

# Friday Seminar Series

October 26, 2012

Patent Prosecution Highway (PPH)

# What is PPH?

- The Patent Prosecution Highway (PPH) speeds up the examination process for corresponding applications filed in participating countries by allowing examiners to reuse search and examination results

# Two Main Types

- “Normal” PPH
- PCT-PPH

# “Normal” PPH

- Originally started as a pilot program between USPTO, JPO, and EPO in July 2006
- Allows for expedited examination of claims in an Office of Second Filing (OSF) if at least one claim is found to be patentable in an Office of First Filing (OFF)

# Offices Currently Cooperating With USPTO for "Normal" PPH

Australia	Denmark	Israel	Singapore
Austria	EPO	Japan	Spain
Canada	Finland	Korea	Taiwan
China	Germany	Mexico	UK
Columbia	Hungary	Norway	
Czech Rep.	Iceland	Russia	

# Benefits – Accelerated Examination

- Application made special
  - First OA within 2 to 3 months from grant of PPH Request
  - All subsequent OAs are taken up quicker
  - Appeals taken up out of turn and are heard more quickly

# Comparison of Accelerated Examination

<b>Program</b>	<u>PPH</u>	<u>Track I</u>	<u>Accelerated Examination</u>	<u>Health / Age</u>
<b>Fee</b>	None	Large	\$130*	None
<b>Extensions</b>	Yes	No	No	Yes
<b>Pre-exam search</b>	No	No	Yes	No

# Benefits - Continued

- Greater Efficiency – over 90% allowance rate
- Decreased Costs – On average fewer Office Actions
- Reduced Pendency – But may be forgoing potential patent term extension



# Requirements for Participation

- File application in OFF
- File application in OSF claiming priority to OFF application under Article 4 of Paris Convention (within one year)
- Receive allowance of a claim in OFF
- Request expedited examination in OSF

# Additional Requirements

- Expedited examination in OSF only permissible for claims that “sufficiently correspond” to any allowed claims in OFF
- Request for expedited examination must be received prior to the beginning of examination on the merits in OSF

# “Sufficiently Correspond”

- Claims must of the same or similar scope as allowed claims in OFF
- Claims of narrower scope are permitted but must be in dependent form
- Note: no new limitations may be added after PPH request is filed

# Specific Qualifications in USPTO

- A Paris Convention application that either:
  - Claims priority under 35 USC 119(a) and 37 CFR 1.55 to one or more applications filed with the OFF; or
  - Claims priority under 35 USC 119(a)/365(a) to a PCT application that contains no priority claims

# Specific Quals in USPTO (cont.)

- A national stage entry in the US from a PCT application, which the PCT application
  - Claims priority under 35 USC 365(b) to an application filed with the OFF;
  - Claims priority under 35 USC 365(b) to a PCT application that contains no priority claims; or
  - Contains no priority claims

# Specific Quals in USPTO (cont.)

- A so-called bypass application filed under 35 USC 111(a) that claims benefit under 35 USC 120 to a PCT application which the PCT application
  - Claims priority under 35 USC 365(b) to an application filed with the OFF
  - Claims priority under 35 USC 365(b) to a PCT application that contains no priority claims
  - Contains no priority claims

# Procedural Requirements in USPTO

- Provide copy of allowable claims from OFF
- Submit copies of all Office Actions from OFF application with allowable claims
- Submit IDS and copy of all references cited by OFF
- File request form for PPH participation
- Include English translations for any items not already in English (with statement of accuracy)
- Submit via EFS-Web with correct indexing

# Example request form

- Forms can be found at [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp)

Doc Code: PPH.PET.652

Document Description: Petition to make special under Patent Pros Hwy

PTO/SB/20EP (02-12)

Approved for use through 01/31/2015. OMB 0651-0058

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the invention:			
THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT <a href="http://www.uspto.gov/efs_help.html">HTTP://WWW.USPTO.GOV/EFS_HELP.HTML</a> .			
<p><b>APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.</b></p>			
<p>The above-identified application and the corresponding EP application(s) have the same priority/filing date. If EPO is not the office of first filing (OFF), identify the OFF and the OFF application no.</p>			
<p>The EP application number(s) is/are: _____</p>			
<p>The filing date of the EP application(s) is/are: _____</p>			
<p><b>I. List of Required Documents:</b></p>			
<p>a. A copy of the latest EP office action prior to the "Decision to Grant a Patent" in the above-identified EP application(s) along with an English translation (if the office action is not in the English language)</p>			
<p><input type="checkbox"/> is attached.</p>			
<p><input type="checkbox"/> is <u>not</u> attached because applicant hereby requests the USPTO to obtain the required office action and any required translation thereof via the Dossier Access System.</p>			
<p><input type="checkbox"/> is <u>not</u> attached because the EP application was allowed in a first office action.</p>			
<p>Notes:</p>			
<ul style="list-style-type: none"> <li>It is <u>not</u> necessary to submit a copy of the "Decision to Grant a Patent" and an English translation thereof.</li> <li>The English translation of the office action may be a machine translation.</li> <li>An accuracy statement for the English language translation of the office action is <u>not</u> required.</li> </ul>			
<p>b. (1) An information disclosure statement listing the documents cited in the EP office action</p>			
<p><input type="checkbox"/> is attached.</p>			
<p><input type="checkbox"/> has already been filed in the above-identified U.S. application on _____</p>			
<p>(2) Copies of all documents (except for U.S. patents or U.S. patent application publications)</p>			
<p><input type="checkbox"/> are attached.</p>			
<p><input type="checkbox"/> have already been filed in the above-identified U.S. application on _____</p>			

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This collection of information is required by 35 U.S.C. 119, 37 CFR 1.55, and 37 CFR 1.102(d). The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.



# Dismissed PPH Request

- If a PPH Request is not granted, notification will include a listing of defects
- Applicant has one chance to correct the defects in a renewed request for participation

# PPH MOTTAINAI

- MOTTAINAI is a Japanese term meaning “a sense of regret concerning waste when the intrinsic value of an object or resource is not properly utilized”.
- PPH MOTTAINAI is a pilot program launched July 15, 2011 to improve PPH by relaxing certain requirements for requesting expedited patent examinations

# Changes for PPH MOTTAINAI

- Applicant can now make PPH requests at the Office of Later Examination (OLE) even if it is the OFF
- Applicant can use the results of the Office of Earlier Examination (OEE) even if it is not the OFF
- Applicants can do the above provided the OEE application and OLE application share a priority claim, the OEE and OLE have a PPH MOTTAINAI agreement

# PPH MOTTAINAI Offices

USPTO (USA)	JPO (Japan)	UK-IPO (UK)
CIPO (Canada)	IP Australia (Australia)	NBPR (Finland)
ROSPATENT (Russia)	SPTO (Spain)	EPO (Europe)

# PCT-PPH

- Permits PPH eligibility for national and regional phase applications under the Patent Cooperation Treaty (PCT) on the basis of favorable treatment of a claim in the PCT international phase

# Favorable Treatment

- Favorable Written Opinion (WO) from ISA
- Favorable WO from IPEA
- Favorable International Preliminary Report on Patentability (IPRP) from IPEA
- At least one claim having: Novelty, Inventive Step, and Industrial Applicability
- Note: ISR alone is not enough

# Offices Currently Cooperating With USPTO for PCT-PPH

Australia	Finland	Nordic Patent Institute
Austria	Israel	Russia
China	Japan	Spain
EPO	Korea	Sweeden

# ISAs for USPTO as Receiving Office

ISA	Current Search Fee
EPO (Europe)	\$2,426
KIPO (Korea)	\$1,101
IP Australia (Australia)	\$2,254
ROSPATENT (Russia)	\$453



# Benefits of PCT-PPH

- Same expedited examination as with “Normal” PPH
- Especially when coupled with an inexpensive ISA, PCT-PPH is a very cost effective way to get speedy examination
- Even higher allowance rate than “Normal” PPH
- Can “Double Dip” (e.g., MOTTAINAI PPH)

# Requirements for Participation

- ISA must be participating Office
- Favorable Treatment of at least one claim
- claims seeking expedited treatment must “sufficiently correspond” to any favorably treated claims.
- Request for expedited examination must be received prior to the beginning of examination on the merits

# "Sufficiently Correspond"

- Claims must of the same or similar scope as allowed claims in OFF
- Claims of narrower scope are permitted but must be in dependent form
- Note: new limitations may be added as dependent claims during prosecution (this is different than "Normal PPH")

# Procedural Requirements in USPTO

- Provide copy of favorable treatment document (i.e., WO from ISA/IPEA or IPRP from IPEA)
- Submit IDS and copy of all references cited by ISA (except US Patents / Patent Publications)
- File request form for PCT-PPH participation
- Include English translation of favorably treated claims if in language other than English (with statement of accuracy)
- Submit via EFS-Web with correct indexing

# Example request form

- Forms can be found at [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp)

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REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY – PATENT PROSECUTION HIGHWAY (PCT-PPH) PROGRAM BETWEEN THE KOREAN INTELLECTUAL PROPERTY OFFICE (KIPO) AND THE USPTO	
Application No.:	First Named Inventor:
Filing Date:	Attorney Docket No.:
Title of the Invention:	
THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT <a href="http://www.uspto.gov/efw/efs_help.html">HTTP://WWW.USPTO.GOV/EFW/EFW_HELP.HTML</a> .	
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.	
The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.	
The corresponding PCT application number(s) is/are: _____	
The international filing date of the corresponding PCT application(s) is/are: _____	
<b>I. List of Required Documents:</b>	
a. A copy of the latest international work product (WO/ISA, WO/PEA, or IPER) in the above-identified corresponding PCT application(s)	
<input type="checkbox"/> is attached.	
<input type="checkbox"/> is <u>not</u> attached because the document is already in the U.S. application.	
b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s)	
<input type="checkbox"/> is attached.	
<input type="checkbox"/> is <u>not</u> attached because the document is already in the U.S. application.	
c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.	
d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/PEA, IPER) of the corresponding PCT application.	
<input type="checkbox"/> is attached.	
<input type="checkbox"/> has already been filed in the above-identified U.S. application on _____	
(2) Copies of all documents (except for U.S. patents or U.S. patent application publications)	
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# 2011 Statistics

Office	<u>USPTO</u>	<u>JPO</u>
Pendency Non-PPH	33.5 Months	33.4 Months
Pendency PPH	11.6 Months	7.4 Months
Pendency PCT-PPH	5.5 Months	3.5 Months
Grant Rate Non-PPH	47%	58.1%
Grant Rate PPH	89%	68.3%
Grant Rate PCT-PPH	96%	93.6%