

Procedures to file a request to IP Viet Nam (Intellectual Property Office of Viet Nam) for Patent Prosecution Highway Pilot Program between IP Viet Nam and KIPO (Korean Intellectual Property Office)

PPH using the national work products from the KIPO

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with IP Viet Nam and satisfies the following requirements under the IP Viet Nam-KIPO Patent Prosecution Highway (PPH) pilot program based on the KIPO application.

When filing a request for the PPH pilot program, an applicant must submit a request form to IP Viet Nam.

The Offices may terminate the PPH pilot program for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.

The PPH pilot program will be in effect for two (2) years commencing on June 1, 2019 and will end on May 31, 2021. The number of requests per year will not exceed one hundred (100) from each Office. However, the program may be extended after a joint IP Viet Nam-KIPO review and assessment of the program implementation.

1. Requirements

- (a) *The IP Viet Nam application (including a PCT national phase application is)***
- (i) an application which validly claims priority under the Paris Convention to the KIPO application(s) (examples are provided in ANNEX I, Figure A, B, C, H, I and J),***
or
 - (ii) a PCT national phase application without priority claim filed at KIPO as receiving office (the application number begins with PCT/KR, hereafter referred to as PCT/KR application) (examples are provided in ANNEX I, Figure K), or***
 - (iii) an application which validly claims priority under the Paris Convention to the PCT/KR application(s) referred to in (ii) above (examples are provided in ANNEX I, Figure L, M and N).***

The IP Viet Nam application, which validly claims priority to multiple KIPO or direct PCT applications, or which is the divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

The PPH pilot program is not applicable on the basis of KIPO “utility model” applications.

- (b) *At least one corresponding application exists in KIPO and has one or more claims that are determined to be patentable/allowable by KIPO.***

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the KIPO application which forms the basis of the priority claim (e.g., a divisional application of the KIPO application or an application which claims domestic priority to the KIPO application (see Figure C in Annex I)), or a KIPO national phase application of a PCT application (see Figures J, K, L, M and N in Annex I).

Claims are “determined to be allowable/patentable” when the KIPO clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet.

- (c) *All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in KIPO.***

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in IP Viet Nam are of the same or similar scope as the claims in KIPO, or the claims in IP Viet Nam are narrower in scope than the claims in KIPO. In this regard, a claim that is narrower in scope occurs when a KIPO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims).

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

Any claims amended or added after the request for participation in the PPH pilot program being accepted shall not be allowed

- (d)** IP Viet Nam has not begun examination of the application at the time of request for the PPH (an example is provided in ANNEX I, Figure O).
- (e)** The request for accelerated examination under the PPH must also be accompanied by, or preceded by a request for examination.

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to the PPH request.

- (a) Copies of all office actions (which are relevant to substantial examination for patentability in KIPO) which were issued for the corresponding application by KIPO, and translations of them¹.**

Either Vietnamese or English is acceptable as translation language. The applicant does not have to submit a copy of KIPO office actions and translations of them when those documents are provided via K-PION (<http://k-pion.kipo.go.kr/>) (KIPO's dossier access system) because the office actions and their machine translations are available for the IP Viet Nam examiner via the K-PION. If they cannot be obtained by the IP Viet Nam examiner via the K-PION or due to low quality of the translations, the applicant may be notified and requested to provide the necessary documents, including higher quality translations.

- (b) Copies of all claims determined to be patentable/allowable by KIPO, and translations of them.**

Either Vietnamese or English is acceptable as translation language. The applicant does not have to submit a copy of claims indicated to be allowable/patentable in KIPO, and translations thereof when the documents are provided via K-PION (<http://k-pion.kipo.go.kr/>) (KIPO's dossier access system) because they are available for the IP Viet Nam examiner via the K-PION. If they cannot be obtained by the IP Viet Nam examiner via the K-PION or due to low quality of the translations, the applicant may be notified and requested to provide the necessary documents, including higher quality translations.

- (c) Copies of references cited by the KIPO examiner**

If the references are patent documents, the applicant doesn't have to submit them because IP Viet Nam usually possesses them. When IP Viet Nam does not possess the patent document, the applicant has to submit the patent document at the examiner's request. Non-patent literature must always be submitted. The translations of the references are unnecessary.

- (d) Claim correspondence table**

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the IP Viet Nam application sufficiently correspond to the patentable/allowable claims in the KIPO application.

¹ Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

When claims are just literal translation, the applicant can just write down that “they are the same” in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim.

When the applicant has already submitted above documents (a) to (d) to IP Viet Nam through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

3. Procedure for the accelerated examination under the PPH pilot program

The IP Viet Nam decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When the IP Viet Nam decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again, provided that there has not been any first office action at the time of request of the PPH again, and it will be calculated as a new request.

4. PPH request form

Subject: Request for an accelerated examination under the PPH pilot program

Date of filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

This application is an application which corresponds to the KIPO application number _____, and the accelerated examination is requested under the PPH pilot program. For this purpose, the following documents are attached:

- Copies of all office actions (which are relevant to substantial examination for patentability in KIPO) which were issued for the corresponding application by KIPO and
- Translations of them

- Copies of all claims determined to be patentable/allowable by KIPO and
- Translations of them

- Copies of references cited by the KIPO examiner

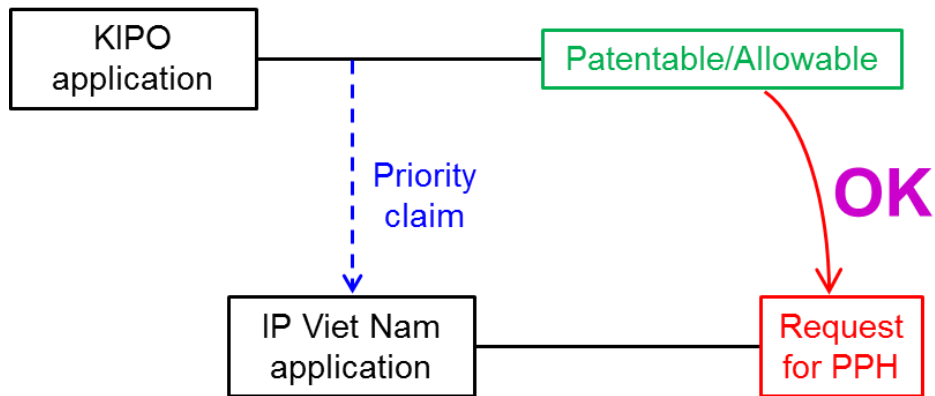
- Claim correspondence table

Claim correspondence table		
The claim in IP Viet Nam	The patentable claim in KIPO	Comments about the correspondence

(Documents to be omitted to submit)

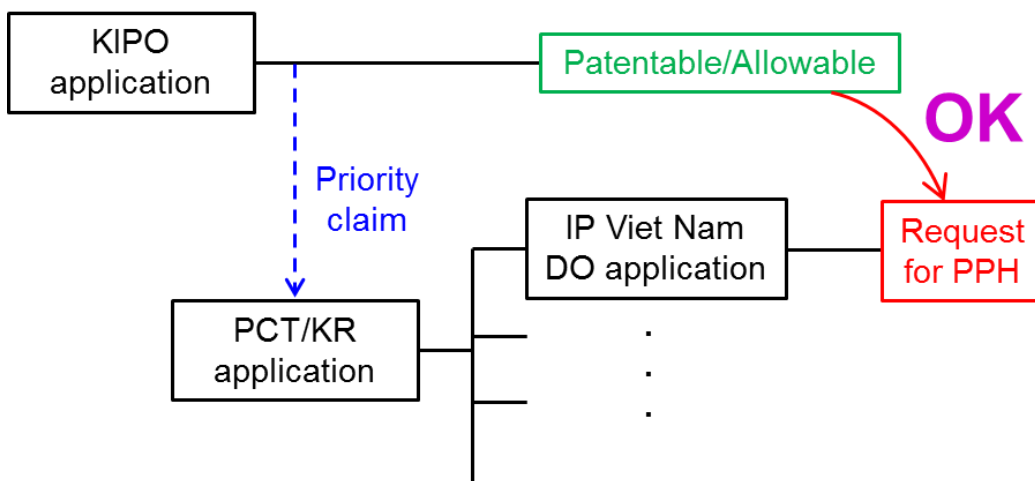
(A) A case meeting requirement (a) (I)

- Paris route -



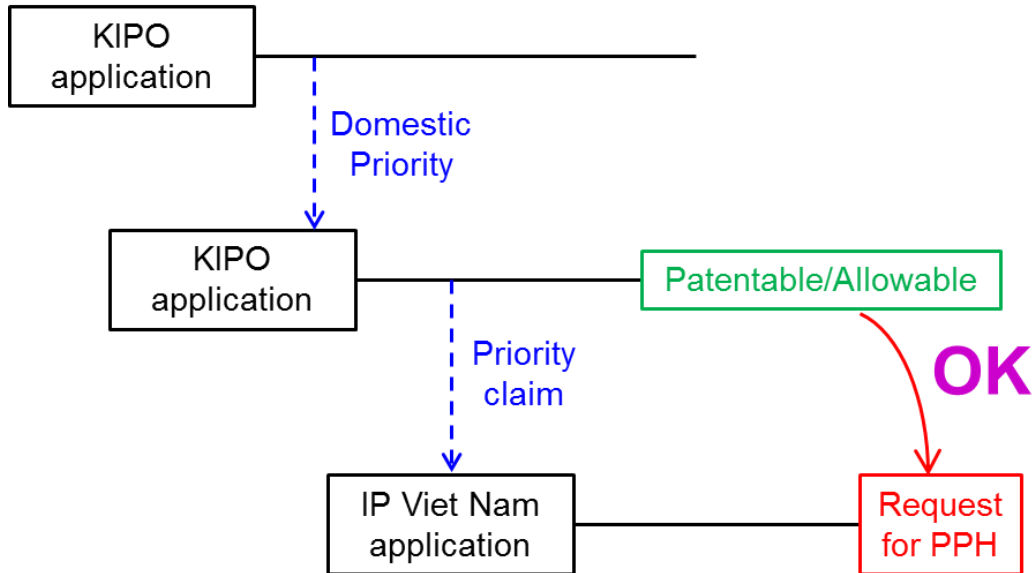
(B) A case meeting requirement (a) (I)

- PCT route -



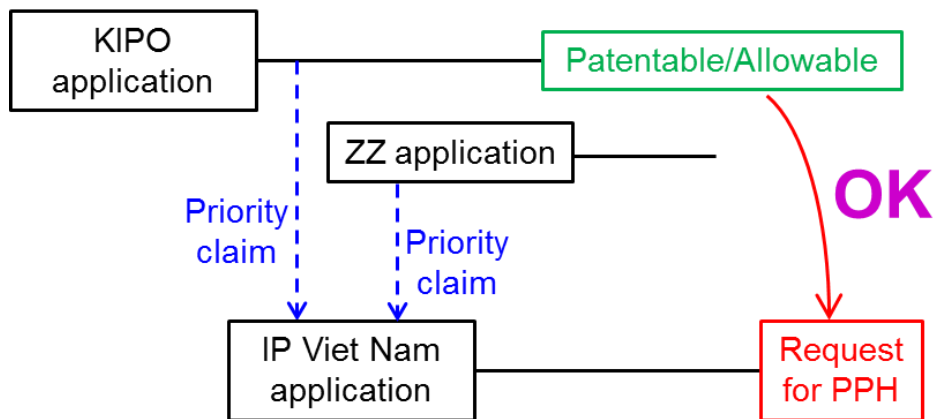
(C) A case meeting requirement (a) (I)

- Paris route, Domestic priority -



(H) A case meeting requirement (a) (I)

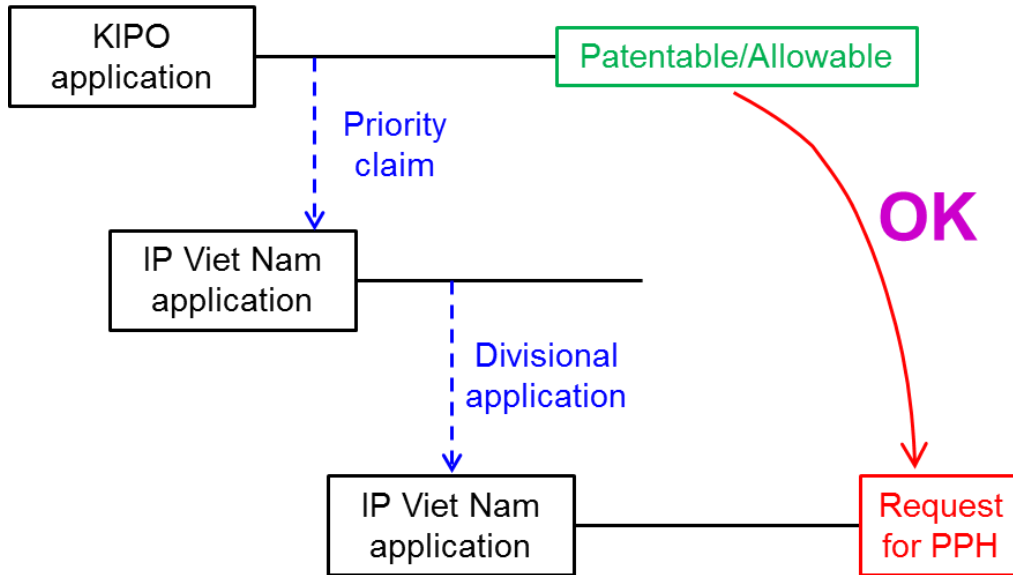
- Paris route & Complex priority -



ZZ : any office

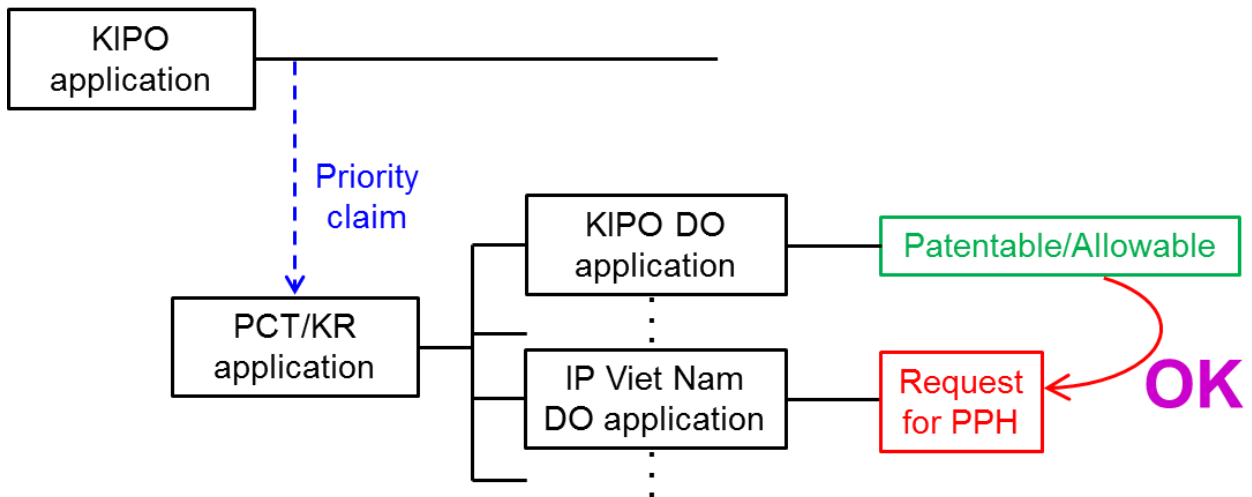
(I) A case meeting requirement (a) (I)

- Paris route & Divisional application -



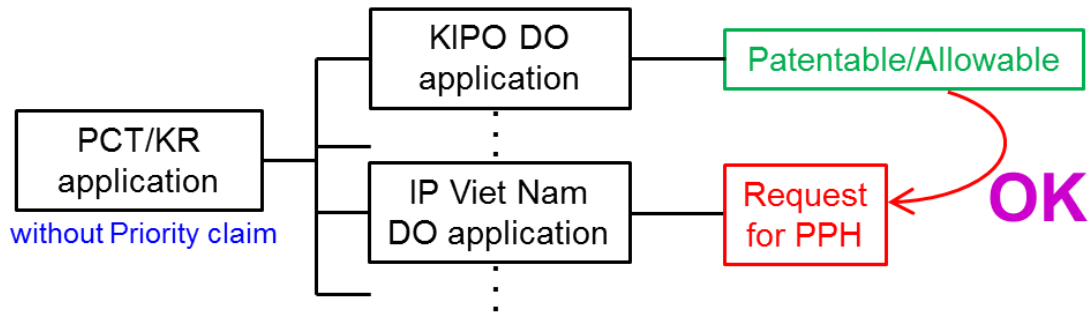
(J) A case meeting requirement (a) (I)

- PCT route -



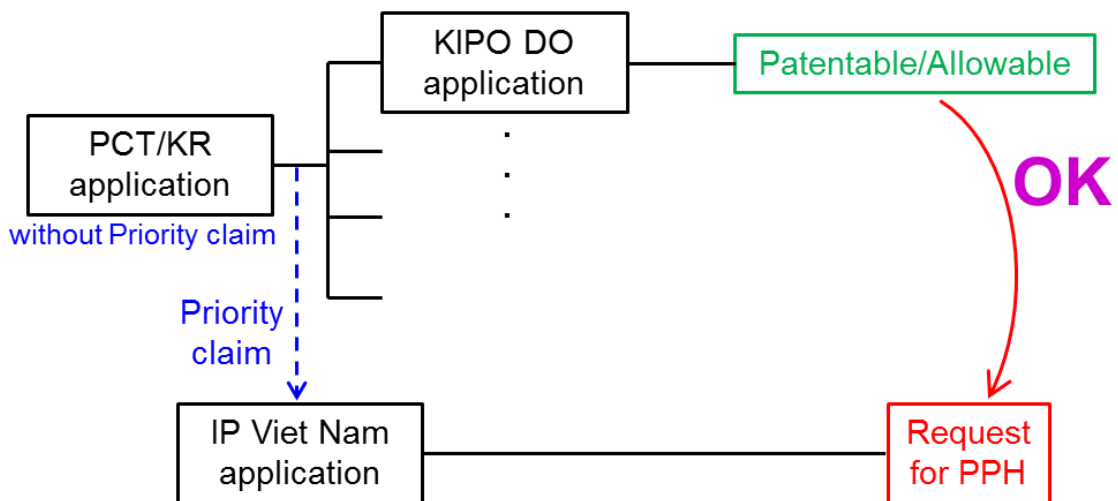
(K) A case meeting requirement (a) (II)

- Direct PCT route -



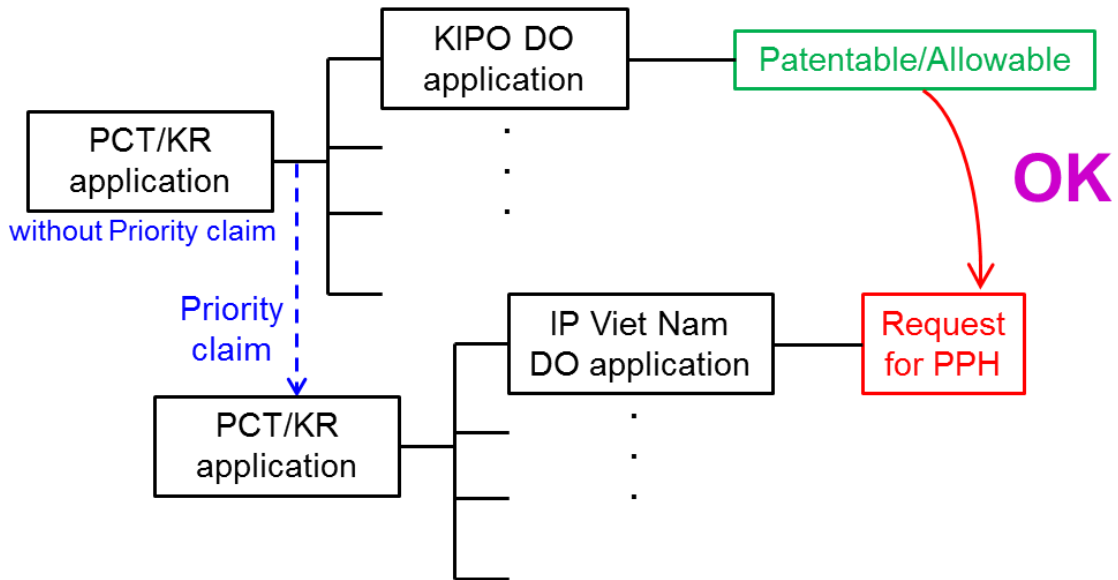
(L) A case meeting requirement (a) (III)

- Direct PCT & Paris route -



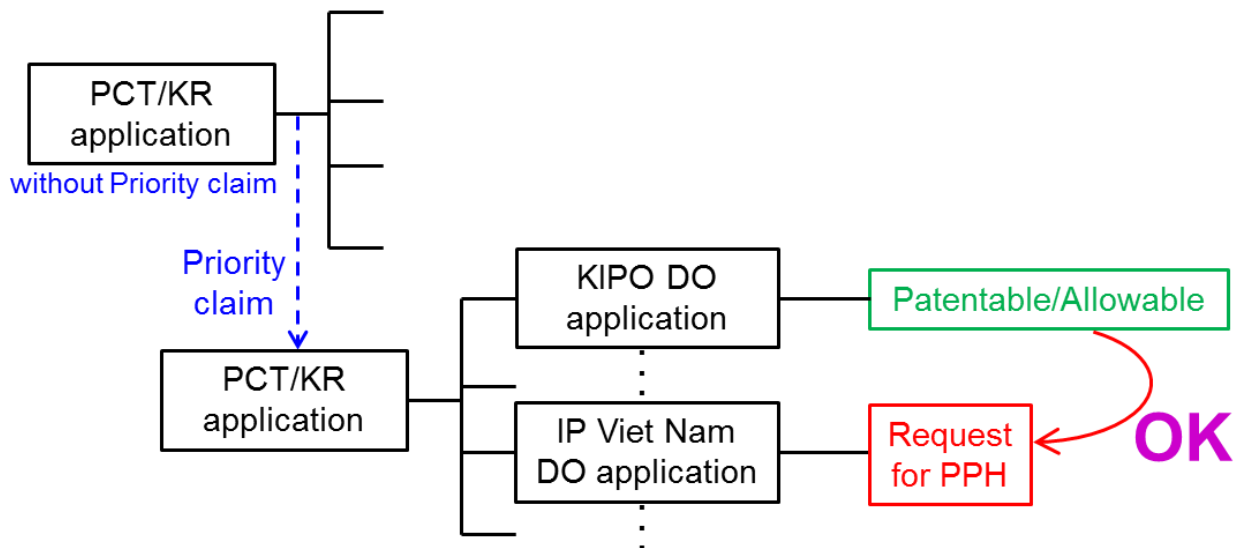
(M) A case meeting requirement (a) (III)

- Direct PCT & PCT route -



(N) A case meeting requirement (a) (III)

- Direct PCT & PCT route -



(O) A case not meeting requirement (d)

- Examination has begun before a request for PPH -

