



International Policies and Norms to Address Emerging IP Challenges

WIPO High Level Forum on the Global Intellectual Property Infrastructure for Promotion of Innovation

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- "The world is moving forward rapidly and decisively into an era where societies and economies are incrementally based on knowledge. The importance of nations in the 21st Century shall be judged not by their economic strength alone, but also by their power to conceptualize inventions and bring their benefits to people."

Pratihba Devisingh Patil

President of the Republic of India

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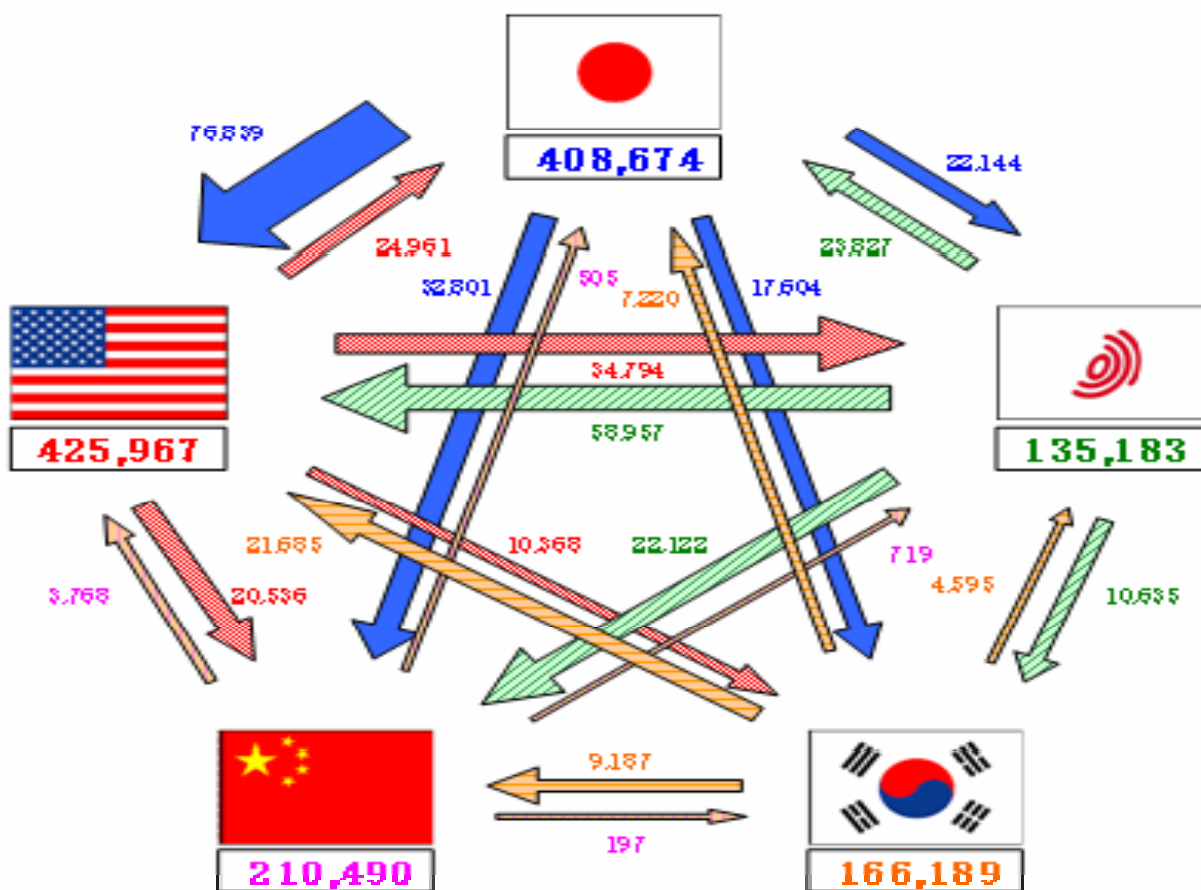
PATENTS

Three truths:

Research and invention are at the root of all innovation.

Patents can protect inventions.

The world's patent offices are awash in patent applications, with no end in sight.





PATENTS

- No office can go it alone any longer.
- Sharing the workload is the only way to go.
- The aim of worksharing is the elimination of unnecessary duplication of work among the offices, enhancement of patent examination efficiency and quality, and guarantee of the stability of patent right. (Jeju Island Summit, 2008)



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Who is Involved, Where, and Since When?

- Nearly three decades of cooperation:
 - Trilateral Offices (EPO, JPO USPTO) since 1983;
 - IP5 Offices (EPO, JPO, KIPO, SIPO, USPTO) since 2007.
- Bilateral Cooperation through Patent Prosecution Highway (PPH)



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- Patent Prosecution Highway
 - Pilot launch with JPO in 2006
 - First true, implemented worksharing program
- Strategic Handling of Applications for Rapid Examination (SHARE)
- PCT
- IP5 Foundation Projects
- Other collaborative programs



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- **What is PPH?**

When claims are determined to be allowable in the Office of First Filing (OFF), a corresponding application with corresponding claims filed in the Office of Second Filing (OSF) may be advanced out of turn.

- **What is the Purpose of PPH?**

- OSF can utilize the search and examination results of the OFF thereby avoiding duplication of work and expediting the examination process in the OSF.



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PPH Benefits for Applicant

- Provides quicker patentability determination in multiple jurisdictions
- Decreases costs of prosecution



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PPH Benefits for Offices

- Avoid redundant work by reuse of OFF work product
- Claims reduced in number and narrowed in scope to what was previously allowed
- Reduced Pendency

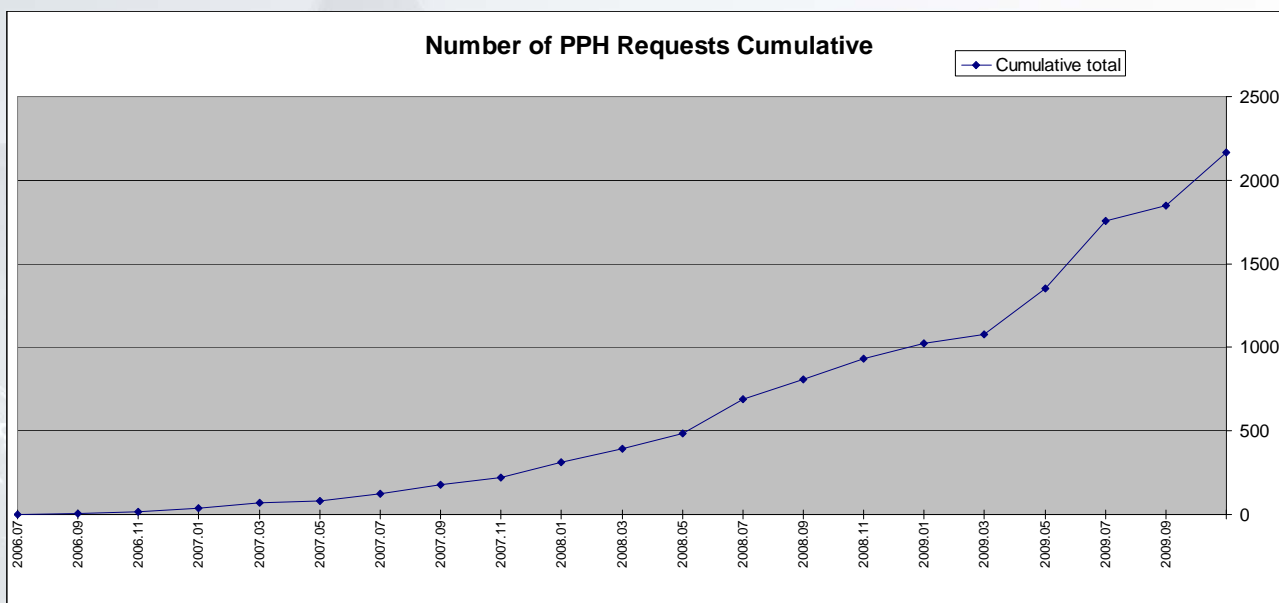


Current and Planned PPH Programs

- Japan (JPO) (full production 2008)
- Korea (KIPO) (full production 2009)
- Australia (IPAU)
- Canada (CIPO)
- Denmark (DKPTO)
- European Patent Office (EPO)
- Finland (NBPR)
- Germany (DPMA)
- Singapore (IPOS)
- United Kingdom (UK IPO)
- Russian Federation (Rospatent) (in discussions)
- Trilateral PCT-PPH (January 2010)



PPH Statistics





PPH Statistics

Overall Allowance Rate

- PPH cases: 93%
- Non-PPH cases: 44%

Actions per disposal

- PPH cases: 1.7
- Non-PPH cases: 2.7

About 20% reduction in number of claims

Pendency reduction varies, but an 18 month decrease has been observed in some technologies

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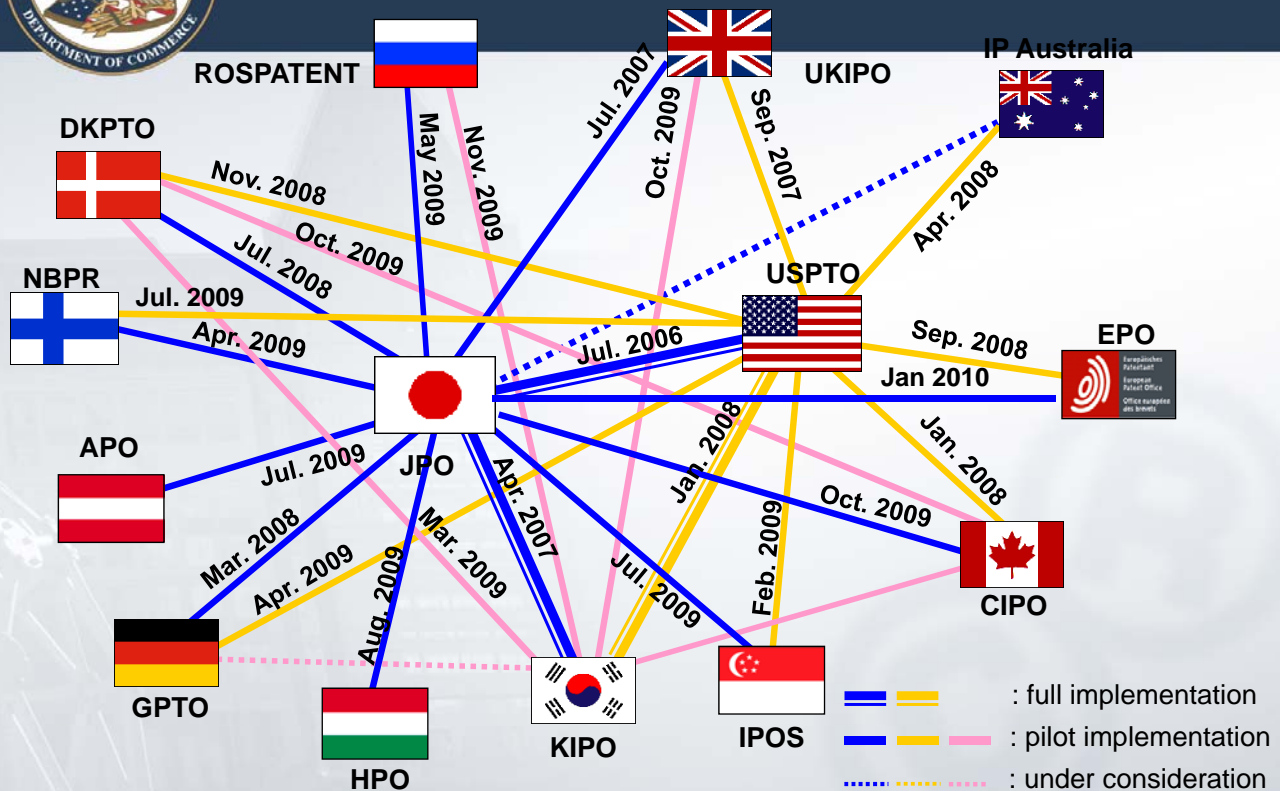
Future Plans

- **USPTO Action Plan to enhance PPH:**
 - define target numerical goals and develop global strategy to reach those goals
 - Align PPH and PCT via the Trilateral pilot program
 - Conduct PPH awareness campaigns, internationally and domestically
- **“Plurilateral” PPH Cooperation**
 - Streamline procedures
 - Share best practices and statistics
 - Provide users with one stop access to information

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The Expanding PPH Network



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SHARE Background

- The concept of SHARE (Strategic Handling of Applications for Rapid Examination) arose out of the discussions among the Trilateral Offices
- A 2004 study conducted by the Trilateral Offices showed that the timing of the availability of OFF search and examination results relative to OSF pendency is a key to worksharing, and that the situation at that time was far from optimal
- In SHARE, applications for which an office is the OFF are moved ahead of second filings in the OFF examination queue
- SHARE is expected to enhance the worksharing environment by increasing the volume of exploitable work product available from the OFF prior to the OSF beginning its own search/examination

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SHARE Benefits

- Increase examination efficiency
- Reduce pendency
- Complements PPH—more OFF work available prior to OSF work commencing means more PPH potential

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SHARE Status

- USPTO has established an internal task force with a view to implementing SHARE in 2010
- The JPO's version of SHARE, JP-FIRST, launched in April 2008
- EPO's PACE program has attributes of SHARE
- More information on these programs is available at http://www.epo.org/patents/law/legal-texts/html/guiapp1/e/ga_aai.htm. and www.jpo.go.jp

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Worksharing and the PCT System

- PCT was established as a worksharing framework, but its benefits have never been fully realized
- Way forward
 - WIPO “Roadmap” (quality, timing, simplification)
 - PPH/PCT
 - Internal process improvements—USPTO Task Force

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IP5 Foundation Projects



Search Strategy

Documented Search Strategy Approach
USPTO



Search & Exam Tools

Common Search & Exam Environment
USPTO



Common Documentation

Common Prior Art Data Set
EPO



Common Classification

Shared Approach to Patent Classification
EPO



Training Policy

Standardized Examiner Training
KIPO



Machine Translation

Mutual Access to Translated Information
KIPO



One Portal Dossier

One-Stop Access to Dossier Information
JPO



Common Application Format

Common Electronic Application Filing Format
JPO



Common Rules & QC

Common Rules for Exam Practice & Quality
SIPO



Common Statistics

Common Statistical Parameters
SIPO

Systems Harmonization: Applications, databases, examination tools, policies, performance measures

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Systems Harmonization IP5 Foundation Projects

- Common Approach to Sharing and Documenting Search Strategies– a means to enable examiners to document the approach and strategy associated with a search of a patent application so that it can be replicated and shared between the offices
- Common Search and Examination Support Tools- a common search and examination environment so each office has the ability to produce and reproduce equivalent search results for each application that is examined

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Systems Harmonization IP5 Foundation Projects

- Common Documentation – an extensive set of existing prior art sources enabling each office to search the same documentation
- Common Classification – a system that incorporates and improves upon the best features of each Office's current system, facilitating efficient, high-quality searching of all documents issued and classified by the Offices

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Systems Harmonization IP5 Foundation Projects

- Common Training Policy - standardize training policies and tools so that patent examiners at each of the Offices approach examination from a common knowledge base
- Mutual Machine Translation - overcome language barriers among the Offices and allow greater access to each office's patent information
- One Portal Dossier- a tool enabling examiners to access the dossier information of each of the IP5 Offices using a single interface

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Systems Harmonization IP5 Foundation Projects

- Common Application Format – a standard application format recognized by all offices to facilitate efficient filing procedures
- Common Rules for Examination and Quality Control - enable the Offices to conduct patent examinations under common rules which will provide uniform information to applicants, streamline formality for applicants, and exercise patent examination based on a standard level of quality
- Common Statistical Parameter System for Examination- establish a system of common performance measures for examination at the Offices

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TRADEMARKS

- **Trilateral Identification Project**
- USPTO, OHIM, JPO are collaborating on a harmonized list of identifications and classifications of goods/services.
- 11,200 harmonized IDs – accepted in all three offices.
- Invitations to “dock-on” to the harmonized list:
 - Canada, Korea, Philippines, China, Mexico, Vietnam, Singapore, Brazil, New Zealand, Australia

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TRADEMARKS

• Trilateral ID Project vs. Madrid G&S Database

- Harmonized ID List
- Harmonizes classification
- Harmonizes translations
- Trilateral ID Web Interface
 - Will identify countries where ID would be accepted and includes translation
- Creates efficiencies for applicants and offices
 - Eliminates examination refusals for IDs
 - Electronic application form “pick lists”

- Comprehensive List
- Includes most lists from WIPO countries as well as IDs already accepted by WIPO in Madrid applications.
- Includes WIPO approved classifications
- Includes WIPO provided translations
- Madrid Filing Assistant provides searching interface
- Once ID is chosen, translation is included, reducing WIPO and applicant costs
- Will allow introduction of multiple filing languages into Madrid system since IDs represent the bulk of translation costs in Madrid apps.

Harmonized list populates the WIPO Madrid database.

The more harmonized the list, the more Madrid efficiencies created for applicants and offices.

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COPYRIGHT and RELATED RIGHTS

- Need to strengthen the international architecture for copyright.
- Need to enhance global copyright system by addressing broadcasting and audiovisual performances issues.
- Need to resolve “transfer of rights” issue
- Need to update Rome Convention

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COPYRIGHT and RELATED RIGHTS

- Need to improve copyright exceptions and limitations, particularly those for the blind and visually-impaired, and print-disabled.
- U.S. is committed to both better exceptions *in* copyright law and better enforcement *of* copyright law.

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ENFORCEMENT and CAPACITY-BUILDING

- Need to adapt out-dated and increasingly out-maneuvered territorial enforcement regimes to the realities of global piracy and counterfeiting.
- Whether trade in counterfeit hard goods or Internet and digital-based, IP theft is both big business and an ever expanding criminal and public health and safety concern.
- IP theft is also an economic harm to all.

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ENFORCEMENT and CAPACITY-BUILDING

- US Government approaches:
 - Free Trade Agreements
 - Anti-Counterfeiting Trade Agreement (ACTA)
 - Increased training and capacity-building for all involved in enforcement
 - Technical assistance on public awareness and out-reach activities

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“Innovation and creativity are drivers of economic development, producing jobs and a better standard of living.”

Barack Obama

President of the United States of America