

## **Procedures to file a request to the SPTO (Spanish Patent and Trademark Office) for Patent Prosecution Highway Pilot Program between the SPTO and the SIPO (State Intellectual Property Office of the People's Republic of China)**

### **Background**

The Spanish Patent and Trademark Office (SPTO) implemented a Patent Prosecution Highway (PPH) pilot program with the State Intellectual Property Office of the People's Republic of China (SIPO) on October 21, 2013. The PPH pilot program is set to start on January 1, 2014 and to expire on December 31, 2016.

### **Trial Period for the PPH Pilot Program**

The PPH pilot program will commence on January 1, 2014, for a period of three years ending on December 31, 2016. The trial period may be extended if necessary to adequately assess the feasibility of the PPH program. The SIPO and SPTO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period.

## **Part I - PPH using the national work products from the SIPO**

### **Request to the SPTO**

**[0001]** An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the SPTO by submitting an application requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the SPTO for accelerated examination under the PPH are given in the following section. Relevant supporting documentation is discussed in a latter section (paragraphs [0003] to [0005]) as is the general SPTO application procedure envisaged at this time (paragraph [0006]).

### **Requirements for requesting an accelerated examination under the PPH Pilot Program at the SPTO**

**[0002]** The requirements for requesting accelerated examination under the PPH pilot program at the SPTO are:

- (a) Both the SPTO application on which PPH is requested and the SIPO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).**

*For example, the SPTO application (including PCT national phase application) may be either:*

- i) an application which validly claims priority under the Paris Convention to the SIPO application(s) (examples are provided in ANNEX 1).
- ii) a PCT national/regional phase application where both the SPTO application and the SIPO application(s) are derived from a common PCT international application having no priority claim (examples are provided

- in ANNEX 1).
- iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in ANNEX 1).
  - iv) an application which is the basis of a valid priority claim under the Paris Convention for the SIPO application(s) (including PCT national/regional phase application(s)) (examples are provided in ANNEX 1).
  - v) an application which shares a common priority document with the SIPO application(s) (including PCT national/regional phase application(s)) (examples are provided in ANNEX 1).

***(b) At least one corresponding SIPO 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 the claims on file, as originally filed or amended, for examination in the SPTO under the PPH must sufficiently correspond to one or more of those claims indicated as patentable/allowable by the SIPO.***

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

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

A claim in the SPTO application which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the SIPO application is not considered to sufficiently correspond. If, for example, the SIPO claims only contain claims to a process of manufacturing a product, then the claims in the SPTO application are not considered to sufficiently correspond if the claims of the SPTO application introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the grant of the request for participation in the PPH Pilot Program need not to sufficiently correspond to the claims indicated as patentable/allowable in the SIPO application.

### **Required documents for accelerated examination under the PPH Pilot Program at the SPTO**

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

a) a copy of all the office actions (which are relevant to the patentability) in the corresponding SIPO application(s), and translations of them. Office actions are documents which relate to substantive examination and which were sent to the applicant by the SIPO examiner. The applicant can either provide these with the request for acceleration under the PPH or request that the SPTO obtain the documents required through the SIPO document database<sup>1</sup>.

Both Spanish and English are acceptable as translation language. Machine translations are 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.

b) a copy of the claims found to be patentable/allowable by the SIPO and translations of them. The applicant can either provide these with the request for acceleration under the PPH or request that the SPTO obtain the documents required through the SIPO document database<sup>2</sup>. Both Spanish and English are acceptable as translation language. The indications provided in the requirement [0003](a) above regarding machine translations also apply to this requirement [0003](b).

c) a complete claim correspondence table showing the relationship between the claims of the SPTO application for accelerated examination under the PPH and the claims of the corresponding SIPO application considered patentable/allowable by the SIPO. Sufficient correspondence of claims occurs where claims are of the same or similar scope.

The claims correspondence table must indicate how the claims in the SPTO application correspond to the patentable/allowable claims in the SIPO application. The claim correspondence table must be written in Spanish 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 will usually be available to the SPTO. If the SPTO does not have access to relevant patent documents, the applicant must submit these documents at the request of the SPTO. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

---

<sup>1</sup><http://cpquery.sipo.gov.cn/>

<sup>2</sup><http://cpquery.sipo.gov.cn/>

**[0004]** The relevant information is obtained from the applicant by filling out a form for requesting accelerated examination under the PPH Pilot Program which is available on the SPTO web site. The relevant supporting documentation should be attached.

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

#### **Procedure for accelerated examination under the PPH Pilot Program at the SPTO**

**[0006]** The applicant fills out the form requesting accelerated examination under the PPH Pilot Program available on the SPTO web site and includes all the relevant supporting documents. The PPH Administrator, who will be an SPTO patent examiner, will consider the request. Where all 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 entry on to the PPH and will provide an explanation as to why entry on to the PPH was not possible. The applicant is free to take any possible correcting action necessary and again requesting acceleration under the PPH.

Where all of the requirements for accelerated examination have been met, the PPH Administrator will notify the applicant that the application has been allowed entry onto the PPH. The PPH Administrator will notify the relevant examining group that the application has qualified for entry to the PPH and the relevant examiner will then conduct an accelerated examination of the application.

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

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

### **Request to the SPTO**

**[0001]** An applicant can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the SPTO and satisfies the following requirements under the SPTO-SIPO Patent Prosecution Highway Pilot Program based on PCT international work products.

### **Requirements for requesting an accelerated examination under the PCT-PPH Pilot Program at the SPTO**

**[0002]** The application which is filed with the SPTO and on which the applicant files a request under the PCT-PPH must satisfy the following requirements:

***(a) The relationship between the application and the corresponding international application satisfies one of the following requirements:***

- i) The application is a national/regional phase application of the corresponding international application. (See Diagrams A, A', and A'' in Annex 2)
- ii) The application is a national/regional application as a basis of the priority claim of the corresponding international application. (See Diagram B in Annex 2)
- iii) The application is a national/regional phase application of an international application claiming priority from the corresponding international application. (See Diagram C in Annex 2)
- iv) The application is a national/regional application claiming foreign/domestic priority from the corresponding international application. (See Diagram D in Annex 2)
- v) The application is the derivative application (divisional application and application claiming domestic priority etc.) of the application which satisfies one of the above requirements (i) – (iv). (See Diagram E in Annex 2)

***(b) 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), the Written Opinion of International Examination Authority (WO/IPEA) or the Preliminary Examination Report (IPER), indicates at least one claim is patentable/allowable.***

The applicant cannot file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

***(c) In case any 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 noted 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.

***(d) All claims, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated to be patentable/allowable in the latest international work product of the corresponding international application.***

Claims are considered to 'sufficiently correspond' where, accounting for differences due to translations and claim format, the claims of the application are of the same or similar scope as the claims indicated to be patentable/allowable in the latest international work product, or the claims of the application are narrower in scope than the 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 product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims) of the application. Narrower claims can be written as dependent claims.

A claim of the application 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, the claims indicated to be patentable/allowable in the latest international work product only contains claims to a process of manufacturing a product, then the claims of the application are not considered to sufficiently correspond if the claims of the application introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the grant of 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 product.

#### **Required documents for accelerated examination under the PCT-PPH Pilot Program at the SPTO**

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

a) a copy of the latest international work product which indicated the claims to be patentable/allowable and their Spanish or English translations if they are not in English.

In case the application satisfies the relationship [0002](a)(i), the applicant need not to submit a copy of the International Preliminary Report on Patentability (IPRP) and 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®', an applicant need not to submit these documents, unless otherwise requested by the SPTO.

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

Machine translations are 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.

b) a copy of the set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their Spanish or English translations if they are not in Spanish.

If the copy of the set of claims which are indicated to be patentable/allowable is available via 'PATENTSCOPE®', e.g. the international Patent Gazette has been published, the applicant need not submit this document unless otherwise requested by the SPTO.

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

If the reference is a patent document, the applicant is not required to submit it. In case the SPTO has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

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

If the claims simply are literal translations, then it is sufficient that the applicant writes 'they are the same' in the table. If the claims are not literal translations, then it is necessary to explain the sufficient correspondence of each claim based on the criteria mentioned above.

**[0004]** When an applicant has already submitted the above mentioned documents (a)-(d) to the SPTO through simultaneous or past procedures, the applicant 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 the SPTO**

**[0005]** The applicant fills out the form requesting accelerated examination under the PCT-PPH Pilot Program available on the SPTO website and includes all the relevant supporting documents. The PCT-PPH Administrator, who will be an SPTO patent examiner, will consider the request. Where all the 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 entry on to the PCT-PPH and will provide an explanation as to why entry on to the PCT-PPH was not possible. The applicant is free to take any possible correcting action necessary and again requesting acceleration under the PCT-PPH.

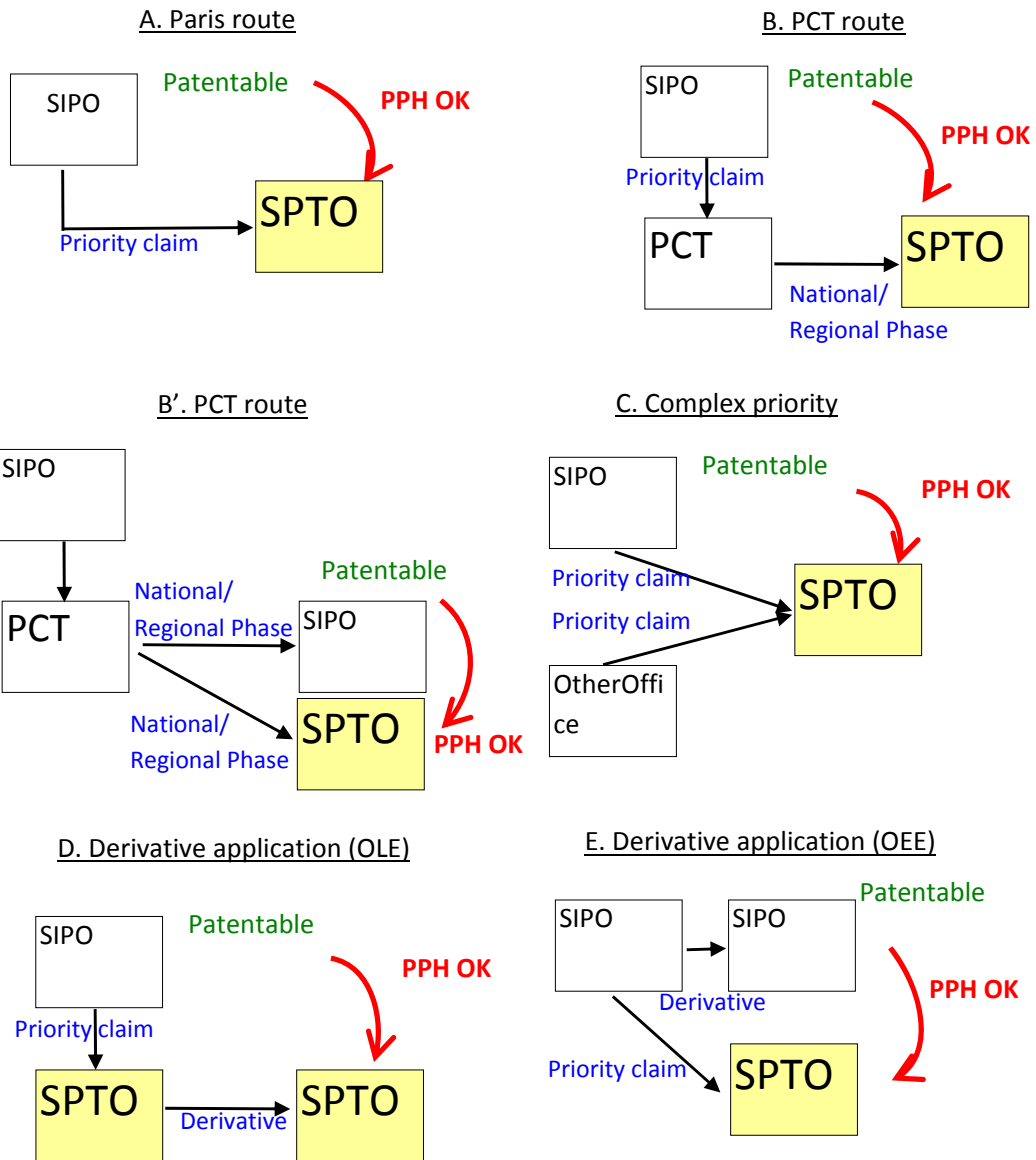
Where all of the requirements for accelerated examination under the PCT-PPH have been met, the PCT-PPH Administrator will notify the applicant that the application has been allowed entry on to the PCT-PPH. The PCT-PPH Administrator will notify the relevant examining group that the application has qualified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

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



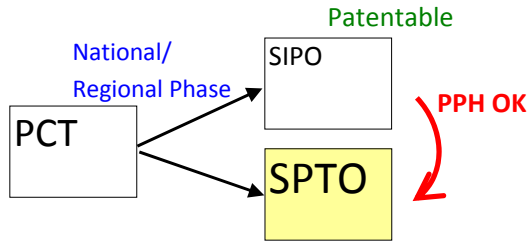
# Annex 1

## CASE I



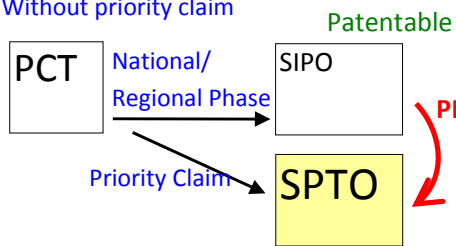
**CASE II**

**F. Direct PCT route**

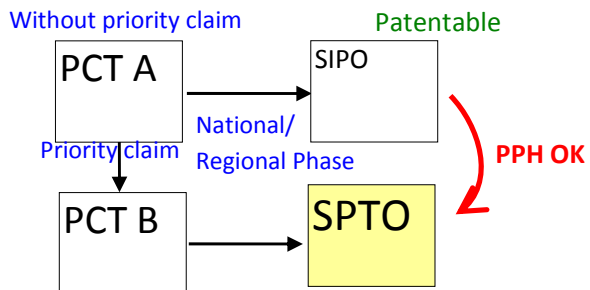
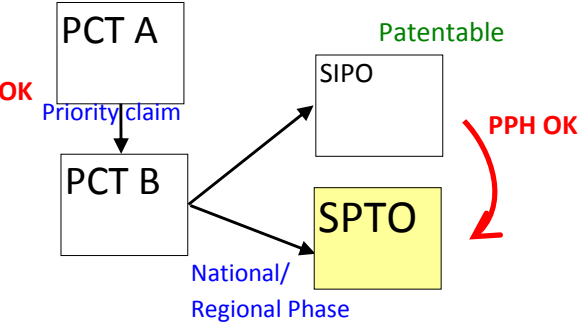


**CASE III**

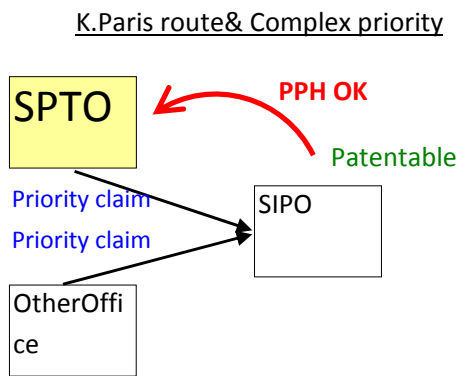
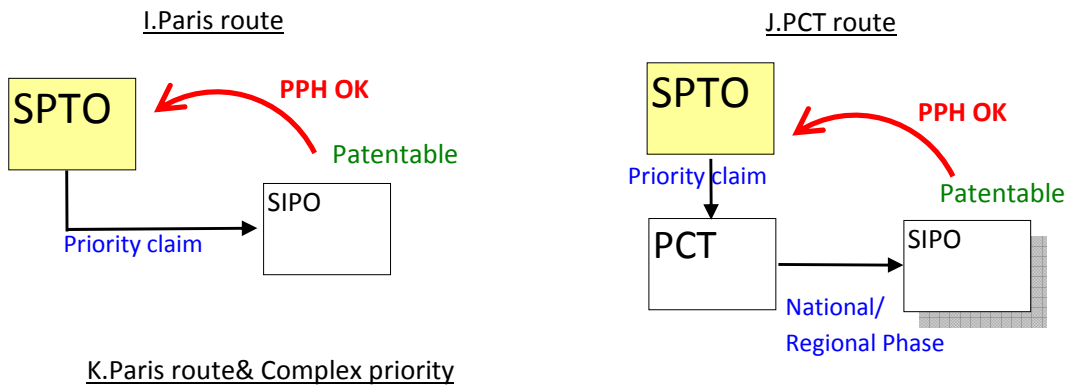
**G. Direct PCT & Paris route**  
Without priority claim



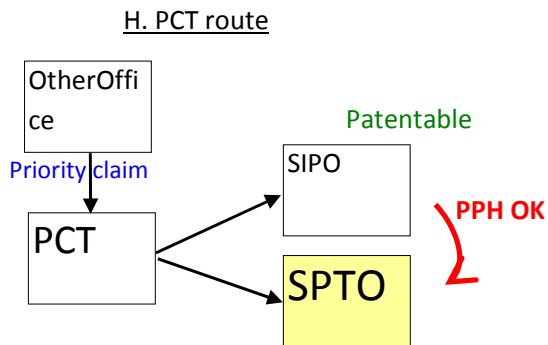
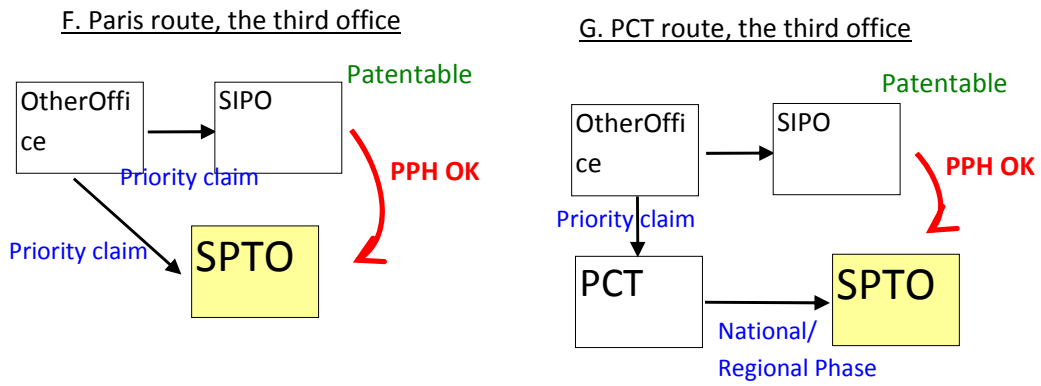
**H. Direct PCT & PCT route**  
Without priority claim



**CASE IV**



**CASE V**



## Annex 2

