

Traveling the Highways of Patent Prosecution

Patent Prosecution Highway

The Patent Prosecution Highway (PPH) is designed to accelerate the examination process for applications filed in participating intellectual property offices.

The PPH is an agreement between participating patent offices that when a first patent office deems that an application has **at least one patentable claim**; the applicant may request a fast track examination of the corresponding claim(s) in a corresponding patent application pending at a second patent office. The PPH allows a final disposition of a patent application to be achieved more quickly and efficiently than through the standard examination process.

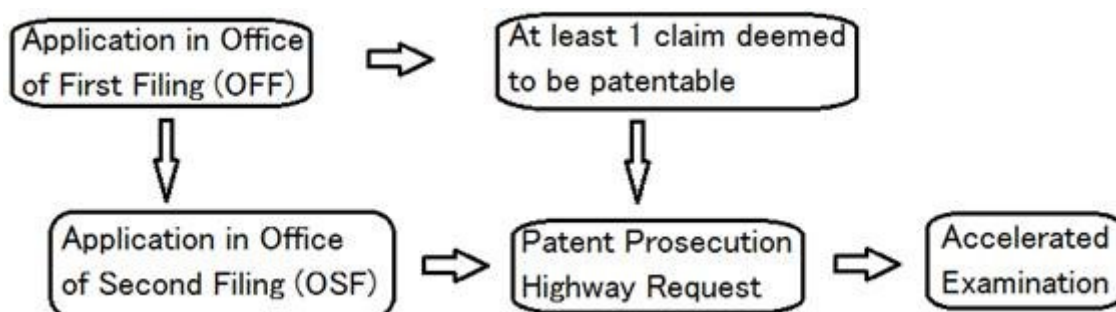
There are no additional fees under the PPH program.

PPH in Japan

The PPH began as a pilot program between the United States Patent Office (USPTO) and the Japan Patent Office (JPO), in 2006. In Japan, approximately 75% of PPH applications are granted (69% worldwide average), and the processing time is much faster than the worldwide average (7 months in Japan vs. 25 months worldwide). However, some PPH applications to the JPO have received a large number of office actions although the claims had been previously granted in another patent office.

The Patent Prosecution Highway allows for an application having at least one claim which has been deemed to be patentable by an Office of First Filing (OFF) to undergo an accelerated examination in an Office of Second Filing (OSF) based on bilateral office agreements. Through the PPH, an applicant may acquire patent rights at an early stage worldwide and the utilization of search and examination results between IP Offices is enhanced in order to reduce the burden of examination and to improve the quality of

examination worldwide.



The JPO has commenced a pilot PPH program using the PCT international work products (PCT-PPH). Under this program, an accelerated examination can be requested using the written opinion established by certain International Searching Authorities (WO/ISA), a written opinion established by certain International Preliminary Examining Authorities (WO/IPEA), or an international preliminary examination report (IPER) established by certain International Preliminary Examining Authorities.

Example of PPH Requirements and Procedures

A. Required Documents

1. Claims Correspondence Table
2. Copy of all claims and translations thereof
3. Copy of any OFF Office Actions (OA) and translations thereof
4. Copies of all documents cited in the OFF Office Actions

In some cases, it is only necessary to submit the Claims Correspondence Table. Please consult the guidelines of each office.

B. Basic Requirements

1. The OSF application must have a relationship with the OFF application. (For example, the OSF application validly claims priority under the Paris Convention to the

OFF application)

2. The OFF application must have at least one claim that was determined by the OFF (or a WO/ISA, WO/IPEA, or IPER) to be patentable.

3. The claim(s) in the OSF application must sufficiently correspond to a claim(s) that was (were) determined by the OFF (or a WO/ISA, WO/IPEA, or IPER) to be patentable.

4. The examination must not have commenced at the OSF. (Some offices do not adhere to this requirement. Please consult the guidelines of each office.)

C. Patent Prosecution Highway Petition Fees

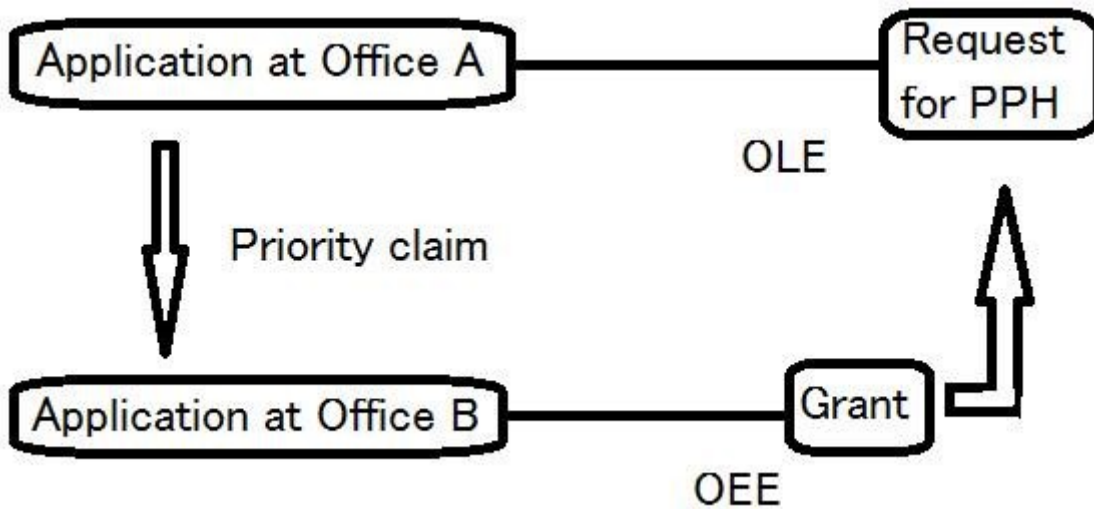
Generally free. Please consult the guidelines of each office.

PPH MOTTAINAI

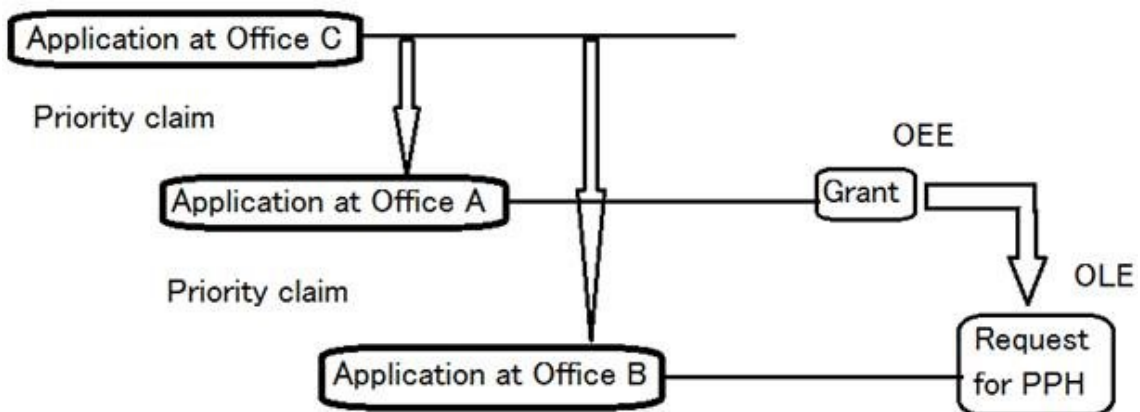
While requests for PPH have been increasing in recent years, the number of requests is still relatively low compared to the total number of patent applications being filed in the world.

According to the current PPH scheme, before another office can accept a PPH request, the Office of First Filing (OFF) must provide its examination results. This requirement delays PPH requests and the results of examinations conducted at one office cannot be fully utilized at subsequent offices, as the OFF has not always finished conducting their examination before the OSF can start performing their examination. The Japanese word "MOTTAINAI" means "wasteful" and clearly applies to this situation.

Therefore, eight offices agreed to launch a revised PPH, called the PPH MOTTAINAI Pilot, which enables applicants to make PPH requests at the Office of Later Examination (OLE) by using the examination results of the Office of Earlier Examination (OEE), provided that the OEE and OLE have a PPH MOTTAINAI agreement.



Case 1: OFF (Office A) receives examination results from OSF (Office B).



Case 2: OFF is an office other than Office A or Office B.

The PPH MOTTAINAI pilot was extended indefinitely in most bilateral PPH after July 15, 2012. Please refer to each office's website and PPH guidelines for further details. As the PPH MOTTAINAI pilot has been implemented through separate bilateral arrangements in place among the participating offices, each bilateral arrangement may be different from other agreements, as decided by the two participating offices. All other PPH arrangements in effect throughout the network of participating offices remain unaffected by the PPH MOTTAINAI pilot program.

For more information regarding specific bilateral arrangements, please visit the homepage of each office.

Country/Organization	PPH	Mottainai	PCT-PPH
United States (USPTO)	Y	Y	Y
European Patent Office (EPO)	Y	Y	Y
China Patent Office (CNIPA)	Y	Y	Y
Korean Patent Office (KIPO)	Y	Y	Y
Intellectual Property Office of Singapore (IPOS)	Y	Y	Y
Israel Patent Office (ILPO)	Y	Y	Y
Intellectual Property Office of the Philippines (IPOP HL)	Y	Y	Y
Department of Intellectual Property in Malaysia (MyIPO)	Y	Y	Y
Directorate General of Intellectual Property Rights (DGIP)	Y		Y
Taiwan Intellectual Property Office (TIPO)	Y	Y	
Department of Intellectual Property in Thailand (DIP)	Y		
Intellectual Property Office of Viet Nam (IP Viet Nam)	Y		
India Office of the Controller General of Patents, Designs & Trade Marks (CGPDTM)	Y*		
Egyptian Patent Office (EGYPO)	Y	Y	Y
UK-IPO	Y	Y	Y
German Patent and Trade Mark Office (DPMA)	Y	Y	Y
Danish Patent and Trademark Office (DKPTO)	Y	Y	Y
Finnish Patent and Registration Office (PRH)	Y	Y	Y

Federal Service for Intellectual Property, Patents & Trademarks of Russia (ROSPATENT)	Y	Y	Y
Austrian Patent Office (APO)	Y	Y	Y
Hungarian Patent Office (HIPO)	Y	Y	Y
Spanish Patent and Trademark Office (SPTO)	Y	Y	Y
Swedish Patent and Registration Office (PRV)	Y	Y	Y
Norwegian Industrial Property Office (NIPO)	Y	Y	Y
Icelandic Patent Office (IPO)	Y	Y	Y
Portuguese Institute of Industrial Property (INPI)	Y	Y	Y
Polish Patent Office (PPO)	Y	Y	Y
Eurasian Patent Organization (EAPO)	Y	Y	Y
Industrial Property Office of the Czech Republic (IPO CZ)	Y	Y	Y
State Office for Inventions and Trademarks of Romania (OSIM)	Y	Y	Y
Estonian Patent Office (EPA)	Y	Y	Y
Turkish Patent and Trademark Office (TURKPATENT)	Y	Y	Y
Nordic Patent Institute (NPI)			Y
Visegrad Patent Institute (VPI)			Y
Saudi Authority for Intellectual Property (SAIP)	Y		
Canadian Intellectual Property Office (CIPO)	Y	Y	Y
Mexican Institute of Industrial Property (IMPI)	Y	Y	Y
Superintendence of Industry and Commerce of the Republic of Colombia (SIC)	Y	Y	Y
National Institute of Industrial	Y	Y	Y

Property of Chile (INAPI)			
National Institute for the Defense of Free Competition and the Protection of Intellectual Property of Peru (INDECOPI)	Y	Y	Y
National Institute of Industrial Property of Brazil (INPI)	Y	Y	
National Institute of Industrial Property of Argentina (INPI)	Y	Y	
IP Australia	Y	Y	Y
Intellectual Property Office of New Zealand (IPONZ)	Y	Y	Y

Table 1: Countries with which Japan has at least one PPH agreement

Link to forms and further information for countries participating in any PPH program with the JPO:

(<https://www.jpo.go.jp/e/system/patent/shinsa/soki/pph/>)

Global Patent Prosecution Highway

The Global Patent Prosecution Highway (GPPH) pilot was launched on January 6, 2014 with the aim of further simplifying the requirements of the PPH in participating offices. The GPPH and the IP5 PPH (discussed later) programs have essentially replaced existing PPH programs in participating offices.

The GPPH pilot allows patent applicants to request an accelerated examination at any of the offices involved in the pilot if the claim(s) has (have) been found to be acceptable by at least one of the other patent offices involved in the pilot.

The pilot is intended to simplify and improve the existing PPH network so that it is easier for users to access.

Framework Provisions for the Global Patent Prosecution

Highway System

The participating offices will evaluate and exchange information on the effectiveness of the GPPH pilot, and modifications to the GPPH pilot may be made based on the results.

New patent offices are eligible to join the GPPH pilot on January 6th or July 6th. Additionally, offices participating in the pilot may limit or terminate their participation in the GPPH pilot at any time by providing written notice at least one month prior to the date of withdrawal.

GPPH - Important Points

Under the GPPH pilot, a request for an accelerated examination can be made at any participating office, from any one of the other participating offices with the proviso that the following eligibility criteria (see "Eligibility Requirements" section below) are met.

The participating offices may, upon their discretion, develop office-specific guidelines based on their legal terminologies and processes, and may expand the Eligibility Requirements as they see fit. The Eligibility Requirements are designed to be a standard to be adhered to by offices participating in the GPPH pilot so as to establish a uniform system for applicants. Essentially, if the GPPH pilot specific requirements below are satisfied, the application qualifies for PPH treatment.

Should two participating offices have a bi-lateral PPH arrangement; the guidelines of the Global PPH pilot will take precedence over those of the bi-lateral arrangement for the duration of the pilot.

Eligibility Requirements

Accelerated processing under the GPPH pilot may be undertaken for applications where the following requirements have been satisfied:

A) An application before an Office of Earlier Examination (OEE) and an Office of Later Examination (OLE) has the same priority date or filing date.

B) The OEE deems and indicates in an explicit statement in any substantive work product that an application has **at least one patentable claim**.

C) The claim(s) presented for examination under the GPPH pilot must sufficiently correspond to one or more of the claims found to be patentable by the OEE.

D) The OLE has not begun a substantive examination of the application.

E) A request for substantive examination must have been filed at the OLE, at any time up until the GPPH request is made.

Provisions for Participating Offices

Participating Offices may require that the OLE application is open to the public and may require the applicant to pay a fee for GPPH acceleration due to their respective legal requirements for accelerated processing.

For an OEE application to be valid as the basis for a GPPH pilot request, it must have been substantively examined, including the consideration of novelty and inventive step, by an OEE participating in the GPPH pilot.

Support documentation required for GPPH request

Participating offices will require the following documentation to support a request for acceleration under the GPPH pilot:

- 1) GPPH request form.
- 2) Copy of the work product(s) which are relevant to the allowability/patentability of the claim(s) of the corresponding OEE application, if not available via Dossier Access Systems.
- 3) Copy of the claims(s) which the OEE deemed to be allowable/patentable, if not available via Dossier Access Systems.

Participating Offices may also require the applicant to provide the following documentation:

- 1) Copies of citations in any Office Actions (OA) raised against the OEE application which are not available to the OLE via their regular databases or search files.
- 2) Translations of any of the support documentation listed above.
- 3) A claim correspondence table indicating the relationship between the claims of the OLE application and those of the OEE application that are deemed to be allowable/patentable.

If the participating office has difficulty in obtaining documents through the Dossier Access Systems and translations thereof, the applicant may be asked to submit such documents. The applicant may be required to submit manual translations of such documents owing to the poor quality of machine translations.

Consideration of a GPPH request

The OLE will handle all requests for accelerated examination under the GPPH. Should a request be found to be deficient, the OLE will inform the applicant of the deficiencies and the applicant will be provided with at least one opportunity to correct the application within a reasonable time limit.

IP5 PPH

The IP5 PPH Patent Prosecution Highway (IP5 PPH) pilot program was initiated on January 6, 2014 and is scheduled to run for a period of three years. This program involves the five largest patent offices: U.S. Patent and Trademark Office (USPTO), the Japanese Patent Office (JPO), the Korean Patent Office (KIPO), the China National Intellectual Property Administration (CNIPA, formerly known as "SIPO"), and the European Patent Office (EPO). The IP5 pilot program was designed to further harmonize and improve the PPH process

among these five patent offices, which handle over 90% of the patent workload worldwide.

Under this pilot program, a PPH request can be based on the latest PCT work product (written opinion of the ISA (WO-ISA) or international preliminary examination report (IPER)) prepared by one of the IP5 Offices as an ISA or IPEA, or on the national work product prepared during the processing of a national application or a PCT application that has entered the national phase at one of the IP5 offices. It has been deemed from the work product that at least one claim is patentable/allowable.

As with the PPH and GPPH, fast-track patent examination procedures already available at the offices may be employed to allow applicants to obtain corresponding patents faster and more efficiently. The IP5 PPH also allows each office to access and use the work previously performed and/or obtained by another office.

Differences between the Global PPH and the IP5 PPH?

In general, the requirements of the two programs are identical. Only the offices participating in the Global PPH and the IP5 PPH are different.

The USPTO, the JPO, and the KIPO are currently the only three patent offices that are members of both the Global PPH and the IP5 PPH programs.

As the USPTO, the JPO, and the KIPO participate in both programs, a USPTO, a JPO, or a KIPO applicant may participate in the PPH based on the work product of any patent office that is a member of either the Global PPH or the IP5 PPH. In this case, only a single Global PPH/IP5 form is used, and the applicant is not required to state under which pilot program the request is being made.

Merits of Requesting GPPH or IP5 PPH

A) Accelerated Examination

1) Average pendency until First Office Action is 2 (two) months, which is more than 6 (six) times faster than for all applications (PPH and non-PPH) at the JPO.

2) Average pendency until Final Decision is approximately 7 (seven) months, which is approximately 3 (three) times faster than for all applications (PPH and non-PPH) at the JPO.

B) Decreased Number of Office Actions

1) The number of Office Actions issued to applications for which PPH was requested is 10% less than for all applications (PPH and non-PPH) at the JPO.

- Fewer Office Actions reduces the costs to the applicant.

C) Increase in Grant Rate

1) While not as high as the grants rates for the United States, the Russian Federation, Mexico, Great Britain, etc., the grant rate for applications for which PPH was requested is about 4% higher than for all applications (PPH and non-PPH) at the JPO.

As the Office of Earlier Examination already deemed the claim(s) to be patentable, PPH applications tend to be granted faster, with fewer Office Actions, and at a higher rate. Together, the GPPH and the IP5 PPH programs eliminate the confusion generated by the use of different systems (PPH, PPH MOTTAINAI, and the PCT-PPH) between offices.

From 2012-2017, the number of PPH application requests worldwide have surged from 13,517 to 30,641. Much of this may be attributed to the number of bilateral PPH agreements, pilot projects, and a general push by patent offices worldwide to disseminate information regarding the existence and the merits of the PPH systems. In Japan, Canada, the US, and Korea, PPH applications obviously showed faster FA pendency than applications prosecuted through the normal application processes at each country's patent office, the patent grant rates and, in particular, the patent grant rates

in the first actions issued by the respective patent offices were all higher than for applications prosecuted through the normal application processes at each country's patent office.

July - December 2019	All Applications	National PPH	PCT PPH
Patent Grant (%)	75	81	92.7
First Action Allowance (months)	14.2	19.8	43.4
Pendency PPH request to First Action (months)	9.4	2.6	2.8
Pendency PPH request to Final Decision (months)	14.3	7.3	5.3
Number of Office Actions	1	1	0.7

Table 2: Patent Prosecution High Requests and Examination Results.

For the 6-month period from July 2019 until December 2019, comparative data regarding national phase PPH applications, PTC-PPH applications, and all applications submitted to the Japan Patent Office