

Standing Committee on the Law of Patents

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PROPOSAL BY THE DELEGATION OF THE UNITED STATES OF AMERICA ON THE STUDY OF WORKSHARING

Document prepared by the Secretariat

1. The Annex to this document contains a proposal submitted by the Delegation of the United States of America on the study of worksharing, for consideration under item 6 of the draft agenda: Quality of Patents, including Opposition Systems.

2. *The members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

PROPOSAL ON THE STUDY OF WORKSHARING

1. Over the past decades the work of patent offices has become more demanding in many ways. The number of patent applications filed has increased, reflecting the importance of intellectual property in the global economy. Related patent applications are routinely filed in multiple jurisdictions by applicants seeking to protect their innovations. Additionally, technology has become increasingly complex, requiring specialized knowledge to understand and assess the subject matter of many patent applications.

2. Over the same period there has been an increase in the volume of available knowledge, reflected in the number of patents and other publications defining the technology state of the art. This knowledge too often is difficult for examiners to find, because it is in unfamiliar languages, it is found only in foreign collections, or because of other limitations to the information available to individual patent offices.

3. Faced with limited resources, patent offices around the world have developed tools to address these problems while maintaining a high quality product. Possibly the most significant tool is worksharing. At a basic level, worksharing is a tool for patent offices to limit the amount of repeated work that they carry out by reusing, to the extent possible, the work previously generated in related patent applications by other offices. After a first office carries out a search and examination of a patent application, those results are used by other offices to facilitate their own later search / examination of a related application.

4. The benefits of worksharing can be especially significant when the offices involved have different capabilities and strengths. For example, offices which operate in different languages or have special expertise in different technical fields can help each other conduct a better search and examination. In many cases, searching the prior art relevant to certain patent applications may be simpler and more efficient for some offices than it is for others. In part this is because access to national collections of prior art, availability of patent examiners that can understand certain languages, and availability of examiners having specialized technical expertise may not be uniform across all offices.

5. Even large offices like the USPTO can have difficulties in using prior art that is in a foreign language and/or which is contained in national collections of other offices. Developing all of these capabilities in every office may be difficult or impossible and prohibitively costly.

6. Worksharing is not a new concept. Even before Offices began to establish formal worksharing projects, patent examiners at times required "an applicant for a patent to provide information concerning the applicant's corresponding foreign applications and grants" (see, for example, Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), Article 29(b)). Examiners also sometimes took advantage of the search results of earlier Patent Cooperation Treaty applications in conducting their own search and examination.

7. To promote a discussion of worksharing in the SCP, Denmark submitted a proposal on this agenda topic in document SCP/17/7. That proposal was for a questionnaire asking member states to share their experiences on a) how national offices use foreign search and examination work, and b) the benefits and challenges of using such foreign work, and how potential obstacles could be overcome.

8. Worksharing was discussed at the 21st meeting of the SCP held November 3-7 2014, as part of a sharing session regarding "experiences on international work sharing and collaboration." During the session, several IP offices discussed their use of worksharing in daily operations. Many offices stated that it was an integral part of their work, and that in

many cases it was a necessary process without which their ability to conduct quality searches and examinations would be significantly hampered.

9. For example, the Australian delegation stated that if IP Australia were not carrying out worksharing collaboration with other offices but rather conducted a full international search on every application that came through its office, it would need to hire a significantly large number of patent examiners, resulting in an exorbitantly high cost for applicants. The Delegation noted further that worksharing allowed the examiners of IP Australia to focus their efforts on complex cases first filed in the Australian office.

10. Several delegations from offices in developing as well as developed countries also took the floor to discuss worksharing. Some delegations indicated that they took advantage of the work product of other offices in conducting searches and examinations. Other delegations indicated that they had only a small number of examiners, and therefore taking advantage of the work product of other offices was useful.

11. We believe that worksharing and international cooperation can be powerful tools that contribute to making the work of patent offices more efficient and effective, and can be instrumental in helping offices to efficiently grant high quality patents. Together with capacity building, training and technical assistance, worksharing can be an effective way for all offices to improve their operation. As a result, we propose the following program:

HOW WORKSHARING CAN AMPLIFY THE CAPABILITIES OF PATENT OFFICES

12. To better understand the potential of worksharing on the operation of patent offices, we propose that the SCP direct the Secretariat to conduct a study of whether, under what circumstances and how the implementation of worksharing and international cooperation programs between patent offices could assist the collaborating offices in conducting more efficient searches and examinations, and in granting high quality patents by leveraging the work carried out in other offices.

13. For this study the Secretariat would collect information from the member states on their experience with worksharing programs. The Secretariat would also collect information on how worksharing has been applied between offices, and how it has impacted the search and examination of patent applications in those offices. The focus would be, for example, on how limited capabilities of an office can be amplified through the use of worksharing.

14. The study we propose to be carried out by the SCP Secretariat would also address the tools that have been used by offices to share information, such as for example WIPO CASE, the Global Dossier and other electronic dossier systems, and what shortcomings and benefits the offices have encountered in using those tools. The study would also investigate what type of work products shared between the offices have been found to be useful by examiners, and how to best share such work products. When the completed study is presented, we request that these tools be demonstrated, so that attendees of the SCP can better understand what is involved in worksharing.

SHARING EXAMINER SEARCH STRATEGIES

15. When performing automated searches of the prior art, examiners prepare a set of search queries to discover the most relevant prior art. The search terms and related logic used are generally preserved in the application file. It would be beneficial for national offices

to have access to the search logic used by offices that have already carried out the examination of related applications. **We propose that the SCP conduct a study/survey of the views of member states concerning sharing search strategies.**

PRIOR ART COLLECTIONS AVAILABILITY

16. Access to as much of the relevant prior art as practical is fundamental to carrying out a high quality search. Some prior art is only found in certain national collections which are not available to other offices. **We propose that the secretariat study the benefits and possible impediments to making national collections of prior art available to all the offices, for example through an IT portal.**

[End of Annex and of document]