

PPH GUIDELINES

Patent Prosecution Highway Pilot Programme between the Intellectual Property Office of Singapore and the State Intellectual Property Office of the People's Republic of China

1. Background

To obtain patent protection for an invention in several countries usually requires the invention to be searched and examined in each of the countries. If the patent authorities in these countries were to share the results of their search and/or examination with each other, the opportunity for a patent office to make reference to earlier work done could have several potential benefits:

- Reduced work – Reference to the earlier work done could reduce or even eliminate the need for subsequent search and examination work.
- Faster prosecution – The reduced work could generally lead to a faster prosecution of the patent application.
- Better search and examination – The other patent authorities might have access to databases unavailable (eg specific technical databases, local databases, databases in other languages) to the examiner, therefore the opportunity to refer to these search and examination results could provide the examiner with information on and assessment of prior art that he or she would otherwise not have access to.

2. Patent Prosecution Highway Programme

- 2.1 The Patent Prosecution Highway (PPH) programme between the Intellectual Property Office of Singapore (IPOS) and the State Intellectual Property Office of the People's Republic of China (SIPO) is one way for the two offices to share their search and examination results with each other.
- 2.2 Where IPOS is the Office of First Filing (OFF) and the Singapore application contains claims that are determined to be allowable/patentable, the applicant may request accelerated examination at the SIPO for the corresponding application filed with the SIPO as the Office of Second Filing (OSF). The requirements and procedures for filing a request with the SIPO for participation in the PPH pilot programme are available from the SIPO website at: <http://www.sipo.gov.cn/ztzl/ywzt/pph/>
- 2.3 Where the SIPO is the OFF and the China application contains claims that are determined to be allowable/patentable, the applicant may request accelerated examination of the corresponding application filed with IPOS as the OSF by furnishing certain information of the China application as set out in the requirements and procedures below. For the avoidance of doubt, the applicant is required to provide all necessary documents to IPOS, and not request that IPOS obtain documents from the SIPO.

PPH GUIDELINES

3. PPH Pilot programme Commencement

The PPH pilot programme commences on September 1, 2013 for a period of 2 years, ending on August 31, 2015.

IPOS and the SIPO will evaluate the results of the pilot programme to determine whether and how the programme should be fully implemented. The Offices may also terminate the PPH pilot programme if the volume of participation exceeds manageable level, or for any other reason. Notice will be published if the PPH pilot programme will be terminated.

4. Requirements and procedures for requesting accelerated prosecution of a Singapore patent application

4.1 Requirement 1

The following are the scenarios in which a request for accelerated examination of a Singapore application under the PPH pilot programme at IPOS can be made:

- (1) The Singapore application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from the China application being relied upon for the PPH request. **[See Diagram 1]**
- (2) The Singapore application is a divisional application of the Singapore application referred to in (1) above, and said divisional application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from the China application being relied upon for the PPH request. **[See Diagram 2]**
- (3) The Singapore application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from a China application, and the China application being relied upon for the PPH request also validly claims priority under China law from said earlier China application. **[See Diagram 3]**
- (4) The Singapore application is a divisional application of the Singapore application referred to in (3) above, and said divisional application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from a China application, and the China application being relied upon for the PPH request also validly claims priority under China law from said earlier China application. **[See Diagram 4]**
- (5) The Singapore application is a national phase entry of a PCT application, and the Singapore application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from a China national application, and it is this China national application that is being relied on for the PPH request. **[See Diagram 5]**
- (6) The Singapore application is a national phase entry of a PCT application, and the Singapore application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from a China national application. The China application being relied upon for the PPH request is a national phase entry of the same PCT application, and the China application being relied upon for the PPH request validly claims priority under China law from said China national application. **[See Diagram 6]**

PPH GUIDELINES

- (7) There is a first PCT application. There is a second PCT application validly claiming priority from the first PCT application. The Singapore application is a national phase entry of the second PCT application, and the Singapore application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from the first PCT application. The China application being relied upon for the PPH request is a national phase entry of the second PCT application, and the China application validly claims priority under China law from the first PCT application. **[See Diagram 7]**

4.2 Diagrams depicting the above scenarios are in Annex I.

4.3 **Requirement 2**

- (1) The Singapore application has not had a valid Patents Form 12A (Request for Supplementary Examination Report) filed.
- (2) The Singapore application has not had a valid Patents Form 10 (Request for Search Report or Supplementary Search Report), Patents Form 11 (Request for Search and Examination Report) or Patents Form 12 (Request for Examination Report) filed yet.
- (3) At least one corresponding application exists in the SIPO and has one or more claims that are determined to be allowable/patentable in IPOS in a substantive examination carried out by the SIPO.
- (4) All claims in the Singapore application must sufficiently correspond to the allowable/patentable claims in the China application. Claims will be considered to sufficiently correspond where, accounting for differences due to translations and claim format requirements, the claims are of the same or similar scope, or the claims are narrower in scope. In this regard, a claim that is narrower in scope occurs when a claim in the Singapore application is amended to be further limited by an additional technical feature that is supported in the specification.

4.4 **The Procedures**

- (1) File duly completed Patents Form 11 (Request for Search and Examination Report) or Patents Form 12 (Request for Examination Report). These forms can be found at:
<http://www.ipos.gov.sg/Services/FilingandRegistration/FormsandFees/Patents.aspx>
- (2) The Patents Form 11 (Request for Search and Examination Report) or Patents Form 12 (Request for Examination Report) must be accompanied by:
 - (a) a copy of all office actions of the China application being relied upon;
 - (b) a copy of the allowable/patentable patent claims referred to in (2)(a) above; and
 - (c) a claims correspondence table showing the relatedness of the allowable/patentable claims referred to in (2)(a) above to the claims in the current Singapore application. The format of the Claims Correspondence Table is found in Annex II.

PPH GUIDELINES

- (3) For avoidance of doubt, a copy of the patent grant without the documents listed in (2)(a), (b) and (c) above will not qualify for the PPH.
- (4) If the forms are submitted electronically (whether online or on electronic media), the phrase "IPOS-SIPO PPH acceleration requested" must be inserted in the "Remarks" box of the forms.
- (5) If the forms are submitted on paper via the Service Bureau, a cover letter must be submitted with the forms. The cover letter must contain in its title, the phrase "IPOS-SIPO PPH acceleration requested".
- (6) All subsequent correspondences with IPOS must be similarly marked with the phrase "IPOS-SIPO PPH acceleration requested".

4.5 **Cited Documents**

A copy of each of the documents cited in the documents submitted under paragraph 4.4 (2)(a) is not required at the time of filing the PPH request. IPOS may, however, require the applicant to furnish a copy of any document cited subsequently.

4.6 **Translations**

- (1) The documents in paragraph 4.4 must be accompanied by an English translation if they are not originally in English, at the time of filing the PPH request.
- (2) The documents in paragraph 4.5 may be filed in their original language. However, IPOS may subsequently request for an English translation of a document or a part of a document if an English abstract of the cited document is not available.
- (3) If it is not possible for IPOS to understand the English translation of any document, IPOS can request the applicant to resubmit the English translation of that document.

4.7 Singapore applications which request accelerated prosecution under the PPH pilot programme will be processed in accordance with the Singapore Patents Act (Cap. 221) and the Singapore Patents Rules. The legislations can be found at: <http://www.ipos.gov.sg/topNav/leg/Statutory+Acts.htm>.

4.8 Applicants should seek professional advice on patent matters in Singapore, in particular, with reference to section 30 (Grant of patent) and section 69 (Restrictions on relief for infringement) of the Singapore Patents Act (Cap. 221).

5. **Enquiries**

For enquiries relating to the Patent Prosecution Highway pilot programme between IPOS and the SIPO, please contact Ms Linda Bernadatte Mitchell of IPOS via telephone (65) 63308 609 or email linda_bernadatte_mitchell@ipos.gov.sg with the subject heading "IPOS-SIPO PPH".

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

Annex I

Diagrams of SG applications that fall under Scenario (1):

Diagram 1: The Singapore application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from the China application being relied upon for the PPH request.

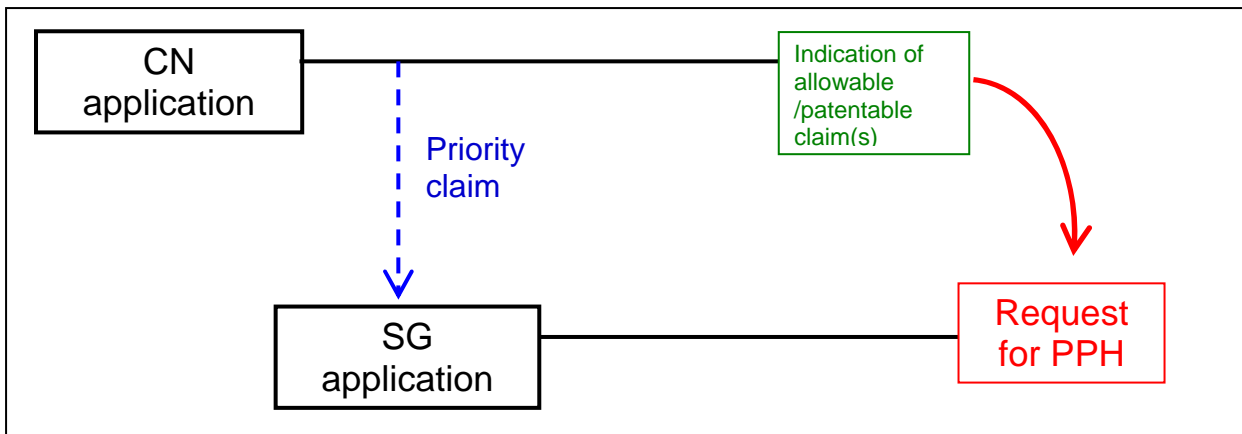
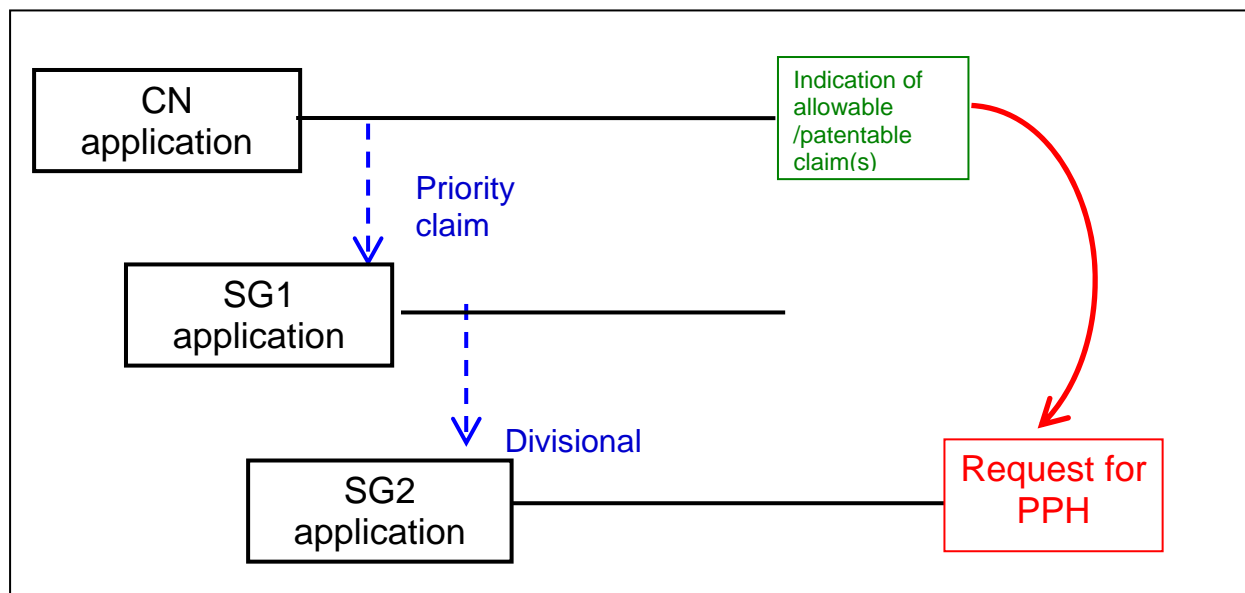


Diagram of SG applications that fall under Scenario (2):

Diagram 2: The Singapore application is a divisional application of the Singapore application referred to in (1) above, and said divisional application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from the China application being relied upon for the PPH request.



PPH GUIDELINES

Diagram of SG applications that fall under Scenario (3):

Diagram 3: The Singapore application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from a China application, and the China application being relied upon for the PPH request also validly claims priority under China law from said earlier China application.

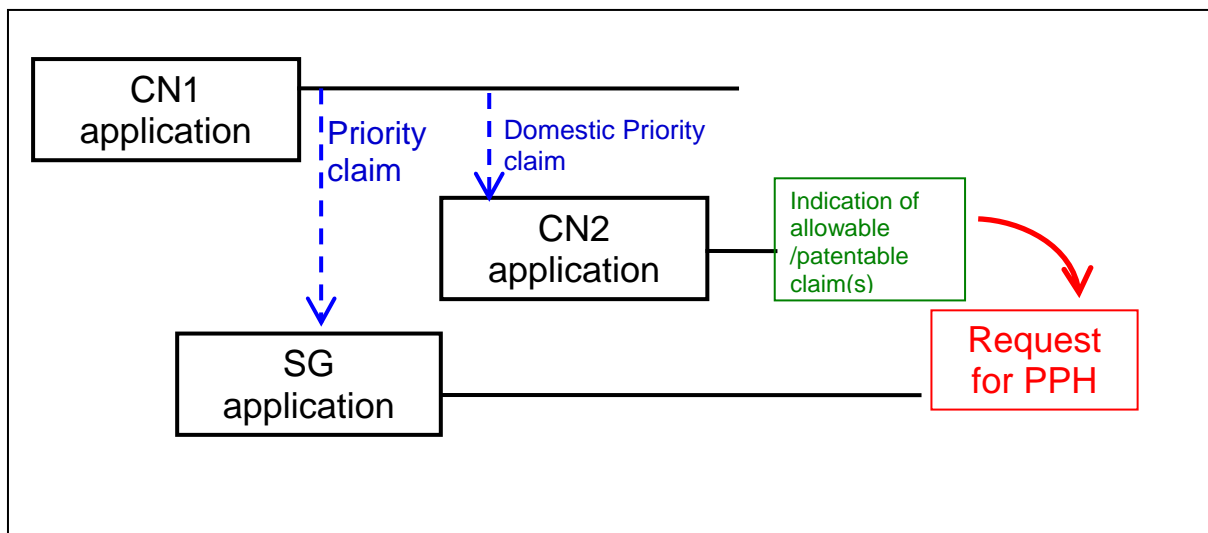
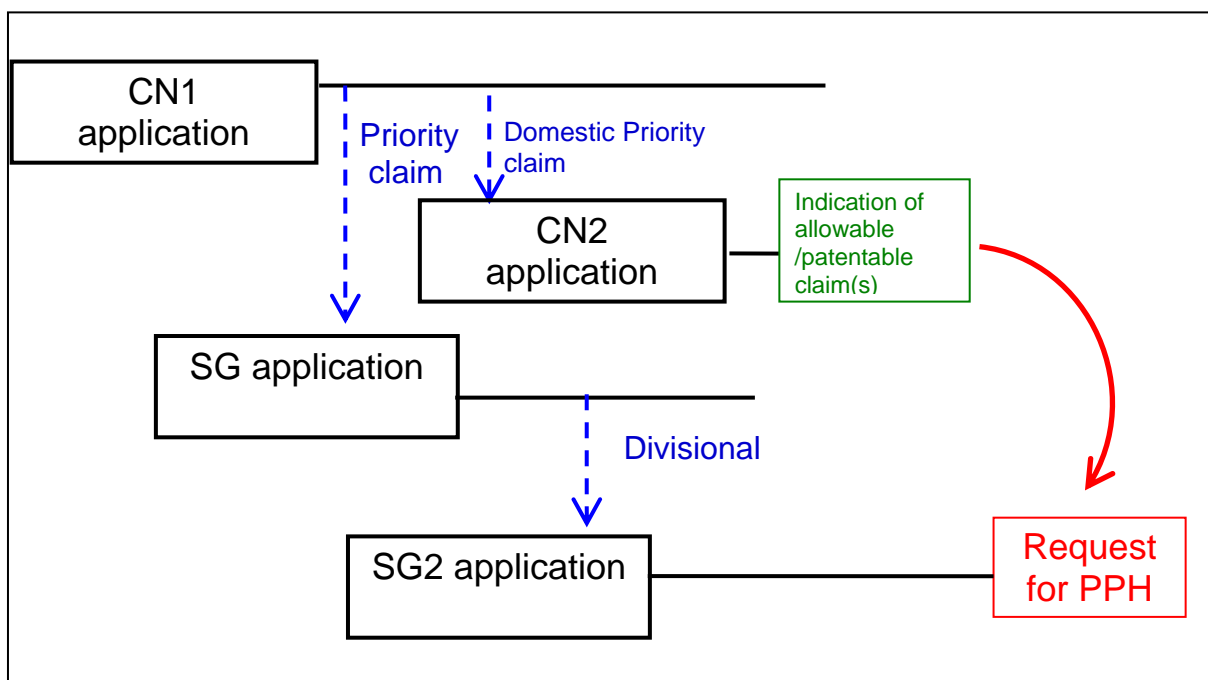


Diagram of SG applications that fall under Scenario (4):

Diagram 4: The Singapore application is a divisional application of the Singapore application referred to in (3) above, and said divisional application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from a China application, and the China application being relied upon for the PPH request also validly claims priority under China law from said earlier China application.



PPH GUIDELINES

Diagram of SG applications that fall under Scenario (5):

Diagram 5: The Singapore application is a national phase entry of a PCT application, and the Singapore application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from a China national application, and it is this China national application that is being relied on for the PPH request.

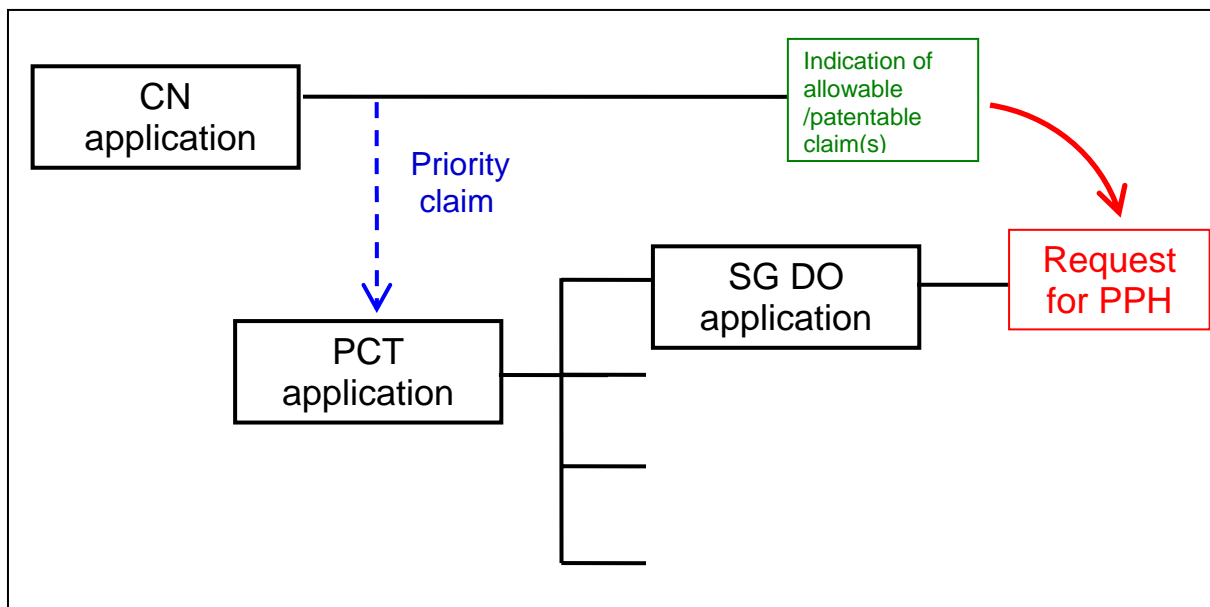
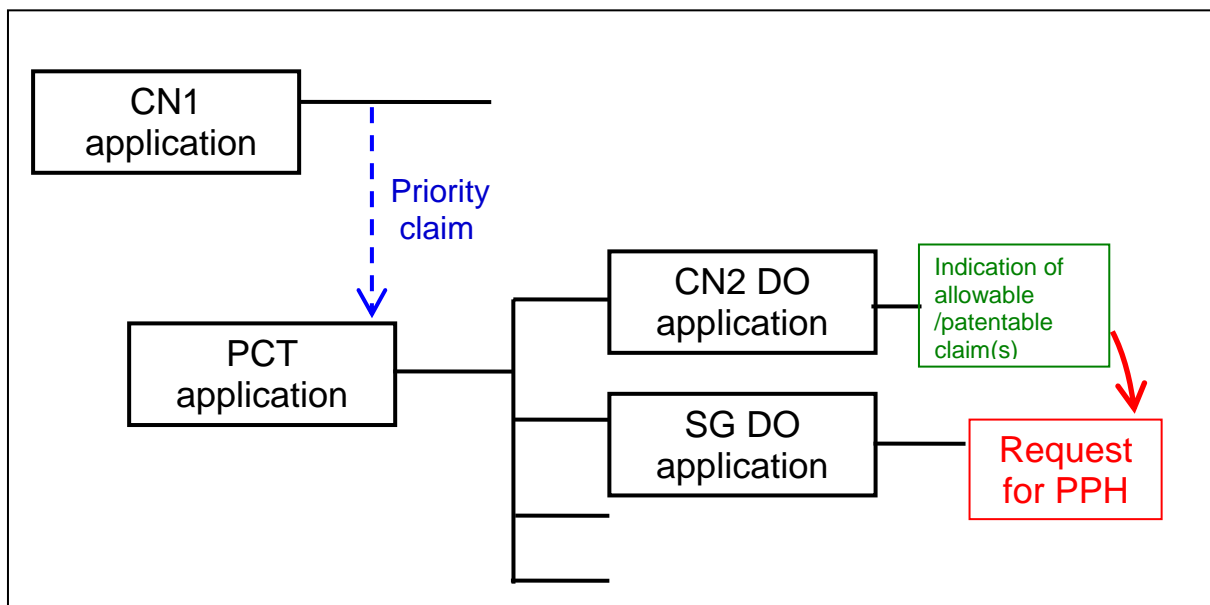


Diagram of SG applications that fall under Scenario (6):

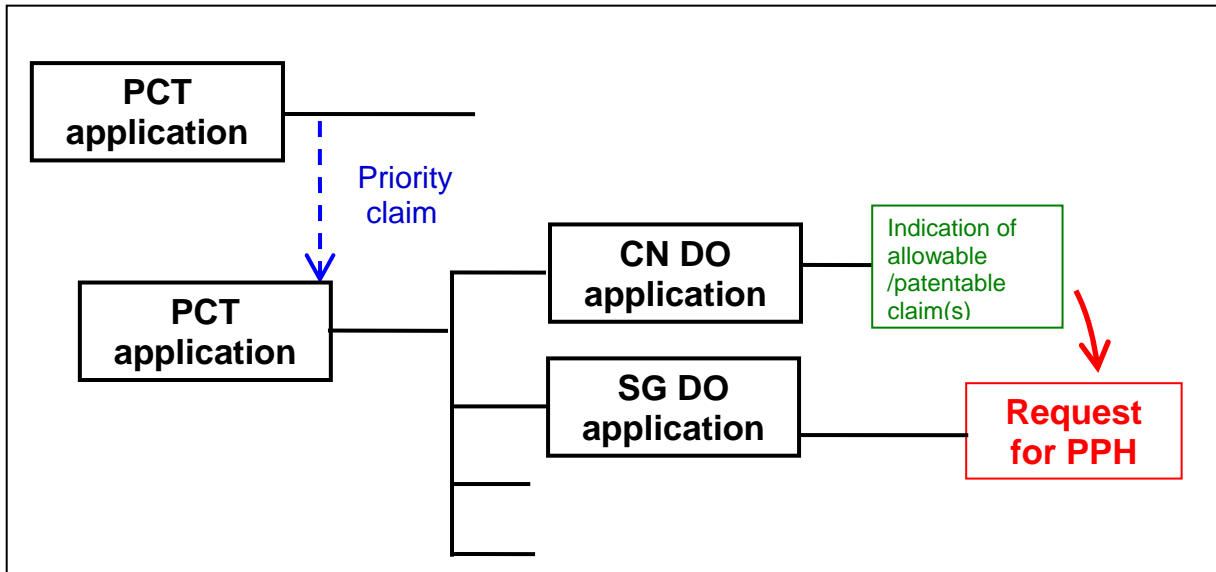
Diagram 6: The Singapore application is a national phase entry of a PCT application, and the Singapore application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from a China national application. The China application being relied upon for the PPH request is a national phase entry of the same PCT application, and the China application being relied upon for the PPH request validly claims priority under China law from said China national application.



PPH GUIDELINES

Diagram of SG applications that fall under Scenario (7):

Diagram 7: There is a first PCT application. There is a second PCT application validly claiming priority from the first PCT application. The Singapore application is a national phase entry of the second PCT application, and the Singapore application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from the first PCT application. The China application being relied upon for the PPH request is a national phase entry of the second PCT application, and the China application validly claims priority under China law from the first PCT application.



PPH GUIDELINES

Annex II

Claim Correspondence Table (Patent Prosecution Highway)

CORRESPONDING APPLICATION NUMBER	
---	--

CLAIMS IN SG APPLICATION¹	EXAMINED CLAIMS IN CORRESPONDING CN APPLICATION²	EXPLANATION REGARDING THE CORRESPONDENCE

Sheet/....

All the claims in the SG application sufficiently correspond to the patentable/allowable claims in the CN application.

¹ Please indicate the claim number relating to a claim in the current application which corresponds to the allowable/patentable claim in the corresponding application.
² Please indicate the claim number relating to a claim that has been determined to be allowable/patentable.