

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

Work Sharing

Full Transparency of Offices' Search Queries
in Both Paris and PCT Filings

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Transparency of Search Queries

- Great benefits associated with Worksharing
 - Reduces Duplication – Examiners can reuse work already done by other Examiners
 - More Efficient – Examiner does not have to start with the original query / search terms
 - Improves Quality – When necessary, Examiners can expand upon work already done by others
 - Helps to address ambiguities or nuances associated with translating search terms
 - Different languages are used in the IP5 Offices
 - New Inventions / Technologies may give rise to new terms

Transparency of Search Queries

- Examiners can not rely on work already done by other Examiners unless they understand how it was done
 - PCT just provides search results and its reuse ability is limited
 - PPH provides more reuse ability because it comes with Examiners' work product analysis
 - Interviews with Examiners indicate that the more they understand the thinking of the prior Examiner (i.e., search query used), the more comfortable they are in reusing the work
 - In collaborative work between Examiners of different patent offices, they found that the best work product comes from understanding the approach of the other Examiner

Transparency of Search Queries

- Limited Information is less useful
 - Providing IC or CPC classes searched is of limited help
 - Providing key words is somewhat helpful but still insufficient to show the relationship between the search terms
 - Providing full search queries, sequence of queries, and full search strategies is required
- File History Including Full Search Strategy should be Fully Transparent
 - Especially with Common Citation Document and Global Dossier file histories will be easily available to Examiners
 - When Global Dossier goes public, the search strategies will be needed by third parties for due diligence, validity analysis, patent enforcement, patent monetization and other purposes