

## **INPI and JPO renew PPH agreement: applicants benefit from extension of covered technical fields**

On 16 January 2019, the Brazilian Patent and Trademark Office (INPI) and the Japan Patent Office (JPO) formalised the renewal of the Patent Prosecution Highway (PPH) pilot project, which continues the provision of fast-track patent examination procedures and the sharing of information from examinations conducted by both offices.

The eligible technical fields under the project have been expanded and now include:

- macromolecular chemistry;
- polymers;
- agrochemicals;
- micro-organisms;
- enzymes;
- metallurgy and materials.

Pharmaceutical and divisional applications cannot benefit from the PPH pilot project.

The International Patent Classifications eligible under Phase II of the PPH project are listed in Table 1.

**Table 1. Patent classification eligible under the PPH pilot project**

<b>Technical field</b>	<b>International Patent Classification code</b>
Machinery and electrical appliances, energy	F21#, H01B, H01C, H01F, H01G, H01H, H01J, H01K, H01M, H01R, H01T, H02#, H05B, H05C, H05F, H99Z
Audiovisual technology	G09F, G09G, G11B, H04N3, H04N5, H04N9, H04N13, H04N15, H04N17, H04R, H04S, H05K
Telecommunications	G08C, H01P, H01Q, H04B, H04H, H04J, H04K, H04M, H04N1, H04N7, H04N11, H04Q
Digital communications	H04L
Communication basic process	H03#
Computer technology	G06# (G06Q not included), G11C, G10L
Methods of information technology for management	G06Q
Semiconductors	H01L
Macromolecular chemistry, polymers	C08B, C08C, C08F, C08G, C08H, C08K, C08L
Metallurgy and materials	B21#, B22C, B22D, B22F, C01B, C01C, C01D, C01F, C01G, C03C, C04B, C21B, C21C, C21D, C22B, C22C; C22F
Agrochemicals	A01N, A01P, C07D, C07G, C07H, C07J
Micro-organisms or enzymes	C12N

Miscellaneous	B60#, B62#, C08J, F02D, G02B, G02F, G03G, G05#, G08G, H01S, H04N19, H04N21, H04W, H05H
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Phase II of the PPH pilot project will run for two years from 1 April 2019 and will be limited to 200 applications per office. In addition, applicants may apply for only one PPH request per month, except for during the last 30 days of the project.

In order to be eligible for Phase II of the PPH pilot project, the following requirements must be met:

- Applications and their corresponding application filed in the other office must have the same earliest date (either priority of filing date).
- The earliest patent application must have been filed at the INPI or the JPO or, under the Patent Cooperation Treaty, at the INPI or the JPO as the receiving office.
- The application must have been substantively examined, including for novelty and inventive step, by the office of earlier examination.
- At the INPI the request must be made as a “decision to grant” a patent application of the same patent family examined by the office of earlier examination, regardless of the application filing date at the offices (*Monttainai* framework). At the JPO the request must be made as a “decision to grant a patent”.
- Invention patent applications and INPI utility model patent applications will be subject to (and/or the basis for) any request from a patent application for participation in Phase II of the PPH pilot project in either office.
- All claims in the application must sufficiently correspond to the patentable or allowable claims in the corresponding applications. Claims will be considered to sufficiently correspond provided that – taking into account the differences due to claim format requirements – they have the same or narrower scope than those in the counterpart application.
- The request must be filed at the office of later examination before the substantive examination of the application has begun.
- Besides the PPH request, the applicant must request substantive examination at the INPI, either at the time of the PPH request or beforehand.

On 8 January 2019, the provisional results on Phase I of the PPH pilot project were published. In almost two years, the INPI received 89 PPH requests, of which 43 have already been decided on. Further, statistics from Phase I have shown that:

- the average time for evaluating PPH requests was 70 days;
- the INPI issued the first office action on average about 160 days after submission; and
- the average time for issuing the final decision was 220 days after submission.

In recent years, the number of Brazilian patent applications filed by foreign applicants has increased. In the last four years, the INPI received an average of 29,976 applications per year, of which 7% were filed by Japanese applicants.

The PPH pilot project has proved to be effective, under the program applicants can save time and money and on average patents have been granted within one year or less. The project is part of a series of measures adopted by the INPI since 2013, aimed at expediting the examination of patent applications and reducing the huge backlog at the office.