

Patent Cooperation Treaty (PCT) Working Group

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EFFECTIVE WORK SHARING BEYOND INTERNATIONAL REPORTS: UTILIZATION OF THE WIPO CASE PLATFORM

Document prepared by the International Bureau

SUMMARY

1. The International Bureau is inviting Offices of all PCT Member States and other intergovernmental organizations acting under the PCT (including Offices in their capacity as an International Searching and Preliminary Examining Authority and/or designated/elected Office under the PCT, and in their capacity as an Office searching and examining patent applications under its national law) to take advantage of the WIPO CASE platform to provide and access search and examination information regarding national applications and international applications (during both the international and the national phase of the procedure) and related patent family applications.

BACKGROUND

2. The WIPO CASE – Centralized Access to Search and Examination system is a platform that is provided free-of-charge by the International Bureau to enable participating Offices to share dossier information related to patent search and examination results for any patent applications examined by these Offices.

3. The main features of the system (further information is available on the WIPO web site¹) are summarized below:

- (a) Offices may participate as “accessing” and/or as “providing” Offices.
- (b) Accessing Offices have access to the WIPO CASE web portal where they can search for patent applications made available by the providing Offices, view related patent family members and bibliographic data, citation data and lists of available documents, and view, download and/or print documents from the dossier of the corresponding providing Office.
- (c) The system also provides advanced features, such as notifications of new dossier content from certain Offices, side-by-side comparison of documents and an online forum where examiners can informally exchange information.
- (d) Where citation data is provided, WIPO CASE links to the cited patent document in PATENTSCOPE so that it can be easily consulted.
- (e) Providing Offices make their dossier content available either by uploading documents to the WIPO CASE document store hosted by the International Bureau, or in real-time via secure web services. The exact scope of the dossier information to be shared is determined by each providing Office. In all cases, the providing Offices only share information related to published patent applications for which the dossier content is often already available to the public through other channels. Providing Offices also supply bibliographic, classification and citation data, if available.
- (f) A linkage to the IP5 One Portal Dossier system enables the IP5 Offices to make their dossier content available to WIPO CASE via web services. The linkage is currently implemented by the patent Offices of China, Japan, Republic of Korea and the United States of America.

4. As of February 1, 2016, the patent Offices of the following countries participate in WIPO CASE as both providing and accessing Offices: Australia, Canada, China, Israel, Japan, Republic of Korea and United Kingdom. The patent Office of Brunei Darussalam has agreed to become a providing and accessing Office but has not yet begun using the system. The International Bureau also acts as a providing Office by making available all documents related to the international phase of international applications.

5. As of February 1, 2016, the patent Office of the United States of America is the only Office which participates in WIPO CASE as a providing Office only.

6. As of February 1, 2016, the patent Offices of the following countries participate in WIPO CASE as accessing Offices only: Chile, India, Indonesia, Lao PDR, Malaysia, Mongolia, New Zealand, Philippines, Singapore, Thailand and Viet Nam. Several of these Offices have agreed to also become providing Offices in the future, once they are legally, operationally and technically ready to do so.

7. Of the 20 operational International Searching and Preliminary Examining Authorities, six participate in WIPO CASE as providing and accessing Offices (the patent Offices of Australia, Canada, China, Israel, Japan and Republic of Korea), three participate as accessing Offices only (the patent Offices of Chile, India and Singapore) and one participates as providing Office only (the patent Office of the United States of America).

¹ <http://www.wipo.int/case/en/>

8. WIPO CASE has been operational since March 2011. The points below summarize the most important phases in the development of the system.

(a) March 2011 – WIPO CASE became operational for the three Vancouver Group Offices (Australia, Canada, United Kingdom).

(b) March 2013 – new Framework Provisions open up WIPO CASE for membership for all IP Offices of WIPO Member States.

(c) April 2014 – “Guideline” agreement with the IP5 Offices enables linkage between the IP5 One Portal Dossier and WIPO CASE. Japan and five other patent Offices participating in WIPO CASE participate in the pilot project.

(d) June 2015 – new Terms and Conditions simplify the governance structure and allow for public access to WIPO CASE. The IP5 Offices can now participate in WIPO CASE on the same terms and conditions as the other Offices.

9. During this time, there have also been continuous enhancements to the functionality and data content of the system. Web services were implemented in 2012 and a new web portal was deployed in 2015 to provide new functions, such as a timeline view of patent families, document comparison features, notification services and simplified navigation. A discussion forum was added and made available for testing. In parallel, work has continued on improving the data coverage in the system and on building a supporting database from the patent data of participating Offices.

10. The system is being actively used by most of the participating Offices. More than 7600 documents were accessed during the last six months of 2015; the number of documents being accessed is increasing, as more content is added from larger providing patent Offices, such as the patent Offices of the Republic of Korea and the United States of America.

11. WIPO CASE is actively promoted by the International Bureau, with the support of some providing Offices. Four regional workshops have promoted use of WIPO CASE and three national training workshops have so far been held. Several of these activities have focused on the ASEAN region as part of the International Bureau’s support for the ASEAN Patent Examination Cooperation Program (ASPEC).

UTILIZATION OF WIPO CASE TO SUPPORT WORK SHARING

12. Member States have discussed proposals to improve the sharing of information between Offices in both the international and national phases on several occasions, notably in the context of the PCT Roadmap discussions. Two of the PCT Roadmap recommendations endorsed by Member States specifically relate to the issue of using reports from other Offices to assist national search and examination (see documents PCT/WG/3/2 and PCT/WG/3/14 Rev):

“146. *Recommendation* – In relation to other reports [other than international search and preliminary examination reports], it is recommended that designated and elected Offices which conduct search and examination in the national phase should consult with the IB on ways of making their national reports available to other designated and elected Offices, either by providing the national reports for inclusion on PATENTSCOPE, or else by providing notifications that reports are available in a way which permits a link to be added in PATENTSCOPE to a national file inspection system. This should be coordinated with other activities aimed at sharing national search reports between national Offices (such as those described in paragraphs 45 to 47 of document SCP/14/3) to minimize the work involved for Offices in making the reports available and to ensure that the reports are available to other Offices as easily and effectively as possible.

“147. The IB should ensure that such reports are made available through PATENTSCOPE in a way which permits efficient access by national Offices, both by looking at the conventional web pages or using automated processes to retrieve all relevant reports. Ideally, the citations should be made available in machine-readable format so that direct links can be provided to at least the easily available cited patent documents.”

13. Since the establishment of the new Terms and Conditions for WIPO CASE in June 2015, providing Offices can authorize their dossier information to be made available to the public via WIPO CASE. The International Bureau is actively working to implement such public access. The public access will build on the search and retrieval features of PATENTSCOPE and dossier content retrieved from providing Offices via WIPO CASE will be displayed to public users through PATENTSCOPE. It is intended that this service will become available in mid-2016 and will give access to dossier content for those providing Offices which have explicitly authorized such access.

14. The WIPO CASE system can facilitate the sharing of information between Offices in both the international and national phases in several ways:

(a) During the international phase, International Authorities can access search results, search strategies and examination outputs relating to earlier national applications the priority of which is claimed in an international application. This will be of limited relevance to the International Searching Authority since, at the time of international search, any earlier applications are likely not yet to have been published. However, it may be of significant benefit to the International Preliminary Examining Authority.

(b) Although international search and examination reports are already available through WIPO CASE, and to the public via PATENTSCOPE, intermediate work products, such as search strategies and correspondence with the applicant, could also be shared via WIPO CASE if the providing Offices make these available. WIPO CASE also allows providing Offices to determine which dossier information may be made available to the public and which information can be accessed only by other participating Offices. This feature could therefore provide a medium for International Authorities not making full search strategies publicly available on PATENTSCOPE to share these strategies with other Offices.

(c) All work products produced by designated/elected Offices during the national phase procedure can be accessed via WIPO CASE. This would include the claims searched, results of any top-up searches and all other standard work products.

(d) Documents submitted for the purposes of PCT-PPH are also part of the file of the patent application and could be consulted via WIPO CASE.

(e) The online forum for exchange of information may be of benefit to the quality-related work of International Authorities.

15. The International Bureau is committed to continuing to develop WIPO CASE to enhance its functionality with a view to meeting the needs of users and to better support work sharing between patent Offices. If all International Authorities were to join the system and there were greater participation from other Offices examining patent applications, notably in their capacity as designated/elected Offices, WIPO CASE would become a valuable add-on and complement to the PCT system, providing a platform where most of the work products established during the international and national phases of the PCT procedure could be accessed through a single interface, thereby greatly reducing the practical barriers to identifying and obtaining the work products necessary to assist work sharing. In view of the importance of such a platform, the International Bureau is fully committed to continuing to actively promote and encourage more examining patent Offices to join WIPO CASE.

16. The utilization of the WIPO CASE platform to support effective work sharing beyond international reports was discussed by the Meeting of International Authorities at its most recent session, held in Santiago in January 2016. The discussions are summarized in paragraphs 27 to 31 of the Summary by the Chair (document PCT/MIA/23/14) as follows:

“27. Discussions were based on document PCT/MIA/23/2.

“28. Authorities which already had joined WIPO CASE as accessing and/or providing Offices expressed their strong support for WIPO CASE, noting its potential as the global platform to provide access to search and examination information regarding national and international applications and thus facilitating work sharing between Offices, and strongly encouraged other Authorities to join the system. Several Authorities particularly thanked the Japan Patent Office for its efforts in linking the IP5’s One Portal Dossier (OPD) platform to WIPO CASE.

“29. Several Authorities which to date had not joined WIPO CASE, or which had not joined WIPO CASE as both accessing and providing Office, stated their intention to do so in the near future.

“30. One Authority suggested to consider using WIPO CASE for the secure transfer of documents related to WIPO’s ICE (International Cooperation on Examination) service and offered to participate in any pilot in that regard. It further suggested to improve the access to existing training material on WIPO CASE on WIPO’s web site. Another Authority suggested that the International Bureau should focus on accessibility and usability of WIPO CASE as demand and use grows.

“31. The Meeting noted the contents of document PCT/MIA/23/2.”

17. With regard to the suggestion in relation to WIPO’s ICE service set out in paragraph 30 of the Summary by the Chair of the most recent Meeting of International Authorities, reproduced in paragraph 16, above, it is to be noted that WIPO’s ICE service provides expert assistance and training to patent examiners in IP Offices of developing countries and facilitates cooperation on patent examination between donor IP Offices and developing country IP Offices. Traditionally, the exchange of patent applications and search reports between the donor and recipient IP Offices has been via paper. The International Bureau is examining ways in which the WIPO CASE platform can be utilized to facilitate the exchange of documentation between offices under the ICE program and also as a tool to assist examiners in developing country IP Offices to effectively utilize search and examination results of other offices.

18. With regard to the suggestion in relation to accessibility and usability of WIPO CASE set out in paragraph 30 of the Summary by the Chair of the most recent Meeting of International Authorities, reproduced in paragraph 16, above, the International Bureau is actively monitoring the use of WIPO CASE to ensure that the system remains responsive and usable as demand grows. Additional capacity will be added to the systems as necessary and the International Bureau will continue to enhance the system to take account of users’ needs.

19. The Working Group is invited to comment on the potential utilization of WIPO CASE to support effective work sharing.

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