

Patent Prosecution Highway Pilot Program between the Israel Patent Office (ILPO) and the National Board of Patents and Registration of Finland (NBPR)

Part I – PPH using national work products from NBPR

A. Background

Since October 15, 2012, the Israel Patent Office (ILPO) has conducted a Patent Prosecution Highway (PPH) pilot program with the National Board of Patents and Registration of Finland (NBPR), based on national (PPH pilot program) and Patent Cooperation Treaty (PCT) work products (PCT-PPH pilot program).

The ILPO and the NBPR agreed to extend the pilot program indefinitely starting on October 15, 2013. The Offices may terminate the PCT PPH agreement if the volume of participation exceeds a manageable level, or for any other reason. Notice of any such changes to the program will be published.

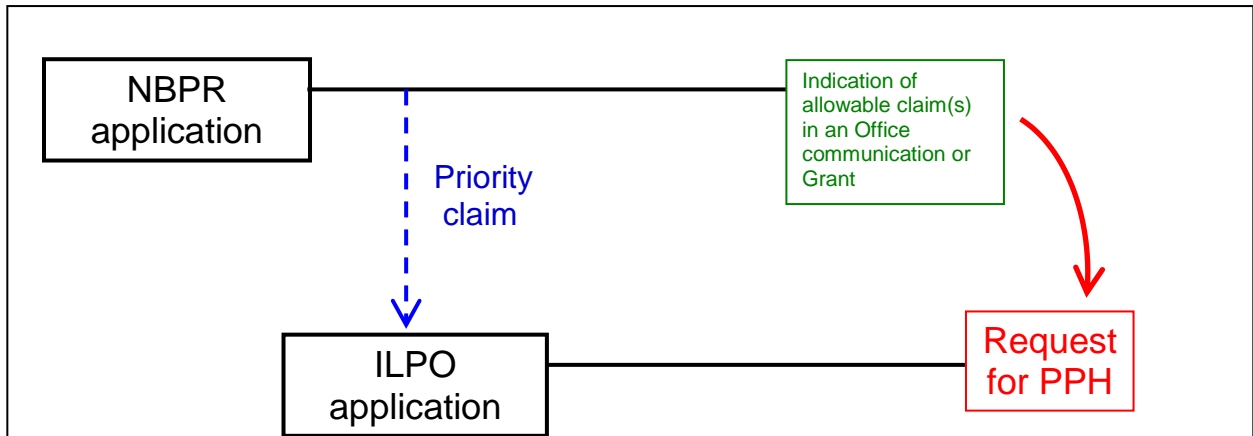
B. Requirements for Requesting Participation in the PPH Pilot Program in the ILPO

In order to be eligible to participate in the PPH pilot program, the following conditions must be met:

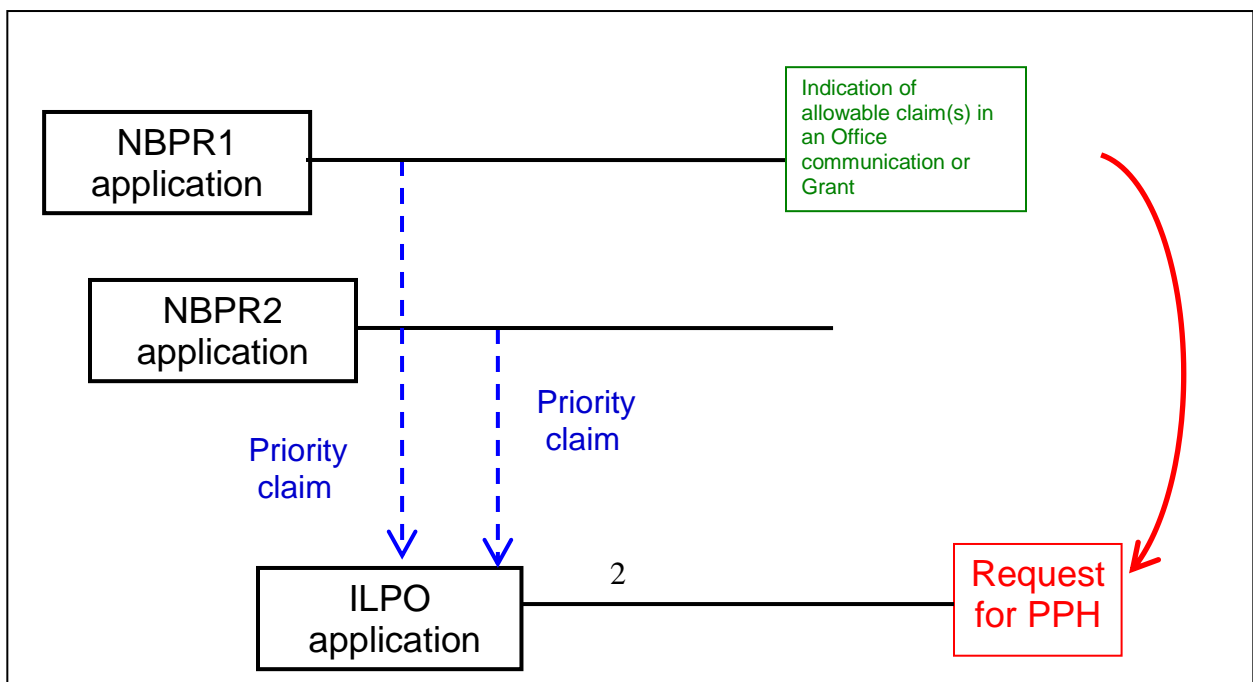
The Israeli (IL) application is a Paris Convention application which validly claims priority under section 10 of the Israeli Patent Law, to one or more applications filed with NBPR.

Examples of Israeli applications that fall under requirements are:

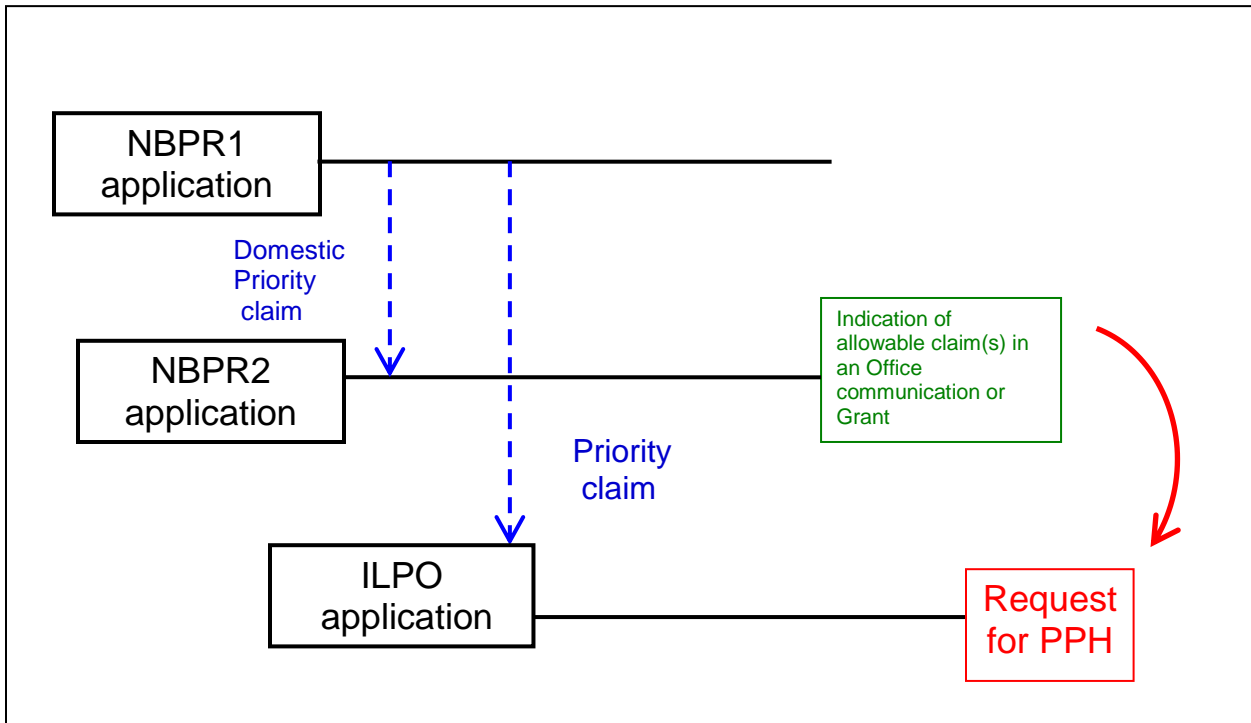
(A) An ILPO application with a single Paris Convention priority claim to an application filed at the NBPR



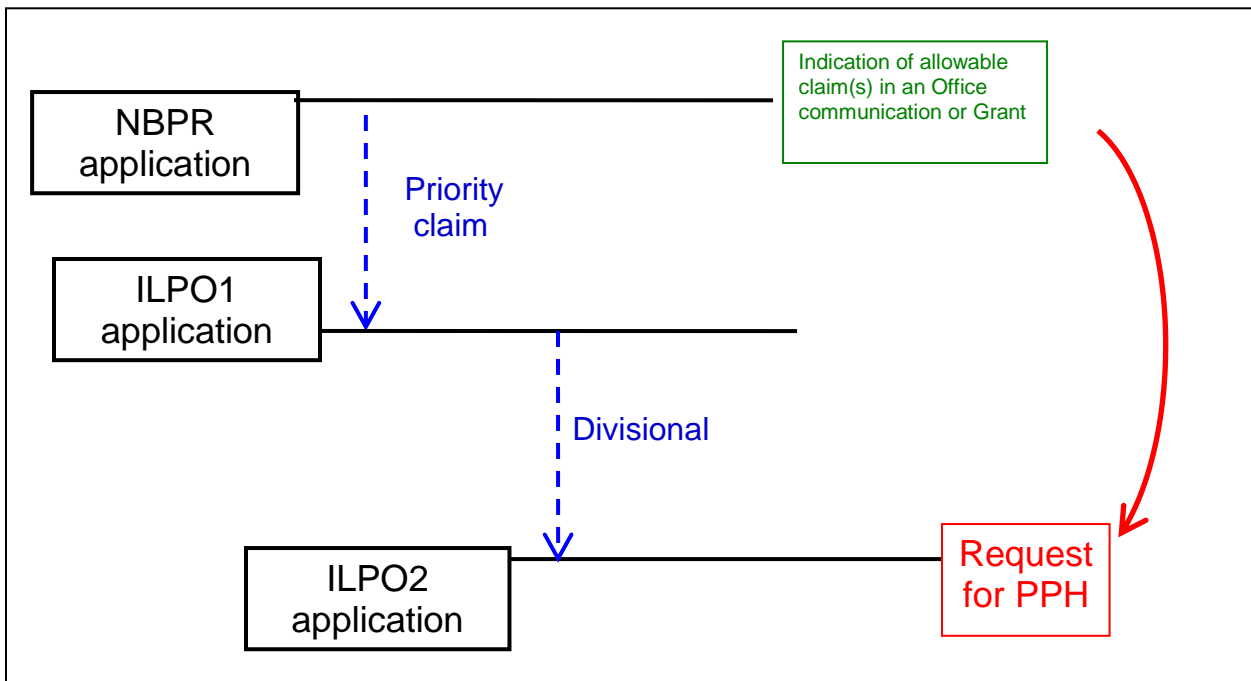
(B) An ILPO application with multiple Paris Convention priority claims to NBPR Applications



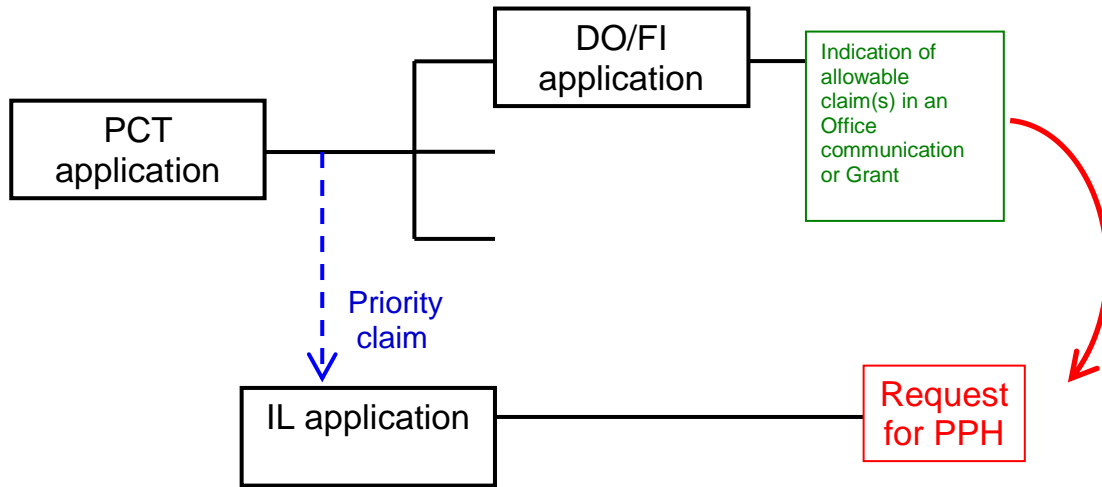
(C) Paris Convention route and domestic priority



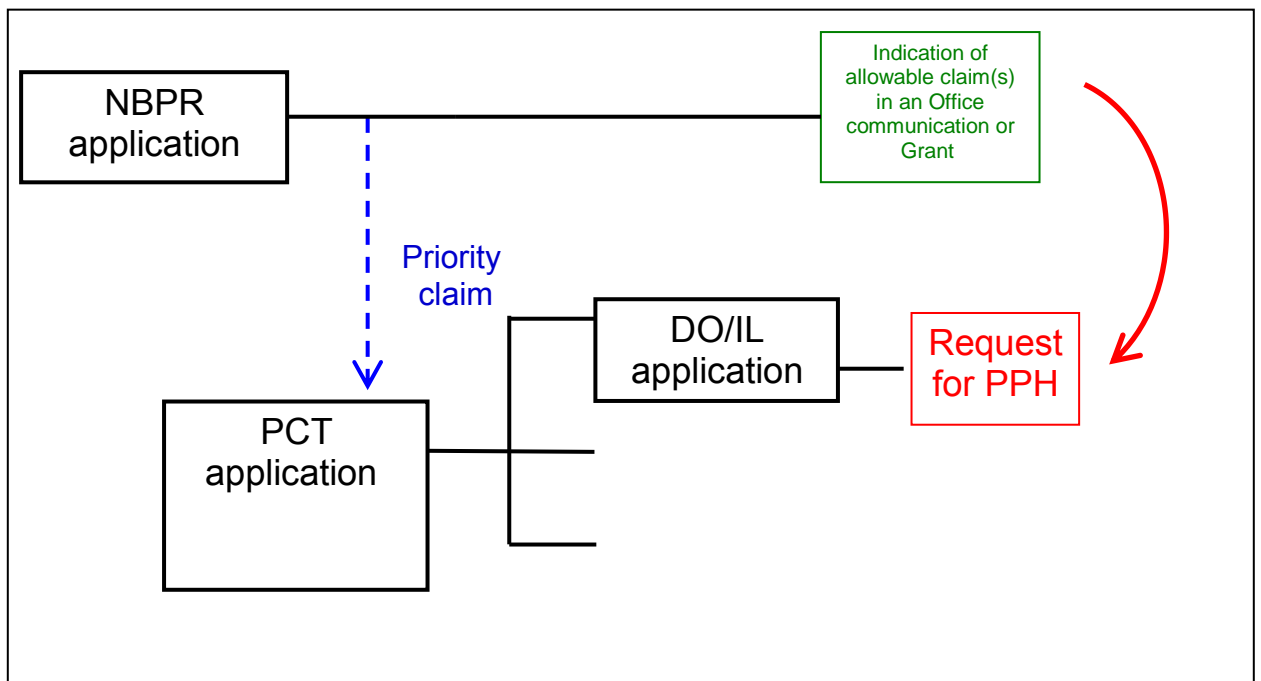
(D) Paris Convention route and divisional applications



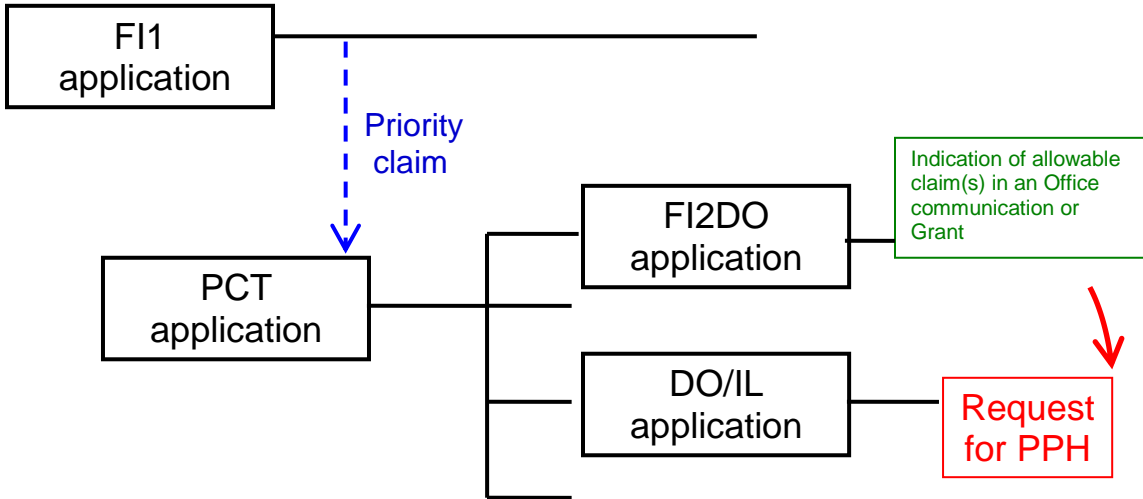
(E) - ILPO application claims Paris Convention priority to a PCT application



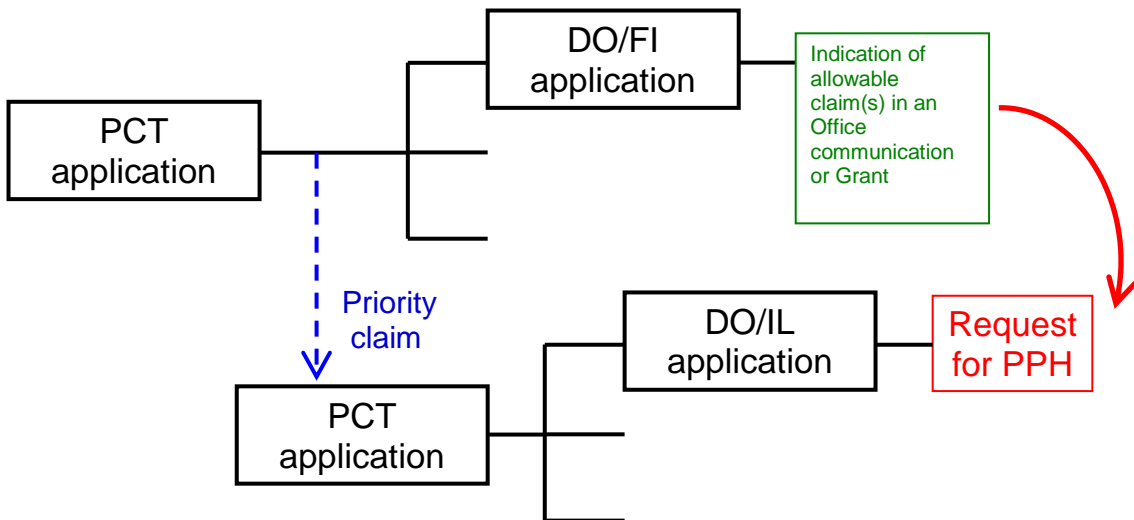
(F)- ILPO application is a national stage of a PCT application claiming Paris Convention priority to a NBPR application



(G) – PCT Route

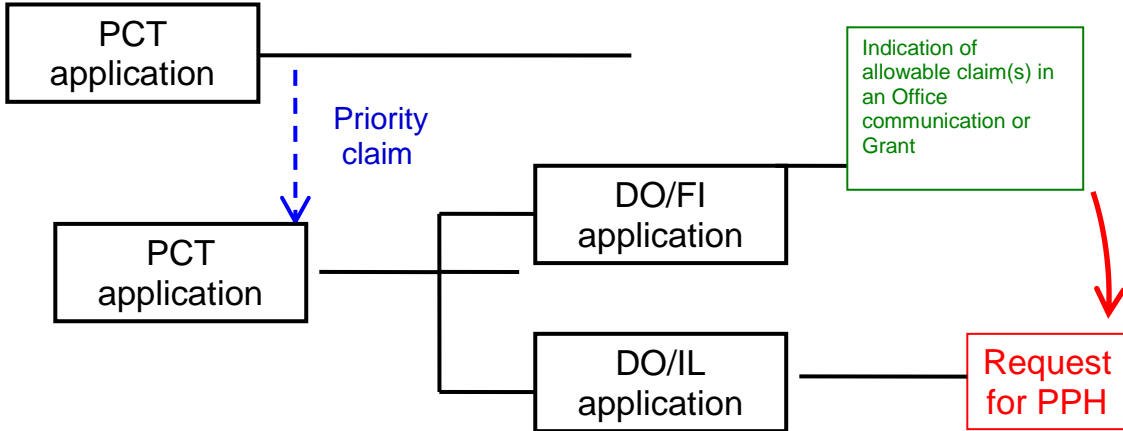


(H) - ILPO application is a national stage of a PCT application which claims Paris Convention priority to another PCT application

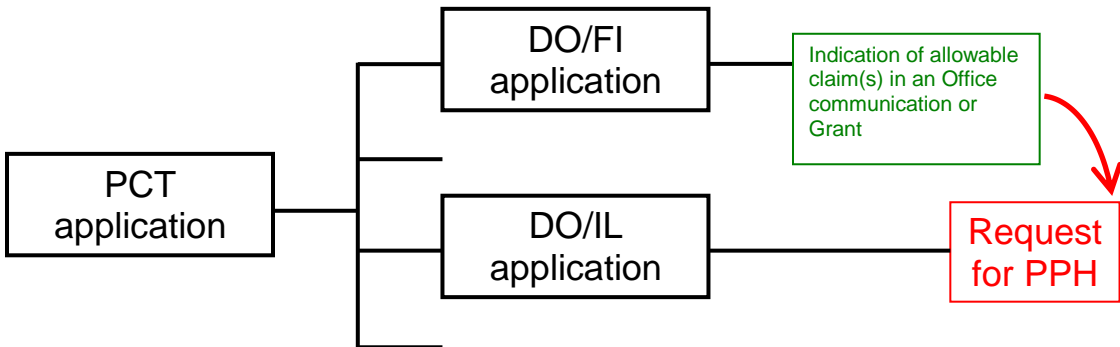


(I) - Direct PCT and PCT Route

Without priority claim



J- ILPO application is a national stage of a PCT application without priority claim



(1) Where the NBPR application containing allowable claims is not the same application for which priority is claimed in the IL application, the applicant must identify the relationship between the NBPR application that contains the allowable claims and the NBPR priority application claimed in the IL application (e.g., a NBPR application X containing the allowable claims is a divisional application of a NBPR application Y, which is the priority application claimed in the IL application).

(2) The NBPR application(s) must have at least one claim that was determined by the NBPR to be allowable. The applicant does not have to submit a copy of the allowable claims from the NBPR application(s) or their translation when they are accessible via PatInfo (NBPR's dossier access system). However, if the ILPO examiner is not able to obtain them via PatInfo or is not able to understand the translated claims, the ILPO examiner may request the applicant to provide the necessary documents and/or translate them.

If the NBPR Office action does not explicitly state that a particular claim is allowable, applicant must include a statement in the request for participation in the PPH pilot program or in the transmittal letter accompanying the request for participation that no rejection has been made in the NBPR Office action regarding that claim, and therefore, the claim is deemed allowable by the NBPR.

(3) All the claims in each ILPO application for which a request for participation in the PPH pilot program is made must sufficiently correspond to or be amended to sufficiently correspond to the allowable claim(s) in the NBPR application(s).

Claims are considered to "sufficiently correspond" where, besides differences due to translations and claim format, the claims in the ILPO application are of the same or of similar scope as the claims in the NBPR application, or the claims in the ILPO application are narrower in scope than the claims in the NBPR application.

In this regard, a claim that is narrower in scope is when an ILPO 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 ILPO application which introduces a new/different category of claims to those claims indicated as allowable in the NBPR application is not considered to sufficiently correspond. For example, should the NBPR application only contain claims to a process of manufacturing a product, then claims in the ILPO application are not considered to sufficiently correspond if the ILPO application claims a product that is dependent on the corresponding process claims.

It is not necessary to include all claims determined to be allowable in the NBPR application in the application at the ILPO, since such deletion of claims is allowable. For example, where an application at the NBPR contains 5 claims which are determined to be allowable, the corresponding application at the ILPO may contain only 3 of the 5 claims. The applicant is also required to submit a "claims correspondence table" in English. The claims correspondence table must indicate how all the claims in the ILPO application correspond to the allowable claims in the NBPR application(s).

(4) Examination of the ILPO application for which participation in this PPH pilot program is requested has not begun.

(5) The applicant must file a request for participation in this PPH pilot program and a request that the ILPO application be advanced out of turn for examination. The request form is available on the ILPO Web site at:

<http://www.justice.gov.il/MOJHeb/RashamHaptentim/>

(6) The applicant does not have to submit a copy of all the Office actions (which are relevant to patentability) of the corresponding NBPR application(s) and their translation when they are provided via PatInfo. However, if the ILPO examiner is not able to obtain them via the PatInfo or understand the translated Office actions, the ILPO examiner may request that the applicant provide the necessary documents.

Office actions should be in either English or translated into English. Machine translation is admissible. However, if the ILPO examiner is not able to understand the machine translated office actions to a sufficient extent, the ILPO examiner may request the applicant submit a professional translation.

(7) The applicant must comply with section 18 of the Israeli Patents Law, 5727-1967 and submit a list of the documents cited by the NBPR examiner in the NBPR Office action. The applicant does not have to submit a copy of the cited documents if they are Finnish patent documents because they are provided via PatInfo. However, if the ILPO examiner is not able to obtain the copy via the PatInfo, the ILPO examiner may request that the applicant provide the necessary documents. Non-patent documents must always be submitted.

(8) The request for participation in this PPH pilot program and all the above required documents must be submitted to the ILPO and indexed with the following document description: "Petition to make special under the Patent Prosecution Highway." Any preliminary amendments submitted with the PPH documents must be separately indexed as a preliminary amendment.

Where the request for participation in this PPH pilot program and special status are granted, the applicant will be notified and the ILPO application will be advanced out of turn for examination. In those instances where the request for participation in this PPH pilot program 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 one opportunity to amend the request in a renewed request for participation (which must be submitted as described above). Note that actions by the examiner, regarding the

application, will NOT be suspended while waiting for the applicant to amend his request for participation (this is relevant in cases where the application has reached its regular turn to be examined if it were not to have been advanced out of turn). That is, if the application is picked up for examination by the examiner after the applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is amended and examination has not begun, the request and special status will be granted, the applicant will be notified and the ILPO application will be advanced out of turn for examination. If not amended, the applicant will be notified and the application will await action in its regular turn.

(9) Request for participation in this PPH pilot program and special status granted in a parent application will not carry over to a divisional application. The applicant must fulfill all the conditions set forth above in order for special status to be granted to the divisional application.

If any of the documents identified in items (2) and (6)- (8) above have already been filed in the ILPO application prior to the request for participation in the PPH pilot program, it will not be necessary for the applicant to resubmit these documents with the request for participation. The applicant may simply refer to these documents and indicate in the request for participation in this PPH pilot program when these documents were previously filed and for what ILPO application.

C. Special Examining Procedures

Once the request for participation in this PPH pilot program and special status have been granted to an ILPO application, said ILPO application will be taken up for examination by the ILPO examiner before all other categories of applications except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination."

Any claims amended or added after a grant of a request for participation in this PPH pilot program must sufficiently correspond to one or more allowable claims in the NBPR application(s). An applicant is required to submit a "claims correspondence table" along with such an amendment (see(3) above). If the amended or newly added claims do not sufficiently correspond to the allowable claims in the NBPR application(s), the amendment will not be made and will be treated as a non-responsive reply under the PPH track and therefore the application will be processed as a regular application.

This PPH program does not absolve applicants of all their duties under the Israeli Patents Law, 5727-1967. By complying with requirements 5.6, 5.7 and 5.8 described above, as well as all requirements set forth under section 18 of the Israeli Patents Law, 5727-1967 and public circular M.N.51, applicants would be considered to have complied with their duties to bring to the attention of the ILPO any prior art cited in corresponding foreign application(s) (see section 18 of the Israel Patents Law, 5727-1967). Any inquiries concerning this notice may be directed to pph@justice.gov.il

Part II – PPH using PCT international work products from the NBPR

A. PCT-PPH Pilot Program

The PCT-PPH pilot program was established to enable an applicant, who has received

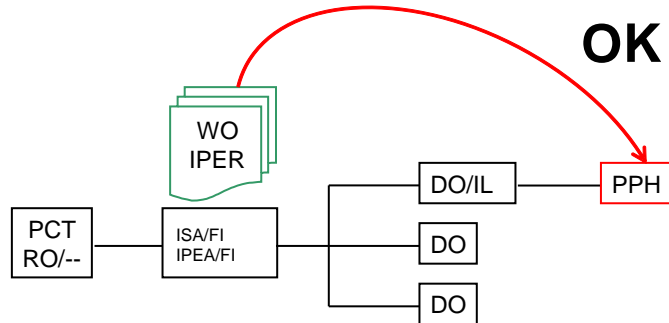
- (1) a Written Opinion from an International Searching Authority (WO/ISA) (ISA must be the NBPR), or
- (2) a Written Opinion from an International Preliminary Examining Authority (WO/IPEA) (IPEA must be the NBPR), or
- (3) an International Preliminary Examination Report (IPER) from an International Preliminary Examining Authority (IPEA must be the NBPR), that indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability, to file a request to participate in the PCT-PPH pilot program in a corresponding Israel application and petition to make the Israel application special under the PCT-PPH pilot program. The procedures and requirements for filing a request in the ILPO for participation in the PCT-PPH pilot program are set forth below.

B. Requirements for Requesting Participation in the PCT-PPH Pilot Program in the ILPO

In order to be eligible to participate in the PCT-PPH pilot program, the following conditions must be met:

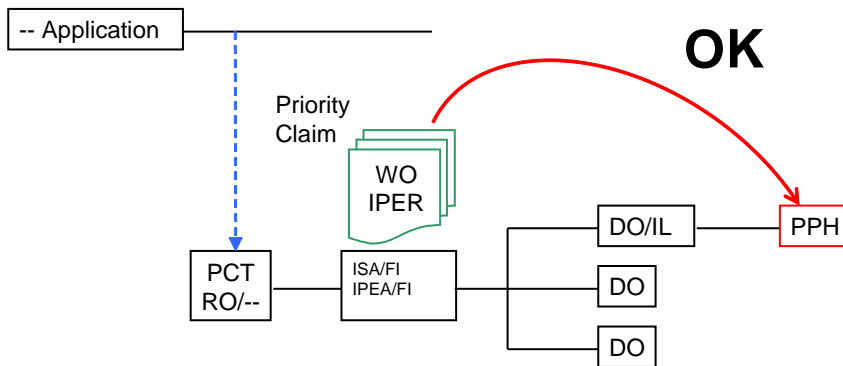
- (1) The relationship between the corresponding Israel application for which participation in the PCT-PPH pilot program is requested and the PCT application satisfies one of the following requirements (note that RO/-- as used in the diagrams below refers to an international application filed under the PCT in any competent receiving office):
 - (a) The Israel application is a national stage entry of the corresponding PCT application. See diagrams (A), (A') and (A'') below.

(A) The Israel application is a national stage entry of the corresponding PCT application.

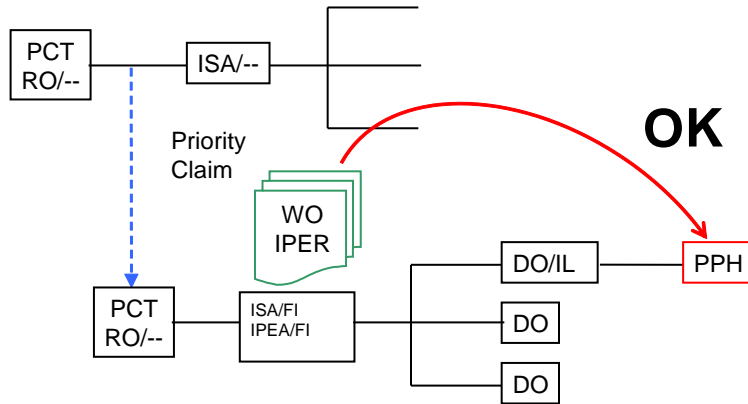


(A') The Israel application is a national stage entry of the corresponding PCT application.

(The corresponding PCT application claims priority to a national application filed anywhere.)

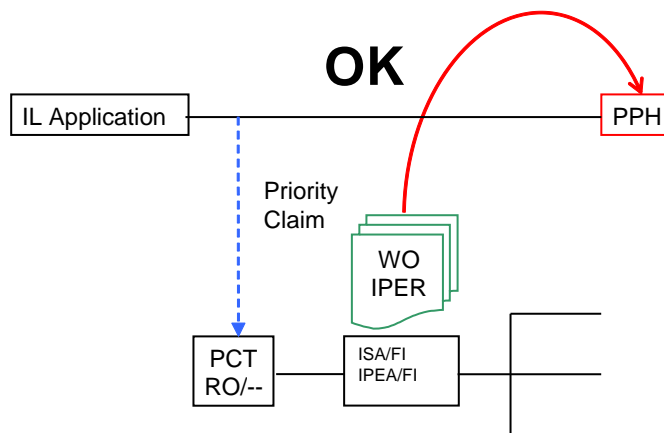


**(A'') The Israel application is a national stage entry of the corresponding PCT application.
(The corresponding PCT application claims priority to another PCT application.)**



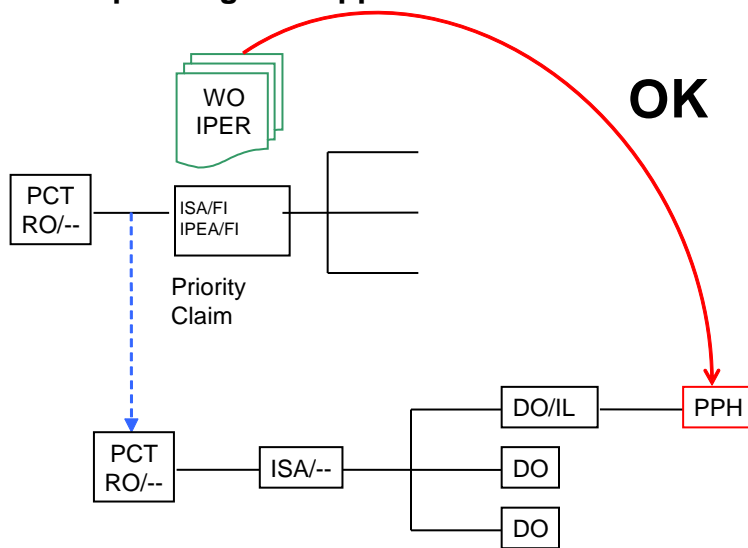
(b) The Israel application is a national application which forms the basis for the priority claim in the corresponding PCT application. See diagram (B) below.

(B) The Israel application is a national application which forms the basis for the priority claim in the corresponding PCT application.



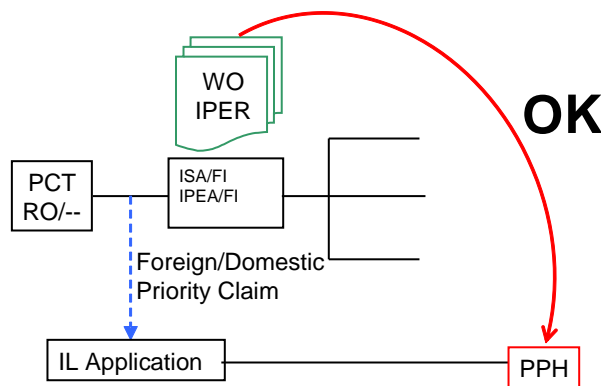
- (c) The Israel application is a national stage entry of another PCT application (which can be filed in any competent receiving office) which claims priority to the corresponding PCT application. See diagram (C) below.

(C) The Israel application is a national stage entry of a PCT application which claims priority to the corresponding PCT application.



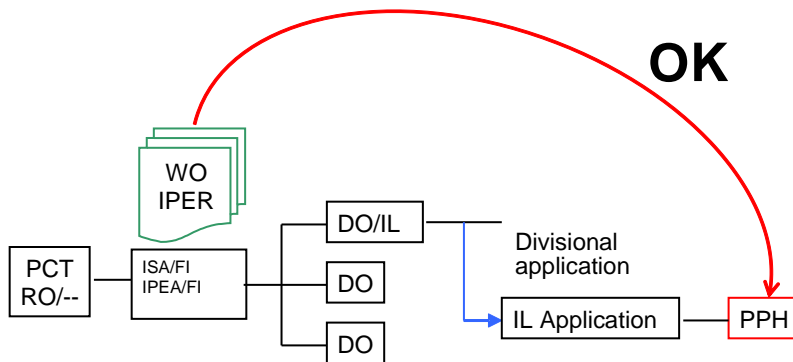
- (d) The Israel application is a national application claiming foreign/domestic priority to the corresponding PCT application. See diagram (D) below.

(D) The Israel application is a national application claiming foreign/domestic priority to the corresponding PCT application.

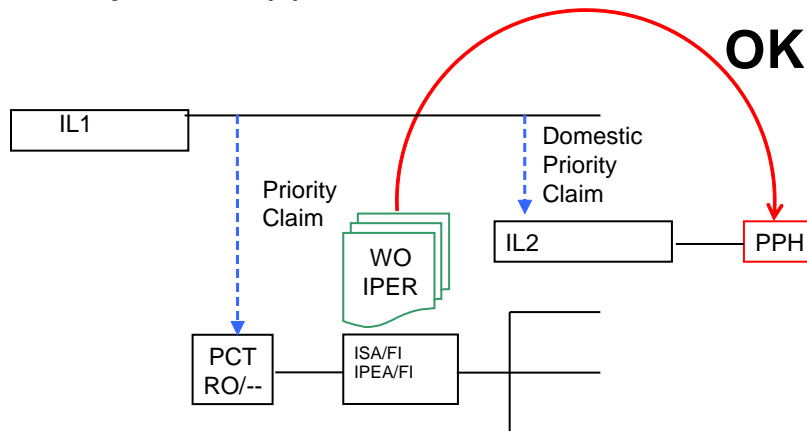


(e) The Israel application is a divisional application of the Israel application which satisfies one of the above (a) through (d) scenarios. See diagrams (E1) and (E2) below.

(E1) The Israel application is a divisional application of an application which satisfies requirement (a).



(E2) The Israel application (IL2) is an application claiming Domestic priority to an application (IL1) which satisfies requirement (b).



(2) The latest work product in the international phase of the PCT application corresponding to the Israel application, namely, the WO/ISA, WO/IPEA, or the IPER, indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability. In case any observation is described in Box VIII of the WO/ISA, WO/IPEA, or IPER which forms the basis for the PCT-PPH request, applicant must identify and explain why the claim(s) is/are not subject to any observation described in Box VIII irrespective of whether an amendment is submitted to correct the observation described in Box VIII. The Israel application will not be eligible to participate in the PCT-PPH pilot program if applicant does not identify and explain why the claim(s) is/are not subject to the observation described in Box VIII.

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the NBPR.

Applicant may not file a request to participate in the PCT-PPH pilot program on the basis of an International Search Report (ISR) only.

(3) Claim Correspondence

(a) All of the claims in each Israel application for which a request for participation in the PCT-PPH pilot program is made must sufficiently correspond to or be amended to sufficiently correspond to one or more of those claims indicated as having novelty, inventive step and industrial applicability and be free of any observation described in Box VIII in the latest work product of the corresponding PCT application.

(b) Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format requirements, the claims in the Israel application are of the same or similar scope as the claims indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application, or the claims in the Israel application are narrower in scope than the claims indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application.

(c) In this regard, a claim that is narrower in scope occurs when a claim indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application is amended to be further limited by an additional feature that is supported in the written description of the Israel application. The claim(s) with the narrower scope must be written in dependent form in the Israel application for which participation in the PCT-PPH pilot program is requested.

(4) Substantive examination of the Israel application for which participation in the PCT-PPH pilot program is requested has not begun.

(5) Applicant must file a request for participation in the PCT-PPH pilot program and a request that the Israel application be advanced out of turn for examination. A sample request form will be available from the ILPO Web site at "<http://www.justice.gov.il/MOJEng/RashamHaptentim/Patents/PPH.htm> " on October 15, 2012.

(6) Unless already filed in the Israel application for which participation in the PCT-PPH pilot program is requested, applicant must submit a copy of the latest international work product, WO/ISA, WO/IPEA or IPER, which indicated that the claim(s) has/have novelty, inventive step and industrial applicability. Where the required documents have been previously filed in the Israel application, applicant may simply refer to these documents and indicate in the request for participation in the PCT-PPH pilot program when these documents were previously filed in the Israel application. Where the Israel application and the corresponding PCT application satisfy the relationship noted in B(1)(a) above, applicant need not submit a copy of the latest international work product since a copy of these documents is already contained in the file wrapper of the Israel application.

(7) Unless already filed in the Israel application for which participation in the PCT-PPH pilot program is requested, applicant must submit a copy of the claims from the corresponding PCT application which were indicated as having novelty, inventive step and industrial applicability in the latest work product of the PCT application. Where the required documents have been previously filed in the Israel application, applicant may simply refer to these documents and indicate in the request for participation in the PCT-PPH pilot program when these documents were previously filed in the Israel application. If the claims in the Israel application for which participation in the PCT-PPH pilot program is requested are identical to the claims from the corresponding PCT application, applicant may just indicate such in the PCT-PPH request and it will not be necessary for applicant to submit a copy of the claims from the corresponding PCT application.

(8) Applicant is required to submit a claims correspondence table in English. The claims correspondence table must indicate how all the claims in the Israel application sufficiently correspond to the claims indicated as having novelty, inventive step and industrial applicability in the latest international work product.

(9) Applicant must submit a listing according to Section 18 of the Israel Patents Law, 5727-1967 ("the Law"), of the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the PCT application corresponding to the Israel application for which participation in the PCT-PPH pilot program is requested (unless such a listing has already been filed in the Israel application, in which case applicant may simply refer to the previously filed listing and indicate in the request for participation in the PCT-PPH pilot program when the listing was previously filed in the Israel application). Applicant must submit copies of all the documents cited in the international work products of the PCT application corresponding to the Israel application (unless the copies have already been filed in the Israel application, in which case applicant may simply refer to the previously filed copies of the documents and

indicate in the request for participation in the PCT-PPH pilot program when the copies were previously filed in the Israel application) except Israel patents or Israel patent application publications.

(10) The request for participation in the PCT-PPH pilot program and all the supporting documents must be submitted to the ILPO via the following email address: PPH@justice.gov.il. Any preliminary amendments and Section 18 of the Law listings submitted with the PCT-PPH documents must be separately indexed as a preliminary amendment and Section 18 of the Law listing, respectively.

Where the request for participation in the PCT-PPH pilot program and special status are granted, applicant will be notified and the Israel application will be advanced out of turn for examination. In those instances where the request for participation in the PCT-PPH pilot program does not meet all the requirements set forth above, applicant will be notified and the defects in the request will be identified. Applicant will be given one opportunity to perfect the request in a renewed request for participation (which must be submitted and indexed accordingly as noted above). Note that action on the application by the examiner will NOT be suspended awaiting a reply by the applicant to perfect the request in a renewed request for participation. That is, if the application is picked up for examination by the examiner after applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, the request and special status will be granted, applicant will be notified and the Israel application will be advanced out of turn for examination. If not perfected, applicant will be notified and the application will await action in its regular turn.

Request for participation in the PCT-PPH pilot program and special status granted in a parent application will not carry over to a divisional application. Applicant must fulfill all the conditions set forth above in order for special status to be granted in the divisional application.

C. Special Examining Procedures

Once the request for participation in the PCT-PPH pilot program and special status have been granted to the Israel application, the Israel application will be taken up for examination by the Israel examiner before all other categories of applications except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination."

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program must "sufficiently correspond" to the claims indicated as having novelty, inventive step and industrial applicability in the latest work product of the corresponding PCT application. See the definition of "sufficient correspondence" in II.B (3) above. Applicant is required to submit a claims correspondence table along with the amendment (see II.B (8) above). If the amended or newly added claims do not sufficiently correspond to the claims indicated as having novelty, inventive step and

industrial applicability in the latest work product of the corresponding PCT application, the amendment will not be entered and will be treated as a non-responsive reply.

This PCT-PPH program does not absolve applicants of all their duties under the Israel Patents Law, 5727-1967. By complying with requirements II.B.(6) and (9) identified above, as well as all requirements set forth under section 18 of the Israeli Patents Law, 5727-1967 and public circular M.N.51, applicants would be considered to have complied with their duties to bring to the attention of the ILPO any prior art cited in corresponding foreign application(s) (see section 18 of the Israel Patents Law, 5727-1967). Any inquiries concerning this notice may be directed to pph@justice.gov.il