



## The Global Patent Prosecution Highway: Enhancing Attractiveness for Applicants and Patent Offices

### History of Patent Prosecution Highways

During the last couple of years, a considerable number of Patent Prosecution Highway (“PPH”) programs between national and regional patent offices were launched. Five years ago, we commented on those involving the European Patent Office (“EPO”), the United States Patent and Trademark Office (“USPTO”), and the Japan Patent Office (“JPO”).<sup>1</sup> Since then, the programs have been refined and largely expanded.

Most PPH programs are initially limited to trial periods of one to three years, so that their feasibility can be assessed. Depending on the outcome of these assessments, the trials are extended or the programs are stopped. However, the assessments of unsuccessful programs are helpful in devising new trial programs. In that way, PPH programs are continuously improved so that the cooperating patent authorities will get the most out of their cooperation.

One well-known PPH program, for example, is the IP5 PPH program, which was launched in 2014 for a trial period of three years. Here, the five largest IP offices—the USPTO, the EPO, the JPO, the Korean Intellectual Property Office, and the Chinese Patent

Office (“SIPO”)—cooperate to improve efficiency and address the backlogs in applications worldwide.

However, PPH programs are not just limited to the world’s largest IP offices. A large number of national offices of various countries around the globe, including the German Patent and Trademark Office (“GPTO”), profit immensely from PPH programs by tightening their cooperation with the various participating patent offices.

A PPH provides a framework in which an application whose claims have been determined to be patentable by an Office of First Filing or Office of Earlier Examination (“OEE”) is eligible to go through an accelerated examination in an Office of Second Filing or Office of Later Examination (“OLE”) with a simple procedure, upon an applicant’s request. Thus, under a PPH, the participating offices have agreed that when the applicant gets at least one claim granted by the OEE, the applicant is eligible to request fast-track examination of corresponding claims at the OLE.

In this way, a PPH allows the participating patent offices to more efficiently examine patent applications by avoiding duplicating work that examiners

in other parts of the world have already done. In addition, it gives applicants advantages to obtain patents faster and more efficiently.

In 2014, there were PPH programs involving 32 patent offices, and 23,465 PPH requests were filed.<sup>2</sup> The top OLEs were: (i) the USPTO, with 7,462 requests, (ii) the SIPO, with 3,951 requests, and (iii) the JPO, with 3,014 requests. By way of comparison, the EPO was OLE in 1,738 cases, and the GPTO was OLE in 640 cases.

With regard to acting as OEEs, the top-three list differs dramatically: (i) the JPO had 9,790 cases, (ii) the USPTO had 6,858 cases, and (iii) the EPO had 2,432 cases. By comparison, the GPTO was involved in just 94 cases as OEE.

## Globalization of Patent Prosecution Highways

On January 6, 2014, the Global Patent Prosecution Highway (“GPPH”) pilot was launched, and as of July 6, 2015, there are 21 patent offices involved in the GPPH pilot. The patent offices of the following countries/regions are participating in a truly global cooperation: Austria, Hungary, Russia, Australia, Iceland, Singapore, Canada, Israel, South Korea, Denmark, Japan, Spain, Estonia, Nordic Patent Institute, Sweden, Finland, Norway, the United Kingdom, Germany, Portugal, and the United States.

In addition, the GPPH includes work carried out under the Patent Cooperation Treaty (“PCT”). This allows an applicant to request accelerated processing based on a written opinion or examination report that was prepared by one of the participating national offices acting as an International Search Authority/International Preliminary Examination Authority for a corresponding PCT application.

Even though the patent applications for all PPH programs are examined in a similar way, most PPH programs regulate just the cooperation between two, or between a few selected patent offices; thus, the qualifying requirements vary slightly among PPH programs. The GPPH pilot uses a single set of qualifying requirements and aims to simplify and improve the existing PPH network so that it is more accessible to users, thereby simplifying the existing PPH network.

According to GPPH regulations, each participating patent office can continue its various PPH cooperations under the GPPH. For example, the GPTO, after joining the GPPH on July 6, 2015, continues to maintain its bilateral cooperation under the PPH with the SIPO, which does not take part in the GPPH. This coordination of the GPPH pilot with other PPH programs provides a high degree of flexibility for both applicants and patent offices.

## Eligibility Requirements of the Global Patent Prosecution Highway

Patent offices will provide accelerated processing under the GPPH pilot for applications meeting the following requirements:

- The applications before the OEE and the OLE have the same earliest date (which may be the priority date or the filing date).
- The OEE has found at least one claim to be allowable. The indication that a claim is allowable will be provided as an explicit statement in any substantive work product from the OEE. Claims determined to be novel, inventive, and industrially applicable in PCT work products are deemed allowable in this document.
- All claims presented for examination under the GPPH pilot must correspond sufficiently to one or more of the claims found allowable by the OEE.
- The OLE has not begun substantive examination of the application. However, OLEs may still choose to allow GPPH requests filed after examination of the OLE application has begun, depending on the particular circumstances and needs of the OLE and its stakeholders.
- A request for substantive examination must have been filed at the OLE, either at the time of the GPPH request or previously.

To request GPPH processing, applicants need to file at least the following at the OLE:

- A completed GPPH request form,
- A copy of the claims found to be allowable by the OEE (if the copy has not already been made available to the OLE), and

- A copy of the work product relevant to the allowability of the claims (if the copy has not already been made available to the OLE).

However, some participating offices require further information such as translations, a claim correspondence table, etc.

## Effect of the Global Patent Prosecution Highway on a National Patent Office in Europe

The goal of the European Union (“EU”) is to offer a truly European patent that has a unifying effect in the 25 participating Member States of the 28 EU countries. The EPO will become responsible for this patent. The PPH programs might assist the EU national patent offices in remaining attractive to applicants or even becoming more attractive despite a kind of competition with the EPO. The GPTO serves as a good example of this effect.

Since 2013, the GPTO has received more direct filings than the EPO. In 2014, approximately 66,000 first applications were filed with the GPTO,<sup>3</sup> and about 60,000 first applications were filed with the EPO<sup>4</sup> (filings under the PCT are not included in these numbers). This is remarkable, given the strong competition by the EPO.

The GPTO has taken various measures to increase its popularity and attractiveness. As a national patent office, its ability to adapt to the permanently changing IP world might be faster than that of the EPO. For example, in 2013, the Act to Amend the German Patent Act relaxed the translation requirements at the GPTO, so the GPTO can now perform searches and first examinations based on English and French application documents. The search report includes a substantive statement on patentability comparable to the search opinion of the EPO. Thus, the same service is now provided by the GPTO for less than one-fourth of the official fees.<sup>5</sup> Perhaps more important is the effect of the acceptance of foreign language application documents and the preparation of search and examination

reports in English and French, in addition to German, for existing and future cooperation with other patent offices.

Further, when the demand for work sharing between the national patent offices was recognized at the GPTO, due to the amount of applications filed in the multiple national offices and hence the increasing cost and associated workload, the GPTO started its first PPH cooperation with the JPO and the USPTO approximately seven years ago. By 2014, the GPTO already maintained cooperation with nine patent offices through its PPH network covering the following countries: Austria, Finland, South Korea, Canada, Japan, the United Kingdom, China, Singapore, and the United States.

By joining the GPPH program on July 6, 2015, the GPTO extended its PPH network by 12 more patent offices, so fast-track prosecution is now also possible in the following patent offices: Australia, Iceland, Portugal, Denmark, Israel, Russia, Estonia, Nordic Patent Institute, Spain, Hungary, Norway, and Sweden.

The main advantage of the GPPH over the PPH at the GPTO is not only the newly extended network of cooperating patent offices but also the existence of just one single arrangement with one single set of qualifying requirements that is applied by all participating offices, instead of multiple bilateral arrangements with different sets of qualifying requirements. In addition, the GPTO has not introduced any fees for GPPH processing thus far, which is in keeping with the GPTO’s existing practice of processing PPH requests free of charge for the applicants.

Filing a patent application initially with a participating national office such as the GPTO and then requesting fast-track prosecution through the GPPH at selected participating national offices can be quicker and less expensive than filing internationally under the PCT or filing a European patent application. Thus, both patent offices and applicants benefit from the GPPH pilot.

## Lawyer Contacts

For further information, please contact your principal Firm representative or one of the lawyers listed below. General email messages may be sent using our “Contact Us” form, which can be found at [www.jonesday.com/contactus/](http://www.jonesday.com/contactus/).

### **Dorothee M. Weber-Bruls**

Frankfurt  
+49.69.9726.3960  
[dweber@jonesday.com](mailto:dweber@jonesday.com)

### **Andreas Holzwarth-Rochford**

Frankfurt  
+49.69.9726.3986  
[aholzwarth@jonesday.com](mailto:aholzwarth@jonesday.com)

### **Matthias Euler**

Frankfurt  
+49.69.9726.3959  
[meuler@jonesday.com](mailto:meuler@jonesday.com)

## Endnotes

- 1 Jones Day *Commentary*, May 2010 “[Patent Prosecution Highways: Accelerating The Patent Examination Process.](#)”
- 2 “[Cumulative Number of PPH Requests, 2014](#),” Patent Prosecution Highway Portal Site.
- 3 “[Jahresbericht 2014](#),” Deutsches Patent- und Markenamt.
- 4 “[European patent filings](#),” European Patent Office.
- 5 Holzwarth-Rochford, *DPMA konkurriert stärker mit dem EPA: Der Kampf um Erstanmeldungen* [Stronger competition between GPTO and EPO—The fight for first filings]; GRUR-Prax, vol. 5, p. 374-376.