Patent Prosecution Highway (“PPH”)

Terry Stalford
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Patent Prosecution Highway

- What is the PPH?
- Worldwide Availability of PPH
- Use of PPH
- Advantages of PPH/Considerations
- Future developments in the PPH
Patent Prosecution Highway

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Patent Prosecution Highways

- A work-sharing program that lets examiners use the search and examination results from patent offices that have bilateral, trilateral or multilateral PPH agreement(s).
- Leverages fast-track examination procedures already available at offices (PACE in EPO) to allow applicants to obtain corresponding patents faster and more efficiently.
- Under the PPH, an application whose claims have been determined to be patentable in an Office of First Filing (OFF) may be eligible to go through an accelerated examination in an Office of Second Filing (OSF).
- More recently under the PPH, an application whose claims have been determined to be patentable in the PCT may be eligible to go through an accelerated examination in a corresponding application.
Example Use of PPH (Paris)
Example Use of PPH (Paris)

A PPH request can be filed even if there is not a direct claim of priority to the OFF application with patentable claims.

- Applicant must explain relationship between the U.S. application and the OFF application with patentable claims.
Example Use of PPH (PCT)
General Requirements of PPH

- The application to be accelerated must have a qualifying relationship to the OFF/PCT application;
- At least one claim in the OFF/PCT application must be indicated as patentable;
- All of the claims in the application must “sufficiently correspond” to the claims in the OFF/PCT application; and
- Substantive examination for the application cannot have already started.
Relationship for PPH in USPTO (Paris)

The U.S. application must be:

- a Paris Convention application which either validly claims priority to one or more applications filed in a qualifying OFF, or validly claims priority to a PCT application that contains no priority claims;
- a national stage application under the PCT, which PCT application validly claims priority under sec. 365(b) to an application filed in the OFF; validly claims priority to another PCT application that contains no priority claim; or contains no priority claim; or
- a bypass application filed under 35 USC 111(a) that claims benefit under 35 USC 120 to a PCT application, which PCT application 1. Claims priority under 35 USC 365(b) to an application filed with the OFF, or 2. Claims priority under 35 USC 365(b) to a PCT application that contains no priority claims, or 3. contains no priority claims
Relationship for PPH in USPTO (PCT)

The U.S. application must be:
- a national stage entry of the corresponding PCT application;
- a national stage entry of another PCT application which claims priority to the corresponding PCT application;
- a national application that claims domestic/foreign priority to the corresponding PCT application;
- a national application which forms the basis for the priority claim in the corresponding PCT application;
- a continuing application of an OSF application that satisfies one of the conditions above; or
- if the USPTO is the OSF, a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.
OFF/OSF Relationship in EPO

PPH (Paris Route) - the EPO application is:
- a European direct/Paris Convention application validly claiming the priority of one or more applications filed with the USPTO or JPO; or
- a PCT application which has entered the regional phase before the EPO (Euro-PCT) and was filed as of September 29, 2008, or has entered the regional phase respectively as of January 29, 2010.
- A divisional EP application of an earlier filed application in the EPO, which validly claims the priority of one or more applications filed with the USPTO or JPO, is considered to be eligible.

PCT-PPH – the EPO application is:
- a regional phase application of a PCT application filed with any receiving Office, which may claim priority from an earlier application filed with any member of the Paris Convention or the WTO. Either the JPO or the USPTO has been ISA. Where a demand for PCT Chapter II has been filed, one of these offices has been IPEA as well.
“Patentable”

- At least one claim in the OFF application must be determined to the “patentable.”
- “Patentable” – novel, includes inventive step, and has industrial applicability.
“Sufficiently Correspond”

Claims sufficiently correspond when they are of the same or similar scope (accounting for the differences due to translations and claim format requirement) as the allowed claims, or of a narrower scope than the allowed claims.

The additional limitation that makes the OSF claims narrower in scope must be presented in dependent form.

By RULE, claims cannot be amended to include subject matter not already recited in dependent claims.

– USPTO examiners appear to have some discretion to allow amendments beyond dependent claims.

In the EPO, a claim which introduces a new/different category of claims than those indicated to be allowable/patentable by the OFF is not considered to sufficiently correspond.
“Substantive Examination”

- Action on the merits.
- Does not include actions regarding formal documents such as missing parts; election/restriction requirements.
- Does not include Rule 161 EPC actions.
Mechanics of PPH in the USPTO

**All the requirements are met...now what?**

- (1) Submit a request to enter PPH by EFS to the USPTO.
- (2) Submit copies of all work product indicating the patentable subject matter (e.g., office actions, WO/ISA, WO/IPRP, WO/IPEA, EESR).
- (3) Submit an IDS including the documents in (2) and cited references (include certified translations if necessary).
- (4) Show claim “correspondence” in the request form or separately.
### Mechanics of PPH

#### CLAIM CORRESPONDENCE TABLE

<table>
<thead>
<tr>
<th>Claims in US Application as amended on December 30, 2010</th>
<th>Corresponding claim in</th>
<th>Explanation regarding the correspondence</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>1</td>
<td>US claim 1 is the same as DE claim 1 except that the claim has been edited to delete reference numbers and to promote clarity.</td>
</tr>
<tr>
<td>2</td>
<td>2</td>
<td>US claim 2 is the same as DE claim 2 except that the claim has been edited to delete reference numbers and to promote clarity.</td>
</tr>
<tr>
<td>3</td>
<td>-</td>
<td>US Claim 3 is canceled</td>
</tr>
<tr>
<td>4</td>
<td>3</td>
<td>US claim 4 is the same as DE claim 3 except that multiple dependencies have been removed and the claim edited to promote clarity.</td>
</tr>
<tr>
<td>5</td>
<td>4</td>
<td>US claim 5 is the same as DE claim 4 except that multiple dependencies have been removed and the claim edited to delete reference numbers and to promote clarity.</td>
</tr>
<tr>
<td>6</td>
<td>5</td>
<td>US claim 6 is the same as DE claim 5 except that multiple dependencies have been removed and the claim edited to delete reference numbers and to promote clarity.</td>
</tr>
<tr>
<td>7</td>
<td>6</td>
<td>US claim 7 is the same as DE claim 6 except that multiple dependencies have been removed and the claim edited to delete reference numbers and to promote clarity.</td>
</tr>
<tr>
<td>8</td>
<td>7</td>
<td>US claim 8 is the same as DE claim 7 except that multiple dependencies have been removed and the claim edited to delete reference numbers and to promote clarity.</td>
</tr>
<tr>
<td>9</td>
<td>8</td>
<td>US claim 9 is the same as DE claim 8 except that multiple dependencies have been removed and the claim edited to delete reference numbers and to promote clarity.</td>
</tr>
</tbody>
</table>
Patent Prosecution Highway

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Regarding PCT-PPH between KIPO and USPTO, KIPO(ISA/IPEA)→USPTO program has launched. USPTO(ISA/IPEA)→KIPO program has not launched yet.
USPTO PPH Programs

- Programs for both Paris Convention filings and PCT filings (“PCT-PPH”).
- All PCT-PPH programs are pilots.
EPO PPH Programs

Also programs for both Paris Convention filings and PCT filings (“PCT-PPH”)

All programs are pilots
DPMA PPH Pilot Programs

PPH programs with Japan, the U.S., Korea, and Canada.

<table>
<thead>
<tr>
<th>Country</th>
<th>PPH</th>
<th>PCT-PPH</th>
</tr>
</thead>
<tbody>
<tr>
<td>Canada (CIPO)</td>
<td></td>
<td>✔️</td>
</tr>
<tr>
<td>Japan (JPO)</td>
<td></td>
<td>✔️</td>
</tr>
<tr>
<td>Korea (KIPO)</td>
<td></td>
<td>✔️</td>
</tr>
<tr>
<td>USPTO (USA)</td>
<td></td>
<td>✔️</td>
</tr>
</tbody>
</table>
**APO PPH Pilot Programs**

PPH programs with Japan, the U.S., Finland, and Hungary.

<table>
<thead>
<tr>
<th>Country</th>
<th>PPH</th>
<th>PCT-PPH</th>
</tr>
</thead>
<tbody>
<tr>
<td>Finland (NBPR)</td>
<td>✔</td>
<td>✔</td>
</tr>
<tr>
<td>Hungary (HPO)</td>
<td>✔</td>
<td></td>
</tr>
<tr>
<td>Japan (JPO)</td>
<td>✔</td>
<td></td>
</tr>
<tr>
<td>USPTO (USA)</td>
<td>✔</td>
<td>✔</td>
</tr>
</tbody>
</table>
UKIPO Pilot PPH Programs

PPH programs with Japan, the U.S., and Korea.

<table>
<thead>
<tr>
<th>Country</th>
<th>PPH</th>
<th>PCT-PPH</th>
</tr>
</thead>
<tbody>
<tr>
<td>Japan (JPO)</td>
<td>✓</td>
<td></td>
</tr>
<tr>
<td>Korea (KIPO)</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>USPTO (USA)</td>
<td>✓</td>
<td>✓</td>
</tr>
</tbody>
</table>
SPTO Pilot PPH Programs

PPH programs with Japan, the U.S., and Canada.

<table>
<thead>
<tr>
<th>Country</th>
<th>PPH</th>
<th>PCT-PPH</th>
</tr>
</thead>
<tbody>
<tr>
<td>Canada (CIPO)</td>
<td>✔️</td>
<td>✔️</td>
</tr>
<tr>
<td>Japan (JPO)</td>
<td>✔️</td>
<td>✔️ ✔️</td>
</tr>
<tr>
<td>USPTO (USA)</td>
<td>✔️</td>
<td>✔️ ✔️</td>
</tr>
</tbody>
</table>
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Use of PPH at USPTO (Paris)

Cumulative Paris Route PPH Applications By TC and Month
Use of PPH at USPTO (Paris)

Count of New Paris Route PPH Filings by Region and Month
Use of PPH at USPTO (PCT)

Cumulative PCT-PPH Requests By TC and Month

Count of PCT-PPH Requests

Month

Feb-10 Mar-10 Apr-10 May-10 Jun-10 Jul-10 Aug-10 Sep-10 Oct-10 Nov-10 Dec-10

1600
1700
2100
2400
2600
2800
3600
3700
Null TC
Total
Use of PPH at USPTO (PCT)
Use of PPH at USPTO by TC

Cumulative Total of Paris-Route and PCT-PPH Cases

![Bar chart showing the count of PPH filings by count of PPH requests.](chart.png)
Hottest PPH Areas at USPTO by Art Group

- **Group 2480 – Video Recording and Compression**
  - PPH requests - 567
  - PCT-PPH requests - 21

- **Group 1720/1750 – Fuel Cells, Batteries, Solar Cells etc.**
  - PPH requests - 172
  - PCT-PPH requests – 26

- **Group 3740 – Thermal and Combustion Technology etc.**
  - PPH requests - 123
  - PCT-PPH requests – 22

- **Group 2830 – Electrical Systems and Components**
  - PPH requests - 115
  - PCT-PPH requests – 20

- **Group 2850 – Electrical/Mechanical Systems**
  - PPH requests - 86
  - PCT-PPH requests - 47
Use of PPH at EPO

**PPH (Paris) Pilot Program**
- JPO as OFF – 173 total requests
- USPTO as OFF – 94 total requests

**PPH (PCT) Pilot Program**
- 60 total requests with JPO/USPTO as the ISA/IPEA
USPTO Experience (Performance Metrics)

- **USPTO Allowance Rates** (from 1/2011)
  - PPH (Paris Route) cases: 92.2%
  - PCT-PPH cases: 97.9%
  - non-PPH cases: 46% (including RCEs)

- **USPTO Actions Per Disposal** (from 12/2010)
  - PPH (Paris Route) cases: 1.88
  - PCT-PPH cases: 1.17
  - non-PPH cases: 2.42

- **AIPLA study based on survey data from 2009-on to be released in March 2011**
USPTO Statistics (Paris)

Overall Statistics for Paris Route Patent Prosecution Highway Programs

- Statistics for PPH requests filed in the USPTO under Paris Route PPH programs

<table>
<thead>
<tr>
<th>FAs</th>
<th>PPH requests received by the USPTO</th>
<th>Percent w/ First Action</th>
</tr>
</thead>
<tbody>
<tr>
<td>Total</td>
<td>4,304</td>
<td>78.42%</td>
</tr>
<tr>
<td>First Action Allowance</td>
<td>3,375</td>
<td>78.42%</td>
</tr>
<tr>
<td>First Action Quayle</td>
<td>849</td>
<td>25.16%</td>
</tr>
<tr>
<td>First Action Rejection*</td>
<td>56</td>
<td>1.66%</td>
</tr>
<tr>
<td>First Action Rejection* (- art rejections)**</td>
<td>2,232</td>
<td>66.13%</td>
</tr>
<tr>
<td>First Action Rejection* (- non art rejections)</td>
<td>1,934</td>
<td>86.65%</td>
</tr>
<tr>
<td>First Action Rejection*</td>
<td>298</td>
<td>13.35%</td>
</tr>
<tr>
<td>First Action Rejection*</td>
<td>238</td>
<td>7.05%</td>
</tr>
<tr>
<td>PPH requests for accelerated examination rejected for not satisfying PPH requirements</td>
<td>183</td>
<td>188.4 days</td>
</tr>
</tbody>
</table>

Average period from request to FA 188.4 days

* First Action Rejections subsequently allowed: 1,112 out of 1,934 times

** Art Rejections where U.S. Patent documents used: 1,805 out of 1,934 times

Grant Rate (Allowances / Total number of Disposals) 92.16%
### USPTO Statistics (PCT)

**Overall Statistics on the PCT-Patent Prosecution Highway Program**

<table>
<thead>
<tr>
<th>PPH requests received by the USPTO</th>
<th>788</th>
<th>Percent w/ First Action</th>
</tr>
</thead>
<tbody>
<tr>
<td>Total</td>
<td>340</td>
<td>43.15%</td>
</tr>
<tr>
<td>First Action Allowance</td>
<td>67</td>
<td>19.71%</td>
</tr>
<tr>
<td>First Action Quayle</td>
<td>4</td>
<td>1.18%</td>
</tr>
<tr>
<td>First Action Rejection*</td>
<td>211</td>
<td>62.06%</td>
</tr>
<tr>
<td>(- art rejections)**</td>
<td>185</td>
<td>87.68%</td>
</tr>
<tr>
<td>(- non art rejections)</td>
<td>26</td>
<td>12.32%</td>
</tr>
<tr>
<td>First Action Restriction</td>
<td>58</td>
<td>17.06%</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>PPH requests for accelerated examination rejected for not satisfying PPH requirements</th>
<th>28</th>
</tr>
</thead>
<tbody>
<tr>
<td>Average period from request to FA</td>
<td>103.0 days</td>
</tr>
</tbody>
</table>

* First Action Rejections subsequently allowed: 20 out of 211 times

** Art Rejections where U.S. Patent documents used: 90 out of 185 times

Grant Rate (Allowances / Total number of Disposals) 97.85%
USPTO Statistics (EPO PCT)

Overall Statistics on the PCT-PPH Program between the USPTO and EPO

<table>
<thead>
<tr>
<th>PPH requests received by the USPTO</th>
<th>264</th>
<th>Percent w/ First Action</th>
</tr>
</thead>
<tbody>
<tr>
<td>Total</td>
<td>108</td>
<td>40.91%</td>
</tr>
<tr>
<td>First Action Allowance</td>
<td>23</td>
<td>21.30%</td>
</tr>
<tr>
<td>First Action Quayle</td>
<td>1</td>
<td>0.93%</td>
</tr>
<tr>
<td>First Action Rejection*</td>
<td>61</td>
<td>56.48%</td>
</tr>
<tr>
<td>(- art rejections)**</td>
<td>55</td>
<td>90.16%</td>
</tr>
<tr>
<td>(- non art rejections)</td>
<td>6</td>
<td>9.84%</td>
</tr>
<tr>
<td>First Action Restriction</td>
<td>23</td>
<td>21.30%</td>
</tr>
</tbody>
</table>

PPH requests for accelerated examination rejected for not satisfying PPH requirements: 5

Average period from request to FA: 108.6 days

* First Action Rejections subsequently allowed: 7 out of 61 times
** Art Rejections where U.S. Patent documents used: 52 out of 55 times

Grant Rate (Allowances / Total number of Disposals) 93.94%
USPTO Experience (Quality Metrics)

**Internal USPTO study of 155 First-action Allowances**
- 98% had new search recorded
- 94% had additional art cited
- 40% included an Examiner’s amendment/interview

**All PPH cases in random annual review**
- Allowance error rate for PPH cases slightly better than average (non-PPH cases)
- Nearly all errors on subject matter eligibility issues (35 U.S.C. 101)
JPO PPH Experience

- **Total PPH and PCT-PPH Requests (as of 12/2010) – 2,112**
  - USPTO: 1,017 (1,014 PPH)
  - DPMA: 607
  - KIPO: 113
  - EPO: 144 (all PCT-PPH)
  - JPO: 182 (all PCT-PPH)

- **JPO first action allowance rates:**
  - PPH: 11%
  - PCT-PPH: 22%
  - Non-PPH: 3%

- **JPO time to first office action (from exam request):**
  - PPH: within 2 months
  - All applications filed in 2009: 29 months on average
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- Future developments in the PPH
Advantages of PPH

**Costs Savings** – PPH applications, on average, appear to have about one less office action.

**Greater Success** – allowance rate of PPH applications is HIGH.

**Reduced Pendency** – PPH enables applications filed in multiple jurisdictions to be fast tracked based on another Office's work product

- In USPTO an application accepted into the PPH will be examined before all other categories of applications except those clearly in condition for allowance, those with set time limits (such as Examiner’s answers), and those that have been granted special status for accelerated examination.
- In EPO, advanced into PACE.
Advantages of PPH

- **Faster Portfolio Building for Start-ups** – could lead to higher damages or higher royalties.

- **Reduced File History** – less office actions to respond to; greater chance to conduct interview with examiner and receive notice of allowance with examiner’s amendment; less file history than other Accelerated Examination program.

- **High Quality** – Initial prosecution at EPO produces high quality claims.
Some Considerations

**Claim Scope**
- Claims filed in some foreign patent offices may originally be narrower as compared to those filed in the U.S.
- Different support standards
- Allowable claims in the OFF are only dependents

**Not Litigation Tested in the U.S.**
- Microsoft Corp. v. i4i Limited Partnership – should the clear and convincing evidence standard be applied even though the prior art on which the invalidity defense rests was not separately considered by the USPTO?
- Impact of foreign prosecution history to construe claims in U.S. patents
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Future Developments in PPH

- Elimination of requirement that patentable claims be determined solely by the OFF – go to an office of first examination model.
- Acceptance of machine, rather than certified, translation of work product and references.
- Self-certification of claim correspondence by applicant.
- Permit narrowing dependent claims with subject matter from disclosure.
Questions and Comments?
Examples