

**Procedures to file a request to the UK Intellectual Property
Office for Patent Prosecution Highway Pilot Program
between the Intellectual Property Office of the UK and the JPO**

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 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 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 Intellectual Property Office application procedure envisaged at this time (paragraph [0007]).

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

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

- a) Either:
 - i) the UK application validly claims priority under the Paris Convention from either a single corresponding JPO application or multiple JPO applications; or
 - ii) the UK application is the national phase of a PCT application which has no priority claims, or

- iii) the UK application is the national phase of a PCT application which validly claims priority from a JPO national application, or
 - iv) the UK application claims priority from a PCT application which has no priority claims, or
 - v) the UK application is the national phase of a PCT application which validly claims priority from a PCT application which has no priority claims, or
 - vi) the UK application is a divisional application of any of the above.
- b) At least one corresponding JPO application has one or more claims that are determined to be patentable by the JPO.
- c) All of the claims in the UK application must sufficiently correspond to one or more of those claims indicated as patentable by the JPO in order for the UK application to qualify for accelerated examination under the PPH at the Intellectual Property Office. 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 application should be such that they correspond to the amended claims of the JPO application. Claims of the UK application which are appended to earlier claims of the UK 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 Intellectual Property Office has not begun examination of the application.

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

[0003] The following documentation will be needed to support a request for accelerated examination under the PPH pilot 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 AIPN¹.
- 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.

[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 Intellectual Property Office website. The form must be sent to the 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**

¹ 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).

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 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 Intellectual Property Office through simultaneous or past procedures.

Procedure for accelerated examination under the PPH pilot program at the UK Intellectual Property Office

[0007] The applicant files a letter requesting accelerated examination under the PPH pilot program to the Intellectual Property Office including the relevant supporting documents and a completed request form. The PPH Administrator, who will be an 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: 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

