

# **Procedures to file a request to the UK IPO for Patent Prosecution Highway Pilot Program between the UK IPO and the USPTO**

## **Request to the UK IPO**

[0001] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the UK IPO by submitting a letter requesting accelerated examination under the PPH accompanied by the relevant supporting documents including a completed PPH request form. The requirements for an application to the UK IPO for accelerated examination under the PPH are given in the following section. Relevant supporting documentation is discussed in a later section (paragraphs [0003]-[0006]) as is the general UK IPO application procedure (paragraphs [0007]-[0008]).

## **Requirements for requesting accelerated examination under the PPH pilot program at the UK IPO**

[0002] There are four requirements for requesting accelerated examination under the PPH pilot program at the UK IPO. These are:

- a) Both the UK IPO application on which PPH is requested and the USPTO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).  
For example, the UK IPO application (including PCT national phase application) may be:
  - (Case I) an application which validly claims priority under the Paris Convention from the USPTO application(s) (for examples see Annex 1, figures A, B, C and D); or
  - (Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the USPTO application(s) (including PCT national phase application(s)) (see Annex 1, figures E, F and G); or
  - (Case III) an application which shares a common priority document with the USPTO application(s) (including PCT national phase application(s)) (see Annex 1, figures H, I, J, K and L); or
  - (Case IV) a PCT national phase application where both the UK IPO application and the USPTO application(s) are derived from a common PCT international application having no priority claim (see Annex 1, figure M).
- b) At least one corresponding USPTO application has one or more claims that are determined to be patentable by the USPTO.
- c) All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO. Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the UK IPO are of the

same or similar scope as the claims in the USPTO, or the claims in the UK IPO are narrower in scope than the claims in the USPTO.

In this regard, a claim that is narrower in scope occurs when an USPTO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims).

A claim in the UK IPO which introduces a new/different category of claims to those claims indicated as allowable in the USPTO is not considered to sufficiently correspond. For example, where the USPTO claims only contain claims to a process of manufacturing a product, then the claims in the UK IPO are not considered to sufficiently correspond if the UK IPO claims introduce product claims that are dependent on the corresponding process claims.

d) The UK IPO has not begun examination of the application.

### **Required documents for accelerated examination under the PPH pilot program at the UK IPO**

**[0003]** The following documentation will be needed to support a request for accelerated examination under the PPH pilot program at the UK IPO:

a) a copy of the office action(s) on the corresponding USPTO application(s). The applicant can either provide these with the request for acceleration under the PPH or request that the UK IPO obtain the documents required from the USPTO.

b) a copy of the claims examined by the USPTO and copies of subsequent amended claims found to be patentable by the USPTO where appropriate. The applicant can either provide these with the request for acceleration under the PPH or request that the UK IPO obtain the documents required from the USPTO.

c) a completed claim correspondence table showing the relationship between the claims of the UK IPO application for accelerated examination under the PPH and the claims of the corresponding USPTO application considered patentable by the USPTO. Sufficient correspondence of claims occurs where the claims are of the same or similar scope.

**[0004]** The relevant information is obtained from the applicant by filling in a form for requesting accelerated examination under the PPH pilot program (as given in Annex 2) which is available for download from the UK IPO website. The form should be sent to the UK IPO along with a letter requesting acceleration under the PPH and the relevant supporting documentation.

**[0005]** Copies of the patent documents cited by the USPTO will not be needed where the documents are available via EPOQUE. The UK IPO Examiner may request translation of citations using the standard UK examination procedure where translation of a cited document is necessary. However, applicants may file translations as part of the

supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the citations if they so desire.

**[0006]** The applicant need not provide further copies of documentation if they have already submitted the documents noted above to the UK IPO through simultaneous or past procedures.

### **Procedure for accelerated examination under the PPH pilot program at the UK IPO**

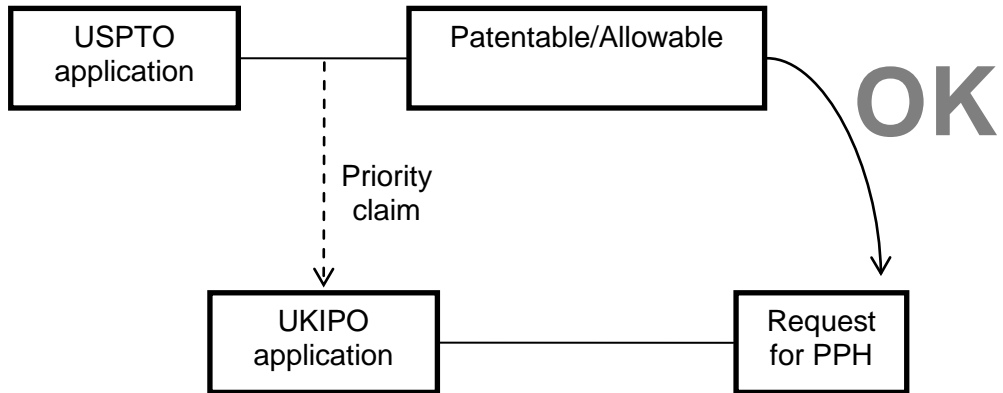
**[0007]** The applicant files a letter requesting accelerated examination under the PPH pilot program to the UK IPO, including the relevant supporting documents as noted above and a completed PPH request form (as given at Annex 2 and also available online at [www.ipo.gov.uk](http://www.ipo.gov.uk)). The application for accelerated examination may be made by email or normal mail but must include a completed PPH request form. The PPH request form should be the uppermost document when applying for accelerated examination by conventional mail to ensure that the request is correctly processed.

**[0008]** The PPH administrator, who will be a UK IPO patent Examiner, will consider the request and if all requirements are met the PPH administrator will notify the relevant examining group. The Examiner will conduct the accelerated examination.

**ANNEX 1:EXAMPLES OF ELIGIBLE PRIORITY  
RELATIONSHIPS**

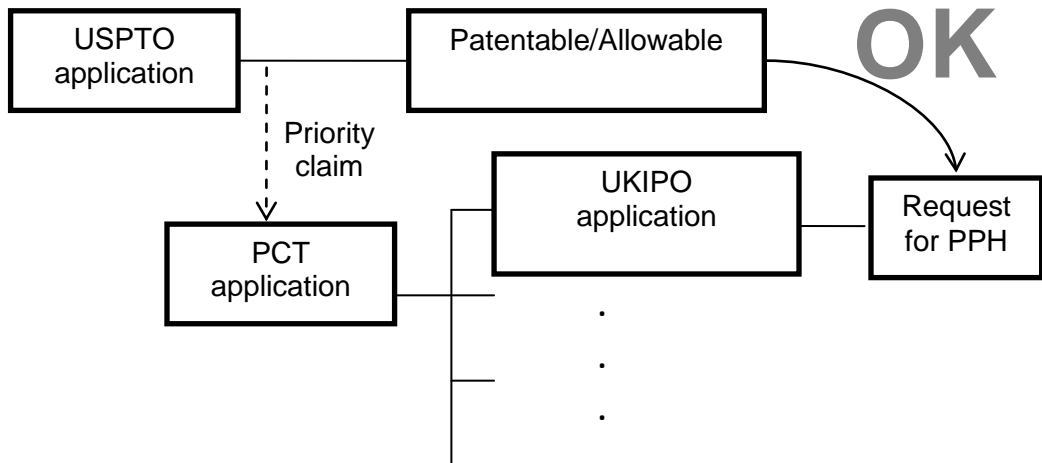
A

(Case I)  
- Paris route -



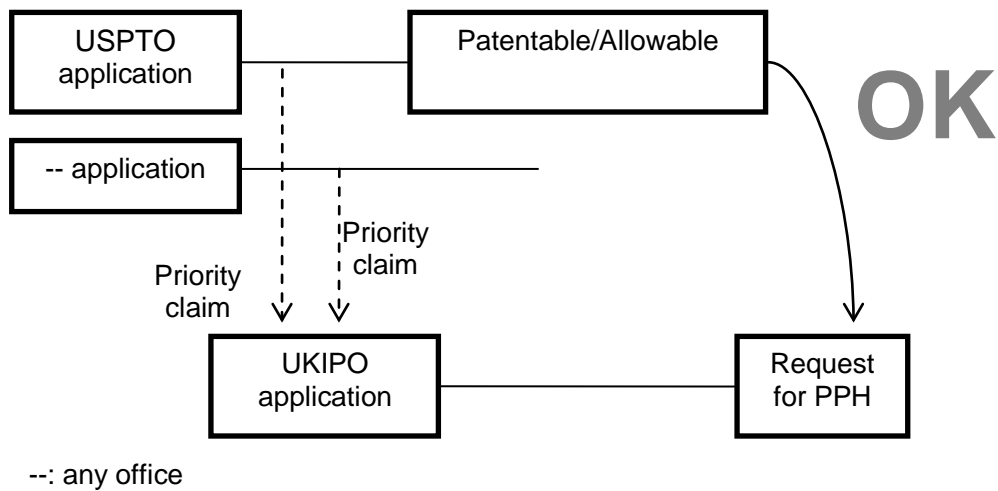
B

(Case I)  
- PCT route -



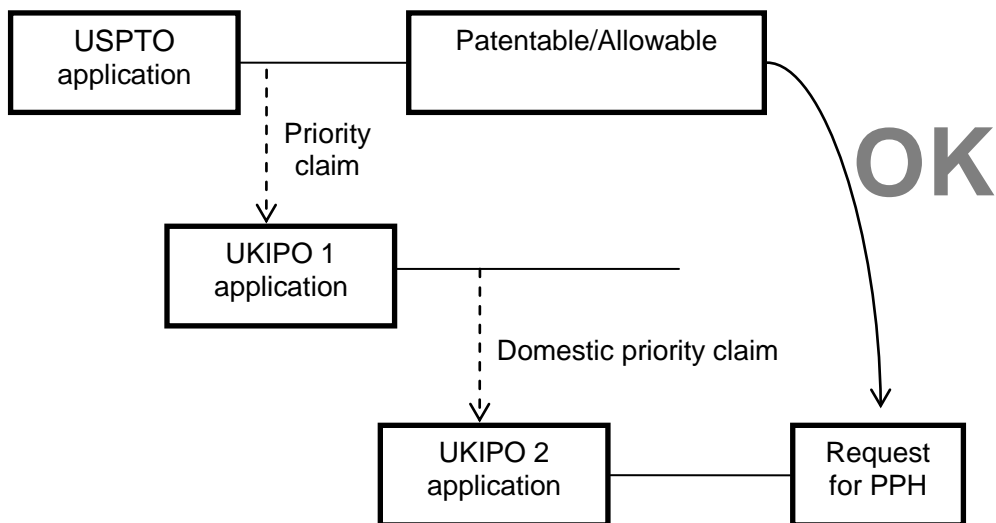
C

(Case I)  
- Paris route & Complex priority -



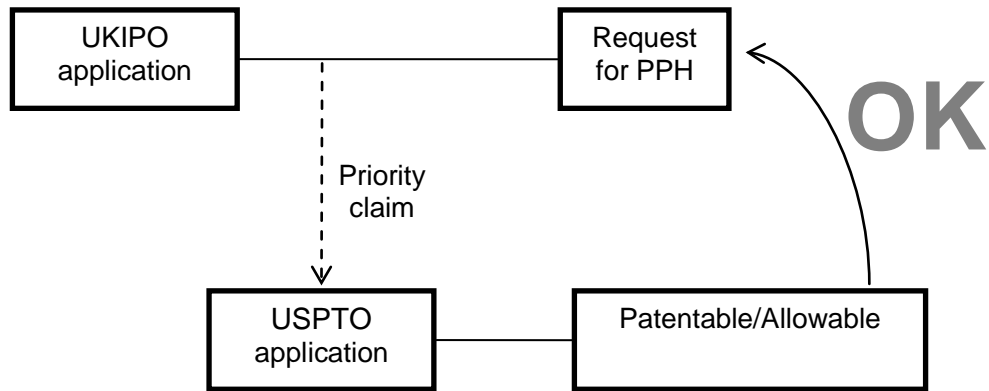
D

(Case I)  
- Paris route & continuing application -



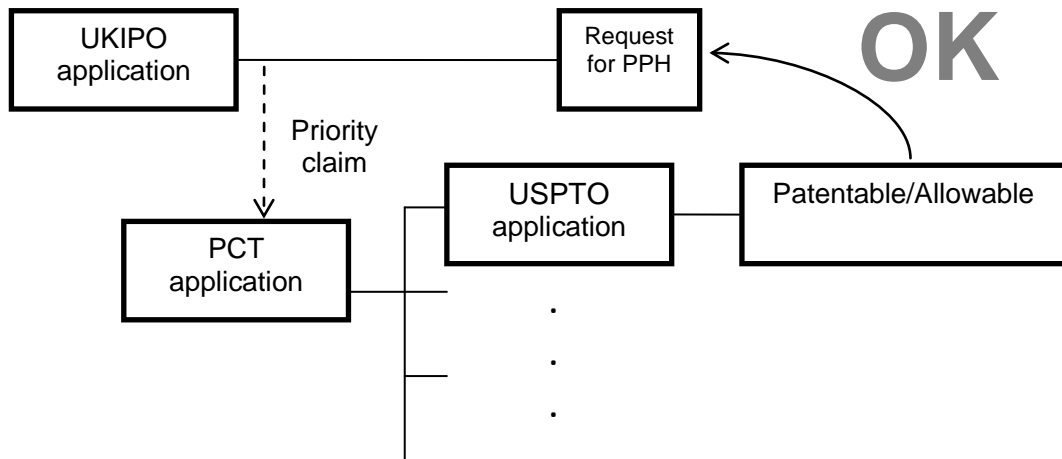
**E**

(Case II)  
- Paris route -



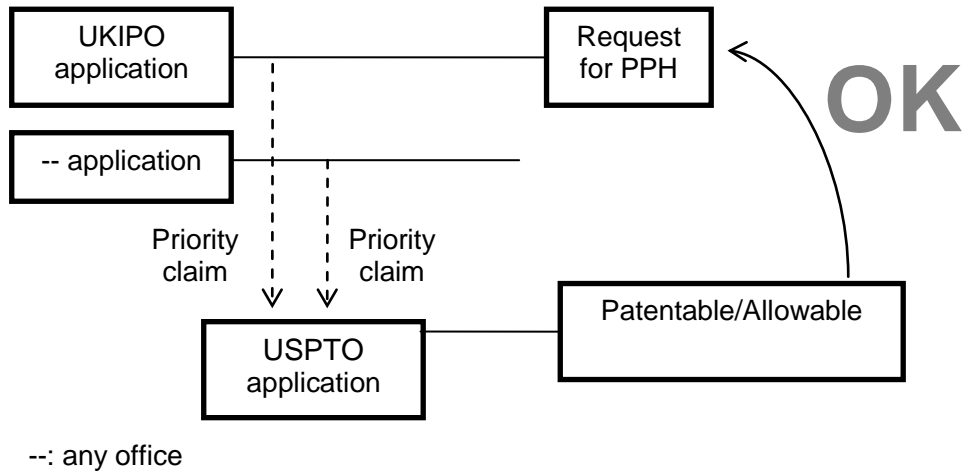
**F**

(Case II)  
- PCT route -



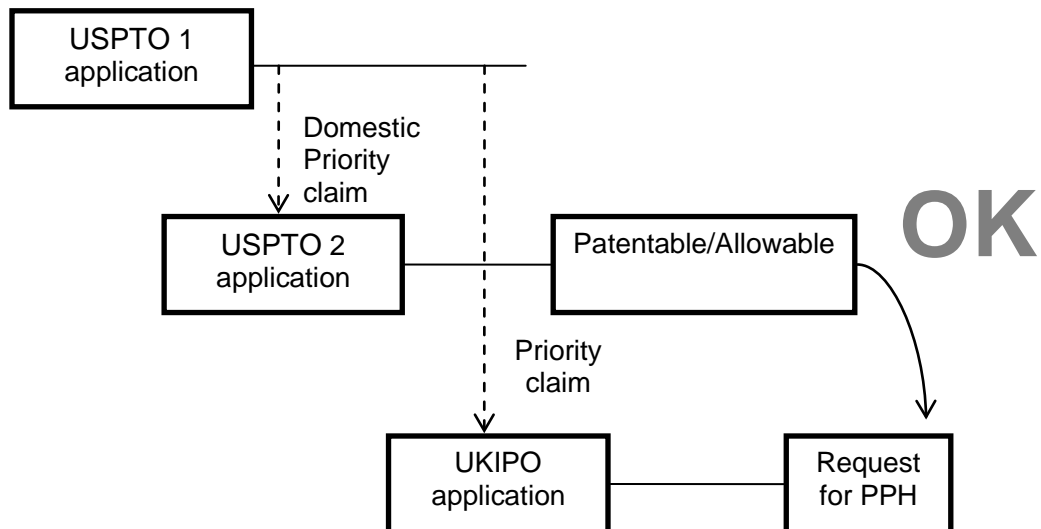
G

(Case II)  
- Paris route & Complex priority -



H

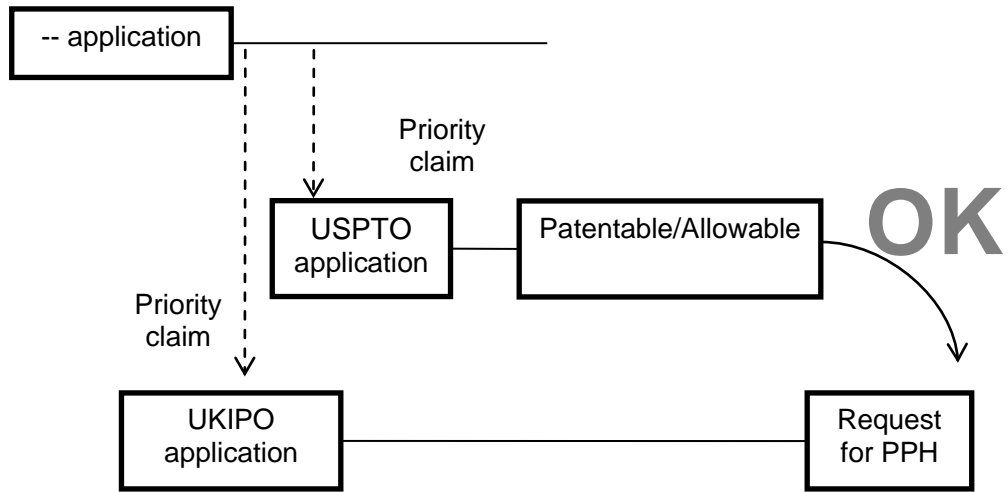
(Case III)  
- Paris route, Domestic priority -



I

1. (Case III)

- Paris route, but the first application is from a third country -

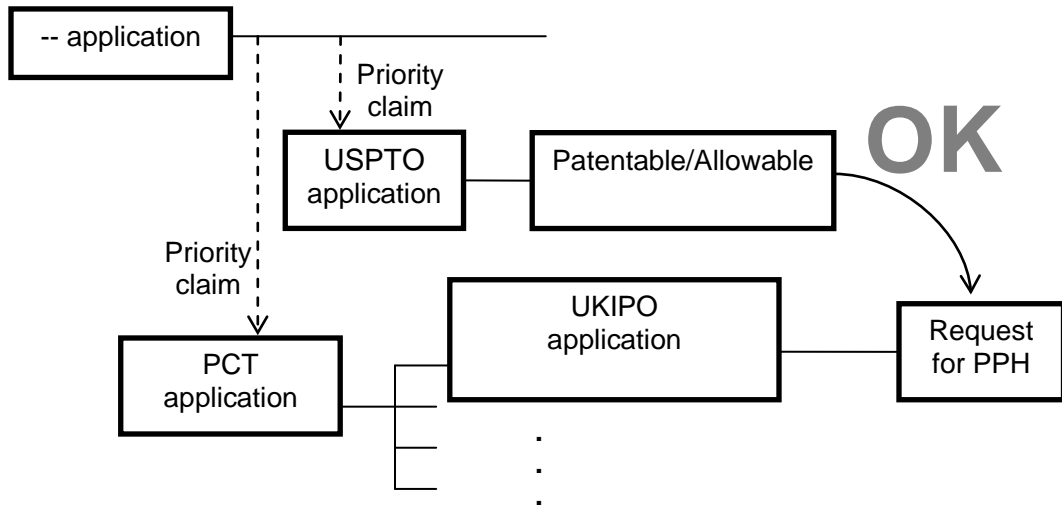


--: an office other than the UKIPO and the USPTO

J

(Case III)

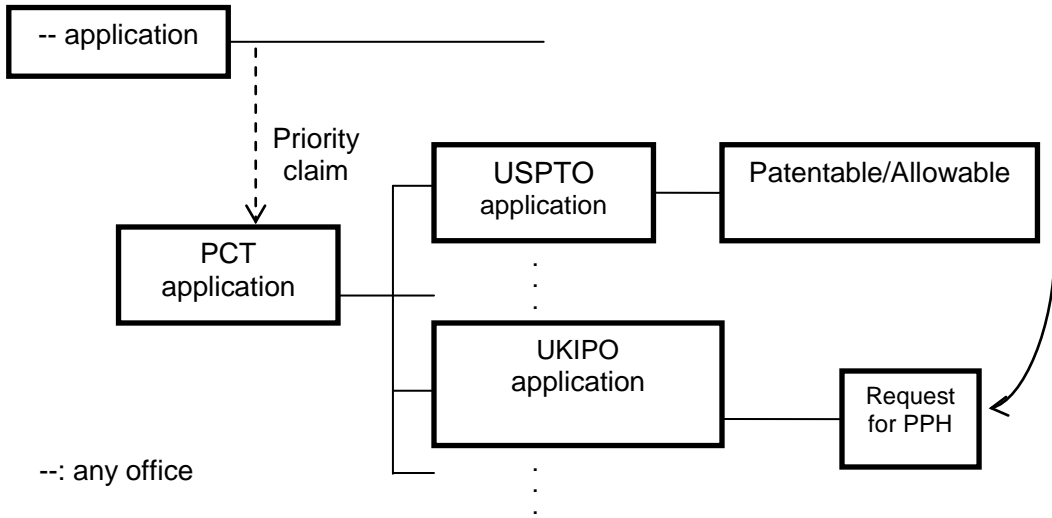
- PCT route, but the first application is from a third country -



--: an office other than the UKIPO and the USPTO

(K)

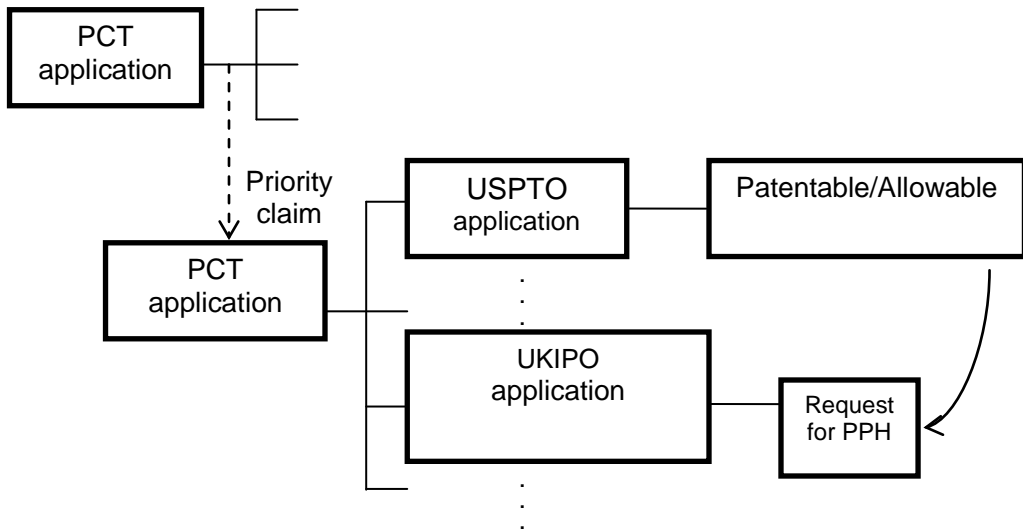
(Case III)  
- PCT route -



OK

(L)

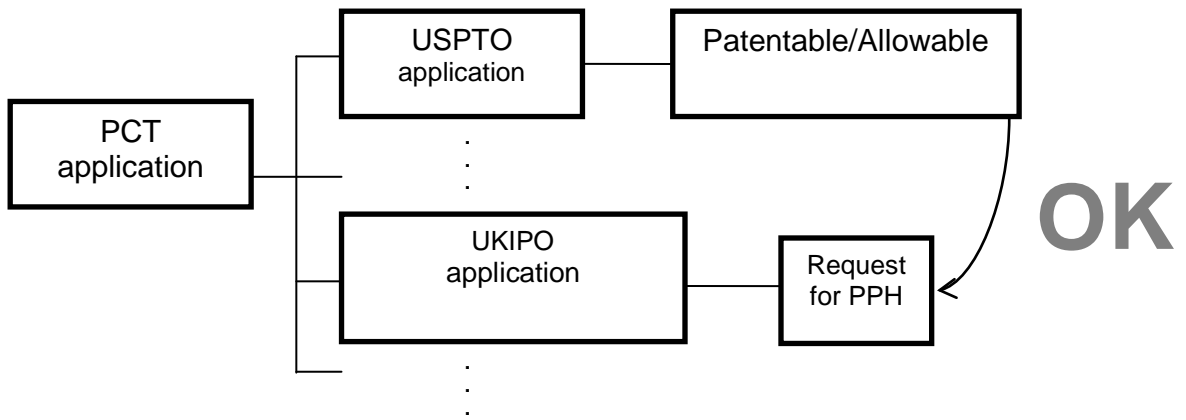
(Case III)  
- Direct PCT & PCT route -



OK

M

(Case IV)  
- Direct PCT route -



**ANNEX 2: REQUEST FORM FOR  
ACCELERATED EXAMINATION UNDER THE  
PATENT PROSECUTION HIGHWAY**

## **Request for Accelerated Examination at the UK IPO Under the Patent Prosecution Highway Pilot Program Between the UK IPO and the USPTO**

- 1** UK application number:  
Corresponding US publication number(s):
- 2** **Either:**  
a) Copy of USPTO office action(s) attached:   
**or**  
b) UK IPO to obtain office actions from USPTO
- 3** **Either:**  
a) Copy of claims of corresponding USPTO application attached:   
**or**  
b) UK IPO to obtain claims from USPTO
- 4** Translated versions of foreign language citations attached:   
*(please note that whilst it is not necessary to provide translations of patent documents at this time, examination of your application may be delayed if the examiner has need to request translation of any documents from you at a later date)*
- 5** Claim correspondence table completed:

