

Patent Cooperation Treaty (PCT) Committee for Technical Cooperation

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EXTENSION OF APPOINTMENT OF THE UNITED STATES PATENT AND TRADEMARK OFFICE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

1. All of the existing International Authorities were appointed by the PCT Assembly for a period ending on December 31, 2017. In 2017, the Assembly will therefore need to make a decision on the extension of the appointment of each existing International Authority that wishes to seek an extension of its appointment, having first sought the advice of this Committee (see PCT Articles 16(3)(e) and 32(3)). Information concerning this process and the role of the Committee is set out in document PCT/CTC/30/INF/1.

2. On March 7, 2017, the United States Patent and Trademark Office submitted its application to extend its appointment as an International Searching Authority and International Preliminary Examining Authority under the PCT. This application is reproduced in the Annex to this document.

3. *The Committee is invited to give its advice on this matter.*

[Annex follows]

APPLICATION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
FOR EXTENSION OF APPOINTMENT
AS AN INTERNATIONAL SEARCHING AND
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

1 – GENERAL

Name of Office or intergovernmental organization: United States Patent and Trademark Office (USPTO)

Date on which application for appointment was received by the Director General:
March 7, 2017

Session of the Assembly at which appointment is to be sought:
The 49th Session of the WIPO International Patent Cooperation Union Assembly

Expected date at which operation as ISA/IPEA could commence:
Operation as ISA/IPEA is ongoing

2 – SUBSTANTIVE CRITERIA: MINIMUM REQUIREMENTS FOR APPOINTMENT

The requirements for reappointment of existing International Authorities are substantially the same as those for the appointment of new offices, subject to certain modifications agreed-to by the member States.

The minimum requirements for appointment as an International Searching Authority are set forth in PCT Rule 36.1, as follows:

- (i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches;
- (ii) that Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media;
- (iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;
- (v) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

The minimum requirements for appointment as an International Preliminary Examining Authority are similar and are set forth in PCT Rule 63.1 as follows:

- (i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out examinations;

(ii) that Office or organization must have at its ready disposal at least the minimum documentation referred to in Rule 34, properly arranged for examination purposes;

(iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international preliminary examination;

(v) that Office or organization must hold an appointment as an International Searching Authority.

The USPTO meets and exceeds all the requirements specified to obtain an extension of its appointment as an International Authority under the PCT, as explained in the paragraphs which follow.

2.1 – SEARCHING AND PRELIMINARY EXAMINING CAPACITY

Number of examiners:

As of January 2017, the USPTO employed over 8,100 utility patent examiners. The number of examiners can be broken down in the following technical specialties, with related average years of experience.

The Technical Centers (TC) referred to in the following tables correspond to the following technologies:

1600 Biotechnology and Organic Chemistry.

1700 Chemical and Materials Engineering.

2100 Computer Architecture Software and Information Security.

2400 Networks, Multiplexing, Cable and Security.

2600 Communications.

2800 Semiconductor, Electrical Optical Systems and Components.

3600 Transportation, Construction, Agriculture and Electronic Commerce.

3700 Mechanical Engineering, Manufacturing and Products.

TC	1600	1700	2100	2400	2600	2800	3600	3700	Other
Number	618	879	871	1002	1001	1403	1051	1163	896
Years exp.	11.7	11.3	8.9	8.3	10.2	10.7	9.7	8.8	9.5

In addition to the USPTO staff examiners, about 375 contract examiners are utilized to carry out search and examination of PCT international applications which specify the USPTO as the International Searching Authority. The outsourcing of PCT Chapter I work is carried out by the USPTO to more efficiently adapt to its workload needs.

Training of examiners:

All USPTO patent examiners are required to hold a science or engineering degree, and are placed in a rigorous training program when they join the examining corps. The training of new examiners and the ongoing advanced training of current examiners is carried out at the U.S. Patent Training Academy.

Mandatory training for first year patent examiners

The mandatory training for first year patent examiners at the Training Academy is formed of two training programs: the Intellectual Property Experienced Examiner Training and the Entry Level Two-phased Training program which is completed over a 12 month period. The first is meant for highly experienced candidates, such as former examiners. The latter program is designed for less experienced candidates.

Intellectual Property Experienced Examiner Training Curriculum

This program includes enhanced instruction in legal, procedural, and automation training in more than a dozen specialized applications used in patent examination, multiple search systems and databases. Training is also directed to commonly used office applications such as USPC and CPC classification systems, searching (classification, text), claims interpretation, advanced text searching and to Technology Center (TC) specific tools, such as STN and Dialog. Candidates are also instructed in writing an effective examiner's answer, in appeal procedure and practice.

Entry Level Two-Phased 12-Month New Examiner Training Curriculum

This program includes legal and procedural training and enhanced instruction in USPC and CPC classification systems, searching (classification, text), claims interpretation, advanced text searching, writing an effective examiner's answer, appeal procedure and practice.

Technical training includes introduction to examining applications in specific areas of technology, the current state of specific technologies and ongoing technology topics, among others.

Automation training includes classes in more than a dozen specialized applications used in patent examination, multiple search systems, databases, and commonly-used office applications.

Life skills training includes: time management, ethics training, stress management, balancing quality and production, professionalism, benefits and financial planning basics, balancing work and personal life, diversity training, and negotiating conflict.

Individual Development Plan

The Academy training program includes creating an Individual Development Plan (IDP) for each examiner. The IDP is composed of formal training courses, development assignments, and on-the-job training. The IDP is designed to assist the examiner from day one, through the first 12 months of employment. When the examiner graduates from the Academy, and is transferred to a TC, the IDP will continue to enable the examiner to acquire the competencies essential to perform assigned duties and to prepare for further development.

Programs for all Patent Examiners

The Legal Practice and Procedure Training includes many courses available to new as well as experienced examiners. Some of these courses include:

Patent Examiner Refresher Training

These are courses developed to enhance patent examiners' knowledge and skills in procedural and legal topics pertaining to patent examination. Participants may enroll in one or more courses in consultation with their supervisor.

Advanced Patent Examiner Training

This is a program for examiners who have several years of patent examining experience. The program provides training in specific legal areas such as evaluating unexpected results in obviousness cases and actual reduction to practice questions, often found in affidavit practice.

Patent Corps Examination Training

This training addresses patent examination policy, practice, and procedures, including legal lectures, for examiners at any grade or level of experience.

In-House Patent Law and Evidence Course

This training for patent examiners is designed to address authoritative court decisions on statutory issues under 35 U.S.C. §§ 101 (patentable subject matter), 102 (novelty), 103 (non-obviousness), and 112 (written description and claims). The course also teaches the handling of evidence during the examination of applications.

Patent Examiner Technical Training Program (PETTP)

In accordance with a White House executive action call to strengthen our patent system and foster innovation, the USPTO is expanding its Patent Examiner Technical Training Program (PETTP). The program is aimed at encouraging innovation and strengthening the quality and accessibility of the patent system. Scientists, engineers, professors, industrial designers, and other technology experts volunteer to share their expertise with patent examiners within a learning environment. Presentations discuss advances in state of the art, emerging trends, and recent innovations in their fields. Courses offered in the past have covered topics such as cloud computing, green technologies, and nanotechnologies from participants such as major corporations and universities. Technology experts from outside USPTO who have value-added expertise teach these courses.

Site Experience Education (SEE) Program

This unique program provides opportunities for groups of examiners to experience technology at its source by visiting sites of innovation within the continental United States to get updates on current and emerging technologies and see technology first-hand. Past visits have been conducted at the sites of companies such as Boeing, Google, IBM, Intel, NASA, Samsung, Syngenta Biotechnology, University of Texas at Austin, and Yahoo. Visits are bundled so examiners can compare and contrast experiences at multiple sites.

Continuing Education Series

Training for patent examiners to enhance their technical and legal knowledge in the examination of patent applications with the following courses:

- Non-Duty Hours Legal Studies Program

- Non-Duty Hours Technical Training Program
- Updated Automation Tools Training (in coordination with Office of Patent Information Management)
- Patent Administrative Professional Training
- Patent Examination for Non-Examiners
- Legal Secretaries and Administrators Conference

PCT-specific training

The International Patent Legal Administration (IPLA) - formerly the Office of PCT Legal Administration, educates and assists the patent community, develops policy and resolves legal issues relating to, among others, the Patent Cooperation Treaty (PCT). One of its functions is to provide instruction to patent examiners at the USPTO concerning the search and examination of PCT applications. The instruction includes training on PCT Chapter I, Chapter II, unity of invention, PCT procedures, taking into account results of earlier search in PCT Chapter I, and other PCT topics.

Contract examiners

The USPTO provides to the contractors training and training materials as needed for initial and recurrent training. Routine training is generally provided by the contractor, in compliance with the requirements specified in the contract with the USPTO. The USPTO monitors the work of the contract examiners and provides training as necessary.

Access to the Minimum Documentation Described in PCT Rule 34

The USPTO provides to examiners access to the patent and non-patent literature collections that are specified in the PCT minimum documentation, and continuously seeks to improve patent examiner's access to prior art.

The Office of Patent Automation (OPA) has program and project management responsibility for all patent automation programs and initiatives. OPA ensures the development and enhancement of automation tools and technologies that incorporate the necessary functional and technical requirements, to effectively improve patent business operations.

In particular, OPA's Patent Examination Tools Division (PETD) is responsible for the development and maintenance of desktop automation tools and data repositories that are used in the day-to-day examination process. It also provides support to various patents initiatives, such as the Patent Hoteling Program (PHP), Patent File Wrapper (PFW), eSignature, and eGrant.

Some of the searching tools available to examiners include the Examiner's Automated Search Tool (EAST) which provides access to multiple text data sources including the Pre-Grant Publications (US-PGPUB), U.S. Patents (USPAT), U.S. Optical Character Recognition (USOCR), European Patent Office (EPO) Abstracts, Japanese Patent Office (JPO) Abstracts, and Foreign Patent Retrieval system (FPRS) databases.

Another tool available to examiners is the Web-based Examiner's Search Tool (WEST) which offers a server-based application tool for searching patent full-text and abstract databases. It also uses the search language entitled Bibliographic Retrieval Services (BRS). WEST provides identical text and image data sources as EAST, providing the following user and system functions: general patent database searches; searches bound to specific document sections; limited general and bound searches; display of search results based on a range of specified

formats; display of page images of patents; user-managed collections of documents; user-managed cases containing searches; local and TCP/IP printing for patent image documents; and links to online patent classification guides.

In addition, USPTO examiners have access to other prior art databases, both commercial and those managed by other offices. Examples include the Derwent World Patents Index from Clarivate Analytics, PATENTSCOPE from the World Intellectual Property Organization and others.

The Scientific and Technical Information Center (STIC) supports the patent examination process by providing examiners with online access to Non-Patent Literature (NPL) and foreign patent documents. STIC provides prior art searches, document delivery, foreign patents and literature translations, and one-on-one assistance with desktop electronic tools and NPL resources. It also supports access to traditional knowledge databases. One of the tasks STIC supports is to ensure access to the patent and NPL documents specified in the PCT Minimum Documentation, according to PCT Rule 34.

For PCT Chapter I searches where USPTO examiners are not employed, the contract examiners operate according to contractual provisions which specify the access to prior art databases which must be provided to those examiners. Those databases must include resources required by the PCT minimum documentation. The USPTO provides to the contractors access to the public version of WEST, in addition to the access to commercial databases obtained independently by the contractors.

2.2 – QUALITY MANAGEMENT

The USPTO has in place a quality management system and internal review arrangement in accordance with the common rules of international search, as specified in PCT Rules 36.1(iv) and 63.1 (iv), which complies with the requirements of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines..

As was agreed by the member States and as reflected in document PCT/MIA/24/2, Paragraph 7, “it shall be sufficient that an Authority seeking extension of its appointment simply refers to the most recent report on its existing quality management system submitted to the International Bureau in accordance with Chapter 21 of the PCT International Search and Preliminary Examination Guidelines.” That report is available on WIPO’s website¹.

The USPTO strives for every patent to be correctly issued in compliance with all the requirements of our patent statutes, as interpreted by our judiciary at the time of issuance. As part of our quality assurance efforts, the USPTO trains all examiners on these legal requirements, including through new examiner training and through mandatory training for all examiners on new developments in the law. The USPTO has mechanisms in place to ensure that examiners properly apply these legal requirements in a manner that results in issued patents meeting all those legal requirements. The USPTO’s recent effort on quality, the Enhanced Patent Quality Initiative (EPQI), is focused on improving these mechanisms by institutionalizing best practices and strengthening the USPTO’s work products, processes, and services at all stages of the patent process. Specifically, as part of the EPQI, the USPTO has implemented a number of quality-focused programs, structured around three core pillars, namely excellence in work products (Pillar 1), excellence in measuring patent quality (Pillar 2), and excellence in customer service (Pillar 3).

With respect to the contractors carrying out PCT Chapter 1 searches, a proposed QMS is established at the time of posting of a request for proposal (RFP) and finalized when contracts

¹ <http://www.wipo.int/pct/en/quality/authorities.html>.

are awarded. The QMS includes, inter alia, quality review, feedback, training, and specific implications for not meeting prescribed targets for quality and timeliness. The contractor's QMS is modified with action plan(s) whenever prescribed targets for quality and/or timeliness fall outside of the contractual compliance rate. The USPTO monitors the quality of the contractors' work product to ensure it remains at a very high level.

3 – INTENDED SCOPE OF OPERATION

The USPTO operates in the English language only. The services of the USPTO as PCT ISA/IPEA will continue to include subject matter that is searched and examined in the United States for national applications. No changes are expected to take place regarding the subject matter limitation nor any other limitation with respect to the current operation of the USPTO as ISA/IPEA under the PCT.

The USPTO, as an International Searching Authority, conducts international searches and prepares international search reports and written opinions for, in addition to the United States of America, the following jurisdictions: Bahrain, Barbados, Brazil, Chile, Dominican Republic, Egypt, Georgia, Guatemala, India, Israel, Mexico, New Zealand, Oman, Panama, Peru, Philippines, Qatar, Saint Lucia, Saint Vincent and the Grenadines, South Africa, Thailand, and Trinidad and Tobago.

4 – STATEMENT OF MOTIVATION

Background

The United States Patent and Trademark Office (USPTO) is the agency that is charged with granting U.S. patents and with registering trademarks. In addition to these core functions, the USPTO advises the President of the United States, the Secretary of Commerce, and various U.S. government agencies on intellectual property (IP) policy, protection, and enforcement. The office also promotes stronger and more effective IP protection around the world. The USPTO seeks to facilitate effective IP protection for U.S. innovators and entrepreneurs worldwide by promoting the adoption of strong IP provisions in international agreements and by providing training, education, and capacity building programs designed to foster respect for IP and encourage the development of strong IP regimes by U.S. trading partners.

The history of the USPTO spans more than 200 years. In 1790, then-President George Washington established the first Patent Act, under which the Secretary of State was responsible for issuing patents. That responsibility was soon transferred to clerks in the State Department, and in 1802 was given to the newly created role of clerk in the Department of State, which became the first patent office. Trademark registration was added to the Office's functions in 1881. On July 31, 1790, the United States awarded its first patent, which was signed by then-President George Washington.

Under this system of intellectual property protection, American industry has flourished. New products have been invented, new uses for old ones discovered, and employment opportunities created for millions of Americans. The strength and vitality of the U.S. economy depends directly on effective mechanisms that protect new ideas and investments in innovation and creativity. The continued demand for patents and trademarks underscores the ingenuity of American inventors and entrepreneurs. The USPTO is at the cutting edge of the nation's technological progress and achievement.

The 2012 report *Intellectual Property and the U.S. Economy: Industries in Focus*, prepared by the Economics and Statistics Administration and the USPTO, identified IP-intensive industries and quantified their contribution to the U.S. economy. It found that in 2010, IP-intensive industries supported over 40 million jobs and accounted for about 5.06 trillion United States

dollars in value added, equivalent to 34.8 per cent of U.S. GDP. The current revision of the report provides updated results demonstrating that IP-intensive industries supported 45.5 million jobs and contributed 6.6 trillion United States dollars in value added in 2014, equivalent to 38.2 per cent of U.S. GDP. The 2016 update to the report reinforces the earlier finding that IP use permeates all aspects of the economy with increasing intensity and extends to all parts of the United States.

The USPTO headquarters occupies five interconnected buildings located at 600 Dulany Street, Alexandria, Virginia as well as other buildings in the Washington, D.C. area. The office employs more than 10,000 people -- including engineers, scientists, attorneys, analysts, computer specialists -- all dedicated to protecting U.S. intellectual property rights.

When then-President Obama signed the America Invents Act into law in 2011, the USPTO was granted the ability to establish at least three regional offices. The first of the new offices, the Elijah J. McCoy office in Detroit, opened in 2012. Our Rocky Mountain Regional Office in Denver, Colorado, opened in 2014. Our Silicon Valley office opened in San Jose, California, in October 2015, and serves the West Coast region. Our Texas Regional Office opened in Dallas in November 2015 and serves the region across the south and southwestern U.S.

Our regional offices give inventors, entrepreneurs, and small businesses the added benefit of a USPTO presence in every U.S. time zone. Staff in these offices work closely with intellectual property services, start-ups and job-growth accelerators in their regions. They collaborate with local science, technology, engineering and mathematics organizations to further the mission of the office.

The structure of the USPTO comprises multiple organizations with diverse responsibilities. Some of these include:

The Office of the Under Secretary and Director

The Office is the principal advisor to the President, the Secretary of Commerce, and the Administration on all intellectual property matters. The Office of the Under Secretary oversees all offices within the USPTO, ensuring the agency achieves its strategic and management goals, including quality, timeliness, cost-effectiveness, and transparency.

The Office of the Commissioner for Patents

The Office of the Commissioner for Patents of the USPTO examines applications and grants patents on inventions when applicants are entitled to them; it publishes and disseminates patent information, records assignments of patents, maintains search files of U.S. and foreign patents and maintains a search room for public use in examining issued patents and records.

The Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB) is created by statute, and is staffed with Administrative Patent Judges. The PTAB is charged with rendering decisions on appeals from adverse examiner decisions, carrying out post-grant proceedings, conducting derivation proceedings and other tasks.

Role in the PCT System

The Patent Cooperation Treaty (PCT) provides applicants who seek patent protection for an invention simultaneously in many jurisdictions the ability to file a single "international" patent application. The USPTO currently operates as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty (ISA/IPEA) pursuant to the terms of an agreement between the USPTO and the International Bureau of the

WIPO². The 2007 Agreement entered into force on January 1, 2008, and will terminate by its terms on December 31, 2017, at the end of the current 10 year term.

The primary functions of the USPTO when operating as an ISA are to establish (1) international search reports and (2) written opinions for international applications having an international filing date on or after January 1, 2004. These functions are defined in PCT Article 16 and PCT Rules 43 and 43*bis*.

When operating as an IPEA, the office's functions are to issue International Preliminary Examination Reports, as defined in PCT Article 32 and PCT Rule 66.

The functioning of the USPTO as a PCT ISA/IPEA is of great importance to both U.S. and foreign applicants, as demonstrated by the high level of use of the ISA/IPEA services provided by the USPTO. In fiscal year 2016, the USPTO generated over 21,000 international search reports, and over 1,200 international preliminary examination reports.

The USPTO has been very active in the PCT system overall. As reported in the *FY 2015 Performance and Accountability Report*, (WIPO STATISTICS) the USPTO as a Receiving Office received 57,881 international applications and as an International Preliminary Examining Authority completed 1,655 international preliminary examinations under Chapter II. As an International Searching Authority, the USPTO generated 19,276 international search reports and written opinions during 2015.

Pursuant to agreements concluded with the International Bureau, the USPTO, as an International Searching Authority, conducts international searches and prepares international search reports and written opinions for, in addition to the United States of America, the following jurisdictions: Bahrain, Barbados, Brazil, Chile, Dominican Republic, Egypt, Georgia, Guatemala, India, Israel, Mexico, New Zealand, Oman, Panama, Peru, Philippines, Qatar, Saint Lucia, Saint Vincent and the Grenadines, South Africa, Thailand, and Trinidad and Tobago.

5 – APPLICANT STATE

Profile of the United States

The following information pertains to the United States of America:

Population (December 2016) ³ :	324,304,407
GDP (2016) ⁴ :	18.56 trillion United States dollars
R&D expenditures as percent of GDP (2013) ⁵ :	2.73%
Number of research universities (2016) ⁶ :	115

² Agreement between the USPTO and the International Bureau of the WIPO in relation to the functioning of the United States Patent and Trademark Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty, October 3, 2007

³ The United States Census Bureau. <http://www.census.gov/popclock/>

⁴ Bureau of Economic Analysis, U.S. Department of Commerce. <https://www.bea.gov/national/index.htm>

⁵ The World Bank. <http://data.worldbank.org/indicator/GB.XPD.RSDV.GD.ZS?end=2013&start=2013&view=map>

⁶ The Carnegie Classification of Institutions of Higher Education.

<http://carnegieclassifications.iu.edu/lookup/standard.php>

6 – PROFILE OF PATENT APPLICATIONS

Number of Patents Granted As Distributed By Year of Patent Grant⁷:

Technical Field	2011	2012	2013	2014	2015
A	9,882	10,550	11,543	12,615	12,780
B	42,265	50,307	56,352	60,819	52,780
C	13,669	16,538	19,035	19,992	17,596
D	18,481	17,658	19,969	22,058	21,939
E	21,329	26,395	28,456	31,099	27,621
F	46,132	49,327	53,880	57,845	55,742
G	120,319	139,071	153,112	166,456	165,012
H	58,054	64,757	70,834	76,376	77,653

The technical fields above correspond to the following:

- A Biotechnology
- B Electrical Computers, Digital Processing Systems, Information Security, Error/Fault Handling
- C Medical Devices
- D Semiconductor Devices and Manufacture
- E Telecommunications
- F Chemical Classes
- G Electrical Classes
- H Mechanical Classes

(The totals in rows F, G and H do not include applications included in A-E)

By route for priority:

	2011	2012	2013	2014	2015
Total Application	537,171	565,566	601,464	618,457	617,216
PCT national phase	65,463	67,573	73,488	78,213	85,387

Number of international applications received as PCT RO:

⁷ USPTO Data Visualization Center. https://www.uspto.gov/web/offices/ac/ido/oeip/taf/reports_stech.htm

	2011	2012	2013	2014	2015
	48,285	52,417	56,226	62,697	56,480

National Pendency Time and Backlog

Data obtained in February 2017 from the United States Patent and Trademark Office Data Visualization Center⁸.

Parameter	Time
To first office action	15.7 months
To final disposition	25.6 months

Measure	Number of applications
Number of pending applications	546,702

CONCLUSION

As demonstrated in this application, the United States Patent and Trademark Office fully meets and exceeds all the requirements for receiving an extension for an additional 10 years of its appointment as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty.

The USPTO plays a key role in promoting intellectual property in the United States and in the world, which affects the national and global economy. Within the PCT system, the USPTO is a key player, processing a large percentage of global PCT applications, searches and examinations.

For all these reasons we request that the USPTO be appointed as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty for an additional 10 years, starting on January 1, 2018.

[End of Annex and of document]

⁸ <https://www.uspto.gov/dashboards/patents/main.dashxml>