

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

On September 29, 2008, the United States Patent and Trademark Office (USPTO) commenced a Patent Prosecution Highway pilot program (PPH) with the European Patent Office (EPO), which was scheduled to last for a period of one year ending on September 29, 2009, but extendible for an additional year. A notice entitled "Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and European Patent Office" was published on October 21, 2008 at 1335 *Off. Gaz. Pat. Office* 196 providing the details of the PPH pilot program.

In view of suggestions recently received from our users, the USPTO has decided to modify the requirements for requesting participation in the PPH pilot program in the USPTO to permit certain applications based on PCT filings to qualify for participation in the PPH pilot program.

Effective December 22, 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 EPO, 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 EPO, 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

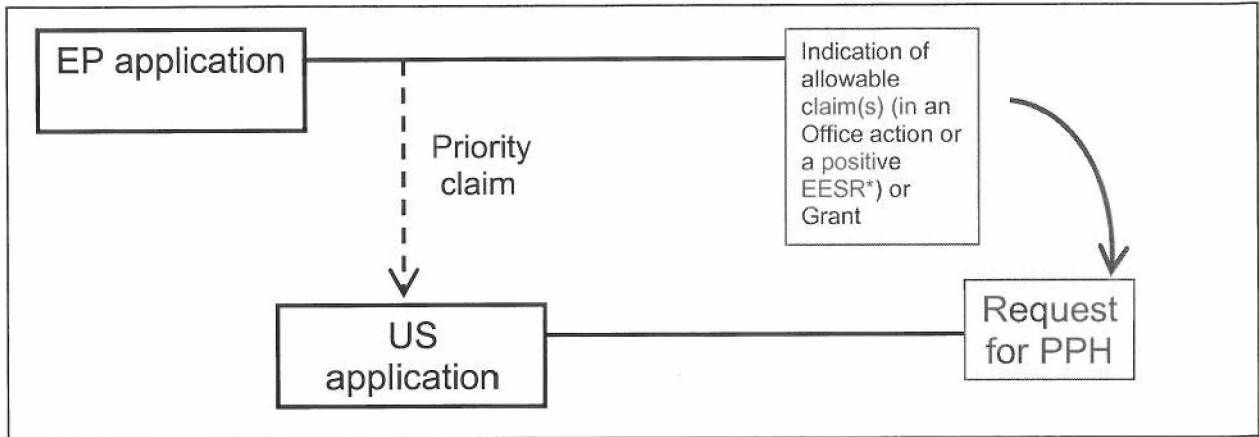
- (c) a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
 - (i) validly claims priority under 35 U.S.C. 365(b) to an application filed in the EPO or

- (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:

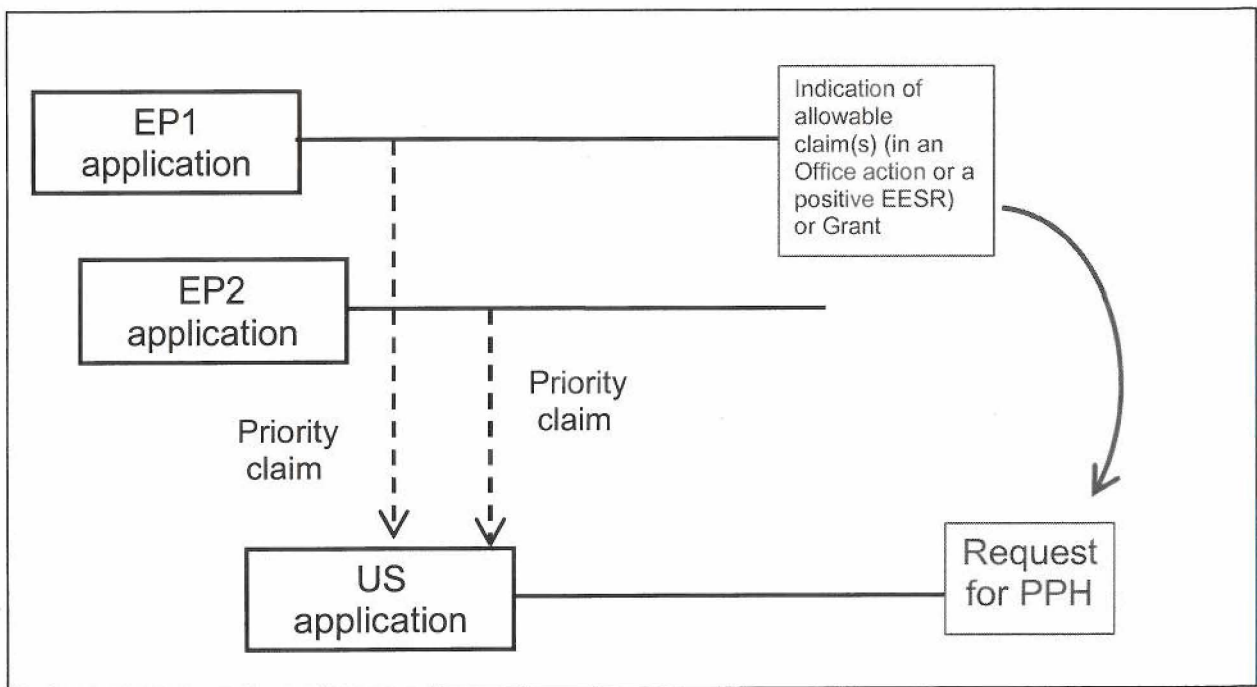
(a)(i):

- US application with single Paris Convention priority claim to an EP application

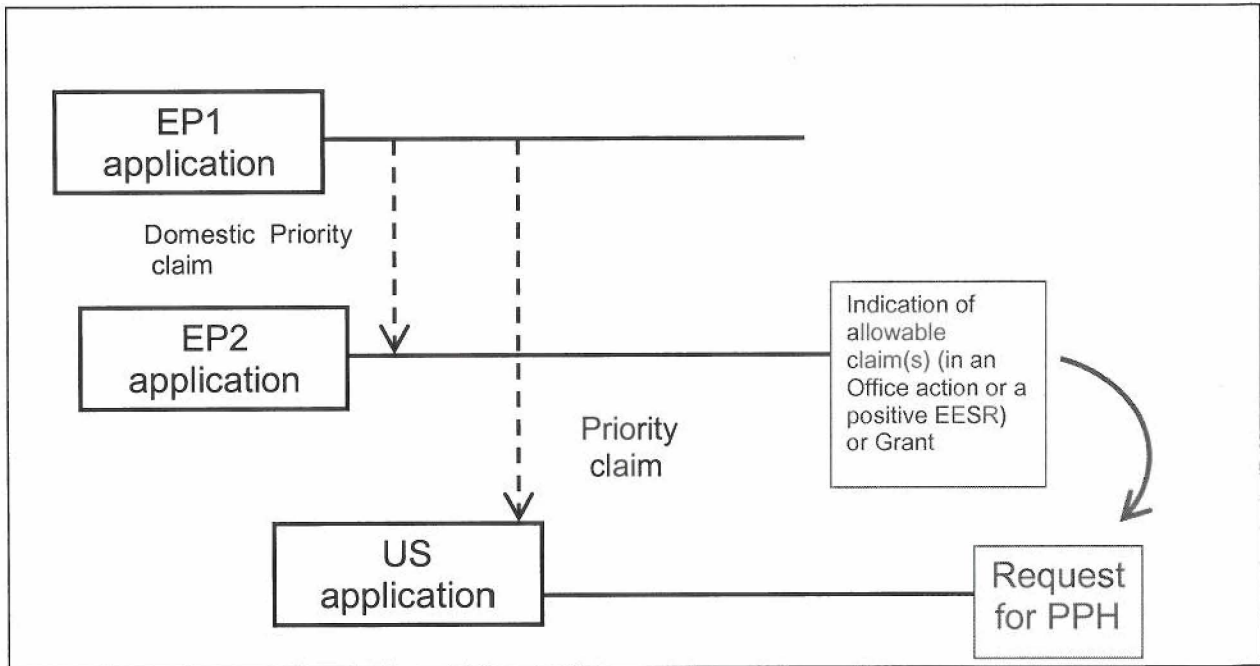


*Extended European Search Report

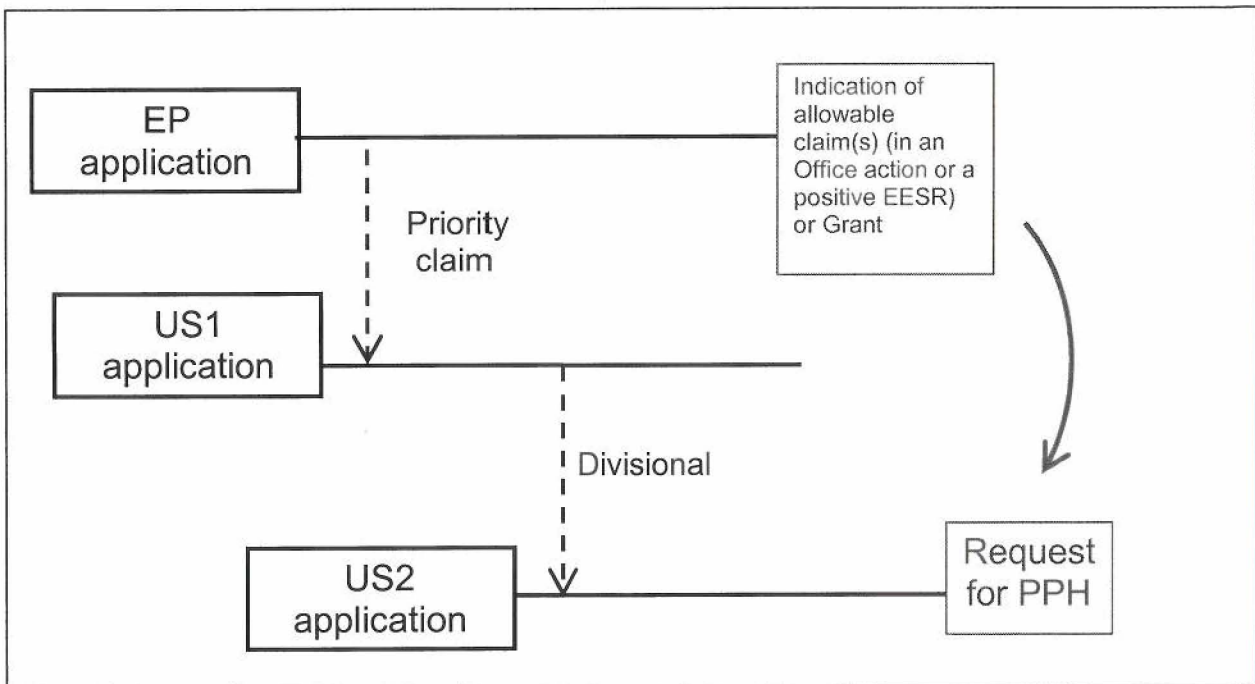
- US application with multiple Paris Convention priority claims to EP applications



- Paris route and domestic priority

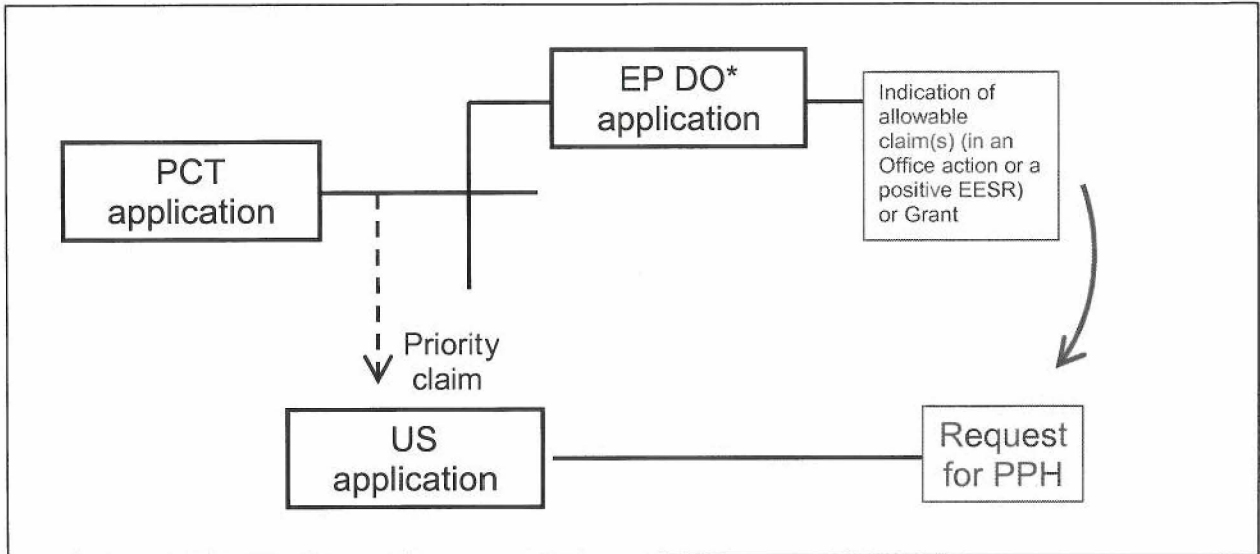


- Paris route and divisional application



(a)(ii):

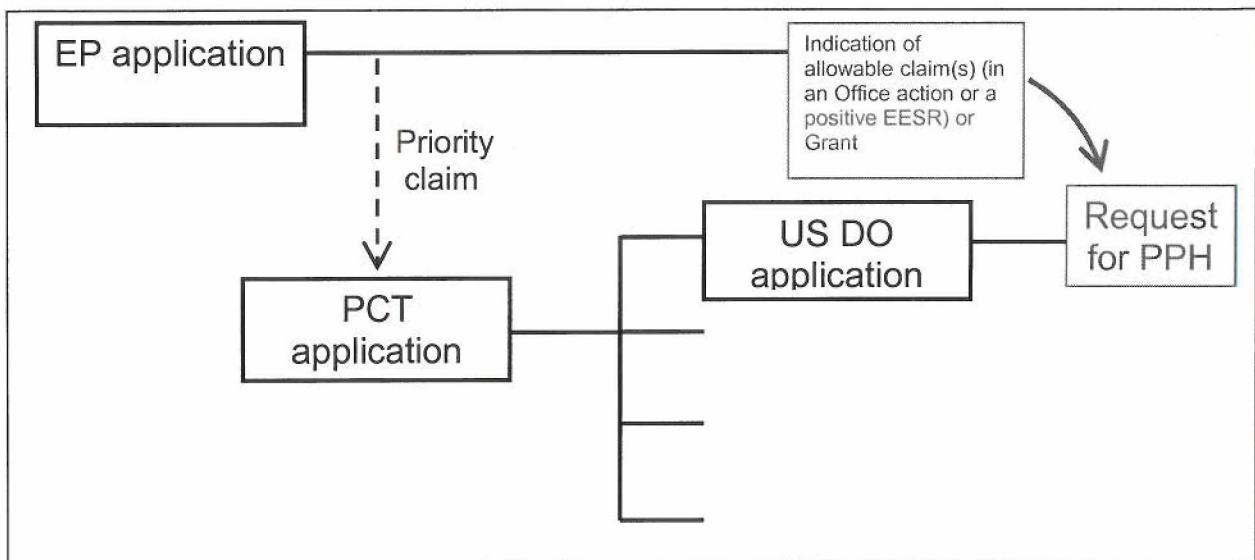
- US application claims Paris Convention priority to a PCT application



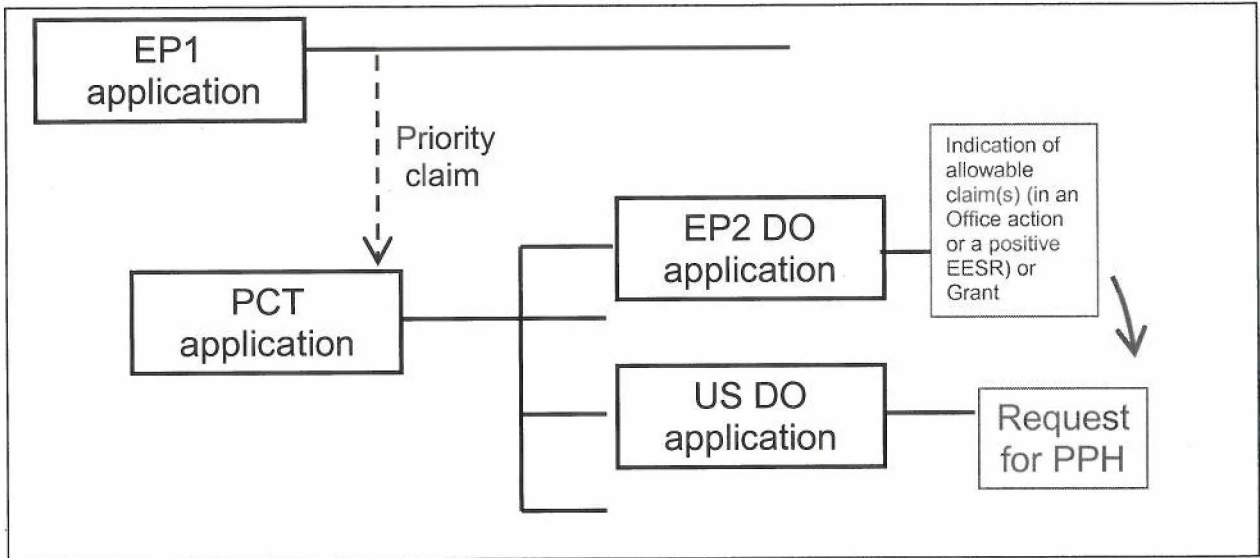
* DO – Designated Office

(b)(i):

- US application is a national stage of a PCT application which claims Paris Convention to an EP application

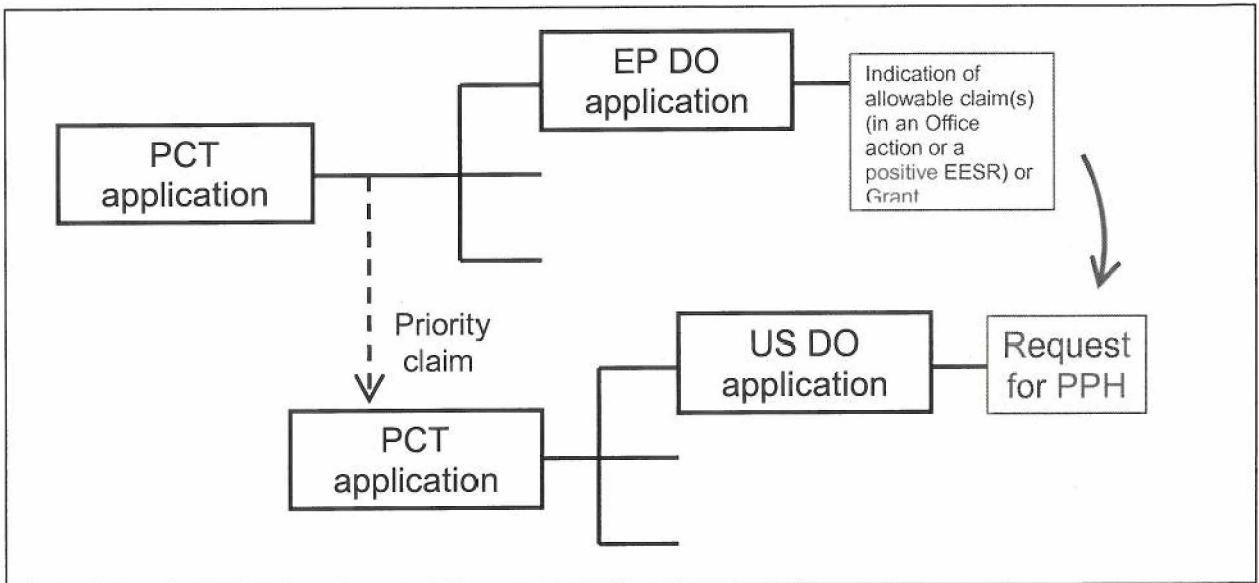


- PCT Route

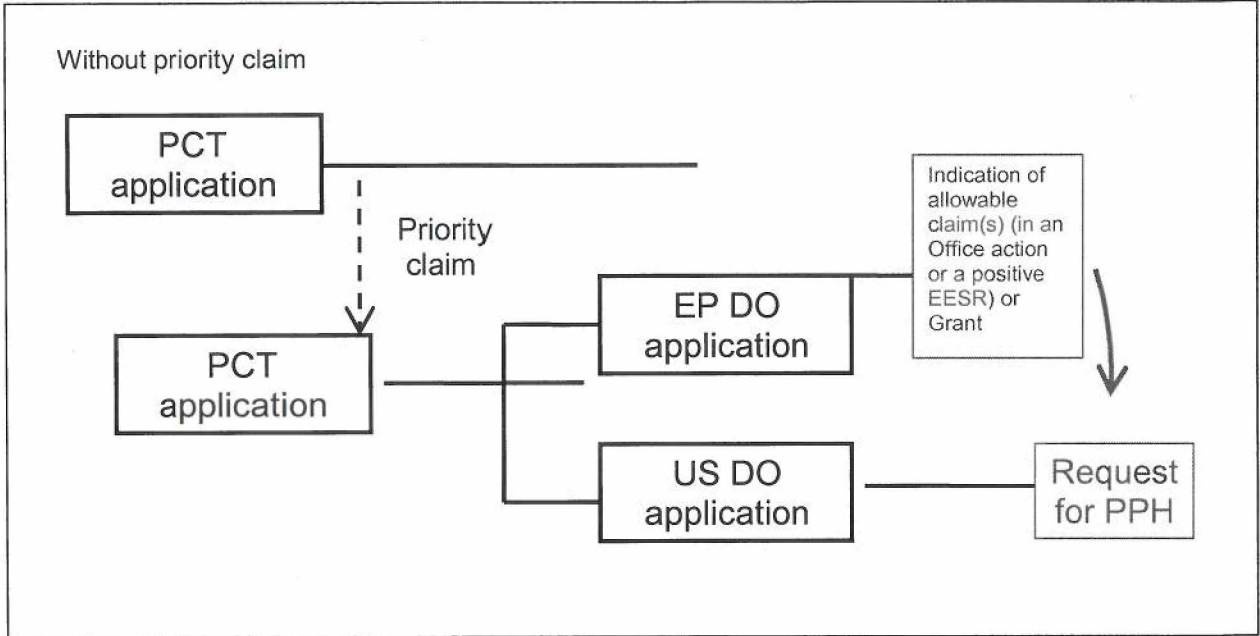


(b)(ii):

- US application is a national stage of a PCT application which claims Paris Convention to another PCT application

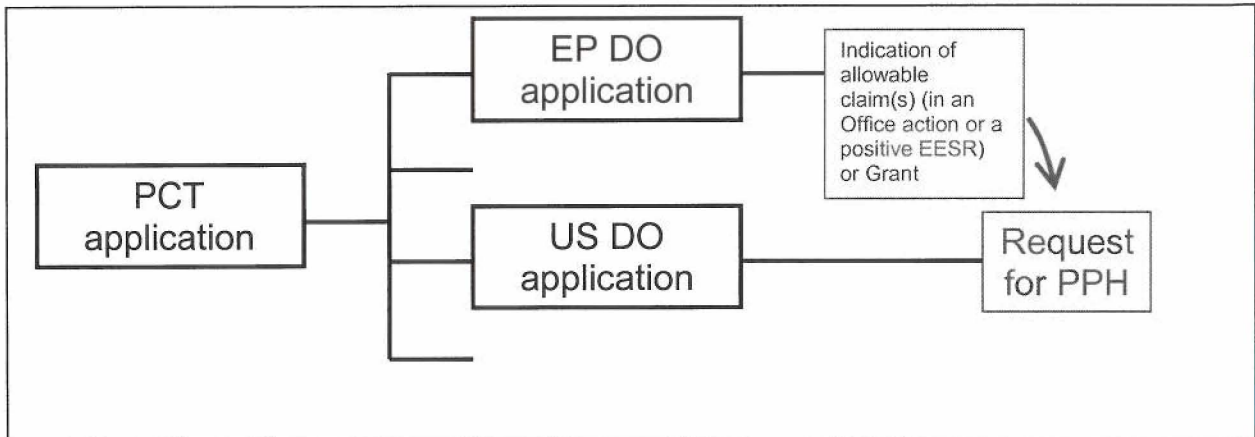


- Direct PCT and PCT Route



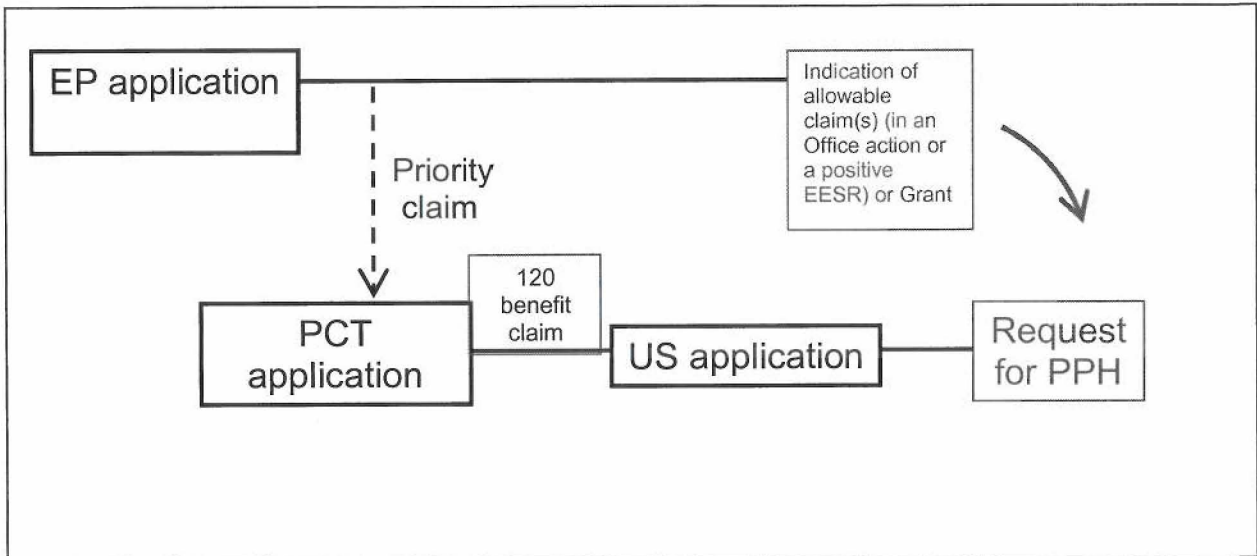
(b)(iii):

- US application is a national stage of a PCT application without priority claim



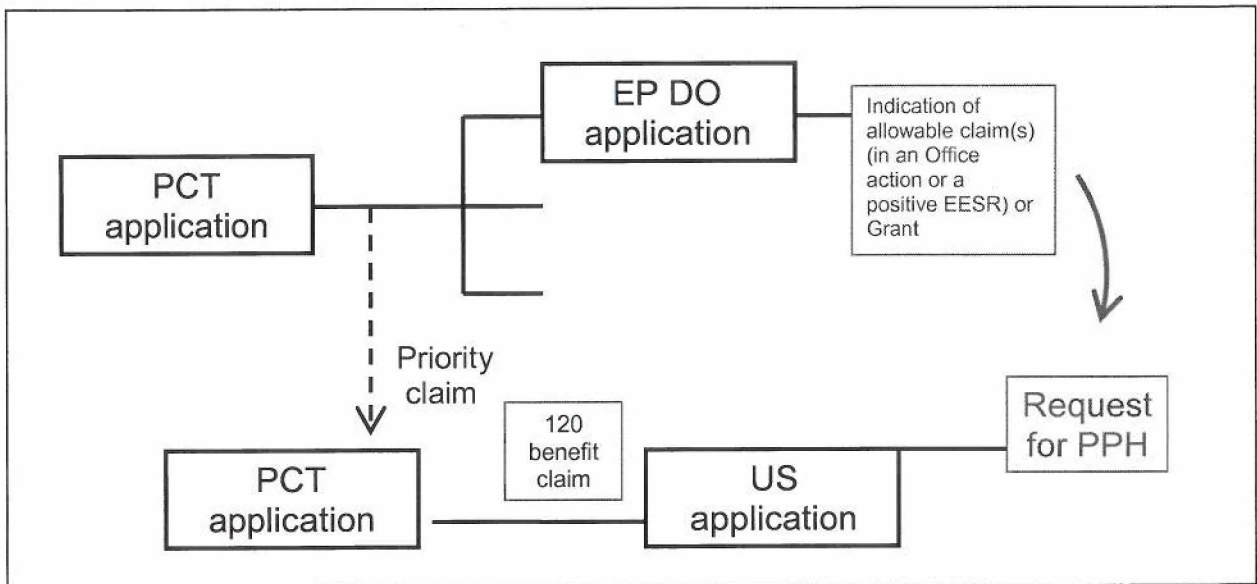
(c)(i):

- US application is a 111(a) bypass of a PCT application which claims Paris Convention priority to an EP application



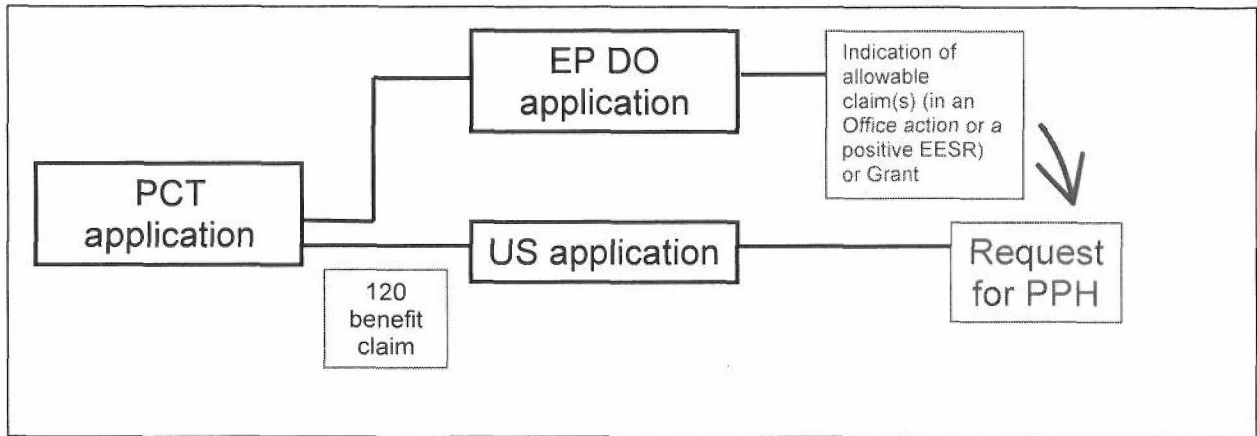
(c)(ii):

- US application is a 111(a) bypass of a PCT application which claims Paris Convention priority to another PCT application



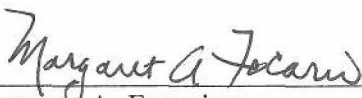
(c)(iii):

- US application is a 111(a) bypass of a PCT application which contains no priority claim



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: 12/10/08



Margaret A. Focarino
Acting Commissioner for Patents