

Citation of prior art - Current status & next steps -

IP5 WG2 & GDTF Meeting | 14-17 January 2019 | Hague



Korean Intellectual Property Office



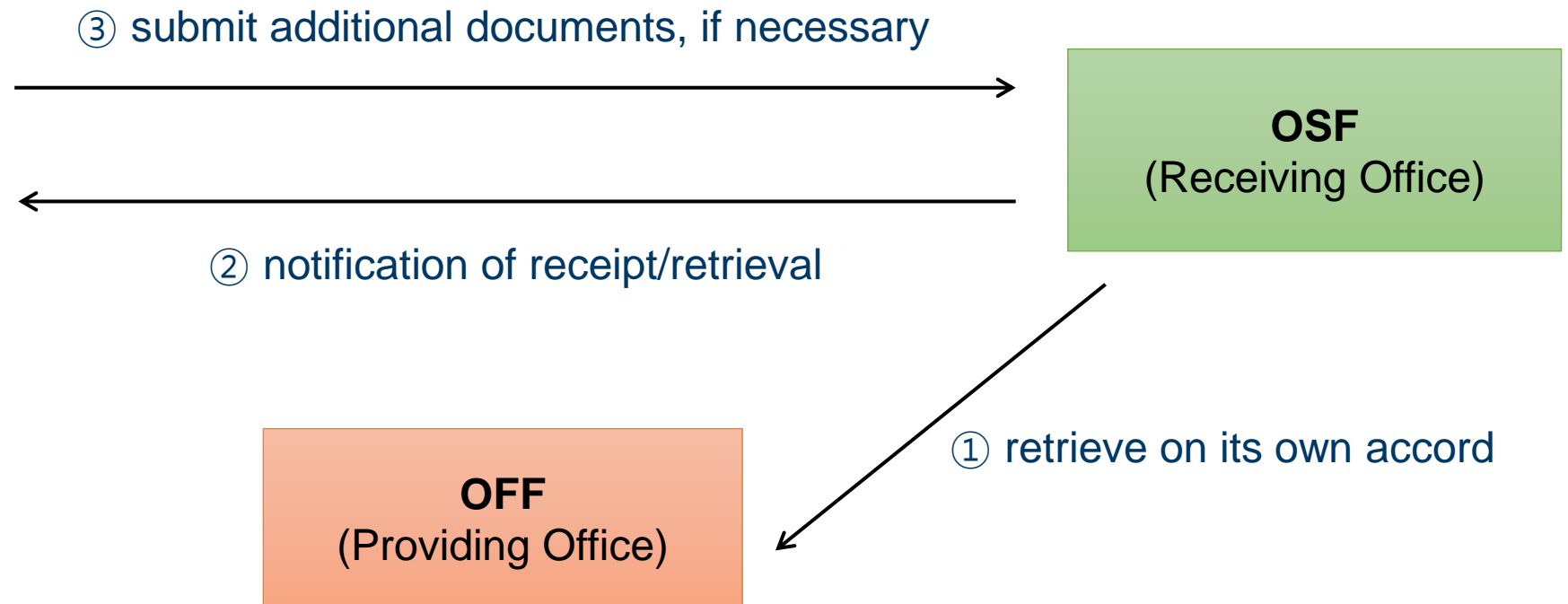
Recent progress

- ❖ PHEP provided **revised business requirements** to WG2 including objectives, essential & desirable functions of an IT system | Jan. 2017
- ❖ Approval of **the future plan** including **the survey of a matrix** | Heads Meeting (Jun. 2017)
- ❖ KIPO and the USPTO submit the analysis report of the matrix survey | Heads Meeting (Jun. 2018)
- ❖ KIPO and the USPTO presented the work-flow model and next steps | PHEP Meeting (Nov. 2018)

Basic form of the Work Flow Model



Applicant



(Work Flow Model) 1. Retrieving on its own accord

- ① A patent applicant files the application to the Office of First Filing (OFF)
- ② A patent applicant files the application to the Office of Second Filing (OSF) as well as to the OFF at the same time or cross files to the OSF within the time limit of claiming priority of the first application
- ③-1 Due to the different FA pendency, the OFF could not have issued the first office action even if the OSF initiated the patent examination process
- ③-2 Any cross-filed applications to the OFF could not have been published even if the OSF started the examination process

(Work Flow Model) 1. Retrieving on its own accord

- ④ (OSF Action) The OSF retrieves citation of the OFF through any specific systems, such as One Portal Dossier (OPD), etc.

	FA : OFF (earlier)	FA : OSF (earlier)
published	Retrieve documents or information as OSF Action is being issued, such as citation submitted as filed, citation used in examination, the third party observation	Retrieve a few documents or information submitted as filed, but FA pendency difference would be one major roadblock to the retrieval
unpublished	<ul style="list-style-type: none">- Share documents or information among some IP offices without any regulation- Add special provisions based on bilateral or multilateral work plan agreement	Retrieve a few documents or information submitted as filed, limitation in sharing documents or information

(Work Flow Model) 2. Notification of receipt / retrieval

- ① (OSF Action) The OSF notifies to the patent applicant of any documents or information retrieved from the OFF; provided, however, that the notice is made over the web service system, such as OPD and the IT tool opened to the public, or through an office action
 - ② (OSF Action) The OSF determines whether the retrieved documents or information follow the examination practice or guidelines
 - ③-1 (OSF Action) The OSF acknowledges that the retrieved documents or information are submitted as prescribed under the applicable regulation regarding submission of citation
 - ③-2 (OSF Action) The OSF makes the best use of the retrieved documents or information in the work-sharing
- * In ③-1 and ③-2, it should be presumed that the OSF accepts citation is submitted as prescribed under the applicable regulation or the use in work-sharing should be security-based and agreeable to the applicant*

(Work Flow Model) 3. Submit additional documents

① (Applicant Action) The applicant submits additional documents or information to the OSF when additional documents or information are required to be submitted as prescribed by the applicable regulation regarding submission of citation

** It should be noted that there could be the gap of consistency between the retrieved documents or information by OSF and the additional ones submitted by the applicant, but it couldn't be completely resolved. To ease the burden of submission on the applicant by shortening the gap of consistency between said documents or information, OSF examination guidelines are desirable to be revised to prompt the issuance of notification by OSF to minimize the delay or OSF is encouraged to internally make recommendations thereof.*

Next Steps

- ❖ To report the final outcome of this project in terms of harmonization to reduce the burden of submission on the applicant and strengthen examination cooperation to the IP5 Deputy Heads Meeting (April 2019)
- ❖ To promote the endorsement of continued cooperation at the IP5 Heads Meeting and complete this project (June 2019)
- ❖ (Follow-up Action) To set up a relevant system to implement this endorsement
 - It needs to be considered in conjunction with Inter-office Document Sharing project(USPTO)

Thank you!