

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

### **Fourth Session June 6 to 10, 2011, Geneva**

#### **Collaborative Search and Examination Pilot Project: Status Report**

*Report prepared by the European Patent Office*

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## 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, KIPO, the USPTO and the EPO launched a first pilot project on collaborative search and examination under the PCT (CS&E) in May 2010. The objective of the project is 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.
2. At the 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 (document PCT/WG/4/2). This document provides an updated view of the pilot that started on 1 June 2011.
3. 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. This *second pilot project of a larger scale* will 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 and operational working model.

## BUILDING ON THE FIRST PILOT PROJECT

4. The main conclusions for the first pilot project were:
  - *CS&E is a realistic concept.*
  - The collaboration between examiners brings a clear added-value regarding the *quality* of the ISR and WO-ISA. As a consequence, legal certainty increases.
  - *No major additional time investment* would be required in regional/national phase as a result of the collaboration in the international phase.
5. Regarding the *methodology*, these were the lessons learnt during the first pilot project:
  - The participating offices should have flexibility in the selection of published or unpublished applications. The use of published applications reduces the administrative burden and avoids delays in getting applicants' consent.
  - Selection of technical fields and applications can be improved if first examiners proposes several files to the peer examiners that can then select those applications for which they feel technically skilled and that do not present major examination difficulties, i.e. patentability issues where the practise differ between offices. In this way the selected applications will have been agreed by all examiners.
  - An IT tool must be used to facilitate the collaboration between examiners. This tool will offer the appropriate level of confidentiality for the information exchanged between the offices.
  - Examiners should be provided with a standard template for the Record of Search Strategy (RoSS) and feedback form, *which are to be used consistently*. The RoSS template needs to be field-specific and the fields "what", "where" and "how" need to be more precisely standardised.

- The final ISR will be as complete as possible by including all citations provided by the peer examiners. The WO-ISA will also be as complete as possible by including the argumentations provided by the peer examiner whenever these are complementary and not contradictory. In the case of the WO-ISA, the argumentations are to be preceded by a standard sentence to help applicants understand these additional argumentations where appropriate.
- The offices will consider sending applicants a letter to inform whenever a specific file is treated under the framework of the CS&E.
- Efficiency in the interactions will be improved by defining time limits for replying to counterparts when an answer is expected.

## **OBJECTIVES FOR THE SECOND PILOT PROJECT**

6. The objectives of the CS&E pilot are:
  - (i) To define the conditions under which examiners of different ISAs in different regions can co-produce the ISR and the WO-ISA for PCT applications. This includes testing the fined-tuned methodology to identify how collaboration could be implemented in an operational environment in a wider deployment within the offices.
  - (ii) To evaluate from a *qualitative* and *quantitative* point of view the benefits and disadvantages of the collaborative approach in terms of *quality* and *efficiency*. The approach towards measuring the quality and efficiency effects of collaborating in the production of the ISR and WO-ISA is explained in annex II.

## **FRAMEWORK OF THE CS&E PILOT**

7. The CS&E pilot project would ideally operate under the IP5 general framework and consequently all IP5 offices are invited to participate in the pilot. The offices that participated in the first pilot project, the USPTO, KIPO and EPO have gained important experience that will be very useful for improving the methodology in this second pilot. The KIPO, USPTO and EPO have confirmed their participation in the second pilot project.
8. In order to keep the momentum gained with the completion of the first pilot and to meet the expectations about the potential of the CS&E, the participating offices have agreed to start the second pilot on the *1st June 2011*. This new pilot will have duration of *1 year* and will include two phases with a pilot review after 6 months.

## **PILOT DESIGN**

9. The pilot is designed for testing the concept of collaborative search and examination according to the objectives set forth in section 3 above. Arrangements for testing other objectives, such as improvement of the ISA timeliness or mastering PCT workloads should be kept outside of the scope of the CS&E pilot.
10. A balance should be found between leaving some discretion to the examiners involved in the pilot for finding the most efficient *modus operandi* and the need for guidance in order to ensure that the pilot operates in a harmonised way among the different offices and examiners in different technical fields. Therefore, the pilot methodology will be based on the following:

### Legal framework

11. The legal framework is the PCT and all its related provisions. Namely, all participating offices will continue to act as ISA under the relevant PCT provisions and to endorse the responsibility for the ISR and WOISA produced under the pilot for their own PCT applications treated in the pilot.

### Pilot scale

12. The proposed scale of the second pilot project is based on each participating office treating around 64-80 applications as ISA. The *total number of PCT applications treated within the pilot will be between 190-240 applications*. With such scale it is believed that the assessment of quality and efficiency from a quantitative perspective according to the objectives defined will be more representative.
13. The second pilot will be split in two parts: A first part will be conducted from June to November with 4 PCT applications per examiner acting as first examiner. The second half of phase 2 will be conducted from February to July 2012. In this second half at least the same amount of files will be treated but the agreement foresees the possibility to increase the number of files.
14. Each office will participate in the pilot with *8 examiners* in different technical areas. Each examiner, as explained above, will treat around 8-10 applications acting as first examiner and 16-20 applications as peer examiner over the duration of the pilot. The group of 8 examiners will include the 6 examiners from the first pilot project in order to build on their experience.

### Selection of PCT applications for the pilot

15. The CS&E pilot can be operated on the basis of published or unpublished applications. The participating offices will select *published applications whenever possible*. However, each office will decide on the type of each application it prefers to include in the pilot according to its own constraints.
16. Whenever an office selects for the pilot PCT unpublished applications, examiners will exchange confidential information under the meaning of Article 30(1)(a) PCT. This means that prior to the exchange of any detail about those applications the office acting as ISA will seek the respective applicants' authorisation.
17. The selection of *all* the applications for this pilot project at the beginning is difficult. Therefore, it is proposed that the first examiners *select the applications progressively over the whole duration of the pilot*. Each first examiner could set his / her monthly target in order to reach by the end of the pilot the number of applications defined as his / her objective, e.g. 8-10 applications as first examiner and 16-20 as peer examiner. The examiners acting as first examiners would define their own planning for the project while making sure that they agree with the peers on a regular basis on a number of files so that at the end of the pilot their objective in terms of number of treated applications is reached.
18. In addition, in order to ensure that applications treated are in the field of all the examiners involved, i.e. for first examiner and peer examiners, the first examiner will propose on a regular basis a list of *several applications* (for example 1-5 applications) to the peers. The peers would indicate which of these proposed applications are acceptable to them. The first examiner would then use those applications that are acceptable to all the peers for the project.

19. The examiners would identify these PCT applications as soon as possible by looking at the publication date. This date should be around the time when the examiner plans to start the discussion about it with the peer examiners. As an example, an examiner could look at the beginning of May 2011 for applications that are to be published in May-July and then send a proposal to the peers with 1-5 applications to be selected during the month of May.

#### **Consultation between examiners**

20. The *main objective of the discussions* between the examiners is not to agree on all the discussion points but to find the areas where there are agreements and disagreements (due for example to differences in practise). This adds value to the final product by leading to more complete products and/or higher confidence in the products by the examiners.
21. For a specific application the consultation between the examiners of the offices should be triggered by the first examiner by sending the results of the initial search and examination, i.e. provisional ISR and the WOISA accompanied by the record of search strategy (RoSS) followed.
22. An IT tool will be available for the examiners participating in this pilot. The tool will facilitate the administrative aspects of the pilot such as managing the status of the communication between examiners, setting time limits, maintaining the repository of the information, will including messaging functionalities, etc. It will also ensure the appropriate level of confidentiality when dealing with unpublished applications.
23. Each time that an examiner sends information to one or more counterparts and, when an answer is to be expected, a *time limit of 1 week* is set from the time the information is sent. The one or more counterparts need to provide an answer before the time limit in order to ensure the interaction. In case of not being able to respect the time limit, a brief statement indicating when the proper answer can be expected is required.
24. *The first examiners should strive to complete each application by finalising the final ISR and WOISA at the latest one month after having started it.*
25. During the consultation the examiners should focus on the assessment relating to part V of the WOISA and on major clarity issues.

#### **Information to the applicants**

26. Applicants whose applications are treated in the framework of the second pilot project will be informed about this fact.
27. In the case of unpublished applications, the applicant will be asked for consent in advance. The office that is responsible for the application will be responsible for getting the consent before sharing the content with the peer examiners in the other offices. Each office will determine the best way to request this consent.
28. Whenever an examiner completes the final ISR and WOISA, these products will be sent to the applicants accompanied by a standard letter that informs about the application being part of the CS&E pilot.

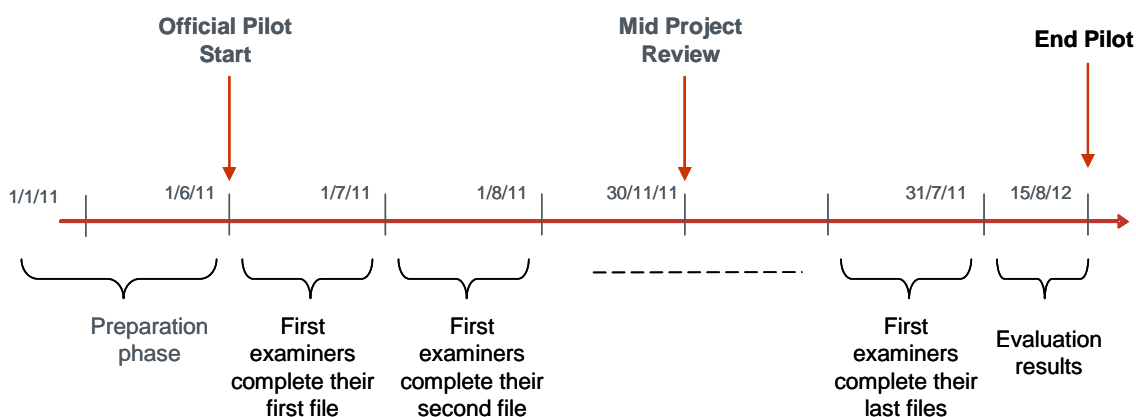
#### **Briefing of participants**

29. Examiners selected by the participating offices will be briefed about the pilot project: objectives, methodology, timeline, etc. The briefing of the examiners should to a large extent be the same in all the participating offices to ensure a similar understanding by the examiners.

30. A standard presentation will be prepared by the participating offices to be used as basic briefing material. The offices could of course build on the basic material to provide additional details to the examiners.

### Pilot outline plan

31. The following diagram shows the outline plan for the second pilot project. The most relevant milestones in the second pilot project would be:
- *Preparation phase* (Dec 2010 and May 2011): Selection of technical fields, examiners and a few number of applications so that the examiners can start the work in the beginning of February.
  - *Launch of the pilot* (1st June 2011): Examiners start the collaboration.
  - *First half of the pilot* (June 2011 - November 2011):
  - *Mid Project Review* (November 2011): The participating offices evaluate the progress in the pilot: Issues, number of files treated, possible improvements.
  - *Second half of the pilot* (February 2012 - July 2012):
  - *Evaluation of results* (August 2012): The offices evaluate the results and produce a final report.
  - *End Pilot* (September 2012): Submission of the report to the next IP5 Deputy Heads meeting.



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

[Annex I follows]

## ANNEX I

### PILOT METHODOLOGY

Examiners participating in this pilot should bear in mind the following methodology:

- (a) The examiner of the office acting as ISA for a given PCT application (called *first examiner*) analyses the application in order to understand it. The first examiner will work on this application as for any other PCT application by preparing a search strategy (what to search, where to search and how to search) and conducting the search and examination accordingly. As a result, the first examiner will establish a *provisional ISR and WO-ISA*. This provisional work should then be transmitted to the peer examiners in the other participating offices (called *peers*). In addition to the provisional ISR and WO-ISA, the first examiner should make available to the peers his/her *provisional RoSS*. The first examiner will use the standard template for the RoSS (Record of Search Strategy) adapted to the needs of the corresponding technical field.

The delivery of the provisional ISR and WO-ISA triggers a *time limit for the peer examiners of 1 week* to provide feedback. The peers are expected to *comment on or complement* as appropriate the provisional work of the first examiner within one week. The comments by the peers could be related to the citations, the WO-ISA or the search strategy and will be sent using the standard template for the feedback form. Complementing the search would mean providing additional search results or examination findings to the first examiner. If a peer examiner decides to complement the search the information about the *RoSS for the additional search* will be included in the feedback form.

The time needed for the peers' contribution will be assessed by each Office under the assumption that the contribution should provide added value to the work of the first examiner. It is therefore expected that the *feedback* will be in general *more substantial than a simple statement indicating that there are no comments*.

There could be more than one exchange of information between the first examiner and any of the peer examiners. For any exchange a time limit of 1 week also applies to the reception of feedback, either from the peer examiner or the first examiner.

- (b) After reception of the feedback from the peer examiners the first examiner will proceed with the establishment of a *final ISR and WO-ISA*. This should be done not later than one week after reception of the last feedback. The final ISR and WO-ISA will be transmitted to the applicant on behalf of the ISA accompanied by a standard letter that informs that the application has been treated under the CS&E pilot.

The final ISR and WO-ISA (consolidated ISR and WO-ISA) will be the result of complementing the provisional ISR WO-ISA (the one drafted by the first examiner before having any feedback) with the comments received from the peers. A *consolidated RoSS* (provisional search strategy drafted by the first examiner + feedback from the peers) will be drafted by the first examiner and kept in the file.

The first examiner will make available to the peers a copy of the final ISR and WO-ISA as well as the consolidated search strategy when these are sent to the applicant.

- (c) The final ISR will be as complete as possible by including all citations, i.e. those found by the first examiner and those provided by the peer examiners. The WO-ISA will also be as complete as possible by including the argumentations provided by the peer examiners whenever these are complementary and not contradictory. In the case of the WO-ISA, the argumentations are to be preceded by a standard sentence to help applicants understand these additional argumentations where appropriate.

[Annex II follows]



## ANNEX II

### PILOT EVALUATION

This pilot should allow the participating Offices to evaluate the following aspects listed below. The evaluation will take into account the input from the examiners as well as the input from the applicants.

*Examiners:* The examiners will be asked to fill in a form for each completed application, either as first examiner or as peer examiner. This input from the examiners will allow the offices to assess the following aspects:

- *Quality:* The quality of the consolidated ISR and WO-ISA will be compared to the quality of the provisional ISR and WO-ISA (the results of the first examiner as sent to the peers). This will be assessed by the examiners and the exact methodology is to be agreed with the participating offices.
- *Efficiency:* The assumption on which the pilot is based is that, when examiners work together for producing the consolidated ISR and WO-ISA, they would naturally reuse this international work to a larger extent when treating the corresponding applications after entry into the national/regional phase than it is the case today.

To measure the efficiency, the first examiners and peers will indicate the time invested in each application. The times will be estimated as "additional time" to the standard time invested in a standard search for the first and peer examiners.

Ideally, when the application enters the national/regional phase, the time investment by the peers for this phase will be measured. However, as this will only be possible after the pilot has been completed a provisional assessment will be made on the potential savings that the examiners can expect for the entry in the national/regional phase. The final objective is to compare the total time invested by the first examiner and the peers using a CS&E model (time in international phase and time in the national/regional phase) and compare it to the time under the normal PCT path (by a first examiner) including the national/regional phases (by the peers).

Two aspects will be assessed: Firstly that the results of this pilot confirm the conclusions from the first pilot project, particularly that no major investment would be needed by the examiners in national / regional phase). And secondly, a measurement of the overall additional time required when a file is treated under CS&E including the time investments in PCT and national / regional phases.

Benefit profiles for quality and efficiency will be defined and will include parameters and evaluation matrix for proper assessment of these aspects. This will be prepared before the official start of the second pilot.

*Applicants:* The quality will be assessed by means of an applicant survey to be sent together with the letter that informs applicants that a specific file is treated in the framework of the CS&E.

[End of Annex II and of document]