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## A SCHEME FOR MAXIMISING THE BENEFITS AVAILABLE UNDER THE PATENT PROSECUTION HIGHWAY (PPH)

### SUMMARY

- File in Australia first;
- Request expedited examination (report issues within 3 months);
- Address objections and obtain acceptance;
- File in USA and request entry to PPH (faster and fewer office actions);
- File PCT designating EPO as ISA;
- Amend claims for best possible prosecution based on results from AU, US and EP.

### EXPLANATION

The PPH aims to accelerate examination in an office of second filing (OSF) based on the outcome of examination in an office of first filing (OFF). To take maximum advantage of PPH an allowance should be obtained as early as possible in the OFF and then a request to use the PPH made in the OSF, together with a claim table showing correlation between the OSF claims and the allowed claims.

The PPH has best advantage when a quick allowance is possible in the OFF. Australia affords this opportunity through the expedited examination procedure. At the time of filing an Australian patent application it is permissible to voluntarily request examination and pay the examination fee. At the same time the examination can be expedited by a request with a simple justifying reason. A suitable reason may be, "The Applicant is entering a competitive market and seeks early determination of validity". If expedited examination is granted (and it almost always is) an examination report will issue within three months. A diligent and comprehensive response can lead to allowance of the application within 6 months of filing.

Once allowance is obtained a corresponding application can be made in USA together with a request to use the PPH. The main requirement is that the claims in the US application correlate with the allowed claims from Australia. Statistics show that the first office action on a PPH case issues up to a year earlier than a non-PPH cases and on average a PPH case receives about one less office action than a non-PPH case.

If the Applicant is seeking protection in a number of countries it is sensible to use the PCT system. The PCT application could designate the EPO as the searching authority, thus providing a third independent view on the validity of the claims. Article 34 claim amendments can be made to obtain a clear IPRP. This would virtually guarantee the patent issuing in Europe, together with the patent having issued in Australia and probably being close to issuance in USA. With this level of testing of the claims it can be reasonably expected that the claims are valid and likely to be defensible in any court action.

For clients who have a definite interest in Australia the scheme provides a very strong outcome without any additional total cost. In fact, there will be cost savings overall.

### CONTACT US

For more information on maximising the benefits available under the Patent Prosecution Highway (PPH), **email us at - [mail@fak.com.au](mailto:mail@fak.com.au) or call +61 7 3229 2655.**

#### PATENTS

#### TRADE MARKS

#### DESIGNS

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