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Jeremy Harrison, a partner in the Houston office, and Thomas Thrash, a patent agent in the Houston office, co-authored an article for *IP Law360* Titled "Effective Utilization Of The Patent Prosecution Highway."

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Effective Utilization Of The Patent Prosecution Highway

The U.S. Patent and Trademark Office offers various programs for tailoring the patenting process, including several accelerated examination options. One accelerated examination option that may be desirable for some applicants is the Patent Prosecution Highway (PPH), an examination work-sharing program between several national and regional patent offices, including the USPTO. Amendment practice in PPH applications before the USPTO does not always follow typical patent prosecution practice, and, to complicate this issue further, USPTO guidance with respect to PPH amendments is not consistently applied by all examiners.

PPH Background

PPH participation in the USPTO is by way of petition and does not require a fee. PPH participation requires favorable examination of a corresponding patent application reported by a PPH-member patent office. More specifically, once a PPH-member Office of Earlier Examination (OEE) reports favorable examination results (e.g., allowability) for at least one claim in a pending patent application, a corresponding patent application in a PPH-member Office of Later Examination (OLE) may qualify for PPH examination.

Entrance into the PPH advances a patent application out of its ordinary examination position in the OLE, thereby shortening the timeline for receiving a first action on the merits. After receipt of a first action,

prosecution of a PPH application continues thereafter under standard deadlines. While PPH participation does not guarantee an allowance or shortened prosecution pendency in every case, PPH applications on average enjoy higher allowance rates and shorter pendency in comparison to non-PPH applications.

A grantable PPH petition requires that the corresponding applications in the OEE and the OLE share a common earliest priority date and that the OLE claims “sufficiently correspond” to the favorably reviewed OEE claims. To demonstrate sufficient correspondence of the claims, a correspondence chart must be submitted to show how the OLE claims and the favorably reviewed OEE claims relate, and any differences must be explained. Differences in claim format due to translation issues and other informalities are allowed, provided that the fundamental substance mirrors that of the OEE claims.

If needed, an applicant can amend the OLE claims to achieve sufficient correspondence with the favorably reviewed OEE claims. Narrowing amendments to achieve sufficient correspondence are acceptable under certain circumstances, but broadening amendments are prohibited. If broader claim scope is desired, PPH participation is not a feasible option, and such claims (and any claims otherwise ineligible for PPH participation) can instead be filed and examined in a nonexpedited corresponding application.

PPH Applications in the USPTO

Even when the U.S. claims sufficiently correspond to the favorably reviewed OEE claims, additional patentability issues may still be identified by the USPTO. The prior art identified by the OEE provides a good head start for U.S. examination, although U.S. examiners frequently identify additional relevant prior art that was not considered by the OEE. Should a U.S. examiner reject the claims based upon previously cited and/or newly located prior art, such rejections must be addressed by way of argument or amendment to secure an allowance.

If arguments and/or minor clarifying claim amendments fail to overcome an outstanding rejection in a PPH application in the USPTO, an applicant may be required to narrow the claim scope via an amendment. Amending the claims in a PPH application in the USPTO can be tricky, however, as the amendment process does not always follow typical patent prosecution practice. To make matters worse, the USPTO has provided scant guidance on this subject.

A 2014 USPTO notice published in the Official Gazette offers PPH practice protocols that continue to date and represent one of the few sources of guidance for amending the claims in a PPH application before the USPTO. According to the notice, “[a]ny claims amended or added after the grant of the request for participation in the [PPH] must sufficiently correspond to one or more allowable/patentable claims in the OEE application.”^[1] In other words, sufficient claim correspondence between the USPTO claims and the OEE claims must be maintained not only at the time of PPH entry, but also when amending claims during prosecution of a PPH application.

In practice, many U.S. examiners do not steadfastly follow the foregoing protocol when examining PPH applications. Nevertheless, failure to maintain sufficient claim correspondence through proper presentation of narrowing claim amendments can be considered nonresponsive in the USPTO’s view, which can trigger issuance of a notice of noncompliant amendment.

One common type of narrowing amendment incorporates the limitations of an existing dependent claim directly into a higher-order claim. In a USPTO PPH application, such an amendment meets the sufficient claim correspondence stipulations stated in the notice above, provided the dependent claim was favorably reviewed by the OEE.

Another common type of narrowing amendment comprises amending the claims to incorporate subject matter from the specification that was not initially included in the claims. Unlike non-PPH applications, the independent claims of a USPTO PPH application cannot directly incorporate a narrowing amendment from the specification without technically violating the stipulations provided in the notice. Even if the amendment is otherwise properly narrowing, such an amendment does not maintain sufficient correspondence with the OEE claims. Although relatively rare, the USPTO can issue a notice of noncompliant amendment when attempting to amend the claims in this manner.

To incorporate subject matter properly from the specification into the claims of a PPH application, an applicant is required to follow a process only briefly alluded to in the notice. More particularly, the notice provides that “[a] claim in the U.S. application that is narrower in scope than the claims indicated as allowable/patentable in the OEE application will sufficiently correspond if presented as a claim dependent upon a claim that is of the same or similar scope as a claim indicated as allowable/patentable in the OEE application.” The USPTO interprets this provision to prohibit direct amendment of an independent claim with subject matter derived solely from the specification (e.g., not initially included in the claims), which necessitates a burdensome two-step amendment process.

Subject matter derived solely from the specification can be introduced to the claims of a PPH application by adding a new dependent claim to the claim set via a first office action response. To maintain sufficient claim correspondence, the new dependent claim must depend from a favorably reviewed OEE claim. If later found allowable, the narrowing subject matter of the new dependent claim may be subsequently incorporated into the corresponding independent claim via a second office action response, thereby rendering the independent claim and its other dependent claims allowable for the same reasons.

If the new dependent claim is presented in a first office action response, a bona fide patentability argument for the associated independent claim must be made without reference to the narrowing limitations of the new dependent claim. If it is absolutely impossible to make such an argument, a continuation application with the desired claim amendments may be filed instead, thereby exiting the PPH process.

The required two-step process for amending the claims in PPH applications is a potential downside of PPH participation. Namely, to properly incorporate potentially allowable subject matter from the specification and simultaneously maintain sufficient claim correspondence, an applicant is required to draft and file two office action responses. It appears many examiners disregard (or are entirely unaware of) this two-step amendment process, potentially seeing it as unnecessary since the same amended claim language inevitably results, whether following a one-step or two-step amendment process. When enforced, however, this burdensome process inherently slows prosecution timelines and increases cost, as compared to non-PPH applications.

Practice Tip

One way to avoid the foregoing two-step process is to take proactive steps prior to receiving an action on the merits. Specifically, additional dependent claims may be introduced defensively to a USPTO PPH application via a preliminary amendment prior to substantive examination. Such added claims maintain sufficient claim correspondence by depending from a favorably reviewed OEE claim. The added claims will then be available for directly amending the OEE claims, if necessary, to address new grounds of rejection.

While one cannot possibly envision all rejections a U.S. examiner might feasibly make in a given circumstance, proactively added dependent claims can often be strategically chosen based upon an applicant's knowledge of the state of the art and foresight of particular limiting features the applicant is willing accept. While added dependent claims may result in excess claim fees, this is not always the case. For example, many applications are drafted to contain around 20 initial claims, and with claim cancellation frequently being needed to bring the U.S. claims into sufficient correspondence with the favorably reviewed OEE claims, excess claim fees, if any, may be mitigated or avoided altogether.

Accordingly, there is a risk-reward calculus associated with PPH participation in the USPTO. If an accelerated U.S. allowance is an overriding goal, PPH participation can indeed be an attractive examination option. Most effective PPH utilization does not occur autonomously, and proactive management of PPH applications prior to substantive examination may be desirable in many instances.