

## **Patent Cooperation Treaty (PCT) Working Group**

**Fourteenth Session**  
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### **FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT**

*Document submitted by Japan, the Republic of Korea, the United Kingdom and the United States of America*

#### **SUMMARY**

1. The present document contains a proposal to amend the PCT Regulations and Administrative Instructions to provide for expedited national phase examination through formal integration of the Patent Prosecution Highway (PPH) into the PCT System.

#### **BACKGROUND**

2. As detailed in documents such as the PCT Roadmap, there has been a renewed effort to make more effective use of the PCT in order to, *inter alia*, reduce duplication of work and provide a more accurate, higher quality search and patentability opinion during the international phase. The PPH has shown that work sharing, or work leveraging, has tangible benefits for both Offices and applicants. It is therefore proposed to formally integrate the PPH system into the PCT. Specifically, it is proposed that, at the applicant's option, national and regional Offices would fast track (or make special) national phase applications which are presented with only claims which were indicated as meeting the criteria of PCT Article 33(2) to (4) by the International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA). This would encourage applicants to ensure that their applications meet the requirements of PCT Article 33(2) to (4) in the international phase, and effectively reduce the cost of pursuing patent protection through the PCT by providing the benefits seen today in PPH, e.g. reduced actions per disposal, higher allowance rate, and reduced rate of appeal. In order to further reduce duplication of effort, it is proposed that national Offices be encouraged to increase leveraging of the work done at the international phase.

3. Under the PPH program, an applicant receiving a favorable written opinion or international preliminary report on patentability (IPRP) from an International Authority would be able to request that a corresponding national phase entry receive expedited examination provided that all claims in the national phase application sufficiently correspond to the claims which received a positive indication in the written opinion or IPRP. The national Office would then leverage the international phase work products to streamline patent examination.

4. Ultimately, participation in the PPH does not require or involve any substantive changes in how participating offices search and examine applications, but instead acts to provide that participating Offices are presented with better quality applications to process.

5. To date, the PPH has been shown to provide benefits for Offices and applicants alike. Specifically, the PPH has been shown to significantly speed up the examination process for corresponding applications filed in participating countries by encouraging applicants to present applications that successfully address prior search and examination results, and thus allowing examiners to take advantage of those search and examination results. This leveraging of search and examination results is carried out while respecting the national sovereignty of the participating Offices, since a search and examination of the application continues to be performed by each Office according to its national laws, and no deference is given to the patentability determinations reached by other Offices. Some of the proven benefits of the PPH include: accelerated examination, a significantly higher allowance rate, a decreased cost of prosecution resulting from the fact that PPH cases generally have fewer actions prior to allowance, and reduced pendency. The quality of the patents granted under the PPH is not compromised, and may be enhanced by giving the examiner a better starting point for their search and examination. Since every Office participating in the PPH carries out a search and examination according to its national laws, the quality of the granted patents is at least as high as that of the patents granted in those Offices outside of the PPH.

6. Regarding the efficiency benefits to the Offices, the United States Patent and Trademark Office (USPTO) has experienced the following<sup>1</sup>:

Allowance Rate:

PPH – 86%  
Non-PPH applications – 77%

First Action Allowance Rate:

PPH – 28%  
Non-PPH applications – 13%

Average Pendency to First Action:

PPH – 10.3 months  
All applications – 14.8 months

Average Pendency to Final Decision:

PPH – 15.3 months  
All applications – 23.3 months

7. Similar data for other PPH participating Offices can be found at:  
<https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html>.

8. Currently, all of the International Authorities, except for one, as well as a large number of Offices that do not act as an International Authority have entered into PPH agreements with at least one other national or regional Office. The result is that there is an ever-growing number of bilateral PPH agreements in force worldwide. By formally incorporating the PPH into the PCT System, the need for many of these separate agreements could be eliminated. Further, the

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<sup>1</sup> Data for October 2019 – September 2020

requirements for receiving PPH treatment before a given Office can differ from one PPH agreement to another. Adoption of the proposal to formally integrate the PPH into the PCT would, therefore, have the added benefit of standardizing many of these requirements, and thus simplifying the process for applicants.

## **INTEGRATION OF THE PPH INTO THE PCT**

9. At the fifth session of the PCT Working Group, held in Geneva from May 29 to June 1, 2012, the United Kingdom and the United States of America presented a joint proposal entitled “PCT 20/20”, containing 12 proposals for further improvement of the PCT System (document PCT/WG/5/18). The joint PCT 20/20 proposal included a specific proposal for “Formal Integration of the Patent Prosecution Highway into the PCT, Fast Track of National Phase Applications, Improve Reuse of PCT Work at the National Phase.”

10. Taking into account the discussions and the comments received during the fifth session of the Working Group, the United Kingdom and the United States of America prepared revised versions of the original proposals, which were presented at the twentieth session of the Meeting of International Authorities under the Patent Cooperation Treaty (MIA), the sixth session of the PCT Working Group, and the twenty-first session of the MIA. The revised and expanded proposals included specific proposals to amend the PCT Regulations to include new Rules 52*bis* and 78*bis*, which specifically provide for PPH treatment of applications entering the national phase under certain conditions.

11. With regard to the specific discussions at the MIA, the Authorities expressed general support for the proposal and indicated a particular interest and hope for fast progress in the PCT Working Group on the formal integration of the PPH into the PCT System. Regarding the discussions at the sixth session of the Working Group, while some concerns were raised, the Report from the Working Group indicates that the majority of the delegations which took the floor indicated a level of support for the proposal, and indicated a willingness to consider proposals directed to overcoming the stated concerns or, in the alternative, indicated that they would take advantage of the proposed notice of incompatibility. However, two delegations indicated outright opposition to the proposal for several reasons, including national sovereignty concerns.

12. Subsequent to the discussions at the twentieth and twenty-first sessions of the MIA and the sixth session of the PCT Working Group, the USPTO and United Kingdom Intellectual Property Office (UKIPO) presented a further revised proposal to the seventh session of the PCT Working Group (PCT/WG/7/21). The further revised proposal took into account the concerns and suggestions made by the Member States and other International Authorities, and met with support by many of the delegations that took the floor at the Working Group meeting. Unfortunately, several delegations still opposed the proposal for the reasons they had given previously, and consensus could not be reached.

13. The USPTO and our co-sponsoring offices continue to hold the position that worldwide use of the PPH should be further advanced by formally incorporating it into the PCT legal framework. In the time since this proposal was first considered by the PCT Working Group and MIA, some Offices that initially had concerns about the proposal may have changed their positions, and in fact, some Offices that opposed the proposal are now active participants in the Patent Prosecution Highway system. Therefore, in view of the changes to the international intellectual property landscape regarding PPH, it is our position that the time is right to reintroduce the previous UKIPO/USPTO proposal to amend the PCT Regulations and Administrative Instructions to provide for expedited national phase examination through formal integration of the Patent Prosecution Highway into the PCT System.

## **PROPOSAL**

14. Annexes I and II of this document contain the specific proposals to amend the PCT Regulations and Administrative Instructions to formally integrate the PPH into the PCT System.

15. As the Member States consider the proposals contained in the Annexes to this document, the following points should be kept in mind:

- In the 15 years that PPH agreements have been in effect, it has been clearly demonstrated that the PPH system does not affect national sovereignty, and in no way provides for an automatic or mandatory grant of a patent. The final determination of whether patent rights are ultimately granted is still left entirely to the national/regional Office concerned.
- Under the proposal, the national Office merely leverages the international phase work products to streamline its own patent examination. National Offices would make a determination as to patentability under their respective national laws taking into account the results of the international stage work product. As such, there would be no change in the PCT System beyond the accelerated examination of certain applications in the national phase.
- Further, any national sovereignty concerns are also addressed through the provision of a notice of incompatibility or, in the alternative, an opt-in procedure in the proposed Rules.
- It has also been shown that the PPH in no way negatively affects the quality of the national phase examination or the quality of any patents issued.
- Formal integration would allow applicants from all member countries to take advantage of the benefits of PPH worldwide regardless of whether their own national Office has entered into a bilateral agreement with another national Office.
- The proposal would also benefit the national offices by providing a mechanism that would assist the Offices in their efforts to reduce any current backlogs of applications.
- Integration of PPH into the PCT System would have no effect on any existing bilateral or multilateral PPH programs with respect to non-PCT work products. To the extent that existing PPH programs already provide for PCT work products, the proposed integration can be viewed as either a replacement or additional mechanism for requesting PPH status.
- The International Bureau has stated that it does not consider this proposal to be a dramatic change in the nature of the PCT and that implementation would not require the convening of a Diplomatic Conference in order to amend the Treaty itself.

*16. The Working Group is invited to consider and comment on the proposals contained in the Annexes to this document.*

[Annexes follow]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS<sup>2</sup>

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<sup>2</sup> 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 Examination Before the Designated Office**

#### 52bis.1 Request and Requirements

(a) At the request of the applicant, any application which contains or is amended to contain, prior to the start of examination by the designated Office, only claims which sufficiently correspond to claims which were indicated as meeting the criteria of Article 33(2) to (4) in the written opinion of the International Searching Authority, and which otherwise satisfies the criteria as set forth in the Administrative Instructions, shall receive expedited examination as defined in the Administrative Instructions.

[(b) If, on [...], paragraph (a) is not compatible with the national law applied by the designated Office, the paragraph shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [...]. The information received shall be promptly published by the International Bureau in the Gazette.]

[(b) Any designated Office which provides expedited examination in accordance with paragraph (a) shall inform the International Bureau accordingly, and the information received shall be promptly published by the International Bureau in the Gazette.]

(c) Any designated Office which provides expedited examination in accordance with paragraph (a) may temporarily suspend offering such as it deems necessary (e.g., for the purposes of workload control, etc.), provided that the said Office informs the International Bureau accordingly including an indication of the period of time the Office expects the suspension to last. The information received shall be promptly published by the International Bureau in the Gazette.

Comment: The alternative options for paragraph (b) are presented for consideration depending on whether the Member States decide that an opt-out or opt-in procedure is desired.

## **Rule 78bis**

### **Expedited Examination Before the Elected Office**

#### 78bis.1 Request and Requirements

(a) At the request of the applicant, any application which contains or is amended to contain, prior to the start of examination by the elected Office, only claims which sufficiently correspond to claims which were indicated as meeting the criteria of Article 33(2) to (4) in the written opinion of the International Preliminary Examining Authority or the international preliminary examination report, and which otherwise satisfies the criteria as set forth in the Administrative Instructions, shall receive expedited examination as defined in the Administrative Instructions.

[(b) If, on [...], paragraph (a) is not compatible with the national law applied by the elected Office, the paragraph shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [...]. The information received shall be promptly published by the International Bureau in the Gazette.]

[(b) Any elected Office which offers expedited examination in accordance with paragraph (a) shall inform the International Bureau accordingly, and the information received shall be promptly published by the International Bureau in the Gazette.]

(c) Any elected Office which provides expedited examination in accordance with paragraph (a) may temporarily suspend offering such as it deems necessary (e.g., for the purposes of workload control, etc.), provided that the said Office informs the International Bureau accordingly including an indication of the period of time the Office expects the suspension to last. The information received shall be promptly published by the International Bureau in the Gazette.

Comment: The alternative options for paragraph (b) are presented for consideration depending on whether the Member States decide that an opt-out or opt-in procedure is desired.

[Annex II follows]



PROPOSED MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS<sup>3</sup>

**PART 9**

**INSTRUCTIONS RELATING TO EXPEDITED NATIONAL PHASE PROCESSING**

**UNDER PCT RULES 52 B/S OR 78 B/S**

**Section 901**

**Requirements for Expedited Examination**

(a) Pursuant to Rules 52 bis and 78 bis, a national or regional phase application filed under Article 22 or 39 shall receive expedited 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 43 bis.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 Article 33(2), 33(3) and 33(4), respectively, provided that such expedited examination shall not be accorded on the basis of the international search report alone;

(ii) all of the claims in the national or regional phase application sufficiently correspond or 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,

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<sup>3</sup> 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.

[Section 901, continued]

inventive step, and industrial applicability in the opinion or report in subparagraph (i);

(iii) the applicant has submitted a formal request for expedited examination under this Section; and

(iv) examination of the national or regional phase application has not yet begun.

(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 Examination**

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

(i) the use of a specific form to request expedited examination:

(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 Examination**

(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 substantive examination 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 for expedited examination is defective, the designated or elected Office shall give applicant at least one opportunity to correct the request within a reasonable period of time.

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

[End of Annex II and of document]