

Proposal for the IP5 Global Dossier Active Phase Assumptions and Procedure

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- **The Four Basic Requirements**
 - Same earliest priority or filing date
 - *A corresponding national application filed with another IP5 Office*
 - *A corresponding PCT international application for which one of the IP5 Offices has been ISA and/or IPEA.*
 - At least one claim indicated to be patentable/allowable
 - *Determined as novel, inventive and industrially applicable*
 - All claims in the Office of Later Examination (OLE) application sufficiently correspond to the patentable/allowable claims in the Office of Earlier Examination (OEE)
 - *Same or a similar scope or narrower in scope*
 - *No new/different category of claims than those indicated to be patentable/allowable*
 - Substantive examination of the OLE application has **not** begun.

- ***The Five Basic Deliverables***

- 1) A **Request** made using a common request form
- 2) A **Claim Correspondence Table** or a Declaration of Claim Correspondence between applications in OEE and OLE
- 3) A **Copy of all Office Actions** or Latest Action of Claims by OEE or latest PCT work product (WO/ISA; WO/IPEA or IPER) **& translation**
- 4) A **Copy of Allowed Claims** in the OEE **& translation**
- 5) **Copies of the Cited Documents** (except patent documents)

➤ Current Channel:

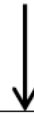
- *Local representative obtains allowance in OEE and decides to use PPH in OLEs*
- *Local representative in OEE assembles and distributes to Local representatives in OLEs copies of (1) most recent action, (2) cited art, and (3) corresponding claim chart*
 - *GD may be accessed passively by OLE to obtain documents*
- *If no FOAM, Local representative files PPH request in OLE*
 - *OEE and local representative in OEE are not involved*

EPO practitioner files app.



OEE (EPO) allows
application

US practitioner files PPH request



OLE
(USPTO)

➤ Prosecution Assumptions for PPH Pilot:

- *The first application is filed in the OEE at most one year prior to filing of a priority application (Paris or PCT) in OLEs*
- *Examination and allowance is obtained in the OEE prior to the start of examination in the OLE*
- *A qualified Local Rep exists for each application in each Office at the time of a PPH request*

➤ Operational Assumptions for PPH Pilot:

- *The OEE will not serve as a conduit for any PPH request to an OLE due to OLE concerns with work-flow, file wrapper integrity and authentication*
- *The OEE Local Rep will not be authorized to interact with an OLE and only an OLE Local Rep can interact with an OLE for a PPH request due to concerns with work-flow, file wrapper integrity, and authentication in the OLE*
- *The OLE Local Rep and OEE Local Rep must communicate with each other to provide PPH data and documents*
- *The OLE Local Rep must provide essential data (OEE and OLE serial numbers) and documents (Claim Correspondence Chart) to the OLE to initiate a PPH request*

➤ Assumptions for Global Dossier:

- *The same data supporting Global Dossier is available to all IP5 Offices, but interfaces to access the data may differ*
- *Prosecution and most prior art documents will be available in Global Dossier using application serial numbers*
 - Allowed claims and translation
 - Most recent Office Action and translation
- *Offices and Users obtain data and documents by PULLING from GD – there is no PUSHING from other Offices or Local Reps*

➤ Assumptions for Global Dossier (cont'd):

- *Enriched Citation Information will be available for all IP5 Offices in the near future*
- *Big Data Extraction will be available to identify and pull documents and data of interest*
 - ISSUE: Can a Claim Correspondence Table for claims allowed by an OEE and claims pending in an OLE be available via GD using Big Data Extraction?
 - SOLUTION: first step, requires identification of XML data in each Office to determine feasibility

➤ Operational Issues for a PPH Pilot Using GD:

- *Can a STANDARDIZED IP5 Form in structured text format be created for an OEE Local Rep to identify the OEE application, send to the OLE Local Rep, and have the form filed and processed at the OLE so relevant prosecution and prior art documents can be accessed by the OLE from GD? Using Big Data Extraction?*
- *If no STANDARDIZED IP5 Form can be created, can the data in an OEE form be identified for reliable access and use by an OEE to access GD data using XML?*

- Operational Issues for a PPH Pilot Using GD (cont'd):
- *Can the USPTO pilot to have users pre-populate USPTO IDS forms with GD data be applied to the PPH processes where the USPTO is OLE, permitting identification of (1) a relevant OEE application, (2) a most recent OEE Office Action prior to allowance and (3) cited prior art in the OEE to be entered into USPTO forms?*
 - *A US Local Rep would have to initiate the PPH and set up a record in the USPTO file wrapper, perhaps by filing a simple request*
 - *The GD data would be available to the USPTO as OLE PULLING from the Global Dossier to pre-populate a form or record*
 - *The US Local Rep would still have to file a claim correspondence chart with the USPTO for consideration in a PPH request*

➤ Advantages of a PPH Pilot Using GD:

- *Demonstrates application to all IP5 offices once pre-population and communication capability is proven*
- *Greater relevance than the IDS proposal*

➤ Disadvantages of the PPH Pilot Using GD:

- *Local Reps must be involved at both ends*
 - *OEE Local Rep to fill out forms and transmit to the OLE Rep*
 - *OEE Local Rep to prepare Claim Correspondence Table and transmit to OLE Rep or OLE Rep to prepare Claim Correspondence Table – in both cases to file with OLE*
- *XML capability is needed but not proven*

➤ Requirements for Progress on Active Phase PPH Pilot

- *JPO to demonstrate XML capability (current PPH documents are images, rather than xml or meta-data format)*
- *USPTO to demonstrate data population capability for IDS*
- *Other Offices to demonstrate data population capability for other forms*

Glossary of Terms:

OEE: Office of Earlier Examination

OLE: Office of Later Examination

PPH: Patent Prosecution Highway

FOAM: First Office Action on the Merits

PCT: Patent Cooperation Treaty

ISA: International Search Authority of the PCT

IPEA: International Preliminary Examination Authority of the PCT

IPER: International Preliminary Examination Report for a PCT
Application

Thank You!