

SOUTH KOREA

Lee International IP & LAW GROUP

Navigating the Patent Prosecution Highway



By Emil Kim

The Patent Prosecution Highway (PPH) programs offer streamlined procedures for avoiding delays and costs associated with obtaining patent protection for the same invention in multiple countries. The programs in general have been touted as promoting “expeditious, inexpensive and high quality patent protection throughout the world.”

The basic principle of PPH is relatively simple: The office of first filing (OFF) is the patent office that has found at least one claim to be allowable in a patent application or an issued patent. An application in the office of second filing (OSF) validly claims priority to an application in the OFF. Finally, all the claims in the OSF application must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims determined to be patentable in the OFF.

The Korean Intellectual Property Office (KIPO) currently has PPH agreements with patent offices in Japan, the US, the Netherlands, Denmark, the UK, Canada, Finland and Germany, and has plans to enter into PPH agreements with many more countries in the future. Due to the rapid growth of such agreements, a closer examination of the benefits of the PPH program from the perspective of the applicant will be explored in more detail below.

What are the benefits?

Expedited patent protection

According to statistics provided by the KIPO, there can be no denying that a patent application in which a request is made to participate in the PPH program (PPH application) is examined faster than non-PPH applications. KIPO statistics show a significant reduction in the time to first office action for PPH applications:

Non-PPH Application: 18 months from the examination request

PPH Application: 2-3 months from the acceptance of a PPH request

Inexpensive patent protection

Through PPH programs, costs to an applicant may be saved during the prosecution of an application in the OSF. The number of office

actions, including final rejections, issued by the KIPO has been much lower for PPH applications. Further, according to KIPO statistics, the registration rate for PPH applications is 87 percent, which is more than 25 percent higher than for non-PPH applications.

By reducing the number of office actions and/or final rejections issued, the overall prosecution costs for obtaining a patent may be reduced. Such cost savings, however, will be offset by the official fee for filing a PPH request. Additionally, other potential costs, such as claim amendments, divisional applications, etc., could also make PPH programs less cost effective.

High quality patent protection

For an applicant, a high quality patent is synonymous with obtaining the most comprehensive and valid patent possible (ie. broadest scope of protection in the claims). However, due to differences in patent laws and local laws, it is very possible that the claims of the OSF, which must be limited to the claim scope allowed in the OFF, will be narrower than if the application was prosecuted separately. In such cases, it may be necessary for the applicant to file a divisional application for the original claims to pursue the broadest scope of protection that can be granted in the OSF.

Do the pros outweigh the cons?

It is clear that PPH programs are not yet the panacea that applicants have been seeking. Further advancements in the programs are required in order to truly increase participation from applicants worldwide. In the meantime, however, there are strategic approaches that can be taken to maximise the advantages that are currently offered under the PPH programs and to mitigate the potential disadvantages and pitfalls. Such strategies include identifying eligible pairs of OFF and OSF applications; choosing an optimal OFF or OSF for a pair of applications; globally managing patent prosecution timelines; and identifying claim formats that are suitable for both the OFF and OSF.

Emil Kim – Foreign Legal Consultant
Lee International IP & Law Group

(리인터내셔널 법률사무소)

14F Kukdong Bldg., Chungmuro 3-Ka

Chung-Ku, Seoul 100-705, Korea

Tel: 82-2-2262-6046

Email: ekim@leeinternational.com

www.leeinternational.com