

GLOBAL PPH AND IP5 – LATEST ITERATION IN THE PATENT PROSECUTION HIGHWAY



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The Patent Prosecution

Highway (also referred to as the “PPH”) embodies numerous bilateral agreements between dozens of countries providing that an indication of allowable subject matter in one country may trigger accelerated examination in another country. The PPH has undergone several iterations in an effort to homogenize aspects of the agreements. Nonetheless, inter-jurisdictional variations in legal and procedural requirements remain a sticking point for many practitioners who view the PPH as unnecessarily onerous and convoluted.

A recent iteration implemented January 6, 2014, came in the form of two programs — the so-called Global Patent Prosecution Highway (Global PPH) that promises to standardize the agreements between 17 offices in 16 countries, as well as the IP5 that standardizes agreements between the United States, the European Patent Office (EPO), Japan, China and Korea.

A PPH PRIMER

The PPH provides accelerated examination of corresponding patent applications by sharing information between multiple patent offices. Once an applicant receives a ruling from an Office of First Filing (OFF) that at least one claim of an application is patentable, the applicant may request that an Office of Second Filing (OSF) fast track the examination of corresponding claims in a corresponding application filed in the OSF. Examination in the second office may be fast tracked to speed

up the examination process and thereby lower costs of the second application. Examination will typically begin within two to three months from the PPH petition being granted (as long as the preliminaries are completed), which provides a greater efficiency for examination.

An applicant is eligible to request expedited review through the PPH once allowable claims have been identified by the OFF. The claims of the application filed in the OSF must correspond to the allowable claims in the OFF application. Once an allowance has been received, the applicant may file a request for PPH in the OSF. If the applicant is filing an application with the U.S. Patent & Trademark Office (USPTO) as the OSF, then a petition to make special may be filed with the application. The petition should be filed before substantive examination at the OSF begins, however the request may be filed when the applicant chooses. Once the petition is accepted, the applications examination may be accelerated. The examiner at the OSF will examine the application in view of the local patent laws, but may utilize the OFF’s work product, including notice of allowance and/or search reports.

In a variation, the PCT-PPH program utilizes Patent Cooperation Treaty (PCT) work product as the basis for accelerated examination. For instance, depending upon the International Searching Authority being used, accelerated examination may be requested utilizing a Written Opinion established and/or an International Preliminary Examination Report.

Revised PPH requirements were published on July 15, 2011, as part of the so-called MOTTAINAI pilot program. Designed to

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make the PPH more useful (the Japanese word, “mottainai,” refers to a sense of regret from wasting a resource), this program was implemented by a number of patent offices.

Among other changes, the revisions implemented by the MOTTAINAI program eliminated the OFF and OSF relationship, broadened the definition of “sufficient correspondence,” and eased the requirements for entering the PPH. The OSF and OFF are now identified as an Office of Later Examination (OLE) and an Office of Earlier Examination (OEE), respectively. The OLE may use examination results of the OEE as long as the OLE and the OEE have an agreement on revised requirements and the applications have the same priority/filing date. The claims of the application must be the same or similar in scope, or the claims must be narrower.

GLOBAL PPH AND IP5

On January 6, 2014, the Global PPH and IP5 programs were initiated. Both programs generally utilize the same criteria for examining applications and are only different as to which countries participate.

Global PPH

[USPTO \(US\)](#)

[JPO \(Japan\)](#)

[KIPO \(Korea\)](#)

[UKIPO \(United Kingdom\)](#)

[PRV \(Sweden\)](#)

[NPI \(Nordic Patent Institute\)](#)

[DKTPO \(Denmark\)](#)

[CIPO \(Canada\)](#)

[LPO \(Israel\)](#)

[SPTO \(Spain\)](#)

[IP Australia](#)

[HPO \(Hungary\)](#)

[ROSPATENT \(Russia\)](#)

[IPO \(Iceland\)](#)

[NBPR \(Finland\)](#)

[INPI \(Portugal\)](#)

[NIPO \(Norway\)](#)

IP5

[USPTO \(US\)](#)

[EPO \(Europe\)](#)

[SIPO \(China\)](#)

[JPO \(Japan\)](#)

[KIPO \(Korea\)](#)

In the participating offices, the Global PPH and IP5 programs supersede previous applicable versions of the PPH. For an application to be eligible for either the Global PPH or IP5 programs, the application filed at the OLE and the OEE must have:

- the same earliest priority date;
- the OEE must have allowed at least one claim;
- all of the claims presented for examination at the OLE must sufficiently correspond to the one or more claims found allowable by the OEE;
- the OLE must not yet have begun substantive examination of the application, and a request for substantive examination must have been filed at the OLE either at the time of the PPH request or earlier;
- depending on the OLE that the request is filed in, a petition fee may be required; and
- the OEE application must have been valid and must have been substantively examined for novelty and inventive step.

When filing a request under the Global PPH and IP5, the applicant must submit a completed request form, a copy of appropriate work product relevant to the allowability of the claims of the corresponding OEE application (for instance, examination reports, etc.), and a copy of the claims found to be allowable by the OEE if not available to the OLE. Additional information that may need to be submitted includes copies of citations raised against the OEE application if not available to the OLE, translations of any documents submitted and a claim correspondence table showing the relationship between the claims of the OLE application and the OEE application.

The Global PPH request will be considered promptly by the OLE and, if any deficiencies are identified, the applicant will be given at least one opportunity to correct the application within a specified period of time. Where a country participates in both the Global PPH and IP5 programs (i.e., the U.S., Japan and Korea), the applicant may file a PPH request based on work product of an office participating in either program.

Details of the Global PPH and IP5 programs may be found on the website of the USPTO at www.uspto.gov/patents/init_events/pph/, and on the website of the JPO at www.jpo.go.jp/ppph-portal/index.htm. PPH request forms may be found at the corresponding OLE website.

A SECOND LOOK

The Patent Prosecution Highway, in all its forms, has proven to be an effective tool, but may be more effective in certain countries. According to statistics provided by the JPO, the PPH can significantly improve both first action allowance rate and overall pendency of applications.

For instance, the first action allowance rate for a PPH (not including PCT-PPH) application versus all applications for the period of July to December 2013 was 27.1 percent versus 17.3 percent at the USPTO, 24 percent versus 16 percent in Japan, and 48.8 percent versus 10.5 percent in Korea.

And, during that same period, the pendency to final decision of such PPH applications versus all applications in the USPTO, Japan and Korea was, respectively, 4.4 months versus 18 months, 2 months versus 13 months, and 2.5 months versus 13.2 months.

Additional offices (e.g., UKIPO, IP Australia and others) have exhibited shortened application pendency, as well as an increase in first action allowance rate, while other offices (e.g., EPO) do not provide any statistics regarding pendency or first action allowance, making it difficult to quantify how effective the PPH is at the EPO.

Points to keep in mind when deciding whether to utilize the PPH include the potential for examiners to overlook possible application issues in an effort to expedite examination, which depending on the office, may have an effect on the presumption of validity of an allowed application. Additionally, the application at the OLE is limited to claims substantially the same as the claims from the OEE, so the application may be narrower in scope than if otherwise examined as a new application in each office. Finally, consider the possibility of integrating the PPH with other accelerated examination procedures at the OEE. For example, allowed claims in a U.S. patent application filed using Track 1 prioritized examination procedures may be used as the basis for PPH filings in other countries.

With revisions such as MOTTAINAI and PCT-PPH, and now the Global PPH and IP5 programs, the PPH is evolving and may be worth a second look as a tool to be used in your practice. ■

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