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Procedure to file a request to the DPMA for participation in the Patent Prosecution Highway Pilot Program between the DPMA and the USPTO

1. The outline of the Patent Prosecution Highway Pilot Program

The Patent Prosecution Highway (PPH) pilot program enables an application whose claims have been determined to be patentable in the Office of First Filing (OFF) to undergo an accelerated examination in the Office of Second Filing (OSF) with a simple procedure, at the request of the applicant.

2. Request to the DPMA

An applicant has to file a request for accelerated examination under the PPH to the DPMA in German language by submitting a form for requesting accelerated examination under the PPH pilot program accompanied by the relevant supporting documents. The requirements for an application to the DPMA for accelerated examination under the PPH are given in the following section. Relevant supporting documentation is discussed in a later section (paragraph 4) as is the general DPMA application procedure envisaged at this time (paragraph 5).

3. Requirements for requesting accelerated examination under the PPH Pilot Program at the DPMA

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

a) Either:

- i) the DPMA application validly claims priority under the Paris Convention from either a single corresponding USPTO application or multiple USPTO applications; or

- ii) the DPMA application arises from a PCT national phase application where the PCT international application has validly claimed priority from a USPTO national application; or
- iii) the DPMA application is a divisional of an application met in the above i) or ii).

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

c) All claims in the DPMA application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as patentable in the USPTO. Claims shall be considered to sufficiently correspond where the claims are of the same scope such that the claims in the DPMA application have a common technical feature with the claims in the USPTO application which makes the claims allowable over the prior art in the corresponding USPTO application. Where amended claims have been determined to be patentable by the USPTO, the claims of the DPMA application should be such that they correspond to the amended claims of the USPTO application. Claims of the DPMA application which are appended to earlier claims of the DPMA application corresponding to claims that are indicated as patentable by the USPTO will also be considered where such claims fall within the scope of the claims indicated as patentable by the USPTO.

d) The DPMA has not begun examination of the application.

4. Required documents for accelerated examination under the PPH Pilot Program at the DPMA

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

- a) a copy of all office actions on the corresponding USPTO application(s). Copies of USPTO office actions in English language are accepted and need not, as a rule, be translated into German. No copy of the office actions need be supplied if the office actions are available via the website of the USPTO. Should the office actions in English language not be comprehensible to the DPMA examiner, he may request an additional translation into German from the applicant.
- b) a copy of the claims examined by the USPTO and copies of subsequent amended claims found to be patentable by the USPTO where appropriate. No paper copy of the claims need to be supplied if the claims are available via the website of the USPTO. Should the claims in English language not be comprehensible to the DPMA examiner, he may request an additional translation into German from the applicant.
- c) a completed claim correspondence table in German language showing the relationship between the claims of the DPMA 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 scope as defined above. When claims are just literal translation, the applicant can just write down that "they are same" in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim based on the criteria 3c).
- d) a copy of the document(s) cited by the USPTO examiner.

If the cited document is a patent document it does not have to be submitted as it is generally available to the DPMA either via DEPATIS, EPOQUE or other search systems. Where the DPMA has difficulty in obtaining a patent document the Office will ask the applicant to submit it.

As a rule, cited documents need not be translated.

The applicant has to provide the relevant information by filling in a form for requesting accelerated examination under the PPH pilot program which will be made available for download from the DPMA website. The form should be sent to the DPMA along with the relevant supporting documentation.

If the applicant has already submitted the above documents a) to d) to the DPMA through simultaneous or past procedures, the applicant can incorporate the documents by reference and does not have to attach them.

5. Procedure for accelerated examination under the PPH Pilot Program at the DPMA

The applicant files a form requesting accelerated examination under the PPH pilot program to the DPMA, including the relevant supporting documents. If the requirements are met, the DPMA will conduct the accelerated examination. If the application does not qualify for participation in the PPH project, the applicant will be informed accordingly and the application will be further processed under the standard DPMA examination procedure, without acceleration.

6. Procedure before the USPTO

Information on the participation in the pilot program at the USPTO is available on the website of the USPTO at:

www.uspto.gov/web/patents/pph/pph_dpma.html