

# Procedures to file a request to the Finnish Patent and Registration Office for the Patent Prosecution Highway Pilot Program between the *Industrial Property Office of Uruguay (DNPI)* and the *Finnish Patent and Registration Office (PRH)*

The Patent Prosecution Highway Pilot Programme (PPH Pilot Program) between DNPI and PRH will commence on 1.10.2022 with duration of three years and end on 30.9.2025. The pilot period may be extended upon mutual consent between DNPI and PRH.

The Offices may terminate the PPH pilot program if the volume of participation exceeds manageable level. Ex Ante notice will be published if the PPH pilot program is terminated.

## Part I- PPH using national/regional work products

**[0001]** An applicant can 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".

## 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 based on the national work products of the DNPI (later the office of earlier examination, OEE). These are:

- a) **Both the PRH application on which the PPH is requested and the Office of Earlier Examination (OEE) application(s) forming the basis of the**

**PPH request shall have the same earliest date (whether this be a priority date or a filing date).**

For example, the PRH application (including PCT national phase application) may be either:

- i) an application which validly claims priority under the Paris Convention from the OEE application(s) (examples are provided in ANNEX 1, Figure A, B, C and D), or
- ii) an application which provides the basis of a valid priority claim under the Paris Convention for the OEE application (including PCT national phase application) (examples are provided in ANNEX 1, Figure E and F), or
- iii) an application which shares a common priority document with the OEE application(s) (including PCT national phase application(s)) (examples are provided in ANNEX 1, Figure G, H and I)

- b) At least one corresponding application exists in the OEE and has one or more claims that are determined to be patentable/allowable by the OEE.**

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 program. This is the case even though the application, which includes those claims, is not granted for patent yet.

- c) All claims in the PRH application (for which an accelerated examination under the PPH program is requested) must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the OEE application.**

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

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

A claim in the PRH which introduces a new/different category of claims to those claims indicated as allowable in the OEE is not considered to sufficiently correspond. For example, if the OEE claims only contain claims to a process of manufacturing a product, then the claims in the PRH are not considered to sufficiently correspond if the PRH claims 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 OEE application.

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

## 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 office actions (which are relevant to the patentability) in the corresponding OEE application(s), and translations of them. Office actions are documents which relate to substantive examination and which were sent to the applicant by the OEE 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 OEE's 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 OEE 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 OEE's 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).
- 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 OEE application considered patentable/allowable by OEE. 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 in [0002](c). The claim correspondence table must be written in Finnish or English.
- d) Copies of the references cited by the OEE 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 which is available on the PRH PPH-webpage. 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

**[0005]** 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 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".

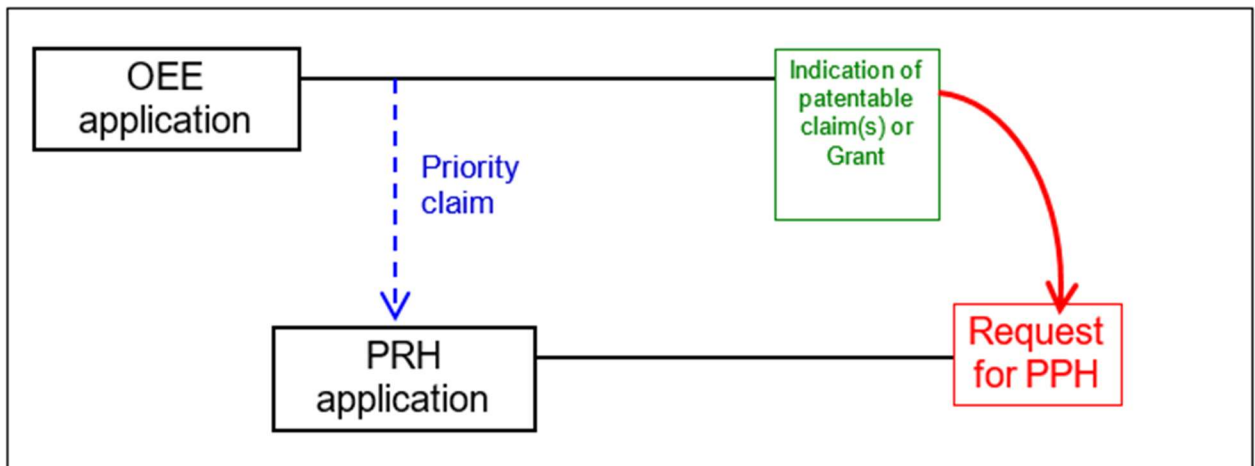
If all requirements for accelerated examination under the PPH are met, the PPH Administrator will notify the applicant that the application has been allowed entry to the PPH. The PPH Administrator will notify the relevant examining group that the application has qualified for entry to the PPH and the 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. If the applicant has limited the scope of claims for the PPH request and wishes to return to a wider scope after the PPH request has been rejected, the applicant has to provide the PRH with a new set of claims based on the basic document.

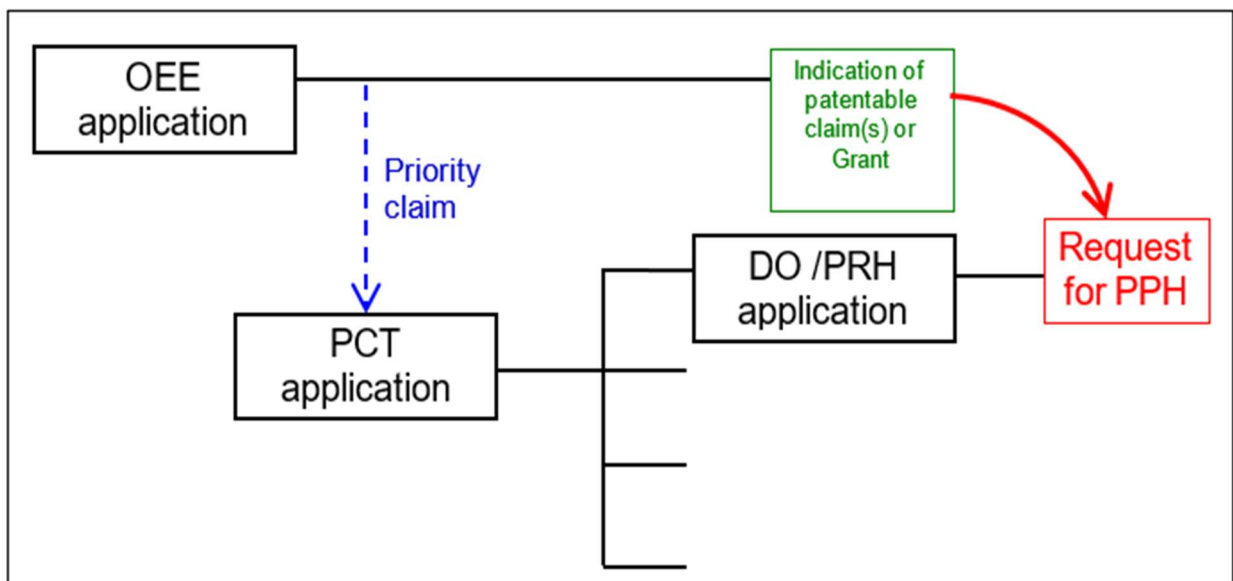
# Annex 1

## Examples of PRH applications eligible for PPH

**Figure A:**

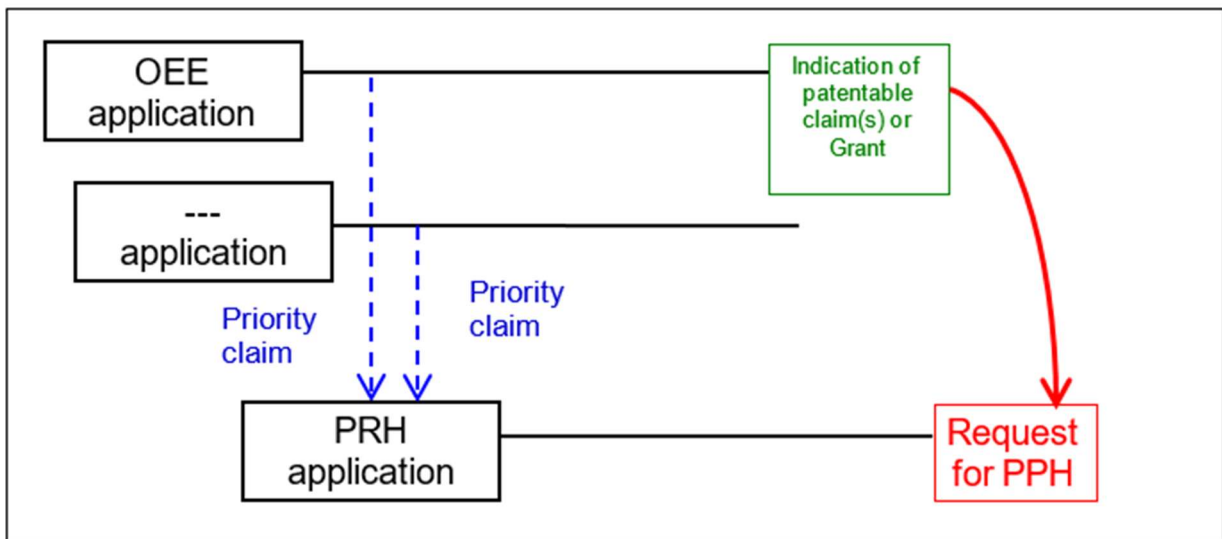


**Figure B:**



\* DO – Designated Office

**Figure C:**



---any office

**Figure D:**

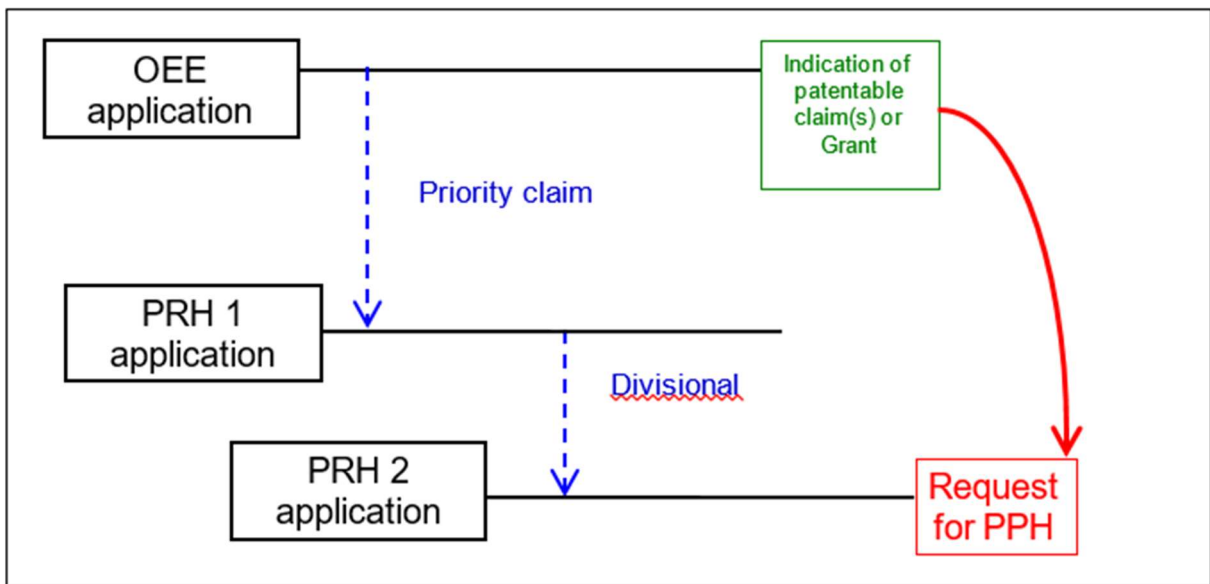




Figure E:

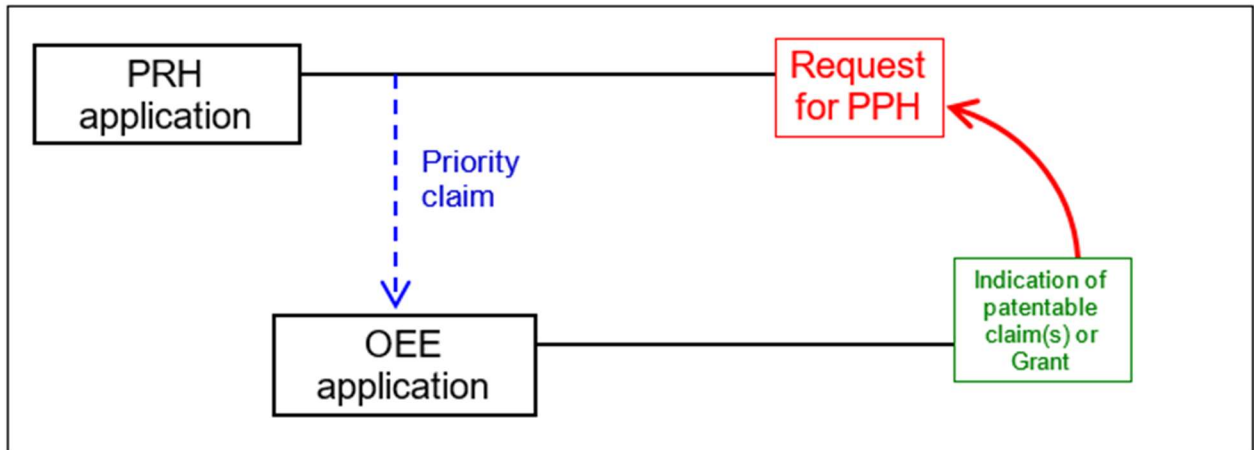
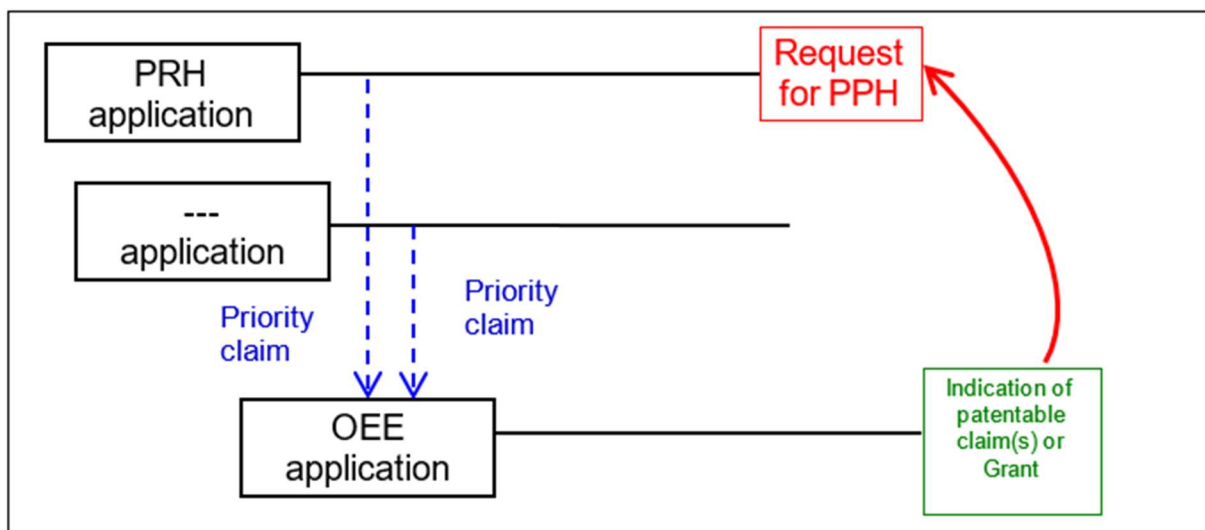


Figure F:



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Figure G:

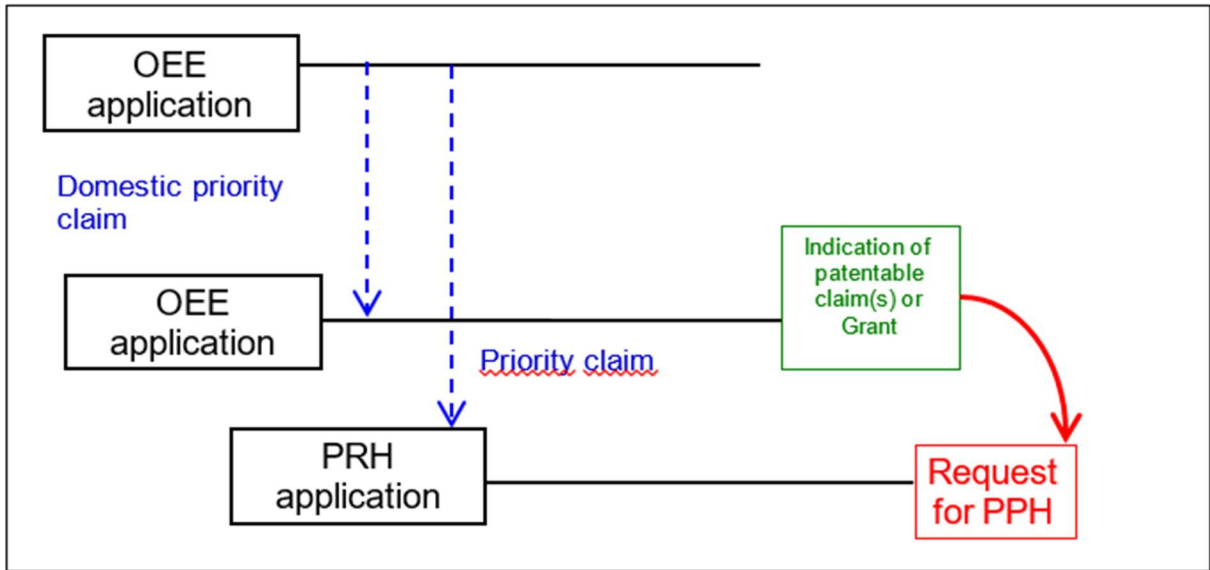
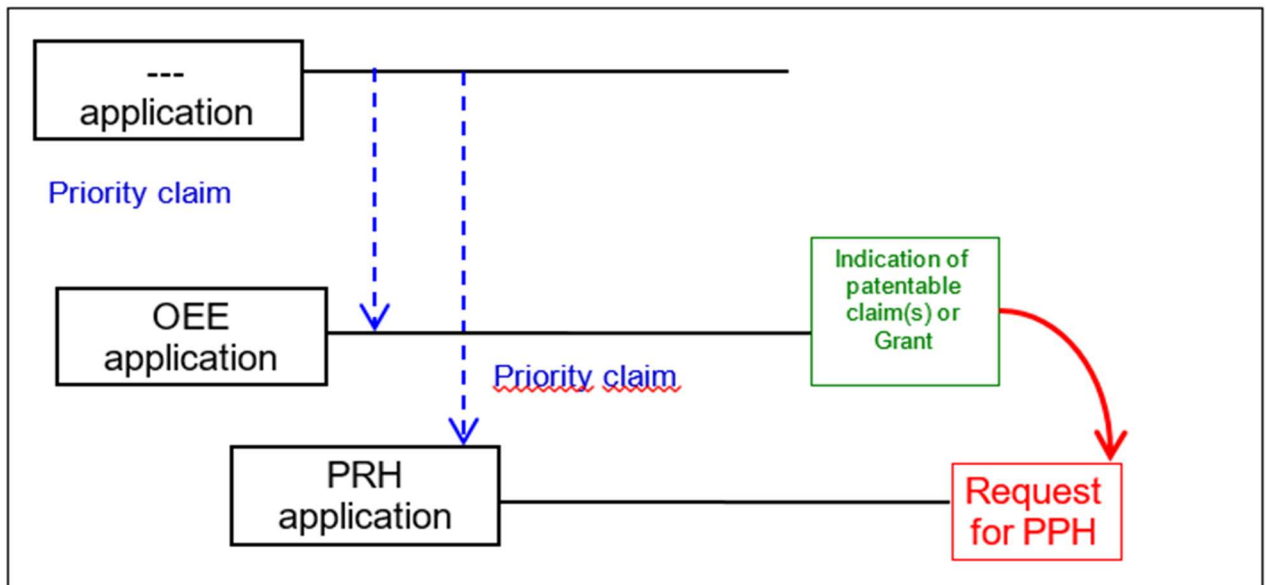
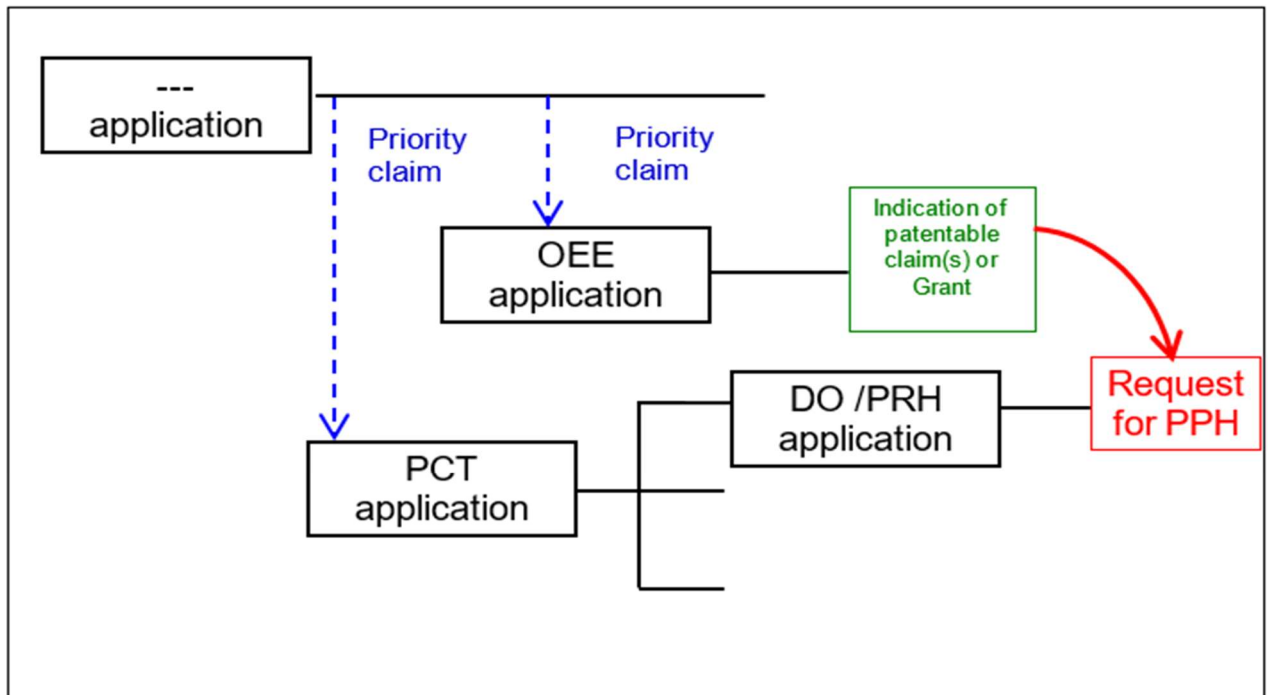


Figure H:



--- any office

Figure I:



--- any office