



## Basing a Patent Prosecution Highway (PPH) Request on an allowed UK or EP Patent Application

The efficacy of PPH varies from territory to territory. In some patent offices there is a history of examination being influenced by the granting of a patent by particular patent offices; PPH may work well for such patent offices. In other patent offices, requesting PPH only results in acceleration and does not guarantee allowance.

### The Main PPH Agreements

There is a large network of different PPH agreements, with new agreements being made. In practice, however, the requirements for requesting PPH are very similar in most patent offices. Some of the main PPH pathways are:

**IP5 PPH** - an agreement between five of the biggest patent offices: the Chinese Intellectual Property Office (SIPO), European Patent Office (EPO), Japanese Patent Office (JPO), Korean Intellectual Property Office (KIPO), and the United States Patent and Trademark 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. Alternatively, it may be based on a positive report produced by a participating patent office on an International patent application; this is called a “PCT work product”. A PCT work product may be the Written Opinion from the International Searching Authority or International Preliminary Examining Authority or International Preliminary Examining Authority, or an International Preliminary Examination Report. Using PCT work products is referred to as PCT-PPH.

**Global PPH** - at the time of writing this includes over 25 countries, including the US PTO, JPO, KIPO and UK IPO, but not the EPO or SIPO. Global PPH can be based on the results of national examination from any of the participating patent offices or based on a PCT work product from a participating patent office.

**Bilateral Agreements** - both the EPO and the UK IPO have established bilateral PPH agreements with other patent offices.

Information regarding PPH and the different PPH agreements is collated by the Japanese patent office and is available [here](#).

### Requirements to Request PPH

The exact requirements of PPH vary depending on the patent office and the specific agreement involved. Broadly speaking, the most common requirements 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 in most countries.

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 the 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, patent offices will usually provide at least one opportunity to rectify any deficiencies.

### PPH Based on Allowed Claims of a UK Patent Application

The allowed claims of a UK patent application may be used as the basis for a PPH request in any country with which the UKIPO has a PPH agreement. At the time of writing, these are China, Brazil and the participants of Global PPH. A list of countries participating in Global PPH can be found [here](#). These countries include, amongst others, the patent offices of Japan, Korea, USA, Canada, Russia and Australia.

### PH Based on a Positive PCT Work Product from the EPO

A positive Written Opinion or International Preliminary Examination Report produced by the EPO in connection with an International patent application, may be used as the basis for a PPH request in a regional patent office or country with which the EPO has a PPH agreement. These are currently the Eurasian Patent Office (EAPO) and the patent offices of China, Japan, Korea, USA, Canada, Australia, Russia, Mexico, Singapore, Malaysia, the Philippines, Saudi Arabia, Colombia, Israel and Peru.

### PPH Based on Allowed Claims of a European Patent Application

The EPO participates in a number of PPH agreements including IP5-PPH, but not Global PPH. Claims allowed in a European patent application may, at the time of writing, form the basis of a PPH request in China, Japan, Korea, USA, Canada, Australia, Russia, Brazil, Mexico, Singapore, Malaysia, the Philippines, Colombia, Peru and Israel.

### For more information, please contact:

David Power – [dpower@jakemp.com](mailto:dpower@jakemp.com)