

Patent Cooperation Treaty (PCT) Working Group

**Sixth Session
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FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT

Document submitted by 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 processing 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 at the international phase. The Patent Prosecution Highway (PPH) has shown that work sharing, or work leveraging, has tangible benefits for both Offices and applicants. It is proposed to formally integrate the PPH system into the PCT. Specifically, it is proposed that, at the applicant's option, national and regional Offices be required to 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)–(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)–(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 reuse 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 or a national application receive expedited processing and 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 use the international phase work products to streamline patent processing.

4. 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 allowing examiners to reuse search and examination results. 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.

5. Currently, all but two of the International Authorities as well as a large number of non-Authorities 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 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

6. 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 twelve proposals for further improvement of the PCT system (document PCT/WG/5/18). The proposals received varying levels of support by the Working Group (see the Summary by the Chair of the fifth session, document PCT/WG/5/21, paragraphs 27 to 29). However, many delegations felt that they could provide only preliminary views on the proposals and noted that more time was needed to carefully study the proposals, to consult with user groups and to consider the possible impact on respective national laws and practices. Following the discussions, the Delegations of the United Kingdom and of the United States of America agreed to further elaborate on the proposals and to provide more details on how to take the proposals forward, for discussion at the next session of the Working Group.

7. 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."

8. 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 for further improvement of the PCT system. Those revised and expanded proposals were communicated by the International Bureau, by way of a Circular (Circular C. PCT 1364, dated December 20, 2012, Annex I), to Offices of all PCT Contracting States in their capacity as a receiving Office, an International Searching and Preliminary Examining Authority and/or a designated and elected Office under the PCT, to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers. The Circular invited recipients to review and further comment on those revised proposals and, in particular, to consult with user groups on those proposals and to consider the possible impact of those proposals, if adopted, on respective national laws and practices.

9. The revised and expanded PCT 20/20 proposals contained in Circular C. PCT 1364 included specific proposals to amend the PCT Regulations to include new Rules 52*bis* and 78*bis* which specifically provide for PPH treatment for applications entering the national phase under certain conditions.

10. To date, 31 responses to the Circular have been received, including comments from 24 national and regional Offices and 7 user groups. The responses included comments on the proposal to incorporate the PPH into the PCT from 20 of the national and regional Offices and each of the user groups, with a majority of those national and regional Offices and every user group expressing a level of support for the proposal.

11. Further, the expanded proposals were discussed at the twentieth session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Munich from February 6 to 8, 2013. A summary of those discussions is set forth in paragraphs 52 to 102 of the Annex to Document PCT/WG/6/3 (MIA Report). In particular, it is noted in paragraph 101 that “there was particular interest and hope for fast progress in the PCT Working Group” on several items, including the formal integration of the Patent Prosecution Highway (PPH) into the PCT system.

12. With regard to the specific discussions at the MIA on the topic of formal integration of PPH into the PCT process, paragraph 83 of the MIA Report states:

“83. Authorities expressed general support for the proposal. Some Authorities emphasized the importance of accelerated treatment of an application being applicant-driven, the impact of expedited processing on resources in an Office, the need for PCT Contracting States to be able to make reservations of incompatibility with their national laws and the development of common guidelines by the Japan Patent Office within the Plurilateral Patent Prosecution Highway (PPH) Network. Should this proposal go forward, it would be necessary to have a common understanding of the meaning of “sufficiently correspond” in the proposed new rules. While the proposal referred to PCT Articles 32(2) to (4) (novelty, inventive step and industrial applicability), it would also need to be certain whether other matters were relevant, for example, the effect of support and clarity points made in Box VIII. In addition, the Administrative Instructions would need to clarify what was meant by accelerated procedures, as treatments currently differed between PCT-PPH agreements.”

13. In addition to those concerns raised at the MIA, there were also concerns expressed in the responses to the Circular. Of those concerns contained in the responses, the most frequent comments were directed to issues of national sovereignty, workload concerns, and the fact that such processing should only be at the request of applicant.

PROPOSAL

14. Annexes I and II of this document contain specific proposals to amend the PCT Regulations and Administrative Instructions to formally integrate the PPH into the PCT system. The proposals contained in the Annexes are believed to address the remaining concerns as expressed by the MIA as well as those expressed in the responses to Circular C. PCT 1364.

15. Annex II of this document contains proposed amendments to the Administrative Instructions which attempt to address the comments of the MIA. Specifically, the proposed Administrative Instructions set forth a definition of “sufficiently correspond” (paragraph (a)(ii)), provide that any claims presented must be free of any observations in Box VIII (paragraph (a)(iii)), and sets forth an understanding of what is meant by “expedited processing” (paragraph (c)).

16. Regarding the fact that several respondents to the Circular indicated concerns with regard to national sovereignty issues, it should be noted that the PPH in no way provides for an automatic or mandatory grant of a patent as a result of positive indications under PCT Article 33(2)–(4) by the International Searching Authority or the International Preliminary Examining Authority. Rather, the proposal simply provides for expedited processing for applications entering the national phase with such an indication. The final determination of whether patent rights are ultimately granted is still left entirely to the national/regional Office concerned. Further, any national sovereignty concerns are also addressed through the provision of a notice of incompatibility in the Rules.

17. The inclusion of a notice of incompatibility in the Rules would also seem to address any concerns expressed with regard to workload issue by providing Offices with the ability to delay modification of their national laws and procedures until such time as they felt they could adequately address any workload issues.

18. Finally, the comments directed to the concern that any expedited processing under this proposal should only be at the request of applicant, are addressed through the specific provision in paragraph (a) of both proposed Rule 52*bis* and proposed 78*bis* that such processing must be “at the request of the applicant.”

19. *The Working Group is invited to consider the proposals contained in the Annexes to this document.*

[Annexes follow]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ 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) 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 set forth in the Administrative Instructions.

(b) If, on [...], paragraph (a) is not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue 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.

Rule 78bis

Expedited Processing and Examination Before the Elected Office

Rule 78bis.1 Request and Requirements

(a) 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 set forth in the Administrative Instructions.

(b) If, on [...], paragraph (a) is not compatible with the national law applied by the elected Office, those paragraphs shall not apply in respect of that Office for as long as they continue 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.

[Annex II follows]

PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS²

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);

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.

[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 II and of document]