

The Patent Prosecution Highway: FAQs

The UK Intellectual Property Office (UKIPO) recently [announced](#) that its Patent Prosecution Highway (PPH) pilot programme with the State Intellectual Property Office of China (SIPO) will be extended indefinitely.

This programme forms a strand of the wider PPH experiment, which has now been running for over ten years. Although most patent applicants have, in that time, become familiar with the concept of PPH, many potential users have unanswered questions about its mechanics and are yet to route any of their patent applications along it. We have therefore given answers to some of the most common questions on PPH below.

What is the PPH?

The name might conjure up mental images of a long, straight road carrying a patent family serenely towards grant, but the reality of the PPH is more like an interconnected national road network: two multi-lateral pilot schemes, the IP5 and GPPH, act as motorways between the biggest offices with a complex web of bi-lateral agreements forming the A- and B- roads joining the remainder. While the patent offices of Japan, Korea and the US are members of both pilot schemes, the UKIPO is a member only of the GPPH whereas the SIPO, along with the European Patent Office, is a member only of the IP5, hence the need for the

continued bilateral agreement between these two offices. Although the complex web formed by the current PPH system may look inaccessible to the uninitiated, experienced users can quickly identify the spider in its middle; the case whose grant will allow the prosecution of all of its brothers and sisters to be accelerated (hint: if the family has a Japanese case, it is that one).

What does it do?

Attention-grabbing press releases tell patent applicants that the PPH will allow them to enjoy “expeditious, inexpensive and high-quality” examination. In practical terms, the PPH simply involves search and examination work products of a first office that has decided to grant a patent being passed to offices yet to examine other applications in the same family. These “offices of later examination” then accelerate their own examination of the application, taking into account the first office’s work but without being bound by its findings. However, many patent office examiners have already been looking at the work of their overseas

counterparts via the various online files that are available; on one level the PPH merely codifies that process.

Does it work?

Yes, at least in some ways. While the PPH certainly does give applicants a further effective option for expediting prosecution of their applications (alongside, for example, the UKIPO’s Green Channel), there is no guarantee it reduces costs or increases quality. Indeed, just because a first office has found a case allowable does not mean an office of later examination will agree; using the PPH can have the effect of accelerating a case into a wall (that, admittedly, it was going to hit eventually). Nonetheless, as well as showing that PPH users can (predictably) expect an earlier first office action, fewer office actions, and an earlier final decision, the available statistics also suggest a higher grant rate for cases that have travelled the PPH. Whether the resulting patents were cheaper to obtain, or of higher quality (whatever that subjective term is intended to mean), is an open question.

Are people using it?

Yes! By the end of December 2015, over 100,000 PPH requests had been filed worldwide. Unsurprisingly, given its position at the centre of the PPH infrastructure, Japan's patent office formed the first office for almost half of those requests. The UKIPO was the 7th most popular first office, behind only the offices of the IP5 and Canada.

Should I be using it?

Good question. There may be strong reasons to keep your applications pending as long as possible, such as deferment of costs or maintaining uncertainty for your competitors. However, if you feel you have a good case and are seeking grant as soon as possible then, as long as you do not mind front-loading some costs, it seems you have little to lose by using the PPH. After all, regardless of whether it achieves the benefits quoted in press releases, if it convinces those setting patent budgets that steps are being taken to manage patent families more efficiently by exploiting positive examination results then, at least on one level, the PPH "works".

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Need advice?

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