



**United States
Patent and Trademark Office
and
United Kingdom Intellectual
Property Office**



**Preliminary Progress Report for
USPTO-UKIPO Work Sharing Initiative**

Executive Summary

On November 10, 2010, the United States Patent and Trademark Office (USPTO) and the United Kingdom Intellectual Property Office (UKIPO) commenced a program for reutilizing each other's search and examination work products on corresponding patent applications to assess the benefits of work sharing between the two offices. By sharing and reutilizing work products, the Offices aimed to increase the efficiency and quality of their respective patent search and examination processes. This program represents one aspect of the ongoing collaboration between the Offices, which also includes initiatives to educate examiners on the respective patent systems and examination practices.

To this end, the Offices collaborated in facilitating access to each other's work products and in developing an examiner survey designed to produce comparable empirical data for assessing the impact of work sharing on efficiency and quality in each office. Examiners from both Offices were asked to complete the survey after referring to a work product from the counterpart office. This report presents preliminary results from these surveys.

The preliminary results suggest that further cooperation should be undertaken to explore the differences in practice between the Offices, particularly regarding novelty and inventive step/non-obviousness. Collaboration on these issues could facilitate a deeper understanding among examiners and help to close gaps, in turn leading to more effective reutilization of work products.

Recommendations

1. The USPTO and UKIPO should continue their work sharing cooperation, with a focus on increasing examiner understanding of each Office's practice.
2. The USPTO and UKIPO should engage stakeholders to identify best practices for leveraging the benefits of work sharing in reducing costs and delays in prosecuting corresponding patent applications.

I. Background

In March 2010, the USPTO and UKIPO endorsed a broad framework to promote cooperation on work sharing, as one aspect of the overall goal of better understanding each other's patent systems and examination practices. Under this framework, the Offices agreed to undertake measures to make greater use of each other's work on commonly filed patent applications, with a view to both increasing the efficiency and quality of the patent examination process, and reducing or eliminating duplication of work.

One of the first steps in the process was implementation of measures to improve access to available work products. Due to differences in practice and information technology systems, examiners in each Office encountered difficulties in obtaining search and examination reports from the other Office. To address these issues, the Offices made a number of initial strides, including:

- Granting UKIPO examiners direct access to application file contents contained in the USPTO's Public Patent Application Information Retrieval (PAIR) system by bypassing the reCaptcha interface.
- Developing a Public PAIR Glossary to aid UKIPO examiner's and the general public's understanding of the various file contents and document codes in PAIR; and
- Providing USPTO examiners with an instructional handbook for accessing, and electronic access to, UKIPO search reports and written examination reports via their desktop search tools and eSp@cenet. These efforts include the development of a 'How To' guide for accessing UKIPO work products through the Office's recently released IPsum electronic dossier.
- Collaborating on initial training modules designed to provide examiners with a better understanding of differences in respective patent laws, claim interpretation and searching.

As a second step, the Offices collaborated to develop an examiner survey, the purpose of which was to provide the data that would serve as the analytic foundation for assessing impacts from the project. After the survey was drafted, distribution to examiners in the respective offices began in November 2010. The results of these surveys are analysed below. It should be noted that the results presented are preliminary in nature as both the bilateral work-sharing effort and the survey evaluations are ongoing.

II. Methodology

The surveys were drafted in cooperation with representatives from each Office. The surveys that were eventually used in each of the Offices were slightly different from one another, to account for differences in Office practice and structure. Nonetheless, the questions were drafted to yield comparable data and metrics.

The USPTO notified examiners, who had an application on their docket related to a corresponding UKIPO application, that useful search report data may be available and

should be accessed and considered. The UKIPO instructed examiners to inspect for the availability of counterpart applications as a matter of routine. Once applications were acted upon, examiners in each Office took the survey to gauge the overall usefulness of the foreign work product considered.

III. Survey and Analysis

Examiners from both the USPTO and UKIPO were asked to complete the survey at the substantive examination stage. To date 300 responses were compiled in the UKIPO, and 236 responses were compiled in the USPTO. Below is a summary of a subset of responses from each Office. These responses are illustrated in chart form, along with a brief analysis of each finding.

A. General Findings on Perceived Usefulness and Cited Prior Art

As a preliminary inquiry, each Office included survey questions which, in general terms, focused on:

- (i) Whether the examiners perceived the work product of the counterpart office to be useful in preparing their own actions/rejections; and
- (ii) If the examiners actually cited references relied upon in the counterpart office.

In regard to (i), the survey inquired as to how useful the participating examiners perceived the actual work sharing initiative. Generally speaking, the examiners found the exchange of work product to be helpful. The two Offices took differing approaches to determine this data set in their respective surveys. For example, UKIPO bifurcated this inquiry between the usefulness of the *prior art search*, and the usefulness of the *substantive examination*. This approach reflects the processes at UKIPO, where search and examination are generally carried out at significantly different times. In this regard, in 59% of cases UKIPO examiners found the USPTO prior art search to be “at least useful,” while in 65% of cases examiners found the USPTO substantive examination to be “at least useful.”

In contrast, the USPTO took a different direction as to this data set, and instead inquired about the usefulness of the entire UKIPO work product (search report and substantive examination, if available). This is due to the fact that USPTO examiners perform both the initial search and the substantive examination at proximate times. In this regard, 44% of USPTO examiners thought that the work provided by UKIPO was useful to a “great or moderate extent.”

In regard to (ii), the survey data revealed that participating examiners were willing to rely on prior art references that were previously cited in actions from a counterpart Office. For example, in 42% of the selected applications USPTO examiners applied art that was cited in UKIPO actions. Although the UKIPO survey did not ask precisely the same question, results showed that where USPTO examiners found extra citations, and UKIPO examiners deemed these citations useful, UKIPO examiners cited an average of 1.6 extra

documents per case. Under UKIPO practice, examiners only cite extra documents at the examination stage if they are more relevant than those already found by the UK search. Therefore, granted UK patents for which extra citations are provided (i.e. those found by the USPTO) have a higher presumption of validity, and therefore higher quality than granted patents lacking extra citations.

B. Specific Findings on Substantive Examination

Presented below are charts illustrating specific findings with respect to substantive examination. In this regard, each Office inquired as to the:

- (i) Similarity of claim language between counterpart applications;
- (ii) Correlation in novelty determinations; and
- (iii) Correlation in obviousness/“inventive step” determinations.

As previously mentioned, because the patent laws and administrative rules of each Office are not exactly the same, each Office used its own set of questions to address each of these data sets. In regard to (i), each Office’s survey asked examiners if the scope of the claims being examined appeared to be commensurate with those of the counterpart application. In most instances, the examiners at the two Offices indicated that the claim scope of two related applications was substantially similar or somewhat similar, as illustrated in Chart A.

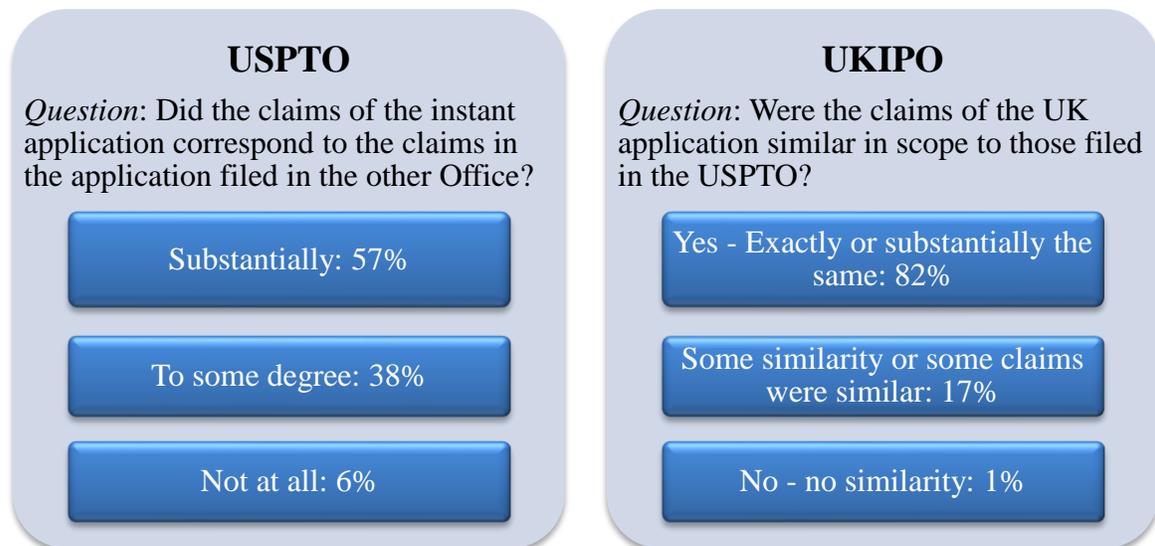


Chart A. Survey Results on Similarity of Claim Language

In regard to (ii), the survey also asked examiners to indicate whether they reached the same novelty conclusion as their counterparts. As illustrated in Chart B below, preliminary data on novelty determinations reveals that most of the examiners in both Offices reached *at least some of the same* novelty conclusions as their counterparts. More specifically, in 66% of cases considered, examiners at the UKIPO came to at least some

of the same conclusions as the USPTO examiner on novelty, with 50% being in full agreement. Similarly, in 63% of the USPTO applications, examiners came to at least some of the same conclusions as the UKIPO examiner on novelty. Of those, 20% were in full agreement.

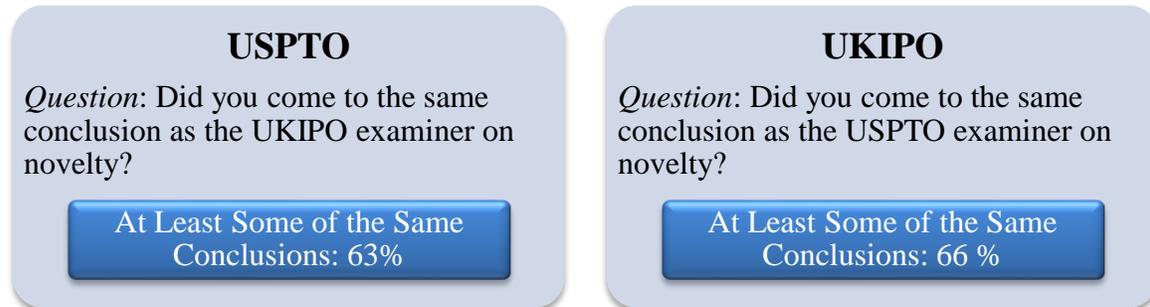


Chart B. Survey Results on Novelty Determinations

In regard to (iii), examiners also had to indicate whether they reached the same obviousness/“inventive step” conclusion as their counterparts. In 55% of UKIPO applications, examiners came to at least some of the same conclusions as the USPTO examiner on inventive step, with 30% being in full agreement. In 64% of the USPTO applications, examiners came to at least some of the same conclusions as the UKIPO examiner on inventive step. Of those, 21% were in full agreement.

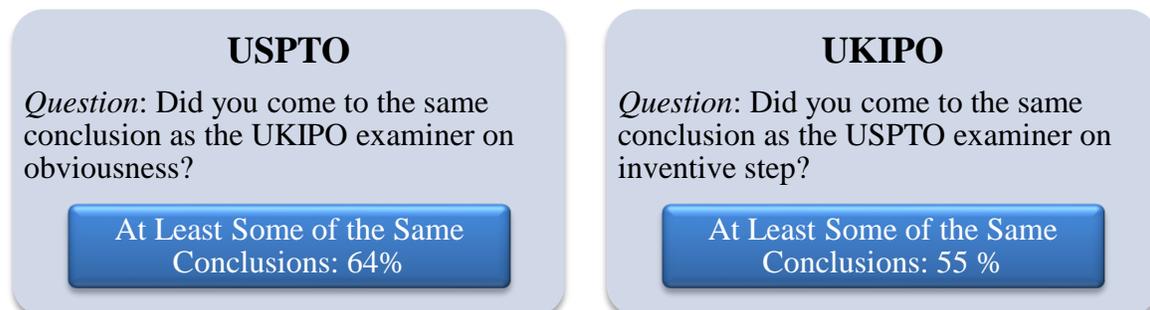


Chart C. Survey Results on Obviousness/“Inventive Step” Determinations

With respect to the findings discussed above in Charts B and C, the Offices are looking into possible underlying reasons for the different conclusions of examiners at each Office. While some of the observed differences could be attributed to differences in claim scope, mentioned above with respect to chart A, the most likely factor is differences in practice in each jurisdiction. Although the laws on novelty and non-obviousness/inventive step in the U.S. and the U.K. on their face have many similarities, it appears there are divergences at least at the practice level, for instance, the methodology by which examiners in each office perform a non-obviousness/inventive step analysis. Another explanation could be differences in approaches for formulating a search strategy.

Accordingly, it is expected that further work at the practice level, alongside more interaction between the Offices, may facilitate a better understanding of the outcomes in each Office and advance work sharing efforts.

C. Observations by Participating Examiners

The participating examiners provided feedback regarding some of the main differences in patent prosecution between the Offices. Some of this feedback underscores the benefit of continuing to pursue work sharing initiatives such as this one. For example, in the USPTO several examiners reported that the references from UKIPO's search report were already cited by Applicants via Information Disclosure Statements (IDS). The redundancy notwithstanding, data from the survey reveals that the UKIPO search report appears to provide additional context to USPTO examiners, a distinctive advantage over an IDS. Accordingly, having these search reports provides more insight as to the relevance of a particular reference.

With respect to UKIPO, some examiners indicated that it was time-consuming to take into consideration USPTO's work products, especially if the USPTO examiner took a different view from the UKIPO examiner. However, an analysis of the data reveals that UKIPO examiners frequently cited extra documents upon considering U.S. work products, suggesting that the quality of UKIPO patents granted is improved as a result of work sharing. A greater understanding of how the USPTO cites and determines the relevance of prior art in determining grounds for rejection may benefit UKIPO examiners in using USPTO work products more efficiently.

In most cases, the search by the UKIPO examiner is completed before examination results from the USPTO on the corresponding application have been published as a Pre-Grant Publication. Comments from examiners suggest that the Offices may want to explore approaches for making work results available at an earlier stage, consistent with applicable law, to improve reutilization rates and efficiency.

IV. Conclusion

Work sharing appears to have a beneficial impact on efficiency and quality, as evidenced by the overlap of findings regarding novelty and obviousness/"inventive step" in both Offices. A majority of the participants tend to agree that the work sharing initiative was useful. Nevertheless, observations by examiners at both Offices reveal that the practices and/or patent laws of the counterpart Offices are not always fully understood. Thus, the potential benefits of work sharing may not be fully exploited until there is a better understanding regarding the applicability of prior art. Accordingly, the USPTO and UKIPO should continue their work sharing cooperation, with a focus on increasing examiner understanding of each Office's practice. In this context, work sharing initiatives can have educational value in helping examiners better understand other Offices' rules and examination practices, particularly with respect to the important topics of novelty and obviousness/inventive step.

The benefits from work sharing should not be seen as limited only to the various Offices. As further work on this and other initiatives continues, applicants may also find it to their advantage to leverage work sharing to reduce costs and prosecution delays. As these preliminary data sets show, examiners report a high incidence of usefulness in certain categories of refusal/rejection, particularly when the claims of the corresponding applications are of similar scope. Moreover, the degree of usefulness of work sharing is expected to increase through further collaboration in examiner education and awareness training. Such an approach should, in turn, minimize duplicative work among examiners. To this end, the Offices may wish to engage with stakeholders on a discussion of best practices that would be effective in minimizing duplication and reducing costs. One example of such practices may address the benefits and drawbacks of using the results of one Office to determine whether and/or how to amend claims of similar scope presented in the other Office, to avoid similar grounds of rejection or refusal.