

Procedures to file a request to the SPTO for Patent Prosecution Highway Pilot Program between the SPTO (Spanish Patent and Trademark Office) and the CIPO (Canadian Intellectual Property Office)

Request to the SPTO

[0001] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the SPTO by submitting an application requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the SPTO for accelerated examination under the PPH are given in the following section. Relevant supporting documentation is discussed in a latter section (paragraphs [0003] to [0005]) as is the general SPTO application procedure envisaged at this time (paragraph [0006]).

Requirements for requesting an accelerated examination under the PPH Pilot Program at the SPTO

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

- a) Either:
 - i) the SPTO application validly claims priority under the Paris Convention from at least one corresponding CIPO application;
 - ii) the SPTO application is the national phase of a PCT application which has no priority claims, or
 - iii) the SPTO application is the national phase of a PCT application which validly claims priority from a CIPO national application, or
 - iv) the SPTO application claims priority from a PCT application which has no priority claims, or
 - v) the SPTO 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 SPTO application is a divisional application of any of the above.

Examples are provided in Annex 1.

- b) At least one corresponding CIPO application has one or more claims that are determined to be patentable/allowable by the CIPO.
- c) All the claims in the SPTO application must sufficiently correspond to one or more of those claims indicated as patentable/allowable by the CIPO in order to the SPTO application to qualify for accelerated examination under the PPH at the SPTO.

Claims are considered to 'sufficiently correspond' where, accounting for differences due to translations and claim format, the claims of the application are of the same or similar scope as the claims indicated to be patentable/allowable in the CIPO application, or the claims of the application are narrower in scope than the claims indicated to be patentable/allowable in the CIPO application.

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

A claim of the application which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the CIPO application is not considered to sufficiently correspond. For example, the claims indicated to be patentable/allowable in the CIPO application only contains claims to a process of manufacturing a product, then the claims of the SPTO application are not considered to sufficiently correspond if the claims of the SPTO 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 Pilot Program need not to sufficiently correspond to the claims indicated as patentable/allowable in the CIPO application.

Required documents for accelerated examination under the PPH Pilot Program at the SPTO

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

- a) a copy of all the office actions (which are relevant to the patentability) in the corresponding CIPO application(s), and translations of them. Office actions are documents which relate to substantive examination and which were sent to the applicant by the CIPO examiner. The applicant is required to provide these with the request for acceleration under the PPH.

Both Spanish and English are acceptable as translation language. 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 the CIPO and translations of them. The applicant is required to provide these with the request for acceleration under the PPH. Both Spanish and English are acceptable as translation language. 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 SPTO application for accelerated examination under the PPH and the claims of the corresponding CIPO application considered patentable/allowable by the CIPO. 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 SPTO application correspond to the patentable/allowable claims in the CIPO application. The claim correspondence table must be written in Spanish or English.

- d) copies of the references cited by the CIPO examiner. If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the SPTO. If the SPTO does not have access to relevant patent documents, the applicant must submit these documents at the request of the SPTO. Non-patent literature must always be submitted.

[0004] The relevant information is obtained from the applicant by filling out a form for requesting accelerated examination under the PPH Pilot Program (see Annex 2) which is available on the SPTO 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 SPTO through simultaneous or past procedures.

Procedure for accelerated examination under the PPH Pilot Program at the SPTO

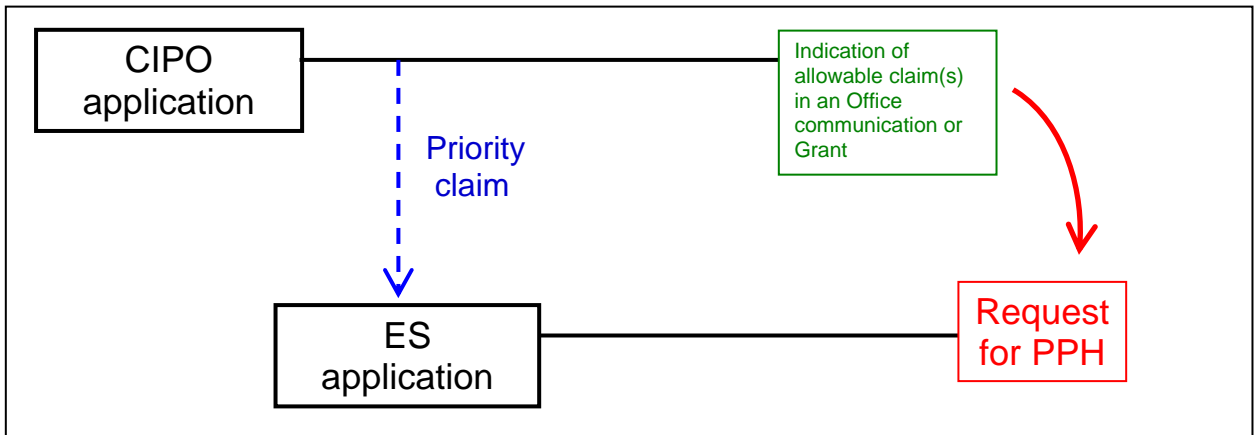
[0006] The applicant fills out the form requesting accelerated examination under the PPH Pilot Program available on the SPTO web page and includes all the relevant supporting documents. The PPH Administrator, who will be an SPTO patent examiner, will consider the request. Where all the requirements for accelerated examination under the PPH have not been met, the PPH Administrator will notify the applicant that the application has not been allowed entry on to the PPH and will provide an explanation as to why entry on to the PPH was not possible. The applicant is free to take any possible correcting action necessary and again requesting acceleration under the PPH.

Where all of the requirements for accelerated examination under the PPH have been met, the PPH Administrator will notify the applicant that the application has been allowed entry on 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.

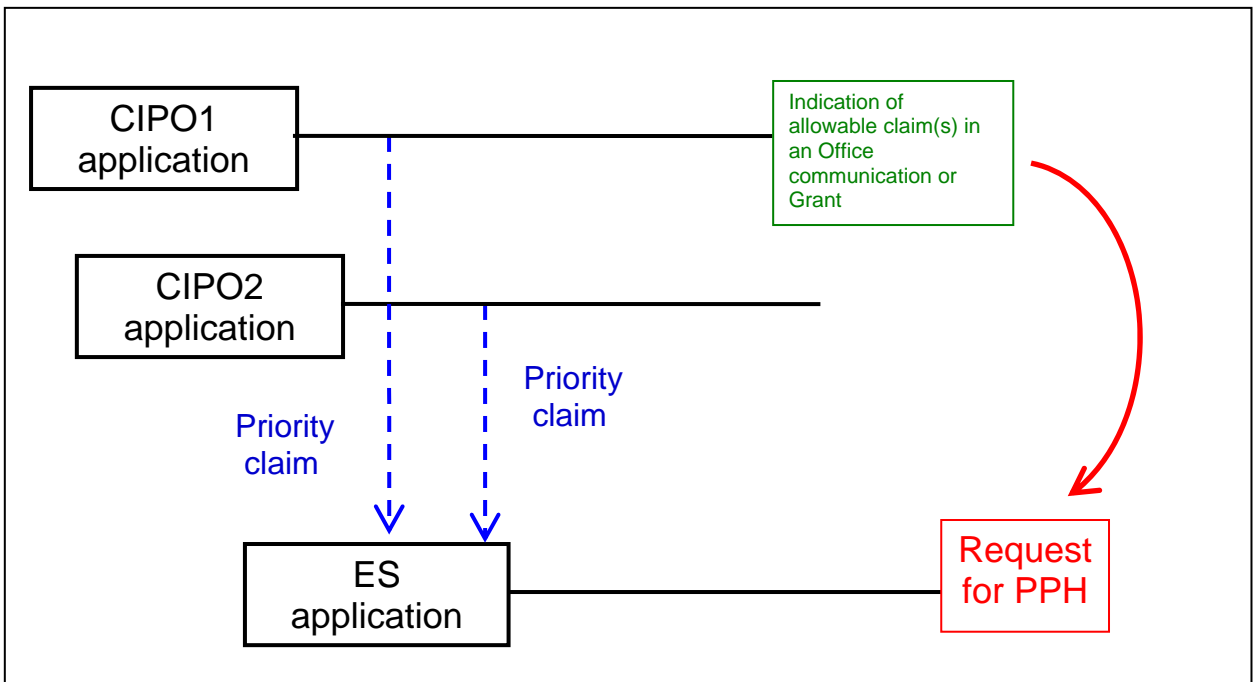
If the request for accelerated examination is not granted, the applicant will be notified that the application will await action in its regular turn.

ANNEX 1

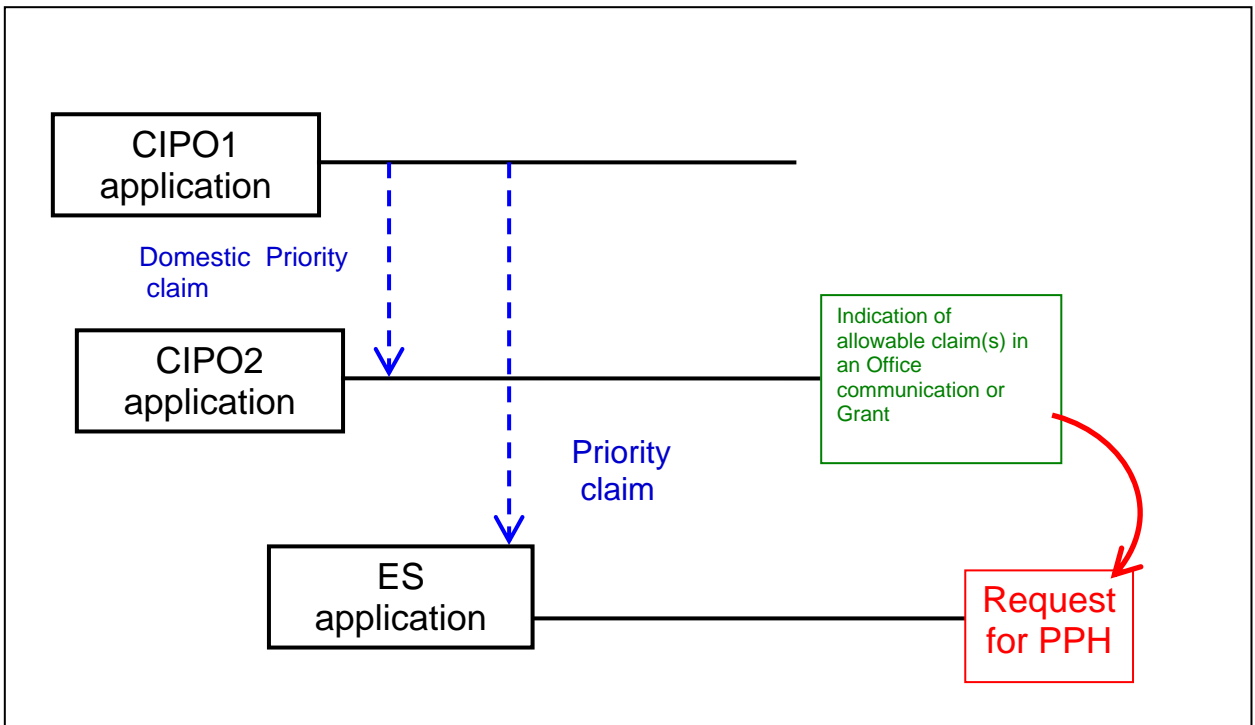
- ES application with single Paris Convention priority claim to an application filed in Canada



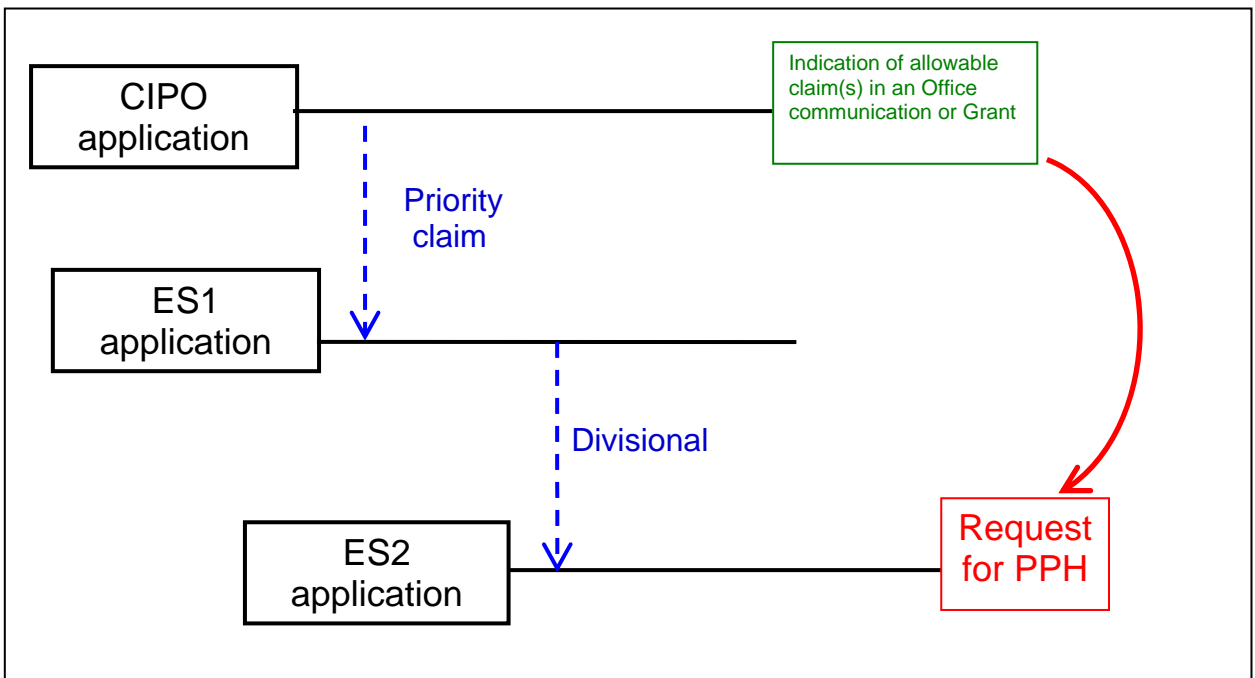
- ES application with a complex Paris Convention priority



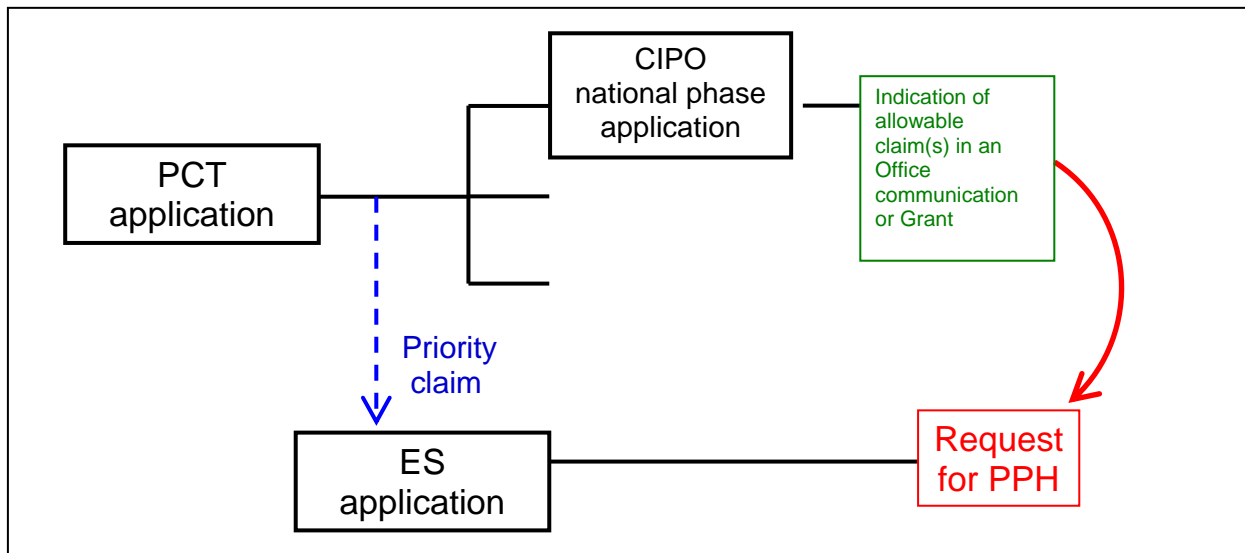
- Paris route and priority



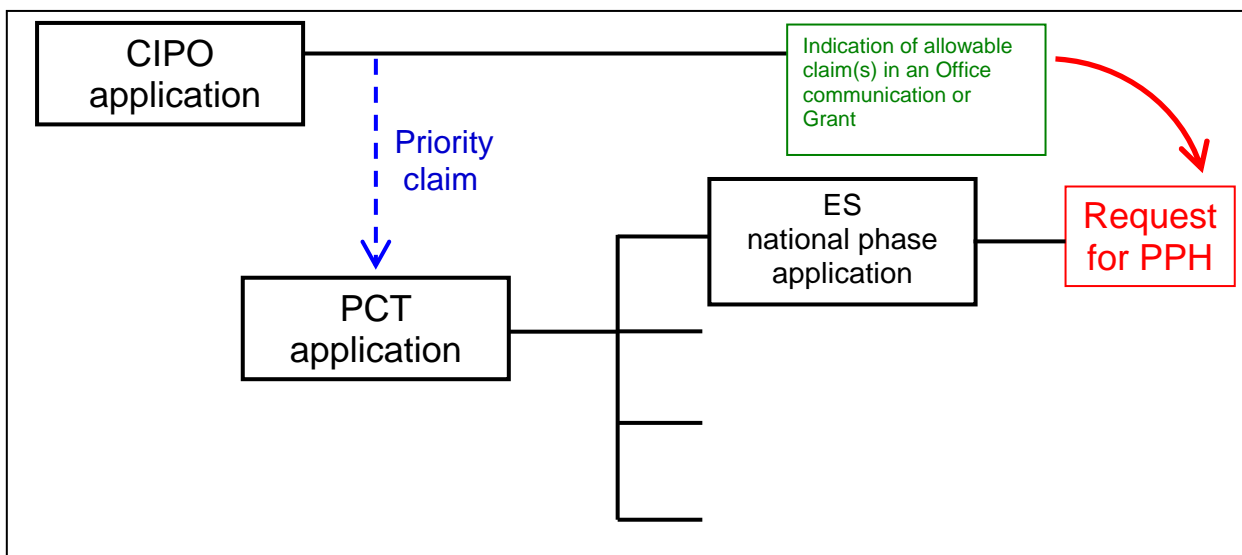
- Paris route and divisional application



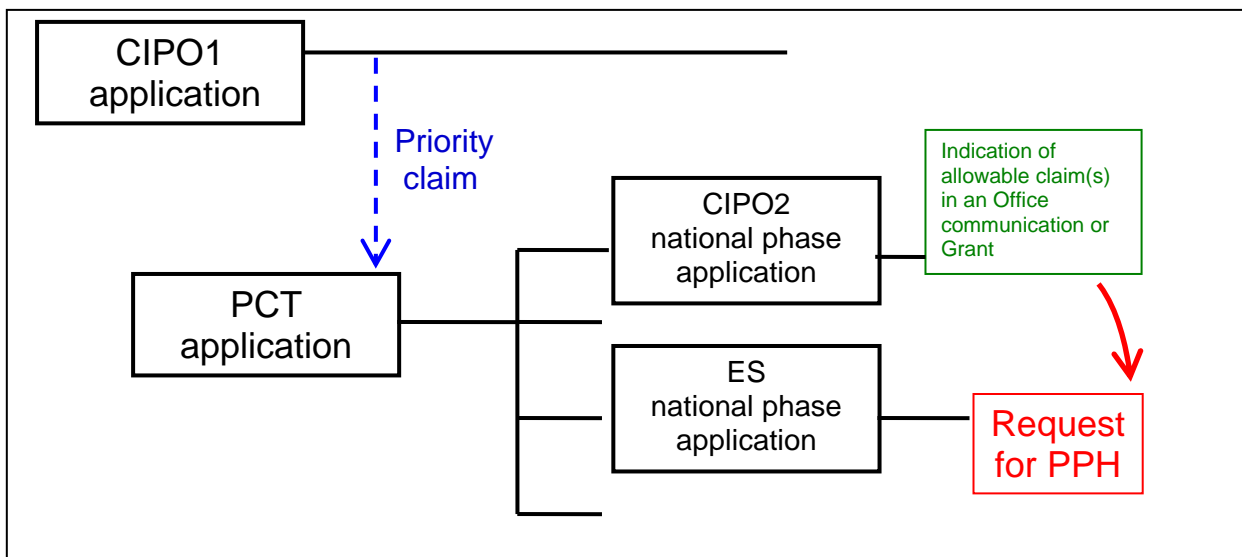
- ES application claims Paris Convention priority to a PCT application



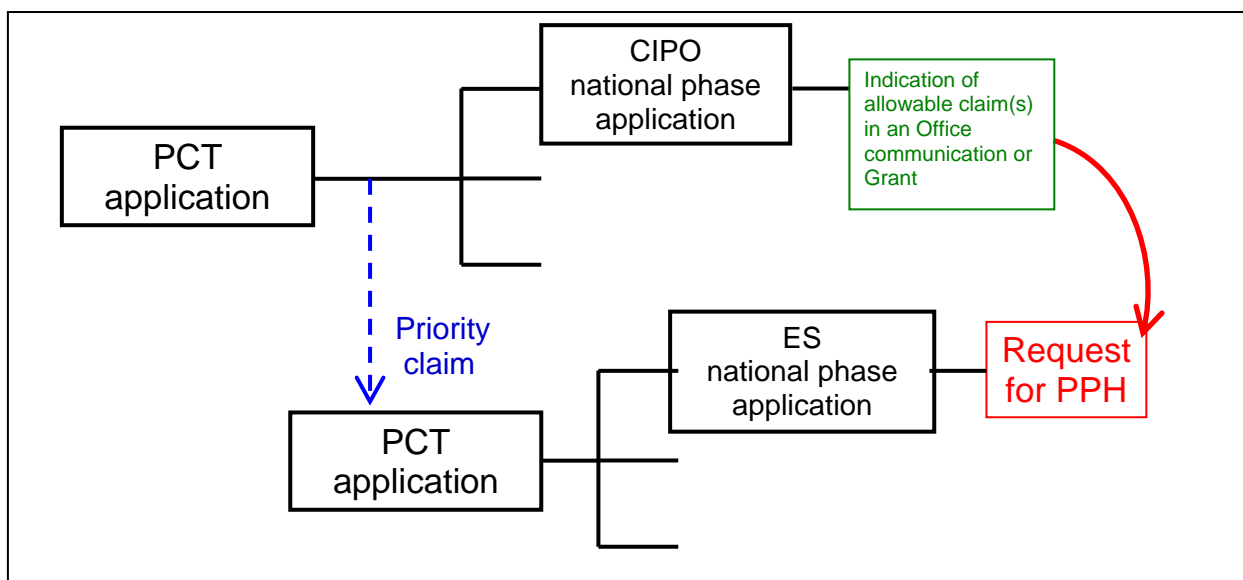
- ES application is a national stage of a PCT application which claims Paris Convention priority to a CIPO application



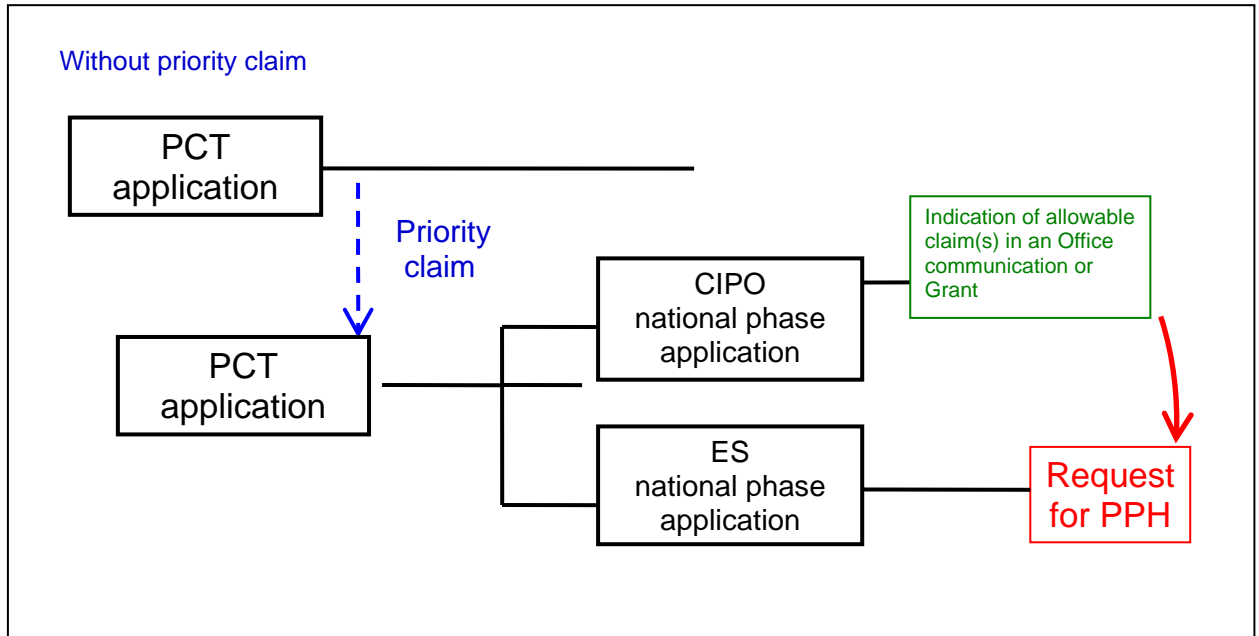
- PCT Route



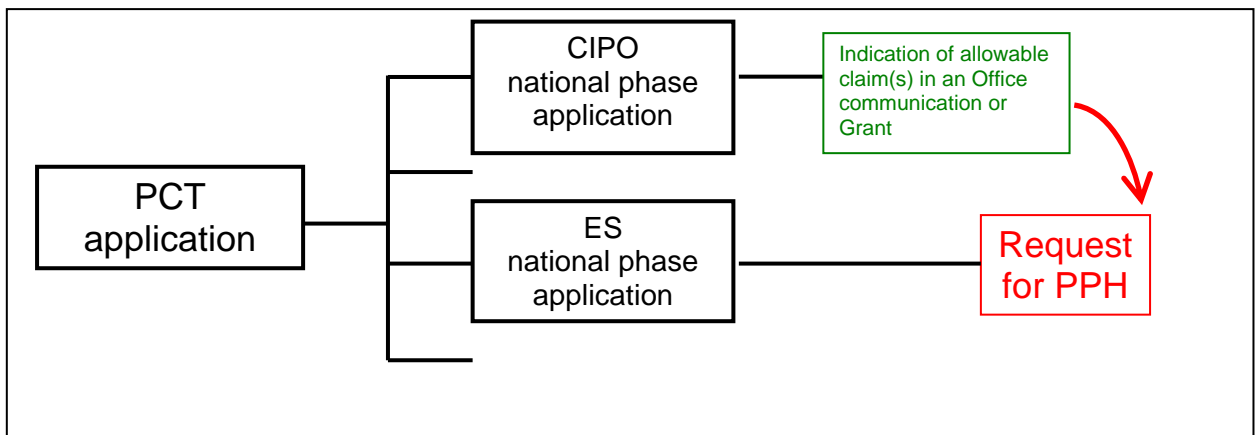
- ES application is a national stage of a PCT application which claims Paris Convention priority to another PCT application



- Direct PCT and PCT Route



- ES application is a national stage of a PCT application without priority claim



ANNEX 2

PPH REQUEST

Request for Accelerated Examination at the Spanish Patent and Trademark Office (SPTO) under the Patent Prosecution Highway Pilot Program. PPH using national work products.

Application information

SPTO application number:

Office of First Filing (hereinafter OFF):

JPO USPTO CIPO

Corresponding OFF application or publication number(s):

Relevant supporting documents

List of Required Documents. Please, tick the boxes below:

1. Either:

1.1. A copy of all the office actions (which are relevant to the patentability) in the above-identified OFF application(s) is attached.

or

1.2. SPTO to obtain the office actions from the OFF data base, where there exists such a data base.

2. Either:

2.1. A copy of all claims which were determined to be patentable/allowable by the OFF in the above-identified OFF application(s) is attached.

or

2.2. SPTO to obtain the set of patentable/allowable claims from the OFF data base, where there exists such a data base.

3. Either:

3.1. Translations into Spanish or English of the documents in 1 and 2 are attached.

or

3.2. SPTO to obtain the translations from the OFF data base, where there exists such a data base.

4. Copies of the documents referred by the OFF Examiner are attached. Patent literature is not necessary to be submitted. Non-patent literature must always be submitted.

□

5. Incorporation by reference. If you want to incorporate any of the above mentioned documents please provide now all the necessary data:

□

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Claim correspondence table completed

Claim correspondence table

SPTO claims	Corresponding OFF claims	Comments explaining the correspondence

The applicant does request, if applicable to the circumstances of the present case, the early publication of the patent application according to Article 32(3) Spanish Patent Law.