

## **New Route Pilot Project between the United States Patent and Trademark Office and the Japan Patent Office**

### **Background**

The United States Patent and Trademark Office (USPTO) and the Japan Patent Office (JPO) have been considering a proposal for work-sharing called the "New Route." Under the New Route framework, a filing in one office that is party to this arrangement would be deemed a filing in all member offices. The first office and applicant would be given a 30-month processing time frame in which to make available a first office action and any necessary translations to the second office(s), and the second office(s) would exploit the search and examination results in conducting their own examination. The first office would also be responsible for 18-month publication of the application. If the language of the first office is not English, an English language abstract and bibliographic data would be published together with the application. By allowing the second office to exploit the search and examination results of the first office, the New Route would help offices reduce overall workload, minimize duplication of search efforts, and increase examination quality.

While the New Route is in many respects similar to the Patent Cooperation Treaty (PCT) (a 30-month processing period, a single filing treated as a filing in several countries, a search report available to "designated" offices, etc.), it may further offer significant advantages to applicants; in particular, lower costs and more targeted filings.

Because the New Route, as envisioned, would require changes in law in the USPTO and the JPO, the USPTO and the JPO agreed, at the May 2007 Trilateral Technical Meeting, to commence a pilot project to test the New Route concept based on the two filing scenarios currently available under existing law in both offices. The two filing scenarios eligible to participate in the New Route pilot project are:

- (1) A priority application is filed in the first office and a PCT application claiming priority to that application is filed with the same first office as the PCT receiving Office; if the search and examination results of the priority application are available within about 26 months from its filing date and the corresponding PCT application enters the national stage in the second office, that national stage application would be eligible to participate in the New Route pilot project based on the examination of the priority application; and
- (2) A PCT application is filed with the PCT receiving Office of the first office (there is no priority application), then the PCT application enters the national stage early in the first office; if the search and examination results on the national stage application are available by about the 26th month from the international filing date, and the PCT application enters the national stage in the second office at the 30th month, that national stage application in the second office would be eligible to participate in the New Route pilot project based on the examination of the national stage application in the first office.

Where the USPTO is the office of first filing (OFF) and the JPO is the office of second filing (OSF), the U.S. applicant may request participation in the New Route pilot project in the JPO as the OSF. The procedures and requirements for filing a request in the JPO for participation in the New Route pilot project are available from the JPO web site at: [http://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/japan\\_usa\\_newroute\\_e.htm](http://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_usa_newroute_e.htm).

An applicant must notify the USPTO as the OFF that the applicant wishes to participate in the New Route pilot project in the JPO as the OSF by following the procedures set forth in item B. below. The fact that the applicant notifies the USPTO as the OFF that he/she wishes to participate in the New Route pilot project in the JPO as the OSF will not guarantee that the USPTO will have the search and examination results available for the application filed in the USPTO within the 26-month period. To ensure that the application filed in the USPTO will have the search and examination results available within the 26-month period, the applicant may wish to take the necessary steps available at the USPTO to advance the examination (e.g., 37 CFR 1.102 and MPEP 708.02(a)). The USPTO will notify the applicant whether the application is selected as a candidate application. The USPTO will send a list of candidate applications to the JPO periodically.

Where the USPTO is the OSF and the JPO is the OFF, an applicant must notify, in advance, the JPO as the OFF that the applicant wishes to participate in the New Route pilot project in the USPTO as the OSF by following the procedures available from the JPO web site at: [http://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/japan\\_usa\\_newroute\\_e.htm](http://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_usa_newroute_e.htm). Once the applicant receives a notice of selection from the JPO, the applicant may request participation in the New Route pilot project in the USPTO and petition to make the U.S. national stage application submitted under 35 U.S.C. 371 special under the New Route pilot project if the requirements set forth in item C. below are satisfied. Note that the procedures for a petition to make special under the accelerated examination program set forth in MPEP 708.02(a) do NOT apply to a petition to make special under the New Route pilot project where the USPTO is the OSF.

#### **A. Trial Period for the New Route Pilot Project**

The New Route pilot project will commence in both offices on January 28, 2008. The pilot project will be terminated once 50 applications have been accepted into the pilot project by each office as the OSF or the expiration of one year (January 28, 2009), whichever occurs first. Notice will be published if the pilot project will be terminated before January 28, 2009 (i.e., when 50 applications have been accepted into the pilot project by each office).

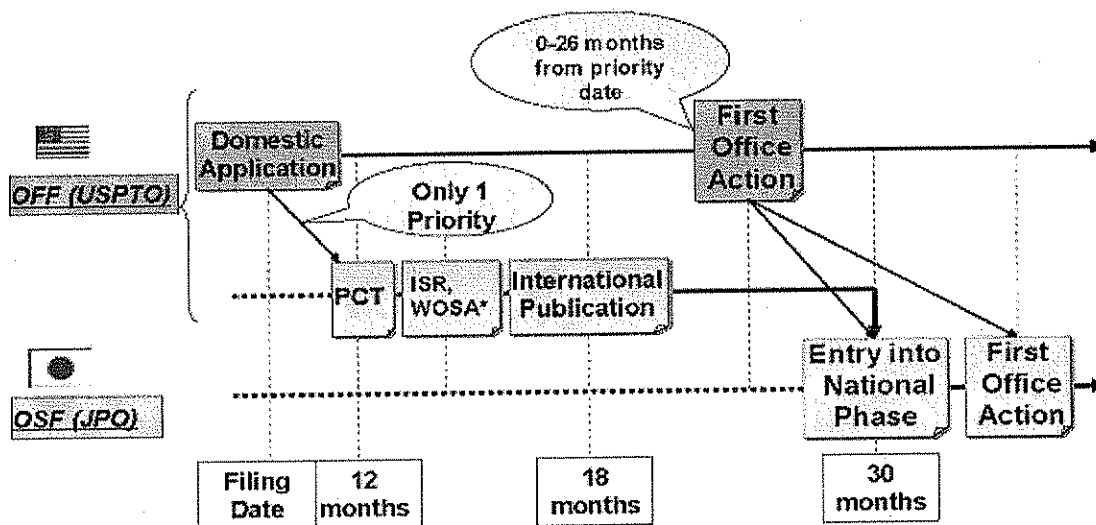
#### **B. Notification to the USPTO as the OFF that Applicant Wishes to Participate in the New Route Pilot Project**

USPTO as the OFF and JPO as the OSF:

A PCT application (for which the USPTO is OFF and the JPO is OSF) that satisfies all of the following requirements (1), (2), (3), and (4) qualifies for the New Route pilot project.

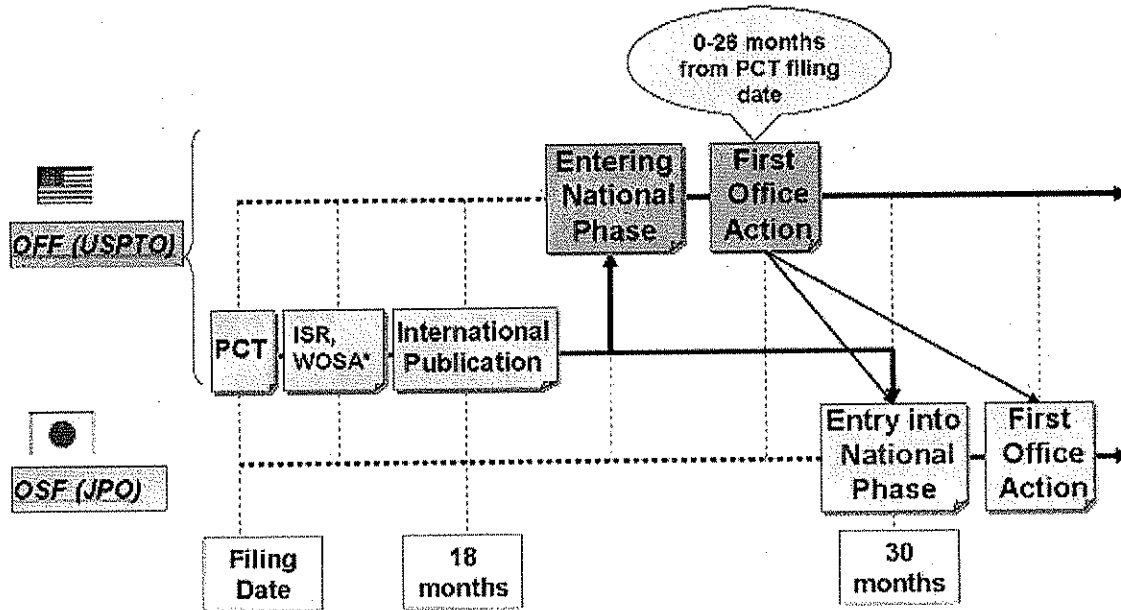
- (1) The PCT application (with a priority claim to a U.S. application filed under 35 U.S.C. 111(a)) is filed with the USPTO (See Case 1) or the PCT application has been filed directly (without a priority claim) with the USPTO (See Case 2).
- (2) The PCT application has not entered the national phase in the JPO.
- (3) A first action on the merits by the USPTO
  - (i) for the U.S. application filed under 35 U.S.C. 111(a) is/will be completed within 26 months from the filing date of that U.S. application (from which the PCT application claims priority) (See Case 1), or
  - (ii) for the U.S. national stage application submitted under 35 U.S.C. 371 is/will be completed within 26 months from the filing date of the PCT application (filed directly with the USPTO) (See Case 2).
- (4) The PCT application does not have multiple priority claims (i.e., a maximum of one priority claim is permitted).

### Case 1: USPTO as OFF and JPO as OSF



\* WOSA stands for Written Opinion by ISA

## Case 2: USPTO as OFF and JPO as OSF



\* WOSA stands for Written Opinion by ISA.

“ISR” in the flowchart denotes International Search Report and “ISA” denotes International Searching Authority.

If the application qualifies for the New Route pilot project and the applicant wishes to participate in the pilot project, the applicant must submit a letter to the USPTO as the OFF notifying the USPTO that the applicant wishes to participate in the New Route pilot project. The letter must identify the U.S. and PCT application numbers and whether a first action on the merits for the U.S. application was/will be available no later than 26 months from the U.S. filing date for Case 1 above or from the filing date of the PCT application for Case 2 above. The USPTO will notify applicant whether his/her application has been selected. A list of the selected applications will be periodically sent to the JPO.

The applicant’s letter to the USPTO indicating his/her desire to participate in the New Route pilot project must be faxed to the Office of the Commissioner for Patents at 571-273-0125, directed to the attention of Magdalen Greenlief.

**C. Requirements for Requesting Participation in the New Route Pilot Project in the USPTO as the OSF**

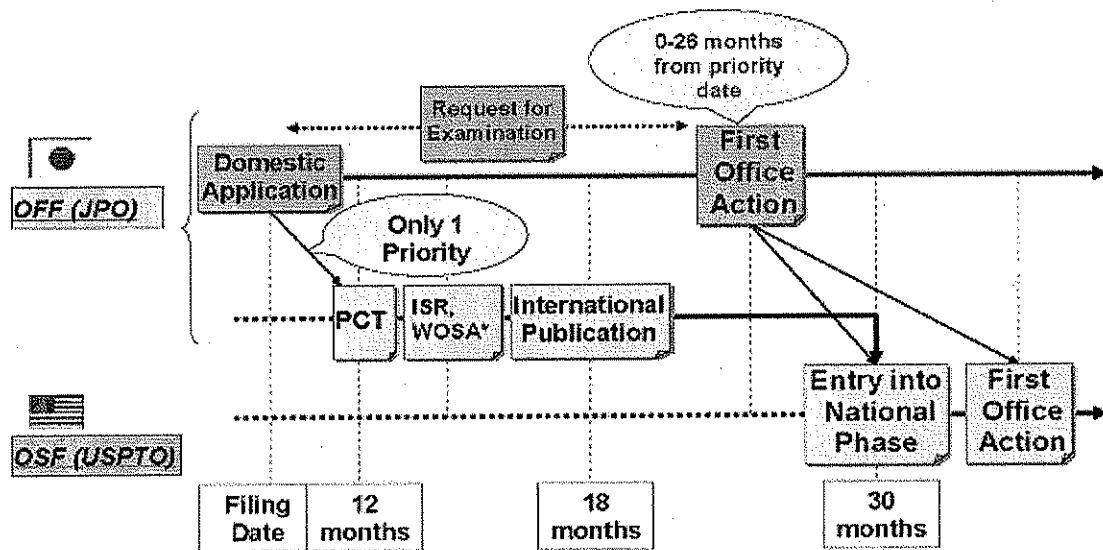
In order to be eligible to participate in the New Route pilot project in the USPTO as the OSF, the following conditions must be met:

(1) The U.S. application is a national stage entry of a PCT application filed with the JPO as the PCT receiving Office.

- (a) The PCT application must either
  - (i) contain a priority claim to a single priority application filed in the JPO, or
  - (ii) contain no priority claim.

(b) If the PCT application contains a priority claim to a single priority application filed in the JPO, a first action on the merits (search and examination results) for the priority application must be available no later than 26 months from the priority date.

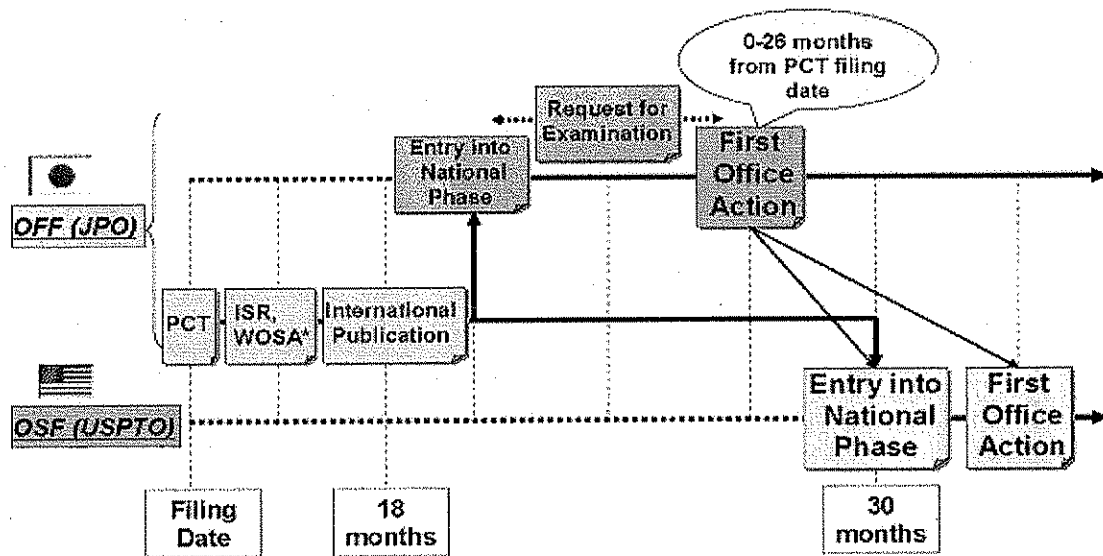
**Case 1: JPO as OFF and USPTO as OSF**



\* WOSA stands for Written Opinion by ISA.

(c) If the PCT application contains no priority claim, the PCT application must have entered national stage early in the JPO and a first action on the merits (search and examination results) for the national stage application in the JPO must be available no later than 26 months from the international filing date.

### Case 2: JPO as OFF and USPTO as OSF



\* WOSA stands for Written Opinion by ISA.

“ISR” in the flowchart denotes International Search Report and “ISA” denotes International Searching Authority.

(2) Applicants must separately submit the following items at the same time as entry into the national stage of the PCT application in the USPTO:

- (a) A request for participation in the New Route pilot project and a petition to make the U.S. national stage application special under the New Route pilot project accompanied by the appropriate fee (a sample request/petition form (PTO/SB/10) is attached to this notice which applicants are encouraged to use; the petition fee is under 37 CFR 1.17(h) for a petition to make special under 37 CFR 1.102(d));
- (b) A copy of the first office action by the JPO and an English translation thereof;

(c) A copy of the claims searched and examined by the JPO and an English translation thereof;

(d) A statement that the translations are accurate;

(e) An information disclosure statement listing the documents cited by the JPO examiner in the JPO office action (if appropriate) together with copies of all the documents except U.S. patents or U.S. patent application publications.

(3) The request for participation in the New Route pilot project and all the supporting documents (items (2)(a) to (e) noted above) must be faxed to the Office of the Commissioner for Patents at 571-273-0125, directed to the attention of Magdalen Greenlief. Note that the requirements for national stage entry of the PCT application under 35 U.S.C. 371 must NOT be transmitted to the USPTO using the facsimile transmission method identified in this paragraph.

If the request for participation in the New Route pilot project and special status are granted, applicant will be notified and the U.S. national stage application filed under 35 U.S.C. 371 will be advanced out of turn for examination. In those instances where the request for participation in the New Route pilot project does not meet all the requirements set forth above, applicant will be notified and the defects in the request will be identified. Applicant will be given one opportunity to perfect the request in a renewed request for participation. If perfected, the request and special status will be granted, applicant will be notified and the U.S. national stage application will be advanced out of turn for examination. If the request is not perfected, applicant will be notified and the national stage application will await action in its regular turn.

Request for participation in the New Route pilot project and special status granted in the U.S. national stage application submitted under 35 U.S.C. 371 will not carry over to a continuing application. Continuing applications of a U.S. national stage application or so-called bypass applications filed under 35 U.S.C. 111(a) which validly claim benefit under 35 U.S.C. 120 to a PCT application are not eligible to participate in the New Route pilot project.

#### **D. Special Examining Procedures in the USPTO as the OSF**

Once the request for participation in the New Route pilot project in the USPTO as the OSF and special status have been granted to the U.S. national stage application filed under 35 U.S.C. 371, the U.S. national stage application will be taken up for examination by the U.S. examiner before all other categories of applications except those clearly in condition for allowance; those with set time limits, such as examiner's answers; and those that have been granted special status for "accelerated examination."

The New Route pilot project does not absolve applicants of all their duties under 37 CFR 1.56 and 37 CFR 10.18. By complying with requirements C.(2)(b) to C.(2)(e) identified above, applicants would be considered to have complied with their duties to bring to the

attention of the USPTO any material prior art cited in the corresponding foreign application(s) (see MPEP § 2001.06(a)). Applicants still have a duty of candor and good faith, including providing to the USPTO other information known to them to be material to patentability.

Any inquiries concerning this notice may be directed to Magdalen Greenlief, Office of the Deputy Commissioner for Patent Examination Policy at 571-272-8800 or at [magdalen.greenlief@uspto.gov](mailto:magdalen.greenlief@uspto.gov).

Date: 1/24/2008

  
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John Doll  
Commissioner for Patents