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

DIRECTOR GENERAL

Management Group

Customer Services and Communications
- Customer Support
- Communications & Marketing
- Customer Experience
- Translation Services

Shared Services
- HR
- Financial administration
- ICT Services

ICT Development Unit
- digitalisation

Patents and Trademarks
- Patents
- Utility models
- Trademarks
- Design Rights

Enterprises and Corporations
- Trade Register
- Register of Foundations
- Register of Associations
- Supervision of Foundations
- Auditor Oversight
Patents and Trademarks
Director Jorma Hanski

Examination Division of Mechanical and Civil Engineering
4 groups

Examination Division of Chemical Technology
4 groups

Examination Division of Physics and Electrical Engineering
3 groups

Examination Division of Information and Communication Technology
3 groups

Trademarks and Designs

Development and IT Systems

Customer Relations and Support Operations

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:
  – 1\textsuperscript{st} Office Action (OA1) \textbf{in 7 months} from filing date,
  – 2\textsuperscript{nd} Office Action (OA2) and further office actions within a \textbf{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 \textbf{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
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.
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

Time in months:

0 
0-2 
< 3-5 
+ 0-4 
+ 2 
< 11

FAST TRACK PROCESSING:
- Application Filed & Fast Track Requested
- Formal Examination
- 1st Technical Office Action
- Response
- 2nd Technical Office Action
- Application accepted or continues as normal

Consultation on need basis:
- Formal Examination
- Technical Office Actions etc.

NORMAL PROCESSING:

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

Applications in

Patent examiner
- Search and examination
- Drafts an Office action

Consulting examiner
- Mandatory in all PCT applications

Principal patent examiner
- Checks the quality

Head of Division
- Checks the quality

OAs out

Preventive actions: Quality control prior to sending out OA

Training
- Basic training for newcomers
- Tutoring newcomers
- Continuous training for all Internal guidelines

Continuous evaluation of quality indicators

Continuous improvement

Quality Assurance Group checks the quality of randomly selected samples

Corrective actions: Quality control after sending out OA

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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
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 practices
Thank you for your attention!

Q&A

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Customer Relations and Support Operations

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