

Procedures to file a request to the HPO for Patent Prosecution Highway Pilot Program between the USPTO and the HPO

1. Request to the HPO

[0001] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the HPO accompanied by the relevant supporting documents. The requirements for an application to the HPO for accelerated examination under the PPH are given in the following section (paragraph [0002]). Relevant supporting documentation is discussed in a later section (paragraphs [0003]-[0006]) as is the general HPO application procedure envisaged at this time (paragraph [0007]).

2. Requirements for requesting an accelerated examination under the PPH pilot program at the HPO

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

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

- (i) an application which validly claims priority under the Paris Convention to the corresponding USPTO application(s) (examples are provided in Annex 3, figure A, B, C, D, E and F), or
- (ii) a PCT national phase application without priority claim (direct PCT applications) (an example is provided in Annex 3, figure G), 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 3, figure H, I and J).

The HPO application, which validly claims priority to multiple USPTO 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 USPTO application exists and has one or more claim(s) that have been determined to be patentable by the USPTO.

Claims clearly identified to be patentable by the USPTO in the latest office action at examination stage can form the basis of a request for an accelerated examination under the PPH pilot program even if the USPTO has not yet granted a patent for those claims. If the USPTO office action does not explicitly state that a particular claim is patentable, applicant must include a statement that no rejection has been made in the USPTO office action regarding the claim and therefore, the claim is deemed patentable by the USPTO. Such a statement must be included in the letter requesting participation in the PPH pilot program.

Where the USPTO application that contains the patentable/allowable claims is not the same application for which priority is claimed in the HPO application, applicant must identify the relationship between the USPTO application that contains the patentable/allowable claims and the USPTO priority application claimed in the HPO application. (Refer to Example C and E in Annex 3).

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

All claims in each HPO application for which a request for participation in the PPH pilot project is made must sufficiently correspond or be amended to correspond to the patentable/allowable claims in the USPTO application(s).

Claims shall be considered to sufficiently correspond where both claims have a common technical feature which made the claims patentable over the prior art in the USPTO application. In this regard, a claim which has additional component on the claim determined to be patentable by the USPTO or which is the same except for claim format as the claim determined to be patentable by the USPTO will be considered to sufficiently correspond.

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

d) The HPO has not yet issued a “Communication of Approval” (The heading of the communication is “Felhívás nyilatkozattételre és megadási díj megfizetésére”).

3. Required documents for accelerated examination under the PPH pilot program at the HPO:

[0003] The following documentation will be needed to support a request for accelerated examination under the PPH pilot program at the HPO:

a) A copy of the office action(s) relating to the corresponding USPTO application(s).

“Office actions” are documents which relate to substantive examination and which were sent to the applicant or the applicant’s representative by the USPTO examiner.

The applicant can either provide the office actions together with the request for the acceleration under the PPH or request that the HPO obtain the documents from the USPTO Public PAIR system.

It is noted that applicants must also submit copies of any office actions (which are relevant to patentability) from the USPTO application(s) issued after the grant of the request for participation in the PPH pilot program in the HPO (especially where USPTO might have reversed a prior holding of allowability/patentability).

Submission of translation of the office action(s) is not required. However, applicants will be free to file Hungarian translations as part of the supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the office actions if they so desire.

b) A copy of the claims determined to be patentable by the USPTO including any subsequent amended claims found to be patentable by the USPTO.

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

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

The applicant can either provide the claims together with the request for acceleration under

the PPH or request that the HPO obtain the claims from the USPTO Public PAIR system.

Submission of translation of the claims is not required. However, applicants will be free to file Hungarian translations as part of the supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the claims if they so desire.

c) A completed claim correspondence table

The applicant must submit a claim correspondence table to explain the correspondence of claims determined to be patentable by the USPTO and the claims of the HPO application for accelerated examination under the PPH. 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 point 2.c). (See also Annex 1 for the examples of the claim correspondence). The claim correspondence table must be written in either English or Hungarian.

Any claims amended or added after the grant of the request for participation in the PPH pilot program must sufficiently correspond to one or more allowable/patentable claims in the USPTO application(s). Applicant is required to submit a new claim correspondence table along with the amendments. If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the HPO application(s), the amendment will not be entered.

d) A copy of the references cited by the USPTO examiner

If the cited references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the HPO. If the HPO does not have access to the relevant patent documents, the applicant must submit these documents at the request of the HPO.

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.

[0004] The applicant is required to complete a form for requesting accelerated examination under the PPH pilot program (as given in Annex 2) which is available for download from the HPO website (<http://www.hpo.hu/English/szabadalom/pph>). The form must be sent to the HPO along with the relevant supporting documentation.

[0005] In those rare situations where the US application has not been published, and therefore the US file wrapper is not available via USPTO Public PAIR system, applicant will be responsible for providing the necessary documents to the HPO.

[0006] When the applicant has already submitted above documents 3.a) to 3.d) to the HPO through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

4. Procedure for accelerated examination under the PPH pilot program at the HPO

[0007] The applicant files a request form for accelerated examination under the PPH pilot program to the HPO along with the documents referred to in point 3.(Annex 2). The applicant is not required to pay a fee for accelerated examination under the PPH.

The HPO 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 in point 3 of this document. When the HPO 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 in this document, 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.

Examples for the claim correspondence

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

EX.1

<i>OFF claims</i>	<i>OSF claims</i>	<i>Comment</i>
1	1	<i>The OSF claim has the additional component on the OFF 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:</p> <p style="padding-left: 20px;">a frame having an opening;</p> <p style="padding-left: 20px;">a support structure being adapted to receive a container, and</p> <p style="padding-left: 20px;">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;</p> <p style="padding-left: 20px;">wherein a container traveling on said conveyer moves unobstructed over said support structure when said support structure is located in said second height,</p> <p style="padding-left: 20px;">wherein the container traveling unobstructed does not contact said support structure while traveling over said support structure located at said second height,</p> <p style="padding-left: 20px;">wherein said support structure, when located at said second height, is located below said transport plane.</p> <p style="color: red; font-size: small;">*This additional part is NOT included in the OFF granted claim but it is included in the description of the OFF application</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:</p> <p style="padding-left: 20px;">a frame having an opening;</p> <p style="padding-left: 20px;">a support structure being adapted to receive a container, and</p> <p style="padding-left: 20px;">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;</p> <p style="padding-left: 20px;">wherein a container traveling on said conveyer moves unobstructed over said support structure when said support structure is located in said second height,</p> <p style="padding-left: 20px;">wherein the container traveling unobstructed does not contact said support structure while traveling over said support structure located at said second height,</p> <p style="padding-left: 20px;">wherein said support structure, when located at said second height, is located below said transport plane,</p> <p style="padding-left: 20px;"><i>wherein said support structure, when located at said first height, is located above said transport plane*</i>.</p>

EX.2

<i>OFF claims</i>	<i>OSF claims</i>	<i>Comment</i>
1	1	Same
none	2	The OSF claim2 is dependent on the OSF claim1, which has been granted at OFF.

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 $1 \cdot 10^9 \text{ cm}^2$ 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

PPH REQUEST

Request for Accelerated Examination at the HPO under the Patent Prosecution Highway Pilot Program between the HPO and the USPTO

1. HU application number:

Corresponding US application number(s):

2. **Either:**

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

or

b) USPTO office action(s) available via Public PAIR:

or

c) USPTO office action(s) on file from previous PPH application:
HU application number:

3. **Either:**

a) Copy of claims of corresponding US application attached:

or

b) Claims of corresponding US application available via Public PAIR:

or

c) US application claims on file from previous PPH application:
HU application number:

4. Copy of translated US office action(s) attached:

5. Copy of translated claims of corresponding US application attached:

6. Translation version of foreign language citation attached:

(Please note that it is not necessary to provide translation of the US office actions, the claims of corresponding US application and the references cited by the USPTO. However, applicant will be free to file translations to allow prompt consideration of these documents if they so desire.)

7. Claim correspondence table completed:

Examples of HPO application eligible for the PPH

Figure A:

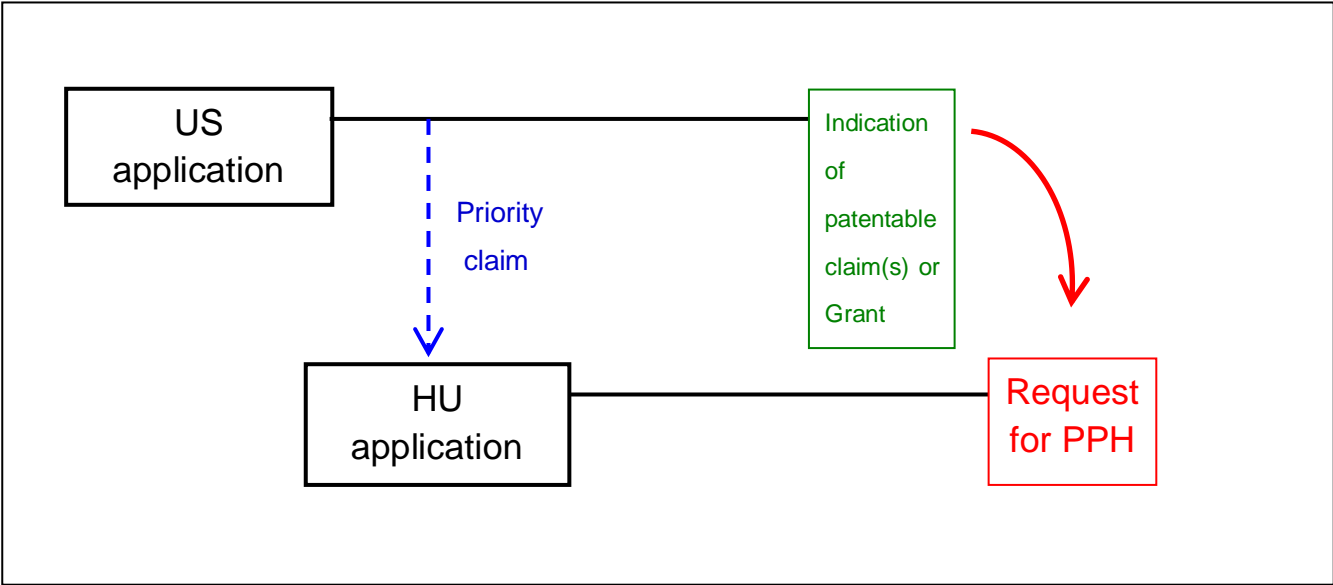


Figure B:

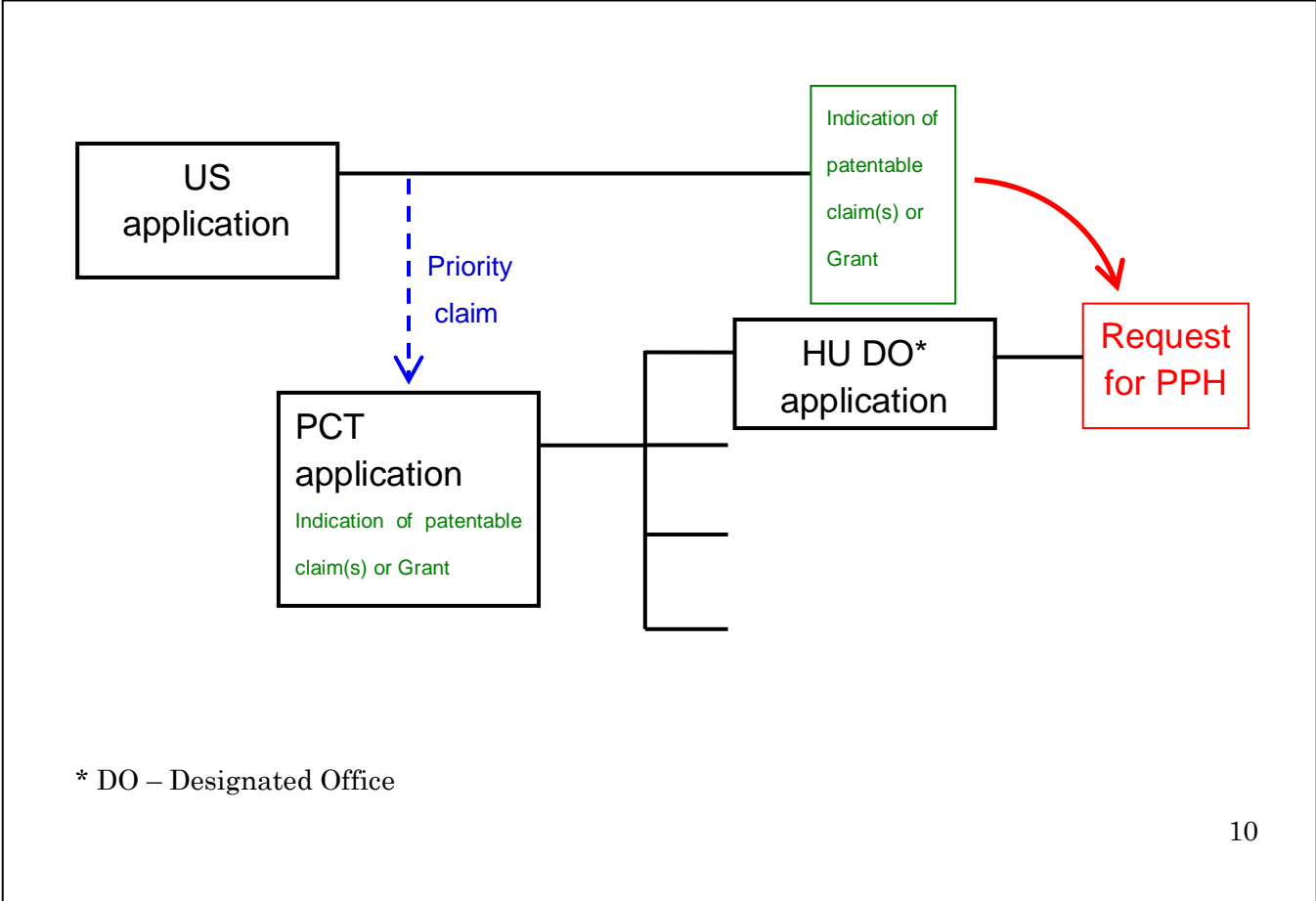


Figure C:

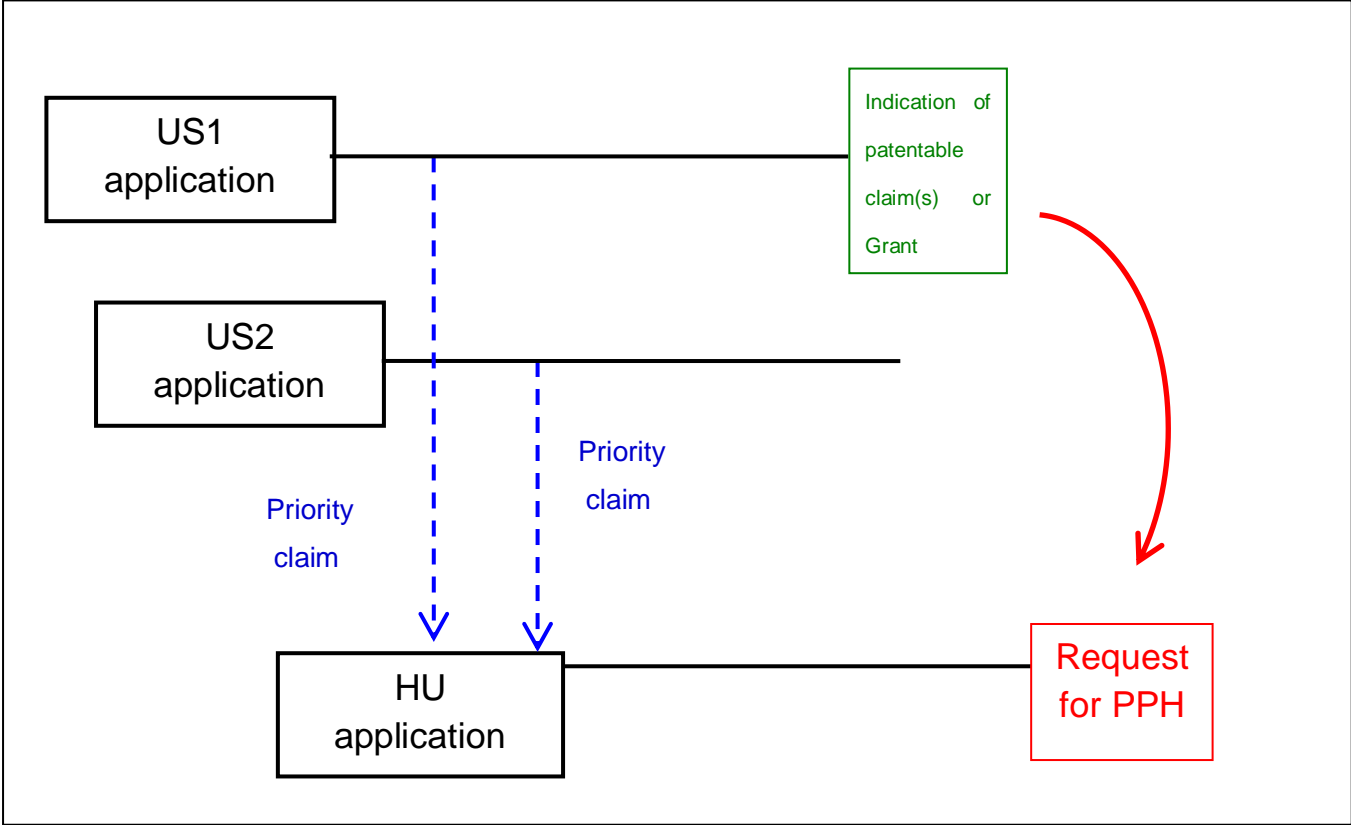


Figure D:

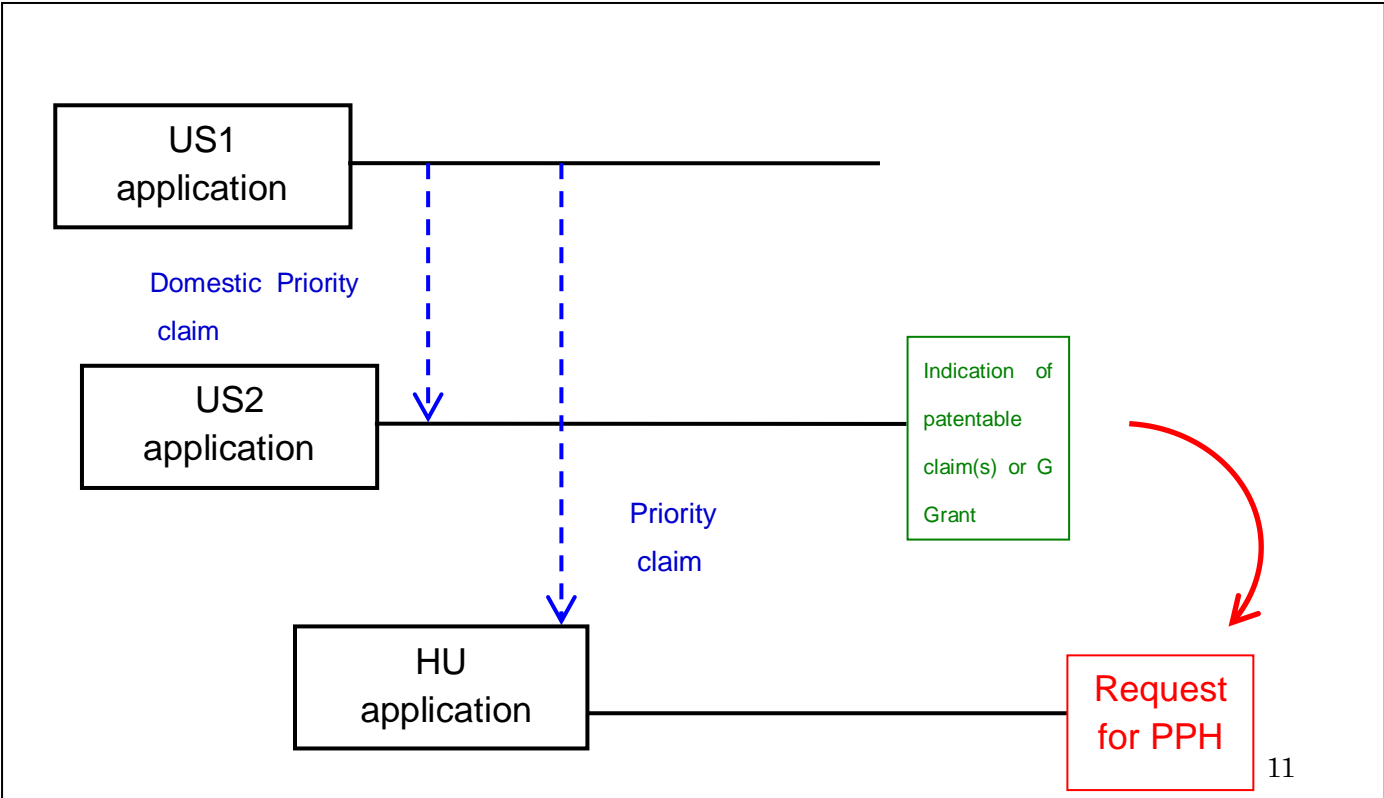


Figure E:

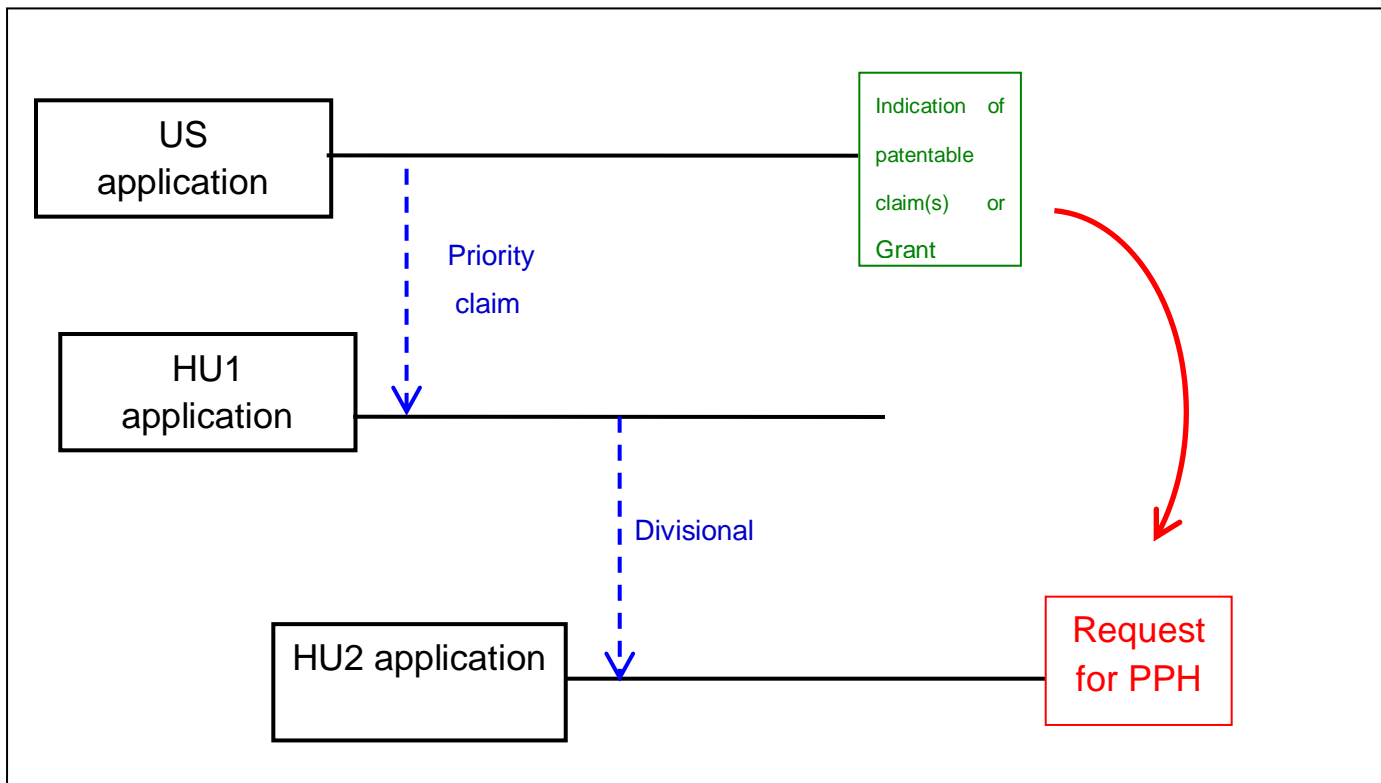


Figure F:

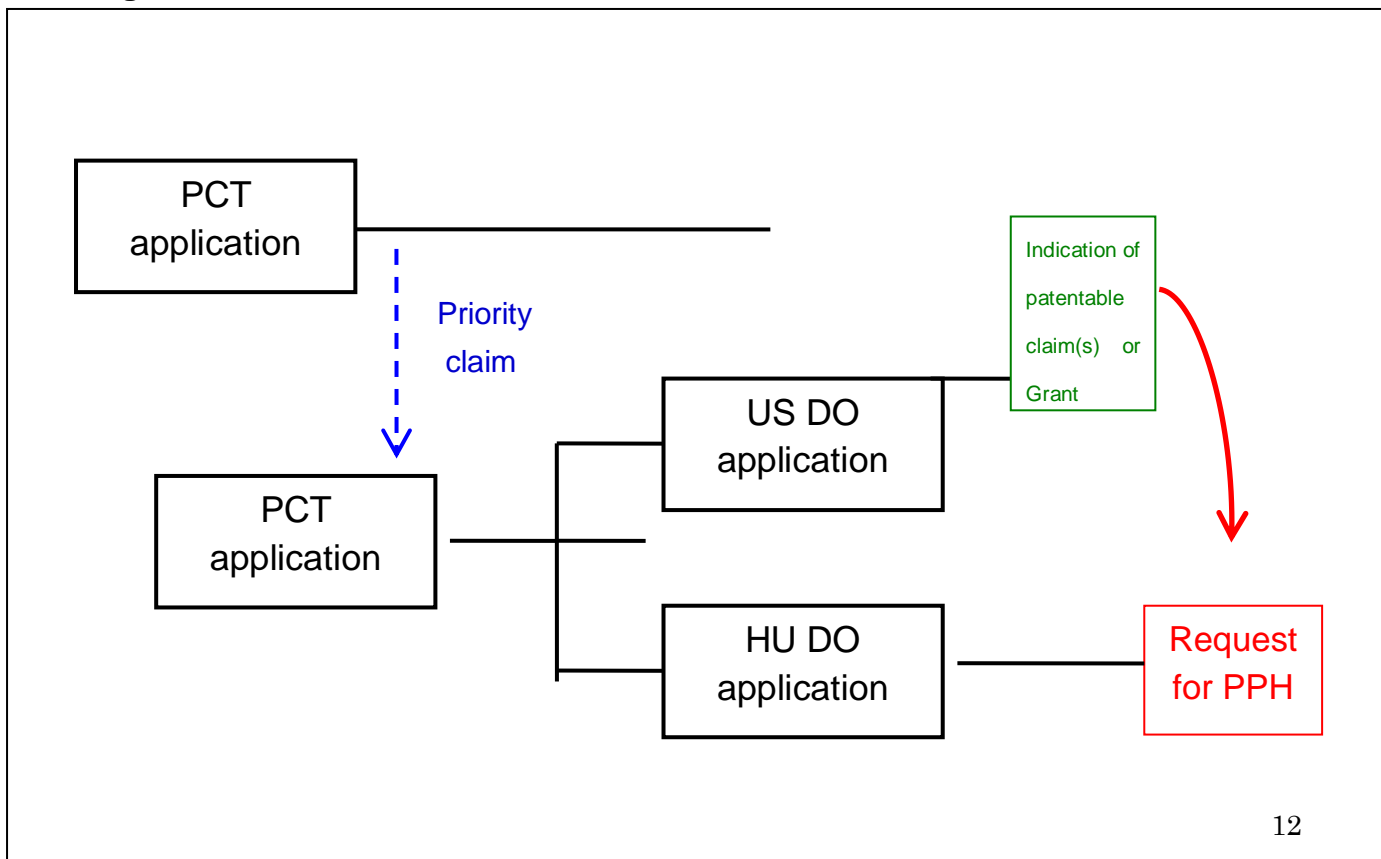


Figure G:

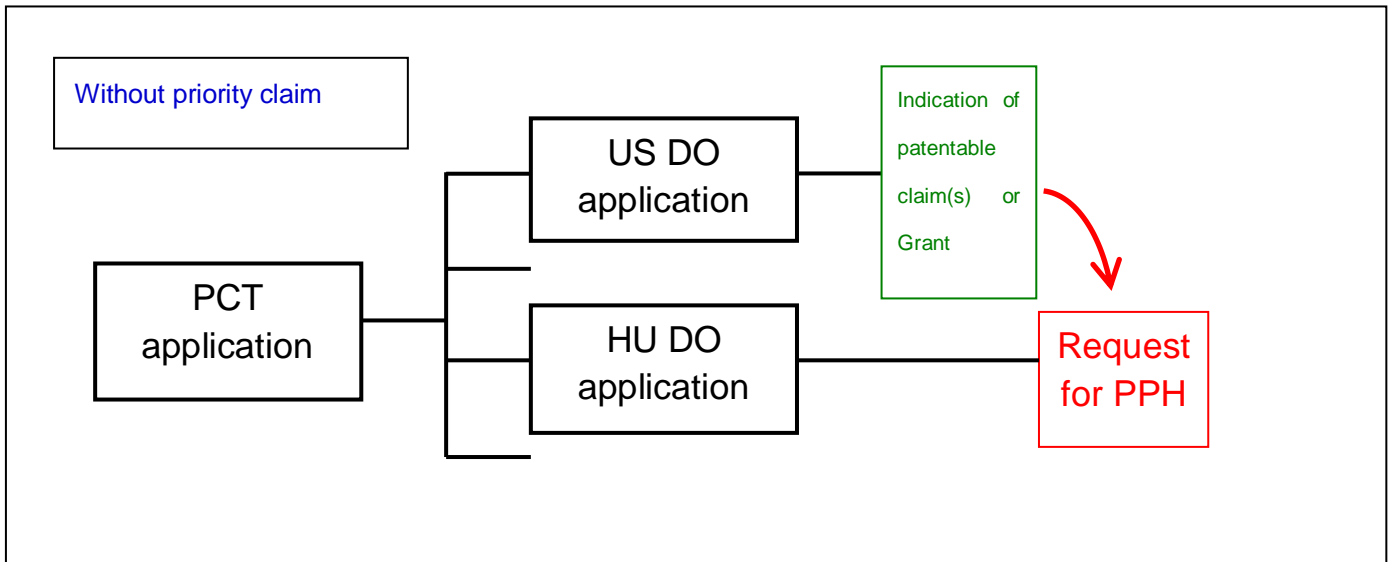


Figure H:

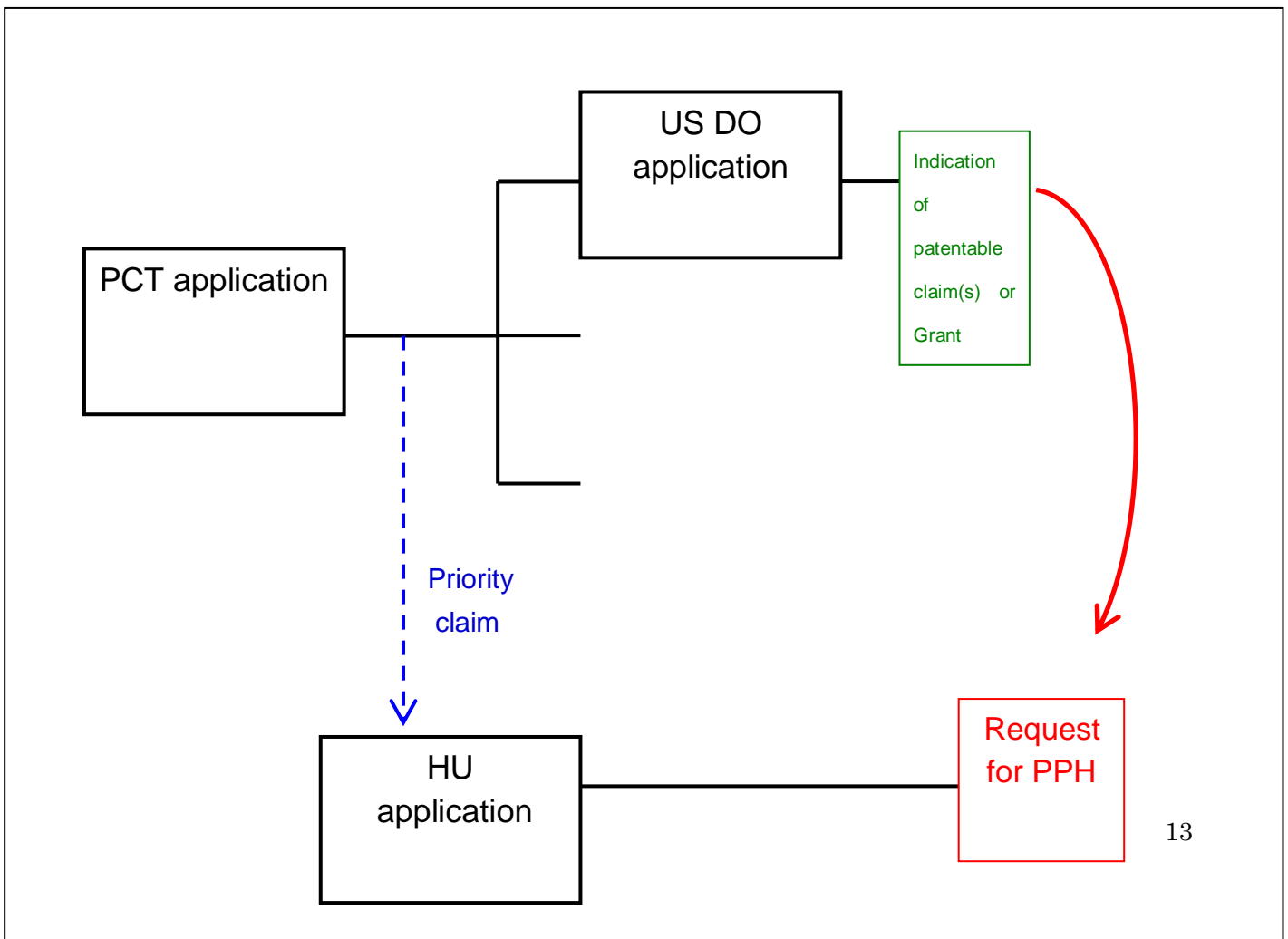


Figure I:

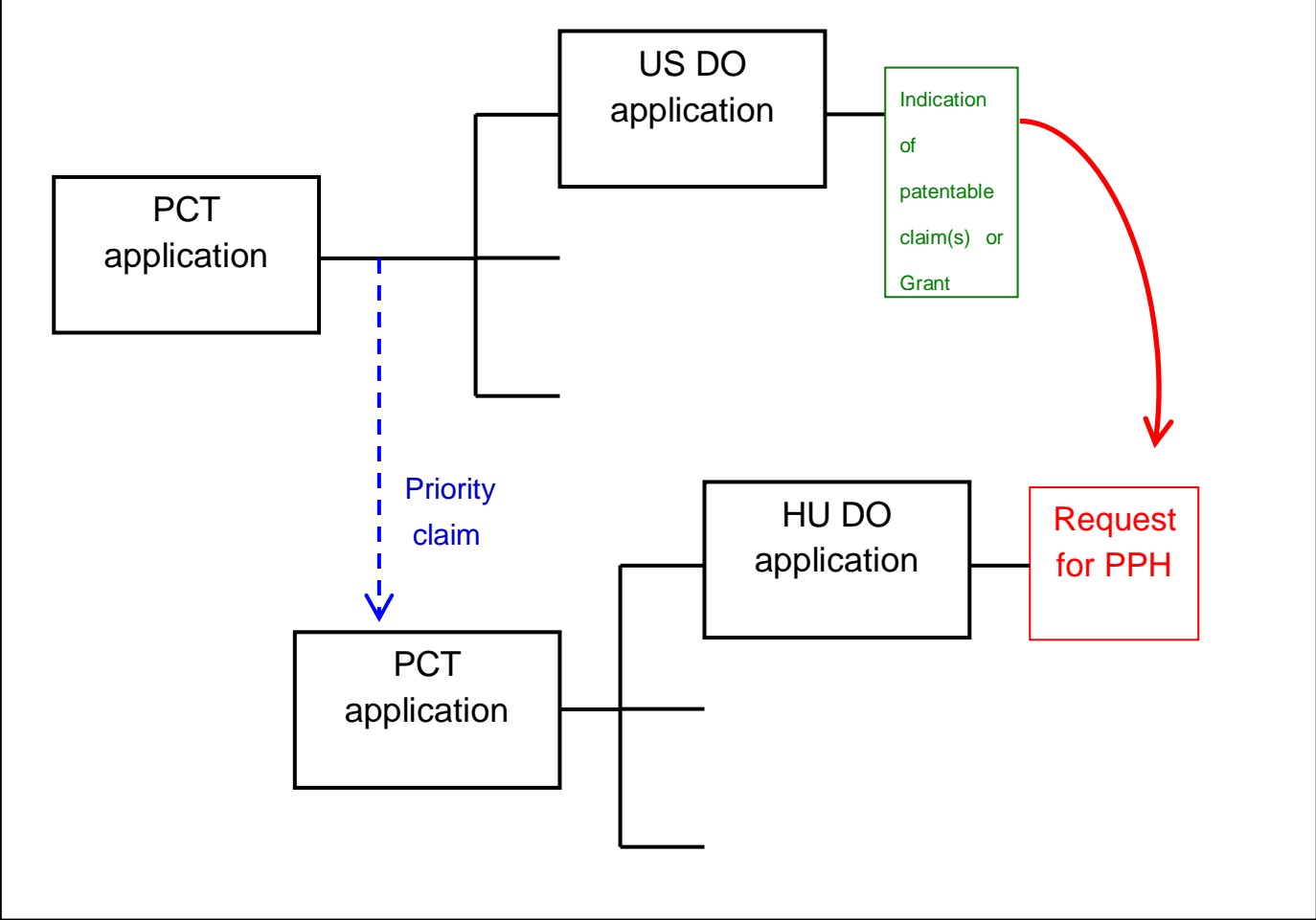
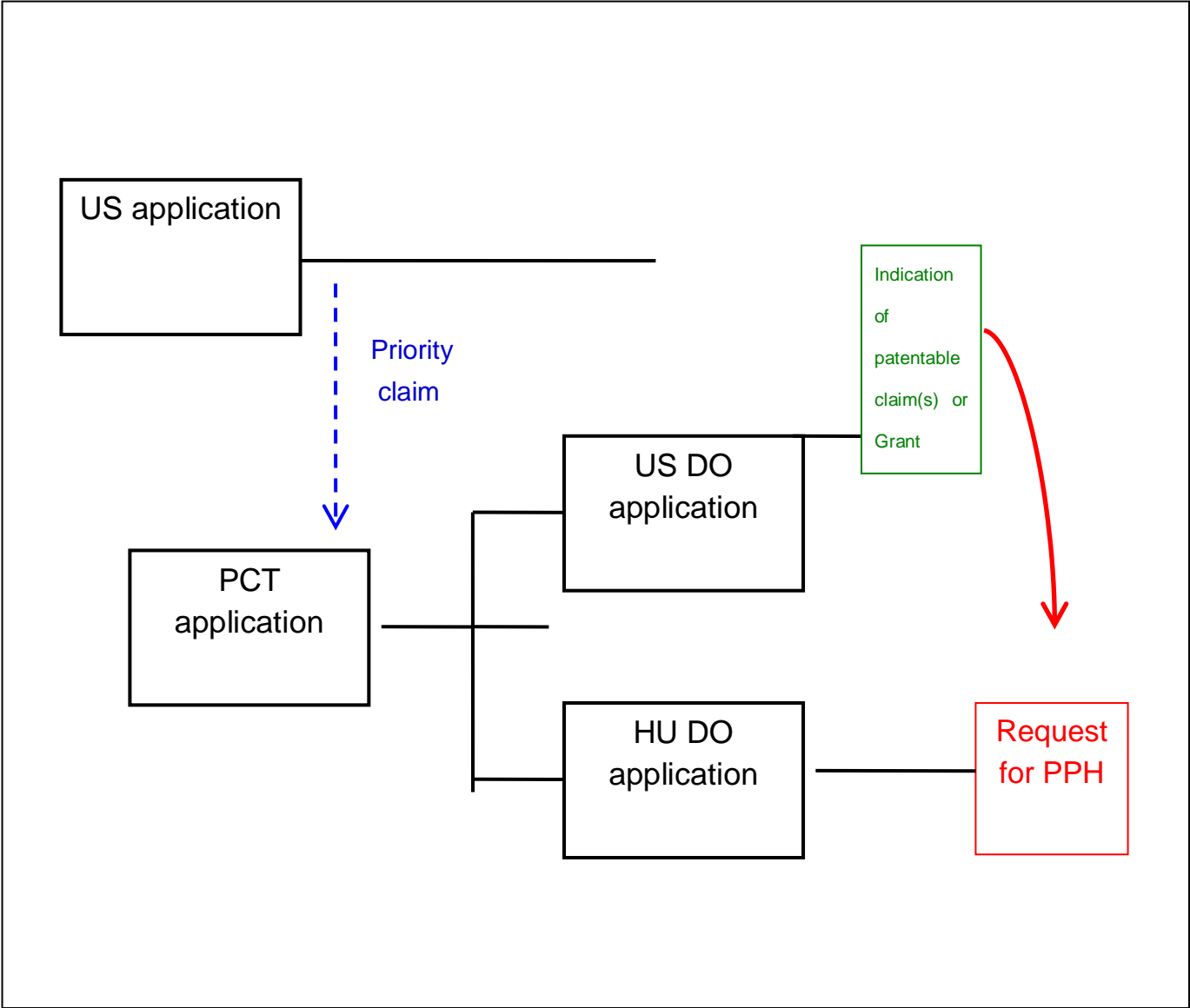


Figure J:



This notice is accepted by:

Date: _____

MIKLÓS BENDZSEL

President

Hungarian Patent Office