

The Trilateral Examiner Exchange

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Introduction - History

The Trilateral Offices process the greater part (more than 57%) of all patent applications filed worldwide, including PCT applications.

In the early 1980s, faced with a dramatic rise in the number of filings, the Trilateral Offices devised specific measures tailored to their needs. Each office engaged in projects to implement new technologies to economically store, efficiently process, and rapidly distribute very large amounts of data.

Since they shared the same problems and goals, they started to propose a co-operative approach to solving common challenges. The result was the creation of a unique and highly effective international cooperation framework: the Trilateral Co-operation, which started in Washington with the First Trilateral Conference in 1983.

Initial progress was made by exchanging know-how and establishing standards for exchanging data files. The Trilateral Offices then worked together to produce new databases and new systems for exploiting them.

The joint creation of new information systems and the collection of data in electronic format by the Trilateral partners gave way to a new generation of information products and services. These were initially conceived for internal use by the Trilateral Offices, but it soon became evident that availability could be extended to public

libraries and the general public. Following years of discussions, the following policy was adopted: the dissemination of patent information products at marginal cost.

The next challenges faced then were the paperless administration of the patent procedure, the exchange of documents and the electronic filing of applications, and the common efforts to develop possible measures for reducing the workload.

At present, the co-operation encompasses several projects, like :

- * Electronic tools, data standardisation and networks
 - * Use of work results
 - * Documentation, harmonization of classification, machine translation systems
 - * Information policy
 - * Legal issues
 - * Biotechnology
- and other projects.

The examiner exchange

The examiner exchange constitutes an important part of the project "Use of work results and exchange of patent examiners".

The first exchange was the result of a bilateral agreement

reached at the Trilateral Conference in November 1999 between the JPO and the EPO. The focus was mainly on search and the purposes was to compare search methods and tools, to promote the use of each other's tools and to explore the possibility of a jointly development of such tools. A further step was the investigation on and promotion of harmonization of the classification where possible.

Since then, more than 250 examiners participated in the fruitful exchanges which have taken place between the JPO and the EPO in many technical fields, and the objectives have been further widened to include comparison on examination practice and procedure, projects on rapidly evolving or problematic (from the patent practice point of view) technological fields, like combinatorial chemistry, business methods, hybrid vehicles.

Moving from bi- to trilateral exchanges

So far the USPTO preferred to play a passive role and to be an observer rather than an actor in the exchange project. A historical step has been taken in November 2003, when the Trilateral Conference the USPTO agreed to participate, together with the EPO and JPO Trilateral partners in a Trilateral Examiner Exchange. The latter is hosted in turn by one of the Trilateral Offices. Four technical fields are agreed on, and teams including each a JPO, USPTO, and EPO colleague work together, both discussing more fundamental issues and practical, everyday practice on the basis of real cases and comparison of law, procedure and tools at the three offices.

A number of factors concurred in inducing the change of policy of the USPTO. Internal changes at the management level, the increasing workload which affects the three trilateral partners, and probably also the awareness of the results of the bilateral examiner

exchange, which were made available at the conferences, were, in my opinion, probably eventually convincing.

While not abandoning the Bilateral examiner exchange with the JPO, we are looking forward to the seventh Trilateral exchange that will take place in April at the JPO, i.e. we completed two cycles (USPTO-JPO-EPO) and will start the third one. Twenty-four technical fields from all the main technology areas, ranging from cars to medical devices, from polymers to biotechnological inventions, from cosmetics to business methods have at least preliminarily been explored, and on four more discussions will start in Tokyo during the spring.

This alone can be considered, in my personal opinion, a good success and suggests that the initial perplexities are being slowly overcome. Especially bearing in mind the high costs of such an exchange in terms of examiner time and organization. But fortunately so far the potential advantages seem to, at least partially, justify the investments of the Trilateral offices.

The exchange : a resource and enrichment for the offices ?

A question that often is posed to the organizers is : which benefits can be drawn from such an exchange ? The answer cannot be a simple one. In my opinion, the most important gain is not directly quantifiable, but has to be articulated into several aspects, some of which rather subtle.

The most evident advantage is of course the acquiring of the **knowledge of each other's search tools**. How the colleagues in the other offices search, which databases they use, what of these resources can be possibly shared and used are data that can be of immediate help in the examiner's everyday life. Some tools can be even developed together.

The comparison of **classification** systems and logic, and the investigation of possible harmonization in fields

where the classification is being reorganized is of utmost importance for a future gain of efficiency.

Getting acquainted with **each other's law and procedure** means becoming aware of the reasons and background for some of the citations in the search report and the actions during the examination phase by the other office. An **improved understanding and trust** will arise, as well as an easier distinction between what can and what cannot be used of the results and findings of the colleague.

Another beneficial result of the Trilateral exchanges is the design of **follow-up microprojects** for individual technical fields and the **dissemination of the information** among the other colleagues in the Directorates of their own offices.

The **recognition of similar difficulties and comparison of practices** is helpful in the sense that it could give indications for a common policy of the three offices aiming to obtaining a better quality in the incoming applications.

Last but not least, getting into personal contact with the colleagues of the other office working in the same area helps abating barriers, associating a face to a name we might encounter as a signature of a search or examination report, building up a relationship which goes beyond the strictly technical aspects and offering the possibility to have at least one contact person in the other offices whom to ask, also in the future, if a question should arise in everyday work. So the **dialogue and communication improvement** has already proven itself valuable also after the exchanges.

The exchange also gave impulse and useful input for several other projects and tools, like the file inspection and machine translation tools, already partially implemented, and the future possibilities of sharing of non patent literature, creation of compatible sequence databases for biotechnological inventions etc.

Meanwhile all the offices can offer adequate e-learning modules on each other's structure law and practice.

Conclusion

In summary, in my opinion the trilateral exchanges are overall a potentially very beneficial project, both to the colleagues directly involved and for the trilateral offices, especially facing the challenges of the future in intellectual property, the development of technology and the fast growth of the other major Patent Offices.

The present article only expresses the personal opinion of the author.

Sources and references

- The Website of the Trilateral Co-operation
<http://www.trilateral.net/>
 The Trilateral Statistical Report 2005
http://www.trilateral.net/tsr/tsr_2005/index.php
 European Patent Office
<http://www.epo.org>
 e-learning at the EPO: the European Patent Academy
http://academy.epo.org/schedule/e_learning/index.en.php
 Internal reports on the exchanges

profile

Anna Maria Villa Riva

Born in 1960, of Italian nationality, married, three children, received a degree in Medicinal Chemistry and Pharmaceutical Technology and a Ph.D. in Medicinal Chemistry from the University of Milan, School of Pharmacy.

She briefly worked in industry (Zambon Group, Milan); after that she has been responsible for the Laboratory for Molecular Modelling and Drug Design at the Milan University School of Pharmacy and took part in scientific exchange projects with several European universities. She joined the EPO in Munich 1997 as a patent examiner in the area of pharmacy (second medical use and galenics).

In 2001 she visited the JPO (Medical Science Division) as an exchange examiner, since 2002 she has been a member of the DG1 Trilateral taskforce, the group that coordinates the bi- and trilateral examiner exchanges.

