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The Patent Prosecution Highway: Is Life in the 'Fast Lane' Worth the Cost?

ALICIA PITTS AND JOSHUA KIM, PH.D.

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Abstract

Globalization has led to a rapid increase in the number of patent applications filed in the United States and abroad. In response, individual patent offices have introduced preliminary programs to share the workload and reduce redundancy, giving rise to the “patent prosecution highway.” Setting grandiose visions aside, the patent prosecution highway is generally failing. This article examines the strengths and weakness of the patent prosecution highway and suggests some methods through which the highway should be navigated and used as part of a global patent strategy.

The Patent Prosecution Highway: Is Life in the ‘Fast Lane’ Worth the Cost?

ALICIA PITTS* AND JOSHUA KIM, PH.D.**

I. Background and Introduction

As the world continues to become more interconnected through the globalization of commerce, patent offices around the world are increasingly taking advantage of the globalization and emerging new technologies to maximize efficiency and cooperation in examining patent applications. Commissioners of a number of patent offices have acknowledged the importance of working together because there has been a great increase in the number of patent applications being filed and in the number of same inventions being patented in multiple countries. This suggests that there is a great deal of redundant work done at each patent office and that it may be useful to combine efforts to minimize duplicative examination and to expedite allowance. Concentrating on these goals is important to patent offices, while patent applicants will be watching closely to see how they will be affected by the means implemented to accomplish those goals.

The creation of a global network must be balanced with a patent applicant’s desire to obtain the most comprehensive intellectual property rights possible in each of the countries where the applicant is applying for patents. Additionally, the patent applicant often desires obtaining a patent in the shortest possible amount of time. The United States Patent and Trademark Office (“USPTO”) currently has a backlog of more than 760,000 patent applications, suggesting

* J.D. Candidate 2009, University of California, Hastings College of the Law; B.A. 2005, Psychology, New York University. The author would like to thank Professor Robin Feldman and her Law and Bioscience colleagues at UC Hastings for their thoughtful encouragement and guidance throughout the writing process.

** Intellectual Property Associate at Jones Day; J.D., University of California Hastings College of the Law; Ph.D., Molecular Microbiology and Immunology, University of Southern California; B.S., Biological Engineering and Sciences, Washington University in St. Louis.

that the patent office is overwhelmed by patent applicants' demands for intellectual property rights.¹ Other countries around the world are also experiencing similar backlogs due to an increasing number of applications.² These problems are compounded by more inventions in complex and emerging technologies.³ With patents in the chemical and biological arts in the United States often taking over 34 months on average to advance from filing to issuance,⁴ it is often essential for start-ups and technology companies, especially those looking to build their patent portfolios and obtain funding, to "accelerate" the examination of a patent.

The USPTO, in connection with a number of foreign patent offices, has implemented several different programs designed to allow practitioners to expedite patent examination. These programs have been designed to alleviate the burden of work placed on participating patent offices by allowing a second patent office to take advantage of the work that has already been completed in a first patent office when the work is likely to be redundant. These programs are also preliminary steps on the road to a truly global intellectual property protection system, which could eventually result in significantly fewer administrative issues in obtaining patent rights around the world, and perhaps the creation of uniform patent rights. The Patent Prosecution Highway is one of the programs designed to reduce administrative and procedural burdens by allowing expedited patent examination in a second patent office, when a corresponding claim has already been found patentable in a participating patent office.

This Article will first define and describe the Patent Prosecution Highway and its various iterations between different patent offices. The Article will next suggest that the Patent Prosecution Highway is generally failing to serve its purpose by illustrating the presence of multiple country-specific practices that eliminate or reduce the lure of participating in the Patent Prosecution Highway program. The Article will then discuss instances where it may be acceptable to use

1. United States Patent and Trademark Office, Press Release: USPTO and the George Washington University School of Business Team Up for 2008 International MBA Business Case Competition, <http://www.uspto.gov/web/offices/com/speeches/08-10.htm> (last visited April 28, 2009).

2. *Id.*

3. *Id.*

4. United States Patent and Trademark Office, Performance and Accountability Report Fiscal Year 2007, Table Four: Patent Pendency Statistics, http://www.uspto.gov/web/offices/com/annual/2007/50304_table4.html (last visited April 23, 2009).

the Patent Prosecution Highway, due to either the lack of alternative procedures or the sufficiency of the allowed claim scope. The Article will finally offer some suggestions as to when and where the Patent Prosecution Highway programs can most effectively be used in a global patenting strategy, as well as what must be resolved before the Patent Prosecution Highway can truly become a program that will consistently serve patent applicants from around the globe.

II. The Patent Prosecution Highway

A. The Original Patent Prosecution Highway Program Overview

The Patent Prosecution Highway was first developed between the USPTO and the Japan Patent Office (“JPO”) as a pilot program that began on July 3, 2006.⁵ The stated purpose of the program was to accelerate examination of an application filed in an office of second filing where corresponding claims were found to be patentable in an office of first filing by taking advantage of the search and examination results of the office of first filing.⁶ This procedure helps avoid the repetition of search and examination efforts that have already been completed.⁷ The goal was to provide a means of accelerated examination and patent issuance, which would satisfy patent applicants because of its relative ease and efficiency.⁸ Through compliance with procedural requirements and submission of certain necessary documents, patent applicants may request participation in the Patent Prosecution Highway program for accelerated examination.

The USPTO and JPO pilot program ended a year and a half later, on January 3, 2008, with results showing that the Patent Prosecution Highway offered both patent offices a way to reduce backlogs, eliminate redundant work, streamline examination, and allow applicants to obtain expeditious and high quality patents.⁹ Although the extent of these positive attributes is not yet known

5. United States Patent and Trademark Office, Patent Prosecution Highway Program between the United States Patent and Trademark Office and the Japan Patent Office, http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/pph_pp.pdf (last visited April 23, 2009).

6. *Id.*

7. *Id.*

8. United States Patent and Trademark Office, Press Release: USPTO and JPO to Implement Patent Prosecution Highway on Full-Time Basis, <http://www.uspto.gov/web/offices/com/speeches/07-50.htm> (last visited April 28, 2009).

9. *Id.*

because the program is still nascent in its development, there are claims that the positive attributes are evident through the expanded scope and duration of the Patent Prosecution Highway program. Other programs, such as work-sharing initiatives¹⁰ and the Priority Document Exchange,¹¹ are also aimed at simplifying the process of prosecuting patents worldwide and reducing the redundancy of work done at the participating patent offices.¹²

The USPTO and JPO implemented the Patent Prosecution Highway on a full-time, permanent basis beginning on January 4, 2008.¹³ The JPO claimed that the advantages of the Patent Prosecution Highway included reducing the procedural burden to file a request for accelerated examination and enabling applicants to receive a first Office Action in an average of two to three months, rather than the 26 month average period from request for examination to first Office Action otherwise.¹⁴ John Dudas, the former Under Secretary of Commerce for Intellectual Property and Director of the USPTO, noted that the Patent Prosecution Highway showed significant potential for reducing the backlog of patent applications and for making better use of resources at the USPTO.¹⁵

B. The Japanese Patent Office Patent Prosecution Highway Requirements

In order to request an accelerated examination under the Patent Prosecution Highway with the JPO as the office of second filing,¹⁶ an

10. See United States Patent and Trademark Office, Press Release: Blueprint Laid Out for Work-Sharing among Five Intellectual Property Offices, <http://www.uspto.gov/web/offices/com/speeches/08-38.htm>.

11. See United States Patent and Trademark Office, Press Release: USPTO and the European Patent Office To Launch Electronic Priority Document Exchange, <http://www.uspto.gov/web/offices/com/speeches/06-68.htm> (last visited April 28, 2009).

12. Though these programs may be of interest to some patent applicants, it is beyond the scope of this paper to evaluate the other programs available to reduce the duplication of work in the prosecution of patent applications.

13. United States Patent and Trademark Office, Press Release: USPTO and JPO to Implement Patent Prosecution Highway on Full-Time Basis, <http://www.uspto.gov/web/offices/com/speeches/07-50.htm> (last visited April 28, 2009).

14. http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.htm (follow hyperlink below "3. Booklet on PPH") (last visited April 23, 2009).

15. United States Patent and Trademark Office, Press Release: USPTO and JPO to Implement Patent Prosecution Highway on Full-Time Basis, <http://www.uspto.gov/web/offices/com/speeches/07-50.htm>.

16. It should be noted that the Patent Prosecution Highway can also be used where the USPTO is the office of second filing, but because this Article is focused on usefulness

applicant must submit a form entitled “The Explanation of Circumstances Concerning Accelerated Examination,” comply with four requirements, and submit mandatory documents.¹⁷ If an applicant satisfies the four requirements and submits the necessary documents to the JPO, the applicant is not required to fill out section two, “Disclosure of prior arts and Comparison between the claimed invention and prior arts,” of “The Explanation of Circumstances Concerning Accelerated Examination” form.¹⁸

The four requirements are: (1) the application must validly claim priority to an application in the USPTO;¹⁹ (2) the application must have at least one claim determined to be patentable by the USPTO;²⁰ (3) the claims of the Japanese application must correspond

to patent attorneys in the United States, the following discussion will center on the USPTO as the office of first filing for all Patent Prosecution Highway programs.

17. Japanese Patent Office, Procedures to file a request to the JPO for Patent Prosecution Highway Program between the JPO and the USPTO, http://www.jpo.go.jp/torikumi_e/t_torikumi_e/pdf/patent_highway_e/jpo_english.pdf (last visited April 23, 2009).

18. http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.htm (follow hyperlink below “3. Booklet on PPH”) (last visited April 23, 2009).

19. The JPO application (including PCT national phase application) is

- (i) An application which validly claims priority under Paris Convention to the corresponding USPTO application(s),
- (ii) An PCT national phase application without priority claim, or
- (iii) An application which validly claims priority under Paris Convention to the PCT application(s) without priority claim.

The JPO application, which validly claims priority to multiple USPTO or PCT applications, or which is the divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible. Japanese Patent Office, Procedures to file a request to the JPO for Patent Prosecution Highway Program between the JPO and the USPTO, http://www.jpo.go.jp/torikumi_e/t_torikumi_e/pdf/patent_highway_e/jpo_english.pdf (last visited April 23, 2009).

20. The allowable/patentable claims are

- (i) The claims shown in the item of “The allowed claim(s) is/are ___” in “Notice of Allowability”;
- (ii) The claims shown in the item of “Claim(s) ___ is/are allowed” in “Office Action Summary” of “Non-Final Rejection” or “Final Rejection”;
- (iii) The claims shown in the item of “Claim(s) ___ is/are objected to” in “Office Action Summary” of “Non-Final Rejection” or “Final Rejection” and the USPTO examiner indicates that the claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Japanese Patent Office, Procedures to file a request to the JPO for Patent Prosecution Highway Program between the JPO and the USPTO, http://www.jpo.go.jp/torikumi_e/t_torikumi_e/pdf/patent_highway_e/jpo_english.pdf (last visited April 23, 2009).

sufficiently to the allowed claims in the USPTO application;²¹ and (4) the JPO must not have begun examination of the Japanese application.²²

In addition to the procedural requirements, as stated above, the JPO requires that certain documents be attached and filed with “The Explanation of Circumstances Concerning Accelerated Examination” form to be eligible to participate. These documents include: copies of all USPTO Office Actions for the corresponding application; copies of all claims determined by the USPTO to be patentable; copies of the USPTO cited references; and a claim correspondence table that indicates how the claims in the Japanese application sufficiently correspond to the allowed U.S. claims.²³ If these documents are available from the USPTO’s Patent Application Information Retrieval (“PAIR”) system, the applicant does not have to submit them and only has to list the names of the documents.²⁴ Also, if the applicant has already submitted the required documents to the JPO through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to resubmit those documents.²⁵ Translations of the Office Actions, cited references, and allowed claims are unnecessary.²⁶ If the Japanese claims are literal translations of the U.S. claims that may be indicated, but the applicant must explain the sufficient correspondence of each claim if the claims of the Japanese application are not just literal translations of the corresponding U.S. claims.²⁷

21. Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope. For the purposes of the JPO, “claims are of the same or similar scope” means that the claims must have a common technical feature which made the claims allowable over the prior art in the USPTO application. Note that when claims are determined to be allowable/patentable by the USPTO by making amendment to claims, the claims in the JPO also must be amended similar way to sufficiently correspond to the allowable/patentable claims in the USPTO application. Japanese Patent Office, Procedures to file a request to the JPO for Patent Prosecution Highway Program between the JPO and the USPTO, http://www.jpo.go.jp/torikumi_e/t_torikumi_e/pdf/patent_highway_e/jpo_english.pdf (last visited April 23, 2009).

22. Japanese Patent Office, Procedures to file a request to the JPO for Patent Prosecution Highway Program between the JPO and the USPTO, http://www.jpo.go.jp/torikumi_e/t_torikumi_e/pdf/patent_highway_e/jpo_english.pdf (last visited April 23, 2009).

23. *Id.*

24. *Id.*

25. *Id.*

26. *Id.*

27. *Id.*

C. Patent Prosecution Highway Programs Implemented in Other Countries

The Patent Prosecution Highway program has also been implemented between the USPTO and other foreign intellectual property offices with the same objectives and minor differences in the requirements. The USPTO began a pilot Patent Prosecution Highway program with the United Kingdom Intellectual Property Office (“UK IPO”) on September 4, 2007, which was originally scheduled to be in pilot mode for a year, but has since been extended until further notice in light of a modification in the requirements for participating in the Patent Prosecution Highway.²⁸ On January 28, 2008, the USPTO extended the Patent Prosecution Highway program on a trial basis to the Canadian Intellectual Property Office (“CIPO”) and the Korean Intellectual Property Office (“KIPO”) for a period of one year.²⁹ The Patent Prosecution Highway program was implemented on a full-time basis between the USPTO and the KIPO on January 29, 2009.³⁰ The trial period of the Patent Prosecution Highway program between the USPTO and the CIPO has been extended for two additional years, until January 28, 2011, unless terminated beforehand.³¹ On April 1, 2008, the USPTO announced another Patent Prosecution Highway pilot program with the Intellectual Property Office of Australia (“IPAU”).³² On September 29, 2008, the USPTO added the European Patent Office (“EPO”) as another pilot program for the Patent Prosecution Highway for a period of one year, with the option of extending or terminating sooner depending on the participation outcome.³³ Most recently, on

28. United States Patent and Trademark Office, Extension of the Patent Prosecution Highway Program between the USPTO and the UKIPO, <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/extphpukipo.pdf> (last visited April 23, 2009).

29. United States Patent and Trademark Office, Press Release, USPTO Expands Patent Prosecution Highway Network to Canadian, Korean Patent Offices (Jan. 28, 2008), <http://www.uspto.gov/web/offices/com/speeches/08-04.htm> (last visited April 23, 2009).

30. United States Patent and Trademark Office, Press Release, USPTO and KIPO to Implement Patent Prosecution Highway on Full-Time Basis, <http://www.uspto.gov/web/offices/com/speeches/09-01.htm> (last visited April 23, 2009).

31. Canadian Intellectual Property Office, Patent Prosecution Highway Pilot Program between the Canadian Intellectual Property Office and the United States Patent and Trademark Office, <http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01221.html> (last visited April 23, 2009).

32. United States Patent and Trademark Office, Press Release, USPTO and IP Australia to Pilot Patent Prosecution Highway (Apr. 1, 2008), <http://www.uspto.gov/web/offices/com/speeches/08-12.htm> (last visited April 23, 2009).

33. United States Patent and Trademark Office, Patent Prosecution Highway Pilot Program between the United States Patent and Trademark Office and the European

November 3, 2008, the USPTO began a year-long Patent Prosecution Highway pilot program with the Danish Patent and Trademark Office (“DKPTO”).³⁴

D. Differences in Participation Requirements for the Patent Prosecution Highway

Although the Patent Prosecution Highway has been implemented in each of the aforementioned countries, the requirements of participation are defined with minor differences in each country. In addition, as will be discussed in Section 3A, certain countries have alternate procedures in place that functionally result in accelerated patent examination but are not part of the Patent Prosecution Highway program. This Section summarizes the differences between requirements in the participating countries and the original USPTO and JPO Patent Prosecution Highway.

The United Kingdom Patent Prosecution Highway pilot program allows for accelerated examination of an application where there has been at least one claim found patentable in the USPTO. The participation requirements³⁵ are largely the same as the program

Patent Office, http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/pph_epo.pdf (last visited April 23, 2009).

34. United States Patent and Trademark Office, Press Release, USPTO and DKPTO to Pilot Patent Prosecution Highway (Nov. 3, 2008), <http://www.uspto.gov/web/offices/com/speeches/08-39.htm> (last visited April 23, 2009).

35. a) Either:

- i) the UK-IPO application validly claims priority under the Paris Convention from either a single corresponding USPTO application or multiple USPTO applications; or
- ii) the UK-IPO application is the national phase of a PCT application which has no priority claims, or
- iii) the UK-IPO application is the national phase of a PCT application which validly claims priority from a USPTO national application, or
- iv) the UK-IPO application claims priority from a PCT application which has no priority claims, or
- v) the UK-IPO application is the national phase of a PCT application which validly claims priority from a PCT application which has no priority claims, or
- vi) the UK-IPO application is a divisional application of any of the above.

b) At least one corresponding USPTO application has one or more claims that are determined to be patentable by the USPTO.

c) All claims in the UK IPO application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as patentable in the USPTO. Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope. Where amended claims have been determined to be patentable by the USPTO, the claims of the UK IPO application should be such that they correspond to the amended claims of the USPTO application. Claims of the UK IPO application which are appended to

between the United States and Japan, but there are a few differences in terms of the documents to be submitted. Unlike the JPO, the UK IPO does not require copies of the USPTO cited references, but instead requires submission of the search and examination reports from the USPTO to benefit from the previously completed work, which purportedly will reduce examination workload and improve the quality of patents.³⁶ Along with this prerequisite, the UK IPO requires the following: copies of the Office Actions from the corresponding U.S. application, copies of the claims examined by the USPTO, a completed claim correspondence table, a Patent Prosecution Highway request form, and translated versions of foreign language citations.³⁷

The Canadian Patent Prosecution Highway pilot program follows the basic premise of its predecessors although there are a few differences. Unlike the JPO or the UK IPO program, the CIPO program has five requirements for requesting participation in the Patent Prosecution Highway program. In addition to the four requirements modeled after the JPO program, the fifth prerequisite requires that the CIPO application either be open to public inspection or be authorized to be made public.³⁸ The CIPO also requires that an

earlier claims of the UK IPO application corresponding to claims that are indicated as patentable by the USPTO will also be considered where such claims fall within the scope of the claims indicated as patentable by the USPTO.

d) The UK IPO has not begun examination of the application.

United Kingdom Intellectual Property Office, Procedures to file a request to the UK IPO for Patent Prosecution Pilot Program between the UK IPO and the USPTO, <http://www.ipo.gov.uk/ukprocedure-uspto.pdf> (last visited April 23, 2009).

36. United Kingdom Intellectual Property Office, Patent Prosecution Highway between the UK and United States, <http://www.ipo.gov.uk/types/patent/p-applying/p-after/p-pph/p-pph-uspto.htm> (last visited April 23, 2009).

37. United Kingdom Intellectual Property Office, Request for Accelerated Examination at the UK IPO under the Patent Prosecution Highway Pilot Program between the UK IPO and the USPTO, <http://www.ipo.gov.uk/pphchecklist-uspto.pdf> (last visited April 23, 2009).

38. a) The CIPO application is either:

(i) a nationally filed application which validly claims priority under the Paris Convention from either a single USPTO national application or multiple USPTO national applications; or

(ii) a PCT national phase application where the PCT international application has validly claimed priority from a USPTO national application or multiple USPTO national applications; or

(iii) a divisional of an application referred to in (i) or (ii)

b) At least one corresponding USPTO application has one or more claims that are determined to be allowable by the USPTO.

c) All claims on file, as originally filed or as amended, for accelerated examination under the PPH must sufficiently correspond to one or more of those

applicant submit a letter requesting accelerated examination in addition to a completed Patent Prosecution Highway request form,³⁹ as well as fulfill the requirements and supply the supporting documentation.⁴⁰ The necessary documents are: a copy of the USPTO Office Actions, a copy of the patentable claims as determined by the USPTO, and a completed claim correspondence table illustrating the relationship between the CIPO application and the USPTO application.⁴¹ These documents can either be provided by the applicant or the applicant can request that the CIPO obtain copies of the Office Actions and patentable claims from the USPTO if the relevant information is clearly identified and the application is publicly available.⁴²

The Korean Patent Prosecution Highway pilot program closely follows the JPO scheme. One key difference, however, is that KIPO does not restrict participation to applications that have not yet begun examination.⁴³ In fact, the KIPO requires that a “Request for

claims indicated as allowable in the USPTO. Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope. CIPO shall consider corresponding USPTO claims to be allowable as indicated in a US Letters Patent or in an Office Action.

d) The CIPO application is open to public inspection.

e) CIPO has received a request for examination, but has not begun examination of the application.

Canadian Intellectual Property Office, Requirements and Procedures to File a Request to CIPO for the Patent Prosecution Highway Pilot Program between CIPO and the USPTO, [http://www.cipo.ic.gc.ca/epic/site/cipointernetinternetopic.nsf/vwapj/PPH_requirements_procedures-e.pdf/\\$FILE/PPH_requirements_procedures-e.pdf](http://www.cipo.ic.gc.ca/epic/site/cipointernetinternetopic.nsf/vwapj/PPH_requirements_procedures-e.pdf/$FILE/PPH_requirements_procedures-e.pdf) (last visited April 23, 2009).

39. Canadian Intellectual Property Office, PPH Pilot Program Request Form, [http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/vwapj/PPH_Request_Form-e.pdf/\\$FILE/PPH_Request_Form-e.pdf](http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/vwapj/PPH_Request_Form-e.pdf/$FILE/PPH_Request_Form-e.pdf) (last visited April 23, 2009).

40. Canadian Intellectual Property Office, Requirements and Procedures to File a Request to CIPO for the Patent Prosecution Highway Pilot Program between CIPO and the USPTO, [http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/vwapj/PPH_requirements_procedures-e.pdf/\\$FILE/PPH_requirements_procedures-e.pdf](http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/vwapj/PPH_requirements_procedures-e.pdf/$FILE/PPH_requirements_procedures-e.pdf) (last visited April 23, 2009).

41. *Id.*

42. *Id.*

43. (1) The KIPO application (including a PCT national phase application) is
- (a) An application which validly claims priority under Paris Convention to the corresponding USPTO application,
 - (b) A national phase application of a PCT application that contains no priority claims, indicates both the KIPO and the USPTO as Designated Offices (DO) or
 - (c) An application which validly claims priority under Paris Convention to “a PCT application that contains no priority claims.”

The following KIPO applications are also eligible for the PPH pilot program:

Examination” have been filed for the KIPO application before an applicant may request participation in the Patent Prosecution Highway.⁴⁴ This is a unique feature that was originated in the Korean system and allows preferential examination even if examination has commenced on an application in the KIPO. Thus, an applicant may request an accelerated examination of an application pending in the KIPO all the way up until the grant of the application. This flexibility in timing of the filing is allowed only by one other patent office, the Danish Patent and Trademark Office.

Australia, as one of the recent participants in the Patent Prosecution Highway pilot programs, essentially follows most of the requirements of the pilot programs in other participating countries. There are four filing requirements, which closely correspond to those in the JPO program.⁴⁵ In addition, Applicants must submit a letter

-
- 1) an application claiming priority to multiple USPTO applications or PCT applications, or
 - 2) a divisional application based on the filed application which is included in (a) to (c) above. . . .

(2) The corresponding USPTO application has at least one claim that is determined to be allowable/patentable by the USPTO. The allowable/patentable claims are the claim which is explicitly identified as allowable/patentable in the Office Action below:

- 1) the claims shown in the item of “The allowed claim(s) is/are____” in the “Notice of Allowability”,
- 2) if there is no “Notice of Allowability”, the claims shown in the item of “Claim(s)_____is/are allowed” in “Office Action Summary” of “Non-final Rejection” or “Final Rejection”(It is necessary to be the last Office Action at the point of the request for participation in the PPH pilot program). . . .

(3) All claims in the KIPO application must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims indicated as allowable/patentable in the USPTO. Claims shall be considered to sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope. For the purposes of the KIPO, “claims are of the same or similar scope” means that claims are practically same. . . .

(4) Whether examination of the KIPO application for which participation in the PPH pilot program has not begun does not affect eligibility for participation in the PPH pilot program. In other words, the KIPO application is eligible for preferential examination under the PPH pilot program not only in the case that examination has not begun but also examination has already begun.

(5) “Request for Examination” must have been filed for the KIPO application same as other request for preferential examination.

Korean Intellectual Property Office, Procedures to File a Request to the Korean Intellectual Property Office for Participation in the Patent Prosecution Highway Pilot Program between the Korean Intellectual Property Office and the United States Patent and Trademark Office, http://www.kipo.go.kr/image/ek/phh/1_PPH_KIPO_English.pdf (last visited Apr. 23, 2009).

44. *Id.*

45. 1. The Australian (AU) application is a standard complete application and is

requesting accelerated examination, clearly indicating the applicant's wishes for accelerated examination under the Patent Prosecution Highway, along with a completed Patent Prosecution Highway request form with the required supporting documents, which are identical to the CIPO requirements.⁴⁶

The European Patent Office Patent Prosecution Highway pilot program has eligibility requirements that correspond to the JPO program, except that only applications filed under the Paris Convention that validly claim the priority of one or more USPTO applications are eligible.⁴⁷ The required documents also correspond

either:

- (a) a nationally filed application which validly claims priority under the Paris convention from either a single USPTO national application or multiple USPTO applications; or
- (b) a PCT national phase application where the PCT international application has validly claimed priority from a USPTO national application or multiple USPTO national applications; or
- (c) a PCT national phase application where the PCT international application has no priority claims or
- (d) a divisional of an application referred to in (a),(b) and (c) . . .

2. At least one corresponding USPTO application has one or more claims that are determined to be allowable by the USPTO. A corresponding USPTO application means either:

- (a) a USPTO national application on the basis of which the AU application referred to under item 1 above claims priority, or
- (b) a USPTO application that is a member of the same patent family (eg a continuation of a US application on the basis of which priority is claimed).

3. All claims in the standard patent application for accelerated examination under the PPH must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims indicated as allowable/patentable by the USPTO or be dependant (sic) upon or fall within the scope of such a claim. Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope. IP Australia shall consider corresponding USPTO claims to be allowable/patentable as indicated in a USPTO Office Action. A USPTO Office Action includes a "Non-Final Rejection", "Final Rejection", "Ex parte Quayle" and a "Notice of Allowability".

4. IP Australia has not issued a first examination report on the application.

Australian Patent Office, Requirements and Procedures to File a request to IP Australia for the Patent Prosecution Highway Pilot Program between IP Australia and the USPTO, http://www.ipaustralia.gov.au/pdfs/patents/PPH_USPTO_Procedures.pdf (last visited Apr. 23, 2009).

46. *Id.*

47. (1) The EP application is a Paris Convention application validly claiming the priority of one or more applications filed with the USPTO.
- (2) The USPTO application(s) has at least one claim determined by the USPTO to be patentable/allowable . . .
- (3) All the claims in each EP application for which a request for participation in the PPH pilot programme is made must sufficiently correspond or be amended to sufficiently correspond to the patentable/allowable claims in the USPTO

to those required by the JPO, which are (1) copies of all the Office Actions issued by the USPTO; (2) copies of the allowed claims; (3) copies of all the documents cited in the USPTO, with translations if necessary; and (4) a claim correspondence table, which must be in English.⁴⁸ The applicant must file a request for participation in the Patent Prosecution Highway form along with the required documents, and all of these documents must be filed in paper form until the European Patent Office adapts online filing software for the program.⁴⁹

Denmark, the most recent participant of the Patent Prosecution Highway pilot programs, closely follows the JPO program eligibility requirements, with two exceptions. The first is that a national stage application of the PCT without priority claims is also eligible for the Patent Prosecution Highway program in Denmark. The second, similar to the KIPO program, is that an application that has already been examined is eligible for the program as long as there has been no communication stating an intention to grant.⁵⁰ The documents

application(s). Claims will be considered to sufficiently correspond where, accounting for differences due to claim format requirements, the claims are of the same or similar a scope . . .

(4) Examination of the EP application for which participation in the PPH pilot programme is requested has not begun.

European Patent Office, Patent Prosecution Highway Pilot Programme between the European Patent Office and the United States Patent and Trademark Office, <http://www.epo.org/patents/law/legal-texts/InformationEPO/archiveinfo/20080926.html> (last visited Apr. 23, 2009).

48. *Id.*

49. *Id.*

50. a) *The DKPTO application (including PCT national phase applications) is:*

(i) an application which validly claims priority under the Paris Convention to the USPTO application(s) . . .

(ii) a PCT national phase application without priority claim (direct PCT applications) . . . , or

(iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim

A DKPTO application which validly claims priority to multiple USPTO or PCT applications, or which is a divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

b) At least one corresponding USPTO application has one or more claims that have been determined to be patentable by the USPTO . . .

c) All claims in the DKPTO application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as patentable in the USPTO. . . .

d) The DKPTO has not yet issued a communication stating an intention to grant.

The heading for such a communication will either be “Berigtigelse af bilag” or “Godkendelse.”

required for participation in the Patent Prosecution Highway program are identical to those in the JPO.⁵¹ An applicant must file a letter requesting accelerated examination under the Patent Prosecution Highway pilot program; a Patent Prosecution Highway completed request form; and the required supporting documentation, either by paper mail or electronic mail to be considered for the program.⁵²

III. To Use or Not to Use the Patent Prosecution Highway

The Patent Prosecution Highway was implemented to provide applicants an option to accelerate examination and obtain patents in less time than would be possible without the collaboration between patent offices; it was also intended to promote inexpensive and high quality patent protection around the world.⁵³ The important question, however, is whether the Patent Prosecution Highway effectively addresses the goal of the patent applicants, which is to obtain the most comprehensive patent rights in the most expedient manner.

This Section will discuss how the Patent Prosecution Highway, as currently enforced, fails to effectively serve its purpose. This is especially true in certain participating countries, which have certain procedures in place that allow for expedited examination without the Patent Prosecution Highway's required voluntary amendment to limit claim scope. The Section will then discuss certain situations where participating in the Patent Prosecution Highway may be acceptable, either because of the lack of alternative procedures, or because limitations on claim scope do not interfere with the concerns of the applicant.

Danish Patent and Trademark Office, Procedures to file a request to the DKPTO for Patent Prosecution Highway Pilot Program between the DKPTO and the USPTO, http://www.dkpto.dk/media/58660/dkpto_guideline_for_usfilers_081030.pdf (last visited Apr. 23, 2009).

51. *Id.*

52. *Id.*

53. United States Patent and Trademark Office, Press Release: USPTO and JPO to Implement Patent Prosecution Highway on Full-Time Basis, <http://www.uspto.gov/web/offices/com/speeches/07-50.htm>.

A. Cons: General and Country-Specific Pitfalls of Using the Patent Prosecution Highway

1. General Negative Impacts

The most relevant criticism of all current Patent Prosecution Highway programs is that all claims in the office of second filing must be limited to the claim scope allowed in the office of first filing, which could result in narrower claims than if prosecuted separately in each country. This major limitation may not be optimal for many applicants who prefer to have broadest scope of claims, which may differ from country to country due to the differences in patent laws and local practice. Another criticism is that filing applications under all Patent Prosecution Highway programs could increase initial costs due to the filing requirements, which involve compiling specific documents, writing letters, and filling out petitions.

3. Country-Specific Practices That Reduce the Allure of the Patent Prosecution Highway

In view of the different patent laws and practices of each participating country, there are distinct disadvantages in choosing to use the Patent Prosecution Highway in each participating office. This Section will discuss country-specific alternative procedures or practices that accelerate examination without a voluntary limitation of claim scope, which illustrate the major disadvantages in using the Patent Prosecution Highway program in each of the participating countries where these alternatives exist.

a. Canada

As discussed above generally, a major disadvantage of the Patent Prosecution Highway program in Canada is that the program requires a voluntary claim amendment to correspond substantially to the allowed claims in the U.S., which may unnecessarily limit the claim scope or may be inappropriate in view of the Canadian patent law and practice. For example, Canada does not follow the U.S. rule in which the one year grace period for the public use or sale of the invention applies only to activities occurring in the U.S.⁵⁴ This means that prior use of the invention by another in Canada or any other country may not be a bar to obtaining a U.S. patent provided that

54. DAVID HECKADON, DAVID HECKADON ON THE DIFFERENCES BETWEEN US AND CANADIAN PATENT PROSECUTION 2 (2007), available at <http://www.lexisnexis.com/store/catalog/productdetail.jsp?pageName=relatedProducts&catId=catEC37&prodId=EC1590>.

there is no printed publication accompanying the invention, whereas such prior use would be a bar to obtaining a patent in Canada.⁵⁵ Also, unlike the U.S., higher life forms and methods of medical treatment are not patentable in Canada.⁵⁶ As such, claims amended to substantially correspond to the allowed U.S. claims, which must still be examined under the program, may nevertheless be unpatentable in Canada in certain situations due to the differences in patent laws between the two countries.

Moreover, in view of Canadian patent law, which significantly limits filing divisional and continuation applications,⁵⁷ prosecution of additional subject matter in a continuation or voluntary divisional application is not an acceptable strategy to obtain a broader claim scope that was given up to satisfy the requirements of the Patent Prosecution Highway. For example, continuations-in-part applications are not available in Canada per se.⁵⁸ Also, any published application can be cited against a later Canadian application, including an inventor's own applications.⁵⁹ In addition, voluntary filing of divisional applications in Canada can be problematic because they are not immune from, and may invite, a double patenting rejection, for which Canada has no terminal disclaimer practice, which is available in the United States.⁶⁰ These differences in the patent laws suggest that it may be difficult to overcome the disadvantages of limited claim scope required by the Patent Prosecution Highway in Canada.

Canada has a particularly attractive alternative to the Patent Prosecution Highway program, which is an existing procedure for expediting examination called the Special Order request.⁶¹ After a completed application has been filed and a request for examination has been sought, an applicant or any other person may request that

55. *Id.*

56. *Id.* at 3-4.

57. *Id.* at 6-7.

58. *Id.* at 7.

59. DAVID HECKADON, DAVID HECKADON ON THE DIFFERENCES BETWEEN US AND CANADIAN PATENT PROSECUTION 7 (2007), available at <http://www.lexisnexis.com/store/catalog/productdetail.jsp?pageName=relatedProducts&catId=catEC37&prodId=EC1590>.

60. *Id.* at 7-8.

61. Canadian Intellectual Property Office, Canada Manual of Patent Office Practice § 13.03, available at [http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/vwapj/ch13-e.pdf/\\$FILE/ch13-e.pdf](http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/vwapj/ch13-e.pdf/$FILE/ch13-e.pdf).

the examination be advanced.⁶² The request must be in writing and must state that failure to grant the request would likely result in prejudice to that person's rights, but no further evidence or details are required.⁶³ The fee associated with filing for advanced examination is \$500.⁶⁴ The application must be open to the public for advanced examination to be granted, but the applicant can request early opening along with the request for advanced examination.⁶⁵ Interestingly, a third party also may request advanced examination under the Special Order in Canada.⁶⁶ While the CIPO aims to have a first substantive examination completed in somewhere between 18-30 months, depending on the subject area, under the usual examination⁶⁷ the Special Order request could greatly reduce the amount of time to the grant of a patent, without unnecessarily limiting claim scope to that allowed in the USPTO.⁶⁸ As such, the Patent Prosecution Highway does not offer any additional advantage over the existing procedure of expedited examination by Special Order in Canada. Therefore, to obtain the broadest patent rights, filing a national phase application early and immediately requesting expedited examination is a preferable prosecution strategy than filing an application through the Patent Prosecution Highway.

b. Australia

Australia similarly offers a procedure by which an applicant can request that an application receive expedited examination without participating in the Patent Prosecution Highway program or having to limit the scope of the claims. According to section 2.13.4.3 of the Australian Patent Manual of Practice and Procedures, an applicant may request expedited examination of a patent application in writing

62. *Id.*

63. *Id.*

64. Patent Rules § 3 pt. I Sched. II l. 4 SOR/2002-147 (Can), available at <http://laws.justice.gc.ca/en/showdoc/cr/SOR-96-423/sc:2/en>.

65. Canadian Intellectual Property Office, Canada Manual of Patent Office Practice § 13.03, available at [http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/vwapj/ch13-e.pdf/\\$FILE/ch13-e.pdf](http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/vwapj/ch13-e.pdf/$FILE/ch13-e.pdf).

66. *Id.*

67. Canadian Intellectual Property Office, Client Service Standards for 2008-2009, <http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01249.html> (last visited Apr. 13, 2009).

68. *See id.*

or by phone.⁶⁹ The Electronic Records Administration will process the request and then forward it to the appropriate examination section; the case will then appear at the top of that section's inbox and be highlighted in red.⁷⁰ The regulations pertaining to this section only state that the Commissioner may expedite examination as long as he or she is reasonably satisfied that it is in the public interest to do so or that special circumstances make it desirable.⁷¹ As such, the Patent Prosecution Highway program may not provide any advantage over the current procedure. As with all of the other Patent Prosecution Highway programs, the requirement of voluntary claim amendment is a detriment that is not present in the existing procedure. Therefore, there is an especially strong argument that a better strategy in Australia is to file a national phase application early and immediately request expedited examination, in order to obtain the broadest patent rights, rather than filing an application through the Patent Prosecution Highway.

c. European Patent Office

The European Patent Office has a program for accelerated prosecution of a patent called PACE, which avoids the claim scope limitation of Patent Prosecution Highway.⁷² Accelerated prosecution of European patents may be granted upon written request, and that request is not published by the EPO.⁷³ PACE allows an applicant to obtain a search report, first examination report, and other communications within tight deadlines.⁷⁴ For applications claiming no priority, the EPO automatically performs an accelerated search, ensuring a search report within six months of the filing date as long as the application documents are complete enough for a search to be performed upon filing.⁷⁵ For those European applications that claim priority, an accelerated search may be requested when the application

69. Australian Patent Office, Patent Manual of Practice & Procedures § 2.13.4.3 (2007), http://www.ipaustralia.gov.au/pdfs/patentsmanual/WebHelp/National/Examination/2.13.4.3_Expedited_Examination.htm (last visited Apr. 12, 2009).

70. *Id.*

71. Patents Regulations, 1991, c. 3, 3.17(2) (Austl.), available at <http://www.timebase.com.au/IPAust/index.cfm?id=patreg:3.17>.

72. European Patent Office, Notice from the European Patent Office dated July 14, 2007 concerning the programme for accelerated prosecution of European patent applications—"PACE," available at http://www.epo.org/patents/law/legal-texts/html/guiapp1/e/ga_aai.htm (last visited April 28, 2009).

73. *Id.*

74. *Id.*

75. *Id.*

is filed, and the EPO will make every effort to issue a search report as soon as possible, as long as the application documents are complete enough for a search to be performed upon filing.⁷⁶

Accelerated examination can also be requested in writing when filing a European patent application, provided that examination is bindingly requested at the same time, in response to a search report, or subsequently.⁷⁷ Accelerated examination can be requested for European-PCT applications only upon entry of after entry into the European phase before the EPO.⁷⁸ Once accelerated examination is requested, the EPO makes all efforts to issue the first examination communication within three months of the receipt of the application by the examining division or the request for accelerated examination, whichever is later.⁷⁹ Because of the availability of the PACE program, which does not require any particular reason or support for the accelerated examination request, there does not appear to be any detriment to choosing PACE over the Patent Prosecution Highway program. Although PACE may take more time than the Patent Prosecution Highway, it avoids the requirement of limiting claim scope, which is advantageous in obtaining the most expansive patent rights.

d. United Kingdom

As discussed above, the major pitfall in using the Patent Prosecution Highway program is the limitation of claim scope, which may be inappropriate in view of the U.K. patent law and practice. UK IPO offers an existing procedure for requesting accelerated examination. Unlike the existing procedures in Canada or Australia, however, the U.K. procedure requires adequate support specific to the particular circumstances of the case.⁸⁰ Section 17.05.1 of the United Kingdom Manual of Patent Practice states that an applicant can request an accelerated search to be performed if adequate reason is given, and states that an adequate reason is in part dependent on

76. *Id.*

77. European Patent Office, Notice from the European Patent Office dated July 14, 2007 concerning the programme for accelerated prosecution of European patent applications—“PACE,” available at http://www.epo.org/patents/law/legal-texts/html/guiapp1/e/ga_aai.htm (last visited April 28, 2009).

78. *Id.*

79. *Id.*

80. *Id.*

the applicant's actions, such as prompt filing of certain documents.⁸¹ Section 18.07 further provides that circumstances such as existence of a potential infringer constitutes an adequate and justified reason.⁸² Upon receipt of the request, an examiner should issue a report confirming or denying accelerated examination.⁸³ If allowed, the report should state that examination will proceed as quickly as possible, but generally no report will issue in less than three months after the application is published, to allow third parties to file observations and to update the search.⁸⁴ This "three month" rule does not necessarily apply to divisional applications and international applications entering the national stage.⁸⁵

Under the current UK IPO practice, patents typically take two to three years to grant, and by requesting accelerated examination this time may be substantially reduced.⁸⁶ Although this strategy may take more time to prosecute than under the Patent Prosecution Highway program, it would potentially provide a more comprehensive patent protection and therefore should be considered in place of the Patent Prosecution Highway, provided that the conditions can be met.

If the requirements under the existing accelerated examination cannot be met, it may nevertheless be preferable to file a single national stage application if a broader scope of protection is sought. To expedite examination voluntary claim amendments should be filed early.⁸⁷ First, in order to expedite examination, the applicant should fully and promptly respond to each and every objection raised by the Examiner to progress the application towards grant, explain how each amendment meets the objection and how it is supported by the

81. UK Manual of Patent Practice—Patents Act 1977, Section 17.05.1, *available at* <http://www.ipo.gov.uk/practice-sec-017.pdf> (last visited April 28, 2009).

82. UK Manual of Patent Practice—Patents Act 1977, Section 18.07, *available at* <http://www.ipo.gov.uk/practice-sec-018.pdf> (last visited April 28, 2009).

83. UK Manual of Patent Practice—Patents Act 1977, Section 18.07.1, *available at* <http://www.ipo.gov.uk/practice-sec-018.pdf> (last visited April 28, 2009).

84. *Id.*

85. *Id.*

86. United Kingdom Intellectual Property Office, After You Apply, <http://www.ipo.gov.uk/types/patent/p-applying/p-after.htm> (last visited April 28, 2009).

87. United Kingdom Intellectual Property Office, UK IPO Code of Practice for Patent Applicants and Agents: *Time Issues in Patent Processing*, <http://www.ipo.gov.uk/codeofpractice.pdf> (last visited April 28, 2009).

original specification, and do not broaden or add new technical disclosures to the scope of the claims.⁸⁸

e. Japan

Japan also offers an existing accelerated examination procedure, but it may not be as inclusive or as attractive as those available in other foreign patent offices. The accelerated examination and accelerated appeal examination procedure is only applicable to the following four types of applications: (1) working invention-related applications; (2) internationally filed applications;⁸⁹ (3) academic institutes-related applications; and (4) small-medium enterprise applications.⁹⁰ Applicants who wish to apply for accelerated examination are required to specify the application number of a foreign application or submit a document or copy of a foreign filed application.⁹¹ In addition, the procedure is required to be carried out in Japanese, and therefore, an applicant who is neither domiciled nor has an address in Japan must do so through a local agent or a local law firm.⁹² The average pendency to a first Office Action under the procedure is 2.2 months, which is shorter than the pendency under normal Japanese patenting procedure.⁹³

Japan has also recently begun a “Super Accelerated Examination System” on a pilot basis to process applications more rapidly.⁹⁴ The program began on October 1, 2008. On October 17, 2008, the first

88. United Kingdom Intellectual Property Office, UK IPO Code of Practice for Patent Applicants and Agents: *Responding to the Examiner's Objections*, <http://www.ipo.gov.uk/codeofpractice.pdf> (last visited April 28, 2009).

89. “Internationally-filed applications” include “applications that were filed with both JPO and at least one foreign IP Office,” “applications that were filed with the IP Office as the Receiving Office under the PCT and then entered in the national phase in Japan,” as well as “applications that were filed with the JPO as domestic applications and also filed with the Receiving Office under the PCT.” Outline of Accelerated Examination and Accelerated Appeal Examination (Patents), http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi_e/t_torikumi_e/outline_accelerated.htm (last visited April 28, 2009).

90. *Id.*

91. *Id.*

92. *Id.*

93. Harakenzo World Patent and Trademark, Super Accelerated Examination to Commence on October 1, 2008, <http://www.harakenzo.com/cgi-bin/newsmnt/article.cgi?lang=e&id=00756> (last visited April 28, 2009).

94. Japanese Patent Office, First Patent Granted under Super Accelerated Examination System, http://www.jpo.go.jp/torikumi_e/hiroba_e/first_patent_granted.htm (last visited April 28, 2009).

patent under the program was granted in 17 days after filing.⁹⁵ The requirements for participating are:

(1) a request for examination must have been filed; (2) the applicant must not have received a Notification of Reasons for Refusal, a copy of Decision to Grant a Patent, a Notice of Violation of Obligation to Disclose Prior Art Documents, or a Directive for Consultation; (3) the application must apply to a working related application filed in the JPO and at least one foreign intellectual property office; (4) the proceedings in the super accelerated examination must all take place online; and (5) an application cannot be transferred from a Patent Cooperation Treaty international phase application to a national phase application in Japan.⁹⁶

If accepted into the Super Accelerated Examination System, a first examination result will issue in a month or less, to which the applicant has one month or less to respond. Subsequently, a second examination result will issue in one month or less.⁹⁷ In its preliminary stages, the Super Accelerated Examination System has its drawbacks, namely the strict requirements and timeline. In terms of claim scope, the Super Accelerated Examination System nevertheless may be a preferable option compared to the Patent Prosecution Highway, if the requirements can be met

f. Korea

Korea also maintains a procedure for preferential examination, which is limited to particular circumstances. Once an application has been filed and a request for examination has been made, the Commissioner of KIPO may direct an examiner to preferentially examine a patent application under either of two prescribed circumstances: (1) an invention has been commercially used by a person other than the applicant after the application has been available to the public, or (2) an invention relates to one of the categories stipulated by the Presidential Decree.⁹⁸ To qualify under

95. *Id.*

96. Harakenzo World Patent and Trademark, Super Accelerated Examination to Commence on October 1, 2008, <http://www.harakenzo.com/cgi-bin/newsmt/article.cgi?lang=e&id=00756> (last visited April 28, 2009).

97. *Id.*

98. The two circumstances are:

(i) where a person other than the applicant is considered to commercially and industrially work the invention claimed in the patent application after the laying open of the application; or

the Presidential Decree, an application may: (1) relate to goods for the defense industry or preparation thereof; (2) relate to environmental pollution prevention; (3) relate to the promotion of export; (4) filed by an employee of the central government or a local government; (5) be an application that the KIPO Commissioner and another patent office head have agreed to examine on an expedited basis; (6) be an application that a KIPO approved agency has been requested to conduct the prior art search and forward those results to the KIPO commissioner; and (7) so forth.⁹⁹ To request accelerated examination, an applicant must submit a written request along with the application, and a statement explaining the necessity of accelerated examination in detail, in addition to any evidence supporting that statement.¹⁰⁰ Due to the rather limited circumstances that qualify for the existing accelerated examination procedure in Korea, it may not be practical for a majority of patent applicants to consider filing under the procedure.

B. Pros: Reasons to Take Advantage of the Patent Prosecution Highway

Although the Patent Prosecution Highway may not serve the general strategy of obtaining the broadest claim scope in each country, especially in view of differences in patent laws and local practices of certain countries, the program may be well-suited in specific situations. In general, relatively consistent filing requirements of the various Patent Prosecution Highway programs renders applying for accelerated examination in the participating countries a more predictable and simpler process than some of the existing procedures for accelerated examination.

One particularly illustrative situation where the Patent Prosecution Highway would be beneficial is where an applicant has obtained issuance of the broadest claim scope that serve the applicant's purpose in the USPTO. In this situation, the Patent Prosecution Highway's mandatory voluntary claim amendments would not be an onerous requirement that limits the scope of patent protection. As such, the Patent Prosecution

(ii) where urgent processing of the patent application is considered necessary as prescribed by Presidential Decree.

Korea Patent Act, Article 61, *available at* <http://www.buyusa.gov/korea/en/patent.html> (click the "Patent Act" link to download a copy of The Act).

99. Korean Intellectual Property Office, Patents: Application Procedure, Accelerated Examination, <http://www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=30101&catmenu=ek30101> (last visited April 28, 2009).

100. *Id.*

Highway may be a more attractive alternative to the existing procedures for accelerated examinations because of the relative uniformity in requirements among the participating countries. Moreover, in practice, notwithstanding the issue of claim scope, many applicants often employ a strategy of amending the claims in pending foreign applications to correspond to allowed claims in the USPTO. Therefore, the Patent Prosecution Highway may benefit such applicants to obtain foreign patents in efficient and cost effective manner.

Another situation that illustrates the positive attributes of the Patent Prosecution Highway would be where an applicant is primarily concerned with obtaining patents in the participating countries quickly, notwithstanding the relatively narrow scope of claims allowed in the USPTO. For example, if the issued claims would most likely be the broadest claim scope allowed in the participating foreign countries given a specific prior art issue or other limiting considerations, the Patent Prosecution Highway may effectively decrease the prosecution cost and time. Also, in the event that the claims must be narrowed to correspond to the allowed claims, applicants may file continuation applications to pursue broader claims in most countries. Canada is one example where this would not be an acceptable strategy.

In addition, some countries do not offer viable alternative procedures for accelerated examination. For example, the DKPTO does not offer an alternative procedure. Also, although the United Kingdom, Japan, and Korea offer various forms of existing procedures for accelerated examination, those procedures may not be practical for many patent applicants due to their strict requirements or specific and narrow circumstances of qualification.

IV. Conclusion

In light of the increasing advances in emerging technologies, possessing global patent rights, and obtaining those rights in an effective and cost effective manner, will continue to be a growing concern for patent applicants. Although the Patent Prosecution Highway is a step in the right direction of accelerating patent prosecution and increasing cooperation between international patent offices, the program, due to its limitations, is far from drastically reducing the backlogs of patent applications around the world. Although the positive attributes of the Patent Prosecution Highway offers benefits to some applicants in certain situations, the program may not be a first-choice strategy in prosecuting foreign patents for most applicants. It is important to carefully consider the needs of the

applicant and the country-specific requirements to determine whether the Patent Prosecution Highway is an acceptable option.

A large concern for many patent applicants is obtaining the most comprehensive patent rights possible. Although the Patent Prosecution Highway was designed to implement a more global patent system, it has not effectively addressed this legitimate concern of many applicants. With opportunities in certain foreign countries to obtain expedited examination through other existing procedures, the attractiveness of the Patent Prosecution Highway is reduced.

Because of the differences in patent law and local practices of various jurisdictions, it may not be feasible at this point in time to implement a global intellectual property network that grants patent protection internationally in a satisfactory manner. It is important for the participating patent offices to review the participation rates in the Patent Prosecution Highway programs and the quality of the patents issued under the programs to determine whether it is worth the cost to move forward and continue with its implementation. As the Patent Prosecution Highway programs mature they may develop answers to the concerns of patent applicants desiring broad patent claim rights, but at present it is uncertain that the Patent Prosecution Highway is going to make it out of the slow lane.
