

## USPTO Announces PCT-Patent Prosecution Highway Pilot Program

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Effective January 29, 2010, the U.S. Patent and Trademark Office (USPTO) will allow applicants to petition to make a U.S. application special and, hence, examined sooner under the PCT-Patent Prosecution Highway (PPH) Pilot Program. This program will enable certain applicants to petition to make the U.S. application special if the applicant has received a

1. written opinion from an International Searching Authority (ISA)
2. written opinion from an International Preliminary Examining Authority (IPEA), or
3. an International Preliminary Examination Report (IPER) from an International Preliminary Examining Authority

indicating that at least one claim in a corresponding PCT application has novelty, inventive step, and industrial applicability. The ISA or IPEA must be either the USPTO, the European Patent Office, or the Japan Patent Office. An applicant cannot participate in the PCT-PPH pilot program on the basis of an International Search Report (ISR) only. Many types of U.S. applications, including those that claim priority to or are related to a PCT application, qualify for this program. To determine whether a particular U.S. nonprovisional application qualifies for this program, please consult the examples set forth in the official U.S. notices, links to which are provided below.

In the case in which an observation is described in Box VIII of the ISA, IPEA, or IPER, the applicant “must identify and explain why the claim(s) is/are not subject to any observation described in Box VIII irrespective of whether an amendment is submitted to correct the observation.” The USPTO warns that an application will not be eligible for this program if the “ap-

plicant does not identify and explain why the claim(s) is/are not subject to the observation.”

### OTHER REQUIREMENTS

- All claims in the U.S. application must sufficiently correspond to, or be amended to sufficiently correspond to, one or more of the claims indicated as having novelty, inventive step and industrial applicability and be free of any observation described in Box VIII. The USPTO has defined “sufficiently correspond” to mean that the claims are of the same or similar scope or narrower in scope than the PCT application. Claims with the narrower scope must be written in dependent form.
- Substantive examination of the U.S. application cannot have begun.
- The applicant must file a request for participation and a petition to make the U.S. application special under the PCT-PPH pilot program.
- The applicant must submit a copy of the latest ISA, IPEA, or IPER indicating that a claim has novelty, inventive step and industrial applicability and an English translation, if necessary (a statement that the English translation is accurate is not required).
- The applicant is required to submit a table in English demonstrating claim correspondence. The table must show how all the claims in the U.S. application sufficiently correspond to the claims indicated as novel and inventive and industrially applicable.

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- The applicant must submit an IDS listing the documents cited in the ISR, ISA, IPEA, and IPER, as well as copies of the documents.
- A request for participation in the PCT-PPH pilot program must be submitted to the USPTO via EFS-Web.
- Any amendments made after special status has been granted must sufficiently correspond to the claims indicating as having novelty, inventive step, and industrial applicability, or the amendment will not be entered.

If there are defects in the application, an applicant will be given one opportunity to perfect the request. Special status is specific for the application in which it was granted and does not carry over to any continuing applications. Applicants should be aware that taking advantage of this pilot program may possibly decrease any patent term adjustment that would accrue due to the PTO's backlog. In cases in which the end of a patent's term is more valuable than the start of a patent's term, the advantages of this pilot program may be minimal.

The USPTO's notices regarding the program can be found here: [http://www.uspto.gov/patents/law/notices/pct\\_pph\\_jpo.pdf](http://www.uspto.gov/patents/law/notices/pct_pph_jpo.pdf) and [http://www.uspto.gov/patents/law/notices/pct\\_pph\\_epo.pdf](http://www.uspto.gov/patents/law/notices/pct_pph_epo.pdf).

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