



Intellectual
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User Guidelines for filing a request to the United Kingdom Intellectual Property Office for acceleration under the Global Patent Prosecution Highway Pilot Program





Request to the UK IPO

[0001] An applicant should file a request for accelerated examination under the Global Patent Prosecution Highway (GPPH) to the United Kingdom Intellectual Property Office (UKIPO) by submitting a letter requesting accelerated examination under the GPPH accompanied by the relevant supporting documents. The requirements for an application to the UKIPO for accelerated examination under the GPPH are given in the following section. Relevant supporting documentation is discussed in a later section (paragraphs [0003]-[0006]) as is the general UKIPO application procedure (paragraphs [0007]-[0008]).

Requirements for requesting accelerated examination under the GPPH pilot program at the UK IPO

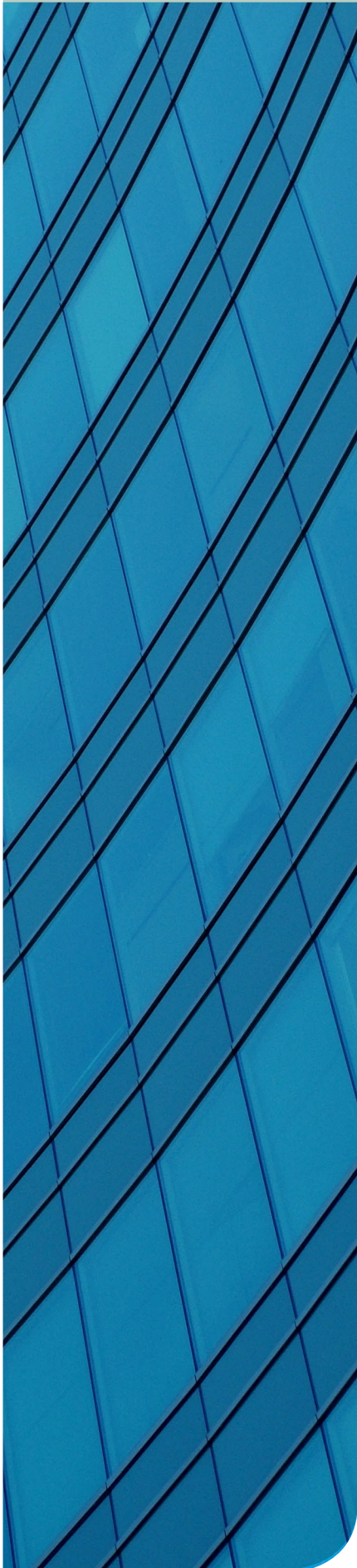
[0002] There are four requirements for requesting accelerated examination under the GPPH pilot program at the UKIPO. These are:

- a) Both the UKIPO application for which acceleration is requested and the Office of Earlier Examination (OEE) application(s) forming the basis of the GPPH request shall have the same earliest date (whether this be a priority date or a filing date).
- b) At least one corresponding OEE application has one or more claims that are determined to be allowable by the OEE. The indication that a claim is allowable should be provided as an explicit statement in any substantive work product from the OEE. Claims determined as novel, inventive and industrially applicable in PCT work products have the meaning of allowable in this document.
- c) All claims on file, as originally filed or as amended, for examination under the GPPH must sufficiently correspond to one or more of those claims indicated as allowable in the OEE.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the UKIPO are of the same or similar scope as the claims in the OEE, or the claims in the UKIPO are narrower in scope than the claims in the OEE.

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

A claim at the UKIPO which introduces a new/different category of claims to those claims indicated as allowable in the OEE is not considered to sufficiently correspond. For example, where the OEE claims only contain claims to a process of manufacturing a product, then the claims in the UKIPO are not considered to sufficiently correspond if the UKIPO claims introduce product



claims that are dependent on the corresponding process claims.

N.B. If the claims on file at the UKIPO do not, at the time of the GPPH request being made, correspond to those found allowable by the OEE then a set of amended claims, which do correspond to the allowed OEE claims, should be filed along with the GPPH request.

d) The UKIPO has not begun examination of the application.

Required documents for accelerated examination under the GPPH pilot program at the UKIPO

[0003] The following documentation is needed to support a request for accelerated examination under the GPPH pilot program at the UKIPO:


a) a completed request form and claim correspondence table showing the relationship between the claims of the UKIPO application and the claims of the corresponding OEE application considered allowable by the OEE (see section [0002](c) above).

b) a copy of the office action(s) on the corresponding OEE application(s). The applicant can either provide these with the GPPH request or, where the OEE has a Dossier Access System upon which the respective documents are available, request that the UKIPO obtain the documents required directly from the OEE.

c) a copy of the claims found to be patentable by the OEE. The applicant can either provide these with the GPPH request or, where the OEE has a Dossier Access System upon which the allowed claims are available, request that the UK IPO obtain the claims directly from the OEE.

d) if the office actions and allowed claims, as noted above, are not in English and/or not available in English on a Dossier Access System then English language translations of the documents should be provided. Where translations are required, machine translations are acceptable, although if a machine translation is of poor quality a further translation may be requested.

[0004] The relevant information is obtained from the applicant by filling in the form requesting accelerated examination under the GPPH pilot program (as provided in Annex 1 and which is available on the UKIPO website). The form should be sent to the UKIPO along with a letter requesting acceleration under the GPPH and the other relevant supporting documentation.



[0005] Copies of the patent documents cited by the OEE will not be needed where the documents are available via EPOQUE but copies of non-patent literature cited by the OEE should be included with the PPH request. The UKIPO 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 GPPH to allow prompt consideration of the citations if they so desire.

[0006] The applicant does not need to provide further copies of documentation if they have already submitted the documents noted above to the UKIPO as part of simultaneous or past procedures.

Procedure for accelerated examination under the GPPH pilot program at the UKIPO

[0007] The applicant files a letter requesting accelerated examination under the GPPH pilot program to the UKIPO, including a completed PPH request form and claim correspondence table (as provided in Annex 1 and also available online on the UKIPO website) and other relevant supporting documents as noted above.

[0008] The PPH administrator, who will be a UKIPO patent examiner, will consider the request and if all requirements are met the PPH administrator will notify the relevant heading examiner, who will conduct the accelerated examination. If one or more of the requirements are not met then the PPH Administrator will contact the applicant and provide them with at least one opportunity to correct the GPPH request in cases where such a remedial correction is possible.

ANNEX 1:

**REQUEST FORM AND CHECKLIST FOR ACCELERATED
EXAMINATION UNDER A PATENT PROSECUTION HIGHWAY AT THE
UNITED KINGDOM INTELLECTUAL PROPERTY OFFICE**

Request for Accelerated Examination at the United Kingdom Intellectual Property Office under the Patent Prosecution Highway

- 1 UK application number:
- 2 Name of Office of Earlier Examination (OEE):

Corresponding OEE application number(s):
- 3 **Either:**
- a) Copy of OEE office action(s) attached:
and
Translation(s) of OEE office actions (if required)¹
- or**
- b) UK IPO to obtain office actions from OEE²
- 4 **Either:**
- a) Copy of claims of corresponding OEE application attached
and
Translation of OEE claims (if required)¹
- or**
- b) UK IPO to obtain claims from OEE²
- 5 Translated versions of foreign language citations attached³
- 6 Claim correspondence table completed:

^{*1} Translations of OEE office actions and allowed claims should be provided where the language of the documents is not English. Machine translations are acceptable although if a machine translation is of poor quality a further translation may be requested.

^{*2} The IPO can obtain supporting documentation on behalf of applicants where the OEE has a Dossier Access System that can be accessed by the UKIPO and upon which the required documents are available. If you are unsure whether the OEE has such a system then either contact the OEE or alternatively email PPH@ipo.gov.uk.

^{*3} Please note that there is no need to provide translations of citations at this time, but examination of your application may be delayed if the examiner needs to request translation of any documents from you at a later date. There is no need to provide translations of patent documents available on EPOQUE.

**To contact the
Intellectual Property Office**

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