

Patent Prosecution Highway Pilot Program between the Israel Patent Office and the United States Patent and Trademark Office based on Patent Cooperation Treaty Work Products

I. Background

Since August 1, 2012, the Israel Patent Office (ILPO) has conducted a Patent Prosecution Highway (PPH) pilot program with the United States Patent and Trademark Office (USPTO), based on Patent Cooperation Treaty (PCT) work products (PCT-PPH pilot program).

The ILPO and the USPTO agreed to extend the pilot program indefinitely starting on August 1, 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.

II. 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 USPTO), or
- (2) a Written Opinion from an International Preliminary Examining Authority (WO/IPEA) (IPEA must be the USPTO), or
- (3) an International Preliminary Examination Report (IPER) from an International Preliminary Examining Authority (IPEA must be the USPTO), 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.

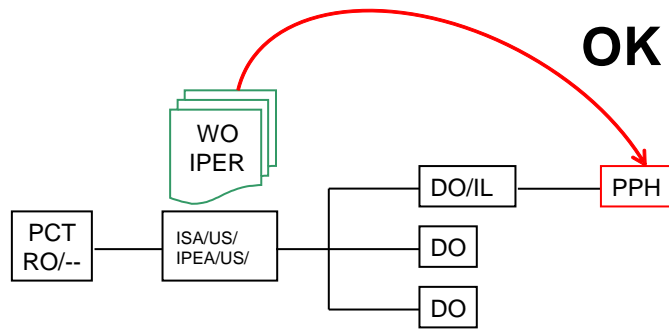
A. Requirements for Requesting Participation in the PCT-PPH Pilot Program in the ILPO

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):

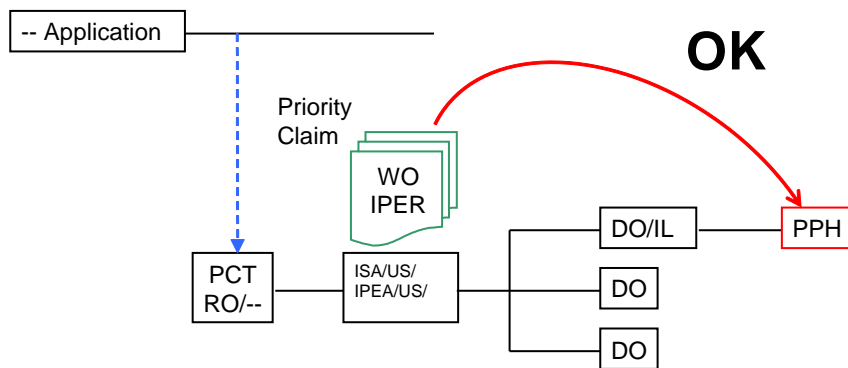
(a) The Israel application is a national stage entry of the corresponding PCT application. See diagrams (A), (A') and (A'') below.

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

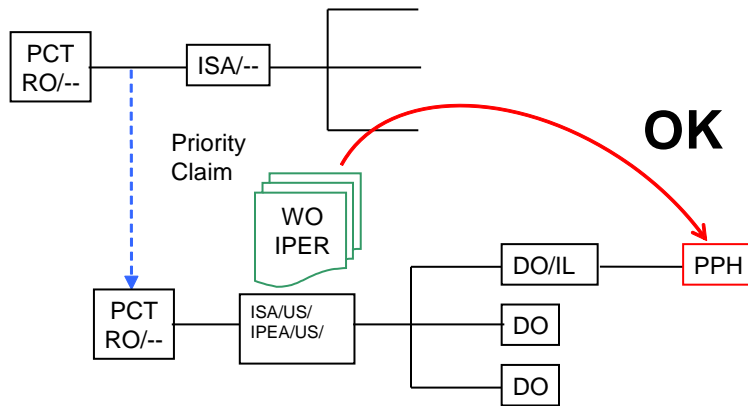


(A') The Israel application is a national stage entry of the corresponding PCT application.

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

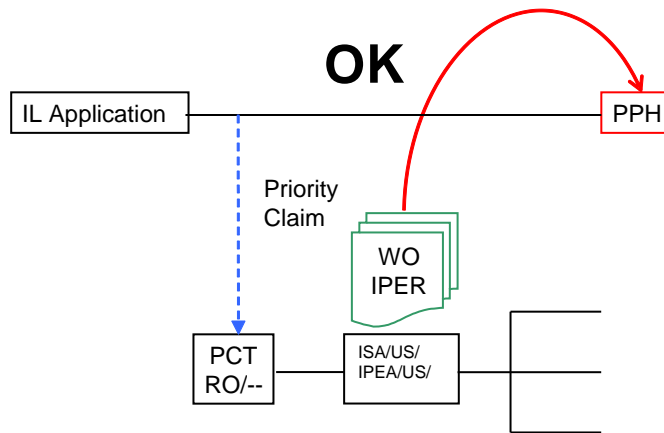


**(A'') The Israel application is a national stage entry of the corresponding PCT application.
(The corresponding PCT application claims priority to another PCT application.)**



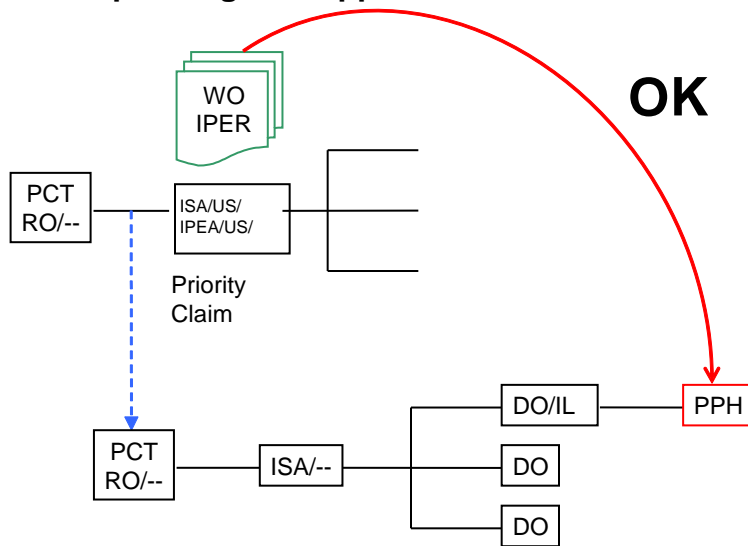
(b) The Israel application is a national application which forms the basis for the priority claim in the corresponding PCT application. See diagram (B) below.

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



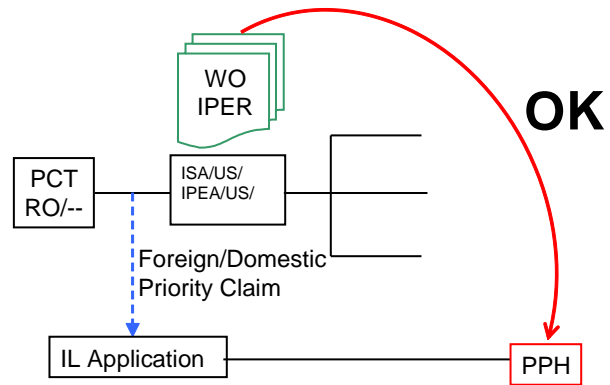
(c) The Israel application is a national stage entry of another PCT application (which can be filed in any competent receiving office) which claims priority to the corresponding PCT application. See diagram (C) below.

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



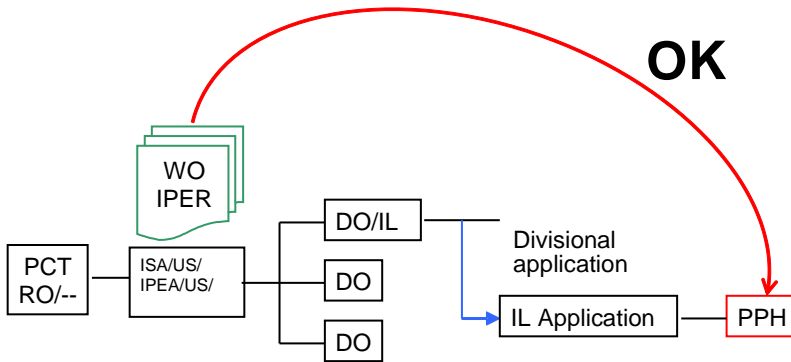
(d) The Israel application is a national application claiming foreign/domestic priority to the corresponding PCT application. See diagram (D) below.

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

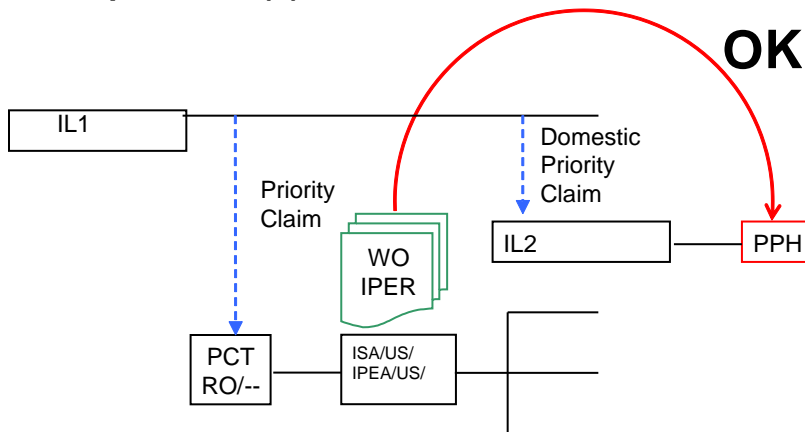


(e) The Israel application is a divisional application of the Israel application which satisfies one of the above (a) through (d) scenarios. See diagrams (E1) and (E2) below.

(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 USPTO.

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"](http://www.justice.gov.il/MOJEng/RashamHaptentim/Patents/PPH.htm) on August 1, 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.

B. 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 Israeli Patents Law, 5727-1967). Any inquiries concerning this notice may be directed to pph@justice.gov.il

Date: _____

Asa Kling
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Commissioner of Patents, Designs and Trademarks