

## - PPH Policy -

### Background

The expansion of global activities of business entities has resulted in the growing need for the acquisition of high quality simultaneous patent rights in a plurality of countries. This has led to the tendency to file the same invention with various patent offices, and an upsurge in the number of patent filings worldwide. This result in (1) an increase in the duration of the examination period and (2) a heavy increase in the examination workload at each patent office.

To accelerate the patenting process, patent offices have developed the PPH, a framework whereby patent applicants whose applications have been determined allowable by a patent office (an Office of Earlier Examination; OEE) are entitled to request, through a simple procedure, an accelerated examination of the corresponding applications in another patent office (an Office of Later Examination) based on the examination results of the Office of Earlier Examination. PPH (via Paris priority applications) and PCT-PPH (PPH using Patent Cooperation Treaty (PCT) international work products) are implemented.

The PPH scheme (PPH and PCT-PPH) presupposes that an applicant should make the claims of an OLE application for which PPH is requested sufficiently correspond to the claims that are determined to be allowable by an OEE. Namely, the OLE examiner examines, in accordance with the national law, the claims that have already been examined and decided to be allowable by the OEE examiner. The PPH scheme also presupposes that the OLE should promptly evaluate the patentability of the claims that are originally filed or amended so as to sufficiently correspond to the claims determined to be allowable.

In the light of the PPH scheme, the fundamental expectations for PPH are cited as follows;

- Predictable fast prosecution of patent applications without any (unduly) time delay (from the perspective of applicants).
- Mitigation of workloads via work-sharing among patent offices (from the perspective of patent offices)

As the number of participating offices has increased, there is a greater need to streamline and simplify the PPH. Every PPH participating office should reconfirm the aforementioned fundamental expectations, and follow common PPH policies. This transparent PPH scheme would enhance the mutual understanding of practices, which would help improve the effectiveness of the PPH.

## **Policies to be followed by PPH participating offices**

Each office participating in PPH should endorse and realize the following policies to their maximum extent in order to promote transparency and effectiveness of PPH.

(1) Offices of Earlier Examination (OEEs) should maximize their efforts to improve examination quality, providing reliable work products, so that Offices of Later Examination (OLEs) can maximize the use of the work products by OEEs. To achieve this end, OEEs should strive to maximize the availability of search/examination-related information.

(2) OLEs should be expected to make maximum use of search/examination-related information of OEEs within the framework of their system such as laws, examination rules and IT systems of each office, considering when the claims of the OLE are sufficiently correspond to the claims determined to be allowable in an the OEE. This will result in improved quality and work-sharing among offices and quality improvement but also faster acquisition of patent for applicants. However, the independence of the OLE is always preserved.

(3) Examination for an application for which PPH request is approved should be expedited throughout its examination stage. Therefore, not only the First Action (FA) pendency from PPH request but also the period from FA to final decision (e.g. decision to grant or reject a patent) of PPH applications should be reduced compared to those of non-PPH applications.

(4) OLEs should strive for effective and timely communication with the applicant at all stages of examination. As a result, OLEs should improve efficiency and process of the examination that may lead to reduction of the total number of office actions for PPH applications, improvement in an allowance rate (especially first allowance rate) and accelerate examination procedure within the framework of the existing system.

(5) Having a transparent system for PPH will enhance predictability and availability for applicants. PPH participating patent offices should ensure publication of PPH related data.

(6) Each patent office should endeavor to make guidelines reflecting the above policies and disseminate it to examiners of each office and the public.

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