



17 January 2013

OFFICE ORDER NO. 13<sup>TH</sup> - 10  
Series of 2013

**Subject: AMENDMENT ON IPOP HL-USPTO PATENT PROSECUTION  
HIGHWAY 2.0 PROGRAM**

The Intellectual Property Office of the Philippines (IPOP HL) and the United States Patent and Trademark Office (USPTO) have agreed to implement an amended Patent Prosecution Highway Program and shall refer therein as PPH 2.0. Said PPH 2.0 shall take effect on January 29, 2013 up to January 28, 2014.


Applications to be prosecuted under PPH 2.0 shall be subject to the amended PPH 2.0 guidelines marked as Annex A herein.

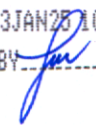
Applicants and agents who wish to avail of PPH 2.0 shall duly accomplish the Request Form attached herein as Annex B, and seasonably file the same.

Under the IPOP HL- USPTO PPH 2.0, IPOP HL applications with corresponding USPTO applications shall be given priority by means of an advanced-out-of-turn examination. Furthermore, USPTO work products shall serve as additional references for IPOP HL examiners.

All IPOP HL applications that were filed following the earlier PPH Agreement shall not be prejudiced and shall be accorded with PPH 2.0.

For guidance.

  
**Atty. RICARDO R. BLANCAFLOR**  
**Director General**

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## **Revised Requirements for the Implementation of the IPOPHL-USPTO PPH 2.0 Program**

### **I. Background**

Since July 15, 2011, the United States Patent and Trademark Office (USPTO) and seven other offices (i.e., IP Australia (IPAU), Canada (CIPO), Finland (NBPR), Japan (JPO), Russia (ROSPATENT), Spain (SPTO) and United Kingdom (UKIPO)) have participated in an enhanced PPH pilot program called "MOTTAINAI". Under MOTTAINAI, participation in the PPH may be requested on the basis of search and examination results from any patent family application from any participating office, regardless of whether the participating office was the office of first filing. To implement the MOTTAINAI pilot, the USPTO revised its PPH requirements. See for example the notice available at <http://www.uspto.gov/web/offices/com/sol/og/2011/week33/TOC.htm#ref13>.

On January 29, 2012, the USPTO implemented PPH 2.0 with respect to the seven MOTTAINAI participating offices along with the European Patent Office (EPO) in order to further enhance the PPH program and to encourage greater usage of, and participation in, the PPH program. PPH 2.0 simplifies the PPH requirements and procedures in a consolidated and user-friendly framework, while at the same time ensuring that work sharing benefits to the offices are not diminished.

The IPOPHL is implementing PPH 2.0 with respect to USPTO.

### **II. Trial Period for the PPH 2.0 Program**

The PPH 2.0 program will commence with respect to the USPTO on January 29, 2013 and will terminate on January 28, 2014. The trial period may be extended if necessary to adequately assess the feasibility of the PPH 2.0 program. The IPOPHL and the USPTO will evaluate the results of the PPH 2.0 program to determine whether and how the program should be implemented after the trial period. The offices may also terminate the PPH 2.0 program early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if the PPH 2.0 program will be terminated with respect to the USPTO before the January 28, 2014 date.



### III. Requirements for Requesting Participation in the PPH 2.0 Program in the IPOPHL

In order to be eligible to participate in the PPH 2.0 Pilot Program, the following conditions must be met:

- (1) The IPOPHIL application for which participation in the PPH program is requested and the corresponding USPTO application must have the same priority date.
  - i) An application that validly claims priority (ANNEX Figures A,B,C and D);
  - ii) An application which is the basis of a valid priority claim under the Paris Convention for the application filed with IPOPHIL (Annex Figures E, F and G);
  - iii) An application which shares a common priority document with the application files in IPOPHIL (Annex Figures H, I, J, K and L;
  - iv) IPOPHIL application derived from/ related to a PCT application having no priority claim (Annex Figure M).

Provisional applications, plant applications, design applications, reissue applications, re-examination proceedings and applications subject to a secrecy order are excluded and not subject to participation in the PPH 2.0.

- (2) At least one (1) claim was determined by USPTO to be allowable/ patentable. The applicant must submit a copy of the allowable/ patentable claims from the USPTO application. If the USPTO office action does not explicitly state that a particular claim is allowable, the applicant must include a statement in the request for participation in the PPH 2.0 program or in the transmittal letter accompanying the request for participation that no rejection has been made in the USPTO office action regarding that claim, and therefore, the claim is deemed to be allowable by the USPTO.
- (3) All claims on file, as originally- filed or as amended, for examination under PPH 2.0 must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the IPOPHIL are of the same or similar scope as the claims in the USPTO. In this regard, a claim that is narrower in scope occurs when a USPTO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). A claim in the IPOPHIL which introduces a new/different category of claims to those claims indicated as allowable in the USPTO is not considered to sufficiently correspond. For example, if the USPTO claims only contain claims to a process of manufacturing a product, then the claims in the IPOPHIL are not considered to sufficiently correspond if the IPOPHIL claims introduce product claims that are dependent on the corresponding process claims.

The additional limitation that makes the claims in the PH application narrower in scope than the allowable/patentable claims in the USPTO application must have support in the written description of the PH application and the additional limitation must be presented in dependent form. The applicant is required to submit a claims correspondence table. The claims correspondence table must indicate how all the claims in the PH application correspond to the allowable/patentable claims in the USPTO application/s. The dependent claims with the additional limitations must be clearly identified in the claims correspondence table.

- (4) Examination of the PH application for which participation in the PPH 2.0 program is requested has not begun.
- (5) The applicant must file a request for participation in the PPH 2.0 program and a request that the PH application be advanced out of turn for examination by order of the Director. *Provided*, That a Request for Early Publication pursuant to Rule 800.1 of the Implementing Rules and Regulations for Patents, as amended will be submitted for Direct Route applications. *Provided, further*, That this rule shall only apply to the first two- hundred (200) PPH applications annually which will be divided to one hundred (100) applications per semester to maintain manageable levels.



The maximum number of PPH applications to be considered shall be reviewed annually and may be modified based on the number of filings, number of examiners and etc.

- (6) The applicant must submit a copy of the office action from the USPTO application just prior to the "Decision to Grant a Patent" (e.g. the latest "Notification for Reasons for Refusal") from each of the USPTO application(s) containing the allowable/ patentable claims that are the basis for the request. It will not be necessary for applicant to submit a copy of the "Decision to Grant a Patent." If the USPTO application is a first action allowance, i.e., there is no office action just prior to the "Decision to Grant a Patent," then applicant should indicate on the request form that no office action from the USPTO application is submitted since the USPTO application was a first action allowance.

The applicant must submit copies of any office actions (which are relevant to patentability) from the USPTO application(s) issued after the grant of the request for participation in the PPH 2.0 program in the IPOPHIL (especially where USPTO might have reversed prior holding of allowability).

- (7) The applicant must submit an information disclosure statement (IDS) listing the documents cited by the USPTO examiner in the USPTO office action (unless such IDS has already been filed in the IPOPHIL application). The applicant must submit copies of all the documents cited in the USPTO office action (unless the copies have already been filed in the PH application) except PH patents or PH patent application publications.

The request for participation in the PPH 2.0 program and all the supporting documents must be submitted to the IPOPHIL.

Where the request for participation in the PPH 2.0 program and special status are granted, the applicant will be notified and the PH application will be advanced out of turn for examination. In those instances where the request for participation in the PPH program does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given one opportunity to perfect

the request in a renewed request for participation. Note that action on the application by the examiner will NOT be suspended awaiting a reply by the applicant to perfect the request in a renewed request for participation. That is, if the application is picked up for examination by the examiner after the applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, the request and special status will be granted, the applicant will be notified and the PH application will be advanced out of turn for examination. If not perfected, the applicant will be notified and the application will await action in its regular turn.

- (8) Request for participation in the PPH program and special status granted in a parent application will not carry over to divisional application(s). The applicant must fulfil all the conditions set forth above in order for special status to be granted in the divisional application.

The Manual for Substantive Examination Procedure, as amended, defines divisional application as a non- elected application which is not elected after a requirement for restriction and can be subject of a new application. Rule 604 (b) of the Implementing Rules and Regulations on Inventions, as amended further provides that a later application filed for an invention divided out shall be considered as having been filed on the same day as the first application.

If any of the documents identified in items (6) and (7) above have already been filed in the PH application prior to the request for participation in the PPH program, it will not be necessary for the applicant to resubmit these documents with the request for participation. The applicant may simply refer to these documents and indicate in the request for participation in the PPH program when these documents were previously filed in the PPH application.



#### IV. Special Examining Procedures

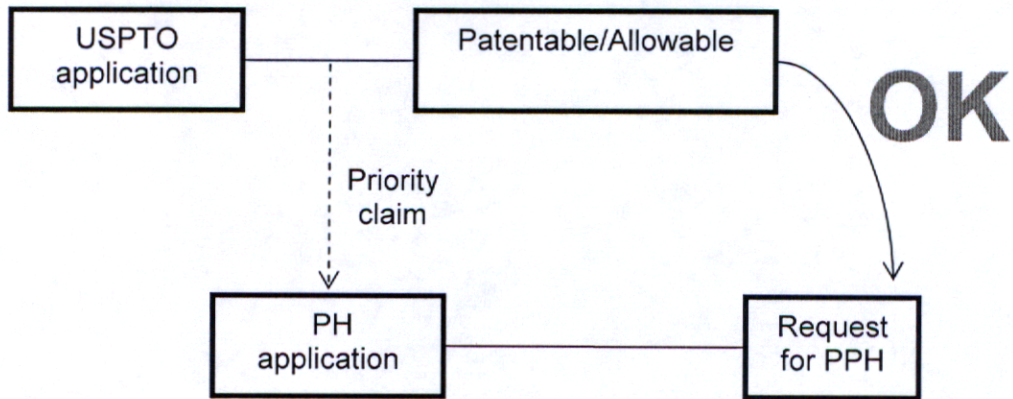
Once the request for participation in the PPH program and special status have been granted to the PH application, the PH application will be taken up for examination by the PH examiner before all categories of application except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination." *Provided*, That such applications make it to the first one hundred (100) PPH applications per semester.

Any claims amended or added after the grant of the request for participation in the PPH program must sufficiently correspond to one or more allowable/patentable claims in the USPTO application(s). The applicant is required to submit a claims correspondence table along with the amendment. If the amended or newly- added claims do not sufficiently correspond to the allowable/patentable claims in the USPTO application(s), the amendment will not be entered and will be treated as a non- responsive reply.

ANNEX

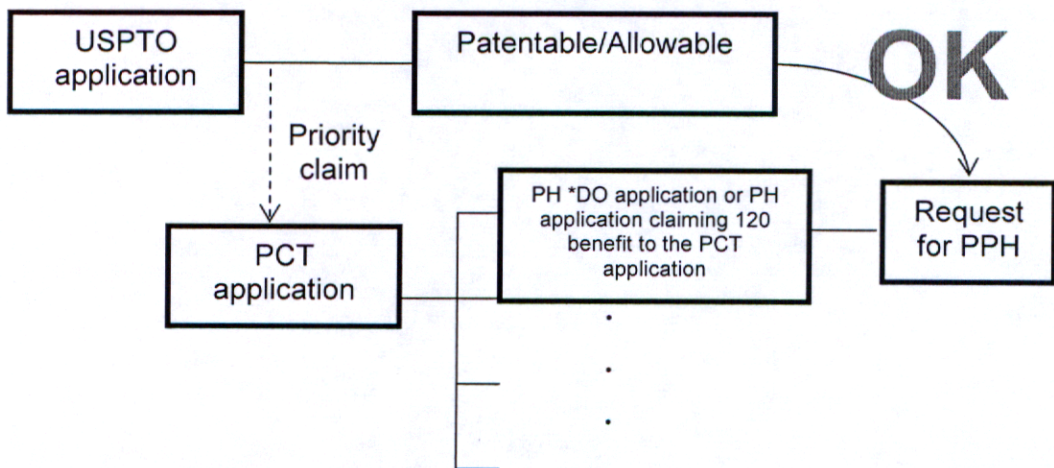
A

(Case I)  
- Paris route -



B

(Case I)  
- PCT route -

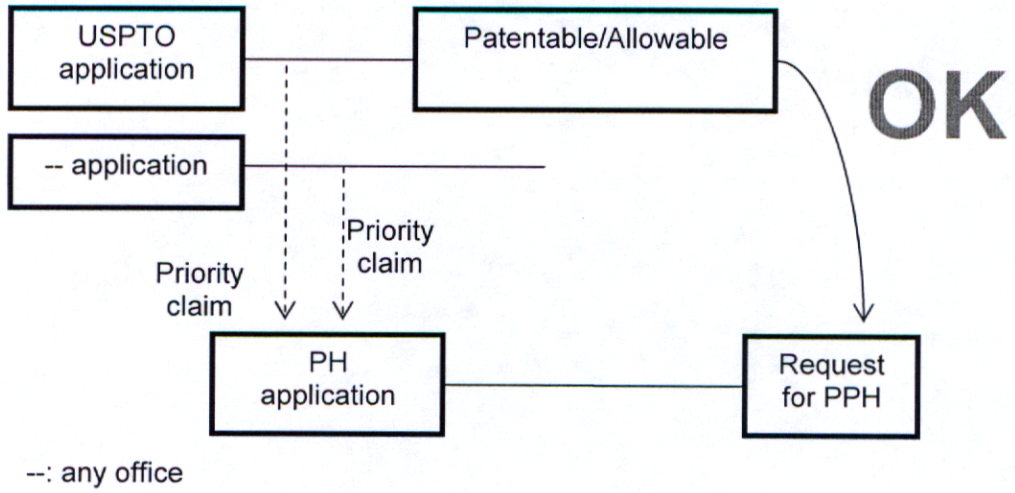


\*DO – designated office



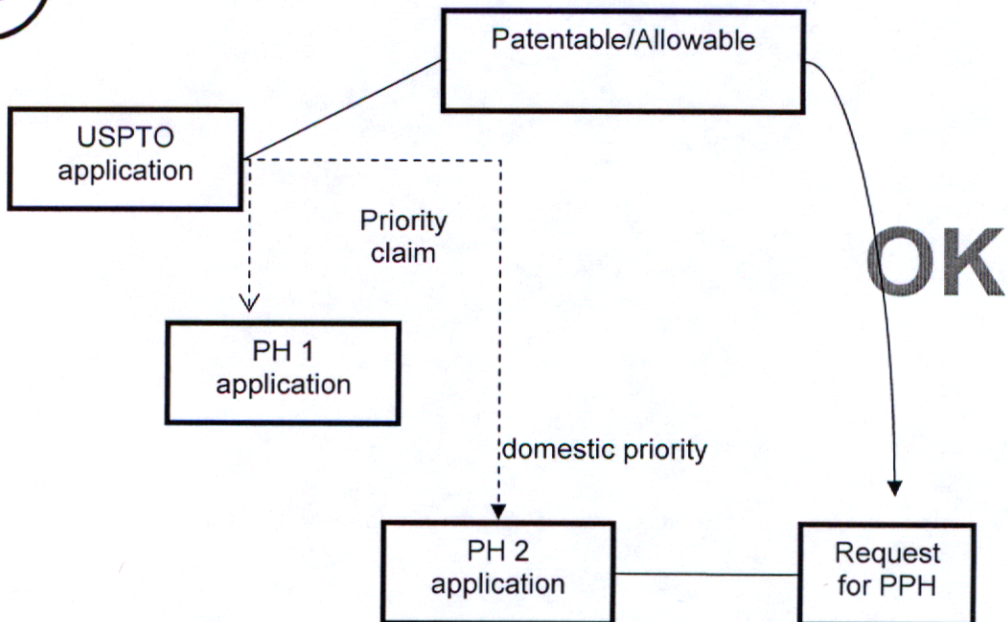
C

(Case I)  
- Paris route & Complex priority -



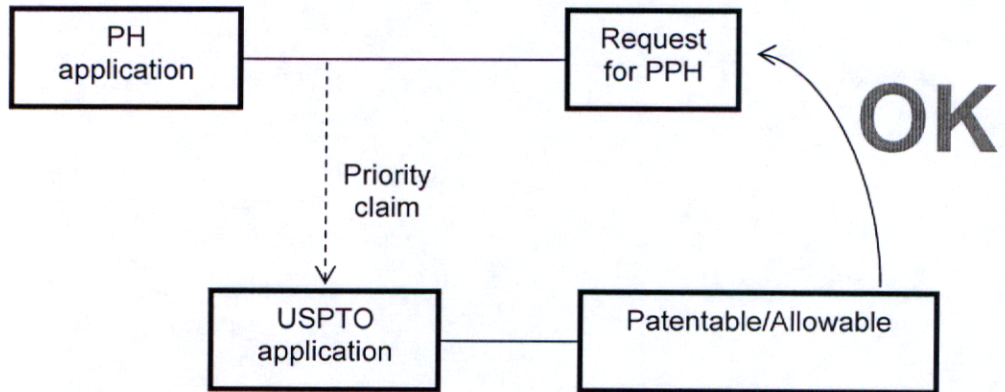
D

(Case I)  
- Paris route & divisional application ==



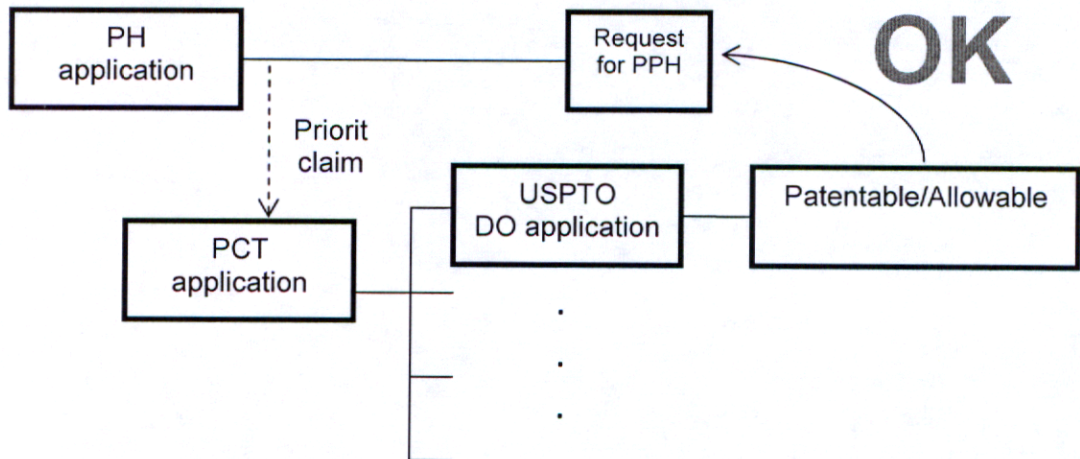
(E)

(Case II)  
- Paris route -



(F)

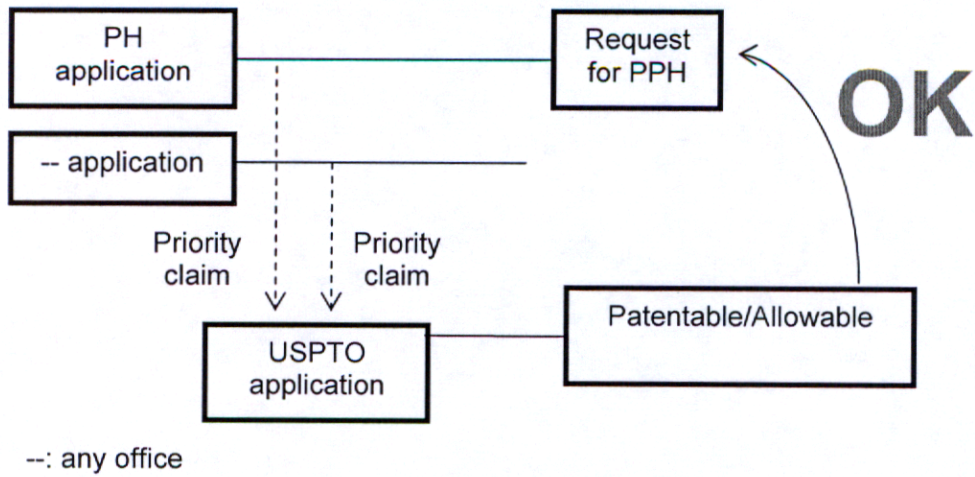
(Case II)  
- PCT route -





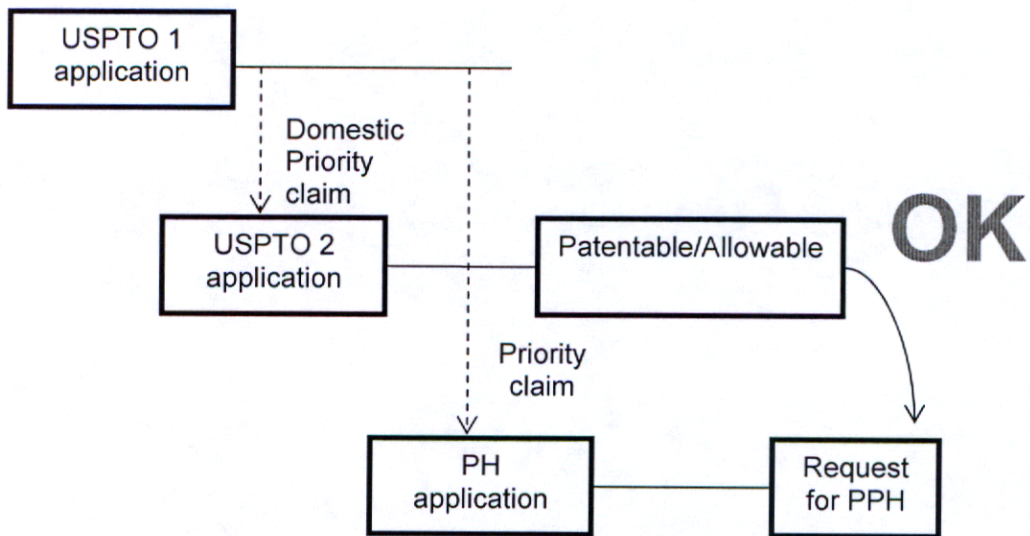
G

(Case II)  
- Paris route & Complex priority -



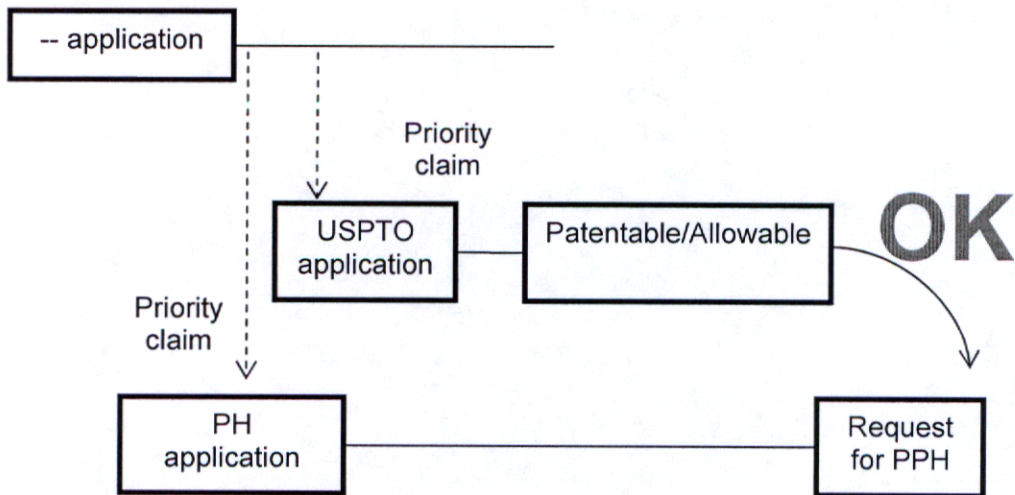
H

(Case III)  
- Paris route, Domestic priority -



(Case III)

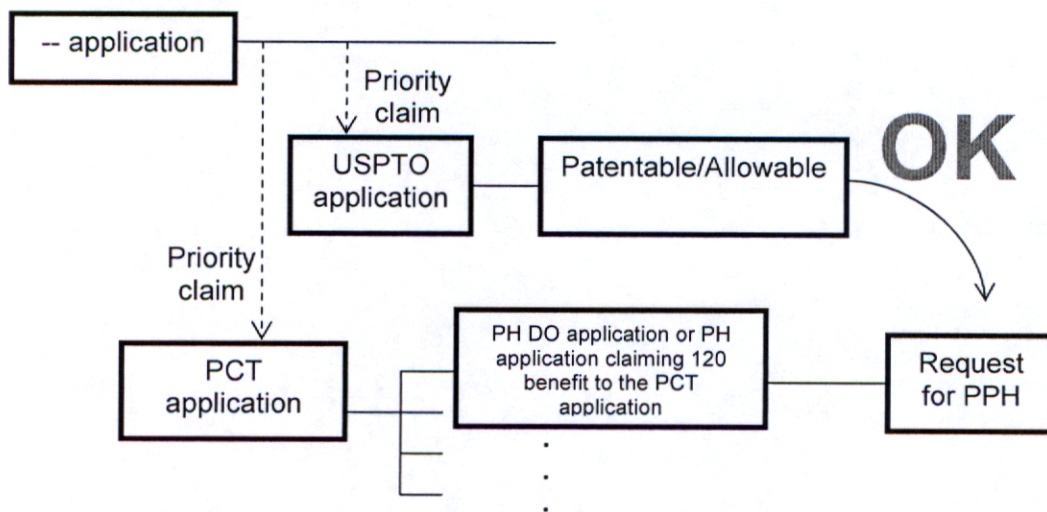
I - Paris route, but the first application is from the third country -



--: an office other than the JPO and the USPTO

(Case III)

J - PCT route, but the first application is from the third country -

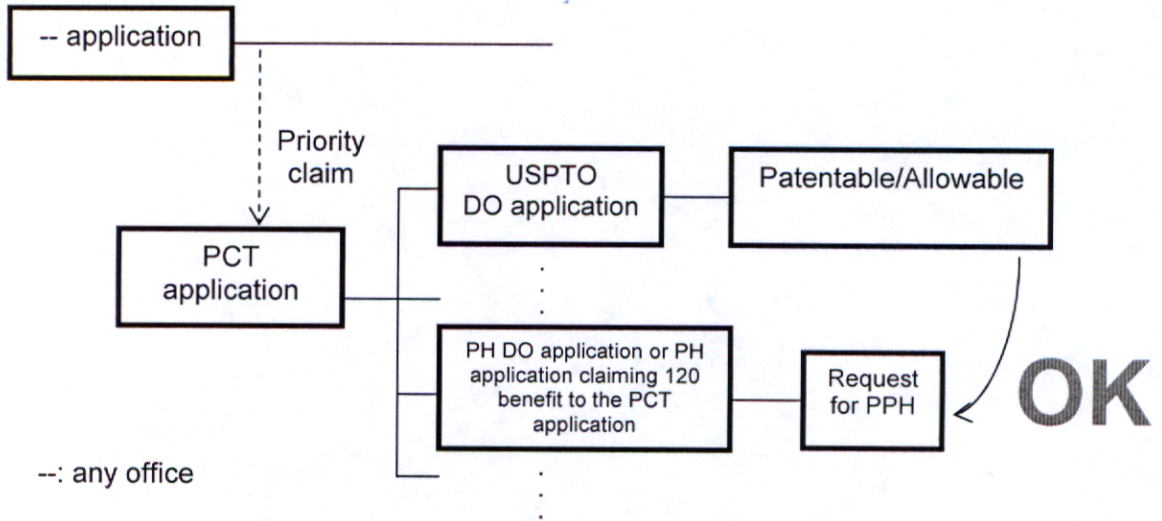


--: an office other than the JPO and the USPTO



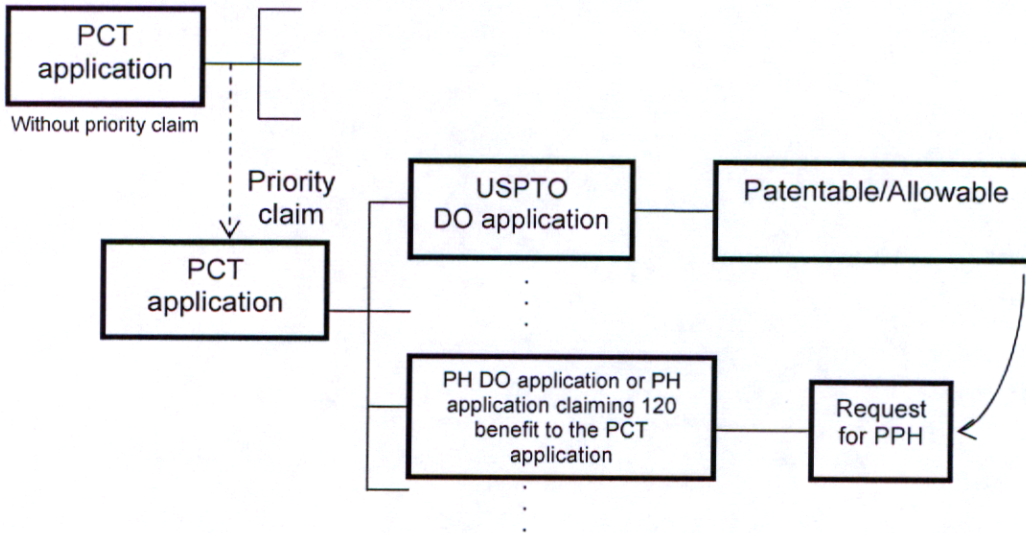
K

(Case III)  
- PCT route -



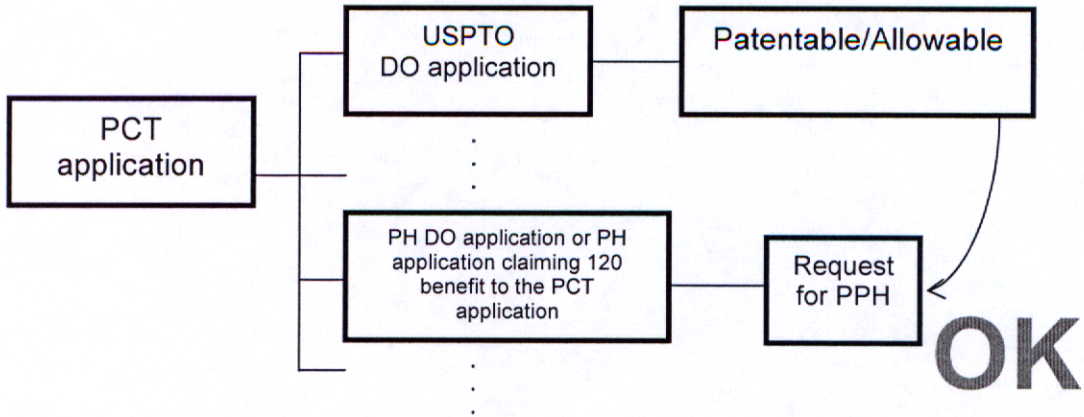
L

(Case III)  
- Direct PCT & PCT route -



M

(Case IV)  
- Direct PCT route -





**USPTO- IPOPHL PATENT PROSECUTION HIGHWAY (PPH) REQUEST FORM**

<b>APPLICATION NO.</b>	
<b>TITLE OF THE INVENTION</b>	
<b>APPLICANT</b>	
<b>CORRESPONDING USPTO APPLICATION NO.</b>	
<b>DOCUMENTS SUBMITTED</b>	<ul style="list-style-type: none"> <li>○ Copies of all office actions</li> <li>○ Copies of all claims determined to be patentable/ allowable by the USPTO</li> <li>○ Information Disclosure Statement (IDS)</li> <li>○ Claim Correspondence Table</li> <li>○ Request for an Advanced-out-of-turn Examination</li> </ul>
<b>SIGNATURE/ DATE</b>	
<i>For authorized receiving officer of IPOPHL only</i>	
<b>RECEIVING OFFICER</b>	
<b>DATE RECEIVED</b>	





**USPTO- IPOPHL PCT- PATENT PROSECUTION HIGHWAY (PPH) REQUEST FORM**


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<b>APPLICATION NO.</b>	
<b>TITLE OF THE INVENTION</b>	
<b>APPLICANT</b>	
<b>CORRESPONDING USPTO APPLICATION NO.</b>	
<b>DOCUMENTS SUBMITTED</b>	<ul style="list-style-type: none"> <li>○ Copies of all office actions</li> <li>○ Copies of all claims determined to be patentable/ allowable by the USPTO</li> <li>○ Information Disclosure Statement (IDS)</li> <li>○ Claim Correspondence Table</li> <li>○ Request for an Advanced-out-of-turn Examination</li> </ul>
<b>SIGNATURE/ DATE</b>	
<i>For authorized receiving officer of IPOPHL only</i>	
<b>RECEIVING OFFICER</b>	
<b>DATE RECEIVED</b>	

