

# **Procedures to File a Request to the Korean Intellectual Property Office for IP5 Patent Prosecution Highway and Global Patent Prosecution Highway Pilot Program**

The European Patent Offices (EPO), Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO), State Intellectual Property Office of the People's Republic of China (SIPO) and the United States Patent and Trademark Office (USPTO), referred to as the IP5 Offices, agreed to launch the IP5 Patent Prosecution Highway (IP5 PPH) pilot program from January 6, 2014 for a duration of three years.

IP Australia, the Canadian Intellectual Property Office (CIPO), Danish Patent and Trademark Office (DKPTO), National Board of Patents and Registration of Finland (NBPR), Hungarian Intellectual Property Office (HIPO), Icelandic Patent Office (IPO), Israel Patent Office (ILPO), JPO, KIPO, Nordic Patent Institute (NPI), Norwegian Industrial Property Office (NIPO), Portuguese Institute of Industrial Property (INPI), Russian Federal Service for Intellectual Property (ROSPATENT), Spanish Patent and Trademark Office (SPTO), Swedish Patent and Registration Office (PRV), United Kingdom Intellectual Property Office (UK-IPO), and the USPTO agreed to launch the Global Patent Prosecution Highway (Global PPH) pilot program from January 6, 2014 with no fixed end date.

The IP5 PPH and the Global PPH pilot programs include both the Patent Prosecution Highway using national work products (PPH) and the Patent Prosecution Highway using the Patent Cooperation Treaty work products (PCT-PPH). The applicant can request accelerated examination by the PPH through the procedures prescribed in Part I of this document or by the PCT-PPH through the procedures prescribed in Part II of this document.

The Offices may terminate the pilot program if the volume of participation exceeds a manageable level, or for any other reason. An ex ante notice will be published if the pilot program is terminated.

## **Part I**

### **PPH request with the national work product**

Applicants can request accelerated examination on an application which is filed with KIPO based on national work product from the DKPTO, EPO, HIPO, ILPO, INPI, IP Australia, IPO, IPOS, JPO, NBPR, NIPO, PRV, ROSPATENT, SIPO, SPTO, UK-IPO and the USPTO as Office of Earlier Examination (OEE). The request should meet the following requirements and the applicant should submit the request form "Request for Accelerated Examination under the Patent Prosecution Highway" with relevant documents to KIPO.

## 1. Requirements

- (a) ***Both the KIPO application on which PPH is requested and the OEE application 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, and explain the relationship between those applications in the request form. See Annex I for examples where the above requirement is satisfied.

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

Claims are “determined to be patentable/allowable” when the OEE examiner explicitly identified the claims to be patentable/allowable in the latest office action, even if the application is not granted for patent yet. If the OEE office action does not explicitly state that a particular claim is patentable/allowable, the applicant must include an explanation accompanying the request for participation in the PPH pilot program that no rejection has been made in the OEE office action regarding that claim and, therefore, the claim is deemed patentable/allowable by the OEE.

- (c) ***All claims in the KIPO application (for which an accelerated examination under the PPH pilot program is requested), as originally filed or as amended, must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the OEE.***

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the KIPO application are of the same or similar scope as the claims in the OEE, or the claims in the KIPO application are narrower in scope than the claims in the OEE.

In this regard, a claim that is narrower in scope occurs when an OEE claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims).

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

It is not necessary to include “all” claims determined as patentable/allowable in the OEE in

an application in KIPO (the deletion of claims is allowable). For example, in a case where an application in the OEE contains 5 claims determined as patentable/allowable, the 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”.

**(d) A “Request for Examination” must have been filed.**

The request for accelerated examination under the PPH must be accompanied or preceded by a request for examination.

The request for accelerated examination under the PPH may be filed not only when examination has not begun, but also when examination has already begun.

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

Documents (a) to (d) below must be submitted attached to “Request for Accelerated Examination under the Patent Prosecution Highway”.

Note that even when it is not needed to submit the documents below, the name of the documents must be listed in the “Request for Accelerated Examination under the Patent Prosecution Highway” (Please refer to the example form below for details).

**(a) Copies of all office actions (which are relevant to substantial examination for patentability in the OEE), which were sent for the corresponding application by the OEE and translations thereof**

Either Korean or English is acceptable as translation language. Machine translations will be admissible but if it is not possible for the examiner to understand the translated office actions, the examiner may request the applicant to resubmit translations.

It is not required to submit the office actions and translations thereof when the documents are available via the Dossier Access System (DAS) of the OEE.

**(b) Copies of all claims determined to be patentable/allowable by the OEE and translations thereof**

Either Korean or English is acceptable as translation language. Machine translations will be admissible but if it is not possible for the examiner to understand the translated claims, the examiner may request the applicant to resubmit translations.

It is not required to submit the claims and translations thereof when those documents are available via the Dossier Access System (DAS) of the OEE.

**(c) Copies of references cited by the OEE examiner**

The copies of references to be submitted are those cited in the office actions of the OEE. If the references are patent documents, the applicant is not required to submit them. When KIPO does not possess the patent documents, the applicant has to submit the patent documents at the examiner's request. Non-patent documents must always be submitted. Translations of references are unnecessary.

**(d) Claim correspondence table**

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

When claims are just literal translations, the applicant can write that "they are the same" in the table. When claims are not just literal translations, it is required to explain the sufficient correspondence of each claim based on criteria 1.(c) (Please refer to the example form below and Annex II).

### **3. Fee for accelerated examination**

The applicant must pay a fee for participation in the PPH which is a requirement for all types of accelerated examination at KIPO.

### **4. Procedure for the accelerated examination under the PPH**

KIPO decides whether the application can be entitled to the status of accelerated examination under the PPH when it receives a request with the documents stated above. When KIPO 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 and the deficiencies in the request will be identified. The applicant will be given the opportunity to correct the deficiencies identified in the request. If the request is not corrected, the application will await action in its regular turn and the applicant will be notified.

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

**Example form of Request for Accelerated Examination under the Patent Prosecution Highway (consists of 2 forms: “Request for Accelerated Examination“ and “Explanation 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 OEE)

【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)

## Part II

### PCT-PPH request with the PCT international work product

Applicants can request accelerated examination on an application which is filed with KIPO based on a PCT international work product from CIPO, EPO, ILPO, IP Australia, JPO, KIPO, NBPR, NPI, PRV, ROSPATENT, SIPO, SPTO and the USPTO. The request should meet the following requirements and the applicant should submit a request form "Request for Accelerated Examination under the PCT-PPH" with relevant documents to KIPO.

#### 1. Requirements

- (a) ***Both the KIPO application on which PCT-PPH is requested and the corresponding international application forming the basis of the PCT-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 corresponding international application, and explain the relationship between those applications in the request form. See Annex II for examples where the above requirement is satisfied.

- (b) ***The latest work product in the international phase of a PCT application corresponding to the application ("international work product"), namely the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive step and industrial applicability).***

The applicant cannot file a request for PCT-PPH on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of the WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation irrespective of whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participation in the PCT-PPH pilot program if the applicant does not explain why the claim(s) is/are not subject to the observation. In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

However, if the WO/ISA, WO/IPEA or IPER forming the basis of a PCT-PPH request is



produced by SIPO and has any observation described in Box VIII of the WO/ISA, WO/IPEA or IPER, the application will not be eligible for participation in the PCT-PPH pilot program.

- (c) ***All claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated as patentable/allowable in the latest international work product of the corresponding international application.***

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the KIPO application are of the same or similar scope as the claims indicated to be patentable/allowable in the latest international work product, or the claims in the KIPO application are narrower in scope than the claims indicated to be patentable/allowable in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated to be patentable/allowable in the latest international work product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims).

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

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

Refer to Annex III for the cases which are considered to "sufficiently correspond" and the cases which are not considered to "sufficiently correspond".

- (d) ***A "Request for Examination" must have been filed.***

The request for accelerated examination under the PCT-PPH must be accompanied or preceded by a request for examination.

The request for accelerated examination under the PCT-PPH may be filed not only when examination has not begun, but also when examination has already begun.

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

Documents (a) to (d) below must be submitted attached to “Request for Accelerated Examination under the PCT-PPH”.

Note that even when it is not needed to submit the documents below, the name of the documents must be listed in the “Request for Accelerated Examination under the PCT-PPH” (Please refer to the example form below for details).

**(a) *A copy of the latest international work product of the corresponding international application which indicates the claims to be patentable/allowable, and translation thereof***

Either Korean or English is acceptable as translation language. Machine translations will be admissible but if it is not possible for the examiner to understand the translated international work product, the examiner may request the applicant to resubmit translations.

If a copy of the latest international work product and translation thereof are available via “PATENTSCOPE”<sup>1</sup> (e.g. the international Patent Gazette has been published), the applicant is not required to submit these documents unless otherwise requested by KIPO.

**(b) *Copies of all claims which are indicated as patentable/allowable in the latest international work product of the corresponding international application, and translations thereof***

Either Korean or English is acceptable as translation language. Machine translations will be admissible but if it is not possible for the examiner to understand the translated claims, the examiner may request the applicant to resubmit translations.

If copies of all the claims which are indicated as patentable/allowable and translations thereof are available via “PATENTSCOPE”, the applicant is not required to submit the documents unless otherwise requested by KIPO.

**(c) *Copies of references cited in the latest international work product of the corresponding international application***

The copies of references to be submitted are those cited in the international work product. If the references are patent documents, the applicant is not required to submit them. When KIPO does not possess the patent documents, the applicant has to submit the patent documents at the examiner’s request. Non-patent documents must always be submitted. Translations of references are unnecessary.

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<sup>1</sup> <http://www.wipo.int/pctdb/en/index.jsp>

**(d) *A claims correspondence table***

The applicant must submit a claims correspondence table, which indicates how all claims in the KIPO application sufficiently correspond to the patentable/allowable claims of the corresponding international application.

When claims are just literal translations, the applicant can write that “they are the same” in the table. When claims are not just literal translations, it is required to explain the sufficient correspondence of each claim based on criteria 1.(c) (Please refer to the example form below and Annex II).

### **3. Fee for accelerated examination**

The applicant must pay a fee for participation in the PPH which is a requirement for all types of accelerated examination at KIPO.

### **4. Procedure for accelerated examination under the PCT-PPH pilot program**

KIPO decides whether the application can be entitled to the status of accelerated examination under the PCT-PPH when it receives a request with the documents stated above. When KIPO decides that the request is acceptable, the application is assigned a special status for accelerated examination under the PCT-PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the deficiencies in the request will be identified. The applicant will be given the opportunity to correct the deficiencies identified in the request. If the request is not corrected, the application will await action in its regular turn and the applicant will be notified.

KIPO will not notify the applicant of acceptance for assigning a special status for accelerated examination under the PCT-PPH, but instead the applicant may recognize it through the receipt of an office action resulting from accelerated examination.

**Example form of Request for Accelerated Examination under the PCT-PPH (consists of 2 forms: “Request for Accelerated Examination“ and “Explanation of Request for Accelerated Examination under the PCT-PPH“)**

【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 PCT-PPH)

【서류명】 PCT-PPH 에 의한 우선심사신청설명서

(Explanation of Request for Accelerated Examination under the PCT-PPH)

【대상국가등】 (Office of Earlier Examination as an ISA or IPEA)

【본원출원번호】 (Application Number)

【대응출원번호】 (Application Number of Corresponding Application)

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

【제출서류】 (Required Documents)

【신규성, 진보성 및 산업상 이용가능성이 모두 있다고 판단된 특허청구범위】

(Patentable Claims in view of Novelty, Inventive Step and Industrial Applicability)

【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)

【국제조사 또는 국제예비심사 관련 통지서】 (International Work Product)

【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)

【국제조사 또는 국제예비심사에서 인용된 선행기술문헌】 (Prior Arts cited in WO/IPER)

【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 the Corresponding International Application)	대응관계 설명 (Correspondence)

**【국제출원에 관한 의견 관련 설명】**

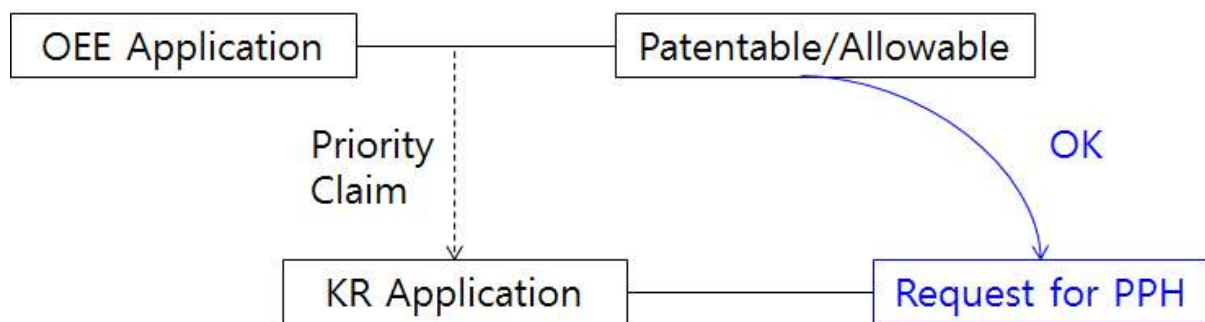
(Explanation for the Comments in Box VIII of the International Work Product)

# ANNEX I

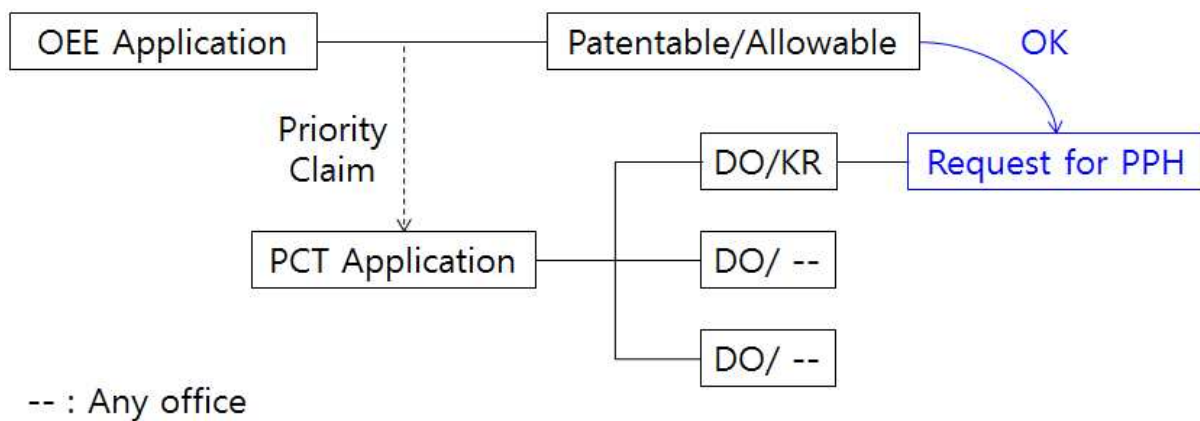
## Examples of KIPO applications eligible for the PPH

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

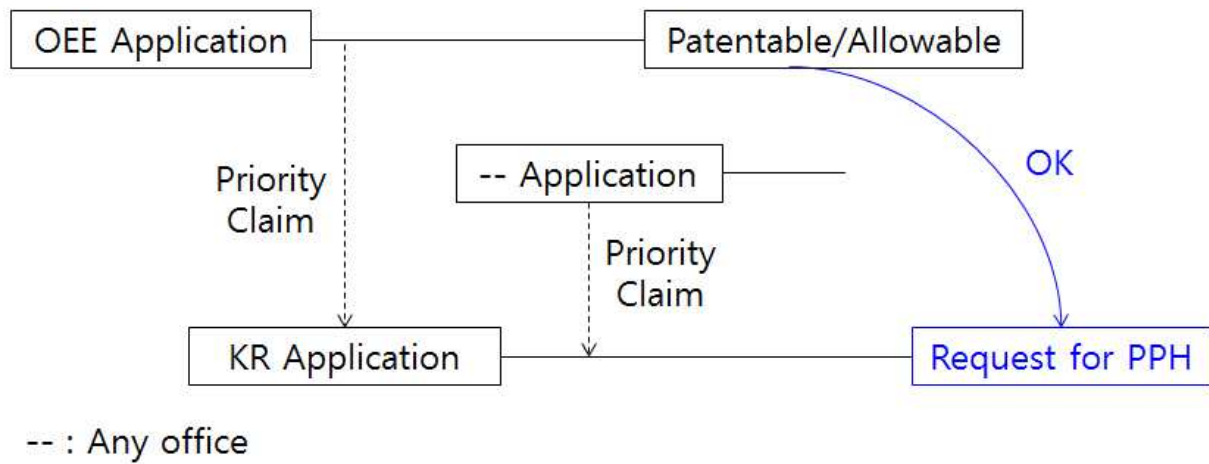
KIPO application which validly claims priority under the Paris Convention from an OEE application.



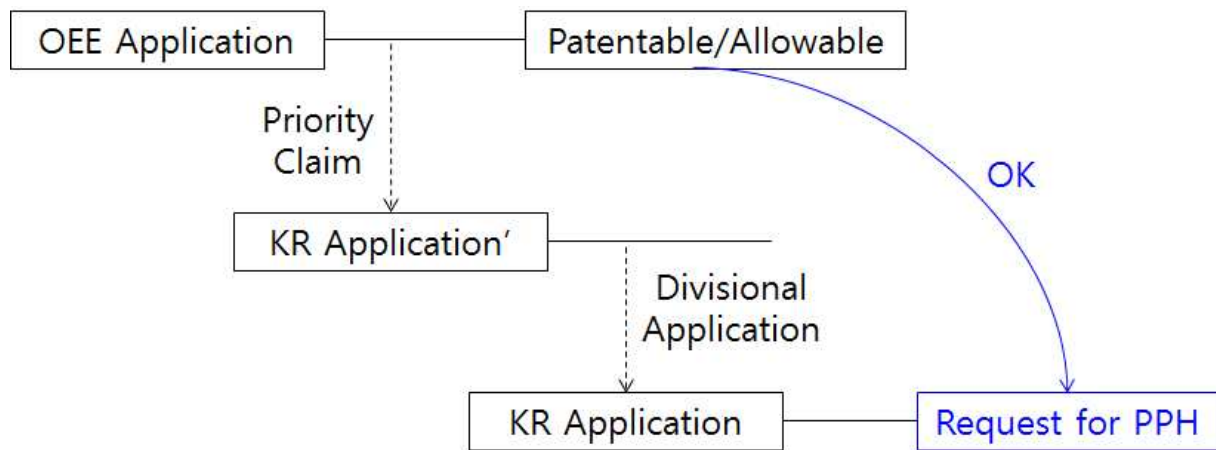
(Figure A) Paris route



(Figure B) Paris route and PCT route



(Figure C) Paris route and complex priority

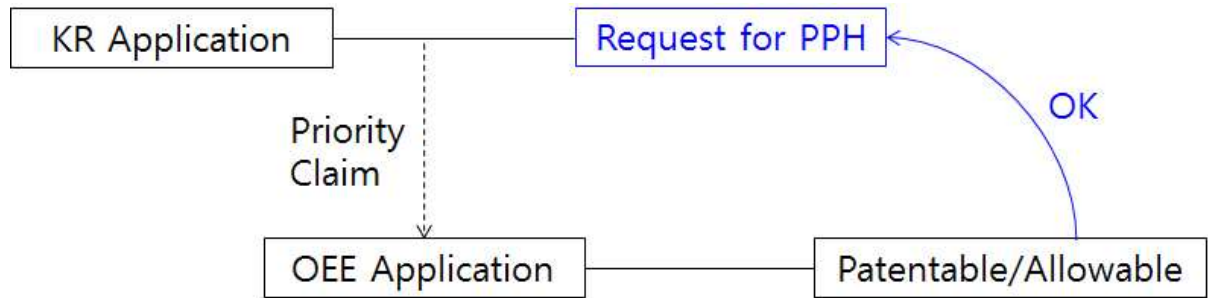


(Figure D) Paris route and divisional application

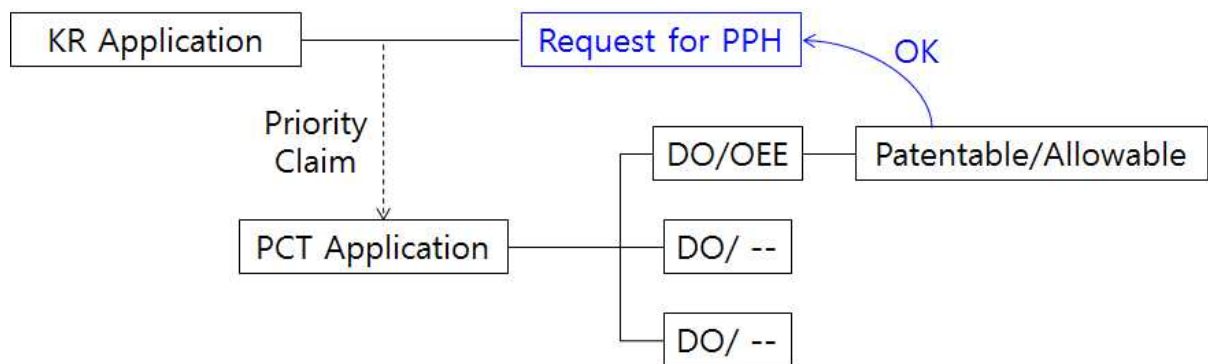


## CASE II (Figure E and F)

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



(Figure E) Paris route

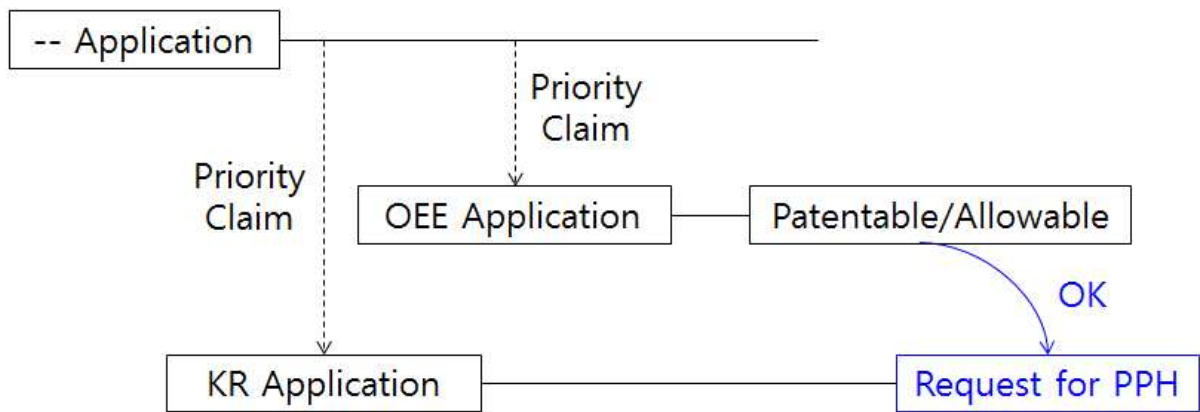


-- : Any office

(Figure F) Paris route and PCT route

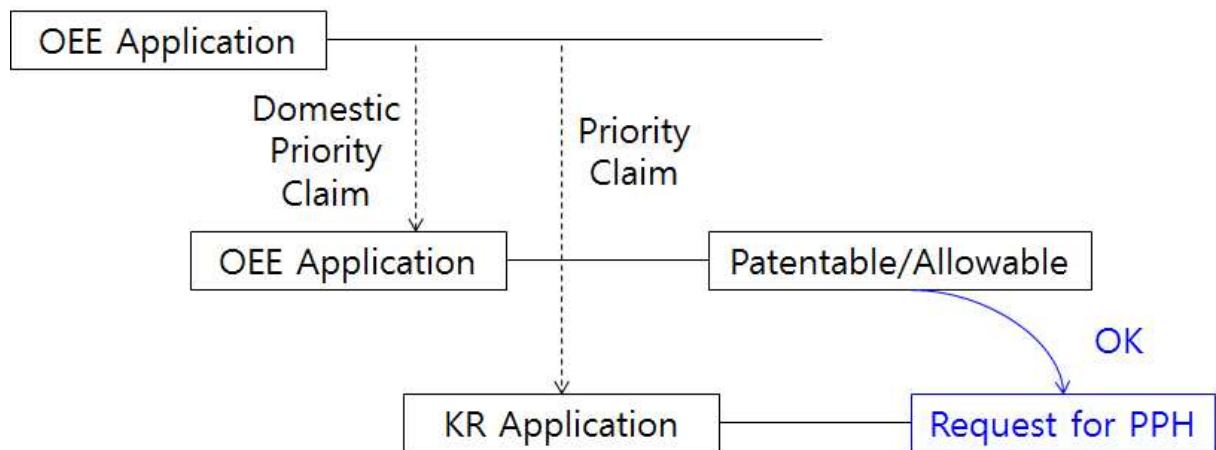
### CASE III (Figure G, H, I, J, K, L and M)

KIPOO application which shares a common priority document with an OEE application (including PCT national phase application).

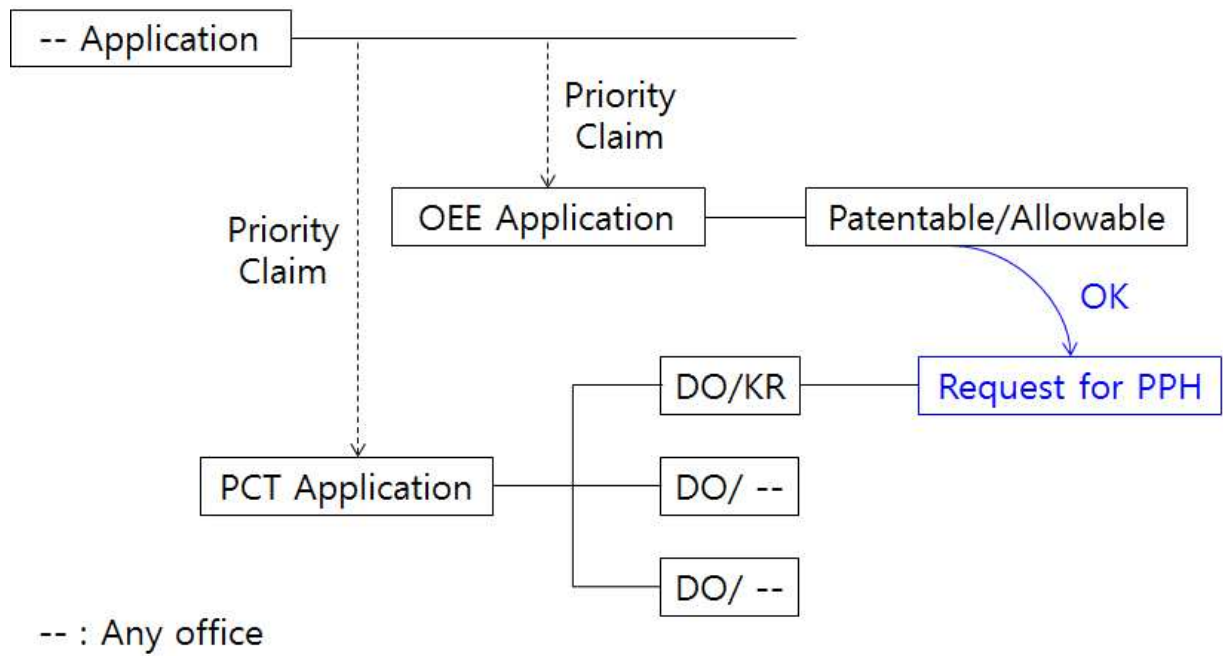


-- : Any office

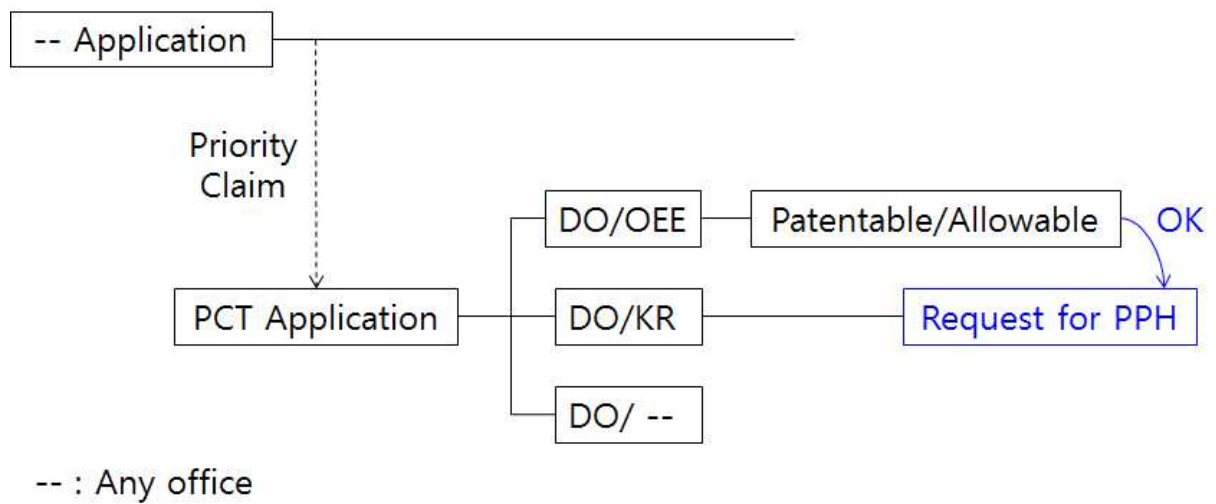
(Figure G) Paris route, but the first application is from the third country



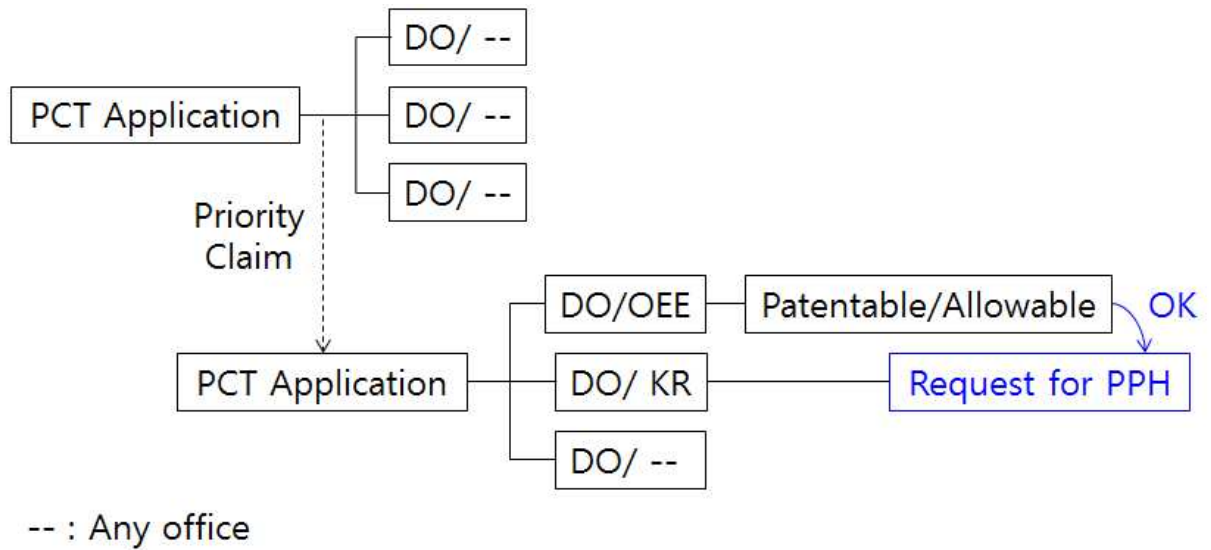
(Figure H) Paris route and domestic priority



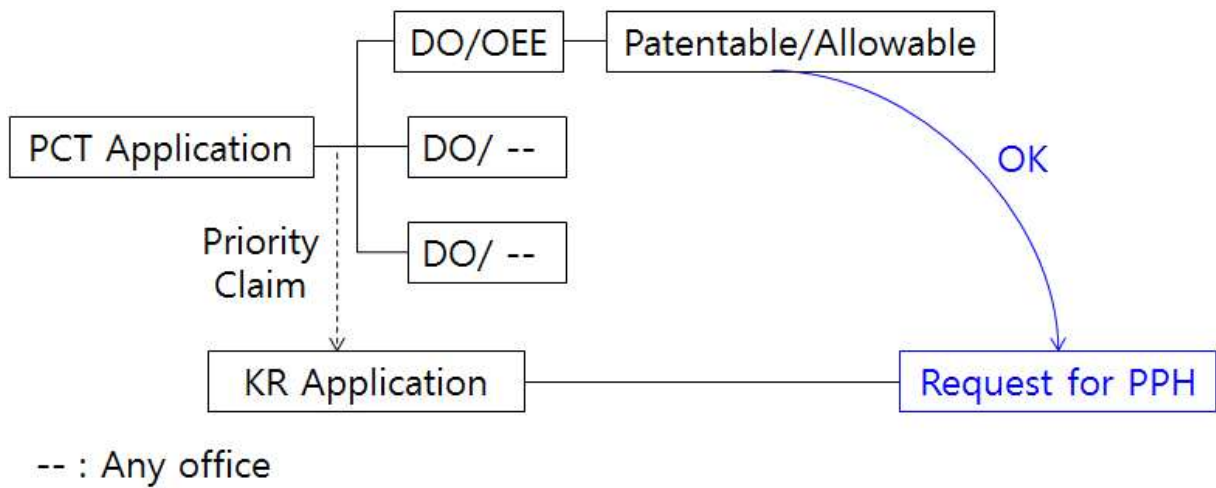
(Figure I) Paris route and PCT route, but the first application is from a third country.



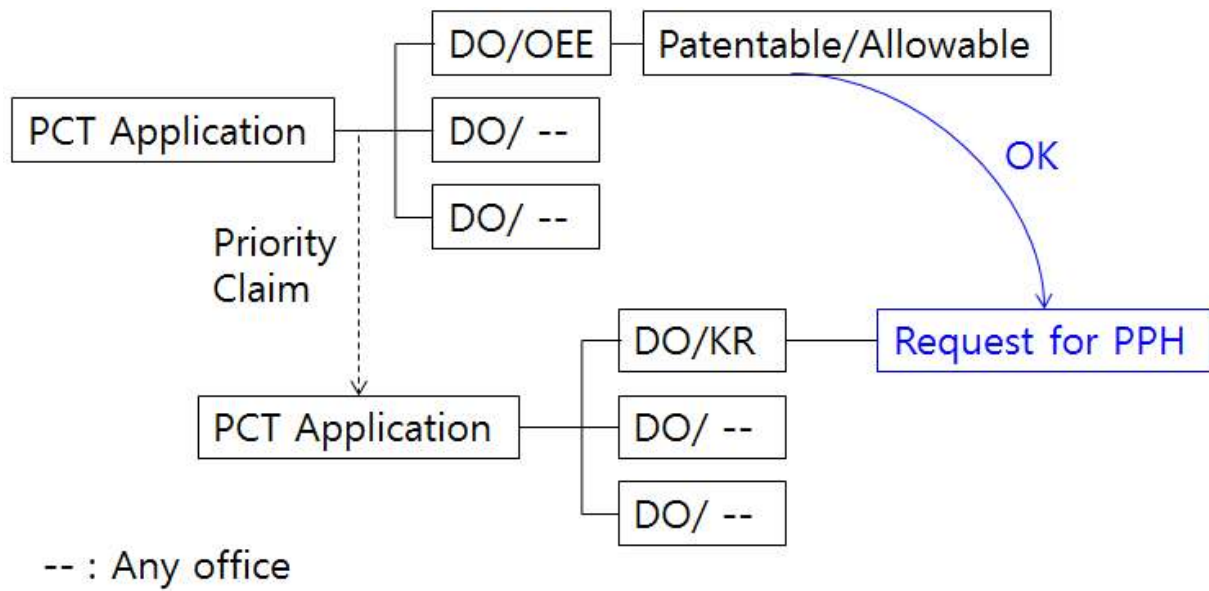
(Figure J) PCT route



(Figure K) Direct PCT route and PCT route



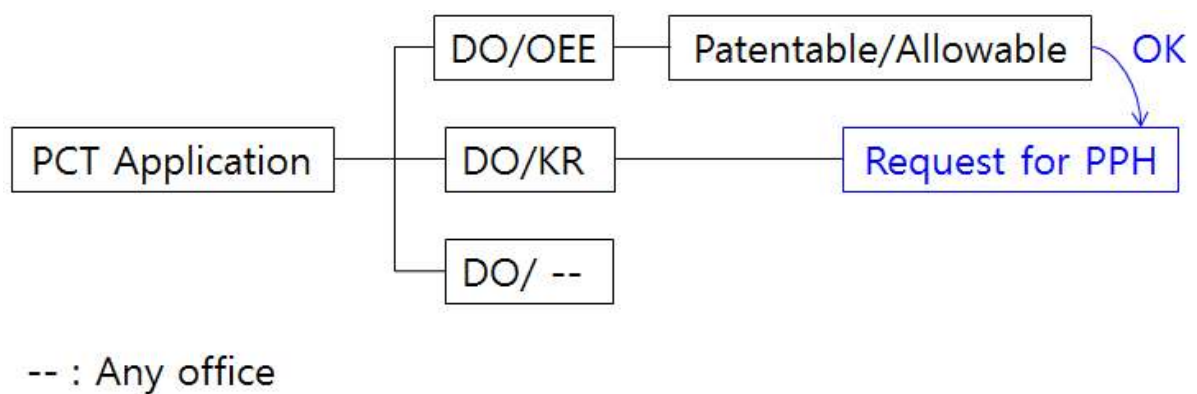
(Figure L) Direct PCT route and Paris route



(Figure M) Direct PCT route and PCT route

### CASE IV (Figure N)

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



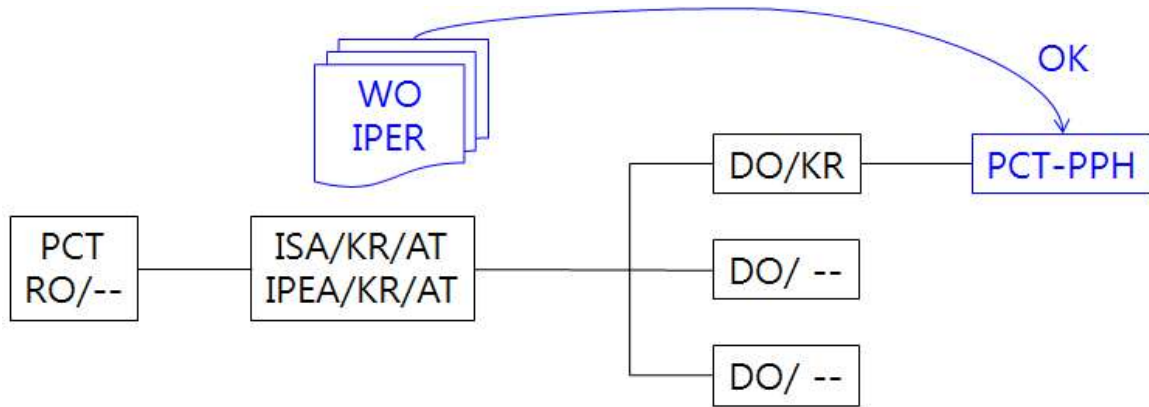
(Figure N) Direct PCT route

## ANNEX II

### Examples of KIPO applications eligible for the PCT-PPH

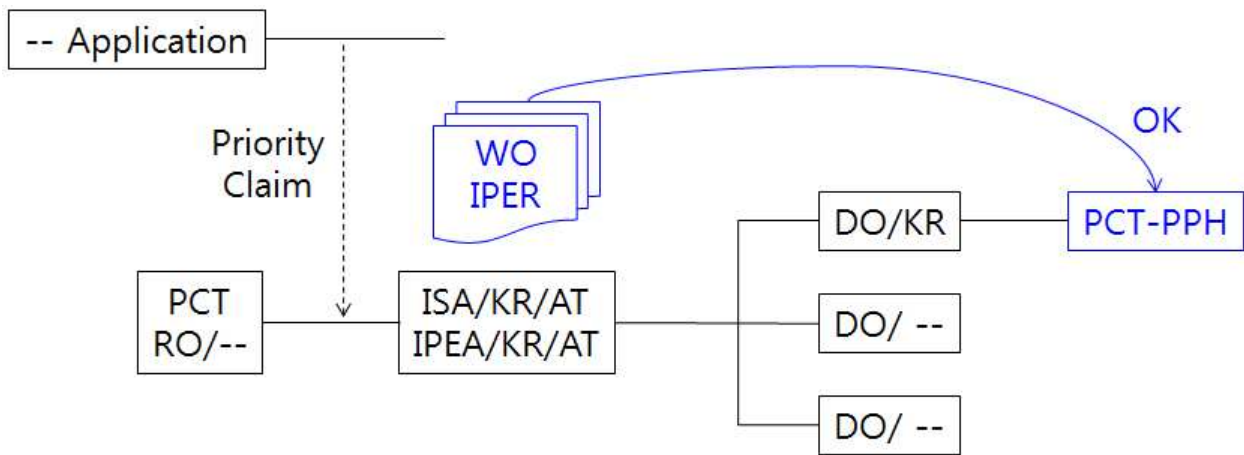
#### CASE I (Figure A, B and C)

KIPOO application is a national phase application of a corresponding international application.



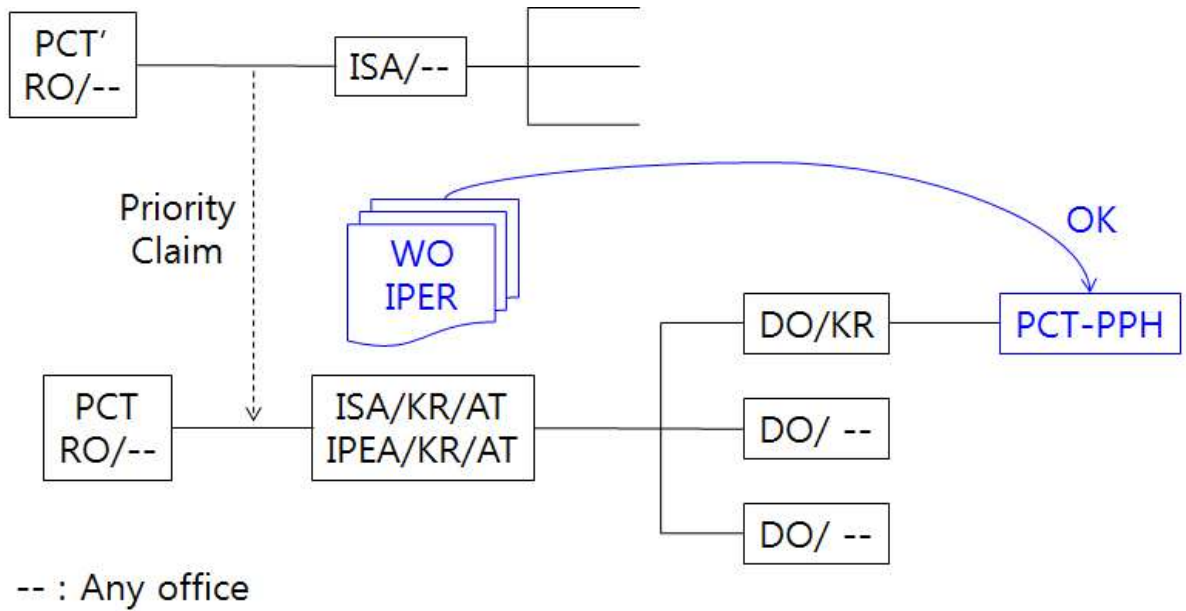
-- : Any office

(Figure A)



-- : Any office

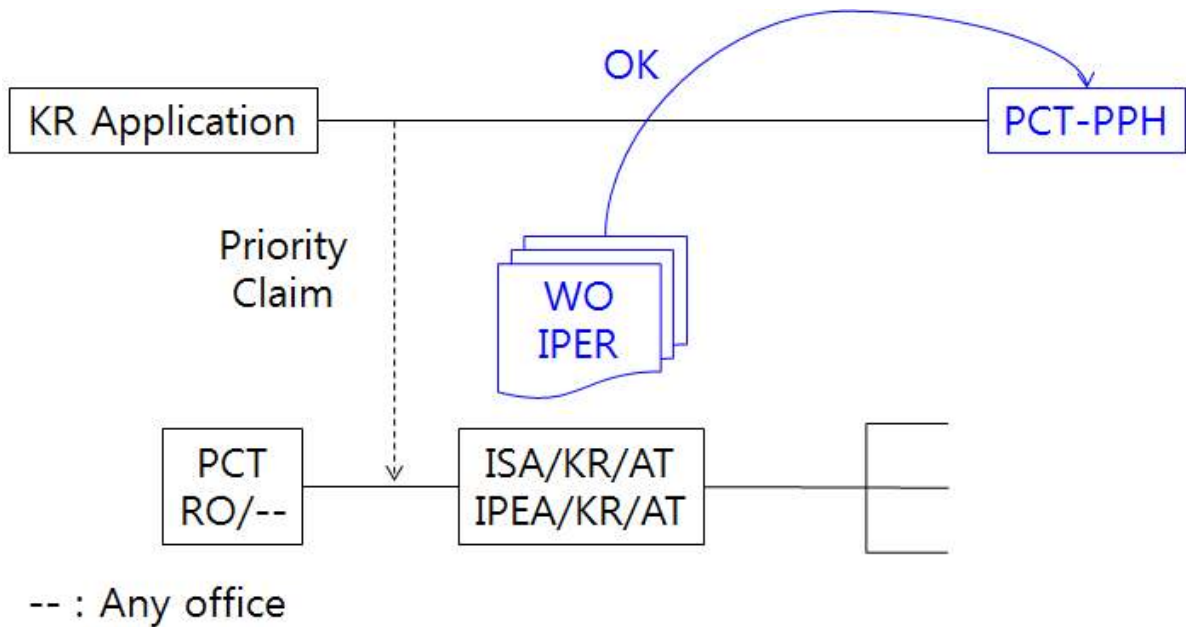
(Figure B)



(Figure C)

### CASE II (Figure D)

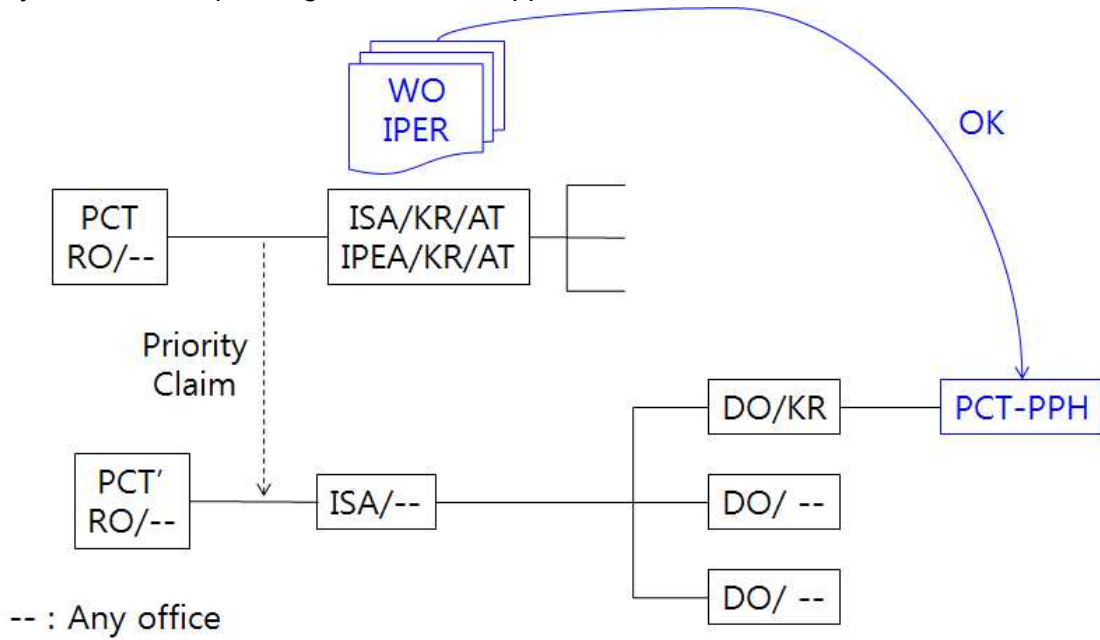
KIPO application is a national application as the basis of a priority claim for a corresponding international application.



(Figure D)

### CASE III (Figure E)

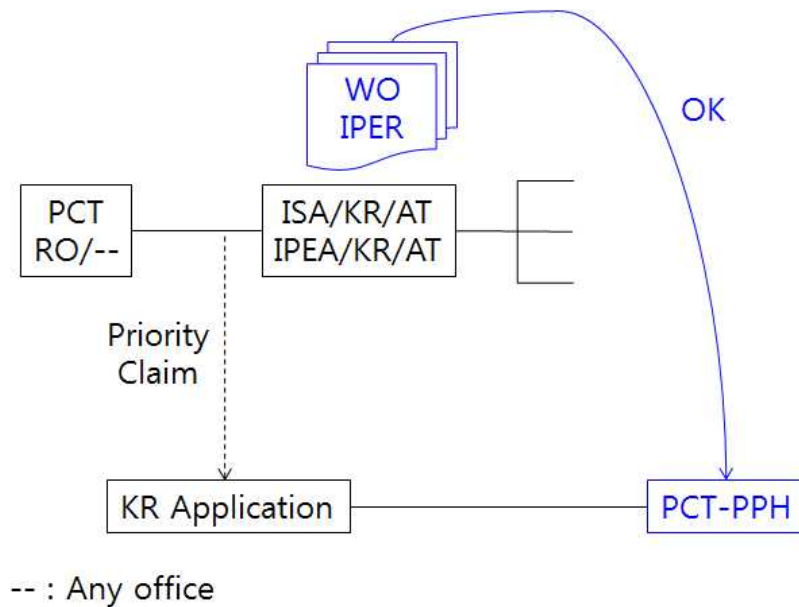
KIPOO application is a national phase application of an international application claiming priority from a corresponding international application.



(Figure E)

### CASE IV (Figure F)

KIPOO application is a national application claiming foreign priority from a corresponding international application.

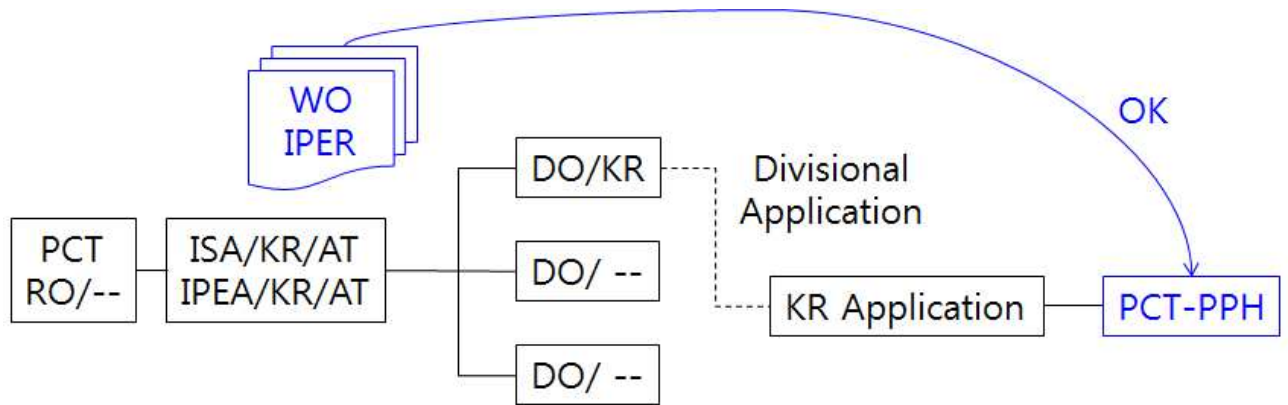


(Figure F)



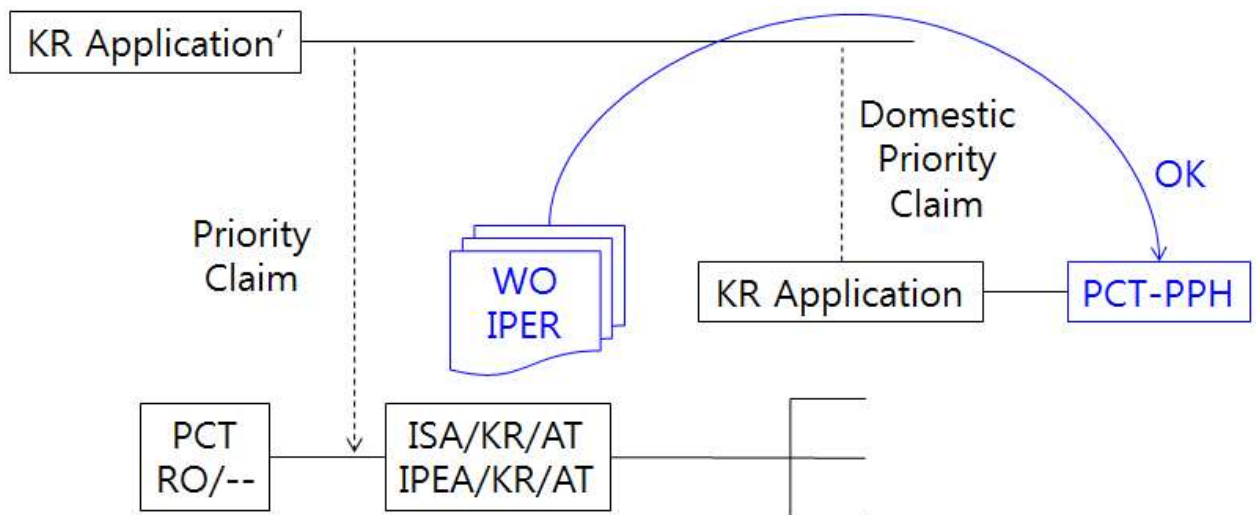
## CASE V (Figure G and H)

KIPO application is a derivative application (divisional application and application claiming domestic priority etc.) of an application which satisfies one of the above cases I-V.



-- : Any office

(Figure G)

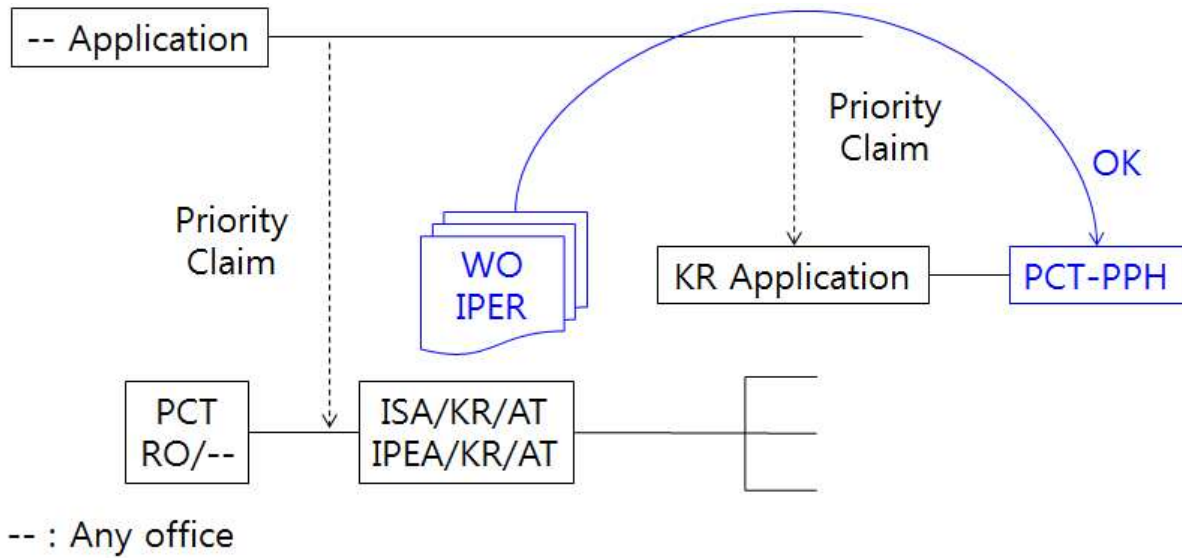


-- : Any office

(Figure H)

## CASE VI (Figure I)

KIPO application is a national application which shares common priority with a corresponding international application.



(Figure I)

## ANNEX III

### 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	“Patentable” claim(s)		PPH claim(s)		Correspondence
	Claim	Wording	Claim	Wording	
Case 1	1	A	1	A	PPH claim 1 is the same as “Patentable” claim 1.
Case 2	1	A	1 2	A A+a	PPH claim 1 is the same as “Patentable” claim 1. PPH claim 2 is created by adding a technical feature disclosed in the specification to “Patentable” claim 1.
Case 3	1 2 3	A A+a A+b	1 2 3	A A+b A+a	PPH claim 1 is the same as “Patentable” claim 1. PPH claims 2, 3 are the same as “Patentable” claims 3, 2, respectively.
Case 4	1	A	1	A+a	PPH claim 1 has an additional technical feature ‘a’ disclosed in the specification.

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

Case	“Patentable” claim(s)		PPH claim(s)		Explanation
	Claim	Wording	Claim	Wording	
Case 5	1	A product	1	A' method	PPH claim 1 claims to a method, whereas “Patentable” claim 1 claims to a product. (The technical feature of “Patentable” claim is the same as that of PPH claim, but categories of both claims are different.)
Case 6	1	A+B	1	A+C	PPH claim 1 is different from “Patentable” claim 1 in a component of the claimed invention. (PPH claim is created by altering part of the technical features of “Patentable” claim.)