

**UNITED STATES
PATENT AND TRADEMARK OFFICE**

uspto

Patent Public Advisory Committee Quarterly Meeting

International Update

Mark Powell

Deputy Commissioner for International Patent Cooperation

Michael Neas

Deputy Director, International Patent Legal Administration

November 8, 2018

UNITED STATES
PATENT AND TRADEMARK OFFICE



USPTO-Hosted Information Communication Technology (ICT) Roadmap Meeting

UNITED STATES
PATENT AND TRADEMARK OFFICE



6th ICT Roadmap Meeting

- Hosted by USPTO at WIPO
 - October 11-12, 2018
 - 26 Participating IP Offices
- Topics of Discussion and Future Collaboration Areas included:
 - Improving mechanisms of data exchange and dissemination between IPOs and to the public
 - Identifying transformative technologies that benefit patent business processes



Meeting Outcomes

- Identified areas of possible collaboration between IP Offices
- Discussions on standardization of data exchange mechanisms and format
 - Application Programming Interfaces (APIs)
 - XML conversion

Access to Relevant Prior Art Initiative

UNITED STATES
PATENT AND TRADEMARK OFFICE



Initiative Objectives

- Leveraging electronic resources to retrieve information (e.g., prior art, search reports, etc.) from relevant sources (e.g., related U.S. applications, counterpart foreign and PCT applications)
- Automatically import information into the file wrapper of a U.S. patent application under examination at the earliest point
 - Potentially reduce applicant's burden under the duty of disclosure

Access to Relevant Prior Art: Phase 1

- Automatically imports references from immediate U.S. parent applications into pending U.S. applications
- New automated tool for examiners developed to provide a master reference list and enhanced searching and filtering functionality

Access to Relevant Prior Art: Phase 1

- Began November 1, 2018
- Initial implementation is a targeted release and will not be a corps-wide release
 - November 1: Released to Art Unit 2131
 - January 1, 2019: Release to Art Units 1616, 1731, 2431, 2675, 2879, 2922, 3635, and 3753
- Subsequent phases of the project will focus on importing from additional sources, such as counterpart foreign and PCT applications

Prior Art Access Contacts

E-mail: PriorArtAccess@USPTO.gov

Website: <https://www.uspto.gov/patents-getting-started/access-prior-art-project>

Michael Neas

Deputy Director, International Patent Legal Administration

571-272-3289

Michael.Neas@USPTO.gov

Jessica Patterson

Director, International Outreach and Administration

571-272-8828

Jessica.Patterson@USPTO.gov



IP5 PCT Collaborative Search & Examination Pilot Update

UNITED STATES
PATENT AND TRADEMARK OFFICE



IP5 PCT CS&E Pilot Overview

- Began July 1, 2018 by the IP5 Offices
- Explores a collaborative approach to international searches under the PCT with two goals
 - Assess expected efficiency gains
 - Determine the users' interest for this approach

Concept

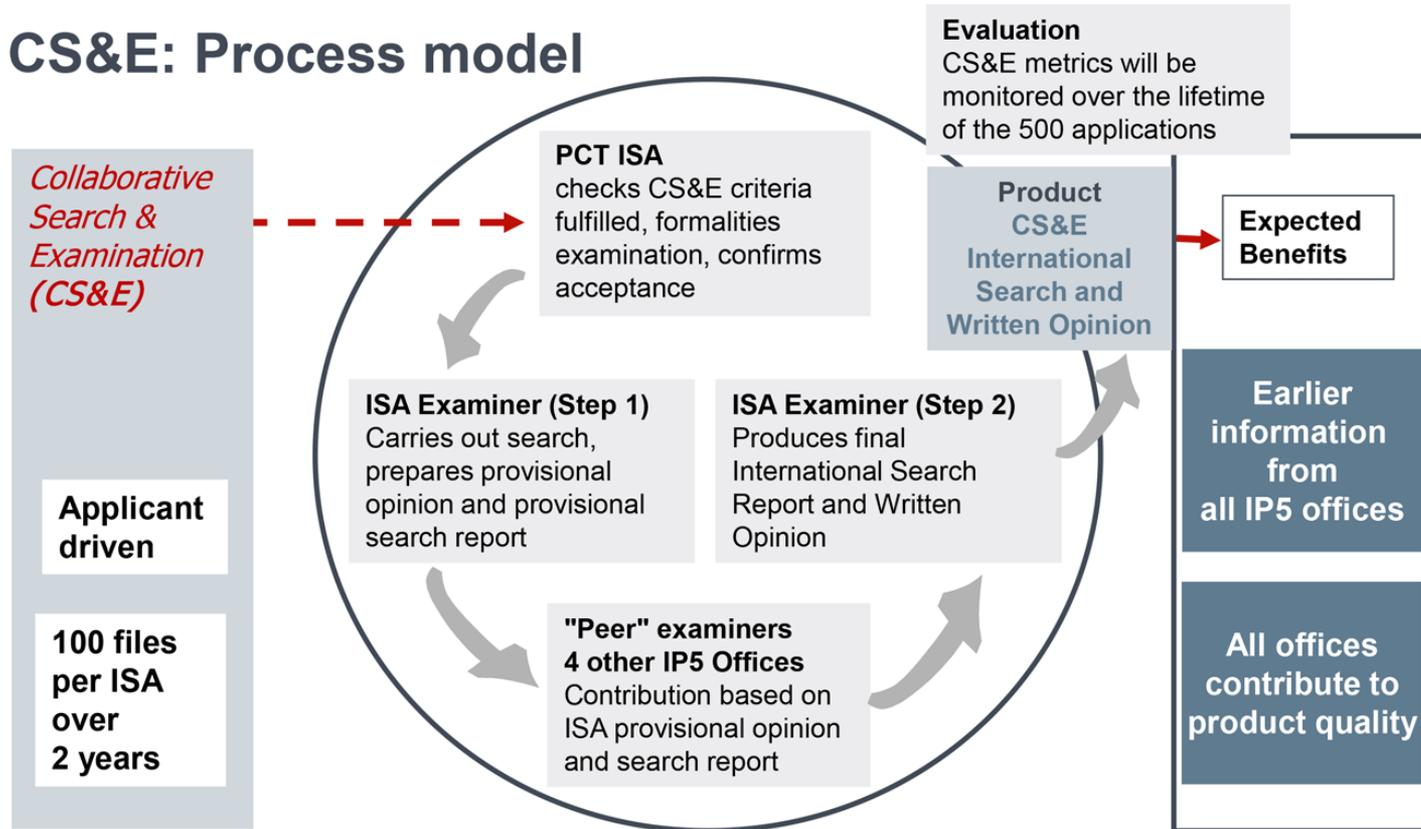
- Collaboration of examiners from different International Authorities in different regions and with different working languages on one international application
- International Search Report (ISR) and Written Opinion (WO) under PCT Chapter I remains the opinion of the chosen International Search Authority (ISA), but is based on contributions from all participating Offices

Purpose of IP5 PCT CS&E

- Better test user interest, operational and quality standards, and an electronic collaboration tool or platform
- Two previous pilots provided information and allowed the USPTO to refine the operational working model
- Determine what effect collaboration has on the quality of the work products and subsequent effects on the national phase

IP5 PCT CS&E Process Model

CS&E: Process model



IP5 PCT CS&E Pilot Statistics

- 61 applications filed with Receiving Office (RO)/US accepted into pilot
 - 31 for ISA/US
 - 20 ISA/EP*
 - 1 ISA/JP
 - 9 ISA/KR
- 121 total applications accepted by IP5 ISAs
 - JP – 3
 - CN – 28
 - KR – 18
 - US – 32
 - EP – 40*

*EPO has filled its quota of English applications

IP5 PCT CS&E Pilot Statistics

CS&E Requests as Main ISA (ISA/US)

40 Total Requests

32 Requests Accepted

Receiving Office

38 RO/US

2 RO/IB

13 Provisional SR
Uploaded

3 Requests Denied

miscellaneous electrical
technologies
7 Computers (hardware &
software)
4 Communications
3 Surgery
1 Business Methods
1 Biotechnology

Technical Fields:

9 Chemical
7 Mechanical
7 Physical Sciences and other
miscellaneous electrical
technologies
7 Computers (hardware &
software)
4 Communications
3 Surgery
1 Business Methods
1 Biotechnology

IP5 PCT CS&E Contacts

Dan Hunter

Director, International Work Sharing Planning &
Implementation

571-272-8050

Daniel.Hunter@USPTO.gov



