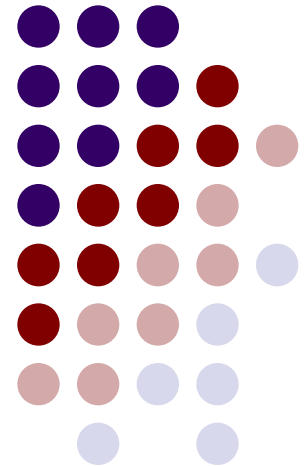




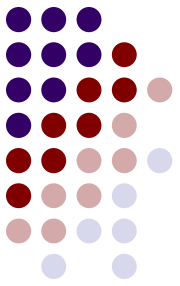
Birch  
Stewart  
Kolasch  
Birch LLP

# New Global PPH (GPPH) Pilot is harmonizing the Patent Prosecution Highway

Seth S. Kim  
February 5, 2014

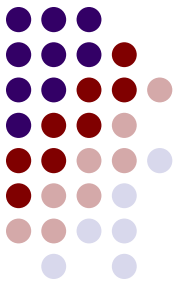


# GPPH



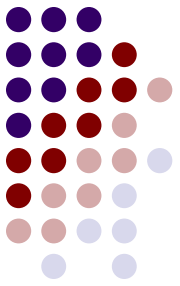
- 1. Introduction
- 2. Existing PPH programs
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- 5. GPPH – Needed Supporting Documents
- 6. GPPH – Principles
- 7. Bilateral Parties not in GPPH
- 8. Conclusion

# Introduction



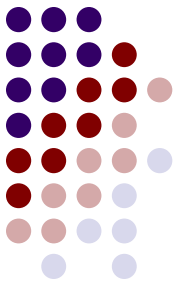
- Global Patent Prosecution Highway (PPH) pilot was launched on January 6, 2014.
- The GPPH pilot will allow patent applicants to request accelerated examination at any of the offices involved in the pilot if their claims have been found to be acceptable by any of the other offices involved in the pilot.
- The pilot will use a single set of qualifying requirements and it aims to simplify and improve the existing PPH network so that it is more accessible to users.

# PPH



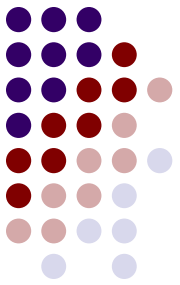
- PPH is a bilateral agreement between 2 national IP offices.
- The PPH program provides applicants with fast-track patent examination procedures, in hopes to obtain corresponding patents faster and more efficiently.
- The PPH program permits each office to make use of the work previously done by the other office and reduce duplication, in hopes to reduce the examination workload and improve patent quality.
- An indication of allowability of at least one claim in a filing in an Office of Earlier Examination (OEE) may be used to request the PPH in a corresponding filing in an Office of Later Examination (OLE)

# PPH/PCT

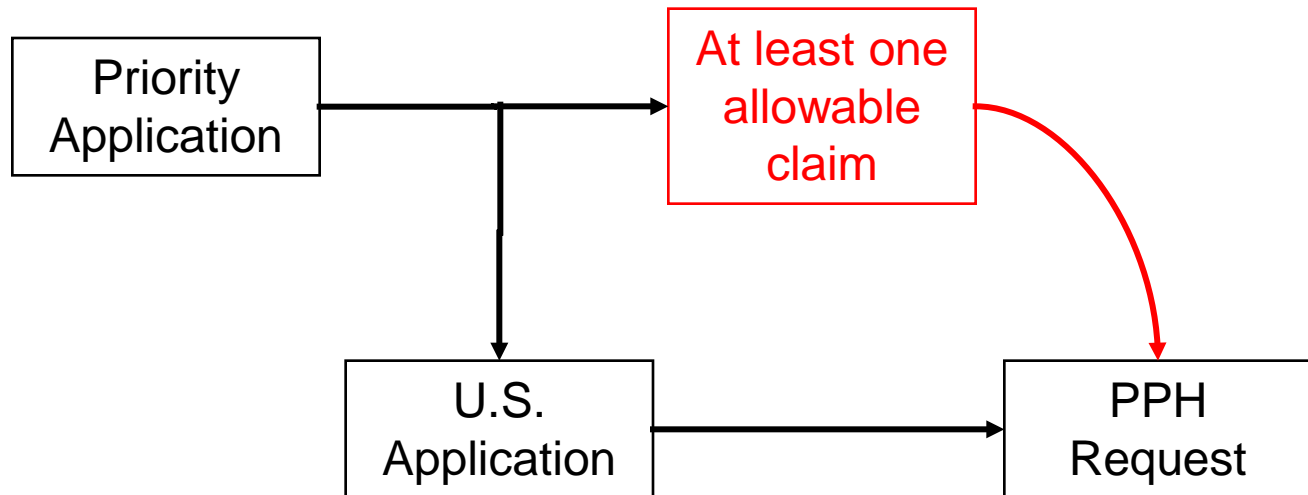


- PPH was extended to include PCT/PPH between the USPTO and several countries.
- Written Opinion or International Preliminary Examination Report can be used to “fast track” an application with at least one claim that has novelty, inventive step and industrial applicability.

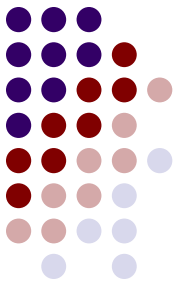
# PPH



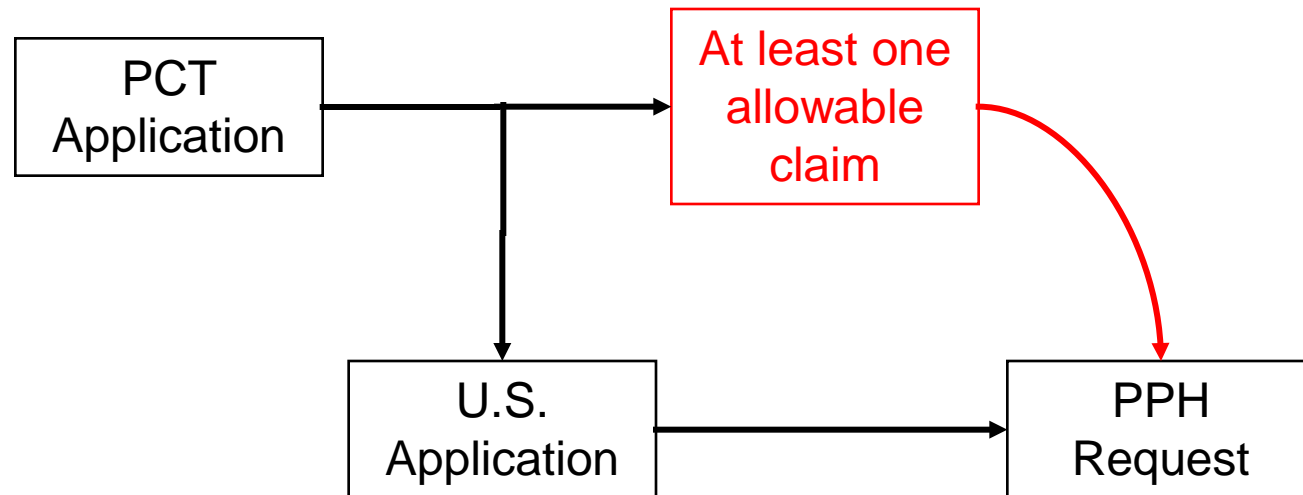
## One example



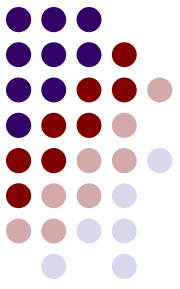
# PPH PCT



- One example



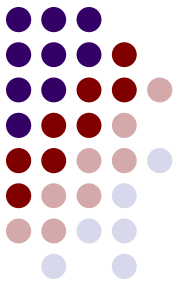
# PPH and PPH/PCT requirements



- PPH
  - Not yet examined
  - Petition form
  - Claim correspondence table
  - Preliminary Amendment, if needed for correspondence
  - OA copies and Translation, if non-English
  - Copy of Allowed claims and Translation, if non-English
  - Statement of Accuracy for the Translations
  - IDS and documents from the OA.
  - Sufficiently Correspond

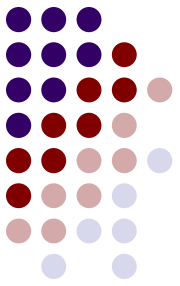


# PPH and PPH/PCT requirements



- PPH/PCT
  - Not yet examined
  - Petition form
  - Claim correspondence table
  - Preliminary Amendment, if needed for correspondence
  - WO/ISA, WO/IPEA, IPER, and Translation, if non-English
  - Copy of Allowed claims and Translation, if non-English
  - Statement of Accuracy for the Translations of Claims
  - IDS and documents.
  - Sufficiently correspond

# PPH and PPH/PCT requirements

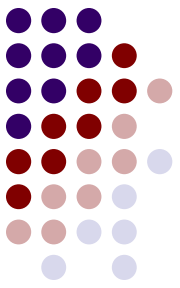


- PPH
  - Sufficiently Correspond

U.S. claims will be considered to “sufficiently correspond” with the claims allowed by the Foreign Office if the U.S. claims are of the same or similar scope.

The same or similar scope is being strictly interpreted by some Petition Examiners. Thus, the Applicant is often required to include exact duplicates of allowed claims, except accounting for differences due to translations and claim format, like minor cosmetic change, such as changing “characterized in that” to “wherein,” etc.

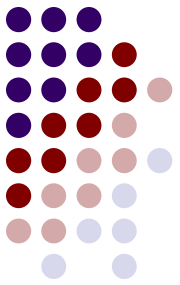
# PPH and PPH/PCT requirements



- PPH/PCT
  - Sufficiently Correspond

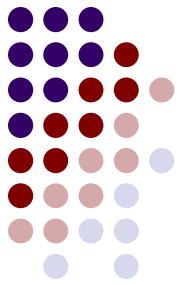
PCT-PPH also includes the definition of sufficiently corresponds that has been broadened to read “a claim that is narrower in scope occurs when a claim indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application is amended to be further limited by an additional feature that is supported in the written description of the U.S. application. The claim(s) with the narrower scope must be written in dependent form in the U.S. application for which participation in the PCT-PPH pilot program is requested.”

# PPH 2.0



- Not yet examined
- Petition form
- Claim correspondence table
- Preliminary Amendment, if needed for correspondence
- Prior to Grant OA copies and Translation, if non-English (may be machine translations)
- Copy of Allowed claims – NOT NEEDED – But at least one claim must be allowed
- Statement of Accuracy for the Translations - NOT NEEDED
- IDS and documents from the OA.

# PPH 2.0

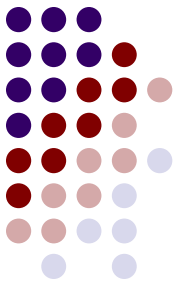


- Sufficiently Correspond

All original or amended claims on file for examination under the PPH 2.0 program in the U.S. application must sufficiently correspond to one or more of those claims as allowable in the application on file in the PPH 2.0 participating office. A claim is considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claim in the U.S. application has the same or similar scope as a claim indicated as allowable in the application filed in the PPH 2.0 participating office.

A claim in the U.S. application which is narrower in scope than the allowable claims in the application filed in the PPH 2.0 office may be presented as a claim dependent upon another claim which is of the same or similar scope as a allowed claim in the application filed with the PPH 2.0 participating office. But the additional limitation that narrows the claim in the U.S. application must be supported in the written description of the U.S. application and cannot be a new/different category of claim, e.g., product or apparatus and process, method or use, etc., than the allowable claim.

# Global Patent Prosecution Highway (GPPH) - Overview



- Commencement date: January 6, 2014
- Participating Offices (17 National and Regional Offices):

IP Australia (IP Australia),

Canadian Intellectual Property Office (CIPO),

Danish Patent and Trademark Office (DKPTO),

National Board of Patents and Registration of Finland (NBPR),

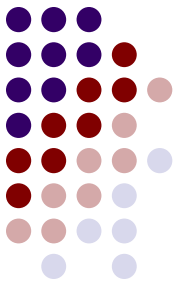
Hungarian Intellectual Property Office (HIPO),

Icelandic Patent Office (IPO),

Israel Patent Office (ILPO),

Japan Patent Office (JPO),

# GPPH



- Participating offices (continued).

Korean Intellectual Property Office (KIPO),

Nordic Patent Institute (NPI),

Norwegian Industrial Property Office (NIPO),

Portuguese Institute of Industrial Property (INPI),

Russian Federal Service for Intellectual Property (ROSPATENT),

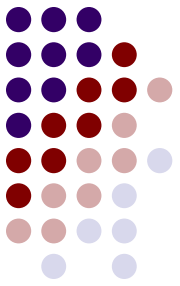
Spanish Patent and Trademark Office (SPTO),

Swedish Patent and Registration Office (PRV),

United Kingdom Intellectual Property Office (IPO), and

United States Patent and Trademark Office (USPTO).

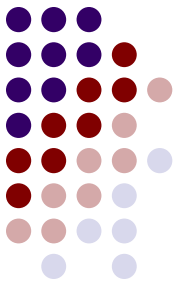
# GPPH



- The GPPH pilot will allow patent applicants to request accelerated examination at any of the offices involved in the pilot if their claims have been found to be acceptable by any of the other offices involved in the pilot.
- The pilot will use a single set of qualifying requirements and it aims to simplify and improve the existing PPH network so that it is more accessible to users.

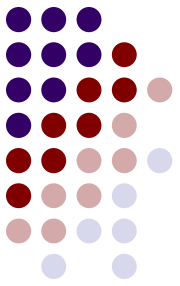


# GPPH - Criteria



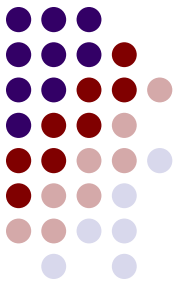
- Under the GPPH pilot, a request for accelerated processing can be made at any participating office based on work products, including PCT work products, from any one of the other participating offices providing the following eligibility criteria are met.
- Participating offices may, if they wish, develop office-specific guidelines, e.g. to reflect their respective legal terminology and processes, and can apply additional flexibility beyond these requirements as they see fit. However, these criteria set out a standard to be adhered to by offices participating in the GPPH pilot so as to provide a uniform system for applicants, i.e. if the GPPH pilot specific requirements below are met, an application will qualify for PPH treatment.

# GPPH - Criteria



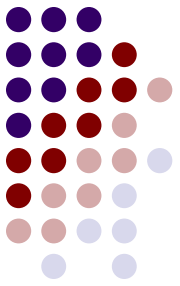
- Where two participating offices have a pre-existing bi-lateral PPH arrangement, the guidelines of the Global PPH pilot will take precedence over those of the existing bi-lateral arrangement for the duration of the pilot.

# GPPH - Eligibility



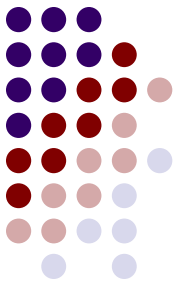
- Offices will provide accelerated processing under the GPPH pilot for applications where the following requirements have been met:
- 1) The applications before the Office of Earlier Examination (OEE) and the Office of Later Examination (OLE) have the same earliest date (which may be the priority date or the filing date).
- 2) 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. The claim(s) determined as novel, inventive and industrially applicable in the PCT work products has/have the meaning of allowable in this document.

# GPPH – Eligibility



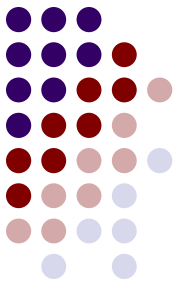
- All claims presented for examination under the GPPH pilot must sufficiently correspond to one or more of the claims found allowable by the OEE.
- The OLE has not begun substantive examination of the application. However, OLE's may still choose to allow GPPH requests filed after examination of the OLE 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.

# GPPH - Eligibility



- Participating Offices may require that the OLE application is open to the public.
- Participating Offices may require the applicant to pay a fee for GPPH acceleration due to their respective legal requirements for accelerated processing.
- For an OEE application to be valid as the basis of a GPPH pilot request it must have been substantively examined, including consideration of novelty and inventive step, by an OEE participating in the GPPH pilot.

# GPPH – Needed Supporting Documents



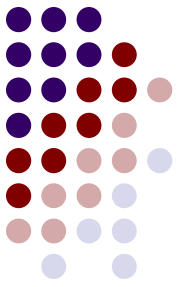
- Participating offices will require the following documentation to support a request for acceleration under the GPPH pilot:

A completed GPPH request form;

A copy of the work product(s) which are relevant to the allowability of the claims of the corresponding OEE application, if not available via Dossier Access Systems; and

A copy of the claims found to be allowable by the OEE, if not available via Dossier Access Systems.

# GPPH Pilot – Needed Supporting Documents



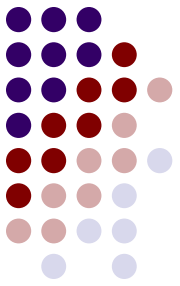
- Participating Offices may also require the applicant to provide the following documentation:

Copies of citations raised against the OEE application which are not available to the OLE via their regular databases or search files;

Translations of any of the OA, Claims or Support documents;  
and

A claim correspondence table that shows the relationship between the claims of the OLE application and those of the OEE application that were considered allowable.

# GPPH Pilot – Needed Supporting Documents

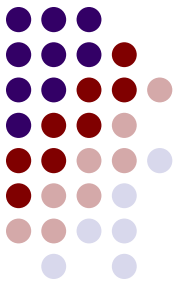


- Participating offices will use Dossier Access Systems and machine translations to access and assess supporting documentation to the maximum extent possible. If the participating office has difficulty in obtaining any of the documents and translations thereof, the applicant may be asked to submit them.

When machine translations are determined by the OLE to be of insufficient quality, then the applicant may also be asked to provide manual translation.

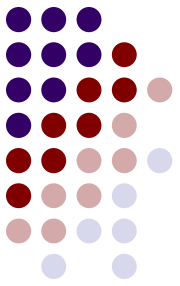


# GPPH - Consideration of request



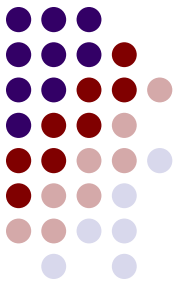
- Requests for accelerated examination under the GPPH will be considered promptly by the OLE. Where a request for accelerated examination under the GPPH pilot is found to be deficient, the OLE will inform the applicant of the deficiencies and provide the applicant with at least one opportunity to correct the application within a reasonable period of time.

# GPPH - Principles



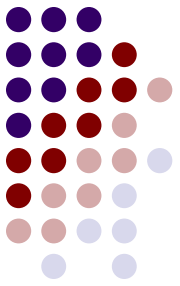
- Many individual bilateral agreements between countries has become challenging.
- Applicants and participating offices would benefit from a single set of principles that form a world-wide PPH system.
- Provides a common framework for a baseline to which new PPH offices can subscribe without varying from the guidelines established by long-standing PPH partners.

# GPPH - Principles

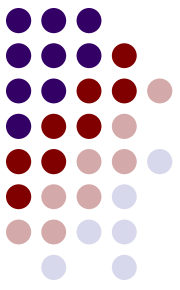


- Consistent with the "MOTTAINAI" concept, PPH eligibility will be based on work available from any participating office, regardless of OFF/OSF status, so long as the applications share the same effective date (priority or filing) and the disclosures support the claimed subject matter.
- Participating offices will accept any substantive search and examination product that explicitly indicates the patentability of claims(i.e., those including a written opinion if other than an initial notice to grant) done by another participating office under any filing scenario (e.g. as a National Office under the Paris Convention or as an ISA/IPEA office under the PCT).

# GPPH - Principles



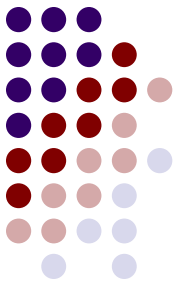
- Claim correspondence will be interpreted and applied by participating offices as per the formulation agreed to in October 2012.



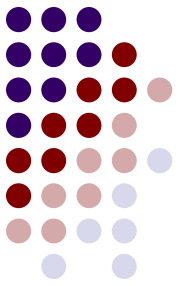
# GPPH - Principles

- Participating offices may require copies of prior office actions and/or decisional notices from the OEE and copies of any prior art cited that it cannot otherwise obtain, and should utilize dossier access systems and its internal search databases, respectively, for such purposes to the maximum extent practicable.
- Participating offices may require a copy of the allowed claims in the earlier office and/or a chart illustrating correspondence.
- Participating offices will accept machine translations of office actions, decisional notices, or allowed claims (as locally required) to the maximum extent practicable, but may require manual translations upon request from the examiner where necessary, e.g., if the quality of the machine translation is deemed of insufficient quality to assess the acceptability of the PPH request.

# Global PPH Principles



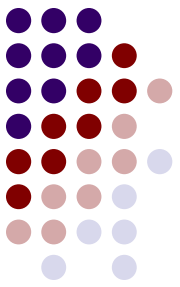
- Participating offices will allow at least one opportunity to correct a defect in the PPH request before finally refusing a PPH request.
- Participating offices may or may not accelerate applications for which PPH is requested after initiation of prosecution before the examiner, depending upon the circumstances and needs of each office and its stakeholder community.



# Bilateral Parties not in GPPH

- Austria
- China
- Columbia
- Czech Republic
- EPO
- Germany
- Mexico
- Nicaragua
- Philippines
- Singapore
- Taiwan

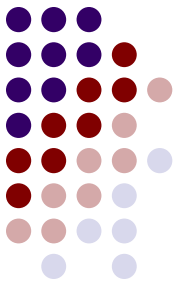
# Conclusion



- GPPH replace any existing PPH programs between the USPTO and the offices participating in these new pilots. The goal of the new pilots is to apply simpler requirements consistently across the participating offices, which will streamline the PPH process for our users.
- The Global PPH and IP5 PPH pilot programs will run concurrently and are substantially identical, differing only with regard to their respective participating offices. Because the USPTO has elected to participate in both the Global PPH pilot program and the IP5 PPH pilot program, a PPH request may be filed in the USPTO based on the work product of any office participating in either pilot program. Furthermore, because the respective requirements for the Global PPH and IP5 PPH pilot programs are equivalent, USPTO applicants need not specify which pilot program is being utilized.



# Conclusion



- More information at:
- <http://www.jpo.go.jp/ppph-portal/globalpph.htm>