

# **Patent Prosecution Highway Pilot Program between the Federal Service on Intellectual Property, Patents & Trademarks of Russia and the United States Patent and Trademark Office**

## **I. Background**

The Federal Service for Intellectual Property, Patents and Trademarks of Russia (Rospatent) in cooperation with the Japan Patent Office has launched the first Pilot program of the Patent Prosecution Highway (PPH). PPH allows an accelerated patent examination in both offices for the applicant to receive patents faster and in a more rational way. PPH allows the Office of the Second Filing to make use of the work already carried out by the Office of the First Filing reducing the workload and improving the quality of the patents. Rospatent and the Japan Patent Office have started the program on May 18, 2009.

A similar agreement was signed by Rospatent with the Korean Intellectual Property Office. The Agreement has started on November 2, 2009.

Following these partnership undertakings Rospatent and the United States Patent and Trademark Office have agreed to launch a PPH Pilot program similar to the Pilot programs mentioned above.

## **II. Patent Prosecution Highway Pilot Program**

The PPH was established to enable an applicant whose claims are determined to be patentable 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, the applicant may request accelerated examination at the USPTO for the corresponding application filed with the USPTO as the OSF. The procedures and requirements for filing a request with the USPTO for participation in the PPH pilot program will be available on July 1, 2010, from the USPTO Web site [://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp)

Where Rospatent is the OSF and the corresponding application filed with the USPTO as the OFF contains claims that are determined to be patentable, 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.

### **A. Trial Period for the PPH Pilot Program**

The PPH pilot program will commence on September 1, 2010, for a period of one year ending on August 30, 2011. The trial period may be extended for up to an additional year if necessary to adequately assess the feasibility of the PPH program. The USPTO 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 early 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 the August 30, 2011.

### **B. Requirements for Requesting Participation in the PPH Pilot Program in the USPTO**

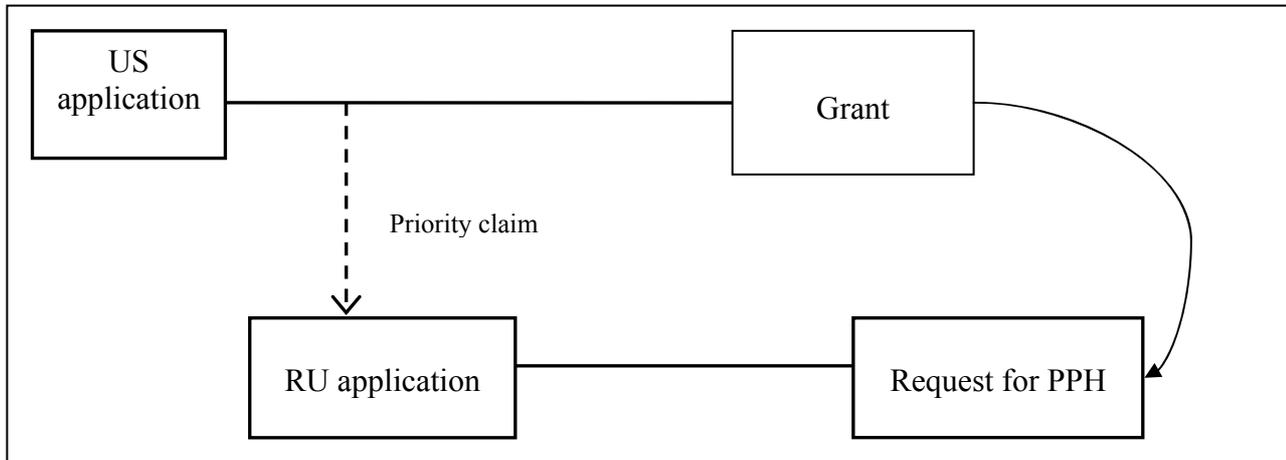
In order to be eligible to participate in the PPH pilot program, the following conditions must be met:

- (1) Accelerated examination can be conducted in respect of the following applications for inventions:
- application filed with Rospatent in compliance with the requirements of the national legislation validly claiming conventional priority based on one or several applications filed with the USPTO;
  - an international application filed with the USPTO as a receiving office transferred to the national phase in Rospatent;
  - an international application filed with the USPTO as a receiving office claiming conventional priority and transferred to the national phase in Rospatent;
  - a divisional application from those mentioned above.

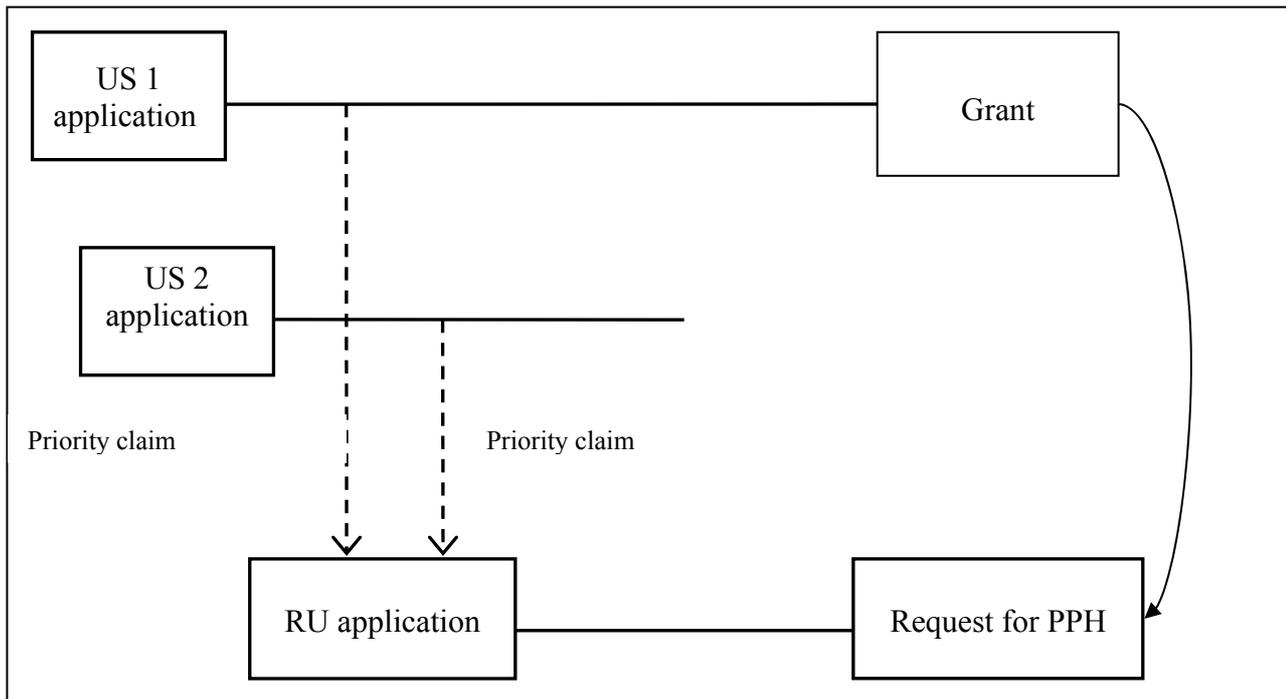
Examples of Russian applications in respect of which the accelerated examination can be conducted:

(1)(a)(i):

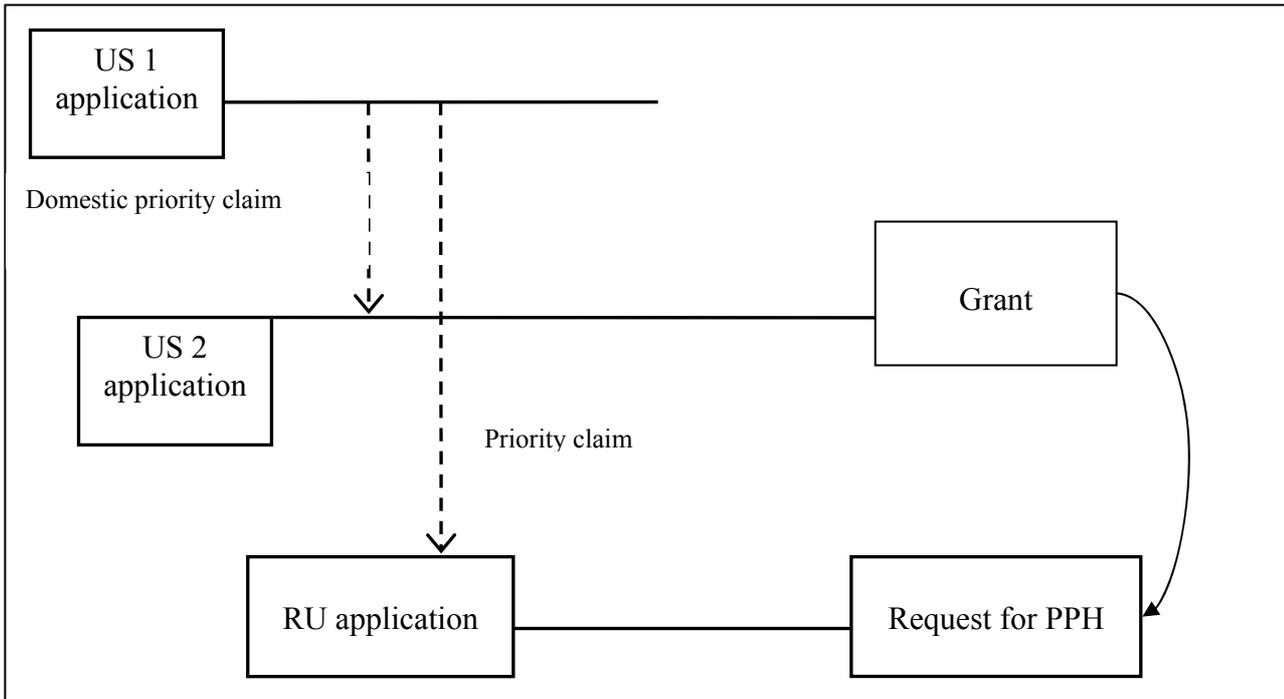
- Russian application filed under the Paris Convention with one priority date of a USPTO application



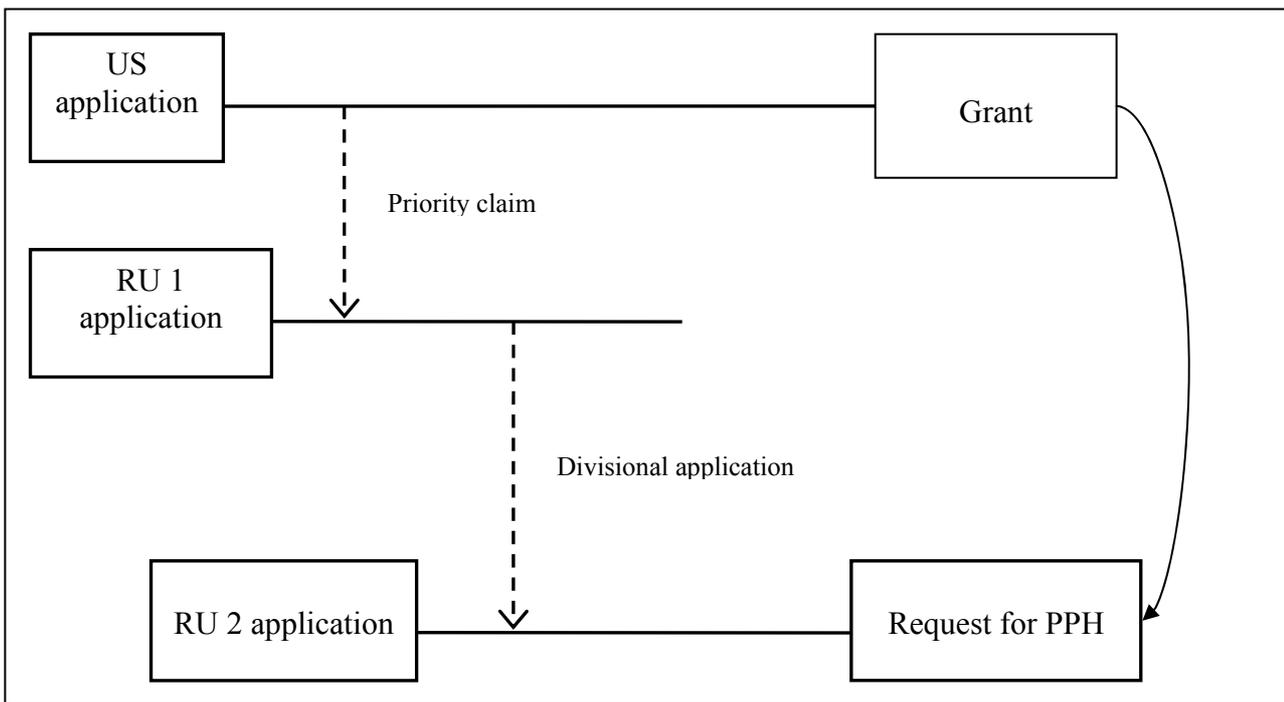
- Russian application filed under the Paris Convention with several priority dates of several USPTO applications



- Russian application filed under the Paris Convention claiming domestic priority

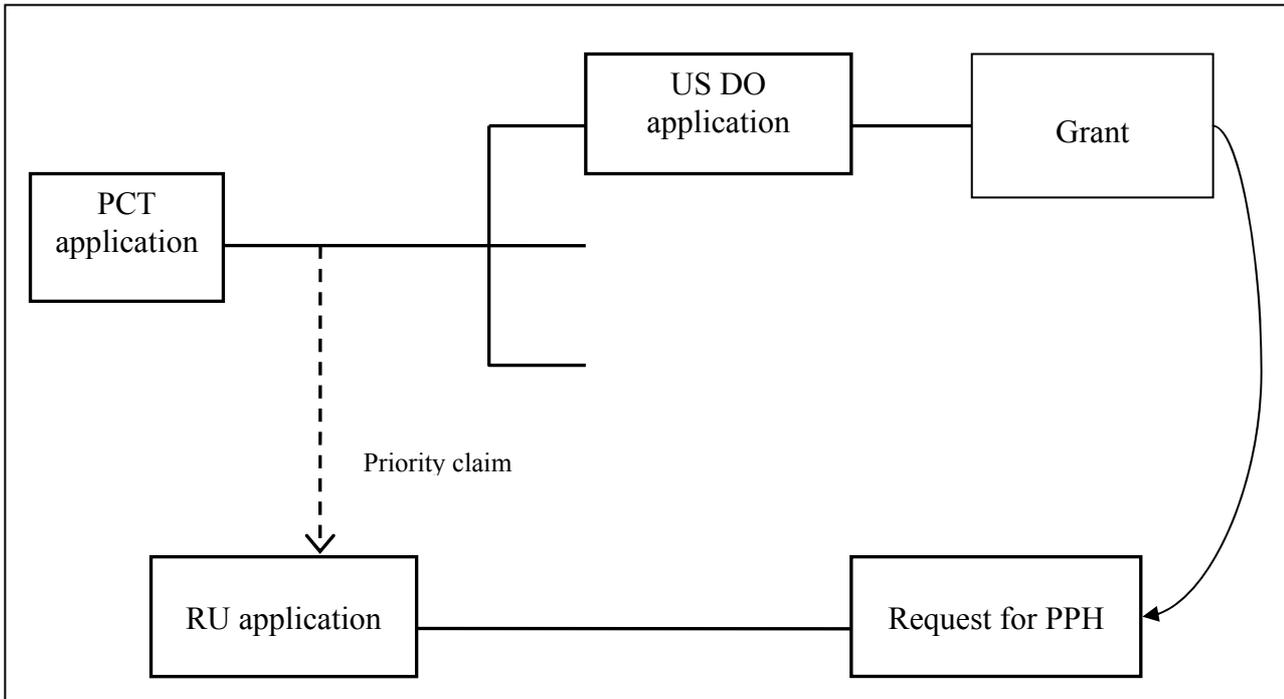


- Russian application filed under the Paris Convention and a divisional application



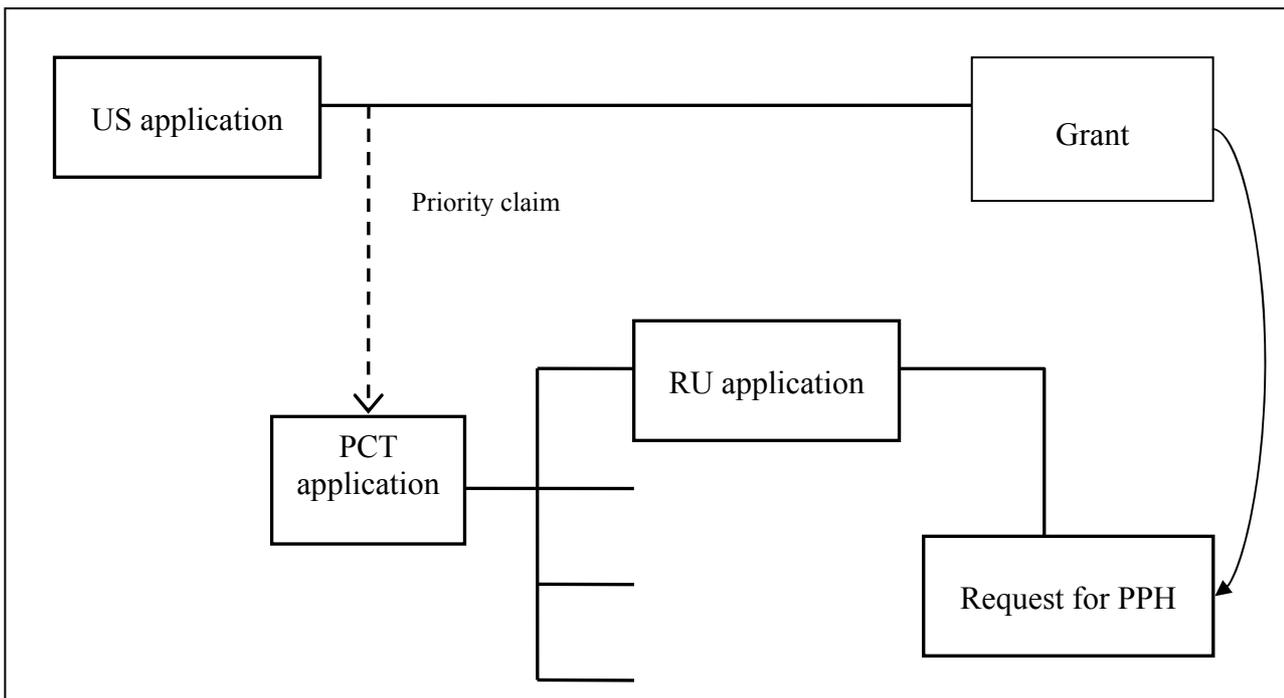
(1)(a)(ii):

- Russian application filed under the Paris Convention validly claiming priority on a PCT application

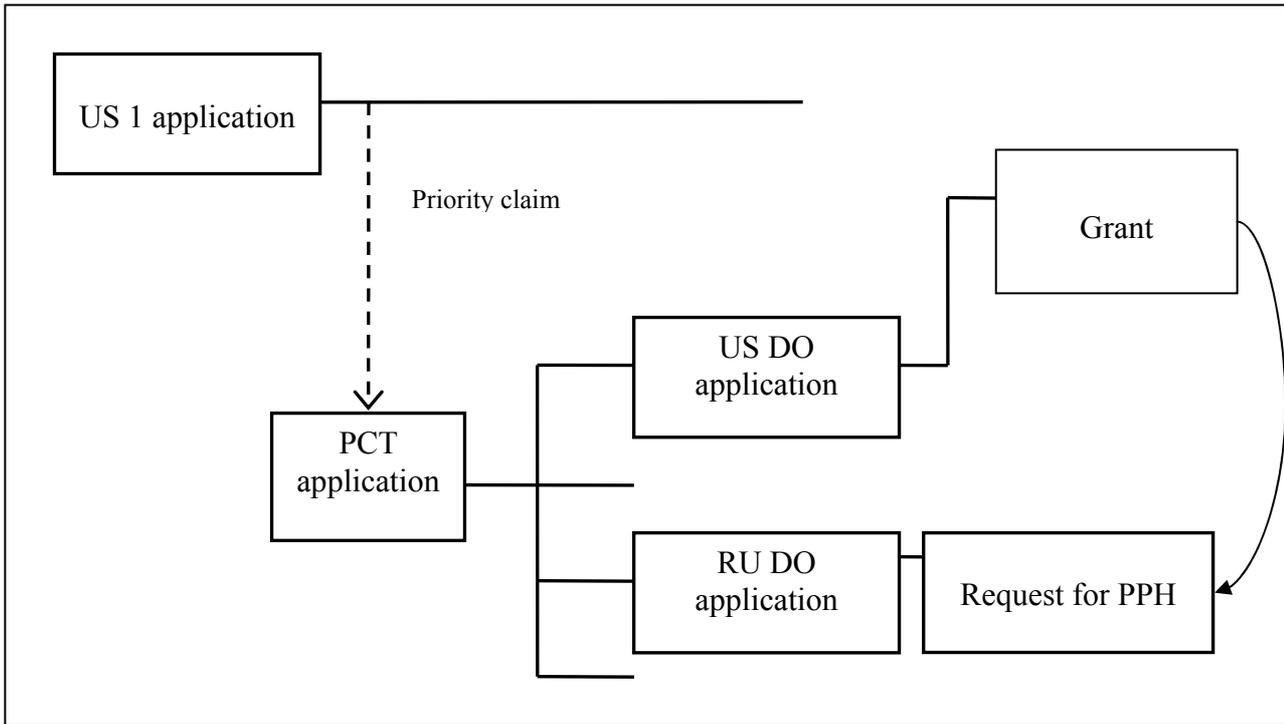


(1)(b)(i):

- Russian application at a national phase of a PCT application which claims a US application priority under the Paris Convention

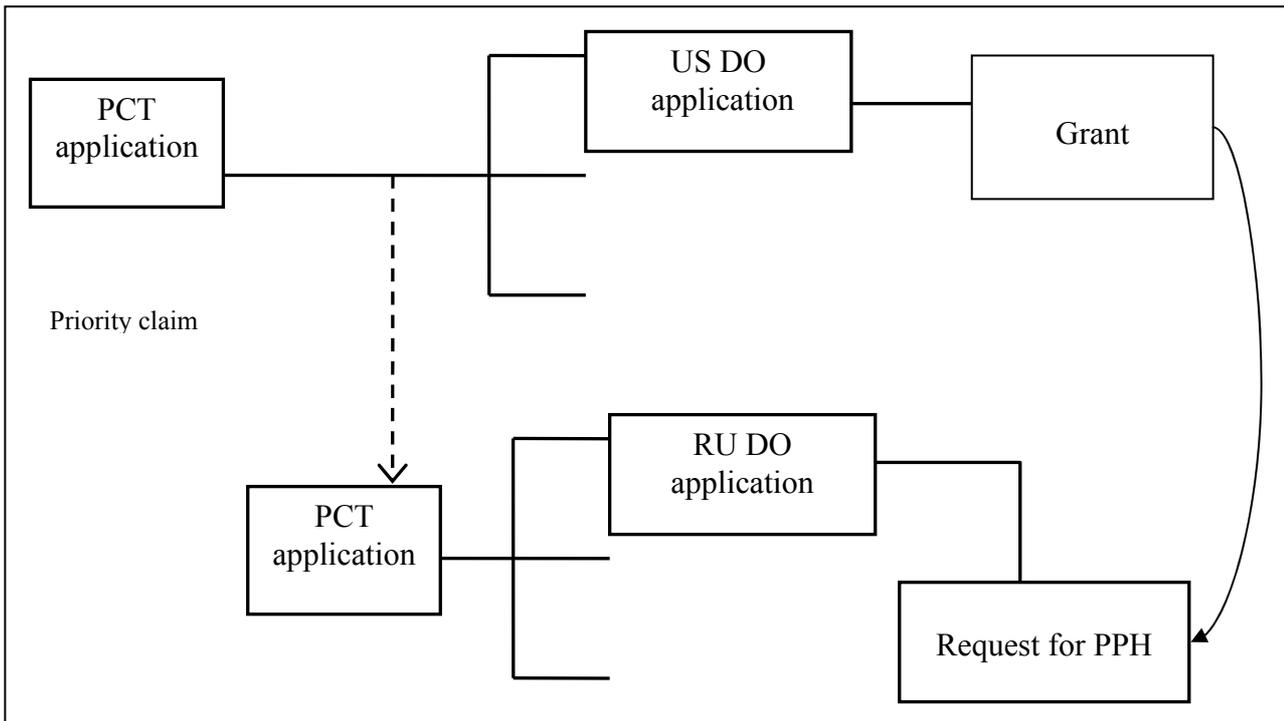


- application filed under the PCT procedure at a national phase

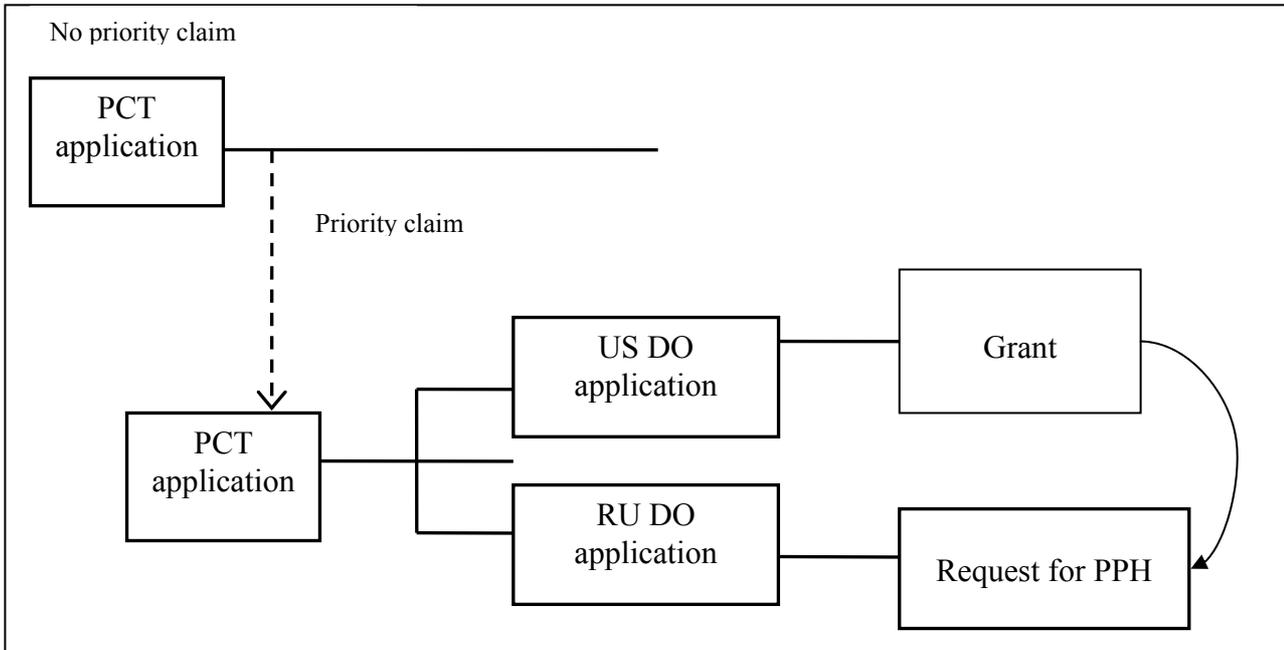


(1)(b)(ii):

- Russian application at a national phase of a PCT application which claims another PCT application priority under the Paris Convention

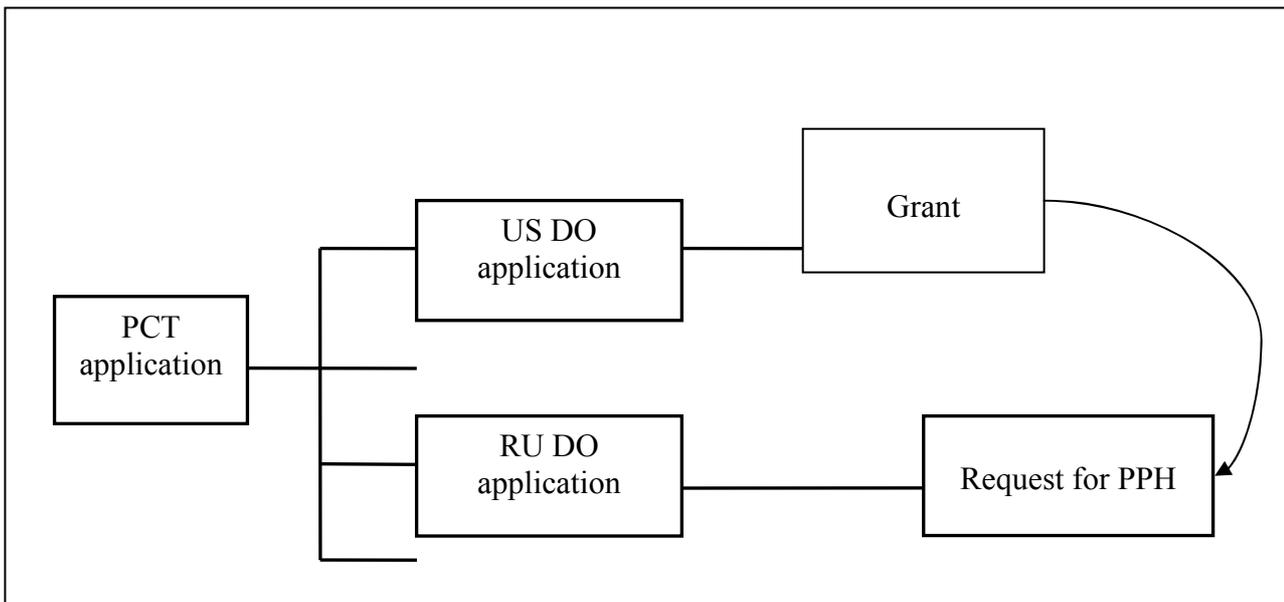


- direct filing through the PCT procedure and a PCT application



(1)(b)(iii):

- Russian application at a national phase of a PCT application without priority claim



(2) The accelerated examination is conducted by Rospatent in respect of an application validly claiming priority under the Paris Convention on the Protection of Industrial Property on the basis of one or several corresponding applications filed with the USPTO as an OFF, if the USPTO decides on the patentability of the invention described in one or several claims contained in the corresponding application.

A corresponding application is an application for an invention described in one or several claims determined to be patentable as a result of examination in the USPTO from the date the decision on the grant of a patent is sent to the applicant.

A preliminary conclusion on the patentability of the claims of an invention contained in the report on the international search carried out by the USPTO as an International Search Authority does not mean that the claims are determined by the USPTO as patentable as the office of first filing.

(3) All the claims of the application in respect of which a request for an accelerated examination is submitted to Rospatent must sufficiently correspond to one or several claims determined to be patentable by the USPTO.

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 by the USPTO if they are identical or correspond in the scope of claims in the mentioned claims.

The requirement of correspondence of the claims is considered to be met if an independent claim of an application filed with Rospatent is different from the claim of the corresponding application due to presence of an additional component in a form of a feature (features) of dependent point (points), or addition of a dependent point 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 claims of an invention in the US application.

The requirement of correspondence of the claims is considered to be met by amendment of the claims in application filed in the OSF.

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

(5) Request for accelerated examination (hereinafter – the request) is submitted in the 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 from July 1, 2010.

The request should contain the USPTO application number, which is the basis for claiming priority and also the publication number or the patent number.

Documents listed in paragraph B.(6) should be attached to the request.

It is required that the request for substantive examination in compliance with paragraph 1 Article 1386 of the Civil Code of the Russian Federation is filed and the fee for filing such a request is paid. In case of amendment of the claims in the application filed in the OSF, in order it is considered as corresponding to the claims determined patentable by the OFF, the corresponding petition shall be filed and corresponding fee shall be paid, if necessary.

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 by the USPTO if they are identical or correspond in the scope of claims in the mentioned claims.

(6) 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 by the USPTO 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 USPTO actions (notifications);

USPTO actions (notifications) – are documents concerning the substantial examination sent to the applicant by the USPTO 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 USPTO, since the examiner will at least understand the sense of the action (notification) of the office.

In case the documents are provided and automated (machine) translation thereof is available to Rospatent examiner, the applicant does not have to submit to Rospatent copies of all the USPTO actions (notifications) and their translations.

If the examiner does not understand the sense of the translation of the USPTO 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 by the USPTO;

A copy of the claims determined to be patentable by the USPTO can be a copy of the initial claims or a copy of modified claims determined to be patentable, or a publication of a patent granted by the USPTO.

Provisions contained in paragraph (b) above are also applicable to the present paragraph in cases when the applicant does not need to provide copies and translations, and also in respect of machine translation.

(d) documents cited by the USPTO 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.

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

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

If any documents mentioned in paragraphs (2), (6) and (7) have already been submitted before the request was filed the applicant need not submit them again with the request. He can just make a reference to them and mention in the request that those documents have already been submitted along with the Russian application.

### C. Special Examining Procedures

Substantive examination of an application for an invention is started after the request for accelerated patent examination is settled and the application is given a special status.

Any claims of an invention amended or added after the request is filed must sufficiently correspond with one or several patentable claims for an invention in the US application/applications. The applicant must also submit a table of correspondence of claims including the amendments (see B(3) above). If the amended or added claims do not sufficiently correspond with the patentable claims of the US application, then the amendments are not taken into consideration.

The applicant must meet the requirement of good faith including the submission to Rospatent of any important information for the determination of the patentability that he is in knowledge of.

For clarifications of the present text please contact Mrs. Elena Utkina, Director of Department, Rospatent by phone +7 499 240 58 74 or e-mail [Eutkina@rupto.ru](mailto:Eutkina@rupto.ru).

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