

IP Guide to the Patent Prosecution Highway

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Agreements between some of the world's patent offices provide applicants with greater choice and certainty in their applications.

From humble beginnings in July 2006 as a one-year pilot agreement between the US Patent and Trademark Office (USPTO) and the Japan Patent Office (JPO), the Patent Prosecution Highway (PPH) has expanded into a full-fledged system of patent examination between more than 10 different patent offices.

Developed as a means to decrease repetition and redundancy in patent examination and lessen existing backlogs, the original programme between the USPTO and JPO was the first step toward the long-term goal of the Trilateral Offices – the USPTO, JPO and the European Patent Office (EPO) – of collaborating on and sharing patent search results. The basis for this theory was founded on an estimate that the Trilateral Offices account for about 80% of global patent applications annually, of which more than 200,000 are duplicated between the offices.

A Quicker Way to File

The PPH is now in effect via bilateral agreements between the USPTO and the JPO, the EPO, the patent offices of the UK, Korea, Canada, Australia, Germany, Denmark, Singapore and Finland; between the JPO and the EPO, the patent offices of Korea, the UK, Germany, Denmark, Finland, Russia, Hungary, Austria, Canada and Singapore; between Korea and the patent offices of Russia, Denmark, Finland and the UK; and between Finland and Hungary. In addition, a PCT-based programme is now available among the Trilateral Offices utilizing PCT work product. All the programmes operate on the same general model: an applicant with at least one allowed claim in the office of first filing (OFF) can use a simplified procedure to expedite examination of its patent application in the office of second filing (OSF). In addition, prosecution documents from the OFF (e.g., office actions, references and allowable claims) are substituted for the pre-examination search and other documents required for requests for accelerating examination in some other patent offices, including the USPTO. However, examination must not have begun in the OSF at the time expedited examination is requested and the applicant must conform the claims in the OSF to those allowed in the OFF.

The PPH has the potential to provide faster examination and a higher allowance rate for applicants who file applications in more than one PPH-participating country. For example, data for the USPTO-JPO PPH shows a dramatic decrease in the time to first action in the USPTO as the OSF from an average of 26 months to about three months, and a 40% decrease in the number of office actions, from an average of 2.9 actions to an average of 1.7 actions. In addition, higher allowance rates have resulted in both offices, with a staggering 94% allowance rate when the USPTO is the OSF (regular cases average 44.2%) and 65% when the JPO is the OSF (regular cases average 49%).

The current PPH programmes, however, provide much greater benefit to applicants using the USPTO as the OSF than as the OFF. The primary reason for this disparity is the long backlog at the USPTO. Historical data for the JPO-USPTO program are evidence of this problem: from July 2006 to March 2008, only 227 applicants used the USPTO as the OFF and the JPO as the OSF.

On the flip side, the addition of PPH programmes between the US and countries with accelerated examination procedures provides an interesting opportunity for US-based applicants who want to expedite examination in the US, as a possible alternative to the Accelerated Examination (AE) procedures put in place by the USPTO. As of August 2006, AE allows a patent application in the USPTO to be examined earlier, so long as the applicant pays an additional fee, conducts a qualifying pre-exam search and provides an examination support document (ESD) that includes a direct comparison of the claims to references identified in the search.

Alternatives for US-based Applicants

In the US, AE has been used infrequently due to admissions required about references disclosed in the search, the potential for inequitable conduct and the costs associated with the ESD and associated search. As an alternative, an applicant who desires expedited examination in the USPTO could first file a patent application in one of the PPH-participating countries (as the OFF) and then commence examination in the USPTO as the OSF.

Depending on the jurisdiction chosen as the OFF, the procedure may incur a similar cost and timeline as the AE, with the addition of a higher allowance rate, a second patent grant in the OFF and without the risk of inequitable conduct or damaging admissions typically associated with the ESD. However, to use the USPTO as the OSF via the PPH, the US claims must have comparable scope to those allowed in the OFF, and the procedure would need to be considered prior to filing the application. In addition, the cost involved is significant if the applicant has no intention of filing internationally or using the USPTO's AE procedure.

Another option for US-based applicants would be to first file an application via the Patent Cooperation Treaty (PCT), enter into the national phase as soon as possible and declare as the OFF the first PPH participating country to allow a claim, with all other national phase (participating) countries as OSFs. And under the newly introduced PCT-based PPH, the PCT itself could act as the OFF, with the OSF relying on claims indicated allowable in the Written Opinion or Initial Preliminary Examination Report.

Although most of the current PPH programmes are pilot agreements, they are likely to become permanent as per the programme between the USPTO and the patent offices of Japan and Korea. Similarly, while all of the current PPH programmes are bilateral only, work-sharing between international patent offices is on the rise. Indeed, discussions are underway among at least five PPH-participating countries to develop a multilateral treaty that would extend far beyond the current programmes. These discussions hearken back to the original goals of the Trilateral Offices, are reflective of the international nature of business and technology today and represent concrete steps toward international patent harmonisation and cooperation.

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