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SUMMARY OF DOCUMENT SCP/35/6: EXPEDITED EXAMINATION PROGRAMS OF IP OFFICES

Document prepared by the Secretariat

INTRODUCTION

1. The Standing Committee on the Law of Patents (SCP), at its thirty-fourth session held in Geneva from September 26 to 30, 2022, agreed that the Secretariat would prepare a document compiling information relating to the expedited examination programs of Intellectual Property Offices (IPOs), including information on Prioritized Examination of COVID-19 related patent applications. It was also agreed that the document would include those expedited examination programs discussed during the thirty-fourth session of the SCP as well as any additional contributions provided to the Secretariat by Member States prior to its thirty-fifth session (see document SCP/34/8, paragraph 25, second bullet point under “Quality of Patents, including Opposition Systems”).

2. Consequently, document SCP/35/6 contains the compilation of the said information for the Committee’s discussions at its thirty-fifth session to be held in Geneva from October 16 to 20, 2023, prepared in accordance with the above decision of the SCP.¹ This document constitutes a summary of document SCP/35/6.

¹ The Secretariat invited Member States and regional patent offices, through Circular Note C. 9141 dated December 7, 2022, to submit relevant inputs to the International Bureau. The information received is published on the website of the SCP electronic forum at:
https://www.wipo.int/scp/en/meetings/session_35/comments_received.html.

EXPEDITED EXAMINATION PROGRAMS OF IP OFFICES

Background

3. Patent offices around the globe recognize the importance of timely delivery of their decisions. Irrespective of its underlying causes, prolonged pendency can have significant consequences.² It can lead to delays in the commercialization of technologies and hinder the objectives of the patent system as a whole. Delays can be particularly problematic in fast-paced industries where innovation cycles are short. Thus, timeliness in the evaluation of patent applications is recognized as one of the important elements contributing to the quality of the patent granting process.³ This means that not only the quality of examination reports but also the speed at which they are delivered are vital to the quality of patents.

4. To address the issue of patent pendency and serve the needs of innovators/applicants efficiently, many IPOs have implemented expedited examination programs. These programs are designed to accelerate the processing and examination of patent applications, allowing the applicants to obtain decisions on their patent applications in a more expeditious fashion compared to applications processed according to the conventional examination timeline. In essence, eligible applications are examined as a matter of priority and, consequently, the time needed to obtain a patent could be significantly reduced.

Types of expedited examination programs/Grounds

5. The submissions by Member States have revealed that the types of expedited examination programs offered by the respective offices differ one from another.⁴ While it is difficult to summarize all available expedited examination programs, the following general observation can be made.

6. In many IPOs, expedited examination programs may be requested on one or more grounds. In some countries, the program is available to any applicant and applies to applications in any field of technology. In other countries, the program is available to eligible applications/applicants under the applicable law, and the possibility to accelerate examination procedures may depend on various qualifications, the most popular being:

- (i) the status of the applicant (such as a small or medium-sized enterprise or startup business, an elderly applicant or an applicant who is seriously ill, or a public entity);
- (ii) whether the application relates to a certain area of technology (such as green technology, health-related technology or artificial intelligence);
- (iii) whether the expedited examination is justified based on public interest (such as national emergency, defence purposes or disaster prevention);

² Patent pendency refers to the time it takes for a patent office to evaluate and grant or reject a patent application. Several factors can influence patent pendency, including examiner staffing, available IT resources, the number of patent applications filed, the complexity of technology covered in the applications, and the length of applications as well as applicant behavior. Some factors may be beyond the control of the patent offices, such as a sudden surge in patent applications filed.

³ For discussions on the concept of “quality of patents” and timeliness as a component of patent quality, see document SCP/26/3.

⁴ See Section III of document SCP/35/6 for the information on expedited examination programs implemented at IPOs in various countries.

(iv) business circumstances of the applicant (such as an applicant requesting a public fund, anticipating infringement proceedings, or intending to commercialize the invention); and

(v) conditions on the filing route (e.g., the application was first filed in the national IPO, or it has been or will be filed in at least one other foreign IPO).

7. In addition, according to Member States' submissions, some other types of expedited examination are introduced in some countries. For example, in Israel, if an application has been subjected to an unreasonably long examination pendency, an applicant can request a fast-track examination. In the Republic of Korea, applications directly related to export promotion and applications filed by an enterprise selected as an exemplary company under the national law,⁵ among others, can also be admitted for expedited examination. Similarly, in Japan, applications relating to technologies resulting from the R&D activities accredited under the national law⁶ may enjoy the benefit of expedited examination. As another example, the IP Office of Canada provides an expedited examination when an applicant is able to demonstrate that the standard examination procedure and pendency would cause its rights to be prejudiced.

8. Furthermore, in a number of IPOs, the expedited examination programs are available with respect to patent applications which concern COVID-19 specifically.⁷ Such programs aim to facilitate fast entry into the marketplace of critical technologies to address the global crisis for the benefit of the public.

9. Table 1, below, provides a general, indicative and non-exhaustive list of grounds and/or types of expedited examination programs provided by IPOs.⁸

Table 1 Types of Expedited Examination Programs provided by IPOs (Indicative)

Expedited Examination Types/Grounds	Details	Countries
General Expedited Examination	A program generally available to any applicant and for all types of applications.	Finland, France, Republic of Moldova, Singapore, Slovakia, Spain, United States of America, European Patent Office
Public Interest/National Emergency/ Defense	Expedited examination of the application is justified by a national emergency, the benefit of the general public or for defense purposes.	Australia, Brazil, China, Israel, Japan, Republic of Korea, United States of America
COVID-19	The application concerns technologies that are used in relation to COVID-19 specifically	Brazil, Bulgaria, Canada, China, France, Israel, Morocco, Republic of Korea,

⁵ Invention Promotion Act

⁶ Act on Special Measures for the Promotion of Research and Development Business, etc. by Specified Multinational Enterprises.
https://www.meti.go.jp/english/policy/external_economy/investment/act_information.html

⁷ According to the responses received from the Member States, these countries are: Brazil, Bulgaria, Canada, China, France, Israel, Morocco, the Republic of Korea, the Russian Federation, and the United States of America.

⁸ Thus, for an accurate information and precise language used with respect to the expedited examination program in a specific jurisdiction, readers must consult relevant national/regional legislation/regulation.

		Russian Federation, United States of America
Health-Care Related Technology	Subject matter of the patent application concerns health-related technologies.	Brazil, Republic of Korea, Russian Federation, Thailand, United States of America
Green Technology	Subject matter of the patent application concerns green technologies or other technologies that aim to improve the environment.	Australia, Brazil, Bulgaria, Canada, China, Finland, Israel, Japan, Republic of Korea, Spain, United States of America
Certain Other Technology Areas	The application concerns certain technological areas, such as AI, IoT, big data, cloud computing, etc.	China, Republic of Korea, Russian Federation
Applications Filed by Small and Medium-Sized Enterprises/Startups/Venture Businesses or Others	The application is filed by an applicant having the status of a Small or Medium-Sized Enterprise, a venture business or another type of business or enterprise.	Australia, Brazil, Canada, Japan, Morocco, Republic of Korea
Application Filed by Public Entity or Scientific/Technological Institution or is Related to Education/Duties of the State	The application is filed by a public, scientific or technological institution or otherwise by an institution related to education or duties of the state.	Brazil, Japan, Republic of Korea
Health/Age of Applicant or Inventor	The applicant's or inventor's health or age justifies expedited examination of the application.	Brazil, Israel, Republic of Korea, United States of America
First-time Filer Applicant or Recipient of an Award	The applicant is filing an application for the first time before the IPO, or is the recipient of an award in the respective country.	United States of America
Need to Commercialize/Produce/Export/License the Invention	The grounds for requesting expedited examination are related to the commercialization, production or licensing of the invention.	Australia, Brazil, China, Israel, Japan, Norway, Republic of Korea
Needs Relating to Unauthorized Use of the Invention by a Third Party	The applicant alleges unauthorized use of the claimed invention by a third party.	Australia, Brazil, China, Israel, Norway, Republic of Korea
Application First Filed in the Country	The application is first filed in the respective country.	Brazil, China, Czech Republic, Japan, Norway, Singapore, Thailand
Application is filed in Conjunction with Another Application	The application has been or will be filed in at least one other foreign IPO (claiming priority)	Israel, Japan, Norway, Republic of Korea

Application is an International Application under the PCT or the Office acts as the Receiving Office or International Searching Authority (ISA)	The program applies with respect to international applications under the PCT or when the Office acts as the Receiving Office/ISA	Japan, Republic of Korea, Spain, Thailand
After Unreasonably Long Pendency for Examination	Possibility to request expedited examination arises if the application has not been examined in due time.	Israel
Applicant has Requested/Intend to Receive Funding or Investment	The applicant has been granted public funding or is requesting funding, e.g., from credit institutions.	Australia, Brazil, Norway
Applicant's Rights Would be Affected Under Regular Examination	Justification for expedited examination is provided when applicant is able to demonstrate that the standard procedure and pendency would cause their rights to be prejudiced.	Canada
PPH	Expedited examination is carried out by virtue of any of the Patent Prosecution Highway programs.	Information on PPH-implementing Member States can be consulted in each respective IPO's website or the PPH Portal website. ⁹

Rationale for provision of expedited examination programs

10. Depending on the types of expedited examination programs offered by the IPOs, the rationale behind expedited examination practices may be different and can be attributed to several compelling reasons, including:

- **Facilitating Commercialization:** Expedited examination practices facilitate the commercialization of patented products and foster business partnerships. Businesses can more readily license or enforce their IP rights when they are granted quickly.
- **Responding to Emerging Technologies:** In rapidly evolving technological fields, timely protection of intellectual property is critical. Expedited examination practices allow applicants in these cutting-edge industries to secure their rights swiftly, enabling them to capitalize on their innovations before they become obsolete.
- **Supporting Small Businesses and Startups:** Small businesses and startups often have limited resources and need to commercialize their intellectual property quickly to compete in the market. Expedited examination practices level the playing field by giving these entities a faster route to protection, enabling them to compete effectively with larger companies.
- **Addressing global challenges:** Technology plays a pivotal role in addressing and resolving some of humanity's most pressing challenges, such as global climate change, the COVID-19 pandemic, or unforeseen global crises that may emerge. The public

⁹ Available at: <https://www.jpo.go.jp/e/toppage/pph-portal/index.html>.

greatly benefits from the timely delivery of solutions to pressing global issues and swift deployment of these technologies.

➤ Public interest or humanitarian consideration: Exceptional circumstances such as national emergency (e.g., natural disaster), or humanitarian reasons (e.g., the age/health conditions of applicants) may justify expeditious processing of patent applications based on public interest or humanitarian consideration.

11. In addition to the above, it was suggested that, on a larger scale, delay in granting patent rights can affect the flow of foreign investment, with subsequent repercussions on domestic innovation reliant on this important venture capital for research and development.¹⁰

12. In summary, with respect to rationale of such programs, by prioritizing certain applications, IPOs can create a dynamic and responsive intellectual property ecosystem that benefits both applicants and society as a whole. These practices play a vital role in shaping the innovation landscape and driving economic growth in today's fast-paced world.

Procedure and conditions

13. Process and conditions for requesting accelerated examination may be different from one office to another. In most offices, such acceleration is subject to an express request by the applicant¹¹ within a certain time limit.¹² In general, applicants are required to provide justification and supporting documents to qualify for a specific program.

14. In several offices, to qualify for the acceleration program, a patent application and/or a request for participation in such a program must be filed electronically *via* the office's electronic filing system.¹³

15. As the number of requests for participation in the fast-track examination programs can be high in some technological fields, in some offices, accelerated prosecution of the application is provided only where it is practically feasible, i.e., the acceptance of such requests is subject to the workload of search and examining divisions.¹⁴

16. Specific conditions to be met to qualify for accelerated examination are different from one office to another and between various types of programs in the same office. For example, in some offices, the number of claims in the application must be limited to a certain number,¹⁵ and

¹⁰ See the proposal of the United States of America for an information exchange on expedited patent examination mechanisms at intellectual property offices, contained in document SCP/33/4.

¹¹ In Slovakia, applicants do not have to request expedited examination of a patent application – examination of an application is expedited based on fulfilment of qualifying conditions. In Brazil, the expedited examination can be requested by a prior user. See Section III of document SCP/35/6 with respect to Slovakia and Brazil, respectively.

¹² E.g., at the same time as the patent application is filed (e.g. Norway and Spain); at any time following the filing of the patent application (e.g., Australia); before the first office action has been issued (e.g. see 'Cancer Moonshot Expedited Examination Pilot Program' in the United States of America); at any time once responsibility for the application has passed to the examining division (see, e.g., European Patent Office (EPO)).

¹³ See, e.g., China, Thailand, United States of America, and EPO.

¹⁴ See, e.g., China, Finland, United States of America and EPO. In Singapore, the application needs to be made within the cap limits established by the Intellectual Property Office of Singapore (IPOS), which currently stands at 10 patent requests per month, in general, and two requests per entity (individual or corporation).

¹⁵ E.g., in Thailand, the application shall contain no more than 10 claims throughout the period of participation in the program; In Singapore, the application must contain 20 or fewer claims; in the United States of America, application must contain three or fewer independent claims and twenty or fewer total claims, and must not contain multiple dependent claims.

the application must be complete to be considered for expedited examination.¹⁶ Another difference among the offices is the availability of accelerated examination for international applications under the PCT that entered the national phase.¹⁷

17. With respect to prioritized examination of COVID-19-related applications, some other conditions may need to be fulfilled. For example, in one office, to be granted a prioritized examination status, a request must include a certification that the applicant qualifies for small or micro entity status, and also a certification that the claim(s) of the patent application cover a product or process subject to an applicable FDA approval for COVID-19 use.¹⁸

18. Under some circumstances, offices can remove an application from the accelerated examination program, resulting in the application being examined according to a standard examination procedure. For example, such circumstances in some offices include: (i) the request for accelerated examination or application has been withdrawn; (ii) the applicant has requested an extension of time limits; (iii) the application has been found to be irregular; and (iv) the application has been amended.

Fees

19. The majority of the offices which provided information on their accelerated examination programs do not require payment of fees for requesting participation in such programs.¹⁹ In some offices, a fee may be required for some grounds for acceleration but not all.²⁰ In at least one office, the fees for expedited procedure increases by 100 per cent as compared to the fee established for the standard examination procedure.²¹ Among offices which offer accelerated examination procedure with respect to COVID-19-related applications specifically, only few offices require fees.²²

Reduced Pendency

20. The average pendency period of applications under regular patent examination varies from one office to another, and so is the average pendency period of applications under accelerated examination, since there are many factors that affect the period. In most of the offices that provided information on pendency, it takes on average more than a year or two to receive a final decision of the office on applications processed according to a regular procedure. Pendency for applications which were examined under accelerated procedure has been reduced by half of that time in some offices, whereas in other offices, to several months.²³ Several offices reported that the average pendency of application processed under the

¹⁶ Other conditions are stipulated in some offices' rules for qualification under such programs. E.g., in USPTO: Claims must be directed to a single invention; Petition must include a statement agreeing to have an interview with the examiner to discuss any outstanding issues arising in the examination process; Applicant must provide a statement that a pre-examination search was conducted meeting certain requirements; and Applicant must provide an accelerated examination support document that satisfies certain requirements.

¹⁷ Some offices apply national fast-track programs to PCT applications at the national phase (although PCT-PPH may be available), while some other offices do. In some other offices, accelerated examination is available if the office was a Receiving Office or an International Searching Authority for the respective PCT application.

¹⁸ The United States Patent and Trademark Office.

¹⁹ These are IPOs in: Australia, Finland, France, Morocco, Norway, Singapore, Slovakia, Spain, Thailand, and EPO.

²⁰ See, e.g. Israel and the United States of America.

²¹ See the Republic of Moldova.

²² These countries are Brazil and the Republic of Korea. However, in the Republic of Korea, startups within three years of their founding obtain 70 per cent discount on fee within 10 cases on a yearly basis.

²³ For example, in Japan, average pendency from request for examination to grant of a patent for applications processed under accelerated examination is 5.6 months and applications processed under super accelerated examination is 2.6 months (while for regular applications the pendency is 15.2 months); In Singapore, under SG IP FAST, an applicant may be granted a patent within six months, subject to the complexity of the patent application.

accelerated programs is around 12 months.²⁴ In two offices, examination pendency for expedited applications is around 20 or 24 months from the filing date or the time of filing a request for such an examination.²⁵

Patent Prosecution Highway (PPH) and Other Bilateral and Multilateral Initiatives

21. The Patent Prosecution Highway (PPH) is an examination cooperation program between two IP Offices, typically managed by a number of bilateral PPH agreements between cooperating Offices. Under the agreements, if the claims of an application are found patentable by the first office (OEE: Office of Earlier Examination), an applicant may request accelerated examination of corresponding claims in a corresponding application at the second office (OLE: Office of Later Examination). The accelerated examination procedures allow applicants to obtain a final examination decision at the OLE more quickly. The OLE can utilize the positive search and examination result of the OEE, while considering the compliance with the patentability requirements under the national law of the OLE. Applying the same PPH principle, some patent offices have concluded agreements which integrate bilateral schemes to a plurilateral scheme. A multi-party PPH allows applicants to request an accelerated examination of a corresponding application at any of the participating office, if the claims of the application are found allowable by any other participating office. Document SCP/35/6 provides information on the various PPH programs.²⁶ In addition, other collaborative initiatives, bilateral or plurilateral, that aim to expedite examination procedures are also outlined in document SCP/35/6.²⁷

[End of document]

²⁴ See, e.g., Canada, China, Finland, Norway, and the United States of America.

²⁵ France and Slovakia, respectively.

²⁶ See section IV of document SCP/35/6.

²⁷ See section V of document SCP/35/6.