

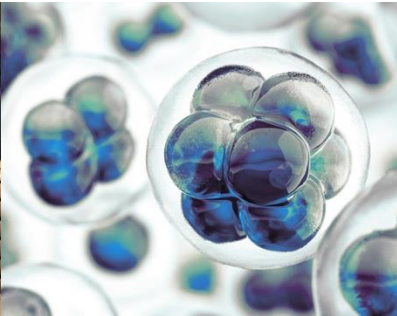
5a. IP5 Co-operation and PPH: general update

US Bar EPO Liaison Council

Washington, DC, 24 September 2019



Sylvie Strobel

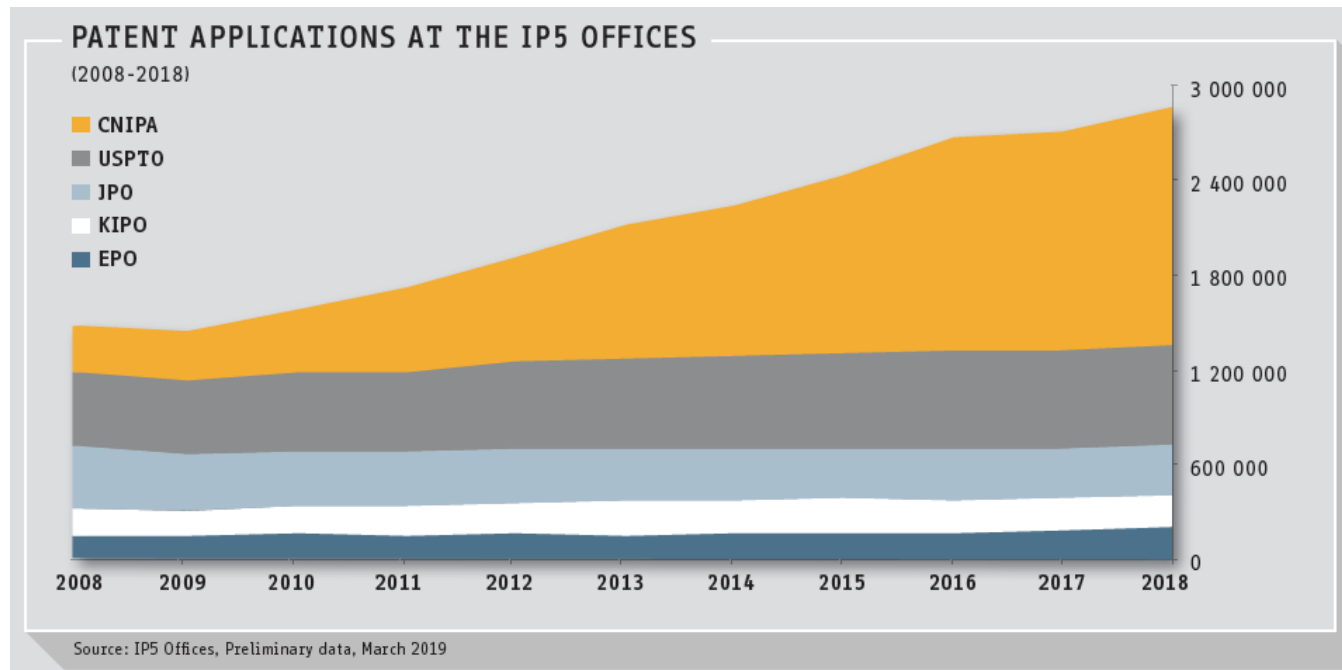


Lawyer, European and International Legal Affairs, PCT



24 September 2019

IP5 filing trends



2018

CNIPA: 1 542 002
USPTO: 597 141
JPO: 313 567
KIPO: 209 992
EPO: 174 317

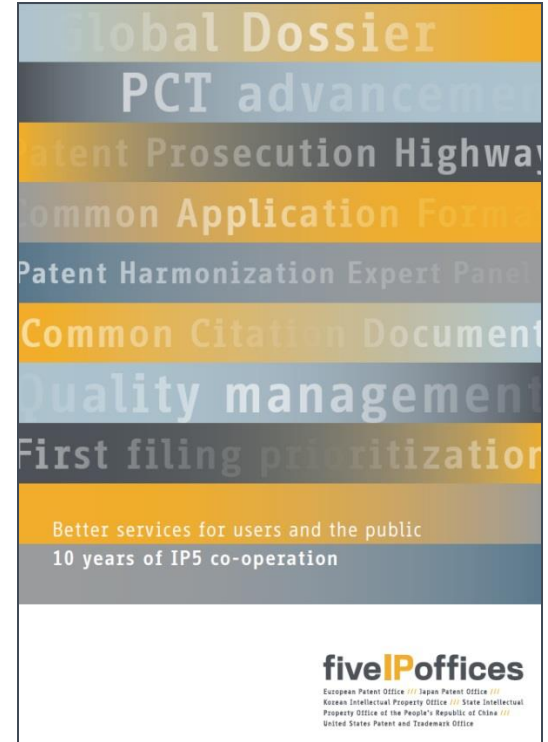
- The IP5 offices together handle about 85% of the world's patent applications and 95% of all PCT work

IP5 vision

- Since the creation of the IP5 co-operation framework in 2007, the global patenting landscape has significantly evolved
- In 2017, the IP5 offices defined their new vision as:
*“Patent **harmonisation** of practices and procedures, **enhanced work-sharing**, **high-quality** and **timely** search and examination results, and **seamless access to patent information** to promote an efficient, cost-effective and user-friendly international patent landscape.”*

Major IP5 achievements at a glance

- Global Dossier: access to IP5 file wrappers, in real time, with machine translation into English
- Common Citation Document (CCD): over 330 million citations from 35 patent offices worldwide
- IP5 Patent Prosecution Highway (PPH)
- PCT Collaborative Search and Examination
- Alignment of patent practices and procedures
- Statistics



www.fiveipoffices.org/material/2017brochure.html

IP5 Global Dossier

- The Global Dossier file wrapper service hugely simplifies access to work products of the IP5:
 - Users can more easily see the status of applications at the IP5 offices and access the dossier documents (file wrapper)
 - Patent examiners can re-use the work done by their IP5 peers
- The future focus of the Global Dossier initiative:
 - Improving the quality and availability of data
 - Looking for ways to streamline global patent prosecution

www.fiveipoffices.org/activities/globaldossier

IP5 procedural patent harmonisation

The IP5 Patent Harmonization Expert Panel (IP5 PHEP) was established in 2012 to promote the alignment of practices among the IP5 offices

- **Unity of invention:** EPO/SIPO
 - determination and application of unity of invention criteria
 - positive outcome, application of agreed approach outside the IP5
- **Citation of prior art:** KIPO/USPTO
 - prior art disclosure requirements
 - offices to explore systems to implement the identified work flow
- **Written description and sufficiency of disclosure:** JPO
 - issues re enablement, sufficiency of disclosure, written description & claims
 - publication of the final case studies' report on the IP5 website

The EPO PPH programmes

- EPO work products can be used at other PPH Offices (IP5 + Australia (AU), Canada (CA), Colombia (CO), Mexico (MX), Singapore (SG), Israel (IL), Russia (RU), Malaysia (MY), the Philippines (PH), EAPO, Brazil (BR))

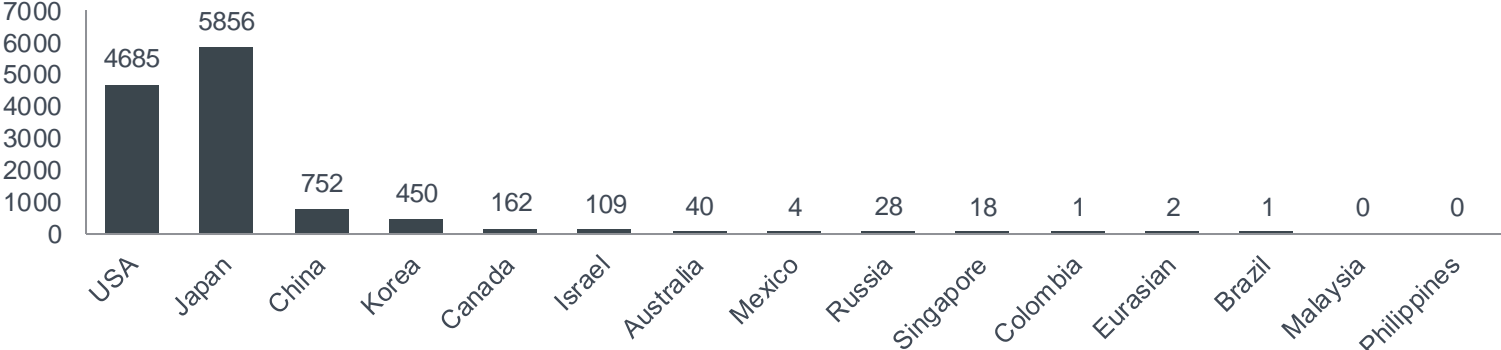
EP

Search and/or examination reports produced by EPO accelerate applications at:

JP US KR CN CA IL MX SG AU CO RU MY PH EAPO BR

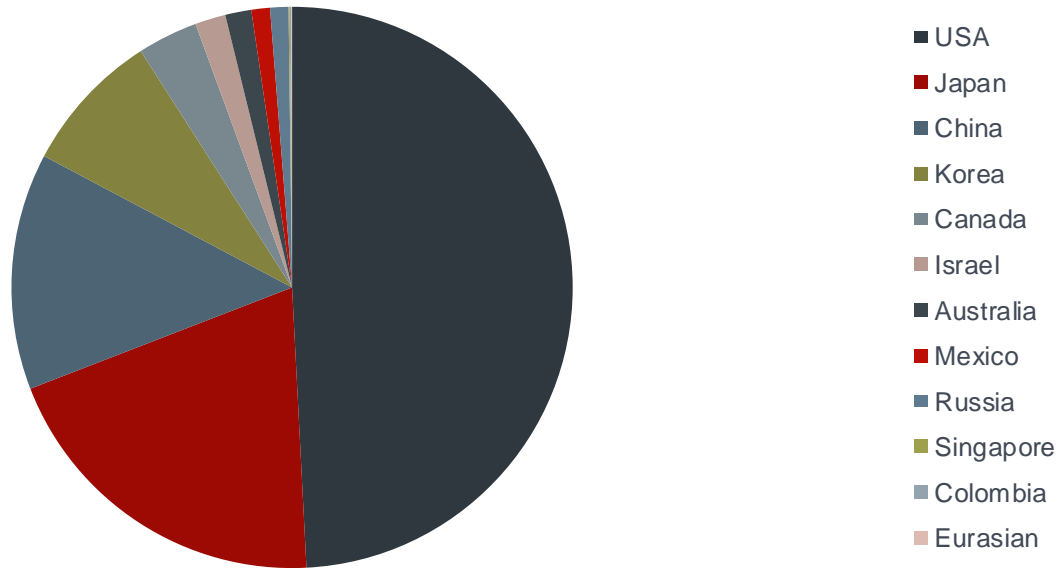
- Peru (INDECOPI) in preparation

Status of PPH pilot programme: Q2 2019



■ Number of incoming PPH requests: 12108 total

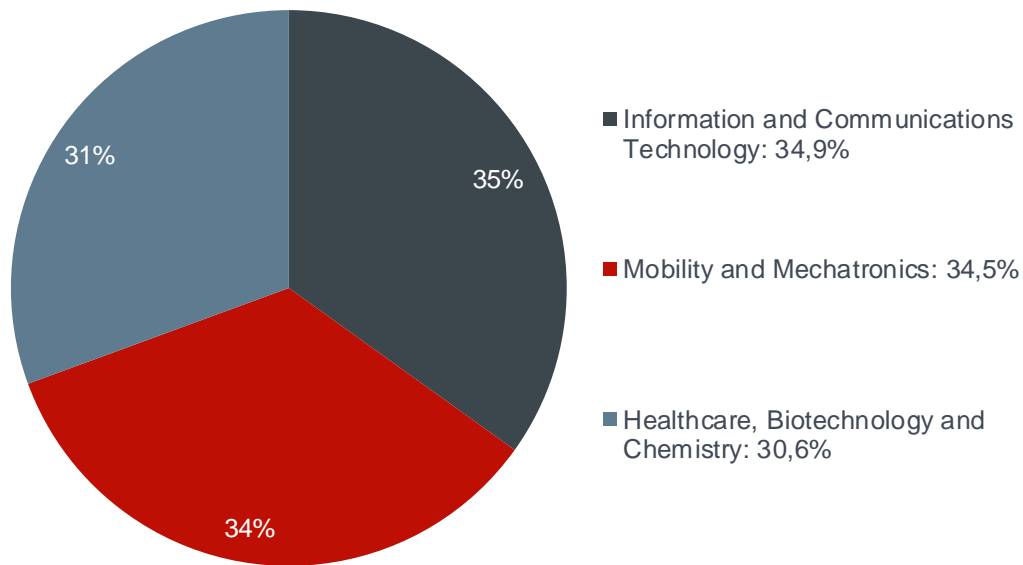
Outgoing PPH requests



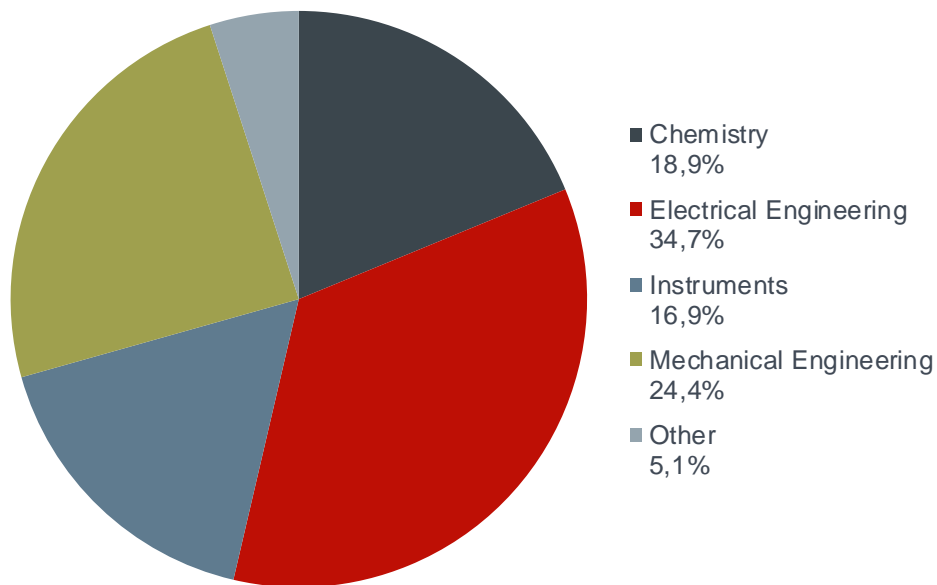
- ca. **22.300** PPH requests filed on the basis of EPO work products
- EPO **WO-ISAs**

Distribution of PPH requests: EPO DG1 sectors

Distribution of PPH requests according to DG1 sectors



Distribution of PPH requests: WIPO IPC sectors



Status of IP5 PPH pilot programme: July 2019

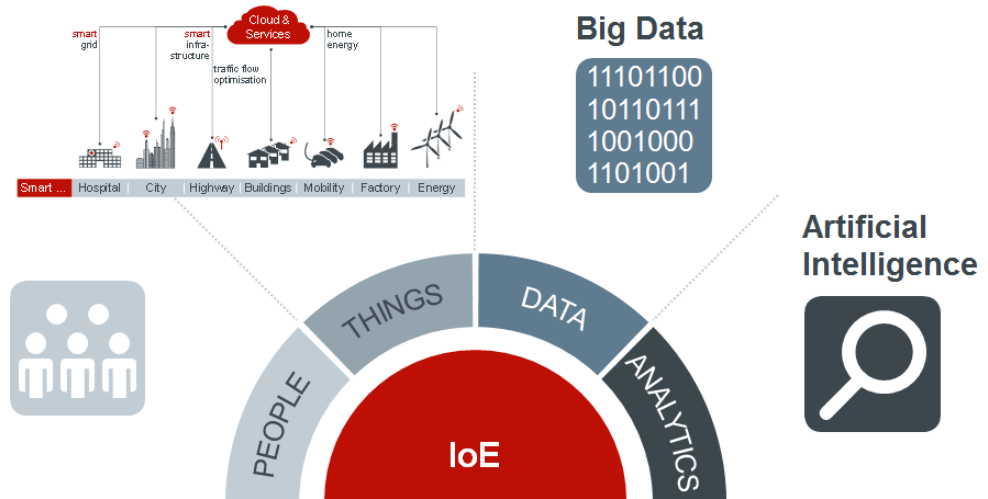
Patent Office	Work product	Launch date	Number of requests
JPO	PCT work products	29 January 2010	2477
	national work products		3379
KIPO	PCT work products	6 January 2014	266
	national work products		184
CNIPA	PCT work products	6 January 2014	573
	national work products		179
USPTO	PCT work products	29 January 2010	587
	national work products	28 September 2008	4098
Total IP5 PPH			11 743

IP5 PPH metrics

- Quantification of PPH benefits
- Need for harmonised PPH metrics
 - currently available information sub-optimal
 - support users awareness about what to expect from offices when requesting PPH
- Key issue
 - thorough understanding of the relevant procedures that impact on the metric definitions
- Agreed metric definitions to be tested in second half 2019

IP5 co-operation: current challenges

- Rapid development of artificial intelligence (AI) and other new emerging technologies (NET):
 - *specific challenges for patent law and practice*
 - *opportunities for efficiency gains in office operations*



IP5 co-operation on NET and AI

- June 2018: IP5 Heads identified AI as a major strategic priority for IP5 co-operation
 - October 2018: IP5 experts explored legal aspects of AI patenting at round table hosted by the EPO
 - Main issues:
 - Inventorship/ownership
 - Patent eligibility
 - Sufficiency of disclosure
 - Inventive step
- report published on IP5 website: www.fiveipoffices.org/material

IP5 task force on NET/AI

- June 2019: decision to create an IP5 task force on NET/AI
- NET/AI related issues are of an interdisciplinary nature
 - strategic, policy, legal, IT
 - wide range of expertise required
- IP5 NET/AI task force to:
 - coordinate and analyse AI related issues
 - propose a roadmap for potential joint work by the IP5
 - engage with stakeholders to address users' expectations and needs

IP5 co-operation: current challenges

- IP5 co-operation has been a success story with tangible results
- The IP5 offices are now entering a new phase of their co-operation where they have to
 - focus resources and further streamline their initiatives to be able to deliver tangible outcomes in a realistic time frame
 - promote a more comprehensive IP agenda in order to respond to the needs of users who handle global IP portfolios with bundles of IP rights
 - step up outreach efforts and enhance communication on the importance of IP and the benefits of IP5 projects to a broader audience

IP5 consultation with industry

- The IP5 offices want to ensure user involvement at an early stage of IP5 projects through regular meetings with industry representatives of the IP5 regions ("IP5 Industry"),
 - Strategic discussions at annual IP5 Heads and Industry meetings
 - Technical discussions on needs basis in the Global Dossier Task Force (GDTF) and Industry Consultation Group (ICG) meetings

8th IP5 Heads and IP5 Industry meeting

- 12 June 2019
- hosted by KIPO in Incheon, Korea



fiveIPoffices

European Patent Office | Japanese Patent Office | Korean Patent Office |
New Zealand Patent Office |
United States Patent and Trademark Office |
United Kingdom Intellectual Property Office

Home

News

About IP5 co-operation

Patent statistics

Activities

IP5 material

Consultation with industry

IP5 Heads of Office and IP5

Industry

Global Dossier Task Force

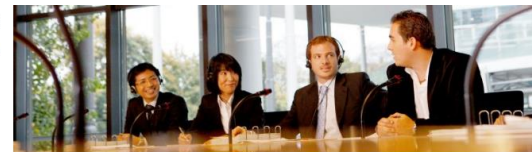
IP5 Industry Consultation Group

Events calendar

Contact us

Online resources

Sitemap



Meeting with IP5 Industry, June 2019, Incheon, Korea

On 12 June 2019, the IP5 Heads of Office met with IP5 Industry in Incheon, Korea, to update the industry representatives on recent developments at their respective offices and on IP5 initiatives such as the Global Dossier and the results of the work of the IP5 Patent Harmonization Expert Panel (PHEP). The IP5 Offices and IP5 Industry also engaged in a dialogue on IP topics of strategic nature, including new emerging technologies and artificial intelligence and the future focus and sustainability of IP5 co-operation.

Search Enter search term

Agenda

Topics and presentations included:

Recent developments at the IP5 Offices and WIPO

- [Recent developments at KIPO](#) (presented by KIPO)
- [Recent updates from CNIPA](#) (presented by CNIPA)
- [USPTO update](#) (presented by the USPTO)
- [Latest updates of WIPO](#) (presented by WIPO)

Follow up from the Global Dossier Task Force (GDTF) and industry Consultation Group (ICG) meeting

- [2019 Global Dossier Task Force and Industry Consultation Group meeting: main outcomes](#) (presented by the EPO)
- [IP5 Industry reply on EPO report of 2019 Global Dossier Task Force and Industry Consultation Group meeting](#) (presented by the PDG on behalf of BE)

Report to Industry: follow up on 2018 strategic topics

- [Follow up: 2018 strategic topics](#) (presented by the USPTO)
- [Report on 2018 strategic topic](#) (presented by IPO)

Work of the Patent Harmonization Expert Panel (PHEP)

- [Conclusion of the current PHEP projects](#) (presented by KIPO)
- [PHEP – Future topics](#) (presented by the USPTO)
- [DUCD new topic: Global patent environment](#) (presented by IPO)

Presentations from the meeting are available online:
www.fiveipoffices.org/industry-consultation/headsandindustry/june2019

For more information, visit
www.fiveipoffices.org/material
www.fiveipoffices.org/resources



- Home
- News
- About IP5 co-operation
- Patent statistics
- Activities
- IP5 material
- Consultation with industry
- Events calendar
- Contact us
- Online resources
- Sitemap

Online resources

The IP5 Offices have compiled a list of useful links pointing to information sources on their respective websites for a number of topics:

- [News and important notices](#)
- [Applying for a patent](#)
- [Online filing](#)
- [Legal resources](#)
- [Fees and forms](#)
- [Patent information](#)
- [Learning and events](#)
- [Annual reports/statistics](#)
- [User feedback](#)
- [General information](#)

Search

Thank you!

ip5@epo.org
www.fiveipoffices.org/