

Procedures and Requirements for Filing a Request for Patent Prosecution Highway Pilot Program (PPH) at the National Institute of Industrial Property of the Argentine Republic (INPI).

Background

These presents are subscribed by the parties within the scope of the PPH Pilot Program agreed upon by and between the National Institute of Industrial Property of the Argentine Republic (INPI) and the Japan Patent Office (JPO) pursuant to the “Joint Statement of Intent for Cooperation in Patent Prosecution Procedures” signed in Geneva on October 5, 2016 by the representatives of the above mentioned entities.

The PPH Pilot Program was established so that, once the Office of Earlier Examination (OEE) has determined patentability of an application, the applicant may request the benefit of accelerated examination of the corresponding application at the Office of Later Examination (OLE), provided that the requirements set forth herein are fulfilled.

The Offices intend that only utility patent applications be subject of or basis for any request for participation in the PPH pilot program in either Office.

This document is intended to define in detail the necessary procedures and requirements for requesting application of the PPH Pilot Program between JPO and INPI.

The JPO and INPI will publish this guideline as well as the necessary forms for requesting participation in the PPH Pilot Program.

The PPH Pilot Program between the INPI and the JPO shall become effective on (month/day/year) for a trial period of 3 years. The INPI and the JPO will evaluate

the results of the pilot program to determine whether and how the program should be fully implemented after the trial period.

Participating offices may terminate the PPH pilot program if the participation volume exceeds the manageable level or for any other reason. Prior notice shall be published when the PPH pilot program is terminated.

This pilot program does not create any legally binding rights or obligations under national or international law.

1. Requirements for Filing Request to INPI for Patent Accelerated Examination under the PPH Pilot Program.

In order to be eligible to participate in the PPH accelerated examination, the following requirements shall be fulfilled:

(a) Both the INPI application on which PPH is requested and the JPO application being the basis of the PPH request shall be corresponding applications (See examples in ANNEX II) having the same earliest date (either a priority date or a filing date).

Applicant shall submit the necessary information to determine the relationship between the application on which the accelerated examination is requested and the corresponding application(s) filed with the JPO.

The expression “corresponding patent applications” should not be necessarily construed as referred to the application on which a priority claim is based, but it could refer to the application derived from the application on which priority is claimed. For example, a divisional application of the application or an application claiming national priority of the application on which priority is claimed.

For example, the INPI application may be:

(Case I) an application which validly claims priority under the Paris Convention based on the JPO application(s), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the JPO application(s), or

(Case III) an application which shares a common priority document with the JPO application(s).

The pilot program is not applicable on the basis of JPO applications for “utility model”.-.

(b) The corresponding application has been substantively examined by JPO and has one or more claims considered as patentable by the JPO

Claims considered patentable shall be expressly identified as such in the granted patent or in the Office action issued by the JPO and they will be the basis for the request for participation in the PPH program, notwithstanding the fact that the application including said claims have not yet been granted. The Office action may be “Decision to Grant a Patent”.

(c) In order to be examined pursuant to PPH, all the application claims, either as originally filed or as amended, shall sufficiently correspond to one or more of those claims indicated as patentable by the JPO so that the INPI application may be then allowed for accelerated examination under the PPH framework.

Claims are considered to "sufficiently correspond" when, considering differences due to translation and/or claim format, the scope of claims in the INPI application are the same as or narrower than that of claims in the JPO application.

In this regard, a claim that is narrower in scope occurs when a JPO 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 INPI application which introduces a new/different category of claims to those claims indicated as patentable by the JPO shall not be considered to sufficiently correspond. For example, where the JPO claims only contain claims on a process of manufacturing a product, then, if the INPI claims introduce product claims that are dependent on the corresponding process claims, the INPI claims shall not be considered to sufficiently correspond.

Any claims amended or added after the request for participation in the PPH pilot program is allowed but Examiner must sufficiently correspond to the claims indicated as patentable by the JPO in order to benefit from the PPH accelerated examination.

(d) A request for substantive examination was filed at INPI, either at the time of the PPH request or previously, and the substantive examination fee was paid.

(e) INPI application is open to the public.

(f) INPI has not begun substantive examination of the application at the time the PPH is requested.

2. Supporting documentation for a PPH request.

The request form for INPI accelerated examination within the PPH pilot program shall include the following documents:

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opies of all Office actions (relevant to substantive examination for patentability at the JPO), which were issued in the corresponding application by the JPO, and their translation.

(b) Copies of all claims determined as patentable by the JPO and their translation.

The applicant does not have to submit (a) and (b) when those documents are provided via dossier access system. If they cannot be obtained by the INPI examiner, the applicant may be notified and requested to provide the necessary documents. Spanish is acceptable as translation language.

(c) Copies of references cited as relevant by the JPO examiner

If references are patent documents, the applicant should not submit them because they are generally available to the INPI. When a patent document is not available to the INPI examiner, the applicant must submit it at the examiner's request. Non-patent literature must always be submitted accompanied by their respective translation.

When the applicant has already submitted above documents (a) to (c) to the INPI through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

(d) Claim Correspondence Table.

The applicant requesting the PPH must submit a claim correspondence table, which will indicate how all claims in the INPI application sufficiently correspond to the patentable-claims in the JPO application.

When claims are just a literal translation, the applicant may only indicate that "they are the same" in the table. When claims are not just a literal translation, the sufficient correspondence of each claim must be explained.

3. Procedure for the accelerated examination under the PPH pilot program

NPI decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When INPI decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again.

4. National Law and Regulation

The decision regarding patentability of patent applications remains on each Office criteria, in line with its own national legislation.

ANNEX I

Solicitud de examen acelerado ante la Administración Nacional de Patentes (ANP) dentro del Programa Piloto PPH (*Request for participation in the PPH Pilot Program*)

A. DATOS BIBLIOGRÁFICOS (*Biographic data*)

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|---|
| Número de solicitud ANP: <i>(Application number)</i> |
| Fecha de presentación de la solicitud ANP: <i>(Date of filing)</i> |
| Prioridad: <i>(Priority number)</i> |
| B. SOLICITUD <i>(Request)</i> |
| El solicitante pide participar en el procedimiento acelerado de examen (PPH) con base en: <i>(Applicant request participation in the PPH pilot program based on)</i> |
| Oficina de Examen anterior (OEA) <i>(Office of earlier examination –OEE–)</i> |
| Número de solicitud de la OEA <i>(OEE application number)</i> |
| Tipo de tarea realizada por la OEA <i>(OEE work products)</i> |
| C. DOCUMENTOS REQUERIDOS <i>(Required Documents)</i> |
| 1.- Documentos/tareas realizadas por la OEA, y traducciones en caso de corresponder <i>(OEE Work Products and , if required, translation)</i> |
| <ul style="list-style-type: none"> • Se adjunta copia de los documentos/ tareas realizadas por la OEA; o <i>(A copy of OEE work products is attached; or)</i> • Se pide a la ANP que recupere los documentos a través del sistema base de datos de patentes y/o patentscope <i>(The office is required to retrieve documents from the patent database or PATENTSCOPE)</i> • Se adjunta traducción al español de los documentos <i>(A spanish translation of documents is attached)</i> |
| 2.- Reivindicaciones patentables determinadas por la OEA y traducción (en caso de corresponder) <i>(Patentable claims determined by OEE, and translation if required)</i> |
| <ul style="list-style-type: none"> • Se adjunta copia de todas las reivindicaciones que se ha determinado que son patentables por la OEA <i>(A copy of all claims determined to be patentable by OEE)</i> • Se pide a la ANP que recupere los documentos a través del sistema base de datos de patentes y/o patentscope <i>(The office is requested to retrieve documents via)</i> • Se adjunta traducción al español de los documentos <i>(A spanish translation of documents is attached)</i> |
| 3.- Documentos citados en las tareas realizadas por la OEA <i>(Documents cited in OEE work</i> |

| | | |
|---|---|---|
| <i>product)</i> | | |
| <ul style="list-style-type: none"> Se adjunta copia de los documentos indicados por el examinador de la OEA. (No es necesario aportar los documentos de patentes) <i>(A copy of the documents cited in OEE work product)</i> | | |
| D. CORRESPONDENCIA DE REIVINDICACIONES <i>(Claims correspondence)</i> | | |
| <p>Todas las reivindicaciones de la solicitud se corresponden suficientemente con las reivindicaciones patentables/admisibles de la solicitud OEA; o <i>(All the claims in the application sufficiently correspond to the patentable/allowable claims in the OEE application, or)</i></p> <p>La correspondencia de las reivindicaciones se explica en la siguiente tabla <i>(Claims correspondence is explained in the following table)</i></p> | | |
| Reivindicaciones consideradas patentables en la OEA <i>(claims considered patentable by the OEE)</i> | Reivindicaciones correspondientes ANP (INPI) <i>(corresponding applications claims)</i> | Comentarios que explican la correspondencia <i>(explanation regarding the correspondence)</i> |
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| Nombre de los solicitante(s) o representante(s) <i>(Name(s) of applicant(s) or representative (s))</i> | | |
| Fecha: <i>(date)</i> | | |
| Firma de solicitante/representante: <i>(Signature of applicant/representative)</i> | | |

ANNEX II

Examples of JPO Patent applications for which accelerated examination can be requested under the PPH Pilot Program.

The following examples refer to JPO and INPI (this latter being the office to which participation in PPH pilot program is requested.)

Example A, Paris Route

Example B, Paris Route and Divisional Application.

Example C, Paris Route.

Example D, Paris Route.

Example E, Paris Rout, but First Application is from a Third Country.

Example F, Paris route and via PCT

ANNEX III

Examples of Cases considered to “Sufficiently Correspond” and Cases not considered to “Sufficiently Correspond”.

1. Claims in the following cases (case 1 to 4) are considered to “sufficiently correspond”:

| Case | “Patentable/Allowable” Claims | | INPI Claims | | Comment |
|--------|----------------------------------|-----------------|-------------|-----------------|--|
| | No. | Content | No. | Content | |
| Case 1 | 1 | A | 1 | A | Claim 1 at INPI application is the same as the “patentable/allowable” claim 1. |
| Case 2 | 1 | A | 1 2 | A A+a | Claim 1 at INPI application is the same as “patentable/allowable” claim 1. Claim 2 at INPI application is created by adding a technical feature described in the specification to “patentable/allowable” claim 1. |
| Case 3 | 1 2 3 | A A+a A+b | 1 2 3 | A A+b A+a | Claim 1 at INPI application is the same as “patentable/allowable” claim 1. Claims 2, 3 at INPI application |

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| | | | | | are the same as “patentable/allowable” claims 3, 2, respectively. |
| Case 4 | 1 | A | 1 | A+a | Claim 1 at INPI application has an additional technical feature “a” described in the specification. |

2. Claims in the following cases (cases 5 and 7) are NOT considered to “sufficiently correspond”:

| Case | “Patentable/Allowable” Claim(s) | | Claim(s) INPI application | | Comment |
|--------|------------------------------------|--------------|------------------------------|--------------|---|
| | No. | Content | No. | Content | |
| Case 5 | 1 | A Product | 1 | A’ Method | Claim 1 at INPI application defines a method while “patentable/allowable” claim 1 defines a product. The technical feature of the “patentable/allowable claim” is the same as at the INPI claim but they have different categories. |
| Case 6 | 1 | A+B | 1 | A+C | Claim 1 at INPI application is different from “patentable/allowable” claim 1 as to a component of the invention claimed. The INPI claim is created by |

| | | | | | |
|--------|---|-----|---|---|--|
| | | | | | changing part of the technical features of the “patentable/allowable” claim. |
| Case 7 | 1 | A+b | 1 | A | Claim 1 at INPI application is different from “patentable/allowable” claim 1 as to a component of the invention claimed. The INPI claim is broader than the “patentable/allowable” claim. |