

# ***PLANNING THE FUTURE OF A GLOBAL IP PRACTICE***

## ***The User's Voice in Plural-Office Initiatives***

***FICPI 15<sup>th</sup> OPEN FORUM***

***November 5-8, 2014***

***Barcelona, Spain***

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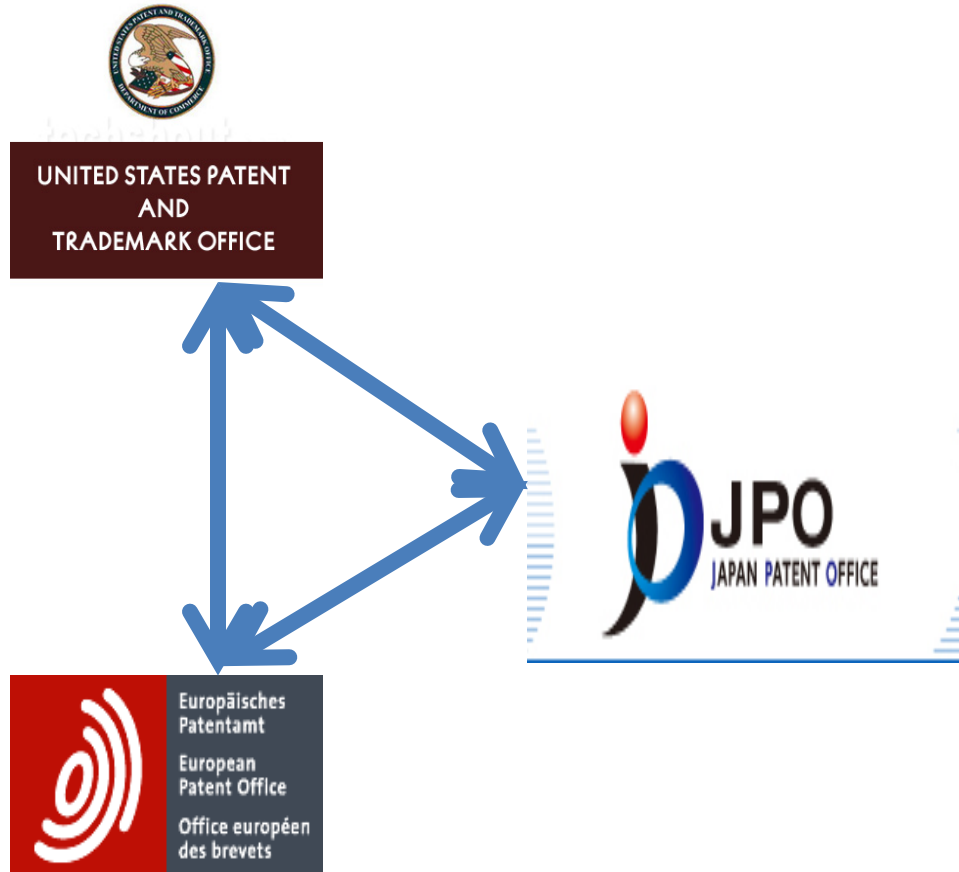
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# A NEW ERA OF OFFICE/USER COOPERATION AND COMMUNICATION

- **Trilateral Offices – *the Industry Trilateral***
  - CAF, CCD, PPH
- **IP5 Offices – *the Industry IP5***
  - One Portal Dossier
  - Global Dossier
  - Key Harmonization Issues
- **Tegernsee Group – *the Tegernsee User Consultation***
  - Substantive Harmonization Issues

# TRILATERAL OFFICES COOPERATION



- **Office-to-Office Dialogue Began in 1983**
- **User Input Began in 2002 following demands for a voice:**
  - Business Europe
  - JIPA
  - IPO/AIPLA
- **Annual Office/User Meetings thru 2012 & again in 2014**
- **Key User Issues were Focused on Cost Savings, Quality and Backlog**

# **TRILATERAL OFFICE INITIATIVES BASED ON USER INPUT**

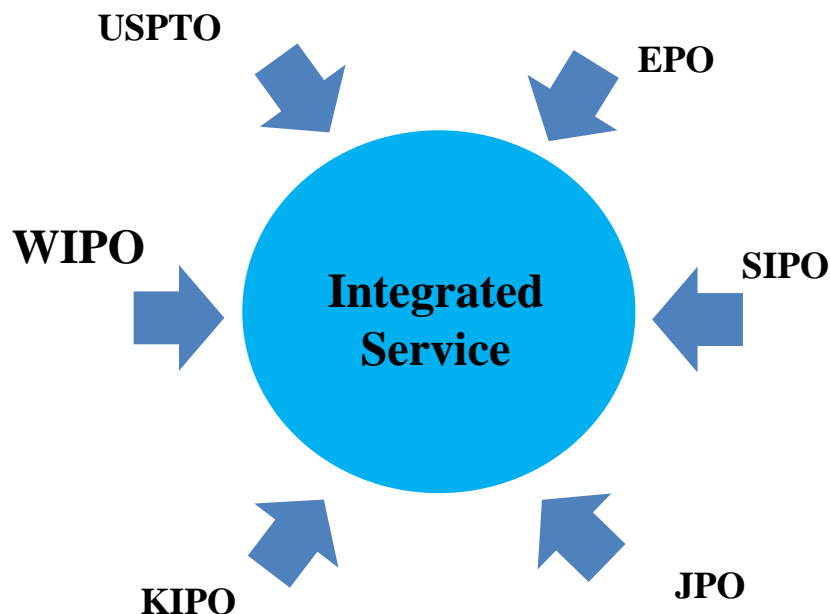
## **Initial User-Focused Project**

- Expert Group Study Asserted \$300M cost savings if key requirements changed at the EPO, JPO and USPTO
  - Established Office/User Working Group
  - Resulted in Common Application Format (CAF)

## **Subsequent User-Focused Projects**

- PPH & PCT Improvements
- Common Citation Document (CCD)
- Classification and Quality
- Procedural Harmonization -Prioritized recommendations to IP5

# IP5 OFFICES COOPERATION



- **5-Office Agreement in 2007**
- **User Input and Participation Demanded from the Beginning**
- **Trilateral Users already established – quest for CN and KR user groups**
- **First User participation began in 2009**
  - Business Europe
  - JIPA
  - IPO/AIPLA
  - KINPA
  - PPAC
- **Key User Issues Focused on Cost Savings, Quality and Backlog**

# **IP5 OFFICE INITIATIVES BASED ON USER INPUT**

- **IP5**
  - **EPO/JPO/KIPO/SIPO/USPTO**
    - 80% of all global filings; 95% of all PCT filings
  - **Vision** – *The elimination of unnecessary duplication of work among the offices, enhancement of patent examination efficiency and quality, and guarantee of the stability of patent rights.*
  - **User Coordination** - *The offices therefore endeavour to bring on board the views of industry, and other offices that share the need for action.*
- **CURRENT PROJECTS**
  - 10 original Foundation Projects ([www.fiveipoffices.org](http://www.fiveipoffices.org))
  - Focus of Current Projects (2013)

# IP5 Initiatives

## ▪ OFFICE GOALS

- Effect Global Cooperation
- Promote Work Sharing among Offices
  - Reduced duplication of work
- Provide a Common Approach to Search/Examination Quality and Reliability
- Promote User Input and Access
- Provide Enhanced Transparency

## ▪ KEY PROJECTS

- Migration – *Distributed to Integrated Service*
- Common Application Format
- Common Citation Document
- One Portal Dossier
- Global Dossier
  - Passive
  - Active - Cross Filing
- Procedural Harmonization

# IP5 PROJECT STRUCTURE

- **THREE OFFICE WORKING GROUPS**
  - WG1 – Classification
  - WG2 – Global Dossier & Patent Information
  - WG3 – Work Sharing & Quality (PPH & PCT)
- **USER PARTICIPATION**
  - **Global Dossier Task Force**
    - Meeting 2013 and **Scheduled 2015**
  - **Patent Harmonization Experts Panel (PHEP)**
    - Industry list of prioritized topics
    - Reduced List – (1) Citation of prior art, (2) Written Description & Sufficiency of Disclosure (3) Unity
    - Meeting October 2014



# **COMMON APPLICATION FORMAT**

- **Origins in Trilateral Discussions With Users (2007)**
- **Migration to IP5 (2012)**
- **IP5 Vision**
  - **Each Office accepts domestic and PCT applications in a Common Application Format (CAF) to make filing procedure for multiple countries easier.**
  - **All applications are filed with Offices electronically or digitized (**XML format**) by the Office of First Filing (or Receiving Office) at an early stage**
  - **All procedures following the filing of an application (i.e., office actions, amendments etc.) are processed and the applications are published in **XML format** at each Offices**

# **COMMON APPLICATION FORMAT**

## **Goals**

- Harmonize divergent filing requirements of Offices
- Facilitate machine translations
- Permit Uniform processing and monitoring

## **Features**

- Applies XML tags
- Based on best practices applied to PCT format
- Reduces differences in filing requirements
  - Numbers in claims
  - ID of prior art in specification

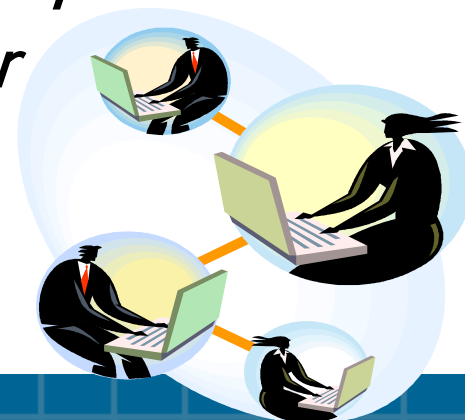


# **COMMON CITATION DOCUMENT**

- ❖ **A Tool for One Portal Access to Family Applications**
  - ❖ **Includes prosecution history and prior art**
  - ❖ **Full IP5 participation agreed (May 2012)**
    - ❖ **Goal is all data enriched – full links**
    - ❖ **Currently, USPTO and JPO not enriched**
  - ❖ **EPO currently hosts CCD at [www.fiveipofices.org/ccd](http://www.fiveipofices.org/ccd)**
    - ❖ **Access to cited art (approx 140 million citations)**
  - ❖ **Data display – according to CPC**

# ONE PORTAL DOSSIER

- *A web-based service that provides Examiners access to all dossier information of a family of applications*
- *Interface may be common (by agreement) of individual*
- *One stop service for IP5 Examiners:*
  - *Access other office dossier via one portal*
  - *Active links to cited documents or classifications using XML data*
  - *Monitoring of prosecution*
  - *Enrichment of information*

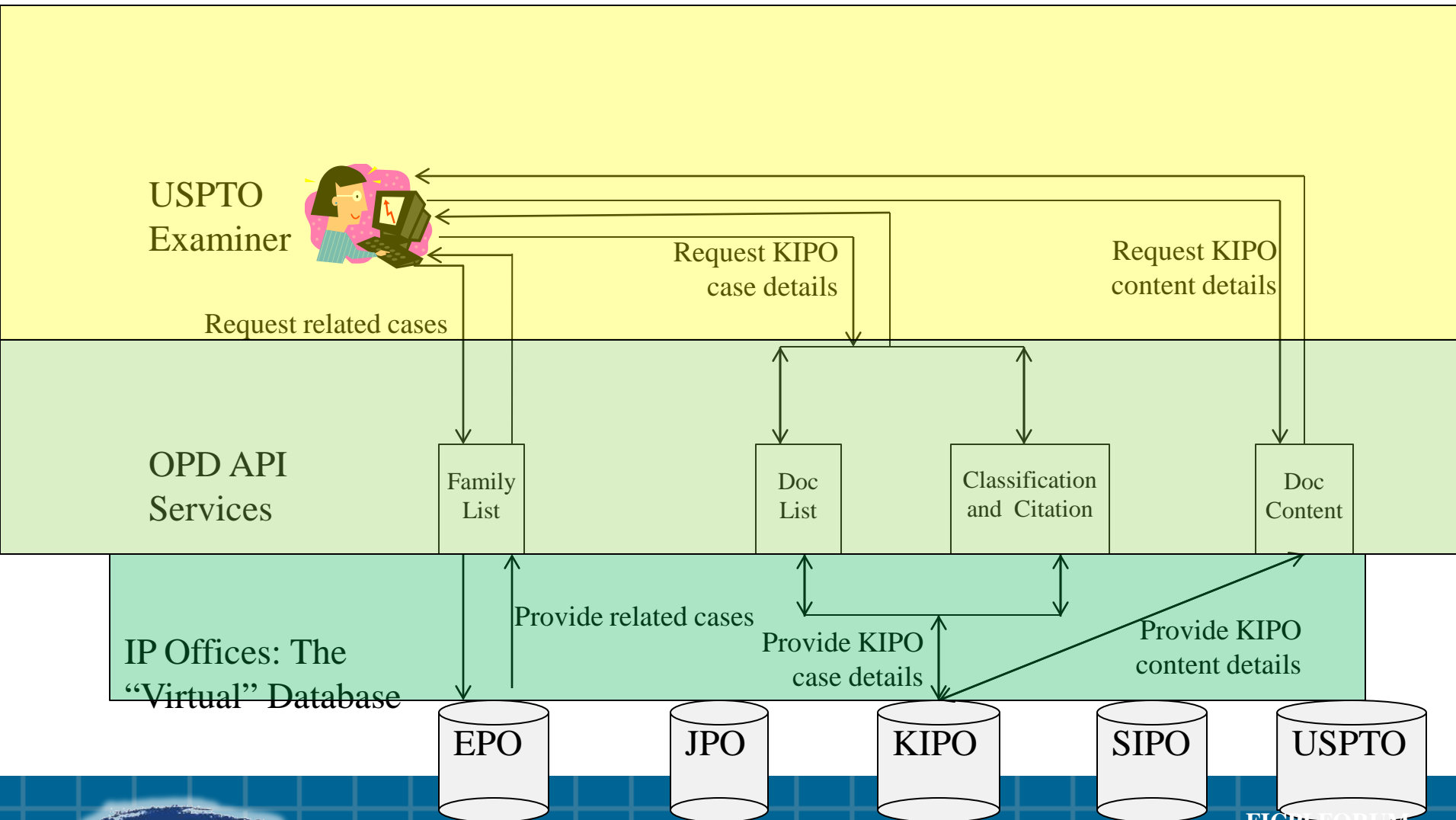


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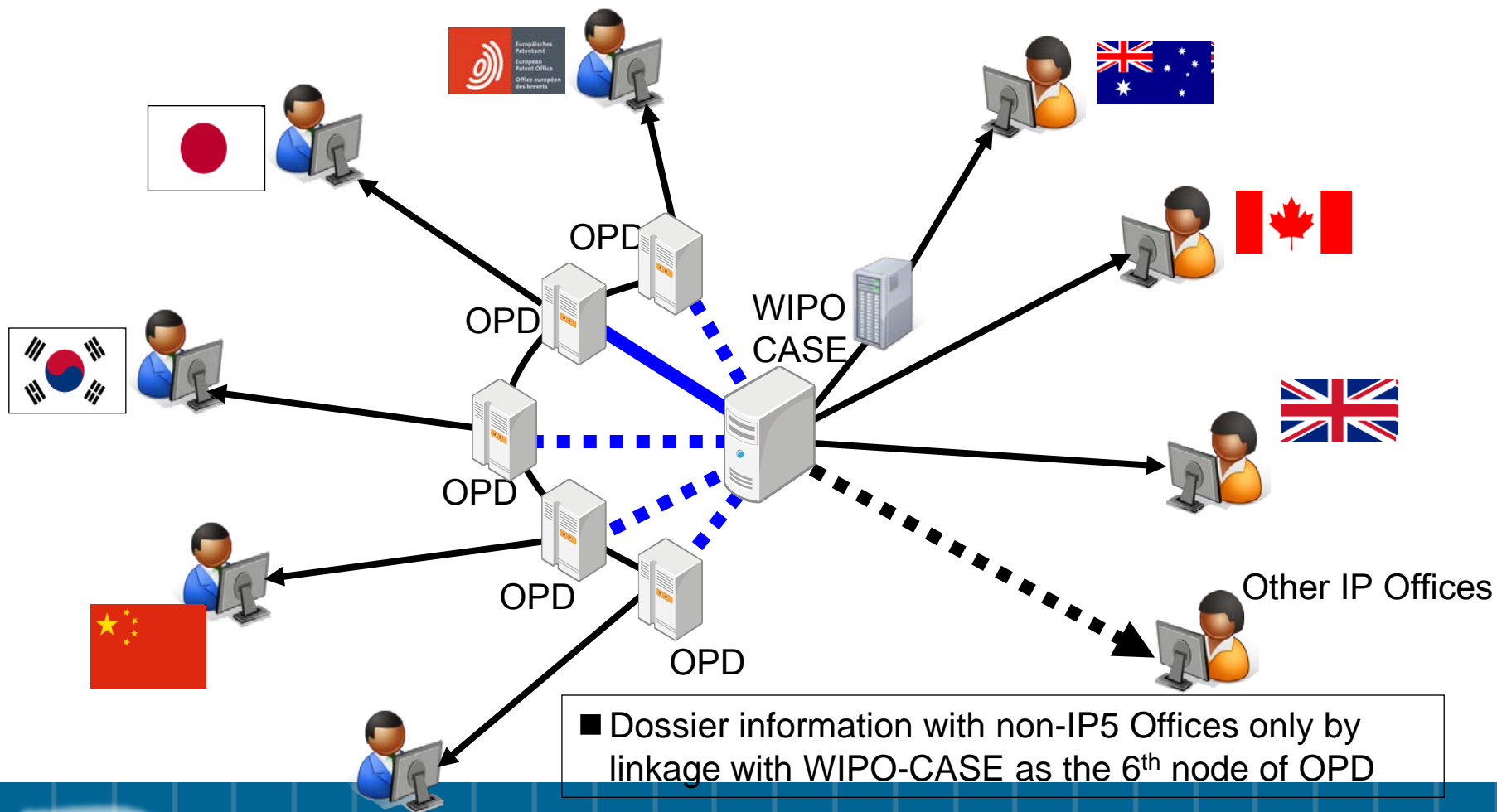
# One Portal Dossier (OPD) in the USPTO

- Virtual Database of *ALL* related cases in the IP5 Offices
- Four Service API Specifications - Mutually Developed by the IP5 Offices
  - *Family List Service*: Returns related cases for a requested application
  - *DocList Service*: Returns a Table of Contents of documents in a filewrapper for a Requested Case
  - *DocContent Service*: Returns the actual contents of the filewrapper for a requested document, e.g., Office Action
  - *Classification and Citation Service*: Returns the classification and any citation data for a requested case
- Automatic machine-translation of actions/responses into English
- Implementation in the USPTO – USPTO currently a “providing” office (July 2013)
- Implementation for Users – *with Global Dossier*

# OPD Example Workflow



# Connection of IP5 OPD with WIPO-CASE



# From OPD to Global Dossier



Patent  
Examiners



Law Firms



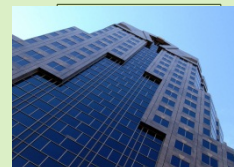
Industry  
Groups



Applicants



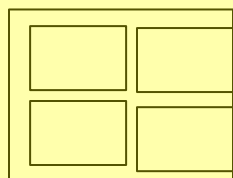
Public and  
3<sup>rd</sup> Parties



Other IP  
Offices

Stakeholders

API  
Services



OPD Services

Cross Filing  
Services

Global  
Payment  
Services

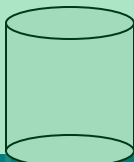
Public Access  
Services

Collaboration  
Services

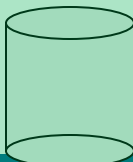
Worksharing  
Services

IP Offices:  
“Virtual”  
Database

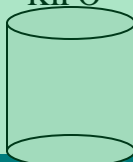
EPO



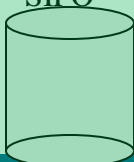
JPO



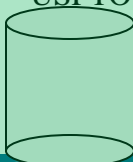
KIPO



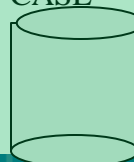
SIPO



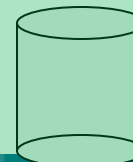
USPTO



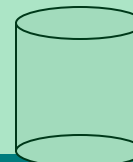
WIPO  
CASE



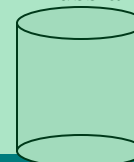
ASEAN



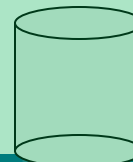
Israel



Russia



Others

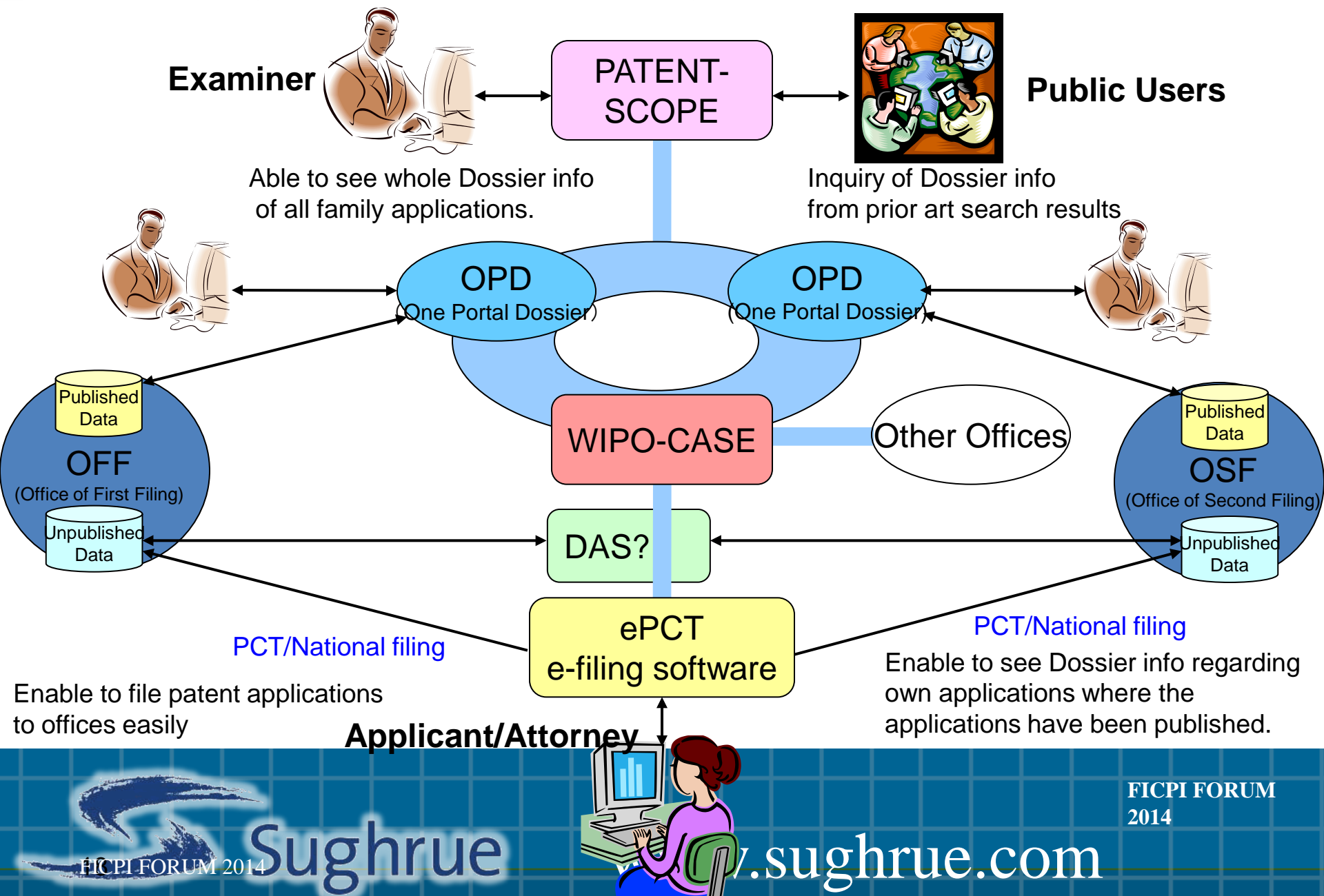




# **GLOBAL DOSSIER**

- *Provides a Set of Business Services Based on an Integrated On-Line Web Portal/User Interface*
- **Users Have Two-Way Access to Participating Office Dossiers**
  - **Passive – public access to One Portal Dossier**
  - **Active – Public use of OPD**
    - **Access to non-confidential information**
    - **- Applicant use of OPD**
    - **Access to information**
    - **Communication/Collaboration with Examiners**
- **Machine translation capability a primary goal**
- *Leads to harmonization/streamlining of Procedures among Participating Offices*

# Future Image of Global Dossier System (possible scenario)



FICPI FORUM  
2014

FICPI FORUM 2014

Sughrue

www.sughrue.com

# **ACTIVE & PASSIVE APPLICATION ACCESS AND FUTURE GOALS**

- **PASSIVE – file inspection**
- **ACTIVE - Cross Filing – an applicant in one country can file in a home country and effect filing in other countries via the OPD interface:**
  - Select countries & representatives
  - Effect timing of filing
  - Monitor filing databases
  - Correct errors
- **FUTURE GOALS – common:**
  - Application Format
  - Language – English
  - Mailbox
  - Examination Report for all IP5

# **TEGERNSEE GROUP COOPERATION**

- **Danish Patent Office (DKPTO)**
- **German MOJ/Patent Offices (BMJV/DPMA)**
- **European Patent Office (EPO)**
- **French Patent Office (INPI)**
- **Japan Patent Office (JPO)**
- **United Kingdom Patent Office (UKIPO)**
- **US Patent & Trademark Office (USPTO)**
- **Heads of Office Meeting in 2011**
- **New Dialogue - International Harmonization of Substantive Patent Law**
- **Included an Experts Group**
- **Initiative for Broad User Input Began in 2012:**
  - **Survey using Tegernsee Joint Questionnaire**
  - **Hearings and Roundtables**
- **Key User Issues were Focused on Substantive Harmonization**
- **Report in 2014**

# Tegernsee Group Subjects

## ▪ Comprehensive List

- First Inventor to File
- Grace Period
- Prior User Rights
- Scope of Prior Art
- Definition of Novelty and non-Obviousness/Inventive step
- 18 Month Publication

## ▪ Topics Studied

- Grace Period
- Prior User Rights
- 18 Month Publication
- **Treatment of Conflicting Applications**

# **Results of User Consultation**

## **❖ GRACE PERIOD**

- ❖ Majority favors some grace period
- ❖ Divergence of views on systemic importance and requirements – duration, declaration, start date

## **❖ PUBLICATION OF APPLICATIONS AT 18 MONTHS**

- ❖ Majority prefers NO opt-out, few use opt-out
- ❖ Generally NO negative effect of opt-out

## **❖ TREATMENT OF CONFLICTING APPLICATIONS**

- ❖ Infrequent but important to harmonization

## **❖ PRIOR USER RIGHTS**

- ❖ Valuable statistics on use in counseling and litigation
- ❖ Variable support for criteria to qualify for defense and scope of defense

# **CONCLUSIONS**

- ❖ **IP5 and other Offices are aggressively working**
  - ❖ **System and procedural harmonization**
  - ❖ **Substantive harmonization**
- ❖ **User input is aggressively sought**
  - ❖ **Domestic and Regional consultation**
  - ❖ **International task forces and working groups**
- ❖ **Increased funding, Office restructuring and IT developments will ensure timely achievement of results**

# Thanks for your attention!



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