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European Patent Office /// Japan Patent Office ///
Korean Intellectual Property Office /// State Intellectual
Property Office of the People's Republic of China ///
United States Patent and Trademark Office

Agreed Record of Discussion between IP5 Heads of Office

Geneva, 23 September 2013

The world's five largest Intellectual Property Offices (IP5) - the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of China (SIPO) and the United States Patent and Trademark Office (USPTO) - met in Geneva on 23 September 2013 and agree as follows:

Having regard to the strategic direction of the IP5 cooperation as established in May 2007 and reviewed over the following years,

Having regard to the significance of promoting work sharing among the IP5 Offices,

Having regard to strengthening the PCT as the primary work sharing platform,

Having regard to the need for the IP5 Offices to deliver high quality products and services in a timely manner,

Having regard to the 6th IP5 Heads meeting held in June 2013 in Cupertino, USA, and the IP5 PPH experts meeting held also in June 2013 in Tokyo, Japan:

The IP5 Heads of Office agree to implement a comprehensive IP5 PPH programme. The programme will cover both PCT and Paris Route applications and its implementation will be based on the principles set out in the annex.

The IP5 Heads of Office further agree that the programme will commence in January 2014 for a period of three years. The IP5 Offices will explore and implement the initiatives and measures necessary to support the IP5 PPH programme, mainly as regards quality as well as the timely and efficient management of the PPH procedure.

Finally, the IP5 Heads of Office agree to publish a joint press release concerning the joint PPH programme, while the detailed participation requirements, request forms and instructions will be made available by the Offices in due course.

Done in Geneva, Switzerland, 23 September 2013 in five original copies.

EPO
Benoit Battistelli
President

JPO
Hideo Hato
Commissioner

KIPO
Young-min Kim
Commissioner

SIPO
He Hua
Deputy Commissioner

USPTO
Teresa Stanek Rea
Deputy Under Secretary of Commerce and Deputy Director of the USPTO

IP5 Patent Prosecution Highway pilot programme

A. Requirements for requesting participation in the IP5 PPH pilot programme

In order to be eligible to participate in the IP5 PPH pilot programme at the XXXX, the following requirements must be met:

(1) The XX application for which participation in the PPH pilot programme is requested must have the same earliest date whether this be the priority or filing date of a corresponding national applications filed with another IP5 Office or a corresponding PCT international application for which one of the IP5 Offices has been ISA and/or IPEA.

(2) The corresponding application(s) has/have at least one claim indicated by the OEE in its capacity as a national or regional Office, ISA and/or IPEA, to be patentable/allowable. The claim(s) determined as novel, inventive and industrially applicable by the ISA and/or IPEA has/have the meaning of patentable/allowable for the purposes of this document.

(3) All claims in the application for which a request for participation in the PPH pilot programme is made must sufficiently correspond to the patentable/allowable claims in the corresponding application(s). Claims are considered to sufficiently correspond where, accounting for differences due to claim format requirements, the claims are of the same or a similar scope or the claims in the application for which PPH is requested are narrower in scope than the claims in the corresponding application(s). In this regard, a claim that is narrower in scope occurs when an OEE claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). Additionally, a claim in the OLE application which introduces a new/different category of claims than those indicated to be patentable/allowable by the OEE is not considered to sufficiently correspond. For example, where the OLE claims only contain claims to a process of manufacturing a product, then the claims in the OLE application are not considered to sufficiently correspond if the OLE claims introduce product claims that are dependent on the corresponding process claims.

(4) Where applicable, substantive examination of the OLE application for which participation in the PPH pilot programme is requested has **not** begun.

B. Documents required for participation in the IP5 PPH pilot programme

For participation in the PPH pilot programme at the XXXX the applicant has to:

(1) file a request for participation in the PPH pilot programme. A request form (_____) is available via the XXXX website at _____;

(2) file a claims correspondence table

or

where applicable, a declaration of claims correspondence;

(3) submit a copy of

either all the office actions or, where applicable, the latest office action for the OEE corresponding application(s) containing the patentable/allowable claims that are the basis for the PPH request and a translation thereof in one of the acceptable languages at the XXXX,

or

the latest work product in the international phase of a PCT application, the WO-ISA or, where a demand under PCT Chapter II has been filed, the WO-IPEA or the IPER and a translation thereof in one of the acceptable languages at the XXXX.

(4) where applicable, submit a copy of the patentable/allowable claim(s) from the OEE application(s) and a translation thereof in one of the acceptable languages of the XXXX.

(5) submit copies of all the documents cited in the office action(s) or the PCT work product identified in point (3) above. If the cited document is a patent document, the applicant is not required to submit it, unless the XXXX has difficulty in obtaining it, in which case the applicant may be asked to submit it.

Where the request for participation in the PPH pilot programme is granted, the XX application will be processed in an accelerated manner. In those instances where the request for participation in the PPH pilot programme does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given at least **one** opportunity to correct deficiencies identified in the request. If the request is not corrected, the application will be taken out of the PPH programme and the applicant will be notified.

If any of the documents identified in points (3) and (4) above

(a) have already been filed in the XX application prior to the request for participation in the PPH pilot programme, it will not be necessary for the applicant to resubmit these documents with the PPH request. The applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot programme when these documents were previously filed in the XX application.

(b) are available via DAS (Dossier Access System) or Patentscope, the applicant does not need to submit a copy thereof, but has to provide a list of the documents to be retrieved. Machine translations will be admissible for the documents identified in points (3) and (4). The XXXX can request applicants to submit an accurate translation, if the machine translation is insufficient. If the OEE application(s) is (are) unpublished, the applicant must submit the documents identified in points (3) and (4) above upon filing the PPH request.