The IP5 PPH – status update

3rd meeting of IP5 Heads of Office and IP5 Industry

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Busan, Republic of Korea

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The PPH: the basic concept

– Scheme enabling an applicant whose claims have been determined to be patentable/allowable in the OEE*

  – to have the corresponding application filed with a PPH partner office (OLE**) processed in an accelerated manner

    • simplification of entry requirements into the accelerated prosecution schemes

  – while at the same time allowing the offices involved to exploit available work results

    • acceleration of procedure through utilisation of work results

    • no recognition of work

* Office of Earlier Examination

** Office of Later Examination
The PPH network

As of 1st of May, 2014
The IP5 PPH and the GPPH

Global Patent Prosecution Highway System Participating Offices

- IP Australia (IP Australia)
- Canadian Intellectual Property Office (CIPO)
- Danish Patent and Trademark Office (DKPTO)
- National Board of Patents and Registration of Finland (NBPR)
- Hungarian Intellectual Property Office (HIPO)
- Icelandic Patent Office (IPO)
- Israel Patent Office (ILPO)
- Japan Patent Office (JPO)
- Korean Intellectual Property Office (KIPO)
- Nordic Patent Institute (NPI)
- Norwegian Industrial Property Office (NIPO)
- Portuguese Institute of Industrial Property (INPI)
- Russian Federal Service for Intellectual Property (ROSPATENT)
- Spanish Patent and Trademark Office (SPTO)
- Swedish Patent and Registration Office (PRV)
- United Kingdom Intellectual Property Office (IPO)
- United States Patent and Trademark Office (USPTO)
Envisaged implementation

• Trilateral PCT - PPH pilot
  – Launched 29 January 2010 (EPO OJ 2012, 89)

• Bilateral PPH pilot between the EPO and the USPTO
  – Launched 29 September 2008 (EPO OJ 2012, 60)

• Bilateral PPH pilot between the EPO and the JPO
  – Launched 29 January 2010 (EPO OJ 2012, 75)

• Latest extension and revision dated 29 January 2012
  – Operational until 5 January 2014

• Comprehensive IP5 PPH
  • Launch: 6 January 2014
    – EPO OJ 2014, A8
# Status of IP5 PPH pilot programme: April 2014

<table>
<thead>
<tr>
<th>Partner Office</th>
<th>Work product</th>
<th>Launch date</th>
<th>Number of requests</th>
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<tr>
<td>JPO</td>
<td>PCT work products national</td>
<td>29 January 2010</td>
<td>669 (659) 1732 (1677)</td>
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<td>KIPO</td>
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<td>USPTO</td>
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<td>work products</td>
<td>29 September 2008</td>
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</table>

Total: 3676
Civil Engineering and Thermodynamics and Industrial Chemistry each have over one eighth of all PPH requests.

Biotechnology, Medical and Consumer Technology, and Pure and Applied Organic Chemistry have the lowest percentage of PPH requests. This seems to reflect the need of applicants in these technical fields to gain time rather than accelerate prosecution.
• Electrical engineering has over a third of all PPH requests at the EPO
Main changes as of 06.01.2014

- **New PPH partners:** KIPO and SIPO

- **New EPO forms**
  - **1009 PR:** PPH request based on national work products
  - **1009 PCT:** PPH request based on PCT work products, i.e. WO-ISA/IPER established by JPO, KIPO, SIPO, USPTO in their capacity as ISA and/or IPEA

- **Only formal deficiencies** of the PPH request can be remedied

- Substantive deficiencies cannot be corrected anymore (claims correspondence must be present at the time when filing the PPH request)
Future trends

- Formal **integration of the PPH into the PCT**
  - EPO supportive
  - caveat: maintain flexibilities available at national laws

- Development of **common PPH metrics**
  - uniform metric definitions
  - essential for monitoring and supporting PPH

- Work on the further **harmonisation/unification** of
  - PPH participation requirements, and
  - PPH practice

- Monitor/evaluate use of **IP5 PPH** at the EPO
Thank you for your attention!