

STRATEGIC USE OF THE PATENT PROSECUTION HIGHWAY

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Obtaining a granted patent may sometimes seem like a long process. The application must be searched, published and examined before it can be granted—a process that can take many years.

But some intellectual property offices have started an initiative that can help applicants obtain a granted patent more quickly.

The so-called Patent Prosecution Highway (PPH) aims to accelerate the examination of patent applications if examination work has already been conducted at another intellectual property office.

The initiative allows one intellectual property office to exploit work previously done by another office, thereby reducing duplication of search and examination procedures. Consequently, it improves quality and efficiency by reducing the workload at each office. In turn, applicants can obtain patents more efficiently, and it will, we hope, improve the quality of the issued patents.

Although the Patent Prosecution Highway network is expanding, it presently exists between only a small number of jurisdictions as a pilot programme. The number of possible second offices depends on the relevant first filing office.

But relationships are being established with some important jurisdictions. The Danish Patent and Trademark Office (DKPTO) has started a PPH pilot programme with the patent offices in the US, Japan and Korea.

The PPH gives an applicant whose claims are determined to be allowable by, for example, the Danish Patent Office, the possibility of having a patent application advanced for examination in the US and Korea. The faster examination of corresponding patent applications in the US will be a valuable improvement for Danish applicants, especially due to reduced prosecution costs and the fact that a US patent will be issued more quickly.

A valid patent in Denmark can also be obtained by filing a European patent (EP) application before the European Patent Office (EPO). Because the EPO and the United States Patent and Trademark Office (USPTO) launched a PPH pilot programme in September 2008, an applicant no longer has to start the prosecution by filing a Danish patent application. Rather, it can start by filing an EP application at the EPO.

Both the DKPTO and EPO will issue the search report and patentability opinion well before the expiry of the priority year, giving the applicant profound information for determining if the application should be prosecuted outside the first jurisdiction.

The trial period for the PPH between the USPTO, DKPTO and EPO respectively is set for one year, but it may be extended or terminated earlier depending on the volume of activity and other factors.

To benefit from this system, it is not a prerequisite that the first patent application has been granted or will imminently be granted. But it is a prerequisite that the initial patent office has found at least one of the patent claims to be patentable.

It is a further requirement that the claims in the application for which a request for participation in the PPH pilot programme is made sufficiently correspond to—or are amended to sufficiently correspond to—the allowable claims in the first application. Generally speaking, claims will be considered to sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope. However, the precise requirements will vary depending on the jurisdiction.

This means that the applicant has fewer opportunities to amend the application, and since various jurisdictions evaluate relevant prior art in different ways, it will be interesting to see if US patent law will withstand this momentum towards harmonisation or whether the various patent laws will be subject to reinterpretation.

An applicant should also think carefully about whether a fast grant is in their best interests. Many applicants are happy to let applications proceed to grant at a slower pace, because it gives them time to develop and plan the commercialisation and marketing of their invention. It also gives an applicant time to determine whether their invention is commercially viable, before committing to greater financial obligations.

There are, however, circumstances in which it is desirable to obtain a patent as promptly as possible, for example, if the applicant sees someone infringing the patent application and would like to start infringement actions, or if an investor requires a granted patent before they are willing to invest in the business.

In any case, it is of great value for all applicants to have the choice of having their patent granted more quickly, and the effort and initiative demonstrated by the relevant patent offices in the search for efficient solutions, which will eventually improve the framework for IPR protection, is welcome.

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