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Using the Patent Prosecution Highway to Receive Faster U.S. Allowances

Since January 2010, there have been several important advancements at the U.S. Patent and Trademark Office (USPTO) regarding the Patent Prosecution Highway (PPH) program, which has been in existence since 2006. The purpose of the PPH is to minimize duplicative searching and prosecution efforts through workload sharing among partnering patent offices regarding applications with common claims. This often results in the expedited allowance of PPH applications and a reduction in prosecution costs.

This paper describes the PPH and recent changes to the program, and offers guidance for U.S. filers as to how to use the PPH, including using certain favorable Patent Cooperation Treaty (PCT) opinions to enter the PPH in the U.S. via the PCT-PPH program.

What Is the PPH?

The PPH allows an applicant who has received notification of allowable claims from a first patent office to request fast-track examination of a corresponding application in a second patent office based upon the search and prosecution results of the first patent office. The first patent office is called the Office of First Filing (OFF) and the second patent office is called the Office of Second Filing (OSF). As of this writing, the patent offices partnering with the U.S. are Australia, Canada, Denmark, Europe, Finland, Germany, Hungary, Japan, Korea, Singapore, and the United Kingdom. According to the Russian Federal Service for Intellectual Property, Patents and Trademarks (Rospatent), Rospatent will join the PPH on September 1, 2010. Some of these programs are considered to be in a "pilot" phase with the U.S. (e.g., Australia, Europe), whereas others are fully implemented (e.g., Japan, Korea). Upon receiving notification in one partner patent office (that is, the OFF) of allowable claims, an applicant may request fast-track examination of a corresponding partner patent office application (as the OSF).

Use of the PPH prior to the introduction of the PCT-PPH, described below, was not an attractive option for many applicants who wanted to file in several countries because one had to use the route of filing Paris Convention applications, rather than a PCT, in order to use the PPH. The introduction of the PCT-PPH, described next, provides an easier route for applicants to pursue quick allowances (e.g., 2-15 days) in certain circumstances.

In a pilot program, the PPH has recently expanded such that an applicant receiving a favorable report on patentability regarding a PCT application having the USPTO, the European Patent Office (EPO), the Japan Patent Office (JPO), or the Korean Intellectual Patent Office (KIPO) as the International Searching Authority (ISA) may request fast-tracking of a U.S., European, Japanese, and/or Korean patent application related to that PCT when that application has entered the national phase. This is referred to generally as the PCT-PPH. The recent inclusion of Korea is significant because choosing the KIPO as



the ISA for PCT applications is fairly common due to its relative affordability compared to the USPTO, the EPO, and the JPO, and because of the searching competency of the KIPO. Upon receiving favorable treatment of at least one claim in, e.g., a PCT Written Opinion (ISA/USPTO, EPO, JPO, or KIPO), one may request fast-track examination of a U.S., European, Japanese, and/or Korean application related to that PCT.

It is important to note that entrance of an application into the PPH is not a guarantee of allowance. Each PPH application is subject to analysis by an examiner under the patent law of the OSF, and an examiner is not obligated to rely only upon the search results and conclusions of the OFF. Furthermore, an applicant is still required to adhere to disclosure obligations as appropriate to the patent law of the OSF.

PPH Requirements and Procedures When the USPTO Is the OSF

Once an applicant has received a notification of allowability of one or more claims in an application filed in an OFF, the applicant may petition an OSF to fast-track a corresponding application for substantive examination. To learn what is required to fast-track an application, one must consult the rules established by the OSF patent office. For example, to fast-track a European application before the EPO using the PPH, one must consult the PPH rules of the EPO.

For the USPTO as the OSF to consider a U.S. application, several requirements must be met, and the primary requirements are noted below. Details regarding each of these requirements, such as which submitted documents must be translated into English, are set forth at http://www.uspto.gov/patents/init_events/pph/index.jsp ("the USPTO PPH website") for each partnering country:

1. The OSF U.S. application must claim priority to the OFF application filing date. The mechanisms of how this may be achieved are many, and the USPTO PPH website outlines several options, including helpful diagrams of exemplary situations. The "Frequently Asked Questions" link on the USPTO PPH website also describes additional examples.

Note: if an applicant first files a U.S. provisional application, the USPTO will be considered the OFF. This is significant because if, e.g., a PCT is later filed that claims priority to the provisional, then a notification of allowable claims in a foreign-nationalized application of a PPH partnering office will not allow one to request entry of the U.S.-nationalized application into the PPH. This is because the USPTO is considered the OFF in this situation and the foreign application is considered the OSF. By contrast, see 10(e) below.



2. At least one claim is found allowable by the OFF.
3. All claims of the OSF U.S. application correspond, or are amended to correspond, to the allowed claims in the OFF application. Submission of a claim correspondence table is required.

Note: the interpretation of whether a claim of an OSF U.S. application "corresponds" to a claim of the OFF application differs depending on which PPH variant (including PCT-PPH) you are working under. The USPTO PPH website explains what is required for each variant.

4. Substantive examination of the OSF U.S. application has not begun.

Note: issuance of a Notice of Missing Parts or Restriction Requirement is not considered as triggering "substantive examination" of the OSF U.S. application under the PPH.

5. The applicant must file a petition to make the OSF U.S. application special (also called a "request").

Note: request forms for the USPTO as the OSF are available at the USPTO PPH website. The request need not be filed at the same time that the application is filed. As of May 25, 2010, there is no fee associated with this request. The request must be filed by EFS-Web, where there is a specific category for PPH submissions.

6. The applicant must submit a copy of all Office Actions from the OFF.
7. The applicant must submit an Information Disclosure Statement (IDS) listing all documents cited by the OFF examiner. Copies of any non-U.S. patent/published application prior art must also be submitted.

The foregoing requirements apply to the PCT-PPH procedure as well. Additional requirements are as follows, with details provided on the USPTO PPH website:

8. With respect to requirement (2) above, a "favorable international work product" must issue with respect to at least one claim. That is:
 - a. a Written Opinion from an ISA (WO/ISA), where the ISA must be the USPTO, EPO, JPO, or KIPO; or



- b. a Written Opinion from an International Preliminary Examining Authority (WO/IPEA) (IPEA must be the USPTO, EPO, JPO, or KIPO); or
- c. an International Preliminary Examination Report (IPER) from an IPEA (IPEA must be the USPTO, EPO, JPO, or KIPO);

must issue indicating at least one claim in the PCT application has novelty, inventive step, and industrial applicability. An applicant may not file a request to participate in the PCT-PPH on the basis of an International Search Report only.

- 9. When an observation is described in Box No. VIII of the ISA, IPEA, or IPER, the applicant "must identify and explain why the claim(s) is/are not subject to any observation described in Box VIII irrespective of whether an amendment is submitted to correct the observation." The USPTO warns that an application will not be eligible for this program if the "applicant does not identify and explain why the claim(s) is/are not subject to the observation."

Note: see M.P.E.P. § 1845.01, part VIII and § 1879, part IX regarding Box No. VIII observations.

- 10. The relationship between the OSF U.S. application and the PCT must be made clear, and must fall under one of the five situations outlined by the USPTO. Each of these five situations is helpfully diagrammed on the USPTO PPH website:
 - a. The U.S. application is a national stage entry of the corresponding PCT application.
 - b. The U.S. application is a national application which forms the basis for the priority claim in the corresponding PCT application.
 - c. The U.S. application is a national stage entry of another PCT application (which may be filed in any competent receiving office) that claims priority to the corresponding PCT application.
 - d. The U.S. application is a national application claiming foreign/domestic priority to the corresponding PCT application.
 - e. The U.S. application is a continuing application (continuation, divisional, or continuation-in-part) of the U.S. application which satisfies one of the above (a) to (d) scenarios.



Note: under 10(e), an applicant may file a U.S. provisional application ("USP"), then file a PCT application claiming priority to USP, such that a WO or IPER issued from the USPTO, EPO, JPO, or KIPO, that favorably treats one or more PCT claims may form the basis for requesting entry of the U.S.-nationalized application into the PPH.

11. The applicant must submit a copy of the latest favorable international work product.
12. The applicant must submit a copy of the claims from the corresponding PCT application that were favorably treated by the international work product.
13. With respect to the IDS requirement, all references cited in the international work product(s) of the corresponding PCT application must be listed in an IDS and, unless a U.S. patent or U.S. published application, copies must be submitted.

If the PPH request is deficient regarding an OSF U.S. application, an applicant will be offered only one chance for correction. If the applicant fails to timely correct the deficiency, there is a chance that the application could be "regularly" examined (that is, not via the PPH) because action on the application is not suspended pending correction of the PPH request.

A PPH request/grant in a parent U.S. application will not carry over to a continuing application (continuation, divisional, or continuation-in-part). An applicant must fulfill all the conditions set forth above in order for a PPH request to be granted in the continuing application. Furthermore, in the U.S., provisional applications, plant applications, design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order are excluded from participating in the PPH program.

Processing by the USPTO

According to the USPTO, a request is "generally decided" within two months from filing. As noted above, the PPH request need not be filed with the OSF at the same time the application is filed. If the PPH request is granted regarding a U.S. OSF application, the applicant will be notified and the application will be "advanced out of turn for examination" as described at 37 CFR § 1.102(a). This is not the same as the Accelerated Examination program offered by the USPTO. For example, pre-exam processing is not accelerated and extensions of time may be taking without withdrawing the special status. If the request is granted, the examiner will "generally" examine the application within 2-3 months of grant provided all pre-exam formalities are satisfied.



Not only is the application advanced out of turn for examination, but according to M.P.E.P. § 708.02, "Applications which have been made special will . . . continue to be treated as special throughout the entire prosecution in the Office." Thus, even if a First Office Action Prediction issued by the USPTO indicates that a First Office Action will soon issue, or even if a Restriction Requirement has issued, it may still make sense to file a PPH request in order to have the application treated "specially" throughout its prosecution time at the USPTO (including any appeals).

Benefits

The USPTO reports that as of February 2010, over 2,500 PPH requests had been received since 2006, and that the First Office Action allowance rate for PPH applications was about 25%, about double the rate for all applications.¹ A USPTO representative presented the following facts at a May 19, 2010 "PPH Users Meeting"²:

- An average number of actions per disposal of about 1.7 for PPH applications compared to 2.7 for all applications in the patent examining corps.
- A 93.3% allowance rate for PPH cases versus a 44% rate for non-PPH cases.
- A 20% reduction in the number of claims.
- An 18-month decrease in pendency for some technologies.
- Reports from other participating PPH partners also showed improved allowance rates, reduced numbers of Office Actions, and reduced pendency statistics for PPH applications as compared to non-PPH applications.

In addition, patent practitioners reporting to a PCT list-serve operated by Carl Oppedahl of the Oppedahl Patent Law Firm LLC have reported receiving Notices of Allowance issued from the USPTO within 2-15 days from the date of a PCT-PPH (ISA/Korea) request.

¹ "Notice Regarding the Elimination of the Fee for Petitions To Make Special Filed Under the Patent Prosecution Highway (PPH) Programs," Fed. Reg., May 25, 2010 (Vol. 75, No. 100, pp 29312-29313)

² <http://www.aipla.org/Template.cfm?Section=20106&Template=/ContentManagement/ContentDisplay.cfm&ContentID=24733> (reported May 20, 2010)



Practice Tips for Fast-Tracking a U.S. Patent Application via the PPH

With respect to the non-PCT PPH, dockets should be reviewed to determine answers to the following questions:

1. Has a notice of allowability issued with respect to one or more claims filed in an application in Australia, Canada, Denmark, Europe, Finland, Germany, Hungary, Japan, Korea, Singapore, or the United Kingdom ("the partner application") for which there is a corresponding U.S. application?
2. Has a U.S. application corresponding to the partner application received a First Office Action on the merits?

If the answer to Question 1 is Yes and the answer to Question 2 is No, the U.S. application is in a position to enter the PPH.

If the answer to Question 1 is Yes and the answer to Question 2 is Yes, one may wish to consider filing a U.S. continuation application and submitting a PPH request regarding the continuation application. This may be appropriate in a situation such as the following:

- The first U.S. application (for which prosecution has begun, called "US1") contains claims of a broader scope than the scope of the allowed claims in the partner application.
- The allowed claims of the partner application are of value to the client, either commercially or otherwise.
- Allowance of the US1 claims does not appear acceptably easy or imminent.
- A continuation application ("US2") may be filed along with a PPH request, where the US2 claims sufficiently correspond to the allowed claims of the partner application.

While US2 will still undergo substantive examination under the PPH, relatively prompt allowance of the US2 claims may be secured while the applicant still pursues the broader claims pending in US1. One would have to be careful of statements made during prosecution of both cases, however, so as not to compromise the prosecution history of either case.



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With respect to the PCT-PPH, dockets should be reviewed to determine answers to the following questions:

1. Has a favorable international work product regarding a PCT application issued where the USPTO, JPO, EPO, or KIPO has acted as the ISA?
2. Has a U.S. application relating to the PCT received a First Office Action on the merits?

If the answer to Question 1 is Yes and the answer to Question 2 is No, the U.S. application is in a position to enter the PPH.

If the answer to Question 1 is Yes and the answer to Question 2 is Yes, one may wish to consider filing a U.S. continuation application and submitting a PCT-PPH request regarding the continuation application. This may be appropriate in a situation such as the following:

- The first U.S. application (for which prosecution has begun, called "US1") contains claims of a broader scope than the scope of claims favorably treated by the USPTO, EPO, JPO, or KIPO ISA in the corresponding PCT application ("the favorably treated PCT claims").
- The favorably treated PCT claims are of value to the client, either commercially or otherwise.
- Allowance of the US1 claims does not appear acceptably easy or imminent.
- A continuation application ("US2") may be filed along with a PCT-PPH request, where the US2 claims sufficiently correspond to the favorably treated PCT claims.
- While US2 will still undergo substantive examination under the PCT-PPH, relatively prompt allowance of the US2 claims may be secured while the applicant still pursues the broader claims pending in US1. One would have to be careful of statements made during prosecution of both cases, however, so as not to compromise the prosecution history of either case.

Finally, applicants should be aware that taking advantage of the PPH may decrease any patent term adjustment that would accrue due to USPTO delay. In cases in which the end of a patent term is more valuable than the start of the term, PPH entry may not be advantageous.



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