

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2016-0013]

**Elimination of Publication Requirement in the Collaborative Search Pilot Program
between the Japan Patent Office and the United States Patent and Trademark
Office**

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) implemented a Collaborative Search Pilot Program with the Japan Patent Office (JPO) on August 1, 2015, to study whether the exchange of search results between offices for corresponding counterpart applications improves patent quality and facilitates the examination of patent applications in both offices. Based upon feedback from the public, the USPTO is modifying the Collaborative Search Pilot Program between JPO and USPTO (JPO-CSP) by removing the requirement that the applications must be published in order to participate in the pilot program. The JPO and USPTO have determined that publication

of the applications is unnecessary for participation in the pilot program and that unpublished applications can participate in the pilot program as long as applicants grant access to the unpublished application and provide a translated copy of the currently pending claims from the corresponding counterpart application(s). Accordingly, publication of an application will no longer be a prerequisite for participation in the JPO-CSP as of the effective date of this notice. Instead, if unpublished, applicant must provide an authorization of access to the unpublished application and submit a translation of the currently pending claims from the corresponding counterpart application(s). These modifications should permit more applications to qualify for the program, supporting the program's study of the efficacy of exchanging search results between corresponding counterpart applications to improve patent quality and facilitate examination.

EFFECTIVE DATE: August 1, 2016.

DURATION: Under this pilot program, the USPTO and JPO will continue to accept petitions to participate until August 1, 2017, two years from the original effective date of the program (August 1, 2015). During each year, the pilot program will be limited to 400 granted petitions, 200 granted petitions where USPTO performs the first search and JPO performs the second search, and 200 granted petitions where JPO performs the first search and USPTO performs the second search. The offices may extend the pilot program (with or without modification) for an additional amount of time, if necessary. The offices reserve the right to terminate the pilot program at any time.

FOR FURTHER INFORMATION CONTACT: Daniel Hunter, Director of International Work Sharing, Planning and Implementation, Office of International Patent Cooperation by telephone at (571) 272-8050 regarding the handling of any specific application participating in the pilot. Any questions concerning this notice may be directed to Joseph Weiss, Senior Legal Advisor, Office of Patent Legal Administration by telephone at (571) 272-7759. Any inquiries regarding this pilot program can be e-mailed to wspilots@uspto.gov.

SUPPLEMENTARY INFORMATION: The USPTO published a notice to implement a joint work sharing initiative, a Collaborative Search Pilot Program, between JPO and USPTO on July 10, 2015. See United States Patent and Trademark Office and Japan Patent Office Collaborative Search Pilot Program, 80 FR 39752 (July 10, 2015), 1417 Off. Gaz. Pat. Office 68 (August 4, 2015) (JPO-CSP Notice). The JPO-CSP Notice indicated that an applicant can request, via petition to make special, to have an application advanced out of turn (accorded special status) for examination, if the application was published and satisfied other requirements specified in the JPO-CSP Notice. The pilot program is designed to ensure the applications are contemporaneously examined so that examiners from both offices have a more comprehensive set of references along with corresponding claim sets before them when making initial patentability determinations. The USPTO has received feedback and suggestions from stakeholders regarding the pilot program's design.

Under the JPO-CSP as originally implemented, each office conducted a prior art search for its corresponding counterpart application and then exchanged the search results with the other office before either office issued a communication to the applicant regarding patentability. As a result of this exchange of search results, the examiners in both offices had a more comprehensive set of references before them when making their initial patentability determinations. As only published applications were permitted, examiners also had access to the currently pending claims of both applications.

The USPTO and JPO have determined that the publication requirement in the JPO-CSP Notice is unnecessary as long as the petition authorizes access to the unpublished application and includes a translation of the currently pending claims from the corresponding counterpart application(s). Accordingly, the USPTO is modifying the JPO-CSP to remove the publication requirement and instead require the applicant to authorize access to the application and at least a machine translation of the currently pending claims from the corresponding counterpart application(s).

To participate in the pilot program, applicants should now use Form PTO/SB/437JP-U, which is available at <http://www.uspto.gov/patent/patents-forms>, when filing a petition to make special under this pilot program satisfying all other requirements set forth in the JPO-CSP Notice. Requirements (1) - (3) set forth in Part III of the original JPO-CSP

Notice of August 1, 2015, are modified by this notice to reflect the modifications discussed above. They are now as follows:

(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(c) with an effective filing date no earlier than March 16, 2013. The U.S. application and the corresponding JPO counterpart application must have a common earliest priority date that is no earlier than March 16, 2013.

(2) A completed petition form PTO/SB/437JP-U must be filed in the application via EFS-web. Form PTO/SB/437JP-U is available at <http://www.uspto.gov/patent/patents-forms>. If the application is unpublished the petition must include a translated copy of the currently pending claims from the corresponding counterpart application(s). A machine translation is acceptable.

(3) The petition submission must include an express written consent under 35 U.S.C. 122(c) for the USPTO to receive prior art references and comments from the JPO that will be considered during the examination of the U.S. application participating in this JPO Work Sharing Pilot Program. The petition also must provide written authorization for the USPTO to provide JPO access to the participating U.S. application's bibliographic data and search reports in accordance with 35 U.S.C. 122(a) and 37 CFR 1.14(c). Form

PTO/SB/437JP-U includes language compliant with the consent requirement(s) for this pilot program.

All other requirements and provisions set forth in the JPO-CSP Notice remain unchanged.

Please see the JPO-CSP Notice for more information on the program.

Date: 6/28/16 Michelle K. Lee
Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office