

# Summary of the Trilateral Conference

**Miami, 12 November 1998**

The European Patent Office (EPO), the Japanese Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the Sixteenth Trilateral Conference in Miami, Florida on November 12-13, 1998.

The Offices met to reconfirm their commitments to Trilateral cooperation based on common recognition of the importance of industrial property as a basic system supporting the progress of industry, technology, and economic growth.

## I. Follow-up of the Kyoto Action Plan

In order to adapt to the globalization of industry and trade and to improve the international patent system the Trilateral Offices adopted a common action plan in Kyoto, in November 1997. Significant progress has been achieved in the implementation of this plan dealing namely with deployment of the Trilateral Patent Network, the Trilateral Concurrent Search and Examination Project, and the Trilateral Website.

## II. Progress and Future Program of Trilateral Cooperation

The three Offices agreed on the following strategies and conclusions for each of the following projects:

### Project A1 Electronic Filing of Applications and Project A2 Networks and Data Exchange

Considering the growing geographic coverage of patent protection sought by applicants, the three offices have recognized the need for a harmonized approach for electronic handling of all interactive transactions among patent offices and with their users.

As a first step, the three Offices agreed on the infrastructure and standards needed for electronic communications and discussed them with WIPO. The standards, which relate to establishing a secure electronic environment including authentication, digital signatures, electronic wrappers and basic encryption, form the basis of all future electronic exchanges.

In addition, a Trilateral Network has been implemented and is currently being tested. This network will be extended to the International Bureau of WIPO in 1999,

Agreement has also been reached on the mechanism for electronic data exchange. For this, the "PUSH" mechanism will be the first to be implemented with the "PULL" mechanism to follow by the end of 1999.

The exchange of priority documents by CD-R will start in January 1999 between the JPO and the EPO. The USPTO will follow shortly afterwards. For PCT applications, the EPO will be involved in this exchange. It was also agreed to progressively implement the exchange of PCT, EP, JP and US publicly available search and examination data, including related cited documents, beginning in 1999.

The Offices agreed to build further applications based on these security, exchange and wrapping standards and to work in particular on further harmonization of Internet based filing. The three Offices also agreed to pursue the JPO's proposal to develop common standards for Internet based PCT filing systems. It is expected that on-line filing through the Internet will become the generally accepted way of filing over the next 24 months.

It was agreed that the Trilateral Offices and WIPO would support the general concept of an International Standard Application Format at the November 1998 PCT and PLT meetings.

#### Project A3 Management Information Exchange

The Trilateral Offices agreed to review the USPTO's proposal for a new joint research effort to build a global forecasting model. The EPO indicated its great interest for such a model. The Trilateral Offices agreed to conduct further discussions regarding this proposal in a meeting of experts prior to the Spring Technical Meeting.

The Trilateral Offices agreed to continue with annual meetings of the Trilateral Statistical Working Group and accepted recommendations made in the report for improving the Trilateral Statistical Report and forecasting methods.

#### Project B2a First Page Database Preparation

The Trilateral Offices affirmed the continued production of the First Page Database.

#### Project B2b Gene Sequence Database

The USPTO agreed to provide both the JPO and the EPO with the newest version of the PatentIn software (both source and object code) as soon as it is available, to respond to the EPO's wish for improved PatentIn training materials, and to provide help desk feedback.

It was further agreed to meet as soon as possible with the database providers. (DDBJ, EMBL, and NCBI/GenBank) to discuss 1) the need for a separate patent sequence repository, and 2) collaboration in future web based versions of PatentIn.

#### Project B2c F-Term

The USPTO agreed to distribute all translated themes to the EPO and the JPO by January 31, 1999.

The Trilateral Offices agreed to conduct a thorough review of the work product by April 1, 1999 and that discussions concerning dissemination of the translated F-Term themes be discussed at the Spring Technical meeting.

The JPO agreed to provide translated updates when changes in the F-Term themes occurred.

The three Offices agreed to translate the FI into English. The JPO will present a project plan for the translation of the entire FT classification including a timeframe for the completion of the project.

#### Project B2f Data Capture

The USPTO agreed to provide the OCR back file capture tapes to its Trilateral partners in the September-November 1999 timeframe in "rich text file" format. The EPO agreed to provide test files of the EPO OCR captured patent data to the USPTO.

#### Project B2g Non-Patent Literature

The EPO agreed that, upon completion of their ongoing non-patent literature project and consultation with the copyright owners, it would share the results with the Trilateral partners.

#### Project B2h Linguistic and Search Tools

The Trilateral Offices agreed to an EPO proposal whereby each Office would prepare for the next Trilateral meeting a set of classification tools inventories which would assist in defining a specific course of action.

#### Project B3a Exchange of Search Results

The first results of the project initiated in Kyoto indicated improved quality of search reports as well as better mutual understanding of search methods and tools.

The three Offices agreed that the final report will include data regarding additional examiner time needed for concurrent searches in order to assess cost effectiveness.

The three Offices also agreed to implement a new Trilateral Concurrent study/pilot in 1999 in accordance with the attached document in Annex 1.

The points of contact from the three Offices will confer prior to February 1999, to further elaborate the procedures for this study/pilot including those involving search guidelines.

#### Project B3b Mutual Understanding in Search and Examination

The EPO and the JPO agreed to exchange examiners in the field of multimedia. The USPTO agreed to host two examiners from each of the EPO and the JPO for a period of 2-3 weeks in January 1999.

The Trilateral Offices agreed to continue the comparative study in biotechnology. The study would focus on selected areas covered in the previous comparative study, including DNA fragments, in order to update and improve the value of the

comparative study in an efficient manner in a shorter period of time. The JPO will prepare a proposal with a draft questionnaire to submit to the EPO and the USPTO on this issue.

#### Project C Patent Information Dissemination

The Trilateral Offices agreed to the revised information dissemination policy covering exchange data. (See Annex 2). The new policy allows each Office to make available to the public on an Internet service the data received from the two other Offices.

The Trilateral Offices decided to determine the steps necessary to conclude the production of GLOBALPat.

#### Project D Legal Issues

The Trilateral Offices agreed to cooperate with WIPO on the resolution of legal issues associated with electronic filing and records management for PCT applications.

#### PCT Automation Plan

The Trilateral Offices agreed to a joint concept for PCT Automation to be delivered to WIPO. The Trilateral Offices noted that determining the technical implementation and timing of the plan were the responsibility of WIPO.

## ANNEX 1

### **Trilateral Project B3a Trilateral Concurrent Search 1999 pilot program**

#### **Introduction: Trilateral Project B3A**

The results of prior search exchange studies show that when examiners were able to confer with each other regarding search strategies and fields of search in advance of performing searches, and then confer again to discuss and share the search results, the quality of search improves. This has proven beneficial for mutual understanding of search methods and tools. However, prior search exchange studies were limited to small numbers of fields of technology and in some instances, limited to PCT International applications. Furthermore, the prior search exchange studies were not cost effective for the Trilateral Offices since the Trilateral Offices were not able to recover the cost of examiner confers-al time and the cost associated with handling of international applications not filed in their respective Offices. At the Fifteenth Trilateral Conference held in Kyoto on November of 1997, the Trilateral Offices agreed to consider a USPTO proposal to possibly extend the study to include first actions on the merits, more types of applications and more fields of technology.

A USPTO proposal on a new study for 1999 was presented to the EPO and JPO at the June 1998 Trilateral Technical Meeting. Comments from the EPO and IPO regarding the USPTO proposal were received in July of 1998 and have been incorporated in the revised 1999 pilot program discussed below.

#### **1999 Concurrent Search Study**

Based upon a proposal from USPTO, the Trilateral Offices have agreed to initiate a new study/pilot program, concurrent search', to be undertaken in the second trimester of 1999. The emphasis of the project is to promote greater mutual understanding and further technical cooperation among the Trilateral Offices. An important aspect of this study/pilot program is to promote increased sharing of information among examiners in the three Offices and enhanced knowledge transfer with respect to both working methods and search tools. The new study will include all fields of technology. As a first stage, the three Offices have agreed to handle up to 150-200 applications up to the next Trilateral conference. If by October 1st the total applications reach this threshold, the Trilateral Offices will confer. The study will be first evaluated prior to the June Trilateral preconference to determine if the study should be modified or expanded.

In order to be eligible to participate in this pilot program, the following conditions must be met:

Search includes planning the field of search, performing the search, and providing the relevant attribution of the reference document(s).

- (1) A national/regional application must be first filed in the EPO, or the JPO, or the USPTO;
- (2) Corresponding applications must be filed in the remaining two Trilateral Offices;
- (3) The claims in the first filed application and the corresponding applications must be drawn to the same invention. Applicants will be required to provide a claims correspondence table which indicates how each claim relates to the corresponding claim in the other applications;
- (4) No first office action on the merits/search report has been issued on the application by any of the Trilateral Offices;
- (5) A request must be filed by the applicant in each of the Trilateral Offices for a specialized concurrent handling procedure. Each Trilateral Office will decide whether a fee is required with the request for specialized concurrent handling procedure. The request/petition will permit an Office to take the application out of turn (e.g., EPO's PACE program, USPTO's petition to make special procedure) or defer action until the application is ready for concurrent search; and
- (6) The request/petition filed in each Trilateral Office must include the application numbers and filing dates of the corresponding applications (if known) filed in the other Trilateral Offices.

Upon receipt of the request/petition, each Trilateral Office will notify the other Trilateral Offices that a request/petition has been filed. A copy of the claims in each application should be exchanged among the three Offices to make sure that the claims of the corresponding applications are drawn to the same invention. If the claims of the corresponding applications are not drawn to the same invention, applicant will be notified that the application is not eligible for participation in the pilot program.

Each Trilateral Office will notify the other Trilateral Offices when the corresponding application filed in its Office is ready for search, e.g., the application is complete and all formality checks have been performed, and will also notify the other Trilateral Offices the name of the examiner who will perform the search of the application in its Office. When the corresponding applications filed in the Trilateral Offices are ready for search, a concurrent search of the application will be performed. The Office with the first filed application will be the lead Office. The examiner of the lead Office will be responsible for initiating discussions/consultations among the examiners of the Trilateral Offices and for notifying the examiners of the other two Offices of the deadlines for exchanging data sheets, start of the search, and exchange of search results.

When the corresponding applications filed in the Trilateral Offices are ready for search, the following procedures will be conducted:

- (1) The examiner of the lead Office will notify the examiners of the other two Offices the due date for exchange of data sheets. Items 1 to 5 (and 6, if applicable) on the data sheet must be completed by each Office. Data sheets used in the current 1998 study (or a revised data sheet) may be used to record information and data to be exchanged.

(2) Within a set time period after the exchange of data sheets, the examiners of the Trilateral Offices will have a first consultation with each other prior to performing the

search to discuss the search strategies and fields of search as well as the search tools and other electronic data bases to be used. Examiners will confer by electronic media such as fax, telephone, or the Trilateral Network.

(3) Examiners of the three Offices will perform a comprehensive search based on the normal working methods for each Office;

(4) Within a set time period, the examiners of the three Offices will each complete a search report. Search reports will be exchanged among the three Offices and cited documents will be exchanged only upon request;

(5) Within a set time period after the exchange of search reports, the examiners of the three Offices will have a final consultation with each other to discuss and share the search results prior to the preparation of the next action

Quality of search should improve based on collaboration by examiners of the Trilateral Offices. The cost of examiner conferral time could be recovered by each Trilateral Office from applicants based on a fee that could be collected, if required by such Office, with the request for specialized concurrent handling procedure.

The 1999 study/pilot program is to be limited to collaboration of examiners of the Trilateral Offices prior to performing the search and thereafter to share the search results prior to the preparation of the office action/search report. The study will be first evaluated prior to the June 2000 Trilateral conference and a determination made as to whether the study should be modified or expanded.

## ANNEX 2

### Information Dissemination Policy

The goal of the three Offices (EPO, JPO, USPTO) is to achieve, to the extent technically feasible and economically viable, effective and widespread dissemination of patent information to all segments of the public. This goal applies both to patent data in electronic form produced by each Office and to patent data in electronic form obtained as a result of mutual exchange within the framework of trilateral cooperation (exchange data).

With respect to patent data in electronic form produced by each Office, the three Offices agree that the data will be provided to the public at no more than the marginal cost or cost of dissemination.

With respect to exchange data, the three Offices agree that, unless authorized in writing by the originating office and subject to conditions established for such distribution at the time of authorization,

1. exchange data will be for official use only by the receiving offices; and
2. exchange data will not be copied, in whole or in part, for distribution or sale to other entities.

The three Offices further agree that:

3. official use of exchange data shall be unrestricted and free of charge;
4. exchange data shall encompass, when available, all data produced as a result of backfile conversion;
5. costs for copying and shipping exchange data shall be borne by the providing office;
6. the EPO shall be entitled to provide exchange data to patent offices of its Member States to be used for the purposes and under the conditions for which the EPO receives it; and
7. the EPO shall forward to the JPO and the USPTO, to the extent required, all patent data in electronic form created by patent offices of its Member States which correspond to data exchanged among the three Offices, to be used for the purposes and under the conditions for which the JPO and USPTO receive exchange data.

#### Definition of **Official Use**

Official use means use by the receiving office:

- for official procedures, including search, examination and appeal procedures;
- for statistical and technical analyses, including searches on the state of the art;
- for purposes necessary to carry out the functions of the office.

#### Authorization to **Disseminate through Patent Libraries**

The three Offices authorize each other to provide public access to exchange data through patent library services.

Patent libraries within the meaning of the present understanding are:

- reading rooms or local search facilities administered by the three Offices and by patent offices of EFO Member States;
- non-commercial institutions which the three Offices authorize to disseminate patent information, and which are established and controlled by federal, state or local authorities, by universities or by non-commercial public or semi-public institutions.

### **Authorization to Disseminate as a Public Service**

Each office, having incorporated exchange data into search databases for official use, may decide to provide public access to all or part of these databases as part of a public service, for example, using the Internet.

The three Offices authorize each other to:

1. provide public access to exchange data where the data are incorporated as part of a notfor-fee public service;
2. provide pages of documents using normal browser capability; and
3. provide a document delivery service for a fee, following the principle of marginal cost or cost of dissemination.