

**Technical Guidelines of the
PPH Pilot Programme between INPI and the EPO**

The following technical guidelines are established under the Memorandum of Understanding between the National Institute of Industrial Property – Brazil – (INPI) and the European Patent Office (EPO) on the INPI - EPO PPH Pilot Programme:

I. Requirements for requesting participation in the INPI - EPO PPH Pilot Programme

1. In order to be eligible to participate the INPI - EPO PPH Pilot Programme, the following requirements must be met:

1.1. The EP or BR application for which participation in the PPH Pilot Programme is requested and the corresponding application filed with the other Office must have the same earliest date whether this be the priority or filing date.

1.2. The earliest patent application must have been filed under the Paris Convention at INPI or the EPO or, under the PCT at INPI or the EPO as Receiving Office.

1.3. The BR application for which participation in the PPH Pilot Programme is requested must be classified in any of the International Patent Classification subdivisions, or any subdivisions thereunder, specified in Annex 2. This restriction does not apply to the EP application for which participation in the Pilot Programme is requested.

1.4. The corresponding application(s) has/have at least one claim indicated by the Office of Earlier Examination (OEE) to be patentable/allowable in an EPO's "decision to grant" or an INPI's "decisão de deferimento".

1.5. All claims in the application for which a request for participation in the PPH Pilot Programme is made must sufficiently correspond to the patentable/allowable claims in the corresponding application(s). Claims are considered to sufficiently correspond where, accounting for differences due to claim format requirements, the claims are of the same or a similar scope or the claims in the application for which PPH is requested are narrower in scope than the claims in the corresponding application(s). In this regard, a claim that is narrower in scope occurs when an OEE claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). Additionally, a claim in the Office of Later Examination (OLE) application which introduces a new/different category of claims than those indicated to be patentable/allowable by 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 application are not considered to sufficiently correspond if the OLE claims introduce product claims that are dependent on the corresponding process claims.

1.6. Substantive examination of the OLE application for which participation in the INPI - EPO PPH Pilot Programme is requested has not begun.

II. Documents required for participation in the INPI - EPO PPH Pilot Programme

2. For participation in the INPI - EPO PPH Pilot Programme the applicant has to:

2.1. File a request for participation in the INPI - EPO PPH Pilot Programme.

2.2. File a claims correspondence table or where applicable, a declaration of claims correspondence.

2.3. Submit a copy of the “decision to grant” or the “decisão de deferimento”, containing the patentable/allowable claims that are the basis for the PPH request and a translation thereof in one of the official languages of INPI or the EPO.

2.4. Submit a copy of the patentable/allowable claim(s) from the OEE application(s) and a translation thereof in one of the official languages of INPI or the EPO.

2.5. Submit copies of all the documents cited in the office action(s) identified in point 2.3. above. If the cited document is a patent document, the applicant is not required to submit it, unless INPI or the EPO have difficulty in obtaining it, in which case the applicant may be asked to submit it.

2.6. The applicant needs to submit copies of the documents identified in points 2.3. and 2.4. unless these documents have already been filed in the EP or BR application prior to the request for participation in the PPH Pilot Programme, it will not be necessary for the applicant to resubmit these documents with the PPH request. The applicant may simply refer to these documents and indicate in the request for participation in the PPH Pilot Programme when these documents were previously filed in the EP or BR application.

III. Procedures

3.1. The Offices will endeavor to evaluate quickly the request for participation in the PPH INPI-EPO Pilot Programme.

3.2. Where the request for participation in the PPH Pilot Programme is accepted, the application will be processed in an accelerated manner.

3.3. In those instances where the request for participation in the PPH Pilot Programme does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given at least one opportunity to correct deficiencies identified in the request within the time limits provided for under the applicable national/regional law. If the request is not corrected, the application will be taken out of the PPH Pilot Programme and the applicant will be notified.

IV. Evaluation and Modification

4.1. The INPI - EPO PPH Pilot Programme will be evaluated for efficiency and usefulness, once all the patent applications accepted in the programme have been processed.

4.2 The Offices may perform an intermediate evaluation of the INPI - EPO PPH Pilot Programme at any time and in accordance with their own criteria.

4.3. The Offices may exchange information about the intermediary evaluation of the INPI - EPO PPH Pilot Programme and consider publishing the intermediate evaluation results at any time.

4.4. The Offices may modify the conditions, procedures or requirements of the INPI - EPO PPH Pilot Programme by request of either Office and by mutual consent, in writing, based on the evaluation results.

4.5. If the conditions applicable to the INPI - EPO PPH Pilot Programme are modified, these Technical Guidelines and the Offices' respective Guidelines will be amended and published by each Office accordingly.

CLASSIFICATION

The patent applications classified at the following IPC¹ symbols will be able to participate at the PPH INPI-EPO Pilot Programme, unless there is an A61K classification symbol - not under A61K8 - associated with the application (in accordance with the limitations described in Article 3 of this MOU):

	Technical Field	IPC Codes
1	Basic materials chemistry	A01N, A01P, C05#, C06#, C09B, C09C, C09F, C09G, C09H, C09K, C09D, C09J, C10B, C10C, C10F, C10G, C10H, C10J, C10K, C10L, C10M, C10N, C11B, C11C, C11D, C99Z
2	Organic fine chemistry	C07B, C07C, C07D, C07F, C07H, C07J, C40B, A61K8*, A61Q
3	Macromolecular chemistry, polymers	C08B, C08C, C08F, C08G, C08H, C08K, C08L
4	Medical technology	A61B, A61C, A61D, A61F, A61G, A61H, A61J, A61L, A61M, A61N, H05G

*Applications classified as A61K8 can participate in the program provided they have no other symbol of A61K.

¹ “WIPO IPC-Technology Concordance Table” (Table 2) available at http://www.wipo.int/edocs/mdocs/classifications/en/ipc_ce_41/ipc_ce_41_5-annex1.pdf