



The Korean Intellectual Property Office
and the
United States Patent and Trademark Office

Bilateral Work Sharing Program

SHARE Pilot Summary Report

I. Background

In 2008, the Korean Intellectual Property Office (KIPO) and the United States Patent and Trademark Office (USPTO) engaged in a comprehensive program to foster increased bilateral cooperation between the Offices. A Memorandum of Understanding was signed that year, and early in 2009 the offices jointly developed and agreed upon an Action Plan that defined project areas and served to guide the efforts of the team. The program was designed to provide mechanisms for exchanging information and best practices, with the ultimate goal of advancing work sharing between the Offices.

The primary focus of the bilateral program is the Strategic Handling of Applications for Rapid Examination (SHARE) pilot. According to the initial SHARE concept, when corresponding applications are filed in two offices, the Office of First Filing (OFF) will conduct a search and examination and share its findings with the Office of Second Filing (OSF), such that the OSF can maximize re-use of the work performed by the OFF and minimize duplication of examination work.

Prior to beginning the pilot, examiners from KIPO visited the USPTO examiners for an Examiner Exchange, where each Office presented an overview of their search and examination practices. The exchange was a great success, and the Offices developed a deeper understanding of each other's rules and processes. This knowledge, combined with lessons learned during the discussions, helped shape the details of the SHARE pilot.

The SHARE pilot was conducted from September 2009 to December 31, 2010, and was developed to ascertain examiner views on the usefulness of the other offices' work products. This SHARE pilot is one of the first concrete steps the USPTO has taken towards testing the key SHARE concepts and is grateful to have partnered with KIPO to test the feasibility of this work sharing effort. Results from the pilot will be used to inform and shape future work sharing pilots and programs.

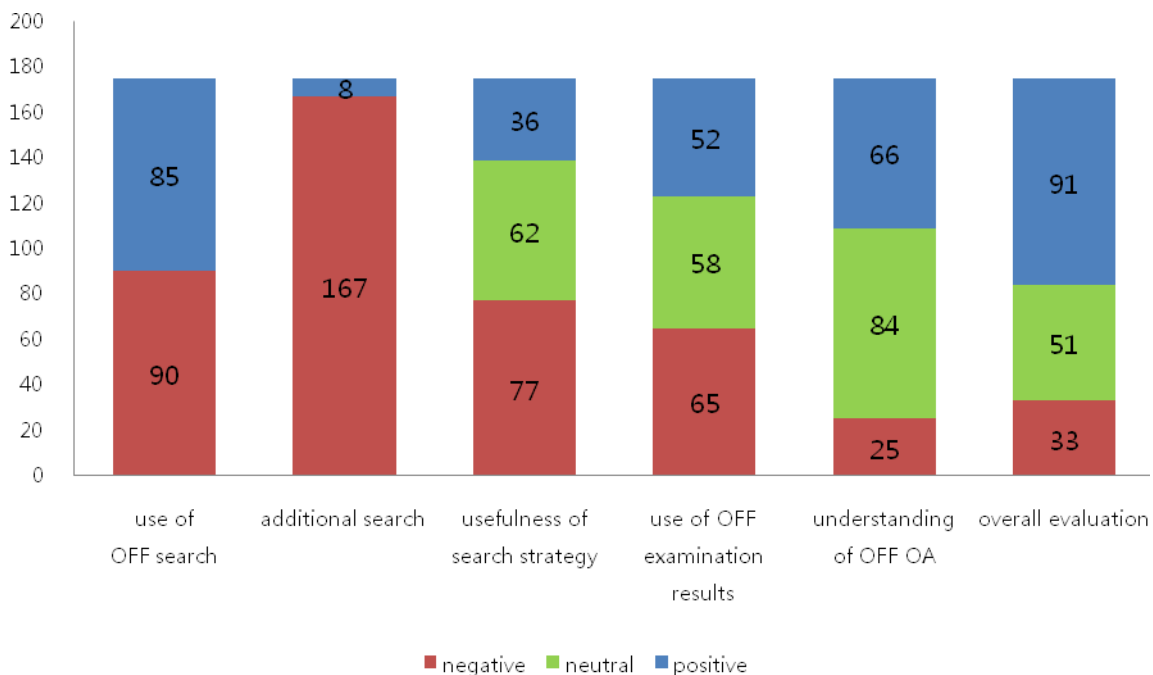
II. SHARE Pilot Methodology and Scope

The general approach of the pilot was to select applications that were filed in both offices and, after examination by the OFF, to have examiners in the OSF evaluate the examination results provided by the OFF during their examination of the corresponding cross-filed application. To ensure a sufficient number of applications would be available for the pilot, the Offices identified technical areas with a large number of cross-filings between the KIPO and USPTO. The technical areas selected were Semiconductor (IPClass H01L) and Fuel Cell (IPClass H01M). 344 applications were included in the pilot.

As part of the pilot, the USPTO hosted a collaborative examination workshop in September 2010. The objective of the workshop was to have an open dialogue between both offices to discuss the reuse of the searches by the OSF when the OFF has completed at least a First Action on the merits. Through this one-on-one collaboration, the participants realized the extent to which work from the OFF could be reused and compared with the searches done by the OSF.

III. Results

Evaluation Data from Both Offices



A total of 175 evaluations were completed from the 344 applications in the pilot. The reduction in the number of completed evaluations from the total applications can mostly be attributed to examination timing differences between the Offices. In other words, there were several instances where the OSF examined the application prior to examination by the OFF.

The Offices reported that examiners considered the references/documents from the OFF search in about 50% of the applications examined by the OSF. In most cases (95%), the examiners performed additional searches. However, this is not interpreted as a negative result, as the searches were done for reasons unrelated to the usefulness of the search completed by the OFF. For example, examiners may be required to do additional searches in accordance with the examination practices and requirements of their respective offices.

Examiners reported that the OFF search strategy was somewhat useful or useful in approximately 56% of the cases. Prosecution procedures between the offices are similar in that both offices complete search and examination results at the same time. As a positive finding, the OSF used the OFF results in over 60% of the cases.

The Offices found it easy to understand the OFF's Office Action or examination results in approximately 40% of the applications. In over 50% of the applications, examiners reported that they found the OFF examination results helpful during examination.

IV. Lessons Learned and Recommendations

The KIPO-USPTO SHARE pilot was extremely useful in providing information to the Offices on the work sharing concept. In addition, the pilot provides many best practices and lessons-learned that should be taken into consideration when designing subsequent pilots or programs.

In both Offices, searches by the OFF supplemented the searches performed by the OSF. Both Offices agree that, in general, a reference could be reused at least in part, but differing examination practices in each Office resulted in examiners applying the references differently. Accordingly, examiners often relied on references cited on a search report but could not solely rely on and consider the search complete due to the search guidelines and procedures within their respective offices. Regardless of the approach taken, examiners discovered the same or similar references. The more similarity between the offices' search results, the more each office will trust the work products of other offices. This trust is an important foundation of work sharing.

Another lesson learned, mentioned briefly earlier, is that examination timing differences between Offices can impact the number of applications available for work sharing.

Additional recommendations from examiners participating in the pilot and exchange program are summarized as follows:

- Understanding office procedures and training is very critical to the success of the work sharing initiative which can be achieved by cross training examiners through the available resources and continuing exchange programs.
- Continue with the efforts to improve quality and accuracy of available translations.
- Improve availability and access to family data and search results.

- Sharing the search strategy between the Offices proves useful and it is hoped that KIPO can move towards recordation practices similar to those at USPTO.
- If provided, a summary of the search and examination results from OFF would be a convenient way of utilizing OFF's work to help and enhance work sharing efficiency.
- Open communication between the offices is vital in order to further an understanding of each other's systems and the positions our examiners take in their office actions.

V. Next Steps for SHARE Pilot

Both the Offices are committed to this bilateral relationship and embrace the value gained by continuing this work. There are opportunities both bilaterally and within each Office to apply what was learned through this effort and to advance work sharing.

Promote work sharing: The Offices need to ensure that examiners are aware of work sharing, understand what it is, and the benefits it can deliver to examiners, the Offices and applicants. Emphasizing the benefits of work sharing to examiners is critical to providing them with the incentive to access and re-use work from other offices. For example, the pilot and its results could be promoted through the intranet, training, or via other resources at each Office.

Work towards changing the culture: The promotion of work sharing programs should aim to change how examiners view re-using work done by other examiners, especially in other offices. One way to accomplish this is through continued examiner exchanges. The benefits are clear to both Offices when examiners are able to meet in-person and discuss the practices, techniques, and even the culture at each Office.

Collaborate: The Offices should explore opportunities for examiners to collaborate on a more frequent basis. The Offices may wish to consider a collaboration pilot where cross-filed applications are identified that have not had a search or examination and enable the examiners to prosecute them collaboratively.

Design and conduct new pilots: It is proposed that the Offices continue to build from this foundational work and develop a new pilot based on what has been learned through this effort.

Since timing of examination is a constraint that limits the number of applications available, it is important that a new pilot address this issue. For example, rather than waiting for the Office of First Filing to complete the

search and examination of a particular application, the Offices could pursue a “first examination” approach where the results from the first office to complete examination are shared with the other office. Another approach could be to pursue similar work sharing mechanisms to expedite examination in the OFF, or to improve the automated mechanisms used to identify eligible applications for the pilot.

Finally, a suggestion was made to look for ways to engage applicants in the process. Both KIPO and the USPTO will work closely in the coming months to consider these options and develop another effective work sharing pilot with the hope of expanding our partnership and utilization of each other’s work product.

VI. Conclusion

The Offices concluded that this pilot brought forth valuable lessons about the SHARE concept specifically, and about work sharing in general. The Offices will now carefully consider these findings and use them to define the goals for the next phase of the partnership, and to determine the most effective course for moving forward. The findings and lessons learned from this pilot will reach beyond the scope of the KIPO-USPTO partnership as both Offices are engaged in other work sharing programs, both internally and with other IP Offices.