

Procedure to file Request to the Eurasian Patent Office (EAPO) for accelerated patent prosecution of patent application in accordance with the Patent Prosecution Highway Pilot Programme between the Eurasian Patent Office and the Finnish Patent and Registration Office

The Patent Prosecution Highway Pilot Programme (PPH Pilot Programme) between the Eurasian Patent Office (EAPO) and the Finnish Patent and Registration Office (PRH) will commence on August 1st, 2020 with duration of three years and end on July 31st, 2023. The pilot period may be extended upon mutual consent between EAPO and PRH.

The Offices may terminate the PPH pilot program if the volume of participation exceeds manageable level. Ex Ante notice will be published if the PPH pilot Programme is terminated.

1. Requirements

1.1. The EAPO application (included the PCT application entered into regional phase at EAPO) for which participation in the PPH Pilot Programme is requested and the corresponding application on the basis of which the request on participation in PPH is filed shall have the same date of priority or the same date of filing.

The corresponding application forming the basis for filing a request for participation in the PPH Pilot Programme (PPH request) (the PRH application), may be:

- (i) the application filed with PRH (examples brought in the attached Annex 1, pic. A-M) or;
- (ii) the PCT application, in which PRH acts as an International Searching Authority (ISA) and/or International Preliminary Examining Authority (IPEA) (examples brought in the attached Annex 2, pic. A-E).

1.2. The corresponding application shall contain at least one claim determined as patentable by PRH acting as a national patent office or as an ISA and/or an IPEA.

The claim recognized as having novelty, inventive step and industrial applicability by PRH acting as an ISA and/or IPEA shall, for the purpose of this Procedure, be deemed as patentable.

The PRH application claims shall be deemed as “determined as patentable” if the PRH has explicitly identified the invention as patentable in the last office action OK, even if patent on this application is not yet granted.

1.3. All claims of the EAPO application, as originally filed or as amended, for which a PPH request is filed must sufficiently correspond to one or more of those claims determined as patentable by PRH.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translation into Russian and claim format, the claims in the EAPO application are of the same or similar scope as the claims in the PRH application, or the claims in the EAPO application are narrower in scope than the claims in the PRH application.

A claim in the EAPO application shall be deemed narrower in scope if a PRH application 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 EAPO application which introduces a new/different category of claims to those claims indicated as patentable in the PRH application shall not be deemed to sufficiently correspond if it represents a new or another category of claims compared to those claims recognized as acceptable by PRH. For example, where the claims in the PRH application only contain claims to a process of manufacturing a product, then the claims in the EAPO application are not considered to sufficiently correspond if the claims in the EAPO application introduce product claims that are dependent on the corresponding process claims.

It is not necessary that all the PRH application claims recognized as patentable be fully reproduced in the EAPO application (the exclusion of the claims is permissible).

Any claims amended or added after the grant of a PPH request, but before the first EAPO office action, need to sufficiently correspond to the claims indicated as patentable in the PRH application. Any claims amended or added after the first EAPO office action, need not to sufficiently correspond to the claims indicated as patentable in the PRH application, provided that the amendments are made by the applicant with the aim of elimination of the examination remarks/objections regarding the invention/claim not to correspond the requirements of the Normative Legal Acts of the Eurasian Patent Organization.

1.4. Substantive examination of the application has not begun at the moment of filing a PPH request to the EAPO.

1.5. For EAPO application, applicant must request for the substantive examination and pay the fees prescribed for substantive examination.

2. Documents to be submitted

To qualify for participation in the PPH Pilot Programme an applicant shall submit:

a) a PPH request. The PPH Request Form is available at the EAPO website in the section Documents/Electronic forms (in Russian) (Annex 3);

b) copies of all office actions (which are relevant to substantial examination for patentability in PRH) which were issued for the corresponding

application, and Russian or English translations thereof, or a copy of the last work product in the international PCT phase, i.e. ISA report, or IPEA report (in case the request was filed in compliance with PCT Chapter II) or the International Preliminary Examination Report (IPER) as well as the Russian or English translation thereof;

(c) copies of all claims indicated as patentable in PRH and Russian or English translation thereof;

(d) copies of documents cited by PRH examiner.

If the cited document is a patent document the applicant needs not present it as this kind of documents are usually accessible for EAPO. In case EAPO does not possess the required document the applicant must submit this patent document at the EAPO request. Non-patent literature shall always be submitted. Submission of translation of the cited documents is required if their translation into Russian or English is not available;

(e) a table of claims correspondence.

The applicant submitting a PPH request must submit a table of the claims correspondence that explains the correspondence of the claims in the EAPO application to the claims that are recognized as patentable in the PRH application.

If the claims are translated literally the applicant may write in the table "claims are identical". If the claims are not a literal translation, the table should explain the conformity of each claim.

If the applicant has already submitted to the EAPO the documents specified in items (b) to (e) during simultaneous or previous procedures, the applicant can include them by referring to them, without attaching the documents themselves. If the documents specified in items (b) and (c) are available in the WIPO Digital Access Service (DAS) or the PATENTSCOPE database, the applicant is not required to file copies of the documents, but must provide a list of documents to be retrieved. For the documents specified in items (b) and (c), the use of machine translation is permissible. In case of poor quality of machine translation, EAPO may ask the applicant to provide an accurate translation. If the PRH application is not published, then the applicant must submit the documents specified in items (b) and (c) above when requests on participation in PPH Pilot Programme.

3. Procedure for considering the PPH request

The decision to satisfy the PPH request is made subject to the fulfillment of all the requirements specified in paragraphs 1 and 2 of this Procedure, which the applicant is notified about.

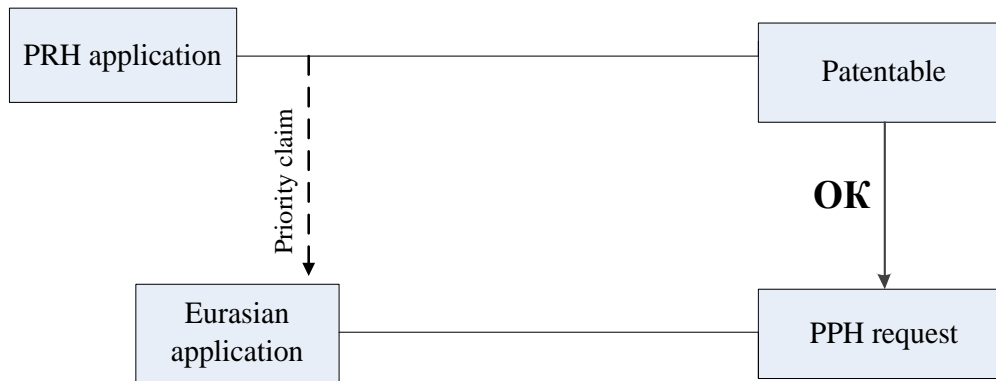
If all the requirements necessary to satisfy the PPH request are not complied with by the applicant and which can be eliminated by the applicant, EAPO shall notify the applicant about the need to correct the identified deficiencies within

the time specified in the notification.

If the applicant does not eliminate these shortcomings, EAPO will inform the applicant of the refusal to satisfy the request. In this case, the EAPO application is subject to examination in the order of priority within the framework of the EAPO procedure.

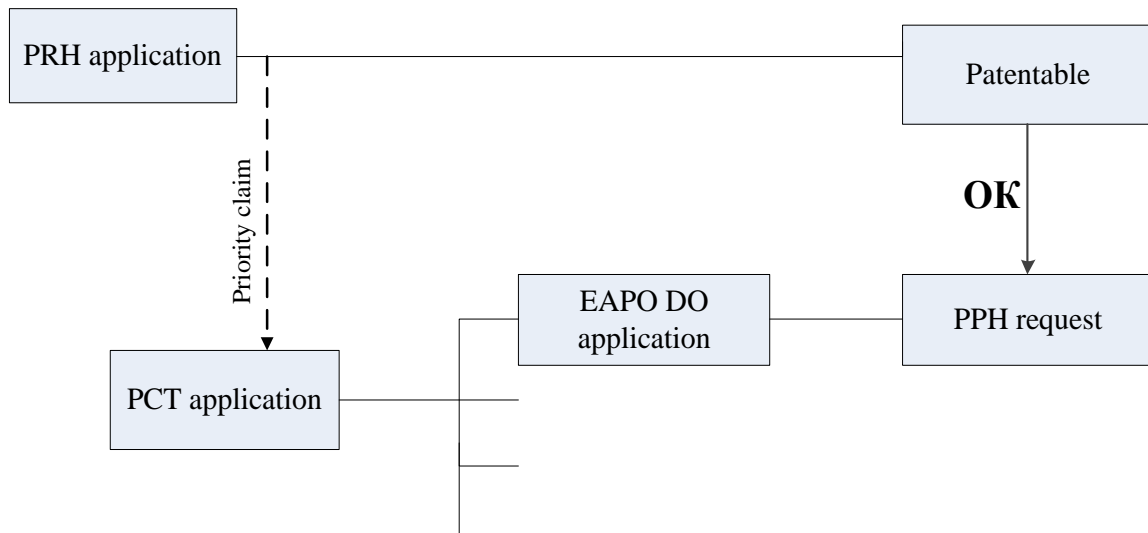
A

Example 1 – Procedure in compliance with the Paris Convention



B

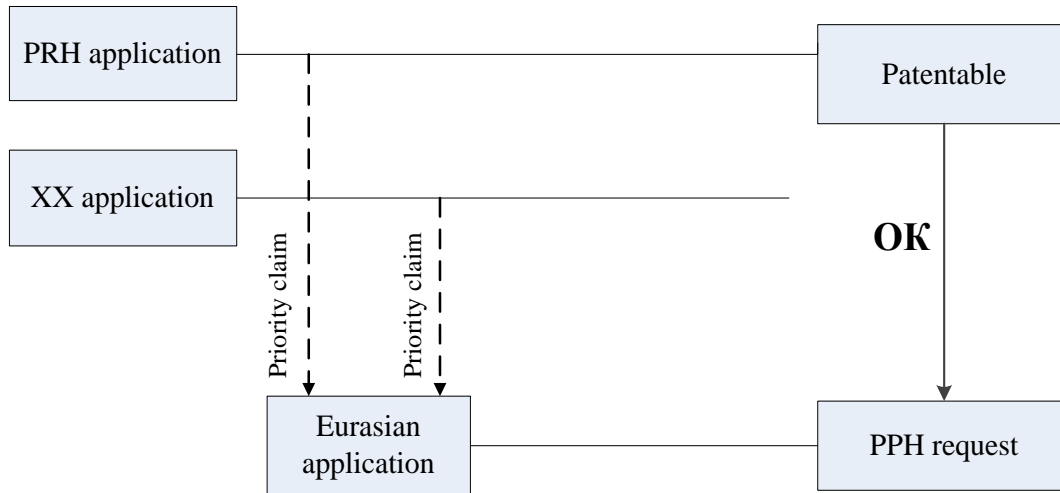
Example 1 – Procedure in compliance with the PCT



DO = Designated Office

C

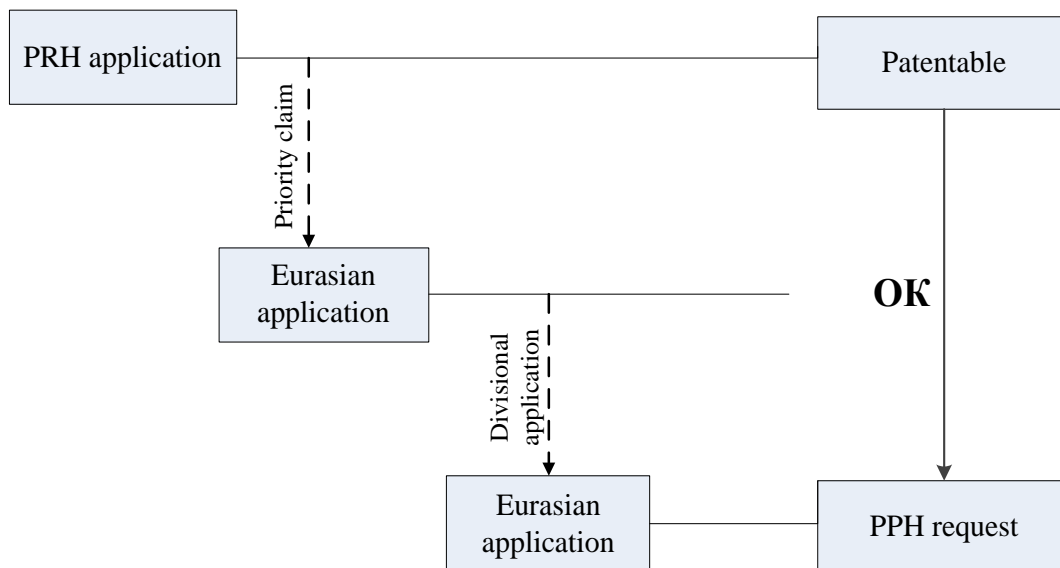
Example 1 – Procedure in compliance with the Paris Convention, complex priority



XX = any office

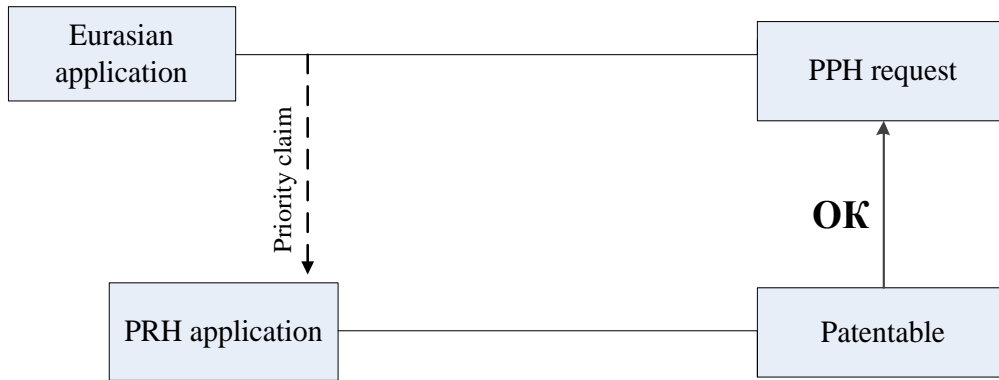
D

Example 1 – Procedure in compliance with the Paris Convention, divisional application



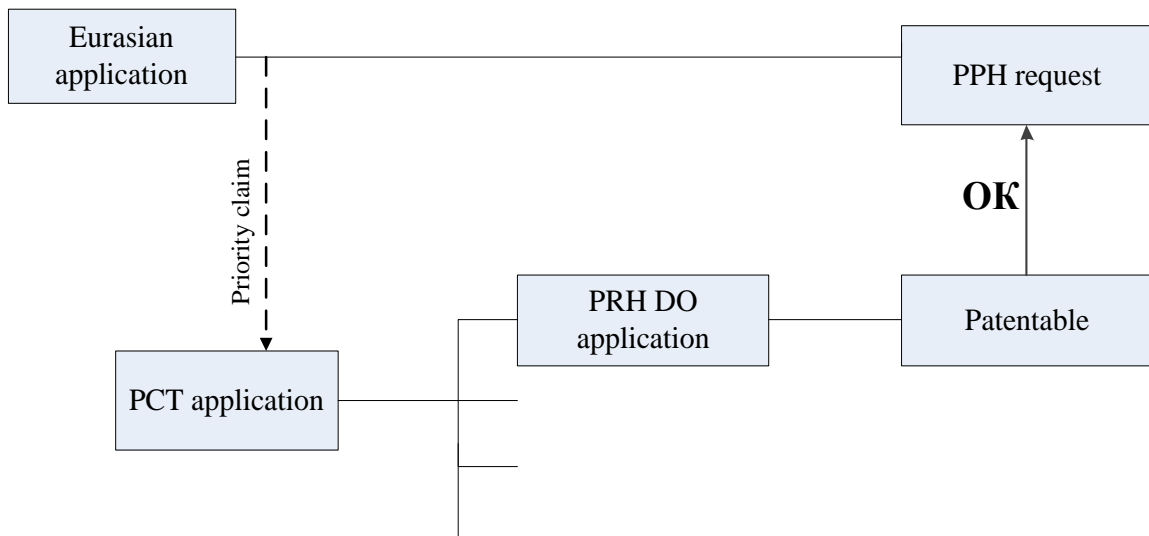
E

Example 2 – Procedure in compliance with the Paris Convention



F

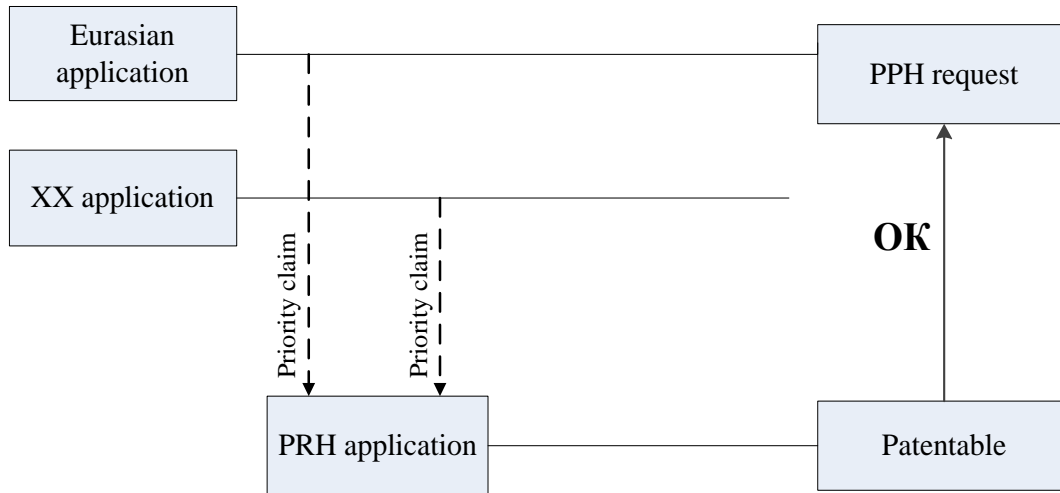
Example 2 – Procedure in compliance with the PCT



DO = Designated Office

G

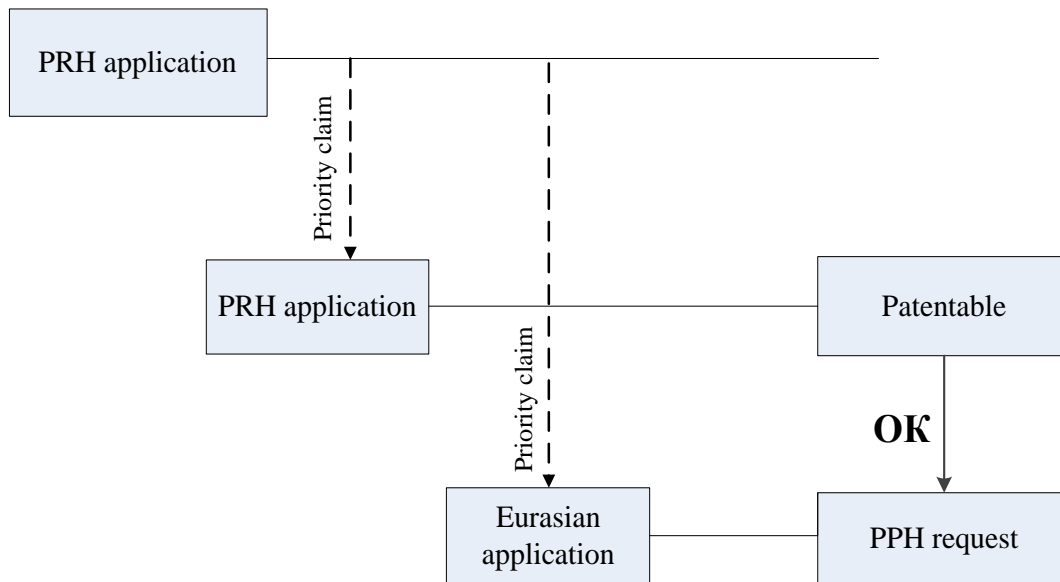
Example 3 – Procedure in compliance with the Paris Convention, complex priority



XX = any office

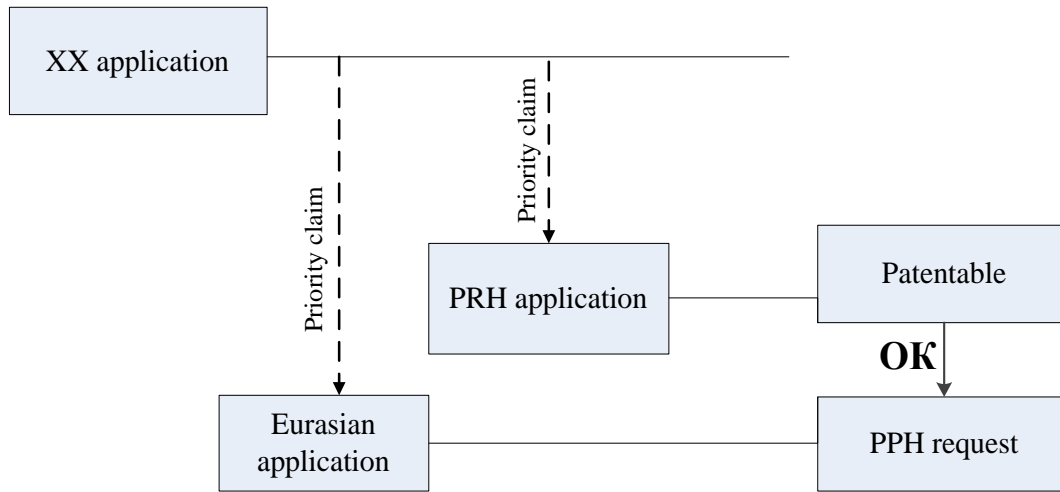
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Example 3 – Procedure in compliance with the Paris Convention, domestic priority



I

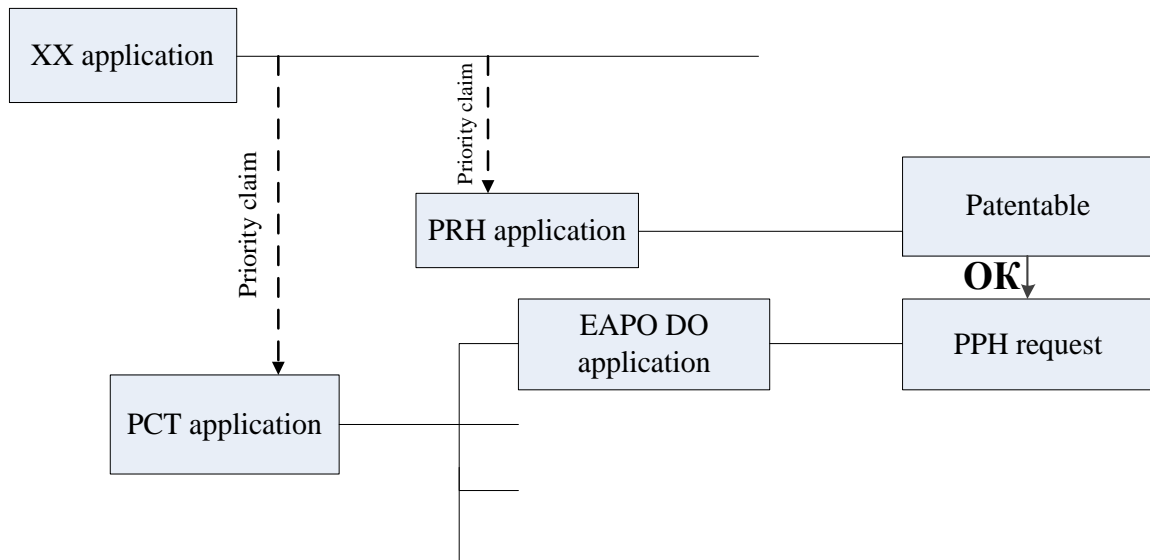
Example 3 – Procedure in compliance with the Paris Convention, but the prior application is from a third country



XX = any office

J

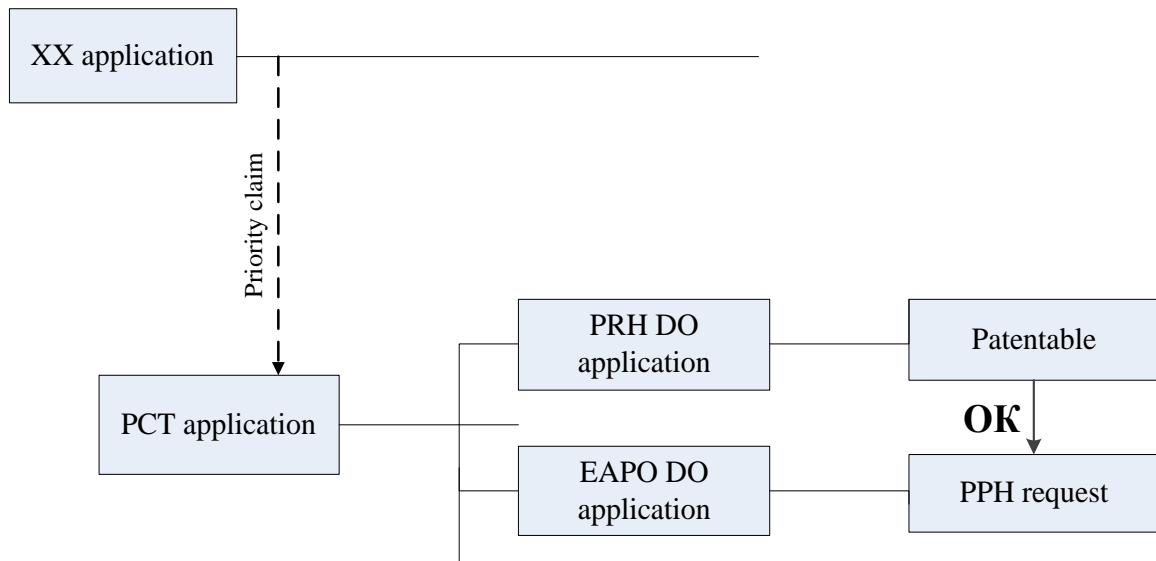
Example 3 – Procedure in compliance with the PCT, but the prior application from a third country



DO = Designated Office
XX = any office

K

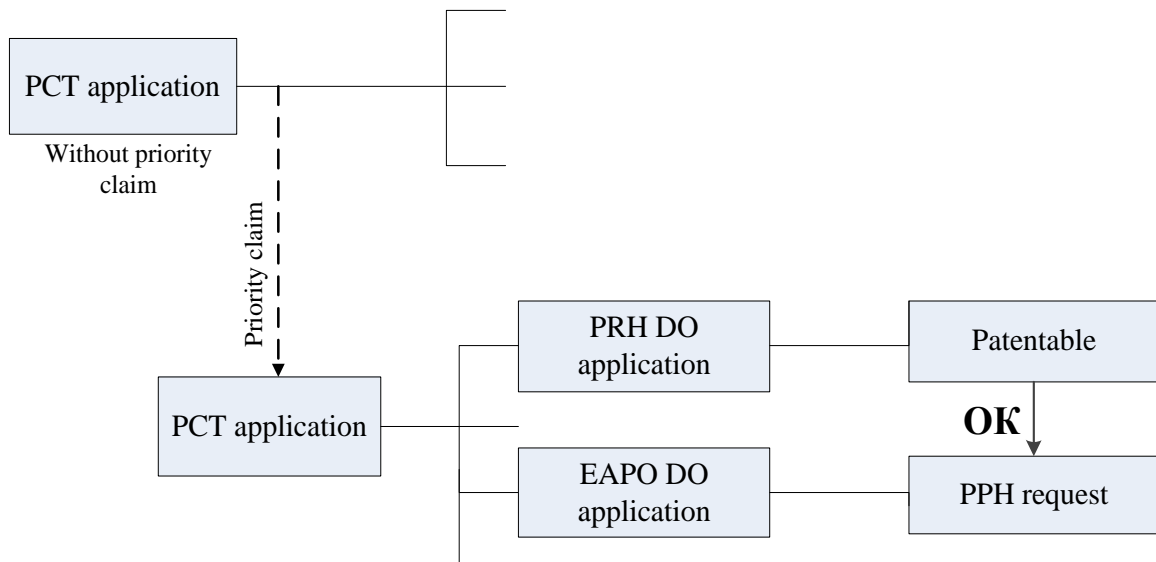
Example 3 – Procedure in compliance with the PCT



DO = Designated Office
XX = any office

L

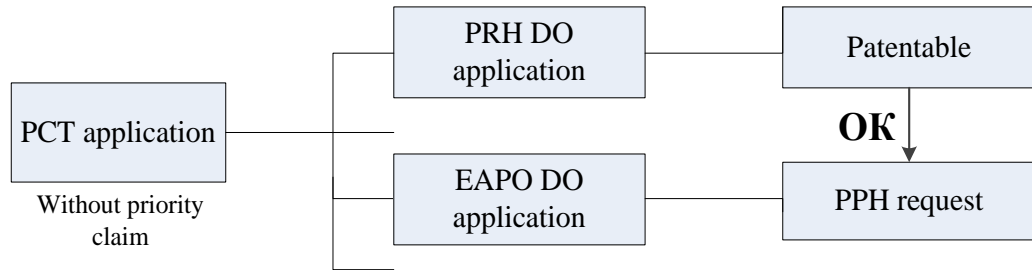
**Example 3 – Procedure in compliance with the PCT
(without priority and with priority)**



DO = Designated Office



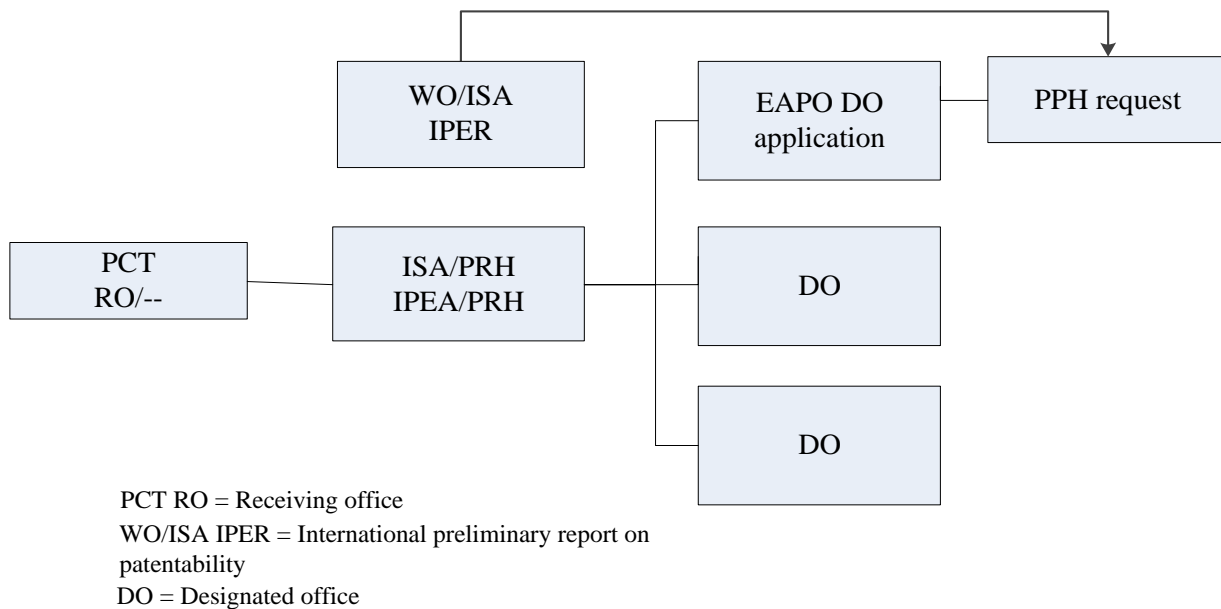
**Example 4 – Procedure in compliance with the PCT
(without priority)**



DO = Designated Office

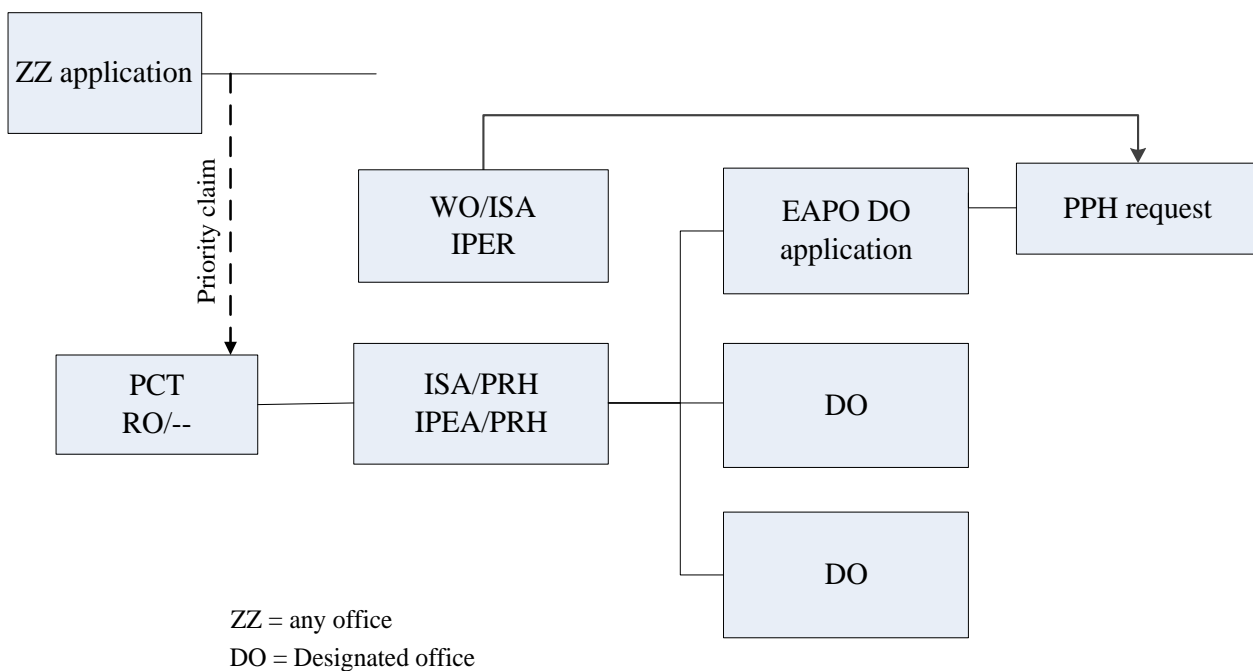
A1

Example: Corresponding PCT application, transferred into regional phase in EAPO



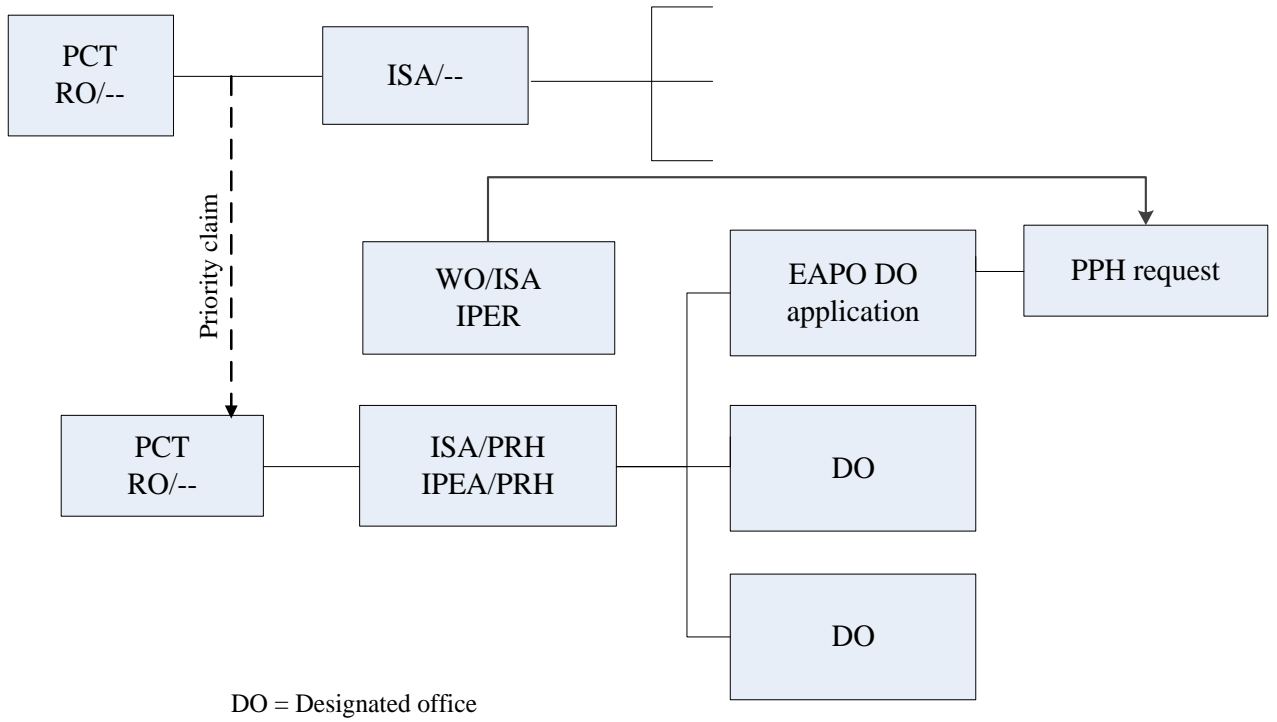
A2

Example: Corresponding PCT application, transferred into regional phase in EAPO (Corresponding PCT application with priority request on the bases of the national application)



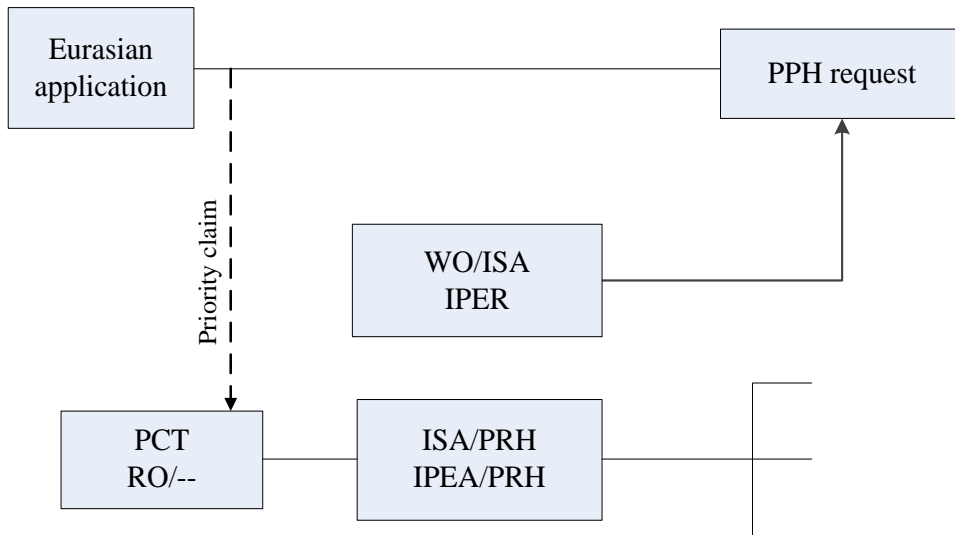
A3

Example: Corresponding PCT application, transferred into regional phase in EAPO (Corresponding PCT application with priority request on the bases of PCT application)



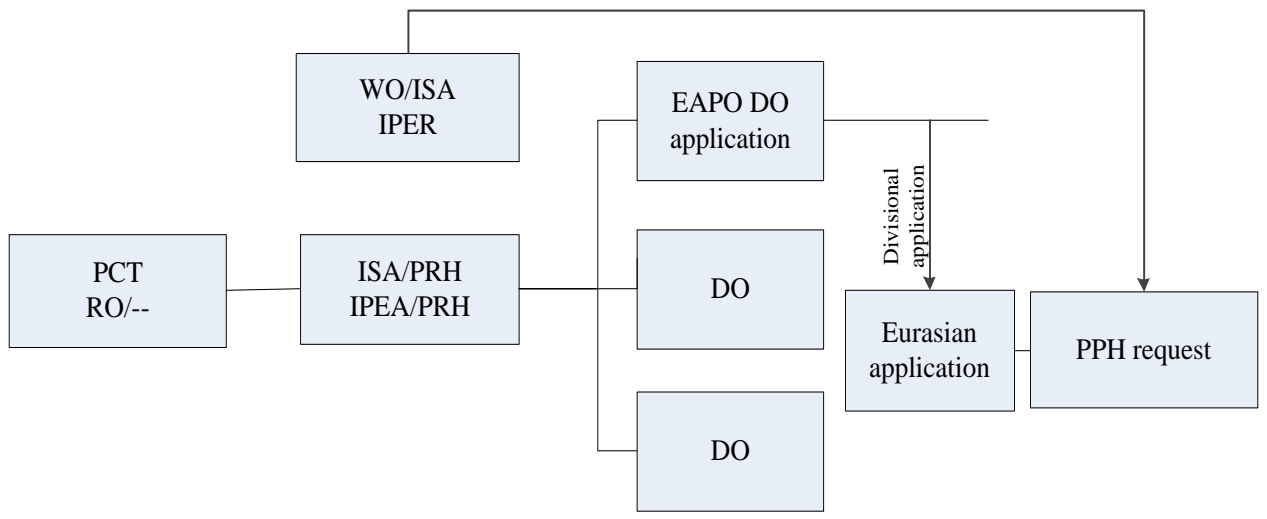
B

Example: Eurasian application on the basis of which priority for the corresponding PCT application is requested



E1

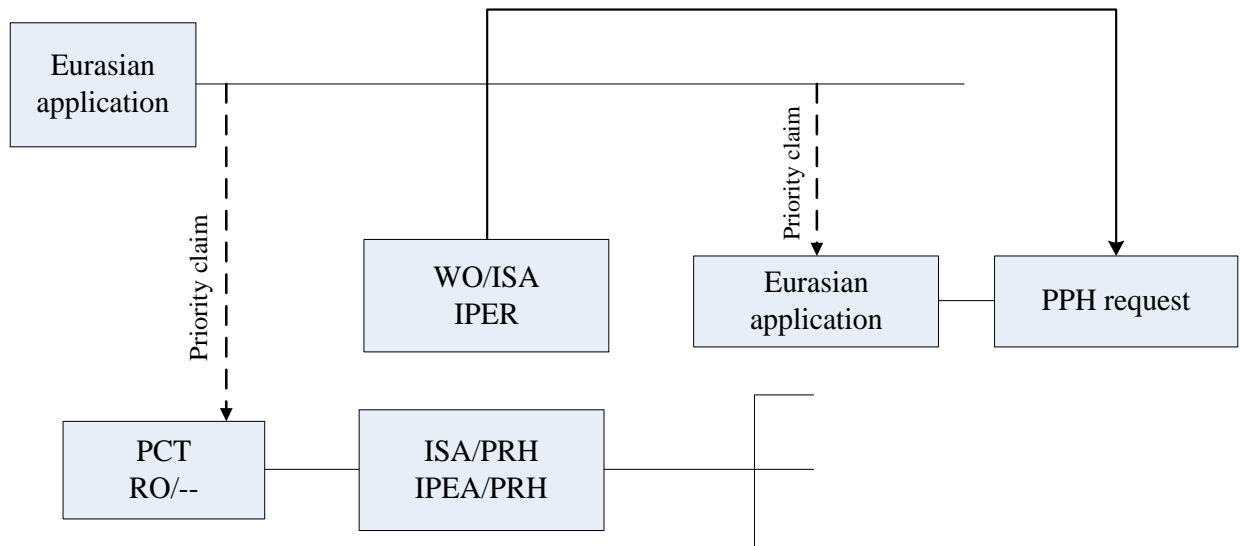
Example: Divisional Eurasian application which meets the requirements of (A1-A3)



DO = Designated office

E2

Example: Eurasian application for which domestic priority is requested based on an application which meets the requirements of (B)



REQUEST
for accelerated patent prosecution in accordance with the Patent Prosecution Highway
Pilot Programme between the Eurasian Patent Office (EAPO)
and Finnish Patent and Registration Office (PRH)

Eurasian application number	
Applicant	
Hereby the applicant requests accelerated patent prosecution referring to this Eurasian application in accordance with the Patent Prosecution Highway Pilot Programme between EAPO and PRH (hereinafter referred to as Pilot Program)	
Attached documents:	Number of pages
<input type="checkbox"/> Claims correspondence table between this Eurasian application and the European application for which a positive decision on patentability (novelty, inventive step and industrial applicability) is made by PRH.	
A copy and the Russian or English translation of the document confirming the claims patentability of the corresponding application <input type="checkbox"/> PRH actions <input type="checkbox"/> Written Opinion prepared by PRH as International Search Authority (WO/ISA) <input type="checkbox"/> International Preliminary Examination Report prepared by PRH as an International Preliminary Examining Authority (IPER/IPEA) <input type="checkbox"/> Russian or English translation of the above documents	
<input type="checkbox"/> a copy of non-patent literature to which references are made in the PRH actions or the PRH WO/ISA or IPER/IPEA acting as an ISA or as an IPEA <input type="checkbox"/> Russian or English translation thereof	

Date

Signature