

## **Standing Committee on the Law of Patents**

**Nineteenth Session**  
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### **PROPOSAL BY THE DELEGATION OF THE UNITED STATES OF AMERICA REGARDING EFFICIENCIES OF THE PATENT SYSTEM**

*Document prepared by the Secretariat*

1. The Annex to this document contains a proposal submitted by the Delegation of the United States of America concerning efficiencies of the patent system.

2. *The members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

PROPOSAL REGARDING EFFICIENCIES OF THE PATENT SYSTEM  
submitted by the United States of America

1. Work sharing programs among patent offices have become a crucial element in improving the efficiency of patent systems in many countries around the world. The prevalence of cross-national filings of patent applications results in patent applications of the same family being examined in multiple countries. As a result, in many cases multiple offices conduct independent searches on the same or similar sets of patent claims, essentially repeating large portions of the work that another office has already performed. This duplication of efforts is not beneficial to the offices, the applicants or the general public because it exacerbates patent backlog and pendency problems that plague many offices.

2. The proliferation of cross-national filings, however, provides a unique opportunity to improve the efficiency of the search and examination process by reusing the work carried out in one office to more efficiently and timely process a related application in another office. The quest for increased efficiency has taken different forms in different contexts. For example, a robust network of Patent Prosecution Highway (PPH) programs has developed between offices of both developed and developing countries. Several other programs have been carried out and are currently being tested between and among offices, in an effort to minimize the duplication of efforts currently taking place with respect to cross-national filings of patent families.

3. In all these programs, one overriding principle is that the sovereignty of the various offices must be maintained. No office does or is expected to “rubber stamp” the decisions made by another office with regards to any member of a family of patent applications. Rather, each office is expected to independently apply its respective national law in determining the patentability of applications. The efficiency improvement comes from reusing the work previously carried out by another office to give a better starting point to the examiner in conducting the search and examination of the application.

4. Different ways of harnessing this increased efficiency have been explored in a number of programs, many of which are currently ongoing. Examples of these cooperative programs include:

USPTO – KIPO SHARE pilot program, where selected applications filed in both offices were examined in one office, and the results were then evaluated by examiners of the other office.

PROSUR regional cooperation undertaken by Argentina, Brazil, Chile, Colombia, Ecuador, Paraguay, Peru, Suriname and Uruguay to improve services to local and international users of the IP system, initially through sharing patent examination results and other intellectual property (IP) resources.

Collaborative Search & Examination, where examiners from the USPTO, KIPO and EPO explored collaborative work in examining PCT applications in groups consisting of a First Examiner and Peer Examiners to create an ISR and WO.

Patent Prosecution Highway (PPH) program, in which dozens of Offices around the world participate, allows an applicant receiving a positive ruling on the patentability of one or more claims in one office to request fast track examination in other participating offices provided that only the allowed claims are presented for examination. This saves both Offices and applicants time and money and provides more timely patent decisions for the benefit of the public.

5. In view of the demonstrated gains in efficiency obtained by work sharing programs, the United States proposes that the member states collaborate in the following activities:
- (a) Carry out an inventory of work sharing programs that are or have been taking place between offices, bilaterally, multilaterally and regionally, and evaluate their benefits for IP offices, for users of the IP system and for the general public.
  - (b) Explore ways to further refine and increase the usefulness of these programs, such as by determining best practices that could be adopted by participating offices on a voluntary basis.
  - (c) Explore the tools that could facilitate effective work sharing programs between participating offices.
  - (d) Conduct workshops on how work sharing programs can be effectively implemented.

[End of Annex and of document]