

Procedures to file a request to the Austrian Patent Office (APO) for Patent Prosecution Highway (PPH) Pilot Program between the APO and the Brazilian Institute of Industrial Property (INPI)

The pilot period of this PPH pilot program will commence on 01/02/2020 for duration of five years and ending on 31.01.2025. The pilot period may be extended subject to the assessment of APO and INPI.

The offices may also terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.

PPH using the national work products from the Office of Earlier Examination (OEE)

The PPH Pilot Program enables an application whose claims have been determined to be patentable in the OEE (in this case INPI) to undergo an accelerated examination in the Office of Later Examination (OLE (in this case APO)) with a simple procedure according to a request from an applicant.

1. Request to the APO

An applicant has to file a request for accelerated examination under the PPH to the APO by submitting a bilingual German/English form for requesting accelerated examination under the PPH Pilot Program accompanied by the relevant supporting documents. The requirements for an application to the APO for accelerated examination under the PPH are given in paragraph 2. Relevant supporting documentation (paragraph 3) and the general AT application procedure envisaged at this time is discussed in the following section (paragraph 4).

2. Requirements for requesting accelerated examination under the PPH Pilot Program at the APO

There are four requirements for requesting accelerated examination under the PPH Pilot Program at the APO. These are:

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

- i) an application which validly claims priority under the Paris Convention from the INPI application(s) (examples are provided in ANNEX 1, Figures A, B, C and D), or
- ii) an application which provides the basis of a valid priority claim under the Paris Convention for the INPI application(s) (including PCT national phase application(s)) (examples are provided in ANNEX 1, Figures E, F and G), or
- iii) an application which shares a common priority document with the INPI application(s) (including PCT national phase application(s)) (examples are provided in ANNEX 1, Figures H, I, J, K, L and M), or

- iv) a PCT national phase application where both the APO application and the INPI application(s) are derived from a common PCT international application having no priority claim (example is provided in ANNEX 1, Figure N).

An AT application which validly claims priority to multiple INPI or PCT applications, or which is a divisional application validly based on the originally filed application that is included in (i) to (iv) above, is also eligible.

- b) **At least one corresponding INPI application has one or more claims that have been determined to be patentable by the INPI.**

Claims are “determined to be patentable” when they are explicitly identified to be patentable in the latest office action of INPI, even if the application is not granted for a patent yet.

Office actions are:

- (a) Preliminary Demand from INPI (6.21; 6.22)
- (b) Checked report (7.1)
- (c) Decision to Grant (9.1)

Claims are also “determined to be patentable” in the following circumstances: If the INPI office action does not explicitly state that a particular claim is patentable, the applicant must include an explanation accompanying the request for participation in the PPH pilot program that no rejection has been made in the INPI office action regarding that claim, and therefore, the claim is deemed to be patentable by the INPI.

- c) **All claims in the AT application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as patentable in the INPI.**

Claims shall be considered to sufficiently correspond where the claims are of the same scope such that the claims in the AT application have a common technical feature with the claims in the INPI application which makes the claims allowable over the prior art in the corresponding INPI application. Where amended claims have been determined to be patentable by the INPI, the claims of the AT application should be such that they correspond to the amended claims of the INPI application. Claims of the AT application which are appended to earlier claims of the AT application corresponding to claims that are indicated as patentable by the INPI will also be considered to sufficiently correspond where such claims fall within the scope of the claims indicated as patentable by the INPI.

- d) **The APO has not yet issued a decision to grant a patent (‘Erteilungsbeschluss’).**

3. Required documents for accelerated examination under the PPH Pilot Program at the APO

The following documentation will be needed to support a request for accelerated examination under the PPH Pilot Program at the APO:

- a) **a copy of all office actions on the corresponding INPI application(s) and translation(s) of them**
Both German and English are acceptable as translation languages. However, if the available (machine) translation is insufficient, the APO examiner may request an additional translation from the applicant.
- b) **a copy of the claims examined by the INPI and copies of subsequent amended claims found to be patentable by the INPI where appropriate, and translation of them**
Both German and English are acceptable as translation languages. However, if the available (machine) translation is insufficient, the APO examiner may request an additional translation from the applicant.
- c) **a completed claim correspondence table in German or English language showing the correspondence between the claims of the AT application for accelerated examination**

under the PPH and the claims of the corresponding INPI application considered patentable by the INPI

Sufficient correspondence of claims occurs where the claims satisfy the requirements 2 c) above. When claims are just literal translation, the applicant can just write down that 'they are 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 2c).

d) a copy of the document(s) cited by the INPI examiner in the reasons for refusal

If the cited document is a patent document, it does not have to be submitted as it is generally available to the APO via EPOQUE. Only if the APO has difficulty in obtaining a patent document the Office will ask the applicant to submit it.

As a rule, cited documents need not be translated.

The applicant has to provide the relevant information by filling in a form for requesting accelerated examination under the PPH Pilot Program which is available for download from the APO website (www.patentamt.at). The form should be sent to the APO along with the relevant supporting documentation.

If the applicant has already submitted the above documents 3a) to 3d) to the APO through simultaneous or past procedures, the applicant can incorporate the documents by reference and does not have to attach them.

4. Procedure for accelerated examination under the PPH Pilot Program at the APO

The APO 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 the APO 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. The applicant will be given opportunity to correct the request. If any of those defects is not corrected, the applicant will be notified and the application will await action in its regular turn.

ANNEX 1

Eligible for the PPH:

Figure A:

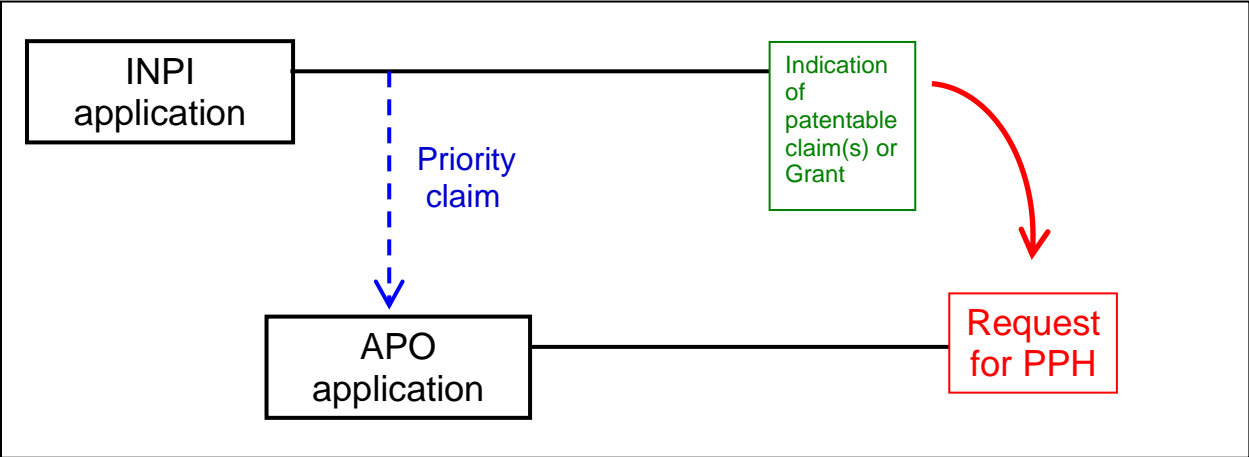
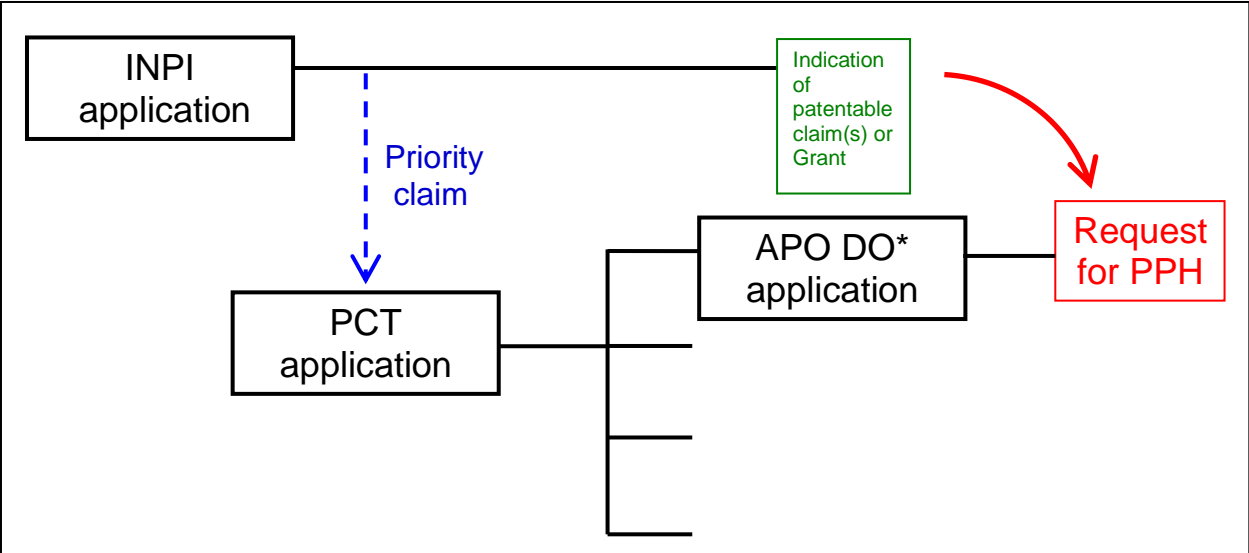
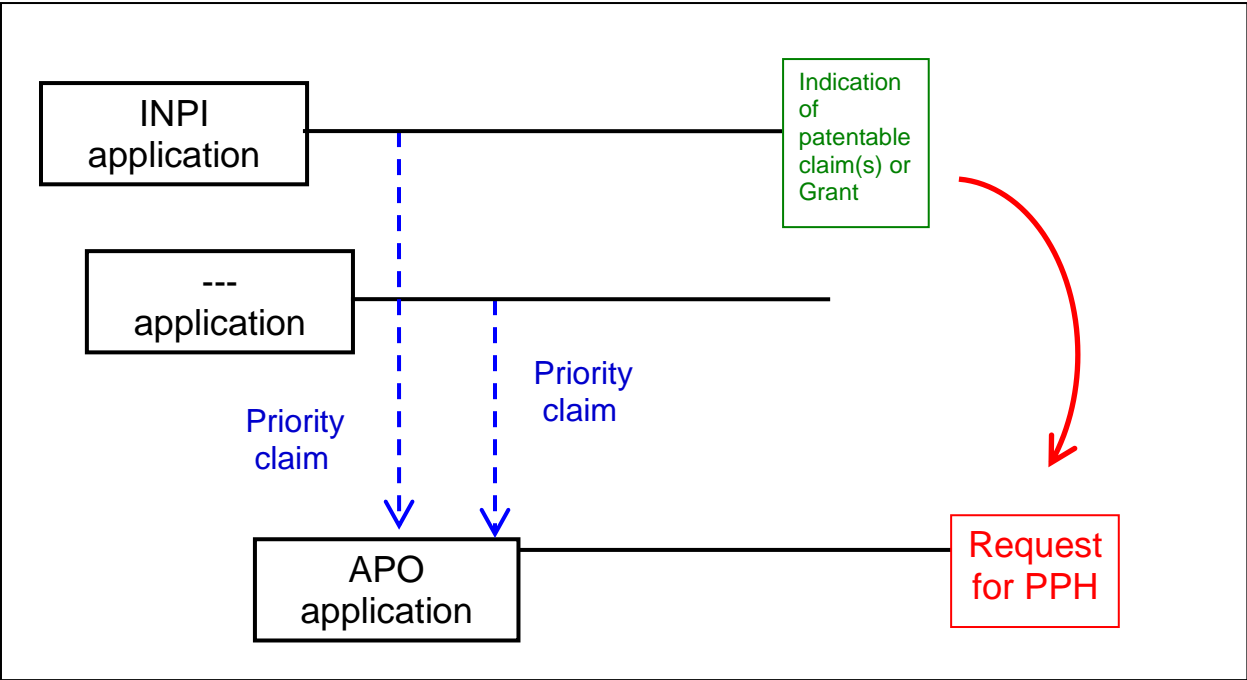


Figure B:



* DO – Designated Office

Figure C:



--- any Office

Figure D:

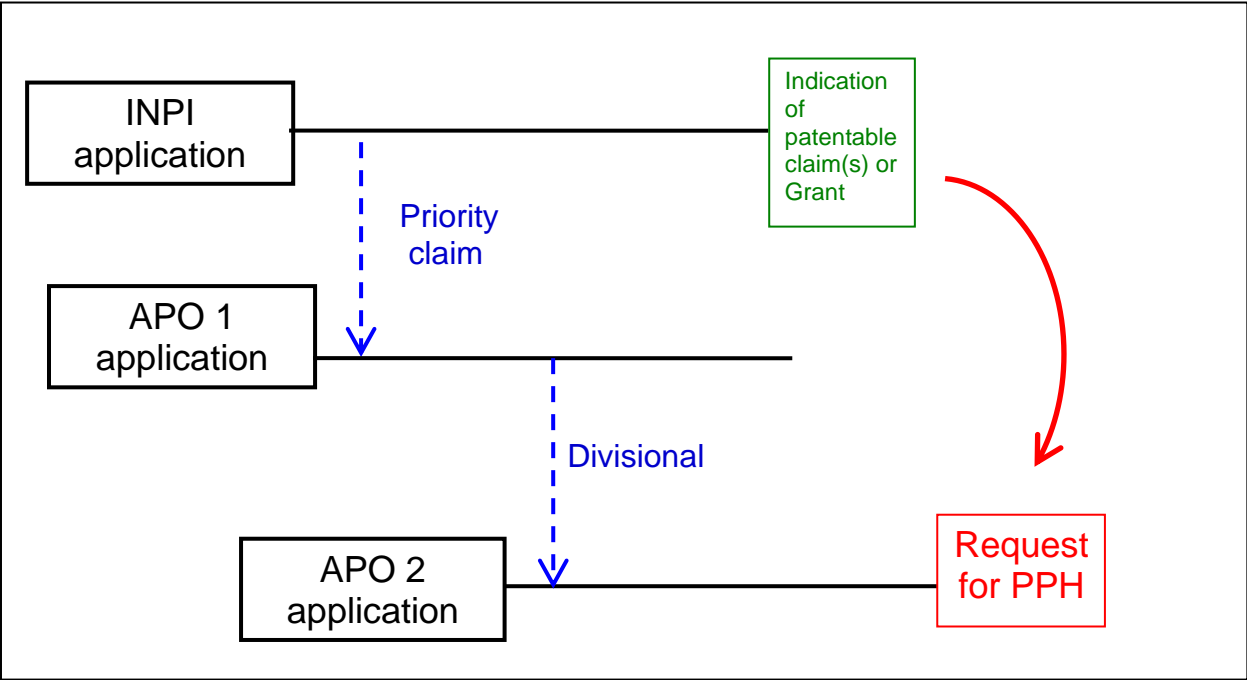


Figure E:

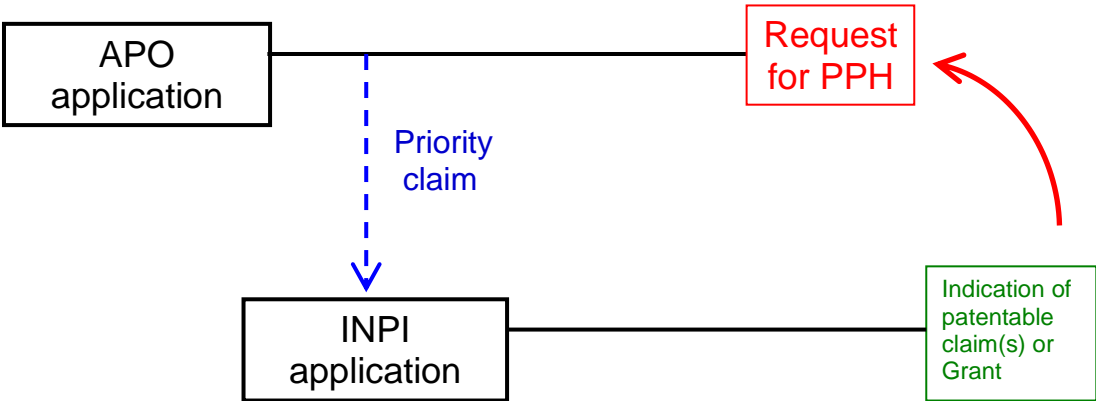
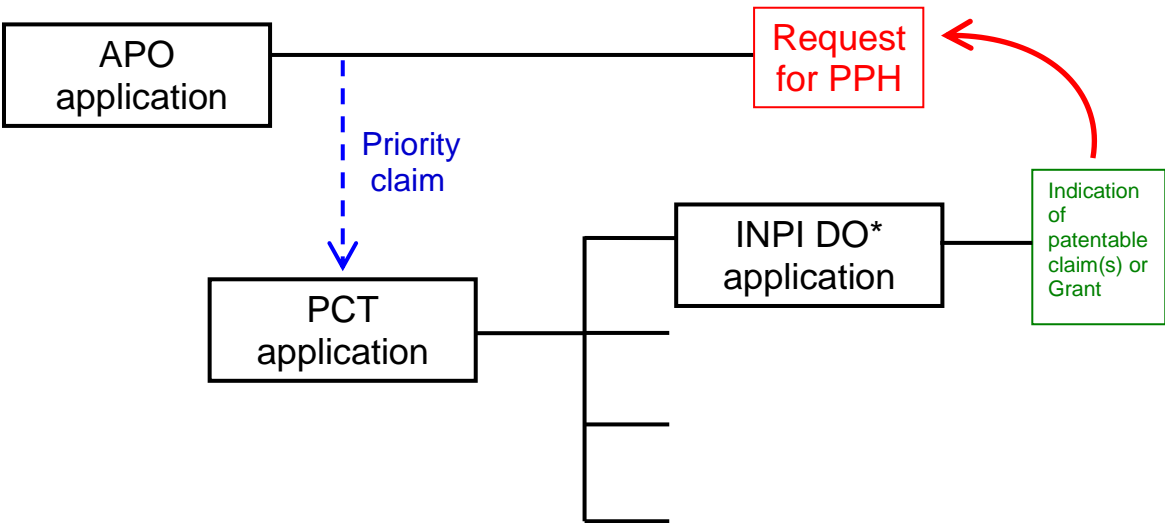
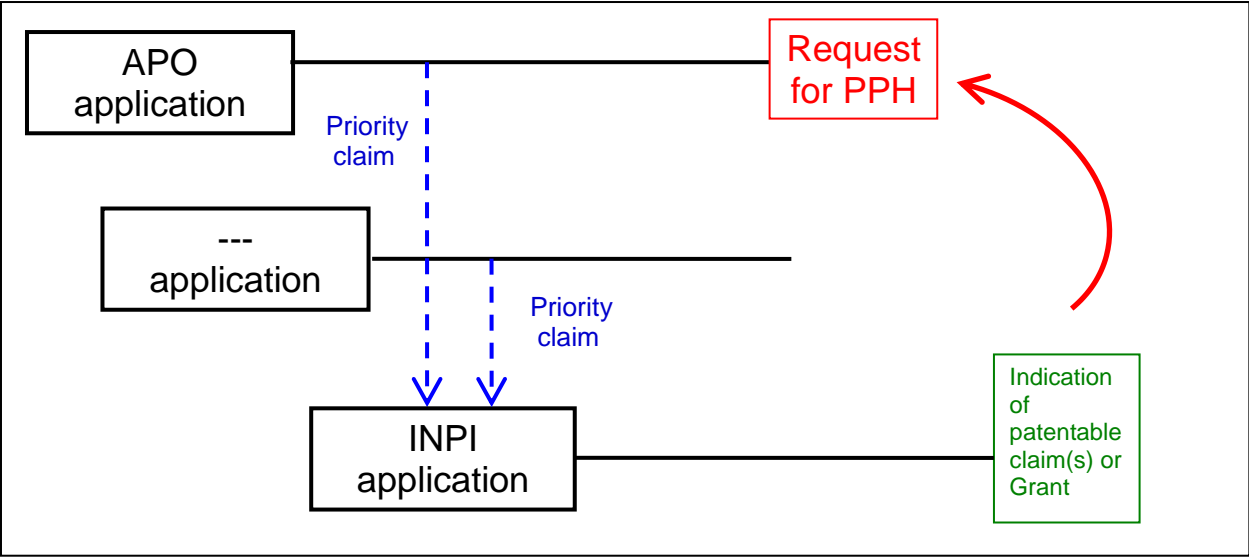


Figure F:



* Designated Office

Figure G:



--- any Office

Figure H:

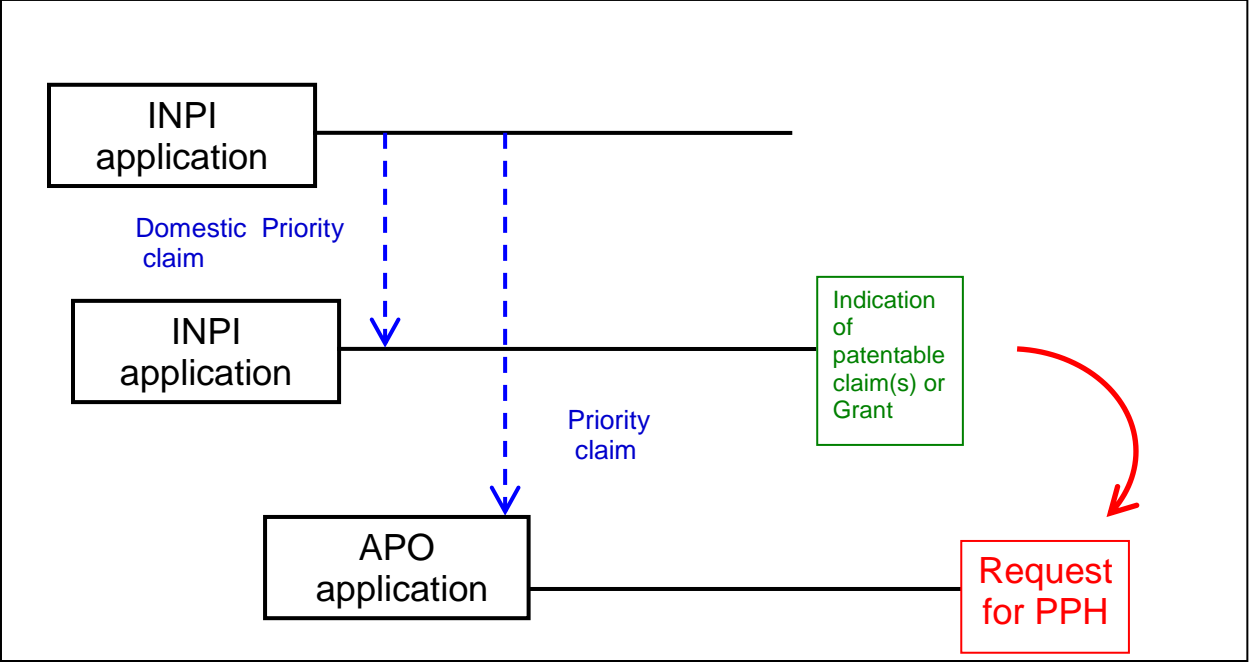
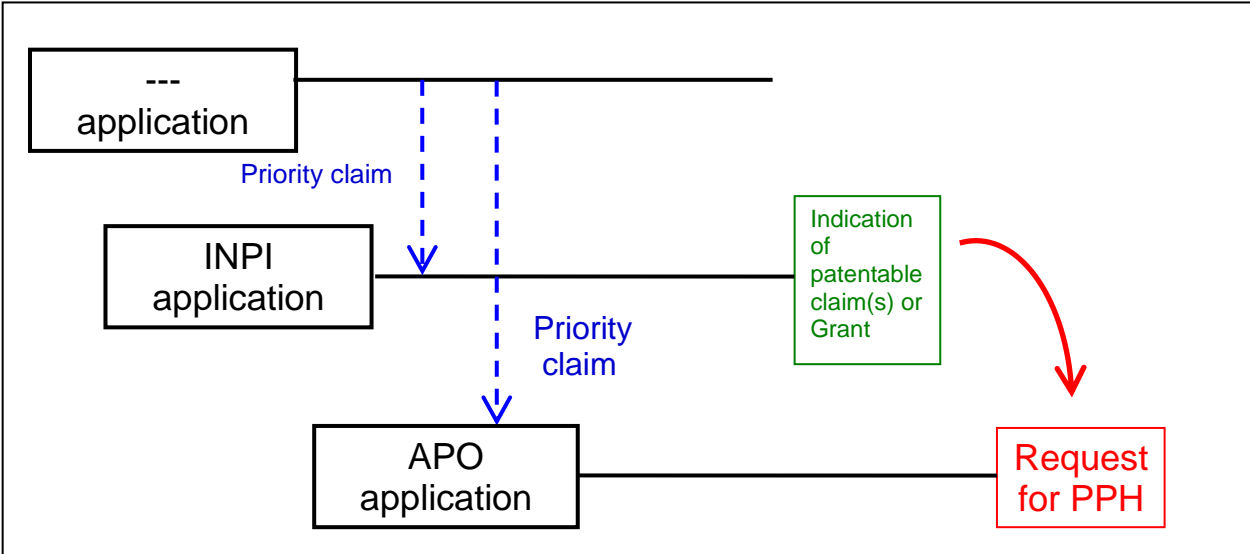
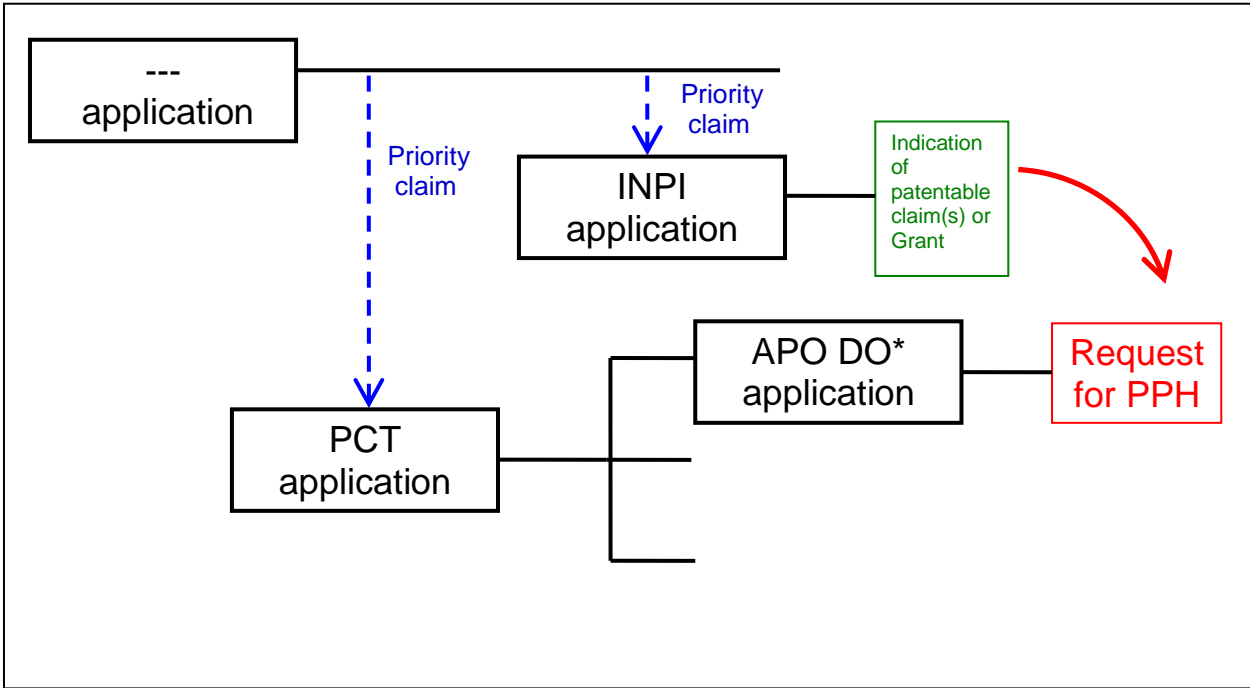


Figure I:



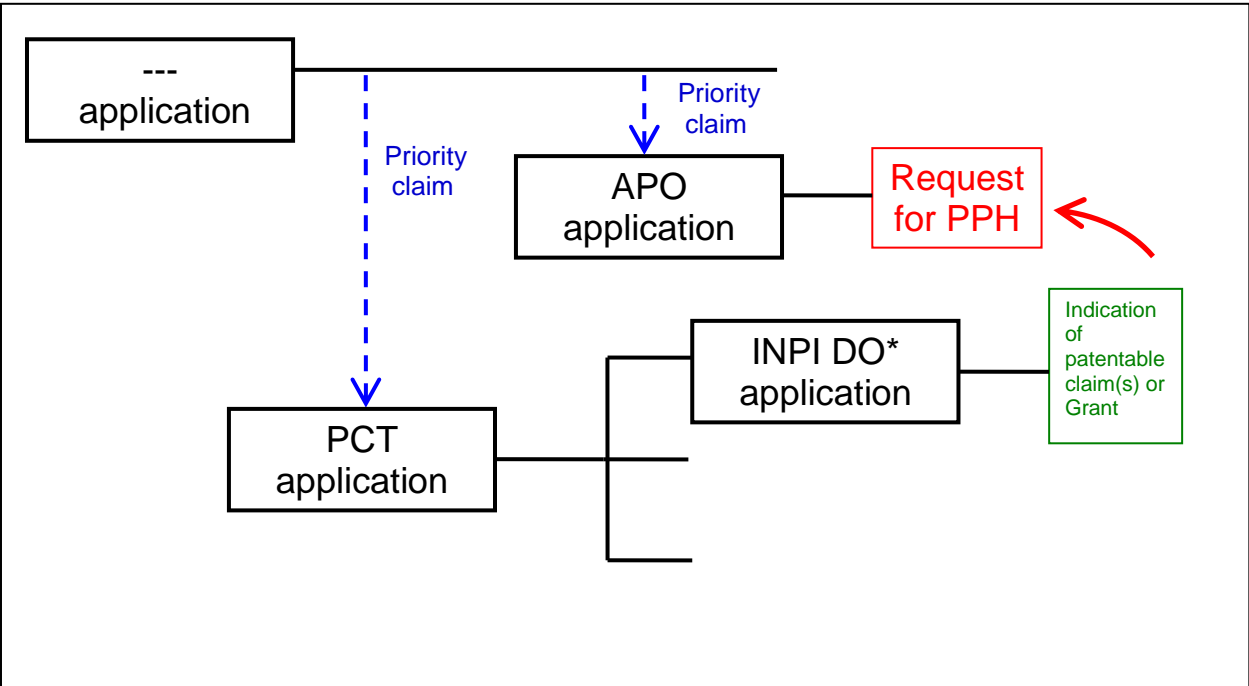
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Figure J:



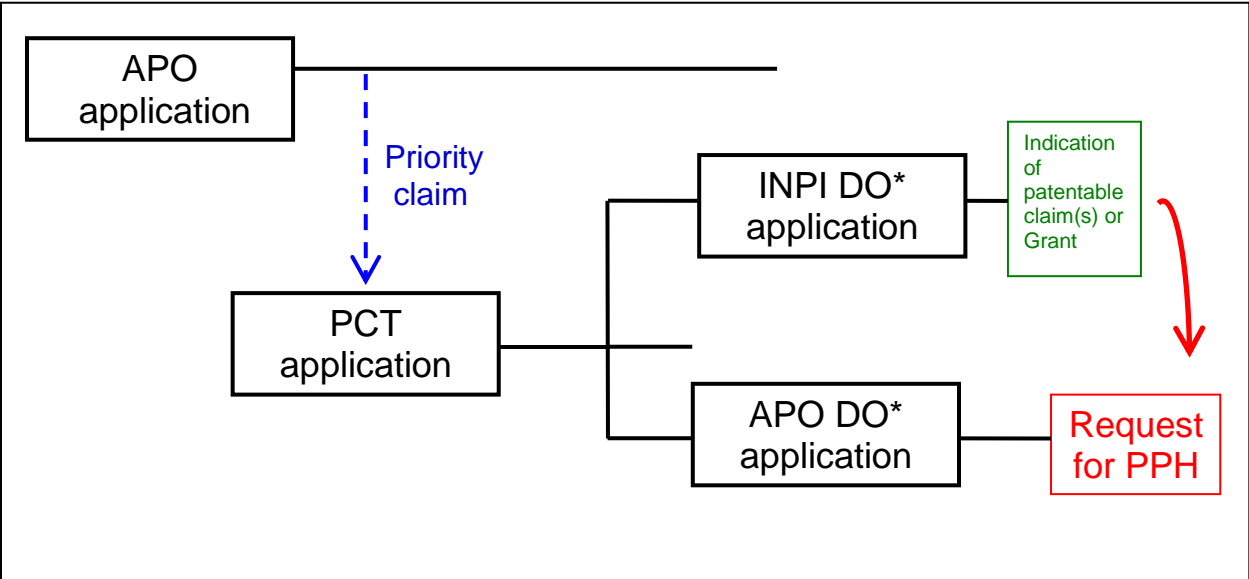
--- any Office
* Designated Office

Figure K:



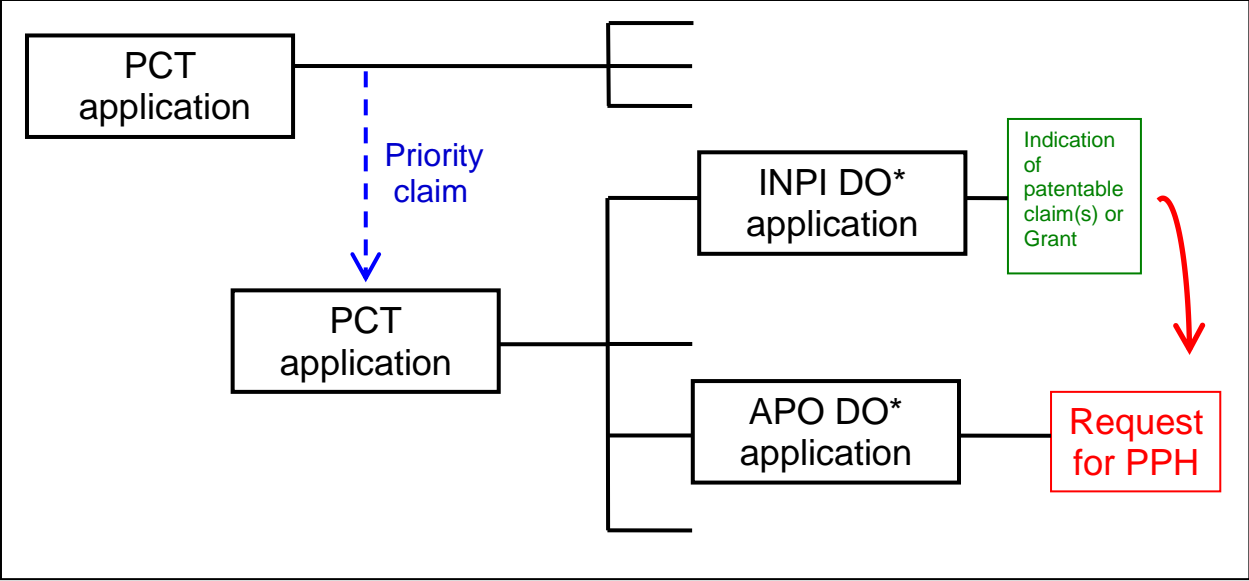
--- any Office
* Designated Office

Figure L:



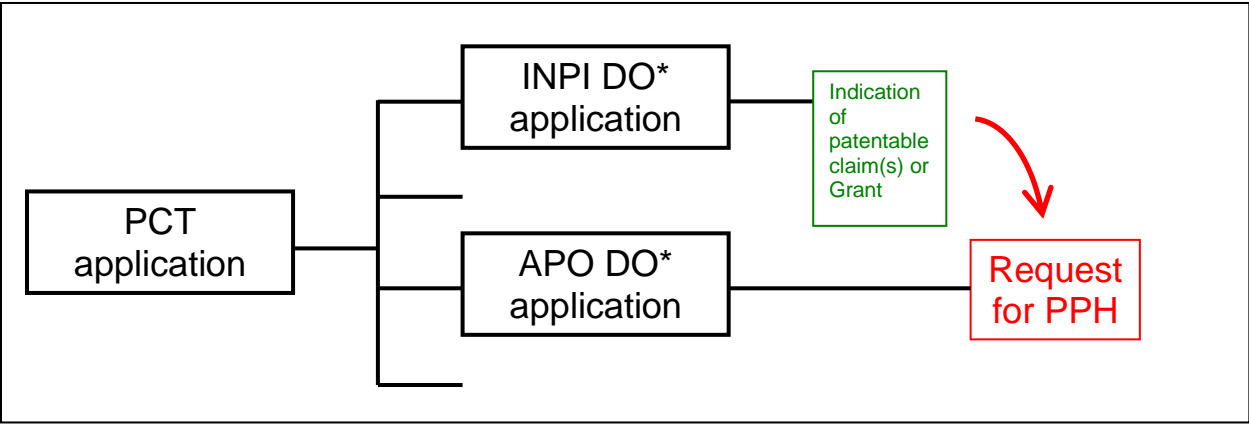
* Designated Office

Figure M:



* Designated Office

Figure N:



* Designated Office