

Patent Offices: Strategy for Work Sharing

“Need For A Pragmatic Outcome” E.R. Kazenske
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There shall be the *“establishment of a universal patent, respected throughout the world, issued in the light of, and invention over, all the prior art of the world ... by the pursuit of international harmonization of patent practice, and a universal network of mechanized information storage and retrieval systems.”* (Report of the President’s Commission on the Patent System, Washington, D.C., 1966)

Frameworks to address the issue(s):

- GATT Trade-Related Aspects of Intellectual Property Rights (TRIPs)
- Global Patent Law Harmonization
- Patent Cooperation Treaty
- Trilateral Patent Office Conferences
- Patent Law Treaty (PCT) Forums
- Group B+ Meetings
- Patent Prosecution Highway (PPH) Bilaterals
- IP5 Foundation Projects

A common theme throughout – “to eliminate unnecessary duplication of work among the offices, and enhance patent examination efficiency and quality”

A lot has been accomplished in many of these forums, but has there been a measurable impact in eliminating duplication of work and enhancing examination efficiency?

For a majority of the forums, the discussions revolve around harmonization policy issues –first-to-file, grace period, patentable subject matter, standard of obviousness/inventive step, publication/secret prior art, the Hilmer doctrine, patent classification systems, etc.

From at least a patent general provisions/administrative view, TRIPs and PCT have certainly been major breakthroughs in normalizing practice and delivering process efficiencies. However, have they delivered patent examination work sharing gains? Can PCT be the vehicle to deliver measurable work sharing efficiencies? PPH, while small in the number of applications in the process, seems to be making progress in elimination of duplication work and bringing more efficiency to the international process. What is being learned from PPH? Can the success points of PPH be transferred and integrated into PCT?

Faced by a globalization explosion in commerce fueled by IT innovations, a global web environment, and the criticality of intangible assets, patent offices are experiencing

capacity operational limits and thereby rapidly growing backlogs of unexamined applications. These types of pressures are reinvigorating patent offices to focus particularly on the redundancy of work and applications in multiple offices, and the importance of work sharing to address and alleviate those workload pressures. We certainly see this in the establishment of IP5 and the 10 Foundation Projects. We have been an advocate of this undertaking, and I'm very supportive of the issues outlined in the 10 Foundation projects.

Since the formation of IP5, another factor has entered the equation impacting a patent office's operational success – and that is reductions in fee revenue as a result of the economic downturn. While possibly being viewed as a dark cloud, it actually can be the force needed to deliver measurable efficiency gains. In downturns like we are facing today, successful businesses recognize these are the times to emerge a new business model.

While all the harmonization and policy issues being discussed are important to a global patent system, does that examiner working on a case really care about these policy issues in the daily examination of your application? Maybe to some extent, but not usually the first priorities they mention in trying to examine your application and to be efficient in doing their work.

They want to know:

Do I understand this technology?

If not, who might help me understand?

What is the closest existing technology and innovation to the invention before me?

Where might I find it and do I have the tools to get to and search that body of art?

Will I be able to understand/read that body of art?

Are there others who work in my art that I can talk to and get help?

Should I have all this before me, then I can address my country's/region's laws and legal requirements in addressing the patentability of the application.

While all the issues need to be addressed, we need to be pragmatic and realistic in today's economic environment and to focus on those few priorities that will begin to deliver meaningful outcomes in a very near term timeframe. We need to focus on three issues:

- 1) A global prior art database network common to all patent examiners – all examiners have ready access to the same and all data anywhere in the world. It is an IP5 Foundation project – hopefully its definition is not what may be implied by “bringing together the prior art from around the world”. This conjures the creation of a single, huge database to be managed and maintained – examiners just need the access to the data bases wherever they exist.

- 2) A translation tool to allow examiners to communicate with each other and to understand to a reasonable degree the prior art before them no matter their native language.
- 3) An examiner desktop network to allow examiners to converse with other examiners in the same technology anywhere in the world. This has the potential of bringing the resources of all the patent offices in the world, no matter their size, together in a new business model, thereby gaining efficiency, fostering collaboration, and sharing expertise.

These are not unique issues to just patent offices or the patent system today. All fields of endeavor, communities, businesses, and corporations are in need to garner information and communicate. These are the same issues facing individuals on the web today in their daily lives. Whether you are looking for information on the next generation of artificial intelligence for your research project, or looking for a unique fishing pole for that next vacation trip, you want to know what is out there, who might help me, what particular information is in the information before me, and don't want to be constrained that it is in a data bank in another country, in a language I really can't read. This is the issue the tech world is addressing daily in innovating the power of the web.

To enhance the three issues, a fourth would certainly address administrative cost efficiencies in globally prosecuting and examining patent applications. That is to have all patent applications filed and prosecuted in a digital format. This is the final leg on the stool for a common patent application format.

As ideas, innovations, and globalization grow even more important to the success of a Nation's economy, the efficiencies and synergies in the patent process will be critical to the development and success of all economies.