

Procedures to file a request to the DGIP (Directorate General of Intellectual Property of the Ministry of Law of the Republic of Indonesia) for Patent Prosecution Highway Pilot Program between the DGIP and the CNIPA (China National Intellectual Property Administration)

Part I

PPH using the national work products from the CNIPA

Applicants may request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the DGIP and satisfies the following requirements under the DGIP-CNIPA Patent Prosecution Highway (PPH) pilot program based on the CNIPA application.

When filing a request for the PPH pilot program, an applicant must submit a request form to the DGIP. To file a request of PPH, DGIP charges a fee in accordance with the applicable Non-Tax State Revenue (PNBP) tariff within the Ministry of Law.

The offices may terminate the PPH pilot program 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.

1. Requirements

- (a) **Both the DGIP application on which PPH is requested and the CNIPA 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 DGIP application (including PCT national phase application) may be either:

(I) an application which validly claims priority under the Paris Convention from the CNIPA application(s) except for a complex priority (examples are provided in Annex, Figures 1, 2, 3, 8, 9 and 10); or

(II) an application which provides the basis of a valid priority claim under the Paris Convention for the CNIPA application(s) (including PCT national phase application(s)) (examples are provided in Annex, Figures 4 and 5), or

(III) a PCT national phase application where both the DGIP application and the CNIPA application(s) are derived from a common PCT international application having no priority claim (an example is provided in Annex, Figures 11, 12, 13 and 14).

(b) Patent applications have been initiated in the Office of the CNIPA or the DGIP.

Patent applications belong to a patent family of which at least the earliest application was filed with the DGIP or the CNIPA acting as a national office (an example of the application which does not comply with this requirement is provided in Annex, Figures 6 and 7). The DGIP application which validly claims priority direct PCT applications is also eligible.

(c) At least one corresponding application exists in the CNIPA and has one or more claims that are determined to be patentable/allowable by the CNIPA.

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the CNIPA application which forms the basis of the priority claim (e.g., a divisional application of the CNIPA application or an application which claims domestic priority to the CNIPA application (see Figure 3 in Annex)), or an CNIPA national phase application of a PCT application (see Figures 10, 11, 13, and 14 in Annex). Claims are “determined to be patentable/allowable” when the CNIPA examiner clearly identified the claims to be patentable/allowable in the latest office action, even if the application is not granted for patent yet. For the purpose of this provision, an “office action” refers to an administrative action, namely an official letter or official decision issued during the substantive examination process of a patent application.

The office action includes:

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

(d) 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 in the CNIPA.

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

- (e) **The DGIP has not begun examination of the application at the time of request for the PPH (an example is provided in ANNEX, Figure 15 and 16).**
- (f) ***The DGIP application must have entered into the substantive examination stage.***

The applicant must have received the *Notice of Invention Patent Application Entering into Substantive Examination Stage* issued from the DGIP before, or when, filing the PPH request (an example is provided in Annex, Figures 17).

Note that as an exception, the applicant may file a PPH request simultaneously with the *Request for Substantive Examination* (an example is provided in ANNEX, Figure 18).

2. Documents to be submitted

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 CNIPA) which were issued for the corresponding application by the CNIPA, and translations of them.**

Either Indonesian or English is acceptable as translation language. The applicant does not have to submit a copy of CNIPA office actions and translations of them when those documents are provided via CNIPA's dossier access system because the office actions and their machine translations are available for the DGIP examiner via the CNIPA's dossier access system. If they cannot be obtained by the DGIP examiner via the dossier access system, the applicant may be notified and requested to provide the necessary documents.

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

Either Indonesian 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 CNIPA, and translations thereof when the documents are provided via CNIPA's dossier access system because they are available for the DGIP examiner via the CNIPA's dossier access system. If they cannot be obtained by the DGIP examiner via the CNIPA's dossier access system, the applicant may be notified and requested to provide the necessary documents.

- (c) **Copies of references cited by the CNIPA examiner**

If the references are patent documents, the applicant doesn't have to submit them because the DGIP

usually possesses them. When the DGIP 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 DGIP application sufficiently correspond to the patentable/allowable claims in the CNIPA 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 DGIP through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

3. PPH request form

Subject: Request for an accelerated examination under the PPH pilot program Date of
filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

The accelerated examination is requested based on a CNIPA application (the application number is _____) under the PPH pilot program. For this purpose, the following documents are attached:

- ☐ Copies of all office actions (which are relevant to substantial examination for patentability in the CNIPA) which were issued for the corresponding application by the CNIPA and translations of them
- ☐ Copies of all claims determined to be patentable/allowable by the CNIPA and translations of them
- ☐ Copies of references cited by the CNIPA examiner
- ☐ Claim correspondence table

Claim correspondence table		
The claim in the DGIP	The patentable claim in the CNIPA	Comments about the correspondence

(Documents to be omitted to submit)

Part II

PPH using the PCT international work products from the CNIPA

Applicants may request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the DGIP and satisfies the following requirements under the DGIP-CNIPA Patent Prosecution Highway pilot program based on PCT international work products (PCT-PPH pilot program).

When filing a request for the PCT-PPH pilot program, an applicant must submit a request form to the DGIP. To file a request of PPH, DGIP charges a fee in accordance with the applicable Non-Tax State Revenue (PNBP) tariff within the Ministry of Law.

The Offices may terminate the PCT-PPH pilot program 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.

1. Requirements

The application which is filed with the DGIP 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), must indicate 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 within the PCT-PPH framework are limited only to the CNIPA. However, if priority is claimed, the priority claim can be based on an application in any Office, as shown in the example 20 in Annex. 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 program if the applicant does not explain why the claim(s) is/are not subject to the observation. However, in this regard, the determination of the adequacy of the explanation and/or whether the proposed amendments have overcome the observations set out in Box VIII shall not prejudice the decision on the application’s eligibility to participate in the PCT-PPH Program.

2) The DGIP application and the corresponding international application shall have the same earliest date, whether this be a priority date or a filing date.

For example, the DGIP application may be either:

- a) a national phase application of the corresponding international application. (See Figures 19 and 20 in Annex), or
- b) a national application as a basis of the priority claim of the corresponding international application. (See Figure 21 in Annex), or
- c) a national phase application of an international application claiming priority from the corresponding international application. (See Figure 22 in Annex), or
- d) a national application claiming foreign priority from the corresponding international application. (See Figure 23 in Annex), or
- e) a derivative application (divisional application and application claiming domestic priority etc.) of an application which satisfies one of the above requirements (A) – (D). (See Figures 24 and 25 in Annex).

3) Patent applications must have been initiated in the Office of the CNIPA or the DGIP.

Patent applications must belong to a patent family of which at least the earliest application was filed with the CNIPA or DGIP acting as a national office (See Figure 20 in Annex).

The DGIP application which validly claims priority to direct PCT applications is also eligible.

4) 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 DGIP are of the same or similar scope as the claims indicated as allowable in the latest international work product, or the claims in the DGIP 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 DGIP which introduces a new or 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 DGIP are not considered to sufficiently correspond if the DGIP 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 PCT-PPH program need not to sufficiently correspond to the claims indicated as allowable in the latest international work product.

- 5) **The DGIP has not begun examination of the application at the time of request for the PCT-PPH.**

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 their Indonesian or English translations if they are not in English.**

In case the application satisfies the relationship as referred to in 1.(2)(A), the applicant need not submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via “PATENTSCOPE (registered trademark)”, an applicant need not submit these documents, unless otherwise requested by the DGIP. (WO/ISA and IPRP 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 their Indonesian or English translations if they are not in English**

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 DGIP. Where the set of claims is written in Chinese, the translations thereof must be still submitted by an applicant.

- 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. However, in case the DGIP has difficulty in obtaining the document, 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 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. (4) (Please refer to the Example form below).

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

3. PCT-PPH request form

Subject: Request for an accelerated examination under the PCT-PPH pilot program Date of
filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

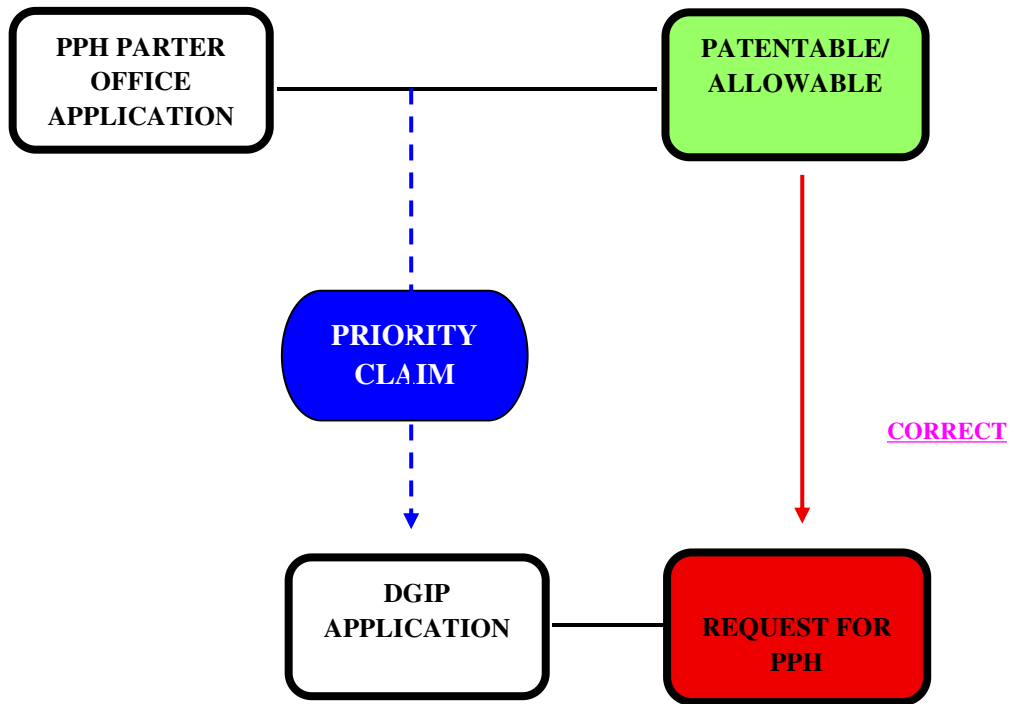
The accelerated examination is requested based on a PCT international application (the application number is _____) under the PCT-PPH pilot program. For this purpose, the following documents are attached:

- ☐ A copy of the latest international work product which indicated the claims to be patentable/allowable and their Indonesian or English translations if they are not in English
- ☐ A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their Indonesian or English translations if they are not in English
- ☐ A copy of references cited in the latest international work product of the international application corresponding to the application
- ☐ A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable

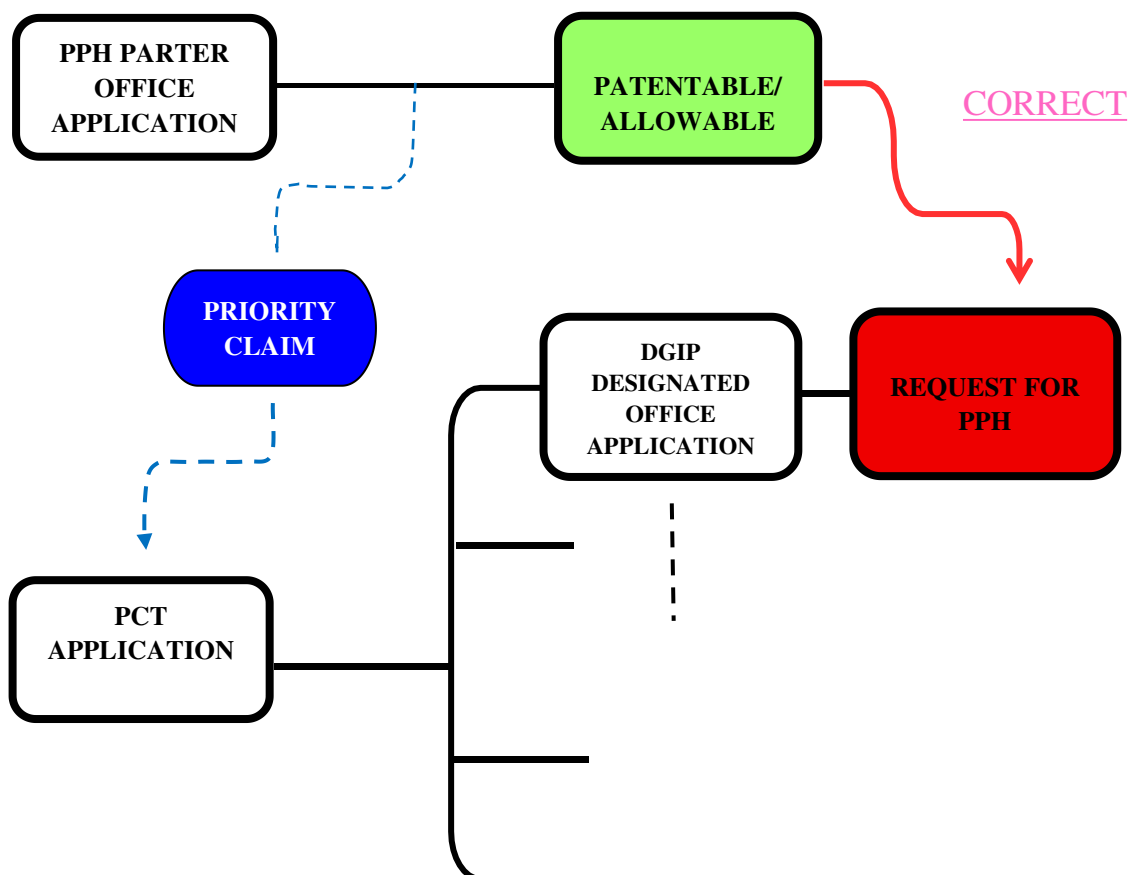
Claim correspondence table		
The claim in the DGIP	The patentable claim in the international phase	Comments about the correspondence

(Documents to be omitted to submit)

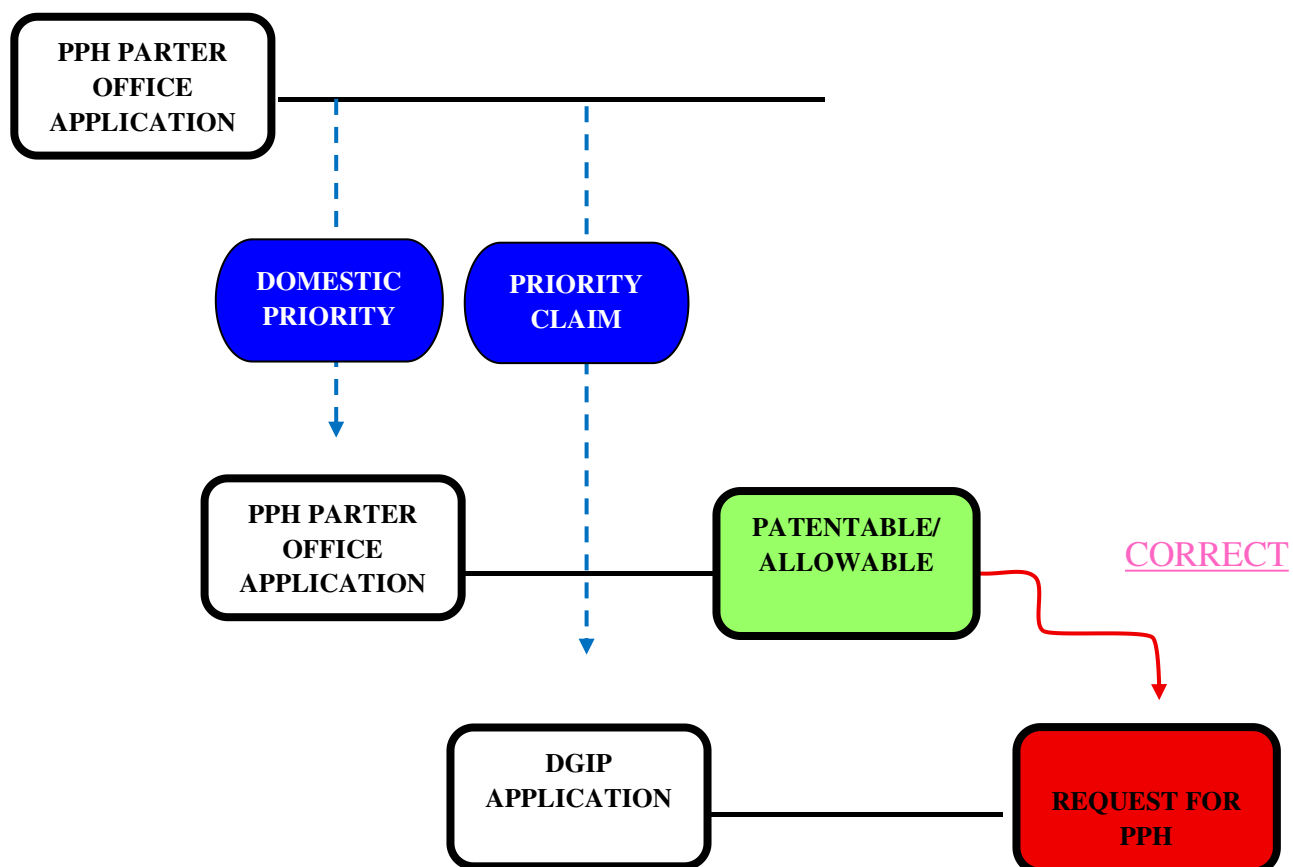
1. A case meeting requirement (a) (I) (Paris Route)



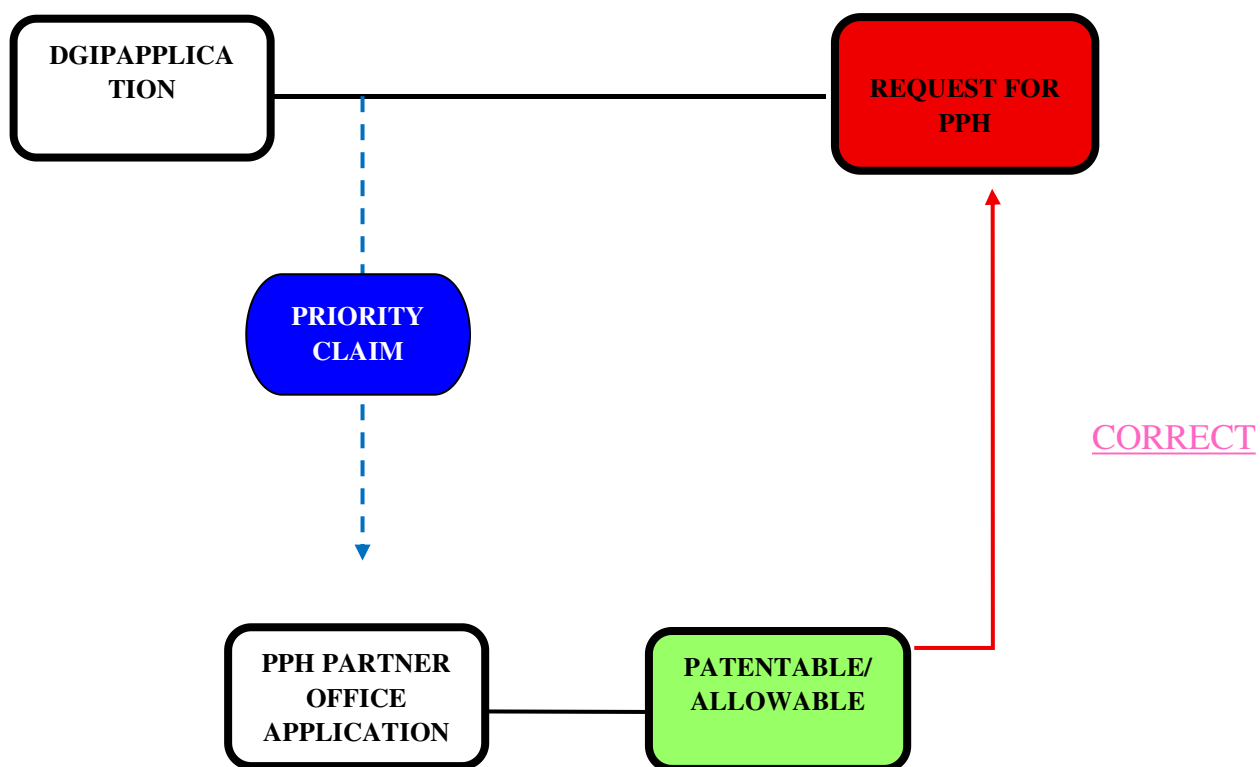
**2. A case meeting requirement (a) (I)
(PCT Route)**



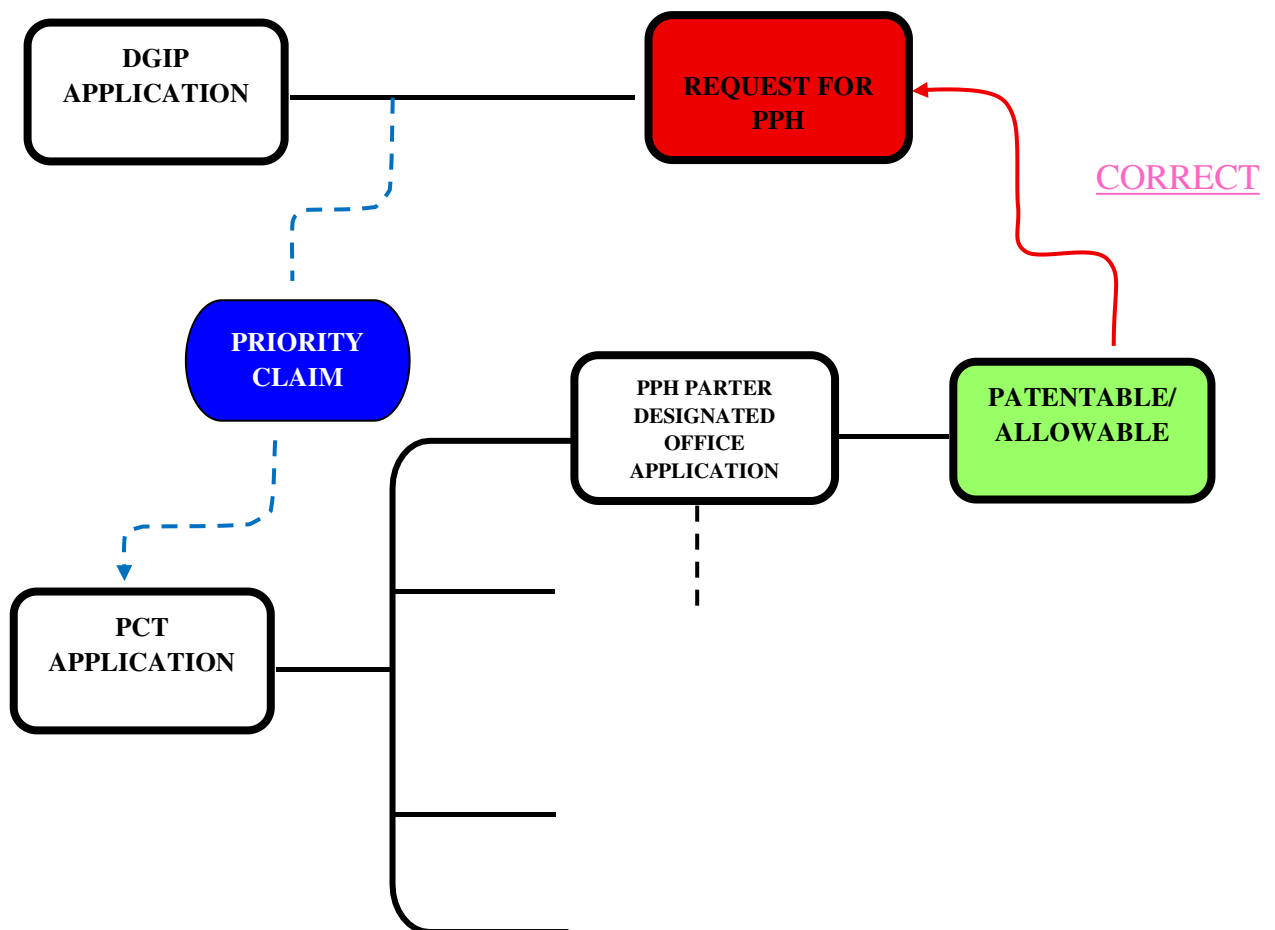
**3. A case meeting requirement (a) (I)
(Paris Route, Domestic Priority)**



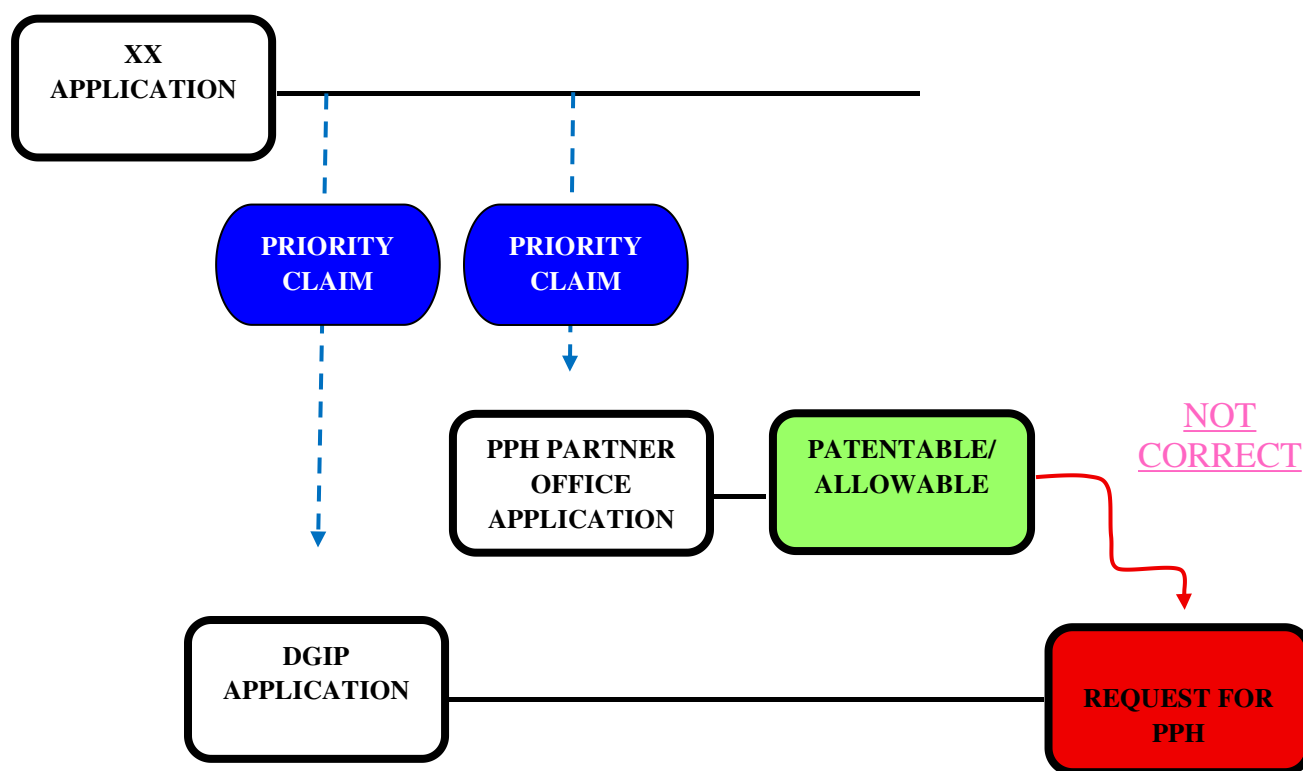
4. A case meeting requirement (a) (II) (Paris Route)



5. A case meeting requirement (a) (II) (PCT Route)

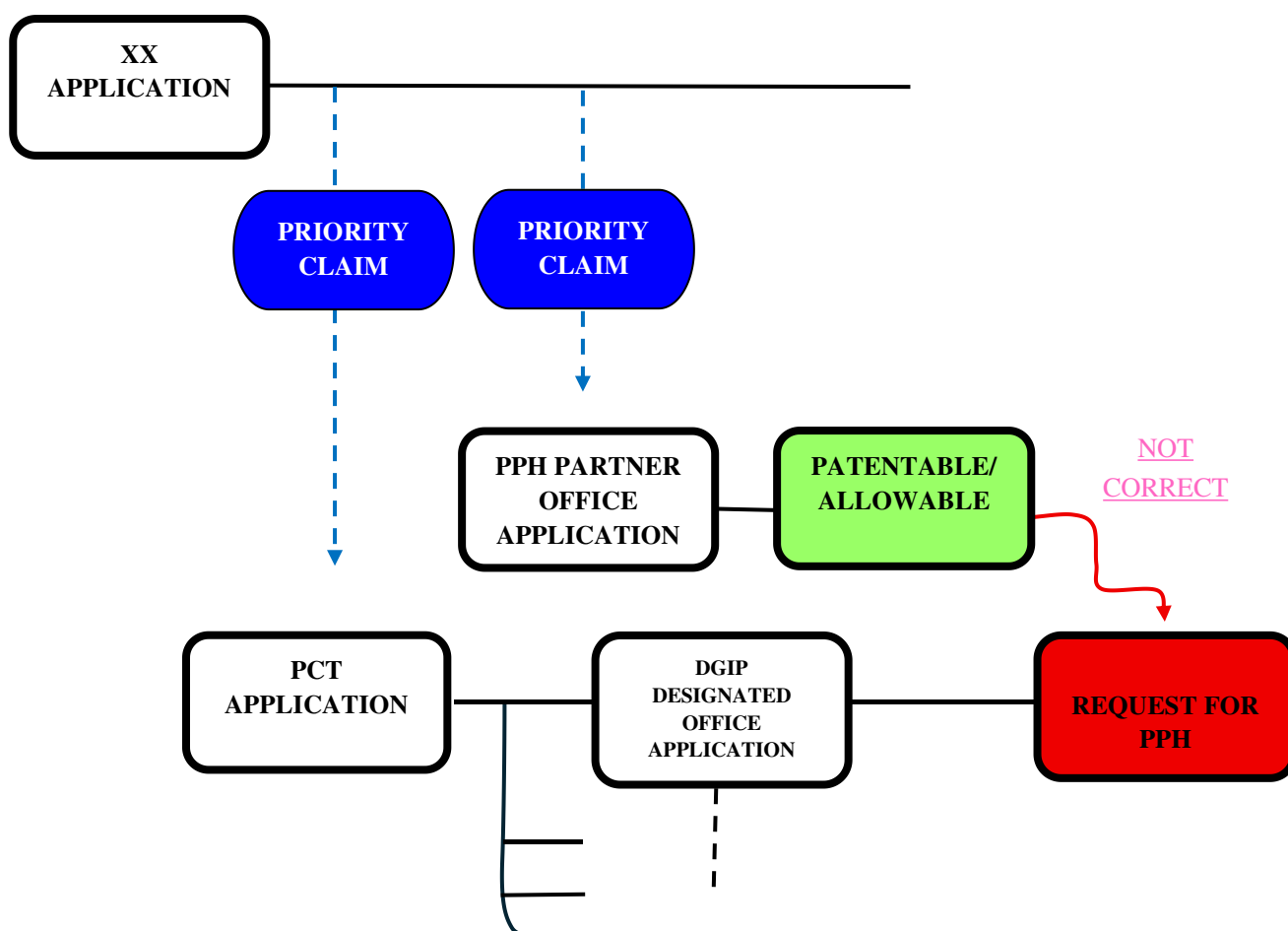


6. A case not meeting requirement (b)
(Paris route, but the first application is from the third country)



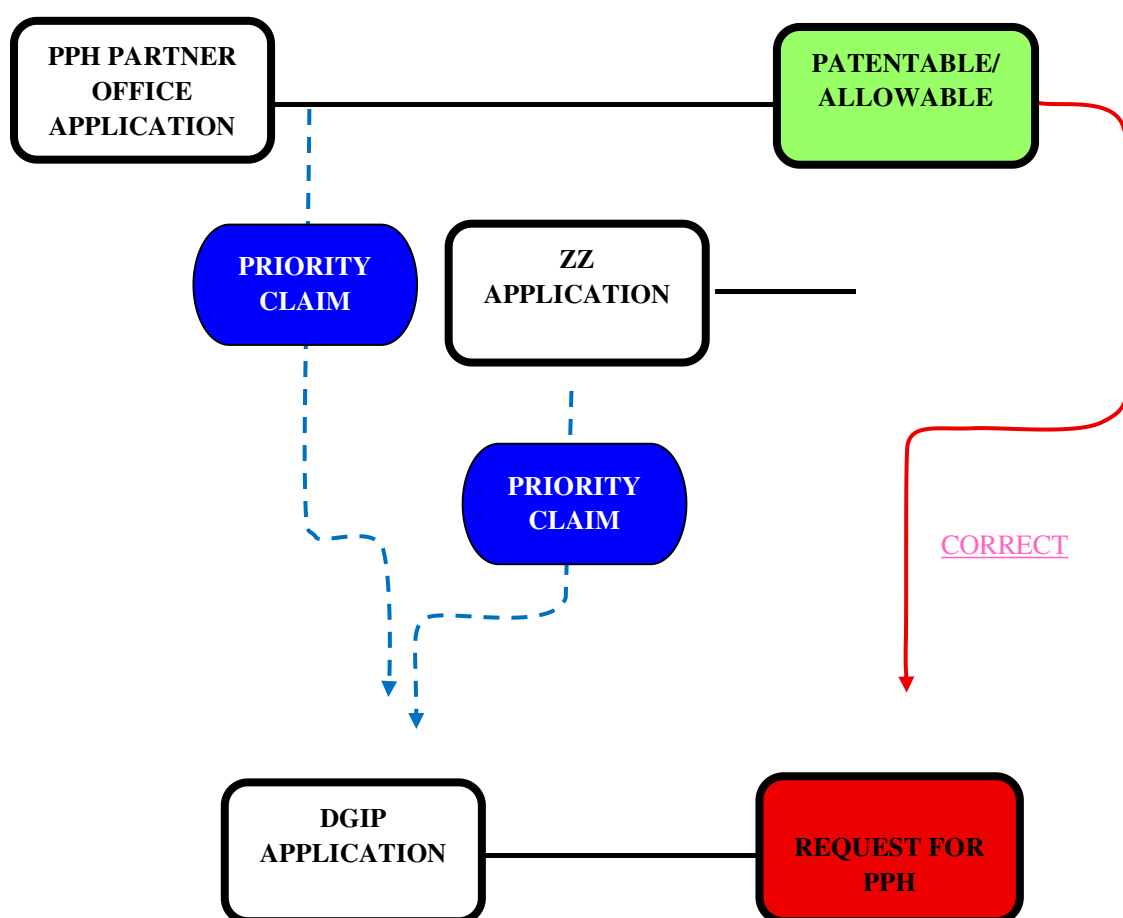
XX: The office other than the PPH partner office or DGIP

7. A case not meeting requirement (b)
(PCT route, but the first application is from the third country)



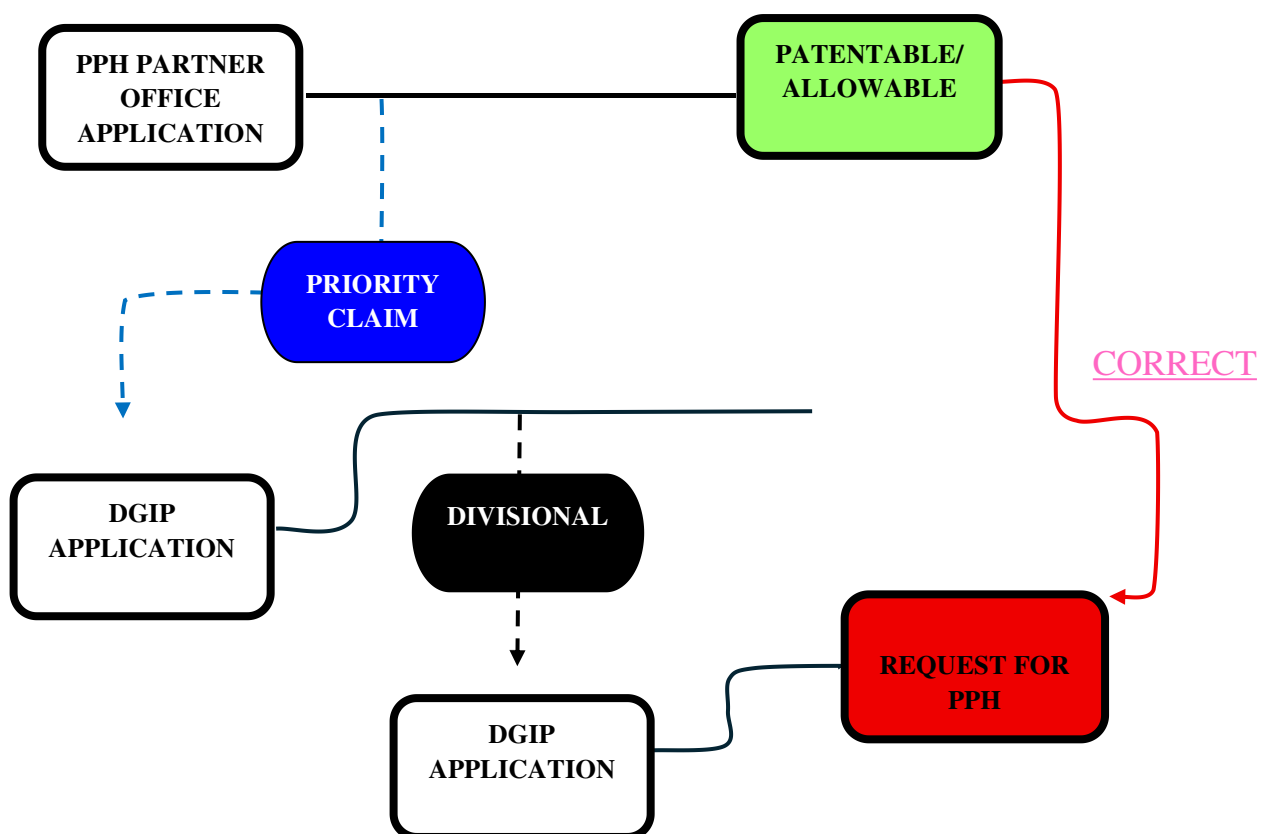
XX: The office other than the PPH partner office or DGIP

**8. A case meeting requirement (a) (I)
(Paris Route & Complex Priority)**

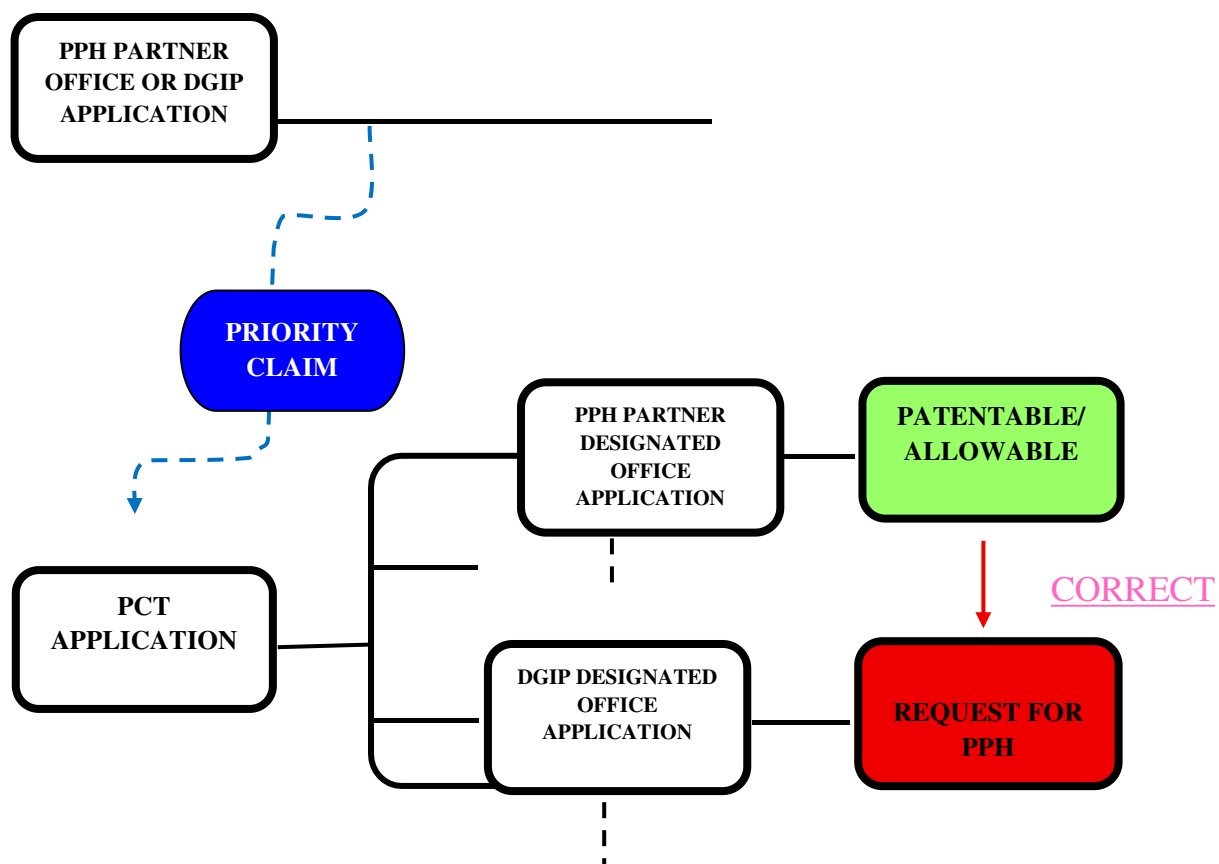


ZZ: Any office

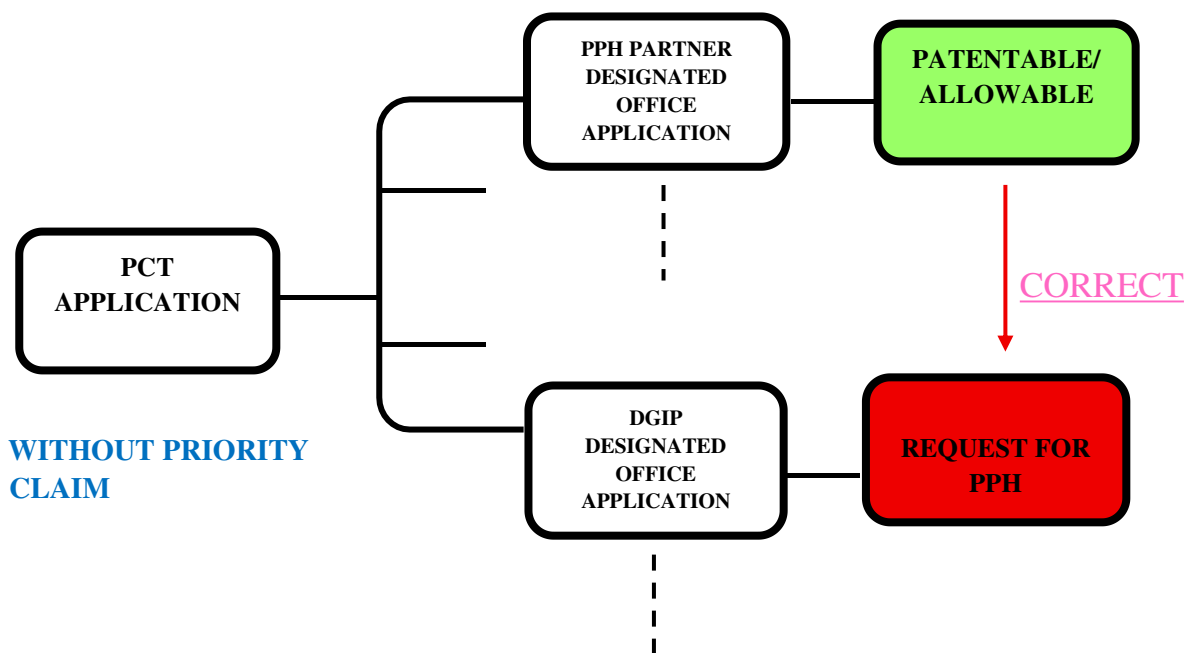
**9. A case meeting requirement (a) (I)
(Paris Route & Divisional Application)**



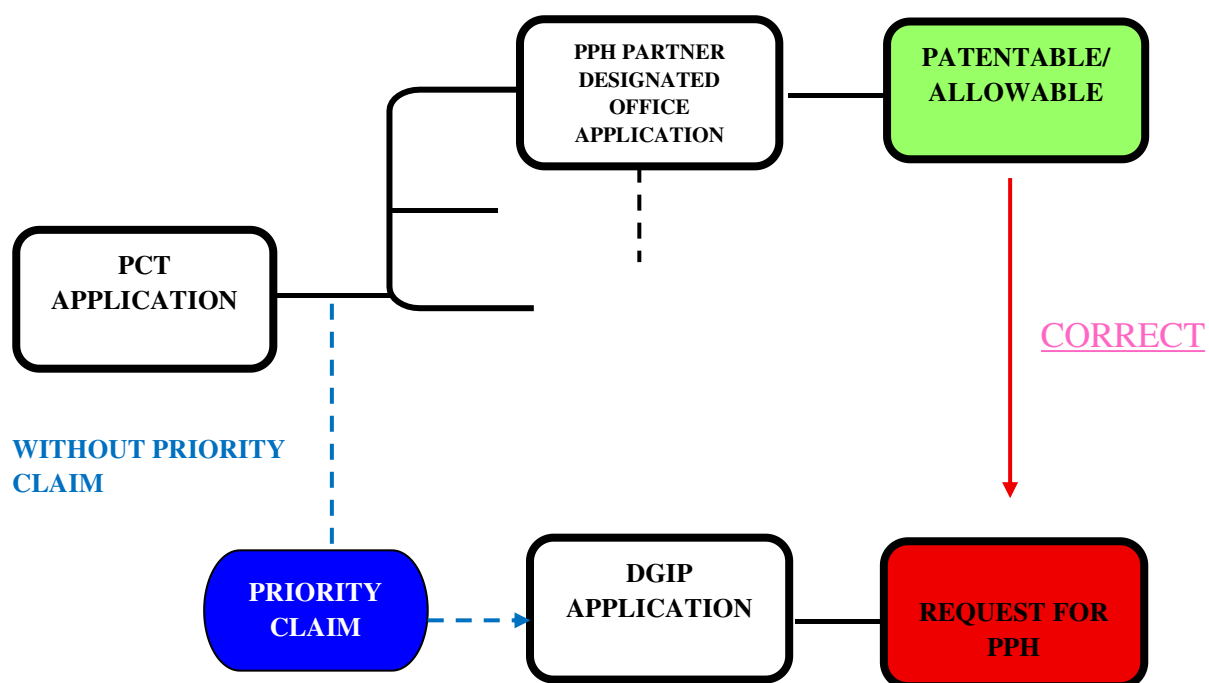
10. A case meeting requirement (a) (I) (PCT Route)



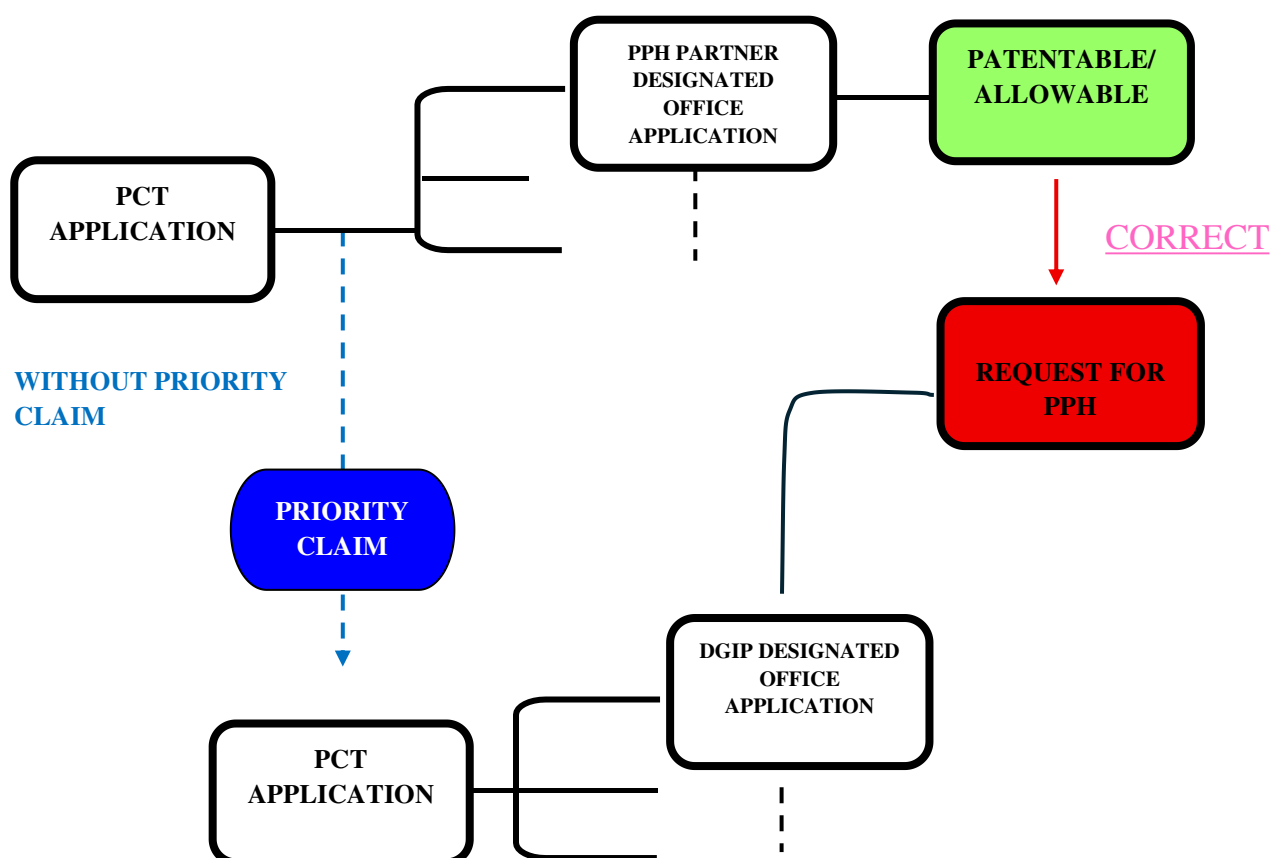
11.A case meeting requirement (a) (III)
(Direct PCT route)



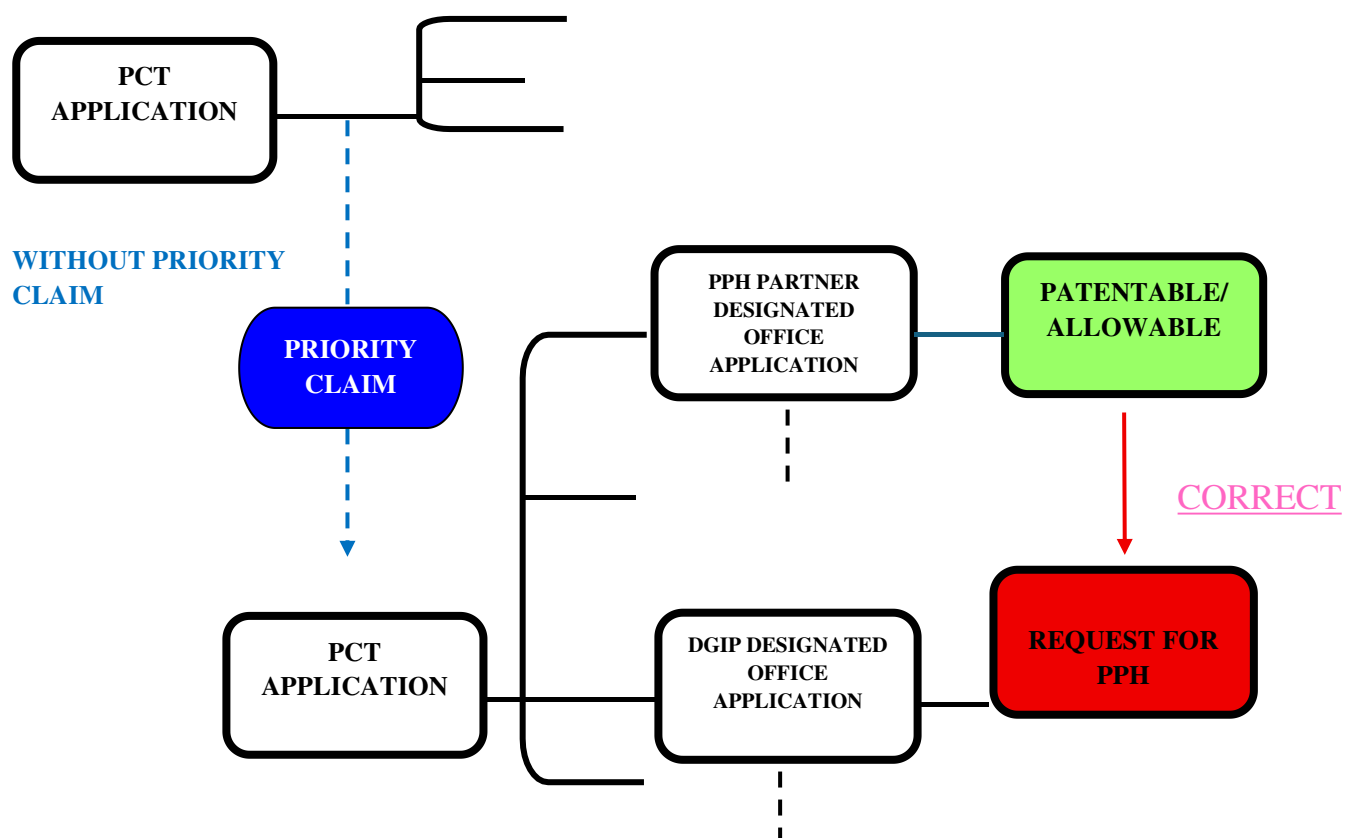
**12.A case meeting requirement (a) (III)
(Direct PCT & Paris route)**



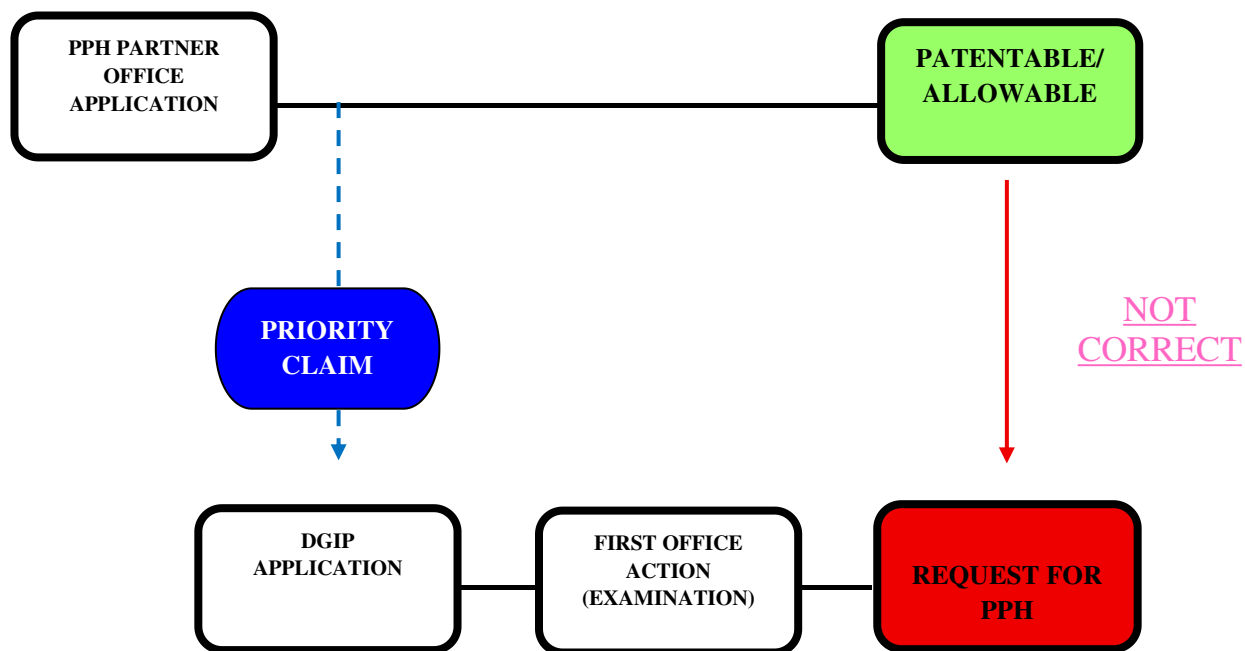
**13.A case meeting requirement (a) (III)
(Direct PCT & PCT Route)**



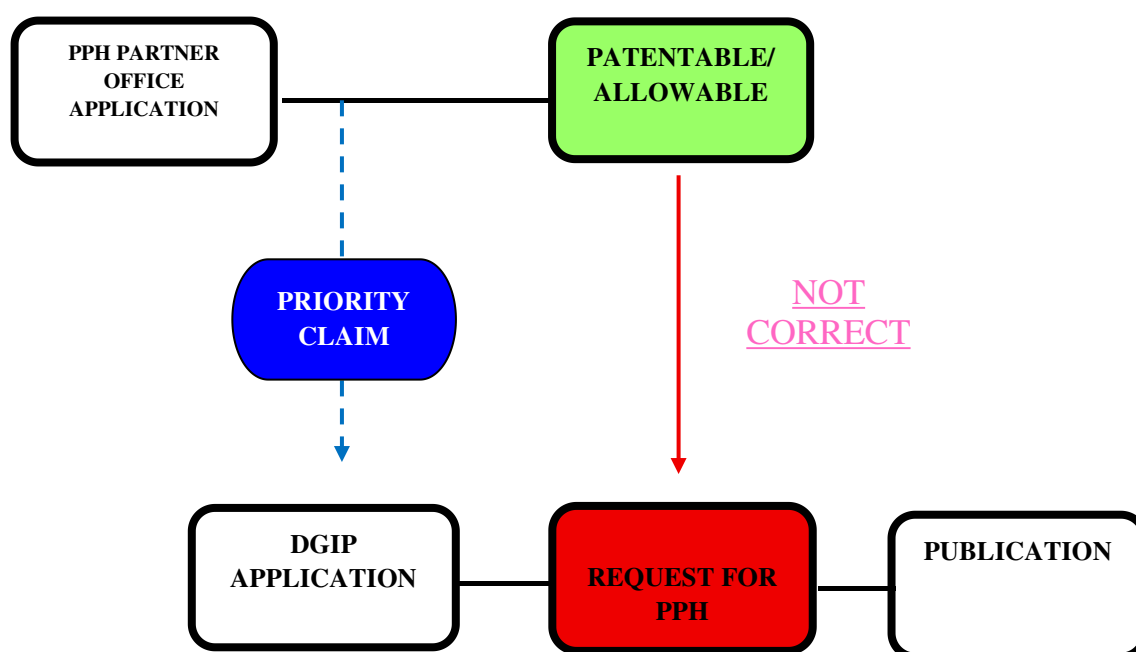
**14.A case meeting requirement (a) (III)
(Direct PCT & PCT Route)**



15.A case not meeting requirement (e)
(Examination has begun before a requests for PPH)

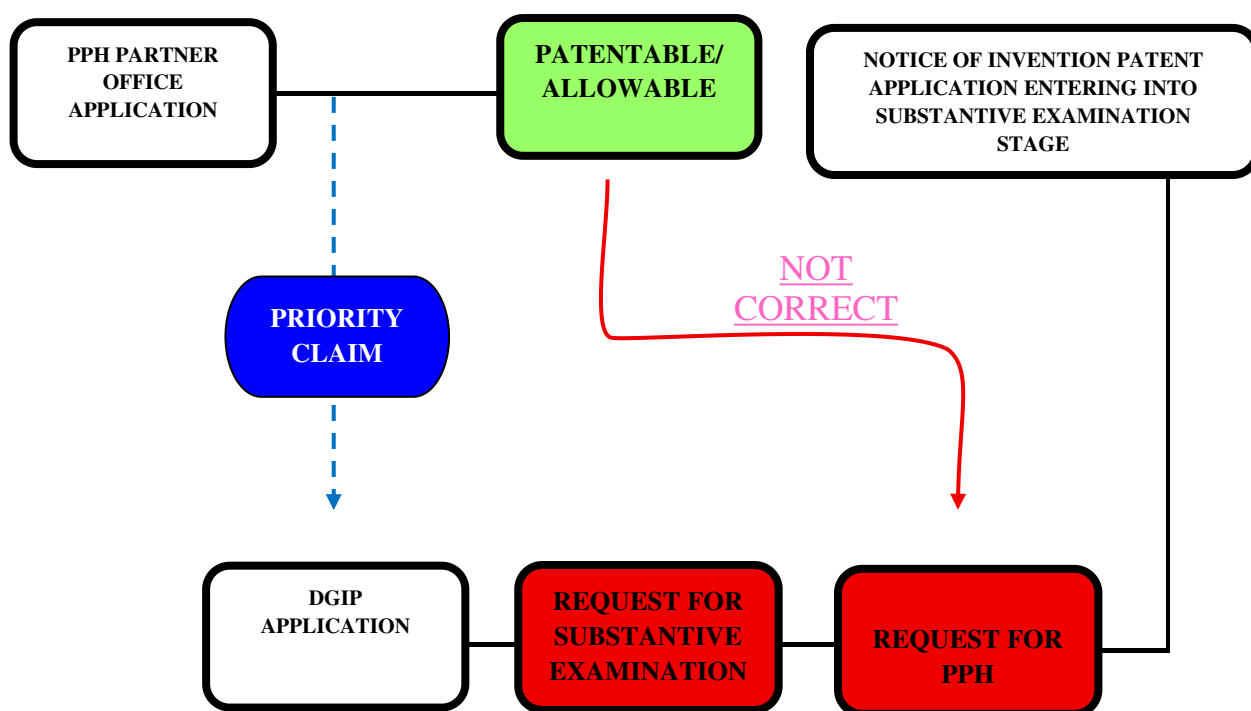


16. A case not meeting requirement (e)
(The application has not been published at the time of request for PPH)



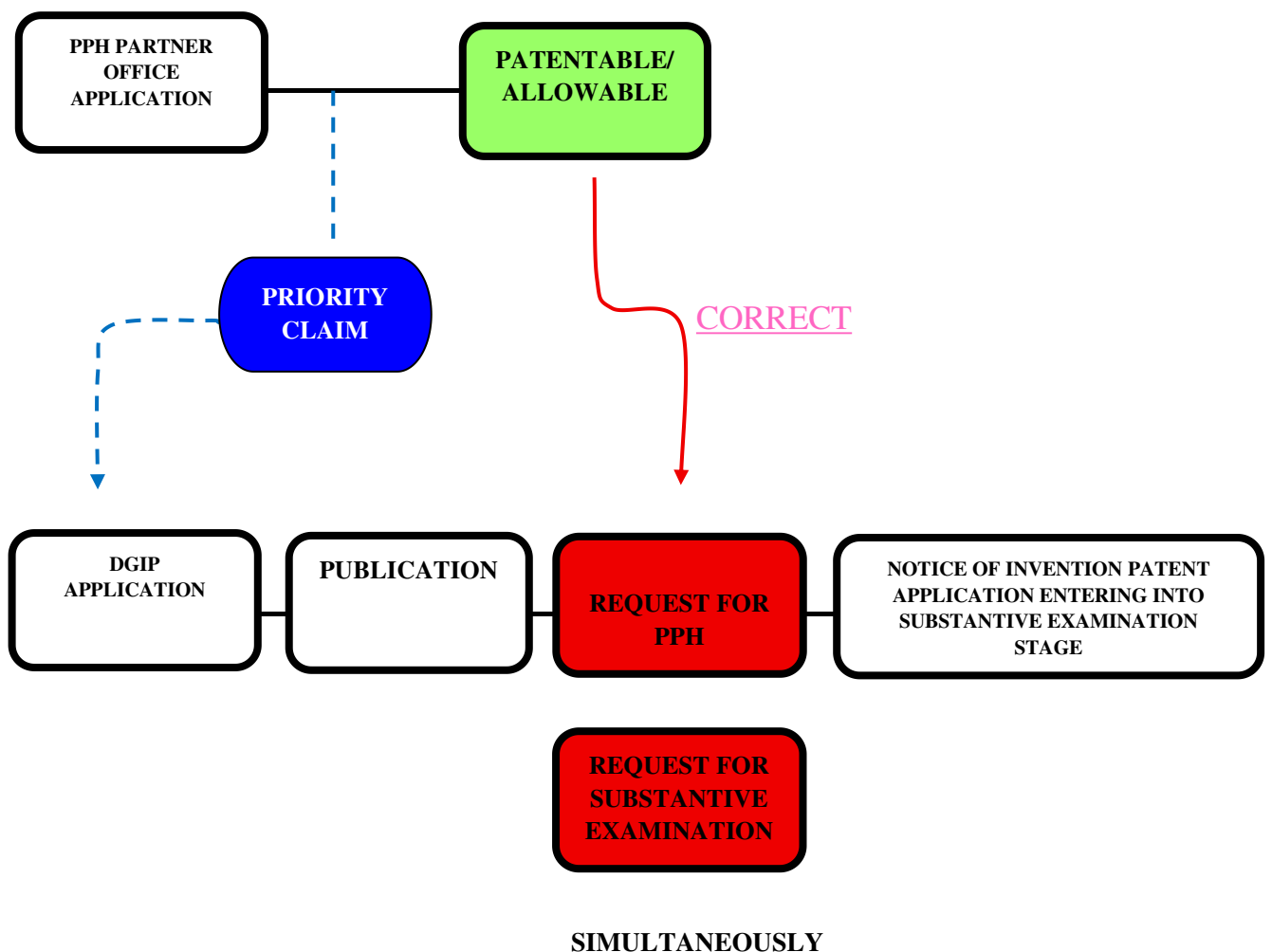
17.A case not meeting requirement (f)

(The application has not entered into substantive examination stage at the time of request for PPH)

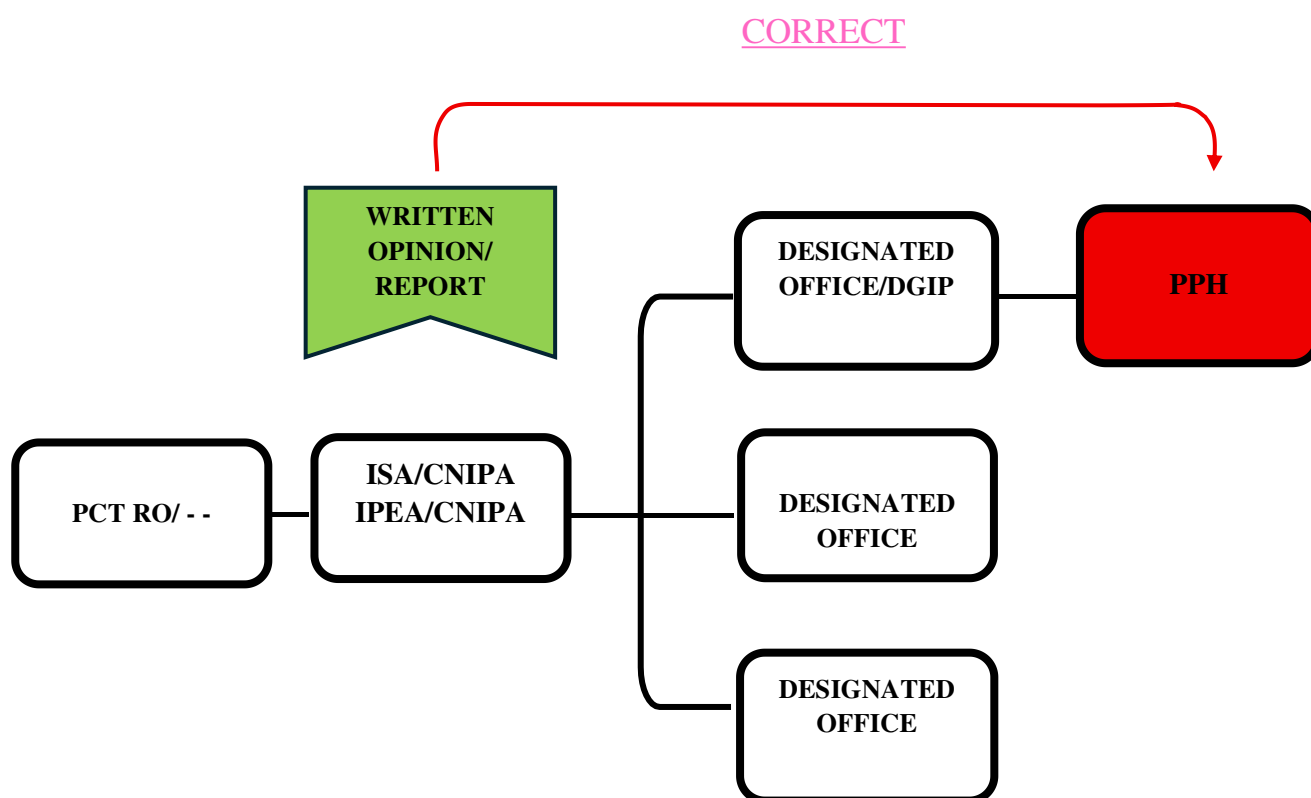


18.A case meeting requirement (f) (exception)

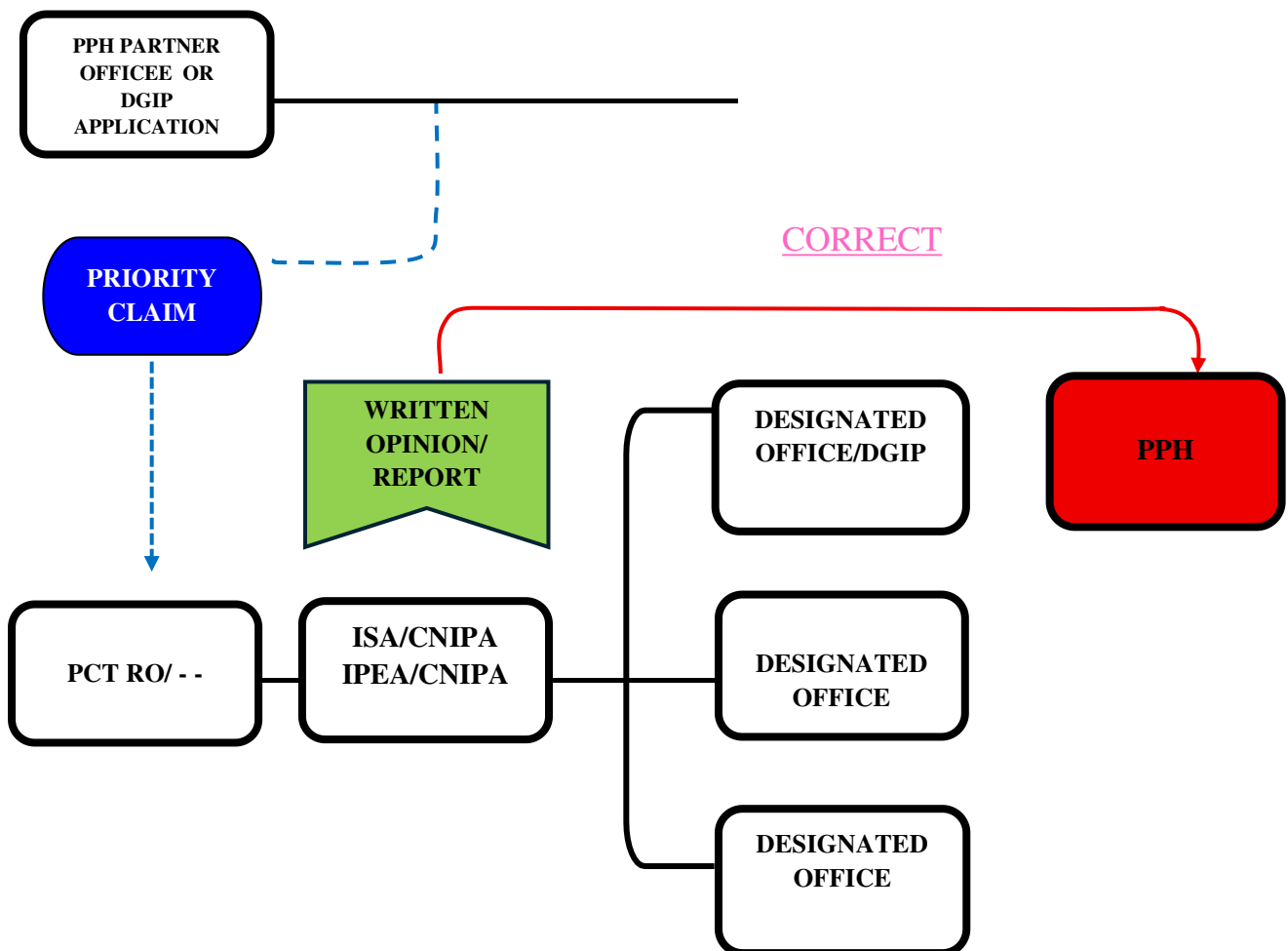
(PPH request simultaneously with the Request for Substantive Examination)



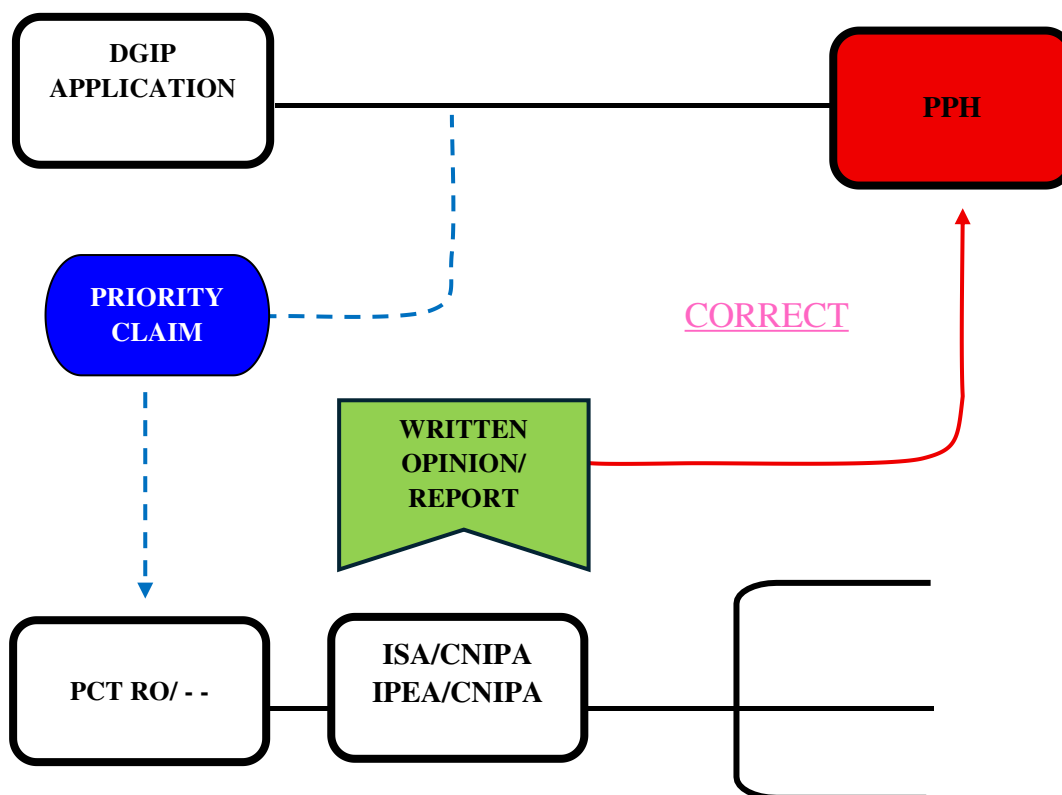
19. The Application is a national phase application of the corresponding international application



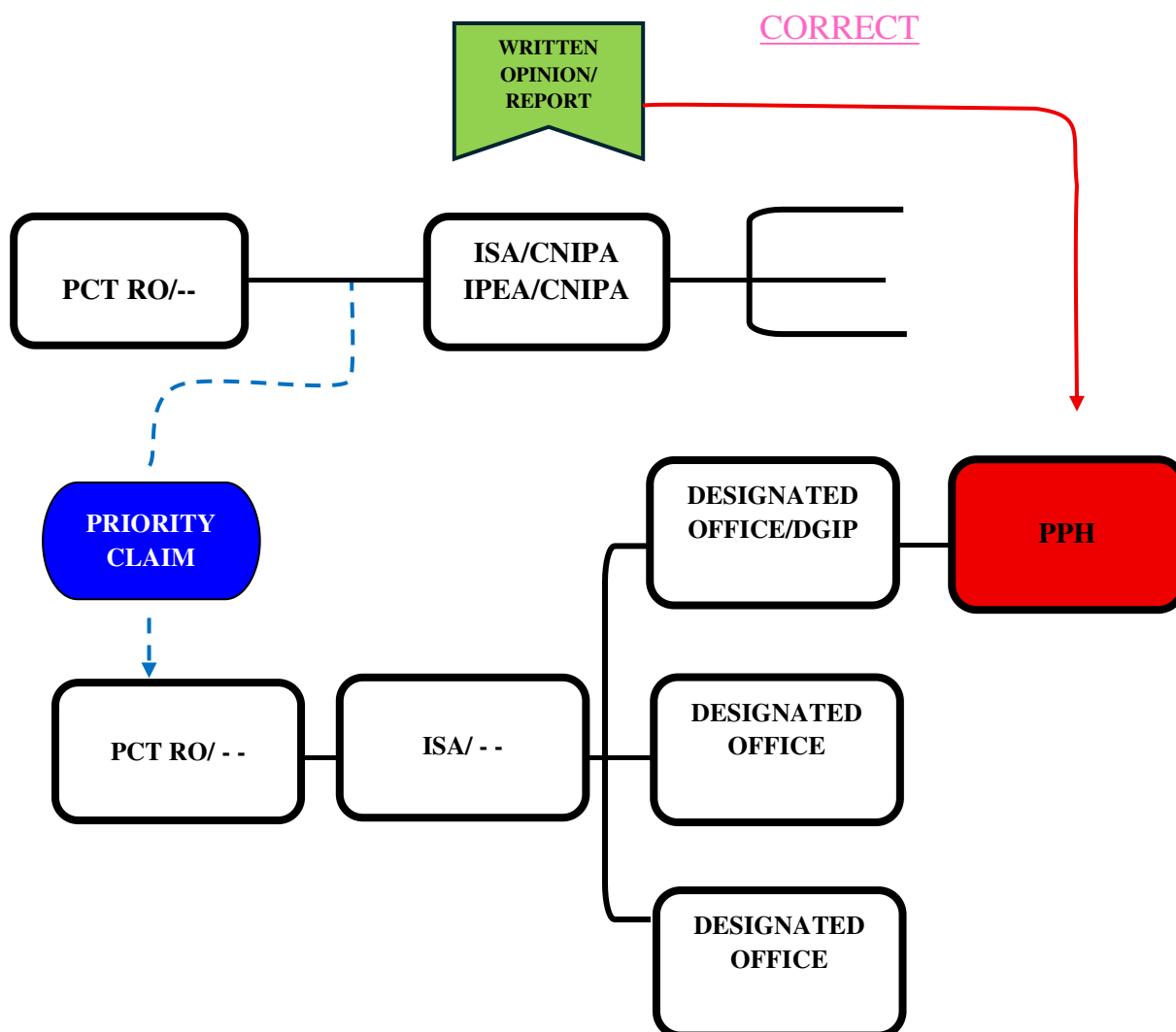
20. The application is a national phase application of the corresponding international application. (The corresponding international application claims priority from PPH Partner Office or DGIP application.)



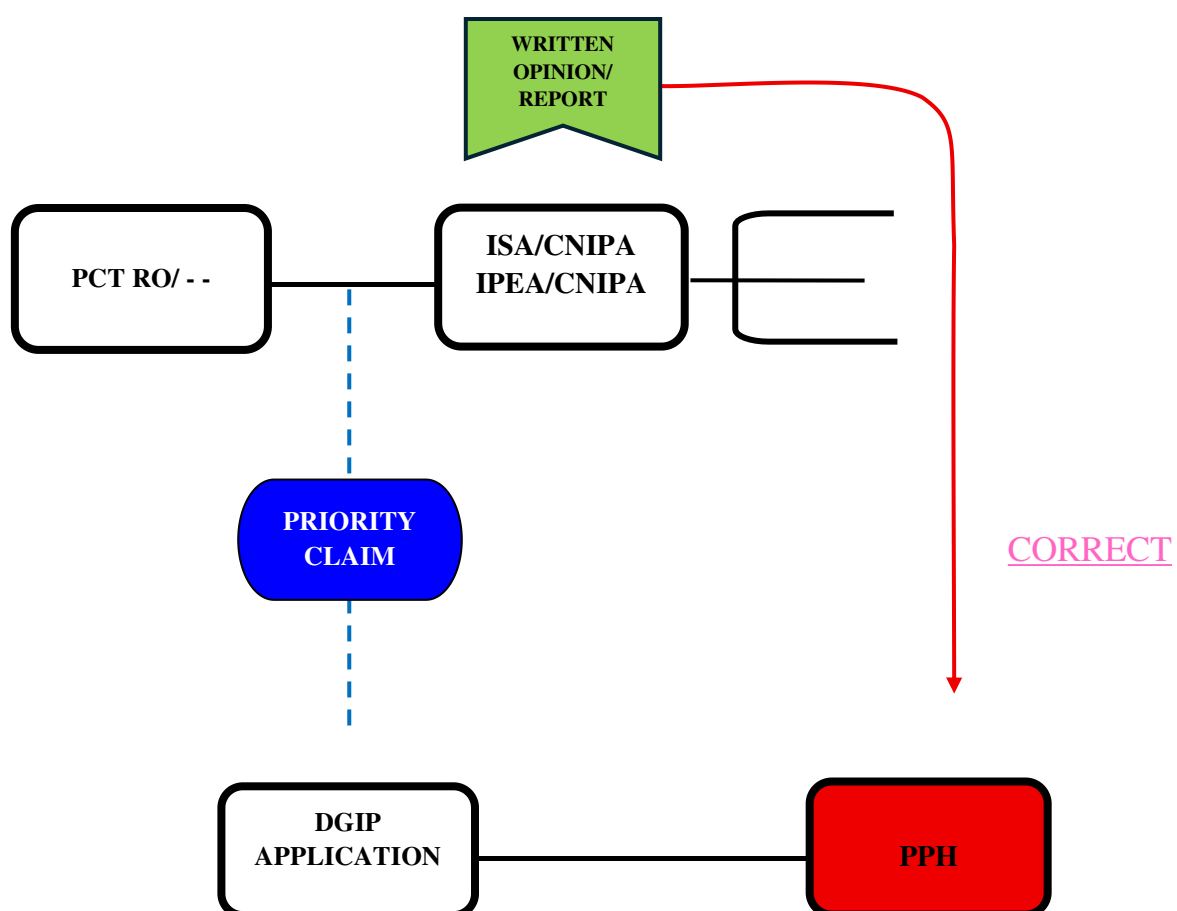
21. The application is a national application as a basis of the priority claim of the corresponding international application



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

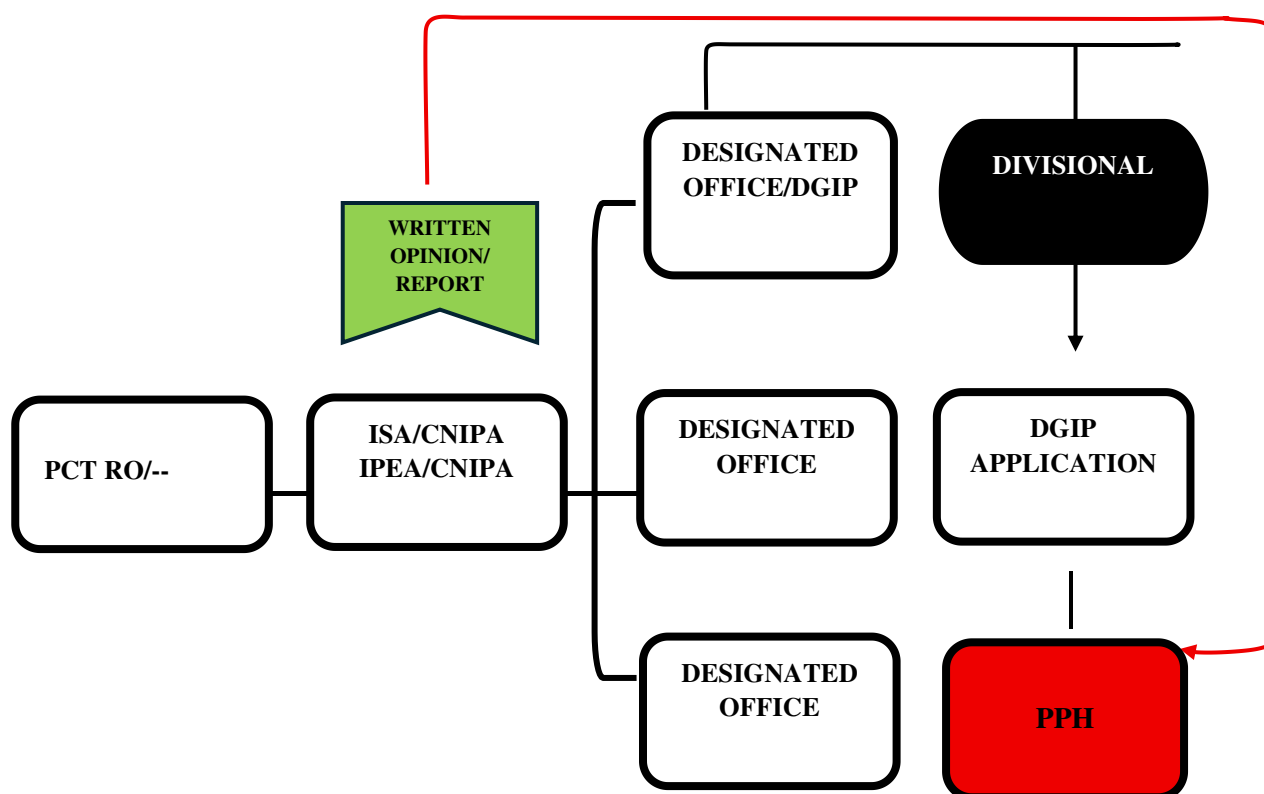


23. The application is a national application claiming foreign/domestic priority from the corresponding international application.



24. The application is a divisional application of an application which satisfies the requirement (A)

CORRECT



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

