

GUIDELINE

Procedures to file a request to the INAPI (the National Institute of Industrial Property of Chile) for Patent Prosecution Highway Pilot Program between the INAPI and the State Intellectual Property Office of the P.R.China (SIPO)

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the INAPI and satisfies the following requirements under the SIPO (State Intellectual Property Office of the P.R.China) and INAPI Patent Prosecution Highway (PPH) pilot program based on the SIPO application (Part I) or PCT international work products (Part II).

When filing a request for the PPH pilot program, an applicant must submit a request form available on the INAPI website¹.

The PPH pilot program between INAPI and SIPO will commence on January 1st, 2018 for a trial period of three years and ending on December 31, 2020. The INAPI and SIPO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period.

The offices may terminate the PPH pilot program early 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.

Part I

PPH using the national work products from the SIPO

1. Requirements

- (a) **The INAPI application (including PCT national phase application) is**
- (i) ***an application which validly claims priority under the Paris Convention to the SIPO 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 (example is 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 INAPI application, which validly claims priority to multiple SIPO 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 the SIPO and has one or more***

¹ <https://ion.inapi.cl/FormulariosPdf/patente/47.Solicitud-de-Participacion.pdf>

claims that are determined to be patentable/allowable by the SIPO.

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

Claims are “determined to be allowable/patentable” when the SIPO examiner clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet. A claim determined as novel, inventive and industrially applicable by the SIPO has the meaning of allowable/patentable for the purposes of this pilot program.

The office action includes:

- (a) Decision to Grant a Patent
- (b) First/Second/Third/... Office Action
- (c) Decision of Refusal
- (d) Reexamination Decision, and
- (e) Invalidation Decision

Claims are also “determined to be patentable” in the following circumstance: If the SIPO office action does not clearly state that a particular claim is patentable, the applicant must include an explanation accompanying the request for participation in the PPH pilot program that no rejection has been made in the SIPO office action regarding that claim, and therefore, the claim is deemed to be patentable by the SIPO.

(c) All claims in the INAPI application, 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 SIPO.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the INAPI are of the same or similar scope as the claims in the SIPO, or the claims in the INAPI are narrower in scope than the claims in the SIPO. In this regard, a claim that is narrower in scope occurs when a SIPO 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 INAPI which introduces a new/different category of claims to those claims indicated as allowable in the SIPO is not considered to sufficiently correspond. For example, where the SIPO claims only contain claims to a process of manufacturing a product, then the claims in the INAPI are not considered to sufficiently correspond if the INAPI claims introduce product claims that are dependent on the

corresponding process claims.

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

(d) *The INAPI application must have been published.*

The publication in the Gazette must have taken effect, and the time period of 45 days provided in Article 5 of the Chilean Industrial Property Law must have ended.

(e) *Substantive examination of the INAPI application for which participation in the PPH is requested has not begun. Substantive examination is considered to have begun when the Examiners accept its designation.*

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to the request form PPH in filing a request under PPH.

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

Either Spanish or English is acceptable as translation language². The applicant does not have to submit a copy of SIPO office actions and translations of them when those documents are provided via WIPO CASE because the office actions and their translations are available for the INAPI examiner. If they cannot be obtained by the INAPI examiner via WIPO CASE, the applicant may be notified and requested to provide the necessary documents.

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

Either Spanish or English is acceptable as translation language. The applicant does not have to submit a copy of claims indicated to be patentable/allowable in the SIPO, and translations thereof when the documents are provided via WIPO CASE because the claims and their translations are available for the INAPI examiner. If they cannot be obtained by the INAPI examiner via WIPO CASE, the applicant may be notified and requested to provide the necessary documents.

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

² Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

If the references are patent documents, the applicant doesn't have to submit them because the INAPI usually possesses them. When the INAPI 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 INAPI application sufficiently correspond to the patentable/allowable claims in the SIPO 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 INAPI through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

3. Procedure for the accelerated examination under the PPH pilot program

The INAPI 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 INAPI 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. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to correct certain specified defects. 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 only once again in a renewed request for participation.

If all requirements for accelerated examination under the PPH are met, the INAPI will notify the applicant that the application has been allowed entry on to the PPH.

Part II

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

1. Requirements

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

- (1) 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 SIPO, 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.

- (2) The relationship between the application and the corresponding international application satisfies one of the following requirements:**
 - (A) The application is a national phase application of the corresponding international application. (See Figures A, A', and A'' in Annex II)**
 - (B) The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex II)**
 - (C) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure**

C in Annex II)

(D) The application is a national application claiming foreign priority from the corresponding international application. (See Figure D in Annex II)

(E) 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 and E2 in Annex II)

(3) 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.

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

A claim in the INAPI 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. For example, where the claims indicated as allowable in the latest international work product only contain claims to a process of manufacturing a product, then the claims in the INAPI are not considered to sufficiently correspond if the INAPI 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 corresponding international application by the SIPO (the deletion of claims is allowable). For example, in the case where the corresponding international application before the SIPO contains 5 claims determined to be patentable/allowable, the application in the INAPI may contain only 3 of these 5 claims.

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program must sufficiently correspond to the claims indicated as allowable in the latest international work product.

(4) The INAPI application must have been published.

The publication in the Gazette must have taken effect, and the time period of 45 days provided in Article 5 of the Chilean Industrial Property Law must have ended.

- (5) Substantive examination of the INAPI application for which participation in the PPH is requested has not begun. Substantive examination is considered to have begun when the Examiners accept its designation**

2. Documents to be submitted

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.

- (1) A copy of the latest international work product which indicated the claims to be patentable/allowable and translations of them³.**

Either Spanish or English is acceptable as translation language. If the copy of the latest international work product is available in Spanish or English via “PATENTSCOPE (registered trademark)”⁴, an applicant need not submit these documents unless otherwise requested by the INAPI (WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date).

- (2) 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 them.**

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 in Spanish or English 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 INAPI.

- (3) A copy of references cited in the latest international work product of the international application corresponding to the application.**

If the reference is a patent document, the applicant is not required to submit it. In case the INAPI has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

- (4) A claims correspondence table which indicates how all claims in the application**

³ Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

⁴ <http://www.wipo.int/pctdb/en/index.jsp>

sufficiently correspond to the claims indicated to be patentable/allowable.

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 based on the criteria 1. (3) (Please refer to the Example form below).

When an applicant has already submitted the above mentioned documents (1) - (4) to the INAPI through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

3. Procedure for the accelerated examination under the PPH pilot program

The INAPI 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 INAPI 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. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, 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 only once again in a renewed request for participation.

If all requirements for accelerated examination under the PPH are met, the INAPI will notify the applicant that the application has been allowed entry on to the PPH.

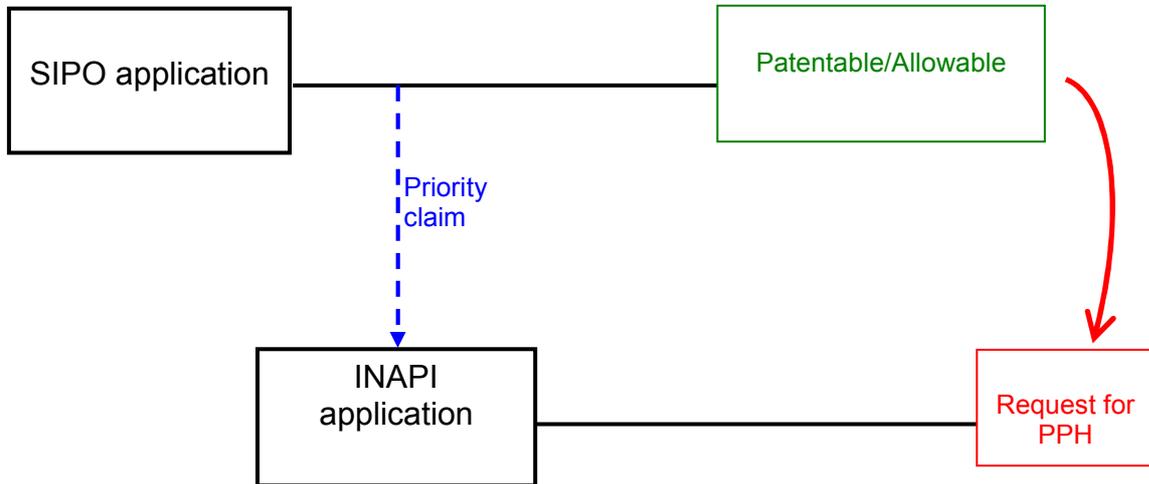
INAPI PPH request form

※Link for download INAPI PPH request form:

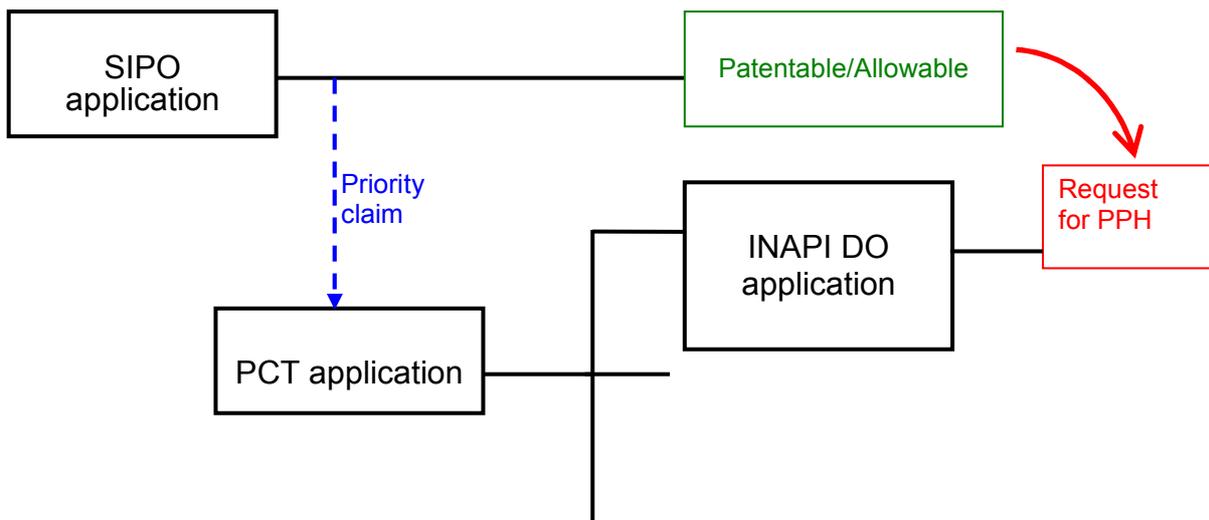
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ANNEX I

A, Paris Route

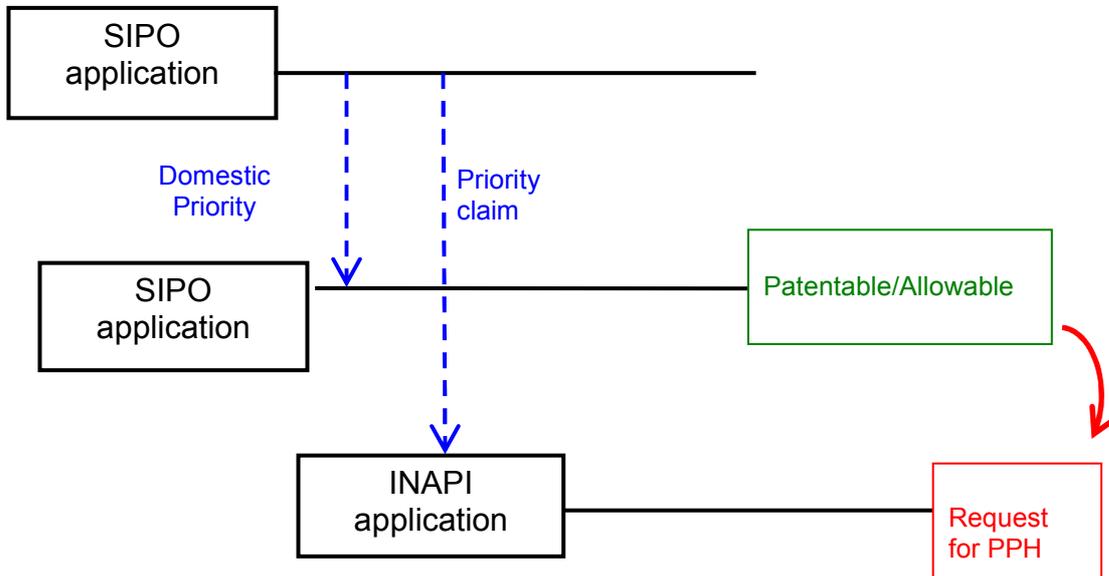


B, PCT Route

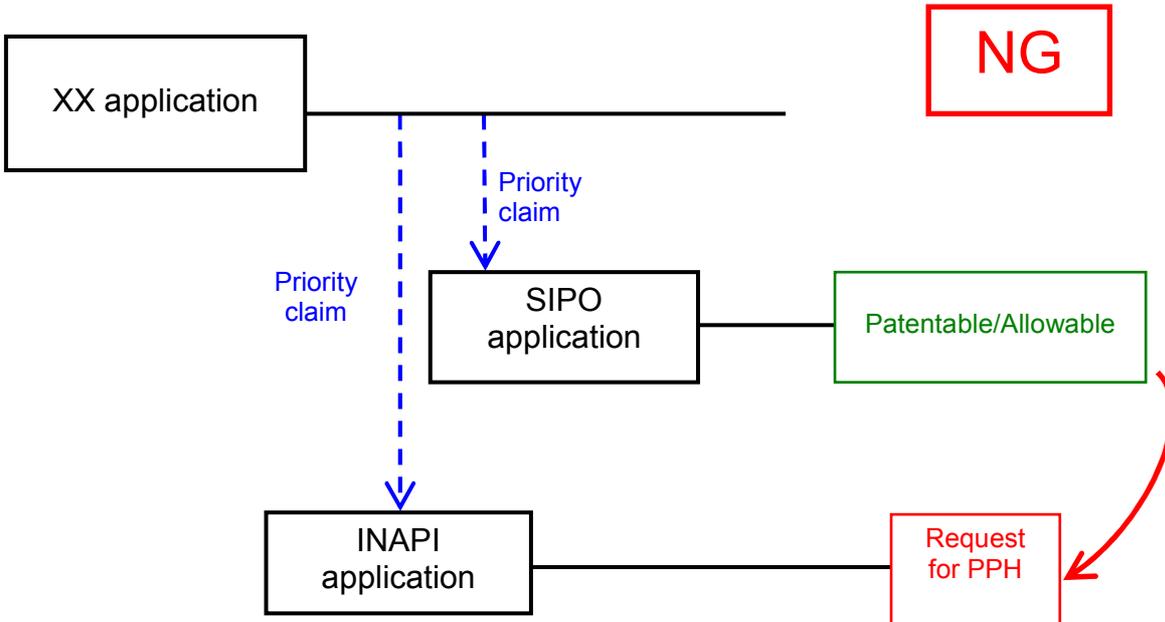


DO = Designated Office

C, Paris route, Domestic Priority

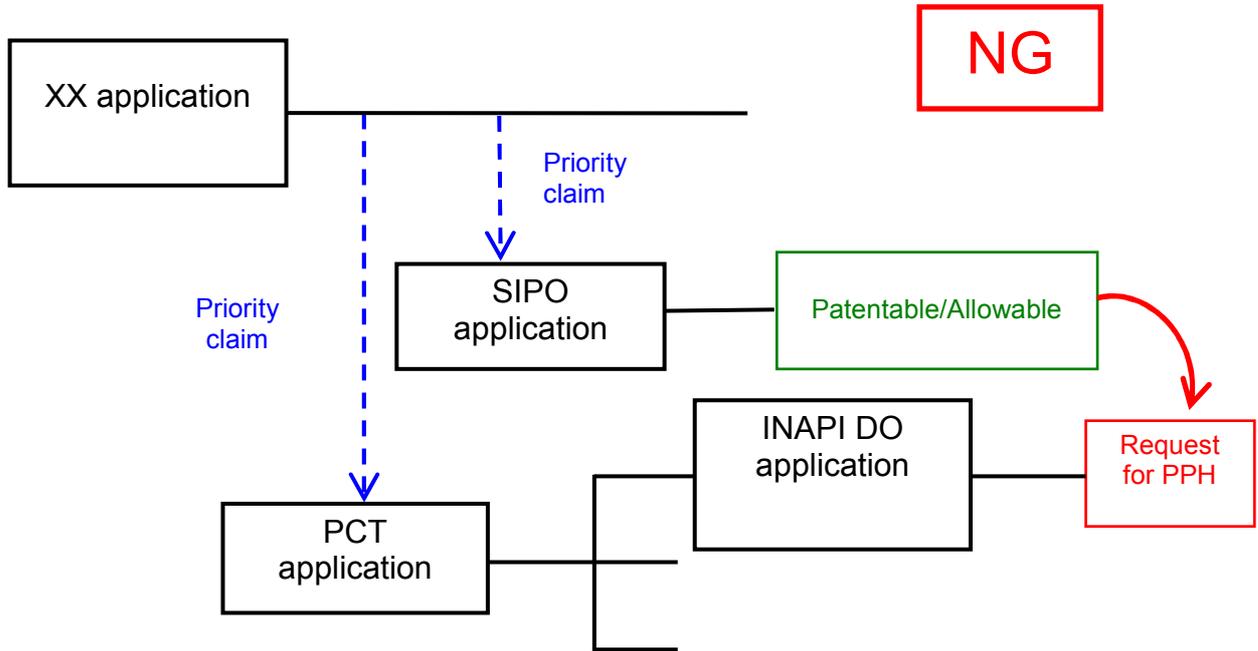


D, Paris route, but the first application is from the third country



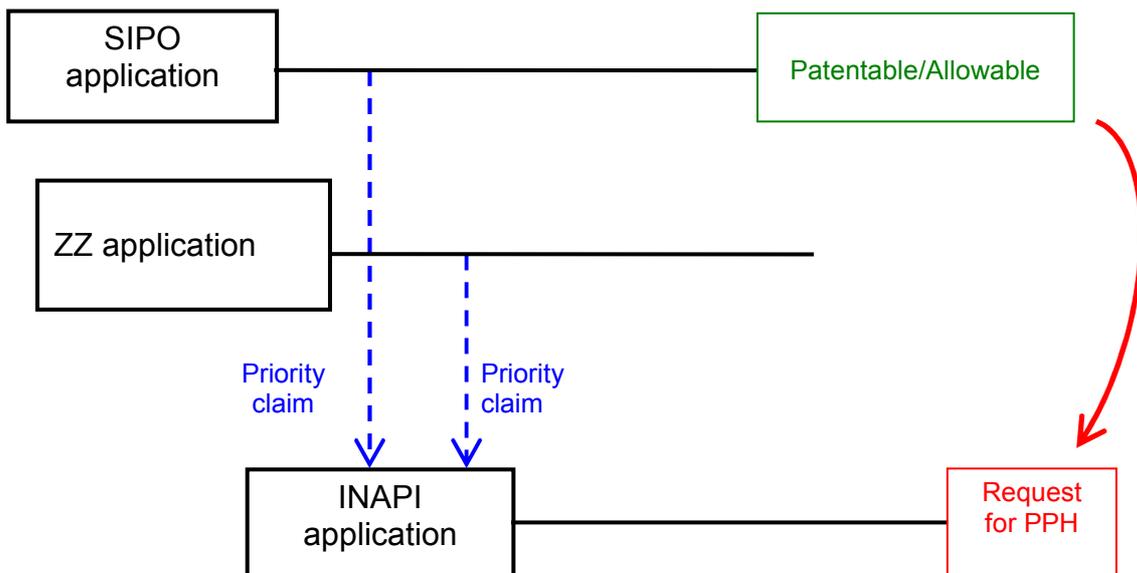
XX = The office other than the SIPO

E, PCT route, but the first application is from the third country



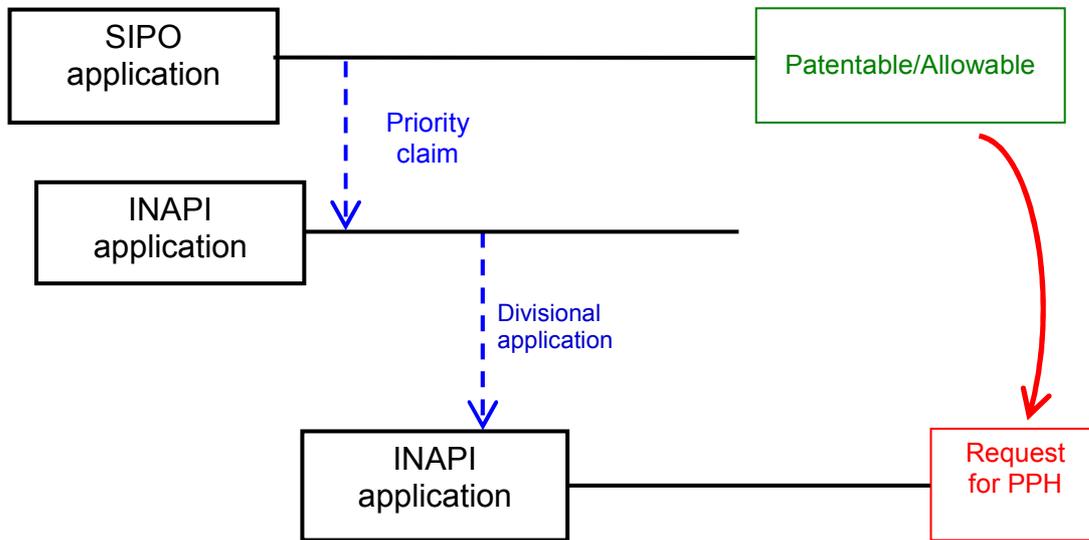
XX = The office other than the SIPO

F, Paris route and complex priority

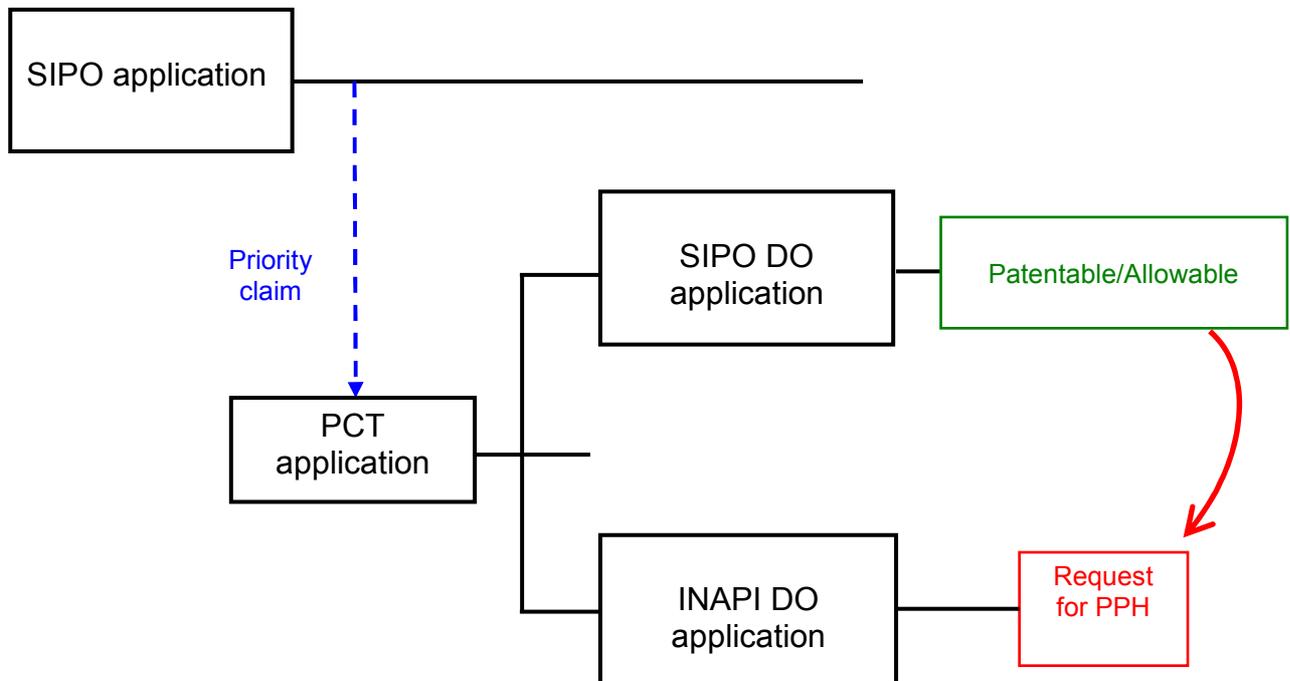


ZZ = Any office

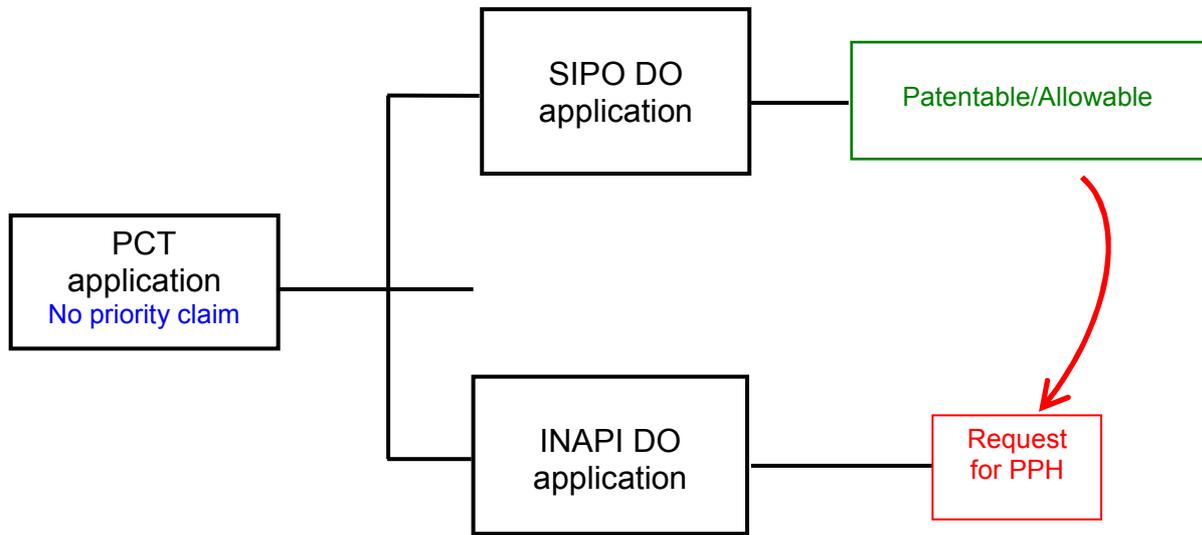
G, Paris route and divisional application



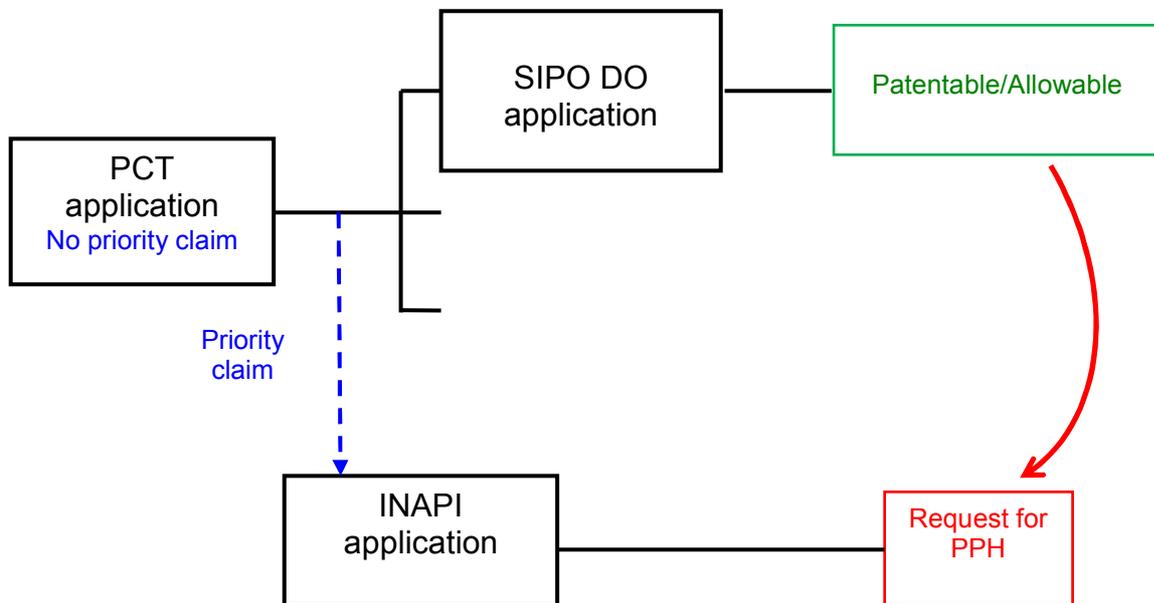
H, PCT route



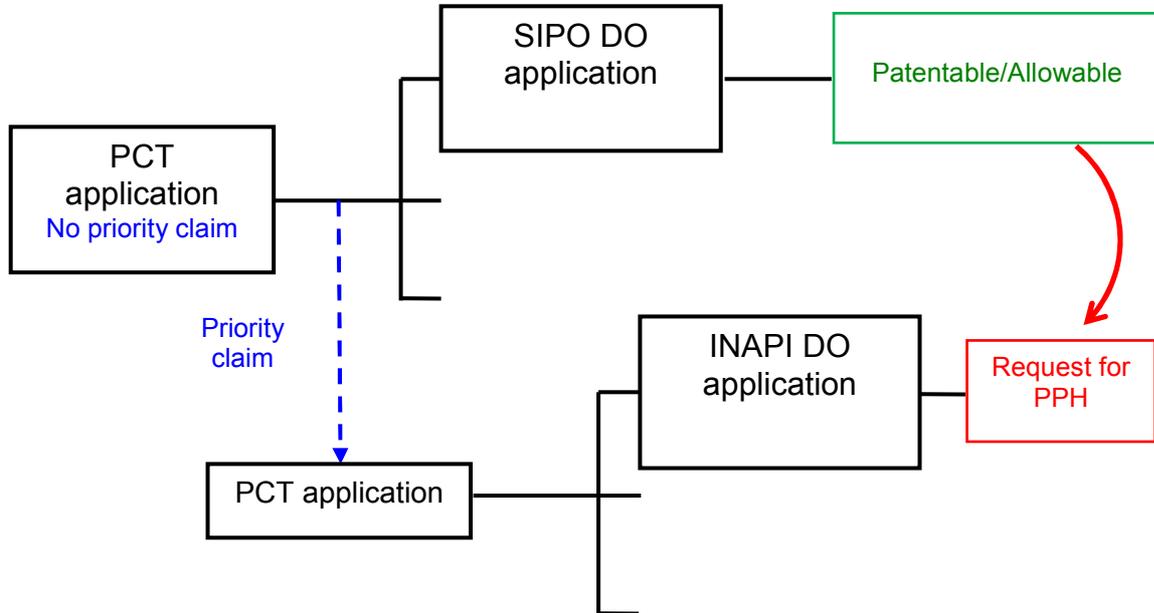
I. Direct PCT route



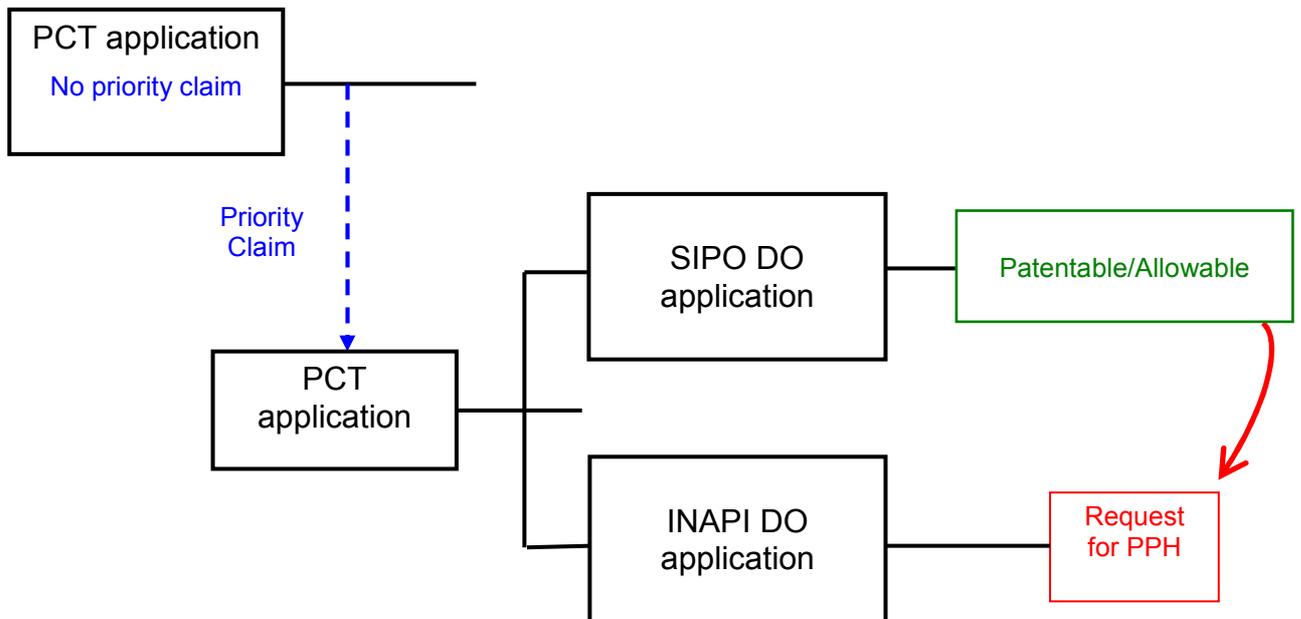
J. Direct PCT and Paris route



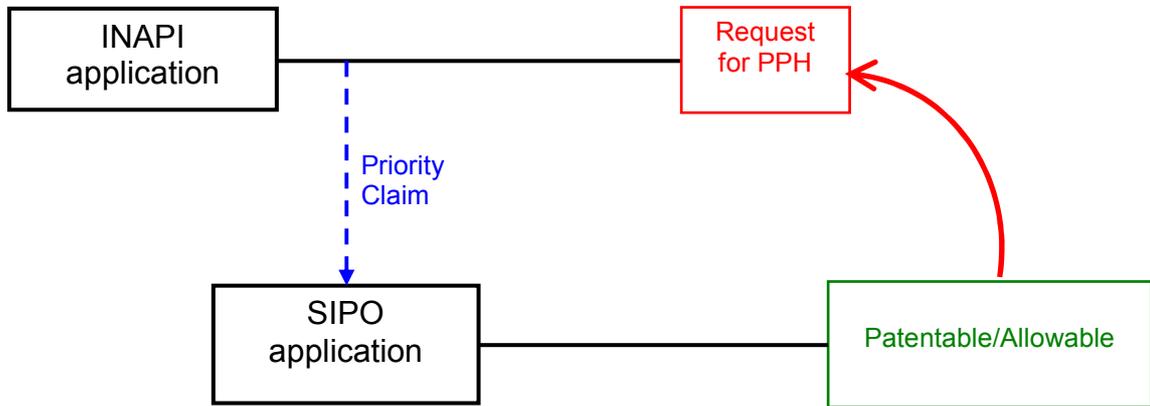
K. Direct PCT and PCT route



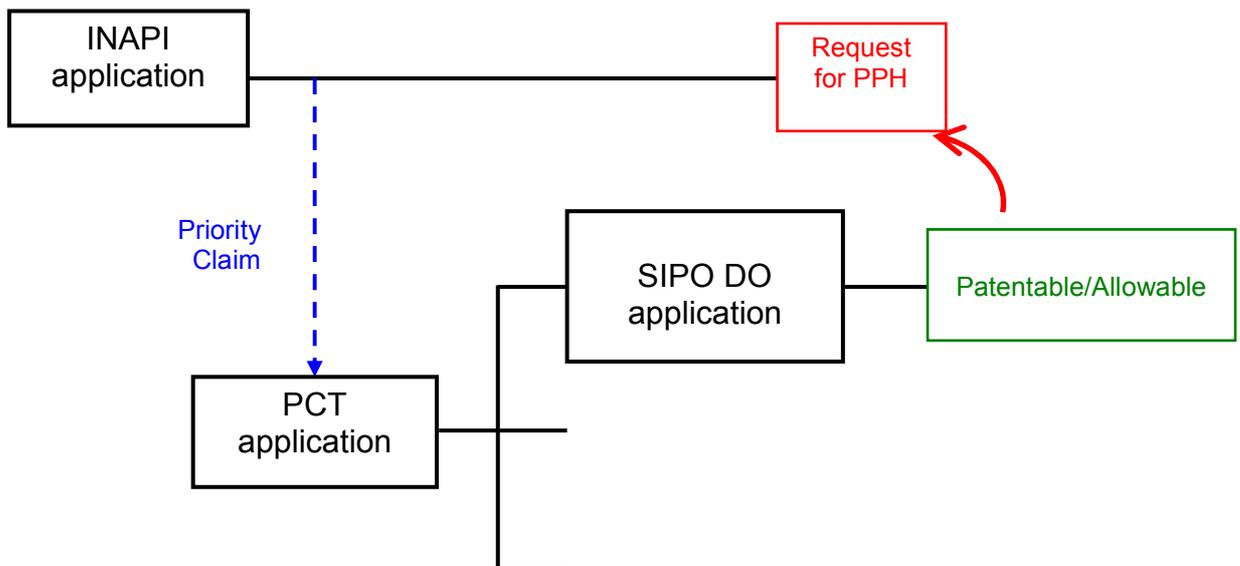
L. Direct PCT and PCT route



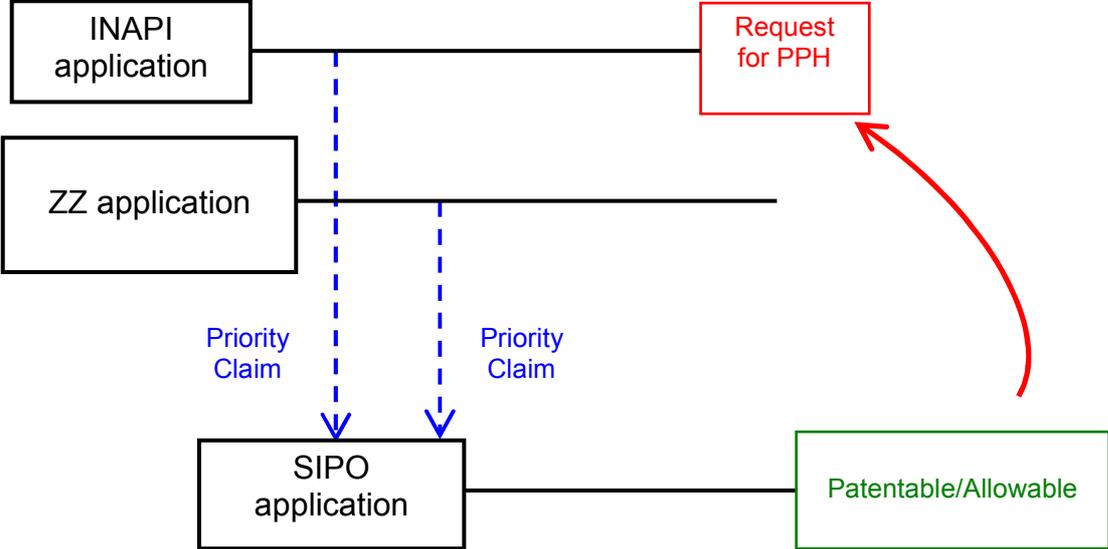
M, Paris route



N, Paris route and PCT route



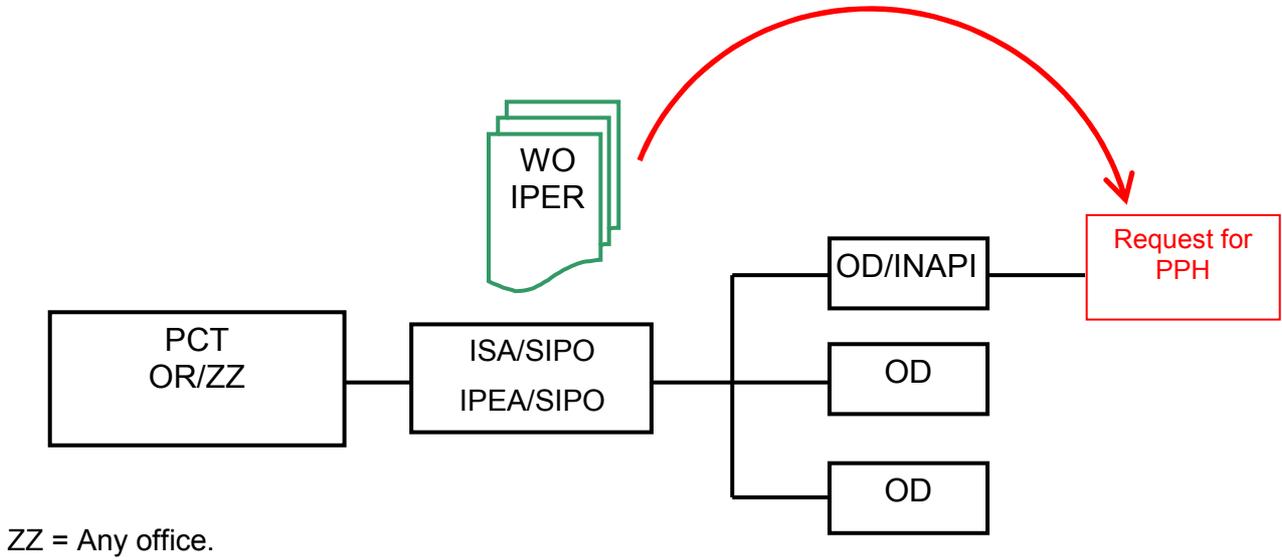
O, Paris route



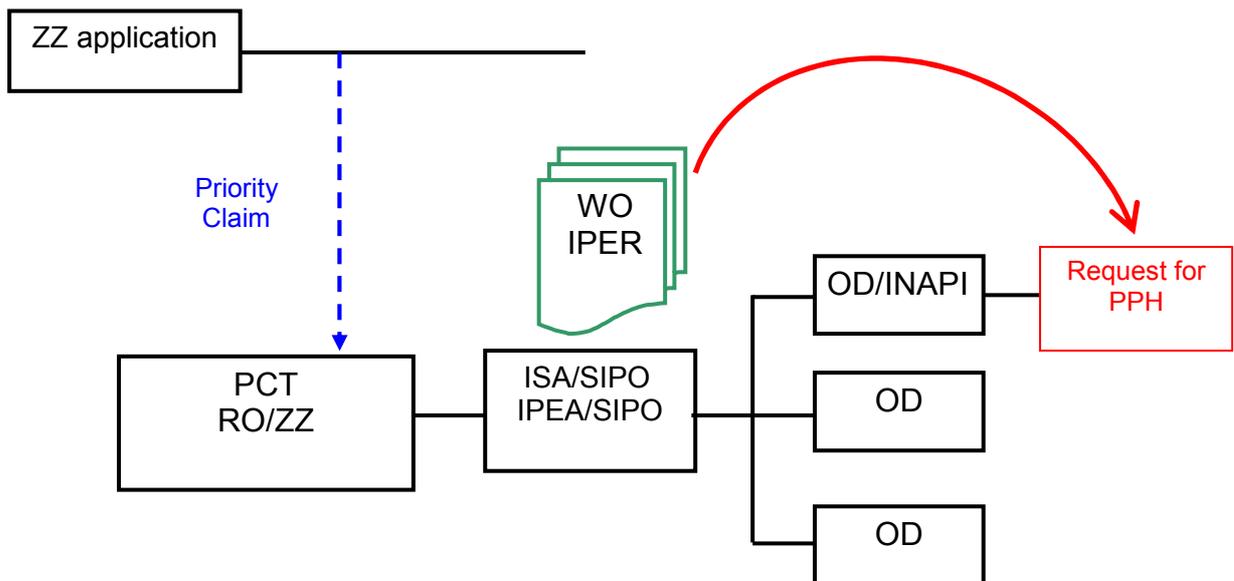
ZZ = Any office.

ANNEX II

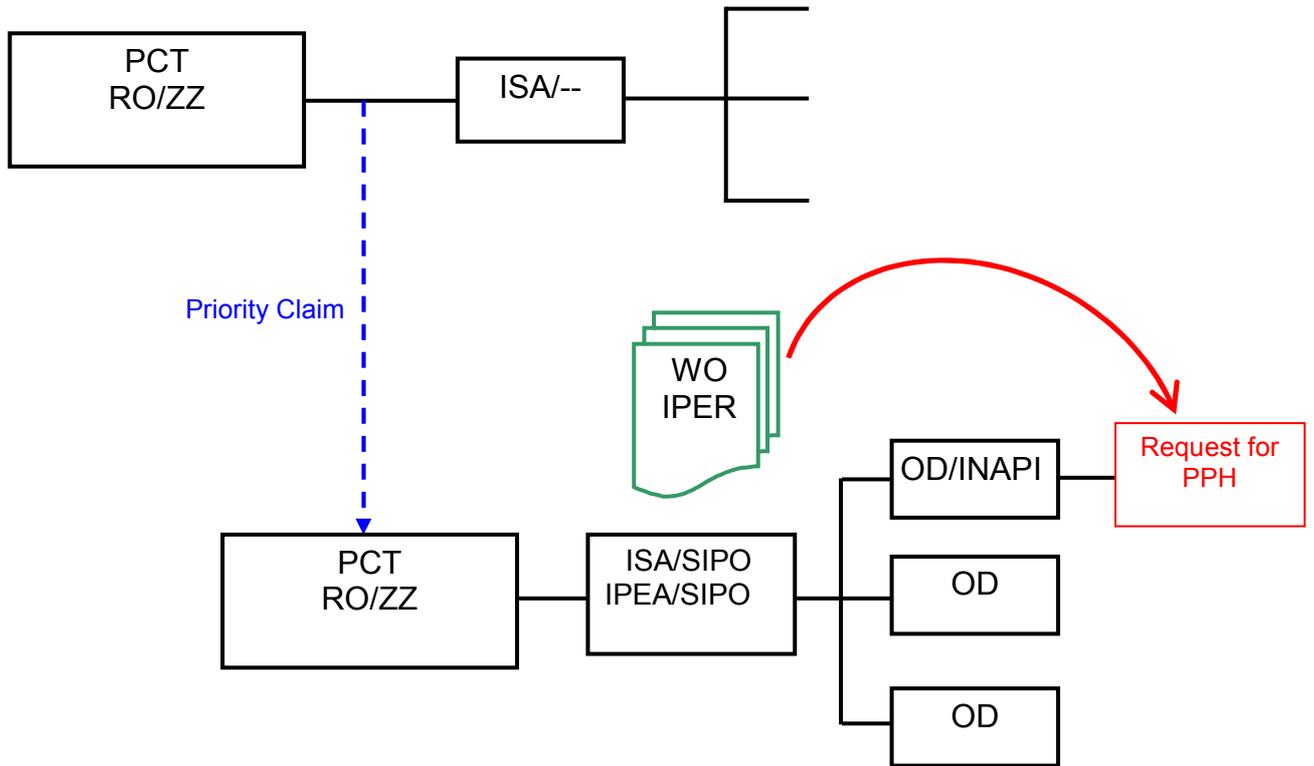
A. The application is a national phase application of the corresponding international application



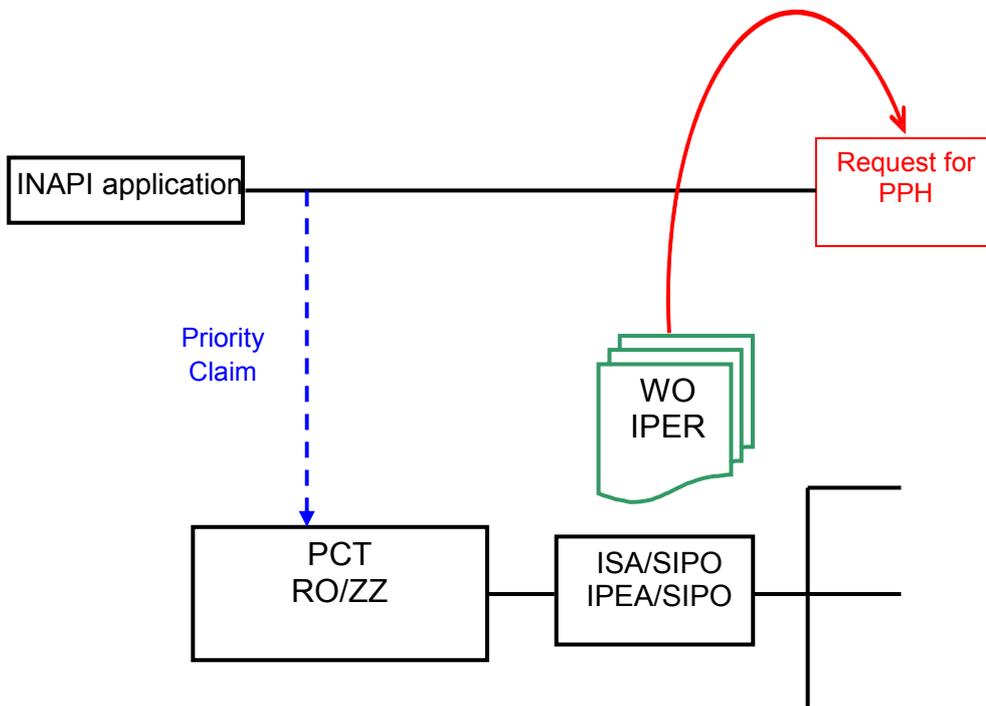
A'. The application is a national phase application of the corresponding international application
(The corresponding international application claims priority from a national application)



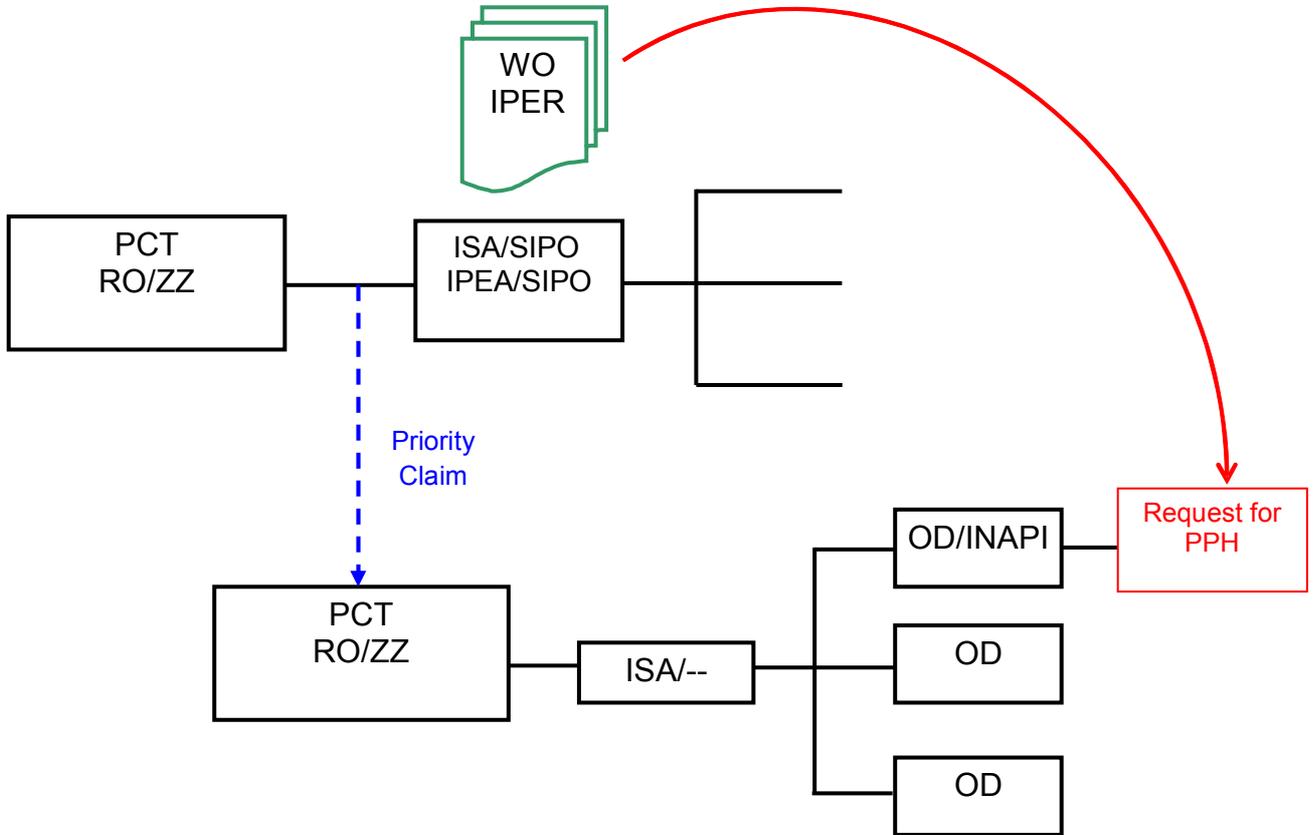
A". The application is a national phase application of the corresponding international application (The corresponding international application claims priority from an international application)



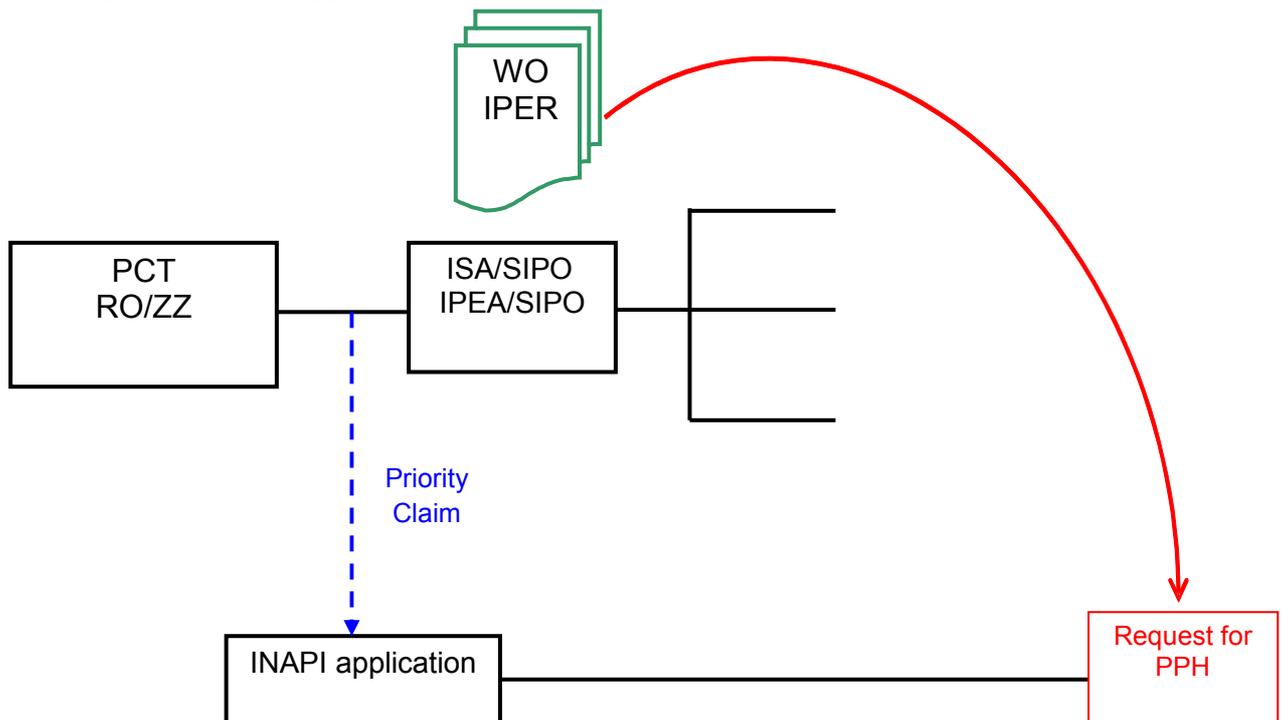
B. The application is a national application as a basis of the priority claim of the corresponding international application



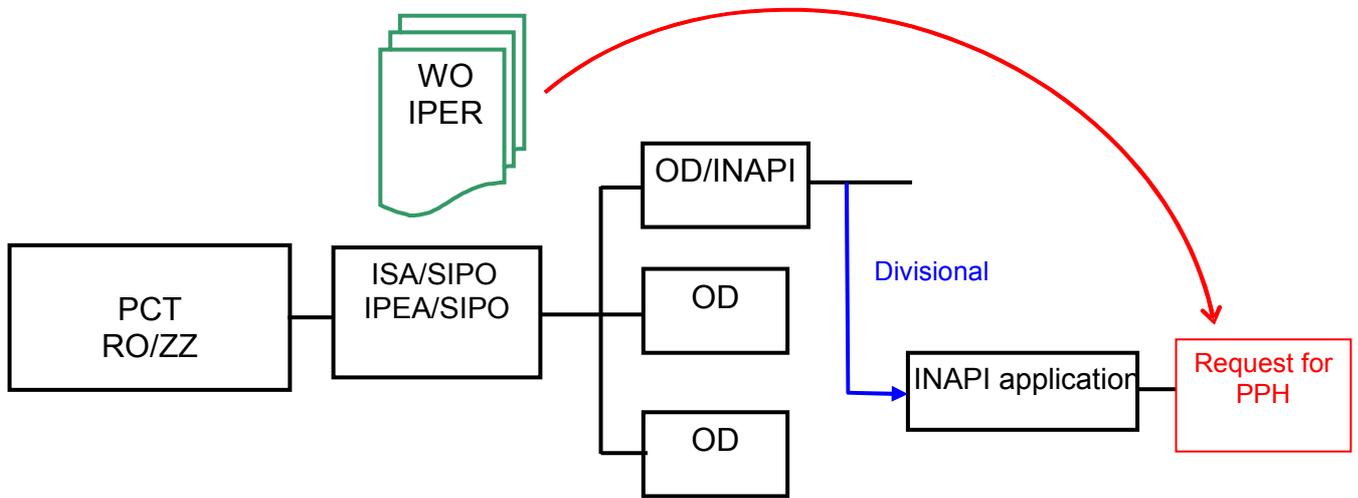
C. The application is a national phase application of an international application claiming priority from the corresponding international application



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)

