

AIPLA

American Intellectual Property Law Association

Serving America's Legal and Creative Community

INDUSTRY IP5 COMMENT ON PCT/PPH

IP5/Users Meeting

Porticcio, France

Tuesday, June 5, 2012

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AIPLA

REASONS FOR PARTICIPATING GENERALLY

❖ Cost

- ❖ Possible reduced cost of prosecution (US Study - \$3,000-\$5,000 per application and possibly higher)

❖ Quality

- ❖ Quality of Examination may be improved




❖ Speed

- ❖ Examination is accelerated in some Offices

❖ Strategy

- ❖ Permits rapid grant of claims allowed in OFF and filing of continuations for broader claims if possible.
- ❖ Consistency in Claims and Prosecution World Wide

COMPARABLE ADVANTAGES IN SOME COUNTRIES FOR PCT/PPH* (January – June 2011) *from PPH portal site

	Office of Filing		
	 JP	 US	 CA
Grant Rate {%	93.6 (58.1)	96^{*1*2} (47)	100 (64.6)
First Action Allowance Rate {%}	63.0 (9.3)	20^{*1*5} (15.9)	60^{*5} (4.9)
Average Pendency from PPH Request to First Office Action {months}	1.9 (27.3)	3.5^{*1} (27.8)	1.5 (23.2)
Average Pendency from PPH Request to Final Decision {months}	3.5 (33.4)	5.5^{*1} (33.5)	1.8 (42.4)
Average Number of Office Actions per PPH Application	0.47 (1.12)	1.61^{*1} (2.49)	0.4 (1.6)

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IIP5 Consideration of PCT/PPH

- ❖ Brief discussion of PCT/PPH in IIP5 Meeting
- ❖ IIP5 Delegations report that some member industries use PCT/PPH while other member industries have not.
 - ❖ Possibly due to lack of knowledge of PCT/PPH
- ❖ Agreement that study and report on use of PCT/PPH by IIP5 participants would be valuable
- ❖ Agreement on use of IPER/WO as a basis for PPH
 - ❖ IIP5 has confidence in quality of IP5 Office workproduct
 - ❖ IIP5 is concerned with reliance of workproduct of some other ISA's

IIP5 Consideration of PCT/PPH

- ❖ Perception of Quality Remains a Significant Issue
 - ❖ Concern with quality of some ISA workproduct
 - ❖ Concern with the quality of the second office workproduct
 - ❖ Need for common and comprehensive metrics for quality
 - ❖ Need for development and sharing of search strategy records
 - ❖ Need for greater transparency for quality and search strategy data to permit user evaluation