

**Procedures to file a request to the Swedish
Intellectual Property Office (PRV)
under the Patent Prosecution Highway (PPH)
Pilot Program
between the National Directorate of Industrial
Property of Uruguay (DNPI) and PRV**

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Overview of the PPH procedure

An applicant, who has filed an application to DNPI under this PPH pilot program may, when filing a corresponding application to the PRV, request accelerated examination by submitting a request form, accompanied by supporting documents. The application must satisfy certain requirements as set out below.

The PRV decides whether the application can be entitled the status of accelerated examination under the PPH when PRV receives a request with the documents stated above. When PRV decides that a request is acceptable, the applicant will be notified and the application is assigned a special status for accelerated examination.

If the request does not meet all the requirements set forth below, 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 the defect(s) are not corrected, the application will await action in its regular turn.

The Offices may 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 national work products

When filing a request for the PPH pilot program, an applicant must submit a request form accompanied by the relevant supporting documents. The requirements for an application to the PRV for accelerated examination under the PPH are given in section 1 and relevant supporting documentation is discussed in section 2.

1. Requirements

The application which is filed with the PRV and on which the applicant files a request under the PPH must satisfy the following requirements:

1.1 Both the PRV application on which PPH is requested and the DNPI 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 PRV application (including PCT national phase application) may be either:

(Case I) - an application which validly claims priority under the Paris Convention from the DNPI application(s) (see examples in Annex 2, Fig. A, B, C, D, E and F), or

(Case II) - an application which provides the basis of a valid priority claim under the Paris Convention for the DNPI application(s) (including PCT national phase application(s)) (see examples in Annex 2, Fig. G and H), or

(Case III) - an application which shares a common priority document with the DNPI application(s) (including PCT national phase application(s)) (see examples in Annex 2, Fig. I, J, K, L and M), or

(Case IV) - a PCT national phase application where both the PRV application and the DNPI application(s) are derived from a common PCT international application having no priority claim (see example in Annex 2, Fig. N).

1.2 At least one corresponding application exists in the DNPI and has one or more claims that are determined to be patentable/allowable by the DNPI.

1.3 All claims in the PRV application (for which an accelerated examination under the PPH pilot program is requested) must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the DNPI.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the PRV are of the same or similar scope as the claims in the DNPI, or the claims in the PRV are narrower in scope than the claims in the DNPI. In this regard, a claim that is narrower in scope occurs when an DNPI claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims). A claim in the PRV application which introduces a new/different category of claims to those claims indicated as allowable in the DNPI is not considered to sufficiently correspond. For example, where the DNPI claims only contain claims to a process of manufacturing a product, then the claims in the PRV are not considered to sufficiently correspond if the PRV application claims introduce product claims that are dependent on the corresponding process claims. Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as patentable/allowable in the DNPI application.

1.4 PRV has not yet issued a “Final notice” (Swedish: “Slutföreläggande”) at the time of request under PPH

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to the PPH request.

All documents under this paragraph with exception for the cited documents have to be drawn up in or translated to Swedish or English. Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated work product or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

(a) Copies of all Office actions (which are relevant to substantial examination for patentability in the DNPI) which were issued for the corresponding application by the DNPI, and translations of them.

PRV accepts any substantive search and examination product that explicitly indicates the patentability of claims (e.g. those including a written opinion if other than an initial notice to grant) done by the DNPI.

The applicant does not have to submit a copy of DNPI Office actions and translations of them when those documents can be provided via the DNPI's dossier access system. If they cannot be obtained by the PRV examiner via the DNPI's dossier access system, the applicant may be notified and requested to provide the necessary documents.

(b) Copies of all claims determined to be patentable/allowable by the DNPI, and translations of them.

The applicant does not have to submit a copy of claims indicated to be patentable/allowable in the DNPI, and translations thereof when the documents are provided via the DNPI's dossier access system. If they cannot be obtained by the PRV examiner via the DNPI's dossier access system, the applicant may be notified and requested to provide the necessary documents.

(c) Copies of references cited by the DNPI examiner

If the references are patent documents, the applicant doesn't have to submit them because the PRV usually possesses them. When the PRV does not possess the patent document, the applicant has to submit the patent document at the examiner's request. Non-patent literature must always be submitted. Translations of the references are unnecessary.

(d) Claim correspondence table

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the PRV application sufficiently correspond to the patentable/allowable claims in the DNPI application.

When claims are just literal translation, the applicant can just write down that “they are the same” in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim.

When the applicant has already submitted above documents (a) to (d) to the PRV through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

Annex 1

Examples for the claim correspondence table

The claims in the following cases are considered to “sufficiently correspond”.

EX.1

<i>Claims in the DNPI</i>	<i>PRV claims</i>	<i>Comment</i>
1	1	<i>The PRV claim has the additional component on the claim that is determined to be patentable in the PCT application.</i>

Allowable claim, DNPI.	PRV claim
<p>A system for presenting a container storing at least one article to a processing tool, comprising:</p> <p>(a) a load port, including:</p> <p> a frame having an opening;</p> <p> a support structure being adapted to receive a container, and</p> <p> a drive mechanism for moving said support structure substantially vertically between a first height and a second height; and</p> <p>(b) a conveyor for movably supporting the container substantially along a container transport plane;</p> <p> wherein a container traveling on said conveyor moves unobstructed over said support structure when said support structure is located in said second height,</p> <p> wherein the container traveling unobstructed does not contact said support structure while traveling over said support structure located at said second height,</p> <p> wherein said support structure, when located at said second height, is located below said transport plane.</p> <p><i>*This additional part is NOT included in the allowable claim but it is included in the description of the national application</i></p>	<p>A system for presenting a container storing at least one article to a processing tool, comprising:</p> <p>(a) a load port, including:</p> <p> a frame having an opening;</p> <p> a support structure being adapted to receive a container, and</p> <p> a drive mechanism for moving said support structure substantially vertically between a first height and a second height; and</p> <p>(b) a conveyor for movably supporting the container substantially along a container transport plane;</p> <p> wherein a container traveling on said conveyor moves unobstructed over said support structure when said support structure is located in said second height,</p> <p> wherein the container traveling unobstructed does not contact said support structure while traveling over said support structure located at said second height,</p> <p> wherein said support structure, when located at said second height, is located below said transport plane,</p> <p><u><i>wherein said support structure, when located at said first height, is located above said transport plane*</i></u></p>

EX.2

<i>Claims in the DNPI</i>	<i>PRV claims</i>	<i>Comment</i>
1	1	<i>Same</i>
<i>none</i>	2	<i>The PRV claim2 is dependent on the PRV claim1, which has been determined to be patentable in the PCT application.</i>

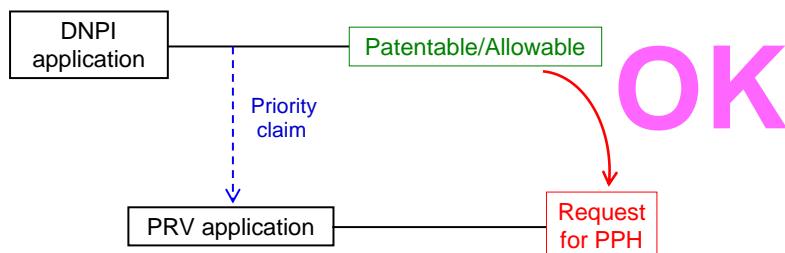
<i>Allowable claim, DNPI</i>	<i>PRV claim</i>
1. A nitride-based semiconductor device comprising: a first semiconductor layer, consisting of either an n-type nitride-based semiconductor layer having a wurtzite structure or an n-type nitride-based semiconductor substrate having a wurtzite structure; and an n-side electrode formed on a back surface of said first semiconductor layer, wherein a dislocation density is not more than $1*10^9 \text{ cm}^2$ in the vicinity of the interface between said first semiconductor layer and said n-side electrode, and contact resistance between said n-side electrode and said first semiconductor layer is not more than $0.05 \Omega \text{ cm}^2$	1. (Same)
2. (None)	2. <i>The nitride-based semiconductor device according to claim 1, wherein said first semiconductor layer includes an n-type dopant*</i>

*This additional part is NOT included in the allowable claim but it is included in the description of the national application

Annex 2

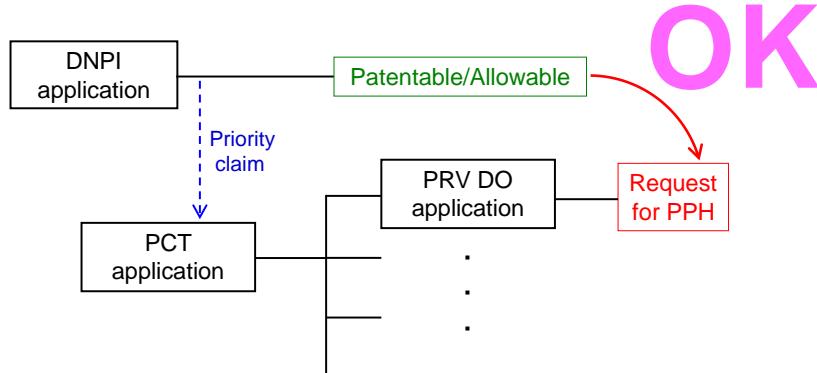
A

An example of Case I - Paris route -



B

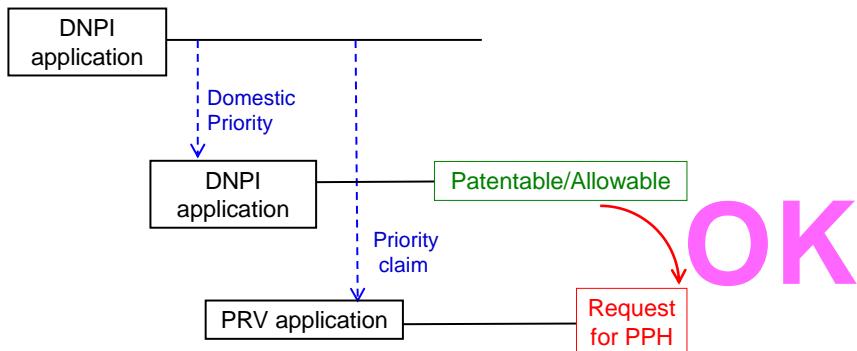
An example of Case I - PCT route -



C

An example of Case I

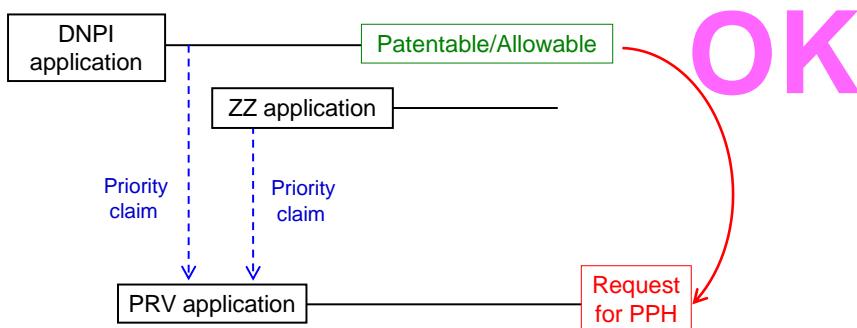
- Paris route, Domestic priority -



D

An example of Case I

- Paris route & Complex priority -

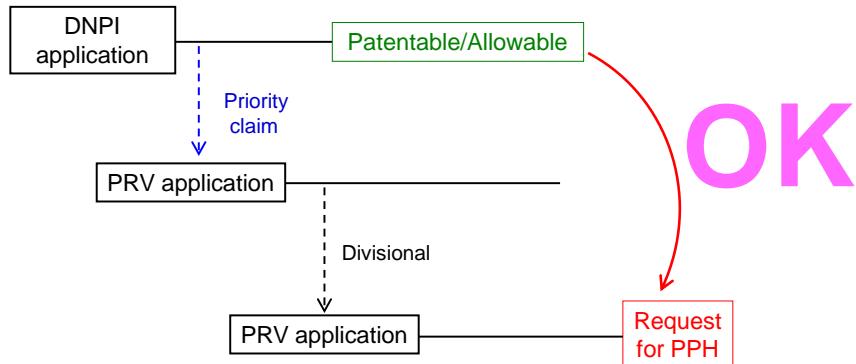


ZZ : any office

E

An example of Case I

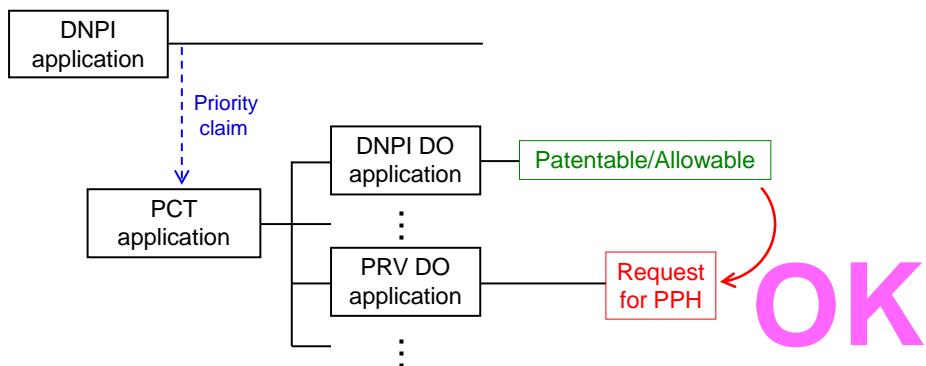
- Paris route & divisional application -



F

An example of Case I

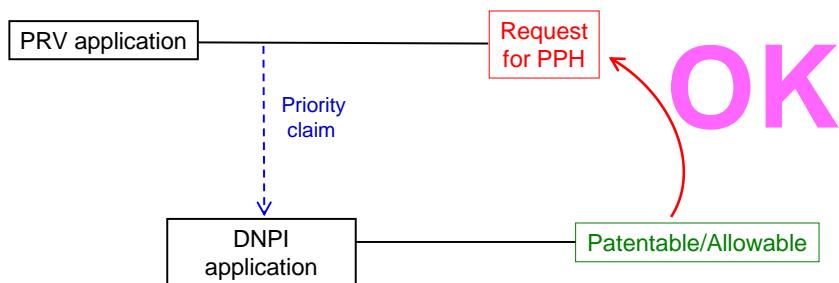
- PCT route -



G

An example of Case II

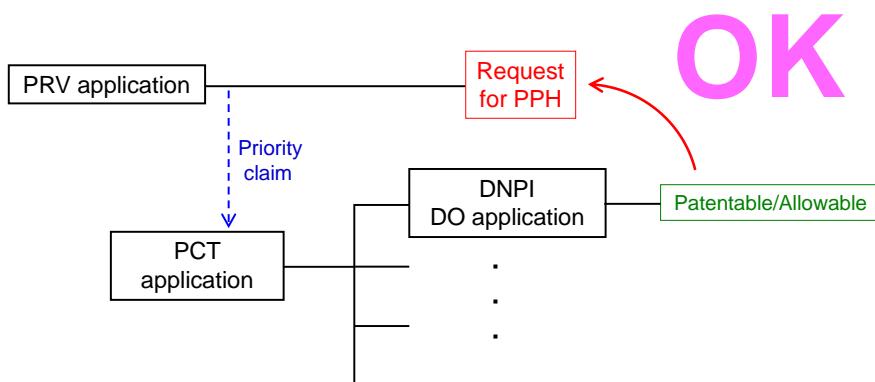
- Paris route -



H

An example of Case II

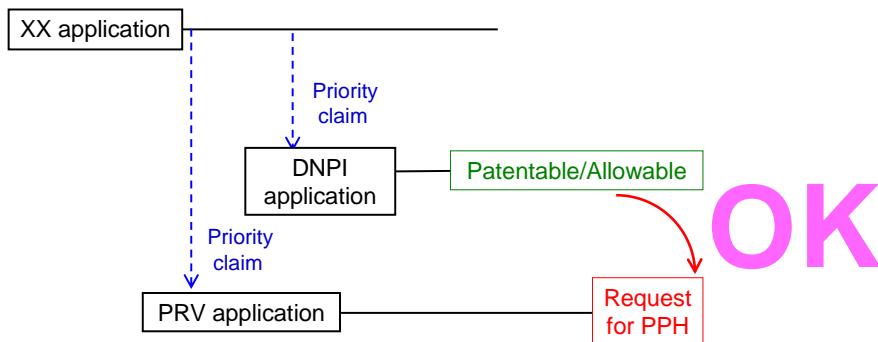
- PCT route -



I

An example of Case III

- Paris route, but the first application is from the third country -

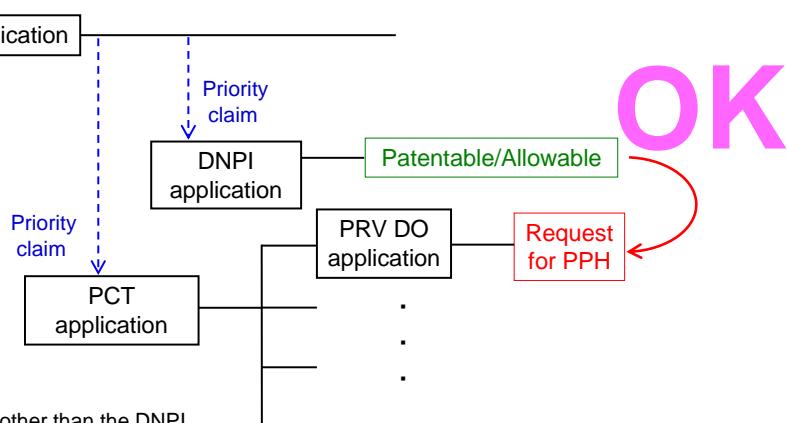


XX : an office other than the DNPI

J

An example of Case III

- PCT route, but the first application is from the third country -

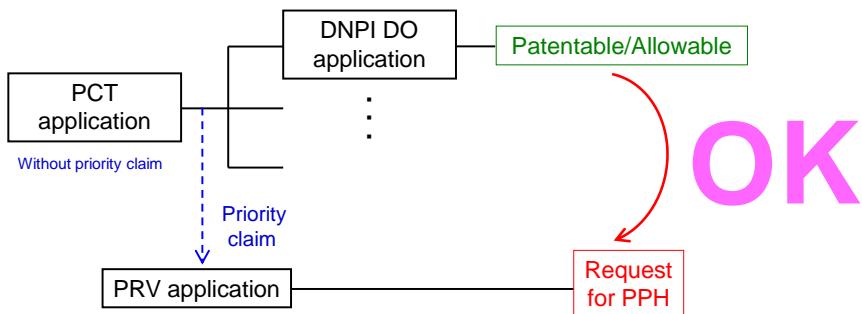


XX : an office other than the DNPI

K

An example of Case III

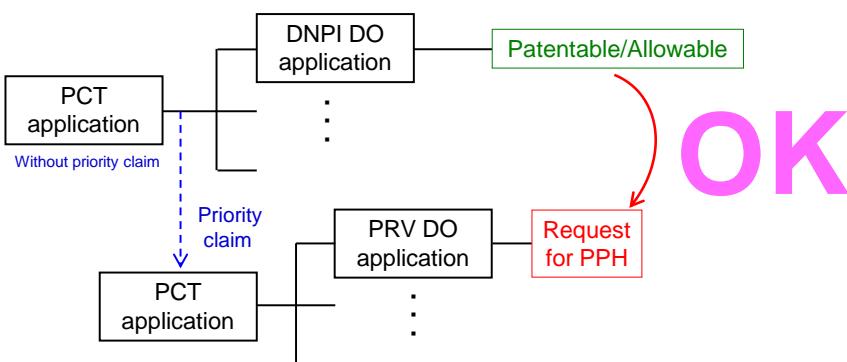
- Direct PCT & Paris route -



L

An example of Case III

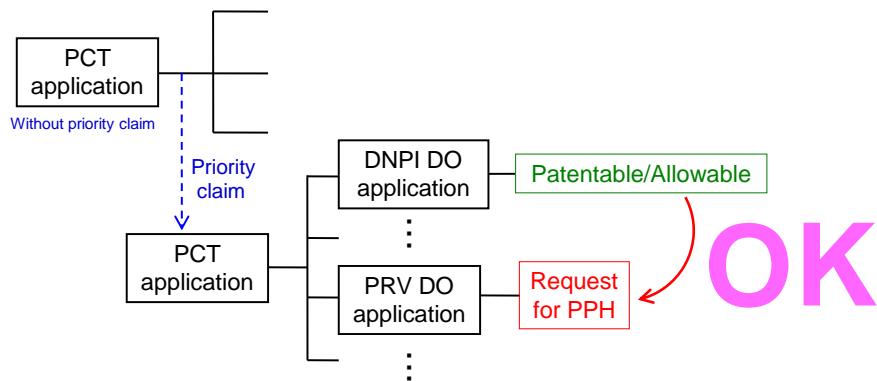
- Direct PCT & PCT route -



M

An example of Case III

- Direct PCT & PCT route -



N

An example of Case IV

- Direct PCT route -

