

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

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Collaborative Search and Examination Pilot Project – Report of Pilot Phase 1

Report by the European Patent Office

BACKGROUND

1. In June 2009 the European Patent Office (EPO) proposed to launch a pilot project in the IP5 framework¹ for testing the concept of collaborative search and examination mentioned in the PCT roadmap (annex to document PCT/WG/2/3). This proposal echoed a request of the industry to the patent offices for developing collaboration between examiners. In this pilot, examiners from different authorities in different regions and with different language specialties would work together on one PCT application with the objective to establish a single common high quality international search report and written opinion.
2. The general principles under which a small scale pilot project should be conducted have been already presented by the EPO at the last Meeting of International Authorities (MIA) in Rio de Janeiro in February 2010. A first pilot project on collaborative search and examination under the PCT (called “CS&E pilot phase 1” hereafter) between the USPTO, the KIPO and the EPO started in May 2010. The results of the pilot were discussed in a workshop hosted by the USPTO on the 8th to 9th September 2010.

¹ The “five IP offices” collaboration between the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People’s Republic of China and the United States Patent and Trademark Office (USPTO).

OBJECTIVES

3. The objectives of the CS&E pilot phase 1 have been:
 - (a) *Testing the potential of collaborative work* between examiners of different International Searching Authorities (ISA) for co-producing the international search report (ISR) and the written opinion of the ISA (WO-ISA) for international applications.
 - (b) *Defining the material condition and the methodology* under which examiners of different ISAs in different regions can co-produce the ISR and the WO-ISA.
 - (c) *Evaluating the project achievements* in terms of quality and efficiency.
 - (d) *Testing the main assumptions underlined in the CS&E concept*, in particular to what extent the examiners contributing to the ISR WO-ISA of another office will consider it as being an reusable for the national/regional phase.

ACHIEVEMENTS

4. This pilot has shown to be a model collaboration between the patent offices matching the challenges that the industrial property is facing and the applicants' needs with a global vision. It has been possible to agree on goals, assumptions, methodology and timeline and to set up all the necessary logistic within a few weeks. An important result of the pilot is that KIPO, USPTO and EPO have agreed to conduct a phase 2 on a larger sample of files and with more IT support for the examiners involved. The aim of phase 2 is to further polish the followed methodology and to provide reliable figures on the cost of CS&E in term of examiners time.

PROJECT DESIGN

5. The phase 1 pilot included *12 PCT applications* per participating office. Each office appointed for the project 2 examiners from each of the three big technical areas (mechanics, electricity/physics and chemistry). Two applications have been selected from each examiner's stock. These applications were either published or unpublished. In the latter case, applicant's consent was requested before including the application as part of the pilot.
6. The examiners worked under the legal framework of the PCT and all its related provisions. Namely, all participating offices continued 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. The following paragraphs explain the procedure for collaboration in the pilot:
 - The examiner of the office acting as ISA for a given PCT application (called *first examiner*) analyzed the application, defined a search strategy and performed the search. A *provisional ISR and WO-ISA*, as well as the *record of search strategy* (RoSS - information indicating what has been searched, where it has been searched and how the search has been conducted) was then shared by the examiner with his/her counterparts (called *peer examiners*).

- The peer examiners were asked to either comment on or complement as appropriate the provisional work of the first examiner. Peers transmitted their comments / feedback to the first examiner, these comments being related to search strategy, the citations or the WO-ISA. When the peers decided to complement the search, they carried either a focused search on particular aspects or a full search.
 - After receipt of this feedback from the peer examiners, the first examiner proceeded with the establishment of a *final ISR and WO-ISA* by considering the comments received and the discussions that took place by means of email, telephone or video conference. The final ISR and WO-ISA were then transmitted to the applicant.
7. Therefore, the final ISR and WO-ISA were the result of complementing the provisional ISR WO-ISA (the one drafted by the first examiner before having any feedback) enriched by the comments and discussions with the peer examiners.

OUTCOME OF PILOT PHASE 1

Methodology and Communication

8. The small size of the pilot phase 1 did not allow to draw any statistically meaningful conclusion. However, such a small scale has been appropriate for this pilot phase 1 as a proof of concept for this innovative collaboration method and for achieving the necessary fine tuning of the tested methodology based on the examiners' experiences. Therefore, the assessment of the results remains *qualitative*.
9. Additional support for the examiners would have been useful. In particular a *collaborative IT tool* would have eased the examiners' work and the monitoring/coordination of the project. This would be particularly important for the larger scale of the pilot phase 2.
10. Regarding the form and content of the feedback or the RoSS, it was left at the discretion of the examiners and only a very general template was proposed. However, a *more harmonized and systematic use of the dedicated forms* has shown to be important to ensure a harmonized level of detail for the information exchanged and facilitate the assessment of the RoSS and feedbacks received.
11. Regarding the communication process between the examiners, email was the main communication channel used. However, telephone conversations also proved to be useful in some situations.
12. Discussions between the examiners have been very positive as they gave them confidence, in particular for reusability in regional / national phase and added value to the final ISR and WO-ISA. *The final ISR and WO-ISA have been more complete* after the collaboration has taken place even when there are diverging views about the relevance of a prior art document for the ISR or the argumentations in the WO-ISA. Different argumentations could be sometime presented in the WO-ISA. They were always complementary and not contradictory. The ownership and decision about the content of the final ISR and WO-ISA remained with the first examiner.

Quality

13. In roughly half of the cases a tangible contribution by the collaboration could be evidenced, e.g. citation of additional prior art, which lead to visible improvement in the quality of the ISR and WO-ISA. In the rest of cases, even in absence of tangible contribution, the examiners considered the feedback and discussions beneficial as it improved the confidence in their own results. In all the cases, the result of the collaboration has been more complete products, which increased the legal certainty provided by the ISR and WO-ISA to the external users.

Efficiency

14. All examiners involved in the pilot agreed that when working as peer examiners, irrespective of whether an additional full search or only a complementary search focusing on some aspect has been, no major additional time investment would be required when dealing with the same application in the subsequent regional/national phase.
15. The efficiency highly depends on the perception by the peer examiners on how their contributions has been treated by the first examiner. An adequately documented RoSS, the relevance of the citations provided by the first examiner and the expertise of the peer examiner in the field played also a role in this respect.
16. On one hand as expected the time investment required by the first examiner per application has been higher in the pilot than in the normal context. However, the fact that now examiners know each other, improved methodology and better synchronization between the Offices will improve efficiency for the pilot phase 2. On the other hand, substantially less time will be spent on treating the application in the regional/national phase as only a mere update of the ISR will be required as indicated above.

CONCLUSION AND NEXT STEPS

17. The CS&E has proven to be a *feasible concept*. Even though some fine tuning is required where improvements have been identified.
18. A *second phase pilot project* will be launched in June 2011. In this second phase more examiners will be involved with more files per examiner. The pilot phase 2 will run over a longer time period in order to not interference too much with the normal business.
19. The objectives of the CS&E pilot phase 2 are:
 - (a) 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 further testing the methodology defined after phase 1 to identify how collaboration could be implemented in an operational environment in a wider deployment within the offices.
 - (b) To evaluate from a *qualitative* and *quantitative* point of view the benefits and disadvantages of the collaborative approach in terms of *quality* and *efficiency*. The approach towards measuring the quality and efficiency effects of collaborating in the production of the ISR and WO-ISA has been defined and agreed between the participating offices.
20. *The Meeting is invited to take note of the report.*

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