

# Global Patent Prosecution

October 2020



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The October 2020 issue of Sterne Kessler's Global Patent Prosecution newsletter discusses the factors you need to consider when filing strategies to protect your innovations in Asia and reviews the benefits for using the Patent Prosecution Highway program.

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## PROTECTING INNOVATION IN ASIA

By: [Paul A. Calvo, Ph.D.](#)

Business factors typically drive many strategy decisions in terms of patent prosecution in foreign jurisdictions. Factors that influence these decisions might include the likelihood of foreign competition, the size of foreign markets, as well as foreign manufacturing and/or licensing

strategies. Typically, the nature of the technology and local factors such the nature of the industry, and costs and enforceability of patents also play a key role. Thus, a great deal of information should be taken into account when considering filing strategies in Asia.

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## **PATENT PROSECUTION HIGHWAY: THE JPO AND USPTO**

By: Sarah Kelly and [Paul A. Calvo, Ph.D.](#)

Major patent offices around the world have long been aware of backlog and redundancy issues facing the global patent landscape. As previously [reviewed](#), the Patent Prosecution (PPH) program aims to accelerate examination among participating offices. Using PPH, participating patent offices have agreed that when an applicant receives a final notice from a first patent office that at least one claim is allowed, the applicant may request fast track examination of corresponding claim(s) in a corresponding patent application that is pending in a second patent office. Thus, the PPH leverages fast-track examination procedures already in place among participating patent offices to allow applicants to reach issuance in multiple regions more quickly and efficiently than through multiple standard parallel examinations.

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Business factors typically drive many strategy decisions in terms of patent prosecution in foreign jurisdictions. Factors that influence these decisions might include the likelihood of foreign competition, the size of foreign markets, as well as foreign manufacturing and/or licensing strategies. Typically, the nature of the technology and local factors such as the nature of the industry, and costs and enforceability of patents also play a key role. Thus, a great deal of information should be taken into account when considering filing strategies in Asia.

Asia can typically be broken down into four major geographic regions: (1) Northern Asia – which includes China, Taiwan, Japan and South Korea; (2) Western Asia – which includes Bangladesh, India, and Sri Lanka; (3) the ASEAN 10 or South East Asia – which includes Singapore, Malaysia, Indonesia, Thailand, Philippines, Vietnam, Brunei Darussalam, Cambodia, Laos and Myanmar; and (4) Oceania – which includes Australia and New Zealand. Importantly, Asia includes 3 out of the top 10 world economies, and 14 of the top 50, so it is important to recognize the continent's potential economic impact.

What then are best practices to effectively protect innovation in Asia? Utility models are an attractive option for protection in China, for example. Utility model patents, which have a 10-year term, are not substantively examined and are granted after a formal examination, which generally takes about one year. Unfortunately, only a small number of foreign applicants take advantage of utility models, but it is used extensively by Chinese applicants. It is important to note that filing utility model patents does not preclude filing of a utility patent and a good practice would be to include filing both utility and utility model applications.

Australia also offers an excellent way to accelerate prosecution and provides a potential springboard to accelerated prosecution globally. The Australian Patent Office provides for an expedited examination mechanism that requires no additional fees, in comparison to the USPTO. Since 2013, eligibility criteria for seeking expedited examination in Australia have been tightened, but criteria ultimately depend on the circumstances of the invention, as well as “commercialization considerations”, “infringement proceedings” or “licensing reasons.” For example, “green technologies” have been especially amenable to acceleration. Satisfactory reasons need to be set out in writing. Importantly, the accelerated grant can then be used to accelerate examination in a country where Australia has a patent prosecution highway arrangement. And since Australia is a member of the Global Patent Prosecution Highway, an Australian grant can be a springboard to acceleration in Austria, Canada, Denmark, Estonia, Finland, Germany, Hungary, Iceland, Israel, Japan, Norway, Poland, Portugal, Russia,

Singapore, Spain, South Korea, Sweden, the United Kingdom, the United States, New Zealand, Colombia, Peru, and Chile.

Moreover, the ASEAN Patent Examination Cooperation (ASPEC) is the first regional patent work-sharing program among nine participating ASEAN Member States (AMS) IP Offices of Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand, and Vietnam. Launched in 2009, ASPEC is an arrangement where a patent applicant that receives a favorable search and examination report in one ASPEC country can request that report be taken into account when examining the application in any of the other ASPEC member Offices. While not guaranteed in practice, the favorable report will most likely result in a favorable examination in the others. The program will potentially reduce duplication on the search and examination work done, thereby saving time and effort. ASPEC operates in the English language in all participating AMS IP Offices and is free-of-charge to the applicant at any participating IP Office.

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The PPH program coordinated by the Japanese Patent Office (JPO) has been a leading participant in the program. The PPH first began with a trial program between the USPTO and the JPO in July 2006. By January 2009, the effort between the JPO and the USPTO became the first fully implemented PPH program, with PPH programs between the USPTO and the UKIPO and the KIPO following.<sup>[i]</sup> Now 54 offices have implemented a PPH to increase efficiency with at least one office. The USPTO has a PPH with 35 offices, adding almost 10 in the last year alone.<sup>[ii]</sup> Since the first highway instituted in 2006, the USPTO has received 66,557 Total Applications with Petitions for PPH examination, of those, 58,650 were granted.<sup>[iii]</sup>

Over the past 5 years, the CNIPA, CIPO, KIPO, and JPO are by far the most used PPH programs with the USPTO as the office of first filing (OFF). Additionally, when the USPTO is the Office of Second Filing (OSF) nearly one-third of requests for PPH requests indicate JPO as the OFF.<sup>[iv]</sup>

From the applicant's perspective, cited benefits include a higher speed to grant (thereby improving predictability and certainty), as well as cost savings by reducing the prosecution tasks in each jurisdiction. If all requirements are met, patent prosecution of a PPH application runs considerably faster with fewer office actions per disposal, reduced RCE filing rates, and reduced appeal rates than non-PPH applications. All at no additional charge to regular fees.<sup>[v]</sup> On average, applications from a higher grant rate compared to standard applications.<sup>[vi]</sup> In some countries, the difference is staggering (e.g. CIPO: 92% PPH grant v. 71% overall; IP Australia 100% vs. 52% overall).

Further, in the rapidly growing markets of Korea and Japan, it may be increasingly advantageous to use PPH programs. At the JPO, PPH applications have an average pendency



of 2.6-2.8 months to first action, while overall applications have average 9.4 months. KIPO PPH applications have an average pendency of 2.5-2.9 months before first action, while overall application pendency is an average of 10.8 months until first action. Pendency to final decision is similarly accelerated with PPH applications in both countries.[vii]

However, notwithstanding these benefits, it should be remembered that ultimately the decision about whether to grant a patent remains under the control of the national Patent Office where individual patentability criteria might vary. Taking advantage of a PPH does not offer a guarantee of allowance. Nor does it allow for complicated claim strategies (e.g. where different prior art documents or different subject matter claims are available in different countries).

There are continuing benefits the initial PPH relationship put forth between the JPO and USPTO in 2006. In a recent joint statement from both offices, the directors underscored the importance of promptly establishing stable patent rights, especially in light of the COVID-19 pandemic. The importance of the PPH program was also highlighted along with the U.S.-Japan Collaborative Search Pilot Program; and the Global Dossier Initiative.[viii]

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[i] Current details on the PPH programs available with the USPTO are available at the USPTO website at <https://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

[ii] View all participating offices here <https://www.jpo.go.jp/e/toppage/pph-portal/network.html>; Note, offices may have different requirements and procedures so it is best to evaluate guidelines on the website of the relevant office.

[iii] As of June 30, 2020 <https://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

[iv] <https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html>

[v] Notice Regarding the Elimination of the Fee for Petitions To Make Special Filed Under the Patent Prosecution Highway (PPH) Programs <https://www.govinfo.gov/content/pkg/FR-2010-05-25/pdf/2010-12471.pdf>

[vi] <https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html> (most recent dataset from July-Dec 2019)

[vii] <https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html>

[viii] Joint message from the USPTO and the JPO: For the future of innovation: <https://www.uspto.gov/about-us/news-updates/joint-message-uspto-and-jpo-future-innovation>

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