

Patent Cooperation Treaty (PCT) Working Group

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INTERNATIONAL SEARCH REPORT FEEDBACK PILOT

Document submitted by the United Kingdom

SUMMARY

1. This document reports on the progress of the recently continued International Search Report Feedback Pilot under the PCT. This phase of the pilot was a collaborative effort involving the United Kingdom Intellectual Property Office (UK IPO), IP Australia, the Canadian Intellectual Property Office (CIPO), the Israel Patent Office (ILPO), the Intellectual Property Office of Singapore (IPOS), and the United States Patent and Trademark Office (USPTO).
2. Each participating Office agreed to provide limited feedback on international search reports (ISRs) issued by another participating International Searching Authority (ISA) for applications that had entered the relevant national phase. The UK IPO provided feedback, but did not receive any since it is not an International Searching Authority (ISA).

BACKGROUND

3. A feedback system on the work provided by ISAs was first suggested in the eleventh session of the PCT Working Group held in 2017, following the publication of a memorandum entitled “The PCT System – Overview and Possible Future Directions and Priorities” by the International Bureau. A system where national Offices could provide feedback on the quality of work carried out by ISAs during the international phase was envisaged.
4. In 2019, the UK IPO invited CIPO and IP Australia to participate in a small-scale feedback pilot on ISRs to identify feedback most beneficial for an ISA and demonstrate the usefulness of such a system. The pilot was discussed at the twelfth session of the PCT Working Group, and the UK IPO issued an open invitation for other ISAs to participate. IPOS expressed an interest and joined the pilot in late 2019. Progress was discussed at the twenty-seventh session of the Meeting of International Authorities (MIA) in February 2020, where several ISAs indicated an

interest in being involved. The USPTO joined the pilot in early 2021, and the ILPO joined shortly afterwards. This stage of the pilot was concluded in October 2021 with ILPO providing responses to the feedback received. That was the last step of the pilot to take place until the most recent phase.

5. In each of these previous phases, the UK IPO provided feedback on five ISRs issued by the ISA once the application had entered the UK national phase. The pilot was part of wider efforts to ensure the PCT and international phase are operating as effectively as possible.

6. The pilot was viewed positively by participants with the feedback being regarded as useful. When the results were presented at subsequent sessions of the PCT Working Group, many other member states made encouraging comments about the potential benefits, although there was some concern about overall costs.

7. In 2023, the UK IPO contacted previous participants about resurrecting the pilot, and discussions were held about how it could continue with suggestions about the process and forms used. In particular, an extension beyond the UK IPO alone providing feedback was thought by all participants to have greater potential benefits.

FRAMEWORK

8. The UK IPO devised this phase of the pilot to be simple to limit the amount of time and labor required, yet still allowing each Office to constructively comment on searches performed by another ISA. The pilot was run as follows:

(a) Each participant identified at least 12 PCT applications which had entered their national phase and had been searched by one of the participant ISAs. For fairness, it was requested that applications searched by a variety of ISAs be selected. These lists were revealed to all participants.

(b) The UK IPO then chose eight applications from each list and ensured that each ISA would receive roughly the same amount of feedback from each Office.

(c) Each participant provided feedback on the eight selected applications from their list. This was typically done by the examiner of the application in the national phase. The feedback for each case was provided on the sheet shown in Annex I and emailed to the UK IPO.

(d) The UK IPO then sent all the feedback forms to the relevant ISA. The feedback was not shared beyond the Office that had provided the feedback and the receiving ISA.

(e) Each ISA digested the feedback and was invited to provide general comments about its quality and how it might be used. These comments were provided on the sheet in Annex II.

(f) To conclude this phase of the pilot, the participants intend to discuss it with each other, how it was successful and how it could be improved. Further stages of the pilot may follow after conversations with the International Bureau and other interested parties.

9. The feedback form (as shown in Annex I) has been modified slightly based on comments from previous phases of the pilot and also suggestions by participants at the beginning of this phase.

STATE OF PLAY

10. All participating ISAs have obtained feedback from each of the participants and provided their response to the feedback. Concluding discussions between participants about the results have not yet taken place. Initial impressions by UK IPO are in the following paragraphs.

How have ISAs used the feedback?

11. One ISA used the feedback to identify gaps in search strategy when new relevant prior art documents were identified. In particular, it was useful if different classification codes and/or keywords were used. Another ISA used the results as a further quality check on their ISRs.

12. An ISA commented that although the feedback provided useful information, the sample size was not big enough to identify trends and draw meaningful conclusions such as identifying specific training needs. Training is often resource and time-intensive and thus more was needed to justify such an investment in training or other changes in practice. However, the feedback may be considered when determining potential quality explorations or future studies.

13. A further ISA stated that the greatest benefit came with sharing the feedback with the international search examiners, who gained a second opinion on their ISR, and may change their approach through citing additional art, extending their search, and being aware of similarities/differences used in search strategies by other ISAs. This ISA also thought this project reinforced the idea that search collaboration workshops are a good opportunity to help all examiners improve search skills. Specific changes to practice or training have not taken place.

What type of feedback was most useful?

14. Every ISA confirmed that the identification of new citations not present in the ISR was useful. This was particularly so if there was an indication as to how that citation was identified (such as the use of different databases, specific classification codes and different keywords).

15. One ISA commented that some of their feedback forms gave detailed reasons for performing an additional search and using new citations, and that they found this feedback to be the most useful.

16. Other feedback stated as being useful is an opinion on the X/Y/A classification of documents, raising awareness of art cited in other jurisdiction, a reminder to double-check structural details in complex drawings and a reminder that web-based NPL might not be available later in the prosecution.

What type of feedback was not useful?

17. Two ISAs did not mention any of the feedback as being non-useful.

18. One ISA stated that a “No” response to Question 5 (“Did you extend the field of search at examination to provide new subclasses/databases not listed by the ISA?”) was not particularly useful.

19. A further ISA stated that some forms did not give detailed information on how newly identified prior art was found (such as different classification codes, new databases, keywords or another route entirely). Some did, and were much more useful as a result.

20. Some feedback had a lack of clarity to why the national phase examiner did not use prior art cited on the ISR and used different prior art instead.

Would any additional feedback prove beneficial?

21. One ISA thought it would be useful to include the search strategy used by the examiner providing feedback, especially the search string that identified a new relevant prior art document.

22. A further ISA suggested three more questions to be included in the feedback form:

- (a) If there are other citations not included in the ISR but used during the examination, are these citations considered more relevant than the ISR citations?
- (b) What is the number of ISR citations used in the examination compared to the total number of citations used in the examination?
- (c) Was additional searching (if any) conducted using AI-powered search tools?

23. The purpose behind these questions was echoed in other responses. An ISA thought there could be a greater focus placed on the prior art cited during examination, in particular how relevant each of the cited documents were and to which claims the examiner applied them. Another ISA also suggested requesting information about whether AI was used during any further searching, and if new relevant prior art was determined using an AI-enabled search platform.

24. One ISA would have liked greater detail as to how the new citations were deemed more relevant to the claims with regard to novelty and inventive step. Information on whether X/Y documents cited in the ISR were actually used in conducting examination of national applications would also be useful.

25. Another suggestion was to ask participating Offices to provide information on their policy/best practice with regard to evaluating and leveraging work from earlier examinations (by other Offices), and what their employees may consider the biggest challenges with leveraging that work.

26. One ISA would have liked to learn about the practice of participating Offices on national phase examination. For example, do they always conduct further searching irrespective of the results on the ISR, and do they then compare their results with those of the ISR? Alternatively, do they use the available search results (if they are considered reasonable) and defer any further searching until amendments are received?

27. Another suggestion was for participating Offices to give the name of the search tool used (e.g. EPOQUE).

Suggestions for improvement to the pilot?

28. An ISA stated that the selected ISRs on which they received feedback were quite old (they were searched approximately 10 years ago). They stated the feedback would have been much more useful for recent international searches. Another ISA confirmed that their examiners thought the feedback came to them too late to be of great benefit. (It is noted, however, that some Offices are restricted by the number of national phase applications which were searched by a particular ISA.)

29. One ISA suggested that it would be helpful to include a citation map showing all the Offices which have cited the same ISR citation. This could be an effective way to convey information about the frequency of ISR citation usage.

30. If not readily available, copies of any additional prior art could be provided.

31. There was occasionally some confusion over which Office was providing the feedback, so it might be useful to tweak the identification fields at the top of the feedback form. A further comment was that the corresponding national phase publication number of the application reviewed could be given, possibly alongside its prosecution documents.

32. Were this pilot to be continued and expanded, it might be worth setting up a secure shared drive where participating Office can have immediate access to their relevant feedback forms.

33. A further ISA commented that the current format is adequate for the nature of the feedback provided in this pilot. If more information is included, then the presentation of the feedback would necessarily need to change.

CONCLUSIONS

34. A discussion between the UK IPO and each participant about the process and results of this phase took place during October and November 2024.

35. All participants agreed that it would be useful to learn (before the feedback was provided) each Office's practice concerning examining applications which enter the national phase. Knowing the practice of an Office beforehand would provide greater insight on the feedback received from that Office. It would be useful in any further phases for each participant to provide some details on their processes prior to any feedback being provided.

36. All participants also agreed that the sample size was too small to inform new practice or identify training needs. Nonetheless, one Office explained that the examiners who received feedback on their own searches appreciated suggestions on different databases, classification areas and general ideas of how to search. This could be shared with colleagues or included in training that examiner was involved in. Thus, there was potentially more benefit to the pilot than just general interest.

37. Most participants agreed it was a useful benchmarking exercise, but could not be relied upon in isolation. There was also broad agreement that the more information on how any new citations were identified (with particular focus on the search strategy), the better. One ISA was concerned that new citations could be arbitrary, and not necessarily any more useful than those provided on the ISR. More detailed analysis would be required to actually estimate how useful and relevant citations were, and the true benefit of the pilot could not be determined otherwise.

38. Although greater sample sizes might give greater benefit, there is a greater cost for doing so. A balance may need to be struck when thinking of future sample sizes. The current administrative cost is low, but to expand the size of the pilot would need careful consideration and possibly greater clearance from some Offices to proceed. Several ISAs claimed that feedback on old applications (e.g. 10 years or older since filing) were less useful, and selecting cases that were currently being examined (i.e. were "in-flight") might further help reduce costs. This would reduce the need to go back to a case not looked at for several years, however it might not always be possible.

39. There was some discussion about restricting future phases of the pilot on certain areas of technology, which might yield more focused results. One suggestion was selecting an IPC area where non-patent literature is often cited.

40. All participants were open to participating again in a future phase of the pilot, provided it isn't run too frequently. Any significant increase in sample size or feedback provided might require further scrutiny, however.

41. The overall impression is that the feedback pilot has proved useful, although greater benefit could be gained through more instruction given to those providing feedback (particularly on the level of detail given), and more consideration about how best to select applications on which to give feedback.

NEXT STEPS

42. There are currently no definitive plans to run a further phase of the pilot or expand the project, but discussions about how that might proceed have begun. Noting the significant work involved, a further phase would need to be carefully designed to meet specific goals, which might either be concerned with the comparison of search and examination results as such, or else in assessing what would be needed to make feedback practical on a larger scale, from the point of view of allowing examiners in designated Offices to give feedback with minimal effort, collecting and distributing the data, and analyzing the data, both at the level of individual applications by examiners and more broadly, for identifying trends and common issues.

43. If a further pilot is performed, it is considered likely that an increase in sample size would be needed for the results to be truly useful. As discussed, this would increase labor costs for participants. It would also likely be a far greater burden were a single Office to facilitate the project.

44. However, there may be solutions, such as examiners providing feedback at the point of examining the application on entrance to the national phase, and collecting these results over a greater period of time. Discussions could then be held by participants at regular times (for example, annually).

45. Smaller scale projects, similar to the one detailed in the report, could also be run if there was enough interest and/or if other Offices wished to be involved before committing to a larger project.

46. The UK IPO is keen to continue working on and facilitating this project. If any Office would like to offer suggestions or be involved in developing this project, please contact Charles Jarman at charles.jarman@ipo.gov.uk.

47. The Working Group is invited:

(i) to comment on any aspect of this phase of the pilot or its findings; and

(ii) to begin discussions on how this project could be developed or expanded.

[Annexes follow]

ISR FEEDBACK FORM

ISA:

ISA Authorized Officer:

Date of International Search:

PCT publication number:

National-phase publication number:

PCT application number:

1. Were there any substantive amendments filed following the issue of the ISR but prior to examination such that the scope of the claimed inventions has changed?

(If yes, briefly describe how)

2. Were there citations not present in the ISR which you relied upon when conducting your examination? If so, please list these below.

3. Were there any X/Y documents cited in the International Search Report you considered to be A documents? If so, please briefly explain why. (Write N/A if there were no X/Y documents cited in the ISR)

4. Were there any A documents cited in the International Search Report you considered to be X/Y documents? (Write N/A if there were no A documents cited in the ISR)

5. Did you extend the field of search at examination to provide new subclasses or databases not listed by the ISA? If so, please list them below, and provide a brief explanation why this was done.

6. If keywords were on the ISR, did you use any new keywords when completing the search? If so, please list them below. (Write N/A if there were no keywords on the ISR)

[Annex II follows]

IPO FEEDBACK RESPONSE FORM

1. How did you use the feedback provided? e.g. identified a specific training need, extended field of search for similar applications

2. Which aspects of the feedback were most useful?

3. Which aspects of the feedback were not as useful?

4. Is there any other feedback you would like to see included?

5. Do you have any ideas of how to improve the presentation of this feedback?

[End of Annex II and of document]