

## **Patent Cooperation Treaty (PCT) Working Group**

**Fourteenth Session**  
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### **INTERNATIONAL SEARCH REPORT FEEDBACK PILOT**

*Document prepared by Australia, Canada, Singapore, the United Kingdom and the United States of America*

#### **SUMMARY**

1. This document reports on the progress of the recently established International Search Report Feedback Pilot under the PCT. The pilot has so far involved the United Kingdom Intellectual Property Office (UKIPO) as designated Office providing feedback to the United States Patent and Trademark Office (USPTO), Canadian Intellectual Property Office (CIPO), IP Australia and the Intellectual Property Office of Singapore (IPOS) on international search reports established by them in their role as International Searching Authority.

#### **BACKGROUND**

2. At the time of the publication of the 3 millionth international patent application under the PCT on February 2, 2017, the Director General published a Memorandum titled "The PCT System - Overview and Possible Future Directions and Priorities". One of the ideas proposed in this document and further discussed in document PCT/WG/11/5 was the creation of a feedback system where national offices can provide feedback on the quality of work carried out by International Authorities during the international phase.

3. The UKIPO supports this approach as part of wider efforts to ensure the PCT and international phase are operating as effectively as possible. In February 2019, the UKIPO invited CIPO and IP Australia to participate in a small-scale International Search Report (ISR) feedback pilot to demonstrate the usefulness of such a system, and to identify feedback most beneficial for International Searching Authorities (ISAs).

4. The UKIPO mentioned the pilot at the twelfth session of the PCT Working Group and issued an open invitation to other ISAs to participate. IPOS expressed an interest and formally joined the pilot in September 2019.

5. Progress was discussed at the twenty-seventh Meeting of International Authorities in February 2020 where several ISAs indicated an interest in joining the pilot. The USPTO are the latest ISA to participate in the pilot, joining in early 2021.

## **FRAMEWORK**

6. The UKIPO devised the pilot to be as simple as possible for participants, limiting the amount of time and work required from them. The pilot works as follows:

- An ISA allows the UKIPO to provide feedback on ISRs for five international applications that have been subsequently examined during the UK national phase.
- The UKIPO collates the feedback and e-mails it to the ISA using the sheet in Annex I.
- The ISA digests the feedback and provides comments to the UKIPO on the quality of feedback received using the sheet in Annex II.
- The UKIPO assesses the comments and reports its findings to both the Meeting of International Authorities and PCT Working Group for discussion.

## **STATE OF PLAY**

7. All current participating Offices have obtained feedback from the pilot and reported back to the UKIPO on the quality of the feedback received. We have evaluated the results of the pilot so far, with the following findings:

### How have ISAs used the feedback?

8. It was clear from the response documents that all four ISAs purposefully set aside time to assess the feedback provided by the UKIPO. The feedback itself provided the ISAs with areas of international examination practices/processes/documentation to review, e.g. citations listed differently, additional IPC and non-patent literature (NPL) sources to consider, etc. One ISA suggested that to get the most value from this type of feedback it would be useful to understand how the substantive examination procedures work in national offices, especially how their practice differs from the PCT International Search and Preliminary Examination Guidelines.

9. Another ISA found that the feedback helped them better understand how their approach to search could be refined in specific circumstances, e.g. lack of unity. They also found the feedback to be useful in further evaluating their approach to utilizing classification.

10. Finally a further ISA found it useful to obtain confirmation from peers in another IP Office that both the art and opinions provided were valid.

### Which feedback was most useful?

11. Most ISAs found the most useful feedback to be the further prior art documents cited by the UK examiner during national phase examination. As claims in many of the applications in the pilot were viewed as being broad in scope, it was suggested that the citing of additional documents could perhaps highlight a difference in practice in dealing with broad claims.

12. Two ISAs also found the feedback provided on field of search useful. They were keen to establish whether the UK examiner had extended the field of search in terms of databases or new subclasses.

13. Another ISA found the feedback helpful as it provided an indirect insight to UKIPO national phase examination practice.

14. In general, all the feedback provided to the ISAs was considered relevant. Explanations from the UK examiner as to how their examination differed from the work carried out by the ISA were deemed to be extremely helpful, as were the links to UK national phase documentation provided by the UK national examiner.

#### Which feedback was not so useful?

15. One ISA felt the feedback could have been more useful if the UK examiner had provided reasons as to why they had re-categorized some citations. This is something the UKIPO will consider when providing feedback to future ISAs participating in the pilot. Another issue was the delay between performing the international search and receiving feedback. Several of the applications involved in the pilot had subsequently been amended upon entry into the national phase, which meant that feedback was less useful than it otherwise could have been. However, this did suggest that work carried out in the international phase had been effective in persuading the applicant to amend their application.

16. These matters were addressed in the latest round of feedback supplied to the USPTO. However, in attempting to narrow the timeframe between the international search and the provision of feedback several PPH applications were chosen which did not provide the receiving ISA with a great deal of feedback. A broader range of applications would have been useful, e.g. where a written opinion had raised issues regarding novelty and inventive step. In addition to this one UK examiner provided comments on the prosecution of a related US application. This was not deemed to be useful as it fell outside of the scope of the pilot.

#### Would any additional feedback prove beneficial?

17. The general feeling from participants was that more reasoning could be provided by UK examiners for any differentiations from the findings in the ISR. High level explanations to accompany statements would be desirable, e.g. why the examiner felt the need to expand the field of search, or why certain documents continued to be cited when amendments had been filed to overcome initial objections, etc. Again, this is something the UK can look at in future iterations of the pilot.

18. For most PCT cases the UKIPO relies on the search carried out in the international phase and performs a top up search to supplement this earlier work. One ISA felt the pilot would perhaps bring greater benefit to ISAs if the national office providing the feedback performed an independent full search and compared the results of both searches.

#### Suggestions for Improvement

19. Several improvements have been discussed in the paragraphs above. However, one further suggestion was for UK examiners to use the term "N/A" in questions 3 and 4 where no X or Y (Q3) or A citations (Q4) were cited by the ISA. This would help distinguish from ISRs where these documents were cited but not re-categorized by the UK examiner.

20. Consideration might also be given to making Q6 the very first question. A substantive amendment could render the ISR (and potentially all remaining questions) moot. Furthermore, Q6 could possibly be reworded as follows: "Were there any substantive amendments filed following the issuance of the ISR but prior to national phase examination such that the scope of the claimed invention has changed?"

21. It was also suggested that the PCT application number be included on the feedback form, as this would allow for easier identification by ISAs.

## **NEXT STEPS**

22. The UKIPO encourages other ISAs to participate in future rounds of the pilot, as it will provide valuable information to the International Bureau should it choose to develop a feedback service in the future. Feedback provided during the pilot has proved useful for ISAs and helps improve the quality of work produced by them during the international phase.

23. If any ISA would like to participate, or obtain more information about the pilot, please e-mail Andrew Bushell at [andrew.bushell@ipo.gov.uk](mailto:andrew.bushell@ipo.gov.uk). The UKIPO remains flexible in how the pilot progresses and are happy to work with ISAs so they get the most from their participation.

24. *The Working Group is invited:*

*(i) to note the contents of the current document; and*

*(ii) to comment on whether they see the development of a feedback service as beneficial to the PCT System.*

[Annexes follow]

ISR FEEDBACK FORM

ISA:

Date of International Search:

PCT publication number:

ISA Authorized Officer:

GB publication number: (IPSUM link)

1. Were there citations not present in the ISR which you relied upon when conducting your examination? If so, please list these below.

2. Were there any citations listed in the International Search Report that you did not use during your examination?

3. Were there any X/Y documents cited in the International Search Report you considered to be A documents?

4. Were there any A documents cited in the International Search Report you considered to be X/Y documents?

5. Did you extend the field of search at examination to provide new subclasses or databases not listed by the ISA?

6. Were there any amendments filed following the issue of the ISR but prior to examination?

(If yes insert link to amendment document on IPSUM)

[Annex II follows]

IPO FEEDBACK RESPONSE FORM

1. How did you use the feedback provided? e.g. identified a specific training need, extended field of search for similar applications

2. Which aspects of the feedback were most useful?

3. Which aspects of the feedback were not as useful?

4. Is there any other feedback you would like to see included?

5. Do you have any ideas of how to improve the presentation of this feedback?

[End of Annex II and of document]