



SCP/33/4
ORIGINAL: ENGLISH
DATE: NOVEMBER 22, 2021

Standing Committee on the Law of Patents

Thirty-Third Session
Geneva, December 6 to 9, 2021

**PROPOSAL BY THE DELEGATION OF THE UNITED STATES OF AMERICA FOR AN
INFORMATION EXCHANGE ON EXPEDITED PATENT EXAMINATION
MECHANISMS AT INTELLECTUAL PROPERTY OFFICES**

Document prepared by the Secretariat

1. The Annex to this document contains a proposal submitted by the Delegation of the United States of America for an information exchange on expedited patent examination mechanisms at intellectual property offices, for consideration by the Committee under item 7 of the revised 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 OF THE UNITED STATES OF AMERICA FOR AN INFORMATION EXCHANGE
ON EXPEDITED PATENT EXAMINATION MECHANISMS AT INTELLECTUAL PROPERTY
OFFICES

It has been understood for centuries that the patent system “adds the fuel of interest to the fire of genius, in the discovery and production of new and useful things.”¹ Stated in today’s fast moving, e-commerce and high technology world vernacular, patent protection is a key driver for encouraging innovators to rapidly convert their innovative ideas into products the public can use, benefit from and enjoy. Patent offices across the globe recognize the importance of timing in the grant of a patent. Patent examination timing is a key consideration of innovators when they bring products and services to market. This is apparent from various examination mechanisms that patent offices implement to provide users of the system some flexibility to pursue patent protection for their most critical and time sensitive innovations in the most expeditious fashion.

Patent pendency and the timely evaluations of patent applications is a consideration for many individual patent offices. Patent pendency can be affected by a variety of circumstances and attributes - examiner staffing, IT resources, filing volume, complexity of technology in applications, and length of applications, to name a few factors. Some factors may be beyond the control of the patent offices, such as a lack of resources or a sudden surge in applications. However, the impact of substantial backlogs and delayed grants of rights, regardless of the cause, still can lead to delays in commercialization of these technologies. The patent right can be a precursor to funding arrangements, business partnerships, and other commercialization activity that is needed to convert innovative ideas into cutting-edge products and services enjoyed by the public. On a larger scale, delay in granting patent rights can affect the flow of foreign investment into states or regions. Delays can also affect associated domestic innovation that may rely on this venture capital for research and development.

The world is looking more than ever to technology to address, mitigate and solve some of humanities most challenging issues, whether it be global climate change, the COVID-19 pandemic, or other yet to be encountered global emergencies. The public benefits from rapid deployment of these technologies. In recent history, offices of the global patent system have admirably responded by bringing to bear a variety of mechanisms to help ensure that development of technologies addressing key challenges are not hindered by delays at patent offices.

While reducing pendency of entire office application inventories to optimal timing is a desirable long term goal, it may be difficult to do in the short term or even over several years’ time. Thus, for years patent offices have employed expedited examination programs allowing qualifying patent applicants to have their patent applications examined either out of turn and/or in expedited fashion.

By way of example, on May 8, 2020, the United States Patent and Trademark Office (USPTO) instituted the COVID-19 Prioritized Examination Pilot Program. The expedited examination program was directed at patent applications covering technologies that can assist in addressing the global pandemic. The program helped facilitate fast entry into the marketplace of critical technologies to address the ongoing global crisis. Although the USPTO has one of the lower traditional pendency periods in the world (around 2 years from filing to final disposition), the expedited examination afforded by the pilot program allowed the Office to address an urgent situation for the benefit of the public.

¹ Abraham Lincoln, lecture on “Discoveries and Inventions”, April 6, 1858.

A broader list of exemplary grounds and rationales for expedited examination in patent offices across the globe include:

- applicant age or health;
- national security or emergency (e.g., COVID-19);
- targeted industries (e.g., green technologies, cancer treatments);
- additional surcharge for service;
- pending litigation; and
- enhanced efficiencies to offices from patent work-sharing arrangements.

While the public is aware of the existence of these expedited examination programs, that knowledge is typically limited to a small number of jurisdictions, and there is a lack of a single location for comprehensive information on all of the various programs that are available worldwide. A consolidated information document on current expedited examination programs at each of the patent offices of the world would be an invaluable resource to patent application filers and the public. Additionally, these expedited examination programs have evolved and have been improved and refined over time based on practical experiences in implementing them by the various patent offices. Sharing experiences and information on these programs will provide enhanced insights into these programs. It will also enhance the knowledge base for patent offices that are potentially considering implementation of, or that are currently implementing, some type of expedited examination program. The Standing Committee on the Law of Patents, with its global patent law and practice expertise, is the appropriate WIPO body for this discussion. Given the recent implementation of expedited examination programs aimed at addressing the COVID-19 pandemic in some patent offices, and other global challenges, the time is right to initiate discussion on this topic.

It is proposed, in particular, that the Committee explore the different approaches used by national and regional patent offices to expedite the examination of certain patent applications. We would be interested in hearing from Member States on their respective current practices for expedited examination and in relation to the following topics:

- (a) Qualifying grounds for expediting examination;
- (b) Internal institutional arrangements to facilitate expedited examinations;
- (c) Staffing and/or resource allocations;
- (d) Goals behind expedited examination programs;
- (e) Interplay between existing pendency and expedited examination goals;
- (f) Cooperation with other patent offices (if any); and
- (g) Any surcharges for expedited examination.

Similarly, we would also be interested to hear from observers, including user associations, on their experiences using existing expedited examination programs and the aspects of these programs that they find beneficial, as well as any challenges or potential improvements they might be able to identify.

We look forward to sharing our own experience in relation to expedited examination programs at the USPTO and to hear and learn about the experiences and practices of others in the Committee.

[End of Annex and of document]