

Global Patent Prosecution Highway – NZ & Australia

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What is the GPPH?

The GPPH (Global Patent Prosecution Highway) is an examination regime by which a patent application that has already been examined and had a claim allowed by a patent office in one GPPH country can be used to expedite examination of corresponding applications filed with other GPPH countries.

The idea is to reduce patent examiners' workloads and backlogs by allowing them to duplicate the efforts of the original examiner rather than conduct their own examination.

The Intellectual Property Office of New Zealand (IPONZ) and IP Australia are two of the 22 patent offices around the world that are participants in the GPPH. Others include the patent offices of Canada, Japan, the United States, and the United Kingdom.

Benefits of the GPPH for Applicants

A timely, favourable examination report from a patent office in one country could give greater confidence in filing patent applications, or proceeding with examination of existing patent applications, in other countries under the GPPH.

Also, requesting accelerated examination of patent applications under the GPPH is likely to mean reduced prosecution costs overall as well as patent rights being granted sooner.

Risks of using the GPPH

There are also some risks that need to be carefully considered before using the GPPH. For example, each country applies its own standards for patentable subject matter. This means that, in one country, the scope of the allowed claims may be narrower than might be considered allowable in another country (if allowable at all).

As the claims of the examined application in one country and those of the application to be examined under the GPPH in another country need to substantially correspond to each other, this could mean, in jurisdictions having a lower standard of patentability, settling for narrower protection than could otherwise be obtained.

Additionally, expediting examination in GPPH countries is likely to result in prosecution, acceptance, and grant costs being incurred sooner than if relying on the normal examination routes. If intending to use the GPPH, applicants will need to consider the likely impact on their cashflow.

Procedure

Examination must be requested in order to have the application processed under the GPPH.

There are also certain criteria that must be met:

- At least one claim of the examined application must have been deemed patentable by a GPPH patent office;
- At least one claim of the examined patent application must substantially correspond to those of the application for which examination under the GPPH is desired; and
- Both applications must also share the same priority date and applicant/inventor.

Although neither IPONZ nor IP Australia charge extra fees for examination under the GPPH, extra forms and documentation are required.

These include:

1. Copies of examination reports that confirm patentability of at least one claim in the examined application;
2. The claims corresponding to those deemed allowable in another country. It may be necessary to enter claim amendments to achieve this correspondence; and
3. A table showing how the filed claims correspond to those deemed allowable in another country.

Strategies for using the GPPH

Compared to most of the other patent offices taking part in the GPPH, IPONZ has a relatively small examination backlog. An examination report will typically issue from IPONZ within three to six months of requesting examination. This turnaround time is much quicker than most other patent offices.

An examination report from IP Australia will usually issue within 12 months of requesting examination.

Local applicants should seek to complete their provisional applications early, or file a complete specification in the first instance, and request examination. The feedback from the examiner can then determine whether overseas applications should be filed. A favourable opinion from the original examiner can form the basis of a request for examination for any applications filed in countries participating in the GPPH.

Overseas applicants should consider requesting examination in New Zealand and/or Australia early. Once a favourable examination report has issued they can request examination of their other patent applications under the GPPH. The prosecution of these applications would then be expedited.

If an overseas application has already been examined by a GPPH patent office, then examination of the corresponding New Zealand / Australian applications should be requested under the GPPH. An examination report will then quickly issue, typically within weeks.

All going well, there are likely to be fewer substantive issues that need to be considered, as these will have been dealt with on the original examined application.

Summary

The GPPH is a process that helps streamline the examination process for patent applications filed with participant patent offices. Based on advice from one GPPH patent office that at least one claim of a corresponding application that has been examined is patentable, examination can be accelerated in another country. This can lead to cost savings and a quicker grant of rights of patent applications.

Although simple to use, care still must be taken to ensure that the claims are not being unduly limited by relying on patentability criteria that are not applicable under another country's patent law.

Seek professional advice if you are uncertain whether examination of your application under the GPPH is appropriate.