Cooperation between Patent Offices and Standards Developing Organizations

George T. Willingmyre, P.E.
GTW Associates

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Conclusions

- Access to accurate and timely prior art information is critical to the global systems of patent granting. The EPO has found standards and standards related information to be of substantive practical value in its decision making.
- The EPO MOUs have proved valuable to the EPO and have generated benefits in the SDO communities in improved accuracy and timeliness of information in standards and patent databases.

Conclusions

The Memoranda of Understandings between the EPO and three key SDOs (IEEE-SA, ITU and ETSI) are based on common criteria:

- i) exchange of information and documentation of mutual interest in the field of standards for the benefit of prior art search;
- ii) collaboration on documentation format definition and dissemination policies and align them with the EPO prior art search needs;
- iii) contribution to education and promotion activities in the field of standards;
- iv) self-funding.

Conclusions

- The USPTO contributed the point of view that SDO's should be incentivized to share information with USPTO to avoid having patents granted improperly and that aspects of the existing EPO-SDO Memoranda of Understandings might serve as a model in the process.

Conclusions

What constitutes *"confidential or non public information"* in the context of standards and standards setting has a strategic impact on the utility of such information in the patent examination process in the United States. Confidential or non public information does not qualify as "prior art". The extent to which European criteria and legal precedents about the use of standards and standards information in European patent deliberations may equally apply to the use of standards and standards information as "prior art" in deliberations at the US Patent and Trademark office is a key unknown factor to the utility of such standards information in the U.S.

Some Databases

- ANSI patent database http://publicaa.ansi.org/sites/apdl/Patent%20Letters/Forms/AllItems.aspx
- National Standards System Network http://www.nssn.org/
- *SGIP Catalog of Standards SSO Information Library* http://collaborate.nist.gov/twiki-sggrid/bin/view/SmartGrid/SGIPCoSSSOInformationLibrary
- The Incorporated by Reference (SIBR) Database http://standards.gov/sibr/query/index.cfm

China

- SIPO and SAC do … have information exchanges and communications with each other on the development of policy on the inclusion of patents in standards.

- *policy related to IP disposition in technical standards, the patent assessment and implementation, increase the proportion of China's IP in major international technical standards. (MIIT, MOST, AQSIQ)* http://english.sipo.gov.cn/laws/developing/201204/t20120410_667158.html

- Apart from the exchanges and communications on the above policy, cooperation in more practical levels, e.g. linking of the SIPO database to the databases and documentation of SAC and so on, has not occurred.

Japan

An expert sub-working group on standardization and intellectual property management within the Japan Ministry of Trade and Industry (METI) recently examined issues of the use of standards documentation by the Japan Patent Office (JPO) during JPO deliberations

The majority of members of the expert subgroup (while not unanimous) believed that the JPO should use standardization drafts during patent examinations.

Recommendation that participants in standardization activities should file a patent application before submitting a standard proposal

A Concern about Patent Office participation in SDOs.

There is no basis for agencies whose administrative role is to adjudicate on patentability based on publicly available prior art information, to be privy to non-public draft standards or discussion papers of SDOs before a standard is adopted and published. Patent offices should only have access to publicly available documents. In fact, patent offices are legally prohibited from using material that is unavailable to the public in examining patent applications. The mere appearance of patent examiners having access to unpublished standard documents undermines the confidence of patent applicants that the standard-based material used by examiners to reject pending claims is in fact publicly available and that the rejection is proper.

7/30/2012 Comment to GTW on DRAFT text from *Ron D. Katznelson, Ph.D. President , Bi-Level Technologies*

Prior Art US

"§ 102. Conditions for patentability; novelty

"(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

"(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

"(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention

Precedents

- The European patent office relies on information gained from standards documents and standards activities in their review of patent applications.
- Key to use of such material by the EPO patent examiners is that it meet the definition of prior art which includes the notion of public availability. A number of legal cases decided by the EPO Appeals Board guide such EPO use.

Precedents

In EPO appeals Case T 202/97 an opponent cited as relevant state of the art the provisional agenda together with the preliminary documents and the minutes of the meeting of the standard developing working group ISO/TC22/SC3/WG9 together with a list of participants. The Board came to the conclusion that a proposal sent to the members of an SDO working group in preparation of their meeting does usually not underlie an obligation to maintain confidentiality and is therefore to be considered as being available to the public.

Precedents

EPO Technical Board of Appeal decision T0050/02 states:

"A document is made available to the public [...] if all interested parties have an opportunity of gaining knowledge of the content of the document for their own purposes, even if they do not have a right to disseminate it to third parties, provided these third parties would be able to obtain knowledge of the content of the document by purchasing it for themselves."

Key Policy Guidance

- OMB Circular A-119 http://standards.gov/a119.cfm
- *National Technology Transfer and Advancement Act of 1995* http://gsi.nist.gov/global/index.cfm/L1-5/L2-44/A-348
- *Federal Engagement in Standards Activities to Address National Priorities Background and Proposed Policy Recommendations.* http://standards.gov/upload/Federal_Engagement_in_Standards_Activities_October12_final.pdf
- *Principles for Federal Engagement in Standards Activities to Address National Priorities* http://www.whitehouse.gov/sites/default/files/omb/memoranda/2012/m-12-08.pdf

Conclusions

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