



## Requesting Patent Prosecution Highway (PPH) in the EPO or UK IPO

The aim of the Patent Prosecution Highway (PPH) is to provide a way for applicants to use positive examination results from one patent office to streamline prosecution in a second patent office. An evolving network of different PPH agreements exists between various patent offices, including most major patent offices.

For both the European Patent Office (EPO) and the UK Intellectual Property Office (UKIPO) requesting PPH results in acceleration of examination and does not guarantee allowance.

### The Main PPH Agreements

There is a large network of different PPH agreements, with new agreements regularly being made. The main PPH pathways are:

- IP5 PPH - an agreement between five of the biggest patent offices: the Chinese Intellectual Property Office (SIPO), Japanese Patent Office (JPO), Korean Intellectual Property Office (KIPO), EPO and the United States Patent and Trade Mark Office (USPTO). A PPH request in a participating patent office may be based on the results of examination of an application in another participating patent office or based on a PCT work product produced by a participating patent office. A PCT work product may be the written opinion from the International Searching Authority or International Preliminary Examining Authority, or an International Preliminary Examination Report. Using PCT work products is referred to as PCT-PPH.
- Global PPH (GPPH) - at the time of writing this includes 20 countries, including the USPTO, JPO, KIPO and UKIPO, but not the EPO or SIPO. GPPH can be based on the results of national examination or based on a PCT work product from any participating patent office.
- Bilateral Agreements - both the EPO and the UKIPO have established bilateral PPH agreements with other patent offices.

### Requirements to Request PPH

The exact requirements of PPH vary depending on the patent office and the specific agreement involved. Broadly speaking, the requirements in the UKIPO and the EPO are:

- The application on which PPH is being requested (“the second application”) has to be related to the application on which the PPH request is being based (“the first application”). How the two have to be related varies, but originating from the same PCT application or having a common parent or priority claim can be expected to suffice.
- At least one claim in the first application has to have been indicated as allowable and the claims of the second application have to “sufficiently correspond” to one of the claims indicated as allowable. Information must be provided, e.g. in the form of a table, showing how each claim of the second application corresponds to an allowed claim of the first application.
- A request for PPH has to be filed, together with copies of prosecution documents from examination of the first application, which may include the relevant prior art. If the documents provided are not in a language used by the second patent office, translations may be required.
- Examination of the second application on which PPH is being requested has not begun.

In the event that there is a deficiency in the PPH request, both the EPO and the UKIPO will provide an opportunity to rectify this. Requesting PPH at the EPO or the UKIPO does not entail payment of an official fee.

## PPH at the EPO

The EPO participates in a number of PPH agreements including IP5-PPH, but not GPPH. Thus, PPH can be requested at the EPO based on the results of examination from most of the major patent offices. At the time of writing, it is possible to base PPH at the EPO on a PCT work product (such as the International Preliminary Examination Report) or allowance in China, Japan, Korea, USA, Canada, Australia, Russia, Mexico, Singapore, Malaysia, the Philippines, Colombia, Israel or the Eurasian Patent Office.

More details of the requirements for requesting PPH based on a work product of another IP5 Office (JPO, KIPO, SIPO or US PTO) can be found in the [EPO Official Journal of January 2014](#).

If the EPO agrees to a PPH request, then this results in accelerated examination. The EPO will still conduct its own search and examination, and will independently consider whether the application meets the requirements of patentability under the EPC. It is important to appreciate that a PPH request does not therefore guarantee allowance. The EPO examiner may raise objections and so make adverse comments on claims allowed elsewhere. The EPO adopts a particularly strict approach to assessing whether amendments have basis in the application as filed and may object that particular amendments unallowably add matter, even though allowed elsewhere. The EPO examiner will also consider whether the claims meet the requirements of novelty, inventive step, support, clarity and enablement in accordance with EPC practice.

Using PPH at the EPO seems to reduce the number of examination reports required to bring the application to allowance in at least some technical areas. However, once the cost of preparing the PPH request is included, the cost of using PPH may not be much less than undergoing non-

PPH examination.

The EPO also offers its own accelerated search and examination which is separate from PPH. This acceleration procedure is known as PACE. PACE can be requested at any time for any application and does not involve the same formal requirements as a request for PPH. Requesting PACE does not entail the payment of any official fee and no reason needs to be given for the acceleration request. When seeking to accelerate prosecution of an application, a request for PACE has the same effect as a request for PPH, but a PACE request is less onerous, and it is more flexible in terms of claims that may be presented for examination. A PACE request must be filed on a dedicated form which the EPO does not place on the public file. In contrast, a PPH request will be placed on the public file. Therefore, there are advantages to using PACE rather than PPH.

## PH at the UKIPO

The UKIPO is a participant in Global PPH and at the time of writing also has a bilateral PPH agreement with SIPO.

At the UKIPO a PPH request is not a guarantee of allowance, but the UKIPO is generally more favourably disposed to PPH than the EPO is. Acceleration can also be requested at the UKIPO without using PPH. However, such a request must be supported by one of the acceptable reasons for acceleration. Thus requesting PPH may have more value at the UKIPO.

More details of the requirements for requesting PPH at the UK IPO can be found on the [UK IPO website](#).

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If you have any questions regarding PPH, please approach your usual contact at J A Kemp who will be able to advise.

**20 October 2017**