

USG Response to WIPO’s December 7, 2023 Request for Input on SCP Documents (Part II)

Topics	Updates
<p>(i) certain aspects of the applicable national or regional patent law, related to prior art, novelty, inventive step (non-obviousness), grace period, sufficiency of disclosure, exclusions from patentable subject matter and/or exceptions and limitations of the rights, available at: <a href="http://www.wipo.int/scp/en/annex_ii.html">http://www.wipo.int/scp/en/annex_ii.html</a>.</p>	<p>The U.S. does not currently have an update to this topic.</p>
<p>(ii) national and regional laws on opposition systems and other administrative revocation and invalidation mechanisms, available at: <a href="http://www.wipo.int/scp/en/revocation_mechanisms/">http://www.wipo.int/scp/en/revocation_mechanisms/</a>.</p>	<p>In June 2021, the USPTO implemented an interim process that allows a party to request review by the Director of the USPTO of a Patent Trial and Appeal Board (PTAB) final written decision in <i>inter partes</i> review (IPR) or post-grant review proceedings, and also provides the Director the option to <i>sua sponte</i> initiate the review of any PTAB decisions (at the Director’s discretion). In July 2023, the USPTO revised the interim process. The <a href="#">revised interim process</a> allows for parties to request review of the Board’s decisions to institute review, in addition to requests for review of the Board’s final written decisions or decisions granting rehearing. Until the process is formalized, the existing, revised interim Director review process will remain in place. The revised interim process has allowed the USPTO to quickly and efficiently implement <a href="#">United States v. Arthrex, Inc.</a>, a 2021 U.S. Supreme Court case holding that the PTAB’s final decisions must be subject to review by the Director. <i>See United States v. Arthrex, Inc.</i>, 141 S. Ct. 1970, 1986 (2021).</p>
<p>(iii) international worksharing and collaborative activities for search and examination of patent applications, available at: <a href="http://www.wipo.int/patents/en/topics/worksharing/">http://www.wipo.int/patents/en/topics/worksharing/</a>.</p>	<p>The USPTO enters into patent worksharing arrangements with foreign IP offices to improve patent examination efficiency and facilitate cooperation within the global patent system. Patent worksharing permits IP offices to collaborate in the examination of commonly filed patent application. The USPTO has various patent worksharing arrangements, including the Patent Prosecution Highway, Accelerated Patent Grant, Parallel Patent Grant, PCT Collaborative Search and Examination Pilot, and Expanded Collaborative Search Pilot. More information on this topic is available <a href="#">here</a>.</p>

<p>(iv) compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors, available at: <a href="https://www.wipo.int/scp/en/confidentiality_advisors_clients/national_laws_practices.html">https://www.wipo.int/scp/en/confidentiality_advisors_clients/national_laws_practices.html</a></p>	<p>The U.S. previously provided an update to this topic: <a href="#">Confidentiality of Communication between Clients and their Patent Advisors</a></p>
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