

Procedures for filing a request at the United Kingdom Intellectual Property Office for acceleration under the Patent Prosecution Highway Pilot Program between the United Kingdom Intellectual Property Office and the State Intellectual Property Office of the People's Republic of China

Request to the UK IPO

[0001] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the United Kingdom Intellectual Property Office (UKIPO) by submitting a letter requesting accelerated examination under the PPH accompanied by the relevant supporting documents including a completed PPH request form and claim correspondence table. The requirements for a request for accelerated examination under the PPH based on national work products are given in Part 1 (paragraphs [0002] – [0009]). The requirements for a request for accelerated examination under the PCT-PPH based on international work products are given in Part 2 (paragraphs [0010] – [0017]).

Part 1

PPH based on national work products

[0002] Applicants can request accelerated examination at the UKIPO based on national work products issued by the State Intellectual Property Office (SIPO) if the following requirements under the SIPO-UKIPO PPH pilot program are satisfied.

Requirements for requesting accelerated examination under the PPH pilot program at the UKIPO

[0003] There are four requirements for requesting accelerated examination under the PPH pilot program at the UKIPO. These are:

a) The UKIPO application must correspond to one or more SIPO applications with which it shares a valid priority claim. This can arise where the UKIPO application is:

- (1) a national application which validly claims priority under the Paris Convention from either a single national SIPO application or multiple national SIPO applications; or
- (2) a PCT national phase application where the PCT international application has validly claimed priority from either a single SIPO national application or multiple national SIPO applications; or

- (3) a PCT national phase application where the PCT application has no priority claim; or
- (4) a national application that validly claims priority under the Paris Convention from either a single PCT application with no priority claim or multiple PCT applications with no priority claims; or
- (5) a PCT national phase application where the PCT application validly claims priority from a PCT application which has no priority claim; or
- (6) a divisional application of an application as referred to in any of (1) to (5).

Please note that an application is not eligible for the PPH pilot program where the associated SIPO application is a utility model application.

b) At least one corresponding SIPO application has one or more claims that are determined to be patentable by the SIPO. Claims clearly identified as patentable by the SIPO in the latest office action at the examination stage can form the basis of a request even if the application which includes these claims has not yet been granted. Such SIPO office actions may include:

- (a) Decision to Grant a Patent;
- (b) First/Second/Third/...Office Action;
- (c) Decision of Refusal;
- (d) Reexamination Decision; and
- (e) Invalidation Decision.

c) All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the SIPO. 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 SIPO, or the claims in the UKIPO are narrower in scope than the claims in the SIPO.

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

A claim in the UKIPO which introduces a new/different category of claims to those claims indicated as allowable in the SIPO is not considered to sufficiently correspond. For example, where the SIPO 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.

It is not necessary to include 'all' claims determined to be patentable/allowable by the SIPO in an application (the deletion of claims is allowable). For example, in the case where an application at the SIPO contains 5 claims determined to be patentable, the application at the UKIPO may contain only 3 of these 5 claims.

N.B. If the claims on file at the UKIPO, at the time of the PPH request being made, do not correspond to those found allowable by the SIPO then a set

of amended claims, which do correspond to the allowed SIPO claims, should be filed along with the PPH request.

d) The UK IPO has not begun examination of the application.

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

[0004] The following documentation is needed to support a request for accelerated examination under the PPH pilot program at the UKIPO:

a) a completed PPH request form and claim correspondence table showing the relationship between the claims of the UKIPO applications and the claims of the corresponding SIPO application that are considered to be allowable (see section [0002](c) above).

b) a copy of the office action(s) on the corresponding SIPO application(s) and translations thereof. The applicant may either provide these documents with the PPH request or, where they are available on a SIPO dossier access system (<http://cpquery.sipo.gov.cn/>), request that the UKIPO obtain the documents directly from the SIPO.

c) a copy of the claims found to be patentable by the SIPO and translations thereof. The applicant may either provide these documents with the PPH request or, where they are available on a SIPO dossier access system, request that the UKIPO obtain the documents directly from the SIPO.

Where English language translations of the above documents are required machine translations are acceptable, but if a machine translation is of poor quality a further translation may be requested.

[0005] The relevant information is obtained from the applicant by filling in the form for requesting accelerated examination under the PPH pilot program which is available for download from the UKIPO website. The form should be sent to the UKIPO along with a letter requesting acceleration under the PPH and the relevant supporting documentation.

[0006] Copies of the patent documents cited by the SIPO will not be needed where the documents are available via EPOQUE. Non-patent literature should always be submitted. 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 PPH to allow prompt consideration of the citations if they so desire.

[0007] The applicant need not provide further copies of documentation if they have already submitted the documents noted above to the UKIPO through simultaneous or past procedures.

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

[0008] The applicant files a letter clearly requesting accelerated examination under the PPH pilot program to the UKIPO, along with the relevant supporting documents as noted above, including a completed PPH request form and claim correspondence table and, if necessary, an amended set of claims to bring the UK claims in line with those found allowable by the SIPO.

[0009] The PPH Administrator, who will be a UKIPO 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 may have one opportunity to take any possible correcting action necessary and again request acceleration under the PPH. If a resubmitted request still does not meet all of the requirements for accelerated examination under the PPH then the request may be refused and the application will await action in its regular turn. 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.

Part 2

PPH based on PCT work products

[0010] Applicants can request accelerated examination at the UKIPO based on PCT work products issued by the SIPO, if the following requirements under the SIPO-UKIPO PCT-PPH pilot program are satisfied.

Requirements for requesting accelerated examination under the PCT-PPH pilot program at the UKIPO based on PCT work products

[0011] There are four requirements for requesting accelerated examination under the PCT-PPH pilot program at the UKIPO. These are:

- a) The relationship between the application (at the UKIPO) and the corresponding international application satisfies one of the following requirements:
- (i) The application is a national phase application of the corresponding international application.
 - (ii) The application is a national application which provides the basis of the priority claim of the corresponding international application.
 - (iii) The application is a national phase application of an international application which claims priority from the corresponding international application.
 - (iv) The application is a national application claiming priority from the corresponding international application.
 - (v) The application is a derivative application (e.g. a divisional application, an application claiming domestic priority etc.) of the application which satisfies one of the above requirements (i) – (iv).
- b) The latest work product in the international phase of a PCT application corresponding to the application, namely the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive steps and industrial applicability). Note that the ISA and the IPEA which produces the WO/ISA, WO/IPEA and/or the IPER is limited to the SIPO, but, if the UK application has a priority claim then the priority claim can be based on an application from any Office. The applicant cannot file a request under the PCT-PPH on the basis of an International Search Report (ISR) only. In case any observations are described in Box VIII of the WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation irrespective of whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participation

in the PCT-PPH pilot program if the applicant does not explain why the claim(s) is/are not subject to the observation. In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

c) All claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated as allowable in the latest international work product of the corresponding international application.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the UKIPO application are of the same or similar scope as the claims indicated to be patentable/allowable in the latest international work product, or the claims in the UKIPO are narrower in scope than those indicated to be patentable/allowable in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated 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).

A claim in the UKIPO application which introduces a new/different category of claims to those claims indicated as allowable in the latest international work product is not considered to sufficiently correspond. For example, where the latest international work product claims only contain claims to a process of manufacturing a product, then the claims in the UKIPO application are not considered to sufficiently correspond if the UKIPO claims introduce product claims that are dependent on the corresponding process claims.

It is not necessary to include 'all' claims determined to be patentable/allowable in the latest international work product in an application (the deletion of claims is allowable). For example, in the case where the latest international work product contains 5 claims determined to be patentable, the application at the UKIPO may contain only 3 of these 5 claims.

N.B. If the claims on file at the UKIPO, at the time of the PPH request being made, do not correspond to those found allowable in the latest international work product then a set of amended claims, which do correspond to the claims found allowable in the latest international work product, should be filed along with the PPH request.

d) The UKIPO has not begun examination of the application at the time of request under PCT-PPH.

Required documents for accelerated examination under the PCT-PPH pilot program at the UKIPO

[0012] The following documentation is needed to support a request for accelerated examination under the PPH pilot program at the UKIPO:

a) A completed PPH request form and claim correspondence table showing the relationship between the claims of the UKIPO application and the claims found allowable in the latest international work product (see section [0011](c) above).

b) A copy of the latest international work product which indicates the claims to be patentable/allowable and their English translation if they are not in English. Where the application satisfies the relationship set out in section [0011](a)(i) above, the applicant need not submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof where a copy of these documents is already be contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via "PATENTSCOPE" (RTM)

(<http://patentscope.wipo.int/search/en/search.jsf>), an applicant need not submit these documents, unless otherwise requested by the UKIPO.

(WO/ISA and IPRP are usually available as "IPRP Chapter I" and "IPRP Chapter II", respectively, at 30 months after the priority date.)

Machine translations are admissible, but if it is impossible for the examiner to understand the translated documents due to poor quality translation the examiner may request that the applicant submits (or resubmits) a translation.

c) A copy of the set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their English translation if they are not in English.

If the set of claims which is indicated to be patentable/allowable is available via "PATENTSCOPE" (RTM) (<http://patentscope.wipo.int/search/en/search.jsf>), an applicant need not submit this document unless otherwise requested by the UKIPO. Where the set of claims are not written or available, e.g. on PATENTSCOPE (RTM), in English, an English language translation of the claims must be submitted by the applicant. Machine translations are admissible, but if it is impossible for the examiner to understand the translated claims due to poor quality translation the examiner may request that the applicant submits (or resubmits) a translation.

[0013] The relevant information is obtained from the applicant by filling in a form for requesting accelerated examination under the PPH pilot program which is available for download from the UKIPO website. The form should be sent to the UKIPO along with a letter requesting acceleration under the PPH and the relevant supporting documentation.

[0014] Copies of the patent documents cited against the international application will not be needed where the documents are available via EPOQUE. Non-patent literature should always be submitted. 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 PPH to allow prompt consideration of the citations if they so desire.

[0015] The applicant need not provide further copies of documentation if they have already submitted the documents noted above to the UKIPO through simultaneous or past procedures.

Procedure for accelerated examination under the PCT-PPH pilot program at the UKIPO

[0016] The applicant files a letter clearly requesting accelerated examination under the PCT-PPH pilot program to the UKIPO, along with the relevant supporting documents as noted above, including a completed PPH request form and claim correspondence table and, if necessary, an amended set of claims to bring the UK claims in line with those found allowable the latest international work product.

[0017] The PPH Administrator, who will be a UKIPO patent examiner, will consider the request. Where all of the requirements for accelerated examination under the PCT-PPH have not been met, the PPH Administrator will notify the applicant that the application has not been allowed entry on to the PCT-PPH and will provide an explanation as to why entry on to the PCT-PPH was not possible. The applicant may have one opportunity to take any possible correcting action necessary and again request acceleration under the PCT-PPH. If a resubmitted request still does not meet all of the requirements for accelerated examination under the PCT-PPH then the request may be refused and the application will await action in its regular turn. Where all of the requirements for accelerated examination under the PCT-PPH have been met, the PPH Administrator will notify the applicant that the application has been allowed entry on to the PCT-PPH. The PPH Administrator will notify the relevant examining group that the application has qualified for entry on to the PCT-PPH and the relevant examiner will then conduct an accelerated examination of the application.