

Patent Applicants often wish they could accelerate examination of their U.S. applications when corresponding patent claims have already been determined to meet the requirements for patentability elsewhere. On January 6, 2014, the United States Patent and Trademark Office (USPTO) launched a simplified Patent Prosecution Highway (PPH) pilot program under the designations “Global PPH” and “IP5 PPH”. The PPH program offers no-cost, accelerated examination for U.S. patent applications that correspond to applications already deemed allowable in participating foreign intellectual property offices. Essentially, under the PPH program, the USPTO has agreed that when an Applicant has already received allowance of at least one claim in a participating patent office (i.e., an Office of Earlier Examination, or OEE) in its capacity as a national or regional Office, International Searching Authority (ISA), or International Preliminary Examination Authority (IPEA), the Applicant can request accelerated examination of corresponding claim(s) in the USPTO (i.e., as an Office of Later Examination, or OLE), if certain conditions are met. The result is often a faster, more efficient examination process, at no additional cost to the Applicant.

To qualify for the PPH, the U.S. application for later examination must have the same earliest date (priority or filing) as the earlier-examined, allowed, corresponding application, and all claims in the U.S. application must sufficiently correspond (or be amended to sufficiently correspond) to the claims deemed allowable in the corresponding OEE application. Importantly, substantive examination of the U.S. application (i.e., in the OLE) must NOT have already begun.

To receive accelerated examination, the Applicant must file:

- (1) a request for participation in the Global / IP5 PPH pilot 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);
- (2) a claims correspondence table in English, indicating how and certifying that all the claims in the U.S. application correspond to allowable/patentable claims in the OEE application;

(3) a copy of the allowable claims and OEE work product relevant to allowability, including:

(A) the office action issued just prior to the “Decision to Grant a Patent” (e.g., the latest “Notification of Reasons for Refusal”) in the OEE national / regional application, along with an English translation thereof, if applicable; or

(B) the latest work product in the international phase of the OEE PCT application (e.g., the Written Opinion of the ISA or, where a demand under PCT Chapter II has been filed, the Written Opinion of the IPEA or the International Preliminary Examination Report), along with an English translation thereof, if applicable; and

(4) An information disclosure statement (IDS) listing the documents cited in the office action or PCT work product (submitted under item (3) above), along with copies of all documents except U.S. patents and U.S. patent application publications.

Requests that meet all eligibility requirements but do not properly include all required documentation are dismissed, and applicant is given one chance to fix it. However, action on the application is not suspended – so the clock is still ticking to beat the start of substantive Examination. Dismissed requests that are not properly corrected, as well as requests that do not meet all eligibility requirements are denied, and the application awaits action in its regular turn.

For additional information on PPH, please visit http://www.uspto.gov/patents/init_events/pph/ or contact the attorneys at Workman Nydegger.

Navigating the Patent Prosecution Highway from **Workman Nydegger**