

# Patent Prosecution Highway pilot programme between the Trilateral Offices based on PCT work products

## I. Background

The Patent Prosecution Highway pilot programme between the Trilateral Offices based on PCT work products (Trilateral PCT-PPH) was launched on 29 January 2010.

The Trilateral Offices have agreed to revise the participation requirements and extend the trial period for the Trilateral PCT-PPH pilot programme until 28 January 2014, with effect from 29 January 2012.

The Patent Prosecution Highway leverages fast-track patent examination procedures already available at the Trilateral Offices to allow applicants to obtain corresponding patents faster and more efficiently. It also permits each office to exploit the work previously done by another office.

**The present notice replaces that published in the OJ EPO 2010, 69 f.**

## II. PCT-PPH pilot programme

The PPH enables an applicant whose claims have been determined to be patentable/allowable to have a corresponding application filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results.

Under the PCT-PPH pilot programme a PPH request can be based on the latest PCT work product (written opinion of the ISA (WO-ISA) or international preliminary examination report (IPER)) established by one of the Trilateral Offices as ISA or IPEA, where this work product determines claims to be patentable/allowable.

Where the EPO is the ISA, or ISA and IPEA, and the PCT application contains claims that are determined to be patentable/allowable by the EPO as ISA or IPEA, the applicant may request accelerated examination at the JPO and the USPTO when the application has entered the national phase before these offices. The procedures and requirements for filing a request with the JPO and the USPTO for participation in the PCT-PPH pilot programme are available from the JPO website at [www.jpo.go.jp](http://www.jpo.go.jp) and from the USPTO website at [www.uspto.gov](http://www.uspto.gov).

Where **either the JPO or the USPTO was the ISA, or ISA and IPEA, and the PCT application contains claims that are determined to be patentable/allowable by that ISA or IPEA**, the applicant may request participation in the PCT-PPH pilot programme at the EPO when the application has entered the European phase. With effect from 29 January 2012, the procedures and requirements for filing a request with the EPO for participation in the PCT-PPH pilot programme are set forth below (B) and apply to PPH requests made on or after 29 January 2012.

With regard to the utilisation of national work products established during the processing of a national application before the JPO or USPTO, reference is made to the EPO-JPO and EPO-USPTO bilateral PPH pilot programmes.

### A. Trial period for the PCT-PPH pilot programme

The PCT-PPH pilot programme with the revised requirements will commence on 29 January 2012, for a period of two years ending on 28 January 2014. The revised requirements will apply to PPH requests filed with the EPO on or after 29 January 2012.

The Trilateral Offices will evaluate the results of the pilot programme to determine whether and how the programme should be fully implemented after the trial period. The trial period may be extended if necessary to adequately assess the

feasibility of the PCT-PPH programme. The offices may also terminate the PCT-PPH pilot programme early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if the PCT-PPH pilot programme is terminated before 28 January 2014.

## **B. Requirements for requesting participation in the PCT-PPH pilot programme at the EPO**

In order to be eligible to participate in the PCT-PPH pilot programme at the EPO, the following conditions must be met:

(1) Either the JPO or the USPTO has been ISA<sup>1</sup>. Where a demand for PCT Chapter II has been filed, one of these offices has been IPEA as well. The PCT application may have been filed with any receiving Office and may claim priority from an earlier application filed with any member of the Paris Convention or the WTO. The different filing scenarios that are covered by the pilot are illustrated in the Annex.

(2) The PCT application has at least one claim determined by the ISA or, where a demand under Chapter II has been filed, by the IPEA to be patentable/allowable in the sense that it is novel, inventive and industrially applicable. If any observation is made in Box VIII of the WO-ISA or IPER, as the case may be, the applicant must explain why the claim(s) is/are patentable/allowable, and may file amendments to overcome these observations.

(3) The claims in the application on file upon entry into the European phase or as amended within the Rule 161 EPC time limit must sufficiently correspond to the claims deemed patentable/allowable by the ISA or the IPEA. Claims will be considered to sufficiently correspond where, accounting for differences due to claim format requirements, the claims are of the same or a similar scope or the claims in the EP application are narrower in scope than the claims determined to be patentable/allowable in the latest international work product. In this regard, a claim that is narrower in scope occurs when a claim determined to be patentable/allowable in the latest international work product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). Additionally, a claim in the EP application which introduces a new/different category of claims than those indicated to be patentable/allowable by the ISA or, where a demand under Chapter II has been filed, by the IPEA is not considered to sufficiently correspond. For example, where the claims determined to be patentable/allowable in the latest international work product only contain claims to a process of manufacturing a product, then the claims in the EP application are not considered to sufficiently correspond if the EP claims introduce product claims that are dependent on the corresponding process claims. **The applicant is required to submit a declaration that the claims on file upon entry into the European phase or as amended within the Rule 161 EPC time limit and the claim(s) determined to be patentable/allowable in the latest international work product sufficiently correspond.**

(4) Examination of the EP application for which participation in the PCT-PPH pilot programme is requested has **not** begun.

## **C. Documents required for participation in the PCT-PPH pilot programme at the EPO**

For participation in the PCT-PPH pilot programme at the EPO the applicant has to:

(1) file a request for participation in the PCT-PPH pilot programme. A request form (EPA/EPO/OEB 1009 PCT) is available from the EPO website at [www.epo.org](http://www.epo.org);

(2) file a declaration of claims correspondence (tick the appropriate box in the PPH request form);

---

<sup>1</sup> Applications for which the EPO was ISA and/or IPEA are not eligible for processing via the PPH before the EPO as DO/EO. The EPO understanding of the PPH is that an application is processed in an accelerated manner on the basis of a patentability assessment made by another office. Where the EPO has been ISA and/or IPEA, the PCT WO/ISA or IPER have effectively the same status as a first communication in substantive examination before the EPO as DO/EO. Thus, in this case there is no work product that can be considered as work done by "another" office. This case can, however, fall under the regular programme for accelerated processing of European patent applications ("PACE") which the applicant can request.

(3) submit a copy of the WO-ISA or, where a demand under PCT Chapter II has been filed, of the IPER and a translation thereof in one of the EPO official languages, unless either of these are already available to the EPO;

(4) submit a copy of the claims deemed patentable/allowable as filed or as amended under Article 34(2)(b) PCT and a translation thereof in one of the EPO official languages, unless either of these is already available to the EPO;

(5) submit copies of all documents other than patent documents cited in the WO-ISA or IPER, unless these documents are already available to the EPO. If the EPO is not able to retrieve a patent document it will request the applicant to submit a copy of it. The EPO may also request the applicant to submit a translation of a patent document in one of the EPO official languages.

Where the request for participation in the PCT-PPH pilot programme is granted, the applicant will be notified and the EP application will be processed in an accelerated manner. In those instances where the request for participation in the PCT-PPH pilot programme does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given **one** opportunity to correct any deficiencies in the request. If the request is not corrected, the applicant will be notified.

#### **D. Prosecution under PACE**

Once the request for participation in the PCT-PPH pilot programme has been granted, the EP application will be processed in an accelerated manner under PACE<sup>2</sup>.

Any inquiries concerning this notice may be directed to Eugen Stohr, Director, International Legal Affairs, PCT, at [international\\_legal\\_affairs@epo.org](mailto:international_legal_affairs@epo.org).

---

<sup>2</sup> Notice from the EPO dated 4 May 2010 concerning the programme for the accelerated prosecution of European patent applications - "PACE", OJ EPO 2010, 352.

**Anlage**

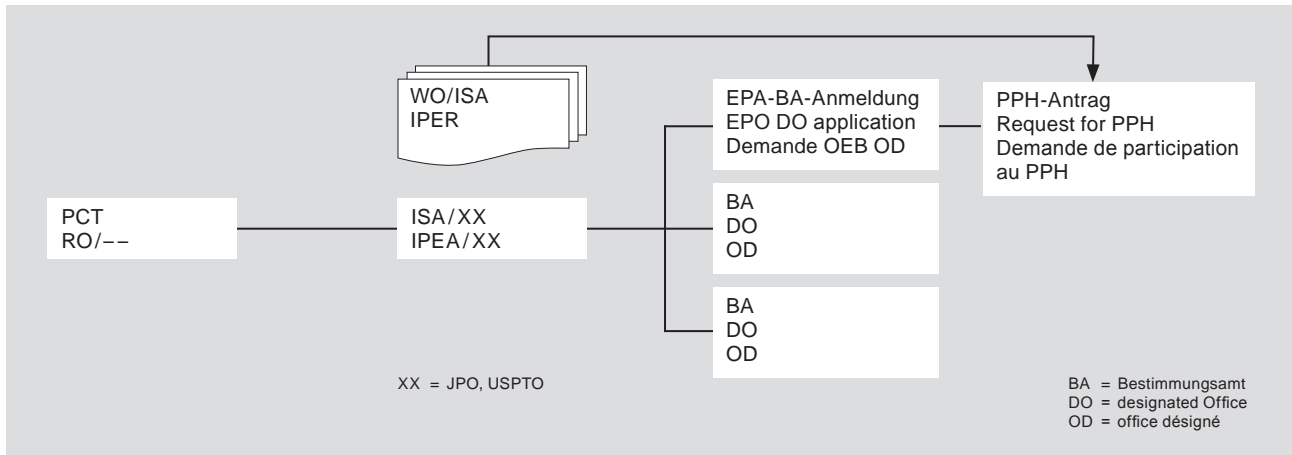
**Annex**

**Annexe**

**A) Die Anmeldung ist eine Anmeldung in der nationalen Phase, die zu der korrespondierenden internationalen Anmeldung gehört.**

**(A) The application is a national phase application of the corresponding international application.**

**A) La demande est une demande internationale entrée dans la phase nationale.**



**A') Die Anmeldung ist eine Anmeldung in der nationalen Phase, die zu der korrespondierenden internationalen Anmeldung gehört.**

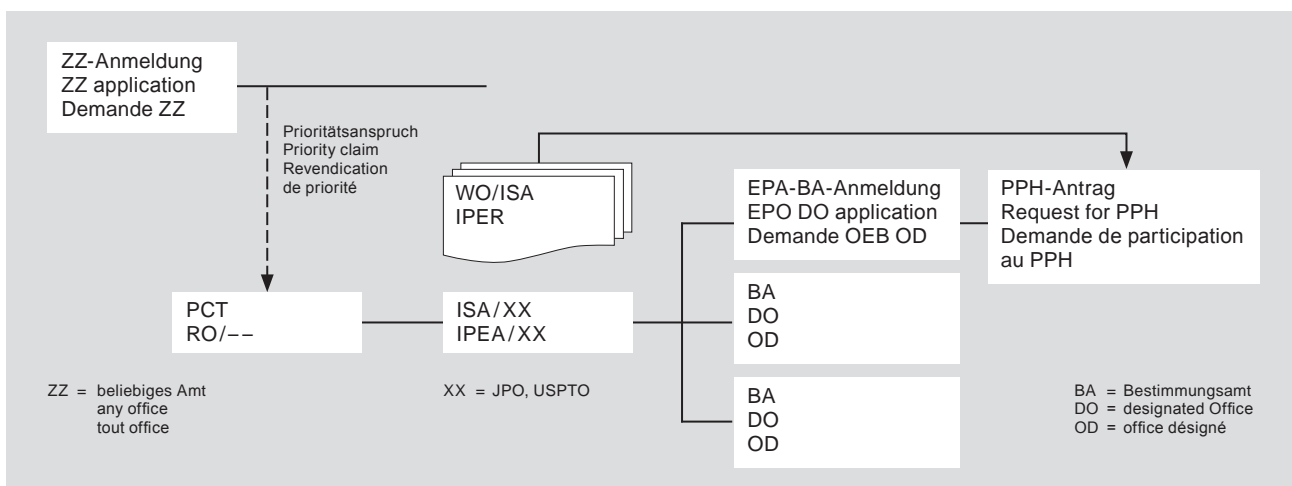
**(A') The application is a national phase application of the corresponding international application.**

**A') La demande est une demande internationale entrée dans la phase nationale.**

**(Die korrespondierende internationale Anmeldung beansprucht die Priorität einer nationalen Anmeldung.)**

**(The corresponding international application claims priority from a national application.)**

**(La demande internationale correspondante revendique la priorité d'une demande nationale.)**



A") Die Anmeldung ist eine Anmeldung in der nationalen Phase, die zu der korrespondierenden internationalen Anmeldung gehört.

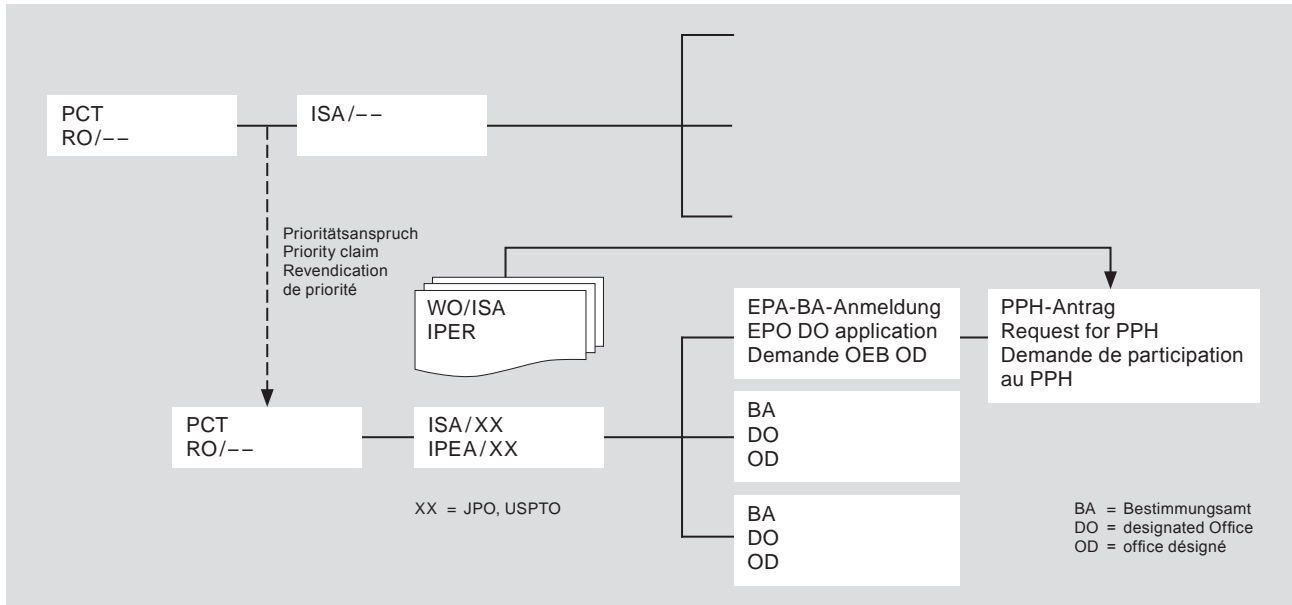
(A") The application is a national phase application of the corresponding international application.

A") La demande est une demande internationale entrée dans la phase nationale.

(Die korrespondierende internationale Anmeldung beansprucht die Priorität einer internationalen Anmeldung.)

(The corresponding international application claims priority from an international application.)

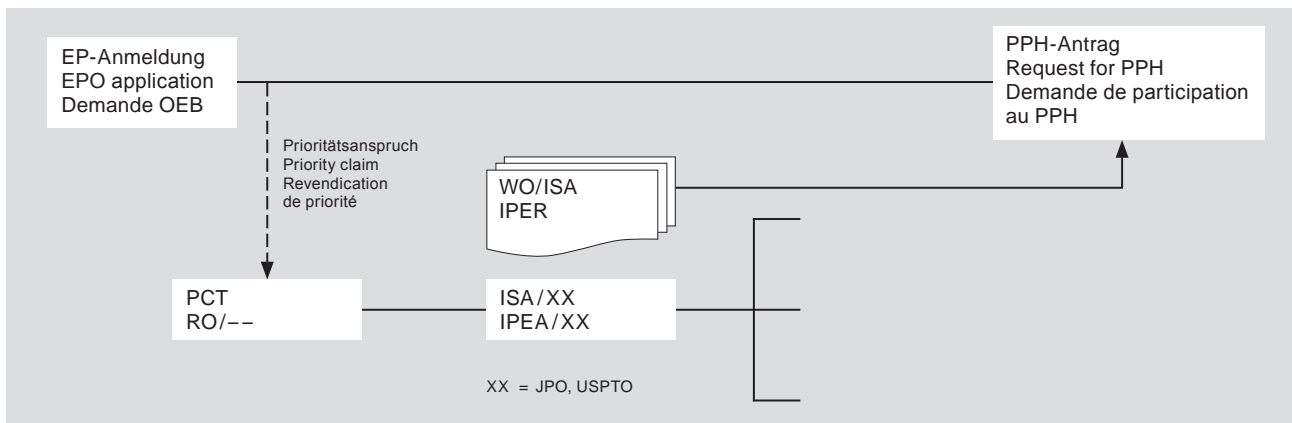
(La demande internationale correspondante revendique la priorité d'une demande internationale.)



B) Die Anmeldung ist eine nationale Anmeldung, die dem Prioritätsanspruch der korrespondierenden internationalen Anmeldung zugrunde liegt.

(B) The application is a national application on which the priority claim of the corresponding international application is based.

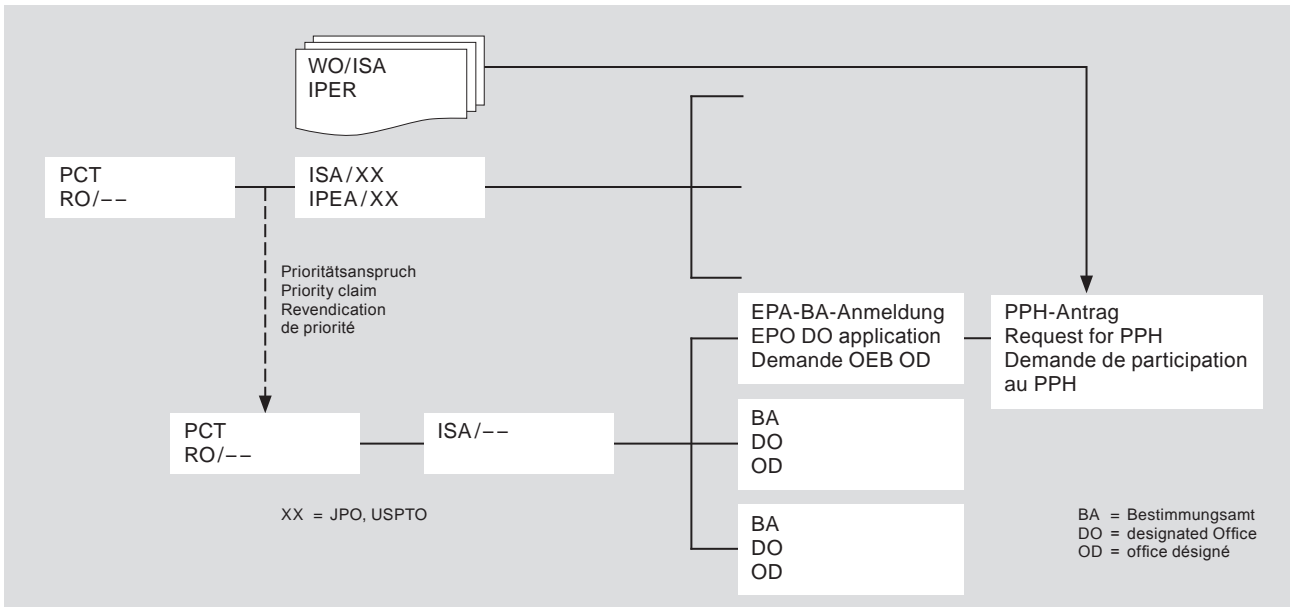
B) La demande est une demande nationale fondant la revendication de priorité de la demande internationale correspondante.



C) Die Anmeldung ist eine Anmeldung in der nationalen Phase, die zu einer internationalen Anmeldung gehört, die ihrerseits die Priorität der korrespondierenden internationalen Anmeldung beansprucht.

(C) The application is a national phase application of an international application claiming priority from the corresponding international application.

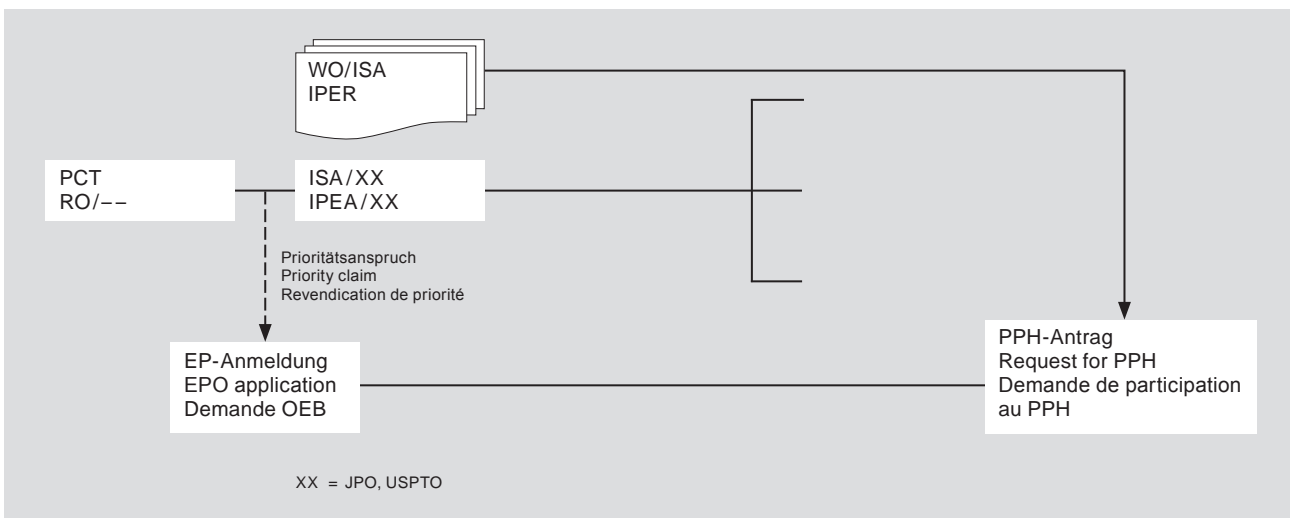
C) La demande est une demande internationale entrée dans la phase nationale et revendiquant la priorité de la demande internationale correspondante.



D) Die Anmeldung ist eine nationale Anmeldung, die eine äußere/innere Priorität der korrespondierenden internationalen Anmeldung beansprucht.

(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.

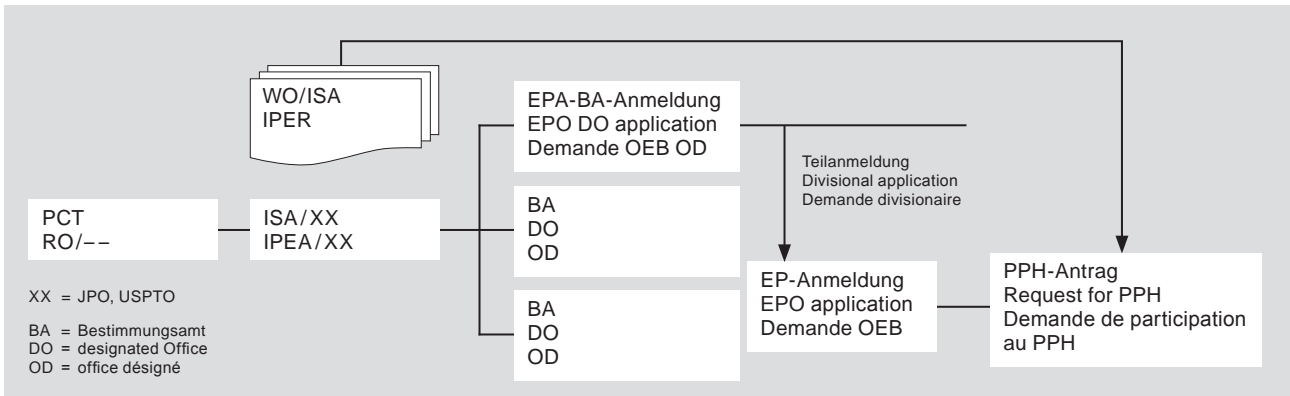
D) La demande est une demande nationale revendiquant une priorité étrangère/nationale de la demande internationale correspondante.



**E1) Die Anmeldung ist eine Teilanmeldung zu einer Anmeldung, die das Erfordernis A erfüllt.**

**(E1) The application is a divisional application of an application which satisfies requirement (A).**

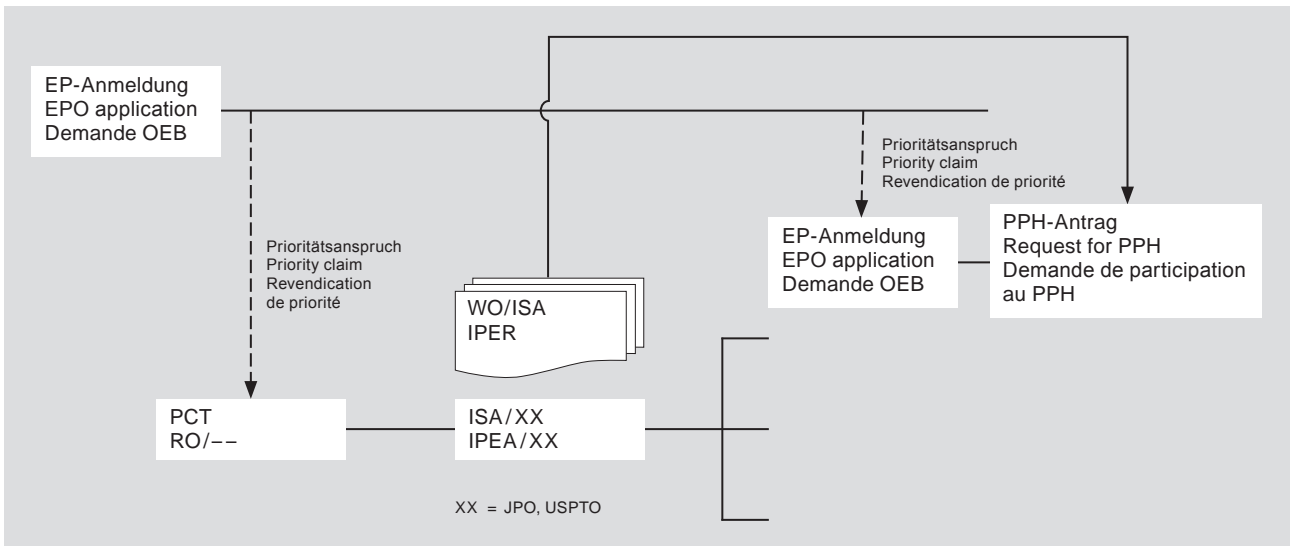
**E1) La demande est une demande divisionnaire d'une demande qui satisfait au critère A.**



**E2) Die Anmeldung ist eine Anmeldung, die eine innere Priorität einer Anmeldung beansprucht, die das Erfordernis B erfüllt.**

**(E2) The application is an application claiming domestic priority from an application which satisfies requirement (B).**

**E2) La demande est une demande revendiquant la priorité nationale d'une demande qui satisfait au critère B.**



## Teilnahme am Pilotprogramm "Patent Prosecution Highway" zwischen den trilateralen Ämtern auf der Grundlage von PCT-Arbeitsergebnissen (PCT-PPH)

## Participation in the Patent Prosecution Highway pilot programme (PCT-PPH) between the Trilateral Offices based on PCT work products

## Participation au programme pilote tripartite "Patent Prosecution Highway" (PPH-PCT) sur la base de produits résultant de travaux au titre du PCT

Der Anmelder beantragt die Teilnahme am Pilotprogramm "PCT-Patent Prosecution Highway":  
The applicant requests participation in the PCT Patent Prosecution Highway pilot programme:  
Le déposant demande à participer au programme pilote "Patent Prosecution Highway-PCT":

Aktenzeichen der PCT-Anmeldung  
PCT application number  
Numéro de la demande PCT

Internationaler Anmeldetag der Anmeldung  
International filing date of the application  
Date du dépôt international de la demande

Entsprechende EP-Anmeldenummer (falls bekannt)  
Corresponding EP application number (if known)  
Numéro de demande EP correspondant (s'il est connu)

Für eine Teilnahme am PCT-PPH sind zusammen mit diesem Formblatt folgende Unterlagen einzureichen/erforderlich:  
For the purposes of participation in the PCT-PPH, the following documents should be attached/are required:  
Pour une participation au PPH-PCT, les documents suivants doivent être joints/sont nécessaires :

- |  |  |
|--|--|
| <p><input type="checkbox"/> 1. WO-ISA oder IPER in Kopie /<br/>A copy of the WO-ISA or IPER /<br/>Copie de la WO-ISA ou de l'IPER</p> <p><input type="checkbox"/> 2. Antrag auf Übermittlung der unter 1 genannten Dokumente über Patentscope /<br/>Request to obtain documents in 1 via Patentscope /<br/>Requête afin d'obtenir les documents visés au point 1 via Patentscope</p> <p><input type="checkbox"/> 3. Alle von der ISA oder IPEA für patentierbar/gewährbar befundenen Ansprüche in Kopie /<br/>A copy of all claims determined to be patentable/allowable by the ISA or IPEA /<br/>Copie de toutes les revendications jugées brevetables/admissibles par l'ISA ou l'IPEA</p> <p><input type="checkbox"/> 4. Antrag auf Übermittlung der unter 3 genannten Dokumente über Patentscope /<br/>Request to obtain documents in 3 via Patentscope /<br/>Requête afin d'obtenir les documents visés au point 3 via Patentscope</p> <p><input type="checkbox"/> 5. Übersetzung der vorstehend unter 1 und 3 genannten Dokumente in einer Amtssprache des EPA (es sei denn, sie ist dem EPA bereits zugänglich) /<br/>Translations of the documents in 1 and 3 above in one of the EPO official languages (unless already available to the EPO) /<br/>Traduction des documents visés aux points 1 et 3 dans l'une des langues officielles de l'OEB (sauf si elle est déjà à la disposition de l'OEB)</p> | <p><input type="checkbox"/> 6. Alle im WO-ISA oder IPER angeführten Dokumente in Kopie (außer Patentunterlagen) /<br/>Copies of all documents cited in the WO-ISA or IPER (except for patent documents) /<br/>Copies de tous les documents cités dans la WO-ISA ou dans l'IPER (hors documents brevets)</p> <p><input type="checkbox"/> 7. Anspruchskorrespondenzerklärung<br/>Der Unterzeichnete erklärt, dass die Ansprüche, die sich beim Eintritt in die europäische Phase in der Akte befanden oder innerhalb der Frist nach Regel 161 EPÜ geändert wurden, den im letzten internationalen Arbeitsergebnis für patentierbar/gewährbar erachteten Ansprüchen in ausreichendem Maße entsprechen. /<br/>Declaration of claims correspondence<br/>The undersigned declares that the claims on file upon entry into the European phase or as amended within the Rule 161 EPC time limit and the claim(s) determined to be patentable/allowable in the latest international work product sufficiently correspond. /<br/>Déclaration de concordance des revendications<br/>Le soussigné déclare que les revendications de la demande qui figuraient au dossier lors de l'entrée dans la phase européenne, ou telles que modifiées dans le délai prévu à la règle 161 CBE, concordent suffisamment avec la (les) revendication(s) jugée(s) brevetable(s)/admissible(s) dans le dernier produit résultant de travaux internationaux.</p> |
|--|--|

Ort/Place/Lieu

Datum/Date

Name(n) des (der) Unterzeichneten/  
Name(s) of signatory/signatories/  
Nom(s) du (des) soussigné(s)

Unterschrift des (der) Anmelder(s) oder Vertreter(s)/  
Signature(s) of applicant(s) or representative(s)/  
Signature(s) du (des) demandeur(s) ou du (des) mandataire(s)

## **Teilnahme am Pilotprogramm "Patent Prosecution Highway" zwischen den trilateralen Ämtern auf der Grundlage von PCT-Arbeitsergebnissen (PCT-PPH) (Formblatt EPA/EPO/OEB 1009 PCT)**

## **Participation in the Patent Prosecution Highway pilot programme (PCT-PPH) between the Trilateral Offices based on PCT work products (Form EPA/EPO/OEB 1009 PCT)**

## **Participation au programme pilote tripartite "Patent Prosecution Highway" (PPH-PCT) sur la base de produits résultant de travaux au titre du PCT (Formulaire EPA/EPO/OEB 1009 PCT)**

### **Einleitung**

Dieses Merkblatt erläutert das Ausfüllen des Formblatts EPA/EPO/OEB 1009 PCT (Teilnahme am Pilotprogramm "PCT-Patent Prosecution Highway" zwischen den trilateralen Ämtern auf der Grundlage von PCT-Arbeitsergebnissen). Das Formblatt ist beim EPA erhältlich.

### **Ausfüllen des Formblatts 1009 PCT**

Die einzelnen Abschnitte des Formblatts sind wie folgt auszufüllen:

- Aktenzeichen der PCT-Anmeldung:  
Geben Sie hier das Aktenzeichen der internationalen PCT-Anmeldung ein.
- Internationaler Anmeldetag der Anmeldung:  
Geben Sie hier den internationalen Anmeldetag ein.
- Entsprechende EP-Anmeldenummer (falls bekannt):  
Geben Sie hier die Nummer der korrespondierenden europäischen Patentanmeldung ein, die im Rahmen des PPH bearbeitet werden soll.

1. WO-ISA oder IPER in Kopie
2. Antrag auf Übermittlung der unter 1 genannten Dokumente über Patentscope:  
Sie können Ihrem Antrag auf Teilnahme am PPH entweder den WO-ISA oder IPER in Kopie beifügen oder beantragen, dass das EPA diese Unterlagen über Patentscope anfordert.
3. Alle von der ISA oder IPEA für patentierbar/gewährbar befundenen Ansprüche in Kopie
4. Antrag auf Übermittlung der unter 3 genannten Dokumente über Patentscope:  
Sie können Ihrem Antrag entweder alle von der ISA/IPEA für patentierbar/gewährbar befundenen Ansprüche in Kopie beifügen oder beantragen, dass das EPA diese Unterlagen bei Patentscope anfordert.
5. Übersetzung der vorstehend unter 1 und 3 genannten Dokumente in einer Amtssprache des EPA, es sei denn, sie ist dem EPA bereits zugänglich.
6. Alle im WO-ISA oder IPER angeführten Dokumente in Kopie (außer Patentunterlagen)

### **Introduction**

These notes explain how to complete form EPA/EPO/OEB 1009 PCT (Participation in the PCT Patent Prosecution Highway pilot programme between the Trilateral Offices based on PCT work products). The form can be obtained from the EPO.

### **Filling in form 1009 PCT**

The sections of the form should be completed as follows:

- PCT application number:  
Enter the number of the international PCT application.
- International filing date of the application:  
Enter the international filing date of the application.
- Corresponding EP application number (if known):  
Enter the number of the corresponding European patent application which should be processed under the PPH.

1. A copy of the WO-ISA or IPER
2. Request to obtain documents in 1 via Patentscope:  
Applicant can either provide a copy of the WO-ISA or IPER with the PPH request or request that the EPO obtain these documents via Patentscope.
3. A copy of all claims determined to be patentable/allowable by the ISA or IPEA
4. Request to obtain documents in 3 via the Patentscope:  
Applicant can either provide a copy of all claims determined to be patentable/allowable by the ISA/IPEA with the PPH request or request that the EPO obtain these documents via Patentscope.
5. Translations of the documents in 1 and 3 above in one of the EPO official languages (unless already available to the EPO)
6. Copies of all documents cited in the WO-ISA or IPER (except for patent documents)

### **Introduction**

La présente notice explique comment remplir le formulaire EPA/EPO/OEB 1009 PCT (Participation au programme pilote tripartite PPH-PCT fondé sur les travaux au titre du PCT). Le formulaire peut être obtenu auprès de l'OEB.

### **Remplir le formulaire 1009 PCT**

Les différentes parties du formulaire doivent être remplies de la manière suivante :

- Numéro de la demande PCT :  
Entrez le numéro de la demande internationale PCT.
- Date du dépôt international de la demande :  
Entrez la date du dépôt international.
- Numéro de demande EP correspondant (s'il est connu) :  
Entrez le numéro de la demande européenne correspondante à traiter dans le cadre du PPH.

1. Copie de la WO-ISA ou de l'IPER
2. Requête afin d'obtenir les documents visés au point 1 via Patentscope :  
Le demandeur peut soit fournir une copie de la WO-ISA ou de l'IPER en même temps que sa demande de participation au PPH, soit requérir que l'OEB se procure ces documents via Patentscope.
3. Copie de toutes les revendications jugées brevetables/admissibles par l'ISA ou l'IPEA
4. Requête afin d'obtenir les documents visés au point 3 via Patentscope :  
Le demandeur peut soit fournir une copie de toutes les revendications jugées brevetables/admissibles par l'ISA/IPEA en même temps que sa demande de participation au PPH, soit requérir que l'OEB se procure ces documents via Patentscope.
5. Traduction des documents visés aux points 1 et 3 dans l'une des langues officielles de l'OEB, sauf si elle est déjà à la disposition de l'OEB
6. Copies de tous les documents cités dans la WO-ISA ou dans l'IPER (hors documents brevets)

7. Anspruchskorrespondenzerklärung  
Der Unterzeichnete erklärt, dass die Ansprüche, die sich beim Eintritt in die europäische Phase in der Akte befanden oder innerhalb der Frist nach Regel 161 EPÜ geändert wurden, den für patentierbar/gewährbar erachteten Ansprüchen in ausreichendem Maße entsprechen.

- Ort:  
Geben Sie hier den Ort ein, von dem aus Sie Formblatt 1009 PCT einreichen.
- Datum:  
Geben Sie hier das Datum ein, an dem Sie Formblatt 1009 PCT einreichen.
- Name:  
Geben Sie hier den Namen der unterschrittsberechtigten Person ein.
- Unterschrift:  
Ist der Anmelder eine juristische Person, so ist das Formblatt zu unterzeichnen:  
– entweder von einer Person, die nach Gesetz oder nach Statut der juristischen Person, ihrer Satzung oder dergleichen zur Unterschrift berechtigt ist, wobei ein Hinweis auf die Unterschriftsberechtigung des Unterzeichneten zu geben ist (z. B. Geschäftsführer, Prokurist, Handlungsbevollmächtigter) (Art. 133 (1) EPÜ); in diesem Fall braucht keine Vollmacht eingereicht zu werden;  
– oder, sofern die juristische Person ihren Sitz in einem Vertragsstaat hat, von einem ihrer Angestellten (Art. 133 (3) Satz 1, Regel 152 (1) EPÜ); in diesem Fall ist eine Vollmacht einzureichen.

7. Declaration of claims correspondence  
The applicant declares that the claims on file upon entry into the European phase or as amended within the Rule 161 EPC time limit and the claim(s) determined to be patentable/allowable sufficiently correspond.

- Place:  
Enter the place of filing of form 1009 PCT.
- Date:  
Enter the date of filing of form 1009 PCT.
- Name:  
Enter the name of the person entitled to sign.
- Signature:  
If the applicant is a legal person other than an individual, the form must be signed:  
– either by a person entitled to sign under the law or the applicant's statute, articles of association or the like, with an indication of the capacity of the person doing so (e.g. chairman, director, company secretary) (Art. 133(1) EPC), in which case no authorisation need be filed  
– or by another employee of the applicant, provided the latter's principal place of business is in a contracting state (Art. 133(3), first sentence, Rule 152(1) EPC), in which case an authorisation must be filed.

7. Déclaration de concordance des revendications  
Le demandeur déclare que les revendications de la demande qui figuraient au dossier lors de l'entrée dans la phase européenne, ou telles que modifiées dans le délai prévu à la règle 161 CBE, concordent suffisamment avec la (les) revendication(s) jugée(s) brevetable(s)/admissible(s).

- Lieu :  
Indiquez le lieu où vous déposez le formulaire 1009 PCT.
- Date :  
Indiquez la date de dépôt du formulaire 1009 PCT.
- Nom :  
Indiquez le nom de la personne habilitée à signer.
- Signature :  
Si le demandeur est une personne morale, le formulaire doit être signé :  
– soit par une personne habilitée à signer en vertu des dispositions légales ou des statuts de la personne morale, en indiquant en quelle qualité cette personne est autorisée à le faire (président, directeur, fondé de pouvoir) (article 133(1) CBE) ; dans ce cas, il n'est pas nécessaire de déposer un pouvoir,  
– soit par un autre employé du demandeur, à condition que ce dernier ait son siège dans un État contractant (article 133(3), première phrase, règle 152(1) CBE) ; dans ce cas, un pouvoir doit être déposé.