



## **Proposal for Collaborative Search and Examination (CSE) in the PCT**

### ***The proposal and the Federation's expectations of it***

Collaborative search and examination (CSE) has been the subject of prolonged support by the Federation, beginning with a presentation by a Vice-President in June 2007 at an international *Colloquium on Patent Quality* in Amsterdam, and in 2012 involving contributions by the President at similar events in London and Warsaw. Since 2010, support for CSE has been given also by the International Chamber of Commerce (ICC), which has been valuable because of ICC's relationship with WIPO.

The proposal is that, as part of the PCT procedure, applicants will have the extra-cost option (at least so long as the text is in English) of requesting that the IP5 Offices<sup>1</sup> perform search and examination collaboratively, instead of search and examination by a single ISA. If in this process, the Offices have "shot their bolt", then the current significant risk, that an applicant will go into the regional / national phases only to find that "new" pertinent art is cited, will be largely avoidable. The proposed process will also reduce the likelihood that the applicant will obtain grant in (say) Europe and USA (being the only countries of commercial interest to him) only to find that his patent is unenforceable because of art that the other IP5 Offices would have found if he had filed there.

It is envisaged that some of the Federation's members would use PCT CSE, once offered, on a routine basis, while other members would use it only for more important inventions. Outside the UK, despite the ICC involvement, there is somewhat less awareness of the proposal for PCT CSE, so initial take-up by non-UK applicants might be proportionately less. Any applicant deciding to take up PCT CSE might phase in its use, to avoid an excessive initial cash flow problem. However, it is expected that in "steady state", once savings on older applications were compensating extra initial costs on current applications, applicants would save money by use of PCT CSE because of improved filing and prosecution effectiveness and efficiency (through abandonment at the national / regional phases of cases that formerly would have proceeded, and through worldwide consistent claim amendment, subject to any differences of law).

Overall, taking the considerations in the previous paragraph into account, the Federation forecasts that, if PCT CSE were offered, it would immediately be used at a level sufficient to make it an obvious success, but that it would take some years for usage to reach a plateau.

### ***The EPO–USPTO–KIPO pilot study of PCT CSE***

While the Federation has always been confident of the merits of this proposal, and indeed presented both anecdotal evidence and research results to support it in 2007, IPOs have quite properly sought independently to satisfy themselves (and others) of those merits. To this end, a pilot study was begun under EPO management in June 2010. In this study, the EPO, the USPTO, and KIPO conducted PCT search and examination collaboratively, with one of the three offices taking the lead on any particular application and the other two acting

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<sup>1</sup> The EPO, the USPTO, the Japanese Patent Office (JPO), the Korean Intellectual Property Office (KIPO), and the Chinese Intellectual Property Office (SIPO).

in support. The study is now complete and the EPO's preliminary report of the study is very encouraging. The Federation draws the following conclusions:-

- (1) *As the Federation members' anecdotal evidence and research results of 2007 had suggested, a collaborative search between IPOs delivers a substantial improvement in quality (offering improved filing and prosecution effectiveness and efficiency to applicants).*

Evidence for (1) from the study: When the EPO took the lead and the other two offices were in support, 87 % of applications had citations added, and in 27 % of applications the WO-ISA was amended, with the lead examiner considering that 92 % of the final ISRs and final WO-ISAs had been improved. When the EPO was in a supporting role, EPO examiners (a) observed that the lead examiner amended the WO-ISA in 50 % of cases and that 63 % of the final ISRs and WO-ISAs were improved, (b) considered that, if the PCT application subsequently entered the EP regional phase, they would they need to perform additional searches in only 2 % of cases, and (c) considered that both search and examination was trustworthy for EPC examination in 70 % of cases.

- (2) *The cost to applicants of an all-IP5 PCT CSE, minus any rebates that might be given in the national / regional phases, promises to be a small multiple of search and examination by a single ISA.*

Evidence for (2) from the study: EPO lead examiners spent from 15-25 % more time in CSE than in independent search and examination. The time needed for EPO support examiners was small (in 50 % of cases, the extra search effort was less than 10 % of an independent search). As already noted under (1), the PCT CSE would save time in the national / regional phases. The EPO suggests that better efficiency should be achievable in real implementation; in real implementation, the IT support would be better, and protocols would have been developed to improve handling of law differences such as on medical inventions.

### **Next steps**

The IPOs (including the JPO and SIPO, not involved directly in the study) need to satisfy themselves that they can cope with the workload that PCT CSE would generate. The Federation's view (compare the advantages for applicants) is that in steady state the savings in the national / regional stages resulting from previous PCT CSE would tend to offset the extra workload involved in PCT CSE. The likely profile of demand which the Federation predicts (see the final paragraph of the first section of this report) suggests that there will be no major initial shock for IPOs when PCT CSE is first offered, but instead an initial modest increase in work followed by a progression to an acceptable steady state. The three Asian IPOs may conceivably need to take advantage of the time before the plateau of demand is reached to increase the number of examiners who are happy not only to examine an English text but also to communicate with collaborators in English.

The EPO, the USPTO, and KIPO will shortly be preparing an official report for a meeting of the heads and deputy heads of the IP5 offices. **The Federation is most grateful to the EPO, the USPTO, and KIPO for their work, and commends the individual examiners involved.** The Federation encourages further developments.

WIPO is firmly of the view that "CSE should be part of the future of PCT". The Federation believes that PCT CSE will be the biggest single improvement in the PCT since it came into force in 1978.

Mike Jewess, 4 November 2012