

Procedures to file a request to the EPA (The Estonian Patent Office) for Patent Prosecution Highway Pilot Program

Part I

PPH based on the national work products

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the patent office and satisfies the following requirements under the Patent Prosecution Highway programs.

Requirements

(a)

The OEE application and the OLE application have a specific relation.

Both the OEE application on which PPH is requested and the OLE 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 OLE application (including PCT national/regional phase application) is either:

- (Case I) an application which validly claims priority under the Paris Convention to the OEE application(s) (examples are provided in ANNEX IA), 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/regional phase application(s)) (examples are provided in ANNEX IA),
- (Case III) an application which shares a common priority document with the OEE application(s) (including PCT national/regional phase application(s)) (examples are provided in ANNEX IA).
- (Case IV) a PCT national/regional phase application where both the OLE application and the OEE application(s) are derived from a common PCT international application having no priority claim (examples are provided in ANNEX IA).

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

See ANNEX IB in regard to concrete cases that claims are “determined to be patentable/allowable” on each OEEs.

(b)

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 patentable/allowable in the OEE.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the OLE are of the same or similar scope as the claims indicated as patentable/allowable in the OEE, or the claims in the OLE 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 a claim indicated as patentable/allowable in the OEE 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 OLE 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, the claims indicated as patentable/allowable in the OEE only contain claims to a process of manufacturing a product, then the claims in the OLE are not considered to sufficiently correspond if the claims in the OLE introduce product claims that are dependent on the corresponding process claims.

- (c)**
- The OLE has not begun examination of the application.**
 - The OLE has not issued final decision of examination of the application.**

(d)

A “Request for Substantive Examination” must have been filed at the OLE either at the time of the PPH request or previously.

(e)

OLE application must have been published.

Documents to be submitted

Documents below must be submitted by attaching to PPH request form.

Some of the documents may not be required to submit in certain cases. Please note that the name of the documents omitted to submit still have to be listed in request form.

(A) A copy of office actions which are relevant to patentability/allowability from the OEE, which were sent in regard to the corresponding OEE patent application, and a translation thereof in Estonian or English.

- All office actions are required.
- Only an office action issued just prior to the “Decision to Grant a Patent” is required.

The applicant does not have to submit a copy of the OEE office actions and translations of them when those documents are provided via the OEE’s dossier access system.¹

Machine translations will be 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.

(B) A copy of all claims determined to be patentable/allowable by the OEE, and a translation thereof in Estonian or English.

The applicant does not have to submit a copy of claims indicated to be patentable/allowable in the OEE, and translations thereof when the documents are provided via the OEE’s dossier access system.

Machine translations will be 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.

¹ Dossier access system; <http://www.jpo.go.jp/pph-portal/filewrapper.htm>

(C) A claims correspondence table

The applicant must submit a claims correspondence table, which indicates how all claims in the OLE application sufficiently correspond to the claims determined to be patentable/allowable by the OEE.

When claims are just literal translation, the applicant can just write down that “they are the 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 above mentioned.

(D) Copies of documents cited by the OEE examiner

The copies of documents to be submitted are those cited in the office action of the OEE.

If a cited document is a patent document, the applicant does NOT have to submit it. In case the OLE has difficulty in obtaining the document, however, the applicant may be asked to submit it.

If a cited document is non-patent literature,
{ **the applicant always has to submit it.**
 it is optional for the applicant to submit it.

Translations of cited documents including patent documents and/or non-patent literature are NOT necessary.

The applicant need not provide further copies of documentation if they have already submitted the documents noted above to the OLE through simultaneous or past procedures related to the application.

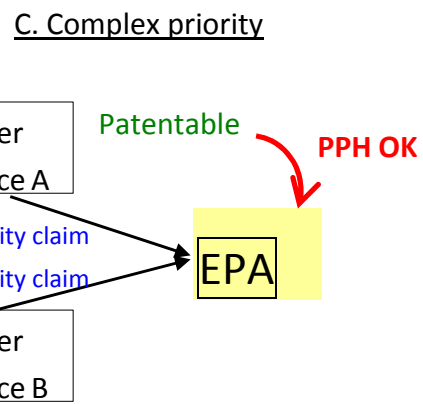
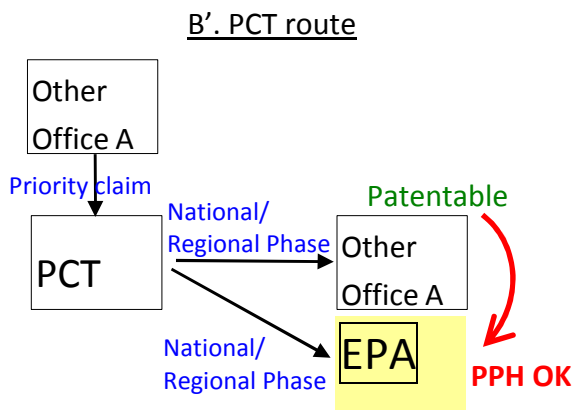
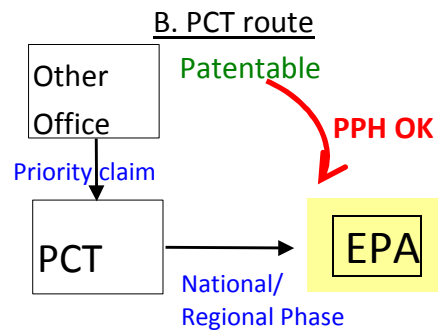
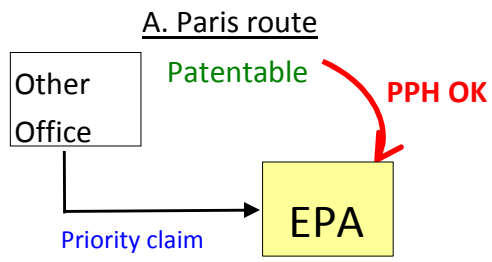
Other Notes

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 may be given at least one opportunity to correct certain specified defects (only one time) .

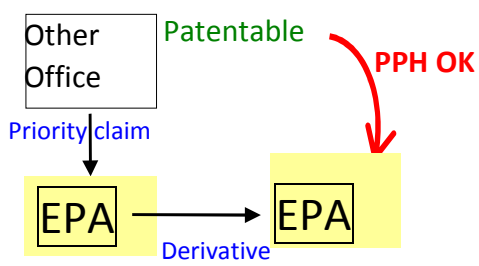
When all requirements for accelerated examination under the PPH program are met, the applicant will be notified that the application was allowed to enter the PPH program.

ANNEX IA

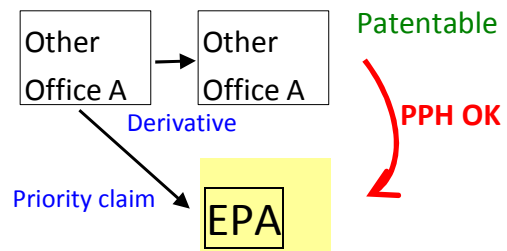
CASE I



D. Derivative application (OLE)

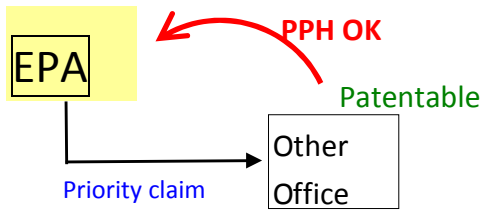


E. Derivative application (OEE)

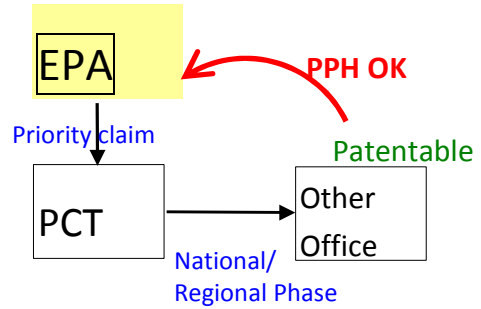


CASE II

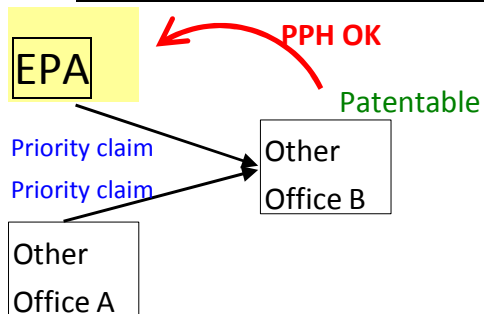
F. Paris route



G. PCT route

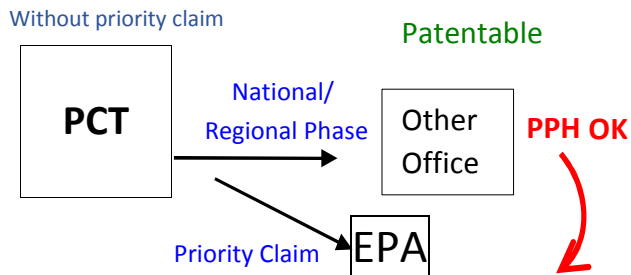


H. Paris route & Complex priority

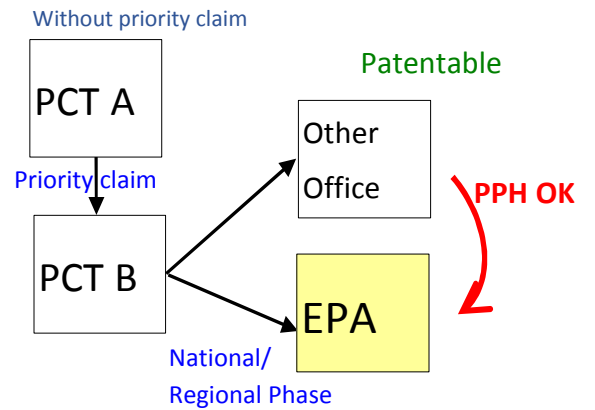


CASE III

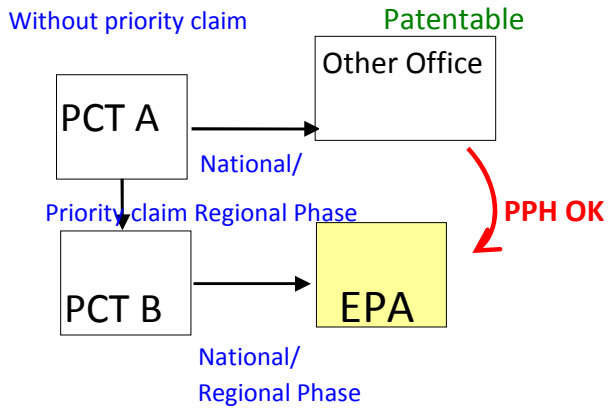
I. Direct PCT & Paris route



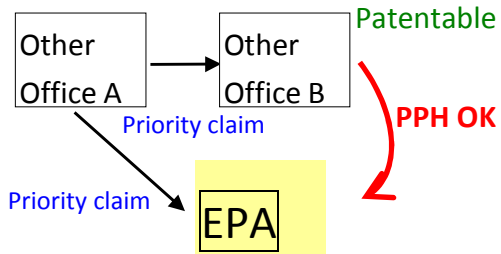
J. Direct PCT & PCT route



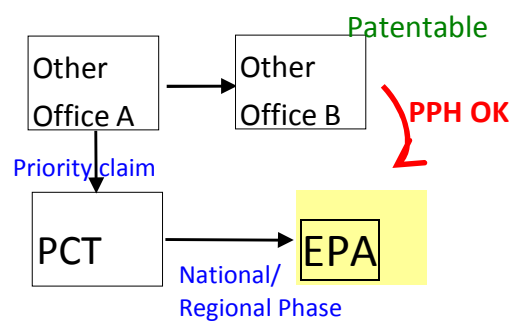
K. Direct PCT & PCT route



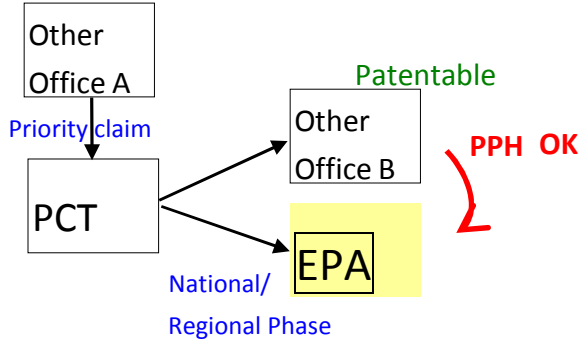
L. Paris route, the third office



M. PCT route, the third office

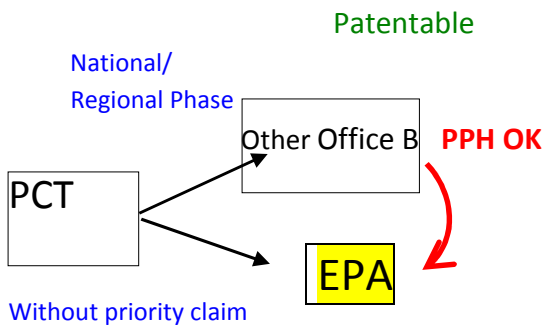


N. PCT route



CASE IV

O. Direct PCT route



ANNEX IB

Corresponding claims are considered to be patentable/allowable as indicated in the following documents:

OEE	Document
IP Australia	A published Accepted or Granted Standard Patent and/or in an office action. An IP Australia office action includes an "Examination Report", "Notice of Acceptance" and a "Notice of Grant/Sealing"
APO	Granted Patent Publication and/or an Office Action entitled: <ul style="list-style-type: none"> - "Erteilungsbefehl" (Decision to grant a patent) - "(Letzter) Vorbescheid" (Office Action relating to Intention to Grant)
CIPO	Granted Patent Publication or an Office Action (Notice of Allowance, Examiner's Report or Final Action Report)
DKPTO	Granted Patent Publication and/or in the office actions entitled: <ul style="list-style-type: none"> - "Godkendelse" ("Grant" in English version letter) - "Berigtigelse af bilag" ("Intention to Grant" in English version letter) - "Resultatet af din n. tekniske behandling af din patentansøgning" ("nth technical examination of your patent application" in English version letter)
EPA	Granted Patent Publication and/or in an Office action "Patendi väljaandmise otsus" (Decision to Grant). Search Report with Written Opinion.
PRH	Granted Patent Publication and/or an Office action ("Office action" or "Communication of Acceptance", in Finnish these are entitled "Välipäätös" or "Hyväksyvä välipäätös")

HIPO	Written Opinion (Írásos vélemény, Letter Code '77') where the claims are explicitly identified as patentable or allowable, Letter relating to Intention to Grant (Letter Code 'SM').
IPO	Granted Patent Publication and/or an Office Action entitled: "Tilkynning um veitingu einkaleyfis" (e. Notification of Grant) or "Fyrirhuguð útgáfa einkaleyfis" (e. Intention to Grant).
ILPO	"Notice of objection in accordance with regulation 41", "Guide to submitting patent applications" mentioning that claims have been allowed, "Notice before acceptance of patent application".

JPO	<p>Granted Patent Publication and/or in an Office action. A JPO Office action includes a "Notification of Reasons for Refusal", "Decision of Refusal", "Appeal Decision" and a "Decision to Grant a Patent".</p> <p>Claims are "determined to be allowable/patentable" when the JPO examiner clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet. For example, if the following routine expression is described in the "Notification of Reason for Refusal" of the JPO, those claims are clearly identified to be allowable/patentable.</p> <p>"<Claims which has been found no reason for refusal> At present for invention concerning Claim __, no reason for refusal is found."</p>
KIPO	Granted Patent Publication and/or in an office action. A KIPO office action includes a "Notification of Reason for Refusal", "Decision to Refuse a Patent" or "Decision to Grant".
NIPO	Granted Patent Publication and/or in the office action entitled "Godkjenning til meddelelse" (Decision to Grant), "Uttalelse" or "Realitetsuttalelse" (Office action)
INPI	Search Report with Written Opinion (Relatório de Pesquisa com Opinião Escrita) where the claims are explicitly identified as patentable, Examination Report (Relatório de Exame), Decision of granting a Patent (Ofício de decisão de Concessão) or Decision of partially granting a Patent (Ofício de decisão de Concessão Parcial).

ROSPATENT	Granted Patent Publication and/or Office action: "Letter of inquiry" (Запрос экспертизы), "Conclusion upon the examination" (Уведомление о результатах проверки патентоспособности) and a "Decision to Grant a Patent" (Решение о выдаче патента).
IPOS	- Written Opinion - Search and Examination Report - Examination Report
SPTO	Granted Patent Publication and/or in the "Resolución de concesión con examen previo de la solicitud de patente" (Granting decision) as part of the substantive examination procedure.
UKIPO	Notification of Grant letter
USPTO	US Letters Patent or in an Office action. A USPTO Office action includes a "Non-Final Rejection", "Final Rejection", "Ex parte Quayle", and a "Notice of Allowability".

Part II PPH using the PCT international work products

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the patent office and satisfies the following requirements under the Patent Prosecution Highway programs based on PCT international work products (PCT-PPH program).

Requirements

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

- (A) The application is a national/regional phase application of the corresponding international application. (See Diagrams A, A', and A'' in Annex II)
- (B) The application is a national/regional application as a basis of the priority claim of the corresponding international application. (See Diagram B in Annex II)
- (C) The application is a national/regional phase application of an international application claiming priority from the corresponding international application. (See Diagram C in Annex II)
- (D) The application is a national/regional application claiming foreign/domestic priority from the corresponding international application. (See Diagram D in Annex II)
- (E) The application is the derivative application (divisional application and application claiming domestic priority etc.) of the application which satisfies one of the above requirements (A) – (D). (See Diagrams E1 and E2 in Annex II)

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 (from the aspect of novelty, inventive steps and industrial applicability).

Note: The applicant can NOT file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

(a)

In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of the PCT-PPH 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-PPH 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)

All claims on file, as originally filed or as amended, for examination under the PCT-PPH 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 in the OLE are of the same or similar scope as the claims indicated as patentable/allowable in the OEE, or the claims in the OLE 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 a claim indicated as patentable/allowable in the OEE is amended to be further limited by an additional feature that is supported in the specification (description and/or claims) of the application.

A claim in the OLE which introduces a new/different category of claims to those claims indicated as patentable/allowable in the OEE is not considered to sufficiently correspond.

For example, the claims indicated as patentable/allowable in the OEE only contain claims to a process of manufacturing a product, then the claims in the OLE are not considered to sufficiently correspond if the claims in the OLE introduce product claims that are dependent on the corresponding process claims.

(c)

- The OLE has not begun examination of the application.
- The OLE has not issued final decision of examination of the application.

(d)

A "Request for Substantive Examination" must have been filed at the OLE either at the time of the PPH request or previously.

(e)

OLE application must have been published.

Documents to be submitted

The applicant must submit the following documents attached to the request form in filing a request under PCT-PPH.

Some of the documents may not be required to submit in certain cases. Please note that the name of the documents omitted to submit still have to be listed in request form.

(A) A copy of the latest international work product which indicated the claims to be patentable/allowable and a translation thereof in Estonian or English.

In case the application satisfies the relationship (A), the applicant need not 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 (registered trademark)”¹, an applicant need not submit these documents, unless otherwise requested by the OLE. (WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date.)

Machine translations will be 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.

(B) A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and a translation thereof in Estonian and English.

If the copy of the set of claims which are indicated to be allowable is available via “PATENTSCOPE (registered trademark)” (e.g. the international Patent Gazette has been published), an applicant need not submit this document unless otherwise requested by the OLE.

¹ <http://www.wipo.int/pctdb/en/index.jsp>

Machine translations will be 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.

(C) A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be allowable.

When claims are just literal translation, the applicant can just write down that “they are the 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 mentioned above.

(D) A copy of references cited in the latest international work product of the international application corresponding to the application.

The copies of documents to be submitted are those cited in the office action of the OEE.

If a cited document is a patent document, the applicant does not have to submit it. In case the OLE has difficulty in obtaining the document, however, the applicant may be asked to submit it.

If a cited document is non-patent literature,

- the applicant always has to submit it.
 it is optional for the applicant to submit it.

Translations of cited documents including patent documents and/or non-patent literature are NOT necessary.

The applicant need not provide further copies of documentation if they have already submitted the documents noted above to the OLE through simultaneous or past procedures related to the application.

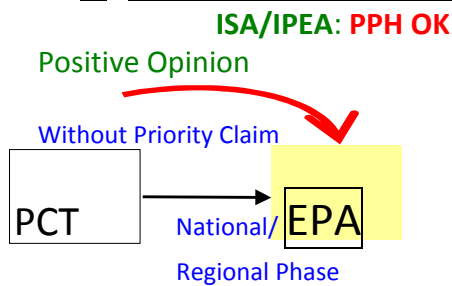
Other Notes

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 may be given at least one opportunity to correct certain specified defects only (one time).

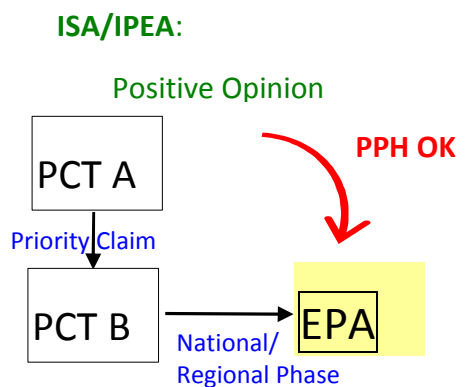
When all requirements for accelerated examination under the PPH program are met, the applicant will be notified that the application was allowed to enter the PPH program.

ANNEX II

A. National phase application



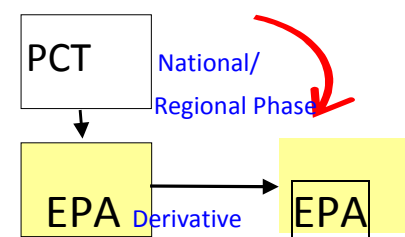
C. National phase application



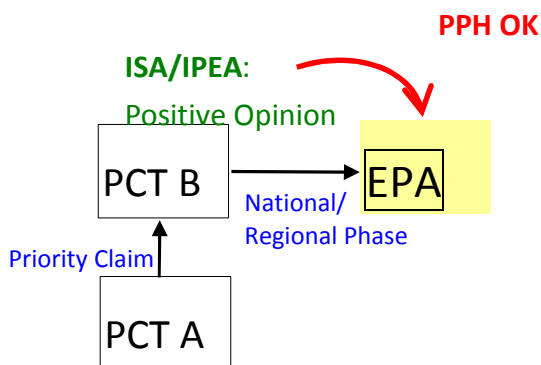
E. Derivative application

ISA/IPEA: Positive Opinion

PPH OK

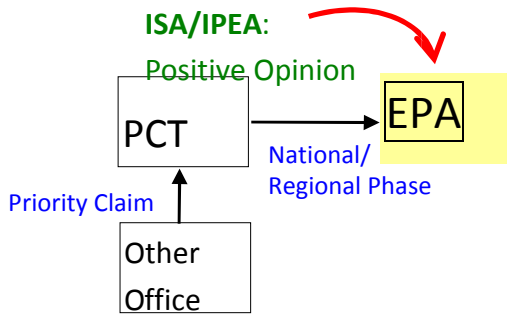


A''. National phase application

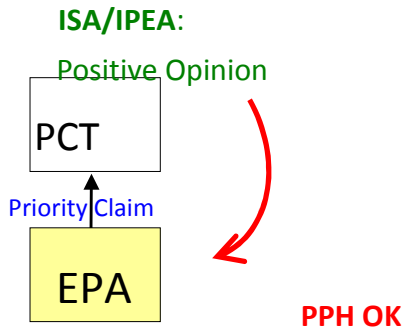


A'. National phase application

PPH OK



B. Priority application



D. Application claiming priority

