



EXPEDITED EXAMINATION PROGRAMS OF IP OFFICES (SCP/35/6)

Standing Committee on the Law of Patents (SCP)
Thirty-fifth session (October 16 to 20, 2023)

Presentation by the Secretariat

SCP/35/6: Background

At SCP 34 (September 26 to 30, 2022), the Committee agreed that:

- The Secretariat would
 - prepare a document compiling information relating to the expedited examination programs of IPOs, including information on Prioritized Examination of COVID-19 related patent applications.
 - the document would include those expedited examination programs discussed during the SCP/34 as well as any additional contributions provided by Member States prior to SCP/35
- Document SCP/35/6 the compilation of the said information.

SCP/35/6: Expedited Examination programs

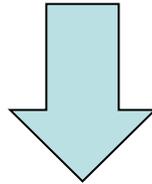
The document consists of the following sections:

- (i) Introduction
- (ii) Overview of the expedited examination programs;
- (iii) Expedited examination programs in national and regional IPOs;
- (iv) Patent Prosecution Highway (PPH); and
- (v) Other bilateral/multilateral initiatives.

SCP/35/6: Expedited Examination programs

Overview of the expedited examination programs

- Patent offices around the globe recognize the importance of timely delivery of their decisions
- Prolonged pendency can have **significant consequences**
 - delays in the commercialization of technologies
 - hinder the objectives of the patent system as a whole
- **Timeliness** in the evaluation of patent applications - **one of the important elements** contributing to **the quality of the patent granting process**
 - not only the quality of examination reports but also the **speed** at which they are delivered are **vital to the quality of patents**



Expedited examination programs

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Types of expedited examination programs/Grounds

- Types of expedited examination programs offered by IPOs are different.
- In many IPOs, expedited examination programs may be requested on **one or more grounds**.
- In some countries, the program is available to **any applicant** and applies to **applications in any field of technology**.
- In other countries, **the program is available to eligible applications/applicants** under the law.

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Types of expedited examination programs/Grounds

- In other countries, the program is available to eligible applications/applicants under the law, and the possibility to accelerate examination procedures may depend on:
 - the status of the applicant (e.g., SME, an elderly applicant or an applicant who is seriously ill, or a public entity);
 - the application relates to a certain area of technology (e.g., green technology, health-related technology or artificial intelligence);
 - the expedited examination is justified based on public interest (e.g., national emergency, defence purposes or disaster prevention);
 - business circumstances of the applicant (e.g., an applicant requesting a public fund, anticipating infringement proceedings, or intending to commercialize the invention); and
 - conditions on the filing route (e.g., the application was first filed in the national IPO, or it has been or will be filed in at least one other foreign IPO).
- In a number of IPOs, the expedited examination programs are available with respect to patent applications which concern COVID-19.

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Types of expedited examination programs/Grounds

Table 1 Types of Expedited Examination Programs provided by IPOs (Indicative)

Expedited Examination Types/Grounds	Details	Countries
General Expedited Examination	A program generally available to any applicant and for all types of applications.	Finland, France, Republic of Moldova, Singapore, Slovakia, Spain, United States of America, European Patent Office
Public Interest/National Emergency/ Defense	Expedited examination of the application is justified by a national emergency, the benefit of the general public or for defense purposes.	Australia, <u>Brazil</u> , China, Israel, <u>Japan</u> , <u>Republic of Korea</u> , United States of America
COVID-19	The application concerns technologies that are used in relation to COVID-19 specifically	Brazil, Bulgaria, Canada, China, France, Israel, Morocco, Republic of Korea, Russian Federation, United States of America
Health-Care Related Technology	Subject matter of the patent application concerns health-related technologies.	Brazil, Republic of Korea, Russian Federation, Thailand, United States of America
Green Technology	Subject matter of the patent application concerns green technologies or other technologies that aim to improve the environment.	Australia, Brazil, Bulgaria, Canada, China, Finland, Israel, Japan, Republic of Korea, Spain, United States of America
Certain Other Technology Areas	The application concerns certain technological areas, such as AI,	China, Republic of Korea, Russian Federation

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Rationale for provision of expedited examination programs

- Depending on the types of expedited examination programs offered by the IPOs, the rationale behind expedited examination practices may be different:
 - Facilitating Commercialization
 - Responding to Emerging Technologies
 - Supporting Small Businesses and Startups
 - Addressing global challenges
 - Public interest or humanitarian consideration

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Procedure and conditions

- Different from one office to another
- In most offices, acceleration is subject to an express request by the applicant within a certain time limit.
- Justification and supporting documents may be required to qualify for a program.
- In some offices, a patent application and/or a request for participation in such a program must be filed electronically.
- In some offices, the acceptance of such requests is subject to the workload of search and examining divisions.
- In some offices, the number of claims in the application must be limited to a certain number, and the application must be complete.
- Regarding COVID-19-related applications, some other conditions may need to be fulfilled (e.g., a requester must be an SME)

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Fees

- The majority of the offices do not require payment of fees for requesting participation in such programs.
- In some offices, a fee may be required for some grounds for acceleration but not all.
- Only few offices require fees with respect to COVID-19-related applications.

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Reduced Pendency

- The **average pendency** period of applications under accelerated examination **varies** from one office to another
- In most of the offices, it takes on average more than a year or two to receive a final decision of the office on applications processed according to a regular procedure. **Pendency** for applications which were examined under accelerated procedure has been **reduced by half** of that time in some offices, whereas in other offices, to several months.
- In several offices, the average pendency of application processed under the accelerated programs is **around 12 months**.
- In two offices, examination pendency for expedited applications is **around 20 or 24 months** from the filing date or the time of filing a request for such an examination.

Thank you.