

## Summary Report of the 4<sup>th</sup> Trilateral IP Systems User's Conference

On April 11, 2005, the 4<sup>th</sup> Trilateral IP Systems User's Conference was held at the UNICE Headquarters in Brussels in order to discuss patent issues shared by applicants and patentees in Japan, the United States, and Europe. This platform conference consists of the Japan Intellectual Property Association (JIPA), the Intellectual Property Owners Association (IPO), the American Intellectual Property Law Association (AIPLA), and the Union of Industrial and Employers' Confederation of Europe (UNICE).

Eight members including Mr. Yasuo Sakuta (President in FY2004) participated in the meeting from JIPA (including three participants as observers). After the meeting, three of them visited the World Intellectual Property Organization (WIPO) and the European Patent Office (EPO) as our delegation, and exchanged opinions and information at these organizations.

The primary purpose of this conference is to make recommendations to the Trilateral Offices (JPO, EPO, and USPTO) from the perspective of reducing patent costs, promoting legal certainty, and reducing pendency, and request them to implement recommended measures that are more feasible.

At this meeting, constructive discussion was held so as to make feasible recommendations regarding harmonization of patent laws, and in particular, common patent application forms (based on PCT application forms that can be electronically filed) and trilateral patent search.

As a result of discussion so far, a series of joint resolutions were adopted at this meeting. For the following three resolutions, please read the next page and after.

- Opposition to the raising of application fees under the WIPO/PCT
- Resolution on Substantive Patent Law Harmonization Treaty
- Support for the efforts of the trilateral offices

The next meeting would be held at JIPA's office on February 23, 2006.





RESOLUTION FOR A PATH FORWARD IN WIPO HARMONIZATION TALKS  
FROM THE INDUSTRY TRILATERAL

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.

At its second meeting, held in Tokyo in February, 2004, the Industry Trilateral discussed and adopted the attached resolution favoring a reduced scope for the patent law harmonization talks being held under the auspices of the World Intellectual Property Organization in the Standing Committee on Patents. It is believed that by focusing on the adoption of common search and examination standards that the discussions in WIPO will have the best chance to provide applicants with legal certainty regarding the patentability of their inventions and to relieve the pressures of the growing workloads of the EPO, JPO, and USPTO.

We commend your consideration of the attached resolution.

Philippe de Buck  
UNICE Secretary General

J. Jeffrey Hawley  
President of IPO

Y. Sakuta  
President of JIPA

Rick Nydegger  
President of AIPLA



## RESOLUTION

### Substantive Patent Law Harmonization Treaty

The Industry Trilateral comprising representatives of industry from Europe, Japan, and the United States:

Desiring the negotiation and conclusion of an effective Substantive Patent Law Treaty (SPLT) that will reduce costs to applicants and industrial property offices, promote legal certainty, and reduce pendency;

Believing that far too many difficult and divisive issues have been introduced into the negotiations of the SPLT resulting in little progress toward the desired goal of an effective SPLT;

Recognizing that opinions of governmental and non-governmental representatives are widely divergent on these many issues, rendering the conclusion of negotiations on the entire set of issues currently under discussion unlikely in the foreseeable future;

Further recognizing that any package of issues to be negotiated should provide balance to the desires and needs of applicants from the Member States of the World Intellectual Property Organization, as well as address the desires and needs of industrial property offices in these Member States;

Therefore Recommends that the Standing Committee on Patents concentrate its efforts on a reduced set of provisions which will lead industrial property offices to the adoption of common search and examination standards and provide applicants with legal certainty regarding the patentability of their inventions; and

Specifically, Recommends that the harmonization of substantive patent laws in the SCP initially concentrate on achieving a reduced harmonization package containing the following provisions:

- a first-to-file system of priority,
- an international grace period for a first-to-file system,
- an agreed definition of prior art having no geographic limitations
- an agreed definition of how and when pending published patent applications, including PCT applications, are to be used as prior art, including any necessary solution for double patenting.



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 22<sup>nd</sup> 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,

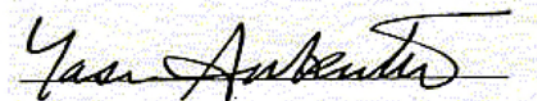
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Yasuo Sakuta  
President of JIPA



William C. Rooklidge  
President of AIPLA

