

Work Sharing and Quality

Proposal for the IP5 Global Dossier Active Phase: PPH Using the Passive GD and CCD

2016 Meeting of IP5 Industry
February 3-4, 2016

USPTO Headquarters
Global Intellectual Property Academy (GIPA)
Alexandria, VA



Agreed Record of Discussion between IP5 Heads of Office – Geneva 23 September 2013

- IP5/PPH programme
 - will cover both PCT and Paris Route applications and its implementation
 - Will be based on the principles set out in an Annex.
- **The Annex Establishes:**
 - **Four Basic Requirements and**
 - **Five Basic Deliverables**

● **The Annex 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 OLE application sufficiently correspond to the patentable/allowable claims in the 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 Annex 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 Patentable Claims** in the OEE **& translation**
- 5) **Copies of the Cited Documents** (except patent documents)

➤ **Global Dossier *Passive* Component Provides:**

- A Copy of Claims Allowed by the OEE
- A Translation of Allowable Claims in the Language of the OLE
- A Copy of All Communications and the Most Recent Office Communication in the OEE Prior to Allowance
- A Translation of the Communications into the language of the OLE

➤ Global Dossier *Passive* Component Does *NOT* Provide:

➤ A Claim Correspondence Table

➤ A Basis for Determining that Examination in the OLE is NOT About to Begin

➤ Copies of Prior Art

➤ **HOWEVER:**

➤ Common Citation Document (CCD) Does Provide

➤ *Patent and Office Published Prior Art*

➤ *Translations of Prior Art*

➤ *BUT – NO non-Patent Prior Art*

➤ *A Three-Part Common Request Form:
Satisfying the Four Basic Requirements and
the Five Basic Deliverables*

➤ Part 1 – Basic OLE Application Information

- Identification of OEE Application – Number & Filing Date
- Identification of OEE Applicant & Inventor
- Identification of common filing date and priority date for OEE and OLE
- Selection of which of four IP5 Offices are an OLE to receive the PPH Request
- Identification of OLE Applications and Applicants
- Identification of Applicant Representative and contact information for each OLE Office

➤ Part 2 – Four Basic Requirements – for **each** of the selected IP5 Offices a check box:

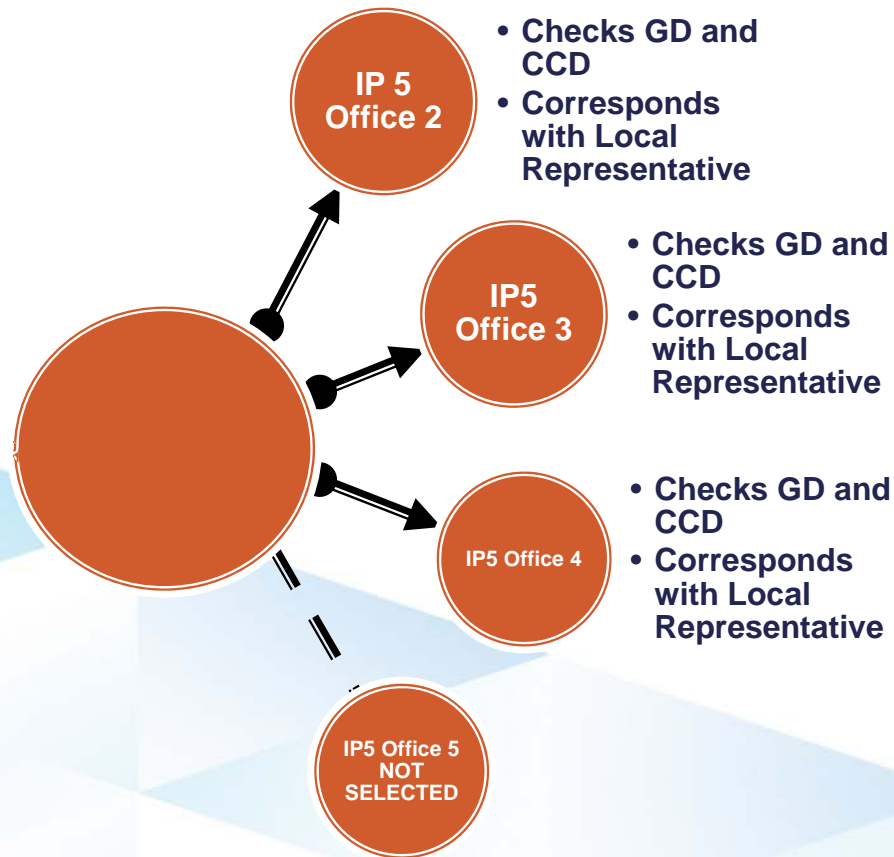
- ✓ Certifying earliest priority or filing date is same for OEE and OLE
- ✓ Certifying at least one claim in OEE is indicated to be patentable/allowable
- ✓ Certifying all claims in the OLE application sufficiently correspond to the patentable/allowable claims in the OEE
- ✓ Certifying substantive examination of the OLE application has **not** begun for each Selected Office.

➤ Part 3 – Five Basic Deliverables: for each of the selected IP5 Offices a check box stating:

- ✓ This is a **Request** to use IP5 PPH for identified IP5 Offices
- ✓ This is a Declaration of Claim Correspondence between applications in OEE and OLE, and a Claim Correspondence Table, as required
 - ✓ *Attached is a **Claim Correspondence Table***
- ✓ This is a **Certification** that **Global Dossier Passive Component contains** 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*
- ✓ This is a **Certification** that **Global Dossier Passive Component contains a Copy of Patentable Claims** in the OEE & *translation*
- ✓ This is a **Certification** that the **Common Citation Document contains ALL Copies of the Cited Documents & translations (except non-patent Prior Art as note below)**
 - 1) *Attached is a **Listing and Copies of Non-Patent Prior Art (unless OEE to OLE disclosure avoids copyright issues)***

➤ Procedure for Requesting IP5 PPH via the Active Global Dossier:

- 1) The Common Request Form would be Submitted by Applicant to the IP5 Office that is OEE
- 2) IP5 Office that is OEE would forward the Common Request Form to the IP5 Offices identified in the form.
- 3) The Identified IP5 Offices would review the form for completeness and accuracy and forward form to local representative for OLE.
- 4) The Identified IP5 Offices would determine if the Certifications are correct , including availability on the Global Dossier Passive Component and the Common Citation Document of the relevant documents and translations.
- 5) The Identified IP5 Offices would determine if the asserted claim correspondence based on any table meets the program requirements.
- 6) The completeness of the listing and copies of Non-Patent Prior Art is reviewed.
- 7) Errors or omissions are identified to the local representative.



THANK YOU FOR YOUR CONSIDERATION
OF THIS PROPOSAL

