

Other Bilateral and Multilateral Initiatives

With respect to other initiatives outside of expedited examination practices put into effect by IPOs within their own jurisdictions or PPH agreements, several IPOs have implemented cooperation frameworks, either bilateral or multilateral, aiming to expedite patent examination procedures and reduce pendency.

ASEAN PATENT EXAMINATION CO-OPERATION (ASPEC)¹

The Asian Patent Examination Co-operation (ASPEC) program is a regional patent work-sharing program launched in 2009 among the nine IP Offices of the members of the Association of Southeast Asian Nations (ASEAN) at the time, namely, Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand, and Viet Nam. The ASPEC program is useful for applicants keen to file multiple patent applications for the same invention in the ASEAN region. Applicants may use the written opinions² or search and examination reports issued by a participating IP Office to accelerate the patenting process in any of the other participating IP Offices.

Two new ASPEC pilot programs were further introduced in August 2019 to provide added benefits for applicants.

- (i) ASPEC Acceleration for Industry 4.0 Infrastructure and Manufacturing (ASPEC AIM)
 - Benefits to applicants: A shorter and committed turnaround time of six months to receive the first office action for an ASPEC request filed for an industry 4.0 patent applications.
 - Duration of the pilot project: Initial period of two years, starting from August 27, 2019, which was extended for 2 years until August 26, 2023.
 - Cap: Up to 50 eligible applications per year, shared between the participating IP Offices.
- (ii) Patent Cooperation Treaty ASPEC (PCT-ASPEC)
 - Benefits to applicants: An additional choice of relying on the international preliminary examination reports or written opinions under the Patent Cooperation Treaty (PCT), issued from an ISA/IPEA in ASEAN as the first IP Office, for acceleration in other participating IP Offices.
 - Duration of the pilot project: Initial pilot period of three years starting from August 27, 2019, which was extended for three years until August 26, 2025.
 - Cap: Up to 100 eligible applications per year, shared between the participating IP Offices.

To participate in these programs, applicants must have corresponding patent applications filed at the first and second participating IP Offices. It means that all claims filed in the second IP Office must sufficiently correspond to allowable/patentable claims referred to in the search and examination documents from the first IP Office. The Request for ASPEC must be supported by the search and examination documents of the corresponding application from the first IP Office.

¹ See the webpage of IPOS at <https://www.ipos.gov.sg/about-ip/patents/how-to-register/acceleration-programmes>.

² For ASPEC, a Written Opinion is an acceptable search and examination result for all participating IP Offices, except the IP Office of Thailand.

To qualify for ASPEC AIM, the patent application must be classified with an eligible IPC code relating to an Industry 4.0 invention. It should be noted that applicants are allowed to submit both the PCT-ASPEC and ASPEC AIM requests simultaneously to the participating IP Office.

COLLABORATIVE SEARCH AND EXAMINATION (CS&E)³

IPOS has established a CS&E pilot program with the Intellectual Property Office of Viet Nam (IP Viet Nam) that will provide innovators with enhanced prior art search and examination results based on the combined expertise from both IP Offices. It is designed to speed up the patent process for those interested to obtain patent protection in both countries.

The CS&E program is complimentary during the pilot duration from March 1, 2023 to February 28, 2025. Applicants will benefit from an accelerated first office action, i.e., the CS&E report will be issued within 10 months from the date of receipt of the request for CS&E.

The number of CS&E requests will be capped at 20 requests per year for an initial duration of two years. This cap is shared between IPOS and IP Viet Nam, with a further cap of two requests per month and a restriction of two requests per applicant (individual or corporate) per month. Any unutilized number will be rolled over to the following month, subject to a maximum cap of four per month.

To be an eligible application for CS&E pilot program, an applicant must first file an application in Singapore or Viet Nam, i.e., no priority claim and not a divisional application. The applicant shall file a Request for the Grant of a Patent, a Request for Search and Examination Report and a Request for CS&E on the same day. The application should contain 20 or fewer claims, including three or fewer independent claims. During the CS&E procedure, if a formalities examination adverse report is issued, applicants must respond within two weeks from its receipt.

EXTENDED COLLABORATIVE SEARCH PILOT (CSP)

The Expanded Collaborative Search Pilot (CSP) program provides applicants who cross-file with the USPTO and the JPO or the KIPO with search results from each partner IP office early in the examination process. It is designed to accelerate examination and provide the applicant with more comprehensive prior art by combining the search expertise of the USPTO and the JPO or the KIPO examiners in different languages before issuing a first Office action.⁴ In the Extended CSP pilot model, examiners of the participating Offices carry out the examination of the corresponding application concurrently, and share the examination reports each other with the partner Office. Applicants do not need to pay a fee to participate in the CSP.

The USPTO, in partnership with the JPO and the KIPO, is extending the Expanded CSP for an additional two years, through October 31, 2024. Based on the feedback received from the applicants participated in the Pilot, an enhanced petition option for participation in the Extended CSP has been introduced. In particular, the new petition modality allows an applicant to file a combined petition in either the USPTO or one of the partner IP offices rather than separate petitions in each office. Further enhancements include a more user-friendly layout, the addition

³ See the webpage of IPOS at <https://www.ipos.gov.sg/about-ip/patents/how-to-register/acceleration-programmes>.

⁴ See the published Federal Register Notice for the program: <https://www.govinfo.gov/content/pkg/FR-2023-01-18/pdf/2023-00799.pdf>. See also a presentation by the representative of the USPTO at SCP/27, which includes the Expanded CSP program, available at: https://www.wipo.int/edocs/mdocs/scp/en/scp_27/scp_27_1_cooperation_united_states_of_america.pdf.

of multilingual text, and a foundation for data collection that both satisfies the petition requirements and streamlines the process for partaking in the Expanded CSP program.⁵

The USPTO and JPO have their own dedicated Collaborative Search Program (US-JP CSP), under which the examiners of both Offices each examine an application filed with respective Offices to share search results and opinions, and expeditiously provide initial examination results to the applicant during the same time period.

A patent application filed with the JPO (hereinafter “JP application”) is eligible for the US-JP CSP if it has a corresponding application filed with the USPTO (hereinafter “US application”) and meets the requirements set by the JPO. Similarly, the corresponding US application needs to satisfy the requirements set by the USPTO.⁶ The JPO and the USPTO also accept unpublished applications into the US-JP CSP. The eligible JP application has a total of 20 or fewer claims including three or fewer independent claims. The US application must include independent claims that substantially correspond to all independent claims of the JP application. A decision as to whether the independent claims contained in the JP and US applications substantially correspond to each other will be made on a case-by-case basis. In general, when an independent claim of the JP application has the same scope as that of the US application, they are considered as substantially corresponding to each other.

Where the JP application is ready for examination, a copy of the corresponding claims of the US application must be submitted to the JPO, if the US application is unpublished at the time of when the applicant files a request for the US-JP CSP. If the JP application is not ready for examination, a JPO staff will contact the applicant, or the applicant can check the status of their application *via* either making an online viewing request or accessing J-PlatPat on the JPO website.

To participate in the US-JP CSP, the earliest priority date of the independent claims of the JP application must be the same as that of the US application. Furthermore, both the JP and US applications must have the earliest priority date or filing date of March 16, 2013 or later.

For the JP application, a request for examination must be submitted before, or at the same time as, requesting the US-JP CSP. One request for the US-JP CSP shall be filed for one application, although a group of technically related applications, consisting of five or fewer applications, can be covered in one request.

It is not possible to participate in the US-JP CSP, if the Collective Examination for IP Portfolio Supporting Business Strategy, Accelerated Examination or Super-Accelerated Examination has already been requested with respect to the same application. However, an application will still qualify for the US-JP CSP if the request is withdrawn.

THE VANCOUVER GROUP

The Vancouver Group (Australia, Canada and the United Kingdom) has been constantly sharing and collaborating on patent initiatives including application processing, quality, searching and training. In addition, CIPO stated that it has entered into many bilateral memorandums of understanding with other jurisdictions, which also include knowledge-sharing components.

⁵ Information regarding the program and the conditions of its extension can be found in the USPTO’s Federal Register concerning the initiative, at: <https://www.govinfo.gov/content/pkg/FR-2023-01-18/pdf/2023-00799.pdf>.

⁶ Information about specific requirements are available at the USPTO website: <https://www.uspto.gov/patents/search/international-protection?MURL=collaborativesearch>.