

Summary of the 25th Trilateral Conference
Alexandria, Virginia
November 9, 2007

The European Patent Office (EPO), the Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the 25th Trilateral Conference in Alexandria, Virginia on November 9, 2007. The Trilateral Offices

- Reconfirming their commitments to Trilateral cooperation based on common recognition of the role of industrial property as a basic system supporting the progress of industry, technology, and international 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,
- Recognizing the benefits of promoting reduction of processing times and reducing or eliminating redundant work through a coordinated Trilateral approach,
- Recognizing the benefits of promoting the improvement of the quality of incoming applications as a means to reduce Office workloads,
- Recognizing the desire of stakeholders for “one application, one search, one examination,”
- Understanding the benefits of harmonizing patent law and procedures,
- Recognizing the benefits of developing common infrastructure and compatible data for electronic business systems and search tools,
- Recognizing the value of patent information as means for raising the quality of applications filed,
- Highlight the following as major achievements of the common efforts of the three offices this year:
 - o Establishment of a new Governance structure
 - o Creation of an enhanced work sharing mandate and roadmap

- Agreement on a concept for prioritization of first filed applications-SHARE (Strategic Handling of Applications for Rapid Examination)
- Agreement to develop a pilot project framework for the “Focus” worksharing approach project
- Agreement to implement the Patent Prosecution Highway between the USPTO and the JPO and to conduct a PPH comparable pilot between the USPTO and the EPO
- Agreement to conduct a “Triway” pilot
- Implementation of electronic priority document exchange among the three Offices
- Creation of an e-learning working group
- Adoption of a dispute resolution procedure and terms of reference for the HARMONY classification projects
- Agreement on the common application format

Furthermore, understand as follows:

Governance

To achieve optimal use of resources, improve meeting efficiency, and to provide a more focused direction for Trilateral cooperation, the Trilateral Offices established a governance structure for overseeing all activities. The Annual Conference will be maintained as the summit meeting with the Strategic Working Group, the Information Technology Group, and all working level meetings integrated into the structure. The mandates for the individual working groups will be reviewed by the Trilateral Offices in early 2008. The Trilateral Offices will utilize identified long-term cooperation activities as one means for planning and monitoring achievable specific goals.

Effective Access To and Use of Work Results

The Trilateral Offices reaffirmed their commitment to more aggressively utilize the framework of Trilateral cooperation to re-use work results of other Trilateral Offices and through this activity recognize the potential to significantly reduce workloads by avoiding duplication of work among the Offices.

(a) Enhanced Work Sharing

To carry out this commitment, the Trilateral Offices established a mandate and a roadmap for an enhanced work sharing working group to develop and coordinate solutions for reutilizing work results of the other Offices to the maximum extent practicable.

(b) Prioritization of First-Filed Applications - SHARE

As part of the activities of this working group, the Trilateral Offices agreed to focus on prioritization of search and examination of first-filed applications by means of the USPTO-proposed concept known as SHARE (Strategic Handling of Applications for Rapid Examination). The Offices will investigate the feasibility of each office prioritizing the search and examination of applications for which it was the office of first filing with the intention of coordinating a pilot project beginning in April 2008. The Trilateral Offices welcomed the JPO's initiative to implement its approach for prioritizing first filed applications. The Trilateral Offices also have a consensus that cooperation of users is indispensable to proceed with the Trilateral examination work-sharing.

(c) "Focus" Project

The Trilateral Offices agreed to develop a pilot project framework based on:

- Selection of applications from areas where there is a high degree of cross filings between the Trilateral Offices;
- Concentration of activities to maximize work sharing in these areas;

in order to obtain comprehensive worksharing results. The pilot project will be designed to coordinate with the SHARE project on prioritization of first filings to provide a comprehensive evaluation of Trilateral efforts to optimize the reuse of the work results of the Office of First Filing to the maximum extent practicable.

(d) Patent Prosecution Highway

The Trilateral Offices re-confirmed that the Patent Prosecution Highway (PPH) enables 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 and confirmed plans to fully implement this program on a permanent basis in January 2008. The EPO and the USPTO agreed to conduct a bilateral, PPH comparable pilot program, in which European applicants can participate on the basis of an EPO Extended European search report. The JPO will study the possibility of a new work sharing framework by using an EESR outside the PPH framework.

In addition, the Offices will continue to implement the Patent Prosecution Highway in cooperation with patent offices outside the Trilateral framework.

(e) Triway

With a view towards finding new ways to improve quality and reduce pendency, the Trilateral offices will undertake a limited pilot involving the concept of sharing searches, or, in the case of the JPO, search and examination results. This Triway pilot will employ both new mechanisms and existing accelerated examination procedures within the respective Offices.

(f) File Wrapper Access

The Trilateral Offices confirmed that the usage of the Trilateral Document Access Tools and feedback from examiners is an important component for analyzing the current status and problems with the exploitation of search and examination results of the other offices. Accordingly, the Trilateral Offices will continue to share information on usage of the tools by examiners, usability from the viewpoint of examiners, and will continue to improve the tools to facilitate worksharing.

Examiners' exchange

Using the Examiners' Exchange program as a tool for enhancing understanding of patent systems and examination practices, building confidence among offices in work performed, and promoting the effectiveness of exchange of work results in order to maximize work sharing activities, the Trilateral Offices will utilize the 2007-2008 examiner exchange program as a means to further work sharing activities.

The Trilateral Office will commence the new round of Examiners' Exchanges in Autumn 2007 at the USPTO. Through this program, the Trilateral Offices will continue to evaluate exchanging search strategies and database information used by examiners.

The Trilateral Offices will also continue to develop e-learning modules as pre-training materials for examiner exchanges and to promote mutual understanding of examination practices. In this regard, the Trilateral Offices agreed to create a virtual e-learning working group to deal with an e-Learning project in 2008 and agreed to a mandate and roadmap for the group.

Project WM: Workload Management

The Trilateral Offices recognized the importance in harmonizing Office practices and procedures in order to gain efficiencies within the Offices and for the applicants. With this in mind, the Trilateral Offices agreed to undertake a comprehensive, technology focused collaborative approach to enhancing the examiner exchange program, and other cooperative efforts.

Electronic Business Systems

The Trilateral Offices support the concept of building interoperability of its systems. Therefore, the Trilateral Offices agreed to develop an action plan within the IT Trilateral governance structure to achieve this objective.

The Trilateral Offices agreed to develop a long-term approach for updating Annex F to make it technology neutral and adaptable to evolving technology.

The Trilateral Offices agreed that text based processing of PCT applications in XML is an important means for increasing Office efficiencies. In this regard, the Offices will review taking a step-by-step approach in digitizing PCT applications in the long-term. The Offices will form a working group to review all relevant issues and determine a time line for developing a project in which the Receiving Offices will forward XML data to WIPO along with the OCR text data.

Dossier Access

The Trilateral Offices agreed to revise the specification to accommodate the WIPO Digital Access Service.

TRINet

The Trilateral Offices will review the services and availability monitoring of TRINet in the short-term and will continue to review future options for providing updated technical architecture for interconnectivity. The Trilateral Offices also reaffirmed the importance of continually evaluating the security policy to ensure it meets the evolving needs of the three Offices.

Priority Document Exchange

The Trilateral Offices recognized the achievement of implementation of electronic Priority Document exchange between the three Offices. This new system allows for direct office-to-office transmission of priority documents that eliminates the need for customers to request and mail these documents, thereby providing considerable savings in terms of costs and time for both applicants and offices.

The Trilateral Offices will continue to refine its procedures for this process and will develop a plan to expand this service to other Offices.

Biotechnology

Aiming toward realization of the common search results among Trilateral offices, the Trilateral Offices agreed to continue to exchange information and discuss on search environment and strategies for exchange of biotechnology work results including sequence exchange and search related information. In order to assist the Offices in meeting its needs in this area of technology, the Offices will review the mandate of the biotechnology work group and develop long-term strategic objectives for this working group.

The Trilateral Offices reiterated that cooperation in this field was significantly

successful with the publication of the Trilateral Search Guidebook and will serve as an important tool for both applicants and examiners.

Linguistic tools

In order to advance progress in the use of search and examination results, the Trilateral Offices will work toward improving machine translation of dossier contents into English. The Trilateral offices will continue to cooperate by providing translation feedback on the JPO's system in order to further develop the dictionary. The Trilateral Offices will continue to exchange information on machine translation of Chinese documentation. The Trilateral Offices welcomed the work by the EPO on the European Machine Translation Program and will review the dictionary technology used for this system. The USPTO and the JPO appreciate the work that the EPO has performed in providing machine translation documents in full text searchable form and welcomed the continued exchange of information on this effort.

Harmonization of Classification

The Trilateral Offices recognize the importance of harmonizing classification work to reduce redundancies and facilitate mutual acceptance of search results. Thus, the Trilateral Offices reaffirmed their commitment to accelerate progress of the classification Harmony projects and will strive to improve efficiencies in completing projects by prioritizing work and expanding the issue resolution procedure to include an Arbitration panel to resolve disputes. In this regard, an arbitration board terms of reference was adopted to define the parameters of the board and provide a dispute resolution procedure.

The Trilateral Offices also welcomed contributions from other Offices on the development of the Harmony projects.

Information Dissemination

The Trilateral Offices reaffirmed their current core dissemination principles and have committed to continue to review dissemination practices and policies. The Offices

have also readdressed their information dissemination policy to address rapid advancements in future information technology and its effect on patent information dissemination.

The view of the Trilateral Offices towards commercial web search sites such as Google™ and NAVER of South Korea is generally very positive and the policy is to welcome these providers based on the strong surge of interest in patent information they are creating. These services are promoting dissemination and raising awareness of patent information for the general public in view of the much larger audience reached by these convenient entry points to the world of patent information.

The Trilateral Offices confirmed that opportunities of joint participation are significant providing the TO's with venues where the results of the Trilateral cooperation activities could be broadly disseminated. In 2008, the Trilateral Offices will continue to support these events in the three regions.

The Trilateral Offices confirmed the need to provide data in the most efficient and cost effective manner. Accordingly, the three Offices will work toward media-less data exchange.

Within the framework of reducing the Offices workload, the Trilateral Offices recognized the importance of promoting patent information as a means for improving the quality of incoming applications. With this in mind, the Offices will work cooperatively to evaluate and provide common guidance on the importance of prior art searches through the use of tools and services made available to the public.

Legal Issues

(a) Common Application Format

The Trilateral Offices agreed on a common application format in consultation with users. This format allows an applicant needing to file an application in each office to prepare a single application in the Common Application Format, and it will be accepted by each office without the need for amendments related to formalities. This will provide

significant savings to applicants in the filing and processing of patent applications before the Trilateral Offices. The Trilateral Offices will consider proposing amendments to the PCT to reflect the progress made in the Common Application Format. In response to a request from users, the Trilateral Offices will continue to discuss relevant legal issues raised by users within the Trilateral Framework.

(b) New Route

Recognizing the need to evaluate various approaches to promote efficient processing of patent applications, the USPTO and the JPO will commence a New Route pilot project by the end of January 2008. The pilot will be implemented for a period of one year. The two offices will then evaluate the result of the pilot to determine next steps.

(c) Developing the PCT

Taking into account the current situation in which the PCT is widely used by applicants of the Trilateral regions, the Trilateral Offices confirmed they will continue their work in further enhancing the PCT administrative procedures. As part of this work, the three Offices will review the electronic environment for the next generation PCT e-filing system and will consider development of a plan to enable more efficient and expeditious processing. Through a work group on developing the PCT, the Trilateral Offices will also study the feasibility of providing for a claims fee in the PCT system. The Trilateral Offices agreed to take an active role in the development of objective criteria for the future addition of PCT publication languages. The Trilateral Offices have prepared a preliminary set of possible criteria and will continue to work with the WIPO as it develops recommendations for the PCT Assembly.

(d) Quality Initiatives

As quality is of significant importance to all of the Offices, the Trilateral Offices will exchange information on quality management in each respective Office. The Trilateral Offices also recognize the Peer Review initiative in which the USPTO is participating as a means for raising quality.

(e) Comparative Studies on Examination Practices

To facilitate the preparation of high quality applications, the Trilateral Offices acknowledged the significance of the comparative study on disclosure and claims. The Trilateral Offices will disseminate the results of this study by posting it on the Trilateral web site. The Trilateral offices will conduct a study on inventive step/non-obviousness based on a review of the examining guidelines and laws.

Technical Cooperation Activities

The Trilateral Offices will undertake approaches in developing their collaborative activities regarding technical assistance cooperation. In this regard, the Trilateral Offices will exchange information on their respective activities and will formulate common objectives for future Trilateral collaborative activities with IP officials in other nations and regions.

For 2008 the Trilateral Offices will investigate developing trilateral cooperative programs based on the needs of each Office and the users. A seminar on design protection with joint participation from SIPO is under consideration.

Economics of Patent Activity

The Trilateral Offices recognized the importance of economic studies related to patenting and innovation and intend to take a lead in building a network in this respect. A micro economic approach would be most suitable for the Trilateral Offices. However to support strategic considerations a macro economic context will be investigated. Such a study may require involvement of other partners. The Trilateral Offices will form the core part of the network. Duplication of work and studies already performed by other entities will be avoided. The EPO will take a lead and will draw up a plan forward.

The three Offices will continue discussions in this area and will expand these discussions to other interested parties. The Offices will begin this review by identifying near term issues of importance to the three Offices.

Cooperation with the Korean Intellectual Property Office and the State

Intellectual Property Office of the People's Republic of China

Recognizing the significance of the KIPO and the SIPO as key players in global patent activities, the Trilateral Offices welcome a meeting of the Heads of Offices and any working groups as appropriate in 2008 to assess progress of all activities from 2007 and discuss next steps.