



Intellectual
Property
Office

Procedures for filing a request at the Intellectual Property Office for acceleration under the Patent Prosecution Highway Pilot Programme between the United Kingdom Intellectual Property Office and the National Institute of Industrial Property of Brazil.



Request to the UK IPO

[0001] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the Intellectual Property Office (IPO) 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 IPO based on national work products issued by the Brazil's National Institute for Industrial Property (INPI) if the following requirements under the IPO-INPI PPH pilot programme are satisfied.

Requirements for requesting accelerated examination under the PPH pilot programme at the IPO

[0003] The requirements for requesting accelerated examination under the PPH pilot programme at the IPO are:

- a. Both the IPO application for which acceleration is requested and the INPI application forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).
- b. The earliest application in the patent family of the IPO and INPI applications must have been filed at either the IPO or INPI.
- c. Patent applications and utility model applications can both serve as the basis for a PPH request. In order to be valid as the basis for a request an application must have been substantively examined, including consideration of novelty, inventive step and industrial applicability.
- d. At least one corresponding INPI application has one or more claims that are determined to be patentable by the INPI. The IPO will accept the 'decision to grant' or the 'decisão de deferimento' of a patent application of the same patent family examined by INPI as the basis for a PPH request.

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- e. All claims on file, as originally filed or as amended, for examination at the IPO under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the INPI. Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the IPO are of the same or narrower scope as the claims in the INPI.

A claim in the IPO which introduces a new/different category of claim to those claims indicated as allowable in the INPI is not considered to sufficiently correspond. For example, where the INPI claims only contain claims to a process of manufacturing a product, then the claims in the IPO are not considered to sufficiently correspond if the IPO 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 INPI in an application (the deletion of claims is allowable). For example, in the case where an application at the INPI contains 5 claims determined to be patentable, the application at the IPO may contain only 3 of these 5 claims.

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

- f. The IPO has not begun examination of the application.

Required documents for accelerated examination under the PPH pilot programme at the IPO

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

- a. A completed PPH request form and claim correspondence table showing the relationship between the claims of the IPO applications and the claims of the corresponding INPI application that are considered to be allowable.
- b. A copy of the office action(s) on the corresponding INPI application(s) and translations thereof (i.e. search and exam reports and the ‘decision to grant’/ ‘decisão de deferimento’).
- c. A copy of the claims found to be patentable by the INPI and translations thereof.

The applicant may provide the above documents with the PPH request or, where they have been made available by INPI on a publically available database, can request that the IPO obtain the documents directly from INPI.

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 programme which is available for download from the IPO website. The form should be sent to the IPO along with a letter requesting acceleration under the PPH and the relevant supporting documentation.

[0006] Copies of the patent documents cited by the INPI will not be needed where the documents are available via EPOQUE. Non-patent literature should always be submitted. The 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.

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

Procedure for accelerated examination under the PPH pilot programme at the IPO

[0008] The applicant files a letter clearly requesting accelerated examination under the PPH pilot programme to the IPO, 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 INPI.

[0009] A PPH Administrator 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.

Part 2

PPH based on PCT work products

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

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

[0011] The requirements for requesting accelerated examination under the PCT-PPH pilot programme are:

- a. Both the IPO application for which acceleration is requested and the corresponding international application forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).
- b. INPI or the IPO was the Receiving Office for the international application.
- c. The latest work product issued by INPI in the international phase of a PCT application corresponding to the application, namely a Written Opinion (WO) or International Preliminary Report on Patentability (IPRP), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive steps and industrial applicability).

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 or IPRP 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 programme 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.

- d. All claims on file, as originally filed or as amended, for examination at the IPO under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the INPI. Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the IPO are of the same or narrower scope as the claims in the INPI.

A claim in the IPO which introduces a new/different category of claim to those claims indicated as allowable by the INPI is not considered to sufficiently correspond. For example, where the INPI claims only contain claims to a process of manufacturing a product, then the claims in the IPO are not considered to sufficiently correspond if the IPO 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 INPI in an application (the deletion of claims is allowable). For example, in the case where an application at the INPI contains 5 claims determined to be patentable, the application at the IPO may contain only 3 of these 5 claims.

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

- e. The IPO 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 programme at the IPO

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

- a. A completed PPH request form and claim correspondence table showing the relationship between the claims of the IPO application and the claims found allowable in the latest international work product.
- b. A copy of the latest international work product which indicates the claims to be patentable/allowable and its English translation if it is not in English.

If a copy of the latest international work product and a copy of its 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 IPO.

(WO/ISA and IPER 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 IPO. 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 programme which is available for download from the IPO website. The form should be sent to the IPO 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 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.

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

Procedure for accelerated examination under the PCT-PPH pilot programme at the IPO

[0016] The applicant files a letter clearly requesting accelerated examination under the PCT-PPH pilot programme to the IPO, 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 INPI.

[0017] A PPH Administrator 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.

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