

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

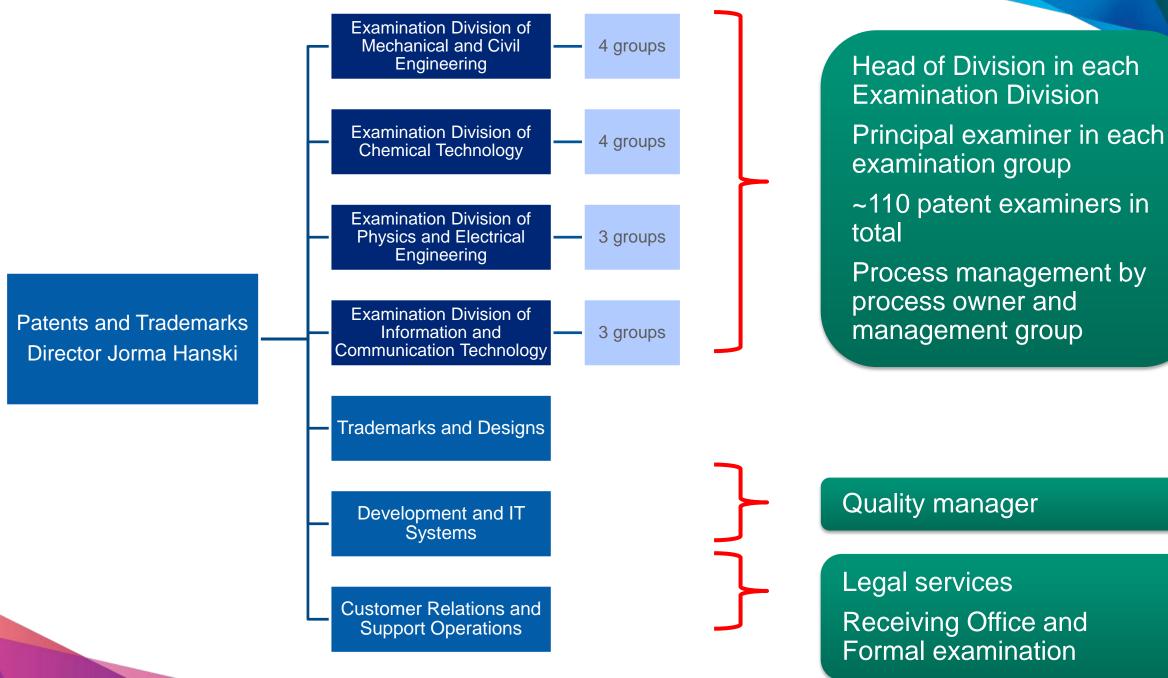
Patents and Trademarks

- Patents
- Utility models
- Trademarks
- Design Rights

Enterprises and Corporations

- Trade Register
- Register of Foundations
- Register of Associations
- Supervision of Foundations
- Auditor Oversight





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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

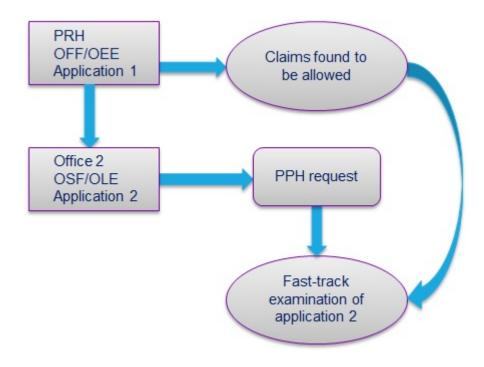
National applications (FI)

- 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.

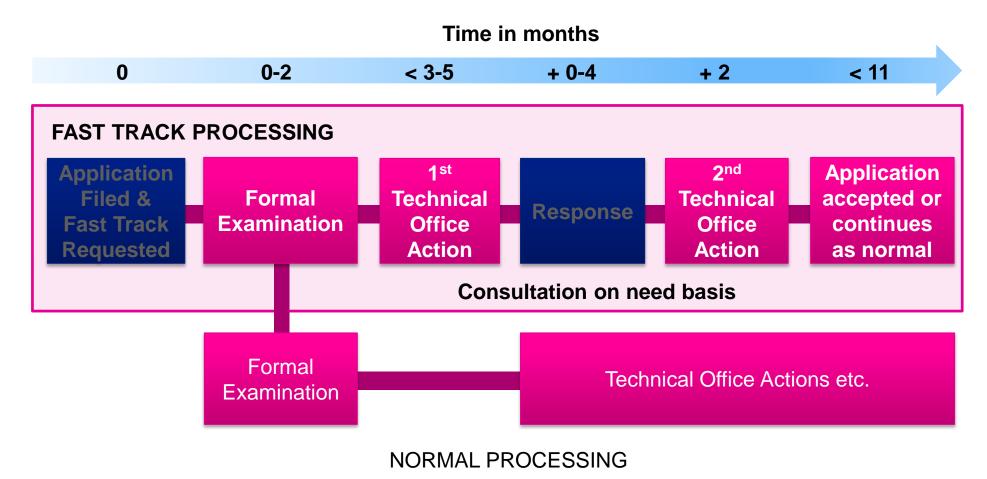


Fast Track process was created in 2015 and updated in 2020

- 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)

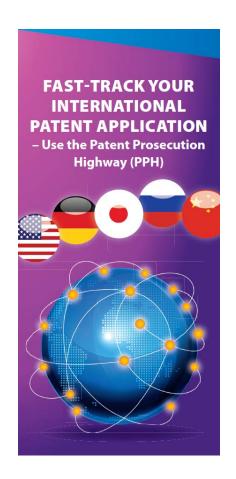


Fast track processing at PRH, effective 1.9.2020



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



THE INTERNATIONAL CERTIFICATION NETWORK

Inspecta Sertificinti Oy as an IQNet Partner hereby states that the organization:

Finnish Patent and Registration Office Helsinki

for the following scope:

Processing of national patent applications and international applications under the Patent Cooperation Treaty (PCT).

has implemented and maintains a

Quality Management System

which fulfils the requirements of the following standard:

ISO 9001:2015

Issued on: 2016-11-15

for the validity date, please refer to the original certificate* issued by Inspecta Sertificanti Oy

Registration Number: FI 4725-06

President of IQNet

Managing Director Inspecta Sertifiointi Oy Inspecta

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^{*} This attestation is directly linked to the ICNet Partner's original certificate and shall not be used as a stand-alone document

Quality Control Processes

Applications in

Patent examiner

- Search and examination
- Drafts an Office action

Principal patent examinerChecks the quality

Head of DivisionChecks the quality

Consulting examiner

Mandatory in all PCT applications

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

OAs out

ISH PATENT AND REGISTRATION OFFICEhelp you succeed.

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



Customers' (everchanging) needs and expectations

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



Observations, information and feedback from other interest groups

- External audits
- Appeal Court Decisions
- Patent Offices



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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