

Patent Prosecution Highway Pilot Programs (PPH and PCT-PPH) between the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (ROSPATENT) & Spanish Patent and Trademark Office (SPTO)

I. Patent Prosecution Highway Pilot Program

The PPH was established to enable an applicant whose claims are determined to be patentable/allowable in the Office of first filing (OFF) to have the corresponding application filed in the Office of second filing (OSF) advanced out of turn for examination while at the same time allowing the OSF to exploit the search and examination results of the OFF.

Where Rospatent is the OFF and the Russian application contains claims that are determined to be patentable/allowable, the applicant may request accelerated examination at the SPTO for the corresponding application filed with the SPTO as the OSF. The procedures and requirements for filing a request with the SPTO for participation in the PPH pilot program will be available from the SPTO Web-site.

Where Rospatent is the OSF and the corresponding application filed with the SPTO as the OFF contains claims that are determined to be patentable/allowable, the applicant may request participation in the PPH pilot program in Rospatent and petition to make the RU application special under the PPH pilot program. The procedures and requirements for filing a request in Rospatent for participation in the PPH pilot program are set forth below.

The PCT-PPH pilot program was established to expand the potential of the PPH pilot program and to enable an applicant, who has received a Written Opinion from an International Searching Authority (WO/ISA) (ISA must be ROSPATENT or SPTO), a Written Opinion from an International Preliminary Examining Authority (WO/IPEA) (IPEA must be ROSPATENT or SPTO), or an International Preliminary Examination Report (IPER/IPEA) (IPEA must be ROSPATENT or SPTO) from an International Preliminary Examining Authority to file a corresponding request to the Office of Second Filing and a petition for examination, allowing the Office of Second Filing to use the result of the international search and examination.

II. Trial Period for the PPH Pilot Program

The PPH pilot program will commence on 04.04.2011 for a period of one year ending on 03.04.2012. The trial period may be extended for up to an additional year if necessary to adequately assess the feasibility of the PPH program. The SPTO and the Rospatent will evaluate the results of the pilot program to determine

whether and how the program should be fully implemented after the trial period. The Offices may also terminate the PPH pilot program earlier if the volume of participation exceeds manageable level, or for any other reason. Notice will be published if the PPH pilot program will be terminated before 03.04.2012.

Part 1. PPH program using the work product from the SPTO

A. Requirements for requesting an examination under the PPH pilot program

(1) An application which is filed with Rospatent and which fulfills all the following requirements is eligible for the examination under the PPH program:

- i) the RU application validly claims priority under the Paris Convention from at least one corresponding SPTO application(s);
- ii) the RU application is the national phase of a PCT application which has no priority claims, or
- iii) the RU application is the national phase of a PCT application which validly claims priority from a SPTO national application, or
- iv) the RU application claims priority from a PCT application which has no priority claims, or
- v) the RU application is the national phase of a PCT application which validly claims priority from a PCT application which has no priority claims, or
- vi) the RU application is a divisional application of any of the above.

Examples are provided in Annex 1.

Examination is conducted by Rospatent, if the SPTO declares on the patentability/allowability of the invention described in one or several claims contained in the corresponding application.

Corresponding application is an application for an invention described in one or several claims determined to be patentable/allowable as a result of examination in the SPTO.

A preliminary conclusion on the patentability/allowability of the claims of an invention contained in the report on the international search carried out by the SPTO as an International Search Authority does not mean that the claims are determined as patentable by the SPTO as the Office of First Filing.

(2) The substantive examination of the application for an invention has not been started at the Rospatent.

B. Requirements for Requesting Participation in the PPH Pilot Program in Rospatent

(1) Request for examination under the PPH pilot program (hereinafter – the request) is submitted in English or Russian language.

The request is submitted on form, Example Form of which will be available on the website of Rospatent.

The request should contain the SPTO application number, which is the basis for claiming priority, as well as the publication number or the patent number.

Documents listed in paragraph B(2) should be attached to the request.

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. 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 OFF, and a corresponding fee shall be paid, if necessary.

(2) The applicant should submit the following documents along with the request:

(a) Table explaining the correspondence of the claims of the corresponding application determined to be patentable/allowable by the SPTO and the claims in the application for an invention filed with Rospatent.

If the claims are identical, such an indication should be made in the table. If the claims are not identical, the table should contain explanations in respect of correspondence of each claim in compliance with requirements mentioned in paragraph B(3).

(b) Copies and translations of all SPTO actions (notifications);

SPTO actions (notifications) are documents concerning the substantial examination sent to the applicant by the SPTO examiner. Russian and English can be the languages of translation.

It is sufficient that the applicant provides automated (machine) translation of the actions (notifications) of the SPTO, since the examiner will at least understand the sense of the action (notification) of the office.

If the examiner does not understand the sense of the translation of the SPTO action (notification) due to its poor quality the examiner may request the applicant to submit (resubmit) the translation.

(c) Copy and translation of claims of the invention determined to be patentable/allowable by the SPTO in Russian language (professional translation).

A copy of the claims determined to be patentable/allowable by the SPTO can be a copy of the initial claims or a copy of modified claims determined to be patentable/allowable, or a publication of a patent granted by the SPTO translated into Russian language.

(d) Documents cited by the SPTO examiner.

Documents cited in the basis for refusal should be provided. Documents cited only for reference and thus, not containing basis for refusal need not be provided.

If the cited document is a non-patent literature, the applicant has to submit it. If the cited document is a patent document, the applicant does not have to provide it since such a document is usually available to the OSF, however, in case the office due to some reasons has problems with obtaining the document, it can request the applicant to submit it.

In any case the applicant is not required to submit the translations of the cited documents.

(3) All the claims of the application in respect of which a request for an examination under PPH program is submitted to Rospatent must sufficiently correspond to one or several claims determined to be patentable/allowable by the SPTO.

All the claims of an application filed with Rospatent are considered as corresponding to one or several claims of an invention determined to be patentable/allowable by the SPTO if they are identical or narrower in the scope of claims.

The requirement of correspondence of the claims is considered to be met if an independent claim of an application filed with Rospatent differs from the claim of the corresponding application due to presence of an additional component in a form of a feature (features) of dependent claim (claims), or addition of a dependent claim with a component from the description of the invention by a feature (features) or in a specific form of expression of a feature, expressed in an independent claim by a general notion or by an exclusion of a feature from a dependent claim. The applicant must also present a table of correspondence of the claim in Russian language. Such a table must show how the claims of an invention in the Russian application correspond with the patentable/allowable claims of an invention in the SPTO application.

The requirement of correspondence of the claims can be achieved by modification of the claim of the OFF application.

C. Examining Procedures under the PPH Pilot program

(1) In case the request is settled the applicant is notified of that and the Russian application will receive the right for examination under PPH program. In case the request does not meet the requirements mentioned above the omissions applicant shall be notified of the omissions. The applicant shall have one opportunity to eliminate the omissions within a specified time period. If within the specified time period the omissions are not eliminated the request shall not be satisfied and the application shall be examined under a national procedure. If the necessary correction is made within the specified time period, the request shall be satisfied, the applicant will be notified of that and the Russian application shall receive the right for an examination under the PPH program.

(2) A request in respect of an application, which is already under substantive examination, shall not be satisfied. The applicant must meet all the abovementioned requirements for his application to receive the special status.

Part 2. PPH program using the PCT international work products, prepared by Rospatent and SPTO (PCT-PPH program)

D. Requirements for requesting an examination under the PCT-PPH pilot program

(1) An application for an invention filed with Rospatent on which may be conducted examination under the PCT-PPH program can be any of applications mentioned in the section A if it fulfills all the following requirements:

SPTO

(a) 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 Searching Authority (WO/ISA),

- the Written Opinion of International Preliminary Examining Authority (WO/IPEA) or

- the International Preliminary Examination Report of International Preliminary Examining Authority (IPER/IPEA),

indicates at least one claim as patentable/allowable.

Note that the ISA and the IPEA, which produced the WO/ISA, WO/IPEA and the IPER/IPEA are limited to Rospatent or the SPTO, 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 program on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of the WO/ISA, WO/IPEA, or IPER which forms the basis for the PCT-PPH request, applicant must identify and explain why the claim(s) is/are not subject to any observation described in Box VIII irrespective of whether an amendment is submitted to correct the observation described in Box VIII. The SPTO application will not be eligible to participate in the PCT-PPH pilot program if applicant does not identify and explain why the claim(s) is/are not subject to the observation described in Box VIII.

(b) The relationship between the corresponding SPTO application for which participation in the PCT-PPH pilot program is requested and the PCT application satisfies one of the following requirements (note that RO/-- as used in the diagrams below refers to an international application filed under the PCT in any competent receiving office):

- (i) The application is a national stage entry of the corresponding PCT application. See diagrams (A), (A') and (A'') in Annex II.
- (ii) The application is a national application, which forms the basis for the priority claim in the corresponding PCT application. See diagram (B) in Annex II.
- (iii) The application is a national stage entry of another PCT application (which can be filed in any competent receiving office), which claims priority to the corresponding PCT application. See diagram (C) in Annex II.
- (iv) The application is a national application claiming foreign/domestic priority to the corresponding PCT application. See diagram (D) in Annex II.
- (v) (v) The application has been divided from an application which satisfies one of the above (i) – (iv) scenarios. See diagrams (E1 and E2) in Annex II.

(c) All of the claims in each application for which a request for participation in the PCT-PPH pilot program is made must sufficiently correspond to or be amended to sufficiently correspond to one or more of those claims indicated as patentable/allowable and be free of any observation described in Box VIII in the latest work product of the corresponding PCT application.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format requirements, the claims in the SPTO application are of the same or similar scope as the claims indicated as patentable/allowable () and free of any observation described in Box VIII in the latest work product of the corresponding PCT application, or the claims in the SPTO application are narrower in scope than the claims indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application.

In this regard, a claim that is narrower in scope occurs when a claim indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application is amended to be further limited by an additional feature that is supported in the description and/or claims SPTO application.

(2) Substantive examination of the application for which participation in the PCT-PPH pilot program is requested has not begun.

E. Requirements for Requesting Participation in the PPH–PCT Pilot Program in Rospatent

(1) Request for examination under PCT-PPH program (hereinafter – the request) is submitted in English or Russian language.

The request is submitted on “The Explanation of Circumstances Concerning Accelerated Examination” form, Example Form of which will be available on the website of Rospatent.

The request should contain the SPTO application number, which is the basis for claiming priority, as well as the publication number or the patent number.

Documents listed in paragraph E.(2) should be attached to the request.

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

(2) The applicant should submit the following documents along with the request:

(a) Unless already filed in the SPTO application for which participation in the PCT-PPH pilot program is requested, applicant must submit a copy of the latest international work product, WO/ISA, WO/IPEA or IPER, which indicated that the claim(s) is/are patentable/allowable along with the translation in Russian and English languages thereof.

In case the application satisfies section D (b) (i), the applicant shall **not** submit a copy of the Written Opinion of the International Searching Authority (WO/ISA) or the International Preliminary Report on Patentability (IPRP/IPEA) because a copy of these documents is already contained in the dossier of the application. In addition, if the copy of the latest international work product is available via “PATENTSCOPE”, an applicant need not submit these documents, unless otherwise requested by the patent Office (WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II”

respectively in 30 months after the priority date.) Russian and English translations of the WO/ISA, IPER/IPEA or WO/ISA, if there is any, shall always be submitted.

(b) Copy of the claims from the corresponding PCT application that were indicated as patentable/allowable(in the latest work product of the PCT application along with a Russian translation (professional translation) thereof and a statement that the Russian translation is accurate if the claims are not in the Russian language.

If the copy of the set of claims, which are indicated as patentable/allowable, is available via “PATENTSCOPE” (or the international Patent Gazette has been published), an applicant need not submit this document, unless otherwise requested by Rospatent. Where translations of the patentable/allowable () claims are necessary, an applicant must submit them the Russian translation.

(c) Applicant must submit copies of all the documents cited in the international work products of the PCT application corresponding to the SPTO application.

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

(d) An applicant must submit a claim correspondence table to explain the correspondence of claims determined to be patentable/allowable () in the latest work product of the corresponding international application and all claims in the application.

If the claims are identical, such an indication should be made in the table. If the claims are not identical, the table should contain explanations in respect of correspondence of each claim in compliance with requirements mentioned in paragraph D(1)(c).

If an applicant has already filed to Rospatent the documents mentioned in paragraphs (a)-(d) in Russian, simultaneously or earlier, he has the right just to refer to these documents.

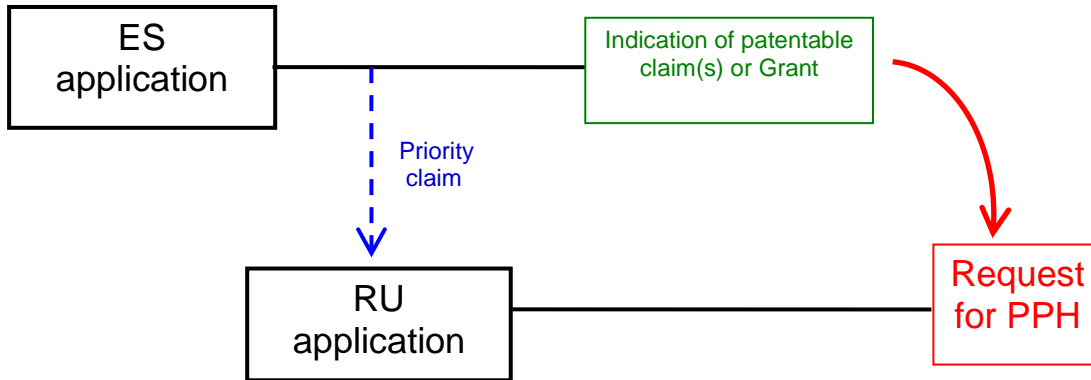
F. Examining Procedures under the PPH-PCT Pilot program

(1) Where the request for participation in the PCT-PPH pilot program and special status are granted, applicant will be notified and the SPTO application will be advanced for examination under the PCT-PPH program. In those instances where the request for participation in the PPH pilot program does not meet all the requirements set forth above, applicant will be notified and the defects in the request will be identified. The applicant shall have one opportunity to eliminate the omissions within a specified time period. If within the specified time period the omissions are not eliminated the request shall not be satisfied and the application shall be examined under a national procedure. If the necessary correction is made within the specified time period, the request will be satisfied, the applicant shall be notified of that and the Russian application shall receive the right for examination under the PCT-PPH program.

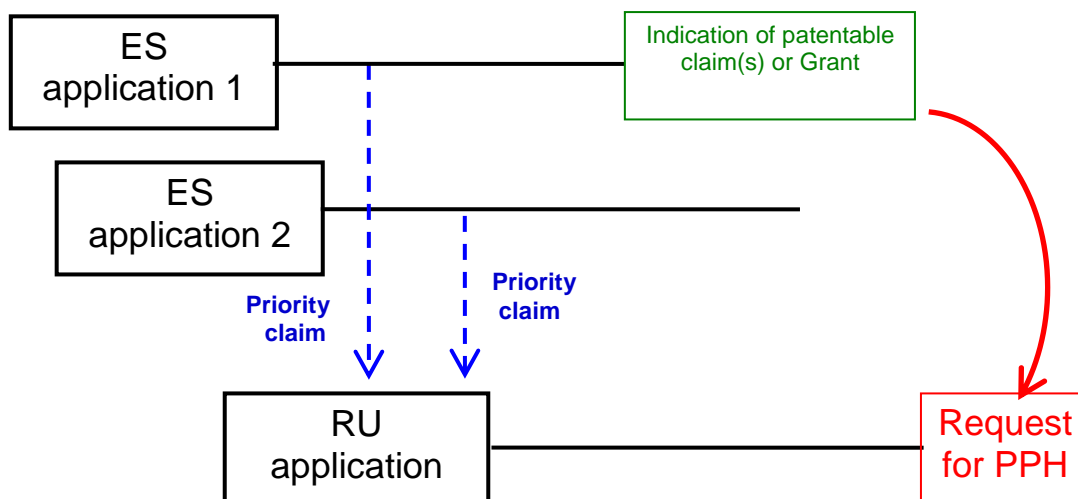
(2) A request in respect of an application, which is already under substantive examination, shall not be satisfied. The applicant must meet all the abovementioned requirements for his application to receive the special status.

Annex I

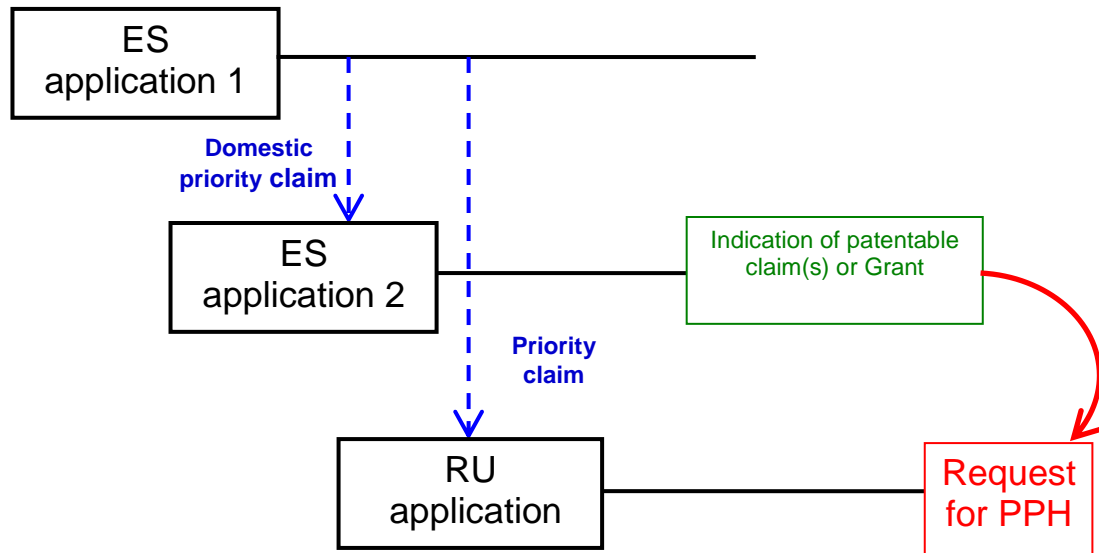
RU application with single Paris Convention priority claim to an application filed in SPTO



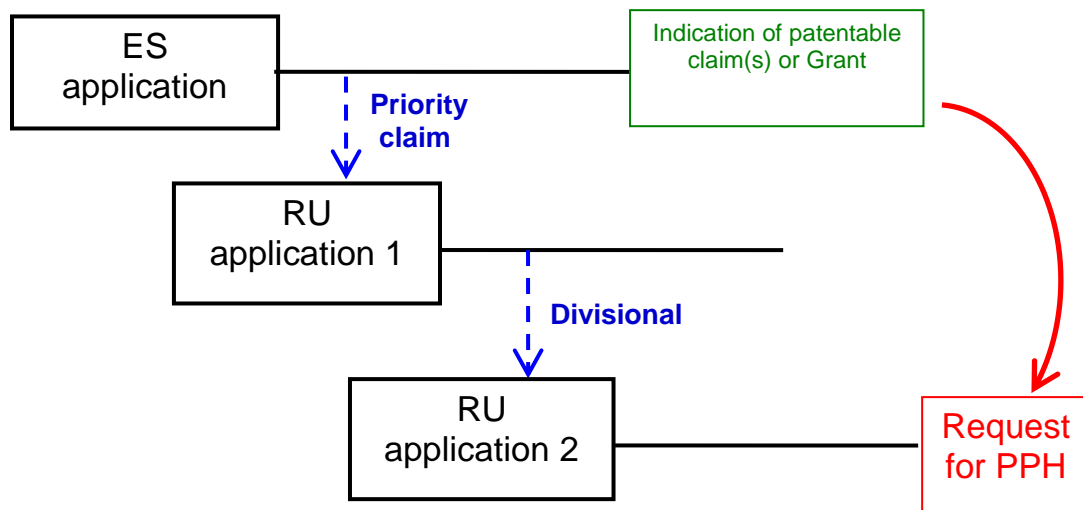
RU application with a complex Paris Convention priority



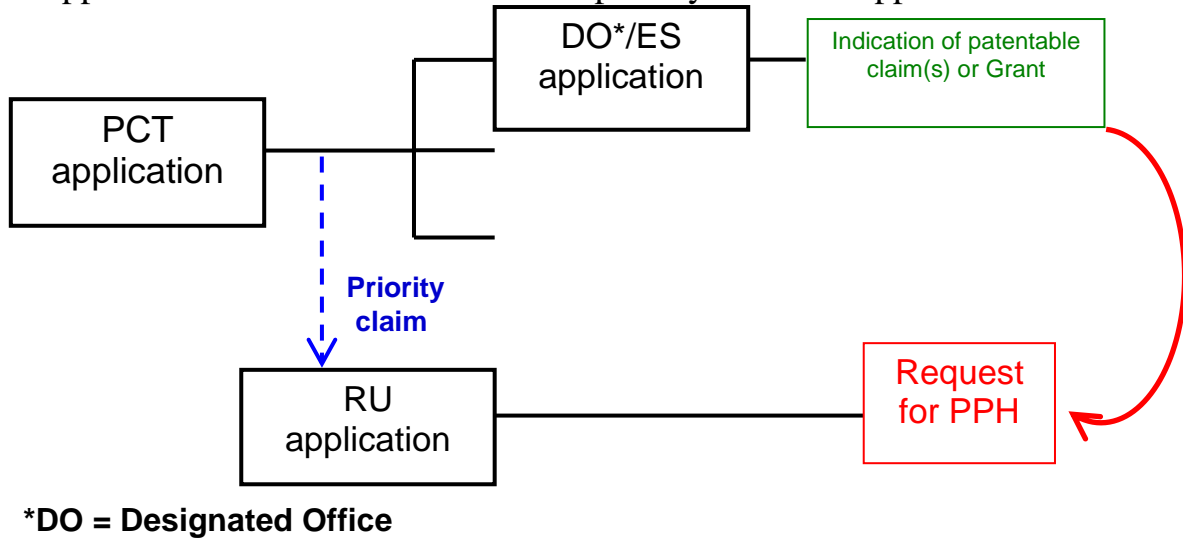
Paris route and domestic priority



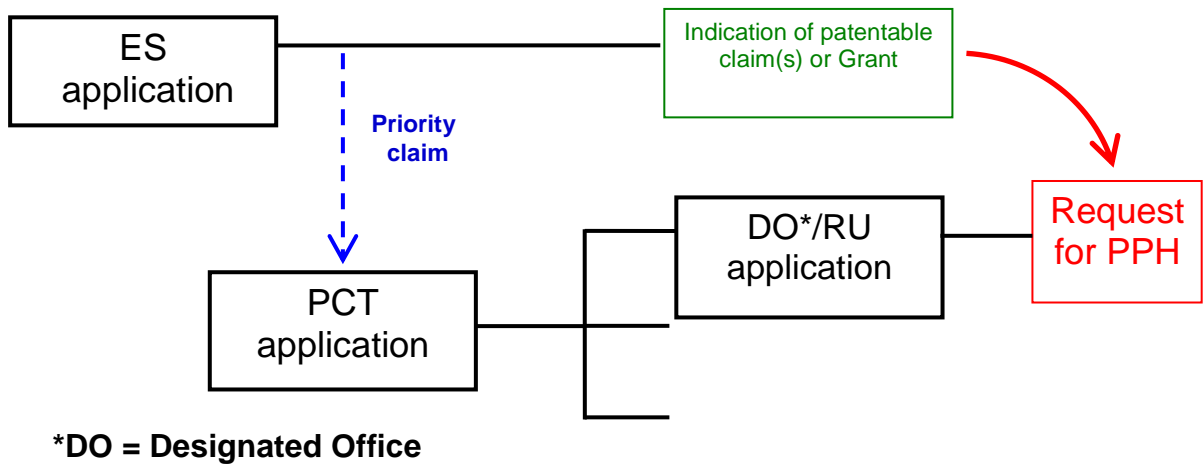
Paris route and divisional application



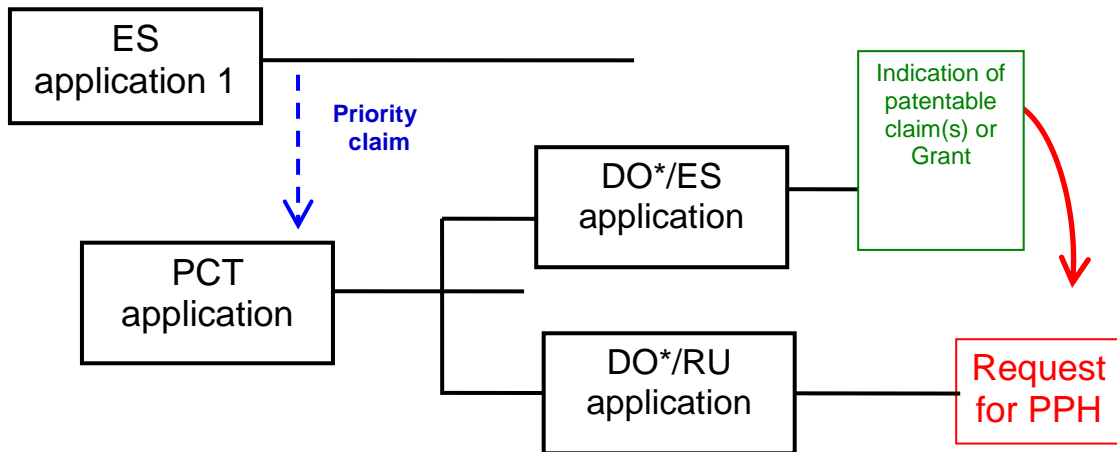
RU application claims Paris Convention priority to a PCT application



RU application is a national stage of a PCT application which claims Paris Convention to a ES application

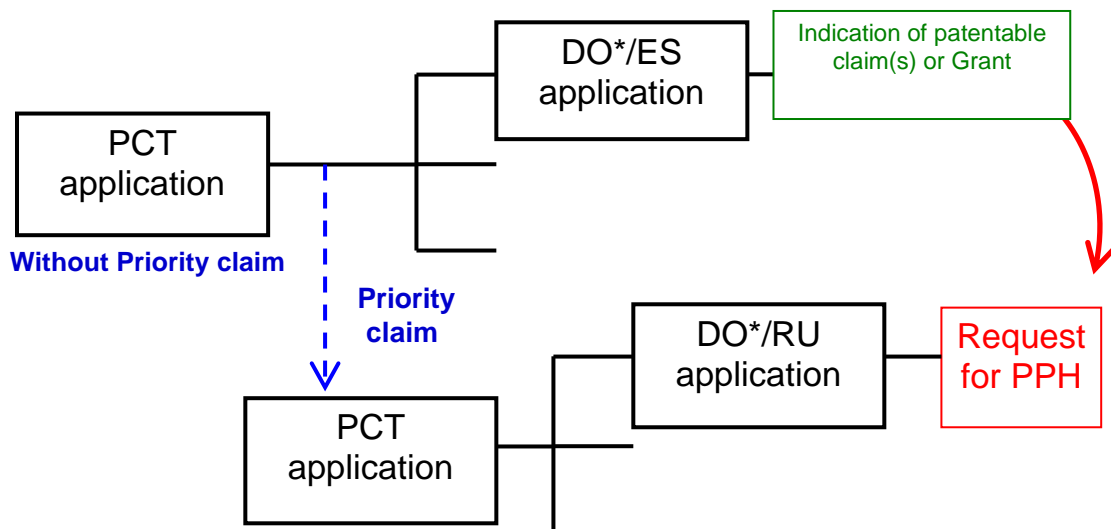


PCT ROUTE



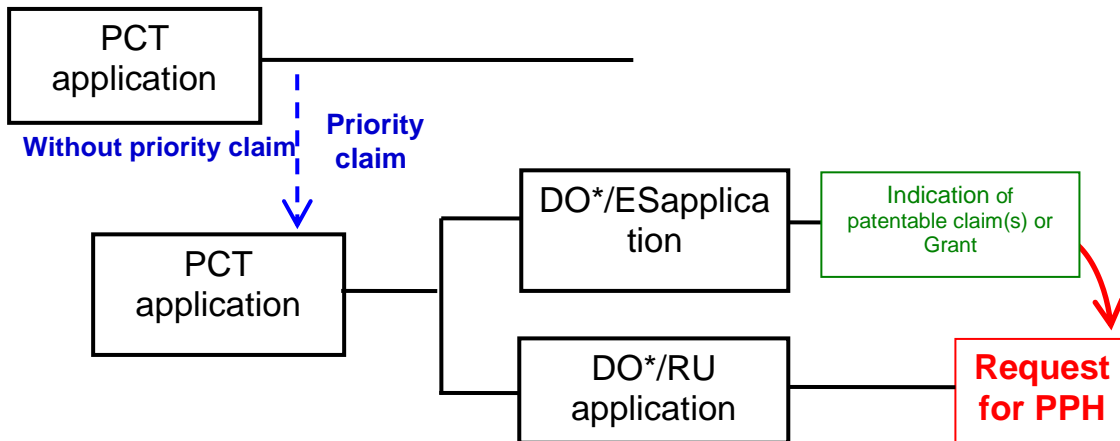
***DO = Designated Office**

RU application is a national stage of a PCT application which claims Paris Convention priority to another PCT application



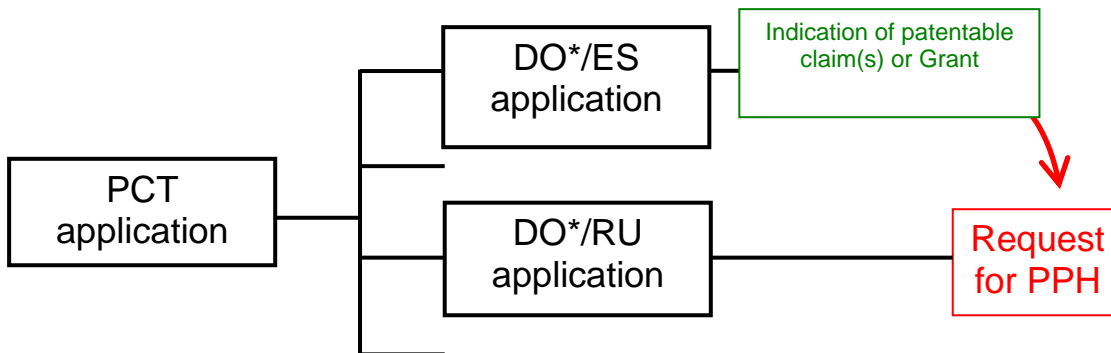
***DO = Designated Office**

Direct PCT and PCT Route



***DO = Designated Office**

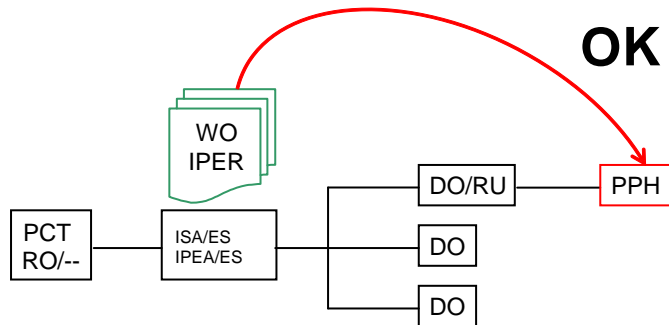
RU application is a national stage of a PCT application without priority claim



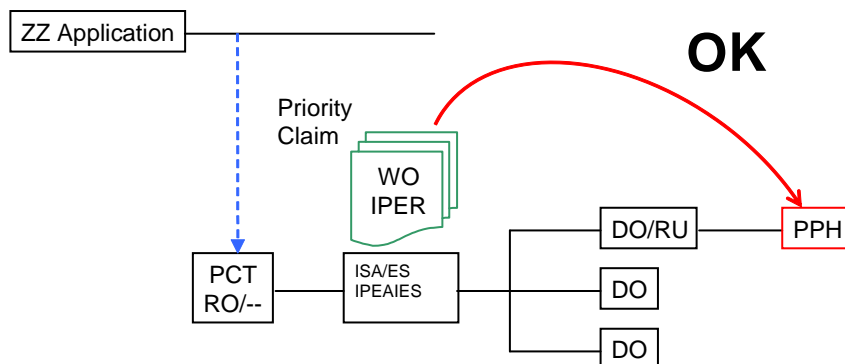
***DO = Designated Office**

Annex II

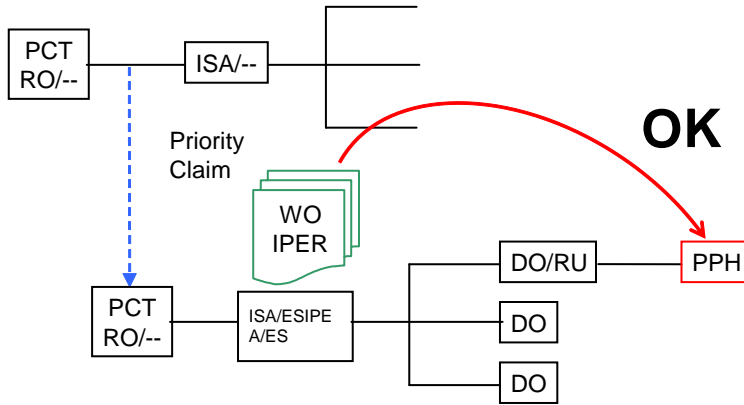
(A) The application is a national stage entry of the corresponding PCT application.



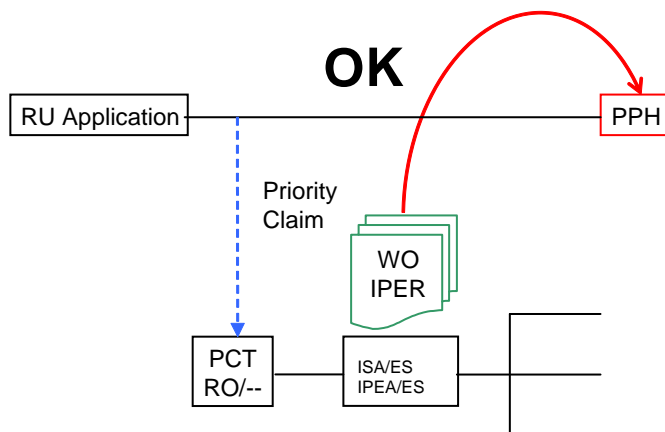
**(A') The application is a national stage entry of the corresponding PCT application.
(The corresponding PCT application claims priority to a national application filed anywhere.)**



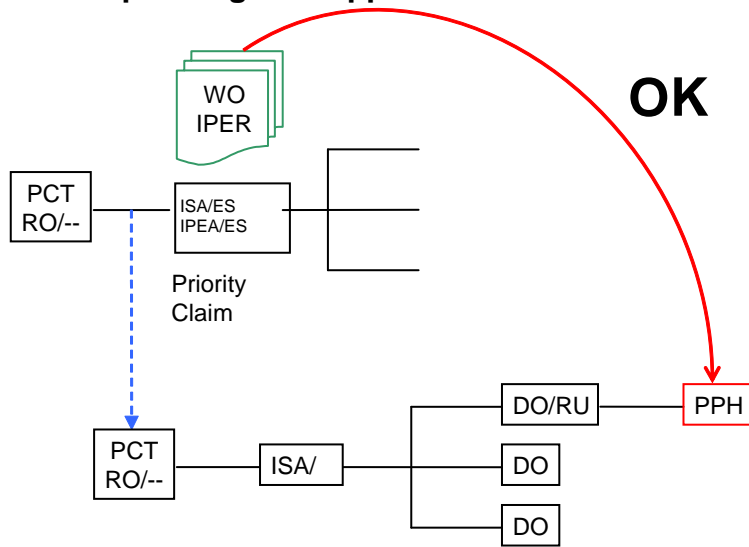
**(A'') The application is a national stage entry of the corresponding PCT application.
(The corresponding PCT application claims priority to another PCT application.)**



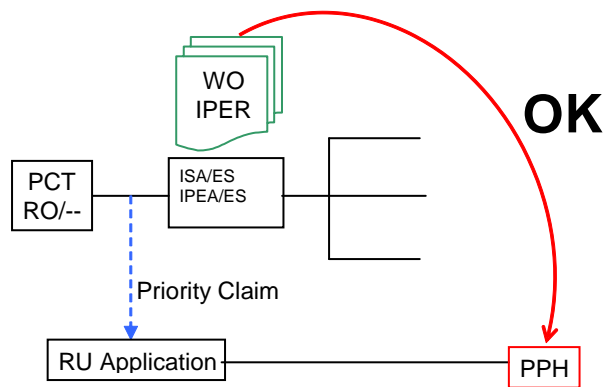
(B) The application is a national application which forms the basis for the priority claim in the corresponding PCT application.



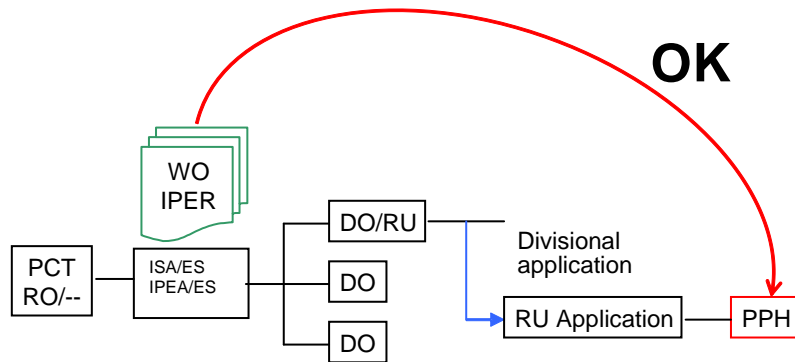
(C) The application is a national stage entry of a PCT application which claims priority to the corresponding PCT application.



(D) The application is a national application claiming priority to the corresponding PCT 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 (B)

