

**Notice Regarding Full Implementation of Patent Prosecution Highway Program
between the United States Patent and Trademark Office and the
Mexican Institute of Industrial Property**

I. Background

On March 1, 2011, the United States Patent and Trademark Office (USPTO) began a Patent Prosecution Highway (PPH) pilot program with the Mexican Institute of Industrial Property (IMPI). For a complete description of the PPH pilot program, see "Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Mexican Institute of Industrial Property," 1364 *Off. Gaz. Pat. Office* 201 (March 15, 2011). The PPH program permits: (1) applicants to expeditiously obtain a patent in the Office of second filing (OSF) at an early stage, by utilizing the petition to make special procedures currently available in the OSF, based on claims that have been allowed in the Office of first filing (OFF); (2) the OSF to reduce duplication of search efforts by exploiting the search and examination results of the OFF to the extent practicable; and (3) the OSF to reduce the examination workload since the scope of the claims in the OSF application has been clarified through the OFF's examination prosecution.

II. Full Implementation of the Patent Prosecution Highway Program

The USPTO and the IMPI agreed to fully implement the PPH program on a permanent basis starting on September 1, 2012. While the program itself will become a permanent cooperative arrangement between the offices, the specific program requirements are subject to change in the future depending on further development and evolution of the PPH. Notice of any such changes to the program will be published.

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 PPH request for expedited examination by order of the Director to expedite the business of the Office under 37 CFR 1.102(a). The procedures and requirements for filing a request in the USPTO for participation in the PPH program are set forth below.

A. Requirements for Requesting Participation in the PPH Program in the USPTO

In order to be eligible to participate in the PPH 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 with the IMPI, 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), in which the PCT application

- (i) validly claims priority under 35 U.S.C. § 365(b) to an application filed with the IMPI, 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

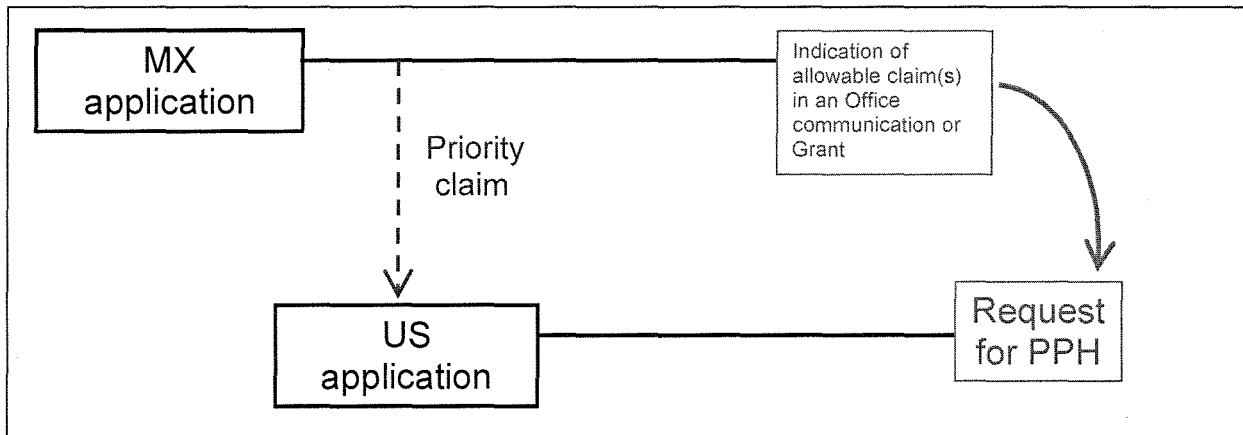
(c) a so-called bypass application filed under 35 U.S.C. § 111(a) which validly claims benefit under 35 U.S.C. § 120 to a PCT application, in which the PCT application

- (i) validly claims priority under 35 U.S.C. § 365(b) to an application filed with the IMPI, 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.

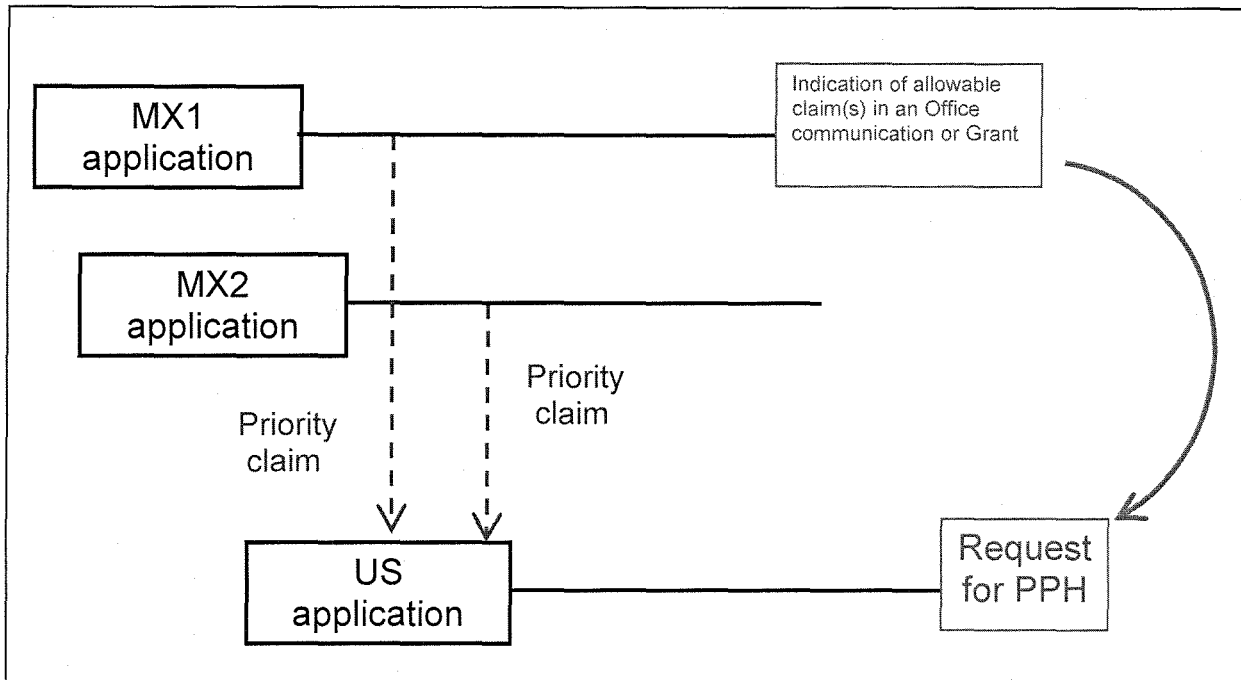
Examples of U.S. applications that fall under requirement (1) are:

(1)(a)(i):

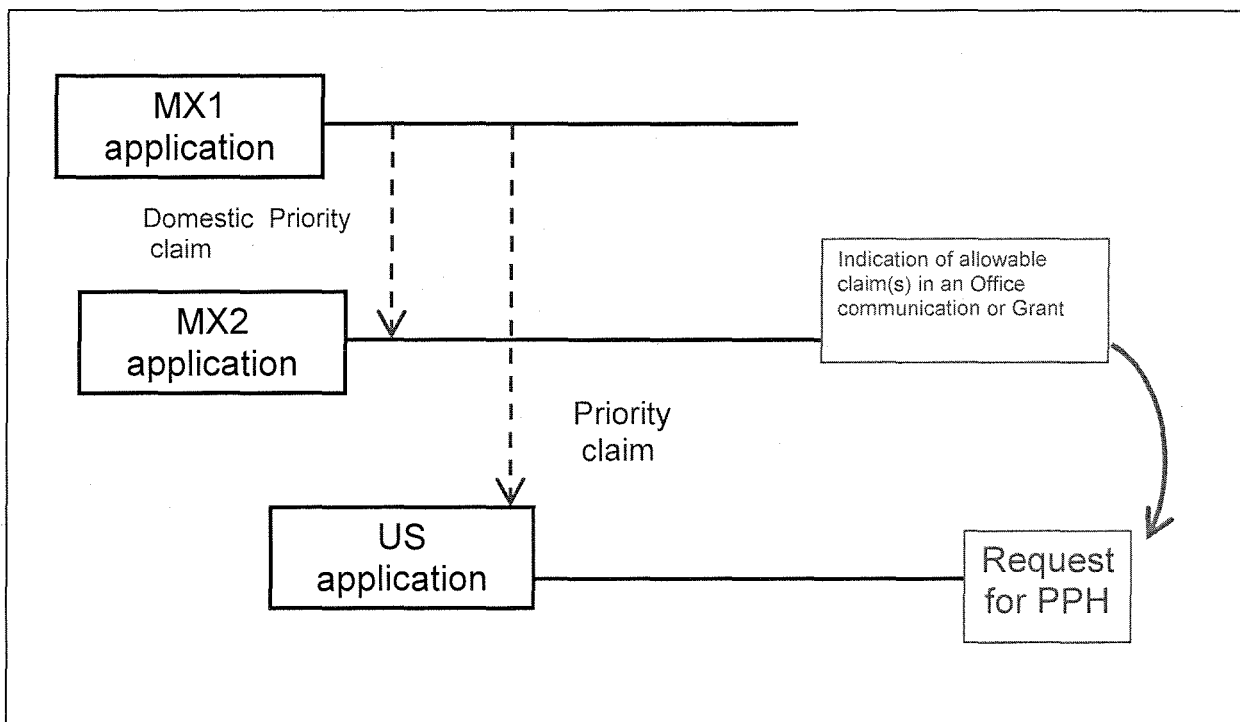
- U.S. application with single Paris Convention priority claim to an application filed in Mexico (MX)



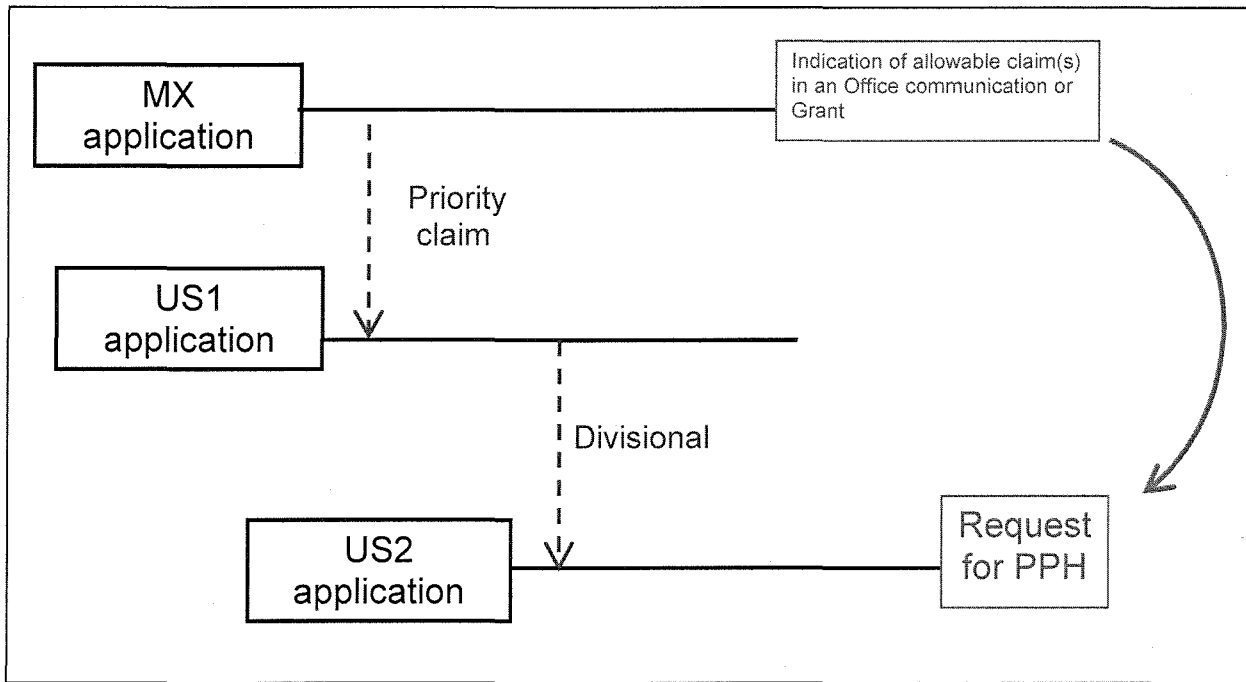
- U.S. application with multiple Paris Convention priority claims to MX applications



- Paris route and domestic priority

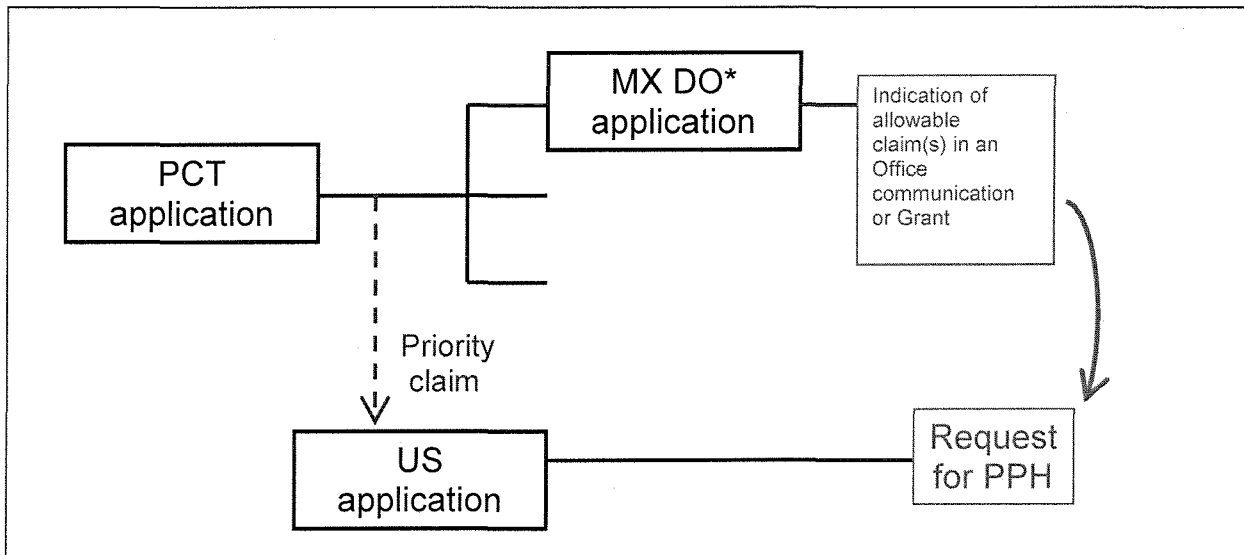


- Paris route and divisional application



(1)(a)(ii):

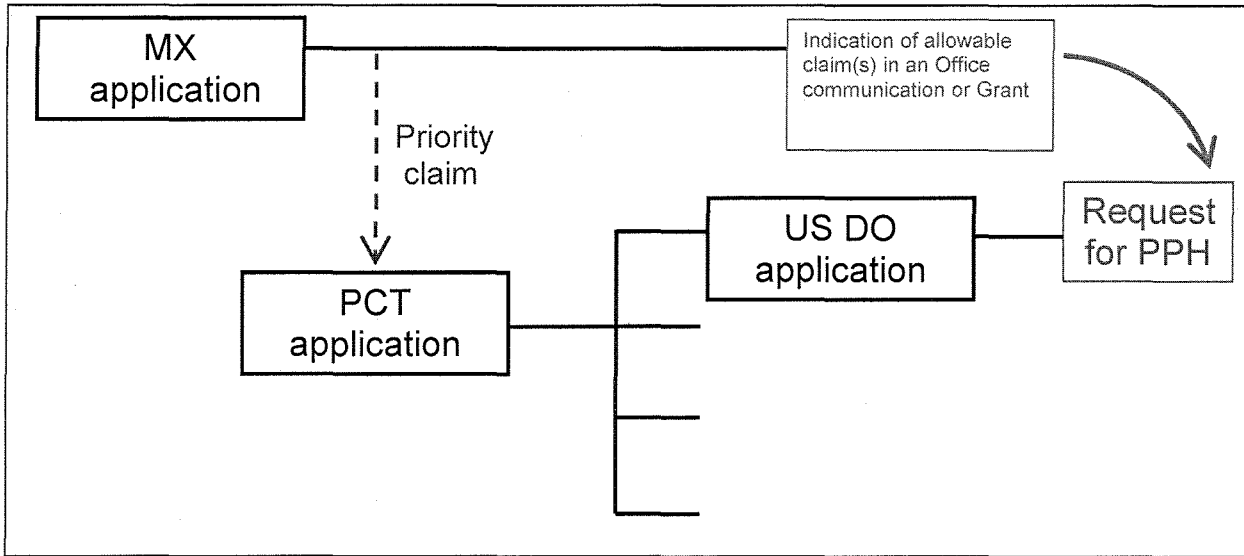
- U.S. application claims Paris Convention priority to a PCT application



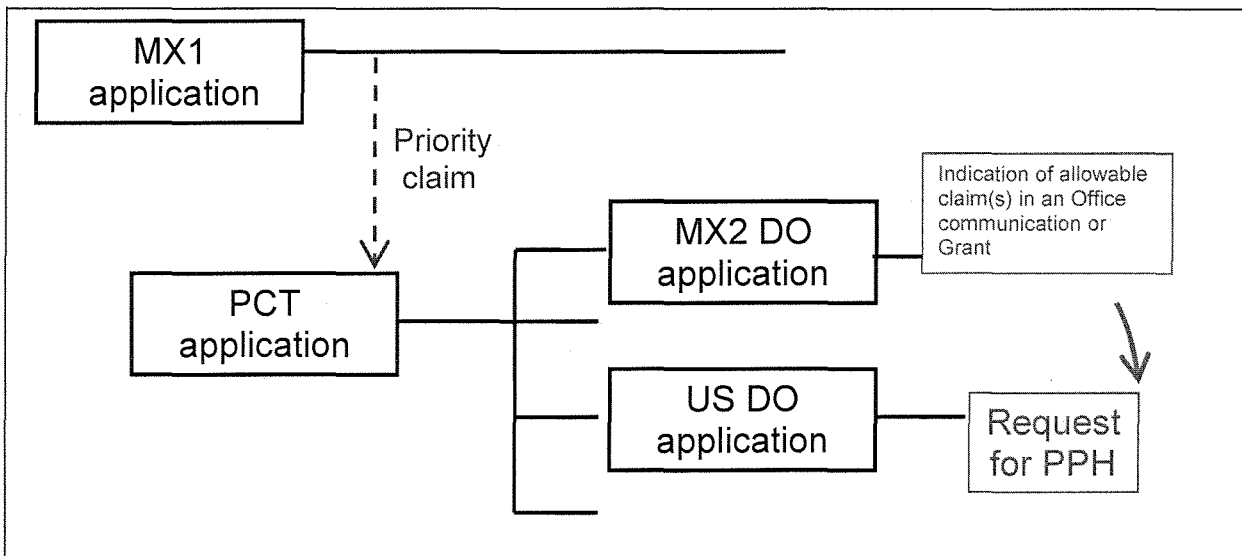
* DO – Designated Office

(1)(b)(i):

- U.S. application is a national stage of a PCT application which claims Paris Convention priority to an MX application

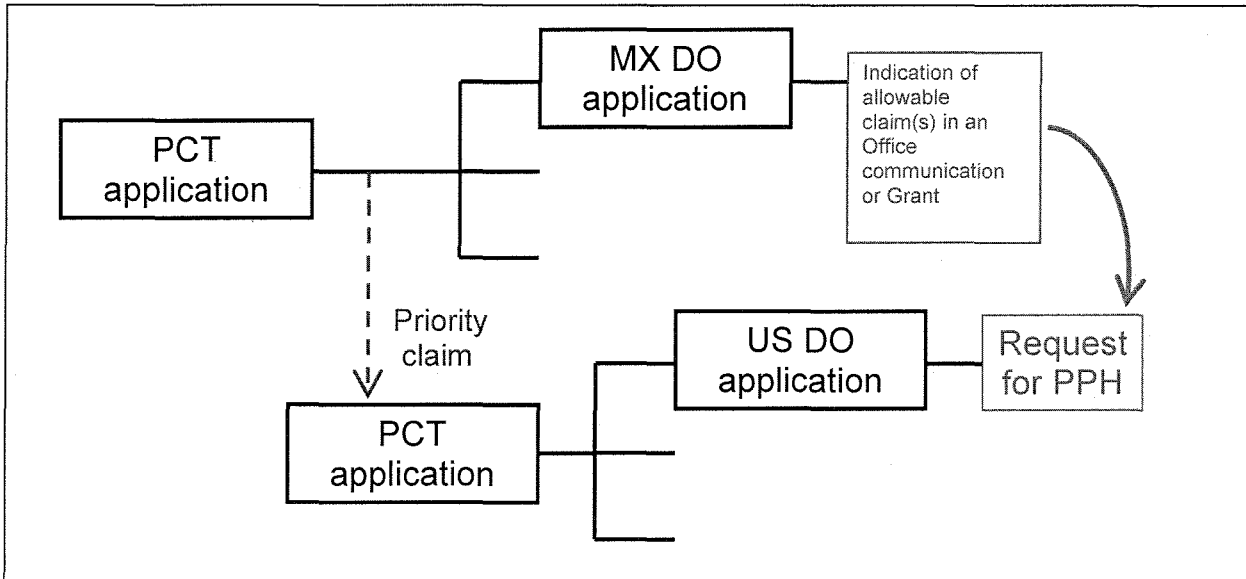


- PCT Route

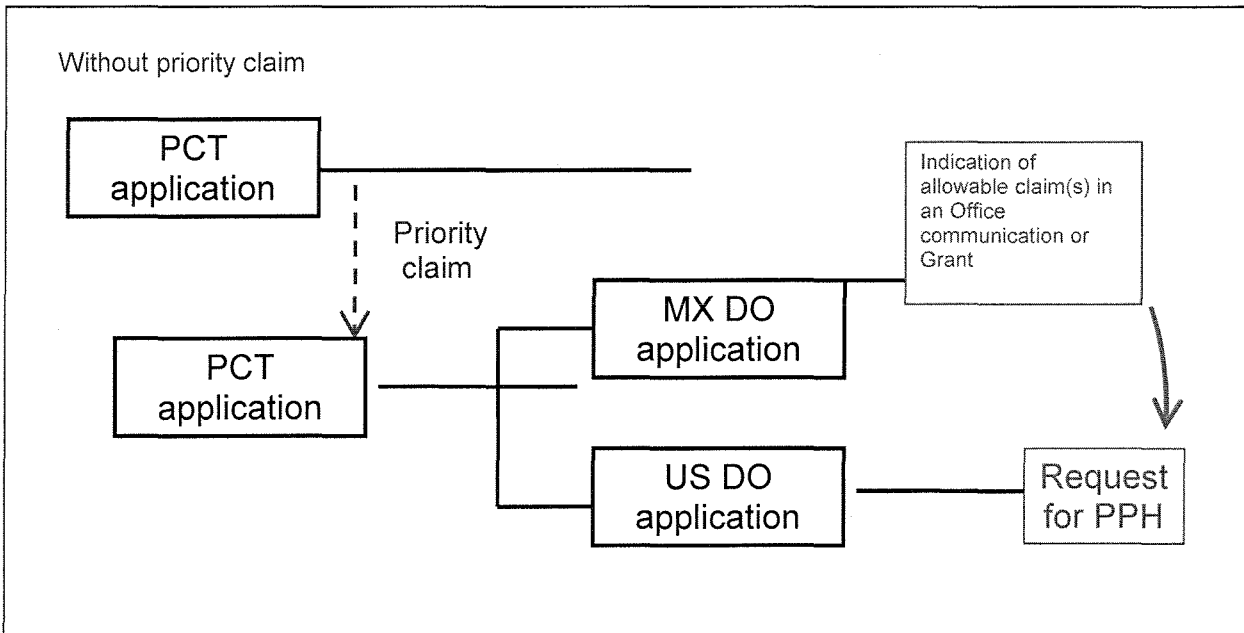


(1)(b)(ii):

- U.S. application is a national stage of a PCT application which claims Paris Convention priority to another PCT application

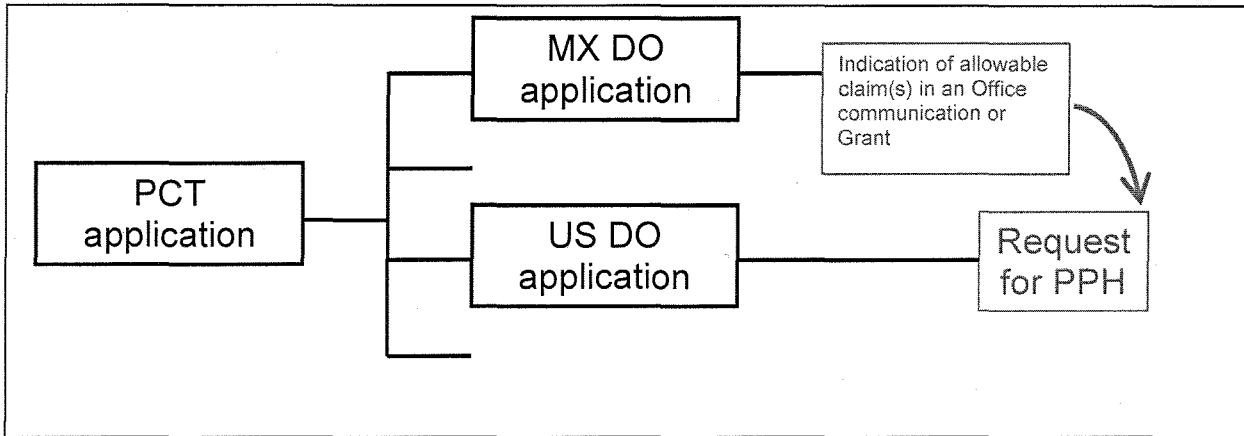


- Direct PCT and PCT Route



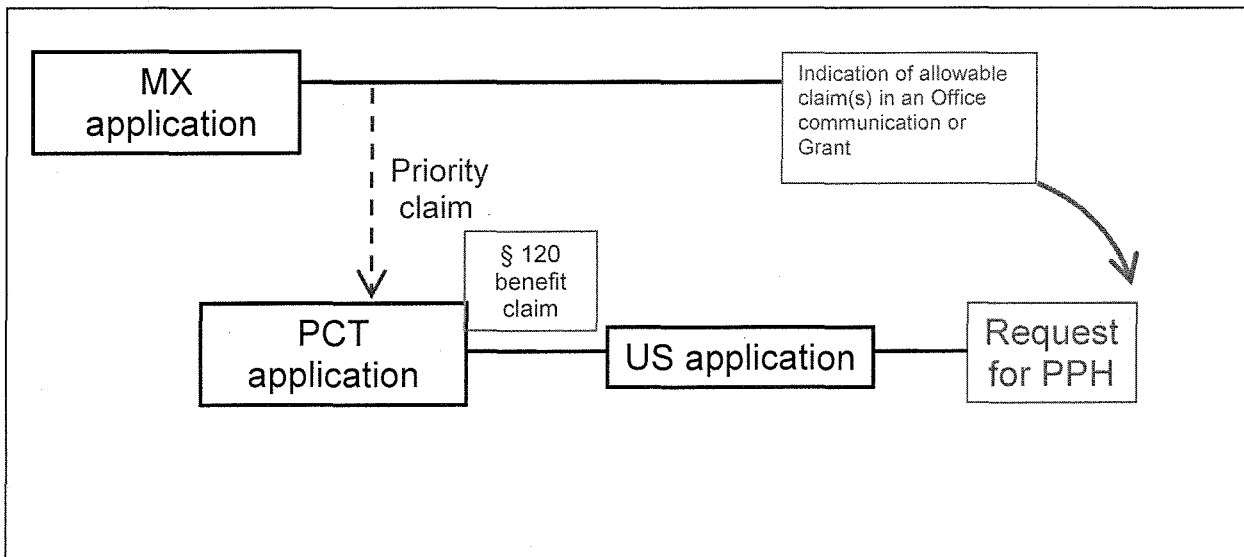
(1)(b)(iii):

- U.S. application is a national stage of a PCT application without priority claim



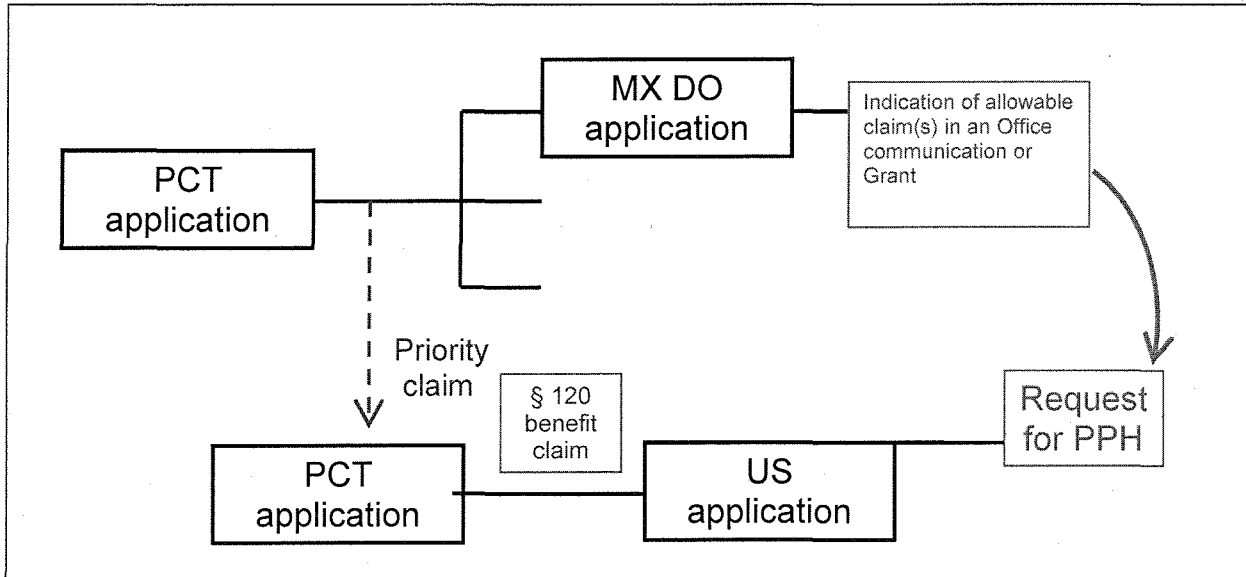
(1)(c)(i):

- U.S. application is a § 111(a) bypass of a PCT application which claims Paris Convention priority to an MX application



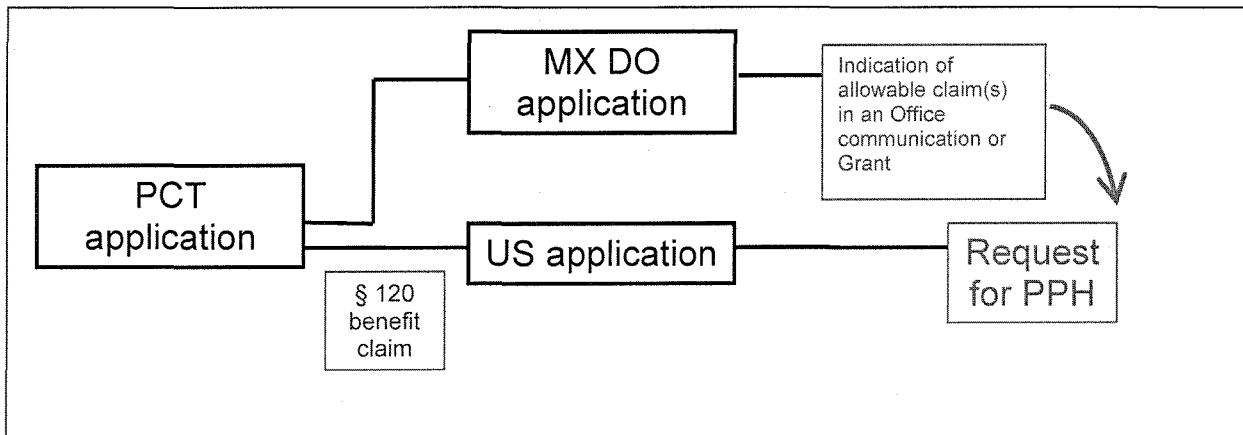
(1)(c)(ii):

- U.S. application is a § 111(a) bypass of a PCT application which claims Paris Convention priority to another PCT application



(1)(c)(iii):

- U.S. application is a § 111(a) bypass of a PCT application which contains no priority claim



The MX application whose claims are determined to be allowable/patentable does not have to be the application for which priority is claimed in the U.S. application (the basic application). The MX application can be an application explicitly derived from the basic application (e.g., a divisional application of the basic application). Note that where the MX application that contains the allowable/patentable claims is not the same application for which priority is claimed in the U.S. application, the applicant must identify the relationship between the MX application that contains the allowable/patentable claims and the MX priority application claimed in the U.S. application (e.g., MX application X that contains the allowable/patentable claims is a divisional application of MX application Y, which is the priority application claimed in the U.S. application).

Provisional applications, plant applications, design applications, reissue applications, reexamination proceedings, and applications subject to a secrecy order are excluded and not subject to participation in the PPH.

(2) The MX application(s) have at least one claim that was determined by the IMPI to be allowable/patentable in a substantive examination carried out in the name of the IMPI. The applicant must submit a copy of the allowable/patentable claims from the MX application(s) along with an English translation thereof and a statement that the English translation is accurate if the claims are not in the English language. If the IMPI office action does not explicitly state that a particular claim is allowable, the applicant must include a statement in the request for participation in the PPH program or in the transmittal letter accompanying the request for participation that no rejection has been made in the IMPI office action regarding that claim, and therefore, the claim is deemed allowable by the IMPI.

(3) All the claims in each U.S. application for which a request for participation in the PPH program is made must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claims in the MX application(s). A claim is considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claim in the U.S. application is of the same or similar scope as a claim indicated as allowable in the application filed in the IMPI. A claim in the U.S. application which is narrower in scope than the claims indicated as allowable in the application filed in the IMPI will also sufficiently correspond if presented as a claim dependent upon a claim which is of the same or similar scope as a claim indicated as allowable in the application filed in the IMPI. The additional limitation that makes the claim in the U.S. application narrower in scope than the allowable/patentable claims in the application filed in the IMPI must have support in the written description of the U.S. application.

A claim in the U.S. application which introduces a new/different category of claims to those claims indicated as allowable in the application filed in the IMPI is not considered to sufficiently correspond. For example, if the only allowable/patentable claims in the application filed in the IMPI are claims to a process of manufacturing a product, then any product claims in the U.S. application are not considered to sufficiently correspond, even if the product claims are dependent on process claims which sufficiently correspond to allowable/patentable claims in the application filed in the IMPI.

The applicant is 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 application(s) filed in the IMPI. Any dependent claims with additional limitations must be clearly identified in the claims correspondence table.

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

(5) The applicant must file a request for participation in the PPH program and a request that the U.S. application be advanced out of turn for examination by order of the Director to expedite the business of the Office under 37 CFR 1.102(a). A sample request/petition form (PTO/SB/20MX) is available from the USPTO Web site at <http://www.uspto.gov/forms/>. Applicants are encouraged to use the USPTO request/petition form. A petition fee under 37 CFR 1.17(h) is NOT required. See Notice Regarding the Elimination of the Fee for Petitions To Make Special Filed Under the Patent Prosecution Highway (PPH) Programs, 75 Fed. Reg. 29312 (May 25, 2010).

(6) The applicant must submit a copy of all the office actions (which are relevant to patentability) from each of the MX 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 the office actions are not in the English language. In addition, the applicant must submit copies of any office actions (which are relevant to patentability) from the MX application(s) issued after the grant of the request for participation in the PPH program in the USPTO (especially where the IMPI might have reversed a prior holding of allowability).

(7) The applicant must submit an information disclosure statement (IDS) listing the documents cited by the IMPI examiner in the IMPI office action (unless such an IDS has already been filed in the U.S. application). The applicant must submit copies of all the documents cited in the IMPI 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 program and all the supporting documents must be submitted to the USPTO via EFS-Web and indexed with the following document description: "Petition to make special under Patent Pros Hwy." Information regarding EFS-Web is available at <http://www.uspto.gov/patents/process/file/efs/>. 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 program and special status are granted, the 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 program does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The 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 the 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, the applicant will be notified and the U.S. application will be advanced out of turn for examination. If not perfected, the applicant will be notified and the application will await action in its regular turn.

(8) Request for participation in the PPH program and special status granted in a parent application will not carry over to a continuing application. The applicant must fulfill all the conditions set forth above in order for special status to be granted in the continuing application.

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 program, it will not be necessary for the applicant to resubmit these documents with the request for participation. The applicant may simply refer to these documents and indicate in the request for participation in the PPH program when these documents were previously filed in the U.S. application.

B. Special Examining Procedures

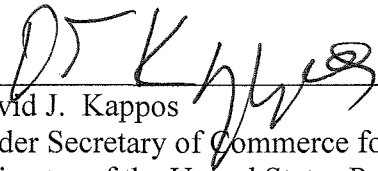
Once the request for participation in the PPH program and special status have been granted to the U.S. application, the U.S. application will be taken up for examination by the U.S. examiner before all other categories of applications except those clearly in condition for allowance, those with set time 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 program must sufficiently correspond to one or more allowable/patentable claims in the MX application(s). The applicant is required to submit a claims correspondence table along with the amendment (see A.(3) above). If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the MX application(s), the amendment will not be entered and will be treated as a non-responsive reply.

The PPH program does not absolve applicants of all their duties under 37 CFR 1.56 and 37 CFR 11.18. By complying with requirements A.(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 Bryan Lin, Office of PCT Legal Administration, at 571-272-3303, or via e-mail addressed to bryan.lin@uspto.gov.

Specific questions about the Patent Prosecution Highway should be directed to the Office of Petitions at 571-272-3282, or via e-mail addressed to PPHfeedback@uspto.gov.

Date: 7/16/12 

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office