

**Procedure to file a Request to the Eurasian Patent Office of the Eurasian Patent Organization for accelerated prosecution of patent application in accordance with the Patent Prosecution Highway Pilot Program between the Eurasian Patent Office of the Eurasian Patent Organization and the State Intellectual Property Office of the People's Republic of China**

The Patent Prosecution Highway Pilot Program (PPH) between Eurasian Patent Office of the Eurasian Patent Organization and the State Intellectual Property Office of the People's Republic of China (PPH Pilot Program) will commence on 01.04.2018 with duration of three years and end on 31.03.2021. The pilot period may be extended upon mutual consent between Eurasian Patent Office of the Eurasian Patent Organization (EAPO) and the State Intellectual Property Office of the People's Republic of China (SIPO).

The Offices may terminate the PPH pilot program if the volume of participation exceeds manageable level. Ex Ante notice will be published if the PPH pilot program is terminated.

1. Requirements

- (a) The EAPO application (included the PCT application entered into regional phase at EAPO) for which participation in the PPH Pilot Program is requested and the corresponding application on the basis of which the request on participation in PPH (PPH Request) is filed shall have the same date of priority or the same date of filing.

The EAPO application (including PCT regional phase application) may be:

- (i) an application which validly claims priority under the Paris Convention to the SIPO application(s) (examples are provided in ANNEX I, Figures A, B, C, F, G and H), or
- (ii) a PCT regional phase application without priority claim (an example is provided in Annex I, Figures 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, Figures J, K and L).

The EAPO 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 which has one or more 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 an

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 explicitly identified the claims to be “allowable/patentable” in the latest office action, even if the application has not been granted yet.

Office actions mentioned above are:

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

(c) All claims in the EAPO 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 determined to be patentable/allowable in the SIPO.

Claims are considered to “sufficiently correspond” where, aside from differences due to translations and claim format, the claims in the EAPO application are of the same or similar scope as the claims in the SIPO application, or the claims in the EAPO are narrower in scope than the claims in the SIPO.

In this regard, a claim that is narrower in scope occurs when SIPO claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims).

A claim in the EAPO which introduces a new/different category of claims to those claims determined to be patentable/allowable in the SIPO is not considered to sufficiently correspond. For example, if the SIPO claims only contain claims to a process of manufacturing a product, then the claims in the EAPO are not considered to sufficiently correspond if the EAPO 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 SIPO in an application in the EAPO (the deletion of claims is allowable).

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 patentable/allowable in the SIPO application.

(d) Substantive examination of the application has not begun at the moment of filing the request for the PPH with EAPO.

(e) For EAPO application, applicant must request for the substantive examination and pay the fees prescribed for substantive examination.

## 2. Documents to be submitted

To qualify for participation in the PPH Pilot Program an applicant shall submit:

a) the PPH Request to EAPO. The PPH Request Form is available at [www.eapo.org](http://www.eapo.org) in the section Documents/electronic forms (Annex II);

b) copies of all office actions (which are relevant to substantial examination for patentability in SIPO) which were issued for the corresponding application, and Russian or English translations thereof;

(c) copies of all claims indicated as patentable in SIPO and Russian or English translation thereof;

(d) copies of documents cited by SIPO examiner.

If the cited document is a patent document the applicant needs not present it as this kind of documents are usually accessible for EAPO. In case EAPO does not possess the required document the applicant must submit this patent document at the request of the examiner. Non-patent literature shall always be submitted. Submission of translation of the cited documents is required if their translation into Russian or English is not available;

(e) a table of claims correspondence.

The applicant submitting PPH request must submit a table of the claims correspondence that explains the correspondence of the claims in the Eurasian application to the claims that are recognized as patentable in the SIPO application.

If the claims are translated literally the applicant may write in the table "claims are identical". If the claims are not a literal translation, the table should explain the conformity of each claim.

If the applicant has already submitted to the EAPO the documents specified in subparagraphs (b) to (e) during simultaneous or previous procedures, he can include them by referring to them, without attaching the documents themselves. For the documents specified in subparagraphs (b) and (c), the use of machine translation is permissible. In case of poor quality of machine translation, EAPO may ask the applicant to provide an accurate translation. If SIPO application is not published, then the applicant must submit the documents specified in subparagraphs (b) and (c) above when applying for the PPH application.

## 3. Procedure for considering the request for the PPH pilot program

The decision to satisfy the PPH request is made subject to the fulfillment of all

the requirements specified in paragraphs 1 and 2 of this Procedure, which the applicant is notified about.

If all the requirements necessary to satisfy the PPH request are not complied with by the applicant and which can be eliminated by the applicant, EAPO shall notify the applicant about the need to correct the identified deficiencies within the time specified in the notification.

If the applicant does not eliminate these shortcomings, EAPO will inform the applicant of the refusal to satisfy the request. In this case, the Eurasian application is subject to examination in the order of priority within the framework of the EAPO procedure.

## REQUEST

**For accelerated patent prosecution in accordance with the Patent Prosecution Highway Pilot Program between the Eurasian Patent Office of the Eurasian Patent Organization (EAPO) and the State Intellectual Property Office of the People's Republic of China (SIPO)**

<b>Eurasian application number</b>	
<b>Applicant</b>	
Hereby the applicant requests accelerated patent prosecution referring to this Eurasian application in accordance with the Patent Prosecution Highway Pilot Program between EAPO and SIPO (hereinafter referred to as Pilot Program)	
<b>Attached documents:</b>	Number of pages
<input type="checkbox"/> Claims correspondence table between this Eurasian application and the SIPO application for which a positive decision on patentability (novelty, inventive step and industrial applicability) is made by SIPO.	
A copy and Russian or English translation of the document confirming the claims patentability of the corresponding application <input type="checkbox"/> SIPO Office actions <input type="checkbox"/> Russian or English translation of the above documents	
<input type="checkbox"/> a copy of non-patent literature to which references are made in the SIPO Office actions <input type="checkbox"/> Russian or English translation thereof	

Date

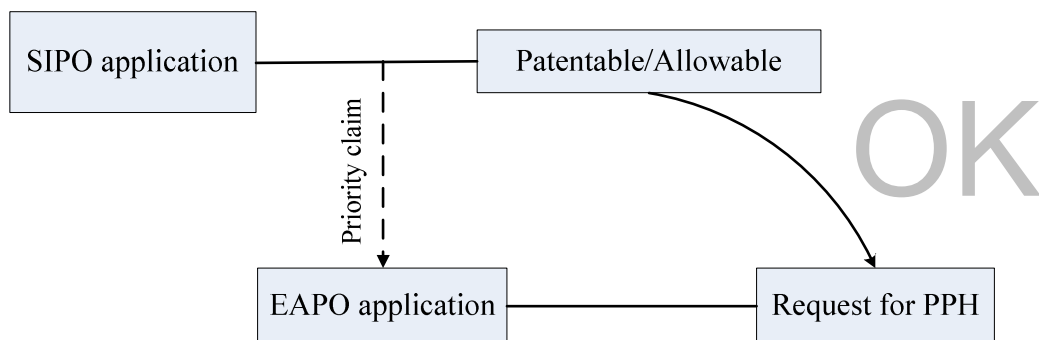
Signature

# ANNEX I

**A**

A case meeting requirement (a) (i)

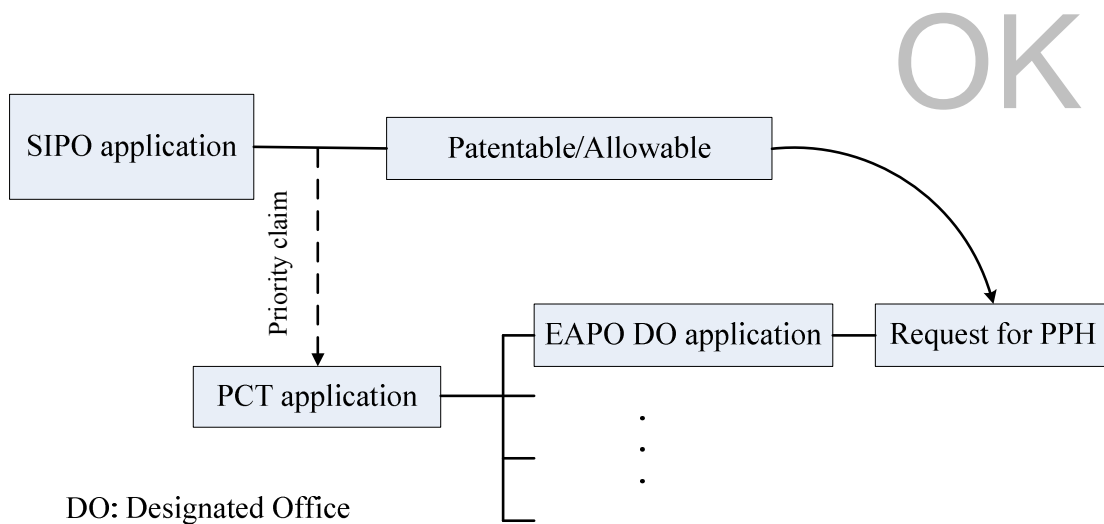
- Paris route -



**B**

A case meeting requirement (a) (i)

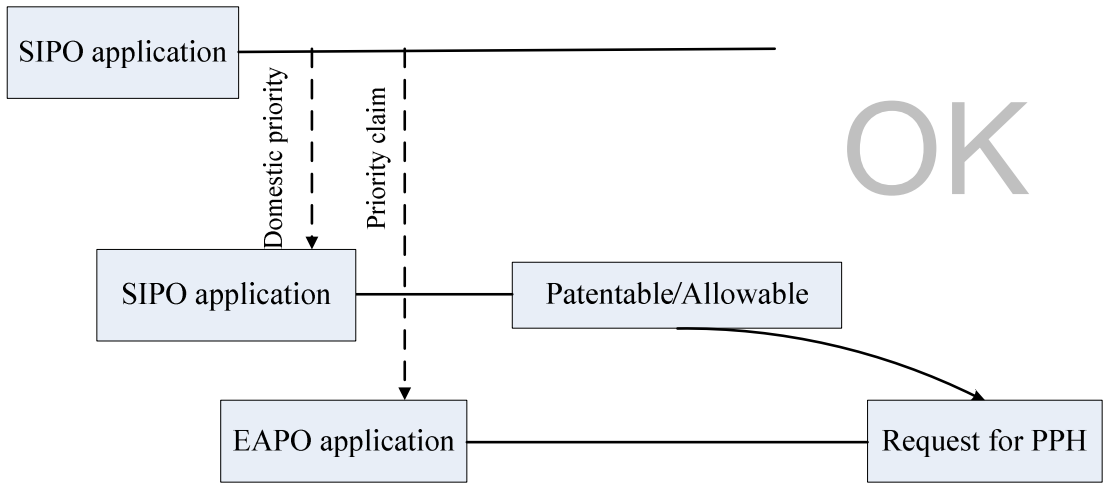
- PCT route -



C

A case meeting requirement (a) (i)

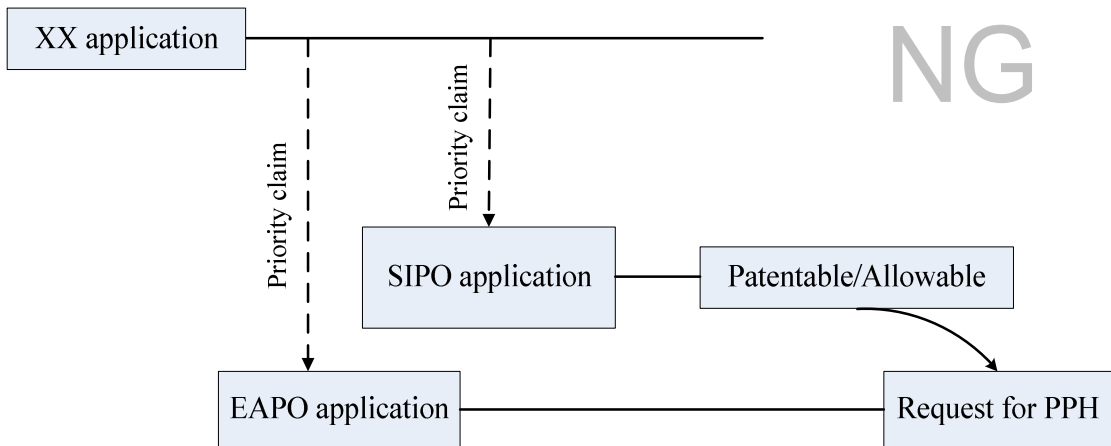
- Paris route, Domestic priority -



D

A case not meeting requirement (a)

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

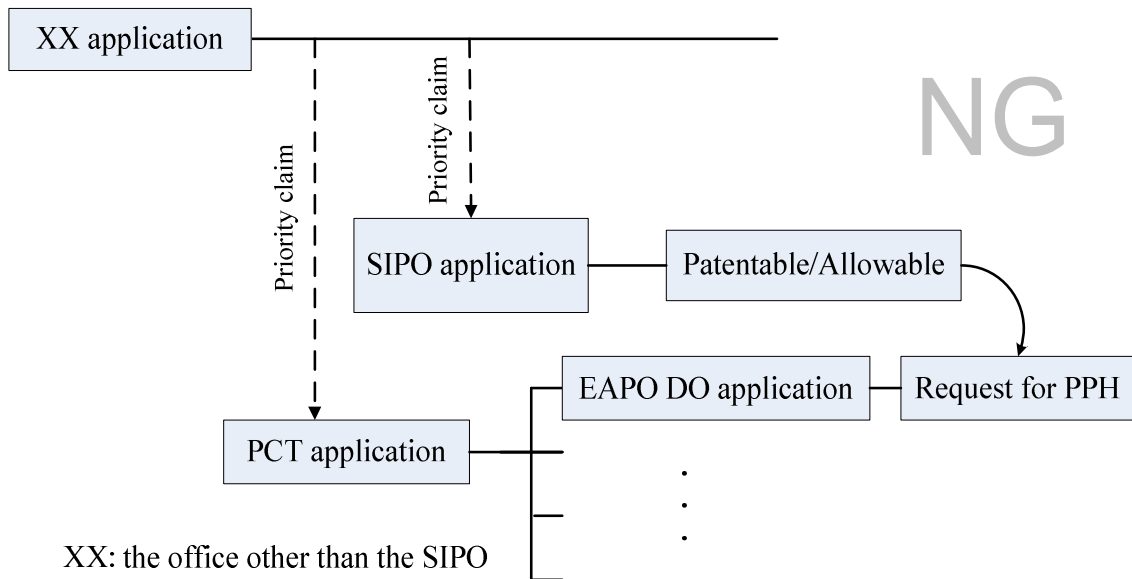


XX: the office other than the SIPO

E

### A case not meeting requirement (a)

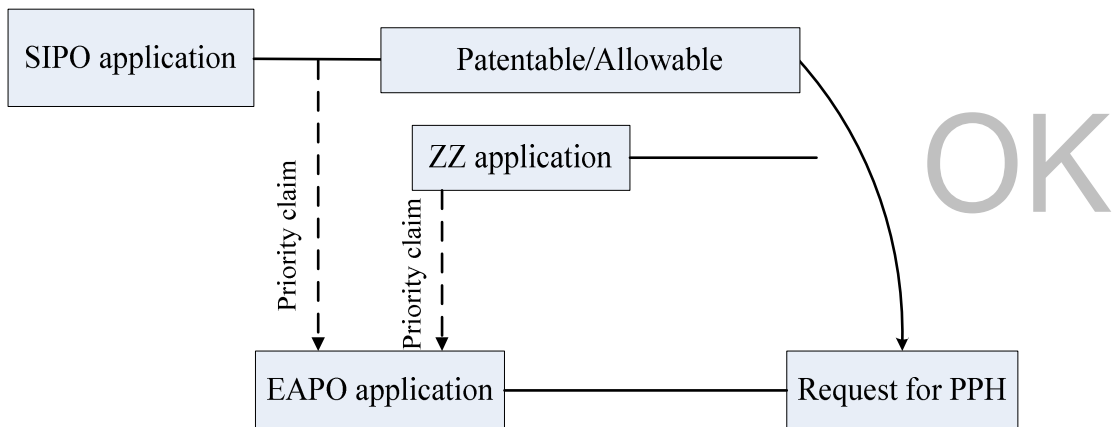
- PCT route, but the first application is from the third country -



F

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

- Paris route & complex priority -



ZZ: any office

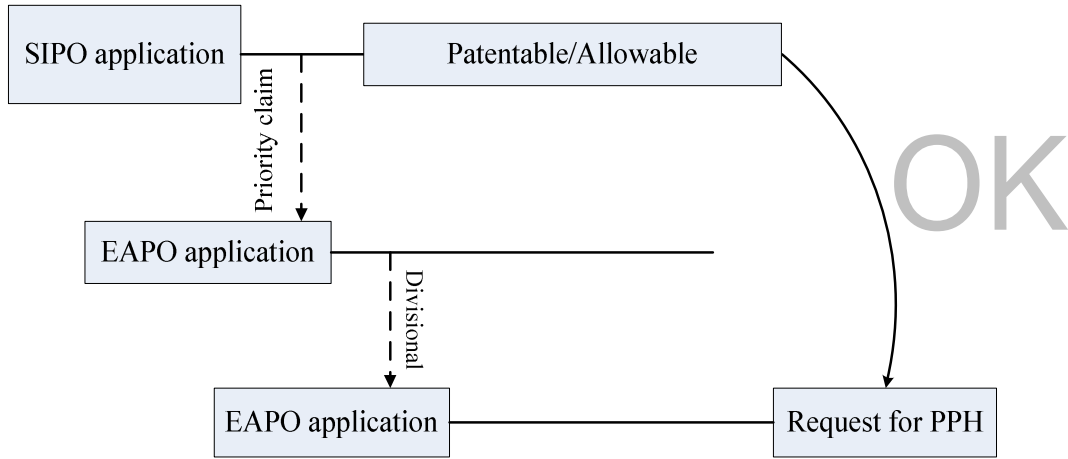
(The first application is from the SIPO)



G

A case meeting requirement (a) (i)

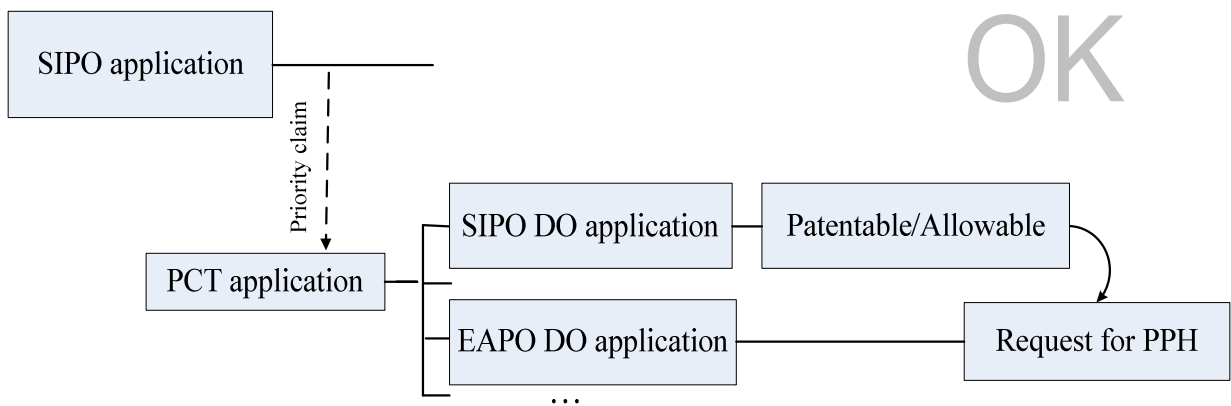
- Paris route & divisional application -



H

A case meeting requirement (a) (i)

- PCT route -

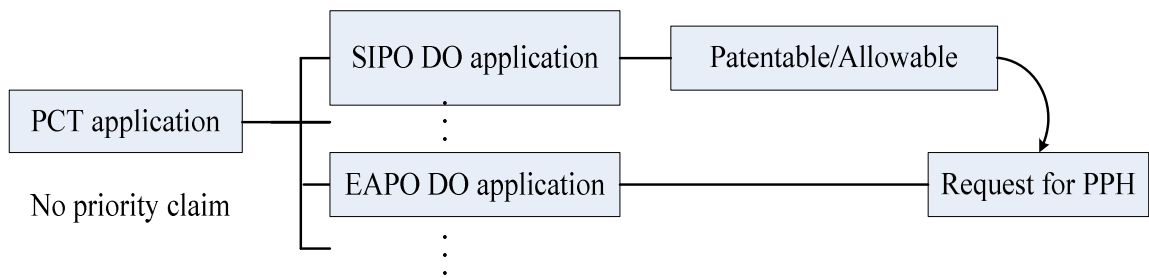


I

A case meeting requirement (a) (ii)

- Direct PCT route -

OK

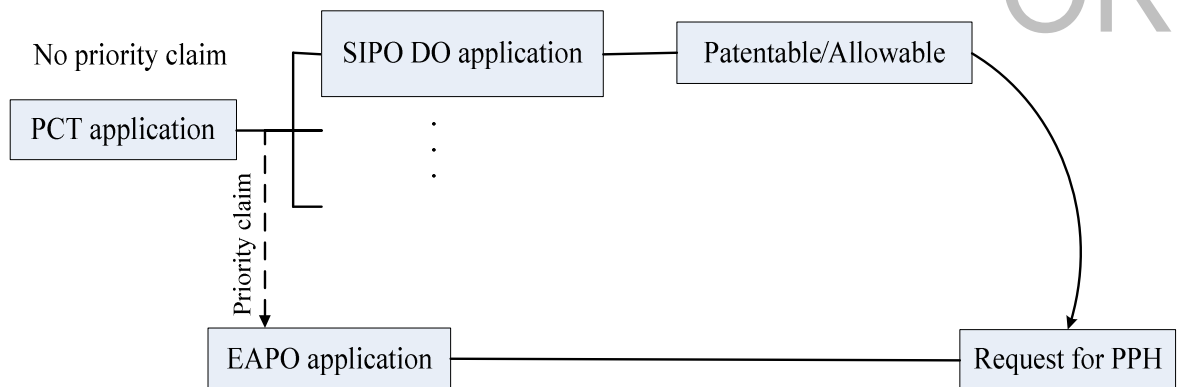


J

A case meeting requirement (a) (iii)

- Direct PCT & Paris route -

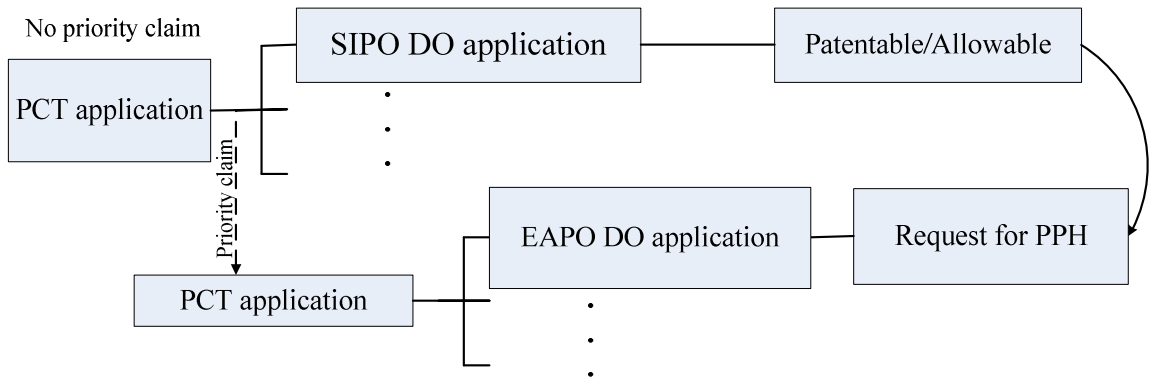
OK



K

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

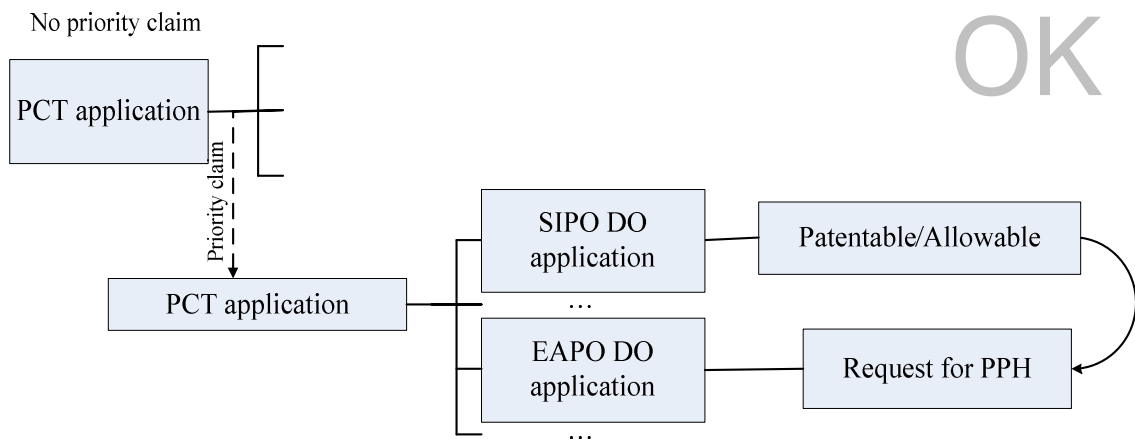
OK



L

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

OK



M

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

