

## **PATENTS PROSECUTION HIGHWAY**

### **Introduction on Patents Prosecution Highway**

It is a common practice for companies to seek patent protection in various jurisdictions for the same invention. As each of these patent applications would need to undergo search and/or examination by the different patent offices, it is therefore not only a costly process for applicants but also one which requires significant time and effort from the patent offices to perform.

To reduce duplication of effort while expediting the processing of the patent applications without compromising the quality of the search and examination, several national patent offices began to explore the possibility of collaborating with one another through the Patent Prosecution Highway (PPH), which was first initiated in 2006 as a pilot programme between United States Patent and Trademark Office (USPTO) and Japan Patent Office (JPO) and subsequently made permanent in 2008.

Under the PPH, partnering patent offices will be able to accelerate the examination process by making use of the outcome of the examination performed by a first patent office on the corresponding application at a second patent office. This will lead to an improvement in efficiency, thereby allowing patent applications to proceed to grant earlier.

### **USPTO-IPOS and JPO-IPOS PPH Programmes**

The Intellectual Property Office of Singapore (IPOS) has entered into two separate PPH programmes in 2009, one with USPTO and the other with JPO. Although the programmes were initially set to run for a year, they have been further extended in order to allow the patent offices to gather additional information as well as to make a better assessment on the feasibility of such PPH programmes. Under these PPH programmes, applicants can rely on the final search and examination results or the patent grant of their corresponding US or Japan application to request for accelerated prosecution of their Singapore application and vice versa.

### **Requirements**

When requesting for accelerated prosecution of a Singapore patent application under the PPH programme with either the USPTO or the JPO, the following requirements must be fulfilled:

- (i) The Singapore application must validly claim priority to either a PCT application or an application which has been filed with IPOS or with the USPTO/JPO, from which the corresponding US/JP application also validly claims priority from. In this regard, the Singapore application can be a convention application or a national phase entry of a PCT application, including a divisional application; and
- (ii) If the Singapore application is a national phase entry of a PCT application, the applicant must not have filed a notice of intention to rely on the International Preliminary Report on Patentability or have been issued with an examination report or a search and examination report by IPOS.

## **Request Procedures**

To make use of the PPH programme, the application filed either with IPOS or USPTO/JPO must contain at least one allowable claim before the applicant can make a request for the other patent office to accelerate the examination of the corresponding claims in the corresponding application.

When the Singapore application proceeds under the PPH, it is necessary to provide one of the following for submission to IPOS and to conform the claims in the Singapore application to those in the corresponding US/JP application:

- (i) a copy of the granted US/JP patent; or
- (ii) documents setting out the final results of the search and examination as to substance together with a copy of the patent claims referred to in the final results of the US/JP application being relied upon.

## **Similarity To Existing Local Examination Option**

The concept behind the PPH programmes should not be unfamiliar since there is an existing examination option under Singapore patent law that allows an application to proceed to grant based on the final search and examination results of a corresponding application or a corresponding patent grant, including those established by the USPTO and JPO. In fact, other than the need to clearly indicate on the prescribe form when an applicant is making an accelerated request under the respective PPH programme, there is no difference between the formal procedures of the PPH programmes and those of the local examination option as mentioned earlier.

## **In Closing**

US and Japan are jurisdictions in which applicants commonly seek patent protection in. Hence, the PPH Programmes which IPOS currently has in place with USPTO and JPO could be beneficial to applicants who have obtained allowance for their applications in either US or JP as they could request for accelerated prosecution of their Singapore applications by using the final search and examination result or patent grant of the US/JP application.

The USPTO-IPOS and JPO-IPOS PPH programmes have been extended to allow more time for the authorities to gather information before making formal decisions on the programmes. Perhaps like the USPTO-JPO PPH programme which first began as a one-year pilot programme but was subsequently made permanent by the two patent offices, the USPTO-IPOS and JPO-IPOS PPH programmes may also be established as permanent arrangements in the future.

Nevertheless, even if the PPH programmes were to draw to a close, applicants for Singapore patents can still rely on the existing examination procedure under Singapore patent law for an application to proceed to grant on the basis of the final examination results of a corresponding application or a corresponding patent grant, which will also go towards helping them to reduce cost and accelerate grant of their patents.