

PRESENTATION:

**COLLABORATION AMONG PATENT OFFICES:
AN INDUSTRY VIEW**

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Good afternoon and thank you for still being here. I practice at a corporation that files patent applications in the United States. We also file a certain percentage of our applications around the world, in the countries in which we feel we can further our business.

Let's look at what we have today. There is no sharing of examination results by other patent offices and we have national patents around the world. Please forgive me, but I am going to go through all the detailed steps so that everyone understands.

First, we have a filing fee in the United States. Later, an action is given with U.S. search results. I get those results, read the patents, amend my claims, write some remarks, and send in my amendment. Hopefully, I'm going to get a case allowed and I will get a U.S. patent.

Now, let's say we are also going to file in Japan and in the European Patent Office. When I file in Japan, I have another filing fee. Translation costs are probably the largest part of my Japanese filing. I understand translators need time to do this, and they are highly educated. I want them to do a good job of translating my technical documents into something understandable in the Japanese language, because in the future I hope to enforce this patent in the Japanese language and court system. Thus, they need to understand the technology invented in the United States and why we are trying to hold it as our property right. After I file the case, pay my filing fee, and pay the examination fee, I later receive a Japanese action.

The amazing thing to me is that typically the Japanese action is different from the one I received in the United States. Often, they are very similar types of art, but the searches are performed in almost two different databases. I often receive Japanese publications called *Koka*, with a brief English language abstract. Whoever writes those abstracts is very good – I really get a lot of information out of them, especially the numbers. Nevertheless, it is different from what I receive in the United States, usually very different. The Japanese Patent Office typically does not cite U.S. patents. They only go through Japanese documents, and I do not blame them. It's their country and they are depending on their technical qualifications for their Japanese patents. That is what I would do; that is what we do here in the United States.

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However, the basic result is that I have a second set of art to consider for drafting claims. Moreover, having already drafted claims for the United States validity and infringement, I now must draft claims for Japanese validity and infringement. It is not terribly difficult, but it is different. Often, when I am unable to provide instructions to the Nakamura or Osamura law firms to respond to my patent application, I have to ask my Texas Instruments' inside patent counsel to look at this from a Japanese viewpoint and provide instructions to the Nakamura or Osamura law firms to respond to the Japanese Patent Office. The results that come out are often a different set of claims and scope for very much the same invention in the United States. This is interesting to me because, based upon the different art, I receive claims of different scope. Maybe I do not have as many limitations in Japan as I do in the United States. This is more an observation than anything else, but there is a difference. It's something I have to think about if I want to use this patent and licensing effort to gain access to other people's patents.

Accordingly, in Japan I have a filing fee, translation cost, examination fee, slightly different claims, and a different set of art.

What happens next? We file in Europe. Again, I have a European filing fee, examination fee, and after the United States and Japanese actions, I receive a European action, not necessarily with the same timing. The European search results are also different. Europeans often are not worried about citing U.S. patents, maybe because so many United States inventors file in Europe. Looking at the corresponding European patents and the U.S. patents, there is still a different set of art. Again, I have to draft my claims according to the different set of art received and, as has happened to me in the Japan patent application versus the United States one, I typically end up with claims of different scope. These claims are often different from those in the United States or Japan. It may not be a major difference; it may be some words or limitations not existing somewhere else, or a slight limitation I had to add. This makes it interesting for me later in the life of the patent.

So, there is the filing fee, examination fee, different art, different claims separate from the other two, and then I receive a European patent.

What do we have here regarding prosecution on the claims? Well, I have three filing fees, two examination fees, three different sets of cited art and arguments, three different sets of claims, and three different sets of patentability and infringement. My prosecution occurs at different times. Literally, what happens is that I prosecute a U.S. case now, and in a couple of years I have to come back and re-open my files to figure out what I did in this application in the United States to present my prosecution in Japan. Then, at a different time, I open up another file to refresh my recollection on my claims, and prosecute in Europe. I do this prosecution three different times, with three different sets of claim coverage.

Now let's see what would happen if we had one search. Again, I would have three filing fees, maybe one examination fee, or maybe none. Hopefully, I would have one set of cited art, three similar arguments, three similar sets of claims – and maybe the scope of the three sets of claims are very similar to each other instead of different. I still would worry about the three different laws of patentability and infringement. As for my prosecution, since there would be three different countries citing one art, the types of claim coverage would be similar. I guess I would save something: time. It would help me in my

prosecution and in obtaining patents. My conclusion is that if I had one search, I would gain some efficiency in filing an application in a home country and in other countries. This efficiency would certainly be a good thing.

Now let me take you a few steps down the line, to what we do and why we file patents in different countries. Most of our patent applications are filed only in the United States, which is perhaps the largest market in the world. This is where we get the most protection for most of our patents. We understand that not all our patents will ever be infringed. However, it is important that we get many patents to obtain the respect of other people getting patents who are in the same business. We do not file all our patents received in the United States in other countries. Only a percentage is filed in countries with large markets, such as Europe, Japan, and those places where we have competitors in the electronics and semiconductor business, such as Korea and Taiwan, which are the major semiconductor manufacturing areas. If I have a patent covering a market, I really do not need a patent where the product is manufactured, because the manufacturing ends up in my market. Those are some of the things we consider when determining where to file a patent application.

Often what we do – and I see this approach from some of the Japanese associates we do patent business with – is to file several Japanese patent disclosures, combine them into one, then file them in the United States. We will file four or five patent applications on one new product we are coming out with, rather than file all five in each of many foreign countries; we then combine them and file one in each of the different countries. When we file the four or five patent applications in the United States, we are looking at several different types of disclosed inventions, different aspects of the invention. The inventors express themselves in the electronic circuits, systems comprised of circuits, or in the processes. It is up to patent attorneys or patent professionals to transform the invention into a written language to describe it. Often when we do that, we learn that there are many different inventions in the applications.

Where am I going with this? In the United States, since I am aware that we have many different, divisional aspects of inventions, we go ahead and file divisionals on each because we want a patent on every different aspect. Further, by doing some divisionals, I am able to keep my patent application alive, because I understand that the most important part of the patent term is not the first 10 years. Personally, I am not interested in getting a patent out right away; I am more interested in the last 10 years of the patent term, and I am even more interested in the last five years of the term, because that is when patents become worthwhile and worth more. Therefore, I file divisional applications with new filing fees, claims, searches, and arguments.

What happens if I do that in the United States and have a corresponding application in Japan, where I've filed my divisional applications? I cannot say that I do the claims exactly the same in the United States and Japan; maybe they're similar. Right now, I receive two different searches and have two different filing fees. If I file the same divisional in all three jurisdictions (US, Japan, Europe), I have three different sets of art again. Even if I were able to get one search, how would the offices coordinate the searches done on my different divisional applications? It strikes me as perhaps something that would be difficult to accomplish. Yes, if I do an original application, it is easier to keep track of it, but five or ten

years later I will have to file a divisional application – or two or three divisional applications, because different types of aspects are important to us.

Once we start getting into the divisional practice maybe it will be more difficult to share search results. Certainly, there are advantages to sharing search results. It strikes me, once I start filing my divisional applications, that it will be more of a burden on the different offices to share search results. I wonder if someone will start saying that maybe I should be the one to share the search results with the different offices, that the burden should be put on me. I don't know what is a good idea, and I don't know if that is the right thing. I am simply thinking ahead.

In regard to overall conclusions, sharing search results does not affect domestic applications. I think somebody said that 25% of applications filed are filed in all three countries. That leaves 75% of the applications in the United States that are only searched here. I can see where it would save the patent offices time. I certainly applaud all three offices and everyone here involved in trying to reduce patent costs. Certainly, this needs to be done, even if we do not get all the way through some of the issues. A one-search system could certainly simplify claim drafting.

As for having the same types of laws for patentability and infringement in different countries, well, we will think about that in the future. It certainly would be nice to do, but it's not going to happen right away, and that's okay. We can live with some of it; we have lived with it for a long time.

Finally, I would like to mention a few other things. I also teach a project manager course two or three times a year at a local university. My students are high-level engineers working to become project managers. They will eventually lead groups of people working on particular projects. I come in and talk to them about patent law. One of the first questions I get is, "Isn't this patent good across the world?" There is a presumption already in many people's minds that a patent is good everywhere. Maybe we are the only group that understands that patents are not good everywhere. Maybe we are the ones that need to change our minds. Maybe there is a bit more of a groundswell available to us to help with a one-world patent than we think. It certainly should not be insurmountable.

I want to raise another point, but I am not sure where to go with it since it really has not been mentioned thus far. In the United States, we have a duty to disclose to the Patent Trademark Office all the art we are aware of that is material to the validity of the claims. I think those are all the magic words – the materiality aspect of it. I don't have those responsibilities in Europe, Japan, or any other country—

Audience Member: Yet.

Bassuk: Really? Well, that answers my question perhaps. If I am bringing art to the attention of the U.S. Patent Office, for example, am I also going to have to bring that same art to the attention of the Japanese or European examiner? Right now I don't have to. Please consider, in your contemplations of where we are going, whether I am now going to have to do that or not. I raise this issue because I have this responsibility.

But let me take this one step further. In the United States, as a reality of litigation and licensing, it is in my best interest to communicate with the examiner to get printed on the patent as much materially relevant art as possible. However, in order to fend off expensive litigation, I also include many other patents only vaguely relevant to the claims. Maybe they are out of the same international class or U.S. classification. I know that unless I put that art in front of the examiner and in the patent – I am talking about 300 or 400 pieces of art, patents, technical publications, or Japanese/European patents – I am looking at an enforcement lawsuit, because the opposing attorney will bring up anything for an argument. Perhaps the litigators here have had some experience with that.

In any case, that is the reality we face with some of our most important patents. I've heard some examiners say that, in some of the chemical arts, in some patent applications they look at 3,000 or 4,000 pieces of cited art. That is a lot of work, if all that has to be cited in all three offices just because it is the same shared search.

I don't know where we should be taking it. I do know that much of what we do now is done in an almost defensive way, to protect ourselves and help enforce the patent much more readily.

I think I've taken my time. I want to thank all of you for being here so late this afternoon and listening to my presentation.