

REPORT

NEW PCT PATENT PROSECUTION HIGHWAY PILOT PROGRAM

February 2, 2010

The United States Patent and Trademark Office (USPTO), the Japanese Patent Office (JPO) and the European Patent Office (EPO), collectively the Trilateral Offices, announced a new Patent Prosecution Highway (PPH) pilot program for expedited examination of certain PCT-based patent applications. Under the program, an applicant that has received an indication 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 Trilateral Offices. The indication must be from one of the Trilateral 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 an international searching authority (WO/ISA);
- (2) a written opinion from an international preliminary examination authority (WO/IPEA); or
- (3) an international preliminary examination report (IPER) from an international preliminary examining authority.

This new program appears to provide a cost-effective method to accelerate prosecution of many PCT-based patent applications.

I. Background

The PCT Patent Prosecution Highway (PCT-PPH) program is a two-year pilot program that began on January 29, 2010, and is intended to allow applicants to obtain corresponding national or regional patents faster and more efficiently. The program is further intended to reduce examination backlogs by permitting each Trilateral Office to accelerate examination of claims already found to be patentable by one of the other Trilateral Offices in the PCT international stage.

The PCT-PPH program between the Trilateral Offices is similar to existing PPH programs.¹ In order to obtain expedited examination, applicants must request participation in the PCT-PPH program and meet the other requirements discussed below. Once the USPTO grants a request for participation in the PCT-PPH 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 JPO and EPO 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 two-year trial period for the PCT-PPH program may be extended as needed. However, if the volume of participation in the program exceeds a manageable level, the program may be terminated early.

II. Requirements To Participate In The PCT-PPH Program In The USPTO

In order to obtain expedited examination of a U.S. application under the PCT-PPH program, the USPTO will require applicants to meet the following requirements.

¹ See our prior Special Reports regarding PPH programs: June 16, 2006, "A New Alternative for Expedited Patent Examination" (USPTO/JPO); September 12, 2007, "New Patent Prosecution Highway Program Between the U.S. and U.K. Patent Offices" (USPTO/UKIPO); and October 3, 2008, "New Patent Prosecution Highway Pilot Program Between United States and European Patent Offices" (USPTO/EPO).

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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 a national stage entry 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 a national stage entry of another PCT application that was filed in any competent Receiving Office and claims priority to the corresponding PCT application;
- (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. Required Documentation And Fee

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.

C. 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, the applicant must submit a copy of the most recent international work product, such as the WO/ISA, WO/IPEA, or IPER, and that most recent work product must indicate that the 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 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 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. If the U.S. application is a national stage entry of the corresponding PCT application, the applicant does not need to submit a copy of the international work product or an English language translation, because these documents should already be of record in the U.S. application.

D. Copy Of The Claim(s) From The Corresponding PCT Application

Unless already filed in the U.S. application, the applicant must submit a copy of the claim(s) from the corresponding PCT application that is indicated as having novelty, inventive step and industrial applicability in the most recent work product of the PCT application. If the claim(s) is not in English, the applicant 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, the applicant 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).

E. All U.S. Application Claims Must Sufficiently Correspond To 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 as having novelty, inventive step and industrial applicability. The USPTO has explained that it will consider claims to "sufficiently correspond" where,

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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 the previous 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.

The 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 as having novelty, inventive step and industrial applicability in the most recent international work product.

F. Applicants Must Disclose All References Cited In The International Work Product

The 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, the applicant need only reference the previous IDS. The 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, the applicant 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.

G. 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.

H. Request For Participation In The Program And All Supporting Documents Must Be Submitted Electronically

The request for participation in the PCT-PPH program, as well as all supporting documents, must be submitted to the USPTO electronically. If preliminary amendments or IDSs are being filed with the request, then these filings must be separately indexed.

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

If a request for participation in the PCT-PPH program does not meet all the requirements set forth above, the USPTO will notify the applicant of the defects in the request. 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 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.

IV. Requests For Participation In The PCT 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.

V. Recommendations

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

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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.

While a PCT application may not be initially filed in a Trilateral Office, applicants should consider designating one of the Trilateral Offices as the ISA or IPEA, when possible, to receive the benefit of the PCT-PPH program. For example, for many applicants of PCT international applications not filed in a Trilateral Office, the PCT application may still designate a Trilateral Office as the ISA or IPEA. By doing so, applicants may still receive accelerated examination under the PCT-PPH program.

Similarly, even some applicants who can file an international application in a Trilateral Office can also designate a different Trilateral Office as the ISA or IPEA. This can be especially helpful when examination of a particular technology in one of the Trilateral Offices is more reasonable than in the other Trilateral Offices, or where examination is particularly slow in one of the Trilateral Offices.

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 to a single month. By taking advantage of both this option and the PCT-PPH, 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 on the PCT-PPH program in any of the Trilateral Offices, or if you have any questions about other ways to expedite examination in any patent office.

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