As many patent practitioners are doubtless aware, there is substantial redundancy in the prosecution of patent applications around the world. The Patent Prosecution Highway (PPH) is intended to reduce duplication of effort by allowing the patent office in a country of second filing to take advantage, at least partially, of the work of the patent office in the country of first filing. When a PPH alliance is in place, an office of second filing (OSF) can use the search results from the office of first filing (OFF) to accelerate their examination. Also, because only allowed claims from the OFF are eligible for examination in the OSF under the PPH, claim amendments have usually already been made to distinguish over any relevant prior art, further accelerating prosecution.

The PPH program first began with a trial program between the U.S. Patent and Trademark Office (USPTO) and the Japan Patent Office (JPO) in July 2006. The U.S. PPH program has since grown to include links with the United Kingdom (UKIPO), Korea (KIPO), Canada (CIPO), Australia (IPAU), Europe (EPO), Denmark (DKPTO), Singapore (IPOS), and Germany (DPMA). In January 2009, the effort between the JPO and the USPTO became the first fully implemented PPH program, with PPH programs between the USPTO and the UKIPO and the KIPO following since. Current details on the PPH programs available with the USPTO are available at the USPTO website at http://www.uspto.gov/web/patents/pph/index.html. Other pairs of patent offices have also implemented PPH programs, e.g., the JPO has established PPH programs with the KIPO, UKIPO, DKPTO, DPMA, National Board of Patents and Registration (NBPR) of Finland, and Russian Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT).

Value Of The PPH

Although some caveats will be discussed in more detail below, PPH programs seem to at least increase allowance rates and reduce a number of office actions. For example, the USPTO has reported a PPH application allowance rate of about 94%, or more than double the usual allowance rate, and the average number of office actions is approximately half that of other U.S. patent applications. The CIPO has reported that approximately 35% of the PPH applications were deemed allowable without an examiner’s report, and many of the remaining PPH applications resulted in an examiner’s report that merely required correction of informalities.

Requirements Of The PPH

Not every application is eligible for entry to an OSF through the PPH, and there are a number of requirements that must be met. First, the application must be an application claiming priority under the Paris convention, a National Stage of a PCT application, or a bypass continuation application. Second, the application must have at least one claim allowed by the OFF. Third, claims provided to the OSF must correspond in scope to the claims found to be allowable in the OFF. Fourth, examination of the application must not have yet begun in the OSF. If these initial conditions are met, then an applicant can file a Request for participation in the PPH program.
USPTO Example

If the USPTO is the OSF, then in addition to the Request for participation in the program, the applicant must also submit an appropriate petition to make special and the required petition fee, copies of all office actions from the OFF that are relevant to patentability, including translations if the office actions are in a foreign language, a table that indicates the correspondence between each claim in the OSF application with an allowed claim from the OFF, and an information disclosure statement listing all the documents cited by the OFF. When the OFF is the EPO or JPO, the applicant can request that the USPTO obtain documents such as office actions and cited references electronically via the Dossier Access System. The USPTO will then review the submission and give the applicant one chance to bring the application into compliance if it is found lacking.

If the Request for participation in the PPH program is granted by the USPTO, then the application will be examined in advance of earlier-filed applications by a supervisory patent examiner. The examiner will then issue an office action indicating allowable claims; other claims will be rejected or objected to with written arguments as in normal examination. The applicant can then respond as usual, with the limitation that any amendments must still correspond to one or more allowable claims from the OFF as shown in a new correspondence table filed with the amendment.

EPO Example

It is important to note that as of the date of this article, the EPO-USPTO PPH is still a trial program. It is also important to note that the EPO PPH program is not open to ex-PCT applications that have entered the European phase. Unfortunately, this excludes the majority of applications with a U.S. priority claim that are eventually filed in the EPO. For an eligible application filed in the EPO, an applicant will be invited to amend the claims of their pending European patent application to conform to the claims of a corresponding U.S. patent that has issued or is about to issue. As in the U.S., the original or amended claims in the European application must sufficiently correspond in scope to the patentable/allowable claims in the USPTO application and a claims correspondence chart must be filed indicating the correspondence between the European application claims and the allowable claims in the U.S. application.

The applicant must also submit copies of all office actions from the USPTO that are relevant to patentability and copies of all the documents cited in the USPTO office action except for European patents of published European applications. However, if these documents have already been filed in the U.S. application before the Request for participation in the PPH program, they do not need to be resubmitted. Instead, the applicant may simply refer to them in the Request for participation indicating when the documents were previously filed in the U.S. application. When the Request for participation in the PPH program is granted by the EPO, the European application will be advanced out of turn for examination and processed under the “programme for accelerated prosecution of European patent applications,” or PACE.
Examples Of The PPH With Other Patent Offices

When the USPTO is the OFF, a PPH Request can be filed in the OSF for fast-track examination of claims that correspond to the claims found allowable in the USPTO. Each OSF will then follow its own rules and practices during examination of the claims presented in the OSF application. Eligibility requirements and application procedures vary among PPH programs, and can even be different for the OFF and the OSF in the same PPH program. Different fast-track procedures may be carried out in each OSF, e.g., the JPO only accelerates the first round of examination to issue a first action within 2-3 months after the PPH request is filed (the usual average time is 26 months). It is therefore important to check current PPH requirements and procedures in each OSF of interest.

Risks And Rewards

There is necessarily a narrow window of opportunity for entry into a PPH program. The application must not have been filed so recently that prosecution in the OFF has not reached a successful conclusion or have been filed so long ago that examination has already begun in the OSF. Applicants wishing to take advantage of the PPH must therefore keep abreast of the prosecution status of related applications in the OFF and the OSF countries so that once a notice of allowance issues in an OFF, a request to enter the PPH can be made as soon as possible before an examination report or office action issues in the desired OSF.

There is also a risk that none of the claims allowed by the OFF under their patent laws and rules will be allowable under the patent laws and rules of the OSF. In fact, for some types of claims, there is a significant risk that there could be no allowable corresponding claim in the OSF. Applicants should also consider the possibility that amendments made during prosecution in the OFF could narrow the claims more than would be required in the OSF. For example, an amendment made during U.S. prosecution to overcome a rejection based on prior art under 35 U.S.C. §102(e) may not be required in the EPO where such a reference might not be considered prior art. Another example are the varying standards for obviousness and inventive step in different countries. There is also a concern that negative comments by the examiner in an OSF might be used during litigation against the patent granted in the OFF.

In effect, the applicant takes these risks, as well as giving up the chance to more carefully craft claim language and limit admissions in prosecution, in exchange for earlier examination and possible earlier enforceable patent protection. This trade off can be of particular interest in fast moving technologies such as computers and electronics, as well as for applicants involved in cross-licensing negotiations where the PPH can provide a means to secure rights to claims that, while possibly narrower, still read on a competitor’s products.

Effective PPH Strategies

Strategic approaches can be developed to maximize the advantages offered by PPH programs and to avoid or mitigate any potential disadvantages. At the outset, applicants must be aware of issues of subject matter, priority relationships between applications, claim scope, and timing in order to take advantage of PPH programs. Further strategic considerations include: identification of eligible pairs of OFF and OSF applications; identification of potential future OFF and OSF applications; the choice of a preferred OFF or OSF for a pair of applications; the
management of prosecution timelines to maximize the chance that a pair of applications will be eligible for PPH; identification of the subject matter, claims, and claim format suitable for each PPH program; and if appropriate, preserving the ability to protect other inventions or subject matter outside of PPH programs.

Another important consideration can be the development of a strategy based on continuation practice in the U.S. by which many of the disadvantages of the PPH can be eliminated. For example, in an unexamined U.S. patent application with claims to multiple inventions, the claims that correspond to allowable claims in an OFF application can be examined under the PPH, and the claims to other inventions could be filed in U.S. divisional and/or continuation applications to be prosecuted separately. In another example, an applicant with a U.S. application corresponding to allowable claims in an OFF application can file a continuation application from the U.S. application and request that the continuation application be examined under the PPH. Such a strategy can preserve the broader claims in the first U.S. application for conventional prosecution while accelerating prosecution of claims corresponding to the allowable OFF claims in the continuation application.

Conclusion

PPH programs offer important benefits such as accelerated patent grant, high allowance rates, and the potential for significant cost savings. An applicant wishing to learn how they can benefit from PPH programs should contact qualified patent counsel who can review their portfolio of patents and patent applications and identify strategies for maximizing the potential benefits of PPH programs.

This advisory was prepared by Nutter’s Intellectual Property practice. For more information, please contact your Nutter attorney at 617-439-2000.

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