

Procedures to file a request to the NBPR for Patent Prosecution Highway Pilot Program between the APO (Austrian Patent Office) the NBPR (National Board of Patent 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 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 the PPH and 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 the APO

1. Requirements for requesting an 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 an 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 APO application(s) (examples are provided in Annex 2, figure A, B, C, D, E and F), or
- (B) a PCT national phase application without priority claim (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 H, I and J).

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

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[Note]

It is noted that the application is NOT eligible for the PPH pilot program in case where the examination was conducted in the EPO (not in APO) and the patent right was validated in APO as a designated state.

1.2 At least one corresponding application exists in the APO and has one or more claim(s) that are determined to be patentable/allowable by the APO

Claims clearly identified to be patentable in the latest office action at examination stage are able to be a base of a request for an accelerated examination under the PPH pilot program, even if the application, which includes those claims is not granted for patent yet. The following cases will fall within this interpretation: an APO examiner sends a notification specifying the APO's intention to grant. The headings for such notifications will be "Communication of Approval" (The heading of the communication is "Erteilungsbeschluss").

[Note]

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

1.3 All claims in the NBPR (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 APO.

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 APO application. In this regard, a claim which has additional component on the claim determined to be patentable in the APO or which is the same except for claim format as the claim determined to be patentable in the APO will be considered to sufficiently correspond.

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

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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 for accelerated examination under the PPH along with the four 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 Copies and translation of all office actions at the APO

“Office action” means documents which relate to substantive examination and which were sent to an applicant by the APO examiner. The office action documents include all issued “Official Letters”, “Search Report”, “Decisions”.

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

2.2 A Copy and translation of all claims determined to be patentable/allowable by the APO

The copy of the claims determined to be patentable/allowable by the APO might be either:

- a copy of the document submitted at initial filing which includes claims determined to be patentable/allowable where no later amendments to the claims have been made, or
- a copy of the amendments which includes claims determined to be patentable/allowable where later amendments to the claims have been made, or
- a copy of the APO’s publication of the granted patent.

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Both Finnish and English are acceptable as translation language. The descriptions in the requirement 2.1 above regarding machine translation are also applicable to this requirement 2.2.

2.3 Copies of references cited by the APO examiner

If the references are patent documents, the applicant doesn't have to submit them because the NBPR usually possesses them. When the NBPR does not possess 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 they so desire.

2.4 Claim correspondence table

An applicant must submit a claim correspondence table to explain the correspondence of claims determined to be patentable/allowable in the APO and all claims in the NBPR. 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 1.3. (See also Annex 1 for the examples of the claim correspondence).

3. Request form

An applicant should submit a request form (See Annex 4) for the accelerated examination under the PPH along with the documents referred in paragraphs 2.1-2.4.

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, figure 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 claim(s) 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

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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 APO, 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 additional component on the claim determined to be patentable in the latest international work product or which is the same except for 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 not to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product.

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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 need **not** submit a copy of the International Preliminary Report on Patentability (IPRP) 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 is available via “PATENTSCOPE”¹, an applicant need not 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 need not submit this document, unless otherwise requested by the patent Office. Where translations of the patentable/allowable claims are necessary, they must be submitted by an applicant since “PATENTSCOPE” does not provide them.

² <http://www.wipo.int/pctdb/en/index.jsp>

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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 doesn't have to submit them because the office of the application usually possesses them. When the office of the application does not possess 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 they so desire.

5.4 Claim correspondence table

An 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 above mentioned 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.

6. 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 in paragraphs 5.1-5.4.

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Procedure for the accelerated examination under the PPH

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

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 not corrected, the applicant will be notified and the application will await action in its regular turn.

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ANNEX 1

Examples for the claim correspondence

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

EX.1

<i>APO claims</i>	<i>NBPR claims</i>	<i>Comment</i>
1	1	<i>The NBPR claim has the additional component on the APO 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>

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EX.2

<i>APO 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 APO.</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. The nitride-based semiconductor device according to claim 1, wherein said first semiconductor layer includes an n-type dopant.*

*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 application eligible for the PPH

Figure A:

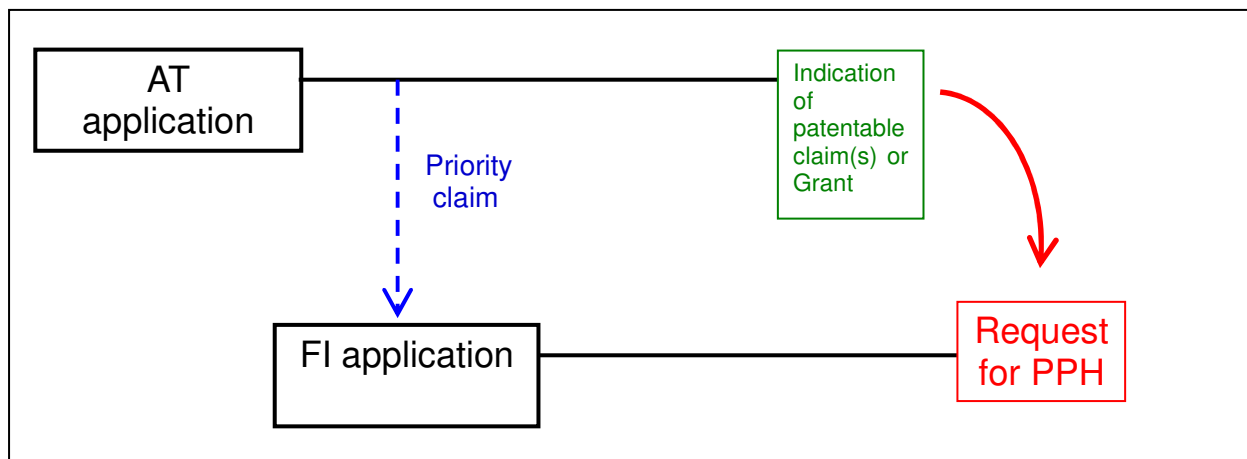
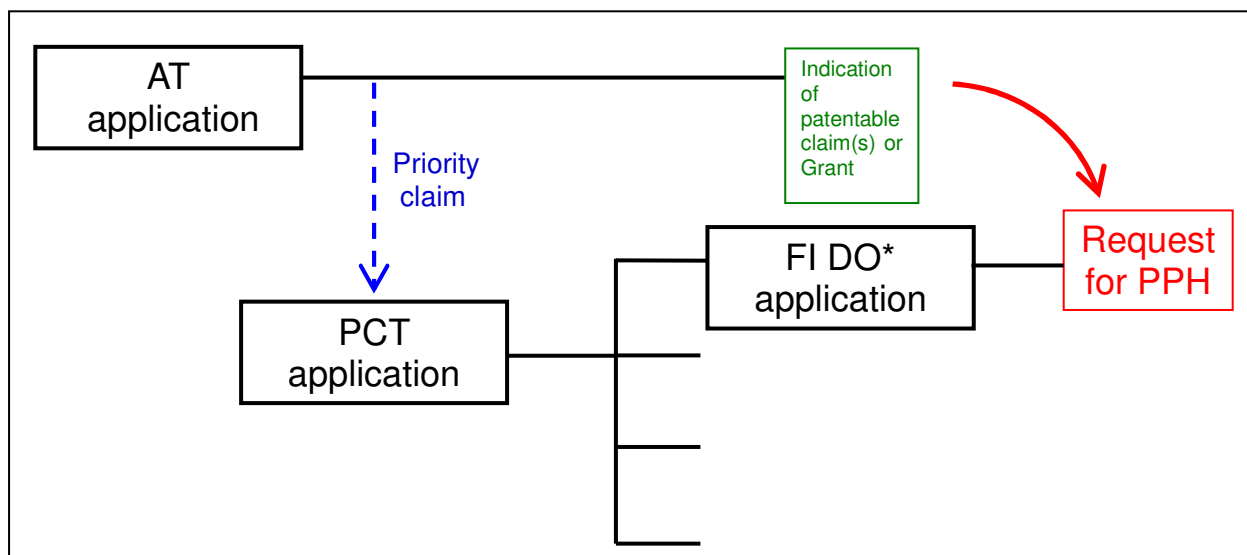


Figure B:



* DO – Designated Office

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Figure C:

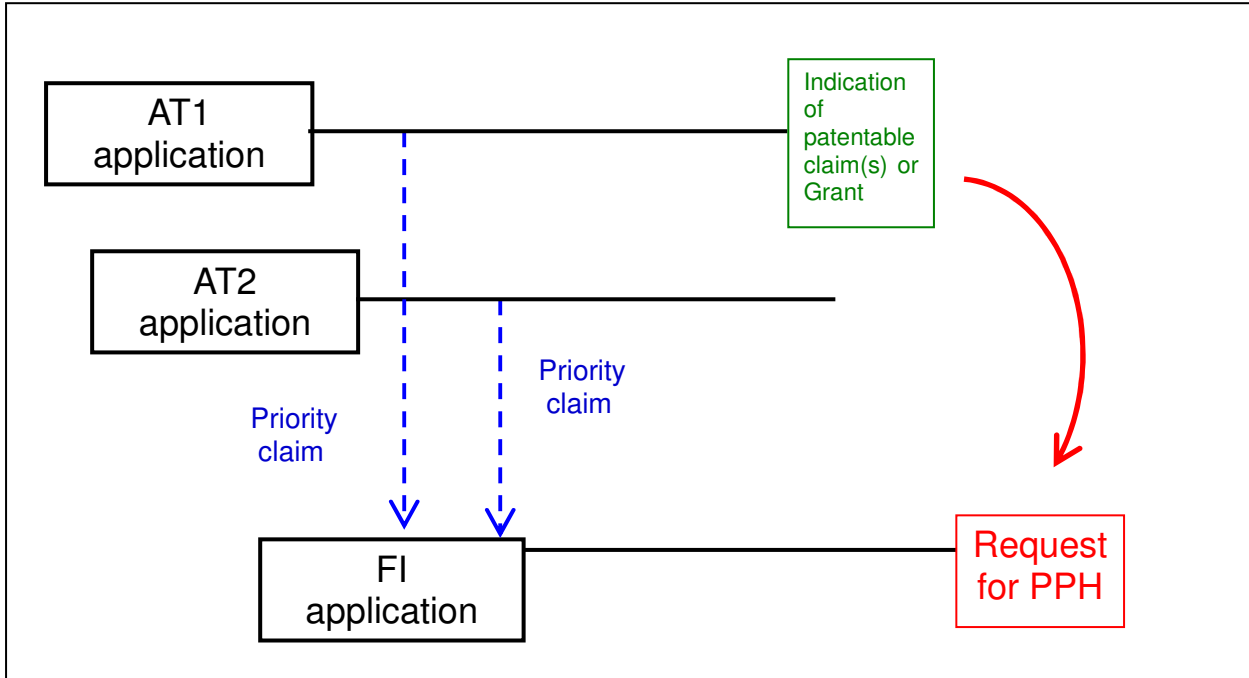
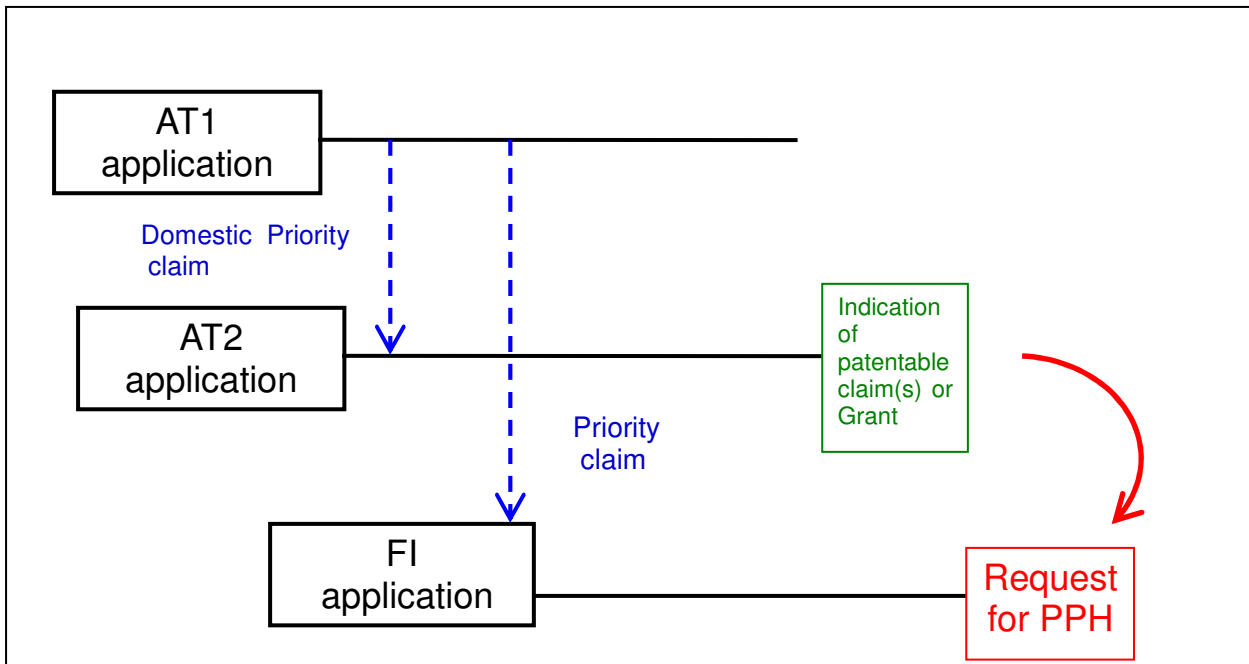


Figure D:



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Figure E:

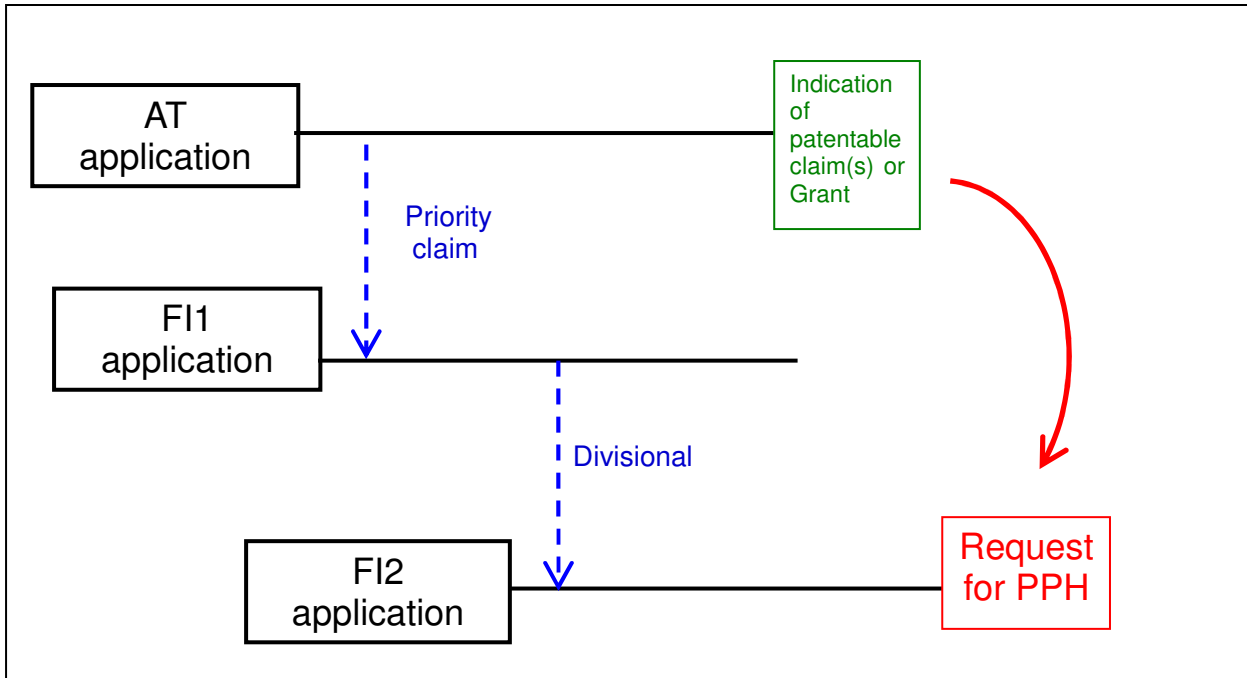
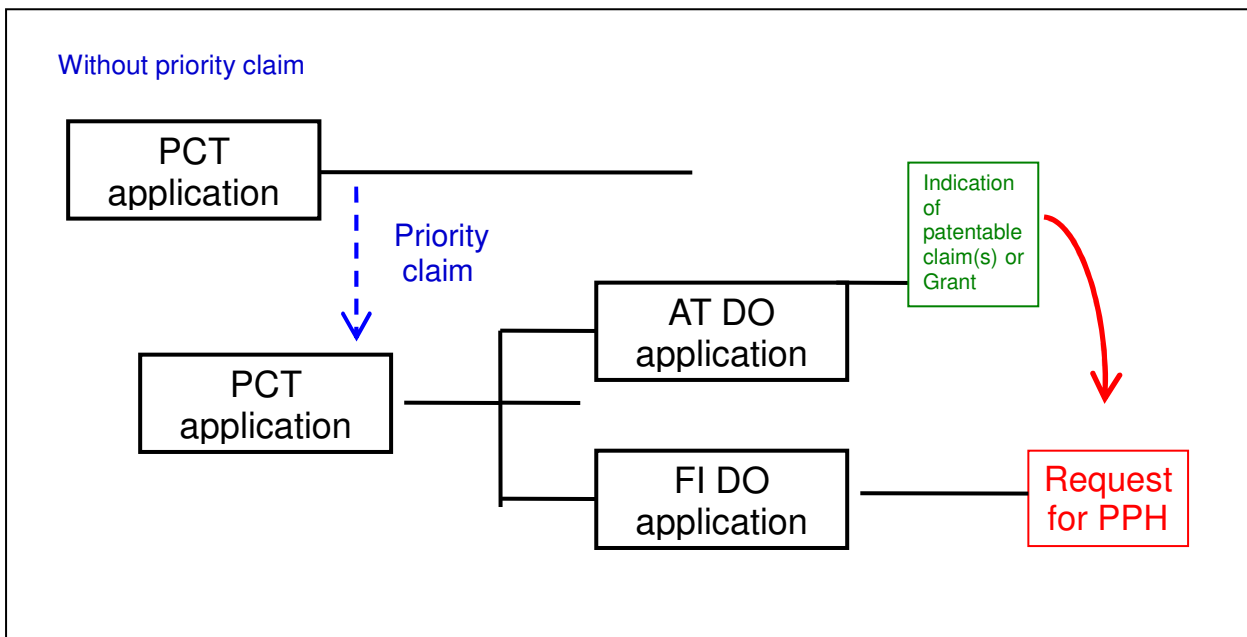


Figure F:



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Figure G:

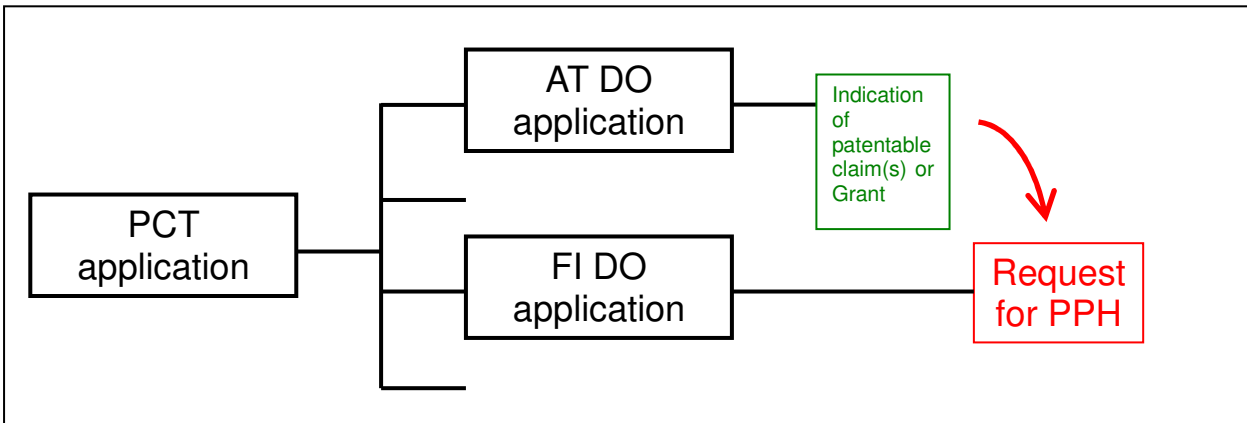


Figure H:

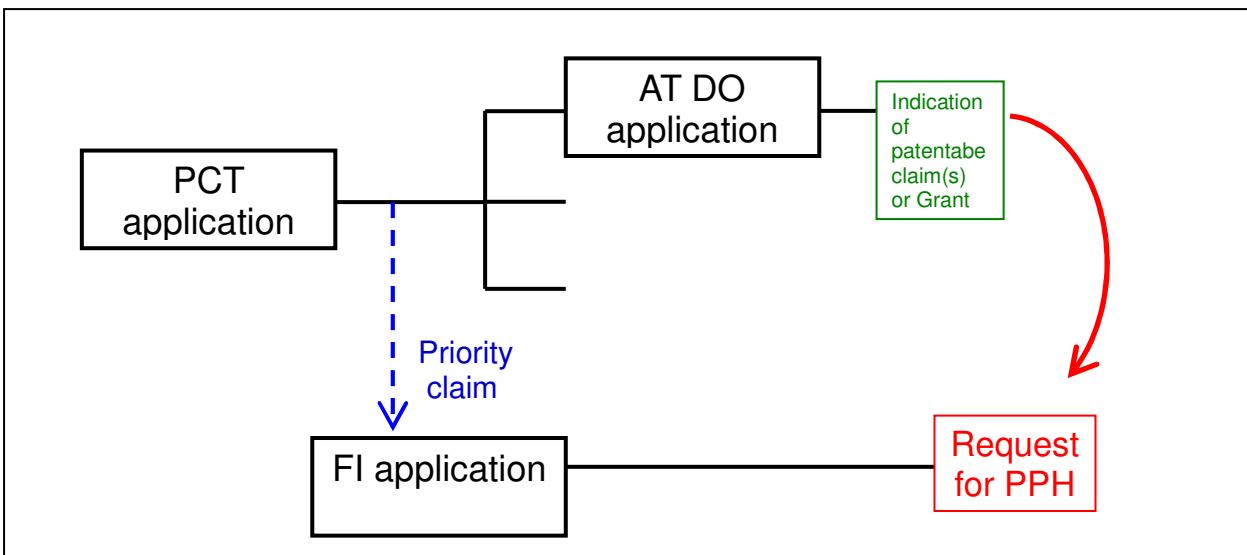
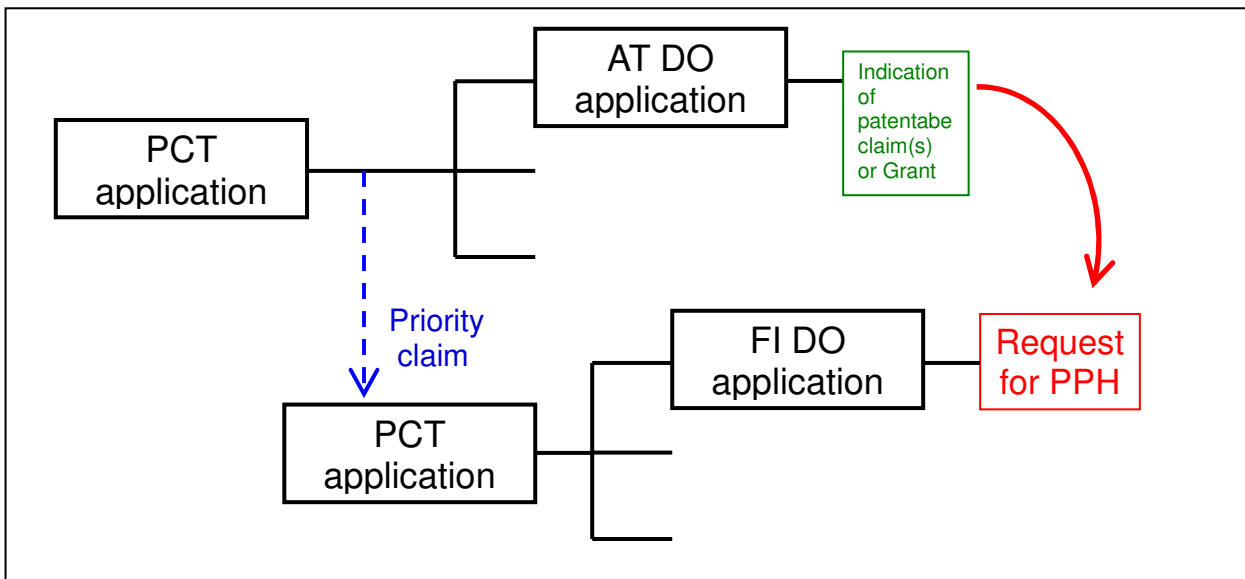
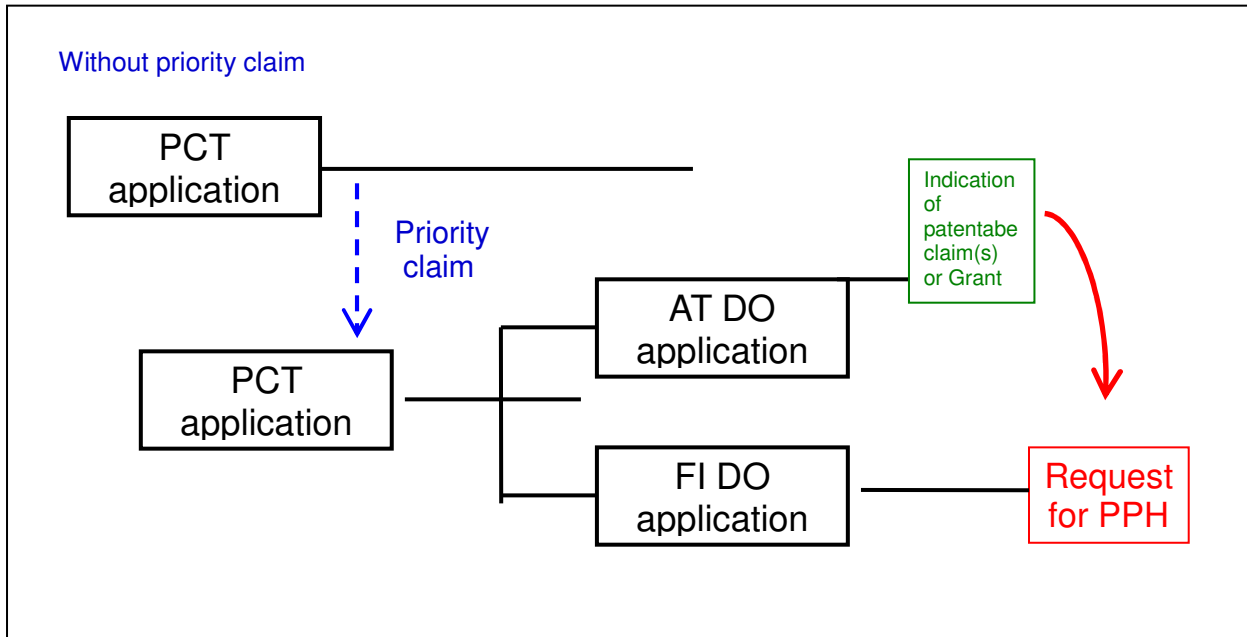


Figure I:



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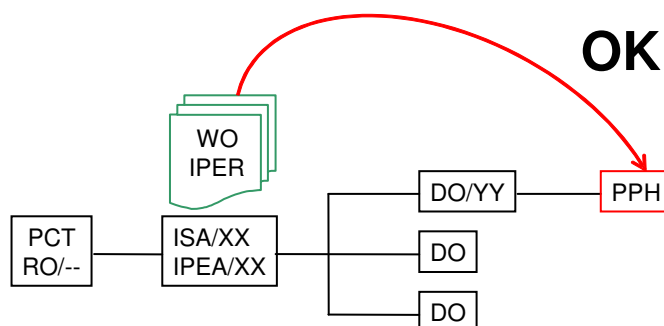
Figure J:



ANNEX 3

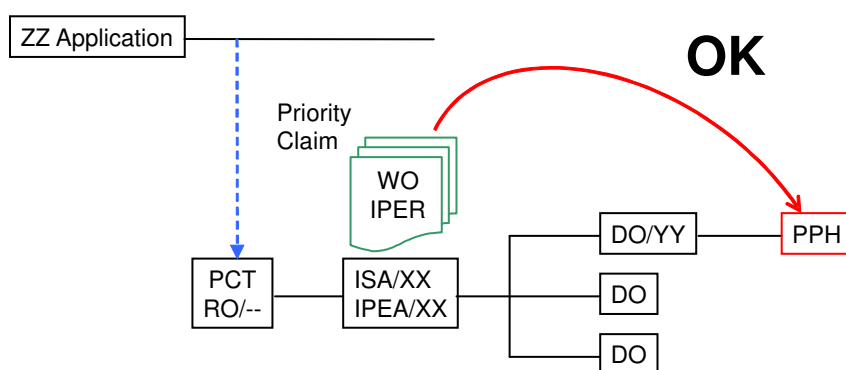
Examples of the application eligible for the PCT-PPH

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



XX=APO
YY=FI

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



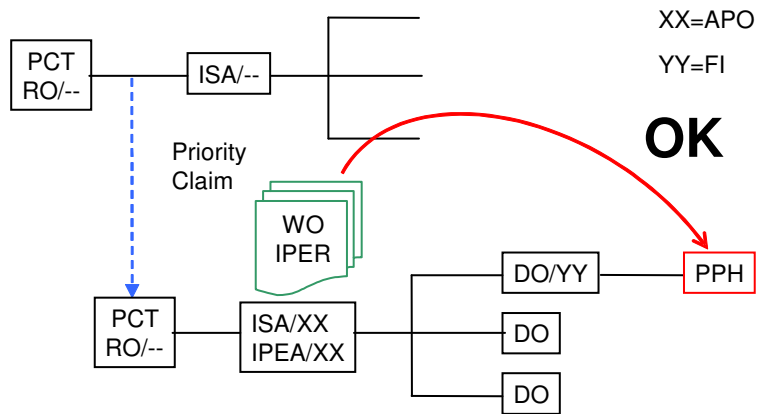
XX=APO
YY=FI

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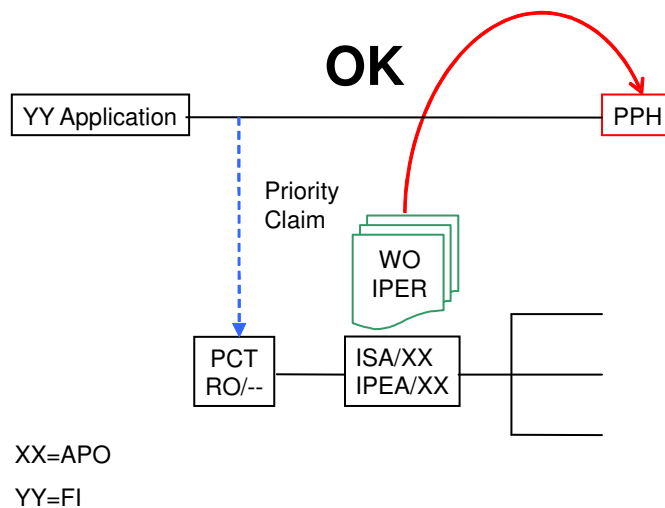
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(A'') The application is a national phase application of the corresponding international application.

(The corresponding international application claims priority from an international application.)



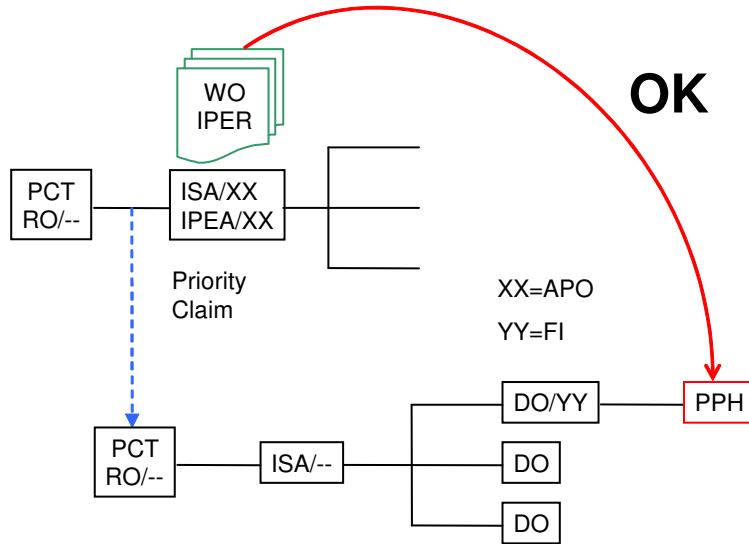
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



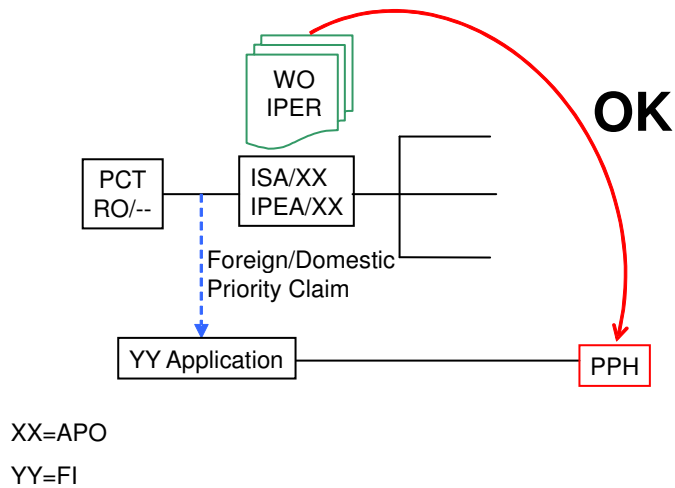
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(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



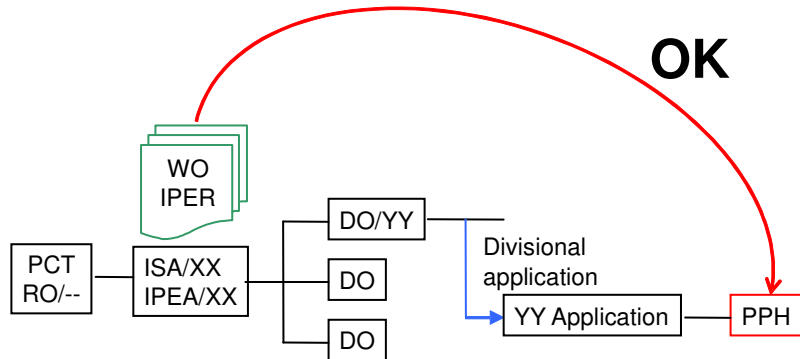
(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



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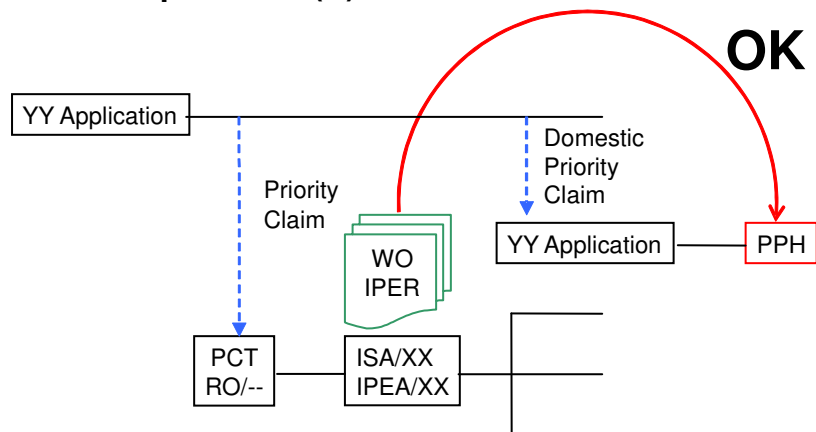
(E1) The application is a divisional application of an application which satisfies the requirement (A).



XX=APO

YY=FI

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



XX= APO

YY=FI

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ANNEX 4

PPH REQUEST

Request for Accelerated Examination at the NBPR under the Patent Prosecution Highway Pilot Program between the NBPR and the APO

1. FI application number:

Corresponding AT application number(s):

2. **Either:**

a) Copy of APO office action(s) attached:

and

Copy of translated APO office action(s) attached

or

b) APO office action(s) on file from previous PPH application:
FI application number:

3. **Either:**

a) Copy of claims of corresponding AT application attached:

and

Copy of translated claims of corresponding AT application attached:

or

c) AT application claims on file from previous PPH application:
FI application number:

4. Translation version of foreign language citation attached

(Please note that it is not necessary to provide translation of documents. However, applicant will be free to file translations to allow prompt consideration of the citations if they so desire.)

5. Claim correspondence table completed:

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ANNEX 5

EXAMPLE FORM

PCT-PPH REQUEST

Request for Accelerated Examination at the NBPR by using the PCT international work products under the Patent Prosecution Highway Pilot Program Between the NBPR and the APO (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:
 - A copy of WO-ISA or IPER and translation thereof in English or Finnish
 - or*
 - Request to obtain documents in 1. via Patentscope
2. Either:
 - A copy of all claims determined to be patentable/allowable by the ISA or IPEA
 - or*
 - Request to obtain documents in 2. 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

