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34. The notices regarding PPH indicate that U.S. claims will be considered to sufficiently correspond with the claims allowed by the OEE if the U.S. claims are of the same or similar scope or the U.S. claims are narrower in scope than the allowed claims. The additional limitation that makes the U.S. claims narrower in scope than the allowed claims must be presented in dependent form. Can applicant incorporate the narrower dependent claim into the independent claim during the U.S. prosecution if the independent claim which has the same scope as the allowed claim was rejected by the U.S. examiner but the narrower dependent claim was objected to as being dependent on a rejected claim?
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1. What is PPH and how does it help me?

The Patent Prosecution Highway (PPH) is a framework in which an application whose claims have been determined to be patentable by an Office of Earlier Examination (OEE) is eligible to go through an accelerated examination in an Office of Later Examination (OLE) with a simple procedure upon an applicant's request.

PPH, through the exploitation of all the search/examination-related information of the OEE,

- (1) delivers lower prosecution costs,
- (2) supports applicants in their efforts to obtain stable patent rights efficiently around the world, and
- (3) reduces the search/examination burden and improves the quality of the examination of the major patent offices in the world.

2. Is there a place where I should look for a complete listing of PPH participating Offices?

The complete list of Offices participating with the USPTO in the PPH is available at:

http://www.uspto.gov/patents/init_events/pph/index.jsp.

In addition, the USPTO has worked closely with the Japan Patent Office (JPO) to create a one-stop PPH information portal, hosted on the JPO website (<http://www.ipo.go.jp/ppph-portal/index.htm>). At this portal, applicants can find relevant information about all current PPH programs, including up-to-date statistics and fillable request forms.

3. How do I know if my USPTO patent application is eligible for PPH?

Your USPTO patent application is eligible for PPH if:

- 1) your USPTO application shares a common earliest priority date with a related application from a partnering PPH office (http://www.uspto.gov/patents/init_events/pph/index.jsp);
- 2) you have received an indication of allowability for at least one claim in the related application;
- 3) all claims in your USPTO application sufficiently correspond (see Question 27 below) to allowable claims in the related application; and
- 4) examination has not begun on your USPTO application (see Question 30 below).

4. Is an application filed before the starting date of the PPH program eligible for participation in the program?

Yes, as long as the other criteria are met (see Question 3 above).

5. Are any types of applications excluded from the PPH program?

Provisional applications, plant applications, design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order are not eligible for the PPH program.

6. How do I participate in the PPH program at the USPTO?

In order to have your application considered for PPH you must meet all the criteria (see Question 3 above) and submit via EFS-Web a PPH Request form along with supporting documents. Click here for a list of PPH Request forms (http://www.uspto.gov/patents/init_events/pph/index.jsp).

7. What supporting documents need to be submitted with the PPH Request form?

In addition to the PPH Request form, applicant must submit a copy of the appropriate OEE work product (see Question 10 below), with an English translation if applicable, and an information disclosure statement (IDS) listing the references cited in the OEE work product along with copies of references which are not U.S. patents or U.S. patent application publications.

If the OEE work product is already present in your USPTO application or is available via the Dossier Access System web site (<http://www.ipa.go.jp/ppph-portal/filewrapper.htm>) or the PATENTSCOPE system (<http://patentscope.wipo.int>) of the World Intellectual Property Organization (WIPO), a separate copy need not be supplied with the PPH request.

Any IDS or reference copies already present in your USPTO application need not be resubmitted.

8. Can a PPH request be filed if the executed declaration of the inventors has not been filed with the USPTO yet?

Yes. An executed declaration of the inventors is not a supporting document that needs to be submitted with a PPH request.

9. The PPH notices indicated that the PPH papers must be submitted via EFS-Web. What document description should I use to submit the PPH request?

The document description for the PPH request is "Petition to make special under Patent Pros Hwy."

For the IDS accompanying the PPH request, the document description is "Information Disclosure Statement (IDS)."

For a preliminary amendment accompanying the PPH request, the document description is "Preliminary amendment."

10. In the OEE application, applicant received one or more rejections (notifications of refusal to grant a patent) in addition to the decision to grant a patent. Which office action must be furnished as the OEE work product?

If the OEE application is not a PCT application, a copy of the office action immediately prior to the “Decision to Grant a Patent” from the OEE must be provided. If the OEE application is a PCT application, the most recent PCT work product must be provided.

11. The notice regarding the PPH programs state that if a copy of the office action from the OEE application(s) is available via the Dossier Access System, applicant may request that the USPTO obtain the copy via the Dossier Access System. Please advise how an applicant could find out whether an OEE office action is available via the Dossier Access System or not.

Applicant can determine the availability of the office action by checking the Dossier Access System Web site at <http://www.ipo.go.jp/ppph-portal/filewrapper.htm> and the PATENTSCOPE system of the World Intellectual Property Organization (WIPO) at <http://patentscope.wipo.int>.

In certain cases, the dossier can be accessed only by intellectual property offices and not by the public. If applicant is unable to determine whether the OEE work product is available via the Dossier Access System or PATENTSCOPE, applicant should provide a copy of the OEE work product. To avoid dismissal of the initial PPH request and potential denial of participation in the PPH program, the applicant should verify that the document is actually available via the Dossier Access System or PATENTSCOPE before requesting retrieval.

12. If an English translation of the OEE work product is required, what types of translations are acceptable and what are the requirements?

The English translation may be a machine translation. However, if the USPTO finds the machine translation is of such poor quality that it is difficult to understand, the applicant may be required to submit a manual translation. The manual translation does not need to be certified.

13. Can I rely on the allowed claims from a utility model or an innovation patent from an OEE to form the basis for requesting PPH in the USPTO?

With one exception, the answer is no. Utility models and innovation patents as a general matter are not required to meet the same patentability standards as regular (utility) patents, and typically are not subjected to substantive examination. An exception has been made for Korean utility models (see notice available at <http://www.uspto.gov/web/offices/com/sol/og/2009/week08/TOC.htm#ref14>). The USPTO continues to consider practices in other countries with regard to possible inclusion in the future of similar types of applications, but has made no decisions as such at this time.

14. Can you provide some information or explanation about what is meant by “a positive Extended European Search Report”?

The EPO generates an Extended European Search Report (EESR) prior to an office action. If the EESR only contains “A” references (no “X” or “Y” references) directed to a particular claim then that claim is

considered to be allowable by the EPO. You will be able to use that EPO allowable claim as the basis for your PPH request in the US application.

15. The first action in the OEE application is a first action allowance. In the Decision to grant, the OEE examiner cited several references. Should I submit an IDS listing those references, even though there was no rejection?

Although the submission of an IDS in this scenario would not be an explicit requirement of the PPH program, applicant still has a duty to bring to the attention of the Office any material prior art or other information cited or brought to applicant's attention in any related foreign application. See MPEP 2001.06(a).

16. When the documents cited in an IDS are in a foreign language, are applicants required to provide an English translation of the documents?

The IDS must comply with the content requirements of 37 CFR 1.98. That is, if the documents are not in English, you will need to submit a concise explanation of the relevance pursuant to 37 CFR 1.98(a)(3). Where the document listed on the IDS is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office (see MPEP 609.04(a), subsection III.)

17. I am filing a national stage entry into the U.S. of a PCT application. Can I file the PPH request form simultaneously with the national state entry papers? What is the required application number? What is the proper filing date?

If you are entering national stage into the U.S. based on a PCT application, there is no requirement that you file your PPH request with the filing of the national stage papers. It is not necessary to file your PPH papers so early because even if your PPH request is granted, our examiner cannot examine your application as special until the application has completed all its pre-exam processing. It is suggested that you wait until at least you get your U.S. application number so that you can identify the U.S. application number on the PPH request before you file your PPH papers. Note that the filing date of a national state entry into the U.S. of a PCT application is the international filing date (see 35 U.S.C. 363).

18. What is the processing time for a PPH request?

Processing time for deciding the PPH petition depends on a number of factors, including the volume of applications and the available staff to process the requests. At the conclusion of 2017, the average processing time was approximately 2 months from the time a PPH request was filed to the initial decision.

19. How will I know if my PPH request is granted?

The USPTO will send you a decision on your request for participation.

20. I recently filed a PPH request and upon review noted that there were errors on the PPH request. With regard to the PPH request error, is it possible to amend the error before I receive a decision on the PPH request?

If you have not received a decision on your PPH request, it is suggested that you submit a corrected PPH request form via EFS-Web as soon as possible. In addition, you should also submit a transmittal letter with these documents explaining that the earlier-filed PPH request contained errors and the replacement documents corrected the errors. If you have already received a decision on the PPH request, in your reply to the PPH decision you should submit the corrected PPH request form. You should also submit a transmittal letter explaining the errors that you are correcting in the replacement PPH request form.

21. My PPH request was dismissed. What is the time period for filing a renewed PPH request?

The applicant will be given **ONE** opportunity within a time period of **ONE MONTH** from the mailing date of the dismissal to perfect the request (correct the deficiencies noted in the decision) in a renewed request for participation. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected within the time period given, the application will await action in its regular turn.

22. My renewed PPH request was denied. Can I file a new PPH request?

No. If the PPH request is denied (as opposed to dismissed), applicant may not file a new or renewed PPH request in the same application. However, a PPH request may be filed in a continuing application.

23. How much quicker will an application proceed to grant if a PPH request is filed at the USPTO? Is there a similar goal of final disposition as in Accelerated Examination (AE)?

The PPH program does not have a similar goal of final disposition of 12 months as in the AE program. The PPH program does not require the request to be filed at the time of filing of the application as in the AE program. The PPH program does not expedite the pre-exam processing as in the AE program. Under the PPH program, applicant chooses when to file the PPH papers. If the PPH request is granted, the examiner will generally examine the application within 2 to 3 months from the grant of the PPH request provided the application has completed all its pre-exam processing and is ready for examination.

24. Is it possible to withdraw from the PPH program after I receive a granted PPH request?

No. Once a PPH request has been granted, the application is accorded special status which is retained throughout the prosecution of the application. If participation in the PPH program is no longer desired, applicant may wish to consider filing a continuing application.

25. Once an application attains special status under the PPH, does the special status apply to continuing applications (e.g., continuation application, C.I.P. application, or divisional application)?

No. Special status under the PPH does not carry over to a continuing application. However, special status under the PPH is retained when a request for continued examination (RCE) is filed.

26. If my PPH request is granted and later on in prosecution an RCE is filed in the same application, will the PPH status still apply in the application?

Yes. Once a PPH request has been granted, the application retains its special status throughout the prosecution of the same application. The filing of an RCE continues prosecution in the same application, unlike the filing of a new continuing application.

27. How is sufficient correspondence determined?

A claim is considered to sufficiently correspond where the claim is of the same or similar scope as an allowable claim in the related OEE application. A claim that is narrower in scope than an allowable OEE claim will also sufficiently correspond if it presented as a claim dependent upon a claim that is of the same or similar scope to an allowable OEE claim.

28. If the allowed claims in my OEE application are solely method claims, may I include corresponding apparatus claims in my USPTO application?

No. A claim in the USPTO application that introduces a different category of claims than that of the allowable OEE claims is not considered to sufficiently correspond, even if the claim is presented as a claim dependent upon a claim which does sufficiently correspond to an allowable OEE claim.

29. My OEE work product contains one or more allowed “use” claims, which are not permitted in U.S. practice. May I rewrite the “use” claims as “method” claims when filing a PPH request?

No. The presentation of a “method” claim in this circumstance would introduce a different category of claim and therefore the “method” claim would not sufficiently correspond to the allowed “use” claim. Furthermore, the respective scopes of “use” and “method” claims usually differ significantly, thereby limiting any work sharing benefit.

30. I understand that a PPH request may not be filed after examination of the U.S. application has begun. Does this mean substantive examination? In other words, can a PPH request be filed after the USPTO has reviewed the U.S. application for formalities only (for example, a Notice to File Missing Parts is mailed)? Can the PPH petition be filed after an applicant has received a restriction requirement but before receipt of the first office action on the merits?

The requirement that examination of the U.S. application must not have begun refers to substantive examination. Therefore, if you have only received a notice to file missing parts, this would not be considered as substantive examination. If you have received a restriction requirement in the U.S. application, your U.S. application may still be eligible to participate in the PPH program if the examiner has not started on the first action on the merits.

31. If an application is recognized as eligible for the PPH, is the application going to be granted without a substantive examination?

No. Substantive examination under the PPH is conducted according to the U.S. law and guidelines in the same way as non-PPH applications. While there is no guarantee that the result of the USPTO examination will match that of the OEE, PPH applications in general enjoy higher allowance rates, fewer office actions per disposal, reduced RCE filing rates, and reduced appeal rates than non-PPH applications.

32. I received an office action on the merits after filing a PPH request and before receiving a decision on the PPH request. Will the U.S. application be eligible to participate in the PPH program?

No. If substantive examination of the application began before the PPH request is granted, the application is not eligible to participate in the PPH program, and the PPH request will be denied.

33. A U.S. application claims foreign priority to an OEE application which contains allowable claims. The U.S. application has received a first office action on the merits. Would it be possible to use the PPH program for a new U.S. continuation or divisional application?

Yes. If you choose to file a U.S. continuation/divisional application, the continuation/divisional application may be eligible to participate in the PPH program based on the allowable claims from the OEE application.

34. The notices regarding PPH indicate that U.S. claims will be considered to sufficiently correspond with the claims allowed by the OEE if the U.S. claims are of the same or similar scope or the U.S. claims are narrower in scope than the allowed claims. The additional limitation that makes the U.S. claims narrower in scope than the allowed claims must be presented in dependent form. Can applicant incorporate the narrower dependent claim into the independent claim during the U.S. prosecution if the independent claim which has the same scope as the allowed claim was rejected by the U.S. examiner but the narrower dependent claim was objected to as being dependent on a rejected claim?

If the narrower dependent claim is indicated as being allowable if written in independent form, you may rewrite the allowable dependent claim in independent form.

35. If an independent claim which sufficiently corresponds to an allowed claim in the OEE work product is rejected by the U.S. examiner but may be allowable if amended to include some additional limitation, will such an amendment meet the sufficient correspondence requirement?

Yes, but only if the limitation was one previously presented in a dependent claim that is indicated as having allowable subject matter but objected to only because it is dependent on a rejected base claim.

36. If a new U.S. application is accepted in the PPH program, is Patent Term Adjustment (PTA) still available to the U.S. application?

PTA is available to applications accepted in the PPH program.

37. Are extensions of time under 37 CFR 1.136(a) available for applications accepted in the PPH program?

Yes. You may obtain extensions of time under 37 CFR 1.136(a) during prosecution of the U.S. application accepted in the PPH program.

38. Can an applicant request a written restriction letter in a PPH application?

MPEP 708.02(a), section III describes the telephonic restriction practice in applications made special for examination. However, applications made special for health/age and PPH are not subject to this requirement. Therefore, it is permissible for an applicant to request a written restriction letter in a PPH application.