

Comments from Carl Oppedahl are interleaved and indented.

1. SELF SERVICE CHANGES (92BIS/PRIORITY CLAIMS)

Under Rule 92bis, changes to the person, name, residence or address of an applicant, agent or inventor must be by way of request to the Receiving Office (RO) or the International Bureau (IB). An RO will request the IB to record any change it receives and approves. The current procedure typically results in a substantial delay between the date applicants file the request and the date the change is recorded by the IB. Complicating Rule 92bis corrections is the fact that authorities are not uniform with respect to the need for a power of attorney in effecting 92bis changes. This leads to applicant confusion, forum shopping, and in some cases conflicting decisions (where an applicant submits the request to both the RO and IB). Processing of priority claim corrections is also subject to delay, which may result in a WOISA not accurately reflecting the relevant date for prior art purposes. The aforementioned problems may be minimized through the provision of an online self-service feature whereby applicants, after verification, could make certain corrections that would be effective immediately, providing instant feedback of the approval to the applicant (similar to the USPTO ePetition feature). A self-service feature would eliminate delay and errors that occur through processing of written requests and would make the process more efficient for both applicants and authorities.

Yes it would be helpful to both Offices and to applicants if a self-service feature could be devised that would permit applicants to carry out changes under Rule 92bis and Rule 26bis in an automatic way.

Oppedahl Patent Law Firm (OPLF) is a user of WIPO's pilot system called ePCT, which may be seen at <https://pct.wipo.int/ePCT/secured> . This system provides just the kind of “verification” that you describe. See the lead story in the PCT Newsletter of January 2012 which says that WIPO expects to add a feature of:

online “actions” whereby, instead of submitting a letter, you can directly specify online the changes that you would like to make, such as corrections to priority claims, withdrawal of the international application or changes to persons, names and addresses under PCT Rule 92bis.

We at OPLF look forward to seeing this feature in the ePCT system. From the point of view of USPTO, the chief action steps would be (a) to encourage and support WIPO in the development and rollout of this feature, and (b) encouraging applicants who filed in RO/US to make use of the ePCT system for such changes. One way to communicate such encouragement to applicants would be by means of a suitable mention of the feature in the MPEP, preceded by such a mention in the OG.

2. LIMITED CHAPTER I CLAIM AMENDMENTS

Occasionally, claims containing inadvertent errors are filed in international applications. These errors include: misnumbered claims, obviously incorrect claim dependencies, multiple claim sets, etc. The PCT does not currently provide an adequate mechanism to allow applicants to correct such errors. In addition, such errors present handling problems for the ISA and often result in an ISA work product that does not cover the full scope of the invention intended by the applicant. Accordingly, permitting limited claim amendments in certain instances prior to drawing up of the search report by the ISA would be helpful to both the ISA and applicants. It is possible that such “amendments” could be

specifically provided for in PCT Rule 91.

It is true that some applicants do sometimes make mistakes such as those described here. It might thus be helpful to such mistake-making applicants to have a mechanism for correction of obvious errors in claims prior to the establishment, by the ISA, of the ISR/WO.

It is important, however, to look at things not only from the perspective of mistake-making applicants but also from the perspective of applicants who have not made such mistakes. Applicants who have not made such mistakes are told that they can expect to receive the ISR/WO within three months of the date of receipt of the Search Copy by the ISA, or within nine months of the priority date, whichever is later. The prompt and timely receipt of the ISR/WO is extremely important for some applicants. It would be unacceptable to such applicants if any change were made to existing rules or procedures that would lead to across-the-board changes in the actually experienced waiting time for an ISR/WO. For example one could imagine a change in a rule or procedure to introduce a new “waiting time” while the ISA waits to see whether the applicant files a request for a correction of obvious errors in the claims. Such a waiting time would delay the ISR/WO for *all* applicants. This would be undesirable and unacceptable.

Thus if any change in rules or procedures were made, it must be made in a way that has zero impact upon the waiting time for an ISR/WO for those applicants who did not make mistakes of this kind.

3. SIMPLIFY WITHDRAWAL OF IA'S

Applicants frequently attempt to withdraw international applications after filing for a variety of reasons, e.g., the application was inadvertently submitted twice in EFS-web, the wrong application parts were uploaded in EFS-web, an application was filed to preserve a Paris Convention priority period prior to confirmation from the client, etc. To effect withdrawal of the application, PCT Rule 90.5 requires that all applicants sign the withdrawal (either directly or through an agent to whom a power of attorney is of record). Obtaining signatures from all applicants in sufficient time to obtain a refund of previously paid costly international and search fees is difficult, particularly in cases having a number of applicant-inventors. To help such applicants, the procedure for withdrawing an international application could be eased at least in certain situations, for example, by allowing the first-named applicant to withdraw the application.

Yes such a feature would be helpful to some applicants. As mentioned above in connection with section 1, WIPO says it expects to add this feature. “Instead of submitting a letter, you can directly specify online the changes that you would like to make, such as ... withdrawal of the international application.”

USPTO could help and support by reminding applicants of this feature in an MPEP section and an OG notice.

4. STANDARDIZING NAT'L STAGE FEES BREAK/REDUCTION

The Patent Prosecution Highway (PPH) has shown that work sharing, or work leveraging, has tangible benefits for both Offices and applicants. However, the benefits of PPH may not be viewed as a sufficient incentive by some applicants to ensure that only claims meeting the criteria of PCT Article 33(2)-(4) are presented in the national stage. Accordingly, it is proposed that national and regional Offices be required to offer a national stage fee reduction for all national phase applications which are

presented with only claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4) by an ISA or IPEA. Such a fee reduction would, in the aggregate, be quite substantial and incentivize applicants to only present claims in their national stage applications that satisfy the PCT requirements of novelty, inventive step and industrial applicability. This would 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.

It is true that such a change would be helpful to applicants, by saving them money and by forcing them to think about whether to make PPH use of a favorable ISR/WO or IPRP-II result.

USPTO already has a similar fee reduction set forth in 37 CFR section 1.496, where an applicant that presents “only claims meeting the criteria of PCT Article 33(2)-(4)” in the national phase. Unfortunately Rule 496 offers this benefit only in the special case where the ISA was ISA/US.

Whenever it is proposed to “require” any particular action by all DO/EOs by means of a rules change, one must worry whether there might be pushback from one or more Offices. The rules change would, after all, present a risk of a fee shortfall at least in the near term for a particular Office.

USPTO could set an example for other DO/EOs by revising Rule 496 to make the fee reduction available regardless of the ISA that had been chosen by the applicant in the international phase.

In the same rulemaking proceeding, USPTO could likewise make a similar fee reduction available for *any application* claiming the benefit under 35 USC section 120 (directly or indirectly) from an international application, again tied to the presentation only of “claims meeting the criteria of PCT Article 33(2)-(4)” regardless of the choice of ISA made by the applicant in the international phase.

5. INTERNATIONAL SMALL/MICRO ENTITY FEE (OR DISCOUNT)

Economic research indicates that small entities (or businesses) are the primary driver of job creation. Part of the growth of small entities is based upon internationalization of their business. For all innovators, patent protection can be a useful tool to protect investments. Patenting in international markets is, however, a costly endeavor. This presents a special challenge for small entities. A PCT small entity fee (or discount) would facilitate the growth of small businesses by reducing the cost of international filing and processing. A small entity fee would permit small businesses in all Member States to make greater use of the PCT system. Increasing the PCT system's accessibility to small businesses would also help to build support for the PCT and patenting systems internationally. A notice of incompatibility could be provided for those offices whose national law is inconsistent with this proposal.

There is an existing mechanism by which applicants from certain States may obtain filing fee reductions. This mechanism has, unfortunately, been abused by some applicants, sometimes in ways that have had large financial consequences for WIPO.

6. INTEGRATE NATIONAL/INTERNATIONAL PHASES, USE A NATIONAL FIRST ACTION ON THE MERITS FOR PCT SEARCH REPORT, REQUIRE RESPONSE TO NEGATIVE COMMENTS AT THE NATIONAL PHASE

Integration of the national and international phases would reduce duplication of work, make the

international work products a more accurate predictor of national phase outcome and likely enhance the importance of (and therefore quality of) the international search and examination since it would be binding on at least the national/regional Office acting as the ISA/IPEA.

Integration of the national and international phases can be achieved through actual integration or effective integration. Actual integration could be implemented where the selection of an ISA is also a national phase entry in that Office. When the ISA then prepares the international search report and written opinion, it is both the international work product and a national Office action. Effective integration can be implemented by the national/regional Offices requiring, at the time of national phase entry, a complete response to any outstanding negative indications made by the ISA/IPEA.

It further proposed that where a national first action on the merits has been issued in a parent application or family member that the ISA adopt that as the ISR/WO where the claims are the same. This would reduce burden on the ISAs and encourage applicants to file international applications in the best form possible.

The European Patent Office already does this, in the special case where the ISA was ISA/EP or the IPEA was IPEA/EP.

7. [PCT APPLICANT REFERENCE CITATION SYSTEM

Applicants are often aware of the best prior art before they file an application, either their own or a competitor's prior work or as a result of a pre-examination search. The PCT does not currently provide an easy way to bring such prior art to the attention of the examiner, other than providing a detailed write up in the description portion of the application. A simple system could easily be developed, possibly integrated with PCT SAFE. Such a procedure would increase search report quality and promote efficiency in the ISA. The proposed system would be limited to the voluntary submission of prior art documents.]

At OPLF we often cite relevant prior art in the description portion of the application. We assume that the ISA and the IPEA do notice such citations and make use of the citations.

We assume that this item refers to the PCT-SAFE Forms Manager as distinct from the PCT-SAFE Editor. Yes, it seems the Forms Manager would be a good place to add a counterpart to Form 1449 in US practice. The filing package communicated by PCT-SAFE FM (which now includes the Application Body, the Request, the Fee Calculation sheet, and the Validation Log) would additionally communicate the citation file. The citation file would automatically form part of the official file at the IB to be communicated to DO/EOs. The citation file would likewise automatically be communicated to the ISA along with the Search Copy and the search fee.

Preferably the citation file would be "future-proofed" so as to include arbitrary XML data defined in future, for example for the nascent Common Citation Document format.

USPTO could provide leadership in this area by guaranteeing use of the citation file in the US national phase. USPTO would set up workflow so that the citation file, when retrieved by DO/EO/US, would automatically load into the "display references" tab of PAIR and would automatically load into the Examiner's workflow. USPTO would establish by rule that the US Examiner is required to consider each document in the citation file without the requirement of any further action by the applicant such as the filing of an IDS.

USPTO could further provide leadership in this area by setting up parallel rules for an

application that claims benefit under 35 USC section 120 from an international application. USPTO would establish by rule that if an applicant files the citation file in the US application, this will be deemed to be an IDS which the US Examiner is required to consider.

8. MANDATORY RECORDATION OF SEARCH STRATEGY

When performing automated searches of the prior art, examiners prepare a set of search queries to discover the most relevant prior art. The search terms and related logic used are generally preserved in the application file. In order for other offices to make use of a search performed by another office, it would be beneficial for the second office to have access to the search logic used by the first office. For example, an examiner in the second office would not need to repeat the search done by the first examiner. In addition, the examiner in the second office would be able to confirm that a proper search had been performed by the first examiner, thus building confidence and promoting work sharing. Accordingly, not only should it be mandatory for examiners to record search strategy, but such strategy should be made available to other offices.

Imposing such a requirement upon ISAs and IPEAs might give rise to some modest improvement in confidence and reuse of work. By far, however, the measure that would immeasurably improve confidence and reuse would be an adoption by major offices of the “eat your own dog food” approach, discussed with item 10 below.

9. COLLABORATIVE SEARCHING (2 + OFFICES), ELIMINATE SIS

The United States Patent and Trademark Office (USPTO), the European Patent Office (EPO) and the Korean Intellectual Property office (KIPO) have been participating in a Collaborative Search and Examination Pilot involving PCT applications. In this pilot, an examiner from one office is the principal examiner who performs a preliminary search on a PCT application. The search results are then forwarded to examiners in the other two offices (peer examiners) who review the work, supplement it if it is felt necessary, and provide their comments to the principal examiner. The principal examiner then prepares a final search report incorporating the comments of the peer examiners. While this process involves some additional work by the principal examiner, the work performed by the peer examiners is substantially less than they would normally do. Thus, examiners do less work than they normally would in 2/3 of the applications. In addition, at the end of the first phase of the pilot, participating examiners felt that the quality was so high that substantially no additional searching would be needed in the national/regional phase. A procedure modeled on this pilot could be formally developed in the PCT system.

A Supplementary International Search (SIS) system was recently instituted in the PCT system. Use of SIS has been substantially less than hoped for. In fact, at the end of November, 2011, only 98 Supplemental International Searches had been requested worldwide. If a Collaborative Search System is developed, it is envisaged that SIS could be curtailed.

This is an intriguing idea. The best way to do this, it seems to me, is to set up new “searching authority” two-letter codes, each with its own search fee and promised collaborative workflow. Thus for example one could define ISA/3U which would mean that the applicant has selected the USPTO to be the “principal examiner” and is also willing to pay for work by the peer examiners in (say) two other offices.

The RO would transmit the Search Copy and allocated portions of the Search Fee to the three Offices involved. It would be left to the Offices to coordinate their activities as described in item 9. The work product, an ISR and WO, would be marked as having been established by ISA/3U rather than by ISA/US or ISA/EP or ISA/KR.

Each office participating in a collaborative code such as “3U” would set its own fee, and the three fees when added up would be the Search Fee paid by the applicant selecting ISA/3U.

Applicants would thus be free to choose between legacy ISAs and newly created collaborative ISAs such as “3U”.

It is suggested that the same Offices that constitute XN would likely be interested in joining in newly created collaborative ISAs as well, each with its own two-letter code.

10. MANDATORY TOP-UP SEARCHES

The original “DRAFT ROADMAP FOR THE DEVELOPMENT OF THE FUTURE PCT” included as one of its milestones the proposal that “international preliminary examination includes ‘top#up’ searches to find ‘secret prior art’ by July 2011.” While this Roadmap Milestone received significant support in both the MIA and the PCT Working Group, to date it still has not been adopted as a mandatory element of the Chapter II process. “Top-up” searches are already performed by many offices and are seen as a necessary step of examination in order to provide the most complete international stage work product. The adoption of this proposal by all authorities would increase the quality of, the confidence in, and the reusability of the Chapter II work product. As such, “top-up” searches should be made a mandatory part of the Chapter II examination process.

I gather that this mandate would direct itself to IPEAs. The suggestion is that some IPEAs may sometimes not develop product that is “complete” and does not inspire “confidence” and permit “reuse”.

The proposed step is to impose a workflow change requirement upon IPEAs, namely that each IPEA would be required to (at least pretend to) carry out a “top-up” search as part of the work of the IPEA.

It seems to me that imposing workflow and documentation changes (required documentation of search strategy, required top-up searches, required documentation as to quality control measures) is *not* the best way to improve quality of work product, and indeed is unlikely to do so. It is all too easy for an Authority to carry out such measures in the form of “lip service” while the actual quality remains unchanged or even gets worse because the Authority is forced to allocate resources away from actual quality-generating tasks and into documentation or lip-service workflow activities.

The ISA and IPEA whose work is most widely reused, treated with highest confidence, and viewed as having highest quality is EPO. This is also the only Office that “eats its own dog food”. EPO communicates by its own conduct that it trusts its own ISA and IPEA work product, by the simple step of always giving full faith and credit to its own work in the EP regional phase. It is well known around the world that if ISA/EP has found a claim to be patentable, then that claim will be automatically allowed in the EP regional phase. It is thus unsurprising that patent examiners in Offices around the world tend to make substantial reuse of work product from ISA/IPEA/EP.

The best way for USPTO to promote confidence in, and reuse of, IPEA work product (at least from IPEA/US) would be to state publicly that USPTO will henceforth “eat its own dog food”, and then to deliver on this commitment by automatically allowing in the US national phase any

claim treated favorably by ISA/US or IPEA/US. This simple step would do more for reuse of IPEA work product than any number of externally imposed workflow or documentation changes.

If USPTO were to join EPO in “eating its own dog food”, this would bring great pressure to bear upon other Offices providing ISA and IPEA services to follow suit. The practical result would be a substantial improvement in quality and reuse of ISA and IPEA work product.

11. DEVELOPMENT AND IMPLEMENTATION OF THE GLOBAL DOSSIER AND INCORPORATION OF SAID SYSTEM INTO THE PCT

This past year the USPTO proposed the development of a Global Dossier system. This concept, similar to WIPO’s proposed ePCT system, is still in its earliest stages of development with many of the specifics to be finalized as the system’s implementation is established. In general, under the system applicants would file a single application regardless of the number of national patents ultimately sought, and thereafter the movement and duplication of documents would be minimized or even eliminated by the creation of a “one-stop” portal for all stakeholders in the merits of a particular invention. Under the Global Dossier the applicant would be required to file the application specification once and only once. Cross-filing would be facilitated in the system. By menus, the applicant could choose countries or regions in which to cross-file under the Paris or PCT routes, or both, depending on the filing strategy. The exact timing of the cross-filing(s) could be preselected at initial filing. For example, a filer could preselect PCT to be initiated at twelve months, at which time the preselected ISA and RO would be notified electronically by the system, and the required fees would be charged and disbursed.

By incorporation of such a system into the PCT, the filing of applications would be greatly simplified for users. Some examples of the advantages such a system would provide are: allowing for “reference filings” in accordance with the Patent Law Treaty; eliminating the requirements for priority documents; and facilitating centralized national phase application filing.

It is interesting to consider whether some system could be devised which would bring about all of the results hoped for in this item.

Much can be learned from the existing experience of applicants with the DAS (document access service) at WIPO. My impression is that DAS, with enhancements, could probably deliver a significant fraction of the results hoped for here. The applicant would file an application once in an office of first filing. The applicant would then “pull” the application into DAS just as applicants now do for priority applications. The applicant could then ask DAS to communicate the application to an office of second filing, for example under the Paris Convention. Alternatively the applicant could do a one-page “telex filing” with the office of second filing, asking that office to “pull” the application from DAS.

An advantage of this approach is that DAS and the Paris Convention already complement each other. Applicants that do Paris filings are likely to have learned already how to use DAS, and vice versa.

It is noticed that China recently joined DAS. USPTO can further these efforts by encouraging other Offices to join DAS, and by encouraging development of DAS as a way to move towards a “file once” system for global filings.

12. 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

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 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 an ISA or IPEA. This would 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 the national Offices improve reuse of the work done at the international phase. The level of reuse of the international work products could be improved by not replicating the search where there was either a collaborative search or where there was both a main search and a supplementary search.

The proposal is to require each DO/EO to fast-track the examination of a national phase application if the national-phase application presents only claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4) by an ISA or IPEA. In essence this would require all DO/EOs to join the PCT Patent Prosecution Highway.

USPTO already has a similar fast-track approach in 37 CFR section 1.496, where an applicant that presents “only claims meeting the criteria of PCT Article 33(2)-(4)” in the national phase is taken “out of turn for examination”. Unfortunately Rule 496 offers this benefit only in the special case where the ISA was ISA/US.

Whenever it is proposed to “require” any particular action by all DO/EOs by means of a rules change, one must worry whether there might be pushback from one or more Offices.

USPTO could set an example for other DO/EOs by revising Rule 496 to make the fast-track treatment available regardless of the ISA that had been chosen by the applicant in the international phase.

In the same rulemaking proceeding, USPTO could likewise make a similar fast-track status available for *any application* claiming the benefit under 35 USC section 120 (directly or indirectly) from an international application, again tied to the presentation only of “claims meeting the criteria of PCT Article 33(2)-(4)” regardless of the choice of ISA made by the applicant in the international phase.

Having set such an example for other DO/EOs, USPTO could then invite other Offices to follow suit.