

fiveIPoffices

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

COMMON INSTRUCTIONS FOR THE IP5 PPH REQUEST FORMS

Prepared by the Five IP Offices

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1. Backgrounds

IP offices under PPH framework all use different style request forms, it leads to inconvenience for users. In order to reduce the burden of applicants and improve the user-friendliness and efficiency of PPH, a proposal named Common PPH Request Form was proposed with the purpose of providing a PPH request form which is simplified, unified and universal in separate offices for applicants.

A draft Common PPH Request Form was presented in 2013 and was widely supported by PPH participating offices. The final version was finalized in late 2014 after several rounds of development and revision. Up till now, the Common PPH Request Form has been implemented by the Swedish Patent and Registration Office (PRV), the Finnish Patent and Registration Office (PRH), the United Kingdom Intellectual Property Office (UKIPO), the State Intellectual Property Office of the People's Republic of China (SIPO), the European Patent Office (EPO), the Austrian Patent Office (APO), the Israel Patent Office (ILPO), the Hungarian Intellectual Property Office (HIPO), the Spanish Patent and Trademark Office (SPTO), the Portuguese Institute of Industrial Property (INPI), the Norwegian Industrial Property Office (NIPO), the United States Patent and Trademark Office (USPTO), IP Australia (IP AU), the Federal Service for Intellectual Property (ROSPATENT), the Canadian Intellectual Property Office (CIPO), the Danish Patent and Trademark Office (DKPTO), the Korean Intellectual Property Office (KIPO) and the Japan Patent Office (JPO).

The Common PPH Request Form shows unity and simplicity as well as a certain degree of flexibility. The form is based on existing forms currently used under different PPH agreements and retains the common practice of all the offices to the highest degree. Each office could add special items so as to satisfy its specific requirements of PPH request examination.

2. Common Instructions

So far the Common PPH Request Form has been implemented by the IP5 offices respectively, and the adopted PPH request forms share a common structure. The Common Instructions aims to explain the common structure of the IP5 adopted PPH request forms and briefly compare the difference of the forms so as to help applicants to a better understanding of the Common PPH Request Form and facilitate applicants searching, filing and using the form.

1) Common structure of the IP5 adopted PPH request forms

The common structure of the IP5 adopted PPH request forms consists of five sections, respectively, A. Bibliographic Data, B. Request, C. Required Documents, D. Claims Correspondence, E. Signature. Each section contains the following basic items.

Common Sections	Basic Items*
A. Bibliographic Data	<ul style="list-style-type: none"> Application number
B. Request	<ul style="list-style-type: none"> Office of Earlier Examination
	<ul style="list-style-type: none"> OEE Work Products Type
	<ul style="list-style-type: none"> OEE Application Number
C. Required Documents***	<ul style="list-style-type: none"> OEE work products and translations
	<ul style="list-style-type: none"> Patentable/allowable claims determined by OEE and translations**
	<ul style="list-style-type: none"> Documents cited in OEE Work Products
D. Claims Correspondence	<ul style="list-style-type: none"> Statement/Declaration of claims sufficient correspondence****
	<ul style="list-style-type: none"> Explanation of claims sufficient correspondence*****
E. Signature*****	<ul style="list-style-type: none"> Name(s) of applicant(s) or representative(s)
	<ul style="list-style-type: none"> Date
	<ul style="list-style-type: none"> Signature(s) of applicant(s) or representative(s)

Notes:

* Basic items refer to those items included in the the final version of the Common PPH Request Form which is agreed by all the offices in late 2014.

** USPTO does not require applicants to submit the copy of the patentable/allowable claims determined by OEE nor their translation.

- *** If the required documents are available online e.g. via “PATENTSCOPE or have been already submitted through simultaneous or past procedures, the applicants do not have to attach them.
- **** KIPO does not require the statement of claims sufficient correspondence in the request form.
The EPO requires applicants to submit the declaration of claims correspondence by clicking the relevant box in section D of the request form.
- ***** The EPO does not require applicants to explain the correspondence of the claims.
- ***** KIPO does not require the signature.











The above common structure should be completed as follows:

- A. Bibliographic Data
 - Under section A, please provide the application number of the application to be processed under the PPH.
- B. Request
 - Under section B, please provide information identifying the Office of Earlier Examination (OEE), the application number of the corresponding application that has been processed by the OEE as well as the OEE work product which is to be used as a basis for the PPH request.
- C. Required Documents
 - Under section C, please provide necessary documents relevant to the application to be processed under the PPH, if applicable, the translations as well.
- D. Claims Correspondence
 - Under section D, please provide information regarding claims correspondence.
- E. Signature (except KIPO)
 - Under section E, please provide the name(s), signature(s) of the applicant(s)/representative(s) and filing date.

2) Differences of the IP5 adopted PPH request forms

Although the overall structure of the IP5 adopted PPH request forms have been implemented in common layout, each office still has special requirements to be met due to its national law and specific language requirements, thus

there are differences in certain sections of the IP5 adopted PPH request forms. For details please refer to the following table.

Common Sections		Additional Items
A. Bibliographic Data		<ul style="list-style-type: none"> Filing date
		<ul style="list-style-type: none"> Filing date Title of the invention First named inventor Attorney Docket No.
B. Request		<ul style="list-style-type: none"> OEE application filing/priority date
		<ul style="list-style-type: none"> Statement of relationship between the application and the OEE application
		<ul style="list-style-type: none"> OEE application filing/priority date Mailing date of OEE work product
C. Required Documents		<ul style="list-style-type: none"> List of names and dates of documents submitted or omitted for submission
E. Signature		<ul style="list-style-type: none"> In JPO, the signature is placed in a document “Explanation of Circumstances Concerning Accelerated Examination” that is submitted with PPH request form
		<ul style="list-style-type: none"> Registration Number
		<ul style="list-style-type: none"> Explanations regarding Box VIII observations
		<ul style="list-style-type: none"> Explanations regarding special items

3. General Information

1) Implementation of the IP5 offices

The EPO has implemented the Common PPH Request Form as of 6 January 2015. The form of EPO also includes an explanatory notes so as to replace previous versions.

The JPO commenced procedures for request for the PPH by using common PPH request form from August 1, 2015. JPO also posted the instructions for JPO’s Common PPH Request Form.

The Common PPH Request Form was launched at the KIPO on 19 August 2015.

The SIPO has implemented the Common PPH Request Form as of 1 January 2015. The SIPO also posted filling instructions for filling out the form of SIPO.

The USPTO modified the Global/IP5 Request Form of USPTO to reflect the features of the Common PPH Request Form in January 2015. The Global/IP5 Request Form of USPTO includes the information from the Common PPH Request Form and includes additional requirements or modifications as required by USPTO and has the Privacy Act Statement of USPTO. A petition to make special under 37 CFR 1.102(a) is required in the USPTO and is incorporated into the modified form.

2) Website linkage

With regard to the detailed requirements for filling out the PPH Request Form of each office, please refer to the following linkage.

EPO	http://www.epo.org/applying/forms-fees/forms.html
JPO	http://www.jpo.go.jp/torikumi_e/t_torikumi_e/guideline_e.htm
SIPO	http://www.sipo.gov.cn/ztl/ywzt/pph/bgxz/201509/t20150908_1172056.html
USPTO	http://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track.html
KIPO	http://www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=100016&catmenu=ek02_02_03

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