Work-sharing in the Unpublished Phase

2nd IP5 ICG Meeting | 1 February 2018 | Tokyo
IP5 offices have built the OPD and have been operating the IP5 PPH program in order to reduce duplicate work with respect to family applications.

As a result of reduced backlogs, accelerated examination and initiatives for shortening pendency, the examinations in the unpublished phase at each office has been increased.

However, information sharing among offices in the unpublished phase is limited due to their domestic laws.

From the perspective of offices and users, the high-quality and efficient examination is required for family applications as they are filed in multiple countries.

Work-sharing in the unpublished phase needs to be considered and discussed.
IP5 Heads and Industry representatives discussed the work-sharing in the unpublished phase, ‘New Stage of Work-sharing’, as one of strategic topics | IP5 Heads and Industry meeting, Valletta, May 2017.

KIPO presented a proposal for work-sharing in the unpublished phase including (a) updating amendments to laws/rules and (b) improving the GD family service with no amendment of laws/rules | IP5 WG3 meeting, Tokyo, Nov. 2017.

- Because the amendment of laws/rules may take time, we proposed two track approach (a, b) which runs in parallel.

- The USPTO will update the document regarding work-sharing in the unpublished phase at each office which was compiled in 2014.
# Current Status on Exchange of Unpublished Information

## Type of Exchanged Information

<table>
<thead>
<tr>
<th>Relevance to Invention Information</th>
<th>Strong</th>
<th>Medium</th>
<th>Weak</th>
</tr>
</thead>
<tbody>
<tr>
<td>Invention info.</td>
<td>CSP</td>
<td>CSP</td>
<td>CSP</td>
</tr>
<tr>
<td>Examination info.</td>
<td>CSP</td>
<td>CSP</td>
<td>CSP</td>
</tr>
<tr>
<td>Search info.</td>
<td>CSP, Rule 23bis PCT, EPC R141</td>
<td>CSP, Rule 23bis PCT, EPC R141</td>
<td>CSP, Rule 23bis PCT, EPC R141</td>
</tr>
<tr>
<td>Classification info.</td>
<td>Rule 23bis PCT</td>
<td>Rule 23bis PCT</td>
<td>Rule 23bis PCT</td>
</tr>
</tbody>
</table>

### Notes:
- **Invention info.**
  - Priority document (IP5)

- **Examination info.**
  - CSP (JPO/KIPO/USPTO)

- **Search info.**
  - CSP, Rule 23bis PCT, EPC R141 (JPO/KIPO/USPTO, PCT RO, JPO/KIPO/USPTO)

- **Classification info.**
  - Rule 23bis PCT (PCT RO)
# Requirement for Exchange of Unpublished Information

<table>
<thead>
<tr>
<th>Organization</th>
<th>Requirement</th>
</tr>
</thead>
<tbody>
<tr>
<td>EPO</td>
<td>Working agreement</td>
</tr>
<tr>
<td>JPO</td>
<td>Explicit permission from applicants</td>
</tr>
<tr>
<td>KIPO</td>
<td>Working agreement</td>
</tr>
<tr>
<td>SIPO</td>
<td>No information except priority document</td>
</tr>
<tr>
<td>USPTO</td>
<td>Explicit permission from applicants</td>
</tr>
</tbody>
</table>

*Modified from the USPTO’s presentation, “Exploring Information Exchange Among Unpublished Applications” in WG3 2014*
**Background**

- KIPO observed problem cases where GD family service does not cover all the information available especially with the application in the unpublished phase.

**Proposal**

- Providing the expanded family information through GD family service (OPS)
  - by expanding family information with unpublished application number in the patent grant publication; or
  - by establishing family information with cross-filing information (e.g. application number, priority number, etc.) which could be exchanged by the IP5 offices at the earliest stage possible like when the applications are accepted.
IMPROVEMENT ON GD FAMILY SERVICE (2018 IP5 WG2)

Concept of the proposal

Proposed family info. : No amendment of laws/rules

Current family info.

- P: Published
- UP: Unpublished

Family applications
- : Family applications
- : Family applications where patent publication includes unpublished application number

Maximum family info. : Amendment of laws/rules required

- UP: Unpublished
- P: Published
- KR
- EP
- US
- JP
- CN

Current family info.

Proposed family info. : No amendment of laws/rules

 UP
 KR

 UP
 JP

 UP
 EP

 UP
 US

 P
 EP

 P
 US

 P
 JP

 P
 CN

 P
 KR
Example

1) Patent grant number: **US 9,554,041 B1**
2) Unpublished provisional application number: **US 62/276,251**
3) Unpublished application number in examination: **KR 10-2016-0008917**

- **(Problem)** KIPO examiner can not see the US patent grant via the OPD.

- **(Solution)** Building family information with the numbers above.

**Related U.S. Application Data**

- Provisional application No. 62/276,251, filed on Jan. 8, 2016.

**Foreign Application Priority Data**

- Jan. 25, 2016 (KR) .......................... 10-2016-0008917
Benefit for offices

- Offices can enhance examination result in the unpublished phase by building additional family information.

  * We observed that with 285 applications, KIPO examiners could use work products (patent grants) of the JPO and the USPTO published in 2016.

  * Comparable figure: Number of PPH/PCT-PPH requests at KIPO with work products from the JPO and the USPTO published in 2016 is 2,763.

Benefit for applicants

- Examiner can see positive result from other offices without applicants’ explicit submission of PPH request and response to office action, etc.
(Point 1) We would like to hear users’ comments on the improvement on GD patent family service.

(Point 2) We would like to hear users’ comments on expanding work-sharing in the unpublished phase with potential amendment of laws/rules at the IP5 offices.

- Search & classification information is the most important in work-sharing.
- However, current practices on exchange of unpublished information are allowed only when specific conditions are met. 
  e.g.) petition for CSP, Rule 23bis PCT, EPC R141
- We therefore would like to discuss a more comprehensive and streamlined approach with users.
point 3) If a comprehensive work-sharing in the unpublished phase among IP5 offices is introduced, what options would be preferred by users and offices?

- (Type of info.) Examination info. / Search info. / Classification info.

- (User’s permission) Without permission / With permission (Opt-out/Opt-in)
Thank you!