

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Twenty-First Session
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FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT

Document submitted by the European Patent Office

I. INTRODUCTION

1. The European Patent Office (EPO) wishes to thank the United States Patent and Trademark Office (USPTO) as well as the United Kingdom Intellectual Property Office for the joint effort and work invested in the development of the proposal for the formal integration of the Patent Prosecution Highway (PPH) into the PCT system and, in particular, the proposals to amend the PCT Regulations and Administrative Instructions to this effect.
2. The present document takes into account the deliberations on the proposal made at the last PCT Working Group meeting (document PCT/WG/6/17). Furthermore, it addresses points made in document PCT/MIA/21/9 submitted by the USPTO on January 21, 2014.
3. The Meeting is invited to consider this document as a contribution towards facilitating the integration of the PPH into the PCT in a manner that safeguards an increased degree of flexibility for interested Offices. From the EPO perspective this is tailored to allow for a wider implementation of the proposal, i.e. even by Offices that would otherwise make use of the notice of incompatibility.

II. EVALUATION

4. In a nutshell, the EPO understanding of the proposal is that a PPH request can be based on the latest PCT work product established by *any*¹ office acting as an International Searching Authority/International Preliminary Examining Authority, where this work product determines

¹ As opposed to selected Offices with which PPH working arrangement exists.

claims to be patentable/allowable. In such cases the applicant may request that the application entering the regional/national phase be processed in an expedited manner. Fees may apply at the discretion of individual offices.

5. The proposal mirrors the EPO position with regard to the advantages of a wider scale reuse of international phase work in general and the PCT-PPH in particular. In line with the ideas set forth in the PCT Roadmap it is argued that the proposal has the potential to

- facilitate a more effective use of the PCT;
- strengthen its use as a work-sharing platform;
- promote the medium-term improvement of the quality of PCT work products by reinforcing and formalizing their reuse as well as reinforce the reliability of PCT work; and
- finally, assist the development of a comprehensive PPH concept that shall focus on the PCT-PPH and facilitate the transition from a framework of bilateral PPH arrangements to an all-inclusive, uniform PPH scheme.

6. While the EPO fully supports the pursued objectives, there are at the same time issues that merit attention in detail.

7. Due to policy considerations, capacity constraints or simply due to limited experience with the scheme, a number of Offices is currently implementing the PPH concept with a limited number of PPH partners. In any case, despite the expansion of the PPH network, there is a substantially variable degree of PPH activity among individual Offices, which is also mirrored in the varying uptake of the scheme.

8. From the EPO viewpoint this advocates the introduction of a certain degree of flexibility in the proposed amendments to the PCT Regulations regarding in particular (i) their application scope and (ii) the design of the expedited processing applicable.

9. In terms of the necessary flexibilities the following issues need to be borne in mind: A potential entry into force of the amended PCT Regulations shall initially not interfere or limit the offices' freedom to engage in PPH activities with selected ISAs/IPEAs. Certain policy considerations as well as workload concerns related to the number of files that can efficiently be processed in an expedited manner should enable offices to limit the application of the proposed Rules.

10. In practical terms issues such as the definition of the Authorities the work products of which shall be eligible to trigger expedited processing shall be left within the purview of the applicable national laws.

11. Additionally, offices should also have the option of limiting the application of said Rules due to potential capacity constraints they may encounter, once the amended Rules have entered into force and become applicable.

12. It is also understood that the application of the Rules shall not affect the existing schemes for expedited processing, i.e. shall not impose any limitations upon the offices' freedom to develop, implement, operate and, if necessary, restrict schemes for expedited prosecution of applications.

13. The EPO notes that the requirements for expedited processing in the proposed draft Administrative Instructions, Sections 901 and 902 reproduce the conditions currently applicable to the PCT-PPH programs. Offices should, nonetheless, be in a position to maintain certain flexibilities in PPH implementation also against the background of their respective procedural frameworks.

14. Finally, with reference to the comment made by the USPTO in paragraph 21 of document PCT/MIA/21/9, it should be pointed out that the approach suggested by the EPO is similar to the PCT model regarding the implementation of supplementary international search, which is available to the extent and within any limitations specified by the participating International Searching Authorities.

III. CONCLUSION

15. The EPO reiterates its support in principle for the proposal contained in document PCT/MIA/21/9. It is, however, argued that the formal integration of the PPH into the PCT shall take into account the need to maintain flexibilities available in national laws. Such safeguards are regarded necessary in order to promote consensus building on the issue in the near term.

16. *The Meeting is invited to note the comments in this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS²

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 52bis

Expedited Processing and Examination Before the Designated Office

Rule 52bis.1 Request and Requirements

(a) Subject to paragraph (b), any application which contains or is amended to contain, prior to the start of processing by the designated Office, only claims which sufficiently correspond to claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4) in the Written Opinion of the International Searching Authority, at the request of the applicant, shall receive expedited processing and examination as provided in the applicable national law.

(b) No designated Office shall be obliged to receive or process requests for expedited processing and examination under paragraph (a) unless it has notified the International Bureau that it is prepared to do so in compliance with the applicable requirements set forth in the Administrative Instructions. Any such notification should indicate the date of entry into force of paragraph (a), any optional requirement set forth in the Administrative Instructions and, if applicable, whether the provisions under paragraph (a) only apply to applications which have been searched and/or examined by one or more International Authorities to be specified. The International Bureau shall publish the information so notified in the Gazette.

Rule 78bis

Expedited Processing and Examination Before the Elected Office

Rule 78bis.1 Request and Requirements

(a) Subject to paragraph (b), any application which contains or is amended to contain, prior to the start of processing by the elected Office, only claims which sufficiently correspond to claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4) in the International Preliminary Examination Report, at the request of the applicant, shall receive expedited processing and examination as provided in the applicable national law.

(b) No elected Office shall be obliged to receive or process requests for expedited processing and examination under paragraph (a) unless it has notified the International Bureau that it is prepared to do so in compliance with the applicable requirements set forth in the Administrative Instructions. Any such notification should indicate the date of entry into force of paragraph (a), any optional requirement set forth in the Administrative Instructions and, if applicable, whether the provisions under paragraph (a) only apply to applications which have been searched and/or examined by one or more International Authorities to be specified. The International Bureau shall publish the information so notified in the Gazette.

PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS

PART 9

INSTRUCTIONS RELATING TO EXPEDITED NATIONAL PHASE PROCESSING

UNDER PCT RULES 52BIS OR 78BIS

Section 901

Requirements for Expedited Processing

(a) Pursuant to Rules 52bis and 78bis, a national or regional phase application filed under Article 22 or 39 shall receive expedited processing and examination by the designated or elected Office in accordance with Section 903 paragraph (a), provided that:

(i) the most recent of the written opinion of the International Searching Authority under Rule 43bis.1, the written opinion of the International Preliminary Examining Authority under Rule 66.2, and the international preliminary examination report under Rule 70 indicates at least one claim in the international application as having novelty, inventive step and industrial applicability as set forth in PCT Article 33(2), 33(3) and 33(4), respectively;

(ii) all of the claims in the national or regional phase application must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims indicated as having novelty, inventive step and industrial applicability in the opinion or report in subparagraph (i). A claim in the national or regional phase application is considered to sufficiently correspond where such claim, accounting for differences due to translations and claim formatting requirements, has a scope equal or similar to, or narrower than that of a claim indicated as having novelty, inventive step, and industrial applicability in the opinion or report in subparagraph (i);

[Section 901, continued]

(iii) all of the claims in the opinion or report in subparagraph (i) which are relied upon for correspondence in subparagraph (ii) must be free of any observations in Box VIII of such opinion or report;

(iv) substantive examination of the national or regional phase application has not yet begun; and

(v) the applicant has submitted a formal request for expedited processing and examination under this Section.

(b) A claim that is narrower in scope under subparagraph (ii) occurs when a claim indicated as having novelty, inventive step and industrial applicability in the most recent work product of the corresponding international application is amended to be further limited by an additional feature that is supported in the written description of the national or regional phase application. The claim(s) with the narrower scope must be written in dependent form in the national or regional phase application.

Section 902

Optional Requirements for Expedited Processing

The designated or elected Office may also require any of the following:

(i) the use of a specific form to request expedited processing;

(ii) a fee;

(iii) a copy of the opinion or report in Section 901 subparagraph (i) and a translation thereof, unless such opinion or report is immediately available to the designated or elected Office in a language accepted by the designated or elected Office;

(iv) a copy of the claims from the international application which were indicated as having novelty, inventive step and industrial applicability and a translation thereof, unless such claims are immediately available to the designated or elected Office in a language accepted by the designated or elected Office;

(v) a claims correspondence table in a language accepted by the designated or elected Office, indicating how all of the claims in the national or regional phase application sufficiently correspond to the claims indicated as having novelty, inventive step and industrial applicability in the opinion or report in Section 901 subparagraph (i);

(vi) a statement certifying that all of the claims in the national or regional application sufficiently correspond to the claims indicated as having novelty, inventive step and industrial applicability in the opinion or report in Section 901 subparagraph (i);

[Section 902, continued]

(vii) a list of all documents cited in every opinion or report in Section 901 subparagraph (i) along with copies of such documents, unless such copies were previously submitted in the national or regional phase application or were published by the designated or elected Office; and

(viii) that the submission of any items under this Part is to be made by electronic means.

Section 903

Expedited Processing

(a) A national or regional phase application which satisfies the requirements set forth in Sections 901 and 902 shall be accorded special status by the designated or elected Office, such that the application is advanced out of turn for examination. Subsequent to the initial action on the merits by the designated or elected Office, the application may retain its special status throughout its prosecution at the option of the designated or elected Office.

(b) In the event that applicant's initial request under this Part is defective, the designated or elected Office shall give applicant one opportunity to perfect the request.

(c) Where the national law provides for requirements or for expedited processing which, from the viewpoint of applicants, are more favorable than the requirements or processing provided for by this Part in respect of national applications, the national Office may apply those more favorable requirements or provide such more favorable processing.

[End of Annex and of document]