IP5 NET/AI Task Force

Scoping document

1. At their annual meeting in June 2019 the IP5 Heads of Offices endorsed the establishment of the IP5 New Emerging Technologies and Artificial Intelligence Task Force (NET/AI TF) as the IP5 body in charge of coordinating and analysing NET and AI-related issues across the IP5 and proposing a roadmap for potential joint work on NET and AI by the IP5 Offices. The approved project brief is annexed.

2. In accordance with this project brief and following the first meeting of the IP5 NET/AI TF (15 - 16 January 2020, Berlin) the present document outlines the scope for potential joint IP5 activities in the area of NET/AI ("scoping document").

3. The task force investigated candidate co-operation topics in three different areas: legal, IT and strategic. The identified candidate co-operation topics will be further analysed and elaborated in the comprehensive roadmap for the IP5 Offices' approach to NET and AI, which will form the basis for specific project proposals by the relevant working groups and recommendations for policy developments.

Area 1 - Legal aspects of NET/AI

Objective

4. Not least due to the complexity and the interdisciplinary character of the subject matter a considerable degree of uncertainty appears to surround issues relevant to AI driven innovation and the patenting of AI related inventions. While each IP5 Office undertakes significant efforts to clarify associated practice issues with its domestic users and stakeholders, detailed guidance appears to be lacking on how innovators can best acquire robust patent protection for their inventions in multiple jurisdictions and, hence, ensure better return on their investments.

5. The TF is of the view that the IP5 Offices should endeavour to address this uncertainty, facilitate better understanding of the applicable legal frameworks and practices particularly as regards, but not limited to, issues such as patentable subject-matter, inventorship and sufficiency of disclosure. This should be done by pursuing a pragmatic approach and concentrating efforts on the mapping of differences and similarities in the applicable laws and practices, the promotion of user awareness and guidance to IP5 examiners. Ultimately, such efforts should promote predictability and consistency as regards the international patenting of NET/AI-related inventions especially for those users seeking patent protection in the IP5 regions. Also due to the challenges intrinsic to the harmonisation of substantive patent laws the TF understands that the outlined approach holds significant potential and can yield timely results to the benefit of the users.

Possible projects

6. In support of the outlined objective it is proposed to consider:
   - developing resource material better illustrating examination practices (such material could utilise case examples available at the IP5 offices' respective practice manuals, examination guidelines, etc.);
   - conducting comparative case studies elaborating commonalities and differences that could assist applicants in navigating the grant procedure at the IP5 Offices;
   - sharing material and study results with broad stakeholder circles, such as IP5 Industry;
   - providing a compilation of useful links to relevant legal texts and resources of the IP5 Offices, e.g. respective sections of examination guidelines, practice manuals, etc.

Area 2 - IT aspects/utilisation of NET/AI

Objective

7. In terms of promoting efficiencies the advancement and wide spread use of NET/AI suggests a substantial opportunity for office operations. Despite the differences in the structure of their working methods and procedures, the IP5 Offices essentially operate in a similar manner, handle tasks of rather identical nature and, most notably, encounter common operational challenges to a considerable extent. Hence, it is evident that a joint exploration of the potential of NET/AI and a concerted consideration of solutions potentially suitable for the business scenario of patent offices could greatly benefit all IP5 Offices in an equal manner.

8. In better understanding how NET/AI can be employed in office operations the TF proposes that the IP5 Offices should pursue a phased approach. Initially, collaborative efforts should focus on the identification of challenges in operations that call for business solutions. Subsequently, the specific, underlying business problems that the offices endeavour to solve by utilising NET/AI should be clarified and clearly articulated also in consideration of the specific type of information required for each office. Once such information has been collected and processed, the IP5 Offices should be able to share detailed knowledge and know-how that could be adapted for use in other systems and, eventually, consider exchanging data sets. High quality data and the development and use of common or comparable metrics could support these efforts.

Possible projects

9. In support of the outlined objective it is proposed to consider:
   - identifying operational challenges common to the IP5 Offices, clarifying specific business problems and sharing related best practices;
   - gathering information on NET/AI implementation at the individual IP5 Offices;
   - sharing knowledge, know-how and data sets in a structured manner, supported by metrics;
   - exploring whether and how NET/AI could be utilised in the area of classification.

Area 3 - Strategic outlook

Objective

10. In addition to the challenges for patent law and practice and the potential opportunities for efficiency gains in office operations the rapid development and exponential use of NET/AI essentially impact on policy and strategy considerations of the individual offices. While the policy making processes of the IP5 Offices differ considerably, an open exchange as to the "bigger picture" implications of NET/AI for IP, the economy and society at large is useful, if not necessary.

11. The TF acknowledges that NET/AI already impacts a wide range of stakeholders, such as the patent offices and their examiners, researchers, innovators, industries and the users of the patent system as a whole. A thorough understanding of key trends, but also of problems, needs and expectations of those concerned is essential for an informed, broader dialogue towards formulating balanced policy responses at the individual IP5 Offices. Similarly, continuous information exchange and experience sharing, increased outreach and strengthened engagement with stakeholders can promote the IP5 Offices' understanding of key technology trends and market

developments which may potentially shape longer-term perspectives on patent protection in the service of innovation and how the offices operate.

Possible projects

12. In support of the outlined objective it is proposed to consider:
    - strengthening the communication and co-operation with stakeholders, with a view to better understanding users' needs;
    - developing a catalogue of common policy considerations;
    - keeping up with trends and market developments.