Notice Regarding Full Implementation of Patent Prosecution Highway Program between the United States Patent and Trademark Office and the Japan Patent Office

I. Background

The United States Patent and Trademark Office (USPTO) has conducted a Patent Prosecution Highway (PPH) pilot program with the Japan Patent Office (JPO) for 18 months from July 3, 2006, to January 3, 2008. For a complete description of the PPH pilot program, see "Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Japan Patent Office," published on June 13, 2006 at 1307 OG 61, "Revised Requirements for Requesting Participation in the Patent Prosecution Highway Pilot Program in the USPTO," published on January 30, 2007 at 1314 OG 1398, and "Revised Requirements for Requesting Participation in the Patent Prosecution Highway Pilot Program in the USPTO," published on June 12, 2007 at 1319 OG 63. The results of the pilot program showed that (1) applicants have been able to expeditiously obtain a patent in the Office of second filing (OSF) at an early stage, by utilizing the petition to make special procedures currently available in the OSF, based on claims that have been allowed in the Office of first filing (OFF); (2) the OSF has been able to reduce duplication of search efforts by exploiting the search and examination results of the OFF to a maximum extent practicable; and (3) the OSF has been able to reduce the examination workload since the scope of the claims in the OSF application has been clarified through the OFF's examination prosecution.

II. Full Implementation of the Patent Prosecution Highway Program

The USPTO and the JPO agreed at the November 2007 Trilateral Conference to fully implement the PPH program on a permanent basis starting in January 4, 2008. The requirements for requesting participation in the PPH program have been revised based on our experience with the PPH pilot program. In particular, under the permanent program (1) the request for participation in the PPH program and the supporting documents must be submitted via EFS-Web; (2) applications eligible to participate in the PPH program have been expanded to include PCT applications that contain no priority claims; and (3) rather than having to submit a copy of all the Office actions from the JPO application along with an English translation thereof, applicants only need to submit a copy of the Office action from the JPO application just prior to the "Decision to Grant a Patent" along with an English translation thereof (e.g., the latest "Notification of Reasons for Refusal").

Note that the procedures for a petition to make special under the accelerated examination program set forth in MPEP 708.02(a) do <u>NOT</u> apply to a petition to make special under the PPH program. The procedures and requirements for filing a request in the USPTO for participation in the PPH program are set forth below.

A. Requirements for Requesting Participation in the PPH Program in the USPTO

In order to be eligible to participate in the PPH program, the following conditions must be met:

(1) The U.S. application is

(a) a Paris Convention application which either
(i) validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
(ii) validly claims priority to a PCT application that contains no priority claims,

or

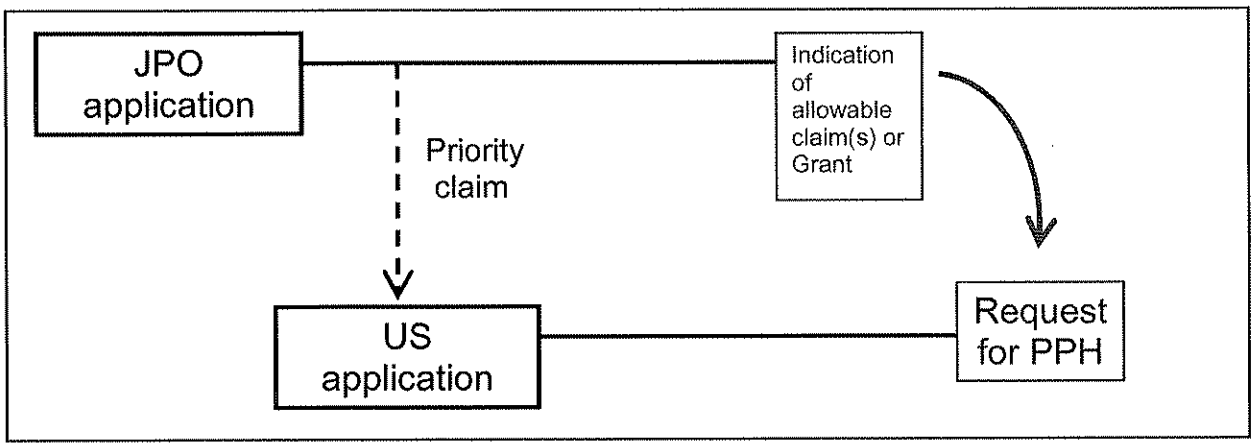
(b) a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
(i) validly claims priority to an application filed in the JPO, or
(ii) validly claims priority to a PCT application that contains no priority claims, or
(iii) contains no priority claim,

or

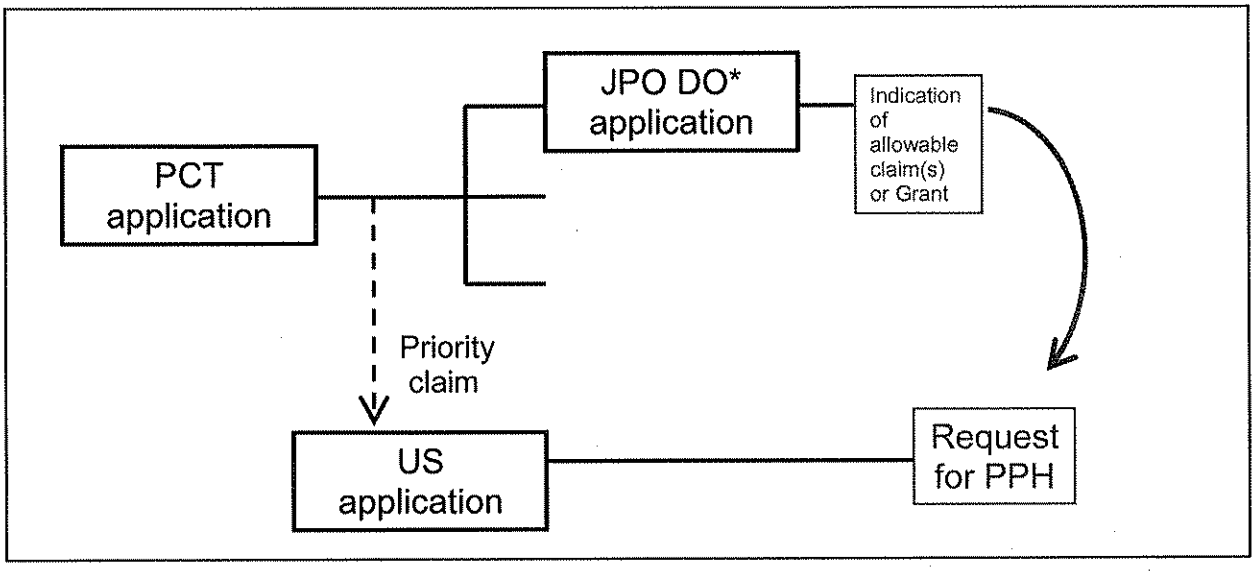
(c) a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
(i) validly claims priority to an application filed in the JPO, or
(ii) validly claims priority to a PCT application that contains no priority claims, or
(iii) contains no priority claim.

Examples of U.S. applications that fall under requirement (1) are:

(1)(a)(i):

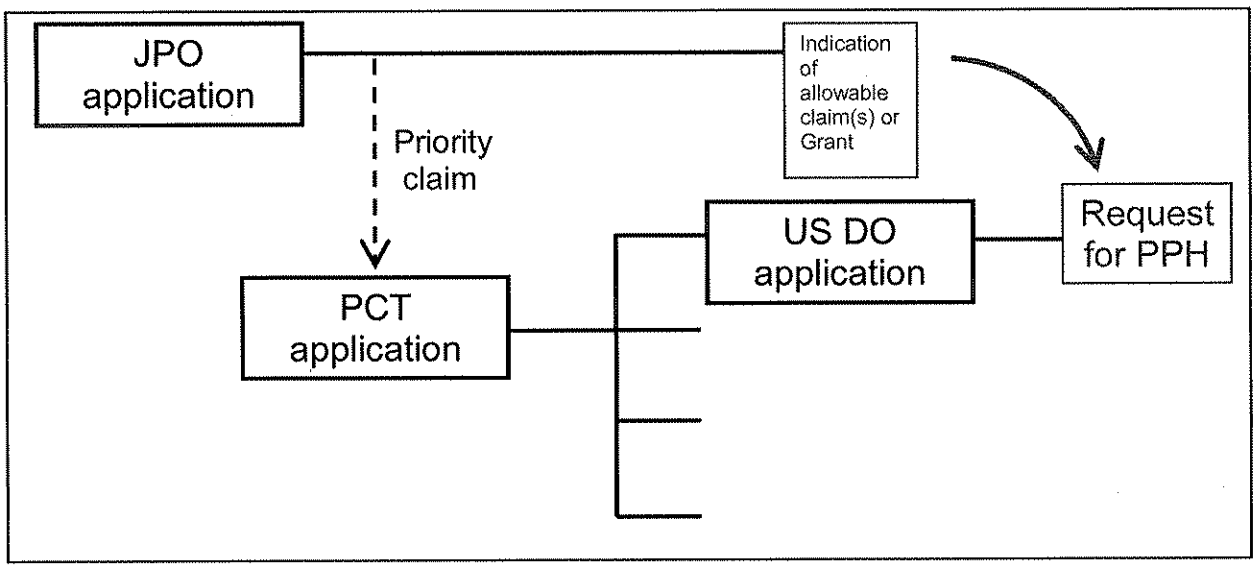


(1)(a)(ii):



* DO- Designated Office

(1)(b)(i):



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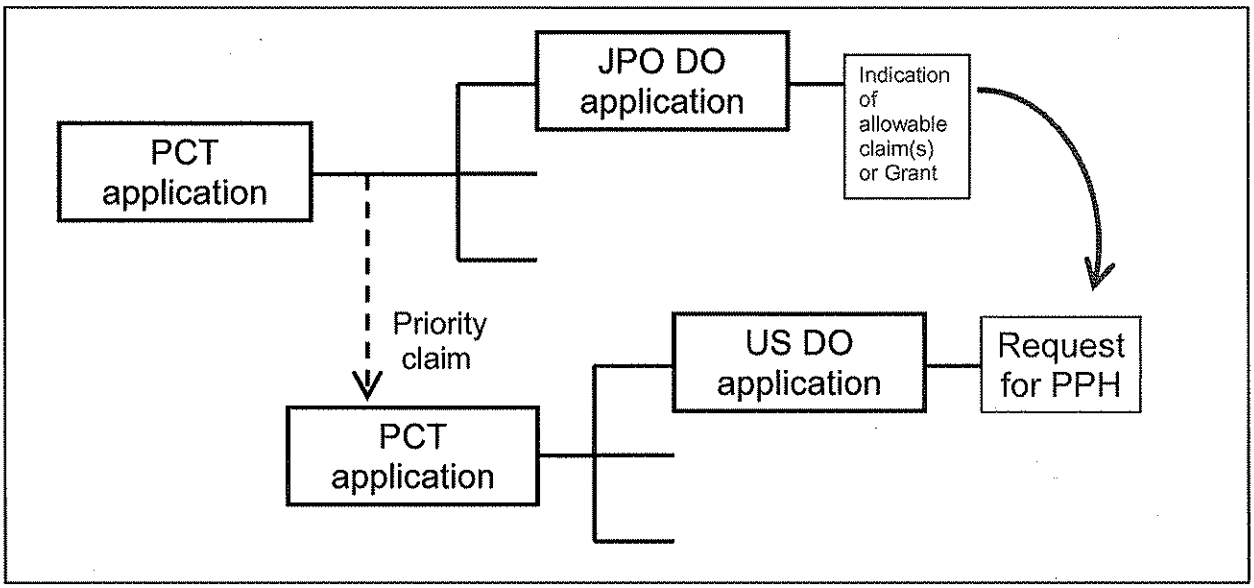
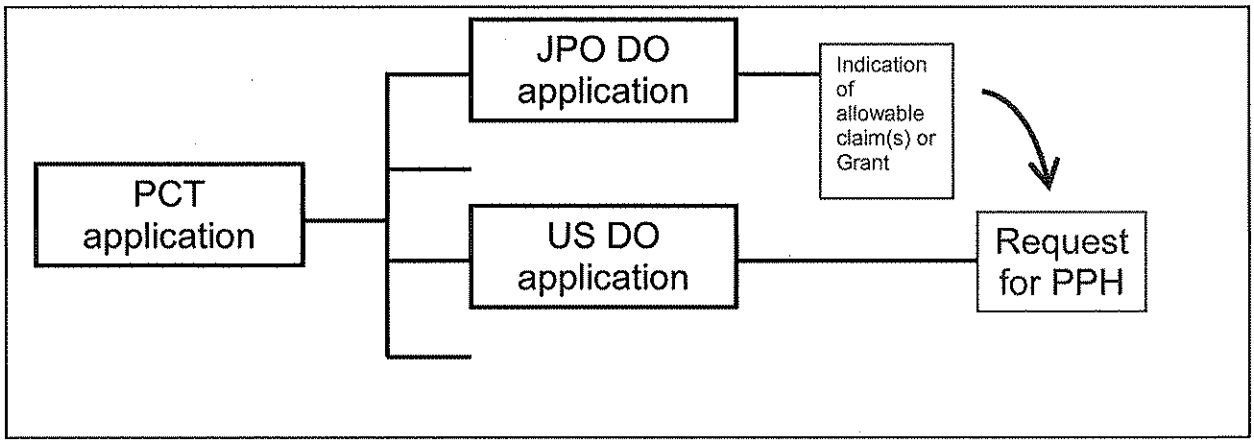
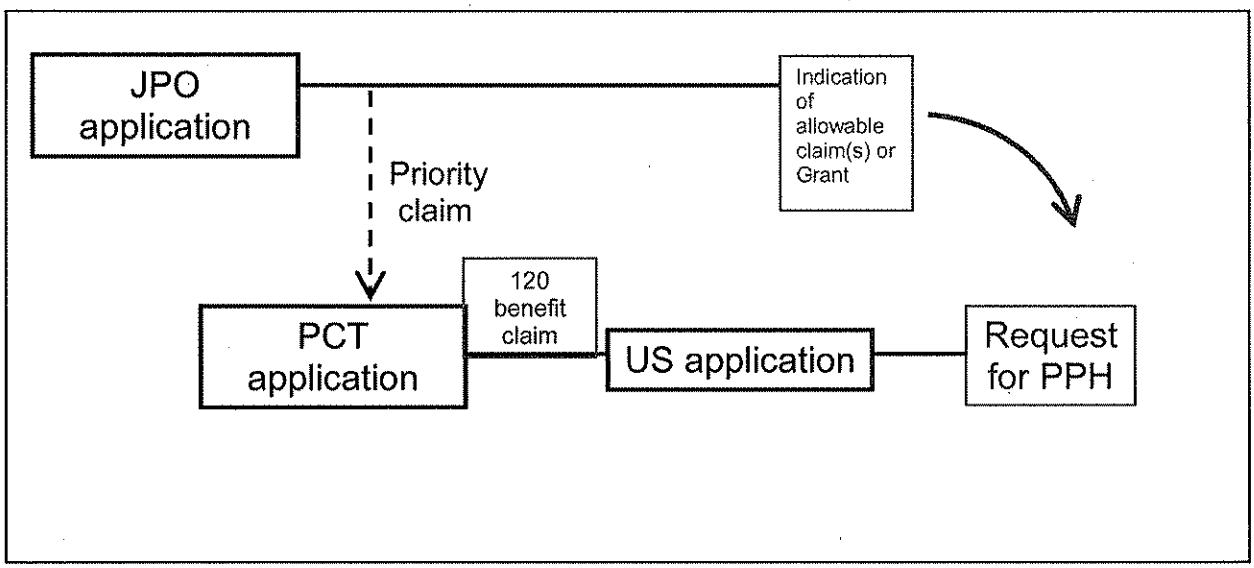

JPO DO application
Indication of allowable claim(s) or Grant
PCT application
Priority claim
US DO application
Request for PPH
PCT application

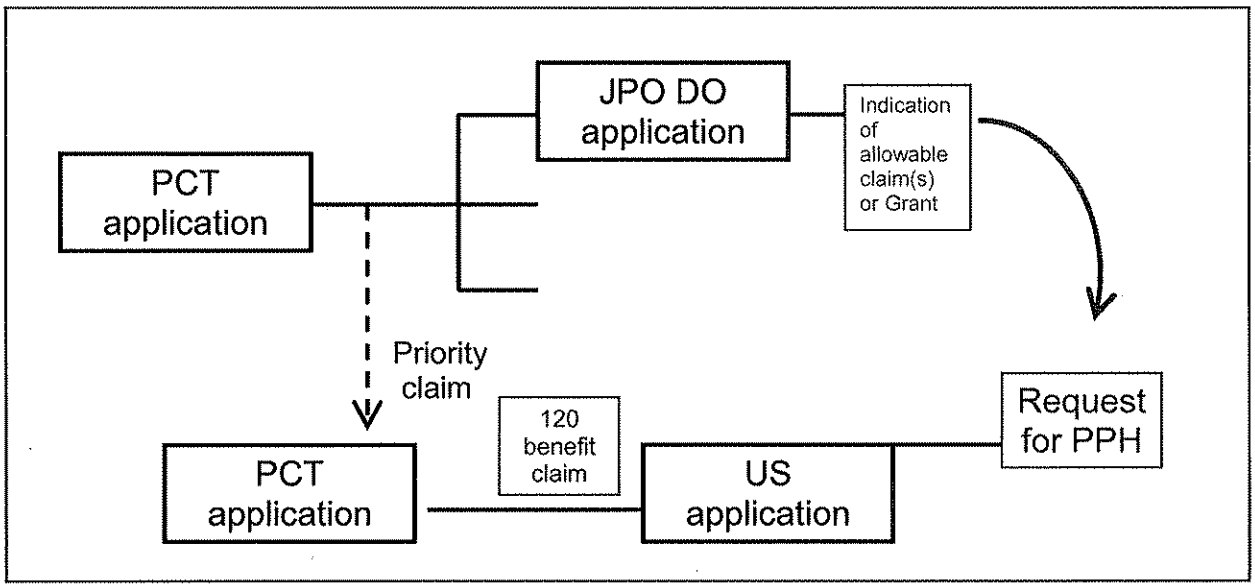
(1)(b)(iii):


JPO DO application
Indication of allowable claim(s) or Grant
PCT application
US DO application
Request for PPH

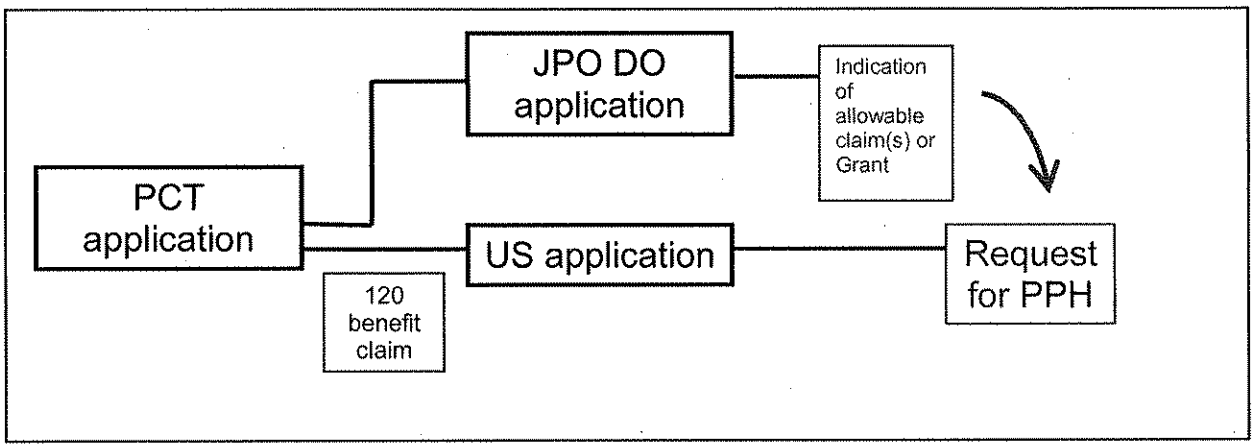
(1)(c)(i):


JPO application
Indication of allowable claim(s) or Grant
Priority claim
120 benefit claim
PCT application
US application
Request for PPH

(1)(c)(ii):


JPO DO application
Indication of allowable claim(s) or Grant
PCT application
Priority claim
120 benefit claim
Request for PPH
PCT application
US application

(1)(c)(iii):



Note that where the JPO application that contains the allowable/patentable claims is not the same application for which priority is claimed in the U.S. application, applicant must identify the relationship between the JPO application that contains the allowable/patentable claims and the JPO priority application claimed in the U.S. application (e.g., JPO application 2007-xxxxxx that contains the allowable/patentable claims, claims internal priority to JPO application 2006-xxxxxx, which is the priority application claimed in the U.S. application).

Provisional applications, plant and design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order are <u>excluded</u>.

(2) The JPO application(s) have at least one claim that was determined by the JPO to be allowable/patentable. Applicant must submit a copy of the allowable/patentable claims from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate. If a copy of the allowable/patentable claims from the JPO application(s) is available via the Dossier Access System, applicant may request that the USPTO obtain the copy via the Dossier Access System. In this case, applicant is still required to submit the English translation along with the statement that the translation is accurate. If the copies cannot be obtained by the USPTO via the Dossier Access System due to technical problems, applicant will be notified and requested to provide the necessary documents.

(3) All the claims in each U.S. application for which a request for participation in the PPH program is made must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claims in the JPO application(s). Claims will be considered to sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope. Applicant is also required to submit a claims correspondence table in English. The claims correspondence table must indicate how all the claims in the U.S. application correspond to the allowable/patentable claims in the JPO application(s).

(4) Examination of the U.S. application for which participation in the PPH program is requested has not begun.

(5) Applicant must file a request for participation in the PPH program and a petition to make the U.S. application special under the PPH program. A sample request/petition form (PTO/SB/20JP) is available at the USPTO Web site at http://www.uspto.gov/web/patents/pph/pph_jpo.html. Applicants are encouraged to use the USPTO request/petition form. A petition fee under 37 CFR 1.17(h) for the petition to make special under 37 CFR 1.102(d) is required and must be submitted.

(6) Applicant must submit a copy of the Office action from the JPO application just prior to the "Decision to Grant a Patent" (e.g., the latest "Notification of Reasons for Refusal") from each of the JPO application(s) containing the allowable/patentable claims that are the basis for the request, along with an English translation thereof and a statement that the English translation is accurate. If the request for participation in the PPH is based on an identification of allowable/patentable claim(s) in a "Notification of Reasons for Refusal," then applicant must submit a copy of the "Notification of Reasons for Refusal" along with an English translation thereof, and a statement that the English translation is accurate.

It will not be necessary for applicant to submit a copy of the "Decision to Grant a Patent" and an English translation thereof. If the JPO application is a first action allowance, i.e., there is no Office action just prior to the "Decision to Grant a Patent", then applicant should indicate on the request/petition form that no Office action from the JPO application is submitted since the JPO application was a first action allowance. If a copy of the office action from the JPO application(s) is available via the Dossier Access System, applicant may request that the USPTO obtain the copy via the Dossier Access System. In this case, applicant is still required to submit the English translation along with the statement that the translation is accurate. If the copies cannot be obtained by the USPTO via the Dossier Access System due to technical problems, applicant will be notified and requested to provide the necessary documents.

(7) Applicant must submit an information disclosure statement (IDS) listing the documents cited by the JPO examiner in the JPO office action (unless such an IDS has already been filed in the U.S. application). Applicant must submit copies of all the documents cited in the JPO office action (unless the copies have already been filed in the U.S. application) except U.S. patents or U.S. patent application publications.

The request for participation in the PPH program and all the supporting documents must be submitted to the USPTO via EFS-Web and indexed as PPH.REQUEST. Information regarding EFS-Web is available at http://www.ustpo.ogv/ebc/efs_help.html. Any preliminary amendments and IDS submitted with the PPH documents must be separately indexed as a preliminary amendment and IDS, respectively.

Where the request for participation in the PPH program and special status are granted, applicant will be notified and the U.S. application will be advanced out of turn for examination. In those instances where the request for participation in the PPH program does not meet all the requirements set forth above, applicant will be notified and the defects in the request will be identified. Applicant will be given one opportunity to perfect the request in a renewed request for participation (which must be submitted via EFS-Web and indexed accordingly as noted above). Note that action on the application by the examiner will NOT be suspended (37 CFR 1.103) awaiting a reply by the applicant to perfect the request in a renewed request for participation. That is, if the application is picked up for examination by the examiner after applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, the request and special status will be granted, applicant will be notified and the U.S. application will be advanced out of turn for examination. If not perfected, applicant will be notified and the application will await action in its regular turn.

(8) Request for participation in the PPH program and special status granted in a parent application will not carry over to a continuing application. Continuing applications must separately fulfill the conditions set forth above.

If any of the documents identified in items (2), (6) and (7) above have already been filed in the U.S. application prior to the request for participation in the PPH pilot program, it will not be necessary for applicant to resubmit these documents with the request for participation. Applicant may simply refer to these documents and indicate in the request for participation in the PPH program when these documents were previously filed in the U.S. application.

C. Special Examining Procedures

Once the request for participation in the PPH program and special status have been granted to the U.S. application, the U.S. application will be taken up for examination by the U.S. examiner before all other categories of applications except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination."

Any claims amended or added after the grant of the request for participation in the PPH program must sufficiently correspond to one or more allowable/patentable claims in the JPO application(s). Applicant is required to submit a claims correspondence table along with the amendment (see B.(3) above). If the amended or newly added claims do not

sufficiently correspond to the allowable/patentable claims in the JPO application(s), the amendment will not be entered and will be treated as a non-responsive reply. Applicant must also submit copies of any office actions from each of the JPO application(s) issued after the grant of the request for participation in the PPH program (especially where the JPO might have reversed a prior holding of allowability) along with English translations thereof and a statement that the English translation is accurate.

The PPH program does not absolve applicants of all their duties under 37 CFR 1.56. By complying with requirements 6 and 7 identified above, applicants would be considered to have complied with their duties to bring to the attention of the USPTO any material prior art cited in the corresponding foreign application(s) (see MPEP § 2001.06(a)). Applicants must still provide to the USPTO other information known to them to be material to patentability.

Any inquiries concerning this notice may be directed to Magdalen Greenlief, Office of the Deputy Commissioner for Patent Examination Policy, at 571-272-8800 or at magdalen.greenlief@uspto.gov.

Date: 12/28/07

John J. Doll
Commissioner for Patents