

User Guidelines for filing a request to the United Kingdom Intellectual Property Office for acceleration under the Patent Prosecution Highway Pilot Program between the United Kingdom Intellectual Property Office and the National Directorate of Industrial Property of Uruguay

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. The requirements for an application to the UKIPO 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 UKIPO application procedure (paragraphs [0007]-[0008]).

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

[0002] Applicants can request accelerated examination at the IPO based on national work products issued by the National Directorate of Industrial Property of Uruguay (DNPI) if the following four requirements have been met. These are:

- a) Both the UKIPO application for which acceleration is requested and the DNPI application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).
- b) At least one corresponding DNPI application has one or more claims that are determined to be allowable by the DNPI. The indication that a claim is allowable should be provided as an explicit statement in any substantive work product from the DNPI.
- 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 by the DNPI.

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 of the DNPI, or the claims in the UKIPO are narrower in scope than the claims of the DNPI.

In this regard, a claim that is narrower in scope occurs when a DNPI 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 by the DNPI is not considered to sufficiently correspond. For example, where the DNPI 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 PPH request being made, correspond to those found allowable by the DNPI then a set of amended claims, which do correspond to the allowed DNPI claims, should be filed along with the PPH request.

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

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

[0003] 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 (see Annex 1) showing the relationship between the claims of the UKIPO application and the claims of the corresponding DNPI application that have been considered allowable (see section [0002](c) above).
- b) a copy of the office action(s) on the corresponding DNPI application(s). The applicant can either provide these with the PPH request or request that the UKIPO obtain the documents required directly from the DNPI online Dossier Access System if the documents are available there.
- c) a copy of the claims found to be patentable by the DNPI. The applicant can either provide these with the PPH request or, where the DNPI Dossier Access System has the allowed claims available, request that the UKIPO obtain the claims directly from the DNPI.
- d) if the office actions and allowed claims, as noted above, are not in English and/or not available in English on the 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 PPH 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 PPH and the other relevant supporting documentation.

[0005] Copies of the patent documents cited by the DNPI will not be needed where the documents are available via EPOQUE/CST but copies of non-patent literature cited by the DNPI 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 PPH 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 PPH pilot program at the UKIPO

[0007] The applicant files a letter requesting accelerated examination under the PPH 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 IPO will consider the request and if all requirements are met then the relevant heading examiner will be notified, who will conduct the accelerated examination. If one or more of the requirements are not met then the the applicant will be contacted and provided with at least one opportunity to correct the PPH request in cases where such a remedial correction is possible.

Annex 1 – UKIPO PPH Request Form

REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM	
A. Bibliographic Data	
Application Number (if known)	
B. Request	
Applicant requests participation in the Patent Prosecution Highway (PPH) pilot program based on:	
Office of Earlier Examination (OEE)	
OEE Work Products Type	<input type="checkbox"/> National/Regional Office Action(s)
	<input type="checkbox"/> WO-ISA, WO-IPEA or IPER
OEE Application Number (Incl. PCT Application Number)	
C. Required Documents	
I. OEE Work Products and, if required, Translations	
1. <input type="checkbox"/> A copy of OEE work products is attached; or <input type="checkbox"/> The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE	
2. <input type="checkbox"/> A translation of documents in 1 in a language accepted by the Office is attached; or <input type="checkbox"/> The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE	
II. Patentable/Allowable Claims Determined by OEE and, if required, Translations	
3. <input type="checkbox"/> A copy of all claims determined to be patentable/allowable by OEE is attached; or <input type="checkbox"/> The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE	
4. <input type="checkbox"/> A translation of documents in 3 in a language accepted by the Office is attached; or <input type="checkbox"/> The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE	

III. Documents Cited in OEE Work Products (if required)

5. ☐ A copy of all documents cited in OEE work products is attached (excluding patent documents); or
- ☐ no references cited

IV. Previously submitted documents

6. ☐ If any of the above mentioned documents have been submitted before, please specify:

D. Claims Correspondence

- ☐ All the claims in the application sufficiently correspond to the patentable/allowable claims in the OEE application; or

- ☐ Claims correspondence is explained in the following table

[illegible]

Name(s) of applicant(s) or representative(s)		
Date		