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“Tip of the Month”

PCT Applications – Using PPH to Fast Track US Patent Applications

Many companies and individuals file Patent Cooperation Treaty (PCT) patent applications. They do so not only as a precursor to filing foreign patent applications, but also as a precursor to filing patent applications in the United States. When filing a PCT application, the applicant chooses an International Searching Authority (ISA) to do a prior art search of the invention. These ISA's include the United States Patent & Trademark Office (USPTO), the European Patent Office (EPO), and the Korean Intellectual Property Office (KIPO). The ISA issues an International Search Report (ISR) and a Written Opinion (WO) regarding patentability of the claims. The ISR and WO are issued usually within 9 months if the first patent application filing is the PCT application and within 16 months if the PCT application claims priority to a prior national patent application. The WO indicates a positive or negative opinion for each of the three patentability criteria (i.e., novelty, inventive step, and industrial applicability) for each of the claims in the PCT application.

As of January 2010, the PCT Patent Prosecution Highway in the USPTO allows an applicant fast track review of any US patent application that receives a positive opinion in the WO on novelty, inventive step, and industrial applicability for any claim(s). The fast track review is restricted to only those claims having a positive opinion on each of the three patentability criteria. For example, a WO might indicate that claims 1-3 do not have novelty, inventive step, or industrial applicability, that claims 4-6 have novelty and industrial applicability but not inventive step, and that claims 7-10 have novelty, inventive step, and industrial applicability. If so, the applicant's pending US patent application is eligible for fast track review of those claims that sufficiently correspond to claims 7-10 of the PCT application.

What does fast track prosecution include? – An application receiving fast track treatment is given special priority in the USPTO. This means that a patent examiner is obligated to examine the fast-tracked US patent application before almost all other applications throughout every stage of the examination process. For example, an application that would have otherwise taken approximately two years to receive a first Office Action may receive one in as little as a few weeks with fast track treatment. Additionally, if it is necessary to appeal an examiner's decision to the Board of Patent Appeals, the Board is also obligated to examine the appeal before almost all other appeals.

Fast track prosecution is not an instant allowance – Just because the WO indicates a positive opinion on patentability, does not mean that the USPTO is obliged to come to the same conclusion. The USPTO can do its own search and issue rejections just as they can in any other case. The fast track prosecution only entitles the applicant to speedy examination, not a guaranteed patent allowance.

If you have any questions about the PCT Patent Prosecution Highway, please call the attorneys at Mesmer & Deleault at 668-1971 or contact us by e-mail at [mailbox @ biz-patlaw.com](mailto:mailbox@biz-patlaw.com).

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