Procedures to File a Request to the SIPO (State Intellectual Property Office of the P. R. China) for Patent Prosecution Highway Pilot Program between the SIPO and the DKPTO (Danish Patent and Trademark Office)

The PPH pilot program commenced on January 1, 2013 for a duration of one year. According to the agreement between the SIPO and the DKPTO, the PPH pilot program will be extended for a two-year term, starting on January 1, 2014 and ending on December 31, 2015. The pilot period may be further extended if necessary until the SIPO and DKPTO receive the sufficient number of PPH requests to adequately assess the feasibility of PPH program.

The Offices may also 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.

PPH using the national work products from the DKPTO

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

When filing a request for the PPH pilot program, an applicant must submit a request form "Request for Participation in the Patent Prosecution Highway Program" to the SIPO.

1. Requirements

(a) The SIPO application (including PCT national phase application) is

(i) an application which validly claims priority under the Paris Convention to the DKPTO application(s) (examples are provided in ANNEX I, Figure A, B, C, F, G and H), or

(ii) a PCT national phase application without priority claim (examples are provided in Annex I, Figure I and K), 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, Figure J and L).

The SIPO application, which validly claims priority to multiple DKPTO 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 DKPTO and has one or more claims that are determined to be patentable/allowable by the DKPTO.

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the DKPTO application which forms the basis of the priority claim (e.g., a divisional application of the DKPTO application or an application which claims domestic priority to the DKPTO application (see Figure C in Annex I)), or a DKPTO national phase application of a PCT application which validly claims priority to the DKPTO application(s) (see Figures H in Annex I), a DKPTO national phase application of a PCT application which validly claims priority to another PCT application(s) without priority claim (see Figures K and L in Annex I), or a DKPTO national phase application of a PCT application without priority claims (see Figure I and J in Annex I).

Claims are "determined to be allowable/patentable" when the DKPTO examiner explicitly identified the claims to be "allowable/patentable" in the latest office action, even if the application is not granted for patent yet..

Office actions mentioned above are:

1. "Godkendelse" (in Danish) or "Grant" (in English"); or
2. "Berigtigelse af bilag" (in Danish) or "Intention to Grant" (in English)

Note, these Office Actions must accompanied by the applicants letter including the claims deemed allowable as mentioned in the Office Actions 1 or 2 above.

(c) All claims in the SIPO 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 DKPTO.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the SIPO are of the same or similar scope as the claims in the DKPTO, or the claims in the SIPO are narrower in scope than the claims in the DKPTO.

In this regard, a claim that is narrower in scope occurs when a DKPTO 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 SIPO which introduces a new/different category of claims to those claims determined to be patentable/allowable in the DKPTO is not considered to sufficiently

correspond. For example, the DKPTO claims only contain claims to a process of manufacturing a product, then the claims in the SIPO are not considered to sufficiently correspond if the SIPO 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 DKPTO in an application in the SIPO (the deletion of claims is allowable). For example, in the case where an application in the DKPTO contains 5 claims determined to be patentable/allowable, the application in the SIPO may contain only 3 of these 5 claims.

Any claims amended or added after the grant of the request for participation in the PPH pilot program but before the SIPO first office action must sufficiently correspond to the claims indicated as patentable/allowable in the DKPTO application. Any claims amended or added after the first SIPO action need not to sufficiently correspond to the claims indicated as patentable/allowable in the DKPTO when applicants need to amend claims in order to overcome the reasons for refusal raised by SIPO examiners. Any amendment outside of the claim correspondence requirement is subject to examiners’ discretion.

Note that any applicant to the SIPO may amend the application including its claims on its or his own initiative when a request for substantive examination is made, and within the time limit of three months after the receipt of the Notice of Invention Patent Application Entering into Substantive Examination Stage. Therefore, an applicant needs to care about the time limit of amendment in order to make claims in the SIPO application correspond to the claims determined to be patentable/allowable in the DKPTO.

(d) The SIPO application must have been published.

The applicant must have received the *Notice of Publication of Invention Patent Application* issued from the SIPO before, or when, filing the PPH request.

(e) The SIPO application must have entered into substantive examination stage.

The applicant must have received the *Notice of Invention Patent Application Entering into Substantive Examination Stage* issued from the SIPO before, or when, filing the PPH request.

Note that as an exception, the applicant may file a PPH request simultaneously with the Request for Substantive Examination.

(f) The SIPO has not begun examination of the application at the time of request for the PPH.

The applicant should have not received any office action issued from the substantive examination departments in the SIPO before, or when, filing the PPH request.

(g) The SIPO application must be electronic patent application.

If the application is a paper based application, the applicant should first transfer his application into electronic patent application and then file a PPH request.

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to "Request for Participation in the Patent Prosecution Highway Program".

Note that even when it is not needed to submit certain documents below, the name of the documents must be listed in the "Request for Participation in the Patent Prosecution Highway Program" (Please refer to the example form below for the detail).

(a) Copies of all office actions (which are relevant to substantial examination for patentability in the DKPTO) which were issued for the corresponding application by the DKPTO, and translations of them.

Either Chinese or English is acceptable as translation language[1]. If it is impossible for the examiner to understand the translated office action, the examiner can request the applicant to resubmit translations.

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

Either Chinese or English is acceptable as translation language. If it is impossible for the examiner to understand the translated claims, the examiner can request the applicant to resubmit translations.

(c) Copies of references cited by the DKPTO examiner

The documents to be submitted are those cited in the above-mentioned office actions. Documents which are only referred to as references and consequently do not consist of the reasons for refusal do not have to be submitted.

If the references are patent documents, the applicant does not have to submit them[2]. When the SIPO 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.

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[1] Machine translation is admissible.

[2] Note that even when it is not needed to submit copies of references, the name of the references must be listed in the "Request for Participation in the Patent Prosecution Highway Pilot Program".

(d) Claim correspondence table

The applicant requesting PPH must submit a claim correspondence table[3], which indicates how all claims in the SIPO application sufficiently correspond to the patentable/allowable claims in the DKPTO 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 based on the criteria 1. (c) (Please refer to the example form below).

When the applicant has already submitted above documents (a) to (d) to the SIPO through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

3. Example of “Request for Participation in the Patent Prosecution Highway Program” for filing request of an accelerated examination under the PPH pilot program

(a) Circumstances

When an applicant files a request for an accelerated examination under the PPH pilot program to the SIPO, the applicant must submit a request form “Request for Participation in the Patent Prosecution Highway Program”.

The applicant must indicate that the application is included in (i) to (iii) of 1. (a), and that the accelerated examination is requested under the PPH pilot program. The application number, publication number, or a patent number of the corresponding DKPTO application(s) also must be written.

In the case that the application which has one or more claims that are determined to be patentable/allowable is different from the DKPTO application(s) included in (i) to (iii) of 1. (a) (for example, the divisional application of the basic application), the application number, publication number, or a patent number of the application(s) which has claims determined to be patentable/allowable and the relationship between those applications also must be explained.

(b) Documents to be submitted

[3] The claim correspondence table must be written in Chinese.

The applicant must list all required documents mentioned above 2. in an identifiable way, even when the applicant is exempted to submit certain documents.

(c) Notice

An applicant can file the “Request for Participation in the Patent Prosecution Highway Program” to the SIPO through on-line procedures only.

4. Procedure for the accelerated examination under the PPH pilot program

The SIPO 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 SIPO 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. The applicant may be given opportunity, one time only, to correct certain specified defects. If the request is not approved, the applicant may resubmit the request up to one time. If the resubmitted request is still not approved, the applicant will be notified and the application will await action in its regular turn.

Example form of Participation in the Patent Prosecution Highway Program (Conventional PPH and PCT-PPH all inclusive)

参与专利审查高速路（PPH）项目请求表 PPH

Request for participation in the Patent Prosecution Highway Program (Sample Form)

<table>
<tr><td colspan="2"></td><td colspan="2">此框由国家知识产权局填写
This frame will be filled in by SIPO</td></tr>
<tr><td rowspan="3">①
专利
申请</td><td colspan="2">申请号： Application Number here</td><td colspan="2">请求日：</td></tr>
<tr><td colspan="2">申请人：Applicant Name here</td><td colspan="2">申请号条码：</td></tr>
<tr><td colspan="2">发明名称： Title of Invention here</td><td colspan="2">挂号号码：</td></tr>
<tr><td>②
说明
事项</td><td colspan="4">根据专利审查高速路项目的相关规定，请求对上述申请进行加快审查。
Request accelerated examination of said application according to relevant guidelines on participation in the Patent Prosecution Highway Pilot Program
☒ 请求参与常规的 PPH Check if request for participation in conventional PPH
☐ 请求参与 PCT-PPH Check if request for participation in PCT- PPH</td></tr>
<tr><td rowspan="2">③
对应
申请
声明</td><td>对应申请号/公开号/专利号/国际申请号
Application Number, publication number, or patent number of the corresponding applications</td><td>对应申请审查机构名称
Name of the Examination Authority of the corresponding applications</td><td colspan="2">相关申请对应关系
Relationship between said application and the corresponding applications</td></tr>
<tr><td></td><td></td><td colspan="2"></td></tr>
</table>

④ 附加 文件 清单	申请人随本 PPH 请求表一起提交了下列文件： *Documents accompanying the request form* ☐ 对应申请的所有可授权权利要求书副本及其译文： 1. 对应申请_____，由__于__年__月__日作出的_____通知书所针对的权利要求书副本及其译文 2. 对应申请_____，由__于__年__月__日作出的_____通知书所针对的权利要求书副本及其译文 *Check if copies of all claims determined to be patentable/allowable in the corresponding application, and translations of them submitted; write down claims are determined to be patentable/allowable in which office action issued by which office on what date; in the case that said application corresponds to more than one corresponding application, write down each corresponding application number.* ☐ 对应申请的审查意见通知书副本及其译文，各文件名称如下： 1. 对应申请_____： 1）由__于__年__月__日作出的_____通知书副本及其译文 2）由__于__年__月__日作出的_____通知书副本及其译文 2. 对应申请_____： 1）由__于__年__月__日作出的_____通知书副本及其译文 2）由__于__年__月__日作出的_____通知书副本及其译文 *Check if copies of all office actions (which are relevant to substantial examination for patentability) which were issued for the corresponding application, and translations of them submitted; write down which office action was issued by which office on what date; in the case that said application corresponds to more than one corresponding application, write down each corresponding application number.* ☐ 权利要求的对应表 *Check if claim correspondence table submitted* ☐ 对应申请的审查意见引用文件副本，各文件名称如下： 1. _____ 2. _____ *Check if copies of references cited in all office actions which were issued for the corresponding application submitted; write down the names of references even if omitted for submission* ☐ 其他证明文件 1. _____ *Check if other documents submitted; write down the names of documents*

⑤ 申请人或专利代理机构签字或盖章 *Signature or seal by applicant or its agent* 年　　月　　日	⑥ 国家知识产权局处理意见 *Decision on this request by SIPO* 年　　月　　日

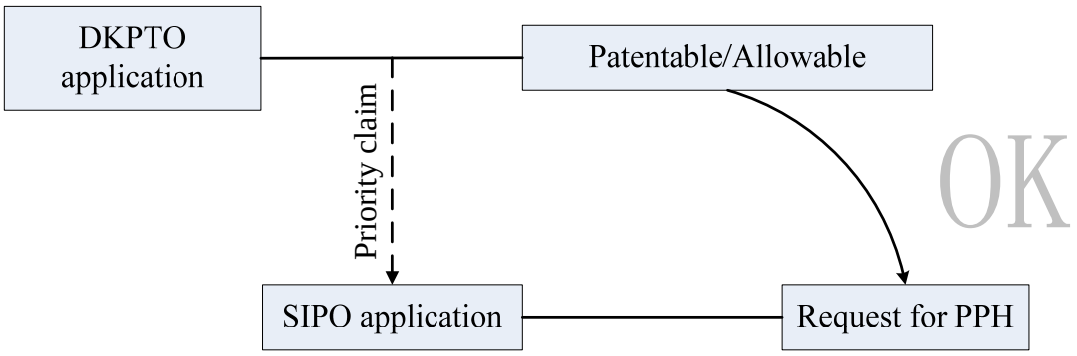
本申请的权利要求 *Claims in this application*	对应申请中被认为可授权的对应权利要求 *Patentable/Allowable claims in the corresponding application*	关于对应性的说明 *Comments on the correspondence*
1	1	完全相同 Both claims are the same
2	2	完全相同 Both claims are the same
3	1	权利要求 3 在对应申请权利要求 1 的基础上引入了说明书第 X 页第 X 段记载的技术特征 X Claim 3 is further limited by an additional technical feature recorded in Paragraph X, Page X in the specification on the basis of Claim 1 in the corresponding application.
4	2	权利要求 4 在对应申请权利要求 2 的基础上引入了说明书第 Y 页第 Y 段记载的技术特征 Y Claim 4 is further limited by an additional technical feature recorded in Paragraph Y, Page Y in the specification on the basis of Claim 2 in the

		corresponding application.
5	1	权利要求 5 在对应申请权利要求 1 的基础上引入了说明书第 Z 页第 Z 段记载的技术特征 Z Claim 5 is further limited by an additional technical feature recorded in Paragraph Z, Page Z in the specification on the basis of Claim 1 in the corresponding application.

ANNEX I

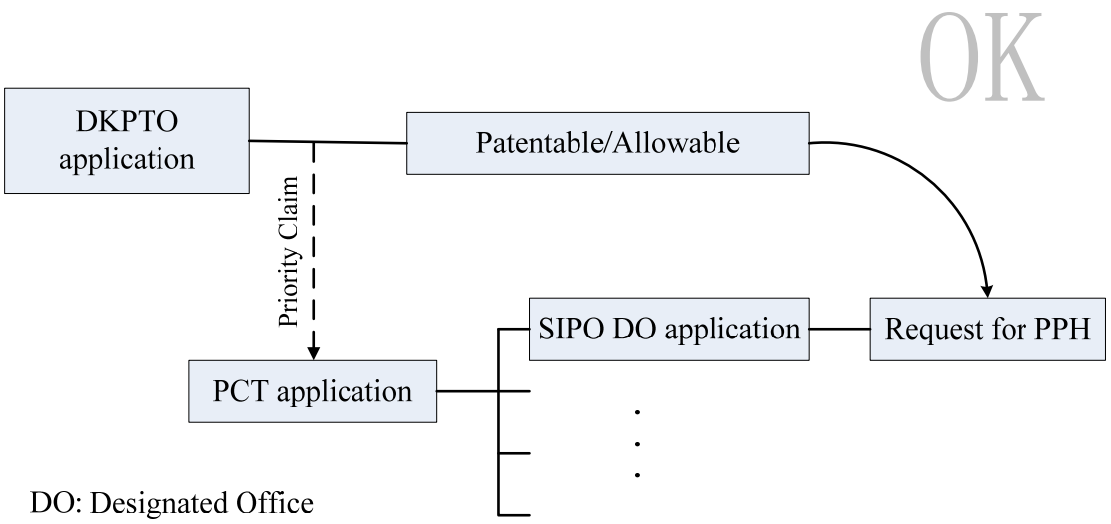
A

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



B

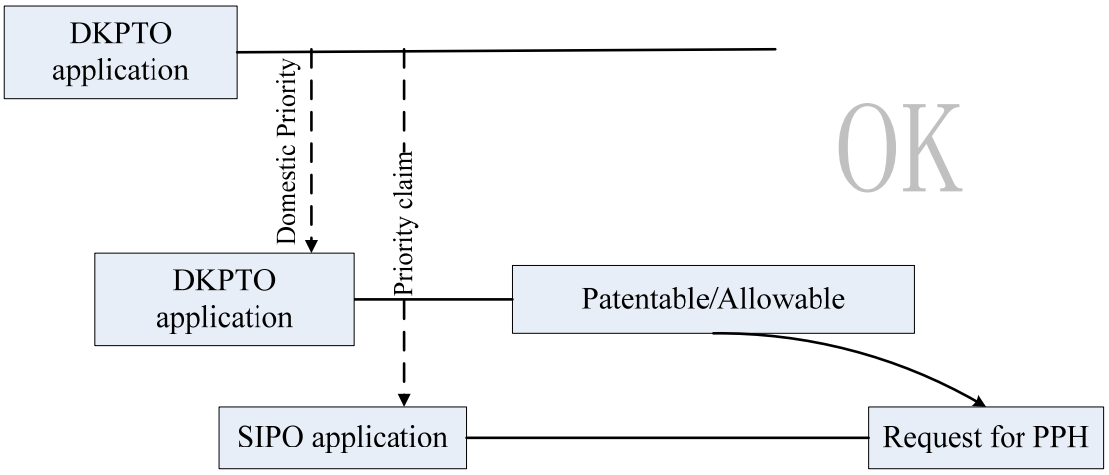
A case meeting requirement (a) (i)
- PCT route -



DO: Designated Office

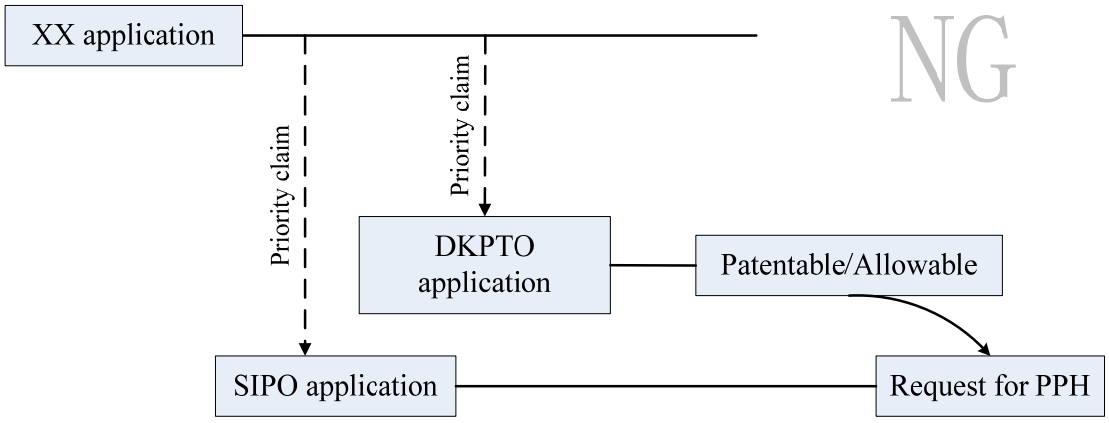
C

A case meeting requirement (a) (i)
- Paris route, Domestic priority -



D

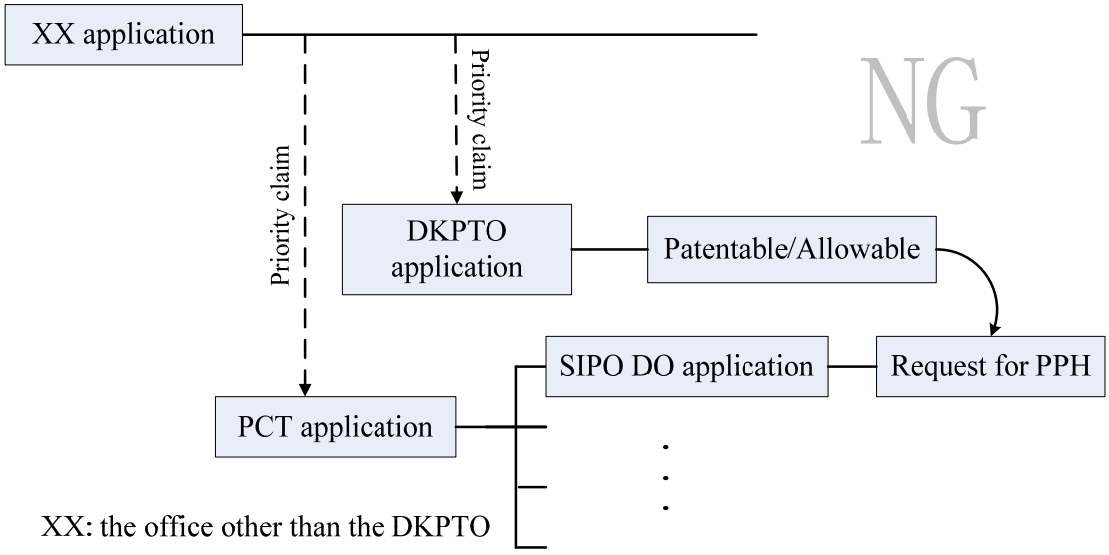
A case not meeting requirement (a)
- Paris route, but the first application is from the third country -



XX: the office other than the DKPTO

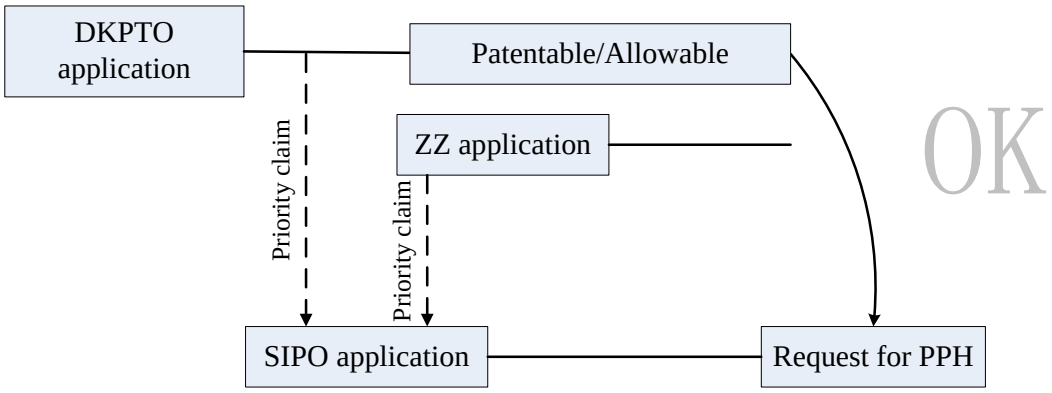
E A case not meeting requirement (a)

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



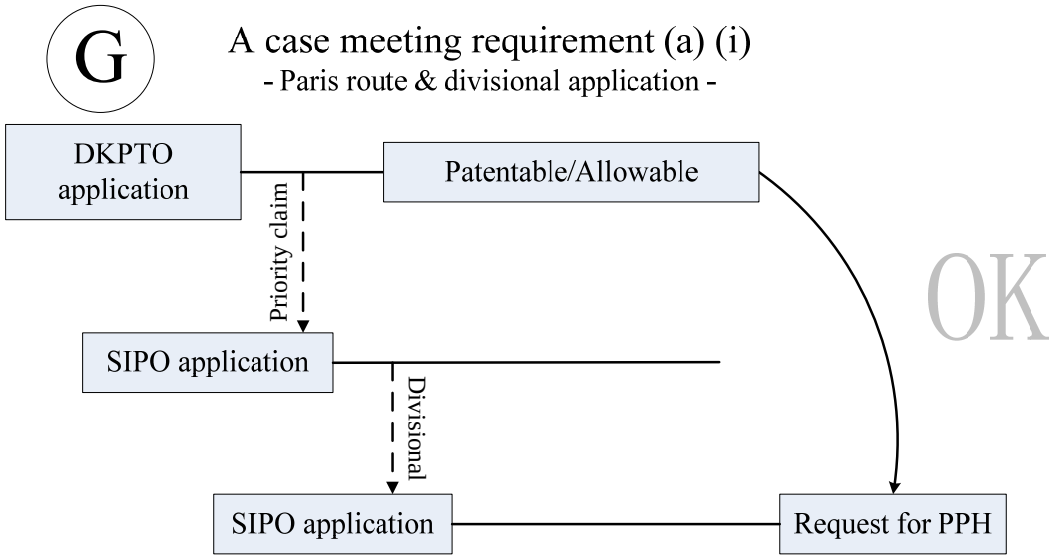
F A case meeting requirement (a) (i)

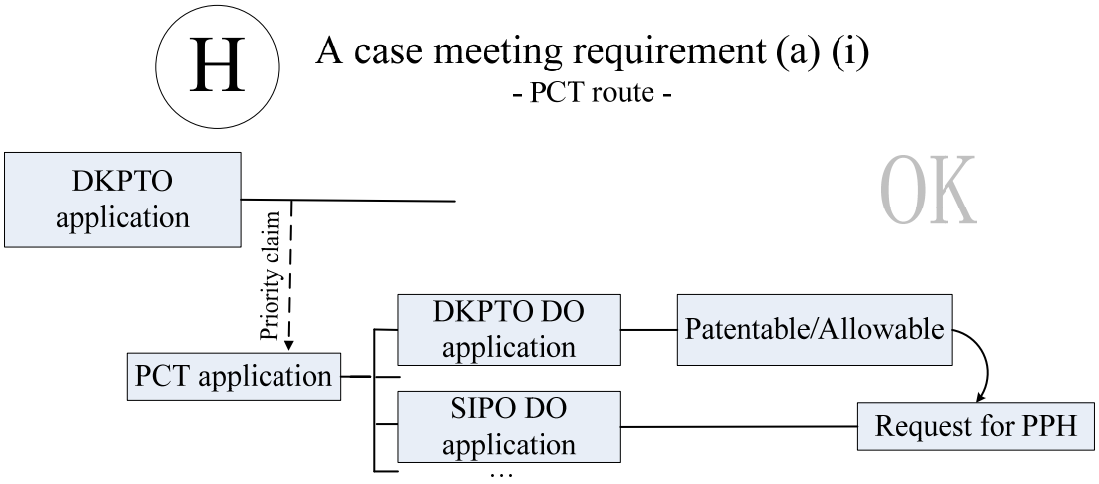
- Paris route & complex priority -



ZZ: any office

(The first application is from the DKPTO)

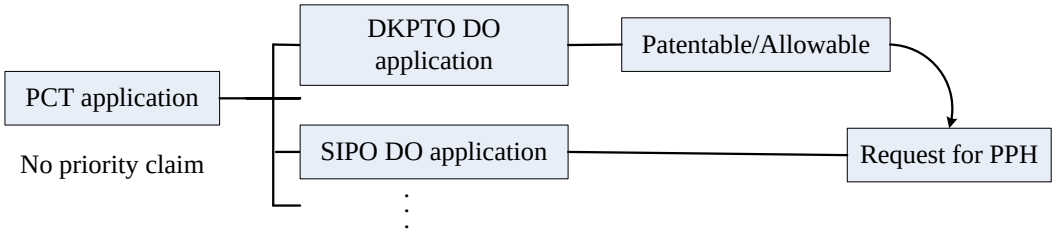

G
A case meeting requirement (a) (i)
- Paris route & divisional application -
DKPTO application
Patentable/Allowable
Priority claim
OK
SIPO application
Divisional
SIPO application
Request for PPH


H
A case meeting requirement (a) (i)
- PCT route -
DKPTO application
OK
Priority claim
DKPTO DO application
Patentable/Allowable
PCT application
SIPO DO application
Request for PPH
…

I A case meeting requirement (a) (ii)

- Direct PCT route -

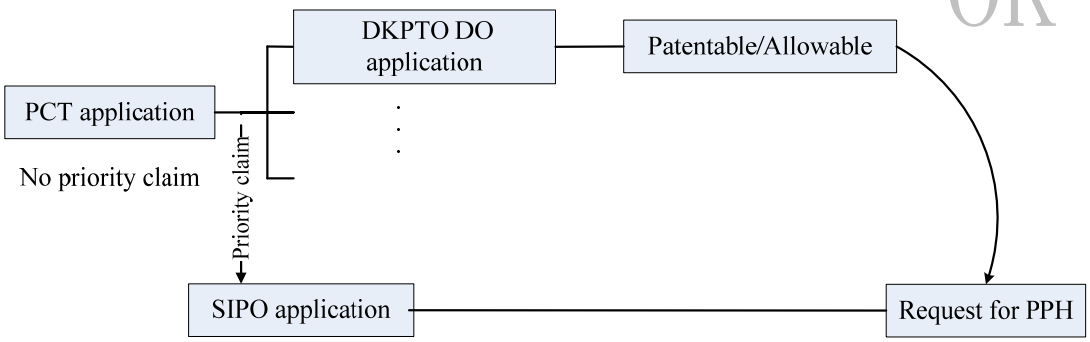
OK



J A case meeting requirement (a) (iii)

- Direct PCT & Paris route -

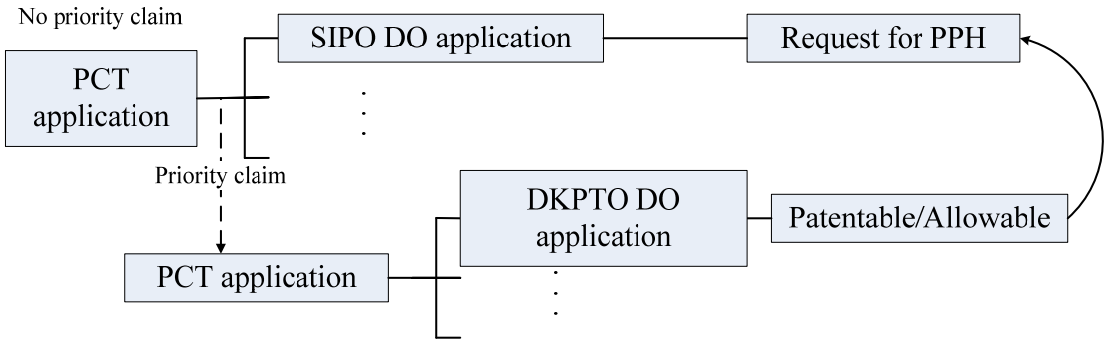
OK



K A case meeting requirement (a) (ii)

- Direct PCT & PCT route -

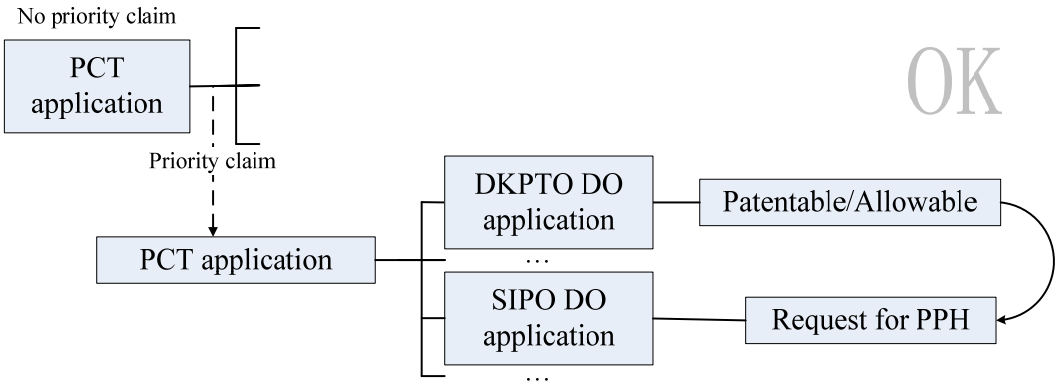
OK



L A case meeting requirement (a) (iii)

- Direct PCT & PCT route -

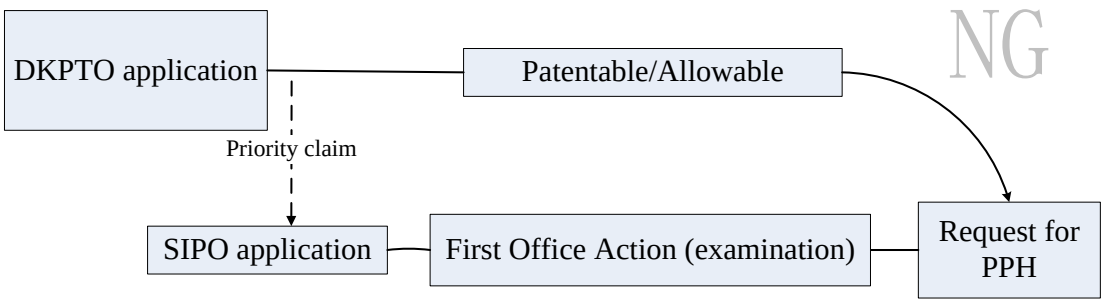
OK



M

A case not meeting requirement (f)

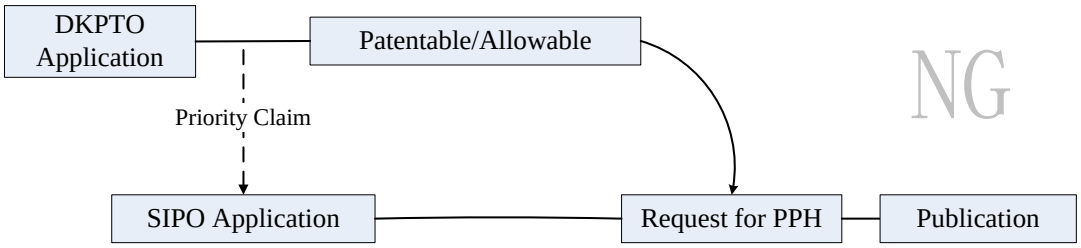
- Examination has begun before a request for PPH -



N

A case not meeting requirement (d)

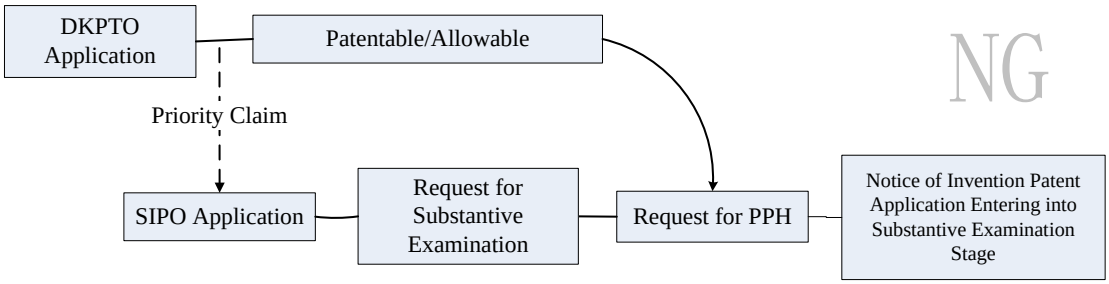
- The application has not been published at the time of request for PPH -



O

A case not meeting requirement (e)

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



P

A case meeting requirement (e) (exception)

- PPH request simultaneously with the Request for Substantive Examination -