

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

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### **WORK-SHARING PROGRAMS AMONG PATENT OFFICES AND USE OF EXTERNAL INFORMATION FOR SEARCH AND EXAMINATION**

*Document prepared by the Secretariat*

#### **INTRODUCTION**

1. Pursuant to the decision of the Standing Committee on the Law of Patents (SCP) at its nineteenth session, held in Geneva from February 25 to 28, 2013, the present document is a compilation, based on information received from Member States, of work-sharing programs among patent offices and use of external information for search and examination.
2. The document consists of the following Sections: (i) Various initiatives on use of search and examination results; (ii) Acceleration of search and examination at the office of second/subsequent filing; (iii) Prioritized or expedited search and examination at the office of the first filing; (iv) Collaboration on joint search and examination; (v) Use of other offices' search and examination capacity; (vi) Platforms and tools to share information on search and examination; and (vii) Challenges and initiatives supporting the work sharing environment.
3. Following Note C.8261, the following Member States and Regional Patent Offices submitted the relevant information which enabled the Secretariat to prepare the present compilation: Argentina, Australia, Costa Rica, Finland, France, Georgia, Germany, Hungary, Israel, Japan, Lithuania, Republic of Moldova, Monaco, Norway, Peru, Poland, Portugal, Republic of Korea, Spain, Sweden, Turkey, Ukraine, United Kingdom, United States of America, Zambia, the European Patent Office (EPO) and the Eurasian Patent Office (EAPO) (27 in total).

## VARIOUS INITIATIVES ON USE OF SEARCH AND EXAMINATION RESULTS

### Vancouver Group

4. The Vancouver Group was established in 2008 between the IP Offices of Australia, Canada and the United Kingdom with an aim to: (i) share information and experiences on common issues and areas relevant to managing a mid-sized national IP office; and (ii) contribute to a more effective multilateral approach to work sharing in a manner that supports the principles of the Patent Cooperation Treaty (PCT).

5. The Vancouver Group Mutual Exploitation initiative (VGME) is the Vancouver Group's approach to efficiently and effectively eliminating unnecessary rework and duplication in prosecuting patent applications in the three offices. The core principle of the VGME is that a Vancouver Group Office (VGO) will, where possible, rely on any patent granted by another VGO, or on the search and examination report of another VGO in coming up with their own report on the same application. An Office may perform further search and examination if it thinks it is necessary.

6. The above principle is applied in an "Office-driven" manner<sup>1</sup> transparently<sup>2</sup> and in relation to all work done by a VGO. Examiners have access to the work of another VGO through the enabling platform using the WIPO infrastructure.<sup>3</sup> VGOs support ongoing examiner interaction that enhances mutual understanding, seeks to minimize variability and promotes greater confidence in one another's work.<sup>4</sup>

7. In addition, where one VGO issues an office action indicating that at least one claim is allowable or a patent is granted in relation to an application, the applicant will be able to apply to the other VGOs for accelerated examination of a related application.<sup>5</sup>

### Regional Frameworks for Work Sharing

#### *ASEAN Patent Examination Co-operation Programme (ASPEC)*

8. ASPEC is a work-sharing programme among IP Offices of ASEAN Member States (AMS) which was launched on June 15, 2009. The programme allows participating AMS IP Offices to share search and examination results among themselves to support their own search and examination work. While the participating AMS IP Office may consider those results, it is not obliged to adopt any of the findings or conclusions reached by the other IP Office. Nine ASEAN countries are participating in the programme: Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, Philippines, Singapore, Thailand and Viet Nam.

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<sup>1</sup> That is, the Offices will rely on earlier work without the need for applicants to ask them to do so.

<sup>2</sup> 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.

<sup>3</sup> See paragraphs 38 and 39 on WIPO Centralized Access to Search and Examination (WIPO CASE).

<sup>4</sup> Further information on VGME can be found at: <http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr02959.html>.

<sup>5</sup> Other initiatives that accelerate search and examination at the office second and subsequent filing are described in paragraphs 20 to 26.

9. The objectives of the programme are:
- (i) Reduced work and faster turnaround time: reference to earlier work could help an examiner to develop his search criteria or strategy more quickly, reduce searching and/or assist the examiner to understand the claimed invention faster. Faster prosecution of the patent application is, therefore, possible.
  - (ii) Better search and examination: the other patent authorities might have access to databases unavailable to the examiner (e.g. specific technical databases, local databases, databases in other languages). Therefore, the opportunity to refer to these search and examination results could provide the examiner with information on and assessment of prior art which he or she would otherwise not have access to.
10. The patent applicant is required to file a duly completed ASPEC Request Form in the second IP Office and it shall be accompanied by the following documents: (i) a copy of the search report and the examination report (“minimum documents”) of a corresponding application from the first IP Office; and (ii) a copy of the claims referred to in the minimum documents submitted.<sup>6</sup> A patent application in the first IP Office is a corresponding application if it is linked by a Paris Convention priority claim to the patent application in the second IP Office, and vice-versa, or the patent applications in both the first IP Office and second IP Office have the same priority claim from another Paris Convention member country.<sup>7</sup>

#### *Cooperation between a Regional Office and its Member States’ National Offices*

11. The European Patent Office Utilization Implementation Project (UIP) was launched on March 28, 2012, with Austria, Denmark and the United Kingdom. Portugal also joined the project after that date. This scheme involves the confidential sharing of search and examination results of these national Offices with the EPO through the automated system before the publication of the national applications. The EPO examiner will consider the results when examining the equivalent European application. Three streams of priority data are being received via the UIP: citations, national-office documents such as search reports and written opinions, and classification data.

12. At the EAPO, when an applicant from a Contracting State of the Eurasian Patent Convention (EAPC) files a regional Eurasian patent application and claims a priority of an earlier national application, EAPO may use the national search report for the corresponding national application, although there is no statutory requirement to submit such report.

#### Bilateral Frameworks for Work Sharing

##### *Strategic Handling of Application for Rapid Examination Project (SHARE)*

13. In 2008, the Korean Intellectual Property Office (KIPO) and the United States Patent and Trademark Office (USPTO) started a comprehensive program to foster increased bilateral cooperation between the offices. This included the SHARE pilot project, under which, when corresponding applications were filed in two offices, the Office of First Filing (OFF) conducted search and examination and shared its findings with the Office of Second Filing (OSF), such

<sup>6</sup> The ASPEC Request Form may be accompanied by a claim correspondence table showing relatedness of the claims examined in the corresponding application to the claims in the current application, a copy of the written opinion(s) and the list of prior art, if available (“additional documents”).

<sup>7</sup> Further information on ASPEC can be found at: <http://www.asean.org/news/asean-secretariat-news/item/asean-enhances-asean-patent-examination-co-operation-programme>, and <http://www.ipos.gov.sg/AboutIP/TypesofIP/WhatisIntellectualProperty/Whatisapatent/Applyingforapatent/ASEANPatentExaminationCo-operationASPEC.aspx>.

that the OSF could maximize reutilization of the work performed by the OFF and minimize duplication of work.

14. Prior to beginning the pilot, examiners from KIPO visited the USPTO as part of an examiner exchange program, in which each Office presented an overview of its search and examination practices. It was reported that, as a result of this program, the Offices developed a deeper understanding of each other's rules and procedures.<sup>8</sup>

#### *United Kingdom Intellectual Property Office (UKIPO)–USPTO Work Sharing Initiative*

15. On November 10, 2010, the USPTO and the UKIPO commenced a program for reutilizing each other's search and examination work products on corresponding patent applications, to assess the benefits of work sharing. According to the program, when corresponding applications are filed in both the USPTO and UKIPO, the UKIPO will conduct a search and share its findings with the USPTO through the normal publication process so that the USPTO can maximize re-use of the work performed by the UKIPO. After the USPTO completes its search and examination, it will make its work available through the public Patent Application Information Retrieval system (PAIR)<sup>9</sup> so that the UKIPO will be able to maximize re-use and minimize duplication of examination work conducted later in the prosecution.

16. By sharing and reutilizing work products, the Offices aim to increase the efficiency and quality of their respective patent search and examination processes. This program includes initiatives to educate examiners on the patent system and examination practices of the other office.<sup>10</sup>

#### Unilateral Use of Search and Examination Reports and Other Available Information

17. Many patent offices' examiners unilaterally use search and examination reports and other available information on corresponding applications produced by other offices to assist the examination of national applications.<sup>11</sup> They can retrieve such information directly from public on-line databases of other patent offices.<sup>12</sup> While some countries' laws expressly state that examiners should or may use search and examination results<sup>13</sup> of other offices, if available,<sup>14</sup>

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<sup>8</sup> In the submission of the United States of America, it was stated that an analysis of the pilot revealed that in general, a reference could be reutilized at least in part, but that different examination practices in each Office resulted in examiners applying the references differently. Therefore, addressing differences in office procedures through examiner exchange programs was one element leading to successful work sharing.

<sup>9</sup> See paragraph 41 on the PAIR system.

<sup>10</sup> In the submission of the United States of America, it was stated that further cooperation would be beneficial in exploring the differences in practice between the Offices, particularly regarding novelty and inventive step/non-obviousness. Collaboration on those issues could facilitate a deeper understanding among examiners and lead to more effective reutilization of work products. In addition, the potential benefits of work sharing could also be exploited more effectively by gaining a better understanding regarding the applicability of prior art.

<sup>11</sup> The following Member States' and the regional patent offices' submissions expressly indicated that such practice was common in their examination process: Argentina, Australia, Hungary, Norway, Portugal, Republic of Moldova, Spain, Sweden, United Kingdom, EAPO and EPO.

<sup>12</sup> For example, IP offices of Brazil, Denmark and Norway publish the results of search and examination carried out by their offices.

<sup>13</sup> The EPO reported in its submission that it had introduced different measures for encouraging the reutilization of other offices search results. They include: (i) pre-search routine, according to which the EP examiners launch automatically a pre-search routine when starting to draft a search report, aiming at collecting information relating to the prior art cited by other offices in family applications; and (ii) extended top up search, according to which examiners should systematically perform a top up search at least at the start and before concluding the examination procedure. The search preparation used for this has been extended to retrieve in addition to the conflicting applications according to Article 54(3), prior art retrieved by other Offices.

<sup>14</sup> For example, in Norway and Sweden.

examiners rely on such information only to the extent possible and as applicable under the respective national law. They may perform further examination work as necessary.

18. In addition to the use of work products established by other national patent offices, in many countries, examiners are encouraged or requested to use the work products prepared by the International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) in the framework of the PCT.<sup>15</sup> Some patent offices have reported to always use the PCT work products, supplemented by a search for prior art which may not be detected by the ISA.<sup>16</sup> In that regard, the re-use of previous search and examination results is regulated under the Spanish patent legislation, which provides for a reduction of search fee when the international search report or international preliminary report on patentability produced by the competent ISA and IPEA is available for re-use by the office.<sup>17</sup>

#### *Obligation of applicants to submit foreign results*

19. According to the patent laws of many countries, the applicant must or may be required to submit information concerning prior art search, grant or refusal of corresponding foreign applications in order to provide additional information which can be used by the examiner to assist or improve the search and examination of national application(s).<sup>18</sup> While the national and regional laws may differ, if such information has not been submitted within the prescribed time limit, an application may be deemed to be withdrawn. For example, according to Rule 141(1) and Rule 70b of the Implementing Regulations to the European Patent Convention (EPC), an applicant claiming priority shall file a copy of the results of any search carried out by the authority with which the previous application was filed together with the European patent application, in the case of a Euro-PCT application on entry into the European phase, or without delay after such results have been made available to him. Rule 141(2) EPC, however, allows the EPO to exempt applicants from the obligation indicated above when an agreement exist between the offices on exchange of search results.<sup>19</sup> If such copy has not been filed with an

<sup>15</sup> In that regard, the UKIPO reported that, as part of its efforts to reduce its backlogs, it had been making greater use of IPRP on PCT cases which had entered the national phase (where the IPRP had raised major objections and where the applicant had not responded to these by way of amendment or argument). In addition, the submission of the Republic of Moldova noted that the ISRs produced by the ISAs were very useful, because the office has no access to various patent and non-patent databases.

<sup>16</sup> At the EAPO, supplementary search is carried out with regard to Eurasian applications with an earlier filing/priority date, using the Eurasian patent database (EAPATIS), as well as the Russian patent and non-patent databases. In Ukraine, if the applicant provides with a search report carried out by the ISA, additional search is performed only in relation to the prior art that could not be detected by the ISA, including, in particular, applications filed at the State Intellectual Property Service of Ukraine (Paragraph 6.3.2 of the Rules of the Application for Invention and Utility Model Processing approved by the Order of the Ministry of Education and Science of Ukraine of March 15, 2002, № 197).

<sup>17</sup> Article 33.5 of Law No. 11/1986 of March 20, 1986 on Patents (as last amended by Law No. 14/2011 of June 1, 2011) states: "Where the prior art report can be based wholly or partially on the international search report conducted under the Patent Cooperation Treaty, the applicant shall be reimbursed 25, 50, 75 or 100 per cent of the fee, depending on the extent of the latter report." Article 39 states: "Where the preliminary examination can be based wholly or partially on the international preliminary examination report produced by the competent international preliminary examining authority, the applicant shall be reimbursed 25, 50, 75 or 100 per cent of the rate, depending on the extent of the aforementioned report."

<sup>18</sup> According to document CDIP/7/3, the patent laws of the following countries contain a specific provision allowing the office to request the applicant to provide such information: Antigua and Barbuda, Argentina, Australia, Bahrain, Barbados, Belize, Bhutan, Botswana, Brazil, Burundi, Cambodia, Chile, China, Costa Rica, Djibouti, Denmark, Dominica, El Salvador, Estonia, Ethiopia, Finland, Ghana, Grenada, Guatemala, Honduras, Iceland, India, Ireland, Israel, Jordan, Kenya, Lao People's Democratic Republic, Liberia, Malaysia, Mauritius, Mexico, Mongolia, Mozambique, Namibia, New Zealand, Nicaragua, Norway, Oman, Pakistan, Papua New Guinea, Paraguay, Philippines, Rwanda, Saint Lucia, San Marino, Serbia, Singapore, Sri Lanka, Swaziland, Thailand, Tonga, Trinidad and Tobago, Tunisia, Uganda, United Republic of Tanzania, Viet Nam, Andean Community and EPO.

<sup>19</sup> Applicants will be exempted from filing a copy of the search results under Rule 141(1) EPC if they are claiming the priority of either (i) an application on which the EPO drew up a certain type of search report, or (ii) a first

[Footnote continued on next page]

application, the applicant is invited to file, within a prescribed period, a copy or a statement that such search results are not available to him. If the applicant fails to reply in due time, the European patent application shall be deemed to be withdrawn.<sup>20</sup>

## **ACCELERATION OF SEARCH AND EXAMINATION AT THE OFFICE OF SECOND/SUBSEQUENT FILING**

### PCT Fast-track

20. In the United Kingdom, as of May 28, 2010, applicants may request accelerated examination in the UK national phase if their PCT international application has received a positive international preliminary report on patentability, thus encouraging effective use of the PCT international phase work products.<sup>21</sup>

### Patent Prosecution Highway (PPH)

#### *Bilateral PPH*

21. Under the bilateral PPH agreements, if the claims of an application have been found patentable by the office of first filing (OFF), an applicant may request accelerated examination of a corresponding application at the office of second filing (OSF). The OSF can utilize the positive search and examination results of the OFF, thereby avoiding duplication of work and expediting the examination process. The PPH began in 2006 as a pilot between the USPTO and Japan Patent Office (JPO), and since then has been embraced by many other offices. The PCT-PPH expands the program to applications that obtained positive work products of the ISA or IPEA.<sup>22</sup>

22. An important principle of the PPH which was underlined in the submissions of participating countries is that every participating office conducts its own search and examination according to its national law. There is no deference to the search results or legal conclusions reached by another office. The work product of the office that first examined the application is simply used to provide a better starting point to the office conducting the later examination.

23. The submissions of the following countries indicated that their offices had concluded various PPH agreements<sup>23</sup> with other IP offices, as shown on the table below: Australia (AU), Finland (FI), Germany (DE), Hungary (HU), Israel (IL), Japan (JP), Poland (PL), Portugal (PT),

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filing made in Austria, Japan, the Republic of Korea, the United Kingdom or the United States of America (“Notice from the European Patent Office dated 27 February 2013 concerning exemption under Rule 141(2) EPC from filing a copy of the search results – utilisation scheme”).

<sup>20</sup> In this regard, Article 46 of Decision 486 of the Andean Community provides as follows: “[...] If the examination of the patentability of the invention requires it, the applicant shall, at the request of the competent national office and within a period not exceeding three months, submit one or more of the following documents relating to one or more foreign applications referring to all or part of the invention being examined: (a) a copy of the foreign application; (b) copies of the findings of the novelty or patentability examinations conducted with respect to the foreign application; (c) a copy of any patent or other protection granted on the basis of the foreign application; (d) a copy of any decision or ruling rejecting or refusing the foreign application; or, (e) a copy of any decision or ruling annulling or invalidating the patent or other protection granted on the basis of the foreign application. The competent national office may accept the results of the examinations referred to in subparagraph (b) above as sufficient to certify that the conditions have been fulfilled regarding the patentability of the invention. If the applicant fails to submit the requested documents within the period prescribed in the present article, the competent national office shall refuse the patent.”

<sup>21</sup> Further information on the UK Fast-track can be found at: <http://www.ipo.gov.uk/p-pn-fasttrack>.

<sup>22</sup> See [http://www.wipo.int/pct/en/filing/pct\\_pph.html](http://www.wipo.int/pct/en/filing/pct_pph.html).

<sup>23</sup> The types of bilateral PPH agreements include: (i) PPH only; (ii) PCT-PPH only; and (iii) PPH and PCT-PPH.

Norway (NO), the Republic of Korea (KR), Spain (ES), Sweden (SE), the United Kingdom (UK) and the United States of America (US).<sup>24</sup>

	PPH and/or PCT-PPH partners
<b>AU</b>	US
<b>FI</b>	AT, CA, CN, ES, HU, IL, JP, KR, RU, US
<b>DE</b>	CA, CN, JP, KR, UK, US
<b>ES</b>	CA, FI, JP, KR, MX, PT, RU, US
<b>HU</b>	AT, FI, JP, KR, PT, US
<b>IL</b>	CA, DK, FI, JP, US
<b>JP</b>	AT, CA, CN, ES, FI, HU, IL, KR, RU, SE, UK, US, EA, EP, NPI (and others)
<b>PL</b>	CN, JP
<b>PT</b>	ES, HU, JP, US
<b>NO</b>	JP, US
<b>KR</b>	AT, CA, CN, DK, ES, FI, DE, HU, JP, MX, RU, SG, UK, US
<b>SE</b>	JP, KR, US
<b>UK</b>	CA, DE, JP, KR, US
<b>US</b>	AT, AU, CA, CN, CO, CZ, DE, DK, ES, FI, HU, IL, IS, JP, KR, MX, NI, NO, PH, PT, RU, SE, SG, UK, EP, NPI, TIPO

### *IP5 PPH*

24. The world's five largest IP Offices (IP5), i.e., EPO, JPO, KIPO, SIPO<sup>25</sup> and USPTO, agreed to launch a comprehensive IP5 PPH pilot programme as of January 2014. The PPH arrangements currently operational between the IP5 Offices will be integrated in this all-inclusive scheme. A pilot programme leverages fast track patent examination procedures already in place at the IP5 in order to enable obtaining patents faster and more efficiently. Under the programme, applicants whose patent claims have been found to be patentable by one office may ask for accelerated processing of their corresponding applications pending before the other IP5 offices. In carrying out the task, the offices concerned will also exploit already existing work results to the extent practicable. Requests to use the PPH can be filed with any of the IP5 Offices both on the basis of the PCT work product as well as national work products established by the IP5.<sup>26</sup>

### *Global Patent Prosecution Highway (GPPH)*

25. The IP offices of the following countries and the Nordic Patent Institute intend to pilot a GPPH arrangement as of January 6, 2014: Australia, Canada, Denmark, Finland, Japan, Norway, Portugal, the Republic of Korea, the Russian Federation, Spain, the United Kingdom and the United States of America (13 in total).

26. The GPPH pilot will allow patent applicants to request accelerated examination at any of the offices involved in the pilot if their claims have been found to be acceptable by any of the other offices involved in the pilot. The pilot will use a single set of qualifying requirements, and aims at simplifying and improving the existing PPH network.<sup>27</sup>

<sup>24</sup> There are other IP offices that have concluded various PPH agreements. For example, see <http://www.ipo.go.jp/ppph-portal/index.htm>.

<sup>25</sup> The State Intellectual Property Office of the People's Republic of China.

<sup>26</sup> See <http://www.epo.org/news-issues/news/2013/20130924.html>.

<sup>27</sup> Further information on GPPH can be found at: <http://www.ipo.go.jp/ppph-portal/globalpph.htm>.

## **PRIORITIZED OR EXPEDITED SEARCH AND EXAMINATION AT THE OFFICE OF THE FIRST FILING**

### JP-Fast Information Release Strategy (JP-FIRST)

27. JP-FIRST is a program under which the JPO prioritizes examination of applications that were used as a basis for filing applications abroad (i.e. applications based on which the priority under the Paris Convention is claimed in foreign applications).
28. The following outcomes are expected from the program:
- (i) Support for acquiring appropriate rights abroad: examiners in various offices will be able to use examination results provided by Japan under this program. By doing so, it is anticipated that those examiners will be able to conduct high-quality examinations. As a result, applicants can acquire strong and stable rights abroad.
  - (ii) Reducing the examination workload worldwide: over the long term, the examination workload at each office is expected to be reduced because of the progress being made in work-sharing among countries. When the efficiency of examination processes is improved, the waiting period for examination can be shortened all over the world, including Japan.

### First Look Application Sharing (FLASH 2.0)

29. The FLASH program is a specific vehicle implementing the SHARE concept in which offices should focus examination efforts on applications for which they are the Office of First Filing (OFF). The FLASH Program is designed to maximize work-sharing among patent offices by establishing a notification system so that other offices can benefit from early availability of search and examination results produced by the USPTO. In this pilot, the FLASH Program leverages the existing priority document exchange system created by the Trilateral Offices, i.e., EPO, JPO and USPTO.

30. When an applicant files an application with the USPTO and then files a corresponding application with another Trilateral Office claiming priority based on the application filed with the USPTO, the applicant can request the priority document via the existing Priority Document Exchange (PDX) system. This request for the USPTO priority document will serve as a trigger to alert the USPTO that it is the OFF. The USPTO will then expedite the search and examination of the identified application in an effort to provide early results for the JPO and EPO. The USPTO will also notify the Trilateral Offices when the examination results are available, and will make those results available via the File Wrapper Access (FWA)/PAIR tools.<sup>28</sup>

## **COLLABORATION ON JOINT SEARCH AND EXAMINATION**

### PCT Collaborative Search and Examination Pilot Project (CS&E)

31. In May 2010, EPO, KIPO and USPTO launched a pilot project on collaborative search and examination under the PCT. The objective of the project was to allow examiners from different Authorities in different regions and with different language specialties to work together on one

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<sup>28</sup> The submission of the EPO stated that a project similar to JP-FIRST and FLASH pilot had been launched recently with SIPO, and that another project had been under discussion with KIPO.



PCT application with the aim of establishing a high quality international search report (ISR) and written opinion of the International Searching Authority (WO-ISA).

32. In the pilot, an examiner from the office acting as ISA for a given PCT application (the first examiner) analyzed the application, defined a search strategy, conducted the search and drafted a provisional ISR and WO-ISA. The provisional ISR and WO-ISA were then transmitted to two peer examiners in the other offices. The peers commented on or supplemented the provisional work of the first examiner, who considered those comments when drafting the final ISR and WO-ISA.

33. The successful completion of the first CS&E pilot program spurred the second pilot with duration of one year and involving more examiners and more PCT applications.<sup>29 30</sup> The second pilot project was completed in October 2012.<sup>31</sup> In May 2013, the PCT Working Group concluded that it was too early to propose at that stage a permanent CS&E scheme. However, the Working Group continues to further explore that concept by initiating a third pilot.<sup>32</sup>

#### KIPO Joint Prior Art Search Program

34. KIPO has implemented a Joint Prior Art Search Program which applies to common patent applications filed with patent offices of countries participating in the program. The program aims to improve the examination quality of participating offices and build a foundation for the collaborative use of examination results. Under this program, KIPO has been cooperating with the offices of China, Germany, Japan, the Russian Federation, the United Kingdom and the United States of America, among others.

35. Under the program, the examiners of the participating countries jointly conduct patent examination of common patent applications filed in each country, analyze the results of examination and prior art search, compare examination practices, and share examination know-how. They also visit the other offices to experience their examination systems and practices, to improve mutual understanding of their patent systems, and to benchmark the strengths of those systems.

### **USE OF OTHER OFFICES' SEARCH AND EXAMINATION CAPACITY**

#### Monaco–EPO Agreement

36. With a view to improving the quality of patents, the Principality of Monaco signed an agreement with the EPO in 2008, whereby, when an application for a national patent is filed and if expressly requested by the applicant, the EPO produces a prior art search report to enable the applicant to assess the chances of subsequently obtaining a European patent.<sup>33</sup>

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<sup>29</sup> At the Meeting of International Authorities (PCT/MIA) held in Moscow in March 2011, the EPO informed about the successful completion of the CS&E first pilot project in September 2010, and the plans for the second pilot. See document PCT/MIA/18/16.

<sup>30</sup> While the first pilot project had a small scale as its main objective was to test basic assumptions related to the feasibility of a collaborative approach between examiners and a general assessment of the benefits and disadvantages from a qualitative point of view, the second pilot project was to build on the lessons learnt during the first pilot project in order to allow a more quantitative assessment of the approach and a fine-tuning of an operational working model.

<sup>31</sup> According to the report of the EPO, the project was, in general, positively evaluated by both examiners and applicants.

<sup>32</sup> See document PCT/WG/6/22 REV.

<sup>33</sup> This search report will be available following the entry into force of the future law on national patents. See the submission of Monaco.

### The Agreement between Turkish Patent Institute and Other Offices

37. Turkish Patent Institute (TPI) has been preparing search and examination reports for some of the IPC classes of patent applications since 2005. The search and examination reports in other classes have been prepared by other offices that have an agreement with TPI, such as the EPO, Rospatent and Swedish Patent Office. However, from 2016, TPI is planning to prepare search and examination reports for all IPC classes.

## **PLATFORMS AND TOOLS TO SHARE INFORMATION ON SEARCH AND EXAMINATION**

### WIPO Centralized Access to Search and Examination (CASE)

38. The WIPO CASE system provides a platform to share information with regard to search and examination among participating IP offices. The system was initially developed by the International Bureau in response to a request from the Vancouver Group offices.<sup>34</sup> It is now operational for exchange of documents between examiners in the three offices.

39. Since March 2013, any patent office may join the system by notifying the International Bureau according to the Framework Provisions of the system. The office will choose whether it wishes to be a depositing office<sup>35</sup> or only an accessing office<sup>36</sup> and technical choices need to be made for the exchange of documents between the office and the system.<sup>37</sup>

### Databases allowing Other Offices to Retrieve Information relevant to Search and Examination

#### *Advanced Industrial Property Network (AIPN)*

40. The AIPN is a web based system which allows patent examiners of various countries to obtain dossier information and legal status of applications examined by the JPO. In particular, the following information is provided on each application: patent family data, legal status, cited documents, full text of publications, file wrapper information (e.g., office actions, search reports, amendment and arguments, examiner's notes)). Almost all information is translated into English by Japanese-English machine translation. In addition, the AIPN has been equipped with a multilingual machine translation function since March 2013. As of April 2013, the AIPN was available in 61 countries/organizations.

#### *United States Patent Application Information Retrieval system (PAIR)*

41. The PAIR system provides a simple and secure way to retrieve and download information regarding patent application status. There are two PAIR applications: public PAIR and private PAIR. Public PAIR provides access to issued patents and published applications. Private PAIR

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<sup>34</sup> The Vancouver Group was established between the IP Offices of Australia, Canada and the United Kingdom. See paragraphs 4 to 7.

<sup>35</sup> The depositing office makes available search and examination documentation for patent applications filed with that office. Technically, this may be done by uploading the documents on the WIPO CASE, or by making the documents available in the WIPO CASE system via secure web services.

<sup>36</sup> Examiners at the accessing office have access to the WIPO CASE web portal and can use the system to search patent applications filed with other participating offices and to retrieve the documents that are made available by those offices

<sup>37</sup> At present, in addition to the Vancouver Group Offices, the IP Offices of China (accessing and depositing office), New Zealand (accessing office) and Singapore (accessing office) participate in the system. The IP office of Israel announced its intention to join the system as well.

provides secure real-time access to pending application status and history using digital certificates.<sup>38</sup>

*The Korean Patent Information Online Network (K-PION)*

42. The K-PION is a Korean to English machine translation service provided by KIPO aiming to help patent examiners in other offices in referring to and reviewing Korean patent information. It offers original texts and the corresponding English translations of the following information: (i) file wrapper information (bibliographic data, transaction history, and publication document) for, *inter alia*, patent applications published by KIPO; (ii) English keyword search of Korean Patent Abstracts (KPAAs); and (iii) file wrapper information of international applications filed with KIPO under the PCT.

*European Patent Register*

43. European Patent Register is an online database which provides procedural and legal status data on patent applications handled by the EPO. It contains all the publicly available information on European patent applications as they pass through the grant procedure, including oppositions, patent attorney/EPO correspondence and more. This service also provides for public file inspection, and is free of charge.<sup>39</sup>

External databases for retrieving information relevant to search and examination

44. Some countries reported that the following external databases had been used by their IP offices for retrieving information relevant to search and examination:

Argentina	Espacenet, Epoline, USPTO and Japanese Patent Office databases
Costa Rica	Cadopat, PatBase
Finland	Various databases including EPODOC, WPI, European Patent Register, PATENTSCOPE
Hungary	EPOQUE Net, STN and websites of different national offices
Israel	EPOQUE Net, Thomson Innovation, STN, Derwent World Patent Index (via STN), Questel and all freely available databases
Republic of Moldova	Espacenet, PATENTSCOPE and other specialized databases
Peru	Various databases, including such as Espacenet, Epoline, PAIR, JPO's database, PATENTSCOPE, OEPM and LATIPAT
Poland	European Patent Register, PAIR, K-PION and AIPN
Portugal	European Patent Register, PATENTSCOPE, as well as other national offices' websites
Republic of Korea	Korean Multifunctional Patent Search System (KOMPASS), as well as 24 external DBs, such as IEEE, Nature, STN (CAS)
Sweden	EPOQUE Net and other available databases provided through this system by the EPO
Turkey	EPOQUE Net, Espacenet
Ukraine	Various databases including EPOQUE Net, REAXYS, STN, Derwent World Patent Index, Espacenet, CISPATENT, and WIPO ARDI program. In addition, 10 foreign commercial databases, funds of 59 largest national and specialized

<sup>38</sup> To access public PAIR, customers need to have an application number, patent number or publication number that they wish to search. To access private PAIR, customers must be (i) a registered patent attorney/agent, an independent inventor, or a person granted limited recognition, (ii) have a customer number, (iii) have a digital PKI certificate to secure the transmission of the application to the USPTO.

<sup>39</sup> The Polish Patent Office (PPO) provides free access to patent specifications and related search reports via the PPO's website in the EPO Register Plus (former name of European Patent Register). There is also a project implemented by the EPO and national offices on a Patent Register Platform, which will enable them to quickly check out the legal status of patent applications in individual member states. See submission of Poland.

	libraries and more than 20 sources of patent information in electronic form
The United Kingdom	Specialist patent databases, and variety of other technical, non-patent databases. These include EPOQUE Net, STN (CAS), EBI-EMBL, IEEE Xplore, Springer Link, Derwent World Patent Index, EPO's global patent documentation abstract collection, patent document full-text including translations to English of Chinese, Japanese and Korean language publications, Elsevier Science Direct, Springer Journals, BIOSIS, Inspec, MEDLINE, PUBCHEM, Traditional Chinese Medicine, Traditional Knowledge Digital Library and other traditional knowledge resources, IBM Technical Disclosure Bulletin, Society of Exploration Geophysicists Digital Library, Institute of Physics Journals, American Institute of Physics Journals, various standards including telecommunications and engineering, Institute of Electrical and Electronic Engineers Journals and IP.com

### Tools for Work Sharing in the Framework of IP5

45. Many work sharing programs rely on various tools to help the examiners communicate, exchange references, access information etc. Some examples of initiatives undertaken in the framework of IP5 to improve access to patent family data and search results, and to share search strategies are described below.

#### *Collaborative Patent Classification (CPC)*

46. The CPC was initiated as a joint partnership between the USPTO and the EPO which agreed to harmonize their existing classification systems (ECLA and USPC, respectively) and migrate towards a common classification scheme. It is expected that this project will result in a more effective search process for all offices taking part.

#### *Common Citation Document (CCD)*

47. CCD aims to provide single point access to up-to-date citation data relating to the patent applications of the IP5 Offices. It consolidates the prior art cited by all participating offices for the family members of a patent application, thus enabling the search results produced by several offices for the same invention to be visualized on a single page.

## **CHALLENGES AND INITIATIVES SUPPORTING THE WORKSHARING ENVIRONMENT**

48. The benefits of using external search and examination reports and work sharing programs have been underlined in the submissions of many Member States.<sup>40</sup> Some of those submissions have also indicated the challenges related to such processes.

49. Understanding and accommodating different laws and practices: In general, different substantive standards employed by offices and understanding those differences were considered as one of the hindrances in effective use of foreign search and examination work. In particular, divergence of office practices and different claim interpretation practices, including the assessment of amended claims, as well as different classification schemes employed by offices were said to complicate the reutilization of other offices' search and examination results.<sup>41</sup> In addition, search and examination reports may not be readily available for

<sup>40</sup> See, for example, the submissions of Australia, Hungary, Portugal, Spain, the United Kingdom, the United States of America and the EPO.

<sup>41</sup> See the submissions of Argentina, Hungary and the United States of America. The submission of the United States of America noted that, in relation to CS&E pilot program, differences between office procedures for analyzing claims directed to medical use or to methods of treatment affected the collaboration of participating offices, due to differences between offices on what is considered patentable subject matter.

subsequent use by other offices due to differences in patent prosecution and examination procedures in various offices.<sup>42</sup>

50. Confidential nature of applications: Another legal obstacle for sharing search and examination results is that patent laws of some countries may prohibit their offices to share the details of the examination with other offices if the examination was carried out before the publication of an application.

51. Different languages: For some, the language barrier constituted the main challenge to the use of foreign search and examination work, as offices normally produce their documentation in their native language, making it difficult or impossible for examiners in other offices to use such documents.<sup>43</sup>

52. To overcome those challenges, understanding the differences in laws and office procedures through examiner exchange programs was stated to be one element that leads to successful work sharing.<sup>44</sup> With an aim to increase such understanding, various trainings and examiner exchange programs have been undertaken in the frameworks of some projects described above. In addition, one submission suggested that harmonization of all the legislations could contribute to effective work sharing.<sup>45</sup>

53. There was a suggestion that the prosecution history of patent application be made publicly available by offices through online databases, so that patent examiners at other offices could have easy access to search and examination results with respect to patent applications belonging to the same family.<sup>46</sup> Various projects, as described above, have been undertaken whereby the office of the first filing prioritizes the examination of applications used as a basis for filing abroad and makes those reports available to other participating offices as soon as possible.<sup>47</sup>

54. Concerning laws which prohibit the office to share the details of the examination with other offices, some patent offices, where such rules exist, have been participating in work sharing programs on a confidential basis with an understanding that the results will not become publicly available through the other patent offices. In the United Kingdom, the IP Bill is currently before Parliament, setting out legislation which would extend the IP Office's scope for confidentially sharing pre-publication work with other IP offices.

55. In relation to the language barrier, some Member States suggested that efforts to facilitate the use of foreign search and examination work focus, *inter alia*, on improvements in machine translation tools.<sup>48</sup>

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<sup>42</sup> For example, not all offices make their work products available for other offices to consult. Furthermore, many patent systems allow applicants to defer patent examination for some time. In some countries, this period may run up to several years after filing.

<sup>43</sup> See the submissions of Hungary, Portugal, the Republic of Moldova and Spain.

<sup>44</sup> See the submission of the United States of America.

<sup>45</sup> However, it was also stated that such harmonization would be difficult to achieve in the near future. See the submission of Argentina.

<sup>46</sup> See, for example, the submission of Spain. The OEPM publishes such information on its website at the following address: <http://archivoenlinea.oepm.es/register/regviewer>.

<sup>47</sup> In this regard, the EPO reported that it set high priority on its first filings which were available for work sharing before the end of the priority period, i.e., at nine months after the filing date of the application.

<sup>48</sup> See the submissions of Spain, Hungary and the Republic of Moldova. In the submission of Spain, it was noted that while rapid progress had been made in that field, machine translation tools that were available did not provide the desired quality.