

出國報告( 出國類別：其他 )

## 赴美國專利商標局參加專利審查高速公路(PPH)合作會議

服務機關：經濟部智慧財產局

出國人 職稱/姓名：吳科長佳穎

趙審查官慶泠

出國地點：美國

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報告日期：民國 100 年 1 月



## 摘 要

專利審查高速公路(簡稱 PPH)，係各國專利局間，藉由簽訂雙方合作計畫，互相利用檢索與審查結果，達到減少重複性工作，進而降低審案負擔、減少積案，並提高專利品質的合作方式。目前美國專利商標局正積極推動與各國專利局的 PPH 合作，由於目前我國並未與其他國家專利局有任何正式的 PPH 合作，藉此次會議瞭解美國和他國執行 PPH 的相關工作，以及評估日後我國和美國是否有審查工作之合作可能性。

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# 第一章、目的

專利審查高速公路(簡稱 PPH)，係各國專利局間，藉由簽訂雙方合作計畫，互相利用檢索與審查結果，達到減少重複性工作，進而降低審案負擔、減少積案，並提高專利品質的合作方式。目前美國專利商標局正積極推動與各國專利局的 PPH 合作，包括：澳洲、奧地利、加拿大、丹麥、芬蘭、德國、匈牙利、日本、韓國、俄羅斯、新加坡、西班牙、英國等國專利局以及歐洲專利局。

我國自 98 年起推動「經濟部智慧財產局發明專利加速審查作業方案(AEP)」，實施迄今外界申請人反應良好，並且本局也在今年 APEC IPEG 會議上報告說明，引發包括日本和美國等許多國家與會代表的迴響，鑑於目前各專利局審查負擔均十分龐大，各國已經有共識應朝向各國審查工作分享的目標，減少各局必須負擔的工作。

由於目前我國並未與其他國家專利局有任何正式的 PPH 合作，藉由此次赴美國專利商標局瞭解，該局與其他國家專利局間的專利審查高速公路(PPH)合作現況，以及該 PPH 加速審查申請所涉及的專利合作議題，各專利局包括審查人員會面對該合作所須進行的改變和配合事項。另外也藉此能蒐集各國審查合作現況包括雙邊和多邊情況，作為我國和他國進行審查合作之模式參考及評估。另亦能藉由拜會美國專利商標局官員與審查官，加強雙方未來合作關係。

## 第二章、過程

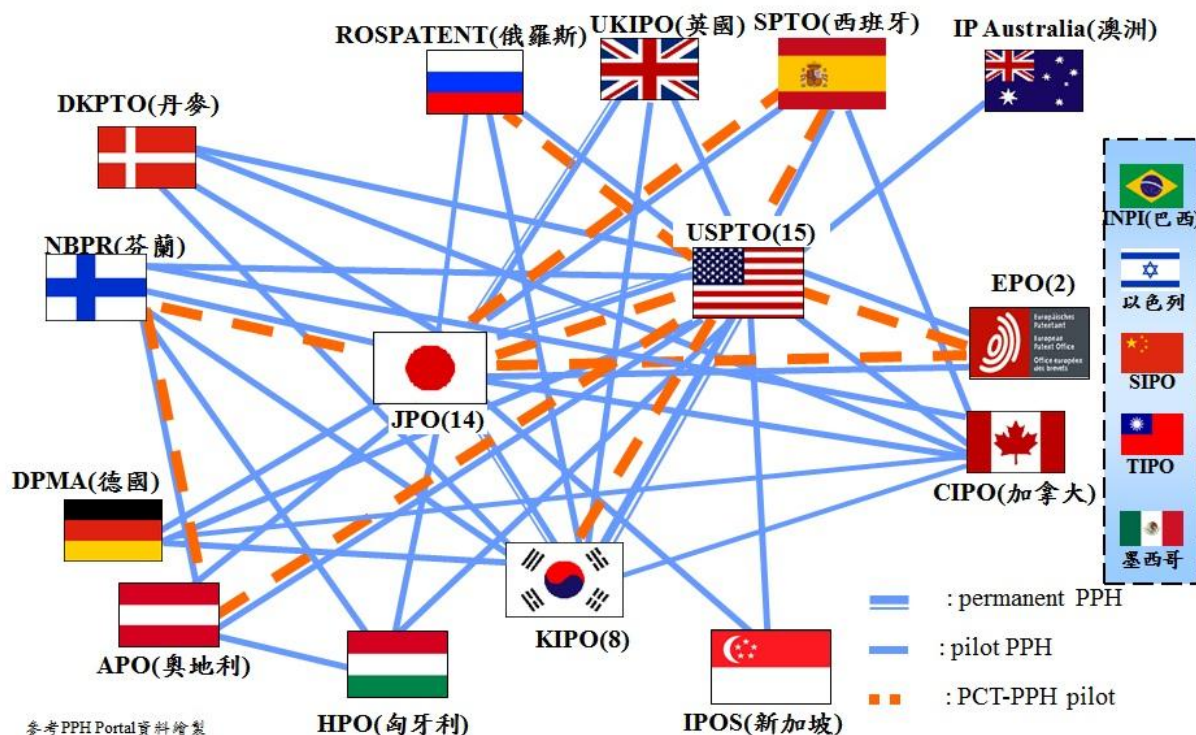
此次參與的國家共有十八個國家/組織，包括奧地利、巴西、加拿大、丹麥、歐洲專利局、冰島、德國、匈牙利、以色列、日本、墨西哥、中國、俄羅斯、韓國、西班牙、瑞典及 WIPO 代表及我國，其中僅有巴西、以色列、中國及我國尚未有簽訂 PPH 協議，惟目前美國正在與以色列及中國洽談 PPH 協議。此次議程討論內容如下：

日期	行程
10/30-31	台北-美國
11/1	赴美國專利商標局瞭解美國專利 PPH 制度以及美國專利審查制度，並瞭解 PPH 包括利用巴黎公約之優先權申請案，PCT 檢索報告以及歐洲專利局檢索報告接受及運用情況。 <ul style="list-style-type: none"><li>◆ 美國專利 PPH 制度簡介<ul style="list-style-type: none"><li>- Paris-PPH，利用巴黎公約之優先權申請案</li><li>- PCT-PPH，利用 PCT 工作成果</li></ul></li><li>◆ 美國專利審查制度簡介</li></ul>
11/2	於美國專利商標局就實際美國專利申請案件的審查流程，包括前案資訊呈報(IDS)，審查意見函(OA)以及審查時程管控，內部檢索工具等進行瞭解。 <ul style="list-style-type: none"><li>◆ “充分相對應請求項”的定義和判斷標準</li><li>◆ PPH 程序相關要求<ul style="list-style-type: none"><li>- 前案資訊呈報(IDS)</li></ul></li></ul>

	<ul style="list-style-type: none"> <li>- 審查意見函(OA)</li> <li>- 英文翻譯證明</li> <li>- 時程管控</li> <li>- 電子申請(EFS Web)</li> </ul>
11/3	<p>於美國專利商標局瞭解申請人如何向該局提出 PPH，包括申請書以及實務上遇到的相關問題和目前的解決方法，並且瞭解目前除了雙邊的審查工作合作外，國際上目前的多邊審查合作進行的現況。</p> <ul style="list-style-type: none"> <li>◆ PPH 請求相關程序確認</li> <li>◆ 目前 PPH 的相關統計</li> <li>◆ 多邊 PPH</li> </ul>
11/4	<p>於美國專利商標局瞭解美國專利制度中主要專利要件判斷，包括新穎性，進步性和產業上利用性，以及說明書揭露和申請專利範圍之要求。</p> <ul style="list-style-type: none"> <li>◆ 美國專利要件 <ul style="list-style-type: none"> <li>- 美國專利法§101 適格標的</li> <li>- 美國專利法§112 書面揭露/可據以實施</li> </ul> </li> </ul>
11/5	<p>於美國專利商標局實際瞭解該國審查人員撰寫審查意見以及檢索報告的形式以及主要記載內容為何。</p> <ul style="list-style-type: none"> <li>◆ 申請專利範圍解讀</li> <li>◆ 美國專利法§102 新穎性</li> <li>◆ 美國專利法§103 進步性</li> </ul>
11/6-7	美國-台北

# 第三章、專利審查高速公路(PPH)

美國目前已經和 14 個國家簽訂雙邊 PPH 協定(Paris-PPH)，且在 2010 年 1 月起，在 WIPO 的促成下，EPO、JPO 與 USPTO(6 月時 KIPO 亦加入)更進一步擴大採用 PCT 國際階段的工作成果，作為提起 PPH 申請的一種方式，稱之為「PCT-PPH」。



為鼓勵申請人提起 PPH 申請，自 2010 年 5 月 25 日起，美國已免除提起 PPH 加速審查之申請費用。

## 壹、 巴黎公約 PPH(Paris-PPH)

此種 Paris-PPH(或稱 Regular-PPH)即為最早由日本提出的 PPH，一般所稱的 PPH 即為此種，其是指當一專利申請案在第一申請局(Office of First Filing, 簡稱 OFF)經過實質審查通過獲准專利後，專利權人可以藉由提交 OFF 的核准專利範圍、審查意見與引證文獻，並同時配合將申請專利範圍修正為和 OFF 核准專



利範圍相同或近似的範圍，而在第二申請局(Office of Second Filing, 簡稱 OSF) 加速審查。使得第二申請局可利用第一申請局的檢索與審查結果，避免重複工作並加速第二專利局的審查效能。

### (一)Paris-PPH 的特色

Paris-PPH 的特色如下：

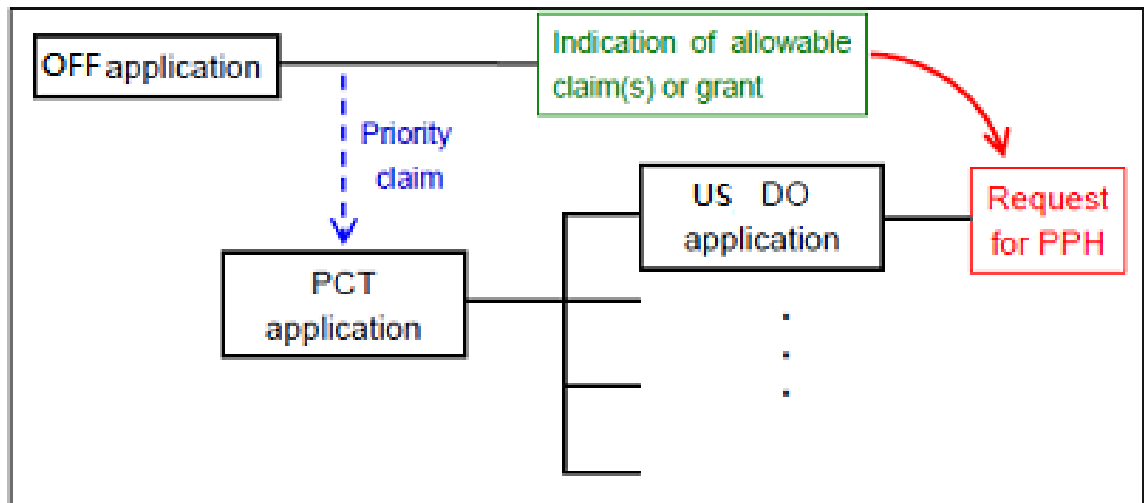
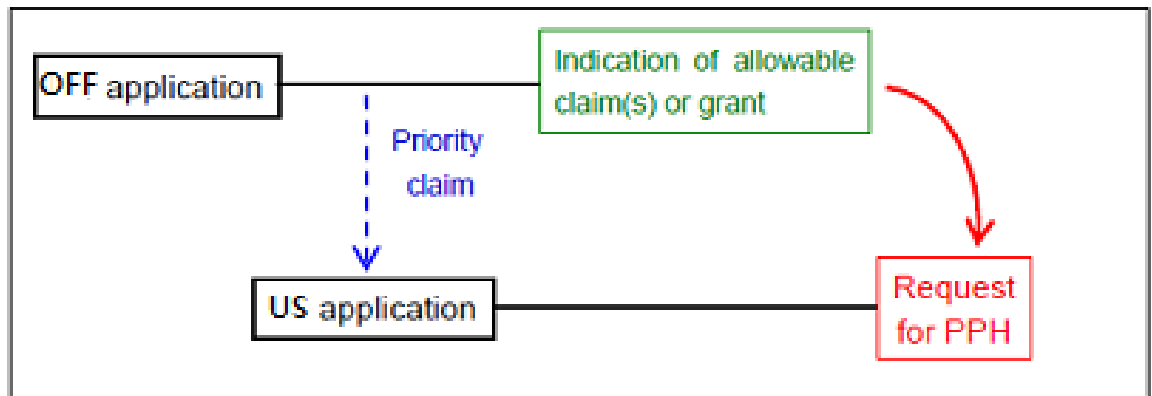
1. Paris-PPH 制度重視「第一專利局(OFF)」和「第二專利局(OSF)」的正確關係和時間順序，以 USPTO 為 OSF 時，要確認申請人所提出的核准係來自於「第一專利局(OFF)」，且第一專利局核准至少一項請求項。
2. 適格向「第二專利局(OSF)」即 USPTO 提出之 PPH 申請案皆必須尚未進行實審(若是 USPTO 僅曾發過請求分割通知，且實際上尚未實體審查，仍可為 PPH 適格申請案)。
3. 在 USPTO 提出的請求項必須和「第一專利局(OFF)」核准的請求項“充分相互對應”，其判斷並未要求申請專利範圍的逐字均相同，但是範圍(scope)必須相同或是近似，惟實務上能接受的差異，多半來自翻譯的差異或是請求項形式上的差異，若是審查人員認為範圍不相同會給申請人一次申復說明機會。
4. 在 USPTO 提出的「第一專利局(OFF)」核准的請求項必須以英文翻譯，且聲明該翻譯無誤。
5. 必須提出「第一專利局(OFF)」的所有 OA，若是非屬英文，還必須全部翻譯成英文且聲明英文翻譯是正確的。
6. 必須提出 IDS，除非該 IDS 已經在美國申請案中提出了。
7. 必須提交「第一專利局(OFF)」之 OA 中所提到的所有文件，但是美國公告或是公開專利則無須提供。
8. 適格美國專利申請案，包括主張巴黎公約的國家申請案，或是 PCT

的美國國家階段申請案，以及 Bypass 申請案，並且上述案件均不可以為臨時申請案(provisional)、植物專利申請(plant)設計專利申請(design)、再發證案(reissue)、再審查案(reexamination)以及受到秘密保持令(secretcy order)的申請案。

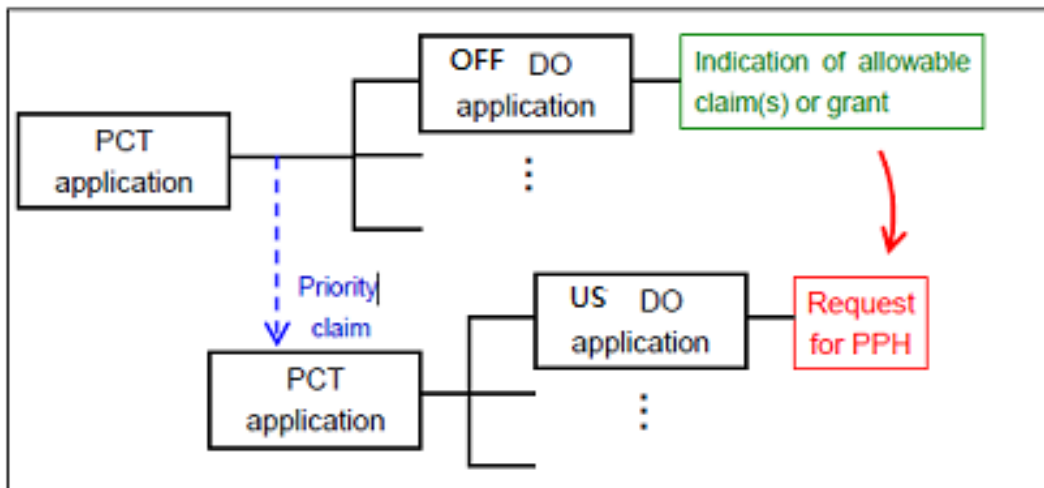
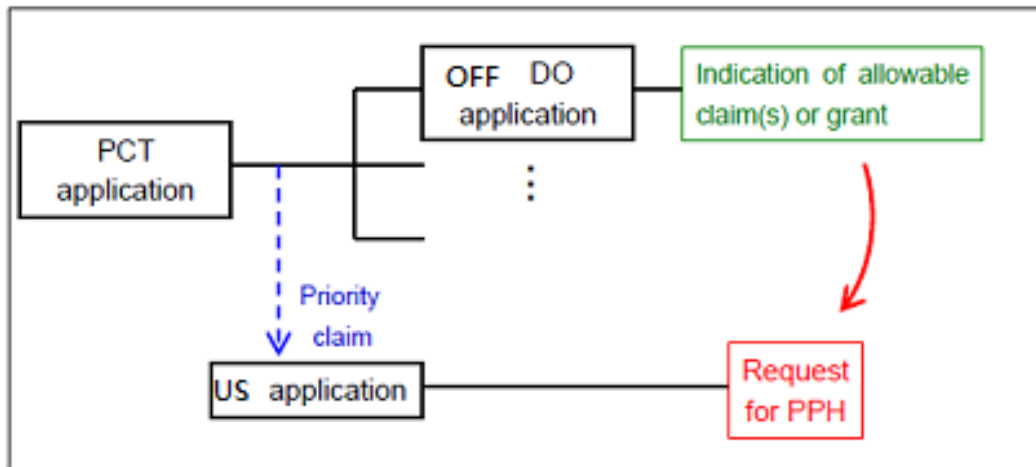
## (二)正確的第一專利局(OFF)與第二專利局(OSF)關係

所謂正確的 OFF 與 OSF 關係，係指符合以下條件之一關係：

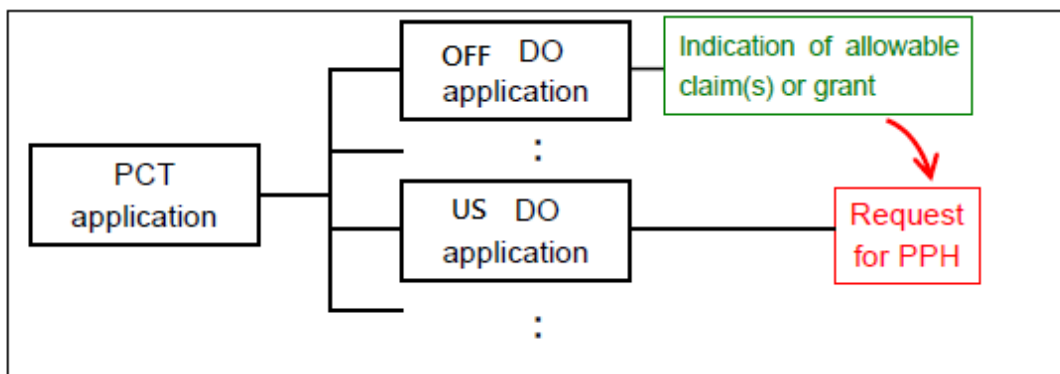
1. US 申請案或 PCT 的 US 國家階段申請案，具有對第一申請局(OFF)主張的一個或多個巴黎公約優先權：



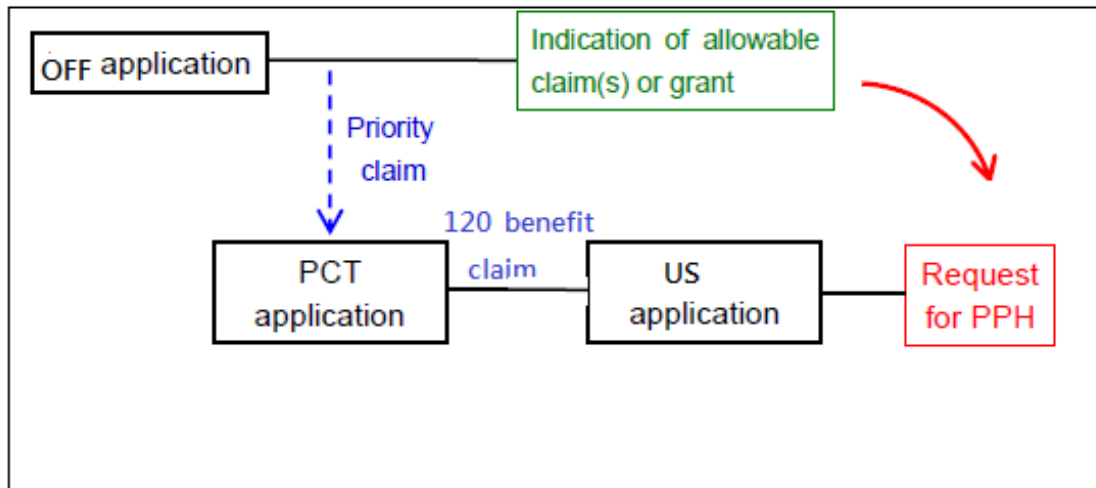
2. US 申請案或 PCT 的 US 國家階段申請案，具有對一未主張優先權的 PCT 申請案，主張巴黎公約優先權：



3. PCT 的 US 國家階段申請案(PCT 申請案從國際階段進入 US 的國家階段)，該 PCT 的 US 國家階段申請案和 OFF 的申請案具有關連：



4. 作為美國專利法第 120 條的 Bypass 申請案(依照美國專利法第 120 條之規定要求享有 PCT 母案之申請日利益的申請案即為“Bypass 申請案”)，若其主張一 PCT 申請案的利益，該 PCT 申請案具有對第一專利局(OFF)主張的優先權：



### (三)請求項必須充分對應

第一申請局(OFF)對申請專利範圍進行實質審查，且至少有一個請求項獲准，在 US 申請案中的請求項必須"充分對應(sufficiently correspond)"於第一專利局(OFF)獲准的請求項，若僅是第一申請局對請求項作出之正面評價的檢索報告，並無法提起 Paris-PPH 申請。

當申請人在向 USPTO 提出 Paris-PPH 申請時，必須同時對申請專利範圍提起補充修正，使請求項充分對應於 OFF 獲准的請求項，如果 OFF 並未發出任何 OA 就獲准，則申請人必須提起並無任何請求項在 OFF 被核駁的聲明。

## 貳、 專利合作條約 PPH(PCT-PPH)

不同於 Paris-PPH，PCT-PPH 所利用的是 PCT 國際階段的工作成果，包括：國際檢索機構的書面意見(WO/ISA)、國際預審機構的書面意見(WO/IPEA)與國際初步審查報告(IPER)，作為提起 PPH 申請的一種方式。如果一申請案，對一 PCT 案主張優先權或主張 PCT 案的利益，則該申請案可以利用該 PCT 案的 WO/ISA、WO/IPEA 或 IPER，提起 PCT-PPH 的加速審查。特別注意的是，在 PCT-PPH，完全不需要考慮第一專利局與第二專利局的順序關係。

### (一)PCT-PPH 的特色

PCT-PPH 的特色如下：

1. PCT-PPH 所運用的為 PCT 國際階段的工作成果，包括國際檢索機構的書面意見(WO/ISA)、國際預審機構的書面意見(WO/IPEA)與國際初步審查報告(IPER)。
2. 其與 Paris-PPH 最大差異為，無須理會「第一專利局(OFF)」和「第二專利局(OSF)」的正確關係和時間順序，使程序認定容易許多。
3. 適格的 PCT-PPH 美國專利申請案，包括美國國家申請案，或是 PCT 的美國國家階段申請案，並且上述案件均不可以為臨時申請案(provisional)、植物專利申請(plant)設計專利申請(design)、再發證案(reissue)、再審查案(reexamination)以及受到秘密保持令(secretary order)的申請案。
4. 所提出該案的 PCT 國際階段的工作成果，至少有一請求項接受到 PCT 國際階段工作成果的正面評價。
5. 製作 PCT 國際階段工作成果的 ISA 或 IPEA 必須有和 USPTO 簽訂 PCT-PPH 協定。

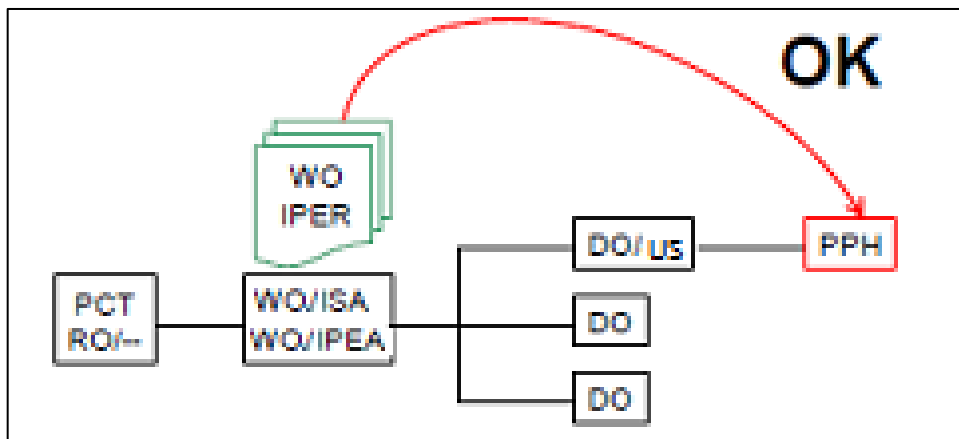
6. 主張進行 PCT-PPH 之 USPTO 申請案必須尚未進行實審，且請求項必須和 PCT 國際階段的工作成果給予正面評價的請求項“充分相互對應”，但較 Paris-PPH 放寬的是，PCT-PPH 允許申請人將說明書已揭露的技術特徵增加為附屬項，依附於給予正面評價的請求項之下。

7. 相同地，有關 IDS、OA 影本及翻譯、請求項翻譯等文件亦須提供。

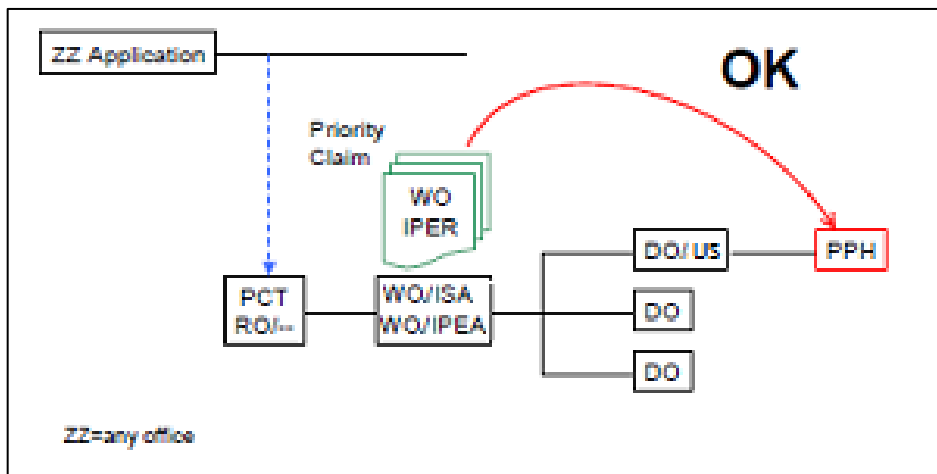
(二)不必考慮的第一專利局(OFF)與第二專利局(OSF)關係

PCT-PPH 不須要考慮「第一專利局(OFF)」和「第二專利局(OSF)」的正確關係和時間順序，因此以下舉例者，均為可能的 PCT-PPH 申請態樣：

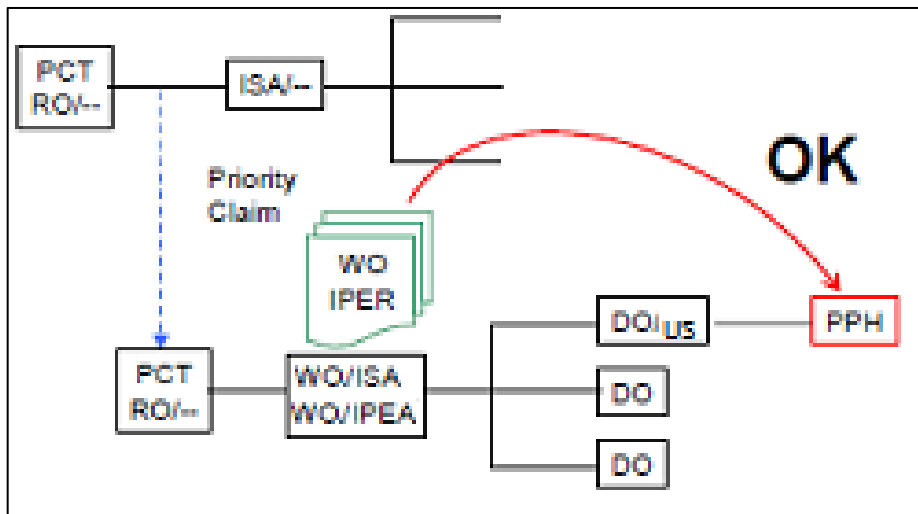
1. US 申請案是 PCT 的 US 國家階段申請案；



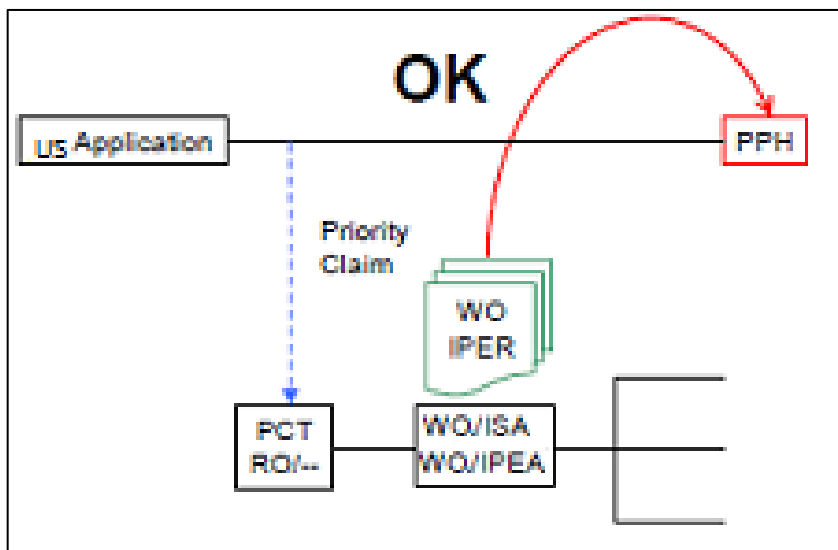
2. US 申請案是 PCT 的 US 國家階段申請案，該 PCT 申請案主張其他國家申請案的優先權；



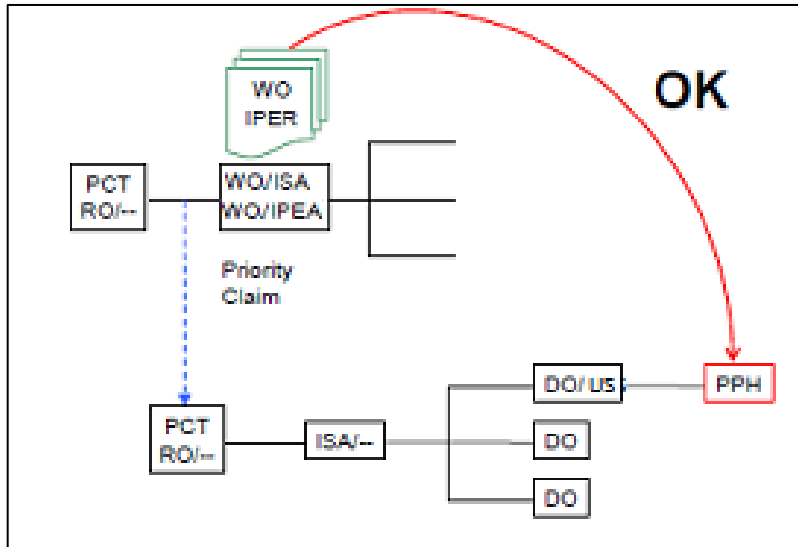
- US 申請案是 PCT 的 US 國家階段申請案，該 PCT 申請案主張一相關連 PCT 申請案的優先權；



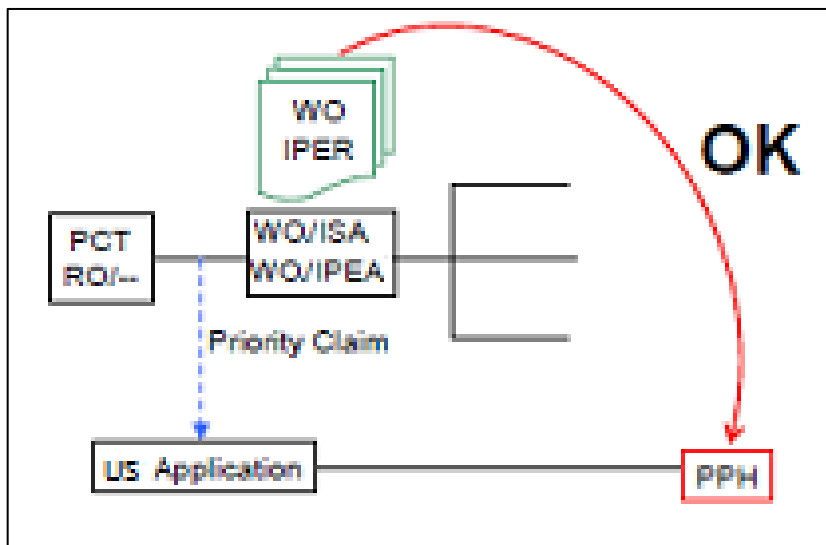
- US 申請案是 US 國家申請案，而被一相關連的 PCT 申請案主張優先權；



- US 申請案是另一 PCT 的 US 國家階段申請案，該另一 PCT 申請案主張一相關連 PCT 申請案的優先權；

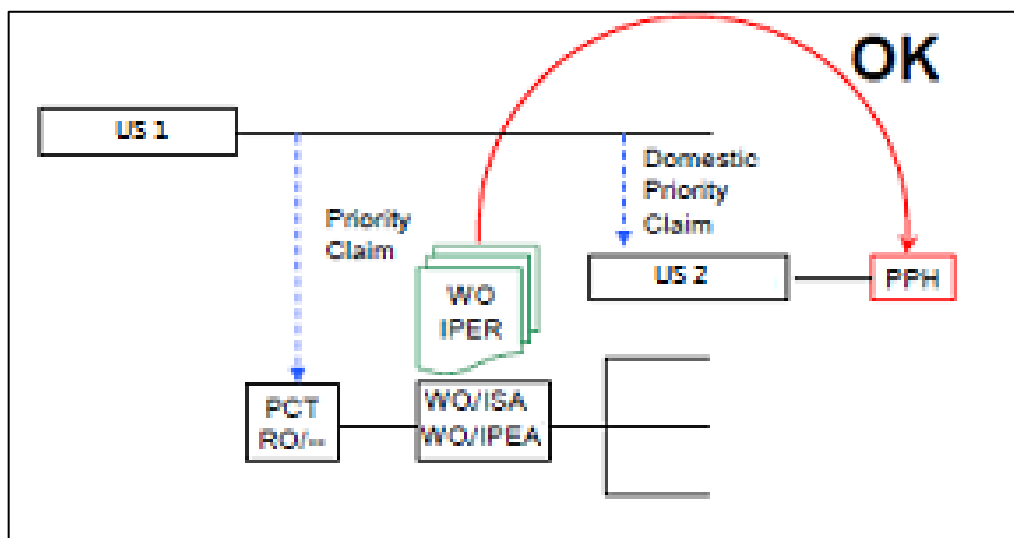
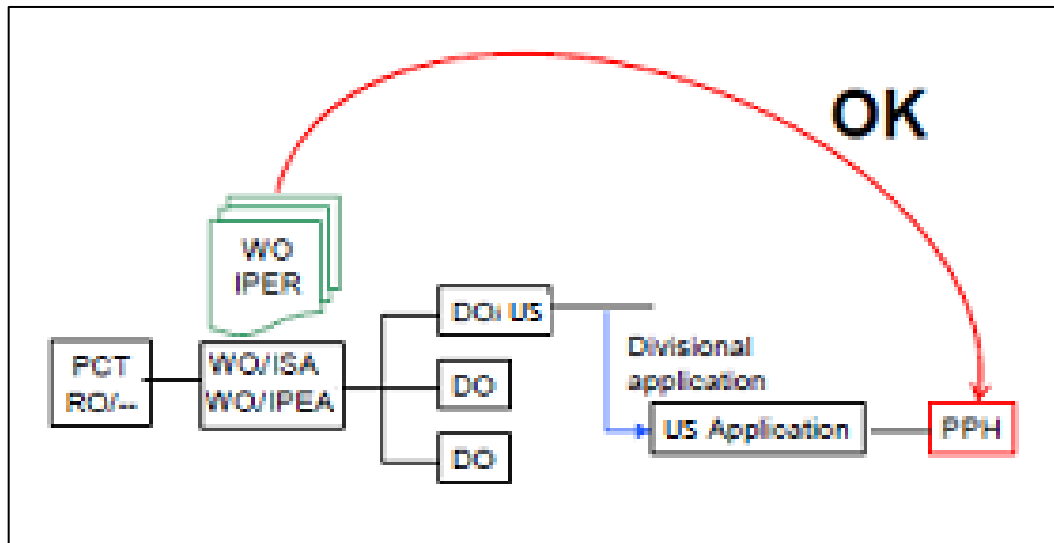


- US 申請案是一國家申請案，主張一相關連的 PCT 申請案的國際/國內優先權；





7. US 申請案是符合前述態樣之 US 申請案的連續申請案 (Continuation、divisional 或 CIP)



(三)請求項必須充分對應

主張進行 PCT-PPH 之 USPTO 申請案之請求項必須和 PCT 國際階段的工作成果給予正面評價的請求項"充分對應(sufficiently correspond)"，但較 Paris-PPH 放寬的是，PCT-PPH 允許申請人將說明書已揭露的技術特徵增加為附屬項，依附於給予正面評價的請求項之下。

當申請人在向 USPTO 提出 PCT-PPH 申請時，必須同時對申請專利範圍提起補充修正，使請求項充分對應於正面評價的請求項；亦即，在 USPTO 提出的申請專利範圍，除了因為翻譯或請求項格式所作的相應調整，

必須和 PCT 申請案最新的工作成果所指出具有專利要件且無第 VIII 欄意見的申請專利範圍相同或更窄，更窄的申請專利範圍必須以附屬項方式撰寫。若 PCT 工作成果(WO/ISA、WO/IPEA 或 IPER)的第 VIII 欄有意見，不論是否根據第 VIII 欄意見已經作出相對應的修正，申請人必須提出該請求項為何已不存在第 VIII 欄的核駁理由的聲明。

## 參、 申請文件

程序要求	Paris-PPH	PCT-PPH
申請書	PTO/SB/20OFF	PTO/SB/20/PCT-PPH PTO/SB/20/PCT(USPTO 為 ISA 或 IPEA)
申請費	無	無
實質審查	必須尚未開始	必須尚未開始
申請專利範圍	OFF 申請案具有至少一個被 OFF 認為是可准/有可專利性 的請求項	WO/ISA、WO/IPEA 或 IPER 指至少有一個 PCT 申請案的 請求項具有專利要件。如果在 WO/ISA、WO/IPEA 或 IPER 的第 VIII 欄有意見，不論是否 根據第 VIII 欄意見已經作出相 對應的修正，申請人必須說明 為何請求項已經不存在第 VIII 欄的核駁理由
充分對應	充分對應係指，在 USPTO 提 出的申請專利範圍，除了因為 翻譯或請求項格式所作的相應 調整，必須和 OFF 核准的申請 專利範圍相同	充分對應係指，在 USPTO 提 出的申請專利範圍，除了因為 翻譯或請求項格式所作的相 應調整，必須和 PCT 申請案 最新的工作成果所指出具有 專利要件且無第 VIII 欄意見的 申請專利範圍相同或更窄，更 窄的申請專利範圍必須以附 屬項方式撰寫

申請專利範圍的提交	核准/具有可專利性之申請專利範圍影本 1 份 若非英文，其英文翻譯本 1 份 聲明該請求項的英文翻譯為正確的聲明書 1 份 若 OFF 的審查意見並未明確指出可准的請求項，申請人必須再提出一聲明書或聲明，主張 OFF 的審查意見並未對請求項作出核駁，因此請求項被認為是在 OFF 可獲准的	核准/具有可專利性請求項影本 1 份 若前述請求項非英文，其英文翻譯本 1 份 聲明該請求項的英文翻譯為正確的聲明書 1 份
請求項對應表	必須提交，且須為英文 請求項對應表必須指出 US 申請案的所有請求項均對應到 OFF 申請案之可准/具有可專利性的請求項	必須提交，且須為英文 請求項對應表必須指出 US 申請案的所有請求項均對應到 PCT 申請案的最新的工作成果所指出的具有專利要件的請求項
審查意見通知 (OA)	OFF 於審查過程中所核發之所有審查意見通知書及檢索報告；若非英文，及其英文簡要說明	WO/ISA、WO/IPEA 或 IPER；若非英文，及其英文簡要說明
IDS	需要	需要
相關先前技術影本	需要，除非為美國公開或公告案	需要，除非為美國公開或公告案
EFS WEB 送件	需要	需要

## 肆、 PPH 統計數據

### (一)Paris-PPH 的申請

USPTO 截至 2010 年 9 月 30 日，共接受到 3676 件 Paris-PPH 的申請，其中 164 件 PPH 申請因不符合程序規定而不予受理。其中案件高度集中在 TC 2600(通訊)，最少的在 TC 1600(生技及有機化學)。Paris-PPH 的首次 OA 等待期，從 PPH 受理日起算，平均為 185.6 天。Paris-PPH 申請案的逕准率為 25.11%，最終核准率為 90.67%，非 PPH 案件的最終核准率為 44%。

**Overall Statistics for Paris Route Patent Prosecution Highway Programs**

- **Statistics for PPH requests filed in the USPTO under Paris Route PPH programs**

As of: 9/30/2010

Number of requests to participate in the PPH Program 3,676

Number of these requests that are not eligible because a first action on the merits was mailed before the requests were considered, or cannot be granted because the request has been dismissed twice. 164

**Breakdown of applications and application data by Tech Center**

	Number of Requests Filed	Days from PPH Request to Grant	Days from PPH Grant to First Action
<b>Technology Center 1600</b> Biotechnology and Organic Chemistry	128	106.32	177.30
<b>Technology Center 1700</b> Chemical and Materials Engineering	519	61.79	120.24
<b>Technology Center 2100</b> Computer Architecture Software and Information Systems	274	70.23	99.26
<b>Technology Center 2400</b> Multiplex, Networking, Cable TV, Computer Security	269	64.63	129.91
<b>Technology Center 2600</b> Communications	1,336	61.81	146.66
<b>Technology Center 2800</b> Semiconductors and Electronic Circuits and Components	520	62.74	68.49
<b>Technology Center 3600</b> Mechanical Engineering	299	41.91	90.55
<b>Technology Center 3700</b> Mechanical Engineering	302	23.02	114.40
Applications undergoing Pre-Exam without a Technology Center assignment	29	0.00	0.00

Eligible requests	<u>3,512</u>
Requests granted	<u>3,139</u>
Requests dismissed once and awaiting further action	<u>97</u>
Requests not acted upon	<u>276</u>

## Overall Statistics for Paris Route Patent Prosecution Highway Programs

### • Statistics for PPH requests filed in the USPTO under Paris Route PPH programs

PPH requests received by the USPTO		3,676	Percent w/ First Action
FAs	Total	2,688	73.12%
	First Action Allowance	675	25.11%
	First Action Quayle	36	1.34%
	First Action Rejection*	1,782	66.29%
	(- art rejections)**	1,552	87.09%
	(- non art rejections)	230	12.91%
First Action Restriction		195	7.25%
PPH requests for accelerated examination rejected for not satisfying PPH requirements		164	
Average period from request to FA		185.6 days	

\* First Action Rejections subsequently allowed: 767 out of 1,552 times

\*\* Art Rejections where U.S. Patent documents used: 1,446 out of 1,552 times

Grant Rate (Allowances / Total number of Disposals) 90.67%

## (二) PCT-PPH 的申請

USPTO 截至 2010 年 9 月 30 日，共接受到 429 件 PCT-PPH 的申請，其中 11 件 PPH 申請因不符合程序規定而不予受理。由於從 2010 年 1 月才開始實施，案件累積數目較少，目前並無集中在特定領域的現象。PCT-PPH 的首次 OA 等待期，從 PCT-PPH 受理日起算，平均為 84.2 天。PCT-PPH 申請案的逕准率為 21.43%，最終核准率為 96.77%。

**Overall Statistics on the PCT-Patent Prosecution Highway Program**

- **Statistics for PPH requests filed in the USPTO under all PCT-PPH programs**

- The PCT-PPH program started on January 29, 2010

**As of: 9/30/2010**

Number of requests to participate in the PPH Program 429

Number of these requests that are not eligible because a first action on the merits was mailed before the requests were considered, or cannot be granted because the request has been dismissed twice. 11

**Breakdown of applications and application data by Tech Center**

	Number of Requests Filed	Days from PPH Request to Grant	Days from PPH Grant to First Action
<b>Technology Center 1600</b> Biotechnology and Organic Chemistry	25	105.79	18.00
<b>Technology Center 1700</b> Chemical and Materials Engineering	77	58.30	37.58
<b>Technology Center 2100</b> Computer Architecture Software and Information Systems	27	65.73	18.40
<b>Technology Center 2400</b> Multiplex, Networking, Cable TV, Computer Security	15	44.85	38.25
<b>Technology Center 2600</b> Communications	46	59.00	119.00
<b>Technology Center 2800</b> Semiconductors and Electronic Circuits and Components	64	48.82	40.00
<b>Technology Center 3600</b> Mechanical Engineering	53	44.07	43.59
<b>Technology Center 3700</b> Mechanical Engineering	75	19.09	33.28
Applications undergoing Pre-Exam without a Technology Center assignment	47	0.00	0.00

Eligible requests	<u>418</u>
Requests granted	<u>243</u>
Requests dismissed once and awaiting further action	<u>21</u>
Requests not acted upon	<u>154</u>



### Overall Statistics on the PCT-Patent Prosecution Highway Program

PPH requests received by the USPTO		429	Percent w/ First Action
FAs	Total	42	9.79%
	First Action Allowance	9	21.43%
	First Action Quayle	0	0.00%
	First Action Rejection*	26	61.90%
	(- art rejections)**	25	96.15%
	(- non art rejections)	1	3.85%
First Action Restriction		7	16.67%
PPH requests for accelerated examination rejected for not satisfying PPH requirements		11	
Average period from request to FA		84.2 days	

\* First Action Rejections subsequently allowed:  $\frac{4}{26}$  out of  $\frac{26}{26}$  times

\*\* Art Rejections where U.S. Patent documents used:  $\frac{52}{52}$  out of  $\frac{25}{25}$  times

Grant Rate (Allowances / Total number of Disposals)  $\frac{96.77\%}{96.77\%}$

整體而言，PPH 申請案平均每個案件准駁所發出的 OA 次數為 1.8 次，非 PPH 案件平均 OA 次數為 2.4 次；此外，PPH 申請案的請求項數，平均較原申請案的請求項數減少 20%。

## 伍、 美國目前 PPH 制度與我國 AEP 制度之差異比較

我國的 AEP 可以允許申請人藉由主張「任何一個專利局」已經核准權利範圍，在我國提出 AEP 並進行加速審查，而美國 Paris-PPH 僅允許申請人主張「第一專利局(OFF)」已經核准的權利範圍來進行加速審查。

美國專利局局長希望擴大使用 PPH 的申請案量，惟相較於我國 AEP，Paris-PPH 對於專利申請人有許多限制條件造成利用率的不高，其限制包括：

1. 嚴格限制了「第一專利局(OFF)」與「第二專利局(OSF)」的時間順序關係，申請人必須僅能主張在「第一專利局(OFF)」核准的權利範圍，進行加速審查。然而目前執行的實務上發現，由於各主要專利局相當程度的積案問題，造成「第一專利局(OFF)」經常實際上並非是第一個完成申請案實質審查的專利局，也因此造成適格案件不如預期多，且由於此限制也造成專利局在進程序要件判斷時較為複雜。
2. Paris-PPH 可利用的係為「第一專利局(OFF)」的核准專利的申請權利範圍，並無法利用「第一專利局(OFF)」尚未審定的檢索報告或審查意見通知就提起 PPH，此對於特定專利局(例如歐洲專利局)，由於該局很快在 18 個月左右就發出檢索報告與初步意見，但是需要花上三至四年才完成審定，若是申請人選擇如歐洲專利局作為「第一專利局(OFF)」，因為審結時間會拖很久，所以其實申請人並很難能享受 PPH 申請的好處。
3. 由於 PPH 要求在 USPTO 提出的請求項必須和「第一專利局(OFF)」核准的請求項"充分相互對應"，鑑於各國專利局在實質上專利法規定有所差異，例如生技醫藥領域的 Swiss-type 或 German-type 的用途請求項，由於 USPTO 可以允許醫療方法發明，並不採用 Swiss-type 或 German-type 的用途請求項，若是以 Swiss-type 或

**German-type** 用途請求項會被審查認為請求項不明確，但是當申請人基於其他國家核准的此二種請求項，向 **USPTO** 提起 **PPH** 申請時，申請人鑑於配合美國實務若直接修改成醫療方法請求項，可能會被 **USPTO** 認為申請專利範圍並沒有充分對應，僅在特定情況如醫療方法請求項的限定步驟條件，均已經出現在核准之 **Swiss-type** 或 **German-type** 用途請求項中，才可能被認為仍然"充分相互對應"。此部分在會議中討論發現 **USPTO** 顯然採取較 **EPO** 或 **JPO** 僵化的認定。

4. 對於提起 **PPH** 申請之補充修正規定，**USPTO** 作嚴格的限制，除了因為翻譯或請求項格式所作的相應調整，申請人必須將美國申請案的申請專利範圍補充修正為和「第一專利局(**OFF**)」核准的申請專利範圍相同，自此申請專利範圍就「鎖住(**locked**)」，之後申請人若收到 **USPTO** 的核駁意見，只允許將附屬項的技術特徵向上併入獨立項中，不允許申請人將已揭示在原說明書的技術特徵但未記載於申請專利範圍的技術特徵，在答辯時增加到申請專利範圍。但是有鑑於申請人/代理人的反彈，**USPTO** 在 **PCT-PPH** 和 **JPO-USPTO** 的 **Paris-PPH**，做了些放寬規定，開放允許申請人在提起 **PPH** 的補充修正時，已揭示於原說明書的技術特徵雖未記載於請求項，以增加附屬項的方式增加到申請專利範圍，但自此申請專利範圍也會「鎖住(**locked**)」，之後申請人若收到 **USPTO** 的審查核駁意見，只允許將附屬項的技術特徵向上併入獨立項中，作為一種折衷方案的試行。此會議中 **JPO** 和 **KIPO** 代表說明他們國家，對於 **PPH** 的補充修正並未有如同 **USPTO** 如此嚴格的限制。

## 第四章、心得及建議

美國專利局局長 David Kappos 希望在 2010 年 PPH 申請案件總數達到 4000 件，在 2011 年目標是可以達到 8000 件，因此非常積極推動各項推動 PPH 相關的外展活動，依照 USPTO 統計雖然 2010 年的 4000 件目標至 10 月已經達成，但 2011 年的 8000 件目標則面臨極大挑戰，因此 USPTO 非常需要其他國家專利局的協助來擴大 PPH 使用者。

<b>First Office</b>	<b>Start Date</b>	<b>Requests (as of 1 Nov. 2009)</b>	
<b>JPO</b>	<b>July 2006</b>	<b>2918 278 (Pilot) 2640 (Full)</b>	
<b>UKIPO</b>	<b>Sept 2007</b>	<b>112</b>	
<b>KIPO</b>	<b>Jan. 2008</b>	<b>709 134 (Pilot) 575 (Full)</b>	<b>Total</b>
<b>CIPO</b>	<b>Jan. 2008</b>	<b>36</b>	<b>4105</b>
<b>IPAU</b>	<b>April 2008</b>	<b>41</b>	
<b>EPO</b>	<b>Sept. 2008</b>	<b>203</b>	
<b>DKPTO</b>	<b>Nov. 2008</b>	<b>48</b>	
<b>DPMA</b>	<b>April 2009</b>	<b>26</b>	
<b>IPOS</b>	<b>Feb 2009</b>	<b>1</b>	
<b>NBPR</b>	<b>July 2009</b>	<b>1 1</b>	

1. 為達成美國專利局局長設定的 2011 年目標，USPTO 會積極向外推動 PPH 的合作，且與美方會談時其亦口頭表示我國是該局希望合作的對象，但是由於目前我國專利法 49 條對於申請人主動提出修正有時點的限制，因此在專利法修正案尚未通過施行前，申請人要主動提出充分相對應的申請專利範圍會受到法律的限制，這部分美方於會談時說明，此為雙方 PPH 合作的法規障礙，美方亦詳細詢問我國目前專利法修法進度。
2. 基於美國專利局可能會提出與我國洽談 PPH 合作，以下針對若是兩局

進行 PPH 合作之 SWOT 分析：

內部優勢	內部劣勢
<ul style="list-style-type: none"> <li>◇ 藉此提升本局專利實質合作的能力。</li> <li>◇ 藉此可提升審查人員對於美國專利制度的基本瞭解。</li> <li>◇ PPH 制度由於必須符合申請專利範圍“充分相對應”的條件，因此審查人員對於此類案件審查所需花費的時間應該相較目前 AEP 降低。</li> <li>◇ 藉此可能可加強與美國專利審查實質面的相互學習和交流。</li> </ul>	<ul style="list-style-type: none"> <li>◇ 必須增加 PPH 制度專利行政系統之控管程式。</li> <li>◇ 我國審查人員意見會被申請人翻譯拿去主張美國 PPH 案，因此審查意見程度將被 USPTO 實質評估。</li> <li>◇ 對於特定領域(如液晶面板)，勢必會增加更多等待加速審查案件，使非加速審查案件審查延宕情況可能嚴重化。</li> <li>◇ 必須對於進入 PPH 制度後允許申請人修正的標準，相較於 USPTO 進行我國政策決定和實質效益評估。</li> </ul>
外部機會	外部威脅
<ul style="list-style-type: none"> <li>◇ 可為我國和專利大局 USPTO 進行專利實質合作的一大進展。</li> <li>◇ USPTO 已與多個國家進行過 PPH 合作簽定，因此若是與本局簽訂，該國相同豐富經驗可使合作協議達成迅速。</li> <li>◇ 對於申請人而言，多一項加速審查的選擇性。</li> <li>◇ 對於代理人而言，多一項加速審查的措施可以對申請人宣導使用，也協助我國代理人能有較多的管道</li> </ul>	<ul style="list-style-type: none"> <li>◇ 我國目前專利審查積案嚴重且結案速度平均晚於 USPTO，若進行 PPH 合作，特定已經積案嚴重的審查科別，勢必會造成更大壓力。</li> <li>◇ 我國目前已經有 AEP 制度，且 AEP 制度比起 PPH 制度來的有彈性且可受理案件較廣，因此兩制度若同時運行，且均沒有需要繳交額外申請費用，評估申請人選擇 PPH 來進行加速審查案件數將不多。</li> </ul>

瞭解美國的 PPH 制度，進而利用。  
◇ 因此可能進入複邊 PPH 合作經驗分享。

◇ 我國為第一申請局時，會有來自外界需加速審查之壓力。

3. 為 PPH 合作在本局清理積案計畫漸漸均上軌道後，整體上和美國進行 PPH 合作是本局國際化很好的機會，惟如何能夠運用上述分析預先培養本局優勢、補強劣勢，以掌握外部環境的機會並降低威脅，提供以下幾點為協議 PPH 合作規劃列入考量之建議：

- i. 可藉由規畫 PPH，將 AEP 和 PPH 作產品措施區別性，例如，因為 PPH 要求申請專利範圍“充分相對應”較為嚴格，因此 AEP 若是保留目前僅為“相同發明”之受理原則，可對外說明因為此種案件審查負擔較大，AEP 可藉此評估考慮收費。
- ii. 另外，由於我國並未參與 PCT，因此美國與我國談 PPH 雙邊合作，應該會著重 Paris-PPH，但是對於 PCT 國際階段的工作成果，我國可以藉此評估其利用度，例如加入 AEP 可受理的事由二範圍，亦可對於目前已有代理人反應本局是否也能參考 PCT 國際階段的工作成果進行加速審查的意見藉此機會進行採納回應，由於事由二目前請求案件數較少，惟其實際上因為要求申請人提出說明為何在我國應該獲准專利的理由，因此實際上此類事由二對於審查人員實質幫助可能較大，應該鼓勵此類加速審查案件申請。
- iii. 由於 PPH 要求申請專利範圍必須“充分相對應”，依據我國目前專利法的第 49 條對於申請人主動修正的時點限制，的確具有執行 PPH 上的障礙，惟轉化劣勢為優勢，此亦可成為我國正式執行 PPH 的緩衝，即在專利法修正案尚未通過施行前，本局還有時間做內部程序或是專利行政系統等規劃因應，因此建議可以大膽接受建立台美

PPH國際合作協議，在雙邊合作關係下，申請人可先以我國核准案到USPTO進行PPH申請，協助USPTO增加PPH申請件數，至於申請人以美國核准案到TIPO進行PPH申請的生效日期，可待我國專利法修正案通過施行後生效，如此可共創雙贏的局面。另有關上述建議，亦即簽訂雙邊但是僅是先行單向執行，美國與韓國已有先例，KIPO目前和美國已經簽訂PCT-PPH協定，但是因為KIPO的加速審查規定係訂定於韓國專利法施行細則，由於細則修正程序尚未完成而無法受理，因此KIPO與USPTO間的PCT-PPH，目前僅是USPTO單向接受KIPO的PCT工作成果。

- iv. 由於PPH制度是申請人主動啟動向特定專利局提出，因此有關於專利審查意見等語言翻譯問題，均係由申請人自行翻譯，再向特定專利局提出，因此執行PPH合作之專利局無須擔心語言翻譯問題；但是就再增加一項加速審查PPH措施，本局專利行政流程和資訊系統勢必要另有執行和管控系統，此部分必須要提早進行設計規劃，才不至於額外增加審查人員太多負擔。

# 第五章、附錄

## (一)Paris-PPH 與 PCT-PPH 申請條件要求比較表

PROCEDURAL REQUIREMENTS	PARIS (REGULAR)	PCT-PPH
Request Form	(PTO/SB/20OFF)	PTO/SB/20/PCT-OFF PCT/SB/20/PCT (where USPTO is ISA or IPEA)
Petition Fee	Petition fee under 37 CFR 1.17 eliminated	Petition fee under 37 CFR 1.17 eliminated
Substantive Examination	Must not have begun at OSF	Must not have begun at OSF
Claims	OFF application(s) have at least one claim that was determined by the OFF to be allowable/patentable.	WO/ISA, WO/IPEA, or the IPER, indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability.  If observation is described in Box VIII of the WO/ISA, WO/IPEA, or IPER, <b>must</b> identify and explain why the claim(s) is/are not subject to any observation described in Box VIII irrespective of whether an amendment is submitted to correct the observation described in Box VIII.
Sufficiently Correspond	Yes  must sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope as allowed claims in OFF.	Yes  must sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are the same or similar scope or narrower as the claims indicated as having novelty, inventive step and industrial applicability <u>and free of</u> any observation described in Box VIII in the <u>latest</u> work product of the corresponding PCT application  <u>Narrower</u> claims must be written in dependent form

PROCEDURAL REQUIREMENTS	PARIS	PCT-PPH
Claim Submission	copy of the allowable/patentable claims  an English translation thereof and  statement that the English translation is accurate if the claims are not in the English language.  <b>Note:</b> If the OFF Office action does not explicitly state that a particular claim is allowable, applicant must include a statement in the request for participation in the PPH pilot program or in the transmittal letter accompanying the request for participation that no rejection has been made in the OFF Office action regarding that claim, and therefore, the claim is deemed allowable by the OFF	copy of the claims indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application  English translation thereof and  statement that the English translation is accurate if the claims are not in the English language
Claim Correspondence Table	Yes, required in English  must indicate how all the claims in the U.S. application correspond to the allowable/patentable claims in the OFF application(s).	Yes, required in English  must indicate how all the claims in the U.S. application sufficiently correspond to the claims indicated as having novelty, inventive step and industrial applicability in the latest international work product



PROCEDURAL REQUIREMENTS	PARIS	PCT-PPH
<b>Office Actions</b>	<p>a copy of all the Office actions (which are relevant to patentability) from each of the OFF application(s) containing the allowable/patentable claims that are the basis for the request,</p> <p>English translation and</p> <p>a statement that the English translation is accurate.</p> <p>NOTE: must submit copies of any Office actions (which are relevant to patentability) from the OFF application(s) issued after the grant of the request for participation in the PPH pilot program in the USPTO (especially where OFF might have reversed a prior holding of allowability).</p>	<p>must submit a copy of the latest international work product, WO/ISA, WO/IPEA or IPER, which indicated that the claim(s) has/have novelty, inventive step and industrial applicability</p> <p>English translation.</p> <p>statement that the English translation is accurate is not required.</p> <p>Where documents have been previously filed in the U.S. application, may simply refer to these documents and indicate they were previously filed in the U.S. application.</p> <p>Where the U.S. application is the national stage application of the PCT application, need not submit a copy of the latest international work product along with an English translation thereof since a copy of these documents is already contained in the file wrapper of the U.S. application.</p>

PROCEDURAL REQUIREMENTS	PARIS	PCT-PPH
<b>I.D.S.</b>	<p>must submit an information disclosure statement (IDS) listing the documents cited by the OFF examiner in the OFF Office action</p> <p>(unless such an IDS has already been filed in the U.S. application)</p>	<p>must submit an information disclosure statement (IDS) listing the documents cited in the international work products of the PCT application</p> <p>(unless such an IDS has already been filed in the U.S. application, in which case applicant may simply refer to the previously filed IDS and indicate in the request for participation in the PCT-PPH pilot program when the IDS was previously filed in the U.S. application).</p>
<b>Copies of cited documents</b>	<p>must submit copies of all the documents cited in the OFF Office action</p> <p>(unless the copies have already been filed in the U.S. application) except U.S. patents or U.S. patent application publications.</p>	<p>must submit copies of all the documents cited in the international work products of the PCT application corresponding to the U.S. application</p> <p>(unless the copies have already been filed in the U.S. application, in which case applicant may simply refer to the previously filed copies of the documents and indicate in the request for participation in the PCT-PPH pilot program when the copies were previously filed in the U.S. application) except U.S. patents or U.S. patent application publications.</p>
<b>E.F.S. Web Filing</b>	Required	Required

## (二)USPTO 之工作分享計畫

USPTO WORKSHARING PROGRAMS AND PROPOSALS

Program Name	Description of Program	Effective Dates	Applicant or Office Initiated	Program Fees	Terms of Acceleration
<b>Patent Prosecution Highway (PPH)</b>  <b>(Paris Route)</b>	<p>When at least one claim is determined to be allowable after examination in an Office of First Filing (OFF), an applicant may request that an Office of Second Filing (OSF) accelerate examination of corresponding claims. The OSF can utilize search and examination results from the OFF to accelerate examination, improve quality of examination, and avoid duplication of work.</p> <p>The PPH framework consists of numerous bilateral arrangements with IP Offices throughout the world. As of September 2010, the USPTO has 12 PPH Programs with key trading partners. To date, there have been over 3000 successful PPH requests with the USPTO.</p> <p>The USPTO is currently in negotiations with other Patent Offices to become PPH partners.</p> <p>For more information go to:  <a href="http://www.uspto.gov/patents/init_events/pph/index.jsp">http://www.uspto.gov/patents/init_events/pph/index.jsp</a></p>	<p><u>Permanent Programs</u></p> <p><u>Start Dates</u>            Japan- 1/4/08            Korea- 1/29/09</p> <p><u>Pilot Programs</u></p> <p><u>Start Dates</u>            UK- 9/4/07            Canada- 1/28/08            Australia- 4/1/08            EPO- 11/3/08            Denmark- 11/3/08            Germany- 4/27/09            Singapore- 2/2/09            Finland- 7/6/09            Hungary- 7/1/10            Russia-8/31/10</p> <p><u>Termination Dates</u>            Canada- 1/28/11            Germany- 4/27/11            Hungary- 7/1/11            Russia- 8/31/11</p>	Applicant Initiated	No Fees (Waived May 25, 2010)	<p>For PPH requests filed with the USPTO as the OSF, applications are placed in an accelerated examination track throughout the entire prosecution in the USPTO.</p> <p>For PPH requests to PPH partners with USPTO as the OFF, the terms of acceleration vary from Office to Office.</p>

Program Name	Description of Program	Effective Dates	Applicant or Office Initiated	Program Fees	Terms of Acceleration
<b>PCT Patent Prosecution Highway (PPH)</b>  <b>(PCT PPH)</b>	<p>When an applicant receives a written opinion or an international preliminary examination report from the Japan Patent Office (JPO), the European Patent Office (EPO) or the Korean Intellectual Property Office (KIPO) indicating that at least one claim in a PCT application has novelty, inventive step, and industrial applicability, the applicant may request that another Office, the Office of Second Filing (OSF), accelerate the examination of corresponding claims in a corresponding national phase application. The OSF can utilize search and examination results from the OFF to accelerate examination, improve quality of examination, and avoid duplication of work.</p> <p>Currently, the PCT PPH Program with EPO and JPO is bidirectional, <i>i.e.</i>, both Offices have agreed to provide reciprocal treatment with respect to participation in the program. The PCT PPH Program with KIPO is unidirectional, <i>i.e.</i>, requests can only be made to the USPTO as the OSF when KIPO has completed the required PCT work product.</p> <p>To date there have been over 180 successful PCT PPH requests filed with the USPTO. The USPTO is in negotiations with other Patent Offices to become PCT PPH partners.</p> <p>For more information go to:  <a href="http://www.uspto.gov/patents/init_events/pph/index.jsp">http://www.uspto.gov/patents/init_events/pph/index.jsp</a></p>	<p><u>Pilot programs</u></p> <p><u>Start Dates</u>            Japan- 1/29/10            EPO- 1/29/10            Korea- 6/1/10</p> <p><u>Termination Dates</u>            Japan- 1/28/12            EPO- 1/28/12            Korea- 5/31/12</p>	Applicant Initiated	No Fees (Waived May 25, 2010)	<p>For PPH requests filed with the USPTO as the OSF, applications are placed in an accelerated examination track throughout the entire prosecution in the USPTO.</p> <p>For PPH requests to PPH partners with the USPTO as the OFF, the terms of acceleration vary from Office to Office.</p>

Program Name	Description of Program	Effective Dates	Applicant or Office Initiated	Program Fees	Terms of Acceleration
<b>USPTO- KIPO (Korean Intellectual Property Office) Worksharing Pilot Program</b>	<p>According to the USPTO-KIPO Worksharing Program, when corresponding applications are filed in both offices, the USPTO and KIPO, the Office of First Filing (OFF) will conduct a search and examination and share its findings with the Office of Second Filing (OSF), such that the OSF can maximize re-use of the work performed by the OFF and minimize duplication of examination work.</p> <p>Over the course of 2010, about 325 commonly filed applications in battery, semiconductor, and fuel cell technologies have been selected for participation in the USPTO-KIPO Pilot Program.</p> <p>Applications that are first filed in KIPO represent a very significant portion of filings in the USPTO. Recent 2009 statistics indicate that over 21,700 applications are first filed in the KIPO.</p>	<p><u>Pilot program</u></p> <p><u>Start Date</u> 9/1/2009</p> <p>Completion of the pilot is expected in the spring of 2011.</p>	Office Initiated	No Fees	While the pilot inherently contains some elements of acceleration, there are <u>no</u> express terms of acceleration under the pilot program.

Program Name	Description of Program	Effective Dates	Applicant or Office Initiated	Program Fees	Terms of Acceleration
<b>USPTO-UKIPO (United Kingdom Intellectual Property Office) Worksharing Pilot Program</b>	<p>According to the USPTO-UKIPO Worksharing Pilot Program, when corresponding applications are filed in both offices, the USPTO and UKIPO, the UKIPO will conduct a search and share its findings with the USPTO through the <u>normal publication process</u> so that the USPTO can maximize re-use of the work performed by the UKIPO. After the USPTO completes its search and examination, the USPTO will make its work available through PUBLIC PAIR so that UKIPO can maximize re-use and minimize duplication of examination work conducted later in the prosecution.</p> <p>This pilot calls for maximizing re-use of currently available work done by each Office on commonly-filed applications to gauge the effectiveness and benefits of worksharing.</p> <p>Applications that are first filed in UKIPO represent a significant portion of filings in the USPTO. Recent 2009 statistics indicate that over 8,000 applications are first filed in the UKIPO. As for applications first filed with the USPTO, there are 1,200 filings with UKIPO that are first filed in the USPTO.</p>	<p><u>Pilot Program</u></p> <p>Agreement between the Offices was announced on March 3, 2010.</p> <p>Implementation is tentatively scheduled to commence in October 2010.</p>	Office Initiated	No Fees	While the pilot inherently contains some elements of acceleration, there are <u>no</u> express terms of acceleration under the pilot program.

Program Name	Description of Program	Effective Dates	Applicant or Office Initiated	Program Fees	Terms of Acceleration
<b>SHARE (Strategic Handling of Applications for Rapid Examination)/ FLASH (First Look Application Sharing) SHARE/FLASH Program</b>	<p>The FLASH program is a specific vehicle designed for implementing the SHARE concept in which Offices should focus examination efforts on applications for which they are the Office of First Filing (OFF). The FLASH Program is designed to maximize work-sharing among Patent Offices by establishing a notification system so that other Offices can benefit from early availability of search and examination results produced by the USPTO. In this Pilot, the FLASH Program leverages the existing priority document exchange system created by the Trilateral Offices—European Patent Office (EPO), Japan Patent Office (JPO) and USPTO.</p> <p>When an applicant files an application with the USPTO and then files a corresponding application with another Trilateral Office claiming priority to the US application, the applicant can then request the US priority document via the existing Priority Document Exchange (PDX) system. This request for the USPTO priority document in JPO and EPO will serve as a trigger to alert the USPTO that it is the Office of First Filing (OFF). The USPTO will then expedite the search and examination of the identified application in an effort to provide early results for the JPO and EPO. The USPTO will also notify the Trilateral Offices when the examination results are available, and will make those results available via the File Wrapper Access (FWA)/Public Patent Application Information Retrieval (PAIR) tools.</p> <p>Initially, the program will be limited to about 100 applications per month per Trilateral office.</p>	<p><u>Pilot Program</u></p> <p><u>Start Dates</u> Implementation is tentatively scheduled to commence in the fall of 2010.</p> <p>The Pilot is scheduled for one year.</p>	Office Initiated	No Fees	<p>The goal is to accelerate search and examination in the USPTO, as the OFF, so that the results are available to the OSF at 18-22 months from USPTO filing.</p> <p>When USPTO examiners are notified under the FLASH system that the USPTO is an OFF, examiners will be asked to expedite examination and prepare a first action on the merits within approximately 3 months from notification.</p>

**JAPAN PATENT OFFICE (JPO) WORKSHARING PROGRAMS**

Program Name	Description of Program	Effective Dates	Applicant or Office Initiated	Program Fees	Terms of Acceleration
<b>JP-Fast Information Release Strategy (JP-FIRST)</b>	<p>The JP-FIRST Program embraces the SHARE concept in which Offices focus examination efforts on applications for which they are the Office of First Filing (OFF) so that other Offices may benefit by the early availability of search and examination results. According to the JP-FIRST Program, the search and examination results are produced by the JPO as the Office of First Filing (OFF) before the Offices of Second Filing (OSF), start examination of corresponding applications. The OSF can benefit by the work product produced by the JPO in order to enhance efficiencies and accelerate examination in their respective Offices.</p> <p>JPO will <u>rearrange the order</u> in which regular applications are examined by prioritizing those applications first filed in the JPO and then filed in the OSF. More specifically, JPO prioritizes applications in the following manner: (1) filed with the JPO and are the basis for priority under the Patent Convention 2) for which examination is requested within 2 years of the JPO filing date.</p>	<p><u>Start Date</u> April 2008</p>	Office Initiated Note: Applicant must request examination within 2 years from JPO filing date.	No Fees	<p>As the OFF, the JPO search and examination results will be available within 30 months of filing in JPO.</p> <p>Prioritization is accomplished by rearranging the order in which applications meeting the requirements are examined.</p>

EUROPEAN PATENT OFFICE (EPO) WORKSHARING PROGRAMS

Program Name	Description of Program	Effective Dates	Applicant or Office Initiated	Program Fees	Terms of Acceleration
Programme for Accelerated Prosecution of European Patent (PACE)	<p>The PACE Program embraces the SHARE concept in which Offices focus examination efforts on applications for which they are the Office of First Filing (OFF), so that other Offices may benefit by the early availability of search and examination results. Under the PACE Program, if an application filed with the EPO does not contain a priority claim, then the search is <u>automatically accelerated</u>. If there is no priority claim upon filing, applicants are required to check a box on the application form indicating that there is no intention of filing a priority claim. According to the EPO, approximately 20 percent of their filings do not contain a claim for priority.</p> <p>Another feature of the PACE Program is an applicant-driven acceleration process for applicants who want their applications processed rapidly. These applicants must make a request and agree to comply with stringent deadlines.</p>	<p><u>Permanent Program</u></p> <p><u>Start Date</u> Jan. 1, 1995</p>	<p>The PACE Program is Office driven for situations when EPO focuses examination on applications that do not contain priority claims.</p> <p>All applicant requests for acceleration must go through PACE, including PPH requests.</p>	No Fees	<p>When EPO is considered the Office of First Filing (OFF), only the search is accelerated. EPO rules set forth that a search report should be available within six months of the filing date in EPO.</p> <p>The goal is to issue the first action within 3 mos. of receipt by the examining division or the request for acceleration, whichever is later. EPO aims to produce subsequent communications within 3 mos. of applicant's reply, provided it was timely filed and deals with all points raised.</p> <p>There are no express terms of acceleration under UPP. Moreover, the EPO will not delay examination if the search results are not submitted before the application is due for examination in the EPO.</p>
Utilisation Pilot Project (UPP)	<p>Under the UPP, an applicant claiming priority to a previous application must file a copy of the results of any search carried out by or on behalf of the authority with which the previous application was filed, i.e., the Office of First Filing (OFF). The search results must be filed together with the European patent application or, if a <del>Euro-PCT</del> PCT application, upon entry into the European phase. The EPO will then utilize the search results produced by the OFF.</p>	<p><u>Permanent Program</u></p> <p><u>Start Date</u> January 2011</p>			

COLLABORATIVE WORKSHARING PROGRAMS

Program Name	Description of Program	Effective Dates	Applicant or Office Initiated	Program Fees	Terms of Acceleration
PCT COLLABORATIVE SEARCH (EPO, KIPO, USPTO)	<p>Designed to explore collaborative work between examiners of different offices, including 6 examiners and 12 PCT applications from each office, for a total of 36 applications.</p> <p>The EPO, KIPO, USPTO examiners will work together on PCT applications to create International Search Reports (ISRs) and Written Opinions of ISA (WO-ISA).</p> <p>The Office acting as ISA will develop a search strategy and optionally prepare a provisional ISR and WO-ISA. This Office will then will transmit the search strategy and, if applicable, the provisional ISR and WO-ISA to the peer examiners in other Offices. The peer examiners will comment/supplement the materials and may consult with the first examiner in the Office acting as ISA. After receiving feedback, the first examiner will establish a final ISR and WO-ISA to be transmitted to applicant.</p>	<p><u>Pilot Program</u></p> <p><u>Start Date</u> May 1, 2010</p> <p>Program concluded with workshop at USPTO held on Sept. 8-9, 2010.</p>	<p>Office initiated. However, consent of applicant will be sought by USPTO</p>	No Fees	No terms of acceleration

### (三)USPTO 之加速審查計畫

#### USPTO PATENT EXAMINATION ACCELERATION PROGRAMS AND PROPOSALS

Program Name	Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<b>Accelerated Examination Program</b>	<p>Pursuant to the Accelerated Examination Program, an applicant may have an application granted accelerated examination status provided certain conditions are met. In order to receive accelerated treatment, applicants must file a petition to make special under 37 CFR 1.107 entitled "Advancement of examination."</p> <p>Key requirements include the following:                      (1) the application must be filed via EFS-Web with a petition to make special along with (a) required petition fee or (b) a statement that the claimed invention is directed to environmental quality, development or conservation of energy resources, or counter terrorism;                      (2) the application must be complete and in condition for examination;                      (3) the application must contain three or fewer independent and twenty or fewer total claims, and must not contain any multiple dependent claims;                      (4) the claims must be directed to a single invention;                      (5) the petition must include a statement agreeing to have an interview;                      (6) applicant must provide a statement that a pre-examination search was conducted that meets certain requirements; and                      (7) applicant must provide an accelerated examination support document that satisfies certain requirements.</p> <p>See MPEP § 708.02(a).  <a href="http://www.uspto.gov/patents/process/file/accelerated/index.jsp">http://www.uspto.gov/patents/process/file/accelerated/index.jsp</a></p>	<p>Permanent Program</p> <p><u>Start Date</u> Aug. 25, 2006</p>	<p>Complete Examination Support Document Required</p>	<p>US \$130 Petition Fee to Request Accelerated Examination</p> <p>No petition fee required for inventions that will enhance the quality of the environment, relate to the development or conservation of energy resources or, contribute to counterterrorism.</p>	<p>Goal is to complete examination of an application within 12 months from the filing date of the application.</p> <p>Applications are placed on an accelerated examination track throughout the entire prosecution in the USPTO.</p>

Program Name	Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<b>Green Technology Pilot Program</b>	<p>The Green Technology Pilot Program permits applicants to request accelerated examination for applications pertaining to clean technologies, such as environmental quality, energy conservation, development of renewable energy resources, and greenhouse gas emission reductions. In order to receive accelerated treatment, applicants must file a petition to make special under 37 CFR 1.107 entitled "Advancement of examination."</p> <p>Some key requirements include the following:                      (1) the application must be filed before December 8, 2009;                      (2) the application must contain three or fewer independent claims and twenty or fewer total claims, and must not contain any multiple dependent claims;                      (3) the claims must be directed to a single invention that materially enhances the quality of the environment;                      (4) the petition must include a statement explaining how the materiality standard is met if it is not clear on its face from the application disclosure;                      (5) the petition must be filed via EFS-Web; and                      (6) the petition must be accompanied by a request for early publication and the publication fee.</p> <p>An initial classification requirement was removed on May 21, 2010, allowing more inventions related to green technologies to qualify.</p> <p><a href="http://www.uspto.gov/patents/init_events/green_tech.jsp">http://www.uspto.gov/patents/init_events/green_tech.jsp</a></p>	<p>Pilot Program</p> <p><u>Start Date</u> Dec. 8, 2009</p> <p><u>Termination Date</u> Dec. 8, 2010, or when the first 3,000 grantable petitions are filed, whichever is earlier</p>	<p>Not Required</p>	<p>No Fees</p>	<p>Applications will be placed on an accelerated examination track in the following situations:                      (1) prior to the first communication on merits, <i>i.e.</i>, first Office action;                      (2) any appeal to the Board of Patent Appeals and Interferences; and                      (3) the patent publication process.</p>

Program Name	Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<b>Project Exchange or Patent Application Backlog Reduction Stimulus Plan</b>	<p>The Project Exchange Program was initially designed to allow small-entity applicants having multiple applications pending before the USPTO to have an application accorded accelerated examination status if the applicant expressly abandons another co-pending unexamined application. In order to receive accelerated treatment, applicants must file a petition to make special under 37 CFR 1.107 entitled "Advancement of examination."</p> <p>Some of the key requirements include the following:</p> <p>(1) the non-provisional application for which accelerated status is sought must be filed before October 1, 2009;</p> <p>(2) the applicant has another co-pending non-provisional application that has an actual filing date earlier than October 1, 2009, and is complete;</p> <p>(3) the application for which accelerated status is sought and the other co-pending application either are owned by the same party as of October 1, 2009, or name at least one inventor in common; and</p> <p>(4) the applicant files a letter of express abandonment in the co-pending application before it has been taken up for examination.</p> <p>The small-entity status requirement was removed on June 24, 2010 to increase participation in the Program.</p> <p><a href="http://www.uspto.gov/patents/init_events/PatentStimulusPlan.jsp">http://www.uspto.gov/patents/init_events/PatentStimulusPlan.jsp</a></p>	<p>Pilot Program</p> <p><u>Start Date</u> Nov. 27, 2009</p> <p><u>Termination Date</u> Dec. 31, 2010 or when 10,000 applications have been granted accelerated status under this program, whichever is earlier</p>	Not Required	No Fees	<p>Applications will be placed on an accelerated examination track in the following situations:</p> <p>(1) prior to the first communication on merits, <i>i.e.</i>, first Office action;</p> <p>(2) any appeal to the Board of Patent Appeals and Interferences; and</p> <p>(3) the patent publication process.</p>

Program Name	Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<b>Applicant's Age or Health</b>	<p>Applications may be accorded accelerated examination status based on an applicant's age or health. In order to receive accelerated treatment, applicants must file a petition to make special under 37 CFR 1.107 entitled "Advancement of examination."</p> <p>Key requirements include a petition with accompanying evidence showing that (1) the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor's certificate or other medical certificate or (2) that the applicant is 65 years of age or older.</p> <p>See 37 CFR 1.102(c).</p>	<p>Permanent Program</p> <p><u>Start Date</u> Circa December, 1959</p>	Not Required	No Fees	<p>Applications are placed on an accelerated examination track throughout the entire prosecution in the USPTO.</p>

Program Name	Description of Program	Effective Dates	Examination Support Document	Program Fees	Terms of Acceleration
<b>Three-Track Proposal</b>	<p>The Three-Track Proposal would permit applicants to choose one of three "tracks" for patent examination. The proposal would provide applicants with greater control over the timing of examination and increase the efficiency of examination by avoiding or reducing duplication of efforts by the Office of First Filing and the USPTO.</p> <p><u>Track I (accelerated examination)</u> Applicants who submit a request and pay an additional fee will have their application placed in an accelerated queue for examination. Applicants would expect to receive a first Office action on the merits within 4 months. Final disposal (allowance or final rejection) would be expected to occur within 12 months of accelerated status being granted.</p> <p><u>Track II (standard or traditional timing for examination)</u> This option will involve standard fees and will proceed under current examination procedures.</p> <p><u>Track III (applicant controlled up to 30 months queue prior to docketing for examination)</u> Non-continuing applications that originate in the United States may have examination delayed for up to 30 months.</p> <p>For United States applications that are based on a prior foreign application, no action would be taken until the applicant submits a copy the search report from the foreign office (if any), a copy of the first action on the merits from the foreign office, and an appropriate reply to the foreign office action. After these items are received, the applicant could request prioritized examination or obtain standard processing under Track II.</p> <p>See 75 FR 31763 (June 4, 2010). <a href="http://www.uspto.gov/news/pr/2010/10_24.jsp">http://www.uspto.gov/news/pr/2010/10_24.jsp</a></p>	Proposal	Not Required	Applications in Track I would require a cost recovery fee.	<p>The goal for handling applications in Track I would be to provide a first Office action on the merits within 4 months and a final disposition within 12 months of accelerated status being granted.</p>