

Global Patent Prosecution

May 2019



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A Snapshot and Strategic Use of the Patent Prosecution Highway (PPH)

The Patent Prosecution Highway (PPH) program accelerates examination among participating patent offices. As a no fee alternative for accelerated prosecution, the program is an attractive option to avoid duplicative efforts of the patent office of various jurisdictions. While typically a speedy process, the PPH is not without its potential pitfalls. The April issue of the Global Patent Prosecution Newsletter provides background on the PPH program and focuses on strategic use.

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PATENT PROSECUTION HIGHWAY (PPH) SNAPSHOT

By [Christian A. Camarce](#) and [Karen Wong-Chan](#)

The Patent Prosecution Highway (PPH) program accelerates examination among participating patent offices. The PPH program first began as a trial program between the U.S. Patent and Trademark Office (USPTO)

and the Japan Patent Office (JPO) in 2006, to avoid duplicate work efforts and expedite patentability decisions between patent offices. [1]

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STRATEGIC USE OF THE PATENT PROSECUTION HIGHWAY

By [Paul Calvo](#)

At last count, there are 27 Global and IP5 Patent Prosecution Highway (PPH) participants with the U.S. Patent and Trademark Office (USPTO). Since the PPH provides a no fee way to speed up the examination process for corresponding applications filed in participating intellectual property offices, it is a very attractive mechanism for accelerating examination of applications.

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By [Christian A. Camarce](#) and [Karen Wong-Chan](#)

The Patent Prosecution Highway (PPH) program accelerates examination among participating patent offices. The PPH program first began as a trial program between the U.S. Patent and Trademark Office (USPTO) and the Japan Patent Office (JPO) in 2006, to avoid duplicate work efforts and expedite patentability decisions between patent offices. [1] Since then, the program has grown to include over 40 patent offices, including the European Patent Office (EPO), Korean Intellectual Property Office (KIPO), China National Intellectual Property Administration (CNIPA), and Canadian Intellectual Property Office (CIPO). This article discusses a brief overview of the PPH program and surveys PPH activity in participating patent offices.

Brief Overview

Under the PPH program, when an applicant receives a final ruling that an application with at least one claim is determined to be patentable at a first patent office (“office of earlier examination”), the applicant can request accelerated examination of corresponding claims in a corresponding application pending in a second patent office (“office of later examination”). As compared to standard examination, the office of later examination can leverage search results and analysis performed by the office of earlier examination, thus resulting in a speedier final disposition (e.g., issuance of a Notice of Allowance) of the application at the second patent office.

In addition to receiving the final ruling indicating that at least one claim is patentable, the PPH program has other requirements. A notable requirement is the submission of claims to the office of later examination that sufficiently correspond to those found allowable by the office of earlier examination. Another notable requirement is that examination of the subject patent application by the office of later examination must not have begun. [2]

Survey of PPH Activity in Participating Patent Offices

Table 1 shows the top five patent offices of earlier examination under the PPH program through June 2018. [3] The JPO has received the most PPH requests—as the office of earlier examination—at approximately 70,000 requests, followed by the USPTO at approximately 55,000 requests. The EPO, KIPO, and CNIPA each received less than half of the requests received by the JPO and USPTO at approximately 20,000, 15,000, and 5,000 requests, respectively.

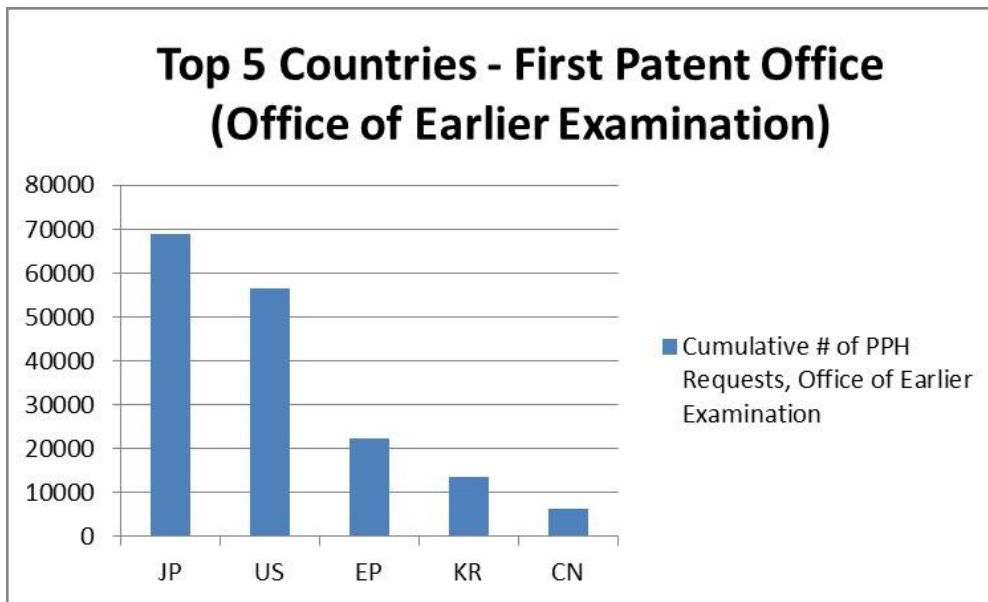


Table 1

Table 2 shows the top five patent offices of later examination through June 2018. [3] The USPTO received the most PPH requests—as the office of later examination—at over 50,000 requests. As the office of later examination, the number of PPH requests received by the USPTO nearly doubles (or even triples) the number of requests received by each of the CNIPA (approximately 27,000 requests), JPO (approximately 25,000 requests), KIPO (approximately 20,000 requests), and CIPA (approximately 15,000 requests).

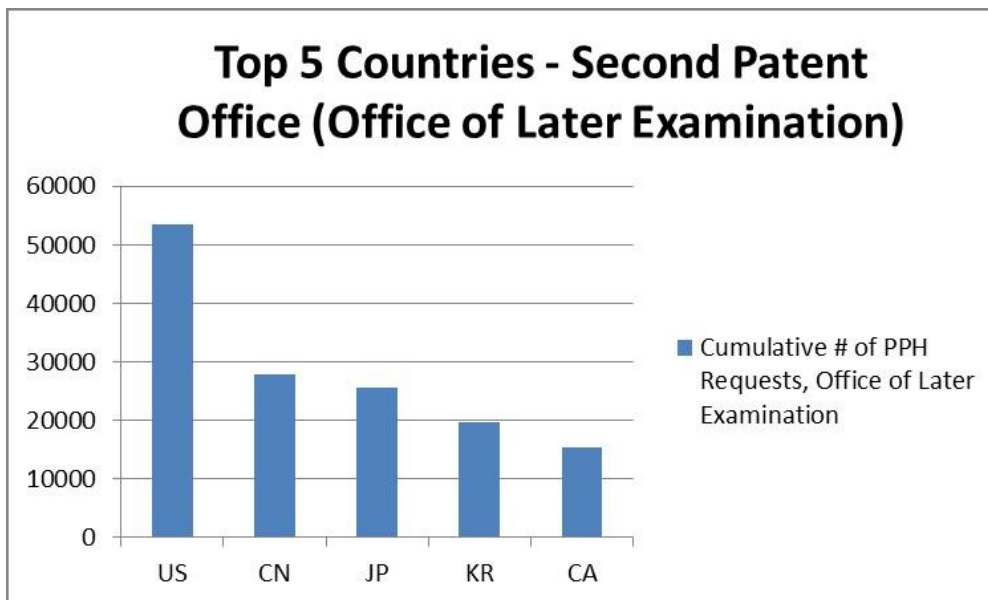


Table 2

Table 3 shows the top 10 PPH filing countries and office of earlier examination/office of later examination combination. [3] The JPO/USPTO combination received the most PPH requests—with the JPO being the office of earlier examination and the USPTO being the office of later examination—receiving over 20,000 PPH requests. This number of PPH requests is over 5,000 more requests received by each of the JPO/CNIPA (approximately 12,000 requests), USPTO/CIPA (approximately 11,000 requests), and EPO/USPTO (approximately 10,000 requests) combinations. The USPTO/CNIPA, KIPO/USPTO, JPO/KIPO, and USPTO/KIPO combinations received approximately between 7,000 and 9,000 PPH requests. The JPO/EPO combination received approximately 5,000 PPH requests.

Top 10 Patent Prosecution Highway (PPH) Filing Countries (June 2018)

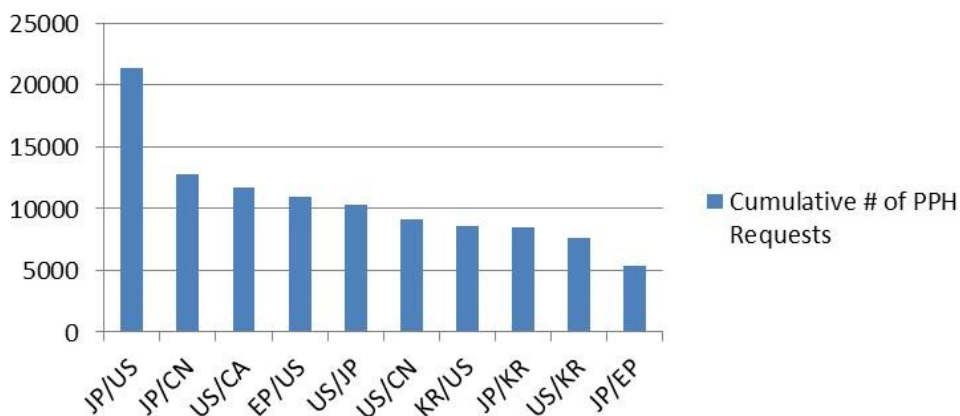


Table 3

The above discussion indicates that the patent offices with the most PPH activity are the JPO and USPTO, with the JPO being the office of earlier examination receiving the most PPH requests and the USPTO being the office of later examination receiving the most PPH requests. The EPO, KIPO, CNIPA, and CIPA also receive a significant number of PPH requests. Thus, for applicants seeking patent protection in these jurisdictions, the PPH program may be a viable vehicle to obtain patents faster than by standard examination.

[1] <https://www.govinfo.gov/content/pkg/FR-2010-05-25/pdf/2010-12471.pdf>

[2] <https://www.uspto.gov/sites/default/files/documents/global-ip5.pdf>

[3] PPH data from June 2018— <http://www.jpo.go.jp/e/toppage/pph-portal/statistics.html>

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Strategies regarding the PPH need to be considered early on during prosecution. For example, identification of eligible pairs of applications must be considered at the outset to avoid or mitigate issues relating to priority relationship between the applications, claim scope, and timing to take advantage of the PPH programs.

While typically a speedy process, the PPH is not without its potential pitfalls. For example, while an applicant may have an understanding of potential prior art issues raised in the earlier examination, it does not preclude a U.S. examiner from identifying additional prior art that was not considered by the earlier Office. And if new art objections are raised, the art must be addressed by way of argument or amendment of the claims.

In many cases, it is the process of amendment that poses difficulty for applicants. If minor claim amendments are necessary, there is generally not a problem with ensuring that the claims sufficiently correspond to the earlier examined claims. The issues occur when more substantial edits, usually narrowing amendments, are required because the PPH amendment process does not always allow for the same type of amendment practice during typical patent prosecution. These issues arise because of the requirement that sufficient claim correspondence must be maintained not only at the time of PPH entry, but also when amending claims during prosecution of the U.S. application.

Introducing the limitations of a dependent claim into (typically) an independent claim is generally looked at favorably by the USPTO as long as the dependent claim was favorably treated by the earlier examination office. Incorporation of a limitation from the specification is typically problematic because the claims may not sufficiently correspond to the earlier examined claims. This is especially true if the added subject matter was not the subject of an earlier examined claim. So while the amended claim may be narrower, if the claims do not sufficiently correspond the amendment is non-compliant. And, unfortunately, the recourse for a non-compliant amendment is to file a continuation application, which then defeats the entire purpose of the PPH.

One way to avoid correspondence issues is by proactively introducing additional dependent claims into the U.S. PPH application prior to substantive examination. These added claims maintain sufficient claim correspondence by depending from a favorably reviewed claim. Once introduced by preliminary amendment, these claims can then be used to address any additional rejections raised by the USPTO.

The PPH program offers a great deal of benefits to applicants. By implementing a strategic use of PPH, applicants can take advantage of accelerated patent grant and the corresponding cost savings of prosecution, as well as significantly higher allowance rates compared to typical patent prosecution.

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