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Patent Quality Chat
International Patent Cooperation Initiatives

April 21, 2020
To send in questions or comments during the webinar, please email:

PatentQuality@uspto.gov
Patent Quality

Providing high-quality, efficient examination of patent applications is paramount to our mission at USPTO. To ensure we continue to issue high-quality patents that will fuel innovation well into the future, the Office of the Deputy Commissioner for Patent Quality, along with our partners across the Patents organization, promotes and supports the continuous improvement of patent products, processes and services through collaboration with internal and external stakeholders of the intellectual property community.

Highlights

Patent Quality Chat
Join us for our upcoming chat on International Patent Cooperation Initiatives on Tuesday, April 21st at noon via webinar.

Stakeholder Training on Examination Practice and Procedure (STEPP)
Sign up for an upcoming training developed for those interested in a better understanding of the examination process at the USPTO.

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# 2020 Chat Series

<table>
<thead>
<tr>
<th>Date</th>
<th>Topic</th>
<th>Speaker</th>
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</table>
| Tuesday, April 21, 12 p.m. - 1 p.m. ET | International Patent Cooperation Initiatives  
• Presentation slides (coming soon)  
• Video (coming soon) | Nelson Yang  
Acting Director, International Worksharing Planning and Implementation (IWPI)  
Jesus Hernandez  
Patent Attorney, Office of Policy and International Affairs (OPIA)  
Amber Ostrup  
Program Manager, International Worksharing Planning and Implementation (IWPI) |
Today’s speakers

• Nelson Yang
  – Acting Director, International Worksharing Planning and Implementation (IWPI)

• Jesus Hernandez
  – Patent Attorney, Office of Policy and International Affairs (OPIA)

• Amber Ostrup
  – Program Manager, International Worksharing Planning and Implementation (IWPI)
Agenda

• Introduction

• International patent cooperation initiatives:
  – Parallel Patent Grant (PPG) program with Mexico
  – Collaborative Search Pilot Program (CSP)
  – Global Dossier
  – Other worksharing efforts (PCT CS&E and PPH)

• Discussion
Introduction

• Dedicated teams at the USPTO leading efforts to assist U.S. inventors and businesses in protecting their patent rights worldwide:
  – The Office of International Patent Cooperation (OIPC)
  – Office of Policy and International Affairs (OPIA)
# Worksharing

<table>
<thead>
<tr>
<th>Increasing certainty of IP rights</th>
<th>Multiple examiners searching similar invention</th>
<th>Greater consistency between IP Offices</th>
</tr>
</thead>
<tbody>
<tr>
<td>Reducing stakeholder costs</td>
<td>Enhance examination efficiencies</td>
<td>Further improving patent quality and timeliness</td>
</tr>
<tr>
<td>Acceleration of examination</td>
<td>Most relevant prior art in various languages</td>
<td>Engage stakeholders</td>
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International patent cooperation initiative

Parallel Patent Grant (PPG) Program
PPG: Background

• The USPTO and the Mexican Institute for Industrial Property (IMPI) signed a Memorandum of Understanding (MOU) on Technical and Strategic Collaboration

• First PPG program of the USPTO
PPG: Worksharing

• Allows a U.S. patent to serve as the basis for an expedited grant of a foreign counterpart patent by a partner IP office

• Builds on existing worksharing models by facilitating enhanced reliance on USPTO work product

• Avoids unnecessary duplication of work
PPG: Key elements

- The PPG only permits one-way reliance
- A PPG request must be submitted at the participating IP office (e.g., IMPI)
USPTO-IMPI PPG: Eligibility criteria

• The Mexican patent application shares the same earliest date with a U.S. patent granted by the USPTO

• All claims in a Mexican patent application sufficiently correspond, or be amended to correspond, to one or more claims in the U.S. patent
USPTO-IMPI PPG: Eligibility criteria

- The Mexican patent application must be published by IMPI; and the period for receiving third party observations at IMPI has elapsed.
- All Mexican patent applications, across all technologies, may benefit from PPG.
USPTO-IMPI PPG: Workflow

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PPG: Benefits

• Encourages increased cooperation between IP Offices to facilitate the sharing and use of each other’s work product
• Enhances examination efficiencies
• Improves patent quality
• Results in cost benefits for patent applicants

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PPG: Implementation

- January 28 - MOU signed by USPTO and IMPI
- February to April - Finalize terms of implementation
- Expected launch of program
International patent cooperation initiative

Expanded Collaborative Search Pilot (CSP) Program
CSP: Background

• CSP provides those cross-filing their patent applications internationally with search results from multiple offices early in the examination process so the applicant can determine their next steps in patent prosecution.
  – Initial CSP: August 2015 – July 2017
  – Expanded CSP: November 1, 2017 through October 31, 2020
    • Currently in discussions on expanding pilot

• Bilateral pilots
  – USPTO – JPO
  – USPTO - KIPO

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Goals of the CSP program

- **Increase quality**
  - Multiple examiners searching an invention may increase search quality by sharing results

- **Reduce pendency**
  - Collaborating with others or providing a better starting point can reduce time devoted to examination

- **Increase consistency**
  - Examiners using same art often come to similar conclusions

- **Increase certainty**
  - Applicants can have more confidence in resulting work product

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Benefits of using the CSP program

• Greater consistency in examination across IP Offices leading to more certainty of IP rights
• Applications will be taken out of turn resulting in expedited first action on merits
• Combined search expertise provides more comprehensive prior art
• It’s free to file a CSP petition for your application
Expanded CSP process: A parallel search

Office 1 Application

Office Conducts Search and Evaluation and Generates Search Results

Offices Exchange Search Results

Office Reevaluates Search Results in View of Other Office's Search Results

Office Action Sent to Applicant

Petition Granted in Both Offices

Office 2 Application

Office Conducts Search and Evaluation and Generates Search Results

Offices Exchange Search Results

Office Reevaluates Search Results in View of Other Office's Search Results

Office Action Sent to Applicant

Target: **four** months from grant  Target: **two** months from exchange

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Example of expanded CSP timing

Anticipated timing agreed upon by partnering IP Offices

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Expanded CSP requirements

• Application eligibility
  – National utility applications that have not started examination in the IP Offices in which a request is filed are eligible for examination under the expanded CSP program
  – Applications must share a common earliest priority date and the disclosures must support the claimed subject matter as of a common date. The earliest priority date is March 16, 2013

• No-cost petition filed in USPTO; request or petition in partner IP Offices
  – Applications must have corresponding independent claims
    • Corresponding claims must be listed on petition form
    • No more than three independent and 20 total claims permitted
    • No multiple dependent claims in U.S. application
International patent cooperation initiative

Global Dossier
Global Dossier: Background

- Global Dossier is a set of business services that provides IP stakeholders with free and secure one-stop access to dossier information of all applications that comprise a family and that have been filed in participating IP offices.

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Global Dossier: Benefits

• Consolidated access to patent family data
  – View an application’s patent family and counterpart prosecution histories from multiple countries in real-time

• View the most relevant art in minutes
  – Citation list allows you to see all the art cited in the patent family, with the most frequently cited art listed first

• Office action translations
  – Only location to find real-time English machine translations of Chinese, Korean, and Japanese Office actions

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Global Dossier: Homepage

Global Dossier Initiative
The Global Dossier Initiative is a set of business services being developed by the IPS Offices (USPTO, EPO, JPO, KIPO, and SIPO) aimed at modernizing the global patent system and delivering benefits to all stakeholders through a single portal/user interface. Global Dossier will provide a single, secure point of access for patent-related capabilities and information.

Global Dossier Public Access
The first service being provided by the Global Dossier Initiative is a secure, online access to the file histories of related applications from participating IP Offices, which currently include the IPS Offices.

By using this service, users can see the patent family for a specific application, containing all relevant information.

Citation List BETA
As part of the Global Dossier Initiative, the USPTO is pleased to announce the beta release of the Citation List. The Citation List is part of the USPTO's ongoing efforts to provide a more comprehensive listing of relevant citations that are available in related applications that share a common priority claim.

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Global Dossier: Patent Family

US 13565455 9 Members in Patent Family (8 currently shown)

<table>
<thead>
<tr>
<th>Office</th>
<th>Application</th>
<th>Applicant</th>
<th>Title</th>
<th>App. Date</th>
<th>Priority #</th>
<th>Pub. #</th>
<th>Pub. Date</th>
<th>Action</th>
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<tr>
<td>CN</td>
<td>201310590403</td>
<td>Applied Materials, INC.</td>
<td>Laser material removal methods and apparatus</td>
<td>08/21/2009</td>
<td>US 12092044</td>
<td>CN 10353781 A</td>
<td>01/29/2014</td>
<td>Add to ⭐</td>
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Global Dossier: Citation list

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Other worksharing initiatives
International patent cooperation initiative

IP5 PCT Collaborative Search and Examination (CS&E) Pilot
IP5 PCT CS&E Pilot: Concept

- Enables collaboration of examiners from different international authorities in different regions and with different working languages on one international application
- International search report (ISR) and written opinion (WO) under PCT Chapter I remain the opinion of the chosen International Search Authority (ISA) but are based on contributions from all participating national IP Offices
IP5 PCT Collaborative Search and Examination (CS&E) Pilot

• Began July 1, 2018 by the IP5 Offices
• Explores a collaborative approach to international searches under the Patent Cooperation Treaty (PCT) with two goals:
  – Assess expected efficiency gains
  – Determine the users’ interest for this approach
IP5 PCT CS&E process model

Collaborative Search & Examination (CS&E)

Applicant driven

100 files per ISA over 2 years

PCT ISA checks CS&E criteria fulfilled, formalities examination, confirms acceptance

ISA Examiner (Step 1) Carries out search, prepares provisional opinion and provisional search report

"Peer" examiners 4 other IP5 Offices Contribution based on ISA provisional opinion and search report

Evaluation CS&E metrics will be monitored over the lifetime of the 500 applications

Product CS&E International Search and Written Opinion

Expected Benefits

Earlier information from all IP5 offices

All offices contribute to product quality

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IP5 PCT CS&E pilot limits and statistics

- Fifty applications per main International Searching Authority (ISA) per year
  - Two-year operational period
    - July 1, 2018 – June 30, 2019
    - July 1, 2019 – June 30, 2020

- Ten applications per main ISA per applicant

- Some ISAs (non-ISA/US) set limits based on technology

- 423 total applications accepted by IP5 ISAs (as of March 25, 2020)
  - EP – 95
  - JP – 60
  - CN – 68
  - KR – 100
  - USPTO – 100
  - KR and USPTO reached ceiling and are no longer accepting applications
  - U.S. applicants wishing to still participate can do so by selecting JPO as ISA

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Patent Prosecution Highway (PPH)
PPH: Background

• PPH is an initiative that allows applicants who received a determination of allowable claims in an application from one IP Office (national, regional, or PCT) to obtain fast track processing of corresponding claims in an application pending in other IP Offices.
PPH benefits

• Special status
  – PPH applications are advanced out of turn for examination, reducing the amount of
time to receive office actions and patents.

• Improved search and examination quality
  – Search results are shared among IP Offices. For example, a JPO examiner is normally
more adept than a U.S. examiner at searching Japanese art. The JPO search results
are used by the U.S. examiner to produce a more thorough examination.

• Reduced overall pendency
  – The efficiencies gained by worksharing help IP Offices reduce the overall application
backlog, which affects all applications.
Allowance rate comparison between PPH and non-PPH prosecution at the USPTO

Data is from October 1, 2019 through February 29, 2020.

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<tr>
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<th>Overall allowance rate</th>
<th>First action allowance rate</th>
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<tbody>
<tr>
<td>PPH</td>
<td>85.3%</td>
<td>28.1%</td>
</tr>
<tr>
<td>Non-PPH</td>
<td>77.3%</td>
<td>14%</td>
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Additional information on USPTO worksharing programs

- Website: www.uspto.gov/patents-getting-started/international-patent-cooperation
- Email: oipc@uspto.gov
- Phone: 571-272-2IPC or 571-272-2472
Let’s chat with our speakers

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Thank you!

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Webinar Series 2020

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