

# **Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Canadian Intellectual Property Office**

## **I. Background**

The United States Patent and Trademark Office (USPTO) has established a 21<sup>st</sup> 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 21<sup>st</sup> 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 July 2006, the USPTO has partnered with the Japan Patent Office (JPO) on a Patent Prosecution Highway pilot program (PPH). The PPH pilot program leverages accelerated examination procedures already available in both offices to allow applicants in both offices to obtain corresponding patents faster and more efficiently. The PPH pilot program also permits each office to benefit from the work previously done by the other office, in turn reducing workload and improving patent quality. The USPTO and the JPO agreed to fully implement the PPH program starting January 28, 2008.

USPTO has also commenced a PPH pilot program with the United Kingdom Intellectual Property Office on September 4, 2007, based on the same framework as the PPH pilot program between the USPTO and JPO.

The USPTO had discussions with the Canadian Intellectual Property Office (CIPO) to launch a PPH pilot program similar to the PPH pilot programs between the USPTO and JPO and between the USPTO and UK IPO. USPTO and CIPO agreed that consistency between PPH pilot programs should be maintained to the extent possible, to avoid creating burdens on applicants and offices, and to ensure maximum work-sharing potential.

## **II. Patent Prosecution Highway Pilot Program**

The PPH was established to enable an applicant whose claims are determined to be allowable in the Office of first filing (OFF) to have the corresponding application filed in the Office of second filing (OSF) advanced out of turn for examination while at the same time allowing the OSF to exploit the search and examination results of the OFF.

Where the USPTO is the OFF and the U.S. application contains claims that are determined to be allowable, the applicant may likewise request accelerated examination in the CIPO for the corresponding application filed in the CIPO as the OSF. The procedures and requirements for filing a request to the CIPO for participation in the PPH pilot program are available from the CIPO web site at: <http://www.cipo.ic.gc.ca/pph/>. Where the CIPO is the OSF, the CIPO will access the necessary documents for

requesting participation in the PPH pilot program from the USPTO public PAIR system. In those rare situations where the U.S. application has not been published, and therefore the U.S. file wrapper is not available via public PAIR, applicant would have to provide the necessary copies to the CIPO. In the event that the CIPO requests a copy of the necessary documents from the USPTO, the USPTO would not provide such copies to the CIPO unless authorization from the applicant is of record in the U.S. application.

Where the USPTO is the OSF and the corresponding application filed in the CIPO as the OFF contains claims that are determined to be allowable, 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. Note that the procedures for a petition to make special under the accelerated examination program set forth in MPEP 708.02(a) do NOT apply to a petition to make 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 January 28, 2008, for a period of one year ending on January 28, 2009. 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 CIPO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period. The Offices may also terminate the PPH pilot program early if the volume of participation exceeds manageable level, or for any other reason. Notice will be published if the PPH pilot program will be terminated before the January 28, 2009 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) 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 CIPO, 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

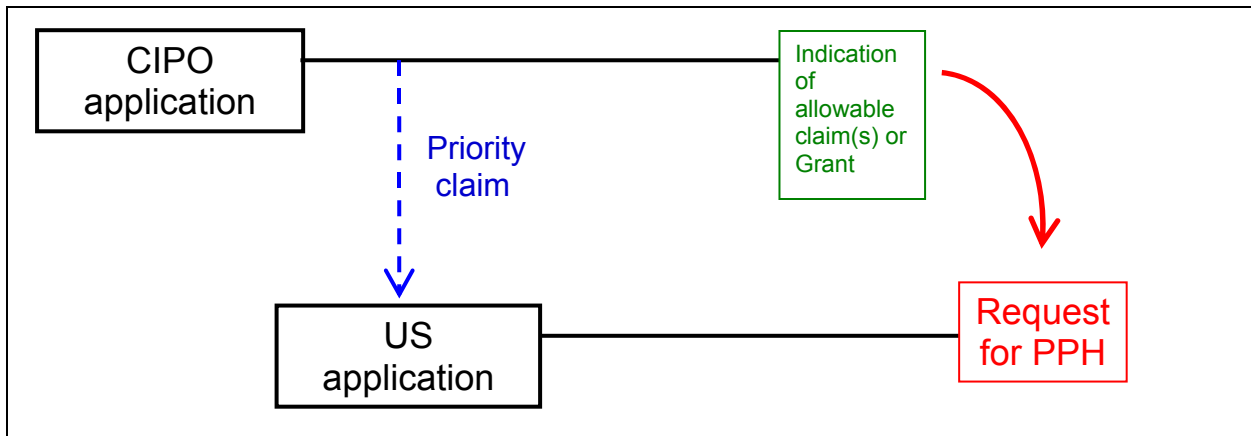
- (i) validly claims priority under 35 U.S.C. 365(b) to an application filed in the CIPO, or
- (ii) validly claims priority under 35 U.S.C. 365(b) to a PCT application that contains no priority claims, or
- (iii) contains no priority claim,

or

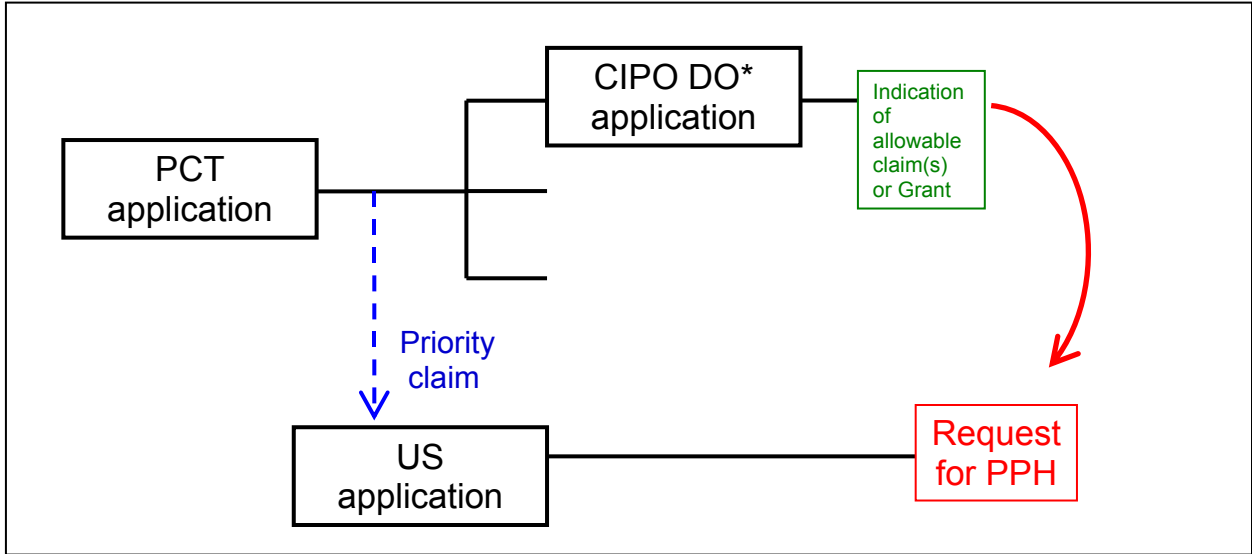
- (c) a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
  - (i) validly claims priority under 35 U.S.C. 365(b) to an application filed in the CIPO, or
  - (ii) validly claims priority under 35 U.S.C. 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 requirement (1) are:

(1)(a)(i):

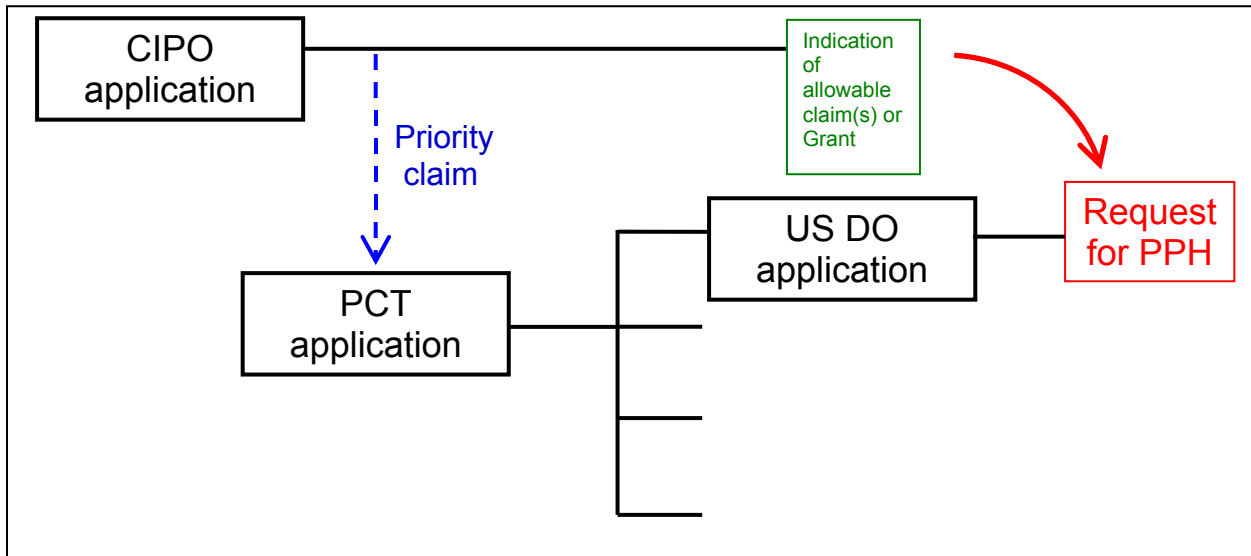


(1)(a)(ii):

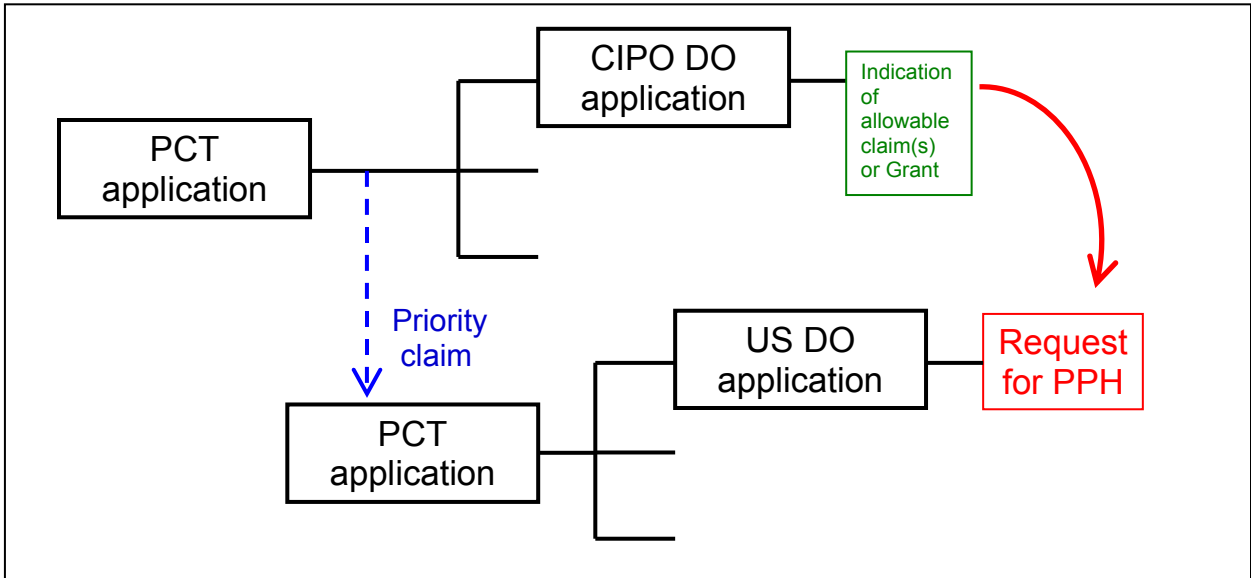


\* DO – Designated Office

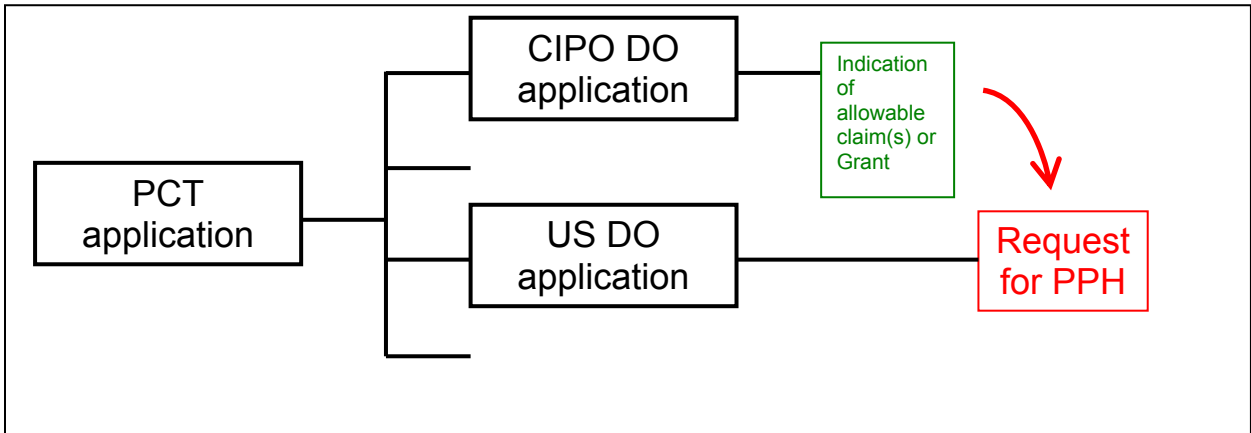
(1)(b)(i):



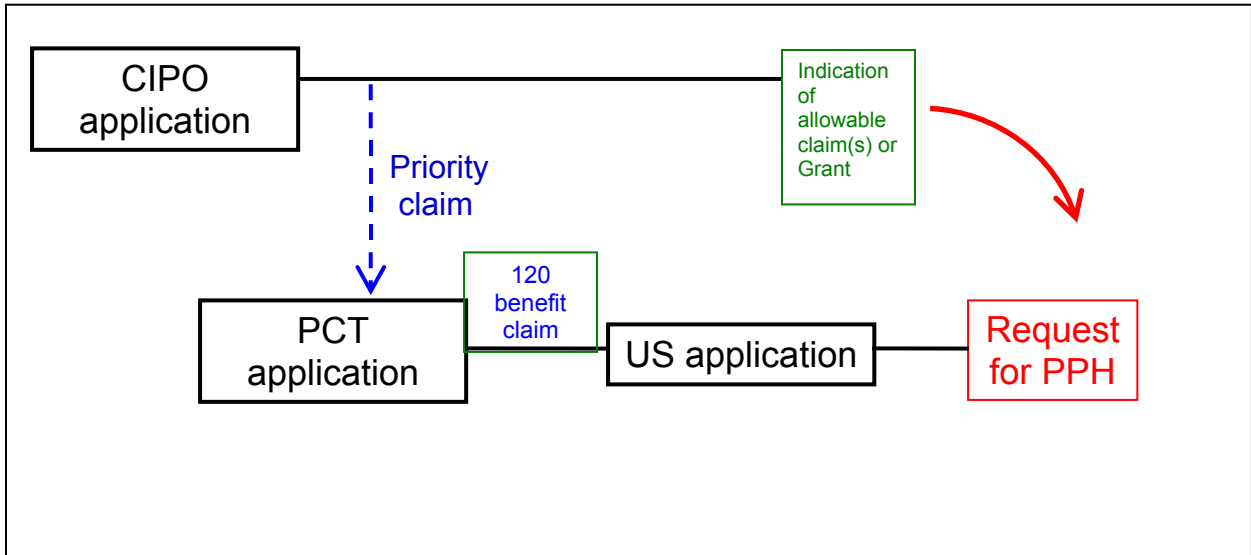
(1)(b)(ii):



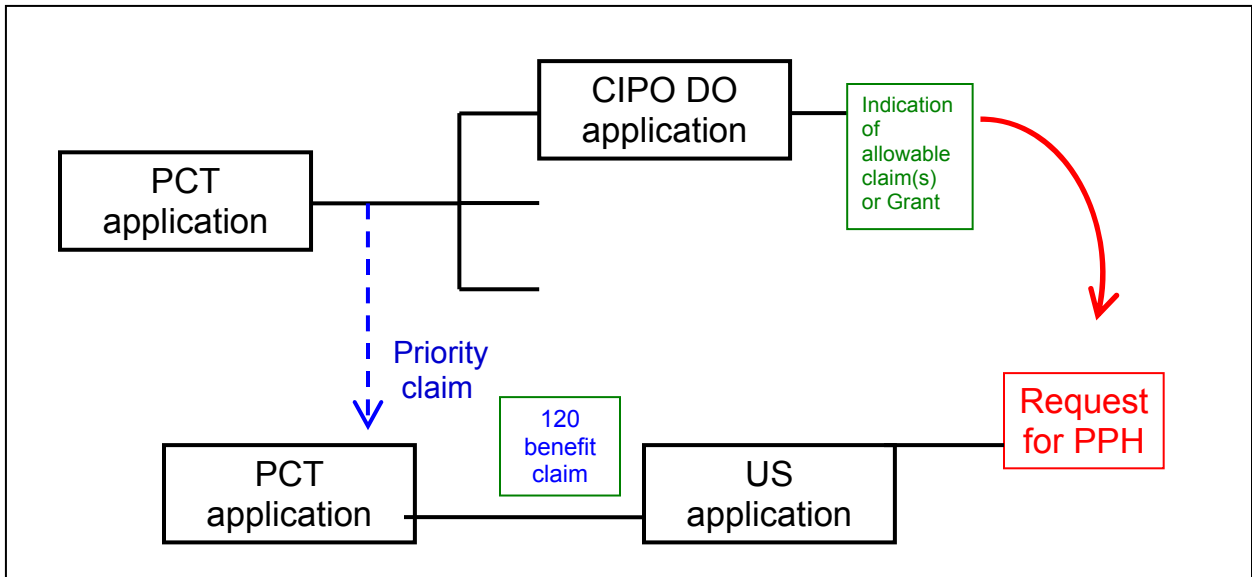
(1)(b)(iii):



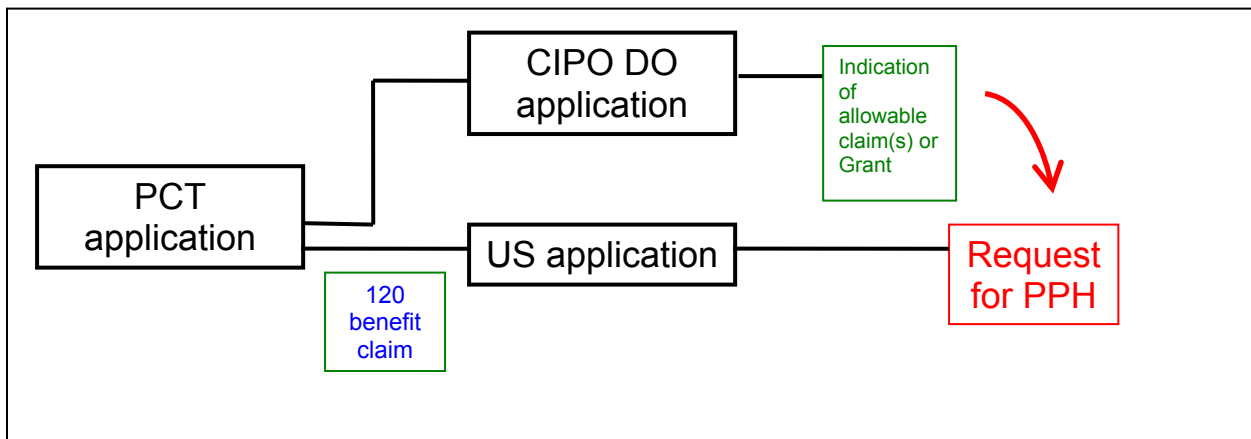
(1)(c)(i):



(1)(c)(ii):



(1)(c)(iii):



Provisional applications, plant and design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order are excluded.

(2) The CIPO application(s) have at least one claim that was determined by the CIPO to be allowable. Applicant must submit a copy of the allowable claims from the CIPO application(s). If the allowable claims from the CIPO application(s) are in a language other than English, then applicant must also submit an English translation of the allowable claims and a statement that the English translation is accurate.

(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 claims in the CIPO 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 claims in the CIPO 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 (PTO/SB/20CA) is available from the USPTO web site at <http://www.uspto.gov>. 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.

(6) Applicant must submit a copy of all the office actions from each of the CIPO application(s) containing the allowable claims that are the basis for the request, along

with an English translation thereof and a statement that the English translation is accurate (if the office actions are not in the English language).

(7) Applicant must submit an information disclosure statement (IDS) listing the documents cited by the CIPO examiner in the CIPO office action (unless such an IDS has already been filed in the U.S. application). Applicant must submit copies of all the documents cited in the CIPO office action (unless the copies have already been filed in the U.S. application) except U.S. patents or U.S. patent application publications.

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](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.

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 (which must be submitted via EFS-Web and indexed accordingly as noted above). Note that action on the application by the examiner will NOT be suspended (37 CFR 1.103) awaiting a reply by the applicant to perfect the request in a renewed request for participation. That is, if the application is picked up for examination by the examiner after applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, 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



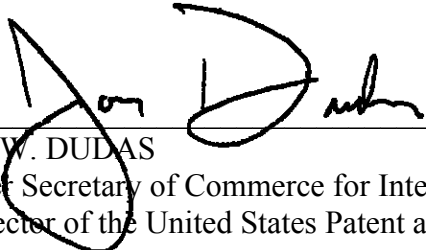
the U.S. examiner before all other categories of applications except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination."

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 claims in the CIPO 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 claims in the CIPO application(s), the amendment will not be entered and will be treated as a non-responsive reply. After the grant of the request for participation in the PPH pilot, if any of the CIPO application(s) contain office correspondence subsequent to the Notice of Allowance related to changes in the claims or the status of the CIPO applications, applicant must also submit copies of the CIPO office correspondence.

The PPH program does not absolve applicants of all their duties under 37 CFR 1.56 and 37 CFR 10.18. 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 still have a duty of candor and good faith, including providing 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: 1/14/08

  
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Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office