

Summary of the 24th Trilateral Conference

Tokyo, 17 November 2006

The European Patent Office (EPO), the Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the 24th Trilateral Conference in Tokyo, Japan on 17 November 2006. The Trilateral Offices

- reconfirming their commitment to Trilateral co-operation based on common recognition of the role of industrial property as a basic system supporting the progress of industry, technology, and international social and economic growth,
- identifying timely processing of increased workloads of patent applications and high-quality examination processes as common objectives of the Trilateral Offices and its user communities,
- recognising the benefits of further promoting mutual exploitation of search and examination results, continuously making efforts to increase mutual reliability, promoting the reduction of processing time/cost, and avoiding duplication of work through a co-ordinated Trilateral approach,
- understanding the benefits of harmonising substantive patent law, patent procedures, and standardisation of patent application format,
- recognising the benefits of developing a common infrastructure and compatible data for electronic business systems and search tools and promoting character-coded electronic document format in order to facilitate co-operative activities,

understand as follows:

Enhanced Work-Sharing

The Trilateral Offices recognize the need to take enhanced and concrete measures to avoid duplication of work among the Offices and to reduce workload of the Offices and procedural / financial burden of users.

To address these concerns, it was decided to expand the mandate of WM1 (Effective access and use of work results) and entitle it as "Working Group on Enhanced Work-Sharing," which will undertake actions to further develop the mutual exploitation of search and examination results performed by other Offices, to the maximum extent practicable

The Strategic working group will oversee the activities of the Working Group. The Strategic working group will provide the Working Group a mandate consistent with the scope of activities agreed above at its Spring 2007 meeting.

Re-use of Work Results

(a) Patent Prosecution Highway

The Trilateral Offices confirmed that the Patent Prosecution Highway (PPH)

may enable users to expeditiously obtain a foreign patent at an early stage and contribute to reducing the examination workload of an Office.

The JPO and the USPTO have been operating a pilot program since July 2006. The EPO will positively consider participation in the pilot program based on the results of the USPTO-JPO pilot program.

The Trilateral Offices will continue to evaluate the current status of the pilot program and consider opinions from users and modification of the PPH framework for improvement.

In addition, the Trilateral Offices will consider implementing the Patent Prosecution Highway in cooperation with patent offices outside the Trilateral framework.

(b) Tri-Way

The USPTO proposed a Trilateral search sharing project in which the Trilateral Offices would conduct on the applicant's request, sequential but closely timed, complementary searches focusing on their respective documentation. The Trilateral Offices confirmed that the USPTO's proposal was a useful option for those applicants who wished to obtain high quality search results.

With a view to launching a pilot project, the Trilateral Offices will continue to discuss the Triway particularly from the viewpoint of workload reduction as well as the users' needs.

(c) Maximized work-sharing

The USPTO introduced a new work-sharing proposal for consideration and discussion in which Offices would focus on first-filed applications and take up second-filed applications only when search/examination information is available from the office of first filing.

The EPO and the JPO will contribute actively to the study of this possibility.

(d) Common Search Templates

The Trilateral Offices are considering the evaluation of the usefulness of exchanging the search approach and the database information being used by examiners. The Trilateral Offices will choose the specific technical fields on which the basis of cooperation among the Trilateral Offices was established and consider starting a pilot project with the objective to create common search templates.

(e) Utilization of Document Access Tools by the Examiners

In order to promote the mutual exploitation of search and examination results, the Trilateral Offices are developing the Trilateral Document Access (TDA) system, which enables the examiners of one Office to electronically access and view the contents of patent application wrappers filed in other Offices.

The Trilateral Offices reported on the usability of tools which enabled

examiners to access and view patent file wrappers via the TDA and the Web and confirmed that the tools were very useful in terms of exploiting the search and examination results of other Offices. The Trilateral Offices confirmed that it was important to improve the utility of the system and promote the usage of the tools.

The Trilateral Offices confirmed that the usage of Document Access Tools and feedback from examiners could be an important index for analyzing the current status of and problems with the exploitation of search and examination results of the other offices as well. The Trilateral Offices will continue to share information on usage of the tools by examiners and improve the tools.

(f) Import Guidelines

The Trilateral Offices have been discussing the importation of a document acquired from one Office through electronic access tools into a file wrapper of another Office. The Trilateral Offices adopted the guidelines at the Conference in 2005 which allowed the importation from published application of the following: (1) Application as filed (Request, Claims, Description, Drawing, etc.) (2) A List of cited references, (3) References cited by examiner, and (4) Search reports of those applications.

The Trilateral Offices confirmed that discussion would continue on the Import Guidelines, aiming at the expansion of the scope of documents which could mutually be imported, taking into consideration benefit of users and the mutual exploitation of search and examination results.

In this regard, the JPO and the USPTO will continue to discuss various measures to facilitate compliance by applicants with the Information Disclosure Statement (IDS) duty in the U.S.

Trilateral Patent Examiner Exchange

Based on reports on the examiner exchanges conducted at the USPTO in May and at the EPO in October of 2006, the Trilateral Offices confirmed that Trilateral examiner exchanges were significantly useful for examiners to understand the patent systems and examination practices of the other Offices and for fostering mutual trust among examiners in the Offices.

The Trilateral Offices also confirmed that the understanding of the patent systems and examination practices of each Office and the mutual trust shared by the Offices would be the basis for promoting the mutual exploitation of search and examination results. Furthermore, the Trilateral Offices recognized Trilateral examiner exchanges to be very meaningful opportunities for engaging in and verifying the success of pilot projects, such as common search templates and the Harmony projects on classification.

Taking into account the results obtained from the previous exchanges, the Trilateral Offices will start preparations for the next exchange which will be held at the JPO in the spring of 2007.

The Trilateral Offices will continue to conduct Trilateral examiner exchanges

after the present round.

The Trilateral Offices confirmed that the next round of the Trilateral exchanges will start at the USPTO in autumn of 2007.

Comparative Study on New Technologies

The Trilateral Offices confirmed that they should continue to discuss the proposal of the USPTO for a comparative study concerning examination practices and exchange of information about the definition and the classification in the field of nanotechnology.

Electronic Access to Patent Application File Contents

(a) Trilateral Document Access (TDA)

The Trilateral Offices agreed on the TDA-File Wrapper Access Service Level Agreement. Regarding the TDA change management process, a pilot procedure will be undertaken by the Trilateral Offices based on the draft proposal from the USPTO. The next version of the TDA specifications, concerning the USPTO-JPO PDX project and the handling and viewing of cited documents will be implemented using this pilot procedure.

(b) TRINet

The Trilateral Offices agreed that a Technical Working Group meeting will be held in January at the EPO to consider the introduction and discussion of both ongoing and future TRINet projects and issues.

(c) Compatibility of IT Systems

The Trilateral Offices confirmed the necessity of changing the contents of ANNEX F corresponding to technical developments, and the importance of keeping the principle of interoperability, confidentiality, integrity and authenticity. Moreover, it was confirmed that all changes of ANNEX F must be treated through the Proposal For Change process.

The Trilateral Offices also agreed to continue discussion on setting up a governance structure to reinforce interoperability.

(d) PCT paragraph replacement issue

The Trilateral Offices and the WIPO confirmed to keep discussing this issue at future trilateral meetings and the WIPO will lead this discussion.

Exchange of Priority Documents

The Trilateral Offices confirmed their support for this concept and their intention to make a major technical contribution in this respect.

The EPO and USPTO will start their exchange of priority documents in Jan 2007.

The JPO and the USPTO agreed commencement of the priority document exchange between both offices from July 2007. Moreover the Trilateral Offices will start discussions to use TDA-PDX priority document exchange mechanism between the Trilateral Offices and the WIPO.

WIPO Digital Libraries Concept

The Trilateral Offices agreed on a common approach. A detailed proposal will be worked out for the February meeting of the WIPO working group.

Biotechnology

Aiming toward realization of the common Trilateral databases and search tools, the Trilateral Offices will investigate the costs of their respective search environments so as to assess possible benefits of common platforms in the future. They will specify the databases and tools which are useful for Offices by revising the Trilateral search guidebook.

Concerning the Trilateral Search Guidebook completed in May 2006, the Trilateral Offices confirmed that they would publicize the information related to common search tools and databases of the Trilateral Offices in spring 2007.

The Trilateral Offices reiterated that cooperation in this field was significantly successful and equally important for applicants and examiners and will continue to cooperate by exchanging search-related information, etc.

Non-Patent Literature (NPL)

The Trilateral Offices reactivated the Non-Patent Literature Working Group in 2006 with a view to promoting the utilization of non-patent literature so as to facilitate the exploitation of search and examination results.

The Trilateral Offices will consider licensing-based approaches and exploring the use of Digital Object Identifiers (DOI), so that they can easily exchange non-patent literature cited by the examiners among the Trilateral Offices while respecting copyrights. The Trilateral Offices confirmed the recommendation of the working group for a basic approach to studying these issues.

Data exchange and quality

The Trilateral Offices unanimously approved the idea proposed by the USPTO for "Media-less data exchange" which will enable the Trilateral Offices to exchange data without media such as DVD.

In view of "data exchange" between the Offices and the conditions to forward such data to third parties the Trilateral Offices confirmed to begin discussing possible modifications to the trilateral data exchange policy.

Linguistic Tools

The Trilateral Offices came to an agreement to continue to cooperate on translation feedback for the JPO system. The Trilateral Offices affirm the

importance of exchanging information about research regarding a search system for a database containing various language documents with machine translation.

Harmonisation of Classification

The Trilateral Offices recognised the usefulness of harmonising classification by introducing the Trilateral harmonised schemes to the IPC advanced level scheme so that users could access all documents worldwide using one search key. They confirmed that Harmony Visits were significantly useful for accelerating the Trilateral classification harmonisation and that they should be continued. The Trilateral Offices decided that acceleration of classification harmonisation is needed and instructed the working group to act accordingly.

Trilateral Statistical Report

The Trilateral Offices continue to make efforts to improve the Trilateral Statistical Report. In particular, they are considering exchanging data, concerned with granted patents, that has been divided by technical field and then subdivided by country of origin. The trilateral Offices are also considering displaying the statistics generated from the aforementioned data in the Trilateral Statistical Report.

Information Dissemination Policies

(a) Public Awareness

The Trilateral Offices confirmed that opportunities of joint participation were significant providing the TO's with venues where the results of the trilateral cooperation activities could be quickly and broadly disseminated to users. In addition, the Trilateral Common Brochure prepared by the Trilateral Offices outlining the trilateral cooperation was completed to support these events. In 2007, the Trilateral Offices will continue to support these events and fairs in the three regions.

(b) Information Dissemination Policies

The Trilateral Offices underlined the strategic importance of information dissemination policies. In particular, the Trilateral Offices agreed that Information Dissemination has increased relevance for applicants and the public.

The Trilateral Offices reaffirm the importance of the Trilateral policy of free flow of information data at marginal cost and their willingness to apply it to any other country provided the reciprocity principle is respected.

Legal Issues

(a) Standard Format

The Trilateral Offices have come to a common understanding with respect to the draft Standard Format of patent applications in response to the request

from users, after having intensive discussions at three Working Group meetings in 2006. The Trilateral Offices confirmed that they would implement the related pilot project in 2007 in co-operation with users. The Trilateral Offices expect to confirm that they will invite the user groups to nominate participants to the Working Group which it is hoped will be held in February or March 2007.

The Standard Format approach will make patent filing at all three Trilateral Offices easier and improve efficiency for both patent applicants and for the Trilateral Offices.

(b) New Route Proposal

Bearing in mind the EPO's reservations, the Trilateral Offices will continue to discuss the JPO proposal for a New Route while recognizing the importance of constructively exploring other options for users.

The Trilateral Offices discussed a proposed Analogous New Route Pilot Project designed to evaluate the merits of the New Route framework. The JPO will further refine the proposal in view of the comments from the USPTO for the Offices to study further.

(c) Developing the PCT

Taking into account the current situation in which the PCT is vastly used by trilateral users, the Trilateral Offices confirmed that they should make a major contribution to further enhancing the PCT.

The Trilateral Offices will launch a project of improving the PCT administration processes and the JPO will lead the project. As a next step, the Trilateral Offices will study the flow of the documents in all PCT procedures, taking due account of the electronic environment, such as, for instance, the flow of character coded documents. After analyzing of the current procedure, the Trilateral Offices will discuss the result of the study at the next trilateral meeting. The Trilateral Offices confirmed this challenge will be the first step of modernization of PCT.

The Trilateral Offices decided to establish a WG to deal comprehensively with the issues related to the PCT. They confirmed that its detailed mandate will be discussed at the next Strategic Working Group in March.

(d) Comparative Study of the examination practices

In order for applicants to prepare high quality patent applications, which lead to enhance the examination quality, the Trilateral Offices acknowledged the significance of a comparative study on the description requirement as a first step and the inventive step as a second step. The Offices will consider the dissemination of the results to applicants and attorneys.

The Trilateral Offices will immediately collect real or hypothetical examples and review their controlling law and practices to draft a mandate for a comparative study for the next strategic working group in March 2007.

Technical Cooperation with Developing Countries

The Trilateral Offices confirmed the importance of each Office to continue exchanging information concerning technical cooperation with developing countries. The Trilateral Offices also confirmed that they would consider Trilateral cooperative program for 2007 based on the needs of each Office and the users. In particular, the Trilateral Offices confirmed that they should consider effective cooperation on the basis of the experience of the co-sponsored seminar held in 2006.

ACCESS TO CHINESE DOCUMENTATION

The Trilateral Offices recognize the strategic importance of access to the Chinese documents for the examiners and the public.

The EPO will send a questionnaire on Chinese databases including (1) the present/planned search environment for each Office, (2) the information provided by the SIPO to the JPO and the USPTO. The EPO will consolidate the replies before the next SWG.

E-Learning

The Trilateral Offices are co-operatively preparing e-learning materials to deepen the mutual understanding of the legislation, practice, search tools, and so on of each Office. Each Office is preparing training materials for two different topics on a trial basis in 2006.

It is intended that the e-learning contents be utilized as pre-training materials for Trilateral examiner exchanges. At the same time, the Trilateral Offices are aiming at publicizing those materials.

The Trilateral Offices confirmed that they would proceed with the e-Learning project in 2007 and thereafter, and the Offices would collaborate in selecting topics and in sharing existing materials. The Trilateral Offices also confirmed to explore the possibility of establishing a substantially harmonized e-learning system.

Patent Related Economic Analyses

The Trilateral Offices recognise the increasing importance of the economics of patents. The Trilateral Offices agreed to proceed with work on a study concerning the role of fees as drivers of workload.