

**Procedures to file a request to the SPTO for Patent Prosecution Highway Pilot Program between the SPTO (Spanish Patent and Trademark Office) and the Russian Federal Service for Intellectual Property (Rospatent)**

**Part I- PPH using national work products from the Rospatent**

**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]** The requirements for requesting accelerated examination under the PPH pilot program at the SPTO are:

***(a) Both the SPTO application on which PPH is requested and the Rospatent 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 SPTO application (including PCT national phase application) may be either:*

- i) an application which validly claims priority under the Paris Convention to the OEE application(s) (examples are provided in ANNEX 1), or
- ii) a PCT national/regional phase application where both the OLE application and the OEE application(s) are derived from a common PCT international application having no priority claim (examples are provided in ANNEX 1).
- iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in ANNEX 1).
- iv) an application which is the basis of a valid priority claim under the Paris Convention for the OEE application(s) (including PCT national/regional phase application(s)) (examples are provided in ANNEX 1),
- v) an application which shares a common priority document with the OEE application(s) (including PCT national/regional phase application(s)) (examples are provided in ANNEX 1).

***(b) At least one corresponding Rospatent application has one or more claims that are determined to be patentable/allowable by the Rospatent.***

***(c) All the claims on file, as originally filed or amended, for examination in the SPTO under the PPH must sufficiently correspond to one or more of those claims indicated as patentable/allowable by the Rospatent.***

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

In this regard, a claim that is narrower in scope occurs when a Rospatent 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 SPTO application which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the Rospatent application is not considered to sufficiently correspond. If, for example, the Rospatent claims only contain claims to a process of manufacturing a product, then the claims in the SPTO application are not considered to sufficiently correspond if the claims of the SPTO 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 need to sufficiently correspond to the claims indicated as patentable/allowable in the Rospatent application.

***(d) SPTO has not begun examination of the application.***

**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 Rospatent application(s), and translations of them. Office actions are documents which relate to substantive examination and which were sent to the applicant by the Rospatent examiner. The applicant can either provide these with the request for acceleration under the PPH or request that the SPTO obtain the documents required through the Rospatent document database.

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/allowable by the Rospatent and translations of them. The applicant can either provide these with the request for acceleration under the PPH or request that the SPTO obtain the documents required through the Rospatent document database. Both Spanish and English are acceptable as translation language. 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 SPTO application for accelerated examination under the PPH and the claims of the corresponding Rospatent application considered patentable/allowable by the Rospatent. 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/allowable claims in the Rospatent application. The claim correspondence table must be written in Spanish or English.

d) copies of the references cited by the Rospatent 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. Translations of cited references are unnecessary.

**[0004]** The relevant information is obtained from the applicant by filling out a form for requesting accelerated examination under the PPH Pilot Program (see Annex 3) 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 (see Annex 3) available on the SPTO website 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 denied. The applicant is free to take any possible correcting action necessary and again requesting acceleration under the PPH.

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 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.

## **Part II- PPH using the PCT international work products from the Rospatent**

### **Request to the SPTO**

**[0001]** An applicant can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the SPTO and satisfies the following requirements under the SPTO-Rospatent 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 an accelerated examination under the PCT-PPH Pilot Program at the SPTO**

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

***(a) The relationship between the application and the corresponding international application satisfies one of the following requirements:***

- i) The application is a national/regional phase application of the corresponding international application. (See Diagrams A, A', and A'' in Annex 2)
- ii) The application is a national/regional application as a basis of the priority claim of the corresponding international application. (See Diagram B in Annex 2)
- iii) The application is a national/regional phase application of an international application claiming priority from the corresponding international application. (See Diagram C in Annex 2)
- iv) The application is a national/regional application claiming foreign/domestic priority from the corresponding international application. (See Diagram D in Annex 2)
- v) The application is the derivative application (divisional application and application claiming domestic priority etc.) of the application which satisfies one of the above requirements (i) – (iv). (See Diagram E in Annex 2)

***(b) The latest work product in the international phase of a PCT application corresponding to the application ('international work product'), namely Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Examination Authority (WO/IPEA) or the Preliminary Examination Report (IPER), indicates at least one claim is patentable/allowable.***

The applicant cannot file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

***(c) 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.

***(d) 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, the claims indicated to be patentable/allowable in the latest international work product only contains 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 to sufficiently correspond to the claims indicated as patentable/allowable in the latest international product.

***(e) SPTO has not begun examination of the application.***

## **Required documents for accelerated examination under the PCT-PPH Pilot Program at the SPTO**

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

a) a copy of the latest international work product which indicated the claims to be patentable/allowable and their Spanish or English translations if they are not in English.

In case the application satisfies the relationship [0002](a)(i), the applicant need not 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®', an applicant need not to submit these documents, unless otherwise requested by the SPTO.

(WO/ISA and IPER are usually available as 'IPRP Chapter I' and 'IPRP Chapter II' respectively in 30 months after the priority date).

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 Spanish or English translations if they are not in Spanish.

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

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 SPTO 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 SPTO 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 criteria mentioned above.

**[0004]** When an applicant has already submitted the above mentioned documents (a)-(d) to the SPTO through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attached the documents.

## **Procedure for accelerated examination under the PCT-PPH Pilot Program at the SPTO**

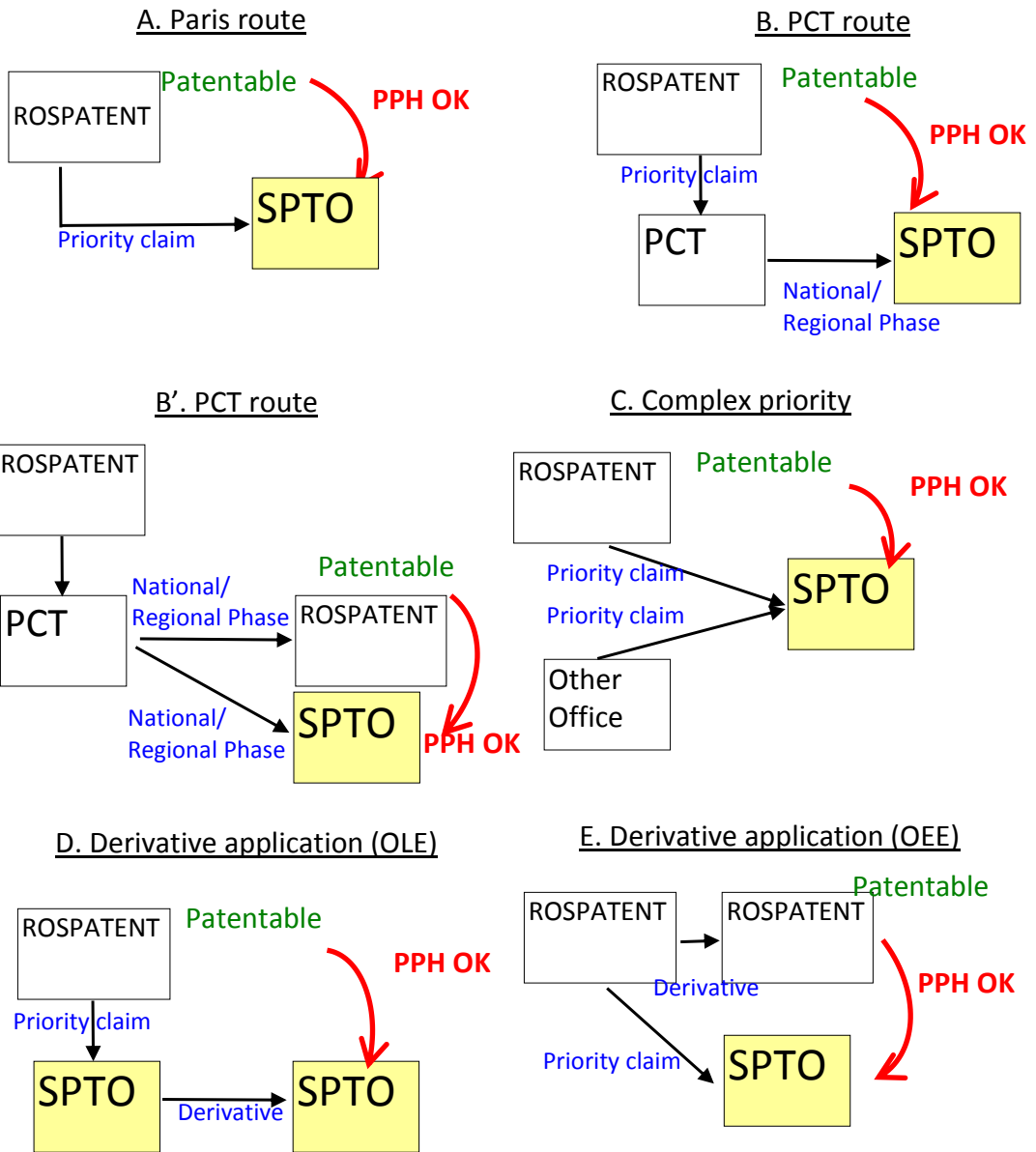
**[0005]** The applicant fills out the form requesting accelerated examination under the PCT-PPH Pilot Program (see Annex 3) available on the SPTO website and includes all the relevant supporting documents. The PCT-PPH Administrator, who will be an SPTO patent examiner, will consider the request. Where all the requirements for accelerated examination under the PCT-PPH have not been met, the PCT-PPH Administrator will notify the applicant that the application has not been allowed entry on to the PCT-PPH and will provide an explanation as to why entry on to the PCT-PPH was not possible. The applicant is free to take any possible correcting action necessary and again requesting acceleration under the PCT-PPH.

Where all of the requirements for accelerated examination under the PCT-PPH have been met, the PCT-PPH Administrator will notify the applicant that the application has been allowed entry on 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

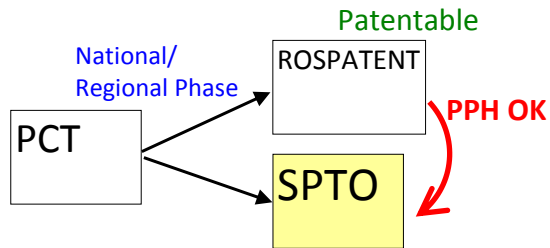
## CASE I





**CASE II**

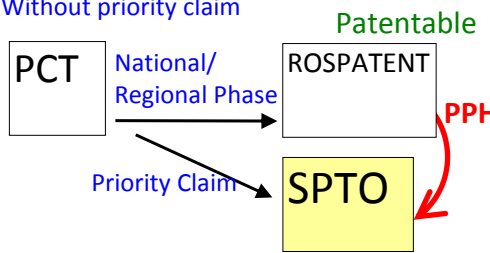
F. Direct PCT route



**CASE III**

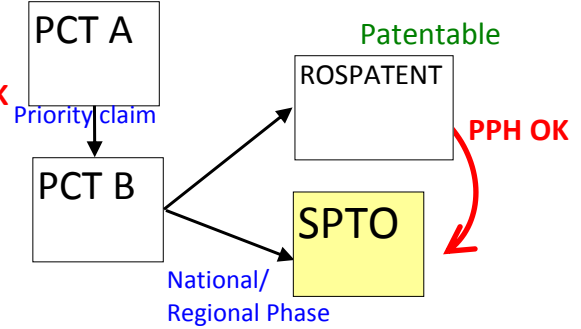
G. Direct PCT & Paris route

Without priority claim

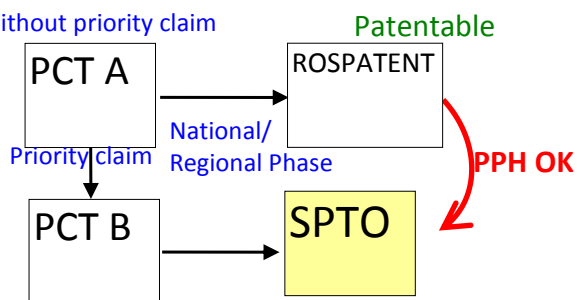


H. Direct PCT & PCT route

Without priority claim

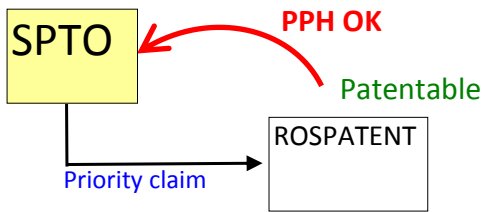


Without priority claim

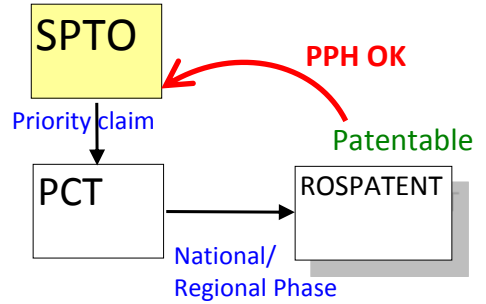


**CASE IV**

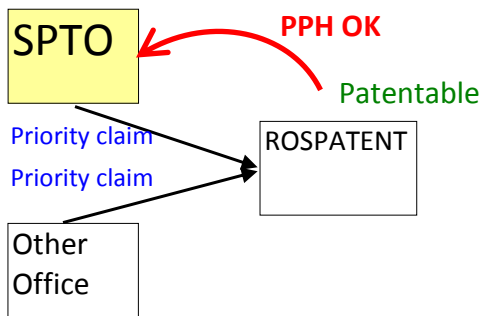
I. Paris route



J. PCT route

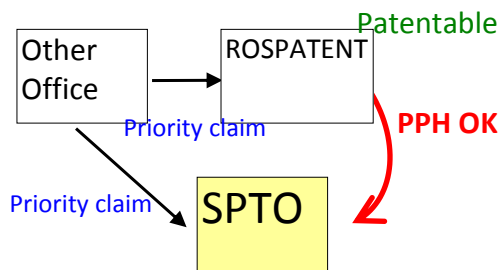


K. Paris route & Complex priority

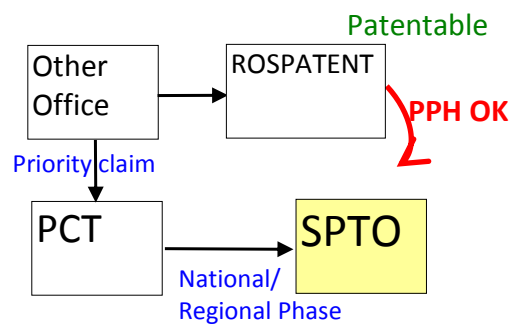


**CASE V**

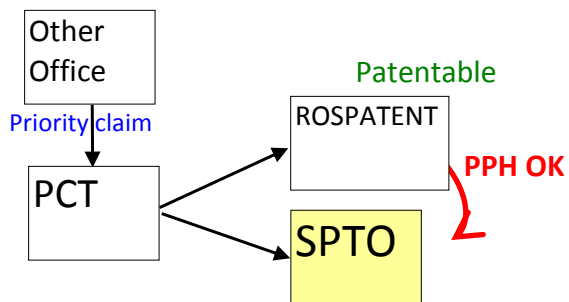
F. Paris route, the third office



G. PCT route, the third office

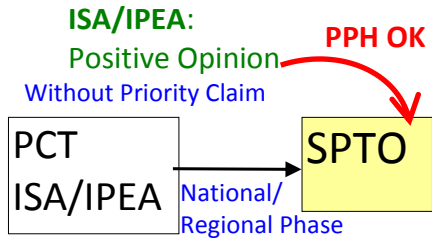


H. PCT route

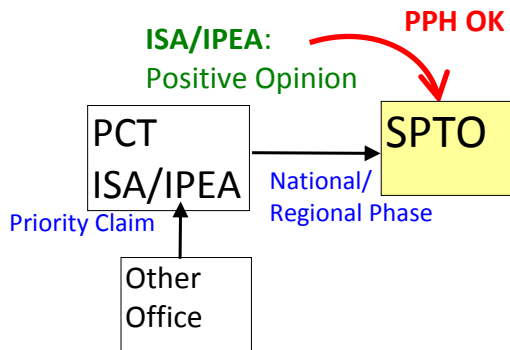


## Annex 2

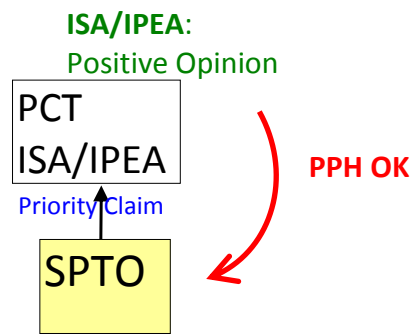
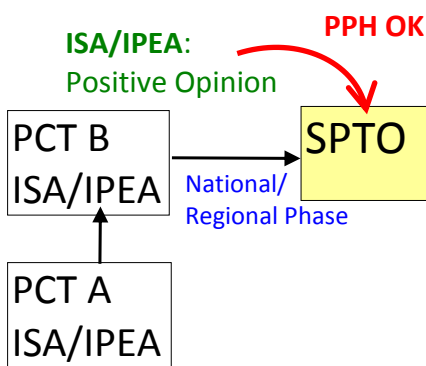
### A. National phase application



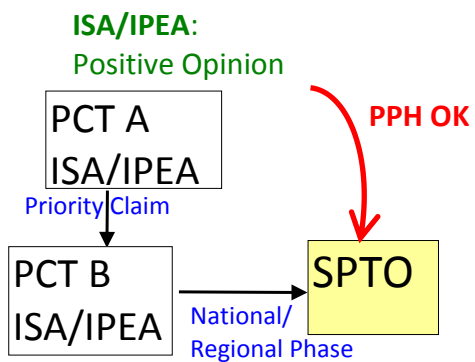
### A'. National phase application



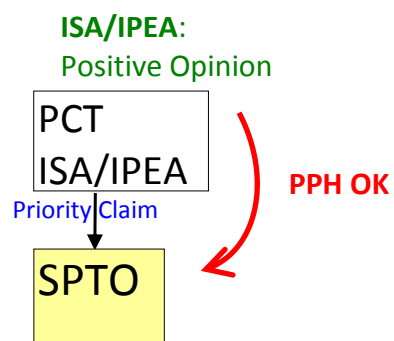
### A''. National phase application



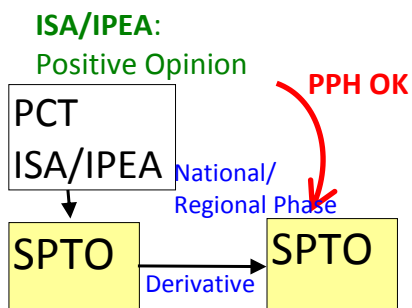
### C. National phase application



### D. Application claiming priority



### E. Derivative application



### Annex 3

<b>REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM</b>	
<b>A. Bibliographic Data</b>	
Application Number (if known)	
Title	
Date of filing	
Reference	
<b>B. Request</b>	
<b>Applicant requests participation in the Patent Prosecution Highway (PPH) pilot program based on:</b>	
Office of Earlier Examination (OEE)	
OEE Work Products Type	<input type="checkbox"/> National/Regional Office Action(s)
	<input type="checkbox"/> WO-ISA, WO-IPEA o IPER
OEE Application Number (Incl. PCT Application Number)	
<b>The applicant, if applicable to the circumstances of this case, requests the early publication of the application in accordance with Article 32 (3) of the Spanish Patent Act.</b>	
<b>C. Required Documents</b>	
<b>I. OEE Work Products and, if required, Translations</b>	
1. <input type="checkbox"/> A copy of OEE work products is attached; or <input type="checkbox"/> The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE	
2. <input type="checkbox"/> A translation of documents in 1 in a language accepted by the Office is attached; or <input type="checkbox"/> The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE	
<b>II. Patentable/Allowable Claims Determined by OEE and, if required, Translations</b>	
3. <input type="checkbox"/> A copy of all claims determined to be patentable/allowable by OEE is attached; or <input type="checkbox"/> The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE	
4. <input type="checkbox"/> A translation of documents in 3 in a language accepted by the Office is attached; or <input type="checkbox"/> The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE	
<b>III. Documents Cited in OEE Work Products (if required)</b>	
5. <input type="checkbox"/> A copy of all documents cited in OEE work products is attached (excluding patent documents); or <input type="checkbox"/> no references cited	
<b>IV. Previously submitted documents</b>	

6.  If any of the above mentioned documents have been submitted before, please specify:

**D. Claims Correspondence**

All the claims in the application sufficiently correspond to the patentable/allowable claims in the OEE application; or

Claims correspondence is explained in the following table

Application Claims	Corresponding OEE claims	Explanation regarding the correspondence

Name(s) of applicant(s) or representative(s)	
Date	
Signature(s) of the applicant / representative	