

# **Procedures to file a request to the Finnish Patent and Registration Office (PRH) for the Patent Prosecution Highway Pilot Program between the National Intellectual Property Administration of The P.R. of China (CNIPA) and the Finnish Patent and Registration Office (PRH)**

The pilot period of this PPH pilot program will commence on January 1, 2013 for a duration of one year and ending on December 31, 2013. The pilot period may be extended if necessary until the CNIPA and PRH receive the sufficient number of PPH requests to adequately assess the feasibility of PPH program.

The Offices may also terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated

## **Request to the PRH**

**[0001]** An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the PRH by submitting an application requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the PRH for accelerated examination under the PPH are given in the following sections. Relevant supporting documentation is discussed in a later section (paragraphs [0003] to [0004]) as is the general PRH application procedure envisaged at this time (paragraph [0005]).

The request form is available online on the PRH website at <https://www.prh.fi/pphen> - "How to file a PPH request".

## **Part I- PPH using national work products from CNIPA**

### **Requirements for requesting accelerated examination under the PPH Pilot Program at the PRH**

**[0002]** There are four requirements for requesting accelerated examination under the PPH pilot program at the PRH. These are:

- a) Either:
- i) the PRH application validly claims priority under the Paris Convention from at least one corresponding CNIPA application(s);
  - ii) the PRH application is the national phase of a PCT application which has no priority claims, or
  - iii) the PRH application is the national phase of a PCT application which validly claims priority from a CNIPA national application, or
  - iv) the PRH application validly claims priority from a PCT application which has no priority claims, or
  - v) the PRH application is the national phase of a PCT application which validly claims priority from a PCT application which has no priority claims, or
  - vi) the PRH application is a divisional application of any of the above.

Examples are provided in Annex 1.

- b) At least one corresponding CNIPA application has one or more claims that are determined to be patentable/allowable by CNIPA examiner in the latest office action, even if the application is not granted patent yet.

CNIPA office actions include:

- (a) Decision to Grant a Patent
- (b) First/Second/Third/...Office Action,
- (c) Decision of Refusal,
- (d) Reexamination Decision, and
- (e) Invalidation Decision.

Claims are also “determined to be allowable/patentable” in the following circumstances: If the CNIPA office action does not explicitly state that a particular claim is allowable/patentable, the applicant must include explanation accompanying the request for participation in the PPH pilot program that no rejection has been made in the CNIPA office action regarding that claim, and therefore, the claim is deemed to be allowable/patentable by the CNIPA.

For example, if claims are not shown in the item of “6. the Opinion on the Conclusion of Examination (审查的结论性意见) about Claims (关于权利要求书)” in the “First Notice of the Opinion on Examination(第一次审查意见通知书)” or “5. the Opinion on the Conclusion of Examination (审查的结论性意见) about Claims (关于权利要求书)” in the “Second/Third/...Notice of the Opinion on Examination(第二次审查意见通知书)” of the CNIPA, those claims may be deemed to be implicitly identified to be allowable/patentable and then the applicant must include the above explanation.

- c) All claims on file, as originally filed or as amended, for examination at PRH under the PPH must sufficiently correspond to one or more of those claims indicated as patentable/allowable in CNIPA in order for the PRH application to qualify for accelerated examination under the PPH at the PRH.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the PRH application are of the same or similar scope as the claims in CNIPA, or the claims in the PRH application are narrower in scope than the claims in CNIPA.

In this regard, a claim that is narrower in scope occurs when a CNIPA claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). Narrower claims can be written as dependent claims

A claim in the PRH application which introduces a new/different category of claims to those claims indicated as allowable in CNIPA is not considered to sufficiently correspond. If, for example, the CNIPA claims only contain claims to a process of manufacturing a product, then the claims in the PRH application are not considered to sufficiently correspond if the claims of the PRH 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 PPH Pilot Program do not need to sufficiently correspond to the claims indicated as patentable/allowable in the CNIPA application.

- d) The PRH has not yet issued a "Communication of Acceptance." (The heading of the communication is "Hyväksyvä välipäätös.")

## **Required documents for accelerated examination under the PPH Pilot Program at the PRH**

**[0003]** The following documentation is needed to support a request for accelerated examination under the PPH pilot program at the PRH:

- a) a copy of all office actions (which are relevant to the patentability) in the corresponding CNIPA application(s), and translations of them. Office actions are documents which relate to substantive examination and which were sent to the applicant by the CNIPA examiner. The applicant can either provide the office actions together with the request for acceleration under the PPH or request that the PRH obtain the documents from the CNIPA document database.

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

- b) a copy of the claims found to be patentable/allowable by CNIPA and translations of them. The applicant can either provide the claims together with the request for acceleration under the PPH or request that the PRH obtain the claims from the CNIPA document database. Both Finnish and English are acceptable as translation languages. The indications provided in the requirement [0003] (a) above regarding machine translations also apply to this requirement [0003](b).

a complete claim correspondence table showing the relationship between the claims of the PRH application for accelerated examination under the PPH and the claims of the corresponding CNIPA application considered patentable/allowable by CNIPA.

The claims correspondence table must indicate how the claims in the PRH application correspond to the patentable/allowable claims in the CNIPA application. The claim correspondence table must be written in Finnish or English.

- c) copies of the references cited by the CNIPA examiner. If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the PRH. If the PRH does not have access to relevant patent documents, the applicant must submit these documents at the request of the PRH. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

In those rare situations where the CNIPA application has not been published, and therefore the CNIPA file wrapper is not available via the CNIPA document database, the applicant will be responsible for providing the necessary documents to the PRH.

**[0004]** The relevant information is provided by the applicant by filling out the form for requesting accelerated examination under the PPH Pilot Program (see Annex 3) which is available on the PRH web site. The relevant supporting documentation should be attached.

The applicant need not provide further copies of documentation if they have already been submitted to the PRH through simultaneous or past procedures.

## **Procedure for accelerated examination under the PPH Pilot Program at the PRH**

**[0005]** The applicant fills out the form requesting accelerated examination under the PPH Pilot Program available on the PRH web page <https://www.prh.fi/pphen> - "How to file a PPH request" and includes all the relevant supporting documents. The PPH Administrator, who will be an PRH patent examiner, will consider the request. If the requirements for accelerated examination under the PPH are not met, the PPH Administrator will notify the

applicant that the application has not been allowed entry to the PPH and will provide an explanation as to why entry to the PPH was denied. The applicant is free to take any possible correcting action necessary and again request acceleration under the PPH until the PRH issues a "Communication of Acceptance".

If all requirements for accelerated examination under the PPH are met, the PPH Administrator will notify the applicant that the application has been allowed entry to the PPH. The PPH Administrator will notify the relevant examining group that the application has qualified for entry to the PPH and the relevant examiner will then conduct an accelerated examination of the application.

If the request for accelerated examination is not granted, the applicant will be notified that the application will await action in its regular turn.

## **Part II- PPH using the PCT international work products from the CNIPA**

### **Request to the PRH**

**[0001]** An applicant can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the PRH and satisfies the following requirements under the PRH- CNIPA Patent Prosecution Highway Pilot Program based on PCT international work products (PCT-PPH Pilot Program).

The Offices may terminate the PCT-PPH Pilot Program early if the volume of participation exceeds manageable levels, or for any other reason. Notice will be published if the PCT-PPH Pilot Program is terminated.

### **Requirements for requesting accelerated examination under the PCT-PPH Pilot Program at the PRH**

**[0002]** The application which is filed with the PRH and to which the applicant files a request under the PCT-PPH must satisfy the following requirements:

- a) The latest work product in the international phase of a PCT application corresponding to the application ('international work product'), namely the Written Opinion of International Searching Authority (WO/ISA), the Written Opinion of International Examining Authority (WO/IPEA), or the Preliminary Examination Report (IPER), indicates that at least one claim is patentable/allowable.

Note that the ISA and the IPEA which produce the WO/ISA, WO/IPEA, and the IPER are limited to CNIPA, but if priority is claimed, the priority claim can be referred to an application in any Office (see example A' in Annex II: Application ZZ can be any national application).

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, irrespective of the fact that an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in the 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 will not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation in Box VIII.

- b) the relationship between the application and the corresponding international application satisfies one of the following requirements:
  - i) the application is a national phase application of the corresponding international application (see figures A, A' and A'' in Annex 2)
  - ii) the application is a national application as a basis of the priority claim of the corresponding international application (see figure B in Annex 2)
  - iii) the application is a national phase application of an international application claiming priority from the corresponding international application (see figure C in Annex 2).
  - iv) The application is a national application claiming priority from the corresponding international application (See figure D in Annex 2)
  - v) The application is the derivate application (divisional application etc.) of the application which satisfies one of the above requirements (i)-(iv). (See figures E1 and E2 in Annex 2.)
- c) all claims, 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 of the application are of the same or similar scope as the claims indicated to be patentable/allowable in the latest international work product, or the claims of the application are narrower in scope than the claims indicated to be patentable/allowable in the latest international work product.

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

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

- d) The PRH has not yet issued a “Communication of Acceptance.”  
(The heading of the communication is “Hyväksyvä välipäätös.”)

## **Required documents for accelerated examination under the PCT-PPH Pilot Program at the PRH**

**[0003]** The following documentation will be needed to support a request for accelerated examination under the PCT-PPH Pilot Program at the PRH:

- a) a copy of the latest international work product which indicated the claims to be patentable/allowable and their Finnish or English translations if they are not in English.

In case the application satisfies the relationship [0002](b)(i), the applicant does not need to submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via ‘PATENTSCOPE®’, then the applicant does not need to submit these documents, unless otherwise requested by the PRH.

(WO/ISA and IPER are usually available as ‘IPRP Chapter I’ and ‘IPRP Chapter II’ respectively in 30 months after the priority date).

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

- b) a copy of the set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their Finnish or English translations if they are not in English. The indications provided in the requirement [0003](a) above regarding machine translations also apply to this requirement [0003](b).

If the copy of the set of claims which are indicated to be patentable/allowable is available via ‘PATENTSCOPE®’ <http://www.wipo.int/pctdb/en/search-adv.jsp>, e.g. the international Patent Gazette has been published, the applicant need not submit this document unless otherwise requested by the PRH.

- c) a copy of the references cited in the latest international work product of the international application corresponding to the application.



If the reference is a patent document, the applicant is not required to submit it. In case the PRH has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

- d) a complete claim correspondence table showing the relationship between the claims of the PRH application for accelerated examination under the PCT-PPH and the claims indicated to be patentable/allowable.

If the claims simply are literal translations, then it is sufficient that the applicant writes 'They are the same' in the table. If the claims are not literal translations, then it is necessary to explain the sufficient correspondence of each claim based on the criterion [0002](c). The claim correspondence table must be written in Finnish or English.

**[0004]** If the applicant has already submitted the above-mentioned documents (a)-(d) to the PRH through simultaneous or past procedures, then the applicant may incorporate the documents by reference and is thus not required to attach the documents.

## **Procedure for accelerated examination under the PCT-PPH Pilot Program at the PRH**

**[0005]** The applicant fills out the form requesting accelerated examination under the PCT-PPH Pilot Program (see Annex 4) available on the PRH web page <https://www.prh.fi/pphen> - "How to file a PPH request" and includes all the relevant supporting documents. The PCT-PPH Administrator, who is a PRH patent examiner, will consider the request. If all requirements for accelerated examination under the PCT-PPH have not been met, then the PCT-PPH Administrator will notify the applicant that the application has not been allowed entry to the PCT-PPH and will provide an explanation as to why entry to the PCT-PPH was denied. The applicant is free to take any possible correcting action necessary and again request acceleration under the PCT-PPH until the PRH issues a "Communication of Acceptance".

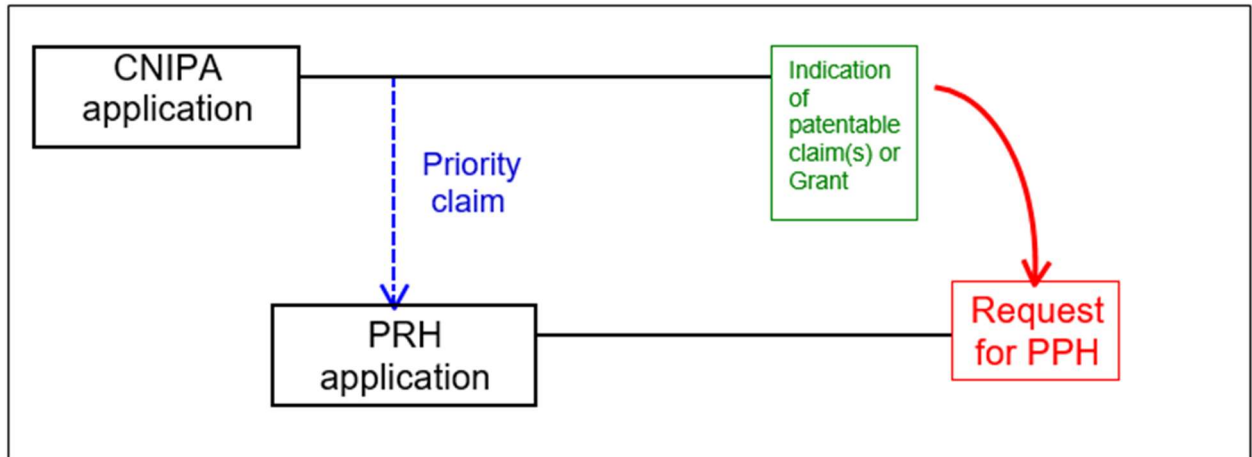
If all requirements for accelerated examination under the PCT-PPH have been met, then the PCT-PPH Administrator will notify the applicant that the application has been allowed entry to the PCT-PPH. The PCT-PPH Administrator will notify the relevant examining group that the application has qualified for entry to the PCT-PPH and the relevant examiner will then conduct an accelerated examination of the application.

If the request for accelerated examination is not granted, the applicant will be notified that the application will await action in its regular turn.

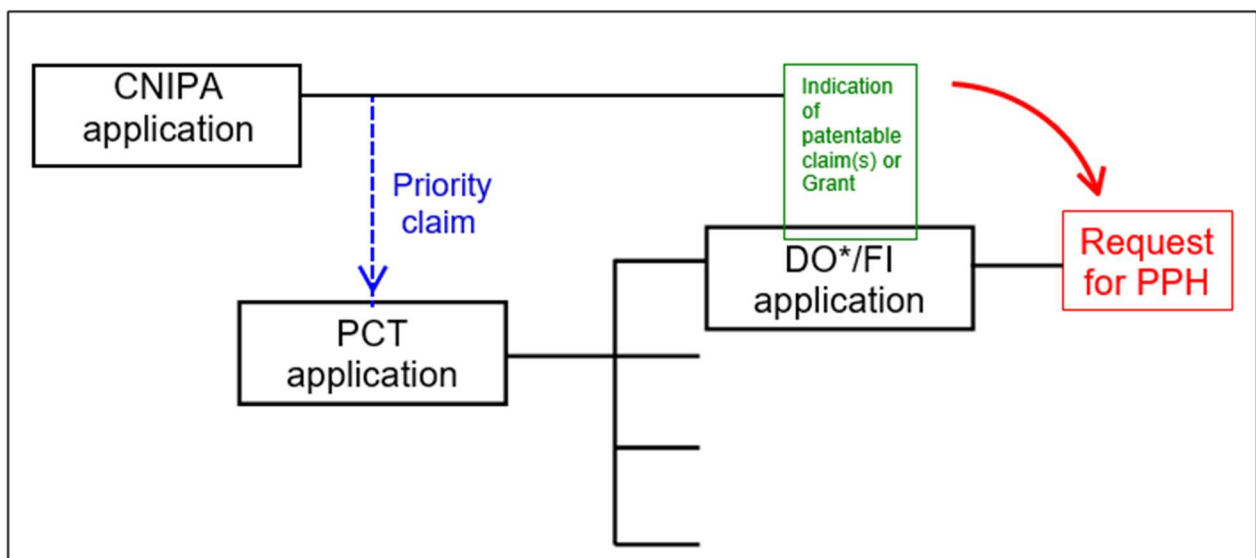
## **Annex 1**

## Examples of PRH applications eligible for PPH

**Figure A:**

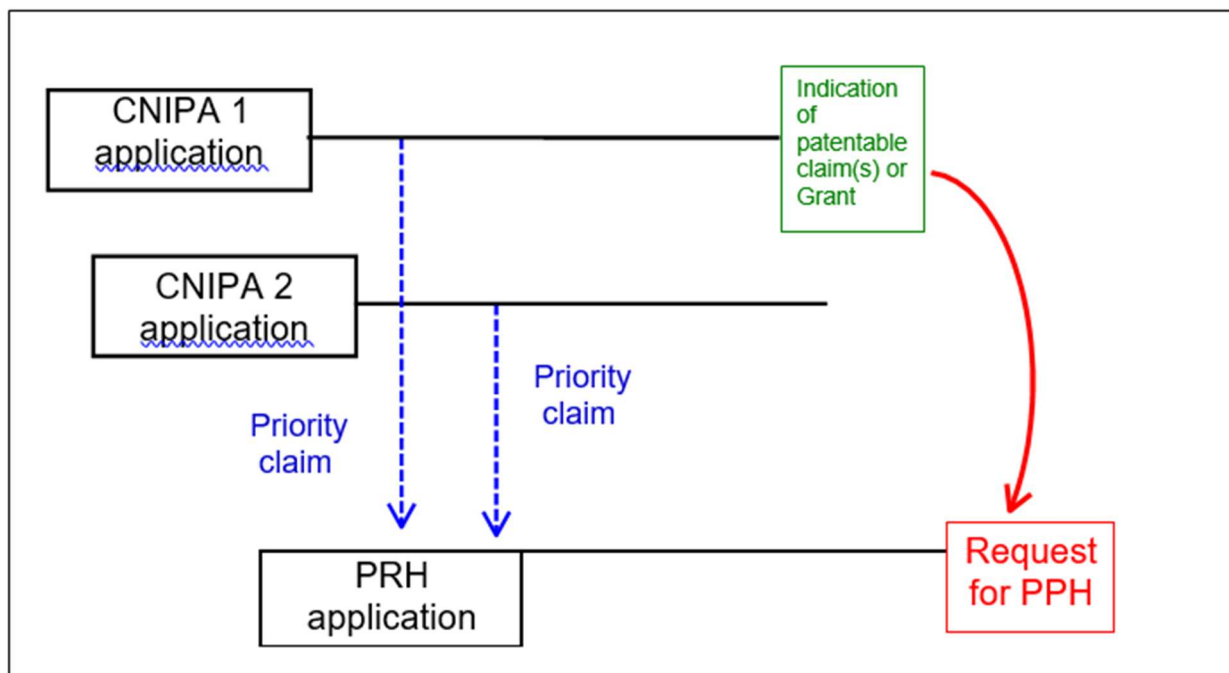


**Figure B:**

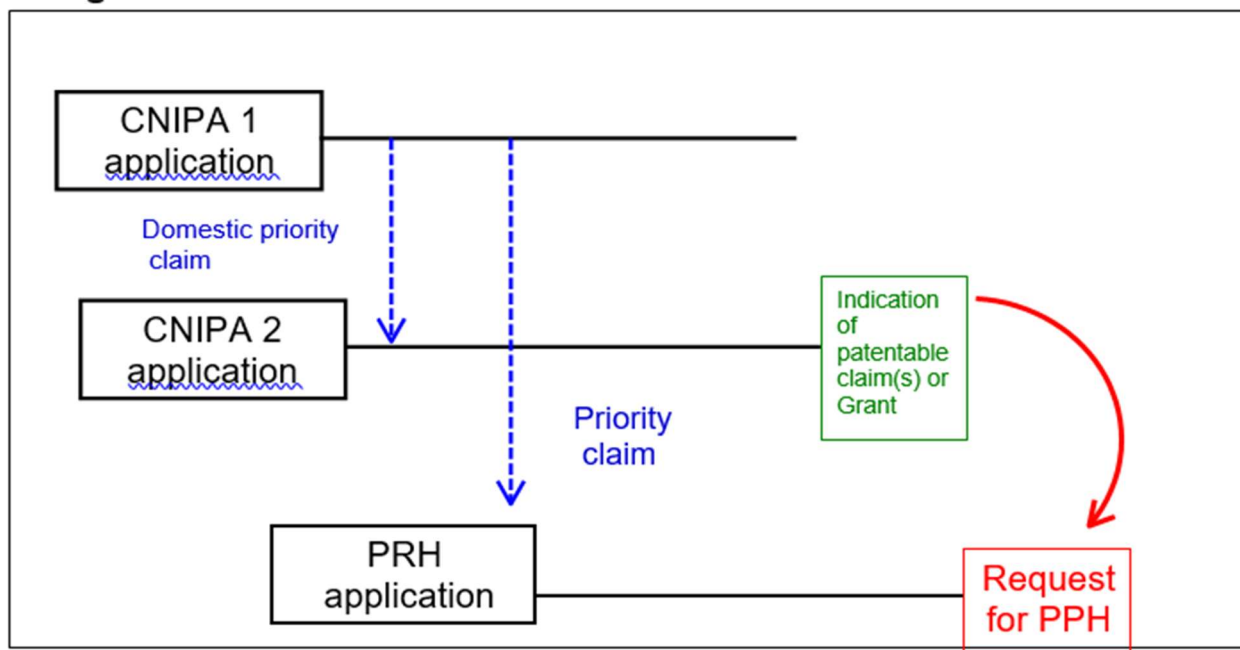


\* DO – Designated Office

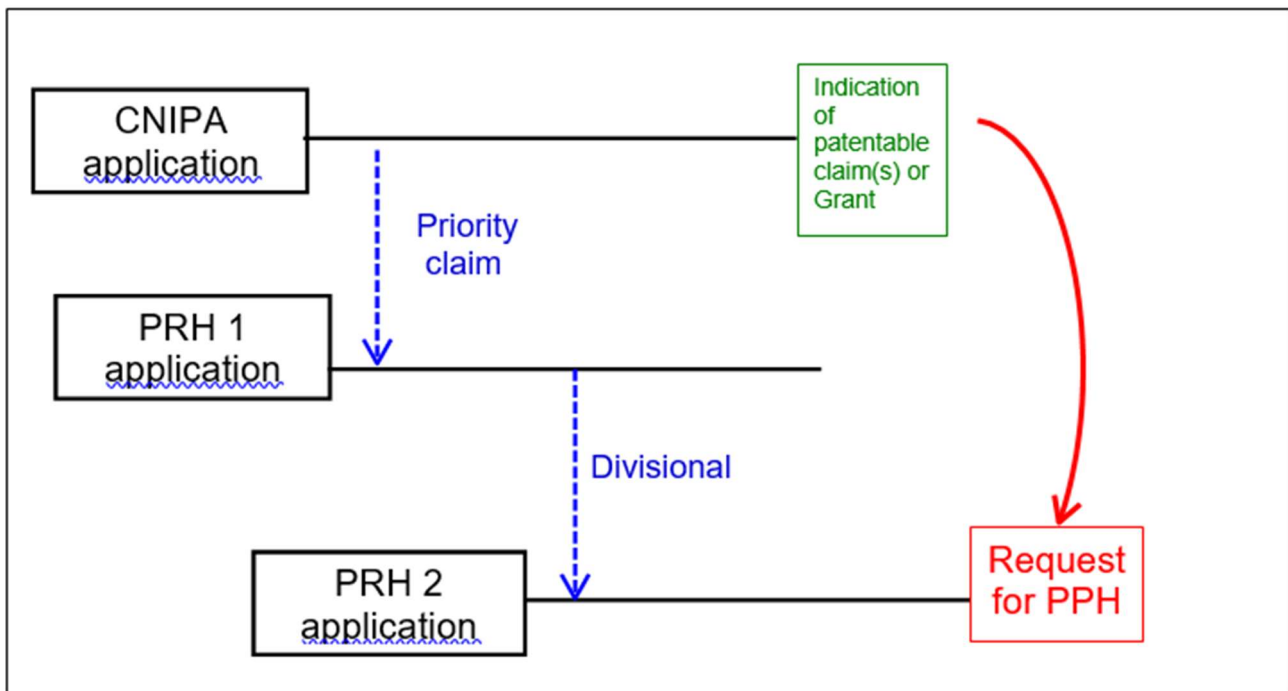
**Figure C:**



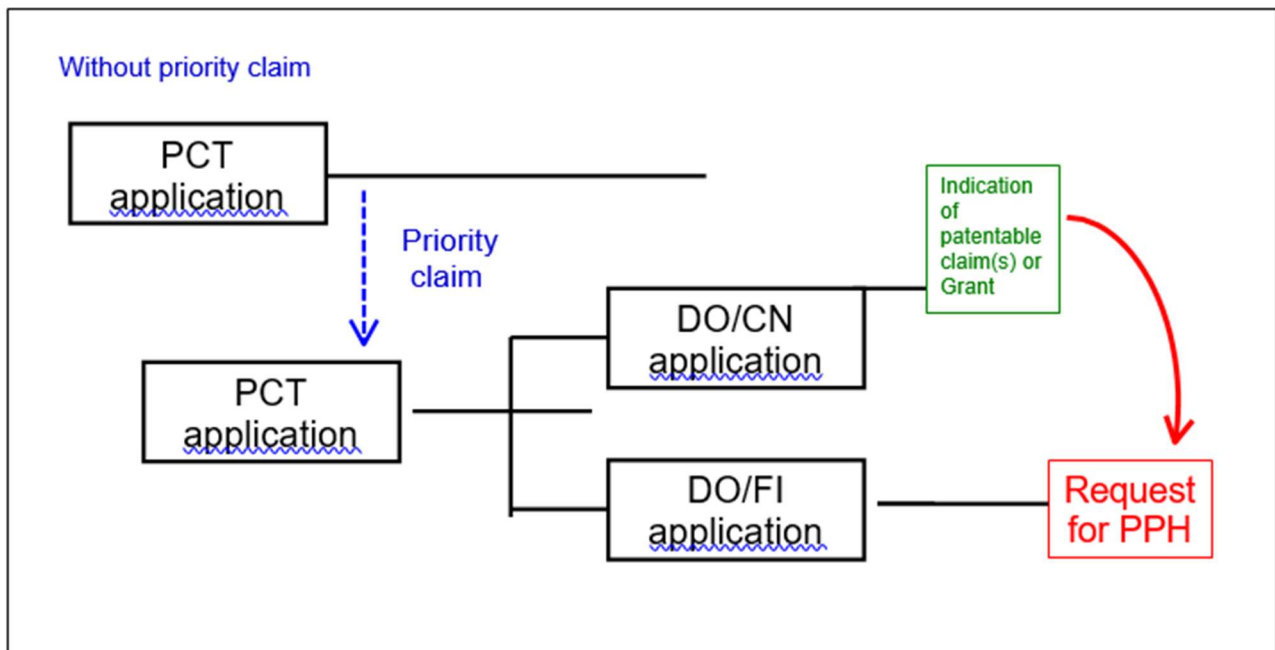
**Figure D:**



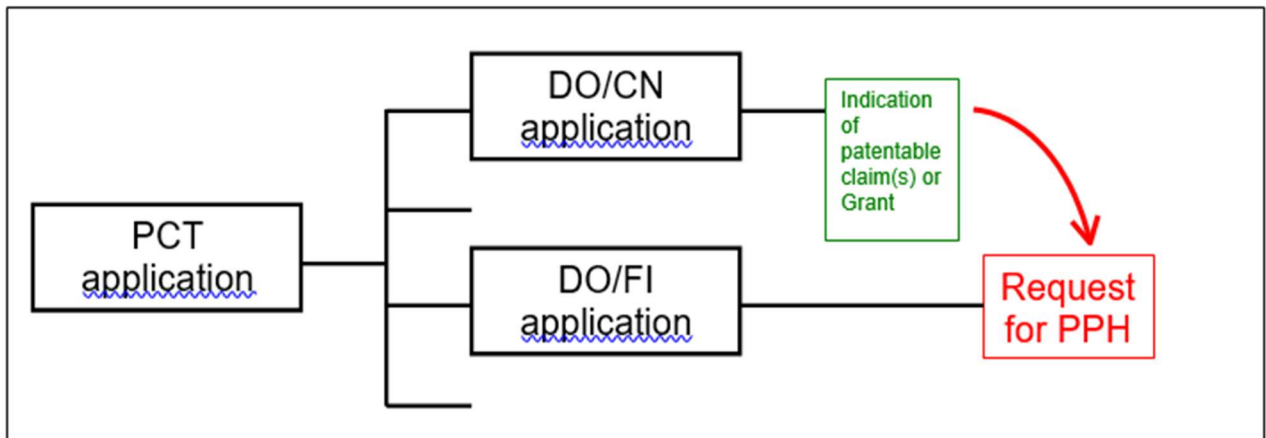
**Figure E:**



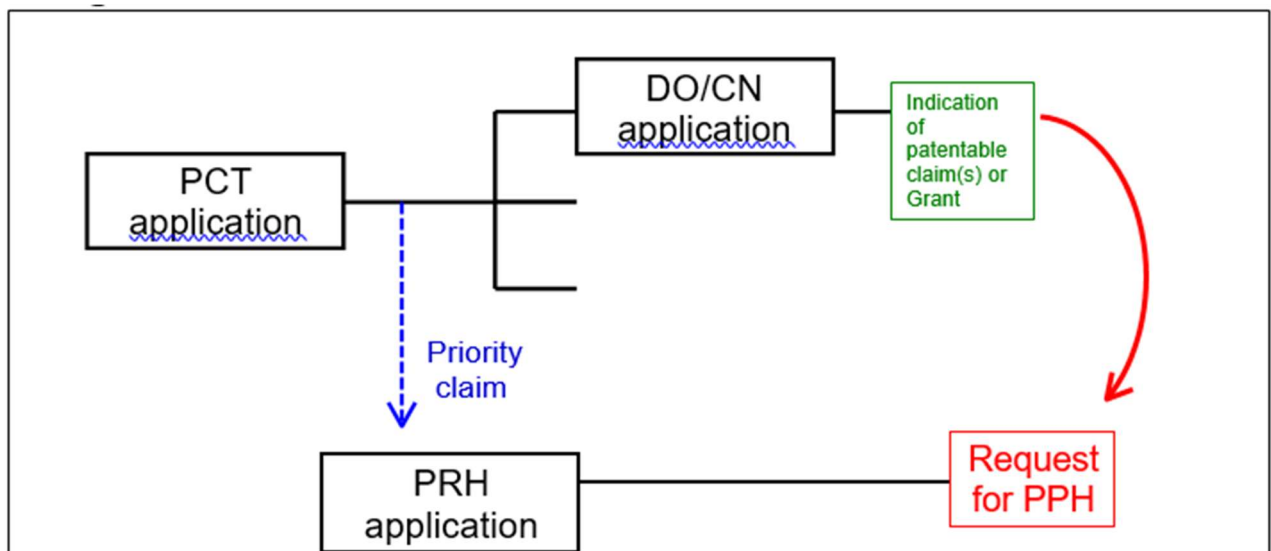
**Figure F:**



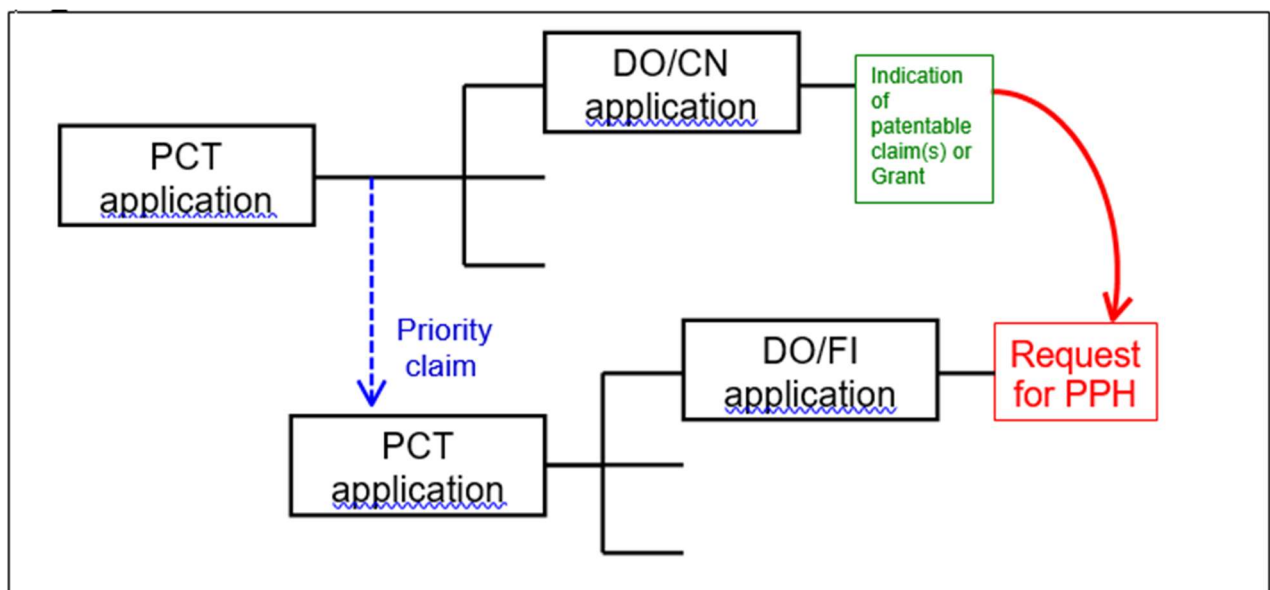
**Figure G:**



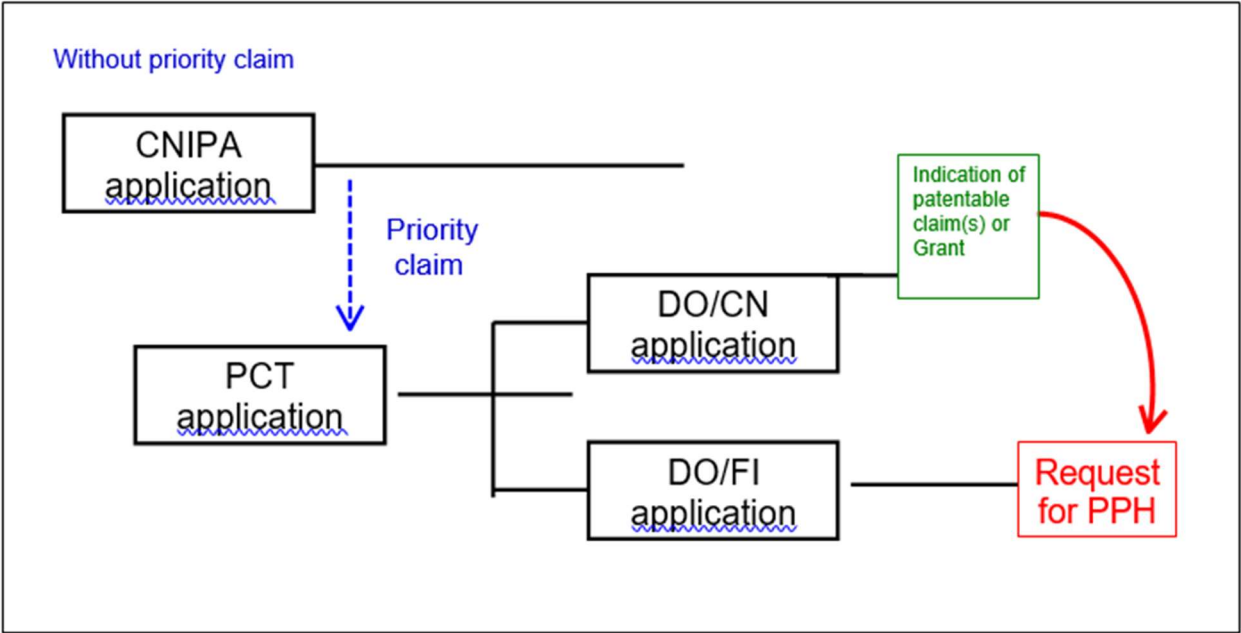
**Figure H:**



**Figure I:**



**Figure J:**

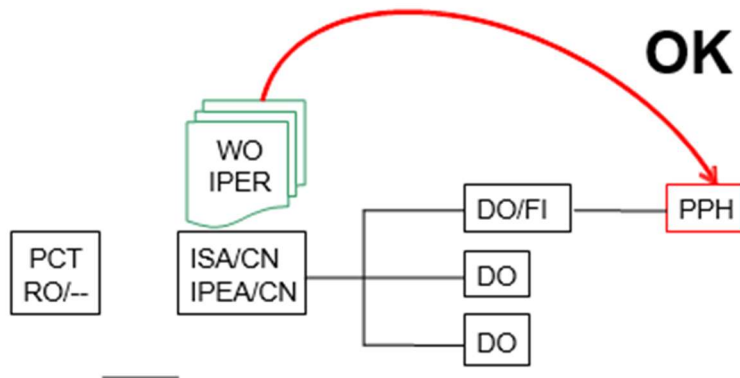


## **Annex 2**

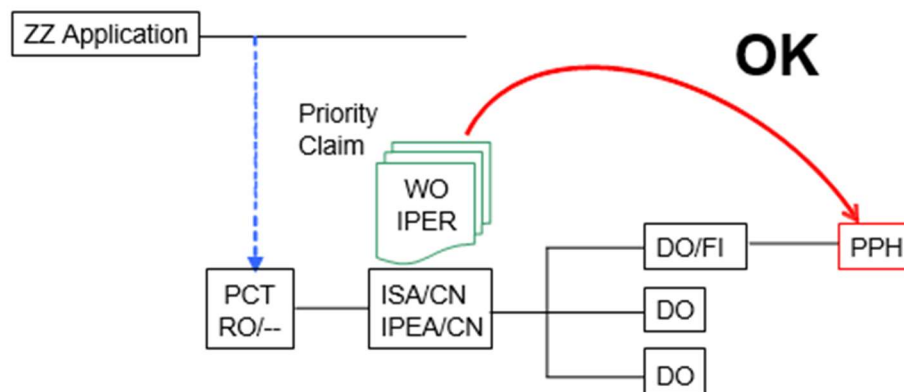


## Examples of the applications eligible for PCT-PPH

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

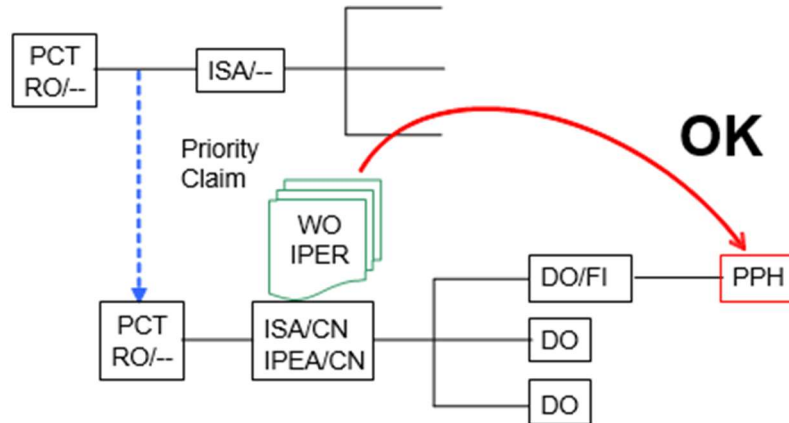


**(A') The application is a national phase application of the corresponding international application.  
(The corresponding international application claims priority from a national application.)**

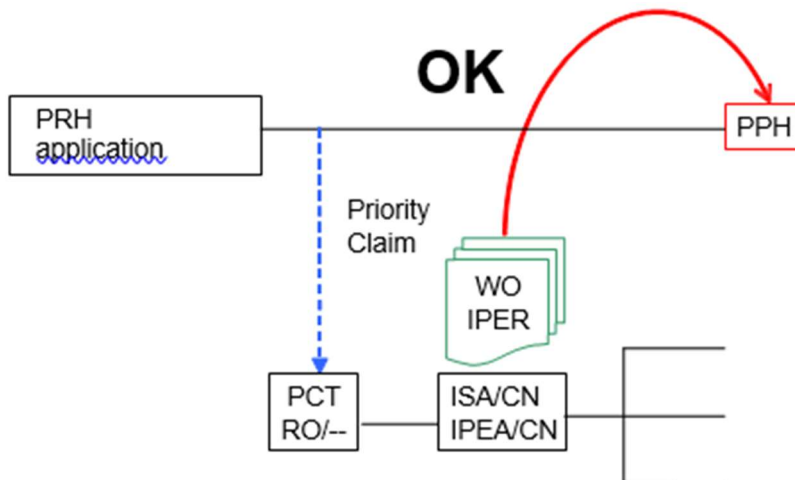


ZZ=any office

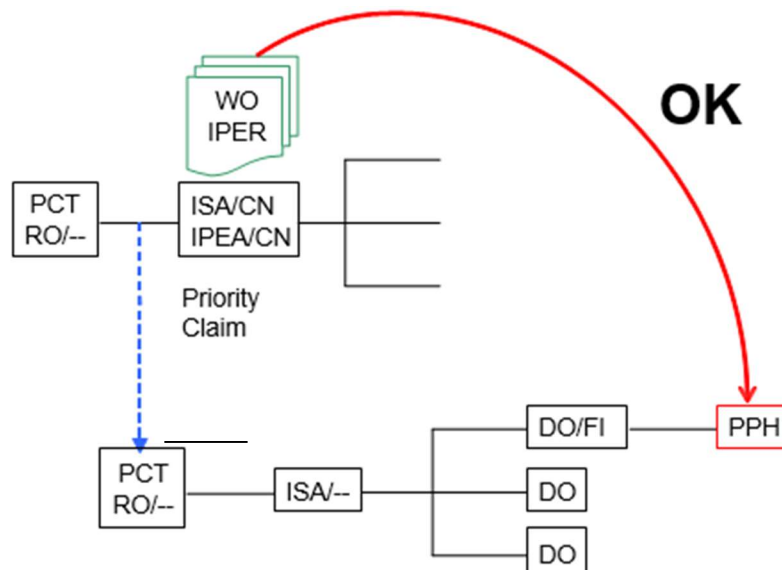
- (A'') The application is a national phase application of the corresponding international application.**  
**(The corresponding international application claims priority from an international application.)**



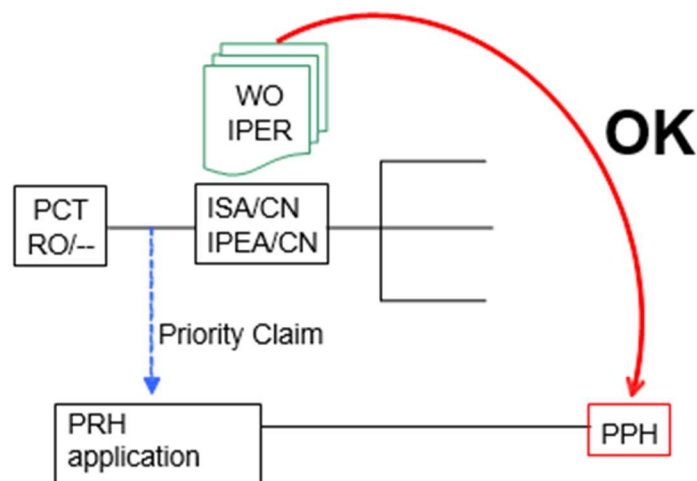
- (B) The application is a national application as a basis of the priority claim of the corresponding international application.**



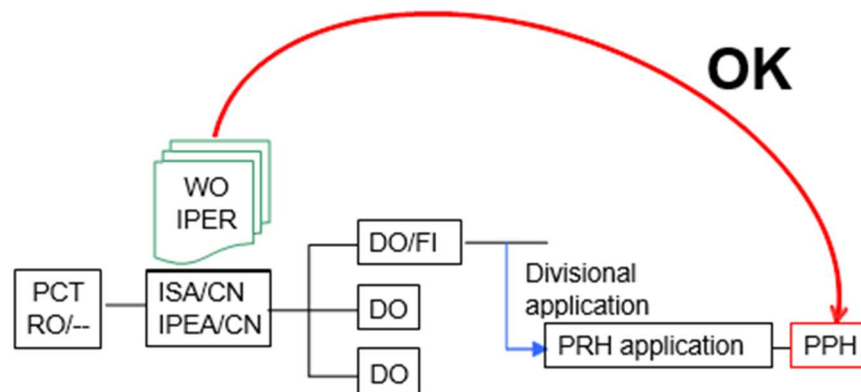
**(C) The application is a national phase application of an international application claiming priority from the corresponding international application.**



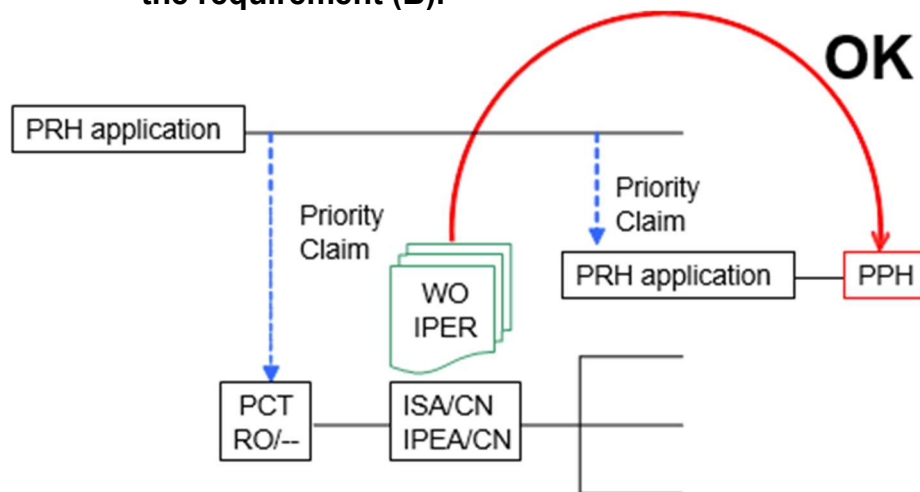
**(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.**



**(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 3**

## Example Form PPH REQUEST

### Request for Accelerated Examination at the PRH under the Patent Prosecution Highway Pilot Program between the PRH and the CNIPA

- 1 PRH application number:  
Corresponding CNIPA application number(s):

**2 Either:**

- a) Copy of CNIPA office action(s) in English attached: or ☐  
Copy of original Chinese CNIPA office action(s) translated into either English or Finnish attached ☐  
or  
b) CNIPA office action(s) available via the CNIPA document database: or ☐  
c) CNIPA office action(s) on file from previous PPH application: PRH application number: ☐

**3 Either:**

- a) Copy of claims of corresponding CNIPA application attached or ☐  
Copy of the Chinese claims of the corresponding CNIPA application translated into either English or Finnish attached ☐  
or  
b) Claims of corresponding CNIPA application available via CNIPA document database ☐  
or  
c) CNIPA application claims on file from previous PPH application PRH 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:** ☐

**Claim correspondence table:**

*Table 1*

PRH application claims	Patentable claims in CNIPA applications	Explanation regarding the correspondence

## **Annex 4**



## Example form PPH-PCT REQUEST

### **Request for Accelerated Examination at the PRH using the PCT international work products under the Patent Prosecution Highway Pilot Program Between the PRH and the CNIPA (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 Finnish.
  
- ☐ 4. Copies of all documents cited in the WO-ISA or IPER (except for patent documents)
  
- ☐ 5. Claims correspondence table

Table 2

PRH application claim	Corresponding PCT claim	Comments