



Patent Prosecution Update – September 2011

US Patent and Trademark Office to Pilot a New Patent Prosecution Highway with the Taiwanese Intellectual Property Office

The United States Patent and Trademark Office (U.S. Patent Office) and the Taiwanese Intellectual Property Office (TIPO) have announced the opening of a Patent Prosecution Highway (PPH) between the two offices through a pilot program extending between September 1, 2011 and August 31, 2012. A PPH allows an applicant who has filed a patent application and received an allowance in a first office (commonly referred to as an Office of First Filing or OFF) to request fast-track examination in a second office (commonly referred to as an Office of Second Filing or OSF).

Under this program, an applicant who has filed a first patent application for examination by the U.S. Patent Office and a second application, which claims priority to the first, for examination by the TIPO can make use of the PPH by requesting expedited examination in Taiwan after the receipt of an allowance of the first application in the U.S. Similarly, an applicant who has filed first in Taiwan can use an allowance of the Taiwanese claims to request fast track examination of a second filed U.S. patent application that claims benefit of the first-filed Taiwanese application. Fast-track examination should occur within 90 days of the filing of the request, so long as all documents are provided to the OSF together with a description of how the claims allowed by the OFF correspond to the pending claims in the OSF. This agreement between the U.S. Patent Office and the TIPO is particularly significant as Taiwan is not a signatory to the Paris Convention or the Patent Cooperation Treaty.

The U.S. Patent Office currently has PPHs available between itself and each of Australia, Austria, Canada, Denmark, the European Patent Office, Finland, Germany, Hungary, Israel, Japan, Korea, Mexico, the Nordic Patent Institute, Russia, Singapore, Spain, Sweden, and the United Kingdom. With the addition of Taiwan, there are now 19 international patent offices through which fast-track examination can be requested.

There is also a PPH-PCT program which allows an applicant to use a favorable Written Opinion or International Preliminary Report on Patentability to request fast-track examination in a national or regional phase application. Currently, the U.S. Patent Office participates with ten other patent offices (Australia, Austria, European Patent Office, Spain, Finland, Japan, Korea, Russia, Sweden, and the Nordic Patent Institute) using this program. The United Kingdom is not apart of any PPH-PCT, however the United Kingdom Patent Office allows applicants to request accelerated examination in any U.K. national phase application based upon a favorable results during the PCT stage.

Additionally, the U.S. Patent Office announced another enhancement to the PPH program this past summer. Only eight overseas patent offices are participating in this enhanced program, which relies on work product from offices of earlier filing ("OEF"). These offices include the patent offices of Australia, Canada, Finland, Federal Service on IP, Japan, Russia, Spain and the United Kingdom. Under this program, an applicant receiving a favorable result from any of these offices may request fast-track examination in a corresponding U.S. patent application

You should consider using the PPH process if you are interested in expedited patent prosecution for your inventions outside the U.S. Favorable results obtained in a U.S. (or international) patent application can be effectively used to obtain claims of corresponding scope quickly in other countries, in accordance with local requirements and at reduced cost.

Our Patent Law Group

As patent laws and the rights of patent holders and applicants continue to evolve as a result of court decisions and legislative initiatives, the protection and exploitation of this valuable intellectual property remains more important than ever to companies of all types. Our Patent Law Group represents clients in all of their patent needs, from litigation and dispute resolution to patent applications and contested patent office proceedings to transactions and strategic counseling, allowing them to maximize revenue, market position and shareholder value while retaining and growing their core assets.

For more information regarding PPHs or questions regarding the applicability of a PPH program for one of your patent applications, please contact Joseph Capraro, Kristin Neuman, or any other member of Proskauer's IP Practice Group:

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