Hungarian Intellectual Property Office

GPPH using the national work products from the OEE

Procedures to file a request to the Hungarian Intellectual Property Office (HIPO) for Global Patent Prosecution Highway Pilot Program

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the HIPO and satisfies the following requirements under the Global Patent Prosecution Highway (GPPH) pilot program based on an OEE application. When filing a request for the GPPH pilot program, an applicant must submit a request form (Global PPH Request Form) to the HIPO.

Part I

GPPH using the national (Paris convention) work products

An applicant should file a request (Global PPH Request Form) for accelerated examination under the Global Patent Prosecution Highway to the HIPO by submitting a letter requesting accelerated examination **under the GPPH** accompanied by the relevant supporting documents. The requirements for an application to the HIPO for accelerated examination under the GPPH are given in Section 1 and relevant supporting documentation is discussed in Section 2.

Section 1

Requirements

(a) **Both the HIPO application on which PPH is requested and the Office of Earlier Examination (OEE) 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 HIPO application (including PCT national phase application) may be either:

(Case I) an application which validly claims priority under the Paris Convention from the OEE application(s) (examples are provided in Annex IA), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the OEE application(s) (including PCT national phase application(s)) (examples are provided in Annex IA), or

(Case III) an application which shares a common priority document with the OEE application(s) (including PCT national phase application(s)) (examples are provided in Annex IA), or

(Case IV) a PCT national phase application where both the HIPO application and the OEE application(s) are derived from a common PCT international application having no priority claim (an example is provided in Annex IA).

***(b)* At least one corresponding application exists in the OEE and has one or more claims that are determined to be patentable/allowable by the OEE.**

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the OEE application which forms the basis of the priority claim (e.g., a divisional application of the OEE application), or a OEE national phase application of a PCT application.
See Annex IB, in regard to concrete cases that claims are "determined to be patentable/allowable" on each OEEs.

***(c)* All claims in the HIPO application (for which an accelerated examination under the GPPH pilot program is requested) must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the OEE.**

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the HIPO are of the same or similar scope as the claims in the OEE, or the claims in the HIPO are narrower in scope than the claims in the OEE. In this regard, a claim that is narrower in scope occurs when a OEE 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 HIPO application which introduces a new/different category of claims to those claims indicated as allowable in the OEE is not considered to sufficiently correspond. For example, where the OEE claims only contain claims to a process of manufacturing a product, then the claims in the OLE are not considered to sufficiently correspond if the HIPO 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 OEE application.

***(d)* Request for Examination**

- "Request for substantive examination" has already been filed and the national fee has been paid previously
or should be made along with the GPPH request;

- the HIPO has not yet issued the final action "Intention to Grant" (The letter code of the communication is "SM")

Hungarian Intellectual Property Office

Section 2

Documents to be submitted

Documents (A) to (D) below must be submitted by attaching to the GPPH request.

(A) Copies of all Office actions (which are relevant to substantial examination for patentability in the OEE) which were issued for the corresponding application by the OEE, and translations of them(1).

Either Hungarian or English is acceptable as translation language. The applicant does not have to submit a copy of OEE Office actions and translations of them when those documents are provided by OEE's dossier access system, because the Office actions and their machine translations are available for the HIPO examiner. If they cannot be obtained by the HIPO examiner via OEE's dossier access system, the applicant may be notified and requested to provide the necessary documents.

(1) Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

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

Either Hungarian or English is acceptable as translation language. The applicant does not have to submit a copy of claims indicated to be patentable/allowable in the OEE, and translations thereof when the documents are provided via OEE's dossier access system, because they are available for the HIPO examiner. If they cannot be obtained by the HIPO examiner via OEE's dossier access system, the applicant may be notified and requested to provide the necessary documents.

(C) Claim correspondence table

The applicant requesting GPPH must submit a claim correspondence table (See annex - Claim Correspondence Table), which indicates how all claims in the HIPO application sufficiently correspond to the patentable/allowable claims in the OEE 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.

(D) Copies of references cited by the OEE examiner

f the references are patent documents, the applicant doesn't have to submit them because the HIPO usually possesses them. When the HIPO 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. The translations of the references are unnecessary, however, in case the HIPO has difficulty in obtaining the translation(s), the applicant may be asked to submit them.

Note

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

Hungarian Intellectual Property Office

Other notes

Principally, there is no limitation of number of opportunity given to the applicant to correct certain specified defect. However, no additional opportunities will be given to the applicant to correct *the same defect* in future corrections.

Hungarian Intellectual Property Office

PART II

Using Patent Cooperation Treaty (PCT) Work Products

An applicant should file a request for accelerated examination under the PCT-Global Patent Prosecution Highway (PCT-GPPH) to the Hungarian Patent and Registration Office (HIPO) by submitting a letter requesting accelerated examination under the PCT-GPPH accompanied by the relevant supporting documents. The requirements for an application to the HIPO for accelerated examination under the PCT-GPPH are given in Section 1. and relevant supporting documentation is discussed in Section 2.

Section 1

Requirements

The application which is filed with the HIPO and on which the applicant files a request under the **PCT-GPPH** must satisfy the following requirements:

(a) **The latest work product in the international phase of a PCT application corresponding to the application ("international work product"), namely the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive steps and industrial applicability).**

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the one of the authorities participating in GPPH, but, if priority is claimed, the priority claim can be to an application in any Office, see example A' in Annex II (application ZZ can be any national application). The applicant cannot file a request under PCT-GPPH on the basis of an International Search Report (ISR) only.
In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-GPPH request, the applicant must explain why the claim(s) is/are not subject to the observation irrespective of whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in PCT-GPPH pilot program if the applicant does not explain why the claim(s) is/are not subject to the observation. In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

(b) **The relationship between the application and the corresponding international application satisfies one of the following requirements** (including the case where the Office of the application is the same as the ISA/IPEA of the corresponding international application)**:**

A. The application is a national phase application of the corresponding international application. (See Figures A, A', and A'' in Annex II)

B. The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex II)

C. The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)

D. The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure D in Annex II)

E. The application is the derivative application (divisional application and application claiming domestic priority etc.) of the application which satisfies one of the above requirements (A) – (D). (See Figures E1 and E2 in Annex II)

(c) **All claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated to be patentable/allowable in the latest international work product of the corresponding international application.**

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims of the application are of the same or similar scope as the claims indicated to be patentable/allowable in the latest international work product, or the claims of the application are narrower in scope than the claims indicated to be patentable/allowable in the latest international work product.
In this regard, a claim that is narrower in scope occurs when a claim indicated to be patentable/allowable in the latest international work product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims) of the application.
A claim of the application which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the latest international work product is not considered to sufficiently correspond. For example, the claims indicated to be patentable/allowable in the latest international work product only contain claims to a process of manufacturing a product, then the claims of the application are not considered to sufficiently correspond if the claims of the application 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 PCT-PPH pilot program need not to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product.

(d) **Request for Examination**

- "Request for substantive examination" has already been filed and the national fee has been paid previously
or should be made along with the GPPH request;

- the HIPO has not yet issued the final action “Intention to Grant” (The letter code of the communication is “SM”)

Section 2

Documents to be submitted - when filing a request for accelerated examination under the PCT-GPPH

The applicant must submit the following documents (A-D) attached to the request form (Global PPH Request Form) when filing a request under PCT-GPPH. All documents under this paragraph with exception for the cited documents have to be drawn up in or translated to Hungarian or English.

(A) A copy of the latest international work product of the corresponding international application

In case the application satisfies the relationship 1.1 (A), the applicant does **not** need to submit a copy of the International Preliminary Report on Patentability (IPER) because a copy of these documents is already available in the file-wrapper of the application. In addition, if the copy of the latest international work product is available via PATENTSCOPE®, an applicant does not need to submit these documents, unless otherwise requested by the patent Office (WO/ISA and IPER are usually available as “IPER Chapter I” and “IPER Chapter II” respectively after 30 months from the priority date.) Machine translation will be admissible, but if it is impossible for the examiner to understand the outline of the latest translated international work product due to insufficient translation, the examiner can request the applicant to resubmit translations.

(B) A copy of a set of claims which the latest international work product of the corresponding international application indicated as allowable

If the copy of the set of claims which are indicated as allowable is available via PATENTSCOPE® (or the international Patent Gazette has been published), an applicant does not need to submit this document. In case the HIPO has difficulty in obtaining the documents, however, the applicant may be asked to submit them. Where translations of the allowable claims are necessary, they must be submitted by the applicant since PATENTSCOPE® does not provide them.

(C) Claim correspondence table

The applicant must submit a claim correspondence table to explain the correspondence of claims determined to be allowable in the latest work product of the corresponding international application and all claims in the application (See annex - Claim Correspondence Table).

(D) Copies of references cited in the latest international work product of the corresponding international application

If the references are patent documents, the applicant does not have to submit them because the Office of the application usually has access to them. When the Office of the application does not have access to the patent document, the applicant has to submit the patent

document at the examiner's request. Non-patent literature must always be submitted. Submission of translation of the references is not required. However, applicants will be free to file translations as part of the supporting documentation when initially requesting accelerated examination under the PCT-GPPH to allow prompt consideration of the citations if the applicants so desire.

Other notes

Principally, there is no limitation of number of opportunity given to the applicant to correct certain specified defect. However, no additional opportunities will be given to the applicant to correct *the same defect* in future corrections.