

Interview No.25

PPH Is an Effective Method for Accelerated Grant of Patent Rights. What Are Its Merits and Demerits?

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There is a system called Patent Prosecution Highway (PPH) which aims to achieve accelerated grant of patent right in plural overseas countries; however, not so many enterprises actually utilize it. We asked Mr. Fumio Hirose, Deputy Director of Miyoshi & Miyoshi, patent attorney, and ex-trial examiner-in-chief of the Patent Office, for his views on the merits and demerits of the PPH.

—What is the purpose of the Patent Prosecution Highway (PPH)?

It aims to enable acquisition of overseas patent rights more easily and quickly. Until now, there have been systems for accelerated examination in each country, this is a method which brought those systems into one. Previously, when requesting an early examination, it was necessary to explain the reason, but in the case of PPH, this is not required. However, it is a prerequisite that an application has already been accepted in a certain country and this can then be utilized in another country when requesting an early examination for obtaining a patent right. It works like this: an invention decided as patentable by an organization (the first office) which received the initial patent application for the invention is permitted to undergo an early examination in another organization (the second office) where the patent application was filed subsequently (Fig. 1).

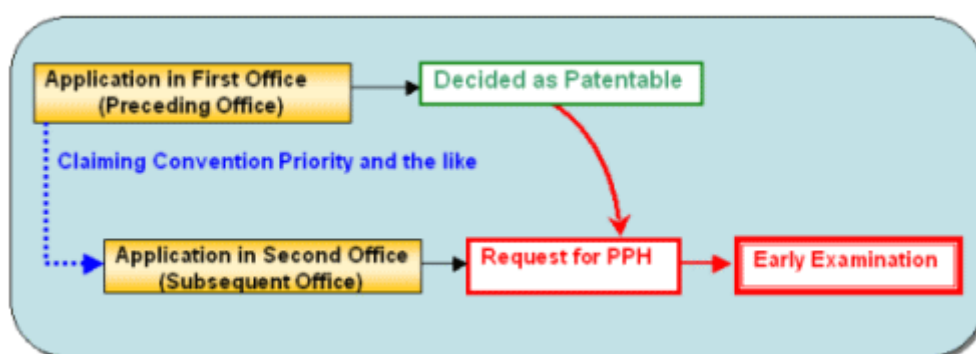


Fig. 1: Mechanism of PPH (quoted from the JPO's website)

—Who are the member states of the PPH?

As of May 1, 2012, 25 countries and organizations including Japan have joined the PPH. However, use of the system is decided by bilateral negotiations between Japan and

another country. So, in some cases, even organizations of target countries within the 25 members are not always covered (Fig. 2).

Apart from the ordinary PPH, there is also another system called PPH (PCT-PPH) utilizing a PCT route. In general, when you wish to file a patent application for the same invention in plural countries, a PCT application can be useful because it achieves the same effect as filing the application in all the PCT member states simply by filing one application document. In the case of the PCT-PPH, there is a preliminary examination by the international search organization and the like at the time of filing an application, and if the application is recognized as patentable then a request for the PPH can be filed. On July 1 2012, South Korea joined the contracting states of the PCT-PPH, which enables the five primary patent offices (that is, Japan, the USA, Europe, China and South Korea), to use the PCT-PPH between these countries.

Additionally, there is also a program called "PPH MOTTAINAI", a trial run of which started on July 15, 2011. In the ordinary PPH, it is necessary to first obtain a decision of possible patent rights application in the host country (the first office) as a requirement to enable request of an early examination in another country. However, in the "PPH MOTTAINAI" system, regardless of in which country the initial application was made, if possibility of patent is granted in any participating state, PPH application is possible. The case of having the examination result first and applying later is possible and the program was named "mottainai (waste not)" with a wish to maximize this effect. Nine countries and organizations including Japan, the USA, and Europe participate in this system, and the one-year trial period can be extended if required.

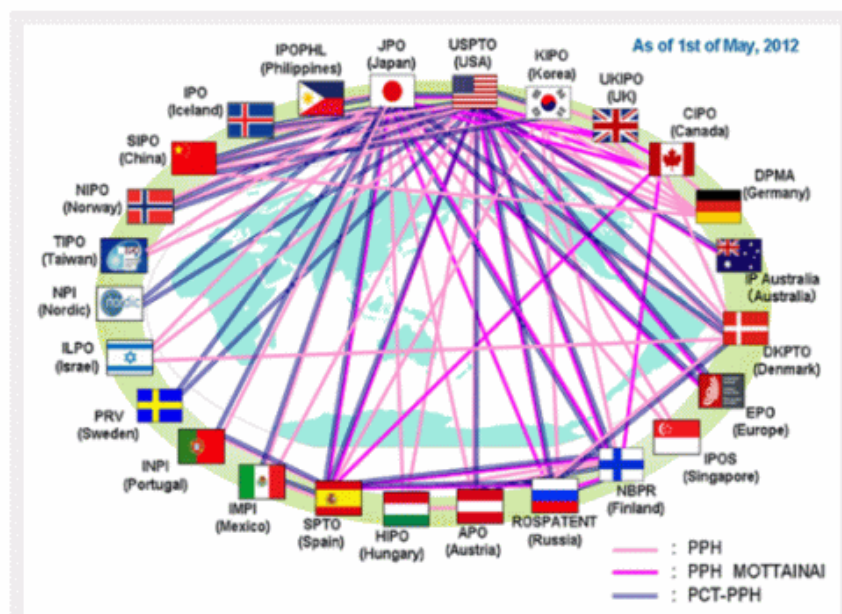


Fig.2: Participating countries/organizations in PPH (quoted from the JPO's website)

—Has there been any specific effect since the PPH system was started?

In the example of filing a request from Japan in the USA, it used to take 25 months on average, but reports suggest that it has shortened to about 6 months on average by utilizing the PPH. Another result is that the ratio of receiving decisions to grant has increased. For example, where Japan is the first office and the USA is the second office, the normal percentage of receiving final decisions to grant for all the US applications is 46 %, while the value of receiving decisions to grant for applications for which the PPH was requested is 92 %. On the other hand, when the USA is the first office and Japan is the second office, the value has only increased from 45% to 64 %. This may be due to the fact that searches of Japanese literature are often not conducted in the USA even though Japanese prior art exists. In addition, this brings about the benefit of decreasing the number of "Office Actions" for notifying reasons for rejection. In the USA, this is down from 2.4 down to 1.9 which in the case of applications, relates to reductions in cost and labor.

—Does utilization of the PPH bring about only good results?

What we should first note is that, because of differences in the legal system from country to country, such as requirements for description and the way to judge non-obviousness, an application recognized as patentable by the first office is not always granted a patent in the second office. When utilizing the PPH there is perhaps an expectation of "registration on the first attempt" without any Office Action; but as a matter of fact, this is not necessarily so. Another point to note is that only an application having the same or more restrictive description of the scope of claims for patent can use the PPH. This means that, for an application filed with the second office, the PPH cannot be requested unless the scope of claims are amended as required to be identical to the patent filed with the first office. Also, where an examination has already started in the country of the second office before filing of the PPH request, the application is dealt with in the ordinary way and the PPH request cannot be accepted.

—We hear that many enterprises are still not actually using the PPH. Is that true

It seems that the PPH itself is not yet widely known. It is an effective system for companies which attach importance to speed as necessitating a short product cycle. So, I think enterprises should consider utilizing the system more.

