

PPH at the EPO: the highway to... nowhere?

The Patent Prosecution Highway (PPH) between the US Patent and Trade Mark Office (USPTO) and the European Patent Office (EPO) allows applicants to accelerate their European patent applications, if they already have allowable claims in a corresponding US application. But is the PPH the best way to accelerate a European application?

Claim correspondence

To use the PPH, the applicants must amend their European claims so that they have the same or narrower scope as the allowable US claims. The claims cannot be broader than the US claims are not and must be in the same category.

Therefore they cannot always amend the European application to suit European law and practice, if that would contravene these requirements. The resulting patent can have a less than ideal scope of protection, and can be difficult to enforce in Europe.

Another problem is that the cited prior art can differ in the US and Europe. The applicants might need to amend their US claims to avoid a document that is not relevant in Europe. Amending their European claims to correspond to the US ones would result in unnecessarily narrow European claims.

What does the PPH give the applicant?

If applicants use the PPH, the EPO puts the application on its accelerated prosecution scheme (PACE).

Once in PACE, the EPO will speed its prosecution process. However it will subject the application to the same full examination as all European applications.

The EPO does not assume that the application is allowable because of US allowance. As a result, PPH does not normally result in a cost saving.

What is the alternative?

Applicants can request PACE can be requested on any European application, at any time (PPH can only be requested before examination). The applicants do not need to use PPH to take advantage of PACE scheme.

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To make a direct PACE request the applicants merely file a simple form or letter. They do not have to pay any official fees, nor collate or file any details of office actions or prior art from elsewhere. The PPH requires the applicants to pay a fee and collate and file a number of documents from the US prosecution.

The applicant can make any amendments under European patent law and practice.

A direct PACE request results in the same speed of prosecution as a successful PPH request, but at a lower cost and with greater flexibility.

When might PPH be useful?

There are some foreseeable circumstances in which PPH may be advantageous over a direct PACE request. In particular, if the applicant wants the EPO to take into consideration the prosecution of the US case, but the US application has not yet reached publication - so the official file cannot therefore be seen by the EPO - a PPH request will provide the relevant parts of the US file to the EPO examining division.

Conclusion

When compared with a direct PACE request, the PPH at the EPO has numerous disadvantages. PACE is less expensive, less burdensome, and more flexible. We recommend that applicants, wishing to speed prosecution of their European patent application, use PACE.