

**Revised Requirements for Requesting Participation in the
Patent Prosecution Highway Pilot Program in the USPTO
(Between the USPTO and the UK IPO)**

On September 4, 2007, the United States Patent and Trademark Office (USPTO) commenced a Patent Prosecution Highway pilot program (PPH) with the United Kingdom Intellectual Property Office (UK IPO), which was scheduled to last for a period of one year ending on September 4, 2008, but extendible for an additional year. A notice entitled "Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the United Kingdom Intellectual Property Office" was published on September 25, 2007 at 1322 *Off. Gaz. Pat. Office* 258 providing the details of the PPH pilot program.

The USPTO and UK IPO recently agreed to modify the pilot program to (1) permit certain applications based on PCT filings (where the PCT application does not contain any priority claim) to qualify for participation in the PPH pilot program, and (2) require that the request for participation in the PPH pilot program and all the supporting documents be submitted to the USPTO via EFS-Web. The September 25, 2007 notice required the PCT application to claim priority to a UK application and required that all the PPH documents be faxed to the Office of the Commissioner for Patents.

Effective January 28, 2008, the following U.S. applications may be eligible to participate in the pilot program:

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 UK IPO, or
 - (ii) validly claims priority under 35 U.S.C. 119(a)/365(a) to a PCT application that contains no priority claims,

or

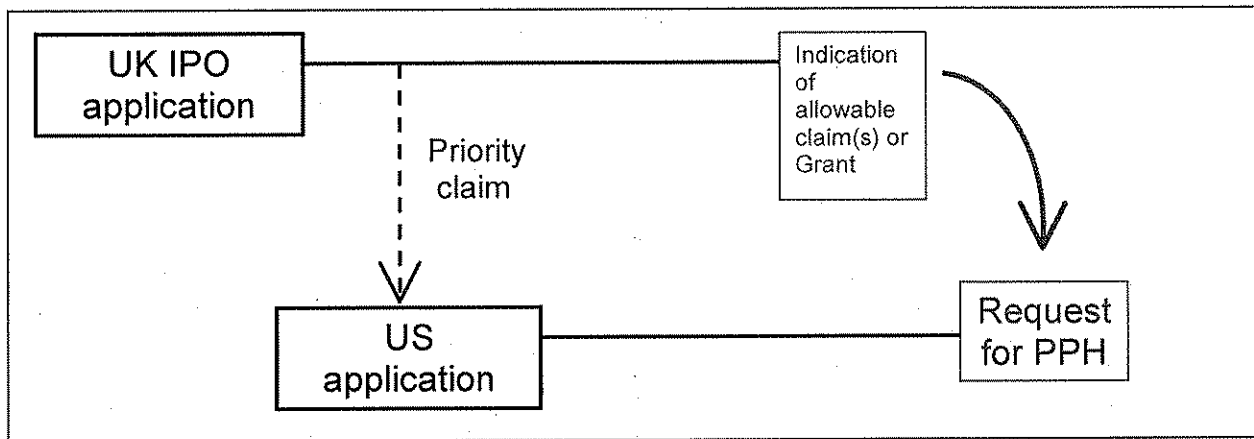
- (b) a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
 - (i) validly claims priority under 35 U.S.C. 365(b) to an application filed in the UK IPO, or
 - (ii) validly claims priority under 35 U.S.C. 365(b) to a PCT application that contains no priority claims, or
 - (iii) contains no priority claim,

or

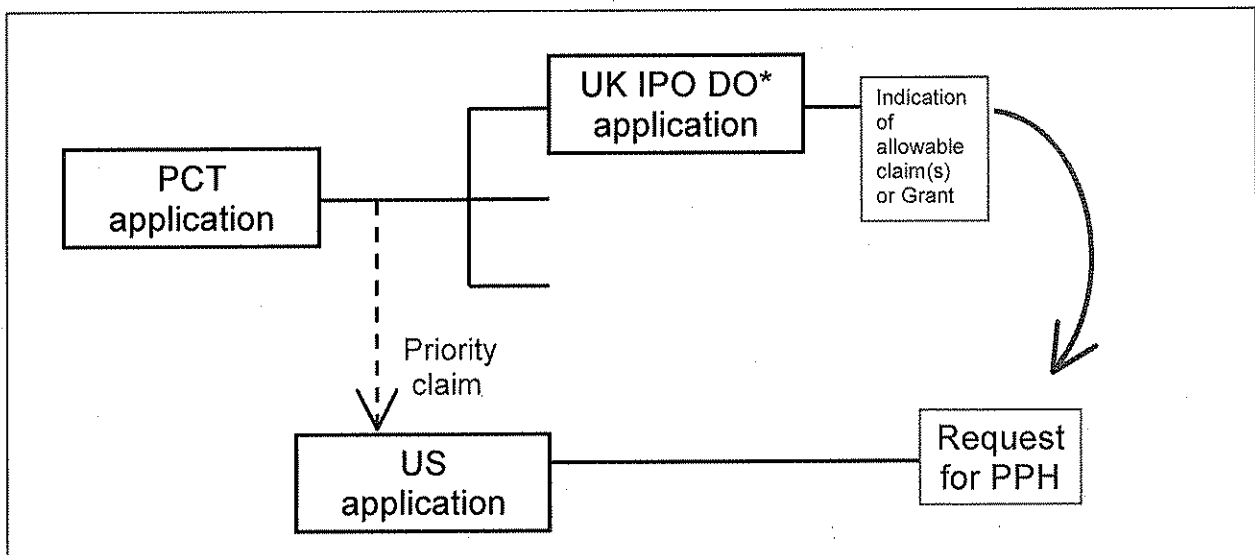
- (c) a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
- (i) validly claims priority under 35 U.S.C. 365(b) to an application filed in the UK IPO or
 - (ii) validly claims priority under 35 U.S.C. 365(b) to a PCT application that contains no priority claims or
 - (iii) contains no priority claim.

Examples of U.S. applications that fall under this requirement are:

(a)(i):

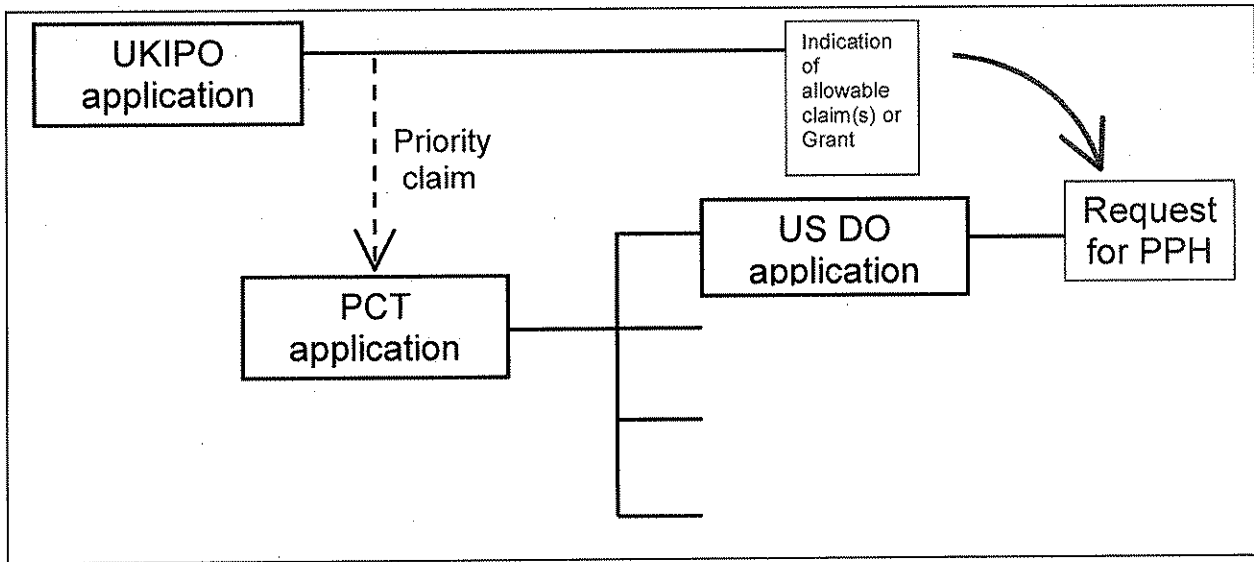


(a)(ii):

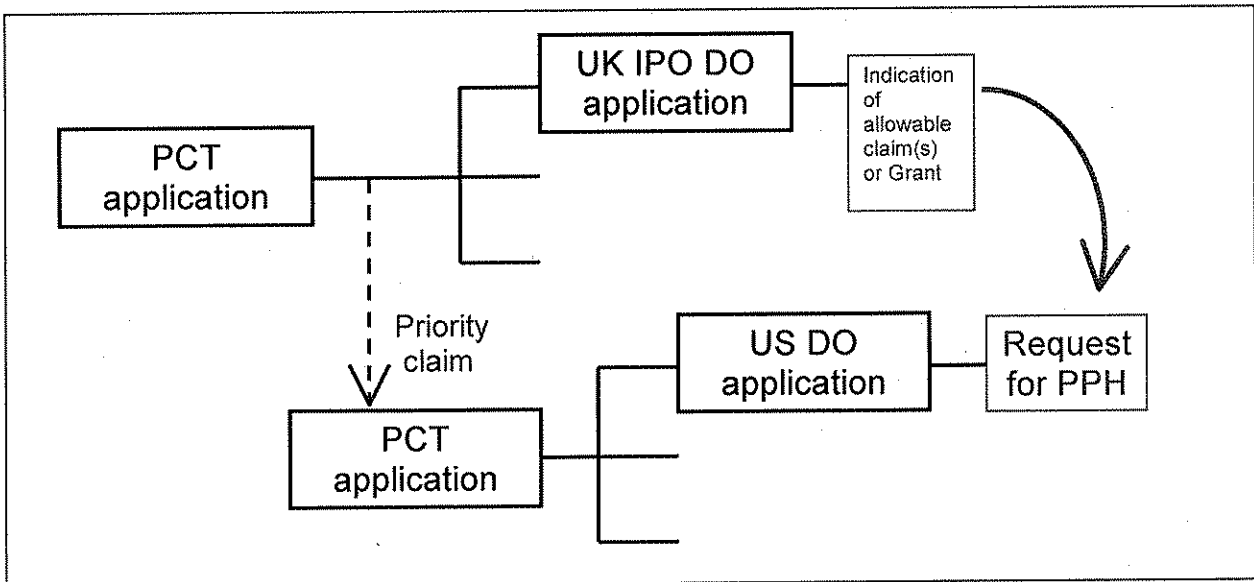


* DO – Designated Office

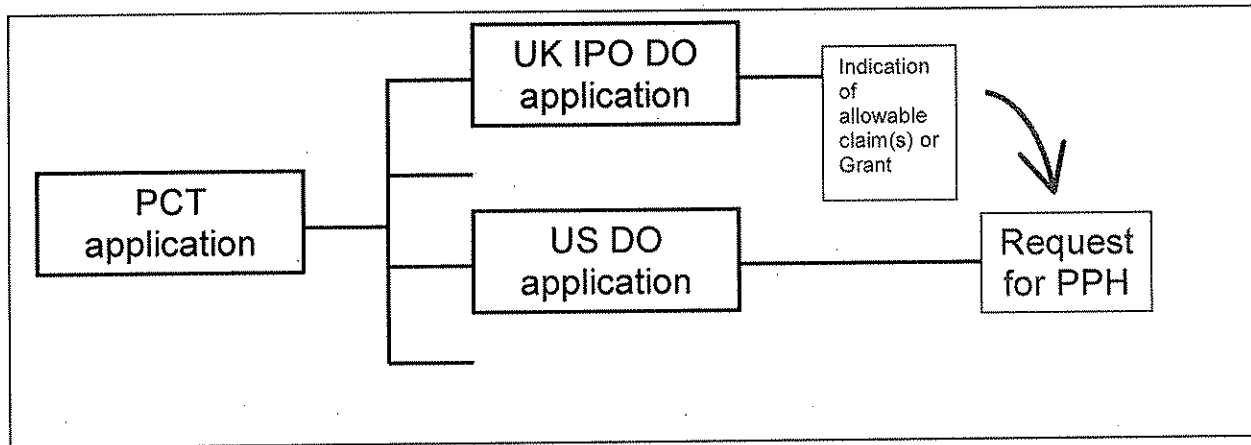
(b)(i):



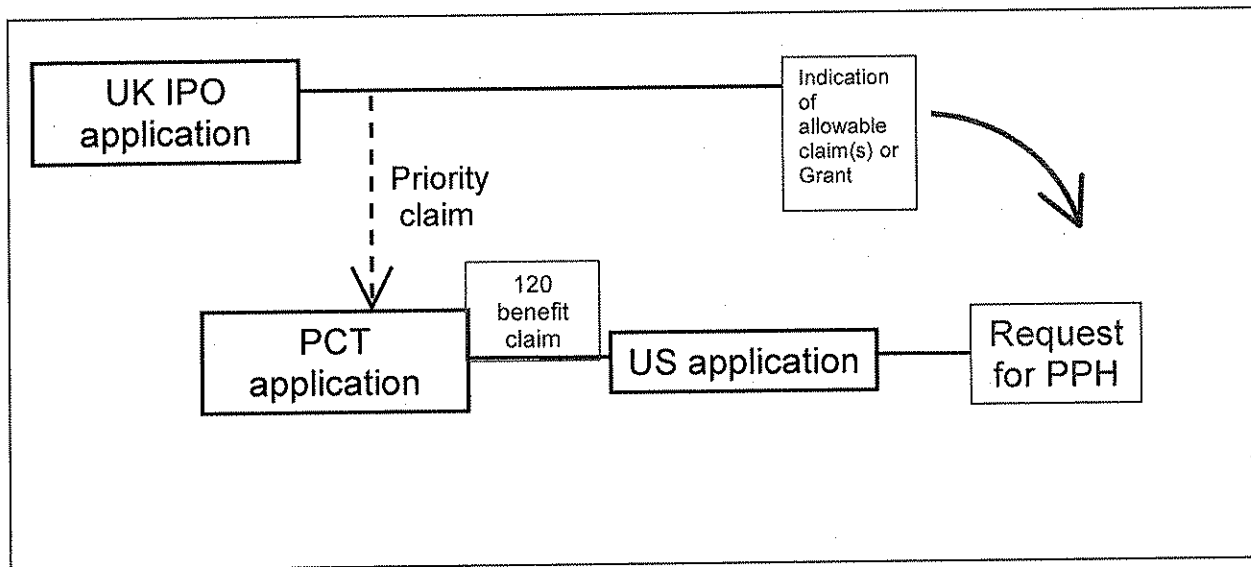
(b)(ii):



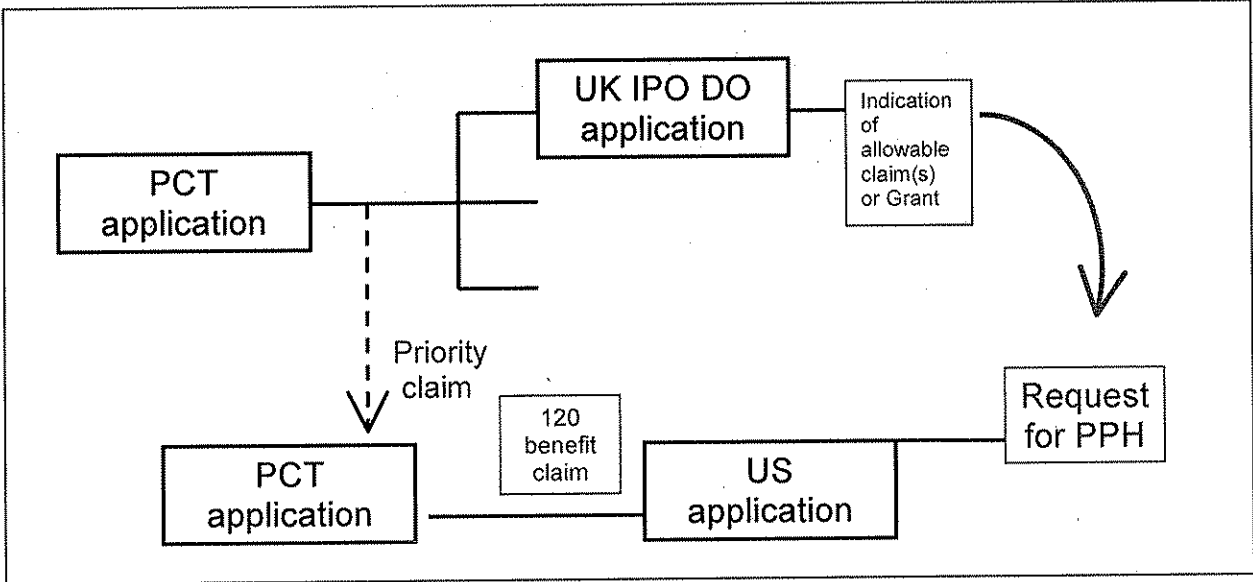
(b)(iii):



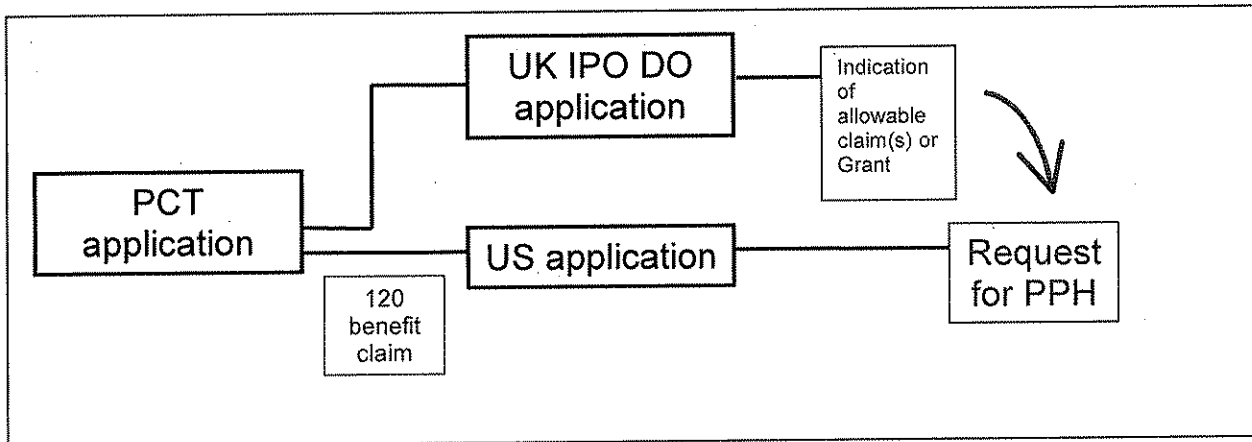
(c)(i):



(c)(ii):



(c)(iii):




Effective January 28, 2008, the request for participation in the PPH pilot program and all the supporting documents must be submitted to the USPTO via EFS-Web and indexed as PPH.PET.652. Information regarding EFS-Web is available at http://www.uspto.gov/ebc/efs_help.html. Any preliminary amendments and IDS submitted with the PPH documents must be separately indexed as a preliminary amendment and IDS respectively. Any renewed request for participation (where the

initial request for participation has been dismissed) must be submitted via EFS-Web and indexed accordingly as noted above.

Please continue to direct inquiries on the PPH pilot program to Magdalen Greenlief at 571-272-8800 or via e-mail addressed to magdalen.greenlief@uspto.gov.

Date: 01/14/2008



John Doll
Commissioner for Patents