

Procedures to file a request to the
Icelandic Patent Office (IPO)
for the
Patent Prosecution Highway
Pilot Program between the
US Patent and Trademark Office (USPTO)
and the
Icelandic Patent Office (IPO)

Request to the IPO

An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the IPO by submitting a letter requesting accelerated examination under the PPH accompanied by the relevant supporting documents, including completed PPH request form. The requirements for an application to the IPO for accelerated examination under the PPH are given in section 1 and relevant supporting documentation is discussed in section 2.

PPH pilot program at the IPO

This Pilot Program commence on December 1, 2011.

1 Requirements

The application which is filed with the IPO and for which the applicant files a request for an accelerated examination under the PPH must satisfy the following requirements:

1.1 The IPO application (including PCT national phase applications) must be:

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

(examples are provided in Annex I, figure I and K), or

(C) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in Annex I, figure J and L).

An IPO 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 (A) to (C) above, is also eligible.

1.2 At least one corresponding USPTO application has one or more claims 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 though 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 which accompanies the request form, cf section 2.5 below.

1.3 Claim correspondence

All claims on file as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO.

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

In this regard, a claim that is narrower in scope occurs when a USPTO 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 IPO which introduces a new/different category of claims to those claims indicated as allowable in the USPTO is not considered to sufficiently correspond. For example, if the USPTO claims only contain claims to a process of manufacturing a product, then the

claims in the IPO are not considered to sufficiently correspond if the IPO claims introduce product claims that are dependent on the corresponding process claims.

1.4 The IPO has not begun examination of the application at the time of request for the PPH

The request for the PPH shall be permitted only before the applicant receives the notification whose heading would be “Rannsókn einkaleyfisumsóknar” (Examination of patent application).

2 Documents to be submitted when filing a request for accelerated examination under the PPH

The applicant must submit the following documents 2.1-2.4 attached to the request form (see Annex 2) when filing a request under PPH. All documents under this paragraph with exception for the cited documents have to be drawn up in or translated to Danish or English.

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

The term “office actions” is here used about the correspondence sent to the applicant or the applicant’s representative from the USPTO examiner.

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 IPO (especially where USPTO might have reversed a prior holding of allowability/patentability).

2.2 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 applicant will need to provide a copy of the claims together with the request for acceleration under the PPH.

2.3 A completed claim correspondence table showing the relationship between the claims of the IPO application for accelerated examination under the PPH and the claims of the corresponding USPTO application considered patentable by the USPTO.

Sufficient correspondence of claims occurs where the claims are of the same or similar scope as defined above in 1.3. The claim correspondence table must indicate how all the claims in the IPO application correspond to the patentable claims in the USPTO application as shown in Annex 2. The claim correspondence table must be written in either English or Danish.

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 claims correspondence table along with the amendments. If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the IPO application(s), the amendment will not be entered.

2.4 A copy of the references cited by the USPTO examiner.

If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the IPO. If the IPO does not have access to the relevant patent documents, the applicant must submit these documents at the request of the IPO. Non-patent literature must always be submitted.

2.5 Request form

An applicant should submit a request form (See Annex 2) to the IPO for the accelerated examination under the PPH along with the documents referred to in paragraphs 2.1-2.4. The applicant need not provide further copies of documentation if they have already submitted the documents noted above to the IPO through simultaneous or past procedures.

Procedure for the accelerated examination under the PPH

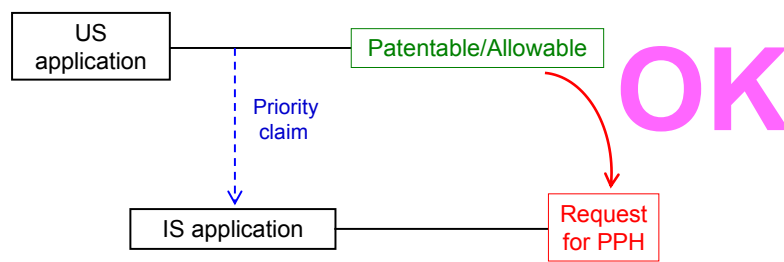
The applicant files a letter requesting accelerated examination under the PPH Pilot Program to the IPO, including the relevant supporting documents and a completed request form (see Annex 2).

If the request does not meet all the requirements set forth above, 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 the defect(s) are not corrected, the applicant will be notified, and the application will await action in its regular turn. If an examination of the application has begun after the applicant has been notified of the defects in the request, any renewed request will be dismissed.

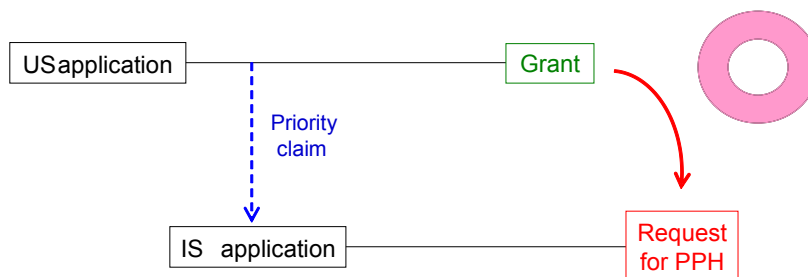
If the request for participation in the PPH pilot program meets all the requirements and examination has not begun, the IPO will decide whether a patent will be issued based on the search and examination carried out by the USPTO or sent to the Danish Patent and Trademark Office (DKPTO) for examination, in accordance with a partnership agreement. If the application is sent to the DKPTO, their patent examiners will conduct the accelerated examination at the request of the IPO.

Annex 1

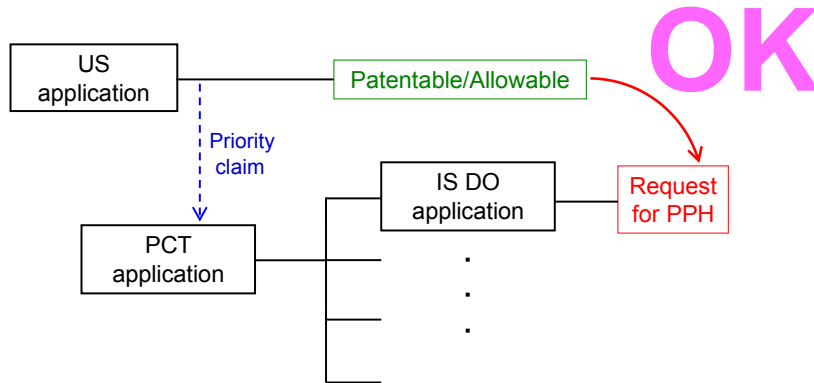
A A case meeting requirement 1.1(A) - Paris route -



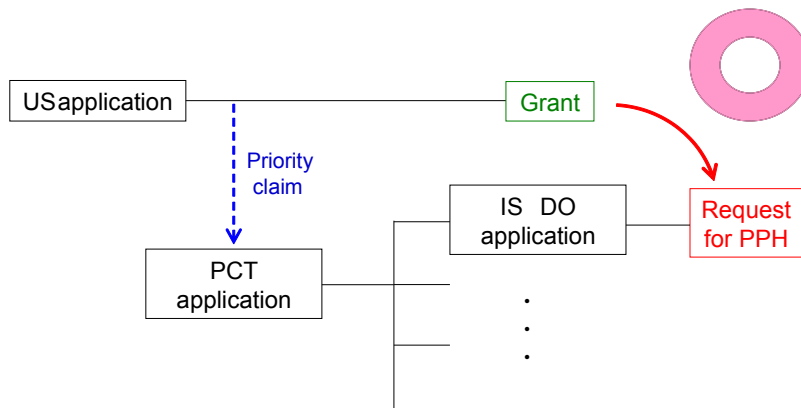
A A case meeting requirement a(i) - Paris route -



B A case meeting requirement 1.1(A)
- PCT route -

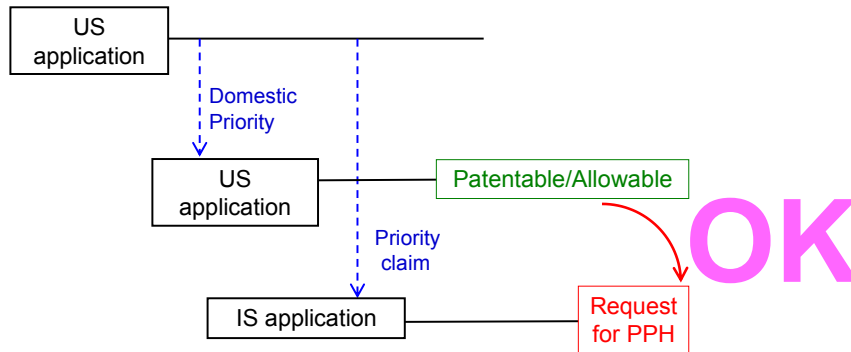


B A case meeting requirement a(i)
- PCT route -



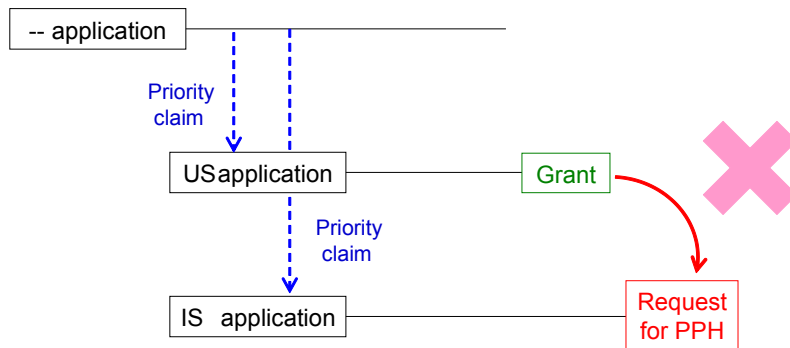
C A case meeting requirement 1.1(A)

- PCT route, Domestic priority -



C A case not meeting requirement a

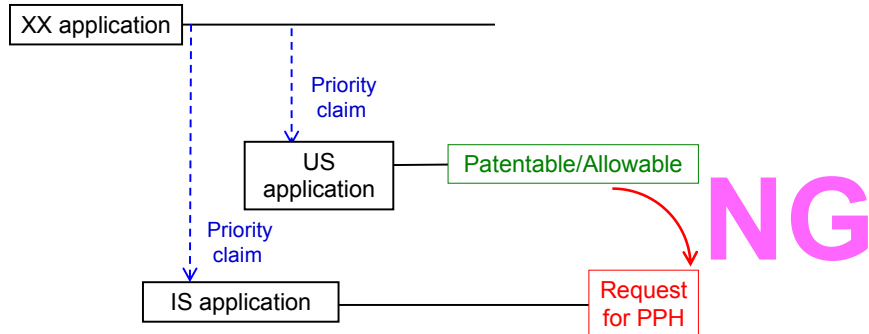
- Paris route, but the first application is from the third country -



-- : NOT PPH participating

D A case not meeting requirement 1.1

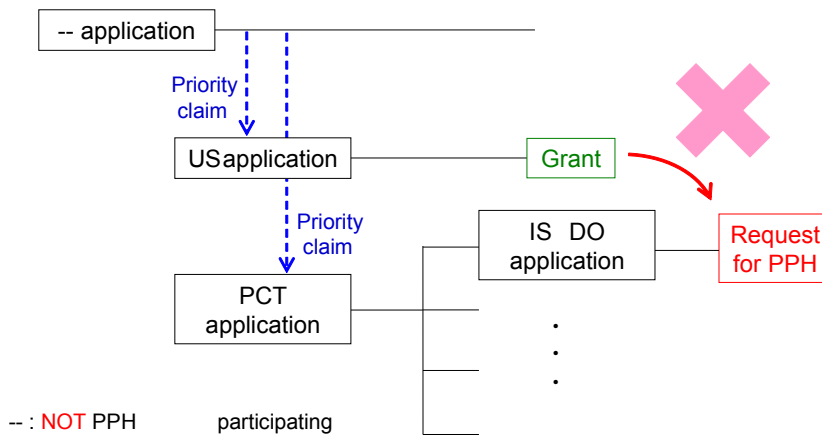
- Paris route, but the first application is from the third country -



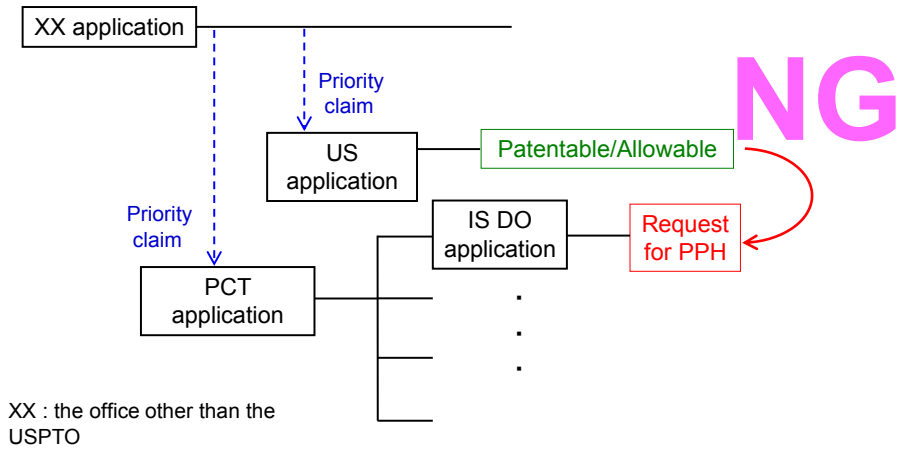
XX : the office other than the USPTO

D A case not meeting requirement a

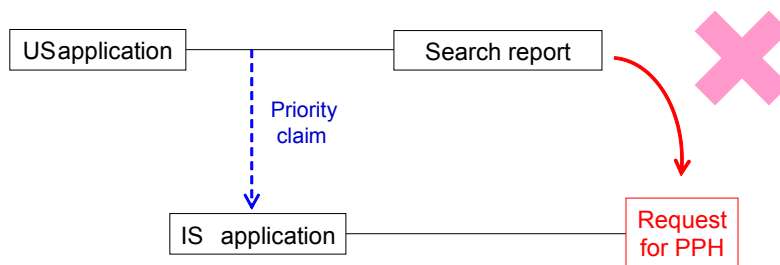
- PCT route, but the first application is from the third country -



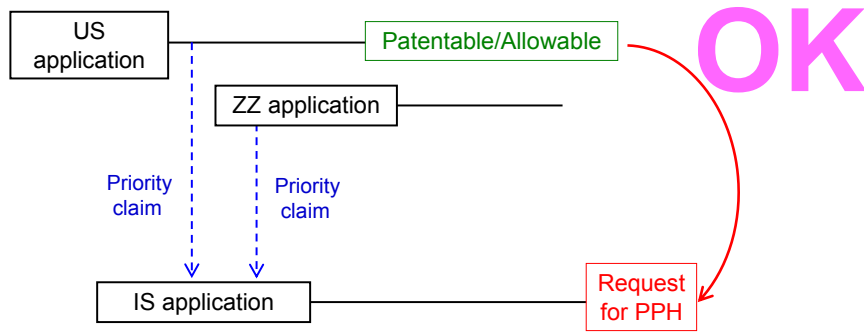
E A case not meeting requirement 1.1
 - PCT route, but the first application is from the third country -



E A case not meeting requirement b
 - Search report -

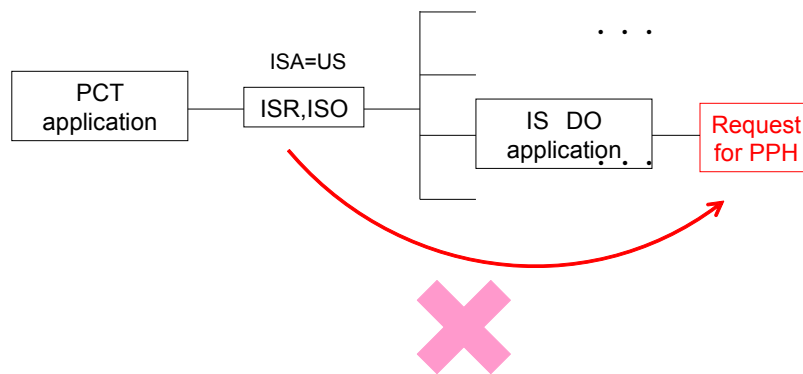


F A case meeting requirement 1.1(A)
- Paris route & Complex priority -

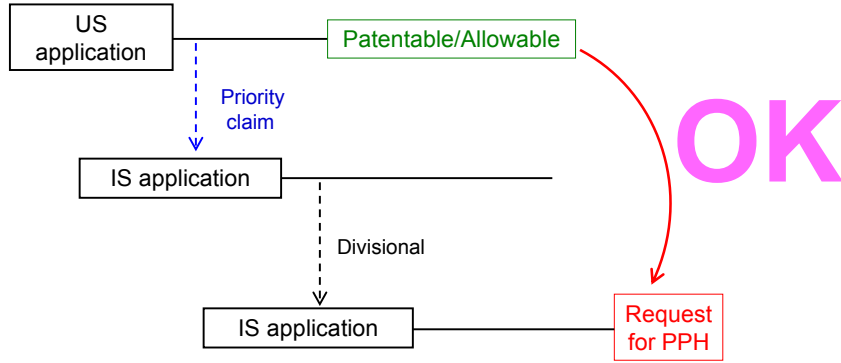


ZZ : any office

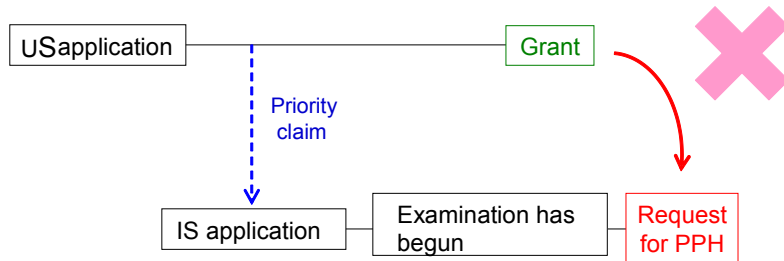
F A case not meeting requirement b
- ISR, ISO -



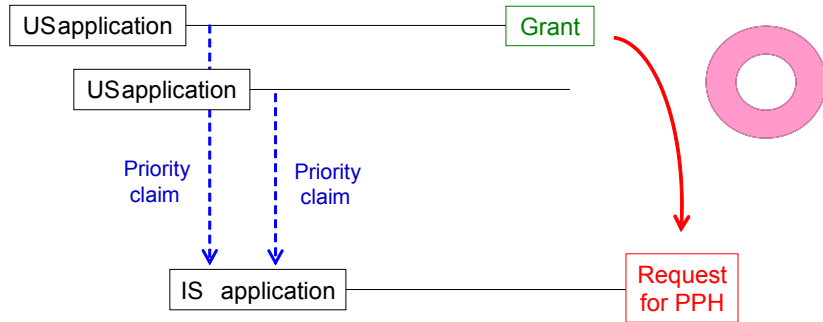
G A case meeting requirement 1.1(A)
- Paris route & divisional application -



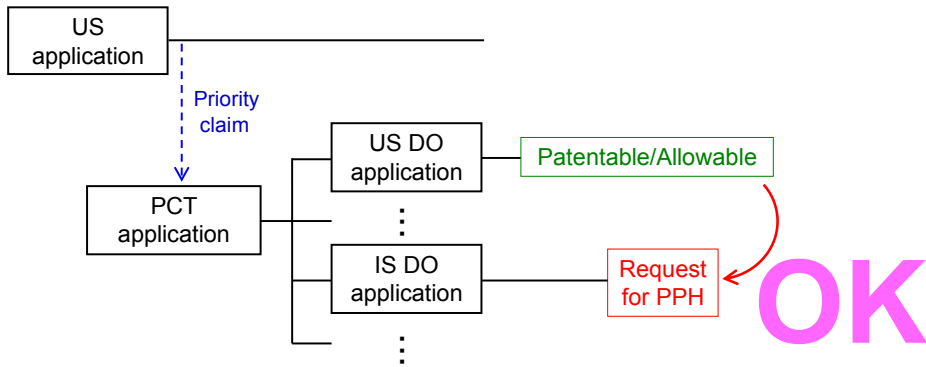
G A case not meeting requirement d
- Decision to grant a patent has issued before a request for PPH -

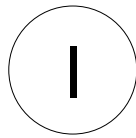


H A case meeting requirement a(i)
- Paris route & Complex -

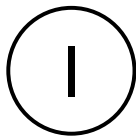
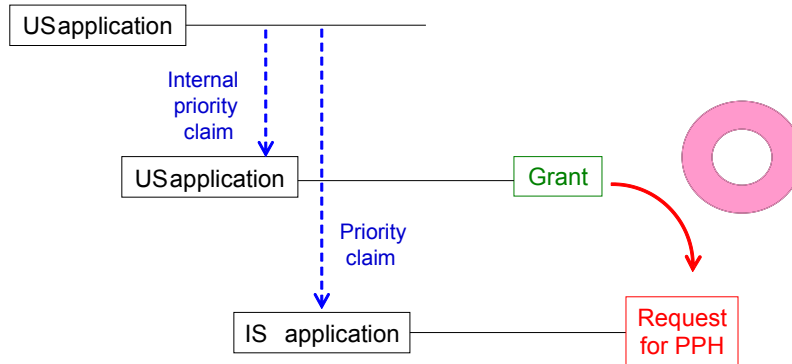


H A case meeting requirement 1.1(A)
- PCT route -

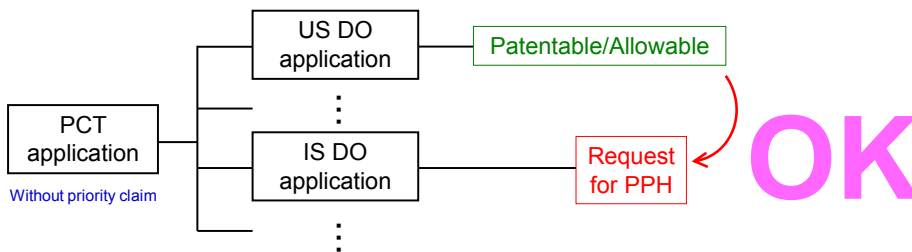




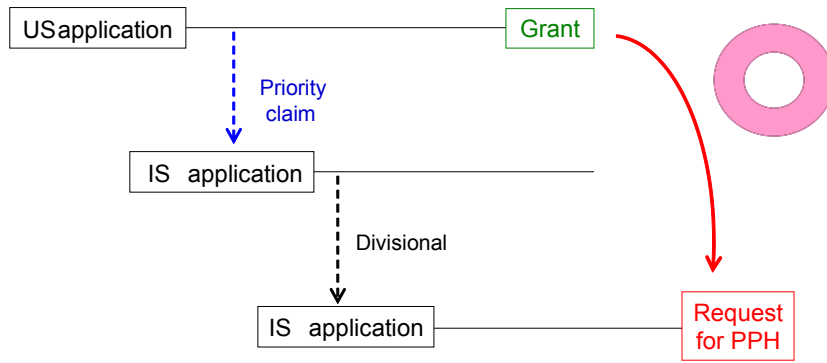
A case meeting requirement a(i) - Paris route & Internal priority -



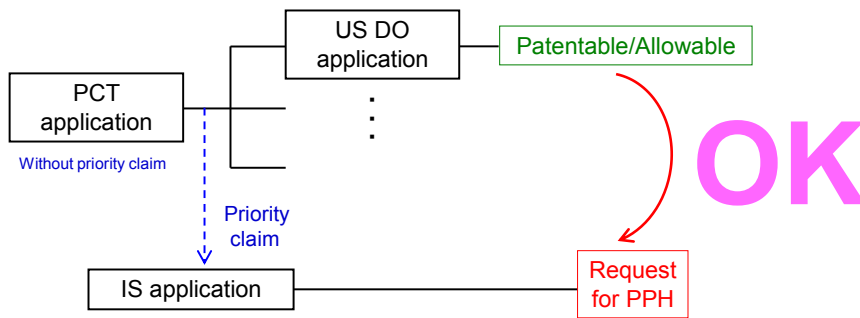
A case meeting requirement 1.1(B) - Direct PCT route -



J A case meeting requirement a(i)
- Paris route & divisional -

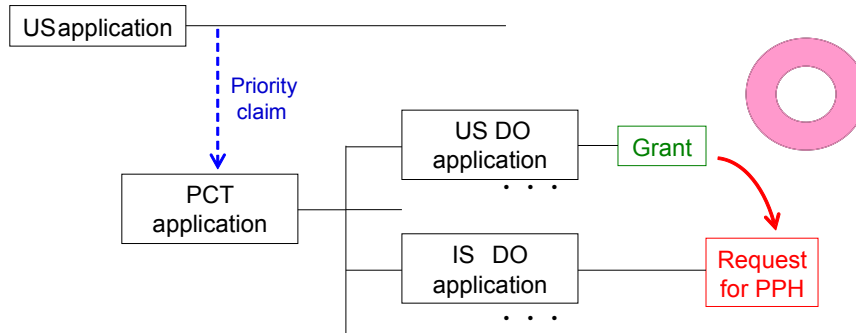


J A case meeting requirement 1.1(C)
- Direct PCT & Paris route -



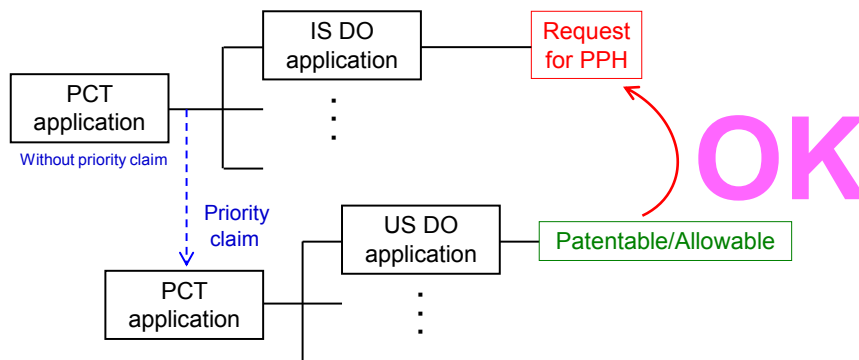
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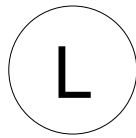
A case meeting requirement a(i) - PCT route -



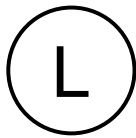
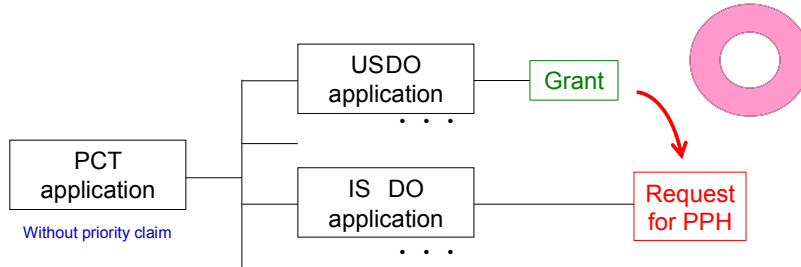
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A case meeting requirement 1.1(B) - Direct PCT & PCT route -

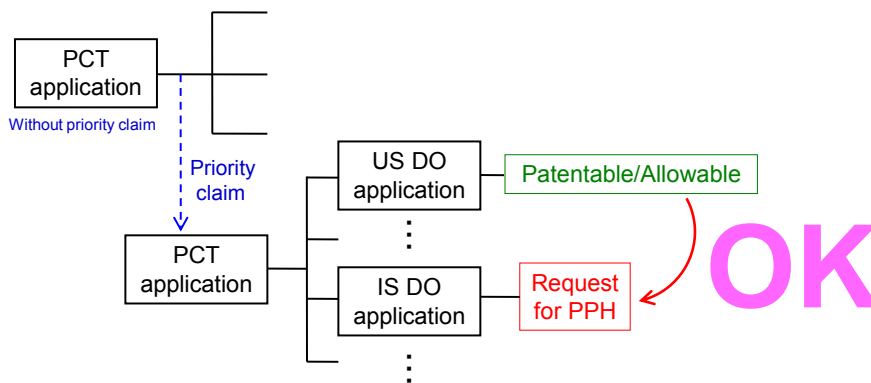




A case meeting requirement a(ii) - Direct PCT route -

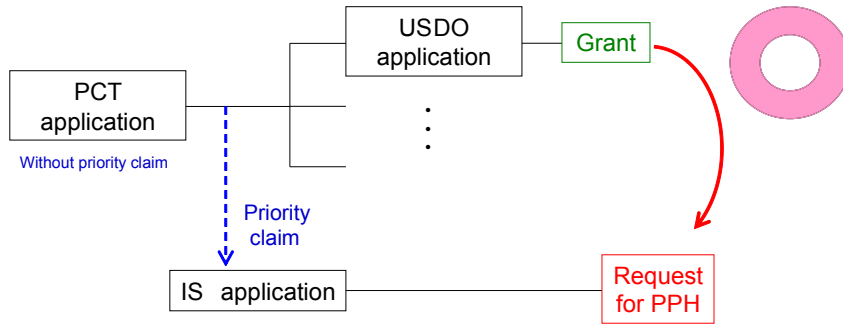


A case meeting requirement 1.1(C) - Direct PCT & PCT route -



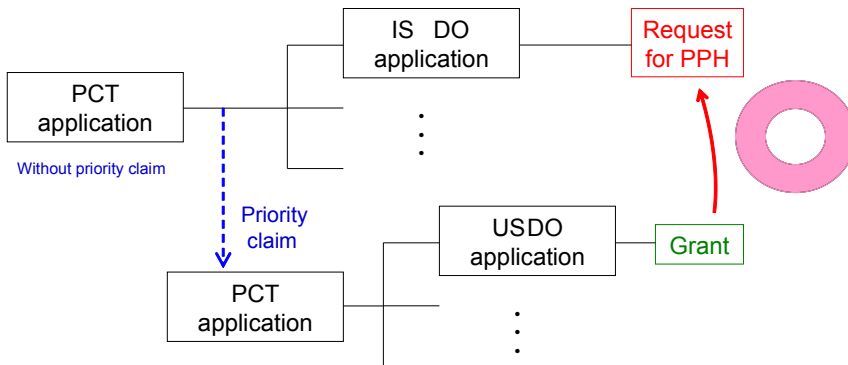
M

A case meeting requirement a(iii) - Direct PCT & Paris route -



N

A case meeting requirement a(iii) - Direct PCT & PCT route -



ANNEX 2**PPH REQUEST****Request for Accelerated Examination at the IPO under the Patent Prosecution Highway Pilot Program between the IPO and the USPTO**

- 1 IS application number:
Corresponding US application number(s):
- 2 **Either:**
a) Copy of USPTO office action(s) attached:
or
b) USPTO office action(s) on file from previous PPH request:
IS application number:
- 3 **Either:**
a) Copy of claims of corresponding US application attached:
or
b) US application claims on file from previous PPH request:
IS application number:
- 4 Claim correspondence table attached:
- 5 Copies of non-patent literature cited by USPTO examiners attached:

Please ensure that this is the uppermost document when requesting accelerated examination under the PPH.

