



Fast Track to Action — A Look at the Patent Prosecution Highway

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Government Benefits from PPH

- Incoming PPH applications allows Patent Offices to gain efficiencies by receiving substantially similar applications and examination results from another office.
- Outgoing PPH applications allow applicants of the nation to receive quicker results in foreign nations.
- PPH allows governments to test, measure and refine the benefits of actual worksharing.



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PPH Requests Across Tech Centers

- As of 1/1/09, the USPTO received a total of 980 Patent Prosecution Highway requests:
 - TC 1600 41 requests
 - TC 1700 132 requests
 - TC 2100 171 requests
 - TC 2400 17 requests
 - TC 2600 316 requests
 - TC 2800 171 requests
 - TC 3600 69 requests
 - TC 3700 63 requests



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Applicants Benefit from PPH

- Quicker results
- Higher allowance rates
- More cost-effective compact prosecution
- The most significant data comes from the Japan-US PPH where there have been over 800 requests from Japan to the US.



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Japan-US PPH Results--Timeliness

- PPH between Japan and the US has made patent decisions much quicker. The time to first action decreases dramatically:

	<u>Regular cases</u>	<u>PPH cases</u>
Japan	26 months	2-3 months
US	26.2 months	3 months



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Japan-US PPH Results—Allowance Rates

- PPH between Japan and the US has led to much higher allowance rates:

	<u>Regular cases</u>	<u>PPH cases</u>
US	44.2 %	94 %
Japan	49 %	65 %



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Japan-US PPH Results—Compact Prosecution

- PPH from Japan to the US has led to a quicker, more compact prosecution.
- The average number of actions per disposal is reduced by 40%:
 - 2.9 average actions in a regular case
 - 1.7 average actions in the PPH



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Patent Prosecution Highway Growth

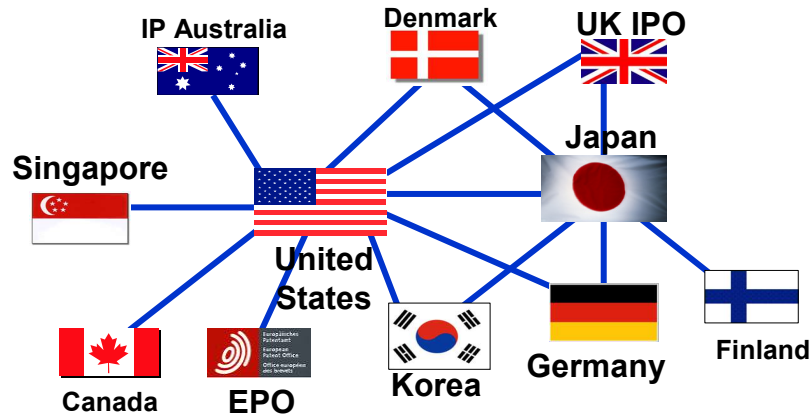
- The success of the PPH pilot program with Japan has led the US to enter into PPH programs with:
 - Australia
 - Canada
 - Denmark
 - European Patent Office
 - Germany
 - Korea (now a permanent program)
 - Singapore
 - United Kingdom

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Patent Prosecution Highway



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PPH Requests By Country

PPH Partner	Type	Start Date	End Date	Requests (as of 1/1/09)
Japan	pilot	7/3/06	1/3/08	274
Japan	full	1/4/08	..	520
United Kingdom	pilot	9/4/07	9/4/08 – extended	50
Korea	pilot	1/28/08	1/28/09 (now full)	125
Canada	pilot	1/28/08	1/28/11	6
Australia	pilot	4/14/08	4/14/09	4
EPO	pilot	9/29/08	9/29/09	1



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PPH Requirements--Japan to US

- Receive at least one allowable claim in the JPO.
- File or amend claims in a related application to *sufficiently correspond* to what was allowed in the first office. Request must be *properly* submitted electronically before USPTO examination begins.
- Request must include, *in English*: the allowed claims from the first office, a table showing how the claims correspond, the relevant office actions in the first office, an information disclosure statement listing the documents cited by the examiner in the JPO.



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PPH Requirements--US to Japan

- Receive at least one allowable claim in the USPTO.
- File or amend claims in a related application to sufficiently correspond to what was allowed in the first office.
- Properly submit a request form—"The Explanation of Circumstances Concerning Accelerated Examination"--before JPO examination begins.
- Submit the copies of all USPTO office actions, copies of all allowed claims, copies of references cited and a claim correspondence table.
- Where submissions are available on PAIR, they need not be submitted but must be listed. Translations are generally not necessary.



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What the PPH is Not

- It is not a system of mutual recognition. A full search and examination is required.
- It is not related to the USPTO Accelerated Examination Program—e.g. there is not a requirement to submit additional materials like a pre-examination search and examination support document.
 - The same requirements regarding duty of candor and good faith that apply in regular applications also apply in cases filed under the PPH programs.



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Strategic Decisions/Risks

- How do you weigh the benefits of quicker, more compact prosecution with the requirements of the PPH?
- How might the Patent Prosecution Highway programs affect an applicant's decision to choose where to file first?
- What will be the additional benefits or risks in litigation?



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Thank You for Your Time!

- Special thanks to Horace Ng, Sam Kais and Anne Dollard for participating in the panel.
- If you have any questions, please do not hesitate to contact us at:
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