

# Patents and Collaboration

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# Two Levels

- 1) Between national offices – inter-office
- 2) Between national offices and the community

# Patent

- Granted by a national (patent)office
- There is no such thing as an international patent

# Mutli-Jurisdiction Patent Filing

- Paris Convention 1883  
[http://www.wipo.int/treaties/en/ip/paris/trtdocs\\_wo020.html](http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html)
- Patent Cooperation Treaty 1970 (PCT)  
<http://www.wipo.int/pct/en/texts/articles/atoc.htm>
- Regional level filing – e.g. European Patent Office – European Patent Convention (1973)

# Paris Convention on Industrial Property 1883 – Art 4 - Priority

## A.

(1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed. ....

## B.

Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union

## C.

(1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks...

# PCT 1970 - Art 8 - Priority

- (1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.
- (2) (a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.  
(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

# PCT 1970 – Art 11 – Filing date

(1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt: (i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office, (ii) the international application is in the prescribed language, (iii) the international application contains at least the following elements: (a) an indication that it is intended as an international application,

- (b) the designation of at least one Contracting State,
- (c) the name of the applicant, as prescribed,
- (d) a part which on the face of it appears to be a description,
- (e) a part which on the face of it appears to be a claim or claims.

# PCT 1970 – Art 21 - Publication

(1) The International Bureau shall publish international applications. (2) (a) Subject to the exceptions provided for in subparagraph (b) and in Article 64(3), the international publication of the international application shall be effected promptly after the expiration of 18 months from the priority date of that application.

# PCT 1970 – Art 22

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in [Article 20](#) has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 30<sup>\*</sup> months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 30<sup>(i)</sup> months from the priority date.

# Summary

- Paris Convention – file in another jurisdiction within 12 months to maintain priority date of the first filing
- PCT – International application – file within 12 months to maintain priority date of the first filing (if any) – publication after 18 months (priority date) – International search report – optional International preliminary examination report - “national phase” after 30 months

# European Patent Convention (EPC 1973)

## Article 2

(1) Patents granted under this Convention shall be called European patents.

(2) The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless this Convention provides otherwise.

## Article 64

(1) A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor from the date on which the mention of its grant is published in the European Patent Bulletin, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.

(2) If the subject-matter of the European patent is a process, the protection conferred by the patent shall extend to the products directly obtained by such process.

(3) Any infringement of a European patent shall be dealt with by national law.

# Problems

- Huge backlog of patents in some countries
- Lot of duplication of effort across offices in the application, examination and grant processes
- Law not harmonised
- What can be done?

# Inter-Office Collaboration

- 1) Patent Prosecution Highway (PPH)
- 2) Vancouver Group – Mutual Exploitation

# Patent Prosecution Highway (PPH)

- Patent Prosecution Highway (PPH)
  - Typically bilateral agreements between patent offices
    - PPH arrangements exist between patent offices in Australia, Canada, Denmark, Europe, Finland, Germany, Japan, Korea, UK and the US
  - An applicant driven work sharing arrangement
  - Accelerated examination where requested by applicants
    - Where at least one claim has been found patentable by a first office, the application can be submitted to the second office to receive a fast-track examination of the corresponding claims
- PCT-PPH
  - Pilot project of the trilateral (EPO, USPTO and JPO)
  - After a favorable search/examination under PCT applicant can request expedited examination

# PPH

[http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi\\_e/t\\_torikumi\\_e/patent\\_highway\\_e.htm](http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.htm)

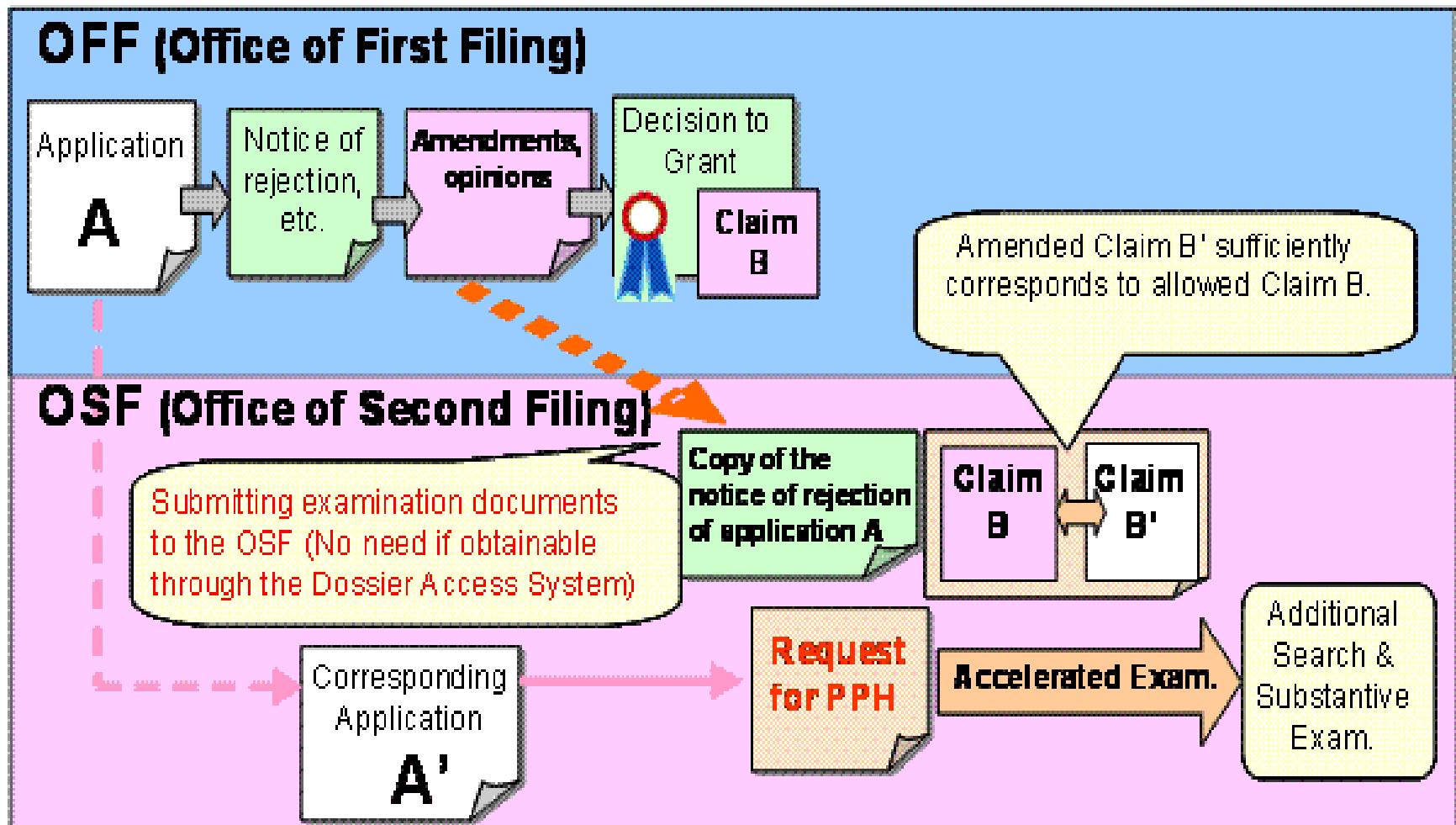
## **“Purpose and Outline of the Patent Prosecution Highway**

The purpose of the PPH is to facilitate an applicant's acquisition of a patent at an early stage worldwide and to enhance the utilization of search and examination results between the world's major IP Offices so as to reduce the burden of examination and to enhance the quality of examination worldwide.

The PPH enables an application whose claims have been determined to be patentable in the Office of First Filing (OFF) to undergo an accelerated examination in the Office of Second Filing (OSF) with a simple procedure upon a request from an applicant.”

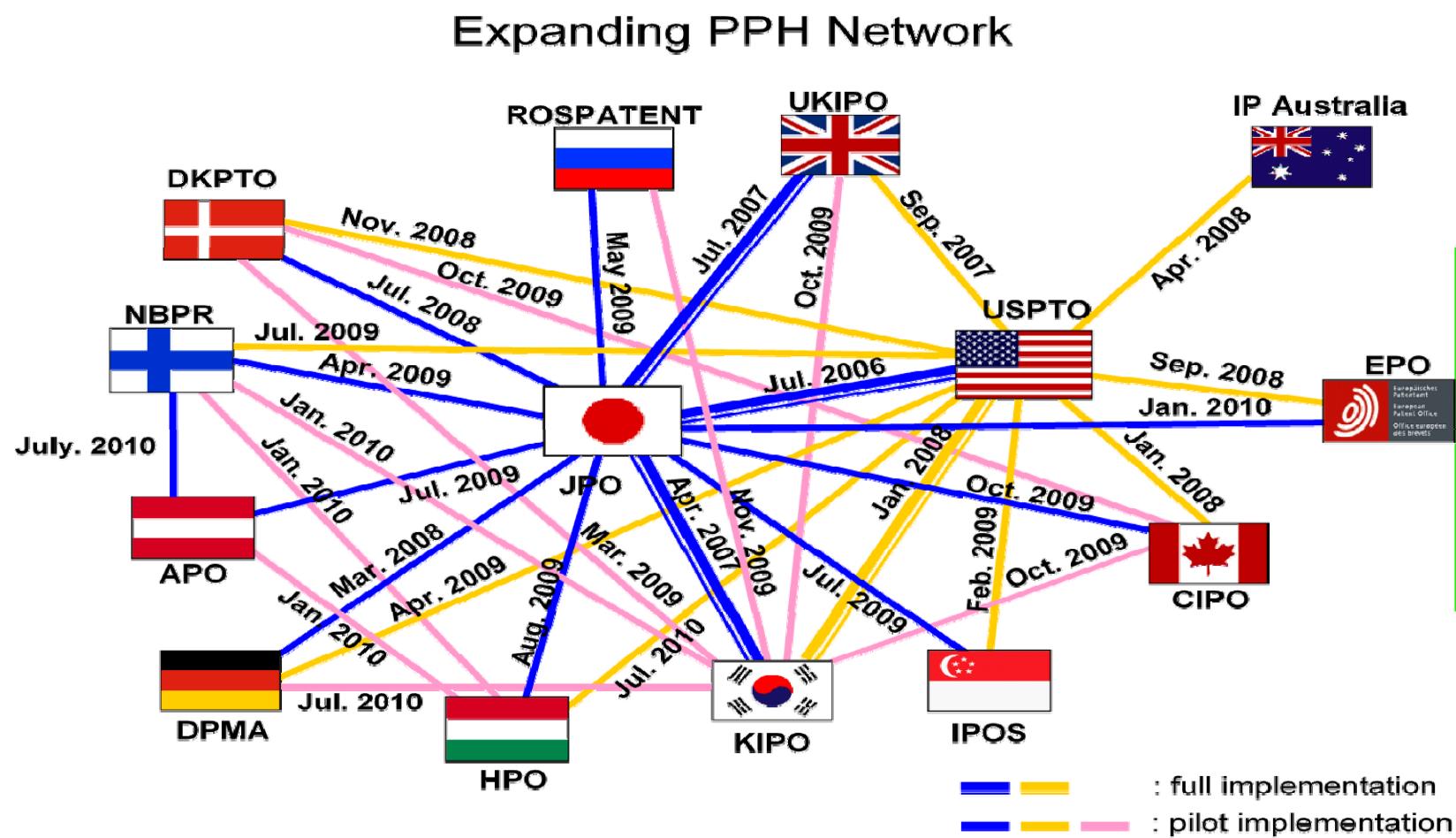
# PPH Portal – JPO

[http://www.jpo.go.jp/cgi/link.cgi?url=/torikumi\\_e/t\\_torikumi\\_e/patent\\_highway\\_e.htm](http://www.jpo.go.jp/cgi/link.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.htm)



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OSF														
	JPO	USPTO	KIPO(※1)	UK-IPO	DPMA	CIPO	IP-AU	DKPTO	EPO(※2)	IPOS	NBPR	ROSPATENT	APO	HPO
JPO	1920	371	16	220	0	-	1	1	0	0	8	0	0	0
USPTO	738	173	16	1	837	40	0	18	1	0	-	-	-	-
KIPO	86	397	0	-	0	-	0	-	-	-	0	-	-	-
UK-IPO	12	79	0	-	-	-	-	-	-	-	-	-	-	-
DPMA	45	15	-	-	-	-	-	-	-	-	-	-	-	-
CIPO	0	26	0	-	-	-	0	-	-	-	-	-	-	-
IP-AU	-	32	-	-	-	-	-	-	-	-	-	-	-	-
DKPTO	1	15	0	-	-	0	-	-	-	-	-	-	-	-
EPO	0	30	-	-	-	-	-	-	-	-	-	-	-	-
IPOS	0	1	-	-	-	-	-	-	-	-	-	-	-	-
NBPR	3	3	0	-	-	-	-	-	-	-	-	-	0	-
ROSPATENT	0	-	0	-	-	-	-	-	-	-	-	-	-	-
APO	0	-	-	-	-	-	-	-	-	-	-	-	0	-
HPO	0	-	-	-	-	-	-	-	-	-	-	-	0	-

As of the end of January 2010

※1 KIPO as OSF : As of the end of March 2010

※2 EPO as OSF : As of 1 March 2010

# Vancouver Group

## Vancouver Group (Canada, Australia and the UK)

- An office driven work sharing arrangement
- The aim is to eliminate duplication between participating offices,
- Achieved by sharing information and relying on examination reports from offices within the group
- Where possible the patent office of a Vancouver Group country will rely on a search or examination performed by another office
- An office can perform further searching and examination if it deems it necessary

# Vancouver Group Statement

[http://www.wipo.int/export/sites/www/meetings/en/2009/sym\\_ip\\_auth/pdf/philipp\\_noonan\\_a.pdf](http://www.wipo.int/export/sites/www/meetings/en/2009/sym_ip_auth/pdf/philipp_noonan_a.pdf)

## **“Mutual Exploitation Principles**

The following principles, discussed in Singapore on 29 July 2009, will apply to Vancouver Group-ME:

The core principle is that a Vancouver Group Office (VGO) will, where possible, rely on any patent granted by another VGO or on the search and examination performed by another VGO resulting in an issued search and examination report for an equivalent application. A VGO may perform further search and examination if it deems further work necessary.

This core principle will be applied in an “Office-driven” manner - i.e. Offices will rely on earlier work without the need for applicants to ask them to do so.

The core principle will also be applied transparently. Where earlier work by another Office is relied on, the later Office will note this on their file and in the report to the applicant. Where the later Office deems it necessary to do further work, it will note this on their file, together with an explanation of why the further work is thought necessary. To maintain confidence in VGO reports, feedback will be provided by the later Office to the earlier Office, where appropriate.”

# Vancouver Group Statement

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“The core principle will apply to all work done by a VGO, whether for purposes of determining patentability in its own jurisdiction or that of another jurisdiction for which such work is performed by the office and irrespective of where the application was first filed.

Where one VGO issues an office action indicating at least one claim is allowable or granted a patent in relation to an application, the applicant will be able to apply to the other VGOs for accelerated examination of a related application.

**6. The procedures and requirements for accelerated examination will be:**

as simple and efficient as possible; and

consistent with other arrangements already in place within Offices for accelerated examination, [such as the Patent Prosecution Highway].

**7. Examiners will have ready access to the work of another VGO. It is intended that an enabling platform will be provided using WIPO infrastructure. Offices will:**

work with WIPO to develop and implement this platform as quickly as possible; and

advocate ongoing enhancement and use of this enabling platform to other IP offices to facilitate greater work sharing.“

# Vancouver Group Statement

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**“8. Offices will support ongoing examiner interaction that enhances mutual understanding, seeks to minimise variability and promotes greater confidence in one another’s work. In particular:**

Offices agree that it would be useful for a periodic independent quality review of each other’s work by the VGOs;

Offices, and the outcomes they are seeking to achieve, would benefit from documenting and sharing of respective search strategies; and

Offices will share experiences and information on using EPOQUE.Net, and advocate similar exchanges with other EPOQUE.Net users.”

# Vancouver Group Statement

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## **“Proposed Approach – access to search and examination reports**

Integral to the success of Vancouver Group-ME is inter-office access to search and examination reports.

The Vancouver Group will work with WIPO on a pilot project where WIPO will host a digital library of these reports – therefore establishing a central document storage and access repository.

The following describes how the Vancouver Group-ME initiative would broadly operate:

Each Office would send their search and examination reports on national and national phase applications to WIPO.

When examining an application, an Office would obtain any available reports done by other Vancouver Group Offices on equivalent applications from WIPO. If a report was available, the examiner of the VG Office would examine the application in accordance with the relevant principles of the Vancouver Group-ME.

Once a new search and/or examination report has been issued by an Office, this report would be sent to WIPO.”

# Substantive and Procedural Reform

# Interview- D-G WIPO – Dr Gurry

FG: The most immediately relevant project from our point of view, all of them are relevant, but the most immediately relevant is the one on the hybrid classification.

Trying to achieve a hybrid between the US, Japan and Europe, that's very important for us because of course, as you know, we are custodians of the international patent classification and we would very much like to see the US move to an IPC based classification system. That, I think, is the intention in the longer run, it's a question now of commitment of resources to get there. And this I think is perhaps the biggest challenge for the IP5, is committing the resources necessary to take these projects through to implementation, particularly when the projects and the IP5's cooperation was just on the point of ratcheting up when the economic crisis occurred.

GQ: Nicolas Maury, the Director of the EPO for the IP5 and trilateral affairs said or has been quoted as saying that he thinks such a international classification, sort of a common classification would probably take 2000 man years, maybe 13 years to actually accomplish. Does that sound reasonable? I mean that seems a bit excessive to me.

FG: That's certainly a lot and it does seem a bit excessive indeed, but they have made their estimates for all of these projects, of what is involved, so presumably he is basing it on that. When you consider the F-term system maybe quite a lot of time is required, but I think with as all of these things one by one. So if you can get the US to move across to an IPC based system, even if it's a more complex system in IPC itself, like ECLA, because ECLA is IPC based, then that is an achievement. Then you see what sort of an accommodation you can have with F-terms.

**G Quinn, An Exclusive Interview with Francis Gurry, WIPO Director General ,**  
[\*\*http://www.ipwatchdog.com/2010/05/04/interview-francis-gurry-wipo/id=10393/\*\*](http://www.ipwatchdog.com/2010/05/04/interview-francis-gurry-wipo/id=10393/)

# Interview- D-G WIPO – Dr Gurry

GQ: So is the uniform classification system, is that sort of the “Holy Grail” for work sharing?

FG: No I think it is one of the tools. Look, for me, work sharing really, means voluntary arrangements, which are designed to achieve a rational division of labor in the international patent system given that in that international patent system what we've got is a number of tasks that are identical, that are performed by different offices so the extent to which you can say “Well look, we will leverage off the work that you have already done in this area.” To that extent I think it's a very rational thing for us to be doing, or for the whole international system to be doing. Now, another aspect of work sharing I think, is common tools and that's where I see the, common tools and common systems, and that's where I see the IPC coming in. It's a common tool, we should have, or hybrid classification/uniform classification system, we should have common tools. It's crazy that we have a globalized world and different classification systems; it just doesn't make any sense what so ever. It's not rational and it's not functional, it's dysfunctional.

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# Interview- D-G WIPO – Dr Gurry

GQ: Now one of the things in the US, whenever we talk about work sharing, that comes up, is question about whether or not that really is code for harmonization of laws, distinct from harmonization of process. I know this is an open-ended question, and maybe you can take it where you'd like.

FG: Sure, look it's a very good question and I am glad you raised it because I discussed with colleagues in the IP5 but more generally in Geneva. I do not think that there is as yet, consensus internationally about work sharing. And why not? Well I think there are 2 fears out there, which for me are based on misinformation, but they're out there, the 2 perceptions or fears. The first is that work sharing is a means by which the bigger offices can impose their results on the smaller offices. And the second is that work sharing is a means of restricting the TRIPPS flexibilities or achieving harmonization. I don't think either of those views/perceptions is correct. I don't think either of them corresponds to reality. I think work sharing is about rational application of principals that Adam Smith identified in the division of labor back several centuries ago.

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FG: So it's a perfectly rational way of going about dealing with the problem of demand management. And let me just pause on the problem of demand management. As you know, we have some 3.5; our estimate is 3.5 million unprocessed patent applications around the world at the moment. We have to tackle that. That is not something that we can ignore. That spells in the long run the death of the patent system if we cannot cure that, because the demand is only going to become stronger. There is 1.1 Trillion US dollars invested in research and development around the world each year. That is not going to diminish the demand for patent rights. That is going to, if anything increase that demand. So we know that we have you know a problem that is with us not just as a present problem but as a future problem and we have to devise the means for tackling that problem. Work sharing is a very sensible way of going about it and for me it incorporates a whole universe of different voluntary arrangements of leveraging off each other's work as well as common tools as I said common tools and common systems.

Does that mean Harmonization? In my view it doesn't; work sharing alone doesn't. It may be that the more you do work sharing, the more you think "Well wouldn't it be more sensible if we also operated on the basis of the same underlying functional concepts of novelty and prior art?" But that may be a logical response to work sharing, to involvement in work sharing, but work sharing alone does not involve harmonization. For me, another way of expressing it, two other ways of expressing it are that you can say that, if you like, that harmonization is really concerned with legal harmonization and work sharing is concerned with technical and practical cooperation. So the examiners are not going to arrive at a common definition, but they might arrive at a common solution to a particular practical invention question.

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# Interview- D-G WIPO – Dr Gurry

FG: That's the Patent Prosecution Highway. GQ: Yes.

FG: Look I think there are a number of different experiments out there. It's all very interesting actually. So one of them is the Patent Prosecution Highway, which is first action, when you get your first action from the first office then you go to accelerated processing in the second office. So that's happening. There was a decision taken last year by the tri-laterals to include the PCT within the PPH and I think that's a very positive thing, it's a very good development. I'd like to see those two systems come together.

GQ: OK, I mean that's sort of...

FG: So maybe you can come back to that but I'll just go on to say then there is for example a different arrangement amongst the Vancouver group, which is Canada, UK, Australia. And then they are actually going to do mutual recognition and we are providing, we are building a platform for that form of cooperation amongst them. Then there is a plan amongst Brazil and 7 other South American countries, to put together a platform where they could use, the idea is a WIKI model. You take the first office's work and then you add to it or improve it and the 3rd does and the 4th does and so on. That's their idea, but these are all different I think schemes for work sharing and they're all positive

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GQ: The one thing that surprised me when I was looking into the PPH, David Kappos recently talked about how despite the US Patent Office's efforts, it seems to be quite under utilized and I guess any time you have change or something new there's a resistance and particularly maybe in the patent space where you're dealing with attorneys who are conservative by nature and wanting to make sure they know the process before they jump into it. What do you see as ways to maybe move the PPH forward?

FG: Well I think the PPH has a certain limitation to it, you know, the numbers are small, several hundred, whereas the PCT is about 160,000 applications a year. And by definition you see, with the PPH, if it became generally used, then you couldn't get expedited treatment in the second country, could you? Because you can get expedited treatment when you're dealing with 300.

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# Interview- D-G WIPO – Dr Gurry

FG: Well, I would say that if you look at the PPH where is it most popular? And this is you know anecdotal rather than scientific.

GQ: That's fine.

FG: Yeah I would say it's popular in smaller countries, high tech, take a high tech country like Denmark. It's very important for them to be able to get in to the major markets. So the PPH is a very good vehicle for them. US Company exporting out isn't going to have so many other, everyone wants to get into the US market. A US company exporting out isn't going to have so many preferential markets. It might have 3 or 4. So that is one thing we are learning is greater market differentiation in patenting strategy and having a product that satisfies; that appeals to that particular nation. Second thing is I think probably IT is one of the technologies that benefits from, because of the fast technological cycle that's probably one of the technologies that is most popular for PPH.

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# Interview- D-G WIPO – Dr Gurry

GQ: Right, I know, no I know. The two things and then you probably have to get going, but if I don't mention these my readers will probably tar and feather me, one is the grace period and two is patentable subject matter in terms of software. It seems recently David Kappos has been talking about trying to get the rest of the world to adopt a grace period like the US has. And at one point he even called it I believe, "the Gold Standard."

FG: Yes. GQ: So I know that this has been an ongoing debate for as long as I've been in the profession.

FG It has and we have certain holdouts as you know for that and Europe has not yet come across to... GQ: Now you say "Yet" and you have a smile on your face so I guess the question where I really wanted to go is do you see on the horizon a potential to have some kind of a harmonization with respect to a grace period?

FG: Yes GQ: You do?

FG: I do, and I think it is, look I think it's an important element of the overall legal architecture of the international patent system.

GQ: OK and then just to be...

FG: And I think it should be standardized. Why? Because you know because you're really talking here, if you'd like just to be simplistic about the matter, the Universities are the factories of the knowledge economy. And you should have a vehicle for accommodating, on the one hand, the university scientists' desire to publish and on the other hand the need to preserve confidentiality in order to preserve your patent rights.

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FG: Yeah, I couldn't agree with you more. Why can't we do that? Well, because the economic and technological circumstances are demanding it. We can't for several reasons, I think, at the moment unfortunately. First there is this underlying political suspicion that harmonization is going to be another form of TRIPPS agreement if you'd like, on the part of the developing countries. I think there what we have to reach is a situation in which we recognize the need for a certain amount of functional standardization simply to make globalization work. And while at the same time respecting, as defined in the TRIPPS agreement, the so-called flexibilities for national policy action. But we wouldn't be able to, I wouldn't be able to use my mobile telephone here unless we had a certain amount of functional standardization going on. Everyone, there is a global use of technologies now we absolutely need that. Never the less, that legal problem is out there and we have to work on persuading, I think, the developing countries that at some stage we have to be able to work on the functional standardization of the international Intellectual Property System to make it fit for purpose for the global economy. And it's not an easy, because there's a lot of misinformation, there are a lot of misperceptions out there. So that's, I think number one. Number two we have the problem of specialists. You know specialists and experts become very attached to their subject matter and to the way in which they do things. So at some stage, we now need political direction from the top about these matters. We're going to need high legal, political direction saying, "You experts, solve this. We want an answer in 12 months. And we don't care whether the answer is that you use secret prior art for novelty only or for novelty and inventive step, but we want one answer and not two." And that is the next challenge.

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# Engage with Community

1) Patent Informatics

2) Peer to Patent

# Patent Informatics

- CAMBIA's Patent Lens <http://www.patentlens.org>
  - An open-access, free full-text patent search
  - Patent landscapes
- Google Patents <http://www.google.com/patents>
  - An agreement between Google and the USPTO to make patent and trademark information available to the public at no charge
- Sourcing technological information from patent applicants
  - What information should be provided by the applicant?

# Peer to Patent

- Crowd sourcing prior art
  - A means of improving the quality of issued patents by facilitating community participation in the patent examination process
- Review participating patent applications in terms of the novelty and inventiveness
- Submit relevant prior art references
- Comment and vote on the relevance of prior art references submitted
- The top 10 prior art references submitted by the community are forwarded to the patent office
- Prior art submitted is considered by the patent examiner in examination

# Benefits of Peer to Patent

- To the public
  - Improve the quality of issued patents
  - The public only benefits when monopoly rights are granted for inventions that truly represent a novel and inventive advance over the existing state of the art
  - Clearer patent landscapes and reduced uncertainty surrounding freedom to operate
- To patent applicants
  - Patent applications undergo more rigorous examination
  - Likely to be more robust as a consequence
  - More robust patents are less likely to be litigated or disputed in licensing negotiations
  - The identification and elimination of weak claims early in the examination process saves the applicant the expensive process of pursuing or enforcing non-meritorious claims
  - May include an option to allow applicants expedited processing for certain cases in order to lower prosecution costs and reduce the prosecution time

# Mass/Networked Collaboration

- “Today, thanks largely to the Internet, the kind of creativity and innovation that used to take place primarily within corporate walls, increasingly takes place over large amorphous networks of peers. Millions of people already join forces in self-organized collaborations such as Linux and Wikipedia that produce dynamic new goods and services that rival those of the world's largest and best-financed enterprises.”
- Tapscott and Williams, *Innovation in the Age of Mass Collaboration*  
[http://www.businessweek.com/innovate/content/feb2007/id20070201\\_774736.htm](http://www.businessweek.com/innovate/content/feb2007/id20070201_774736.htm)

# Origins of Peer to Patent

- Project of New York Law School
- Agreement with USPTO
- Professor Beth Novak/IBM
  - See *Wiki Government* (2009)
- Professor Mark Webbink
- Software platform



# Support for the Concept

- “[f]or the first time in history [peer review of patent applications by the public] allows the patent office examiners to open up their cubicles and get access to a whole world of technical experts.”

David J Kappos, Former Vice President and Assistant General Counsel at IBM and now Under Secretary of Commerce for Intellectual Property and Director of the USPTO speaking in The Washington Post

- Peer to Patent creator Professor Beth Noveck was named Deputy Chief Technology Officer for Open Government for the Obama administration
- Involved patent applications from high profile backers in the US - IBM, HP, General Electric, CA, Intel, Microsoft, Cisco, Yahoo, Citicorp, Visa
- Recent Japanese Pilot a success
- Peer to Patent prior art has been relied upon by examiners in more than 25 percent of the applications receiving office actions in US

# US Peer to Patent Pilots

- [www.peertopatent.org](http://www.peertopatent.org)
- US Patent Classification focus:
  - IT; Business Methods; E-commerce
- Launched June 2007 – ran for two years
- Consent of applicants was sought prior to inclusion
- Each application open for review for 90 days

# US Peer to Patent Pilots

- 2nd Anniversary Report highlights:
  - 2,600 registered peer reviewers
  - 187 patent applications as of 30 May 2009
  - Prior art used to reject one or more claims in 18 patent applications (10% of cases)

# US Peer to Patent Pilots

- 2nd Anniversary Report highlights:
  - 75% of reviewers think that a third-party submission of prior art program like Peer to Patent should be incorporated as regular USPTO practice
  - 69% of examiners think that a program like Peer to Patent would be useful if incorporated into regular office practice.
  - 67% of examiners believe Peer to Patent would be helpful in doing their job
- 6-month pilot in Japan – comparable results



- Review patent applications
- Nominate relevant prior art
- Assist the patent examination process

Professor Brian Fitzgerald and Ben McEniry

Peer-to-Patent Australia is an initiative of the Queensland University of Technology  
Faculty of Law and IP Australia. [www.peertopatent.org.au](http://www.peertopatent.org.au)



# Peer-to-Patent Australia

- [www.peertopatent.org.au](http://www.peertopatent.org.au)
- A collaboration between QUT and IP Australia
- 6 month pilot – December 09 – May 10
- Closely modelled on the United States Peer to Patent pilots
  - Used the same software platform as used for US pilots
  - Consent of applicants was sought prior to inclusion
  - Each application open for review for 90 days
- Technology areas:
  - business methods; computer software and related applications
- Applications drawn from those that:
  - had been laid open to public inspection; and
  - for which an examination request has been made by the applicant



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## WELCOME TO PEER-TO-PATENT AUSTRALIA

Peer-to-Patent Australia is part of the international expansion of Peer-to-Patent into jurisdictions outside the United States. It operates with [the support of IP Australia](#) and is the result of the collaborative efforts of the Queensland University of Technology Faculty of Law and New York Law School.

Become part of this historic program. Help us locate the information relevant to assessing the claims of pending patent applications. Become a community reviewer and improve the quality of issued patents in Australia.

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	9	<a href="#">Method and device for content information sharing</a>

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These contributors submitted prior art or annotations that will be forwarded to IP Australia to be used in deciding whether a patent should be granted.



**Australian Government**

**IP Australia**

## INAUGURAL PILOT NOW COMPLETE

The peer review phase of the inaugural Peer-to-Patent Australia pilot project is now complete. Thank you to all who contributed to the project by joining our community, submitting prior art references, posting comments, and spreading word of the pilot. The project has now entered an evaluation phase, the results of which will be published in our first anniversary report.



## PEER-TO-PATENT VIDEOS

An overview of Peer-to-Patent Australia  
Beth Noveck, Prof. New York Law School as adapted by  
Jimmy Ti and Ben McEniry. [More Videos](#)



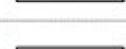
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Brisbane Australia



**Active Patent Applications**
**Archived Applications**

Please click on the name of an application to view that application.

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Patent Application Title	Community	Discussions	Prior Art	Annotations	Timeline
Method and apparatus for run-time incorporation of domain data configuration changes	4 ●	3 	3 	0	12/09 - 03/10
A method of processing a user data card, an interface module and a gaming system	7 ●	7 	7 	0	12/09 - 03/10
A software management system and method	9 ●	3 	6 	0	12/09 - 03/10
Methods and apparatus for interactive specification of context-sensitive service level agreements; for provisioning of resources required during service delivery events regulated by service level agreements; and for monitoring compliance with service level agreements during service delivery events	5 ●	5 	0 	0	12/09 - 03/10
Cold row encapsulation for server farm cooling system	4 ●	4 	2 	1	12/09 - 03/10
A gaming system and method of gaming	5 ●	0 	2 	0	12/09 - 03/10
Shared appreciation progressive mortgage	4 ●	2 	3 	1	12/09 - 03/10
System and method of computer aided dispatching using a coordinating agent	4 ●	1 	1 	0	12/09 - 03/10
Method and system for integrating browsing histories with media playlists	6 ●	3 	1 	0	12/09 - 03/10
A gaming system and a method of gaming	3 ●	0 	2 	0	12/09 - 03/10
Binary representation of number based on processor word size	8 ●	16 	4 	1	12/09 - 03/10
Rail car tracking system	10 ●	7 	8 	0	12/09 - 03/10

## Binary representation of number based on processor word size

Track the progress of public participation in the review of this pending patent application, and view application details. The menu on the right will help you navigate this patent application. Subscribe to the community enables you to receive updates on this application via email so that you can easily follow recent activity.

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0 days left


**Activity**

**Application**

Abstract

Description

Claims (12)

Illustrations (4)


**Discussion (16)**

**Prior Art (4)**

**Research (0)**
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### LATEST PRIOR ART

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Date	Title	Reviewer
02/24/10	Knut, Seminumerical Algorithms	Richard O'Keefe
02/24/10	DEC-10 Prolog library	Richard O'Keefe
12/10/09	GNU GMP 2.0X	Paul Leopardi
12/10/09	Densely packed decimal encoding	Graham Menhennitt

### DISCUSSION

[View All Discussion](#)

**Paul Leopardi** (7 months ago)

I believe that this whole patent was preempted by GNU GMP 2.0 in 1996. I will contact Paul Zimmermann of Inria to ask him to comment.

**Paul Leopardi** (5 months ago)

Can someone please compare both instances of prior art with the claims and description of the patent application? I believe that the patent application is identical (or at least sufficiently close) to what is done by GNU GMP 2.0.2, and differs from Densely Packed Decimal Encoding. Specifically, the description in the patent application talks about doing the usual binary computer arithmetic directly on the stored words, possibly with an extra carry (as per GNU GMP 2.0.2). I don't think that Densely Packed Decimal Encoding allows this. It would either need new hardware (or microcode) for arithmetic, or would need software to convert the packed numbers to a format to allow the usual binary computer arithmetic to be performed. I don't think that this matches the claims, description or inferred intent of the HP patent application.

**Mik Clarke** (7 months ago)

With regard to the DPD prior art (which is summarized on Wikipedia: [http://en.wikipedia.org/wiki/Densely\\_packed\\_decimal](http://en.wikipedia.org/wiki/Densely_packed_decimal)) you could argue that the filing is about selecting an appropriate length of DPD based upon the wordsize of the target CPU - useful if you're on a

### COMMUNITY (8)

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 3	Computer Professional/Technologist
 2	Academic Technologist/Engineer
 1	Legal Academic/Professor
 1	Science Academic/Professor
 1	Writer/Editor

### ACTIVITY BY CLAIM

[View All Claims](#)

Claim 1	4 Prior Art
Claim 2	4 Prior Art
Claim 5	4 Prior Art
Claim 6	4 Prior Art
Claim 7	4 Prior Art

### WHAT IS THIS APPLICATION ABOUT

computer architecture binary-decimal conversion decimal-binary conversion number encoding benson gottschalk

Add a Tag

# Peer-to-Patent Australia Pilot

- 31 participating patent applications
- Participating patent applicants:
  - IBM; GE; HP; CSIRO; Aristocrat Leisure; Residex; Yahoo and Western Union
- 131 registered peer reviewers
- 106 prior art references submitted
- We await examination results – interim feedback show the project has had impact.

# Moving Forward

- Further Peer to Patent projects to run in Japan, Korea
- USPTO and NYLS are working towards a third pilot
- Possibility that Peer to Patent to be run by WIPO as part of international application process under PCT
  - To permit third party observations in the international phase
  - Observations to be made on an informal basis, without specific new rules using a Web-based system
  - Observations to be used by designated offices and international authorities as considered appropriate

# Moving Forward

- Need for more dialogue between Peer to Patent projects running in different jurisdictions
- A Peer to Patent project at the WIPO/PCT stage would benefit from harmonisation of procedural and substantive patent law
- Peer to Patent run in-house by a patent office vs run by independent organisation

# Moving Forward

- How do we get people to connect with the project?
  - As patent applicants
  - As peer reviewer
- Need to encourage potential reviewers

# Application to Technology Transfer Sector

“Peer-to-Patent may be of particular value to university technology transfer officers as a means of signaling potential obstacles to successful patent prosecution. Unlike large corporate patent offices that have substantial operating budgets for patent prosecution, university technology transfer officers are often limited in their financial resources for patent prosecution. As a consequence, patent prosecution in a university setting may be hampered by imperfect information about the state of the art a patent may have to compete with. The sooner a technology transfer officer can determine the likelihood of validity and breadth of claims, the better. This is where Peer-to-Patent steps in. If a patent application quickly draws attention and draws substantial prior art assertions from reviewers, the technology transfer officer may be in a better position to assess whether continued prosecution is worthwhile. Thus, Peer-to-Patent may lend itself to improving tech transfer efficiency and financial performance.” Fitzgerald, McEniry and Webbink “The Peer to Patent Initiative” 2010, NCURA Magazine

# Conclusion

- At different levels collaboration is an important process for ensuring a more efficient and effective patent system?

# Professor Brian Fitzgerald

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*Brian Fitzgerald studied law at the Queensland University of Technology graduating as University Medalist in Law and holds postgraduate degrees in law from Oxford University and Harvard University. He is well known in the areas of Intellectual Property and Internet Law and has worked closely with Australian governments on facilitating access to public sector information. Brian is also a project lead of Peer to Patent Australia [www.peertopatent.org.au](http://www.peertopatent.org.au) and The Legal Framework for eResearch. From 1998-2002 he was Head of the School of Law and Justice at Southern Cross University in New South Wales, Australia and from January 2002 – January 2007 was appointed as Head of the School of Law at QUT in Brisbane, Australia. Brian is currently a specialist Research Professor in Intellectual Property and Innovation at QUT, Honorary Professor at City University of London and Chief Investigator in the ARC Centre of Excellence for Creative Industries and Innovation. In 2009 Brian was appointed to the Australia Government’s “Government 2.0 Taskforce” by Ministers Tanner and Ludwig and to the Advisory Council on Intellectual Property (ACIP) by Minister Carr.*

*Relevant publications include B Fitzgerald (editor) Legal Framework for E-Research (Sydney University Press 2008) <http://eprints.qut.edu.au/14439>*