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Intellectual Property Alert: Patent Prosecution Highway in India and Brazil

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In an increasingly globalized economy, companies and other innovators pursue patent protection in foreign jurisdictions across the globe to protect their intellectual property. To fast track their patents in strategic markets, companies can successfully leverage Patent Prosecution Highway (PPH) programs. Briefly, bilateral PPH programs allow an Applicant to expedite patent examination in one jurisdiction based on approval of at least one patent claim by the patent office of another jurisdiction, as long as there is a PPH agreement between the two jurisdictions. PPH programs have led to shorter patent pendency times and an increase in the number of issued patents. Responding to this success, the number of PPH agreements continues to grow.

Recently, Brazil and India, both top ten largest world economies and common targets for patent filings, have made changes to their PPH programs to increase the speed at which patents are issued. This is good news for innovators, as a decade-long wait for a patent is not unusual in Brazil, and average wait times in India are averaging between 4 and 6 years.

India

In September of this year, India amended its Patent Rules to fast-track international patent applications filed pursuant to an agreement between the Indian Patent Office and other participating patent offices. This legislative change allows India's first PPH agreement, signed between Japan and India in late 2018, to move forward. Currently, Japan is the only country with a PPH agreement with India. Japan, the source of more foreign patent applications filed at the Indian Patent Office than any other Asian country, had previously pressured India to address a backlog at the Indian Patent Office, saying the long wait time for patents was hampering economic relations between the countries.

The Japan-India PPH program began taking requests December 5, 2019, and will run for three years. Only 100 requests will be accepted per

year in each office, and India has imposed an additional limitation of 10 requests per year per applicant. This annual limit will be reconsidered after March 31, 2020.

Because the US has not yet signed an agreement with India, US applicants interested in obtaining an Indian patent might consider filing in Japan to speed the examination of a corresponding Indian application. Strategic filing practices such as these may lead to shorter wait times for patents.

Brazil

New regulations from Brazil's patent office, INPI, came into effect on December 1, 2019, following an October resolution that consolidated the rules and procedures of current PPH pilot programs. Perhaps most importantly, the technological field limitation of current PPH programs has been lifted, allowing applications from any International Patent Classification (IPC) to benefit from the new, unified PPH program. Pharmaceutical applications, which previously did not qualify, are no longer excluded from the fast track program in Brazil.

To ensure that US patent applicants can avail themselves of the revised PPH programs in Brazil, the US recently signed an updated PPH program agreement to incorporate Brazil's changes. The current PPH program with Brazil terminates on November 30, 2024.

To participate in Brazil's new PPH program, several criteria must be met, including that substantive examination cannot have already commenced, and applications must either have been filed for 18 months, have had early publication requested, or have been published by the World Intellectual Property Organization.

Conclusion

PPH programs may not always be the best option for seeking protection in foreign jurisdictions, such as India and Brazil. When considering whether to use a PPH program or file traditionally, applicants should evaluate the importance of the patent to their business model and how the patent will be leveraged, identify critical jurisdictions that require protection, and consider the scope of the patent and cost limitations, among other factors.