

GUIDELINE

Procedures to file a request to the SAIP (Saudi Authority for Intellectual Property) for Patent Prosecution Highway Pilot Program

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the SAIP and satisfies the following requirements under the CNIPA (China National Intellectual Property Administration) SAIP 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 PPH request form presented in “SAIP PPH request form” of this guideline.

The PPH pilot program between SAIP and CNIPA will commence on 01/11/2020, for a duration of three years and will end on 31/10/2023. 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 CNIPA

1. Requirements

- (a) ***Both the SAIP 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 SAIP application (including PCT national phase application) may be either:

(Case 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 I, 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 CNIPA application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures D and E), or

(III) a PCT national phase application without priority claim (an example is provided in ANNEX I, Figure K), or

(Case IV) an application which validly claims priority under the Paris Convention from the PCT application without priority claim (examples are provided in ANNEX I, Figures L, M and N).

- (b) ***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 C in ANNEX I)), or an CNIPA national phase application of a PCT application.

Claims are “determined to be allowable/patentable” when the CNIPA 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 CNIPA has the meaning of allowable/patentable for the purposes of this pilot program.

The office action includes:

- (1) Decision to Grant a Patent

- (2) First/Second/Third/...Office action
- (3) Decision of Refusal
- (4) Reexamination Decision
- (5) Invalidation Decision

Claims are also “determined to be patentable” in the following circumstance: If the CNIPA 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 CNIPA office action regarding that claim, and therefore, the claim is deemed to be patentable by the CNIPA.

- (c) ***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 CNIPA.***

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the SAIP are of the same or similar scope as the claims in the CNIPA, or the claims in the SAIP 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 SAIP 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 SAIP are not considered to sufficiently correspond if the SAIP 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 sufficiently correspond to the claims indicated as allowable in the CNIPA application.

- (d) ***The SAIP has not begun substantive examination of the application at the time of request for the PPH.***

- (e) ***Patent applications initiated in the Office of the CNIPA or the SAIP.***

Patent applications belong to a patent family of which at least the earliest application was filed with the SAIP or the CNIPA acting as a national office (see Figures F and G

in ANNEX I).

2. Documents to be submitted

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

- (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 Arabic or English is acceptable as translation language¹. 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 systems because the office actions and their machine translations are available for the SAIP examiner via the CNIPA's dossier access systems. If they cannot be obtained by the SAIP examiner via the CNIPA's dossier access systems, 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 Arabic 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 systems because the claims and their machine translations are available for the SAIP examiner via the CNIPA's dossier access systems. If they cannot be obtained by the SAIP examiner via the CNIPA's dossier access systems, 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 SAIP usually possesses them. When the SAIP 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.

¹ 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 applicant may be requested to resubmit translations.

(d) *Claim correspondence table*

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the SAIP 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 SAIP through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

Part II
PPH using the PCT international work products from the CNIPA
(PCT-PPH)

1. Requirements

The application which is filed with the SAIP 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 CNIPA, and, if priority is claimed, the priority claim must be to CNIPA or SAIP application, see example (A') in ANNEX II.

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) 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/domestic 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)–(E3) 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 SAIP are of the same or similar scope as the claims indicated as allowable in the latest international work product, or the claims in the SAIP 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 SAIP 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 SAIP are not considered to sufficiently correspond if the SAIP 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 pilot program need not to sufficiently correspond to the claims indicated as allowable in the latest international work product.

- (4) The SAIP has not begun substantive examination of the application at the time of request for the PPH.**
- (5) Patent applications initiated in the Office of the CNIPA or the SAIP**

Patent applications belong to a patent family of which at least the earliest application was filed with the CNIPA or the SAIP acting as a national office (see Figures (A'), (B), (E1)–(E3) in ANNEX II) or filed with the CNIPA acting as a receiving office (see Figures (A), (A''), (C) and (D) in ANNEX II).

2. Documents to be submitted

The applicant must submit the following documents attached to the PPH 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 them².

Either Arabic or English is acceptable as translation language. If the copy of the latest international work product is available in English via “PATENTSCOPE (registered trademark)”³, an applicant need not submit these documents unless otherwise requested by the SAIP (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 Arabic 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 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 SAIP.

(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 SAIP has difficulty in obtaining the document, the applicant has to submit it at the examiner’s request. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

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.

³ <http://www.wipo.int/pctdb/en/index.jsp>

(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.

When an applicant has already submitted the above mentioned documents (1) - (4) to SAIP 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 SAIP 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 SAIP 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 once again in a renewed request for participation.

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

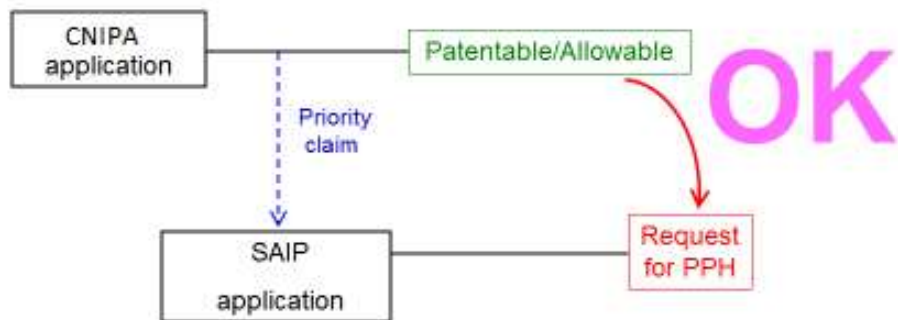
4. SAIP PPH request form

REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM طلب الاشتراك في البرنامج التجريبي للمسار السريع لفحص طلبات براءات الاختراع		
A. Bibliographic Data		أ. المعلومات البيبليوغرافية
Application Number		رقم الطلب
Applicant's name		اسم مقدم الطلب
Inventor name		اسم المخترع
Title of invention		عنوان الاختراع
B. Request		ب. المطلوب
Applicant requests participation in the Patent Prosecution Highway (PPH) pilot program based on: يطلب مقدم الطلب الاشتراك في البرنامج التجريبي للمسار السريع لفحص طلبات براءات الاختراع (PPH) على أساس:		
Office of Earlier Examination (OEE)		مكتب الفحص السابق
OEE Work Products Type	<input type="checkbox"/> PPH (National Office Actions) <input type="checkbox"/> PCT-PPH (International Work Products) <input type="checkbox"/> المسار السريع لفحص طلبات براءات الاختراع (نتائج الفحص للمكتب الوطني) <input type="checkbox"/> المسار السريع لفحص طلبات براءات الاختراع (نتائج الفحص في المرحلة الدولية)	نوع نتائج مكتب الفحص السابق
OEE Application Number		رقم طلب مكتب الفحص السابق
Priority Application Number or PCT Application Number		رقم طلب الأسبقية أو رقم طلب معاهدة التعاون بشأن البراءات
Both the OEE application and the above identified application have the following earliest date (filing or priority date):		طلب مكتب الفحص السابق والطلب المودع المحدد أعلاه كلاهما لهما التاريخ الأقدم التالي (تاريخ الإيداع أو الأسبقية)

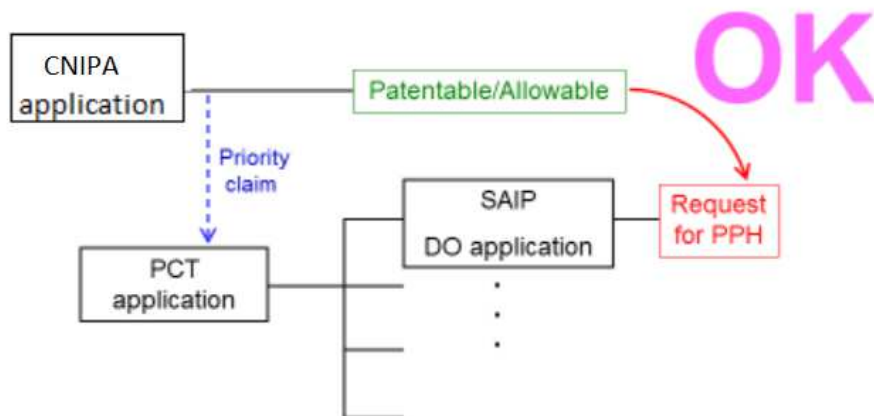
C. List of Required Documents	ج. قائمة الوثائق المطلوبة	
(a) A copy of OEE work product(s)	<input type="checkbox"/> attached <input type="checkbox"/> Previously submitted <input type="checkbox"/> Provided via CNIPA's dossier /PATENTSCOPE <input type="checkbox"/> Not required because the decision to grant a patent was the first office action. <input type="checkbox"/> مرفقة <input type="checkbox"/> متوفرة عبر نظام CNIPA's /dossier PATENTSCOPE <input type="checkbox"/> قدمت مسبقا <input type="checkbox"/> غير مطلوب لأن قرار منح براءة الاختراع كان أول إجراء للمكتب	(أ) نسخة من نتائج مكتب الفحص السابق
(b) Patentable/Allowable Claims Determined by OEE	<input type="checkbox"/> is attached <input type="checkbox"/> Provided via CNIPA's dossier /PATENTSCOPE <input type="checkbox"/> is <u>not</u> attached because the document is already in the SAIP application. <input type="checkbox"/> مرفقة <input type="checkbox"/> متوفرة عبر نظام CNIPA's /dossier PATENTSCOPE <input type="checkbox"/> غير مرفقة نظرًا لأن المستند موجود مسبقًا في الطلب بـ SAIP	(ب) عناصر الحماية الممنوحة / القابلة للمنفح التي حددها مكتب الفحص السابق
(c) Translations of the documents in (a) and (b) above are attached (if the documents or translations thereof are not in the English via CNIPA's dossier/PATENTSCOPE). A statement that the English translation is accurate is attached for the document in (b) above.	(ج) الترجمات للوثائق الواردة في (أ) و (ب) أعلاه مرفقة (إذا لم تكن الوثائق مصاغة أو مترجمة باللغة الإنجليزية عبر نظام CNIPA's dossier / PATENTSCOPE). يتم إرفاق بيان بأن الترجمة الإنجليزية دقيقة للمستند في (ب) أعلاه.	

<p>(d) Documents Cited in OEE Work Products (if required).</p>	<p><input type="checkbox"/> attached</p> <p><input type="checkbox"/> Provided via CNIPA's dossier /PATENTSCOPE</p> <p><input type="checkbox"/> Previously submitted</p> <p><input type="checkbox"/> No references were cited in the OEE work product.</p> <p><input type="checkbox"/> مرفقة /CNIPA's dossier</p> <p><input type="checkbox"/> متوفرة عبر نظام PATENTSCOPE</p> <p><input type="checkbox"/> قدمت مسبقا</p> <p><input type="checkbox"/> غير مرفقة لأنه لم يتم ذكر أي مراجع في نتائج مكتب الفحص السابق.</p>	<p>(د) الوثائق المذكورة في نتائج مكتب الفحص السابق (إذا لزم الأمر)</p>
<p>D. Claims Correspondence</p>		<p>د. تطابق عنصر الحماية</p>
<p><input type="checkbox"/> All the claims in the application sufficiently correspond to the patentable/allowable claims in the OEE application; or</p> <p><input type="checkbox"/> Claims correspondence is explained in the following table:</p> <p><input type="checkbox"/> جميع عناصر الحماية في الطلب تتطابق مع عناصر الحماية القابلة للبراءة / الممنوحة في طلب مكتب الفحص السابق؛ أو</p> <p><input type="checkbox"/> شرح تطابق عناصر الحماية في الجدول التالي:</p>		
<p>Application Claims عناصر الحماية للطلب</p>	<p>Corresponding OEE claims عناصر الحماية للطلب السابق المطابق</p>	<p>Explanation regarding the correspondence شرح بشأن التطابق</p>
<p>Name(s) of applicant(s) or representative(s)</p>		<p>اسم مقدم الطلب أو الوكيل</p>
<p>Date</p>		<p>التاريخ</p>

A A case meeting requirement (a) (I)
- Paris route -



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

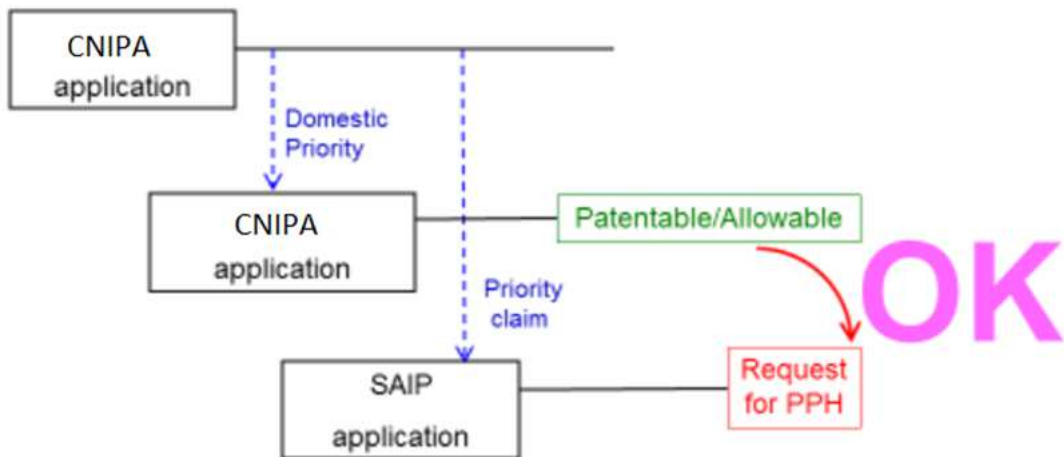


DO: Designated Office

C

A case meeting requirement (a) (I)

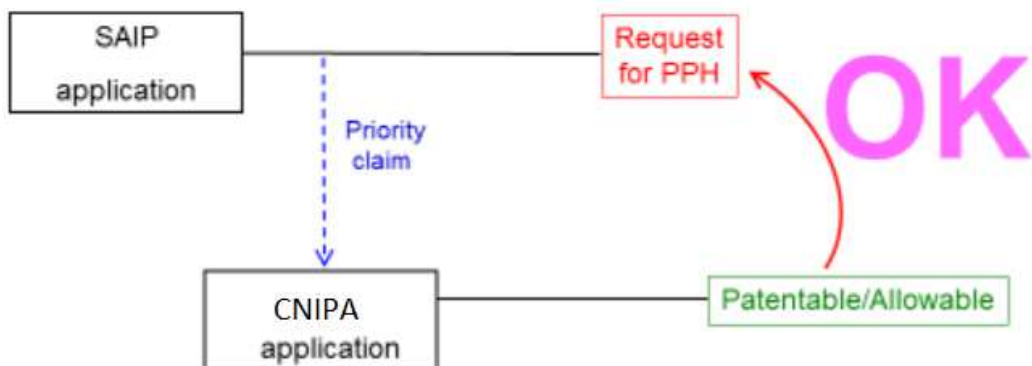
- Paris route, Domestic priority -



D

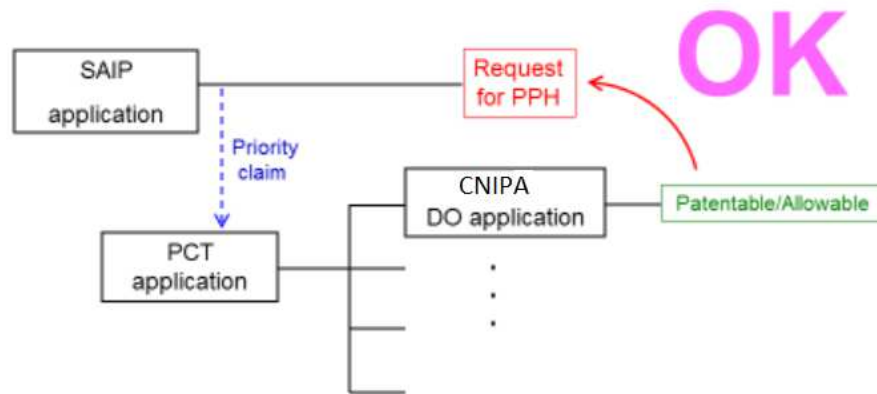
A case meeting requirement (a) (II)

- Paris route -



E

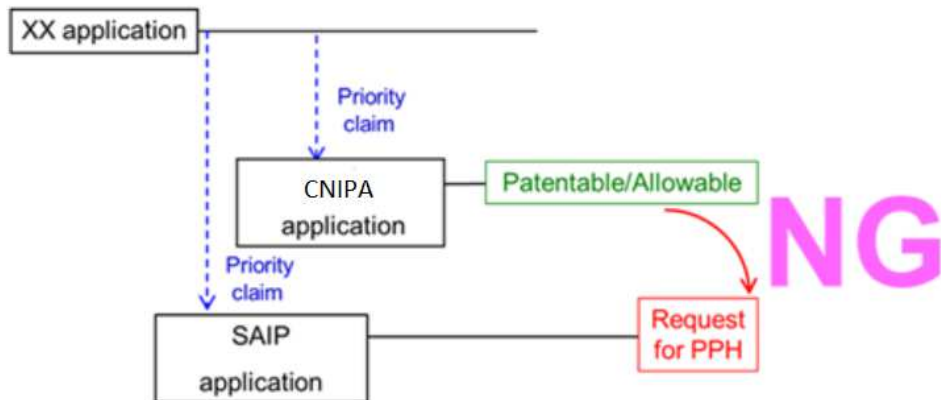
A case meeting requirement (a) (II)
- PCT route -



DO: Designated Office

F

A case not meeting requirement (e)
- Paris route, but the first application is from the third country -

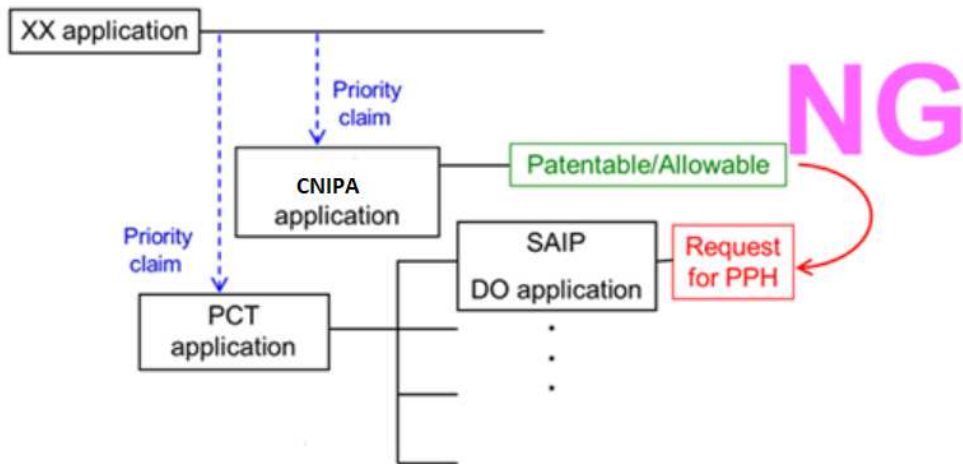


XX : the office other than the CNIPA or SAIP

G

A case not meeting requirement (e)

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

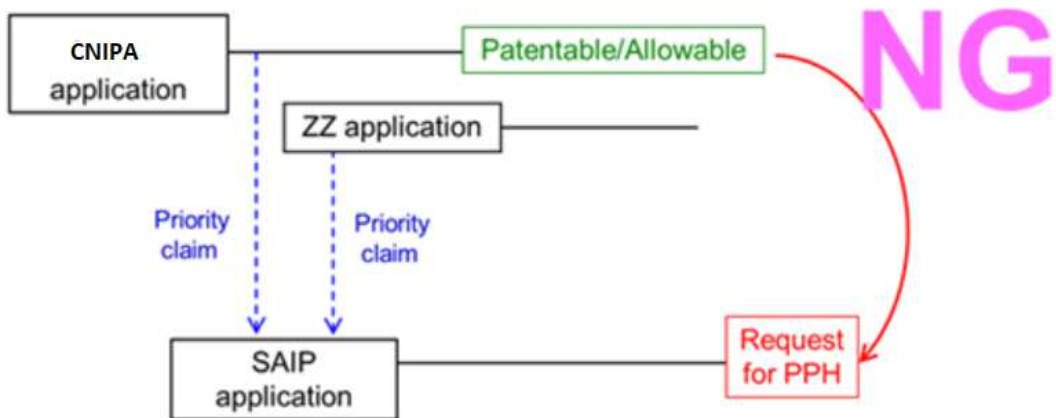


XX: the office other than CNIPA or SAIP

H

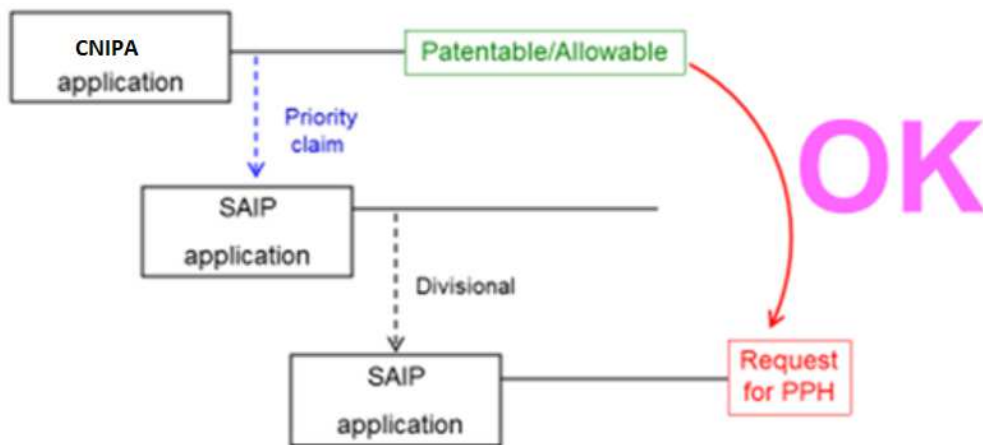
A case not meeting requirement (a) (I)

- Paris route & Complex priority -

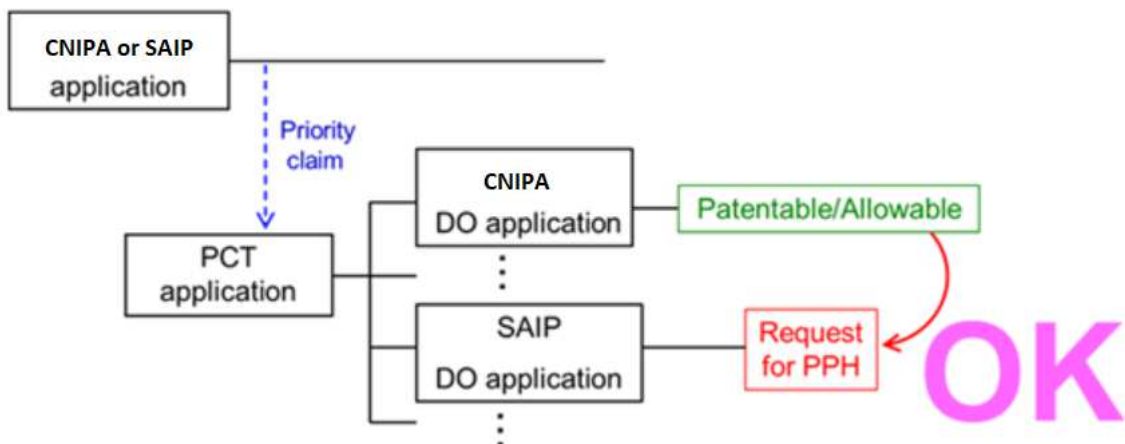


ZZ : any office

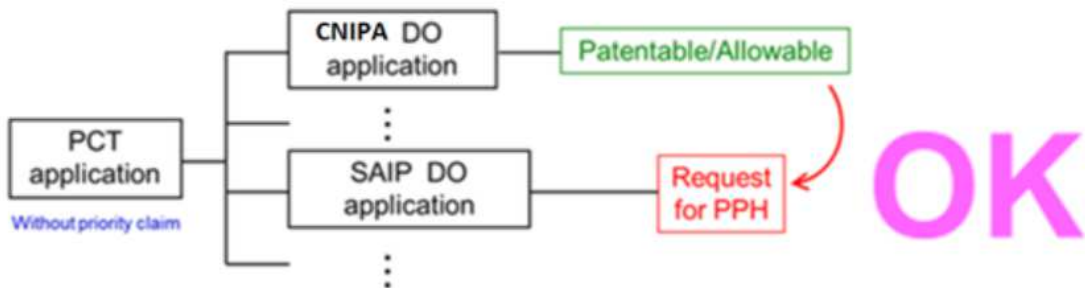
I A case meeting requirement (a) (I)
- Paris route & divisional application -



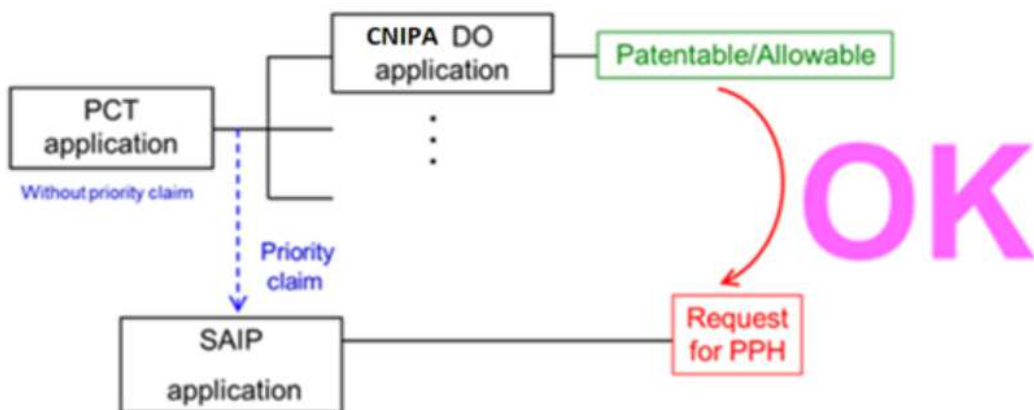
J A case meeting requirement (a) (I)
- PCT route -



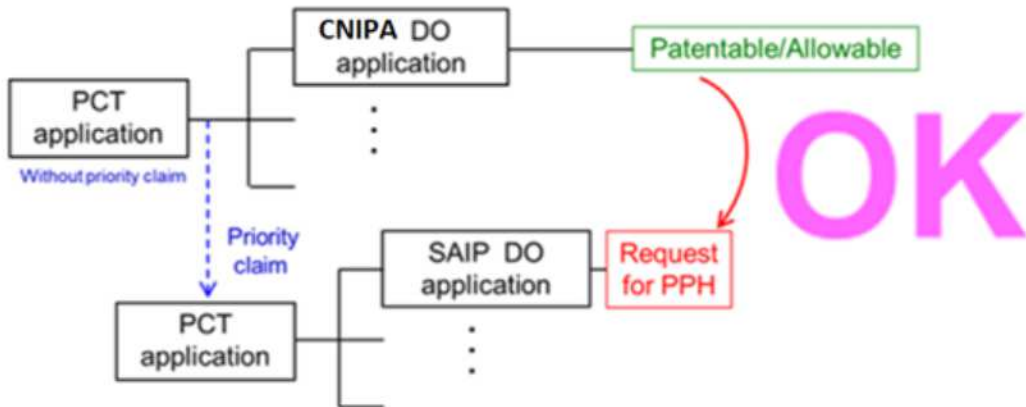
K A case meeting requirement (e)
- Direct PCT route -



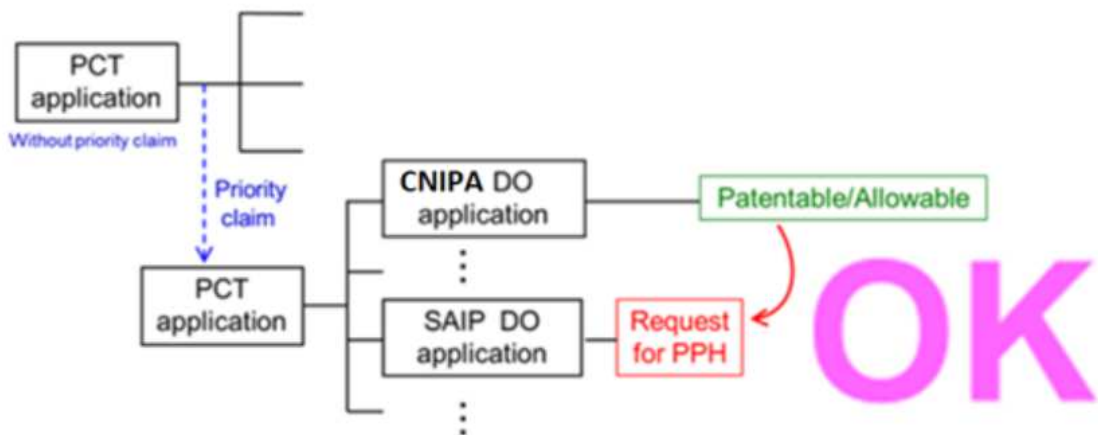
L A case meeting requirement (e)
- Direct PCT & Paris route -



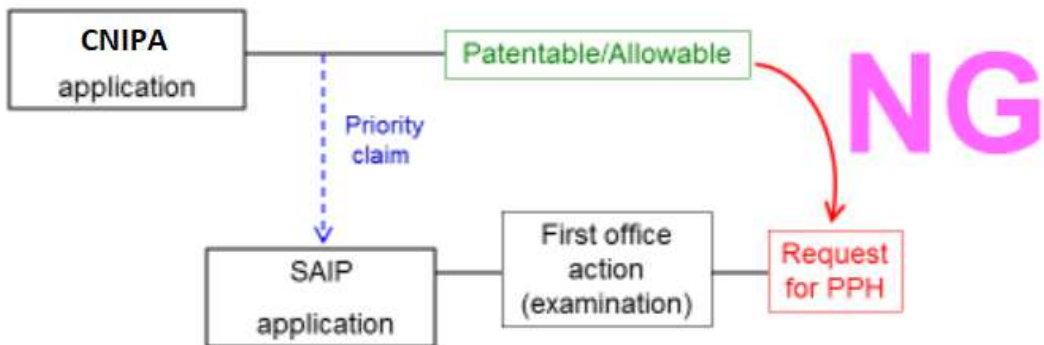
M A case meeting requirement (e)
- Direct PCT & PCT route -



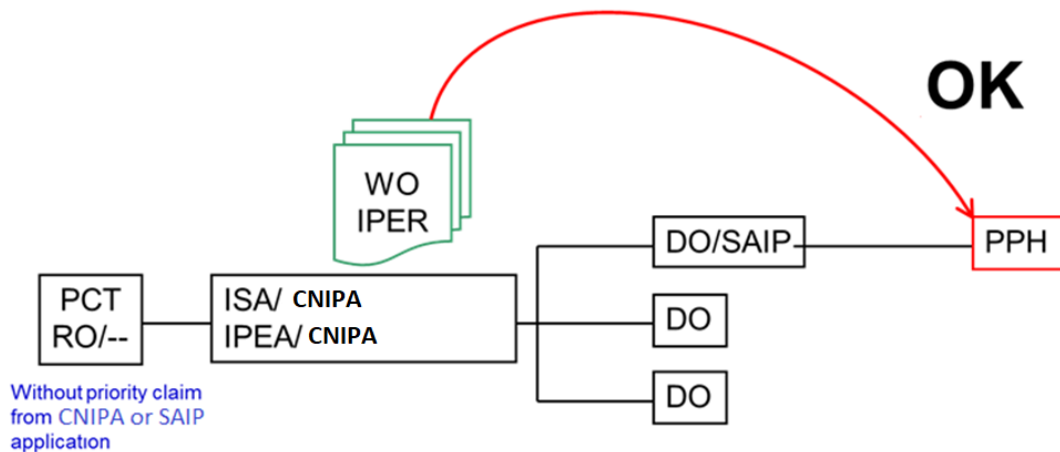
N A case meeting requirement (e)
- Direct PCT & PCT route -



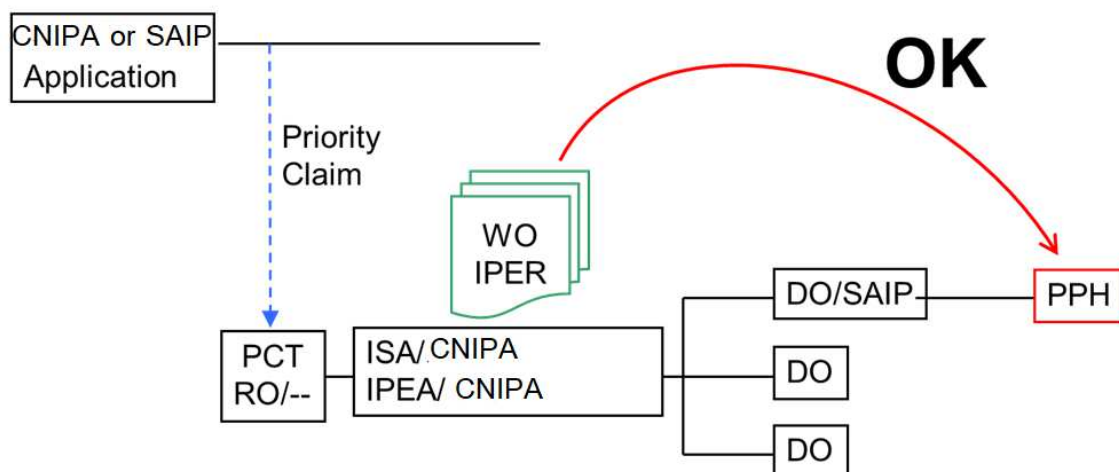
O A case not meeting requirement (d)
- Examination has begun before a request for PPH -



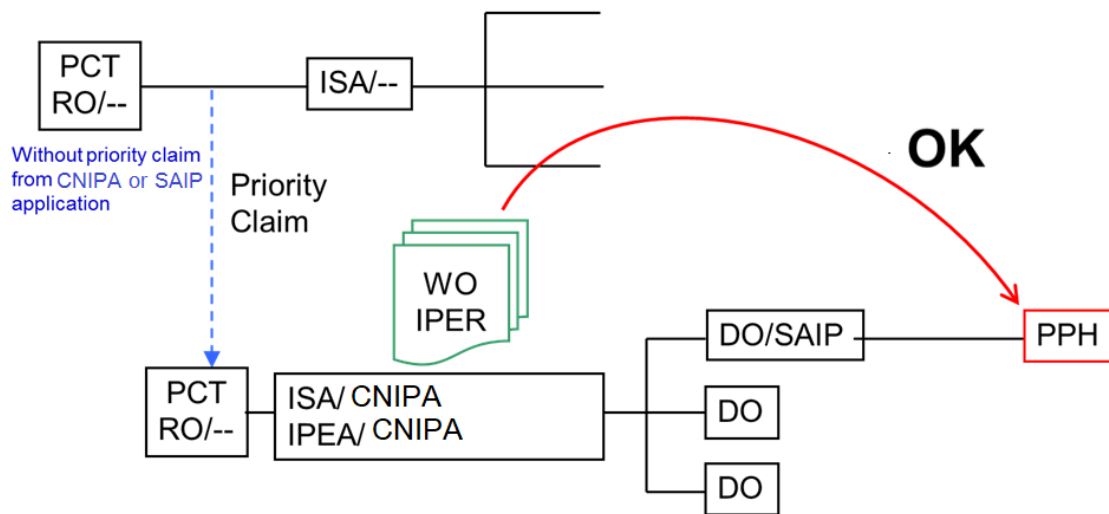
(A) The application is a national phase application of the corresponding international application.



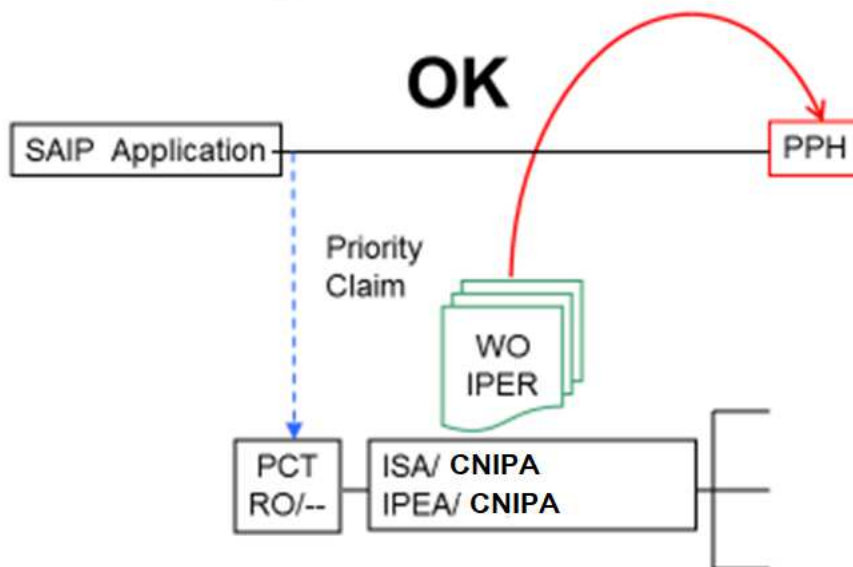
(A') The application is a national phase application of the corresponding international application.
(The corresponding international application claims priority from CNIPA or SAIP application.)



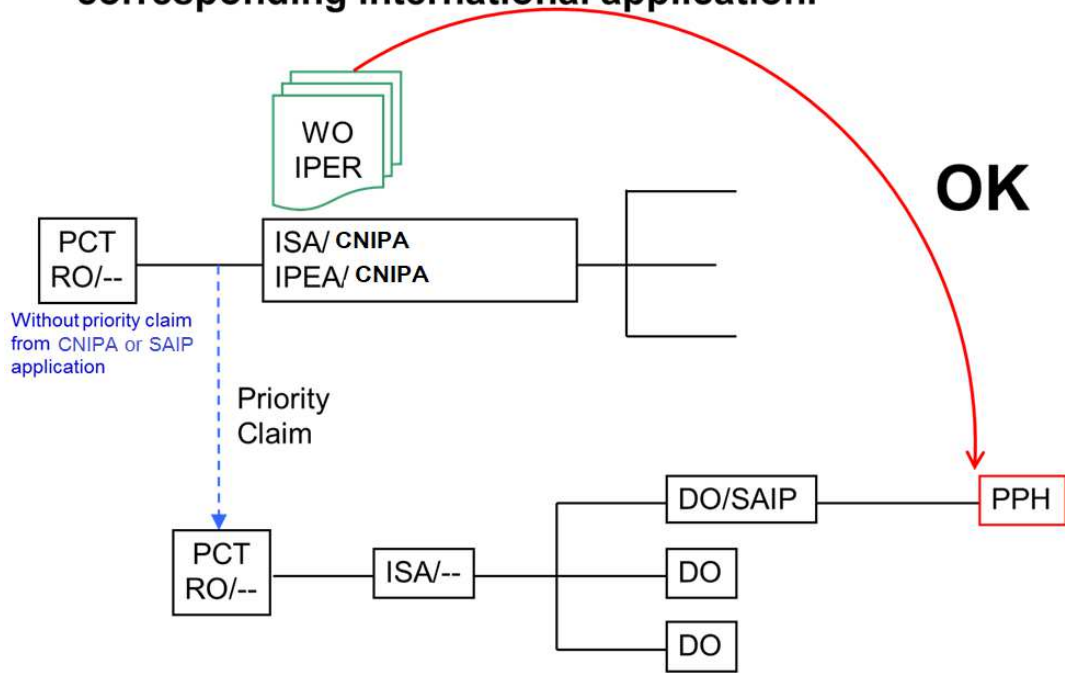
- (A'') The application is a national phase application of the corresponding international application.**
 (The corresponding international application claims priority from an international application.)



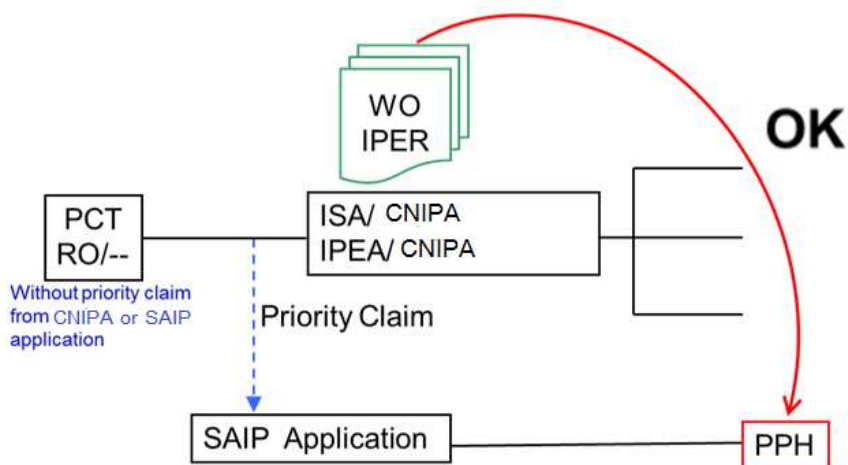
- (B) The application is a national application as a basis of the priority claim of the corresponding international application.**



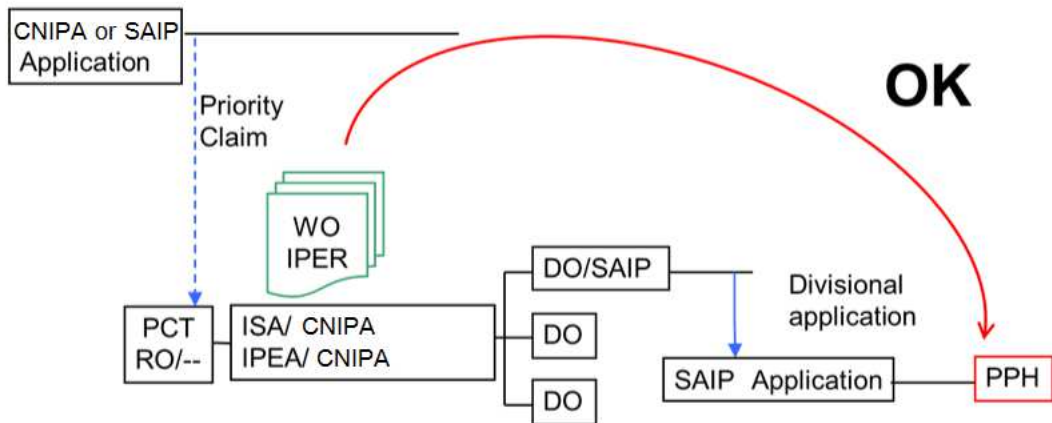
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



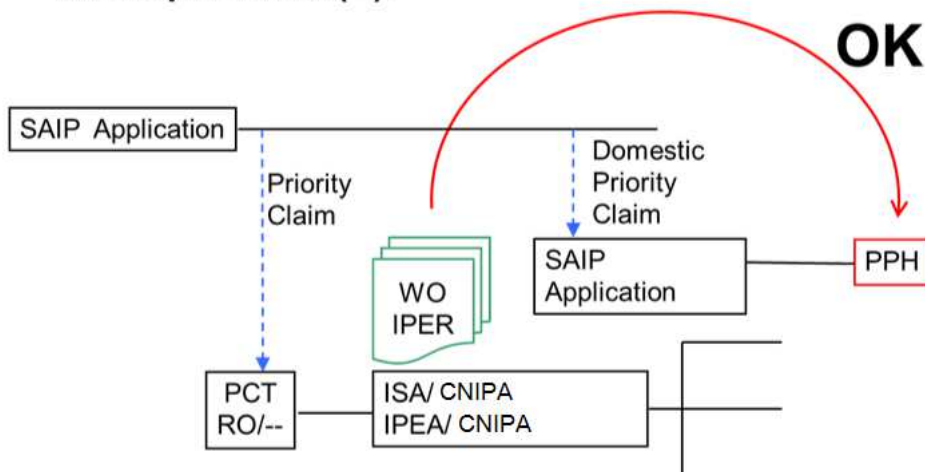
(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



(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 SAIP application which satisfies the requirement (B).



(E3) The application is an application claiming priority from ^{CNIPA} application which satisfies the requirement (B).

