

REPORT

A NEW ALTERNATIVE FOR EXPEDITED PATENT EXAMINATION

June 16, 2006

Under standard U.S. Patent and Trademark Office (USPTO) procedures, new patent applications are ordinarily taken up for examination in the order of their effective United States filing dates. Certain exceptions are made by way of "petitions to make special," which when granted result in an application being examined out of turn ahead of most other pending applications. For example, an application may be made special for any of the following reasons: 1) prospective manufacture; 2) actual infringement; 3) applicant's poor health; 4) the applicant is 65 years of age or more; 5) the invention will materially enhance the quality of the environment of mankind; 6) the invention will materially contribute to the discovery or development, or the more efficient utilization and conservation, of energy resources; 7) the invention relates to safety of research in the field of recombinant DNA; 8) applicant requests special examination and complies with procedural requirements including searching for, identifying and distinguishing the closest prior art; 9) the invention relates to superconductivity technologies; 10) the invention relates to HIV/AIDS or cancer; 11) the invention materially contributes to countering terrorism; or 12) the applicant is a small entity and the invention involves biotechnology.

The Japanese Patent Office (JPO) also has programs in place for expediting examination of Japanese patent applications.

The USPTO and the JPO have now announced a new pilot program for expedited examination called the "Patent Prosecution Highway" program that is available to applicants whose convention priority applications were filed in one of those two patent offices.¹ Under the

program, an applicant receiving a ruling from either the USPTO or JPO 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.

The Patent Prosecution Highway program is a one-year pilot program that is scheduled to begin on July 3, 2006, 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.

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 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 JPO will similarly expedite examination of applications in which a request for participation has been granted.

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.

I. Requirements to Participate in the Patent Prosecution Highway Program

In order to obtain expedited examination under the Patent Prosecution Highway (PPH) program, the USPTO

¹ This priority claim requirement will exclude applicants whose priority applications were filed in other national or regional patent offices. However, both patent offices have indicated that they hope in time to expand the program to include other patent offices such as the EPO.

June 16, 2006

and the JPO will require applicants to meet the following requirements.

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

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 JPO 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). While the JPO will not require a translation of the patentable U.S. claims, the USPTO will require an English-language translation of the patentable Japanese claims and a statement that the English translation is accurate. If a copy of the patentable U.S. claims is available from the USPTO PAIR system, a copy need not be submitted to the JPO. Similarly, if a copy of the patentable claims from the JPO application is available via the JPO Dossier Access System, applicants may request that the USPTO obtain the copy via the Dossier Access System. In such a case, applicants must still separately submit the corresponding English language translation and accuracy statement to the USPTO.

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. The JPO has explained that it will consider claims to be of the "same or similar scope" if the claims have a common

technical feature that make the claims patentable over the prior art.

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.

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.

The JPO will require submission of an "Explanation of Circumstances Concerning Accelerated Examination."

F. Applicants Must Submit Copies of Office Actions

The USPTO and the JPO will each require PPH applicants to submit copies of all of the office actions (including a JPO "Decision to Grant a Patent" or a USPTO "Notice of Allowability" or other office action clearly identifying patentable claims) from the priority application(s). The USPTO will also require English-language translations of the office actions and statements that the translations are accurate. Similarly to the submission of the patentable claims from the JPO application described above, if copies of the JPO office actions are available via the JPO Dossier Access System, then applicants may request that the USPTO obtain the copies via the Dossier Access System. In such a case, applicants must still separately submit the corresponding English-language translations and statements. The JPO similarly will not require that copies of the USPTO office actions be submitted if they are available through the USPTO PAIR System. The JPO will not require translations, except when the indication of patentability is coupled with an objection to the claim (e.g., as depending from a rejected claim).

June 16, 2006

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 JPO office actions. With the exception of U.S. patents and U.S. patent application publications, copies of all of the documents cited in the JPO office actions must be submitted to the USPTO.

The JPO will require submission of copies of any references not available from the JPO Intellectual Property Document Library (IPDL).

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.

II. 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 JPO 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 JPO will notify the applicant, and the application will await action in its regular turn.

III. 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. If any of the documents identified in the above requirements 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.

IV. Recommendations

At present, there are substantial delays in examination at both the USPTO and the JPO. 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. 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 Japan, the PPH program may be most effective when combined with a petition to make special filed on other grounds in the USPTO. Moreover, the PPH program may be effective even without a petition to make special if the application is being handled by one of the faster USPTO examining groups.

Our clients who file Japanese priority applications may find the PPH program less useful, because at present Japanese examination often lags behind U.S. prosecution. However, targeting applications that are being examined by a particularly slow technology group at the USPTO may be a beneficial way for those clients to use the PPH program. Specifically, if a JPO 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 a JPO application may uncover prior art that is more relevant than that considered by the USPTO. Generally a JPO search report is issued within 18 months of filing, and new prior art often is not applied in a subsequent JPO office action. Nonetheless, because the JPO 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 JPO. 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 JPO, or if you have any questions about other ways to expedite examination in any patent office.

June 16, 2006

* * * * *

Oliff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oliff & Berridge, PLC. Readers

should seek the advice of professional counsel before acting upon any of the information contained herein.

For further information, please contact us by telephone at (703) 836-6400, facsimile at (703) 836-2787, e-mail at email@oliff.com or mail at 277 South Washington Street, Suite 500, Alexandria, Virginia 22314. Information about our firm can also be found on our web site, www.oliff.com.

スペシャル・レポートの日本語版は、英語版の発行後、二週間以内にウェブ・サイトでご覧いただけます。