

THE PATENT PROSECUTION HIGHWAY (PPH) – WHAT IS IT ALL ABOUT?

Executive Summary

The Patent Prosecution Highway (PPH) is a bilateral program between two patent offices that provides a fast-track examination of a patent application in one patent office if at least one claim of the corresponding application filed with the other patent office has been deemed patentable. The PPH program is a new, attractive opportunity for those applicants looking for patent protection in Russia as soon as possible – previously, there has been no official procedure to accelerate the examination. The following article provides all the details of three different PPH programs in which the Patent Office of Russian Federation is currently taking part, and summarizes the formal requirements to be fulfilled in order to participate in the PPH programs.

The Patent Prosecution Highway (PPH) program provides a fast-track examination for a Russian patent application. The following overview of the program is particularly relevant to our American, Japanese, Korean and Scandinavian clients, as the patent offices of these countries participate in the PPH program with the Russian Federal Service for Intellectual Property (ROSPATENT).

Since the trial period, which started on 1 October 2010 between the USPTO and ROSPATENT, the number of PPH agreements with ROSPATENT has increased, and currently ROSPATENT has a PPH agreement with the Japanese PO, Korean PO, USPTO, Finnish PO and Spanish PO. In addition, a PPH pilot program with the Danish Patent and Trademark Office (DKPTO) has commenced on 1 February 2012.

During 2011 and the first part of 2012, the number of PPH fast-track examination requests filed by our agency in Russia has steadily increased, in most cases leading to issuance of an acceptance decision within about 4-8 months from requesting an examination under the PPH. While the total number of applications requesting a fast-track examination under the PPH is not that high – e.g. in 2011, ROSPATENT has received a total of 51 PPH requests from the US and JP applicants – the advantage of the PPH over the regular examination procedure of a Russian application is clear. Compared to the regular examination procedure, where issuance of a first Office Action usually takes 9-12 months, the PPH not only significantly reduces the time required to obtain a patent in Russia, but it also cuts down expenses, as less attorney work is generally required during the examination phase.

At the moment, ROSPATENT participates in three different types of PPH programs:

1. PPH

Under the PPH framework, an application whose claims have been determined to be patentable at the Office of First Filing (OFF) is, upon the applicant's request, eligible to go through an accelerated examination at the Office of Second Filing (OSF).

The Russian Federal Service for Intellectual Property (ROSPATENT) has a PPH agreement with the Japanese PO, Korean PO, USPTO, Finnish PO and Spanish PO. In addition, the Danish Patent and Trademark Office (DKPTO) and the ROSPATENT are launching a PPH pilot program commencing on 1 February 2012. The most recent PPH pilot program to be launched by ROSPATENT is the one with China State Intellectual Property Office (SIPO). The PPH pilot program will commence on 1 July 2012 and, according to the current agreement between SIPO and ROSPATENT, it will last for one year. We emphasized that currently there is no agreement between ROSPATENT and the EPO for a fast-track examination under the PPH.

2. PCT-PPH

Under the PCT-PPH program, an applicant receiving a written opinion (WO) or international preliminary examination report (IPER), stating that at least one claim in a PCT application is patentable, can request a fast-track examination of the corresponding claim in a corresponding PCT national phase application. However, it should be noted that the corresponding PCT national phase application is eligible for a fast-track examination only if the WO or IPRP is authored by a patent office participating in the PCT-PPH program.

At the moment, ROSPATENT has a PCT-PPH agreement with the USPTO, Finnish PO and Spanish PO. The current PPH program with the above states will continue until 14 July 2012. In addition, the Danish Patent and Trademark Office (DKPTO) and ROSPATENT have launched a PCT-PPH program on 1 February 2012.

3. PPH-MOTTANAI

The PPH-MOTTANAI pilot program has less strict requirements for filing fast-track examination requests under the PPH. Under the PPH-MOTTANAI framework, the examination results from any patent office participating in the program may be re-used by any other patent office, regardless of the office with which the application was first filed. This provides a clear advantage over the PPH, which allows re-use of the examination results issued by the Office of First Filing (OFF) only.

ROSPATENT has a PPH-MOTTANAI agreement with the Japanese PO, USPTO, Finnish PO and Spanish PO, and the current pilot program is intended to run until 14 July 2012.

According to the above PPH and PPH-MOTTANAI programs, an applicant receiving a favorable ruling (i.e. acceptance decision) from one of the above mentioned patent offices can apply for a fast-track examination in Russia. The formal requirements (in addition to the normal filing requirements) are:

- a duly completed PPH request form,
- a claim chart comparing the accepted claims of the foreign application to the pending Russian claims and copies and machine translations of all Office Actions – these will be obtained by ROSPATENT directly from the Office of First Filing (PPH) or the office which has issued the Office Action (PPH-MOTTANAI),
- a copy and translation of the accepted claims,
- copies of the documents cited by the examiner (no translations needed).

The request for a fast-track examination will be accepted only if the claims of the pending Russian application fully correspond to the accepted claims of the foreign application. However, it should be noted that, according to the Russian Patent Rules, only features that have been directly mentioned in the original disclosure or claims can be introduced into amended claims – introduction of e.g. features that can only be seen from the drawings is not allowed. This requirement of literal support is very strictly followed by Russian examiners, possibly creating a problematic situation when the accepted claims of a foreign application comprise features that do not have literal support in the application as filed and thus cannot be introduced into amended claims of the Russian application.

The fast-track examination can be requested after entering the national phase in Russia; however, it should be requested either before or together with the substantive examination request, which is due 3 years after the international filing date. There are no special official fees involved in requesting the fast-track examination; instead, the normal examination fees are applied.

The rules state that the PPH request cannot be made once the examination has started. The examiners at ROSPATENT are interpreting this rule so that they are not obliged to, and usually will not accept any PPH requests once the Patent Office has confirmed the receipt of the examination request. According to our experience, in some cases the examiner can make an exception and accept a PPH request if the request is

filed within a short period of time after requesting examination. As the PPH system in Russia is quite immature, ROSPATENT is yet to adopt specific policies to this effect. However, the results indicating that PPH is a viable tool for more efficient patent prosecution in Russia have thus far been very encouraging.

Erik Goussev
Patent Attorney

Teemu Lang
Director, Patent Attorney