

Patent Prosecution Highway – The IP Bridge between India and Japan

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A Patent Prosecution Highway (PPH) is an examination cooperation programme for patent applications between the patent offices of two countries. It allows a patent applicant to request an accelerated examination of its application pending before the second office or office of later examination (OLE) if a corresponding application has been found to be patentable by the first office or office of earlier examination (OEE). It benefits both the patent applicants and also the respective patent offices. Faster patent grants are made under [PPH programmes](#), resulting in higher grant rates. PPHs reduce the workload on patent offices and enhance examination quality.

Japan is a key trading partner for India.. Japan's bilateral trade with India was worth USD17.63 billion in the financial year 2018—2019. Exports from Japan to India during this period totalled USD12.77 billion and imports USD 4.85 billion. From 2000 to 2020, Japanese investment in India was valued at USD32 billion, primarily in the automobile, electrical equipment, telecommunication, chemical and pharmaceutical sectors. The number of Japanese companies registered in India has consistently increased. The number of Indian companies operating in Japan has also multiplied considerably.



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In 2019, the government approved the recommendations of the Office of the Controller General of Patents, Designs and Trade Marks, generally known as the Indian Patent Office (IPO), to establish PPH programmes with the patent offices of other countries. This resulted in the first PPH programme being set up between the Japan Patent Office (JPO) and the IPO for an initial period of three years from November 2019. Expedited prosecutions of patent applications are allowed by each patent office based on the allowed and granted Patents by the other.

The number of PPH requests is currently limited to 100 cases per year for each office. An applicant acting either alone or jointly is allowed to apply for a maximum of 10 PPH cases in any one year. The IPO has received 100 cases so far with 56 being allowed. The IPO accepts PPH requests only for the technical fields of electrics, electronics, computer software, information technology, physics, civil and mechanical engineering, textiles, automobiles and metallurgy.

A number of requirements have to be met before the respective patent offices will grant a request for an accelerated examination under the PPH. The first requirement is that both the OLE application on which PPH is requested and the OEE corresponding application forming the basis of the PPH request must have the same earliest date, being either a priority date or a filing date. The following cases illustrate this requirement.

- Case 1. An OLE application which claims priority under the Paris Convention from the OEE application;
- Case 2. An OLE application which provides the basis of a valid priority claim under the Paris Convention for the OEE application;
- Case 3. An OLE application which shares a common priority document with the OEE application, including Patent Cooperation Treaty (PCT) national phase applications, and
- Case 4. A PCT national phase application where both the IPO and the JPO applications are derived from a common PCT international application having no priority claim.

The second requirement is that there must be at least one corresponding application in the OEE with one or more claims that are determined to be patentable and allowable by that OEE. The third requirement is that all claims originally filed or as amended for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable and patentable in the OEE.

Applications to the IPO for accelerated examination under the PPH must be accompanied by copies of office actions of the corresponding applications with the JPO, copies of patent references cited by the JPO and copies of granted claims of the corresponding application. All documents must be accompanied by verified English translations.

A PPH may turn out to be an effective way to encourage innovation and the commercialisation of new patented technology in the participating countries. The PPH between the Indian and Japanese patent offices is an excellent example to follow when the programme is extended to other countries.

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