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Continuing expansion of the 'Patent Prosecution Highway'

On 6 January 2015 the EPO entered into a PPH pilot agreement with CIPO, IPOS, IMPI and ILPO.

The European Patent Office (EPO) has entered into a Patent Prosecution Highway (PPH) pilot agreement with the Canadian Intellectual Property Office (CIPO), the Intellectual Property Office of Singapore (IPOS), the Mexican Institute of Industrial Property (IMPI), and the Israel Patent Office (ILPO). Each agreement commenced on 6 January 2015 and will run for a trial period of three years, ending on 5 January 2018.

Under this agreement, an applicant may request accelerated prosecution of their application at any one of CIPO, IPOS, IMPI or ILPO, if the claims of a corresponding European application have been found to be patentable by the EPO. Similarly, acceleration at the EPO can be based on positive feedback from CIPO, IPOS, IMPI or ILPO.

This article discusses the new agreements and when PPH will be useful in practice.

Using PPH at the EPO

Specifically, a PPH request at the EPO may be made based on

- (i) a positive examination report for a corresponding application by either CIPO, IPOS, IMPI or ILPO (either a national application or an ex-PCT);
- (ii) a positive Written Opinion where CIPO or ILPO was the International Search Authority; or
- (iii) a positive International Preliminary Report on Patentability where CIPO or ILPO was the International Preliminary Examination Authority;

provided that the application was filed or entered the national phase at the EPO on or after 6 January 2015.

Once the request for entry into the PPH pilot programme has been granted, the European application will be processed in an accelerated manner, similar to accelerated prosecution under the long-standing 'PACE' programme. In fact, the EPO has repeatedly stated that a PPH request will have the same effect as a request for acceleration under PACE. A PACE request does not require any evidence or justification, and does not require correspondence between the European claims and the claims of a counterpart application. This raises a question mark over whether the extra administration of PPH is worthwhile, or whether PACE should always be used.

There are reasons why some applicants will choose the PPH procedure, despite the EPO's statements that it will be handled in the same way as PACE. Firstly, PPH provides a formal procedure for alerting EPO examiners to the positive opinion of another patent office, and busy EPO examiners will have the discretion to make use of the first office's opinion. Secondly, there are several technical fields in which simple PACE requests are currently not achieving the desired speed of examination; which invites applicants to try the alternative PPH programme.

PPH at CIPO, IPOS, IMPI and ILPO

A PPH request at CIPO, IPOS, IMPI or ILPO may be based on

- (i) a positive examination report for a corresponding application by the EPO (either first filed at the EPO or ex-PCT);

■ (ii) a positive Written Opinion where the EPO was the International Search Authority; or

■ (iii) a positive International Preliminary Report on Patentability where the EPO was the International Preliminary Examination Authority;

provided that the application was filed or entered the national phase at the CIPO, IPOS IMPI or ILPO on or after 6 January 2015.

CIPO has stated that, for all applications under PPH, it aims to provide a first office action within 90 days from receipt of the PPH request. This could be either a notice of allowance or a first substantive report, but in either case this acceleration would be very significant. Approximately 40% of PPH applications in Canada are allowed without an office action, significantly higher than 4.4% for non-PPH applications (link to source [here](#)).

The potential benefit to applicants is therefore expedited allowance of their corresponding application(s) at reduced prosecution costs.

Each office will evaluate the success of the pilot programme to determine whether and how it can be fully implemented following the trial period. If deemed necessary, the trial period may also be extended.

The EPO currently participates in the Patent Prosecution Highway with the United States Patent and Trade Mark Office (USPTO), the State Intellectual Property Office of China (SIPO), the Japanese Patent Office (JPO) and the Korean Intellectual Property Office (KIPO). Now, with the addition of CIPO, IPOS IMPI and ILPO, the options for

requesting accelerated prosecution at the EPO are broader than ever.

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