

Procedures to file a request to the Finnish Patent and Registration Office for the Patent Prosecution Highway Pilot Program between The Brazilian National Institute of Industrial Property (INPI) and the Finnish Patent and Registration office (PRH)

The Patent Prosecution Highway Pilot Programme (PPH Pilot Program) between INPI and PRH will commence on 1.8.2023 with duration of five years and end on 31.7.2028. The pilot period may be extended upon mutual consent between INPI and PRH.

The Offices may terminate the PPH pilot program if the volume of participation exceeds manageable level. Ex Ante notice will be published if the PPH pilot program is terminated.

Part I- PPH using national work products

[0001] An applicant can file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the PRH by submitting an application requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the PRH 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 PRH application procedure envisaged at this time (paragraph [0005]).

The request form is available online on the PRH website at <https://www.prh.fi/pphen> - “How to file a PPH request”.

Requirements for requesting accelerated examination under the PPH Program at the PRH

[0002] There are four requirements for requesting accelerated examination under the PPH program at the PRH based on the national work products of the INPI (later the office of earlier examination, OEE). These are:

- a) **Both the PRH application on which the 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 PRH application (including PCT national phase application) may be either:

- i) an application which validly claims priority under the Paris Convention from the OEE application(s) (examples are provided in ANNEX 1, Figure A, B, C and D), or
- ii) an application which provides the basis of a valid priority claim under the Paris Convention for the OEE application (including PCT national phase application) (examples are provided in ANNEX 1, Figure E, F and G), or
- 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 1, Figure H, I, J, K, L and M), or
- iv) a PCT national phase application where both the PRH application and the OEE application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX 1, Figure N)

- 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.**

Claims clearly identified to be patentable in the latest office action at examination stage are able to function as the basis for a request for accelerated examination under the PPH program. This is the case even though the application, which includes those claims, is not granted for patent yet.

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

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

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

A claim in the PRH 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, if the OEE claims only contain claims to a process of manufacturing a product, then the claims in the PRH are not considered to sufficiently correspond if the PRH 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 Program do not need to sufficiently correspond to the claims indicated as patentable/allowable in the OEE application.

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

Required documents for accelerated examination under the PPH Program at the PRH

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

- a) A copy of office actions (which are relevant to the patentability) in the corresponding OEE application(s), and translations of them. Office actions are documents which relate to substantive examination and which were sent to the applicant by the OEE examiner. The applicant can either provide the office actions together with the request for acceleration under the PPH or request that the PRH obtain the documents from the OEE's 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 OEE and translations of them. The applicant can either provide the claims together with the request for acceleration under the PPH or request that the PRH obtain the claims from the OEE's 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).
- c) A complete claim correspondence table showing the relationship between the claims of the PRH application for accelerated examination under the PPH and the claims of the corresponding OEE application considered patentable/allowable by OEE. When claims are just literal translation, the applicant can just write down that "they are 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 in [0002](c). The claim correspondence table must be written in Finnish or English.
- d) Copies of the references cited by the OEE examiner. If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the PRH. If the PRH does not have access to relevant patent documents, the applicant must submit these documents at the request of the PRH. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

[0004] The relevant information is provided by the applicant by filling out the form for requesting accelerated examination under the PPH Program which is available on the PRH PPH-webpage. The relevant supporting documentation should be attached.

[0005] The applicant need not provide further copies of documentation if they have already been submitted to the PRH through simultaneous or past procedures.

Procedure for accelerated examination under the PPH Program at the PRH

[0005] The applicant fills out the form requesting accelerated examination under the PPH Program available on the PRH web page and includes all the relevant supporting documents. The PPH Administrator, who will be a PRH 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 PRH 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

[0001] An applicant can file a request for accelerated examination under the Patent Prosecution Highway (PPH) based on PCT international work products of the INPI (later the office of earlier examination, OEE) to the PRH by requesting accelerated examination under the PCT-PPH accompanied by the relevant supporting documents. The requirements for an application to the PRH for accelerated examination under the PCT-PPH are given in the following sections.

The request form is available online on the PRH website at <https://www.prh.fi/pphen> - “How to file a PPH request”.

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

[0002] The application which is filed with the PRH 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 OEE, 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 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 derivate 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.

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 Program need not to sufficiently correspond to the claims indicated as patentable/allowable in the latest international product.

- d) The PRH 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 Program at the PRH

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

- 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 PRH.

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 PRH.

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

If the reference is a patent document, the applicant is not required to submit it. In case the PRH 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 PRH application for accelerated**

¹<https://patentscope.wipo.int/search/en>

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 PRH 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 Program at the PRH

[0005] The applicant fills out the form requesting accelerated examination under the PCT-PPH Program available on the PRH web page and includes all the relevant supporting documents. The PCT-PPH Administrator, who is a PRH 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 PRH 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 PRH applications eligible for PPH

Figure A:

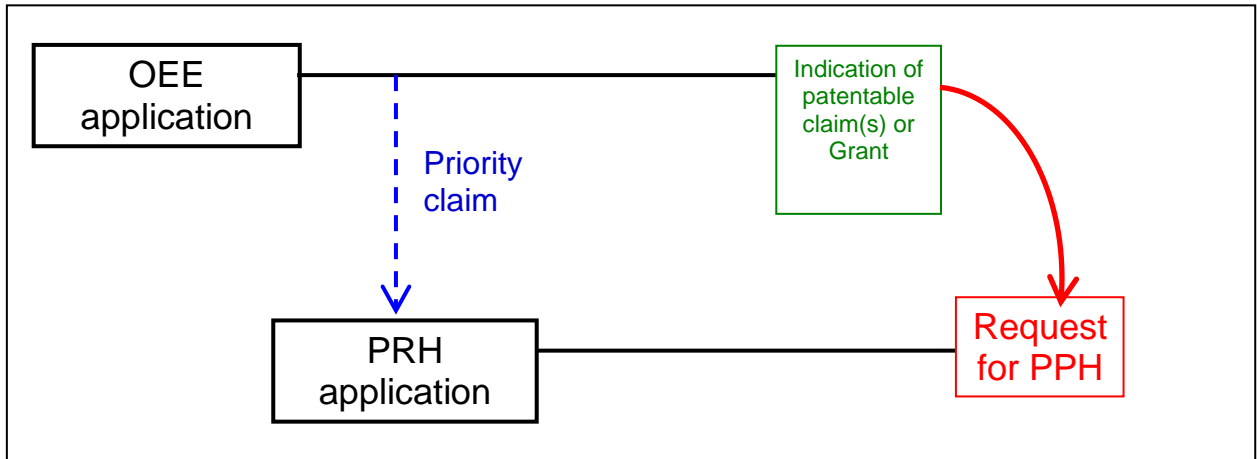
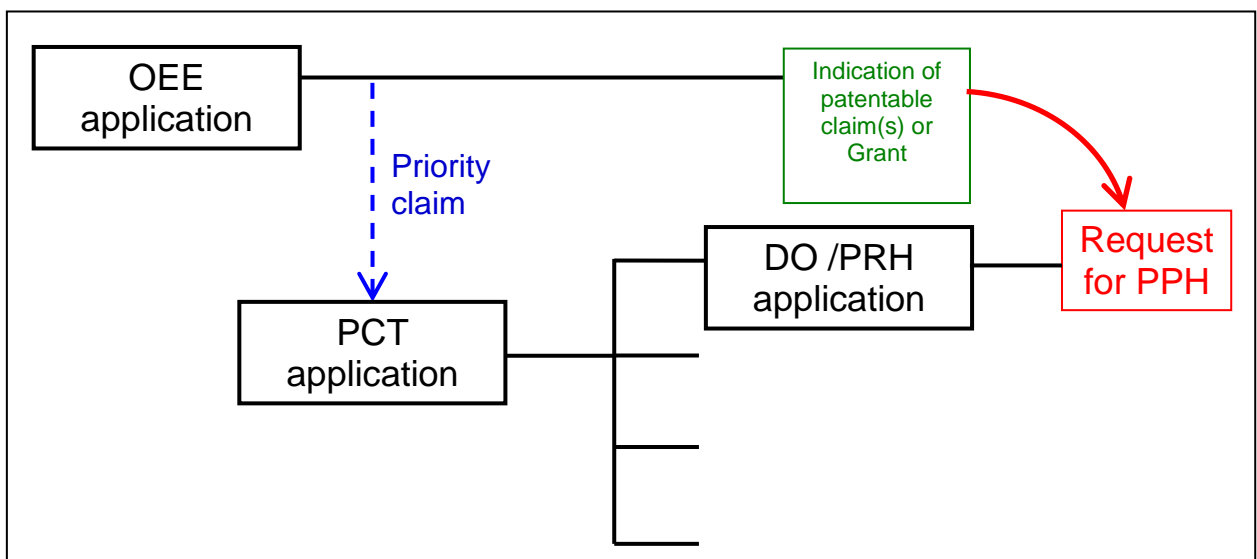
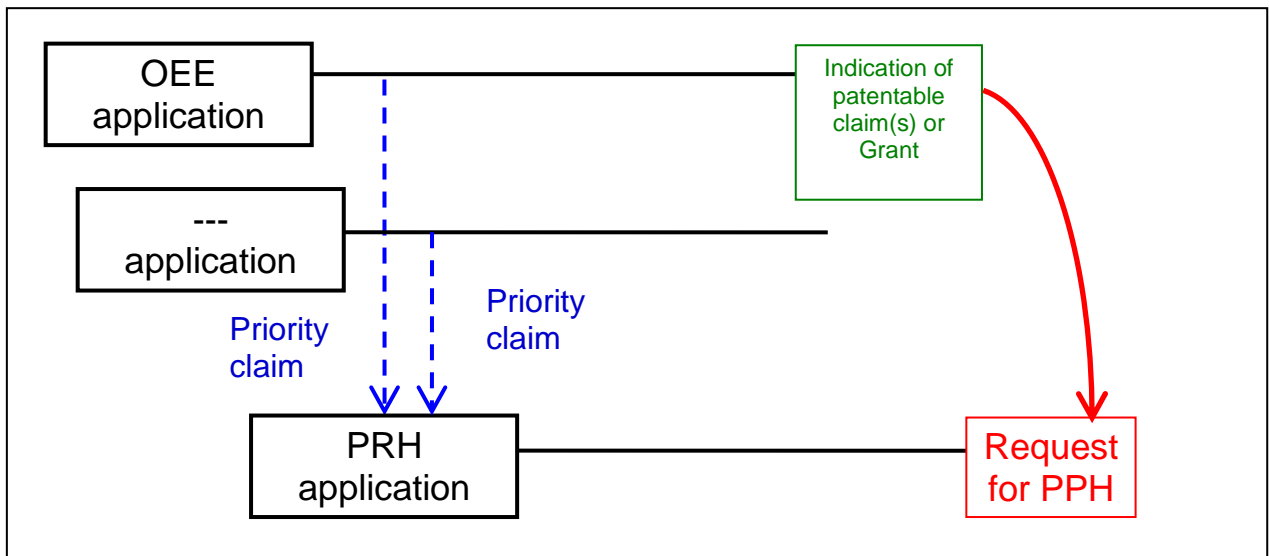


Figure B:



* DO – Designated Office

Figure C:



--- any office

Figure D:

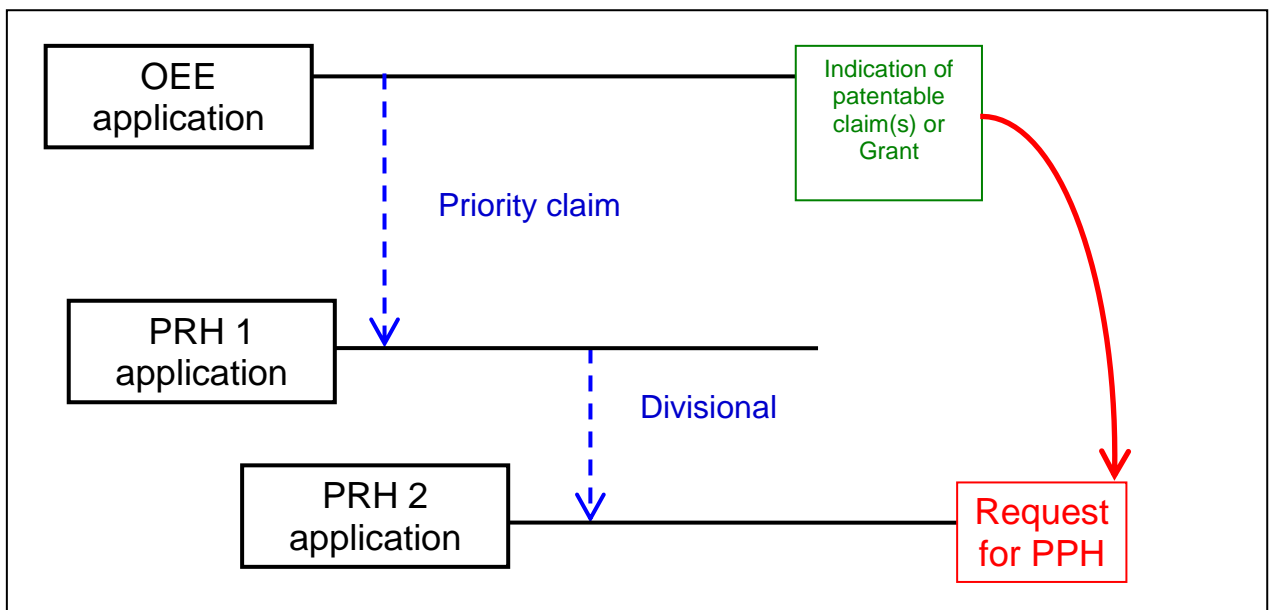


Figure E:

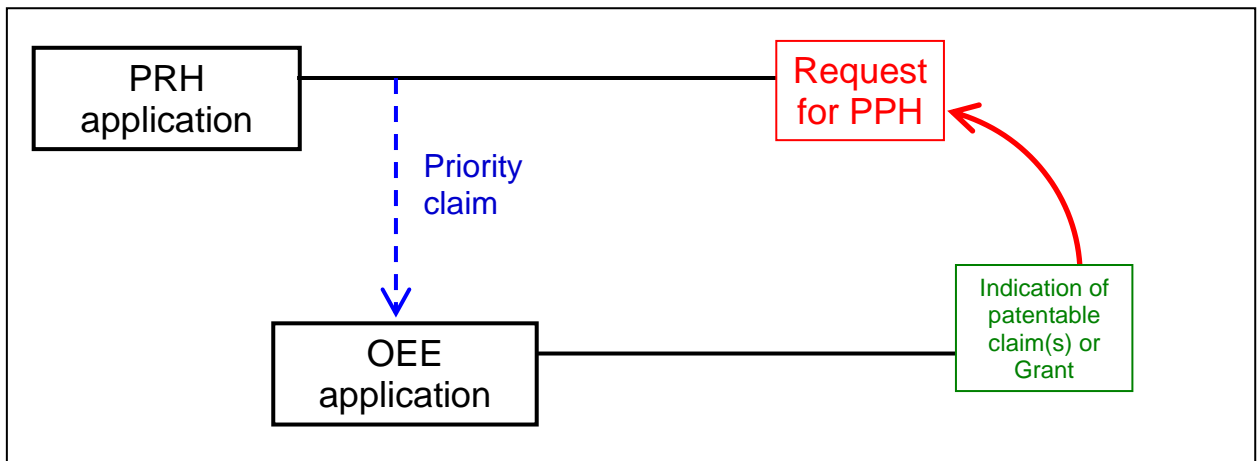


Figure F:

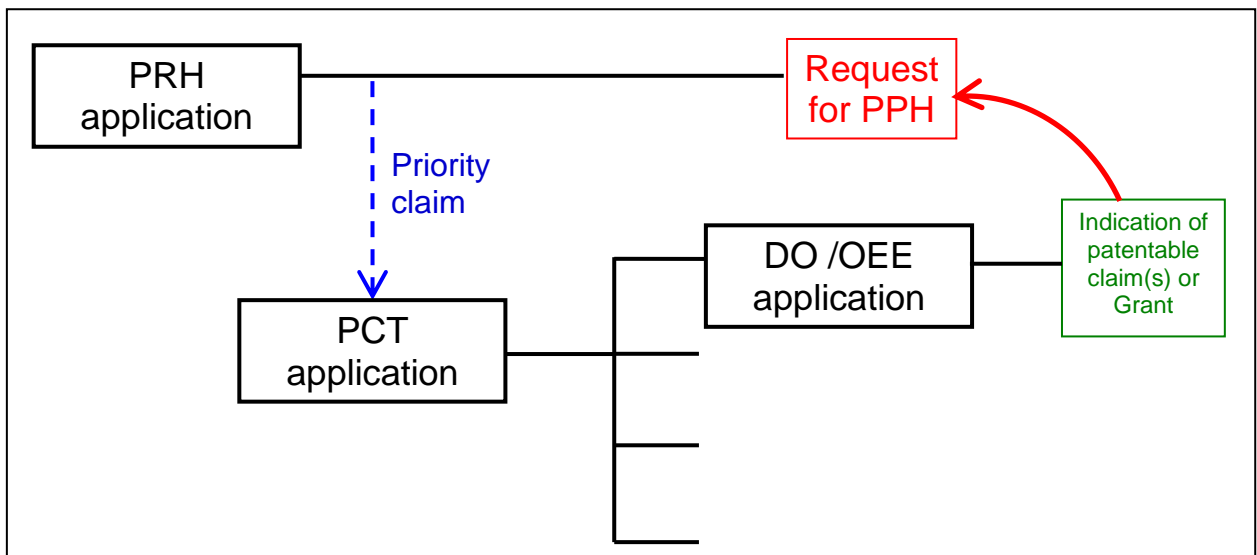
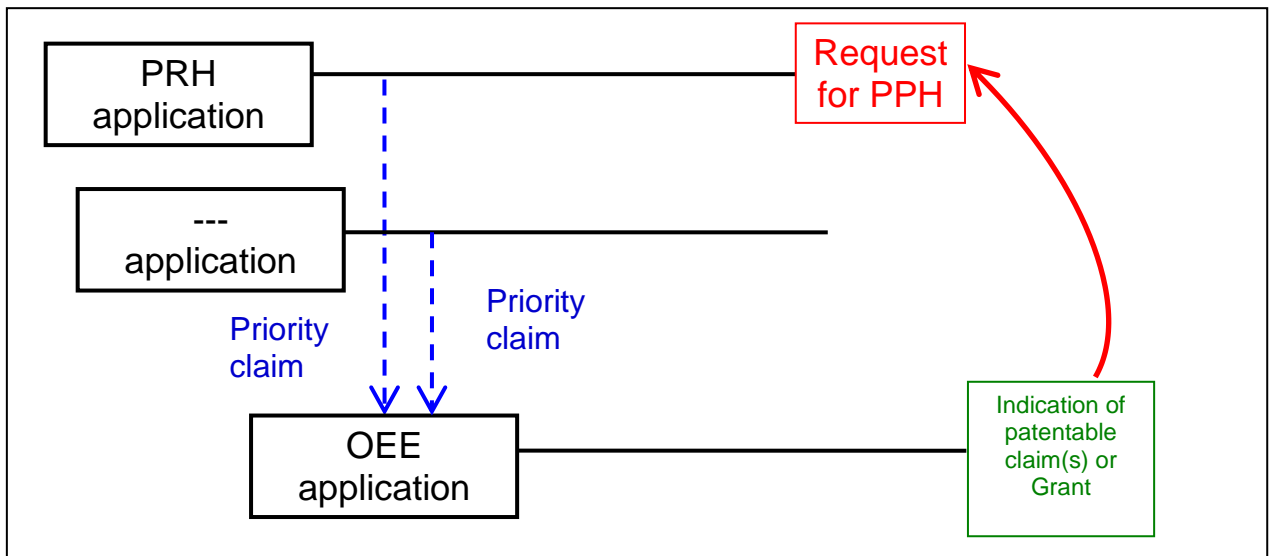


Figure G:



--- any office

Figure H:

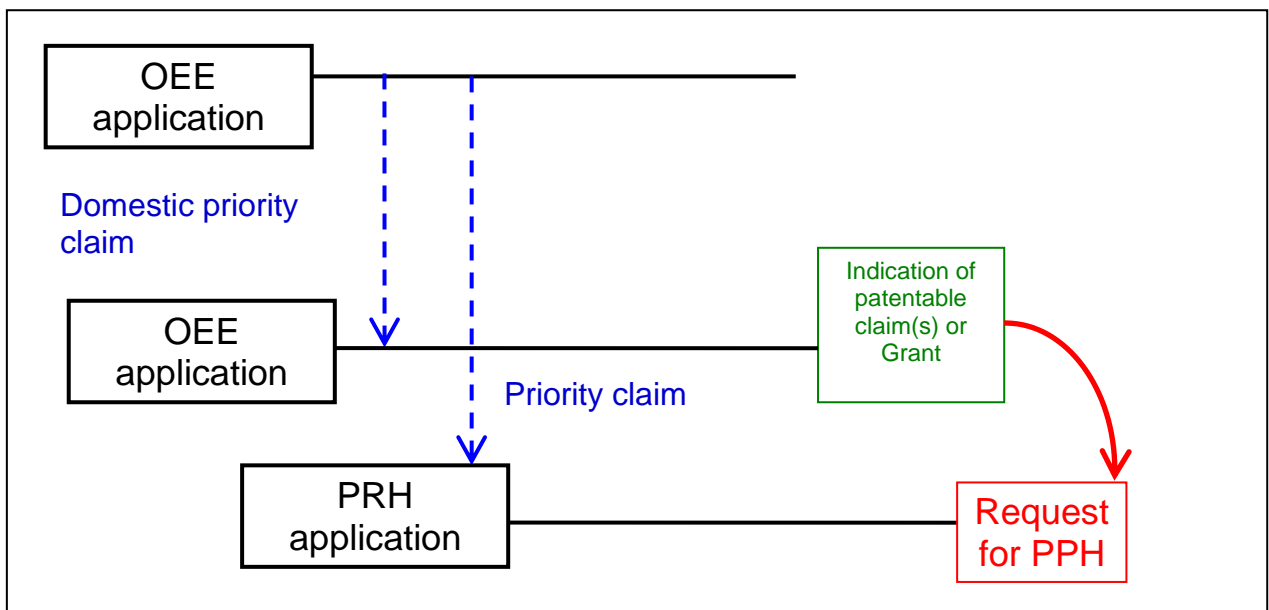
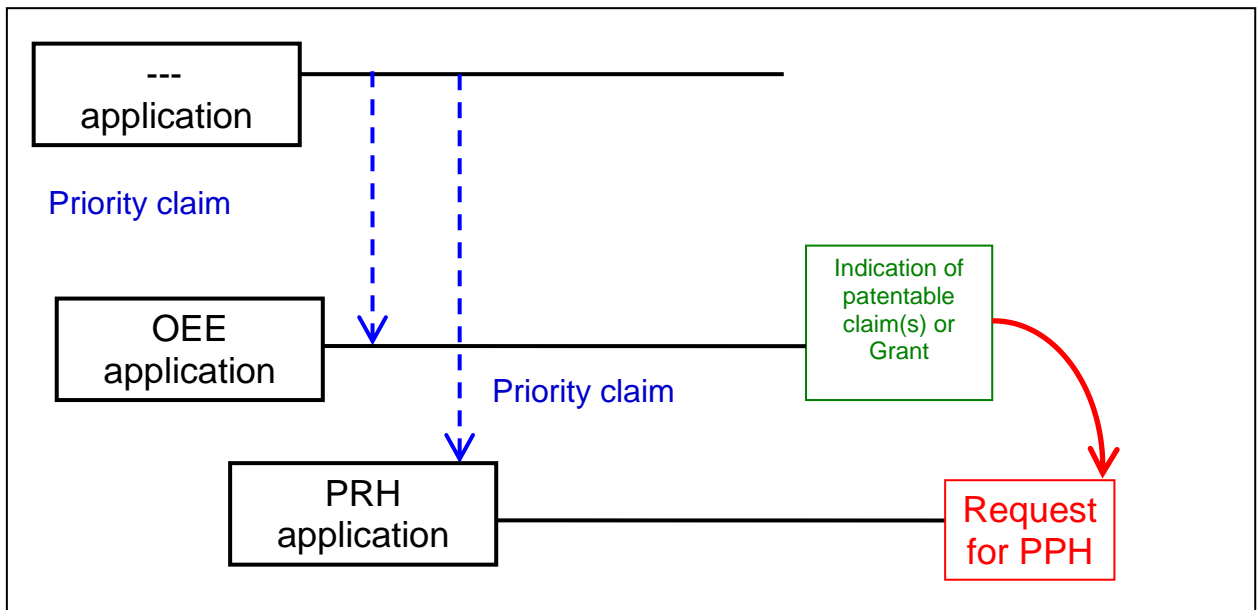
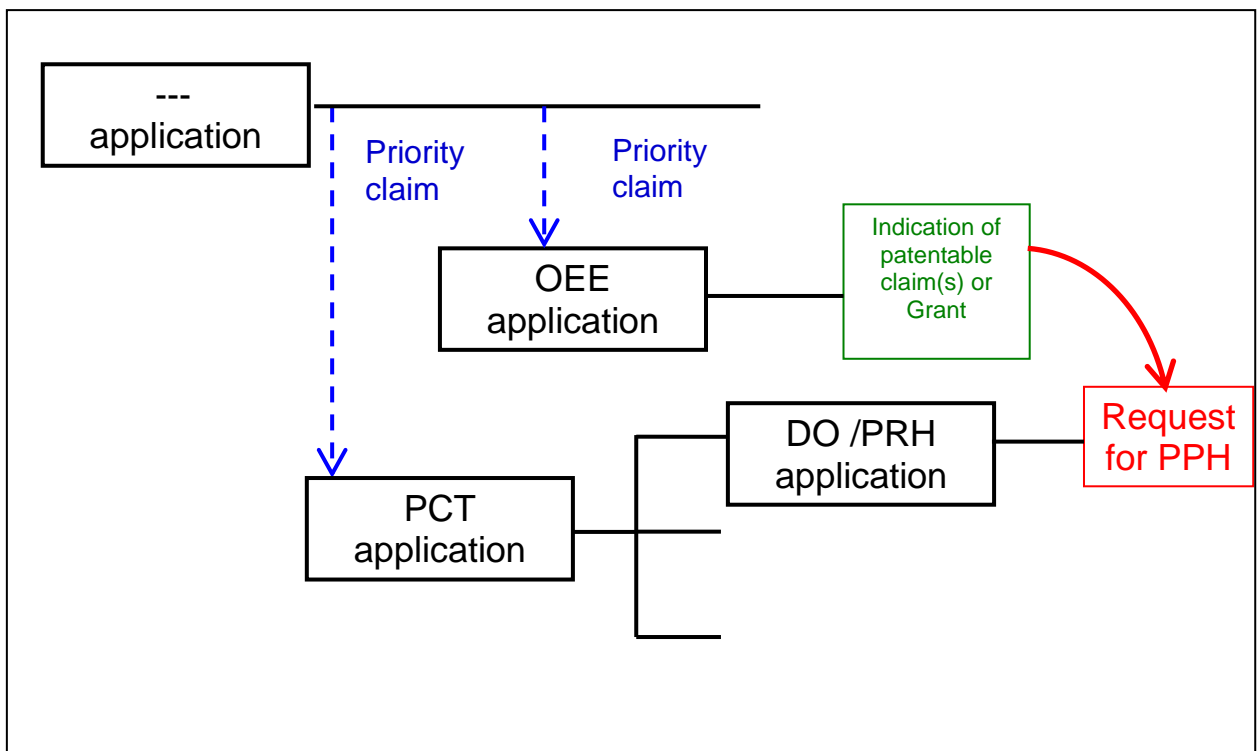


Figure I:



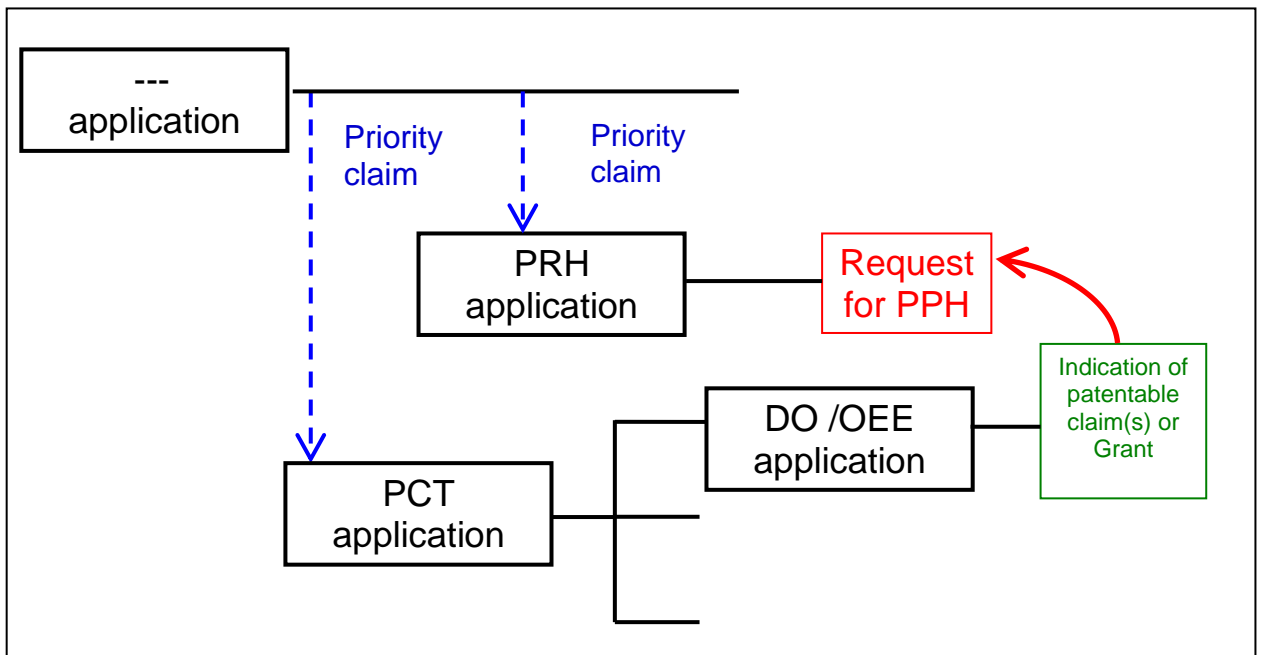
--- any office

Figure J:



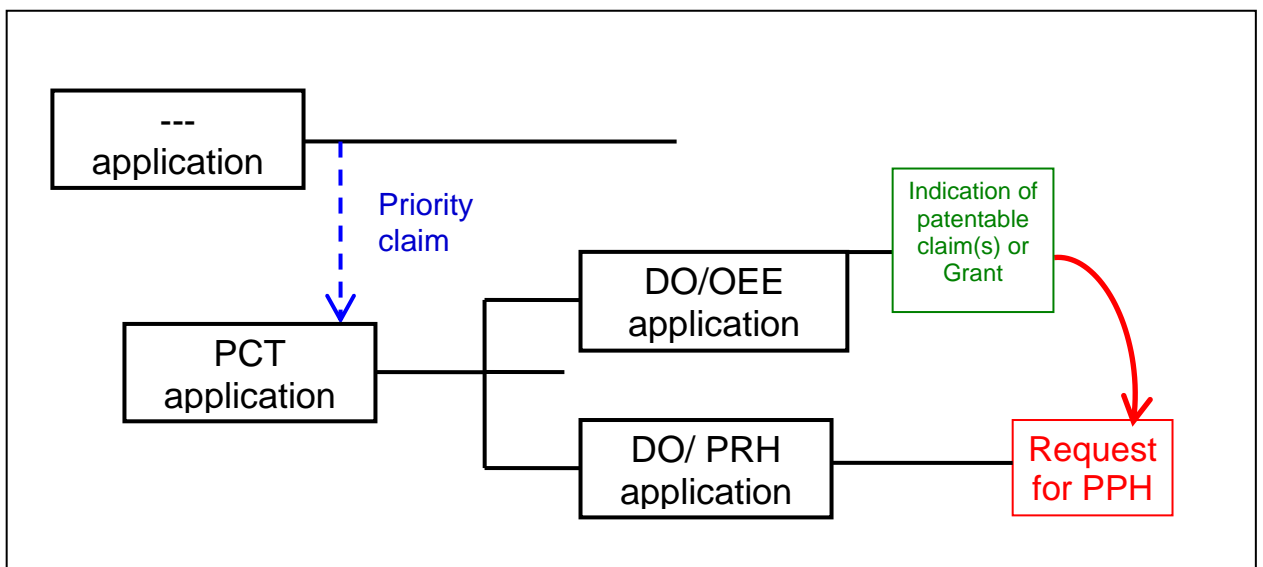
--- any office

Figure K:



--- any office

Figure L:



--- any office

Figure M:

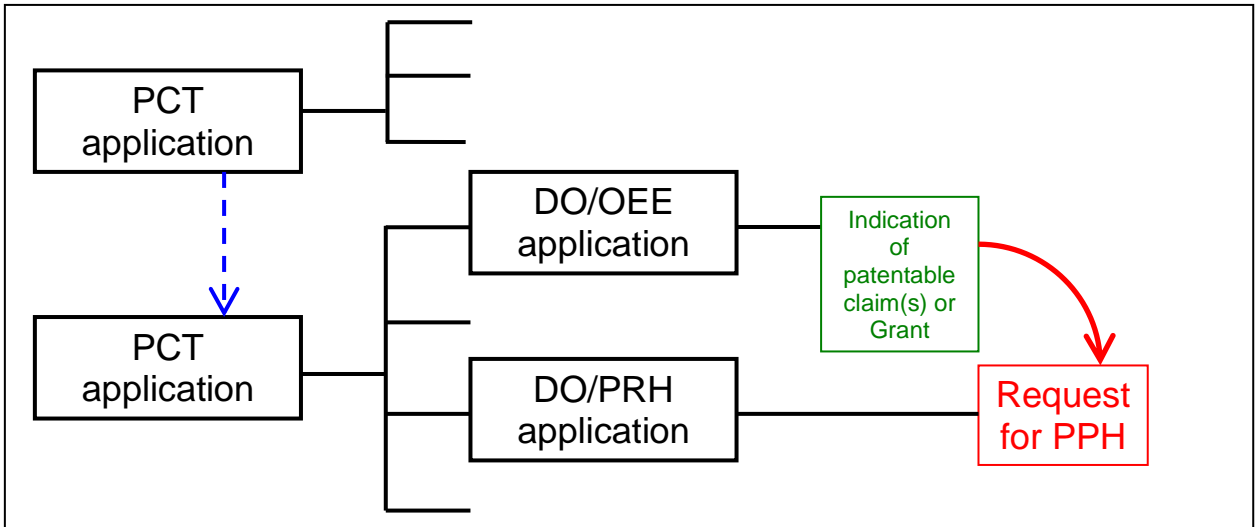
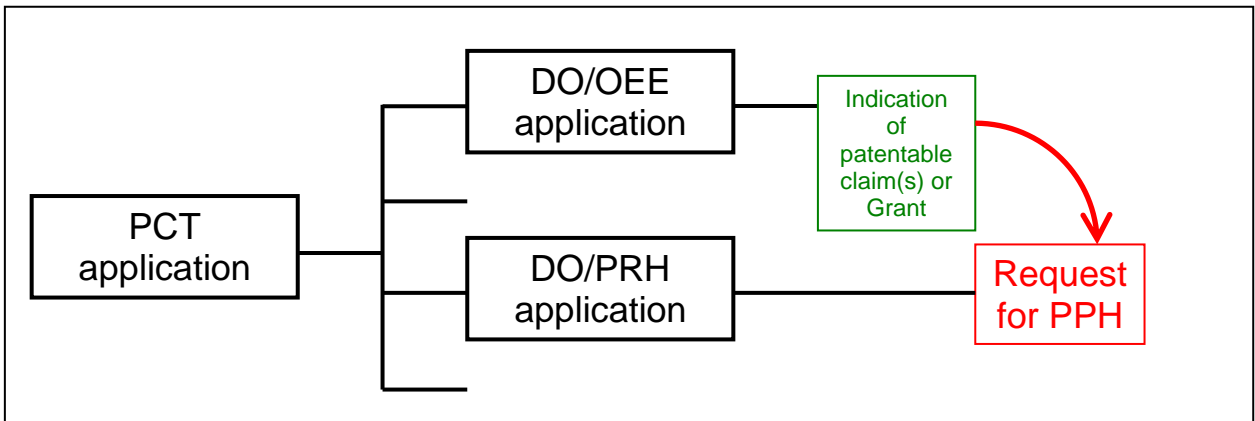


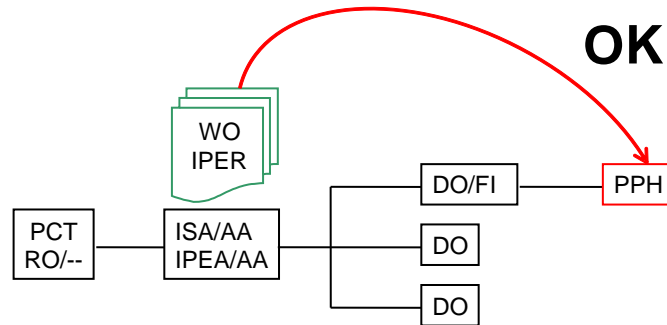
Figure N:



ANNEX 2

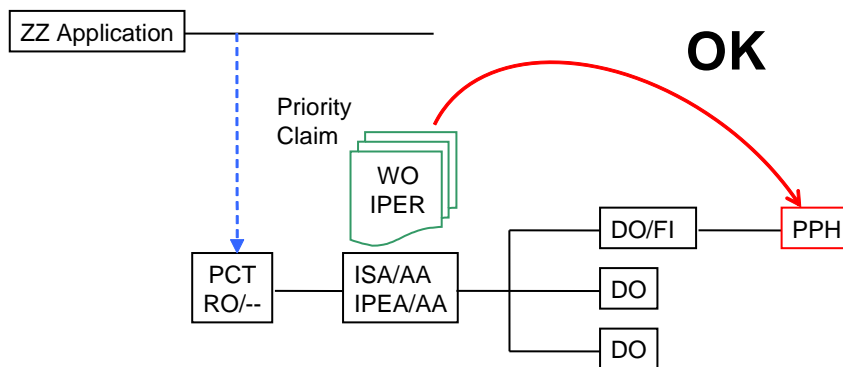
Examples of the applications eligible for PCT-PPH

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



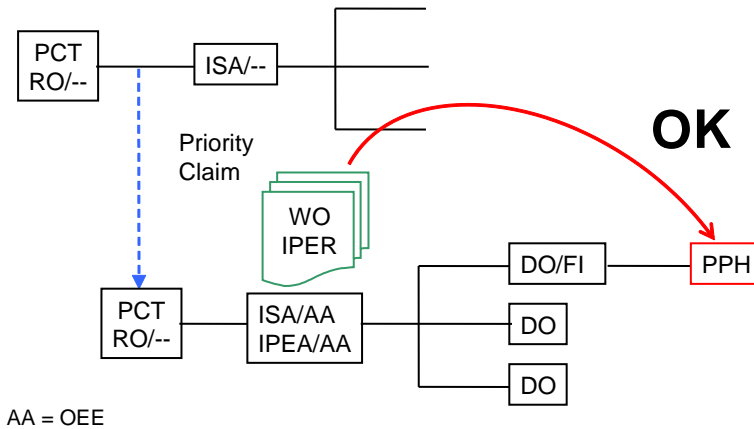
AA = OEE

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



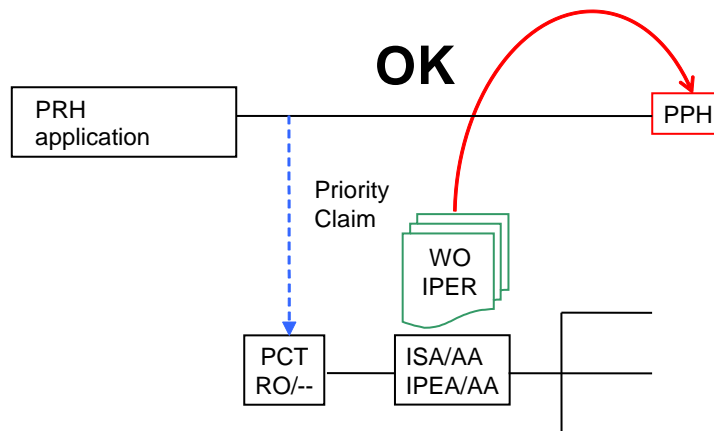
ZZ=any office
AA = OEE

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



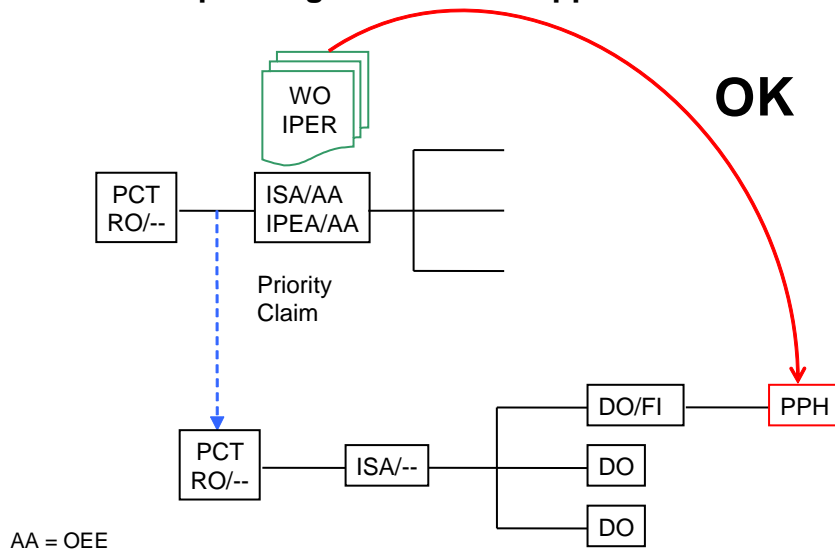
AA = OEE

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

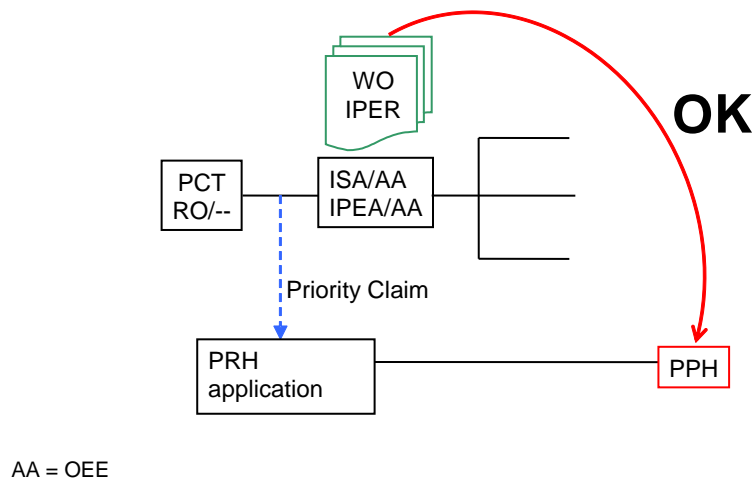


AA = OEE

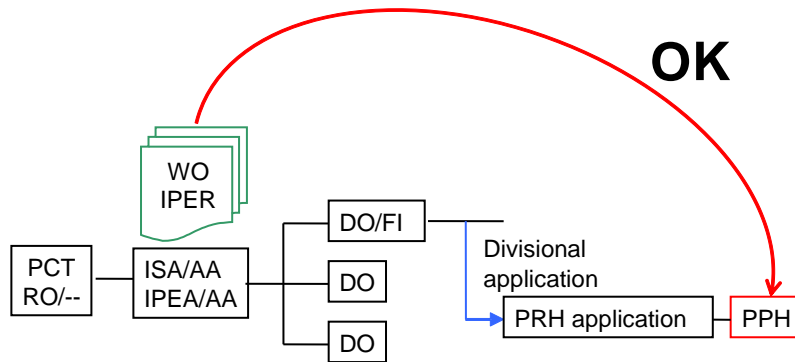
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



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

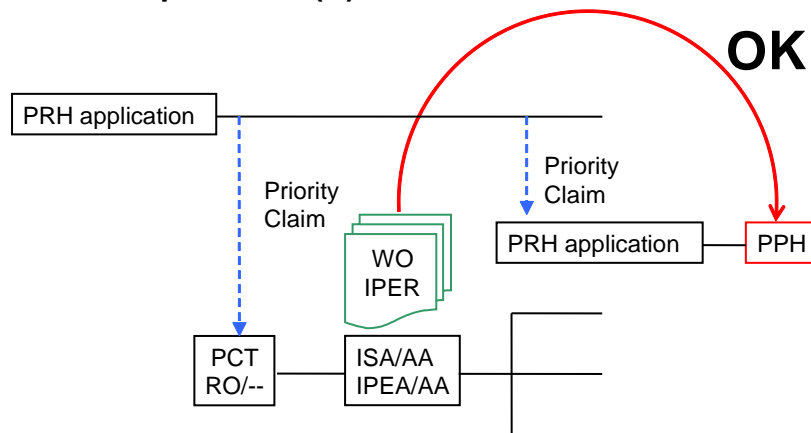


(E1) The application is a divisional application of an application which satisfies the requirement (A).



AA = OEE

(E2) The application is an application claiming domestic priority from an application which satisfies the requirement (B).



AA = OEE