

## **Patent Cooperation Treaty (PCT) Working Group**

**Twelfth Session  
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### **PCT COLLABORATIVE SEARCH AND EXAMINATION: STATUS REPORT**

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#### **SUMMARY**

1. This document reports on the progress of the third pilot project on collaborative search and examination under the PCT (“CS&E”) among the IP5 Offices (the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the National Intellectual Property Administration of the People’s Republic of China (CNIPA) and the United States Patent and Trademark Office (USPTO)).

#### **BACKGROUND**

2. 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 International Authorities with complementary skills work together to establish a report.

3. With this aim, KIPO, the USPTO and the EPO launched two pilot projects on collaborative search and examination under the PCT (CS&E) in 2010 and 2012. Both pilots concluded with an 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 (see documents PCT/MIA/18/7, PCT/MIA/20/4 and PCT/MIA/24/3).

## FRAMEWORK

4. On June 2, 2016, the IP5 Heads endorsed the “IP5 Cooperation Framework on Collaborative Search and Examination under the PCT”, which is a document setting the underlying principles and main features of the third pilot. The Collaborative Search and Examination Pilot Group (“CS&E Pilot Group”) established on the basis of that document is in charge of developing and monitoring this project.
5. The main features of this pilot project are in particular:
  - an applicant-driven approach: the applications processed during this pilot are selected by applicants;
  - a balanced workload distribution: all collaborating International Authorities contribute to the establishment of each CS&E work product; each Office will process approximately 100 international applications in its role as “main International Searching Authority” and approximately 400 international applications in its role as “peer International Searching Authority” over two years;
  - a common set of quality and operational standards is applied by all collaborating International Authorities when processing PCT applications;
  - the use of a “collaborative tool”, i.e. an IT infrastructure allowing exchanges among Offices in a secure environment and automated data collection; and
  - the possibility for the collaborating International Authorities to accept, at some point in time during the pilot, also applications filed in a language other than English.
6. In this pilot project, the examiner from the Office acting as competent International Searching Authority under PCT Rule 35 for a given international application (“the main examiner”) conducts the search and examination as for any other international application and establishes a provisional international search report and written opinion. These provisional work products are then transmitted to peer examiners from the other participating Offices in their capacity as International Searching Authorities. Peer examiners provide the main examiner with their contributions, taking into consideration the provisional international search report and written opinion. The final international search report and written opinion are established by the main examiner after consideration of the contributions from the peer examiners. Further details on the concept and framework of this CS&E pilot project and the requirements for participation are available on the respective IP5 Offices’ websites.

## STATE OF PLAY

7. This pilot project is divided in two phases: a preparatory phase and an operational phase. The preparatory phase, which started on June 2, 2016, was dedicated to the administrative and practical preparations required to ensure a smooth functioning of the pilot. The operational phase started on July 1, 2018 and will run until June 1, 2021. It is dedicated to the processing of applications under the collaborative scheme, the monitoring of applications for evaluation purposes and the assessment of the outcome of the pilot.
8. The operational phase is running very smoothly in spite of the operational challenges faced by the various participating Offices due in particular to manual work-arounds to process the files and the peer contributions. Hence, in February 2019, the CS&E Pilot Group decided that its next session will be held in autumn 2019, i.e. around one year after the previous session. Figures giving a general overview of the progress of this pilot project on May 6, 2019, may be found in the table below. These figures show that the total number of the applications accepted until then by all Offices is close to the global yearly target of 250 applications. Provisional international search reports, peer contributions and final international search reports

have been established for most of these applications. In this context, it is underlined that the collaborative tool provided and maintained by the International Bureau proved to be very practical and effective. Moreover, the deadlines set within the framework of this pilot for the establishment of provisional international search reports and peer contributions (i.e. respectively eight weeks from the receipt of the search copy by the main International Searching Authority and four weeks from the transmission of the provisional work products) have so far almost always been met. The deadline set within the framework of this pilot for the establishment of final international search reports (i.e. four weeks from the expiration of the peer contribution period or from the receipt of all peer contributions, whichever event occurs first) has been met in less than half of all files dealt with so far. A possible explanation for the latter figure is that the establishment of the final work products is a new demanding task for examiners. Indeed, it requires the assessment by the main examiner of four peer contributions.

Total number of accepted applications	Total number of provisional search reports	Total number of peer contributions	Total number of final search reports
216	203	777	185

9. In general, applicants' interest for this pilot project is high. Indeed, most Offices have reached their yearly quota for English applications and some Offices experienced a strong response from applicants in the first months of the operational phase. For instance, the EPO as main International Searching Authority already reached its quota for applications in English for the first year of the operational phase in September 2018 and the CNIPA in November 2018. The USPTO and KIPO reached their full quotas in January 2019 and in April 2019, respectively. Applicants' interest is also testified by the recurrent mentioning of this topic in conferences and blogs.

10. This pilot project has been extended in the course of 2019 to other languages than English. More specifically, the EPO, the CNIPA and the JPO decided to accept international applications filed respectively in French or German as of January 1, 2019, in Chinese as of March 1, 2019, and in Japanese as of April 1, 2019. Further details in this regard may be found on the respective Offices' websites. Moreover, KIPO is also considering accepting files in Korean in the near future.

11. Finally, it is recalled that all IP5 Offices will start accepting again applications as of the beginning of the second year of the operational phase, i.e. July 1, 2019.

*12. The Working Group is invited to take note of the contents of the present document.*

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