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.
FLOW OF SINGLE REQUEST FORM OEE TO SELECTED OLE OFFICES

- IP 5 Office 2
  - Checks GD and CCD
  - Corresponds with Local Representative

- IP 5 Office 3
  - Checks GD and CCD
  - Corresponds with Local Representative

- IP 5 Office 4
  - Checks GD and CCD
  - Corresponds with Local Representative

- IP 5 Office 5
  - NOT SELECTED
THANK YOU FOR YOUR CONSIDERATION OF THIS PROPOSAL