

“Triway” Pilot Program among the United States Patent and Trademark Office, the European Patent Office, and the Japan Patent Office

I. Background

At the November 2005 Trilateral Pre-conference, the United States Patent and Trademark Office (USPTO) presented a search sharing proposal (“Triway”) that would leverage the searching expertise of each of the Trilateral Offices (European Patent Office (EPO), Japan Patent Office (JPO), and USPTO) to the benefits of both applicants and the Offices.

The basic concept behind the Triway proposal is to promote worksharing by eliminating certain timing issues, while at the same time providing applicants and the Offices with the benefit of search results of the Trilateral Offices being available within a certain short time period in order to give applicants and Trilateral Offices an opportunity to share and consider all of the Trilateral search results. This would help improve the resulting quality of any patents issued on the corresponding applications by each of the Trilateral Offices. The Triway proposal would complement other worksharing efforts such as the Patent Prosecution Highway Program.

Under the Triway proposal, each Office would conduct searches on corresponding applications filed under the Paris Convention in each of the Offices in a sufficiently early time period. The search results from each of the Offices would then be shared among the Offices in order to reduce the search and examination workload in each of the Offices.

The Trilateral Offices agreed at the November 2007 Trilateral Pre-conference to undertake a limited pilot program.

II. Triway Pilot Program

The Trilateral Offices agreed that the Triway pilot program be limited to 100 applications of diverse technologies, where the USPTO is the Office of first filing (OFF). In order to ensure that the 100 applications are from diverse technologies, the USPTO will accept 15 requests for participation in the Triway pilot program for U.S. applications assigned to each Technology Center.

A. Trial Period for the Triway Pilot Program

The Triway pilot program will commence on July 28, 2008. The pilot program will end on July 28, 2009, or upon the acceptance of 100 requests submitted to the USPTO as the OFF, whichever occurs first. The Trilateral Offices may terminate the pilot program early if the volume of participation in the pilot program is *de minimis*, or for any other reason. Notice will be published if the Triway pilot program will be terminated early.

B. Requirements for Requesting Participation in the Triway Pilot Program in the USPTO

In order to be eligible to participate in the Triway pilot program, the following conditions must be met:

- (1) An application must be filed or have recently been filed in the USPTO as the OFF. The U.S. application must be complete (37 CFR 1.51(b)) at the time of filing. Provisional applications, plant and design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order are excluded and not subject to participation in the Triway pilot program.
- (2) A corresponding application claiming priority to the U.S. application must be filed in the EPO and JPO as the Offices of second filing (OSF) under the Paris Convention within four (4) months from the filing of the application in the USPTO. The applications filed in the EPO and JPO as the OSF should be complete at the time of filing under the law and rules of the respective Offices.
- (3) The U.S., EP and JP applications must be limited to a single invention and the claims of the 3 applications must sufficiently correspond. Claims will be considered to sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope. EPO and JPO may determine whether the claims in the corresponding application filed in its respective office sufficiently correspond to the claims in the U.S. priority application when deciding whether to accept the request to participate in the Triway pilot program filed in its respective office.
- (4) Applicant must file a request for participation in the Triway pilot program and a petition to make the U.S. application special under the Triway pilot program. The requirements and procedures for petitions to make special set forth in MPEP § 708.02(a) **DO NOT** apply to the petition to make special under the Triway pilot program. A sample request/petition form (PTO/SB/12) will be available from the USPTO's Internet Web site at <http://www.uspto.gov> on July 28, 2008. The request/petition form must identify the corresponding EP and JP applications by application number and filing date. Applicants are encouraged to use the USPTO request/petition form. A petition fee under 37 CFR 1.17(h) for the petition to make special under 37 CFR 1.102(d) is required and must be submitted.
- (5) The request for participation in the Triway pilot program must be faxed to:

The Office of the Commissioner for Patents at 571-273-0125, directed to the attention of Magdalen Greenlief.

C. Special Procedures

(1) Once the request for participation in the Triway pilot program and special status have been granted to the U.S. application, the USPTO will notify the EPO and JPO of the corresponding applications (by application number and filing date) filed in each of their Offices.

(2) The USPTO will perform a search of the U.S. application and will issue a search report including search history recordation. The report will be in the form of a PCT/ISA/210 form (e.g., including X, Y, A designations) or equivalent thereof. To the extent practicable, the USPTO will fax a copy of the search report to the applicant within six (6) months after the filing of the U.S. application.

(3) Upon receipt of the USPTO search report by the applicant, applicant must promptly file a copy of the USPTO search report in the corresponding EP application.

(4) Applicant must request participation in the Triway pilot program in the EPO. Information regarding the Triway pilot program in the EPO is available on the EPO's Internet Web site at <http://www.epo.org/patents/law/legal-texts/InformationEPO/archiveinfo/20080716.html>.

(5) The EPO will conduct its Extended European Search Report (EESR) process and consider the art cited in the USPTO search report. The EPO will issue an EESR.

(6) Upon receipt of the EESR by the applicant, applicant must promptly file a copy of the EESR in the corresponding U.S. application. For the U.S. application, applicant must list the art cited in the EESR on an information disclosure statement (IDS) complying with 37 CFR 1.98.

A copy of the EESR and the IDS must be faxed to the Office of the Commissioner for Patents at 571-273-0125, directed to the attention of Magdalen Greenlief.

(7) Applicant must file a request for examination, a request for accelerated examination, including the statement of participation in the Triway pilot program in the JPO, as well as providing copies of the USPTO search report and the EESR. Information regarding the Triway pilot program in the JPO is available on the JPO's Internet Web site at http://www.jpo.go.jp/torikumi_e/t_torikumi_e/triway_e.htm.

(8) Upon granting the request for accelerated examination for the JP corresponding application, the JPO will conduct search and examination of the JP corresponding application. The JPO will consider the art cited in the USPTO search report and the EESR. The JPO will issue an office action for the JP corresponding application.

(9) Upon receipt of the JP office action, applicant must promptly file a copy of the JP office action in the corresponding EP and U.S. applications. For the U.S. application, an English translation of the JP office action along with a statement that the English

translation is accurate must also be submitted. In addition, applicant must list the art cited in the JP office action on an IDS complying with 37 CFR 1.98.

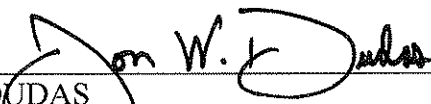
A copy of the JP office action, an English translation thereof, an accuracy statement, and the IDS must be faxed to the Office of the Commissioner for Patents at 571-273-0125, directed to the attention of Magdalen Greenlief.

(10) At this point, each of the corresponding applications will contain the search results from all three Offices (plus an examination result in the JPO). Since special status has been granted to the U.S. application, the U.S. application will be taken up for examination as special by the U.S. examiner. The U.S. examiner will consider the search results of all three Offices in the examination of the U.S. application. Applicants are encouraged to amend the claims in the U.S. application in view of the art cited by all three Offices.

The Triway pilot program does not absolve applicants of all their duties under 37 CFR 1.56 and 37 CFR 10.18. By complying with items C.(6) and C.(9) 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 applications (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.

Date: 7/14/08



JON DUDAS
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office