



The Finnish fast track prosecution for green inventions.

6/6/2023

Motivation

“Intellectual Property Will Play Critical Role in the Achievement of UN Sustainable Development Goals”



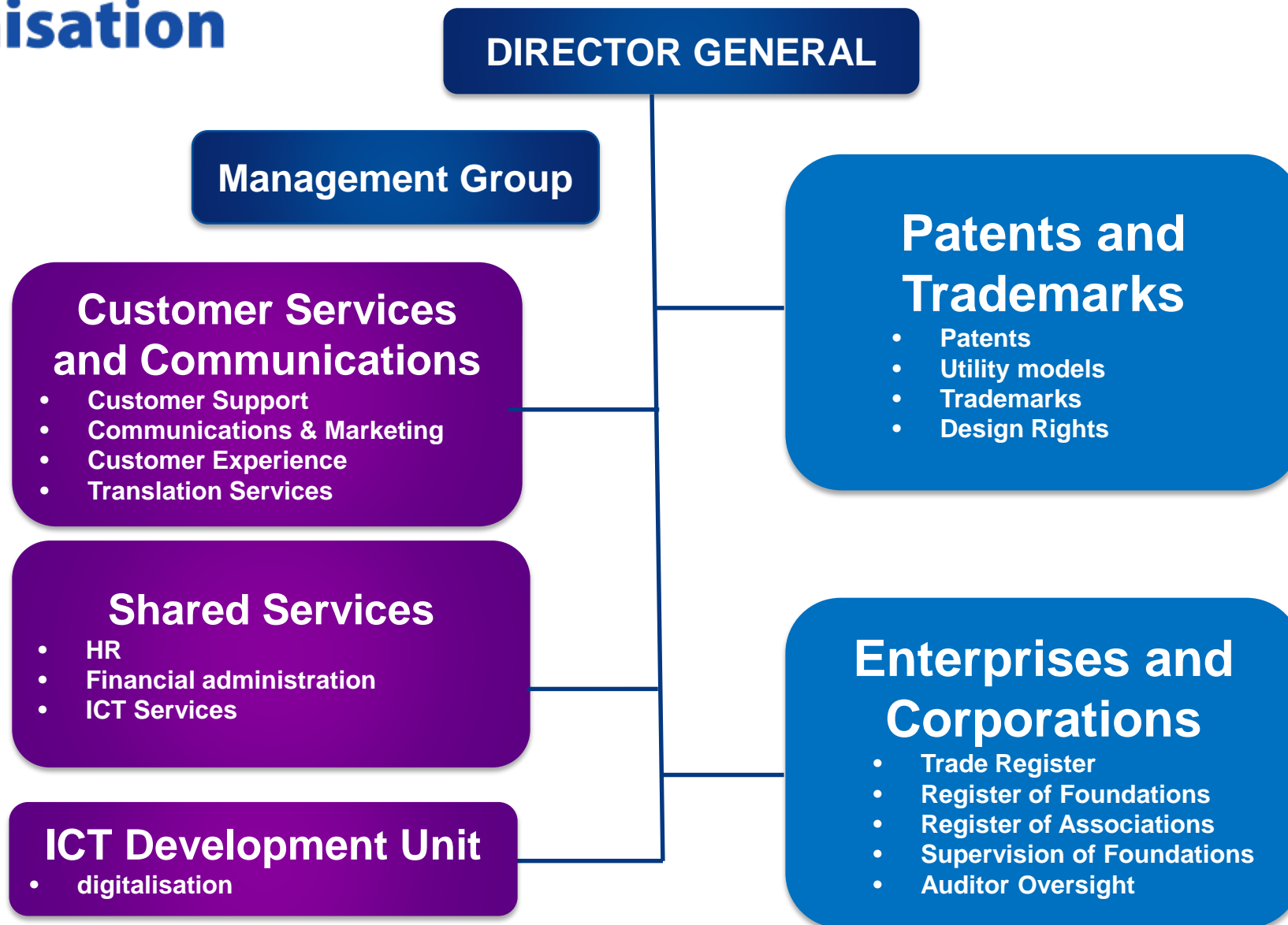
Harsh Truth: Finland is good but not great in green technology

- Green tech is not a Finnish strength but an opportunity.
- Green tech is a priority for all exporting countries in the World at the moment. It can create an illusion that green tech is a natural strength for us. It is not. We have to work hard in order to take our piece of the increasing demand.

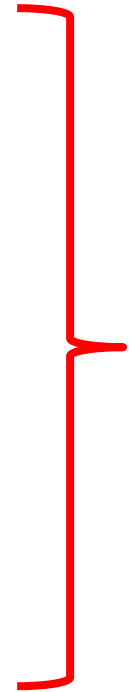
Quotes from Permanent Secretary, Jari Gustafsson,
The Ministry of Economic Affairs and Employment,
28 November 2015

About PRH

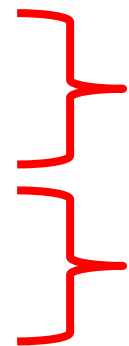
Organisation



Patents and Trademarks
Director Jorma Hanski



Head of Division in each Examination Division
Principal examiner in each examination group
~110 patent examiners in total
Process management by process owner and management group



Quality manager

Legal services
Receiving Office and Formal examination

Our philosophy to support green tech

- 1) One size does not fit all but alternatives are needed
- 2) Green tech is about thinking local and acting global
- 3) Mistakes are expensive but cannot be totally eliminated

Alternatives: Patents and utility models in Finland and going global

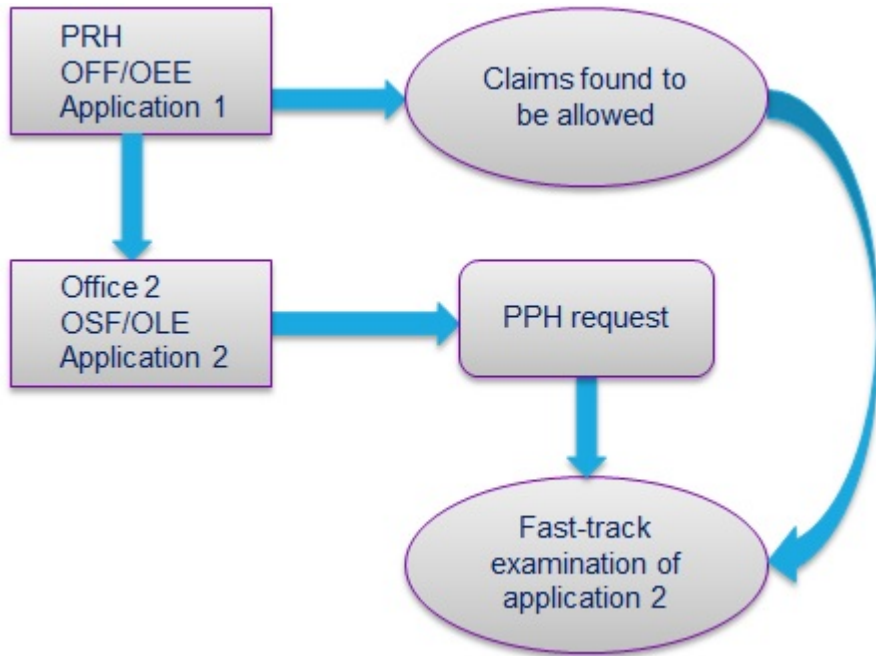
National applications (FI)

- Standard procedure:
 - 1st Office Action (OA1) **in 7 months** from filing date,
 - 2nd Office Action (OA2) and further office actions within a **year** of applicant's reply
- Fast track by request (**Green tech**, PPH aim or specific reason)
 - OA1 within 3 months after the application has proceeded to the technical examination and OA2 within **2 months** of reply
 - Two office action well within the priority year
- All parts of the application and communications can be in Finnish, Swedish or English
 - The applicant is free to choose the language
 - Oppositions and appeals only in Finnish or Swedish

PCT applications

- PRH has acted as an international PCT authority (ISA/IPEA) since 2005
- Search executed with same tools and databases as the European Patent Office, EPO
- To cover the special features of different jurisdictions, PRH searches and examines also non-technical features and unclear claims
- Different examiners for PCT and national priority applications: second search and opinion

Patent Prosecution Highway



The PPH procedure: Application 1 and application 2 must have a relationship. For example, No. 2 may claim priority from No. 1, or it may be a PCT application in the national phase.

Offices implementing PPH

Since the start of the PPH pilot between the JPO (Japan) and the USPTO (USA) in 2006, the number of Offices implementing PPH has increased to as many as 55.

Global PPH participating Offices

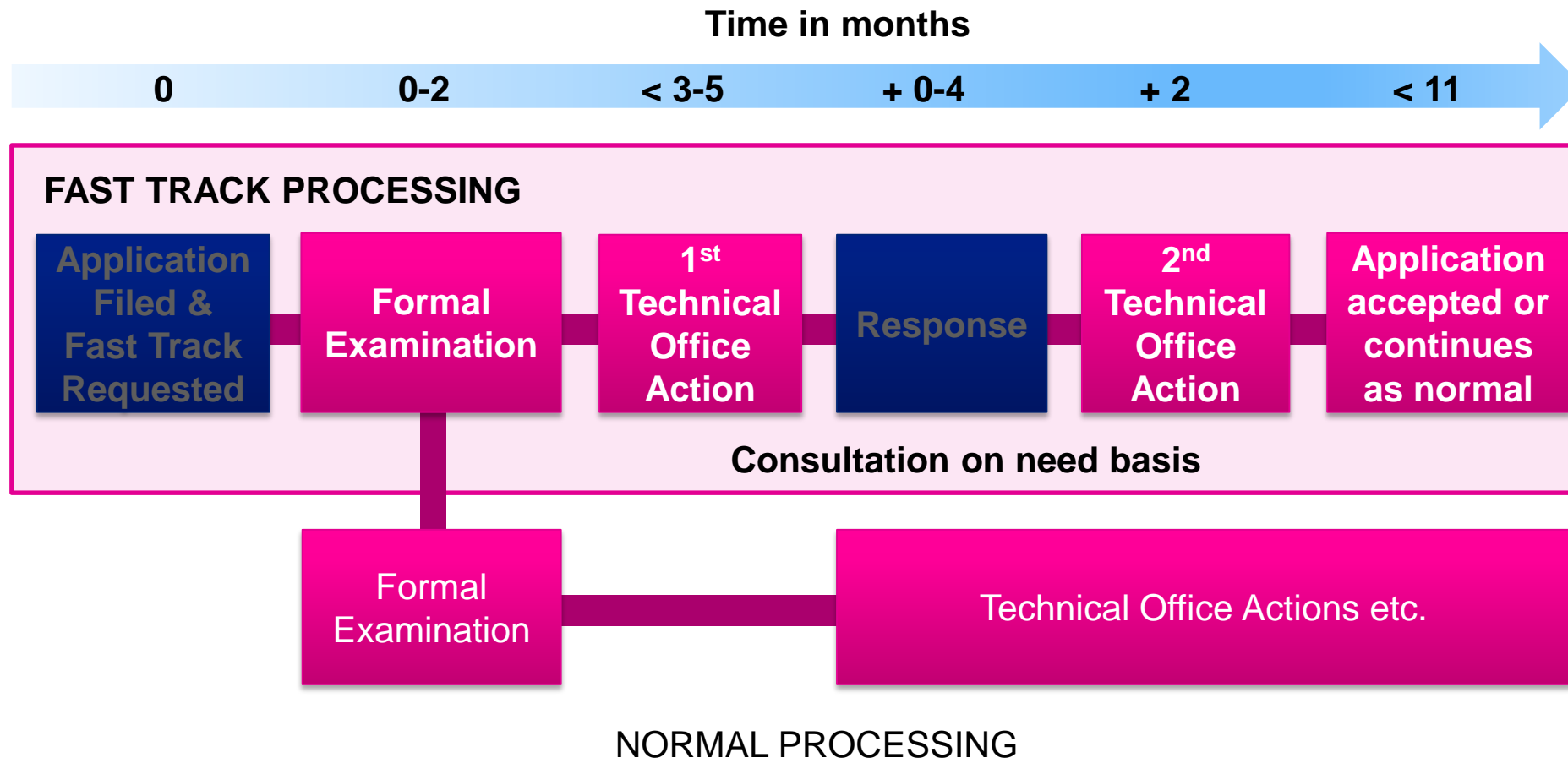


Fast Track process was created in 2015 and updated in 2020

- Old process was rigid and did not take into account different customer needs
- Inventors' transfer rights documents often delayed => drop to normal procedure after 1 month delay
- Fast Track request was accepted within 1 month from filing => caused difficulties to PRH resource planning
- During summer time delivery time of OA2 was 2 months, otherwise 1 month
- Differences to EPO practices (cf. 2 months time to complement documents)

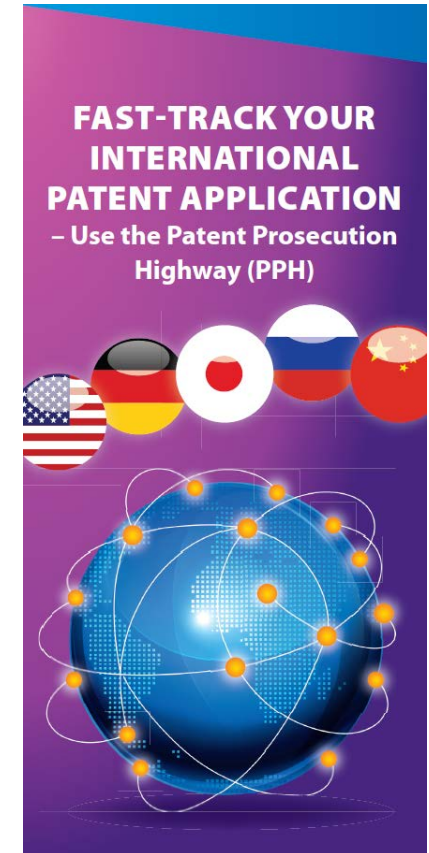


Fast track processing at PRH, effective 1.9.2020



Fast Track in nutshell

- Our premium examination service when Applicant requires positive outcome within the priority year
- Must be requested at the same time as application filed
- OA1 within 3 months after all documents are in order, OA2 within 2 months from the reply to OA1
- Does not cost extra but requests may be discarded due to overload
- Can be complemented with consultation
- Enables at least two Office Actions within the priority year





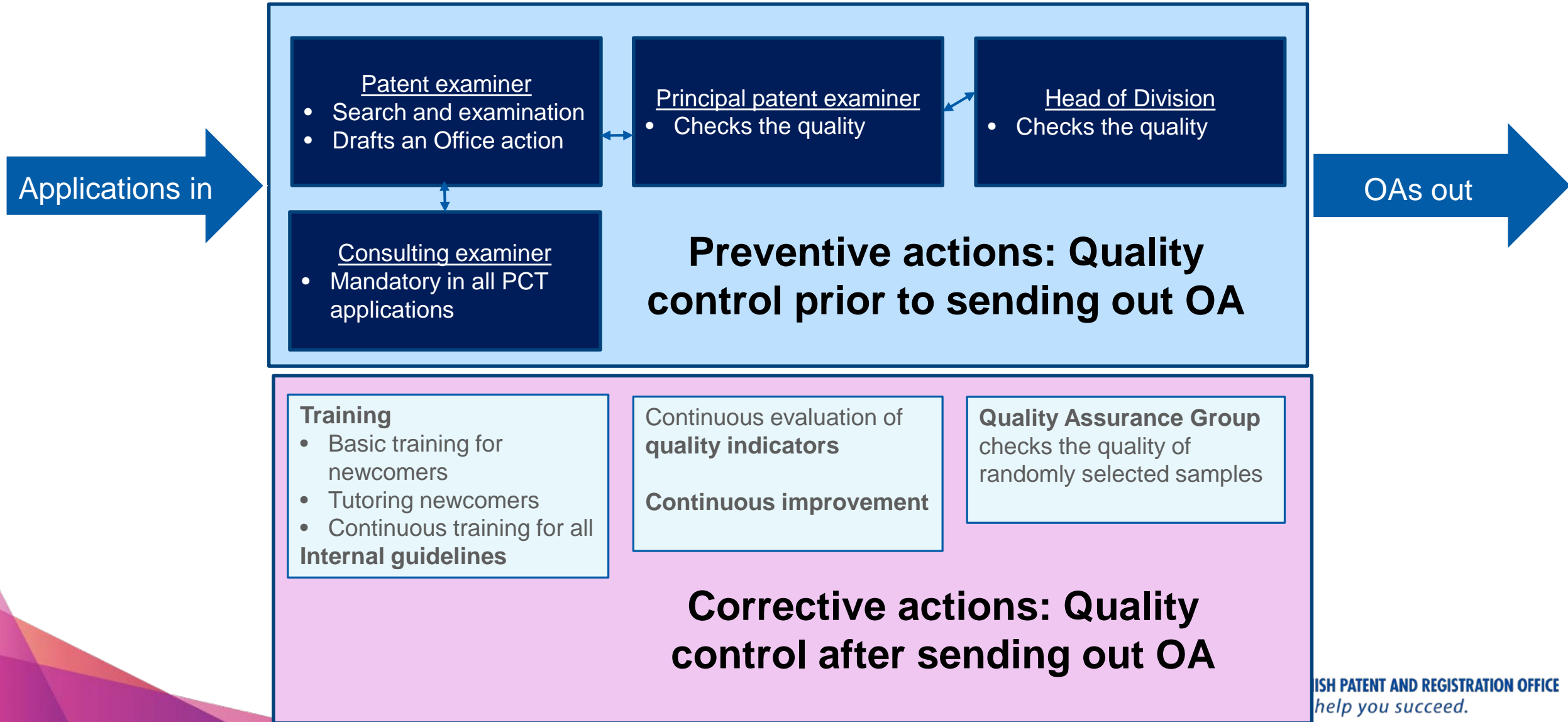
Avoiding mistakes: Quality management

Quality Management System

- Delivery time is a part of quality but being fast is not enough!
- QMS applied to the key processes in the Patents and Trademarks area
 - *handling of patent applications (national, PCT applications, utility models)*
 - *handling of trademark applications*
 - *key support processes, e.g. management, training, ICT*
- QMS established according to ISO 9001 (2015) standard



Quality Control Processes



Quality Assurance Group

- Consists of 10-12 senior examiners (part-time)
- Measures the quality level of searches and examinations on the basis of quality assessment criteria
- Analyses whether the examiner has followed the given quality criteria, quality standards, and guidelines
- Random sampling

Training of newcomers

- Training of new examiners takes about 18 months
 - During this time their work is supervised by a tutor (senior patent examiner)
 - After this they are interviewed and authorized to work independently



Inspecta Sertifiointi Oy

Harmonisation of Search Activities

- The EPO is often the second step along the long road to worldwide fame
 - Special agreement between EPO and PRH
 - For the purposes of harmonising search activities
 - Shall not exceed 50 per year
 - EPO remains responsible carrying out the search under PCT
 - 50 % of the international search fee transferred to PRH
 - Finland has participated three times (2017, 2019, 2021)
- ⇒ Overall, it seems quality at PRH and EPO at the same level
- ⇒ No systemic differences
- ⇒ PRH's internal guidelines and practices already well harmonised with EPO

Input for continuous development

1

Customers' (ever-changing) needs and expectations

- Feedback (online form)
- Customer relations management (KAMs)
- Customer satisfaction surveys
- Discussion panels with patent attorneys etc.
- Complaints

2

Observations, information and feedback from other interest groups

- External audits
- Appeal Court Decisions
- Patent Offices

3

Internal sources

- Quality control reports
- Internal audits
- Quality and performance indicators
- Quality Assurance Group
- Ideas and best practises

Thank you for your attention!

Q&A

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