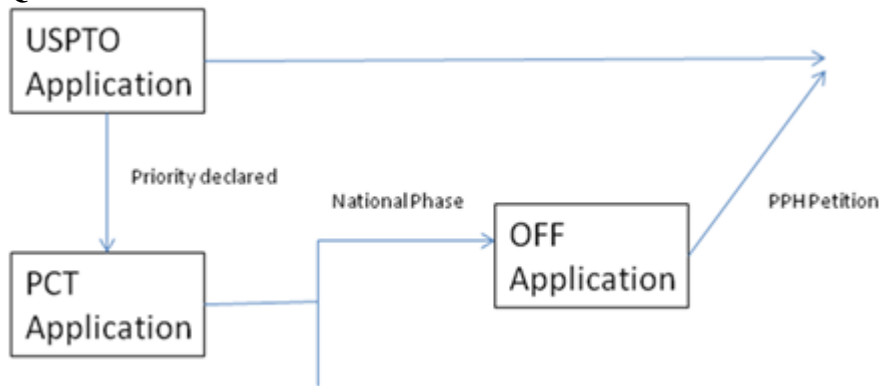


Patent Prosecution Highway (PPH) Frequently Asked Questions (FAQs)

1. Common to all PPH programs

1(a). Application eligibility (see item 9 below regarding the revised PPH requirements published on July 15, 2011).

Q1.



(i) I filed a US application first. A PCT application is subsequently filed which claims Paris Convention priority to the US application. The PCT enters national stage in a partnering office (“OFF application”) and during prosecution of that national stage entry application allowed claims are granted. Can the granted patent from the “OFF application” be used as a basis for a PPH request filed in the US application (assuming examination has not started in the US application)?

(ii) Suppose the first filed US application is a US provisional application and the PCT application claims Paris Convention priority to the US provisional application. A non-provisional application is timely filed which claims domestic priority to the US provisional application. Can the granted patent from the “OFF application” be used as a basis for a PPH request filed in the US non-provisional application which claims domestic priority to the US provisional application?

A1.(i). OFF as used in the PPH notices refers to the office of first filing. OSF as used in the PPH notices refers to the office of second filing. Based on the facts that you have provided, the OFF is the USPTO and the OSF is the partnering office. Even if you received allowable claims in the national stage entry (in a partnering office) of the PCT application, you are not eligible to file a PPH request in the US application based on the allowable claims from the national stage entry application because this will be going from OSF to OFF. Under the PPH framework, you must receive allowable claims from an OFF application before you can file a request for PPH in the OSF application and the OSF application must have a valid priority claim to an OFF application.

A1.(ii). The result would be the same as in A1.(i) if your first filed application is a US provisional application.

Q2. A US provisional application and a foreign application (directed to the same subject matter as in the US provisional application) were both filed on the same day. A US non-provisional application is timely filed which claims domestic priority under 35 U.S.C. 119(e) to the US provisional application and foreign priority under 35 U.S.C. 119(a) to the foreign application. If the foreign application receives allowable claims, can a PPH request be filed in the US non-provisional application based on the allowable claims from the foreign application? Does the additional domestic priority claim to the US provisional application affect the eligibility of the US non-provisional application in the PPH program?

A2. The US non-provisional application may be eligible to participate in the PPH based on the allowable claims from the foreign application. Since the foreign application was filed on the same day as the US provisional application, the foreign application may be considered as the office of first filing application. In addition, the US non-provisional application has a valid foreign priority claim under 35 U.S.C. 119(a) to the foreign application.

Q3 (revised). Is there a place where I should look for a complete listing of PPH participating countries?

A3 (revised). The complete list of PPH participating countries is available at: http://www.uspto.gov/patents/init_events/pph/index.jsp.

1(b). Examination has not begun

Q1. I understand that a PPH request may not be filed after examination of the US application has begun. Does this mean substantive examination? In other words, can a PPH request be filed after the USPTO has reviewed the US application for formalities only (for example, a Notice to File Missing Parts is mailed)? Can the PPH petition be filed after an applicant has received a restriction requirement but before receipt of the first office action on the merits?

A1. The requirement that examination of the US application must not have begun refers to substantive examination. Therefore, if you have only received a notice to file missing parts, this would not be considered as substantive examination. If you have received a restriction requirement in the US application, your US application may still be eligible to participate in the PPH program if the examiner has not started on the first action on the merits. However, at this point in time, you may not need PPH since your application will not be examined any faster than its normal examination process even if your PPH request is granted. With a restriction requirement, our examiner will generally examine the application within 60 days from the date you file your reply to the restriction requirement. By the time your PPH request is decided, your application would probably be examined in its regular turn anyway.

Q2. A US application claims foreign priority to an OFF application. The OFF application has received allowable claims. The US application has received a first office

action on the merits. Would it be possible to use the PPH program for a new US continuation or divisional application?

A2. If you choose to file a US continuation/divisional application, the continuation/divisional application may be eligible to participate in the PPH program based on the allowable claims from the OFF application.

1(c). Filing of the PPH request

Q1. I am filing a national stage entry into the US of a PCT application. Can I file the PPH request form simultaneously with the national stage entry papers? What is the required application number? What is the proper filing date?

A1 (revised). If you are entering national stage into the US based on a PCT application, there is no requirement that you file your PPH request with the filing of the national stage papers. It is not necessary to file your PPH papers so early because even if your PPH request is granted, our examiner cannot examine your application as special until the application has completed all its pre-exam processing. It is suggested that you wait until at least you get your US application number so that you can identify the US application number on the PPH request before you file your PPH papers. Note that the filing date of a national stage entry into the US of a PCT application is the international filing date (see 35 U.S.C. 363).

1(d). Timing of the examination

Q1. How much quicker will an application proceed to grant if a PPH request is filed at the USPTO? Is there a similar goal of final disposition as in Accelerated Examination (AE)? Or will it be a shorter time frame assuming the USPTO agrees with the patentability assessment of the office of first filing?

A1 (revised). The PPH program does not have a similar goal of final disposition of 12 months as in the AE program. The PPH program does not require the request to be filed at the time of filing of the application as in the AE program. The PPH program does not expedite the pre-exam processing as in the AE program. Under the PPH program, applicant chooses when to file the PPH papers. Once the PPH request is filed, the PPH request is generally decided within 2 months from the filing of the PPH request. If the PPH request is granted, the examiner will generally examine the application within 2 to 3 months from the grant of the PPH request provided the application has completed all its pre-exam processing and is ready for examination.

1(e). Patentability determination

Q1. If I submit the required documents and fee with my request to participate in the PPH program and the OFF application has been granted, does this mean automatic allowance in the USPTO?

A1 (revised). PPH is not full faith and credit. The fact that your application filed in the OFF has allowable claims does not mean that the corresponding claims in the corresponding application filed in the office of second filing (OSF) will automatically be allowed. The OSF examiner will examine the OSF application based on the patent law of the OSF.

Q2. I filed a national stage entry in the US of a PCT application filed in an OFF. The PCT application claims Paris Convention priority to an OFF application. A PPH request was granted in the US national stage application. I received an action from the US examiner which identified 16 species of the invention and is requiring an election of species. The US examiner is taking the position that the species lack the same or corresponding special technical feature. There was no lack of unity holding in the OFF application or the PCT application. Does the election of species requirement in the US national stage entry application run counter to the principles of the PPH program?

A2 (revised). The acceptance of the PPH request merely makes your application special and allows it to be advanced out of turn for examination. Even though your PCT application and the OFF application do not have any holdings of lack of unity, this does not mean that it would be improper for the US examiner to hold lack of unity and make an election of species requirement in the US national stage entry of the PCT application.

1(f). Information Disclosure Statements (IDSs)

Q1 (revised). The first action in the OFF application is a first action allowance with no office actions. In the Decision to grant, the OFF examiner cited several references. Should I submit an IDS listing those references, even though the references were not cited in the office action but instead were cited in the Decision to grant?

A1. If the OFF examiner cited documents in the decision to grant, you will need to list those documents in an IDS as part of your PPH supporting documents. The decision to grant is considered to be an office action.

Q2. One of the PPH requirements is that applicants must submit copies of all the documents cited by the foreign patent office. When the documents cited are in a foreign language, are applicants required to provide an English translation of the documents?

A2. The documents cited by the foreign office must be submitted in an IDS. The IDS must comply with the content requirements of 37 CFR 1.98. That is, if the documents are not in English, you will need to submit a concise explanation of the relevance pursuant to 37 CFR 1.98(a)(3). Where the document listed on the IDS is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office (see MPEP 609.04(a), subsection III.).

1(g). Miscellaneous/Fees

Effective May 25, 2010, the requirement for a petition fee to make the application special under the Patent Prosecution Highway program has been eliminated. See “Notice Regarding the Elimination of the Fee for Petitions To Make Special Filed Under the Patent Prosecution Highway (PPH) Programs” published in 75 Fed. Reg. 29312 on May 25, 2010.

All petitions to make special filed with a PPH request on or after May 25, 2010 will be treated as a request that the Director order their application be advanced out of turn to expedite the business of the Office under 37 CFR 1.102(a), and the petition fee set forth in 37 CFR 1.17(h) will not be required. Petitions to make special filed with a PPH request prior to May 25, 2010 will be treated under 37 CFR 1.102(d) and the petition fee set forth in 37 CFR 1.17(h) will be required.

Q1. If a new US application is accepted in the PPH program, is Patent Term Adjustment (PTA) still available to the US application?

A1. PTA is available to applications accepted in the PPH program.

Q2. Are extensions of time under 37 CFR 1.136(a) available for applications accepted in the PPH program?

A2. Yes. You may obtain extensions of time under 37 CFR 1.136(a) during prosecution of the US application accepted in the PPH program.

Q3. I recently filed a PPH request and upon review noted that there were errors on the PPH request and also that the PPH petition fee was not paid. With regard to the PPH request error, is it possible to amend the error before I receive a decision on the PPH request? With regard to the payment of the fee, can the \$130 fee be paid after the filing of the PPH request? If the fee can be paid later, can it be paid via EFS by credit card without a cover sheet or explanation of the payment?

A3 (revised). If you have not received a decision on your PPH request, it is suggest that you submit a corrected PPH request form along with the petition fee (since you stated that you did not submit the petition fee in the earlier request) via EFS-Web as soon as possible. In addition, you should also submit a transmittal letter with these documents explaining that the earlier-filed PPH request contained errors and the replacement documents corrected the errors. If you have already received a decision on the PPH request, in your reply to the PPH decision you should submit the corrected PPH request form along with the petition fee. You should also submit a transmittal letter explaining the errors that you are correcting in the replacement PPH request form.

Q4. The PPH notices indicated that the PPH papers must be submitted via EFS-Web. What document description should I use to submit the PPH request?

A4. The document description is provided on the upper left-hand corner of the PPH request form. For all the PPH programs (except for the PCT-PPH pilot program that commenced on January 29, 2010), the document description is “Petition to make special under Patent Pros Hwy.” For the PCT-PPH pilot program, the document description is “Petition to make special under PCT-Patent Pros Hwy.” For the IDS accompanying the PPH request, the document description is “Information Disclosure Statement (IDS).” For the preliminary amendment accompanying the PPH request, the document description is “Preliminary amendment.”

Q5 (New). Can I rely on the allowed claims from a utility model or an innovation patent from an OFF to form the basis for requesting PPH in the USPTO?

A5 (New). With one exception, the answer is no. Utility models and innovation patents as a general matter are not required to meet the same patentability standards as regular (utility) patents, and typically are not subjected to substantive examination. An exception has been made for Korean utility models (see notice available at <http://www.uspto.gov/web/offices/com/sol/og/2009/week08/TOC.htm#ref14>). The USPTO continues to consider practices in other countries with regard to possible inclusion in the future of similar types of applications, but has made no decisions as such at this time.

2. Regarding the PPH program between the USPTO and Canada (CIPO)

2(a). Application eligibility

Q1. I filed a Canadian provisional application (CA1). Within 12 months I filed a PCT application claiming Paris Convention priority to CA1. PCT application entered national stage in Canada (CA2). The CA2 application has allowed claims. Is my US national stage entry of the same PCT application eligible to participate in the PPH based on the allowed claims from the CA2 application even though the US application does not claim priority to the CA2 application?

A1. Your US national stage application may be eligible to participate in the PPH program based on allowed claims from the CA2 application. However, since the CA2 application with the allowed claims is not the Canadian application (CA1) for which priority is claimed in the US application, you will need to identify the relationship between the CA2 and CA1 applications. The explanation may be as follows: The CA2 application which contains the allowed claims is a national stage entry of the same PCT application for which the US application is also a national stage entry thereof and the PCT application claims priority to the CA1 application. This explanation may be included in the transmittal letter accompanying the PPH documents.

3. Regarding the PPH program between the USPTO and the EPO

3(a). Application eligibility

Q1. I filed the first application in Germany. I later filed an application in the EPO and an application in the USPTO claiming Paris Convention priority to the German application. When a European patent issues, can I file a PPH request in the US application based on the allowed claims in the EP application?

A1. The US application is not eligible to participate in the PPH program based on the allowed claims from the EP application since under the facts that you have provided, the first application was filed in Germany rather than in the EPO.

Q2. An EP1 application was filed first. A PCT application was subsequently filed in the EPO and claimed Paris Convention priority to the EP1 application. The EP1 application was then abandoned. National stage of the PCT was entered in both the EPO (EP2) and the USPTO. EP2 application has allowable claims. May I file a PPH request in the US national stage application based on the allowable claims in the EP2 application?

A2. Yes, your US national stage application may be eligible to participate in the PPH program based on the allowable claims in the EP2 application. However, since the EP application with the allowable claims (EP2) is not the priority application (EP1) that is claimed in the US national stage application, you will need to identify the relationship between the EP2 and EP1 applications. The explanation may be as follows: The EP application (EP2) with the allowable claims is a national stage entry of the same PCT application for which the US application is also a national stage entry thereof and the PCT application claims Paris Convention priority to the EP1 priority application.

3(b). Extended European Search Report (EESR)

Q1. Can you provide some information/explanation about what is meant by “a positive Extended European Search Report”?

A1. The EPO generates an Extended European Search Report (EESR) prior to an office action. If the EESR only contains “A” references (no “X” or “Y” references) directed to a particular claim then that claim is considered to be allowable by the EPO. You will be able to use that EPO allowable claim as the basis for your PPH request in the US application. All the claims in the US application must sufficiently correspond to that EP allowable claim.

4. Regarding PPH between the USPTO and Singapore (IPOS)

4(a). Application eligibility

Q1. I filed the first application in Singapore and then I filed a PCT application claiming Paris Convention priority to the Singapore application. I entered national stage in the US from the PCT application. The Singapore application now has allowable claims. My client indicated that IPOS used the Austrian Patent Office to conduct the search and examination on its behalf and the Singapore examination report for the Singapore priority application was carried out, issued and sent in the name of the IPOS. In view of the

requirement that the Singapore application must have at least one claim that was determined by the IPOS to be allowable/patentable in a substantive examination carried out in the name of the IPOS (and not based on examination results adopted by the IPOS from another office), is my US national stage application eligible to participate in the PPH program based on the allowable claims from the Singapore priority application?

A1. Yes, since the Singapore examination report indicating allowable claims was carried out, issued and sent in the name of the IPOS, your US national stage application may be eligible to participate in the PPH program based on the allowable IPOS claims.

5. Regarding PPH between the USPTO and JPO

5(a). Application eligibility

Q1. I filed 3 JP applications (JP1, JP2, JP3). I then filed a PCT application claiming Paris Convention priority to the 3 JP applications. National stage of the PCT was entered in both the JPO (JP4) and the USPTO. JP4 application has allowable claims. Is the US national stage application eligible to participate in the PPH program based on allowable claims from the JP4 application?

A1. Yes, your US national stage application may be eligible to participate in the PPH program based on the allowable claims in the JP4 application. However, since the JP application with the allowable claims (JP4) is not the priority application (JP1, JP2, JP3) that is claimed in the US national stage application, you will need to identify the relationship between the JP4 and the JP1, JP2, JP3 applications. The explanation may be as follows: The JP application (JP4) with the allowable claims is a national stage entry of the same PCT application for which the US application is also a national stage entry thereof and the PCT application claims Paris Convention priority to the JP1, JP2, JP3 priority applications.

5(b). Obtaining JP documents via the Dossier Access System

Q1. The notice regarding the full implementation of the PPH program between the USPTO and JPO stated that “[i]f a copy of the office action 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.” Please advise how an applicant could find out whether the JPO office action is available via the Dossier Access System or not.

A1. The USPTO currently does not have the capability to download copies of JPO documents via the Dossier Access System for importation into our Image File Wrapper (IFW). We have eliminated the check box that was provided on the PPH request form which permitted applicants to request that the USPTO obtain copies of the OFF documents via the Dossier Access System. Applicant must submit copies of the OFF documents to the USPTO via EFS-Web. The USPTO has provided a clarification note on the PPH Web page at: http://www.uspto.gov/patents/init_events/pph/pph_jpo.jsp.

5(c). Machine translation into the English language of the JP office actions

Q1. The notice on the revised requirement that became effective on January 29, 2010 indicated that applicant will be permitted to submit a machine translation into the English language of the latest JP office action prior to the “Decision to Grant a Patent” provided the machine translation is one that was provided by the JPO rather than from a commercial service. The language of the revised requirement seems to indicate that the applicant must submit the machine translation to the USPTO. However, the JPO does not currently make machine translations of the office actions available to the applicant. It is my understanding that the machine translations of the JP office actions are available to the USPTO through the Dossier Access System. Is there a procedure for the applicant to request the USPTO to electronically retrieve a machine translation of the JP office actions through the Dossier Access System?

A1. JPO has indicated that the machine translations into the English language of the JP file wrapper documents are available via the Advanced Industrial Property Network (AIPN). AIPN is only available to intellectual property offices and is not available to the applicants or the public. JPO has also indicated that they do not plan to send copies of the machine translations to the applicants. The USPTO currently does not have the capability to download a copy of the machine translation into the English language of the JP office action via AIPN for importation into our Image File Wrapper (IFW). In view of the current circumstances at the JPO and USPTO, applicants will have to continue to provide a manual translation of the JP office action along with the accuracy statement until further notice. The USPTO has provided a clarification note on the PPH Web page at: http://www.uspto.gov/patents/init_events/pph/pph_jpo.jsp.

5(d). Definition of “sufficient correspondence”

Q1. The notice on the revised requirement that became effective on January 29, 2010 indicated that US claims will be considered to sufficiently correspond with the claims allowed by the JPO if the US claims are of the same or similar scope or the US claims are narrower in scope than the allowed JP claims. The additional limitation that makes the US claims narrower in scope than the allowed JP claims must be presented in dependent form. Can applicant incorporate the narrower dependent claim into the independent claim during the US prosecution if the independent claim which has the same scope as the allowed JP claim was rejected by the US examiner but the narrower dependent claim was objected to as being dependent on a rejected claim?

A1 (revised). Yes. Applicants are permitted to incorporate the limitations from an allowed or objected to dependent claim into an independent claim during prosecution of the US application.

Q2. My PPH request was granted and during prosecution, the US examiner rejected all the claims based on prior art references. The notice on the revised requirement that became effective on January 29, 2010 stated that additional limitation that makes the US claims narrower in scope than the allowed JP claims may be added as dependent claims.

Can I now add additional limitations to the dependent claims in the US application to overcome the rejections?

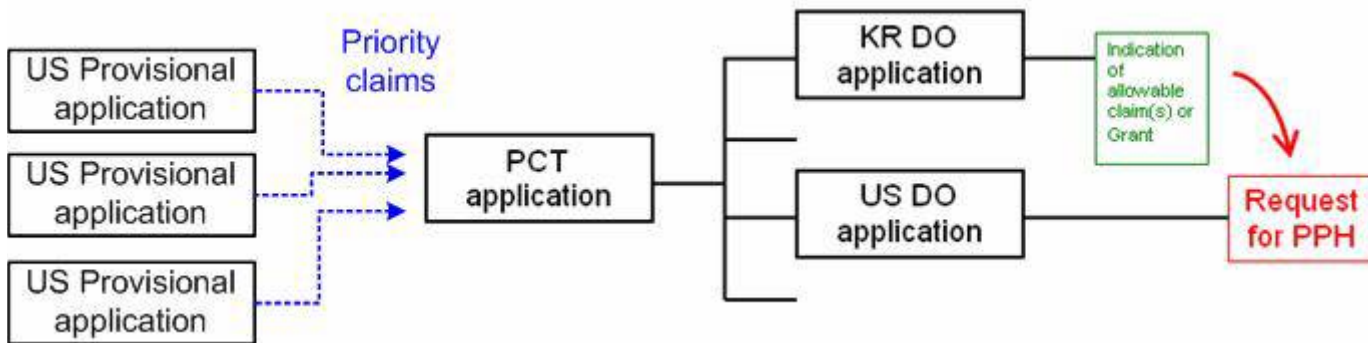
A2. No. The additional limitations presented as dependent claims must be added by preliminary amendment when the PPH request is filed. If the PPH request is granted, during prosecution of the US application, you may not add additional limitations to the US claims.

Q3. Will the broader definition of “sufficiently correspond” be applicable in programs other than the PCT-PPH and the JPO-PPH programs?

A3 (revised). The revised definition of “sufficient correspondence” only applies to the PCT-PPH programs and the pilot programs under the revised requirements published on July 15, 2011 (see item 9 below).

6. Regarding PPH between the USPTO and Korea (KIPO)

6(a). Application eligibility



Q1. National stage of the PCT application was entered into both the US and KR. The PCT application claims Paris Convention priority to 3 US provisional applications. The KR DO application is granted in KIPO. Is the US DO application eligible to participate in the PPH based on the allowed claims from the KR DO application?

A1. Your US national stage application is not eligible to participate in the PPH program based on allowed claims from the KR application since the office of first filing in your facts is the USPTO and not the KIPO.

7. Regarding PPH between the USPTO and the United Kingdom (UKIPO)

7(a). Application eligibility (see item 9 below regarding the revised PPH requirements published on July 15, 2011)

Q1. I filed a first U.S. application with no earlier priority claims. 2 months later I filed a corresponding UK application. Am I correct that if I receive allowable claims in the UK application that I could at that time request PPH for the pending US application?

A1 (revised). Yes, you may file a PPH request in the U.S. application based on the allowed claims from the UK application. The PPH requirements were revised on July 15, 2011 for the PPH pilot program between the USPTO and UKIPO (see item 9 below and the notice available at http://www.uspto.gov/patents/init_events/pph/pph-mottainai_ukipo.pdf).

8. Regarding the PCT-PPH pilot programs

8(a). Application eligibility

Q1. I have a PCT application which claims Paris Convention priority to a US provisional application. I have received positive PCT work product from the JPO in the PCT application. Can I file a PCT-PPH request in (i) a US non-provisional application that claims domestic benefit under 35 U.S.C. 119(e) to the US provisional application, or (ii) a US national stage entry of the PCT application, or (iii) a 111(a) bypass of the PCT application?

A1. Yes to (i), (ii) and (iii).

Q2. I have a PCT application and I have received a positive International Preliminary Report on Patentability (IPRP) from the EPO. I would like to file a PCT-PPH request in my national stage entry of the PCT in the US. Is my national stage entry of the PCT application in the USPTO eligible to participate in the PCT-PPH pilot based on the positive IPRP?

A2. Yes. For an international application filed on or after January 1, 2004, if applicant did not timely file a demand for international preliminary examination with the International Preliminary Examining Authority (IPEA), the written opinion is transmitted to the designated offices in the form of an International Preliminary Report on Patentability (IPRP). The IPRP has the same contents as the written opinion. See PCT rule 44bis. For an international application filed on or after January 1, 2004, when an international preliminary examination is performed by an IPEA, the international preliminary examination report (IPER) bears the title "International Preliminary Report on Patentability."

8(b). English translation of the claims

Q1. If the PCT application (in Japanese) and the corresponding English specification were previously filed in the national stage application, then I believe a statement of accuracy of the English translation of the claims indicated as having novelty, inventive step, and industrial applicability is not necessary when filing the PCT-PPH request. Please confirm.

A1. Where your PCT application is not in the English language, when you file the English specification in the US national stage application, there is no requirement that the English language specification must be accompanied by an accuracy statement (see 35 U.S.C. 371(c)(2)). However, as noted in item II.B.(7) of the notice announcing the PCT-PPH pilot program, if the claims from the PCT application which were indicated as having novelty, inventive step and industrial applicability in the latest work product of the PCT application are not in English, you will need to submit an English translation and an accuracy statement.

8(c). Definition of “sufficient correspondence”

Q1. The notice on the PCT-PPH pilot program between the USPTO and JPO based on PCT work products indicated that US claims will be considered to sufficiently correspond with the claims indicated as having novelty, inventive step and industrial applicability and free of any observations described in Box VIII in the latest work product of the corresponding PCT application if the US claims are of the same or similar scope or the US claims are narrower in scope than the claims indicated as having novelty, inventive step and industrial applicability and free of any observations described in Box VIII in the latest work product of the corresponding PCT application. The additional limitation that makes the US claims narrower in scope than the claims indicated as having novelty, inventive step and industrial applicability and free of any observations described in Box VIII in the latest work product of the corresponding PCT application must be presented in dependent form. Can applicant incorporate the narrower dependent claim into the independent claim during the US prosecution if the independent claim which has the same scope as the claim indicated as having novelty, inventive step and industrial applicability and free of any observations described in Box VIII in the latest work product of the corresponding PCT application was rejected by the US examiner but the narrower dependent claim was objected to as being dependent on a rejected claim?

A1 (revised). Yes. Applicants are permitted to incorporate the limitations from an allowed or objected to dependent claim into an independent claim during prosecution of the US application. Applicants are also permitted to add limitations into the US claims during prosecution provided such additional limitations are presented in dependent form only.

Q2. My PCT-PPH request was granted and during prosecution, the US examiner rejected all the claims based on prior art references. The notice on the PCT-PPH pilot program between the USPTO and the JPO based on PCT work products stated that additional limitation that makes the US claims narrower in scope than the claims indicated as having novelty, inventive step and industrial applicability and free of any observations described in Box VIII in the latest work product of the corresponding PCT application may be added as dependent claims. Can I now add additional limitations to the dependent claims in the US application to overcome the rejections?

A2 (revised). Yes. The additional limitations must be presented as dependent claims only.

Q3 (revised). Will the broader definition of “sufficiently correspond” be applicable in programs other than the PCT-PPH program?

A3 (revised). The revised definition of “sufficient correspondence” applies to the PCT-PPH programs and the revised PPH requirements published on July 15, 2011 (see item 9 below regarding the revised PPH requirements).

8(d). Miscellaneous

Q1. The PCT-PPH notice indicated that the PCT-PPH papers must be submitted via EFS-Web. What document description should I use to submit the PCT-PPH request?

A4. The document description is provided on the upper left-hand corner of the PCT-PPH request form. For the PCT-PPH pilot program, the document description is “Petition to make special under PCT-Patent Pros Hwy.” For all the other PPH programs (except for the PCT-PPH pilot program that commenced on January 29, 2010), the document description is “Petition to make special under Patent Pros Hwy.” For the IDS accompanying the PCT-PPH request, the document description is “Information Disclosure Statement (IDS).” For the preliminary amendment accompanying the PCT-PPH request, the document description is “Preliminary amendment.”

9. Regarding the PPH pilot programs based on the revised PPH requirements published on July 15, 2011 (New)

Q1. Do the revised PPH requirements published on July 15, 2011 apply to all PPH requests filed in the USPTO on or after July 15, 2011?

A1. No. The USPTO has agreements with 7 offices to implement the revised PPH requirements on a trial basis for a period of one year starting on July 15, 2011 and ending on July 14, 2012. These offices are:

IP Australia (http://www.uspto.gov/patents/init_events/pph/pph-mottainai_ipau.pdf);
Canada (http://www.uspto.gov/patents/init_events/pph/pph-mottainai_cipo.pdf);
Finland (http://www.uspto.gov/patents/init_events/pph/pph-mottainai_nbpr.pdf);
Japan (http://www.uspto.gov/patents/init_events/pph/pph-mottainai_jpo.pdf);
Russia (http://www.uspto.gov/patents/init_events/pph/pph-mottainai_ropatent.pdf);
Spain (http://www.uspto.gov/patents/init_events/pph/pph-mottainai_spto.pdf); and
the United Kingdom (http://www.uspto.gov/patents/init_events/pph/pph-mottainai_ukipo.pdf).

All other PPH programs and the PCT-PPH programs are not affected by the revised PPH requirements published on July 15, 2011.

Q2. How are the revised PPH requirements different than the prior PPH requirements?

A2. In order to improve the PPH programs and make them available to a wider range of applicants, the USPTO, IPAU, CIPO, NBPR, JPO, Rospatent, SPTO and UKIPO agreed to revise the requirements for requesting participation in the PPH pilot programs. The revised requirements eliminated the OFF to OSF relationship and broadened the definition of “sufficient correspondence.”

Under the revised PPH requirements, an applicant may request participation in the PPH pilot program at an office of later examination (OLE) by using the examination results of an office of earlier examination (OEE) provided the OEE and OLE have an agreement on the revised requirements and the OEE application and the OLE application have the same priority/filing date. See the flow diagrams in the ANNEX attached to the notices.

Regarding the definition of “sufficient correspondence” of the claims, the claims in the OLE must be of the same or similar scope as the claims indicated as allowable by the OEE or the claims in the OLE are narrower in scope than the claims in the OEE. Where the USPTO is the OLE, the additional limitation that makes the claims in the U.S. application narrower in scope than the allowable claims in the OEE must have support in the written description of the U.S. application and the additional limitation must be presented in dependent form. Applicants are also permitted to add limitations into the US claims during prosecution provided such additional limitations are presented in dependent form only (i.e., complies with the definition of “sufficient correspondence”).