

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Twenty-Second Session
Tokyo, February 4 to 6, 2015

COLLABORATIVE SEARCH AND EXAMINATION - THIRD PILOT

Document prepared by the European Patent Office

BACKGROUND AND INTRODUCTION

1. At its third session in June 2010, the PCT Working Group endorsed a series of recommendations to improve the functioning of the PCT as listed in document PCT/WG/4/3. The recommendation under paragraph 165(b) mentions trials of arrangements whereby examiners in Offices with complementary skills work together to establish a report. In that respect, the Korean Intellectual Property Office (KIPO), the United States Patent and Trademark Office (USPTO) and the European Patent Office (EPO) launched a first pilot project on collaborative search and examination under the PCT (CS&E) in May 2010. 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 PCT application with the aim of establishing a high quality international search report and written opinion. 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 / disadvantages from a qualitative point of view. The second pilot project of a larger scale built on the lessons learnt during the first pilot project in order to allow a quantitative assessment of the approach and a fine-tuning of and operational working model.
2. Both pilots were concluded with overall very positive outcome in terms of quality and efficiency for both the participating Offices and users whose applications were treated under the collaborative scheme.

EPO ASSESSMENT OF THE COLLABORATIVE SEARCH AND EXAMINATION CONCEPT

3. The overall success of both pilots led to a preliminary proposal by KIPO, presented during the twenty-first session of the Meeting of International Authorities in 2014, to include the collaborative search and examination in the PCT Regulations. During the discussion on the proposal, it was concluded that it was premature to include it in the PCT Regulations, as the two conducted pilots only tested the concept and did not establish any practical arrangements.

4. The EPO has conducted an in-depth and thorough assessment of the CS&E concept based on the results of the preceding two pilot phases. The aim of this assessment was two-fold:

- Evaluate the future of the CS&E approach and the possible need for a third pilot phase (third pilot).
- Determine its goals and methodology of the third phase to be implemented to ensure a right assessment.

5. The results of the EPO's assessment are as follows:

- Phase 3 seems necessary in light of two earlier pilot phases results and users' feedback; the concept should be further developed and tested before any decision can be taken regarding implementation.

6. The objectives of Phase 3 should be:

- Agree on common set of quality standards to be applied in the CS&E project (procedure and product): timeliness; search standards; classification; written opinion of the International Searching Authority (WO-ISA) standards.
- Check users' adherence and interest for the CS&E product (*inter alia* is there a market for a high-end and more expensive product?).
- Sound cost-benefit analysis: operational impact; examiner's time investment; assessment of potential savings when considering entry into national/regional phase.

ROADMAP

7. The EPO started preparations to launch a third phase of the CS&E pilot aimed at achieving the basic objectives set above.

8. The EPO expects that such a third pilot should be the final decisive milestone in the collaborative concept. Based on its outcomes a conclusive recommendation on the future of the scheme should be proposed.

9. A recommendation can only be made based on collective participating Offices' experiences.

CS&E PHASE 3 DESIGN

10. In order to make the phase 3 as realistic as possible, the EPO proposes the following principles to be applied in the third pilot to the CS&E partners.

The access should be limited to selected applicants ("limited access model")

11. Each participating Office would offer to selected applicants to process a limited number of PCT applications under the collaborative scheme. The applications (e.g. 200 PCT files per Office) would be selected by the applicants ("applicant driven"), but should be second filings. Each participating applicant will be able to file a limited number of CS&E applications (e.g.

20 PCT applications per applicant). Large companies are probably the most interested in the CS&E. If at least a part of the applicants that participated in the previous pilots would enroll for the third, it should be possible to gather their opinion on quality, completeness and timeliness aspects and their overall experience with this particular product compared to their normal PCT international search report and written opinion.

The applicants cannot choose the peer Offices contributing to the collaborative product

12. Applicants cannot single out any of the collaborative Offices. CS&E should be one product established by all participating Offices.

13. Each participating Office should process as International Searching Authority (primary Office) the same number of applications.

14. The CS&E workload must be evenly distributed between participating Offices. The processing of CS&E products cannot be subcontracted and must be performed by examiners of the collaborating Offices.

Third phase duration

15. The third phase of the pilot would need to cover a relatively long period to evaluate, in particular, the effect on the timeliness, the regional-phase entry rate, and the quality of CS&E applications entering the regional/national phase.

16. The suggested length of this pilot would thus be of around three years divided as follows:

- **6 months** for registration of pilot users and administrative preparations including development/purchase of a collaboration tool, agreement on operational aspects, key indicators, data exchange and agreeing of a Memorandum of Understanding to ensure an efficient and transparent governance.
- **9 months** for the search process.
- **15 months** to cover the rest of the international phase.
- **6 months** following the entry into the national/regional phase.

17. It is suggested that participating Offices process first actions in national phases in an accelerated manner (similar to Patent Prosecution Highway applications).

KEY INDICATORS

18. It is proposed that Offices agree on specific indicators related to a CS&E product. These should include quality and timeliness indicators.

CS&E OPERATIONAL ASPECTS

19. Before launching the third pilot, the participating Offices should agree on operational aspects of a potential CS&E product.

Fees

20. Since the CS&E is pivoting around the PCT international search procedure, only the PCT Chapter I fee is affected. It is assumed that other fees will remain unchanged.

21. Based on the result of the two pilots and users' feedback, it is assumed that a CS&E search report would have a similar value to a combination of all individual search reports issued by the participating Offices.

22. Therefore, the proposed CS&E fee would be the aggregated PCT Chapter I fees of the participating Offices topped with a small administrative fee (e.g. 10 per cent covering the administration of the CS&E scheme). A mechanism for balancing the inter-Office CS&E fees will have to be established.

Communication to the Users

23. In order to have a manageable project, a third pilot has to be limited to a restricted group of applicants who would be charged with the standard fee for a PCT Chapter I Search at the corresponding International Searching Authority. However, this means that as applicants will not be charged with the expected higher fee for a CS&E product, it will not be possible to evaluate reliably within the framework of the third pilot whether users would opt for a future CS&E product. To mitigate this uncertainty, it is strongly advised to trigger feedback from pilot users to assess whether they would consider making use of the system in the future, should it become operational. This means that the relevant information, including a detailed description of the service, the expected level of CS&E fee and possible advantages (reductions) in national/regional phase needs to be disclosed publicly.

Collaborative Environment

24. The first and second pilots highlighted a need of collaborative environment, where examiners from participating Offices could perform the work.

25. A collaboration tool will be made available before the third pilot is launched. The collaboration tool must support the management, operation and collaboration evaluation to ensure timely operation of CS&E and automated data collection for a pilot evaluation.

26. In view of the broader scale of the third pilot, a manual administration would not be manageable.

SUGGESTED TIMELINE

27. It is proposed to start the third pilot (open to IP5 Offices) in the course of 2015. The first half of the year would serve for administrative preparations, signing necessary agreements and setting up a procedural and technical framework supporting the third pilot.

28. The Meeting is invited to note the contents of the present document.

[End of document]