

IPO CZ PPH Guidelines for Finnish filers/applicants

**Procedures to file a request to the  
Industrial Property Office of the Czech Republic  
for the  
Patent Prosecution Highway**

**Pilot Program (PPH) between  
the National Board of Patents and Registration of Finland (NBPR)  
and the  
Industrial Property Office of the Czech Republic (IPO-CZ)**

**PPH using national work products from NBPR**

**1. Request to the IPO-CZ**

[0001] An applicant shall file a request for a patent application procedure with accelerated examination under the Patent Prosecution Highway (PPH) to the IPO-CZ accompanied by the relevant required documents. Requirements for the request for patent application procedure under the PPH are stated in the following section (paragraph [0002]). Relevant required documentation is listed in the next section (paragraphs [0003] to [0005]) as is the general IPO-CZ application procedure (paragraph [0006]).

**2. Requirements for filing a request for patent application procedure under the PPH Pilot Program at the IPO-CZ**

[0002] In order to request accelerated examination under the PPH Pilot Program at the IPO-CZ, the following five requirements must be fulfilled:

**a) Patent application filed at the IPO-CZ (including international PCT applications which have entered the national phase in the Czech Republic) is either:**

- (i) an application which validly claims priority under the Paris Convention for the Protection of Industrial Property to the corresponding NBPR application(s), or
- (ii) an international PCT application which has entered the national phase in the

Czech Republic without priority claim (direct PCT applications), or  
(iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim.

An IPO-CZ patent application, which validly claims priority to multiple NBPR or PCT applications, or which is a divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

**b) At least one corresponding NBPR application exists and has one or more claim(s) that have been determined to be patentable by the NBPR.**

Claims clearly identified to be patentable in the latest office action during the examination procedure at the NBPR can form the basis of a request for an accelerated examination under the PPH Pilot Program even if the NBPR has not yet granted a patent for these claims. If the NBPR office action does not explicitly state that a particular claim is patentable, the applicant must submit a statement that no rejection has been made in the NBPR office action regarding this claim and therefore the claim is deemed patentable by the NBPR. Such a statement must be included in the request for participation in the PPH Pilot Program.

If the NBPR application that contains the patentable/allowable claims is not the same application for which priority is claimed in the IPO-CZ patent application, the applicant must identify the relationship between the NBPR application that contains the patentable /allowable claims and the NBPR priority application claimed in the IPO-CZ patent application.

**c) For accelerated examination under the PPH, all claims in the IPO-CZ application must sufficiently correspond to one or more of those claims determined to be patentable in the NBPR.**

All claims in each IPO-CZ patent application for which a participation in the PPH Pilot Program is requested must sufficiently correspond or be amended to correspond to the patentable/allowable claims in the NBPR application(s).

Claims shall be considered to sufficiently correspond where both claims have common technical feature(s) which made the claims patentable over the prior art in the NBPR application. In this regard, a claim which has additional component(s) compared to the claim determined to be patentable by the NBPR or which is the same except for claim format as the claim determined to be patentable by the NBPR will be considered to sufficiently correspond. A claim in the IPO-CZ application which introduces a new/different category of claims to those claims indicated as allowable in the NBPR is not considered to sufficiently correspond.

Note that when claims are determined to be patentable by the NBPR after making

amendments to the claims, the claims at the IPO-CZ must be also amended in a similar way to sufficiently correspond to the patentable claims in the NBPR application.

**d) The IPO-CZ has not yet finished the substantive examination and has not yet invited the applicant to pay the administration fee for issue of the Patent Letter.**

In view of the Czech national legislation, fulfilment of a fifth requirement is necessary:

**e) No later than the date of filing of this request, it is necessary to file a request for substantive examination of the patent application according to Section 33 of Act No. 527/1990 Coll. on Inventions and Rationalisation Proposals, and pay the relevant administration fee associated with this request.**

### **3. Required documents for the procedure of accelerated examination under the PPH Pilot Program at the IPO-CZ:**

[0003] Documentation needed to support a request for accelerated examination under the PPH Pilot Program at the IPO-CZ:

**a) A copy of the office action(s) relating to the corresponding NBPR application(s).**

"Office actions" are documents which relate to substantive examination and which were sent to the applicant or the applicant's representative by the NBPR examiner.

The applicant shall provide the office actions together with the request for the acceleration under the PPH.

It is noted that the applicant must also submit copies of any office actions (which are relevant to assessment of patentability) from the NBPR application(s) issued after the grant of the request for participation in the PPH Pilot Program at the IPO-CZ (especially where the NBPR might have reversed a prior opinion on allow ability/patentability of the claims).

Submission of Czech or English translations of the NBPR office action(s) is required.

**b) A copy of the claims determined to be patentable by the NBPR including any subsequent amended claims found to be patentable by the NBPR.**

The copy of the claims determined to be patentable /allowable by the NBPR might be

either:

- a copy of the document submitted at initial filing which includes claims determined to be patentable where no later amendments to the claims have been made, or
- a copy of the amendments which includes claims determined to be patentable where later amendments to the claims have been made, or
- a copy of the NBPR's publication of the granted patent.

The applicant shall provide the claims together with the request for acceleration under the PPH.

Submission of Czech or English translation of the claims is required.

**c) A completed claim correspondence table**

The applicant must submit a claim correspondence table to explain the correspondence of claims determined to be patentable by the NBPR and the claims of the patent application filed at the IPO-CZ with request for accelerated examination under the PPH. When claims are just literal translation, the applicant can just write down that "claims are the 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 in point 2.c).

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 NBPR application(s). The applicant is required to submit a new claim correspondence table along with the amendments. If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the NBPR application(s), the amendment will not be accepted.

**d) A copy of the references cited by the NBPR examiner**

If the cited references are patent documents, it will not be necessary to submit these documents as they will usually be available to the IPO-CZ. If the IPO-CZ does not have access to the relevant patent documents, the applicant must submit these documents at the request of the IPO-CZ.

Non-patent literature must always be submitted.

Submission of Czech or English translations of these references is required. The IPO-CZ will request Czech translation of the documents when necessary; certification of translations is not required.

[0004] The applicant is required to complete a request form for a procedure with accelerated examination under the PPH Pilot Program which is available for download from the IPO-CZ website (<http://www.upv.cz>). The form must be sent to the IPO-CZ along with the relevant required documentation.

[0005] When the applicant has already submitted the above listed documents 3. a) to 3. d) to the IPO-CZ during simultaneous or past procedures, the applicant may incorporate these documents by reference and does not have to attach them.

#### **4. Procedure regarding the request for accelerated examination under the PPH Pilot Program at the IPO-CZ**

[0006] The applicant files a request form for a procedure with accelerated examination under the PPH Pilot Program to the IPO-CZ along with the documents referred to in point 3.

The applicant is not required to pay any fee for accelerated examination under the PPH.

Upon receiving a request with the documents stated in point 3 of this document, the IPO-CZ decides whether the application can be entitled to the status for an accelerated examination under the PPH. When the IPO-CZ decides that the request is acceptable, the application is assigned a special status for a procedure under the PPH.

In those instances where the request does not fulfil all the requirements stated in this document, the applicant will be notified and informed about the defects in the request. The applicant will be given opportunity to correct or complete the request. If the request and required documents are not appropriately corrected/completed, the applicant will be notified and informed that the patent application will not be included in the PPH project.