

Revised Requirements and Procedures to file a request to the SPTO for Patent Prosecution Highway Pilot Program between the SPTO (Spanish Patent and Trademark Office) and the USPTO (United States Patent and Trademark Office)

Background

The Spanish Patent and Trademark Office (SPTO) implemented a patent prosecution highway (PPH) pilot program with the United States Patent and Trademark Office (USPTO) on October 1, 2010. The PPH pilot program is set to expire on September 30, 2011.

In order to improve the PPH program and make it available to a wider range of applicants, the SPTO and USPTO have agreed to revise the requirements for requesting participation in the PPH pilot program. The revised requirements and the trial period are set forth below and supersede all prior PPH notices between the USPTO and SPTO with respect to national products. The PCT-PPH pilot program is not affected by the current notice..

Trial Period for the PPH Pilot Program

The PPH pilot program with the revised requirements will commence on July 15, 2011, for a period of one year ending on July 14, 2012. The revised requirements will apply to PPH requests filed in the SPTO on or after July 15, 2011 based on claims that have been determined allowable by USPTO in a corresponding application filed in USPTO. 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 SPTO 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 a manageable level, or for any other reason. Notice will be published if the PPH pilot program will be terminated before the July 14, 2012 date.

Request to the SPTO

[0001] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the SPTO by submitting an application requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the SPTO for accelerated examination under the PPH are given in the following section. Relevant supporting documentation is discussed in a latter section (paragraphs [0003] to [0005]) as is the general SPTO application procedure envisaged at this time (paragraph [0006]).

Requirements for requesting an accelerated examination under the PPH Pilot Program at the SPTO

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

- a) The SPTO application for which the PPH request is made, and the Office of Earlier Examination (in this case, USPTO) application(s) forming the basis of the PPH request, shall be corresponding applications.

A corresponding OEE (USPTO) application means either: 1) an OEE (USPTO) national application on the basis of which the SPTO application claims priority, 2) an OEE (USPTO) application that is a PCT national phase application derived from the same PCT international application as the SPTO application or 3) an OEE (USPTO) application that is a member of the same patent family as the SPTO application. Patent family members will be considered patent documents that share at least one common priority document or document from which benefit is claimed.

Both the SPTO application on which PPH is requested and the OEE (USPTO) application(s) forming the basis of the PPH request shall have the same priority/filing date.

For example, the SPTO application (including PCT national phase application) is either:

(Case I) an application which validly claims priority under the Paris Convention to the OEE (USPTO) application(s) (examples are provided in ANNEX I, Figure A, B, C, D and E), or

(Case II) an application which is the basis of valid priority claim under the Paris Convention for the OEE (USPTO) application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figure F, G and), or

(Case III) an application which shares the common priority document with the OEE (USPTO) application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figure H, I, J, K and L), or

(Case IV) a PCT national phase application where both the SPTO application and the OEE (USPTO) application(s) are derived from a PCT international application having no priority claim

(an example is provided in ANNEX I, Figure M).

- b) At least one corresponding OEE (USPTO) application has one or more claims that are determined to be patentable/allowable by the OEE (USPTO).
- c) All the claims in the SPTO application must sufficiently correspond to one or more of those claims indicated as patentable/allowable by the OEE (USPTO) in order to the SPTO application to qualify for accelerated examination under the PPH at the SPTO.

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

In this regard, a claim that is narrower in scope occurs when a OEE (USPTO) 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 SPTO which introduces a new/different category of claims to those claims indicated as allowable in the OEE (USPTO) is not considered to sufficiently correspond. For example, where the OEE (USPTO) claims only contain claims to a process of manufacturing a product, then the claims in the SPTO are not considered to sufficiently correspond if the SPTO claims introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in the OEE (USPTO) application.

- d) It is possible to participate in the PPH not only when the SPTO examination has not begun, but also when examination has already begun. But if examination of the application is finished, it is not possible to participate in the PPH

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

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

- a) a copy of all the office actions (which are relevant to the patentability) in the corresponding OEE (USPTO) 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 (USPTO) examiner. The applicant is required to provide these with the request for acceleration under the PPH.

Both Spanish and English are acceptable as translation language. 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 by the OEE (USPTO) and translations of them. The applicant is required to provide these with the request for acceleration under the PPH. Both Spanish and English are acceptable as translation language. The indications provided in the requirement (3)(a) above regarding machine translations also apply to this requirement (3)(b).
- c) a complete claim correspondence table showing the relationship between the claims of the SPTO application for accelerated examination under the PPH and the claims of the corresponding OEE (USPTO) application considered patentable by the OEE (USPTO). Sufficient correspondence of claims occurs where claims are of the same or similar scope.

The claims correspondence table must indicate how the claims in the SPTO application correspond to the patentable claims in the OEE (USPTO) application. The claim correspondence table must be written in Spanish or English.

- d) Copies of the references cited by the OEE (USPTO) examiner. If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the SPTO. If the SPTO does not have access to relevant patent documents, the applicant must submit these documents at the request of the SPTO. Non-patent literature must always be submitted.

[0004] The relevant information is obtained from the applicant by filling out a form for requesting accelerated examination under the PPH Pilot Program which is available on the SPTO web site. 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 SPTO through simultaneous or past procedures.

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

[0006] The applicant fills out the form requesting accelerated examination under the PPH Pilot Program available on the SPTO web page and includes all the relevant supporting documents. The PPH Administrator, who will be an SPTO patent examiner, will consider the request. Where all the requirements for accelerated examination under the PPH have not been met, the PPH Administrator will notify the applicant that

the application has not been allowed entry on to the PPH and will provide an explanation as to why entry on to the PPH was not possible. The applicant is free to take any possible correcting action necessary and again requesting acceleration under the PPH.

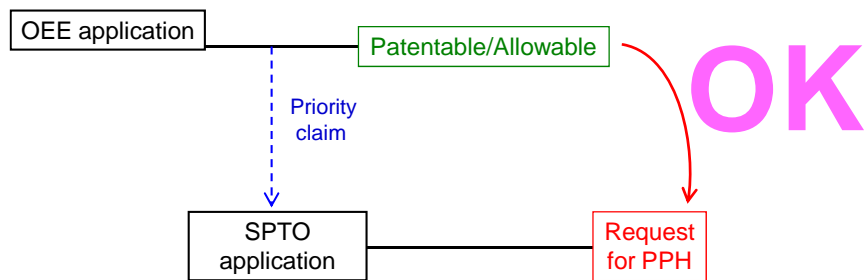
Where all of the requirements for accelerated examination have been met, the PPH Administrator will notify the applicant that the application has been allowed entry on to the PPH. The PPH Administrator will notify the relevant examining group that the application has qualified for entry to the PPH and the relevant examiner will then conduct an accelerated examination of the application.

If the request for accelerated examination is not granted, the applicant will be notified that the application will await action in its regular turn.

ANNEX 1

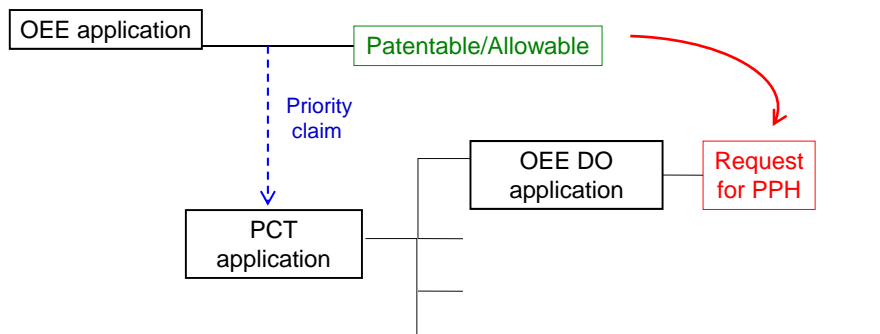
A

(Case I)
- Paris route -



B

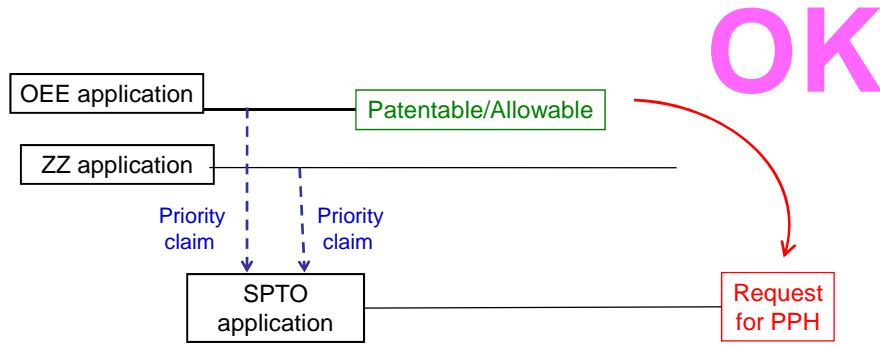
(Case I)
- PCT route -



C

(Case I)

- Paris route and Complex priority -

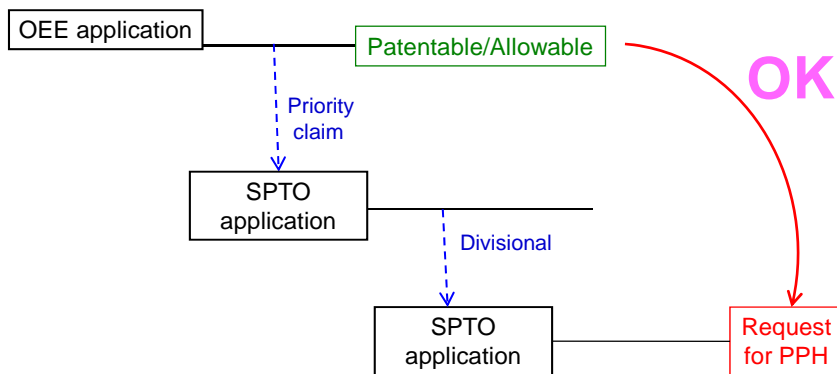


ZZ= Any office

D

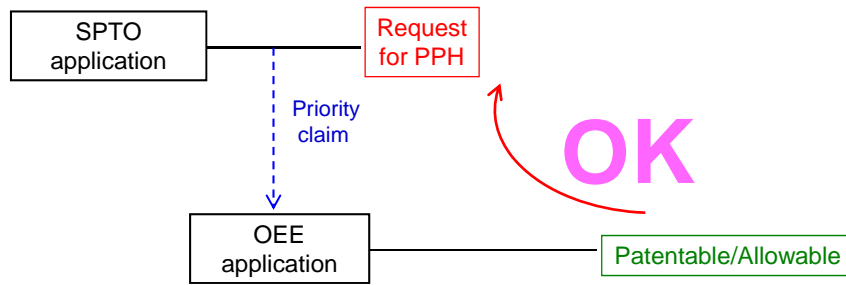
(Case I)

- Paris route & divisional application -



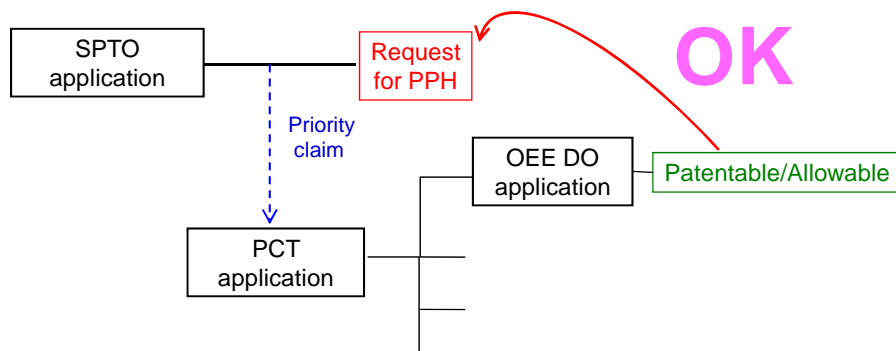
E

(Case II)
- Paris route -



F

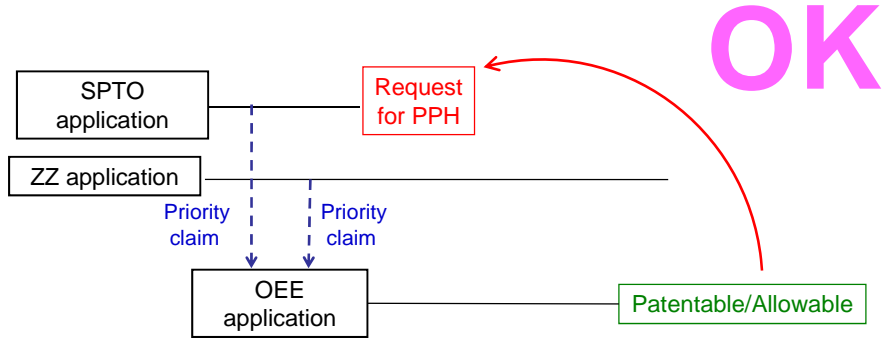
(Case II)
- PCT route -



G

(Case II)

- Paris route and Complex priority -

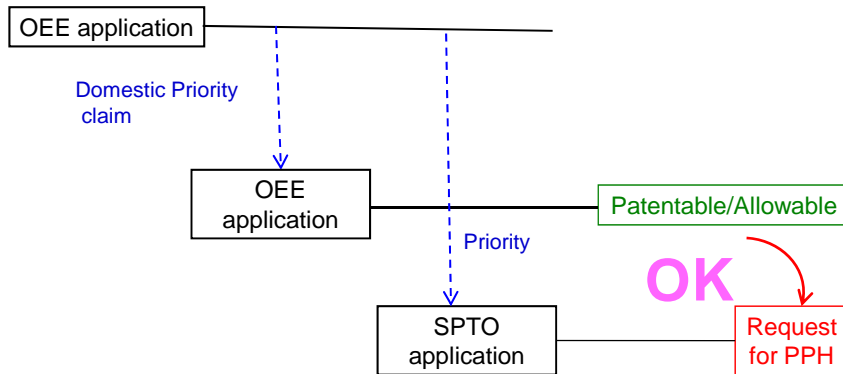


ZZ= Any office

H

(Case III)

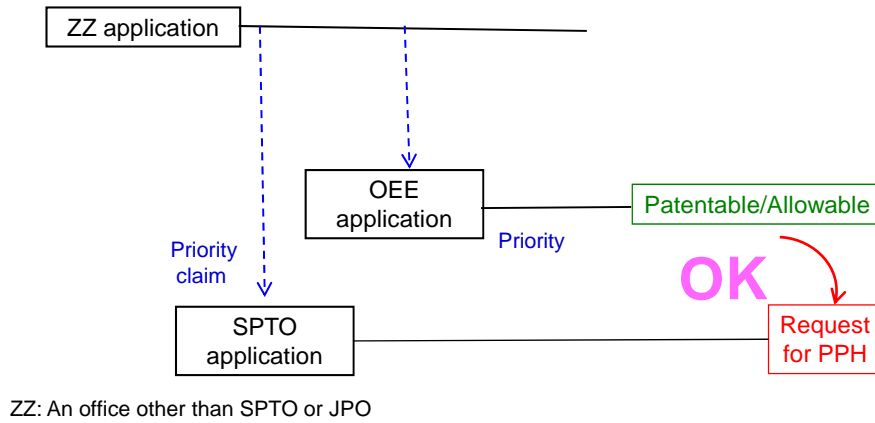
- Paris route & domestic application -



I

(Case III)

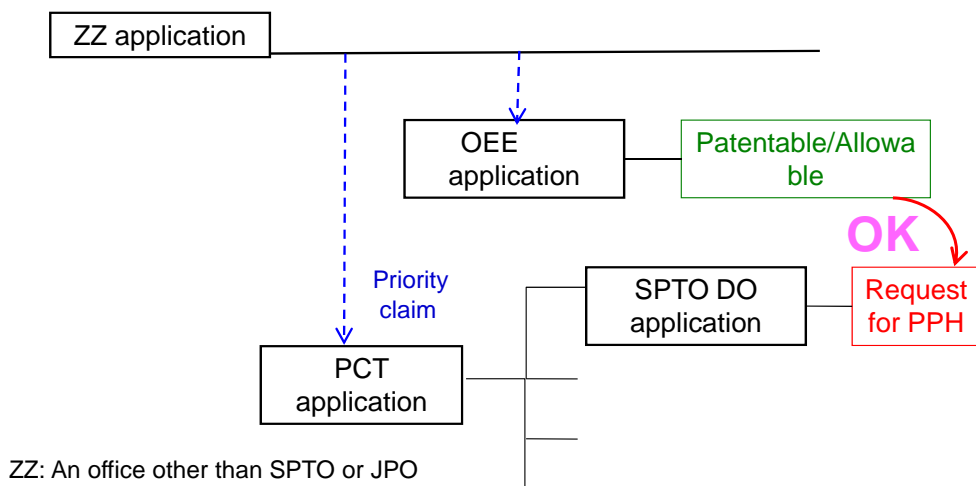
- Paris route but the first application is from the third country-



J

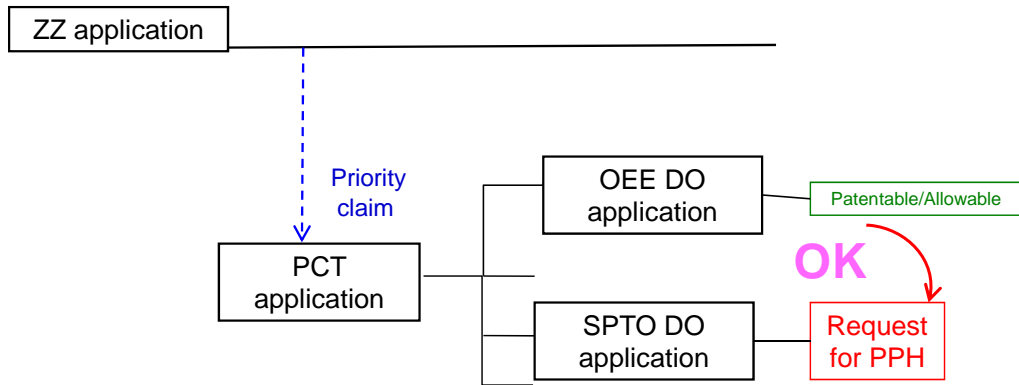
(Case III)

- PCT route, but the first application is from a third country -



K

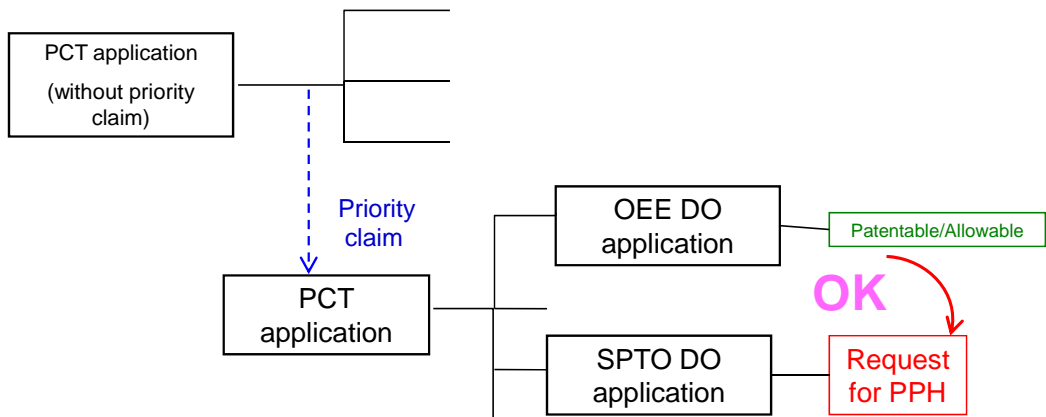
(Case III)
- PCT route-



ZZ: An office other than SPTO or JPO

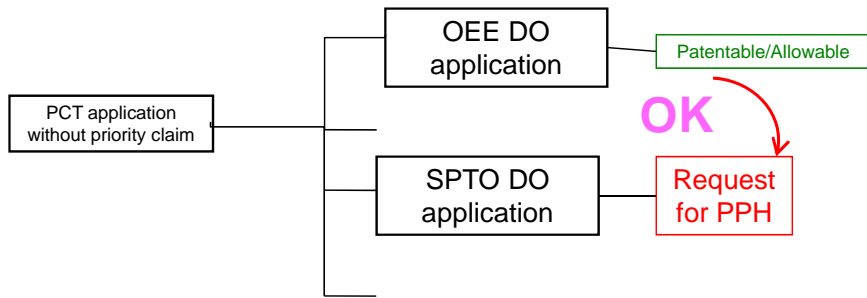
L

(Case III)
- Direct PCT & PCT route-



M

(Case IV)
- Direct PCT route-



PPH REQUEST

Request for Accelerated Examination at the Spanish Patent and Trademark Office (SPTO) under the Patent Prosecution Highway Pilot Program. PPH using national work products.

Application information

SPTO application number:

Office of Earlier Examination (hereinafter OEE):

Corresponding OEE application or publication number(s):

Relevant supporting documents

List of Required Documents. Please, tick the boxes below:

1. Either:

1.1. A copy of all the office actions (which are relevant to the patentability) in the above-identified OEE application(s) is attached.

or

1.2. SPTO to obtain the office actions from the OEE database, where there exists such a data base.

2. Either:

2.1. A copy of all claims which were determined to be patentable by the OEE in the above-identified OEE application(s) is attached.

or

2.2. SPTO to obtain the set of patentable/allowable claims from the OEE data base, where there exists such a data base.

3. Either:

3.1. Translations into Spanish or English of the documents in 1.1 and 2.1.

or

3.2. SPTO to obtain the translations from the OEE database, where there exists such a data base.

4. Copies of the documents referred by the OEE Examiner are attached. Patent literature is not necessary to be submitted. Non-patent literature must always be submitted.

□

5. Incorporation by reference. If you want to incorporate any of the above mentioned documents please provide now all the necessary data:

□

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Claim correspondence table completed

Claim correspondence table

SPTO claims	Corresponding OEE claims	Comments explaining the correspondence