

Promoting linkage between the international phase and the national phase

UK IPO response to the IB's questions

(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.

For PCT applications, UK practice is to make full use of the international search report in the UK national phase to reduce duplication of work. UK examiners are only required to re-search a PCT application if they are “reasonably sure that such a search will yield more pertinent art” (see paragraph 89B.12 of the UK’s [Manual of Patent Practice](#)). Otherwise, any further searching is restricted to the “top-up” search and any supplementary search necessitated by allowable amendment of the claims (as for national applications).

Practice for performing the top-up search is set out in paragraphs 17.115-17.118 of the Manual of Patent Practice – the same practice applies regardless of whether the application originated as a national or PCT application. In addition to updating the original search, the top-up search includes a check for published equivalent applications to identify documents cited against them. Where appropriate, the online files of any foreign equivalents are consulted for further information on the significance of citations (see paragraph 18.10 of the Manual of Patent Practice). The top-up search also involves a check of the CPC classifications that have been applied to the case by the EPO and/or the USPTO. If the check reveals CPC classifications that were not searched during the original search (whether performed by the UK IPO for a national application or the ISA for a PCT application), the examiner considers whether the search should be extended to these areas. No search report is issued to the applicant following the top-up search – any additional citations are brought to the applicant’s attention in the examination report (with details of how/where they were found).

UK examiners consider the IPRP in detail and derive as much assistance as possible from it to increase efficiency and avoid duplication of work in the UK national phase. However, the UK examiner has ultimate responsibility for determining whether the application meets the requirements of UK law, so objections

in the IPRP are not repeated unless the UK examiner is satisfied that they apply under national legislation (see paragraph 89B.16 of the Manual of Patent Practice).

When considering foreign search reports, it is useful to have as much detail as possible about the search strategy e.g. classifications searched, keywords used, documents viewed. For this reason, we think that offices should be encouraged to share online search strategies (OSS). Access to the OSS enables examiners to determine the exact scope of the search and to quickly determine whether any further searching is required. It also increases the efficiency of the top-up search as the examiner can use the OSS as a template for updating the search.

With regard to the IPRP, International Authorities (IAs) sometimes raise objections that are particular to their own national/regional law/practice and not necessarily applicable under the law/practice of other PCT contracting states. Such practice should be avoided where possible to maximise the usefulness of the IPRP in the national phase.

(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?

Examiners need to be able to easily determine the set of claims that was the subject of the search and how these relate to the claims under consideration. Access to related examination reports is also useful to obtain an explanation of the relevance of citations.

When performing the top-up search, UK examiners use electronic tools on Epoque to quickly identify and view equivalent applications and the documents cited against them.

(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?

A reduced search fee of £120 applies in the UK national phase for international applications which have already been searched by an ISA (including where the ISA has issued a declaration under PCT Article 17(2) that no international search has

been established). The search fee for all other applications is £150. The fee reduction recognises the efficiency savings brought about by the availability of the ISR.

Where the IPRP indicates that major amendment is required and the UK examiner is in agreement, he/she may issue the first UK examination report in the form of an “abbreviated examination report” (AER) referring to objections in the IPRP/WO (see paragraph 18.47.1 of the Manual of Patent Practice). Full examination of the application and completion of the top-up search is deferred until the objections in the IPRP are addressed. This procedure increases the efficiency of the national examination process and we would encourage other national offices to adopt similar procedures where possible.

We also offer our “PCT(UK) Fast Track” service which allows applicants to request accelerated examination in the UK national phase if their PCT application has received a positive IPRP in respect of at least one claim. In order to qualify for the service, all claims present in the application at the time of the request must have been examined in the IPRP and found to meet the requirements for novelty, inventive step and industrial applicability, and any claims indicated as unallowable in the IPRP must have been deleted from the application. The service functions as a unilateral PCT-PPH, where acceleration is offered based on a positive IPRP issued by any international authority. Unfortunately the PCT Working Group was unable to reach agreement to formally integrate the PPH into the PCT system. However, we would encourage other Offices to adopt similar initiatives of their own accord to increase the incentive for applicants to eliminate defects before the start of the national phase. Further details of PCT(UK) Fast Track may be found in paragraphs 89B.17.1 of the Manual of Patent Practice.

(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?

Routine sharing of search and examination reports directly between offices would be desirable, for example using electronic dossier access systems such as WIPO CASE. The UK IPO already uses CASE to share reports with the other participating offices, and supports expansion of these systems such as the linkage of CASE to the One Portal Dossier.

UK examiners also make use of online file inspection services to access search and examination reports of other offices e.g. the EPO’s European Patent Register and the USPTO’s PAIR system. We offer online file inspection of UK cases via our [IPSUM](#) service and we would encourage other offices to offer similar services.