

IP5 STRATEGY ON TIMELINES

IP5 Heads/Industry meeting

Alfred Spigarelli
Patent Procedures Management
DG1 Business Services

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Background

4th IP5 Heads meeting in June 2011 in Tokyo agreed:

- timely issuance of first office actions is essential for efficient work sharing between OFF and OSF
- IP5 offices should progressively prioritise or accelerate OFF first office actions

IP5 Deputy Heads meeting 15th and 16th May 2012 in Munich:

- mandated EPO to define a strategy for timeliness to optimise work sharing

Strategy for timely exchange of search results between OFF and OSF should:

- **acknowledge the different examination regimes in IP5 offices**
- **aim at reaching a balanced situation between the offices when acting as OFF based on reciprocity principles**

General principles

Objectives:

- Quality: enhance the legal certainty through sharing search results
- Efficiency: minimise the unnecessary duplication of work

Basic principles:

- For some offices search results should be available at the latest for the 18 months publication
- OFF results should be available at 15 months for re-use by OSF publishing the search report with the application at 18 months
- Reach the right balance between applicants and public interests

This seems to mainly address patent offices responsibility toward public interests

However, to a large extent these concerns should be/are also shared by the applicants

Timely issuance of search results by the OFF

**EPO proposal discussed yesterday in the IP5 Deputy Heads meeting
(no agreement yet):**

OFF search results for the first filings identified by OSF should be available:
15 months after the priority date.

**Fair share between OFF and OSF of the time available between end of
priority period and A-publication**

Requires:

- OSF informs OFF that search results are required
- OFF prioritises these prior art searches

Top priority is the transmission of prior art citations from OFF to OSF :

- Confidentiality requirements of published citations lower
- Citations are the key to work sharing

No one-fits-all solution

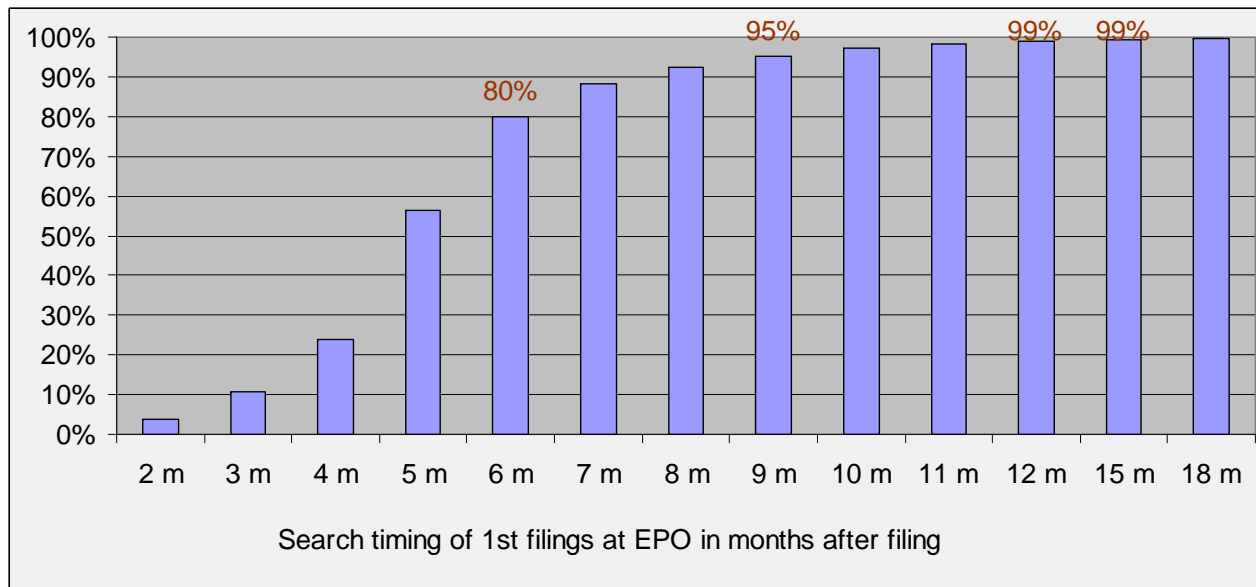
Different policies for different examination regimes

- All Offices currently prioritise according to legal provisions, internal administrative measures and political decisions
 - **it is proposed to add requirement to prioritise 1st filings for OSF**
- JPO, KIPO and SIPO additionally practice deferred examination

However, work sharing between IP5 Offices should progressively evolve toward a more effective scheme fed by all offices contributions

Current timelines situation at EPO

- **First Filing Search Report** and WO available average 6 months after filing
- 99% of search reports and WO for 1st filings available at 15 months



- **Second filing Search Reports** produced on average 26 months after priority
- However, **strategic aim to produce all SR for the 18 months publication** - currently 40% before 18 months

Accompanying measures

- Proposed work sharing strategy based on **reciprocity principle**
 - only effective if balanced exchange of search results is achieved
 - May not be possible from the beginning but progressive improvements are necessary
 - Monitoring of work sharing and results to be reported annually
- The additional effort required for prioritising 1st filings used for priority claim in other IP5 offices is a **good investment for reducing backlogs** - leverage (saving) effect due to feedback from other offices on 1st and 2nd filings
- Efficient handling of notifications between OSF and OFF requires IT support

On-going pilots: FLASH (USPTO as OFF)

Different work sharing strategies tested with different effects on timeliness:

FLASH:

- USPTO informed by an IP5 OSF that a 2nd filing claims US priority,
- USPTO prioritises the search and examination of this 1st filing
- Flash is office-driven, no applicant intervention needed (apart for unpublished applications)

JP-FIRST

- JPO prioritises applications with 2nd filing where request for application received before 24 months

EPO-SIPO

- SIPO prioritises First Filings for EPO Second Filings, and
- encourages applicants to request examination

IP5 Strategy for Timeliness (Paris Route)

Start of a challenging journey:

- Effective work sharing to be based on reciprocity and balanced exchange of search results on 1st filings in a timely manner
- Work sharing should support production of search results for:
 - **first filings** used for priority claim at the latest at **15 months**, and
 - **second filings for the 18 months** publication (where applicable)
- Effective work sharing strategy must **incorporate both office-driven and applicant-driven measures** with tailor-made solution for accommodating office-specific constraints in particular for deferred examination offices

Conclusion

- **Timeliness in work sharing is discussed since the early days of IP5**
- Experience gathered in the different on-going pilots evidences a need for a more focussed policy
- **EPO proposal is not the end but just the beginning of more concrete discussion**
- This discussion will continue at Working Group level and should **take due account of needs expressed by users**