

The Patent Prosecution Highway

The Patent Prosecution Highway (PPH) provides a means for accelerating patent application examination at a second patent office, if examination work has already been conducted at a first patent office with whom a PPH agreement is in place. If claims of an application have been found acceptable by a first office (usually the office of first filing), accelerated examination of a corresponding application at a second office may be requested. The PPH allows a second patent office to make use of relevant work already conducted by a first office when examining an application.

PPH agreements between UKIPO and other offices and EPO and other offices

The UKIPO currently has a PPH agreement with the Japanese Patent Office (a permanent agreement from March 2010), the United States Patent and Trademark Office (agreement extended indefinitely) and the Korean Intellectual Property Office (agreement extended indefinitely).

The EPO currently has a PPH agreement with the United States Patent and Trademark Office (USPTO) and the Japanese Patent Office (JPO) until 28 January 2012.

A tripartite agreement also exists between the EPO/USPTO/JPO based on a PCT application where the EPO/USPTO/JPO acted as International Search Authority or International Preliminary Examination Authority. PPH can be requested upon national phase entry in EPO/USPTO/JPO based on positive comments received from the International Search Authority or International Preliminary Examination Authority.

Requirements for requesting PPH

- There must be a PPH agreement in place between the second patent office where PPH is being requested and the first patent office where examination work has already been conducted.
- The patent applications at the first and second patent offices must be corresponding and must have at least the same priority/filing dates (this criteria is much stricter for patent offices which have not signed up to the MOTTAINAI pilot scheme and exact criteria therefore vary depending on the patent offices involved e.g. the order of filing of patent applications and the countries from which the applications initially claim priority may be relevant).
- At least one claim must have been accepted by the first patent office where examination work has already been conducted.
- All claims on file at the second patent office where PPH is being requested must sufficiently correspond to one or more of the claims indicated as accepted by the first patent office.
- Examination at the second patent office where PPH is being requested should not have begun.

Advantages of the PPH

Using the PPH has many advantages for patent applicants. The accelerated examination reduces the time for prosecution and also reduces costs. In some offices, the period of time until a first examination report is received has been reduced from an average of 27 months to 3 months. Further, at some offices, PPH applications can have a grant rate of 95% with more than 20% of PPH applications going to grant with one examination report being received. Thus, requesting PPH at a second patent office based on claims accepted at a first patent office should reduce the number of examination reports received and should therefore reduce prosecution costs for those applications.



Further advice

For further advice please contact us at Dehns using the details provided below.

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