



SCULLY SCOTT MURPHY & PRESSER PC
INTELLECTUAL PROPERTY LAW

PATENT PROSECUTION HIGHWAY

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Overview of Requirements for PPH 2.0

(1) Patentable/Allowable Claim(s) in PPH 2.0 Participating Office

- At least one claim determined by one of the PPH 2.0 participating offices to be allowable/patentable

(2) Same Priority/Filing Date

- U.S. application for which participation in the PPH 2.0 program is requested and the corresponding application filed in the PPH 2.0 participating office (with the allowable/patentable claim(s)) must have the same priority/filing date.

(3) Sufficient Correspondence and Claims Correspondence Table

- All claims on file for examination under the PPH 2.0 program in the U.S. application must “sufficiently correspond” to one or more of those claims indicated as allowable in the application filed in the PPH 2.0 participating office.

(4) Examination has Not Begun

- Examination of the U.S. application for which participation in the PPH 2.0 program is requested has not begun.



Overview of Requirements for PPH 2.0

(5) Request (Form)

- Request for participation in the PPH 2.0 program and a request that the U.S. application be advanced out of turn for examination

(6) Documentation of Prior Office Action

- Documentation of office action issued just prior to “Decision to Grant a Patent” from application filed in the PPH 2.0 participating office

(7) Information Disclosure Statement

- IDS listing documents cited in office action of the PPH 2.0 participating office

(8) Filing via EFS-WEB

- PPH 2.0 request from and all supporting documents must be filed via EFS-WEB.



(1) Patentable/Allowable Claim(s) in PPH 2.0 Participating Office

- At least one claim determined by one of the PPH 2.0 participating offices to be allowable/patentable
- The applicant will no longer need to submit a copy of the allowed claims from the application filed in the PPH 2.0 participating office or any English translation thereof.



(2) Same Priority/Filing Date

- The U.S. application (including national stage entry of a PCT application and 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) for which participation in the PPH 2.0 program is requested and the corresponding application filed in the PPH 2.0 participating office (with the allowable/patentable claim(s)) must have the same priority/filing date.
- Provisional applications, plant applications, design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order are excluded and not subject to participation in the PPH 2.0 program.



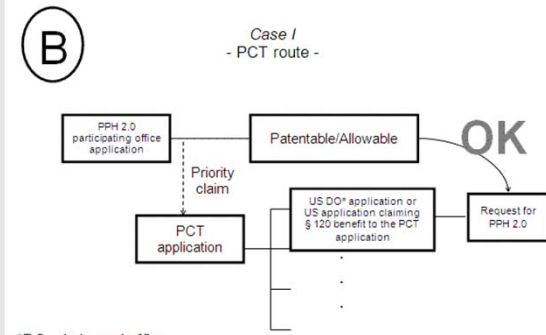
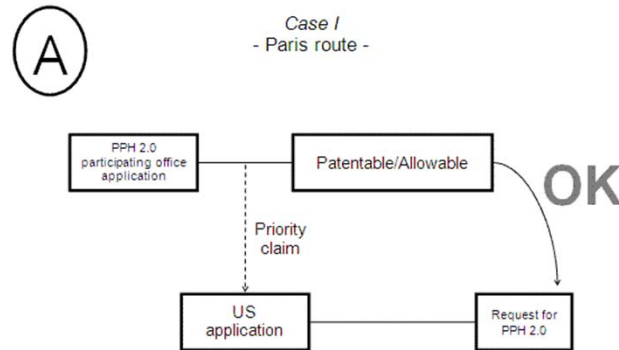
(2) Same Priority/Filing Date

- In particular, the U.S. application:
 - Case I is an application that validly claims priority under 35 U.S.C. § 119(a) and 37 CFR 1.55 to one or more applications filed with the PPH 2.0 participating office, or
 - Case II is an application which is the basis of a valid priority claim under the Paris Convention for the application filed in the PPH 2.0 participating office, or
 - Case III is an application which shares a common priority document with the application filed in the PPH 2.0 participating office, or
 - Case IV and the application filed in the PPH 2.0 participating office are derived from/related to a PCT application having no priority claim.

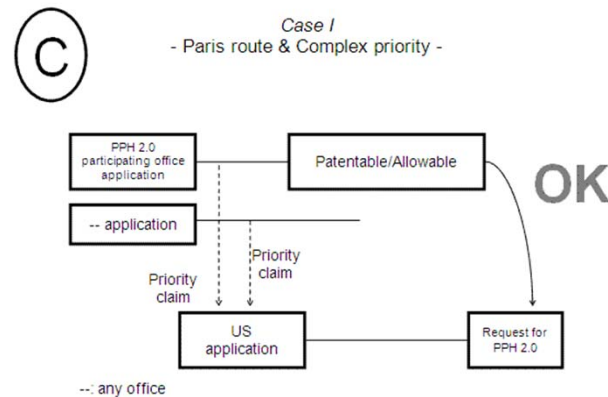


(2) Same Priority/Filing Date

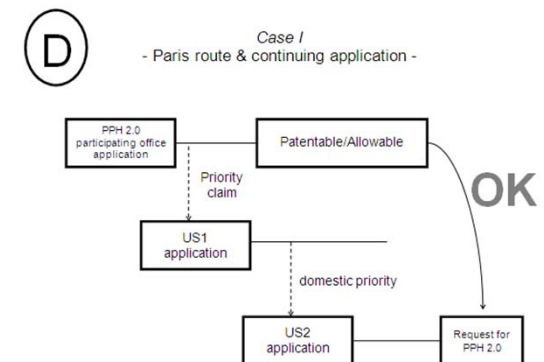
- In particular, the U.S. application:
 - Case I is an application that validly claims priority under 35 U.S.C. § 119(a) and 37 CFR 1.55 to one or more applications filed with the PPH 2.0 participating office



*DO – designated office



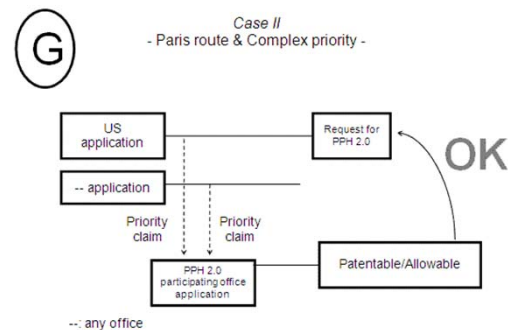
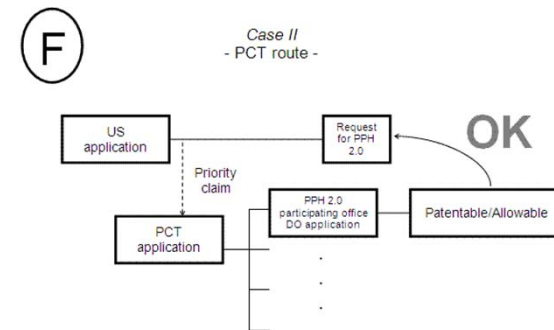
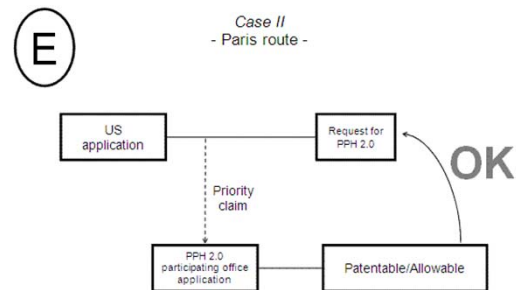
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(2) Same Priority/Filing Date

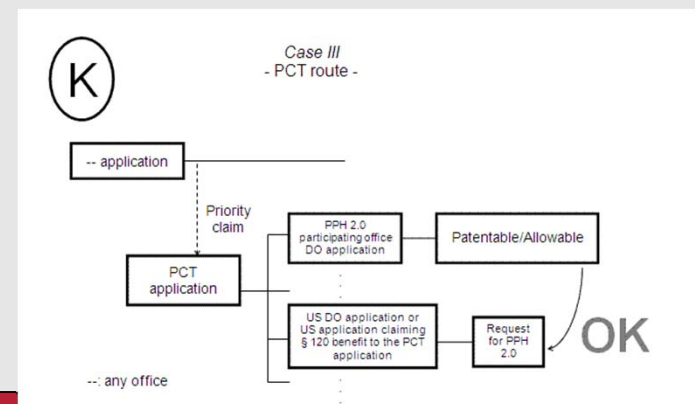
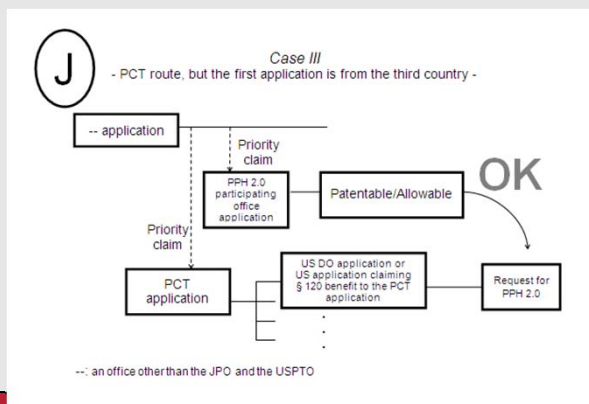
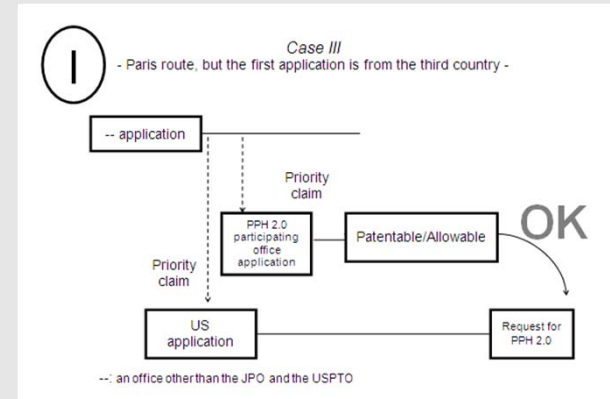
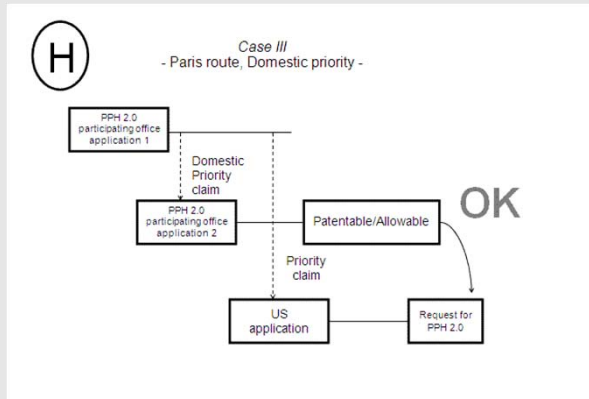
- In particular, the U.S. application:
Case II is an application which is the basis of a valid priority claim under the Paris Convention for the application filed in the PPH 2.0 participating office





(2) Same Priority/Filing Date

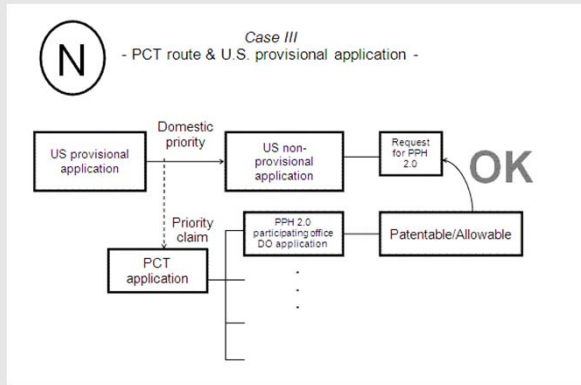
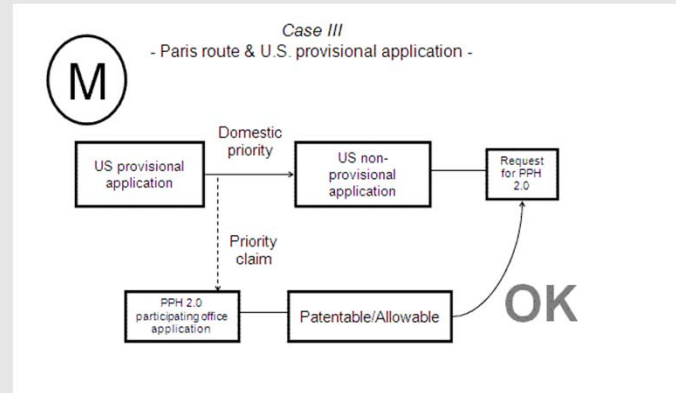
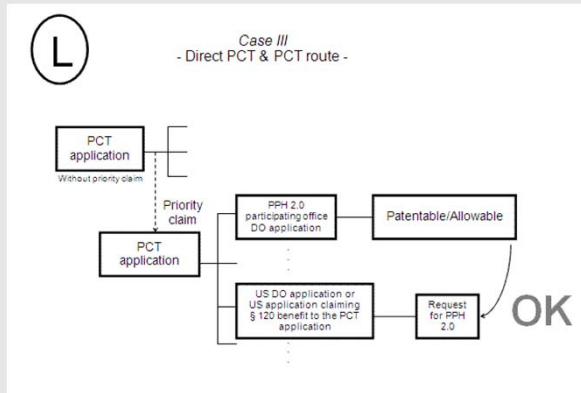
- In particular, the U.S. application:
 - Case III is an application which shares a common priority document with the application filed in the PPH 2.0 participating office





(2) Same Priority/Filing Date

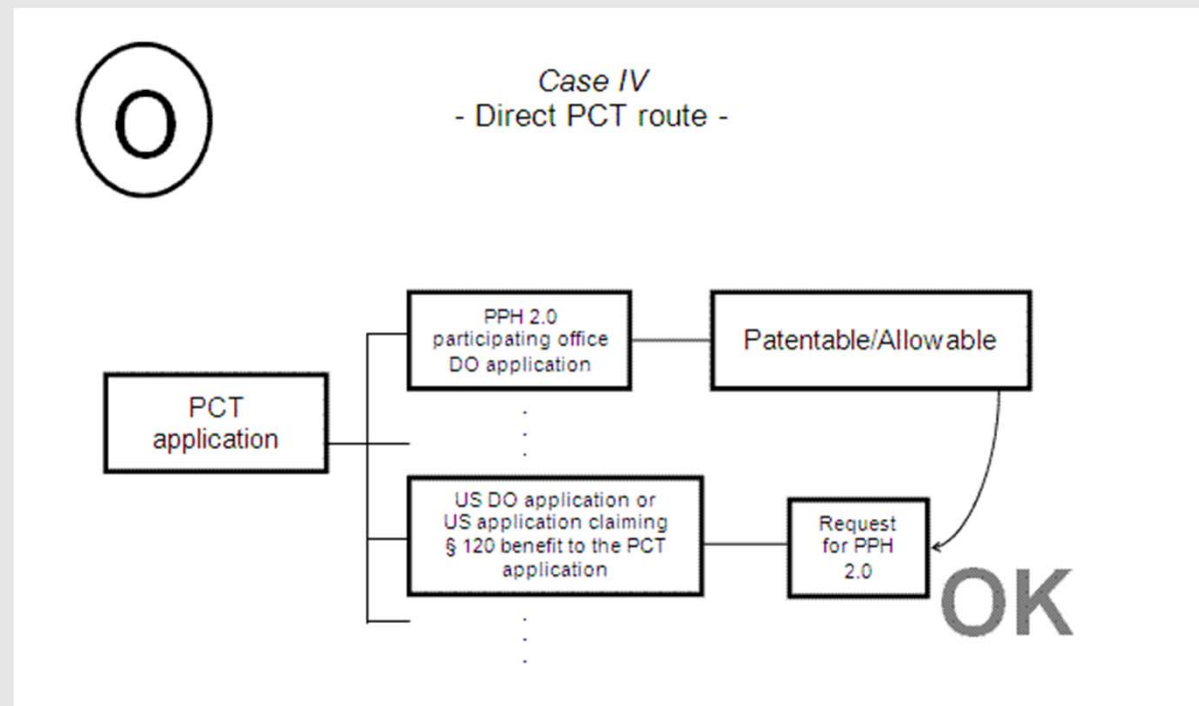
- In particular, the U.S. application:
Case III is an application which shares a common priority document with the application filed in the PPH 2.0 participating office





(2) Same Priority/Filing Date

- In particular, the U.S. application:
Case IV and the application filed in the PPH 2.0 participating office are derived from/related to a PCT application having no priority claim





(3) Sufficient Correspondence and Claims Correspondence Table

- All claims on file, as originally filed or as amended, for examination under the PPH 2.0 program in the U.S. application must sufficiently correspond to one or more of those claims indicated as allowable in the application filed in the PPH 2.0 participating office.
- A claim is considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claim in the U.S. application is of the same or similar scope as a claim indicated as allowable in the application filed in the PPH 2.0 participating office.



(3) Sufficient Correspondence and Claims Correspondence Table

- A claim in the U.S. application which is narrower in scope than the claims indicated as allowable in the application filed in the PPH 2.0 participating office will also sufficiently correspond if presented as a claim dependent upon a claim which is of the same or similar scope as a claim indicated as allowable in the application filed in the PPH 2.0 participating office.
- The additional limitation that makes the claim in the U.S. application narrower in scope than the allowable/patentable claims in the application filed in the PPH 2.0 participating office must have support in the written description of the U.S. application.



(3) Sufficient Correspondence and Claims Correspondence Table

- A claim in the U.S. application which introduces a new/different category of claims to those claims indicated as allowable in the application filed in the PPH 2.0 participating office is not considered to sufficiently correspond.

For example, if the only allowable/patentable claims in the application filed in the PPH 2.0 participating office are claims 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 application filed in the PPH 2.0 participating office.



(3) Sufficient Correspondence and Claims Correspondence Table

- The applicant is required to submit a claims correspondence table in English.

The claims correspondence table must indicate how all the claims in the U.S. application correspond to the allowable/patentable claims in the application(s) filed in the PPH 2.0 participating office.

Any dependent claims with additional limitations must be clearly identified in the claims correspondence table.



(4) Examination has Not Begun

- Examination of the U.S. application for which participation in the PPH 2.0 program is requested has not begun.
- The requirement that examination of the U.S. application must not have begun refers to substantive examination. Example: Notice to File Missing Parts is not considered substantive examination.
- If substantive examination in parent U.S. application has begun, a continuation/divisional application can be filed, and such continuation/divisional application may be eligible to participate in the PPH program.



(5) Request (Form)

- The applicant must file a request for participation in the PPH 2.0 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).
- PPH request forms are available from the USPTO Web site. Applicants are encouraged to use the USPTO request form.
- 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).



(6) Documentation of Prior Office Action

- The applicant must submit 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”) from each of the application(s) filed in the PPH 2.0 participating office containing the allowable/patentable claims that form the basis for the request, along with an English translation thereof.
- The English translation may be a machine translation.
- The applicant will no longer need to provide a statement that the English translation is accurate if the office actions are not in the English language.



(6) Documentation of Prior Office Action

- It will not be necessary for the applicant to submit a copy of the “Decision to Grant a Patent” and an English translation thereof.

If the application filed in the PPH 2.0 participating office is a first action allowance, i.e., there is no office action just prior to the “Decision to Grant a Patent,” then the applicant should indicate on the request form that no office action from the application filed in the PPH 2.0 participating office is submitted since the application was a first action allowance.

- The English translation may be a machine translation.



(6) Documentation of Prior Office Action

- If the copy of the office action from the application filed in the PPH 2.0 participating office is available via the dossier access system, instead of submitting a copy of the office action, the applicant may request that the USPTO obtain such a copy of the office action via the dossier access system.



(6) Documentation of Prior Office Action

- The applicant must submit copies of any office actions (which are relevant to patentability) from the application(s) filed in the PPH 2.0 participating office issued after the grant of the request for participation in the PPH 2.0 program in the USPTO (especially where the PPH 2.0 participating office might have reversed a prior holding of allowability).



(7) Information Disclosure Statement

- The applicant must submit an information disclosure statement (IDS) listing the documents cited in the office action of the PPH 2.0 participating office (unless such an IDS has already been filed in the U.S. application).
- The applicant must submit copies of all the documents cited in the office action of the PPH 2.0 participating office (unless the copies have already been filed in the U.S. application) except U.S. patents or U.S. patent application publications.



(8) Filing via EFS-WEB

- The request for participation in the PPH 2.0 program and all the supporting documents must be submitted to the USPTO via EFS-Web and indexed with the following document description: “Petition to make special under Patent Pros Hwy.”
- Any preliminary amendment or IDS submitted with the PPH 2.0 documents must be separately indexed as a preliminary amendment or an IDS, respectively.



USPTO Review of Request for Participation in PPH 2.0 Program

- Where the request for participation in the PPH 2.0 program and special status are 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 PPH 2.0 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 (which must be submitted via EFS-Web and indexed accordingly as noted above).
- Note that action on the application by the USPTO will NOT be suspended (37 CFR 1.103) awaiting a reply by the applicant to perfect the request in a renewed request for participation.



Patentability Determination After Grant of Request to Participate in PPH Program

- PPH is not full faith and credit. Grant of request to participate in PPH program does not mean that corresponding U.S. claims will automatically be allowed.



Patent Prosecution Highway Based on Patent Cooperation Treaty Work Products

PPH-PCT program enables applicant who has received:

- a Written Opinion from an International Searching Authority (WO/ISA), or
- a Written Opinion from an International Preliminary Examining Authority (WO/IPEA), or
- an International Preliminary Examination Report (IPER) from an International Preliminary Examining Authority,

that indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability, to file a request to participate in the PCT-PPH pilot program in a corresponding U.S. application and petition to make the U.S. application special under the PCT-PPH pilot program.



Eligibility for PPH-PCT Program

In order to be eligible to participate in the PCT-PPH program, the relationship between the corresponding U.S. application for which participation is requested and the PCT application must be one of the following:

- the U.S. application is a national stage entry of the corresponding PCT application;
- the U.S. application is a national application which forms the basis for the priority claim in the corresponding PCT application;
- the U.S. application is a national stage entry of another PCT application (which can be filed in any competent receiving office) which claims priority to the corresponding PCT application;
- the U.S. application is a national application claiming foreign/domestic priority to the corresponding PCT application; and
- the U.S. application is a continuing application (continuation, divisional, or continuation-in-part) of the U.S. application which satisfies one of the above scenarios.



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