

## **Requirements and Procedures to File a request to IP Australia for the Patent Prosecution Highway Pilot Program between IP Australia and the USPTO**

### **Request to IP Australia for accelerated examination under PPH**

An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to IP Australia by submitting a letter requesting accelerated examination under the PPH accompanied by a completed PPH request form and the relevant supporting documentation as indicated on the PPH request form. The letter should clearly indicate that the applicant wishes accelerated examination to proceed under the PPH. A claim correspondence table should always be filed with the request for accelerated examination and a request for examination should also be filed if it has not previously been filed at IP Australia. The PPH request form is available at the IP Australia web site – [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au).

### **Requirements for requesting accelerated examination under the PPH pilot program at IP Australia**

There are four requirements for accelerated examination under the PPH pilot program at IP Australia. These are:

1. The Australian (AU) application is a standard complete application and is either:
  - (a) a nationally filed application which validly claims priority under the Paris convention from either a single USPTO national application or multiple USPTO applications; or
  - (b) a PCT national phase application where the PCT international application has validly claimed priority from a USPTO national application or multiple USPTO national applications; or
  - (c) a PCT national phase application where the PCT international application has no priority claims or
  - (d) a divisional of an application referred to in (a),(b) and (c).Diagrams illustrating examples of these application categories are provided at Annex A.
2. At least one corresponding USPTO application has one or more claims that are determined to be allowable by the USPTO. A corresponding USPTO application means either:
  - (a) a USPTO national application on the basis of which the AU application referred to under item 1 above claims priority, or
  - (b) a USPTO application that is a member of the same patent family (eg a continuation of a US application on the basis of which priority is claimed).
3. All claims in the standard patent application for accelerated examination under the PPH must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims indicated as allowable/patentable by the USPTO or be dependant upon or fall within the scope of such a claim. Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope. IP Australia shall consider corresponding USPTO claims to be allowable/patentable as indicated in a USPTO Office Action. A

USPTO Office Action includes a “Non-Final Rejection”, “Final Rejection”, “Ex parte Quayle” and a “Notice of Allowability”.

4. IP Australia has not issued a first examination report on the application.

#### **Required documents for accelerated examination under the PPH pilot program at IP Australia**

The following documentation will be needed to support a request for accelerated examination under the PPH pilot program at IP Australia:

1. a copy of the office action(s) on the corresponding USPTO application(s). The applicant can either provide these with the request for acceleration under the PPH or request that IP Australia obtain the documents required from the USPTO if these documents are publicly available on the USPTO Public PAIR system. The applicant must clearly identify the relevant information (document description and date) of the office actions to be retrieved from public PAIR on an attachment to the PPH request form.
2. a copy of the claims examined by the USPTO and copies of subsequent amended claims found to be allowable by the USPTO where appropriate. The applicant can either provide these with the request for acceleration under the PPH or request that IP Australia obtain the documents required from the USPTO if these documents are publicly available on the USPTO Public PAIR system. The applicant must clearly identify the relevant information (document description and date) of the claims to be retrieved from public PAIR on an attachment to the PPH request form.
3. a completed claim correspondence table showing the relationship between the claims of the IP Australia application for accelerated examination under the PPH and the claims of the corresponding USPTO application considered allowable by the USPTO. Sufficient correspondence of claims occurs where the claims are of the same or similar scope. A sample claim correspondence table is attached to the PPH request form.

Applicants may file citations and translations of USPTO citations as part of the supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the citations, if they so desire.

#### **Procedures for filing a request for accelerated examination under the PPH pilot program at IP Australia.**

The applicant files a letter requesting accelerated examination under the PPH pilot program to IP Australia, a completed PPH request form and the relevant supporting documents as noted above.

The request for accelerated examination under PPH may be made by mail or fax. The PPH request form is available online at the IP Australia website – [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au).

All subsequent correspondence with IP Australia relating directly to the PPH request must clearly identify the application as a PPH pilot program application to ensure that the correspondence is correctly processed.

The request for accelerated examination under the PPH pilot program must also be accompanied by, or preceded by a request for standard or modified examination.

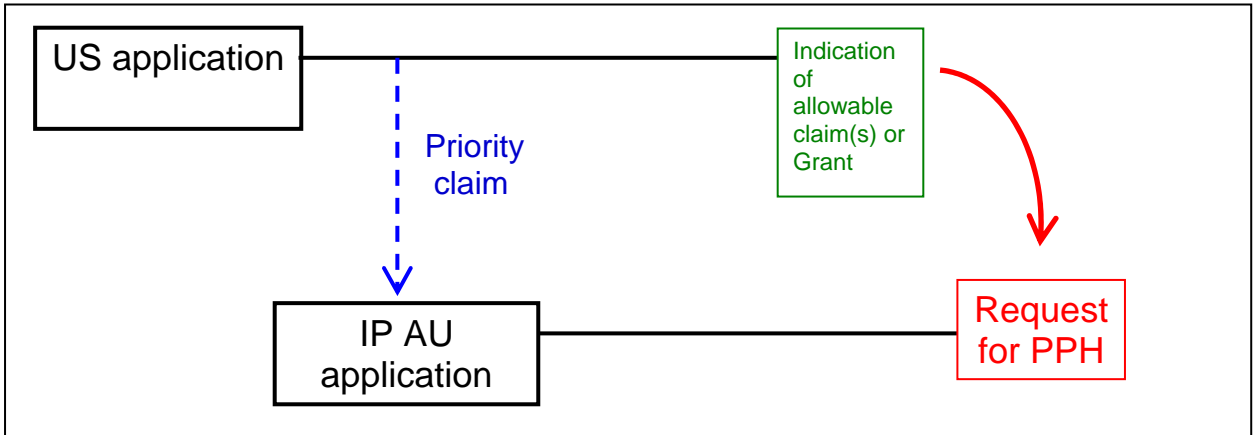
### **Procedures of examination under the PPH pilot program at IP Australia**

IP Australia will treat a request for accelerated examination under the PPH as a request for expedited examination under Australian law.

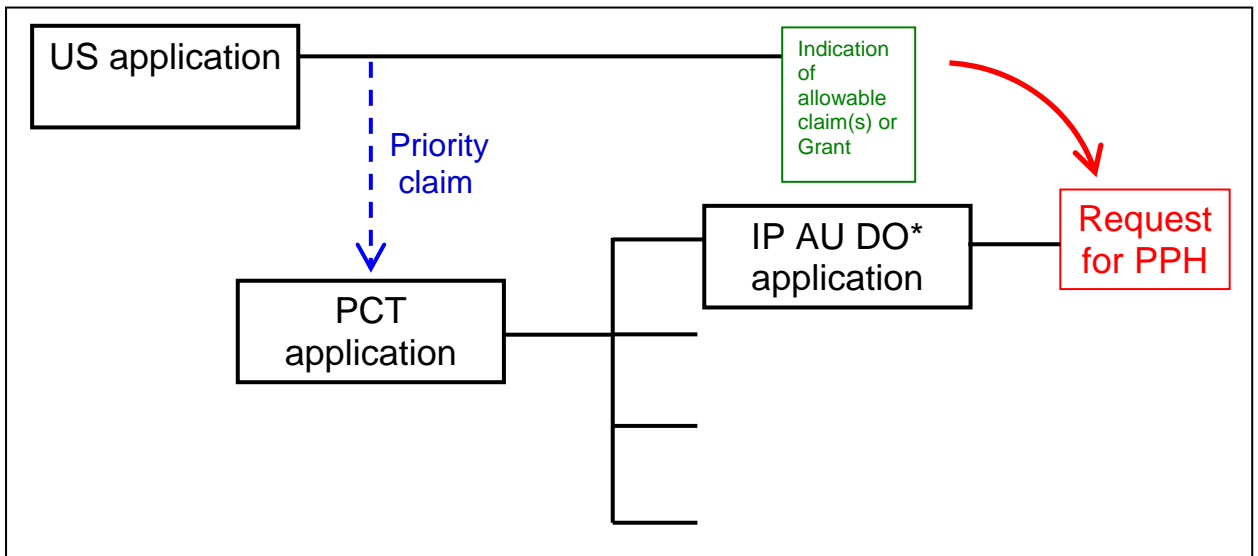
Examination of applications that satisfy the requirements for accelerated examination under the PPH will take account of the work performed previously at the USPTO. The application will be examined in accordance with the Patents Act 1990 and IP Australia's Manual of Practice and Procedures.

Enquiries in relation to the Patent Prosecution Highway from within Australia should be directed to IP Australia's Customer Service Centre on 1300 65 1010 or by email to [assist@ipaaustralia.gov.au](mailto:assist@ipaaustralia.gov.au). Enquiries from outside Australia can be directed to 61 2 6283 2999.

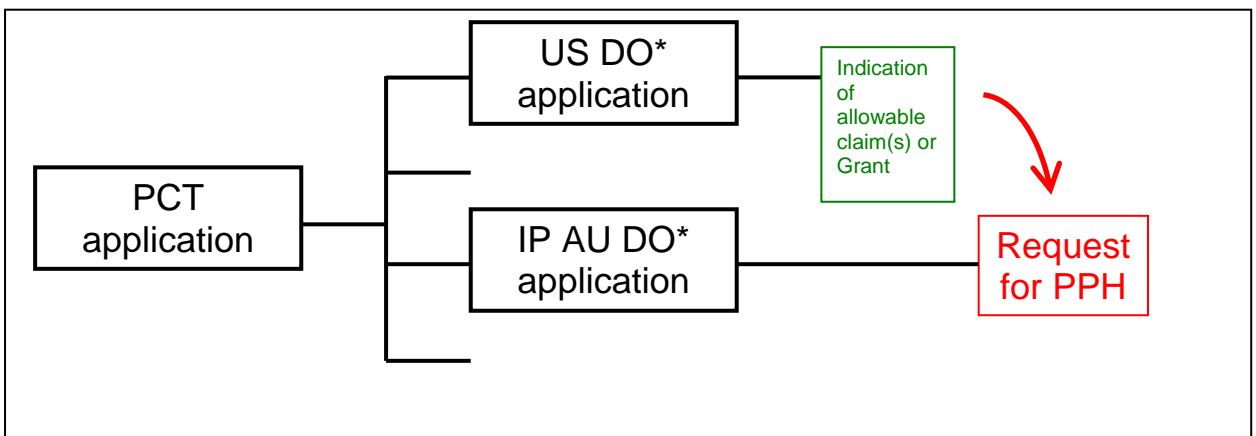
(a)



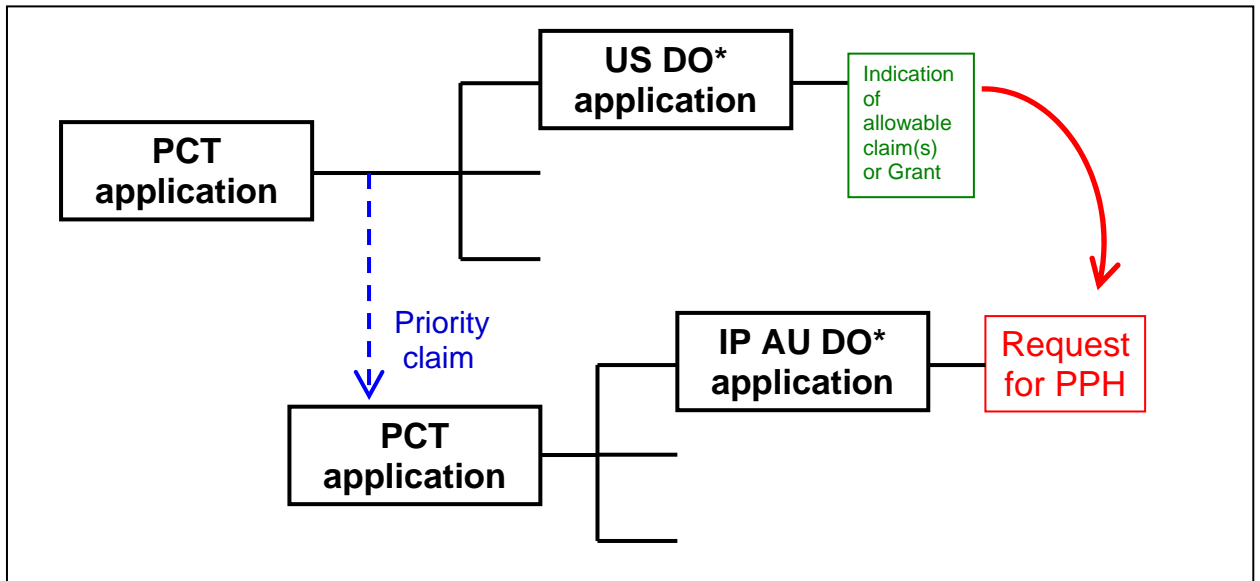
(b)



(c)



(d)



Note \*DO means Designated Office