

Patent Prosecution Highway Pilot Program between the Industrial Property Office of the Czech Republic and the United States Patent and Trademark Office

A. Introduction

Generally, Patent Prosecution Highway agreements are cooperative initiatives that streamline the patent system and promote expeditious, inexpensive and high-quality patent protection throughout the world. The PPH between the two Offices will allow applicants to obtain patents faster and more efficiently. It will permit each Office to exploit the work previously done by the other Office and reduce duplication. In turn, the initiative will reduce examination workload and improve the patent quality.

The PPH was established to enable an applicant whose claims are determined to be allowable/ patentable in the Office of the first filing (OFF) to have the corresponding application filed in the Office of the 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.

Recognizing the importance of bilateral cooperation and aspiring to develop quality-focused, highly productive market-driven industrial property protection system supporting competitiveness, desiring to facilitate obtaining of patent protection by providing accelerated search and examination, the Industrial Property Office of the Czech Republic and the United States Patent and Trademark Office have agreed to launch a PPH Pilot Program as mentioned above.

B. Trial Period for the PPH Pilot Program

The PPH pilot program will commence on 1 October 2012 for a period of one year ending on 30 September 2013. The pilot program may be extended if necessary to adequately assess the feasibility of the PPH program. The IPO CZ and the USPTO 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 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 30 September 2013.

C. Procedures to file a request to the Industrial Property Office of the Czech Republic for Patent Prosecution Highway Pilot Program (PPH) between the United States Patent and Trademark Office (USPTO) and the Industrial Property Office (IPO-CZ)

1. Request to the IPO-CZ

[0001] An applicant shall file a request for a patent application procedure with accelerated examination under the Patent Prosecution Highway (PPH) to the IPO-CZ accompanied by the relevant required documents. Requirements for the request for patent application procedure under the PPH are stated in the following section (paragraph [0002]). Relevant required documentation is listed in the next section (paragraphs [0003] to [0005]) as is the general IPO-CZ application procedure (paragraph [0006]).

2. Requirements for filing a request for patent application procedure under the PPH Pilot Program at the IPO-CZ

[0002] In order to request accelerated examination under the PPH Pilot Program at the IPO-CZ, the following five requirements must be fulfilled:

a) Patent application filed at the IPO-CZ (including international PCT applications which have entered the national phase in the Czech republic) is either:

- (i) an application which validly claims priority under the Paris Convention for the Protection of Industrial Property to the corresponding USPTO application(s) (examples are provided in Annex 3, figure A, B, C, D, E and F), or
- (ii) an international PCT application which has entered the national phase in the Czech republic without priority claim (direct PCT applications) (an example is provided in Annex 3, figure G), or
- (iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in Annex 3, figure H, I and J).

An IPO-CZ patent application, which validly claims priority to multiple USPTO or PCT applications, or which is a divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

b) At least one corresponding USPTO application exists and has one or more claim(s) that have been determined to be patentable by the USPTO.

Claims clearly identified to be patentable in the latest office action during the examination procedure at the USPTO can form the basis of a request for an accelerated examination under the PPH Pilot Program even if the USPTO has not yet granted a patent for these claims. If the USPTO office action does not explicitly state that a particular claim is patentable, the applicant must submit a statement that no rejection has been made in the USPTO office action regarding this claim and therefore, the claim is deemed patentable by the USPTO. Such a statement must be included in the request for participation in the PPH Pilot Program.

If the USPTO application that contains the patentable/allowable claims is not the same application for which priority is claimed in the IPO-CZ patent application, the applicant must identify the relationship between the USPTO application that contains the patentable/allowable claims and the USPTO priority application claimed in the IPO-CZ patent application (see Example C and E in Annex 3).

c) For accelerated examination under the PPH, all claims in the IPO-CZ application must sufficiently correspond to one or more of those claims determined to be patentable in the USPTO.

All claims in each IPO-CZ patent application for which a participation in the PPH Pilot Program is requested must sufficiently correspond or be amended to correspond to the patentable/allowable claims in the USPTO application(s).

Claims shall be considered to sufficiently correspond where both claims have common technical feature(s) which made the claims patentable over the prior art in the USPTO application. In this regard, a claim which has additional component(s) compared to the claim determined to be patentable by the USPTO or which is the same except for claim format as the claim determined to be patentable by the USPTO will be considered to sufficiently correspond.

Note that when claims are determined to be patentable by the USPTO after making amendments to the claims, the claims at the IPO-CZ must be also amended in a similar way to sufficiently correspond to the patentable claims in the USPTO application (see Annex 1).

d) The IPO-CZ has not yet finished the substantive examination and has not yet invited the applicant to pay the administration fee for issue of the Patent Letter.

In view of the Czech national legislation, fulfillment of a fifth requirement is necessary:

e) No later than the date of filing of this request, it is necessary to file a request for substantive examination of the patent application according to Section 33 of Act No. 527/1990 Coll. on Inventions and Rationalisation Proposals, and pay the relevant administration fee associated with this request.

3. Required documents for the procedure of accelerated examination under the PPH Pilot Program at the IPO-CZ:

[0003] Documentation needed to support a request for accelerated examination under the PPH Pilot Program at the IPO-CZ:

a) A copy of the office action(s) relating to the corresponding USPTO application(s).

“Office actions” are documents which relate to substantive examination and which were sent to the applicant or the applicant’s representative by the USPTO examiner.

The applicant shall provide the office actions together with the request for the acceleration under the PPH.

It is noted that the applicant must also submit copies of any office actions (which are relevant to assessment of patentability) from the USPTO application(s) issued after the grant of the request for participation in the PPH Pilot Program at the IPO-CZ (especially where USPTO might have reversed a prior opinion on allowability/patentability of the claims).

Submission of translations of the office action(s) is not required. However, the applicant will be free to file Czech translation as a part of the supporting documentation when filing the request to allow prompt consideration of the office actions if so desired.

b) A copy of the claims determined to be patentable by the USPTO including any subsequent amended claims found to be patentable by the USPTO.

The copy of the claims determined to be patentable/allowable by the USPTO might be either:

- a copy of the document submitted at initial filing which includes claims determined to be patentable where no later amendments to the claims have been made, or
- a copy of the amendments which includes claims determined to be patentable where later amendments to the claims have been made, or
- a copy of the USPTO’s publication of the granted patent.

The applicant shall provide the claims together with the request for acceleration under the PPH.

Submission of translation of the claims is required.

c) A completed claim correspondence table

The applicant must submit a claim correspondence table to explain the correspondence of claims determined to be patentable by the USPTO and the claims of the patent application filed at the IPO-CZ with request for accelerated examination under the PPH. When claims are just literal translation, the applicant can just write down that “claims are the 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 point 2.c) (see also Annex 1 for examples of claim correspondence).

Any claims amended or added after the grant of the request for participation in the PPH Pilot Program must sufficiently correspond to one or more allowable/patentable claims in the USPTO application(s). The applicant is required to submit a new claim correspondence table along with the amendments. If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the USPTO application(s), the amendment will not be accepted.

d) A copy of the references cited by the USPTO examiner

If the cited references are patent documents, it will not be necessary to submit these documents as they will usually be available to the IPO-CZ. If the IPO-CZ does not have access to the relevant patent documents, the applicant must submit these documents at the request of the IPO-CZ.

Non-patent literature must always be submitted.

Submission of translations of these references is not required. However, applicant will be free to file translations as a part of the supporting documentation when filing the request for procedure with accelerated examination under the PPH to allow prompt consideration of the documents. The IPO-CZ will request translations of the documents when necessary; certification of translations is not required.

[0004] The applicant is required to complete a request form for a procedure with accelerated examination under the PPH Pilot Program (as given in Annex 2) which is available for download from the IPO-CZ website (<http://www.upv.cz>). The form must be sent to the IPO-CZ along with the relevant required documentation.

[0005] When the applicant has already submitted the above listed documents 3.a) to 3.d) to the IPO-CZ during simultaneous or past procedures, the applicant may incorporate these documents by reference and does not have to attach them.

4. Procedure regarding the request for accelerated examination under the PPH Pilot Program at the IPO-CZ

[0006] The applicant files a request form for a procedure with accelerated examination under the PPH Pilot Program to the IPO-CZ along with the documents referred to in point 3 (Annex 2).

The applicant is not required to pay any fee for accelerated examination under the PPH.

Upon receiving a request with the documents stated in point 3 of this document, the IPO-CZ decides whether the application can be entitled to the status for an accelerated examination under the PPH. When the IPO-CZ decides that the request is acceptable, the application is assigned a special status for a procedure under the PPH.

In those instances where the request does not fulfill all the requirements stated in this document, the applicant will be notified and informed about the defects in the request. The applicant will be given opportunity to correct or complete the request. If the request and required documents are not appropriately corrected/completed, the applicant will be notified and informed that the patent application will not be included in the PPH project.

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Date:

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