

**Procedures to file a request to the
National Board of Patents and Registration of Finland
for the Patent Prosecution Highway
Pilot Program between the
State Intellectual Property Office of The P. R. of China (SIPO)
and the
*National Board of Patents and Registration of Finland (NBPR)***

The pilot period of this PPH pilot program commenced on January 1, 2013 for a duration of one year and ending on December 31, 2013. According to the agreement between the SIPO and the NBPR, the PPH pilot program will be extended for an indefinite time period, starting on January 1, 2014.

The Offices may terminate the PPH program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH program is terminated

Request to the NBPR

[0001]An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the NBPR by submitting an application requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the NBPR for accelerated examination under the PPH are given in the following sections. Relevant supporting documentation is discussed in a later section (paragraphs [0003] to [0004]) as is the general NBPR application procedure envisaged at this time (paragraph [0005]).

The request form is available online on the NBPR website at http://www.prh.fi/en/patentit/pph/request_for_pph.html

Part I- PPH using national work products from SIPO

Requirements for requesting accelerated examination under the PPH Pilot Program at the NBPR

[0002] There are four requirements for requesting accelerated examination under the PPH pilot program at the NBPR. These are:

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

Examples are provided in Annex 1.

- b) At least one corresponding SIPO application has one or more claims that are determined to be patentable/allowable by SIPO examiner in the latest office action, even if the application is not granted patent yet.

SIPO office actions include:

- (a) Decision to Grant a Patent
- (b) First/Second/Third/...Office Action,
- (c) Decision of Refusal,
- (d) Reexamination Decision, and
- (e) Invalidation Decision.

Claims are also “determined to be allowable/patentable” in the following circumstances: If the SIPO office action does not explicitly state that a particular claim is allowable/patentable, the applicant must include explanation accompanying the request for participation in the PPH pilot program that no rejection has been made in the SIPO office action regarding that claim, and therefore, the claim is deemed to be allowable/patentable by the SIPO.

For example, if claims are not shown in the item of “6. the Opinion on the Conclusion of Examination (审查的结论性意见) about Claims (关于权利要求书)” in the “First Notice of the Opinion on Examination(第一次审查意见通知书)” or “5. the Opinion on the Conclusion of

Examination (审查的结论性意见) about Claims (关于权利要求书)” in the “Second/Third/...Notice of the Opinion on Examination(第一次审查意见通知书)” of the SIPO, those claims may be deemed to be implicitly identified to be allowable/patentable and then the applicant must include the above explanation.

- c) All claims on file, as originally filed or as amended, for examination at NBPR under the PPH must sufficiently correspond to one or more of those claims indicated as patentable/allowable in SIPO in order for the NBPR application to qualify for accelerated examination under the PPH at the NBPR.

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

In this regard, a claim that is narrower in scope occurs when a SIPO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). Narrower claims can be written as dependent claims

A claim in the NBPR application which introduces a new/different category of claims to those claims indicated as allowable in SIPO is not considered to sufficiently correspond. If, for example, the SIPO claims only contain claims to a process of manufacturing a product, then the claims in the NBPR application are not considered to sufficiently correspond if the claims of the NBPR 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 PPH Pilot Program do not need to sufficiently correspond to the claims indicated as patentable/allowable in the SIPO application.

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

Required documents for accelerated examination under the PPH Pilot Program at the NBPR

[0003] The following documentation is needed to support a request for accelerated examination under the PPH pilot program at the NBPR:

- a) a copy of all office actions (which are relevant to the patentability) in the corresponding SIPO application(s), and translations of them. Office actions are documents which relate to substantive examination and

which were sent to the applicant by the SIPO examiner. The applicant can either provide the office actions together with the request for acceleration under the PPH or request that the NBPR obtain the documents from the SIPO document database.

Both Finnish and English are acceptable as translation languages. Machine translations are 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.

- b) a copy of the claims found to be patentable/allowable by SIPO and translations of them. The applicant can either provide the claims together with the request for acceleration under the PPH or request that the NBPR obtain the claims from the SIPO document database. Both Finnish and English are acceptable as translation languages. The indications provided in the requirement [0003](a) above regarding machine translations also apply to this requirement [0003](b).

a complete claim correspondence table showing the relationship between the claims of the NBPR application for accelerated examination under the PPH and the claims of the corresponding SIPO application considered patentable/allowable by SIPO.

The claims correspondence table must indicate how the claims in the NBPR application correspond to the patentable/allowable claims in the SIPO application. The claim correspondence table must be written in Finnish or English.

- c) copies of the references cited by the SIPO examiner. If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the NBPR. If the NBPR does not have access to relevant patent documents, the applicant must submit these documents at the request of the NBPR. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

In those rare situations where the SIPO application has not been published, and therefore the SIPO file wrapper is not available via the SIPO document database, the applicant will be responsible for providing the necessary documents to the NBPR.

[0004] The relevant information is provided by the applicant by filling out the form for requesting accelerated examination under the PPH Pilot Program (see Annex 3) which is available on the NBPR web site. The relevant supporting documentation should be attached.

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

Procedure for accelerated examination under the PPH Pilot Program at the NBPR

[0005] The applicant fills out the form requesting accelerated examination under the PPH Pilot Program available on the NBPR web page http://www.prh.fi/en/patentit/pph/request_for_pph.html and includes all the relevant supporting documents. 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 until the NBPR issues a "Communication of Acceptance".

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.

Part II- PPH using the PCT international work products from the SIPO

Request to the NBPR

[0001] An applicant 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-SIPO 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 levels, or for any other reason. Notice will be published if the PCT-PPH Pilot Program is terminated.

Requirements for requesting accelerated examination under the PCT-PPH Pilot Program at the NBPR

[0002] The application which is filed with the NBPR and to which the applicant files a request under the PCT-PPH must satisfy the following requirements:

- 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 Examining Authority (WO/IPEA), or the Preliminary Examination Report (IPER), indicates that at least one claim is patentable/allowable.

Note that the ISA and the IPEA which produce the WO/ISA, WO/IPEA, and the IPER are limited to SIPO, but if priority is claimed, the priority claim can be referred 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 the fact that an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in the 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 will not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation in Box VIII.

- b) the relationship between the application and the corresponding international application satisfies one of the following requirements:
- i) the application is a national phase application of the corresponding international application (see figures A, A' and A'' in Annex 2)
 - ii) the application is a national application as a basis of the priority claim of the corresponding international application (see figure B in Annex 2)
 - iii) the application is a national phase application of an international application claiming priority from the corresponding international application (see figure C in Annex 2).
 - iv) The application is a national application claiming priority from the corresponding international application (See figure D in Annex 2)
 - v) The application is the derivative application (divisional application etc.) of the application which satisfies one of the above requirements (i)-(iv). (See figures E1 and E2 in Annex 2.)
- c) all claims, 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 product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims) of the application. Narrower claims can be written as dependent claims.

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, if 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 product.

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

Required documents for accelerated examination under the PCT-PPH Pilot Program at the NBPR

[0003] The following documentation will be needed to support a request for accelerated examination under the PCT-PPH Pilot Program at the NBPR:

- a) 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 [0002](b)(i), the applicant does not need to 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®’, then the applicant does not need to 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).

Both Finnish and English are acceptable as translation languages. Machine translations are 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.

- b) a copy of the 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. The indications provided in the requirement [0003](a) above regarding machine translations also apply to this requirement [0003](b).

If the copy of the set of claims which are indicated to be patentable/allowable is available via ‘PATENTSCOPE®’¹, e.g. the international Patent Gazette has been published, the applicant need not submit this document unless otherwise requested by the NBPR.

- c) a copy of the references cited in the latest international work product of the international application corresponding to the application.

¹<http://www.wipo.int/pctdb/en/search-adv.jsp>

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 references are unnecessary.

- d) a complete claim correspondence table showing the relationship between the claims of the NBPR application for accelerated examination under the PCT-PPH and the claims indicated to be patentable/allowable.

If the claims simply are literal translations, then it is sufficient that the applicant writes 'They are the same' in the table. If the claims are not literal translations, then it is necessary to explain the sufficient correspondence of each claim based on the criterion [0002](c). The claim correspondence table must be written in Finnish or English.

[0004] If the applicant has already submitted the above-mentioned documents (a)-(d) to the NBPR through simultaneous or past procedures, then 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

[0005] The applicant fills out the form requesting accelerated examination under the PCT-PPH Pilot Program (see Annex 4) available on the NBPR web page http://www.prh.fi/en/patentit/pph/request_for_pph.html and includes all the relevant supporting documents. The PCT-PPH Administrator, who is a NBPR patent examiner, will consider the request. If all requirements for accelerated examination under the PCT-PPH have not been met, then the PCT-PPH Administrator will notify the applicant that the application has not been allowed entry to the PCT-PPH and will provide an explanation as to why entry to the PCT-PPH was denied. The applicant is free to take any possible correcting action necessary and again request acceleration under the PCT-PPH until the NBPR issues a "Communication of Acceptance".

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

ANNEX 1

Examples of NBPR applications eligible for PPH

Figure A:

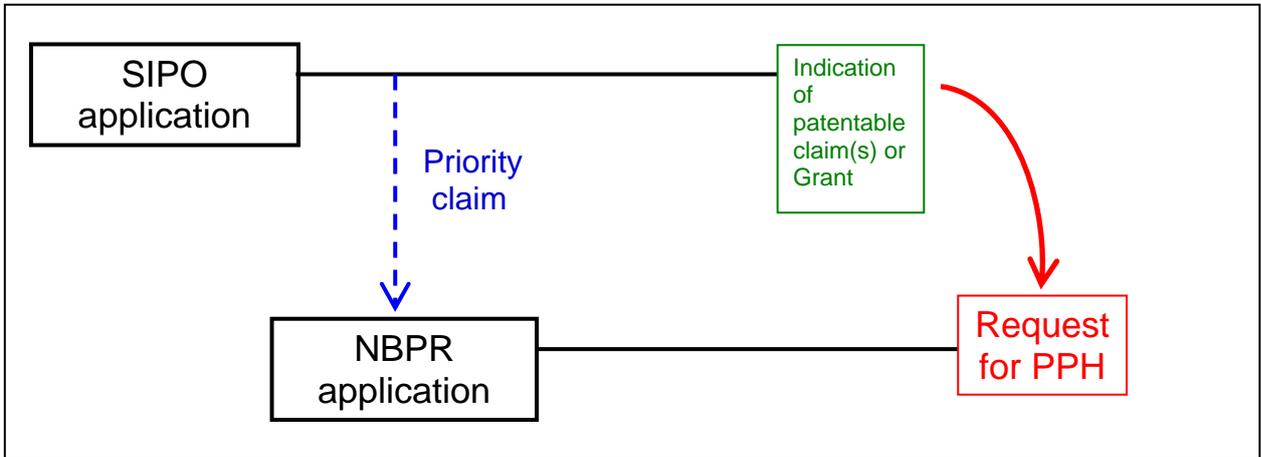
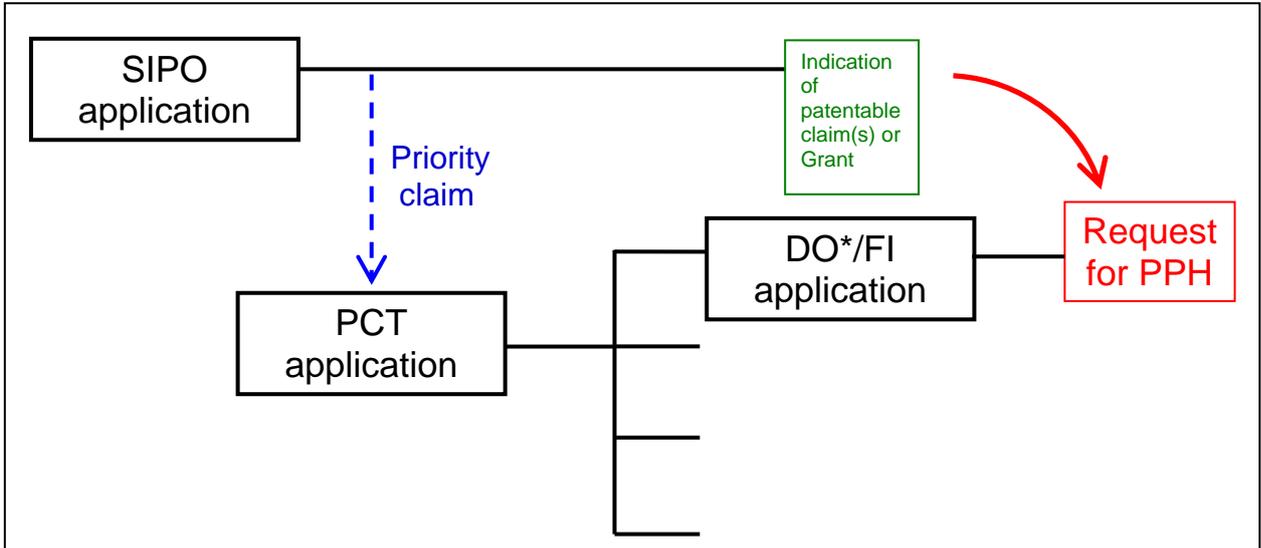


Figure B:



* DO – Designated Office

Figure C:

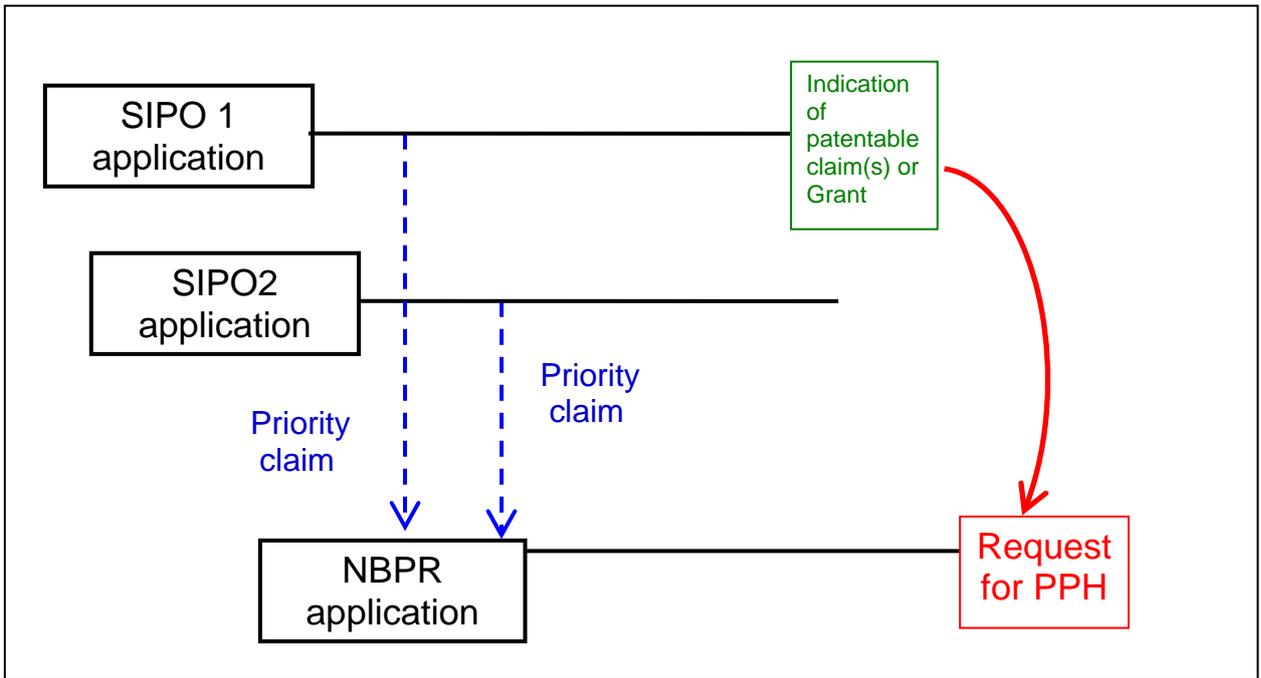


Figure D:

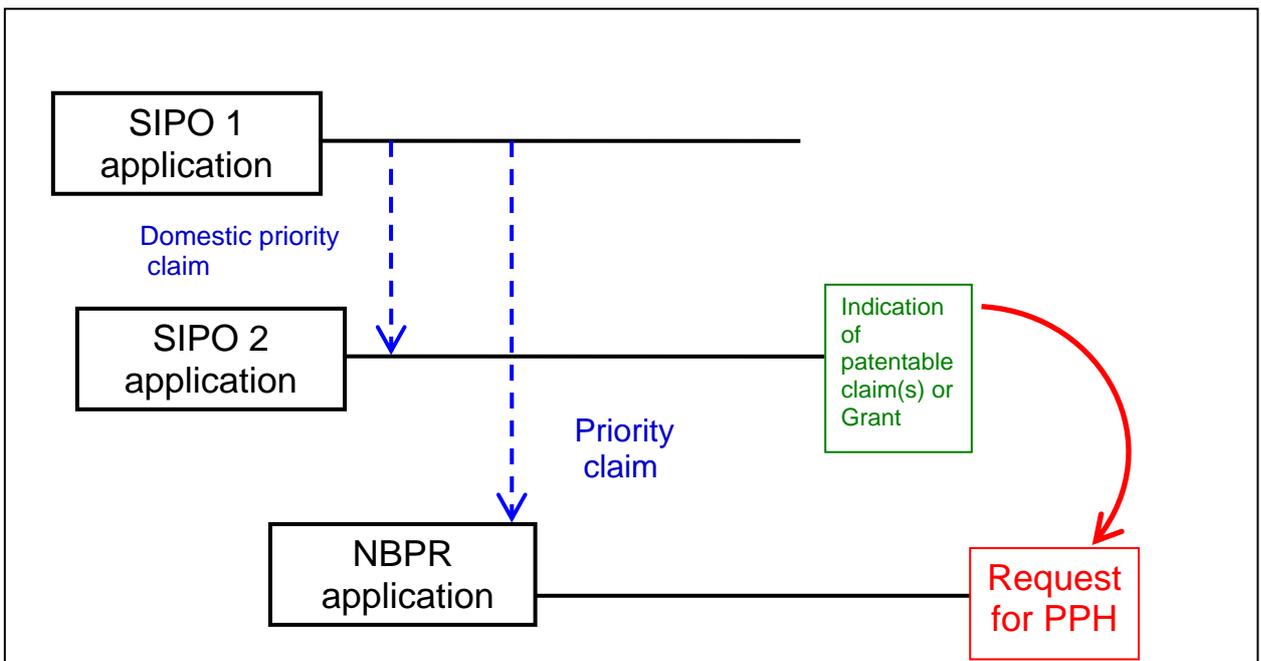


Figure E:

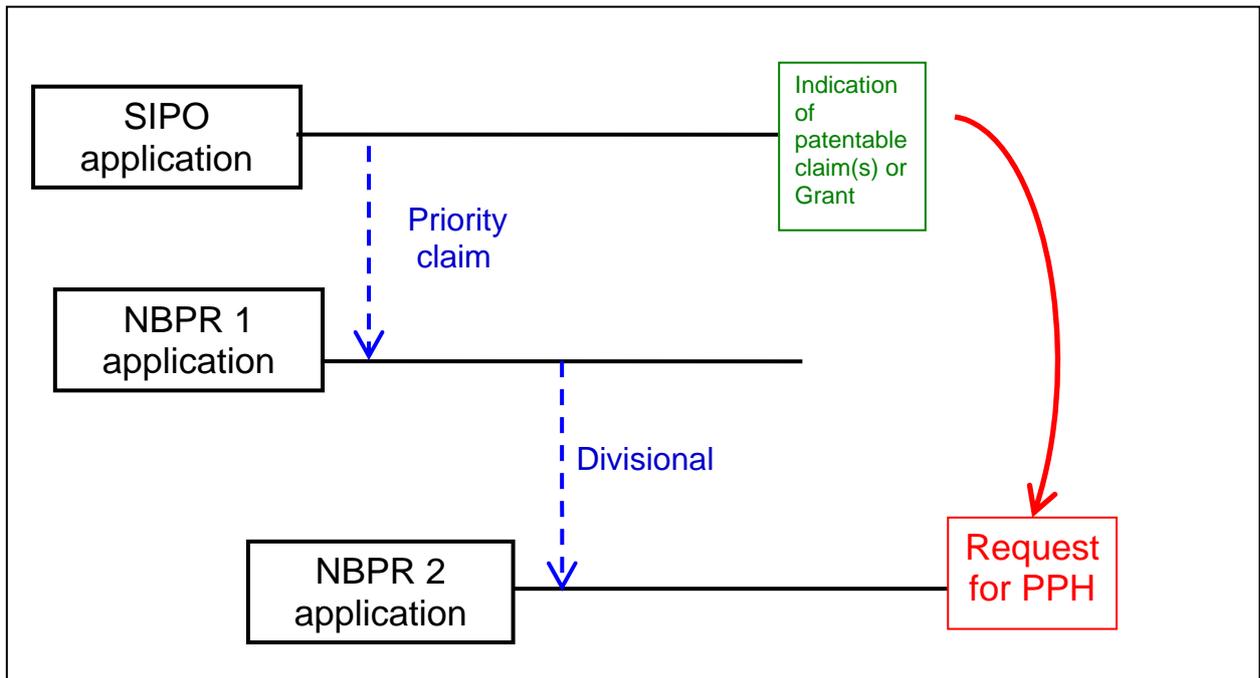


Figure F:

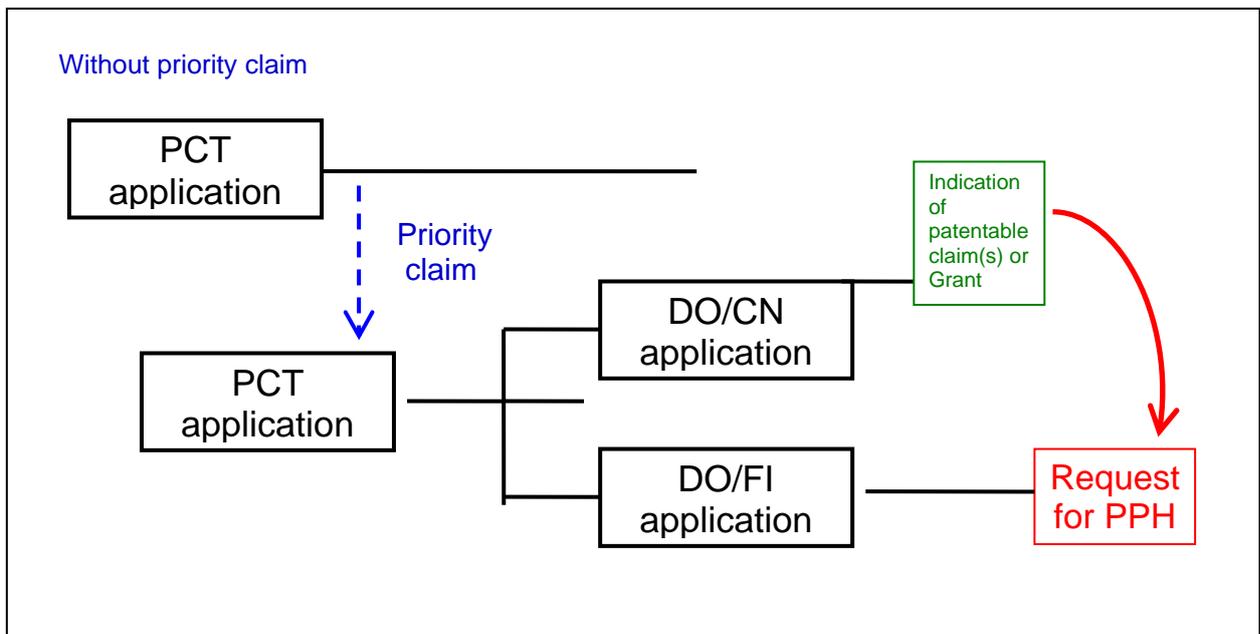


Figure G:

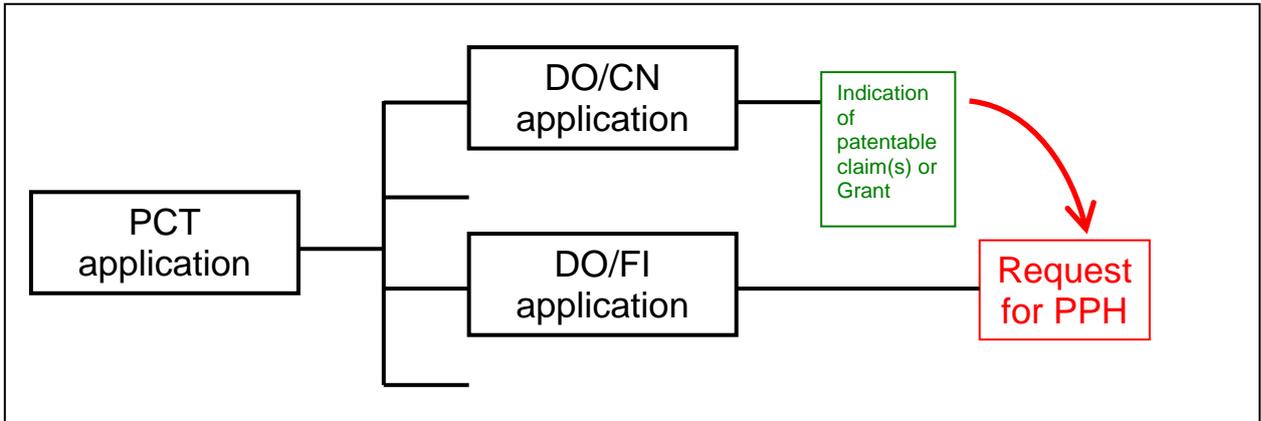


Figure H:

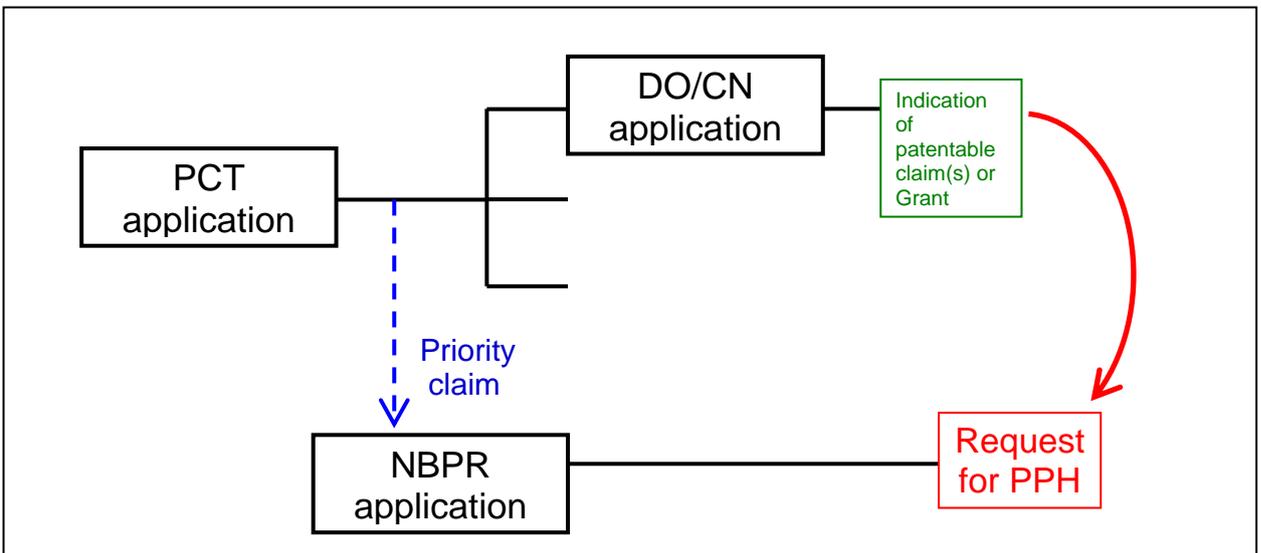


Figure I:

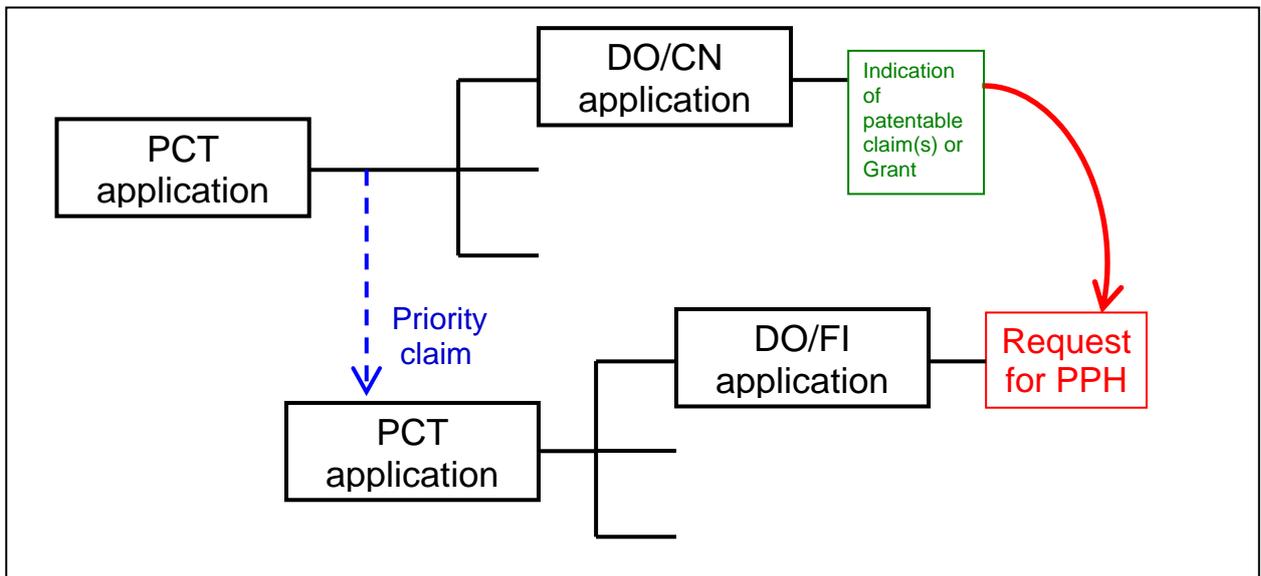
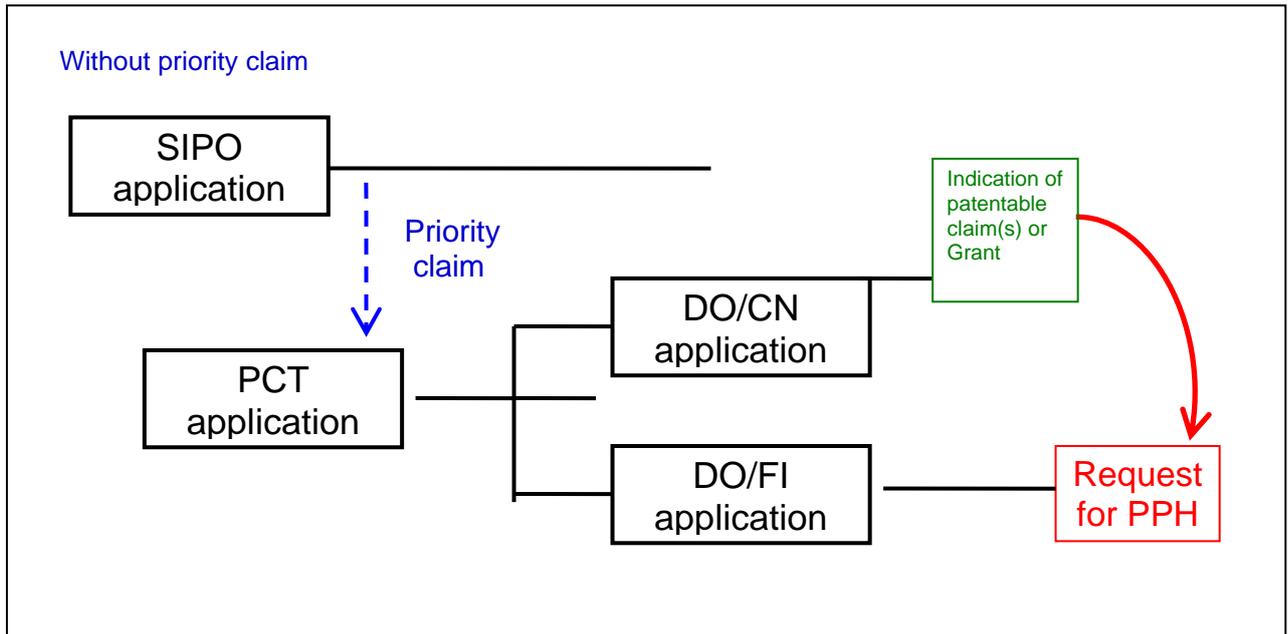


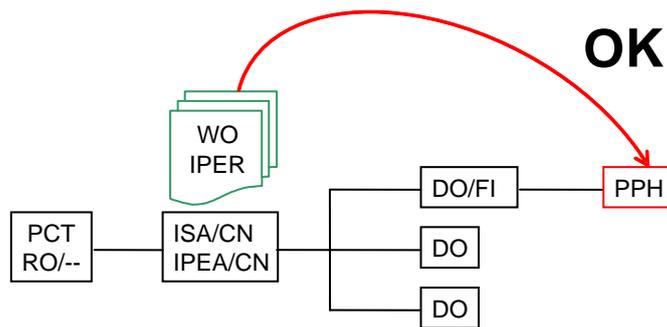
Figure J:



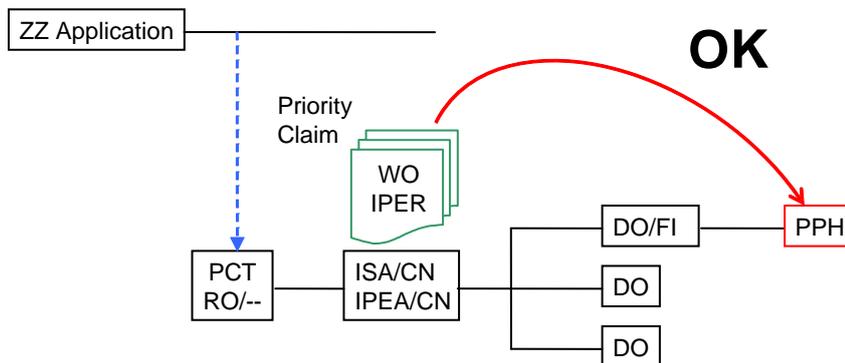
ANNEX 2

Examples of the applications eligible for PCT-PPH

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

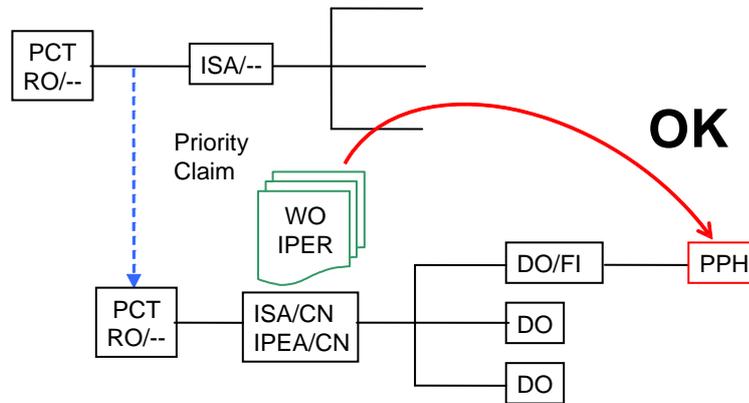


**(A') The application is a national phase application of the corresponding international application.
(The corresponding international application claims priority from a national application.)**

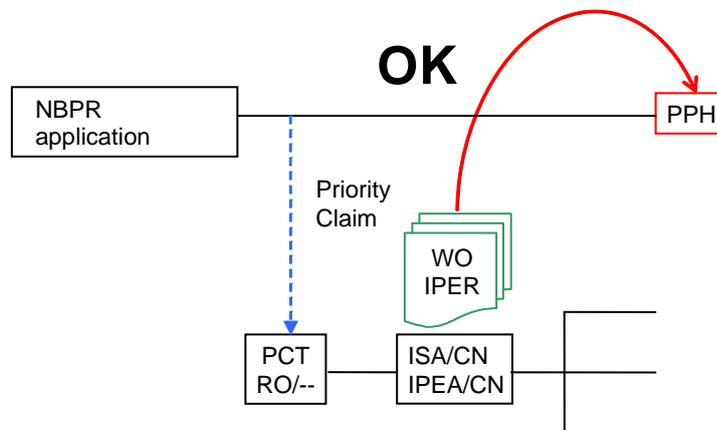


ZZ=any office

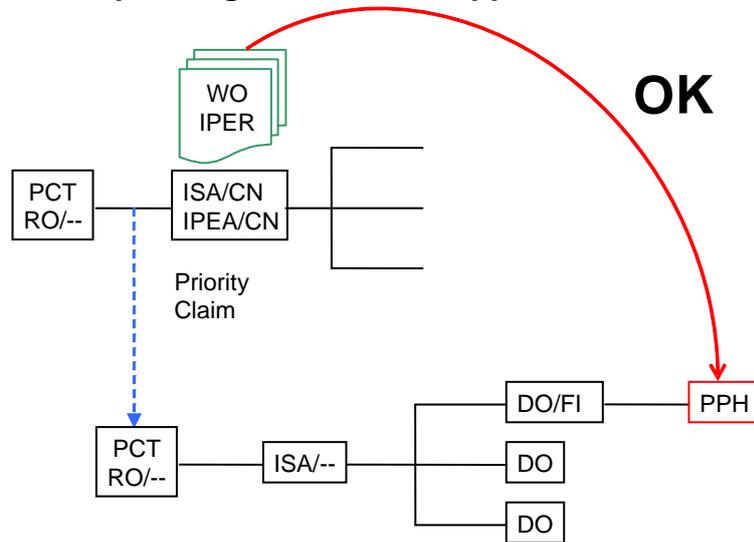
**(A'') The application is a national phase application of the corresponding international application.
 (The corresponding international application claims priority from an international application.)**



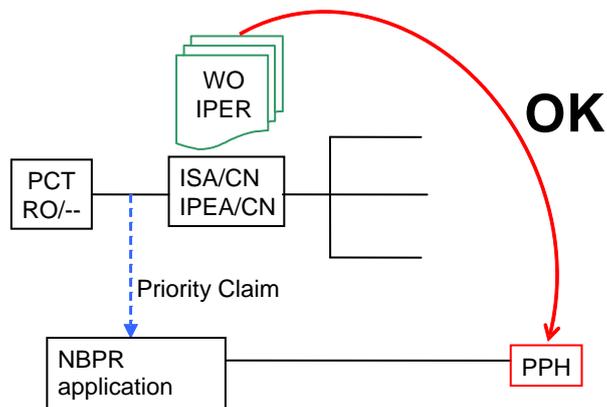
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



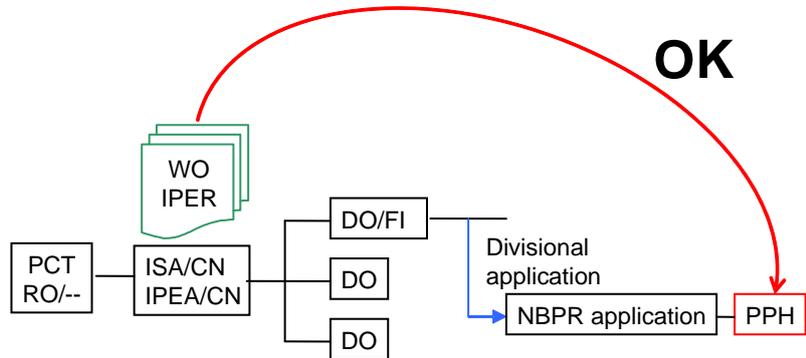
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



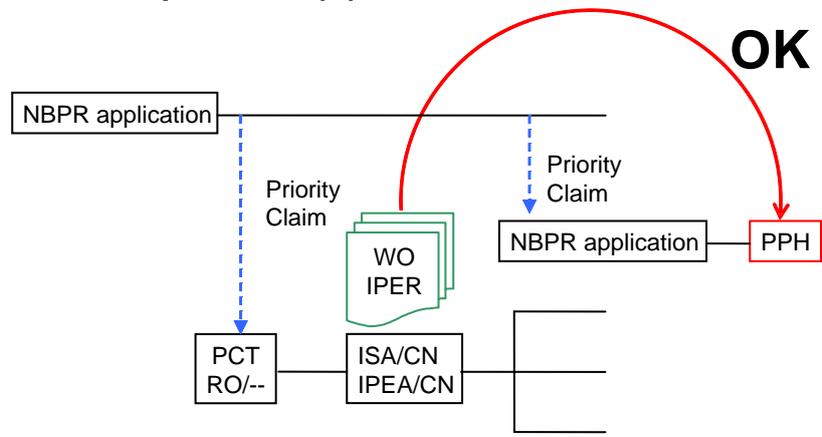
(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



(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).



ANNEX 3

Example form



PPH REQUEST

Date of request

Request for Accelerated Examination at the NBPR under the Patent Prosecution Highway Program between the NBPR and the

- 1 NBPR application number
- 2 Corresponding application number(s):
- 3 Either:
 - a) a copy of the original office action(s) in English attached
 - b) a copy of the original office action(s) translated into either English or Finnish attached
 - c) office action(s) available in English via document database
 - d) office action(s) on file from previous PPH application
NBPR application number
- 4 Either:
 - a) a copy of claims of the corresponding application in English attached
 - b) a copy of the original claims of the corresponding application translated into English or Finnish attached
 - c) claims of corresponding application available via document database
 - d) application claims on file from previous PPH application
NBPR application number
- 5 Translated version of foreign language citation attached
(Please note that it is not necessary to provide translation of the documents. However, applicant will be free to file translation to allow prompt consideration of the citation if they so desire.)
- 6 Claim correspondence table completed

ANNEX 4

Example form



PCT-PPH REQUEST

Date of request

Request for Accelerated Examination at the NBPR using the PCT international work products under the Patent Prosecution Highway Program between the NBPR and the

NBPR application number

Corresponding PCT application number(s):

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

- | | | |
|---|---|--|
| 1 | Either:
a) a copy of WO-ISA or IPER and translation thereof in English or Finnish
b) request to obtain documents in 1a via Patentscope ® | <input type="checkbox"/>
<input type="checkbox"/> |
| 2 | Either:
a) a copy of all claims determined to be patentable/allowable by the ISA or IPEA
b) request to obtain documents in 2a via Patentscope ® | <input type="checkbox"/>
<input type="checkbox"/> |
| 3 | Translation of documents in 2 in English or Finnish | <input type="checkbox"/> |
| 4 | Copies of all documents cited in the WO-ISA or IPER (except for patent documents) | <input type="checkbox"/> |
| 5 | Claim correspondence table completed | <input type="checkbox"/> |

