

Patent Cooperation Treaty (PCT) Working Group

Ninth Session
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COLLABORATIVE SEARCH AND EXAMINATION - THIRD PILOT

Document submitted by the European Patent Office

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 in paragraph 165(b) mentions trials of arrangements whereby examiners in International Authorities with complementary skills work together to establish a report.
2. With this aim, 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 International Authorities in different regions and with different working languages to work together on one PCT application with the aim of establishing a high quality international search report and written opinion. 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.
3. A second pilot project of a larger scale built on the lessons learnt during the first pilot project in order to allow a quantitative assessment of the approach and a fine-tuning of the operational working model. 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 and PCT/MIA/20/4).
4. The overall success of both pilots led to a preliminary proposal by KIPO, presented at the PCT Meeting of International Authorities in 2014 (paragraph 19, document PCT/MIA/21/19), to introduce the CS&E as a new PCT service. During the discussions, it was concluded that it was premature to include it in the Regulations under the PCT, as the two pilot phases only tested the

CS&E concept at operational level with a limited number of applications selected by the participating Authorities. There was no discussion on how this service could be actually implemented in the PCT.

5. The EPO conducted an in-depth and thorough internal assessment of the CS&E concept based on the results of the preceding two pilot phases. The aim of this assessment was to evaluate the CS&E concept and the possible need for a third pilot phase, and to determine the goal and methodology of a third pilot phase to fully assess the concept, including from an operational point of view. The assessment concluded that a third pilot phase was necessary in light of the results of the two earlier pilot phases and users' feedback because the concept needed to be further tested to check among others the actual business interest for such a product by applicants and the expected efficiency gains for Offices.

THIRD PILOT ROADMAP

6. At the IP5 Working Group 3 meeting in October 2015, the EPO proposed to its IP5 partners (USPTO, KIPO, the Japan Patent Office (JPO), and the State Intellectual Property Office of the People's Republic of China (SIPO)) to launch a third pilot phase with the aim of achieving the basic objectives of:

- checking users' adherence and interest for a Collaborative Search and Examination product (in particular, with respect to the expected cost of this new product, see paragraphs 21 and 22 of document PCT/MIA/22/13);
- agreeing on a common set of quality standards to be applied in the Collaborative Search and Examination project; and
- evaluating the economic value of the additional service provided by the CS&E written opinion of the International Searching Authority (WO-ISA).

7. The EPO expects that this third phase should set the basis for a decision as to the future of this concept. Test users should be directly involved in the evaluation so that the concept is looked at from different angles.

8. In October 2015, the IP5 partners agreed that discussions on this project should continue on the basis of a set of principles governing the third pilot such as: balanced workload distribution among all participating International Searching Authorities, applicant-driven approach and no possibility for an applicant to single Offices out (i.e. all collaborating International Searching Authorities will contribute to the establishment of all collaborative work products). Also, the pilot should last at least three years in order to cover the entry into the various national phases and assess the results in terms of efficiency gains accordingly.

9. The implementation of the third pilot proposal was further discussed at the Meeting of International Authorities in January 2016 (document PCT/MIA/23/12). At the IP5 Deputy Heads of Office meeting in March 2016, all IP5 Offices confirmed their interest in participating in the Collaborative Search & Examination pilot phase 3. Discussions are currently ongoing on the document that will serve as a basis for the future cooperation framework. It is intended to present such document to the IP5 Heads of Office meeting early June.

10. If there is agreement at the IP5 Heads of Office meeting in June, it is intended to start the preparatory phase of this third pilot project immediately thereafter with a view to launch the operational phase within a reasonable timeframe. The EPO will continue to report on any progress made regarding the discussions concerning that pilot at the next sessions of the PCT Meeting of International Authorities and PCT Working Group in 2017.

11. *The Working Group is invited to take note of the contents of the present document.*

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