Important changes to Patent Prosecution Highway (PPH) practice at the U.S. Patent and Trademark Office (USPTO) and other intellectual property offices around the world took effect on January 6, 2014. The world’s five largest IP offices – the USPTO, the European Patent Office (EPO), the Korean Intellectual Property Office, the Japan Patent Office, and the State Intellectual Property Office of the People’s Republic of China (collectively, the “IP5”) – launched a new PPH pilot program (referred to as the “IP5 PPH”). Simultaneously, and with the inclusion of three IP5 members, thirteen intellectual property offices launched a similar pilot program titled the “Global PPH” pilot program. The Global PPH pilot program includes the national offices of the United States, Japan, South Korea, Australia, Canada, Denmark, Finland, Norway, Portugal, Russia, Spain, United Kingdom, and the Nordic Patent Institute.

These changes signal the end of myriad existing bilateral PPH programs between the IP5 nations and the thirteen Global PPH nations, such as the EPO-USPTO PPH agreement that is set to expire on January 28, 2014. The former bilateral PPH programs between the IP5 and Global PPH nations will be incorporated into the IP5 and Global PPH pilot programs. According to the USPTO, under the new pilot programs, “any earlier, positive results by any of these offices is now available as a basis for PPH at USPTO, so long as the applications share a common earliest date and support the claimed subject matter—be it PCT or national office products.”

PPH programs have long been lauded as avenues for reducing inefficiencies in patent examination procedures. Theoretically, PPH programs allow resource and work-sharing between offices, thereby decreasing the amount of duplicate searching and examination conducted at participating offices. Member offices utilize the search and examination results of an IP5 patent office’s priority application to accelerate the review of the application. That is, an applicant receiving a ruling from an IP5 office that at least one claim in an application is patentable may request, under the PPH, that the second IP5 member accelerate examination of the corresponding claims. The general rules for participation in the updated pilot programs have not yet been released by the USPTO but will likely be similar to previous PPH programs and require that priority is validly claimed, that at least one claim is allowed, that the corresponding claim in the second application is substantially similar to the allowed claim, and that examination has not begun on the second application.

The new programs are intended to provide strategic opportunities for patent filers by increasing PPH filing opportunities. The USPTO has said that “[t]he strategic possibilities are countless for IP owners!” Other benefits of the updated pilot programs to patent practitioners come in the way of uniform standards, guidelines, and forms. According to the USPTO, the pilot programs “will have a single form and a common set of guidelines for all of the major offices which are now engaged with the USPTO in the PPH process.” This should benefit practitioners by
providing “a common form and common expectations from nearly all of the participating offices within this system.” Greater uniformity of process across participating offices could create additional cost savings in the form of saved attorney time.

In conclusion, patent owners should consider utilizing the PPH pilot programs as a method of reducing pendency time and also attorney and/or prosecution costs. While many patent filers are familiar with the PPH program in general, the new IP5 and Global PPH pilot programs simplify the process and could provide more strategic possibilities. Thus, new consideration should be given to utilizing the PPH programs in the U.S. and in other member nations.

This update was prepared by Nutter’s Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.

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