

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

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IP5 PCT COLLABORATIVE SEARCH AND EXAMINATION: FINAL REPORT

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SUMMARY

1. This document reports on the conclusion of the third pilot project on collaborative search and examination under the PCT (“CS&E”) among the IP5 Offices (the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the China National Intellectual Property Administration (CNIPA) and the United States Patent and Trademark Office (USPTO)).

BACKGROUND

2. 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 International Authorities with complementary skills work together to establish a report.

3. With this aim, KIPO, the USPTO and the EPO launched two pilot projects on collaborative search and examination under the PCT (CS&E) in 2010 and 2012. Both pilots concluded with an overall very positive outcome in terms of quality and efficiency for both the participating Offices and users whose applications were treated under the collaborative scheme (see documents PCT/MIA/18/7, PCT/MIA/20/4 and PCT/MIA/24/3).

FRAMEWORK

4. On June 2, 2016, the IP5 Heads endorsed the “IP5 Cooperation Framework on Collaborative Search and Examination under the PCT”, which is a document setting the underlying principles and main features of the third pilot. The Collaborative Search and Examination Pilot Group (“CS&E Pilot Group”) established on the basis of that document was in charge of developing and monitoring the project.

5. The main features of this pilot project were, in particular:

- an applicant-driven approach: the applications processed during this pilot were selected by applicants;
- a balanced workload distribution: all collaborating International Authorities contributed to the establishment of each CS&E work product; each Office processed up to 100 international applications in its role as “main International Searching Authority” and up to 400 international applications in its role as “peer International Searching Authority” over two years;
- a common set of quality and operational standards was applied by all collaborating International Authorities when processing PCT applications;
- the use of a “collaborative tool”, i.e. an IT infrastructure allowing exchanges among Offices in a secure environment and automated data collection; and
- the possibility for the collaborating International Authorities to accept, at some point in time during the pilot, also applications filed in a language other than English.

6. In this pilot project, the examiner from the Office acting as competent International Searching Authority (ISA) under PCT Rule 35 for a given international application (“the main examiner”) conducted the search and examination as for any other international application and established a provisional international search report (ISR) and written opinion. These provisional work products were then transmitted to peer examiners from the other participating Offices in their capacity as International Searching Authorities. Peer examiners provided the main examiner with their contributions, taking into consideration the provisional international search report and written opinion. The final international search report and written opinion were established by the main examiner after consideration of the contributions from the peer examiners.

RESULTS OF THE PILOT

7. The pilot project was divided into three phases: a preparatory phase, an operational phase and an evaluation phase.

8. The operational phase — dedicated to the processing of applications under the collaborative scheme — ran smoothly from July 1, 2018 to June 30, 2020. Applications in all six official languages of the participating ISAs have been accepted and successfully processed in the pilot. A total of 468 applications have been accepted into the pilot and the same number of international search reports have been established in collaborative mode.

9. The final operational CS&E results are summarized in the table below:

Accepted applications	CS&E search reports per ISA	Receiving Offices	Languages	Technological fields
468	CN: 93 JP: 75 KR: 100 US: 100 EP: 100	CN – 92 EP – 32 IB – 42 JP – 60 KR – 26 US – 216	de – 13 en – 413 fr – 2 ja – 20 ko – 3 zh – 17	A – 87 B – 53 C – 62 D – 6 E – 10 F – 14 G – 145 H – 91

10. On July 1, 2020, the pilot entered the evaluation phase during which the IP5 Offices are assessing and reporting on the results gathered during the international phase as well as the entry of international applications processed collaboratively into their respective national or regional phases, based on the agreed set of quality and operational indicators. So far, the data collected during the international phase reveals that in comparison to the provisional ISRs drafted by the main ISA:

- 70 per cent of the final ISRs established in collaborative mode by the IP5 Offices contained new citations;
- 53 per cent of the final ISRs contained additional XYE citations;
- On average, the number of citations increased from 6.1 to 8.1 in the final ISRs;
- While 12.8 per cent of provisional ISRs contained only A citations, the percentage is 4 per cent lower in the final ISRs.

11. In 2021, the International Bureau conducted a survey of pilot participants using a questionnaire agreed upon by the IP5 Offices. Further feedback from pilot participants and user groups could also be gathered by participating Offices.

12. The IP5 Cooperation Framework on Collaborative Search and Examination under the PCT initially foresaw that the pilot would have a maximum duration of five years, i.e. with the evaluation phase ending in June 2021. A first one-year extension of the evaluation phase was decided by the IP5 Heads of Office in 2020.

13. However, most CS&E files had not received a final action at the IP5 Offices by June 2022 as a majority of applications were entering into the national/regional phases in the course of 2021. For this reason, the pilot had been extended by one year until June 2023 based on the recommendation of the IP5 CS&E Pilot Group at its tenth session in November 2021.

CONCLUSION OF THE PILOT

14. The pilot was concluded in June 2023 with the presentation of a final assessment report to the IP5 Heads of Offices. A thorough evaluation of the pilot came to the conclusion that whilst the scheme enriched the work products of the participating Offices, the Collaborative Search and Examination would not be implemented in the PCT framework for the time being and in its present form. No consensus could be found on the way to set the amount of the collaborative search fee and there were hurdles in the operational handling of these patent applications, especially in cases of non-unity.

15. The IP5 Heads of Offices noted that this pilot had enabled a better understanding of their respective practices and provided useful insights into work-sharing. They also thanked the International Bureau of WIPO for its operational support to the pilot, and for its contributions regarding the collection of data and for conducting a survey addressed to the pilot participants.

16. Therefore, the IP5 Offices have decided to complete the monitoring of the pilot patent applications in the respective national and regional phases, and to explore how the knowledge and experience gained from the pilot could be employed to the benefit of the users and offices.

17. The Meeting is invited to note the contents of this document.

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