



Biotechnology/Chemical/Pharmaceutical Customer Partnership Meeting

Overview of USPTO Work-Sharing

Bruce Kisliuk - Assistant Deputy Commissioner for Patent Operations,
Chemical Disciplines & Designs, USPTO

December 8, 2010

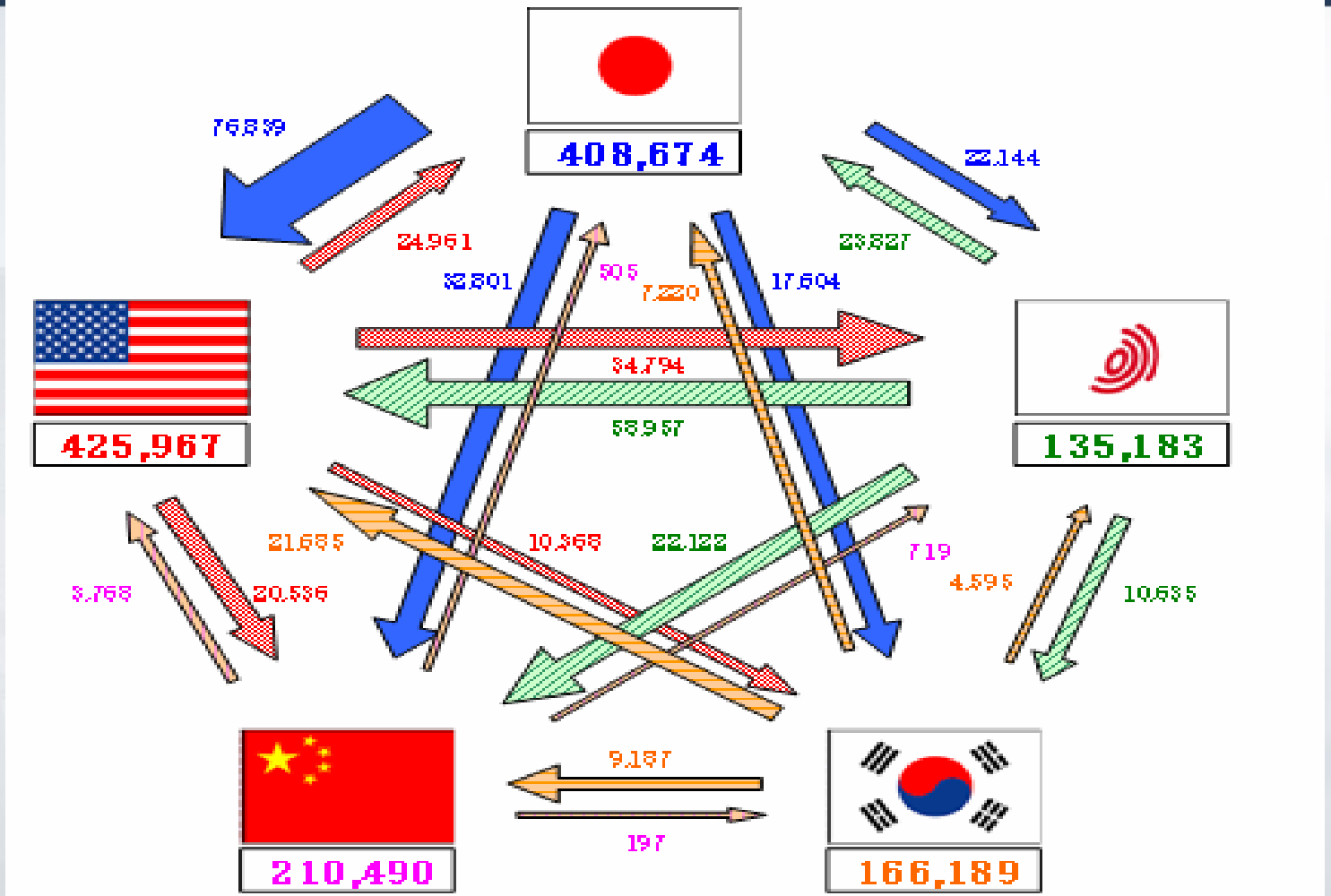


Work-sharing

- Work Sharing
 - Re-use the search and examination results done on an application or corresponding application to the maximum extent practicable in order to minimize duplication of work.



Background



2006 Cross filing Applications among IP5 Offices



Foundations of Work-sharing

Examiner Perspective:

- **Awareness** that prior work results are available
- **Access** to results
- **Understanding** the substance of the results

Applicant/User Perspective:

- **Awareness** of re-use programs and when they are available
- **Access** to re-use programs of different IP Offices
- **Understanding** the benefits



Work-sharing Initiatives

- Patent Prosecution Highway (PPH)
- SHARE-type initiatives:
 - USPTO-KIPO SHARE Pilot
 - USPTO & UK-IPO Action Plan for Re-use
 - JP-First
 - Trilateral FLASH Pilot
- PCT Updates



PPH: Fast Track Examination of Applications

- **What is PPH?**
 - When claims are determined to be allowable in the Office of First Filing (OFF), a corresponding application with corresponding claims filed in the Office of Second Filing (OSF) may be advanced out of turn
- **What is the Purpose of PPH?**
 - OSF can utilize the search and examination results of the OFF thereby avoiding duplication of work and expediting the examination process in the OSF
- **PPH Benefits for Applicant**
 - Provides quicker patentability determination in multiple jurisdictions
 - Decreases costs of prosecution

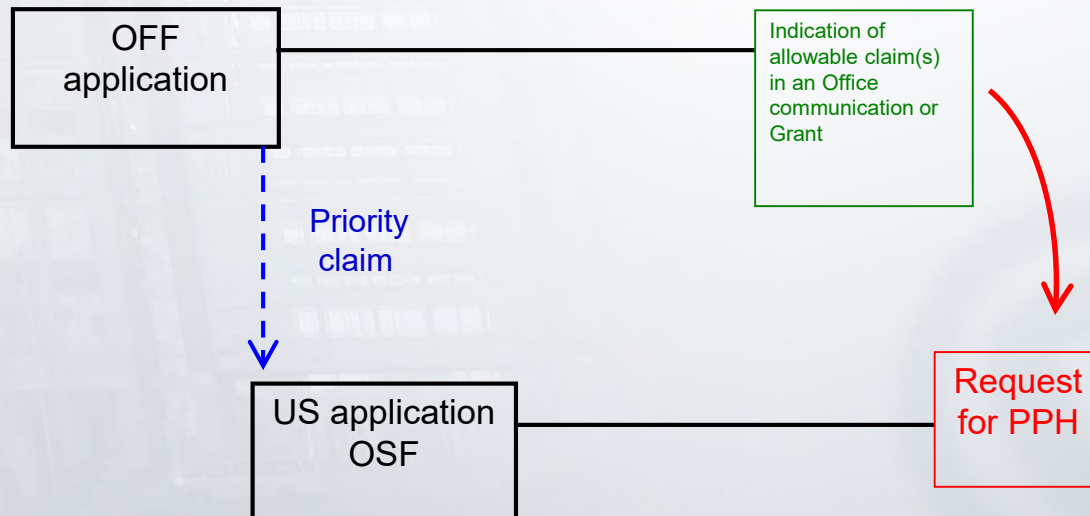


Example: Paris Convention and National Applications

The U.S. application is

(a) a Paris Convention application which either

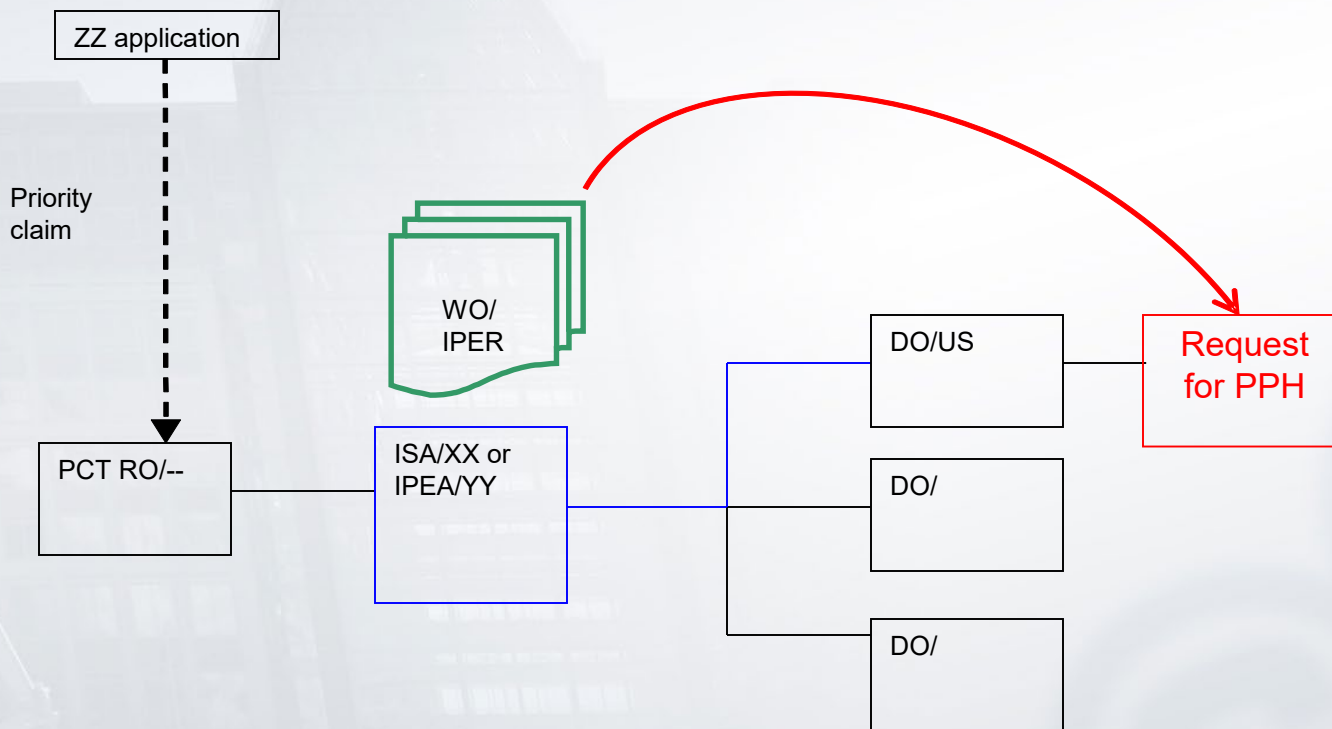
(i) validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed with OFF





One Example of PCT-PPH

US application is national stage entry of the corresponding PCT application
Corresponding PCT application claims priority to a national application filed anywhere



XX=JP, US, EP, KIPO, Spain, Russia, Austria
YY=JP, US, EP, KIPO, Spain, Russia, Austria



Current and Planned PPH Programs

- Japan (JPO) PPH Pilot July 2006, Full Jan. 2008
 - United Kingdom PPH (UK IPO) Sept. 2007
 - Korea (KIPO) PPH Pilot Jan. 2008, Full Jan. 2009
 - Canada (CIPO) PPH Jan. 2008
 - Australia (IPAU) PPH April 2008
 - European Patent Office (EPO) PPH Sept. 2008
 - Denmark (DKPTO) PPH Nov. 2008
 - Germany (DPMA) PPH April 2009
 - Singapore (IPOS) PPH Feb. 2009
 - Finland (NBPR) PPH July 2009
-
- Trilateral (EPO & JPO) PCT-PPH Jan. 2010
 - Korea (KIPO) PCT-PPH June 2010, only KIPO-to-US
 - Hungary (HPO) PPH July 2010
 - Russia (Rospatent) PPH & PCT-PPH Sept. 2010
 - Spain (SPTO) PPH & PCT-PPH Oct. 2010
 - Austria (APO) PPH & PCT-PPH Oct. 2010
 - **China in discussions, Israel planned**





Paris-Route PPH Statistics

		OFFICE OF SECOND FILING - OSF														
		JPO	USPTO	KIPO	UK-IPO	DPMA	CIPO	IP-AU	DKPTO	EPO	IPOS	NBPR	ROSPATENT	APO	HPO	
OFFICE OF FIRST FILING - OFF	Totals	1058	3543	682	35	0	1117	57	1	80	2	1	0	0	0	
	JPO	3139	2706	460	17		13	-	1	41	0	1		0	0	
	USPTO	2313	874	222	18		1101	57	0	39	2	0	-	-	-	
	KIPO	612	102	519	0		3	-	0	-	-	0		-	-	
	UK-IPO	112	18	104	0		-	-	-	-	-	-	-	-	-	
	DPMA	74	52	24	0		-	-	-	-	-	-	-	-	-	
	CIPO	33	0	36	0		-	-	0	-	-	-	-	-	-	
	IP-AU	38	-	40	-		-	-	-	-	-	-	-	-	-	
	DKPTO	41	2	42	0		-	-	-	-	-	-	-	-	-	
	EPO	60	6	61	-		-	-	-	-	-	-	-	-	-	
	IPOS	1	0	1	-		-	-	-	-	-	-	-	-	-	
	NBPR	13	3	10	0		-	-	-	-	-	-	-	0	0	
	ROSPATENT	1	1	-	0		-	-	-	-	-	-	-	-	-	
	APO	0	0	-	-		-	-	-	-	-	-	0	-	0	
	HPO	0	0	0	-		-	-	-	-	-	-	0	-	0	

USPTO data as of September 1, 2010. Other data as of the end of July 2010.



PCT-PPH Statistics

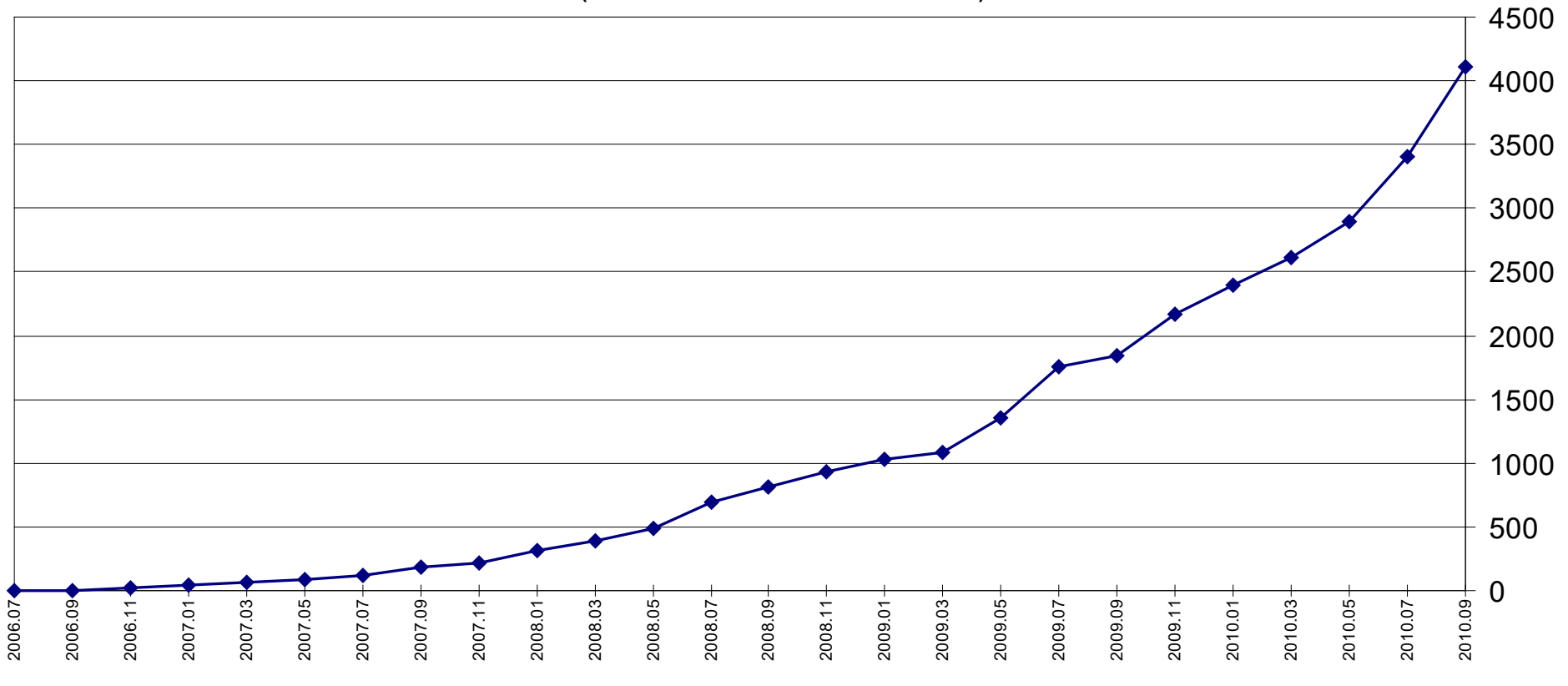
		Office of National Stage Filing						
			JPO	USPTO	EPO	NBPR	KIPO	APO
ISA/IPEA	Totals	197	346	5	0	0	0	
	JPO	166	71	104	5	0	-	-
	USPTO	1	1	0	0	-	-	-
	EPO	209	125	97	-	-	-	-
	NBPR	0	0	-	-	-	-	0
	KIPO	89	-	145	-	-	-	-
	APO	0	-	-	-	0	-	-

USPTO data as of September 1, 2010. Other data as of the end of July 2010.



PPH Requests at the USPTO

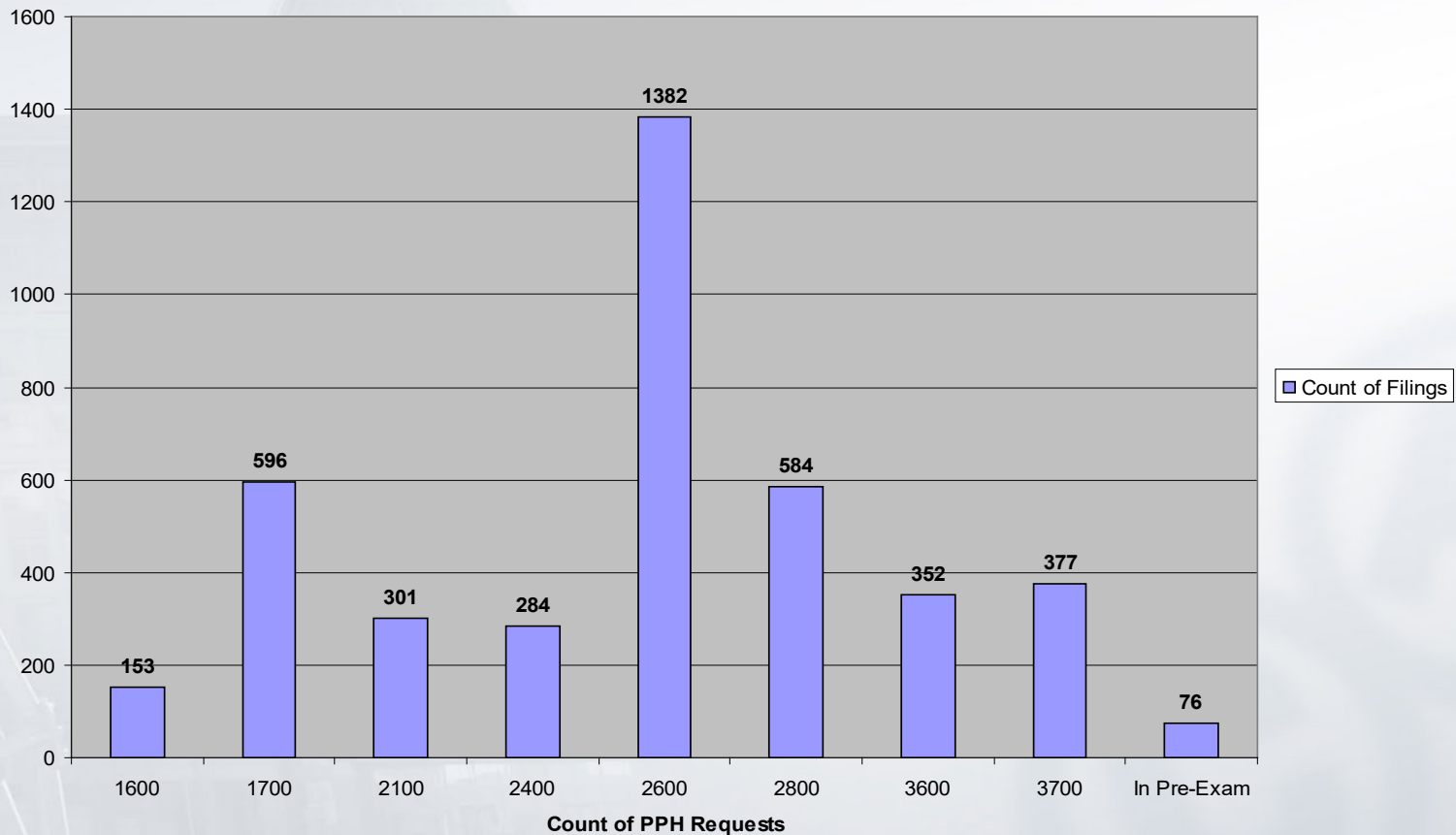
Total PPH Requests at USPTO as OSF
(includes Paris-route PPH & PCT-PPH)





PPH Requests by Technology Center

Cumulative Total of Paris-Route and PCT-PPH Cases





PPH Statistics - Benefits

For example, when USPTO is the Office of Second Filing:

- **Overall Allowance Rate**

- PPH cases: 92%
- Non-PPH cases: 45%

- **Actions to Complete Patent Application Prosecution**

- PPH cases: 1.9
- Non-PPH cases: 2.4

- **About 20% reduction in number of claims.**

- **Pendency reduction varies, but an 18 month decrease has been observed in some technologies.**

www.uspto.gov/patents/init_events/pph/index.jsp



Promoting PPH

- USPTO eliminated the PPH petition fee (effective May 25, 2010)
- Robust outreach campaign launched
 - PPH informational video and brochure for external stakeholders (*on USPTO website*)
 - Communication plan targeting key meetings and audiences
 - Articles and blogs in popular IP publications
- Question and feedback e-mail inbox established (PPHfeedback@uspto.gov)
- FAQs posted on USPTO website



SHARE Background

SHARE = **S**trategic **H**andling of **A**pplications for **R**apid **E**xamination

The SHARE concept is intended to appropriately prioritize and balance workloads in order to be able to maximize re-use of foreign search and examination results and minimize duplication of examination work done in other IP offices.

One important distinction of the SHARE-related projects relative to the PPH is that SHARE does not depend on an applicant's request to reutilize work; it operates independently of such requirements. As such, its potential is not limited in the same way that PPH is limited by applicant requests.



SHARE-Related Projects

- **USPTO and Korean Intellectual Property Office (KIPO) agreed to cooperate on a one-year SHARE pilot, which began in Fall 2009.**
 - To maximize re-use, the OSF waited to perform their search until the OFF completes their search on 326 cross-filed applications.
 - Completion of all office actions expected by Jan. 2011, final evaluation by April 2011.
- **USPTO & United Kingdom (UK-IPO) Action Plan (March 2010 Press Release)**
 - Focusing on “Office-driven” mechanisms for reutilization of work, versus applicant-initiated.
 - Timing between the two offices is such that in cross-filed applications, USPTO can use the UK search results for our FAs, and UK can use USPTO FAs for their examination phase.
- **JP-FIRST**
 - JPO accelerates certain work as OFF if there is an OFF, JPO shares with the USPTO a list of applications with JPO actions done.
- **FLASH – First Look Application Sharing**
 - Relatively small scale Trilateral pilot to accelerate U.S. first actions when we are aware there is a foreign Office of Second Filing.
 - Within the year of filing in the U.S., applicants file a corresponding application in another Trilateral Office claiming priority to the U.S. application, and many request the U.S. priority document via PDX, thus providing an early indication that the USPTO is the OFF.



Biotechnology/Chemical/Pharmaceutical Customer Partnership Meeting

Updates on PCT

December 8, 2010



PCT Task Force

- Formed in the fall of 2009
- Mission
 - Ensure that USPTO provides world-class products and services under the PCT
- Public Outreach
 - Public meeting held January 2010
 - Heard comments on how the USPTO could improve performance as RO, ISA, IPEA and DO/EO
- Focus to date
 - Timeliness and quality of products and processing



PCT Timeliness

		FY2008	FY2009	FY2010	FY2011 goal
RO/US Receipt to record copy mailing		60 days	21 days	13 days	
DO/EO/US Receipt to release		369 days	379 days	251 days	
		Calendar year 2008	2009	2010	
ISA/US Mailing of ISR/WO within 16 months from priority		23%	77%	82%	
Mailing of ISR/WO within 18 months of priority		37%	87%	91%	
IPEA/US Mailing of IPER within 28 months from priority		15%	14%	12%	
Mailing of IPER within 30 months of priority		22%	22%	17%	



PCT Quality

- Modified the quality measures of contractor-prepared PCT work products to be more aligned with those of U.S. national applications to maximize potential for re-use
- Provided training to contractors
- Conducting Trilateral ISR re-use study
- Recently concluded a PCT collaborative search and examination pilot project



PCT Collaborative Search and Examination Pilot

- Pilot project aimed at testing the feasibility and the potential of collaborative work between examiners of different Offices in the international phase
- Small scale pilot between EPO, KIPO and USPTO
- Designed for six examiners per Office with each acting as:
 - The first examiner on two PCT applications in which their Office was selected as ISA
 - Peer examiner on two PCT applications from each of the other Offices



PCT Collaborative Search and Examination Pilot (continued)

- PCT Collaborative Pilot results and recommendations
 - Quality: Examiners indicated that the collaboration resulted in more complete final products
 - Sometimes additional citations were included
 - Sometimes no additional citations were included, but discussions provided confidence to examiners about results
 - Efficiency: Examiners indicated that, in general, little or no additional search would be required at national phase
 - Participating examiners recommended a 2nd phase pilot with focus on improving methodology and developing IT tools



Russia as ISA/IPEA

- Russian Federal Service for Intellectual Property, Patents and Trademarks (Rospatent) and the USPTO have signed an agreement for Rospatent to serve as ISA/IPEA for international applications filed in
 - RO/US
 - RO/IB
 - Where at least one applicant is a resident or national of the United States
- Rospatent international search fee = 449 USD
- Technical details are being finalized
- Start date to be announced



Resources

For more information, please visit our website at:

http://www.uspto.gov/patents/init_events/pph/index.jsp

Plurilateral PPH website can be found at:

http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.htm



Thank you!