

The PCT-Patent Prosecution Highway – Cost- and Time-effective means to securing concordant subject-matter of a PCT Patent application across the jurisdictions of Europe, United States and Japan

As of 29 January 2010, and running for a period of two years ending on 28 January 2012, a new Patent Prosecution Highway (PPH) pilot utilising PCT communications was launched by the Trilateral Offices of the EPO, USPTO and JPO. The PPH was established to enable an applicant whose claims are determined to be patentable/allowable in the office of first filing (OFF) to have the corresponding application filed in the office of second filing (OSF) expedited for examination while at the same time allowing the OSF to exploit the work results of the OFF.

Under the PCT-PPH pilot program a PPH request can be based on the latest PCT communication (Written Opinion of the International Search Authority (ISA) or International Preliminary Examination Report (IPER)) established by the EPO, USPTO or JPO as ISA or International Preliminary Examination Authority (IPEA), where this communication determines claims to be patentable/allowable.

Where the EPO is the ISA, or ISA and IPEA, the procedures and requirements for filing a request with the JPO and the USPTO for participation in the PCT-PPH pilot program are available from the JPO website at www.jpo.go.jp and from the USPTO website at <http://www.uspto.gov/web/offices/com/sol/og/2010/week08/TOC.htm#null>

Where either the JPO or the USPTO was the ISA, or ISA and IPEA, the applicant may request participation in the PCT-PPH pilot program at the EPO when the application has entered the European phase.

Requirements for requesting participation in the PCT-PPH pilot program in the EPO

Either the JPO or the USPTO has been ISA and/or where a demand for PCT Chapter II has been filed, one of these offices has been IPEA as well. The PCT application may have been filed with any receiving Office and may claim priority from an earlier filed application.

The PCT application has *at least one claim* determined by the ISA or the IPEA to be patentable/allowable. In case any observations have been made in the WO-ISA or IPER, the applicant must explain why the claim(s) is/are patentable/allowable, and may file amendments to overcome these observations. The applicant must submit a copy of the claims deemed patentable/allowable as filed or as

amended under Article 34(2)(b) PCT and a translation thereof in one of the EPO official languages, unless either of these is already available to the EPO.

All the claims in the application on file upon entry into the European phase (or as amended within the Rule 161 EPC time limit) must sufficiently correspond to the claims deemed patentable/allowable by the ISA or the IPEA. “*Sufficiently correspond*” meaning the claims are (i) of the same or a similar scope, (ii) are in the same category and/or (iii) are narrower in scope than the claims in the PCT application(s). *The applicant is also required to submit a claims correspondence table*, indicating how all the claims on file upon entry into the European phase correspond to the claims deemed patentable/allowable by the ISA or the IPEA.

The applicant must file a request for participation in the PPH pilot program on request form (EPA/EPO/OEB 1009 PCT), submit a copy of the WO-ISA or, where a demand under PCT Chapter II has been filed, of the IPER and a translation thereof in one of the EPO official languages (unless either of these are already available to the EPO), and submit copies of all documents other than patent documents cited in the WO-ISA or IPER (unless these documents are already available to the EPO).

Where the request for participation in the PCT-PPH pilot program is granted, the applicant will be notified and the EP application will be expedited for supplementary European search and substantive examination. In those instances where the request for participation in the PCT-PPH pilot program does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given one opportunity to correct any deficiencies in the request.

Once the request for participation in the PCT-PPH pilot program has been granted, the EP application will be processed in an accelerated manner under PACE (program for accelerated prosecution of European Patent applications), where a first examination communication should be issued within three months of receipt by the examining division of the application.

Conclusion

The PCT-PPH will potentially provide a more streamlined cost effective approach in obtaining granted patents in the US, Europe and Japan for PCT originating applications. If you would like further information on the PCT-PPH please contact info@purdylucey.com