



IF YOU HAVE A PATENT APPLICATION IN THE UNITED STATES PATENT AND TRADEMARK OFFICE THAT HAS BEEN, OR IS ABOUT TO BE GRANTED, AND YOU HAVE AN UNEXAMINED CORRESPONDING APPLICATION PENDING ABROAD — JAPAN, THE UNITED KINGDOM, EUROPE OR OTHER SELECT COUNTRIES — YOU SHOULD CONSIDER GETTING ON THE PATENT PROSECUTION HIGHWAY. IT COULD BE THE FAST AND CHEAP EXPRESSWAY TO PATENTABILITY.

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The Patent Prosecution Highway is a program that allows an applicant to fast track the examination of a patent application by allowing information to be shared between the participating patent offices. How does it work? The Patent Prosecution Highway enables an applicant whose claims are determined to be allowable in one country to have a corresponding application in another country advanced out of turn for examination.

Often an application is first filed in the patent office of one country, then a corresponding application is filed in the patent office of a second country. Let's call the patent office that receives the first application the Office of First Filing (OFF), and the patent office that receives the later application the Office of Second Filing (OSF). On the Patent Prosecution Highway, the examination process in the OSF is accelerated by allowing the OSF to rely on the search and examination results of the OFF.

The way things work now is, if, for example, you file an application in the United States (*i.e.* the OFF) and a counterpart application in another country, such as Japan (*i.e.* the OSF), there will be substantial redundancy in the prosecution of the two applications. Because the U.S. Patent Office and the Japan Patent Office will examine the applications according to different standards of patentability, each office will conduct its own search and examination, which can result in largely duplicative and redundant efforts.

The Patent Prosecution Highway reduces duplication and redundancy by allowing the OSF to rely in part on the work of the OFF. In our example, this saves resources because the Japan Patent Office can use the search results of the U.S. Patent Office as a jumping-off point for its own patentability search.

If you have a patent that has issued (or is about to issue) by the U.S. Patent Office, you should check the status of your corresponding application in the OSF of a country that participates in the Patent Prosecution Highway program. If the corresponding patent application in the participating country is not yet examined, you can accelerate its examination by getting on the Patent Prosecution Highway. To do this, a request must be made to accelerate prosecution under the Patent Prosecution Highway program, while at the same time the claims of the OSF application must be amended to conform with the claims allowed by the U.S. Patent Office. The OSF application will then be moved to the head of the examination queue and examined out of turn. Though the claims will not be "rubber-stamped" by the OSF in the participating country, the claims may be treated more favorably because it will rely on the search and examination results of the U.S. Patent Office which granted the claims.

For more information, contact our firm at [Trojan@patenttrademark.com](mailto:Trojan@patenttrademark.com) and we'll put you on the Patent Prosecution Highway.

