

# **Common Understanding of Implementing the Patent Prosecution Highway Pilot Program between the Korean Intellectual Property Office and the Spanish Patent and Trademark Office**

## **I. Purpose of this document**

The Korean Intellectual Property Office (KIPO) and the Spanish Patent and Trademark Office (SPTO) agreed to the implementation of the Patent Prosecution Highway (PPH) Pilot Program between the KIPO and the SPTO. The PPH pilot program will commence on July 1, 2011, for a period of one year ending on June 30, 2012.

The purpose of this document is to define detailed requirements and procedures of the PPH between the KIPO and the SPTO based on the PPH MOU in May 26, 2011 between the Offices.

The KIPO and the SPTO will publish the guidelines for users about the procedures to file a request for participating in the KIPO-SPTO PPH based on this document.

## **II. Requirements of the PPH**

An application which is filed at the KIPO and the SPTO and which fulfills the following requirements is eligible for an accelerated examination under the PPH.

In the following, the expression “OFF” refers to “the Office of First Filing”, whereas the expression “OSF” refers to “the Office of Second Filing”.

### **1. Basic requirements for requesting accelerated examination under the PPH**

An application must fulfill all five requirements listed below:

#### **1.1 The OSF application (including a PCT national applications) is either:**

- (1) a national application which validly claims priority under the Paris Convention from either a single national OFF application or multiple national OFF applications (examples are provided in Annex I, Figure A, B, C), or
- (2) a PCT national phase application where the PCT international application has validly claimed priority from either a single OFF national application or multiple national OFF applications (examples are provided in Annex I, Figure D, E), or
- (3) a PCT national phase application where the PCT application has no priority claim (example is provided in Annex I, Figure F), or
- (4) a national application that validly claims priority under the Paris Convention from either a single PCT application with no priority claim or multiple PCT applications with no priority claims (example is provided in Annex I, Figure G), or
- (5) a PCT national phase application where the PCT application validly claims priority from a PCT application which has no priority claims (examples are provided in Annex I, Figure H, I), or
- (6) a divisional application of an application as referred to in any of (1) to (5) (examples are provided in Annex I, Figure J).

Refer to Annex I for illustrated examples of the above applications.

**1.2 The corresponding application(s) in the OFF has one or more claim(s) determined to be patentable/allowable by the OFF**

(1) The patentable/allowable claims of the OFF are the claims which are explicitly identified as patentable/allowable in the granted patent publication or in the office action by the OFF. Claims clearly identified to be patentable/allowable by the OFF in the latest office action at examination stage can form the basis of a request for an accelerated examination under the PPH, even if the application which includes those claims is not granted for patent yet.

(2) Corresponding application in the OFF whose claims are determined to be patentable/allowable does not have to be the application for which priority is claimed in the OSF application (the basic application). The OFF application can be an application explicitly derived from the basic application, e.g., a divisional application of the basic application, a converted application of the basic application or an application which claims domestic priority to the basic application (Refer to Example C and J in Annex I).

*[Note]*

Where the OFF application that contains the patentable/allowable claims is not the same application for which priority is claimed in the OSF application, applicant must identify the relationship between the OFF application that contains the patentable/allowable claims and the OFF priority application claimed in the OSF application.

**1.3 All claims in the OSF must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the OFF.**

All the claims in the OSF application for which a request in the PPH program is made must sufficiently correspond or be amended to sufficiently correspond to one or more of patentable/allowable claims in the OFF application(s).

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the OSF are of the same or similar scope

as the claims in the OFF, or the claims in the OSF are narrower in scope than the claims in the OFF.

In this regard, a claim that is narrower in scope occurs when an OFF 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 OSF which introduces a new/different category of claims to those claims indicated as patentable/allowable in the OFF is not considered to sufficiently correspond. For example, the OFF claims only contain claims to a process of manufacturing a product, then the claims in the OSF are not considered to sufficiently correspond if the OSF 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 OFF in an application in the OSF (the deletion of claims is allowable). For example, in the case where an application in the KIPO as OFF contains 5 claims determined to be patentable/allowable, the corresponding application in the SPTO may contain only 3 of these 5 claims.

Refer to Annex II for the cases which are considered to “sufficiently correspond” and the cases which are not considered to “sufficiently correspond”.

*[Note]*

When claims become determined to be patentable/allowable in the OFF by making amendment to claims in the OFF application, the claims in the OSF application should be amended in a similar way to sufficiently correspond to the patentable/allowable claims in the OFF application.

#### **1.4 The OSF has not finished examination of the application**

It is possible to participate in the PPH not only when examination has not begun, but also when examination has already begun. But if examination of the application is finished, it is not possible to participate in the PPH.

**1.5 A “Request for Search” or “Request for examination” must have been filed.**

Where the SPTO is the OSF, the request for accelerated examination under the PPH must be accompanied by, or preceded by a request for search.

Where the KIPO is the OSF, the request for accelerated examination under the PPH must be accompanied by, or preceded by a request for examination.

**2. Required documents to file a request for accelerated examination under the PPH**

An applicant who requests for accelerated examination under the PPH should submit a request form for accelerated examination under the PPH along with the four documents below.

**2.1 A Copy and translation of all claims determined to be patentable/allowable by the OFF**

(1) The copy of the claims determined to be patentable/allowable by the OFF might be either:

- a copy of the document submitted at initial filing which includes claims determined to be patentable/allowable where no later amendments to the claims have been made, or
- a copy of the amendments which includes claims determined to be patentable/allowable where later amendments to the claims have been made, or
- a copy of the OFF's publication of the granted patent.

(2) The official language of the OSF or English is acceptable as a translation language.

When an applicant submits the translation of the claims, the machine translations will be admissible. However, it is noted that the machine translation should be basically limited to officially recognized machine translation by OFF.

If it is impossible for the examiner to understand the translated claims due to insufficient translation, the examiner may request the applicant to submit (or resubmit) translations. It is noted that the request for PPH should not be rejected because the machine translation is not enough to understand the translation.

(3) It is not needed to submit the documents of the copy and translation of the claims when those documents are available via Dossier Access System (DAS) of OFF

It is possible for the applicant not to submit the documents by explaining that the documents are available via DAS in the request form. The translation of the claims has to be submitted by the applicant in cases where the translation of the claims is not provided via DAS.

*[Note]*

An applicant may submit the professional translation of the claims in order to let examiner easily understand it according to applicant's discretion.

## **2.2 Copies and translation of all office actions in the OFF**

(1) "Office action" means documents which relate to substantive examination and which were sent to an applicant from the OFF examiner.

- In the case where the KIPO is the OFF, the office actions are limited to "Notice of Grounds for Rejection", "Decision of Rejection" and "Decision to grant a patent".
- In the case where the SPTO is the OFF, the office actions are limited to "Search report and written opinion", "Notice of grounds for Rejection", "Decision of rejection" and "Decision to grant a patent"

(2) The official language of the OSF or English is acceptable as a translation language.

The descriptions in the requirement 2.1 above regarding the occasions where the applicant will not have to submit copies and translations, and regarding machine translation are also applied to this requirement 2.2.

### **2.3 Documents cited by the OFF examiner**

The documents to be submitted are those cited in the office action of reasons for refusal in the OFF. 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 cited document is a patent document, applicant does not have to submit it because it is usually available to the OSF. However, if the cited document is non-patent literature, applicants will have to submit it.

*[Note]*

In the case where the OSF has difficulty in obtaining the document, it will ask the applicant to submit it. In every case, translations of the cited documents are not required.

### **2.4 Claim correspondence table**

An applicant must submit a claim correspondence table to explain the correspondence of claims determined to be patentable/allowable in the OFF and all claims in the OSF.

An applicant must explain how all claims in the OSF application sufficiently correspond to the patentable/allowable claims in the OFF application in the table for each OSF claims based on the criteria in “II.1.3. All claims in the OSF must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the OFF” (Also refer to Annex II for the examples of the claim correspondence).

## **3. Request form and fee**

An applicant should submit a request form for the accelerated examination under the PPH along with the documents referred to “II.2 Required documents to file a request for accelerated examination under the PPH”, and when applicable, an applicant should pay the fee for the request for the participation under the PPH to the OSF.

### **III. Procedure for the accelerated examination under the PPH**

The OSF 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 OSF 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 will be given opportunity to perfect the request. If not perfected, the applicant will be notified and the application will await action in its regular turn.

*[Note]*

When the KIPO is the OSF, KIPO will not notify the applicant of the acceptance for assigning a special status for accelerated examination under the PPH, but instead applicant may recognize it by the reception of an office action resulting from accelerated examination.



## **IV. Miscellaneous provisions**

### **1. Guidelines for users**

The Offices will make Guidelines for users to file a request for the accelerated examination under the PPH based on this document.

### **2. Exchange of information on the status of PPH pilot program**

The Offices will exchange the relevant data to evaluate the pilot program on a quarterly basis and consider modifying the program on the basis of the evaluation results.

### **3. Amendment of Common Understanding of PPH pilot program**

This common understanding document may be amended at any time with the mutual written consent of the Offices. If either Office perceives a need to amend this document, they may request a mutual review of the document, and the other office shall immediately accept the request.

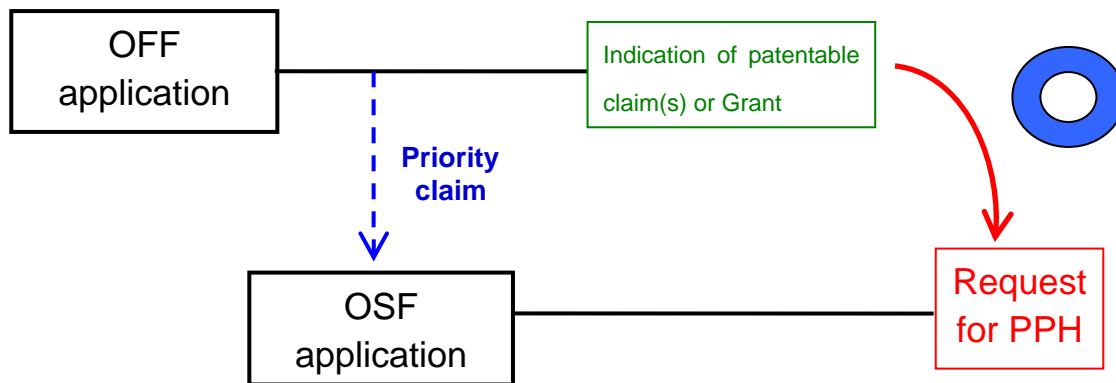
# ANNEX I

## Examples of OSF application eligible for the PPH

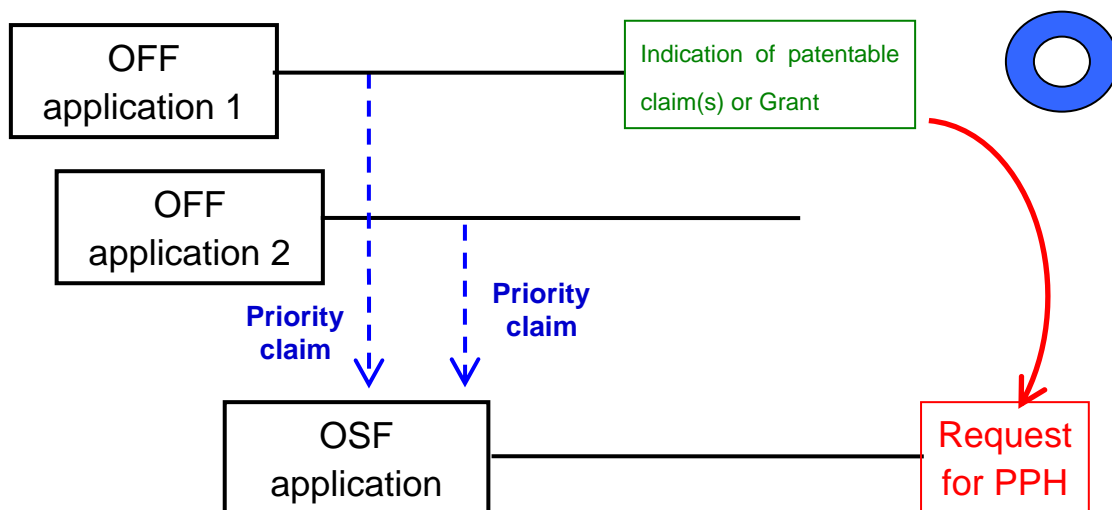
1.1.(1) The national application which validly claims priority under the Paris Convention from either a single national OFF application or multiple national OFF applications

(A Korean Utility Model is also included in the OFF application.)

### A Paris Route (Single Priority)

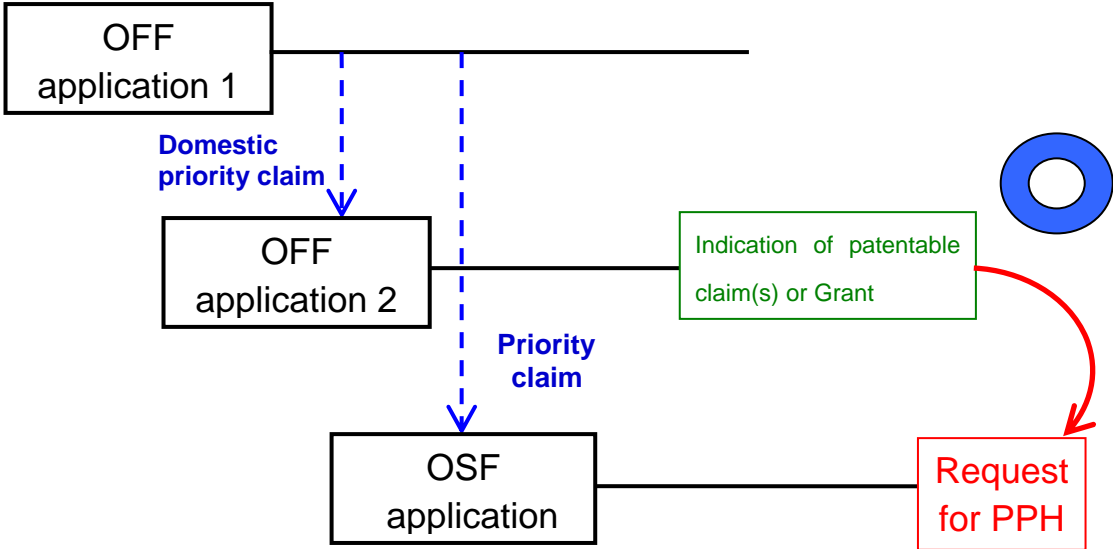


### B Paris Route (Multiple Priority)



1.1.(1) (continued)

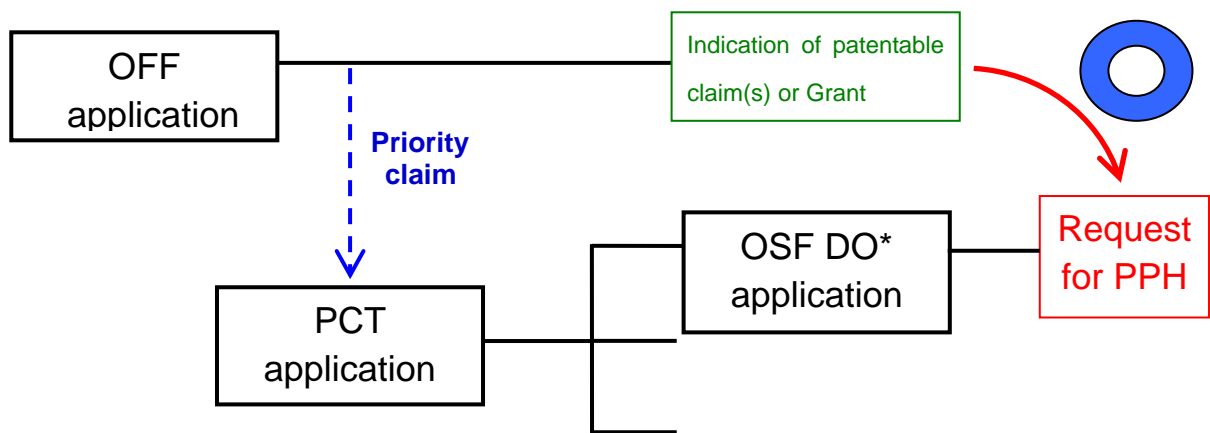
**C Paris Route (Domestic Priority)**



1.1.(2) The PCT national phase application where the PCT international application has validly claimed priority from either a single OFF national application or multiple national OFF applications

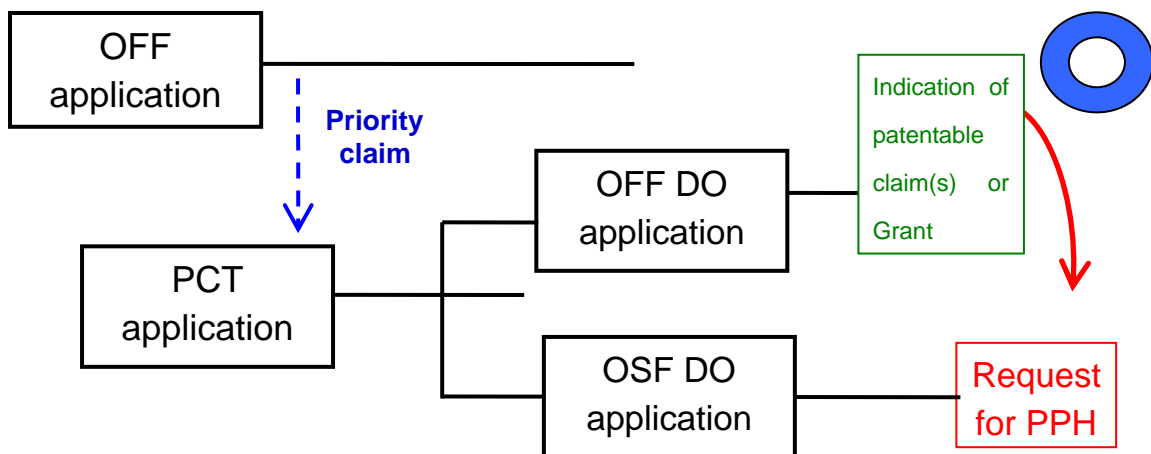
(A Korean Utility Model is also included in the OFF application.)

**D PCT Route**



\*DO = Designated Office

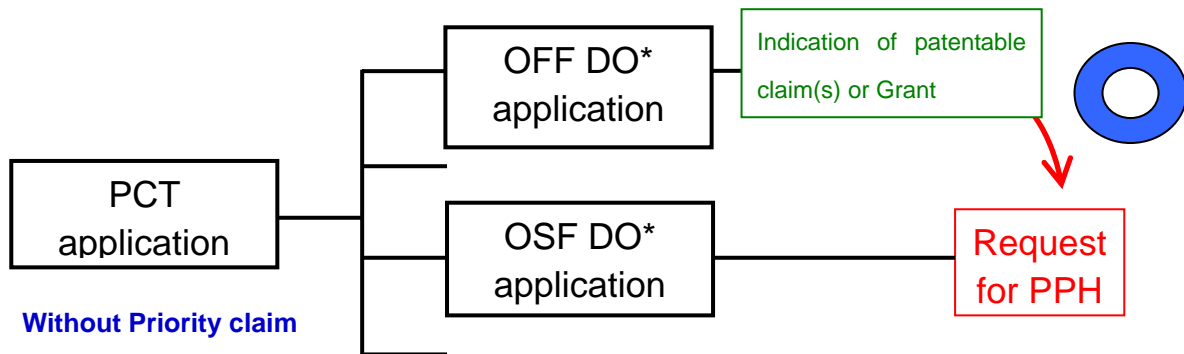
**E PCT Route**



\*DO = Designated Office

1.1.(3) The PCT national phase application where the PCT application has no priority claim

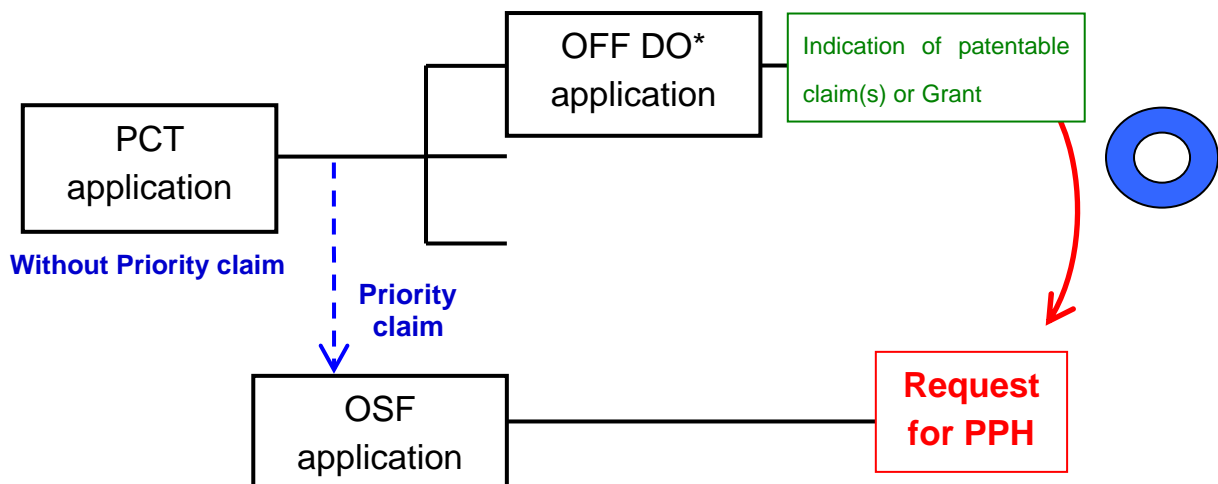
**F** Direct PCT Route



\*DO = Designated Office

1.1.(4) The national application that validly claims priority under the Paris Convention from either a single PCT application with no priority claim or multiple PCT applications with no priority claims

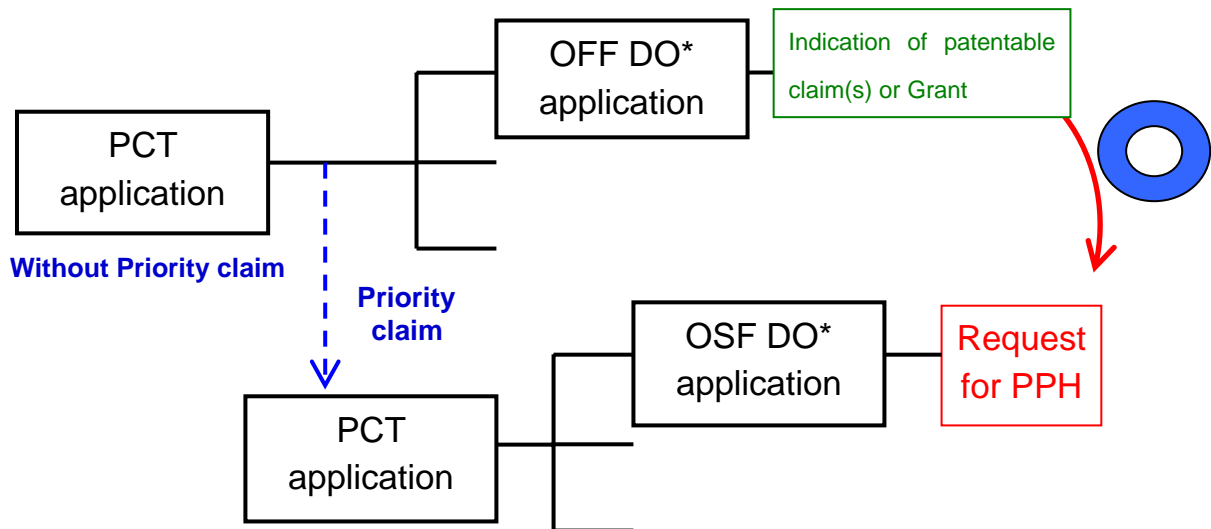
**G** Direct PCT & Paris Route



\*DO = Designated Office

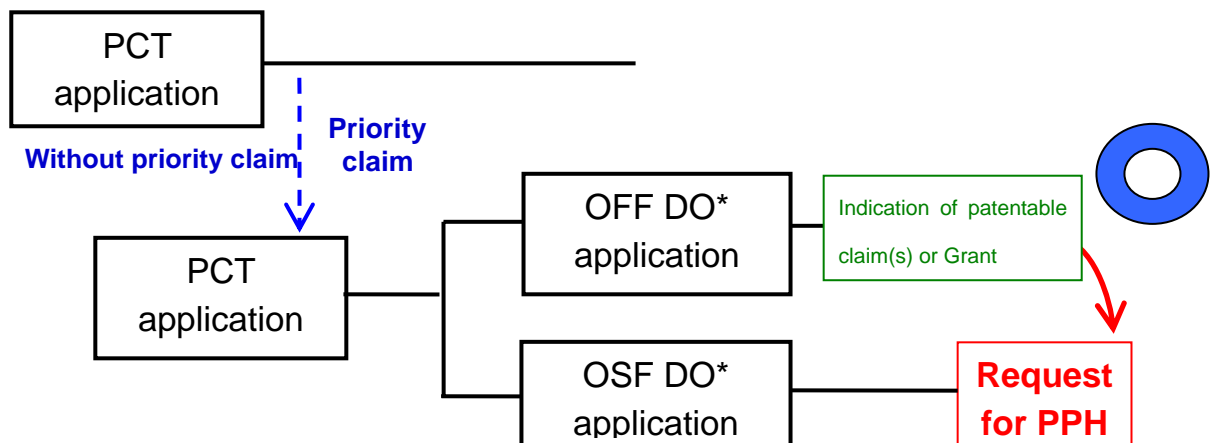
1.1.(5) The PCT national phase application where the PCT application validly claims priority from a PCT application which has no priority claims

**H** Direct PCT & PCT Route



\*DO = Designated Office

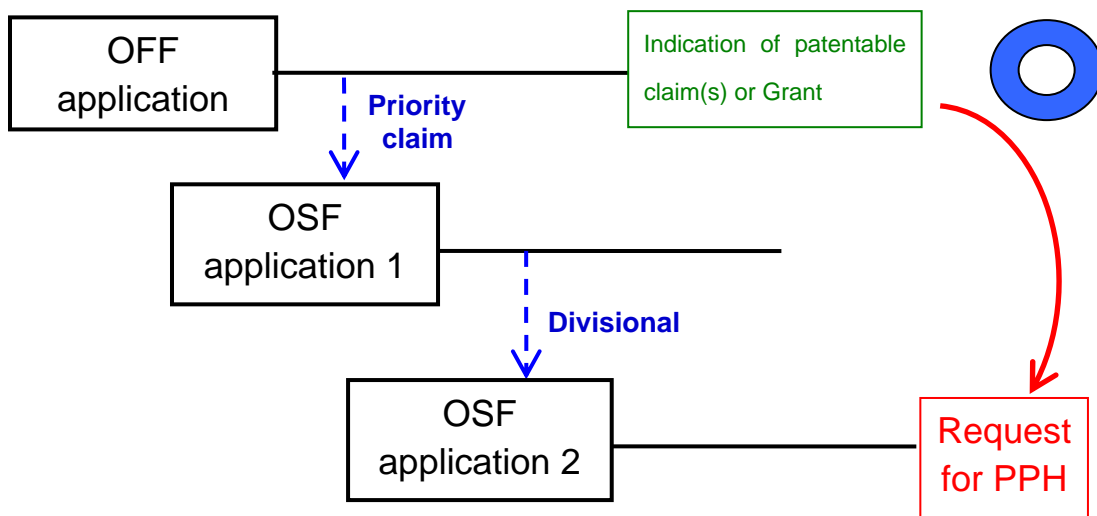
**I** Direct PCT & PCT Route



\*DO = Designated Office

1.1.(6) The divisional application of an application as referred to in any of (1) to (5)

**J** Paris (PCT) Route (Divisional Application)

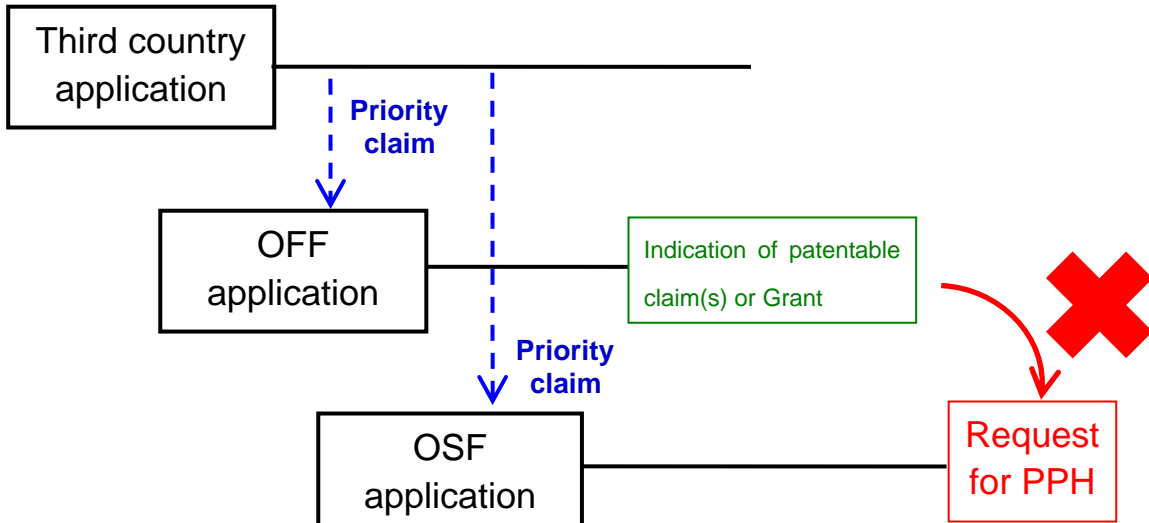


Cases NOT meeting requirement II.1.1

K

**Paris Route**

**(But the first application is from the third country)**

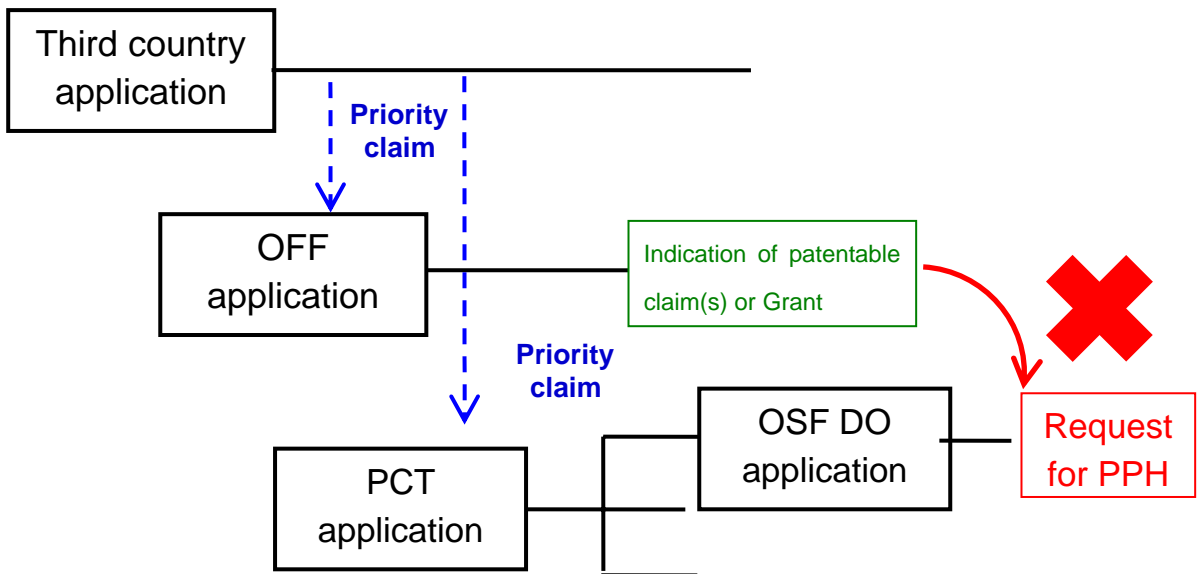


Third country: NOT PPH participating country

L

**PCT route**

**(But the first application is from the third country)**



Third country: NOT PPH participating country

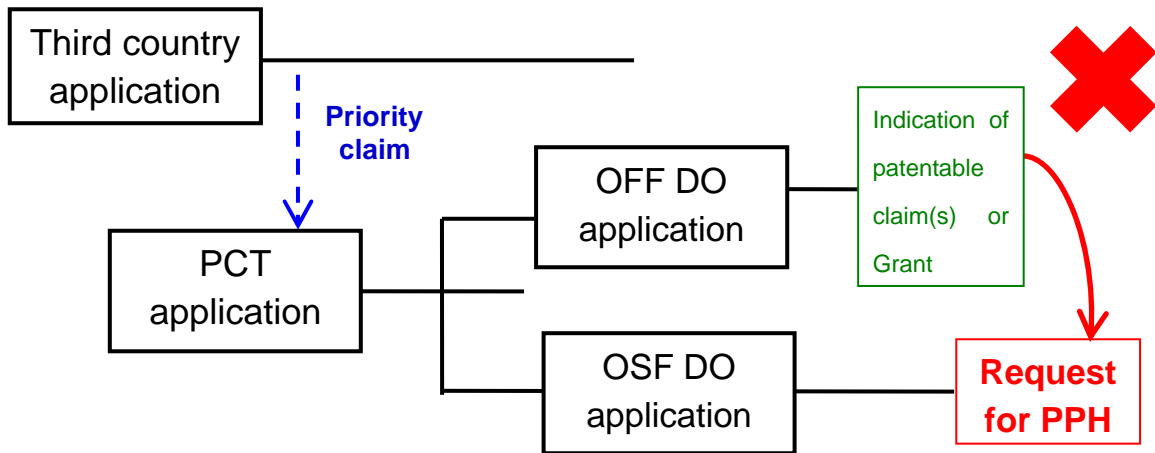


Cases NOT meeting requirement II.1.1 (continued)

M

PCT route

(But the first application is from the third country)



Third country: NOT PPH participating country

## ANNEX II

### Examples for the claim correspondence

1. The claims in the following cases (case 1 to case 4) are considered to “sufficiently correspond” to each other.

Case	OFF claim(s)		OSF claim(s)		Correspondence
	Claim	Subject matter	Claim	Subject matter	
Case 1	1	A	1	A	The same as OFF claim 1.
Case 2	1	A	1 2	A A+a	The same as OFF claim 1. Dependent claim 2 in the OSF claim is created by adding an element to the OFF claim.
Case 3	1 2 3	A A+a A+b	1 2 3	A A+b A+a	The same as OFF claim 1. The same except for claim format. The same except for claim format.
Case 4	1	A	1	A+a	Claim 1 has an additional element ‘a’.

\* Where “A” is the subject matter, and “a” and “b” are the additional technical features which are supported in the description

2. The claims in the following cases (case 5 and case 6) are NOT considered to “sufficiently correspond” to each other.

Case	OFF claim(s)		OSF claim(s)		Explanation
	Claim	Subject matter	Claim	Subject matter	
Case 5	1	A system	1	A’ method	The claimed invention of the OSF application is a method, whereas the claimed invention of the OFF application is a system. (The technical features in the OFF claim are the same as those in the OSF claim, but categories of both inventions are different)
Case 6	1	A+B	1	A+C	The OSF claim is different from the OFF granted claim in a component of the claimed invention. (The OSF claim is created by altering part of the technical features of the OFF claim)