

USPTO PCT Roundtable

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PCTs

- Need timely processing of national stage applications
- Need timely ISR/WO and Search Report (SR)
- Need high quality search and written opinion
- Need an efficient system- reduce duplication of efforts
- Need a cost effective system

Use of PCT

- PCT typically utilized to buy time for making decisions on filing
 - Additionally in some instances, get two searches
 - Funding stream issues usually lead to use of PCT to delay costs
- In some instances recommend against due to cost
- Addition of PCT to PPH good modification
 - Realistically few PCTs get “clean” report – comes through back and forth of prosecution
 - May prompt some increase in Chapter II but not significant

PCT Timely Processing

- National stage applications (371s) should be processed as quickly as regular 111(a) applications
- USPTO should follow the rules in 37 CFR 1.492(c)(1) and place the applications on the special new docket where the US has provided a “clean” PCT report
- Historic delays and cost in SR and WO from USPTO have prompted applicants to seek other ISAs
 - KIPO and EPO selected
 - However, quality of work is very important and EPO and USPTO still better for biotechnology

High Quality Search Report and WO

- Need ability to rely on outcome from PCT since decisions are made internationally based on the SR and WO
- References and action in US national stage application should be similar to PCT- consistency is goal
 - Different references and approach frequently occur
- Lack of unity should be applied in both PCT and 371, however, the 371 frequently receives a restriction in the guise of unity of invention
 - **Applicants do not complain for fear of retribution**

High Quality Search

- Inclusion of search logic in documents would assist quality and evaluation of work done
 - Worksharing ability is improved upon understanding of the search performed
- Identification of all issues including 112s would help applicants
- Evaluation of all sources of prior art- US and foreign patents and NPL
 - Reputation and future of worksharing depend upon quality of work and the perception of that work

USPTO Use of Contractors

- PCTs being done more timely
- Provides more resources to handle volume of applications
- Concerns about quality
 - Anecdotally, some reports have less than adequate search
- Examiners best suited to handle complex issues of scope, search and evaluation of issues

Efficient System

- Currently PCT and US national stage application done separately
 - Redundant work
 - Little to no advantage taken of work done in PCT- done by contractors or other patent offices
- Worksharing- should use work from PCT in 371 or vice versa
 - If work is published as ISA/US work, Examiners should be using it, at least as a beginning point
- Work should be done once
 - Update search and use in 371
 - Second application should receive less credit – counts or time

Cost Effective

- Applicants are paying for two searches
- Cost to outsource appears to be higher than having Examiners do the work

Issues and Challenges

- Backlogs in Office make it difficult to get all applications completed
- Labor relations issues complicate improving efficiency
 - Changes to counts require negotiation on impacts
- Improve attitude of personnel toward PCT
- Improve quality of work

Changes

- Ideally, a single examination of both applications addresses volume and credit issues
 - Combination into a single application/examination with incentive of cost reduction to applicants
 - Challenges to single output satisfying both systems
- Could PCT be used to provide delay but without incurring extra work for offices?
 - Option to forgo search and just publish?
- Option to submit prior art