

# **Procedures for filing a request at the UK Intellectual Property Office for acceleration under the Patent Prosecution Highway Program between the UK Intellectual Property Office and the Japanese Patent Office**

## **Request to the UK Intellectual Property Office**

**[0001]** An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the UK Intellectual Property Office by submitting a letter requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the UK Intellectual Property Office 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 Intellectual Property Office application procedure envisaged at this time (paragraph [0007]).

## **Requirements for requesting accelerated examination under the PPH program at the UK Intellectual Property Office**

**[0002]** There are four requirements for requesting accelerated examination under the PPH program at the UK Intellectual Property Office. These are:

a) Both the UK IPO application on which PPH is requested and the JPO 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 applications) may be:

- (Case I) an application which validly claims priority under the Paris Convention from the JPO 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 JPO 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 JPO 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 JPO application(s) are derived from a common PCT international application having no priority claim (see Annex 1, figure M).

b) At least one corresponding JPO application has one or more claims that are determined to be patentable by the JPO.

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 JPO. 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 JPO, or the claims in the UK IPO are narrower in scope than the claims in the JPO.

In this regard, a claim that is narrower in scope occurs when a JPO 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 JPO is not considered to sufficiently correspond. For example, where the JPO 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 Intellectual Property Office has not begun examination of the application.

**Required documents for accelerated examination under the PPH program at the UK Intellectual Property Office**

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

a) a copy of the office action(s) on the corresponding JPO application(s). No paper copy and corresponding translation of the office actions need be supplied if the office actions are available on AIPN<sup>1</sup>.

b) a copy of the translated claims examined by the JPO and copies of subsequent amended claims found to be patentable by the JPO where appropriate. No paper copy or translation of the claims need be supplied if the claims are available on AIPN.

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

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<sup>1</sup> AIPN is a network between patent offices which provides JPO's file wrapper information. Applicants do not have access to AIPN, but if you want to know whether information about your application is available on the AIPN, please ask the JPO (PA2260@jpo.go.jp).

**[0004]** The applicant is required to complete a form for requesting accelerated examination under the PPH program (as given in Annex 2) which is available for download from the UK Intellectual Property Office website. The form must be sent to the UK Intellectual Property Office along with a letter requesting acceleration under the PPH and the relevant supporting documentation. **Please ensure that the request form is the uppermost document when requesting accelerated examination under the PPH. Failure to do so may result in consideration of your request for accelerated examination under the PPH being delayed.**

**[0005]** Copies of the patent documents cited by the JPO will not be needed where the documents are available either via EPOQUE or AIPN. The UK Intellectual Property Office 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 program at the UK Intellectual Property Office**

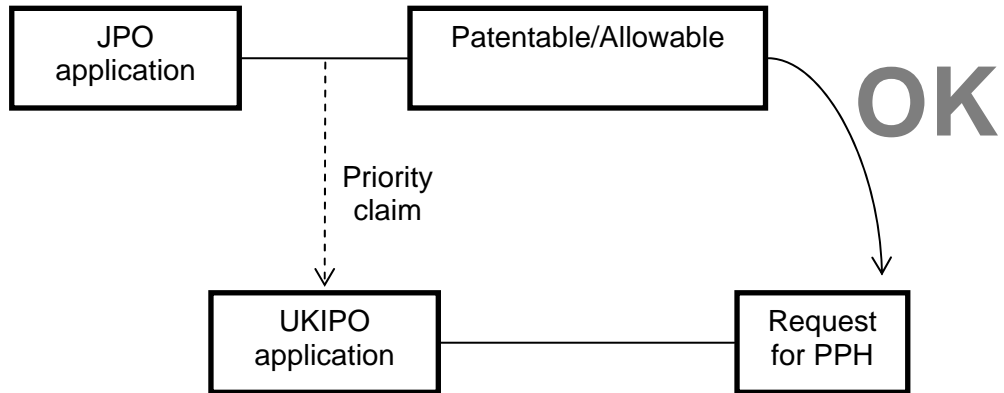
**[0007]** The applicant files a letter requesting accelerated examination under the PPH program to the UK Intellectual Property Office including the relevant supporting documents and a completed request form. The PPH Administrator, who will be a UK Intellectual Property Office patent examiner, will consider the request. Where all of the requirements for accelerated examination under the

PPH have not been met, the PPH Administrator will notify the applicant that the application has not been allowed entry on to the PPH and will provide an explanation as to why entry on to the PPH was not possible. The applicant is free to take any possible correcting action necessary and again request acceleration under the PPH. Where all of the requirements for accelerated examination under the PPH have been met, the PPH Administrator will notify the applicant that the application has been allowed entry on to the PPH. The PPH Administrator will notify the relevant examining group that the application has qualified for entry on to the PPH and the relevant examiner will then conduct an accelerated examination of the application.

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

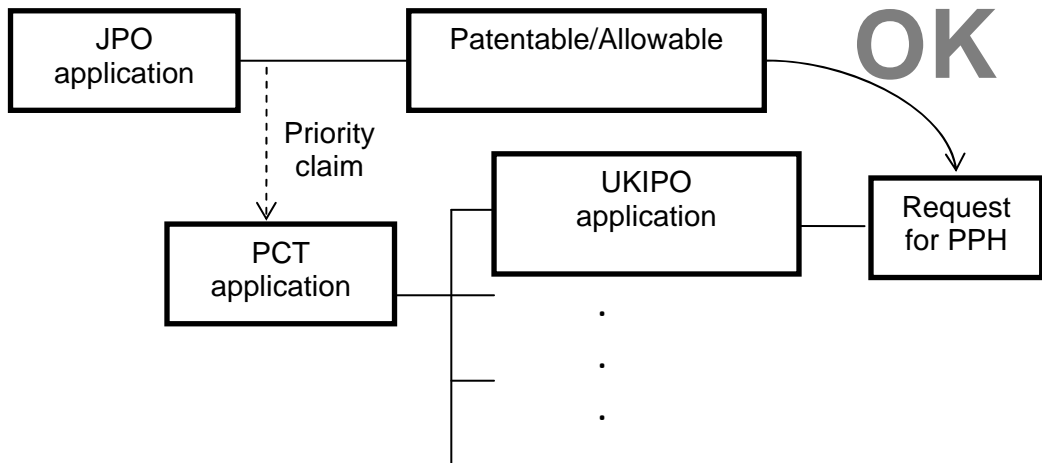
(A)

(Case I)  
- Paris route -



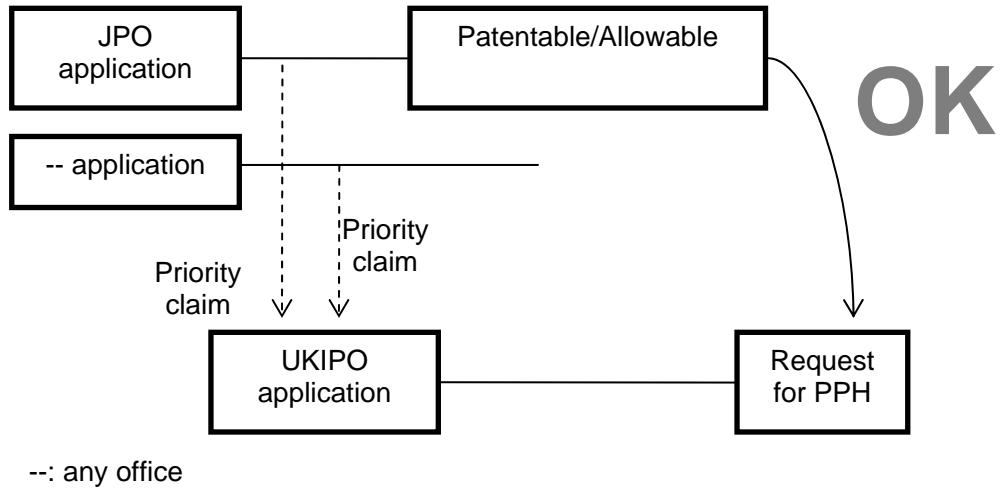
(B)

(Case I)  
- PCT route -



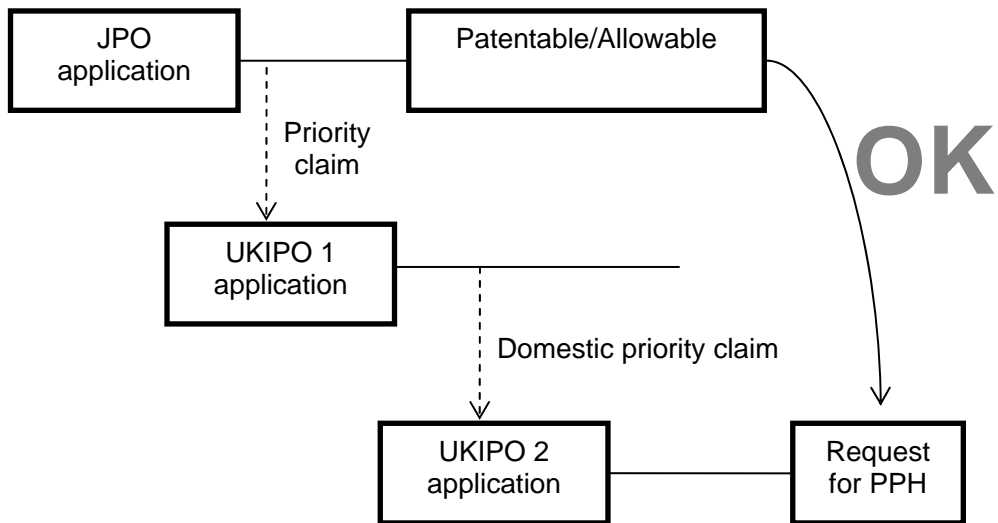
C

(Case I)  
- Paris route & Complex priority -



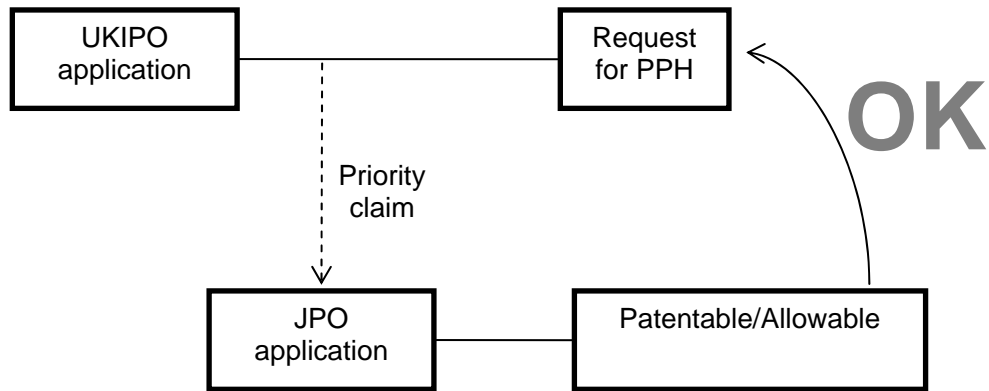
D

(Case I)  
- Paris route & continuing application -



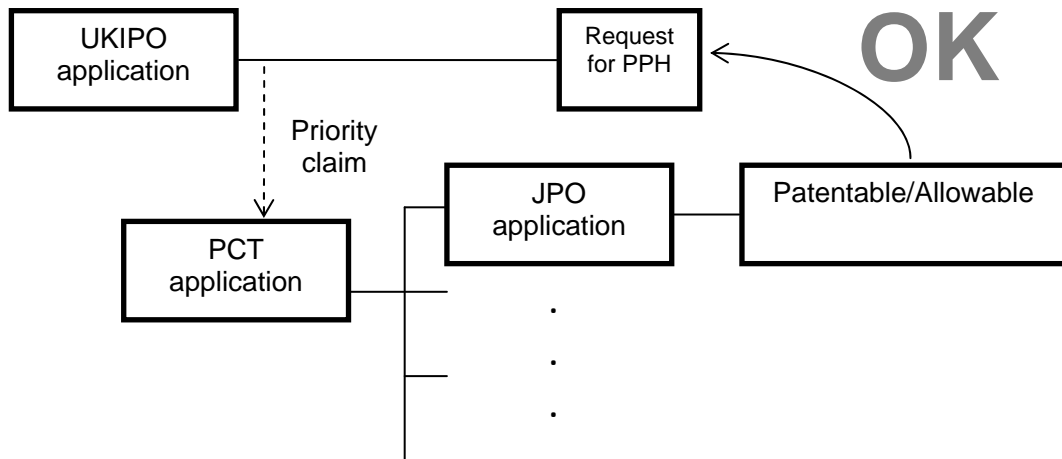
**E**

(Case II)  
- Paris route -



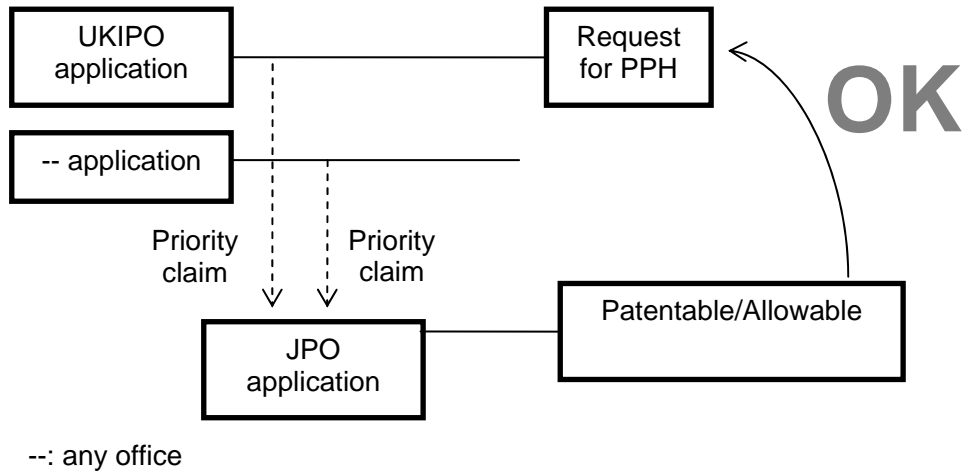
**F**

(Case II)  
- PCT route -



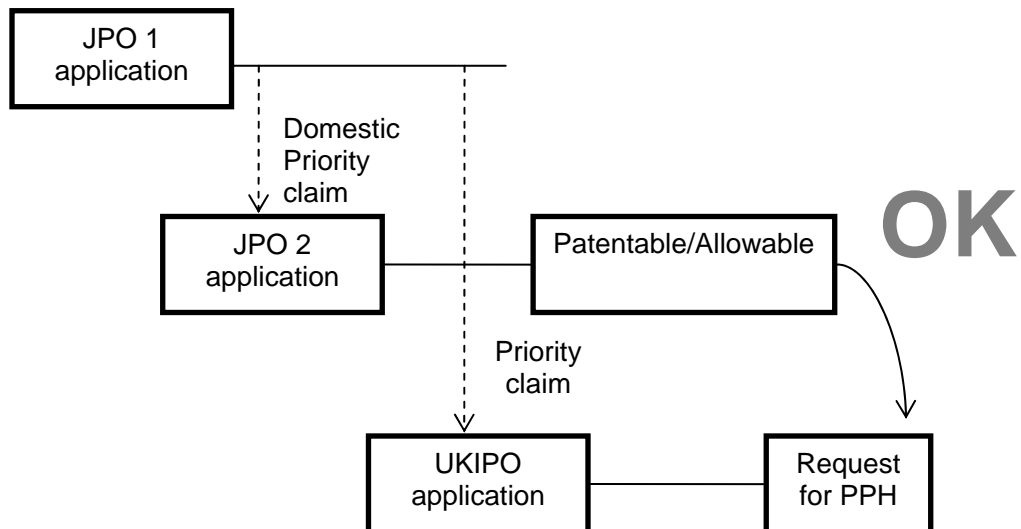
G

(Case II)  
- Paris route & Complex priority -



H

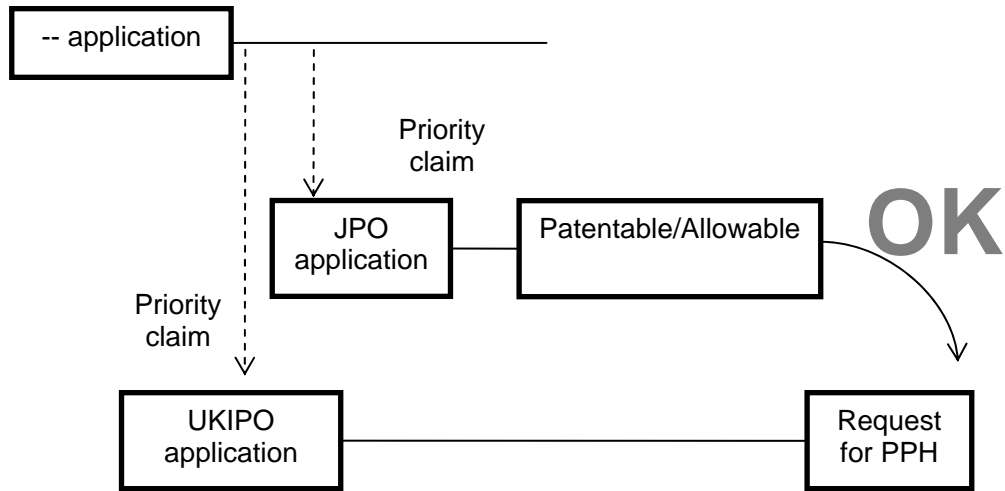
(Case III)  
- Paris route, Domestic priority -



I

1. (Case III)

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

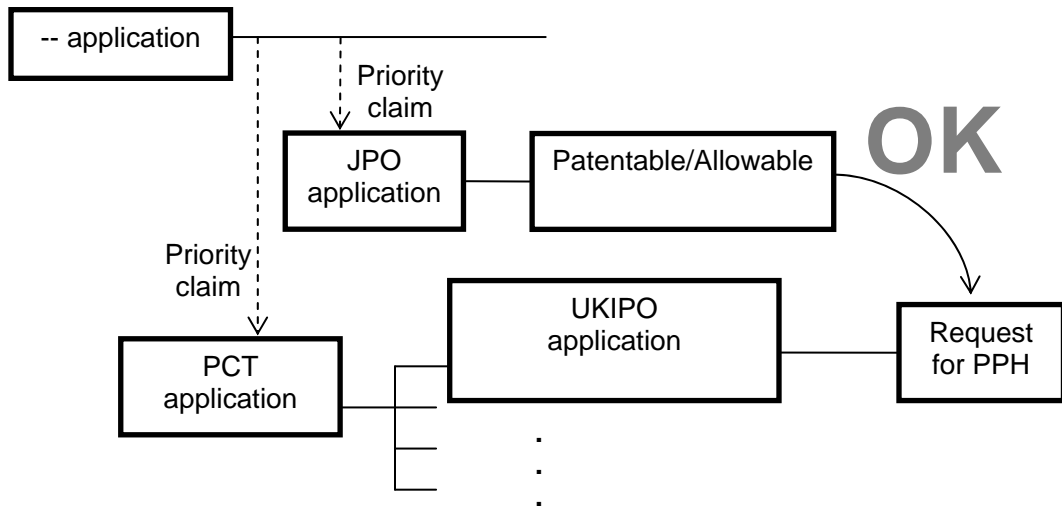


--: an office other than the UKIPO and the JPO

J

(Case III)

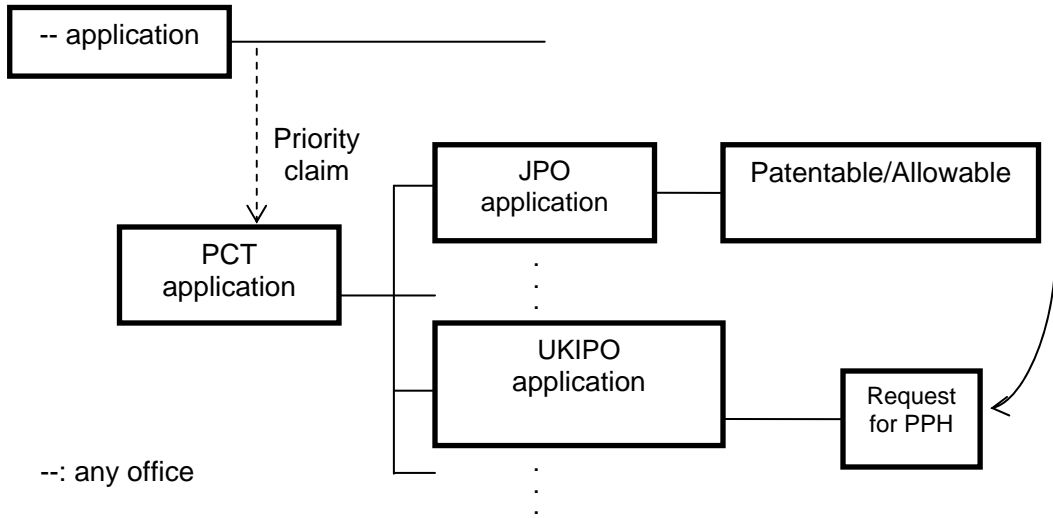
- PCT route, but the first application is from the third country -



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

(K)

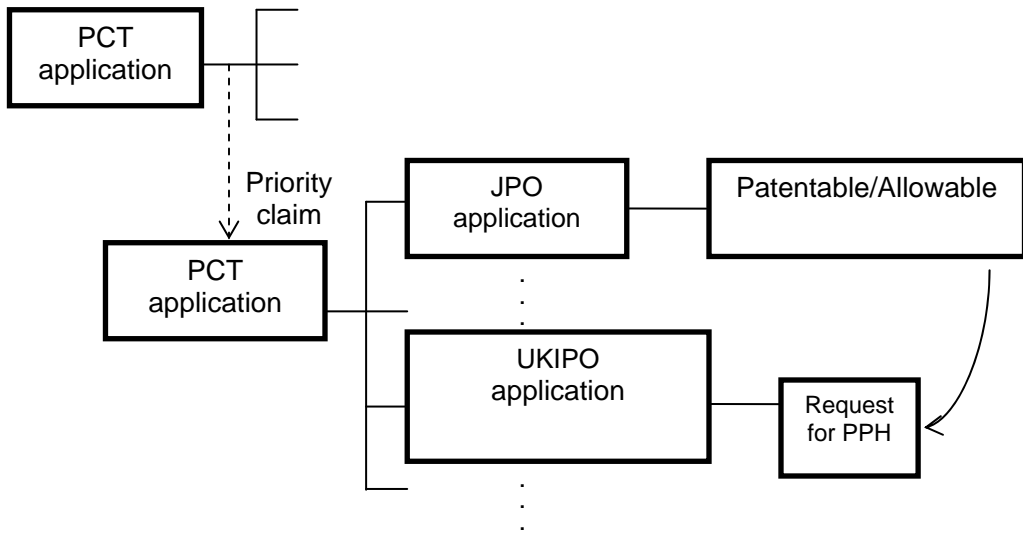
(Case III)  
- PCT route -



OK

(L)

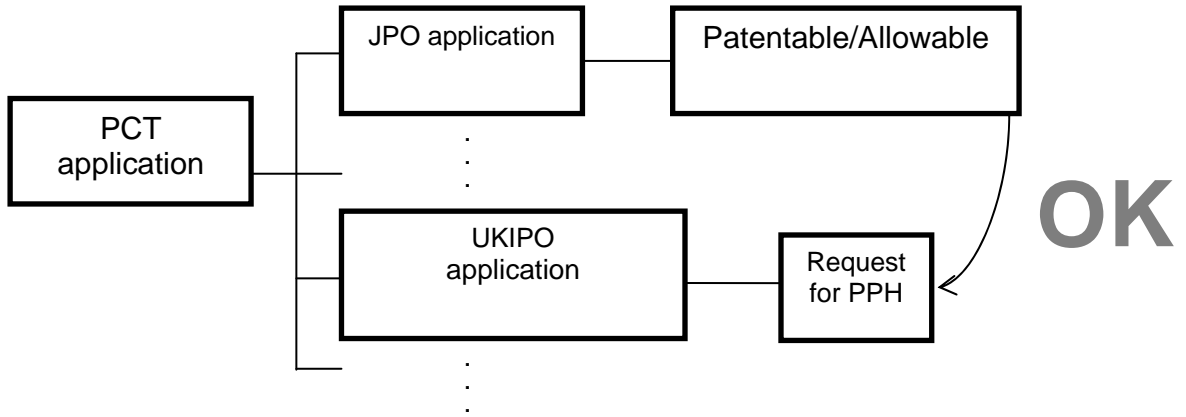
(Case III)  
- Direct PCT & PCT route -



OK

M

(Case IV)  
- Direct PCT route -



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

# PPH REQUEST

## **Request for Accelerated Examination at the UK Intellectual Property Office under the Patent Prosecution Highway between the UK Intellectual Property Office and the JPO**

- 1** UK application number:  
Corresponding JP publication number(s):
- 2** **Either:**
- a) Copy of JPO office action(s) attached:   
**and**  
Copy of translated JPO office action(s) attached:
- or**
- b) JPO office action(s) available on AIPN:
- or**
- c) JPO office action(s) on file from previous PPH application:   
UK application number:
- 3** **Either:**
- a) Copy of claims of corresponding JP application attached:   
**and**  
Copy of translated claims of corresponding JP application attached:
- or**
- b) Claims of corresponding JP application available on AIPN:
- or**
- c) JP application claims on file from previous PPH application:   
UK application number:
- 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:

**Please ensure that this is the uppermost document when requesting accelerated examination under the PPH**

