

JPO's experience in Patent Prosecution Highway

YAMAGUCHI, Toshiki (山口 俊樹)

Deputy Director

Examination Policy Planning Office

Japan Patent Office



Outline

- History of PPH
- Objectives of PPH
- Statistics seen from the JPO

History of PPH

- Initially proposed by the JPO at the 22nd Trilateral (EPO, JPO and USPTO) Conference in 2004, and the trilateral offices endorsed the proposal at the 23rd Trilateral Conference.
- Based on a bilateral agreement, the JPO and the USPTO have been operating a PPH (pilot) program since July 2006.



23rd Trilateral Conference in Munich, November 2005.

(Left to right)

Mr. Jon DUDAS, Undersecretary of Commerce for
Intellectual Property and Director of the USPTO

Mr. Alain POMPIDOU, President of the EPO

Mr. Makoto NAKAJIMA, Commissioner of the JPO

<https://link.epo.org/trilateral/2005.pdf>

https://www.jpo.go.jp/news/kokusai/nichibeiou/3kyoku_200511_munich.html

History of PPH: Global network

As of January 2023 / 2023年1月現在

PPH Participating Offices / PPH参加庁

54 Offices

GPPH Participating Offices / GPPH参加庁



JPO status report 2023
<https://www.ipo.go.jp/resources/report/statusreport/2023/document/index/all.pdf>

*The IP offices that have not commenced PPH with the JPO as of January 2023 / *2023年1月現在、日本国特許庁との間ではPPH未実施の庁

Objectives of PPH

The objectives of PPH are to:

- **Promote accelerated examination**
 - by providing accelerated examination upon simple requests
 - by facilitating early patent grants worldwide
- **Reduce examination burden**
 - by optimizing a claim scope
 - by promoting the sharing of work results between offices
 - by decreasing the number of office actions

PPH is **NOT** an agreement concerning substantive examination and therefore does **NOT affect independence of each office** in substantive examination.

Objectives of PPH: Benefits

● For Offices

- Reduced examination burden

| | PCT | PPH | Dossier Cooperation (One-portal dossier, Global dossier) |
|-----------------------------------|-------------|-------------|---|
| Type | User driven | User driven | Inter-Office cooperation |
| Referring to other office results | Yes | Yes | Yes |
| Claim correspondence obligation | No | Yes | No |
| Accelerated examination | No | Yes | No |

PPH has more **work-sharing merits** than PCT and Dossier cooperation because PPH has **claims correspondence** obligation.

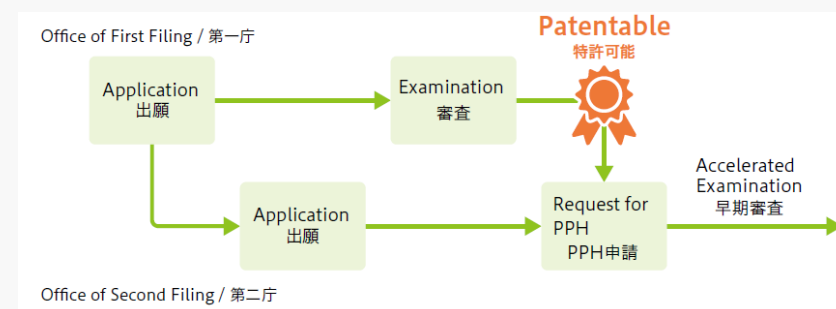
Objectives of PPH: Benefits

● For Applicants

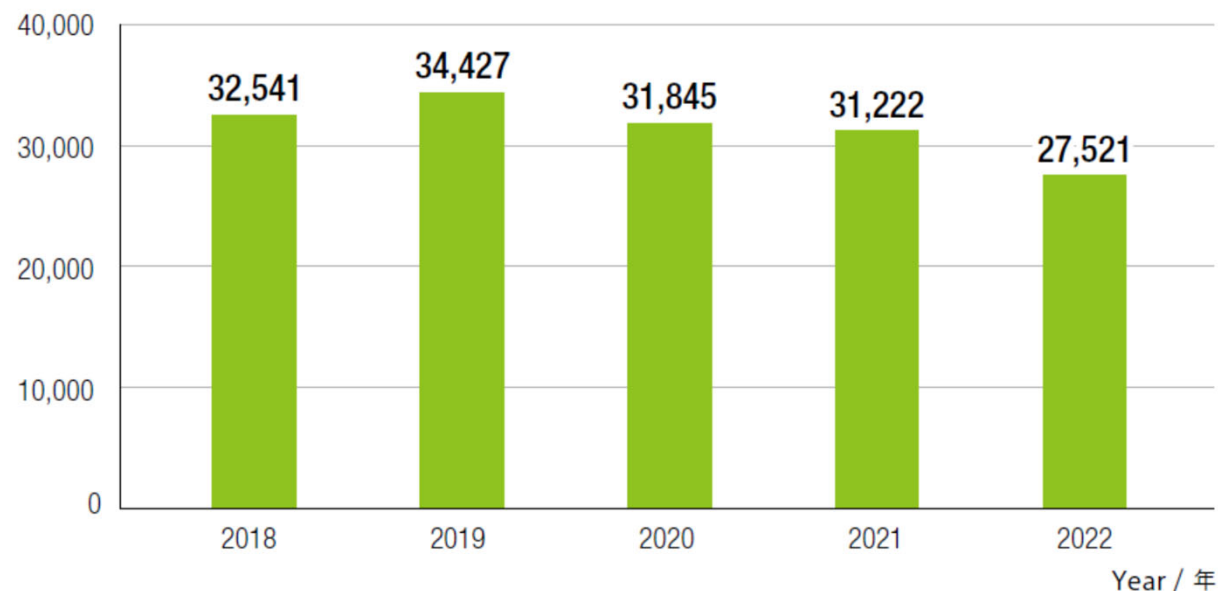
- Shorter examination period:
 - grant patent rights in a more timely manner
 - help applicants to develop business activities
- Improved examination quality
 - guarantee OLE's examination quality at least at the level of OEE

Statistics: Number of PPH applications

Number of Worldwide Patent Prosecution Highway (PPH) Applications



Number / 件



Note: • The number of applications for 2022 is the total as of March 1, 2023.

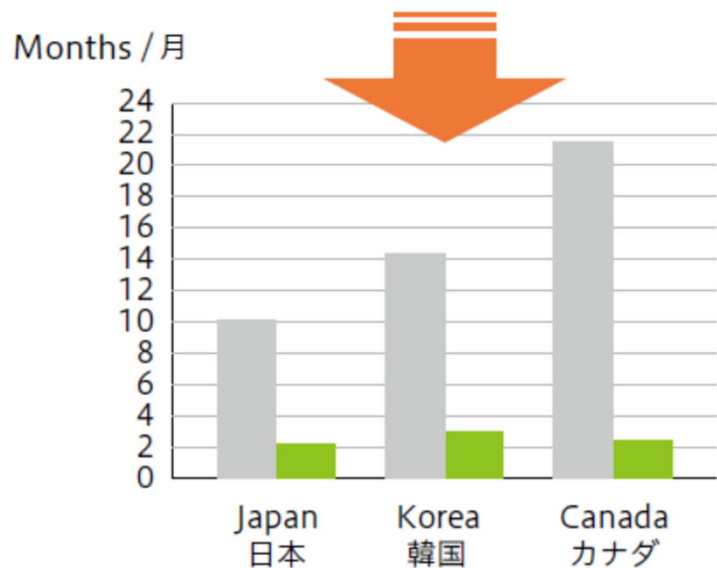
備考: • 2022 年の申請件数は、2023 年 3 月 1 日時点集計。

JPO status report 2023

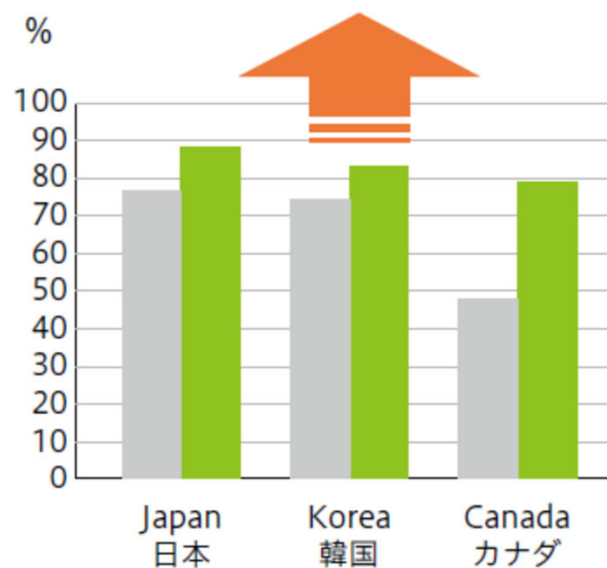
<https://www.jpo.go.jp/resources/report/statusreport/2023/document/index/all.pdf>

Statistics: Effects of PPH

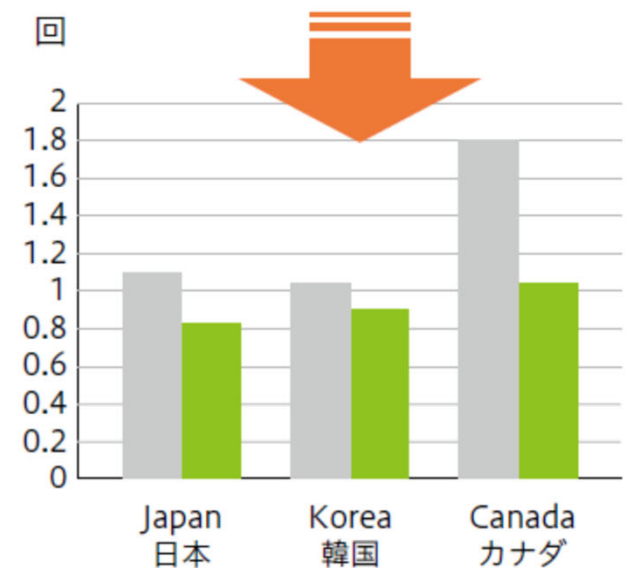
Shorter First Action Pendency
一次審査通知までの期間が短縮



Increased Grant Rate
特許査定率が上昇



Smaller Number of Negative Office Actions
拒絶理由の通知回数が減少

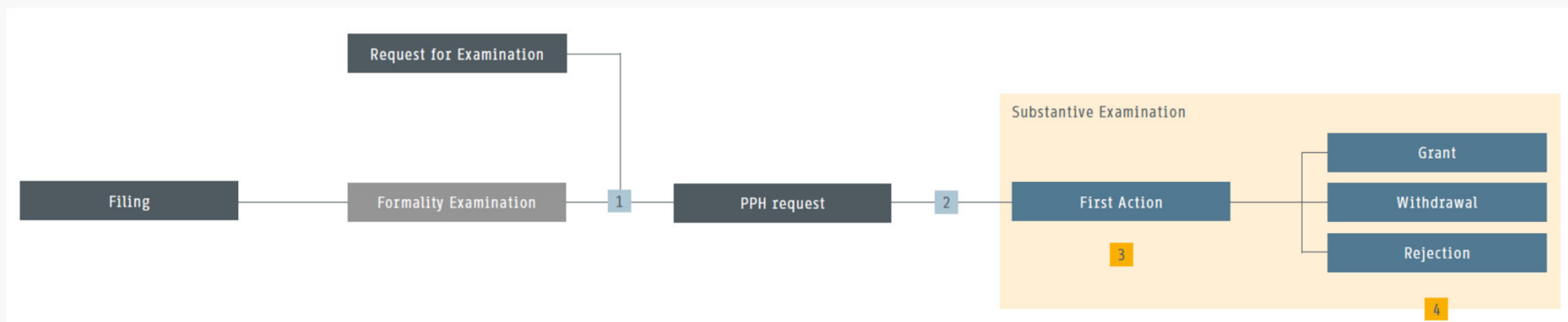


Normal Applications
全出願

PPH Applications
PPH出願

(Jan.2022 - Dec.2022)

Statistics: Pendency to first/final office action @JPO



Pendency to First Office Action

All applications

1▶ 3 10.1 months

PPH applications

2▶ 3 2.2 months

Pendency to Final Office Action

All applications

1▶ 4 14.9 months

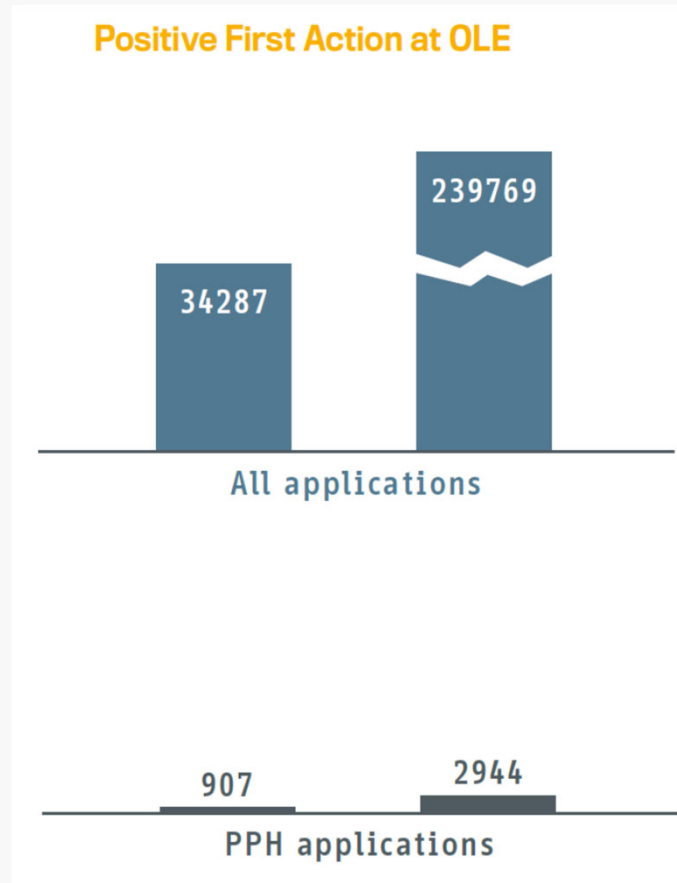
PPH applications

2▶ 4 6.3 months

IP5 PPH metrics (Reporting on calendar year 2022)

<https://www.jpo.go.jp/e/toppage/pph-portal/docs/IP5-PPH-metrics-all-offices-2022CY.pdf>

Statistics: Positive first action @JPO



For all applications: 14.3%

For PPH applications: 30.8%

Number of grants in a first substantive communication from the examiner (for PPH- and all applications)

IP5 PPH metrics (Reporting on calendar year 2022)

<https://www.jpo.go.jp/e/toppage/pph-portal/docs/IP5-PPH-metrics-all-offices-2022CY.pdf>

Further improvements to PPH

In order to improve the predictability of the timing of PPH examination, the JPO, the USPTO and the KIPO have each set target deadlines for issuing office actions for PPH applications.

- JPO and USPTO: for applications filed as from January 1, 2022
- KIPO: for applications filed as from August 1, 2023

The targets set by the JPO and the results for 2022 against those targets are as follows:

| | Target | Result (1 January to 31 December 2022) |
|---|-----------------|--|
| Average period from completion of PPH request to first office action | Within 3 months | 2.3 months |
| Average period from applicant's response to subsequent office action | Within 3 months | 1.5 months |

https://www.jpo.go.jp/e/system/patent/shinsa/soki/pph/highway_pilot_program.html

https://www.uspto.gov/sites/default/files/documents/USPTO_JPO_further_improve_PPH_June_2023.pdf

https://www.kipo.go.kr/en/HtmlApp?c=100016&catmenu=ek02_02_03

For more information

- PPH portal

<https://www.jpo.go.jp/e/toppage/pph-portal/index.html>

Various information about PPH, e.g. statistics and global network, is available.

- IP5 PPH

<https://www.fiveipoffices.org/activities/ws/ip5pph>

Information regarding IP5 PPH and its metrics is available.

Thank you all the PPH colleagues for your usual cooperation! 😊

Thank you! Merci!

