

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Nineteenth Session
Canberra, February 8 to 10, 2012**

COLLABORATIVE SEARCH AND EXAMINATION PILOT PROJECT - INTERMEDIARY REPORT OF PILOT PHASE 2

Report prepared by the European Patent Office

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, the Korean Intellectual Property Office (KIPO), the United States Patent and Trademark Office (USPTO) and the European Patent Office (EPO) launched a first pilot project on collaborative search and examination under the PCT (CS&E) in May 2010. The objective of the project was 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 Meeting of International Authorities 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/MIA/18/16).
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. The *second pilot project of a larger scale* builds 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 an operational working model.

4. This document is a progress report of the second pilot and includes the views of the EPO participants. The initial plan was to complete the first part of this second pilot by the time of the PCT MIA beginning of February. There have been some delays due to the appointment of the examiners, some difficulties to find suitable files in certain technical fields, as well as workload for some examiners that did not allow them to dedicate more time to this pilot.

5. Overall, the second pilot project is going well and the completion is expected for the summer of 2012. A detailed evaluation by the participating Offices will follow with the aim of reporting the results at the IP5 Deputy Heads meeting before the end of 2012.

BUILDING ON THE FIRST PILOT PROJECT

6. 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.

7. Based on these main conclusions from the limited scale first pilot, the Offices KIPO, USPTO and EPO decided to launch the second pilot with duration of 1 year and involving more examiners and more PCT applications. The size of this second pilot is as follows:

- 8 examiners per participating office, with a total of *24 examiners involved* in the pilot.
- Each examiner treating a total of 8 PCT applications as first examiner (responsible for the applications - see Annex), and collaborating in other 16 PCT applications of the two counterparts.
- The total number of *PCT applications treated in the pilot is 192* (each Office treating 64 PCT applications as ISA and collaborating in another 128).

8. The second pilot is split in two parts: A *first part* will be conducted from October 2011 to March 2012 with 4 PCT applications per examiner acting as first examiner. The *second part* will be conducted from April to September 2012 with 4 additional PCT applications per examiner acting as first examiner.

OBJECTIVES FOR THE SECOND PILOT PROJECT

9. 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 fine-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.

PILOT DESIGN

10. The pilot is designed for testing the concept of collaborative search and examination according to the objectives set forth in paragraph 9 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.

11. A balance has been 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 harmonized way among the different Offices and examiners in different technical fields.

12. 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 WO-ISA produced under the pilot for their own PCT applications treated in the pilot.

13. The methodology agreed by the participating Offices is depicted in the Annex.

EVALUATION OF PROGRESS

14. On January 26, 2012 a total of 35 of the planned 64 PCT applications planned for the first half of the pilot have been completed. Although it was expected to have this first half completed by the time of the PCT MIA, due to operational delays, e.g. selection of USPTO examiners and other operational priorities for the examiners, the first half of the pilot will only be ready by the end of February.

15. The general perception is that the pilot is teaching very relevant aspects about the collaboration between examiners in remote locations, with different cultures, operational constraints, etc. This collaborative approach being a new way of treating applications and never tested before the launch of the CS&E pilots, the learning phase is very important and will certainly still last until the end of the second pilot.

16. Some of the main general lessons learnt to date are summarized in the points below:

- *Operational constraints* within each Office have an important impact in the collaboration. Examples of these constraints are the workload of an examiner, the incentives to dedicate time to this pilot, different priorities defined by the Offices for the treatment of applications.
- The success in the collaboration varies from group to group, each group being composed of one examiner per participating Office. The lack of progress by one member in a group, for whatever reason this is, has a big impact on the progress of the group, as this, according to the current methodology, blocks the whole group. *Progress* is determined by the least responsive / least active participant in the group.
- *Differences in practice* in the PCT procedure for aspects such as claims directed to medical use or to method of treatment are an issue for the collaboration that tends to be more limited.
- Email is the main *communication means* for the collaboration. It seems that the examiners' pace for handling applications as well as the time difference between the Offices makes email the preferred option. Video-conference, chat and telephone have been tested, however are not often used.

- Collaboration highly improves once the participants in a specific group have worked together for a certain period of time and know what to expect from the counterparts.
- Collaboration needs to be supported by a *collaboration tool* that automatically keeps the "state" of the often multiple threads and, even, multiple applications treated by a group at the same time. Functionalities such as generation of reminders to provide feedback, making visible that one participant is not available for a period of time.

17. The evaluation of the pilot project has two different components: (1) Views of the participants, (2) Views of the applicants. The following sections explain how these different evaluations have been planned and the preliminary results.

EVALUATION BY THE EPO PARTICIPATING EXAMINERS

18. The participants within an Office have been asked to provide feedback on a regular basis and to fill in a questionnaire after they complete an application, either as first examiner or as peer examiner (see Annex for clarification about the roles). The objective of this pilot is to gather quantitative results, and the questions to the participants focus, therefore, on the quantitative aspects of the *quality* and *efficiency* when treating an application according to the CS&E approach.

Quality

19. The quality of the consolidated ISR and WO-ISA is compared to the quality of the provisional ISR and WO-ISA (the results of the first examiner as sent to the peers).

20. The views of the EPO participants for their *work as first examiner*, e.g. receiving feedback, on the work done until now and making abstraction of the operational issues associated to a pilot:

- The feedback received as first examiner was relevant in almost 100% of the applications treated.
- In more than 60% of the applications the feedback received included comments to the search strategy, interpretation of the claims and prior art or patentability. In 30% of the applications the feedback received included *additional search hints*, e.g. classes, keywords, databases. In around 86% of the applications included *additional citations* found by the peer examiners.
- In more than 90% of the applications the feedback resulted in *citations added* to the final search report by the first examiner. In 64% of the applications the feedback resulted in *amendments to the WO-ISA*.
- Regarding the *quality of the final product* (final ISR and final WO-ISA), the examiners, when acting as first examiner consider that: (1) in around 40% of the applications the quality of the final product "greatly improved by making the product more complete"; (2) in around 40% of the applications the quality of the final product "improved a bit making this product more complete"; and (3) in 10% of the applications quality improved a bit by "providing confidence to the first examiner".

Efficiency

21. The views of the EPO participants based on the work done until now and making abstraction of the operational issues associated to a pilot:

- When acting as first examiner, and comparing the CS&E collaboration with a normal search of a PCT application, for most of the cases around 15%-25% additional time was needed.

- When acting as peer examiner, the examiner time needed to provide feedback was as % of time of a normal PCT search was (1) in around 30% of the cases around 5%-10% of the search time, (2) in 21% of the cases around 12%-25% of the search time, (3) in 10% no time was needed, (4) in 35% of the cases more than 30% of the search time.
- For the PCT applications treated in collaboration, the participants acting as peer examiner consider that when these applications enter regional/national phase (1) in almost 70% of the cases he/she would trust the results of the collaboration and would only need additional time for administrative matters, (2) in 15% of the cases he/she would need little time for a complementary search, (3) in 30% of the cases would need little time for a complementary examination.

22. The previous views by the EPO participants are based on a very limited number of applications during the second pilot to date. By the end of the second pilot it will be possible to have feedback from the participants for more applications treated and the conclusions will be more representative. However, it is interesting to see that the feedback received until now is consistent and in line with the assumptions and outcome of the first CS&E pilot.

EVALUATION BY APPLICANTS

23. The origin of the CS&E concept is a *proposal made by the industry* that expressed an interest for a single search report and written opinion presenting the views of the examiners of the major patent Offices. According to the views expressed by industry associations, such a report and written opinion would provide applicants with a new product which would assist them in defining the appropriate strategy for extending their IP rights worldwide for specific inventions which are key for their business development.

24. The participating Offices have arranged discussions with industry associations. Particularly, the EPO has addressed a request to BUSINESSSEUROPE to collect feedback about the interest that applicants could have in a collaborative product provided by patent Offices. Applicants' views on the following series of points have been identified as important:

- Initial tests have indicated that beyond its feasibility such a product would have added value as the search report and written opinion would reflect the common view of examiners in the different Offices thereby providing applicants at the PCT Chapter I stage with a richer and more thorough view on the potential outcome of prosecutions in national / regional phases in different regions.
- The new product would provide applicants higher legal certainty at an earlier stage which might be interesting for defining the appropriate strategy for key applications.
- CS&E pilot follows a different approach than the current procedure Supplementary International Search (SIS) in that the examiners collaborate to produce a consolidated search report and written opinion. Applicants that do not consider SIS today as an interesting option for their applications might find the CS&E approach interesting.
- The production cost of an ISR and WO-ISA in the CS&E pilot is higher compared to a conventional ISR and WO-ISA (i.e. more time for the first examiners in addition to the time required for the peer examiners contribution). EPO's initial estimate indicates that in the current constellation the price could be between two and three times the current international search fee search fee charged by the EPO.

25. The feedback received until now is limited and final conclusions on applicants' interest will only be available after more detailed feedback is received. The available feedback, however, shows an interest in the collaborative approach proposed by this pilot and that a potential product of these characteristics could be of interest for certain industries or types of applicants. The matter of the cost is a very important one and more precise views have been requested to the industry associations.

26. *The Meeting is invited to take note of the report.*

[Annex follows]

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) analyzes 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 one 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 one 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.

[End of Annex and of document]