

Standing Committee on the Law of Patents (SCP)

Twentieth Session

A) Work-sharing initiatives – United Kingdom Intellectual Property Office (IPO)

Backlogs of unprocessed patent applications are steadily growing around the world as a result of increased demands on the patent system. These backlogs are associated with delays in the time taken to grant patents, which can be costly for businesses as they affect the economic benefits businesses can derive from patent rights. Backlogs also create uncertainty for third parties who do not know which patents will ultimately be granted. One factor which contributes to backlogs around the world is the large degree of duplication in the global patent system. To reduce this duplication, the United Kingdom has been pursuing a number of work-sharing initiatives with other international partners.

One of the key features of work-sharing initiatives is that if one Intellectual Property (IP) office has already performed patent processing work on an application, a second office, considering an equivalent application, will use that work to the maximum extent possible (whilst still maintaining its right to make its own final decision on the application). The aim is to reduce the amount of duplicated processing as much as possible and, by doing so, reduce backlogs.

The key work-sharing initiatives that the United Kingdom (UK) Intellectual Property Office (IPO) is currently involved in (June 2013) are set out below:

- *EPO Utilisation Scheme* – This scheme (also known as the UIP) involves the confidential sharing of IPO search and examination results with the European Patent Office (EPO) before publication of the UK application (the European Patent Convention (EPC) means the UK has a duty to share this information). The EPO examiner will consider the results when examining the equivalent European application.

- *IP Bill work-sharing clause* – The UK currently has an IP Bill before Parliament setting out legislation which would extend the IPO's scope for confidentially sharing pre-publication work with other IP offices to help reduce backlogs.
- *Patent Prosecution Highway (PPH)* - The PPH is an initiative through which applicants can significantly accelerate examination of patent applications if examination has already been conducted at another intellectual property office which is part of the PPH agreement. Under PPH agreements, if the claims of an application have been found to be acceptable by a first IP office, an applicant may request accelerated examination of a corresponding application at a second office. The IPO currently has PPH agreements with the Japan Patent Office, the United States Patent and Trademark Office, the Canadian IP Office, the German Patent and Trademark Office, and the Korean IP Office.
- *PCT Fast-track* - This enables patent applicants to request accelerated examination in the UK national phase if their international PCT application has received a positive International Preliminary Report on Patentability (IPRP), thus encouraging effective use of the International phase of the PCT.
- *PCT applications and use of IPRPs* - As part of the UK's efforts to reduce its backlogs, the IPO has been making greater use of International Preliminary Reports on Patentability (IPRPs) on PCT cases which have entered the national phase (where the IPRP has raised major objections and where the applicant has not responded to these by way of amendment or argument).
- *Vancouver Group* - The Vancouver group is a collaborative initiative with the Intellectual Property offices of Australia, Canada and the UK working together to explore how each can maximise the benefits that can be achieved from work carried out by the other offices.

- *Work-sharing through improved IT systems* - WIPO CASE is a database for information sharing which was developed by WIPO, Australia, Canada, and the UK to allow each office in the Vancouver group to use search and examination reports from the other offices. Any patent office may now join the system by notifying the International Bureau and following the procedures set out at on the WIPO website at <http://www.wipo.int/case/en/>. Work is also under way to investigate linking WIPO CASE to other relevant work-sharing platforms.
- UK-IPO/USPTO work-sharing initiative – This initiative aims to maximise the reuse of work by examiners at the UK-IPO and USPTO.
- *Examiner exchanges* – The UK-IPO participates in a wide range of examiner and information exchange activities discussing, among other issues, examiner search/examination, quality procedures, productivity, and IT systems. These exchanges facilitate more work-sharing between offices.
- *Use of search/examination reports from other offices* – Examiners at the UK-IPO routinely utilise search and examination reports from other equivalent applications which are being processed in other IP offices.

B) Use of external information for search and examination

How we search

Patent examiners at the UK-IPO search worldwide documentation to help us to decide whether patent applications are new and inventive. Most of our searching is performed online using specialist patent databases, but we also use a wide variety of other technical, non-patent databases.

Search tools

The primary search tool for UK-IPO patent examiners is EPOQUENet. Examiners also have access to other tools such as STN/CAS, EBI-EMBL, IEEE Xplore and Springer Link for use whenever considered appropriate.

Typical search resources include, but are not limited to, Derwent World Patent Information, European Patent Office's global patent documentation abstract

collection, patent document full-text including translations to English of Chinese, Japanese and Korean language publications, Elsevier Science Direct, Springer Journals, BIOSIS, Inspec, MEDLINE, PUBCHEM, Traditional Chinese Medicine, Traditional Knowledge Digital Library and other traditional knowledge resources, IBM Technical Disclosure Bulletin, Society of Exploration Geophysicists Digital Library, Institute of Physics Journals, American Institute of Physics Journals, various standards including telecommunications and engineering, Institute of Electrical and Electronic Engineers Journals, and IP.com.

Quality

Our use of such a broad range of databases means that we are confident in the thoroughness of our searches. In order to confirm this quality, we have an internal quality-assessment programme that samples applications throughout processing.

We believe that using leading edge search tools results in high quality searches and granted patents that have a high degree of validity, a claim which is supported by our ISO 9001:2000 certification.

Transfer of Technology

The global exchange and development of technologies is crucial to economic growth and the wellbeing of societies in all countries. It is important to recognise the critical role of the private sector in enabling the dissemination of technologies. Private sector organisations are good at adapting existing technologies to meet local and regional needs, and investing in the people and knowledge required to build sustainable businesses. They can do this most effectively in the right investment climate: which usually means a combination of reasonable regulations, infrastructure, property rights (including intellectual property rights), market access, tax system and transparent bureaucracy. Governments play a key role in building this investment climate, as does civil society in ensuring that policies are a fair reflection of the public interest. Technical assistance and capacity-building is available from many developed countries and international organisations.

The UK seeks to promote the conditions for more and better targeted transfer of technologies through its international development policies (more details at this link: <https://www.gov.uk/government/policies/helping-developing-countries-economies-to-grow/supporting-pages/helping-developing-countries-to-remove-barriers-to-trade-and-investment>). For example, a recent speech by the UK International Development Secretary, Justine Greening, explains the role of social impact investment in driving innovation in development countries (<https://www.gov.uk/government/speeches/g8-impact-investment-event>).