

***The Backlog and Other Issues:
Measures for
Cost Reduction and Efficiency***

**FICPI/AIPLA
Colloquium on the
Backlog Crisis**

June 17-18, 2010

REDUCING BACKLOG BY SAVING TIME AND RESOURCES:

Three Initiatives from the Industry Trilateral

■ **INDUSTRY TRILATERAL:**

- Industry-Based representatives from Trilateral Office regions
 - Business Europe, Japan Intellectual Property Association, IPO and AIPLA
- Multiple initiatives with a focus on best practices and efficient/effective acquisition of quality IP rights
- Semi-annual meetings on policy and initiatives
- Working Meetings with Trilateral Offices

■ **THREE INITIATIVES:**

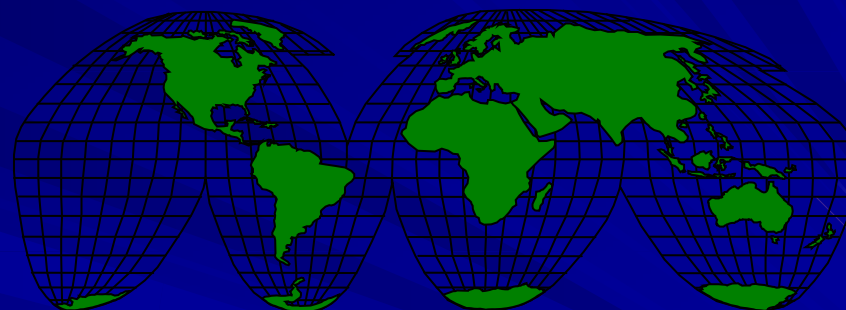
- Common Application Format (CAF)
- Common Search Document (CSD)
- Common Reference Portal



1. SCOPE AND IMPACT OF DIFFERING APPLICATION FORMATS

■ SCOPE of Format Differences

- Application Filing Formats
 - Physical Requirements for Documents (size, fonts, drawings, etc.)
 - Paragraph/Line numbering
- Application Content
 - Order and Titles of Sections
 - Mandated Sections
 - Handling of Formulae and Tables
 - Claim Style and Content

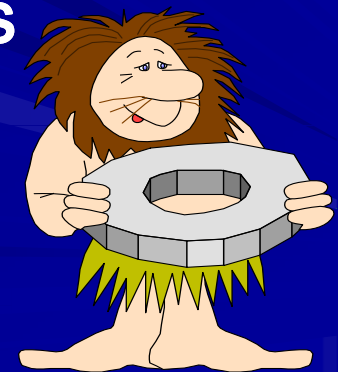


■ IMPACT of Format Differences

- Administrative and Financial Impact on Users World Wide
- Operational and Financial Impact on Offices
- Impediment to Harmonized Electronic filing/processing system
- Impediment to Machine Translation
- **Risk of Substantive Limitation of Rights – especially in the U.S.**

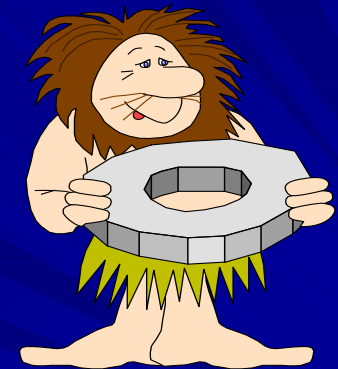
TRILATERAL ADOPTION OF A COMMON APPLICATION FORMAT (CAF):

- Abstract With Standard Size
- Specific Section Titles and Order
- Numbering of Paragraphs
- Use of Scientific (SI) Units of Measurements
- Uniform Drawing Standards
- Uniform Standards for Formulae and Tables
- Optional Parts Lists



TRILATERAL ADOPTION OF A COMMON APPLICATION FORMAT (CAF):

- Approved by Trilateral Offices - November 2008
- Adopted by JPO – part of standard electronic filing software with XML tagging - January 2009
- Voluntary in EPO and USPTO
 - Limited Promotional Activity
 - No tools provided for users
 - No incentives to date
- Significant Additional Benefits if Deferred or Excluded Substantive Issues Are Successfully Addressed



EXCLUSION and DEFERRAL of SIGNIFICANT SUBSTANTIVE ITEMS from the CAF:

■ **Requirement for National Legends**

- *Offices will Accept an Application with National Legends of another Office*
- *EP/JP May require deletion later - adding delay and cost*

■ **Requirement for Industrial Applicability**

- *Optional with Offices*
- *JPO May require addition later – adding delay and cost*

■ **Requirement for Citation of Prior Art In Disclosure**

- *JPO/EPO Still requires Addition to Disclosure – adding delay and cost*

■ **Addition of Reference Numbers in Claims**

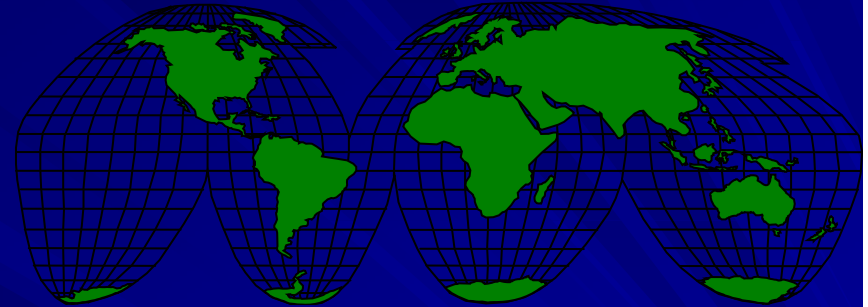
- *Optional for Offices*
- *Deletion when filing in USPTO - loss of benefit with added cost*

2. SCOPE AND IMPACT OF DIFFERING CITATION FORMATS

■ *SCOPE of Format Differences*

– Reference Citation Formats

- *PCT Search Reports are Uniform*
- *National Search Reports Differ*
- *National Applicants Citation Formats Differ*
 - USPTO IDS*
 - JPO citation in Specification*
 - EPO amendment of Specification*

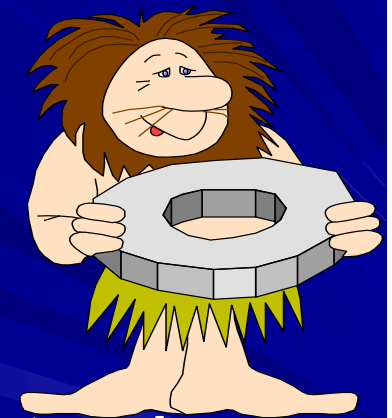


■ *IMPACT of Format Differences*

- Administrative and Financial Impact on Users World Wide*
- Inefficiencies Among Offices*
- Impediment to Harmonized Electronic processing, storage and access*
- RISK of legal liability – especially inequitable conduct in the U.S.*

INDUSTRY TRILATERAL PROPOSAL: Common Citation Document (CCD)

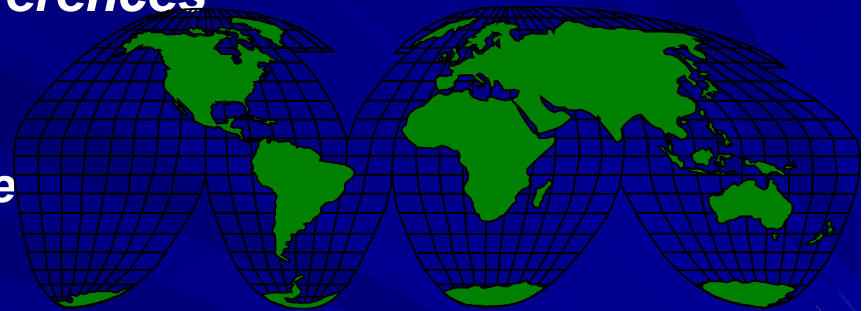
- Uniform Document / Protocol for Citation by All
 - Offices
 - Users
 - Third Parties
- Uniform Understanding of Content
- Uniform Storage and Processing of Data
- STATUS - Ongoing Discussions with Trilateral Offices
 - Possible Pilot Program



3. SCOPE AND IMPACT OF SEPARATE SEARCH AND STORAGE FACILITIES

■ *SCOPE of Facility and Storage Differences*

- *Different Data Bases*
- *Different Search Protocols*
- *Lack of Application Family Linkage*

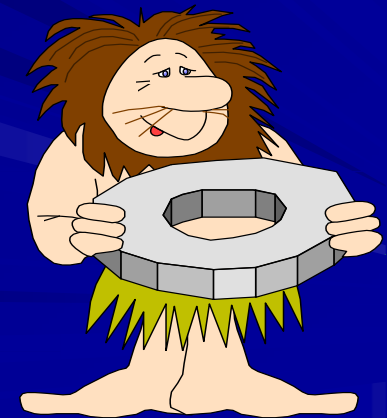


■ *IMPACT of Facility Differences*

- *Administrative and Financial Impact on Users World Wide*
 - *Especially Cost of IDS Compliance in the US*
- *Inefficiency in Offices Due to Added Filing Burdens*
- *Unavailability of Full Scope of Relevant Art for Examiner*
- *Impediment to Benefits of Work Sharing*
- ***RISK of legal liability – especially inequitable conduct in the U.S.***

INDUSTRY TRILATERAL PROPOSAL: Common Reference Portal

- **Common Data Base for Storage of Reference Data for Application Families**
 - Use CCD form as basis for filing information
 - Storage is cumulative for application family – horizontally (similar research project) and vertically (multi-Office and single Office family)
- **Common Web-based portal for access by all to relevant references**
 - Offices
 - Applicants
 - Third Parties
- **Uniform Storage and Processing of Data**
- **STATUS - Ongoing Discussions with Trilateral Offices**
 - Possible Pilot Program



4. *COMPACT PROSECUTION BY OFFICES*

■ *SCOPE of Examination INEFFICIENCIES – Users and Offices*

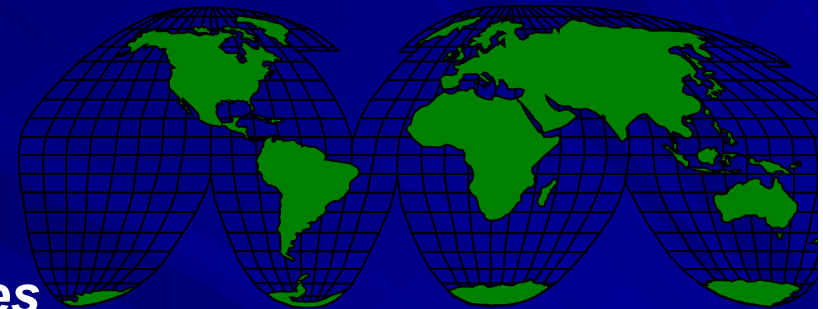
- *Restriction Practices*
- *Claiming Practices*
- *Formalities Practices*
- *Piecemeal prosecution*

■ *IMPACT of Examination Inefficiencies*

- *Administrative and Financial Impact on Users World Wide*
- *Inefficiency in Offices Due to Added/Duplicated Work*
- *Impediment to Benefits of Work Sharing*

■ *SOLUTIONS*

- *Early invitations to Applicants to correct*
- *Initiatives by Offices to address all Examination issues early and at one time*



THANK YOU