



## Trilateral Users Day

November 13, 2008 (The Hague)

### “Sustainable Patent Systems”

Presented by **Steven W. Miller**  
*President*

Intellectual Property Owners Association (IPO)



© 2008 Intellectual Property Owners Assoc. (IPO)

Prepared by IPO, Nov. 2008

© 2008 Intellectual Property Owners Association

## Intellectual Property Owners Association (IPO)

- Trade association of **more than 200 companies, with more than 10,000 individuals involved**, from companies, law firms, and individual members. Established in 1972.
- Represents interests of IP owners from all major industries.
- Advocates greater legal certainty and more effective and affordable IP rights in the U.S. and abroad.
- Members file approximately 30% of the patent applications filed at USPTO by U.S. nationals.
- Monitors the courts, and especially the Federal Circuit, and submit *amicus* briefs on significant IP issues.
- Provides education on IP issues.



Slide 2

Prepared by IPO, Nov. 2008

© 2008 Intellectual Property Owners Association

## IPO Supports Objectives of Trilateral Office Cooperation

- **Enhancing Work-Sharing:** Mutual utilization of patent examination results-for example, through PCT
- **Improving Patent Quality**
- **Realizing Harmonization**



Slide 3

Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association

## Advantages of PCT – User’s Perspective

- **One Filing = Many Countries**
- **Standard Format/Same Claims**
- **Preliminary Search**
- **Delay Payment of Fees**

Result: Lower Cost, Less Time, Better Quality throughout most countries



Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association

## **IPO believes patent owners and other patent system users need:**

- I. High-quality issued patents;**
- II. Early determination of rights; and**
- III. Cost-effective determination of rights.**

*Essential to achieving the above is quality patent examination and prosecution.*



Slide 5

Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association

## **Patent Quality**

From the Corporate Perspective

- **Recommendations on Process** – What is needed to ensure a high-quality patent that will hold up in the marketplace?
  - Actions needed by Patent Applicants and Owners (Quality is a Shared Responsibility)
  - Actions needed by Patent Offices
- **Measuring High-Quality Patents**
  - What criteria should be used to measure high-quality examination?



Slide 6

Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association

**Quality patent prosecution must:**

- Provide maximum scope of protection at lowest cost.
- Be consistent with global business strategy and related patents and applications worldwide.
- Result in valid and enforceable claims that provide clear notice to others.
- Guarantee that the best prior art is fully considered by the examiner.

**Applicants must:**

- Define business objectives before drafting and prosecuting application.
- Support business IP strategy and patent portfolio development with the application.
- Focus from start of prosecution on precisely what is the invention.

**What actions should corporate filers take to ensure quality examination?**

**Start with a Knowledge of the Prior Art**

**End with Quality Claims**

- Corporate filers measure the quality of granted claims based on claims that:
  - clearly and thoroughly protect all aspects of invention embodied in newly commercialized product or process and defend strategic goals;
  - recite the uses of invention in all appropriate streams of commerce.

## Recommendations for Preparing a Quality Patent Application and Expediting Its Examination Before a Patent Office

- Be knowledgeable of the prior art (cite it to the Patent Office).
- Draft your patent application in standard format.
- Avoid repetitive or inconsistent language when drafting your patent specification.
- Draft your specification and claims in light of the known prior art.
- Document why changes in the claims were made, and make sure your prosecution record is clear.
- Set out clearly features of your invention to provide explicit basis for any claims you draft.



Slide 9

Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association

## Best Practices for Preparing a Quality Patent Application and Expediting Its Examination Before a Patent Office (cont'd)

- Wherever possible provide data in your specification showing how your invention works.
- Ensure that any data you provide is intelligible to a normal practitioner in the field.
- Draft clear and unambiguous independent claims and use multiple dependent claims judiciously.
- Check your application thoroughly before you file.
- Seek assistance from your local patent office or retain a qualified and experienced patent attorney.



Slide 10

Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association

## Patent offices will grant high-quality patents if they:

**Patent Quality**  
Actions By Patent Offices

- **Insure an independent search and examination**
  - Do not depend solely on applicant's search or analysis
  - Share results with other patent offices in real time
- **Provide incentives for quality**
  - Shift examiner incentives toward quality and away from goals based purely on production
- **Rely on meaningful measures that can improve the end result. Share measures with other offices and the public.**
- **Train examiners in new technologies.**
- **Provide rejections or allowances that are well reasoned, thorough and clear.**
- **View applicants as part of the solution, not the problem.**



Slide 11

Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association

## Recommendations for Patent Offices

- Implement a checklist to ensure that examiners have thoroughly reviewed the specification and claims.
- Require examiners to more rigorously apply the requirements for an adequate disclosure.
- Use software tools available to identify terms in claims not referenced in the specification, etc.
- Collect more data indicative of examination quality.



Slide 12

Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association

## Recommendations for Patent Offices

(cont'd)

- Permit interviews before first office action.
- Assign related applications to the same examiner.
- Locate patent offices in areas with lower costs of living.
- Increase the amount of training and guidance given to new examiners.
- Use a “second set of eyes.”
- Review patent office actions when a patent is invalidated by the courts.
- Search for patent families of the application under examination and review search reports in such patent family members.



Slide 13

Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association



## Intellectual Property Owners Association (IPO)

1501 M Street, NW

Suite 1150

Washington, DC 20005

Phone: 202-507-4500 Fax: 202-507-4501

[info@ipo.org](mailto:info@ipo.org) | [www.ipo.org](http://www.ipo.org)



Prepared by IPO, Nov. 2008  
© 2008 Intellectual Property Owners Association