

Patent Prosecution Highway (PPH) Pilot Program between the Israel Patent Office (ILPO) and the EPO European Patent Office (EPO)

Part I – PPH using national work products from the EPO

1. Background

The Israel Patent Office (ILPO) and the European Patent Office (EPO) have agreed to launch a PPH pilot program.

The PPH is one of the programs designed to reduce administrative and procedural burdens by allowing expedited patent examination in a second patent office, when at least one corresponding claim has already been found patentable in a participating patent office.

2. Brief Overview

The PPH was established to enable an applicant whose claims are determined to be allowable/patentable in the Office of Earlier Examination (OEE) to have the corresponding application filed in the Office of Later Examination (OLE) advanced out of turn for examination while at the same time allowing the OLE to exploit the search and examination results of the OEE.

Where the ILPO is the OEE and the Israeli application contains claims that are determined to be allowable/patentable, the applicant may request accelerated examination at the EPO for the corresponding application filed with the EPO as the OLE.

Where the ILPO is the OLE and the corresponding application filed with the EPO as the OEE contains claims that are determined to be allowable/patentable, the applicant may request participation in the PPH pilot program in the ILPO and request that the Israeli application be advanced out of turn for examination under the PPH pilot program.

The procedures and requirements for filing a request in the ILPO for participation in the PPH pilot program are set forth below.

A. Trial Period for the PPH Pilot Program

The PPH pilot program commenced on January 6st, 2015, and will end on January 5st, 2018. The trial Period may be extended if necessary to adequately assess the feasibility of the PPH program. The EPO and the ILPO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the Trial Period. The Offices may also terminate the PPH pilot program early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published should the PPH pilot program be terminated before January 5st, 2018 .

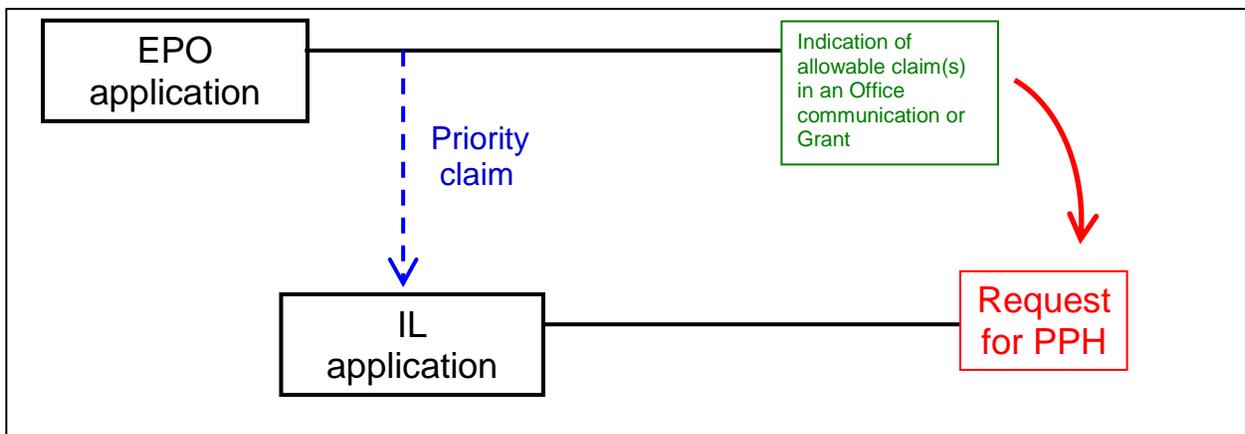
B. Requirements for Requesting Participation in the PPH Pilot Program in the ILPO

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

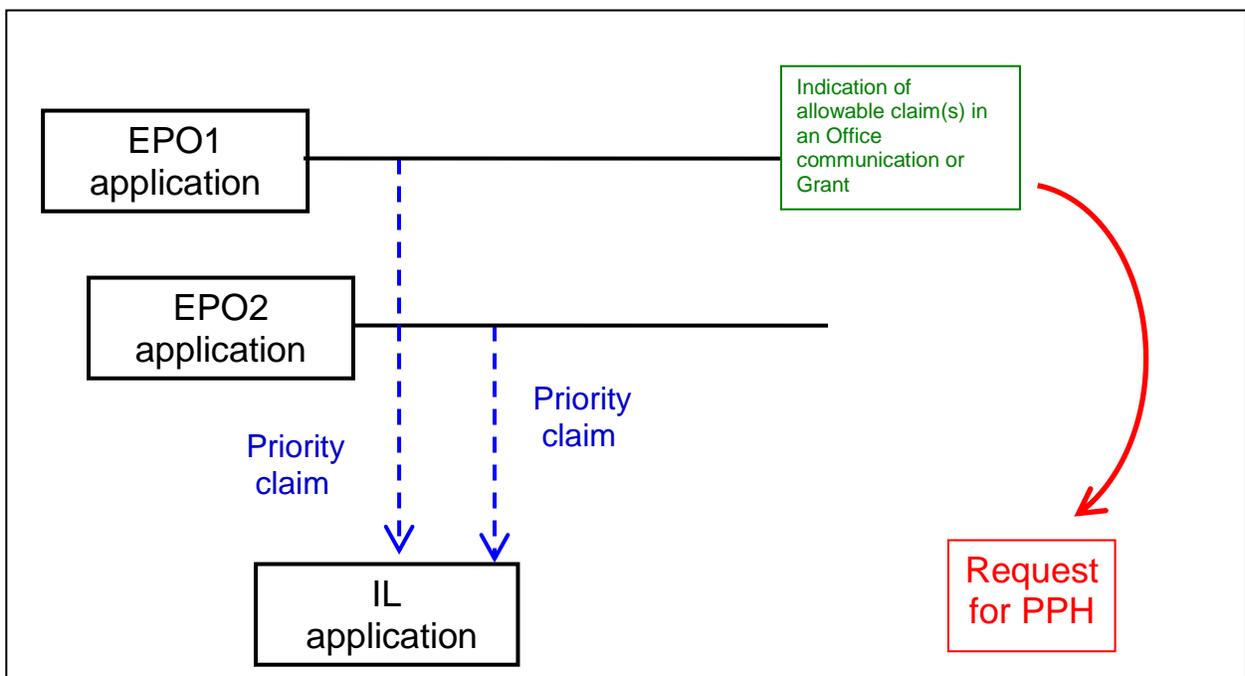
The Israeli (ILPO) application is a Paris Convention application which validly claims priority under section 10 of the Israeli Patents Law, to one or more applications filed with the EPO.

Examples of ILPO applications that fall under this requirement are:

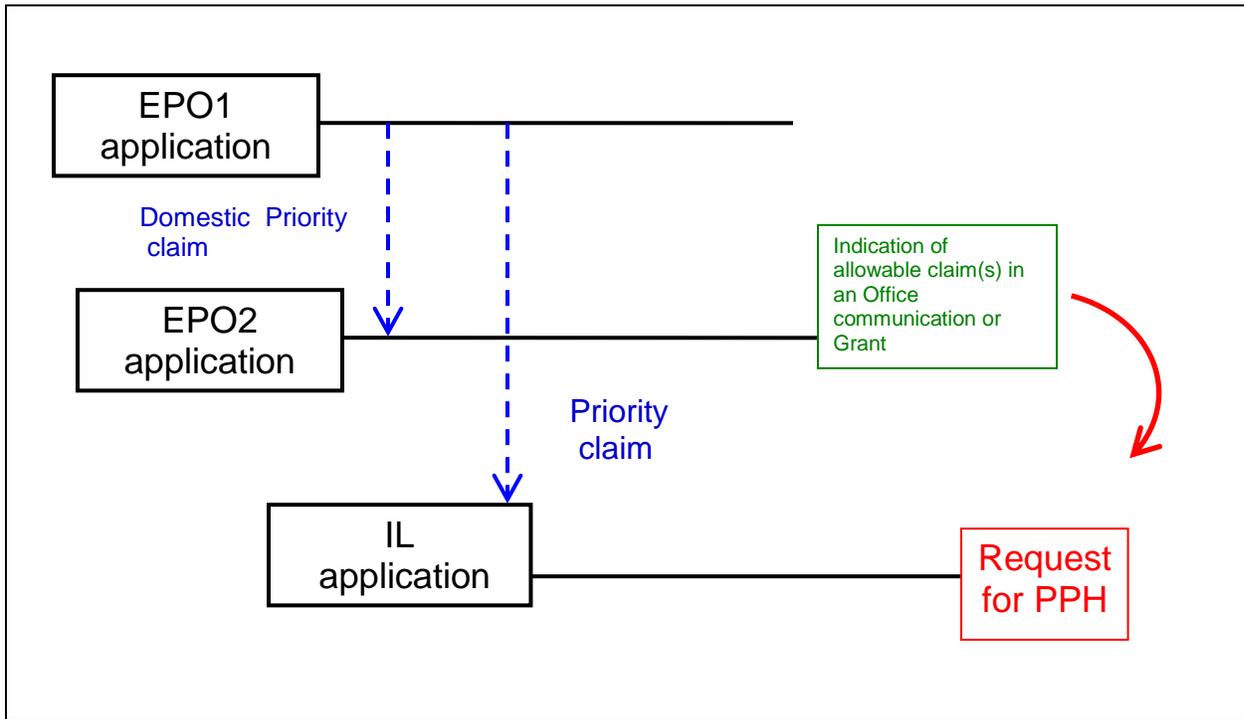
(A) An ILPO application with single Paris Convention priority claim to an application filed at the EPO



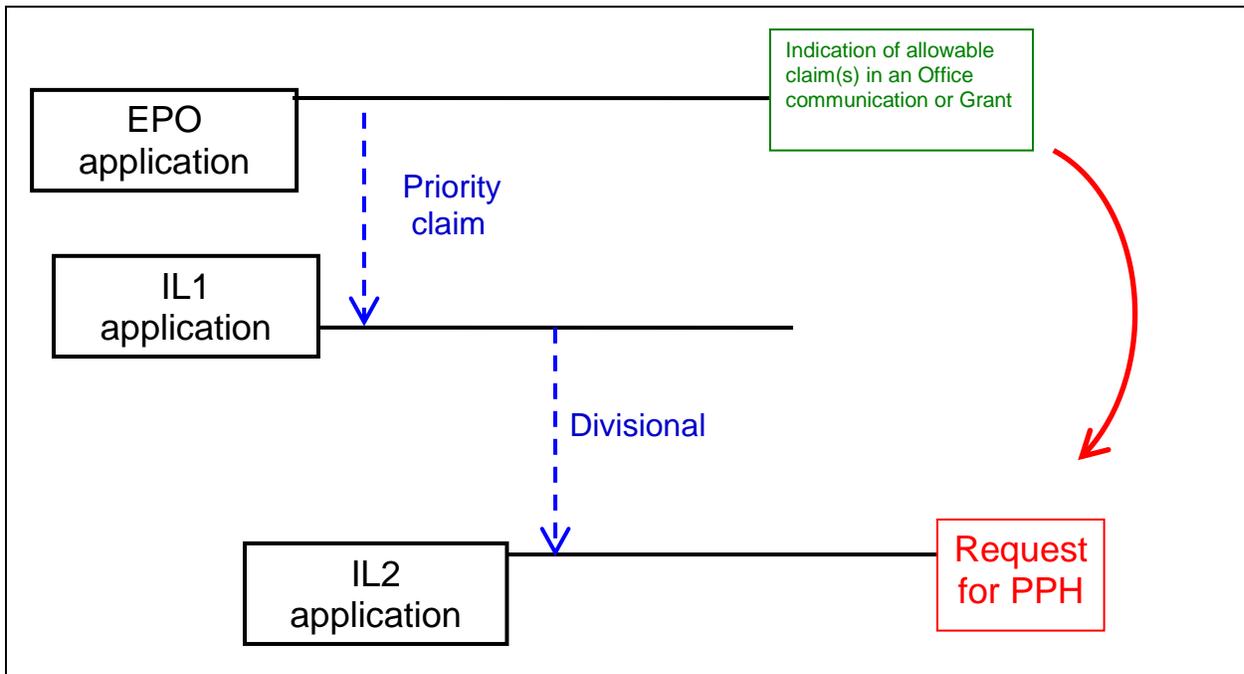
(B) An ILPO application with multiple Paris Convention priority claims to EPO applications



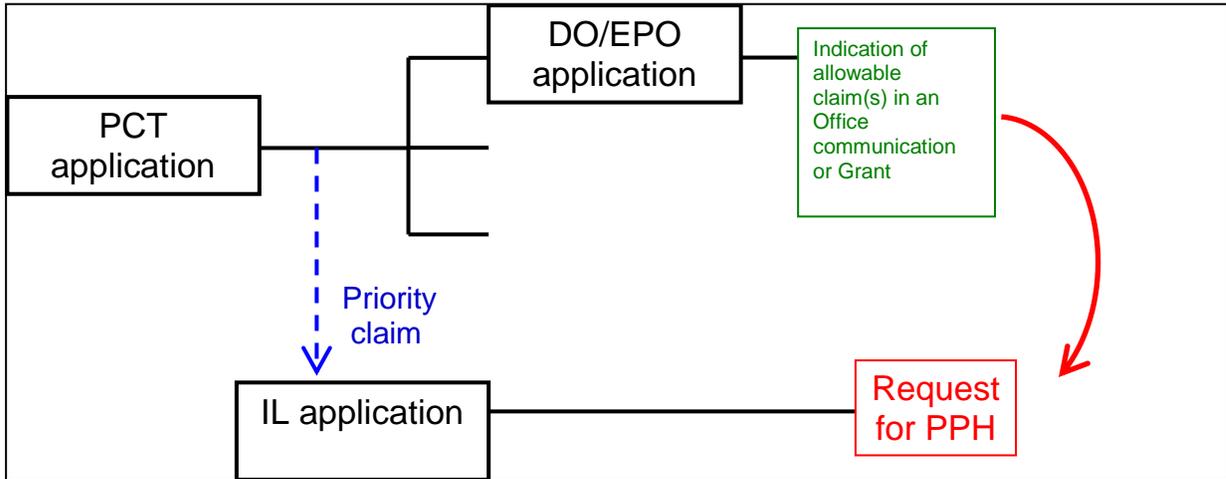
(C) Paris Convention route and domestic priority



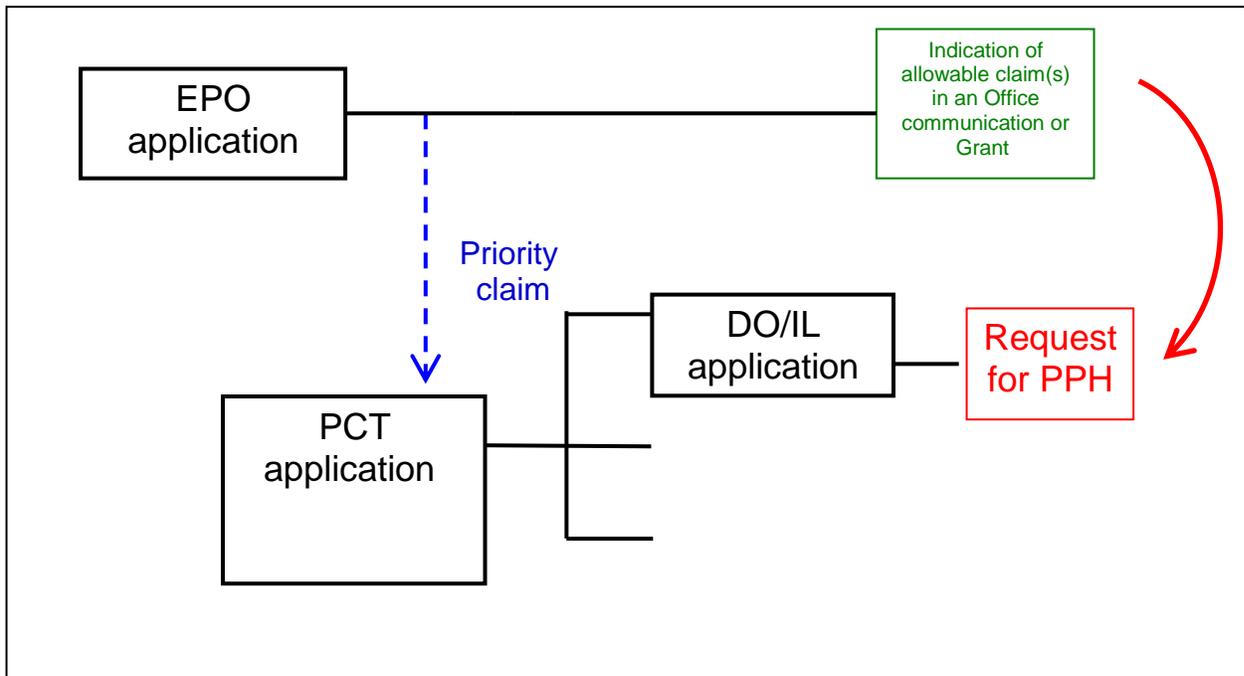
(D) Paris Convention route and divisional applications



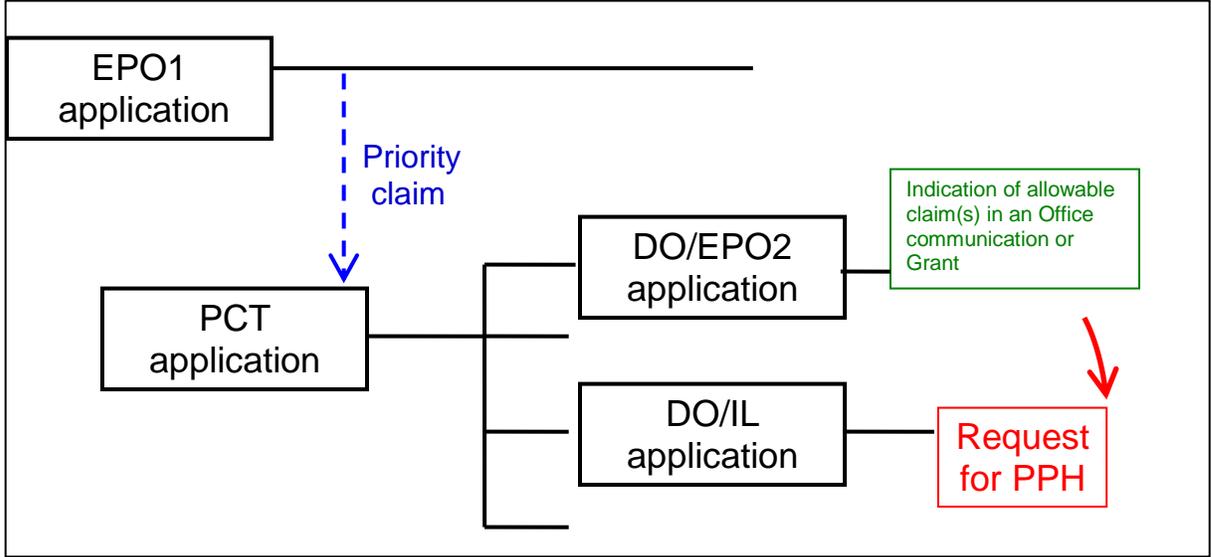
(E) ILPO application claims Paris Convention priority to a PCT application



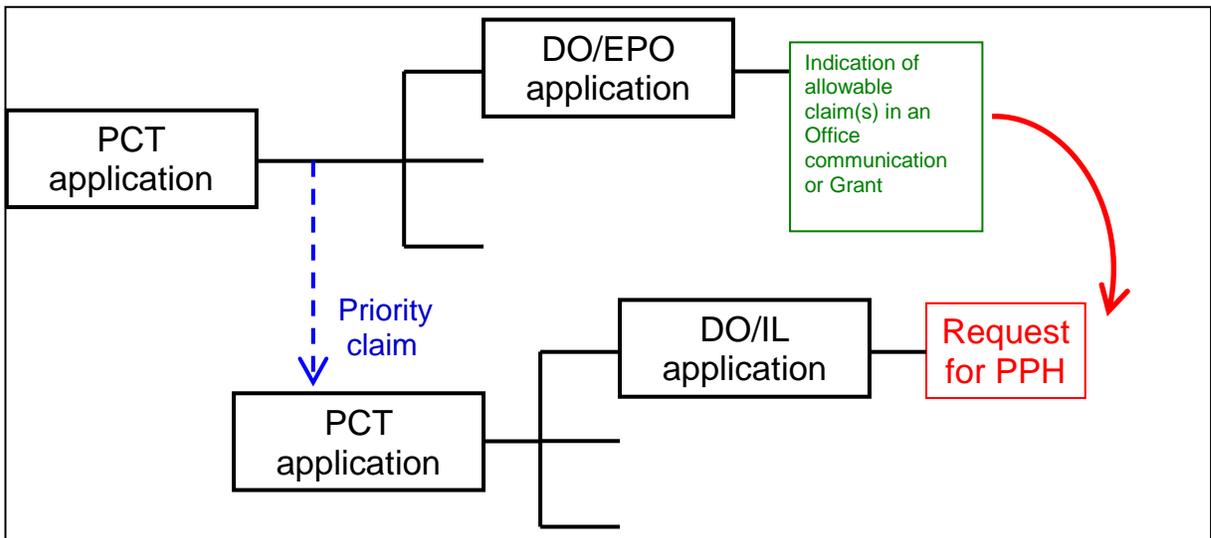
(F) ILPO application is a national stage of a PCT application claiming Paris Convention priority to an EPO application



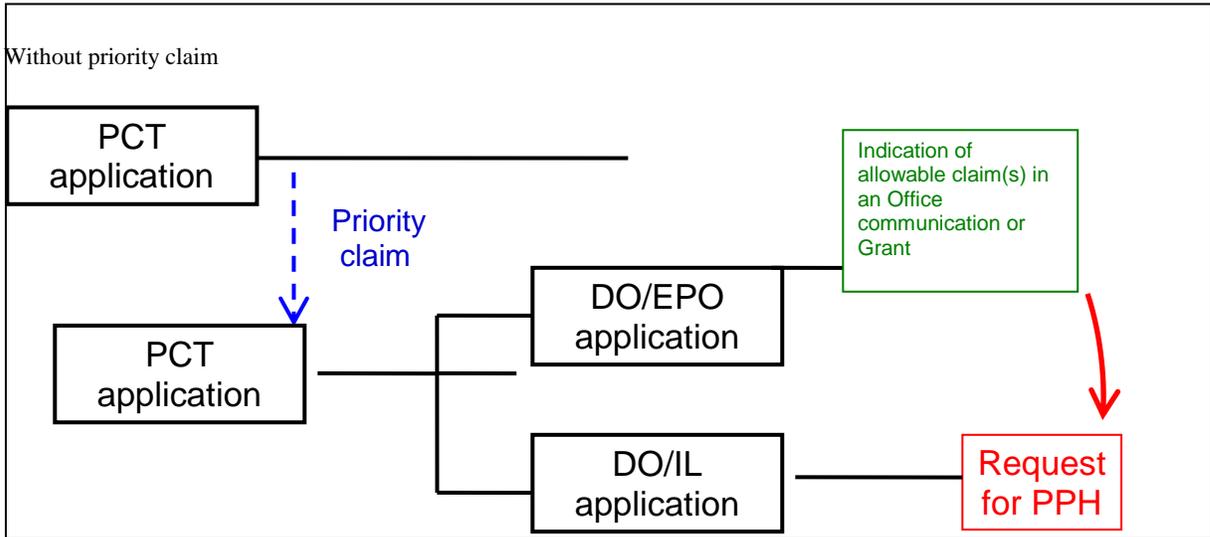
(G) PCT Route



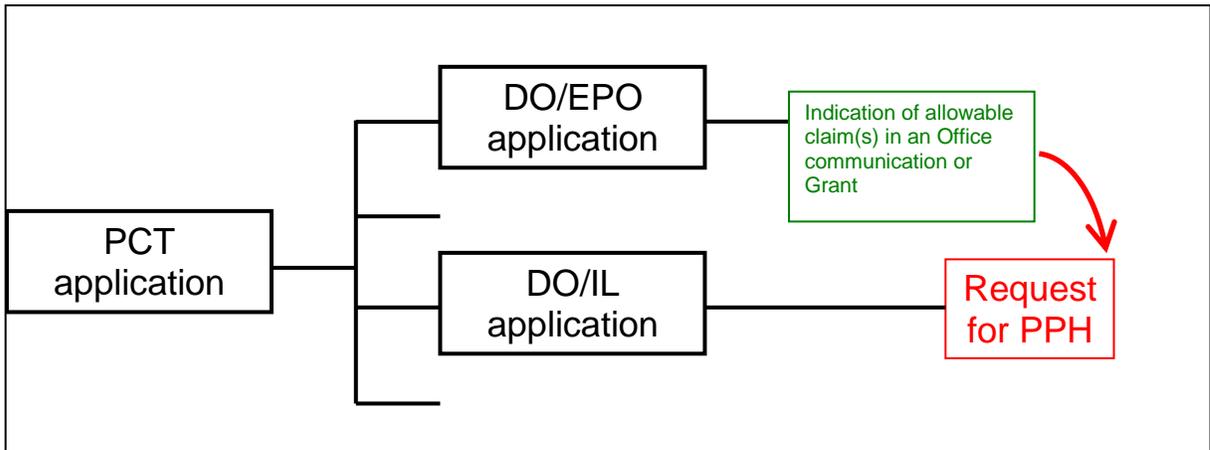
(H) ILPO application is a national stage of a PCT application which claims Paris Convention priority to another PCT application



(I) Direct PCT and PCT Route



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



(1) The EPO application whose claims are determined to be allowable/patentable does not have to be the application for which priority is claimed in the IL application (the basic application). The EPO application can be an application explicitly derived from the basic application, e.g., a divisional application of the basic application. Note that where the EPO application that contains the allowable/patentable claims is not the same application for which priority is claimed in the IL application, applicant must identify the relationship between the EPO application that contains the allowable/patentable claims and the EPO priority application claimed in the IL application (e.g., EPO application X that contains the allowable/patentable claims is a divisional application of EPO application Y, which is the priority application claimed in the IL application).

(2) The EPO application(s) has at least one claim that was determined by the EPO to be allowable/patentable. The applicant does not have to submit a copy of the allowable/patentable claims from the EPO application(s) and the translation when they are provided via "European Patent Register"¹ (EPO's dossier access system). However, if the ILPO examiner is not able to obtain them via the "European Patent Register" or understand the translated claims, the ILPO examiner may request the applicant to provide the necessary documents.

If the EPO 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 EPO Office action regarding that claim, and therefore, the claim is deemed allowable by the EPO.

(3) All the claims in each IL 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/patentable claim(s) in the EPO application(s).

All claims on file as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the EPO. Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the ILPO are of the same or similar scope as the claims in the EPO, or the claims in the ILPO are narrower in scope than the claims in the EPO.

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

It is not necessary to include all claims determined to be patentable in the EPO in the application to the ILPO, as the deletion of claims is allowable. In a case where an application to the EPO contains 5 claims which are determined to be allowable, the corresponding application to the ILPO may contain only 3 of those 5 claims.

Applicant is also required to submit a claims correspondence table in English. The claims correspondence table must indicate how all the claims in the IL application correspond to the allowable/patentable claims in the EPO application(s).

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

¹ <https://register.epo.org/regviewer>

(5) Applicant must file a request for participation in the PPH pilot program. A sample request form is available from the ILPO Web site at:
<http://index.justice.gov.il/Units/RashamHaptentim/Units/patent/Madrichim/Pages/PPH.aspx>

(6) The applicant does not have to submit a copy of all the Office actions (which are relevant to patentability) from the EPO application(s) and the translation when they are provided via "European Patent Register". However, if the ILPO examiner is not able to obtain them via the "European Patent Register" or understand the translated claims, the ILPO examiner may request the applicant to 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 translated office actions to a sufficient extent, the ILPO examiner may request the applicant to submit a professional translation.

(7) Applicant must comply with section 18 of the Israeli Patents Law, 5727-1967 and submit a list of the documents cited by the EPO examiner in the EPO Office action. If the reference is a patent document available online, the applicant is not required to submit it. In case the patent examiner has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

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

Where the request for participation in the PPH pilot program and special status are granted, applicant will be notified and the IL application will be advanced out of turn for examination. In those instances where the request for participation in the 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 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. This is relevant in cases where the application has reached its regular turn. 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 IL 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.

(8) Request for participation in the 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.

If any of the documents identified in items (2), (6) and (7) above have already been filed in the IL application prior to the request for participation in the PPH pilot program, it will not be necessary for applicant to resubmit these documents with the request for participation. Applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot program when these documents were previously filed in the IL application.

C. Special Examining Procedures

Once the request for participation in the PPH pilot program and special status have been granted to the IL application, the IL application will be taken up for examination by the IL 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 PPH pilot program must sufficiently correspond to one or more allowable/patentable claims in the EPO application(s). Applicant is required to submit a claims correspondence table along with the amendment (see B (3) above). If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the EPO application(s), the amendment will not be entered and will be treated as a non-responsive reply under the PPH track and therefore will be processed as a regular application.

The PPH program does not absolve applicants of all their duties under the Israeli Patents Law, 5727-1967. By complying with requirements B (6) and (7) identified above, as well as all requirements set forth under section 18 of the Israeli Patents Law, 5727-1967 and official circular M.N.51, applicants would be considered to have complied with their duties to bring to the attention of the ILPO any material prior art cited in the 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 EPO

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 EPO), or (2) a Written Opinion from an International Preliminary Examining Authority (WO/IPEA) (IPEA must be the EPO), or (3) an International Preliminary Examination Report (IPER) from an International Preliminary Examining Authority (IPEA must be the EPO), 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 ILPO application and petition to make the ILPO 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.

A. Trial Period for the PCT-PPH Pilot Program

The ILPO and the EPO agreed that the PCT-PPH pilot program will commence on January 6st, 2015 for a period of three years ending on January 5st, 2018. The Trial Period may be extended if necessary to adequately assess the feasibility of the PCT-PPH pilot program. The ILPO and the EPO may also terminate the PCT-PPH pilot program early if the volume of participation exceeds a manageable level, or for any other reasons. Notice will be published if the PCT-PPH pilot program will be terminated before January 5st, 2018.

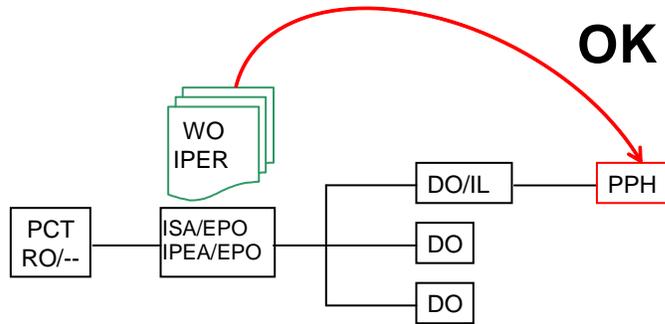
B. Requirements for Requesting Participation in the PCT-PPH Pilot Program in the ILPO

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

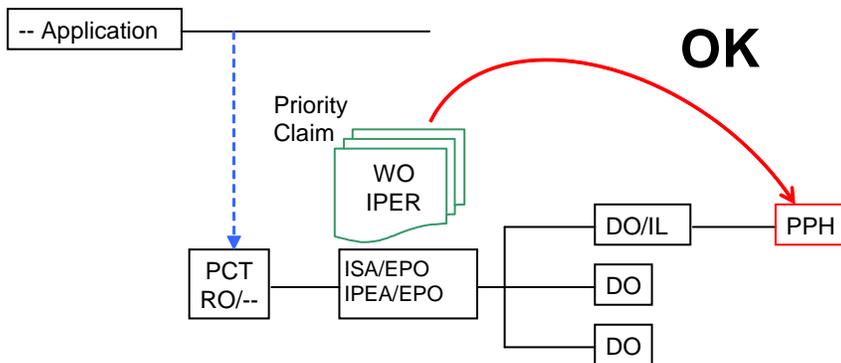
(1) The relationship between the corresponding ILPO application for which participation in the PCT-PPH pilot program is requested and the PCT application satisfies one of the following requirements (note that RO/-- as used in the diagrams below refers to an international application filed under the PCT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

(A) The ILPO application is a national stage entry of the corresponding PCT application. See diagrams (A1), (A2) and (A3) below.

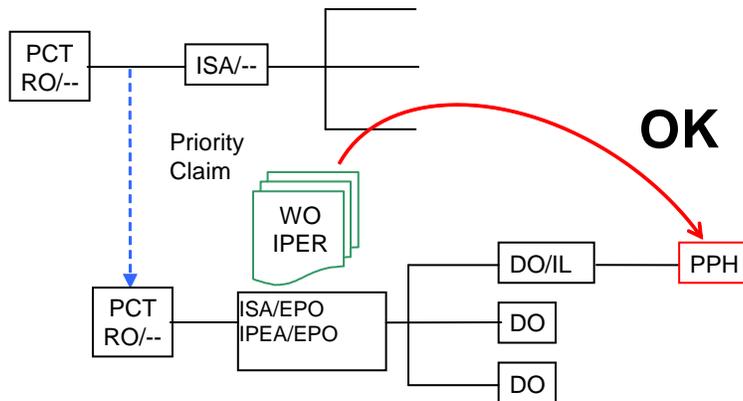
(A1)



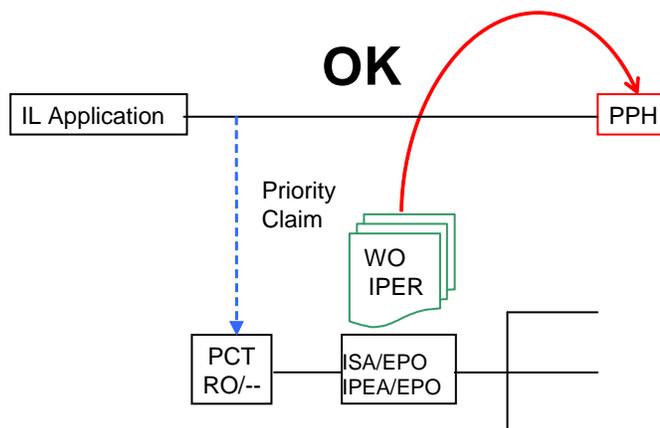
(A2) The corresponding PCT application claims priority to a national application filed anywhere.



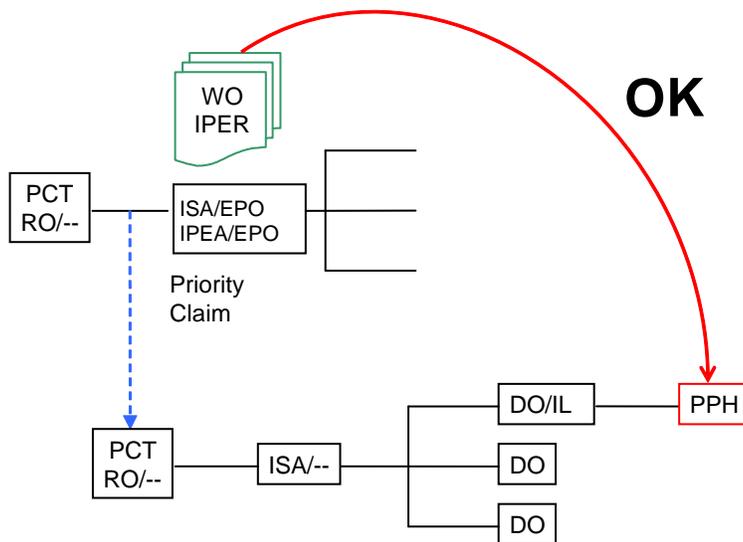
(A3) The corresponding PCT application claims priority from another PCT application.



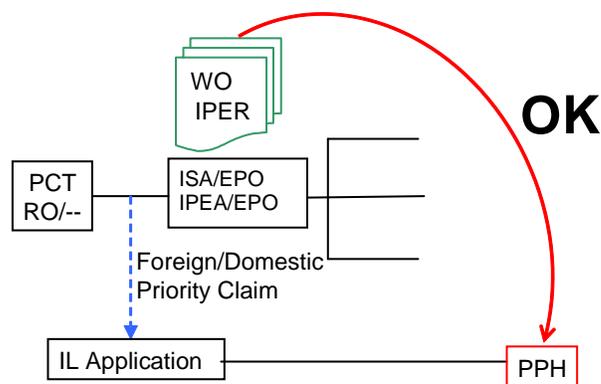
(B) The ILPO application is a national application which forms the basis for the priority claim in the corresponding PCT application.



(C) The ILPO 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.

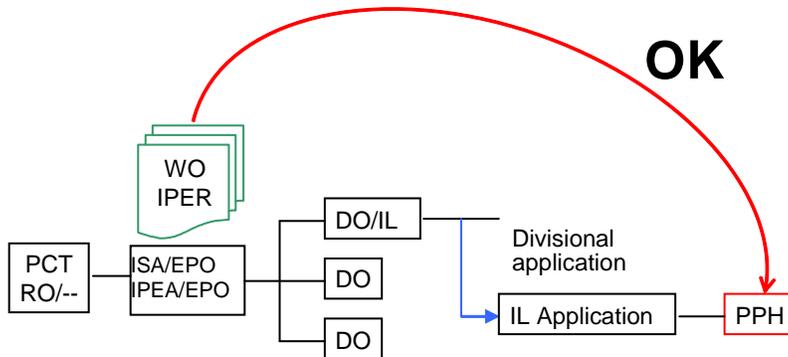


(D) The ILPO application is a national application claiming foreign/domestic priority to the corresponding PCT application. See diagram (D) below.

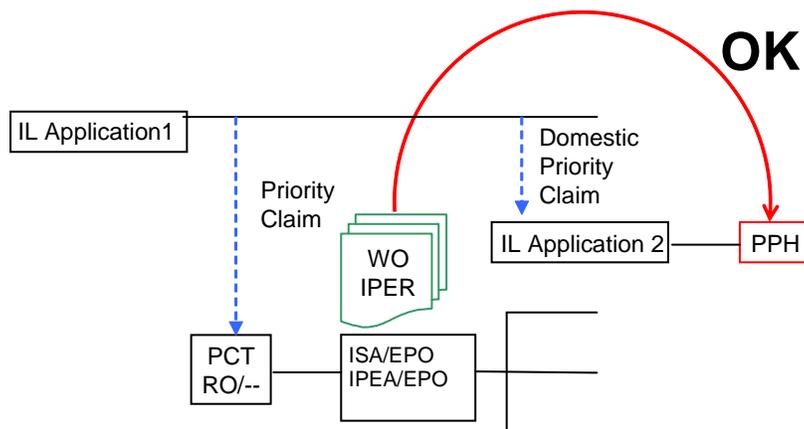


(E) The ILPO application is a divisional application of the ILPO application which satisfies one of the above (A) through (D) scenarios. See diagrams (E1) and (E2) below.

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



(E2) The ILPO 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 ILPO 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 ILPO 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 EPO.

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 ILPO 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 ILPO 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 ILPO 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 ILPO application.

(4) Substantive examination of the ILPO 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. A sample request form will be available from the ILPO Web site at

<http://index.justice.gov.il/Units/RashamHaptentim/Units/patent/Madrachim/Pages/PPH.aspx>

(6) The applicant need not submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof when a copy of these documents is available online. An applicant need not submit these documents, unless otherwise requested by the ILPO.

(WO/ISA and IPER are usually available as "IPRP Chapter I" and "IPRP Chapter II" respectively 30 months after the priority date.)

(7) If the copy of the set of claims which are indicated to be patentable/allowable is available online, an applicant need not submit this document unless otherwise requested by the ILPO. The applicant does not have to submit a copy of the allowable/patentable claims and the translation when they are available online. However, if the ILPO examiner is not able to obtain them via the "European Patent Register" or understand the translated claims, the ILPO examiner may request the applicant to provide the necessary documents.

(8) Applicant is required to submit a claims correspondence table in English. The claims correspondence table must indicate how all the claims in the ILPO 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 ILPO application for which participation in the PCT-PPH pilot program is requested (unless such a listing has already been filed in the ILPO 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 ILPO application). If the reference is a patent document available online, the applicant is not required to submit it. In case the patent examiner has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

(10) The request for participation in the PCT-PPH pilot program and all the supporting documents can either be submitted to the ILPO by mail to: Israel Patent Office, 1 Agudat Sport Hapoel St. Technology Garden, Building No. 5, Jerusalem, 9695101, Israel; or 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 ILPO 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 ILPO 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 ILPO application, the 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 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).

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