



PATENT PROSECUTION HIGHWAYS: ACCELERATING THE PATENT EXAMINATION PROCESS

WHAT IS A PATENT PROSECUTION HIGHWAY?

To speed up the patent examination process, a set of Patent Prosecution Highways (“PPH” or “Patent Highways”) has been launched in the recent past. These Patent Highways have been established between national and regional patent offices all around the world, most of them as two-way highways between one patent office and another, to share information relating to the examination process, and to permit each participating patent office to benefit from the work already done by the other. The aim of the Patent Highways is to improve patent quality and reduce the examination workload through faster procedures. Therefore, an applicant whose claims are determined to be patentable by the patent office of first filing and who has filed a corresponding application with a participating patent office in another country may request accelerated examination while at the same time allowing the office of first filing to provide the results of its work to the patent office in the other country.

WHICH ARE THE MOST IMPORTANT PATENT PROSECUTION HIGHWAYS?

To date, Patent Highways as pilot programs connect the world’s most relevant patent offices. Of the multitude of existing Patent Highways, the Patent Highways between the European Patent Office (“EPO”) and the United States Patent and Trademark Office (“USPTO”) as well as the Japan Patent Office (“JPO”) could turn out to be the most important patent highways in the near future. These highways could be an effective mechanism to obtain patents in the major economic regions in a much shorter time than using the established procedures.

On January 29, 2010, a Patent Cooperation Treaty/ Patent Prosecution Highway (“PCT/PPH”) pilot program was established for a two-year period. Before this pilot program was established, the PPH program was limited to using search and examination results of a corresponding national application under the Paris Convention. Under this pilot program, a

favorable PCT result issued by the EPO, JPO, or USPTO can be used to fast-track the patent examination process.

WHAT ARE THE REQUIREMENTS FOR PARTICIPATION IN THE PATENT HIGHWAYS AT THE EPO BASED ON APPLICATIONS FILED AT THE USPTO OR JPO?

In order to be eligible to participate in the Patent Highway at the EPO, it is a precondition that the European (“EP”) application be a European direct application validly claiming the priority of at least one application filed, e.g., at the USPTO or the JPO or an international Patent Cooperation Treaty (“PCT”) application that has entered the regional phase before the EPO. In the case of a direct EP application claiming the priority of a U.S. patent application, the date of its filing must have been after September 29, 2008; otherwise, the EP application must have been filed or entered the regional phase after January 29, 2009.

It is also possible to participate with a divisional EP application of an earlier EP application that validly claims priority of at least one application filed with the USPTO or the JPO.

To participate in the Patent Highway program at the EPO, the applicant must file a request for participation and submit a copy of all the office actions for each of the USPTO or JPO applications. In case of the JPO, the applicant must also file a copy of the request translated into one of the EPO official languages.

In addition, the applicant must submit copies of all documents other than patent documents cited in the USPTO or JPO office actions. In the case of an international patent application, the applicant must submit a copy of the written opinion of the International Searching Authority (“WO-ISA”) or the international preliminary examination report (“IPER”) and a translation of it in one of the EPO official languages, as well as all documents other than patent documents. The EPO may also request a translation of all documents into one of the EPO official languages.

The basis for the acceleration of the examination process is always at least one patentable/allowable claim of a U.S. or Japanese (“JP”) application or can be based on the latest PCT work product—the WO-ISA or the IPER—established by the EPO, USPTO, or JPO as ISA or International Preliminary Examining Authority (“IPEA”), where this work product determines claims to be patentable/allowable. All the claims in the EP application that should benefit from the Patent Highway must correspond sufficiently or be amended to sufficiently correspond to these claims already considered to be patentable/allowable. Claims will be considered to sufficiently correspond where they are of the same or similar scope, or where the claims of the EP application are narrower in scope than the claims in the USPTO, JPO, or PCT application. In addition, it is also required to submit a claims correspondence table in English, which has to indicate how all the claims in the EP application correspond to the patentable/allowable claims in the U.S., JP, or PCT application. As a further requirement, the examination of the EP application should not yet have started at the time the request is made.

WHAT CONSIDERATIONS FOR PARTICIPATING IN THE PATENT HIGHWAYS AT THE USPTO BASED ON APPLICATIONS FILED AT THE EPO ARE IMPORTANT?

Generally, an applicant who has one or more allowed claims in an application from a country having a PPH agreement with the U.S. can file a petition to make the U.S. application special. More specific to the EPO, the EPO-USPTO PPH program commenced on September 29, 2008, and it has been extended until September 29, 2010.

Many different types of U.S. applications are candidates for the EPO-USPTO PPH program. For example, a U.S. application with a Paris Convention priority claim to an EP application can be a part of the PPH program. As another example, an applicant can use a favorable Extended European Search Report as the basis for a PPH request in the U.S. application. All claims in the U.S. need to correspond sufficiently to the allowable EP claim.

Compared with certain other petitions to make special for accelerating prosecution in the U.S., the petition to make special based on the PPH program has advantages. For example, the petition to make special based on the PPH program can avoid having to make potentially narrowing statements in the prosecution history.

HOW CAN THE “THREWAY” BE USED?

The Patent Highway between the EPO, the USPTO, and the JPO is a “Threeway” that speeds up the examination procedures in all three patent offices at the same time.

A PCT patent application may be filed with *any* receiving office and may claim priority from an earlier application filed with *any* member of the Paris Convention or the WTO. Either the EPO, the USPTO, or the JPO has to have been the ISA; if a Demand for International Preliminary Examination (Chapter II) has been filed, the IPEA is included as well. This means that a participation at the “Threeway” is possible even if the office of first filing is not a member of the “Threeway” patent offices.

In addition, one of the major differences of participating in the “Threeway” is the possibility of dealing with observations made by a patent office. Observations of the WO-ISA or IPER may be overcome by the applicant by means of an explanation why the claims are patentable/allowable. There is also an opportunity to file amendments to overcome the observations.

DO THE PATENT HIGHWAYS GUARANTEE A REASONABLE SPEED UP FOR PATENT PROSECUTION?

The aim of the Patent Highways is to significantly reduce the time to grant patents and to reduce the workload for patent offices and vice versa for applicants.

At least for EP patent applications, this effect may not be achieved to the same extent by requesting information on prior art, which will become compulsory in 2011, due to the fact that the EPO will then still not have copies of the office

actions of the other patent offices or the claims concordance table. Access to the files of another patent office is often not possible or only possible at a much later date.

For U.S. patent applications, a pendency reduction has been seen. For example, the average number of patent office actions before disposal of a case has dropped from 2.7 (for non-PPH cases) to 1.7 (for PPH cases). Of particular note is that PPH cases have a 93 percent allowance rate (versus 44 percent for non-PPH cases). A sizeable number of PPH requests currently come from the JPO (which has been in the program since 2006) and are filed in the technology area directed to cellular and digital communications.

Thus, Patent Highways are expected to have great potential to provide faster and cheaper examination procedures and should therefore be a benefit for all parties involved, especially if the intellectual property protected by the patent applications for which participation is applied is already on the market. An applicant and as its competitors are therefore not only able to get legal certainty within a shorter time as to whether an application will lead to a patent, but also applications with the same scope in the world’s most relevant markets may be obtained at approximately the same time.

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