

REPORT

EXPANSION OF THE U.S. PATENT PROSECUTION HIGHWAY FOR EXPEDITING PATENT EXAMINATION

August 3, 2011

The USPTO announced a new pilot program to expand the availability of the Patent Prosecution Highway (PPH). Under this revised PPH pilot program, applicants can now rely on the presence of an allowable claim in a related application filed in any "partnering office" as the basis to file a request to participate in the PPH, as long as the related application and the PPH application share a common priority application. The revised program is intended to make the PPH easier to use and more widely available to applicants.

The original PPH program is credited with expediting examination of numerous applications. According to USPTO statistics, a PPH application is typically examined within 3 months after a Request to Participate in the PPH program is filed, as opposed to the average 25 month waiting period for non-PPH applications. Additionally, a PPH application receives on average 1.7 office actions per disposal, while non-PPH applications receive 2.7 actions per disposal. PPH applications enjoy a 91 percent allowance rate, as opposed to only a 44 percent allowance rate for non-PPH applications.

In addition to the USPTO, there are seven other partnering offices currently participating in the revised program, including the patent offices of Canada (CIPO), Japan (JPO), Australia,

Finland (NBPR), Russia (Rospatent), Spain (SPTO), and the United Kingdom (UKIPO).¹

I. Background

Under the revised PPH program, a U.S. or foreign applicant receiving a ruling from a partnering office that at least one claim in a related patent application is patentable may request that the USPTO accelerate examination of corresponding claims in a PPH application, as long as the related application and the PPH application share a common U.S. or foreign priority application. PPH applicants can also participate in the revised program in other partnering offices; however, each partnering office has its own requirements for participating in the revised PPH program.

The revised pilot program is a one-year program that began on July 15, 2011. In addition to increasing the number of applications that qualify for the PPH, the pilot program incorporates other changes to the basic PPH framework that are intended to make the program more flexible and user-friendly. In order for the USPTO to assess the feasibility of the program,

¹ The following additional countries participate in more limited PPH programs with the USPTO, any may join the new expanded program in the future: Australia, Austria, Denmark, EPO, Germany, Hungary, Israel, Korea, Mexico, Singapore, and Sweden. The revised PPH program does not affect the Patent Cooperation Treaty PCT-PPH program.

August 3, 2011

the one-year trial period may be extended for up to one additional year. However, if the volume of participation in the pilot program exceeds a manageable level, it may be terminated early.

II. Requirements To Participate In The Revised Program

In order for patent applicants to obtain expedited examination in the USPTO under the revised PPH pilot program, they must meet the following requirements. Some of the requirements to participate in the revised PPH pilot program have changed relative to the original PPH program, while others remain identical. Requirements that have changed are described separately in a first section below, while unchanged requirements are described in a second section for completeness.

A. Changed Requirements

1. The PPH Application Need Only Share A Priority Application With The Related Application Containing An Allowable Claim

The PPH application and the related application having at least one allowable claim in a partnering office must share a priority application. This requirement differs from the original PPH program, where a PPH applicant could only rely on allowability of a claim in a priority application that was filed in the office of first filing (OFF). The revised requirement expands the number of applications that can form the basis of a PPH Request. Specifically, PPH applicants can now rely on allowability of a claim in any related application in the same patent family to make a PPH Request, regardless of whether it was from an OFF, and regardless of the patent office in which the priority application was filed, as long as the related application was filed in a partnering office.

In the following three examples, a family of applications is filed in China (a non-partnering office), the USPTO, Japan (a partnering office), the United Kingdom (a partnering office), and Germany (a non-partnering office). If the Chinese application is the priority application, a U.S. applicant could enter the PPH in the USPTO based on an indication of allowability of claims in either the Japanese or United Kingdom application, but not in the Chinese or German application. Similarly, if the priority application is filed in Japan, a U.S. applicant could enter the PPH in the USPTO based on indication of allowability of claims in the Japanese priority application or the United Kingdom application, but not in the Chinese or German application. Finally, if the priority application is filed in the USPTO, a U.S. applicant could enter the PPH in the USPTO based on an indication of allowability of the claims in the Japanese or United Kingdom application, but not the Chinese or German applications. These rules apply regardless of whether the application having an allowable claim and/or the PPH application are filed directly or as PCT national phase applications. However, an indication of allowability only in the PCT international phase, even if issued by a partnering office, does not qualify under the revised pilot program.

2. All PPH Application Claims Must Sufficiently Correspond To The Allowable Claims

Each claim in the PPH application must sufficiently correspond to the allowable claims of the related application. Under the revised requirements, claims are considered to "sufficiently correspond" where, accounting for differences due to translation and claim format, the claims in the USPTO are of the same or similar scope as the allowable claims in the related application, or (for dependent claims) are

August 3, 2011

narrower in scope than the allowable claims in the related application. The original PPH program did not permit PPH applicants to submit claims that were narrower in scope than the allowable claims in the related application.

The USPTO defines a claim as being narrower in scope than an allowable claim of the related application when that claim is further limited by an additional feature. The additional limitation that makes the claim in the PPH application narrower in scope than the allowable claim in the related application must have support in the written description of the PPH application and must be presented in a dependent claim. A claim that introduces a new or different category of claims than any claim indicated as allowable in the related application will not be considered to sufficiently correspond, even if it depends from a corresponding claim.

As in the original PPH program, the USPTO 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 allowable/patentable claims in the related application. Further, applicants must clearly identify any narrower dependent claims in the claims correspondence table.

B. Unchanged Requirements

1. The PPH Applicant Must Submit A Copy Of At Least One Patentable Claim From the Related Application

As with the original PPH program, the PPH applicant must submit a copy of the allowable claim(s) of the related application from the partnering office. If not in the English language, the PPH applicant must also submit an English-language translation of the claim(s) and a statement that the English-language translation is

accurate. If the partnering office does not explicitly state that a particular claim is allowable, the applicant must submit a statement in the Request for Participation in the PPH program that no rejection has been made regarding that claim, and therefore that the claim is deemed allowable.

2. 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.

3. Required Documentation

Applicants must file a Request for Participation in the PPH program and a request that the U.S. application be advanced out of turn for examination. There is no Patent Office fee for filing the Request.

4. Applicants Must Submit Copies Of Office Actions

PPH applicants must submit copies of all Office Actions issued by the partnering office of the related application that are relevant to patentability, except where the JPO is the partnering office. If the JPO is the partnering office, PPH applicants need only submit a copy of the most recent Office Action. When an Office Action is not in English, applicants must also submit an English-language translation of the Office Action and a statement that the English-language translation is accurate.

Applicants must also submit copies of any Office Actions that are relevant to patentability from the related application issued after grant of the Request for Participation in the PPH program. Not submitting such an Office Action, especially when the Office Action reverses a prior holding

August 3, 2011

of allowability, could jeopardize enforceability of the patent.

5. Applicants Must Submit All References Cited In The Related Application

All references cited during prosecution of the related application must be submitted to the USPTO with the Request for Participation, unless such references have already been submitted in the PPH application. Further, 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.

6. Requests For Participation In The Revised Program Do Not Automatically Extend To Continuing Applications

Any continuing application(s) (continuations, divisions, or continuations-in-part) must separately fulfill the requirements for participation in the revised 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. If any of the required documents other than a Request for Participation have already been filed in the parent application prior to the Request for Participation in the continuing application, an applicant need not resubmit those documents with the Request. 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.

7. Non-Compliant Requests For Participation In The Patent Prosecution Highway Program

If the Request for Participation in the PPH program does not meet all the requirements set forth above, the USPTO will notify the applicant of the defects in the Request. At that time, the applicant will be given only one opportunity to perfect the Request. If the applicant fails to perfect the Request, the USPTO will notify the applicant, and the application will await action in its regular turn.

III. Special Examining Procedure

Once a Request for Participation in the PPH program is granted to a U.S. application, the U.S. application will be taken up for examination before all other categories of application, except for those clearly in condition for allowance, those with set time limits, such as Examiners' Answers, and those that have been granted special status for "accelerated examination."

Any claims amended or added after the grant of the Request must sufficiently correspond to one or more allowable claims in the related application. The applicant is required to submit a claims correspondence table along with each amendment. If the amended or newly added claims do not sufficiently correspond to the allowable claims in the related application as defined above, the amendment will not be entered and will be treated as a non-responsive reply.

IV. Recommendations

1. We recommend (a) monitoring all related applications for indications of allowability of claims of acceptable scope; (b) when such allowable claims are found, checking to see whether they are in an application in a patent office that is at that time a "partnering office;"

August 3, 2011

and (c) if so, determining whether PPH entry is desirable in the USPTO.

2. We also recommend considering filing narrower dependent claims in addition to directly corresponding claims with a PPH Request. To avoid delaying examination, PPH applicants should strive to add any narrower dependent claims at the time of filing the PPH Request so that they will be considered by the USPTO prior to a first Office Action. This is because adding narrower dependent claims in response to a first Office Action may prolong examination by requiring the PPH applicant to file an RCE in order to have the narrower dependent claims considered.

3. For our clients who want to rely on a related U.S. application to obtain expedited issuance of a patent in a partnering office, unless the U.S. application is being handled by one of the faster USPTO examining groups, we recommend considering filing a petition to make special in the U.S. application. However, as noted in other Special Reports (see, e.g., our September 22, 2006 Special Report), there are significant difficulties and risks that should be considered with respect to most petitions to make special in the USPTO.

4. Accelerating the examination of a related application in a partnering office may uncover prior art early in the life of a related U.S. patent, and in some cases within the two-year period for

filing a broadening reissue application in the USPTO. In such circumstances, U.S. patentees should consider the desirability of filing a reissue application to address that prior art before the two-year deadline, possibly 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 revised PPH program in either the USPTO or the partnering offices, or if you have any questions about other ways to expedite examination in any patent office.

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