

# **Procedures to file a request to the NBPR (National Board of Patent and Registration of Finland) for Patent Prosecution Highway Pilot Program between the JPO (Japan Patent Office) and the NBPR**

## **Background**

National Board of Patent and Registration of Finland (NBPR) and Japan Patent Office (JPO) implemented a Patent Prosecution Highway (PPH) pilot program on 20 April, 2009.

Under the current PPH scheme, the Office of first filing (OFF) has to provide its examination results before any of the other offices accept PPH requests. This principle puts a restriction on making PPH requests and prevents subsequent offices from fully utilizing the results of examinations conducted in the other offices, due to the fact that the OFF does not always conduct the examinations before the Office of second filing (OSFs) do theirs.

In order to improve the PPH program and make it available to a wider range of applicants, the NBPR and the JPO have agreed to revise the requirements for requesting participation in the PPH pilot program. The revised requirements and the trial period are set forth below and supersede all prior PPH notices between the NBPR and the JPO.

Under the PPH MOTTAINAI Pilot, an applicant can make PPH requests at the Office of Later Examination (OLE) by using the examination results of the Office of Earlier Examination (OEE), provided that the OEE and OLE have a PPH MOTTAINAI agreement.

The PPH MOTTAINAI pilot will commence on 15 July, 2011, for a period of one year ending on 14 July 2012. The pilot period may be extended if necessary. The offices will bilaterally determine whether and how the program should be fully implemented at the end of the pilot period.

## **Part I**

### **PPH using the national work products from the JPO**

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the NBPR and satisfies the following requirements under the NBPR-JPO Patent Prosecution Highway pilot program based on the JPO application.

When filing a request for the PPH pilot program, an applicant must submit a request form,

which is available online at the NBPR PPH website at <http://www.prh.fi/en/patentit/pph.html>.

## **1. Requirements**

- (a) Both the NBPR application on which PPH is requested and the JPO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).**

For example, the NBPR application (including PCT national phase application) may be either:

- (Case I) an application which validly claims priority under the Paris Convention from the JPO application(s) (examples are provided in ANNEX I, Figure A, B, C and D),  
or  
(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the JPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figure E, F and G), or  
(Case III) an application which shares a common priority document with the JPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figure H, I, J, K and L), or  
(Case IV) a PCT national phase application where both the NBPR application and the JPO application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX I, Figure M).

The NBPR application, which validly claims priority to multiple JPO or PCT applications, or which is the divisional application validly based on the originally filed application that is included in (I) to (IV) above, is also eligible.

- (b) At least one corresponding application exists in the JPO and has one or more claims that are determined to be patentable/allowable by the JPO.**

Claims clearly identified to be patentable/allowable in the latest office action at examination stage can form the basis of a request for an accelerated examination under the PPH pilot program. This is the case even though the JPO has not yet granted a patent for those claims if the JPO examiner has added the following routine expression in the “notice of reason for refusal”:

*“At present for invention concerning Claim\*, no reason for refusal is found. Any subsequently identified reasons for rejection will be notified accordingly.*

- (c) 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 JPO.**

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

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 NBPR which introduces a new/different category of claims to those claims indicated as allowable in the JPO is not considered to sufficiently correspond. For example, if the JPO claims only contain claims to a process of manufacturing a product, then the claims in the NBPR are not considered to sufficiently correspond if the NBPR claims introduce product claims that are dependent on the corresponding process claims.

- (d) The NBPR has not yet issued a communication "Communication of Approval" (The heading of the communication is "Hyväksyvä välipäätös").**

**2. Documents to be submitted**

The following documentation (a) to (d) below will be needed to support a request for accelerated examination under the PPH pilot program at the NBPR:

- (a) Copies of all office actions<sup>1</sup> in the JPO, which were sent for the corresponding application by the JPO, and translations of them<sup>2</sup>.

Both Finnish and English are acceptable as translation language. An applicant who requests an accelerated examination under the PPH pilot program to the NBPR does not have to submit copies of office actions when those documents are provided via AIPN.

- (b) Copies of all claims determined to be patentable/allowable by the JPO, and translations of them<sup>2</sup>.

Both Finnish and English are acceptable as translation language. The descriptions above in requirement (2)(a) - regarding the occasions where the applicant is not required to submit copies and translations and regarding machine translations - also

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<sup>1</sup> Office actions are documents which relate to substantive examination.

<sup>2</sup> Machine translations will be 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.

applies to this requirement (2)(b).

(c) Copies of references cited by JPO examiner

If the references are patent documents, the applicant doesn't have to submit them because the NBPR usually possess them. When the NBPR does not possess the patent document, the applicant has to submit the patent document at the examiner's request. 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.

(d) Claim correspondence table

Applicant must submit a claim correspondence table, which indicates how all claims in the NBPR application sufficiently correspond to the patentable/allowable claims in the JPO application.

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 (1) (c).

When the applicant has already submitted above documents 2.(a) to 2.(d) to the NBPR through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

The applicant is required to complete a form for requesting accelerated examination under the PPH pilot program (Please refer to the **Example form** below on page 5) which will be available for download from the NBPR website (<http://www.prh.fi/en/patentit/pph.html>). The form must be sent to the NBPR along with a letter requesting acceleration under the PPH and the relevant supporting documentation.

The applicant need not provide further copies of documentation if they have already submitted the documents noted above to the NBPR through simultaneous or past procedures.

**Procedure for accelerated examination under the PPH pilot program at the NBPR**

The applicant files a letter requesting accelerated examination under the PPH pilot program to the NBPR, including the relevant supporting documents and a completed request form.

The PPH Administrator, who will be an NBPR patent examiner, will consider the request. If the requirements for accelerated examination under the PPH are not met, the PPH Administrator will notify the applicant that the application has not been allowed entry to the PPH and will provide an explanation as to why entry to the PPH was denied. The applicant is free to take any possible correcting action necessary and again request acceleration under the PPH. If all requirements for accelerated examination under the PPH are met, the PPH Administrator will notify the applicant that the application has been allowed entry 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.

**EXAMPLE FORM**

**PPH REQUEST**

Request for Accelerated Examination at the NBPR Under the Patent Prosecution Highway Pilot Program Between the NBPR and the JPO

1. FI application number:

Corresponding JP application number(s):

2. **Either:**

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

**and**

Copy of translated JPO office action(s) attached

**or**

b) JPO office action(s) available on AIPN:

**or**

c) JPO office action(s) on file from previous PPH application:  
FI application number:

3. **Either:**

a) Copy of claims of corresponding JP application attached:

**and**

Copy of translated claims of corresponding JP application attached: **or**

b) Claims of corresponding JP application available on AIPN:

**or**

c) JP application claims on file from previous PPH application:  
FI application number:

4. Translation version of foreign language citation attached

*(Please note that it is not necessary to provide translation of documents. However, applicant will be free to file translations to allow prompt consideration of the citations if they so desire.)*

5. Claim correspondence table completed:



## **Part II**

### **PPH using the PCT international work products from the JPO**

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the NBPR and satisfies the following requirements under the NBPR-JPO Patent Prosecution Highway pilot program based on PCT international work products (PCT-PPH pilot program).

The Offices may terminate the PCT-PPH pilot program early if the volume of participation exceeds manageable level, or for any other reason. Notice will be published if the PCT-PPH pilot program is terminated.

#### **1. Requirements**

The application which is filed with the NBPR and on which the applicant files a request under the PCT-PPH must satisfy the following requirements:

- (1) The latest work product in the international phase of a PCT application corresponding to the application (“international work product”), namely the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive steps and industrial applicability).

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the JPO, but, if priority is claimed, the priority claim can be to an application in any Office, see example A’ in Annex II (application ZZ can be any national application).

The applicant cannot file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in PCT-PPH pilot program if the applicant does not explain why the claim(s) is/are not subject to the observation. In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

- (2) The relationship between the application and the corresponding international application satisfies one of the following requirements:

- (A) The application is a national phase application of the corresponding international application. (See Diagrams A, A', and A'' in Annex II)
  - (B) The application is a national application as a basis of the priority claim of the corresponding international application. (See Diagram B in Annex II)
  - (C) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Diagram C in Annex II)
  - (D) The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Diagram D in Annex II)
  - (E) The application is the derivative application (divisional application and application claiming domestic priority etc.) of the application which satisfies one of the above requirements (i) – (iv). (See Diagrams E1 and E2 in Annex II)
- (3) All claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated to be patentable/allowable in the latest international work product of the corresponding international application.

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 latest international work product, or the claims of the application are narrower in scope than the claims indicated to be patentable/allowable in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated to be patentable/allowable in the latest international work product is amended to be further limited by an additional 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 latest international work product is not considered to sufficiently correspond. For example, the claims indicated to be patentable/allowable in the latest international work product only contain claims to a process of manufacturing a product, then the claims of the application are not considered to sufficiently correspond if the claims of the 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 PCT-PPH pilot program need not to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product.

- (4) The NBPR has not yet issued a communication “Communication of Approval” (The heading of the communication is “Hyväksyvä välipäätös”).

## **2. Documents to be submitted**

The applicant must submit the following documents attached to the request form in filing a request under PCT-PPH.

- (1) A copy of the latest international work product which indicated the claims to be patentable/allowable and their Finnish or English translations if they are not in English.

In case the application satisfies the relationship I.(2)(A), the applicant need not submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via “PATENTSCOPE (registered trademark)”\*, an applicant need not submit these documents, unless otherwise requested by the NBPR.

(WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date.)

- (2) A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their Finnish or English translations if they are not in English

If the copy of the set of claims which are indicated to be patentable/allowable is available via “PATENTSCOPE (registered trademark)” (e.g. the international Patent Gazette has been published), an applicant need not submit this document unless otherwise requested by the JPO.

- (3) A copy of references cited in the latest international work product of the international application corresponding to the application.

If the reference is a patent document, the applicant is not required to submit it. In case the NBPR has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited documents are unnecessary.

- (4) A claims correspondence table which indicates how all claims in the application

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\* <http://www.wipo.int/pctdb/en/index.jsp>

sufficiently correspond to the claims indicated to be patentable/allowable.

When claims are just literal translation, the applicant can just write down that “they are the 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 1. (3) (Please refer to the **Example form** below).

When an applicant has already submitted the above mentioned documents (1) - (4) to the NBPR through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

### **Procedure for accelerated examination under the PCT-PPH pilot program at the NBPR**

The applicant files a letter requesting accelerated examination under the PPH pilot program to the NBPR, including the relevant supporting documents and a completed request form.

The PPH Administrator, who will be an NBPR patent examiner, will consider the request. If the requirements for accelerated examination under the PPH are not met, the PPH Administrator will notify the applicant that the application has not been allowed entry to the PPH and will provide an explanation as to why entry to the PPH was denied. The applicant is free to take any possible correcting action necessary and again request acceleration under the PPH. If all requirements for accelerated examination under the PPH are met, the PPH Administrator will notify the applicant that the application has been allowed entry 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.

## **EXAMPLE FORM**

### **PCT-PPH REQUEST**

Request for Accelerated Examination at the NBPR by using the PCT international work products under the Patent Prosecution Highway Pilot Program Between the NBPR and the JPO (PCT-PPH pilot program)

FI application number:

Corresponding PCT application number:

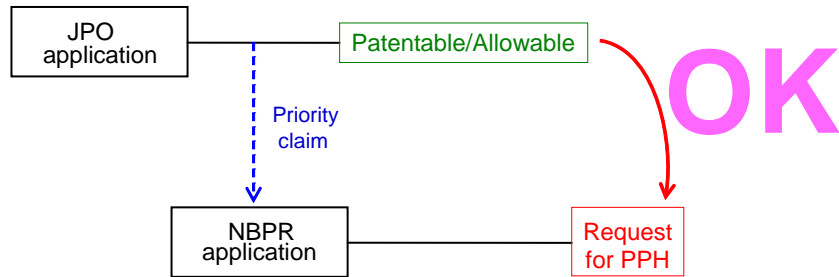
**For the purposes of participation in the PPH, the following documents should be attached/are required:**

1. Either:
  - A copy of WO-ISA or IPER and translation thereof in English or Finnish
  - or*
  - Request to obtain documents in 1. via Patentscope
  
2. Either:
  - A copy of all claims determined to be patentable/allowable by the ISA or IPEA
  - or*
  - Request to obtain documents in 2. via the Patentscope
  
3. Translation of the documents in 2. in English or Finish.
  
4. Copies of all documents cited in the WO-ISA or IPER (except for patent documents)
  
5. Claims correspondence table



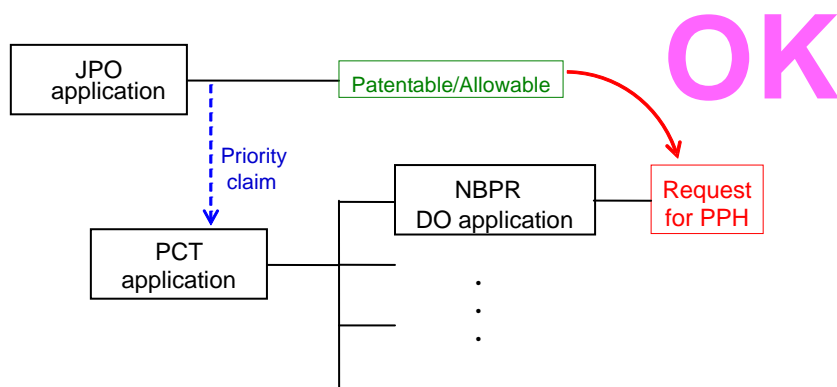
A

(Case I)  
- Paris route -



B

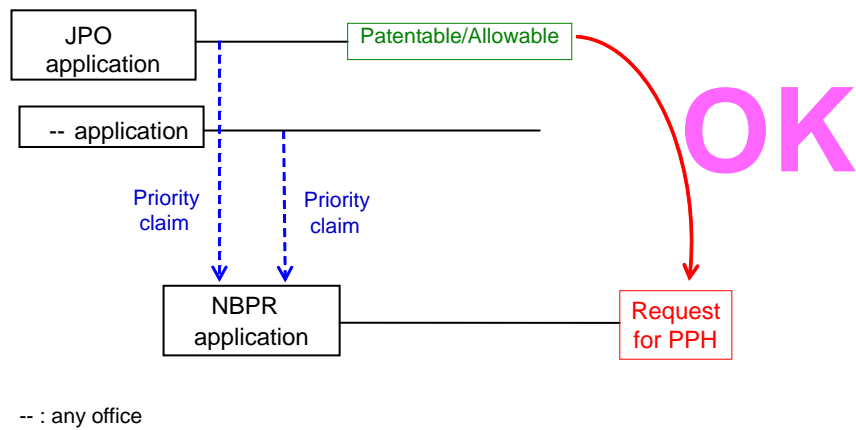
(Case I)  
- PCT route -



C

(Case I)

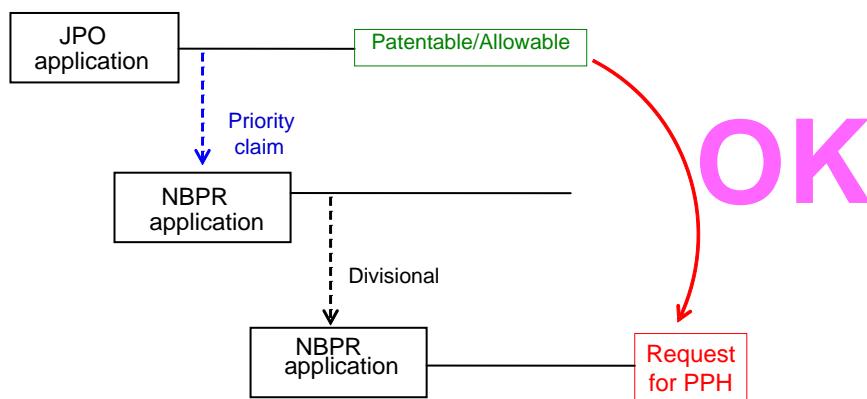
- Paris route & Complex priority -



D

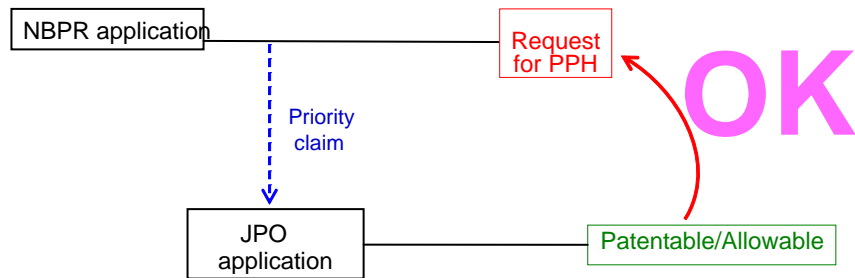
(Case I)

- Paris route & divisional application -

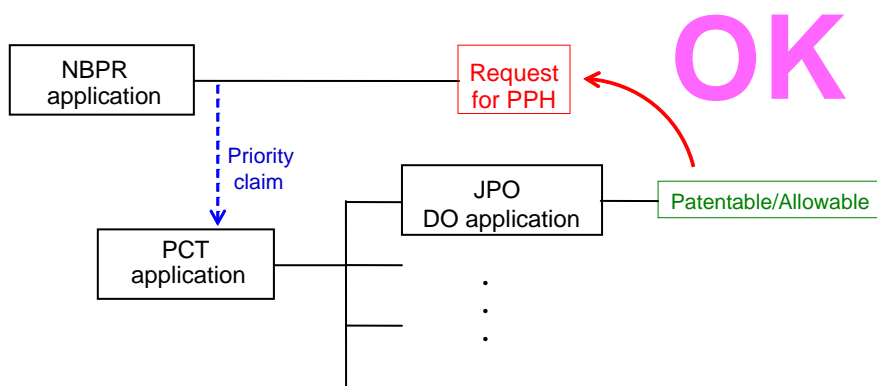


**E**

(Case II)  
- Paris route -

**F**

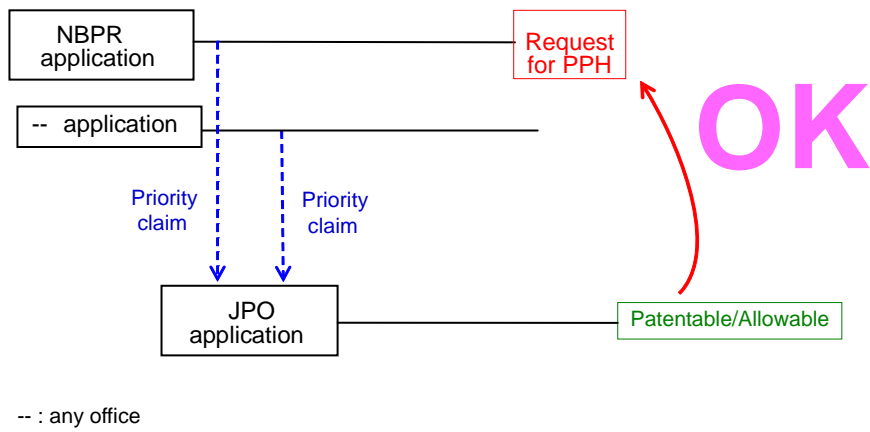
(Case II)  
- PCT route -



G

(Case II)

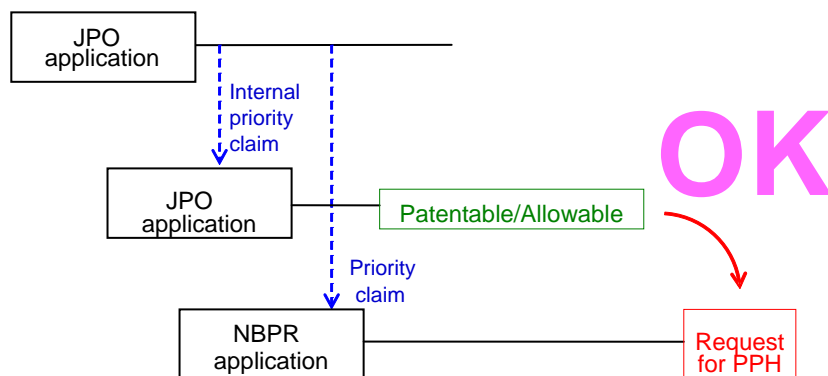
- Paris route & Complex priority -



H

(Case III)

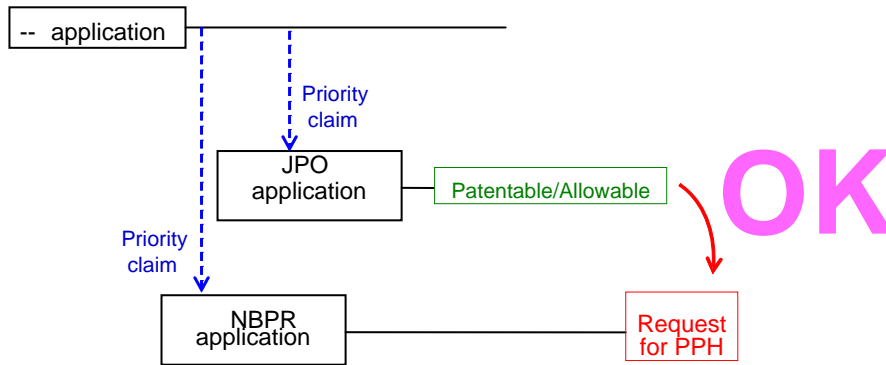
- Paris route, Internal priority -



I

*(Case III)*

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

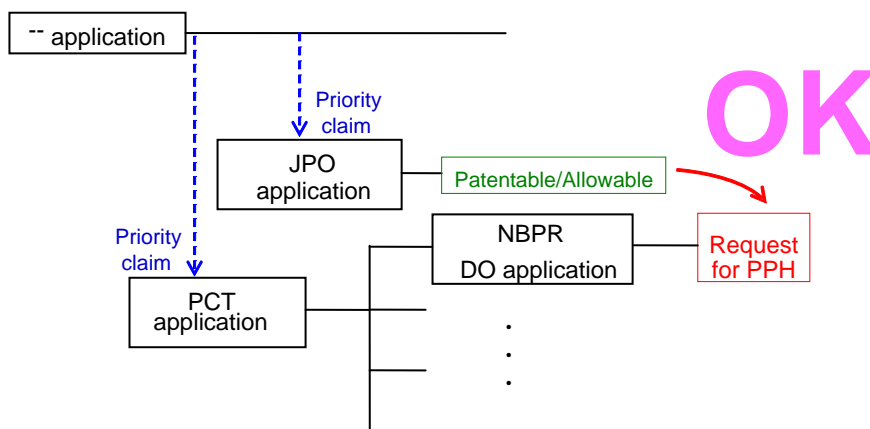


-- : the office other than the JPO and the NBPR

J

*(Case III)*

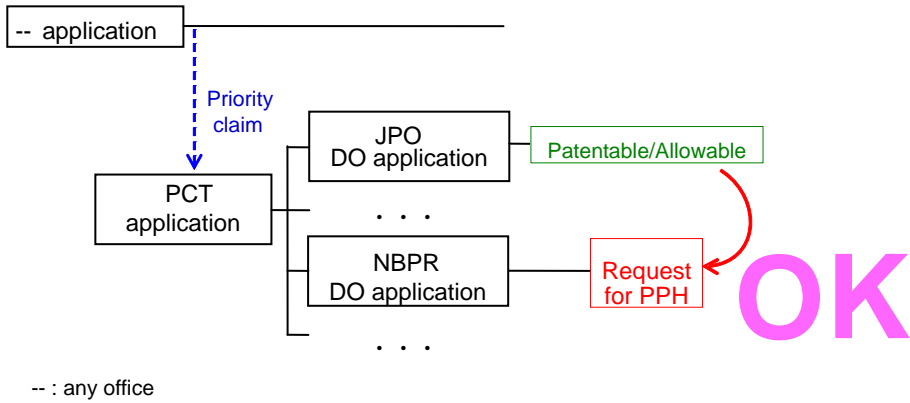
- PCT route, but the first application is from the third country -



-- : the office other than the JPO and the NBPR

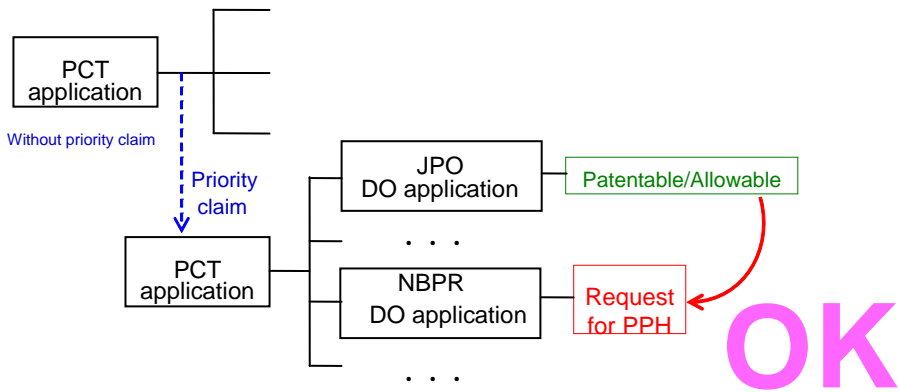
K

(Case III)  
- PCT route -



L

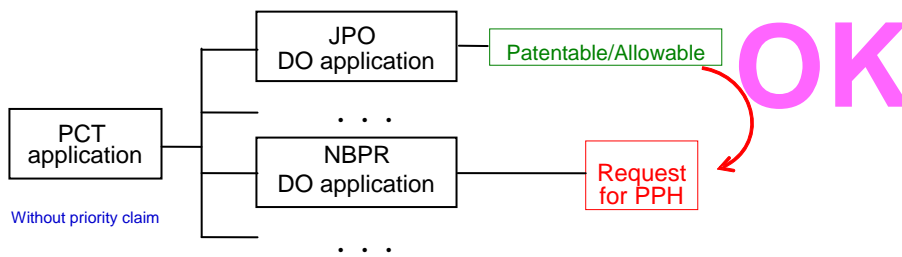
(Case III)  
- Direct PCT & PCT route -



M

(Case IV)

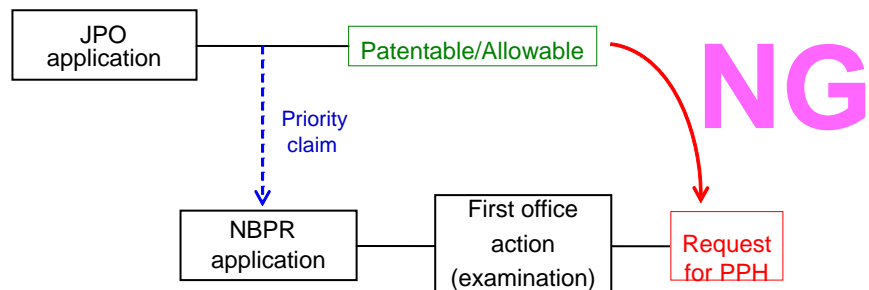
- Direct PCT route -



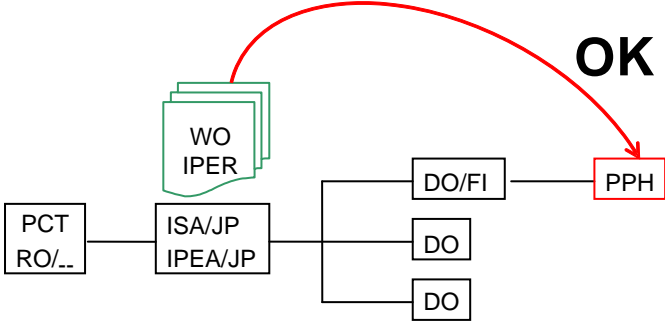
N

*A case not meeting requirement (d)*

Examination has begun before a request for PPH

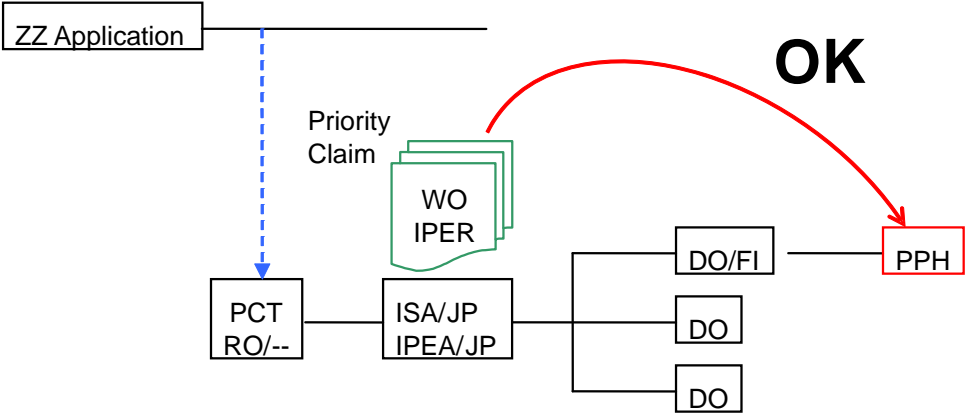


**(A) The application is a national phase application of the corresponding international application.**



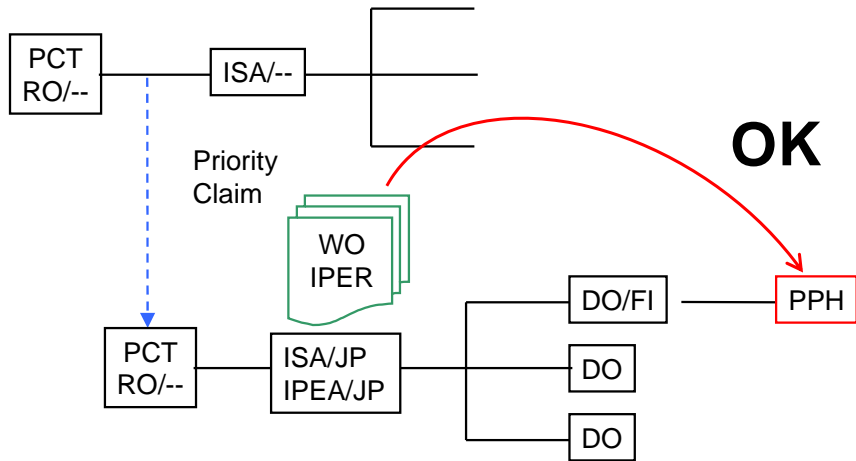
**(A') The application is a national phase application of the corresponding international application**

**(The corresponding international application claims priority from a national application.)**

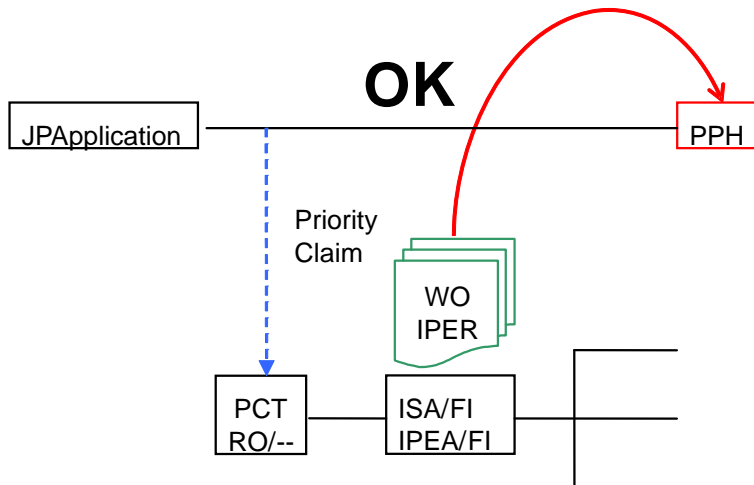


ZZ=any office

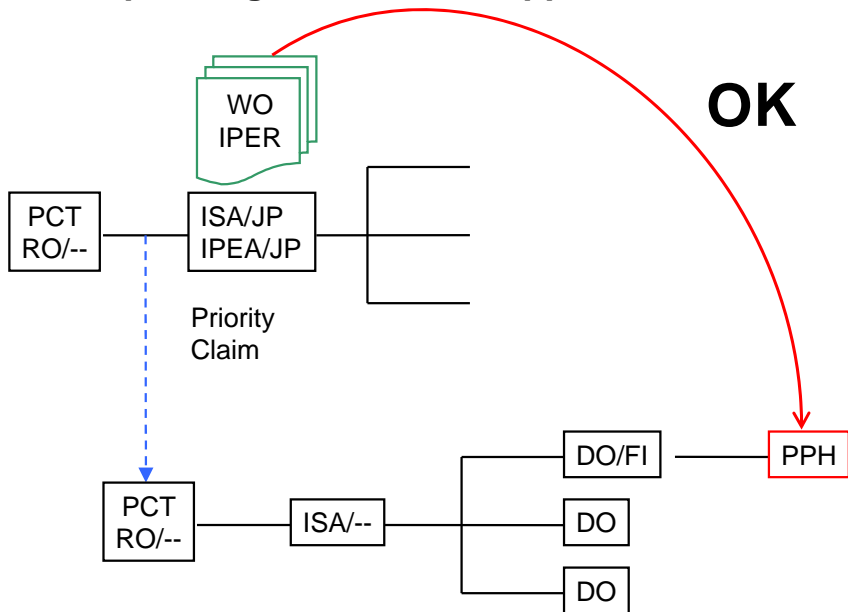
**(A'')** The application is a national phase application of the corresponding international application.  
 (The corresponding international application claims priority from an international application.)



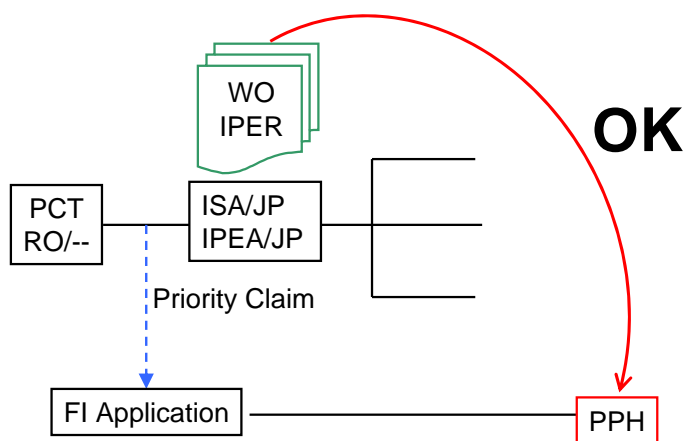
**(B)** The application is a national application as a basis of the priority claim of the corresponding international application.



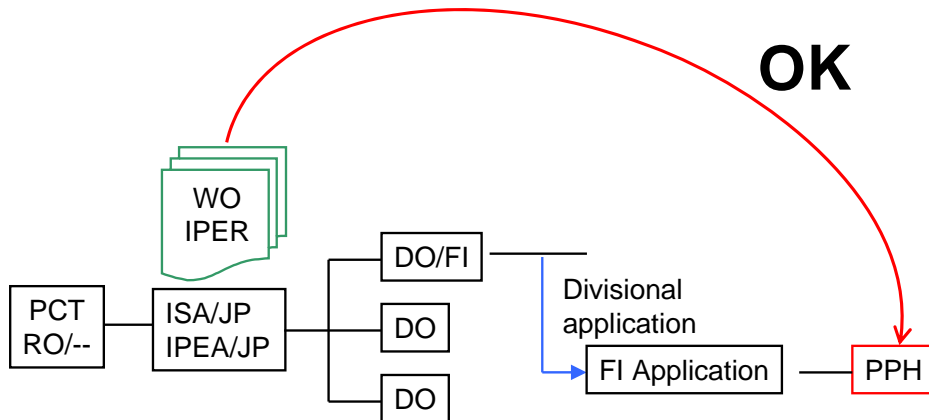
**(C) The application is a national phase application of an international application claiming priority from the corresponding international application.**



**(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.**



**(E1) The application is a divisional application of an application which satisfies the requirement (A).**



**(E2) The application is an application claiming domestic priority from an application which satisfies the requirement (B).**

