



EXAMINATION under PATENT PROSECUTION HIGHWAY (PPH) PROGRAMS in RUSSIA

Bilateral PPH and PCT-PPH pilot programs of ROSPATENT

Japan Patent Office (PPH since 08.05.2009)

Korean Intellectual Property Office(PPH since 02.11.2009)

United States Patent and Trademark Office (PPH since 01.09.2010; PCT-PPH since 01.10.2010)

Finnish Patent and Registration Office (PPH and PCT-PPH since 01.03.2011)

Spanish Patent and Trademark Office (PPH and PCT-PPH since 01.04 2011)

Danish Patent and Trademark Office (PPH 01.02.2012)

State Intellectual Property Office of the People's Republic of China (PPH and PCT-PPH since 01.07.2012)

European Patent Office (PPH and PCT-PPH since 01.02.2017)

Global Patent Prosecution Highway System

Participating Offices (06.01.2014)

Austrian Patent Office
Australian Patent Office
Canadian Intellectual Property Office
Superintendence of Industry and Commerce (Colombia)
German Patent and Trade Mark Office
Danish Patent and Trademark Office
Estonian Patent Office
Spanish Patent and Trademark Office
Finnish Patent and Registration Office (PRH)
Intellectual Property Office (United Kingdom)
Hungarian Intellectual Property Office
Israel Patent Office
Icelandic Patent Office
Japan Patent Office
Korean Intellectual Property Office
Norwegian Industrial Property Office
Intellectual Property Office of New Zealand
Patent Office of the Republic of Poland
National Institute of Industrial Property (Portugal)
Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation)
Swedish Patent and Registration Office
Intellectual Property Office of Singapore
United States Patent and Trademark Office
Nordic Patent Institute
Visegrad Patent Institute

List of documents for PPH programs, PPH-MOTTAINAI

1. Request for the examination of the application under the PPH program
2. A claims correspondence table
3. Copies of all office actions in OFF / OEE, which were sent for the corresponding application by OFF / OEE (the decision to grant a patent in OFF / OEE; search report of OFF / OEE; copies opposing documents; copies of non-patent literature cited by the OFF / OEE, and translations of them
4. Copies of all claims determined to be patentable/allowable by OFF / OEE, and translations of them
5. A petition for substantive examination

List of documents under the PCT-PPH program

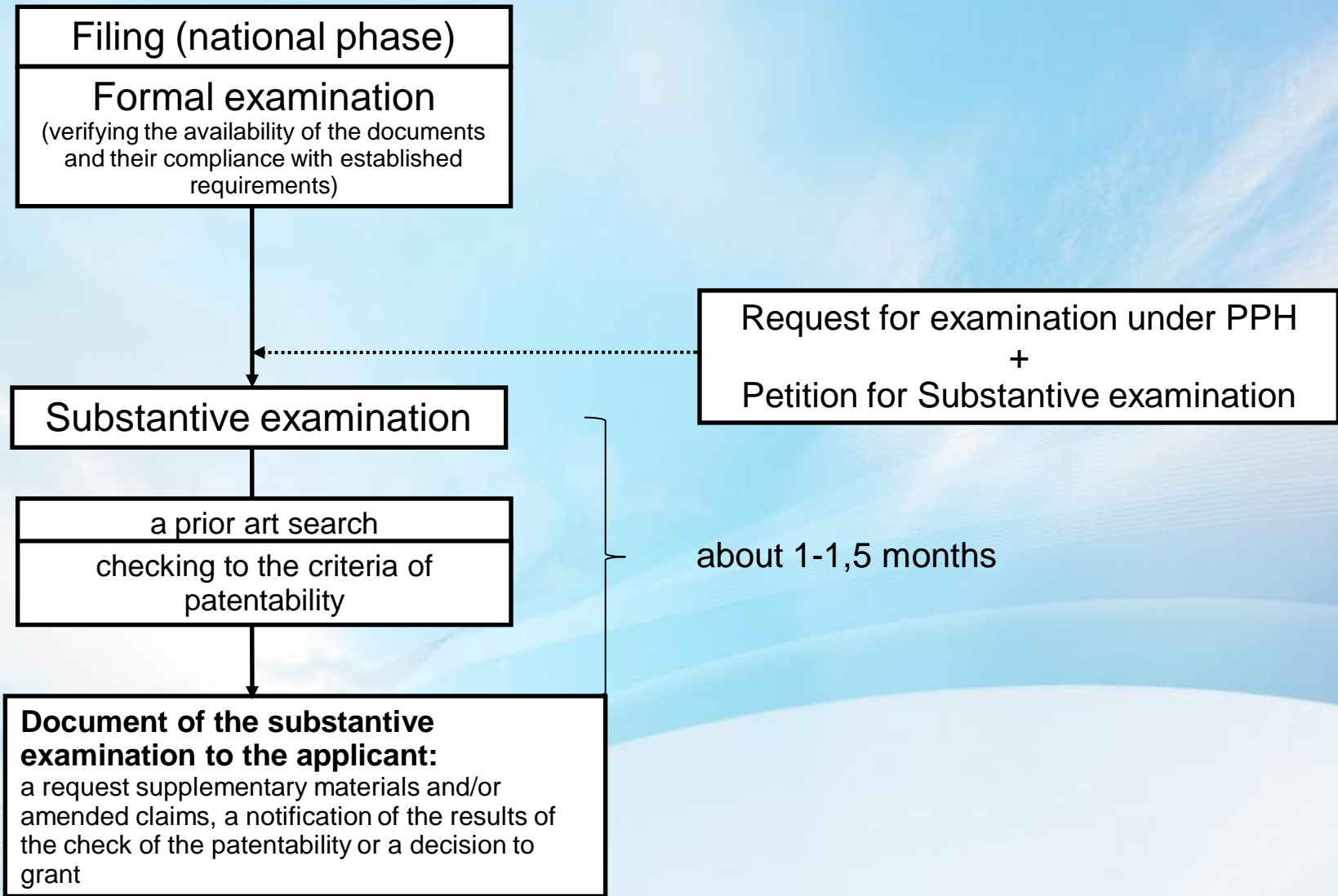
1. Request for the examination of the application under the PPH program
2. A copy of the latest international work product which indicated the claims to be patentable/allowable and their English or Russian translations.
3. A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable
4. A copy of references cited in the latest international work product of the international application corresponding to the application.
5. A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable.
6. A petition for substantive examination.

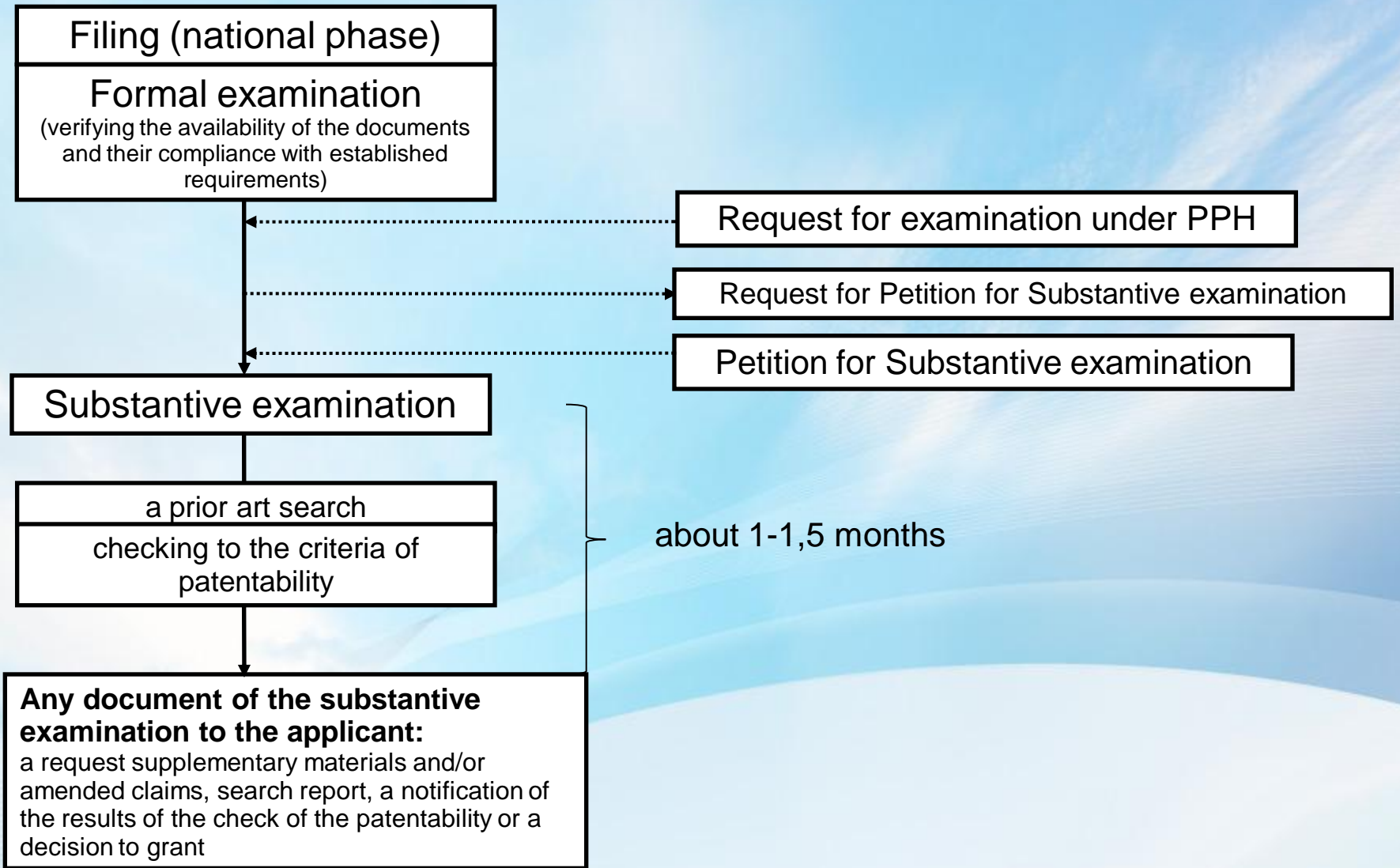
List of documents under the GPPH program

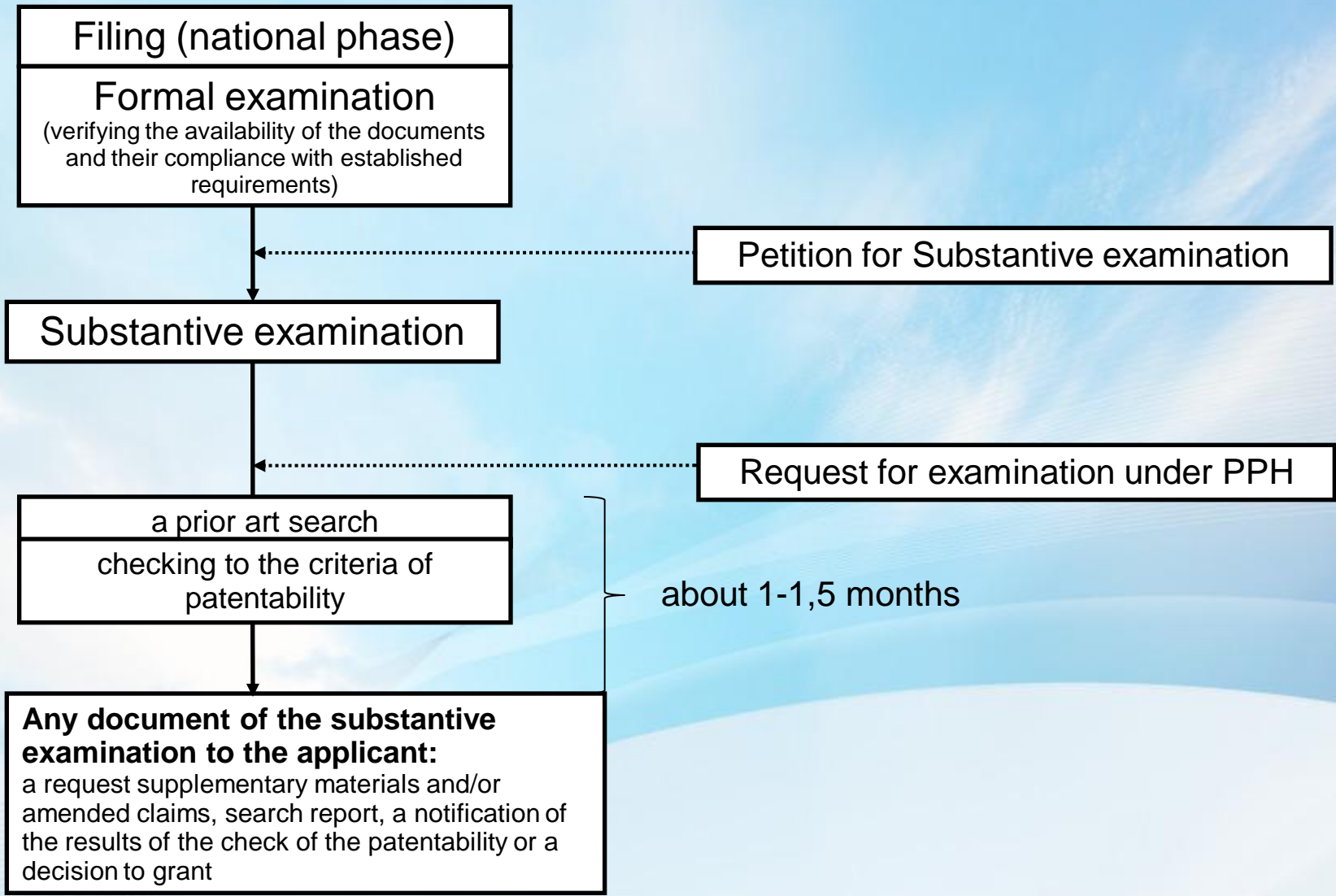
1. Request for GPPH examination;
2. A copy of the work product(s) which are relevant to the allowability of the claims of the corresponding OEE application;
3. A copy of the claims found to be allowable by the OEE;
4. A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable;
5. Copies of non-patent literature cited by the OEE;
6. A petition for substantive examination.

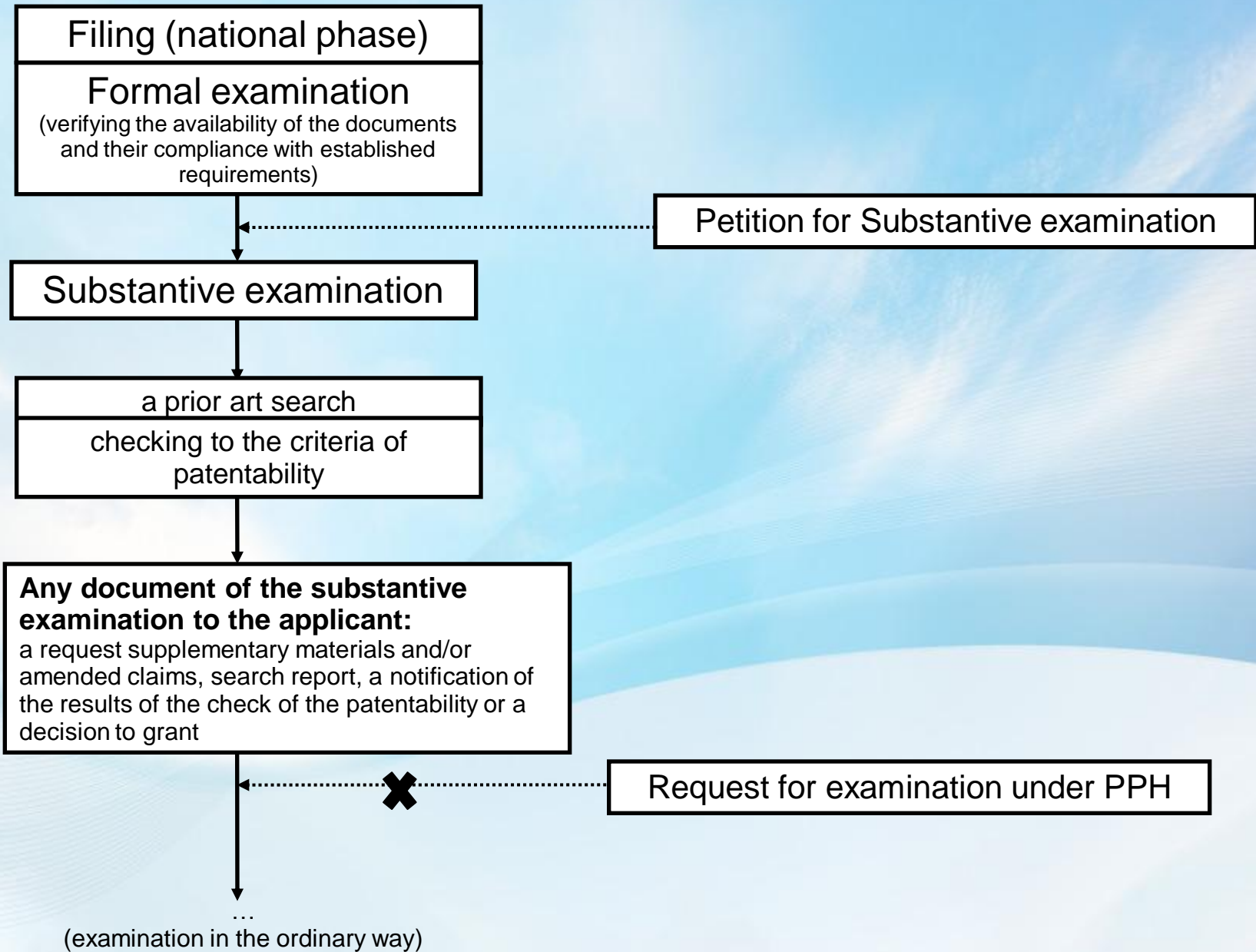
Each of the claims to be examined under PPH program must “*sufficiently correspond*” to the respective claim considered allowable by OFF /OEE. So the claims for PPH program should be put in line with the claims considered allowable by OFF /OEE. “*Sufficiently correspond*” means the claims although having differences due to translation matters and format of drafting but still keeping the same or similar scope, or being narrower. A claim has a narrower scope when it is restricted by inserting additional feature supported by the specification or claims.

Claims don't “*sufficiently correspond*” when it introduces a new/different category of claims with respect to the claims allowable by the first patent office. E.g. the claims allowable by OFF /OEE contain process claim and the claims to be examined under PPH program comprise product claim dependent on the process claim.









Article 27 Patent Cooperation Treaty (PCT)

(5) Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.

PPH treaties also don't restrict to apply criteria of national law in respect of prior art and conditions of patentability

Examination under any PPH program includes:

1. analysis of documents cited in the search report of OFF/OEF
2. own prior art search with respect to claimed invention/group of inventions as it defined in claims changed by applicant under PPH program **in accordance with national law**
3. checking of compliance of claimed invention/group of inventions the established criteria of patentability **in accordance with national law**

Benefits of PPH

Reduction of examination time:

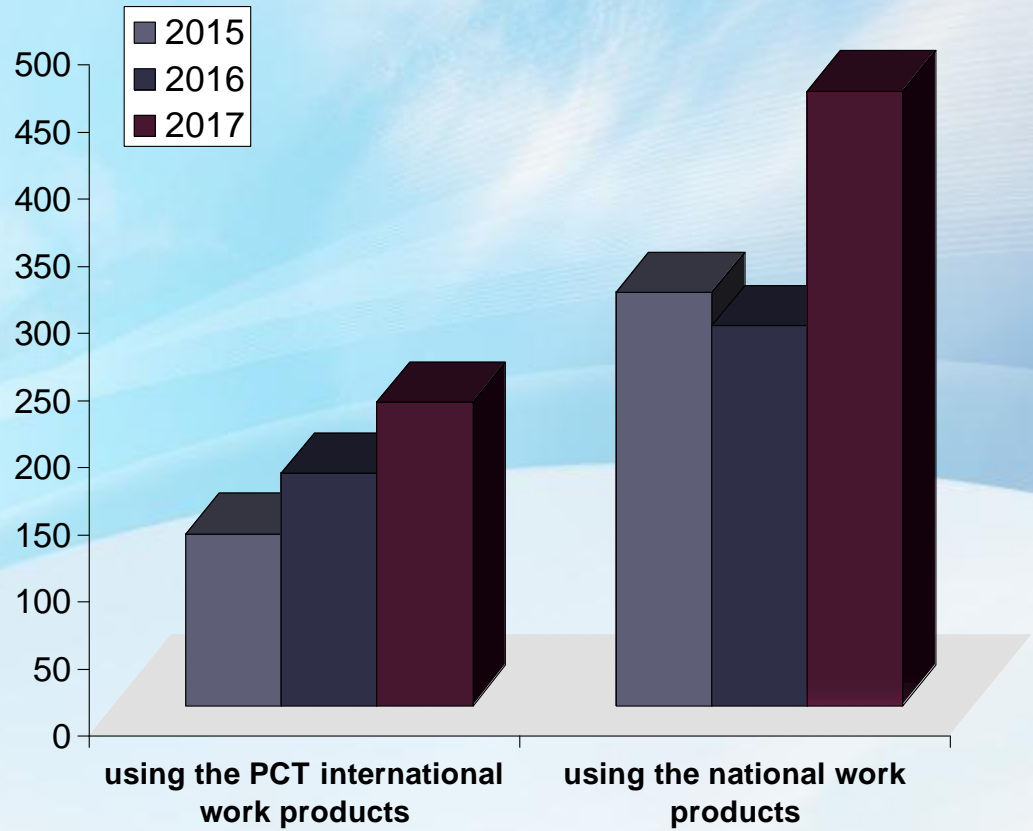
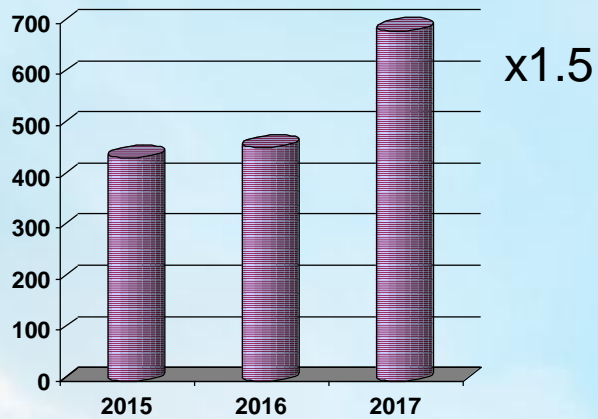
OSF / OLE begins to conduct substantive examination on the application earlier.

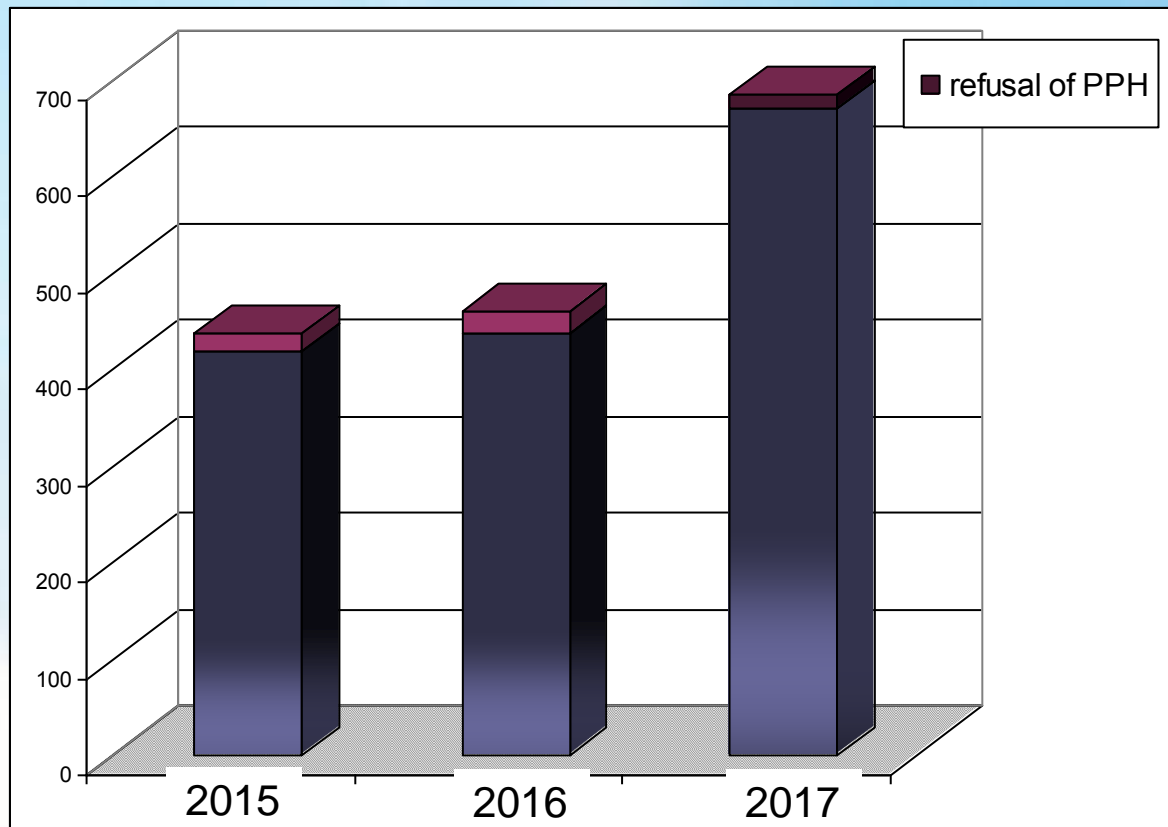
OSF / OLE has the ability not to repeat the work with the claims that OFF / OEE has already done, but to make a shorter examination due to a reduction in a number of actions, including verifying of unity and clarity.

Improving the quality:

Conducted in the OSF / OLE examination of the application, which actually carried out substantive examination in OFF / OEE, improves the quality of consideration of the application, since the examiner uses the additional information, including the information search and correspondence with the applicant, conducted by OFF / OEE.

Patent applications under PPH





refusal of PPH, %	2015	2016	2017
National product	3.6	3.9	1.5
PCT product	5.5	6.8	3.5



Thank you

CONTACTS

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FIPS: www1.fips.ru

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