
USPTO PCT Task Force Public Hearing

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Users Generally Support Worksharing

- Most important inventions are filed in the IP5 (USPTO, JPO, EPO, SIPO, KIPO)
 - Users would welcome a system where searching efforts are not duplicated in these offices. Indeed, at the recent worksharing forum at the USPTO, Herb Wamsley, Executive Director of IPO, noted that he was not aware of a single IPO user who is not supportive of the goals of worksharing.
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Patent Prosecution Highways are Part of the Solution

- The various Patent Prosecution Highways (PPH) have helped to provide a partial solution for some users in certain technologies. However, timing is an issue.
 - First, one needs to get the case in the office of first filing examined in a timely fashion, so that an allowed case can be used to get expedited examination in the office of second filing.
 - Further, one needs to do this while not impacting patent term strategies which take advantage of the priority year.
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Patent Prosecution Highways are Part of the Solution (cont.)

- Currently, the PPH does not fit into the global patent filing strategy for those entities seeking to file broadly (30-40 jurisdictions or more) and who wish to take advantage of the Paris convention year to maximize patent terms. Such a filing strategy is usually adopted by applicants protecting technologies with a longer life cycle, and those for which commercialization may occur 10 years or more after initial patent application filing (e.g., biotech, agricultural, or pharmaceutical inventions). Generally, such applicants will file an initial provisional patent application, followed by a PCT application at the end of the Paris Convention year, in order to maximize the global patent term, as well as retaining the broadest options for country coverage.
 - These bilateral systems, which require an initial search and examination in the first filing, do not fit as well into these strategies.
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The Perfect Blend?

- However, clearly PPH has been a valuable tool for other kinds of inventions.
 - PCT to date has not achieved the worksharing goals one might have hoped, as PCT search and examination reports have not always been given much consideration in the national phase.
 - Thus, the recently announced pilot PCT/PPH project of the trilateral offices with the prospect of combining PCT and PPH principles for at least the USPTO, EPO and JPO, is viewed very positively.
 - As we understand it, under this pilot, a positive preliminary examination on at least one claim during the PCT international phase would allow an applicant to get PPH treatment in each of the trilateral offices.
 - This has the potential to become a perfect blend of the two international vehicles.
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