

## NEWSSTAND

### USPTO Update: Intellectual Property Bulletin - Winter 2009

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#### Patent Prosecution Highway Program Commences Between U.S. and Europe

Effective September 29, 2008, the USPTO began a Patent Prosecution Highway (PPH) pilot program with the European Patent Office (EPO).

The new pilot program enables the USPTO to share search results in applications filed in both the U.S. and Europe, and follows similar programs with intellectual property offices in Japan, the United Kingdom, Canada, Korea, and Australia. The purpose is to allow applicants whose claims are determined to be allowable in a first office to have a second office use the search and examination results, and accelerate consideration in the second office.

For example, assume that an application filed in the USPTO claims priority to an earlier EPO application, and the EPO application includes at least one allowable claim. In such a case, the applicant may ask to participate in the PPH pilot program in the USPTO, and petition to make the U.S. application special under the PPH pilot program. If the petition is granted by the USPTO, it will advance the U.S. application out of turn, and it will use the search and examination results from the EPO application during the examination of the U.S. application.

To be eligible to participate in the PPH pilot program, the U.S. application must be a Paris Convention application that claims priority to one or more applications already filed in the EPO. (The PPH pilot program is not available for PCT international applications (including U.S. National Phase applications filed under 35 USC 371).) The underlying EPO application must have at least one allowable claim, as indicated in an EPO Office Action or in a positive Extended European Search Report. Further, all of the claims in the U.S. application must correspond or be amended to correspond to claims in the EPO application. Differences in claim format are acceptable, assuming the claims are of the same or similar scope. A claims correspondence table in English is required.

To participate in the PPH pilot program, the applicant must file the appropriate request form, available on the PTO's web site. If the PTO has already begun to examine the U.S. application before the request is filed, the application is not eligible to participate in the PPH pilot program. Additionally, the applicant must provide copies of all Office Actions issued in the corresponding EPO application, and submit an information disclosure statement (IDS) listing all documents cited by the EPO examiner.

If the request for participation and special status is granted, then the applicant will be notified, and the U.S. application will be advanced out of turn for examination.

The PPH pilot program may be particularly useful for applicants in the USPTO that are looking for a less stringent and costly way of expediting the examination process than the USPTO's existing accelerated examination procedure.

More information is available on the USPTO website at: [www.uspto.gov/web/patents/pph/pph\\_epo.html](http://www.uspto.gov/web/patents/pph/pph_epo.html).

## **USPTO Enters Agreement with Australia as International Searching Authority**

Effective November 1, 2008, IP Australia (IPAU) is available to act as both International Searching Authority (ISA) and International Preliminary Examination Authority (IPEA) for most international applications filed with the USPTO under the Patent Cooperation Treaty (PCT).

Applicants who select Australia as the ISA will pay a search fee of US\$1514, which is less than the current USPTO search fee of US\$1800. Other available searching authorities for U.S. applicants are the EPO (current fee is US\$2665) and the Korean Intellectual Property Office (current fee is US\$244).

## **New Rule Issued for Patent Appeals**

On June 10, 2008, the U.S. Patent and Trademark Office (USPTO) issued a final rule for conducting *ex parte* appeals before the Board of Patent Appeals and Interferences.

The final rule applies to patent appeals in which the appeal brief is filed on or after December 10, 2008. Although briefing will be simpler in some respects, the final rule includes new procedural and substantive requirements that are likely to increase the complexity of drafting appeal and reply briefs. Under the final rule, appeal briefs are limited to 30 pages, and reply briefs to 20 pages, not including the appendix and certain mandatory sections. Formerly, no such page limits existed.

The final rule also eliminates the "summary of the invention" section. The USPTO had formerly required a separate explanation of each independent claim in the "summary of the invention" section, but had not always applied that requirement consistently. In place of the "summary of the invention" section, the new rule requires an appendix that includes: (i) a claims and drawing analysis; and (ii) a means- or step-plus-function analysis. The claims and drawing analysis must list each limitation of each independent claim, as well as each separately-argued dependent claim, and identify support in the specification for each limitation.

The final rule also mandates a statement of facts and an argument section. In the "statement of facts," material facts relevant to the rejections on appeal must be "set out in an objective and non-argumentative manner." The "argument" section should explain, for each ground of the examiner's rejection, how the examiner erred. This section must identify every point of disagreement with the examiner; points not so identified are considered waived. The appellant must also identify when each argument was initially made during prosecution, and disclose each new argument that is being made.

Under the final rule, the examiner's answer cannot include a new ground of rejection. According to the USPTO, whether a particular rejection constitutes a "new ground of rejection" will be evaluated on a case-by-case basis. Essentially the examiner is not permitted to make any rejection having a "basic thrust" different than that of a previous rejection.

The appellant may submit a single reply brief in response to the examiner's answer, which must contain appropriate headings and sections similar to those required in the appeal brief; under current practice, no such structure is required.

According to the USPTO, the purpose of the final rule is to speed up the *ex parte* appeals process, and "avoid unnecessary returns to examiners." While the final rule may accomplish the goal of advancing the appeals process, it will likely increase the time and effort required by appellants to prepare appeal and reply briefs.