

USE OF PCT TO REDUCE BACKLOGS

Samson Helfgott
Katten Muchin Rosenman LLP
New York, NY

FICPI/AIPLA
Colloquium on Backlog
June 17-18, 2010
Edinburgh, Scotland

- I. Reuse of a Patent Office's Own ISA Work
- II. Reuse of Work From Another ISA
- III. New PCT Proposals for Consideration

REUSE OF PATENT OFFICE'S OWN ISA WORK

CURRENT REUSE

USPTO

- PCT searches are outsourced
- US National Phase of PCT, where ISA/US, is searched again
- No certainty of search results where ISA/US, not even for US National Phase
- US applicants pay for 2 searches where ISA/US
- No benefit from using ISA/US

- More US Applicants are using ISA/KR
- Result: Costly, Duplications, No Certainty, Raises issues on Efficacy of entire PCT System, Raises questions on Quality

- **JPO**
 - In JPO no difference in time allotted for PCT or JP searches. However, domestic JP searches are usually outsourced
 - If claims are amended. Examiner decides if new search is needed. Complete Examiner discretion
 - If JP priority case was already searched by JPO, applicant can identify such earlier case in Part VII of PCT application form PCT/RO/10. The Examiner will use the prior search to the greatest extent possible. No limit of search time on Examiner.

- **EPO**
 - If EPO/ISA, NO additional search is carried out in EPO Regional Phase
 - However, Top-Up search for “secret” prior art done in EPO Regional Phase, e.g. before substantive examination, or during any supplemental search
 - Examiner “points” are the same for both PCT and EP searches
 - Same Examiner assigned to Regional Phase as was assigned to International Phase

- If claims amended upon entry into EP Regional Phase, Art. 137(4) EPC requires that any amendments must be unitary with the searched claims, thus amended claims will already have been encompassed by the original PCT search. Thus, no additional time is provided, even for amended claims
- If EP priority case was searched in EPO, the PCT application would be assigned to the same Examiner and a simple “cut & paste” of the previous search would be used for the PCT
- Chap. II now being used to expedite prosecution during the International Phase before entry into the EPO Regional Phase

POTENTIAL IMPROVED USE OF PCT BY THE SAME PATENT OFFICE

- Treat International & National Searches identically. If different treatment is necessary, make sure the quality of the searches is identical
- Do “top-up” search as part of first search (ISR or National) that occurs after 18 mos., and indicate that this includes the “top-up” search

- Whenever possible, use same Examiner for both PCT search and National search
 - e.g – If existing domestic and corresponding PCT application is being searched pull domestic case and send out FAOM
 - If existing US domestic application was already searched, assign same Examiner to the PCT application and “cut & paste” FAOM as ISR/WO
 - If only PCT application and then Domestic National Phase , assign to same Examiner that did the PCT ISR/WO. There should be no requirement for applicant to file National Phase early

- Must incentivize Examiners to do Quality PCT searches
- Must limit Examiner time (and points) for the “duplicate search”
- Provide “some” time (and credit) for “top-up” search, whenever it is done (ISR or National), but only one “top-up” search
- If claims of PCT and US are different: provide time (and credit), but reduced amount

- Encourage use of Chap II to begin prosecution of application early, and upon entry into National Phase have Examiner continue this ongoing prosecution
- If applicants have “certainty” that PCT search will be the same for the corresponding National application, more people will be using PCT
- Encourage use of Chap II to try and get “clean” claims for use in PPH system
- Goal: “One Search per Invention”

REUSE OF WORK FROM ANOTHER ISA

CURRENT STATUS

- Officially reductions in search fees and make use of the search results to the extent possible
- Un-officially, duplications in all patent offices
- “Top-up” search always required
- While change in claim scope can be used to justify new search, in most cases a new search is conducted even with same scope of claims

PPH-PCT PROGRAMS

- Too early to provide conclusions
- However, same improved rates and times should occur for PCT “allowed” cases as for National “allowed” cases
- If not, must examine quality of PCT work, and or reluctance on part of Examiners
- If same positive results, can be helpful in using PCT to reduce backlogs-will be a real help for all Patent Offices

NEW PCT PROPOSALS FOR CONSIDERATION

- Extend Search to after 18 months
- Extend International, Phase beyond 30/31 months
- Deferred Examination in PCT
- PCT “Lite”
- “Virtual Search”

CONCLUSION

- If countries are serious on making PCT a “world class system” they must stop treating it as a “stepchild”
- Patent Offices must take PCT seriously and let Examiners know the importance of PCT
- “One search for one invention”
- Continue working with User Community
- Can be a basic aid in reducing backlogs

**Contact Information for
Samson Helfgott
Director of Patents
Katten Muchin Rosenman LLP
575 Madison Ave.
New York, N.Y., 10022
(212) 940-8683
Samson.Helfgott@kattenlaw.com**

Disclaimer: This presentation does not constitute any specific legal or business advice.