

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 Mexican Institute of Industrial Property

The trial period of this Patent Prosecution Highway (PPH) pilot program will commence on July 1, 2012 and will end on June 30, 2014. The trial period may be extended if necessary until the Korean Intellectual Property Office (KIPO) and the Mexican Institute of Industrial Property (IMPI) receive the sufficient number of PPH requests to adequately assess the feasibility of the PPH program.

The Offices may also terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.

Applicants may request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with KIPO and satisfies the following requirements under the KIPO-IMPI PPH pilot program.

When filing a request for the PPH pilot program, an applicant must submit a request form "Request for Accelerated Examination under the Patent Prosecution Highway" to KIPO.

1. Requirements

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

(i) *an application which validly claims priority under the Paris Convention to the IMPI application(s) (examples are provided in ANNEX I, Figure A, B, C, F, G and H), or*

(ii) *a PCT national phase application without priority claim (examples are provided in ANNEX I, Figure I), or*

(iii) *an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in ANNEX I, Figure J, K and L).*

The KIPO application, which validly claims priority to multiple IMPI 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 for PPH request.

If there is an application firstly filed in the third country and having priority linkage to the

KIPO and/or IMPI application(s), the KIPO application is not eligible for PPH request (see Figure D and E in ANNEX I).

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

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

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

The office action includes:

- (1) Granted Patent
- (2) Decision to Grant a Patent
- (3) Notification of Reasons for Refusal
- (4) Decision of Refusal
- (5) Decision of Legal Appeal

Claims are also “determined to be patentable/allowable” in the following circumstances: If the IMPI 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 IMPI office action regarding that claim, and therefore, the claim is deemed to be patentable/allowable by IMPI.

(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 IMPI.*

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

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

A claim of KIPO which introduces a new/different category of claims to those claims determined to be patentable/allowable in IMPI is not considered to sufficiently correspond. For example, the IMPI 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.

It is not required to include “all” claims determined to be patentable/allowable by IMPI (the deletion of claims is allowable). For example, in the case where an application in IMPI contains 5 claims determined to be 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”.

Any claims amended or added before the substantive examination are required to sufficiently correspond to the claims indicated as patentable/allowable by IMPI.

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

The request for accelerated examination under the PPH must be accompanied by, 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 by attaching to “Request for Accelerated Examination under the Patent Prosecution Highway”.

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

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

Either Korean or English is acceptable as translation language. Machine translations will be admissible. But if it is impossible 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 those documents are available via Dossier Access System (DAS) of IMPI.

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

Either Korean or English is acceptable as translation language. Machine translations will be admissible. But if it is impossible 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 Dossier Access System (DAS) of IMPI.

(c) Copies of cited references

Reference documents which are not relevant to the reasons for refusal stated in the office action are not required to be submitted.

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. The translations of the references are unnecessary.

(d) Claim correspondence table

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

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

3. Example of "Request for Accelerated Examination under the Patent Prosecution Highway" for filing request of an accelerated examination under the PPH pilot program

(a) Circumstances

When an applicant files a request for participation in the PPH pilot program to KIPO, an applicant must submit a request form "Request for Accelerated Examination under the Patent Prosecution Highway".

The applicant must indicate that the application belongs to any of the categories (i) to (iii) of 1.(a), and that the accelerated examination is requested under the PPH pilot program.

The application number of the corresponding IMPI application must be written as well.

In the case where an IMPI application which has one or more claims that are determined to be patentable/allowable does not directly belongs to any of the categories (i) to (iii) of

1.(a) (for example, the divisional application of the basic application that belongs to any of the categories (i) to (iii) of 1.(a)), the application number of the IMPI application which has claims determined to be patentable/allowable and the relationship between those applications must be written.

(b) Documents to be submitted

The applicant must list all required documents mentioned above 2. in an identifiable way, even when the applicant is exempted to submit certain documents.

(c) Notice

An applicant may file the "Request for Accelerated Examination under the Patent Prosecution Highway" to KIPO via either paper-based or on-line procedures.

4. Procedure for the accelerated examination under the PPH

KIPO 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 KIPO 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. The applicant will be given opportunity to perfect the request. If not perfected, the applicant will be notified and the application shall be assigned to the regular examination track. Then the applicant may resubmit the request.

KIPO will not notify the applicant of the acceptance for assigning a special status for accelerated examination under the PPH, but instead applicant may recognize it by the reception 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)

【대상국가】 (Office of First Filing)

【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 OFF)

【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 OFF)

【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)

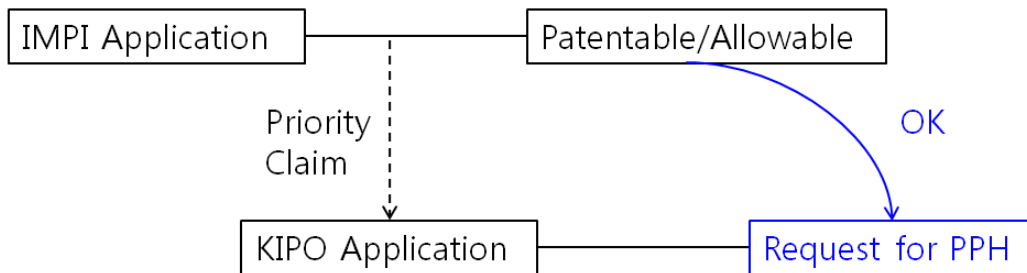
【제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

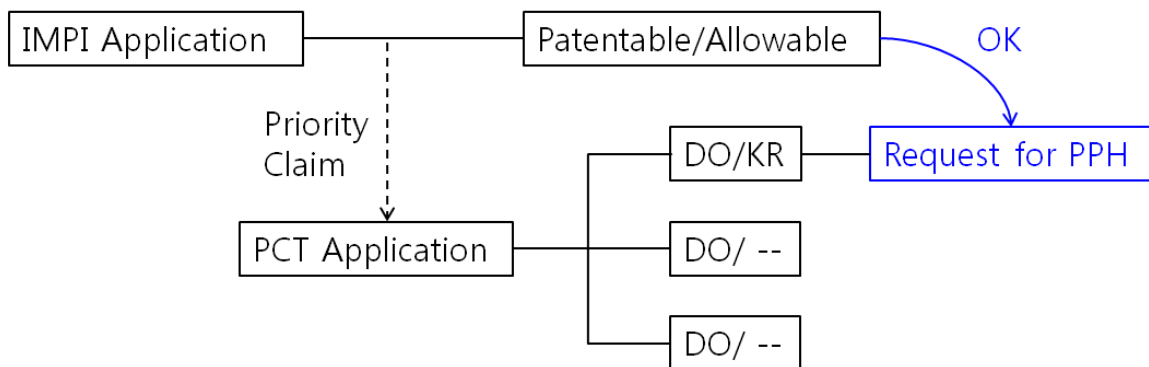
【청구항간 대응관계설명표】 (Claim Correspondence Table)

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

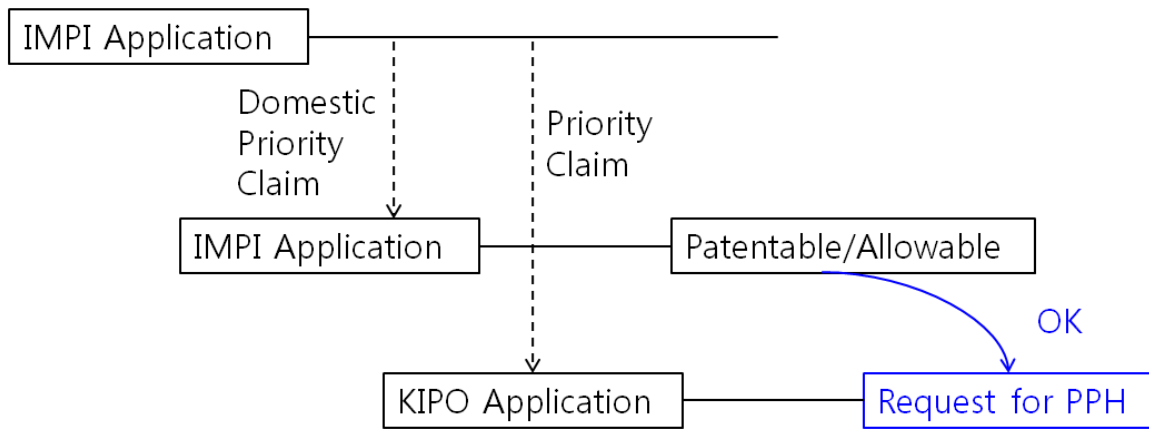
ANNEX I



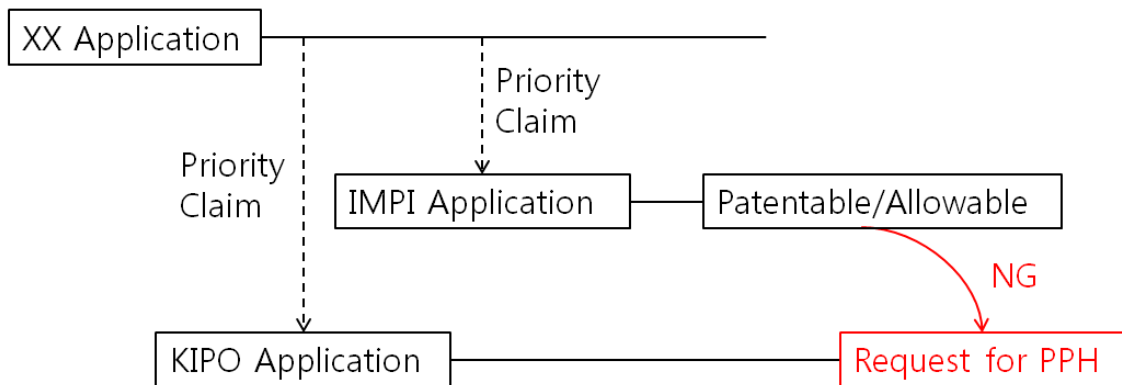
(A) A case meeting requirement (a) (i)
- Paris Route



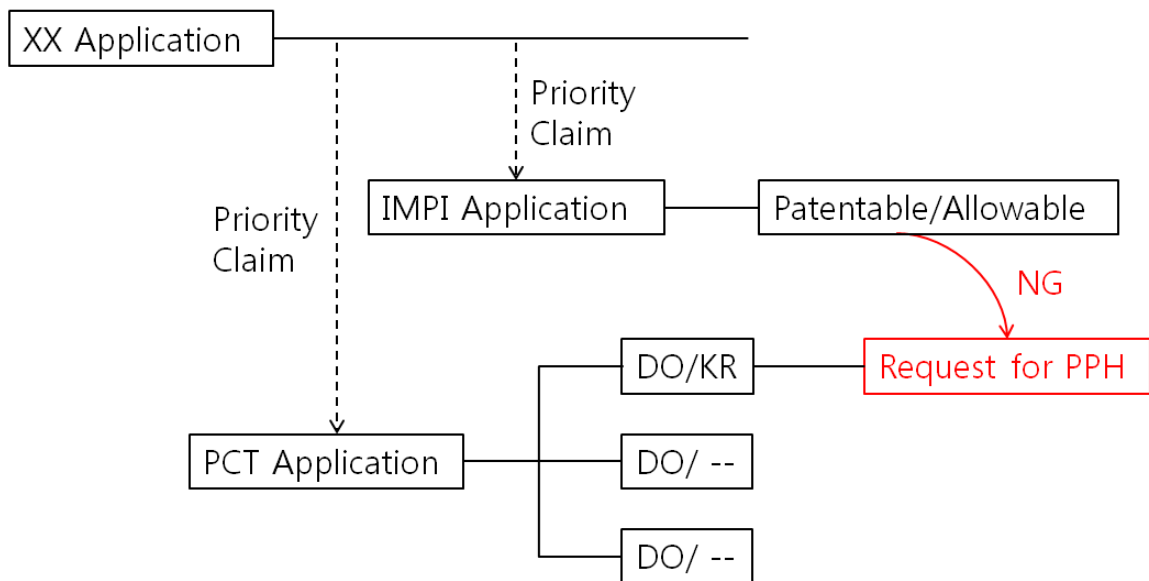
(B) A case meeting requirement (a) (i)
- Paris Route and PCT Route



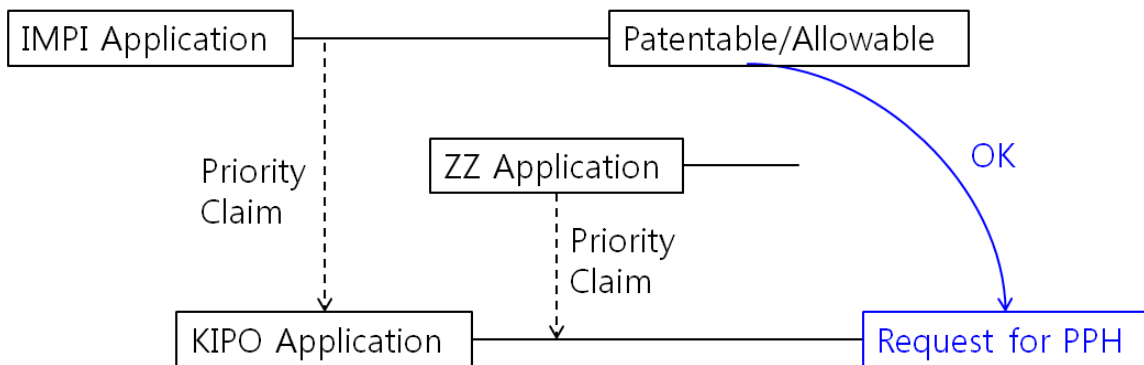
(C) A case meeting requirement (a) (i)
- Paris Route and Domestic Priority



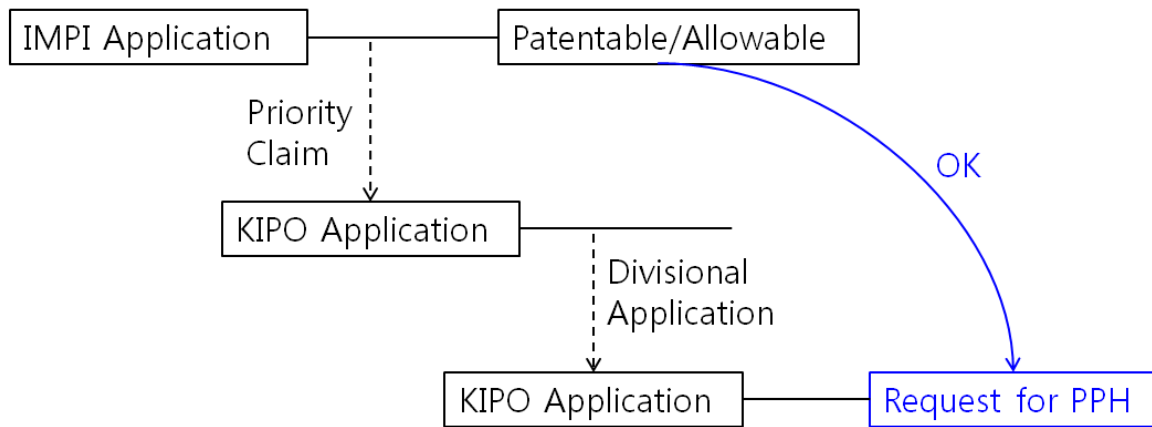
(D) A case not meeting requirement (a) (i)
- Paris Route, but the first application is from the third country (XX)



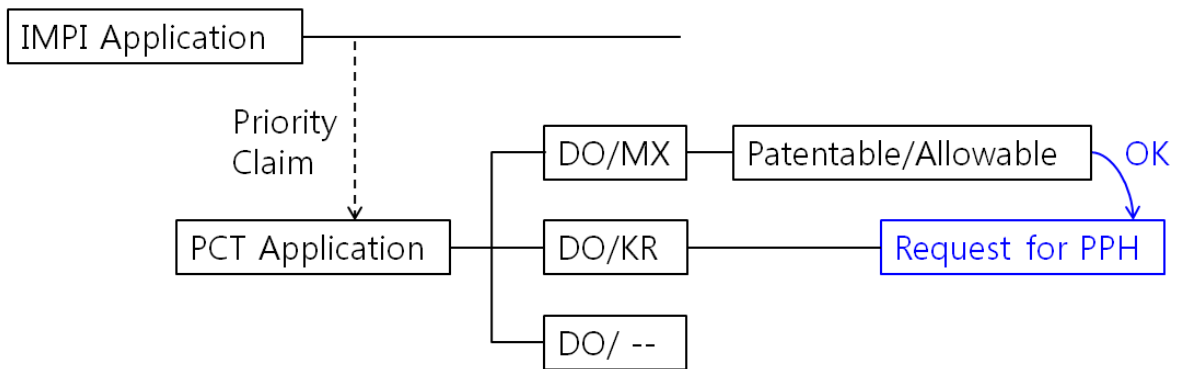
- (E) A case not meeting requirement (a) (i)
 - Paris Route and PCT Route,
 but the first application is from the third country (XX)



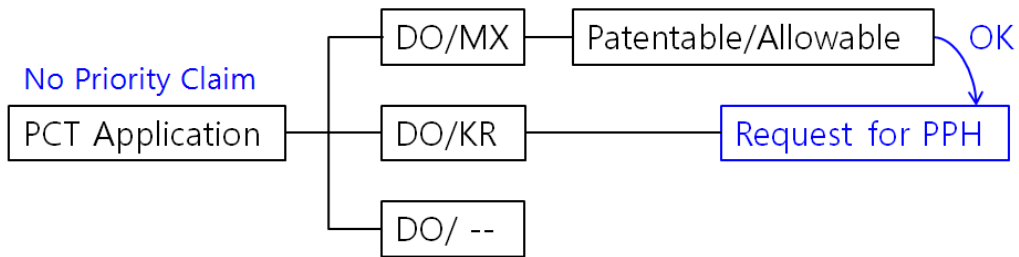
- (F) A case meeting requirement (a) (i)
 - Paris Route and Complex Priority from any Office (ZZ)



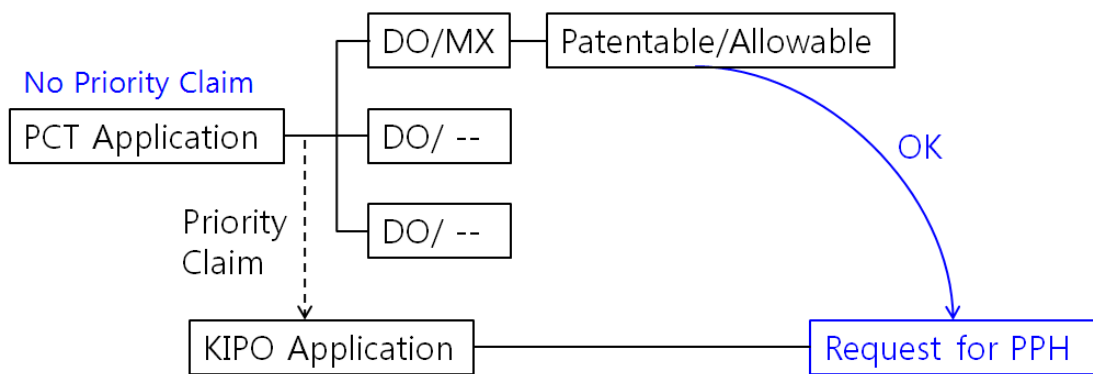
(G) A case meeting requirement (a) (i)
- Paris Route and Divisional Application



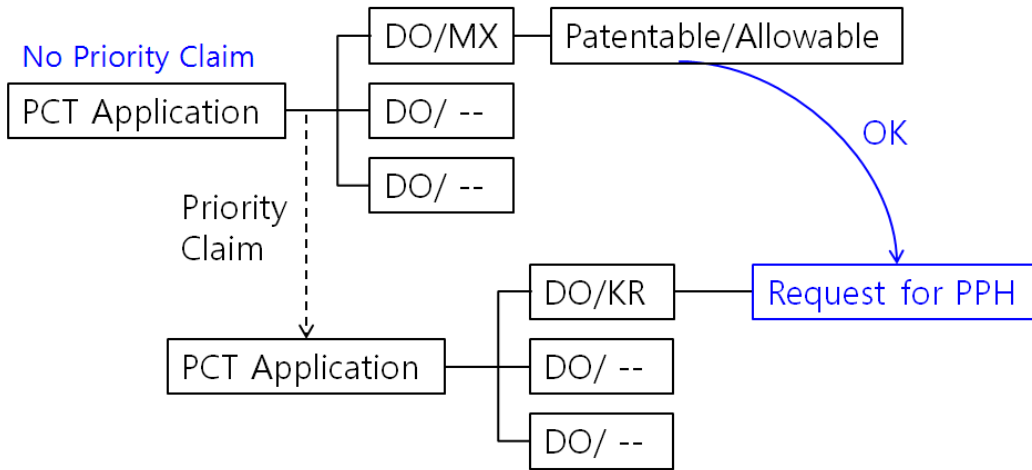
(H) A case meeting requirement (a) (i)
- Paris Route and Direct PCT Route



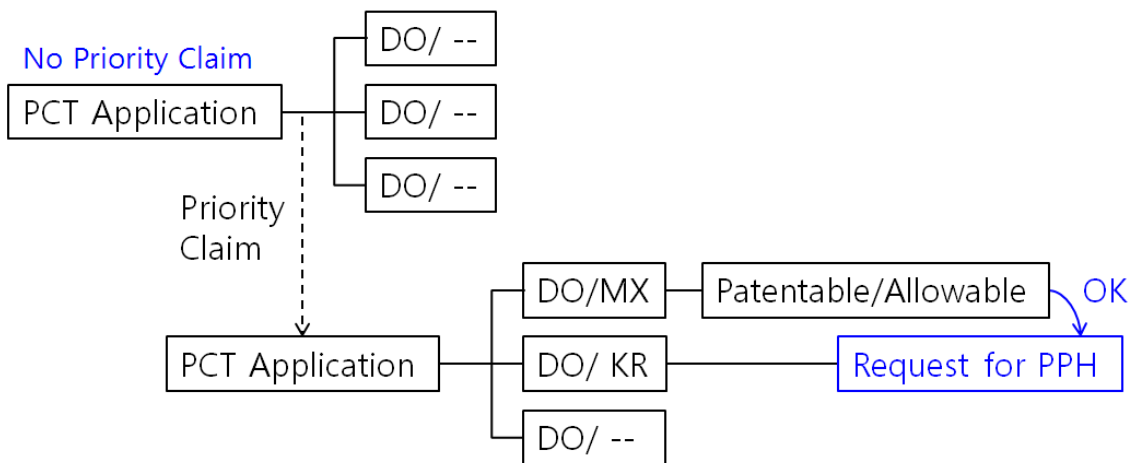
(I) A case meeting requirement (a) (ii)
- Direct PCT Route



(J) A case meeting requirement (a) (iii)
- PCT Route and Paris Route



(K) A case meeting requirement (a) (iii)
 - PCT Route and Paris Route



(L) A case meeting requirement (a) (iii)
 - Paris Route and Direct PCT Route

ANNEX II

Example of Claim Correspondence Table

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.)