

2025 PCT Training Seminar

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Making Use of PCT-PPH, and Comparison with Track I

Summarizing some of the fast-track initiatives

- Track I
- PPH (Patent Prosecution Highway)

Track I

With Track I, the applicant pays \$4645 to get “prioritized” examination. (Cheaper for small and micro entity.)

The up-front fee cost of \$4645 has two components:

- \$4515 track-I fee (less for small and micro)
- \$130 petition fee

3

Claim limits for Track I

The filer is limited to four independent claims.

The filer is limited to thirty total claims.

The filer is not permitted to use multiple dependent claims.

4

Track I requirements

Track I is not available for any already-pending case. If a filer has an already pending case, then to get its subject matter onto Track I would require filing a continuation application.

5

Losing Track-I status

Any of a long list of events triggers a loss of Track-I status. These events include:

- filing of a Notice of Appeal
- filing of an RCE
- petitioning for an extension of time to respond to an Office Action
- amending to add a fifth independent claim
- amending to add a thirty-first total claim
- amending to add a multiple-dependent claim

6

A chief drawback with Track I

- You are spending \$4640 at a time when you do not yet know whether or not your invention is even patentable

7

Patent Prosecution Highway

- Now we turn to PCT-PPH
- We discuss Best Practices

8

PPH results

Allowance rate typically 90% as compared with 50-55% for non-PPH cases

Number of office actions to disposition reduced from around 2½ to around 1½

Several factors may help to explain these results

9

PCT-PPH (Patent Cooperation Treaty PPH)

The whole thing can be done in a single patent application if desired

The trigger for PCT-PPH benefits can be a mere Written Opinion

10

When do you get your WO?

Recall that you get your WO within:

- three months of ISA's receipt of Search Copy, or
- nine months of the priority date, whichever is later.
- Some ISAs give you your WO much sooner than the nine months.

11

Without even trying ...

Many applicants can get PCT-PPH benefits even if they had no intention of trying to get such benefits. There is no extra cost beyond what would already be spent for a PCT filing.

12

Requirements for PCT-PPH

The ISA-WO or IPEA-WO or IPRP-II must come from an “approved” ISA or IPEA (AT, AU, CA, CN, EP, ES, FI, IL, JP, KR, RU, SG, SE, UK, US, XP, AT, AU, CA, CN, EP, ES, FI, IL, JP, KR, RU, SG, SE, UK, US, XP)

The ISA-WO or IPEA-WO or IPRP-II must treat at least one claim favorably

The US case must be connected, no matter how remotely, by Section 119 and/or Section 120 and/or Paris Article 4 relationships, with the IA (international application) containing the WO or IPRP-II

The claims must “sufficiently correspond”

13

Identifying eligible cases for PCT-PPH?

You may have PCT-PPH-eligible cases right now, and maybe you don't even know it. Go back and look at every old PCT application that you ever filed. Look at every Written Opinion. Go back and look at every old IPRP-II. You might find some favorably treated claims.

14

Variety of possible “gaining” cases

PCT-PPH benefits are not limited to national-stage cases. The beneficiary of PCT-PPH might be a continuation case, or a domestic case that predates the PCT case.

15

PCT work product

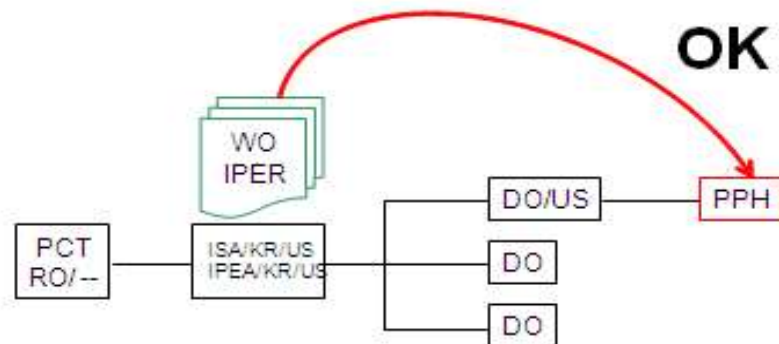
PCT work product can include:

- Written Opinion of the ISA
- Written Opinion of the IPEA
- International Preliminary Report on Patentability under Chapter II

16

Many scenarios for PCT-PPH

(A) The U.S. application is a national stage entry of the corresponding PCT application.

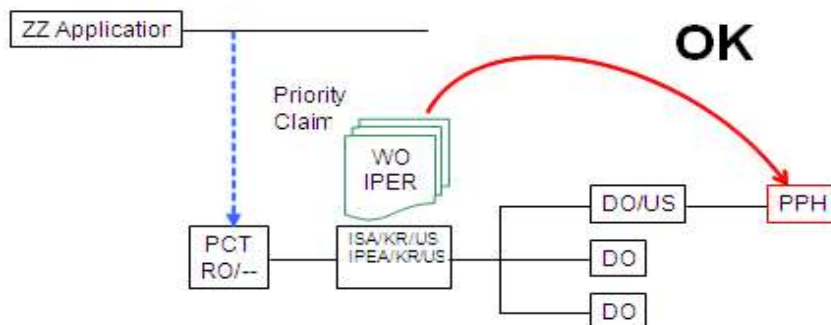


Note that the RO could be anywhere! It does not have to be the RO/US. It does not have to be the same as the ISA or IPEA. Note: IPER means IPRP-II.

17

Many scenarios for PCT-PPH

**(A') The U.S. application is a national stage entry of the corresponding PCT application.
(The corresponding PCT application claims priority to a national application filed anywhere.)**

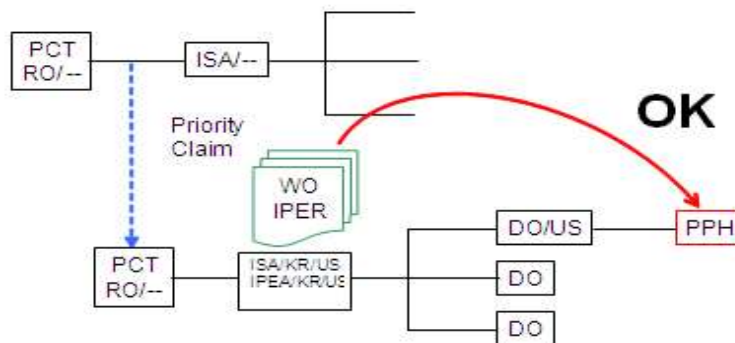


Note that the priority application could be anywhere! It does not have to be the US. It does not have to be the same as the ISA or IPEA. Note: IPER means IPRP-II.

18

Many scenarios for PCT-PPH

(A'') The U.S. application is a national stage entry of the corresponding PCT application.
(The corresponding PCT application claims priority to another PCT application.)

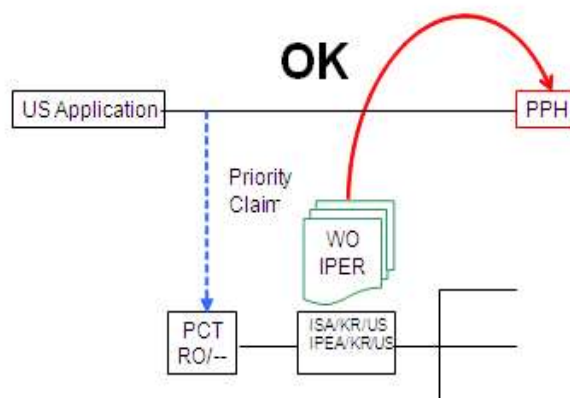


Note that the priority PCT filing could be anywhere! It does not have to be the US. It does not have to be the same as the ISA or IPEA. Note: IPER means IPRP-II.

19

Many scenarios for PCT-PPH

(B) The U.S. application is a national application which forms the basis for the priority claim in the corresponding PCT application.

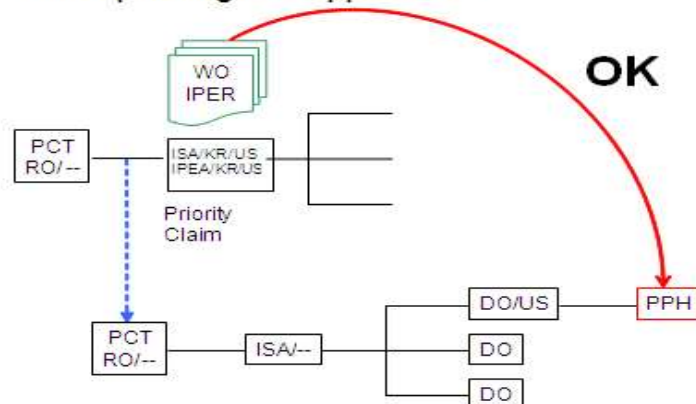


Note that the PCT application need not be filed in RO/US! Note: IPER means IPRP-II.

20

Many scenarios for PCT-PPH

(C) The U.S. application is a national stage entry of a PCT application which claims priority to the corresponding PCT application.

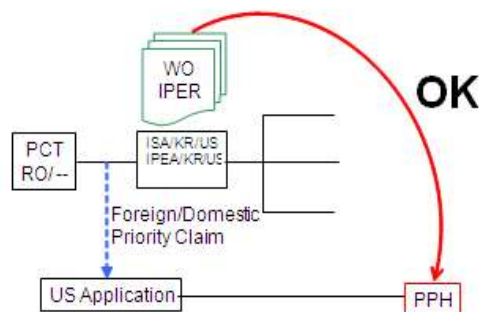


Note that the PCT application need not be filed in RO/US!
But don't forget the claims need to "sufficiently correspond".

21

Many scenarios for PCT-PPH

(D) The U.S. application is a national application claiming foreign/domestic priority to the corresponding PCT application.

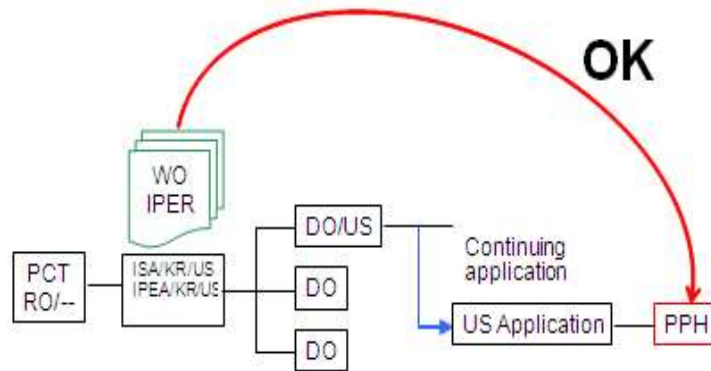


Note that the US case might have a Paris relationship or a Section 120 relationship with the PCT application.

22

Many scenarios for PCT-PPH

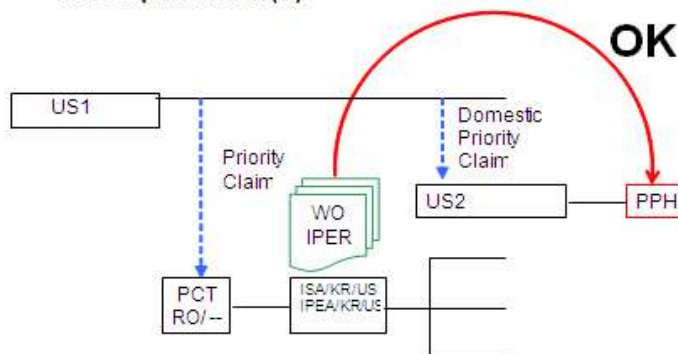
(E1) The U.S. application is a continuing application of an application which satisfies the requirement (a).



23

Many scenarios for PCT-PPH

(E2) The U.S. application (US2) is an application claiming Domestic priority to an application (US1) which satisfies the requirement (b).



24

How to docket PPH

When a PPH petition is filed, docket a month to check for a decision on the petition.

When a petition is filed in a case that does not have a Filing Receipt, docket a month to check for a Filing Receipt.

Also docket to check that an Examiner gets assigned to the case.

If a petition is dismissed, aggressively docket the one-month period.

25

Trap for the unwary

Many filers will put off filing thorough IDSs until months after getting the US application number. But when you file a PCT-PPH petition, you might get a Notice of Allowance at any time thereafter, perhaps within mere days. Make sure that all of your IDSs (not only the IDS required by the PCT-PPH procedure) have been filed before you file your PCT-PPH petition.

26

An actual PCT-PPH result

February 28, 2007	Priority application filed
February 27, 2008 (ISA/KR)	International application filed
July 29, 2008	International search report mailed
August 28, 2009	US national stage entered
April 22, 2010	First Office Action Prediction is 22 months
June 3, 2010	PCT-PPH-KR petition filed
June 9, 2010	PCT-PPH-KR petition granted
June 18, 2010	Notice of allowance

27

Most commonly made mistakes when petitioning for PCT-PPH status

- failing to provide all references from the ISR
- failing to file an IDS detailing those references
- failing to cancel claims that were not treated favorably
- failing to index the petition correctly - "Petition to make special under PCT-Patent Pros Hwy."
- failing to provide a copy of the ISR
- Failing to provide a copy of the WO
- Failing to list the ISR and the WO in the IDS
- failing to cause the US claims to "sufficiently correspond"

28

If a petition is dismissed?

Trap for the unwary: If the Examiner picks up the file while you are sitting around not responding to the dismissal, you lose your chance for PCT-PPH. So don't let the whole month go by. Respond sooner.

29

PCT can make good sense

Note that PCT-PPH means that PCT may make good sense even for applicants who have no intention of foreign filing.

30

Comparison of PCT-PPH and Track I

Up-front fee may be cheaper for PCT

Gaining application can be almost anything under PCT-PPH

Different limits on your numbers of claims

How long the “special” status lasts ...

Consequences of filing an RCE

Consequence of taking a day of extension of time

The “special” status of PPH is a gift that keeps on giving, all the way through *ex parte* appeal (not so for Track I)

31

Track I

- With Track I, you are spending \$4640 at a time when you do not yet know whether your invention is patentable

32

Tedious and old-fashioned work

There is simply no substitute for the tedious and old-fashioned business of figuring out what the invention is, drafting the best claims that our abilities permit, and keeping the application concise and to the point.

If one is tempted to pursue one or another of the approaches described here, one should do so only for a well drafted patent application.

Thank you!