

New and Ongoing Initiatives at the United States Patent and Trademark Office



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USPTO Initiatives

- ❖ Patent Initiatives
- ❖ Trademark Initiatives
- ❖ International Initiatives



Patent Initiatives



Patent Initiatives

- ❖ Pendency Reduction
 - Three-Track Patent Processing
 - 1st Action Interview Pilot
 - Prioritizing Patent Applications
 - Revision to Patent Examiner Production System
 - Targeted Examiner Hiring

- ❖ Patents End-to-End

- ❖ KSR Examination Guidelines



Pendency Reduction – Three-Track Patent Processing

- Three-Track Patent Processing Goals:
 - Gives more control on timing of examination to applicants
 - Relies more on the work product of other offices
 - Promotes greater efficiency by allowing the USPTO to deploy its resources to better meet the needs of innovators
- Track 1: Prioritized examination with a goal of 12-month disposition from date of status grant
- Track 2: Traditional examination under the current procedures
- Track 3: Applicant-controlled delay for up to 30 months prior to docketing for examination



Three-Track Patent Processing

Track 1 – Prioritized Examination

- First Office action on the merits (FAOM) within 4 months of status grant
- Final disposition within 12 months of prioritized status being granted
- Upon applicant's request and payment of a "cost recovery" fee
- For applications claiming benefit of a prior foreign filed application, request could only be made upon submission of a copy of a FAOM from the Office of First Filing (OFF) and a U.S. style reply



Three-Track Patent Processing

Track 2 – Traditional Examination

- Examination in accordance with current procedures
- Default if neither Track 1 or 3 is requested
- Amount of Track 1 fee to be set so as to allow the Office to devote/obtain sufficient resources so that prioritization of Track 1 applications will not adversely affect pendency of Track 2 applications
- Applications claiming benefit of a prior foreign filed application, would not be placed in the Track 2 examination queue until a copy of a FAOM from the OFF and a U.S. style reply is received by the USPTO



Three-Track Patent Processing

Track 3 – Delayed Examination

- Applicants may request a PCT-type 30 month delay
 - **Non-continuing applications first filed in the USPTO**
 - Cannot contain a non-publication request
- Upon expiration of the 30-month period, applicants must:
 - Affirmatively request examination
 - Complete any of the fees that were deferred
- Thereafter, the application is treated as a Track 2 application but one that will be acted upon based on the date examination was requested



Three-Track Patent Processing – Flexibility

- Speeding up:
 - Any U.S. first-filed applicant may request Track 1 at any time on payment of the prioritization fee
 - Any non-U.S. first-filed applicant may request Track 1 concurrently or after having submitted to USPTO a copy of the FAOM from the office of first filing and a U.S. style reply
 - USPTO anticipates granting and docketing these requests automatically
 - The request may occur after the FAOM, such as when an appeal to the BPAI is filed



Three-Track Patent Processing – Flexibility (Cont'd)

- Slowing down:
 - A Track 1 applicant may, at any time prior to first action, request transfer to Track 2 or to Track 3 if the application could have requested Track 3 on filing
 - Any non-publication request must be rescinded prior to granting a request for track 3
- Continuing applications and requests for continued examination (RCE):
 - On filing, a continuing application or RCE may request placement in any of the tracks that the parent or prior application could have been placed
 - If cost recovery prioritization is requested the cost recovery fee must be paid again



Three-Track Patent Processing – Expected Outcomes

- Overall pendency would be decreased in four ways:
 - Increased resources in Track 1 would result in increased output
 - Reuse of search and examination work done by other offices would result in greater efficiency
 - Applicants who chose Track 3 because their applications were of questionable value might ultimately not pursue their application in the U.S.
 - Applicants with applications first filed abroad might ultimately not pursue their application in the U.S.



Pendency Reduction – 1st Action Interview Pilot

- Allows participants to conduct an interview with the examiner after reviewing the results of a prior art search conducted by the examiner
- Program recently expanded to include additional technical areas, enhance efficiency, and provide more options to participants
- Benefits include:
 - The ability to advance prosecution of an application
 - Enhanced interaction between applicant and the examiner
 - The opportunity to resolve patentability issues one-on-one with the examiner at the beginning of the prosecution process
 - The opportunity to facilitate possible early allowance



Pendency Reduction – Prioritizing Patent Applications

Project Exchange Pilot (Patent Application Backlog Reduction Stimulus Plan)

- Applicants having two or more pending applications may accelerate one of the applications by abandoning a second unexamined application
- Gives applicants greater control over the processing speed of their applications
- Helps the USPTO prioritize its workload while reducing the backlog of unexamined patent applications
- Recently expanded to permit use by all patent applicants



Pendency Reduction – Prioritizing Patent Applications

Green Technology Pilot Program

- Promotes innovation in “green technologies” through accelerated examination of inventions involving green technology
- Reduces the pendency of applications claiming subject matter which is critical to climate change mitigation
- Accelerates the development and deployment of “green technology”
- Seeks to create jobs in “green” industries
- Promotes U.S. competitiveness in this vital sector
- In May 2010, the Green Technology Pilot Program was revised to allow more categories of technologies to be eligible for expedited processing under the program



Pendency Reduction – Patent Examiner Production System

- Sets the foundation for long-term pendency improvements
- Focuses on quality work up front by increasing production credit for first action and more overall time
 - Increase in customer satisfaction
- Identifies allowable subject matter earlier in prosecution
 - Increase in examiner-initiated interviews
 - Decrease in actions per disposal due to compact prosecution
- Rebalances incentives both internally and externally resulting in decreased rework
- Supports examiner ownership of transferred or inherited cases by providing consistency in production credit
- Increases examiner morale leading to reduced attrition



Pendency Reduction – Targeted Examiner Hiring

- A targeted hiring program was launched to focus on recruiting experienced former examiners and IP professionals
- Seeks individuals with appropriate technology backgrounds who also have previous IP experience for patent examiner positions
 - Previous hiring focused on scientific background and experience
- Experience enables the new employees to become productive quickly
 - Candidate's IP experience results in reduced training time
 - Able to examine applications sooner than a new hire with little or no IP experience



Patents End-to-End (PE2E)

- The USPTO is building a new patent examination information technology system from end to end
- Involves the reengineering of the pre-exam process (including formats used for electronic application submission), the workflow, examination, and publication processes
- Will provide a new core architecture including improved reliability and availability for all automated systems
- Patent applications will be captured in text format, rather than in image format as is currently the case with IFW
- Analytic tools will be applied to the application text, assisting patent applicants in the identification and correction of informalities and assisting patent examiners with the formulation of Office actions



Updated KSR Examination Guidelines

- In 2007, in response to the decision of the U.S. Supreme Court in KSR Int'l Co. v. Teleflex Inc. (KSR), the USPTO issued guidelines concerning the law of obviousness under 35 U.S.C. 103 (2007 KSR Guidelines)
- Those guidelines were updated in light of recent precedential decisions issued by the CAFC (2010 KSR Guidelines)
 - <http://edocket.access.gpo.gov/2010/pdf/2010-21646.pdf>



Updated KSR Examination Guidelines (Cont'd)

- In KSR, the Supreme Court reaffirmed propriety of the Graham v. Deere four point analysis of prior art in determining obviousness:
 - The scope and content of the prior art
 - The difference between the prior art and the claimed invention
 - The level of ordinary skill in the art
 - Secondary considerations of nonobviousness
- Under the 2007 KSR Guidelines, every obviousness rejection, regardless of the rationale or line of reasoning used to formulate the rejection, requires:
 - Appropriate findings of fact
 - A reasoned explanation
 - A legal conclusion of obviousness



Updated KSR Examination Guidelines (Cont'd)

2010 KSR Guidelines

- Reaffirms the 2007 KSR Guidelines
 - i.e., does not replace the 2007 KSR Guidelines
- Summarizes some CAFC decisions concerning obviousness since KSR
 - The technologies and rationales included are those most thoroughly discussed in the decisions issued since 2007
- Provides examples of obvious and nonobvious claims
- Is not a new USPTO policy with respect to obviousness
- Does not identify any new obviousness rationales
- Points out that an examiner may not choose to disregard the Supreme Court's decision in KSR or the associated examiner guidance materials



Trademark Initiatives



Trademark Initiatives

- ❖ Examination Timeliness
- ❖ Excellent Office Action Initiative
- ❖ IT/Automation Initiatives
- ❖ Consistency Initiative



Examination Timeliness

- Trademark pendency is maintained within the target of 2.5-3.5 months while total pendency is better than the 13-month target
 - Currently 3.0 months to First Action
 - Currently 10.2 months to registration (excluding suspensions)
 - Currently 12.2 months to registration (including suspensions)
- To achieve this performance, the USPTO aligns examination capacity with incoming workload via appropriate staffing and judicious use of production incentives
- Trademarks continues to benefit from electronic filings and the development, implementation and continuous enhancement of automation tools



Excellent Office Action Initiative

- Quality initiative to encourage examination excellence
- Developing criteria for “excellence” for particular issues
- Addresses format, writing, search, appropriate use of form paragraphs and evidence
- Office has received input from INTA, AIPLA and is seeking input from IPO and the DC Bar
- Training has been provided to all Trademark examining attorneys on comprehensive excellence
- A pilot incentive award has been implemented to encourage examining attorneys to pursue the highest quality and reach out to users/representatives early in the application process directly by telephone or email



IT / Automation Initiatives

- Trademarks has been directed to:
 - Separate its IT systems from Patent systems
 - Make their computer systems virtual
 - Have a 21st century IT operation
- Goal is for trademark applications to be completely handled electronically end-to-end
- Input has been sought from employees, TPAC, INTA, AIPLA, IPO and bar associations around the country
- More than 200 comments have been received to date
- Currently categorizing and evaluating the comments



Consistency Initiative

- Request for Consistency Review can be made where a substantive or procedural issue has been addressed in a significantly different manner in different cases owned by the applicant
- The initial 2008 Pilot was restricted to those registrations issued in the past year and excluded issues involving identifications of goods and services
- Effective June 23, 2010, the Pilot was extended and expanded
 - Request for Consistency Review (excluding issues involving identifications of goods and services) may include registrations that have issued within the past five years
 - For at least a period of four months, commencing on June 23, 2010, the Office will accept Requests concerning identifications of goods and services



International Initiatives



International Initiatives

❖ Patent Worksharing Initiatives

- Patent Prosecution Highway (PPH)
- Strategic Handling of Applications for Rapid Examination (SHARE)
- PCT Collaboration Pilot

❖ PCT Processing

❖ Common Citation Document



Worksharing – PPH

- Under PPH, when claims are allowed in the Office of First Filing (OFF), a corresponding application with corresponding claims filed in the Office of Second Filing (OSF) may be advanced out of turn
- Allows the OSF to utilize the work-product of the OFF
 - avoids duplication of work in the OSF
 - expedites the examination process in the OSF
- All claims in the OSF application must “sufficiently correspond” to the allowable claims in the OFF application



Worksharing – PPH (Cont'd)

Qualifying Applications:

- Current PPH Programs, generally speaking:
 - Paris priority applications
 - PCT Bridge filings
 - Certain non-binding work product, e.g., EPO's Extended European Search Report

- PCT-PPH Pilot
 - Launched January 29, 2010 among Trilateral Offices
 - Positive WO/ISA, WO/IPEA or IPER
 - USPTO-KIPO pilot launched June 2010
 - Plan to launch pilots with other ISAs/IPERs in near future



Worksharing – PPH (Cont'd)

- Provides quicker patentability determinations in multiple jurisdictions
- Decreases costs of prosecution
- Can reduce pendency
- USPTO eliminated the PPH petition fee (effective May 25, 2010)
- FAQs posted on USPTO Website



Worksharing – PPH (Cont'd)

- USPTO Allowance Rates
 - PPH cases: 95%
 - PCT PPH cases: 100%
 - Non-PPH cases: 44%
- USPTO actions per disposal
 - PPH cases: 1.88
 - PCT PPH cases: 1.17
 - Non-PPH cases: 2.3



Worksharing – SHARE (Proposed)

- Where corresponding applications are filed in multiple offices, the USPTO will prioritize and balance workloads to maximize the re-use of foreign search and examination results, and minimize duplication of examination work done in other IP offices
- SHARE, unlike the PPH, does not depend on an applicant's request to reutilize work
 - Its potential is not limited in the same way that PPH is limited as an applicant-driven process
- Increases examination efficiency
- Reduces pendency
- Initiative to optimize worksharing on a global scale



Worksharing – PCT Collaboration Pilot

- Pilot project aimed at testing the feasibility and the potential of collaborative work between examiners of different offices in the international phase
- Small scale pilot between EPO, KIPO and USPTO
- Designed for six examiners per Office with each acting as:
 - The first examiner on two PCT applications filed with his/her Office as ISA
 - Peer examiner on two applications from each of the other Offices



Worksharing – PCT Collaboration Pilot (Cont'd)

PCT Collaboration Pilot Procedure, in general:

- The first examiner proposed to the peer examiners a provisional ISR and WOISA, as well as a record of search strategy
- The peer examiners either commented on or complemented as appropriate this provisional work
 - The complement to the first examiner's search was either a focused search on particular aspects or a full search
- After reception of the peer examiners' feedback, the first examiner issued a final ISR and WO-ISA encompassing the peer examiners' contributions
- The communication between examiners took place mainly via email and telephone when required



Worksharing – PCT Collaboration Pilot (Cont'd)

PCT Collaboration Pilot Results and Recommendations

- Quality: Examiners indicated that the collaboration resulted in more complete final products
 - Sometimes additional citations were included
 - Sometimes no additional citations were included, but discussions provided confidence to examiners about results
- Efficiency: Examiners indicated that, in general, little or no additional investment would be required in regional / national phase
- Participating examiners recommended that a 2nd phase pilot be established with focus on improving the methodology and developing IT tools



PCT Processing

- The USPTO is working to raise its PCT processing and products to world-class levels
- For new PCT applications, averaging 13 days from receipt to transmission of record copy to WIPO with 88% of record copies being received within 4 weeks
- 81% of International Search Reports are issued within 16 months from priority and 91% are issued within 18 months from priority
- Currently remapping entire Chapter II process in order to improve timeliness of international preliminary examination reports
- Recently modified the quality measures of contractor-prepared PCT work products to be more aligned with those of U.S. national applications to maximize the potential for re-use of the international search and written opinion in the national phase



Common Citation Document

- In June 2009, the Industry Trilateral (AIPLA, BusinessEurope, IPO, JIPA) recommended the use of a Common Citation Document (CCD) with the following details:
 - CCD format to be based on that of the PCT ISA/210 search report
 - CCD to be used by the three Trilateral Offices, applicants, and third parties to cite relevant prior art documents
 - A single repository to be developed for the CCDs for each patent family



Common Citation Document (Cont'd)

- In June 2010, the Trilateral Offices agreed to implement an initial pilot program with a target implementation date of November 2010
 - For purposes of the initial pilot program, the use of the CCD will be limited to examiners from the three Trilateral Offices
 - EPO to create and host a **non-public** prototype user interface as the common work sharing platform by leveraging EPO's existing esp@cenet system
 - Examiners will be able to view the CCD data cited from each Office in a "living" document format
 - Examiners will review the CCD data for the counterpart foreign application, if available at the time of examination of the corresponding national application



Common Citation Document (Cont'd)

- Up to a total of approximately 80-100 applications, which have been commonly filed at all three Trilateral Offices and spanning each of the 8 IPC disciplines (“eligible applications”), will be selected for the pilot
- Each of the three Trilateral Offices will be the office of first examination for a portion of the commonly filed applications
- The three Trilateral Offices will work together to identify the eligible applications for the pilot



Thank You

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