

Should You Get On The Patent Prosecution Highway?

By **Jeremy Kriegel** (July 21, 2023)

Due to limits the U.S. Patent and Trademark Office's implementation of the Patent Prosecution Highway program places on patent applicants' options when amending claims during examination, patent applicants should carefully consider whether the PPH is the most appropriate vehicle for accelerating examination of their U.S. applications that have been allowed elsewhere.



Jeremy Kriegel

The only permitted claim amendments are those that still sufficiently correspond in scope to the allowable claims of an earlier-examined application which served as the basis for the PPH program request, and once a PPH request is granted, there is no opportunity to withdraw a U.S. patent application from the PPH program — short of filing a continuing application.

The PPH is a procedural avenue available to patent applicants to accelerate examination of utility patent applications.

The PPH invites applicants who have received allowable claims in a corresponding patent application in a jurisdiction with which the U.S. shares a reciprocal PPH program to amend the claims of a new or pending U.S. application to correspond in scope to allowed claims of the corresponding application. There is no USPTO fee to file a PPH request.

The USPTO can be rather strict on the formalities of a PPH application, which require the applicant to provide an explanation regarding how the claims of the U.S. application correspond to allowable or granted claims of the corresponding application, make a certified statement that the claims sufficiently correspond, and file an information disclosure statement identifying all prior art considered in the corresponding application on which the PPH request is based.

While the USPTO examiner need not give full faith and credit to the favorable treatment previously accorded by the examiner in the corresponding application the Office of Earlier Examination, or OEE, once the PPH request is granted, the U.S. application will receive special status, advancing the case on the patent examiner's docket, effectively accelerating examination.

While the PPH program seems an attractive route, applicants and their counsel may want to tell their USPTO navigation systems not to ignore toll roads, and instead consider alternative procedures for requesting accelerated examination, such as a request for prioritized examination.

This is commonly referred to as the Track One program, which provides similar benefits to the PPH, but for a hefty fee — currently \$4,200 for large entities, \$1,680 for small entities, and \$840 for micro entities, and may only be requested at the time of initial filing or upon filing of a request for continued examination — or a petition to make special due to circumstances such as the age or health of the inventor, or inventions that will materially: (1) enhance the quality of the environment; (2) contribute to the development or conservation of energy resources; or (3) contribute to countering terrorism.

Another option for accelerating applications is the petition to make special under accelerated examination 708.02(a), which has a lower fee than the Track One program, but much more onerous procedural requirements.

This petition includes the preparation of an accelerated examination support document requiring a statement that a preexamination search was conducted including U.S. patents and published applications, foreign patent documents, and nonpatent literature, as well as a detailed explanation of how each of the claims is patentable over each reference deemed most closely related to the subject matter of each of the claims.

Since the less-burdensome Track One program launched in 2011, few applicants utilize the accelerated examination option.

Periodically, the USPTO introduces pilot programs that offer alternatives to shortening the time to a first office action on the merits, such as:

- The Climate Change Mitigation Program is for patent applications with "claims to a product or process that mitigates climate change by being designed to: (a) remove greenhouse gases already present in the atmosphere; (b) reduce and/or prevent additional greenhouse gas emissions; and/or (c) monitor, track, and/or verify greenhouse gas emission reductions." This program was recently expanded "to include innovations in any economic sector that are designed to make progress toward achieving net-zero greenhouse gas emissions," and extended to June 7, 2027, unless a cap of 4,000 granted petitions to participate in the program is met sooner.
- The First Time Filer Expedited Examination Pilot Program requires that no inventors named in an application were named as an inventor in any previously filed nonprovisional U.S. patent application. New applications filed with a petition to make special under this pilot program must also be filed in .DOCX format. This program is available until March 11, 2024, unless a cap of 1,000 granted petitions to participate in the program is met sooner.

Once an application is accelerated based on a Patent Prosecution Highway request, the applicant's options for amending claims are more limited than if a patent application is made special — i.e., its examination is fast-tracked — on a different basis.

In accordance with a February 2014 notice from the USPTO's then-Deputy Director Michelle K. Lee, every time an amendment is made in a U.S. patent application in which a request for accelerated examination under the PPH program was approved, the applicant must certify the amended claims still correspond in scope to the allowed claims of the corresponding application on which the PPH request was based, even if newly cited prior art arises that may make claim amendments which would result in claims diverging in scope from those previously allowed claims desirable:

Any claims amended or added after the grant of the request for participation in the Global/IP5 PPH pilot program must sufficiently correspond to one or more allowable/patentable claims in the OEE application. The applicant is required to submit, along with the amendment, a statement certifying that the amended or newly added claims sufficiently correspond to the allowable/patentable claims in the

OEE application. If the certification statement is omitted, the amendment will not be entered and will be treated as a non-responsive reply.[1]

The PPH notice indicates that U.S. claims are considered to sufficiently correspond in scope with the claims of the corresponding application on which the PPH request was based if the U.S. claims are narrower in scope than the allowed claims, provided that the additional limitation that makes the U.S. claims narrower in scope is presented in dependent claims.

In order to amend an independent claim to narrow its scope by incorporating a narrower dependent claim into an independent claim, the dependent claim must have been indicated as having allowable subject matter and objected to only because of its dependence on a rejected base claim.[2]

The failure to provide a statement certifying that the amended — or any newly added — claims of an amendment sufficiently correspond to allowable claims of an OEE application may result in a notice of noncompliant amendment, and if not remedied, could result in abandonment of the U.S. patent application.

Once an application attains special status under the PPH program, it is not possible to withdraw from the program; The only alternative appears to be filing a continuing application, such as a continuation or a divisional, without a PPH request.[3]

In other words, an office action rejecting on the merits all allowable claims of an OEE application on which the PPH application was based, which rejections cannot be overcome by arguments alone, is likely a dead end for an application on the patent prosecution highway — the only available turnaround being in the form of a continuing application requiring a new set of filing, search and examination fees, and potential additional costs to continue accelerated examination, if desired, through a Track One request or other applicable program.

Depending on the procedural mechanism used as the basis to accelerate examination, the applicant may not be able to take extensions of time without the application reverting to the examiner's regular, nonaccelerated docket.

Applicants whose applications are accelerated on the basis of PPH requests can still file petitions for extensions of time under Title 37 of the Code of Federal Regulations, Section 1.136(a) to respond to office actions.[4]

While taking an extension of time might offer an option to effectively withdraw from other accelerated examination programs, an extension of time would not provide an exit ramp from the PPH program.

As of June 30, the USPTO received a total of 86,939 petitions to expedite examination of U.S. patent applications under the PPH program, of which 77,633 were granted.

Based on the constraints under which applicants must proceed with respect to amendments in applications in the PPH program, applicants receiving allowable claims in corresponding patent applications outside the U.S. might want to pump the breaks before taking the PPH on-ramp, as they may encounter new prior art during the U.S. examination and find themselves stuck in an express lane without an efficient mechanism to pull over.

Jeremy Kriegel is a partner and chair of the design patents practice at Marshall Gerstein & Borun LLP.

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[1] Implementation of the Global and IP5 Patent Prosecution Highway (PPH) Pilot Programs with Participating Offices (February 10, 2014). <https://www.uspto.gov/sites/default/files/documents/global-ip5.pdf>.

[2] Frequently Asked Questions, revised May 3, 2023, page 11, response to Question No. 34 ("If the narrower dependent claim is indicated as being allowable if written in independent form, you may rewrite the allowable dependent claim in independent form."). <https://www.uspto.gov/sites/default/files/documents/FAQs-for-PPH-revised-05032023.pdf>.

[3] *Id.*, page 9, response to Question No. 24 ("Once a PPH request has been granted, the application is accorded special status which is retained throughout the prosecution of the application. If participation in the PPH program is no longer desired, applicant may wish to consider filing a continuing application.").

[4] *Id.*, page 11, response to Question No. 37 (Yes. You may obtain extensions of time under 37 CFR 1.136(a) during prosecution of the U.S. application accepted in the PPH program."); Cf. MPEP 708.02(a)(VIII)(E) (9th Ed., Rev .7) ("There is no provision for "withdrawal" from special status under the accelerated examination program. However, filing a petition for extension of time will result in the application being taken out of the accelerated examination program.").