

Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Japan Patent Office

I. Background

The United States Patent and Trademark Office (USPTO) has established a 21st Century Strategic Plan to transform the USPTO into a more quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system. One of the specific action plans of the 21st Century Strategic Plan is to share search results with other intellectual property offices. By relying on the search results obtained via partnerships with other intellectual property offices, we can reduce duplication of efforts and decrease workload.

Since the beginning of 2003, the USPTO, the European Patent Office (EPO) and the Japan Patent Office (JPO) (the Trilateral Offices) have participated in search exchange projects aimed at promoting the mutual exploitation of search results to a maximum extent practicable. The prior projects involved the establishment of a technical and procedural framework to ascertain the usefulness of the search exchange results. The results of the prior projects show that there is a potential benefit in exploiting the search results of the office of first filing (OFF) to reduce workload in the office of second filing (OSF) and to improve quality where the OFF performed the search in advance of the OSF working on the corresponding application. In order to exploit the search results of the OFF to the maximum extent practicable, timely delivery of the search results from the OFF to the OSF is critical. Because of JPO's request for the examination system, the percentage of applications where the JPO as the OFF could provide its search results to the USPTO is less than 10%.

In order to help address the timing disparity in availability of search results that currently exists among the Trilateral Offices when the JPO is the OFF, the USPTO and the JPO have worked together to establish a framework, called the "Patent Prosecution Highway" (PPH), that will provide applicants that file at the JPO with an incentive to file a request for examination at an earlier time and to obtain search and examination results early from the JPO (where the JPO is the OFF). Under this framework, an applicant whose claims are determined to be allowable/patentable in the OFF can request that its corresponding application filed in the OSF be advanced out of turn for examination (e.g., undergo accelerated examination) provided certain conditions are met. The OSF would be able to exploit the search and examination results of the OFF and applicant may be able to obtain a patent on the corresponding application filed in the OSF faster since the OSF application is advanced out of turn for examination.

II. Patent Prosecution Highway Pilot Program

The PPH was established to enable an applicant whose claims are determined to be allowable/patentable in the OFF to have the corresponding application filed in the OSF advanced out of turn for examination while at the same time allow the OSF to exploit the

search and examination results of the OFF. At the November 2005 Trilateral Conference, the USPTO and the JPO agreed to commence a PPH pilot program to assess the feasibility of the PPH program. The USPTO and JPO jointly announced the PPH pilot program at the May 22-24, 2006 Trilateral Technical Meeting held in Japan.

Note that where the USPTO is the OFF and the U.S. application contains claims that are determined to be allowable/patentable, the U.S. applicant may likewise request accelerated examination in the JPO for the corresponding application filed in the JPO as the OSF. The procedures and requirements for filing a request to the JPO for participation in the PPH pilot program are available from the JPO web site at: www.jpo.go.jp/index.htm

Where the USPTO is the OSF and the corresponding application filed in the JPO as the OFF contains claims that are determined to be allowable/patentable, the applicant may request participation in the PPH pilot program in the USPTO and petition to make the U.S. application special under the PPH pilot program. The procedures and requirements for filing a request in the USPTO for participation in the PPH pilot program are set forth below.

A. Trial Period for the PPH Pilot Program

The PPH pilot program will commence on July 3, 2006, for a period of one year ending on July 3, 2007. The trial period may be extended for up to an additional year if necessary to adequately assess the feasibility of the PPH program. The USPTO and the JPO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period. The PPH pilot program may also be terminated early if the volume of participation exceeds manageable level. Notice will be published if the PPH pilot program will be terminated before the July 3, 2007 date.

B. Requirements for Requesting Participation in the PPH Pilot Program in the USPTO

In order to be eligible to participate in the PPH pilot program, the following conditions must be met:

(1) The U.S. application is a Paris Convention application validly claiming priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO. Continuing applications that validly claim the benefit of the U.S. application under 35 U.S.C. 120 and the priority date of JPO application(s) under 35 U.S.C. 119(a) are also eligible. PCT international applications (including national stage applications filed under 35 U.S.C. 371), provisional applications, plant and design applications, reissue applications and reexamination proceedings are excluded.

(2) The JPO application(s) have at least one claim that was determined by the JPO to be allowable/patentable. Applicant must submit a copy of the allowable/patentable claims

from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate. If a copy of the allowable/patentable claims from the JPO application(s) is available via the Dossier Access System, applicant may request that the USPTO obtain the copy via the Dossier Access System. In this case, applicant is still required to submit the English translation along with the statement that the translation is accurate. If the copies cannot be obtained by the USPTO via the Dossier Access System due to technical problems, applicant will be notified and requested to provide the necessary documents.

(3) All the claims in each U.S. application for which a request for participation in the PPH pilot program is made must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claims in the JPO application(s). Claims will be considered to sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope. Applicant is also 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 JPO application(s).

(4) Examination of the U.S. application for which participation in the PPH pilot program is requested has not begun.

(5) Applicant must file a request for participation in the PPH pilot program and a petition to make the U.S. application special under the PPH pilot program. A sample request/petition form is attached to this notice. Applicants are encouraged to use the USPTO request/petition form. A petition fee under 37 CFR 1.17(h) for the petition to make special under 37 CFR 1.102(d) is required and must be submitted.

The request for participation in the PPH pilot program and all the supporting documents must be faxed to:

The Office of the Commissioner for Patents at 571-273-0125, directed to the attention of Magdalen Greenlief.

(6) Applicant must submit a copy of all the office actions (including a “Decision to Grant a Patent”) from each of the JPO application(s) containing the allowable/patentable claims that are the basis for the request, along with an English translation thereof and a statement that the English translation is accurate. If a copy of each of the office actions from the JPO application(s) is available via the Dossier Access System, applicant may request that the USPTO obtain the copy via the Dossier Access System. In this case, applicant is still required to submit the English translation along with the statement that the translation is accurate. If the copies cannot be obtained by the USPTO via the Dossier Access System due to technical problems, applicant will be notified and requested to provide the necessary documents.

(7) Applicant must submit an information disclosure statement listing the documents cited by the JPO examiner in the JPO office action. Applicant must submit copies of all

the documents cited in the JPO office action except U.S. patents or U.S. patent application publications.

Where the request for participation in the PPH pilot program and special status are granted, 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 pilot program does not meet all the requirements set forth above, applicant will be notified and the defects in the request will be identified. Applicant will be given one opportunity to perfect the request in a renewed request for participation. If perfected, the request and special status will be granted, applicant will be notified and the U.S. application will be advanced out of turn for examination. If not perfected, applicant will be notified and the application will await action in its regular turn.

(8) Request for participation in the PPH pilot program and special status granted in a parent application will not carry over to a continuing application. Continuing applications must separately fulfill the conditions set forth above.

If any of the documents identified in items (2), (6) and (7) above have already been filed in the U.S. application prior to the request for participation in the PPH pilot program, it will not be necessary for applicant to resubmit these documents with the request for participation. Applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot program when these documents were previously filed in the U.S. application.

C. Special Examining Procedures

Once the request for participation in the PPH pilot program and special status have been granted to the U.S. application, the U.S. application will be taken up for examination by the U.S. examiner before all other categories of applications except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination."

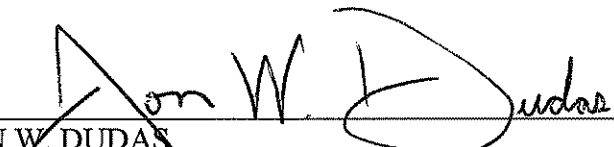
Any claims amended or added after the grant of the request for participation in the PPH pilot program must sufficiently correspond to one or more allowable/patentable claims in the JPO application(s). Applicant is required to submit a claims correspondence table along with the amendment (see B.(3) above). If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the JPO application(s), the amendment will not be entered and will be treated as a non-responsive reply. Applicant must also submit copies of any office actions from each of the JPO application(s) issued after the grant of the request for participation in the PPH pilot program (especially where the JPO might have reversed a prior holding of allowability) along with English translations thereof and a statement that the English translation is accurate.

The PPH program does not absolve applicants of all their duties under 37 CFR 1.56. By complying with requirements 6 and 7 identified above, applicants would be considered to

have complied with their duties to bring to the attention of the USPTO any material prior art cited in the corresponding foreign application(s) (see MPEP § 2001.06(a)). Applicants must still provide to the USPTO other information known to them to be material to patentability.

Any inquiries concerning this notice may be directed to Magdalen Greenlief, Office of the Deputy Commissioner for Patent Examination Policy at 571-272-8800 or at magdalen.greenlief@uspto.gov.

Date: 5/22/06



JON W. DUDAS
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office