

WIPO pilot projects on collaborative search and examination

Introduction

The Federation represents IP intensive companies in the United Kingdom - a list of members is attached. Our member companies are extensively involved with IP in Europe and internationally. Not only do our companies own considerable numbers of IP rights, both in Europe and elsewhere, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions, here and elsewhere.

Collaborative Search and Examination

The Federation notes [PCT/WG/4/15](#) of 20 May 2011 reporting WIPO's Collaborative Search and Examination (CS&E) Pilot Project, and the EPO's commentary on this dated 20 October 2011. A second pilot project is in progress.

The EPO observes that the CS&E concept originated in a proposal made by industry, and asks for reassurance that it is still supported by industry. As one of first industrial organisations that made such a proposal in 2007,¹ the Federation now confirms the following:

- (i) The Federation considers that applicants and others would benefit greatly from the option of a PCT search done within 30 months of the priority date which was *at least as good* as the combination of the searches done independently by each of the IP5 offices at present (but mostly at later than 30 months). If properly coordinated, with each office not only searching to its linguistic and other strengths but also challenging the other offices' search strategies, *such a search should be better*. It is assumed that all five IP5 offices would be prepared to search on the basis of a text in English.
- (ii) Such a search, if available, would be chosen by some of our members for PCT applications on important inventions only, and by others for most inventions, provided that the cost was a modest multiple of the present ISA search as the pilot studies so far suggests it would be.

¹ *Colloquium on Patent Quality*, 8-9 June 2007, organised by the American Intellectual Property Lawyers' Association (AIPLA) and the Fédération des Conseils en Propriété Industrielle (FICPI): presentation by the Federation Vice-President Dr Michael Jewess entitled "Timely comprehensive search – what applicants need but do not have", available at:

<http://www.aipla.org/resources/intlip/Pages/FICPI-AIPLA-Colloquium-Transcript.aspx>

- (iii) Where an application which had been subjected to such a search entered the regional/national phases at the IP5 offices, the Federation would expect:
 - (a) that no additional art would be cited save in exceptional cases, and
 - (b) that a partial or total refund of the fees from the regional / national offices would be due (compare the present practice of the EPO).
- (iv) The search would in the Federation's opinion lead to some patent applications which currently enter the national and regional phases not so doing. This is good:
 - (a) for the applicants, saving cost;
 - (b) for the Offices, helping with backlog reduction; and
 - (c) for third parties in reducing uncertainty as to their commercial freedom.

The Federation looks forward to the completion of the second pilot project.

IP Federation
6 January 2012

IP Federation members 2012

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. Its Council also includes representatives of the CBI, and its meetings are attended by IP specialists from three leading law firms. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

ARM Ltd
AstraZeneca plc
Babcock International Ltd
BAE Systems plc
BP p.l.c.
British Telecommunications plc
British-American Tobacco Co Ltd
BTG plc
Caterpillar U.K. Ltd
Delphi Corp.
Dyson Technology Ltd
Eli Lilly & Co Ltd
ExxonMobil Chemical Europe Inc
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Hewlett-Packard Ltd
IBM UK Ltd
Infineum UK Ltd
Merck Sharp & Dohme Ltd
Microsoft Limited
Nokia UK Ltd
Nucletron Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
Procter & Gamble Ltd
Rolls-Royce plc
Shell International Ltd
Smith & Nephew
Syngenta Ltd
The Linde Group
UCB Pharma plc
Unilever plc
Vectura Limited