

Patent Prosecution Highway: The expanding network – update

1. What is it?

1.1 As previously described,^{1,2} the Patent Prosecution Highway (PPH) is a scheme involving cooperating national IP offices who aim to reduce work duplication through work sharing.

1.2 To applicants, it provides the possibility of reduced application pendency by expediting examination of pending applications on the basis of claims deemed allowable in a co-pending foreign application.

2. The Network

2.1 Following initial early engagement in the scheme from the United States Patent Office (USPTO) and the Japanese Patent Office (JPO), the number of countries participating in PPH programmes has grown to 14, with 28 bilateral highways in existence and more under consideration.^{3,4,5}

2.2 Figure 1 illustrates the extent of the PPH network currently in place.

2.3 The UK Intellectual Property Office (IPO) has implemented highways between the US, Japan and Korea, the UK IPO-USPTO and UK IPO-JPO programmes having now been extended indefinitely.

3. Involvement of the EPO

3.1 The European Patent Office (EPO), which was initially cautious of taking an active role in the PPH scheme, have launched a highway with the USPTO which commenced in September 2008, and more recently, with Japan in January 2010.

3.2 Use of the PPH with the USPTO is available on the basis of a positive search

opinion from the EPO⁶. This is a notable difference from existing highways, where PPH examination can only be based on a positive examination report. Here, 'positive' refers to the application having at least one claim deemed to be patentable/allowable.

3.3 As the EPO provides search opinions in around 6 months from filing, as compared with the 26 month period expected before issue of the first examination report from the USPTO, this highway may prove to be a very useful tool for applicants seeking accelerated prosecution in the US.

Thus for example:

A US applicant files a patent application at the USPTO, followed by an application at the EPO claiming priority from the earlier US application. During the EPO prosecution process, the Extended European Search Report (EESR) is issued approximately 6 months from filing. Should the EESR determine that the claims (or claims after amendment) of the application are patentable/allowable, a PPH request can then be made to the USPTO based on this. This effectively accelerates prosecution in the US, reducing the time to grant.

4. PPH based on PCT work products

4.1 The trilateral offices (USPTO, JPO and EPO) have recently launched a new pilot programme to utilise PCT work products (written opinion of the ISA or international preliminary examination report (IPER)), which commenced on 29 January 2010 for a period of two years⁷.

4.2 Under this programme, a PPH request may be made at one of the trilateral offices based on the latest PCT work product issued by another trilateral office, where the work product returns a positive view of the claims contained in the PCT application.

4.3 For instance, where the EPO is the International Search Authority and determines the claims (or claims after amendment) of a PCT application to be

¹ [The Patent Prosecution Highway Oct 07](#)

² [The Patent Prosecution Highway Update Apr 08](#)

³ [The Patent Prosecution Highway \(PPH\) Portal Web Site](#).

⁴ Patent Prosecution Highway; Japan Patent Office, United States Patent and Trademark Office (booklet).

⁵ [The Patent Prosecution Highway \(PPH\) Portal Web Site – Guidelines](#).

⁶ [Request for participation in PPH Pilot Program between EPO & USPTO](#)

⁷ [PPH Pilot Programme between the Trilateral Offices based on PCT work products](#)

patentable/allowable, the applicant can request accelerated examination before the JPO and USPTO when the application enters the national phase in these countries.

4.4 Where a PPH request is made based on national work products (for example an EESR in the case of the EPO), this is done by reference to the existing PPH bilateral agreements between the three offices.

5. Use of the PPH

5.1 As yet, little use has been made of the highways between the UK IPO-USPTO and UK IPO-JPO.

5.2 The number of applications being processed through the scheme is said to number in tens, although this has been increasing. Reasons put forward for the comparatively slow uptake include, a lack of awareness, and that the speed of grant is frequently of little concern to an applicant.

5.3 Current procedures for filing a PPH request vary from country to country. Therefore, the Plurilateral PPH Initiative has been proposed and is being discussed in an attempt to standardise requirements³. This is yet to be initiated.

6. Practice Notes/Advice

6.1 A PPH request can be made based on a US application at either of the EPO or UK IPO, in addition to 8 other offices with which the US has a bilateral agreement.

6.2 An EESR is issued by the EPO approximately 6 months from filing. This may be advantageous in accelerating prosecution in other countries where the time taken to issue an examination report may be considerably longer.

6.3 A PPH request may be filed at any of the trilateral offices based on a positive PCT work product issued from another trilateral office.

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