

The Patent Prosecution Highway

The Patent Prosecution Highway (PPH) offers a system through which patent prosecution can be accelerated in one participating jurisdiction provided the claims of interest have been found to be acceptable in another participating jurisdiction.

Summary

The PPH is designed to offer applicants a [faster route to patent allowance](#), and to allow patent offices to [share their workloads by reusing search and examination results](#) available from another participating patent office. If the claim(s) of interest have been found to be acceptable by a participating first patent office in one jurisdiction, accelerated examination of corresponding claims at the second patent office in another jurisdiction may be requested, provided the requirements of the PPH agreement are satisfied.

[It is important to note that the PPH can only offer accelerated prosecution](#); it does not provide a presumption that the claims are allowable or offer a guarantee of allowance, nor does it allow substantially different claims to be prosecuted in different countries. Accordingly, although one of the aims is to allow the second patent office to make use of the search and examination carried out by the first patent office, in practice we have found that the second patent office still considers whether the application meets the patentability requirements of its own country, which often entails carrying out its own additional search and examination.

The PPH appears to be meeting its objective of accelerating prosecution. As an example, the average pendency to receipt of a first office action has reduced from 18 months to 4.4 months at the US

Patent and Trademark Office (USPTO) and from 13 months to 2 months at the Japan Patent Office (JPO) where a PPH request was made. The average time between filing a PPH request and receiving the final decision has reduced from 29 months to 14 months at the USPTO and from 22 months to 6.7 months at the JPO¹. Accordingly, [although the PPH allows examination to start earlier, subsequent examination in the US using the PPH appears to take a similar length of time to standard examination without the PPH](#).

Who takes part in PPH?

The PPH is not available in all countries; it is available only where an agreement exists between the patent office in the country of interest and another patent office which has already deemed one or more claims in a corresponding application to be allowable.

Traditionally, the PPH has been made up of a web of patent offices having various bilateral agreements. For example, the UK Intellectual Property Office (UKIPO) currently has a bilateral PPH agreement with the German Patent and Trade Mark Office (DPMA). This is currently only a pilot project, with an agreed duration of three years from 1st March 2012². The UKIPO has also started preparations to

put into place a bilateral PPH agreement with the Chinese State Intellectual Property Office (SIPO). The PPH between the UKIPO and the SIPO is due to be made available later this year³.

The UKIPO also has bilateral PPH agreements with patent offices in a number of other countries. However, on 6th January 2014, these other bilateral agreements were superseded by the [Global PPH \(GPPH\) pilot](#) for the duration of the pilot. The GPPH allows patent applicants with one or more allowable claims in any of the participating GPPH offices to expedite examination in some or all of the other patent offices involved in the pilot, as all participating offices will evaluate the PPH request based on the same set of agreed criteria. Separate PPH requests in each country of interest will, however, be required. Currently, the patent offices of the following 17 countries are involved in the GPPH pilot: Australia, Canada, Denmark, Finland, Hungary, Iceland, Israel, Japan, Korea, Nordic Patent Institute, Norway, Portugal, Russia, Spain, Sweden, United Kingdom and the United States of America. More patent offices may join should they wish to do so. Offices participating in the pilot are able to limit or end their participation in the GPPH pilot at any stage by giving written notice not less than one month prior to the date

1. See data for period July 2013 to December 2013 at www.jpo.go.jp/ppph-portal/statistics.htm

2. www.ipo.gov.uk/types/patent/p-applying/p-after/p-pph/p-pph-dpma.htm

3. www.ipo.gov.uk/about/press/press-release/press-release-2013/press-release-20131205.htm

of withdrawal. Any pre-existing bilateral PPH agreements between countries participating in the GPPH have been superseded by the GPPH agreement during the pilot.

Notably, the European Patent Office (EPO) is not part of the GPPH pilot. However, it is participating in the “IP5” PPH pilot in conjunction with the other IP5 offices: USPTO, JPO, Korean Patent Office (KIPO) and SIPO. The IP5 PPH pilot supersedes the EPO’s existing bilateral PPH agreements with the USPTO and JPO for the duration of the pilot. The IP5 pilot commenced on 6th January 2014 and is due to run for a period of three years, although it is possible for participating countries to withdraw before the end of this period, should they wish to do so.

Requirements for entry into PPH

Under the previous bilateral PPH agreements, the requirements for PPH differed between the various countries. However, the GPPH and IP5 PPH pilots have introduced a standard set of requirements which make it simpler for applicants to assess whether their application is eligible for the PPH and to enter the application into the PPH. The offices may also adopt a limited number of optional supporting documentation and fee requirements, should they wish^{4,5}. The PPH agreement between the UKIPO and the DPMA in Germany has similar, but not identical, core eligibility and supporting documentation requirements

4. www.jpo.go.jp/ppph-portal/globalpph.htm
5. www.epo.org/law-practice/legal-texts/official-journal/information-epo/archive/20131218.html

to those for the GPPH and IP5 PPH. The requirements for the PPH between UKIPO and SIPO have not yet been announced and may be more restrictive than those of the GPPH and IP5 PPH.

Accordingly, since there may be some additional requirements for PPH in different jurisdictions, it is important to check the particular agreement before making use of the PPH.

More information on PPH

The PPH is coordinated by the JPO. More information, including the individual agreements between offices involved, as well as information on the recently launched GPPH pilot, and the requirements for eligibility and supporting documentation can be found on their [website](#).

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Need advice?

For more information, please contact email@carpmaels.com.

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