

## **Procedures to file a request to the DIP (Department of Intellectual Property in Thailand) for Patent Prosecution Highway Pilot Program between the DIP and the JPO (Japan Patent Office)**

The Patent Prosecution Highway (PPH) pilot program between the Department of Intellectual Property (DIP) and the Japan Patent Office (JPO) will be in effect for two (2) years, commencing on January 1, 2024 and will end on December 31, 2025. The pilot program may be extended after a joint DIP-JPO review and assessment of the program implementation.

The offices may suspend or terminate the PPH pilot program if the volume of PPH requests exceeds a manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is suspended or terminated.

Applicants can request accelerated examination of an invention patent application in accordance with a prescribed procedure including submission of relevant documents on the application which is filed with the DIP (DIP application) and satisfies the following requirements under the DIP - JPO PPH pilot program based on the JPO application. When filing a request or participation in the PPH pilot program, an application must submit, through on-line procedure or paper procedure, a request form "DIP-JPO PPH Request Form" to the DIP<sup>1</sup>.

### **1. Requirements**

- (a) The DIP application (including a PCT national phase application) is**
- (i) an application which validly claims priority under the Paris Convention to the JPO application(s) (examples are provided in ANNEX, Figure A, B, C, F, G and H), or**
  - (ii) a PCT national phase application without priority claim (examples are provided in ANNEX, 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, Figure J, K and L).**

The DIP application, which validly claims priority to multiple JPO 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.

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<sup>1</sup> It is encouraged to submit the PPH request via the Patent E-Service on the DIP's website (<https://www.ipthailand.go.th>) of which the pendency period tends to be faster than paper procedure.

**(b) 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 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 (see Figure C in Annex)), or an JPO national phase application of a PCT application (see Figures H, I, J, K and L in Annex).

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 one of the following:

- (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 application, those claims are clearly identified to be allowable/patentable.

“<Claims which has been found no reason for refusal>

At present for invention concerning Claim \_\_\_, no reason for refusal is found.”

**(c) All claims in the DIP 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 indicated as allowable in the JPO application.**

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

A claim in the DIP application which introduces a new/different category of claims to those claims indicated as allowable in the JPO application is not considered to sufficiently correspond. For example, where the JPO claims only contain claims to a process of manufacturing a product, then the claims in the DIP application are not considered to sufficiently correspond if the DIP 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 in the JPO application in the DIP application. For example, in the

case which the JPO application contains five claims, the DIP application may contain only two of these five claims.

Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in the JPO application after the first DIP office action.

- (d) ***The DIP has not begun examination of the application at the time of request for the PPH (an example is provided in ANNEX, figure M).***
- (e) ***A “Request for Substantive Examination” must be filed at the DIP before or at the same time of submission of the PPH Request.***

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

Documents (a) to (d) below must be submitted by attaching to the DIP-JPO PPH Request Form.

- (a) ***Copies of all office actions (which are relevant to substantial examination for patentability in the JPO application) which were issued for the corresponding application by the JPO, and translations of them.***

Either Thai or English is acceptable as translation language. The applicant does not have to submit a copy of JPO office actions and translations of them when those documents are provided via JPO's dossier access system because the office actions and their machine translations are available for the DIP examiner via the JPO's dossier access system. If they cannot be obtained by the DIP examiner via the JPO's dossier access system, the applicant may be notified and requested to provide the necessary documents. It is understood that if the result of the machine translation submitted to the DIP is unclear or insufficient, the examiner may request the applicant to submit a new translation of the documents.

Note that even when copies of the office actions and/or their translation are omitted for submission, the applicants must submit the list of such omitted documents.

- (b) ***Copies of all claims determined to be patentable/allowable by the JPO, and translations of them.***

Either Thai or English is acceptable as translation language. The applicant does not have to submit a copy of claims indicated to be allowable/patentable in the JPO application, and translations thereof when the documents are provided via JPO's dossier access system because they are available for the DIP examiner via the JPO's dossier access system. If they cannot be obtained by the DIP examiner via the JPO's dossier access system, the applicant may be notified and requested to provide the necessary documents.

It is understood that if the result of the machine translation submitted to the DIP is unclear or insufficient, the examiner may request the applicant to submit a new translation of the documents.

Note that even when copies of the claims and/or their translation are omitted for submission, the applicant is requested to submit the list of such omitted documents.

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

The applicant must submit the list of the references cited by the JPO examiner. If the references are patent documents, the applicant doesn't have to submit them because the DIP usually possesses them. When the DIP 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. The translations of the references are unnecessary.

**(d) *Claim correspondence table***

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the DIP application sufficiently correspond to the patentable/allowable claims in the JPO application.

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.

When the applicant has already submitted above documents (a) to (d) to the DIP through simultaneous or subsequent procedures, the applicant may incorporate the documents by reference and does not have to attach them.

### **3. DIP – JPO PPH Request Form**

Example of “Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program between the Department of Intellectual Property (DIP) and the Japan Patent Office (JPO)”

#### **(a) Circumstances**

When an applicant files a request for an accelerated examination under the PPH pilot program to the DIP, the applicant must submit a request form “Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program between the Department of Intellectual Property (DIP) and the Japan Patent Office (JPO)”.

The applicant must indicate that the application is included in (i) to (iii) of 1.(a) and that accelerated examination is requested under the PPH pilot program. The application number, publication number, or a patent number of the corresponding the DIP application(s) must also be indicated.

In the case that the application which has one or more claims that are determined to be patentable/allowable is different from the JPO application(s) included in (i) to (iii) of 1.(a) (for example, the divisional application of the basic application), the application number, publication number, or a patent number of the application(s) which has claims determined to be patentable/allowable and the relationship between those applications must also be explained in 2.4 of Request Form.

#### **(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 from submitting certain documents.

#### **(c) Notice**

An applicant can submit the “Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program between the Department of Intellectual Property (DIP) and the Japan Patent Office (JPO)” through on-line procedure or paper-based procedure. Note that in the case of paper procedure, the pendency period tends to longer than on-line procedure.

Example form of DIP – JPO PPH request form

**Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program**  
**Between the Department of Intellectual Property (DIP)**  
**and the Japan Patent Office (JPO)**

1. Bibliographic Data:
Date of filing (วันยื่นคำขอ): _____
DIP Application number (เลขที่คำขอ): _____
Date of Publication (วันที่ประกาศโฆษณา): _____
Date of Request for Substantive Examination (วันยื่นขอให้ตรวจสอบการประดิษฐ์): _____
Title of Invention (ชื่อแสดงการประดิษฐ์): _____
Applicant (ชื่อผู้ขอ): _____
The applicant requests participation in the PPH pilot program based on:
Corresponding JPO Application Number (เลขที่คำขอที่ขอใช้ผลการตรวจสอบ): _____
Priority Application Number (เลขที่คำขอที่ยื่นในต่างประเทศเป็นครั้งแรกซึ่งเป็นการประดิษฐ์เดียวกันที่ยื่นในไทย): _____

**2. Documents submitted:**

1.  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 the documents in Thai or English language ; or  
 List of documents (Office Actions) to retrieve via the Dossier Access System

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2.  Copies of all claims determined to be patentable/allowable by the JPO; and  
 translations of the document in Thai or English language; or  
 List of documents (Claims) to retrieve via the Dossier Access System

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3. ; List of references cited by the JPO examiner or  
; Copies of references cited by the JPO examiner

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4.  Claim correspondence table

<b>2.1 List of documents (Office Actions) to retrieve via the Dossier Access System</b>		
<b>Date</b>	<b>Document type/Description</b>	<b>Comment/Remark</b>
Jun.24,2012	Notice of Reasons for Refusal	-
Oct.11,2012	Decision to Grant a Patent	-

<b>2.2 List of documents (Claims) to retrieve via the Dossier Access System (If any)</b>		
<b>Date</b>	<b>Document type/Description</b>	<b>Comment/Remark</b>
Sep.13,2012	Written amendment	Amended before granted



<b>2.3 List of references cited by the JPO examiner</b>		
<b>Publication date</b>	<b>Publication number/Publication Document</b>	<b>Comment/Remark</b>
1998	A. Hassen et al., Resistance of environmental bacteria to heavy metals, Bioresource Technology, Vol. 64, No. 1, , 1998. . , , p. 7-15	Closest prior art
2005	A.A. Belimov et al., Cadmium-tolerant plant growth-promoting bacteria associated with the roots of Indian mustard (Brassi, Soil Biology and Biochemistry, Vol. 37, No. 2, , 2005. . , , p. 241-250	Closest prior art
25-10-2007	US-A1-2007/0249034	-

<b>2.4 Claim Correspondence Table</b>		
<b>Claim in the DIP application</b>	<b>Patentable Claim in the JPO application</b>	<b>Comment/Remark about the correspondence</b>
1-5	1-5	
6	7	
7	10	

Remark / Note (If any)

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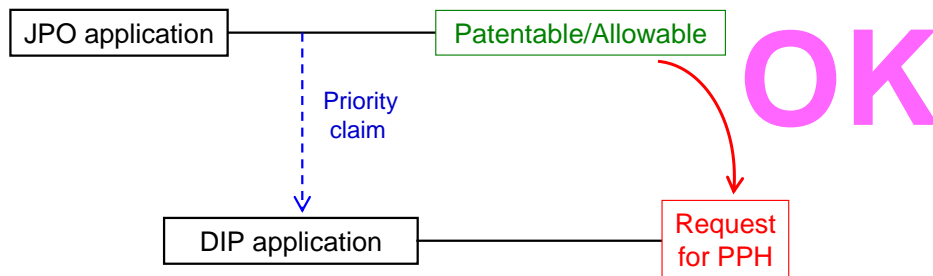
I, hereby, certify that

- The DIP application meets all requirements specified in the Sub-paragraph (a) of Paragraph 1 (Requirements).
- The request for substantive examination must have been filed at the DIP either at the time of the PPH request or previously.
- The DIP application has not been examined after filing the request for substantive examination.

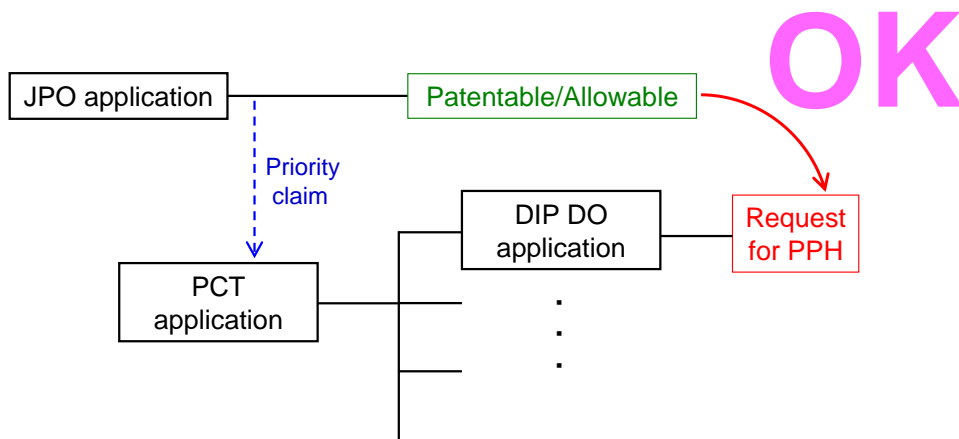
**Name and Signature of Applicant or Agent:**

**Date:**

**A** A case meeting requirement (a) (i)  
- Paris route -



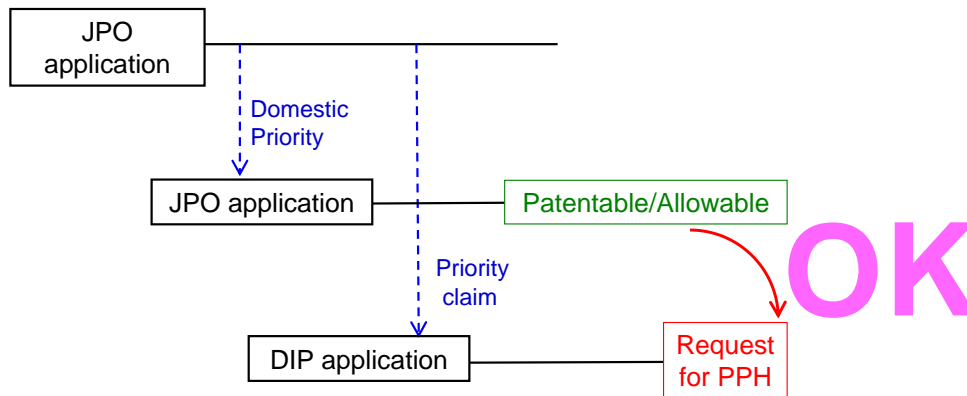
**B** A case meeting requirement (a) (i)  
- PCT route -



C

## A case meeting requirement (a) (i)

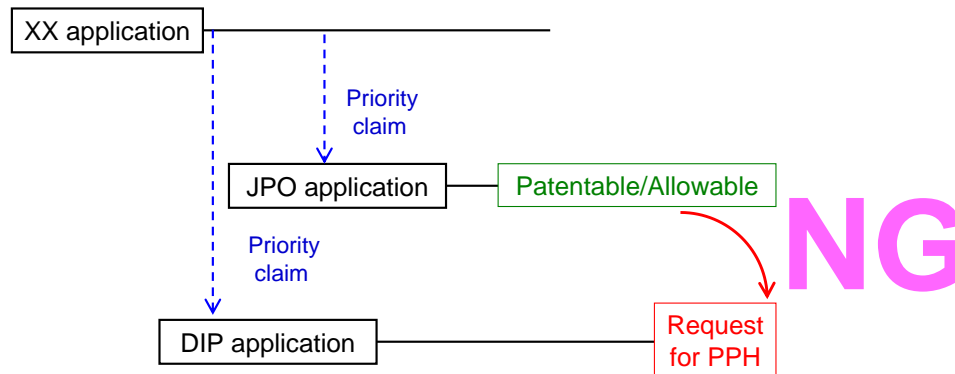
- Paris route, Domestic priority -



D

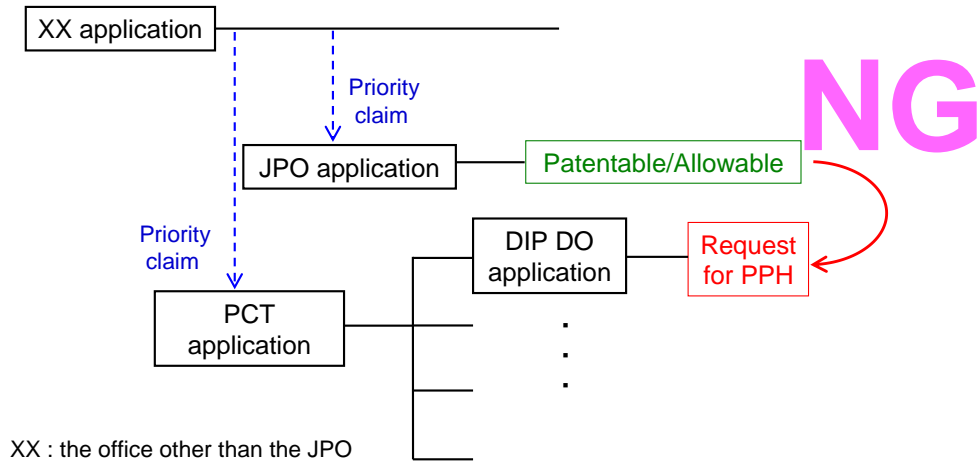
## A case not meeting requirement (a)

- Paris route, but the first application is from the third country -

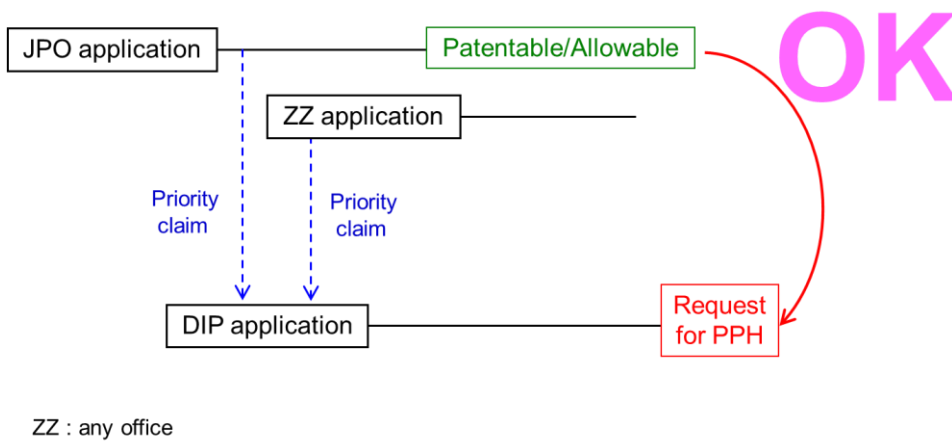


XX : the office other than the JPO

**E** A case not meeting requirement (a)  
 - PCT route, but the first application is from the third country -

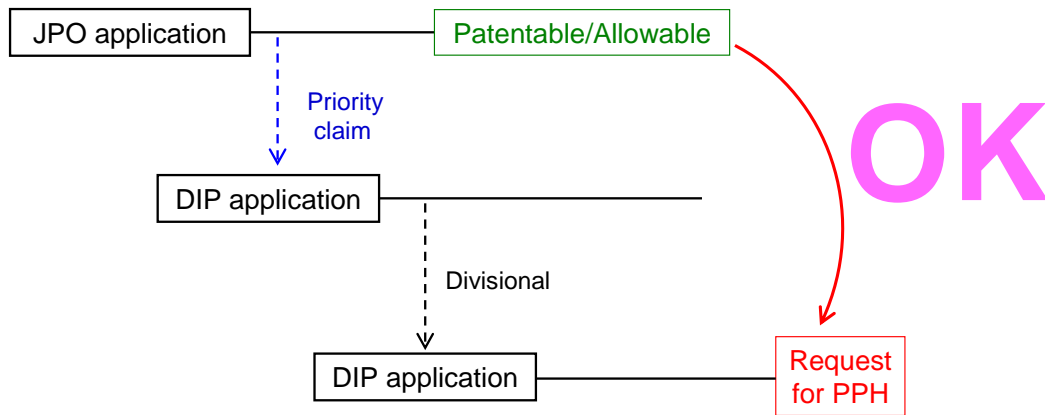


**F** A case meeting requirement (a) (i)  
 - Paris route & Complex priority -



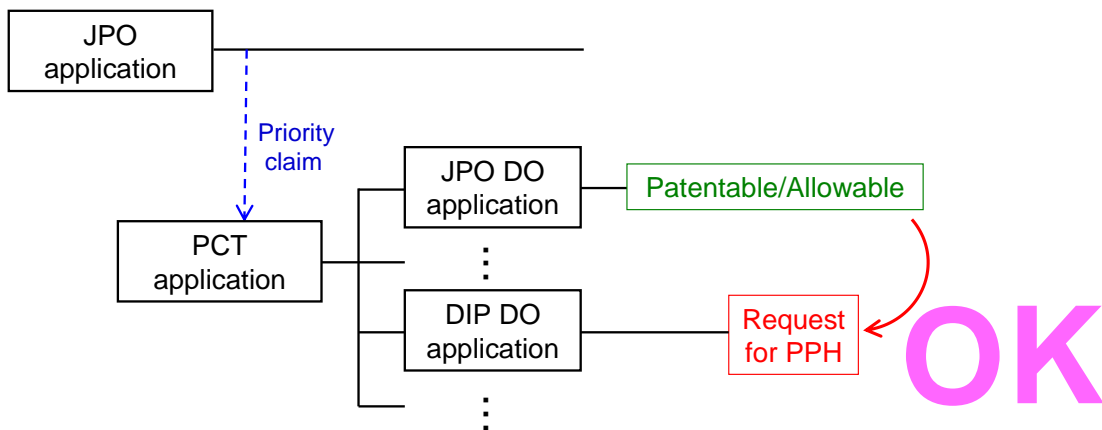
**G**

A case meeting requirement (a) (i)  
- Paris route & divisional application -

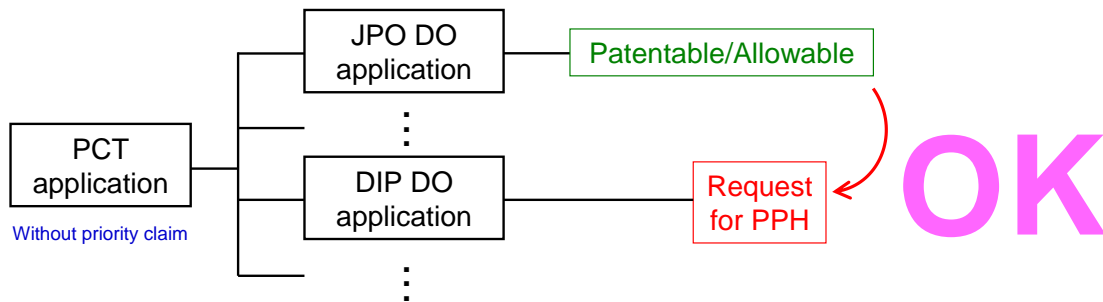


**H**

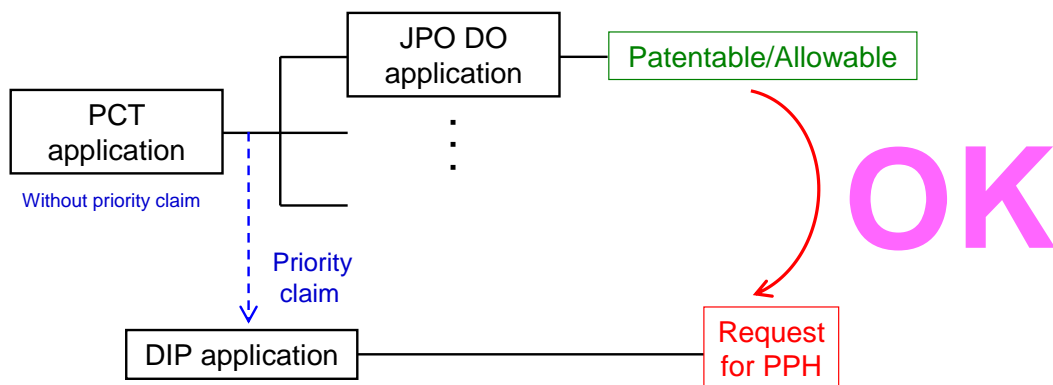
A case meeting requirement (a) (i)  
- PCT route -



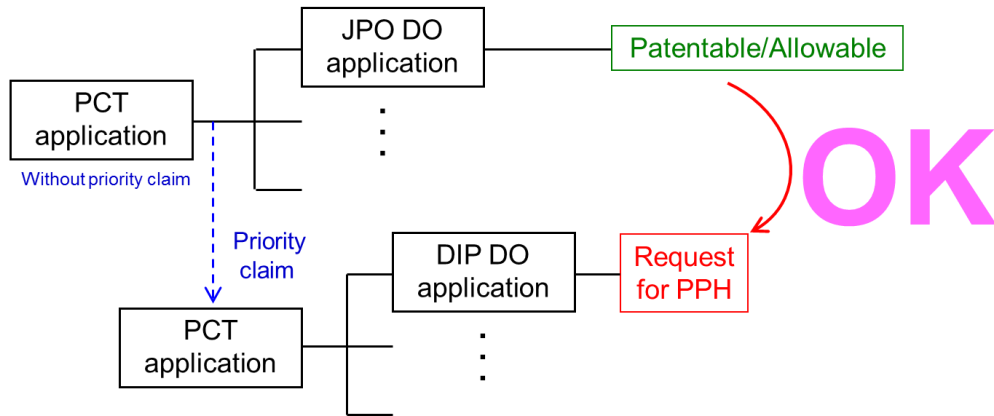
**I** A case meeting requirement (a) (ii)  
- Direct PCT route -



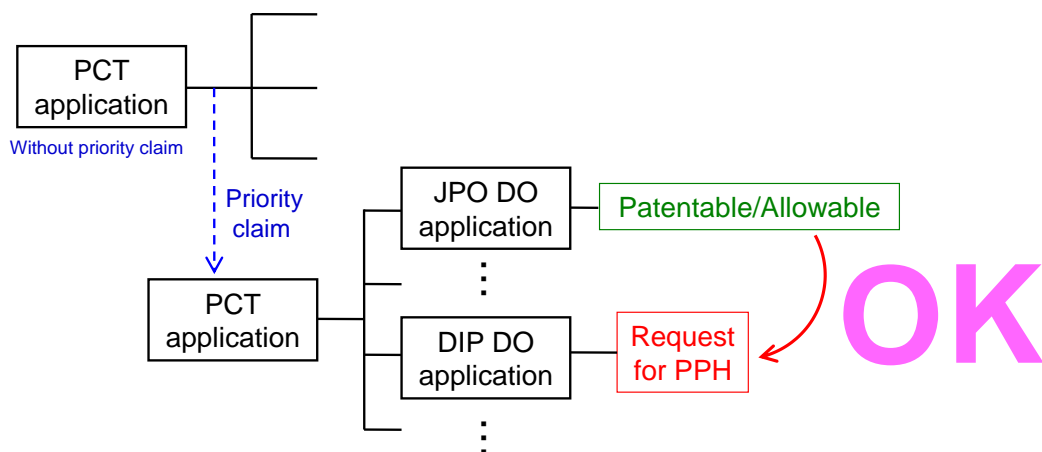
**J** A case meeting requirement (a) (iii)  
- Direct PCT & Paris route -



**K** A case meeting requirement (a) (iii)  
- Direct PCT & PCT route -



**L** A case meeting requirement (a) (iii)  
- Direct PCT & PCT route -





**M** A case not meeting requirement (d)  
- Examination has begun before a request for PPH -

