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AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

Hon. Alison Brimelow
President
European Patent Office

Hon. Takashi Suzuki
Commissioner
Japan Patent Office

Hon. John Doll
Acting Undersecretary of Commerce for Intellectual Property and Director
United States Patent and Trademark Office

June 26, 2009

Dear Trilateral Office Heads,

Organizations representing intellectual property interests of industry in the regions of the Trilateral Patent Offices agreed at their first meeting in Nice, France, in 2003, to form an "Industry Trilateral" to cooperate in developing and expressing a coordinated view of industry on intellectual property matters.

The Industry Trilateral has agreed to the attached Resolution that recommends adoption of a common citation document. The Resolution also recommends that the Trilateral Offices should encourage other National Offices and international organizations to adopt the same common citation document. Further, it is recommended that such common citation document should be based on a format outlined in the Industry Trilateral document entitled "Common Citation Document Proposal", a copy of which is attached, together with an Annex.

We commend your consideration of the attached Resolution, Proposal and Annex.



Philippe de Buck
BUSINESSEUROPE Director General



Tsuneaki Hagiwara
President of JIPA



Steven W. Miller
President of IPO



Teresa Stanek Rea
President of AIPLA

Attachments (3)



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RESOLUTION

Common Citation Document

On behalf of the Industry Trilateral -- AIPLA, IPO, BusinessEurope, and JIPA -- we would like to express our deep appreciation to the Trilateral Offices for their effort creating the common application format, because such uniform format could dramatically reduce application costs for obtaining patents from multiple Offices. The Industry Trilateral wishes to continuously expand the principle of a uniform format beyond the application specification, and believes a common format for search reports – both from applicants and from the Trilateral Offices -- may improve the harmonization of search reporting and the recording of relevant art.

In the interests of harmonization and efficiency it is resolved that the Trilateral Offices should adopt a common citation document to be used by each Office by means of which all art citations by that Office, including art cited in official search reports, office actions, information disclosure statements, and art submissions by the applicant and/or third parties, can be recorded in a common format with a view to facilitating the efficient access to and reuse of search and disclosure efforts for related applications.

It is resolved that the Trilateral Offices/WIPO should develop a single repository of citation information for each patent family as a whole, using the Common Citation Document.

It is resolved that the Trilateral Offices in turn should encourage other National Patent Offices and international organizations to adopt the same Common Citation Document.

It is resolved that such Common Citation Document should be based on PCT form ISA/210, an example of a suitable format being outlined in the Industry Trilateral document entitled "Common Citation Document Proposal"

26 June 2009

Common Citation Document Proposal

Objectives and Advantages

There are various stages in the patent application process during which information about art documents of possible relevance to the patent application in question become available. In particular, prior art may be identified by the applicant before filing or during prosecution, and may be identified by an official search. For a particular international family of patent applications various iterations of each of these stages may occur before each national or regional office, or during the PCT process, all relating to essentially the same invention, each of which takes a different form such that earlier efforts are difficult to reuse, and may often be duplicated. As part of a broader effort to harmonise patent processing and reduce duplication of effort, the present proposal puts forward a Common Citation Document, which the Industry Trilateral proposes should be used by all patent offices and applicants, in all circumstances concerning the recordal of documents, such as those mentioned above. By adopting such a Common Citation Document, the efficient access to and reuse of search and disclosure efforts for earlier related applications is facilitated. Still further, a single repository of citation information for a patent family as a whole, to which a variety of protagonists may add as the patent family develops can be envisaged.

At the November 2005 Trilateral pre-conference, the United States Patent and Trademark Office presented a search sharing proposal (“Triway”) that would leverage the searching expertise of each of the Trilateral Offices to the benefits of both applicants and the offices. The Trilateral Offices agreed at the November 2007 trilateral pre-conference to undertake a limited pilot program to commence on July 28, 2008. The present Common Citation Document proposal complements and enhances the search sharing proposal by ensuring that citations from each office are available in a standardised form easily recognizable by the examiners of multiple offices. Meanwhile, the Triway approach of reusing and building upon the work of other offices reflects the “single repository” concept presented herein.

Implementation Details

A proposed Common Citation Document has been drawn up with official search reports, US Information Disclosure Statements and EPO post filing acknowledgement of the prior art in mind.

A version of such proposed Common Citation Document is attached as Annex 1. It would be used differently depending on which of the three roles identified above it was to fulfil at any given time:

- The document is based on the PCT International Search Report form, and as such would be easily adopted for PCT and EPO searches
- For US IDS purposes, one or more citation documents resulting either from official searches carried out for earlier applications, or filled in by the applicant to disclose other documents, might be gathered together and submitted by a suitable covering letter. The applicant would not be required to attribute a category to the citations, or provide any other information beyond that required by the relevant legal provisions.

- In the case of the acknowledgement of prior art in a European Patent application, it is suggested that the citation document or documents be filed as annexes to the specification. This could be done by including in the specification the phrase "prior art documents are acknowledged in appendix 1". This approach is in line with the Industry Trilateral's recommendation that applicants should not be obliged to amend the description text of an application to acknowledge prior art documents identified during the application procedure.

The suggestion is that a family of patents will gather a number of citation documents as the individual family members progress, which will lead to the formation of a contiguous series of documents listing all art relevant to the family as a whole. The "Index" field might permit each such document to be consecutively numbered so that the series could easily be constituted as required.

Several fields are only required for official search reports, so an abbreviated version might be envisaged, in which case the need for the shading of the zones required only for official search reports in the general purpose document attached would be reduced.

It is further proposed that a standard Common Citation Document specification be established, defining not only the format of the document itself, but also standard typesetting requirements and a set of text tags or symbols to facilitate the electronic capture of information from Common Citation Documents in accordance with the present proposal.

26 June 2009

COMMON CITATION DOCUMENT

Citation Document Type	Index	Application no.
"d" disclosure at filing or IDS	Consecutive numbering of citation documents for the patent family	
"e" official search report <small>Shaded cells reserved for this type</small>		
"f" post-filing acknowledgement of prior art		

A. CLASSIFICATION OF SUBJECT MATTER
 According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum Documentation Searched (Classification system followed by classification symbols)

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the search (name of data base and, where practical, search terms used)

IDS only Examiner Initials*	Category*	C. DOCUMENTS CONSIDERED TO BE RELEVANT		Relevant to claim No.
		Citation of document, with indication, where appropriate of the relevant passages	Voluntary comments attached	

Further documents are listed in the continuation of Box C See patent family annex

D. Claims not searched.

* Special categories of cited documents :

<p>"A" document defining the general state of the art which is not considered to be of particular relevance</p> <p>"E" earlier document but published on or after the filing date</p> <p>"L" document which may throw doubts on priority claim (s) or which is cited to establish the publication date of another citation or other special reason (as specified)</p> <p>"O" document referring to an oral disclosure, use, exhibition or other means</p> <p>"P" document published prior to the filing date but later than the priority date claimed</p>	<p>"T" later document published after the filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention</p> <p>"X" document of particular relevance: the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone</p> <p>"Y" document of particular relevance: the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.</p> <p>"&" document member of the same patent family</p>
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Date of the actual completion of the search (document type "e" or filing of document (document type "d" or "f"))	Date of mailing of the search report (document type "e")
Name and mailing address of the official Search Authority	Authorised officer