

Vancouver Group

INTELLECTUAL PROPERTY OFFICES OF
AUSTRALIA, CANADA AND THE UNITED KINGDOM



Towards Global Collaboration:
What IP infrastructure should be developed?

Collaboration between Canada, UK and Australia

Mr Philip Noonan
Director General, IP Australia



- Environment of economic uncertainty necessitates that we work together in a smarter, more collaborative way.
- IP system is *not* immune to impact from a changing global economy
 - ⇒ presents opportunity to evaluate current model and advance efficiencies
- Investment in infrastructure that practically improves the operation and efficiency of the IP system is in *all* our interests.
- **As an example.....** collaboration between the UK, Canadian and Australian IP offices that *is* developing new infrastructure to enable more effective work sharing.

About the Vancouver Group



- **Established in April 2008** (during a meeting in Vancouver, Canada) between the **IP offices of the UK, Canada and Australia**
 - Similar sized developed offices
 - Similar legal heritage
 - Long standing relationships

Aim:

- Share information and experiences on common issues and areas relevant to managing a mid-sized national IP office; and
- Through this collaboration contribute to a more effective multilateral approach to work sharing.

Focus on patents work sharing



- Priority – endeavour to eliminate unnecessary rework and duplication in prosecuting patent applications in the three offices.
- **To this end, undertaken:**
- ✓ Examiner Exchange:
 - Compared search and examination outcomes on 28 national Canadian applications:
 - full search and opinion on 20 pending applications
 - 8 granted patents, with accepted family members in UK and Australian offices
- ✓ Comparison of quality standards and processes

Outcomes:

- Mutual exploitation of each office's work is tenable
- Vancouver Group offices will have discretion to do further work as deemed necessary for an individual case



Principles of the Vancouver Group Mutual Exploitation initiative :

- 1. Core Principle** - where possible, rely on any patent granted by another Vancouver Group Office or on the search and examination report of another Vancouver Group Office resulting in an issued report for an equivalent application. Further work undertaken if a Vancouver Group Office deems it necessary.
- 2. Office driven** - offices will rely on earlier work without the need for applicants to ask them to do so.
- 3. Transparency** - offices will give notice, where appropriate, to when work from another office *has* and *has not* been relied upon. Maintains confidence and contributes to continuous improvement of offices.
- 4. Applies to all work done by Vancouver Group offices** - includes PCT work regardless of the origin of the applicant.



Applicant-driven principles:

- 5. Accelerated examination** - if application successful in one Vancouver Group Office, applicant can request acceleration of equivalent application in other Offices.

- 6. Arrangements for accelerated examination** - simple and efficient as possible; consistent with other arrangements (eg. PPH).



Implementation-focused principles:

7. **Access to work** - enabling platform using WIPO infrastructure
8. **Ongoing examiner interaction** - to enhance mutual understanding and promote greater confidence in one another's work.



Given....

- Inter-office access to search and examination reports critical
- Multilateral repository does not yet exist

Vancouver Group and WIPO agreed to a pilot project:

- ⇒ development of a digital library of search and examination reports, accessed via WIPO infrastructure

Intended approach:

- Each Office sends reports on national and national phase applications to WIPO for storage in digital library
- Upon examination, examiners to source available reports done by another Vancouver Group Office from digital library
- If report on equivalent application available, examiner will use this work in accordance with Vancouver Group-ME principles

Expected benefits



- Practical model for facilitating work sharing
 - inherently improve transparency and quality of work done by offices
- Resource for centralised access to search and examination reports - could be extended to other offices
- Positive step forward for offices working together to address common challenges:
 - increasing (and unsustainable) patent backlogs;
 - improving quality of rights;
 - minimising unnecessary duplication and inefficiencies in the IP system
- **Ultimately**, enhance efficiency of the IP system and productivity of offices – in the interest of our customers and the community

Next steps.....



- Commitment between Vancouver Group offices and WIPO..... at the beginning of our collaborative journey
- Implementation underway
- Embraced this opportunity and enthusiastic about its potential



Thank You!

Merci!



The Vancouver Group was established in April 2008 and comprises the Canadian IP Office (CIPO), United Kingdom IP Office (UKIPO), and IP Australia (referred to as “Offices”).

This collaboration is borne out of all three Offices being similarly sized developed offices, having similar legal heritage and long standing cooperative relationships.

Broadly, the aim of the Vancouver Group is:

- to share information and experiences on common issues and areas relevant to managing a mid-sized national IP office; and
- through this collaboration, and in particular our endeavours to eliminate unnecessary rework and duplication in prosecuting patent applications in the three offices, contribute to a more effective multilateral approach to work sharing.

To this end, the Vancouver Group has agreed to a mutual exploitation arrangement, known as the Vancouver Group Mutual Exploitation initiative (Vancouver Group-ME).

This paper outlines the intent and principles of Vancouver Group-ME as well as the proposed approach for accessing inter-office search and examination reports that will underpin Vancouver Group-ME.

Mutual Exploitation Principles

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

1. 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.
2. 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.
3. 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.
4. 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.
5. 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.
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.

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.

Further Information

IP Australia

Ms Gillian Jenkins
gillian.jenkins@ipaustralia.gov.au

CIPO

Mr David Campbell
david.campbell@ic.gc.ca

UKIPO

Mr Andrew Bartlett
andrew.bartlett@ipo.gov.uk