

2022 Virtual PCT Training Seminar

# Session 15

Making Use of PCT-PPH, and Comparison with Track I and AE

Friday, March 18, 2022



## Before We Get Started...

 **Recording**

A recording of this session will be posted to the Attendee Hub after the live session ends.

 **Questions**

Please enter questions in the Q&A feature in the Zoom menu.

 **Social**

Follow us on LinkedIn or go to SLW Institute on slwip.com to see upcoming and on demand webinars.

## Disclaimer

This is not legal advice. Reading these slides or attending this webinar or viewing a recording does not make you my client and does not make me your lawyer. This is an educational program. If you want legal advice, consult competent counsel who can learn your detailed situation and can give you advice about your situation.



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## A Word about Your Presenter

Yes I am often a consultant for WIPO, teaching this and many other PCT programs, live and recorded ...

in person and via webinar ...

I am also an opinionated private practitioner

Please join me in recognizing that I wear two hats from time to time during the webinar

When you hear me expressing opinions, then I am not speaking on behalf of WIPO, and instead I am merely speaking as a private practitioner



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## How Can You Ask Questions?

- Ask your questions in the “questions” box, not the chat box
- I posted answers for questions from the first four webinars in my blog (Ant-Like Persistence blog)

## Helpful PCT Resources

- WIPO’s PCT Distance Learning Course
- WIPO video series (Matthias Reischle)
- WIPO’s PCT Applicant’s Guide
- The PCT listserv (email discussion group)
- PCT section of the *Ant-Like Persistence* blog

## Helpful PCT Resources

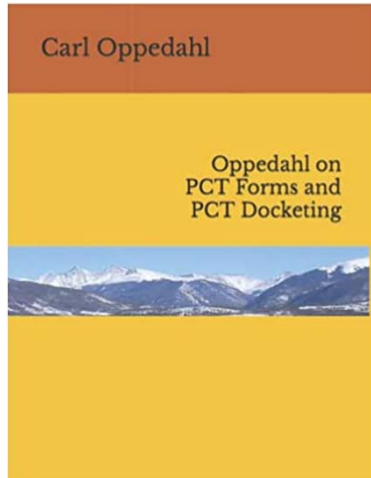
- WIPO's PCT Help Desk
  - +41 22 338 83 38
- USPTO's PCT Help Desk
  - +1 671 272 4300
- Make sure you are subscribed to WIPO's *PCT Newsletter*

## Upcoming ePCT Webinars That I Will Be Presenting

- Intro to ePCT, why ePCT is important, getting a user ID and password, setting up 2FA
- Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts
- Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work
- Shared address books, collaborative workflow, sharing with clients, sharing with outside counsel
- Getting to know your ePCT workbench, portfolios, office profiles, cloning, ePCT actions
- Getting pending PCT applications into your workbench, going back to January 1, 2009, archiving old applications
- Filing a new US PCT application in RO/US using ePCT
- Filing a new US PCT application in RO/IB using ePCT
- ePCT actions and communications with the IB
- External signatures and PCT declarations
- Sequence listings and ePCT
- Using ePCT to e-file in ISAs and IPEAs, filing Demands
- Doing 92bis changes
- Docketing of PCT applications and making use of ePCT notifications
- Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents

***Don't want to miss them? Subscribe to the PCT listserv or subscribe to my blog (or both).***

## Helpful PCT Resources



- The fifty PCT forms that you are most likely to encounter
- Which dockets to set or clear when these forms arrive
- What dates and check boxes to check on the forms
- Warning signs that you can detect from the forms
- Order through your local bookstore
- Also available at [shop.oppedahl.com](http://shop.oppedahl.com)
- Also available on Amazon
- ISBN-13 : 979-8766914655
- Paperback : 218 pages
- A bargain at USD 89

## Summarizing Some of the Fast-Track Initiatives

- AE (Accelerated Exam)
- Track I
- PPH (Patent Prosecution Highway)

## Accelerated Examination

In August of 2006, with much fanfare, USPTO announced its Accelerated Examination program.

The AE program has had only very limited success from USPTO's point of view, and many experienced practitioners consider AE tantamount to legal malpractice.

AE nonetheless remains available even now for use by applicants.

## AE

As an inducement to filers to participate in AE, USPTO committed that it would conclude all prosecution (with an allowance or a final rejection) within 12 months of filing.

## AE Search

Search report and search statement. The filer must carry out an extremely detailed prior-art search.

- USPTO has publicly admitted that the ordinary search that an Examiner would carry out in the examination of a normal (non-AE) application would not satisfy the requirements for an AE search.
- USPTO has also stated that a foreign search (for example in a PCT application or in a priority application filed in a foreign patent office) would not satisfy the requirements of an AE search.

## AE Search

Having carried out the search, the filer must provide a signed search statement promising that all required databases and resources were searched and must (effectively) represent that no significant reference was overlooked in the search.

The signer of such a search statement may reasonably expect to be deposed at length if the patent is ever litigated.

# Accelerated Examination Support Document (AESD)

The filer must pick and choose among the references found in the AE search, picking out the “most important” references. The selected references must then be applied one by one, and in combination, against each claim in the application, and against each limitation of each claim. In a typical case with (say) thirty claims, and (say) twenty “most important” references, some six hundred combinations must be considered and discussed. The filer must construct a *prima facie* case for rejection of each claim as to each reference being discussed and must then explain why the claim is nonetheless patentable even in view of the *prima facie* case for rejection.

## AESD

One way to characterize the work required in preparing the AESD is that the filer must start by writing the first Office Action for the Examiner, and then responding to that first Office Action.



## AESD Support Statement

In the AESD, the filer is required to provide a detailed statement of support as to each claim limitation, showing exactly where each such limitation may be found in the specification.

In contrast, in a normal (non-AE) application, such a support statement is only required if and when it turns out to be necessary to file an appeal brief to the Patent Trial and Appeal Board. Such a support statement is likely to make a big difference in litigation, probably narrowly limiting the scope and range of interpretation of particular claim terms.

## Why So Few Have Used AE?

### *Cost.*

Practitioners who have actually filed AE cases have reported that the additional cost to file AE (above and beyond normal preparation and filing costs) is ten or twenty thousand dollars or more. I have estimated that AE could easily double or triple the cost of a patent filing.

## Why So Few Have Used AE?

*Weakening of any granted patent.*

Litigators rub their hands together with glee when they contemplate representation of an infringer where the patent asserted is an AE patent. The number and range of lines of attack are such that it is easy to imagine invalidating a patent earlier in a case, and at lower cost, than in an otherwise comparable non-AE case.

## Why So Few Have Used AE?

*Malpractice risk.*

What practitioner would want to apply his or her signature to an AE search statement? What practitioner would want to apply his or her signature to an AESD? Imagine the inequitable-conduct charges that could be alleged against the signer, regardless of whether the signer did not actually do anything wrong. Imagine the discovery (not only as to documents but also in deposition) and the trial testimony that would be demanded of the signer.

## Why So Few Have Used AE?

### *Loss of appeal options.*

To get AE status, the filer must promise in advance that on appeal to the PTAB, the filer will not argue patentability of a dependent claim separately from the patentability of the independent claim from which it depends. Stated differently, the filer must concede in advance that all claims stand and fall together on appeal.

## Why So Few Have Used AE?

### *Limits on claim count.*

The application is not permitted to have, or to be amended to have, more than three independent claims, nor more than twenty total claims. The filer is not permitted to use multiple dependent claims.

## Why So Few Have Used AE?

*Loss of ability to purchase extensions of time.*

If the filer purchases an extension of time to respond to any Office Action, the case loses AE status. The AESD and search results remain in the application file, however, available to the Examiner and to any adversary in litigation.

## Why So Few Have Used AE?

*Vulnerability to unreasonable or unjustified restriction requirements.*

The filer must promise in advance not to traverse any restriction requirement. The Examiner can thus make any restriction requirement, no matter how unreasonable or unjustified, secure in the knowledge that there will be no review of the restriction requirement by any higher authority.

## Why So Few Have Used AE?

*Consequences of a denial of the AE petition.*

About one-third of all AE petitions have been denied. When this happens, the application moves forward as a non-AE application. The AESD and search results remain in the application file. The Examiner will draw upon these documents in examining the application, and an adversary in litigation will be able to make use of the content of these documents and any party admissions therein.

## Track I

Now we turn to a summary of Track I.

## Track I

With Track I, the applicant pays \$4130 to get “prioritized” examination.  
(Cheaper for small and micro entity.)

The up-front fee cost of \$4130 has two components:

- \$4000 track-I fee
- \$130 petition fee

## Claim Limits for Track I

The filer is limited to four independent claims.

The filer is limited to thirty total claims.

The filer is not permitted to use multiple dependent claims.

## Track I Requirements

Track I is not available for any already-pending case. If a filer has an already pending case, then to get its subject matter onto Track I would require filing a continuation application.

## Losing Track-I Status

Any of a long list of events triggers a loss of Track-I status. These events include:

- Filing of a Notice of Appeal
- Filing of an RCE
- Petitioning for an extension of time to respond to an Office Action
- Amending to add a fifth independent claim
- Amending to add a thirty-first total claim
- Amending to add a multiple-dependent claim

## A Chief Drawback with Track I

You are spending \$4130 at a time when you do not yet know whether or not your invention is even patentable.

## Patent Prosecution Highway

- Now we turn to PCT-PPH
- We discuss Best Practices



## PPH Results

Allowance rate typically 90% as compared with 50-55% for non-PPH cases.  
Number of office actions to disposition reduced from around 2½ to around 1½.  
Several factors may help to explain these results.

## PCT-PPH (Patent Cooperation Treaty PPH)

The whole thing can be done in a single patent application if desired.  
The trigger for PCT-PPH benefits can be a mere Written Opinion.

## When Do You Get Your WO?

Recall that you get your WO within:

- Three months of ISA's receipt of Search Copy, or
- Nine months of the priority date,

... whichever is later.

## Without Even Trying...

Many applicants can get PCT-PPH benefits even if they had no intention of trying to get such benefits. There is no extra cost beyond what would already be spent for a PCT filing.

## Requirements for PCT-PPH

The ISA-WO or IPEA-WO or IPRP-II must come from an “approved” ISA or IPEA (AT, AU, CA, CN, EP, ES, FI, IL, JP, KR, RU, SG, SE, UK, US, XP, AT, AU, CA, CN, EP, ES, FI, IL, JP, KR, RU, SG, SE, UK, US, XP).

The ISA-WO or IPEA-WO or IPRP-II must treat at least one claim favorably.

The US case must be connected, no matter how remotely, by Section 119 and/or Section 120 and/or Paris Article 4 relationships, with the IA (international application) containing the WO or IPRP-II.

The claims must “sufficiently correspond”.

## Identifying Eligible Cases for PCT-PPH?

You may have PCT-PPH-eligible cases right now, and maybe you don't even know it. Go back and look at every old PCT application that you ever filed. Look at every Written Opinion. Go back and look at every old IPRP-II. You might find some favorably treated claims.

## Variety of Possible “Gaining” Cases

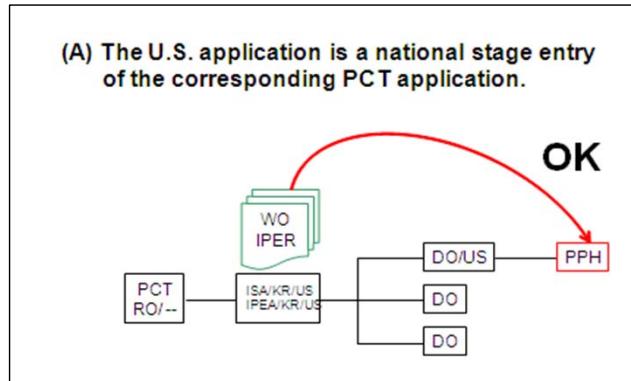
PCT-PPH benefits are not limited to national-stage cases. The beneficiary of PCT-PPH might be a continuation case, or a domestic case that predates the PCT case.

## PCT Work Product

PCT work product can include:

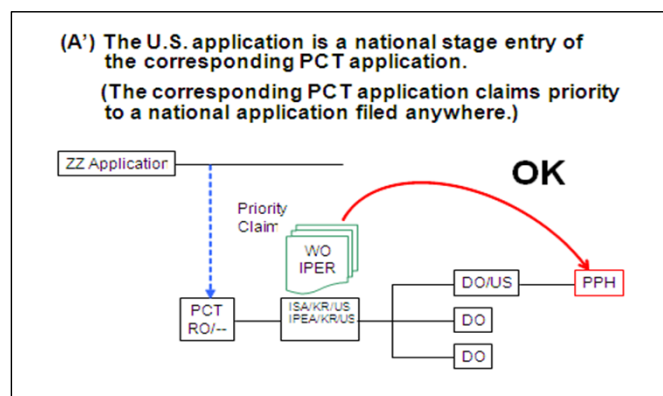
- Written Opinion of the ISA
- Written Opinion of the IPEA
- International Preliminary Report on Patentability under Chapter II

## Many Scenarios for PCT-PPH



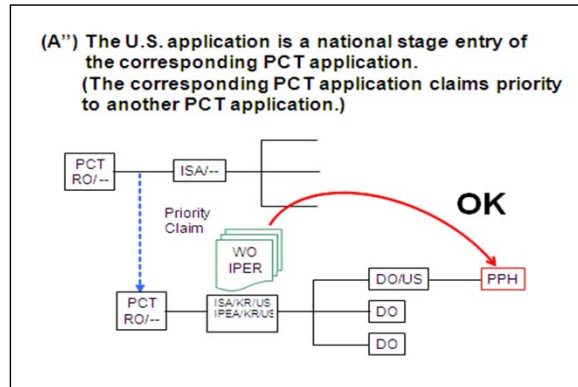
Note that the RO could be anywhere! It does not have to be the RO/US. It does not have to be the same as the ISA or IPEA. Note: IPER means IPRP-II.

## Many Scenarios for PCT-PPH



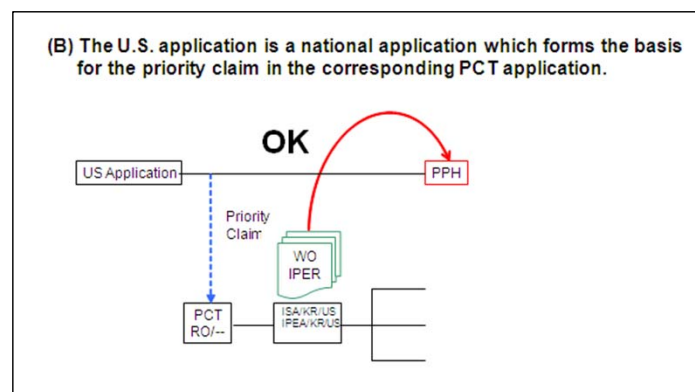
Note that the priority application could be anywhere! It does not have to be the US. It does not have to be the same as the ISA or IPEA. Note: IPER means IPRP-II.

## Many Scenarios for PCT-PPH



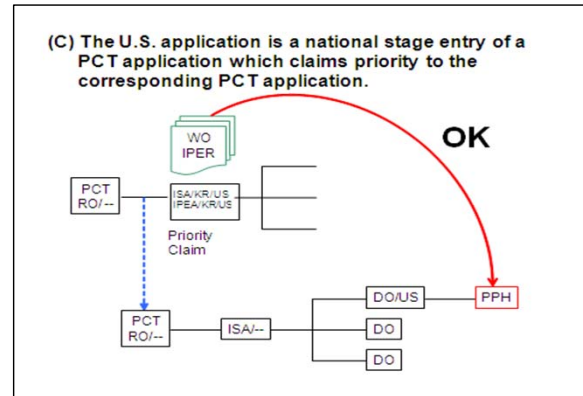
Note that the priority application could be anywhere! It does not have to be the US. It does not have to be the same as the ISA or IPEA. Note: IPER means IPRP-II.

## Many Scenarios for PCT-PPH



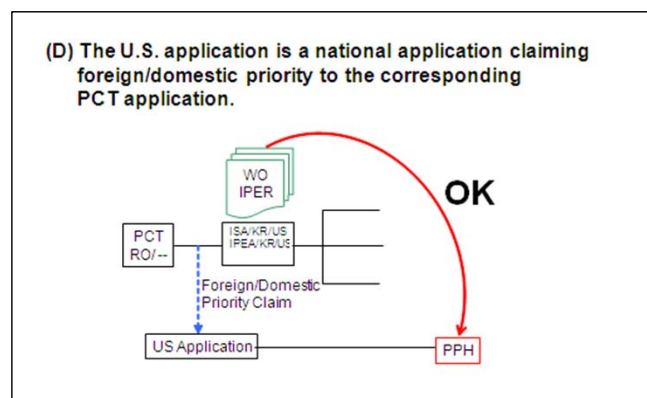
Note that the PCT application need not be filed in RO/US! Note: IPER means IPRP-II.

## Many Scenarios for PCT-PPH



Note that the PCT application need not be filed in RO/US!  
But don't forget the claims need to “sufficiently correspond”.

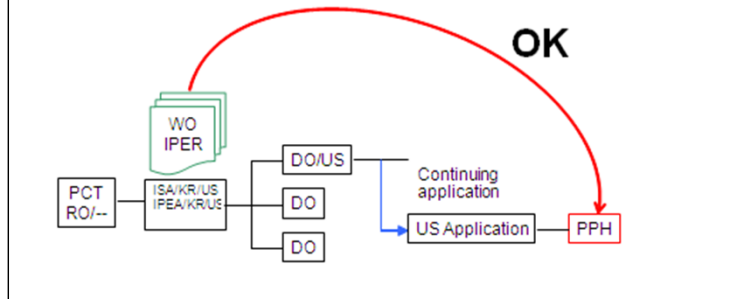
## Many Scenarios for PCT-PPH



Note that the US case might have a Paris relationship or a  
Section 120 relationship with the PCT application.

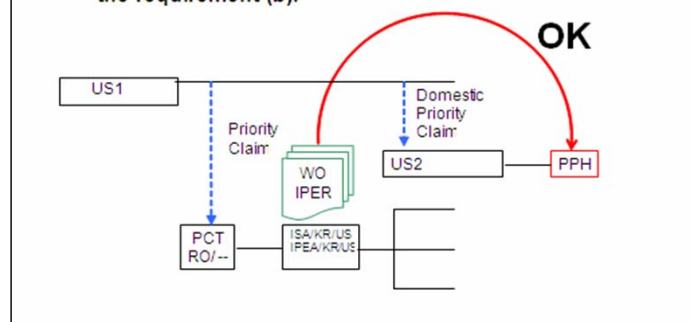
## Many Scenarios for PCT-PPH

(E1) The U.S. application is a continuing application of an application which satisfies the requirement (a).



## Many Scenarios for PCT-PPH

(E2) The U.S. application (US2) is an application claiming Domestic priority to an application (US1) which satisfies the requirement (b).





## How to Docket PPH

When a PPH petition is filed, docket a month to check for a decision on the petition.

When a petition is filed in a case that does not have a Filing Receipt, docket a month to check for a Filing Receipt.

Also docket to check that an Examiner gets assigned to the case.

If a petition is dismissed, aggressively docket the one-month period.

## Trap for the Unwary

Many filers will put off filing thorough IDSs until months after getting the US application number. But when you file a PCT-PPH petition, you might get a Notice of Allowance at any time thereafter, perhaps within mere days. Make sure that all of your IDSs (not only the IDS required by the PCT-PPH procedure) have been filed before you file your PCT-PPH petition.

## An Actual PCT-PPH Result

February 28, 2007	Priority application filed
February 27, 2008	International application filed (ISA/KR)
July 29, 2008	International search report mailed
August 28, 2009	US national stage entered
April 22, 2010	First Office Action Prediction is 22 months
June 3, 2010	PCT-PPH-KR petition filed
June 9, 2010	PCT-PPH-KR petition granted
June 18, 2010	Notice of allowance

## Most Commonly Made Mistakes When Petitioning for PCT-PPH Status

- Failing to provide all references from the ISR
- Failing to file an IDS detailing those references
- Failing to cancel claims that were not treated favorably
- Failing to index the petition correctly - "Petition to make special under PCT-Patent Pros Hwy."
- Failing to provide a copy of the ISR
- Failing to provide a copy of the WO
- Failing to list the ISR and the WO in the IDS
- Failing to cause the US claims to "sufficiently correspond"

## If a Petition is Dismissed?

Trap for the unwary: If the Examiner picks up the file while you are sitting around not responding to the dismissal, you lose your chance for PCT-PPH. So don't let the whole month go by. Respond sooner.

## PCT Can Make Good Sense

Note that PCT-PPH means that PCT may make good sense even for applicants who have no intention of foreign filing.

## Comparison of PCT-PPH and Track I

- Up-front fee may be cheaper for PCT
- Gaining application can be almost anything under PCT-PPH
- Different limits on your numbers of claims
- How long the “special” status lasts ...
- Consequences of filing an RCE
- Consequence of taking a day of extension of time
- The “special” status of PPH is a gift that keeps on giving, all the way through *ex parte* appeal (not so for Track I)

## Track I

With Track I, you are spending \$4130 at a time when you do not yet know whether your invention is patentable.

## Tedious and Old-Fashioned Work

There is simply no substitute for the tedious and old-fashioned business of figuring out what the invention is, drafting the best claims that our abilities permit, and keeping the application concise and to the point.

If one is tempted to pursue one or another of the approaches described here, one should do so only for a well drafted patent application.

**Now Maybe a Few Questions?**

**Thank you!**