

REPORT

NEW PATENT PROSECUTION HIGHWAY PROGRAM BETWEEN THE U.S. AND U.K. PATENT OFFICES

September 12, 2007

On August 30, 2007, the U.S. Patent and Trademark Office (USPTO) and the United Kingdom Intellectual Property Office (UK IPO) announced a new "Patent Prosecution Highway" pilot program for expedited examination of patent applications. The program is available to applicants whose 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 UK IPO 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.

I. Overview

The Patent Prosecution Highway (PPH) program is a one-year pilot program that began on September 4, 2007, and is similar to the programs currently existing between the USPTO and the Japanese Patent Office (JPO) and between the UK IPO and the JPO. Like the JPO PPH programs, the new U.S./U.K. PPH program 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 PPH program and meet the other requirements listed below. Once the USPTO grants a request for participation in the PPH program and 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 UK IPO 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 PPH program may be extended for up to an additional year. However, if the volume of participation in the PPH program exceeds a manageable level, the program may also be terminated early.

II. Requirements To Participate In The PPH Program

The requirements to participate in the U.S./U.K. PPH program closely resemble those for the JPO PPH programs. Thus, with the exception of translation requirements, clients already familiar with the JPO PPH programs will find the following requirements to be quite similar.

In order to obtain expedited examination under the PPH program, the USPTO and the UK IPO 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 for which expedited examination is desired (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 UK IPO application(s) under 35 U.S.C. §119(a) are eligible. Additionally eligible are national stage

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applications under the PCT and so-called "bypass" continuation applications filed under 35 U.S.C. §111(a) which validly claim benefit under 35 U.S.C. §120 of a PCT application validly claiming priority to an application(s) filed in the UK IPO. However, provisional, plant and design applications, reissue applications, reexamination proceedings and applications subject to a secrecy order 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). To satisfy this requirement, the PPH applicant can request that the USPTO obtain a copy of the patentable claim(s) from the UK IPO; however, if the USPTO is not able to obtain a copy, then the applicant will ultimately be required to provide the copy. The UK IPO similarly will not require that copies of the U.S. patentable claim(s) be submitted if available through the USPTO PAIR System.

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

Each claim in the PPH application must "sufficiently correspond" to or be amended to "sufficiently correspond" to the patentable claim(s) in the priority application(s). The USPTO has explained that it will consider claims to "sufficiently correspond" where, accounting for the differences due to 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.

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 PPH Program and a Petition to Make Special under the PPH Program. The USPTO will also require a petition fee, currently in the amount of \$130. In the UK IPO, a PPH applicant will need to file a request for accelerated examination under the PPH program along with a completed PPH request form.

F. Applicants Must Submit Copies Of Office Actions

The USPTO and the UK IPO will each require PPH applicants to submit copies of all of the office actions from the priority application(s). To satisfy this requirement, the PPH applicant can request that the USPTO obtain copies of the documents from the UK IPO; however, if the USPTO is not able to obtain copies, then the applicant will ultimately be required to provide the copies. The UK IPO similarly will not require that copies of the USPTO office actions be submitted if they are available through the USPTO PAIR System.

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 UK IPO office actions. With the exception of U.S. patents and U.S. patent application publications, copies of all of the documents cited in the UK IPO office actions 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.

III. Non-Compliant Requests For Participation In The PPH 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 UK IPO will notify the applicant of the defects in the request. At that time, the applicant will be given one opportunity to perfect the

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request in a renewed request for participation. If the applicant fails to perfect the request, then the USPTO or UK IPO will notify the applicant, and the application will await action in its regular turn.

IV. Requests for Participation in the PPH 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 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.

V. Recommendations

At present, there are substantial delays in examination at the USPTO. However, some applications and some technologies may be examined earlier, either in the usual course or through an accelerated examination procedure. The PPH program, in connection with the U.K. application, 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 U.K., 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 U.K. priority applications may also find the PPH program useful, because U.K. examination is often faster than U.S. prosecution. Therefore, 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 U.K. priority application corresponding to such a U.S. application contains a patentable claim, the PPH program could be effective in accelerating an otherwise slow U.S. examination.

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

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