

Procedures to file a request to the Austrian Patent Office (ÖPA) for Patent Prosecution Highway (PPH) Pilot Program between the ÖPA and the Hungarian Patent Office (HPO)

The PPH Pilot Program enables an application whose claims have been determined to be patentable in the Office of First Filing (OFF) - HPO - to undergo an accelerated examination in the Office of Second Filing (OSF) - ÖPA - with a simple procedure according to a request from an applicant.

1. Request to the ÖPA

An applicant has to file a request for accelerated examination under the PPH to the ÖPA by submitting a bilingual German/English form for requesting accelerated examination under the PPH Pilot Program accompanied by the relevant supporting documents. The requirements for an application to the ÖPA for accelerated examination under the PPH are given in paragraph 2. Relevant supporting documentation (paragraph 3) and the general ÖPA application procedure envisaged at this time is discussed in the following section (paragraph 4).

2. Requirements for requesting accelerated examination under the PPH Pilot Program at the ÖPA

There are four requirements for requesting accelerated examination under the PPH Pilot Program at the ÖPA. These are:

a) The ÖPA application (including PCT national phase applications) is:

- (i) an application which validly claims priority under the Paris Convention to the HPO application(s) (examples are provided in Annex, figure A, B, H, I, J and K), or
- (ii) a PCT national phase application without priority claim (direct PCT applications) (examples are provided in Annex, figure L), or
- (iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in Annex, figure M, N and O).

An ÖPA application which validly claims priority to multiple HPO or PCT applications, or which is a divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

b) At least one corresponding HPO application has one or more claims that have been determined to be patentable by the HPO.

c) All claims in the ÖPA application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as patentable in the HPO.

Claims shall be considered to sufficiently correspond where the claims are of the same scope such that the claims in the ÖPA application have a common technical feature with the claims in the HPO application which makes the claims allowable over the prior art in the corresponding HPO application. Where amended claims have been determined to be patentable by the HPO, the claims of the ÖPA application should be such that they correspond to the amended claims of the HPO application. Claims of the ÖPA application which are appended to earlier claims of the ÖPA application corresponding to claims that are indicated as patentable by the HPO will also be considered where such claims fall within the scope of the claims indicated as patentable by the HPO.

d) The ÖPA has not yet issued a decision to grant a patent (‘Erteilungsbeschluss’).

3. Required documents for accelerated examination under the PPH Pilot Program at the ÖPA

The following documentation will be needed to support a request for accelerated examination under the PPH Pilot Program at ÖPA:

- a) **a copy of all office actions on the corresponding HPO application(s) and translation(s) of them.**
Both German and English are acceptable as translation languages. However, if the available (machine) translation is insufficient, the ÖPA examiner may request an additional translation from the applicant.
- b) **a copy of the claims examined by the HPO and copies of subsequent amended claims found to be patentable by the HPO where appropriate, and translation of them.**
Both German and English are acceptable as translation languages. However, if the available (machine) translation is insufficient, the ÖPA examiner may request an additional translation from the applicant.
- c) **a completed claim correspondence table in German or English language showing the correspondence between the claims of the ÖPA application for accelerated examination under the PPH and the claims of the corresponding HPO application considered patentable by the HPO.**
Sufficient correspondence of claims occurs where the claims are of the same scope as defined above. 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 2c).
- d) **a copy of the document(s) cited by the HPO examiner in the reasons for refusal.**
If the cited document is a patent document, it does not have to be submitted as it is generally available to the ÖPA via EPOQUE. Only if the ÖPA has difficulty in obtaining a patent document the Office will ask the applicant to submit it.
As a rule, cited documents need not be translated.

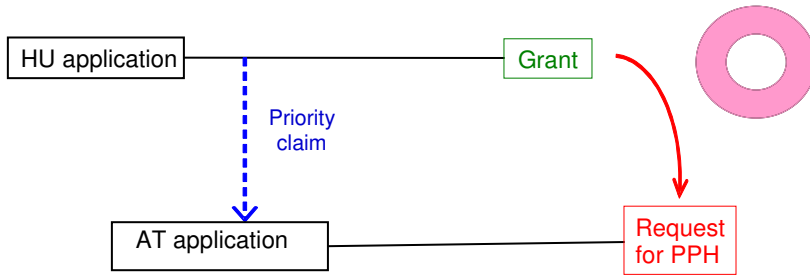
The applicant has to provide the relevant information by filling in a form for requesting accelerated examination under the PPH Pilot Program which is available for download from the ÖPA website. The form should be sent to the ÖPA along with the relevant supporting documentation.

If the applicant has already submitted the above documents 3a) to 3d) to the ÖPA through simultaneous or past procedures, the applicant can incorporate the documents by reference and does not have to attach them.

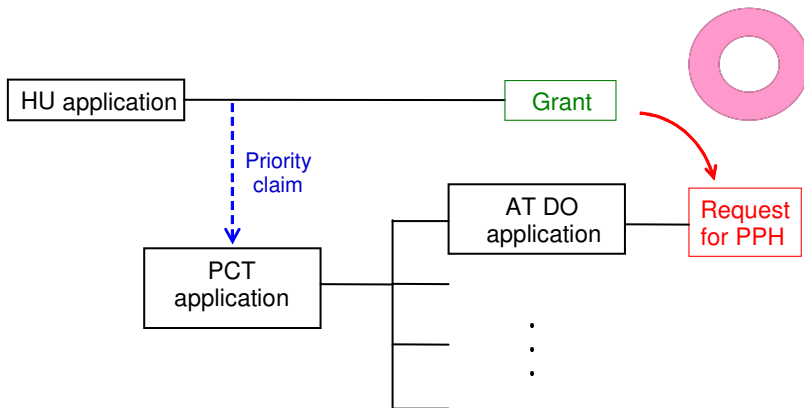
4. Procedure for accelerated examination under the PPH Pilot Program at the ÖPA

The applicant files a form requesting accelerated examination under the PPH Pilot Program to the ÖPA, including the relevant supporting documents. If the requirements are met, the ÖPA will conduct the accelerated examination. If the application does not qualify for participation in the PPH Pilot Project, the applicant will be informed accordingly and the application will be further processed under the standard ÖPA examination procedure, without acceleration.

A A case meeting requirement (a) (i)
- Paris route -



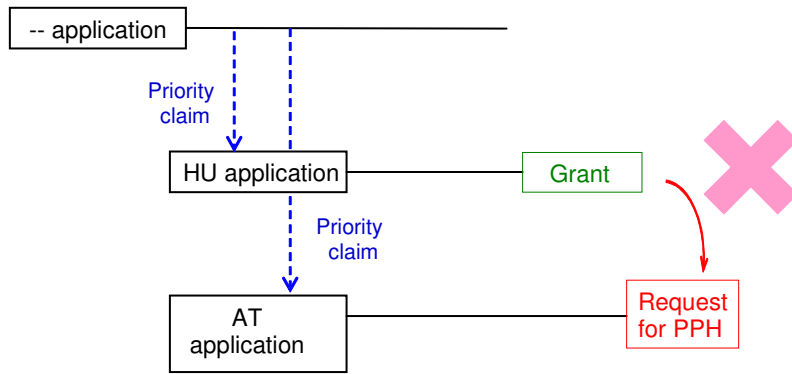
B A case meeting requirement (a) (i)
- PCT route -



C

A case not meeting requirement (a)

- Paris route, but the first application is from the third country -

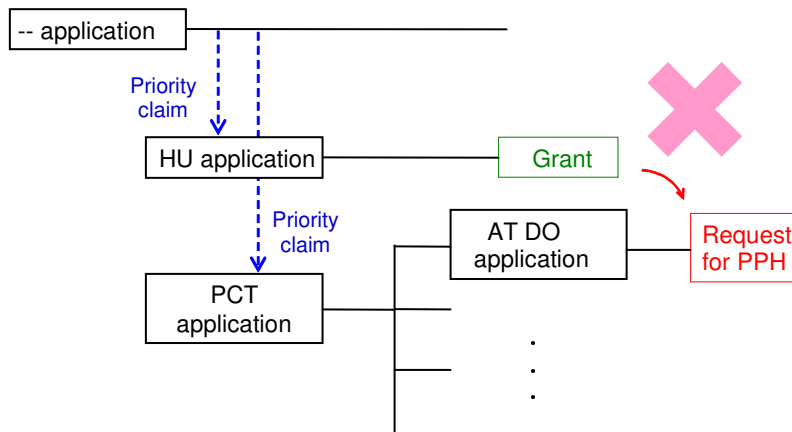


--: NOT PPH participating country

D

A case not meeting requirement (a)

- PCT route, but the first application is from the third country -

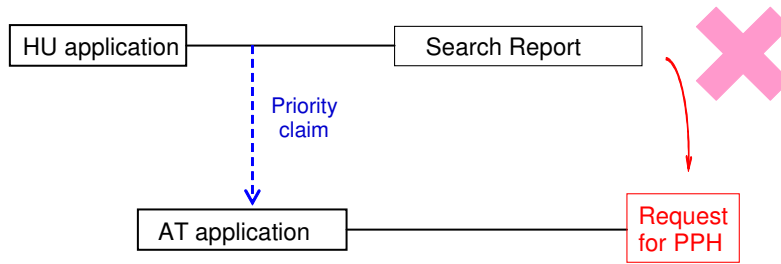


--: NOT PPH participating country

E

A case not meeting requirement (b)

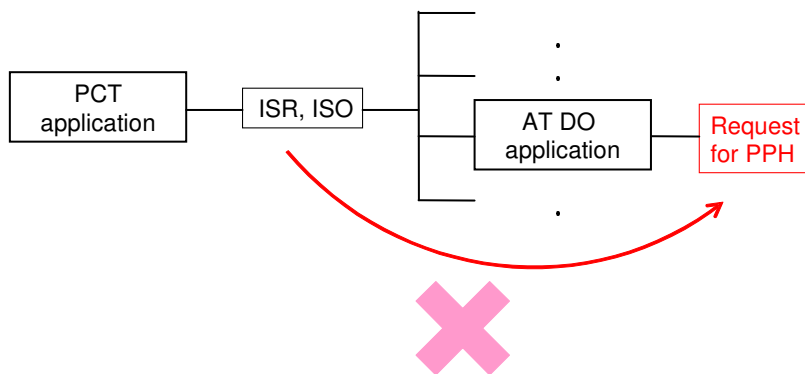
- Search Report -



F

A case not meeting requirement (b)

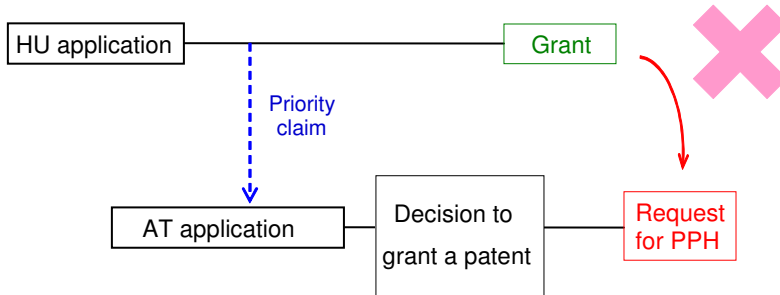
- ISR, ISO -



G

A case not meeting requirement (d)

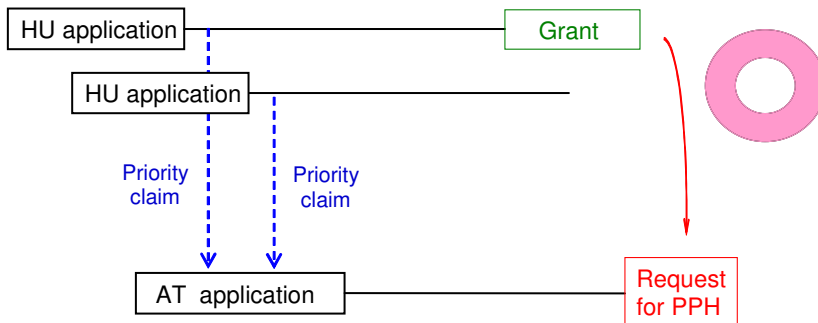
- "Decision to grant a patent" has issued before a request for PPH -



H

A case meeting requirement (a) (i)

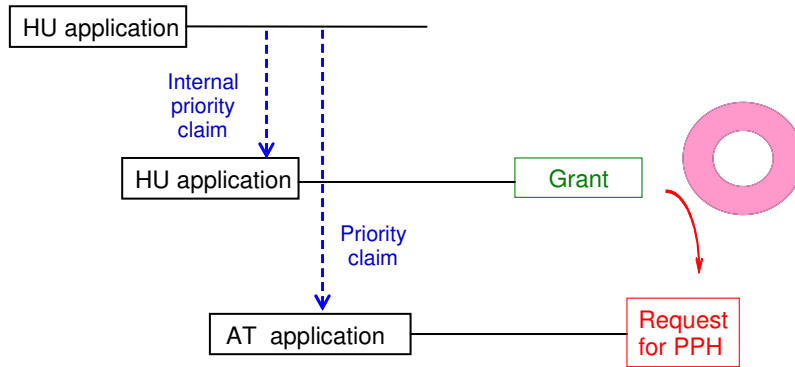
- Paris route & Complex priority -



I

A case meeting requirement (a) (i)

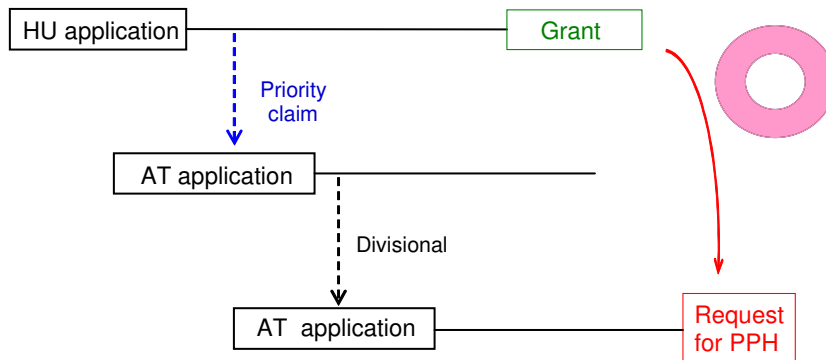
- Paris route & Internal priority -



J

A case meeting requirement (a) (i)

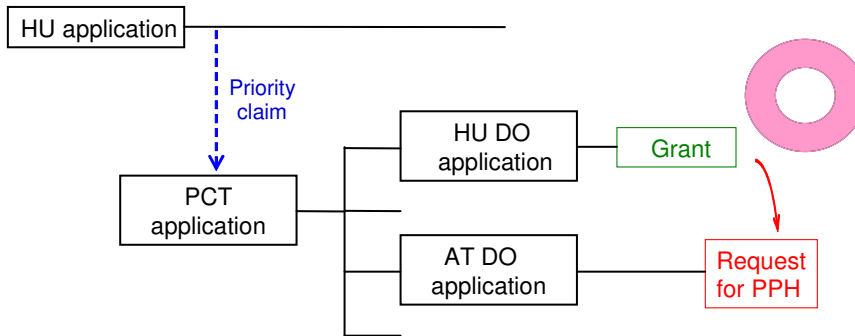
- Paris route & divisional application -



K

A case meeting requirement (a) (i)

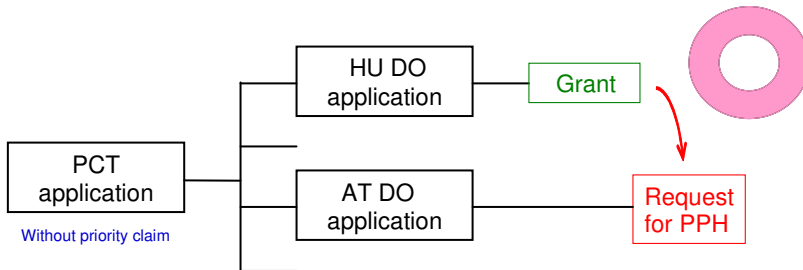
- PCT route -



L

A case meeting requirement (a) (ii)

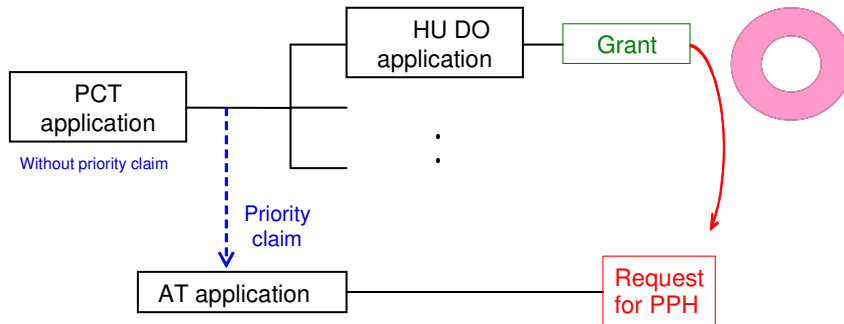
- Direct PCT route -



M

A case meeting requirement (a) (iii)

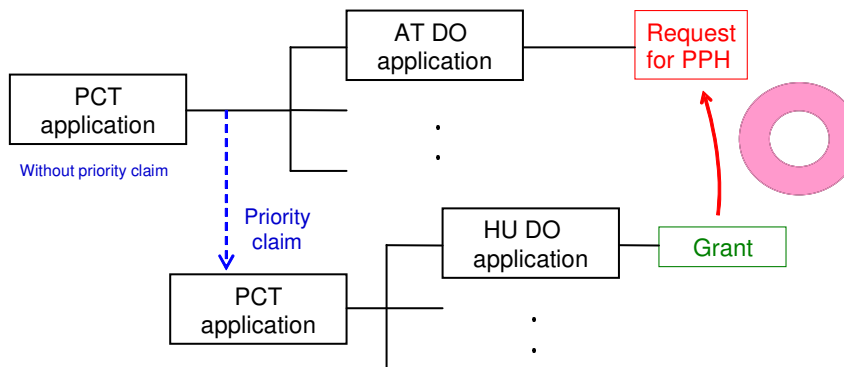
- Direct PCT & Paris route -

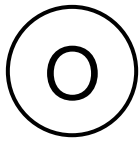


N

A case meeting requirement (a) (iii)

- Direct PCT & PCT route -





A case meeting requirement (a) (iii)

- Direct PCT & PCT route -

