

*Introduction to **P**atent **P**rosecution **H**ighway*

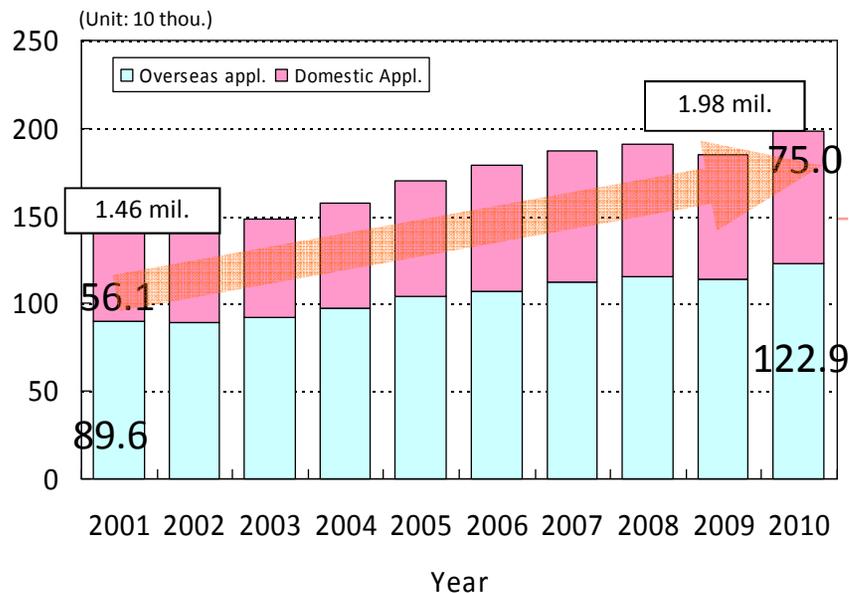
JAPAN PATENT OFFICE

Background

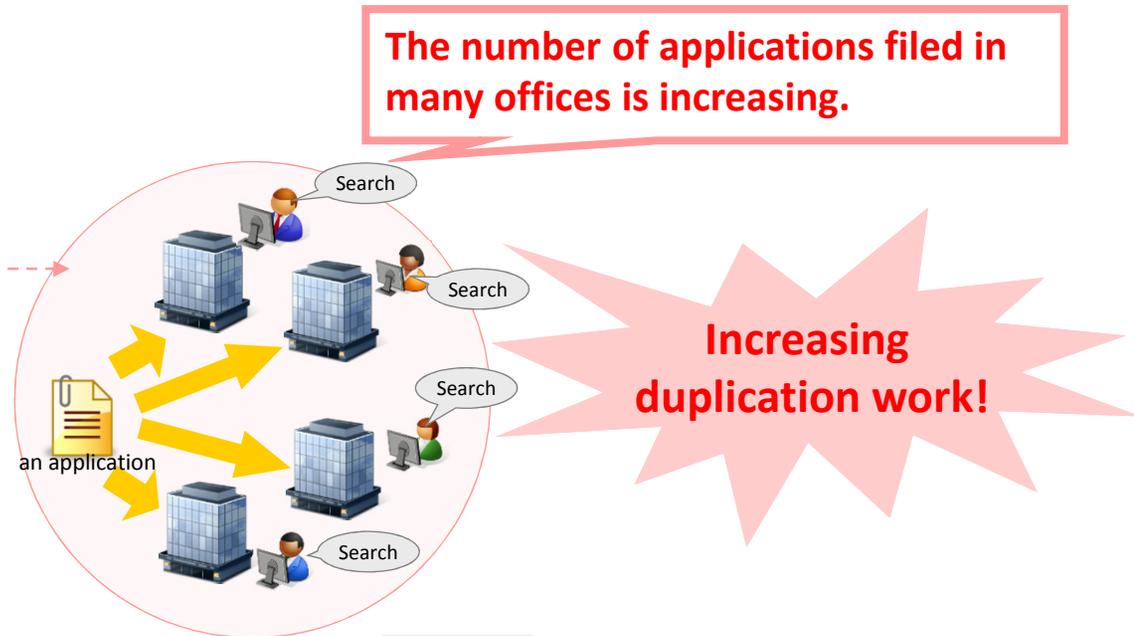
Growing Demand for Work Sharing

- ✓ The number of patent applications in the world is increasing along with the globalization of business.
- ✓ In particular, **the number of applications filed in many offices is significantly increasing.**
- ✓ **Duplication work among each patent offices are increasing.**

Changes in Patent Appl. Filed in the Whole World



Source: WIPO Industrial Property Statistics

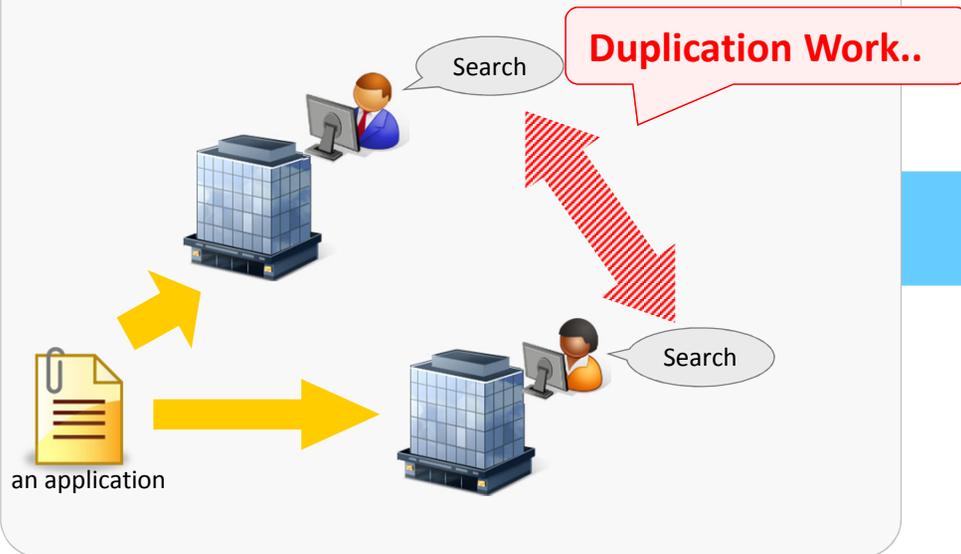


Growing Demand for Worksharing

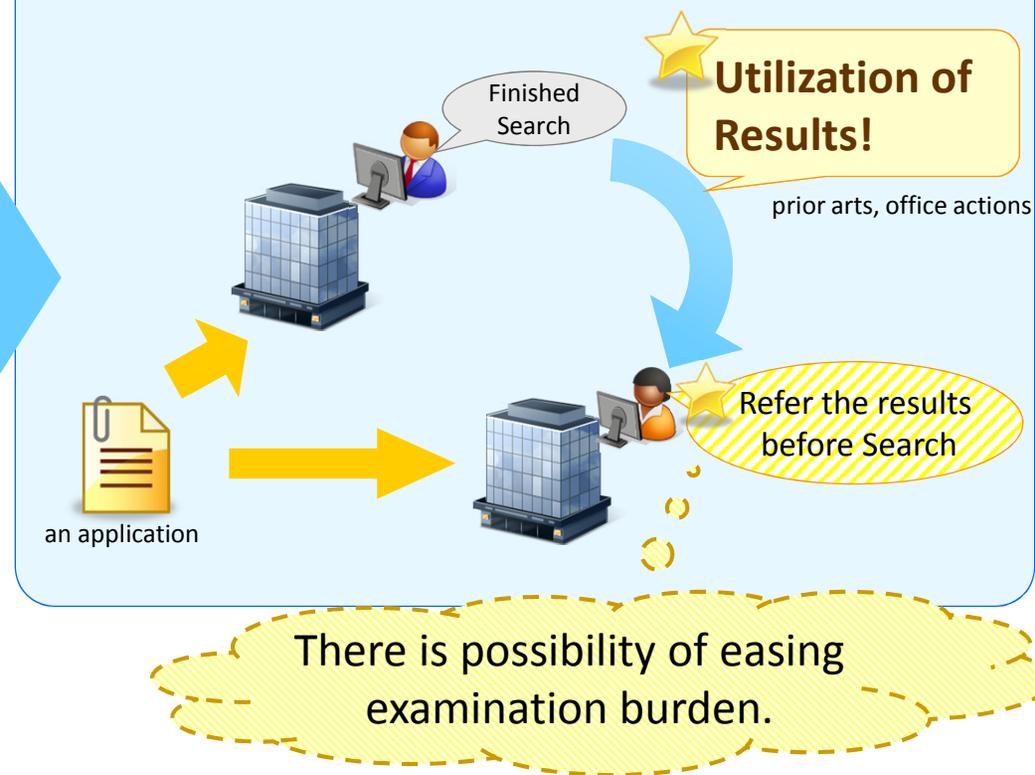
Growing Demand for **Work Sharing**

✓ The general concept of work sharing is the utilization of search & examination results in office of earlier examination.

Normal Case



Work sharing Case



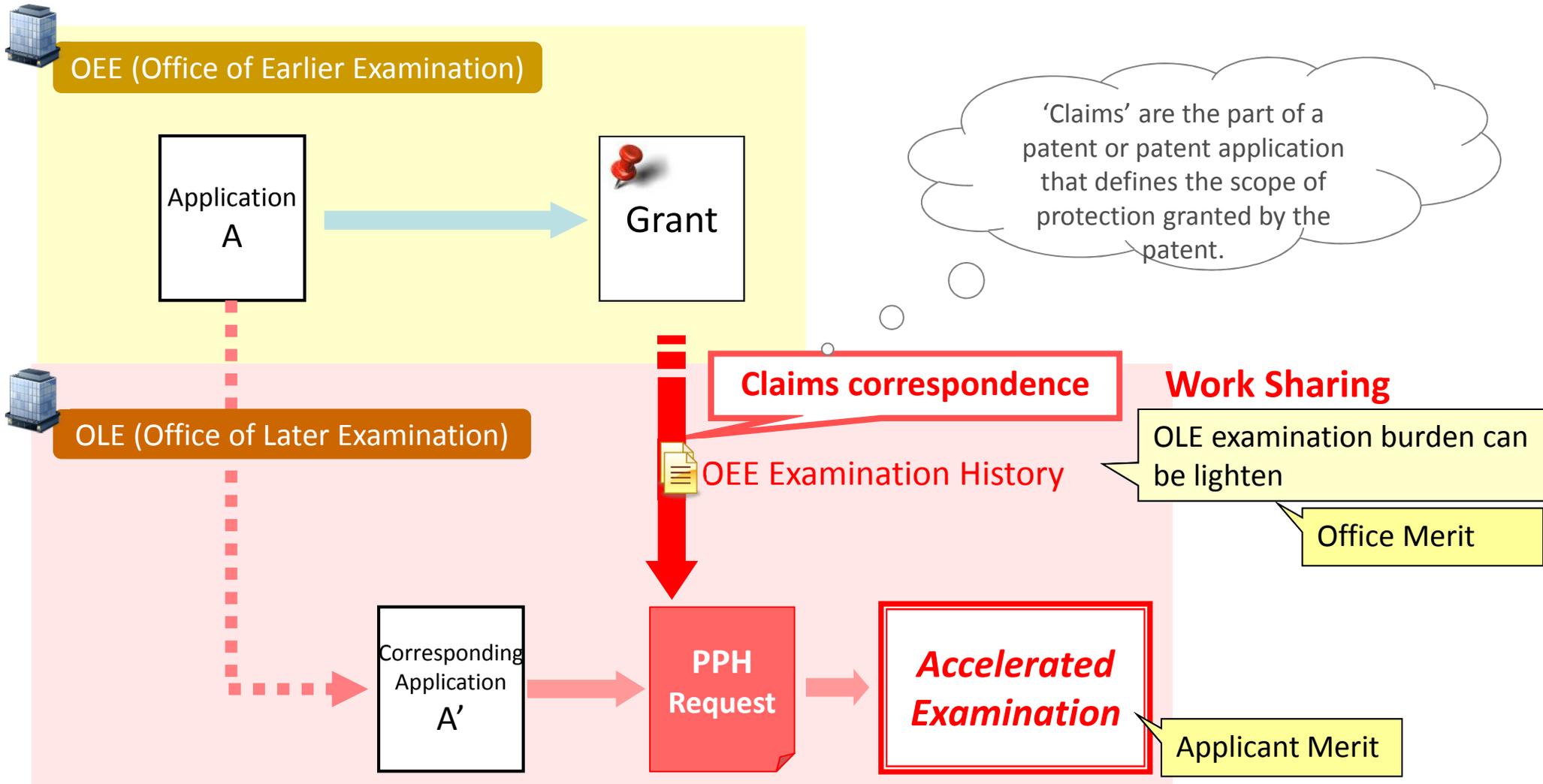
(In this context, "Work sharing" does NOT mean an adjustment program designed to help employers and employees avoid layoffs .)

What is PPH?

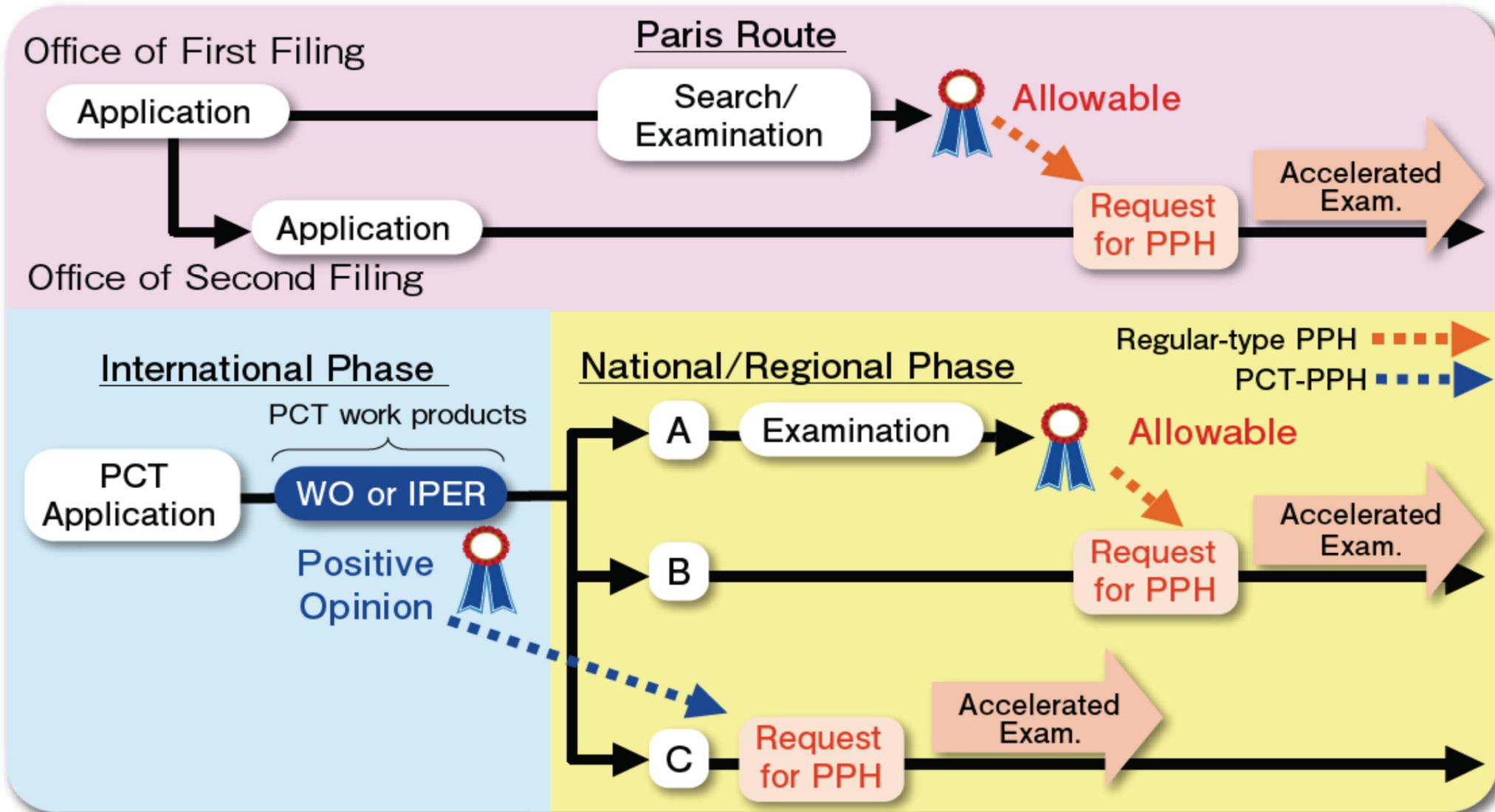


The Scheme of Patent Prosecution Highway

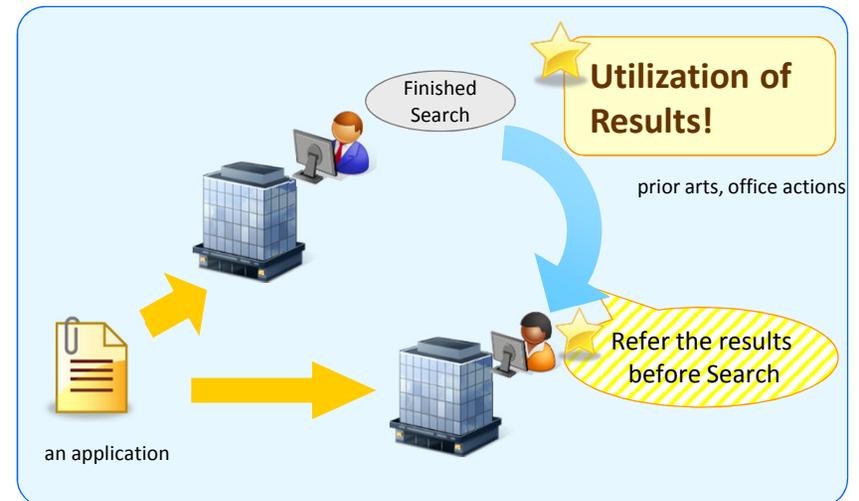
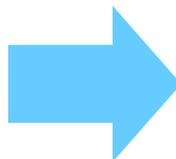
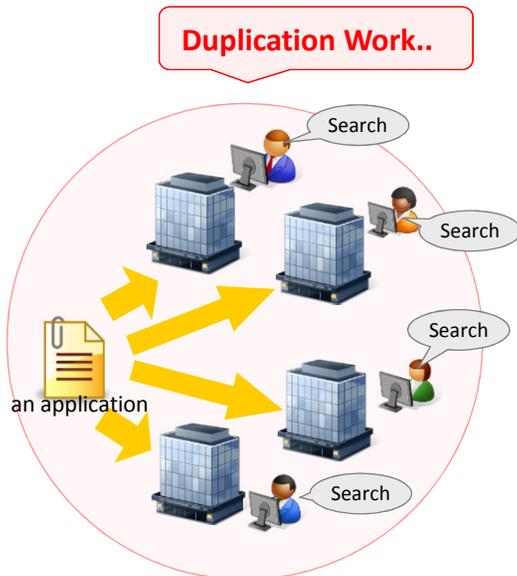
PPH is a framework in which an application determined to be patentable in the Office of Earlier Examination is eligible to have ***an accelerated examination*** in the Office of Later Examination with a simple procedure upon an applicant's request.



The Scheme of Patent Prosecution Highway



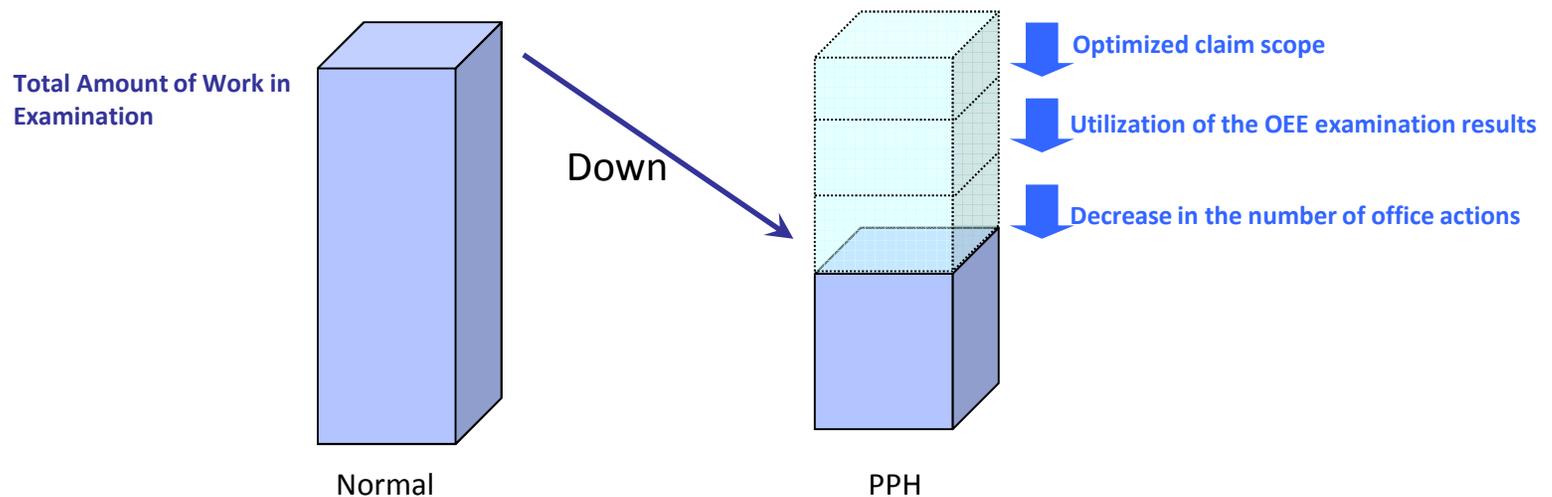
Merit for the Patent Offices: **Work Sharing effect**





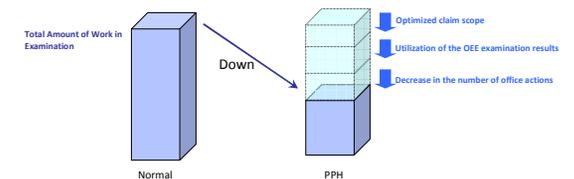
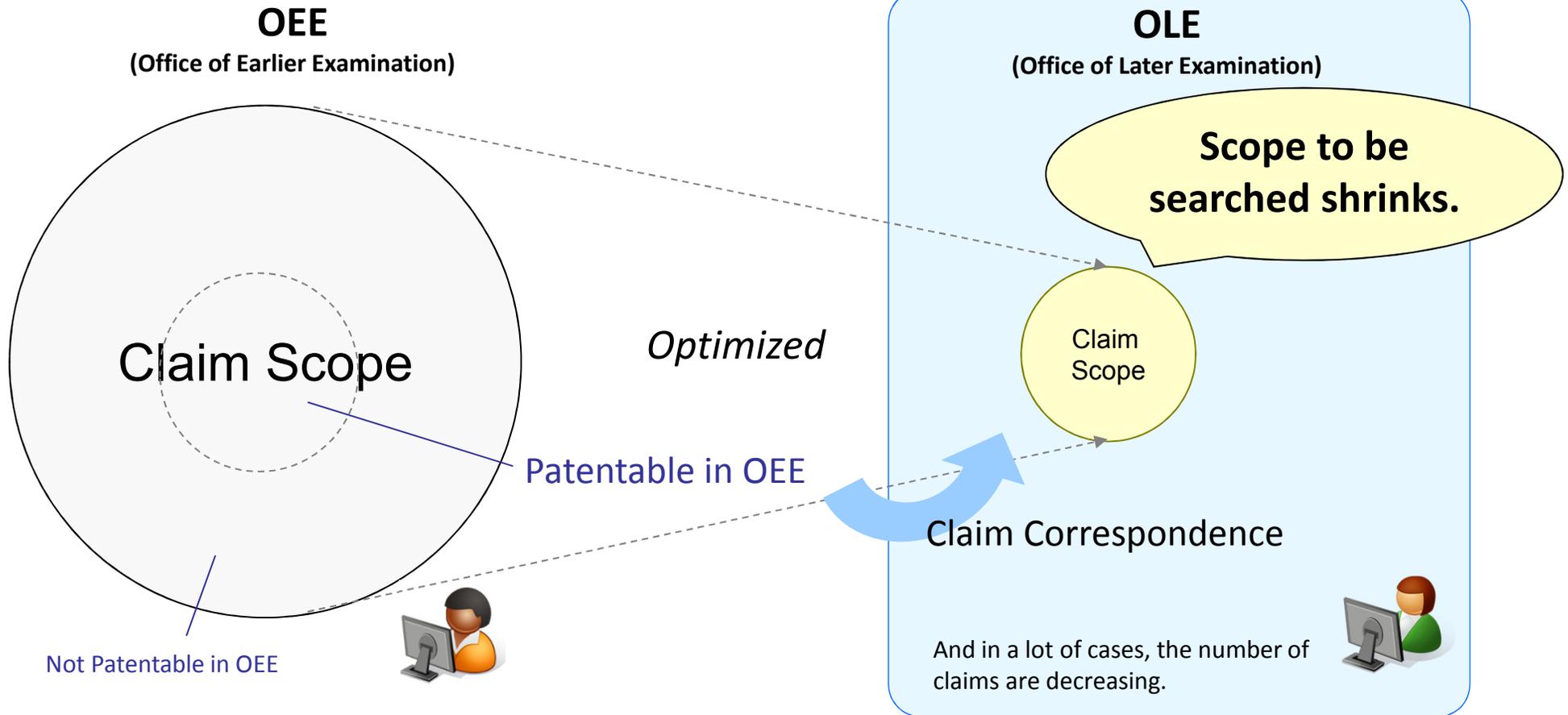
Work Sharing Effect: Easing Examination Burden

1. Optimized claim scope
2. Utilization of OEE search/examination history
3. Decrease in the number of office actions



Merit for the Patent Offices: **Easing Examination Burden**

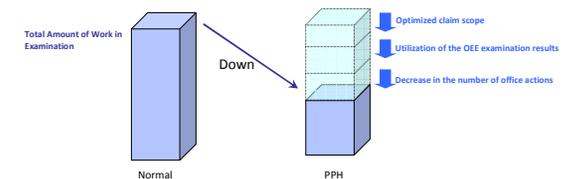
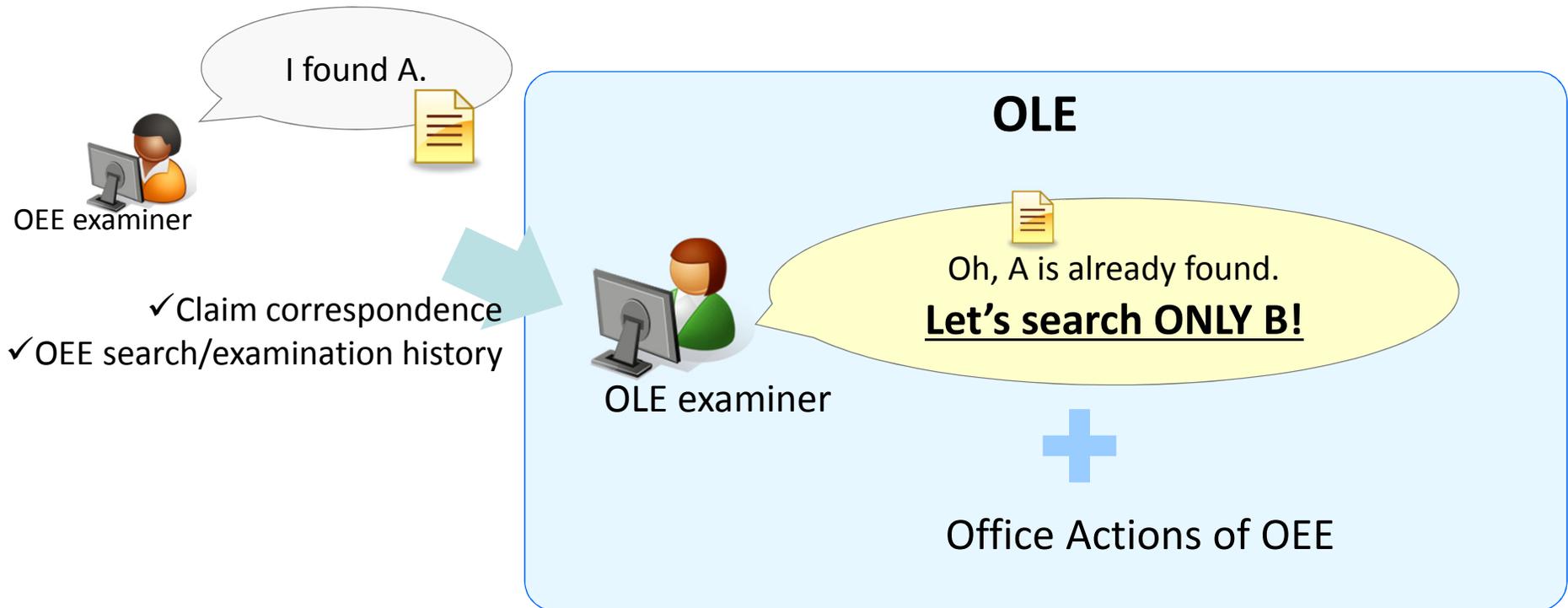
Optimized claim scope



Utilization of OEE search/examination history



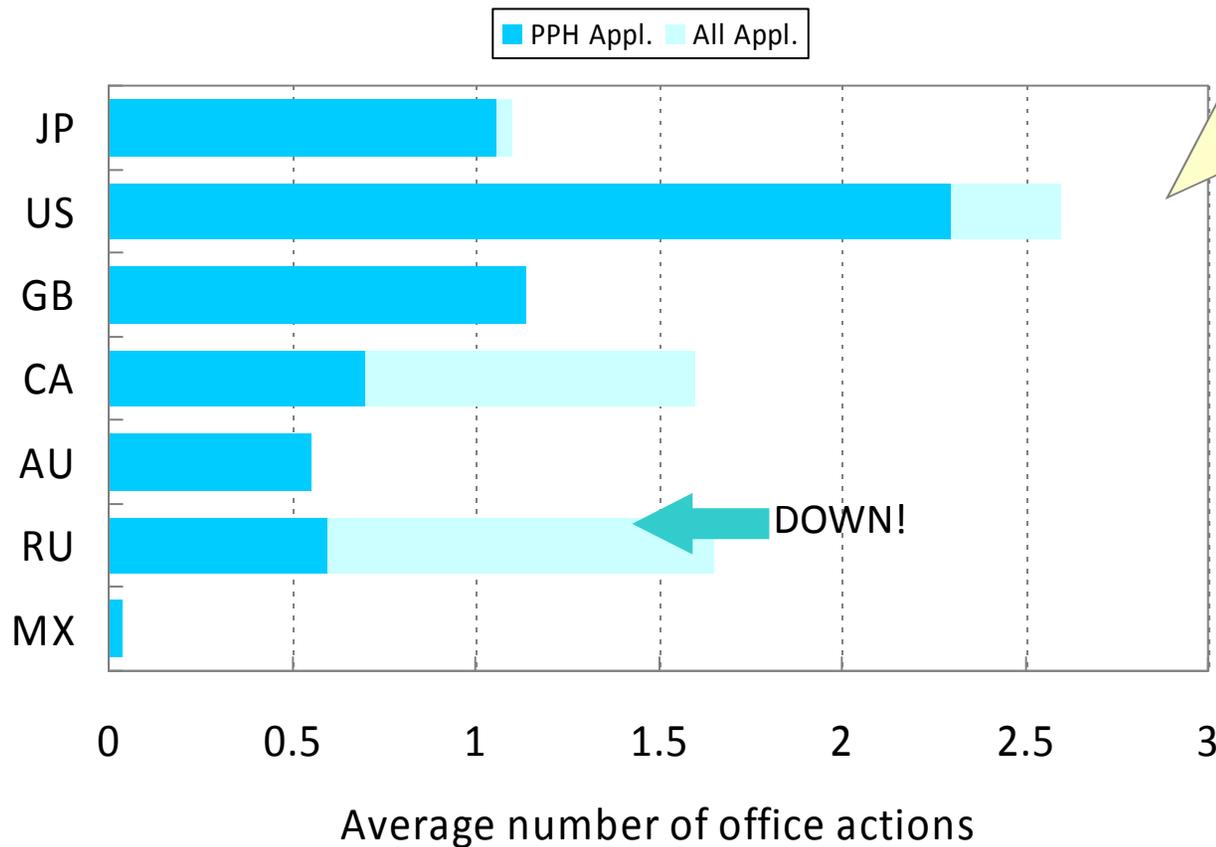
Example: Claims consists of parts A and B.





Decrease in the number of office actions

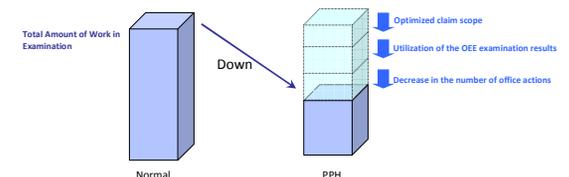
PPH - Average number of office actions



PPH applications tend to be efficiently judged in the OEE because OEE examiners can refer examination history of the OLE.

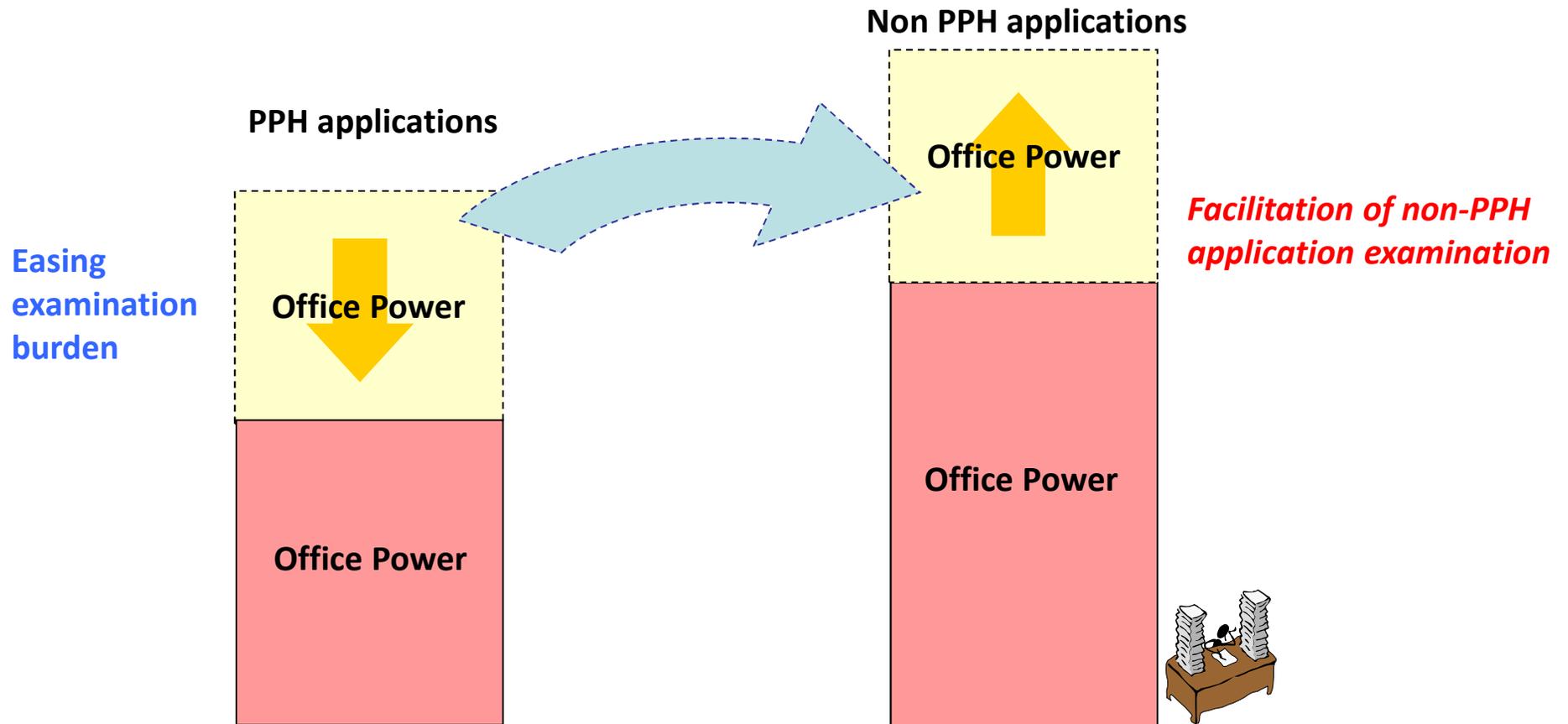
(PPH is NOT an agreement concerning substantive examination.)

Period: Jan-Jun 2012



Merit for the Patent Offices: **Easing Examination Burden**

Offices can facilitate all application examinations.



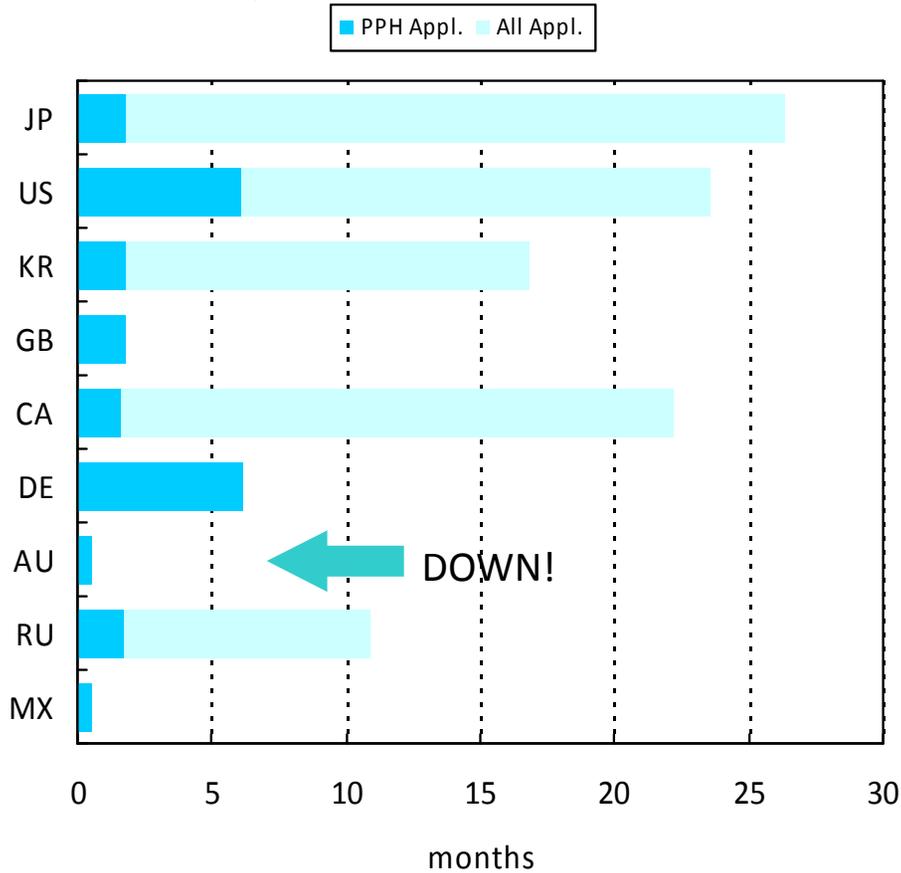
Merit for the Applicants:
High speed, Low cost, High predictability



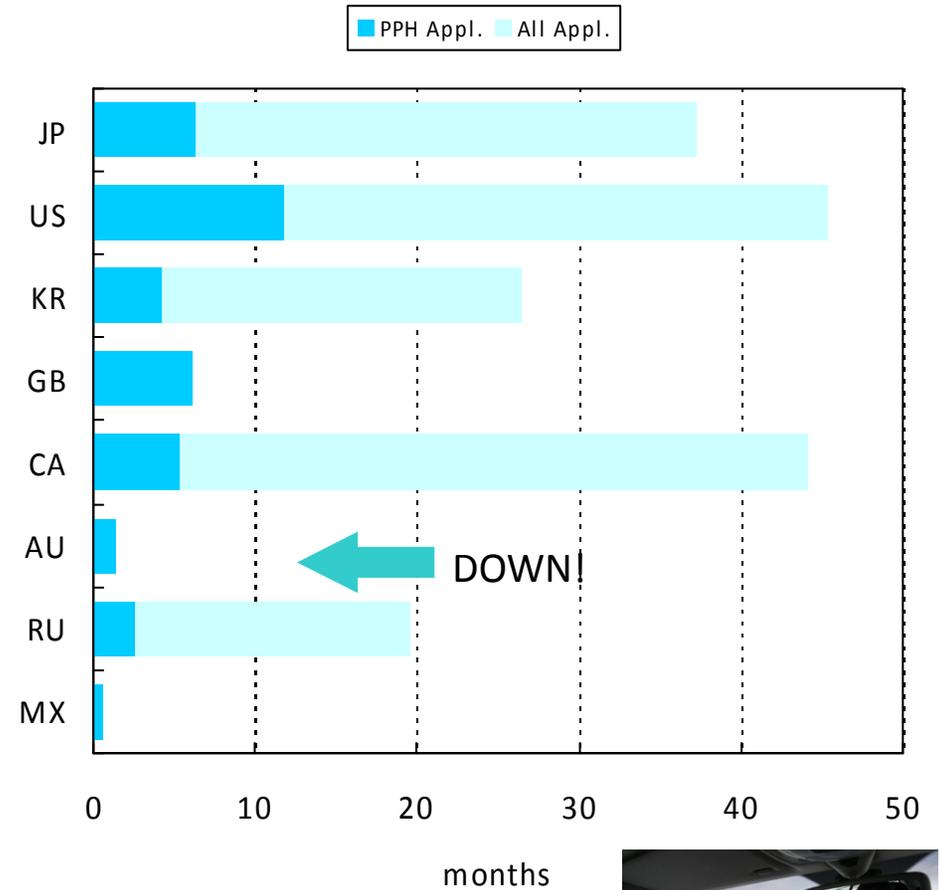
Merit for the Applicants: High Speed

Accelerated Examination

PPH - Average pendency from PPH request to First Office Action

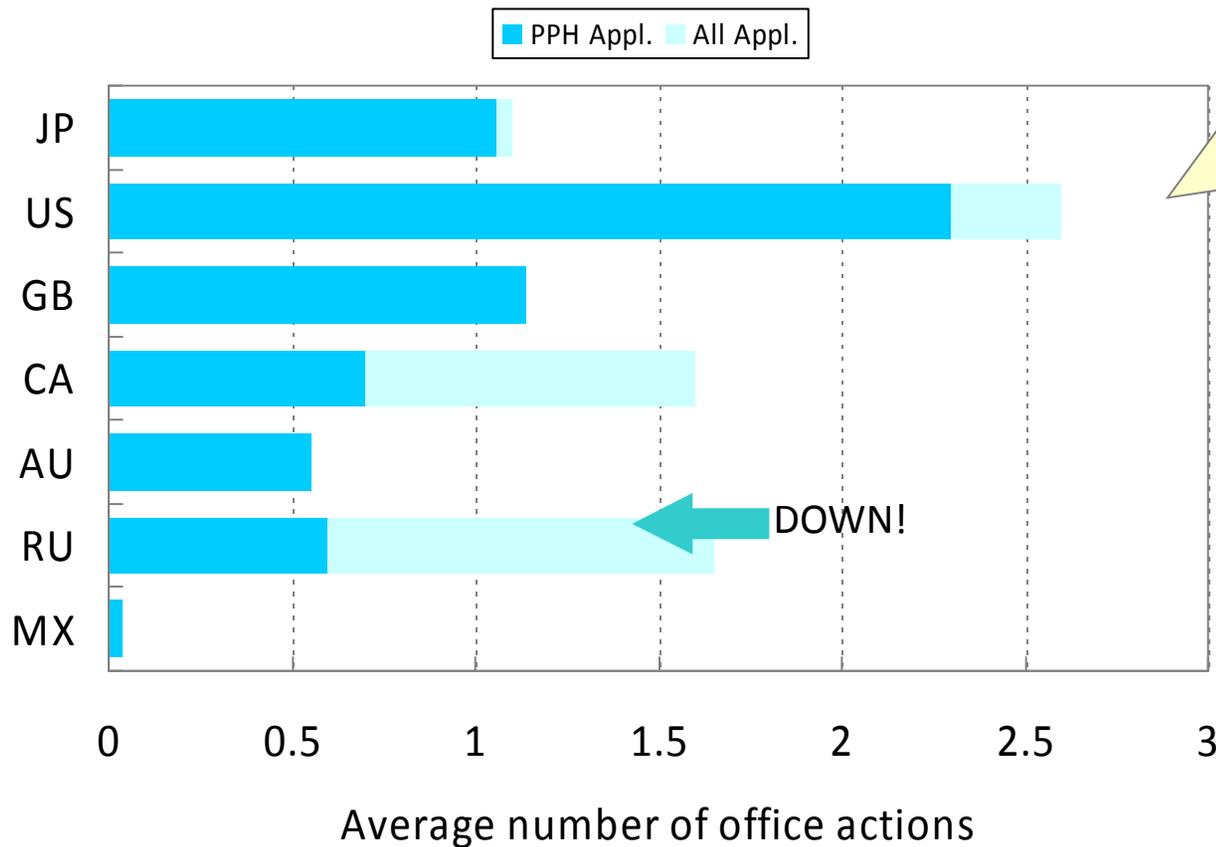


PPH - Average pendency from PPH request to Final Decision



Decrease in the number of office actions

PPH - Average number of office actions



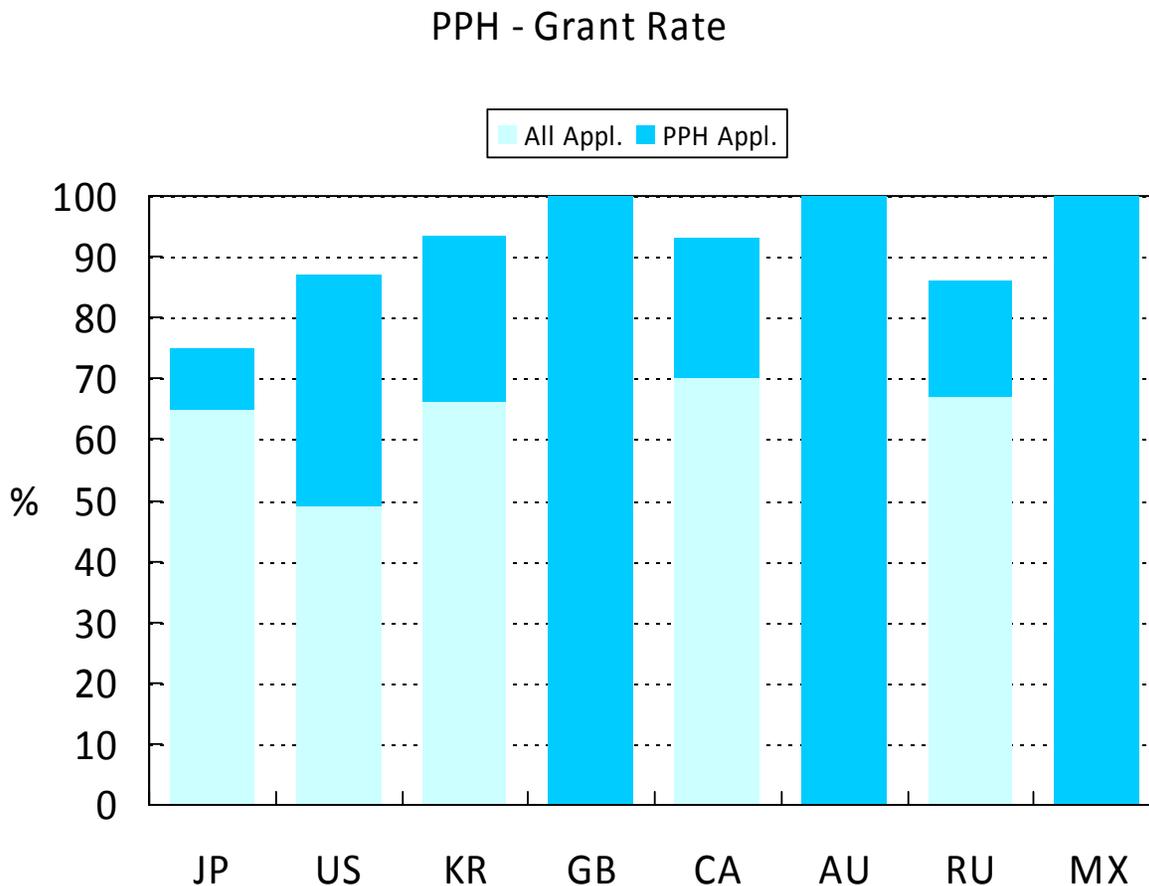
Decrease in the number of office actions reduces applicant **cost** (e.g. attorney and translation fee).

(PPH is NOT an agreement concerning substantive examination.)



Merit for the Applicants: High Predictability

Increase in Grant Rate



UP!

- PPH applications tend to be granted in the OEE because they were already judged to be patentable in the OLE.
- However, grant rates do not equal 100% because patent laws and practices differs in countries and regions and new prior arts are found by the OLE examiner due to difference of search DBs.

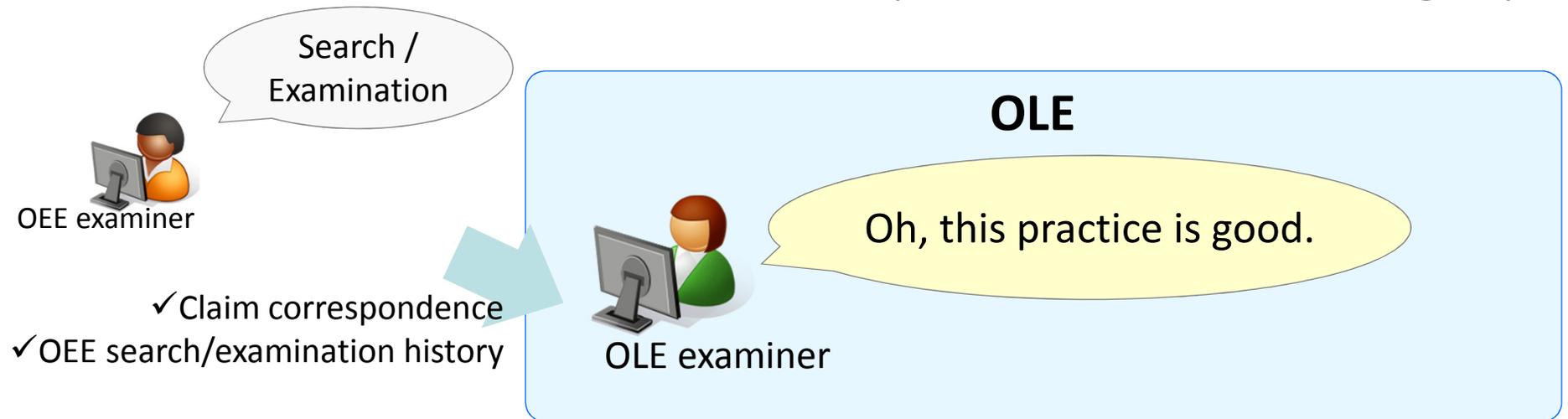
(PPH is NOT an agreement concerning substantive examination.)



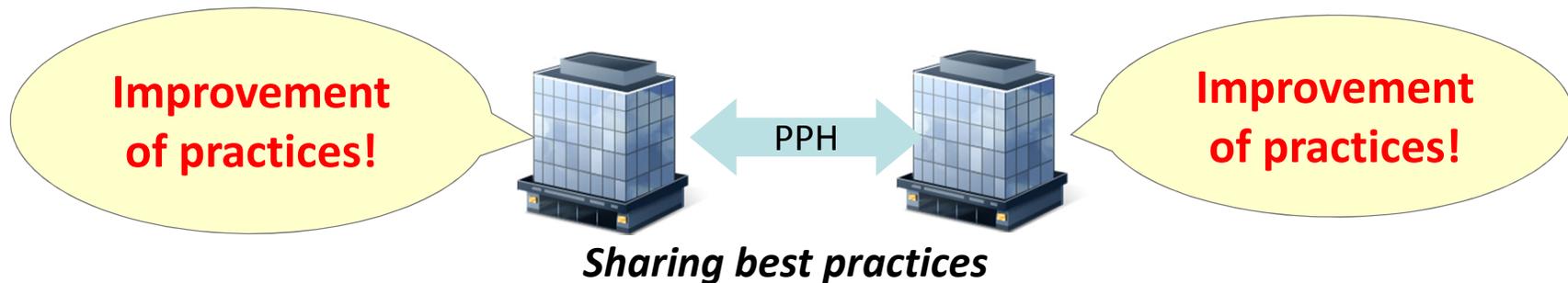
Merit for offices and applicants:
Quality Improvement



- ✓ In PPH scheme, the examination quality of the OLE is guaranteed for at least the OEE level.
- ✓ In addition, the OLE examiners can learn the OEE examination/search practices via submitted OAs and cited prior arts.
 - + “Claim correspondence” makes understanding easy.



✓ In this sense, PPH scheme is virtually a sort of examiner exchange program.



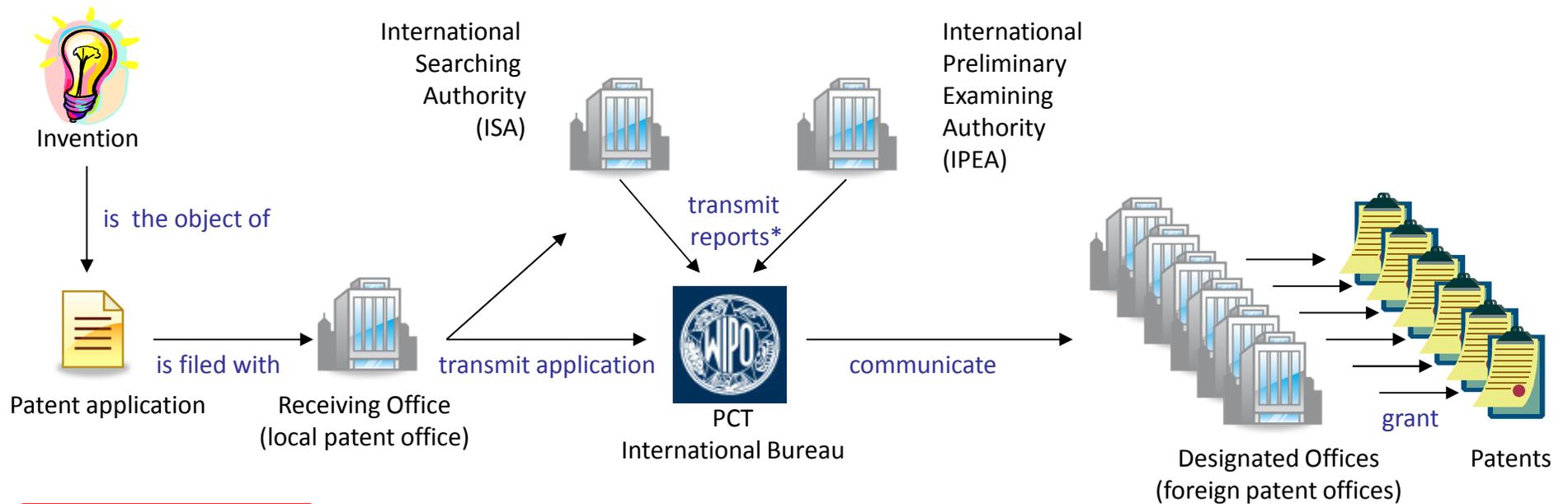
This effect is not limited to only PPH applications.

Some Topics

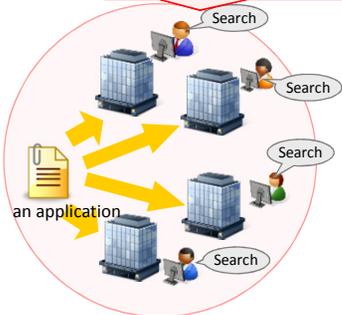
- (1) What are differences between PPH and other approaches?*
- (2) Does PPH prioritize only 'foreign' applicants?*
- (3) Does PPH interfere independency of examination?*
- (4) What does "Accelerated Examination" mean?*

(1) What are differences between PPH and other approaches?

There are several approaches concerning work sharing. Especially, 'PCT' is used all over the world.



Increasing Duplication Work..



Source: WIPO

(1) What are differences between PPH and other approaches?

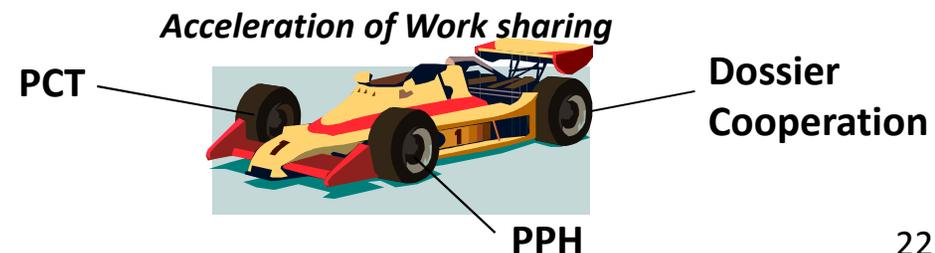
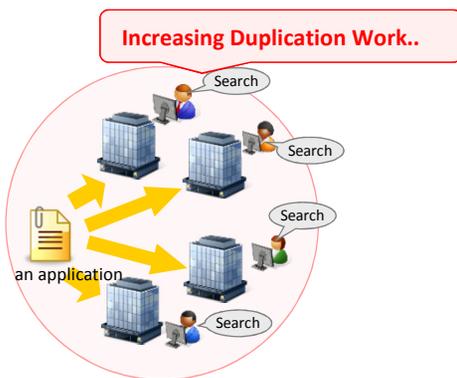
All these approaches are important **work sharing** approaches.



Users can select one of them or PCT-PPH according to their needs.

	PCT	PPH	Dossier Cooperation (OPD, AIPN, ePEC, CASE...)
JPO	Yes	Yes	Yes
Type	User driven	User driven	Offices cooperation
Referring other office results	Yes	Yes	Yes
Claim correspondence obligation	No	Yes	No
Accelerated examination	No	Yes	No

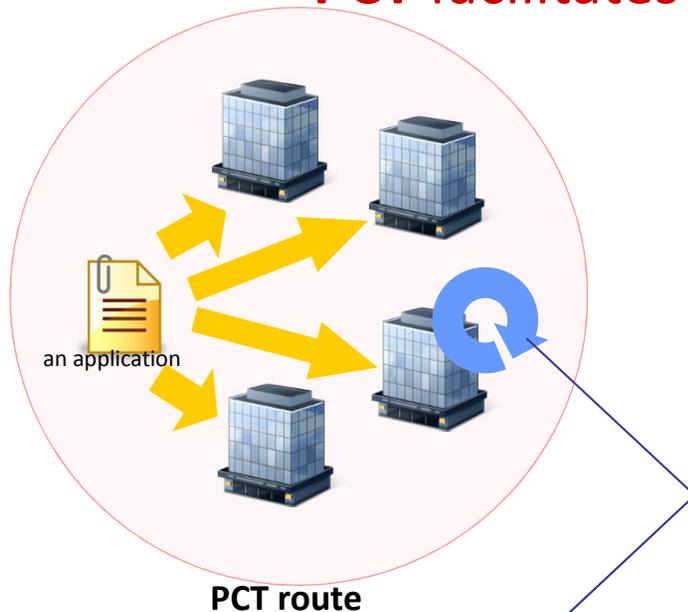
PPH has higher **work sharing effects** than PCT and Dossier cooperation because PPH has **claims correspondence** obligation.



(1) What are differences between PPH and other approaches?

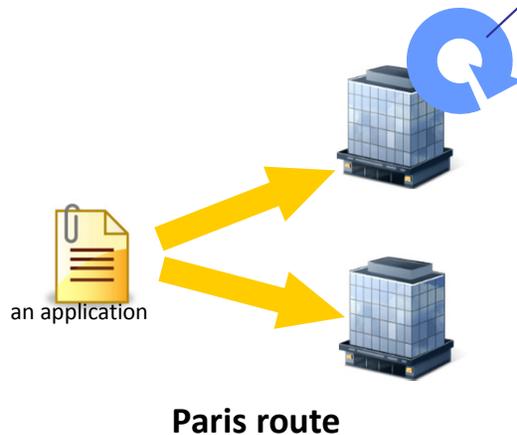
In users' view, PCT and PPH bring each merits.

PCT facilitates applications to many countries.

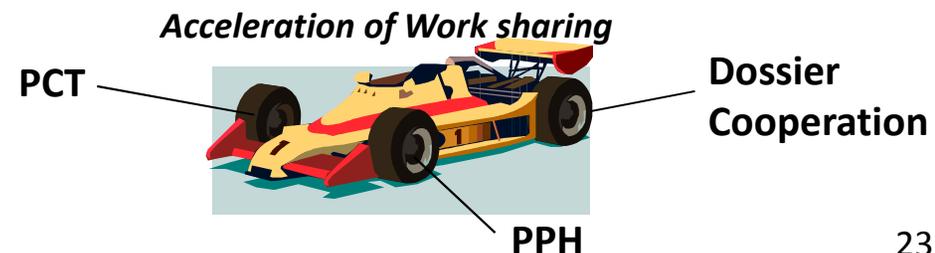


PCT route

PPH enables accelerated examination on both PCT and Paris route.



Paris route

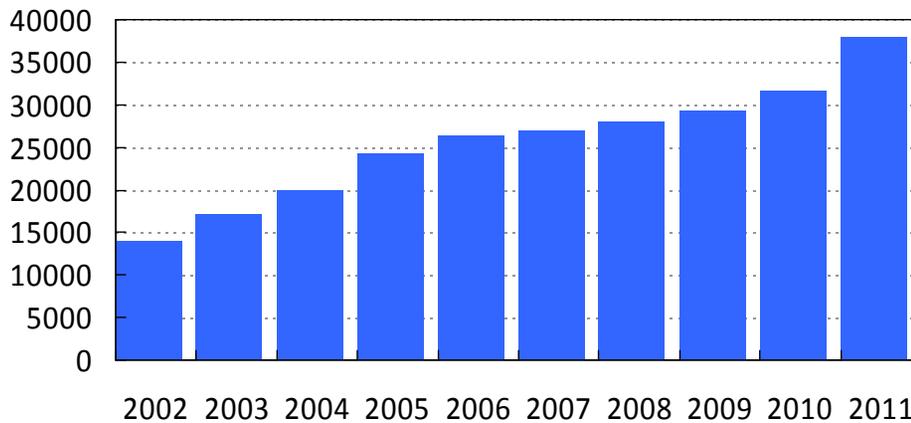


(1) What are differences between PPH and other approaches?

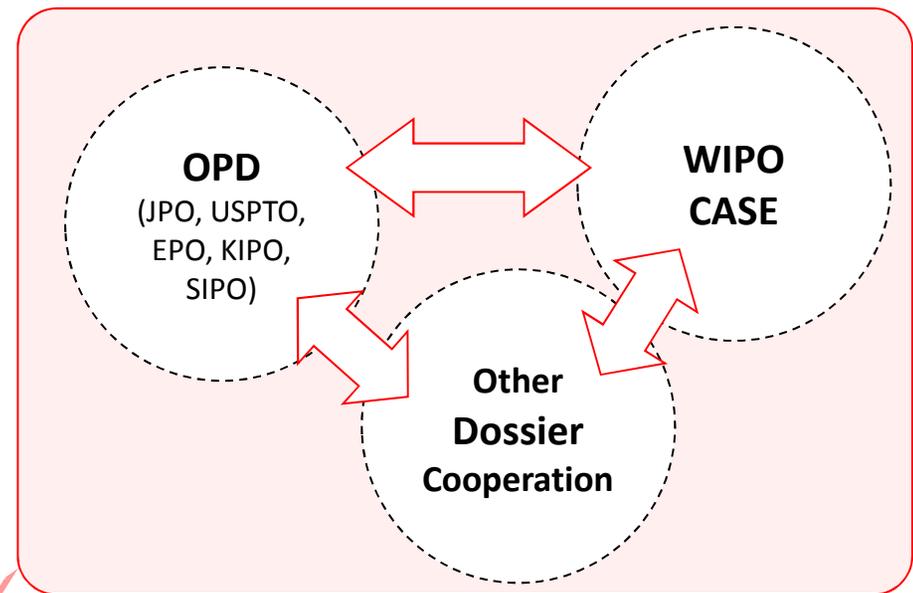
Of course, the JPO promotes PCT and Dossier cooperation.



Changes in the Number of PCT Applications in Japan



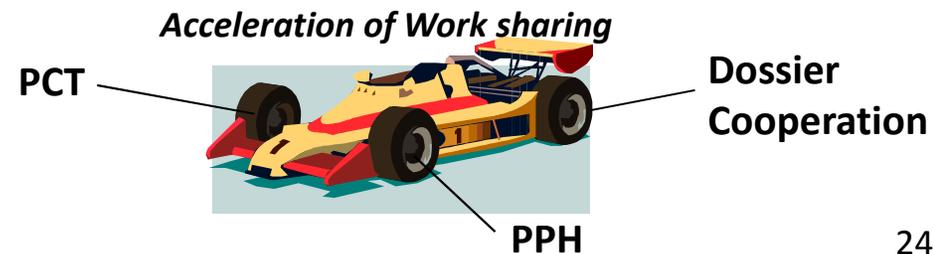
Global Dossier Initiative



“Backlog” is a common enemy among patent offices all over the world.

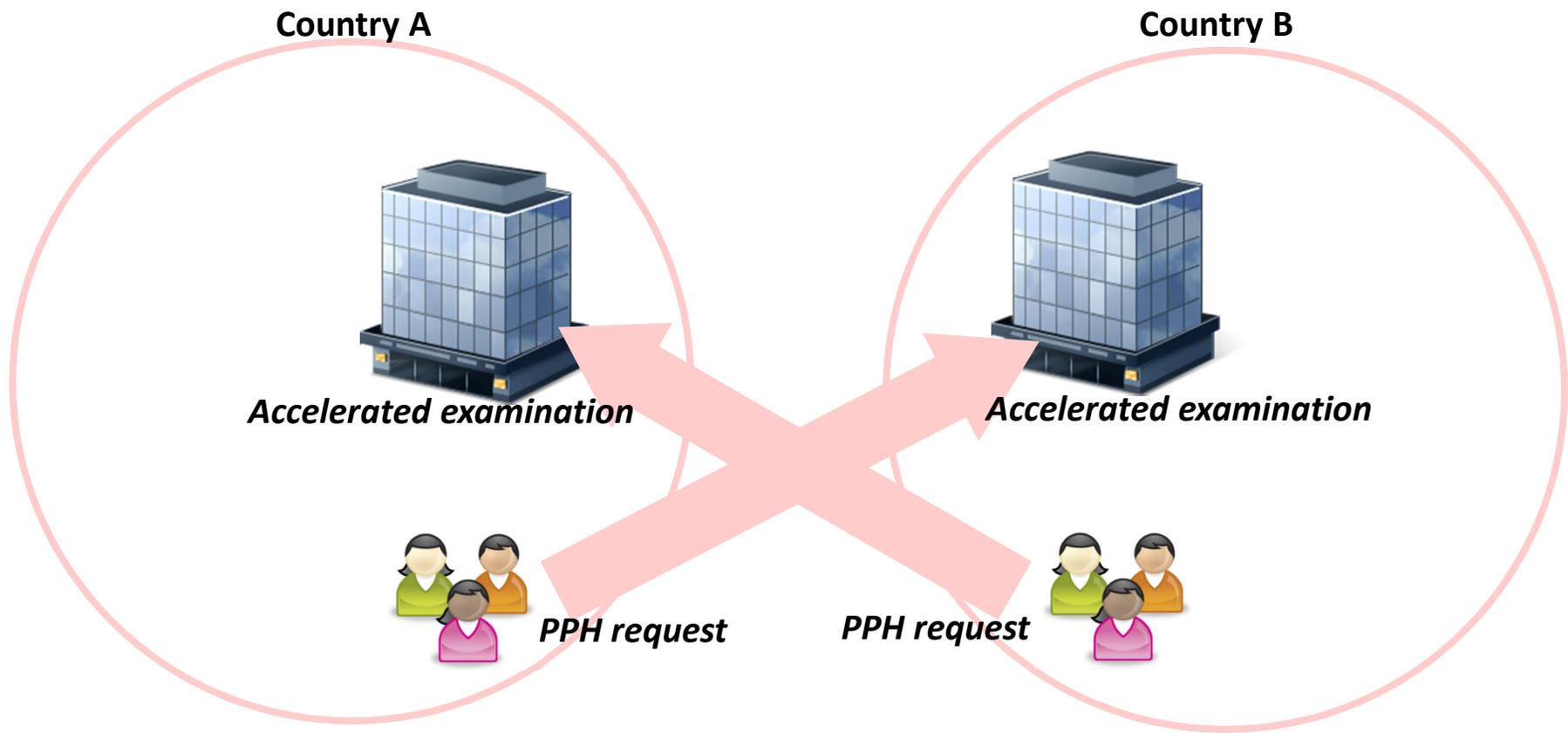
It is important to referring other office examination histories for work sharing.

It is appropriate to use whatever we can use.



(2) Does PPH prioritize only 'foreign' applicants?

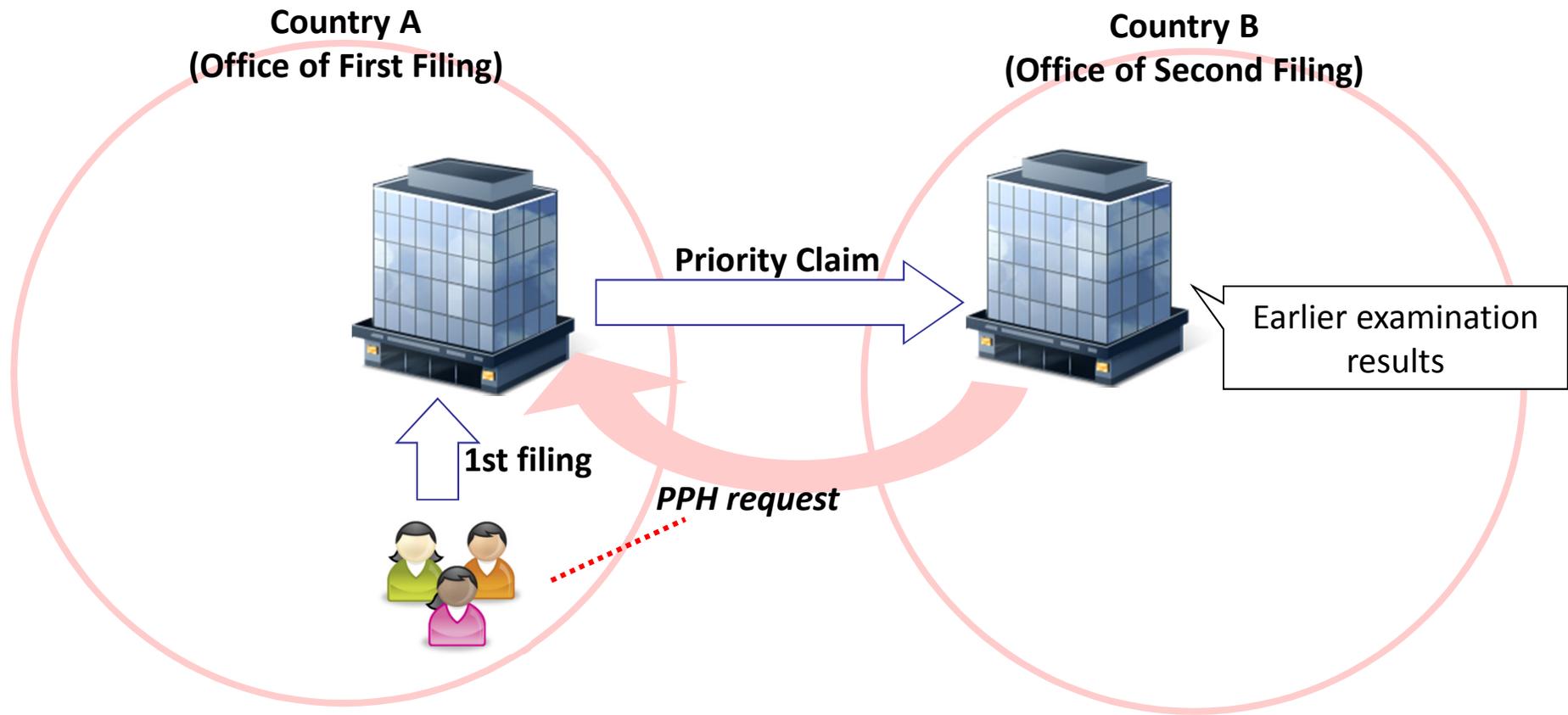
PPH scheme is a reciprocity scheme.
Therefore, both peoples can acquire PPH merits.



(2) Does PPH prioritize only 'foreign' applicants?

In PPH MOTTAINAI scheme, users can request PPH on the basis of **earlier examination results**. (The first file principle is eliminated.)

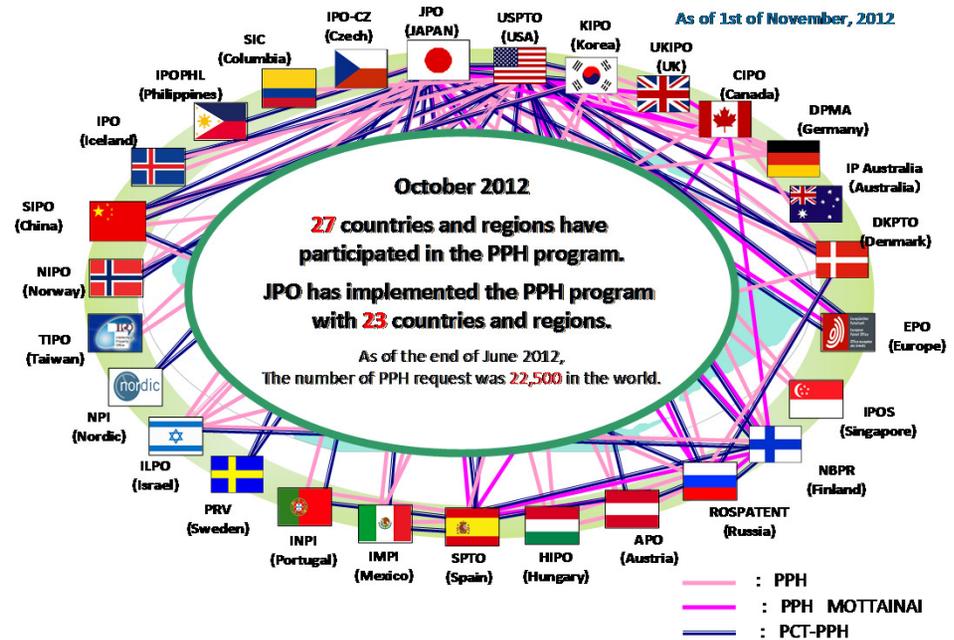
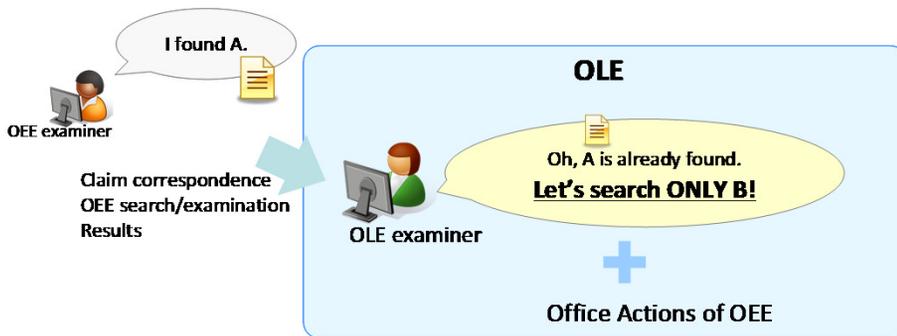
Therefore, users can request PPH for 1st filing office.



(3) Does PPH interfere independency of examination?

PPH is the agreement concerning only examination turn.
 PPH is NOT concerning substantive examination.

For this reason, PPH pilot programs are spreading all over the world including China and Mexico, Columbia etc. and all PPH pilot programs do not have expired.



Purposes of PPH are work sharing and accelerated examination.

(3) Does PPH interfere independency of examination?



If PPH were concerning substantial examination, first of all, the JPO examiners would not accept PPH because each examiner is considered to have strong independency of examination in Japan...

「審査官は、特許出願の審査(第17条第2項による形式審査を除く。)に関しては特許庁長官から独立した行政庁であると解すべきである。」

昭和50年(行ケ)第107号

The court said “ *An examiner should be considered as an intendance independent of the patent office commissioner as regarding patent examination.*” .

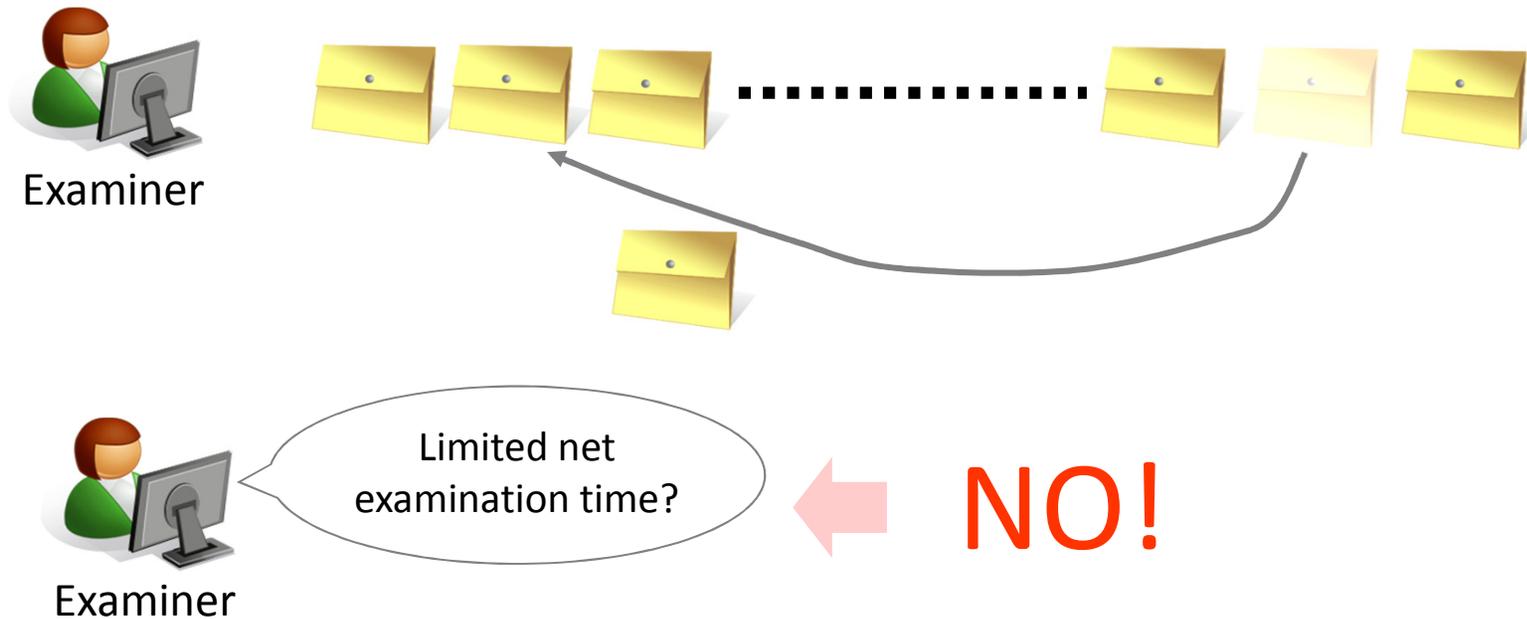
In addition, applicants do not demand cut-off of examination in the second office because patent rights containing invalid reasons are meaningless.

Purposes of PPH are work sharing and accelerated examination.

(4) What does “Accelerated examination” mean?

PPH is the agreement concerning only examination turn.

“Accelerated examination” does not mean reducing net examination time.



However, PPH scheme aims easing search/examination burden as a result of utilization of the OEE search/examination result.

◆ Too many PPH requests?

➡ *Ceiling can be set.*

Many guidelines have this sentence;

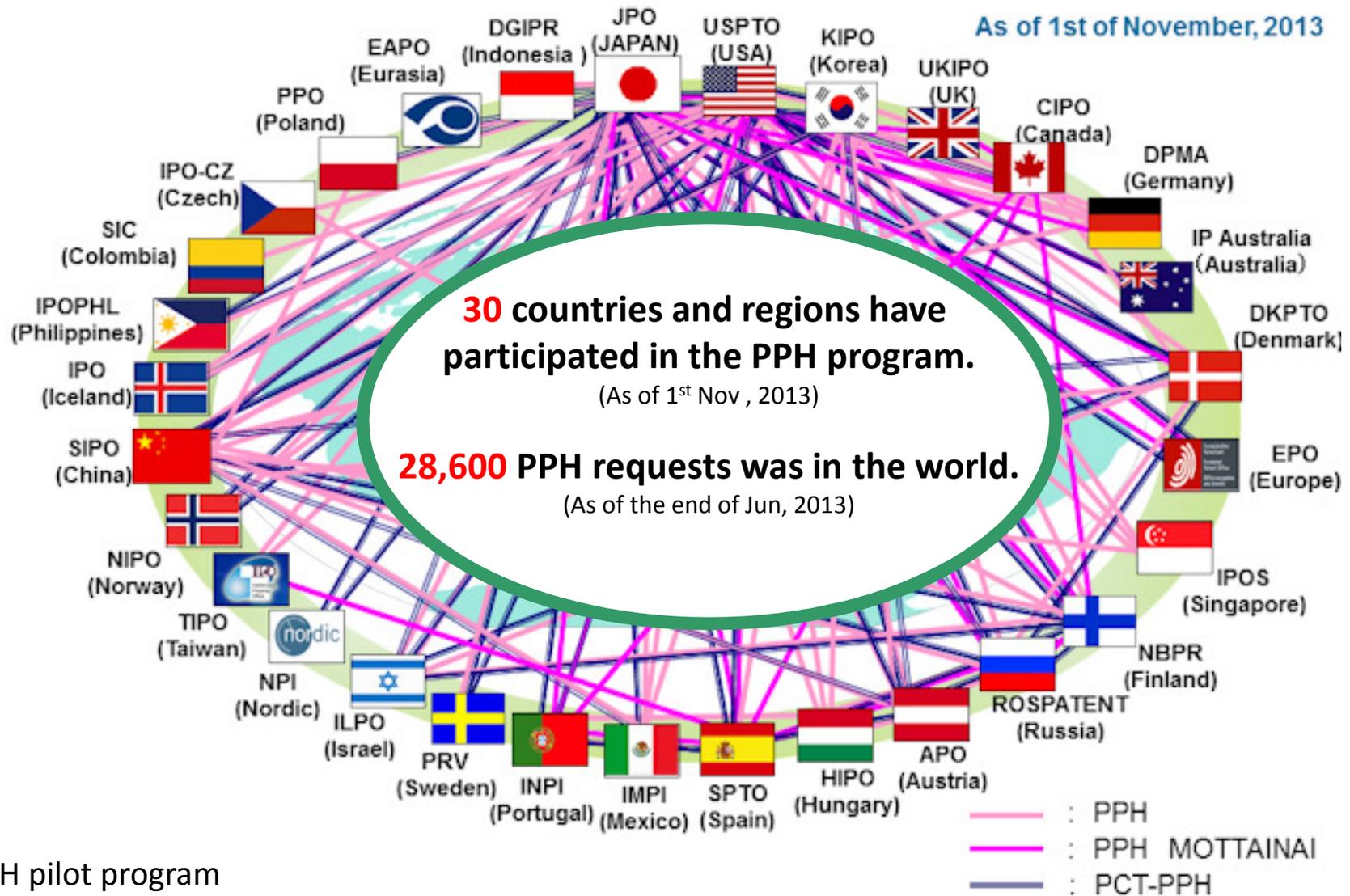
“The Offices may terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.”.

◆ New legal framework?

➡ *No, Implementation basis.*

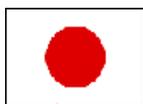
Recent Development of PPH

Expanding PPH Network

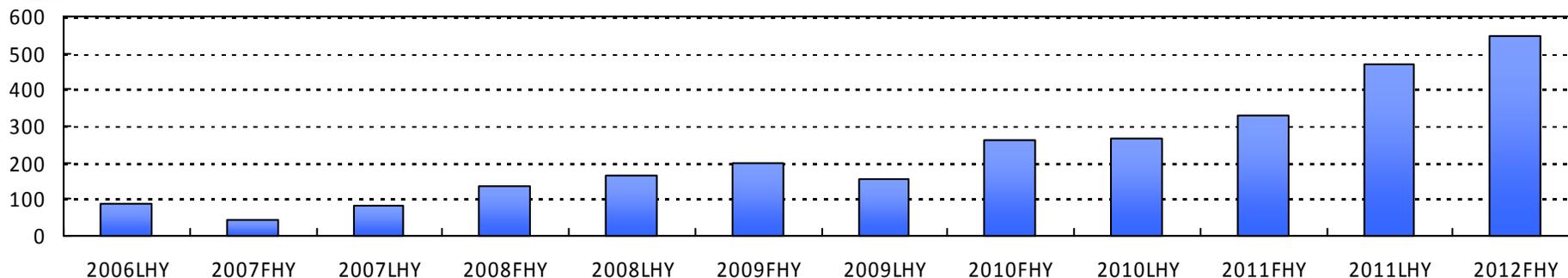


The first PPH pilot program was commenced in July 2006 by the JPO and the USPTO

Number of PPH Requests (received by JPO)



(Except JPO-JPO PCT-PPH)



Breakdown

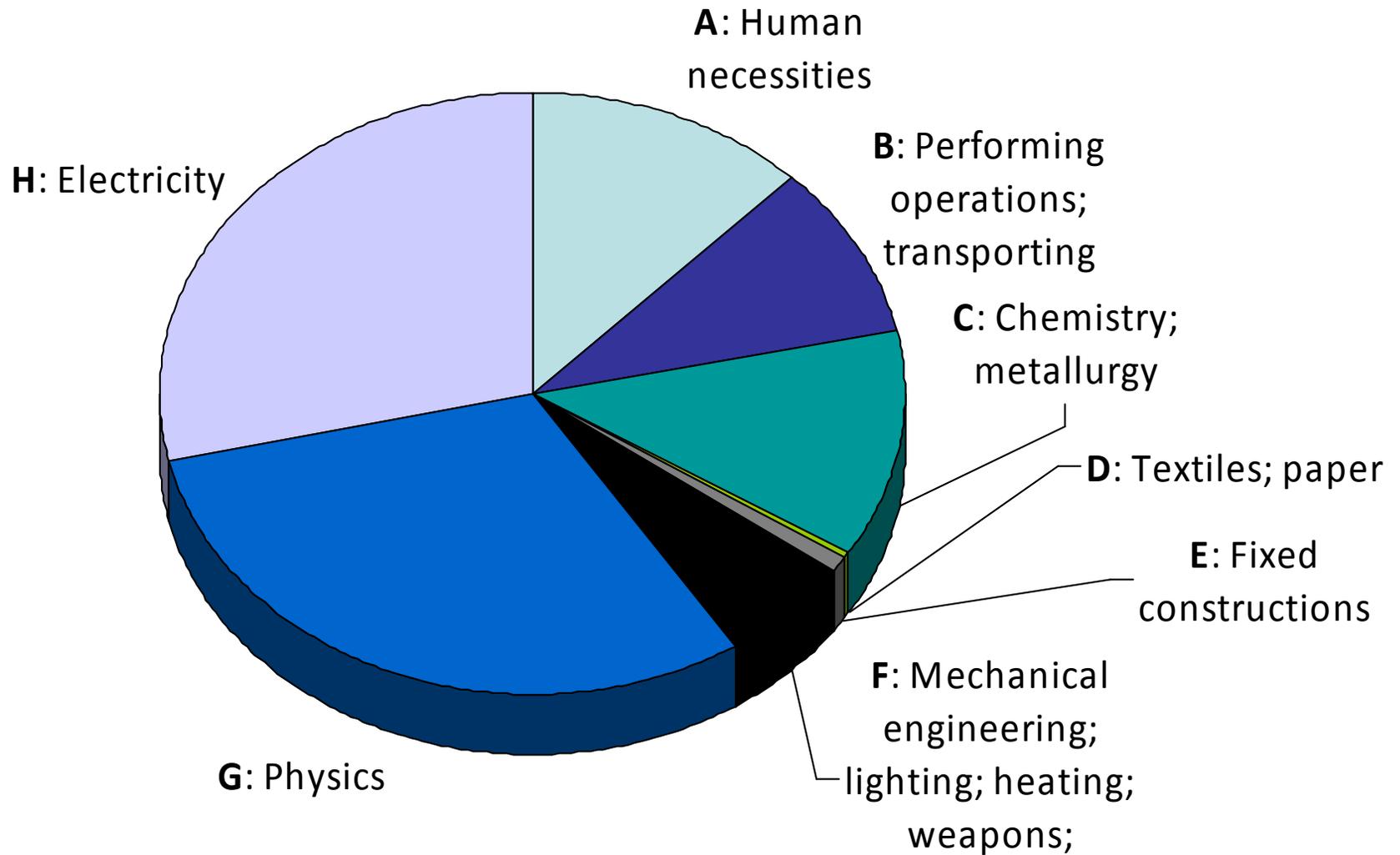
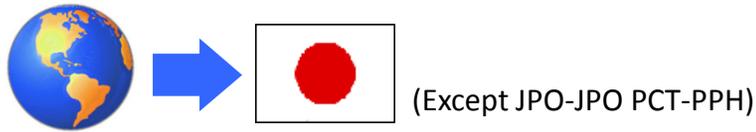
Bilateral PPH

OEE	Number of PPH Requests	OEE	Number of PPH Requests
US	1772	HU	2
KR	202	ES	0
GB	70	MX	0
CA	4	PT	0
DE	93	IL	0
DK	10	TW	2
EP	110	NO	0
SG	0	CN	10
FI	6	IS	0
RU	3	PH	0
AT	1		

PCT-PPH

OEE	Number of PPH Requests
US	19
EP	428
FI	0
ES	2
SE	8
XN	3
CN	7

Number of PPH Requests by IPC Sections



PPH Development in Asia



JP	2011.11~
US	2011.12~
DE	2012.1~
KR	2012.3~
RU	2012.7~
DK	2013.1~

JP	2007.4~
US	2008.1~
DK	2009.3~
UK	2009.10~
CA	2009.10~
RU	2009.11~
FI	2010.1~
DE	2010.7~
ES	2011.7~
CN	2012.3~
MX	2012.7~
HU	2013.1~
SG	2013.1~

US	2009.7~
JP	2009.1~
KR	2013.1~

JP	2012.3~
US	2013.1~

US	2012.3~
DK	2012.1~
JP	2012.3~
FI	2012.10~
CA	2012.11~



PPH Development in Latin America



US*	2011.3~
JP*	2011.7~
ES	2011.10~
KR	2012.7~

* MX-US & MX-JP program are permanent now.

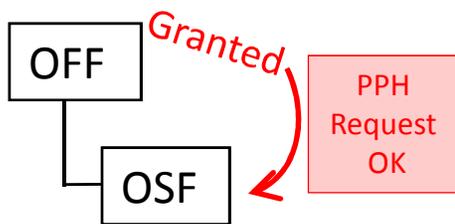


US	2012.9~
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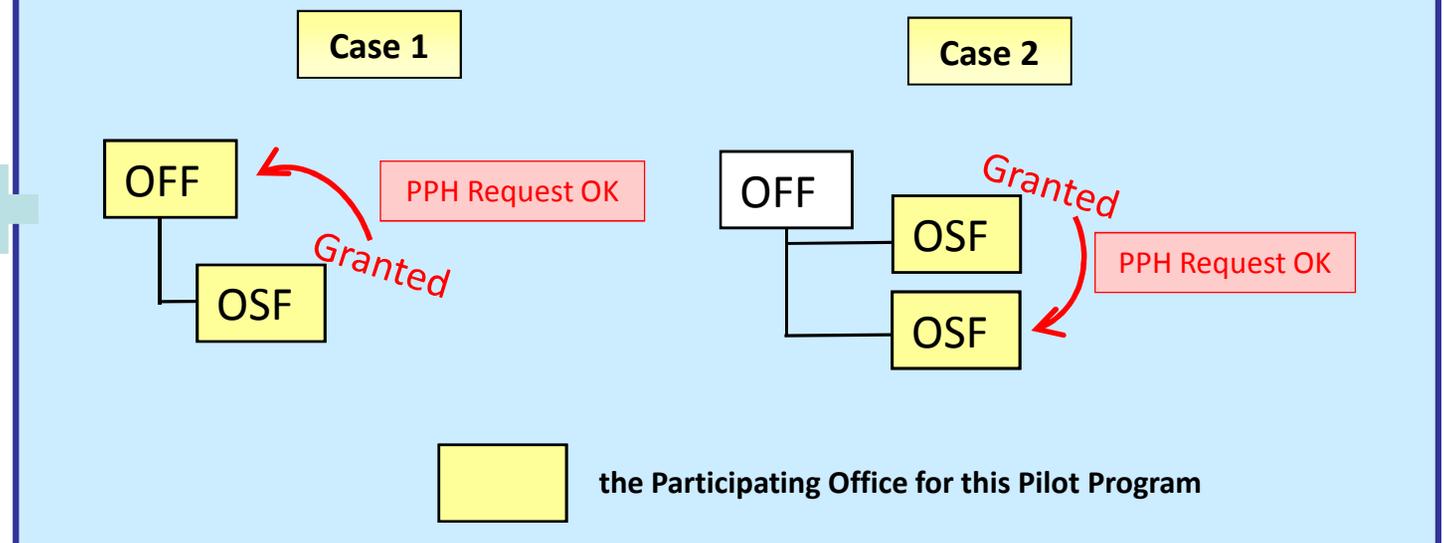


- To make the PPH program more user-friendly and available for patent applicants, *the PPH MOTTAINAI Program* launched on 15th of July, 2011.
 - JPO (Japan), USPTO(USA), UK-IPO(UK), CIPO (Canada), IP Australia (Australia), NBPR (Finland), Rospatent (Russia) and SPTO (Spain) adopted this pilot program.
 - EPO has commenced this pilot program on 29th of January, 2012.
- Under this pilot program, PPH request is eligible, whether or not the office which provides the examination results is the Office of First Filing (OFF).

The eligible example under conventional PPH



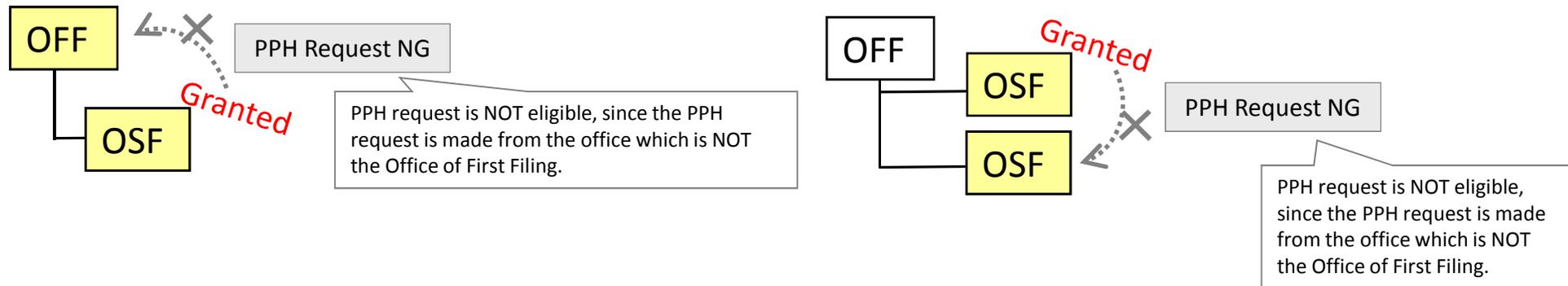
The newly eligible examples under the PPH MOTTAINAI Pilot Program



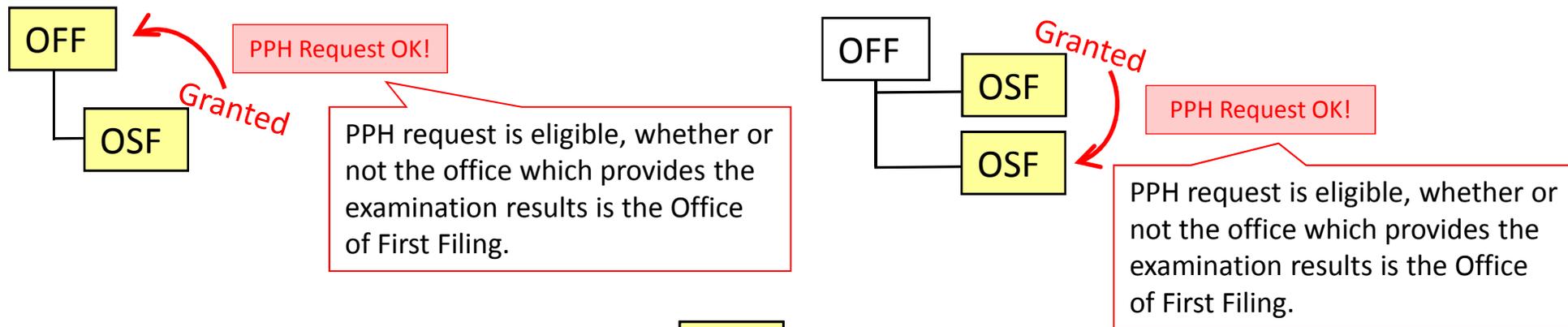
Case 1

Case 2

Under the "First File Principle"



Under the "PPH MOTTAINAI Model"



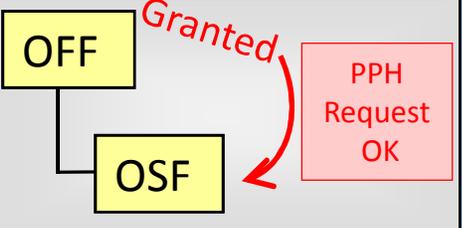
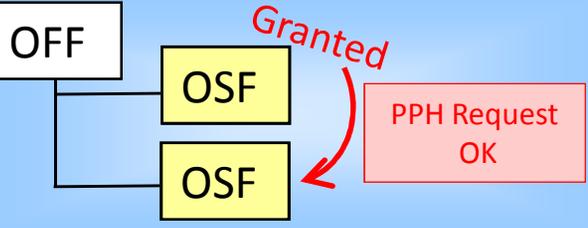
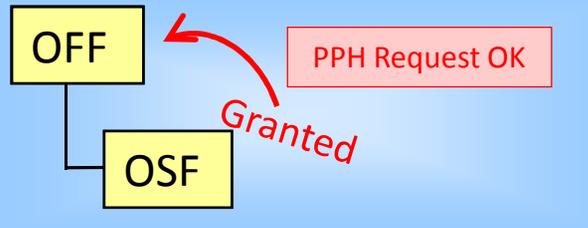
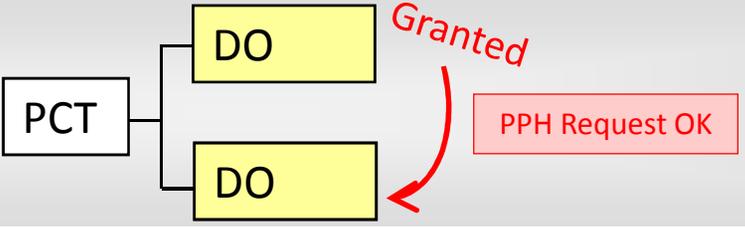
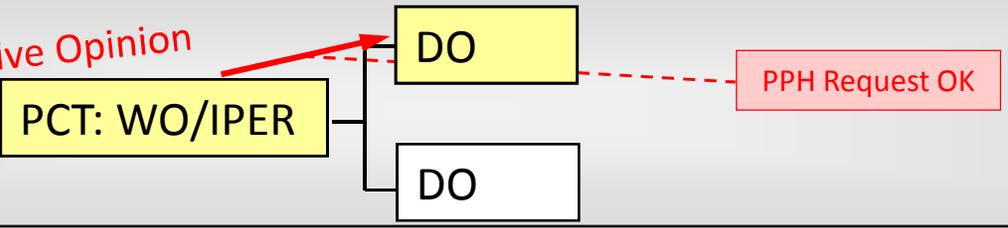
 the Participating Office for this Pilot Program

New terminology of the first and second offices

OEE: Office of **E**arlier **E**xamination

OLE: Office of **L**ater **E**xamination

PPH MOTTAINAI

Type		A	B	C
Principle		First File	Earlier Examination (MOTTAINAI** model)	
Concept		PPH requested office can utilize the examination result of only OFF which has PPH agreement with the office.	PPH requested office can utilize the earlier examination result created by OSF which has PPH agreement with the office.	
Examination Results	Paris Route			
	Direct PCT Route			
PCT Work Product	PCT-PPH			

* Two yellow boxes mean PPH agreement is available between the two offices

** "MOTTAINAI" is a Japanese term meaning "a sense of regret concerning waste when the intrinsic value of an object or resource is not properly utilized." It is said that its concept is made up by Reuse, Recycle, Reduce and Respect.

PPH Portal Website

<http://www.jpo.go.jp/ppph-portal/>

PPH Patent Prosecution Highway
Patent Prosecution Highway Portal Site

Top Booklet	About PPH Statistics	PPH MOTTAINAI Access to Dossier	★ Procedures Events
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Procedures

All PPH Procedure Information

PPH Patent Prosecution Highway
Patent Prosecution Highway Portal Site

Top Booklet	About PPH Statistics	PPH MOTTAINAI Access to Dossier	★ Procedures Events
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Statistics

PPH Statistics

OFF/OEE/ISA or IPEA

JP	US	KR	GB
JP	US	KR	GB
US	JP	KR	GB
KR	JP	US	GB
GB	JP	US	KR
CA	JP	US	KR
DE	JP	US	KR
AU	JP	US	KR
DK	JP	US	KR
EP	JP	US	KR
SG	JP	US	KR

Latest PPH Information in the world

Number of PPH(using the nation)

	JP	US	KR	GB
JP	5520	1395	24(0)	10
US	1772(44)	627	49(1)	24
KR	202	957	6	
GB	70(4)	294	27	1
CA	4(4)	152	1	0(0)
DE	93	80	19	0
AU	-	153	-	-
DK	10	107	4	-
EP	110(55)	281	-	-
SG	0	2	-	-
FI	6	26	0	-
RU	3(0)	10	0	-
AT	1	1	-	-
HU	2	3	-	-
ES	0	0	0	-

PPH Patent Prosecution Highway
Patent Prosecution Highway Portal Site

Top Booklet	About PPH Statistics	PPH MOTTAINAI Access to Dossier	★ Procedures Events
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Expanding PPH Network

As of 1st of November, 2012

Page for Printing

Legend:
 - PPH (red line)
 - PPH MOTTAINAI (green line)
 - PCT-PPH (blue line)

Notification

1 November 2012	New PPH(CIPO-ILPO) Program commenced
15 October 2012	New PPH(NBPR-ILPO), New PCT-PPH(NBPR-ILPO) Program commenced
1 October 2012	New PPH(USPTO-IPO-CZ) Program commenced