

## **Framework Provisions for the Global Patent Prosecution Highway System**

1. In order to further improve the Patent Prosecution Highway (PPH) system by enhancing its attractiveness to applicants and increasing associated efficiencies for intellectual property offices, the offices listed in the document titled 'Global Patent Prosecution Highway System Participating Offices' (**Annex A**) have decided to participate in a Global PPH (GPPH) pilot arrangement according to the criteria set out in the document titled Global PPH Pilot Criteria (**Annex B**) and with reference to the Global PPH Principles (**Annex C**).
2. The GPPH pilot will commence on Monday 6<sup>th</sup> January 2014.
3. The participating offices will periodically evaluate and exchange information on the status and effectiveness of the GPPH pilot, and may consider modifying the GPPH pilot on the basis of the evaluation results.
4. Any offices wishing to participate in the the pilot should write to the GPPH Secretariat to indicate their willingness to adopt the guidelines and procedures referred to in the present document, and such offices will subsequently be included in the pilot from a mutually acceptable start date.
5. Offices wishing to participate in the pilot will, using the required format, provide the GPPH Secretariat with requested information including an outline of their patent application processes, quality assurance processes, and their examination practices, for consolidation into a comparative guide to practices at all participating offices.
6. This framework may be amended at any time with the consent of all the participating offices involved.
7. Offices participating in the pilot reserve the right to limit or end their participation in the GPPH pilot at any stage by giving written notice not less than one month prior to the date of withdrawal.

## **Annex A**

### **Global Patent Prosecution Highway System Participating Offices**

IP Australia (IP Australia)

Canadian Intellectual Property Office (CIPO)

Danish Patent and Trademark Office (DKPTO)

National Board of Patents and Registration of Finland (NBPR)

Japan Patent Office (JPO)

Korean Intellectual Property Office (KIPO)

Nordic Patent Institute (NPI)

Norwegian Industrial Property Office (NIPO)

Portuguese Institute of Industrial Property (INPI)

Russian Federal Service for Intellectual Property (ROSPATENT)

Spanish Patent and Trademark Office (SPTO)

United Kingdom Intellectual Property Office (IPO)

United States Patent and Trademark Office (USPTO)

## **Annex B**

### **Global PPH Pilot Criteria**

#### 1 Introduction

1.1 - This document provides the criteria upon which the Global Patent Prosecution Highway (GPPH) pilot is to operate.

1.2 - Under the GPPH pilot, a request for accelerated processing can be made at any participating office based on work products, including PCT work products, from any one of the other participating offices providing the following eligibility criteria are met.

1.3 - Participating offices may, if they wish, develop office-specific guidelines, e.g. to reflect their respective legal terminology and processes, and can apply additional flexibility beyond these requirements as they see fit. However, these criteria set out a standard to be adhered to by offices participating in the GPPH pilot so as to provide a uniform system for applicants, i.e. if the GPPH pilot specific requirements below are met, an application will qualify for PPH treatment.

1.4 - Where two participating offices have a pre-existing bi-lateral PPH arrangement, the guidelines of the Global PPH pilot will take precedence over those of the existing bi-lateral arrangement for the duration of the pilot.

#### 2 Eligibility Requirements

2.1 – Offices will provide accelerated processing under the GPPH pilot for applications where the following requirements have been met:

- 1) The applications before the Office of Earlier Examination (OEE) and the Office of Later Examination (OLE) have the same earliest date (which may be the priority date or the filing date).
- 2) The OEE has found at least one claim to be allowable. The indication that a claim is allowable will be provided as an explicit statement in any substantive work product from the OEE. The claim(s) determined as novel, inventive and industrially applicable in the PCT work products has/have the meaning of allowable in this document.
- 3) All claims presented for examination under the GPPH pilot must sufficiently correspond to one or more of the claims found allowable by the OEE.
- 4) The OLE has not begun substantive examination of the application. However, OLE's may still choose to allow GPPH requests filed after examination of the OLE application has begun depending on the particular circumstances and needs of the OLE and its stakeholders.
- 5) A request for substantive examination must have been filed at the OLE, either at the time of the GPPH request or previously.

2.2 – Participating Offices may require that the OLE application is open to the public.

2.3 – Participating Offices may require the applicant to pay a fee for GPPH acceleration due to their respective legal requirements for accelerated processing.

2.4 – For an OEE application to be valid as the basis of a GPPH pilot request it must have been substantively examined, including consideration of novelty and inventive step, by an OEE participating in the GPPH pilot.

### 3 Supporting documentation required for GPPH request

3.1 – Participating offices will require the following documentation to support a request for acceleration under the GPPH pilot:

- 1) A completed GPPH request form;
- 2) A copy of the work product(s) which are relevant to the allowability of the claims of the corresponding OEE application, if not available via Dossier Access Systems; and
- 3) A copy of the claims found to be allowable by the OEE, if not available via Dossier Access Systems.

3.2 – Participating Offices may also require the applicant to provide the following documentation:

- 1) Copies of citations raised against the OEE application which are not available to the OLE via their regular databases or search files;
- 2) Translations of any of the documents listed in points 3.1 2) or 3) (see point 3.3 below); and
- 3) A claim correspondence table that shows the relationship between the claims of the OLE application and those of the OEE application that were considered allowable.

3.3 – Participating offices will use Dossier Access Systems and machine translations to access and assess supporting documentation to the maximum extent possible. If the participating office has difficulty in obtaining documents listed in points 3.1 2) or 3) and translations thereof, the applicant may be asked to submit them. When machine translations are determined by the OLE to be of insufficient quality, then the applicant may also be asked to provide manual translation.

### 4 Consideration of a GPPH request

4.1 - Requests for accelerated examination under the GPPH will be considered promptly by the OLE. Where a request for accelerated examination under the GPPH pilot is found to be deficient, the OLE will inform the applicant of the deficiencies and provide the applicant with at least one opportunity to correct the application within a reasonable period of time.

### 5 Miscellaneous Provisions

5.1 - Participating Offices will share basic statistical information and may conduct studies as appropriate, and as resources allow, in order to monitor usage and improve the quality of the system as a whole.

## Annex C

### Global PPH Principles

As a result of the success of the PPH Program, the maintenance of the many individual bilateral agreements between countries has become challenging. With that in mind, both applicants and participating offices would benefit from a single set of principles that form a world-wide PPH system. In addition, a common framework provides a baseline to which new PPH offices can subscribe without varying from the guidelines established by long-standing PPH partners. The following principles set the foundation for a global PPH system:

- Consistent with the “MOTTAINAI” concept, PPH eligibility will be based on work available from any participating office, regardless of OFF/OSF status, so long as the applications share the same effective date (priority or filing) and the disclosures support the claimed subject matter.
- Participating offices will accept any substantive search and examination product that explicitly indicates the patentability of claims (i.e., those including a written opinion if other than an initial notice to grant) done by another participating office under any filing scenario (e.g. as a National Office under the Paris Convention or as an ISA/IPEA office under the PCT).
- Claim correspondence will be interpreted and applied by participating offices as per the formulation agreed to in October 2012.
- Participating offices may require copies of prior office actions and/or decisional notices from the OEE and copies of any prior art cited that it cannot otherwise obtain, and should utilize dossier access systems and its internal search databases, respectively, for such purposes to the maximum extent practicable.
- Participating offices may require a copy of the allowed claims in the earlier office and/or a chart illustrating correspondence.
- Participating offices will accept machine translations of office actions, decisional notices, or allowed claims (as locally required) to the maximum extent practicable, but may require manual translations upon request from the examiner where necessary, e.g., if the quality of the machine translation is deemed of insufficient quality to assess the acceptability of the PPH request.
- Participating offices will allow at least one opportunity to correct a defect in the PPH request before finally refusing a PPH request.
- Participating offices may or may not accelerate applications for which PPH is requested after initiation of prosecution before the examiner, depending upon the circumstances and needs of each office and its stakeholder community.
- Participating offices will share basic statistical information and may conduct studies as appropriate—and resources allow—in order to monitor usage and improve the quality of the system as a whole by providing mutual feedback among them as to any gaps identified.
- Finally, participating offices reserve the right to limit participation in cases where incoming PPH requests exceed resources.