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Special Feature -- Speeding Up the Patent Process Using the Patent Prosecution Highway

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By Christopher Ma, Robert Kinberg & Steven J. Schwarz of Venable LLP

The process for seeking patent prosecution in multiple countries is getting a little bit easier thanks to the Patent Prosecution Highway (PPH) program recently implemented by the U.S. Patent and Trademark Office (USPTO), and numerous foreign patent offices.

Seeking patent prosecution for an invention in multiple countries can be a long and expensive process, sometimes taking four years or longer. Even though corresponding patent applications filed in each country may be essentially identical, each country usually performs its own prior art search and patentability examination, meaning that the finding of patentable claims in one country ordinarily has little effect on the examination of a corresponding patent application in another country.

Under the PPH program, applicants can take advantage of favorable findings by the first patent office in which the application is filed—the Office of First Filing (OFF)—to expedite patent examination in a second or subsequent patent office—the Office of Second Filing (OSF).

The PPH program exists between the USPTO and Australia, Austria, Canada, Denmark, the European Patent Office, Finland, Germany, Hungary, Japan, Korea, Patent Cooperation Treaty (PCT) Offices, Russia, Spain, Singapore and the United Kingdom. Any of these patent offices can serve as either an OFF or OSF.

The benefit of the USPTO's PPH program is that substantive examination of U.S. applications begins 1-2 months from when an application enters the program, reducing the delay between filing and substantive examination from the 25 month average, potentially cutting years off the process.

The USPTO says:

"PPH is not full faith and credit. The fact that your application filed in the OFF has allowable claims does not mean that the corresponding claims in the corresponding application filed in the OSF will automatically be allowed. The OSF examiner will examine the OSF application based on the patent law of the OSF."

However, **patent applications in the USPTO's PPH program have also been allowed at the rate of a staggering 93 percent**, more than double the overall USPTO allowance rate of 44 percent. Additionally, PPH applications have a shorter examination process, with an average of 1.7 Office Actions issued by the USPTO before disposal for PPH applications, which is significantly less than the overall average of 2.7 actions before disposal.

A U.S. patent application may be eligible to enter the PPH program if patentable claims are found in either the first country where the original patent application was filed, or in a related PCT application that does not include a priority claim. However, the U.S. patent application must not have begun substantive examination and all claims must have the same or similar scope as the claims found patentable in the corresponding application. An exception can be made in a case where the OFF is the Japanese Patent Office or a PCT office, then claims may also be of narrower scope than the claims found patentable in the corresponding application.

A request to enter the PPH program requires no governmental fees and is similar for all foreign patent offices, though not identical. A verified English translation of all claims determined to be patentable must be provided to the USPTO along with a claims correspondence chart indicating how claims in the U.S. application sufficiently correspond and an Information Disclosure Statement (IDS) submitting all documents cited in the foreign office. Additionally, copies of all the documents which are not U.S. patent publications or U.S. patents must be provided, and verified English translations of foreign office actions must be submitted.

Once the PPH request is submitted, the USPTO will issue a decision on entry into the PPH within approximately two months. After entry into the program, the first substantive Office Action on the merits of the application is typically issued after another two months.

While the program has many benefits, PPH applications are subject to the restriction that further claim limitations can not be added during prosecution unless the limitations were already present in at least one of the claims when the PPH request was granted. In the unlikely event that all claims in a PPH application are found unpatentable and limitations not previously examined must be introduced into the claims, a continuation application must be filed to introduce the new claim limitations.

Because the PPH program is new, it is also uncertain if claim amendments or attorney arguments made in the foreign patent office can adversely limit the scope of the U.S. patent application, for example, under the doctrine of prosecution history estoppel.

However, even with these potential drawbacks, expediting examination through the PPH program can be advantageous over other available options for speeding examination. While filing a Petition to Make Special is another option to speed examination of an application, only applications falling under special categories can be made special. Another option for speeding examination is Accelerated Examination. However, Accelerated

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Examination places significant burdens and limitations on applicants, such as requiring applicants to conduct a prior art search and explain how each claim is patentable over references uncovered by the search.

Due to the simplicity and the benefits of the PPH program, we recommend eligible applicants consider the PPH program if they are happy with the breadth of patentable claims in a corresponding foreign application, especially if reducing costs or speeding the examination process is important.

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