

Patent Cooperation Treaty (PCT) Working Group

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IP5 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 China National Intellectual Property Administration (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 up to 100 international applications in its role as “main International Searching Authority” and up to 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”) conducted the search and examination as for any other international application and established a provisional international search report and written opinion. These provisional work products were then transmitted to peer examiners from the other participating Offices in their capacity as International Searching Authorities. Peer examiners provided 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 were established by the main examiner after consideration of the contributions from the peer examiners.

STATE OF PLAY

7. This pilot project is divided into three phases: a preparatory phase, an operational phase and an evaluation phase.

8. The operational phase – dedicated to the processing of applications under the collaborative scheme – ran smoothly from July 1, 2018 to June 30, 2020, in spite of the operational challenges resulting from the need of manual workarounds to process CS&E files and especially peer contributions. The USPTO and KIPO reached the ceiling of 100 applications in January 2020 and the EPO reached it in April 2020. On June 30, 2020, the JPO and CNIPA stopped accepting requests to participate in the pilot. Applications in all six official languages of the participating ISAs have been accepted and successfully processed in the pilot. A total of 468 applications have been accepted into the pilot and the same number of international search reports have been established in collaborative mode.

9. The final operational CS&E results are summarized in the table below:

Accepted applications	CS&E search reports per ISA	Receiving Offices	Languages	Technological fields
468	CN: 93 JP: 75 KR: 100 US: 100 EP: 100	CN – 92 EP – 32 IB – 42 JP – 60 KR – 26 US – 216	de – 13 en – 413 fr – 2 ja – 20 ko – 3 zh – 17	A – 87 B – 53 C – 62 D – 6 E – 10 F – 14 G – 145 H – 91

10. On July 1, 2020, the pilot entered the evaluation phase during which the IP5 Offices are assessing and reporting on the results gathered during the international phase as well as the entry of international applications processed collaboratively into their respective national or regional phases, based on the agreed set of quality and operational indicators. So far, the data collected during the international phase reveals that in comparison to the provisional ISRs drafted by the main ISA:

- 70 per cent of the final ISRs established in collaborative mode by the IP5 Offices contained new citations;
- 53 per cent of the final ISRs contained additional XYE citations;
- On average, the number of citations increased from 6.1 to 8.1 in the final ISRs;
- While 12.8 per cent of provisional ISRs contained only A-citations, the percentage is 4 per cent lower in the final ISRs.

11. These figures alone are, of course, to be taken with caution, as the addition of new citations in an ISR is, as such, not necessarily an indication of enhanced quality. The assessment of a number of other indicators will help shedding more light on the business case.

12. In 2021, the International Bureau conducted a survey of pilot participants using a questionnaire agreed upon by the IP5 Offices. 88 per cent of respondents rated CS&E as beneficial to highly beneficial, providing more legal certainty to enter into the respective national/regional phases. However, of those respondents who indicated that they either would or would not be ready to pay a CS&E fee corresponding to the aggregated amount of all international search fees charged by each IP5 office acting as ISA for such a product, those who indicated that they likely would not pay such a fee outnumbered those who indicated they would by a margin of two to one. It is also important to bear in mind that many CS&E applications are still being processed in the various national/regional phases.

13. Further feedback from pilot participants and user groups could also be gathered by participating Offices. The Pilot Group is also looking into the various financial scenarios that could sustain the CS&E concept in the PCT framework. It appears that the WIPO Fee Transfer Service would be the proper tool to use by participating ISAs but there are still various options possible regarding the determination of the amount of the CS&E fee.

14. The IP5 Cooperation Framework on Collaborative Search and Examination under the PCT initially foresaw that the pilot would have a maximum duration of five years, i.e. with the

evaluation phase ending in June 2021. A first one-year extension of the evaluation phase was decided by the IP5 Heads of Office in 2020. However, most CS&E files will not have received a final action at the IP5 Offices by June 2022 as a majority of applications are entering into the national/regional phases in the course of 2021. For this reason, based on a recommendation from the IP5 CS&E Pilot Group, the IP5 Heads of Office have endorsed an additional one-year extension of the pilot. The pilot will therefore conclude in June 2023 with the presentation of a final assessment report to the IP5 Heads of Office concerning the proof of concept and including recommendations regarding the implementation of the new concept in the PCT system from a legal, financial and operational point of view.

15. The Working Group is invited to note the contents of this document.

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