

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 Intellectual Property Office of Singapore

The trial period of this Patent Prosecution Highway (PPH) pilot program will commence on 1 January 2013 and will end on 1 January 2015. The trial period may be extended if necessary until the Korean Intellectual Property Office (KIPO) and the Intellectual Property Office of Singapore (IPOS) 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-IPOS 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 IPOS 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 IPOS 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.

- (b) At least one corresponding application exists in IPOS and has one or more claims that are determined to be patentable/allowable in a substantive examination carried out by IPOS. The phrase “substantive examination carried out by IPOS” implies a substantive examination carried out in the name of IPOS or a substantive examination adopting examination results from the USTPO, the UKIPO, the JPO or CIPO as a “prescribed patent office” referred to in the Singapore patent legislation.**

The corresponding application(s) can be an application which forms the basis of the priority claim, an application which derived from the IPOS application which forms the basis of the priority claim (e.g., a divisional application of the IPOS application or an application which claims domestic priority to the IPOS application (see Figure C in ANNEX I)), or an IPOS 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.

- (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 a substantive examination carried out by IPOS. The phrase “substantive examination carried out by IPOS” implies a substantive examination carried out in the name of IPOS or a substantive examination adopting examination results from the USTPO, the UKIPO, the JPO or CIPO as a “prescribed patent office” referred to in the Singapore patent legislation.**

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 IPOS, or the claims in KIPO are narrower in scope than the claims in IPOS.

In this regard, a claim that is narrower in scope occurs when an IPOS 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 KIPO which introduces a new/different category of claims to those claims determined to be patentable/allowable in IPOS is not considered to sufficiently correspond. For example, the IPOS 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 necessary to include “all” claims determined to be patentable/allowable by IPOS in an application in KIPO (the deletion of claims is allowable). For example, in the case where an application in IPOS 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 after the grant of the request for participation in the PPH pilot program need to sufficiently correspond to the claims indicated as patentable/allowable in the IPOS application.

(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 needed 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 substantive examination for patentability in IPOS), and translations of thereof

(i) When the substantive examination of IPOS was carried out in the name of IPOS:

Copies of all office actions which were issued for the corresponding application in the name of IPOS, 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 office actions, the examiner may request the applicant to resubmit translations.

(ii) When the substantive examination of IPOS was carried out by adopting examination results from the USTPO, the UKIPO, the JPO or CIPO as a “prescribed patent office” referred to in the Singapore patent legislation:

Copies of all office actions which were issued by the prescribed patent office such as the USPTO, the UKIPO, the JPO or CIPO, 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 office actions, the examiner may request the applicant to resubmit translations.

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

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

(i) When the substantive examination of IPOS was carried out in the name of IPOS:

Copies of all claims which were determined to be patentable/allowable in a substantive examination carried out in the name of IPOS, 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 office actions, the examiner may request the applicant to resubmit translations.

(ii) When the substantive examination of IPOS was carried out by adopting examination results from the USPTO, the UKIPO, the JPO or CIPO as a “prescribed patent office” referred to in the Singapore patent legislation:

Copies of all claims which were determined to be patentable/allowable in a substantive examination adopting examination results from the prescribed patent office such as the USPTO, the UKIPO, the JPO or CIPO, 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 office actions, the examiner may request the applicant to resubmit translations.

It is not required to submit the copies of all claims determined to be patentable/allowable and translations thereof when those documents are available via Dossier Access System (DAS) of the prescribed patent office.

(c) Copies of cited references

If the references are patent documents, the applicant is not required to submit them. When the 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 IPOS application.

If the substantive examination of IPOS was carried out by adopting examination results from the USPTO, the UKIPO, the JPO or CIPO as a “prescribed patent office” referred to in the Singapore patent legislation, the applicant must submit an additional claim correspondence table indicating how all claims of the KIPO application correspond to the patentable/allowable claims of the prescribed patent office referred to in the Singapore patent legislation 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 IPOS application must be written as well.

If the substantive examination of IPOS was carried out by adopting examination results from the USPTO, the UKIPO, the JPO or CIPO as a “prescribed patent office” referred to in the Singapore patent legislation, the applicant must indicate the application number of the prescribed patent office referred to in the Singapore patent legislation application.

In the case where an IPOS 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 IPOS 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)

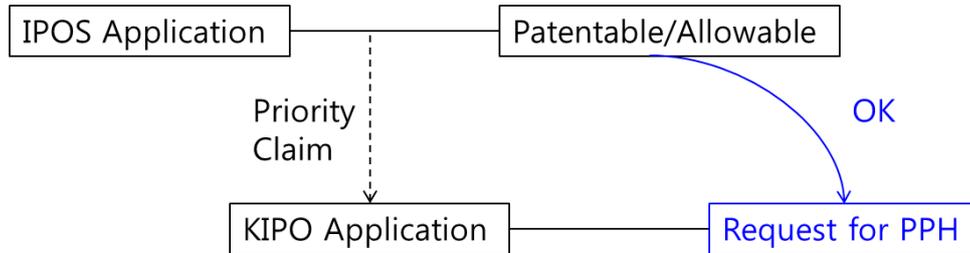
【제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

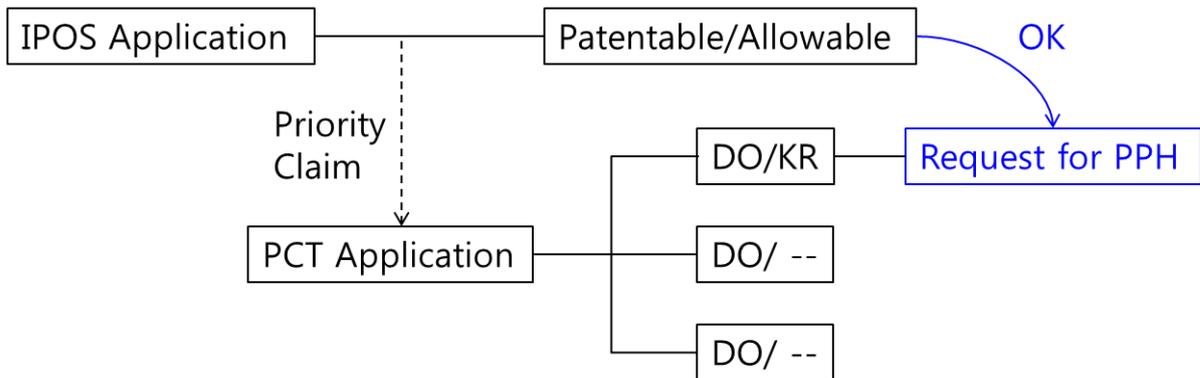
【청구항간 대응관계설명표】 (Claim Correspondence Table)

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

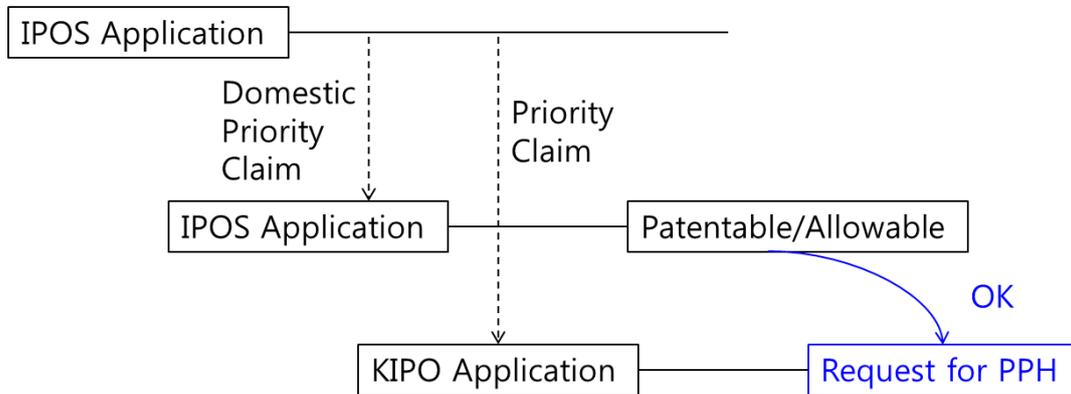
ANNEX I



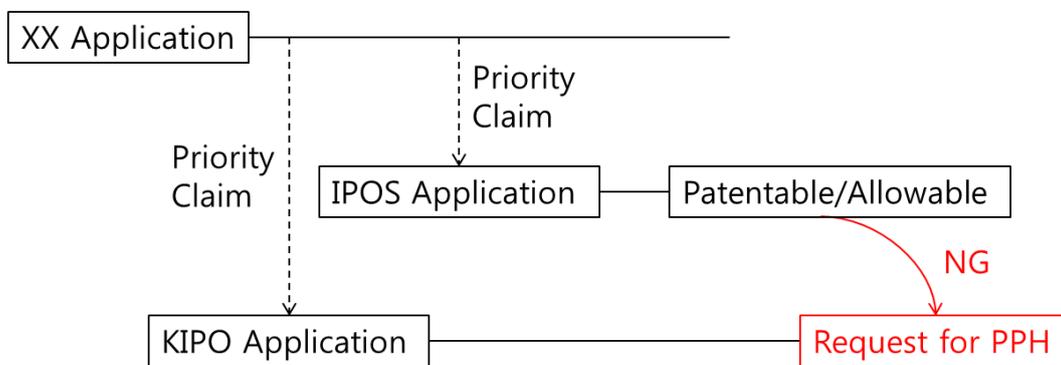
(A) A case meeting requirement (a) (i)
- Paris Route



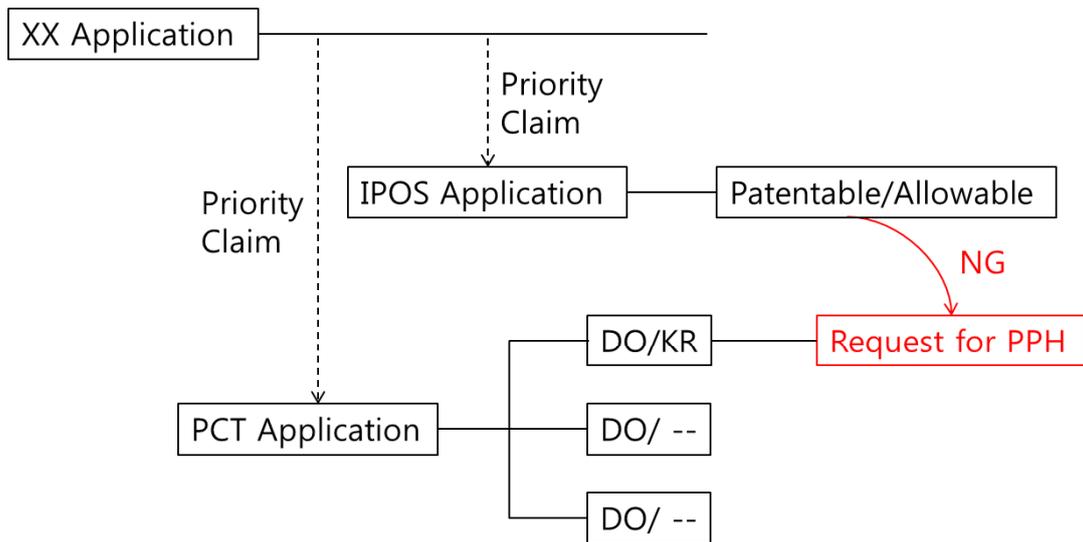
(B) A case meeting requirement (a) (i)
- Paris Route and PCT Route



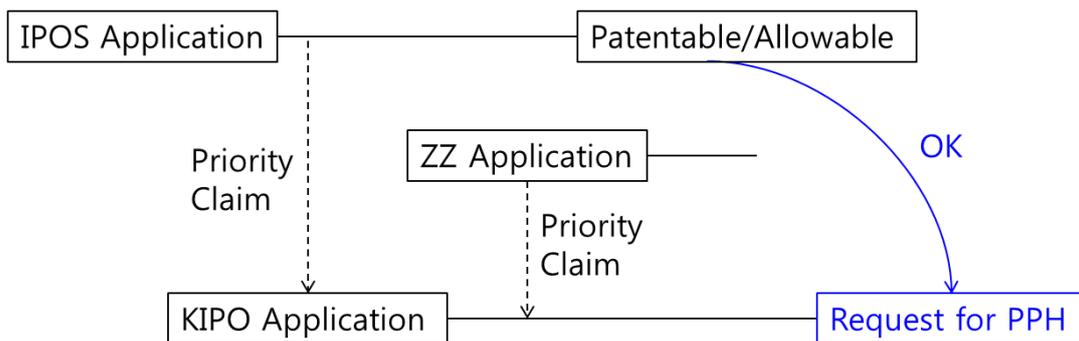
(C) A case meeting requirement (a) (i)
- Paris Route and Domestic Priority



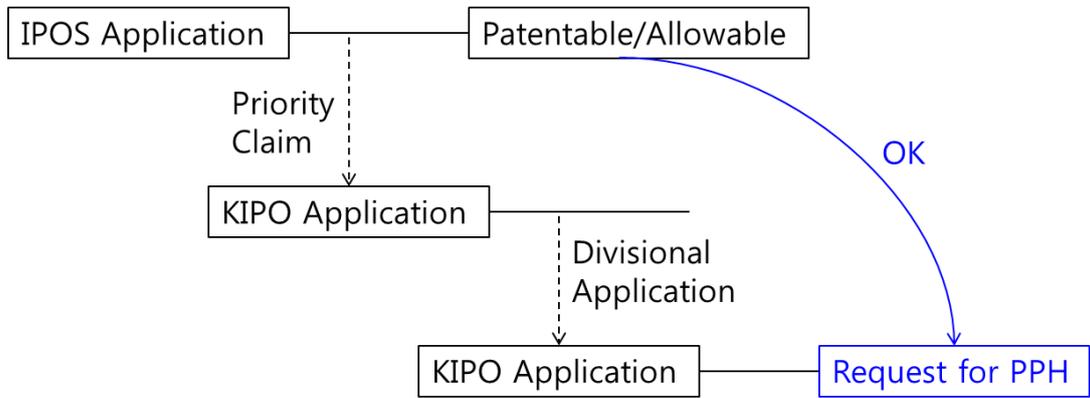
(D) A case not meeting requirement (a) (i)
- Paris Route, but the first application is from the third country (XX)



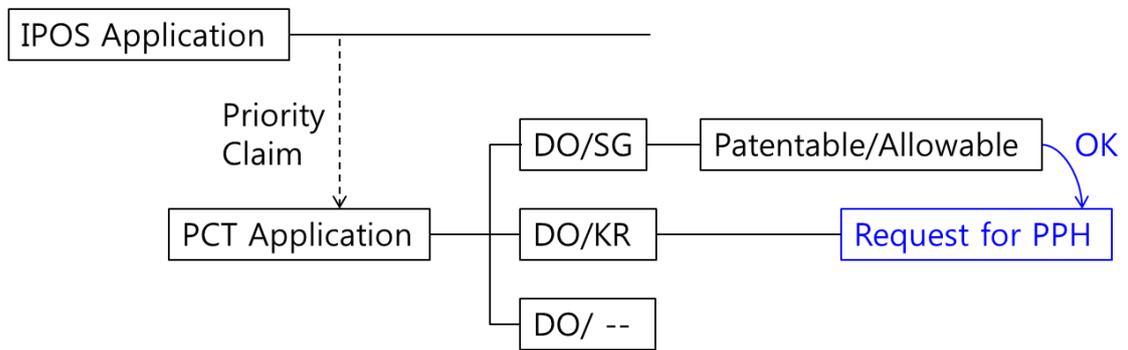
(E) A case not meeting requirement (a) (i)
 - Paris Route and PCT Route,
 but the first application is from the third country (XX)



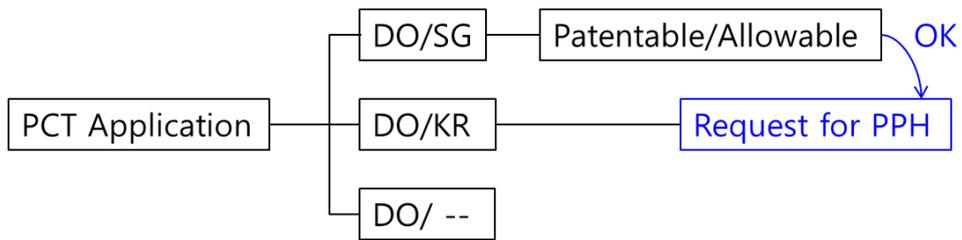
(F) A case meeting requirement (a) (i)
 - Paris Route and Complex Priority from any Office (ZZ)



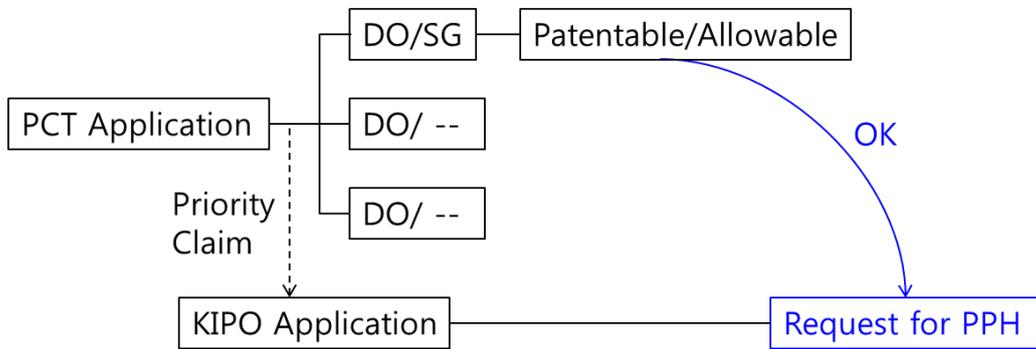
(G) A case meeting requirement (a) (i)
- Paris Route and Divisional Application



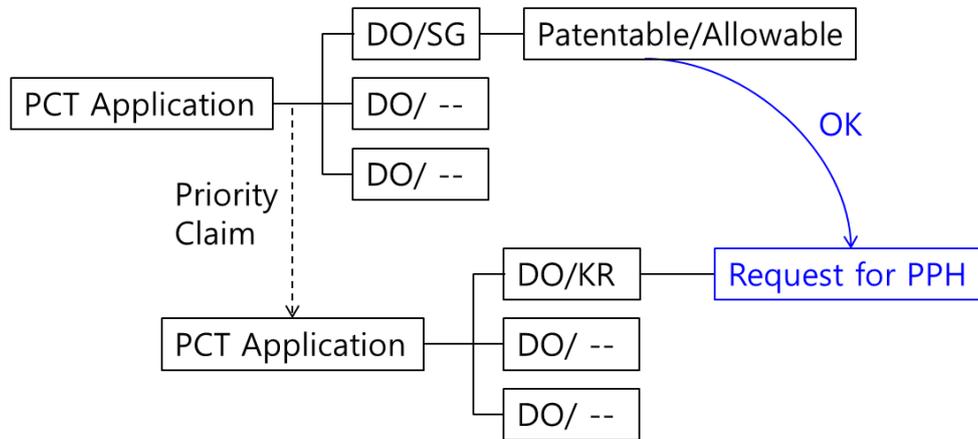
(H) A case meeting requirement (a) (i)
- Paris Route and Direct PCT Route



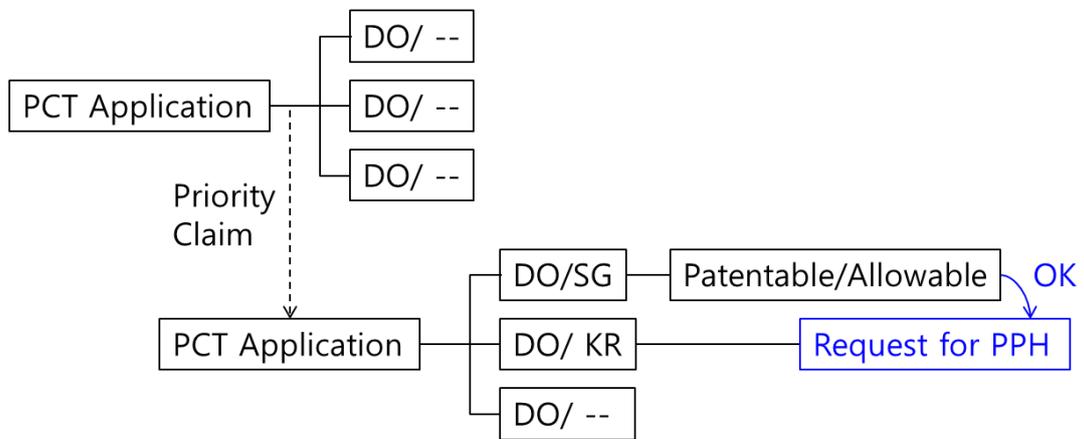
(I) A case meeting requirement (a) (ii)
 - Direct PCT Route



(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

Examples 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.)