

# Noli IP Newsletter

NOLI IP Solutions, PC

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## *PCT- Patent Prosecution Highway (PPH) Pilot Program & Other Related Programs*

By Sergio Chacon-Hoffmann

In today's prosecution of your PCT international application, you count with additional tools that can expedite the foreign prosecution of your applications by using a number of bilateral

- ✓ the written opinion of the International Searching Authority,
- ✓ the written opinion of the International Preliminary Examining Authority, or

*"These (bilateral) agreements have been signed between patent Offices to promote work sharing and enable patent applicants to request accelerated processing in the national phase, where patent examiners can make use of the work products from the other Office(s)."*

agreements. These agreements have been signed between patent Offices to promote work sharing and enable patent applicants to request accelerated processing in the national phase, where patent examiners can make use of the work products from the other Office(s). These work products can include:

- ✓ the international preliminary examination report issued within the framework of the PCT, subject to certain conditions.

By requesting that their applications be processed under these agreements, applicants can generally obtain a final action more

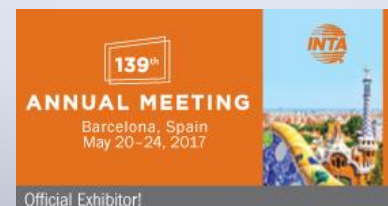
## *INTA 2017 in Barcelona*

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Last night, Ms. Fischer and Ms. Mariana Noli were present at the Pre-INTA Annual Meeting reception in downtown Los Angeles.



We had the opportunity to mingle, network and meet friends, peers and professionals in our field. This 2017 INTA Annual Meeting is particularly exciting for us at Noli IP Solutions, PC. We are an Official Exhibitor at INTA for the very first time. Stop by and visit us at our booth. Nos Vemos en Barcelona!!!



quickly before participating Offices.

Reusing search and examination results in this way facilitates the prosecution of patent applications. The decision about whether to grant a patent, however, remains under the control of the national or regional Offices. Participating Offices are:

- ✓ AT - Austrian Patent Office
- ✓ AU - Australian Patent Office
- ✓ CA - Canadian Intellectual Property Office
- ✓ DE - German Patent and Trademark Office
- ✓ DK - Danish Patent and Trademark Office
- ✓ EE - Estonian Patent Office
- ✓ ES - Spanish Patent and Trademark Office
- ✓ FI - Finnish Patent and Registration Office
- ✓ GB - Intellectual Property Office (UK)
- ✓ HU – Hungarian Intellectual Property Office
- ✓ IL – Israel Patent Office
- ✓ IS – Iceland Patent Office
- ✓ JP – Japan Patent Office
- ✓ KR – Korean Intellectual Property Office

- ✓ NO – Norwegian Industrial Property Office
- ✓ PL – Polish Republic Patent Office
- ✓ PT – National Institute of Industrial Property (Portugal)
- ✓ RU – Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation)
- ✓ SE – Swedish Patent and Registration Office
- ✓ SG – Intellectual Property Office of Singapore
- ✓ US – United States Patent and Trademark Office
- ✓ XN – Nordic Patent Institute

The USPTO is participating in both the Global PPH pilot program and the IP5 PPH pilot program. A list of the other offices currently participating in the Global PPH pilot program is available at [http://www.uspto.gov/patents/init\\_events/pphl](http://www.uspto.gov/patents/init_events/pphl). The European Patent Office (EPO), Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO), and State Intellectual Property Office of the People's Republic of China (SIPO) are participating in the IP5 PPH pilot program.

Brazil, Colombia, Czech Republic, Mexico, Nicaragua, Philippines, Romania and Taiwan have bilateral agreements that can assist your national phase applications.

Please note these are not all the agreements in place. The United States Patent and Trademark Office (USPTO) today benefits from examination decisions made by Patent Offices around the world. Having a **U. S. patent grant** when you begin the filing of national and/or regional phase patent applications is a great resource. In each such country where you file a national application, you must ask if your U. S. granted application can serve as the basis for examination and grant of the patent application you are filing in that country. You will be pleasantly surprised that many patent offices today will accept your U. S. granted patent as the basis for examination reducing considerably the time in which prosecution may be completed on your application. Please let us know if you require any additional information on your particular case.

# European Patent Validation in Morocco

By Judit Marai and Karim Lagobi

We can observe the worldwide tendency of creating more and more unified patent systems where applicants are able to obtain patent protection in multiple countries following only one procedure.



The best examples are the Patent Cooperation Treaty (PCT) and the European Patent Convention (EPC). If you file an application under the EPC, your patent application will automatically designate all the countries that are members of the treaty. But what happens with the non-member countries?

Are they either in or out? And if they are out, is your only option to obtain a patent registration in those countries the national procedure? Most of the

time yes, but there are certain exceptions. A few countries have entered in separate validation agreements with the European Patent Organization, like Morocco on December 17, 2010 (in force since March 01, 2015), to allow European patents (and PCT patents as well) to have the same effect in that particular country as national patents by using a very uncomplicated procedure tied to the basic EPC or PCT application.



Validation is obtained by specifically filing a validation request: it is not automatic, in the same way as the designation for EPC members. After 6 months from the date when the search report is mentioned (in case of a PCT application 31 months from the application, or 6 month from the date when the

search report is mentioned, whichever is later) the validation fee must be paid or the validation request is deemed to be withdrawn. The procedure and the effects of the validation are governed by the Moroccan law, the European Union is merely the basis of it. The validated application is equivalent with a national application. The applicant has to file the documents translated in either Arabic or French, and the renewal has to meet the national requirements as well.

Besides Morocco, the Republic of Moldova, Tunisia and Cambodia entered validation agreements but only in the Republic of Moldova has entered in force.

Please feel free to contact us if you have any additional questions or need more information about the possibility of filing a patent protection in Morocco through the European Patent Office. Feel free to email Ms. Judit Marai at [judit@noli-ipsolutions.com](mailto:judit@noli-ipsolutions.com) or Mr. Karim Lagobi at [karim@noli-ipsolutions.com](mailto:karim@noli-ipsolutions.com)