

Procedures to file a request to the SPTO (Spanish Patent and Trademark Office) 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 SPTO and satisfies the following requirements under the Patent Prosecution Highway (PPH) pilot program based on the national work products from any one of the offices listed in Appendix A.

When filing a request for the PPH pilot program, an applicant must submit a request form available on the SPTO website <http://www.oepm.es/cs/OEPMSite/contenidos/PPH/PPH.htm>

1. Requirements

- (a) ***Both the SPTO application on which PPH is requested and the Office of Earlier Examination (OEE) 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 SPTO application (including PCT national phase application) may be either:

(Case I) an application which validly claims priority under the Paris Convention from the OEE application(s) (examples are provided in ANNEX I), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the OEE application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I), or

(Case III) an application which shares a common priority document with the OEE application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I), or

(Case IV) a PCT national phase application where both the SPTO application and the OEE application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX I).

- (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.***

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the OEE application which forms the basis of the priority claim (e.g., a divisional application of the OEE application), or a OEE national

phase application of a PCT application.

See Appendix B in regard to concrete cases that claims are “determined to be patentable/allowable” on each OEEs.

- (c) All claims in the SPTO application (for which an accelerated examination under the PPH pilot program is requested) must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the OEE.**

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the SPTO are of the same or similar scope as the claims in the OEE, or the claims in the SPTO 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 technical feature that is supported in the specification (description and/or claims). A claim in the SPTO 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 OLE are not considered to sufficiently correspond if the SPTO claims 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 OEE application.

- (d) The SPTO has not begun examination of the application at the time of request for the PPH.**
- (e) A “Request for Substantive Examination” must have been filed at the SPTO either at the time of the PPH request or previously.**

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to the form requesting accelerated examination under the PPH Pilot Program.

- (a) Copies of all office actions (which are relevant to substantial examination for patentability in the OEE), which were sent for the corresponding application by the OEE, and translations of them.**

Either Spanish or English is acceptable as translation language. Machine translation will

be admissible, but if it is impossible for the examiner to understand the outline of the translated office action due to insufficient translation, the examiner can request the applicant to resubmit translations.

The applicant does not have to submit copies of the office actions when those documents are provided via OEE's dossier access system¹. If they cannot be obtained by the SPTO examiner via the OEE's dossier access system, the applicant may be notified and requested to provide them.

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

Either Spanish or English is acceptable as translation language. Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

The applicant does not have to submit copies of all claims determined to be patentable/allowable when the documents are provided via OEE's dossier access system¹. If they cannot be obtained by the SPTO examiner via the OEE's dossier access system, the applicant may be notified and requested to provide them.

(c) *Copies of references cited by the OEE examiner*

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

¹ See Appendix C

(d) Claim correspondence table

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the SPTO 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 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. (c)

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

3. Procedure for the accelerated examination under the PPH pilot program

The SPTO decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When the SPTO decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents.

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 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.

Part II

PPH using the PCT international work products

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

When filing a request for the PPH pilot program, an applicant must submit a request form available on the SPTO website <http://www.oepm.es/cs/OEPMSite/contenidos/PPH/PPH.htm>

1. Requirements

The application which is filed with the SPTO 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 one of the authorities listed in Appendix A, 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 irrespective of 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 Figures 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 Figure B in Annex II)
- (C) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)
- (D) The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure 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 Figures 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 SPTO has not begun examination of the application at the time of request under PCT-PPH.**

(5) A “Request for Substantive Examination” must have been filed at the SPTO either at the time of the PCT-PPH request or previously.

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.

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

In case the application satisfies the relationship 1.(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)”¹, an applicant need not submit these documents, unless otherwise requested by the SPTO.

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

Machine translation will be admissible, but if it is impossible for the examiner to understand the outline of the latest translated international work product due to insufficient translation, the examiner can request the applicant to resubmit translations.

(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 Spanish or English 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 SPTO. Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

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

Documents which are only referred to as references and consequently do not consist of the

¹ <http://www.wipo.int/pctdb/en/index.jsp>

reasons for refusal do not have to be submitted.

If the reference is a patent document, the applicant is not required to submit it. In case the SPTO 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 references 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)

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

3. Procedure for the accelerated examination under the PPH pilot program

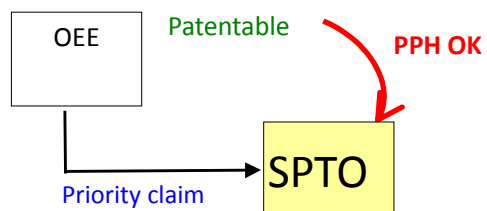
The SPTO decides whether the application can be entitled to the status for an accelerated examination under the PCT-PPH when it receives a request with the documents stated above. When the SPTO decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PCT-PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PCT-PPH, the applicant will be given opportunity to submit missing documents.

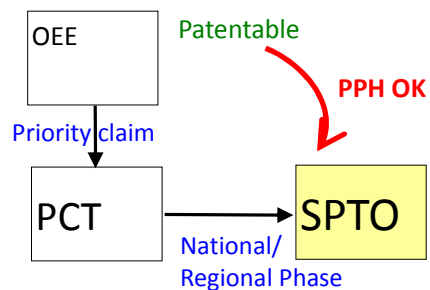
If all requirements for accelerated examination under the PPH are met, the PPH Administrator will notify the applicant that the application has been allowed entry on to the PPH. The PPH Administrator will notify the relevant examining group that the application has qualified for entry to the PPH and 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.

CASE I

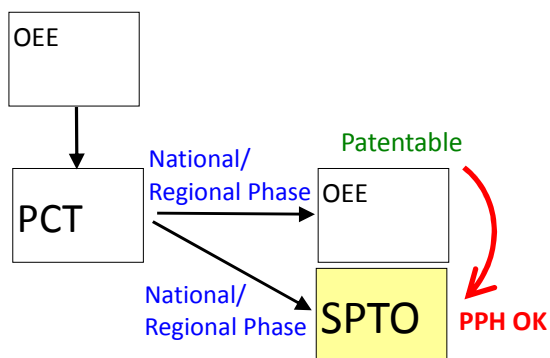
A. Paris route



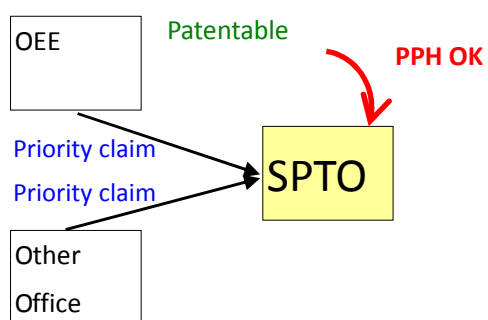
B. PCT route



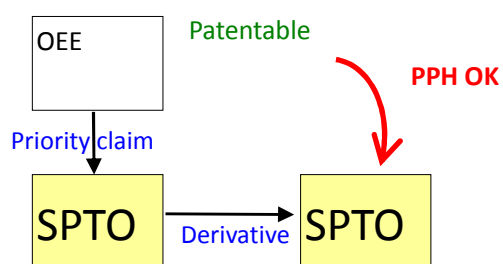
B'. PCT route



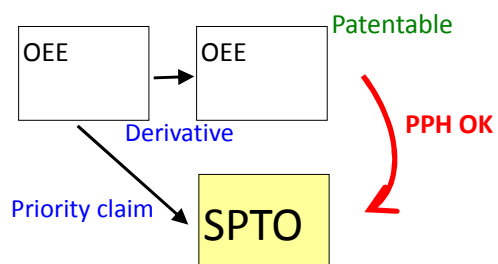
C. Complex priority



D. Derivative application (OLE)

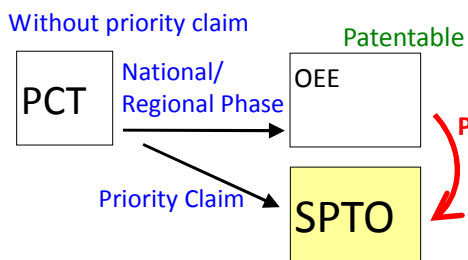


E. Derivative application (OEE)

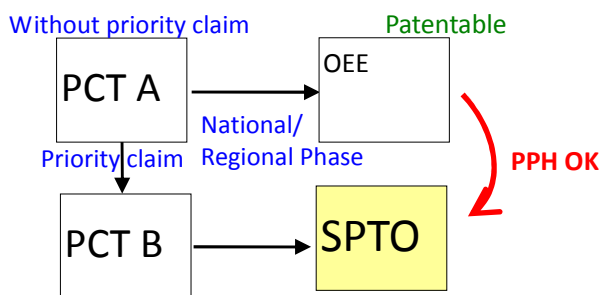
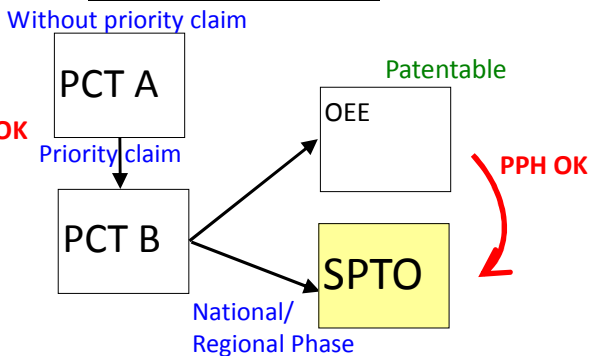


CASE II

F. Direct PCT & Paris route

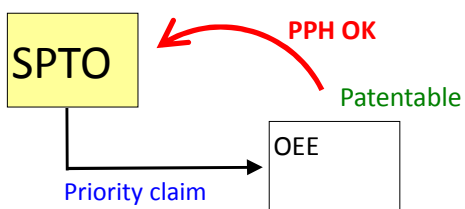


G. Direct PCT & PCT route

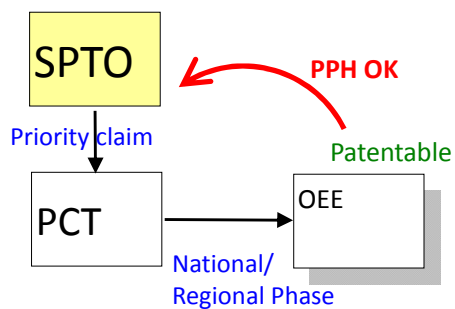


CASE III

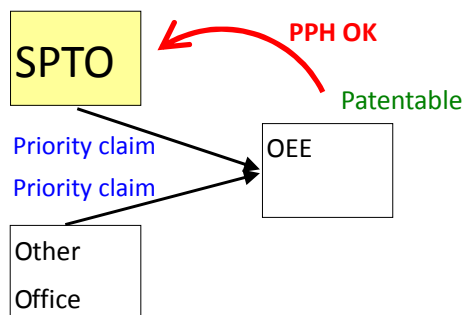
I. Paris route



J. PCT route

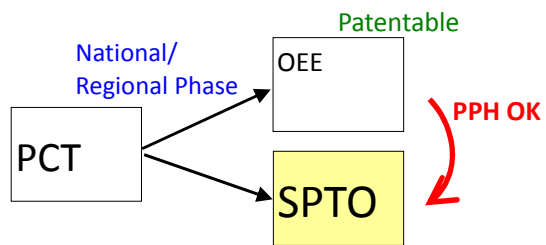


K. Paris route & Complex priority

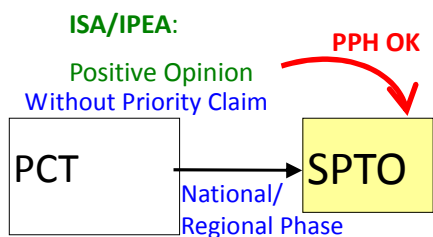


CASE IV

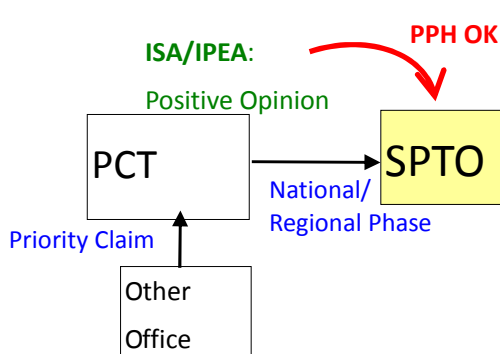
L. Direct PCT route



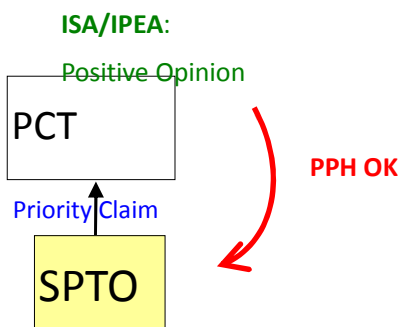
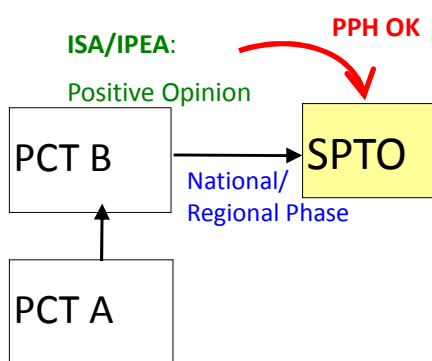
A. National phase application



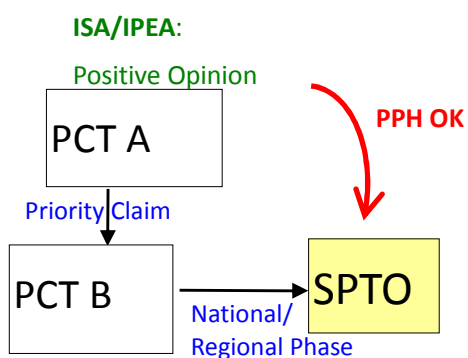
A'. National phase application



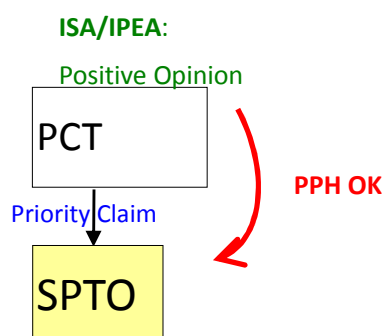
A''. National phase application



C. National phase application



D. Application claiming priority



E. Derivative application

