

REPORT

NEW PATENT PROSECUTION HIGHWAY PILOT PROGRAM BETWEEN UNITED STATES AND CHINA

December 5, 2011

The United States Patent and Trademark Office (USPTO) and the State Intellectual Property Office of the People's Republic of China (SIPO) announced new Patent Prosecution Highway (PPH) and PCT Patent Prosecution Highway (PCT-PPH) pilot programs for expedited examination of certain national and PCT-based patent applications.

Under the PPH program, an applicant receiving a ruling from either the USPTO or the SIPO 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.

Under the PCT-PPH program, an applicant that has received an indication from either the USPTO or the SIPO that at least one claim in a PCT application has novelty, inventive step and industrial applicability may obtain accelerated examination of corresponding applications in the other patent office. The indication must be from one of these patent offices acting as an international search authority (ISA) or as an international preliminary examining authority (IPEA), and can appear in:

(1) a written opinion from the international searching authority (WO/ISA);

(2) a written opinion from the international preliminary examination authority (WO/IPEA); or

(3) an international preliminary examination report (IPER) from the international preliminary examining authority.

The USPTO does not charge a fee for participation in either of these programs. These new programs are designed to provide a cost-effective method to accelerate prosecution of national and PCT-based patent applications.

I. Background

Both the PPH and PCT-PPH programs are one-year pilot programs that began on December 1, 2011, and are intended to allow applicants to obtain patents faster and more efficiently. The programs are intended to reduce examination backlogs by permitting each patent office to accelerate examination of claims already found to be patentable by the other patent office.

The programs between the USPTO and SIPO are similar to existing PPH and PCT-PPH programs. In order to obtain expedited examination, applicants must request participation in the programs and meet the other requirements discussed below. Once the USPTO grants a request for participation in a program and accordingly grants special status to a U.S.

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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.

In order to assess the feasibility of these programs, the one-year trial period for both the PPH and PCT-PPH programs may be extended as needed. However, if the volume of participation in the programs exceeds a manageable level, the programs may be terminated early.

II. Requirements to Participate in the PPH Program

In order to obtain expedited examination in the USPTO under the PPH program, PPH applicants must 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 a SIPO application(s) under 35 U.S.C. §119(a) are also eligible. Provisional, plant and design applications, reissue applications and reexamination proceedings are excluded.

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

PPH applicants must submit a copy of the patentable claim(s) from the priority

application(s). The USPTO will require that the SIPO application(s) have at least one claim that was determined by the SIPO to be allowable. The priority application can not be a utility model application, as the USPTO will not permit applicants to rely on allowed claims from a utility model application to request entry into the PPH program.

To rely on a SIPO office action that does not explicitly state that a particular claim is allowable, applicants must include a statement in the request for participation in the PPH program that no rejection has been made in the SIPO office action regarding that claim, and therefore that the claim is deemed allowable by the SIPO.

Applicants must also submit an English language translation of the allowable claim(s), along with a statement that the translation is accurate.

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 (i.e., neither broader nor narrower). From our experience with other PPH programs, we have found the USPTO willing to accept claims as sufficiently corresponding when the claims are identical or nearly identical to the patentable claims, but more likely to reject a claim as that claim increasingly varies from the patentable claim.

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Additionally, applicants are required 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 PPH application must not have already begun.

E. Required Documentation

The USPTO requires 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. There is no USPTO fee to file such a Request and Petition.

F. Applicants Must Submit Copies of Office Actions

The USPTO requires PPH applicants to submit copies of all of the office actions that are relevant to patentability from each SIPO application containing the allowable claims that are the basis for the request. Applicants must also submit an English language translation of the office actions, along with a statement that the translation is accurate.

G. Applicants Must Submit References Cited in the Priority Application

The USPTO requires submission of the references cited during prosecution of the SIPO priority application, along with an Information Disclosure Statement listing the documents cited

in the SIPO office actions. 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. If copies have already been filed in the U.S. application, applicants can simply indicate when the copies were previously filed.

Further, U.S. PPH applicants remain under a duty to disclose to the USPTO all 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.

III. Requirements To Participate In The PCT-PPH Program

In order to obtain expedited examination under the PCT-PPH program in the USPTO, applicants must meet the following requirements.

A. U.S. Application And Corresponding PCT Application Must Have A Qualifying Relationship

A U.S. application for which participation in the PCT-PPH program is requested and a corresponding PCT application must have one of the following relationships:

- (i) the U.S. application is the U.S. national phase of the corresponding PCT application;
- (ii) the U.S. application is a national application which forms the basis for the priority claim in the corresponding PCT application;
- (iii) the U.S. application is the national phase of another PCT application that was filed in any competent Receiving Office and claims priority to the corresponding PCT application;

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(iv) the U.S. application is a national application claiming priority to or continuing status from the corresponding PCT application; or

(v) the U.S. application is a continuing application (continuation, divisional, or continuation-in-part) of another U.S. application that satisfies at least one of the above requirements (i - iv).

B. PCT-PPH Applicants Must Submit A Copy Of The Claim(s) From The Corresponding PCT Application

Unless already filed in the U.S. application, a copy of the claim(s) from the corresponding PCT application indicated by the SIPO as having novelty, inventive step, and industrial applicability in the most recent work product of the PCT application must be filed. If the claim(s) is not in English, applicants must submit an English language translation of the claim(s), along with a statement that the translation is accurate.

If the claim(s) has already been filed in the U.S. application, applicants need only indicate when the claim(s) was filed. If the claim(s) in the U.S. application is identical to the claim(s) from the corresponding PCT application, and is already in English, there is no need to submit another copy of the claim(s).

C. All PCT-PPH Application Claims Must Sufficiently Correspond To The Patentable PCT Application Claims

All claims in the U.S. application must "sufficiently correspond" to, or be amended to "sufficiently correspond" to, one or more of the corresponding PCT application claims indicated by the SIPO as having novelty, inventive step,

and industrial applicability. The USPTO has explained that it will consider claims to "sufficiently correspond" where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope, or are narrower in scope. In our experience with other PCT-PPH programs, the USPTO generally accepts claims that are identical or nearly identical to the patentable claims, but is more likely to reject a claim that increasingly varies from the patentable claim. The USPTO defines a claim that is narrower in scope as a claim that has been identified as having novelty, inventive step and industrial applicability, and that is further limited by an additional feature.

Applicants must submit a "claims correspondence table." The claims correspondence table must indicate how all claims in the U.S. application sufficiently correspond to the claim(s) of the corresponding PCT application indicated by the SIPO as having novelty, inventive step, and industrial applicability in the most recent international work product.

D. Examination Of The PCT-PPH Application Must Not Have Begun

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

E. Required Documentation

The USPTO requires applicants to file a Request for Participation in the PCT Patent Prosecution Highway Program and a Petition to Make Special under the PCT-PPH Program. There is no USPTO fee to file such a Request and Petition.

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F. PCT-PPH Applicants Must Submit The Most Recent Work Product From The Corresponding PCT Application

Unless already filed in the U.S. application requesting entry into the PCT-PPH program, a copy of the most recent international work product, such as the WO/ISA, WO/IPEA, or IPER, must be filed, and that most recent work product must indicate that the relied-upon claim(s) has novelty, inventive step, and industrial applicability. If the latest international work product is not in English, then an English language translation of the work product is also required.

If the WO/ISA, WO/IPEA, or IPER that forms the basis for the PCT-PPH request includes any observation in Box VIII (regarding clarity and support issues), the applicant must identify and explain why the U.S. claim(s) is not subject to the observation, irrespective of whether an amendment is submitted to correct the observation described in Box VIII. The U.S. application will not be eligible to participate in the PCT-PPH program if the applicant does not identify and explain why the U.S. claim(s) is not subject to the observation described in Box VIII.

If the most recent international work product has already been filed in the U.S. application, the applicant need only indicate when the work product was previously filed in the U.S. application.

G. PCT-PPH Applicants Must Submit References Cited In The International Work Product

PCT-PPH applicants must submit an Information Disclosure Statement (IDS) listing the documents cited in all of the international

work products (ISR, WO/ISA, WO/IPEA, and IPER) of the corresponding PCT application. If such an IDS has already been filed in the U.S. application, applicants need only refer to the previous IDS. Applicants must also submit copies of all documents cited in the international work products of the corresponding PCT application, except for U.S. patents or U.S. patent application publications. Again, if copies have already been filed in the U.S. application, applicants can simply indicate when the copies were previously filed.

In addition, U.S. applicants remain under a duty to disclose to the USPTO all other information known by them to be material to patentability. The PCT-PPH program does not absolve applicants of their duty of disclosure.

IV. Non-Compliant Requests For Participation In The PPH and PCT-PPH Programs

If all of the requirements for participation in either program are not met, the USPTO will notify applicants of the defects. Applicants will be given one opportunity to meet the requirements in a renewed request for participation. If an applicant again fails to meet the requirements, then the USPTO will notify the applicant, and the application will await examination in its regular turn. Further, if examination of the application begins after the applicant has been notified of a defect, but before the filing of a renewed request, the renewed request will be dismissed.

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V. Requests For Participation In The PPH and PCT-PPH Programs Do Not Automatically Extend To U.S. Continuing Applications

The USPTO requires that any continuing application separately fulfill the requirements for participation in one of the programs in order for its examination to be expedited under that program. Accordingly, any request for participation and special status granted in a parent application will not automatically carry over to a continuing application.

VI. Recommendations

Due to the differences between the programs, we separately provide our recommendations for each program below. When an applicant qualifies for both programs, we recommend considering the respective claim scopes of the national and PCT-based patent applications. Generally, applicants should select the program corresponding to the application having the most favorable claim scope. As described above, if the application is a PCT-based patent application, then applicants may also include claims that are narrower than the claims indicated as having novelty, inventive step, and industrial applicability with their request.

In general, U.S. patent applications participating in a PPH program have a much shorter pendency and much higher allowance rate than other U.S. patent applications. Thus, where the desired claim scope is indicated to be patentable by the SIPO, we recommend participating in one of these programs unless a strategic delay in patent issuance is desired.

A. PPH Program

For our clients who file U.S. priority applications and want to obtain expedited issuance of a patent in the SIPO, 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 SIPO priority applications may find the PPH program less useful unless they have successfully requested accelerated examination in the SIPO. 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 SIPO examination. Specifically, if a SIPO priority application corresponding to such a U.S. application contains an acceptable 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 a SIPO application may uncover prior art that is more relevant than that considered by the USPTO. By accelerating examination in the SIPO, 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 SIPO. Therefore, the applicant may be able to file a reissue application,

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.

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narrowing the claims to avoid the more relevant prior art, while at the same time possibly broadening the claims in some other respect.

B. PCT-PPH Program

The PCT-PPH program may be most effective for applicants that receive a written opinion from an international search authority (WO/ISA) indicating that at least one claim in the PCT application has novelty, inventive step and industrial applicability. Because the WO/ISA is routinely generated within about 18 months of the priority date of a PCT application, the timing of a favorable WO/ISA permits applicants to receive accelerated examination as early as possible under the PCT-PPH program. Of course, although issued later in time, favorable work product from the IPEA could similarly be relied upon for the PCT-PPH filing.

Applicants that do not receive a favorable WO/ISA should consider filing a Chapter II Demand. Under Chapter II, applications will be examined by an IPEA, and applicants will be given an opportunity to submit arguments and/or amend the claims. If the IPEA issues a favorable WO/IPEA or IPER, then the WO/IPEA or the IPER could be the basis for the PCT-PPH filing.

When entering the U.S. national phase, applicants should be mindful of a twelve-month or more delay in administrative processing of the U.S. national phase application in the USPTO. To minimize such delay, applicants can instead file a continuation, rather than national phase, of the international application. This can reduce the administrative delay. By taking advantage of both this option and the PCT-PPH program, applicants can benefit from both the accelerated examination of the PCT-PPH program and minimal USPTO administrative delay.

Applicants should also consider including a set of claims with a narrower scope in the PCT application. Such claims will be more likely to receive a favorable WO/ISA, which could subsequently form the basis of a PCT-PPH filing. Broader claims that do not receive a favorable WO/ISA could be addressed with amendments and/or arguments under Chapter II (described above) with the goal of receiving a favorable WO/IPEA or IPER. Any broader claims that do not receive a favorable decision could be examined in regular course, including in a continuing application.

Please let us know if you desire any additional information about the PPH or PCT-PPH programs in either the USPTO or the SIPO, or if you have any questions about other ways to expedite examination.

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