

Reply from IP Australia

The International Bureau would like to thank Offices for the comments received (from AT, JP, AU, PH, RU and PT). The IB thinks that it would be useful to seek further and more detailed comments, particularly from any Offices which are able to share specific procedures and guidelines which have been documented to assist their examiners in assessing when an earlier search or examination may or may not be useful, as well as for effective utilization of the results. In effect, this means ensuring that (at least on average) the time spent reading a report and following up cited documents and comments should result in either a higher quality examination according to the relevant national laws, or else a shorter time taken to achieve a result of at least the same quality (and preferably both).

The IB wishes to encourage Offices to share any concrete procedures which they have found useful and which could be provided to other Offices wishing to develop their own policies and examiner guidelines to maximize national examination quality while minimizing costs.

Having reviewed the comments received so far, the IB wishes to expand the questions further, as follows.

Clearly the largest interest for the PCT is where the earlier search is the international search. However, the questions are framed more generally and comments relating to effective use of earlier national searches by ISA and searches by other designated Offices in equivalent national phases, or by different Offices on equivalent applications by the Paris rather than PCT route would also be of interest.

Designated Office Issues:

(1) Are there any particular features of a search or examination report by a different Office which help an examiner to quickly determine the extent to which it seems appropriate to rely on it? Different degrees of reliance might include:

- ignoring it entirely;
- checking the citations but nevertheless conducting a complete new search;
- conducting a more limited search than would otherwise have been the case, for example focussing only on specific technical features or else documentation in particular languages or from particular databases;
- conducting only a "top-up" search to find documents which might not have been available to the ISA at the time of the international search, especially "secret prior art" (patent applications filed before the priority or international filing date, but only published later); or
- relying fully on the earlier search and conducting no further national search at all.

As noted in our post above, IP Australia encourages its examiners to efficiently use the work products from the international phase and the work products established by other Offices in the national phase (Foreign Examination Reports, or FERs). Where the search has been limited in the international phase and a full search has not been previously conducted IP Australia may conduct a further search. However in general we endeavour to re-use work conducted in another office to the maximum extent possible to minimise unnecessary duplication of work.

A clear indication of the subject matter that was searched (search strategy) greatly assists examiners in assessing whether an additional search is necessary, or whether the FER can be relied on. Search strategy information includes an indication of which databases were interrogated, the keywords and classification marks used (including IPC marks), any chemical structures or gene sequences if relevant, and an indication of which search results were considered by the examiner. IP Australia publishes our Search Information Statement (SIS) containing the above information for all national applications on our online AusPat database.

In relying on FERs, examiners must verify that positive or negative novelty/inventive step findings are applicable under Australian law. Examiners check that the reasoning in the FER is both accurate with regard to the citation and relevant to the claims under consideration. Any findings on other examination issues such as sufficiency or clarity is also considered and assessed for relevance and correspondence to Australian law.

Features of a search or examination report that facilitate this checking include a clear indication of the relevance of each citation, both with respect to the claims under examination, and which passages of the citation are relevant. This allows examiners to quickly and efficiently assess the claims against the citation to determine if it is applicable under Australian law.

(2) Are there any practical suggestions for ways of using the earlier search to get the best information out of it with the minimum effort?

IP Australia examiners check the claims that were searched by the other office to see if the Australian claims are similar enough to rely fully on the results of earlier searches.

A clear indication in a search report of the relevance of documents facilitates extracting information from a search report with minimum effort. IP Australia examiners rely on the document's category to prioritise documents viewed: we focus firstly on X and Y documents, and lower priority to consideration of 'A' documents. However, as noted above, clearly indicating specifically relevant passages or examples in the citation allows examiners to quickly get the necessary information from the documents for minimum effort.

The use of summary tables and clear headings in reports can also facilitate extracting relevant information. For example, listing of all the citations that are relied on together in one place allows examiners to assess which citations to view more readily than if the citations are only referred to in the body text of the report. Summary tables of e.g novelty and inventive step of claims allow examiners to focus their attention on the most relevant claims. Clearly heading objections also allows our examiners to easily refer to the parts of the FER that may be applicable under Australian law and ignore the parts of the FER that are not relevant to IP Australia.

(3) A number of practices are used by Offices to utilize earlier work, or to encourage applicants to take steps to eliminate defects identified in the earlier search or examination. Examples are:

- fee reductions for applications where an international search has been conducted (either generally or where the search was done by particular Offices);
- Patent Prosecution Highway (accelerated processing if the earlier report indicates that the claims used appear novel and inventive);
- requiring a response to defects noted in the earlier report before national examination begins; and
- the proposal to consider making Chapter II examination mandatory in some cases (Annex II of PCT/WG/6/23).

Are there any other similar arrangements in use or under consideration by Offices to recognize contributions from or provide an incentive for effective use of reports by other Offices?

IP Australia has a bilateral arrangement with the USPTO under the Patent Prosecution Highway (PPH). We have also indicated our intention to participate in the plurilateral PPH pilot proposed to commence in January 2014.

IP Australia also offers fee discounts for national phase work for applications for which there was an International Preliminary Examination Report where IP Australia was the IPEA.

(4) Most of the above practices are essentially applicant driven. What measures might be desirable to make more national search and examination reports easily available to Offices in a way which would allow them to use reports automatically without the need for applicant intervention?

Access to national search and examination reports should be provided by national offices to the World Intellectual Property Organization Centralized Access to Search and Examination (WIPO CASE) to ensure that there is a single central place to retrieve and review national proceedings. The latest release of WIPO-CASE 2.1 now supports transfer of document data (in bulk or on demand), and a notification service to allow for streamlined uploading and access of documents by national offices.

ISA Issues:

(5) It should be remembered that PCT Rule 41 permits the possibility of taking into account earlier searches. At present the International Search and Preliminary Examination Guidelines indicate how to record the use of an earlier search (paragraph 16.56) but leave it entirely to the individual ISAs to determine how best to use the earlier searches. **Information from ISAs equivalent to questions (1) and (2) on how earlier searches are assessed and used to assist an international search would be useful.**

In relation to the provision of international work products, IP Australia encourages its examiners to use earlier search results wherever they are deemed as appropriate and applicable to the application under consideration. As noted above, the process requires a careful comparison of present and earlier applications in order to identify efficiencies in search strategy, for example an ability to limit the current search to a top up search of the earlier search or a minor extension of the search into additional IPC, ECLA, or US classification areas. In that respect, as noted above the publication of detailed search strategies would assist this process.

IP Australia offers a 'international-type search' service under PCT Article 15(5) for applicants seeking an early indication of the patentability of a provisional application before filing of a complete PCT application. Where such a search has been carried out, IP Australia will usually use this search as the basis for the international search (and offer the applicant a partial refund of the search fee – see above), unless the subject matter or claims of the application have been amended such as to require a new search.

If an earlier search **has** been carried out, and it was carried out by an examiner other than the search examiner, where practicable the case is transferred to that other examiner to do the search. Where an earlier search was done by IP Australia, our PCT Unit will forward the earlier application's search report and citations to the search examiner. Where a foreign patent office was the RO, any earlier search report completed on the application will have been sent to AU at the same time as the search copy. The search examiner should attempt to access the cited documents by the usual techniques, namely from the internet or by requesting the library to obtain the document(s).

(6) Various projects are under way aimed at improving the quality of international search reports, including supplementary international search, collaborative search and examination and general quality improvement measures being taken individually by ISAs and collectively by the PCT/MIA Quality Subgroup. Having regard to the answers to questions (1) and (2), are there additional actions which should be considered by International Searching Authorities to ensure that international search reports are as effective as possible for use by designated Offices?

Publishing a clear indication of the search strategy would allow designated offices to assess the international search performed and would assist them in making a decision in the national phase on whether to search, and the parameters of their search. IP Australia provides its Search Information Statements (SIS) to the International Bureau for publication on PATENTSCOPE along with the International Search Report and Written Opinion. Our SIS contain a full history of the International Search including a listing of databases consulted (including the IPC categories where relevant), the steps undertaken in the search, the specific terms keyed into the search engines, an indication of the documents viewed, and an indication of the team of three examiners who conducted the search.

Further comments on these issues and relevant extracts from Office guidelines are invited by 30 September 2013.