

# **Notice Regarding Full Implementation of Patent Prosecution Highway Program between the United States Patent and Trademark Office and the Mexican Institute of Industrial Property**

## **I. Background**

On March 1, 2011, the United States Patent and Trademark Office (USPTO) began a Patent Prosecution Highway (PPH) pilot program with the Mexican Institute of Industrial Property (IMPI). For a complete description of the PPH pilot program, see "Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the Mexican Institute of Industrial Property," 1364 Off. Gaz. Pat. Office 201 (March 15, 2011). The PPH program permits: (1) applicants to expeditiously obtain a patent in the Office of second filing (OSF) at an early stage, by utilizing the petition to make special procedures currently available in the OSF, based on claims that have been allowed in the Office of first filing (OFF); (2) the OSF to reduce duplication of search efforts by exploiting the search and examination results of the OFF to the extent practicable; and (3) the OSF to reduce the examination workload since the scope of the claims in the OSF application has been clarified through the OFF's examination prosecution.

## **II. Full Implementation of the Patent Prosecution Highway Program**

The USPTO and the IMPI agreed to fully implement the PPH program on a permanent basis starting on September 1, 2012. While the program itself will become a permanent cooperative arrangement between the offices, the specific program requirements are subject to change in the future depending on further development and evolution of the PPH. Notice of any such changes to the program will be published.

### **A. Requirements for Requesting Participation in the PPH Program at the IMPI**

In order to be eligible to participate in the PPH 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:

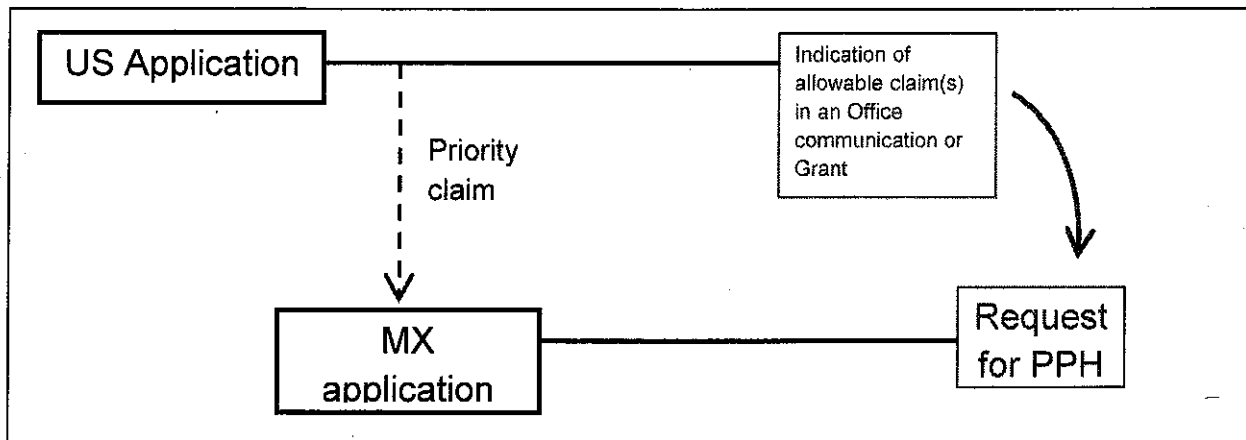
(i) validly claims priority under articles 40 and 41 of the LPI to an application filed with USPTO, or

- (ii) validly claims priority to a PCT application that contains no priority claims, or
- (iii) contains no priority claim,

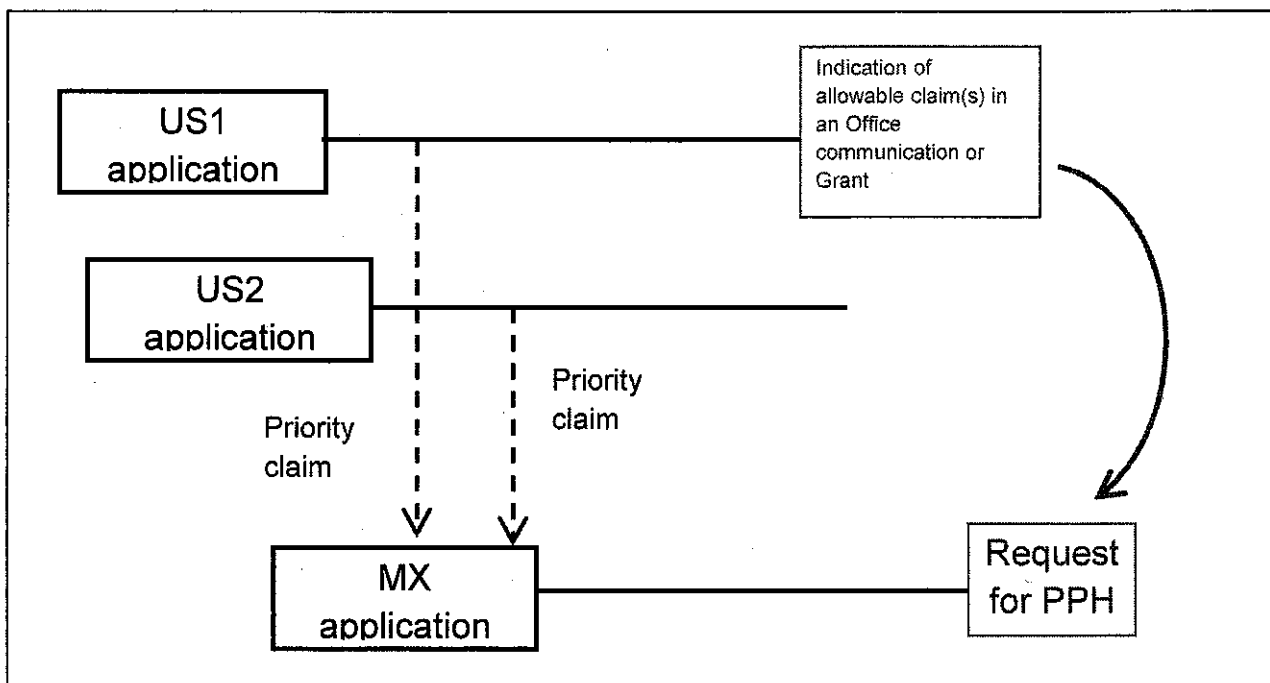
Examples of MX applications that fall under requirement (1) are:

(1)(a)(i):

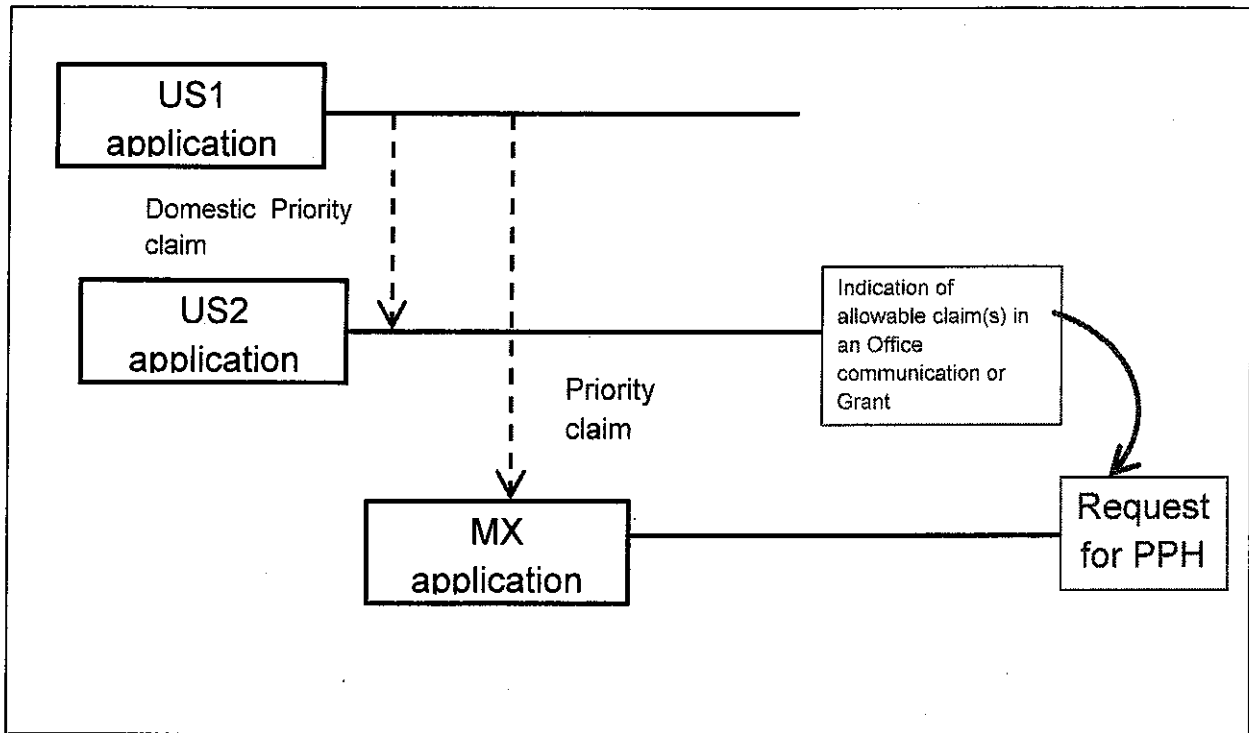
- MX application with single Paris Convention priority claim to an application filed in the US



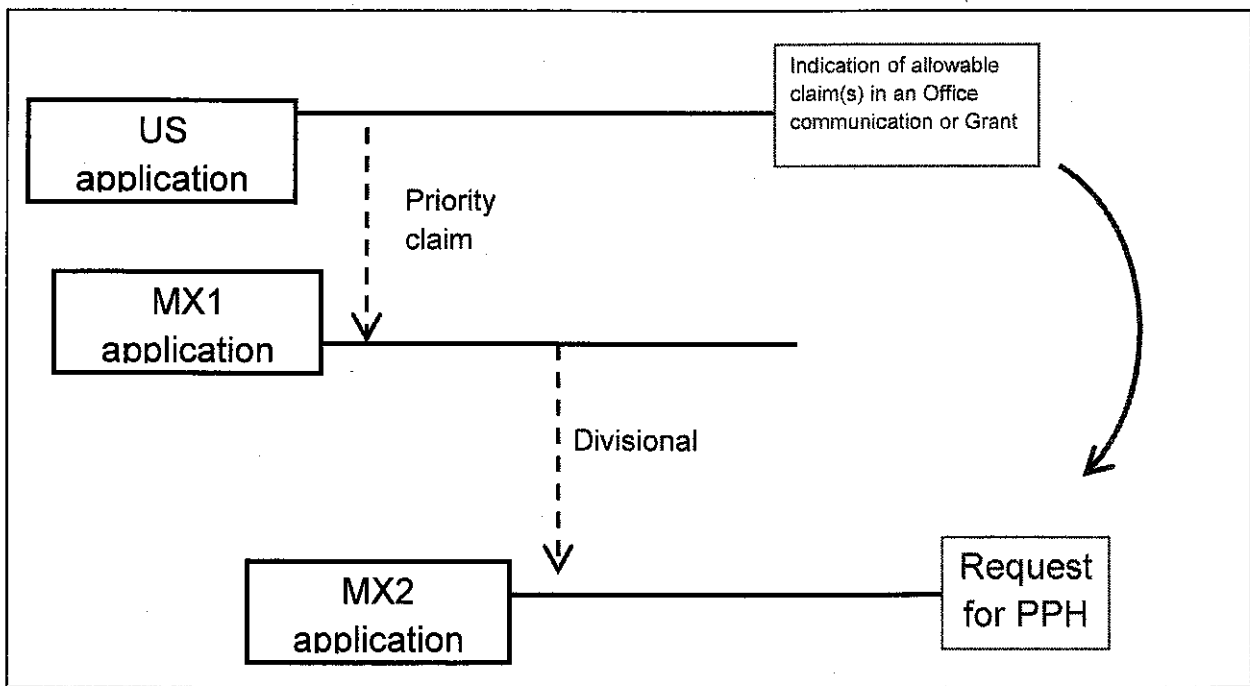
- MX application with multiple Paris Convention priority claims to US applications



- Paris route and domestic priority

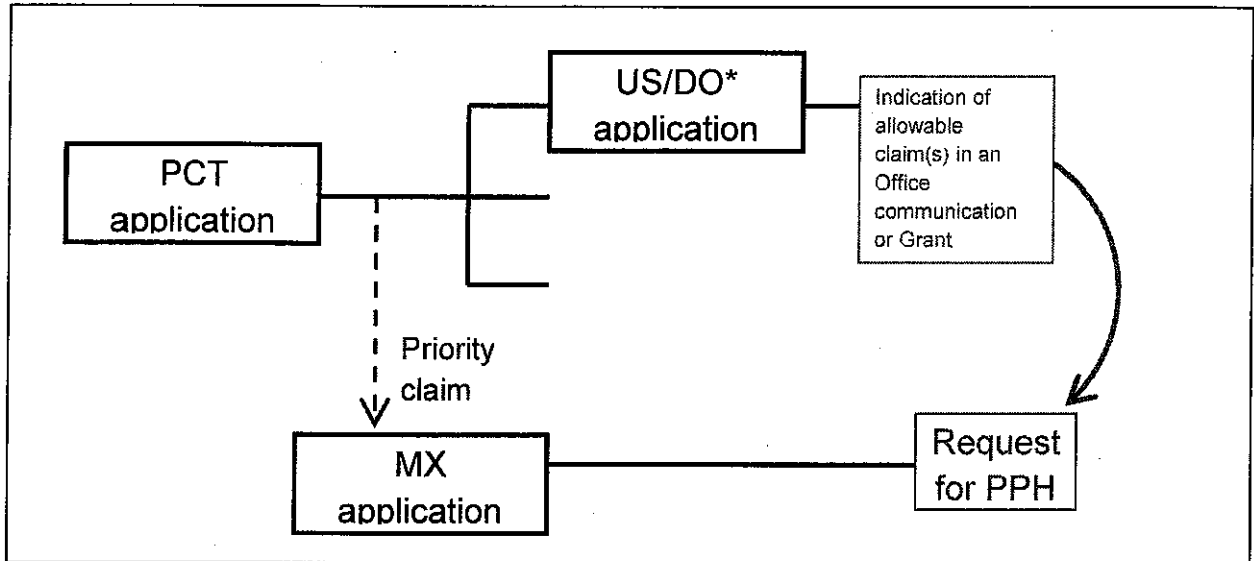


- Paris route and divisional application



(1)(a)(ii):

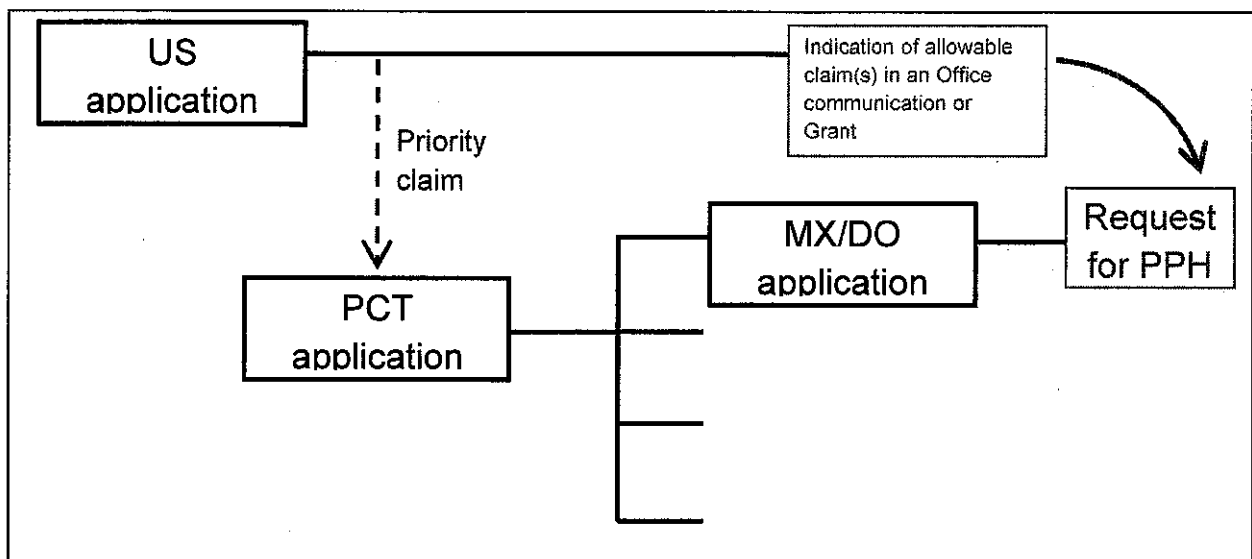
- MX application claims Paris Convention priority to a PCT application



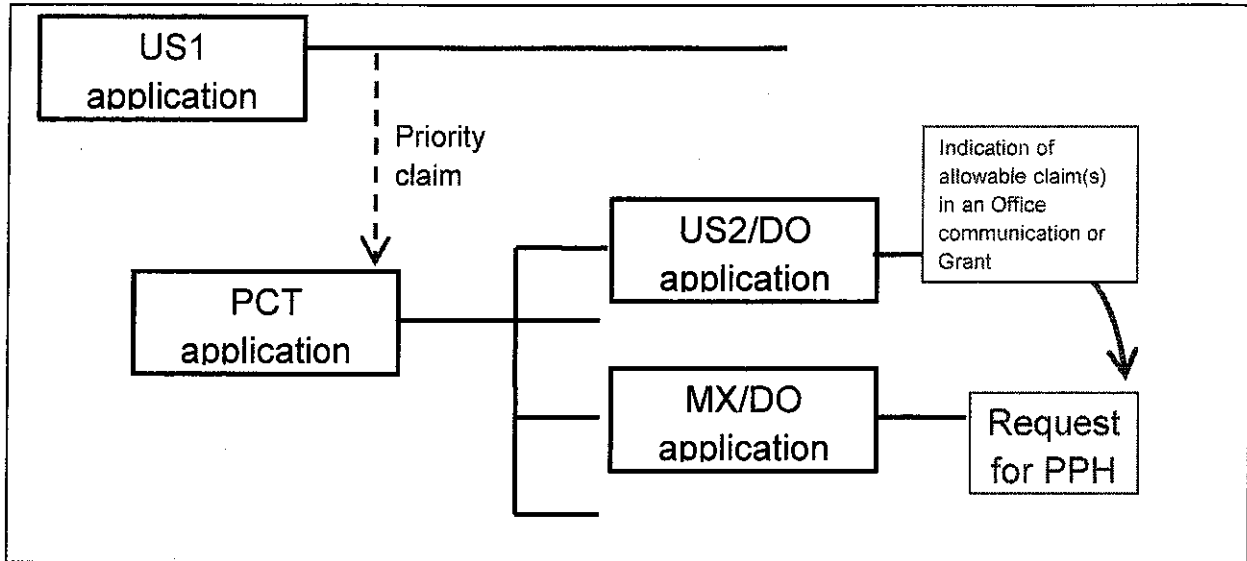
\* DO – Designated Office

(1)(b)(i):

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

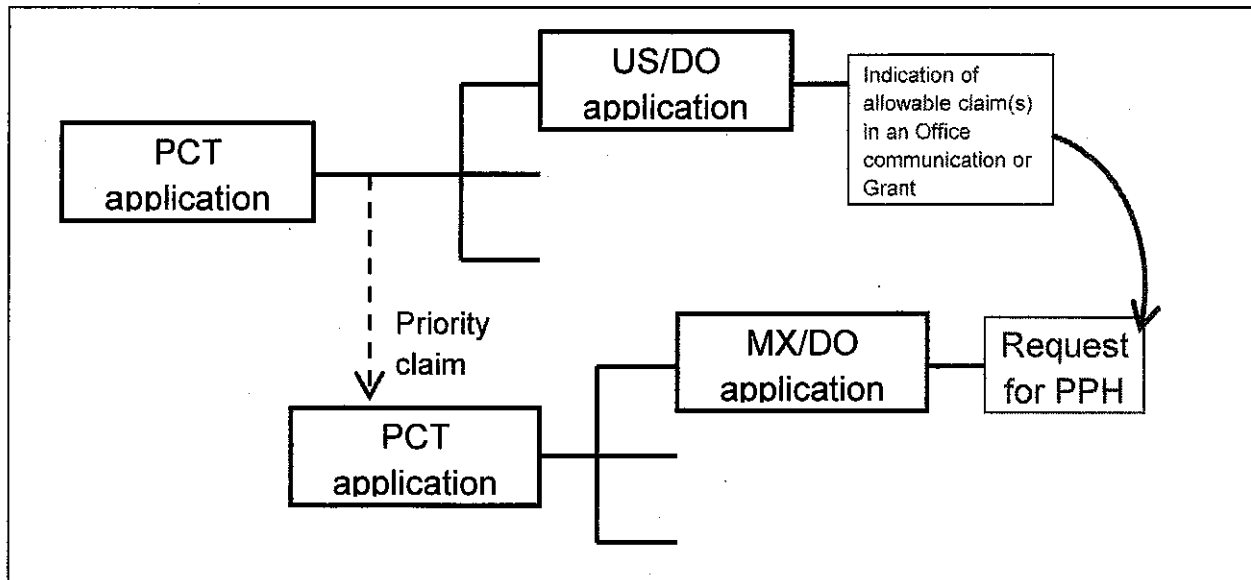


- PCT Route

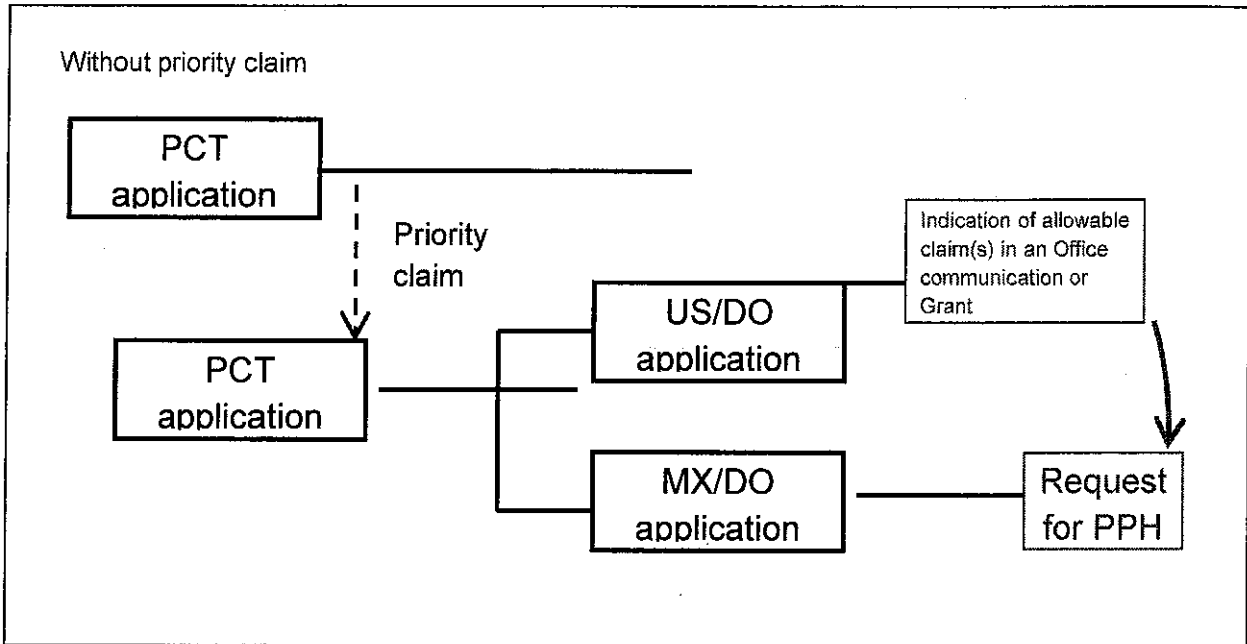


(1)(b)(ii):

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

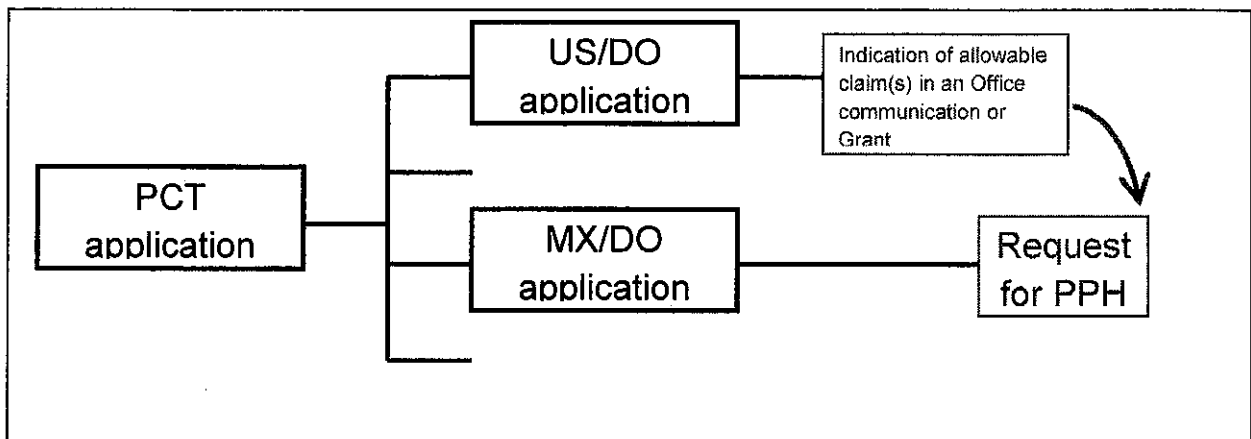


- Direct PCT and PCT Route



(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 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 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 program is requested has not begun.

Will be accepted any claims amended or added after the request for participation in the PPH 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 program must submit before IMPI a sample text 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 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 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 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 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 program is not perfected, the application will await action in its regular turn.

(6) The acceptance of a participation request in the PPH program in a parent application will not carry over to a divisional application. Applicant must submit a new request of participation in the PPH 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 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 program when these documents were previously filed in the MX application.

## **B. Special Examining Procedures**

Once the request for participation in the PPH 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 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 A.(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](mailto:rsalazar@impi.gob.mx)

Date: 08/17/2012



\_\_\_\_\_  
José Rodrigo Roque Díaz  
— IMPI Director General