

**Procedures and Requirements for Filing a Request for Patent Prosecution
Highway Pilot Program (PPH) to the National Institute of Industrial Property
(INPI) in Argentina.**

I. Background

These presents are subscribed by the parties within the scope of the PPH Pilot Program agreed upon by and between the National Institute of Industrial Property of the Argentine Republic (INPI) and the Japan Patent Office (JPO) pursuant to the “Joint Statement of Intent for Cooperation in Patent Prosecution Procedures” signed in Geneva on October 5, 2016 by the representatives of the above mentioned entities.

The PPH Pilot Program was established so that, once the Office of Earlier Examination (OEE) has determined patentability of an application, the applicant may request the benefit of accelerated examination of the corresponding application at the Office of Later Examination (OLE), provided that the requirements set forth herein are fulfilled.

This document is intended to define in detail the necessary procedures and requirements for requesting application of the PPH Pilot Program between the INPI and the JPO.

The INPI and the JPO will publish this guideline as well as the necessary forms for requesting

participation in the PPH Pilot Program.

The PPH Pilot Program between the JPO and the INPI shall become effective on April 1, 2017 for a trial period of 3 years. The JPO and the INPI will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period.

Participating offices may terminate the PPH pilot program if the participation volume exceeds the manageable level or for any other reason. Prior notice shall be published when the PPH pilot program is terminated..

1. Requirements for Filing Request to INPI for Patent Accelerated Examination under the PPH Pilot Program..

In order to be eligible to participate in the PPH Pilot Program, the following requirements shall be fulfilled:

(a) Both the INPI application on which PPH is requested and the JPO application being the basis of the PPH request shall be corresponding applications (See examples in ANNEX II) having the same earliest date (either a priority date or a filing date).

Applicant shall submit the necessary information to determine the relationship between the application on which the accelerated examination is requested and the corresponding application(s) filed with the JPO.

The expression “corresponding patent applications” should not be necessarily construed as referred to the application on which a priority claim is based, but it could refer to the application derived from the application on which priority is claimed. For example, a divisional application of the application or an application claiming national priority of the application on which priority is claimed.

For example, the INPI application may be:

(Case I) an application which validly claims priority under the Paris Convention based on the JPO application(s), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the JPO application(s), or

(Case III) an application which shares a common priority document with the JPO application(s).

The pilot program is not applicable on the basis of JPO applications for “utility model”.-.

(b) The corresponding application has been substantively examined by the JPO

and has one or more claims considered as patentable/allowable by the JPO

Claims considered patentable/allowable shall be expressly identified as such in the granted patent or in the Office action issued by the JPO and they will be the basis for the request for participation in the PPH program, notwithstanding the fact that the application including said claims has not yet been granted patent. The Office action may be:

(a) Decision to Grant a Patent

(b) Notification of Reasons for Refusal

(c) Decision of Refusal

(d) Appeal Decision

For example, if the following routine expression is described in the “Notification of Reason for Refusal” of the JPO, those claims are clearly identified to be patentable/ allowable.

“<Claims which has been found no reason for refusal>

At present for invention concerning Claim___, no reason for refusal is found.”

(c) In order to be examined pursuant to PPH, all the application claims, either as originally filed or as amended, shall sufficiently correspond to one or more of

those claims indicated as allowable by the JPO so that the INPI application may be then allowed for accelerated examination under the PPH Pilot Program. .

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Claims are considered to "sufficiently correspond" when, considering differences due to translation and/or claim format, the scope of claims in the INPI application is the same as or narrower than that of claims in the JPO application.

In this regard, a claim that is narrower in scope occurs when a JPO 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 INPI application which introduces a new/different category of claims to those claims indicated as allowable by the JPO shall not be considered to sufficiently correspond.

For example, where the JPO claims only contain claims on a process of manufacturing a product, then, if the INPI claims introduce product claims that are dependent on the corresponding process claims, the INPI claims shall not be considered to sufficiently correspond.

Any claims amended or added after the request for participation in the PPH pilot program is allowed but before examination by the INPI Examiner must sufficiently correspond to the

claims indicated as allowable by the JPO in order to benefit from the PPH accelerated examination.

(d) The INPI has not begun substantive examination of the application at the time the PPH is requested.

(e) The patent application filed with the INPI must have been published, the term for third party objections must have been expired and the substantive examination fee must have been paid.

2. Documents to be submitted with INPI for Accelerated Examination under PPH

Pilot Program.

The request form for INPI accelerated examination within the PPH pilot program shall include the following documents:

(a) Copies of all Office actions (relevant to substantive examination for patentability at the JPO), which were issued in the corresponding application by the JPO, and their translation.

The applicant does not have to submit a copy of the JPO office actions and translations of them when those documents are provided via AIPN (JPO's dossier access system)

because the office actions and their machine translations are available for the INPI examiner via the AIPN. If they cannot be obtained by the INPI examiner via the AIPN, the applicant may be notified and requested to provide the necessary documents. Either Spanish or English is acceptable as translation language.

(b) Copies of all claims determined as patentable/allowable by the JPO and their translation.

The applicant does not have to submit a copy of claims indicated to be patentable/allowable in the JPO and translations of them when those documents are provided via AIPN (JPO's dossier access system) because the claims and their machine translations are available for the INPI examiner via the AIPN. If they cannot be obtained by the INPI examiner via the AIPN, the applicant may be notified and requested to provide the necessary documents. Either Spanish or English is acceptable as translation language.

(c) Copies of references cited as relevant by the JPO examiner

If references are patent documents, the applicant should not submit them because they are generally available to the INPI. When a patent document is not available to the INPI examiner, the applicant must submit it at the examiner's request. Non-patent literature

must always be submitted and, if necessary, accompanied by their respective translation

When the applicant has already submitted above documents (a) to (c) to the INPI through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

(d) Claim Correspondence Table.

The applicant requesting the PPH must submit a claim correspondence table, which will indicate how all claims in the INPI application sufficiently correspond to the patentable/allowable claims in the JPO application.

When claims are just a literal translation, the applicant may only indicate that “they are the same” in the table. When claims are not just a literal translation, the sufficient correspondence of each claim must be explained.

3. Procedure for Filing a Request to the INPI for Accelerated Examination under

PPH Pilot Program

The applicant must file the request form for accelerated examination under PPH pilot program, as per the sample described in Section 4 of this guideline and available from the INPI web site. The applicant must submit all relevant supporting documents.

When the request for participation in the PPH pilot program complies with all the above requirements, it will be accepted and the INPI patent application may be advanced out of turn for examination, provided it complies with the publication established in Article 26 of the LP and upon expiration of the period for third parties observations referred to in Article 28 of the LP.

When the request for participation in the PPH pilot program does not comply with the requirements set forth above, such request will be rejected and the applicant will be notified of the defects found in the request. The applicant will be then given only one opportunity to correct the defects that led to said rejection and file a new request for participation in the PPH pilot program.

The INPI will not notify the applicant of the acceptance for assigning a special status for accelerated examination under the PPH.

Acceptance of the request for participation in the PPH pilot program granted in a parent patent application will not carry over to its divisional application(s). In fact, the applicant must file a new request for participation in the PPH pilot program for divisional application(s) and meet all the same requirements as set forth above.

All correspondence or notices related to the accelerated examination procedures and submitted to the INPI must be clearly identified as related to a PPH request in order to

ensure that they are properly processed. To that effect, the cover page of the respective brief must include a heading clearly identifying the application and the “PPH” initials in an outstanding pattern.

It is recommended that when requesting accelerated examination under the PPH program, applicants should not only focus on the claims but on the application as a whole.

The applicant must review the whole application and make the necessary amendments in order to avoid inconsistencies in the information contained, without adding any features to the originally filed subject-matter.

It is to be noted that all amendments to the application to be examined under the PPH program will be entered regardless of whether the request for participation in the PPH pilot program is accepted or not.

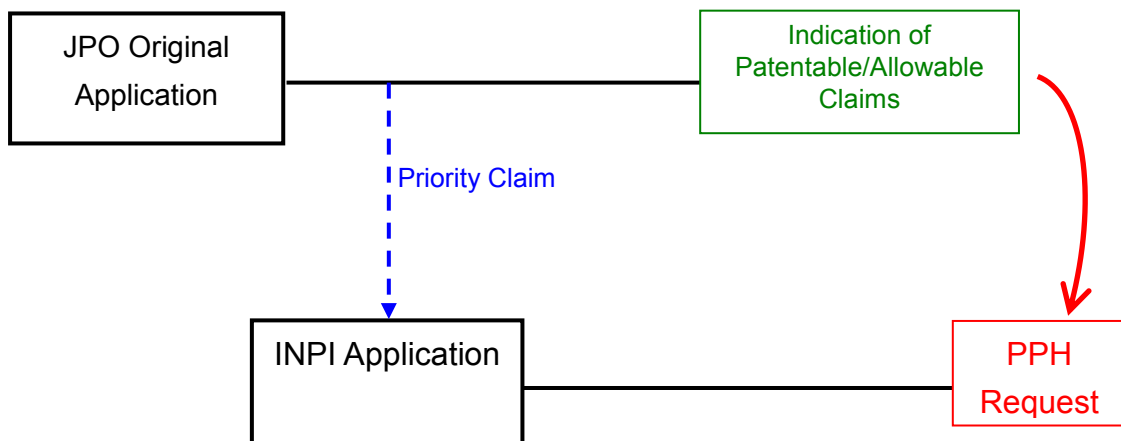
The PPH program does not exempt applicants from their duties under patent laws and legislation in force in the country where the request is submitted. The applicant must act in good faith and furnish information to the INPI about any document considered relevant to patentability assessment.

ANNEX I

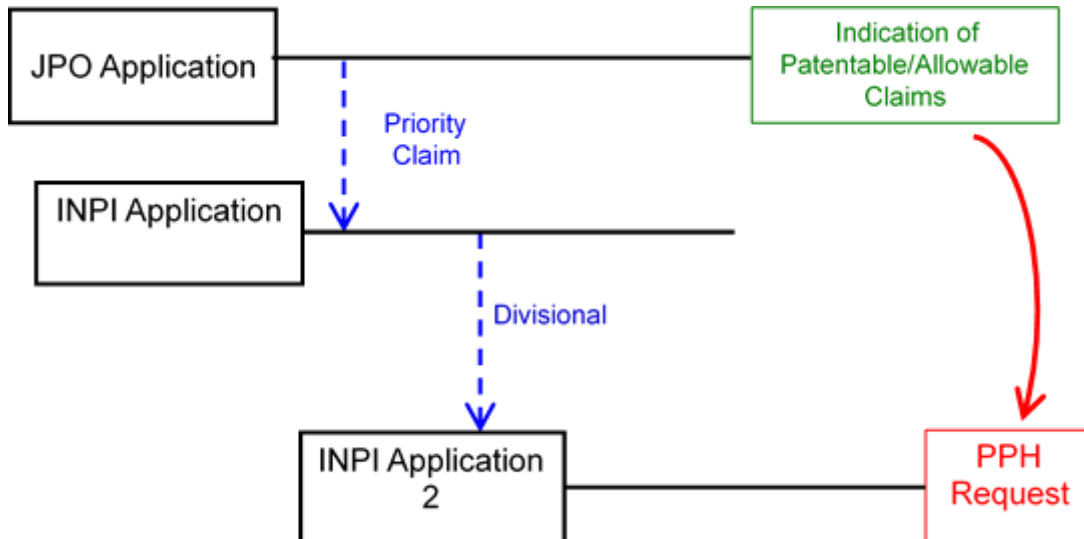
Examples of Argentine Patent Applications for which Accelerated Examination can be requested under the PPH Pilot Program.

The following examples refer to the JPO y INPI (this latter being the office to which participation in PPH pilot program is requested.)

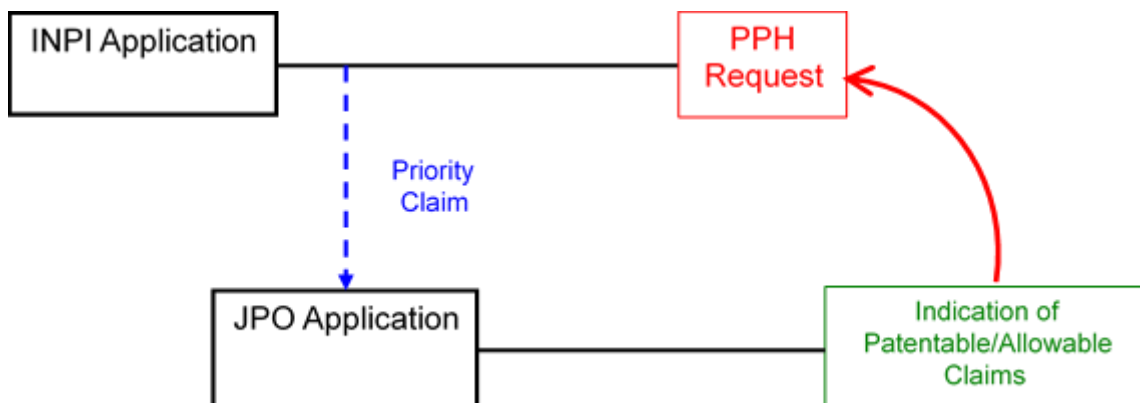
Example A, Paris Route



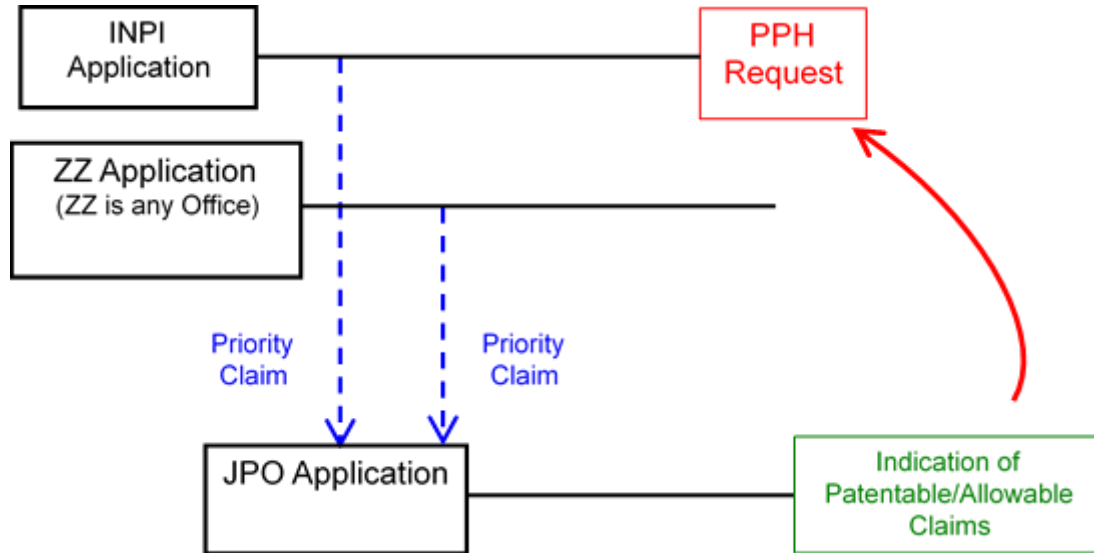
Example B, Paris Route and Divisional Application.



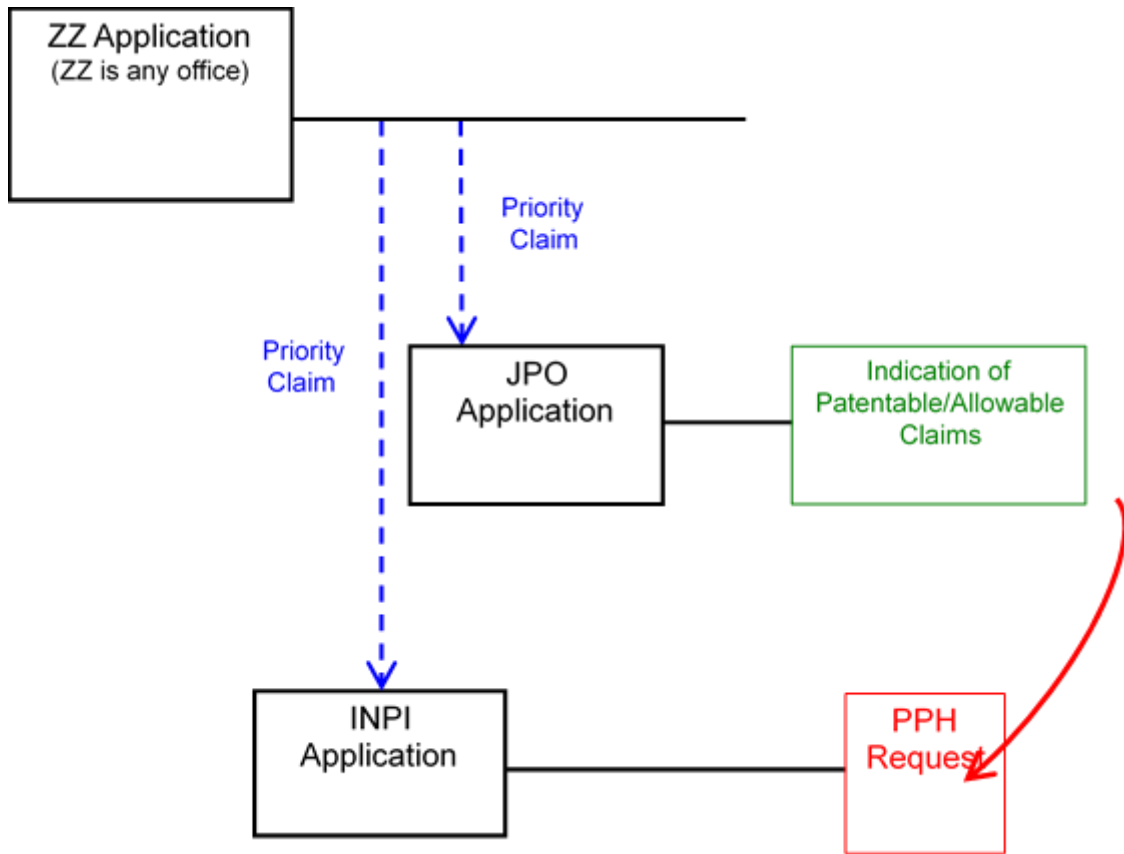
Example C, Paris Route.



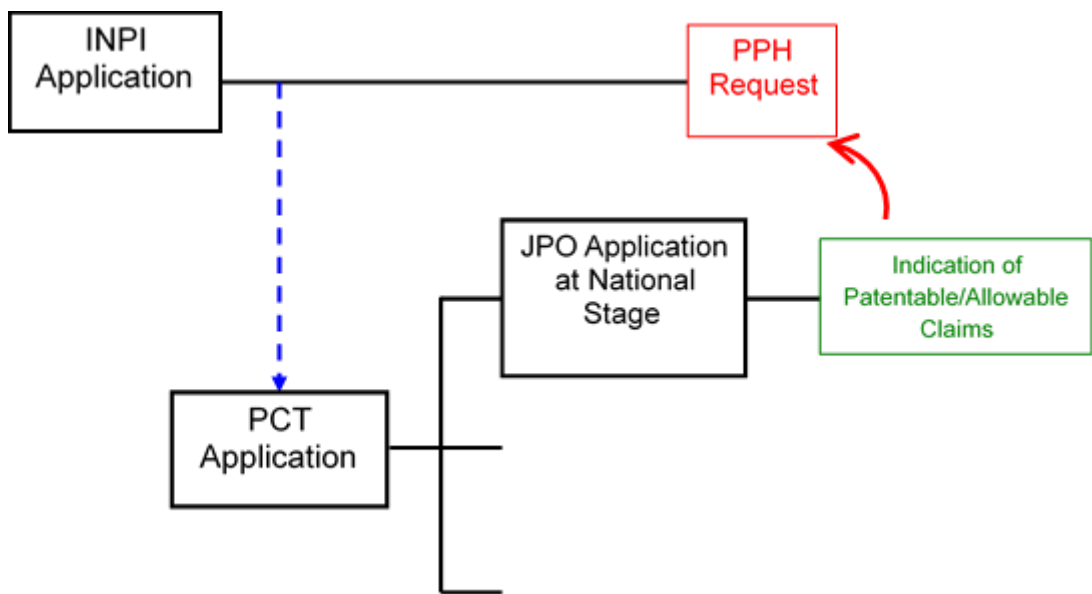
Example D, Paris Route.



Example E, Paris Rout, but First Application is from a Third Country.



Example F, Paris route and via PCT



ANNEX II

Examples of Cases considered to “Sufficiently Correspond” and Cases not considered to “Sufficiently Correspond”.

1. Claims in the following cases (case 1 to 4) are considered to “sufficiently correspond”:

Case	“Patentable/Allowable” Claims		INPI Claims		Comment
	No.	Content	No.	Content	
Case 1	1	A	1	A	Claim 1 in INPI application is the same as the “patentable/allowable” claim 1.
Case 2	1	A	1 2	A A+a	Claim 1 in INPI application is the same as “patentable/allowable” claim 1. Claim 2 in INPI application is created by adding a technical feature described in the specification to “patentable/allowable” claim 1.
Case 3	1 2 3	A A+a A+b	1 2 3	A A+b A+a	Claim 1 in INPI application is the same as “patentable/allowable” claim 1. Claims 2, 3 in INPI application are the same as “patentable/allowable” claims 3, 2, respectively.
Case 4	1	A	1	A+a	Claim 1 in INPI application has an additional technical feature

					"a" described in the specification.
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2. Claims in the following cases (cases 5 to 7) are NOT considered to "sufficiently correspond":

Case	"Patentable/Allowable" Claim(s)		Claim(s) in INPI application		Comment
	No.	Content	No.	Content	
Case 5	1	A Product	1	A' Method	Claim 1 in INPI application defines a method while "patentable/allowable" claim 1 defines a product. The technical feature of the "patentable/allowable claim" is the same as in the INPI claim but they have different categories.
Case 6	1	A+B	1	A+C	Claim 1 in INPI application is different from "patentable/allowable" claim 1 as to a component of the invention claimed. The INPI claim is created by changing part of the technical features of the "patentable/allowable" claim.
Case 7	1	A+b	1	A	Claim 1 in INPI application is different from

					<p>“patentable/allowable” claim 1 as to a component of the invention claimed.</p> <p>The INPI claim is broader than the “patentable/allowable” claim.</p>
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