

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

### **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. 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 envisaged at this time (paragraph [0007]).

### **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) Either:
  - i) the UK IPO application validly claims priority under the Paris Convention from either a single corresponding JPO application or multiple JPO applications; or
  - ii) the UK IPO application arises from a PCT national phase application where the PCT international application has validly claimed priority from a JPO national application; or
  - iii) the UK IPO application is a divisional of an application originally filed in the UK which validly claims priority from a JPO application
- b) At least one corresponding JPO application has one or more claims that are determined to be patentable by the JPO.
- c) All claims in the UK IPO application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as patentable in the JPO. Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope such that the claims have a common technical feature which makes the claims allowable over the prior art in the corresponding JPO application. Where amended claims have been determined to be patentable by the JPO, the claims of the UK IPO application should be such that they correspond to the amended claims of the JPO application. Claims of the UK IPO application which are appended to earlier claims of the UK IPO application corresponding to claims that are indicated as patentable by the JPO will also be considered where such claims fall within the scope of the claims indicated as patentable by the JPO.

- 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 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 IPO 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.

**[0004]** The applicant is required to complete a form for requesting accelerated examination under the PPH pilot program (as given in Annex 1) which is available for download from the UK IPO website. The form must 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 JPO will not be needed where the documents are available either via EPOQUE or AIPN. 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**

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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).

**[0007]** The applicant files a letter requesting accelerated examination under the PPH pilot program to the UK IPO, including the relevant supporting documents and a completed request form. 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 send an appropriate message to the relevant examining group. The examiner will conduct the accelerated examination.

## **PPH REQUEST**

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

