

AIPLA/FICPI COLLOQUIUM - THE PATENT OFFICES BACKLOG CRISIS -

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ICC and IP Commission

- ICC is a representative body that speaks with authority on behalf of enterprises from all sectors in every part of the world. The fundamental mission of ICC is to promote trade and investment.
- The Commission on Intellectual Property contributes world business views to governmental and intergovernmental debates on key intellectual property issues facing the international business community.
- Positions reported in a working document that was adopted by the Commission on Intellectual Property of the International Chamber of Commerce (ICC) on April 26, 2010 – but not yet by the ICC as a whole.

Position of ICC IP Commission on Cooperation on Prior Art Searching

- **Goal:** Continued and improved cooperation between patent offices of an early, coordinated and comprehensive search
- **Goal pursued through:**
 - Support the PCT as the preeminent vehicle for work-sharing on global patent applications
 - Work with participating patent offices in the implementation of Patent Prosecution Highways
 - Encourage patent offices to take positive steps to achieve an “early comprehensive, coordinated search”

“Early, Comprehensive, and Coordinated Search”

- Ensure ISAs conduct an international search that fully and in good faith complies with obligations under the PCT.
- Ensure improved collaboration among national patent offices (in particular the IP5 offices) on search, including on databases, search strategies and exchange of search results.
- Explore mechanisms for an applicant, upon request, to obtain more than one search in connection with an application for a single invention
 - Such as through increased participation by ISAs in the supplementary international search system under PCT Rule 45bis.1(e)

The Problem and Ideal Solution

- Multiple offices jurisdictions, each of the patent offices performs a separate and independent novelty search on the same invention.
 - **Search results diverge** – for multiple reasons – including linguistic differences between offices and examiners and differences in search strategies.
 - **Divergences have consequences** - if examiner does not have all relevant prior art, patents may be granted of questionable validity.
- **Ideal (though presently unrealistic) solution:** patent offices manage work flow such that no office completes examination until the complete set of prior art from all offices is available.

From Ideal to Practical Solution

- ICC would like all applications to be subject – on applicant request – to early comprehensive, coordinated search taking advantage of combined strengths of the IP5 Offices
 - PCT Working Group driving ISA's to improve quality of international search
 - PPH important and excellent step and PCT-PPH Trilateral pilot should be made permanent and expanded
 - Supplemental Search under PCT Rule 45*bis*.1(e) – should be expanded to IP5 offices
- “Early” results consistent with PCT ISR and PCT supplemental search timelines

Closing Points

- Additional options under PCT, by national offices and through PPH give effective choices to applicants
 - Choice of options – and related additional costs – left to applicant
- An early comprehensive, coordinated search would result in fewer cases reaching substantive examination as cases would be abandoned.
- Applicants have more confidence in amending applications before substantive examination.
- Offices examining on basis of same set of prior art documents would realize efficiency gains through collaboration and work sharing.

Thank You