



Mr. Alain Pompidou
President
European Patent Office

Mr. Hiroshi Ogawa
Commissioner
Japan Patent Office

The Honorable Jon Dudas
Undersecretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
United States Department of Commerce

2 December 2004

Dear Trilateral Office Heads,

The undersigned organisations together form the Industry Trilateral whose aim is to increase industry's cooperation efforts on Intellectual Property discussions. The Industry Trilateral is a unique platform that brings together industry representatives from the United States, Japan and Europe.

We would like, on behalf of the Industry Trilateral, to express our support in principle for the efforts of the Trilateral Offices in order to strengthen their coordination, cooperation and harmonisation efforts.

In this context, we welcome the general orientation of the Memorandum of Understanding (MoU) signed on 22 November 2004 during the 22nd Trilateral Conference held in Alexandria, Virginia.

We support in particular current discussions to coordinate work-sharing, electronic business development to support work-sharing and harmonisation or standardisation of search strategies, tools and substantive patent law.

The Industry Trilateral is in particular supportive of the following projects:

- **Effective access to and use of work results/strategic issues.**
We support making it possible for the search and examination results of the Trilateral Offices of first filing to be provided in a timely manner to be used by the other Trilateral Offices of second filing.
- **Comparative studies in new technologies.**
We welcome the establishment of a working group to identify trends in emerging technologies and exchange of information between the Trilateral Offices in this area.
- **Electronic business system.**
We support the project whose aim is to achieve the goal of author-once-file-anywhere in an operational electronic filing environment, and hope to make recommendations on the goal of author-once-file-anywhere in the spring.
- **Priority documents.**
We welcome the objective of the Trilateral Offices to further work on a technical standard for Trilateral Offices to exchange Priority Documents.
- **Linguistic tools.**
We support progress in studying carefully how machine translation can improve progress in the use of search and examination results.

Nevertheless, concerns have been expressed about certain of the elements in the project LEG on Legal Issues. For example, we cannot support the concept of enlarged novelty.

The Industry Trilateral would appreciate being kept closely informed about developments in the above-mentioned projects. We would also greatly welcome further links being built between the Trilateral Offices and the Industry Trilateral. In this context, we would like to propose that when the next Trilateral Offices meeting takes place in Europe, a meeting be organised with the Industry Trilateral.

We look forward to your reaction to this and we remain at your disposal to discuss further the above comments.

Yours Sincerely,

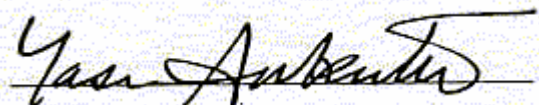
Philippe de Buck
UNICE Secretary General



J. Jeffrey Hawley
President of IPO



Yasuo Sakuta
President of JIPA



William C. Rooklidge
President of AIPLA



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SUBJECT: Report of the 22nd Trilateral Conference

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: 1. Administrative Council (for information)
2. Working Party on Technical Information (for information)

SUMMARY

This document is a report of the 22nd Trilateral Pre-Conference and Conference held by the USPTO in Washington from 15 to 19 November 2004, and includes a copy of the Memorandum of Understanding signed at the Trilateral Conference.

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I. SUMMARY

The 22nd Trilateral Pre-Conference was held in Washington from 15 to 17 November 2004. Mr Steve Pinkos, Deputy Director of the United States Patent and Trademark Office, chaired the meeting, which was also attended, as observer status, by WIPO.

The Trilateral Conference was held on 19 November 2004, chaired by Mr Jon Dudas, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

As in 2003, both the **JPO and the USPTO Reports** covered the revision process of their national patent systems to promote timely and high quality examination including a restructure of the patent fees and striving towards the harmonization with global patenting standards.

In the area of **working methods**, it was particularly stressed the importance of timeliness of search result. The JPO presented a draft joint message which recommends that applicants at the JPO should actively utilize the PCT route and the accelerated examination system. In order then to continue making progress within the project, a Strategic Working Group Meeting will be held in late February or early March 2005 at the USPTO.

The next trilateral **examiner exchange** will be hosted at the JPO from 11 to 22 April 2005.

A Trilateral Working Group on Emerging Technologies was set up to exchange information regarding **Nanotechnology**.

The Trilateral Offices reported on the current status of their Electronic Business Systems. Aiming towards a single **e-filing** and internal electronic processing solution, the Trilateral offices agreed to continue co-operation on on-line filing, to achieve interoperability.

The USPTO and the EPO will start a limited electronic **exchange of priority documents** in December 2004 and will work with the JPO to adopt the Trilateral Data Access services for electronic exchange of Priority Documents.

In **Biotechnology** the three Offices will continue to work to develop tracking mechanisms to follow trends pertaining to SNPs (Single Nucleotide Polymorphisms) applications and related new electronic standards. The offices will also make efforts to improve databases completeness in this field.

The Trilateral Offices will exchange information on the use of Digital Object Identifiers (DOIs) as a means for providing access to the full-text of **Non-Patent Literature**.

Progress has been made in **linguistic tools**: the implementation of the "JP-EN Machine Translation System", feedback from EPO and USPTO is welcomed for further quality improvement of the system.

The harmonisation of **classification** is proceeding. Trilateral Offices agreed on the importance of harmony projects and to explore ways to accelerate their progress in view of the IPC reform. JPO is willing to provide further resources in the examiner exchange if required.

The Trilateral Offices reinforce their commitment to use the Internet as the main dissemination tool for **patent information** in the future. The Trilateral Offices appreciate the contribution of the private sector in their information dissemination efforts and will each encourage a continuing dialog with these organizations.

The Trilateral Offices recognize the importance of patent **law harmonization** and note that harmonization of prior art issues will likely improve quality and contribute to reduction of workloads in the three Offices and reduce costs for applicants. With this in mind and in order to advance discussions on patent law harmonization, the Trilateral Offices will base further harmonization work on a limited package of issues and work toward harmonizing on that basis.

The EPO will organise the Trilateral Technical Meeting in The Hague, from 18 to 20 May 2005.

II. **PRESENTATION OF THE OFFICES' STATUS REPORTS**

USPTO

Fee Bill. The USPTO reported on the status of the USPTO Fee Modernization Bill. Some version of the USPTO appropriations and fee modernization bill may be included in an omnibus appropriations bill that may be considered by Congress this week or next. The fee bill is required in order to allow the USPTO to generate the income necessary to implement the goals and objectives of the 21st Century Strategic Plan.

Workload. The USPTO received more than 350,000 applications during the fiscal year that ended September 30, 2004 representing a 6% increase over the filing level of last year. Over 400 patent examiners were hired during the fiscal year giving the office a total of close to 3700 patent examiners.

Quality. Quality initiatives continue to be a focus within the Patents operation area. Examiners are required to pass a certification examination prior to promotion to an independent level and are then required to be recertified every three years.

Automation. The USPTO accomplished its 21st Century Strategic Plan objective of moving from a paper based examination process to an end-to-end automation process. The Image File Wrapper was fully deployed in August 2004.

JPO

To achieve the goal of making Japan a nation built on Intellectual Property a revision of the law has been carried out during 2004 on the basis of a Strategic Program on the Creation, Protection and Exploitation of Intellectual Property, which was promulgated in June 2004.

Strategic Program. It includes:

- Radical improvement of anti-counterfeiting measures
- Expeditious patent examination (timeliness improvement in the patent examination process within a global patent system)
- Assistance to SMEs, venture businesses and local areas (regional promotion of technology development)
- Development of content businesses (assistance to the modernization of contents industry)
- Promotion of IP at universities
- Intensified human resources development (promotion of IP education)

Outsourcing. Since October 2004, the expansion of capacity to outsource prior art searches is allowed. The registration standard for search organizations was deregulated to lift the limitation on participation by only non-profit organizations. The JPO also mentioned the training development efforts for registered search organizations planned by the National Center for Industrial Property Information and Training.

Workload. The number of patent applications in Japan increased at an annual rate of almost 3% since 1997 until 2001 and is still maintaining a high level (about 413.000 filings in 2003). PCT filing to JPO in 2003 has also shown a 23% increase over the previous year (about 17.000 PCT application in 2003) and an upward tendency is expected.

III. **EFFECTIVE ACCESS AND USE OF WORK RESULTS**

The Summary Report of the September Working Group Meeting was adopted by the Trilateral Offices.

The Trilateral Offices agreed on the following next steps for this project:

1. Introduce where necessary possible modifications to the legal system, the technical infrastructure and/or measures influencing applicant behavior to allow timely access to the OFF (Office of First Filing) search information;
2. Provide technical solutions to make the OFF search history available to OSF (Office of Second Filing) in readily accessible form;
3. Improve the acceptance of the OFF search results to OSF examiners by utilizing an examiner exchange program and identifying additional efficient ways to accomplish this acceptance;
4. Continue to improve current machine translations and work towards a comprehensive machine translation infrastructure.

The JPO presented a **draft joint message** to the Trilateral Offices. The draft joint message recommends that applicants should actively utilize the PCT route and the accelerated examination system. The EPO and the USPTO indicated that it will support the JPO efforts to make these recommendations to JP applicants.

The Offices agreed that a **policy on document import** should be put in place and preliminary comments for this should be made if possible by the middle of December 2004.

In order to continue making progress on the Trilateral projects identified within this project, a strategic working group meeting will be held in late February or early March 2005.

IV. EXAMINERS EXCHANGE

Using the Examiner Exchange program as a tool for enhancing understanding and effectiveness of the exchange of work results, the Trilateral Offices will continue to utilize the current examiner exchange program to improve acceptance and reduce any gaps identified within the search exchange project.

The current Trilateral Examiner Exchange program includes a final Spring 2005 visit to the JPO. The Trilateral Offices will develop a detailed evaluation of the current program after this visit before deciding to renew the program. The JPO will identify the technical fields for inclusion in the Spring examiner exchange program by early December 2004.

The JPO is willing to extend the examiners exchange if requested, in order to accelerate the harmonisation of classification.

V. COMPARATIVE STUDIES IN NEW TECHNOLOGIES

The Trilateral Offices presented their progress on **Nanotechnology**. Based on those on-going activities a Trilateral Working Group will be started. This Working Group would identify trends in new emerging technologies and exchange information between the Trilateral Offices in regard to these emerging technologies. This exchange will include sharing trends in new technologies, sharing information on definitions and initial classification efforts and sharing ideas on best practices for effective and efficient examination of emerging technologies.

VI. ELECTRONIC BUSINESS

EPO provided an update to the status report on EPTOS highlighting that the objective of EPTOS is to provide the National Offices with a common infrastructure that will allow them to electronically file and process the applications for Patents and Trademarks. The system is classified in packages (Administration tools, Search and Examination tools and eBusiness tools).

A. E-FILING

The USPTO introduced the paper "Plan for Achieving Electronic Filing Interoperability". That document proposes that the Trilateral/WIPO Standards Working Group, at its next meeting in 2005 March, will refine and complete the list of interoperability issues and make forward progress for identifying best practices for each issue that will ensure interoperability among the Trilateral Offices and WIPO. After that determination is made, each Office will create its plan for making

the internal changes needed to migrate to the target best practices. Once that step is completed, and each Office has produced an implementation schedule and allocated the required funding, the Offices can estimate a date by which interoperability, as defined, will be achieved.

All of the Trilateral Offices agreed that the table, which describes issues considered to be obstacles to interoperability, should be completed to determine the full scope of the problem. The Trilateral/WIPO Standards Working Group was asked to complete the table by the close of its next meeting in March. The Trilateral Offices will provide the expertise required to do that in the next few months leading up to that meeting.

B. DOSSIER ACCESS

The EPO and the USPTO declared that they are ready to begin a limited production pilot of Trilateral Data Access for dossier and dossier document access on 30 November. Priority document access will begin as a limited production pilot at the end of December 2004. Priority document exchange will use the asynchronous method, where the documents are delivered with some delay following the request.

The EPO will begin with an initial deployment to around 100 examiners and subject to user feedback are planning on large-scale deployment early in 2005.

The JPO requested access to the TDA services of the EPO and the USPTO, in the short term, for testing. The EPO and the USPTO agreed to support the JPO request.

VII. PROJECT IT3: TRINET

The Trilateral Offices support the revised Protocol for adding new members to TRINet. The three Offices will move forward with completing the next steps for adding IP Australia to the TRINet. The Trilateral Offices note that the contract to allow the interconnection of TRINet, PATNet, and WIPONet has now been signed by the Trilateral Offices.

VIII. PRIORITY DOCUMENTS

The USPTO and the EPO will pilot a limited exchange of electronic priority document in December 2004, using the asynchronous method for delivery, with the intention of moving to production mode in 2005. The EPO and the USPTO will work with the JPO to adopt the Trilateral Data Access services for electronic exchange of Priority Documents.

The Trilateral Offices will further work on a technical standard (i.e., TDA Interface Specification-Trilateral dossier access standard) for Trilateral Office exchange of Priority Documents. The standard will be finalized during the coming EPO/USPTO pilot project and presented for adoption at the May Trilateral Meeting in 2005 in order to achieve benefits from electronic exchange.

The Trilateral Offices believe that the format of the priority document should be specified in bilateral or multilateral agreements between the participating offices.

IX. BIOTECHNOLOGY

The EPO presented a summary of the Biotechnology Working Group (BWG) Meeting held on October 7-8, 2004. At the BWG meeting, the Trilateral Offices agreed to develop tracking mechanisms to follow trends pertaining to SNPs applications, to study the impact of any new electronic standard on each Office's procedures and thereafter to decide whether it is possible to implement such a standard, and to make efforts to improve database completeness by inviting WIPO to establish a mechanism for delivering sequences to public databases providers and by encouraging other International Search Authorities to do the same. The EPO also reported on the USPTO request for public input on receiving 3D protein structure data and chemical structure data in electronic form and the EPO pilot project pertaining to creation of a non-redundant sequence database for patents.

X. NON PATENT LITERATURE

The Trilateral Offices will exchange information on the use of Digital Object Identifiers (DOIs) as a means for providing access to the full text of NPL. Each Office will continue to study the issue of NPL exchange and report to the Trilateral Offices the results of such studies. The JPO will participate in the current pilot program between the USPTO and EPO to eliminate the exchange of copies of cited documents in the ISR exchange program.

XI. LINGUISTIC TOOLS

The JPO described the capabilities of Phase 2 of the Advanced Intellectual Property Network (AIPN), which was released on October 12, as Phase 2 of the English-Japanese Machine Translation System. In addition to providing access to the JPO dossiers, system functionality has been improved. Phase 2 capabilities include an online feedback feature that allows AIPN users to report mistranslations. Patent terms and proper names have been loaded into the dictionary to improve translation results.

The EPO is interested in integrating the AIPN into EPOQUE to give examiners one click access to Japanese machine translations. The EPO would also like to provide their member states with AIPN access. The JPO indicated that there were contractual and licensing concerns connected with this request, but indicated their willingness to work on these issues.

The EPO described work on the European Machine Translation Programme (EMTP), which will translate from English into the other national languages of the EPO and vice versa. A prototype of the system has been created and testing is ongoing. The EPO is interested in determining ways of evaluating machine translation quality, in standards for building technical dictionaries, and in involving other parties in this effort.

The EPO also suggested the establishment of a Trilateral Machine Translation Working Group. After discussion, the Trilateral Partners agreed to create the group within the following parameters:

- The Working Group will conduct discussions and consider its mandate and WIPO's request to be involved in the Working Group;
- The Working Group, according to its mandate, will accomplish work and hold meetings as needed.

XII. HARMONISATION OF CLASSIFICATION

EPO provided a summary of the meeting of the Trilateral Working Group on Classification held in Vienna on October 4-8, 2004. The meeting focused primarily on reviewing of current progress on classification harmony projects, establishing new harmony projects, IPC reform issues, and actions to accelerate progress of harmony projects.

The Trilateral Offices agreed on the importance of Harmony projects since they are essential to success of IPC reform. They also agreed on the need for finding ways to accelerate the progress of harmony projects.

The JPO is willing to look into the possibility of special examiner exchanges based upon active harmony projects.

The JPO also reported it will start producing English translations of their **F-term** manuals within 2005.

XIII. PATENT INFORMATION

The JPO gave an overview of the Trilateral Working Group on Information Dissemination Policy meeting held on October 12 in Tokyo. This meeting focused on how the Offices are utilizing the Internet to further information dissemination.

The Trilateral Offices reinforce its commitment to use the Internet as the key dissemination tool for patent information in the future. Each office will use the internet in ways that are appropriate in light of individual legal, technological, and data requirements. One of the projects in this respect is the Japanese interface for *esp@cenet* which is being developed by the EPO in cooperation with the JPO and will be launched in 2005. Further projects can be a Japanese interface to *epoline* and the implementation of linguistic tools in these applications.

The Trilateral Offices appreciate the contribution of the private sector in their information dissemination efforts and will each encourage a continuing dialog with these organizations.

Worldwide Patent Statistical Database. The USPTO and the JPO support the concept of not duplicating work in the creation of a Worldwide Patent Statistical Database. The EPO will meet with WIPO to start cooperation for the creation of such a database.

XIV. LEGAL ISSUES

The Trilateral Offices recognize the importance of **patent law harmonization** and note that harmonization of prior art issues will likely improve quality and contribute to reduction of workloads in the three Offices and reduce costs for applicants. With this in mind and in order to advance discussions on patent law harmonization, the Trilateral Offices will base further harmonization work on a limited package of issues and work toward harmonizing on that basis.

The USPTO is planning to convene a meeting, outside of the context of the Trilateral, to explore next steps in patent law harmonization. The USPTO and the JPO encourage the EPO participation.

The Trilateral Offices will conduct a comparative study on their respective novelty practices with a view to further developing the **enlarged novelty concept**. Such study will employ example fact patterns from each office. The USPTO will take the lead in drafting examples. The USPTO will continue its current study on enlarged novelty involving the review of file histories of applications and will provide the results to the Trilateral Patent Harmonization Working Group.

The Trilateral Offices will continue discussions on the adoption of a **30-month priority period** as an additional system to the international filing systems under the PCT and the Paris Convention. The USPTO will continue to refine its discussion paper taking into consideration the concerns (for example the **Hilmer doctrine** and 35USC 102(e)) raised by the EPO and the JPO and request that any further comments be submitted in writing within the next couple of months.



**22nd Memorandum of Understanding
on Trilateral Cooperation
in the Field of Industrial Property**

**Alexandria, Virginia
November 19, 2004**

The European Patent Office (EPO), the Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO) met at the 22nd Trilateral Conference in Alexandria, Virginia on November 19, 2004,

- 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 concerns of the Trilateral Offices and its user communities,
- Recognizing the benefits of promoting reduction of processing times and avoiding duplication of work through a coordinated Trilateral approach,
- Understanding the benefits of harmonizing substantive patent law,
- Recognizing the benefits of developing common infrastructure and compatible data for electronic business systems and search tools,

understand as follows:

Project WM1/Strategic: Effective Access and Use of Work Results/Strategic Issues

The Trilateral Offices reaffirm their expectations that the exploitation of the search results of other Trilateral offices would have the potential to reduce the workload and contribute to the improvement of the quality of the examination.

The Trilateral Offices deepen the recognition that it is desirable that the search/examination result of the Trilateral Offices of first filing be provided in a timely manner to be used by the other Trilateral Offices of second filing in order that the other Trilateral Offices of second filing achieve high quality examination and work reduction.

The EPO and the USPTO point out the challenge of searching Japanese language patent documents particularly those that do not have English family members. Both offices confirm that enhanced patent quality may result from exploiting the search results of the JPO of Japanese language patent documents. They express interest in receiving the search results of the JPO in a timely manner.

The EPO and the USPTO acknowledge the efforts made by the JPO and the Japanese private industry to promote utilization of the PCT route and accelerated examination.

The Trilateral Offices' evaluation of the bilateral search exchange projects has shown potential benefit for reduction of workload, avoiding duplication of effort, and

improving quality by exploiting the search results from another office. The Trilateral Offices recognize that the timely availability of the search results from the Office of First Filing is critical.

Efforts should be made to provide timely access of the search data of the Office of First Filing to the Office of Second Filing.

The Offices recognize there are currently gaps between each Office's search results. To narrow the gaps, the Trilateral Offices will promote programs such as examiner exchanges, patent law harmonization, automated system development, classification harmonization, and the exchange of search strategy information;

Furthermore, the Trilateral Offices recognize there is a need for effective translation tools;

The Trilateral Offices identify the following next steps for accelerating work sharing progress in the short term:

1. Introduce where necessary possible modifications to the legal system, the technical infrastructure and/or measures influencing applicant behavior to allow timely access to the OFF search information;
2. Provide technical solutions to make the OFF search history available to OSF in readily accessible form;
3. Improve the acceptance of the OFF search results to OSF examiners by utilizing an examiner exchange program and identifying additional efficient ways to accomplish this acceptance;
4. Continue to improve current machine translations and work towards a comprehensive machine translation infrastructure.

The Trilateral Offices will consider the "Patent Prosecution Highway Project" prepared by the JPO. The USPTO will study the proposal to determine what impact this will have on the USPTO and send comments on the proposals to the other Trilateral Offices.

For the long term, the Trilateral Offices will work on procedures and law changes to achieve benefits from work exchange. The Offices will address timing of work so that work sharing provides benefits to the office of second filing to the greatest extent possible.

The USPTO and the JPO will postpone reviewing fee policy changes that would provide applicants with a benefit for the use of search and examination results from another Trilateral Office.

The Trilateral Offices will cooperate to define the requirements for the JPO Dossier Access System for the satisfaction of the IDS (Information Disclosure Statement) requirement in order to reduce the procedural burden of applicants when applicants receive office actions from the JPO. The USPTO will identify the requirements needed for system developments with cooperation by the other Trilateral Offices at the next Strategic Working Group meeting.

The Trilateral Offices will continue to review the legal and technical issues related to import guidelines. The Trilateral Offices will review import requirements and provide preliminary comments, if possible, by the middle of December 2004 with the goal of establishing guidelines by Spring 2005. The guidelines are to address types of documents and conditions for importing.

The Trilateral Offices believe that in order to maximize work sharing it is important to access complete information on search history, strategy and results. The Offices will continue discussions in this regard.

In order to continue making progress on the Trilateral projects identified within this document, a strategic working group meeting will be held in late February or early March 2005. The USPTO will draft a proposed agenda and circulate for comments.

Project WM3: Examiner Exchange

Using the Examiner Exchange program as a tool for enhancing understanding and effectiveness of the exchange of work results, the Trilateral Offices will continue to utilize the current examiner exchange program to improve acceptance and reduce any gaps identified within the search exchange project.

The current Trilateral Examiner Exchange program includes a final Spring 2005 visit at the JPO. The Trilateral Offices will to develop a detailed evaluation of the current program after this visit before deciding to renew the program. The JPO will identify the technical fields for inclusion in the Spring examiner exchange program by early December 2004.

As to the bilateral examiner exchange, the JPO expressed its intention to dispatch its examiners at the same magnitude as that of recent years and willing to receive examiners at the same magnitude as that of recent years.

The Trilateral Offices will better identify and define the mandates/objectives prior to any future examiner exchanges. The three Offices recognize that there is need for clarity and a determination of scope on the technical areas selected, a need to identify the mandate, stipulate the nature of the results to be gained, and a need for broadening the dissemination of the results and information gained by the examiners.

Project WM4: Comparative Studies in New Technologies

Based on the ongoing activities on Nanotechnology, the Trilateral Offices will form a Trilateral Emerging Technologies Working Group. The Working Group will identify trends in emerging technologies and exchange information between the Trilateral Offices in regard to these emerging technologies. This exchange will include sharing trends in new technologies, sharing information on definitions and initial classification efforts and sharing ideas on best practices for effective and efficient examination of emerging technologies.

Project EB1: Electronic Business Systems

The Trilateral Offices support the concept of interoperable tools for all IP Offices. Therefore, the Trilateral Offices recognize the value of the EPTOS project and note the progress made in the Netherlands, Denmark, and Sweden.

To achieve the goal of author-once-file-anywhere in an operational electronic filing environment, the Trilateral Offices will develop an interoperability issue paper for e-filing data compatibility which prioritizes the issues and proposes initial targets for best practices by Spring 2005. Each office will produce a resource and implementation schedule in order to achieve the goal of interoperability.

Project EB3: Dossier Access

In order to achieve the goal of effective access to each Office's dossier, the Trilateral Offices commit to the Trilateral dossier access standard for dossier access.

The EPO-USPTO will begin a limited production pilot of Trilateral Data Access for published dossier and dossier document access at the end of November 2004. The USPTO and the EPO will continue working with the JPO to provide dossier access using the Trilateral dossier access standard.

The Trilateral Offices will prepare an inventory of all data and document exchanges between the Offices for consideration of using Trilateral Data Access as a progressive replacement for other exchange mechanisms. The Trilateral Offices also will extend the Trilateral Document Access (TDA) to support the machine translation possibilities coming from Project WT1.

Project IT3: TRINet

The Trilateral Offices support the revised Protocol for adding new members to TRINet. The three Offices will move forward with completing the next steps for adding IP Australia to the TRINet. The Trilateral Offices note that the contract to allow the

interconnection of TRINet, PATNet, and WIPONet has now been signed by the Trilateral Offices.

Project DTR3: Priority Documents

The USPTO and the EPO will pilot a limited exchange of electronic priority document in December 2004, using the asynchronous method for delivery, with the intention of moving to production mode in 2005. The EPO and the USPTO will work with the JPO to adopt the Trilateral Data Access services for electronic exchange of Priority Documents.

The Trilateral Offices will further work on a technical standard (i.e., TDA Interface Specification-Trilateral dossier access standard) for Trilateral Office exchange of Priority Documents. The standard will be finalized during the coming EPO/USPTO pilot project and presented for adoption at the May Trilateral Meeting in 2005 in order to achieve benefits from electronic exchange.

The Trilateral Offices believe that the format of the priority document should be specified in bilateral or multilateral agreements between the participating offices.

Project DR2: Biotechnology

The Trilateral Offices will continue to work within the Biotechnology Working Group to develop tracking mechanisms to follow trends pertaining to SNP applications and to study the impact of any new XML standard as a replacement for WIPO standard ST.25 on each Office's procedures and thereafter decide whether it is possible to implement such a standard. The Offices will also make efforts to improve database completeness by inviting WIPO to establish a mechanism for delivering sequences to public database providers and by encouraging other ISAs to do the same.

The JPO will select the technical field where chemical compound structure search is frequently done as one of the fields of the examiner exchange program to be held in Tokyo in April considering its finds of Chemical Compound Structure Search Study.

Project DR4: Non-Patent Literature

The Trilateral Offices will exchange information on the use of Digital Object Identifiers (DOIs) as a means for providing access to the full text of NPL. Each Office will continue to study the issue of NPL exchange and report to the Trilateral Offices the results of such studies. The JPO will participate in the current pilot program between the USPTO and EPO to eliminate the exchange of copies of cited documents in the ISR exchange program.

Project WT1: Linguistic Tools

The Trilateral Offices welcomed the JPO release of the Advanced Industrial Property Network on October 12 as Phase 2 of the English-Japanese Machine Translation System.

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 in English. To this end, the Trilateral Offices will establish a Trilateral Machine Translation Working Group.

Project WT2: Harmonization of Classification

The Trilateral Offices reaffirm the importance to development and implementation of IPC Reform as a necessary tool to achieve harmonization of the classification systems of the three Offices. The Trilateral Offices will continue development in this area for a January 2006 implementation date.

The Trilateral Offices recognize the importance of harmonizing classification as the basic infrastructure to facilitate harmonization in search and enhanced usability of other offices search results, reduction of redundancies and increased mutual exploitation of search results.

The EPO proposed to accelerate the Harmony project and the JPO is requested to enhance its contribution in the harmonizing classification by dispatching its examiners to engage in the harmonizing classification project.

The JPO will provide a whole data file of its Alloys database to the EPO on a regular basis.

Project WT3: F-I/F-Terms

The JPO will start producing the English translation of F-term manuals and provide them to the EPO and the USPTO.

The Trilateral Offices recognize that the English translation of F-term manuals will assist the EPO and the USPTO in the use of the F-term system. The JPO will investigate the possibility of sharing information regarding discrepancies found between the use of their machine translation tools and human translation.

Project PI1: Information Dissemination Policies

The Trilateral Offices reinforce its commitment to use the Internet as the key dissemination tool for patent information in the future. Each office will use the internet

in ways that are appropriate in light of individual legal, technological, and data requirements. One of the projects in this respect is the Japanese interface for esp@cenet which is being developed by the EPO in cooperation with the JPO and will be launched in 2005. Further projects can be a Japanese interface to epoline and the implementation of linguistic tools in these applications.

The Trilateral Offices appreciate the contribution of the private sector in their information dissemination efforts and will each encourage a continuing dialog with these organizations.

Project LEG: Legal Issues

The Trilateral Offices recognize the importance of patent law harmonization and note that harmonization of prior art issues will likely improve quality and contribute to reduction of workloads in the three Offices and reduce costs for applicants. With this in mind and in order to advance discussions on patent law harmonization, the Trilateral Offices will base further harmonization work on a limited package of issues and work toward harmonizing on that basis.

The USPTO is planning to convene a meeting, outside of the context of the Trilateral, to explore next steps in patent law harmonization. The USPTO and the JPO encourage the EPO's participation in such a meeting and the EPO will address the issue at the December 2004 meeting of the EPO Administrative Council.

The Trilateral Offices will conduct a comparative study on their respective novelty practices with a view to further developing the enlarged novelty concept. Such study will employ example fact patterns from each office. The USPTO will take the lead in drafting examples. The USPTO will continue its current study on enlarged novelty involving the review of file histories of applications and will provide the results to the Trilateral Patent Harmonization Working Group.

The Trilateral Offices will continue discussions on the adoption of a 30-month priority period as an additional system to the international filing systems under the PCT and the Paris Convention. The JPO will also propose a system that may include a transitional period of 30-months before filing a national application in an office of second filing. The USPTO will continue to refine its discussion paper taking into consideration the concerns (for example the Hilmer doctrine and 35USC 102(e)) raised by the EPO and the JPO and request that any further comments be submitted in writing within the next couple of months.

Other Issues

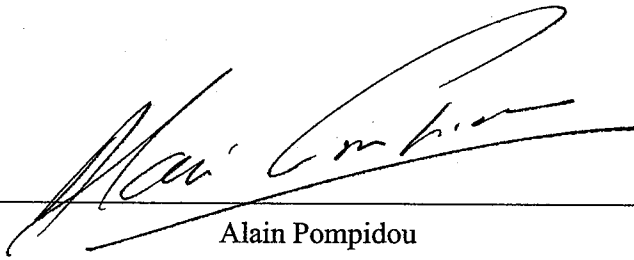
The Trilateral Offices will continue, with respect to the PCT, the discussions on streamlining PCT operations, including usefulness of capturing applications in electronic form at the Receiving Office in order to enhance processing of applications at WIPO.

The Trilateral Offices also will continue consulting with one another on patent law issues concerning genetic resources and traditional knowledge, particularly with respect to proposed new disclosure requirements in patent applications.

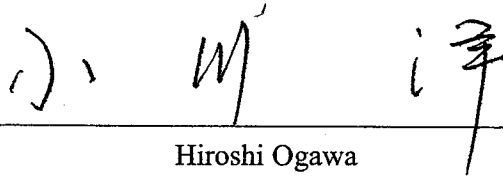
The USPTO and the JPO support the concept of not duplicating work in the creation of a Worldwide Patent Statistical Database. The EPO will meet with WIPO to start cooperation for the creation of such a database.

The Trilateral Offices recognize that quality standards are an important priority to consider when establishing new International Search and Examination Authorities under the PCT. The JPO and the EPO suggest that the number of the domestic/international applications might be further criteria to be considered. In this regard, the USPTO will elaborate appropriate proposals and will circulate the proposals to the other Trilateral Offices for comment.

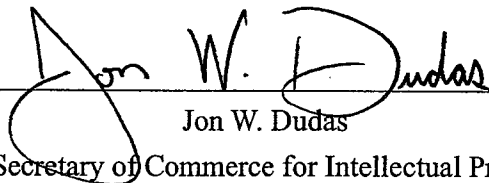
Done in Alexandria, Virginia
in the United States of America
November 19, 2004



Alain Pompidou
President
European Patent Office



Hiroshi Ogawa
Commissioner
Japan Patent Office



Jon W. Dudas
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office