IP5 STRATEGY ON TIMELINES

IP5 Heads/Industry meeting

Alfred Spigarelli
Patent Procedures Management
DG1 Business Services

Porticcio, 5th June 2012
**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