

# G-NEWS

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GORODISSKY & PARTNERS  
PATENT AND TRADEMARK ATTORNEYS  
IP LAWYERS

*Merry Christmas and a Happy New Year!*

## WINTER HOLIDAYS 2017

DUE TO THE STATE WINTER HOLIDAYS ALL GORODISSKY & PARTNERS OFFICES ARE CLOSED FROM DECEMBER 31, 2016 TILL JANUARY 8, 2017.

ON MONDAY JANUARY 9, 2017 WE'LL BE BACK TO WORK. ALL DEADLINES FALLING ON THIS PERIOD WILL BE AUTOMATICALLY EXTENDED.

# PPH – shortcut to patent



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In this article we just try to summarize the frequently asked questions of PPH we have recently encountered in our practice. Patent Prosecution Highway (PPH) is the chain of agreements between various patent offices offering a mechanism according to which positive examination results in one (first) patent office can be submitted to a second patent office to accelerate patent prosecution in the second patent office. This procedure was suggested in order to relieve of a burden of repeated examinations in overloaded patent offices and a failure to provide fast issuance of patents, especially for swift developing technologies.

## 1. PURPOSES OF PPH?

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## 2. KINDS OF PPH?

Normal PPH – PPH based on national work products of the first patent office (a patent office of the first filing OFF) which are valid for and used by the second patent office (a patent office of the second filing OSF). PCT PPH – PPH based on PCT international work products issued by the International Search

## Finding ways of sharing work of patent offices to reduce workloads and streamline procedure to offer applicants a faster patent allowance

Authority (ISA) or the International Preliminary Examination Authority (IPEA). The basis for filing PCT PPH request is positive International Preliminary Examination Report (IPER). The applicant cannot file the request on the basis of an International Search Report (ISR) only. PPH MOTTAINAI – PPH based on national work products of the first patent office (a patent office of the earlier examination OEE) which are valid for and used by the second patent office (a patent office of the later examination OLE). The difference from normal PPH is in that according to PPH MOTTAINAI the patent office(s) of the later examination use the work product (decision of grant) issued first by any participating patent office irrespectively of where the first application is filed. GPPH (Global PPH) – actually a developed PPH MOTTAINAI where the same principle is used but the number of participating patent offices is enlarged.

## 3. CAN WE USE PCT WORK PRODUCTS IN THE FRAME OF GPPH?

One of the advantages of GPPH is that PCT international work products can be used by any office of the later examination (OLE) in the frame of GPPH.

## 4. WHY MAY I BE INTERESTED IN USING PPH?

If a positive examination result has been obtained in one country, and the same scope of protection is suitable in other participating countries, using PPH will assist to get easy and quick grant of corresponding pending patent applications in these countries.

## 5. WHAT COUNTRIES ARE PPH-ENGAGED WITH RUSSIA?

If you have a patent application filed in any patent office of Australia, Austria, Canada, China, Denmark, Germany, Great Britain, Hungary, Iceland, Israel, Korea, Norway, Portugal, Singapore, Spain, USA, Finland, Sweden, Estonia, Japan or Nordic Patent Institute you are more than welcome to go ahead with this or that PPH program in Russia. For all the above countries except for China using GPPH is possible and advantageous. Chinese applicants will have to use normal PPH or PCT PPH.

## 6. WHAT IS NECESSARY TO BE ENTITLED FOR PPH IN RUSSIA?

(1) The application at the Russian PTO must have the corresponding first application(s) (at the first office) having the same priority.

(2) The first application should have at least one claim considered allowable by the first patent office. Decision of Grant is not obligatory. It is quite enough to have a notification specifying intension to grant or positive International Preliminary Examination Report (IPER).

(3) Each of the claims to be examined under PPH program must “sufficiently correspond” to the respective claim considered allowable by the first patent office. So the claims for PPH program should be put in line with the claims considered allowable by the first patent office. “Sufficiently correspond” means the claims although having differences due to translation matters and format of drafting but still keeping the same or similar scope, or being narrower. A claim has a narrower scope when it is restricted by inserting additional feature supported by the specification or claims.

Here we according to the practice may state that in Russia “sufficiently corresponding” claims should be literally supported in the original application. A claim does not “sufficiently correspond” when it introduces a new/different category of claims with respect to the claims allowable by the first patent office. E.g. the claims allowable by the first patent office contain process claim and the claims to be examined under PPH program

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comprise product claim dependent on the process claim.

(4) Examination on merits in the Russian PTO must not have begun. For Russia this usually means that the first official Action has not been issued yet. To avoid refusal in entering the PPH program we recommend to file request for PPH simultaneously with examination request.

## 7. DOCUMENTS TO BE FILED?

- (1) PPH request form.
- (2) Copies of all official actions issued by the first patent office as well as Russian translation thereof (in case of PPH request based on the national work product). A copy of the international work product (positive International Preliminary Examination Report (IPER)) and its Russian translation (in case of PPH request based on the international work product).
- (3) Copies of all allowable claims as well as Russian translation thereof.
- (4) Copies of the non-patent documents cited. If the patent document is not available for the Russian PTO, the citation should be submitted by the examiner's request.
- (5) Claim correspondence table indicating “sufficient correspondence” of all the claims pending at the Russian PTO with the claims allowable by the first patent office. When the claims are just literal translation it is quite enough to use language “they are the same”. If it is not the case it is necessary to explain “sufficient correspondence” shown in answer to Q8.

(6) Examination request (may be filed earlier or simultaneously with the PPH request).

#### **8. IS IT POSSIBLE TO SUBMIT ENGLISH TRANSLATION OF THE OFFICIAL ACTIONS AND CLAIMS? WILL MACHINE TRANSLATION BE SUITABLE?**

English translation of the official actions and claims is acceptable. Russian machine translation of the official actions will suffice unless it is impossible for the examiner to get the outline of the official action or the claims. English machine translation is not acceptable.

#### **9. IS IT OBLIGATORY TO FILE COPIES OF THE OFFICIAL ACTIONS ISSUED BY THE FIRST PATENT OFFICE IF THEY ARE ON-LINE AVAILABLE FOR THE EXAMINERS OF THE RUSSIAN PTO?**

No. It is not compulsory if DOSSIER is on-line available for the Russian Examiners.

#### **10. DOES REFUSAL OF A PPH REQUEST IN RUSSIA NECESSARILY MEAN THE END?**

In some patent offices PPH request can be applied for as many times as it is wanted, as long as the respective requirements are met. The Russian PTO gives the applicant a single opportunity to perfect the PPH request. It is important to comprehend that the examination on merits will not be suspended to allow time for the PPH request to be corrected. So if the PPH request is not in line with the requirements you may lose the possibility of getting into the PPH program.

#### **11. HOW FAST CAN I RECEIVE AN OFFICIAL ACTION USING PPH IN RUSSIA?**

According to statistics given by the Japan Patent Office the first official action in the course of normal prosecution in Russia will be issued during 6 months after filing examination request. Using PPH request you will receive the first official action during 3,3 months in average.

#### **12. WHAT IS THE AVERAGE NUMBER OF OFFICIAL ACTIONS WITHOUT AND WITH PPH?**

The numbers are 1,9 and 1,3 respectively. G&P statistics shows 1,13.

#### **13. WHAT IS THE TERM TILL ISSUING THE FINAL DECISION WHEN APPLYING PPH IN RUSSIA?**

Again the Japan Patent Office states that the final decision will be issued during 10 months without PPH and within 3,9 months using PPH.

#### **14. WHAT IS THE LIKELIHOOD OF REFUSAL?**

The Japan Patent Office website informs that in 33% of cases the Russian PTO issues the final rejection without PPH and only in 2% of applications using PPH. G&P practice shows 0,7%, that is 99,3% of allowance.

#### **15. WHAT IS THE PERCENTAGE OF THE FIRST ACTION ALLOWANCES IN RUSSIA?**

G&P database indicates 72%.

#### **16. WHAT DO I SURELY GET FORM PPH IN RUSSIA?**

First of all, you will advance forward in the examination queue and will have accelerated examination completed in 4 months. As a

result, those relying on the PPH need to be aware that the decision on whether to file a divisional application and pursue other embodiments will come quickly, so you need to be prepared prior to pursuing the PPH route. For this reason the PPH is more valuable in industries that don't require state regulatory approval, or where the goal is to license. Then the possibility of allowance is much higher than without PPH, that is the examination result is more predictable. So while there is no guarantee of a patent even if you employ the PPH process, with over 98% of applications allowed it will make considerable sense for those who can qualify for the PPH to pursue this path if the goal is to obtain a quickly issued Russian patent.

Finally, you will surely get the quality patent based on examination product of the first office modified and double-checked by the examiner of the Russian PTO. Last but not least you will save money due to less number of negative official actions.

#### **17. WHAT IS NOT POSSIBLE USING PPH?**

PPH doesn't mean you are going to get your patent, it just means you are going to get your first action much faster. G&P practice shows that in 32% of cases for which we are responsible the examiners first issued negative official actions and only after that the cases were allowed. This also underlines the examination quality.

PPH (at least in Russia) does not allow for complicated claim strategies in different countries including claims of different categories and different number of independent claims. As it was mentioned earlier the claims must "sufficiently correspond". This requirement can sometimes create difficulties for the applicant since neither the claims can be supplemented with additional independent claims nor it is possible to argue that narrower claims obligatory "sufficiently correspond".

PPH does not give you any possibility to extend one-year priority term for filing overseas or to convert a granted patent into a foreign country patent.

#### **18. WHAT ARE POSSIBLE DISADVANTAGES OF PPH?**

Even before PPH has started up we noticed that sometimes the Russian examiners rather used the results of the corresponding prosecutions in the EPO and US PTO than carried out their own national searches. Nowadays with the PPH proliferating, this trend may spread more widely which can lead to decreasing quality of Russian patents as well as diminishing importance of the Russian language patent and non-patent databases. On the other hand, this

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can raise credibility of the Russian language databases in case of need to invalidate patents in different countries.

#### **19. CONCLUSION**

PPH is a new great opportunity to get patent swiftly. But the patent strategies should be reevaluated and the relevancy of PPH thereto should be estimated in view of the particular market goal and patent portfolio.

# Events

(conferences, seminars, news)

## 29.09.2016 // DUBNA

Gorodissky & Partners launched the 11th branch office in Russia - now in Dubna, Moscow region.

Dubna is Russia's famous conglomerate of research, scientific and hi-tech enterprises. Benefits of a Special Economic Area (SEA) in Dubna helps to entice both Russian and foreign investors to the country top priority industries. The new branch office staff along with 140 patent/trademark attorneys and lawyers of Gorodissky & Partners are ready to assist enterprises and companies encompassed by SEA in Dubna on IP issues related to obtaining and protection of IP rights, to management, disposal and commercialization thereof; and also to represent their IP rights before the court and administrative bodies in case of infringement. Opening of the office coincided with the All-Russian Conference "Principles and Mechanisms of Forming the National Innovative System" in Dubna at which Gorodissky Managing Partner Valery Medvedev spoke about the role of IP under the import substitution on the Plenary session of the Conference. After the Plenary session a Cooperation Agreement between Gorodissky & Partners and SEA in Dubna was signed.

## 31.08-1.09.2016 // SHANGHAI



Photo: Vladimir Biriulin speaking

Vladimir Biriulin, Partner, Patent Attorney (Gorodissky & Partners, Moscow), gave a presentation on "Intellectual Property: Fuel of Innovation" at the Global IP & Innovation Summit 2016 hosted by "Managing Intellectual Property" magazine in Shanghai (China). Vladimir provided a guide to IP protection in Russia, addressing the differences between national and Eurasian patents, as well as out-

lined the enforcement options including civil and criminal actions. Over 300 senior IP counsel from across China, Hong Kong, South Korea, Singapore, Vietnam and other countries were in attendance, bringing together in-house counsels and private practice experts.

## 16-20.09.2016 // MILAN

Valery Medvedev, Managing Partner, Sergey Dudushkin, Senior Partner, Elena Nazina, Partner, and Alexander Vasilets, Partner (all from Gorodissky & Partners, Moscow), attended the AIPPI World Congress in Milan where topic issues of current situation and trends of IP protection in the world were discussed. The Congress gathered about 1800 patent/trademark attorneys and IP specialists.

## 21.09.2016 // VLADIVOSTOK

Vladimir Biriulin, Partner, Russian Patent Attorney, and Anton Melnikov, LL.M., Senior Lawyer (both of Gorodissky & Partners, Moscow), Masashi Kurose, Of Counsel (Gorodissky & Partners, Vladivostok), delivered speeches at the Seminar "IP Enforcement in Russia: procedures in courts and customs" hosted by Gorodissky & Partners in Vladivostok for IP attorneys and lawyers from Japanese law firms and industrial companies.

## 11.10.2016 // MOSCOW

Ilya Goryachev, Senior Lawyer (Gorodissky & Partners, Moscow), spoke on "Boundaries of drug patenting and fighting against 'ever green patents' in pharmaceuticals. Practice of compulsory licensing" at the XVII IP Conference "Patenting and protection of innovations – 2016" held by Infor-media Russia company in Moscow. The Conference covered topical issues of IP protection in Russia and was attended by the representatives of the major Russian and foreign right holders.

## 12-13.10.2016 // LONDON

Sergey Dorofeev, Partner, Russian and Eurasian Patent Attorney (Gorodissky & Partners, Moscow), LES Russia President, was a Moderator of the Plenary Session "Compulsory Licensing" and spoke on "Compulsory license: Russia in the global context" at the Pan-European Conference "Being brave for economic growth" held by LES Britain and Ireland in London.



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