



International Issues: Work-Sharing Update and Status of IP5 Foundation Projects

PPAC Meeting

April 29, 2010



Worksharing Initiatives

- Patent Prosecution Highway (PPH)
- SHARE-type initiatives:
 - USPTO-KIPO SHARE Pilot
 - USPTO & UK-IPO Action Plan for Re-use
- PCT
- IP5 Foundation Projects
- Other collaborative 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



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



Current and Planned PPH Programs

- JPO (full production 2008)
- KIPO (full production 2009)
- Australia (IPAU)
- Canada (CIPO)
- Denmark (DKPTO)
- European Patent Office (EPO)
- Finland (NBPR)
- Germany (DPMA)
- Singapore (IPOS)
- United Kingdom (UK IPO)
- Trilateral PCT-PPH (January 2010)
- Rospatent (in discussions)





PPH Stats: USPTO as 2nd Office

First Office	Start Date	Requests (as of Jan. 31, 2010)
JPO	July 2006 (Pilot) Jan. 2008 (Full)	1,920 278 (Pilot) 1,642 (Full)
UKIPO	Sept 2007	79
KIPO	Jan. 2008 (Pilot) Jan. 2009 (Full)	397 134 (Pilot) 263 (Full)
CIPO	Jan. 2008	26
IPAU	April 2008	32
EPO	Sept. 2008	30
DKPTO	Nov. 2008	15
DPMA	April 2009	15
IPOS	Feb 2009	1
NBPR	July 2009	3



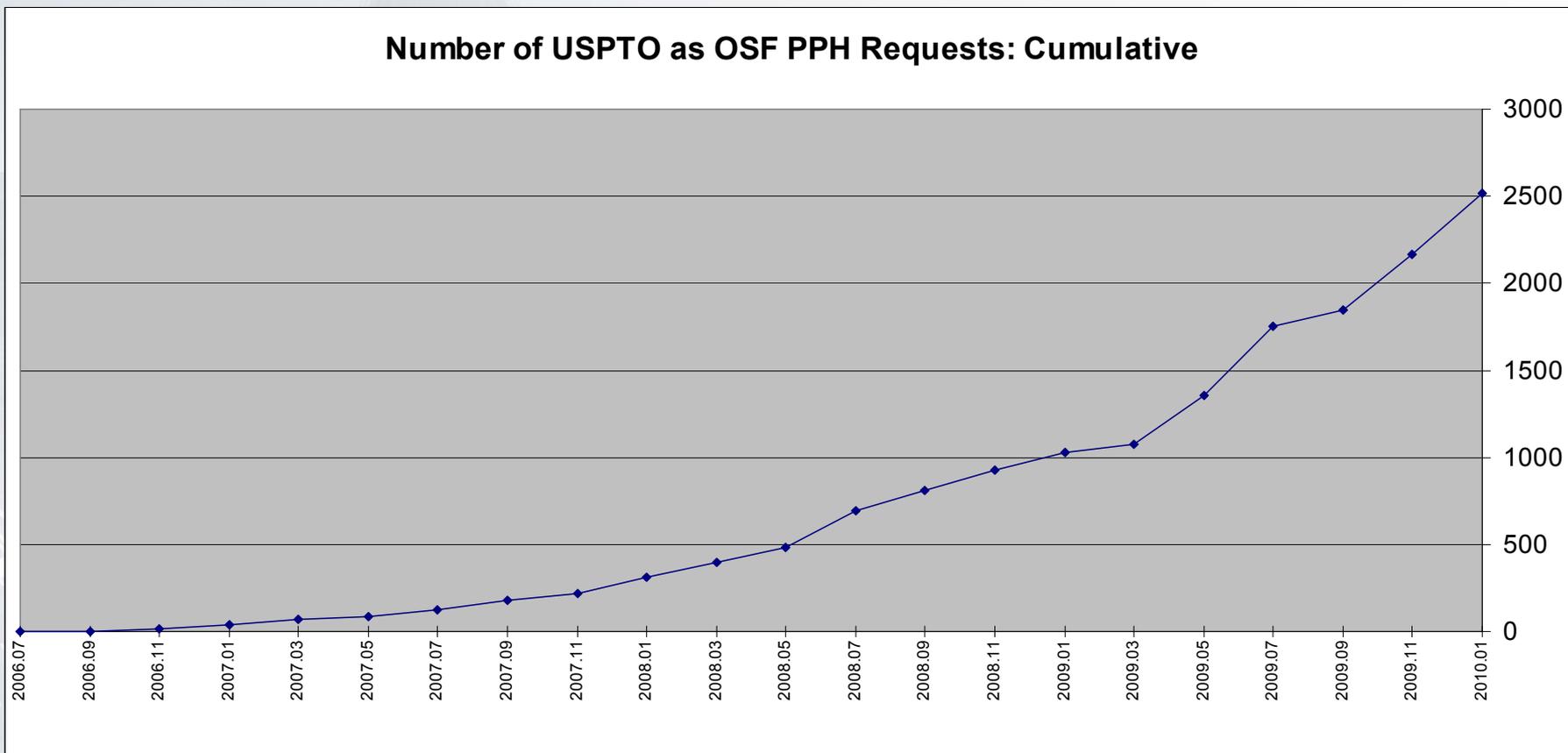
PPH Stats: International Activity

		OFFICE OF SECOND FILING - OSF														
		JPO	USPTO	KIPO	UK-IPO	DPMA	CIPO	IP-AU	DKPTO	EPO	IPOS	NBPR	ROSPATENT	APO	HPO	
		858	2518	489	32	221	837	40	1	0	1	0	0	0	0	
OFFICE OF FIRST FILING - OFF	JPO	2485		1920	328	16	220	0	—	1		0	0		0	0
	USPTO	1775	719		161	16	1	837	40	0		1	0	—	—	—
	KIPO	478	81	397		0	—	0	—	0	—	—		—	—	—
	UK-IPO	91	12	79	0		—	0	—	—	—	—	—	—	—	—
	DPMA	58	43	15	—	—		—	—	—	—	—	—	—	—	—
	CIPO	26	0	26	0	—	—		—	0	—	—	—	—	—	—
	IP-AU	32	—	32	—	—	—	—		—	—	—	—	—	—	—
	DKPTO	16	1	15	0	—	—	0	—		—	—	—	—	—	—
	EPO	30	0	30	—	—	—	—	—	—		—	—	—	—	—
	IPOS	1	0	1	—	—	—	—	—	—	—		—	—	—	—
	NBPR	5	2	3	0	—	—	—	—	—	—	—		—	—	0
	ROSPATENT	0	0	—	0	—	—	—	—	—	—	—	—		—	—
	APO	0	0	—	—	—	—	—	—	—	—	—	—	—	—	0
	HPO	0	0	—	—	—	—	—	—	—	—	—	—	—	0	



PPH Requests at the USPTO

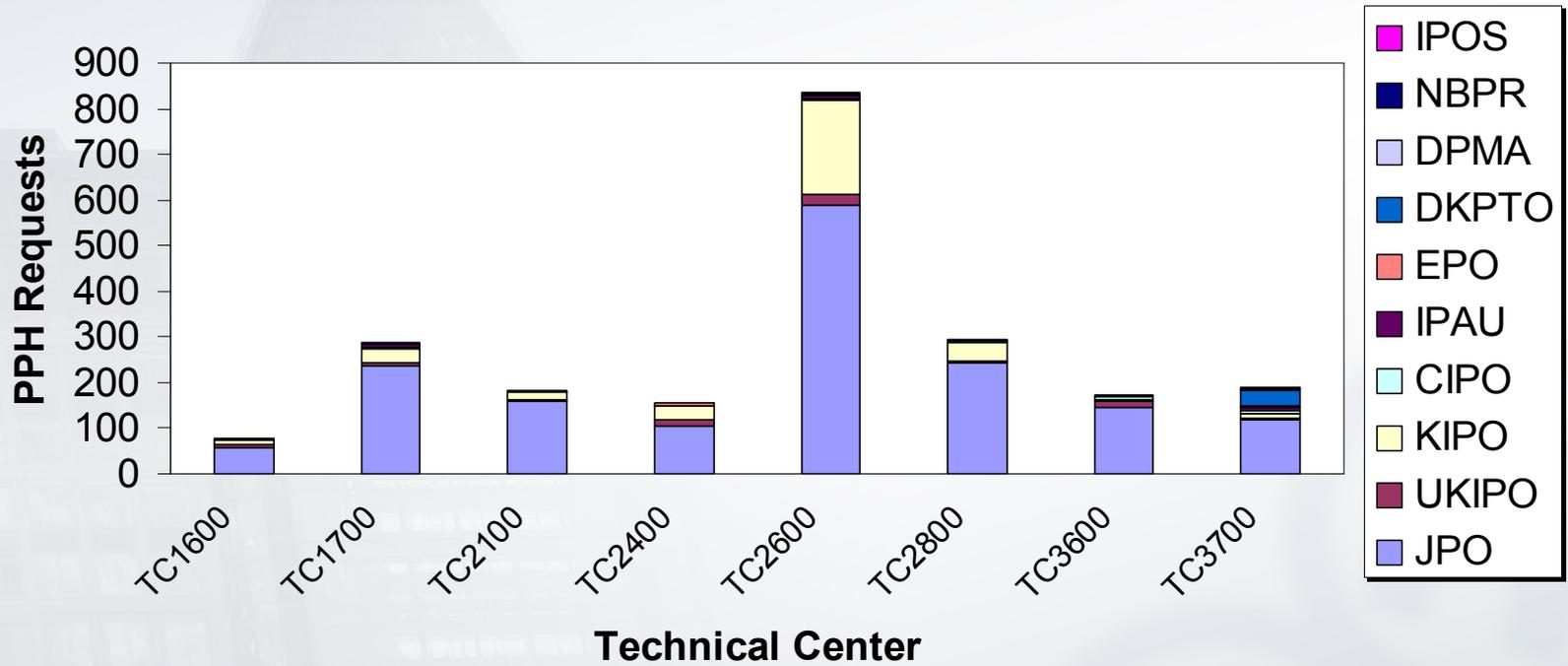
Number of USPTO as OSF PPH Requests: Cumulative





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

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:**
 - define target numerical goals and develop global strategy to reach those goals
 - Align PPH and PCT via the Trilateral pilot program
 - Conduct PPH awareness campaigns, internationally and domestically
- **“Plurilateral” PPH Cooperation**
 - Streamline procedures
 - Share best practices and statistics
 - Provide users with one stop access to information



SHARE Background

- The concept of SHARE (Strategic Handling of Applications for Rapid Examination) arose out of the discussions among the Trilateral Offices.
- According to the SHARE concept, where corresponding applications are filed in multiple offices, the USPTO, consistent with the United States' international obligations, will appropriately prioritize and balance workloads to be able to maximize the re-use of foreign search and examination results, and minimize duplication of examination work done in other IP offices.
- One important advantage of SHARE 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.



USPTO & KIPO SHARE pilot

- USPTO and Korean Intellectual Property Office (KIPO) agreed to cooperate on a one-year SHARE pilot, which began in Fall, 2009.
- 326 cross-filed applications between USPTO and KIPO were identified in two technology areas:
 - Fuel and Electrochemical Cells (TC 1700)
 - LEDs and Semiconductor Electrodes (TC 2800)
- To maximize reuse, the OSF will wait to perform their search until the OFF completes their search.
- A common search report form developed between the two offices is used to more efficiently share information and consistently evaluate results.
- Impact on stakeholders and examiners along with next steps will be determined at pilot end, which is currently ahead of schedule.



USPTO & UK-IPO Action Plan

- Heads of both IP Offices endorsed basic cooperation action plan on work-sharing (See March 10, 2010 Press Release)
- Kick-off conference held March 29, 2010
- Focusing on “Office-driven” mechanisms for reutilization of work, versus applicant-initiated
- Data collection and exchange have commenced, to be followed by near-term and long-term implementation strategies
- Goal is to maximize re-use of each others work in the shortest practical timeframe



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

- IP5 is a partnership of the 5 largest patent offices in the world: EPO, JPO, KIPO, SIPO and USPTO
- 2009 WIPO World IP Indicators reported these offices received over 76% of all patent applications filed world-wide in 2007
- Ten IP5 Foundation Projects consist of IT-supported business processes and examination practice-related initiatives to provide infrastructure for work sharing
- Significant progress has been made over the last two years, including the formation of:
 - Working Groups (WGs) to begin detailed planning and implementation of the projects
 - Program Management Group to coordinate across the IP5 offices and advise the Deputies and Heads of Office



IP5 Foundation Projects – Working Groups

WG1: Common Hybrid Classification (EPO)

WG2: IT-Supported Business Processes

- Common Documentation Database (EPO)
- Common Application Format (JPO)
- One Portal Dossier (JPO)
- Machine Translation (KIPO)
- Common Search Tools (USPTO)
- Common Approach to Sharing Search Strategy (USPTO)

WG3: Examination Practice-Related Projects

- Common Training Policy (KIPO)
- Common Statistical Parameters (SIPO)
- Common Rules for Quality Management (SIPO)



IP5 Foundation Projects-Status

- WGs began working-level meetings in 2009, with several planned for 2010
- Deputies and Heads of Offices met to commit to the plans and timelines developed in the WGs
- Phased implementation plans developed with benefits to be delivered defined for each phase
- Sample of key activities in 2010:
 - Conduct demonstration pilots for Common Hybrid Classification
 - Develop IP5 business requirements and initial pilots for Search Tools and Sharing Search Strategy
 - Develop IP5 specifications for One Portal Dossier and design Phase 1 version for testing in 2011
 - Conduct second IP5 Examiner Workshop



IP5 Foundation Projects- Acceleration Plan Proposal

- USPTO Proposed an Acceleration Plan for five of the ten Foundation Projects:
 - Common Hybrid Classification,
 - Common Application Format,
 - Machine Translation,
 - Common Rules for Quality, and
 - Common Approach to Sharing Search Strategy
- Goal was to identify components of the projects that could deliver tangible benefits to the Offices within a 2-year timeframe
- Under Secretary Kappos presented the plan to the Offices at the April 15th Heads of Office Meeting



IP5 Foundation Projects-Next Steps

- Implementation plans have been developed for all ten projects defining specific tasks and resource requirements for the next 2 years
- WGs continue to meet in-person and through other means to advance the work of the projects



Staff Exchanges

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



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