



Titikaan Ungbhakorn
Attorney-at-Law
titikaan.u@tilleke.com

Update: Thailand–Japan Patent Prosecution Highway Pilot Program Extended

In the [August 2015 edition of *Informed Counsel*](#), we discussed Thailand’s Patent Prosecution Highway Pilot Program (PPH Pilot Program), in which the Department of Intellectual Property (DIP) and the Japanese Patent Office (JPO) collaborated to accelerate the patent examination process of Thai applications based on prior Japanese applications.

The PPH Pilot Program was due to expire in December 2015, and there were expectations that the program would be extended if it was deemed to be successful. As the PPH Pilot Program was found to be effective, the DIP and the JPO have now agreed to continue the PPH Pilot Program for two more years, from January 1, 2016, onward.

Under the PPH Pilot Program, an applicant who has filed a patent application in Japan can accelerate the substantive examination of their counterpart application in Thailand by utilizing the examination results issued in the Japanese application. The first official communication from the Thai Patent Office, either in the form of an Office Action or a Notification requesting payment of the registration fee, can be expected within approximately six months from the

date the request for a substantive examination under the PPH Pilot Program was filed.

According to the [JPO’s website](#), as of June 2015, 96 patent applications were filed using the PPH Pilot Program, compared to 58 applications as of December 2014. And in our practice, we are seeing even greater interest in this process. In the first quarter of 2016 alone, Tilleke & Gibbins filed 20 new requests to use the fast-track procedure. Based on these statistics, Japanese applicants are increasingly recognizing and using the PPH Pilot Program.

To date, 35 patent applications filed under the PPH Pilot Program have received a notification requesting payment of the registration fee. The time frame for receiving these notifications has varied widely—from 1 month in the quickest case to 21 months in the longest—with the average being 8.4 months. Among the 64 pending cases, 10 cases received their first Office Action within an average of 7.9 months.

Overall, the fast-track procedure moderately accelerates the substantive examination of Thai applications. The time to receive the notification requesting payment of the registration fee has been shortened from 3-4 years to an average of 8.4 months from the date of submission of the request for a substantive examination, along with voluntary amendment of the claims to conform to the granted claims of the corresponding patent.

Although the process has been accelerated, there are some major obstacles to the fast-track procedure, including Thailand’s limited number of examiners and the Thai Patent Office’s internal procedures. As a result, a number of applications under the PPH Pilot Program are still pending, which have not yet received any official communication from the Patent Office.

Once these issues are rectified, the fast-track procedure will benefit from greater efficiency, and it would be used to a greater extent. We will update our readers on important developments in the PPH Pilot Program in future editions of *Informed Counsel*. 🍻