

China National Intellectual Property Administration Patent Prosecution Highway

The CNIPA-IPONZ Patent Prosecution Highway (PPH) allows patent applicants to request expedited examination with IPONZ if one or more claims in a corresponding patent application have been found to be allowable by the CNIPA.

This page provides guidelines on how the CNIPA-IPONZ PPH pilot will operate in New Zealand and how to request expedited examination under this PPH.

For the duration of the pilot agreement, patent applicants can request accelerated processing of an application at IPONZ, based on work products for a corresponding application from CNIPA, providing the eligibility criteria are met.

How to file a request

Before you file, check that your request meets the eligibility criteria for expedited examination under the CNIPA PPH and you have the required documents.

To file a request for request expedited examination under the CNIPA PPH, use the IPONZ case management facility.

Eligibility Criteria

In order for a request to be eligible for expedited examination under the CNIPA-PPH, your application must meet the following conditions:

1. **Dates:** The application to be examined by IPONZ and the corresponding application examined by CNIPA must have the same earliest date (which may be the priority date or the filing date).
2. **Patentable claims:** At least one claim has been found to be patentable by CNIPA, i.e. novel, inventive and useful/industrially applicable. There must be an express statement of patentability for these claim(s) in a work product issued by CNIPA.

Filing requirements

The following are filing requirements for expedited examination under the CNIPA PPH:

- 1) The claim(s) presented for examination at IPONZ must “sufficiently correspond” to one or more of the claims found patentable by CNIPA.
- 2) A request for examination has been filed. This can be made prior to, or at the same time as requesting expedited examination under the CNIPA PPH.
- 3) The following documents must be provided as part of your request:
 - a) A copy of the work product(s) issued by CNIPA which expressly identifies the patentable claims; and
 - b) A copy of the claims that the CNIPA examination has found to be patentable; and
 - c) A claim correspondence table which sets out the patentable claim(s) of the CNIPA application and identifies the "sufficiently corresponding" claim(s) to be examined by IPONZ.

In instances where the claims to be examined are identical to those found patentable, a statement to this effect is also acceptable.

- d) A complete specification document which includes the claims which “sufficiently correspond” to those found patentable by CNIPA.

An English language copy of all documents must be provided.

Optional documents

You can also provide additional documents with your request, such as a cover letter, documents cited against the corresponding application, non-patent literature cited by CNIPA, or other materials that relate to the request. IPONZ may also request copies of citations raised against the earlier application if they are not available via regular databases or search files, or translations thereof.

The meaning of ‘sufficiently correspond’

All claims to be examined by IPONZ must “sufficiently correspond” to the claim(s) of the CNIPA application. Claims are considered to ‘sufficiently correspond’ where the claims to be examined by IPONZ are of the same or similar scope as the claims indicated as patentable by CNIPA, or the claims are narrower in scope than the claims indicated as patentable.

Claim(s) to be examined by IPONZ cannot be broader in scope than those found patentable by the CNIPA. IPONZ will also account for the effects of any translations into the English language if the original claims were not in English.

Different claim categories

Claim(s) which introduce a new/different category of claims to those claims determined to be patentable are not considered to sufficiently correspond.

For example, if the CNIPA application contains only claims to an article, then claims to a method of making the article will not sufficiently correspond.

Amending to claims which sufficiently correspond

You can amend your specification to claims which sufficiently correspond prior to, or at the time of, submitting your request for expedited examination under the CNIPA PPH.

A voluntary amendment fee will apply if you make any amendments after requesting examination.

What is a valid work product?

A work product is a formal report or action issued by the CNIPA.

A request under the CNIPA PPH requires a report or action issued by CNIPA that expressly identifies the patentable claim(s). A patentable claim must be assessed as novel, inventive and useful/capable of industrial applicability.

This can be any report or action issued by the CNIPA, as long as the patentable claims are clearly identified.

A Written Opinion or International Preliminary Report on Patentability issued by the CNIPA as the International Search Authority or International Examination Authority is a valid work product.

Multiple work products can also be used in a single request, provided they share the same earliest date.

Relevant dates for examination in New Zealand

Requesting examination of an application prior to examination eligibility

National phase entry applications under the Patent Cooperation Treaty (also known as ‘Treaty’ applications) are only eligible for examination if at least 31 months have passed since the earliest priority date.

This examination eligibility requirement applies even if you request us to expedite the examination of your Treaty application under the CNIPA PPH.

If you intend for us to examine your Treaty application ahead of its eligibility date, you must indicate this as part of your CNIPA PPH request.

This request is separate to the request for expedited examination under the CNIPA PPH.

Late entry into national phase requires restoration

If a Treaty application is filed at IPONZ later than the 31-month national phase entry deadline, a request for expedited examination under the CNIPA PPH *cannot* be made at the same time.

Your application will need to be restored before requesting PPH. Please see the restoration guidelines for more information.

Late convention claims

If a convention application is filed at IPONZ later than the 12 month convention period, you can still make a request for expedited examination under the CNIPA PPH at the time of filing.

However, this request will not be actioned until the applicant has satisfied the Commissioner that the convention application is entitled to the claimed priority date.

If a convention claim is not found to be entitled to the claimed priority date, then the request for expedited examination under the CNIPA PPH will be refused as the New Zealand application and the CNIPA application would no longer share the same earliest priority or filing dates.

Processing of requests and timelines

Once IPONZ receives a request for expedited examination under the CNIPA PPH, we will assess the request to determine:

1. If your application meets the eligibility requirements
2. If the request meets the filing requirements, including the required documents

If your application does not meet the eligibility requirements, IPONZ will refuse the request.

If your application is eligible, but does not meet the filing requirements, you will be given an opportunity to remedy any issues with the request. You must submit your response and/or additional documentation within 10 working days for their request to be considered. IPONZ may still choose to decline requests that are invalid or do not meet the filing requirements.

If the request meets the eligibility and filing requirements, IPONZ will accept the request.

Once a request for expedited examination is accepted, the application will be allocated to an examiner for substantive examination after the examination eligibility date has been reached.

IPONZ reserves the right to limit participation where incoming CNIPA PPH requests exceed resources.

Fees

There is no fee for requesting expedited examination under the CNIPA PPH.

Other fees may still apply, including a fee to request examination, file an amendment or an excess claims fee.

For more information, please see the Patent fees section of our website.