




---



---

## **Procedures to File a Request to the Korean Intellectual Property Office for Patent Prosecution Highway Pilot Program between the Korean Intellectual Property Office and the National Institute of Industrial Property of Brazil**

---



---

period.

### **I. Purpose of this document**

This document aims to publicize the requirements and necessary documents for requesting participation in the Patent Prosecution Highway (PPH) pilot program between Korean Intellectual Property Office (KIPO) and National Institute of Industrial Property of Brazil (INPI) at KIPO in order that an applicant is able to easily file a request for preferential examination under the PPH pilot program.

When an applicant files a request for preferential examination under the PPH pilot program to KIPO based on examination results by INPI as Office of Earlier Examination (OEE), the PPH request should meet the requirements described in the below paragraph III.

### **II. Trial Period for the PPH Pilot Program**

The PPH pilot program will be in effect for two (2) years commencing on April 1, 2020 and will end on March 31, 2022. The offices will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial

### **III. Procedures to File a Request for Preferential Examination under the PPH Pilot Program**

#### **1. Basic Requirements for Requesting Preferential Examination under the PPH Pilot Program at KIPO**

There are five requirements for requesting preferential examination under the PPH pilot program at KIPO. An applicant must fulfill all five requirements listed below:

**1.1 Both the KIPO application on which PPH is requested and the OEE application(s) forming the basis of the PPH request must have the same earliest date (whether this be a priority date or a filing date).**

The applicant should write the earliest dates for the KIPO application and the OEE application(s) in the request form. See Annex I for examples where the above requirement is satisfied.

**1.2 The corresponding application(s) in INPI has one or more claim(s) determined to be patentable/allowable by INPI**

(1) The patentable/allowable claims of INPI are the claims which are explicitly identified as patentable/allowable in the granted patent publication or in the latest office action by INPI.

(2) Corresponding application in INPI whose claims are determined to be patentable/allowable does not have to be the application for which priority is claimed in the KIPO application (the basic application). The INPI application can be an application explicitly derived from the basic application, e.g., a divisional application of the basic application, a converted application of the basic application or an application which claims domestic priority to the basic application (Refer to Example D and H in Annex I).

*[Note]*

Where the INPI application that contains the patentable/allowable claims is not the same application for which priority is claimed in the KIPO application, applicant must identify the relationship between the INPI application that contains the patentable/allowable claims and the INPI priority application claimed in the KIPO application.

**1.3 All claims in KIPO must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims determined to be patentable/allowable in INPI.**

(1) Claims are considered to “sufficiently correspond” where the claims in KIPO are the same or substantially same as the claims in INPI, or have additions or further limitations of specific features resulting that

the claims in KIPO fall within the scope of the claims in INPI.

A claim in KIPO which introduces a new/different category of claims to those claims indicated as allowable in INPI is NOT considered to sufficiently correspond. For example, the INPI claims only contain claims to a process of manufacturing a product, then the claims in KIPO are not considered to sufficiently correspond if the KIPO claims introduce product claims that are dependent on the corresponding process claims.

(2) It is not necessary to include “all” claims determined to be patentable/allowable in INPI in an application in KIPO (the deletion of claims is allowable). For example, in the case where an application in INPI contains 5 claims determined to be patentable/allowable, the corresponding application in KIPO may contain only 3 of these 5 claims.

Refer to Annex II for the cases which are considered to “sufficiently correspond” and the cases which are not considered to “sufficiently correspond”.

**1.4 Whether examination of the KIPO application has begun or not, it is possible to participate in the PPH program**

It is possible to participate in the PPH not only when examination has not begun, but also when examination has already begun, provided that there has been no first office action at the time the PPH request is submitted.

**1.5 A “Request for examination” must have been filed by the applicant in order to request the preferential examination under the PPH.**

The request for preferential examination under the PPH must also be accompanied by, or preceded by a request for examination.

## **2. Document Necessary to File a Request for Preferential Examination under the PPH Pilot Program at KIPO.**

Applicant must submit a “Request Form for Accelerated Examination” and “The Explanation of Request for Accelerated Examination under the PPH”. The documents 2.1 to 2.4 below must be submitted by attaching them to “The Explanation of Request for Accelerated Examination under the PPH”. Please refer to the ANNEX III for “Request Form for Accelerated Examination” and “The Explanation of Request for Accelerated Examination under the PPH”.

### **2.1 A Copy and translation of all claims determined to be patentable/allowable by INPI**

(1) An applicant who requests participation in the PPH is required to submit the copy of the claims determined to be patentable/allowable in INPI.

The copy of the claims determined to be patentable/allowable by INPI might be either:

i) a copy of the document submitted at initial filing which includes claims determined to be patentable/allowable where no later amendments to the claims have been made, or

ii) a copy of the amendments which includes claims determined to be patentable/allowable where later amendments to the claims have been made, or

iii) a copy of INPI’s publication of the granted patent.

(2) Korean or English is acceptable as a translation language. If it is impossible for the examiner to understand the translated claims due to inadequate translation, the examiner can request the applicant to resubmit translations. It is noted that a request for the PPH is not rejected on the basis that the translation is not sufficient to understand the scope of the claims.

### **2.2 Copies and translation of all office actions in INPI**

(1) An applicant who requests participation in the PPH is required to submit copies of the office actions in INPI.

“Office action” means documents which relate to examination and which were sent to an applicant from the INPI examiner.

The office actions in INPI are communications of the examiner such as the final decision to grant a patent, or the most recent non-final office action or a decision of rejection issued on the patent application, however, which indicates that any claim or claims are allowable.

(2) Korean or English is acceptable as a translation language. If it is impossible for the examiner to understand the translated office actions due to inadequate translation, the examiner can request the applicant to resubmit translations. It is noted that a request for the PPH is not rejected on the basis that the translation is not sufficient to understand the scope of the office actions.

### **2.3 Documents cited by the INPI examiner**

(1) The documents to be submitted are

those cited in the office action in the reason of refusal in INPI. Documents which are only referred to as references and consequently do not take part of the reason for refusal do not have to be submitted.

(2) If the cited document is a patent document, applicant does not have to submit it because it is usually available to KIPO. However, if the cited document is non-patent literature, applicant will have to submit it.

*[Note]*

In the case where the KIPO examiner has difficulty in obtaining the document, it will ask the applicant to submit it. In every case, translations of the cited documents are not required.

#### **2.4 Claim correspondence table**

(1) An applicant must submit a claim correspondence table to explain the correspondence of claims determined to be patentable/allowable in INPI and all claims in KIPO.

(2) An applicant must explain how all claims in the KIPO application sufficiently correspond to the patentable/allowable claims in the INPI application in the table for each KIPO claims based on the criteria in "III.1.3 All claims in KIPO must sufficiently correspond to one or more of those claims determined to be patentable/allowable in INPI" (Also refer to Annex II for the examples of the claim correspondence).

### **3. Fee for Participation in the PPH**

An applicant must pay the fee for preferential examination under the PPH same as other request for preferential examination.

### **4. Notes on Examination Procedures**

KIPO decides whether the application can undergo preferential examination under the PPH when it receives a request along with the documents stated above. When KIPO decides that the request is acceptable, the application is assigned a special status for a preferential examination under the PPH.

KIPO will not notify the applicant of the acceptance for assigning a special status for preferential examination under the PPH, but instead applicant may recognize it by the reception of an office action resulting from preferential examination.

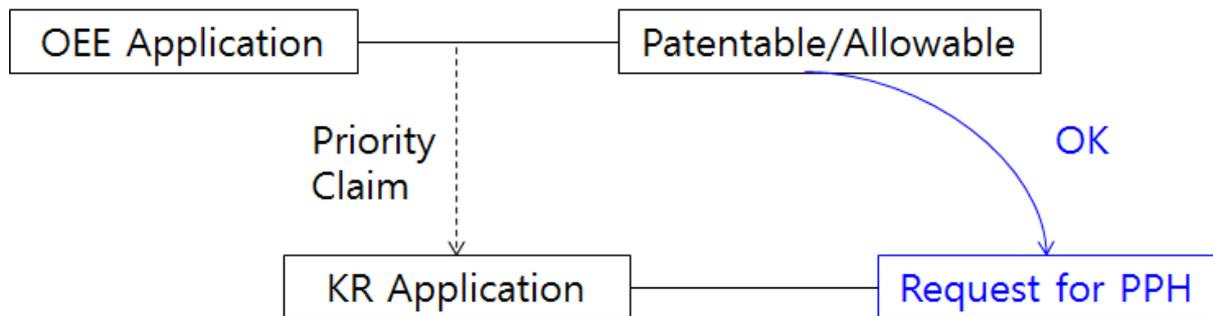
In those instances where the request does not meet all the requirements set forth above, applicant will be notified and the defects in the request will be identified. Applicant may be given opportunity to perfect the request or may be required to submit a new request. If the PPH request is rejected, the applicant will be notified and the application will await examination in its regular turn.

## ANNEX I

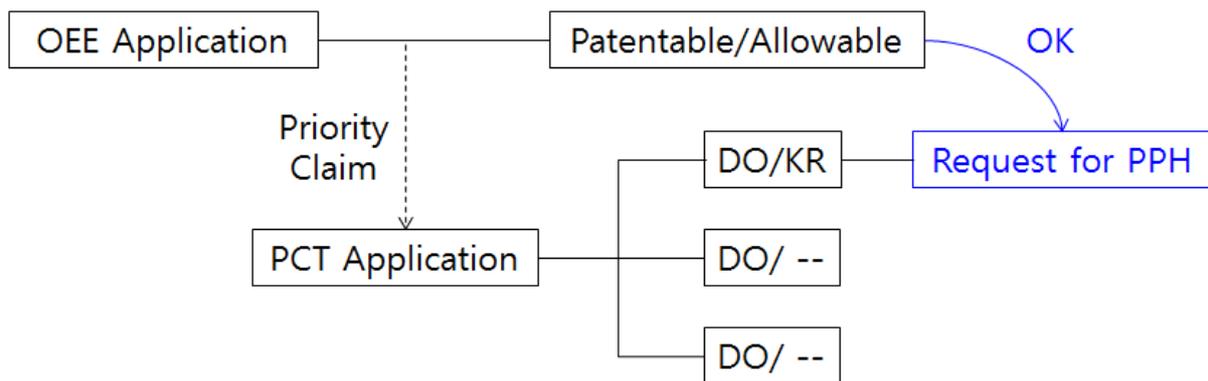
### Examples of KIPO application eligible for the PPH

#### CASE I (Figure A, B, C and D)

KIPO application which validly claims priority under the Paris Convention from the OEE application(s).

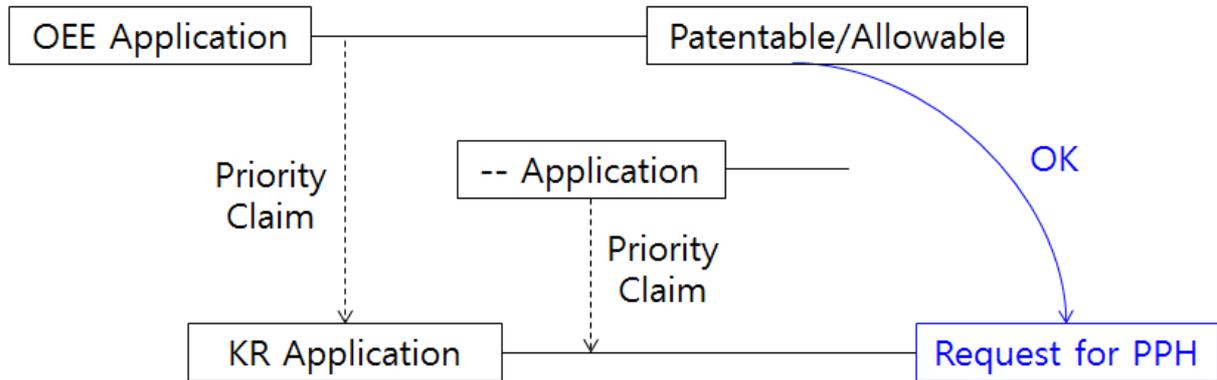


(A) Paris route



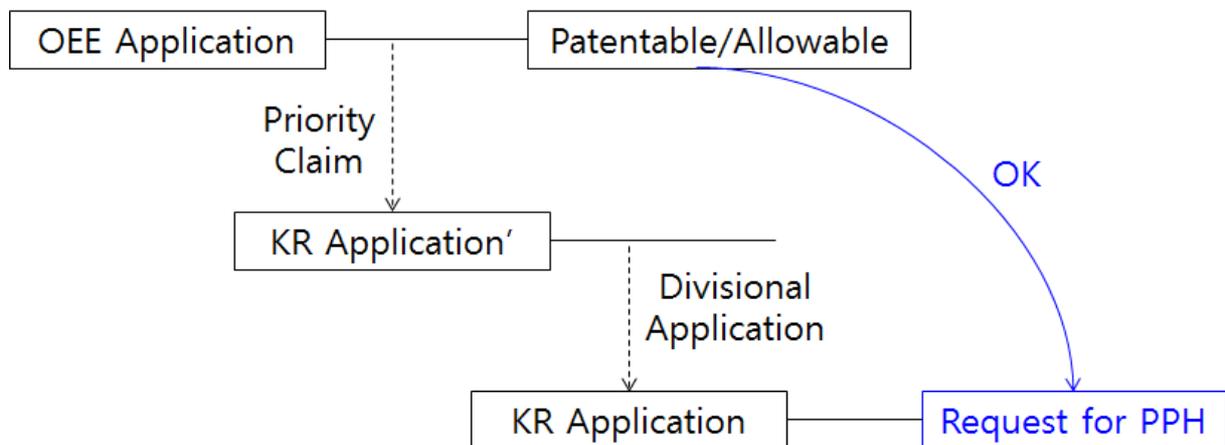
-- : Any office

(B) Paris route and PCT route



-- : Any office

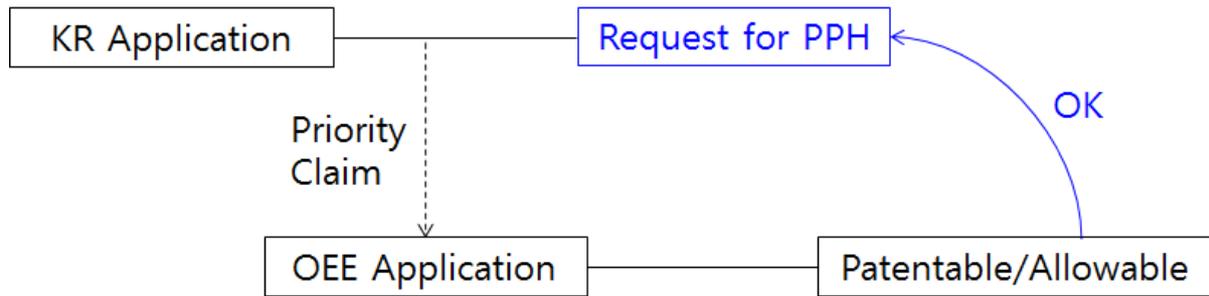
(C) Paris route and complex priority



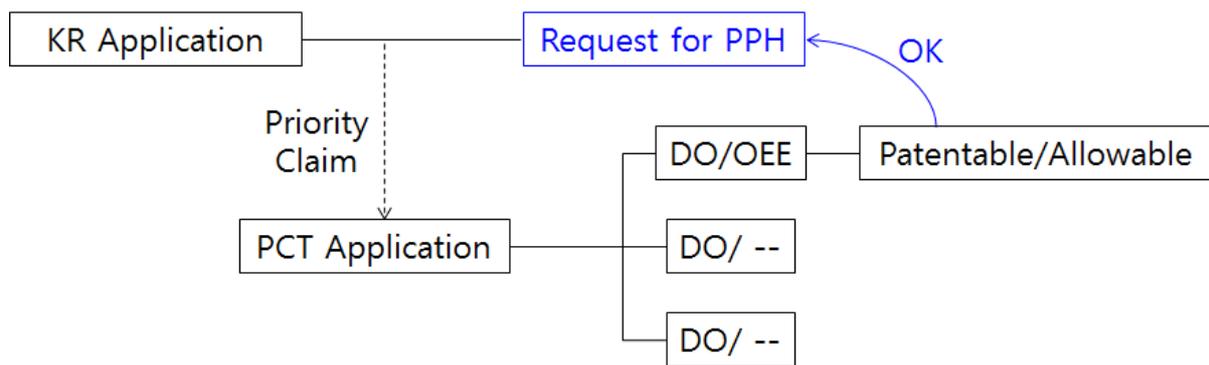
(D) Paris route and divisional application

### CASE II (Figure E and F)

KIPO application which provides the basis of a valid priority claim under the Paris Convention for the OEE application(s) (including PCT national phase application(s)).



(E) Paris route

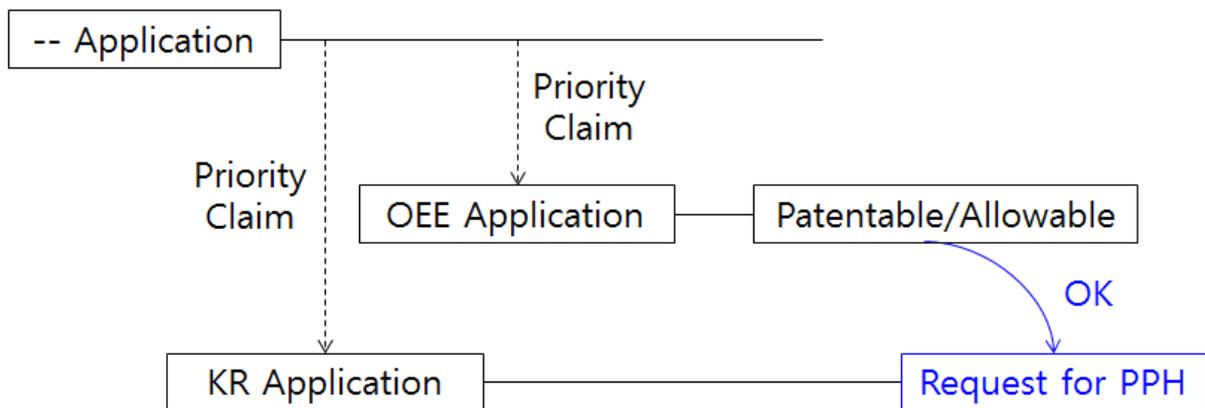


-- : Any office

(F) Paris route and PCT route

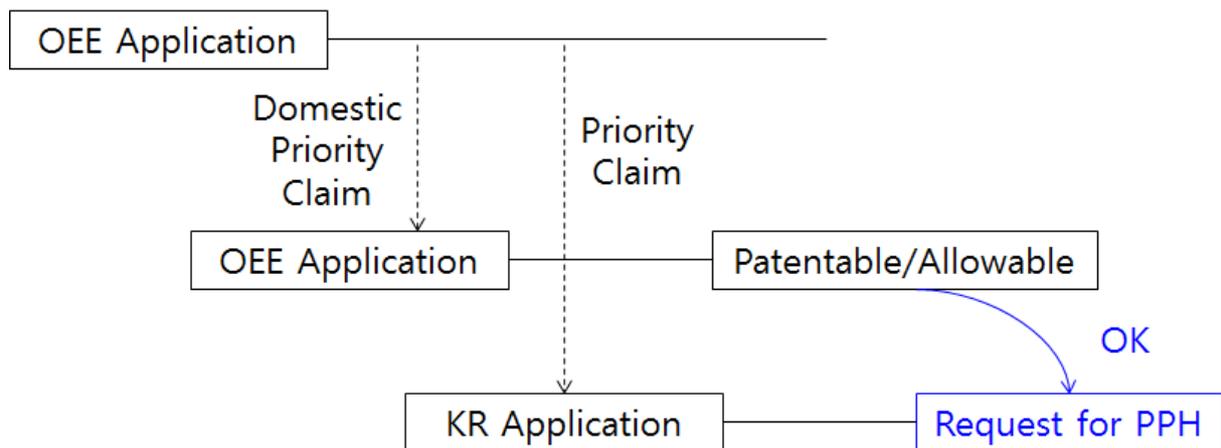
**CASE III (Figure G, H, I, J, K, L and M)**

KIPO application which shares a common priority document with the OEE application(s) (including PCT national phase application(s)).

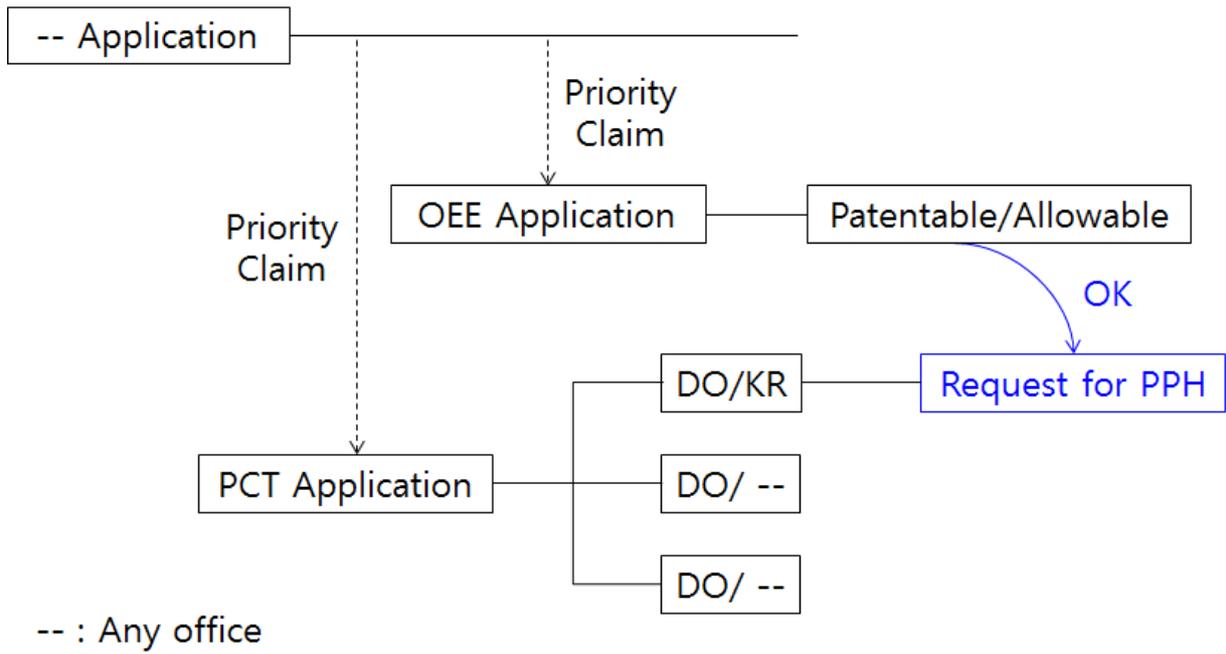


-- : Any office

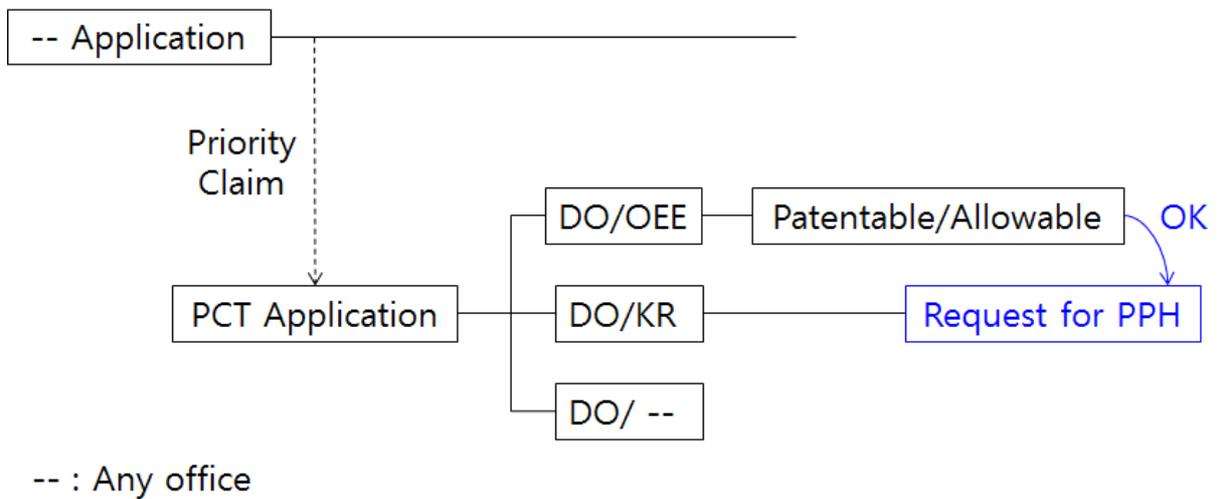
(G) Paris route, but the first application is from the third country



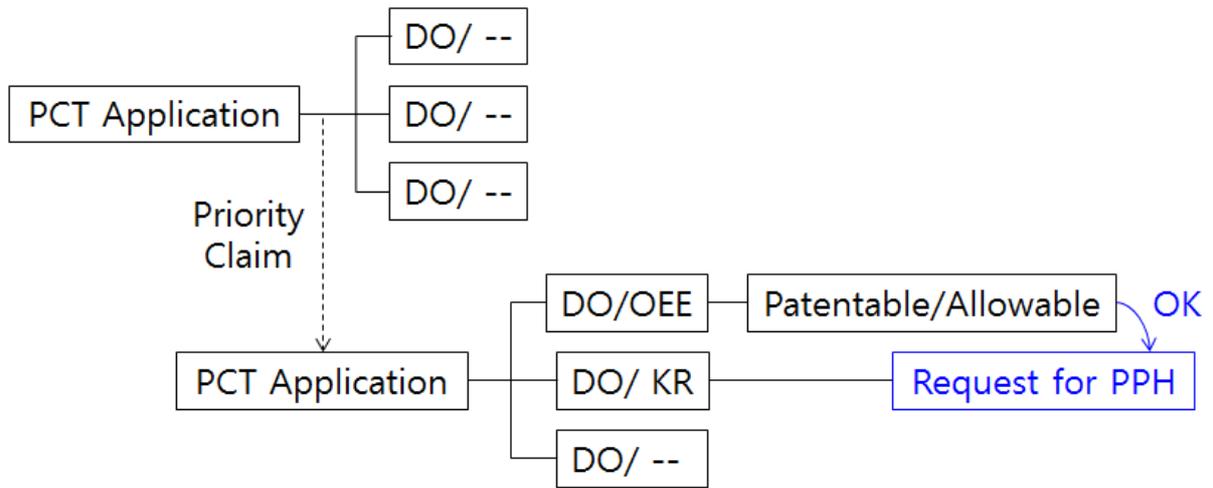
(H) Paris route and domestic priority



(I) Paris route and PCT route, but the first application is from the third country.

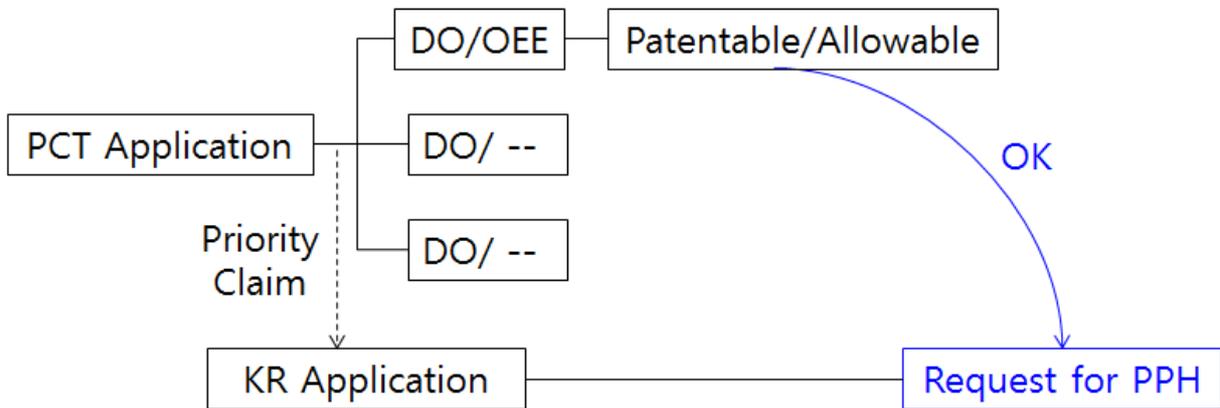


(J) PCT route



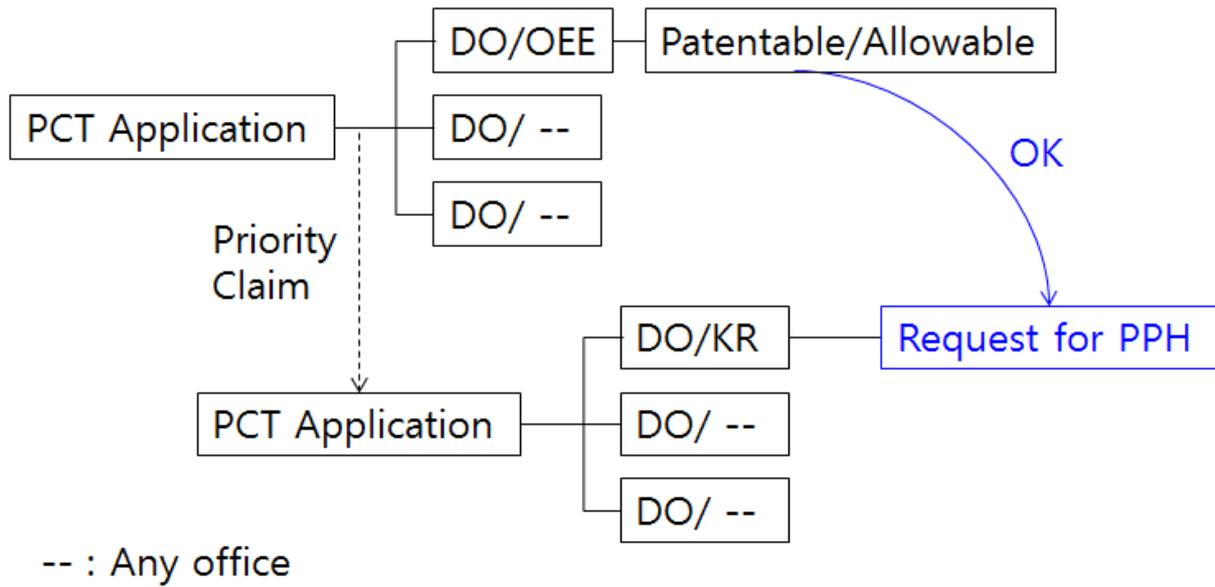
-- : Any office

(K) Direct PCT route and PCT route



-- : Any office

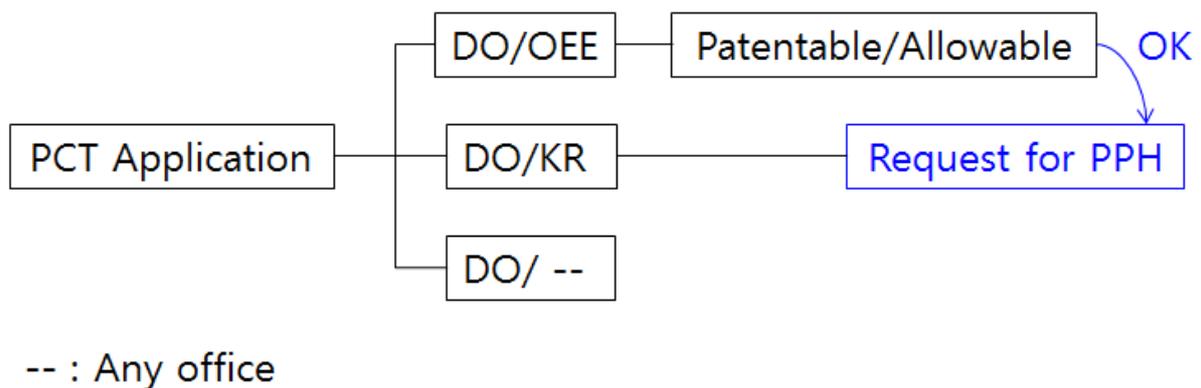
(L) Direct PCT route and Paris route



(M) Direct PCT route and PCT route

### CASE IV (Figure N)

A PCT national phase application where both the KIPO application and the OEE application(s) are derived from a common PCT international application with no priority claim.



(N) Direct PCT route

## ANNEX II

### Examples for the claim correspondence

1. The claims in the following cases (case 1 to case 4) are considered to “sufficiently correspond” to each other.

Case	INPI claim(s)		KIPO claim(s)		Correspondence
	Claim	Subject matter	Claim	Subject matter	
Case 1	1	A	1	A	The same as INPI claim 1.
Case 2	1	A	1 2	A A+a	The same as INPI claim 1. Dependent claim 2 in the KIPO claim is created by adding an element to the INPI claim.
Case 3	1 2 3	A A+a A+b	1 2 3	A A+b A+a	The same as INPI claim 1. The same except for claim format. The same except for claim format.
Case 4	1	A	1	A+a	Claim 1 has an additional element ‘a’.

\* Where “A” is the subject matter, and “a” and “b” are the additional technical features which are supported in the description

2. The claims in the following cases (case 5 and case 6) are NOT considered to “sufficiently correspond” to each other.

Case	INPI claim(s)		KIPO claim(s)		Explanation
	Claim	Subject matter	Claim	Subject matter	
Case 5	1	A system	1	A' method	The claimed invention of the KIPO application is a method, whereas the claimed invention of the INPI application is a system. (The technical features in the INPI claim are the same as those in the KIPO claim, but categories of both inventions are different)
Case 6	1	A+B	1	A+C	The KIPO claim is different from the INPI granted claim in a component of the claimed invention. (The KIPO claim is created by altering part of the technical features of the INPI claim)

## ANNEX III

### Example form of “Request for Accelerated Examination under the Patent Prosecution Highway”

【서류명】 심사청구(우선심사신청)서 (Form of Request for Accelerated Examination)

【구분】 우선심사신청 (Request for Accelerated Examination)

【제출인】 (Subscriber)

【명칭】 (Name)

【출원인코드】 (Subscriber ID)

【사건과의 관계】 (Relation)

【대리인】 (Agent)

【성명】 (Name)

【대리인코드】 (Agent ID)

【포괄위임등록번호】 (Mandating Registration ID)

【사건의 표시】 (Application)

【출원번호】 (Application Number)

【발명의 명칭】 (Title)

【수수료】 (Fee)

【우선심사 신청료】 (Fee for Accelerated Examination)

【수수료 자동납부번호】 (Automated Fee Transfer ID)

【취지】 (Purpose)

【첨부서류】 (Attachment) (Explanation of Request for Accelerated Examination under the Patent Prosecution Highway)

【서류명】 특허심사하이웨이(PPH)에 의한 우선심사신청설명서

(Explanation of Request for Accelerated Examination under the Patent Prosecution Highway)

【대상국가등】 (Office of Earlier Examination; OEE)

【본원출원번호】 (Application Number)

【대응출원번호】 (Application Number of Corresponding Application)

【본원출원과 대응출원의 관계】 (Relation of the Corresponding Application)

【제출서류】 (Required Documents)

【특허가능하다고 판단된 특허청구범위】 (Patentable Claims in OEE)

【서류명 및 제출(발행)일】 (Issue Date)

【서류제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

【번역문제출여부】 (Submit Translations, Y/N)

【제출생략 이유】 (Reasons of Exemption for Translations)

【심사관련통지서】 (Office Action in OEE)

【서류명 및 통지일】 (Issue Date)

【서류제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

【번역문제출여부】 (Submit Translations, Y/N)

【제출생략 이유】 (Reasons of Exemption for Translations)

【심사단계에서 인용된 선행기술문헌】 (Prior Arts cited in the Office Action of OFF)

【명칭】 (Title)

【제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

【청구항간 대응관계설명표】 (Claim Correspondence Table)

본원출원의 청구항 번호 (Claim Number)	대응출원에서 특허가능하다고 판단한 청구항 번호 (Claim Number of OEE)	대응관계 설명 (Correspondence)