

Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Mexican Institute of Industrial Property

I. Background

In the modern global economy, IP users firms and IP applicants face an increasing need of extending their inventions' protection in several countries. To do so, IP users are required to fulfill different legal and administrative procedures, established by each patent office.

In this scenario, the Mexican Institute of Industrial Property (IMPI), to meet the objectives set in different applicable legal regulations, especially those contained in the Industrial Property Law (LPI), intends to establish the foundations for the country's industrial and commercial activities, aimed at fostering a permanent system for process and products' improvement. Thus constituting a more quality-focused, highly productive and responsible organization, supporting a market-oriented IP system.

In 2011, IMPI, with the aim of speeding-up and making the Mexican Patent System more effective, as well as seeking to take an active role in the international scenario, launches a First Patent Prosecution Highway Pilot Program (PPH) jointly with the United States Patent and Trademark Office (USPTO). With this pilot program, IMPI and the USPTO will benefit, mutually, from the substantive examination process carried out by these two offices, in order to accelerate their patent granting process, avoiding the duplication of efforts and decreasing their workloads.

This first PPH Pilot Program is expected to be a successful experience that will provide IP system users with the necessary tools to access new markets, as well as positioning IMPI as a modern Institution, harmonized with international trends.

II. Patent Prosecution Highway Pilot Program

The PPH was established to enable an applicant whose claims are determined to be allowable/patentable in the Office of first filing (OFF) to have the corresponding application filed in the Office of second filing (OSF) advanced out of turn for examination while at the same time allowing the OSF to exploit the search and examination results of the OFF.

Where IMPI is the OFF and the corresponding application filed with the Institute contains claims that are determined to be allowable/patentable, the applicant may request accelerated examination at USPTO for the corresponding application filed with USPTO as the OSF. The procedures and requirements for filing a request with USPTO for participation in the PPH pilot program will be available on March 1, 2011, from the USPTO Web site at: http://www.uspto.gov/patents/init_events/pph/pph_impi.jsp.

Where IMPI is the OSF and the corresponding application filed with USPTO as the OFF contains claims that are determined to be allowable/patentable, the applicant may request participation in the PPH pilot program at the IMPI and request that the IMPI application be advanced out of turn for examination according to this agreement. The procedures and requirements for filing a request with IMPI for participation in the PPH pilot program will be available in section "Patent Prosecution Highway IMPI-USPTO" on March 1, 2011, from the IMPI Web site at: <http://www.impi.gob.mx>. The procedures and requirements for filing a request for participation in the PPH pilot program are set forth below.

A. Trial Period for the PPH Pilot Program

The PPH pilot program will commence on March 1, 2011, for a period of one year ending on February 29, 2012. The trial period may be extended for up to an additional year or more if necessary to adequately assess the feasibility of the PPH program. The USPTO and IMPI will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period. The Offices may also terminate the PPH pilot program early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if the PPH pilot program finalized before February 29, 2012.

B. Requirements for Requesting Participation in the PPH Pilot Program at the IMPI

In order to be eligible to participate in the PPH pilot program, the following conditions must be met:

(1) The MX application is

- (a) a Paris Convention application which either
 - (i) validly claims priority under articles 40 and 41 of the LPI to one or more applications filed with USPTO, or
 - (ii) validly claims priority to a PCT application that contains no priority claims,

or

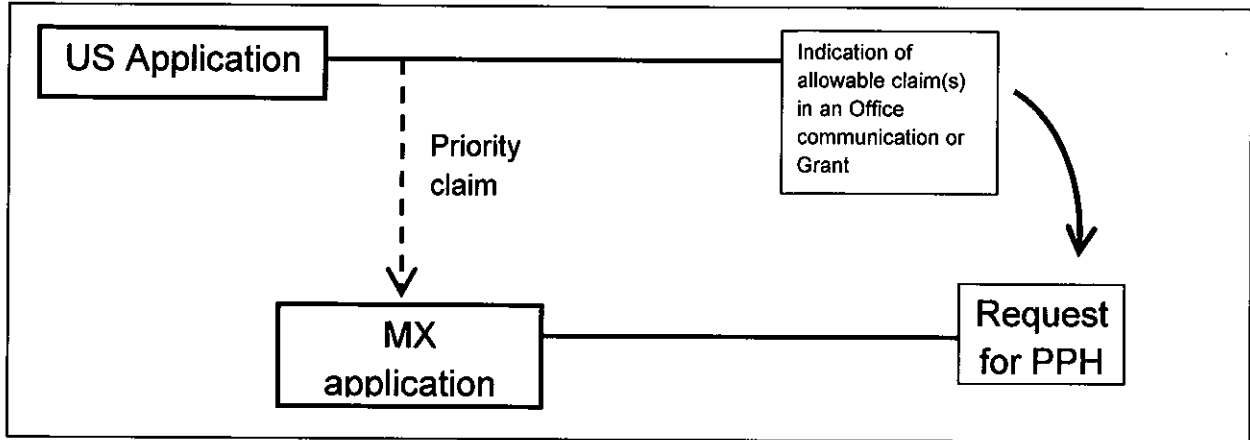
(b) a national stage application under the PCT (an application which entered the national stage in MX) from a PCT international application that:

- (i) validly claims priority under articles 40 and 41 of the LPI to an application filed with USPTO, or
- (ii) validly claims priority to a PCT application that contains no priority claims, or
- (iii) contains no priority claim,

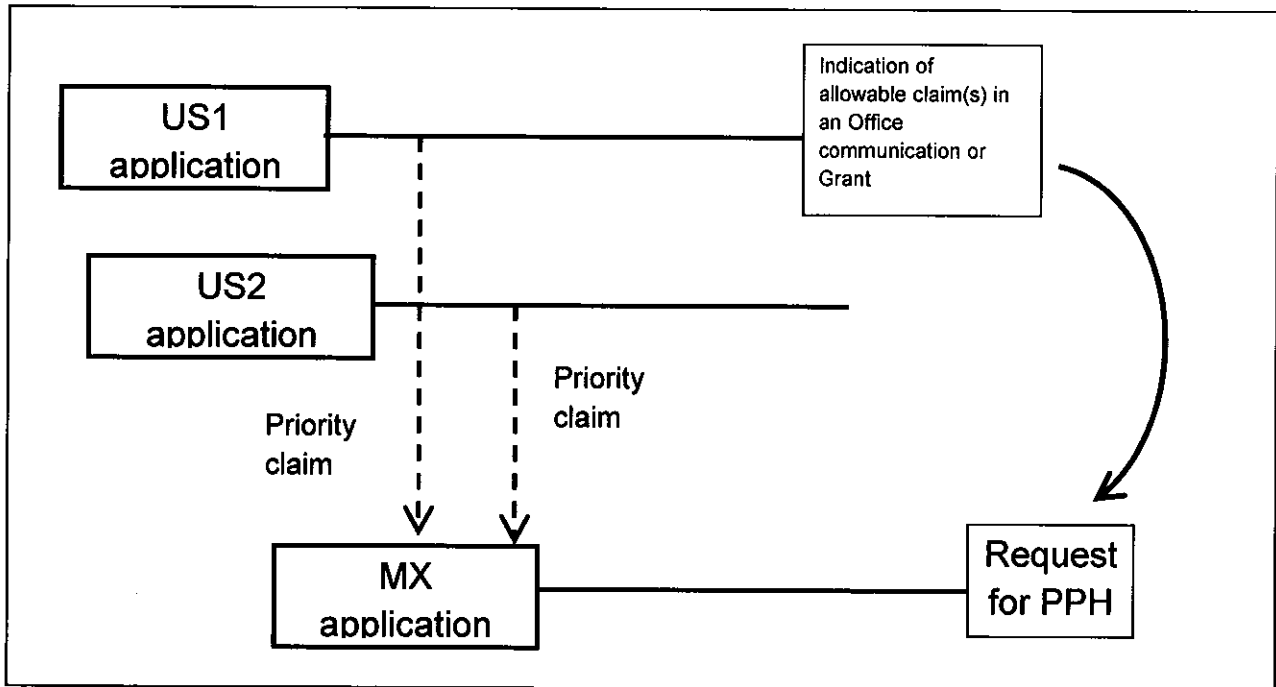
Examples of MX applications that fall under requirement (1) are:

(1)(a)(i):

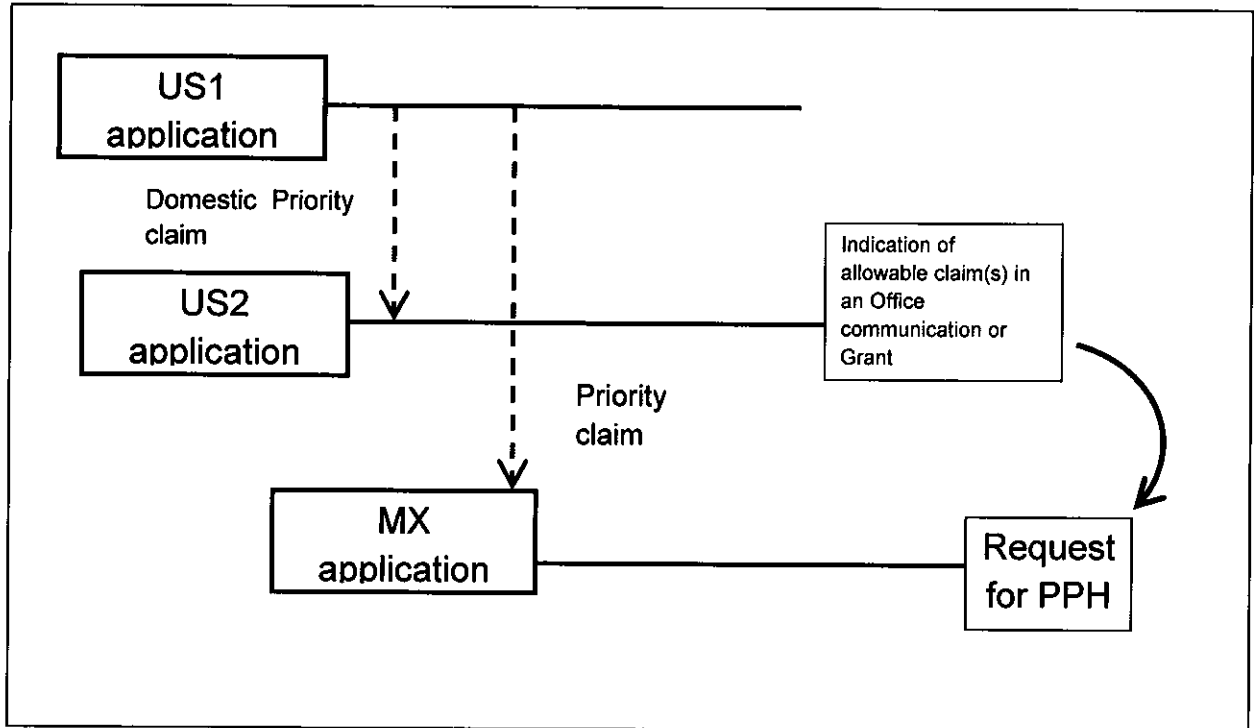
- MX application with single Paris Convention priority claim to an application filed in the US



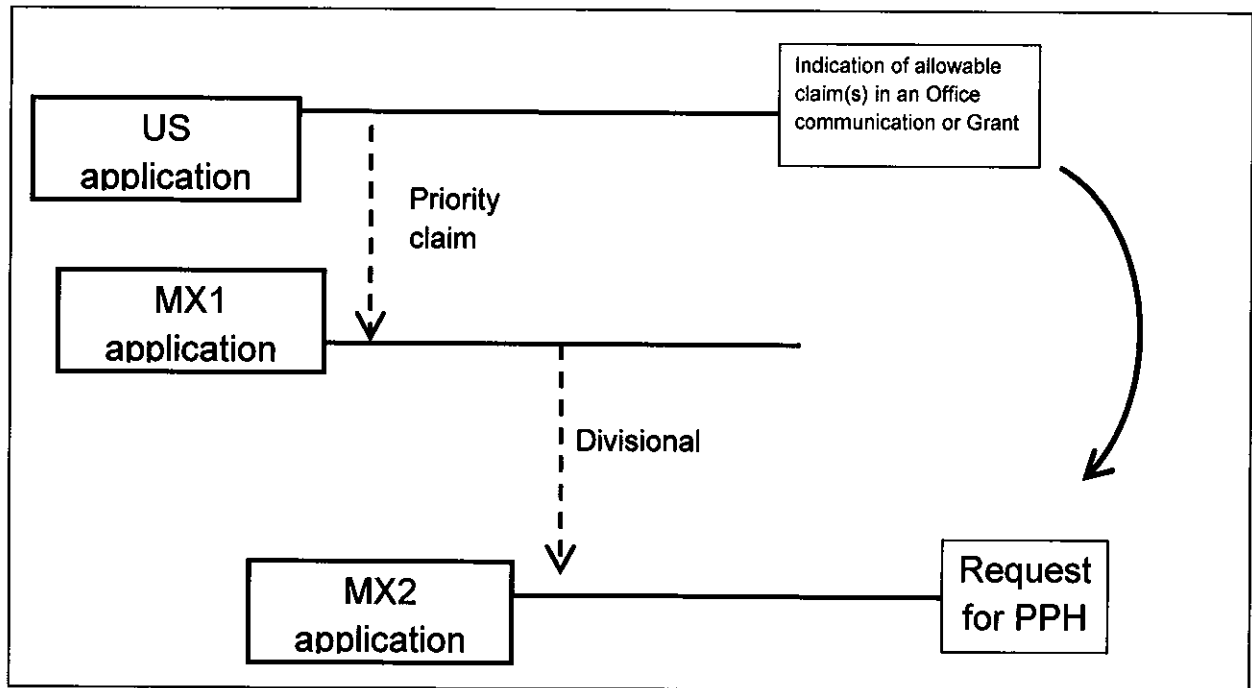
- MX application with multiple Paris Convention priority claims to US applications



- Paris route and domestic priority

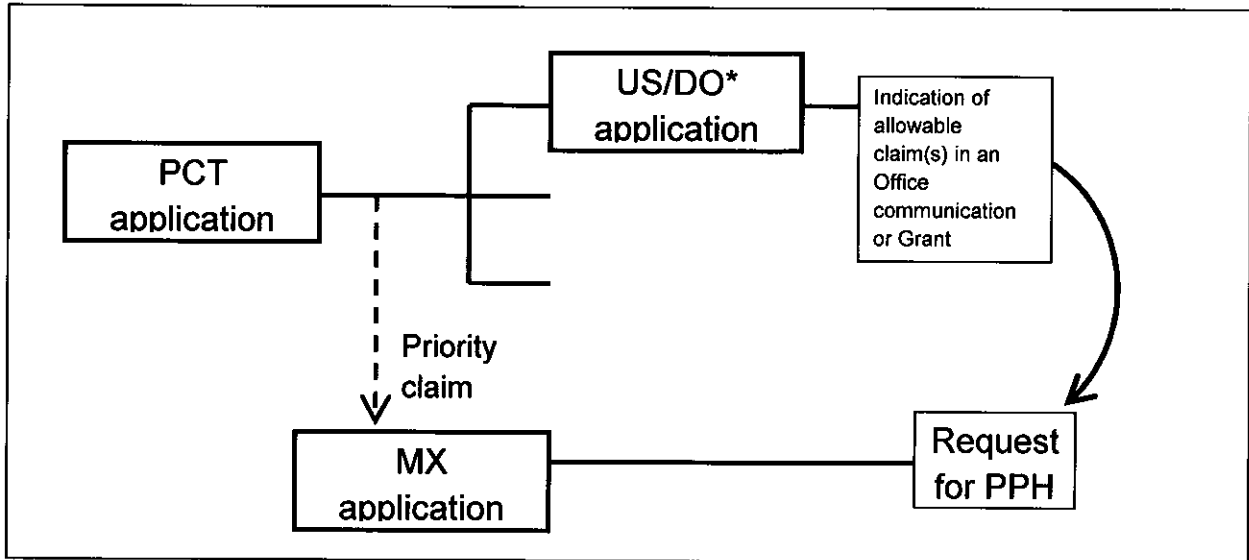


- Paris route and divisional application



(1)(a)(ii):

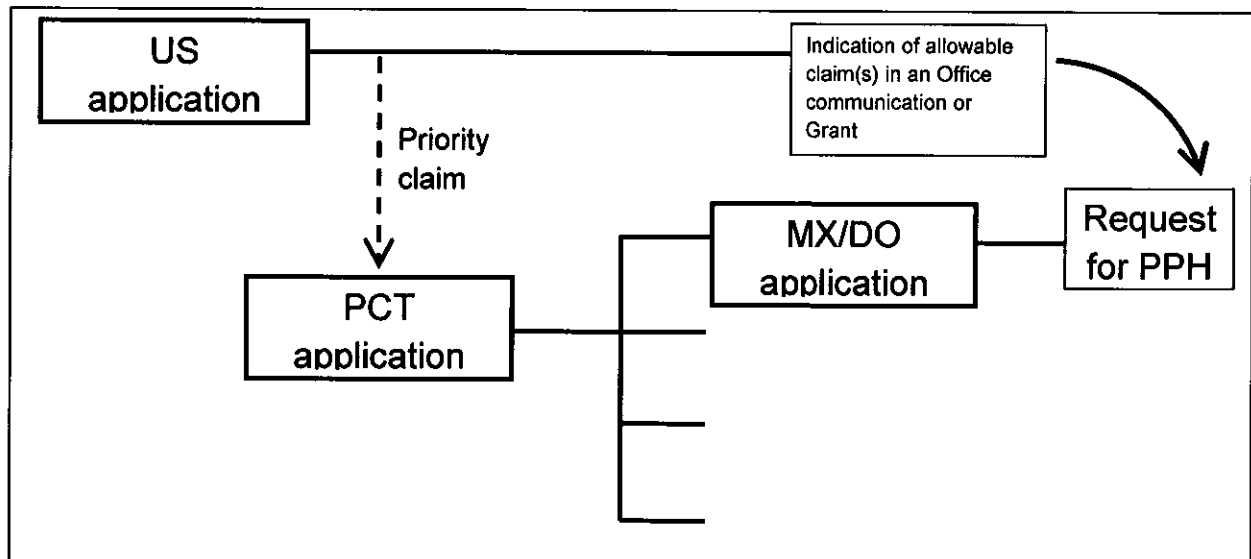
- MX application claims Paris Convention priority to a PCT application



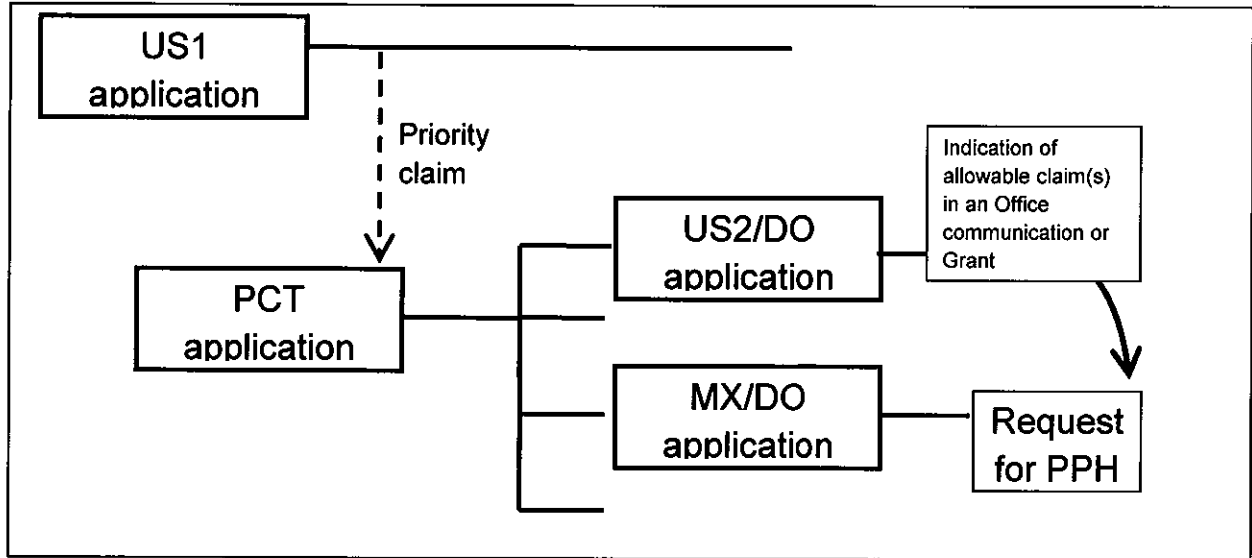
* DO – Designated Office

(1)(b)(i):

- MX application is a national stage of a PCT application which claims Paris Convention priority to a US application

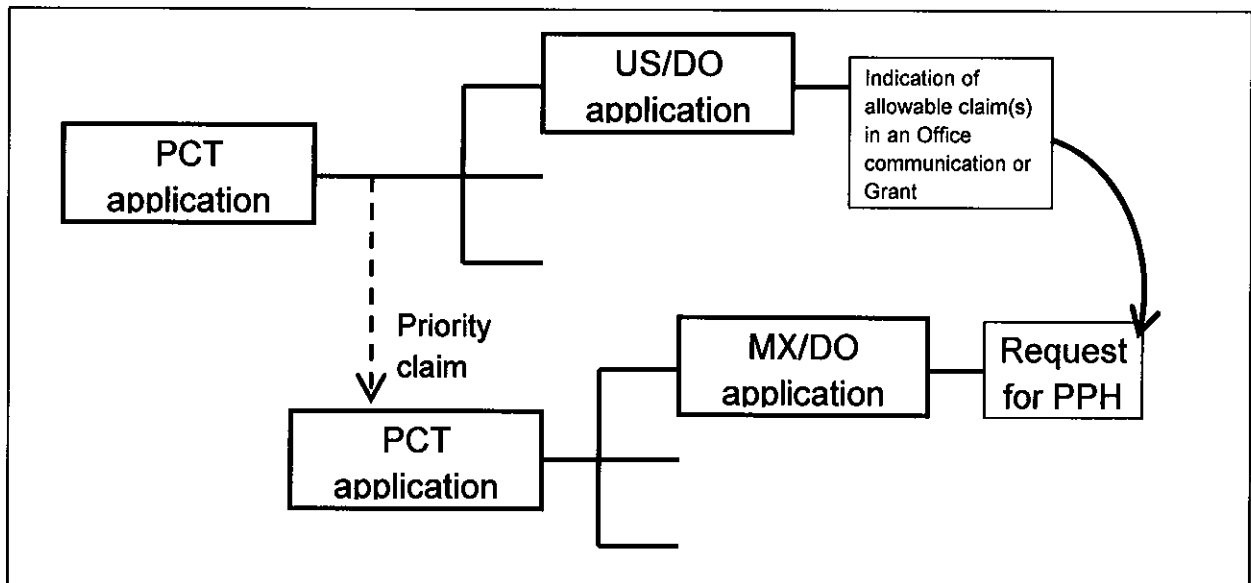


- PCT Route

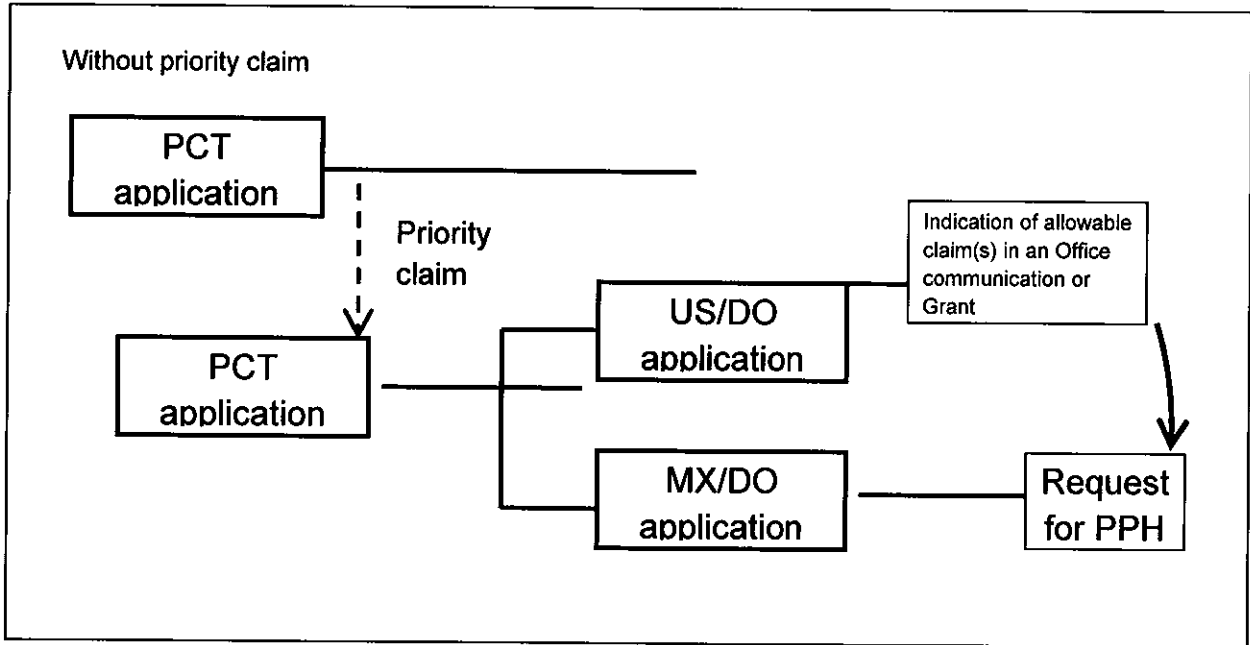


(1)(b)(ii):

- MX application is a national stage of a PCT application which claims Paris Convention priority to another PCT application

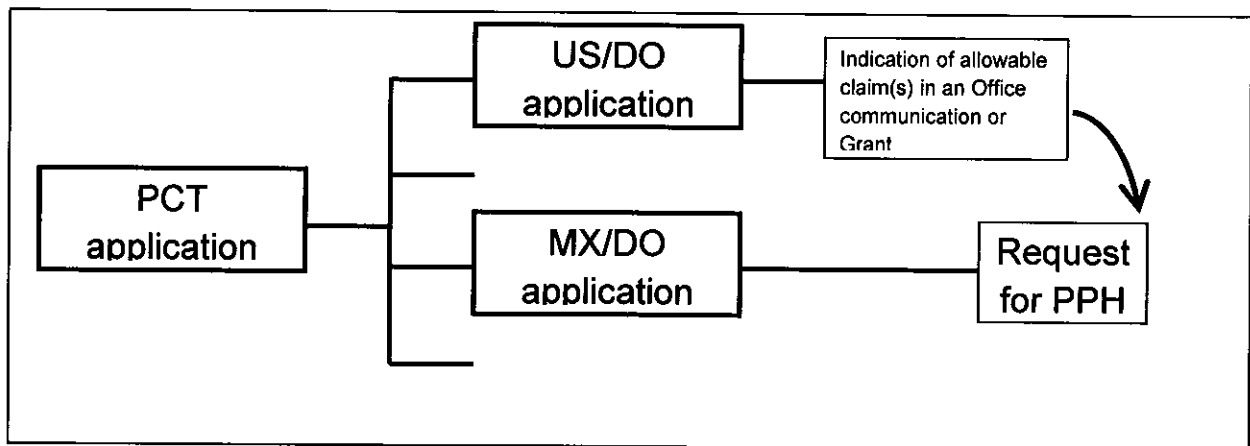


- Direct PCT and PCT Route



(1)(b)(iii):

- MX application is a national stage of a PCT application without priority claim



The US application whose claims are determined to be allowable/patentable may not be the application for which priority is claimed at the IMPI application (the basic application). The US application that contains the allowable/patentable claims can be an application explicitly derived from a basic application, e.g., a divisional application of the basic application. Note that where the US application that contains the allowable/patentable claims is not the same application for which priority is claimed in the MX application, applicant must identify the relationship between the US application that contains the allowable/patentable claims and the US priority application claimed in the MX application (e.g., US application "X" that contains the allowable/patentable claims is a divisional application of US application "Y", which is the priority application claimed in the MX application).

Utility model and industrial design applications, likewise claims of patent which contains material covered by articles 4, 16 and 19 of the LPI are excluded and not subject to participation in the PPH.

(2) The US application(s) have at least one claim that was determined by the USPTO to be allowable/patentable. Applicant must submit a copy of the allowable/patentable claims from the US application(s) along with an Spanish translation thereof, if the claims are not in the Spanish language.

Claims are determined to be allowable/patentable when an official action of the USPTO determine them as allowable/patentable

If the USPTO Office action does not **explicitly** state that a particular claim is allowable, applicant must include in the request, for participation in the PPH pilot program, a technical analysis with respect to the prior art stated, indicating that no rejection has been made in the USPTO Office action regarding that claim, and therefore, the claim is deemed allowable by the USPTO.

(3) All the claims in each MX application for which a request for participation in the PPH pilot program is made must sufficiently correspond to or be amended to sufficiently correspond to the allowable/patentable claims in the US application(s). Claims will be considered to sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope, or claims at the IMPI are narrower in scope to those claims determined to be allowable/patentable in the USPTO. In this regard, a claim that is narrower in scope occurs when an MX claim is amended to be further limited by an additional technical feature that is supported in the application originally filed at the IMPI (description and/or claims).

A claim in MX application which introduces a new/different category of claims to those claims determined to be patentable/allowable in the USPTO is not considered to sufficiently correspond, e.g., the US claims only contain claims to a process of manufacturing a product, then the claims at the IMPI are not considered to sufficiently correspond, if this claims introduce product claims that are dependent on the corresponding process claims.

Applicant is also required to submit a claims correspondence table in Spanish. The claims correspondence table must indicate how all the claims in the MX application correspond to the allowable/patentable claims in the US application(s).

(4) Examination of the MX application for which participation in the PPH pilot program is requested has not begun.

Will be accepted any claims amended or added after the request for participation in the PPH Pilot Program when sufficiently correspond to the claims indicated as patentable/allowable in the US application and submitted before the basic patent application determination issuance.

(5) Applicant to participate in the PPH pilot program must submit before IMPI a sample text (see annex 1) along with the correspondent annex documents.

- a) A copy of all the Office actions (which are relevant to patentability) from each of the US application(s) containing the allowable/patentable claims that are the basis for the request, along with its translation.
- b) A copy of all claims which were determined to be patentable by the USPTO, along with its translation. In addition, applicant must submit copies of any Office actions (which are relevant to patentability) from the US application(s) issued after the request for participation in the PPH pilot program at the IMPI (especially where USPTO might have reversed a prior holding of allowability). Submitting such documents may be omitted if available in the USPTO database (Patent Application Information Retrieval, Public PAIR).
- c) An information disclosure statement (IDS) listing the documents cited by the USPTO examiner in the USPTO Office action (unless such an IDS has already been filed in the MX application). Applicant must submit copies of all the documents cited in the USPTO Office action including non-patent literature (unless the copies have already been filed in the MX application) Patent documents must be submitted when not available for IMPI in this case the applicant will be required.
- d) A claims correspondence table

Where the request for participation in the PPH pilot program is accepted, MX application will be advanced out of turn for examination, as long as it complies with article 52 and upon expired the period prescribed in article 52 bis of the LPI. In those instances where the request for participation in the PPH pilot program does not meet all the requirements set forth above, applicant will be notified and the defects in the request will be identified. Applicant will be given one opportunity to perfect the request in a renewed request for participation in the PPH pilot program. 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 applicant has been notified of the defects, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, the application will be considered to advance out of turn for examination. If the request of participation in the PPH pilot program is not perfected, the application will await action in its regular turn.

(6) The acceptance of a participation request in the PPH pilot program in a parent application will not carry over to a divisional application. Applicant must submit a new request of participation in the PPH pilot program for the divisional application and fulfill all the conditions set forth above in order to be accepted in the divisional application.

If any of the documents identified in items (2) and (5) above have already been filed in the MX application prior to the request for participation in the PPH pilot program, it will not be necessary for applicant to resubmit these documents with the request for participation. Applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot program when these documents were previously filed in the MX application.

C. Special Examining Procedures

Once the request for participation in the PPH pilot program is accepted for the MX application, this will be considered by IMPI for advancing the examination, except those clearly in condition for allowance, and those with set time limits.


Any claims amended or added after the acceptance of the request for participation in the PPH pilot program must sufficiently correspond to one or more allowable/patentable claims in the US application(s). Applicant is required to submit a claims correspondence table along with the amendment (see B.(3) above). If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the US application(s), the amendment will not be entered. .

The PPH program does not absolve applicants of all their duties under the Industrial Property Law and applicable law. Applicant must act in good faith, including providing to the IMPI other information known to them to be material to patentability.

Any inquiries concerning this notice may be directed to Fabián Salazar García, Patent Division Director, at (5255) 5334 0710 or at rsalazar@impi.gob.mx

This is signed on the basis of the provisions of Articles 22 Section I and 59 Section I of the Federal Law of Public Enterprises; 6 Section I, 7, 7 Bis 1 and 7 Bis 2 of the Industrial Property Law, published at the Official Gazette on June 27 1991, reforms of August 2nd 1994, December 26th 1997, May 17th 1999, January 26th 2004 and June 16th 2005; 6 and 10 of the Decree that established the Mexican Institute of Industrial Property, published in the Official Gazette on December 10th 1993; 3rd Section II, 4th and 6th Bis of the Mexican Institute of Industrial Property Rules, published in the Official Gazette on December 14th 1999, amended and supplemented on July 15th 2004 and September 7th 2007 and 10 of the Mexican Institute of Industrial Property Organic Statute, published in the Official Gazette on December 27th 1999; reforms of October 10th 2002 and July 29th 2004, with an explanatory note published on August 4th 2004, and amended and supplemented on September 13th 2007.

Date: 03/01/2011



Jorge H. Amigo Castañeda
IMPI Director General

Sample text

Place and Date
Subject: Request of
participation in the PPH Pilot
Program
Application number before
IMPI
Filing Date
Title of the Invention:
Applicant
Attorney or legal
representative

Mexican Institute of Industrial Property
Patent Division

Through this means, we request the inclusion of the application with file number MX/a/ / / into the PPH Pilot Program corresponding to the application XXXXXX filed before the USPTO and met the conditions provided in subsection (X) of paragraph 1 (a) or (b) (explain the reasons why it complies with this conditions) and for this purpose we attach the following documents:

- (a) A copy of all USPTO office actions which are relevant to patentability in the above-identified US application(s) and where appropriate, its translation.
- (b) A copy of all claims which were determined to be patentable by the USPTO in the above-identified US application(s) and where appropriate, its translation.
- (c) An information disclosure statement listing the documents cited in the USPTO office actions and where appropriate, its translation.
- (d) Table of claims correspondence

Claims correspondence		
Claims in MX application	Patentable Claims in the US application	Explanation regarding the sufficient correspondence
XXX	XXX	They are the same
XYY	XYZ	Justification of sufficient correspondence

Submitting such documents may be omitted if available in the USPTO database (Patent Application Information Retrieval, Public PAIR)

(Make a list of the documents)

Name and signature of the applicant or attorney