GUIDELINES

Procedures to file a request to the INDECOPI (National Institute for the Defense of Free Competition and the Protection of Intellectual Property) for Patent Prosecution Highway Pilot Program

The present guidelines are approved between Japan Patent Office (JPO) and National Institute for the Defense of Competition and the Protection of Intellectual Property (INDECOPI) within the framework of the Joint Statement of Intent signed by the representatives of the mentioned offices.

The basic concept of the PPH program is that where the Office of Earlier Examination (OEE) has determined that one or more claims of a patent application is/are allowable, the applicant will be entitled to the benefit of an accelerated examination before the Office of Later Examination (OLE) for the corresponding application, provided that certain conditions are met, including the sufficient correspondence of claims between the two applications and that work results of the OEE are made available to the OLE.

The PPH pilot program between INDECOPI and JPO will commence on November 1st, 2017 for a trial period of three years. The INDECOPI and JPO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period.

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the INDECOPI and satisfies the following requirements under the JPO (Japan Patent Office)–INDECOPI Patent Prosecution Highway (PPH) pilot program based on the JPO application (Part I) or PCT international work products (Part II).

The offices may, in the event of an excessive number of PPH requests which impede their proper functioning, suspend the implementation of the PPH pilot program. That suspension can only be activated if the decision to suspend is formally communicated to the other office three (03) months before the suspension becomes effective.

Part I

PPH using the national work products from the JPO

1. Requirements

1.1. Both the INDECOPI application on which PPH is requested and the JPO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).
For example, the INDECOPI application (including PCT national phase application) may be either:

(Case I) an application which validly claims priority under the Paris Convention from the JPO application(s) (examples are provided in ANNEX II, Figures A, B, C, H, I and J), or
(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the JPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX II, Figures D and E), or
(Case III) an application which shares a common priority document with the JPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX II, Figures F, G, L, M, N O), or
(Case IV) a PCT national phase application where both the INDECOPI application and the INDECOPI application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX II, Figure K).

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the JPO application which forms the basis of the priority claim (e.g., a divisional application of the JPO application or an application which claims domestic priority to the JPO application, or an JPO national phase application of a PCT application.

1.2. At least one corresponding application exists in the JPO and has one or more claims that are determined to be patentable/allowable by the JPO.

The applicant shall identify the relationship between the application in JPO that contains the allowable/patentable claims and the application in the Indecopi.

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

The office action includes:
(a) Decision to Grant a Patent
(b) Notification of Reasons for Refusal
(c) Decision of Refusal
(d) Appeal Decision

For example, if the following routine expression is described in the “Notification of Reason for Refusal” of the JPO, those claims are clearly identified to be patentable/allowable.

"<Claims which has been found no reason for refusal>
At present for invention concerning Claim__, no reason for refusal is found."

1.3. All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable/patentable in the JPO.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the INDECOPI are of the same or similar scope as the claims in the JPO, or the claims in the INDECOPI are narrower in scope than the claims in the JPO. In this regard, a claim that is narrower in scope occurs when a JPO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims) originally filed at INDECOPI.

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

It is not required to include "all" claims considered to be allowable/patentable by JPO (claims removal allowed). For example, in the case where the application in JPO contains 5 claims allowable/ patentable, the application in Indecopi may contain only 3 claims.

Illustrative examples of claims which are considered to be "sufficiently correspond" and claims that are not considered "sufficiently correspond" are shown in ANNEX I.

Any claims amended or added after the grant of the request for participation in the PPH pilot program need to be sufficiently correspond to the claims indicated as allowable/patentable in the JPO application.

1.4. The application must have been published
At the time of request for the PPH the application must have been published and the deadline for oppositions in accordance with the provisions of articles 40 and 42 of Decision 486 has expire.

1.5. Patentability examination
At the time of filing the application to participate in the PPH Pilot Program, Indecopi should not have notified the patentability examination in accordance with article 45 of Decision 486.
2. Documents to be submitted

2.1 Documents (a) to (d) below must be submitted by attaching to the PPH request.

(a) **Copies of all office actions (which are relevant to substantial examination for patentability in the JPO) which were issued for the corresponding application by the JPO and translations of them.**
   Spanish is acceptable as translation language.

(b) **Copies of all claims determined to be patentable/allowable by the**
   Spanish is acceptable as translation language.

(c) **Copies of all references cited by the JPO examiner**
   If the references are patent documents, the applicant doesn’t have to submit them because the INDECOPI usually possesses them. When the INDECOPI does not possess the patent document, the applicant has to submit the patent document at the examiner’s request. Non-patent literature must always be submitted.

(d) **Claim correspondence table**
   The applicant requesting PPH must submit a claim correspondence table in spanish, which indicates how all claims in the INDECOPI application sufficiently correspond to the patentable/allowable claims in the JPO application (see 4. INDECOPI PPH request form). When claims are just literal translation, the applicant can just write down that “they are the same” in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim.

2.2. When the applicant has already submitted above documents (a) to (d) to the INDECOPI through the procedure, the applicant may incorporate the documents by reference and does not have to attach them.
   The applicant must mention this fact and indicate in the request for participation in the PPH pilot program when they were previously presented at the request of INDECOPI.
Part II

PPH using the PCT international work products from the JPO (PCT-PPH)

1. Requirements

The application which is filed with the INDECOPI and on which the applicant files a request under the PCT-PPH must satisfy the following requirements:

(a) 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 steps and industrial applicability).

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the JPO, but, if priority is claimed, the priority claim can be to an application in any Office, see example A’ in Annex II (application ZZ can be any national application).

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

In case any observation is described in Box VIII of 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 participating in 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.

(b) The relationship between the application and the corresponding international application satisfies one of the following requirements:

- The application is a national phase application of the corresponding international application. (See Figures A, A’, and A” in Annex III)
- The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex III)
- The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex III)
- The application is a national application claiming foreign/national priority from the
corresponding international application. (See Figure D in Annex III)

- The application is the derivative application (divisional application and application claiming priority etc.) of the application which satisfies one of the above requirements (A) – (D). (See Figures E1, E2 and F in Annex III)

(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 allowable in the latest international work product of the corresponding international application.

The applicant shall identify the relationship between the application in JPO that contains the allowable/patentable claims and the application in the Indecopi.

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

In this regard, a claim that is narrower in scope occurs when a claim indicated as 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) originally filed at INDECOPI.

A claim in the INDECOPI which introduces a new/different category of claims to those claims indicated as allowable in the latest international work product is not considered to sufficiently correspond.

It is not required to include "all" claims considered to be allowable/patentable by JPO (claims removal allowed). For example, in the case where the application in JPO contains 5 claimed claims allowable/patentable, the application in Indecopi may contain only 3 claims.

Illustrative examples of claims which are considered to be "sufficiently correspond" and claims that are not considered "sufficiently correspond " are shown in ANNEX I.

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program need to be sufficiently correspond to the claims indicated as allowable in the latest international work product.
(d) The application must have been published

At the time of request for the PPH the application must have been published and the deadline for oppositions in accordance with the provisions of articles 40 and 42 of Decision 486 has expire.

(e) Patentability examination

At the time of filing the application to participate in the PPH Pilot Program, Indecopi should not have notified the patentability examination in accordance with article 45 of Decision 486.

2. Documents to be submitted

2.1 The applicant must submit the following documents attached to the request form in filing a request under PCT-PPH. Some of the documents may not be required to submit in certain cases.

(a) A copy of the latest international work product which indicated the claims to be patentable/allowable and translations of them.

Spanish is acceptable as translation language. If the copy of the latest international work product is available in Spanish or English via “PATENTSCOPE (registered trademark)”1, an applicant need not submit these documents unless otherwise requested by the INDECOPI (WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date).

(b) A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and translations of them1.

Either Spanish or English is acceptable as translation language. If the copy of the set of claims which are indicated to be patentable/allowable is available via “PATENTSCOPE (registered trademark)” (e.g. the international Patent Gazette has been published), an applicant need not submit this document unless otherwise requested by the INDECOPI.

(c) A copy of all references cited in the latest international work product of the international application corresponding to the application

If the references are patent documents, the applicant doesn’t have to submit them because the INDECOPI usually possesses them. When the INDECOPI does not possess the patent document, the applicant has to submit the patent document at the examiner’s request. Non-

patent literature must always be submitted.

(d) A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable.

The applicant requesting PPH must submit a claim correspondence table in Spanish, which indicates how all claims in the INDECOPI application sufficiently correspond to the patentable/allowable claims in the JPO application (see 4. INDECOPI PPH request form).

When claims are just literal translation, the applicant can just write down that “they are the same” in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim.

2.2. When the applicant has already submitted above documents (a) to (d) to the INDECOPI through the procedure, the applicant may incorporate the documents by reference and does not have to attach them.

The applicant must mention this fact and indicate in the request for participation in the PPH pilot program when they were previously presented at the request of INDECOPI.
3. Procedure for the accelerated examination under the PPH pilot program

3.1. The applicant must submit a request form to the INDECOPI (see section 4. INDECOPI PPH request form) and the documents mentioned in the previous numeral.

The INDECOPI 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 the INDECOPI 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 submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH. If the second request does not meet all the requirements, the application will continue with the regular procedure.

3.2. The participation in the PPH pilot program may not be transferred to a divisional application. The applicant may submit a new request to participate in the PPH pilot program in the divisional application procedure and comply with all requirements set forth above.

3.3. Design applications and utility model applications are excluded from participation in the PPH pilot program.

3.4. Any amendments made to the patent applications will be made regardless of whether or not the request to PPH pilot program is accepted.

3.5. Claims for patent applications containing matters falling within the scope of Articles 15, 20 and 21 of Decision 486, as well as in the Judgment of the Court of Justice of the Andean Community in Process 89-AI-2000 published in Official Gazette No. 22 of October 12, 2001, regarding the non-patentability of uses, are excluded from participation in the PPH pilot program.

3.6. All communication or correspondence relating to participation in the PPH pilot program presented at Indecopi shall be clearly identified as such by placing the term PPH at the top of the first page to ensure that it can be handled properly.

3.7. The PPH procedure does not exempt applicants from all their obligations under peruvian laws.
### 4. INDECOPI PPH request form

**REQUEST FOR PARTICIPATION IN**

**THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM**

**JPO-INDECOPI**

<table>
<thead>
<tr>
<th>A. Bibliographic Data</th>
</tr>
</thead>
<tbody>
<tr>
<td>Application Number (if known)</td>
</tr>
<tr>
<td>Title of invention:</td>
</tr>
<tr>
<td>Filing Date:</td>
</tr>
<tr>
<td>Reference:</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>B. Request</th>
</tr>
</thead>
<tbody>
<tr>
<td>Applicant requests participation in the Patent Prosecution Highway (PPH) pilot program based on:</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Office of Earlier Examination (OEE)</th>
<th>JPO</th>
</tr>
</thead>
<tbody>
<tr>
<td>OEE Work Products Type</td>
<td>□ PPH</td>
</tr>
<tr>
<td>(National Office Action)</td>
<td>(WO-ISA, WO-IPEA or IPER)</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>OEE Application Number</th>
</tr>
</thead>
<tbody>
<tr>
<td>Priority Application Number or PCT Application Number</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>C. Required Documents</th>
</tr>
</thead>
</table>

#### I. OEE Work Products and, if required, Translations

1. □ A copy of OEE work products is attached; or
   - The office is requested to retrieve documents via the Dossier Access System, PATENTSCOPE or other patents databases.

2. □ A translation of documents in 1. in a language accepted by the Office is attached; or
   - The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE

#### II. Patentable/Allowable Claims Determined by OEE and, if required, Translations

3. □ A copy of all claims determined to be patentable/allowable by OEE is attached; or
   - The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE

4. □ A translation of documents in 3. in a language accepted by the Office is attached; or
   - The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE

#### III. Documents Cited in OEE Work Products (if required)

5. □ A copy of all documents cited in OEE work products is attached (excluding patent documents); or
   - no references cited
IV. Previously submitted documents

6. □ If any of the above mentioned documents have been submitted before, please specify:

D. Claims Correspondence

□ All the claims in the application sufficiently correspond to the patentable/allowable claims in the OEE application; or

□ Claims correspondence is explained in the following table

<table>
<thead>
<tr>
<th>Application Claims</th>
<th>Corresponding OEE claims</th>
<th>Explanation regarding the correspondence</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Name(s) of applicant(s) or representative(s)

Date

Signature
ANNEX I (Spanish)
Illustrative examples of claims which are considered to be "sufficiently correspond" and claims that are not considered "sufficiently correspond"

1. Las reivindicaciones en los casos siguientes (caso 1 a 4) se consideran “suficientemente correspondientes”:

<table>
<thead>
<tr>
<th>Caso</th>
<th>Reivindicación(es) “patenteable(s)/otorgable(s)”</th>
<th>Reivindicación(es) en INDECOPI</th>
<th>Explicación</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>No. Contenido</td>
<td>No. Contenido</td>
<td></td>
</tr>
<tr>
<td>Caso 1</td>
<td>1 A</td>
<td>1 A</td>
<td>La reivindicación 1 en INDECOPI es la misma que la reivindicación 1 “patenteable/otorgable”.</td>
</tr>
<tr>
<td>Caso 2</td>
<td>1 A</td>
<td>1 A</td>
<td>La reivindicación 1 en INDECOPI es la misma que la reivindicación 1 “patenteable/otorgable”. La reivindicación 2 en INDECOPI es creada añadiendo una característica técnica descrita en la especificación a la reivindicación 1 “patenteable/otorgable”.</td>
</tr>
<tr>
<td>Caso 3</td>
<td>1 A+A</td>
<td>1 A</td>
<td>La reivindicación 1 en INDECOPI es la misma que la reivindicación 1 “patenteable/otorgable”. Las reivindicaciones 2, 3 en INDECOPI son las mismas que las reivindicaciones 3, 2 “patenteables/otorgables”, respectivamente.</td>
</tr>
<tr>
<td>Caso 4</td>
<td>1 A+A</td>
<td>1 A+a</td>
<td>La reivindicación 1 en INDECOPI tiene una característica técnica adicional “a” descrita en la especificación.</td>
</tr>
</tbody>
</table>

2. Las reivindicaciones en los casos siguientes (casos 5 y 6) NO se consideran “suficientemente correspondientes”:

<table>
<thead>
<tr>
<th>Caso</th>
<th>Reivindicación(es) “patenteable(s)/otorgable(s)”</th>
<th>Reivindicación(es) en INDECOPI</th>
<th>Explicación</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>No. Contenido</td>
<td>No. Contenido</td>
<td></td>
</tr>
<tr>
<td>Caso 5</td>
<td>1 A</td>
<td>1 A’</td>
<td>La reivindicación 1 en INDECOPI reivindica un método en donde la reivindicación 1 “patenteable/otorgable” reivindica un producto. La característica técnica de la reivindicación “patenteable/otorgable” es la misma que la reivindicación en INDECOPI pero las categorías de ambas son diferentes.</td>
</tr>
<tr>
<td>Caso 6</td>
<td>1 A+B</td>
<td>1 A+C</td>
<td>La reivindicación 1 en INDECOPI es diferente de la reivindicación 1 “patenteable/otorgable” en un componente de la invención reclamada. La reivindicación en INDECOPI se crea alterando parte de las características técnicas de la reivindicación “patenteable/otorgable”.</td>
</tr>
</tbody>
</table>
A case meeting requirement (a) (I)
- Paris route -

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

OK
A case meeting requirement (a) (I)
- PCT route, Domestic priority -

A case meeting requirement (a) (II)
- Paris route -
E A case meeting requirement (a) (II)
- PCT route -

INDECOPI application

Priority claim

PCT application

JPO DO application

Request for PPH

Patentable/Allowable

OK

F A case meeting requirement (a) (III)
- Paris route, but the first application is from the third country -

XX application

Priority claim

JPO application

Patentable/Allowable

OK

INDECOPI application

Priority claim

Request for PPH

XX : the office other than the JPO
**G** A case meeting requirement (a) (III)  
- PCT route, but the first application is from the third country -

**H** A case meeting requirement (a) (I)  
- Paris route & Complex priority -
I. A case meeting requirement (a) (I) - Paris route & divisional application -

J. A case meeting requirement (a) (I) - PCT route -
K A case meeting requirement (a) (IV)
- Direct PCT route -

L A case meeting requirement (a) (III)
- PCT route, but the first application is from the third country -
A case meeting requirement (a) (III)
- Direct PCT & PCT route -

A case meeting requirement (a) (I)
- Paris route & Complex priority -

ZZ : any office
A case not meeting requirement (d)
- Examination has begun before a request for PPH -
(A) The application is a national phase application of the corresponding international application.

(A') The application is a national phase application of the corresponding international application. (The corresponding international application claims priority from a national application.)

ZZ=any office
(A") The application is a national phase application of the corresponding international application. (The corresponding international application claims priority from an international application.)

(B) The application is a national application as a basis of the priority claim of the corresponding international application.
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.

(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.
(E1) The application is a divisional application of an application which satisfies the requirement (A).

(E2) The application is an application claiming domestic priority from an application which satisfies the requirement (B).
(E3) The application is an application claiming priority from an application which satisfies the requirement (B).

ZZ : any office