



Worksharing: PPH, IP5, and Beyond

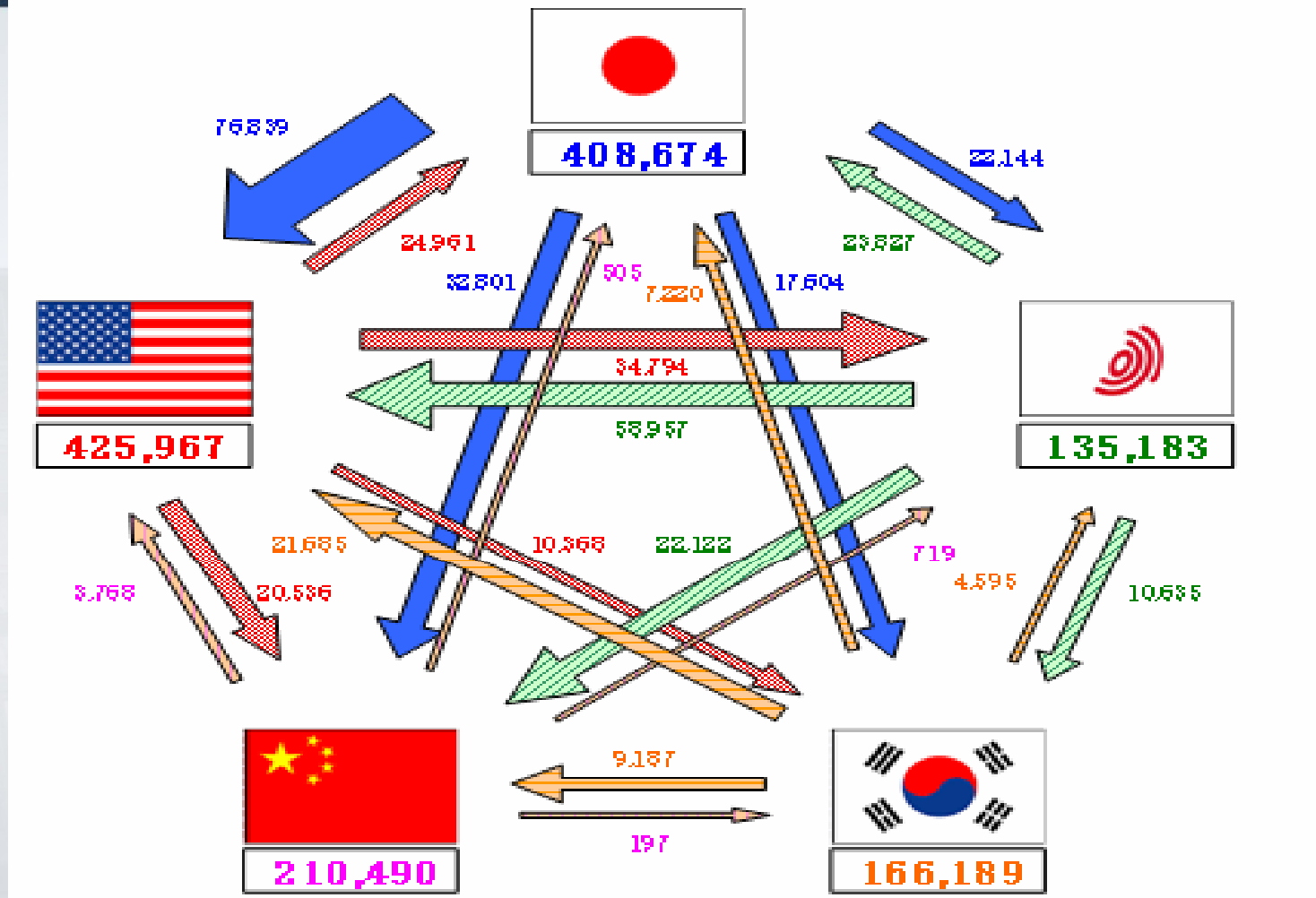
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Why Worksharing?



2006 Cross filing Applications among IP5 Offices



What is Worksharing?

The aim of worksharing is:

“The elimination of unnecessary duplication of work among the offices , enhancement of patent examination efficiency and quality, and guarantee of the stability of patent right.”

-Jeju Island Summit, 2008



Who is Involved, Where, and Since When?

- Nearly three decades of cooperation
 - Trilateral Offices (USPTO, EPO and JPO) since 1983
 - The Five IP Offices: a forum of the five largest offices (USPTO, EPO, JPO, KIPO, and SIPO) since 2007
- Bilateral Cooperation
 - Patent Prosecution Highway (PPH), examiner exchanges, symposia, information sharing



Worksharing Initiatives

- Patent Prosecution Highway
 - Pilot launch with JPO in 2006
- PCT
- IP5 Foundation Projects
- Other programs



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



What Are the Benefits of PPH?

PPH Benefits for Applicant

- Provides quicker patentability determination in multiple jurisdictions
- Decreases costs of prosecution



What Are the Benefits of PPH?

PPH Benefits for Offices

- Avoid redundant work by reuse of OFF work product
- Claims reduced in number and narrowed in scope to what was previously allowed
- Reduced Pendency



Some Basic PPH Requirements

Claim Correspondence

- All claims in the OSF application must “sufficiently correspond” to the allowable claims in the OFF application
- USPTO recently expanded the definition of “sufficient correspondence” to make the system more attractive while still providing work-sharing benefits



PPH Requirements (cont'd)

Qualifying Applications

- Current PPH Programs, generally speaking
 - Paris priority applications
 - PCT Bridge filings
 - Certain non-binding work product, e.g., EPO's EESR
- PCT-PPH Pilot
 - Launched January 29, 2010 among Trilateral Offices
 - Positive WO/ISA, WO/IPEA or IPER



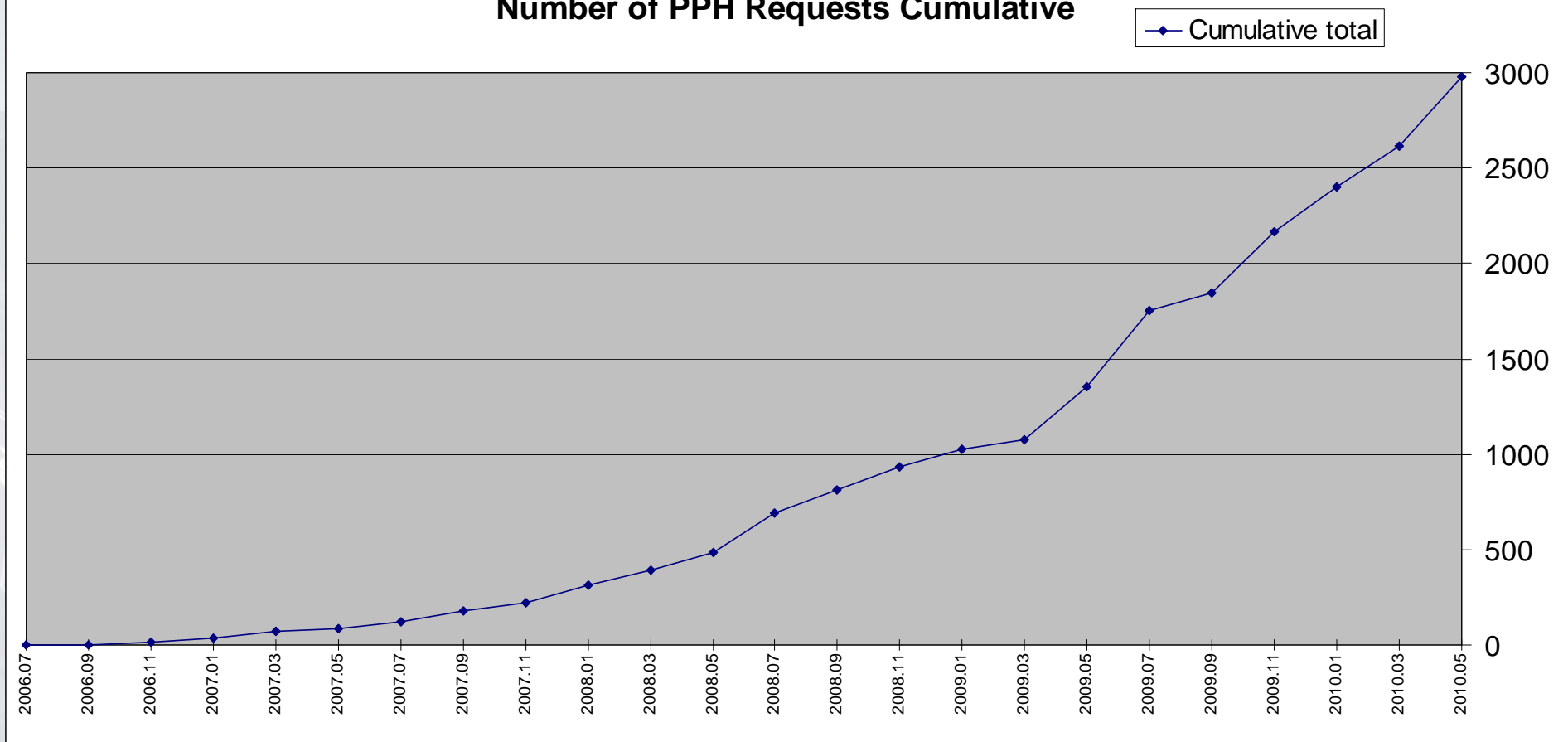
PPH Stats

First Office	Start Date	Requests (as of 1 May 2010)	
JPO	July 2006	2196 278 (Pilot) 1918 (Full)	
UKIPO	Sept 2007	82	
KIPO	Jan. 2008	452 134 (Pilot) 318 (Full)	Total
CIPO	Jan. 2008	29	2978
IPAU	April 2008	35	
EPO	Sept. 2008	41	
DKPTO	Nov. 2008	29	
DPMA	April 2009	25	
IPOS	Feb 2009	1	
NBPR	July 2009	7	
EPO (ISA/IPEA)	January 2010	35	
JPO(ISA/IPEA)	January 2010	46	



PPH Stats

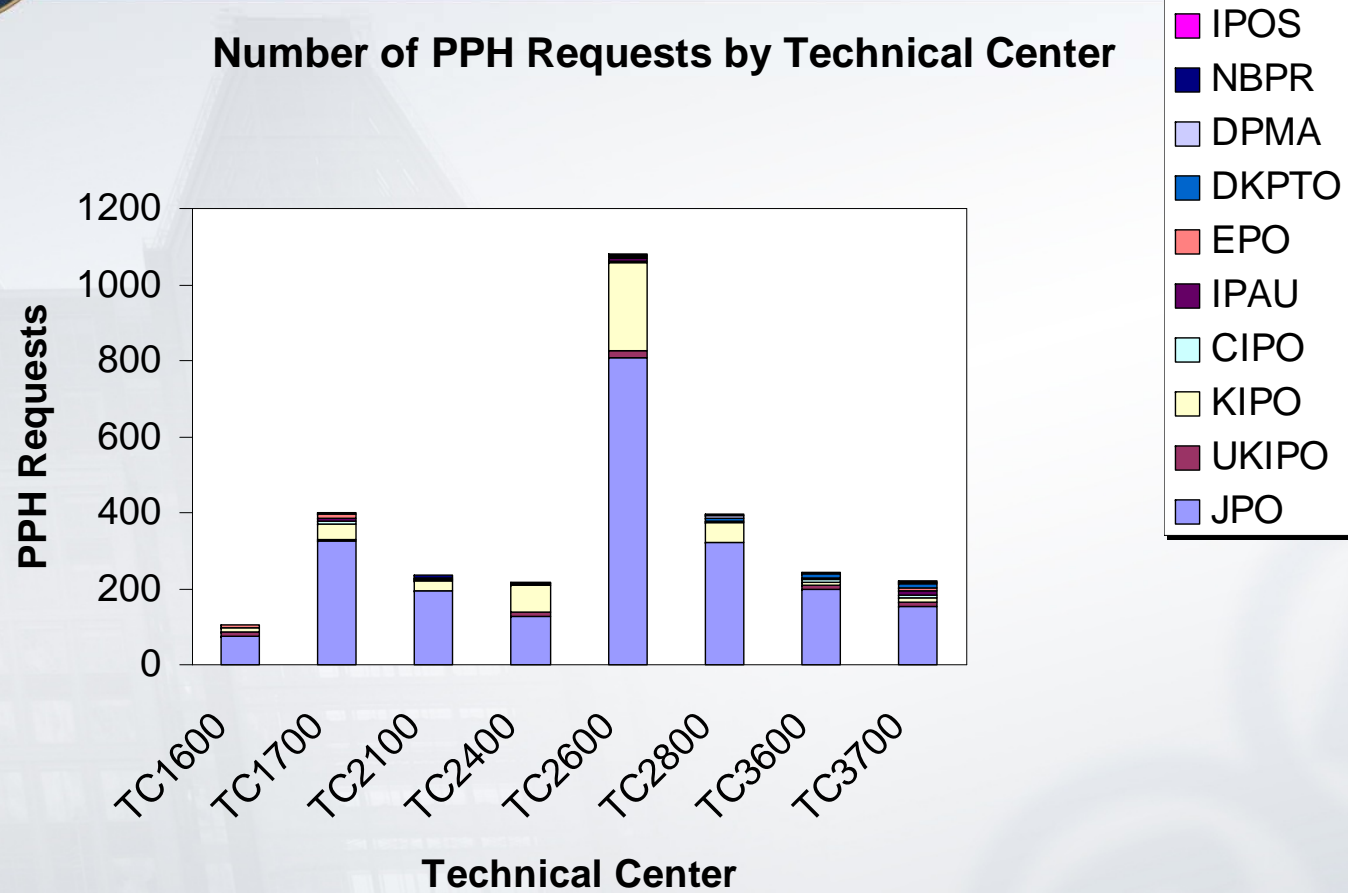
Number of PPH Requests Cumulative





PPH Stats

Number of PPH Requests by Technical Center





PPH Stats

Overall Allowance Rate

- PPH cases: 93%
- Non-PPH cases: 44%

Actions per disposal

- PPH cases: 1.7
- Non-PPH cases: 2.7 (though that has recently come down)

About 20% reduction in number of claims

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



Future Plans

- **USPTO Action Plan to enhance PPH:**
 - 4000, 8000, 16K and beyond . . .
 - Align PPH and PCT via the Trilateral pilot program
 - Conduct PPH awareness campaigns, internationally and domestically
 - Dropped PPH fees
- **“Plurilateral” PPH Cooperation**



Worksharing and the PCT System

- PCT was established as a worksharing framework, but its benefits have never been fully realized
- Way forward
 - WIPO “Roadmap” (quality, timing, simplification)
 - PPH/PCT
 - Internal process improvements—USPTO Task Force



IP5 Foundation Projects



Search Strategy

Documented Search Strategy Approach
USPTO



Search & Exam Tools

Common Search & Exam Environment
USPTO



Common Documentation

Common Prior Art Data Set
EPO



Common Classification

Shared Approach to Patent Classification
EPO



Training Policy

Standardized Examiner Training
KIPO



Machine Translation

Mutual Access to Translated Information
KIPO



One Portal Dossier

One-Stop Access to Dossier Information
JPO



Common Application Format

Common Electronic Application Filing Format
JPO



Common Rules & QC

Common Rules for Exam Practice & Quality
SIPO



Common Statistics

Common Statistical Parameters
SIPO

Systems Harmonization: Applications, databases, examination tools, policies, performance measures



Systems Harmonization IP5 Foundation Projects

- Common Approach to Sharing and Documenting Search Strategies— a means to enable examiners to document the approach and strategy associated with a search of a patent application so that it can be replicated and shared between the offices
- Common Search and Examination Support Tools- a common search and examination environment so each office has the ability to produce and reproduce equivalent search results for each application that is examined
- Common Documentation – an extensive set of existing prior art sources enabling each office to search the same documentation
- Common Classification – a system that incorporates and improves upon the best features of each Office’s current system, facilitating efficient, high-quality searching of all documents issued and classified by the Offices



Systems Harmonization IP5 Foundation Projects

- Common Training Policy - standardize training policies and tools so that patent examiners at each of the Offices approach examination from a common knowledge base
- Mutual Machine Translation - overcome language barriers among the Offices and allow greater access to each office's patent information
- One Portal Dossier- a tool enabling examiners to access the dossier information of each of the IP5 Offices using a single interface
- Common Application Format – a standard application format recognized by all offices to facilitate efficient filing procedures



Systems Harmonization IP5 Foundation Projects

- Common Rules for Examination and Quality Control - enable the Offices to conduct patent examinations under common rules which will provide uniform information to applicants, streamline formality for applicants, and exercise patent examination based on a standard level of quality
- Common Statistical Parameter System for Examination- establish a system of common performance measures for examination at the Offices



Staff Exchanges

- Examiner and Staff Exchanges
 - Traditional arrangements (comparative studies of exam practices, etc.)
 - New view toward advancing worksharing programs (classification harmonization, IT requirements)
- IEIR (International Examiner in Residence Program)
- Virtual Collaboration
 - Essential to expand worksharing and other programs



And some
interesting new
ideas ...



SHARE component of three-track

- For applications filed in the PTO that are based on a prior foreign-filed application
- No action would be taken until the PTO received a copy of the first office action from foreign office as well as appropriate reply to foreign office action.
- Following submission of foreign office action and reply, applicant could request: prioritized application under Track I or ordinary processing under Track II.

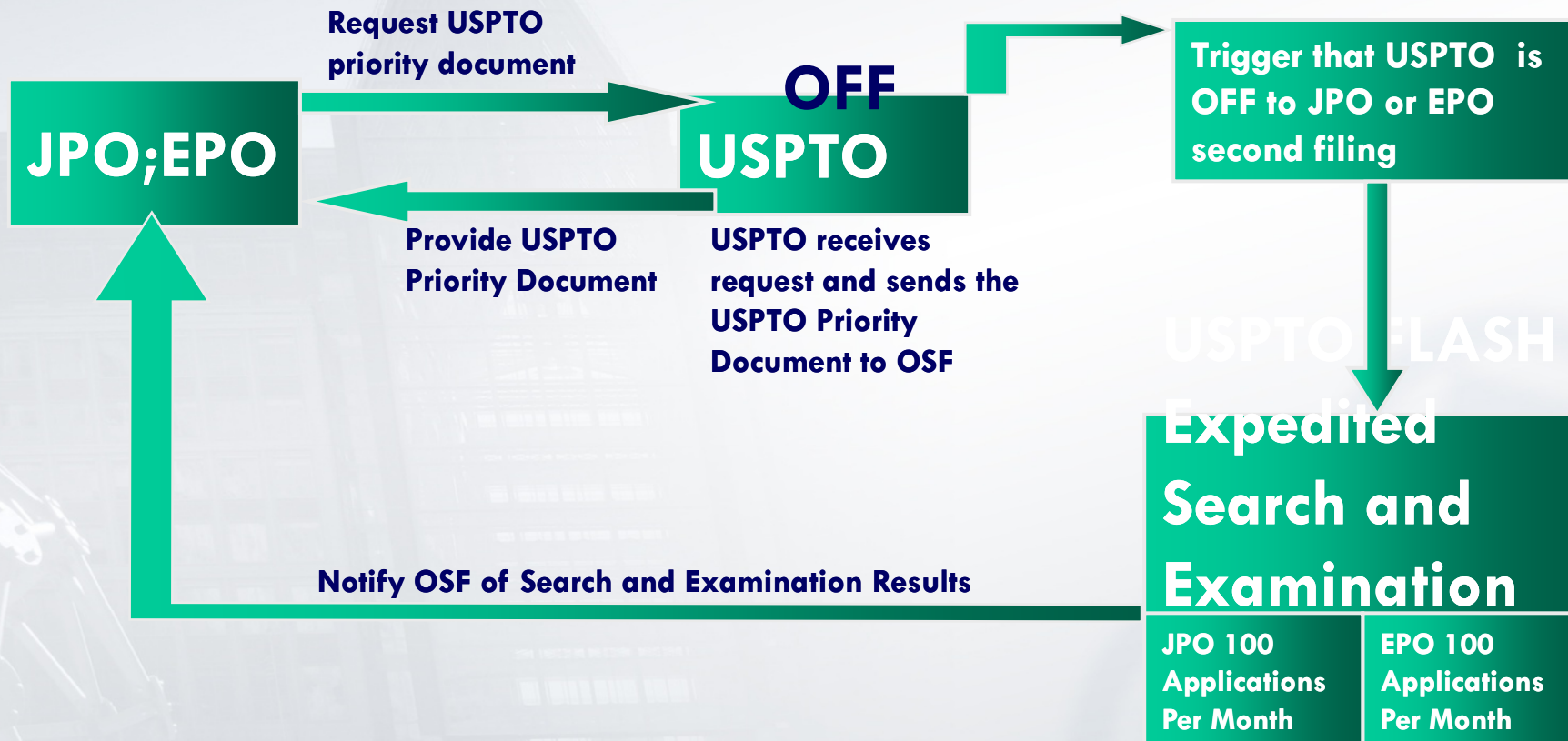


First Look Application Sharing

- Utilizes Trilateral Document Access (TDA) technology
- When request for U.S. Priority document received through the Priority Document Exchange (PDX) system, trigger that USPTO is Office of First Filing (OFF)
- Trigger to produce timely providing search and examination results for use by Office of Second Filing (OSF)



FLASH process





FLASH timeline

