

Procedures to file a request to the Federal Service for Intellectual Property (Rospatent) for Patent Prosecution Highway Pilot Program

Part I

PPH using the national work products

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the Rospatent and satisfies the following requirements under Patent Prosecution Highway pilot program based on the national work products from one of the offices listed in Appendix A.

1. Requirements

(a) Both the Rospatent application on which PPH is requested and the Office of early examination (OEE) application(s) forming the basis of the PPH request shall have the same earliest date (whether this is a priority date or a filing date).

For example, the Rospatent application (including PCT national phase application) is either:

(Case I) an application which validly claims priority under the Paris Convention to the application(s) (examples are provided in ANNEX I, Figure A, B, C and D), or

(Case II) an application which is the basis of valid priority claim under the Paris Convention for the OEE 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 the common priority document with the OEE 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 Rospatent application and the OEE application(s) are derived from a PCT international application having no priority claim (an example is provided in ANNEX I, Figure M).

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

Claims clearly identified to be patentable/allowable in the latest

office action at examination stage are able to be a base of a request for an examination under the PPH pilot program, even if the application, which includes those claims is not granted for patent yet. The following case will fall within this interpretation: When an OEE examiner sends a notification specifying the OEE's intention to grant listed in Annex F/

- (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 OEE.***

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

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

A request on the amendment of the dossier of the application shall be filed in case the claims of the initial application are not identical with the claims of the invention considered patentable/allowable in the OEE, and a corresponding fee shall be paid, if necessary.

Any claims amended or added after the grant of the request for participation in the PPH pilot program need to sufficiently correspond to the claims indicated as allowable in the OEE application.

- (d) The Rospatent has not begun examination of the application*** (an example is provided in ANNEX I, Figure N).

2. Documents to be submitted

Documents (a) to (e) below must be submitted by attaching to "The Explanation of Circumstances Concerning Examination under PPH Program".

(a) Copies of all office actions¹ in the OEE, which were sent for the corresponding application by the OEE, and translations of them².

Both Russian and English are acceptable as translation language.

(b) Copies of all claims determined to be patentable/allowable by the OEE, and translations of them.

Russian and English are acceptable as translation language³.

(c) Copies of references cited by OEE examiner

If the references are patent documents, the applicant doesn't have to submit them because the Rospatent usually possess them. When the Rospatent 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.

The translations of the references are unnecessary.

(d) Claim correspondence table

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

(e) The applicant must file the request for substantive examination

It is required to file the request for substantive examination in compliance with paragraph 1 Article 1386 of the Civil Code of the Russian Federation and to pay the fee for filing of this request.

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

¹ Office actions are documents which relate to substantive examination.

² 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.

³ Machine translations **will not** be admissible.

When the application doesn't fulfill the requirement of 1. and 2. above, the request of an examination is not accepted. In that case, the Rospatent will notify that and the reason for it to the applicant (or the representative). The applicant will be given one opportunity to perfect the request. If the request will not be perfected the application will await action in its regular turn.

Part II
PPH using the PCT international work products from the OEE

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

When filing a request for the PCT-PPH pilot program, an applicant must submit a request form “The Explanation of Circumstances Concerning Examination under PCT-PPH 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 Rospatent 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 OEE, 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 (A) – (D). (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 as allowable in the OEE as ISA/IPEA.

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

In this regard, a claim that is narrower in scope occurs when an OEE 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 Rospatent which introduces a new/different category of claims to those claims indicated as allowable in the OEE is not considered to sufficiently correspond. For example, the OEE claims only contain claims to a

process of manufacturing a product, then the claims in the Rospatent are not considered to sufficiently correspond if the Rospatent claims introduce product claims that are dependent on the corresponding process claims.

A request on the amendment of the dossier of the application shall be filed in case the claims of the initial application are not identical with the claims of the invention considered patentable/allowable in the OEE, and a corresponding fee shall be paid, if necessary.

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 allowable in the latest international work product.

(4) The Rospatent has not begun examination of the application at the time of request under PCT-PPH.

2. Documents to be submitted

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

Some of the documents may not be required to submit in certain cases. Please note that the name of the documents omitted to submit still have to be listed in “The Explanation of Circumstances Concerning Examination under PCT-PPH Program”.

(1) A copy of the latest international work product which indicated the claims to be patentable/allowable and their English or Russian translations.

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 Rospatent.

(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

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

product of the corresponding international application indicated to be patentable/allowable and their Russian translations.

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 Rospatent.

(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 Rospatent 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 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).

(5) It is required to file the request for substantive examination in compliance with paragraph 1 Article 1386 of the Civil Code of the Russian Federation and to pay the fee for filing of this request.

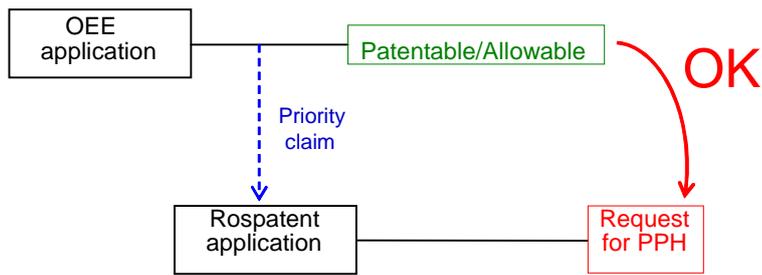
When an applicant has already submitted the above mentioned documents (1) - (4) to the Rospatent through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

When the application doesn't fulfill the requirement of 1. and 2. above, the request of an examination is not accepted. In that case, the Rospatent will notify that and the reason for it to the applicant (or the representative). The applicant will be given one opportunity to perfect the request. If the request will not be perfected the application will await action in its regular turn.

ANNEX I

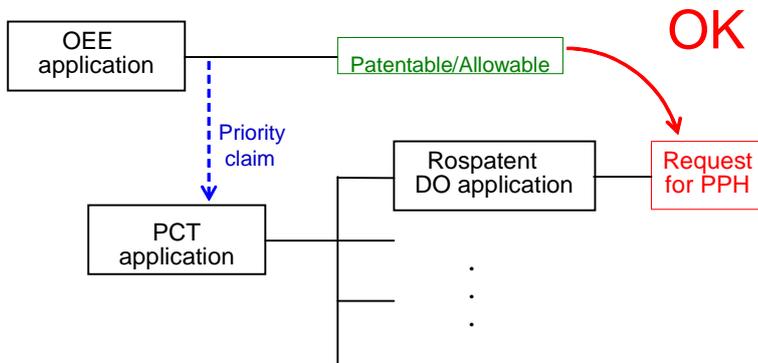
A

(Case I)
- Paris route -



B

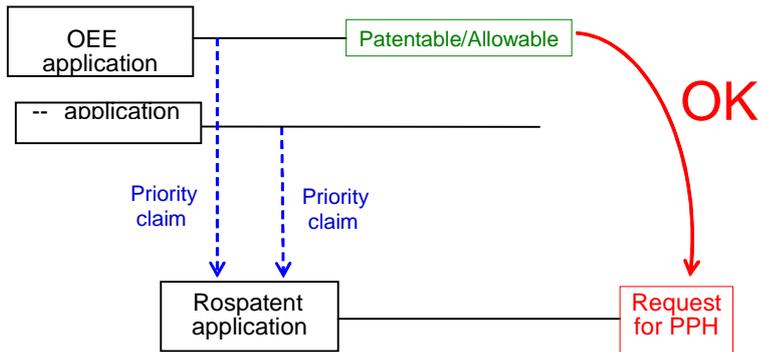
(Case I)
- PCT route -



C

(Case I)

- Paris route & Complex priority -

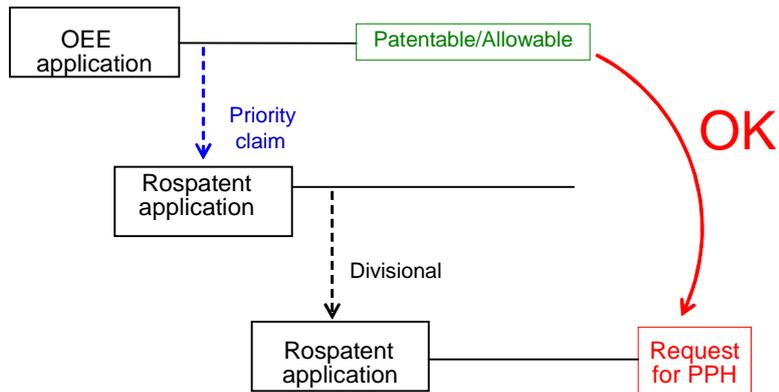


-- any office

D

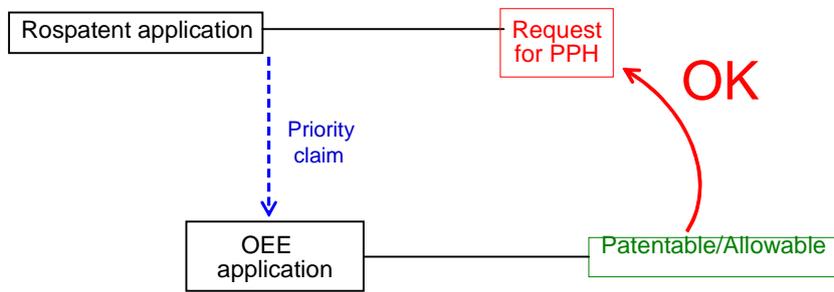
(Case I)

- Paris route & divisional application -



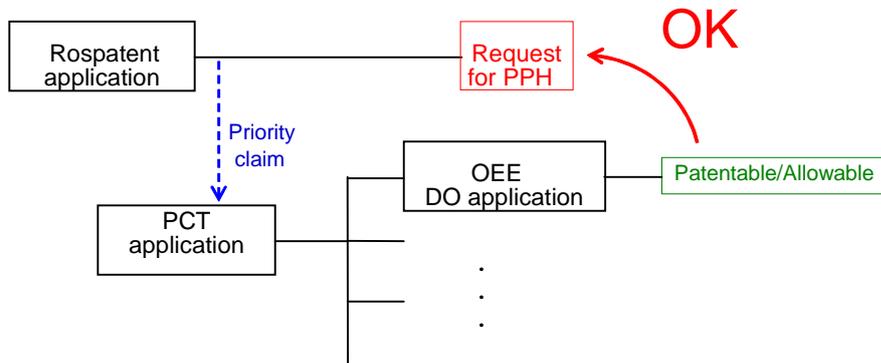
E

(Case II)
- Paris route -



F

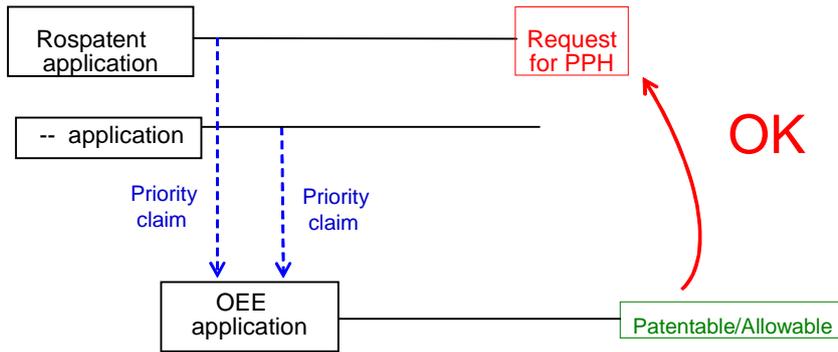
(Case II)
- PCT route -



G

(Case II)

- Paris route & Complex priority -

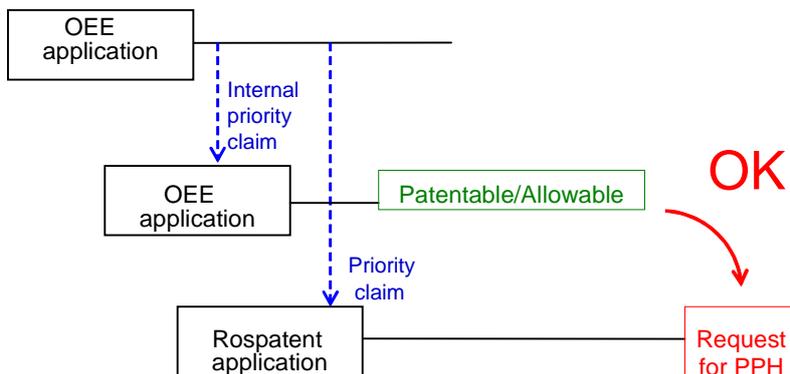


-- : any office

H

(Case III)

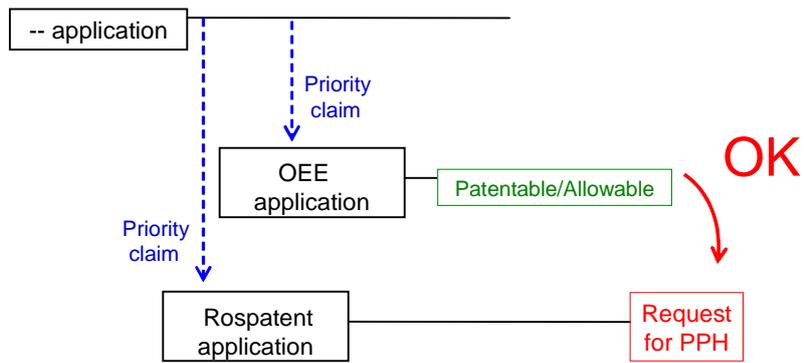
- Paris route, Internal priority



I

(Case III)

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

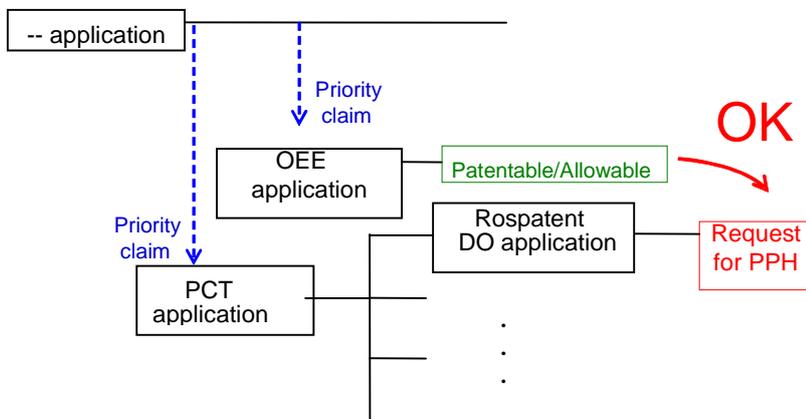


-- : the office other than Rospatent and OEE

J

(Case III)

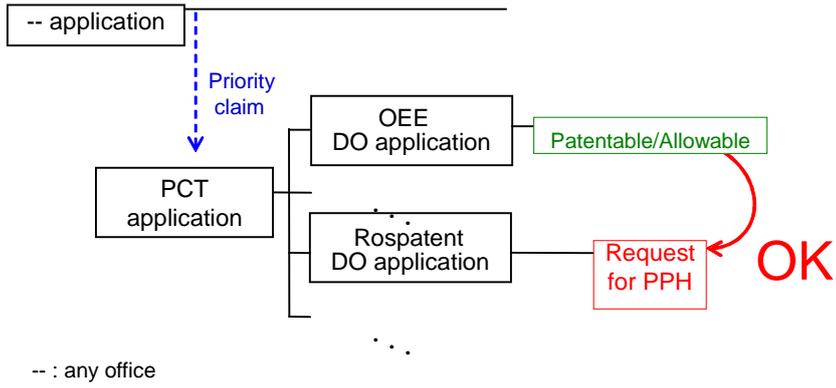
- PCT route, but the first application is from the third country -



-- : the office other than Rospatent and OEE

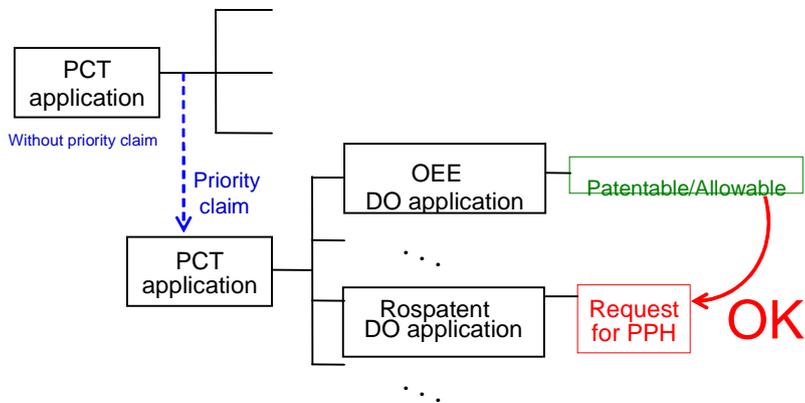
K

(Case III)
- PCT route -



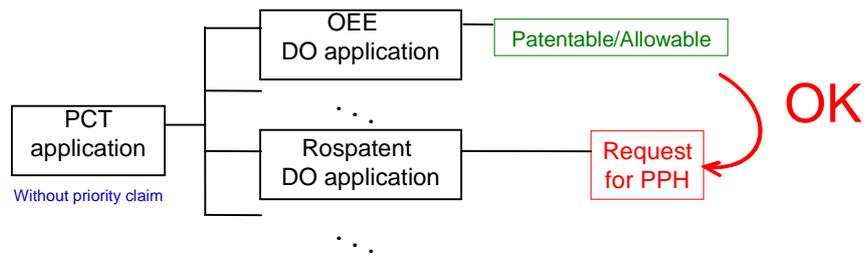
L

(Case III)
- Direct PCT & PCT route -



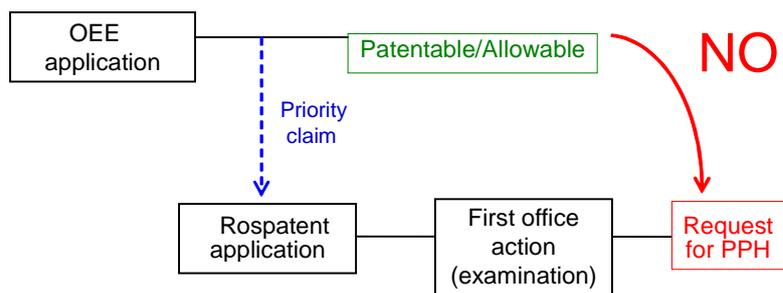
M

(Case IV)
- Direct PCT route -



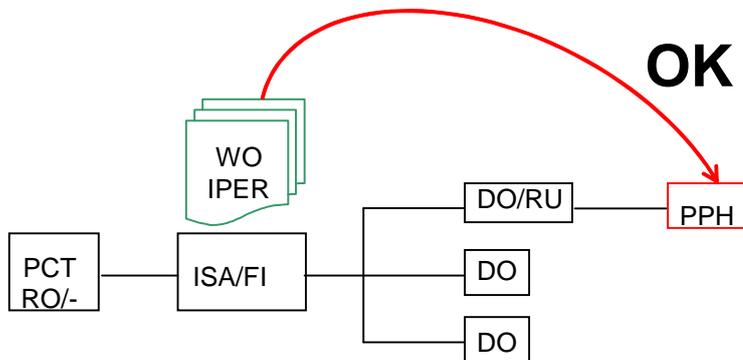
N

A case not meeting requirement
Examination has begun before a request for PPH

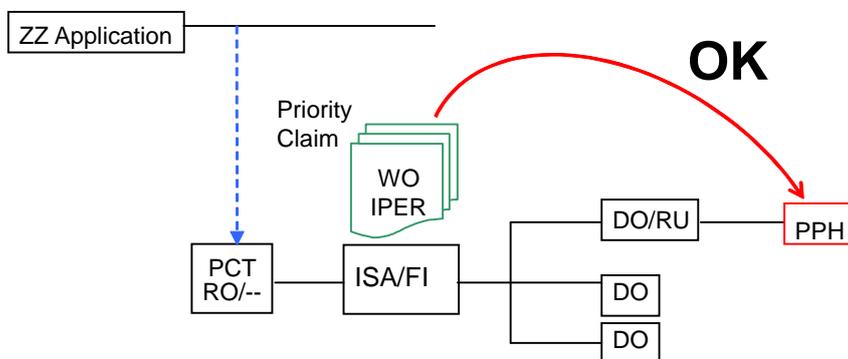


ANNEX II

(A) The application is a national stage entry of the corresponding PCT application.

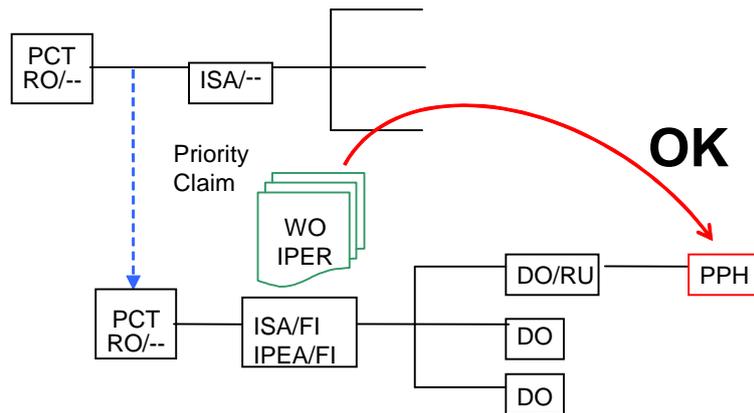


**(A') The application is a national stage entry of the corresponding PCT application.
(The corresponding PCT application claims priority to a national application filed anywhere.)**

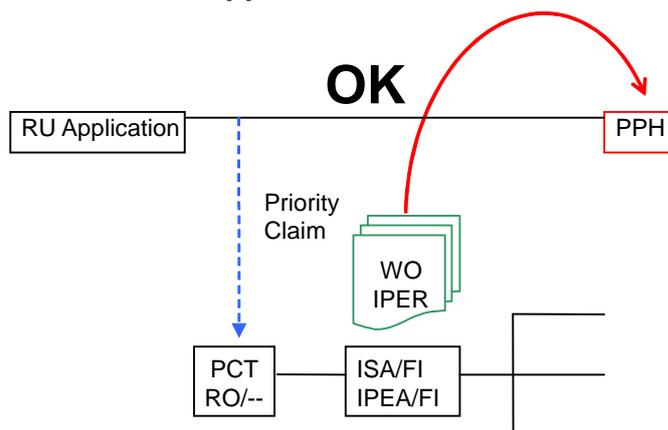


ZZ – any office

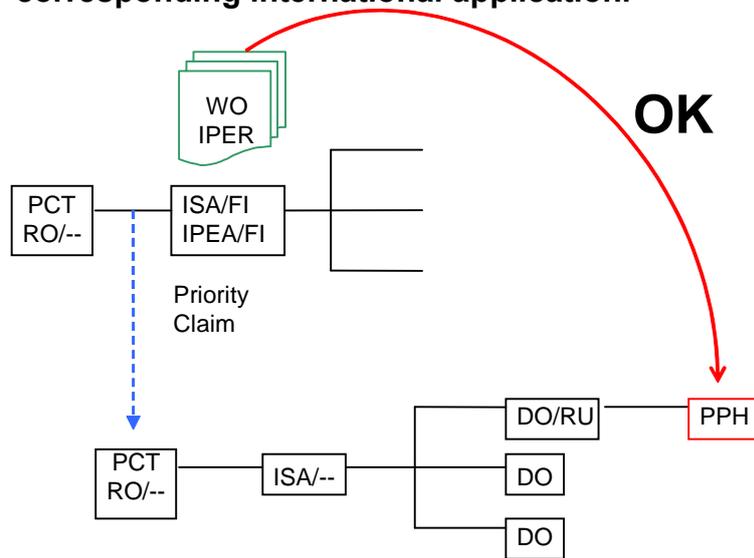
(A'') The application is a national phase application of the corresponding international application.
(The corresponding international application claims priority from an international application.)



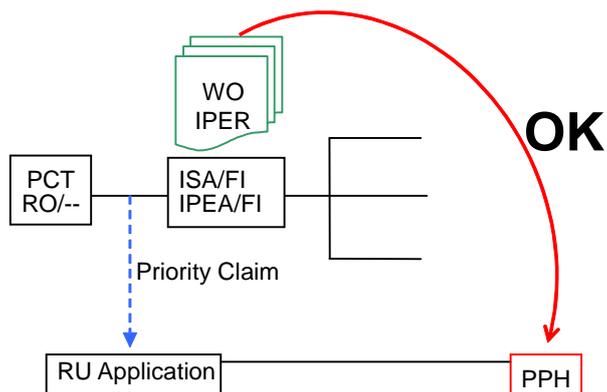
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



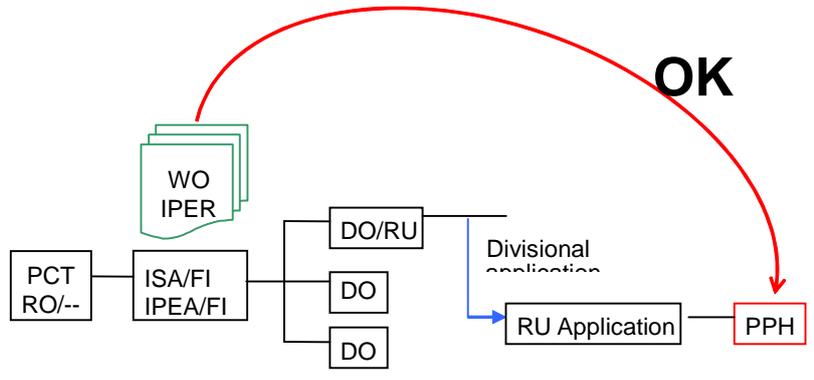
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



(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).

