

Revised Requirements for Requesting Participation in the Patent Prosecution Highway Pilot Program in the USPTO

On July 3, 2006, the United States Patent and Trademark Office (USPTO) commenced a Patent Prosecution Highway pilot program (PPH), which was scheduled to last for a period of one year ending on July 3, 2007, but extendible for an additional year to July 3, 2008. A notice entitled "Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Japan Patent Office" was published on June 13, 2006 at 1307 *Off. Gaz. Pat. Office* 61 providing the details of the PPH pilot program.

The requirements for requesting participation in the PPH pilot program were revised on January 30, 2007 to no longer require applicant to submit a copy of the "Decision to Grant a Patent" along with an English translation thereof. See notice entitled "Revised Requirements for Requesting Participation in the Patent Prosecution Highway Pilot Program in the USPTO" published at 1314 *Off. Gaz. Pat. Office* 1398 on January 30, 2007.

The USPTO and JPO recently agreed to a further modification of the pilot program to permit certain applications based on PCT filings to qualify for participation in the PPH pilot program. (The June 13, 2006 notice excluded any PCT applications). **Effective immediately**, where the USPTO is the Office of second filing (OSF), 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 validly claims priority under 35 U.S.C. 119(a)/365(b) to one or more applications filed in the JPO (Office of first filing) may be eligible to participate in the PPH pilot program. That is, (1) a national application must have been first filed in JPO (the JP national application must be (a) the priority application, or (b) another JP national application which validly claims domestic priority to the first JP national application, or (c) a divisional application of the first JP national application, or (d) a PCT application which enters national stage in the JPO which PCT application validly claims priority to the first JP national application); (2) the JP national application is examined and found to have one or more claims allowable by the JPO; (3) a PCT international application validly claiming priority to the JP national application is filed and enters the national stage in the U.S.; and (4) the claims in the national stage application sufficiently correspond to the allowable/patentable claims in the JP national application. That national stage application filed in the U.S. may be eligible to participate in the PPH pilot program provided all the other requirements identified in the two prior notices are satisfied.

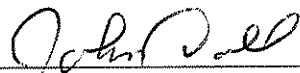
In addition, a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application validly claims priority under 35 U.S.C. 365(b) to one or more applications filed in the JPO (Office of first filing) may also be eligible to participate in the PPH pilot program. That is, (1) a national application must have been first filed in the JPO (the JP national application must be (a) the priority application, or (b) another JP national application which validly claims domestic priority to the first JP national application, or (c) a

divisional application of the first JP national application, or (d) a PCT application which enters national stage in the JPO which PCT application validly claims priority to the first JP national application); (2) the JP national application is examined and found to have one or more claims allowable by the JPO; (3) a PCT international application is filed validly claiming priority to the JP national application; (4) rather than entering national stage in the U.S. under the PCT, applicant files an application under 35 U.S.C. 111(a) (by-pass application) validly claiming benefit under 35 U.S.C. 120 to the PCT international application; and (5) the claims in the by-pass application sufficiently correspond to the allowable/patentable claims in the JP national application. The by-pass application may be eligible to participate in the PPH pilot program provided all the other requirements identified in the two prior notices are satisfied.

If the JP national application containing the allowable/patentable claims is a JP application which is other than the priority application (e.g., the JP national application with the allowable/patentable claims validly claims domestic priority to the first JP national application), applicant must indicate on the form, PTO/SB/20, "Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program between the JPO and the USPTO" how the JP national application with the allowable/patentable claims is related to the JP priority application. A copy of the form PTO/SB/20 is available at www.uspto.gov/web/forms/sb0020.pdf.

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: 5/12/12



John Doll
Commissioner for Patents