

Patent Prosecution Highway Pilot Program between the Canadian Intellectual Property Office and the Korean Intellectual Property Office

I. Background

The Patent Prosecution Highway (PPH) is an initiative currently being used by leading Intellectual Property Offices (IPOs) globally, such as the Korean Intellectual Property Office (KIPO), the United States Patent and Trademark Office (USPTO), the Japan Patent Office (JPO), and the Danish Patent and Trademark Office (DKPTO). The PPH provides a means of significantly accelerating examination of patent applications if examination work has already been conducted at another intellectual property office. Under the PPH agreements, if claims of an application have been found to be allowable by a first intellectual property office, an accelerated examination can be requested at a second intellectual property office.

This pilot program can be compared to the PPH pilot program between CIPO and the USPTO, initiated on January 28, 2008 and extended for a period of two years ending on January 28, 2011.

This initiative falls under CIPO's International Strategic Direction, as outlined in the CIPO Business Plan, contributing to the improvement of the worldwide IP system and benefiting Canadians through influencing international IP administrative policies and practices, and sharing and acquiring best practices.

II. Patent Prosecution Highway Pilot Program

The PPH was established to enable an applicant whose claims are determined to be allowable in the Office of first filing (OFF) to have the corresponding application filed in the Office of second filing (OSF) advanced out of turn for examination while at the same time allowing the OSF to exploit the search and examination results of the OFF.

Where the KIPO is the OFF and the KIPO application contains claims that are determined to be allowable, the applicant may request accelerated examination in CIPO for the corresponding application filed in CIPO as the OSF. Each Canadian patent application will be examined in accordance with the Canadian *Patent Act* and *Rules* and CIPO's Patent Office Practice.

The procedures and requirements for filing a request to CIPO for participation in the PPH pilot program are available from the CIPO PPH website at <http://www.cipo.ic.gc.ca/pph/>.

Where the KIPO is the OSF and the corresponding application filed in CIPO as the OFF contains claims that are determined to be allowable, the applicant may file a request for accelerated examination under the PPH pilot program to the KIPO.

The required forms, procedures, and requirements for filing a request to the KIPO for participation in the PPH pilot program are available from the KIPO website at <http://www.kipo.go.kr/kpo/eng/>.

III. Trial Period for the PPH Pilot Program

The PPH pilot program will commence on October 1, 2009, for a period of two years ending on September 30, 2011. The trial period may be extended if necessary to adequately assess the feasibility of the PPH program. The KIPO and CIPO will evaluate the results of the pilot program to determine whether the program should be fully implemented after the trial period. The Offices may also terminate the PPH pilot program early if the volume of participation exceeds manageable level, or for any other reason. Notice will be published if the PPH pilot program will be terminates before the September 30, 2011 date.

During the pilot CIPO will process requests for advanced prosecution under the PPH program free of charge. CIPO will evaluate what, if any, fees should apply for this service if it later becomes permanent. Regular fees (Schedule II of the *Patent Rules*) for requesting examination will continue to apply during the PPH pilot.

Further Information

Any inquiries concerning the PPH may be directed to the PPH Project Manager at pph@ic.gc.ca, or by calling the CIPO Client Service Center at 819-934-0544 or toll-free at 1-866-997-1936.

Requirements and Procedures to File a Request to CIPO for the Patent Prosecution Highway Pilot Program Between CIPO and the KIPO

Request to CIPO for accelerated examination under PPH

An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to CIPO by submitting a letter requesting accelerated examination under the PPH accompanied by a completed PPH request form and the relevant supporting documents.

The PPH request form must be the uppermost document to ensure that the request is correctly processed. The PPH request form is given in Annex A and is also available online at the CIPO PPH website at <http://www.cipo.ic.gc.ca/pph/>.

Requirements for requesting accelerated examination under the PPH pilot program at CIPO

There are five requirements for requesting accelerated examination under the PPH pilot program at CIPO. These are:

- a) The CIPO application is either:
 - (i) a nationally filed application which validly claims priority under the Paris Convention from either a single KIPO national application or multiple KIPO national applications; or
 - (ii) a nationally filed application which validly claims priority under the Paris Convention from a PCT application which has no priority claims; or
 - (iii) a PCT national phase application where the PCT international application has validly claimed priority from a KIPO national application or multiple KIPO national applications; or
 - (iv) a PCT national phase application where the PCT international application has no priority claims; or
 - (v) a PCT national phase application where the PCT international application has validly claimed priority from a PCT international application which has no priority claims; or
 - (vi) a divisional of an application referred to in any of (i) to (v).

Illustrated examples of Canadian patent applications that may request accelerated examination under the PPH pilot program at CIPO are given in Annex D.

- b) At least one corresponding KIPO national application¹ has one or more claims that are determined to be allowable by the KIPO.
- c) All claims on file, as originally filed or as amended, for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the KIPO.

Claims shall be considered to sufficiently correspond where, except for differences due to translations and claim format, the claims on file are of the same or similar scope as the claims in the KIPO, or the claims on file are narrower in scope than the claims in the KIPO.

¹ May include a KIPO Utility Model filed from October 1, 2006 according to the new Utility Model Act.

In this regard, a claim on file which is narrower in scope occurs when a KIPO claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims). When possible, the claim on file should be presented in dependent form.

A claim on file which introduces a new/different category of claims to those claims indicated as allowable in the KIPO is not considered to sufficiently correspond.

CIPO shall consider corresponding KIPO claims to be allowable as indicated in a KIPO Granted Patent Publication and/or in an Office Action².

An example of claims on file which comply with requirement (c) is given in Annex C. Illustrated examples of office actions are given in Annex E.

- d) The CIPO application is open to public inspection.
- e) CIPO has received a request for examination, but has not begun examination of the application.

Note that where the relationship between the KIPO application that contains the allowable claims and the CIPO application is not clearly apparent, the applicant must explain the relationship between these applications.

Required documents for accelerated examination under the PPH pilot program at CIPO

The following relevant documentation will be needed to support a request for accelerated examination under the PPH pilot program at CIPO:

- a) a translation into English or French of the KIPO Granted Patent Publication and/or all the KIPO office action(s) issued in the KIPO application(s). An applicant is required to provide a professional translation of the office action(s) in order to ensure the accuracy of the translation. The patent examiner will use the translation to understand at least the outline of the office action(s).

Where the KIPO office action(s) are available on the KIPO K-PION³, an applicant is not required to submit translations of the office action(s) because the original office action(s) and its English machine translations are available to the CIPO examiner.

- b) a translation into English or French of the claims in the KIPO Granted Patent Publication or a translation of the claims indicated as allowable by the KIPO in the above office action(s). An applicant is required to provide a professional translation of the claims in order to ensure the accuracy of the translation. The CIPO patent examiner will use the translation to understand the scope of the claims and to determine the requirement of claim correspondence.

² A KIPO Office Action includes a "Notice of Submission of Opinion", "Notice of Final Rejection" or "Written Decision on Registration". Refer to Annex E for illustrated examples.

³ Korean Patent Information Online Network (K-PION) is a network which provides an English translation of KIPO's file wrapper information and full text search to authorized government patent offices; applicants do not have access to K-PION.

- c) a completed claim correspondence table showing the relationship between the claims of the CIPO application for accelerated examination under the PPH and the claims of the corresponding KIPO application considered allowable by the KIPO. A sample claim correspondence table is given in Annex B.

The applicant can either provide the copies of the relevant documentation with the request for accelerated examination under the PPH or request that CIPO obtain the documents required from the KIPO if these documents are available on the K-PION.

Where the relevant documentation is not available on the K-PION, the applicant is not required to submit the Korean language version of the office actions but is required to submit a translation thereof. Where a KIPO Granted Patent Publication is the relevant document, the office actions of the corresponding KIPO application(s) must be available on the K-PION or the applicant is required to submit a translation thereof. When submitting the KIPO Granted Patent Publication, only the cover page is required.

An applicant who requests participation in the PPH is required to submit English or French language translations of the relevant documentation.

If it is impossible for the patent examiner to understand even the outline of the translated office action(s) or the scope of the translated claims due to inadequate translation, the examiner can request the applicant to resubmit translations. A request for the PPH will not be rejected on the basis that the translation is inadequate until after at least one opportunity is given to submit adequate translations.

Where not publicly available, copies of the patent documents cited by the KIPO must be provided with the request. Non-patent literature cited by the KIPO should always be submitted.

The CIPO patent examiner may requisition translation of citations using the standard CIPO examination procedure (section 29 of the *Patent Rules*) where translation of a cited document is necessary. However, applicants may file translations as part of the supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the citations, if they so desire. An applicant does not have to submit translations of KR patent documents where those documents are provided via K-PION.

The applicant need not provide further copies of documentation if they have already submitted the documents noted above to CIPO through simultaneous or past procedures related to the application.

Procedures for filing a request for accelerated examination under the PPH pilot program at CIPO

The applicant files a letter requesting accelerated examination under the PPH pilot program to CIPO, a completed PPH request form, and the relevant supporting documents as noted above.

The request for examination under PPH may be made by mail, fax, or electronically via the Industry Canada website as per the CIPO patent correspondence procedures. The PPH request form must be the uppermost document to ensure that the request is correctly processed. The PPH request form is given in Annex A and is also available online at the CIPO PPH website.

All subsequent correspondence with the office must be clearly identified as a PPH pilot program application to ensure that the correspondence is correctly processed.

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

If the CIPO application is not open for public inspection at the time of request, the applicant must authorize the application be made open for public inspection in the letter.

It is recommended that the applicant not only focus on the claims when making the PPH request but additionally review the application as a whole and amend the application to correct known informalities that result from the differences between CIPO and KIPO patent application requirements.

These informalities include defects such as a statement that incorporates by reference another document (section 81(1) of the *Patent Rules*), and reference to documents that are not available to the public (subsection 81(2) of the *Patent Rules*).

Procedures of examination under the PPH pilot program at CIPO

The PPH request will be considered by a Patent Examiner and if all requirements are met, the patent examiner will conduct the accelerated examination. Each Canadian patent application will be examined in accordance with the Canadian *Patent Act* and *Rules* and CIPO's Patent Office Practice.

If the patent examiner determines that the claims on file do not sufficiently correspond to one or more of those claims indicated as allowable in the KIPO, the applicant will be notified that the request for accelerated examination is not granted. Further, the patent examiner will have access to the KIPO K-PION machine translation of the claims to verify the translation and correspondence of the claims as submitted by the applicant. To re-enter the PPH, the applicant must amend the claims accordingly and reapply altogether.

At any time during the prosecution of a PPH application, if the patent examiner determines that the claims on file do not sufficiently correspond to one or more of those claims indicated as allowable in the KIPO, the applicant will be notified that the application will await action in its regular turn.

All amendments to the claims made with the request for accelerated examination under the PPH pilot will be entered regardless of whether the request is granted or not.

ANNEX A

PPH Pilot Program Request Form

Request for Accelerated examination at CIPO under the Patent Prosecution Highway Pilot Program Between CIPO and the KIPO

Application Information

CIPO application number: _____
Corresponding KR application
or publication number(s): _____

Claims on file and Claim Correspondence Table

Either:

- (a) The claims on file correspond to one or more of those claims indicated as allowable in the KIPO; or
- (b) The applicant is amending the claims with this request to correspond with one or more of those claims indicated as allowable in the KIPO.

and

A claim correspondence table is completed.

Translation of the corresponding KIPO claims

A copy of an accurate translation of those claims indicated as allowable in the KIPO is attached.

Corresponding KIPO required documents

Either:

- (a) A copy of the KIPO Letters Patent cover page is attached¹; or
- (b) A copy of an accurate translation of the KIPO office actions is attached; or
- (c) CIPO is requested to retrieve the translation of the KIPO office actions from the KIPO K-PION¹.

Document Name	Date

Other Amendments to application (Optional)

Either:

- (a) The applicant has reviewed the application, the specification on file conforms with Canadian patent application requirements and practice; or
- (b) The applicant is amending the specification to conform with Canadian patent application requirements and practice.

¹ The office actions of the corresponding KIPO application(s) must be available on the Korean Patent Information Online Network (K-PION).

ANNEX B

Claim Correspondence Table

CIPO application claim on file	Corresponding KIPO claim	Comment

Examples:

Claim Correspondence Table

CIPO application claim on file	Corresponding KIPO claim	Comment
1 to 5	1 to 5	Applicant has amended the claims to the present claims having the same scope as the claims of the applicant's corresponding KIPO application. KIPO claims 1 to 5 have been indicated as allowable in the "Written Decision on Registration" office action dated ____ .
1 to 3	1 to 3	Applicant has amended the claims to the present claims having the same scope as the claims of the applicant's corresponding KIPO application. KIPO claims 1 to 3 have been indicated as allowable in the "Notice of Submission of Opinion" office action dated ____ .

ANNEX C

With regards to requirement (c), the claims in the following example are considered to “sufficiently correspond”:

CIPO claims	Subject matter	KIPO claims	Subject matter	Comment
1	A	1(independent)	A	The same as KIPO claim 1.
2	A + a +b	2 (dependent on 1)	A + a	Claim 2 has the additional technical feature “b” on the KIPO claim 2.
3	A	3 (dependent on 1)	A + b	Similar to KIPO claim 1 except for claim format.
4	A+d			Claim 4 has an additional technical feature “d” on the KIPO claim 1. Where "d" is supported in the description but is not claimed in the KIPO.

Where “A” is the subject matter and “a”, “b”, and “d” are the additional technical features which narrow (further restrict) the scope of the subject matter.

A CIPO claim 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, the KIPO claims only contain claims to a process of manufacturing a product, then the CIPO claims are not considered to sufficiently correspond if the CIPO claims introduce product claims which are independent or dependent on the corresponding process claims.

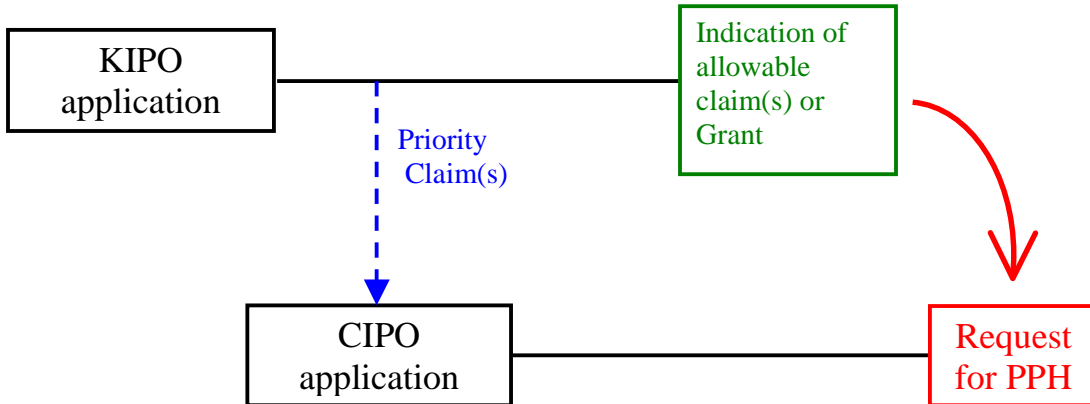
Note, it is not necessary to include “all” claims determined to be allowable in the KIPO in an application in CIPO (the deletion of claims is allowable). For example, in the case where an application in the KIPO contains 5 claims determined to be patentable/allowable, the corresponding application in CIPO may contain only 3 of these 5 claims.

ANNEX D

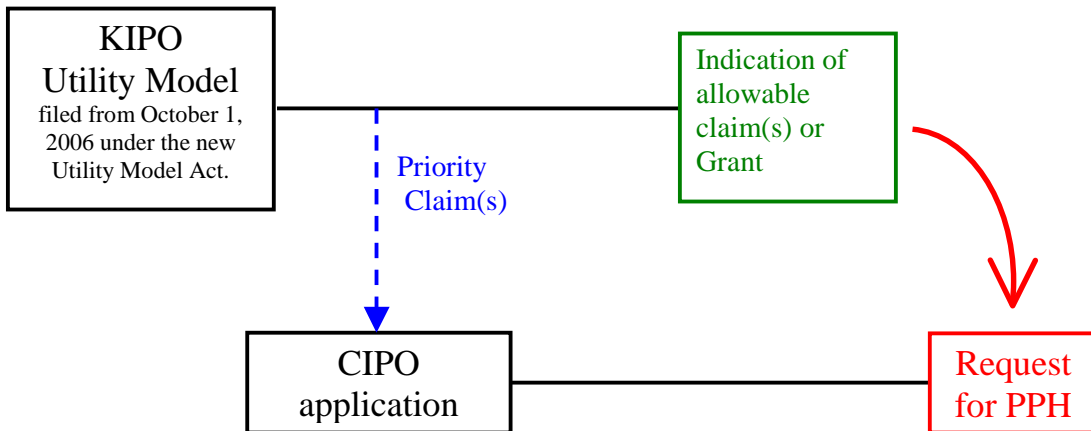
Examples of Canadian patent applications that may request accelerated examination under the PPH pilot program at CIPO:

- a) (i) a nationally filed application which validly claims priority under the Paris Convention from either a single KIPO national application or multiple KIPO national applications

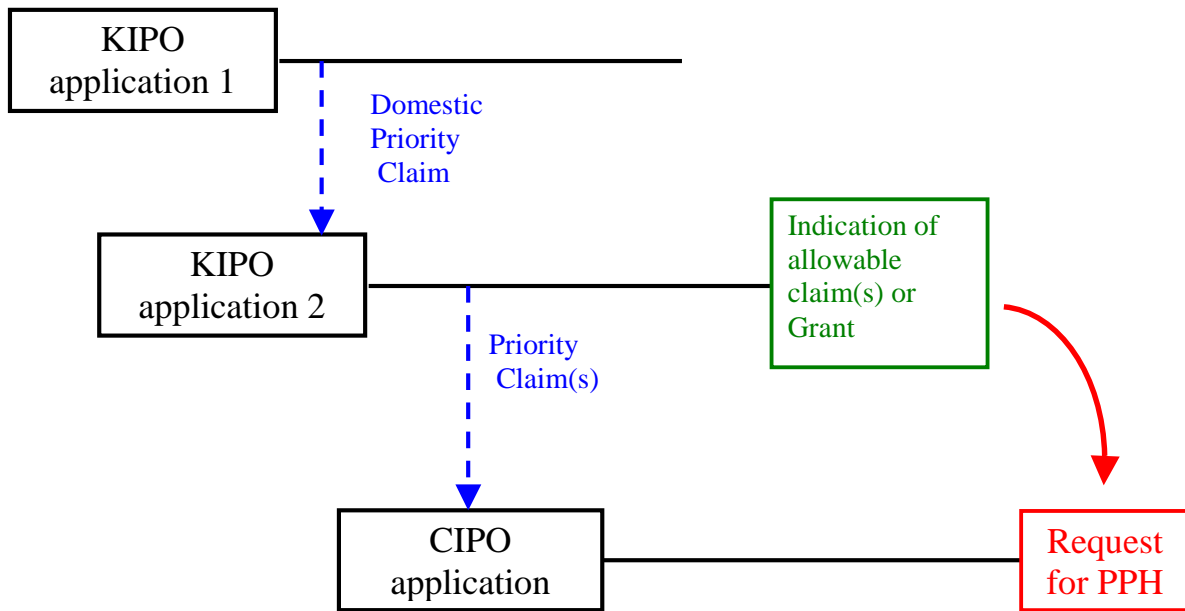
Example A:



Example B:

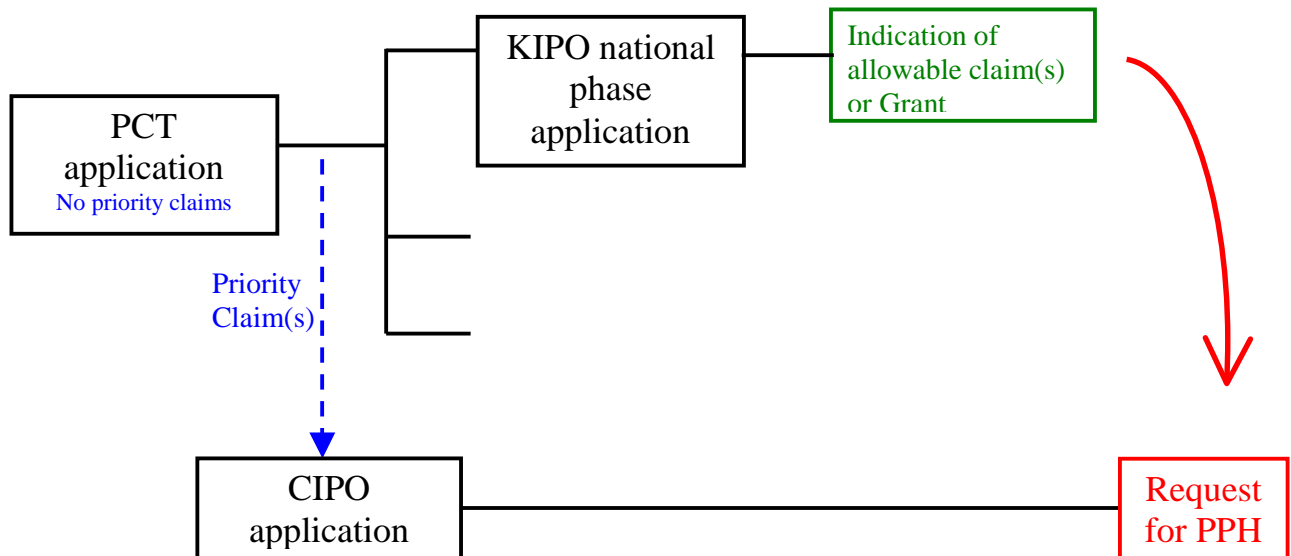


Example C:



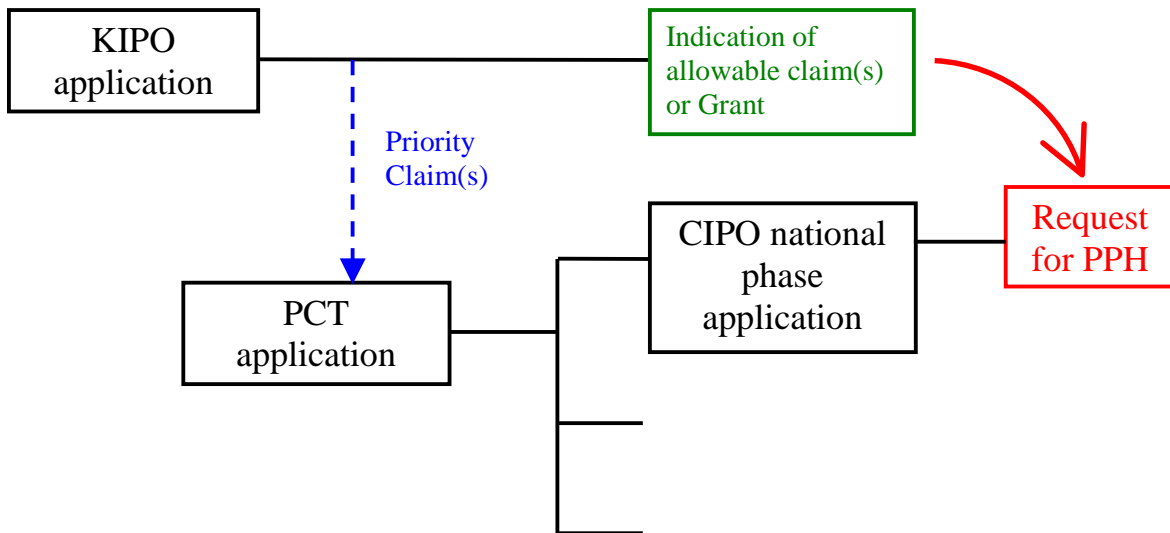
- a) (ii) a nationally filed application which validly claims priority under the Paris Convention from a PCT application which has no priority claims

Example D:



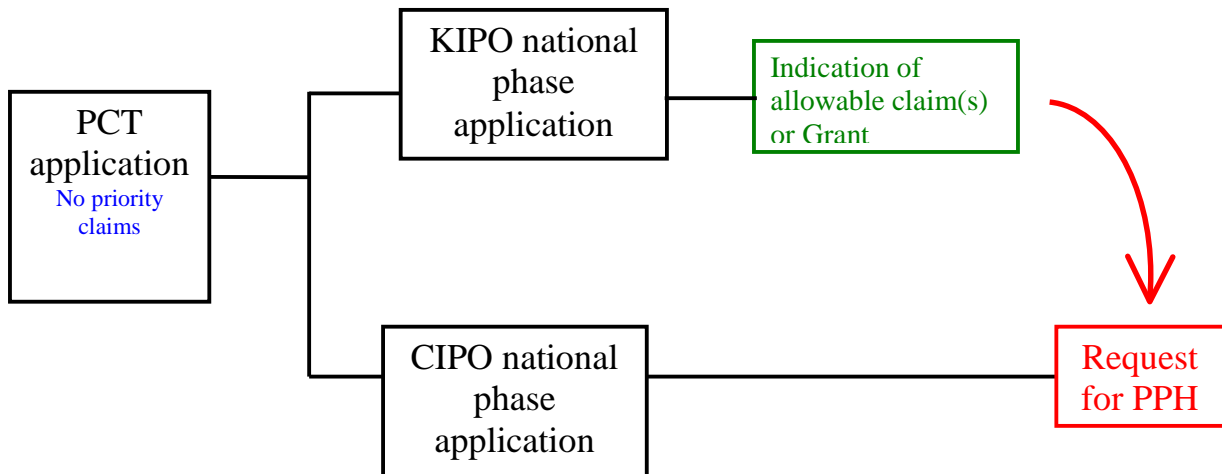
a) (iii) a PCT national phase application where the PCT international application has validly claimed priority from a KIPO national application or multiple KIPO national applications

Example E:



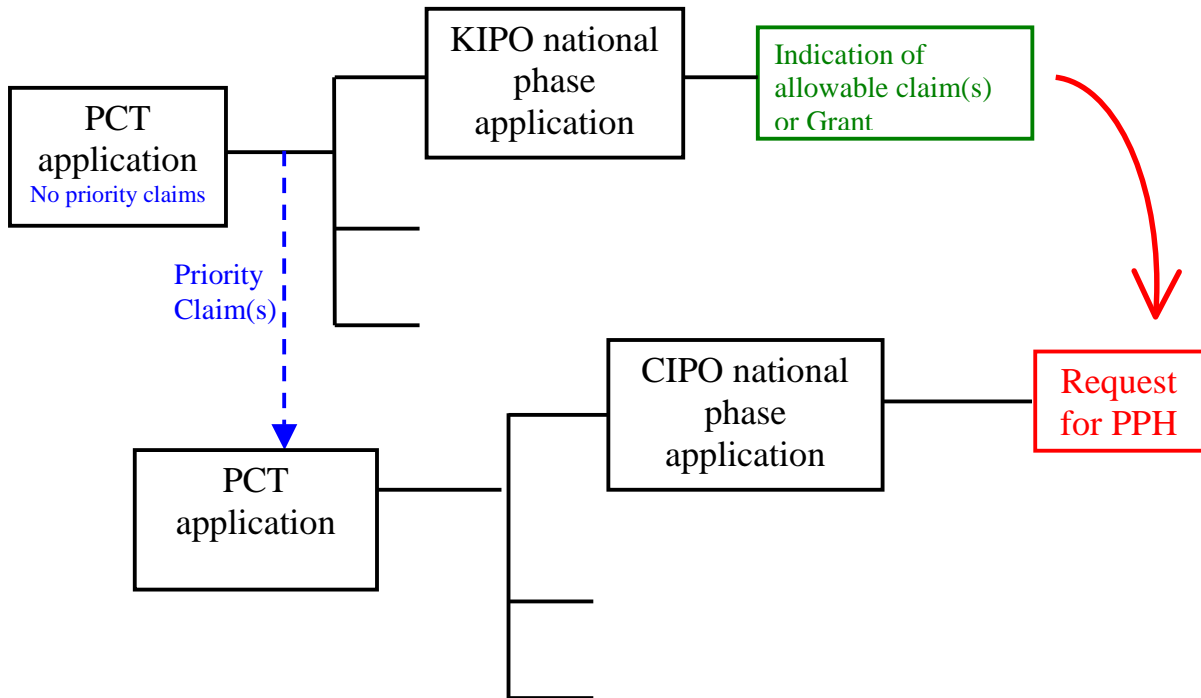
a) (iv) a PCT national phase application where the PCT international application has no priority claims

Example F:

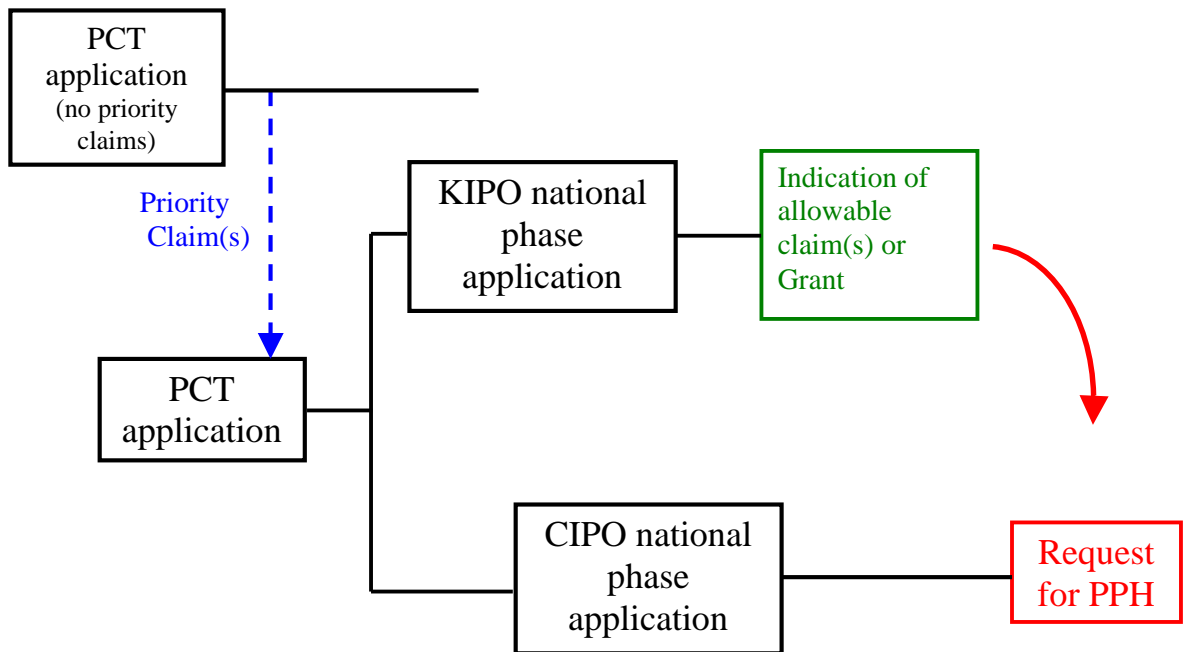


- a) (v) a PCT national phase application where the PCT international application has validly claimed priority from a PCT application which has no priority claims

Example G:

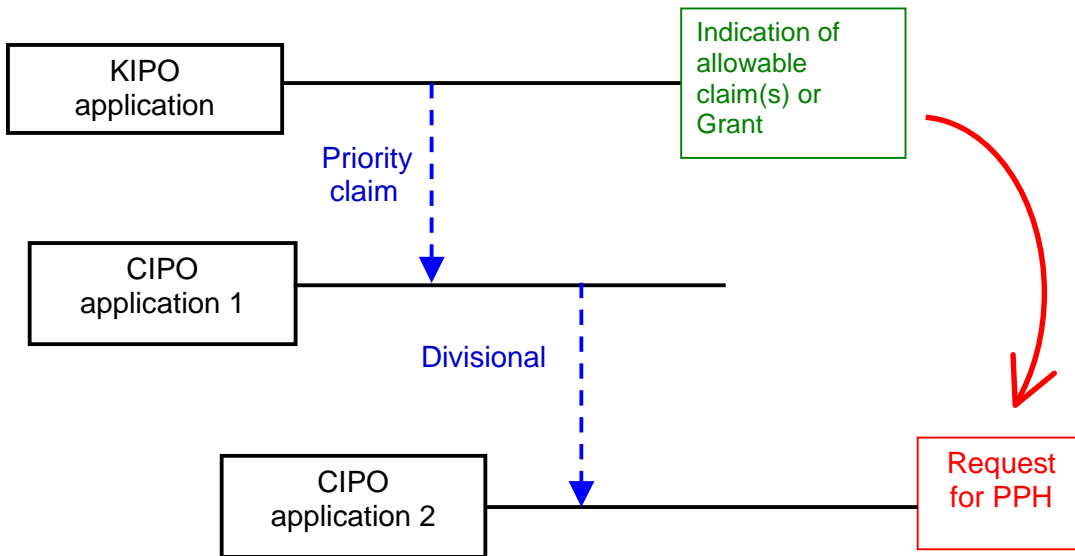


Example H:



(a) (vi) a divisional of an application referred to in any of (i) to (v)

Example I:



ANNEX E

Examples of KIPO Office Actions having an indication of claims determined to be allowable by the KIPO.

Requirement c) states that:

CIPO shall consider corresponding KIPO claims to be allowable as indicated in a KIPO Granted Patent Publication and/or in an Office Action.

Requirement c) includes:

- (I) English language version - claims indicated in the Written Decision on Registration under the field "*Claim*"
- (II) Korean language version - claims indicated in the Written Decision on Registration under the field "*Claim*"
- (III) English language version - claims indicated in the Notice of Submission of Opinion under the field *PATENTABLE (REGISTRABLE) CLAIM(S)*:
- (IV) Korean language version - claims indicated in the Notice of Submission of Opinion under the field *PATENTABLE (REGISTRABLE) CLAIM(S)*:
- (V) English language version - claims indicated in the Notice of Final Rejection under the field *PATENTABLE (REGISTRABLE) CLAIM(S)*:
- (VI) Korean language version - claims indicated in the Notice of Final Rejection under the field *PATENTABLE (REGISTRABLE) CLAIM(S)*:

Examples are illustrated in the following pages.

(I) English language version - claims indicated in the Written Decision on Registration:



The Korean Intellectual Property Office

KIPO

Sending number :
Dispatched date : 2008.06.25
Submission due date.

YOUR INVENTION PARTNER
KIPO
Grant of Patent

Applicant.	Name. Address. Secure Information
Agent.	Name. - Address. Secure Information
Inventor.	Name. Address. Secure Information Name. Address. Secure Information Name. Address. Secure Information

Application number.

Claim. 16

Title of Invention

The original decision (2008.02.18) is canceled. This application has been granted a patent under Article 66 of the Patent Act. (patent right takes an effect by paying the patent fee after registration under Article 87 of Patent Act.) The end.

(II) Korean language version - claims indicated in the Written Decision on Registration:



The Korean Intellectual Property Office

KIPO

발송번호:
발송일자: 2008.06.25
제출기일

YOUR INVENTION PARTNER

[심사전치]

**특 허 청
특허결정서**

출원인	명칭	
	주소	개인정보보호를 위해 비공개합니다.
대리인	성명	
	주소	개인정보보호를 위해 비공개합니다.
발명자	성명	
	주소	개인정보보호를 위해 비공개합니다.
	성명	
	주소	개인정보보호를 위해 비공개합니다.
	성명	
	주소	개인정보보호를 위해 비공개합니다.

출원번호

청구항

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발명의명칭

원결정(2008.02.18)을 취소합니다. 이 출원은 특허법 제66조에 의하여 특허결정합니다. (특허법 제87조의 규정에 따라 특허권 특허료를 납부하여 설정등록함으로써 발생하게 됩니다.) 끝.

(III) English language version - claims indicated in the Notice of Submission of Opinion under the field *PATENTABLE (REGISTRABLE) CLAIM(S)*:



The Korean Intellectual Property Office

Sending number :
Dispatched date : 2008.04.29
Submission due date : 2008.06.29

YOUR INVENTION PARTNER

KIPO
Notice of Submission of Opinion

Applicant. Name.
Address. Secure Information

Agent. Name.
Address. Secure Information
Designated person besides
Patent
Attorney.

Inventor. Name.
Address. Secure Information

Application number.
Title of Invention

As a result of examination for this application, please be advised under Article 63 of the Patent Act that there is reason for rejection as follows, and you should submit an opinion (Written reply, Supporting statement)[copy of form of attached document No.24 of Patent Act] or/and amendment [copy of form of attached document No.9] by the designated date in case you have an opinion or need of amendment. (request for extension of the submission date can be limited to 1 month at a time, and we do not give you special notification regarding the grant of extension.)

[EXAMINATION RESULT]

EXAMINED CLAIM(S):

Claim 1-2.

REJECTED SECTION(S) AND RELATED ARTICLE(S)

Sequence number.	The part in which it has the reason for rejection.	Related law articles.
1	Claim 2.	The article 29(2) of Patent Act.

PATENTABLE(REGISTRABLE) CLAIM(S):

Claim 1.

※ Indication of PATENTABLE CLAIM(S) is based on opinion(s) prepared when the Notice of Submission of Opinion is issued. Therefore, PATENTABLE CLAIM(S) may be changed at subsequent examination procedures. If the reason for rejection is defeated, the Patent will be granted.

[SPECIFIC REASON FOR REJECTION]

The person (it hereinafter says to be " person skilled in the art ") having the normal knowledge in the technical field in which as to the written invention, this invention belongs before the application beneath points out, it is according to due to claim 2 of the patent claim of this application and since easily inventing, the patent cannot be received according to the article 29(2) of Patent Act.

- Follows -

(V) English language version - claims indicated in the Notice of Final Rejection under the field *PATENTABLE (REGISTRABLE) CLAIM(S)*:



The Korean Intellectual Property Office

Sending number :
Dispatched date : 2008.02.18
Submission due date.

YOUR INVENTION PARTNER

KIPO
Notice of Final Rejection

Applicant. Name.
Address. Secure Information

Agent. Name.
Address. Secure Information

Application number.
Title of Invention

Since unable to resolving a part of 2007.11.15 reason for rejection, and this application determines opinion (reply, and the supporting statement) of 2008.01.15 being received [the opinion according to notification including the reason for rejection etc] with [correction including specification etc] amendment based on the rules of the article 62 of Patent Act as a result of re-examination.

[RE-EXAMINATION RESULT]

EXAMINED CLAIM(S):

Claim 1-17.

REJECTED SECTION(S) AND RELATED ARTICLE(S)

Sequence number.	The part in which the reason for rejection is not solved.	Related law articles.
1	Claim 13.	The article 42(4)(2) of Patent Act.

PATENTABLE(REGISTRABLE) CLAIM(S):

The 1-12, and 14-17 claim.

※ Indication of PATENTABLE CLAIM(S) is based on opinion(s) prepared when the Notice of Final Rejection is issued. Therefore, PATENTABLE CLAIM(S) may be changed at subsequent examination procedures. If the reason for rejection is defeated, the Patent will be granted.

[REASON FOR THE DECISION ON REJECTION]

