

**Procedures to file a request to the
National Board of Patents and Registration of Finland
for the
Patent Prosecution Highway
Pilot Program between the
United States Patent and Trademark Office
and the
*National Board of Patents and Registration of Finland***

Request to the NBPR

An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the National Board of Patents and Registration of Finland (NBPR) by submitting a letter requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the NBPR for accelerated examination under either the PPH or the PCT-PPH are given in sections 1 and 4 and relevant supporting documentation is discussed in sections 2 and 5.

Part 1: PPH using the national work products from USPTO

1. Requirements for requesting accelerated examination under the PPH pilot program at the NBPR

An application which is filed with the NBPR and which fulfills all the following requirements is eligible for accelerated examination under the PPH.

1.1 The NBPR application (including a PCT national phase application) is either:

- (A) an application which validly claims priority under the Paris Convention to the USPTO application(s) (examples are provided in Annex 2: figures A, B, C, D, E, and F), or
- (B) a PCT national phase application without priority claim (an example is provided in Annex 2: figure G), or
- (C) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in Annex 2: figures F, H, and I).

The NBPR application, which validly claims priority to multiple USPTO or PCT applications, or which is the divisional application validly based on the originally filed application that is included in (A) through (C) above, is also eligible.

1.2 At least one corresponding application exists in the USPTO and has one or more claims that are determined to be patentable/allowable by the USPTO

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 PPH pilot program, even if the application, which includes those claims is not granted for patent yet.

[Note]

Where the USPTO application that contains the patentable/allowable claims is not the same application for which priority is claimed in the NBPR application, the applicant must identify the relationship between the USPTO application that contains the patentable/allowable claims and the USPTO priority application claimed in the NBPR application. (See examples D and E in Annex 2.)

1.3 All claims in the NBPR application (for which an accelerated examination under the PPH pilot program is requested) must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the USPTO.

Claims are considered to sufficiently correspond where both claims have a common technical feature which made the claims patentable over the prior art in the USPTO application. In this regard, a claim which has an additional component on the claim determined to be patentable in the USPTO, or which apart from claim format is the same as the claim determined to be patentable in the USPTO, will be considered to sufficiently correspond.

Note that when claims are determined to be patentable by the USPTO by making amendment to claims, the claims in the NBPR also must be amended in a similar way to sufficiently correspond to the allowable/patentable claims in the USPTO application. (See example in Annex 1.)

1.4 The NBPR has not yet issued a “Communication of Approval”

The NBPR has not yet issued a “Communication of Approval.” (The heading of the communication is “Hyväksyvä välipäätös.”)

2. Documents to be submitted to file a request for accelerated examination under the PPH

An applicant who requests for accelerated examination under the PPH should submit a request form along with the documents listed below.

[Note]

Even when it is not needed to submit documents below, the name of the documents must be listed in the request form.

2.1 A copy of the office action(s) relating to the corresponding USPTO application(s)

The term “office actions” here used refers to the correspondence sent to the applicant or the applicant’s representative from the USPTO examiner. The applicant can either provide the office actions together with the request for acceleration under the PPH or request that the NBPR obtain the documents from the USPTO Public PAIR system.

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

2.2 A copy of the claims determined to be patentable by the USPTO including any subsequent amended claims found to be patentable by the USPTO

The applicant can either provide the claims together with the request for acceleration under the PPH or request that the NBPR obtain the claims from the USPTO Public PAIR system.

2.3 A copy of the references cited by the USPTO examiner

If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the NBPR. If the NBPR does not have access to the relevant patent documents, the applicant must submit these documents at the request of the NBPR. Non-patent literature must always be submitted.

Submission of translation 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 the applicants so desire.

2.4 A completed claim correspondence table showing the relationship between the claims of the NBPR 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 or similar scope as defined above in section 1.3. The claim correspondence table must indicate how all the claims in the NBPR application correspond to the patentable claims in the USPTO application as shown in Annex 1. The claim correspondence table must be written in either English or Finnish.

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 USPTO application(s). The 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 USPTO application(s), the amendment will not be entered.

2.5 When the US file wrapper is not available via USPTO Public PAIR

In those rare situations where the US application has not been published, and therefore the US file wrapper is not available via the USPTO Public PAIR system, the applicant will be responsible for providing the necessary documents to the NBPR.

Part 2: PPH using the PCT international work products

4. Requirements

The application which is filed with the NBPR and on which the applicant files a request for an accelerated examination under the PCT-PPH must satisfy the following requirements:

4.1 The relationship between the application and the corresponding international application

The relationship between the application and the corresponding international application satisfies one of the following requirements (including the case that the Office of the application is the same as the ISA/IPEA of the corresponding international application):

(A) The application is a national phase application of the corresponding international application (examples are provided in Annex 3: figures A, A', and A'').

(B) The application is a national application as a basis of the priority claim of the corresponding international application (example is provided in Annex 3: figure B).

(C) The application is a national phase application of an international application claiming priority from the corresponding international application (example is provided in Annex 3: figure C).

(D) The application is a national application claiming foreign/domestic priority from the corresponding international application (example is provided in Annex 3: figure D).

(E) The application is the derivative application (divisional application, application claiming internal priority, etc.) of the application which satisfies one of the above requirements (A) – (D) (examples are provided in Annex 3: figures E1 and E2).

4.2 The application has one or more claims that are determined to be patentable/allowable in the work product of the corresponding PCT application

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 Searching Authority (WO/ISA), the Written Opinion of International Preliminary Examining 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). The applicant cannot file a request under PCT-PPH 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 a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation whether or not an amendment is submitted to correct the observation. The application will not be eligible for participating in PCT-PPH pilot program if the applicant does not explain why the claim(s) is/are not subject to the observation. 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.

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER must be the USPTO, but, if priority is claimed, the priority claim can be to an application in any Office, see Annex 3, example A' (application ZZ can be any national application).

4.3 Claim correspondence

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 as patentable/allowable in the latest international work product of the corresponding international application.

Claims are considered to sufficiently correspond where both claims have a common technical feature which made the claims patentable over the prior art in the latest international work product of the corresponding international application. In this regard, a claim which has an additional component on the claim determined to be patentable in the latest international work product, or which is the same apart from claim format as the claim determined to be patentable in the latest international work product, will be considered to sufficiently correspond.

A claim of the application which introduces a new/different category of claims to those claims indicated as patentable/allowable in the latest international work product is not considered to sufficiently correspond. For example, the claims indicated as patentable/allowable in the latest international work 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-PPH pilot program need to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product.

4.4 The office of the application has not yet issued a “Communication of Approval”

The NBPR has not yet issued a “Communication of Approval.” (The heading of the communication is “Hyväksyvä välipäätös.”)

5. Documents to be submitted to file a request for accelerated examination under the PCT-PPH

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

5.1 A copy of the latest international work product of the corresponding international application

In case the application satisfies the relationship 4.1 (A), the applicant does **not** need to submit a copy of the International Preliminary Report on Patentability (IPRP) because a copy of these documents is already available in the file-wrapper of the application. In addition, if the copy of the latest international work product is available via PATENTSCOPE^{®*}, an applicant does not need to submit these documents, unless otherwise requested by the patent Office (WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date.)

5.2 A copy of a set of claims which the latest international work product of the corresponding international application indicated as patentable/allowable

A copy of a set of claims which the latest international work product of the corresponding international application indicated as patentable/allowable, and a copy of the English or Finnish translation.

If the copy of the set of claims which are indicated as patentable/allowable is available via PATENTSCOPE[®] (or the international Patent Gazette has been published), an applicant does not need to submit this document, unless otherwise requested by the patent Office. Where translations of the patentable/allowable claims are necessary, they must be submitted by the applicant since PATENTSCOPE[®] does not provide them.

5.3 Copies of references cited in the latest international work product of the corresponding international application

If the references are patent documents, the applicant does not have to submit them because the office of the application usually has access to them. When the office of the application does not have access to the patent document, the applicant has to submit the patent document at the examiner’s request. Non-patent literature must always be submitted.

Submission of translation 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 the applicants so desire.

5.4 Claim correspondence table

The applicant must submit a claim correspondence table to explain the correspondence of claims determined to be patentable/allowable in the latest work product of the corresponding international application and all claims in the application.

When the applicant has already submitted the documents mentioned above in paragraphs 5.1 – 5.4 to the patent Office in an examination procedure of the patent family application, through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

5.5 Request form

An applicant should submit a request form (See Annex 5) for the accelerated examination under the PCT-PPH along with the documents referred to in paragraphs 5.1-5.4.

Procedure for the accelerated examination under the PPH

The applicant files a letter requesting accelerated examination under the PPH Pilot Program to the NBPR, including the relevant supporting documents and a completed request form (for PPH see Annex 4 and for PCT-PPH see Annex 5).

The NBPR decides whether the application can be entitled the status of accelerated examination under the PPH when NBPR receives a request with the documents stated above. When NBPR decides that a request is acceptable, the application is assigned a special status for accelerated examination.

If 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 the defect(s) are not corrected, the applicant will be notified, and the application will await action in its regular turn.

ANNEX 1

Examples for the claim correspondence

The claims in the following cases are considered to “sufficiently correspond”.

EX.1

<i>USPTO claims</i>	<i>NBPR claims</i>	<i>Comment</i>
1	1	<i>The NBPR claim has the additional component on the USPTO granted claim.</i>

OFF granted claim	OSF claim
<p>A system for presenting a container storing at least one article to a processing tool, comprising:</p> <p>(a) a load port, including: a frame having an opening; a support structure being adapted to receive a container, and a drive mechanism for moving said support structure substantially vertically between a first height and a second height; and</p> <p>(b) a conveyor for movably supporting the container substantially along a container transport plane; wherein a container traveling on said conveyer moves unobstructed over said support structure when said support structure is located in said second height, wherein the container traveling unobstructed does not contact said support structure while traveling over said support structure located at said second height, wherein said support structure, when located at said second height, is located below said transport plane.</p> <p><u>*This additional part is NOT included in the OFF granted claim but it is included in the description of the OFF application</u></p>	<p>A system for presenting a container storing at least one article to a processing tool, comprising:</p> <p>(a) a load port, including: a frame having an opening; a support structure being adapted to receive a container, and a drive mechanism for moving said support structure substantially vertically between a first height and a second height; and</p> <p>(b) a conveyor for movably supporting the container substantially along a container transport plane; wherein a container traveling on said conveyer moves unobstructed over said support structure when said support structure is located in said second height, wherein the container traveling unobstructed does not contact said support structure while traveling over said support structure located at said second height, wherein said support structure, when located at said second height, is located below said transport plane, <i>wherein said support structure, when located at said first height, is located above said transport plane*.</i></p>

EX.2

<i>USPTO claims</i>	<i>NBPR claims</i>	<i>Comment</i>
<i>1</i>	<i>1</i>	<i>Same</i>
<i>none</i>	<i>2</i>	<i>The NBPR claim2 is dependent on the NBPR claim1, which has been granted at USPTO.</i>

OFF granted claim	OSF claim
1. A nitride-based semiconductor device comprising: a first semiconductor layer, consisting of either an n-type nitride-based semiconductor layer having a wurtzite structure or an n-type nitride-based semiconductor substrate having a wurtzite structure; and an n-side electrode formed on a back surface of said first semiconductor layer, wherein a dislocation density is not more than $1 \times 10^9 \text{ cm}^{-2}$ in the vicinity of the interface between said first semiconductor layer and said n-side electrode, and contact resistance between said n-side electrode and said first semiconductor layer is not more than $0.05 \text{ } \Omega \text{ cm}^2$	1. (Same)
2. (None)	2. <i>The nitride-based semiconductor device according to claim 1, wherein said first semiconductor layer includes an n-type dopant.*</i>

*This additional part is NOT included in the OFF granted claim but it is included in the description of the OFF application

ANNEX 2

Examples of NBPR applications eligible for PPH

Figure A:

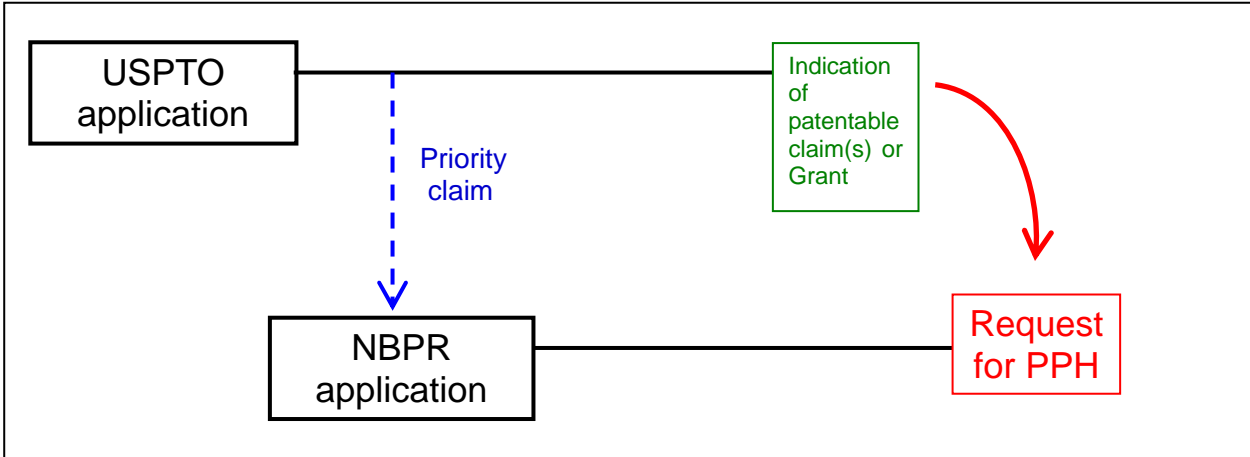
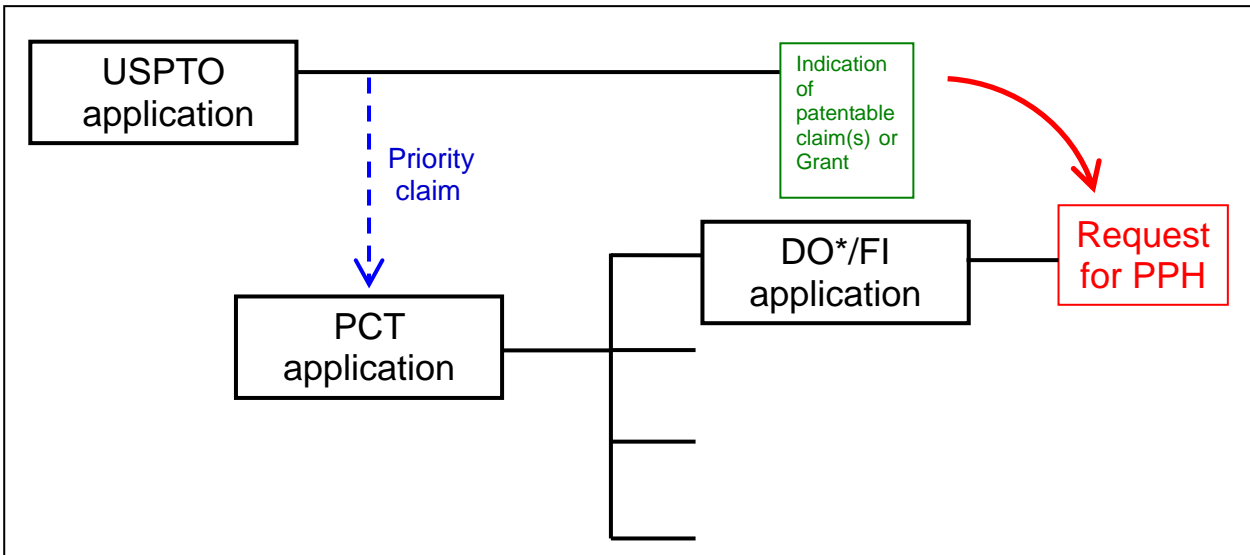


Figure B:



* DO – Designated Office

Figure C:

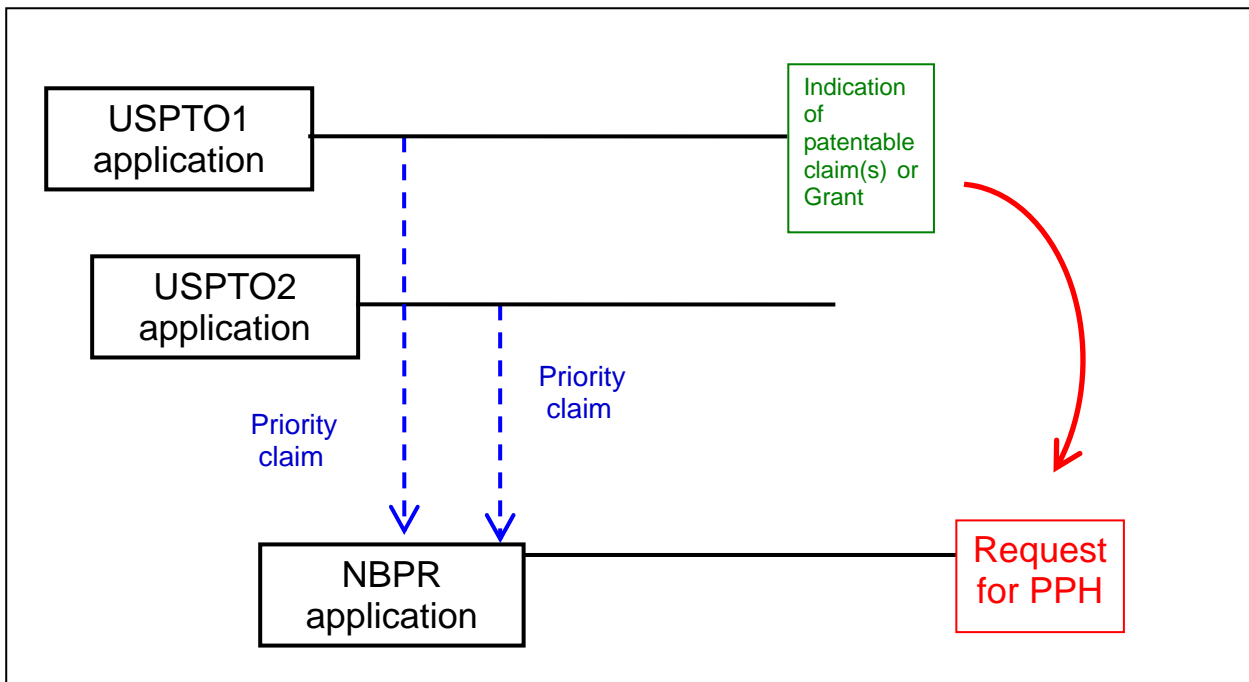


Figure D:

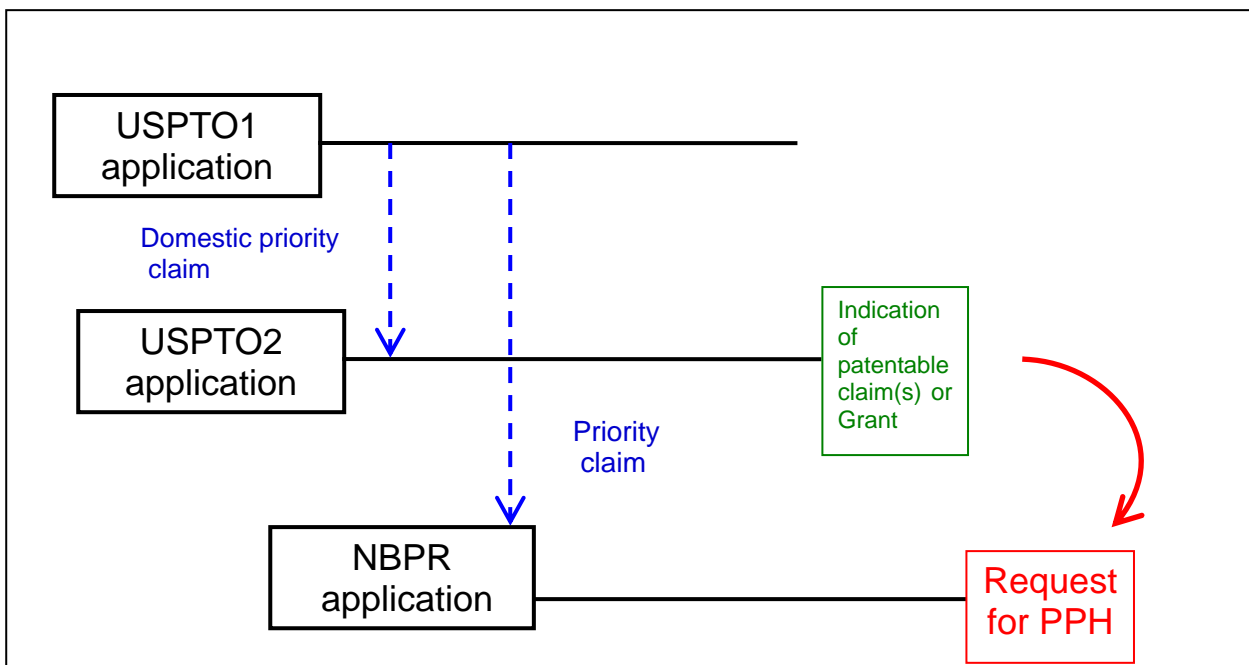


Figure E:

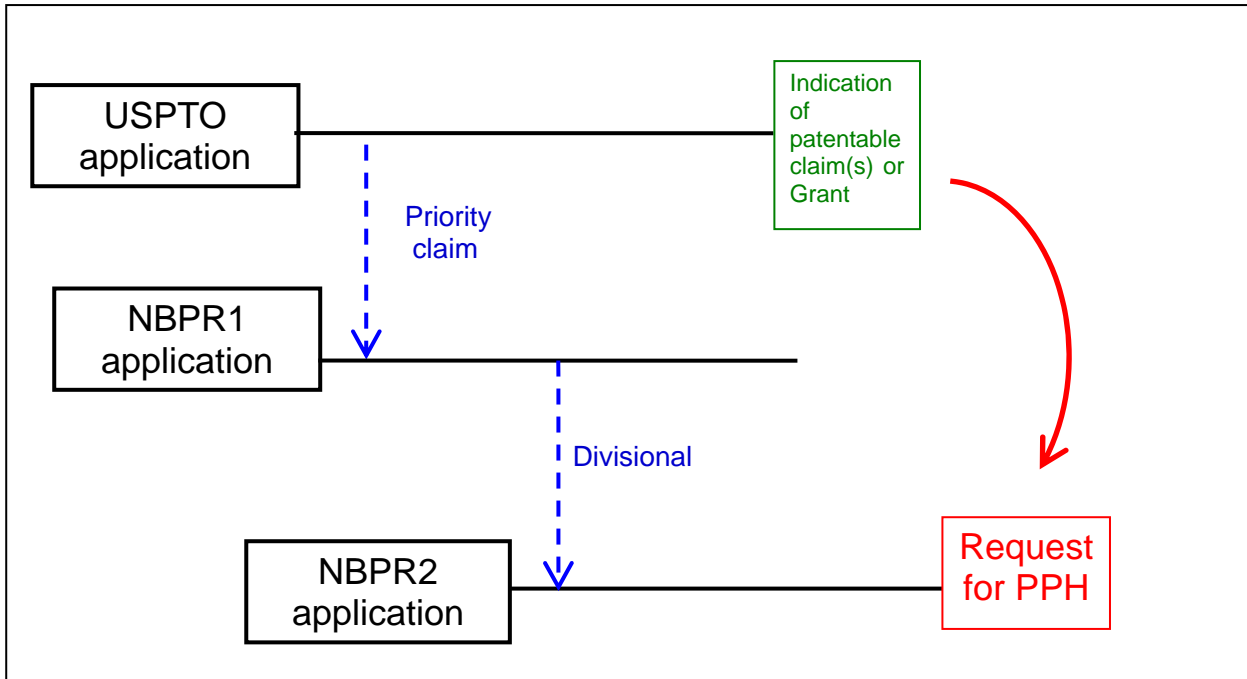


Figure F:

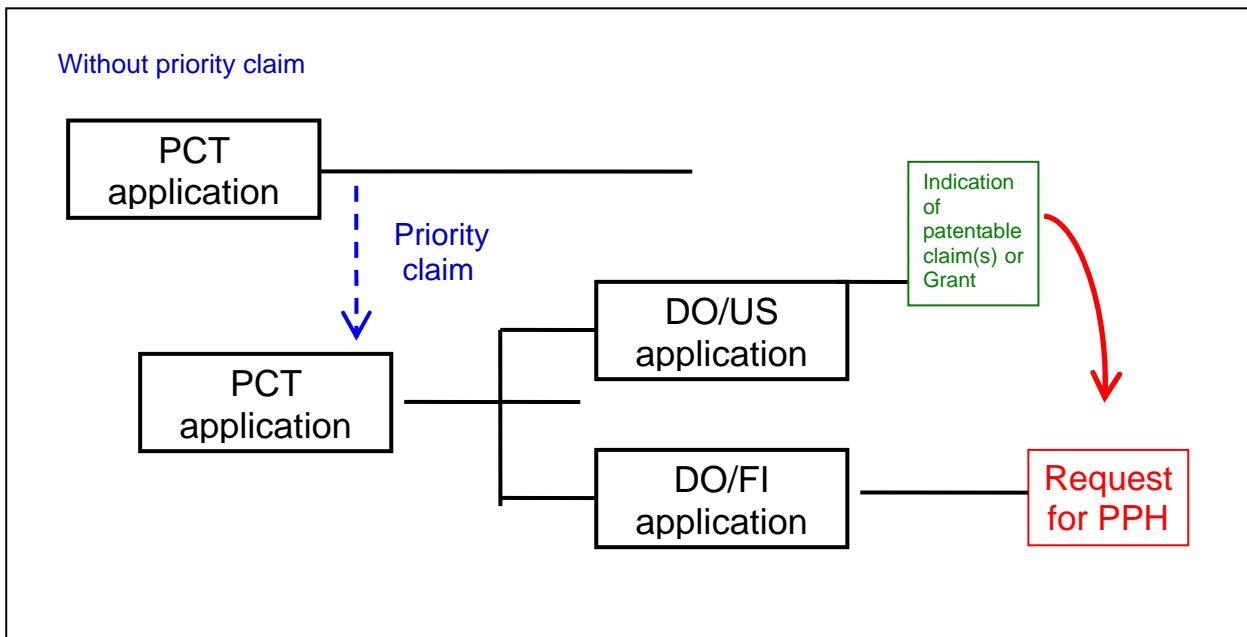


Figure G:

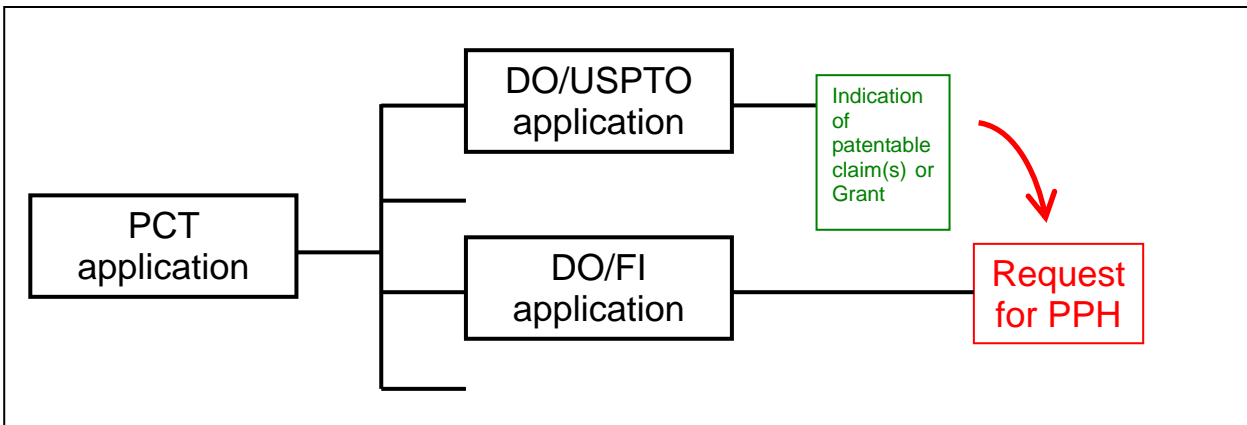


Figure H:

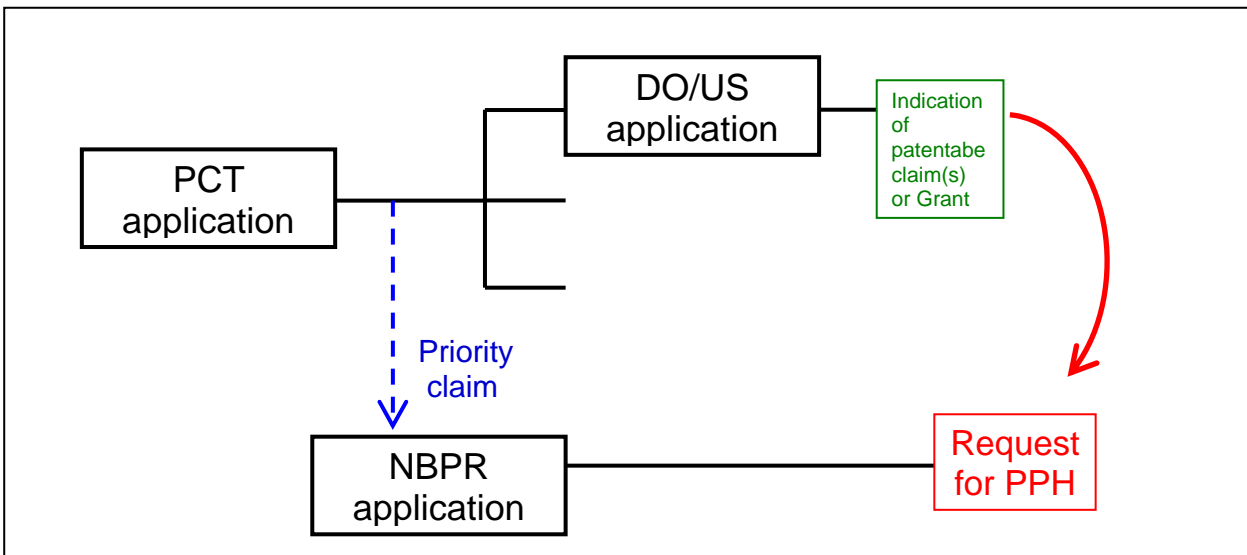


Figure I:

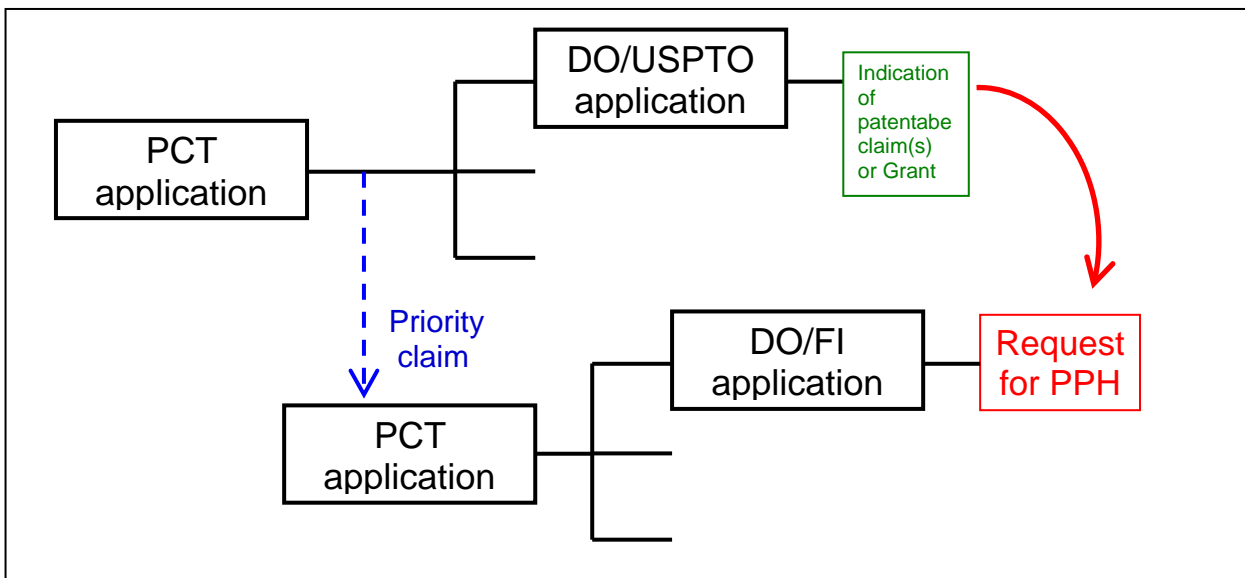
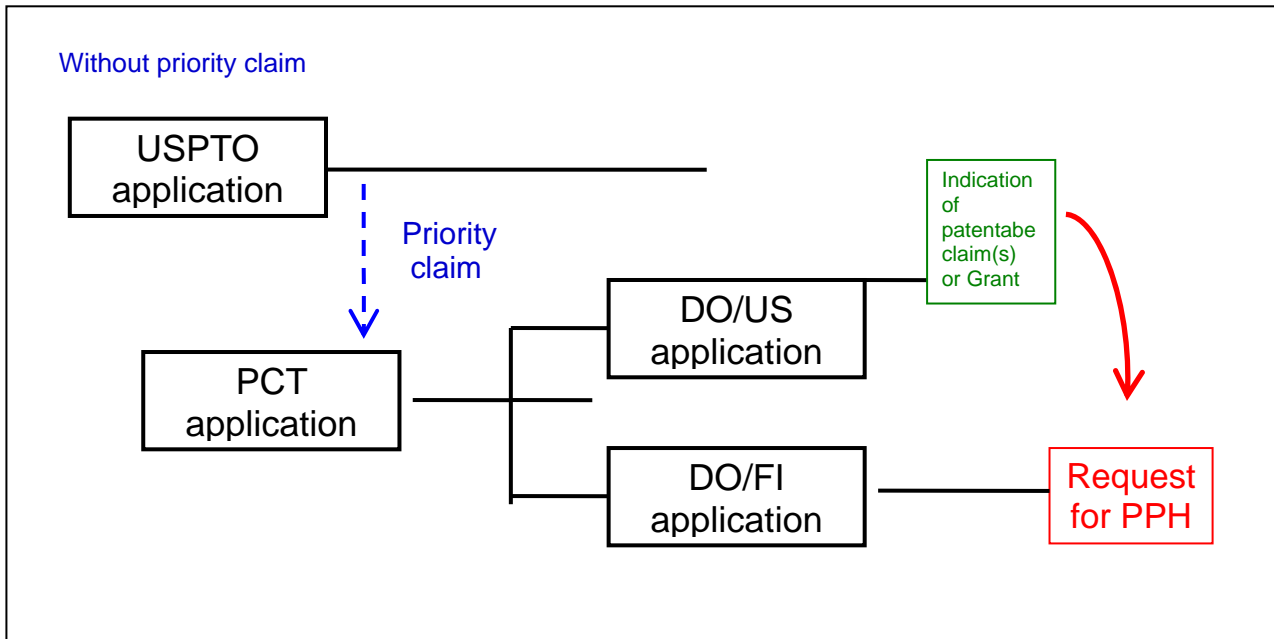


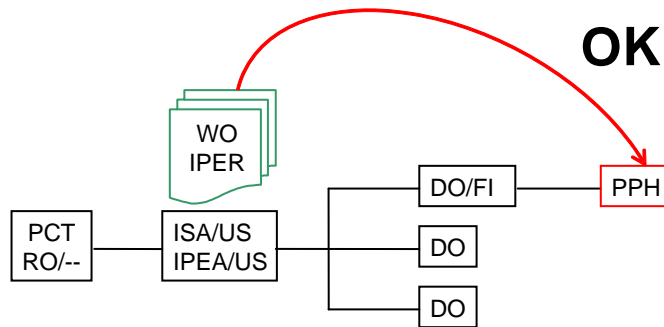
Figure J:



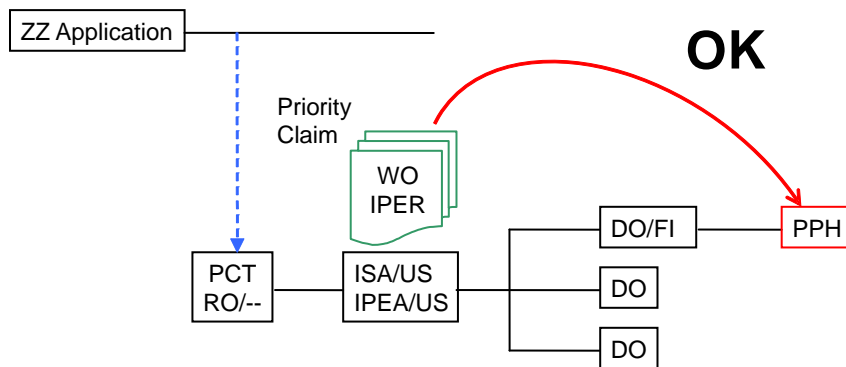
ANNEX 3

Examples of the applications eligible for PCT-PPH

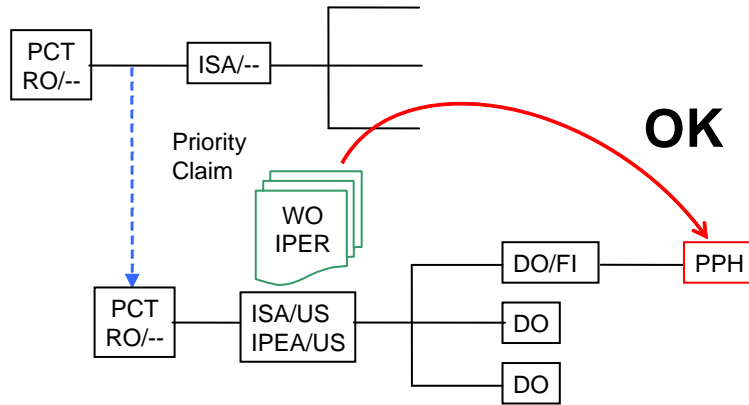
(A) The application is a national phase application of the corresponding international application.



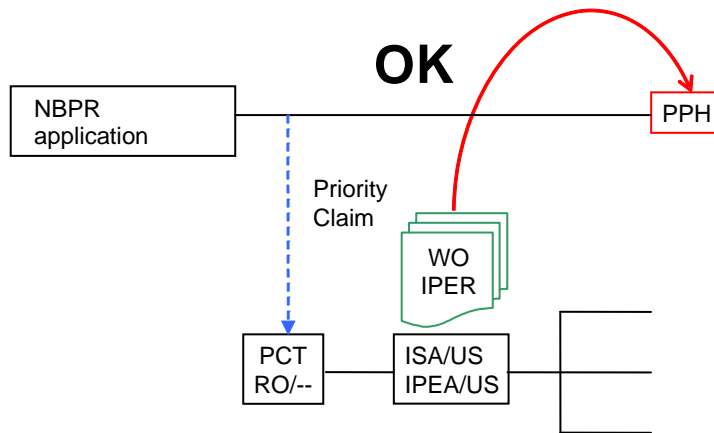
(A') The application is a national phase application of the corresponding international application. (The corresponding international application claims priority from a national application.)



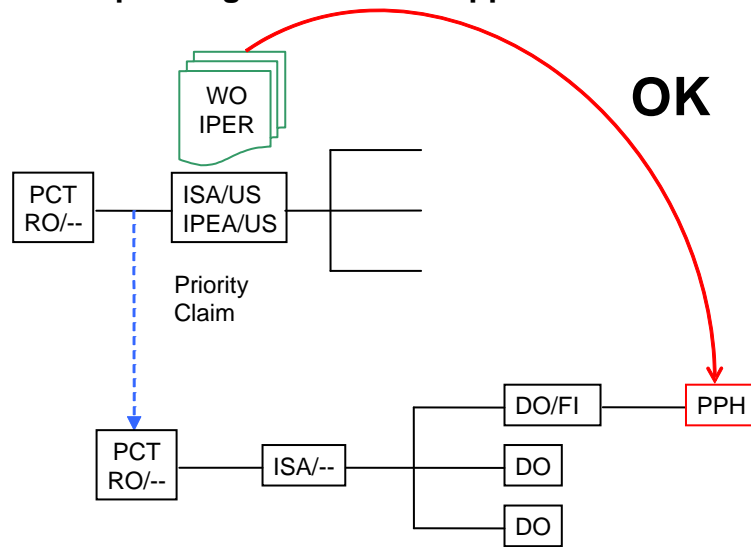
(A'') The application is a national phase application of the corresponding international application.
 (The corresponding international application claims priority from an international application.)



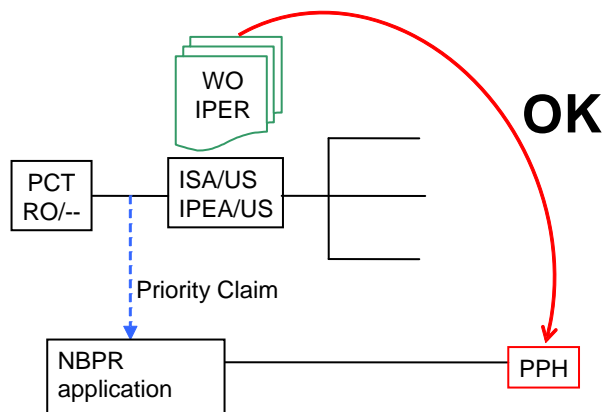
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



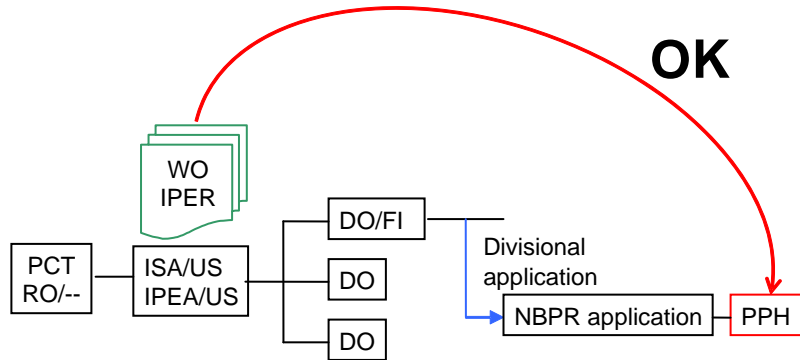
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



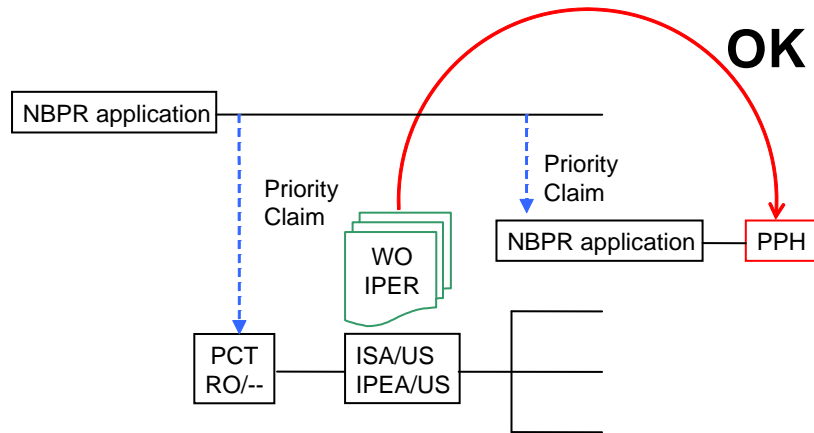
(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



(E1) The application is a divisional application of an application which satisfies the requirement (A).



(E2) The application is an application claiming domestic priority from an application which satisfies the requirement (B).



ANNEX 4

PPH REQUEST

Request for Accelerated Examination at the NBPR Under the Patent Prosecution Highway Pilot Program Between the NBPR and the USPTO

- 1 NBPR application number:
Corresponding USPTO application number(s):

- 2 **Either:**
 - a) Copy of USPTO office action(s) attached:
 - or**
 - b) USPTO office action(s) available via Public PAIR:
 - or**
 - c) USPTO office action(s) on file from previous PPH application:
NBPR application number:

- 3 **Either:**
 - a) Copy of claims of corresponding USPTO application attached:
 - or**
 - b) Claims of corresponding USPTO application available via Public PAIR:
 - or**
 - c) USPTO application claims on file from previous PPH application:
NBPR application number:

- 4 Claim correspondence table completed:

ANNEX 5

PCT-PPH REQUEST

Request for Accelerated Examination at the NBPR using the PCT international work products under the Patent Prosecution Highway Pilot Program Between the NBPR and the USPTO (PCT-PPH pilot program)

FI application number:

Corresponding PCT application number:

For the purposes of participation in the PPH, the following documents should be attached/are required:

1. Either:
 - 1.1 A copy of WO-ISA or IPER and translation thereof in English or Finnish
or
 - Request to obtain documents in 1.1 via PATENTSCOPE®

2. Either:
 - 2.1 A copy of all claims determined to be patentable/allowable by the ISA or IPEA
or
 - Request to obtain documents in 2.1 via the PATENTSCOPE®

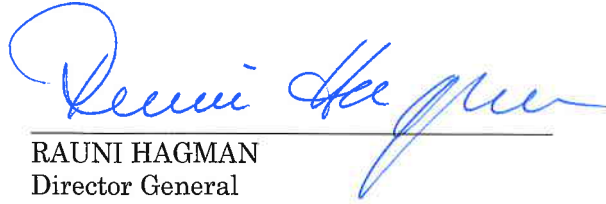
3. Translation of the documents in 2. in English or Finish.

4. Copies of all documents cited in the WO-ISA or IPER (except for patent documents)

5. Claims correspondence table

This notice is accepted by

Date: 13. 1. 2011



RAUNI HAGMAN
Director General
National Board of Patents and
Registration of Finland