

Procedures to file a request to the DKPTO for use of the Patent Prosecution Highway Pilot Program between the DKPTO and the KIPO

Requests 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 (paragraph [0002]). 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 KIPO application(s) (examples are provided in Annex I, figure A, B, C, D, E, F and G) (may include utility model applications filed in the KIPO – please refer to Annex I, figure L)
 - (ii) a PCT national phase application without priority claim (direct PCT applications) (an example is provided in Annex I, figure H), 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 I, J and K).

A DKPTO application which validly claims priority to multiple KIPO 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.

Where the KIPO application that contains the allowable/patentable claims is not the same application for which priority is claimed in the DKPTO application, applicant must identify the relationship between the KIPO application that contains the allowable/patentable claims and the KIPO priority application claimed in the DKPTO application (eg KIPO application X that contains the allowable/patentable claims, claims domestic priority to KIPO application Y, which is the priority application claimed in the DKPTO application).

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

Claims clearly identified to be patentable by the KIPO 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 KIPO has not yet granted a patent for those claims. If the KIPO has not yet granted a patent for the corresponding application it is a requirement that the KIPO examiner has clearly identified the corresponding claims to be patentable in either "Notice of Submission of Opinion" or "Notice of Final Rejection" by adding the following expression:

□ PATENTABLE (REGISTRABLE) CLAIM(S):

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 KIPO.***

All claims in each DKPTO application for which a request for participation in the PPH pilot project is made must sufficiently correspond or be amended to correspond to the allowable/patentable claims in the KIPO application(s). Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope. This means that the claims have a common technical feature which makes the claims patentable over the prior art in the corresponding KIPO application.

Dependant claims in the DKPTO application which are appended to earlier claims in the KIPO application corresponding to claims that are indicated as patentable by the KIPO will also be considered where such claims fall within the scope of the claims indicated as patentable by the KIPO.

Claims filed to the DKPTO which contains additional technical features compared to the claims that the KIPO have found patentable will be considered to sufficiently correspond to the KIPO claims.

It is not necessary to include all claims determined to be patentable in the KIPO in the application to the DKPTO, as the deletion of claims is allowable. In a case where an application to the KIPO contains 5 claims, which KIPO determined to be patentable, the corresponding application to the DKPTO may contain only 3 of those 5 claims.

Where amended claims have been determined to be patentable by the KIPO, the claims of the DKPTO application should be such that they correspond to the amended claims of the KIPO application.

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 KIPO application(s) and a translation thereof.*

The term “office actions” is here used about the correspondence sent to the applicant or the applicant’s representative from the KIPO examiner.

No paper copy and translation of the office actions need be supplied if the office actions are available via K-PION (<http://www.k-pion.net>), as machine translation into English is available to the DKPTO examiner via K-PION.

If the office actions or the translations are not available via K-PION, the applicant must supply copies of the office actions and the translations hereof into either English or Danish to the DKPTO. Machine translation is admissible.

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

If the DKPTO examiner is not able to understand the translated office actions to a sufficient extent, the examiner can request the applicant to submit (or resubmit) translations.

b) *A copy of the claims determined to be patentable by the KIPO - including any subsequent amended claims found to be patentable by the KIPO – and translations of the claims found to be patentable by the KIPO.*

The applicant can either provide the claims together with the request for acceleration under the PPH or request that the DKPTO obtains the claims from KIPO’s database K-PION.

Both Danish and English are acceptable as translations languages. The terms described above in section [0003]a regarding the occasions where the applicant will not have to submit copies and translations – and regarding machine translations – also apply to this requirement b.

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 application considered patentable by the KIPO.*

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 KIPO application as shown in Annex III. The claim correspondence table must be written in either English or Danish.

Where the claims applied for at the DKPTO are literal translations of the claims which the KIPO has determined to be patentable, it will be sufficient to write “they are the same” in the table of correspondence. When the claims applied for at the DKPTO are not literal translations, it will be necessary to explain why there is a sufficient correspondence of each claim based on the criteria set out in section [0002]c above.

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 KIPO 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 applicant will be notified that the application will await action in its regular turn.

d) *A copy of the references cited by the KIPO 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.

Submission of translations of the references is not required. However, applicants will be free to file translations as part of the supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the citations if they so desire.

[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 KIPO application has not been published, and therefore the KIPO file wrapper is not available via KIPO’s database K-PION, applicant will be responsible for providing the necessary documents to the DKPTO.

The applicant 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 conventional 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:

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:

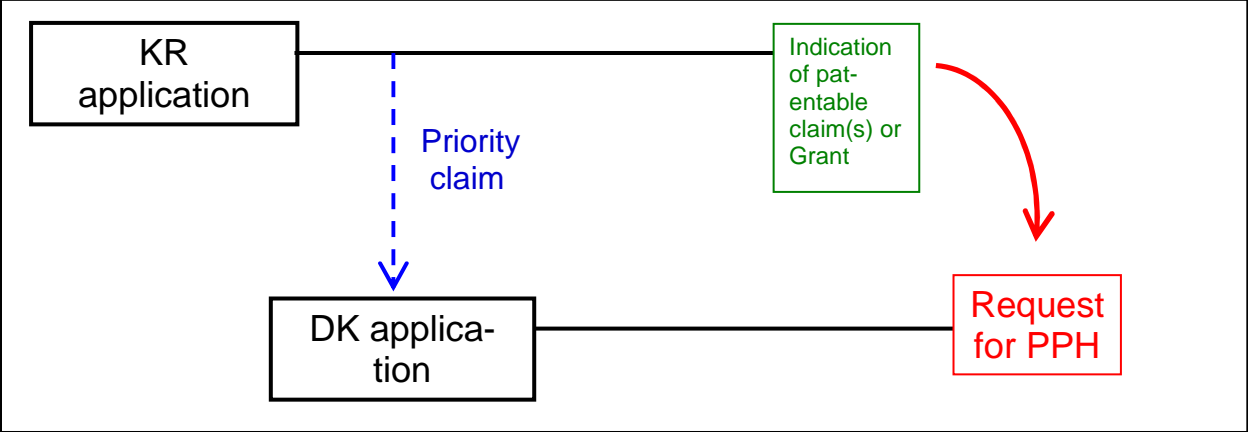
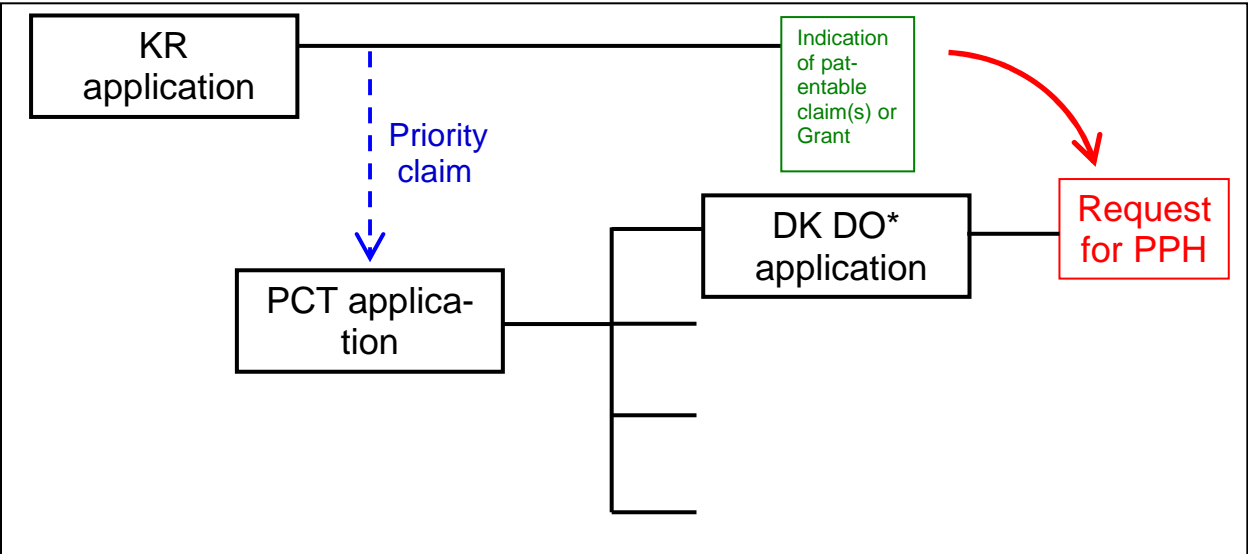


Figure B:



*DO – Designate Office

Figure C:

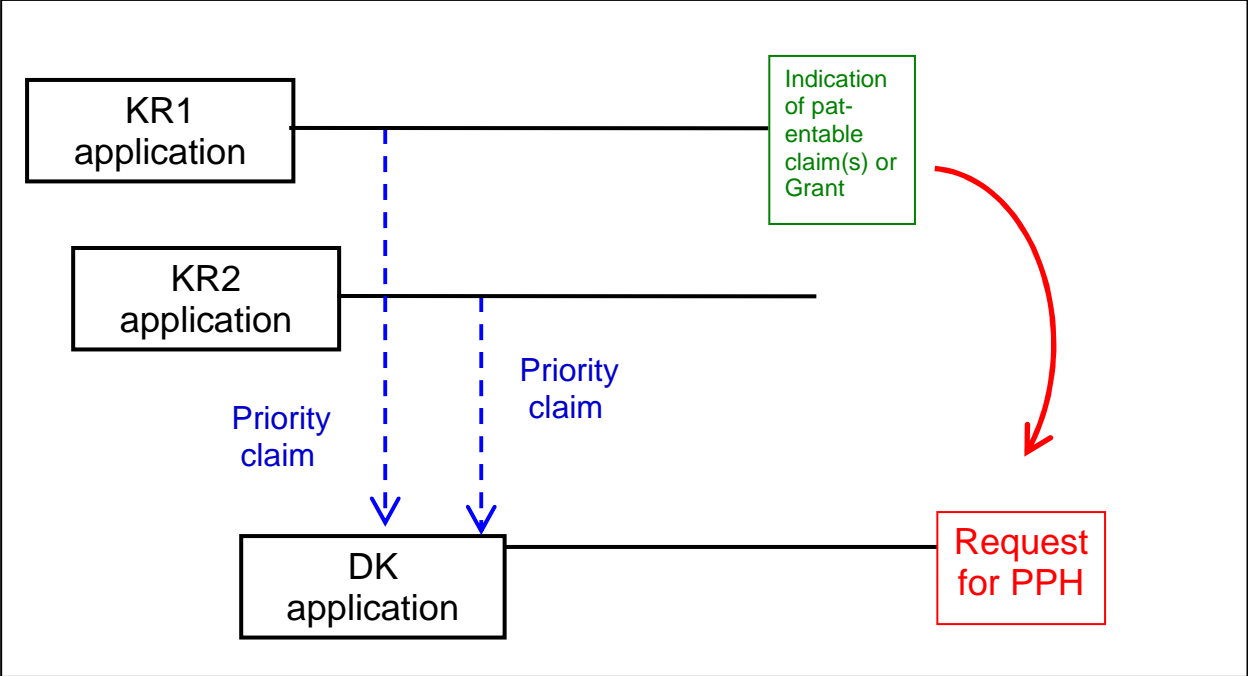


Figure D:

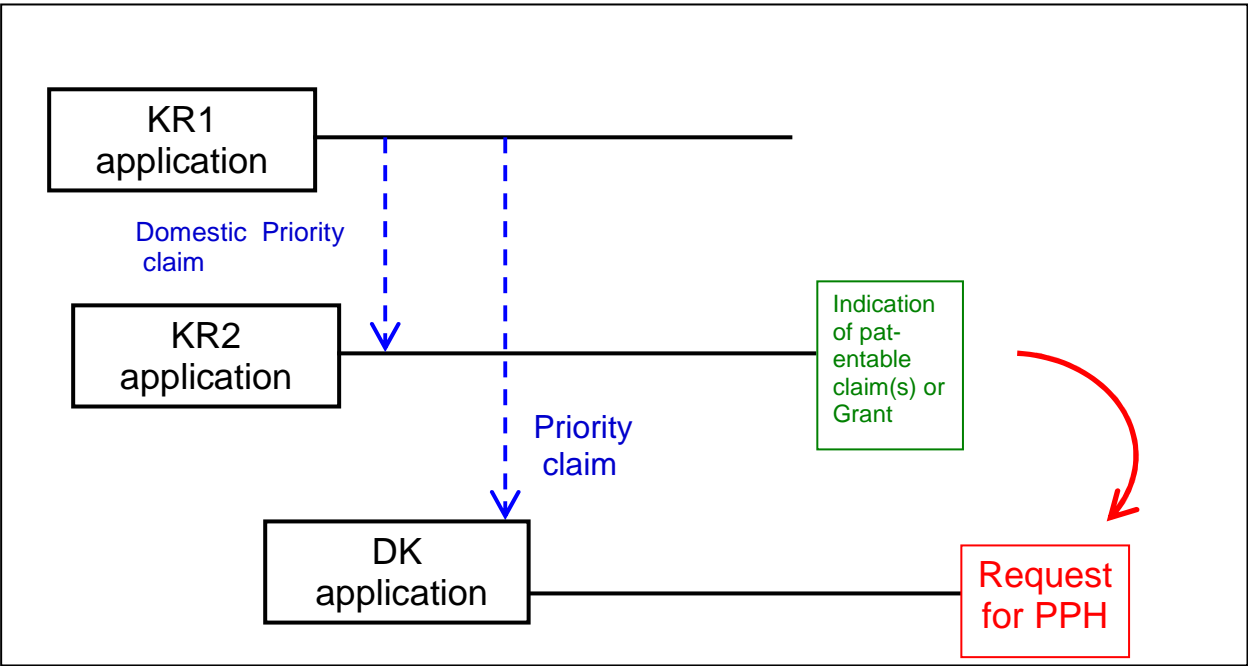


Figure E:

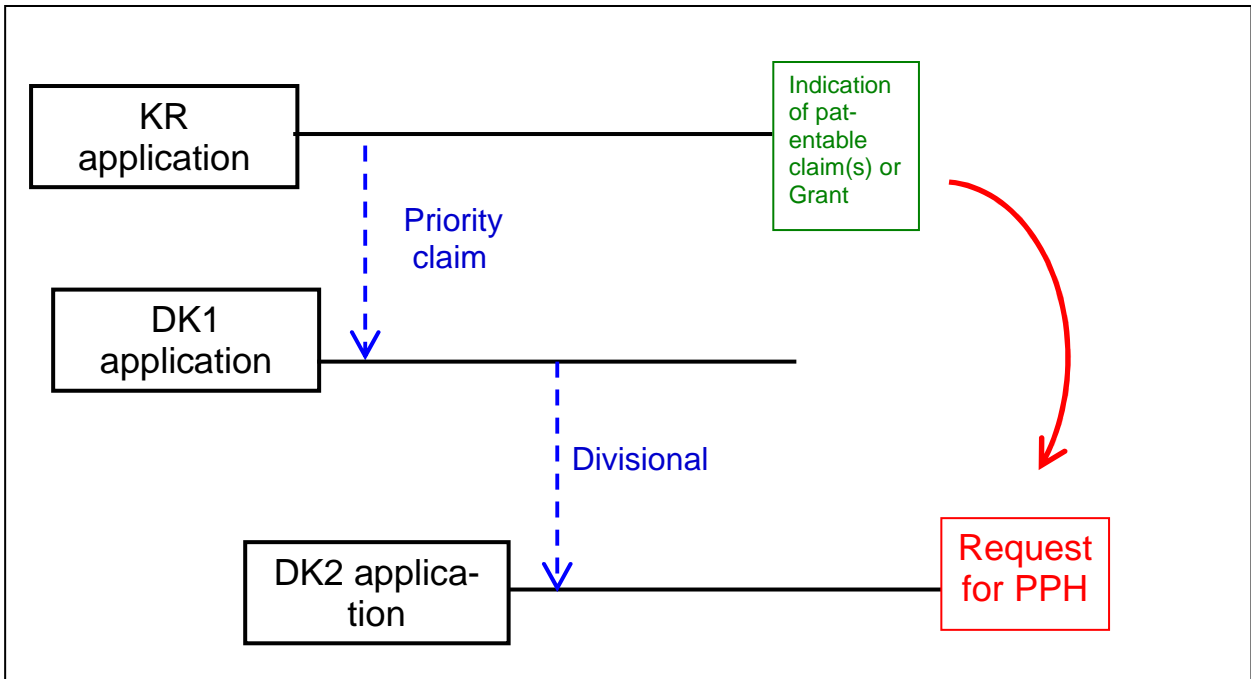
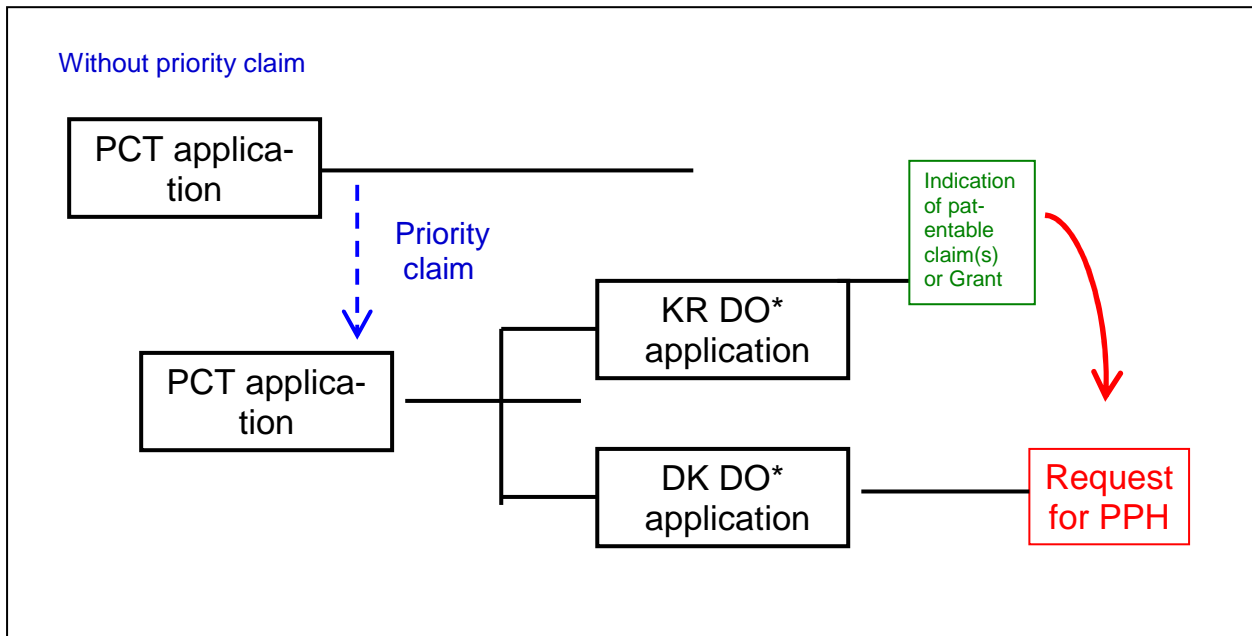


Figure F:



*DO – Designated Office

Figure G:

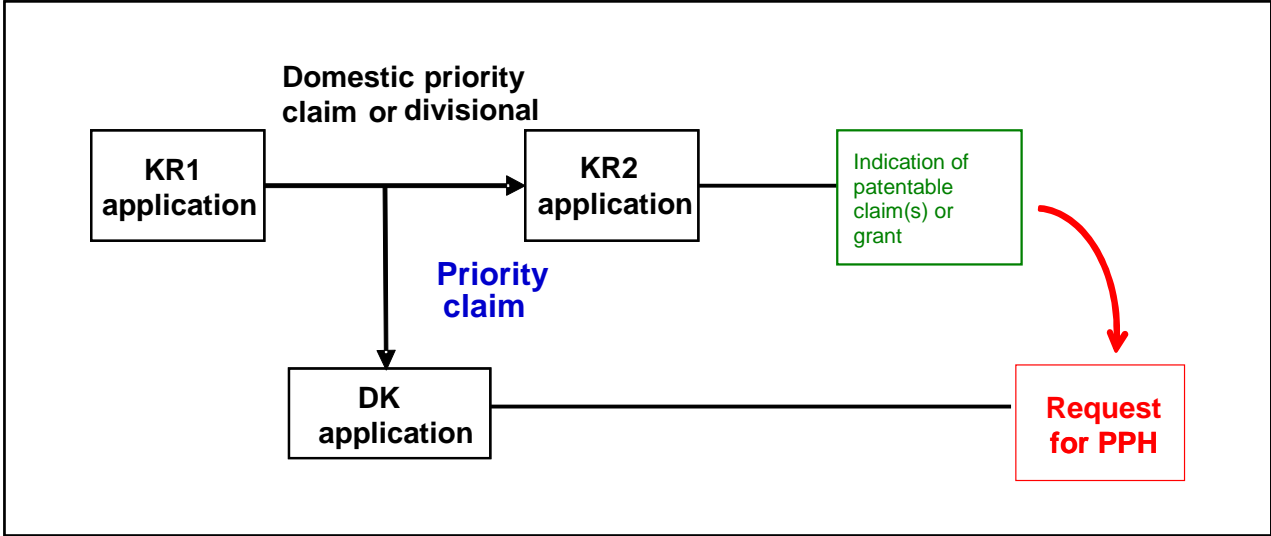
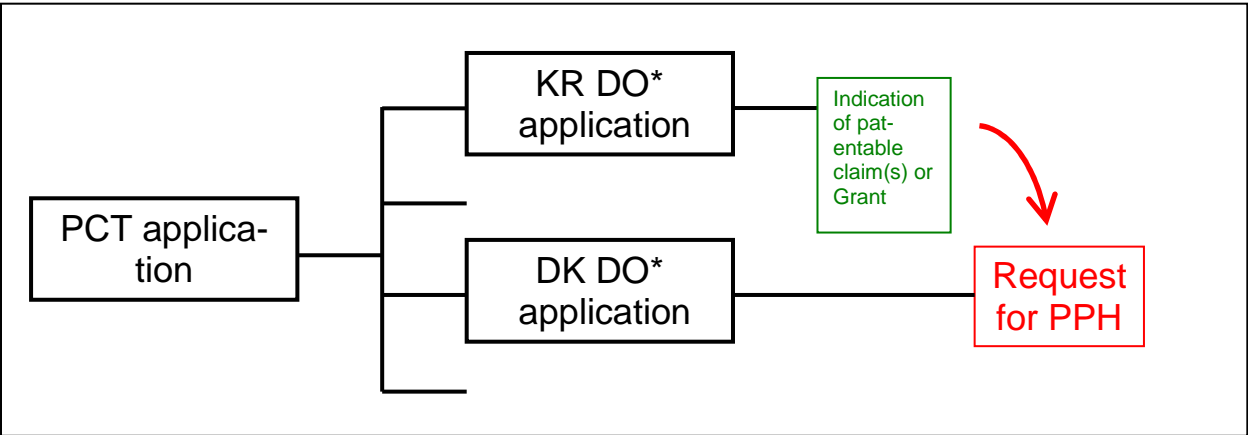
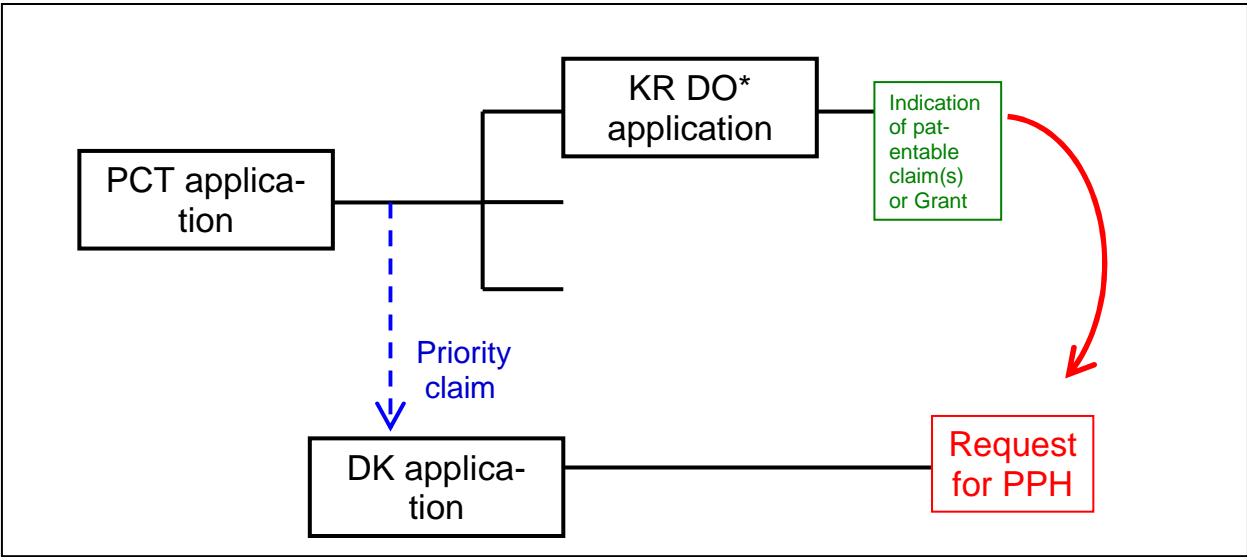


Figure H:



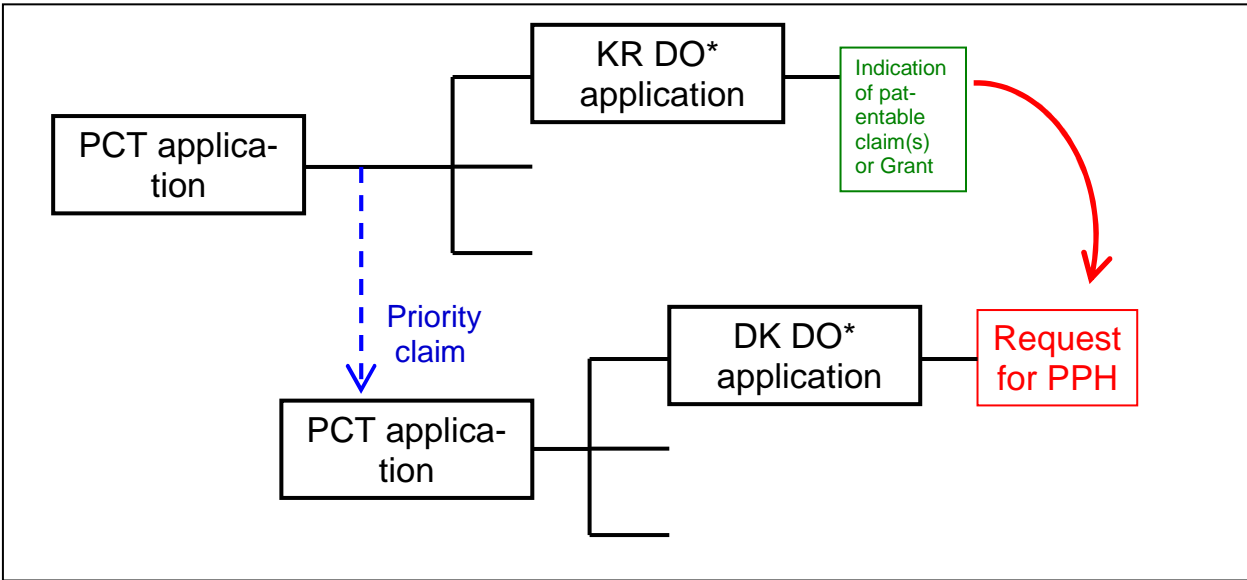
*DO - Designated Office

Figure I:



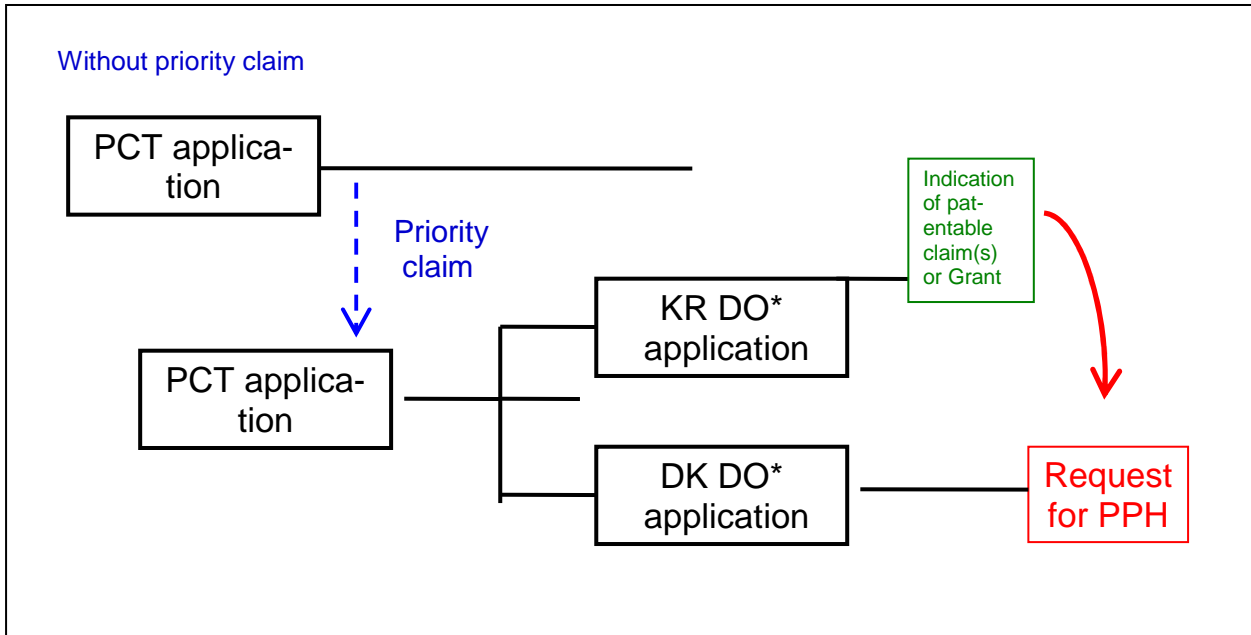
* DO – Designated Office

Figure J:



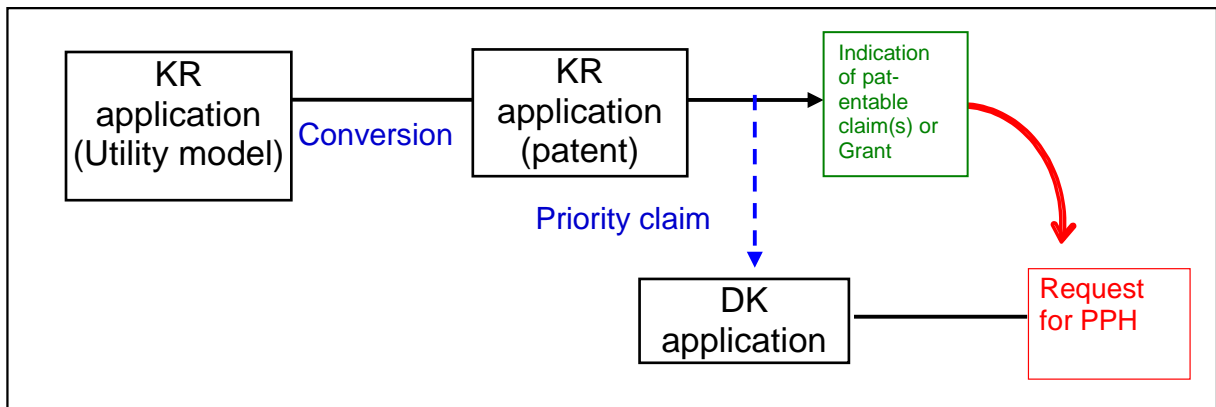
*DO – Designated Office

Figure K:



*DO – Designated Office

Figure L: (Conversion of KR application from utility model to patent)



ANNEX II

PPH REQUEST

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

- 1 DK application number:
Corresponding KR application number(s):

- 2 **Either:**
 - a) Copy of KR office action(s) attached:
 - and**
 - Copy of translated KR office action(s) attached:
 - or**
 - b) KR office action(s) available via K-PION:
 - or**
 - c) KR office action(s) on file from previous PPH application:
DK application number:

- 3 **Either:**
 - a) Copy of claims of corresponding KR application attached:
 - and**
 - Copy of translated claims of corresponding KR application attached:
 - or**
 - b) Claims of corresponding KR application available via K-PION:
 - or**
 - c) KR 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.

ANNEX III

Claim correspondence table:

DK application claims	Patentable claims in KIPO applications	Explanation regarding the correspondence