



Procedures to File a Request to the Korean Intellectual Property Office for Participation in the Patent Prosecution Highway Pilot Program between the Korean Intellectual Property Office and the Danish Patent and Trademark Office

I. Purpose of the Document

This document aims to publicize requirements and necessary documents for requesting participation in the Patent Prosecution Highway (PPH) pilot program at the Korean Intellectual Property Office (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 the Danish Patent and Trademark Office (DKPTO) 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 commenced on March 1, 2009 and will be continued until both Offices notify of any changes to the PPH pilot program.

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 the KIPO

(1) The KIPO application (including a PCT national phase application) is

1) an application which validly claims priority under the Paris Convention to the corresponding DKPTO application (Examples are provided in the Annex I, figure A, B, C, D,

E, F and G) (may include utility model applications filed in the DKPTO – please refer to the Annex I, figure L)

2) a PCT national phase application that contains no priority claims (direct PCT applications) and indicates both the KIPO and the DKPTO as Designated Offices (DO) (An example is provided in the Annex I, figure H), or

3) an application which validly claims priority under the Paris Convention to a PCT application that contains no priority claims. (Examples are provided in the Annex I, figure I, J and K.)

The following KIPO applications are also eligible for the PPH pilot program:

- an application claiming priority to multiple DKPTO applications or PCT applications, or
- a divisional application based on the filed application which is included in 1) to 3) above.

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

(2) The corresponding DKPTO application has at least one claim that is determined to be patentable by the DKPTO.

1) The corresponding DKPTO application should have at least one claim which has been determined to be patentable at the examination stage in the DKPTO. It is noted that the following types of cases are not eligible for PPH: Examination was conducted in the EPO and the patent right was validated in Denmark as a designated state.

2) “Corresponding application in the DKPTO” should not necessarily be interpreted as the application which forms the basis of the priority, but may be the application which derived from the application which forms the basis of the priority; e.g., a divisional application of the application, or an application which claims internal priority to the application.

Note that where the DKPTO application that contains the allowable/patentable claims is not the same application from which priority is claimed in the KIPO application, applicant must identify the relationship between the DKPTO application that contains the allowable/patentable claims and the DKPTO priority application claimed in the KIPO application (eg DKPTO application X that contains the allowable/patentable claims, claims domestic priority to DKPTO application Y, which is the priority application claimed in the KIPO application).

3) Claims clearly identified to be patentable in the latest office action at the examination stage at the DKPTO are able to be a base of a request for a preferential examination under the PPH pilot program, even if the application which include those claims is not granted for patent yet. The following cases will fall within this interpretation: When a DKPTO examiner sends a notification specifying the DKPTO’s intention to grant. The headings for such notifications will be “Godkendelse”.

(3) All claims in the KIPO application must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims indicated as patentable in the DKPTO.

1) Claims shall be considered to sufficiently correspond where, accounting for differences due to translations and claim format, the claims are of the same or similar scope. This means that the claims have a common technical feature which makes the claims patentable over the prior art in the corresponding DKPTO application. The claims must thus be practically the same.

Claims filed to the KIPO which contains additional technical features compared to the claims that the DKPTO have found patentable will be considered to sufficiently correspond to the KIPO claims. This is also illustrated in example 1 below, where the claims are found to sufficiently correspond (it is noted that “OFF” is short for Office of First Filing, whereas “OSF” is short for Office of Second Filing).

Example 1:

<i>KIPO claims (OSF)</i>	<i>DKPTO claims (OFF)</i>	<i>correspondence</i>
<i>1</i>	<i>1</i>	<i>the same</i>
<i>2</i>	<i>1</i>	<i>the KIPO claim 2 has the additional component A on the DKPTO claim1</i>
<i>3</i>	<i>1</i>	<i>the same except for claim format</i>

Dependant claims in the KIPO application which are appended to earlier claims in the DKPTO application corresponding to claims that are indicated as patentable by the DKPTO will also be considered where such claims fall within the scope of the claims indicated as patentable by the DKPTO. This is also illustrated in example 2 below, where the claims are found to sufficiently correspond:

Example 2:

<i>KIPO claims (OSF)</i>	<i>DKPTO claims (OFF)</i>	<i>correspondence</i>
<i>1</i>	<i>1</i>	<i>the same</i>
<i>2</i>	<i>2</i>	<i>the same</i>
<i>3</i>	<i>3</i>	<i>the same</i>
<i>4</i>		<i>dependent claim of claim 3</i>

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

3) When claim(s) are determined to be patentable by the DKPTO by making amendment to claim(s) in the DKPTO application, the claim(s) in the KIPO application should be amended similar way to sufficiently correspond to the patentable claim(s) in the DKPTO application.

(4) Whether examination of the KIPO application for participation in the PPH Pilot program has begun does not affect the eligibility for participation in the PPH pilot program.

In other words, the KIPO application is eligible for preferential examination under the PPH pilot program not only in the case that examination has not begun, but also when examination has already begun.

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

Applicant must submit a request form for preferential examination under the PPH pilot program, “The Explanation of Circumstances Concerning Preferential Examination under the PPH Pilot Program”. The documents that the applicant should attach to “The Explanation of Circumstances Concerning Preferential Examination” are the documents mentioned under section (1), (2), (3) and (4) below.

(1) A table to explain the correspondence of claims which were determined to be patentable in the DKPTO and all claims in the KIPO application

The relation between claims should be described in the table for each KIPO claim. Please see the example shown below in Annex II.

(2) Copies and translations of all office actions in the DKPTO

“Office actions” are documents which relate to substantive examination and which were sent to an applicant from the DKPTO examiner. Both Korean and English are acceptable as translations languages.

In the case where the DKPTO is the OFF, an applicant who requests for PPH to the KIPO as the OSF does not have to submit copies of the office actions when those documents are provided via DKPTO’s database “PVS online <http://onlineweb.dkpto.dk/pvsonline/patent?action=1&subAction=front&language=GB>”. This is due to the fact that the KIPO will be able to retrieve such office actions from PVS online. However, the Korean or English translations of the office actions must be submitted by the applicant in cases where the office actions are not provided in English in PVS online.

When an applicant submits the translations of the office actions, machine translations will be admissible. However, if it is impossible for the examiner to understand the outline of the translated office action(s) due to insufficient translation, the KIPO examiner can request the applicant to submit (or resubmit) translations.

It is noted that the request for PPH is not rejected because the translation is not enough to understand the outline of the translated office action(s).

(3) Copy and translation of claims determined to be patentable in the DKPTO

The Copies of the claims determined to be patentable in the DKPTO might be either copies of the amendments, the document submitted at filing (where no later amendments to the patent claims have been made) which includes claims determined to be patentable, or a copy of the DKPTO’s publication of the granted patent.

The Descriptions in the requirement 2.(2) above regarding the occasions where the applicant will not have to submit copies and translations and regarding machine translation also apply to this requirement 2.(3).

(4) Documents cited by the examiner in the DKPTO

Applicants are required to submit the documents cited by the examiner in the DKPTO. If a cited document is a patent document, applicants do not have to submit it because it is usually available to the KIPO, but in the case where the KIPO has difficulty in obtaining a document,

it will ask the applicant to submit it. In every case, translations of the cited documents are not required.

3. Request form and fee

Applicant must submit a request form for preferential examination under the PPH pilot program, titled “The Explanation of Circumstances Concerning Preferential Examination under the PPH Pilot Program.” Please find the request form attached in the Annex II.

Applicant must submit preferential examination fee same as other request for preferential examination.

4. Notes on examination and notification procedure

KIPO decides whether the application can undergo a preferential examination under the PPH when it receives a request with the documents set forth above. The grant for assigning a special status for preferential examination under the PPH pilot program will not be notified, but instead applicant can 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 will be given opportunity to perfect the request. If not perfected, applicant will be notified and the application will await action in its regular turn.

Where an applicant amends any of the claims of an application before the application undergoes a preferential examination at KIPO under the PPH and the amended claims do not substantially correspond to one or more allowable or patentable claims in the DKPTO application, the applicant is required to submit a comparison table between the amended claims and the documents cited by the examiner in the DKPTO along with the amendments.

ANNEX I

Figure A:

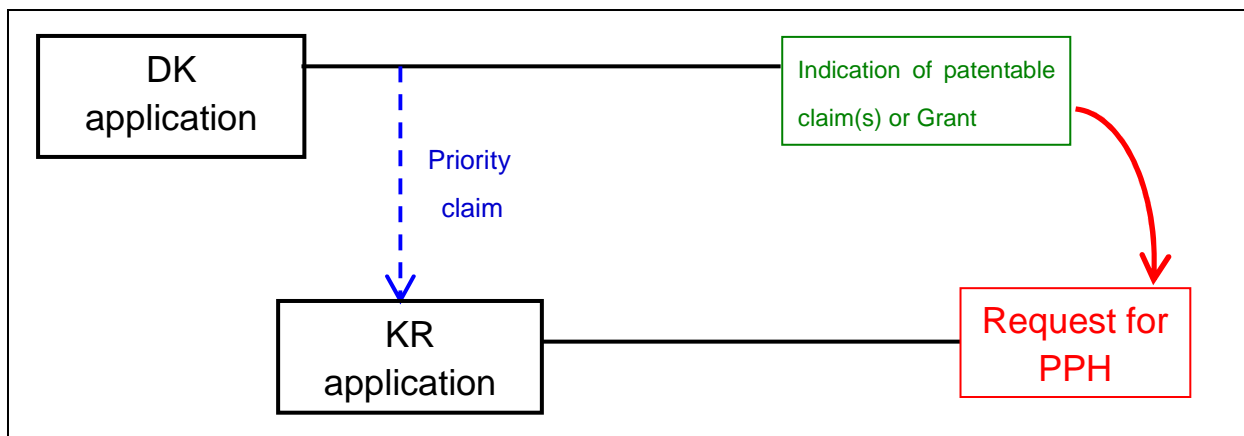
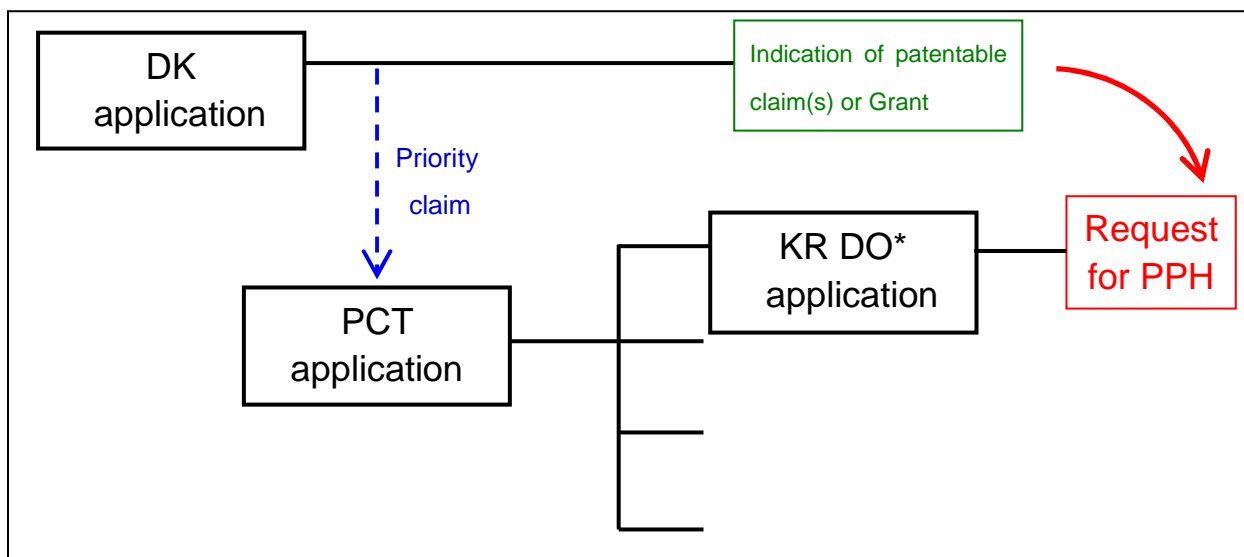


Figure B:



*DO – Designate Office

Figure C:

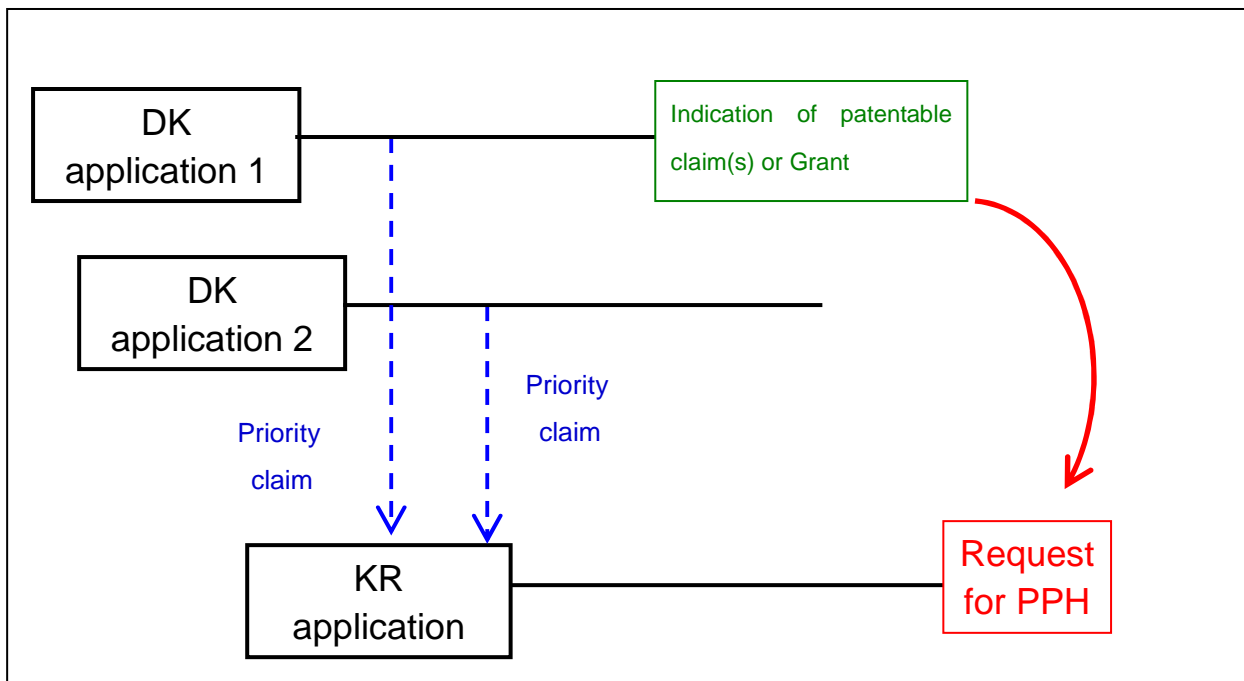


Figure D:

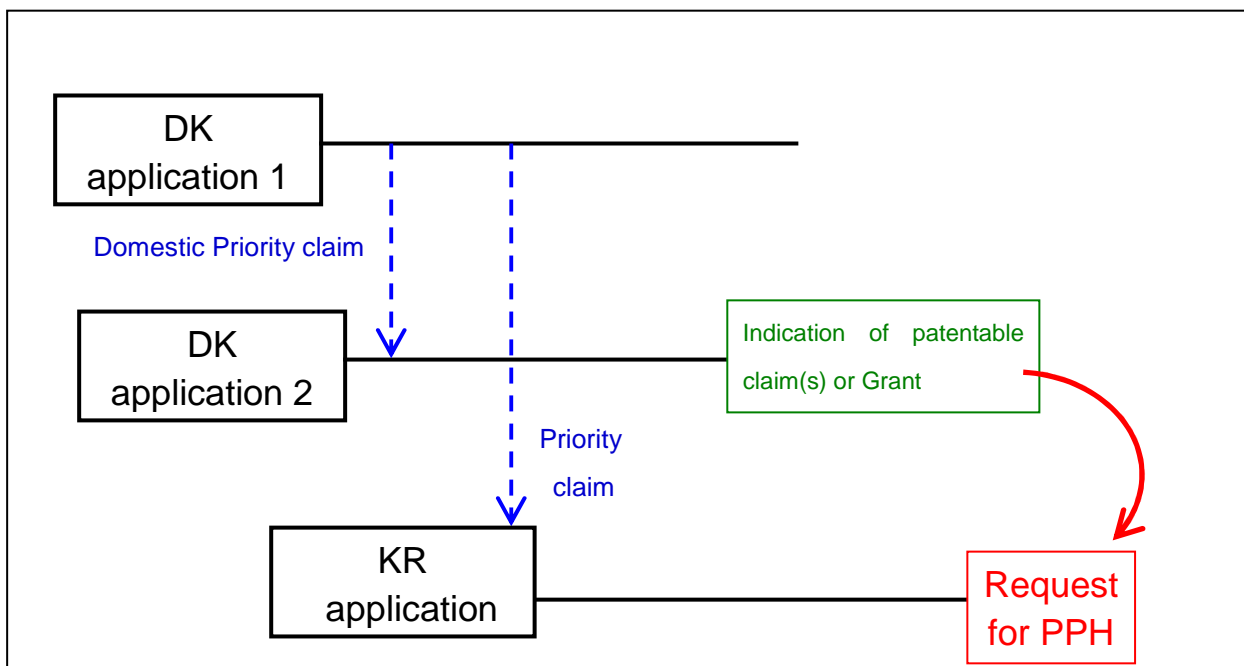


Figure E:

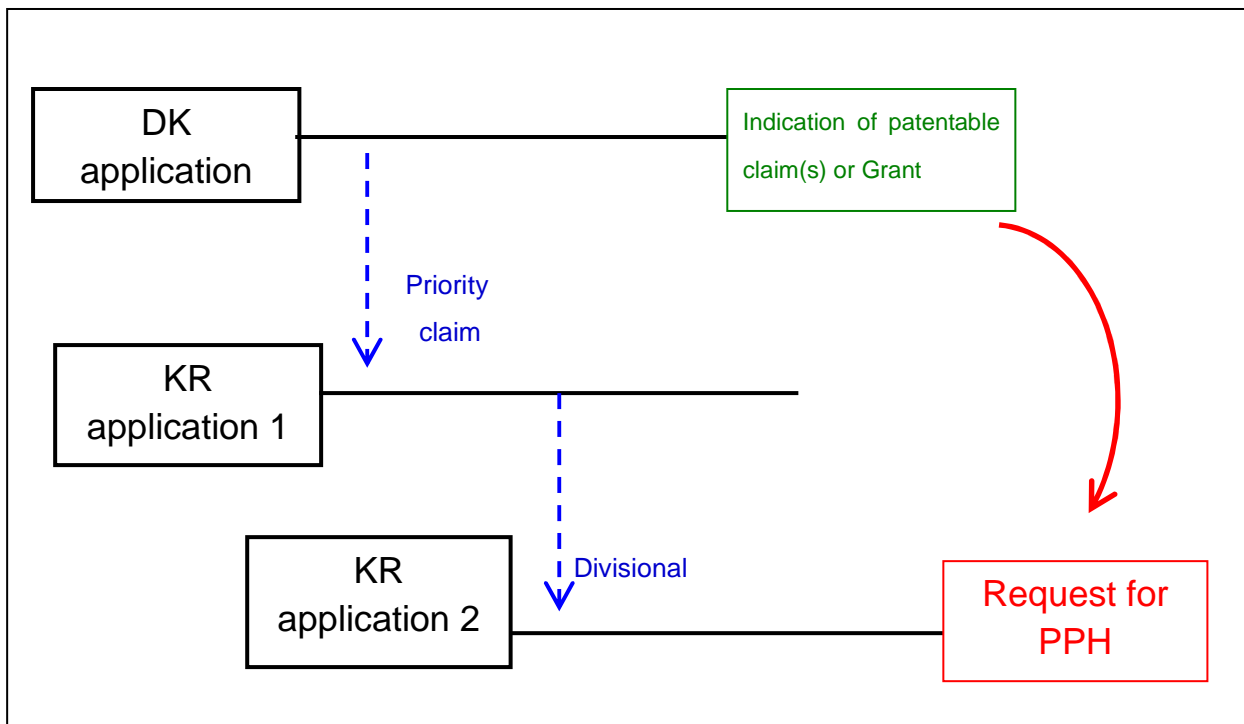
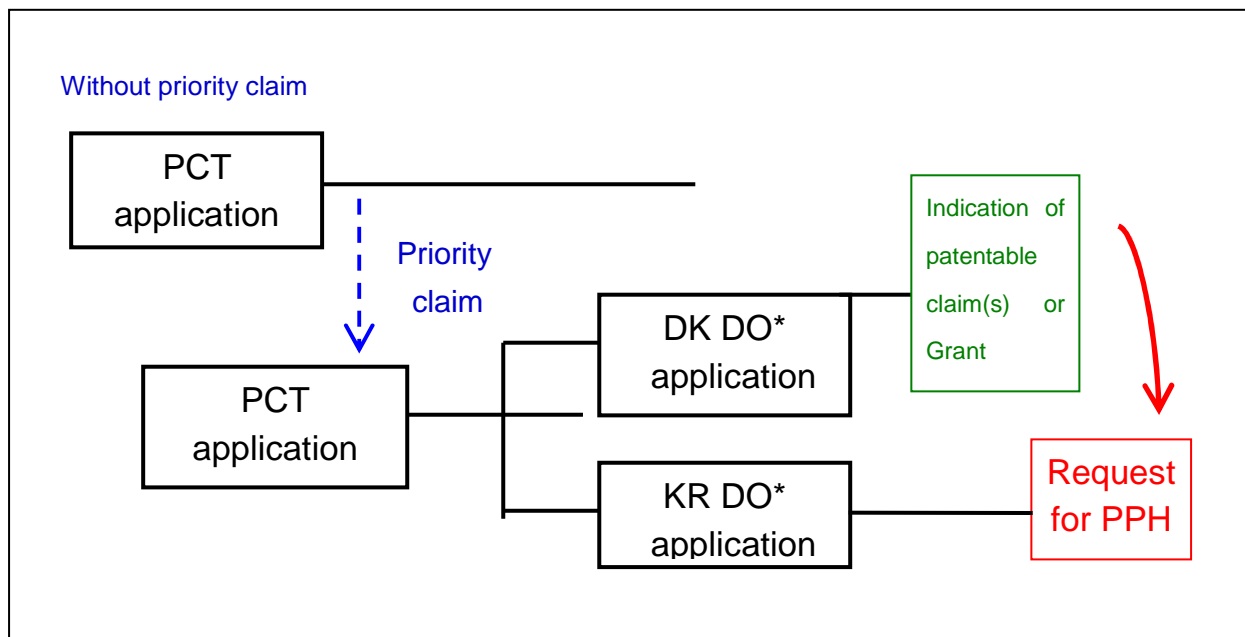


Figure F:



*DO – Designated Office

Figure G:

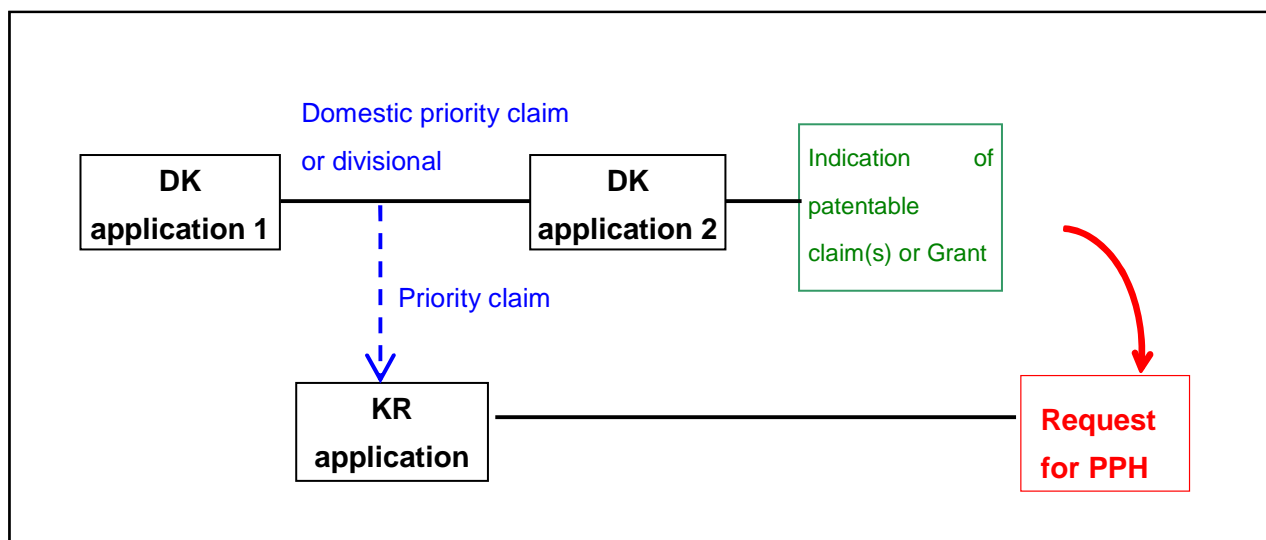
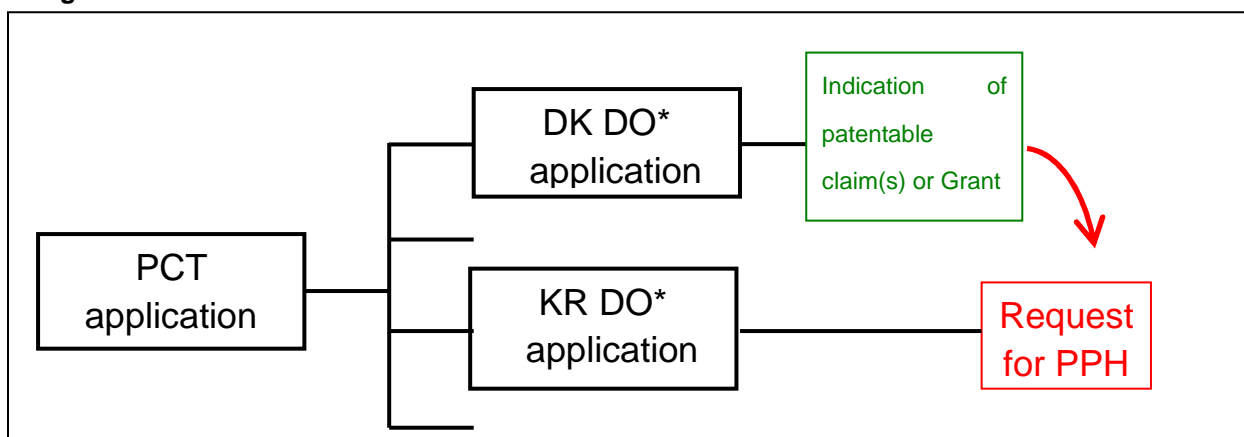
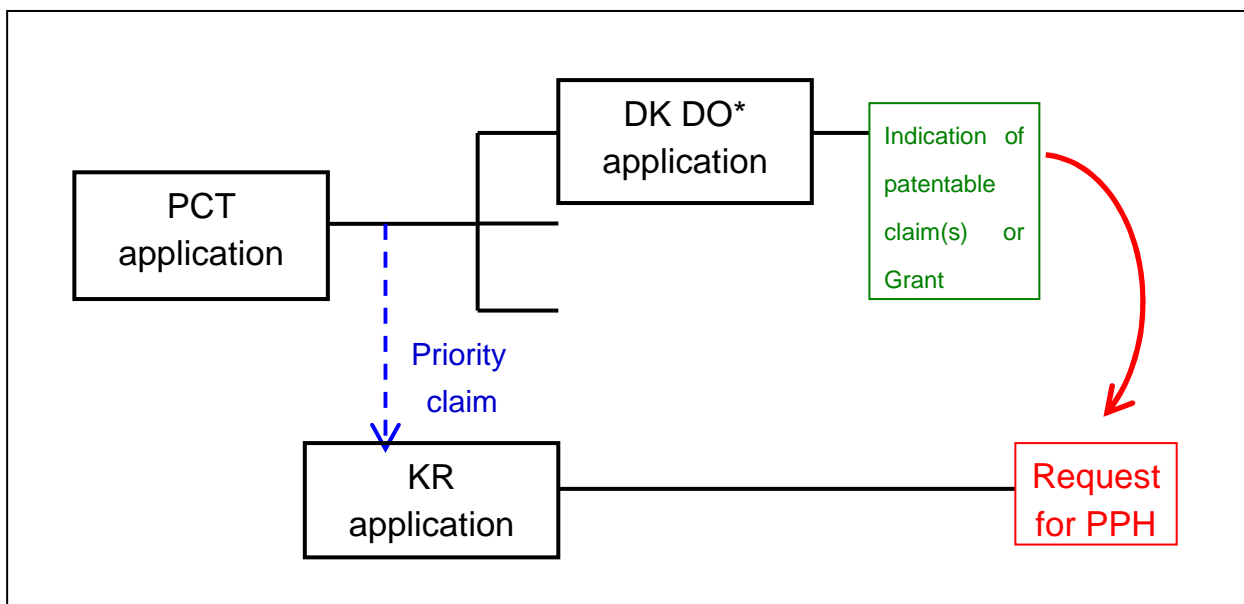


Figure H:



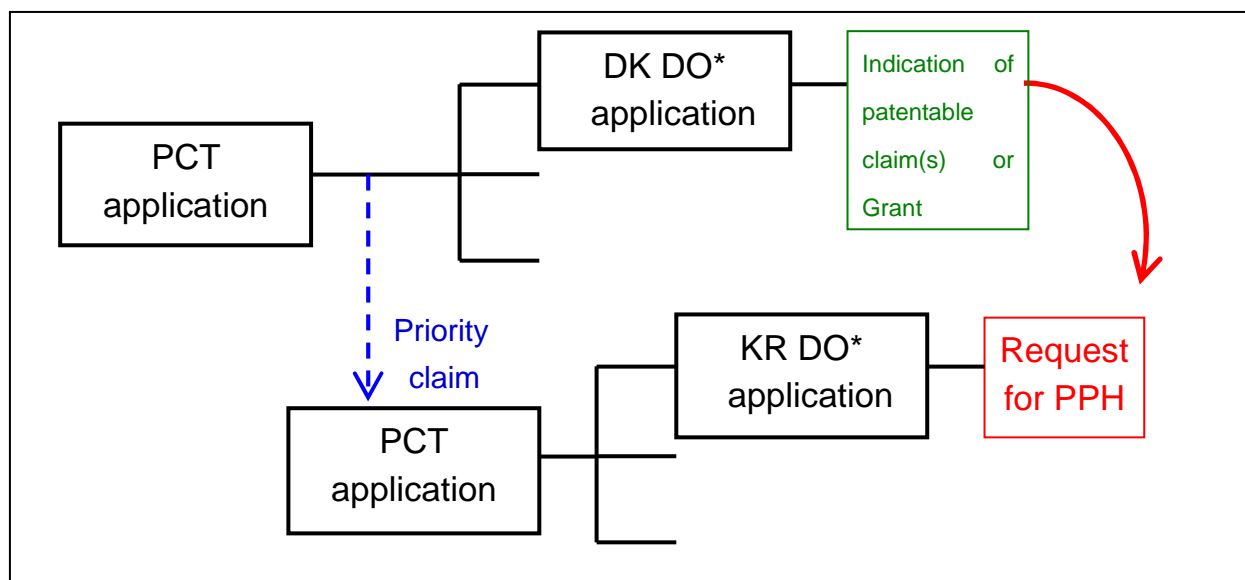
*DO - Designated Office

Figure I:



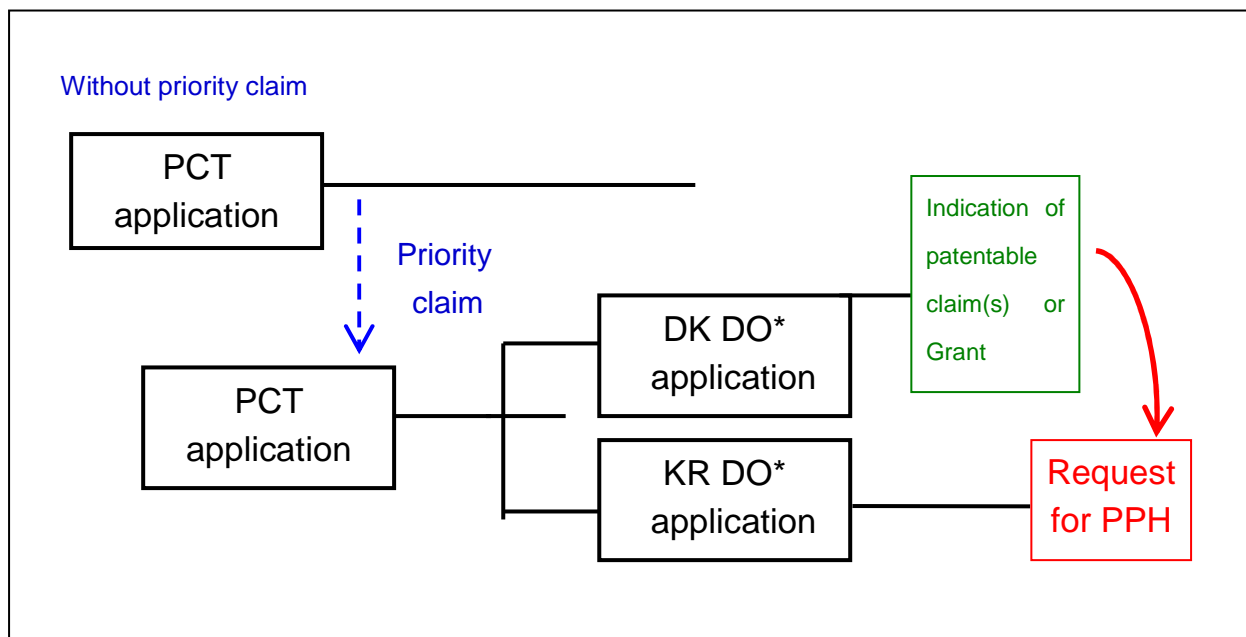
* DO – Designated Office

Figure J:



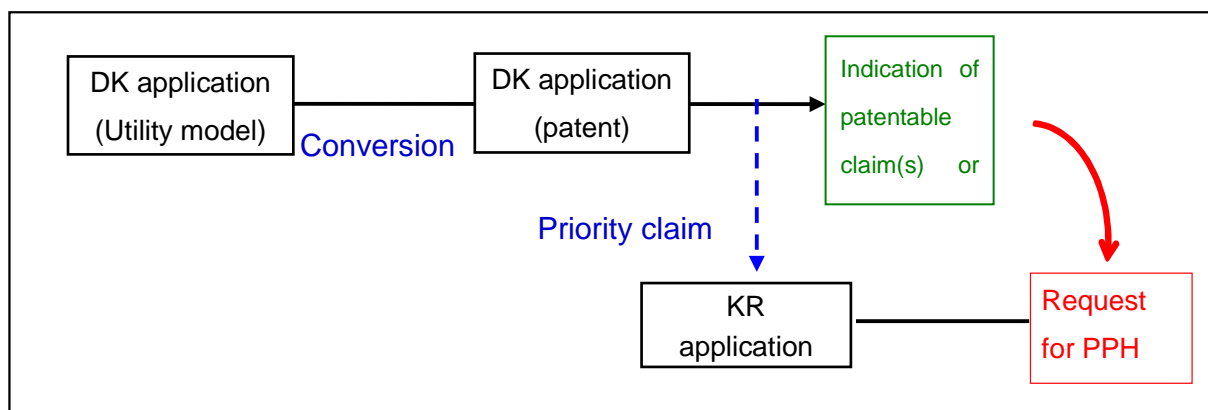
*DO – Designated Office

Figure K:



*DO – Designated Office

Figure L: (Conversion of DK application - from utility model to patent)



ANNEX II Request Form

서면

[별지 제 3 호서식]

【서류명】 특허심사하이웨이(PPH)에 의한 우선심사신청설명서

【대상국가】

【본원출원번호】

【대응출원번호】

【본원출원과 대응출원의 관계】

【제출서류】

【특허가능하다고 판단된 특허청구범위】

【서류명 및 제출(발행)일】

【서류제출여부】

(**【제출생략 이유】**)

【번역문제출여부】

(**【제출생략 이유】**)

【심사관련통지서】

【서류명 및 통지일】

【서류제출여부】

(**【제출생략 이유】**)

【번역문제출여부】

(**【제출생략 이유】**)

【심사단계에서 인용된 선행기술문헌】

【명칭】

【제출여부】

(**【제출생략 이유】**)

【청구항간 대응관계설명표】

본원출원의 청구항 번호	대응출원에서 특허가능하다고 판단한 청구항 번호	대응관계 설명

※ 기재요령

1. **【대상국가】** 란에는 한국 특허청이 특허심사하이웨이를 시행하고 있는 대상국가(일본, 미국, 덴마크, 영국, 캐나다, 러시아, 핀란드, 독일) 중 어느 한 국가의 명칭 기재합니다.
2. **【대응출원번호】** 란에는 위 대상국가에서 특허가능하다고 판단한 특허청구범위를 포함하고 있는 특허출원의 출원번호 및 출원일을 적습니다.

예) **【대응출원】** JP 평 18-1234 호, 2007. 1. 1.

3. **【본원출원과 대응출원의 관계】** 란에는 위 대응출원과 본원출원간의 대응 관계를 명확하게 설명합니다. 대응출원에는 조약우선권 주장의 기초가 된 상대국의 특허출원뿐만 아니라 조약우선권 주장의 기초가 된 상대국의 특허출원과 연계되어 있음이 명확한 상대국의 다른 특허출원(예. 분할출원, PCT 국제출원의 조기 국내단계 진입출원)도 포함됩니다.

예) **【본원출원과 대응출원의 관계】** 대응출원 JP 18-1234 은 본원출원(분할출원)의 원출원(KR10-2008-12345)이 조약 우선권주장하고 있는 상대국 특허출원 JP 17-5678 의 분할출원으로서 본원출원의 대응(패밀리)특허에 해당합니다.

4. **【특허가능하다고 판단된 특허청구범위】** 란에는 대상국가에서 특허가능하다고 판단한 특허청구범위가 기재된 서류명 및 제출 여부를 다음과 같이 기재합니다.

가. **【서류명 및 제출(발행)일】** 란에는 해당 특허청구범위가 기재된 서류의 종류와 제출일, 공보발간된 경우 공보번호와 공개일 등을 함께 기재합니다.

나. **【서류제출여부】** 란에는 ‘제출’로 기재하고 해당 특허청구범위를 첨부하여 제출합니다. 다만, 심사관이 정보통신망[예. AIPN(일본), public PAIR(미국), PVS online(덴마크) 등]을 통해 해당 특허청구범위를 용이하게 입수할 수 있는 경우에는 제출생략이 가능하므로 **【서류제출여부】** 란에 ‘제출생략’으로 기재하고 **【제출생략 이유】** 란에 생략 가능한 이유를 기재합니다.

다. 해당 특허청구범위가 국어 또는 영어가 아닌 언어로 작성된 경우에는 **【번역문제출여부】** 란을 만들어 ‘제출’로 기재하고 국어 또는 영어로 번역된 번역문을 첨부하여 제출합니다. 다만, 심사관이 정보통신망에서 국어 또는 영어로 된 번역문을 확인할 수 있는 경우에는 제출생략이 가능하므로 **【번역문제출여부】** 란에 ‘제출생략’으로 기재하고 **【제출생략 이유】** 란에 생략 가능한 이유를 기재합니다.

라. 우선심사신청 후 심사관이 해당 특허청구범위를 입수할 수 없거나 국문 또는 영문 번역이 불충분하여 보완지시를 하는 경우에는 해당 서류를 보완하여 제출하여야 합니다.

예 1) **【서류명 및 발행일】** JP2000-123456(2000.01.01)

【서류제출여부】 제출생략

【제출생략 이유】 OOOO 을 통해 심사관이 입수 가능하므로 제출생략

【번역문제출여부】 제출생략

【제출생략 이유】 OOOO 에서 영어 번역문이 제공되므로 제출생략

예 2) 【서류명 및 제출일】 보정서, 2009.06.25 자로 일본특허청에 제출

【서류제출여부】 제출

【번역문제출여부】 제출

5. 【심사관련 통지서】 란에는 대응출원에 대한 대상국가의 심사관이 통지한 실체심사 관련 서류명(거절결정서, 등록결정서, 의견제출통지서 등) 및 제출여부를 다음과 같이 기재합니다.

가. 【서류명 및 통지일】 란에는 실체심사와 관련하여 통지된 서류의 명칭, 통지일 등을 기재합니다.

나. 【서류제출여부】 란에는 ‘제출’로 기재하고 해당 심사관련 통지서를 첨부하여 제출합니다. 다만, 심사관이 정보통신망[예. AIPN(일본), public PAIR(미국), PVS online(덴마크) 등]을 통해 해당 심사관련 통지서를 용이하게 입수할 수 있는 경우에는 제출생략이 가능하므로 【서류제출여부】 란에 ‘제출생략’으로 기재하고 【제출생략 이유】 란에 생략 가능한 이유를 기재합니다.

다. 해당 통지서가 국어 또는 영어가 아닌 언어로 작성된 경우에는 【번역문제출여부】 란을 만들어 ‘제출’로 기재하고 국어 또는 영어로 번역된 번역문을 첨부하여 제출합니다. 다만, 심사관이 정보통신망에서 국어 또는 영어로 된 번역문을 확인할 수 있는 경우에는 제출생략이 가능하므로 【번역문제출여부】 란에 ‘제출생략’으로 기재하고 【제출생략 이유】 란에 생략 가능한 이유를 기재합니다.

라. 우선심사신청 후 심사관이 해당 통지서를 입수할 수 없거나 국문 또는 영문 번역이 불충분하여 보완지시를 하는 경우에는 해당 서류를 보완하여 제출하여야 합니다.

예 1) 【서류명 및 통지일】 특허사정서, 2008.12.30

【서류제출여부】 제출생략

【제출생략 이유】 정보통신망을 통해 심사관이 입수 가능하므로 제출생략

【번역문제출여부】 제출

6. 【심사단계에서 인용된 선행기술문헌】 란에는 심사관련 통지서에서 기재한 선행기술문헌

의 명칭 및 제출여부를 다음과 같이 기재합니다.

가. 【명칭】란에는 인용된 선행기술문헌의 종류, 공개일(공보일)을 기재합니다.

나. 【서류제출여부】란에는 ‘제출’로 기재하고 해당 선행기술문헌을 첨부하여 제출합니다. 다만, 심사관이 해당 선행기술문헌을 용이하게 입수할 수 있는 특허문헌(비특허문헌은 제출)은 제출생략이 가능하므로 【제출여부】란에 ‘제출생략’으로 기재하고 【제출생략 이유】란에 생략이유를 기재합니다.

예) 【명칭】 JP2000-123456(2000.01.01), US2004/348454(2004.05.04)

【제출여부】 제출생략

【제출생략 이유】 특허문헌으로 용이하게 입수 가능하므로 제출생략

【명칭】 3GPP TR 29.802 v7.0.0 'Technical Specification Group Core Network and Terminals; (G)MSC-S-(G)MSC-S Nc Interface based on the SIP-I protocol, JUNE 2007(sections 5.7 and 5.8)

【제출여부】 제출

7. 【청구항간 대응관계설명표】란에는 본원출원의 모든 청구항에 대하여 대응되는 “대응출원의 특허가능하다고 판단한 청구항 번호”를 기재하여야 하며, 대응관계 설명 부분에는 양 청구항의 동일 여부 또는 차이점을 구체적으로 기재하여야 합니다.

예)

본원출원의 청구항 번호	대응출원에서 특허가능하다고 판단한 청구항 번호	대응관계 설명
1	1	양 청구항은 동일
2	2	”
3	3	”
4	5	양 청구항은 기재형식의 차이일 뿐 실질적으로 동일
5	6	”
6	4	”
7	1	청구항 7은 대응출원의 청구항 1에 A라는 구성이 추가됨