



RESOLVED, that, to facilitate greater work-sharing among the Trilateral Offices, the Industry Trilateral supports (a) the identification, adoption, deployment, and use (including the training of examiners in such use) of common databases by each of the Trilateral Offices and (b) the mutual exchange of strategies developed for searching such common databases during the search of counterpart applications filed in the Trilateral Offices.

Background:

Each of the Trilateral Offices face immense workload pressures, as both the number and complexity of patent applications continue to increase. The duplication of work that currently occurs when applicants file applications claiming identical inventions in multiple offices exacerbates the workload problems. This is caused, in part, by unnecessary duplication of search activity in the Offices. Searching identical applications multiple times in succession in each of the Offices is inefficient and wastes valuable examiner resources.

At least as early as 2002, Trilateral project WM1 contemplated an objective to “reduce duplications of efforts by mutual exploitation of each other’s search results to a maximum extent practicable.” The Industry Trilateral proposes that the Trilateral Offices extend this objective by adopting a One Search concept, meaning that a single invention upon which an applicant files patent applications in two or more of the Offices would be the subject of a single search by only the Office of First Filing. The One Search, performed by the Trilateral Office in which the first application was filed, would be a complete search in the sense that it would identify all references that could be considered as prior art in any of the Offices. While each of the other Offices would remain free to decide whether and when additional searches are required, the need for multiple searches could be avoided or significantly reduced. Implementation of such a concept would require, among other things, commonality of search strategies, prior art databases, search tools, and examiner training, all of which have value independent of the One Search concept.

Common (Shared) Search Strategies:

Each of the Trilateral Offices has the capability to store the search queries, logic, and strategy employed by its examiners when conducting electronic database searches.

The Offices currently use this information for quality assurance purposes. Sharing these search strategies among the Trilateral Offices would build trust and confidence in each Office in the comprehensiveness of the searches performed, and would facilitate mutual exploitation of the resulting search reports.

In June 2005, the USPTO began to require U.S. examiners to record their search strategies in a detailed, consistent format (MPEP 719.05). If each Trilateral Office adopted a similar search recordation requirement and shared the recorded search strategies with one another, all of the Offices would benefit. Recordation and exchange of search strategies would enable and encourage further exploitation of the underlying searches, resulting in time and cost savings and, ultimately, in improved patent quality.

Common Database:

Sharing of search strategies among the Trilateral Offices is only a first, though necessary, step to reduce the wasteful duplication of search activity. Of primary importance is for each Office's examiners to search against common bases of data. The Patent Cooperation Treaty recognizes this, and requires that International Search Authorities "have at their ready disposal" at least a baseline set of search resources, referred to as the PCT Minimum Documentation. All of the Trilateral Offices qualify as Search Authorities and each has access to the requisite data. The Offices have cooperatively developed an even more comprehensive data set, however, and common use of this Trilateral Database would produce higher quality search results.

The most comprehensive instantiation of the Trilateral Database is the EPO's BACON Numerical System (BNS) search database. BNS contains both the text and images of U.S. published patent applications and patents, Japanese published applications and patents, the PAJ (English language abstracts of Japanese published applications), and the EPO database of European published patent applications and patents (including those of EPO member states), and published international patent applications. BNS also includes the First Page Data Base (FPDB) of front-page English language information for published European patent applications as well as for published patent applications and patents from other offices with which the EPO has data exchange agreements such as ROSPAT, KIPO, and SIPO. BNS further includes the English language version of the JPO FI and F-Term manuals that permits searching the deep indexed terms within Japanese language patents and published applications. The U.S. full text database is also loaded into BNS and can be searched using Boolean logic terms. Finally, BNS also includes a number of non-patent literature databases, including Derwent English language abstracts of patents and published applications from over 40 countries as well as family patent databases such as INPADOC.

The Trilateral Offices have cooperated to define and assemble the Trilateral Database. Now they should fully deploy this data in its most comprehensive form, the BNS, as the "gold standard" for thorough patent searching by all examiners in the Trilateral Offices.

Common Work Station with Common Graphical User Interface (GUI):

Along with deployment of the BNS version of the Trilateral Database, the EPO provides EPOQUE II workstations to each of its member states and connects the

workstations to the EPO through EPONET. These specially developed workstations are designed to exploit fully the wealth of data in BNS. The USPTO and JPO have deployed a limited number of these workstations in their offices, but they continue to use their own workstations and databases for mainstream examination. It would be useful to extend the EPOQUE II workstations and EPO system architecture throughout the JPO and USPTO with a common GUI, modified if desired to provide a Japanese language interface for the JPO. This would provide the full capability of BNS to the USPTO and JPO.

Common Training:

Finally, full exploitation of the best search tools requires uniform training on how to efficiently and effectively use the equipment to perform high quality prior art searches. The Trilateral Offices should develop and employ a consistent training program for all examiners on use of the common search tools and on best practice search techniques. This would enhance the ability of examiners to perform high quality searches of the Trilateral Database using EPOQUE type workstations, and would equip them to formulate appropriate search queries efficiently and effectively.

Conclusions:

Comprehensive prior art searches are integral to the process of examining and issuing high quality, enforceable patents. Producing such searches is resource intensive, and occupies a great deal of professional examiner time. Continuing to perform duplicate searches in multiple offices on identical applications significantly contributes to workload problems and wastes these valuable resources. The Trilateral Offices should seek to minimize such duplicated work by sharing search strategies, deploying the BNS version of the Trilateral Database along with customized EPOQUE workstations, and standardizing examiner training. If these measures are taken, an original search by any one of the Trilateral Offices should produce substantially identical prior art, and each of the Offices can feel comfortable relying upon another Offices' search results. Once that end is attained, work sharing will be facilitated and the One Search concept can be fully realized to the benefit of both applicants and the Offices.