

## **GUIDELINE**

### **Procedures to file a request to the Saudi Authority for Intellectual Property (SAIP) for the Patent Prosecution Highway Pilot Program**

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the SAIP and satisfies the following requirements under the KIPO (Korean Intellectual Property Office) SAIP 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 PPH request form presented in the "SAIP PPH request form" of this guideline.

The PPH pilot program between the SAIP and KIPO will commence on July 1<sup>st</sup>, 2019 and will end with mutual consent. The offices may terminate the PPH pilot program early if the volume of participation exceeds manageable level, or for any other reasons. An ex Ante notice will be published if the PPH pilot program is terminated.

## The PPH using the national work products from KIPO

### 1. Requirements

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

For example, the SAIP application (including a PCT national phase application) may be either: (Case I) an application which validly claims priority under the Paris Convention from the KIPO application(s) (examples are provided in ANNEX I, Figures A, B, C, D and E), or (Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the KIPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures F, G and H), or

- (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 is derived from the KIPO application which forms the basis of the priority claim (e.g., a divisional application of the KIPO application).

Claims are “determined to be allowable/patentable” when the KIPO examiner clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet. A claim determined as novel, inventive and industrially applicable by the KIPO has the meaning of allowable/patentable for the purposes of this pilot program.

The office action includes:

- (a) Decision to Grant a Patent
- (b) Notification of Reasons for Refusal

- (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/patentable in KIPO.***

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the SAIP are of the same or similar scope as the claims in KIPO, or the claims in the SAIP 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 the SAIP which introduces a new/different category of claims to those claims indicated as allowable in the 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 the SAIP are not considered to sufficiently correspond if the SAIP claims introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the grant of the request for participation in the PPH pilot program need not sufficiently correspond to the claims indicated as allowable in the KIPO application.

- (d) *The SAIP has not begun substantive examination of the application at the time of a request being made for the PPH.***

## **2. Documents to be submitted**

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

- (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 them.***

Either Arabic or English is acceptable as translation language<sup>1</sup>. The applicant does not have to submit a copy of KIPO office actions and translations of them when those documents are provided via the 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 SAIP examiner via the K-PION. If they cannot be obtained by the SAIP examiner via the K-PION, the applicant may be notified and requested to provide the necessary documents.

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

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

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

If the references are SAIP patent documents, the applicant doesn't have to submit them because the SAIP usually possesses them. When the SAIP does not possess the patent document (except for SAIP patents or SAIP patent application publications), 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 if the documents are in the English language.

- (d) *Claim correspondence table***

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<sup>1</sup> 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 applicant may be requested to resubmit translations.

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

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 the SAIP 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 SAIP decides whether the application can be entitled to the status for accelerated examination under the PPH when it receives a request with the documents stated above. When the SAIP decides that the request is acceptable, the application is assigned a special status for 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 thereof 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 an 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 once again in a renewed request for participation.

If all requirements for accelerated examination under the PPH are met, the SAIP will notify the applicant that the application has been allowed entry on to the PPH.

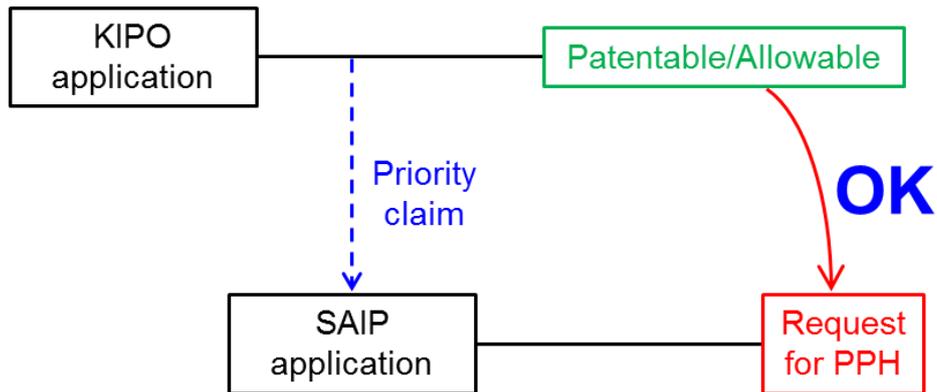
#### 4. SAIP PPH request form

REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM طلب الاشتراك في البرنامج التجريبي للمسار السريع لفحص طلبات براءات الاختراع		
<b>A. Bibliographic Data</b>		<b>أ. المعلومات البيبليوغرافية</b>
Application Number		رقم الطلب
Applicant's name		اسم مقدم الطلب
Inventor name		اسم المخترع
Title of invention		عنوان الاختراع
<b>B. Request</b>		<b>ب. المطلوب</b>
<b>Applicant requests participation in the Patent Prosecution Highway (PPH) pilot program based on:</b> يطلب مقدم الطلب الاشتراك في البرنامج التجريبي للمسار السريع لفحص طلبات براءات الاختراع (PPH) على أساس:		
Office of Earlier Examination (OEE)		مكتب الفحص السابق
OEE Work Products Type	<input type="checkbox"/> PPH (National Work Products) <input type="checkbox"/> المسار السريع لفحص طلبات براءات الاختراع (نتائج الفحص للمكتب الوطني)	نوع نتائج مكتب الفحص السابق
OEE Application Number		رقم طلب مكتب الفحص السابق
Priority Application Number or PCT Application Number		رقم طلب الأسبقية أو رقم طلب معاهدة التعاون بشأن البراءات
Both the OEE application and the above identified application have the following earliest date (filing or priority date):		طلب مكتب الفحص السابق والطلب المودع المحدد أعلاه كلاهما لهما التاريخ الأقدم التالي (تاريخ الإيداع أو الأسبقية)

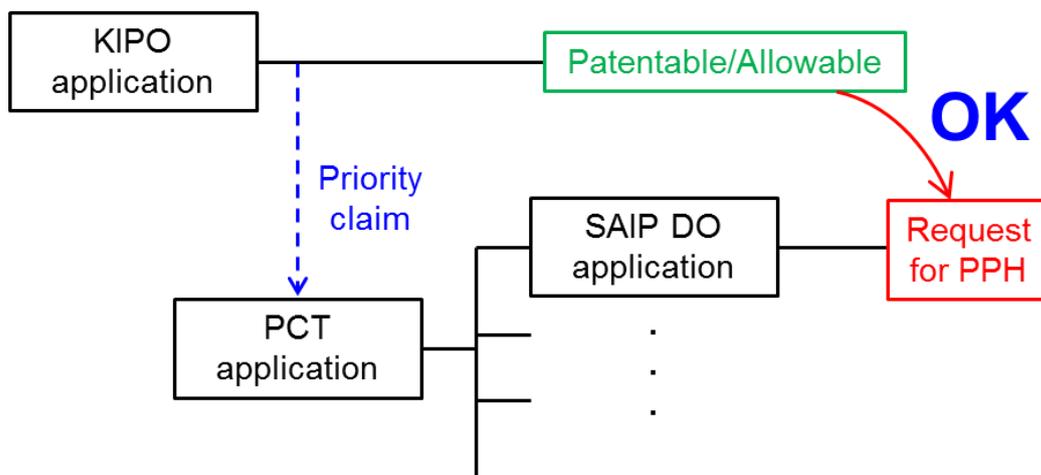
C. List of Required Documents	ج. قائمة الوثائق المطلوبة	
(a) A copy of OEE work product(s)	<input type="checkbox"/> Attached <input type="checkbox"/> Previously submitted <input type="checkbox"/> Not required because the decision to grant a patent was the first office action. <input type="checkbox"/> مرفقة <input type="checkbox"/> قدمت مسبقا <input type="checkbox"/> غير مطلوب لأن قرار منح براءة الاختراع كان أول إجراء للمكتب	(أ) نسخة من نتائج مكتب الفحص السابق
(b) Patentable/Allowable Claims Determined by OEE	<input type="checkbox"/> is attached <input type="checkbox"/> is not attached because the document is already in the SAIP application. <input type="checkbox"/> مرفقة <input type="checkbox"/> غير مرفقة نظرًا لأن المستند موجود مسبقًا في الطلب بـ SAIP	(ب) عناصر الحماية الممنوحة / القابلة للمنفح التي حددها مكتب الفحص السابق
(c) Translations of the documents in (a) and (b) above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in (b) above.	(ج) الترجمات للوثائق الواردة في (أ) و (ب) أعلاه مرفقة (إذا لم تكن الوثائق باللغة الإنجليزية). يتم إرفاق بيان بأن الترجمة الإنجليزية دقيقة للمستند في (ب) أعلاه.	
(d) Documents Cited in OEE Work Products (if required).	<input type="checkbox"/> attached <input type="checkbox"/> Previously submitted <input type="checkbox"/> No references were cited in the OEE work product. <input type="checkbox"/> مرفقة <input type="checkbox"/> قدمت مسبقا <input type="checkbox"/> غير مرفقة لأنه لم يتم ذكر أي مراجع في نتائج مكتب الفحص السابق.	(د) الوثائق المذكورة في نتائج مكتب الفحص السابق (إذا لزم الأمر)



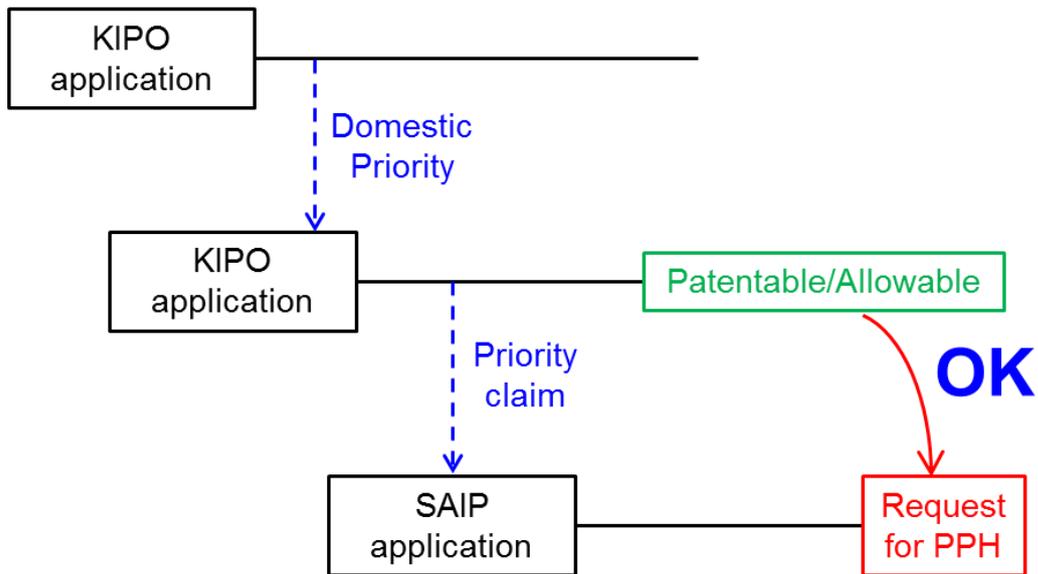
Ⓐ A case meeting requirement (a) (I)  
- Paris route -



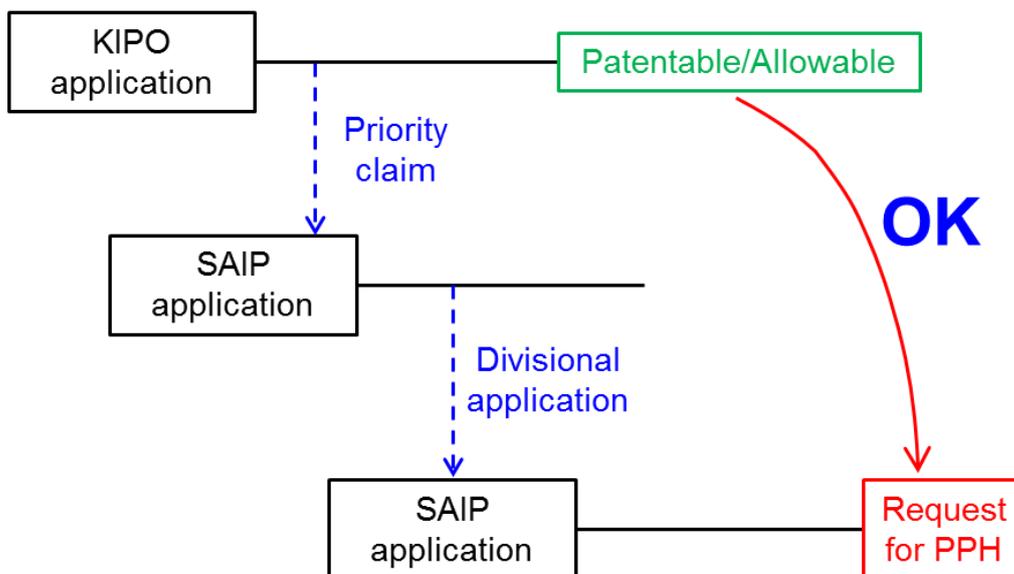
Ⓑ A case meeting requirement (a) (I)  
- PCT route -



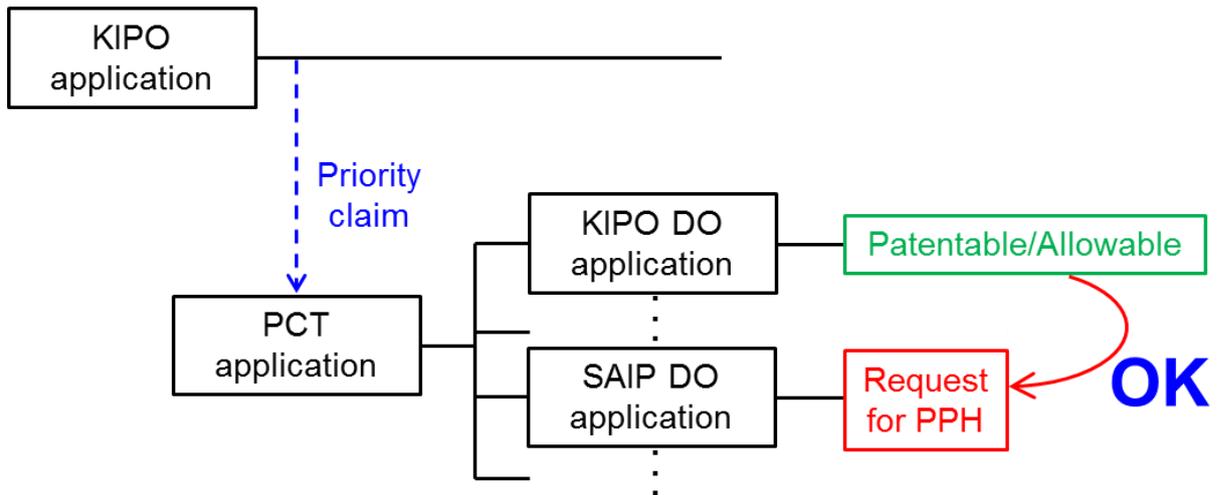
© A case meeting requirement (a) (I)  
- Paris route, Domestic priority -



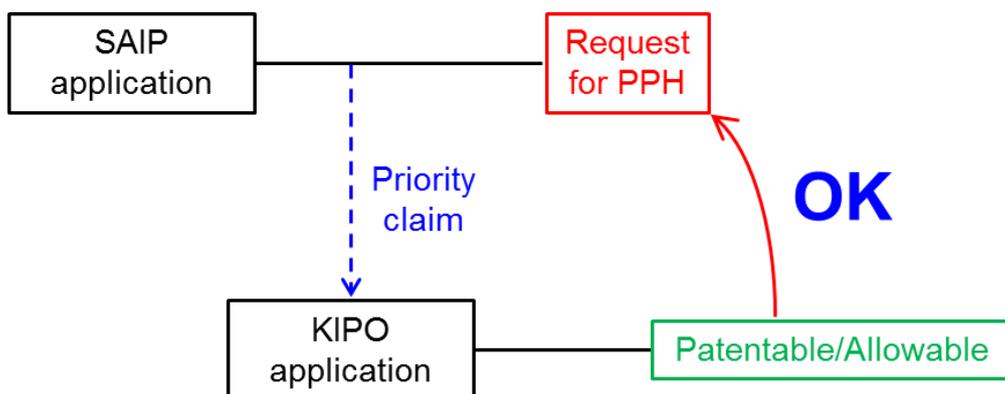
© A case meeting requirement (a) (I)  
- Paris route & Divisional application -



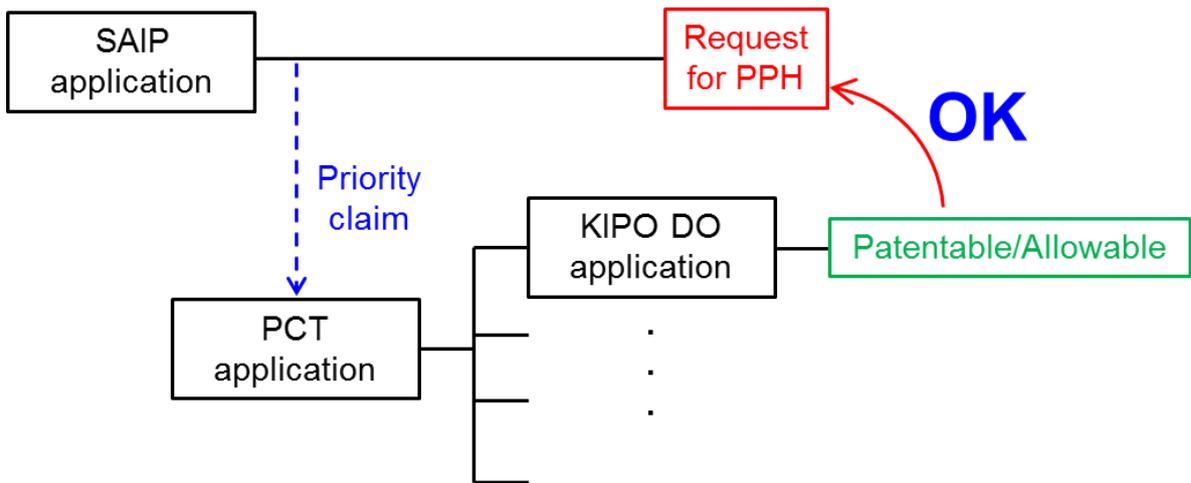
**(E)** A case meeting requirement (a) (I)  
- PCT route -



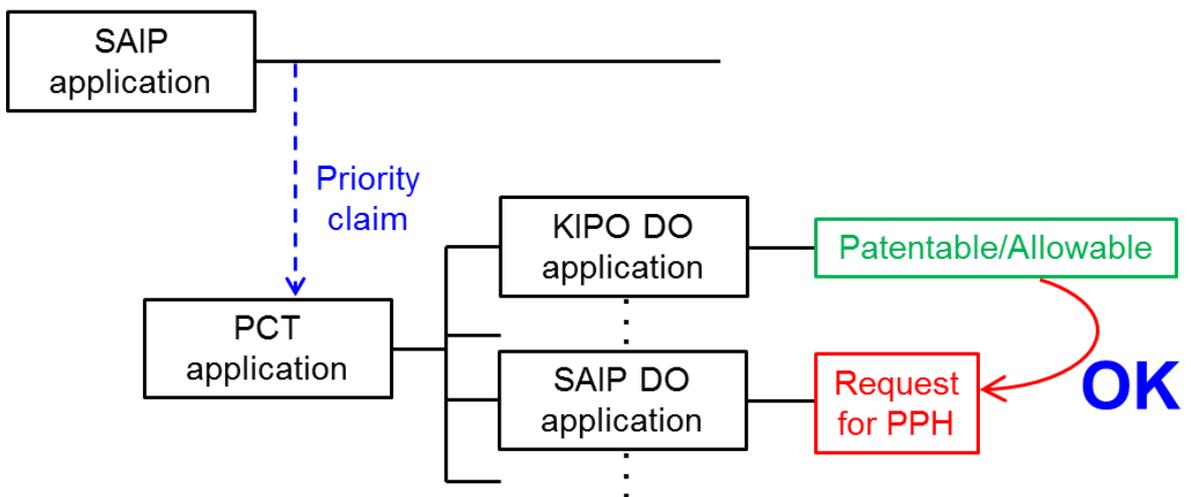
**(F)** A case meeting requirement (a) (II)  
- Paris route -



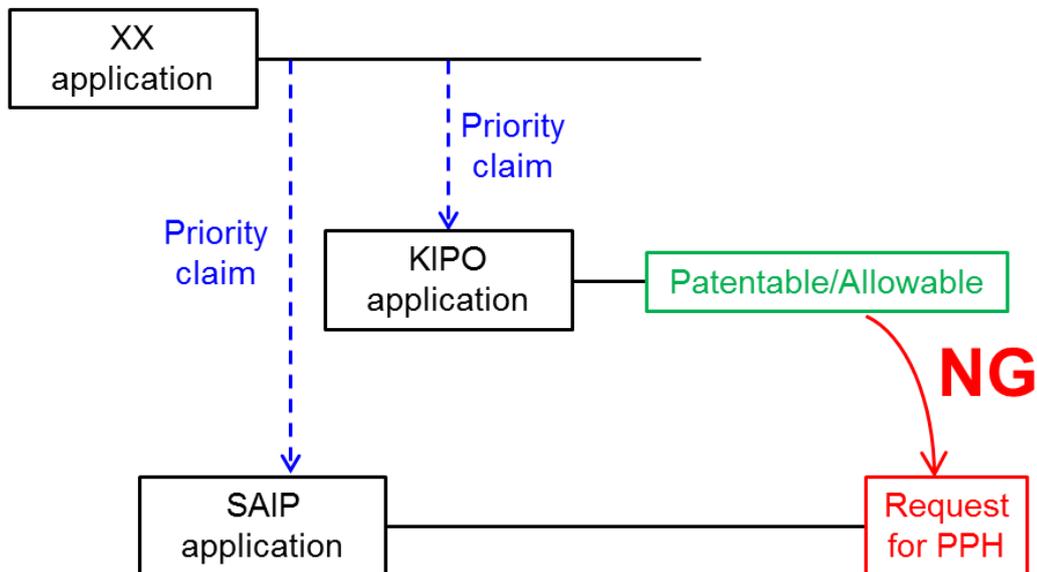
**G** A case meeting requirement (a) (II)  
- PCT route -



**H** A case meeting requirement (a) (II)  
- PCT route -

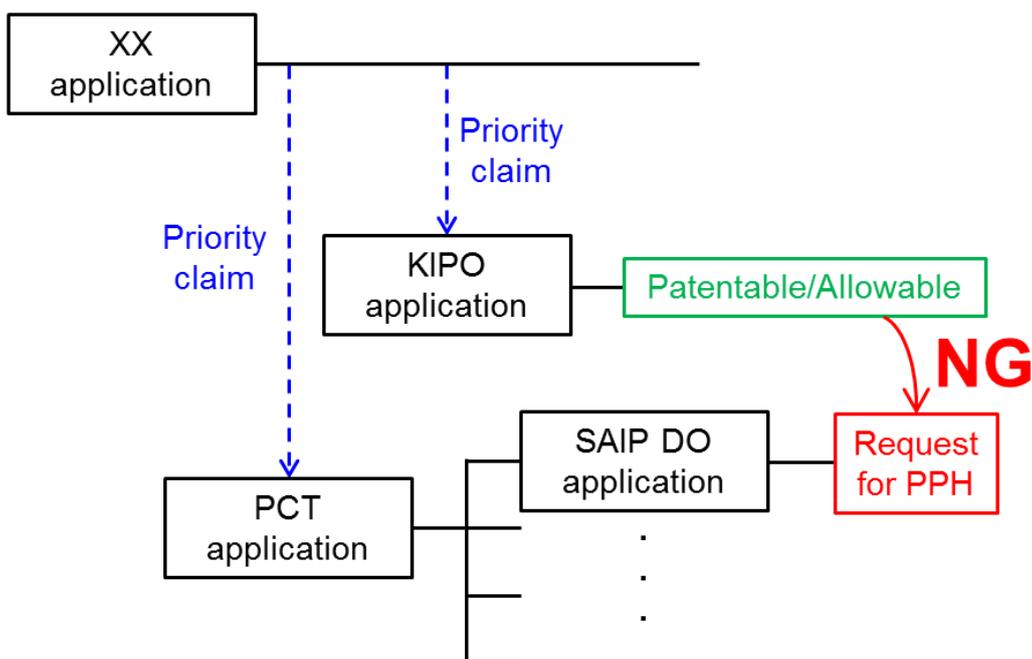


**I** A case not meeting requirement  
 - Paris route, but the first application is from the third country -



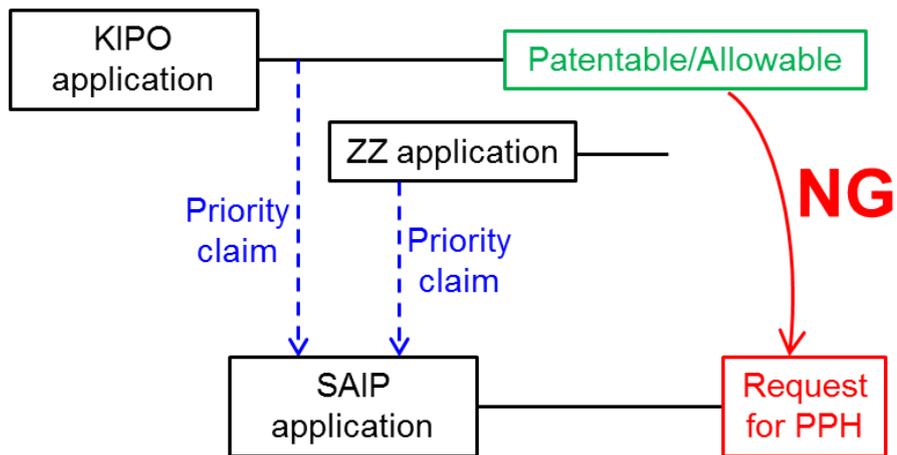
XX : the office other than the KIPO

**J** A case not meeting requirement  
 - PCT route, but the first application is from the third country -



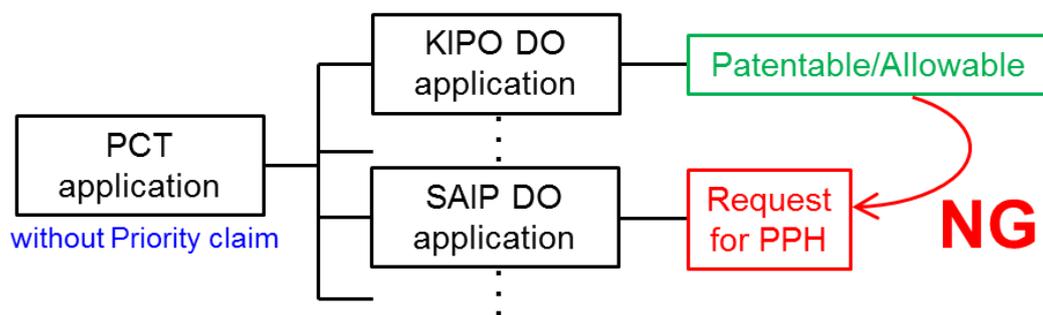
XX : the office other than the KIPO

**(K)** A case not meeting requirement  
 - Paris route & Complex priority -



ZZ : any office

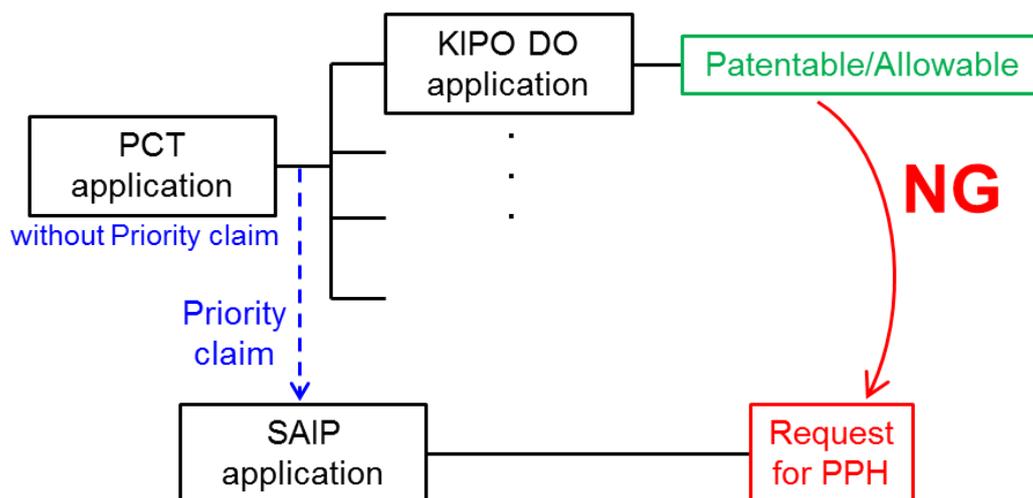
**(L)** A case not meeting requirement  
 - Direct PCT route -



(M)

### A case not meeting requirement

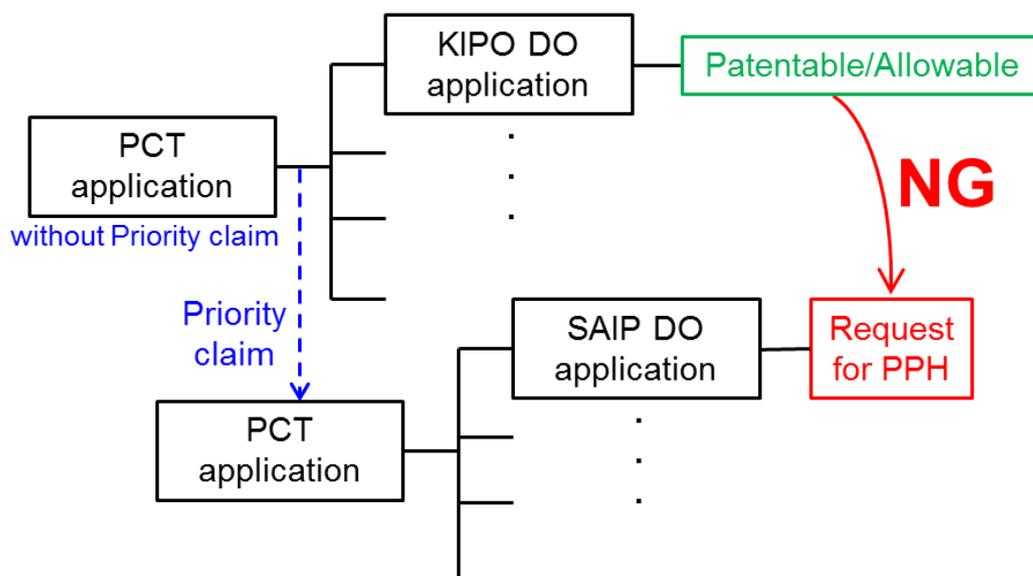
- Direct PCT & Paris route -



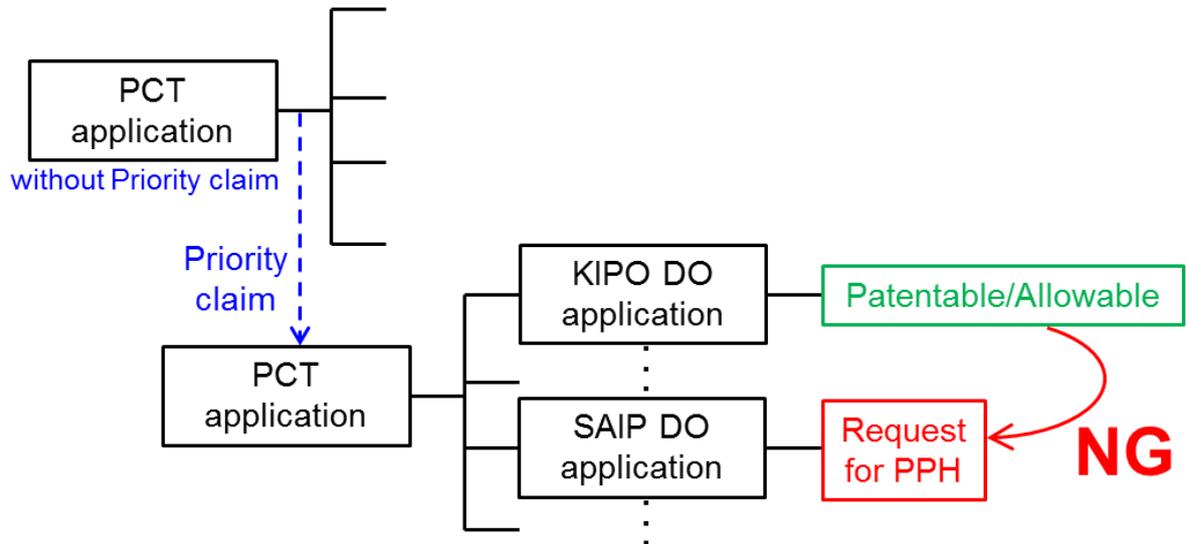
(N)

### A case not meeting requirement

- Direct PCT & PCT route -



⓪ A case not meeting requirement  
- Direct PCT & PCT route -



Ⓟ A case not meeting requirement  
- Examination has begun before a request for PPH -

