



SIPO

PATENT PROSECUTION HIGHWAY (PPH)

BETWEEN THE

PORTUGUESE INSTITUTE OF INDUSTRIAL PROPERTY (INPI)

AND THE

STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC
OF CHINA (SIPO)

**REQUIREMENTS AND PROCEDURES TO FILE A PPH
REQUEST AT INPI**

2013

Procedures to file a request at INPI for the Patent Prosecution Highway Pilot Program between the INPI Portuguese Institute of Industrial Property (INPI) and the State Intellectual Property Office of the People's Republic of China (SIPO)

The PPH is a bilateral mechanism that allows sharing search tasks and examination results associated to patent applications between INPI and SIPO, whose main purpose is to provide a faster decision-making process of a patent application.

The purpose of these guidelines is to define the necessary conditions to file a request, for accelerated examination under the Patent Prosecution Highway (PPH), at INPI. The patent application, subjected to the accelerated examination procedure under the PPH, must comply with the Portuguese legislation, namely the fact that the Patent application must be in Portuguese as stated in the Portuguese Law.

The pilot period of this PPH pilot program will commence on January 1, 2014 for a duration of two years and ending on December 31, 2015. The pilot period may be extended if necessary until the INPI and SIPO receive the sufficient number of PPH requests to adequately assess the feasibility of PPH program.

The Offices may terminate the PPH pilot program if the volume of participation exceeds a manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.

Part I - PPH using national work products from the SIPO

Request at INPI

[0001] An applicant should file a request for accelerated examination under the PPH at INPI by submitting an application requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for this request are given in the next section. Relevant supporting documentation and the procedure for accelerated examination under the PPH at INPI are discussed in a latter section (paragraphs [0003] to [0006]).

Requirements for requesting an accelerated examination under the PPH Pilot Program at INPI

[0002] There are three requirements for requesting accelerated examination under the PPH pilot program at INPI, namely:

- a) Either:
 - i) INPI's application claims a valid priority under the Paris Convention from at least one corresponding SIPO's application (see figures A, B, C in Annex 1); or
 - ii) INPI's application is the national phase of a PCT application which has no priority claims (see figure D in Annex 1), or
 - iii) INPI's application is the national phase of a PCT application which claims a valid priority from at least one SIPO national application (see figures E and F in Annex 1), or
 - iv) INPI's application claims a valid priority from at least one PCT application which has no priority claims (see figure G in Annex 1), or
 - v) INPI's application is the national phase of a PCT application which claims a valid priority from at least one PCT application which has no priority claims (see figures H and I in Annex 1), or
 - vi) INPI's application is a divisional application of any of the above (see figure J in Annex 1).

- b) At least one corresponding SIPO's application has one or more claims that are determined to be patentable/allowable by the SIPO.

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 is not granted for patent yet.

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 patentable” in the following circumstances: If the SIPO office action does not explicitly 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 SIPO office action regarding that claim, and therefore, the claim is deemed to be patentable by the SIPO.

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 SIPO, those claims may be deemed to be implicitly identified to be patentable and then the applicant must include the above explanation.

- c) All claims in INPI’s application must sufficiently correspond to one or more claims indicated as patentable/allowable by the SIPO in order that INPI’s application qualifies for accelerated examination under the PPH.

Claims are considered to ‘sufficiently correspond’ when, considering differences due to translations and claim format, claims of the application have the same or similar scope as the claims indicated to be patentable/allowable in the SIPO’s application, or claims of the application are narrower in scope than the claims indicated to be patentable/allowable in the SIPO’s application.

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

A claim of the application which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the SIPO’s application is not considered to sufficiently correspond. For example, if claims indicated to be patentable/allowable in the SIPO’s application only claim a process of manufacturing a product, then the claims of the INPI’s application are not

considered to sufficiently correspond if it introduces product claims that are dependent on the corresponding process claims.

Any claims amended or added after accepting the request for participation in the PPH Pilot Program don't need to sufficiently correspond to the claims indicated as patentable/allowable in the SIPO's application.

- d) INPI has not yet begun the examination of the application at the time of request for the PPH.

Required documents for accelerated examination under the PPH Pilot Program at INPI

[0003] The following documentation will be needed to support a request for accelerated examination under the PPH pilot program at the INPI:

- a) a copy of all office actions produced by SIPO (which are relevant to patentability) in the corresponding SIPO's application(s), and their Portuguese or English¹ translations. Office actions are documents which relate to substantive examination and which were sent to the applicant by the SIPO examiner.
The applicant does not have to submit a copy of SIPO's office actions when the office actions are provided via SIPO's dossier access system². If the office actions and their translations cannot be obtained by the INPI's examiner through this system, the applicant may be notified and requested to provide the necessary documents.
- b) a copy of the claims found to be patentable/allowable by the SIPO, and their Portuguese or English³ translations. The applicant can either provide these with the request for acceleration under the PPH or request that the INPI obtain the documents required through the SIPO's database, if they are publicly available⁴.

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 examiner can request the applicant to resubmit translations.

² <http://cpquery.sipo.gov.cn/>

³ 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.

⁴ <http://cpquery.sipo.gov.cn/>

The applicant does not have to submit a copy of claims indicated to be allowable/ patentable in the SIPO when the claims are provided via SIPO's dossier access system. If the claims and their translation cannot be obtained by the INPI's examiner through that system, the applicant may be notified and requested to provide the necessary documents.

- c) a complete claims correspondence table showing the relationship between the claims of INPI's application for accelerated examination under the PPH and the claims of the corresponding SIPO's application considered patentable/allowable by the SIPO. Sufficient correspondence of claims occurs when claims satisfy requirement in paragraph [0002] c.

The claims correspondence table must indicate how the claims in INPI's application correspond to the patentable/allowable claims in the SIPO's application. The claims correspondence table must be written in Portuguese or English.

- d) copies of the references cited by the SIPO examiner. If the references are patent documents, it will not be necessary to submit these documents, as they are usually available to INPI. If however INPI has difficulty in obtaining the document, the applicant will be asked to submit it. Non-patent literature must always be submitted. The translations of the references are unnecessary.

[0004] Relevant information is obtained from the applicant by filling out a form for requesting accelerated examination under the PPH Pilot Program which is available in INPI's web site⁵. The relevant supporting documentation should be attached.

[0005] The applicant need not to provide further copies of documentation if they have already been submitted to the INPI through simultaneous or past procedures.

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

[0006] The applicant fills out the form requesting accelerated examination under the PPH Pilot Program available in INPI's web page and includes all the relevant

⁵ <http://www.marcaspatentes.pt>

supporting documents. The PPH Administrator, who will be an INPI's patent examiner, will consider the request. If any of the requirements for accelerated examination under the PPH have not been met, the PPH Administrator will notify the applicant that the application has not been allowed to enter in the PPH and will provide an explanation as to why entry onto the PPH was not possible.

If the request for accelerated examination is not accepted, the applicant will be notified that the application will await action in its regular turn.

The applicant is free to take any possible correcting action and again request acceleration under the PPH.

When all requirements for accelerated examination under the PPH have been met, the PPH Administrator will notify the applicant that the application has been allowed to enter in the PPH. The PPH Administrator will inform the relevant examining group that the application has qualified to enter in the PPH and the designated examiner will then conduct an accelerated examination of the application.

Other dispositions

These Guidelines may be modified at any time, by mutual agreement between the INPI and SIPO, after a modification request made in writing by one of the Offices.

Part II - PPH using the PCT international work products from the SIPO

Request at INPI

[0001] An applicant can request accelerated examination of an application filed at INPI and satisfies all the requirements under the INPI-SIPO Patent Prosecution Highway Pilot Program based on PCT international work products (PCT-PPH Pilot Program).

Requirements for requesting an accelerated examination under the PCT-PPH Pilot Program at INPI

[0002] The application which is filed at INPI and in which the applicant files a request under the PCT-PPH must satisfy the following requirements:

- a) The latest work product in the international phase of a PCT application corresponding to the application ('international work product'), namely Written Opinion of International Search Authority (WO/ISA), Written Opinion of International Examination Authority (WO/IPEA) or Preliminary Examination Report (IPER), indicates that at least one claim is patentable/allowable.

Note that ISA and IPEA which produce WO/ISA, WO/IPEA and IPER are limited to SIPO, but if priority is claimed it can be referred to an application in any Office (see example A' in Annex 2: Application ZZ can be any national application). The applicant cannot file a request under PCT-PPH based on an International Search Report (ISR) only.

If an 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 the fact that an amendment is submitted to correct the observation made in Box VIII. The application will not be eligible for participating in the 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 will not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation in Box VIII.

- b) the relationship between the application and the corresponding international application satisfies one of the following requirements:
- i) the application is a national phase application of the corresponding international application (see figures A, A' and A" in Annex 2);
 - ii) the application is a national application as a basis of the priority claim of the corresponding international application (see figure B in Annex 2);
 - iii) the application is a national phase application of an international application claiming priority of the corresponding international application (see figure C in Annex 2);
 - iv) the application is a national application claiming priority of the corresponding international application (see figure D in Annex 2);
 - v) the application derives from (divisional application, etc) an application which satisfies one of the above requirements (i)-(iv) (see figure E in Annex 2).
- c) all claims, as originally filed or as amended, on file for examination under the PCT-PPH, must sufficiently correspond to one or more of those claims indicated to be patentable/allowable by the SIPO as ISA/IPEA.

Claims are considered to 'sufficiently correspond' in INPI when, considering differences due to translations and claim format, are of the same or similar scope as claims indicated to be patentable/allowable in the latest international work product, or claims in INPI are narrower in scope than claims indicated to be patentable/allowable in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated to be patentable/allowable in the latest international work product is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims) of the application.

A claim in INPI which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the latest international work product is not considered to sufficiently correspond. For example, if claims indicated to be patentable/allowable in the latest international work product only claim a process of manufacturing a product, then claims in INPI are not

considered to sufficiently correspond if it introduces product claims that are dependent on the corresponding process claims.

Any claims amended or added after accepting the request for participation in the PCT-PPH Pilot Program need not to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product.

- d) INPI has not yet begun the examination of the application at the time of request for the PPH.

Required documents for accelerated examination under the PCT-PPH Pilot Program at the INPI

[0003] The following documentation will be needed to support a request for accelerated examination under the PCT-PPH Pilot Program at INPI:

- a) a copy of the latest international work product which indicated the claims to be patentable/allowable and their Portuguese or English⁶ translations.

In case the application satisfies the relationship [0002](b) i), the applicant does not need to submit a copy of the International Preliminary Report on Patentability (IPRP) or any English translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via 'PATENTSCOPE®', the applicant need not to submit these documents, unless otherwise requested by INPI.

(WO/ISA and IPER are usually available as 'IPRP Chapter I' and 'IPRP Chapter II' respectively within 30 months after the priority date).

- b) a copy of the set of claims indicated as being patentable/allowable in the latest international work product of the corresponding international application, as well as their Portuguese or English⁷ translations.

^{6/7} 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.

If a copy of the set of claims indicated as being patentable/allowable is available via 'PATENTSCOPE®'⁸, e.g. if the international Patent Gazette has been published, the applicant need not to submit this document, unless otherwise requested by INPI. Where the set of claims is written in Chinese, the translation thereof must be still submitted by the applicant.

- c) a copy of the references cited in the latest international work product of the corresponding international application.

If the reference is a patent document, the applicant is not required to submit it. However, if INPI has difficulty in obtaining this document, the applicant may be asked to submit it. Non-patent literature must always be submitted. The translations of the references are unnecessary.

- d) a complete claim correspondence table showing the relationship between the claims in INPI's application for accelerated examination under the PCT-PPH and the claims indicated to be patentable/allowable.

When claims are just a literal translation, the applicant can just write down 'they are the same' in the table. When claims are not a literal translation, it is necessary to explain the sufficient correspondence of each claim based on the criteria [0002](c). The claim correspondence table must be written in Portuguese or English.

[0004] When the applicant has already submitted the above mentioned documents (a)-(d) to INPI through simultaneous or past procedures, he may incorporate the documents by reference and is thus not required to attach the documents.

Procedure for accelerated examination under the PCT-PPH Pilot Program at INPI

[0005] The applicant fills out the form requesting accelerated examination under the

⁸ <http://www.wipo.int/pctdb/en/search-adv.jsp>

Requirements and procedures to file a PPH request at INPI

PCT-PPH Pilot Program available on INPI's web page and includes all the relevant supporting documents. The PCT-PPH Administrator, who will be an INPI's patent examiner, will consider the request. When all requirements for accelerated examination under the PCT-PPH have not been met, the PCT-PPH Administrator will notify the applicant that the application has not been allowed to enter in the PCT-PPH and will provide an explanation as to why entry onto the PCT-PPH was not possible.

If the request for accelerated examination is not accepted, the applicant will be notified that the application will await action in its regular turn.

The applicant is free to take any possible correcting action and again request acceleration under the PCT-PPH.

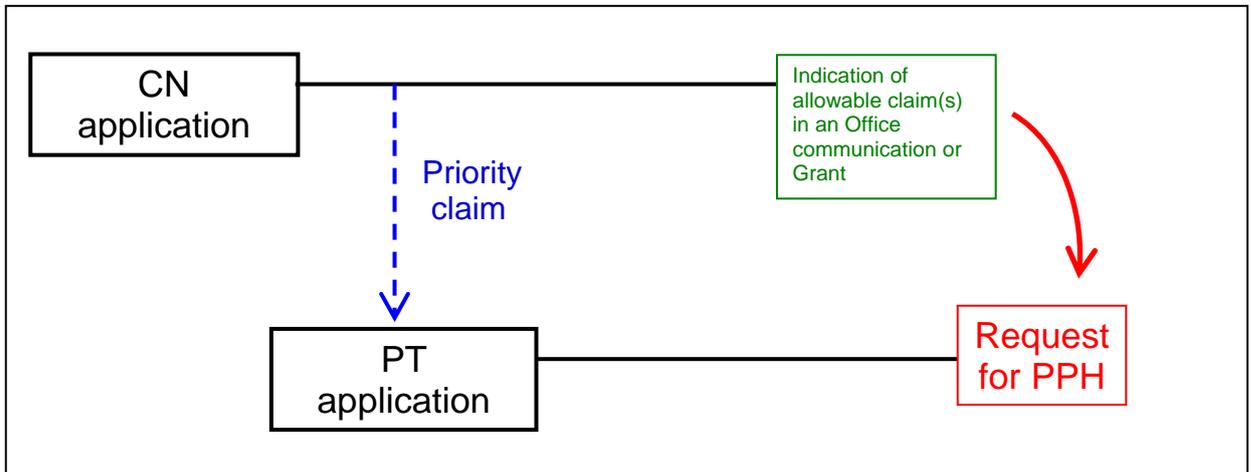
When all requirements for accelerated examination under the PCT-PPH have been met, the PCT-PPH Administrator will notify the applicant that the application has been allowed to enter in the PCT-PPH. The PCT-PPH Administrator will inform the relevant examining group that the application has qualified to enter in the PCT-PPH and the designated examiner will then conduct an accelerated examination of the application.

Other dispositions

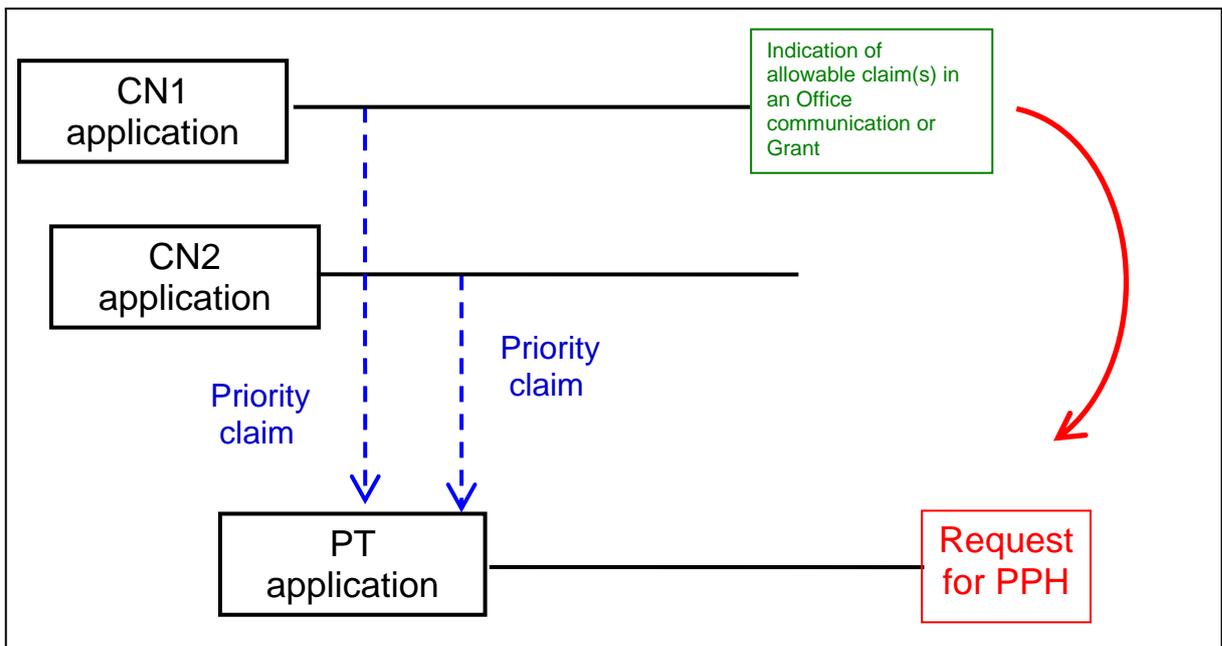
These Guidelines may be modified at any time, by mutual agreement between INPI and SIPO, after a modification request made in writing by one of the Offices.

ANNEX 1

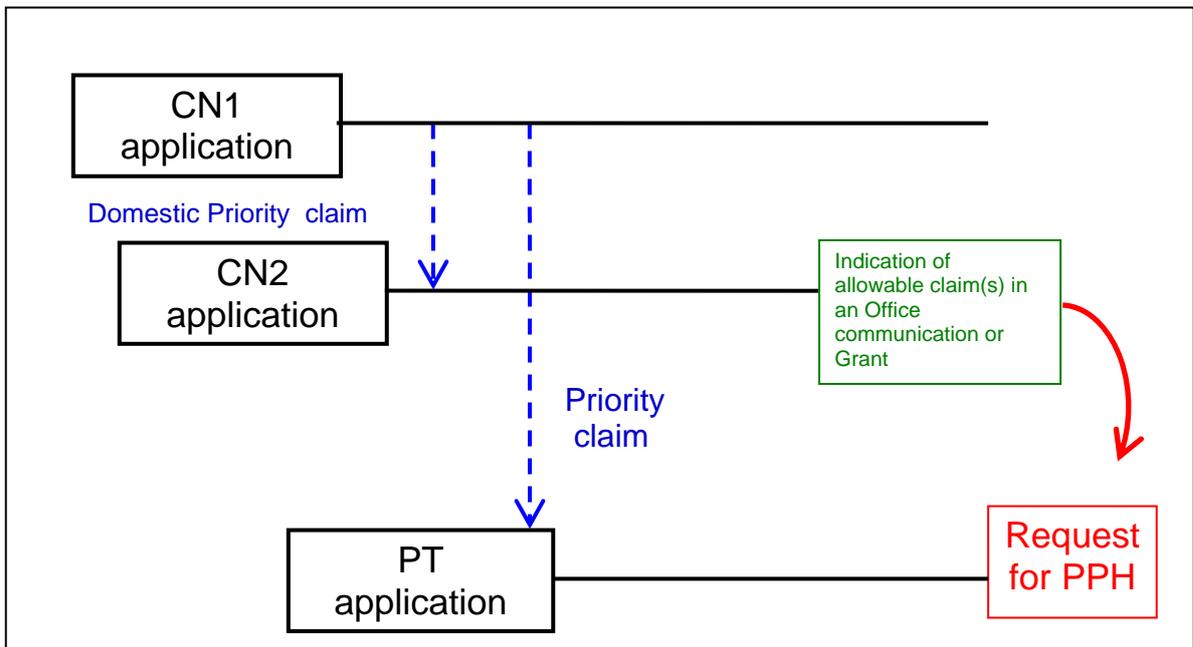
(A) PT application with a Paris Convention priority claim from an application filed in CN



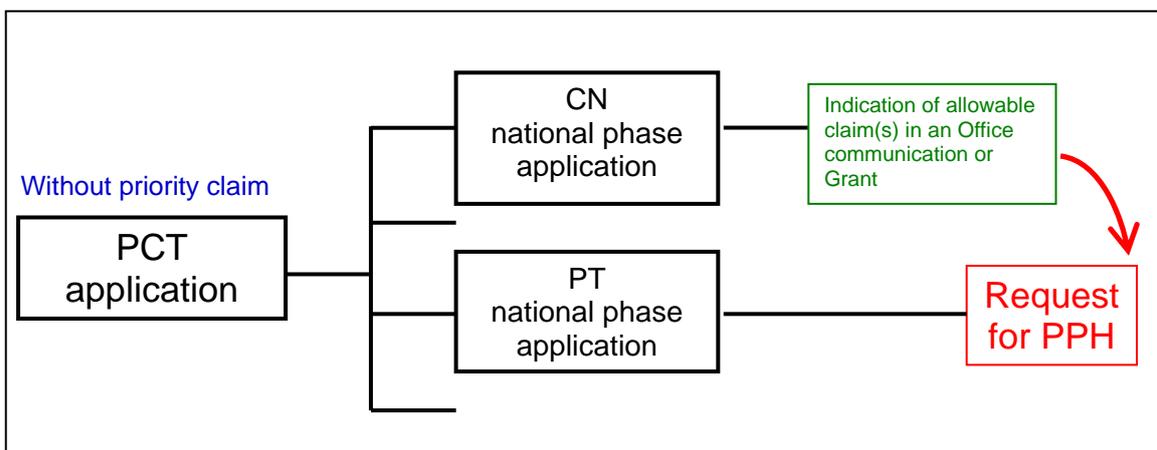
(B) PT application with multiple Paris Convention priorities



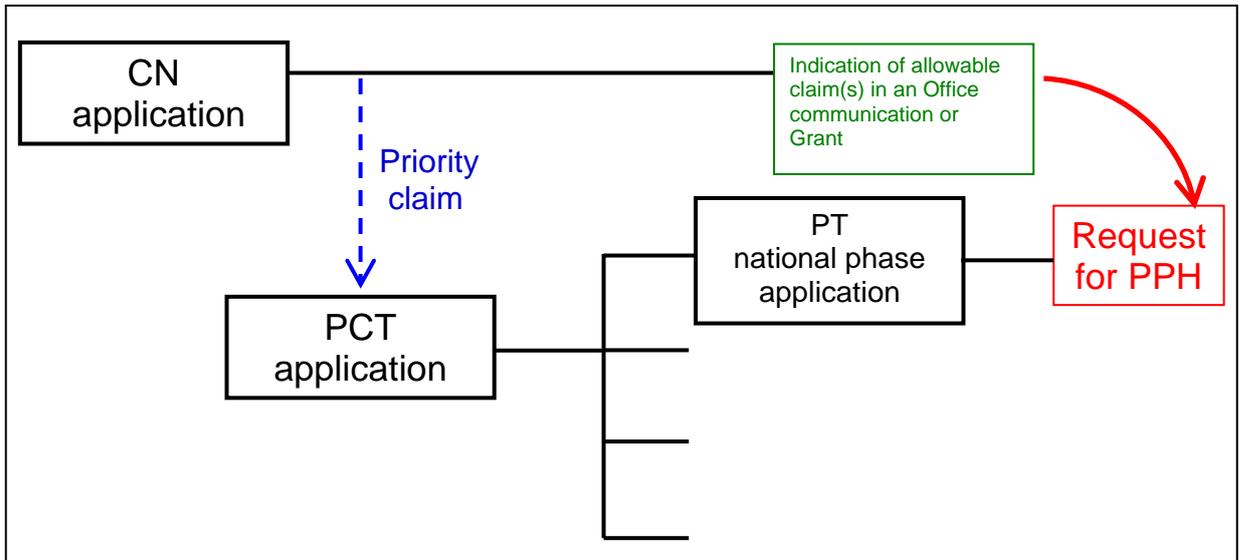
(C) Paris route and domestic priorities



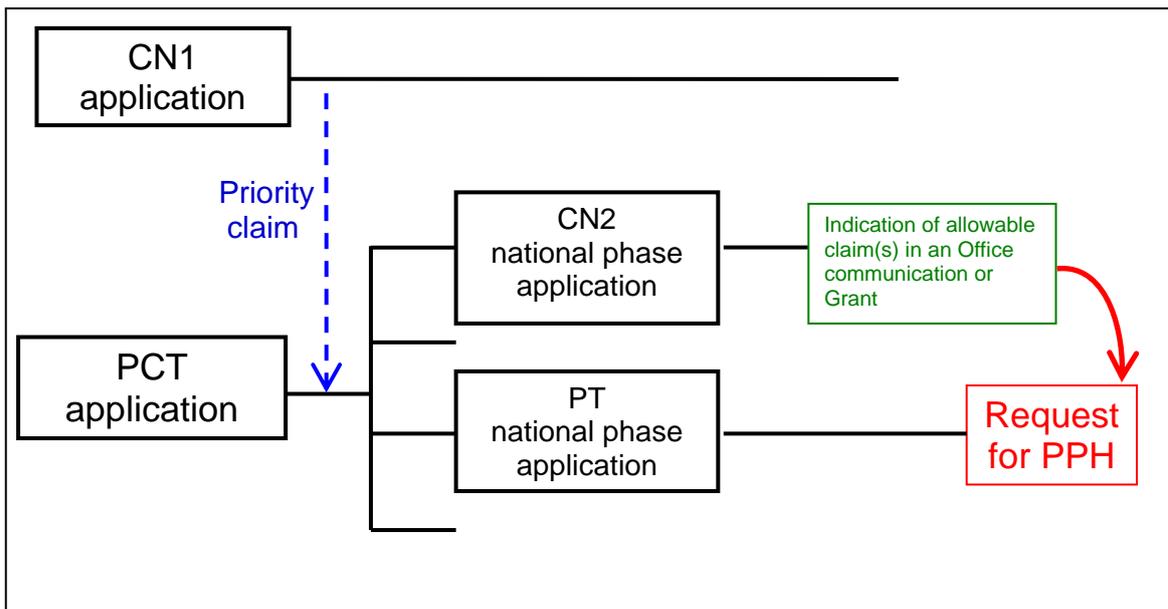
(D) PT application is a national phase of a PCT application without priority claim



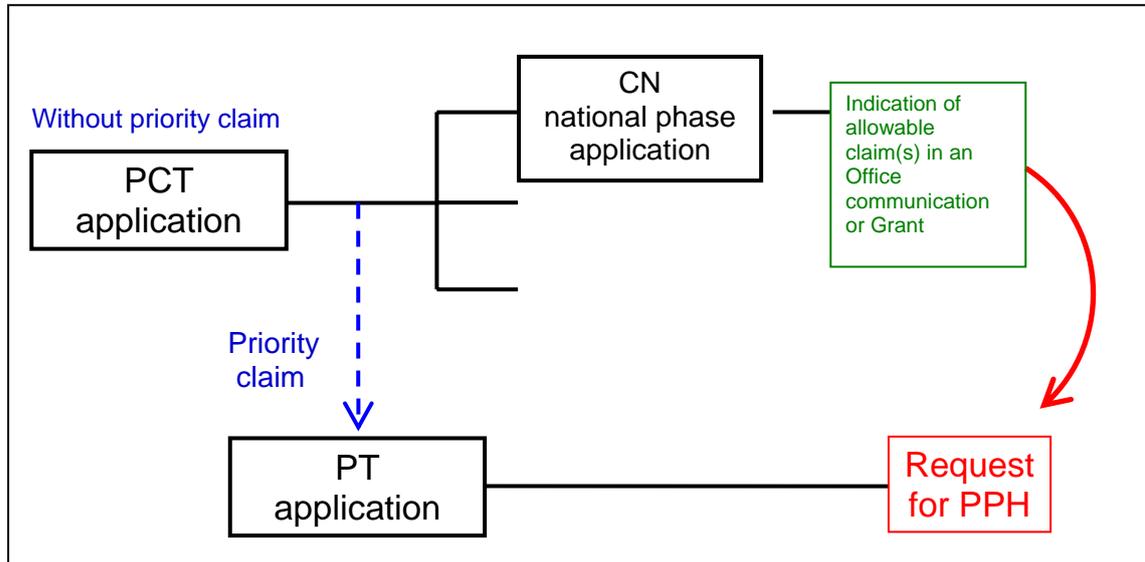
(E) PT application is a national phase of a PCT application which claims Paris Convention priority from a CN application



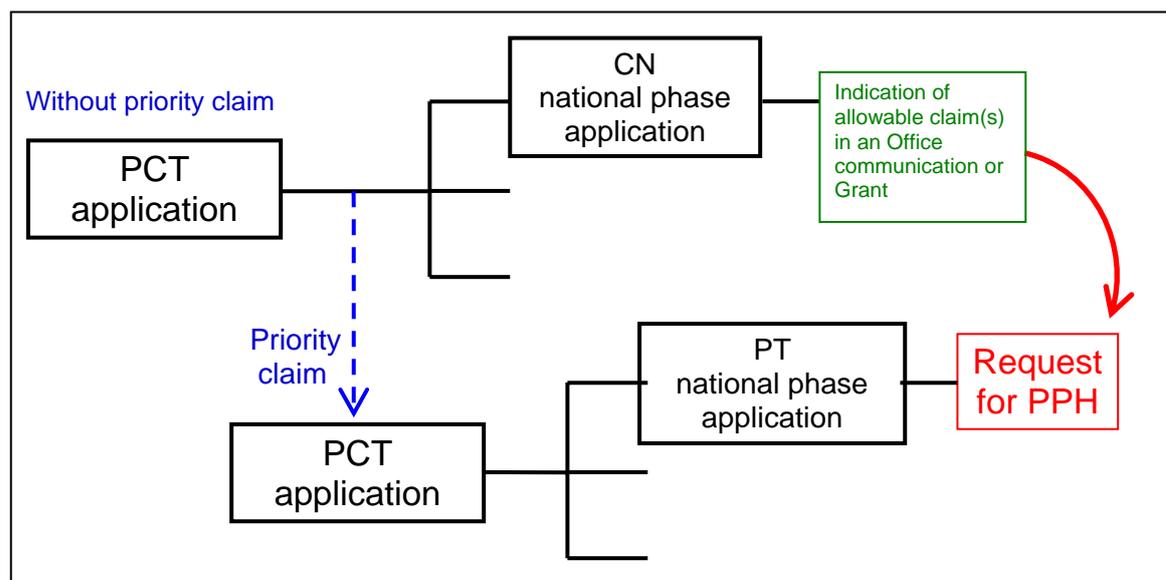
(F) PCT Route



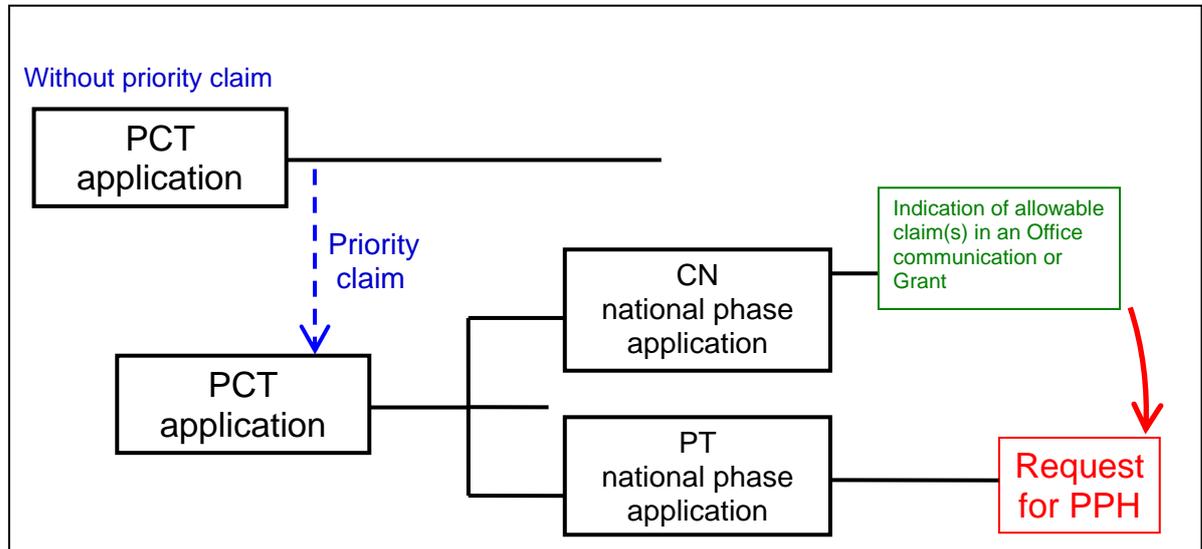
(G) PT application claims Paris Convention priority from a PCT application



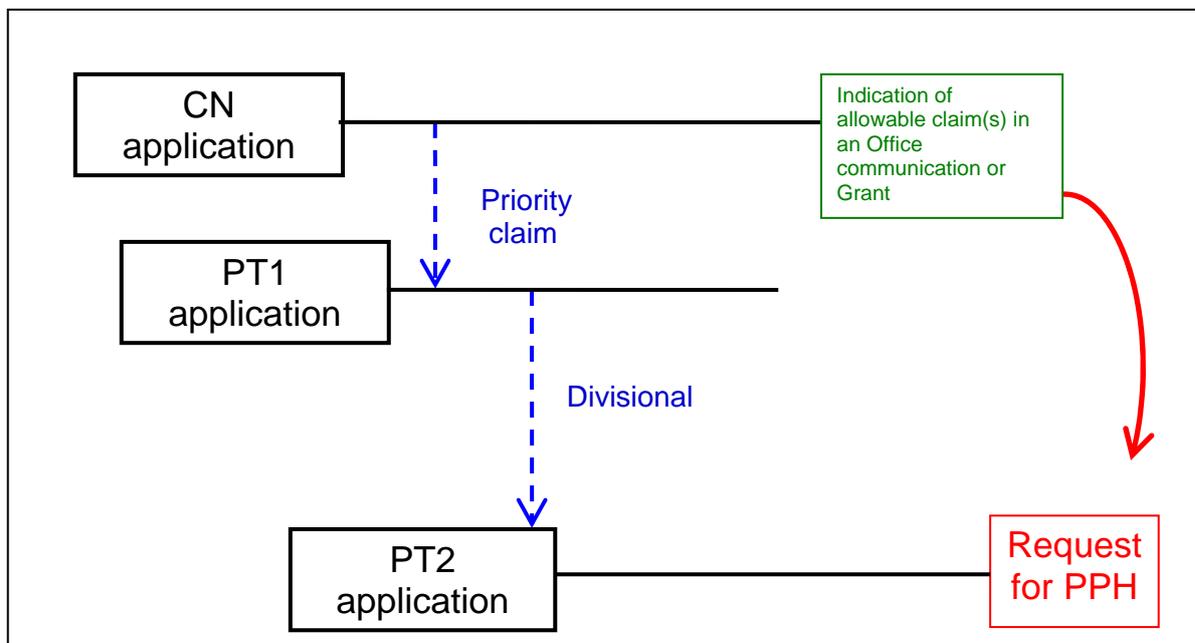
(H) PT application is a national phase of a PCT application which claims Paris Convention priority from another PCT application



(I) Direct PCT and PCT route



(J) Paris route and divisional application



ANNEX 2

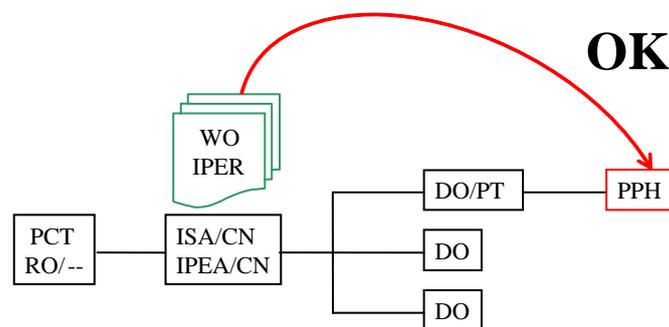
Examples of the applications eligible for PCT-PPH

Abbreviations:

RO – Receiving Office

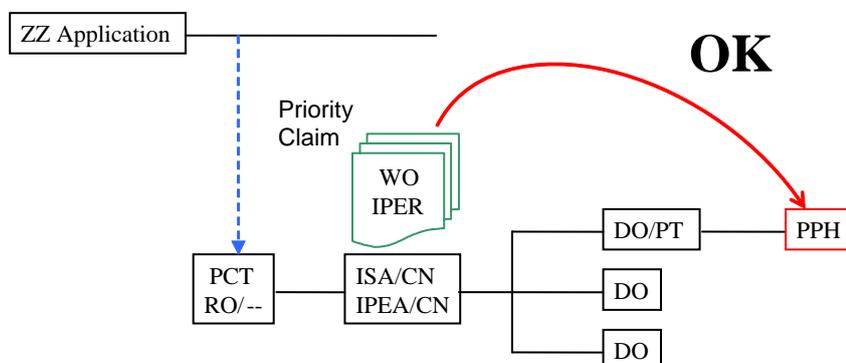
DO – Designated Office

(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.

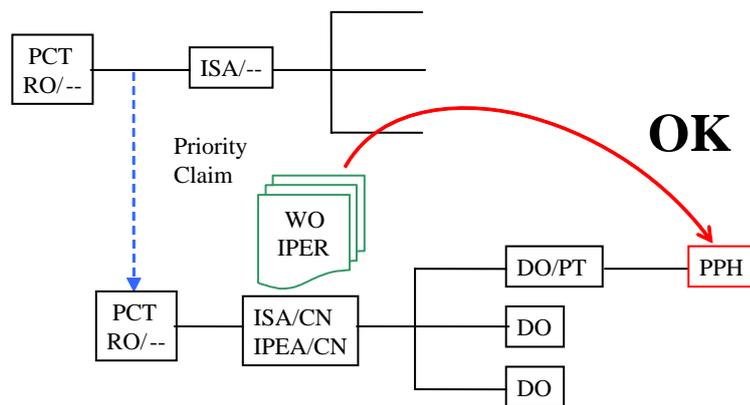
(The corresponding international application claims priority from a national application)



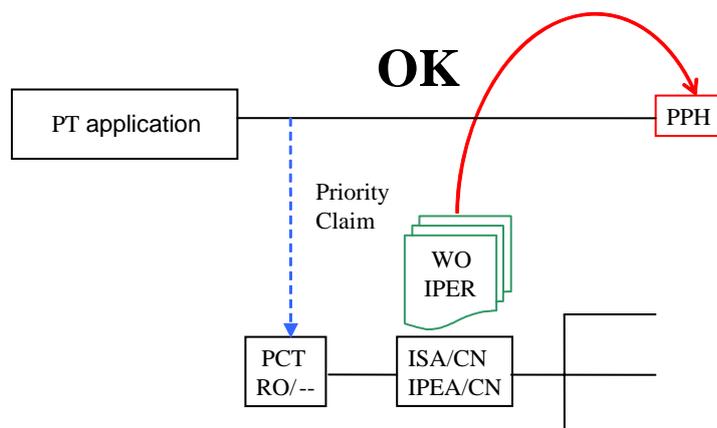
ZZ = any office

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

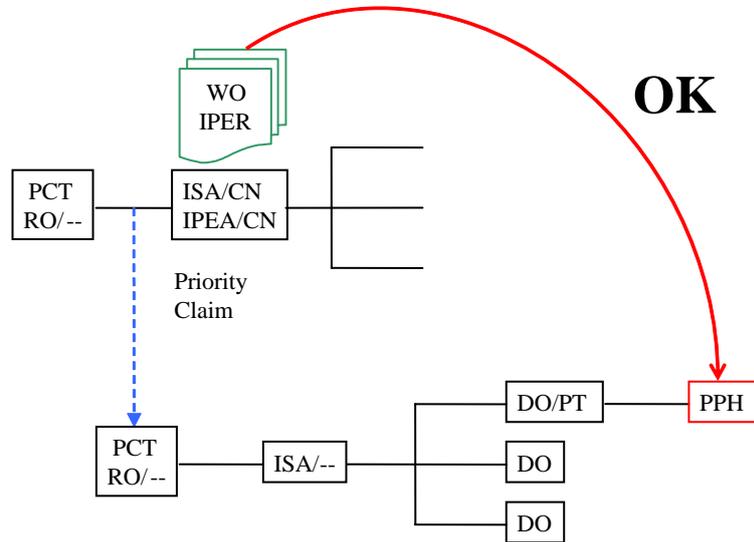
(The corresponding international application claims priority from an international application)



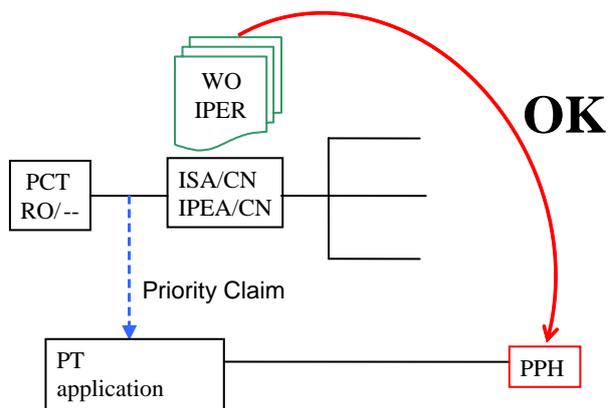
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



(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.



(E) The application is a divisional application of an application which satisfies the requirement (A).

