Trilateral Offices took note of the report from the working group on biological sequences and approved the following actions:

- Regarding completeness of the databases, they have decided to carry out ~ jointly funded quality study to compare the contents of the publicly available databases with the patent documents contained in the inventory files of the Trilateral Offices,
- regarding filing tools and methods, the Offices agreed to begin investigations into a new sequence authoring tool,
- regarding search tools and methods, the Offices agreed to monitor biological sequence filing statistics and trends and collate these semi-annually in a common report starting mid-2000. Furthermore, it was also agreed to jointly investigate the use of external expert support for the development and management of a future common biological sequence search system,
- regarding the processing of sequence filings on paper, the Offices recognised a significant problem in that area and agreed to review the rules and procedures related to filing, priority document exchange and the publication of biological sequences with the aim of eliminating the paper sequence listing.

### **B2c: F-Term Translation and Classification Issues**

The Trilateral Offices agreed on the need for a common approach to classification, in

particular the reform of the IFC. They requested the working group on classification to prepare a common position before the end of April 2000, if possible.

The EPO and JPO took note of the status of FI translation as well as the plan for harmonising FI and ECLA.

### **B2g: Non patent literature**

The three Offices noted the comparative study on the use of Non Patent Literature (NPL) resources and instructed the working group to propose measures to improve access to NPL. In particular, the working group should propose:

- (1) common framework for the citation of documents in search reports
- (2) criteria to evaluate the efficiency of the use of NPL resources
- (3) optimal search techniques and/or training guidelines for retrieving NPL articles
- (4) recommendations for effective management of the copyright aspects

### **B2i: Quality of Exchange Data**

The Trilateral Offices agreed on the importance of data quality for their own work and for the scientific community. They took note of the measures proposed by the working group on data quality to improve the quality of the data to be loaded in their databases. As a first step, an error feedback reporting mechanism will be set up between the three offices.

### **B3a: Exchange of Search Results**

The ongoing concurrent search pilot project will be continued and evaluated in June 2000.

The JPO's proposal for a new project (monitoring of search results) was supported by the USPTO and EPO. It will be worked out in detail at expert level, for adoption at the next Technical Meeting.

### **B3b: Mutual Understanding in Search and Examination**

The JPO and EPO agreed to expand significantly the exchange of examiners in order to promote mutual understanding of search methods and tools, as well as to explore possibilities for improving the search environment.

The three Offices have shown their interest for a comparative study on business method related inventions. JPO and USPTO agreed to start such a study.

## **C: Dissemination of Patent Information**

### **GLOBALPAT**

The production of the GlobalPat CD collection for dissemination of the First Page Database was discussed. The USPTO confirmed its decision to end its participation in the project upon completion of production of the 1 998 data or in May 2000, whichever occurs first.

WIPO indicated that, subject to a SCIT decision in December, it was in favour of joining the project as it was a most important documentation tool for small and medium-sized patent offices.

## **MIMOSA**

The EPO indicated that Mimosa version 3.6 (authoring software) was recently made available. JPO has great interest in Mimosa version 4.0, and will participate in the cost of maintenance. The USPTO will conclude its participation in Mimosa as of the end of 1999. WIPO will study the possibilities of participating in the cost-sharing for Mimosa for the next two years.

## **WEBSITES**

The Trilateral Offices agreed to study and make proposals on common criteria to measure the activity of the different websites. The same group will also study the compared functionalities of the websites, including WIPO.

## Annex 1

### Action Plan for PCT On-line Filing

#### Background

This document, prepared by the Trilateral Offices, presents the actions required to progress from the current technical standard through pilots to an operational POT On-line Filing environment.

#### Decision Requested

Annex F and Appendices I and II are presented for consideration by the SC IT. This Action Plan is presented for adoption by SCIT.

#### Action Plan

When	What	Who
Dec 1999	Adoption by SCIT of this Action Plan. Discussion of Annex F and Appendix I.	SCIT
Dec 1999	Issue draft Administrative Instructions for review	IB
Jan 2000	Finalization of the PCT DTD	EPO, USPTO, JPO and IB
Jan — Jun 2000	Build IB Server to accept On-line Filings	IB
Jan — Mar 2000	Comments on draft Administrative Instructions	All PCI Offices
Mar 2000	Approval of Ticket Mechanism and definitions of its legal usage as well as of electronic signature mechanisms. Instructs WIPO DG to adopt AIs on e-filing	PCT Assembly
Apr 2000	Administrative Instruction, Annex F and Appendices adopted	WIPO DG (after consultation)
May 2000	PLT adopts Annex F and Appendices I/II for National and Regional filings	PLT Conference
June 2000	Adoption by SCIT of Appendices I/II as WIPO STxx.	SCIT
June 2000	Publication of Administrative Instructions	IB
July — Dec 2000	POT On-line Filing Pilots	IB with EPO, USPTO and JPO
July 2000 — Mar 2001	Preparation of DIDs for other POT documents	IB with EPOT USPTO and JPO
Jan — Mar 2001	Provide standard application test suites to encourage third-party software developments	IB with EPO, USPTO and JPO
Mar 2001	PCI On-line Filing operational	IB

