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PATENT PROSECUTION HIGHWAY AGREEMENT EXECUTED BY THE MEMBER COUNTRIES OF THE PACIFIC ALLIANCE

On July 1st, 2016 the Pilot Patent Prosecution Highway agreement (PPH) executed by the member states of the Pacific Alliance (Chile, Mexico, Colombia and Peru [1]) came into force.

The PPH Pilot Program is an agreement executed by the patent offices of said countries, which allows applicants to request an accelerated examination process of a patent application. In order to do this, the applicant must request that the Office of Later Examination (OLE) use and apply, as far as possible [2] , the results of the substantive examinations previously conducted by the Office of Earlier Examination (OEE) with regards to claims considered by it to be allowable/patentable.

Thus, the PPH Pilot Program allows patent applicants in Chile, whose patentability has already been examined by IMPI, SIC or INDECOPI (OEEs), to request that INAPI (OLE) provide an accelerated examination of the Chilean application.

In Chile, the requirements for requesting the benefit of accelerated examination established by the PPH Pilot Program are the following:

1. The Chilean application for which PPH is requested and the foreign application are equivalent, this is, that they must have the same earliest date, which can be the same priority date or the same filing date.
2. The foreign application must have been examined substantively by the OEE and have one or more claims considered by it as patentable/allowable.
3. All claims presented for examination under the PPH – as originally filed or as modified – must correspond to one or more of the claims found patentable/allowable by the OEE.
4. The national application filed before INAPI has been published in the Official Gazette.
5. INAPI has not begun the substantive examination of the

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application at the time the PPH request has been filed. Substantive examination begins when an examiner is appointed.

In order to request the benefit of accelerated examination under the PPH Pilot Program, the applicant must request it before INAPI through the respective form and enclose the following documents:

1. A copy of all official actions that are relevant for determining patentability, issued by the respective OEE.
2. A copy of the claims that have been considered by the OEE as patentable/allowable.
3. A claim correspondence table that shows the relationship between the claims of the OLE application and those of the OEE application that were considered allowable/patentable by the latter.
4. Copies of all relevant documents cited by the OEE examiner.

If the requirements set forth above are met, INAPI will grant the request for the accelerated examination of the application. If not, the applicant will be notified of the reasons for the denial. The applicant will be given one opportunity to file a new request correcting the formal deficiencies. There are no official fees applicable to the PPH request.

The main benefits brought by the PPH Pilot Program are, for the applicant, the savings on costs for the prosecution of patents, the reduction in time for the prosecution of patent applications and a greater certainty in obtaining registration; and for patent offices, the non-duplication of efforts and a reduction in their workload.

It is important to mention that the benefit granted by the PPH Pilot Program does not relieve the applicant of its obligations under the patent law of the country in which the accelerated examination request is entered, and that the program is a system which is compatible with the PCT.

PPH Pilot Program will run for a period of 3 years and may be extended for another year. During this trial period, the countries which are part of the agreement will evaluate its results in order to determine when and how the program should be fully implemented.

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1 Instituto Nacional de Propiedad Industrial (INAPI) in Chile, Instituto Mexicano de Propiedad Industrial (IMPI) in Mexico, Superintendencia de Industria y Comercio (SIC) in Colombia and Instituto Nacional para la Defensa de la Competencia y la Protección de la Propiedad Intelectual (INDECOPI) in Peru. 2 There are exceptions to the application of the substantive examination results in the country of the OLE, for example when the claims presented for examination under PPH include or are referred to matters which are not patentable in that country. Such would be the case for treatment and diagnostic methods for humans and animals in Chile.

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