

Search and Examination in small and medium IPOs

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Bangkok
4-5 October
2010

Agenda

- Types of offices
- Options for substantive examination
- WIPO's ICE service
- Further options

Challenges of small & medium IPOs

Countries' challenges:

- Foster innovation by creating infrastructure for IP rights
- Meet obligations due to TRIPS, FTAs,

IPOs' challenges:

- Efficient patent prosecution procedures for
 - **foreign** (including PCT) and
 - **truly national** patent applicationswith **limited resources** (e.g. legal and technical expertise of staff, access to databases..)
- Advisory services

Different categories of IPOs

Expertise

- IPOs just **embarking on patent prosecution** (e.g. Bahrain, Oman, Bhutan, Cambodia,...)
- IPOs having **established patent prosecution** ("emerging Offices"; e.g. Jordan, Malaysia, Viet Nam,...)

Size

- **Small IPOs** with very few examiners (e.g. Bahrain, Oman, Bhutan, Jordan, Syria) and the capacity to **cover very few areas of technology**
- **Medium size IPOs** with the capacity to **cover some but not all areas of technology**

Types of patent applications

■ Truly national first filing

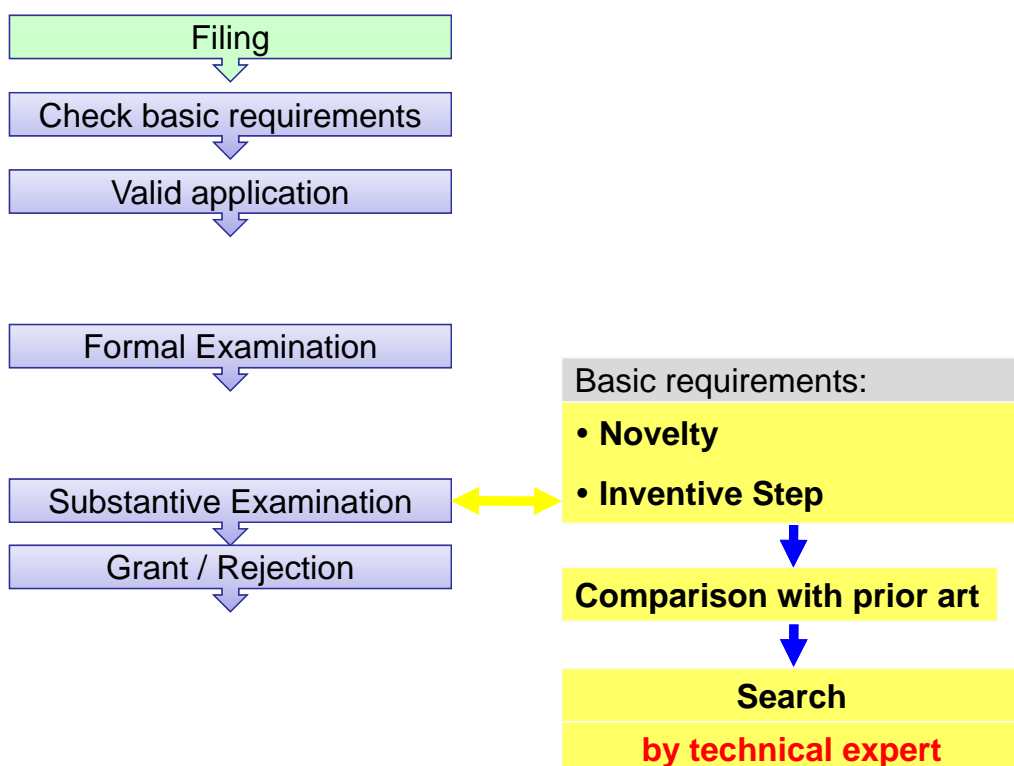
- second filing abroad is possible, i.e. application may become member of **patent family**

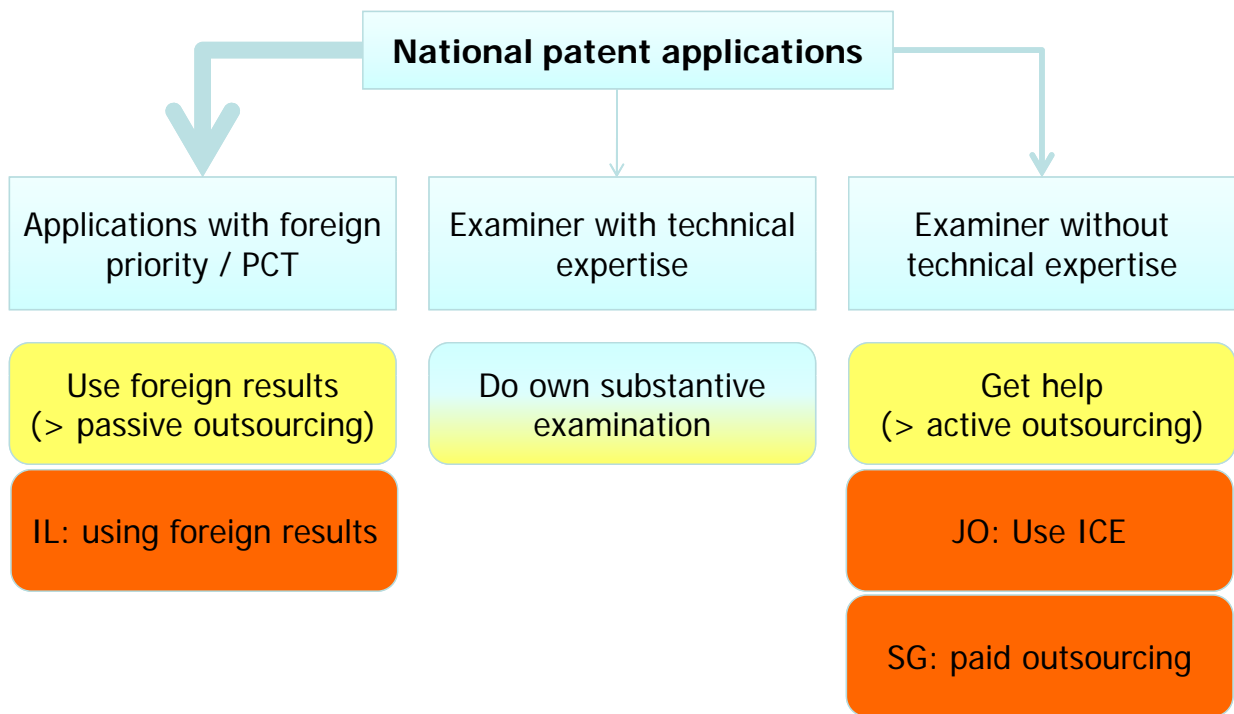
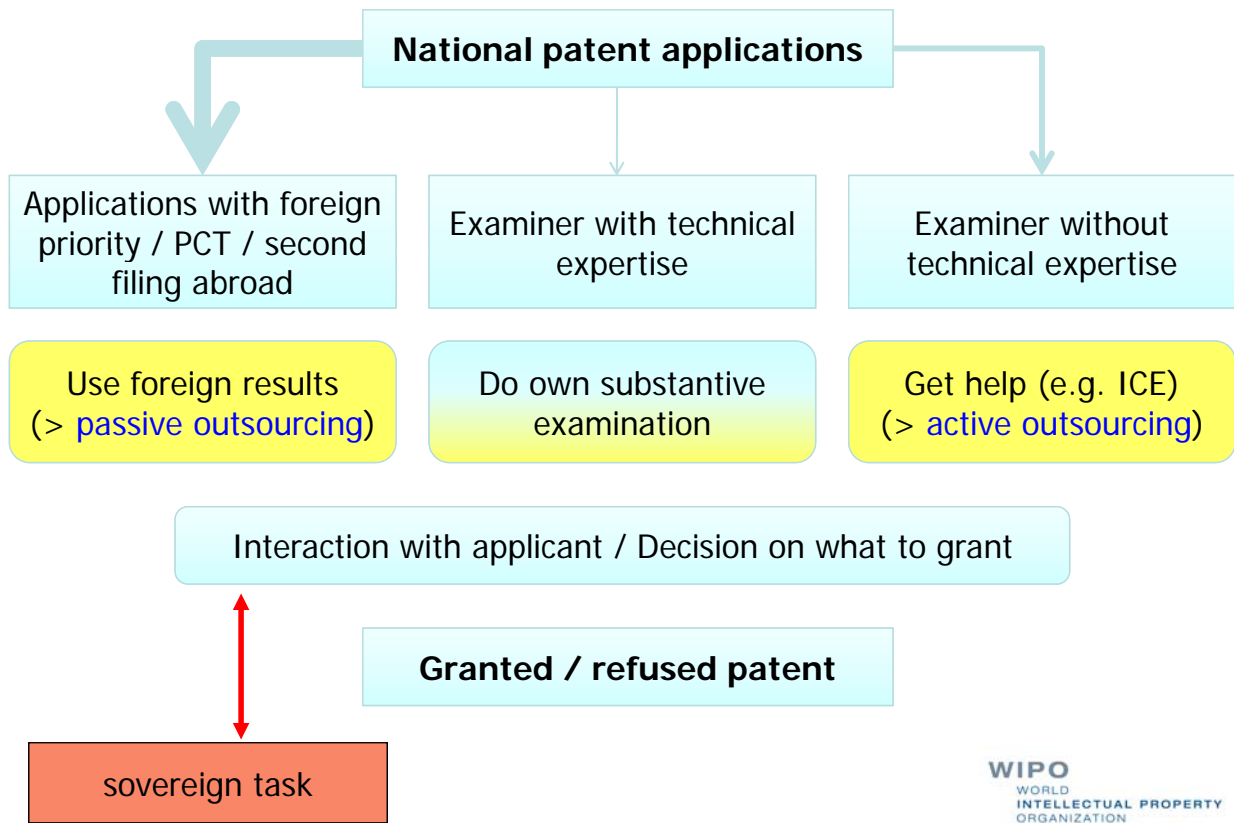
■ PCT national phase entries

- application is member of **patent family**

■ non-PCT foreign filings (second filings)

- priority claimed, i.e. is member of patent family
- priority not claimed:
 - > "**technical family**" because same invention





Example: Singapore

- Outsourcing of S&E for a fee to other IPOs (AU, AT, HU, DK) for "local route"
- For all types of applications, including PCT national phase entries
- Outsourced examination based on SG patent law and regulations
- Self-assessment by applicant based on examination report (currently under review)

- Similar outsourcing by GCC, UAE, ...

Example: Israel

- Law explicitly authorizes that the granting decision is based on granting decisions of selected offices (e.g. US, EP, DE), if
 - applicant requests so
 - claims are identical

- Law authorizes the Registrar to proceed differently
- Applied to only 20% of possible cases

Example: Jordan

- Two track system:
 - foreign results available and usable:
 - > wait for availability of final results

 - foreign results unavailable or not usable:
 - submit request to WIPO's ICE service
 - preliminary examination prior to submission (claim quality,...)

Patent prosecution – no options:

- ▶ Doing formality examination, registry, grant, invalidation

Patent prosecution – option 1

- ▶ Doing full substantive examination (search, examination, granting), at least in some areas of technology

Patent prosecution – option 2

- ▶ Outsourcing full search&examination

Patent prosecution – option 3

- ▶ Rely fully on grants/rejections of other IPOs
 - possible for PCT, foreign priorities, including technical families
 - not possible for truly national filings, unless in case of second filing abroad
 - requires identical claims & cooperative applicants
 - requires claims compatible with national law
 - implies considerable delay because final results have to become available

Patent prosecution – option 4

- ▶ Use only S&E results, e.g. search reports, i.e. not final results, of other IPOs, e.g. via ICE, ASPEC, AIPN, PPH:
 - possible for national filings (through ICE)
 - possible also for PCT, foreign priorities
 - implies some but smaller delay than option 3
- ICE S&E reports: requirements to be observed:
 - clear claims
 - no foreign results available

National sovereignty

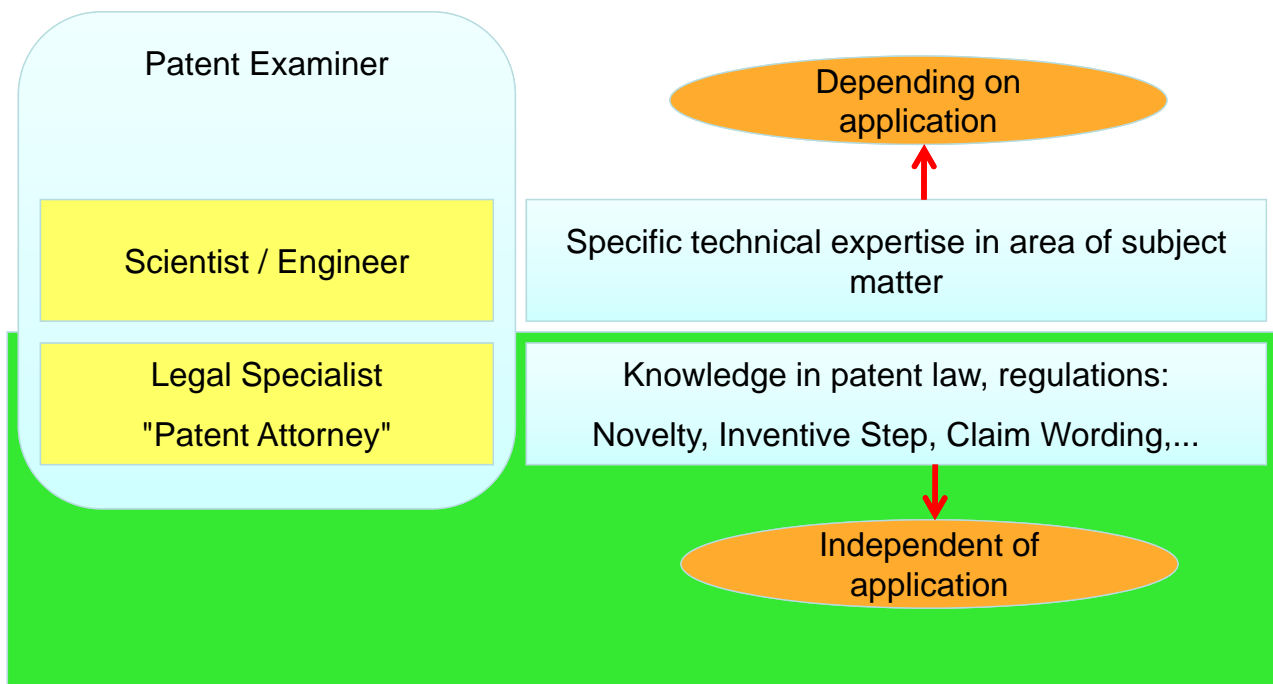
- No obligation to use results of others, or to follow their conclusions
- Obligation to observe national legislation
- Liability of national IPO

- **IPO's responsibility for granting and quality**

- IPOS of SG: "we just hire examiner overseas"

Substantive examination in small offices ?

- WIPO previously did not recommend that
- National sovereignty: IPO is legally responsible for granting, i.e. liable for quality of patent !
- Leads to better understanding of patent protection, practices, implications
- Allows informed participation in policy discussion
- Builds trust and confidence among IPOs



Summary of challenges

- Technical expertise of examiners
- Expertise for delivering full patent prosecution
 - claim drafting
 - using results of other IPOs
 - retrieving them (eg. technical families)
 - exploiting them (e.g. language barrier; lack of standarization)
- search expertise
- rejection rulings
- opposition/appeals

Summary of challenges

- Access to specialized/commercial databases
- Cover complex / high tech fields
- Training resources / support
- Hiring (paying) qualified examiners
- Staff turnover
- Technical infrastructure

WPIS - WIPO's Patent Information Service for developing countries

Current WPIS portfolio:

- ▶ WPIS provides **free of charge**, upon request by national Intellectual Property Office (IPO):

- ...

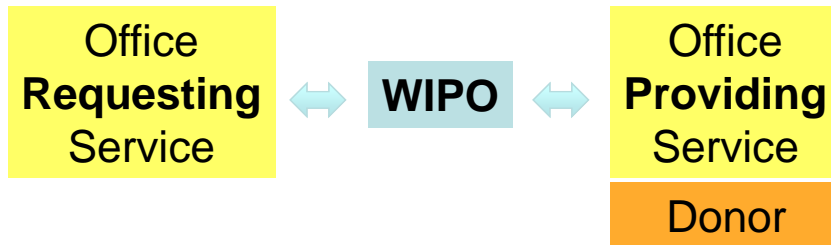
- **Search and examination (S&E) reports** for patent applications of IPOs in developing countries

> **complements PCT**

- ▶ **ICE** – International Cooperation on Examination
(previously ICSEI)

WPIS

- WIPO acts mainly as "agent":



- Search reports done by "donor offices" with expertise in search and examination, based on bilateral agreements with WIPO

WPIS

- Current donor offices:

AR, AT, AU, BR, BG, CA, CH, CU, DE, FI, FR, GB, JP, KR, MX, NO, PT, RU, SE, VE

- Some donors contribute only state of the art search reports, others also "written opinions", i.e. ICE reports

ICE : goals of redesigned ICSEI

- ▶ Focus on **capacity building** in countries developing their IP infrastructure, e.g.
 - Strengthening patent prosecution
 - National IPOs or TISCs to deliver IP information services to their private sector

- ▶ **Efficiency** of ICE: avoid duplication of work (search), aligning with PCT procedures

- ▶ Enlarging volume: more and new clients; more service providers, larger quota

Options for redesigned ICE

- ▶ Covering full patent prosecution beyond just one set of search and examination reports:
 - Top-up searches for amended claims
 - Examination reports for amended claims
 - Rejections
 - Opposition, invalidation, revocation
 - Inclusion of PCT national phase (ideally done by ISA examiner)

Options for redesigned ICE

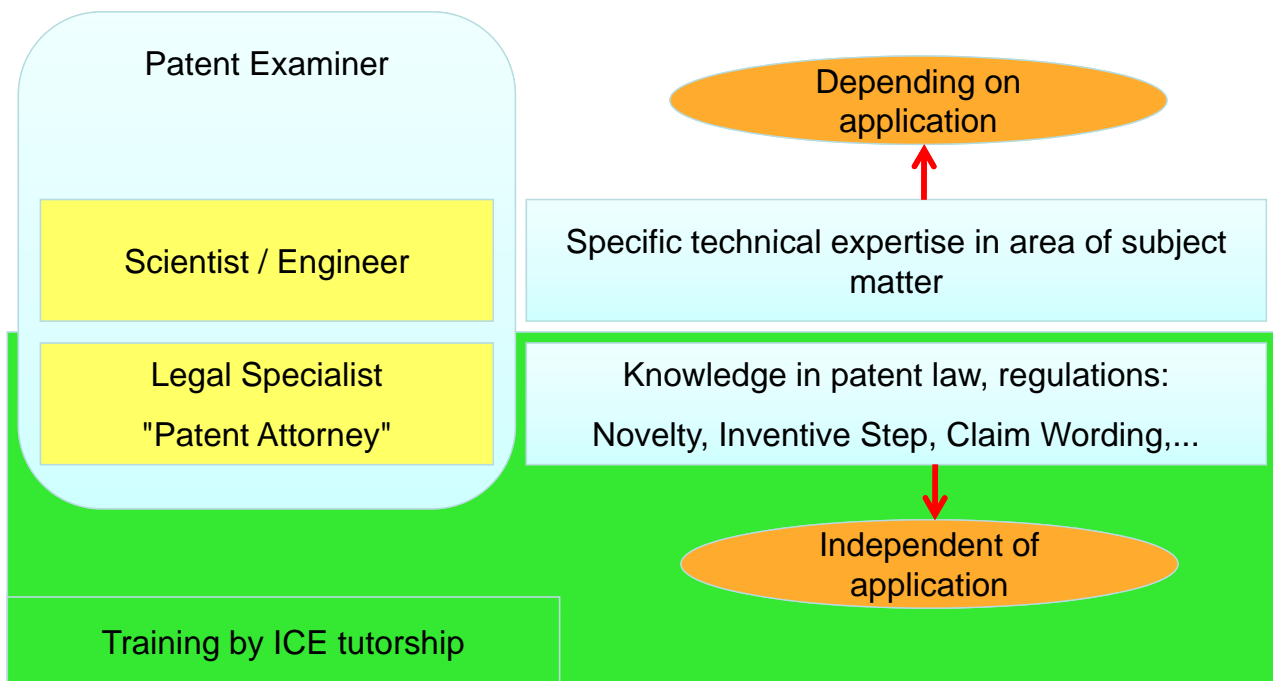
- ▶ For small IPOs: full S&E service

- ▶ For medium size IPOs having experience in substantive examination:
 - Support in selected complex technical fields
 - Indirect, mediated access to specialised databases in order to complement searches in free databases (<>TISCs, aRDi, aSPi)

Options for redesigned ICE

- ▶ Training component, e.g.
 - [Training on the job](#) for selected cases of national applications by direct (electronic) exchange, i.e. tutorship between
 - an examiner developing expertise and
 - an examiner having expertise, i.e. the one who prepared the S&E report

 - Discussion e.g. of efficient search strategy; inventive step; applicant's reply, amended claims; rejection



Options for redesigned ICE

- ▶ Training, tutorials for patent prosecution, e.g. claim drafting, search strategies, reading and using S&E reports,....
 - cooperation with other programs/offices
 - using material developed by other offices
 - developing new material

- ▶ Establishing a platform for exchange on best practices

Options for redesigned ICE

- ▶ Support for cooperation and work sharing:
 - Avoid duplication of work: sharing and mutual utilization of search and examination results (ASPEC, AIPN, PPH, Vancouver Group, LA initiative)
 - Requires platform for
 - sharing of application information
 - identification of patent families
 - exchange of documents

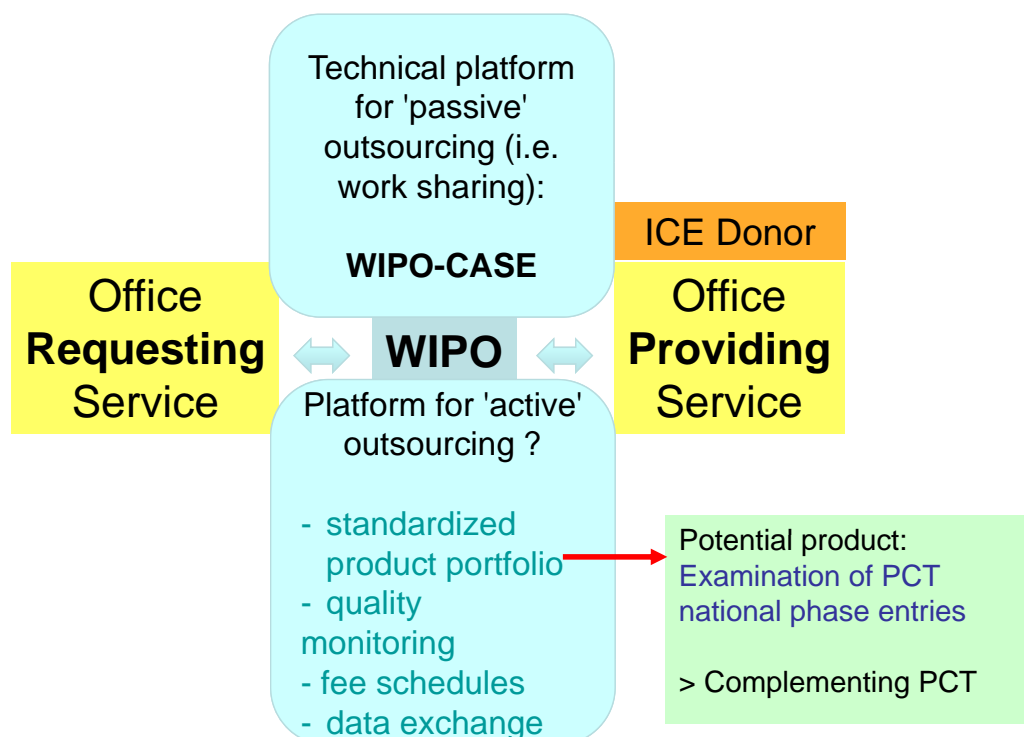
- > WIPO CASE (Central Access to Search and Examination) for Vancouver Group, etc.

Mobilizing resources

- ▶ Future promotion will increase demand for ICE services
- ▶ Investigating options to broaden participation of "donors" for
 - more ICE reports (i.e. written opinions) instead of only state of the art search reports
 - additional tutoring
 - inclusion of other donors, e.g. all ISA

Broadening the service ?

- ▶ Establishing a wider work sharing cooperation framework / platform for outsourcing ?
 - Servicing any IPOs wishing to outsource S&E, including paid services
 - Establishing a "market place" for demand of S&E and supply of S&E
 - Service Providers – Service Recipients
 - Business model for some IPOs (Production costs? Own backlog?)
 - Appears to meet the needs of several IPOs
 - Small scale pilot project ?



Thank you

WIPO
WORLD
INTELLECTUAL PROPERTY
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