



Procedures to file a request to the Romanian State Office for Inventions and Trademarks (OSIM) for “Patent Prosecution Highway” (PPH) Pilot Program between the OSIM and the Japan Patent Office (JPO)

The PPH Pilot Program enables to applicants of a patent application whose claims have been determined to be patentable by the JPO (Office of Earlier Examination OEE), to undergo an accelerated examination in the OSIM (Office of Later Examination OLE), with a simple procedure according to a request from the applicant/applicants.

1. Request to the OSIM

The applicant has to file with the OSIM a request for accelerated examination under PPH, by submitting a bilingual Romanian/English form for requesting entering in the accelerated examination under the PPH Pilot Program based on JP application (PPH Pilot Program) or the PPH Pilot Program based on PCT international work products (PCT-PPH Pilot Program), accompanied by the relevant supporting documents. The form is accessible on the OSIM website www.osim.ro

The requirements for an application with the OSIM for accelerated examination under PPH are given below in paragraph 2, the relevant supporting documentation in paragraph 3 and the general procedure envisaged, in paragraph 4.

2. Requirements for requesting accelerated examination under the PPH Pilot Program or the PCT-PPH Pilot Program at the OSIM

The five requirements are:

(a) The RO (Romanian) patent application is:

(i) an application which priority under the Paris Convention is recognized, to one or more applications filed in JP (examples in Annex 1, fig. A, B, C, D, E, F, G or H), or

(ii) a PCT national phase application in Romania, representing a first filing and with a national phase application also in the JP (examples in Annex 1, fig. I), or

(iii) an application which priority under the Paris Convention is recognized, to one or more PCT applications with a national phase in the JP (examples in Annex 1, fig. J, K, L) or

- (iv) a PCT national phase application in Romania of the corresponding PCT application (examples in Annex 2, fig. A, A', and A") or
- (v) an application as a basis of the priority claim of the corresponding PCT application (examples in Annex 2, fig. B) or
- (vi) a PCT national phase application in Romania of an PCT application claiming priority from the corresponding PCT application (examples in Annex 2, fig. C) or
- (vii) an application claiming foreign priority from the corresponding PCT application (examples in Annex 2, fig. D) or
- (viii) a RO patent application being a divisional application or application claiming domestic priority etc of the application filed under (i)-(vii) (examples in Annex 2, E1 and E2 etc).

(b) At least one corresponding JP application has one or more claims that have been determined to be patentable/allowable by the JPO or one corresponding PCT application has one or more claims that have been determined to be patentable/allowable by the JPO as ISA or IPEA.

(i) In the case of PPH, claims are "determined to be patentable/allowable" when the JPO examiner clearly identified the claims to be patentable/allowable in the latest office action, even if the application is not granted for patent yet

The office action includes:

- (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.

(ii) In the case of PCT-PPH, 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).

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 irrespective of whether or not an amendment is submitted to correct the observation noted in Box VIII.

(c) All the claims in the RO application for the accelerated examination under the PPH or the PCT-PPH must sufficiently correspond to one or more of those claims indicated as patentable in the JPO or the latest international work product of the corresponding PCT application.

Claims are considered to “sufficiently correspond”, where accounting for differences due to translations and claim format, the claims in the RO application are of the same or similar scope as the claims indicated as patentable/allowable in the corresponding JP application or the corresponding PCT application.

A claim in the RO application that is narrower in scope than the claims indicated as allowable/patentable in the JP application or the PCT application will “sufficiently correspond” if presented as a claim dependent upon a claim that is of the same or similar scope as a claim indicated as allowable/patentable in the JP application or the PCT application. In this regard, a claim that is narrower in scope occurs when a JP claim or a claim of the PCT application is amended to be further limited by an additional feature that is supported by the written description of the RO application (description and/or claims).

A claim in the RO application which introduces a new/different category of claims to those claims determined to be patentable/allowable in the JP application or the PCT application is not considered to sufficiently correspond. For example, if the JPO claims or the claims of the PCT application only contain claims to a process of manufacturing a product, then, the claims in the RO application are not considered to sufficiently correspond if the RO application claims introduce product claims that are dependent on the corresponding process claims.

(d) The OSIM has not yet started the (substantive) examination procedure of the patent application.

(e) A “Request for Substantive Examination” must have been filed at the OSIM either at the time of the PPH request or previously.

3. Required documents for accelerated examination under the PPH Pilot Program or the PCT-PPH Pilot Program at the OSIM

The following documentation will be needed to support a request for accelerated examination under the PPH or the PCT-PPH at the OSIM:

a) a copy of either all office actions relevant to the substantive examination for patentability, on the corresponding JP application(s), and translation of them in English, or the latest international work product which indicated the claims to be patentable/ allowable and their Romanian or English translations if they are not in English.

Either Romanian or English is acceptable as translation language. No copy of the office actions need to be supplied if the office actions are available via AIPN (JPO's dossier access system) or PATENTSCOPE (registered trademark). Machine translations will be admissible. Should the office action in English language not be comprehensible to the OSIM examiner, he may request an additional translation into Romanian from the applicant.

b) a copy of either the claims examined and found to be allowable/patentable by the JPO, and translations of them in English, or a set of claims which the latest international work product of the corresponding PCT application indicated to be patentable/ allowable and their Romanian or English translations if they are not in English.

Either Romanian or English is acceptable as translation language. No paper copy of the claims need to be supplied if the claims are available via AIPN (JPO's dossier access system) or PATENTSCOPE (registered trademark). Machine translations will be admissible. Should the claims in English language not be comprehensible to the OSIM examiner, he may request an additional translation into Romanian from the applicant.

c) a completed claim correspondence table in Romanian or English language showing the correspondence between the claims of the RO application for accelerated examination under the PPH and the claims of the corresponding JP application considered allowable/patentable by the JPO.

Sufficient correspondence of claims occurs where the claims satisfy the requirements under 2c). When the 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 2c).

d) a copy of the document(s) cited by the JPO examiner or cited in the latest international work product of the PCT application corresponding to the application.

If the cited document is a patent document, it does not have to be submitted as it is generally available to the OSIM via EPOQUE. Only if the RO examiner has difficulty in obtaining a patent document, he will ask the applicant to submit it.

As a rule, cited documents need not to be translated.

4. Procedure for accelerated examination under the PPH Pilot Program or the PCT-PPH Pilot Program at the OSIM

The applicant has to provide the relevant information by filling in a form for requesting accelerated examination under the PPH Pilot Program which is available for download from the OSIM website. The form should be sent to the OSIM along with the relevant supporting documentation.

If the requirements under point 1 are met, the OSIM will conduct the accelerated examination. Thus, after registering the request for the accelerated procedure, according to the PPH, OSIM decides within two months whether the request is admitted. If the application does not qualify for participation in the PPH Pilot Program,

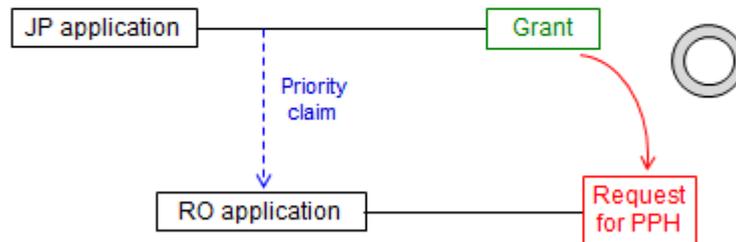
the applicant will be informed accordingly and the applicant will be given opportunity to correct the request. If the defects are not corrected in the time limit indicated, the applicant will be notified and the application will be further processed under the standard Romanian procedure, without acceleration.

If the application is admitted, the OSIM examiner will examine the fulfillment of the patentability conditions according to the Patent Law No. 64/1991 as republished, and OSIM will take a decision.

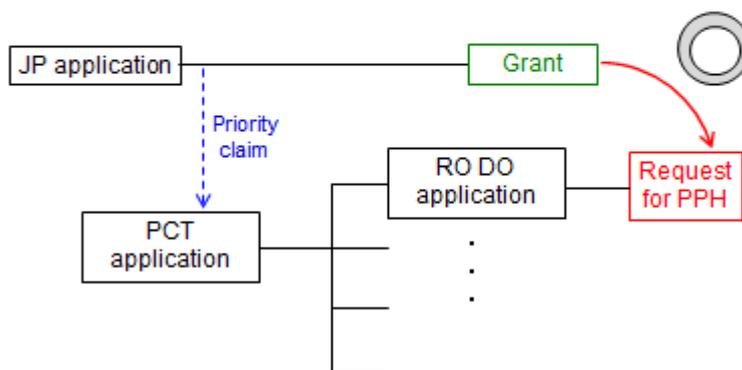
The documents accompanying the request for the accelerated examination are paper documents and they are transmitted by post.

Applications for utility models, for plant varieties or for design cannot be subjected to the accelerated examination procedure according to the PPH Program.

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

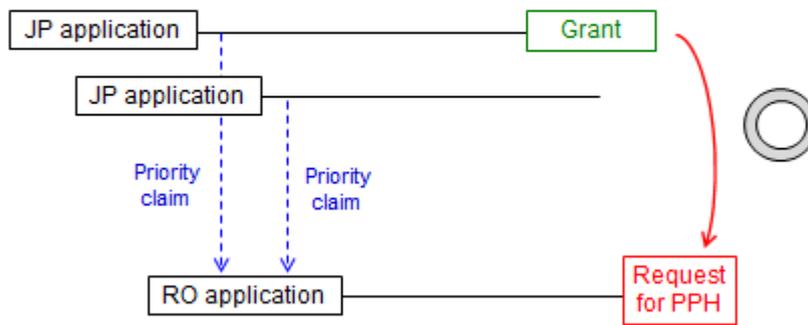


B A case meeting requirement (a) (i)
- PCT route -

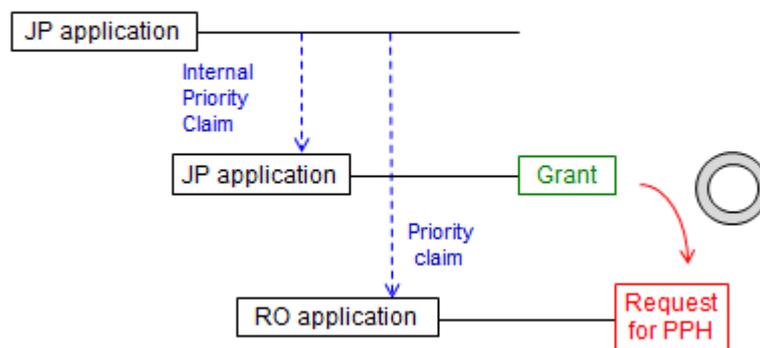


*DO – designated office

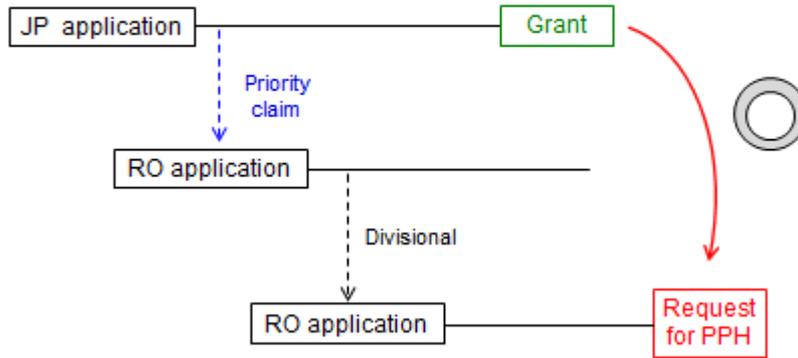
C A case meeting requirement (a) (i)
- Paris route & Complex priority -



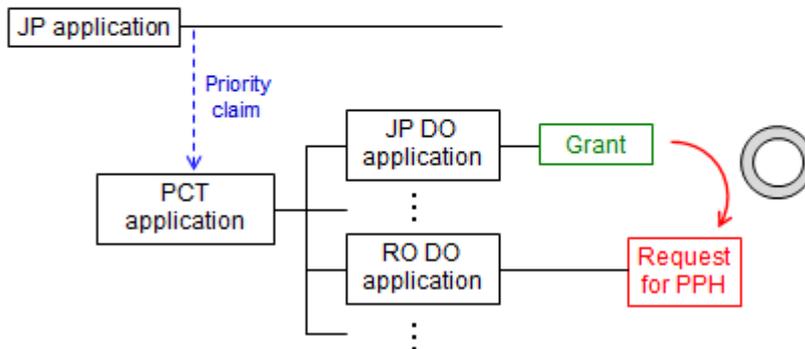
D A case meeting requirement (a) (i)
- PCT route & Internal priority -



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

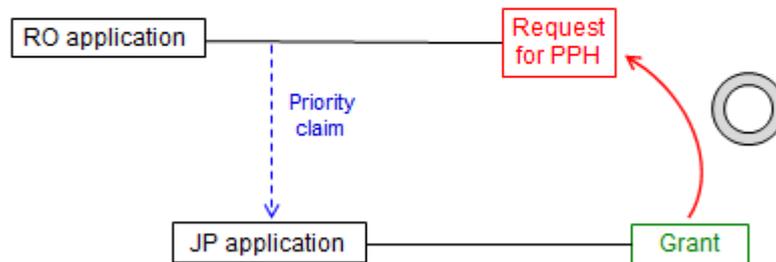


F A case meeting requirement (a) (i)
 - PCT route -



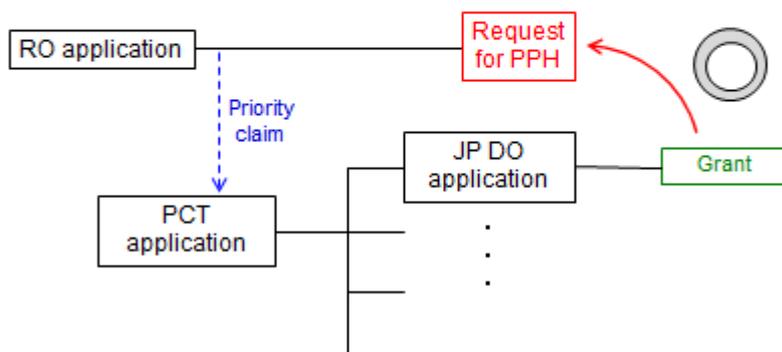
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A case meeting requirement (a) (i)
- Paris route -

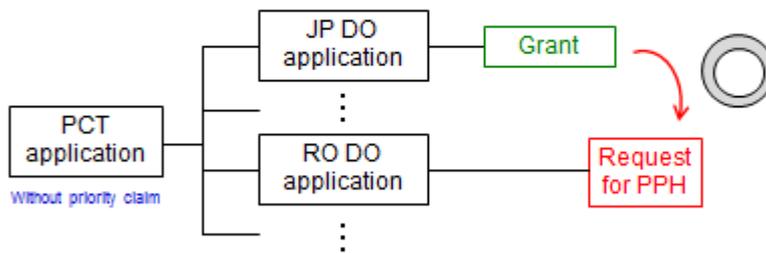


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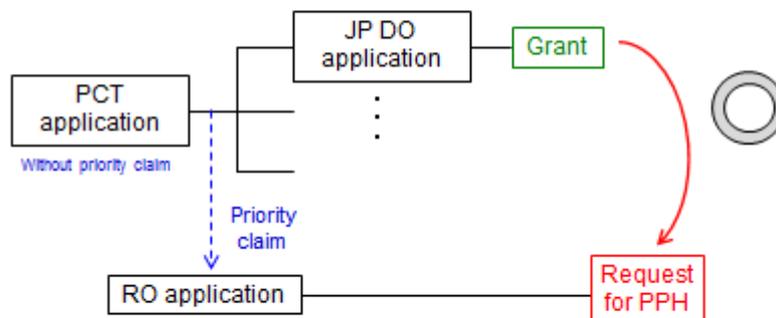
A case meeting requirement (a) (i)
- PCT route -



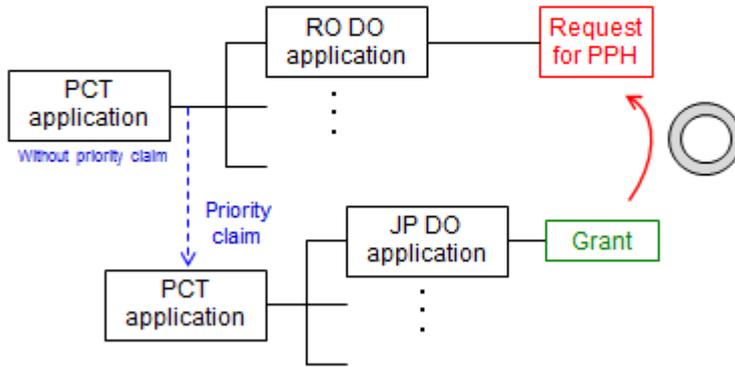
I A case meeting requirement (a) (ii)
- Direct PCT route -



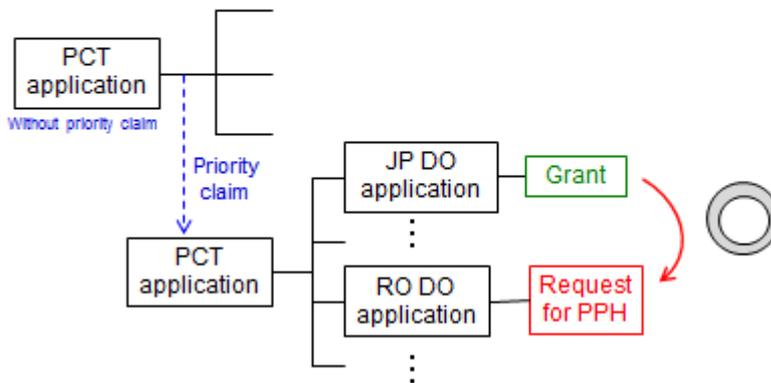
J A case meeting requirement (a) (iii)
- Direct PCT & Paris route -

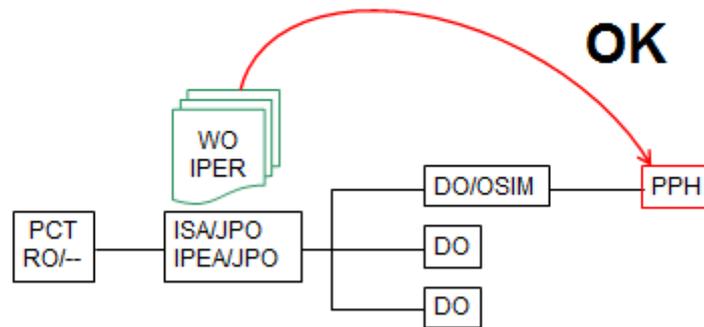


K A case meeting requirement (a) (iii)
- Direct PCT & PCT route -

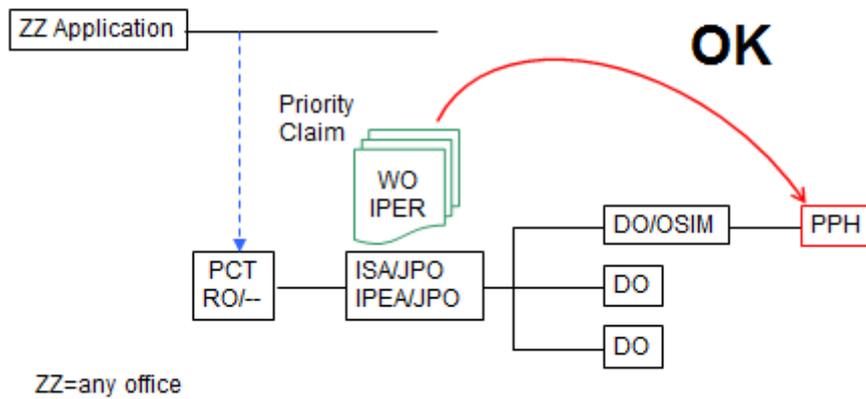


L A case meeting requirement (a) (iii)
- Direct PCT & PCT route -

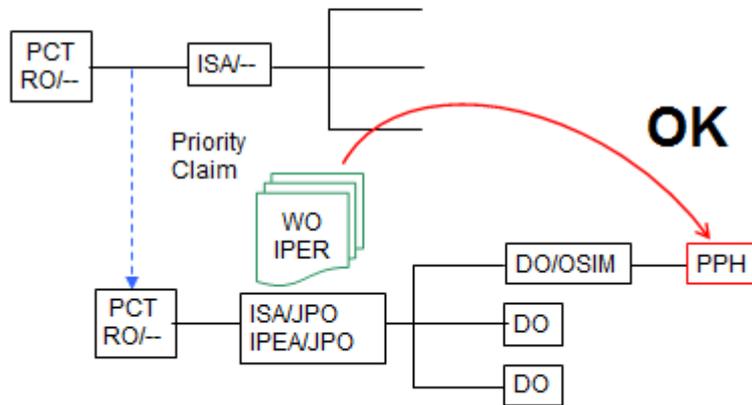


(A) A case meeting requirement (a) (iv)

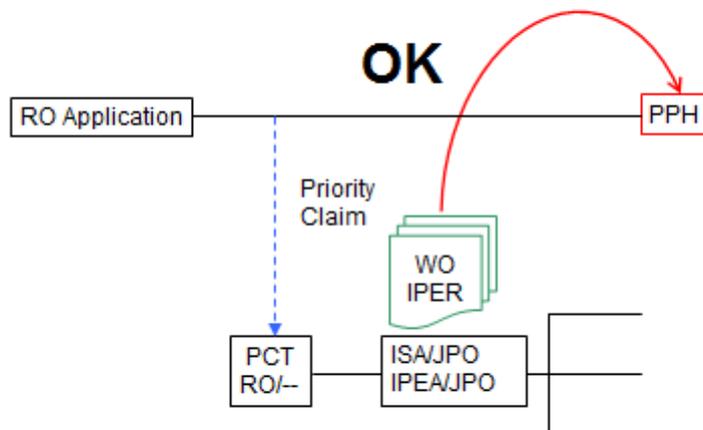
(A') A case meeting requirement (a) (iv)
 (The corresponding PCT application claims priority from a national application.)



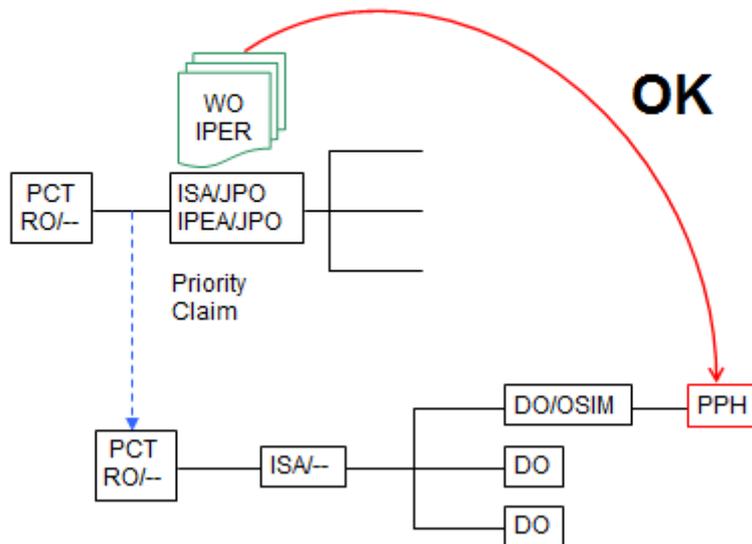
(A") A case meeting requirement (a) (iv)
 (The corresponding PCT application claims priority from an PCT application.)



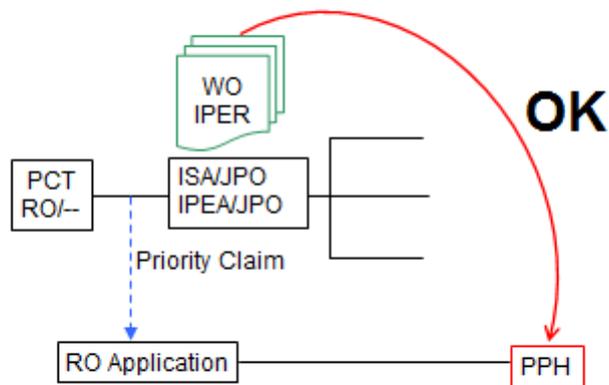
(B) A case meeting requirement (a) (v)



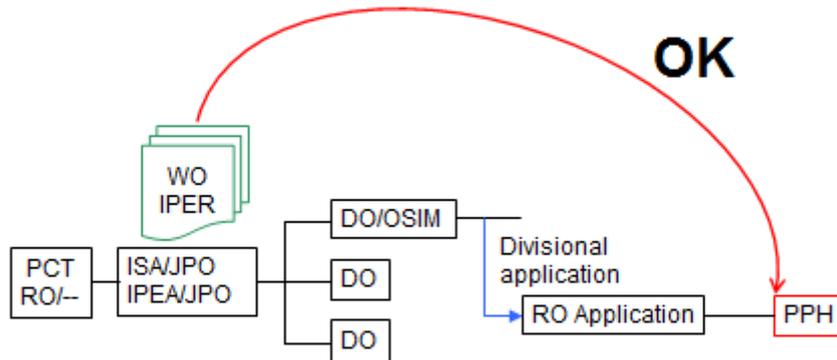
(C) A case meeting requirement (a) (vi)



(D) A case meeting requirement (a) (vii)



(E1) A case meeting requirement (a) (viii)
(The application is a divisional application of
an application which satisfies the requirement (iv).)



(E2) A case meeting requirement (a) (viii)
(The application is an application claiming domestic
priority from an application which satisfies
the requirement (v).)

