# Procedures to file a request to the Austrian Patent Office (APO) for the Global Patent Prosecution Highway (GPPH) Pilot Program

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the APO and satisfies the following requirements under the GPPH Pilot Program.

The request form ("*GPPH Request Form*") is available online on the APO website at http://www.patentamt.at/Erfindungsschutz/Formulare_und_Gebuehren/

## ***PART 1:***

## ***GPPH using national work products***

An applicant has to file a request for accelerated examination under the GPPH to the APO by submitting a bilingual German/English form for requesting accelerated examination under the GPPH accompanied by the relevant supporting documents. The requirements for an application to the APO for accelerated examination under the GPPH are given in Section 1 and relevant supporting documentation is discussed in Section 2.

### Section 1: Requirements

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

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

i) an application which validly claims priority under the Paris Convention from the OEE application(s) (examples are provided in ANNEX 1, Figures A, B, C and D), or

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 ANNEX 1, Figures E, F and G), or

iii) an application which shares a common priority document with the OEE application(s) (including PCT national phase application(s)) (examples are provided in ANNEX 1, Figures H, I, J, K, L and M), or

iv) a PCT national phase application where both the APO application and the OEE application(s) are derived from a common PCT international application having no priority claim (example is provided in ANNEX 1, Figure N).

**b) At least one corresponding application exists in the OEE and has one or more claims that are indicated to be patentable/allowable by the OEE.**

Claims clearly identified to be patentable in the latest office action at examination stage are able to function as the basis for a request for accelerated examination under the GPPH. This is the case even though the application, which includes those claims, is not granted for patent yet.

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

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the APO are of the same or similar scope as the claims indicated as patentable/allowable in the OEE, or the claims in the APO are narrower in scope than the claims indicated as patentable/allowable in the OEE.
In this regard, a claim that is narrower in scope occurs when an OEE claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims).
A claim in the APO which introduces a new/different category of claims to those claims determined to be patentable/allowable in the OEE is not considered to sufficiently correspond. For example, if the OEE claims only contain claims to a process of manufacturing a product, then the claims in the APO are not considered to sufficiently correspond if the APO claims introduce product claims that are dependent on the corresponding process claims.
Any claims amended or added after the grant of the request for participation in the GPPH need not to sufficiently correspond to the claims indicated as patentable/allowable in the OEE application.

d) **The APO has not yet issued a decision to grant a patent** (The heading of the communication in German is "Erteilungsbeschluss".)**.**

## Section 2: Required documents

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

a) **Copies of all office actions (which are relevant to substantial examination for patentability in the OEE) which were issued for the corresponding application(s) by the OEE, and translation(s) of them.**

Both German and English are acceptable as translation languages. Machine translations are admissible, but if it is impossible for the examiner to understand the outline of the translated office action due to insufficient translation, the examiner can request the applicant to resubmit translations.
The applicant does not have to submit the copy of OEE office actions and translations of them when those documents are provided by OEE´s dossier access system. If they cannot be obtained by the examiner via OEE´s dossier access system, the applicant may be notified and requested to provide the necessary documents.

b) **Copies of all claims determined to be patentable/allowable by the OEE, and translations of them.**

Both German and English are acceptable as translation languages. Machine translations are admissible, but if it is impossible for the examiner to understand the outline of the translated office action due to insufficient translation, the examiner can request the applicant to resubmit translations.
The applicant does not have to submit the copy of OEE claims and translations of them when those documents are provided by OEE´s dossier access system. If they cannot be obtained by the examiner via OEE´s dossier access system, the applicant may be notified and requested to provide the necessary documents.

c) **A completed claim correspondence table in German or English language showing the correspondence between the claims of the APO application for accelerated examination under the GPPH and the claims of the corresponding OEE application considered patentable/allowable by the OEE.**

Sufficient correspondence of claims occurs where the claims satisfy the requirements c) 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 in c).

d) **Copies of the references cited by the OEE examiner.**

If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the APO examiner. Only if the APO examiner has difficulty in obtaining a patent document the APO will ask the applicant to submit it. Non-patent literature must always be submitted.
As a rule, cited documents need not be translated.

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

**Procedure for accelerated examination under the GPPH Pilot Program at the APO**

The APO decides whether the application can be entitled to the status for an accelerated examination under the GPPH when it receives a request with the documents stated above. When the APO decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the GPPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given opportunity to correct the request. If any of those defects is not corrected, the applicant will be notified and the application will await action in its regular turn.

# ***PART 2:***

# ***GPPH using the PCT international work products***

An applicant has to file a request for accelerated examination under the PCT-GPPH to the APO by submitting a bilingual German/English form for requesting accelerated examination under the PCT-GPPH accompanied by the relevant supporting documents. The requirements for an application to the APO for accelerated examination under the PCT-GPPH are given in Section 1 and relevant supporting documentation is discussed in Section 2.

## Section 1: Requirements

a) **The latest work product in the international phase of a PCT application corresponding to the application ("international work product"), namely the**

**Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/ allowable.**

Note that the ISA and the IPEA which produce the WO/ISA, WO/IPEA and the IPER are limited to one of the authorities listed in Annex A (http://www.jpo.go.jp/ppph-portal/globalpph.htm ), but if priority is claimed, the priority claim can be referred to an application in any Office (see example A´ in Annex 2). The applicant can NOT file a request under PCT-GPPH on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of the PCT-GPPH request, the applicant must identify and explain which claim(s) is/are patentable/allowable whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in PCT-GPPH program if the applicant does not identify and explain which claim(s) is/are patentable/allowable. In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

**b) The relationship between the application and the corresponding international application satisfies one of the following requirements:**

i) The application is a national phase application of the corresponding international application (examples are provided in ANNEX 2, Figures A, A' and A'').

ii) The application is a national application as a basis of the priority claim of the corresponding international application (example is provided in ANNEX 2, Figure B).

iii) The application is a national phase application of an international application claiming priority from the corresponding international application (example is provided in ANNEX 2, Figure C).

iv) The application is a national application claiming foreign/domestic priority from the corresponding international application (example is provided in ANNEX 2, Figure D).

v) The application is the derivative application (divisional application, application claiming internal priority, etc.) of the application which satisfies one of the above requirements (i) – (iv) (examples are provided in ANNEX 2, Figures E1 and E2).

**c) All claims, as originally filed or as amended, for examination under the PCT-GPPH must sufficiently correspond to one or more of those claims indicated to be patentable/allowable in the latest international work product of the corresponding international application.**

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims of the application are of the same or similar scope as the claims indicated to be patentable/allowable in the latest international product, or the claims of the application are narrower in scope than the claims indicated to be patentable/allowable in the latest international product.

In this regard, a claim that is narrower in scope occurs when a claim indicated to be patentable/ allowable in the latest international product is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims) of the application.

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

Any claims amended or added after the grant of the request for participation in the PCT-GPPH need not to sufficiently correspond to the claims indicated as patentable/allowable in the latest international working product.

**d) The APO has not yet issued a decision to grant a patent** (The heading of the communication in German is “Erteilungsbeschluss”.)**.**

## Section 2: Required documents

The following documentation will be needed to support a request for accelerated examination under the PCT-GPPH at the APO:

**a) A copy of the latest international work product which indicated the claims to be patentable/allowable and their German or English translation if they are not in English.**

Both German and English are acceptable as translation languages. Machine translations are admissible, but if it is impossible for the examiner to understand the outline of the translated work product due to insufficient translation, the examiner can request the applicant to resubmit translations.

In case the application satisfies the relationship b) i), the applicant does not need to submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via “PATENTSCOPE®”*, then the applicant does not need to submit these documents, unless otherwise requested by the APO. (WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date.)

**b) A copy of the set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their German or English translation if they are not in English.**

Both German and English are acceptable as translation languages. Machine translations are admissible, but if it is impossible for the examiner to understand the outline of the translated claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

If the copy of the set of claims which are indicated to be patentable/allowable is available via “PATENTSCOPE®” (e.g. the international Patent Gazette has been

published), an applicant need not submit this document unless otherwise requested by the APO.

**c) A claim correspondence table in German or English language showing the correspondence between the claims of the APO application and the claims determined to be patentable/allowable in the latest work product of the corresponding international application.**

Sufficient correspondence of claims occurs where the claims satisfy the requirements c) 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 c).

**d) Copies of references cited in the latest international work product of the corresponding international application**

If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the APO examiner. Only if the APO examiner has difficulty in obtaining a patent document the APO will ask the applicant to submit it. Non-patent literature must always be submitted.
As a rule, cited documents need not be translated.

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

**Procedure for accelerated examination under the PCT-GPPH Pilot Program at the APO**

The APO decides whether the application can be entitled to the status for an accelerated examination under the PCT-GPPH when it receives a request with the documents stated above. When the APO decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PCT-GPPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given opportunity to correct the request. If any of those defects is not corrected, the applicant will be notified and the application will await action in its regular turn.

# ANNEX 1

**Figure A:**

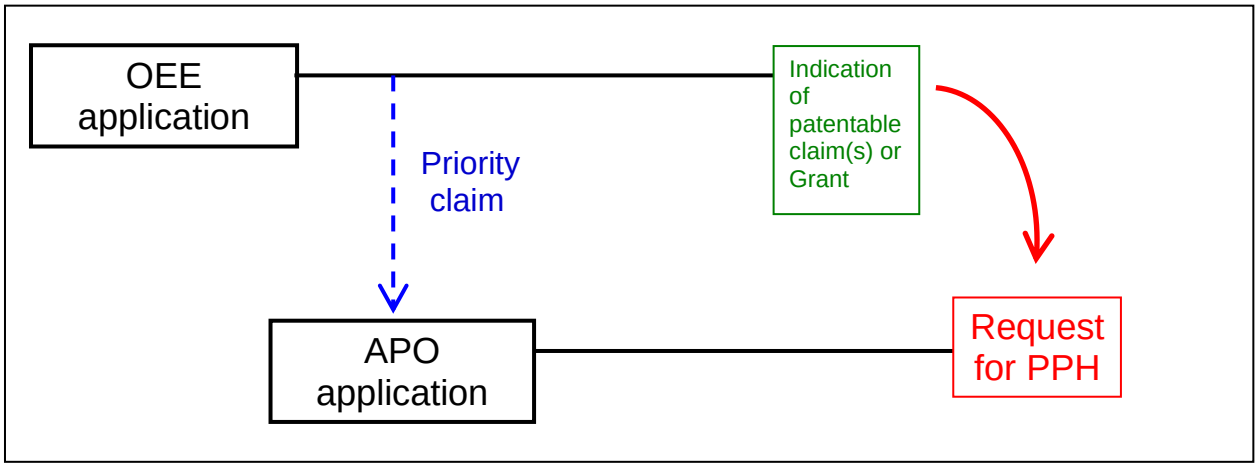
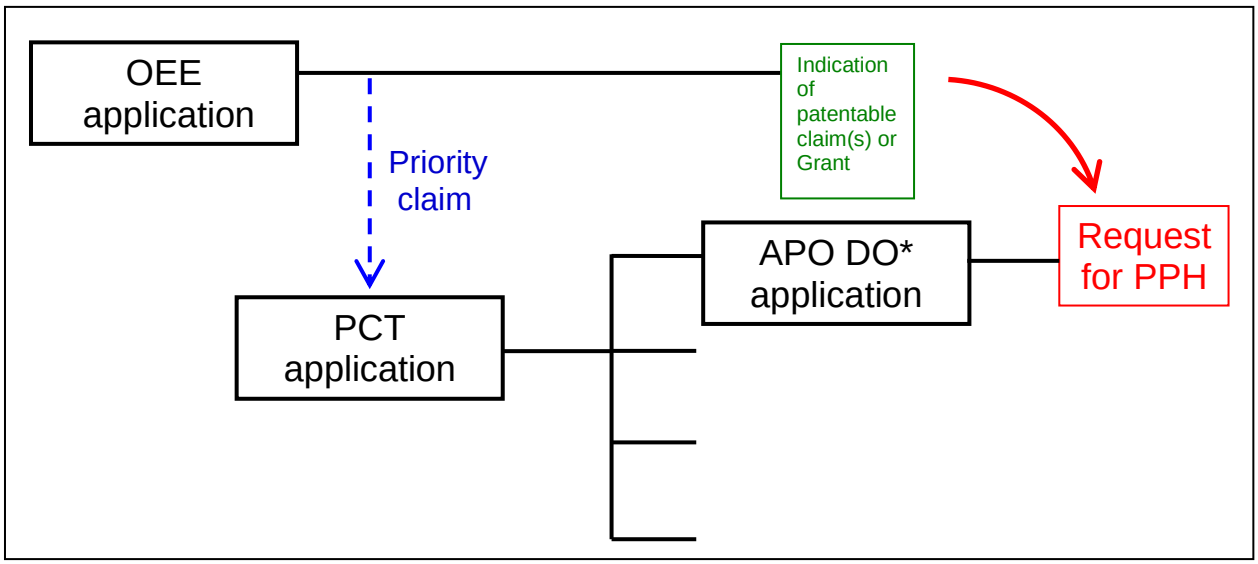
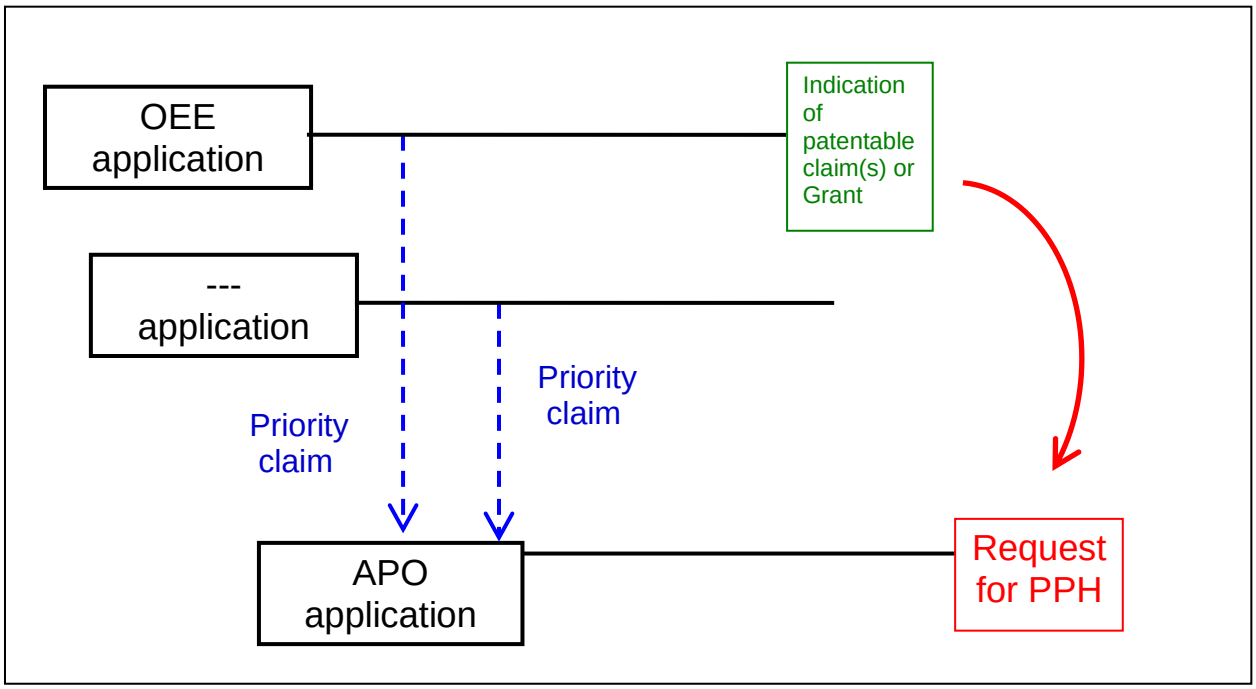



**Figure B:**




* Designated Office

**Figure C:**

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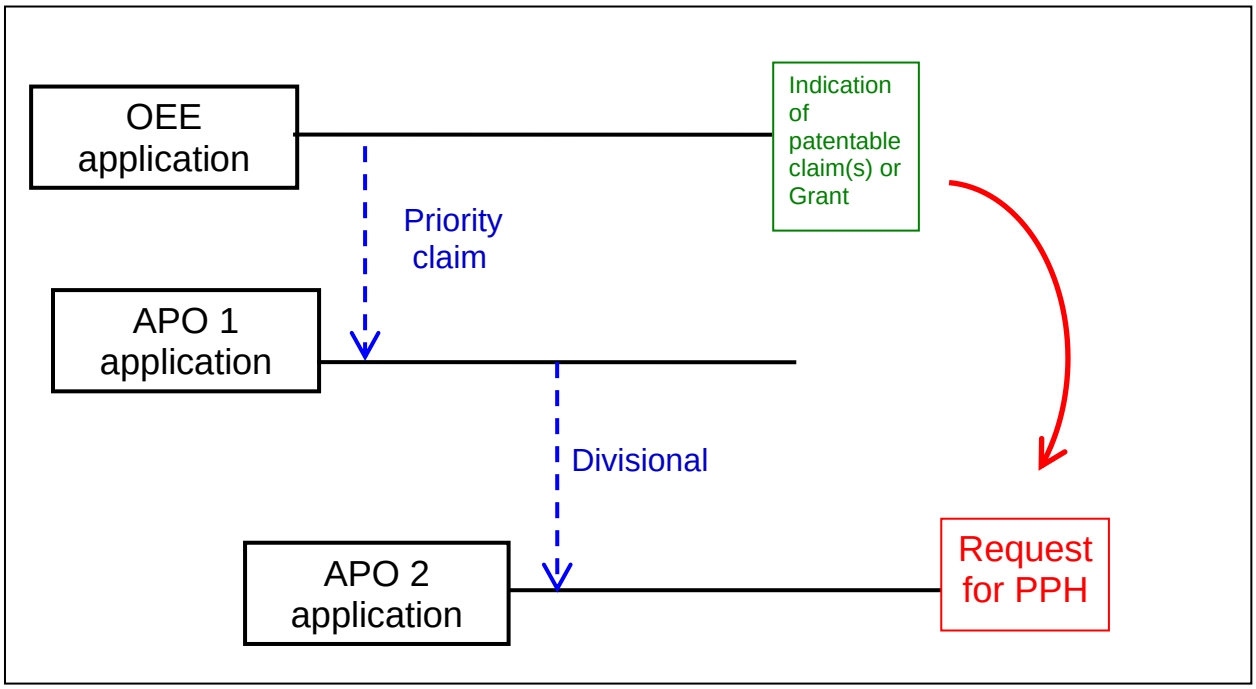

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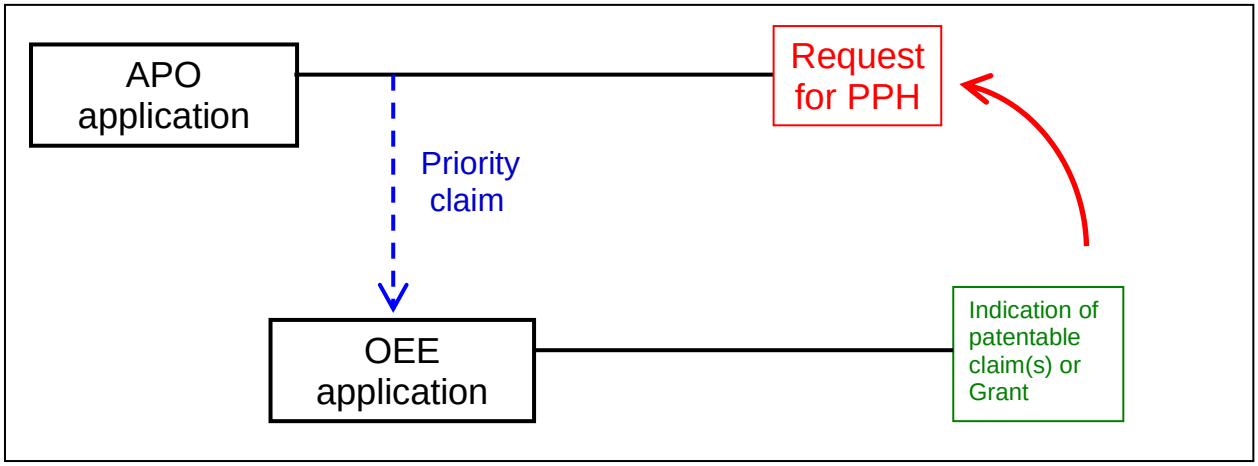


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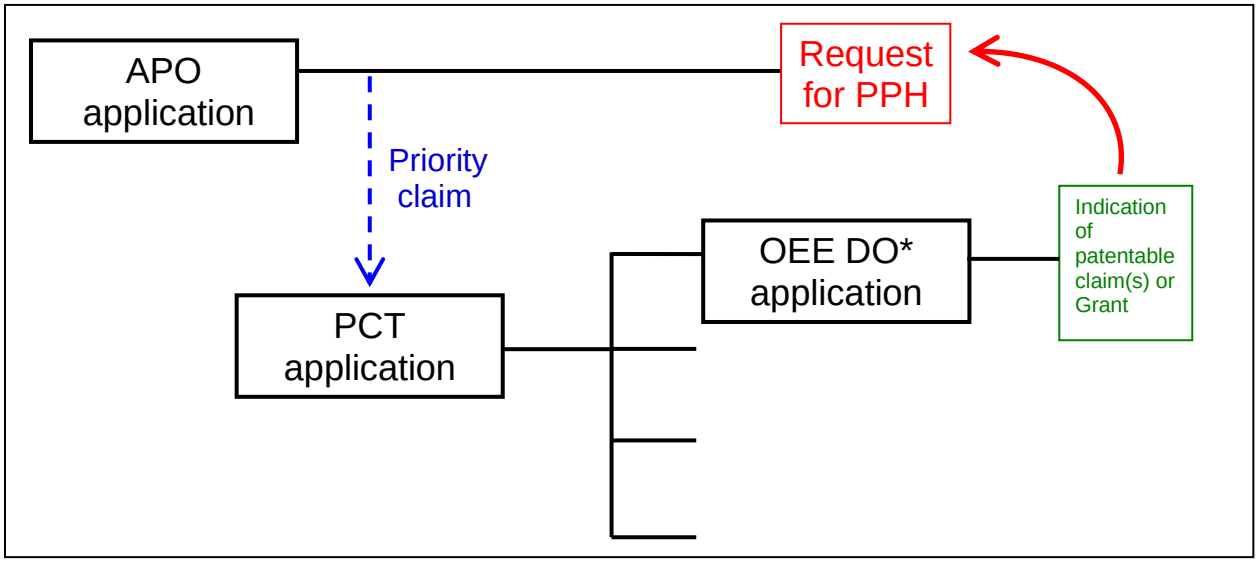


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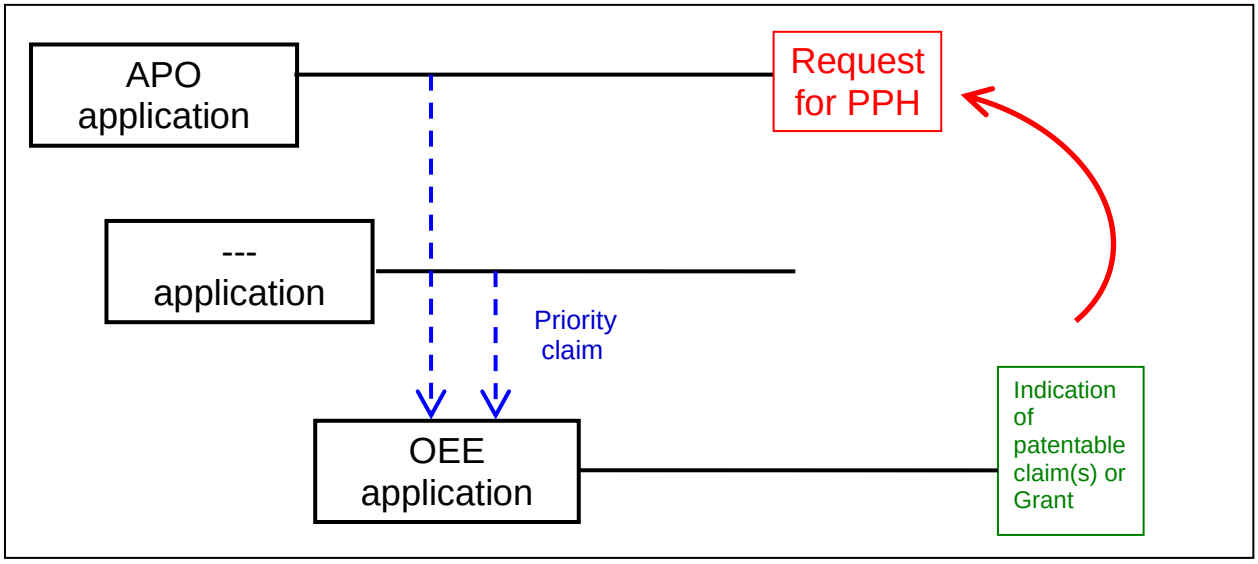


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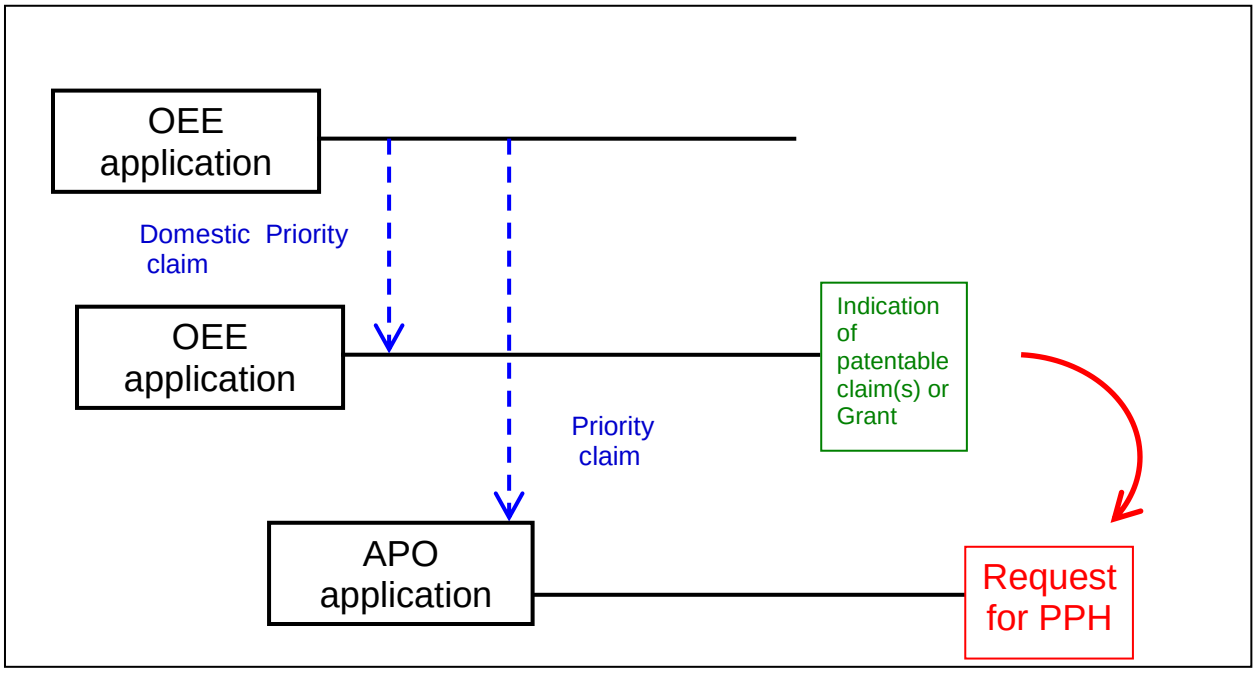
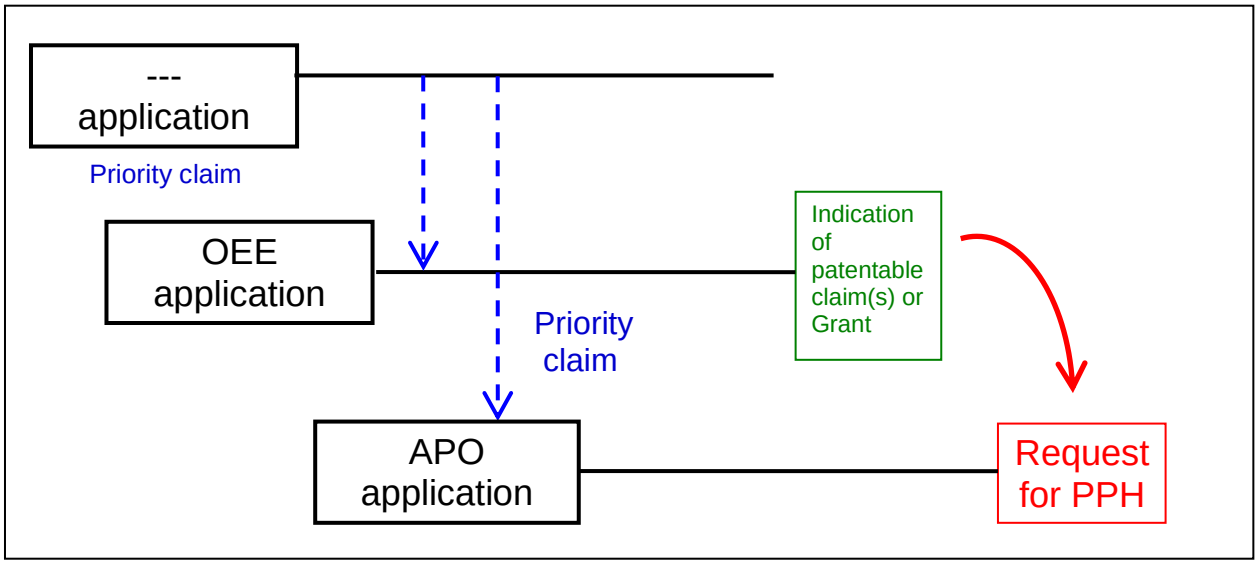


**Figure I:**

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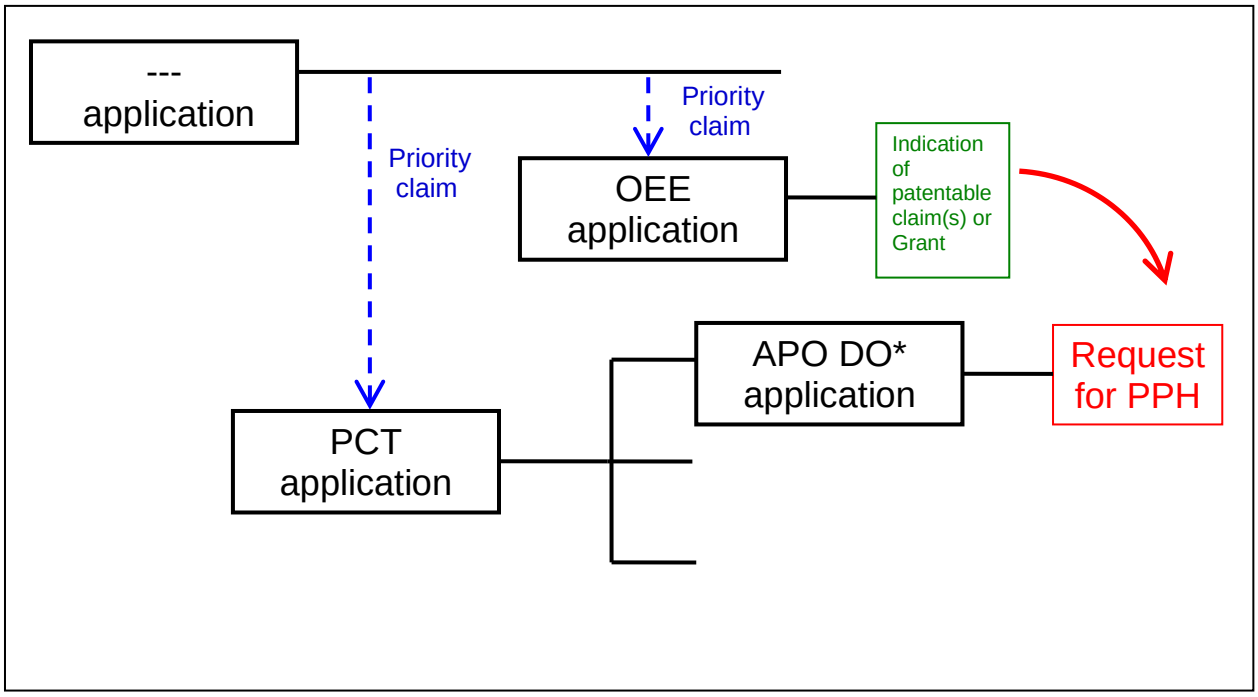


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**Figure K:**

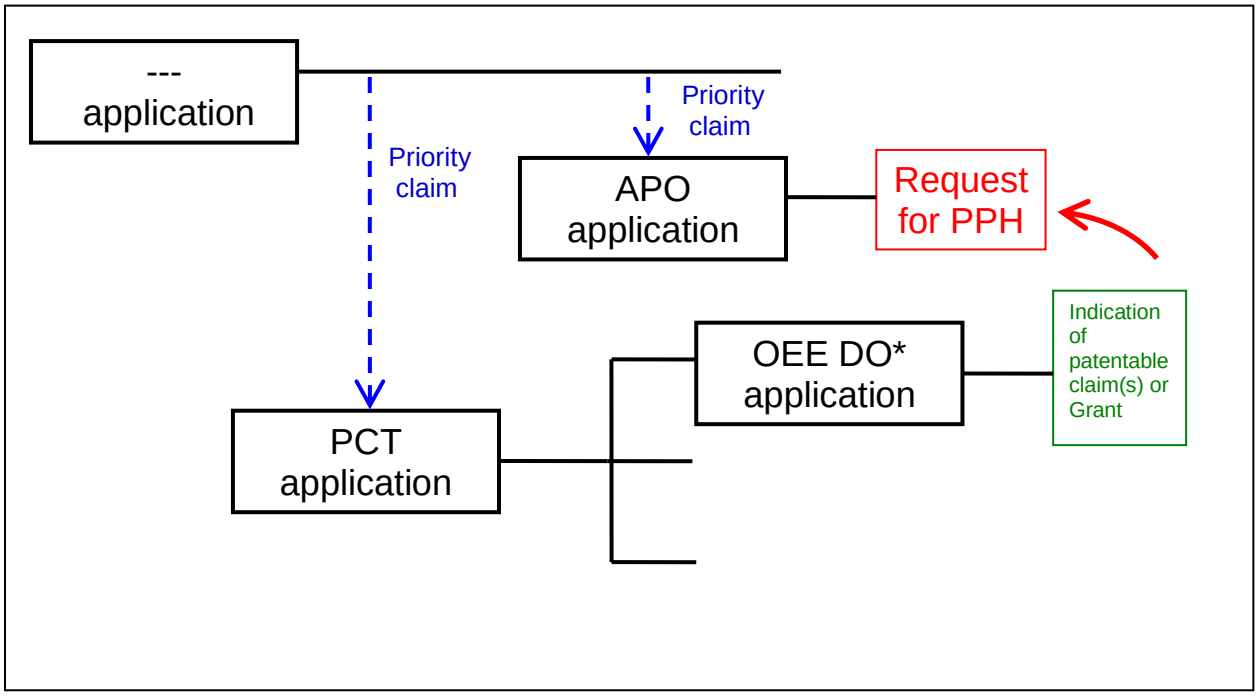


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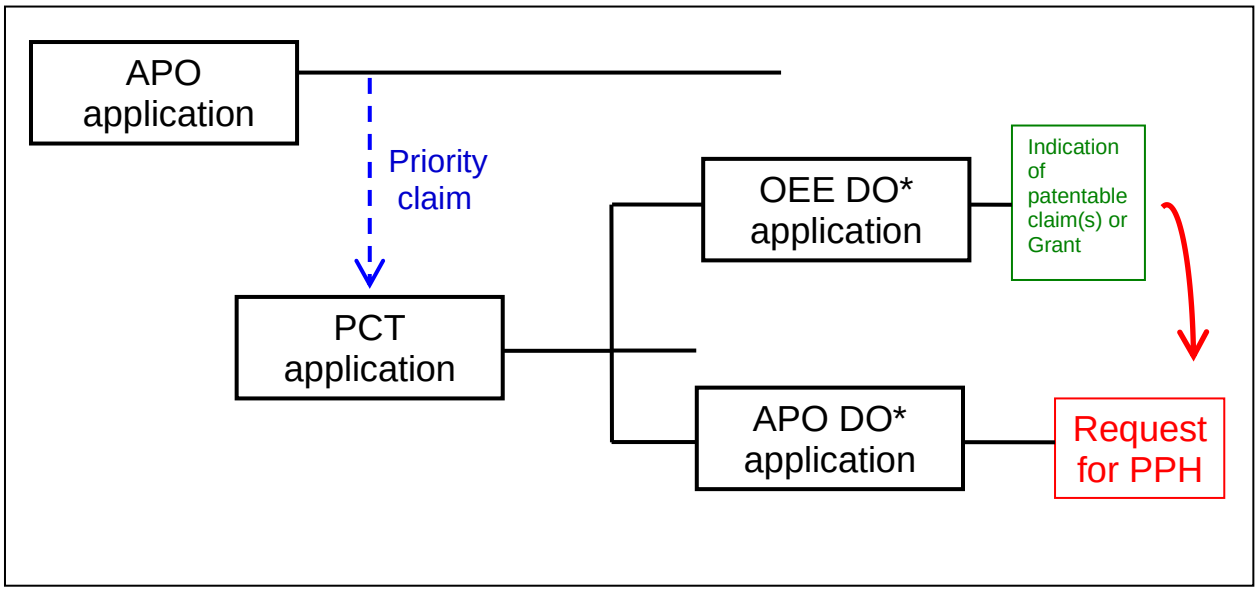
**Figure L:**

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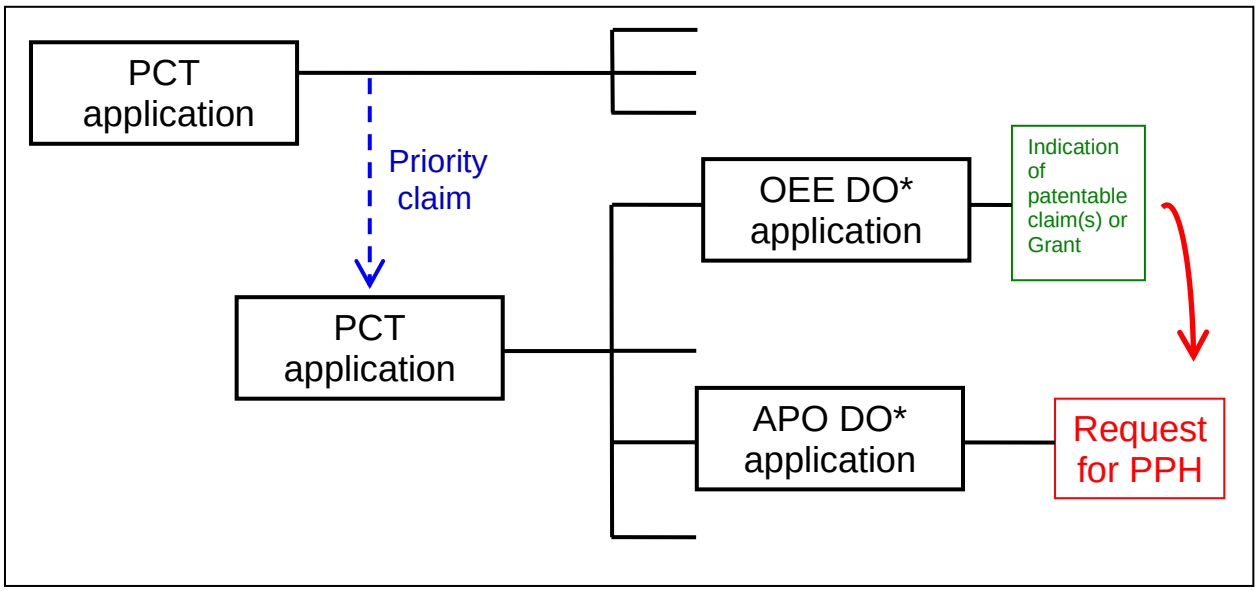


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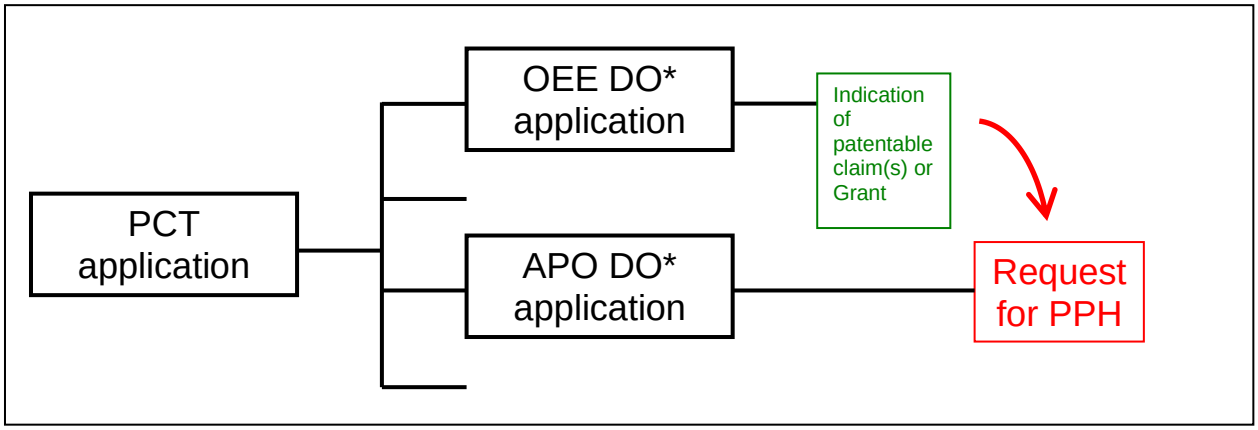
**Figure N:**

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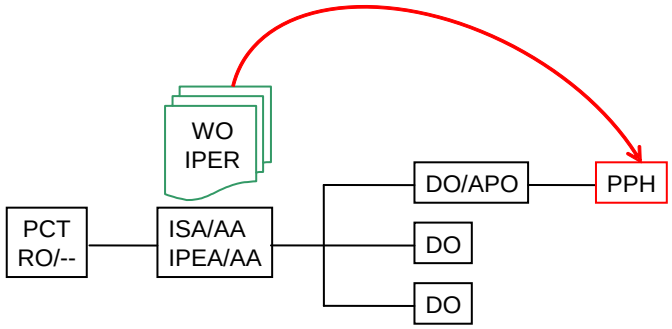
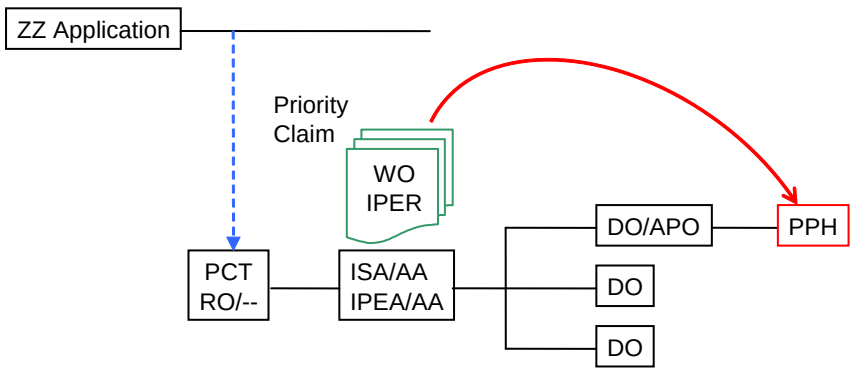
# ANNEX 2

## Figure (A)




AA…offices listed in Appendix A

## Figure (A')




AA… offices listed in Appendix A

ZZ … any office

**Figure (A'')**

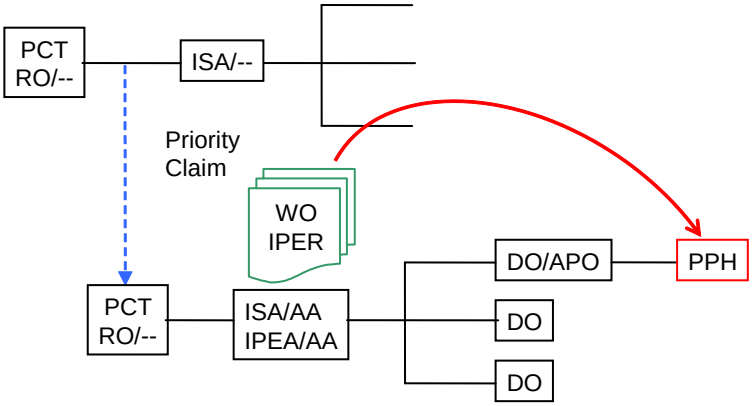



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**Figure (B)**

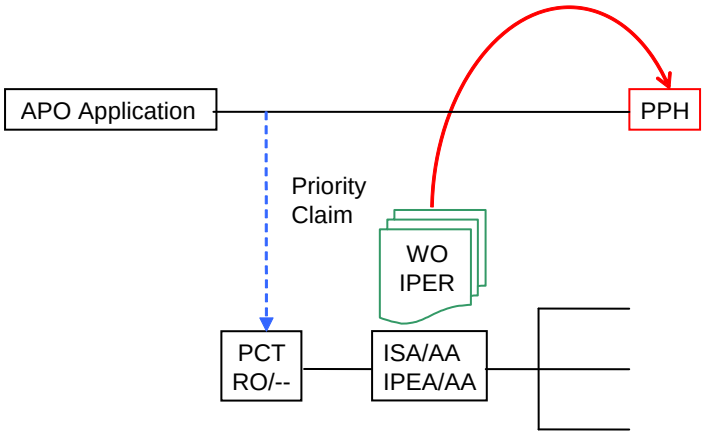


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**Figure (C)**

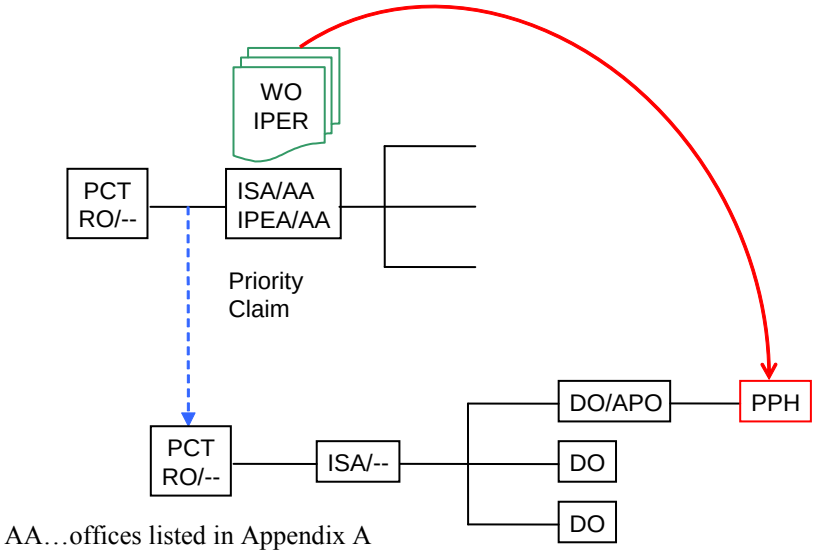


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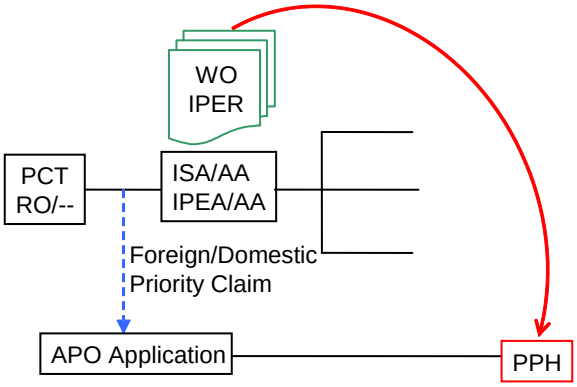
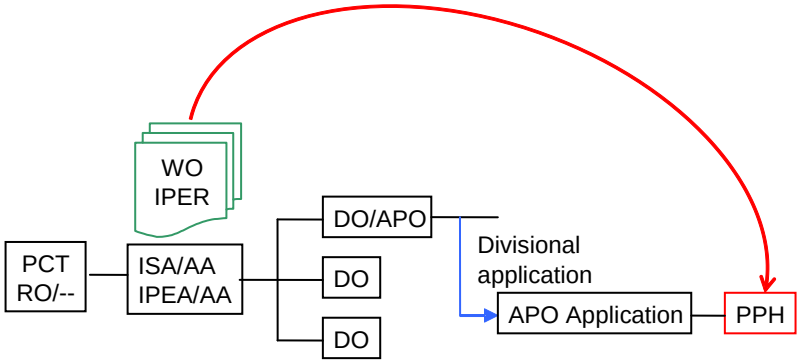
**Figure (D)**



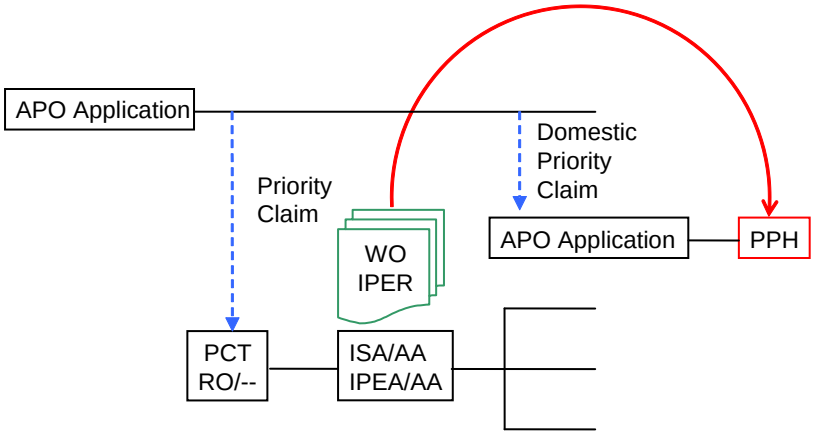

AA…offices listed in Appendix A

**Figure (E1)**




AA…offices listed in Appendix A

**Figure (E2)**

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