

Implementation of the Global and IP5 Patent Prosecution Highway (PPH) Pilot Programs with Participating Offices

I. Background

Beginning in July 2006, the United States Patent and Trademark Office (USPTO) has partnered with several other offices in Patent Prosecution Highway (PPH) programs. The PPH enables an applicant who receives a positive ruling on patent claims from one participating office to request accelerated prosecution of corresponding claims in another participating office, which allows the applicant to obtain a patentability decision in the second office more quickly. Furthermore, the PPH promotes patent application processing efficiency by allowing the examiner in the office of later examination (OLE) to reuse the search and examination results from the office of earlier examination (OEE), thereby reducing workload and duplication of effort.

Since its inception, various enhancements to the original PPH program have been introduced. For instance, a requirement that the OEE be the office of first filing was eliminated under the "MOTTAINAI" program. See, for example, the notice available at <http://www.uspto.gov/web/offices/com/sol/og/2011/week33/TOC.htm#ref16>. Also, the scope of eligible search and examination results was expanded to include Patent Cooperation Treaty (PCT) work products under the PCT-PPH program. See, for example, the notice available at <http://www.uspto.gov/web/offices/com/sol/og/2010/week08/TOC.htm#ref17>. Additionally, the requirements for requesting participation in the PPH were simplified under the PPH 2.0 program. See, for example, the notice available at <http://www.uspto.gov/web/offices/com/sol/og/2012/week10/TOC.htm#ref15>.

As the work sharing benefits provided by the PPH have become apparent, participation in the PPH program in its various forms has grown rapidly. However, because the above-described modifications to the PPH program have not been universally implemented by the different participating offices, the administration of multiple PPH programs, each having particular requirements, has become increasingly cumbersome. Recognizing the need and opportunity for greater efficiency, the USPTO and several other offices seek to consolidate and replace existing PPH programs, with the goal of streamlining the PPH process for both offices and applicants. To this end, the USPTO and other offices have established the Global PPH pilot program and the IP5 PPH pilot program.

The Global PPH and IP5 PPH pilot programs are running concurrently and are substantially identical, differing only with regard to their respective participating offices. The USPTO is participating in both the Global PPH pilot program and the IP5 PPH pilot program. A list of the other offices currently participating in the Global PPH pilot program is available at http://www.uspto.gov/patents/init_events/pph/. The European Patent Office (EPO), Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO), and State Intellectual Property Office of the People's Republic of China (SIPO) are participating in the IP5 PPH pilot program.

Because the USPTO has elected to participate in both the Global PPH pilot program and the IP5 PPH pilot program, a PPH request may be filed in the USPTO based on the work product of any

office participating in either pilot program. Furthermore, because the respective requirements for the Global PPH and IP5 PPH pilot programs are equivalent, USPTO applicants need not specify which pilot program is being utilized. For USPTO applications, the Global PPH and IP5 PPH pilot programs supersede any prior PPH program between the USPTO and each Global PPH and IP5 PPH participating office. Any existing PPH programs between the USPTO and offices that are not participating in either the Global PPH pilot program or the IP5 PPH pilot program remain in effect.

II. Trial Period for the Global PPH and IP5 PPH Pilot Programs

The Global PPH and IP5 PPH pilot programs commenced on January 6, 2014. The Global PPH pilot program will run for a period of one year ending on January 5, 2015. The IP5 PPH pilot program will run for a period of three years ending on January 5, 2017. The trial period for each pilot program may be extended if necessary to adequately assess the feasibility of the PPH program. The participating offices will continually evaluate the results of the Global PPH and IP5 PPH pilot programs to determine whether and how the programs should be fully implemented. The offices also may terminate either the Global PPH pilot program or the IP5 PPH pilot program early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if either the Global PPH pilot program or the IP5 PPH pilot program will be terminated.

III. Requirements for Requesting Participation in the Global PPH or IP5 PPH (“Global/IP5 PPH”) Pilot Program in the USPTO

A. Eligibility

In order to be eligible to participate in the Global/IP5 PPH pilot program at the USPTO, the following requirements must be met:

(1) The U.S. application for which participation in the Global/IP5 PPH pilot program is requested must have the same earliest date, whether this is the priority date or filing date, as that of a corresponding national or regional application filed with another Global/IP5 PPH participating office, or a corresponding PCT international application for which one of the Global/ IP5 PPH participating offices was the International Searching Authority (ISA) or the International Preliminary Examining Authority (IPEA).

(2) The corresponding application has at least one claim indicated by the OEE in its capacity as a national or regional Office, ISA, or IPEA to be allowable/patentable. A claim determined as novel, inventive, and industrially applicable by the ISA or IPEA has the meaning of allowable/patentable for the purposes of this program.

(3) All claims in the U.S. application for which participation in the Global/IP5 PPH pilot program is requested must sufficiently correspond to the allowable/patentable claims in the corresponding OEE application. A claim is considered to sufficiently correspond where,

accounting for differences due to claim format requirements, the claim is of the same or similar scope as an allowable/patentable claim in the corresponding OEE application. A claim in the U.S. application that is narrower in scope than the claims indicated as allowable/patentable in the OEE application will sufficiently correspond if presented as a claim dependent upon a claim that is of the same or similar scope as a claim indicated as allowable/patentable in the OEE application. In this regard, a claim that is narrower in scope occurs when an OEE claim is amended to be further limited by an additional feature that is supported by the written description of the U.S. application. Additionally, a claim in the U.S. application that introduces a new/different category of claims than those indicated to be allowable/patentable by the OEE is not considered to sufficiently correspond. For example, where the OEE application contains only claims relating to a process of manufacturing a product, then any product claims in the U.S. application are not considered to sufficiently correspond, even if the product claims are dependent on process claims which sufficiently correspond to allowable/patentable claims in the OEE application.

(4) Substantive examination of the U.S. application for which participation in the Global/IP5 PPH pilot program is requested has not begun.

B. Required Documents

For participation in the Global/IP5 PPH pilot program at the USPTO, the applicant must submit:

(1) A request for participation in the Global/IP5 PPH pilot program and a request that the U.S. application be advanced out of turn for examination by order of the Director to expedite the business of the Office under 37 CFR 1.102(a). A request form is available from the USPTO Web site at http://www.uspto.gov/patents/init_events/pph/. A petition fee under 37 CFR 1.17(h) is NOT required. See Notice Regarding the Elimination of the Fee for Petitions To Make Special Filed Under the Patent Prosecution Highway (PPH) Programs, 75 Fed. Reg. 29312 (May 25, 2010).

(2) A claims correspondence table in English, indicating how and certifying that all the claims in the U.S. application correspond to allowable/patentable claims in the OEE application.

(3) A copy of the office action issued just prior to the “Decision to Grant a Patent” (e.g., the latest “Notification of Reasons for Refusal”) in the OEE national/regional application, along with an English translation thereof, if applicable, or the latest work product in the international phase of the OEE PCT application (e.g., the Written Opinion of the ISA or, where a demand under PCT Chapter II has been filed, the Written Opinion of the IPEA or the International Preliminary Examination Report), along with an English translation thereof, if applicable. Note that if the office action or PCT work product is already present in the U.S. application or is available via the Dossier Access System Web site at <http://www.jpo.go.jp/ppph-portal/filewrapper.htm> or the PATENTSCOPE system of the World Intellectual Property Organization (WIPO), the applicant must identify the document but need not supply a copy thereof.

(4) An information disclosure statement (IDS) listing the documents cited in the office action or PCT work product submitted under item III.B.(3) above along with copies of all documents except U.S. patents and U.S. patent application publications. Note that any IDS or document copies submitted in the U.S. application prior to the Global/IP5 PPH request need not be resubmitted.

The above-listed documents must be submitted via EFS-Web and indexed with the document description "Petition to make special under the Patent Pros Hwy," except that any preliminary amendment or IDS submitted with the PPH request must be separately indexed as a preliminary amendment or an IDS, respectively.

IV. Special Examining Procedures

Where the request for participation in the Global/IP5 PPH pilot program and special status is granted, the 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 Global/IP5 PPH pilot program does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given one opportunity to perfect the request in a renewed request for participation. Note that action on the application by the USPTO will NOT be suspended (37 CFR 1.103) awaiting a renewed request for participation. That is, if the application is picked up for examination after the 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, the applicant will be notified, and the U.S. application will be advanced out of turn for examination. If the request is not perfected, the applicant will be notified and the application will await action in its regular turn.

Although a request for participation in the Global/IP5 PPH pilot program and special status granted in an application carries over to a request for continued examination (RCE) of the application, a request for participation in the Global/IP5 PPH pilot program and special status granted in a parent application will not carry over to a continuing application. The applicant must fulfill all the conditions set forth above in order for special status to be granted in a continuing application.

Any claims amended or added after the grant of the request for participation in the Global/IP5 PPH pilot program must sufficiently correspond to one or more allowable/patentable claims in the OEE application. The applicant is required to submit, along with the amendment, a statement certifying that the amended or newly added claims sufficiently correspond to the allowable/patentable claims in the OEE application. If the certification statement is omitted, the amendment will not be entered and will be treated as a non-responsive reply.

The Global/IP5 PPH pilot program does not absolve applicants of all their duties under 37 CFR 1.56 and 37 CFR 11.18. By complying with requirements III.B.(3) and (4) identified above, the applicant would be considered to have complied with the duty to bring to the attention of the USPTO any material prior art cited in corresponding foreign applications (see MPEP

§ 2001.06(a). The applicant still has a duty of candor and good faith, including providing to the USPTO other information known to be material to patentability.

Any inquiries concerning this notice may be directed to Bryan Lin, Office of PCT Legal Administration at 571-272-3303, or via e-mail addressed to bryan.lin@uspto.gov.

Specific questions about the Patent Prosecution Highway should be directed to the Office of Petitions at 571-272-3282, or via e-mail addressed to PPHfeedback@uspto.gov.

Date: 2/10/14 
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