

REPORT

NEW PATENT PROSECUTION HIGHWAY PILOT PROGRAM BETWEEN UNITED STATES AND EUROPEAN PATENT OFFICES

October 3, 2008

The United States Patent and Trademark Office (USPTO) and the European Patent Office (EPO) announced a new Patent Prosecution Highway pilot program for expedited examination that is available to applicants whose convention priority applications were filed in one of those two patent offices. Under the program, an applicant receiving a ruling from either the USPTO or the EPO that at least one claim in a patent application is patentable may request that the other patent office accelerate the examination of corresponding claims in applications claiming priority to the application containing the patentable claim.

This new program may be helpful to break through some of the delays in the respective patent offices. It may be particularly useful in U.S. applications claiming priority of EPO applications in which accelerated examination has been successfully requested, and in EPO applications claiming priority of U.S. applications that are examined in one of the faster U.S. examining groups.

I. Background

The US-EPO Patent Prosecution Highway program is a one-year pilot program that began on September 29, 2008, and is intended to allow applicants in both countries to obtain corresponding patents faster and more efficiently. The program is further intended to reduce examination workloads and improve patent quality by permitting each patent office to benefit from work previously done by the other patent office.

As reported in our June 16, 2006 Special Report, the USPTO has already partnered with the Japanese Patent Office (JPO) to establish the first Patent Prosecution Highway pilot program. Since then, the USPTO has also commenced separate Patent Prosecution Highway pilot programs with the United Kingdom Intellectual Property Office (UK IPO), the Canadian Intellectual Property Office (CIPO), the Korean Intellectual Property Office (KIPO), and IP Australia (IPAU), based on the same framework as the Patent Prosecution Highway pilot program between the USPTO and the JPO.

The Patent Prosecution Highway program between the USPTO and the EPO is similar to the previous programs. In order to obtain expedited examination, applicants must request participation in the Patent Prosecution Highway program and meet the other requirements listed below. Once the USPTO grants the request for participation in the Patent Prosecution Highway program and accordingly grants special status to a U.S. application, the U.S. application will be advanced out of turn for examination and will be taken up for examination before all other categories of applications, except those clearly in condition for allowance, those with set time limits such as an Examiner's Answer to an Appeal Brief, and those that have also been granted special status. The EPO will similarly expedite examination of applications in which a request for participation has been granted.

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In order to assess the feasibility of the program, the one-year trial period for the Patent Prosecution Highway program may be extended for up to an additional year. However, if the volume of participation in the Patent Prosecution Highway program exceeds a manageable level, the program may also be terminated early.

II. Requirements to Participate in the Patent Prosecution Highway Program

In order to obtain expedited examination under the Patent Prosecution Highway (PPH) program, the USPTO and the EPO will require applicants to meet the following requirements.

A. The PPH Application Must Validly Claim Foreign Priority to the Application Containing A Patentable Claim

The application whose examination is desired to be expedited (the "PPH application") must validly claim priority to one or more applications filed in the other patent office. U.S. continuing applications that validly claim the benefit of a U.S. application under 35 U.S.C. §120 and the priority date of an EPO application(s) under 35 U.S.C. §119(a) are also eligible. However, PCT national phase applications, provisional, plant and design applications, reissue applications and reexamination proceedings are excluded.

B. The PPH Applicant Must Submit A Copy of at Least One Patentable Claim

The PPH applicant must submit a copy of the patentable claim(s) from the priority application(s). The USPTO will require that the EPO application(s) have at least one claim that was determined by the EPO to be allowable, either in an EPO office action or in a positive Extended European Search Report (EESR), if no EPO office action has been issued.

In a case where an EPO office action does not explicitly state that a particular claim is allowable, the

Applicant must include a statement in the request for participation in the PPH program that no rejection has been made in the EPO office action regarding that claim, and therefore that the claim is deemed allowable by the EPO. Alternatively, if the applicant is relying on a positive EESR to establish that a particular claim is deemed allowable by the EPO, the applicant must explain in the request for participation in the PPH program how the EESR establishes allowability of that particular claim.

C. All PPH Application Claims Must Sufficiently Correspond to the Patentable Priority Application Claims

All claims in the PPH application must "sufficiently correspond" to or be amended to "sufficiently correspond" to the patentable claims in the priority application(s). The USPTO has explained that it will consider claims to "sufficiently correspond" where, accounting for the differences due to translations and claim format requirements, the claims are of the same or similar scope. While "same" scope implies identical or nearly identical claim language, it is currently unclear how broadly the USPTO intends to interpret the meaning of "similar" scope. From our experience with the previous PPH programs, we have found that the USPTO accepts claims that are identical or nearly identical to the patentable claims, but is more likely to reject a claim as that claim increasingly varies from the patentable claim.

Additionally, both patent offices will require applicants to submit a "claims correspondence table." The claims correspondence table must indicate how all the claims in the PPH application correspond to the patentable claims in the priority application.

D. Examination of the PPH Application Must Not Have Begun

In order for an application to be eligible for participation in the PPH program, examination of that application must not have already begun.

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E. Required Documentation

The USPTO will require applicants to file a Request for Participation in the Patent Prosecution Highway Program and a Petition to Make Special under the Patent Prosecution Highway Program. The USPTO will also require a petition fee, currently in the amount of \$130.

F. Applicants Must Submit Copies of Office Actions

The USPTO will require PPH applicants to submit copies of all of the office actions that are relevant to patentability from each of the EPO application(s) containing the allowable claims that are the basis for the request. In a case where the applicant is relying on a positive EESR to establish that a particular claim is deemed allowable by the EPO, and no EPO office action relevant to patentability has been issued by the EPO, the USPTO requires that the applicant submit a copy of the positive EESR. In either case, the applicant must submit copies of any office actions that are relevant to patentability from the EPO application(s) that are issued after the grant of the request for participation in the PPH program in the USPTO.

G. Applicants Must Submit References Cited in the Priority Application

Each office will require submission of the references cited during prosecution of the priority application. The USPTO will require applicants to submit an Information Disclosure Statement listing the documents cited in the EPO office actions or in the positive EESR. With the exception of U.S. patents and U.S. patent application publications, copies of all of the documents cited must be submitted to the USPTO.

Further, U.S. PPH applicants remain under a duty to disclose to the USPTO other information known by them to be material to patentability. The PPH program does not absolve applicants of their duty of disclosure under 37 C.F.R. §1.56.

H. Request for Participation in the Program and All Supporting Documents Must Be Submitted Electronically

The request for participation in the Patent Prosecution Highway program, as well as all supporting documents, must be submitted to the USPTO electronically via EFS-Web.

III. Non-Compliant Requests for Participation in the Patent Prosecution Highway Program

In those instances where the Request for Participation in the PPH Program does not meet all the requirements set forth above, the USPTO or EPO will notify the applicant of the defects in the request. At that time, the applicant will be given one opportunity to perfect the request in a renewed request for participation. If the applicant fails to perfect the request, then the USPTO or EPO will notify the applicant, and the application will await action in its regular turn. Further, if examination of the application begins after the applicant has been notified of the defect, but before the filing of a renewed request, the renewed request will be dismissed.

IV. Requests for Participation in the Patent Prosecution Highway Program Do Not Automatically Extend to U.S. Continuing Applications

The USPTO will require that continuing applications separately fulfill the requirements for participation in the PPH program. Accordingly, any request for participation in the PPH program and special status granted in a parent application will not automatically carry over to a continuing application. However, if any of the documents identified in the above requirements II. B, F and G have already been filed in the parent application prior to the request for participation in the PPH program, it will not be necessary for the applicant to resubmit those documents with the request for participation. Instead, the applicant may simply refer to those documents and identify the date(s) on which those documents were previously filed in the parent application.

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V. Recommendations

At present, there are substantial delays in examination at both the USPTO and the EPO. However, some applications and some technologies may be examined earlier at one of these patent offices, either in the usual course or through an accelerated examination procedure. In particular, we understand that accelerated examination is easier to obtain in the EPO than in the USPTO. The PPH program may be most useful in such situations.

For our clients who file U.S. priority applications and want to obtain expedited issuance of a patent in the EPO, the PPH program may be most effective if the U.S. application is being handled by one of the faster USPTO examining groups. The PPH program may also be particularly effective when used in connection with a U.S. priority application in which a petition to make special has been filed on other grounds in the USPTO.¹

Our clients who file EPO priority applications may find the PPH program less useful unless they have successfully requested accelerated examination in the EPO, because in our experience routine EPO examination often progresses at a similar rate to U.S. prosecution. However, U.S. applications that are being examined by a particularly slow technology group at the USPTO may benefit from the PPH program even without accelerated EPO examination. Specifically, if an EPO priority application corresponding to such a U.S. application contains a patentable claim, the PPH program could be effective in accelerating an otherwise lengthy U.S. examination.

In situations where claims of a U.S. priority application are patentable, accelerating the examination of an EPO application may uncover prior

art that is more relevant than that considered by the USPTO. Generally an EPO search report is issued within 18 months of filing, and new prior art often is not applied in a subsequent EPO office action. Nonetheless, because the EPO examination was accelerated, it will be more likely that the resultant U.S. patent will still be within the two-year period for filing a broadening reissue application in the event that more relevant prior art is discovered by the EPO. Therefore, the applicant may be able to file a reissue application, narrowing the claims to avoid the more relevant prior art, while at the same time possibly broadening the claims in some other respect.

Please let us know if you desire any additional information on the PPH program in either the USPTO or the EPO, or if you have any questions about other ways to expedite examination in any patent office.

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¹ However, as noted in other Special Reports (see, e.g., our September 22, 2006 Special Report), there are significant difficulties and risks associated with filing most petitions to make special in the USPTO.