

Procedures to file a request to the Finnish Patent and Registration Office (PRH) for the Patent Prosecution Highway Program between the Industrial Property Office of the Czech Republic (IPO-CZ) and the Finnish Patent and Registration Office (PRH)

PPH using national work products from IPO-CZ

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 [0005]) as is the general PRH application procedure envisaged at this time (paragraph [0006]).

Requirements for requesting accelerated examination under the PPH Program at the PRH

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

- a) Either:
 - i) the PRH application validly claims priority under the Paris Convention from at least one corresponding IPO-CZ 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 IPO-CZ national application, or

- iv) the PRH application 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 IPO-CZ application has one or more claims that are determined to be patentable/allowable by IPO-CZ.
- 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 IPO-CZ 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 IPO-CZ, or the claims in the PRH application are narrower in scope than the claims in IPO-CZ.

In this regard, a claim that is narrower in scope occurs when an IPO-CZ 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 IPO-CZ is not considered to sufficiently correspond. If, for example, the IPO-CZ 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 Program do not need to sufficiently correspond to the claims indicated as patentable/allowable in the IPO-CZ application.

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

Required documents for accelerated examination under the PPH Program at the PRH

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

- a) a copy of all office actions (which are relevant to the patentability) in the corresponding IPO-CZ application(s), and translations of them. Office actions are documents which relate to substantive examination and which were sent to the applicant by the IPO-CZ examiner. The applicant should provide the office actions together with the request for acceleration under the PPH. 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 IPO-CZ and translations of them. The applicant should provide the claims together with the request for acceleration under the PPH. 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).
- c) 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 IPO-CZ application considered patentable/allowable by IPO-CZ. Sufficient correspondence of claims occurs where claims are of the same or similar scope. The claims correspondence table must indicate how the claims in the PRH application correspond to the patentable/allowable claims in the IPO-CZ application. The claim correspondence table must be written in Finnish or English.
- d) copies of the references cited by the IPO-CZ 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.

[0004] The relevant information is provided by the applicant by filling out the form for requesting accelerated examination under the PPH Program (see Annex 2) which is available on the PRH web site. The relevant supporting documentation should be attached.

[0005] 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 Program at the PRH

[0006] The applicant fills out the form requesting accelerated examination under the PPH Program available on the PRH web page and includes all the relevant supporting documents. The PPH Administrator, who will be a 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.

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.

Annex 1

Examples of PRH applications eligible for PPH

Figure A:

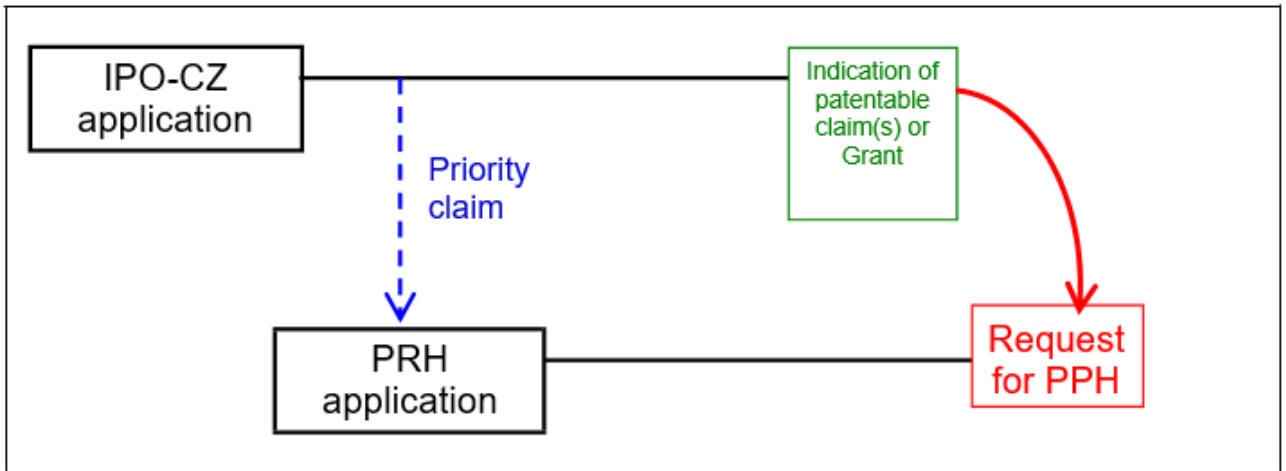
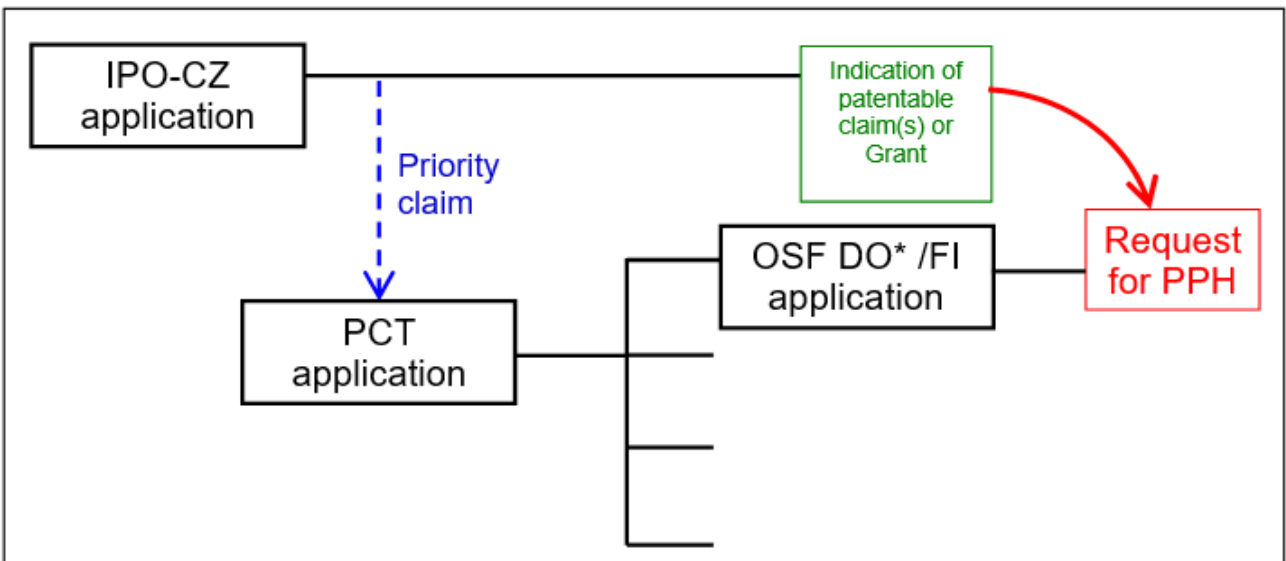


Figure B:



* DO – Designated Office

Figure C:

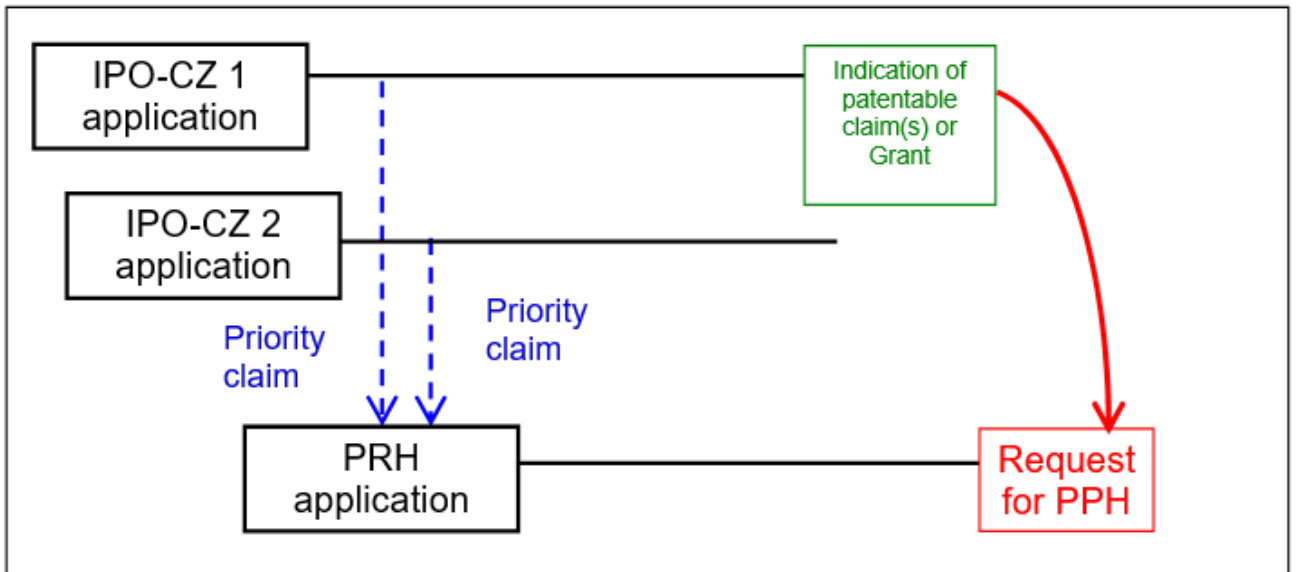


Figure D:

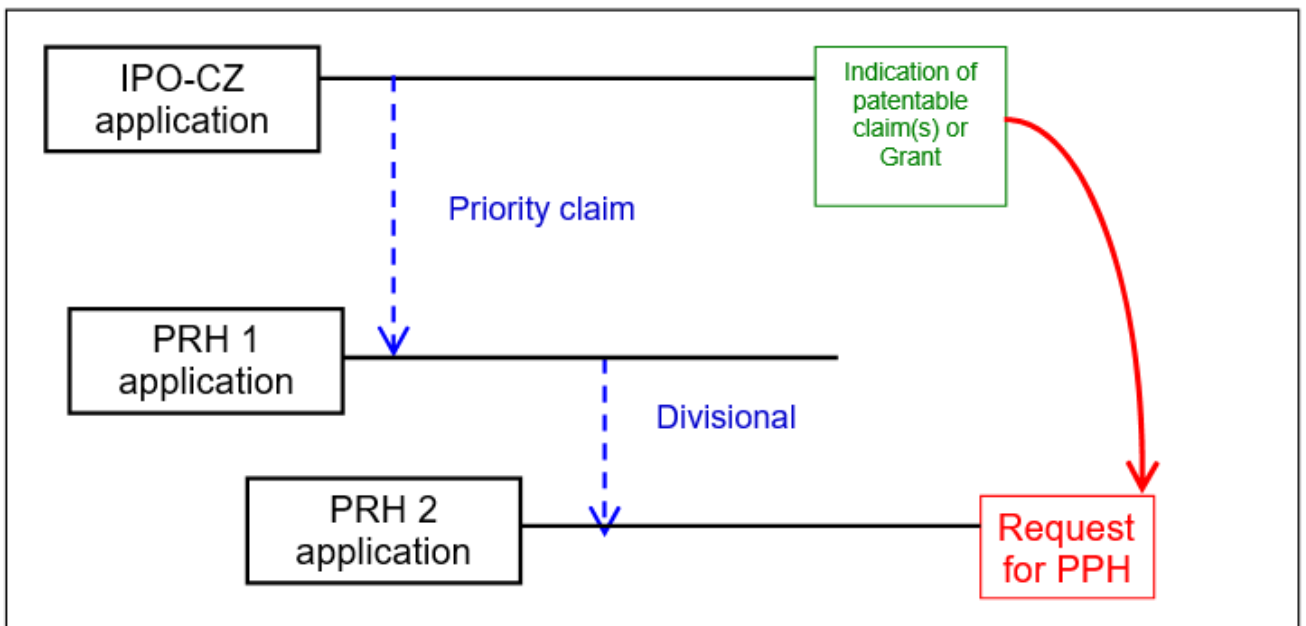


Figure E:

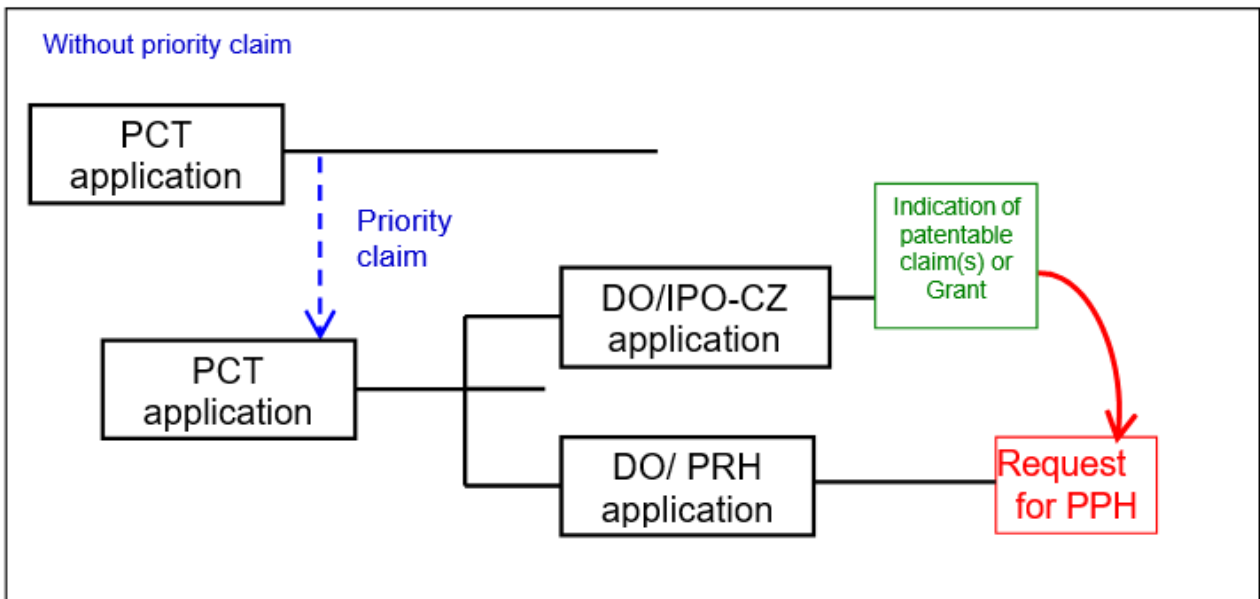


Figure F:

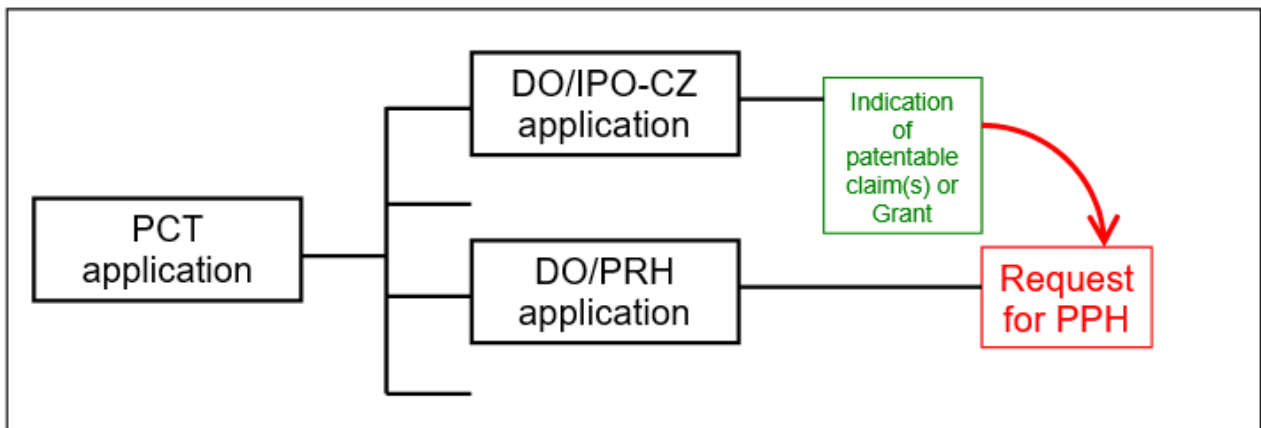


Figure G:

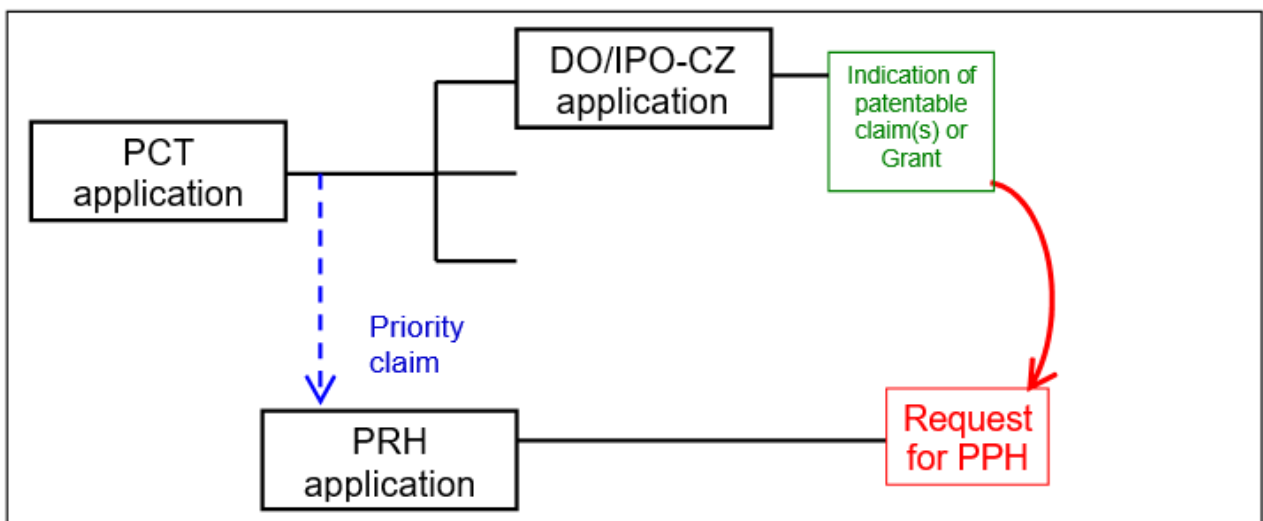


Figure H:

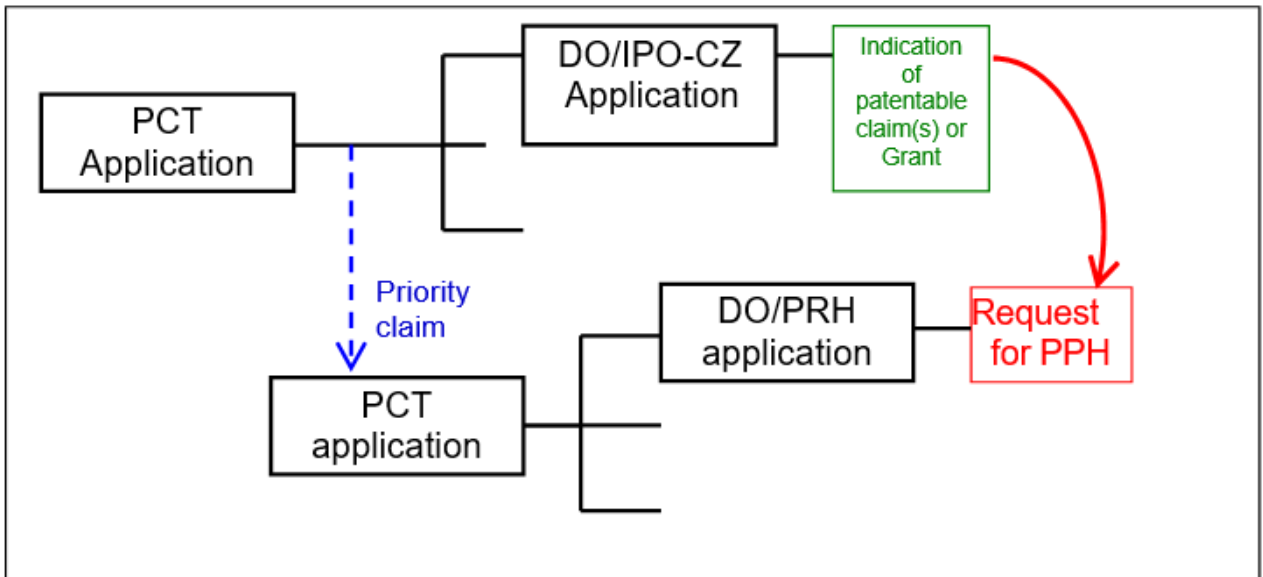
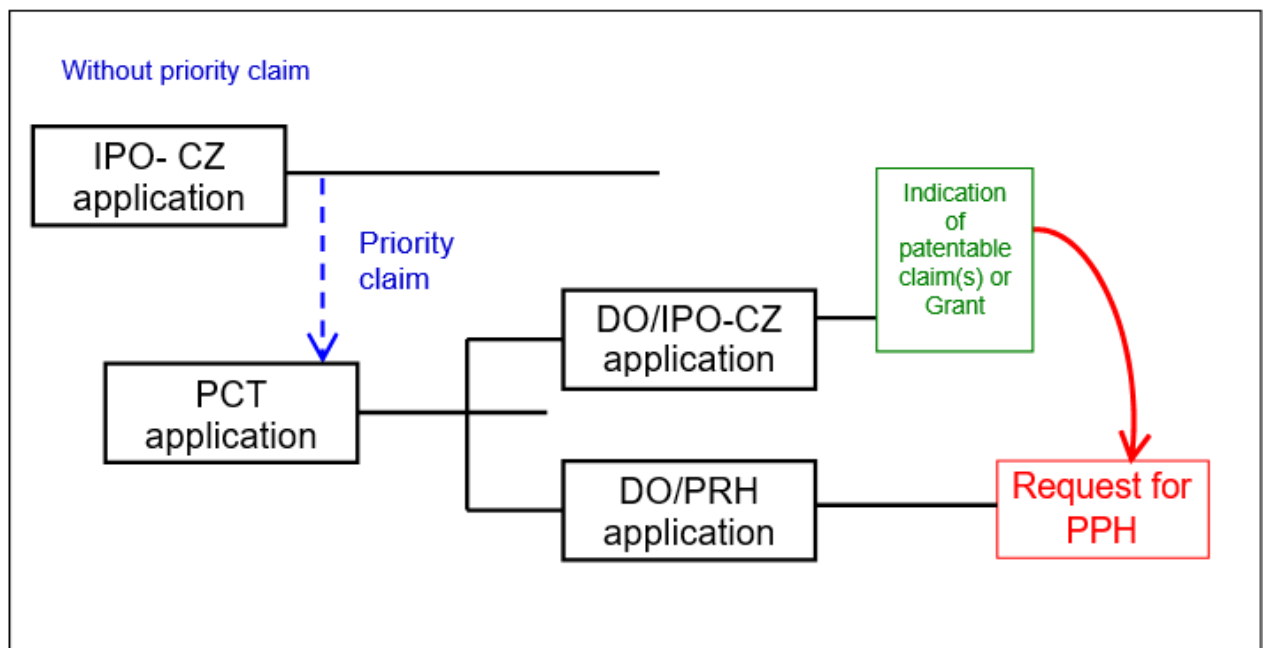




Figure I:



Annex 2

Example form

 FINNISH PATENT AND REGISTRATION OFFICE			
REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PROGRAM			
Application Number			
Applicant requests participation in the Patent Prosecution Highway program based on:			
Office of Earlier Examination (OEE)			
OEE Work Products Type		<input type="checkbox"/> National/Regional Office Action(s)	
		<input type="checkbox"/> WO-ISA, WO-IPEA or IPER	
OEE Application Number			
Required Documents			
I. OEE work products and translations thereof			
<input type="checkbox"/> 1. A copy of OEE work products			
<input type="checkbox"/> Applicant requests Office to obtain documents via PATENTSCOPE			
<input type="checkbox"/> 2. Translations of documents in item 1 in a language accepted by the Office			
<input type="checkbox"/> Applicant requests Office to obtain documents via PATENTSCOPE			
II. Patentable/allowable claims determined by OEE and translations thereof			
<input type="checkbox"/> 3. A copy of all claims determined to be patentable/allowable by OEE			
<input type="checkbox"/> Applicant requests Office to obtain documents via PATENTSCOPE			
<input type="checkbox"/> 4. Translations of documents in item 3 in a language accepted by the Office			
<input type="checkbox"/> Applicant requests Office to obtain documents via PATENTSCOPE			
III. Documents cited in OEE work products			
<input type="checkbox"/> 5. Copies of all documents cited in OEE work products (except for patent documents)			
IV. Previously submitted documents			
<input type="checkbox"/> 6. If any of the above mentioned documents have been submitted before, please specify:			

Claims Correspondence		
Application Claims	Corresponding OEE claims	Explanation regarding the correspondence
<input type="checkbox"/> All the claims in the application sufficiently correspond to the patentable/allowable claims in the OEE application.		
Additional voluntarily submitted documents (e.g. translations of documents in item 5)		
Name(s) of applicant(s) or representative(s)		
Date		