

Procedures to file a request to the DKPTO for Patent Prosecution Highway Pilot Program between the DKPTO and the USPTO

April 27, 2011

Request to the DKPTO

[0001] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the DKPTO by submitting a letter requesting accelerated examination under the PPH accompanied by the relevant supporting documents including a completed PPH request form. The requirements for an application to the DKPTO for accelerated examination under the PPH are given in the following section. Relevant supporting documentation is discussed in a later section (paragraphs [0003]-[0005]) as is the general DKPTO application procedure envisaged at this time (paragraph [0006]-[0007]).

Requirements for requesting accelerated examination under the PPH Pilot Program at the DKPTO

[0002] There are four requirements for requesting accelerated examination under the PPH pilot program at the DKPTO. These are:

- a) ***The DKPTO application (including PCT national phase applications) is:***
- (i) an application which validly claims priority under the Paris Convention to the USPTO application(s) (examples are provided in Annex I, figure A, B, C, D, E and F)
 - (ii) a PCT national phase application without priority claim (direct PCT applications) (an example is provided in Annex I, figure G), or
 - (iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in Annex I, figure H, I and J).

A DKPTO application which validly claims priority to multiple USPTO or PCT applications, or which is a divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

- b) ***At least one corresponding USPTO application has one or more claims that have been determined to be patentable by the USPTO.***

Claims clearly identified to be patentable by the USPTO in the latest office action at examination stage can form the basis of a request for an accelerated examination under the PPH pilot program even if the USPTO has not yet granted a patent for those claims. If the USPTO office action does not explicitly state that a particular claim is patentable, applicant must include a statement that no rejection has been made in the USPTO office action regarding the claim and therefore, the claim is deemed patentable by the USPTO. Such a statement must be included in the letter requesting participation in the PPH pilot program which accompanies the request form, cf section [0004] below.

c) ***All claims in the DKPTO application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as patentable in the USPTO.***

All claims on file as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the DKPTO are of the same or similar scope as the claims in the USPTO, or the claims in the DKPTO are narrower in scope than the claims in the USPTO.

In this regard, a claim that is narrower in scope occurs when a USPTO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims).

A claim in the DKPTO which introduces a new/different category of claims to those claims indicated as allowable in the USPTO is not considered to sufficiently correspond. For example, the USPTO claims only contain claims to a process of manufacturing a product, then the claims in the DKPTO are not considered to sufficiently correspond if the DKPTO claims introduce product claims that are dependent on the corresponding process claims.

d) ***The DKPTO has not yet issued a communication stating an intention to grant.***

The heading for such a communication will either be "Berigtigelse af bilag" or "Godkendelse".

Required documents for accelerated examination under the PPH pilot program at the DKPTO

[0003] The following documentation will be needed to support a request for accelerated examination under the PPH pilot program at the DKPTO:

a) ***A copy of the office action(s) relating to the corresponding USPTO application(s).***

The term "office actions" is here used about the correspondence sent to the applicant or the applicant's representative from the USPTO examiner. The applicant can either provide the office actions together with the request for acceleration under the PPH or request that the DKPTO obtain the documents from the USPTO Public PAIR system.

It is noted that applicants must also submit copies of any office actions (which are relevant to patentability) from the USPTO application(s) issued after the grant of the request for participation in the PPH pilot program in the DKPTO (especially where USPTO might have reversed a prior holding of allowability/patentability).

b) ***A copy of the claims determined to be patentable by the USPTO including any subsequent amended claims found to be patentable by the USPTO.***

The applicant can either provide the claims together with the request for acceleration under the PPH or request that the DKPTO obtain the claims from USPTO Public PAIR system.

c) *A completed claim correspondence table showing the relationship between the claims of the DKPTO application for accelerated examination under the PPH and the claims of the corresponding USPTO application considered patentable by the USPTO.*

Sufficient correspondence of claims occurs where the claims are of the same or similar scope as defined above in section [0002]c. The claim correspondence table must indicate how all the claims in the DKPTO application correspond to the patentable claims in the USPTO application as shown in Annex III. The claim correspondence table must be written in either English or Danish.

Any claims amended or added after the grant of the request for participation in the PPH pilot program must sufficiently correspond to one or more allowable/patentable claims in the USPTO application(s). Applicant is required to submit a new claims correspondence table along with the amendments. If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the DKPTO application(s), the amendment will not be entered.

d) *A copy of the references cited by the USPTO examiner.*

If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the DKPTO. If the DKPTO does not have access to the relevant patent documents, the applicant must submit these documents at the request of the DKPTO. Non-patent literature must always be submitted.

[0004] The applicant is required to complete a form for requesting accelerated examination under the PPH pilot program (as given in Annex II below) which will be available for download from the DKPTO's website. The form must be sent to the DKPTO along with a letter requesting acceleration under the PPH and the relevant supporting documentation.

[0005] In those rare situations where the US application has not been published, and therefore the US file wrapper is not available via USPTO Public PAIR system, applicant will be responsible for providing the necessary documents to the DKPTO.

The applicants need not provide further copies of documentation, if the applicant has already submitted the documents noted above to the DKPTO through simultaneous or past procedures.

Procedure for accelerated examination under the PPH Pilot Program at the DKPTO

[0006] The applicant files a letter requesting accelerated examination under the PPH Pilot Program to the DKPTO, including the relevant supporting documents as noted above and a completed request form (as given in Annex II below and also available from DKPTO's website). The application for accelerated examination under the PPH may be made by e-mail or normal mail, but must in any case include a completed request form and the relevant supporting documents.

E-mail requests for PPH processing at the DKPTO must be sent to: pvs@dkpto.dk.

PPH requests sent by conventional mail must be sent to:

The Danish Patent and Trademark Office
Helgeshøj Allé 81
2630 Taastrup

The PPH request form should be the uppermost document when applying for accelerated examination by conventional mail to ensure that the request is correctly processed.

[0007] The PPH administrator will consider the request and if all requirements are met the PPH administrator will notify the relevant examining group. The DKPTO's patent examiners will conduct the accelerated examinations.

ANNEX I

Figure A:

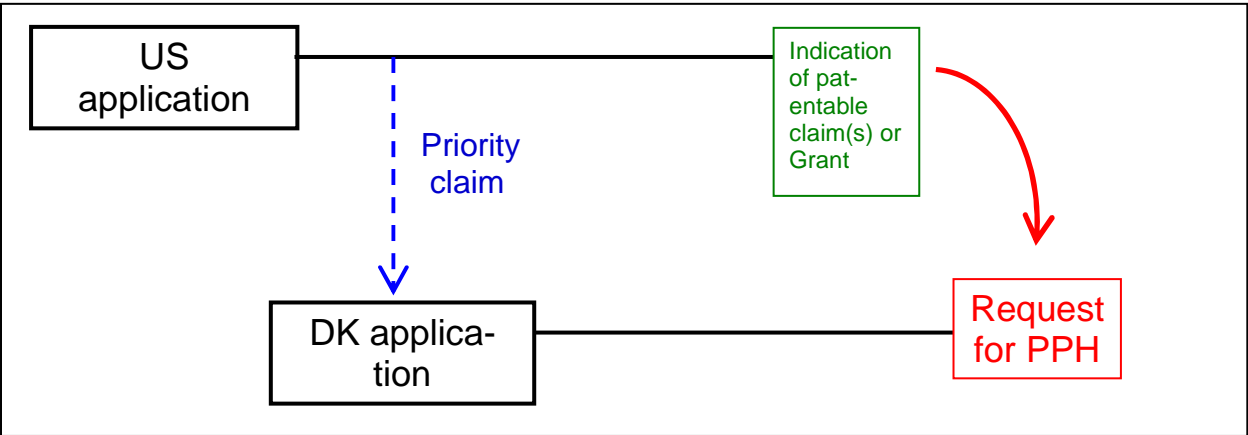


Figure B:

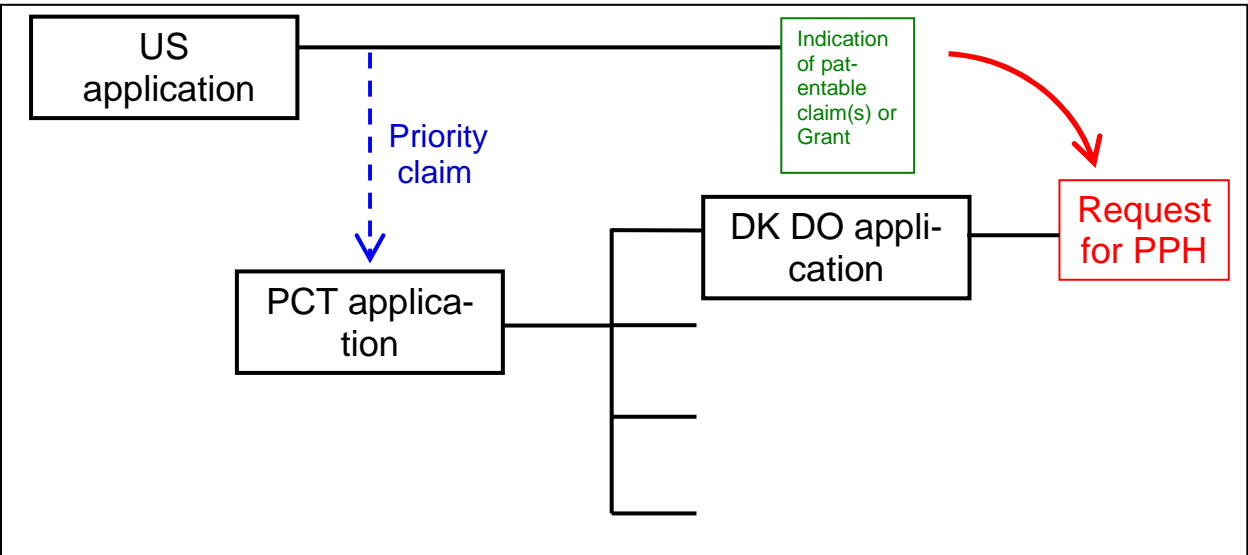


Figure C:

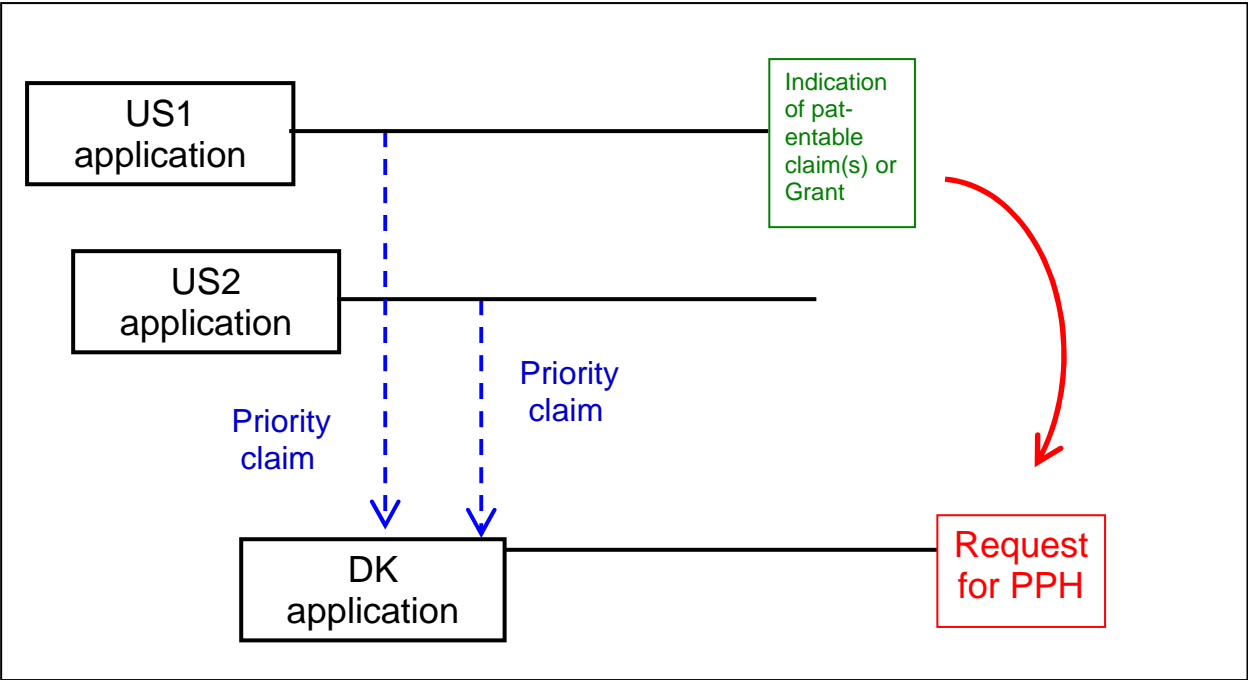


Figure D:

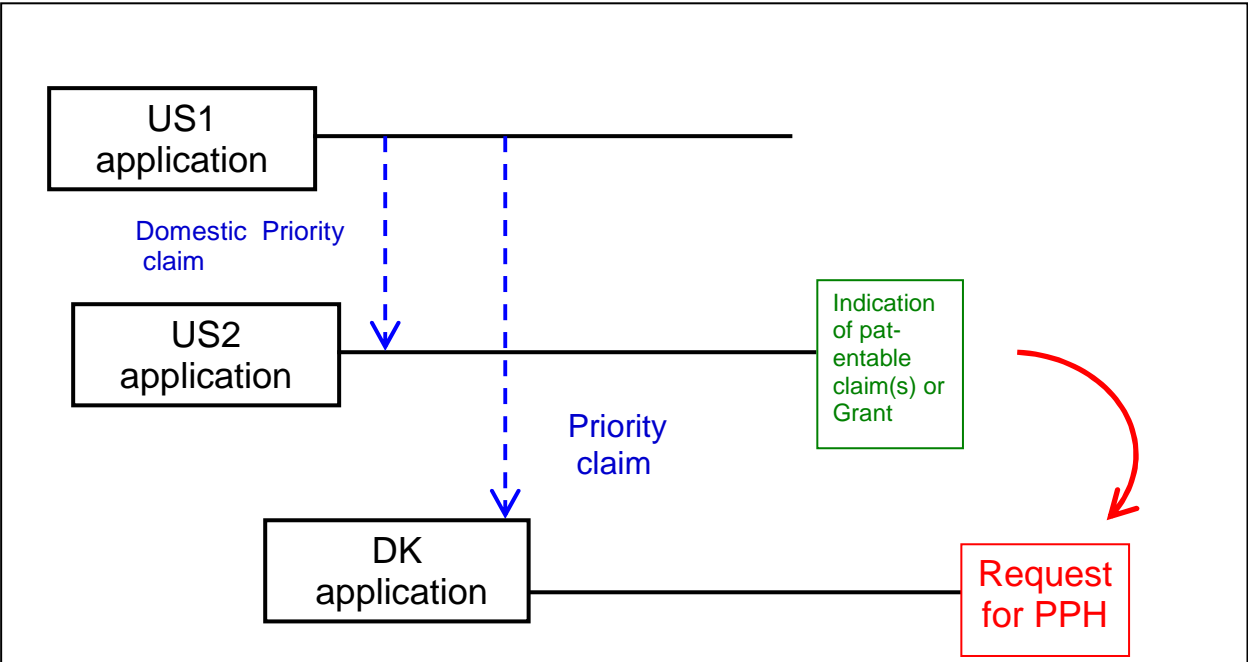


Figure E:

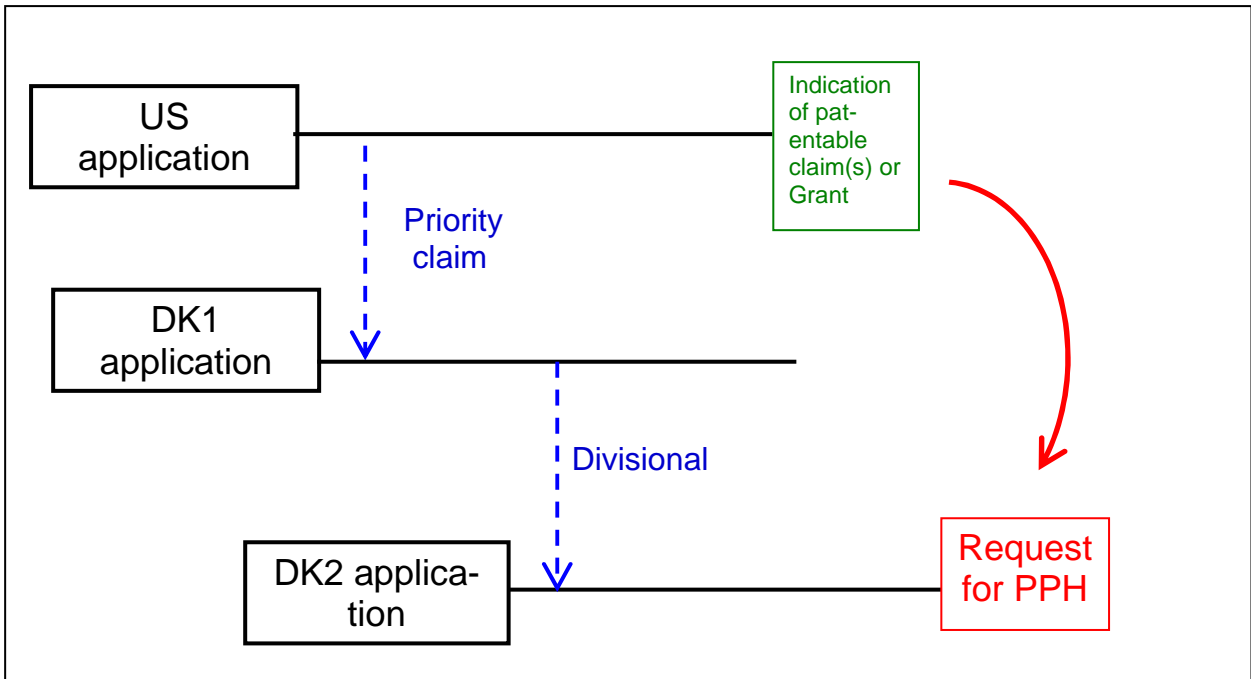


Figure F:

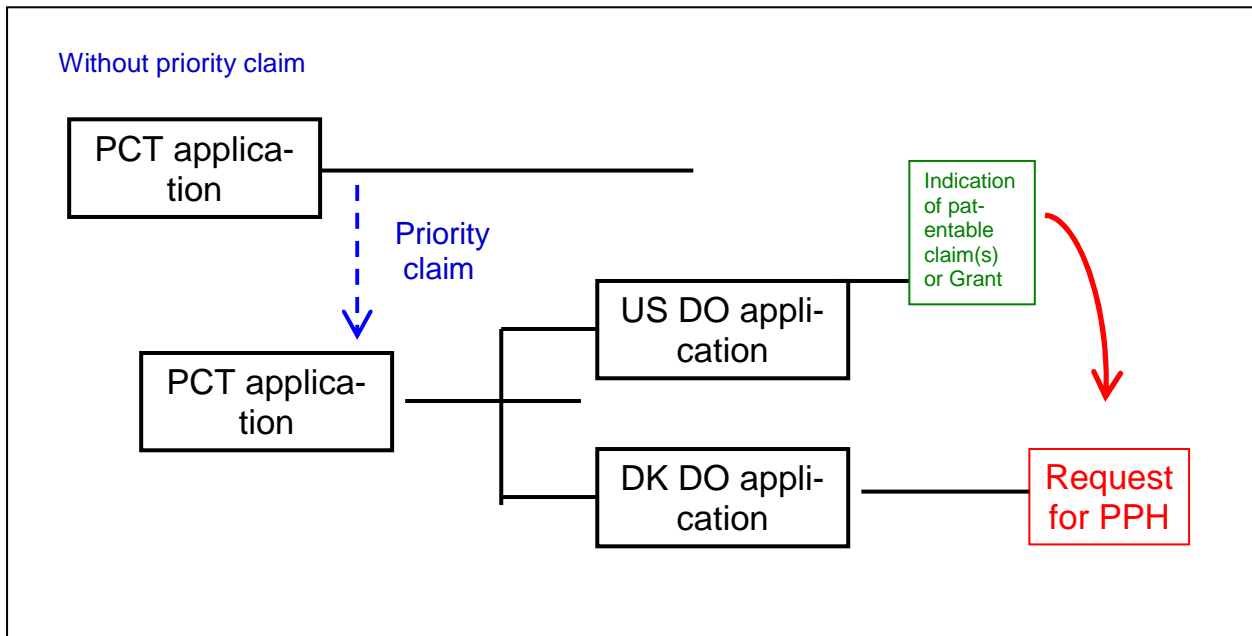


Figure G:

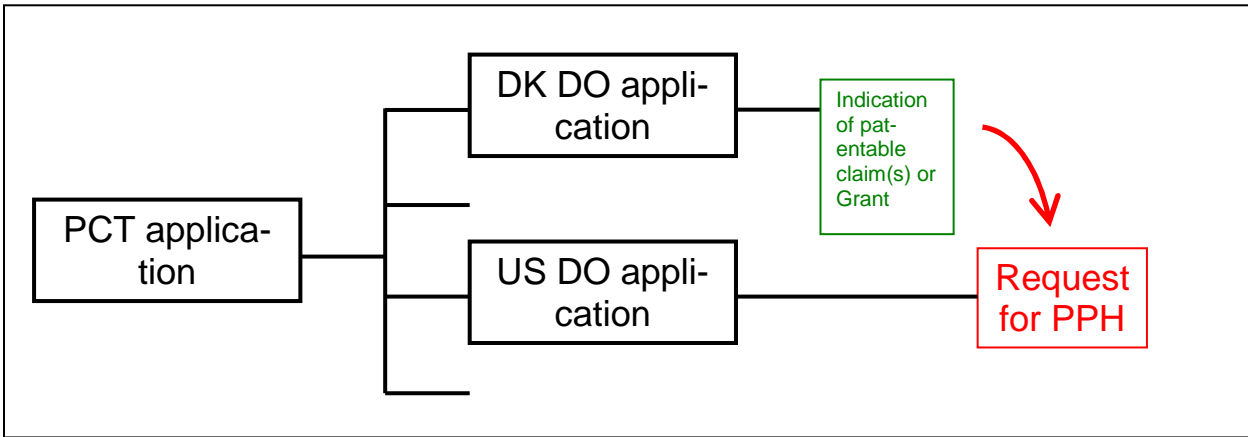
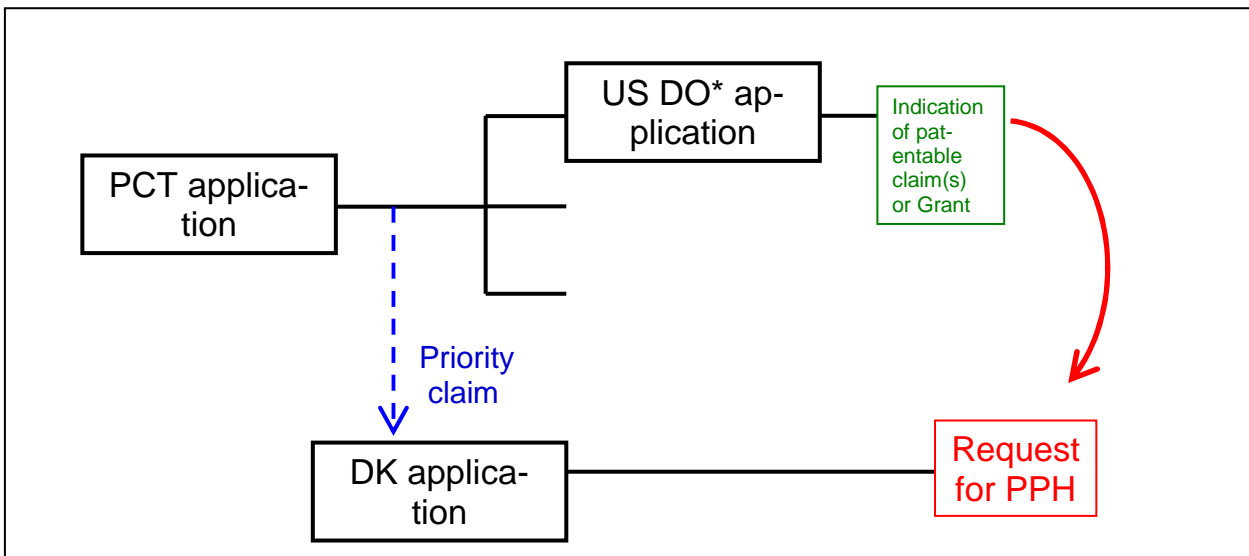


Figure H:



* DO – Designated Office

Figure I:

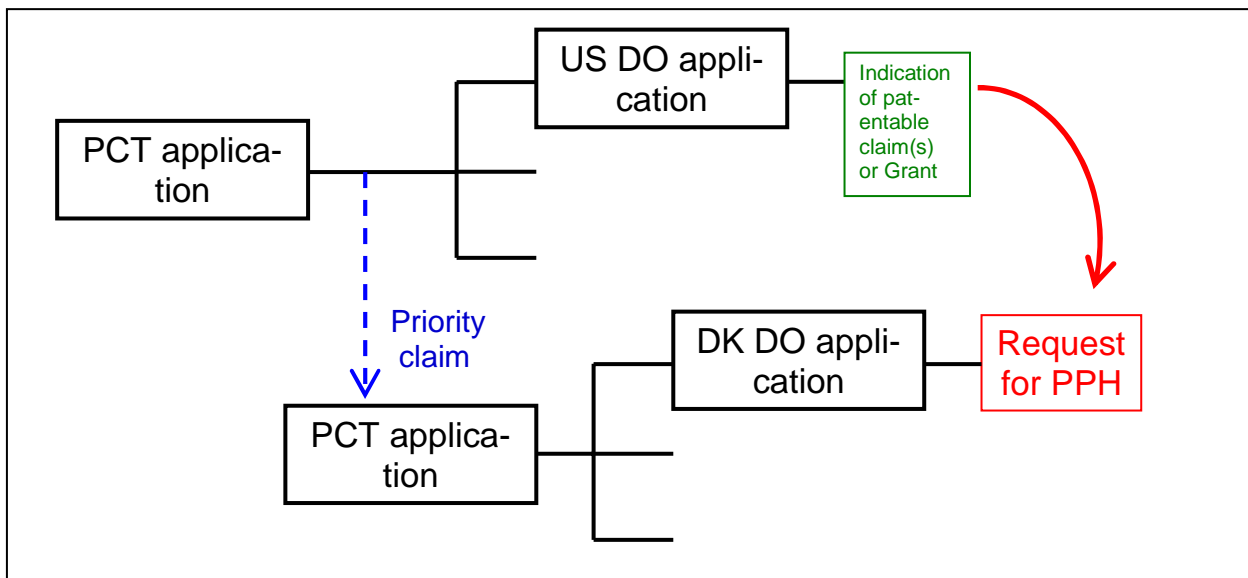
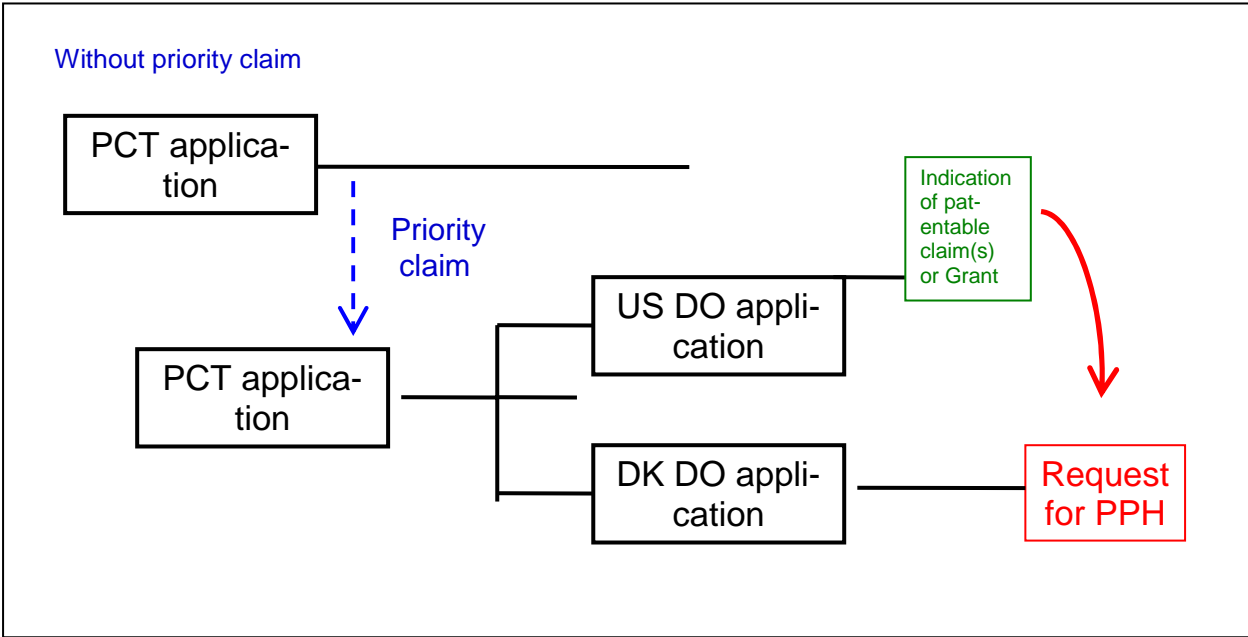


Figure J:



PPH REQUEST

Request for Accelerated Examination at the DKPTO Under the Patent Prosecution Highway Pilot Program Between the DKPTO and the USPTO

- 1** DK application number:
Corresponding US application number(s):
- 2** **Either:**
- a) Copy of USPTO office action(s) attached:
- or**
- b) USPTO office action(s) available via Public PAIR:
- or**
- c) USPTO office action(s) on file from previous PPH application:
DK application number:
- 3** **Either:**
- a) Copy of claims of corresponding US application attached:
- or**
- b) Claims of corresponding US application available via Public PAIR:
- or**
- c) US application claims on file from previous PPH application:
DK application number:
- 4** Claim correspondence table completed:

Please ensure that this is the uppermost document when requesting accelerated examination under the PPH.

