

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2017-0036]

Expanded Collaborative Search Pilot Program

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) conducted two separate Collaborative Search Pilot Programs (CSPs) during the period of 2015 through 2017. One of these programs was conducted with the Japan Patent Office (JPO) and the other with the Korean Intellectual Patent Office (KIPO). Improvements in patent quality and examination pendency were identified as positive outcomes from these two original CSPs. Building on the success of these two programs, the USPTO is participating in a new, expanded CSP (Expanded CSP) in which applicants may request that multiple partnering Intellectual Property (IP) offices exchange search results for their counterpart applications prior to formulating and issuing their office actions. In Expanded CSP, each

designated partner IP office will independently conduct a prior art search for its corresponding counterpart application. The search results will then be exchanged between the designated partner IP office(s) and the USPTO before any IP office issues an office action. By this exchange of search results, the examiners in all designated partner IP offices will have a more comprehensive set of prior art references to consider when making initial patentability determinations. In addition to changing the number of IP offices that may be providing search results to the USPTO, Expanded CSP provides applicants with more flexibility by not requiring that applicants follow the procedures of the First Action Interview Pilot Program (FAI). Expanded CSP will allow the USPTO to study the impact on examination processes resulting from exchanges of search results between the USPTO and multiple partner IP offices prior to formulating and issuing office actions.

DATE: Under Expanded CSP, the USPTO and partner IP offices will each accept requests to participate from November 1, 2017, through November 1, 2020, and each IP office will not grant more than 400 requests per year per partner office. The offices may extend the pilot program (with or without modification), if necessary. Each office reserves the right to withdraw from the program at any time.

FOR FURTHER INFORMATION CONTACT: Inquiries regarding the handling of any specific application participating in the pilot may be directed to Daniel Hunter, Director of International Work Sharing, Planning, and Implementation, Office of International Patent Cooperation, by telephone at (571) 272-8050. Any inquiries

regarding this pilot program can be e-mailed to esp@uspto.gov. Inquiries concerning this notice may be directed to Joseph F. Weiss, Jr., Senior Legal Advisor, Office of Patent Legal Administration, by phone (571) 272-7759.

SUPPLEMENTARY INFORMATION:

I. Background: The USPTO is continually looking for ways to improve the quality of issued patents and to promote work sharing with other IP offices throughout the world. Work sharing benefits applicants by promoting compact prosecution, reducing pendency, and supporting patent quality by reducing the likelihood of inconsistencies in patentability determinations (not predicated upon differences in national patent laws) between IP offices. The USPTO has launched numerous work sharing pilot programs, including the recently completed CSPs with JPO and KIPO. In these completed CSPs, the participating offices implemented administrative procedures to facilitate work sharing between the USPTO and a single designated partner IP office in the form of sharing search results of related counterpart applications. Feedback from the completed CSPs showed sufficiently positive benefits to justify expanding CSP to permit work sharing between the USPTO and more than one designated partner IP office for the same U.S. application.

The USPTO will cooperate in an Expanded CSP to determine whether exchanging the results from searches independently performed by multiple IP offices, which occur substantially simultaneously, also increases the efficiency and quality of patent examination. This Expanded CSP is designed so that this exchange of search results

would occur prior to the IP offices making initial patentability determinations. The current partner IP offices for the Expanded CSP are JPO and KIPO. The USPTO will announce future partner IP offices when they are designated.

Currently, applicants in the USPTO having U.S. applications with claims of foreign priority may have search results and prior art cited to them by the foreign IP office during pendency of their U.S. applications. Often, applicants submit the prior art after examination on the merits is already underway in their U.S. application. Upon evaluation of the search results and cited prior art, the U.S. examiner may determine that the prior art cited by the foreign office is relevant to patentability and merits being used in further examination before making a final determination on patentability of the pending claims. This delay caused by further examination results in additional cost to applicants and the USPTO that could have been avoided if the U.S. examiner was in possession of the foreign office's search results before commencing examination of the U.S. application. Furthermore, in light of the USPTO's various expedited examination programs, the possibility exists that a U.S. application may reach final disposition before the applicant is in receipt of a foreign office's search results. The exchange of search results between IP offices before an initial determination on patentability should increase efficiency and promote patent examination quality.

In order to study the benefits of the exchange of search results between multiple IP offices, current USPTO examination practice will be modified for applications in Expanded CSP so that a search will be conducted and search results generated, without

issuance of an Office action. The U.S. applications in Expanded CSP will also be “made special” pursuant to USPTO procedures to ensure that they are contemporaneously searched with their corresponding counterpart applications.

In the original version of the CSP, the USPTO required the use of the First Action Interview Pilot Program (FAI), which bifurcated the prior art search from issuance of an Office action. The USPTO has determined that it is unnecessary to require applicants participating in Expanded CSP to use FAI procedures. Instead, applications in Expanded CSP will be accorded special status prior to first action on the merits (FAOM) and prior art references provided through the exchange of search results will be included in the FAOM.

Expanded CSP in the U.S. requires a petition to make special for the participating application and authorization to exchange information with the designated partner IP office(s) prior to an initial determination of patentability. As this work sharing program is operating under a common framework across all agreements between the USPTO and all partner offices, it is permissible to participate in Expanded CSP with multiple partner offices simultaneously, and the program is open to adding additional partner IP offices once appropriate agreements are in place.

II. Overview of Expanded CSP: An application must meet all the requirements set forth in section III of this notice to be accepted into Expanded CSP. Applicants must file a Petition to Make Special Under the Expanded Collaborative Search Pilot Program using

form PTO/SB/437 via EFS-web in a U.S. application. Use of the form is mandatory and will assist applicants in complying with the pilot program's requirements, as well as assist the USPTO in quickly identifying participating applications. Form PTO/SB/437 is available at: <http://www.uspto.gov/patents-getting-started/international-protection/collaborative-search-pilot-program-csp>. The collection of information involved in this pilot program has been submitted to OMB. This collection will be available at OMB's Information Collection Review Web site, www.reginfo.gov/public/do/PRAMain.

In addition to a petition being filed with the USPTO, a request must also be filed in the corresponding counterpart applications in each applicant-designated partner IP office, in accordance with the requirements of that office. (Partner IP offices may require a petition or a request; therefore, for purposes of this notice, usage of the term 'request' refers to the initial submission that a partner IP office requires to initiate participation in Expanded CSP.) As each partner IP office's conditions for entry may differ, applicants should review the requirements of the relevant partner IP offices to ensure compliance.

No fee for a petition to make special under 37 CFR 1.102 is required for participation in Expanded CSP.

New patent applications are normally taken up for examination in the order of their U.S. filing date. Applications accepted into Expanded CSP will receive expedited processing by being granted special status and taken out of turn until issuance of an FAOM, but will

not maintain special status thereafter. Designated partner IP offices and the USPTO will be sharing search results before issuance of an initial determination on patentability. Participants in Expanded CSP should review the references cited in each respective office's initial determination on patentability. If the references cited by any partner IP office are not already of record in the USPTO application and the applicant wants to ensure that the examiner considers the references, then the applicant should file an Information Disclosure Statement (IDS) that includes a copy of the communication along with copies of any missing or newly cited references in accordance with 37 CFR 1.97, 37 CFR 1.98, and MPEP §§ 609.04(a)-(b). *See also* MPEP §§ 609 and 2001.06(a).

Each office may reevaluate the workload and resources needed to administer Expanded CSP at any time. The USPTO will provide notice of any substantive changes to the program (including early termination of the program) at least 30 days prior to implementation of any changes.

III. Requirements for Participation in Expanded CSP: The following requirements must be satisfied for a petition under Expanded CSP to be granted:

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a); or an international application that has entered the national stage in compliance with 35 U.S.C. 371, with an effective filing date of no earlier than March 16, 2013. For corresponding counterpart applications filed in accordance with the agreement between the USPTO and KIPO only, plant applications filed under 35

U.S.C. 161 are also eligible. The U.S. application and all corresponding counterpart applications must have a common earliest priority date that is no earlier than March 16, 2013. The disclosures of the U.S. application and all counterpart applications must support the claimed subject matter as of a common date. The U.S. application must be complete and eligible to receive a filing receipt at the time the petition is filed.

(2) A completed petition form PTO/SB/437 must be filed in the application via EFS-Web. Form PTO/SB/437 is available at: <http://www.uspto.gov/patents-getting-started/international-protection/collaborative-search-pilot-program-csp>. Based upon the agreements reached between the USPTO and the partner IP offices, a separate petition to make special must be filed in the U.S. application for each partner IP office that the applicant designates.

The petition (Form PTO/SB/437) includes:

(A) An express written consent under 35 U.S.C. 122(c) for the USPTO to accept and consider prior art references and comments from each designated partner IP office during the examination of the U.S. application;

(B) Written authorization for the USPTO to provide to the designated partner IP office access to the participating U.S. application's bibliographic data and search results in accordance with 35 U.S.C. 122(a) and 37 CFR 1.14(c); and

(C) A statement that the applicant agrees not to file a request for a refund of the search fee and any excess claim fees paid in the application after the mailing of the decision on the petition to join Expanded CSP. Note: Any petition for express

abandonment under 37 CFR 1.138(d) to obtain a refund of the search fee and excess claim fee filed after the mailing of a decision on the petition will be granted, but the fees will not be refunded.

(3) Petitions must be filed before examination has commenced. Examination may commence at any time after an application has been assigned to an examiner. Petitions should preferably be filed before the application has been assigned to an examiner to ensure that the USPTO does not examine the application before recognizing the petition. Therefore, applicants should check the status of the application using the Patent Application Information and Retrieval (PAIR) system to see if the application has been assigned to an examiner. If the application has been assigned to an examiner, the applicant should contact the examiner to confirm that the application has not been taken up for examination and inform the examiner that a petition to participate in Expanded CSP is being filed. Following this guidance will minimize delays caused by remedial corrective action when a petition is not recognized before examination commences. Further, examination must not have commenced in the identified corresponding counterpart application(s) before each designated partner IP office when filing petitions requesting participation in the U.S. application.

(4) The petition filed in the USPTO and any request filed in a designated partner IP office must be filed within 15 days of each other. If the petition and request(s) are not filed within 15 days of each other, the applicant runs the risk of one of the pending applications being acted upon by an examiner before entry into the pilot program, which

will result in the applications being denied entry into Expanded CSP. The request for participation filed in the corresponding counterpart application(s) for Expanded CSP must be granted by at least one of the designated partner IP offices in order to participate in Expanded CSP.

(5) The petition submission must include a claims correspondence table, which at a minimum must establish “substantial corresponding scope” between all independent claims present in the U.S. application and the corresponding counterpart application(s) filed in the designated partner IP office(s). The claims correspondence table must individually list the claims of the instant U.S. application and correlate them to the claims of the corresponding counterpart application having a substantially corresponding scope. Claims are considered to have a “substantially corresponding scope” where, after accounting for differences due to claim format requirements, the scope of the corresponding claims in the corresponding counterpart application(s) would either anticipate or render obvious the subject matter recited under U.S. law. Additionally, claims in the U.S. application that introduce a new/different category of claims than those presented in the corresponding counterpart application(s) are not considered to substantially correspond. For example, where the corresponding counterpart application(s) contain only claims relating to a process of manufacturing a product, any product claims in the U.S. application are not considered to substantially correspond, even if the product claims are dependent on process claims that do substantially correspond to claims in the corresponding counterpart application(s). Applicants may file a preliminary amendment in compliance with 37 CFR 1.121 to amend the claims of the

U.S. application to satisfy this requirement when attempting to make the U.S. application eligible for the program. A translated copy of the claims in English for each counterpart application is required if the application in the designated partner IP office(s) is not publicly available in English. A machine translation is sufficient. Non-corresponding claims need not be listed.

(6) The U.S. application must contain 3 or fewer independent claims and 20 or fewer total claims. The U.S. application must not contain any multiple dependent claims; the corresponding counterpart application may contain multiple dependent claims in accordance with national practice of the partner IP office where it is filed. For a U.S. application that contains more than 3 independent claims or 20 total claims, or any multiple dependent claims, applicants may file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims to make the application eligible for the program.

IV. Treatment of Petition: As discussed in section III, the number of petitions to make special filed in the U.S. application must equal the number of designated partner IP offices where a corresponding counterpart application has been filed. At least one designated partner office must grant the request in order for that application and the counterpart U.S. application to participate in Expanded CSP.

If examination commences in either the U.S. or a given designated corresponding counterpart application before either the petition or request is filed, then that combination

of U.S. application and designated corresponding counterpart application cannot participate in Expanded CSP. Applicants are advised that, even if they timely file a request with a designated partner office, if the USPTO is not informed by the designated partner office of the filing of the request in the corresponding counterpart application within 20 days of a petition filing with the USPTO, then the USPTO may initially dismiss the petition. In such situation, the applicant may request reconsideration, as discussed in Item B, below.

A. Petition Grant by USPTO: Once a determination is made that all the requirements of Section III of this notice are satisfied, the USPTO petition will be granted and the application will be placed on the examiner's special docket until an FAOM is issued. The USPTO and the designated partner IP office(s) will then have four months to provide search results. As a result, once the USPTO grants the petition, the applicant will no longer have a right to file a preliminary amendment that amends the claims. Any preliminary amendment filed after the petition is granted and before issuance of an FAOM amending the claims will not be entered unless approved by the examiner. After the petition is granted and before issuance of the FAOM, the applicant may still submit preliminary amendments to the specification that do not affect the claims. All such submissions for the participating U.S. application must be filed via EFS-Web.

B. Petition Dismissal by USPTO: If the applicant files an incomplete Form PTO/SB/437, or if an application accompanied by Form PTO/SB/437 does not comply with the requirements set forth in this Notice, the USPTO will notify the applicant of the

deficiencies by dismissing the petition and the applicant will be given a single opportunity to correct the deficiencies. If the applicant still wishes to participate in the pilot program, the applicant must make appropriate corrections within 1 month or 30 days of the mailing date of the dismissal decision, whichever is longer. The time period for reply is *not* extendable under 37 CFR 1.136(a). If the applicant timely files a response to the dismissal decision correcting all the noted deficiencies without introducing any new deficiencies, the USPTO will grant the petition if a grantable request has been filed in a corresponding counterpart application.

If the applicant fails to correct the noted deficiencies within the time period set forth, the USPTO may dismiss the petition and notify the designated partner IP office(s). The U.S. application will then be taken up for examination in accordance with standard examination procedures, unless designated special in accordance with another established procedure (*e.g.*, Request for Prioritized Examination, Petition to Make Special Based on Applicant's Age).

C. Withdrawal of Petition: An application can be withdrawn from the pilot program only by filing a request to withdraw the petition to participate in the pilot program prior to issuance of a decision granting the petition. Once the petition for participation in the pilot program has been granted, withdrawal from the pilot program is not permitted.

V. Requirement for Restriction: The claims must be directed to a single invention. If the examiner determines that not all the claims presented are directed to a single

invention, the telephone restriction practice set forth in MPEP § 812.01 will be followed. The applicant must make an election without traverse during the telephonic interview. If the applicant refuses to make an election without traverse, or if the examiner cannot reach the applicant after a reasonable effort (*i.e.*, three business days), the examiner will treat the first claimed invention (the group of claim 1) as constructively elected without traverse for examination and include a basis for the restriction or lack of unity requirement in the FAOM. When a telephonic election is made, the examiner will provide a complete record of the telephonic interview, including the restriction or lack of unity requirement and the applicant's election, in the FAOM. Applicants are strongly encouraged to ensure that applications submitted for Expanded CSP are written such that they claim a single, independent, and distinct invention. The applicant is responsible to ensure the same invention is elected in both the U.S. and all corresponding counterpart applications for concurrent treatment in Expanded CSP.

VI. First Action on the Merits (FAOM): During examination, the USPTO examiner will consider all exchanged search results and all references submitted by the applicant in accordance with 37 CFR 1.97 and 37 CFR 1.98. Search results that are not received by the USPTO within four months may not be included in the FAOM. The examiner will prepare and issue an Office action and notify the applicant if any designated partner IP

office did not provide search results prior to the issuance of the Office action. Once an FAOM issues, the application will no longer be treated as special under Expanded CSP.

OCT 25 2017
Date: _____

Joseph Matal

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Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office