

LEGAL INSIGHT

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Practice Group:

**IP Procurement and
Portfolio
Management**

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Solutions**

Shortcuts on the Patent Prosecution Highway

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The Patent Prosecution Highway (PPH) is a program that allows applicants to leverage allowable claims in one participating office to obtain a patent faster and more efficiently for corresponding claims in another participating office¹. For example, under PPH, an applicant with at least one claim that has been deemed allowable in a first participating office may request that a second participating office fast track the examination process for an application with corresponding claims². The PPH program may be used for claims that are deemed allowable in either a national application or a Patent Cooperation Treaty (PCT) application³.

New PPH Pilot Programs

In January 2014, the United States Patent and Trademark Office (USPTO) launched two pilot programs that are intended to simplify the PPH program: (1) IP5 PPH; and (2) Global PPH⁴. Before these pilots, there were bilateral PPH agreements between different intellectual property offices. However, because the bilateral agreements were not uniform, different PPH programs had different forms and different submission requirements, thus requiring attorneys to spend time reviewing the various procedures for each program to ensure compliance⁵. The IP5 PPH program will run for a period of three years, ending on January 5, 2017. However, the Global PPH program will only run for a period of one year, ending on January 5, 2015⁶.

The IP5 and Global PPH pilots attempt to harmonize the PPH program by replacing the bilateral PPH agreements with a single set of procedures⁷. According to the USPTO, the two pilot programs are “substantially identical” and differ only in the respective participating offices⁸. Furthermore, because the USPTO has elected to participate in both pilot programs and the requirements for the two programs are equivalent, a single PPH request form may be filed in the USPTO based on allowed claims in any of the following participating offices, without specifying which pilot program is being utilized⁹:

1. State Intellectual Property Office of the People's Republic of China (IP5 PPH)
2. European Patent Office (IP5 PPH)
3. Japan Patent Office (IP5 PPH)
4. Korean Intellectual Property Office (IP5 PPH)
5. IP Australia (Global PPH)
6. Canadian Intellectual Property Office (Global PPH)
7. Danish Patent and Trademark Office (Global PPH)
8. National Board of Patents and Registration of Finland (Global PPH)
9. Hungarian Intellectual Property Office (Global PPH)

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10. Icelandic Patent Office (Global PPH)
11. Israeli Patent Office (Global PPH)
12. Nordic Patent Institute (Global PPH)
13. Norwegian Industrial Property Office (Global PPH)
14. Portuguese Institute of Industrial Property (Global PPH)
15. Russian Federal Service for Intellectual Property (Global PPH)
16. Spanish Patent and Trademark Office (Global PPH)
17. Swedish Patent and Registration Office (Global PPH)
18. United Kingdom Intellectual Property Office (Global PPH)

However, for countries that are not participants in the IP5 or Global PPH pilots, the existing bilateral PPH agreements with the USPTO will remain in place¹⁰. Therefore, applicants who wish to request PPH in the USPTO based on allowed claims in any of the following intellectual property offices may do so using the forms and requirements under the existing PPH agreements: Austria, Colombia, Czech Republic, Germany, Mexico, Nicaragua, Philippines, Singapore, and Taiwan¹¹.

Benefits of Requesting Examination under the PPH Pilot Programs

The USPTO no longer requires a fee for an application to be accepted into the PPH program, so applicants can expedite examination at no cost. Prosecution under the PPH program in the USPTO has also been proven on average to take significantly less time than for non-PPH applications¹². In addition, statistics from the PPH portal site indicate that the rate of applications allowed in a first action and the overall rate of patents granted is higher under the PPH program¹³. Therefore, participation in the PPH program can result in faster allowance for a given application and lower attorney fees for prosecuting the application.

Requirements for Participation in the PPH Program

In order to qualify for participation in the PPH program in any participating office under either of the pilots, the following requirements must be met¹⁴:

1. The applications at the Office of Earlier Examination (OEE) and the Office of Later Examination (OLE) (i.e., the USPTO) must have the same earliest date, which can be either the filing date or the priority date¹⁵.
2. The OEE must have found at least one claim allowable, or if based on a PCT work product, the PCT work product must have indicated that at least one claim has novelty, inventive step, and industrial applicability.
3. All claims presented under the PPH program must **sufficiently correspond** to one or more of the allowable claims.
4. The OLE has not started substantive examination of the application

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"Sufficiently Correspond"

One of the key issues for most applicants is trying to determine what "sufficiently correspond" means and, thus, what claims can be presented under the PPH program. Aside from formatting differences between participating offices, claims must be of the same or similar scope¹⁶. Claims that are narrower in scope may be presented in the OLE if they are supported in the specification¹⁷. Although most participating offices do not require narrower claims to be in dependent form, the USPTO requires that narrower claims be presented in dependent form only¹⁸. As a result, the independent claims in the USPTO must be essentially identical to the allowed claims in the OEE¹⁹. However, the narrower limitation may be added into the independent claim during prosecution if the USPTO determines that the dependent claim would be allowable if not dependent on a rejected base claim²⁰.

Applicants cannot present a new "category" of claims in the OLE that was not present in the OEE. For example, if the claims in the OEE were directed to a process of manufacturing a product, the applicant cannot add new claims in the OLE directed to a product that corresponds to the process claims²¹.

Applying and Prosecuting Applications under the PPH Program at the USPTO

The USPTO provides a single form to request participation in either of the new pilot programs: <http://www.uspto.gov/forms/sb0020gbl.pdf>. As discussed previously, this form may be used to request entry into the new PPH program at the USPTO based on allowable claims in any of the offices participating in either pilot program.

As noted in the form, the following documents are required in addition to the request itself:

1. A copy of the most recent office action prior to the decision to grant the patent or the most recent PCT work product. This is not required if the OEE issued the patent on the first office action. The applicant may select the option of having the USPTO access the latest office action via the Dossier Access System or World Intellectual Property Organization's PATENTSCOPE System, but if the actions are not available on either system, the applicant will be notified by the USPTO and must then submit a copy of the office action or work product²².
2. An English language translation if the most recent office action or PCT work product is not written in English. However, a verification statement for the translation is no longer required²³.
3. An Information Disclosure Statement listing the documents cited in the OEE work product
4. Copies of any documents cited by the OEE that are not US patent or US patent publications

In addition to the required documentation, applicants must fill out a Claims Correspondence Table in the request form. The correspondence table requires applicants to: (1) list which claims in the current application correspond to allowable claims in the OLE; and (2) provide an explanation of the correspondence for each claim.

Finally, the attorney submitting the request must sign a statement at the end of the form stating that "All the claims in the U.S. application sufficiently correspond to the patentable/allowable claims in the OEE application."

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If an applicant files the afore-mentioned request and accompanying documentation and is denied participation in the PPH program, applicant will have one chance to correct any mistakes. If the applicant fails to correct the mistakes, the application will be examined in normal turn.

Questions about the PPH Pilot Programs

The USPTO has a phone number (571-272-4100) and email address for questions regarding the PPH pilots²⁴. However, in our experience, the USPTO has been more responsive to email requests. Thus, we recommend emailing PPHfeedback@USPTO.GOV with any questions about the PPH pilots and compliance therewith.

Conclusion

Due to the very recent launch of the PPH pilot programs, it is unclear whether or to what degree the new pilots will streamline the PPH program. For example, the USPTO has still not set forth a precise definition for “sufficiently correspond.” However, the universal request form and minimal required accompanying documentation seem to be a step in the right direction. Therefore, the new PPH program in the USPTO appears to be a desirable option for applicants who have allowable claims in participating offices.

Please note that, while the focus of this client alert is on the PPH program at the USPTO, expedited examination under the PPH program is available in other participating offices and is subject to the requirements for that particular office²⁵. For example, an applicant who has received allowable claims in the USPTO may want to seek accelerated examination under the PPH program in the Japan Patent Office (JPO) or the European Patent Office (EPO).

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¹ USPTO Patent Prosecution Highway webpage, available at http://www.uspto.gov/patents/init_events/pph/, ¶¶ 1-2.

² *Id.* at ¶ 2.

³ *Id.* at ¶ 7.

⁴ *Id.* at ¶ 5.

⁵ Compare e.g., <http://www.uspto.gov/forms/sb0020pct-jp.pdf> (the old USPTO form to enter the PCT-PPH program between the JPO and USPTO required an accuracy statement for the English translation) with <http://www.uspto.gov/forms/sb0020jp.pdf> (the old USPTO form to enter the PPH program between the JPO and USPTO did not require the accuracy statement for the English translation).

⁶ “Implementation of the Global and IPS Patent Prosecution Highway (PPH) Pilot Programs with Participating Offices,” available at <http://www.uspto.gov/patents/law/notices/global-ip5.pdf>, Section II.

⁷ USPTO Patent Prosecution Highway webpage, available at http://www.uspto.gov/patents/init_events/pph/, ¶¶ 5-6.

⁸ *Id.* at ¶ 6.

⁹ *Id.*

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¹⁰ USPTO Patent Prosecution Highway webpage, available at http://www.uspto.gov/patents/init_events/pph/, ¶ 8 (“Other Patent Prosecution Highway Programs”).

¹¹ *Id.*

¹² Patent Prosecution Highway Portal Site, available at <http://www.jpo.go.jp/ppph-portal/statistics.htm>:

Statistics from Jul 2013 - Dec 2013 in the USPTO	PPH Applications only	All Applications (PPH and non-PPH)
Granted Patents	87.9%	53%
First Action Allowance	27.1%	17.3%
Average Pendency to 1st Office Action	4.4 months	18 months
Average Pendency to Final Decision	14 months	29 months

¹³ Implementation of the Global and IP5 Patent Prosecution Highway (PPH) Pilot Programs with Participating Offices, available at <http://www.uspto.gov/patents/law/notices/global-ip5.pdf>, p. 2, § III(A).

¹⁴ *Id.* at § III(A)(3).

¹⁵ The previous requirement that the OEE also be the office of first filing was eliminated under the MOTTAIAI program. See “Implementation of the Global and IP5 Patent Prosecution Highway (PPH) Pilot Programs with Participating Offices,” available at <http://www.uspto.gov/patents/law/notices/global-ip5.pdf>, Background, ¶ 2).

¹⁶ Implementation of the Global and IP5 Patent Prosecution Highway (PPH) Pilot Programs with Participating Offices, available at <http://www.uspto.gov/patents/law/notices/global-ip5.pdf>, p. 2, § III(A)(3).

¹⁷ *Id.*

¹⁸ The EPO, JPO, and Canadian Intellectual Property Office (CIPO) do not state that the narrower claims must be in dependent form. See “Patent Prosecution Highway pilot programme between the IP5 Offices based on PCT and national work products,” available at <http://www.epo.org/law-practice/legal-texts/official-journal/information-epo/archive/20131218.html>, II.B.(3); “Examination Activities and Appeal Examination Activities: Patent Prosecution Highway,” available at http://www.jpo.go.jp/cgi/link.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.htm, (See .pdfs under the “How to make a request” link); “Framework Provisions for the Global Patent Prosecution Highway System,” available at <http://www.cipo.ic.gc.ca/eic/site/cipointernet/internetopic.nsf/eng/wr03742.html#annexd>, Annex D; Email dated February 19, 2014 from PPHfeedback@USPTO.GOV stating that “Narrower claims must be in dependent form.”

¹⁹ “The Patent Prosecution Highway at the USPTO,” Presentation by Charles Eloshway, Senior Patent Counsel for the Office , available at <http://www.jpo.go.jp/ppph-portal/events/PPH%20at%20the%20USPTO.%20Mr.%20Charles%20Eloshway.pdf>, p. 10.

²⁰ USPTO PPH FAQs, available at http://www.uspto.gov/patents/init_events/pph/pph_faqs.pdf, p. 12, § 8(c), Q1 and A1 (revised).

²¹ “The Patent Prosecution Highway at the USPTO,” Presentation by Charles Eloshway, Senior Patent Counsel for the Office, available at <http://www.jpo.go.jp/ppph-portal/events/PPH%20at%20the%20USPTO.%20Mr.%20Charles%20Eloshway.pdf>, p. 10.

²² Email dated January 28, 2014 from PPHfeedback@USPTO.GOV stating that “You may request that the USPTO utilize the Dossier system to access the document, however, not all documents are available in the Dossier system. If the document is not available the USPTO will ask that you provide it.”

²³ Compare, e.g. <http://www.uspto.gov/forms/sb0020pct-jp.pdf> (the old USPTO form to enter the PCT-PPH program between the JPO and USPTO required an accuracy statement for the English translation) with <http://www.uspto.gov/forms/sb0020glbl.pdf> (the new USPTO form to enter the Global/IP5 PPH program does not require the accuracy statement for the English translation).

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²⁴ USPTO Patent Prosecution Highway webpage, available at http://www.uspto.gov/patents/init_events/pph, ¶¶ 9-10.

²⁵ See e.g., <http://www.epo.org/law-practice/legal-texts/official-journal/information-epo/archive/20131218.html> (Requirements for filing PPH request at the EPO); http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr02160.html (Requirements for filing PPH request at the CIPO); https://www.jpo.go.jp/torikumi_e/t_torikumi_e/patent_highway_e.htm (Requirements for filing PPH request at the JPO).