

COORDINATION OF NATIONAL and INTERNATIONAL PHASE OF PCT APPLICATIONS

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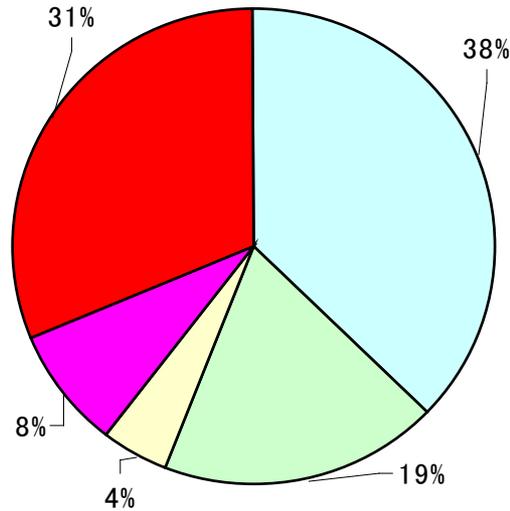
USPTO
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RESULTS FROM “SURVEY ON ISR PREPARED BY THE JPO AND THE USPTO”

- Published by JPO, 12/3/09
 - Used PCT cases searched in 2004
 - Used cases where ISR only found “A” references
 - Nevertheless, useful results

ISA=US FA CONDUCTED BY DO

US



 **First Action Allowance**

 **Notification of Reasons for Refusal (without Cited Documents)**

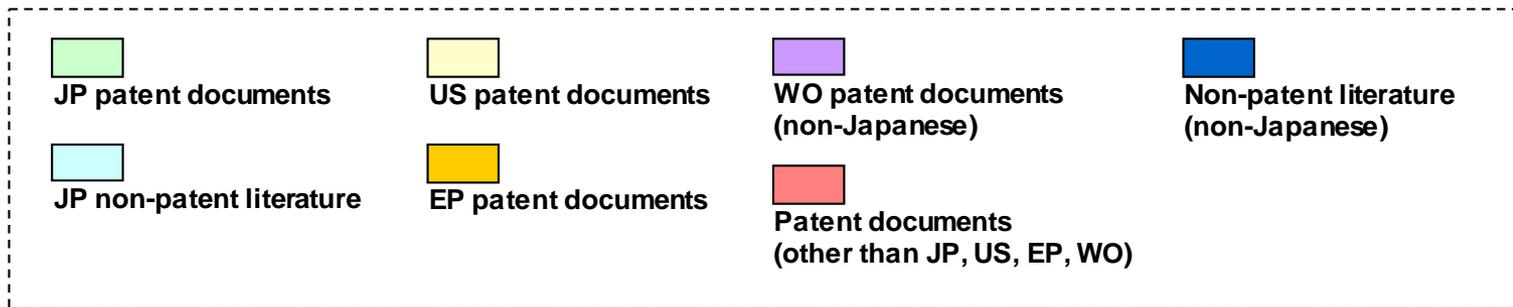
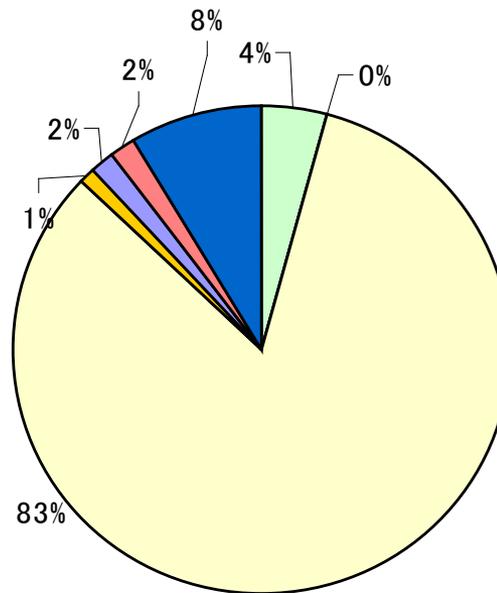
 **Notification of Reasons for Refusal (with Cited Documents; category A documents only)**

 **Notification of Reasons for Refusal (with Cited Documents; category A documents and new documents)**

 **Notification of Reasons for Refusal (with Cited Documents; new documents only)**

ISA=US DOCUMENTS CITED BY DO

US



CURRENT STATUS

- PCT searches are outsourced
- US National Phase of PCT, where ISA/US, is searched again
- No certainty of search results where ISA/US, not even for US National Phase
- US applicants pay for 2 searches where ISA/US
 - If PCT first: PCT search 2080;
US search 100
 - If non-provisional first: US search 540;
PCT search 2080

- No benefit from using ISA/US
- More US Applicants are using ISA/KR
- Result: Costly, Duplications, No Certainty, Raises issues on Efficacy of entire PCT System, Raises questions on Quality

CHOICE OF ISA FOR INTERNATIONAL APPLICATIONS FILED IN RO/US

	ISA/US	ISA/EP	ISA/KR	ISA/AU*
FY2007	55%	40%	5%	N/A
FY2008	43%	41%	17%	N/A
FY2009 (mid year)	35%	39%	26%	0%

*ISA/AU available as of 01 Nov 2008. Very few applicants have selected ISA/AU.

KEY ELEMENT IN PCT ROADMAP

— Milestone: Subject to any exceptions in the relevant declarations by the International Authorities in the PCT Assembly, Offices acting as International Authorities agree that international searches carried out by them from January 1, 2010 will not be repeated by them as designated Office if the international application enters the national phase. For this purpose, it is not considered to be repeating a search:

(i) to conduct a top-up search to find matter published or introduced into databases too late to have been considered in the international search;

(ii) to require additional searches covering claims or aspects of the invention which were not the subject of the international search;

(iii) to cite additional relevant documents which are known to the examiner, or which are otherwise brought to his attention, for example as a result of searches conducted in other Offices or of third party observations; or

(iv) to conduct a complete new search where *in exceptional cases* it is apparent that the international search was significantly deficient.

- HOWEVER, to avoid duplications, not only should ISR/US be used in National Phase DO/US
also
- USPTO search should be used in later PCT case in ISR/US,
and also
- ISR/US search should be used in separately filed Non-Provisional
namely
- ONE SEARCH PER INVENTION

EPO APPROACH **(from Mark Weaver, EPO)**

- If EPO/ISA, NO additional search is carried out in EPO Regional Phase
- However, Top-Up search for “secret” prior art done in EPO Regional Phase, e.g. before substantive examination, or during any supplemental search
- (EPO would support a top-up search in Chapter II)
- Examiner “points” are the same for both PCT and EP searches
- Same Examiner assigned to Regional Phase as was assigned to International Phase

- If claims amended upon entry into EP Regional Phase, Art. 137(4) EPC requires that any amendments must be unitary with the searched claims, thus amended claims will already have been encompassed by the original PCT search. Thus, no additional time is provided, even for amended claims
- If EP priority case was searched in EPO, the PCT application would be assigned to the same Examiner and a simple “cut & past” of the previous search would be used for the PCT
- Chap. II now being used to expedite prosecution during the International Phase, before entry into the EPO Regional Phase

JPO APPROACH

(from Koichi Minami – JPO)

- If JP/ISA, JPO Examination Guideline, Part IX, Sect. 2, Parg. 2.2(2), Examiner not required to conduct a new search where he considers it possible to use previous search results. When he does a new search, the scope of the previous search shall be excluded, unless it is considered highly probable to find more significant prior art.
- Top-up search is done in National Phase
- (JPO has been promoting that International Search be done after 18 months to exclude secret prior art in a single conducted search)

- In JPO no difference in time allotted for PCT or JP searches. However, domestic JP searches are usually outsourced.
- If claims are amended, Examiner decides if new search is needed. Complete Examiner discretion.
- If JP priority case was already searched by JPO, applicant can identify such earlier case in Part VII of PCT application form PCT/RO/10. The Examiner will use the prior search to the greatest extent possible. No limit of search of search time on Examiner.

RECOMMENDATIONS FOR USPTO TO COORDINATE ISR OF ISA/US AND USPTO SEARCH

- Treat International & National Searches identically. Do not outsource PCT searches if US searches are done in house. If outsourcing is needed, do it for selected technologies, and for both PCT & Domestic applications alike. “Separate is not equal.”
- Do “top-up” search as part of first search (ISR or US) that occurs after 18 mos., and indicate that this includes the “top-up” search.
- No objection to delaying ISR to 20 months to include secret prior art in same search. But not later than 20 or 21 months, and should not extend International Phase beyond 30 months.

- Wherever possible, use same Examiner for both PCT search and US search
 - e.g. – If existing non-provisional and corresponding PCT application is being searched, pull that non-provisional and send out US FAOM
 - If existing US non-provisional was already searched, assign same Examiner to the PCT application and “cut and paste” US/OA as ISR/WO
 - If only PCT application and then National Phase US (or by-pass), assign US application to same Examiner that did the PCT ISR/WO. There should be no requirement for applicant to file US National Phase early.

- Must incentivize Examiners to do PCT searches timely:
 - e.g. – 1.25 points for ISR within 16 months
 - 1.00 points for ISR by 18 months
 - .75 points for ISR by 20 months
 - .50 points for ISR by 22 months
- Must limit Examiner time (and points) for the “duplicate search”
 - i.e. – Full credit for first time invention is searched, either PCT or US (if both involved, possibly more credit), and
 - No, or minimal time for “cut & paste” of same search

- Provide “some” time (and credit) for “top-up” search, whenever it is done (ISR or US), but only one “top-up” search
- If claims of PCT and US are different:
 - e.g. – different claims for US non-provisional & PCT application as filed;
 - claims amended in PCT under Article 19 or 34;
 - claims amended upon entry into US National Phase
- Give Examiners half to $\frac{3}{4}$ credit for new Search

- Encourage use of Chap II to begin prosecution of application early, and upon entry into national Phase (or by pass) have Examiner continue this ongoing prosecution.
- If applicants have “certainty” that PCT search will be the same for the US corresponding application, more people will be using ISA/US even if search fees remain high. However, goal should be to reduce or eliminate “duplication” of search fees, e.g. separate non-provisional search fee and separate ISR fee.
- Encourage use of Chap II to try and get “clean” claims for use in PPH system.

CONCLUSION

- If USPTO is serious on making PCT a “world class system”, they must stop treating it as a “stepchild”
- USPTO must take PCT seriously and let Examiners know the importance of PCT
- “One search for one invention”
- Must get Union cooperation
- Continue working with User Community
- Serve as “role model” for IP5

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