Procedures to File a Request to the Korean Intellectual Property Office for Patent Prosecution Highway using the Patent Cooperation Treaty Work Products Pilot Program between the Korean Intellectual Property Office and the Japan Patent Office

The trial period of this Patent Prosecution Highway based on the Patent Cooperation Treaty Work Products (PCT-PPH) pilot program will commence on July 1, 2012 and will end on June 30, 2014. The trial period may be extended if necessary until the Korean Intellectual Property Office (KIPO) and the Japan Patent Office (JPO) receive the sufficient number of PCT-PPH requests to adequately assess the feasibility of the PCT-PPH program.
The Offices may also terminate the PCT-PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PCT-PPH pilot program is terminated.

Applicants may request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with KIPO and satisfies the following requirements under the KIPO-JPO PCT-PPH pilot program.
When filing a request for the PCT-PPH pilot program, an applicant must submit a request form "Request for Accelerated Examination under the PCT-PPH" to KIPO.

1. Requirements

The application which is filed with KIPO and on which the applicant files a request for 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 the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive steps and industrial applicability).

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to KIPO or the JPO, but, if priority is claimed, the priority claim can be to an application in any Office, see example A' in ANNEX I (application ZZ can be any national

application).

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

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 whether or not 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 does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted 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 I)

(ii) The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in ANNEX I)

(iii) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in ANNEX I)

(iv) The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure D in ANNEX I)

(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 Figures E1 and E2 in ANNEX I)

(c) All claims on file, 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 work product is amended to be further

limited by an additional 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 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 contain 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.

It is not required to include "all" claims determined to be patentable/allowable in the latest international work product (the deletion of claims is allowable). For example, in the case where the corresponding international application contains 5 claims determined to be patentable/allowable, the application filed with KIPO 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".

Any claims amended or added before the substantive examination are required to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product.

(d) A "Request for Examination" must have been filed.

The request for accelerated examination under the PCT-PPH must be accompanied by, or preceded by a request for examination.

The request for accelerated examination under the PCT-PPH may be filed not only when substantive examination has not begun, but also when substantive examination has already begun.

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to "Request for Accelerated Examination under the PCT-PPH".

Note that even when it is not required to submit documents below, the name of the documents must be listed in "Request for Accelerated Examination under the PCT-PPH" (Please refer to the example form below for the detail).

(a) A copy of the latest international work product of the corresponding international application which indicates the claims to be patentable/allowable, and translation thereof

Either Korean or English is acceptable as translation language. If it is impossible for the examiner to understand the translated international work product, the examiner may request the applicant to resubmit translations.

If the copy of the latest international work product and translation thereof are available via "PATENTSCOPE"[1] (e.g. the international Patent Gazette has been published), the applicant is not required to submit these documents, unless otherwise requested by the KIPO.

(b) Copies of all claims which are indicated to be patentable/allowable in the latest international work product of the corresponding international application, and translations thereof

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

If the copies of all the claims which are indicated to be patentable/allowable and translation thereof are available via "PATENTSCOPE", the applicant is not required to submit this document unless otherwise requested by the KIPO.

(c) Copies of references cited in the latest international work product of the corresponding international application

Reference documents which are not relevant to negation of the patentability (novelty/inventive steps/industrial applicability) are not required to be submitted.

If the references are patent documents, the applicant is not required to submit them. When KIPO does not possess the patent documents, the applicant has to submit the patent documents at the examiner's request. Non-patent documents must always be submitted. The translations of the references are unnecessary.

(d) A claims correspondence table

The applicant requesting for PCT-PPH must submit a claim correspondence table, which indicates how all claims of the KIPO application sufficiently correspond to the patentable/allowable claims of the corresponding international application.

When claims are just literal translations, the applicant can just write down that "they are the same" in the table. When claims are not just literal translation, it is required to explain the sufficient correspondence of each claim based on the criteria 1.(c) (Please refer to the example form below and ANNEX II).

[1] http://www.wipo.int/pctdb/en/index.jsp

3. Example of "Request for Accelerated Examination under the PCT-PPH" for filing request for an accelerated examination under the PCT-PPH pilot program

(a) Circumstances

When an applicant files a request for participation in the PCT-PPH pilot program to KIPO, an applicant must submit a request form "Request for Accelerated Examination under the PCT-PPH".

The applicant must indicate that the application belongs to any of the categories (i) to (v) of 1.(b), and that the accelerated examination is requested under the PCT-PPH pilot program. The application number(s) of the corresponding international application(s) also must be written.

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 explanation why the claim(s) is/are not subject to the observation must be written.

(b) Documents to be submitted

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 may file the "Request for Accelerated Examination under the PCT-PPH" to KIPO via either paper-based or on-line procedures.

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

KIPO decides whether the application can be entitled to the status for an accelerated examination under the PCT-PPH when it receives a request with the documents stated above. When KIPO decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PCT-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 shall be assigned to the regular examination track. Then the applicant may resubmit the request.

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

Example form of "Request for Accelerated Examination under the PCT-PPH" (consists of 2 Forms: Request for Accelerated Examination and Explanation of Request for Accelerated Examination under the PCT-PPH)

【서류명】 심사청구(우선심사신청)서 (Form of Request for Accelerated Examination)

【구분】 우선심사신청 (Request for Accelerated Examination)

【제출인】 (Subscriber)

【명칭】 (Name)

【출원인코드】 (Subscriber ID)

【사건과의 관계】 (Relation)

【대리인】 (Agent)

【성명】 (Name)

【대리인코드】 (Agent ID)

【포괄위임등록번호】 (Mandating Registration ID)

【사건의 표시】(Application)

【출원번호】 (Application Number)

【발명의 명칭】 (Title)

【수수료】 (Fee)

【우선심사 신청료】 (Fee for Accelerated Examination)

【수수료 자동납부번호】 (Automated Fee Transfer ID)

【취지】 (Purpose)

【첨부서류】

(Attachment, Explanation of Request for Accelerated Examination under the PCT-PPH)

【서류명】 **PCT-PPH** 에 의한 우선심사신청설명서

(Explanation of Request for Accelerated Examination under the PCT-PPH)

【대상국가】 (Office of First Filing)

【본원출원번호】 (Application Number)

【대응출원번호】 (Application Number of Corresponding Application)

【본원출원과 대응출원의 관계】 (Relation of the Corresponding Application)

【제출서류】 (Required Documents)

【신규성, 진보성 및 산업상 이용가능성이 모두 있다고 판단된 특허청구범위】

(Patentable Claims in view of Novelty, Inventive step and Industrial Applicability)

【서류명 및 제출(발행)일】 (Issue Date)

【서류제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

【번역문제출여부】 (Submit Translations, Y/N)

【제출생략 이유】 (Reasons of Exemption for Translations)

【국제조사 또는 국제예비심사 관련 통지서】 (International Work Product)

【서류명 및 통지일】 (Issue Date)

【서류제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

【번역문제출여부】 (Submit Translations, Y/N)

【제출생략 이유】 (Reasons of Exemption for Translations)

【국제조사 또는 국제예비심사에서 인용된 선행기술문헌】 (Prior Arts cited in WO/IPER)

【명칭】 (Title)

【제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

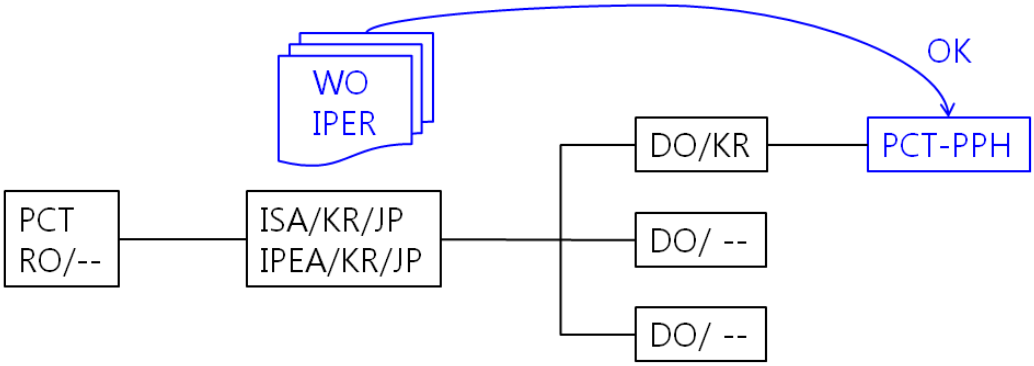
【청구항간 대응관계설명표】 (Claim Correspondence Table)

본원출원의 청구항 번호 (Claim Number)	대응출원에서 특허가능하다고 판단한 청구항 번호 (Claim Number of the Corresponding International Application)	대응관계 설명 (Correspondence)

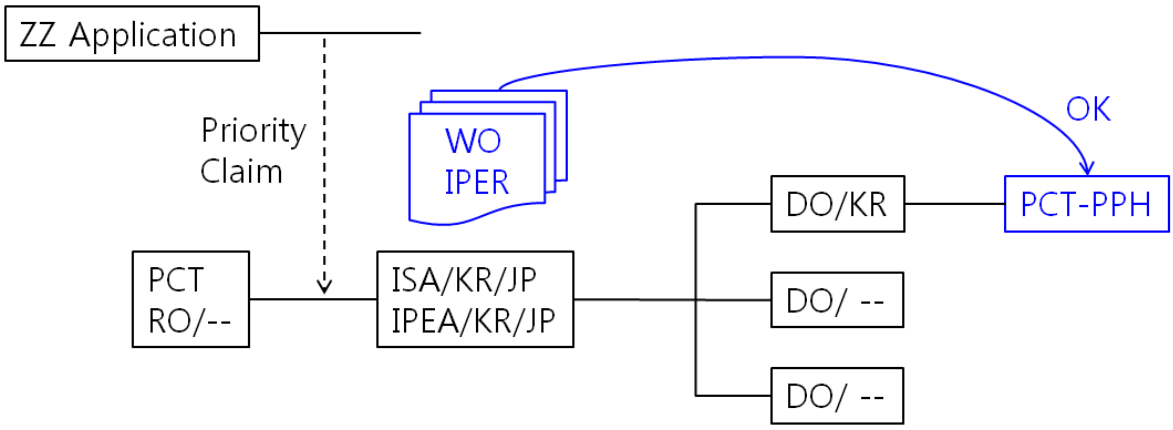
【국제출원에 관한 의견 관련 설명】

(Explanation for the Comments in Box VIII of the International Work Product)

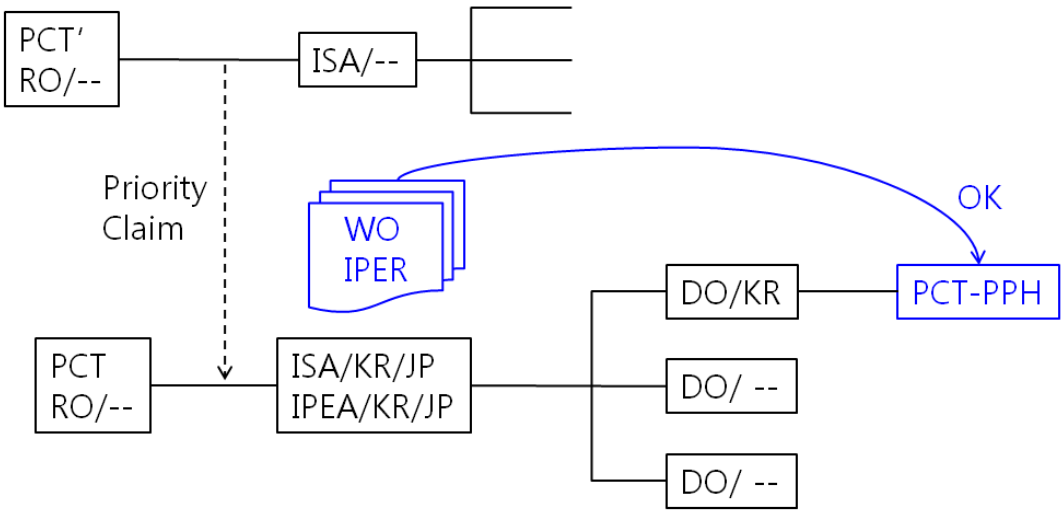
ANNEX I



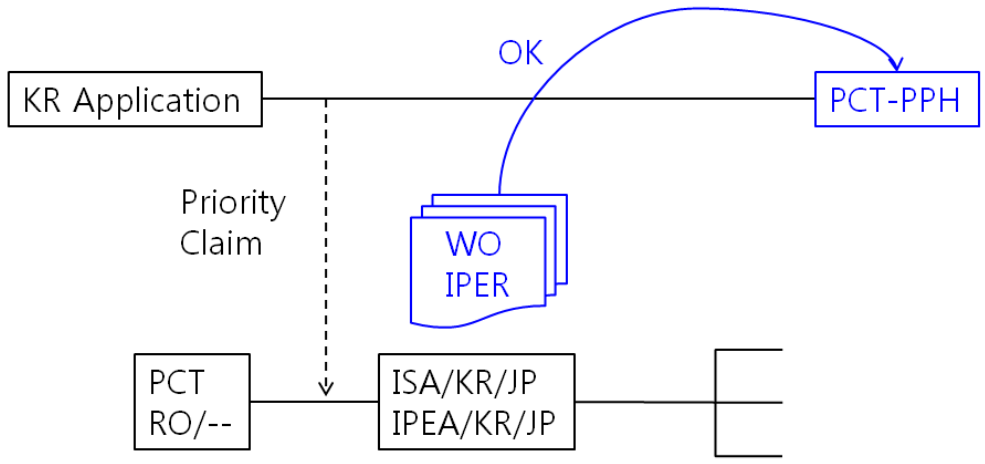
(A) The application is a national phase application of the corresponding PCT application.



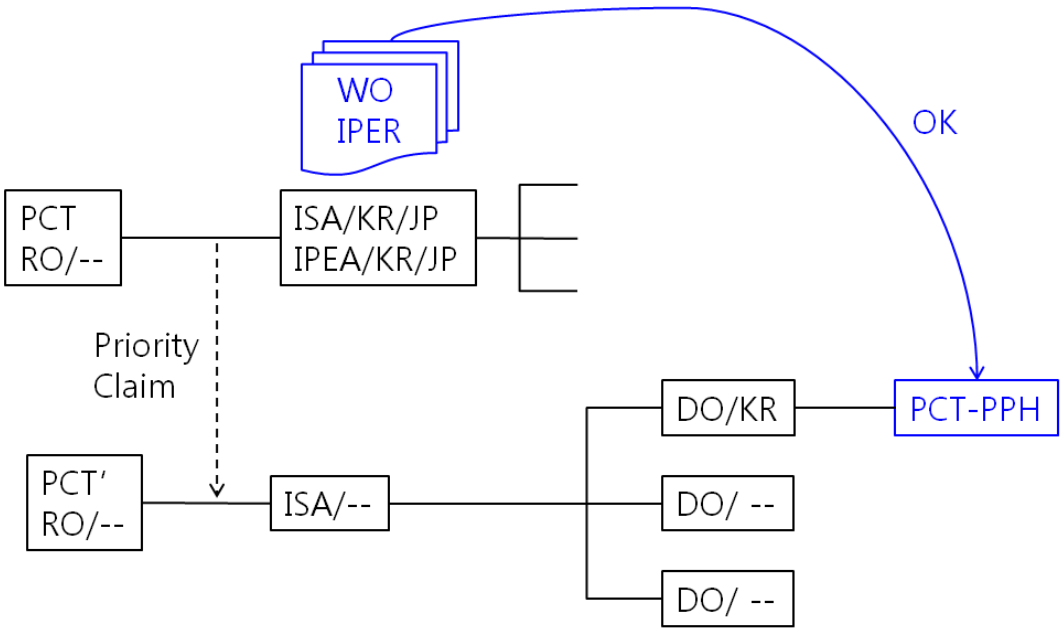
(A') The application is a national phase application of the corresponding PCT application.
(The corresponding PCT application claims priority to a national application filed anywhere.)



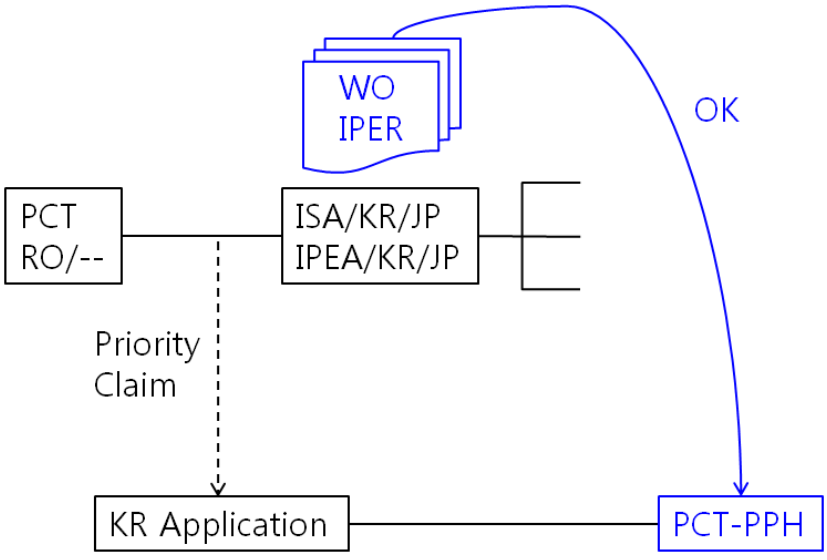
(A") The application is a national phase application of the corresponding PCT application claiming priority to another PCT application.



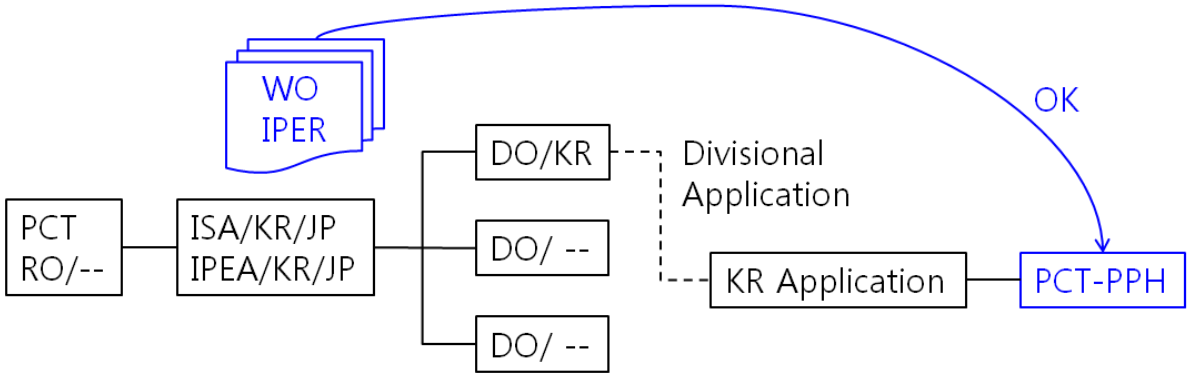
(B) The application is a national application which forms the basis of the priority claim of the corresponding PCT application.



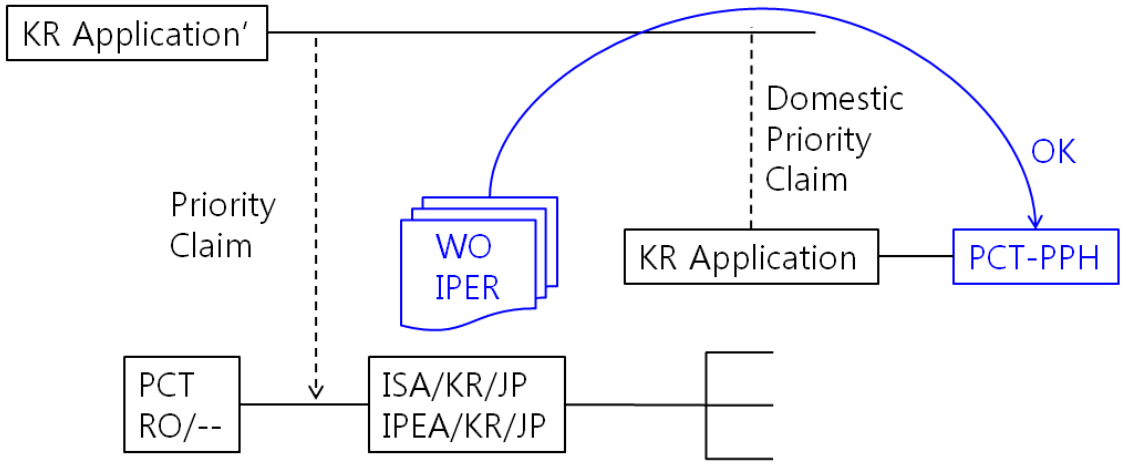
(C) The application is a national phase application of a PCT application claiming priority to the corresponding PCT application.



(D) The application is a national application claiming foreign/domestic priority to the corresponding PCT application.



(E1) The application is a divisional application of an application which satisfies the requirement (A).



(E2) The application is an application claiming domestic priority to an application which satisfies the requirement (B).

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	"Patentable" claim(s)		PPH claim(s)		Correspondence
	Claim	Wording	Claim	Wording	
Case 1	1	A	1	A	PPH claim 1 is the same as "Patentable" claim 1.
Case 2	1	A	1 2	A A+a	PPH claim 1 is the same as "Patentable" claim 1. PPH claim 2 is created by adding a technical feature disclosed in the specification to "Patentable" claim 1.
Case 3	1 2 3	A A+a A+b	1 2 3	A A+b A+a	PPH claim 1 is the same as "Patentable" claim 1. PPH claims 2, 3 are the same as "Patentable" claims 3, 2, respectively.
Case 4	1	A	1	A+a	PPH claim 1 has an additional technical feature 'a' disclosed in the specification.

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

Case	"Patentable" claim(s)		PPH claim(s)		Explanation
	Claim	Wording	Claim	Wording	
Case 5	1	A product	1	A' method	PPH claim 1 claims to a method, whereas "Patentable" claim 1 claims to a product. (The technical feature of "Patentable" claim is the same as that of PPH claim, but categories of both claims are different)
Case 6	1	A+B	1	A+C	PPH claim 1 is different from "Patentable" claim 1 in a component of the claimed invention. (PPH claim is created by altering part of the technical features of "Patentable" claim.)