

***IP5 Working Group 2
Second Global Task Force Meeting
Suzhou, China
January 21-22, 2015***

**Reflections on the Active
Component of the Global
Dossier**

Lawrence T. Welch

Eli Lilly and Company



What Should Be The Overall Goal?

- IPO is in favor of a system that is best for IP owners, third parties, the offices, and other users of the system.
- A “one stop” system should insure accuracy and quality with a minimum of duplication and in a cost effective manner.
- Ultimately, this benefits all stakeholders.
- Avoiding duplication, while maintaining quality, means less work needs to be done, which may mean that in the short term some participants in the system (e.g., the local IP professionals) will have a lesser role.
- However, while some parties will have less work, the goal is to reduce costs and to improve the quality of the system and the resulting rights for all.
- The substantive aspects of the IP system will always require the work of local IP professionals.
- Concerns raised by the private bar to date are similar to those which occurred on PCT implementation, but in the end, the PCT has lead to more applications being filed, and ultimately more work for IP professionals.

Implementation Should Use Existing Technologies and Proceed in a Stepwise Fashion

- The suggested approach of filing a document in one office, and then uploading it at a later date in another office, makes sense from the standpoint of IT efficiency, since new systems can build on existing systems.
- Proceeding in a step wise fashion beginning with a proof of concept on a small scale to implement and validate the IT changes is an acceptable way to proceed.
- Such an approach should ultimately allow for various kinds of application filings, including both Paris Convention application filings and as well as PCT national entries.
 - WIPO has already proposed a similar approach for PCT national entry.

Translations

- There is a difference between the kinds of translations used for uploaded documents in the active phase versus documents retrieved in the passive phase.
- Machine translations can readily be used for the passive component, however we may need to further study such use in the active component.
- Documents found in the passive phase now, such as office actions and search reports, particularly if in standardized format, are more amenable for machine translations.
- Documents that are filed by users which represent the legal rights, e.g., the specification and claims, must be completely accurate.

Uploaded Translations and Timing

- There may be a legal difference between uploading of translations of the patent application in a Paris Convention filing versus a national entry under the PCT.
- Under the PCT, Article 11, the filing of a PCT application in the language of the receiving office is legally the filing of an application in each of the designated states; thus if there is an error in translation one could argue that the applicant could return to the original PCT filing to correct errors .
- While some offices permit the filing of an application in the priority document language, followed by a translation later, generally, in a Paris Convention filing, the first document received by the office will be the translated document.
- If, under the active component of GD, one could upload a document filed in the original language of the priority document to a second office, followed by a translation later, it would make sense that the original priority document in the original language could be referred to for correction of errors as in the PCT example.

The Overall Goals Of GD Are Crucial For The Future Of The IP System

- The growth of technology, and the large number of pending applications, requires significant efficiencies in the system to insure that:
 - Backlogs are reduced,
 - Uncertainties and inconsistencies are minimized, and
 - Strong, clear patent rights can continue to drive technological improvements for the benefit of all.
- In the end, everyone will benefit from an optimized system, allowing for the most efficient and cost effective means to process quality patent applications globally.
- We appreciate the willingness of the IP5 Offices to address user requirements, and the rapid implementation of the system so far.
- We look forward to further participation in the continued development of the system.