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## Take The Patent Prosecution Highway To Save Time And Money Patenting The Same Invention In Different Countries

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*Obtaining patents for the same invention in different countries can be a lengthy and expensive process. Most major patent offices now have Patent Prosecution Highway (PPH) programs that allow a patent applicant to accelerate the process by relying on a favorable result from one patent office to obtain fast-track examination in another, often with high allowance rates. Due to recent changes in existing PPH programs, and ongoing implementation of new programs, many patent applications are now eligible for one or more PPH programs. Given the potential benefits of the PPH, applicants seeking to patent the same invention in multiple countries should work with patent counsel to identify opportunities to save time and money using the PPH.*

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### Introduction

PPH programs offer streamlined procedures for avoiding some of the delays and costs associated with obtaining patent protection for the same invention in multiple countries. Each PPH program is an agreement between two patent offices, where a favorable result in one patent office allows the applicant to sidestep the usual procedures and accelerate the process in the second patent office. The program works as follows:

- The office of first filing (OFF) is the patent office that has found at least one claim to be allowable in a patent application or an issued patent (the OFF application).
- The office of second filing (OSF) is a partner patent office where an eligible corresponding application has been filed (the OSF application), but examination on the merits has not begun.

- A request to participate in the PPH program is filed in the OSF.
- After the PPH request is granted, the OSF application is advanced out of turn for examination of claims that correspond to the allowable claims of the OFF application, where the OSF may use the search and examination results of the OFF.

Many patent applications are now eligible to participate in one or more PPH programs because of recent changes in existing programs and implementation of new programs. Beginning in 2006, the United States Patent and Trademark Office (USPTO) established PPH programs with most major patent offices, including the European Patent Office (EPO), the Japanese Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Canadian Intellectual Property Office (CIPO), the United Kingdom Intellectual Property Office (UKIPO), IP Australia (IPAU), the Danish Patent and Trademark Office (DKPTO), the Intellectual Property Office of Singapore (IPOS), and the German Patent and Trademark Office (DPMA). At <http://www.uspto.gov/main/patents.htm> the USPTO provides a detailed description of each PPH program, as well as links to the corresponding PPH program description in each partner office. Other pairs of patent offices have also implemented PPH programs, e.g., the JPO has established PPH programs with the KIPO, UKIPO, DKPTO, DPMA, the National Board of Patents and Registration of Finland (NBPR), and the Federal Service for Intellectual Property, Patents, and Trademarks of Russia (ROSPATENT).

Participating patent offices have reported high allowance rates and fewer official actions for OSF applications approved for examination under the PPH (PPH applications). 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.<sup>1</sup> 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 resulting in an examiner's report were merely required to correct informalities.<sup>2</sup>

Thus, applicants can benefit from PPH programs by obtaining a patent in the OSF months if not years sooner than under usual procedures, which saves money by avoiding duplicative searching and examination in the OSF. The high allowance rates reported for PPH applications provide further benefits and savings. Participating patent offices benefit by reducing the initial search and examination burdens in the OSF, thereby promoting efficiency, consistency, and quality of examination.

### PPH in the USPTO

When the USPTO is the OSF, an unexamined U.S. non-provisional utility patent application<sup>3</sup> can claim priority to an OFF application directly under the Paris Convention, or by way of a Patent Cooperation Treaty (PCT) international application, either as a U.S. national stage application of the PCT application, or as a "bypass" application, i.e., a continuation of a pending PCT application designating the U.S. Detailed descriptions of the eligibility requirements for U.S. applications, with helpful diagrams illustrating allowable priority claims for each PPH program, are available at <http://www.uspto.gov/main/patents.htm>.



<sup>1</sup> Patent Public Advisory Committee Annual Report, December 1, 2008; [www.uspto.gov/web/offices/com/advisory/reports/ppac\\_2008annualrpt.pdf](http://www.uspto.gov/web/offices/com/advisory/reports/ppac_2008annualrpt.pdf)

<sup>2</sup> Joint Liaison Committee Meeting, October 22, 2008; <http://www.cipo.ic.gc.ca/eic/site/cipointernetinternetopic.nsf/eng/wr01471.html>

<sup>3</sup> U.S. provisional patent applications, plant and design patent applications, reissue applications, applications involved in reexamination proceedings, and applications subject to a secrecy order are not eligible for any PPH program in the USPTO.

The PPH request (PTO Form SB/20), which includes a petition to make the application special under 37 C.F.R. § 1.102(d), is filed electronically. The request is accompanied by a claim correspondence table showing how the allowed claims of the OFF application<sup>4</sup> and the unexamined claims of the U.S. application (the OSF application) correspond, copies of all official actions in the OFF application (with translations if necessary), an IDS listing all documents cited by the OFF, and the required petition fee. 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 U.S. claims can be amended to correspond to the allowable claims of the OFF application prior to or concurrent with filing the request, and in some circumstances after participation in a PPH program has begun. When the PPH request is granted, the U.S. application is granted special status and will be advanced out of turn for examination, to be taken up by the examiner before almost all other categories of applications.

### PPH in Other Patent Offices

When the USPTO is the OFF, a PPH request is 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 EPO accelerates all steps of prosecution under PACE accelerated procedures, whereas 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 therefore is important to be aware of PPH requirements and procedures in each OSF of interest.

### Maximizing the Benefits of PPH Programs

Strategic approaches can be developed to maximize the advantages offered by PPH programs, and to avoid or mitigate any potential disadvantages. An applicant who wishes to benefit from PPH programs should engage qualified patent counsel to consider issues of subject matter, priority relationships between applications, claim scope, and timing for PPH programs. Although some aspects of this analysis are already a routine part of managing portfolios of applications filed in multiple patent offices, PPH programs introduce additional strategic considerations such as: identifying eligible pairs of OFF and OSF applications; identifying potential future OFF and OSF applications; choosing a preferred OFF or OSF for a pair of applications; managing patent prosecution timelines, e.g., accelerating examination of a potential OFF application and/or delaying examination of a potential OSF application; identifying 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. Specific examples of strategic approaches are:

- For an existing portfolio of corresponding patent applications filed in multiple patent offices, identify actual and potential opportunities for fast-track examination under one or more PPH programs.
- For a proposed portfolio of applications not yet been filed, proactively identify the filing strategies that will place the applications in the most favorable position to participate in one or more PPH programs.

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PPH programs differ as to acceptable OFF determination of allowable claims. Most programs require a substantive Office Action or Examination Report from the OFF identifying the allowable claims, whereas the USPTO-EPO program will accept a positive Extended European Search Report (ESSR) if no EPO Office Action relevant to patentability has issued yet.

- Identify opportunities to enhance PPH benefits by combination with other options, e.g., accelerated examination in the office selected to be the OFF, followed by fast-track examination under the PPH in the OSF, in order to further accelerate the process of obtaining patents for the same invention in different countries. For example, if a pair of corresponding patent applications are pending in the USPTO and the EPO, and both have unexamined claims and are eligible for the USPTO-EPO program, then an applicant may select the EPO as the intended OFF and request accelerated prosecution under the PACE program, and after at least one claim is found allowable in the EPO, then file a PPH request in the USPTO as the OSF, relying on the search and examination results from accelerated examination in the EPO.
- Identify patentable subject matter suitable for each PPH program, because participating in a PPH program does not guarantee that the claims allowed in an OFF application will be allowed by the OSF. Although the OSF will use the OFF examination and search results, the OSF will follow its own rules and practices during examination. It therefore is possible that the OSF could refuse to allow claims that were found allowable in the OFF.
- Identify claim format suitable for each PPH program. According to the USPTO PPH program announcements, claims are considered to “sufficiently correspond” where, “accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope” (e.g., 1327 OG 45, at 47).
- Identify options that maximize PPH program flexibility and do not limit the potential scope of patent protection for all inventions disclosed in an application. 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 should be filed in U.S. divisional and/or continuation applications to be prosecuted separately.

## Conclusion

PPH programs offer important benefits such as accelerated patent grant, consistent examination of claims in multiple patent offices, 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.

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