Improving Patent Quality With International Collaborative Search Pilot Programs

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The USPTO has launched two new programs aimed at improving patent quality by joining forces with the Japanese Patent Office (JPO) or the Korean Intellectual Property Office (KIPO) at the initial stages of the patent examination process. The JPO pilot program seems the most likely to have an impact on examination, but the USPTO will be evaluating both programs to see if one or the other is more effective.

JPO Pilot Program: Serial Search And Evaluation

The USPTO describes the JPO pilot program as a “serial search and evaluation program,” because the first examiner will provide his or her search and preliminary evaluation results to the other examiner before the other examiner undertakes examination. The other examiner will consider the first examiner’s search and preliminary evaluation results, generate his or her own search and preliminary evaluation results, and share those results with the first examiner. Then, both examiners will prepare and send examination reports to the Applicant(s).

The USPTO has provided this diagram of the JPO pilot program workflow:

Applications must be filed and pending in both countries, and petitions to participate in the program must be filed and accepted in both patents offices. (The USPTO does not charge any fees to participate in this program, but the JPO may charge an administrative fee.) Selection of the “first” examiner will be based whether the application has an earlier U.S. or Japanese priority rate, or will be determined by the patent offices.
U.S. applications in this program will be examined under the First Action Interview pilot program. When the USPTO examiner is the “first” examiner, he or she will send a (draft) Pre-Interview Communication (PIC) to the JPO examiner, consider the JPO examiner’s search results, and then send a (final) PIC to the Applicant, who then can elect how to proceed under the First Action Interview program (e.g., request an interview or elect to treat the PIC as the first Office Action). Possible advantages to Applicants in this program include expedited examination and a more thorough evaluation early in the examination process.

More details on the JPO Collaborative Search Pilot Program are found in this Federal Register Notice.

**KIPO Pilot Program: Parallel Search And Evaluation**

The USPTO describes the KIPO pilot program as a “parallel search and evaluation program,” because the examiners will conduct examination independently, and the other’s results may not inform or impact the first examination reports. As explained by the USPTO, an examiner will wait to send his or her report to the Applicant until the other report is received, but might not take the other report into account when preparing the first report.

The USPTO has provided this diagram of the KIPO pilot program workflow:

As with the JPO pilot program, applications must be filed and pending in both countries, and petitions to participate in the program must be filed and accepted in both patents offices. (The USPTO does not charge any fees to participate in this program, but the KIPO may charge an administrative fee.)

Also as with the JPO pilot program, U.S. applications in this program also will be examined under the First Action Interview pilot program. After the examiners have exchanged search results, the USPTO examiner will send the PIC and the KIPO examiner’s results to the Applicant, who then can elect how to proceed under the First Action Interview program. Possible advantages to Applicants in this program include expedited examination and early receipt of search results from both offices.

More details on the KIPO Collaborative Search Pilot Program are found in this Federal Register Notice.

**Assessing The Impact Of International Collaboration**

For each program, each patent office will accept 200 applications as the primary patent office, for a possible total of 400 applications in each program. The USPTO is interested in determining whether either program has an impact on examination, and whether it makes a difference if results are shared before or after the first examination report is written. The JPO pilot program seems to have the most potential to impact examination, since the first examination reports will reflect the search and evaluations of both examiners. On the other hand, the worksharing under the KIPO pilot program seems to duplicate what applicants already should be doing—making international search results of record in parallel U.S. applications—but perhaps USPTO examiners will give more consideration to KIPO search results under this program.