



Patents Worksharing – business guidance

Background

As the demand for patents increases across the world patent backlogs are steadily growing, increasing the strain on the patent system.

The rise in patent applications can be partially attributed to multiple filings. Patents are territorial and patent protection is granted within national borders. With increased globalisation, innovators often seek patent protection in several countries. Effectively this means that the same patent application is examined many times over by examiners in different patent offices.

These backlogs can contribute to delays in the time taken to grant a patent. Such delays can be costly for business by affecting the economic benefits businesses can derive from patent rights and creating uncertainty as to what patents will be granted. Any measures which help reduce worldwide patent backlogs are therefore beneficial to business.

Worksharing is a way of reducing the duplication of examination work by patent offices around the world. Worksharing means that if one patent office has already performed patent processing work on an application, a second office, when considering an application for the same invention, will use that work to the maximum extent possible. The aim is to reduce the amount of duplicated processing as much as possible and, by doing so, reduce backlogs.

Current situation

The UK Intellectual Property Office (IPO) can currently share work relating to **published** patent applications. It does this under a number of worksharing initiatives, including for example:

- WIPO CASE (“Centralized Access to Search and Examination”) – a system developed by the International Bureau of WIPO, which enables patent offices to securely share search and examination documentation related to published patent applications in order to facilitate work sharing.
- The Patent Prosecution Highway (PPH) – an initiative where applicants can significantly accelerate examination of patent applications if examination has already been conducted at another intellectual property office with a PPH agreement.

In addition, the IPO currently provides pre-publication information to the European Patent Office in accordance with section 118(3)(a) of the Patents Act 1977.

What’s changing

Worksharing is more effective if the information, in particular relating to the search results, can be shared with other offices earlier in the patenting process. The UK law will therefore be changing on 1 October 2014, allowing the IPO to send information on **unpublished** patent applications to other national and regional patent offices. In practice, the IPO will only send information on an unpublished UK patent application when the patent applicant has filed an equivalent patent application at that other patent office.

Detail

The IPO will only be able to share information on **unpublished** patent applications if there is a working agreement in place between the IPO and the other patent office; and the IPO will only be able to send information on unpublished patent applications in accordance with that working agreement.

The working agreement will include provision for ensuring confidential treatment of the information – i.e. the working agreement will say that the other patent office cannot disclose the pre-publication patent information when that information remains confidential in the UK.

The IPO will only share information with other offices in circumstances where doing so is likely to lead to a reduction in duplication of work. Information will therefore not be shared until a search has been conducted by the IPO in relation to the UK patent application. Only information likely to reduce duplication will fall within the scope of the worksharing arrangements, such as:

- UK search and examination reports
- examination opinions issued during the search/examination process
- patent claims (so that the other office has the context of the search/examination)
- classification data
- statistical management information data relating to the operation of the worksharing arrangements.

The worksharing agreements will set out the terms and conditions under which the other office is allowed to access information from an earlier UK patent application. For example, the agreements could limit pre-publication worksharing to situations where that other office is dealing with an application which claims priority from a UK application. This approach would be in line with the approach currently taken when the IPO provides information to the European Patent Office in accordance with section 118(3)(a) of the Patents Act 1977. So the applicant must have actively chosen to file at that other office and claimed priority, before such pre-publication information is sent from the IPO.

Helping applicants make an informed decision about their filing strategy

The IPO will publish information about current and future worksharing arrangements on the IPO area of the gov.uk website, ensuring that sufficient notice is provided of the start date of such worksharing arrangements. This will ensure that patent applicants and representatives know in advance of filing their application what information will be shared and with whom. The guidance will set out:

- what information will be shared,
- with which other offices,
- from what date onwards,
- from what point in the patent application process onwards, and
- what restrictions are in place on the use of that information.

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