



# **USPTO Experiences with Worksharing and with the Patent Prosecution Highway (PPH)**

Presented to the 21<sup>st</sup> session of the Standing  
Committee for the Law of Patents (SCP)

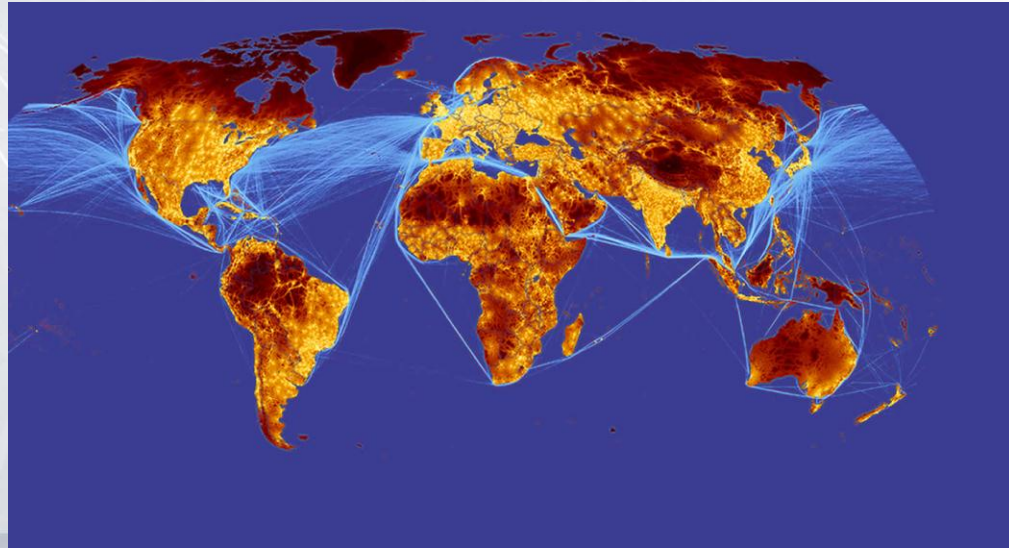
November 3-7, 2014

**United States Patent and Trademark Office**



# History of the Worksharing Programs: Global Scale of Modern Commerce

## International air routes

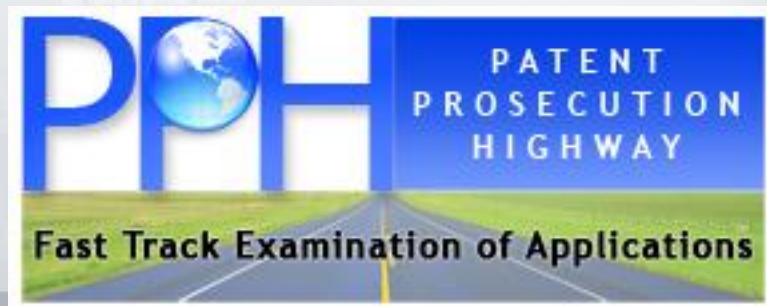


## International shipping lanes



# History of the PPH Program:

- Backlogs in offices around the world began to explode in the late 1990s
- The number of applications filed in multiple offices also started to steadily increase
- Offices began discussing potential ways to improve efficiencies – focusing on **worksharing**
- PPH began as a pilot in between the JPO and USPTO in 2006





# Why Worksharing?

Offices seek ways to re-use the search and examination results completed on related or cross-filed applications in an another Office to:

- Minimize duplication of work
- Enhance examination efficiency and quality
- Deliver real benefits to end users





# What Else can Worksharing Provide?

- Make search and examination more efficient and cost effective
- Help offices grant higher quality patents according to their national laws



# What Else can Worksharing Provide?

- Help access to specialized capabilities:
  - Languages
  - Tools
  - Prior art collections
  - Databases
  - Technical specialization



# Worksharing Pilots

- Trilateral FLASH (JPO EPO USPTO)
  - USPTO is OFF and prioritizes applications identified for the pilot
  - Evaluates ways to improve the availability and usability of results
- JP-First
  - JPO notifies USPTO when work is available; applications are not prioritized
  - Evaluates ways to improve the availability and usability of results



# Worksharing Pilots

- KIPO-USPTO SHARE Pilot
  - Offices exchange list of cross-filed applications to select candidates for pilot; applications are not prioritized
  - Evaluates the usability of results of the OFF
- UKIPO-USPTO Work Sharing Initiative
  - Offices exchange list of cross-filed applications to select candidates for pilot; applications are not prioritized
  - Evaluates the usability of results of the OFF





# Lessons Learned

- Logistical or Technical Findings:
  - Timing
  - Notification
  - Access
- Usability Findings:
  - Generally positive regarding the usefulness of work products
  - All suggest better understanding of offices' practices will improve worksharing



# Collaborative Search & Examination

Ongoing program in the PCT

- Goal: to establish a **HIGH QUALITY** search report for WIPO PCT applications
- Initially EPO, KIPO, USPTO
- Primary examiner from one office collaborates with supporting examiner(s) from the other offices



# Collaborative Search & Examination

- Phase 1: qualitative, determine if collaboration is possible
  - » Successfully completed
- Phase 2: quantitative, how useful is the collaboration
  - » Successfully completed
- Phase 3: determine interest by users of the PCT system
  - » Ongoing



# PPH Basics



- **What is PPH?**
  - A system of **work sharing** that improves examination efficiency by reducing duplication of effort among patent offices.
  - Enables an applicant who has received a determination of allowable claims from one office to obtain **fast track processing** of corresponding claims in other offices.





# How Does PPH Work?

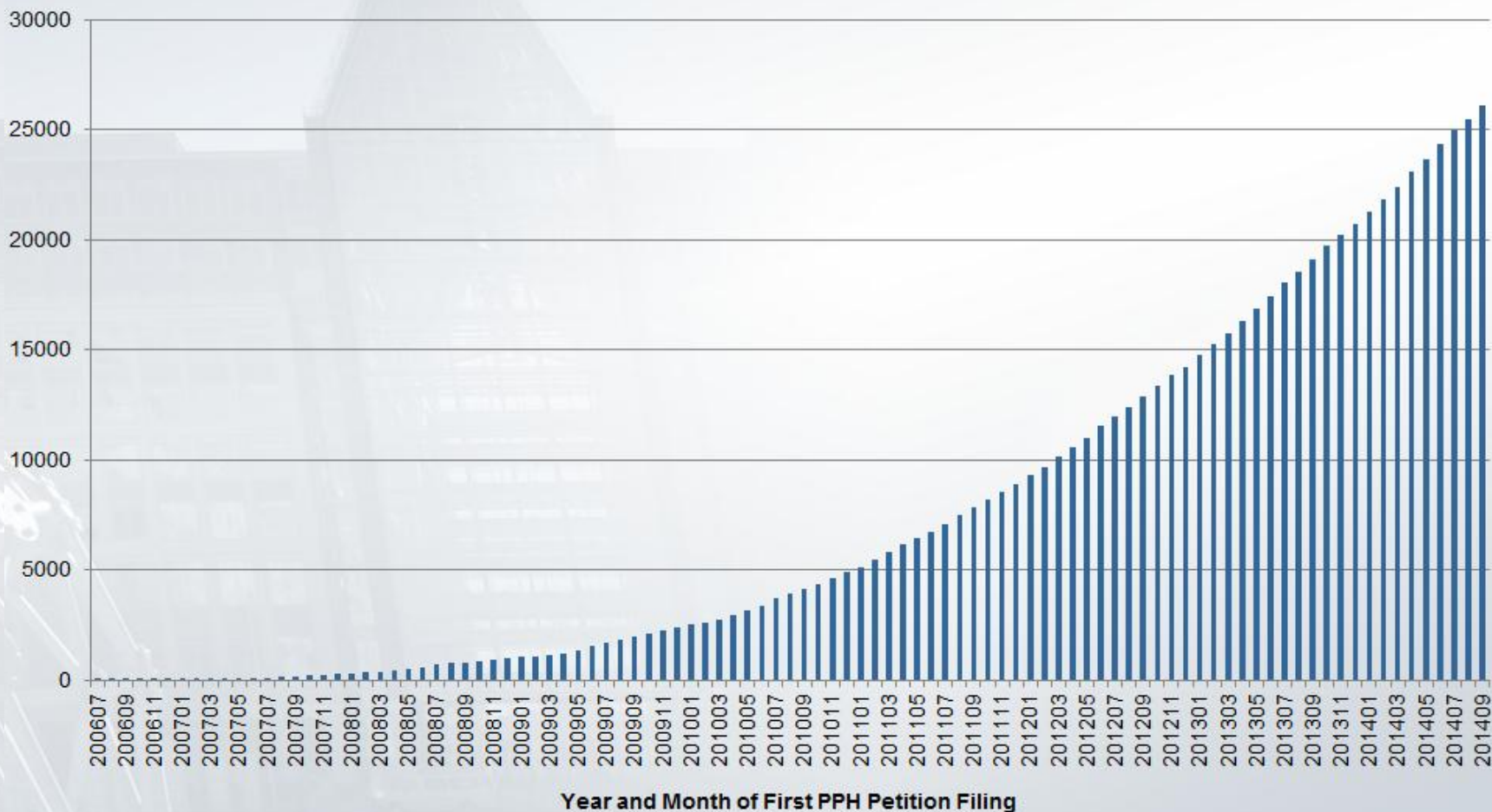
- 1. Applicant receives a positive examination result from a PPH participating office.**
  - A national/regional office action indicating allowable claims
  - Patent Cooperation Treaty (PCT) Written Opinion or PCT International Preliminary Report on Patentability
- 2. Applicant files a PPH request for a corresponding patent application in another PPH participating office.**
- 3. Once the PPH request is granted, examination of the application in the second office is expedited.**





# PPH Statistics at a Glance

## Cumulative PPH Filings from 2006 - Present





# PPH Statistics at a Glance & Program Growth – New Requests

- Approximately **26,733** petitions filed as of September 30, 2014
  - 625 filed in September 2014
- Average monthly requests = **616**
  - increased by 12% from FY 2013 to FY 2014



# Benefits of the PPH Program

- Benefits to applicant of using the PPH program:
  - Significantly lower prosecution costs
    - Higher allowance rate
    - Fewer actions per disposal
    - Reduced rates of RCE filing and Appeal
  - Fast-tracked examination improves timeliness of patent issuance
  - Potentially higher quality than can be delivered by any single office acting individually



# Terminal Disposal Comparison between PPH and non-PPH Prosecution – FY 2014

	Percent of Applications with at least one RCE	Examination Actions per Application Disposal	Overall Allowance Rate	First Action Allowance Rate
Non PPH Applications	25%	3	53.2%	12.6%
PPH Applications	12%	2.2	84%	23.8%

Examiner Actions include restrictions, non-final rejection, final rejection, ex parte Quayle, allowance, Interference, SIR disposal, Rule 105 requirement, examiner's answer, advisory action, miscellaneous action with SSP, first action interview actions, examiner initiated suspension and abandonment after PTAB decision



# PPH Cost Savings Estimate

## Savings due to reduced number of actions



- **Reply/amendment of minimal complexity**

Average Cost per response to Action = \$2,086

(Source: AIPLA Report of the Economic Survey, 2011\*)

For each non-PPH application: ( $\$2,086/\text{response} \times 3.0 \text{ actions}$ ) = \$6,258

For each PPH application: ( $\$2,086 \times 2.18 \text{ actions}$ ) = \$4,547 → **\$1,711 SAVINGS**

- **Relatively complex reply/amendment**

Average Cost per response to Action = \$3,434

(Source: AIPLA Report of the Economic Survey, 2011\*)

For each non-PPH application: ( $\$3,434/\text{response} \times 3.0 \text{ actions}$ ) = \$10,302

For each PPH application: ( $\$3,434 \times 2.18 \text{ actions}$ ) = \$7,486 → **\$2,816 SAVINGS**

\* Estimates are based on 2011 figures.

*(Estimate of cost savings data provided by the AIPLA)*





# PPH Cost Savings

## Added Cost Savings for reduced RCEs and Appeals

- **Applicable USPTO Fees**

RCEs - **\$1,200**

Appeals - **\$1,300** (\$800 Appeal and \$500 Brief)

- **Hypothetical complex case (assumes cost savings of \$3,434 per action and avoidance of RCE and appeal filings)**

Savings on Action \$ 3,434

Savings on RCE fees 1,200

Savings on Appeal fees 1,300

Savings on Appeal services 4,931  
(without oral argument)

**Total savings = \$10,865**



\* Estimates are based on 2011 figures.



# PPH Quality Benefits



- Analysis of 155 First Action Allowances
  - 98% - Examiner recorded a new search
  - 84% - Additional art cited
  - 40% - Examiner amendment and/or interview
- Higher grant rate and fewer office actions are due to **the claims entering the PPH being fewer, in better shape for allowance.**
- NOT because of lower standards of examination.



# Global/IP5 PPH Principles

- **Reciprocity**

Every participating office in Global PPH or IP5 PPH has agreed to accept the work product of any other participating office as the basis for a PPH request. (Note: some offices participate in both Global PPH and IP5 PPH.)

- **Common Requirements**

Every participating office has agreed to a common set of requirements to provide applicants with a generally standardized PPH request process.



# Global/IP5 PPH pilot

## Global PPH Principles

- Eligibility based on work available **from any participating office, regardless of OFF/OSF status**, so long as the applications share the same effective date (priority or filing).....
- Participating offices will **accept any substantive search and examination product that explicitly indicates the patentability of claims** ... done by another office under any filing scenario (Paris Convention or as PCT ISA/IPEA).

## Common Guidelines

Substantially same for all offices.

Machine translation, electronic dossier, at least one correction.



# Types of PPH Agreements

Today - 30 offices worldwide; 28 with USPTO

- **IP5 PPH** (EPO, JPO, KIPO, SIPO, USPTO)
- **Global PPH** (effective 1/6/14)
- **Bilateral Agreements**





# Global/IP5 PPH Countries



AUSTRALIA  
IPAU



CANADA  
CIPO



DENMARK  
DKPTO



EUROPEAN  
EPO



FINLAND  
NBPR



HUNGARY  
HPO



ICELAND  
IPO



ISRAEL  
ILPO



JAPAN  
JPO



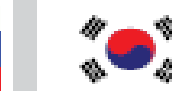
CHINA  
SIPO



PORTUGAL  
INPI



RUSSIA  
ROSPATENT



KOREA  
KIPO



NORDIC  
NPI



NORWAY  
NIPO



SPAIN  
SPTO



SWEDEN  
PRV



UK  
UKIPO



US  
USPTO



# Bilateral PPH Agreements



Austria



Columbia



Czech Republic



Germany



Mexico



Nicaragua



Philippines



Singapore

Effective November 1, 2014 – Poland will become a member of the bilateral PPH program



# Filing a PPH Request

- Eligible Applications
  1. Office of Earlier Examination (OEE) and the Office of Later Examination (OLE) must have the same earliest date (priority or filing date).
  2. Claims in the OLE application must sufficiently correspond to allowable claims in the OEE application.
  3. Substantive examination has not begun in the OLE application.



# Filing a PPH Request

- Required Documents
  1. PPH request form, which includes a claims correspondence table
  2. Copy of the most recent office action issued by the OEE
  3. Information disclosure statement (IDS), which lists any documents cited by the OEE, and document copies

Note: Item 2 and the document copies in item 3 need not be submitted if the OLE can obtain them from electronic dossier access systems (e.g. USPTO's PublicPAIR).



# Filing a PPH Request

- Cost of Submitting a PPH Request
  1. Petition fee: \$0
  2. Attorney fees
    - Minimal requirements involved
    - Harmonized procedures under Global/IP5 PPH





### III. Requirements for Requesting Participation in the Global PPH or IPS PPH ("Global/IP5 PPH") Pilot Program in the USPTO

#### A. Eligibility

- In order to be eligible to participate in the Global/IP5 PPH pilot program at the USPTO, the following requirements must be met:
- (1) The U.S. application for which participation in the Global/IP5 PPH pilot program is requested must have the **same earliest date**, whether this is the priority date or filing date, **as that of a corresponding national or regional application** filed with another Global/IP5 PPH participating office, or a corresponding PCT international application for which one of the Global/IP5 PPH participating offices was the International Searching Authority (ISA) or the International Preliminary Examining Authority (IPEA).
- <http://www.uspto.gov/patents/law/notices/global-ip5.pdf>



### III. Requirements for Requesting Participation in the Global PPH or IPS PPH ("Global/IP5 PPH") Pilot Program in the USPTO

- **A. Eligibility**
- (2) The corresponding application has **at least one claim indicated by the OEE in its capacity as a national or regional Office, ISA, or IPEA to be allowable/patentable**. A claim determined as novel, inventive, and industrially applicable by the ISA or IPEA has the meaning of allowable/patentable for the purposes of this program.



### III. Requirements for Requesting Participation in the Global PPH or IPS PPH ("Global/IP5 PPH") Pilot Program in the USPTO

- (3) All claims in the U.S. application for which participation in the Global/IP5 PPH pilot program is requested **must sufficiently correspond to the allowable/patentable claims** in the corresponding OEE application.
- A claim is considered to **sufficiently correspond where, accounting for differences due to claim format requirements, the claim is of the same or similar scope as an allowable/patentable claim in the corresponding OEE application.** A claim in the US application that is narrower in scope than the claims indicated as allowable/patentable in the OEE application will sufficiently correspond if presented as a claim dependent upon a claim that is of the same or similar scope as a claim indicated as allowable/patentable in the OEE application.



### III. Requirements for Requesting Participation in the Global PPH or IPS PPH ("Global/IP5 PPH") Pilot Program in the USPTO

- In this regard, a claim that is narrower in scope occurs when an OEE claim is amended to be further limited by an additional feature that is supported by the written description of the US application. **Additionally, a claim in the U.S. application that introduces a new/different category of claims than those indicated to be allowable/patentable by the OEE is not considered to sufficiently correspond . . .**
- (4) **Substantive examination** of the U.S. application for which participation in the Global/IP5 PPH pilot program is requested has not begun.



# Global / IP5 PPH Requirements in the USPTO

- **I. Required Documents:**
  
- a. A copy of the **most recent office action** prior to the decision to grant a patent or the **most recent PCT work product** (along with an English translation, if not in the English language):
  - is attached.
  - is already present in the U.S. application.
  - is not attached because it is available to the USPTO via the Dossier Access System or WIPO's PATENTSCOPE system.
  - is not attached because the decision to grant a patent was the first office action.





# Global / IP5 PPH Requirements in the USPTO

- **b. (1) An information disclosure statement listing the documents cited in the OEE work product:**
  - is attached.
  - has already been filed in the U.S. application.
  - is not attached because no references were cited in the document in section a. above.
  
- **(2) Copies of all cited documents (except for U.S. patents or U.S. patent application publications)**
  - are attached.
  - have already been filed in the U.S. application.
  - are not attached because no references were cited in the document in section a. above.



# Global / IP5 PPH Requirements in the USPTO

- **II. Claims Correspondence Table:**

Claims in US Application

Patentable Claims in OEE Application

Explanation regarding  
the correspondence

- **III. All the claims in the US application sufficiently correspond to the patentable/allowable claims in the OEE application.**



# What Happens to the PPH application?

- **If petition to enter PPH is granted:**
  - **Application is placed on accelerated docket**
  - **USPTO examiner reviews prior art and office communications from OEE**
  - **USPTO examiner conducts search and examines application under US law**



# PPH Current Developments

- **Expanding quality efforts/studies** of PPH petition applications (reasons for refusal).
- Developing **PPH common request form** for all PPH programs into one single form.
- **Extend Global PPH pilot indefinitely** in January 2015.
- Internal **process and utilization studies**



# Information on PPH Programs

## USPTO's Website

[http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp)

## Japan Patent Office's PPH Portal

[http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi\\_e/t\\_torikumi\\_e/patent\\_highway\\_e.htm](http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.htm)





# Thank you for your attention!

**United States Patent and Trademark Office**