

USPTO Implements PPH 2.0 Upgrade

By Donald Zuhn -- February 22, 2012



Earlier this month, the U.S. Patent and Trademark Office [announced](#) that the Office and eight other patent offices had agreed to implement an enhanced Patent Prosecution Highway (PPH) pilot program. The new pilot builds off an enhanced PPH framework that went into effect in July (see "[USPTO Expands Patent Prosecution Highway](#)").

The enhanced PPH pilot program implemented last summer has been called [PPH MOTTAINAI](#), for the Japanese term meaning "a sense of regret concerning waste when the intrinsic value of an object or resource is not properly utilized." Under the PPH MOTTAINAI pilot program, eight patent offices -- the USPTO, Canadian Intellectual Property Office (CIPO), Japan Patent Office (JPO), IPAustralia, National Board of Patents and Registration of Finland (NBPR), Federal Service on Intellectual Property, Patents & Trademarks of Russia (Rospatent), Spanish Patent and Trademark Office (SPTO), and United Kingdom Intellectual Property Office (UKIPO) -- implemented enhanced PPH programs in which the requirements for participation were modified to make the programs easier to use and more widely available to a greater number of applicants. In particular, participation in the PPH MOTTAINAI program could be requested on the basis of results available on any patent family member from any office participating in the pilot, regardless of whether it was the office where the priority application was filed. In addition, the enhanced program utilized a new definition of claim correspondence, which the USPTO indicated would make the system more flexible and user-friendly without compromising efficiency or quality.

Under the new version of the PPH MOTTAINAI program, which is being called PPH 2.0, the European Patent Office (EPO) has joined the original MOTTAINAI offices, bringing the total number of participating offices to nine. The PPH 2.0 program, which commenced on January 29, will run until January 28, 2013 (although the program could be extended for one additional year, if needed, or terminated early if, for example, the volume of participation were to exceed a manageable level).

In order to participate in the PPH 2.0 program in the USPTO, applicants must satisfy the following requirements:

1. One of the other PPH 2.0 participating offices has determined that at least one claim is allowable/patentable (under the PPH 2.0 program, applicants no longer need to submit a copy of the allowed claim or any English translation thereof).
2. The application before the PPH 2.0 participating office (*i.e.*, containing the allowable/patentable claim) and the U.S. application for which participation in the PPH 2.0 program is being requested must have the same priority/filing date (the Annex to the USPTO's notice on the PPH 2.0 program provides fifteen schematics outlining situations in which this requirement would be satisfied).

3. All claims on file, as originally filed, or as amended in the U.S. application must sufficiently correspond to one or more of the claims indicated as allowable in the application filed in the PPH 2.0 participating office (the USPTO notice states that "[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 PPH 2.0 participating office"). Under the PPH 2.0 program, applicants must submit a claims correspondence table (in English), indicating how all the claims in the U.S. application correspond to the allowable/patentable claims in the application filed in the PPH 2.0 participating office.
4. Examination of the U.S. application for which participation in the PPH 2.0 program is being requested has not yet begun.
5. The applicant has filed a request to participate in the PPH 2.0 program.
6. The applicant must submit a copy of the office action issued just prior to the "Decision to Grant a Patent" (along with an English translation, which may be a machine translation) for the application before the PPH 2.0 participating office (under the PPH 2.0 program, applicants no longer need to submit a statement that the English translation is accurate).
7. The applicant must submit an information disclosure statement listing all documents cited in the office action of the PPH 2.0 participating office.
8. All of the documents described above must be filed via the EFS-Web and indexed using the document description: "Petition to make special under Patent Pros Hwy."

Additional information regarding the enhanced framework may be found [here](#).

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