



Third and final pilot for “PCT-IP5” search / “CS&E”

The ultimate objective, now in sight

Subject to the successful conclusion of a third and final pilot, begun on 1 July 2018 (details in next section of this report), it is hoped that, in a few years' time, all PCT applicants will be offered a procedural option providing for -

one of the IP5 offices (European, US, Japanese, Chinese, and Korean) to act as a “main ISA” leading a *collaborative exercise*, the result of which will be that the main ISA issues a search report and written opinion in Chapter I based on both its own work and on inputs from the other four offices (called “peer ISAs”).

Such a collaborative exercise is currently officially called “collaborative search and examination (CS&E)”; but to avoid possible confusion with other initiatives (and possible future renaming), in this report the exercise will be called “PCT-IP5 search”.

The Federation, relying on evidence of the weaknesses of the present systems for international patenting, has been urging the introduction of PCT-IP5 search since 2005,¹ and two smaller pilots have produced encouraging results. The Federation is grateful to the International Chamber of Commerce for having supported it.²

Provided that the IP5 offices collaborate with a healthy degree of mutual criticism and competition, it is expected that applicants will in all probability enter the regional / national phase (30 months after the priority date) with a good knowledge of the prior art, such as presently often emerges only much later, either in prosecution or in litigation. In most cases, the applicant entering the regional / national phase of the PCT should find that offices do not cite additional prior art.³

It is to be emphasised that the aim in PCT-IP5 search is *not* mutual recognition of searches between the five offices, for it is known that no single office can be expected reliably to produce a comprehensive search. Rather, the aim is to take early advantage of each office's strengths in databases, language skills, and searching strategies.

Whenever applicants take up the option of PCT-IP5 search, the following practical advantages are expected:

¹ *Trends and Events*, 2004/5, pages 16-17; “Timely, comprehensive search – what applicants need but do not have”, presentation by TMPDF Vice-President, AIPLA Colloquium on Patent Quality, Amsterdam, 8-9 June 2007,

<https://www.aipla.org/resources2/intlip/Documents/AIPLA%20Documents/6-TMPDF-Jewess.pdf>;

Trends and Events December 2010, page 21; *Trends and Events* December 2012, pages 32-33.

² ICC documents 450/1056 of 28 June 2010 and 450/1072 of 6 April 2012.

³ The national and regional offices will nevertheless apply their own law on (i) eligibility of the prior art already cited in the PCT-IP5 search, (ii) obviousness, and (iii) exclusions from patentability.

- (i) Applicants will save time and money on applications that are abandoned or amended earlier than would otherwise have been the case. They will also have (commercially significant) greater confidence in the enforceability of their granted patents.
- (ii) Third parties will be able to make an earlier assessment of the likely valid scope of competitor patents.
- (iii) Although IP5 offices will have to expend extra effort in operating collaboratively rather than independently, and although work will be more front-loaded, *in steady state and overall, offices' workloads should be diminished because fewer official actions will be necessary.*
- (iv) Those non-IP5 offices which currently rely heavily on the PCT search and written opinion will be able to rely on a better-quality product.

It is believed that when PCT-IP5 search is offered as an option⁴ for all applicants in the PCT international phase Part I, this will be the single biggest procedural improvement in the PCT since it began in 1978.

The pilot

The pilot began on 1 July 2018. The WIPO announcement, including a new form, is at -

<http://www.wipo.int/pct/en/filing/cse.html>,

and the individual IP5 offices are issuing notices on their own provisions for the pilot. Each office will, as a "main ISA", accept 100 patent applications for the pilot over two years.⁵ Applicants will have to volunteer applications on the form. Main ISAs will choose their 100 applications from those volunteered so as to ensure a representative sample for monitoring. Until 31 December 2018, only PCT applications in the English language will be accepted for the pilot, but thereafter it is expected that procedures for applications not in English will be introduced.

The official fee for a PCT-IP5 search in the pilot will be the same as a single ISA fee.

Accordingly, those Federation members who envisage benefiting from eventual full implementation of PCT-IP5 search should seriously consider volunteering applications for the pilot.

The full implementation within the PCT (i.e. PCT-IP5 search offered to all applicants)

The 500 PCT applications in the pilot will be monitored into their regional / national phase, so that (it is hoped) the option of PCT-IP5 search can in due course be offered to all PCT applicants with confidence that advantages (i) to (iv) referred to above will be achieved.

The official fee in full implementation will be some multiple (to be determined) of a single-ISA search, and rebates of regional / national fees will have to be determined also. Applicants will decide whether the likely cost savings and commercial advantages under (i) above justify the net extra cost in official fees compared with a single-ISA search.

The Federation, all the more for being the originator of this concept, will in due course be making its own assessments of the pilot and of the proposals on procedure and fees in the full implementation.

Michael Jewess, 2 July 2018

⁴ Note that it will be *only* an option. Applicants will still be able to select a single-ISA search in the international phase.

⁵ Each office will also, therefore, act as a "peer ISA" for 400 other patent applications.