

## **Summary of the Trilateral Conference**

**San Francisco, 9 November 2001**

The European Patent Office (EPO), the Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the Nineteenth Trilateral Conference in San Francisco, California on November 8-9, 2001.

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.

The Offices agree that the main issue they currently face is the increasing workload stemming from the growth of the number of applications both from national or regional origin or through the PCT. The Offices have implemented several strategies for addressing the situation: hiring a large number of examiners, improving the productivity of their work, and investing in automation and documentation tools. While these efforts are important, the Offices agree a greater common and coordinated effort needs to be undertaken to address the workload situation.

The Trilateral Offices agree to carry out a reflection on strategic issues related to the evolution of the patent system, including the PCT. This will include a better understanding of the users' needs according to the different industrial sectors, more flexibility in the implementation of the patent granting procedures, better use of exchanged search results based on a better understanding of search and examination carried out in the partner Offices.

In order to address these issues the Trilateral Offices agree to the creation of two work groups: one group to focus on medium/long-term strategic issues related to reduction of Office workloads and another group to explore technical solutions to the workload problems such as automation, networking, electronic filing, etc. The second group will also deal with the PCT expanded International Search Reports and changes to PCT Minimum Documentation necessitated by electronic searching. WIPO is invited to contribute to these working groups according to its expertise.

With this in mind, the Trilateral Offices agree as follows (conclusions arranged by project number):

### Project AI Electronic Filing of Applications

In order to guarantee continued harmonization of online filing software systems, the Trilateral Offices agree on a Change Management Procedure for Annex F of the PCT Administrative Instructions and its associated components that will be submitted by the International Bureau to the PCT Member States for comment and adoption. The Trilateral Offices propose that all changes be packaged together into

annual releases, except for emergency situations, that will come into force on January 1st of each year.

### Project A2 Networks and Data Exchange

To support the efforts of the Trilateral Offices to address expanding workloads and provide harmonization of data to facilitate communication with applicants, the Trilateral Offices agree to develop standards to encompass all office-applicant communications. This would support JPO's move to XML based systems and the USPTO's TEAM project scheduled in 2004 as well as the EPO's ongoing developments in **epoline**. A rationalized working group structure has been put into place as a result.

Because the exchange of priority documents represents a significant volume of documents, the Trilateral Offices reconfirmed the importance of reducing costs for the applicants and workloads in the Offices through the electronic exchange of priority documents.

The Trilateral Offices agree on the Trilateral Network (TriNet) Security Policy and the operational procedure for the TriNet Security Authority. The Trilateral Offices also agree on additional specific requirements of the Draft Protocol for Adding New Members to the TriNet.

### Project A3 Management Information Exchange

The Trilateral Offices will present by 31 December 2001, a revised format of the Trilateral Statistical Report. The 2001 Report will expand statistical information such as the number of PCT applications in the national phase for each Trilateral region and the number of applications filed from one Trilateral region to another independently from the number of designations. This data should promote trilateral cooperation and will enhance public understanding of the global patent process.

The Trilateral Offices confirm that the data used for forecasting patent filings in each region will be further expanded in the coming year as a further step toward cooperative forecasting, and that the offices will continue to cooperate in preparing a joint applicant survey, which is tentatively planned to be launched in 2003.

### Project B2b Gene Sequence Database

The Trilateral Offices agree to investigate the creation, in the long term, a wrapped application document on a CD with a human readable certification for exchanging priority documents for biological sequences and for processing biosequence applications. The Trilateral Offices also agree to explore the possibility of creating a unified database approach related to storage and methods for disseminating sequence data.

The Trilateral Offices agree to recommend a review of a revision, of ST.25 to examine the question of Inventor's name field. The database providers NCBI, EBI, and **DDBJ will be** consulted on the revision. The Trilateral Offices agree to

propose a discussion of this issue at the next Standards Working Group of the Standing Committee of Information Technologies.

#### Project B2c F-Term/Classification Issue

The three Offices agree to work towards a common classification as a means towards coping with increased workloads.

To accomplish this goal, the Trilateral Offices will redirect their classification resources towards a common system through cooperation in reclassification projects concentrating in the most active technologies.

The Trilateral Offices recommend that this harmonized system will form the basis for the advanced level of the International Patent Classification.

#### Project B2g Non-Patent Literature

The Trilateral Offices will collaborate on a list of desired capabilities for the electronic presentation and searching of defensive publications. Recognizing the increasing importance of non-patent literature, the Trilateral Offices also agree to begin an effort to share data related to their non-patent literature databases.

#### Project B2j Data Exchange/Data Quality

The Trilateral Offices agree to establish a working group related to the exchange of search results preferably in an electronic format. The working group will review both the exchange of national search results and search results for PCT cases.

#### Project B3a Exchange of Search Results

#### Paris-Route Pilot Program

The Trilateral Offices adopted the final report on the 1999 Paris-route pilot concurrent search program and agree to publish the report on the Trilateral Web site.

#### Use of PCT cases with Focus on Business Method Applications

The Trilateral Offices conducted a concurrent search program using 20 PCT business method related inventions. The three Offices adopted the final report and agree to publish the final report on the Trilateral Web site. The three Offices agree to further exchange of information in this field for search tools and practices under the Trilateral cooperation for Patent and Non-Patent Literature.

#### Investigation of use of ISR

The JPO and EPO reported the results of the investigation of the use of TSR, in particular, with respect to an analysis of additional documents used during the regional phase. The study confirms that citations in the international search report

are beneficial for reducing the workload during the further processing of the application by other offices. The study also shows that the degree of convergence of search results varies significantly with the technical field.

The JPO and EPO will proceed with a more detailed evaluation and report the results during the next Trilateral meeting.

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

The Trilateral Offices adopt the report on the comparative study conducted by the three Offices on “reach-through claims” (claims to future inventions based on currently disclosed inventions) and agree to publish the final report on the Trilateral Web Site since it would provide useful information to the user community on the patentability of such claims.

The requirements for industrial applicability, utility, enablement, support, clarity and written description requirements of hypothetical claims were discussed in the report, and the Trilateral Offices were found to have similar opinions concerning these requirements.

The Trilateral Offices also agree to continue the project of information exchange concerning utility requirement of nucleic acid related inventions whose functions are inferred based on homology search.

The EPO and JPO agree to continue exchange visits for examiners and to expand the scope to include the entire granting procedure for both search and examination. They also agree to expand the visits to managers to gain a better understanding of management practices at the respective offices.

#### Project C Patent Information Dissemination

The Trilateral Offices express interest in developing standards for patent documentation on Intellectual Property Digital Libraries. The USPTO will draft a questionnaire for determining the scope of the Intellectual Property Digital Library effort.

The Trilateral Offices finalize their Information Policy covering exchange data (See Annex 1). These guidelines will be made available to WTPO for its own dissemination policy and be a reference for other countries.

## ANNEX 1

### TRILATERAL OFFICE POLICY ON THE USE OF EXCHANGED ELECTRONIC INDUSTRIAL PROPERTY INFORMATION DATA

#### INTRODUCTION

The Trilateral Offices exchange industrial property information data (e.g., document images, text data, bibliographic information, etc.) for the mutual benefit of each Office 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 made between the Offices involved in the exchange. The policy on the use of this data is set forth below to provide uniform minimum guidelines for using the data being exchanged. The Trilateral Offices may, of course, agree to more liberal use of their data.

#### DEFINITIONS

1. **“Bulk transfer”** of data is considered to occur when the amount of data downloaded or copied in electronic form equals or exceeds an amount that would conflict with a normal commercial sale of the data by, or otherwise unreasonably prejudice the legitimate interests of, the Office providing the data. The term “bulk transfer” is used in reference to unauthorized activities.

2. “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 controlled by public or private universities or foundations in accordance with requirements of a Trilateral Office) for the dissemination of information to the public.

3. A **“Member State”** is an individual Industrial Property Office belonging to an organization of Industrial Property Offices, e.g., the European Patent Office (EPO).

A **“third party”** is any Industrial Property Office, organization, individual or enterprise which is neither the data providing Office nor the data receiving Office (or its Libraries or Member States).

4. **“Internal use”** of data consists of “official use” and “library use” as provided for below:

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

(i) in the course of official procedures for the grant of industrial property titles, including search, examination, maintenance and appeal procedures;

(ii) for the purpose of statistical and technical analyses as well as searches of

- the state of the art, necessary to carry out the official business, of the Office;
- (iii) to provide an inquiry service for the public to meet specific requirements of individual and corporate users based on their own needs, e.g., providing copies of patent documents or bibliographic data upon the request of a user;
  - (iv) 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
  - (v) for the purpose of providing copies of the data for the use of the receiving Office or library.
- (b) “Library use”** is the use of data by members of the public in search rooms of Industrial Property Offices or in libraries (as defined above).

## POLICY

1. Industrial property information data provided as part of a free exchange by a Trilateral Office to another Trilateral Office is provided only for the internal use of the receiving Office.

2. A Member State of the EPO is authorized to use the data provided to the organization to which they belong only if they agree to follow the guidelines regarding the use of the data as provided herein.

The EPO will provide the data of its Member States to other Trilateral Offices as part of an exchange of data and in accordance with these guidelines.

3. The receiving Office, unless authorized in writing by the Office providing the data and subject to conditions established for such distribution at the time of authorization, must agree that:

- (a) the bulk transfer of the data by a receiving Office to a third party is prohibited;
- (b) the data shall not be passed on in machine-readable form to a third party in such manner that it enables the third party commercial use of the data as such;
- (c) the data will be provided to the public at no more than the cost of dissemination.

## SPECIAL CASES

**1. Authorization to Disseminate as a Public Service** — A receiving Office, having incorporated exchange data into search databases for internal 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 receiving Office is authorized to:

- a) provide public access to exchange data where the data are incorporated as part of a not-for-fee public service; and
- b) provide pages of documents using normal browser capability.

**2. Electronic data purchased from an Office** — The above policy applies only to electronic data obtained by a receiving Office as part of a free exchange of data with the Office providing the data. Electronic data purchased from another Office are not necessarily subject to this policy and may be subject to any limitations agreed to by the Offices involved.

## OTHER EXCHANGE-RELATED CONCERNS

### **1. Exchange of backfile data**

In order to provide a receiving Trilateral Office with a complete copy of a given type of data, the exchange of data shall encompass all available backfile data, e.g. data produced as a result of backfile conversion, etc.

### **2. Copying and shipping costs**

The costs of copying and for shipping exchanged data shall be borne by the Trilateral Office providing the data.