

Global Patent Prosecution Highway Pilot Program: Requirements and Procedures

Background

With effect from 6th January 2014 the pilot PPH program between IP Australia and the USPTO has been superseded by an agreement between IP Australia and the following patent offices:

Office of Earlier Examination	International Authority
Canadian Intellectual Property Office	Yes
Danish Patent and Trademark Office	No
National Board of Patents and Registration of Finland	Yes
Japan Patent Office	Yes
Korean Intellectual Property Office	Yes
Nordic Patent Institute	Yes
Norwegian Industrial Property Office	No
Portuguese Institute of Industrial Property	No
Russian Federal Service for Intellectual Property	Yes
Spanish Patent and Trademark Office	Yes
United Kingdom Intellectual Property Office	No
United States Patent and Trademark Office	Yes

Under the Global Patent Prosecution Highway (GPPH) pilot you are entitled to request expedited examination for your Australian (AU) application in instances where an associated application has been examined by one of the patent offices participating in the program. These offices are known as Offices of Earlier Examination (OEE).

Examination by an OEE under their national law is known herein as the GPPH program, whilst work carried out by the OEE under the Patent Cooperation Treaty (PCT) is also included and referred to herein as the PCT-GPPH program.

This document details the requirements your AU application must meet and filing procedures that you will need to follow to participate in the GPPH or PCT-GPPH programs in Australia.

Requirements

To participate in the GPPH pilot at IP Australia, your AU application must meet the following requirements:

Requirement 1:

The AU application must be appropriately associated with either

- a. an overseas application having at least one claim found to be allowable/patentable by one of the OEE (GPPH program) or
- b. a PCT Application having at least one claim been found to allowable/patentable by an International Authority that is one of the OEE (PCT-GPPH program).

Option (a) - GPPH program. The AU application being appropriately associated with an overseas application examined by an OEE.

The AU application must be a complete application for a standard patent and be associated with a corresponding overseas application that has been examined by one of the participating OEE and one or more claims have been deemed to be allowable.

The AU application must be associated with the overseas application in one of the following ways:

- i. The AU application claims priority from the overseas application;
- ii. The AU and overseas applications are both based on the same PCT application;
- iii. The AU application and overseas application claim priority from a common priority document. The priority document can be filed at any jurisdiction (Mottainai principle);
- iv. The AU application is the basis of priority claim for the overseas application;
- v. A divisional of an application referred to in (i), (ii), (iii) or (iv),

Option (b) – PCT-GPPH program. The AU application being appropriately associated with a PCT application examined by an International Authority that is one of the OEE.

The AU application must be a complete application for a standard patent and is associated with a corresponding PCT application which has one or more claims that the International Searching Authority (ISA) or International Preliminary Examination Authority (IPEA) has indicated to be allowable/patentable in a written opinion or examination report.

The ISA or IPEA must have been one of the OEE.

The AU application must be associated with the PCT application in one of the following ways:

- i. The AU application is the PCT application and it has entered national phase;
- ii. The AU application claims priority from the PCT application;
- iii. The AU application is a priority document for the PCT application;
- iv. A divisional of an application referred to in (i), (ii), or (iii).

The PCT-GPPH program is not a mechanism for requesting expedited examination of an AU application where IP Australia was the International Searching Authority (ISA) or International Preliminary Examination Authority and the PCT application is an Australian PCT application. You may instead consider requesting conventional expedited examination.

Requirement 2: Corresponding Australian Claims

All claims in the AU application must sufficiently correspond or be amended to sufficiently correspond to one or more of those allowable/patentable claims of the overseas or PCT Application examined by the OEE.

An indication of allowability/patentable claims follows substantive examination, including consideration of novelty and inventive step, by the OEE.

Claims shall be considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims are of the same, similar or narrower scope as the claims indicated as allowable/patentable. In this regard, a claim that is narrow in scope occurs when the claim is amended to be further limited by an additional feature that is disclosed in the specification (description and/or claims). A claim which introduces a new/different category of claims to those claims indicated as allowable/patentable is generally not considered to sufficiently correspond. However where Australian law allows variation in category of claims applicants may consider adapting their claims, for example to include product by process claims.

Requirement 3: Australian Examination

A request for examination must either have been filed earlier or filed at the time of requesting acceleration under the GPPH pilot.

IP Australia has not issued a first examination report on the AU application.

Documents Required for Participation in the GPPH

To participate in the GPPH pilot program at IP Australia, you must file the following documents:

- a letter requesting accelerated examination under the GPPH pilot program to IP Australia,
- a completed GPPH request form (available online at the IP Australia website – www.ipaustralia.gov.au),
- and the relevant supporting documents as noted below

Supporting Documents

Option (a) - GPPH program. The AU application being appropriately associated with an overseas application examined by an OEE.

You are required to submit at the time of making the examination request the following:

1. A copy or the specific details (document description and date) of any one or more office action by the OEE that indicates the allowability/patentability of the claims being examined.
2. A copy or provide the details (document description and date) of the claims examined by the OEE and copies of subsequent amended claims found to be allowable/patentable by the OEE, where appropriate.
3. An indication of the relationship between the AU claims and those of the OEE application.

The indication can be in the form of a completed claim correspondence table (in the GPPH request form) showing the relationship between the claims of AU application and the claims of the corresponding overseas application considered allowable/patentable by the OEE.

Alternatively you may indicate that all the claims of the AU application correlate with the equivalent claims examined by the OEE.

Alternatively you may indicate the relationship in more general terms, for example “Claims 1 – 20 as proposed to be amended correspond to claims 63 – 83 of the US application”.

Should you provide specific details of the documents this is to allow IP Australia to access the documents themselves via the OEE Dossier Access System (DAS). The table below shows the available Dossier Access Systems.

Office	Dossier Access System
IP Australia	AusPat (http://pericles.ipaustralia.gov.au/ols/auspat/)
DKPTO	PVS online (http://onlineweb.dkpto.dk/pvsonline/patent?action=1&subAction=front&language=GB)
JPO	AIPN (http://aipn.ipdl.inpit.go.jp/)
KIPO	K-PION (http://k-pion.kipo.go.kr/)
NIPO	https://dbsearch2.patentstyret.no/AdvancedSearch.aspx?Category=Patent
UKIPO	IPSUM (http://www.ipo.gov.uk/p-ipsum.htm)
USPTO	public PAIR (http://portal.uspto.gov/pair/PublicPair)
WIPO	Patentscope (http://www.wipo.int/pctdb/en/index.jsp)
WIPO	WIPO CASE (http://www.wipo.int/case/en/)

Where the relevant documents are in a language other than English you are required to file verified English language translations, or the DAS is to provide acceptable English language translations. During examination, if the quality of the machine translations is not considered adequate you will be asked to provide verified translation.

Option (b) – PCT-GPPH program. The AU application being appropriately associated with a PCT application examined by an International Authority that is one of the OEE.

You are required to submit at the time of making the examination request the following:

1. A copy or the specific details (document description and date) of any one or more of the Written Opinion or International Preliminary Report on Patentability prepared by International Authority that is one of the OEE listed in the table at the start of this document and which indicates the allowability/patentability of the claims being examined.

Note that the applicant cannot file a request under the PCT-GPPH program on the basis of an International Search Report (ISR) only.

In addition, note that the applicant may not file a request under PCT-GPPH on the basis of a Written Opinion or International Preliminary Report on Patentability prepared by IP Australia. Instead, please consider filing a conventional request for expedited examination.

2. A copy or provide the details (document description and date) of the claims examined by the OEE and copies of subsequent amended claims found to be allowable/patentable by the OEE, where appropriate.
3. An indication of the relationship between the AU claims and those of the OEE application.

The indication can be in the form of a completed claim correspondence table (in the GPPH request form) showing the relationship between the claims of AU application and the claims of the corresponding overseas application considered allowable/patentable by the OEE.

Alternatively you may indicate that all the claims of the AU application correlate with the equivalent claims examined by the OEE.

Alternatively you may indicate the relationship in more general terms, for example "Claims 1 – 20 as proposed to be amended correspond to claims 63 – 83 of the claims amended under Article 34 and Annexed to the IPRPII".

Should you provide specific details of the documents this is to allow IP Australia to access the documents themselves via PatentScope. Where the relevant documents are in a language other than English you are required to file verified English language translations, or PatentScope is to provide acceptable English language translation of the documents. During examination, if the quality of the machine translations is not considered adequate you will be asked to provide verified translation.

NOTE:

When an applicant has already submitted the above mentioned documents to IP Australia through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

Applicants may file citations and translations of citations 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.

How to File a Request for under the GPPH

The documents required for participation in the GPPH can be filed with IP Australia by either mail, fax, or via eServices.

All subsequent correspondence with IP Australia relating directly to the GPPH request must clearly identify the application as a GPPH pilot program application to ensure that the correspondence is correctly processed.

The request for expedited examination under the GPPH pilot program must also be accompanied by, or preceded by, a request for standard examination.

As with a conventional request for expedited examination, there are no fees payable when requesting expedited examination under the GPPH.

Examination of the AU Application Under the GPPH pilot

IP Australia will treat a request for accelerated examination under the GPPH as a request for expedited examination under Australian law.

Examination of AU applications that satisfy the requirements for accelerated examination under the GPPH will take account of the work performed previously by the OEE.

The AU application will be examined in accordance with the *Patents Act* 1990 and IP Australia's Manual of Practice and Procedures.

Enquiries

Enquiries in relation to the Global Patent Prosecution Highway from within Australia should be directed to IP Australia's Customer Service Centre on 1300 65 1010. Enquiries from outside Australia can be directed to 61 2 6283 2999.