

# Requirements and Procedures for the IP Australia-EPO PPH pilot program

## ***Background***

The IP Australia-EPO Patent Prosecution Highway (PPH) is a pilot program between IP Australia and the European Patent Office (EPO). This program leverages fast-track patent examination procedures already available at IP Australia and the EPO to allow applicants to obtain corresponding patents faster and more efficiently.

Under the IP Australia-EPO PPH pilot you are entitled to request expedited examination for your Australian (AU) application in instances where an associated application has been examined by the EPO and where at least one claim has been determined to be patentable/allowable.

The IP Australia -EPO PPH pilot program covers both Patent Cooperation Treaty (PCT) and Paris Route applications.

For the purpose of this notice:

- the Office of Earlier Examination (OEE) refers to the EPO, also in its capacity as International Search Authority (ISA) and/or International Preliminary Examination Authority (IPEA), the work product of which is used as a basis for the IP Australia -EPO PPH request;
- the Office of Later Examination (OLE) refers to IP Australia as the office before which participation in the IP Australia-EPO PPH pilot program is being requested.

## ***Requirements***

In order to be eligible to participate in the IP Australia-EPO PPH pilot program at IP Australia, your application must meet the following requirements:

### Requirement 1:

The AU application for which participation in the IP Australia -EPO PPH pilot program is requested must have the same earliest date with the corresponding application, whether this be the priority or filing date of a corresponding national application filed with the EPO or a corresponding PCT application for which the EPO has been the ISA and/or IPEA<sup>1</sup>).

The AU application is associated with the EP application in one of the following ways:

- I. The AU application claims priority from the EP application; or
- II. The AU and EP applications are both based on the same PCT

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<sup>1</sup> The IP Australia -EPO PPH program is not a mechanism for requesting expedited examination of an AU application where IP Australia was the ISA or IPEA and the PCT application is an Australian PCT application. You may instead consider requesting conventional expedited examination.

application; or

- III. The AU application and EP application claim priority from a common priority document. The priority document can be filed in any jurisdiction; or
- IV. The AU application is the basis of priority claim for the EP application; or
- V. The AU application is a divisional of an application referred to in i, ii, iii or iv above.

The AU application is associated with a PCT application in one of the following ways:

- I. The AU application is the PCT application and it has entered national phase; or
- II. The AU application claims priority from the PCT application; or
- III. The AU application is a priority document for the PCT application; or
- IV. The AU application is a divisional of an application referred to in i, ii, or iii above.

#### Requirement 2:

The corresponding application(s) must have at least one claim indicated by the EPO in its capacity as a national office or 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 notice.

#### Requirement 3:

All claims in the AU application for which a request for participation in the IP Australia -EPO PPH pilot program is made must sufficiently correspond to the patentable/allowable claims in the corresponding EP 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 are narrower in scope than the claims in the corresponding EP application(s). In this regard, a claim that is narrower in scope occurs when an EP claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). A claim which introduces a new/different category of claims to those claims indicated as allowable/patentable is generally not considered to sufficiently correspond. However where Australian law allows variation in category of claims applicants may consider adapting their claims, for example to include product by process claims.

#### Requirement 4:

A request for examination must either have been filed earlier or filed at the time of requesting acceleration under the IP Australia-EPO PPH pilot. Substantive examination of the AU application for which participation in the IP Australia -EPO PPH pilot program is requested must not have already begun.

#### ***Documents Required for Participation in the IP Australia -EPO PPH pilot program***

For participation in the IP Australia-EPO PPH pilot program at IP Australia the applicant has to:

- (1) file a [request for participation](#) in the IP Australia-EPO PPH pilot program;
- (2) file an indication of claims correspondence which is included in the Request Form;
- (3) submit a copy of  
either all the office actions for the OEE corresponding application(s) containing the patentable/allowable claims that are the basis for the IP Australia-EPO PPH request and a translation thereof in English,  
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 English.
- (4) submit a copy of the patentable/allowable claim(s) from the OEE application(s) and a translation thereof in English.

In those instances where the request for participation in the IP Australia-EPO PPH pilot program does not meet all the requirements set forth above, the applicant may be notified of the deficiencies in the request. The applicant will be allowed to correct deficiencies identified and if not corrected, the application may be taken out of the IP Australia-EPO PPH program.

#### ***Supporting Documents***

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

- (a) have already been filed in the AU application prior to the request for participation in the IP Australia-EPO PPH pilot program, it will not be necessary for the applicant to resubmit these documents with the IP Australia-EPO PPH request.

The applicant may simply refer to these documents and indicate in the request for participation in the IP Australia-EPO PPH pilot program when these documents were previously filed in the AU application.

- (b) are available via [Espacenet](#) 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).

IP Australia may request applicants to submit a verified translation of the documents identified in points (3) and (4) above if they are 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 IP Australia-EPO PPH request.

### ***Examination of the AU application under the IP Australia-EPO PPH pilot***

Once the request for participation in the IP Australia-EPO PPH has been approved, IP Australia will treat this request for accelerated examination under the IP Australia-EPO PPH as a request for expedited examination under Australian law.

Examination of AU applications that satisfy the requirements for accelerated examination under the IP Australia-EPO PPH will take account of the work performed previously by the OEE.

The AU application will be examined in accordance with the Patents Act 1990, Patents Regulations 1991 and IP Australia's Manual of Practice and Procedures.

### ***How to File a Request for Participation***

The documents required for participation in the IP Australia-EPO PPH can be filed with IP Australia by either mail or via eServices.

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

The request for expedited examination under the IP Australia-EPO PPH pilot program must also be accompanied by, or preceded by, a request for standard examination.

As with a conventional request for expedited examination, additional fees beyond standard examination are not required when requesting expedited examination under the IP Australia-EPO PPH.

### ***Enquiries***

Enquiries in relation to the IP Australia-EPO Patent Prosecution Highway from within Australia should be directed to IP Australia's Customer Service Centre on 1300 65 1010.

Enquiries from outside Australia can be directed to +61 2 6283 2999.