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OFFICE OF PETITIONS

In re Application of: :
Jeffrey L. PETERS et al. :
Application No. 12/442,845 : ON PETITION
Filing or 371(c) Date: March 24, 2009 :
Attorney Docket No: 02968.0328USWO :

This is a decision on the renewed petition under 37 CFR 1.183, filed February 2, 2010, requesting waiver of certain requirements of the Patent Prosecution Highway Program between the United States Patent and Trademark Office and the Japan Patent Office, the petition is properly treated under 37 CFR 1.182.

The petition is **DENIED**¹.

BACKGROUND

The above application was filed with the USPTO on March 24, 2009 and is a national stage entry of PCT/US07/80306, which claims priority from U.S. Provisional Application 60/829,396.

A petition filed January 7, 2010, requesting waiver of certain requirements of the Patent Prosecution Highway (PPH) Program between the United States Patent and Trademark Office (USPTO) and Japan Patent Office (JPO) was dismissed in the decision of January 19, 2010.

The instant petition again requests waiver of the requirements of the PPH program.

REGULATION AND OFFICE PROCEDURE

In order to 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. 1328 *Off. Gaz. Pat. Office* 44 (March 4, 2008).

37 CFR 1.181 states, in part:

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

OPINION

A Japan Patent Office application, JP 2009-532503, which is also a national stage entry of PCT/US07/080306 has had claims indicated as being allowable. Accordingly, petitioner requests that the instant application be afforded the benefits of the Patent Prosecution Highway (PPH) program because although the office of first filing (OFF) is not the Japan Patent Office (JPO), the JPO has indicated that applicants' claims have been determined to be allowable/patentable. Petitioner argues that this request is consistent with Office goals of

expanding work sharing. As there is no regulation which applies to the PPH program, the request is treated under 37 CFR 1.182.

As set forth above, in order to eligible to participate in the PPH program, the following conditions must be met; it is these conditions which govern the Office's goals with respect to work sharing:

- (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. 1328 *Off. Gaz. Pat. Office* 44 (March 4, 2008).

The instant application is a national stage under the PCT which PCT application validly claims priority to a provisional United States application filed under 35 U.S.C. 119(e), hence the OFF is the United States. Accordingly, the instant application does not meet any of the above requirements and therefore, cannot be advanced out of turn for examination.

While, petitioner is correct in noting that under the PPH program an application is advanced out of turn for examination based upon a determination that claims are allowable/patentable in the JPO that is only when the JPO is the OFF. The PPH program is a negotiated agreement between the USPTO and the JPO which provides for an applicant whose claims are determined to be allowable/patentable in the OFF to request that its corresponding application filed in an office of second filing (OSF) be advanced out of turn provided certain conditions are met. The PPH framework is based on search and examination results being produced by an OFF so that an OSF can rely on the search and examination results of the OFF to a maximum extent practicable. Petitioner further argues that waiving requirements of the PPH program would provide further expansion of work sharing. However, in order for such a waiver to be an expansion of work sharing both the USPTO and JPO would have to further negotiate and agree to waive the requirements of this agreement. Where the USPTO provides notice of a procedure, as the procedure here, which affords the benefit of advanced examination based upon specified requirements, the creation of another scheme (*e.g.*, under 37 CFR 1.182) for other scenarios for advanced examination would be inconsistent with the stated policy of the Office. 37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures. See

Hicks v. Costello, 1903 C.D. 123, 125 (Comm'r. Pats. 1903). Therefore, it would be inappropriate to grant the relief requested.

Despite petitioner's arguments to the contrary it would not be appropriate to treat this petition under either 37 CFR 1.181 or 37 CFR 1.183. Neither 37 CFR 1.181 nor 37 CFR 1.183 apply to the situation here, where it requested that certain requirements of an Office policy not based in regulation be waived.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-7099.



Anthony Knight
Director
Office of Petitions

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02