Deutsches
Patent- und Markenamt

Procedures to File a Request to the DPMA for Participation in the Global Patent Prosecution Highway Pilot Programme

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PPH 1029.1/10.25

Contents

1. The outline of the Patent Prosecution Highway pilot programme 3

2. Request to the DPMA 3

3. Requirements for requesting accelerated examination under the GPPH pilot programme at the DPMA 3

4. Required documents for accelerated examination under the GPPH pilot programme at the DPMA 4

5. Procedure for accelerated examination under the GPPH pilot programme at the DPMA 4

Annex: 5

A Case I Paris route 5

B Case I PCT route 5

C Case II Paris route 6

D Case II PCT route 6

E Case III Paris route & domestic priority or divisional application 7

F Case III PCT route & domestic priority or divisional application 7

G Case III Application from third country & Paris route 8

H Case III PCT route 1/first application from third country 8

I Case III PCT route 2/first application from third country 9

J Case III PCT route 9

K Case III Direct PCT route & PCT route 10

L Case IV Direct PCT route 10

1. The outline of the Patent Prosecution Highway pilot programme

The Global Patent Prosecution Highway (GPPH) pilot programme enables an application whose claims have been determined to be patentable by one of the offices participating in the GPPH (https://www.jpo.go.jp/e/toppage/pph-portal/network.html) as Office of Earlier Examination (OEE) to undergo an accelerated examination at the German Patent and Trade Mark Office (DPMA) with a simple procedure according to a request from an applicant.

2. Request to the DPMA

The requirements for a request for accelerated examination under the GPPH at the DPMA are given in the following section (paragraph 3). Relevant supporting documentation is discussed in a later section (paragraph 4) as is the general DPMA application procedure envisaged at this time (paragraph 5).

An applicant has to file a request for accelerated examination under the GPPH to the DPMA in German language by submitting a request form for accelerated examination under the GPPH pilot programme accompanied by the relevant supporting documents. This form is 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 documents indicated in 4a) 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.

3. Requirements for requesting accelerated examination under the GPPH pilot programme at the DPMA

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

a) Both the DPMA application on which PPH is requested and the OEE application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).

For example, the DPMA application (including PCT national phase application) may be either:

(Case I) an application which validly claims priority under the Paris Convention from the OEE application(s) (examples are provided in the annex, figures A and B),

or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the OEE application(s) (including PCT national phase application(s)) (examples are provided in the annex, figures C and D),

or

(Case III) an application which shares a common priority document with the OEE application(s) (including PCT national phase application(s)) (examples are provided in the annex, figures E, F, G, H, I, J and K),

or

(Case IV) a PCT national phase application where both the DPMA application and the OEE application(s) are derived from a common PCT international application having no priority claim (example is provided in the annex, figure L).

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

c) All claims in the DPMA application, as originally filed or as amended, for examination under the GPPH must sufficiently correspond to one or more of those claims indicated as allowable (patentable) by the OEE.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the DPMA application are of the same or similar scope as the claims in the OEE application, or the claims in the DPMA application are narrower in scope than the claims in the OEE application. "Claim format" means the formal version of the claims.

Claims are of the same scope if the claims in the DPMA application present the same technical features as the claims in the OEE application, which have made the claims allowable over prior art in the corresponding OEE application.

Claims are of a similar scope if the differences between the claims in the OEE application and those in the DPMA application are solely due to the translation or the claim format and do not deviate from the original disclosure.

In this regard, a claim that is narrower in scope occurs when an OEE 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 DPMA application which introduces a new/different category of claims to those claims indicated as allowable by the OEE is not considered to sufficiently correspond. For example, where the OEE claims only contain claims to a process of manufacturing a product, then the claims in the DPMA application are not considered to sufficiently correspond if the DPMA application claims introduce product claims that are dependent on the corresponding process claims.

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

This means that the DPMA has not yet sent a first office action (*Erstbescheid*) to the applicant after the request for examination.

4. Required documents for accelerated examination under the GPPH pilot programme at the DPMA

With regard to the required documents, German, English and French are acceptable languages. However, if the available (machine) translation is insufficient, the DPMA examiner may request an additional translation from the applicant.

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

a) **A copy of all office actions on the corresponding OEE application(s)**

Office actions of the OEE are the search report(s), the substantive examination reports, the work product of a PCT authority (WO-ISA, WO-IPEA, IPER) and the decision to grant a patent. Annex F of the framework provisions for the GPPH system contains for each office participating in the GPPH a list of all work products on which a PPH request to the DPMA can be based.

If these documents are available online via a dossier access system the applicant does not have to submit them and only has to list up the names of the documents. A compilation of the respective dossier access systems of the offices participating in the GPPH is available at: https://www.jpo.go.jp/e/toppage/pph-portal/links.html.

b) **A copy of the claims found to be patentable by the OEE where appropriate**

There is no need to submit a copy of the claims if they are available online via a dossier access system (https://www.jpo.go.jp/e/toppage/pph-portal/links.html).

c) **A completed claim correspondence table showing the relationship between the claims of the DPMA application for accelerated examination under the GPPH and the claims of the corresponding OEE application considered patentable by the OEE**

Sufficient correspondence of claims occurs where the claims are of such a scope as defined under 3c).

When claims are just literally translated, the applicant can just write down that "they are the same" in the table.

When claims are not just literally translated the applicant is allowed to explain the sufficient correspondence of each claim based on the criteria under 3c).

In all cases of doubt the examiner may request an explanation of each claim based on the criteria under 3c) from the applicant; otherwise, the claims are presumed to correspond.

d) **A copy of the document(s) cited by the OEE 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 or EPOQUE. Where the DPMA has difficulty in obtaining a patent document, it will ask the applicant to submit it. As a rule, cited documents need not be translated.

5. Procedure for accelerated examination under the GPPH pilot programme at the DPMA

The applicant files a request form for accelerated examination under the GPPH pilot programme to the DPMA, including the relevant supporting documents.

a) If the requirements are met, the DPMA will conduct an accelerated examination.

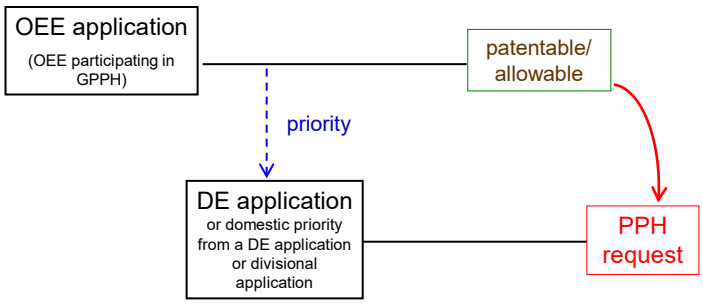
b) If the application does not qualify for participation in the GPPH pilot programme, the applicant will be informed accordingly and the application will be further processed under the standard DPMA examination procedure, without acceleration.

Note: in those instances where the request does not meet all the requirements, the applicant may correct deficiencies and resubmit the PPH request. Before the issuing of the notification of not approving accelerated examination under the GPPH pilot programme, the applicant may submit missing documents. Even after the issuing of the notification of not approving accelerated examination under the GPPH pilot programme, the applicant may file another PPH request so long as the request is filed before the issuing of the first office action.

Annex:

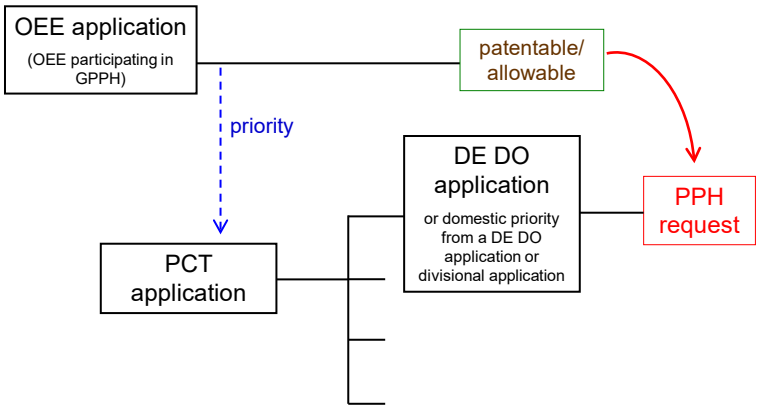
A

Case I
Paris route



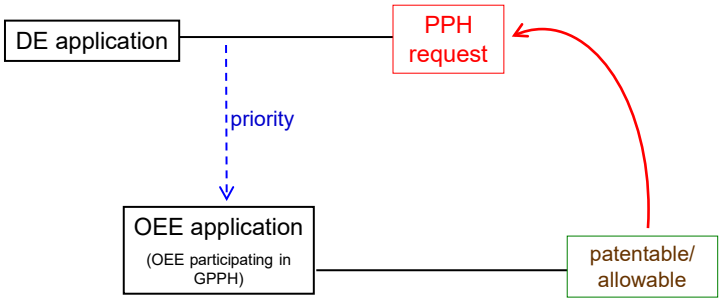
B

Case I
PCT route



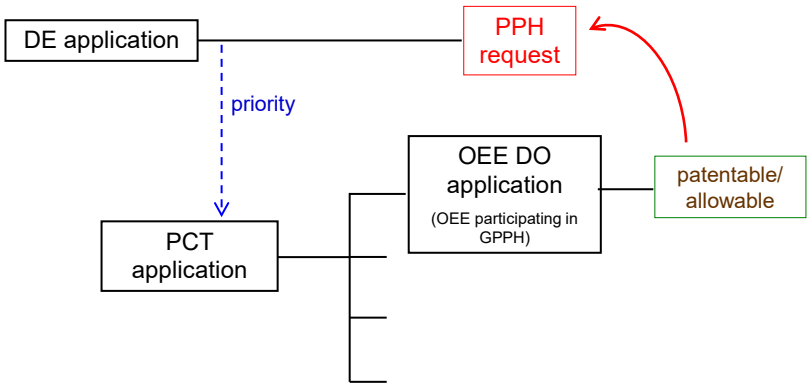
C

Case II
Paris route



D

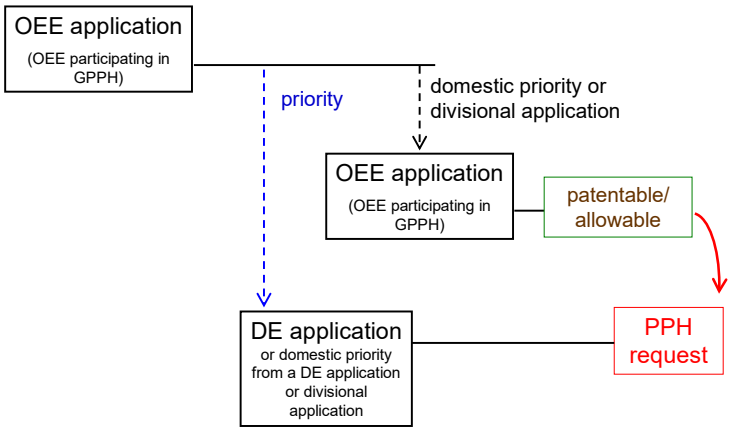
Case II
PCT route



Case III

E

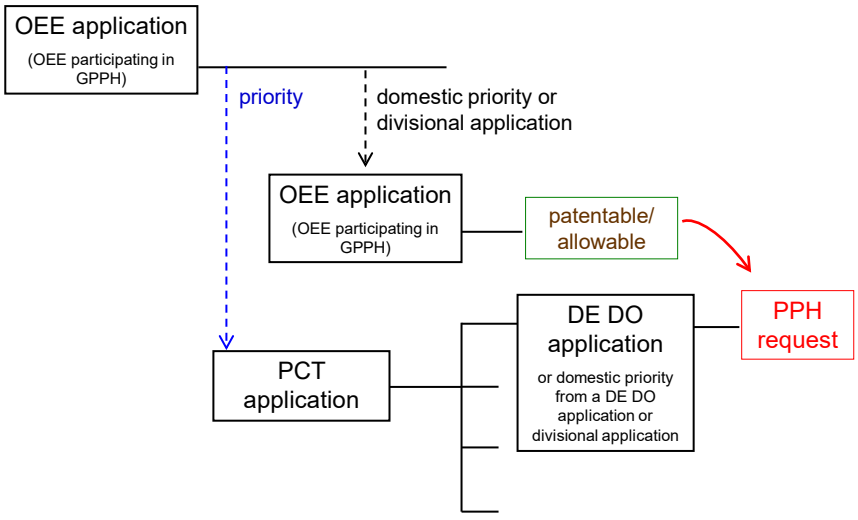
Paris route & domestic priority or divisional application



Case III

F

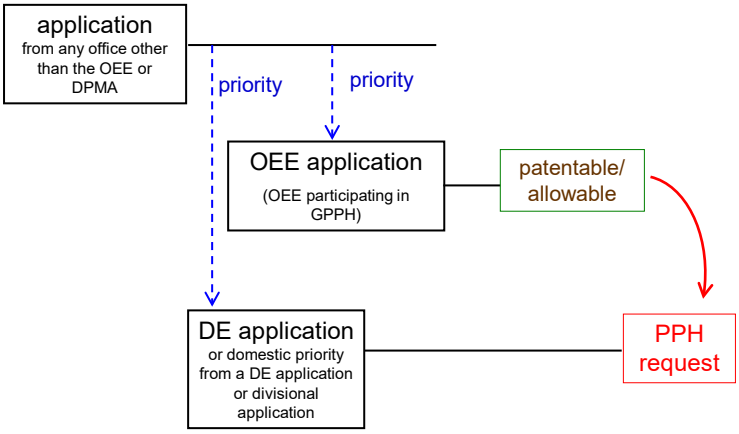
PCT route & domestic priority or divisional application



G

Case III

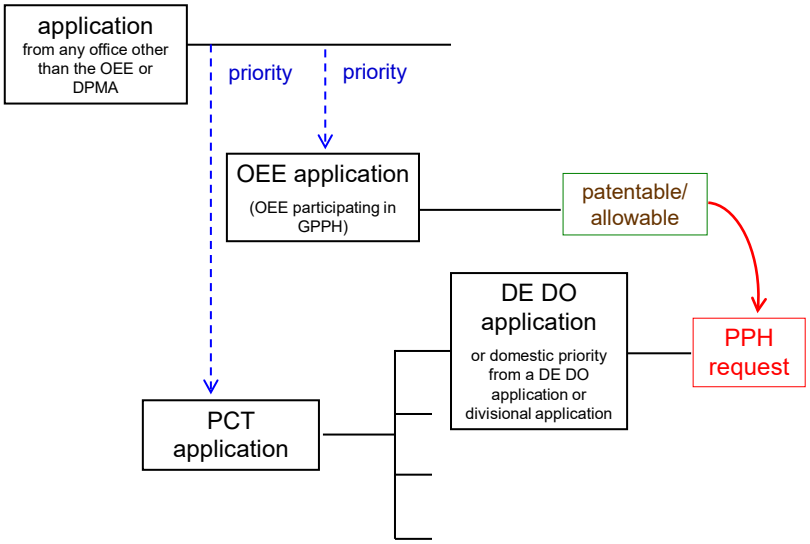
Application from third country & Paris route



H

Case III

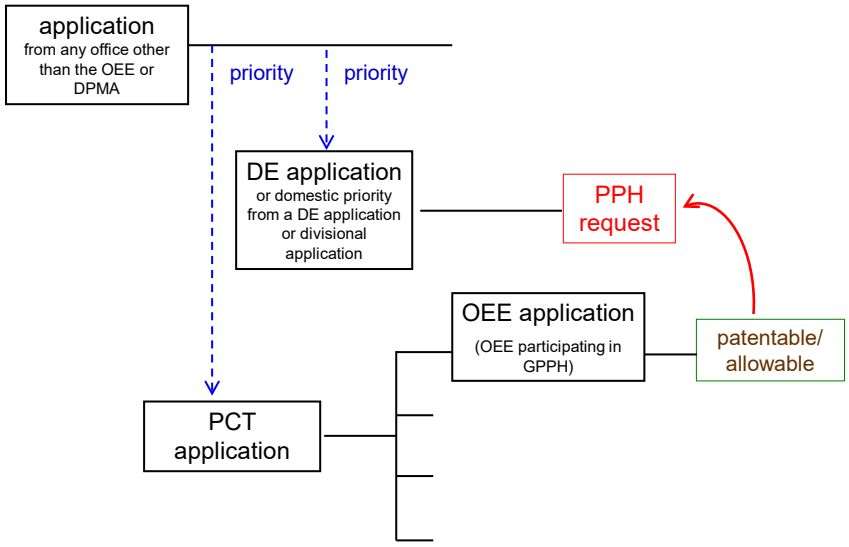
PCT route 1/first application from third country



I

Case III

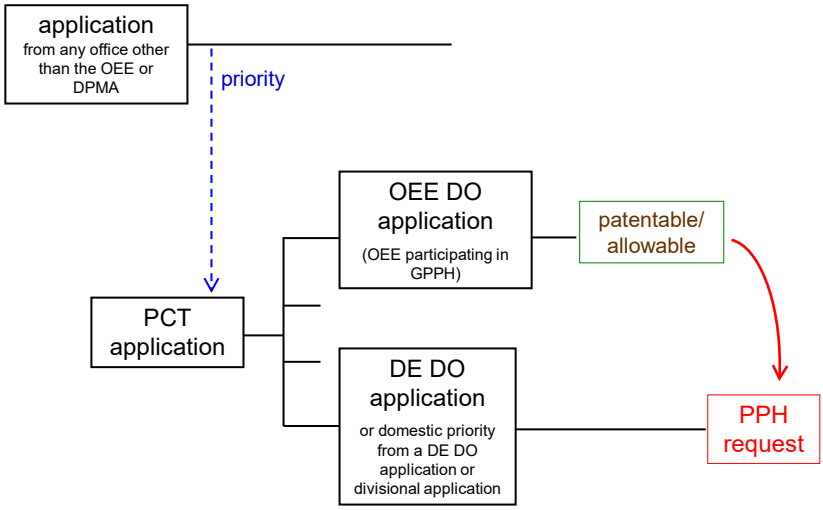
PCT route 2/first application from third country



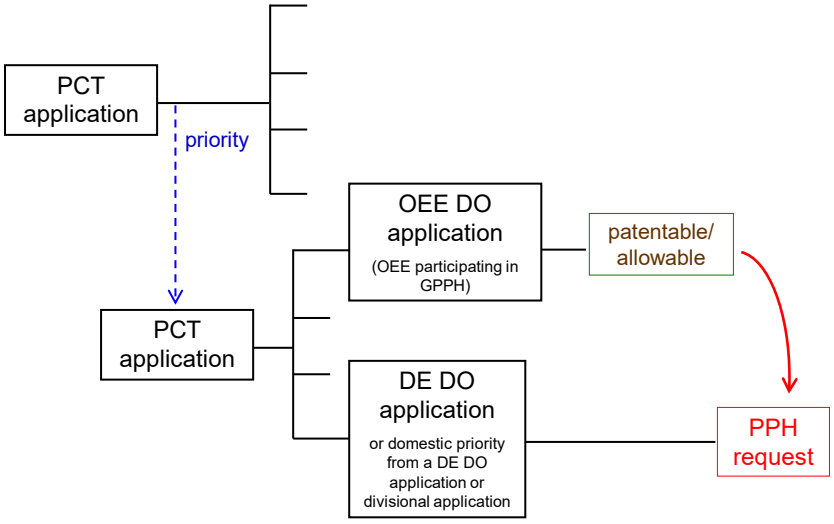
J

Case III

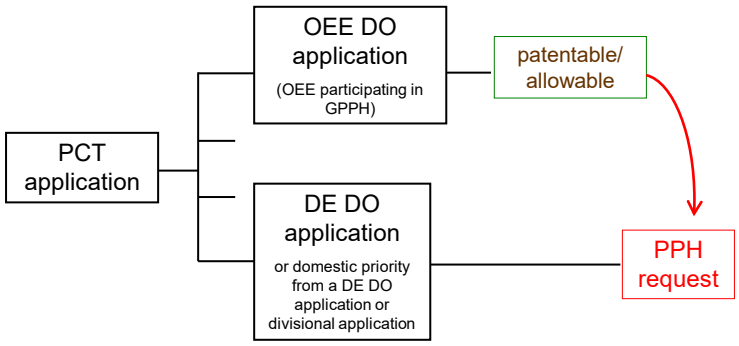
PCT route



K


PCT application
priority
PCT application
OEE DO application
(OEE participating in GPPH)
patentable/ allowable
DE DO application
or domestic priority from a DE DO application or divisional application
PPH request

L


PCT application
OEE DO application
(OEE participating in GPPH)
patentable/ allowable
DE DO application
or domestic priority from a DE DO application or divisional application
PPH request