

SHARING SESSION REGARDING EXPERIENCES ON INTERNATIONAL WORK SHARING AND COLLABORATION

Summary

Document prepared by the Secretariat

1. The present document is a summary of a sharing session regarding experiences on international work sharing and collaboration held during the twenty-first session of the Standing Committee on the Law of Patents (SCP).
2. In total, 12 Member States made interventions during this session.
3. The Delegations of Australia, Japan, the United Kingdom and the United States of America made presentations on the experiences of their respective Offices in international work sharing and collaboration.
4. The Delegation of Australia emphasized that a work sharing was not a substitute for conducting patent search and examination in accordance with the national law of a participating office. The Delegation explained that, if IP Australia were not carrying out work sharing collaboration with other offices, the need to hire a significantly larger number of patent examiners would arise, resulting in an exorbitantly high cost for patent protection. The Delegation noted that work sharing allowed examiners to use work products of another office as a head start, and to learn from the experiences of other offices in conducting searches. work sharing also allows examiners of IP Australia to focus their efforts on complex cases first filed in Australia. Noting that 90 percent of filings in Australia are of foreign origin for which other offices had likely performed search and examination, the Delegation stated that what examiners in IP Australia would do further was to validate and complement foreign work results in order to ensure that that particular application met the requirements of Australian patent law. In that context, the Delegation stated that a process of validation was important to support quality output from its office. The Delegation also informed the Committee about work sharing initiatives that IP Australia had been involved in, such as: PCT, Vancouver Group, Global Patent Prosecution Highway and Australia-New Zealand Single Economic Market. The Delegation further highlighted the importance of technical infrastructure allowing offices to access work products of other offices, such as WIPO Patentscope and WIPO CASE. In conclusion, the Delegation noted the complexity of prior art search in certain areas of technology and stated that work sharing was an inevitable and necessary tool to ensure the efficiency of the patent system.
5. The Delegation of the United Kingdom, in its presentation elaborated on the necessity of work sharing to address, *inter alia*, backlogs in patent offices due to high number of filings around the world, difficulties in searching prior art in different languages and complexity of applications in new fields of technology that required examiners with specific skills. The Delegation stated that work sharing reduced duplication and increased efficiency. In addition, the Delegation informed the Committee that the patent law of the United Kingdom had been amended to allow sharing of applications with other patent offices before their publication. The Delegation also informed the Committee about the work sharing programs its office was participating in.
6. The Delegation of Japan made a presentation on the Patent Prosecution Highway (PPH). In particular, the Delegation elaborated on three significant benefits that PPH provided to users: (i) accelerated examination process; (ii) cost reduction due to the reduced number of office actions; and (iii) high predictability of the examination outcome.

The Delegation also emphasized that PPH was not aimed at harmonizing substantive examination.

7. The Delegation of the United States of America informed the Committee about the USPTO experience with work sharing, in particular, the PPH. The Delegation spoke about the evolution of work sharing programs, benefits of such programs, and thoroughly elaborated on work sharing pilots the USPTO was involved in.

8. The Delegation of the Republic of Korea also shared the experience of its office on work sharing and elaborated in particular on bilateral and multilateral work sharing arrangements, such as PPH, PCT collaborative search and examination, joint prior art search program and the KIPO-USPTO pilot. In addition to these programs, the Delegation informed the SCP about COBOA (collaboration before office action), which was a new work sharing initiative proposed by KIPO.

9. The Delegation of Spain also informed the Committee about the PPH agreements that its office had signed with other offices. The Delegation stressed that work sharing programs promoted quality of patents independently of the level of development of countries and their patent offices. The Delegation also discussed, *inter alia*, the impediments to effective use of search and examination results of other offices. In particular, the Delegation emphasized the need for improvement of automatic translation tools and the need to make all documents produced during patent prosecution process available through the Internet.

10. A number of other Delegations also shared their experiences in work sharing and collaboration initiatives. The Delegations of Ecuador and Ireland stated that their national patent offices also took advantage of the work product produced by other offices in conducting search and examination of national applications. In addition, the Delegation of Ireland stated that as its patent office was very small with only three examiners processing applications in various fields of technology, the decision on how to allocate resources deserved careful consideration. The Delegation noted in particular that without work sharing, it would not be possible for its office to reach a required level of quality. The Delegation also reassured that while the examiners of its office used work results of other offices, the national law was being applied. The Delegation of Paraguay also stated that its small office had been using work results produced by other offices and noted that they were very useful.

11. The Delegation of Kenya stated that in order for examiners in developing countries to be able to understand and analyze search and examination reports produced by other offices, capacity building was needed. The Delegation sought further clarifications on the question of necessity, feasibility and beneficiaries in work sharing initiatives. With respect to capacity building, the Delegation of China also stressed that it was an important prerequisite for international work sharing.

12. The Delegation of Australia, in responding to a question on necessity of work sharing, noted the growing number of patent applications filed around the world and related backlogs. The Delegation stated that work sharing was one way of resolving that problem. As regards feasibility, the Delegation referred to the possibility of accessing foreign work products electronically. The Delegation noted that IP Australia also published search strategies used by examiners in carrying out prior art search and encouraged other offices to do the same. Regarding the beneficiaries, the Delegation stated that while the first beneficiary was an applicant, the eventual beneficiary of work sharing was society as a whole, as such programs aimed to ensure that patents were not granted to inventions which did not comply with the patentability requirements of the particular country. The Delegation also informed the Committee about the initiatives IP Australia had been undertaking to build capacity of examiners from other patent offices.

13. The Delegation of Egypt sought clarification concerning usefulness of work sharing mechanisms, such as PPH, in particular for countries with different patentability criteria. The Delegations of Australia and Japan responded that such programs allowed the participating offices to have search and examination results of another office that otherwise would not have been accessible. Thus, such programs allowed the office to save time and resources in conducting its own search. Regarding differences in national laws, it was explained, *inter alia*, that practical capacity required for search and examination was similar in various patent offices.

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