

Procedures to file a request to the Icelandic Intellectual Property Office for use of the Patent Prosecution Highway Pilot Program between the Icelandic Intellectual Property Office (ISIPO) and the China National Intellectual Property Administration (CNIPA)

Patent Prosecution Highway (PPH) Pilot Program

[0001] The PPH is established to enable an applicant whose claims are determined to be allowable/patentable in the Office of First Filing (OFF) to have the corresponding application filed in the Office of Second Filing (OSF) enter into an accelerated examination procedure.

This PPH will commence on 1 July 2014, for a period of two years, ending on 30 June 2016. The pilot period may be extended if necessary until SIPO and the IPO receive a sufficient number of PPH requests to adequately assess the feasibility of the PPH program. The Offices may also terminate the PPH pilot program if the volume of participation exceeds a manageable level, or for any other reason. A notice will be published if the PPH pilot program is terminated.

A request for PPH is free of charge at the ISIPO.

Requests to the ISIPO

[0002] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the ISIPO by submitting a letter requesting accelerated examination under the PPH accompanied by the relevant supporting documents including a completed PPH request form. The requirements for an application to the ISIPO for accelerated examination under the PPH are given in the following section (paragraph [0003]). Relevant supporting documentation is discussed in a later section (paragraphs [0004]-[0006]) as is the general ISIPO application procedure envisaged at this time (paragraph [0007]).

Requirements for requesting accelerated examination under the PPH Pilot Program at the ISIPO

[0003] There are four requirements for requesting accelerated examination under the PPH pilot program at the ISIPO. These are:

- a) *The ISIPO application is either:*
- (i) a nationally filed application which validly claims priority under the Paris Convention to the CNIPA application(s) (*see examples A to C in Annex I*); or
 - (ii) a nationally filed application which validly claims priority under the Paris Convention from a PCT application(s) which has no priority claims (*see example D in Annex I*); or

- (iii) a PCT national phase application where the PCT international application has validly claimed priority from a CNIPA national application(s) (*see example E in Annex I*); or
- (iv) a PCT national phase application where the PCT international application has no priority claims (*see example F in Annex I*); or
- (v) a PCT national phase application where the PCT international application has validly claimed priority from a PCT international application(s) which has no priority claims (*see examples G to H in Annex I*); or
- (vi) a divisional of an application referred to any of (i) to (v) (*see example I in Annex I*).

Note that where the relationship between the CNIPA application that contains the allowable claims and the ISIPO application is not clearly apparent, the applicant must explain the relationship between these applications (e.g. CNIPA application X that contains the allowable/patentable claims, claims domestic priority to CNIPA application Y, which is the priority application claimed in the ISIPO application).

b) *At least one corresponding CNIPA application has one or more claims that have been determined to be allowable by the CNIPA.*

Claims clearly identified to be allowable in the latest Office Action by a CNIPA examiner or in the CNIPA Granted Patent can form the basis for a request for an accelerated examination under the PPH pilot program at the ISIPO.

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 allowable/patentable” in the following circumstances: If the CNIPA office action does not explicitly state that a particular claim is allowable/patentable, the applicant must include 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 allowable/patentable by the CNIPA.

For example, if claims are not shown in the item of “6. the Opinion on the Conclusion of Examination (审查的结论性意见) about Claims (关于权利要求书)” in the “First Notice of the Opinion on Examination(第一次审查意见通知书)” or “5. the Opinion on the Conclusion of Examination (审查的结论性意见) about Claims (关于权利要求书)” in the “Second/Third/...Notice of the Opinion on Examination(第 次审查意见通知书)” of the CNIPA, those claims may be deemed to be implicitly identified to be allowable/patentable and then the applicant must include the above explanation.

c) *All claims in the ISIPO application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the CNIPA.*

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 ISIPO are of the same or similar scope as the claims in the CNIPA, or the claims in the ISIPO 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 ISIPO 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, the CNIPA claims only contain claims to a process of manufacturing a product, then the claims in the ISIPO are not considered to sufficiently correspond if the ISIPO claims introduce product claims that are dependent on the corresponding process claims.

It is not necessary to include all claims determined to be patentable in the CNIPA in the application to the ISIPO, as the deletion of claims is allowable. In a case where an application to the CNIPA contains 5 claims which are determined to be allowable, the corresponding application to the ISIPO may contain only 3 of those 5 claims.

Examples of claims which comply with requirement c) are given in Annex III.

d) *The ISIPO has not yet issued a communication stating an intention to grant.*

The heading for such a communication will either be

- “Fyrirhuguð útgáfa einkaleyfis” (in Icelandic) or “Intention to Grant” (in English), **or**
- “Tilkynning um veitingu einkaleyfis” (in Icelandic) or “Notification of Grant” (in English).

Required documents for accelerated examination under the PPH pilot program at the ISIPO

[0004] The following documentation will be needed to support a request for accelerated examination under the PPH pilot program at the ISIPO:

a) *A copy of the office action(s) relating to the corresponding CNIPA application(s) and a translation thereof if the office actions are not issued in English.*

The term “office actions” is here used to define the correspondence sent to the applicant or the applicant’s representative by the CNIPA examiner.

The applicant must supply the ISIPO with copies of the office actions issued by CNIPA for the corresponding application(s). If CNIPA’s office actions are not issued in English, the applicant must also submit translations of CNIPA’s office actions in either English or Danish. Machine translation is admissible. However, if the person handling the application at the

ISIPO is not able to understand the translated office actions to a sufficient extent, the ISIPO can request the applicant to submit professional translations.

b) *A copy of the claims determined to be patentable by the CNIPA and translations hereof.*

The applicant must submit copies to the ISIPO of the claims allowed by the CNIPA. If the allowed claims are not in English, the applicant must further submit a translation of the allowed claims into either English or Danish. Machine translation is admissible. However, if the person handling the application at the ISIPO is not able to understand the translated claims to a sufficient extent, the ISIPO can request the applicant to submit professional translations.

c) *A completed claim correspondence table showing the relationship between the claims of the ISIPO application for accelerated examination under the PPH and the claims of the corresponding application considered patentable by the CNIPA.*

Sufficient correspondence of claims occurs where the claims satisfy the requirements of section [0003]c. The claim correspondence table must indicate how all the claims in the ISIPO application correspond to the patentable claims in the CNIPA application as shown in the Annex IV. The claim correspondence table must be written in either English or Danish.

Where the claims filed to the ISIPO are literal translations of the claims which the CNIPA has determined to be allowable, it will be sufficient to write “they are the same” in the claim correspondence table. When the claims applied for at the ISIPO are not literal translations, it will be necessary to explain why there is sufficient correspondence of each claim based on the criteria set out in section [0003]c above.

Applicant is required to submit a new claims correspondence table along with the amendments. Any claims amended or added after the grant of the request for participation in the PPH pilot program but before the ISIPO first action must sufficiently correspond to the claims indicated as patentable/allowable in the in the CNIPA application. Any claims amended or added after the first ISIPO action need not to sufficiently correspond to the claims indicated as patentable/allowable in the CNIPA in order to overcome the reasons for refusal raised by the ISIPO.

d) *A copy of the references cited by the CNIPA examiner.*

If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the ISIPO. If the ISIPO does not have access to the relevant patent documents, the applicant must submit these documents at the request of the ISIPO. Non-patent literature must always be submitted.

Submission of translations of the references is not required. However, if the person handling the application at the ISIPO has difficulties in understanding the references, the applicant may be requested to submit translations thereof. Furthermore, applicants will be free to file translations as part of the supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the citations if they so desire.

[0005] The applicant is required to complete a form for requesting accelerated examination under the PPH pilot program (as given in Annex II below) which will be

available for download from the ISIPO's website on <https://www.hugverk.is/en/pph-accelerated-examination> The form must be sent to the ISIPO along with the relevant supporting documentation.

[0006] The applicant need not provide further copies of documentation, if the applicant has already submitted the documents noted above to the ISIPO through simultaneous or past procedures.

Procedure for accelerated examination under the PPH Pilot Program at the ISIPO

[0007] The applicant files a letter requesting accelerated examination under the PPH Pilot Program to the ISIPO, including the relevant supporting documents as noted above and a completed request form (as given in Annex II below and also available from ISIPO's website). The application for accelerated examination under the PPH may be made by e-mail or conventional mail.

E-mail requests for PPH processing at the IPO must be sent to: hugverk@hugverk.is.

PPH requests sent by conventional mail must be sent to:

The Icelandic Intellectual Property Office
Engjateigur 3
IS-150 Reykjavik
Iceland

The PPH request form should be the uppermost document when applying for accelerated examination by conventional mail to ensure that the request is processed correctly. All subsequent correspondence from the applicant to the ISIPO must be clearly identified as concerning a PPH pilot program application to ensure that the correspondence is processed correctly.

The ISIPO decides whether the application can be entitled the status of accelerated examination under the PPH when ISIPO receives a request with the documents stated above. When the ISIPO decides that a request is acceptable, the application is assigned a special status for accelerated examination. The applicant will be notified if the request is accepted.

If 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. When the request is corrected by the applicant, the application will continue its accelerated examination under the PPH.

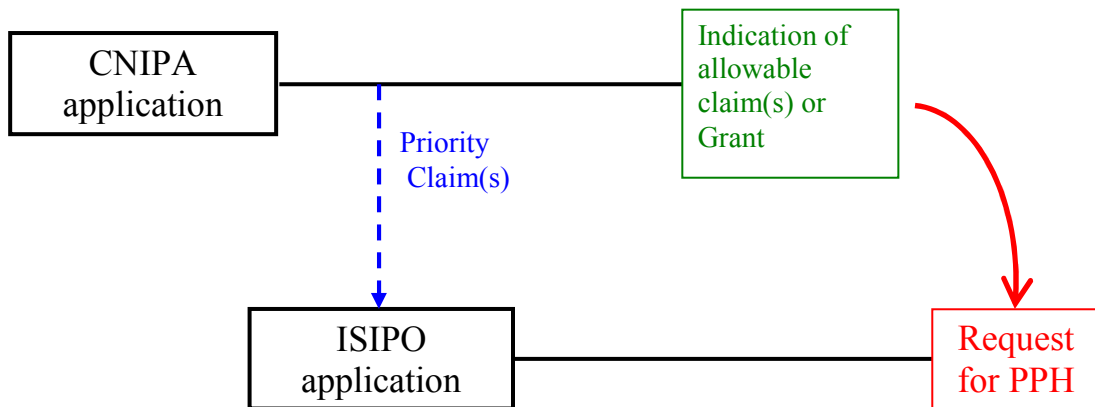
If the request for participation in the PPH pilot program meets all the requirements, the ISIPO will decide whether a patent will be issued based on the search and examination carried out by the CNIPA or, should the documents submitted not be considered sufficient, sent to the Danish Patent and Trademark Office (DKPTO) for examination, in accordance with a partnership agreement. If the application is sent to the DKPTO, their patent examiners will conduct the accelerated examination at the request of the ISIPO. The ISIPO will notify the applicant in advance, should the application proceed to further examination at DKPTO.

ANNEX I

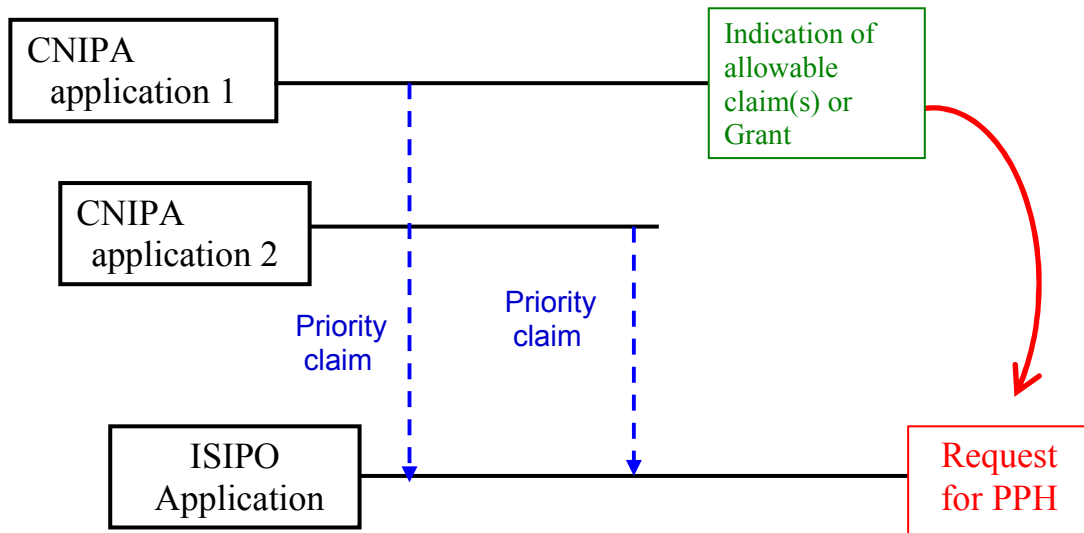
Examples of Icelandic patent applications eligible for accelerated examination under the PPH pilot program at ISIPO:

a)(i) A nationally filed application which validly claims priority under the Paris Convention to the CNIPA application(s):

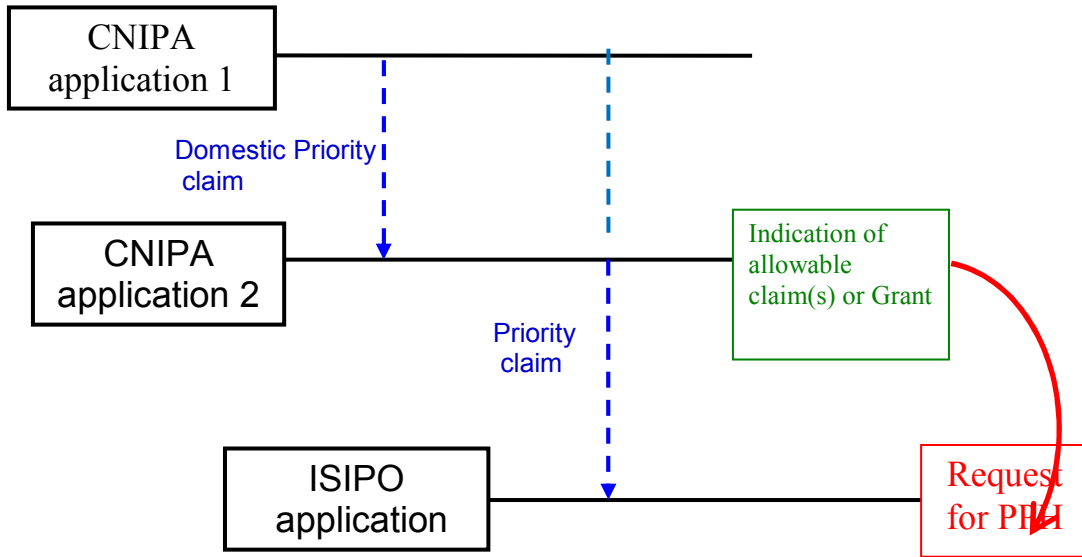
Example A:



Example B:

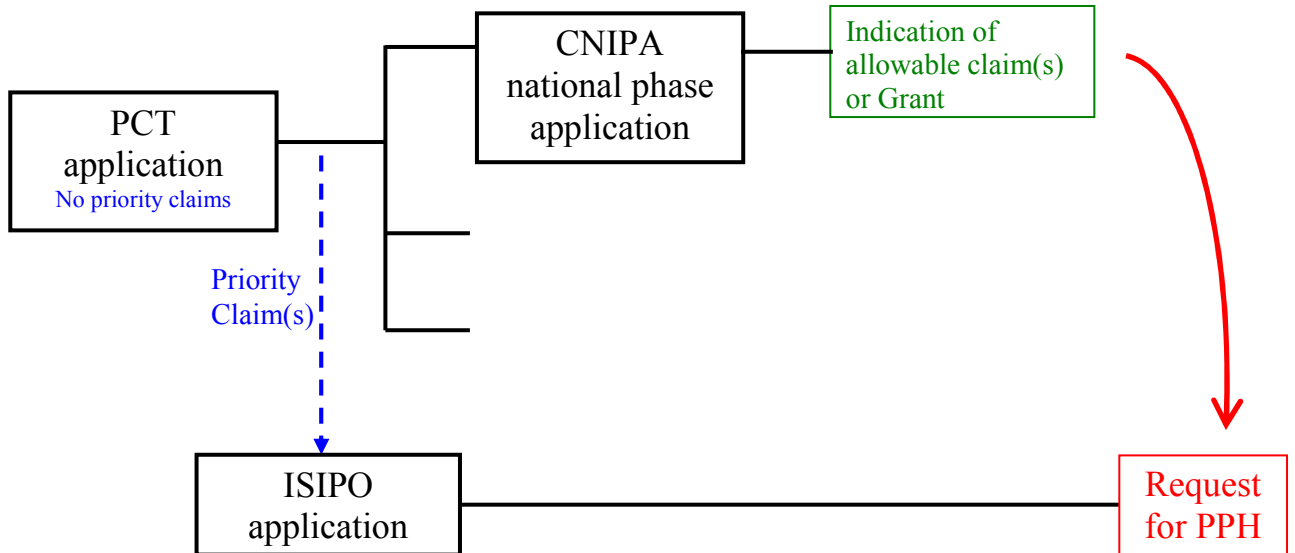


Example C:



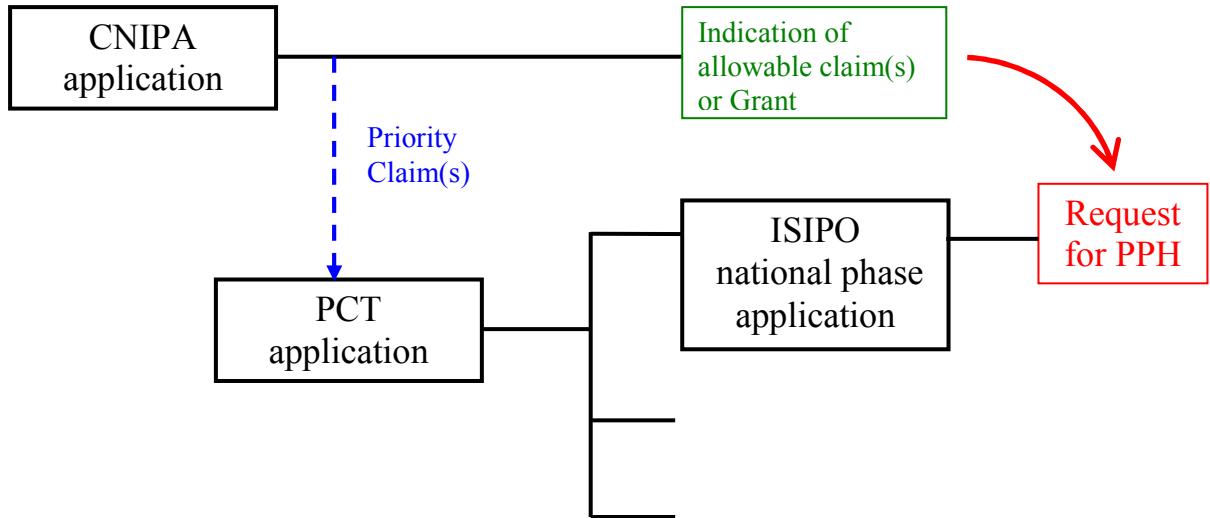
a)(ii) A nationally filed application which validly claims priority under the Paris Convention from a PCT application(s) which has no priority claims:

Example D:



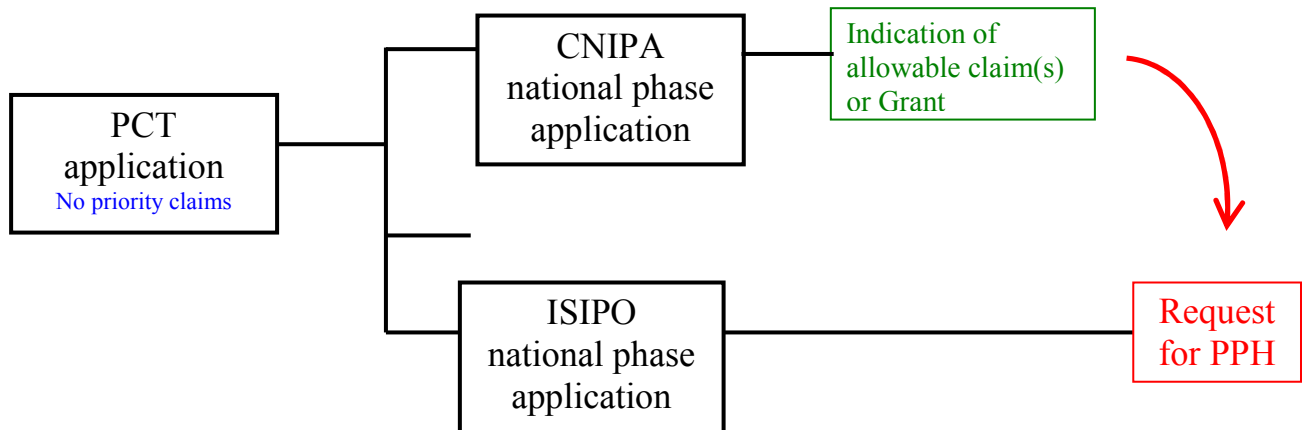
a)(iii) A PCT national phase application where the PCT international application has validly claimed priority from a CNIPA national application(s):

Example E:



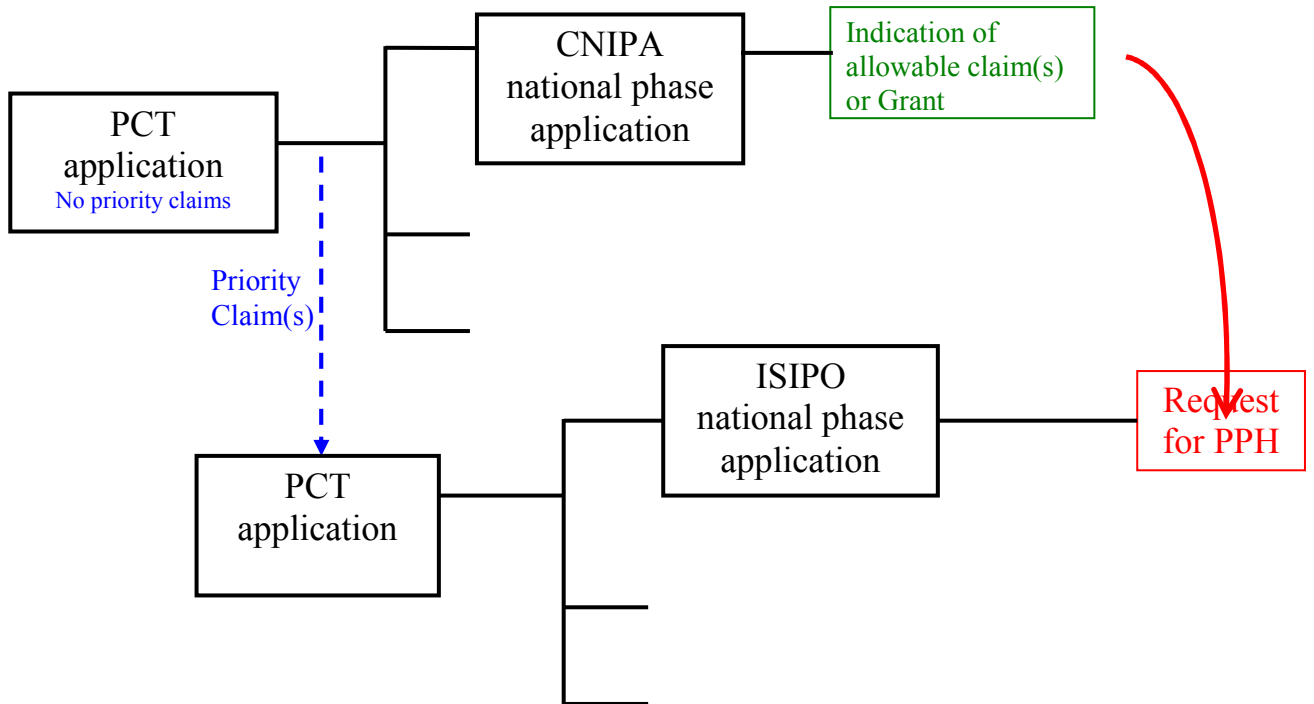
a)(iv) A PCT national phase application where the PCT international application has no priority claims:

Example F:

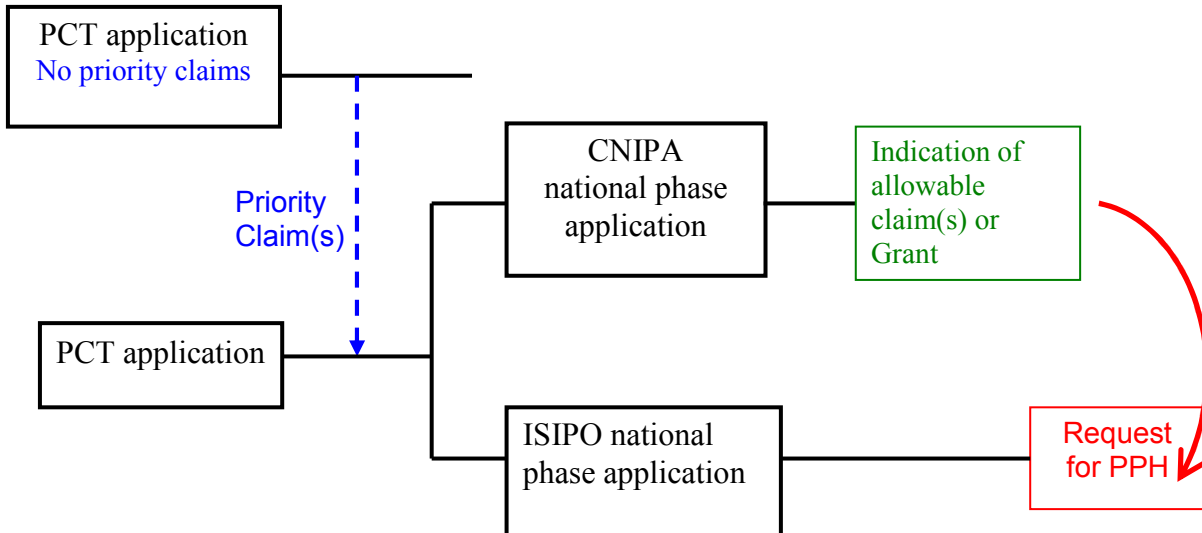


a)(v) A PCT national phase application where the PCT international application has validly claimed priority from a PCT application(s) which has no priority claims:

Example G:

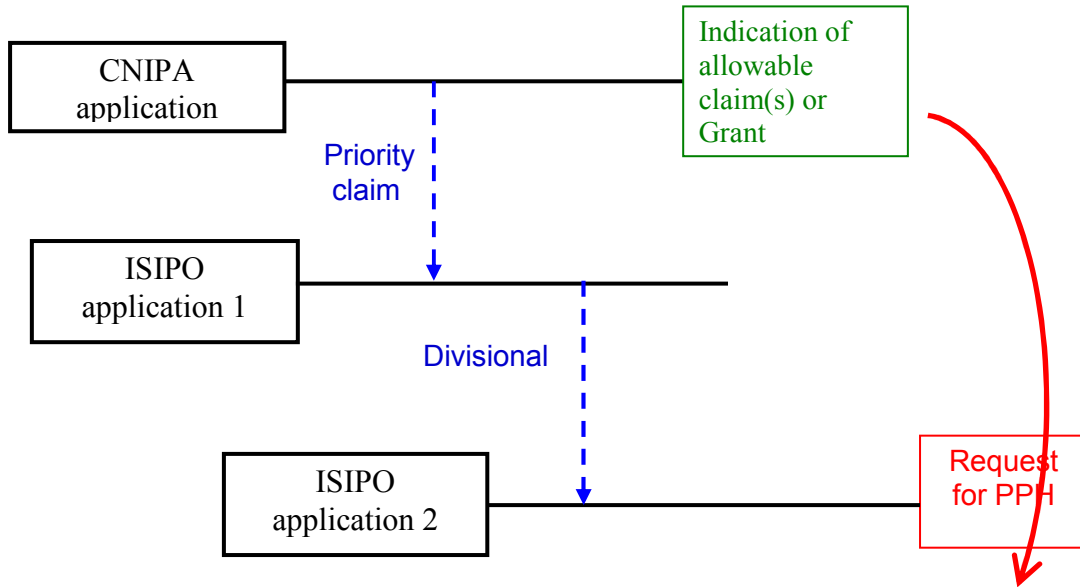


Example H:



a)(vi) A divisional of an application referred to any of (i) to (v):

Example I:



ANNEX II

PPH REQUEST

Request for Accelerated Examination at the ISIPO under the Patent Prosecution Highway Pilot Program between the ISIPO and CNIPA

- 1 IS application number:
Corresponding CNIPA application number(s):
- 2 **Either:**
a) Copy of CNIPA office action(s) in English or a translation thereof in English or Danish attached:
or
b) CNIPA office action(s) on file from previous PPH request:
IS application number:
- 3 **Either:**
a) Copy of claims of corresponding CNIPA application in English or a translation thereof in English or Danish attached
or
b) CNIPA application claims on file from previous PPH request:
IS application number:
- 4 Claim correspondence table attached:

Please ensure that this is the uppermost document when requesting accelerated examination under the PPH.

ANNEX III

The following figure contains examples of claims which meet the requirement of “sufficient correspondence” as laid down in PPH requirement c):

| CNIPA claims | Subject matter | ISIPO claims | Subject matter | Comment |
|-------------------|----------------|--------------|----------------------------------|--|
| 1(independent) | A | 1 | A | The same as CNIPA claim 1. |
| 2(dependent on 1) | A + a | 2 | A + a + b | Claim 2 has the additional technical feature “b” on the CNIPA claim 2. |
| 3(dependent on 1) | A + b | 3 | A | Similar to CNIPA claim 1 except for claim format. |
| | | 4 | A + d (new independent claim) | Claim 4 has an additional technical feature “d” on the CNIPA claim 1. Where "d" is supported in the description but is not claimed in the CNIPA. |

Where “A” is the subject matter and “a”, “b”, and “d” are the additional technical features which narrow (further restrict) the scope of the subject matter.

ANNEX IV

Claim Correspondence Table:

| ISIPO application claims | Corresponding claims allowed by CNIPA | Explanation regarding the correspondence |
|--------------------------|---------------------------------------|--|
| | | |
| | | |
| | | |
| | | |

Example of Completed Claim Correspondence Table:

| ISIPO application claim | Corresponding claims allowed by CNIPA | Explanation regarding the correspondence |
|-------------------------|---------------------------------------|---|
| 1 to 5 | 1 to 5 | Applicant has amended the claims to the present claims having the same scope as the claims of the applicant's corresponding CNIPA application. CNIPA claims 1 to 5 have been indicated as allowable in the CNIPA Granted Patent _____, dated ____ . |
| 1 to 3 | 1 to 3 | Applicant has amended the claims to the present claims having the same scope as the claims of the applicant's corresponding CNIPA application. CNIPA claims 1 to 3 have been indicated as allowable. |