

Pilot project between the IP5 Offices on collaborative search and examination under the PCT

I. Concept

1. Following the first and second pilot projects on collaborative search and examination (“CS&E”) under the PCT conducted by the European Patent Office (EPO), the Korean Intellectual Property Office (KIPO) and the United States Patent and Trademark Office (USPTO), respectively in 2010 and in 2011-2012, the EPO, the Japan Patent Office (JPO), the KIPO, the State Intellectual Property Office of the People's Republic of China (SIPO) and the USPTO, referred to as the IP5 Offices, will operationally launch a third pilot project on CS&E with a view to further developing and testing that concept amongst the IP5 Offices (hereinafter “the pilot project”). In particular, this IP5 pilot project aims at assessing the users’ interest for a CS&E product and the expected efficiency gains for Offices.

2. The concept of CS&E under the PCT refers to the collaboration of examiners from different International Authorities in different regions and with different working languages on one international application for the establishment of an international search report and written opinion under PCT Chapter I, which, although remaining the opinion of the chosen International Search Authority, is based on contributions from all participating Offices.

3. Under the pilot project, the examiner of the IP5 Office acting as competent International Searching Authority under Rule 35 PCT for a given international application (“the main examiner”) works on the application as for any other international application by conducting the search and examination and by establishing a provisional international search report and written opinion. These provisional work products are transmitted to examiners from the other participating IP5 Offices in their capacity as an International Searching Authority (“the peer examiners”). Each peer examiner provides the main examiner with his contribution, in the light of the provisional international search report and written opinion. The final international search report and written opinion is subsequently established by the main examiner after having taken into consideration the contributions of the peer examiners. Further details regarding the implementation of the CS&E concept within the framework of this pilot project are provided below.

II. Framework

4. Under the pilot project, with a view to assessing the users’ interest for a CS&E product, international applications processed under the collaborative scheme will be selected by the applicants (“applicant-driven approach”), whereas under the two previous pilot projects the applications were selected by the Offices.

5. Applicants wishing to participate in the pilot project must submit a request for participation in the pilot on a standard participation form and file it together with the international application at the receiving Office of one of the IP5 Offices or the International Bureau of the World Intellectual Property Organization (WIPO). The participation form is available in all official languages of the IP5 Offices on WIPO’s website at <http://www.wipo.int/pct/en/filing/cse.html>

6. For international applications filed in English, requests for participation in the pilot may be filed as from 1 July 2018. Each applicant will only be able to select a limited number of international applications.

7. Until 31 December 2018, only international applications filed in English will be accepted into the pilot. After that date, the competent International Searching Authority under Rule 35 PCT for a given international application (also referred to as “the main International Searching Authority”) may also accept international applications filed in a language other than English. Each main International Searching Authority which will accept international applications filed in a language other than English will inform the applicants accordingly by a communication

published on its website. Such communication will specify the additional languages which will be accepted by a main International Searching Authority for the purposes of this pilot and the date as of which requests for participation in the pilot may be filed in such languages, and provide explanations regarding their acceptance and processing.

8. The receiving Office will transmit the participation form to the International Bureau and the main International Searching Authority as part of the record copy and search copy, respectively. Upon receipt of the search copy, the main International Searching Authority will determine if the request for participation in the pilot may be accepted. The main International Searching Authority will therefore assess whether the applicable requirements detailed below in part III are met and notify the applicant and the International Bureau of the acceptance or refusal of the request for participation in the pilot. Form PCT/ISA/224 (Communication in Cases for Which No Other Form Is Applicable) will be used for that purpose.

9. The main International Searching Authority will perform the search and examination as for any other international application not processed under this pilot. It will establish a provisional international search report (Form PCT/ISA/210) (or, where appropriate, declaration of non-establishment of international search report (Form PCT/ISA/203)) and written opinion (Form PCT/ISA/237), and, where applicable, a record of the search strategy. The form and content of the record of the search strategy will generally be according to the current practice of each International Searching Authority.

10. The main International Searching Authority will transmit the above mentioned provisional work products to the peer International Searching Authorities, where a peer examiner will prepare a contribution to the final search product, taking into consideration the provisional work products prepared by the main International Searching Authority and performing additional searching to the extent deemed necessary.

11. With respect to the handling of non-unity cases by the peer International Searching Authorities, the principle of the first invention will be followed. This means that each main International Searching Authority proceeds with the non-unity procedure according to its own standard practice, whilst the provisional work products submitted to the peer International Searching Authorities are based only on the invention first mentioned in the claims. Peer examiners will focus their searches on what they determine to be the first invention, regardless of whether the provisional work products are directed to one or more inventions.

12. Each peer International Searching Authority will transmit its contribution to the main International Searching Authority using a standard peer contribution form. Depending on their practice, the peer International Searching Authorities will either record its contribution directly on the peer contribution form or use the peer contribution form as a cover sheet to the standard forms PCT/ISA/210 and PCT/ISA/237¹. Peer contribution forms and peer contributions attached to such forms, if any, will be made available as separate documents in PatentScope².

13. The main International Searching Authority will consider the contributions received from the peer International Searching Authorities and prepares the final international search report (Form PCT/ISA/210) (or, where appropriate, declaration of non-establishment of international search report (Form PCT/ISA/203)) and written opinion (Form PCT/ISA/237) in the light of these contributions. The main International Searching Authority will strive to establish these final work products within the time limit under Rule 42.1 PCT, however compliance with this time limit may not be guaranteed due to the collaborative nature of the pilot project which inherently results in additional administrative burdens. The final work products will be transmitted to the applicant and the International Bureau.

¹ JPO provides its contribution using the standard forms PCT/ISA/210 and PCT/ISA/237.

² Peer contributions provided by peer ISA are published in PatentScope.

<https://patentscope.wipo.int/search/en/search.jsf>

14. Final CS&E work products will be identified either by a direct indication in box V of Form PCT/ISA/237, or at the top of a supplemental sheet referenced in the said box, as the result of the collaboration under the pilot which does not necessarily reflect the opinions of all IP5 Offices. Only a final CS&E work product may serve as a basis for requesting participation in a Patent Prosecution Highway (PPH) pilot programme.

15. All exchanges of documents and information among Offices will be carried out via an ePCT based platform allowing a secure and confidential data transmission. This ePCT based platform is provided and maintained by the International Bureau.

16. In this pilot project, the level of the international search fee charged by each IP5 Office remains unchanged. Applicants participating in this pilot will therefore only pay the standard fee for a PCT Chapter I search at the competent International Searching Authority. However, if following this pilot the CS&E product is implemented as a regular product under the PCT³, applicants will have to pay a specific fee for such product (the CS&E fee)⁴. The maximum prospective amount of the CS&E fee is the aggregated amount of the search fees of the participating International Searching Authorities plus an administrative fee to cover the collaboration costs.

17. Towards the end of the pilot project, applicants having participated in this pilot will be asked to complete a questionnaire about their interest for a regular CS&E product under the PCT. The applicant's replies will be taken into account by the IP5 Offices in the assessment of the pilot project.

III. Requirements for participation

18. The requirements for applicants' participation in the pilot project are of two kinds: requirements to be met by applicants and limitations set by Offices.

A. Requirements to be met by applicants

19. The following requirements must be met by applicants wishing to participate in the pilot project:

- (a) The request for participation in the pilot must have been submitted on the standard participation form⁵ and filed together with the international application.
- (b) The participation form and the international application must have been filed at the receiving Office of one of the IP5 Offices or at the International Bureau as receiving Office⁶.
- (c) Where the participation form and the international application are filed with the JPO, they must have been filed in electronic form using any of the following filing tools: The Internet Application Software.
- (d) Until languages other than English are accepted into the pilot as provided for under paragraph 7, the participation form and the international application must have been filed in English.

³ It is not determined whether the CS&E product will be implemented as a regular product under the PCT after the pilot or not.

⁴ Applicants don't have to pay CS&E fee during the pilot.

⁵ Request to Participate in the IP5 PCT Collaborative Search & Examination Pilot

⁶ When applicants choose JPO as main ISA, applicants have to choose JPO, USPTO or WIPO as receiving office.

B. Limitations set by Offices

20. The following limitations related to organisational aspects of the pilot must be complied with for the main International Searching Authority to accept a request for participation in the pilot:

- (a) The applicant must not already have had ten international applications accepted in the pilot by the same main International Searching Authority, ten being the maximum number of applications permitted into the pilot per applicant at a same main International Searching Authority.
- (b) Each main International Searching Authority aims to accept 100 international applications into the pilot, spread over the course of two years. The main International Searching Authority will accept applications based on achieving this aim.

IV. Duration

21. The pilot project is divided in two phases, a preparatory phase and an operational phase. The preparatory phase started on 2 June 2016 and was dedicated to the administrative and practical preparations required for a smooth functioning of the pilot. The operational phase will start on 1 July 2018 and will be dedicated to the processing of applications under the collaborative scheme, the monitoring of applications for evaluation purposes and the assessment of the outcome of the pilot. The operational phase will last until 1 June 2021 and will also cover the assessment of the effect of the collaboration in the subsequent national/regional phases.