

Patent Prosecution Highway (PPH)

The Patent Prosecution Highway (PPH) is a cooperation program that can be implemented between two IPOs, focusing on substantive examination. When two countries have reached an agreement on PPH terms, this allows an applicant to pursue examination in an Office of Later Examination (OLE) on the basis of an earlier application filed and found to be patentable in an Office of Earlier Examination (OEE). Offices that have entered into PPH agreements and have implemented these programs and procedures have been able to economize examination efforts and improve on the quality of examination, much to the benefit of the applicants and the Offices themselves.¹ The PPH's main focus since its inception has been work-sharing between IPOs as well as providing accelerated examination.

There are many different PPH programs currently in practice worldwide.² The first pilot PPH program was co-developed by the USPTO and JPO, and was first put into practice in 2006. Since then, PPH agreements and programs have been expanded and improved upon, including incorporation of work products of the International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the PCT in the PPH agreements (PCT-PPH).³

In general, efficiency gain and improved patent quality demonstrated by reduced actions between IPOs and applicants per disposal, higher allowance rate, and reduced rate of appeal are considered as major benefits of the PPH programs. For users, they benefit from the reduced pendency period for corresponding foreign applications and more predictability on the patentability of their inventions and possible grant of patents in OLEs.⁴ IPOs may be able to optimize their tasks with respect to the workload they handle and refine and improve the quality of their examination practices.⁵ A request for PPH expedited examination in a particular office generally requires no additional fees, since communication and sharing of documents relating to published applications between IPOs nowadays provides no major costs or challenges. While there are plurilateral PPH agreements (e.g., Global PPH, IP5 PPH, PROSUR-PPH and Pacific Alliance PPH), PPH initiatives have been mainly bilateral in nature.

In practice, the expedited examination of a patent application by virtue of a PPH agreement begins when the applicant informs the OLE that a previously-allowed and granted patent application rests with the OEE. Once the proper information has been provided, the two Offices are able to share the information and documents that are needed in order to expedite the OLEs examination period. A commonly required rule or strategy of PPH-participating offices is the commitment to provide expeditious issuance of not only first office actions but also final decisions. Additionally, the OLEs are expected to make use of search/examination-related information as provided by the OEEs to the best of their ability to improve the quality of the examination and provide justification for the cooperation between the offices.⁶

While PPH agreements are tailored to the respective IPO's needs with specific conditions and criteria, there are certain practices that are generally found in all PPH agreements. For example, the autonomy of the OLE has been carefully preserved in these agreements. Most PPH agreements will thus often stipulate that, the OEE's results cannot be imposed on the OLE, which must be able to come to its own independent results with respect to the examination of applications. Therefore, PPH agreements commonly provide conditions under which an OLE may take into consideration the examination results provided by an OEE. One

¹ See the PPH Portal webpage, available at: <https://www.jpo.go.jp/e/toppage/pph-portal/pph.html>.

² Information about the PPH as reported by different IPO's can be found on the PPH Portal website: <https://www.jpo.go.jp/e/toppage/pph-portal/links.html>.

³ More information on PCT-PPH is available at: https://www.wipo.int/pct/en/filing/pct_pph.html.

⁴ See the PPH Portal webpage: <https://www.jpo.go.jp/e/toppage/pph-portal/pph.html>.

⁵ *Idem*.

⁶ In 2014, the seventh Plurilateral PPH Working-Level Meeting held in Singapore agreed on a common PPH Policy, which can be found at: <https://www.jpo.go.jp/e/toppage/pph-portal/docs/pph-policy-en.pdf>.

example of such a condition is a correspondence between the claims in both patent applications, which can be a technically complex question in practice.

There are currently several types of PPH programs being applied by different IPOs, as indicated below. In addition to this document, the PPH Portal website⁷ as well as PCT-PPH page on the WIPO website⁸ compile comprehensive information about PPH programs, membership and statistics. Each IPO may set different requirements, criteria and procedures for various kinds of PPH agreements with varied countries. Therefore, these websites also include links to the websites of IPOs on which further details about separate requirements, procedures, guidelines and forms relating to each agreement are provided.

⁷ <https://www.jpo.go.jp/e/toppage/pph-portal/pph.html>.

⁸ WIPO PCT-Patent Prosecution Highway Program and Global PPH webpage, available at: https://www.wipo.int/pct/en/filing/pct_pph.html.

PCT-PPH

A number of bilateral, plurilateral and global PPH agreements incorporate work products of ISAs and IPEAs as a basis for applicants to request accelerated examination in OLEs during the national phase under the PCT. These work products can include: (i) the written opinion of the ISA; (ii) the written opinion of the IPEA; and/or (iii) the international preliminary examination report issued within the framework of the PCT, subject to certain conditions. Accordingly, an applicant receiving a favorable written opinion or international preliminary report on patentability (IPRP) from an International Authority would be able to request that a corresponding national phase entry receive expedited examination, provided that all claims in the national phase application sufficiently correspond to the claims which received a positive indication in the written opinion or IPRP. The national Office would then leverage the international phase work products to streamline patent examination in the national phase.⁹ The PCT-PPH programs are still held and agreed upon between, or among, the parties to each PPH agreement.

PPH MOTTAINAI

Another type of PPH-implemented program is the PPH MOTTAINAI, which was initially agreed by eight IPOs in 2011.¹⁰ In summary, PPH MOTTAINAI removed certain formalities and requirements that were first introduced into PPH agreements that had been agreed-upon bilaterally. In particular, under the initial PPH agreements, the OEE must be the first office with which the relevant application was filed, i.e., the concept of the Office of First Filing (OFF). In that model, when the OFF could not finish the examination of a patent application in due time, other offices that received corresponding subsequent applications had to wait until the OFF finishes its examination work, if the other offices wished to utilize the work product of the OFF. By introducing the concept of Office of Second Filing (OSF) and allowing the examination results of an OSF to be shared with OFF, the program further optimized the examination practices and workloads of implementing offices.¹¹ Currently, the PPH MOTTAINAI is implemented by many other IPOs.¹²

Global PPH

The Global PPH is one of the plurilateral PPH pilot programs.¹³ Under the Global PPH, a request for accelerated processing can be made at any participating office based on the work products from any other participating office, covering three types of PPH programs, i.e., the normal PPH, PPH MOTTAINAI and PCT-PPH. The Global PPH operates under more standardized practices and criteria among its membership, based on unified Framework Provisions as well as common criteria and principles.

IP5 PPH

The IP5 PPH program, initiated by the IP5 Offices¹⁴ in January 2014, extends and simplifies PPH requests to the IP5 Offices.¹⁵ Under this program, normal PPH, PPH MOTTAINAI and PCT-PPH are available among the five Offices. The IP5 Offices also developed a model common PPH request form, with a uniform set of data that must be submitted by applicants.

⁹ *Idem.*

¹⁰ JPO (Japan), CIPO (Canada), IP Australia (Australia), PRH (Finland), ROSPATENT (Russia), SPTO (Spain), UKIPO (UK), and USPTO (USA). See <https://www.jpo.go.jp/e/toppage/pph-portal/pph-mottainai.html>.

¹¹ See PPH MOTTAINAI webpage, available at: <https://www.jpo.go.jp/e/toppage/pph-portal/pph-mottainai.html>.

¹² For the IPOs currently implementing the PPH MOTTAINAI, see the PPH Network webpage, available at: <https://www.jpo.go.jp/e/toppage/pph-portal/network.html>.

¹³ See the Global PPH webpage, available at: <https://www.jpo.go.jp/e/toppage/pph-portal/globalpph.html>.

¹⁴ China National Intellectual Property Administration (CNIPA), European Patent Office (EPO), Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO) and the United States Patent and Trademark Office (USPTO).

¹⁵ See the IP5 Patent Prosecution Highway (IP5 PPH) webpage, available at: <https://www.fiveipoffices.org/activities/ws/ip5pph>.

An IP5 PPH request can be based on: (i) the latest PCT work product (written opinion of the ISA (WO-ISA) or international preliminary examination report (IPER)) established by one of the IP5 Offices as ISA or IPEA; or (ii) the national work product established during the processing of a national application or an international application under the PCT that has entered the national phase before one of the IP5 Offices. To be an eligible application, the above work product determines one or more claims to be patentable/allowable.

PROSUR-PPH

PROSUR-PPH is a plurilateral PPH agreement concluded by the IPOs of Argentina, Brazil, Chile, Colombia, Ecuador, Paraguay, Peru and Uruguay, with special consideration towards the needs of the region. The agreement includes PPH modalities with respect to international applications under the PCT and integrates the PPH MOTTAINAI framework. In particular, applicants may use the work product of INPI Brazil and the National Institute of Industrial Property (INAPI) of Chile, as ISA/IPEA under the PCT, to expedite the examination of a patent application in any of the other PROSUR participating countries.¹⁶

Pacific Alliance PPH

With respect to the Pacific Alliance, whose members include Chile, Colombia, Mexico and Peru, a PPH agreement that applies among them entered into force in 2015. The program allows participating IPOs to benefit from PPH expedited examination practices, including those provided under PPH MOTTAINAI, when certain conditions are met. This initiative does not include, or make explicit reference to, eligibility of international applications under the PCT.¹⁷

¹⁶ PROSUR press release, available at: <https://prosur.org/en/novedad/prosur-initiates-the-implementation-of-the-agreement-that-will-allow-applicants-an-accelerated-patent-procedure-pph/>. See also the information regarding the implementation and extension of the program which is available at the website of each respective country's intellectual property office.

¹⁷ The Memorandum on the understanding and implementation of a PPH initiative between member states of the Pacific Alliance, available at: <https://www.indecopi.gob.pe/documents/20791/368017/MOU+PPH,+Alianza+del+Pacifico.pdf/e1fe3cc7-c8c9-4543-b688-4f5231dbcb83>.