

## Summary of the Trilateral Conference

Tokyo, 7 November 2003

The European Patent Office (EPO), the Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the 21st Trilateral Conference in Tokyo, Japan on November 7, 2003,

- Recognizing industrial property as a basic system supporting the progress of industry, technology, and economic growth, and the need for close cooperation in the administration of their Offices, and their national industrial property protection systems,
- Reconfirming the importance and the benefit to harmonize their industrial property systems and to develop common infrastructure for improving further efficiency,
- Renewing the awareness of the important role of the Trilateral Offices to contribute to international economy,

have reached the understandings on co-operation between the Offices as follows:

### **Project WM1-3: Effective access and use of work results, Mutual understanding in search and examination, Examiners' exchange**

The Trilateral Offices' evaluation of the bilateral search exchange projects has shown potential benefit for reduction of workload by exploiting the search results from another office.

The Trilateral Offices intend to continue to pursue further work in this area through feedback and analysis of the results by the office of second filing to the office of first filing. They will provide feedback information including any further office actions with search histories for additional searches, claims and qualitative commentary.

The Trilateral Offices will establish a common infrastructure (on-line dossier access system) that enables constant and effective access to the electronic dossier.

The Trilateral Offices endeavour to study ways and means how applicants may benefit from the use of search and examination results in the office of second filing. The Trilateral Offices will continue to explore appropriate policies and other

procedural considerations including existing Information Disclosure Statement (IDS) obligations to promote the exploitation of search and examination results.

The Trilateral Offices will promote the exchange of examiners in early 2004 to discuss search tools, search methodology/requirements, and search strategy.

The Trilateral Offices intend to study at the Biotechnology Working Group the standardization of search strategy in the chemical and biotechnological fields, especially in chemical compounds and the use of publicly known compounds for medicine with recognition that the effective exploitation of search will be achieved where the search tool is common among the Trilateral Offices.

### **Project EB1-3: Electronic Filing and Electronic Processing**

The Trilateral Offices will further explore solutions that promote efficient application processing with the aim to contribute to more efficiently mastering the workload stemming from the growth of the number of applications from national, regional and PCT systems as well as the growth in “global” Industrial Property applications.

Building on the success of their existing automated administrative systems and as a logical extension of the activity of the Trilateral Working group on Workload Reduction, the Offices have mutually decided to address the usefulness of a common technical infrastructure for the IP Offices around the world, with the goal of workload reduction for all offices and users involved. This will be achieved by harmonizing interoperability of e-filing and e-processing/dossier-access systems leading to a more efficient processing of applications.

The Trilateral Offices will join forces in the lead of this project and set up a Trilateral Steering Committee which will identify the project strategy and guiding principles for going forward with this project. This project will focus on:

- Defining a common set of technical interface standards that will ensure interoperability between the Trilateral Offices and the non-Trilateral Offices of IP e-business systems. These standards will include Dossier Access with translation into English when technically available, Priority Document Exchange and Integration of e-filing.
- Defining and further developing a common user-friendly e-filing server solution as documented in the Memorandum of Understanding signed at the Vienna Trilateral meeting in November 2002.
- Defining and further developing both a single configuration of hardware and software application processing system (“toolbox” based approach) and an alternative approach based on building a single standard English language

interface to an existing end-to-end application processing system (“interface” based approach) within an IP Office.

Each implementation is subject to the availability of resources and contingent upon successful implementation and testing of all software components.

The Trilateral Offices will elaborate the strategy of cooperation towards interested non-Trilateral Offices under the proviso that any such office is free to choose between the “toolbox”- and “interface”-based approaches. During calendar year 2004, discussions will be held to identify at least two Intellectual Property offices with whom such a strategy could be initially piloted. Each implementation would have one lead Trilateral Office with the other two offices offering support as needed.

The Steering Committee will be composed of at least two members per Office. Proposals for these members are expected to be exchanged by mid-December 2003 in order to allow a first meeting of the Steering Committee in mid-January 2004 with representatives of the pilot Offices.

### **Project WT1: Linguistic tools**

The Trilateral Offices recognized the importance of machine translations introduced by the JPO and their intention to co-operate in the Machine Translation System project as set forth in Annex 1 of the Trilateral Technical Meeting Report (“Agreement on Co-operation in Machine Translation System”) prepared at the Trilateral Technical Meeting held in Tokyo in June, 2003. The JPO will develop and maintain the “Trilateral JA-EN Machine Translation System” at its expense while the EPO and the USPTO will give the JPO feedback on the correctness of the translation to improve the dictionary. The JPO will make every effort to complete Phase 1 by March, 2004 and Phase 2 including dossier access by October, 2004, respectively. The EPO will seek to provide the JPO and the USPTO their translation services in the future (e.g., French to English).

### **Project MAN: Management Information Tools**

The Trilateral Offices took note of the publication of the Trilateral Statistical Report 2002.

The Trilateral Offices will start the project to exchange business information data.

The Trilateral Offices mutually decided that WIPO should participate in the Trilateral Statistical Working Group beginning in 2003 onwards as observer on the projects related to Statistics and Forecast, and that WIPO will have access to the shared file on annualised patent filing data and forecasts under the condition that it

was for internal use only. The shared file would continue to be administered by the Trilateral Offices and updated by the end of April every year.

### **Project PI1: Patent Information**

The Trilateral Offices concluded that their IP information dissemination policies are very similar.

The Trilateral Offices reaffirmed the importance of sharing their views and opinions on these issues to appropriately deal with new issues and to continue to seek coordination on these issues. The Trilateral Offices will continue to exchange information regarding the IP information dissemination policies.

The JPO and the EPO mutually decided to further develop their cooperation to present to the public Japanese patent information in Europe and European Patent Information in Japan.

### **Project LEG: Legal issues**

<Harmonization of the patent law>

With a common view that patent law harmonization would contribute to easing work load problems of patent offices as well as the burden on applicants, sharing views that patent law harmonization is important and achievable, the Trilateral Offices recognize the following guiding principles to progress discussions on patent law harmonization;

To take a pragmatic approach aimed at early and realistic results rather than to pursue lengthy theoretical debates,

To aim towards a package without adherence to a rigid framework,

To pursue best practice taking into account current practices,

To address users' interests as much as possible, and

To promote the discussion at the WIPO/SCP.

The Trilateral Offices have identified two categories of items for consideration in the context of patent law harmonization and have tasked them out to the working group already established by the Trilateral Offices.

(1) First package items likely to produce agreement in near future, such as next meeting of SCP in May 2004

|   |
|---|
| Prior art**   |
| Hilmer Doctrine   |
| Anti-self-collision   |
| Prior art effect of PCT Applications in the International phase |
| Prior art effect of Earlier applications for Inventive step     |
| Grace period***   |
| Novelty**   |
| Inventive step/Non-obviousness**                                |
| Sufficiency of disclosure*                                      |
| Claim drafting****  |
| Restriction / Unity of invention                                |
| Amendments/ Correction  |

\*Under this item, the working group will discuss at least the items regarding best mode, deposit practice, enablement and support requirement, and any further items that the working group may decide to discuss.

\*\*Discussion on double patenting will be included.

\*\*\*Since it is accepted that the item of grace period and first-to-file/first-to-invent are linked, grace period, although included for discussion in the “first package”, is subject to movement on first-to-invent.

\*\*\*\*Under this issue, the working group will discuss claim interpretation during the course of patent granting process, but not during litigation.

In the working group, priority will initially be given to the items relating to prior art, grace period, novelty and inventive step/non-obviousness.

(2)Items to be addressed at a later stage

|                               |
|-------------------------------|
| First-to-file/First-to-invent |
|-------------------------------|

|  |
|--|
| Patentable subject-matter /technical character |
| Utility/Industrial Applicability               |

<Claims fee>

The Trilateral Offices supported the concept of claims fee under the PCT in principle and continuation of discussion.

**Project IT3: TRINet**

The Trilateral Offices supported the proposal to interconnect TRINet, WIPONET, and PatNET, based on secure Internet technology.