



Procedures to File a Request to the Korean Intellectual Property Office for the Patent Prosecution Highway Pilot Program between the Korean Intellectual Property Office (KIPO) and the Directorate General of Intellectual Property (DGIP)

I. Purpose of this Document

This document aims to publicize the requirements and necessary documents for requesting participation in the Patent Prosecution Highway (PPH) pilot program between the Korean Intellectual Property Office (KIPO) of the Republic of Korea and the Directorate General of Intellectual Property (DGIP) of the Republic of Indonesia to KIPO in order for an applicant to easily file a request for accelerated examination under the PPH pilot program.

When an applicant files a request for accelerated examination under the PPH pilot program to KIPO based on examination results by the DGIP as an Office of Earlier Examination (OEE), the PPH request should meet the requirements described in the below paragraph III.

II. The Trial Period for the PPH Pilot Program

The PPH pilot program will be in effect for three (3) years commencing on 8 December 2023 and will end on 8 November 2026. The offices will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period.

III. Procedures to File a Request for Accelerated Examination under the PPH Pilot Program

1. Basic Requirements for Requesting Accelerated Examination under the PPH Pilot Program to KIPO

There are six requirements for requesting accelerated examination under the PPH pilot program to KIPO. An applicant must fulfill all six requirements listed below:

1.1 Both the KIPO application for which the PPH is requested and the OEE application(s) forming the basis of the PPH request must have the same earliest date (whether this be a priority date or a filing date)

An applicant should write the earliest dates for the KIPO application and the OEE application(s) in the request form. Refer to Annex I for examples where the above requirement is satisfied.

1.2 Examination of an original application related to a request for accelerated examination under the PPH program should be initiated in KIPO or in the DGIP

The KIPO application requested for accelerated examination belongs to a patent family originally filed with KIPO or the DGIP (Refer to examples G and H of Annex I for the applications that do not satisfy such requirement). Also, the KIPO application that claims priority to a direct PCT application is eligible for a request for accelerated examination under the PPH program.

1.3 The corresponding DGIP application(s) has one or more claim(s) determined to be patentable/allowable by the DGIP

(1) The patentable/allowable claims of the DGIP application refer to the claims which are explicitly identified as patentable/allowable in the granted patent publication or in the latest office action issued by the DGIP.

(2) The corresponding DGIP application whose claims are determined to be patentable/allowable does not have to be a DGIP application claiming priority under the Paris Convention (the basic application). The corresponding DGIP application can be an application explicitly derived from the basic application, e.g., a divisional application of the basic application (Refer to example D in Annex I).

[Note]

Where the DGIP application that contains patentable/allowable claims is not the same with an application claiming priority under the Paris Convention, an applicant must confirm the relationship between the DGIP application that contains the patentable/allowable claims and the application claiming priority under the Paris Convention.

1.4 All claims in the KIPO application must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims determined to be patentable/allowable by the DGIP.

(1) Claims are considered to “sufficiently correspond” where the claims of the KIPO application are the same or substantially same as the claims of the DGIP application or have additions or further limitations of specific features resulting that the claims of the KIPO application fall within the scope of the claims of the DGIP application.

Claims of the KIPO application which introduces a new/different category of claims to those claims indicated as allowable in the DGIP application are NOT considered to sufficiently correspond. For example, where the claim of the DGIP application is directed to a manufacturing process, and the claim of the KIPO application is directed to a product, the both claims are NOT considered to correspond to each other.

(2) The KIPO application is not necessary to include “all” claims determined to be patentable/allowable in the DGIP application (the deletion of claims is allowable). For example, where the DGIP application contains 5 claims determined to be patentable/allowable, the corresponding KIPO application may contain only 3 of the 5 claims. Refer to Annex II for specific cases of claims correspondence.

1.5 Regardless of whether examination of the KIPO application has begun or not, it is possible to participate in the PPH program

It is possible to participate in the PPH program regardless of whether examination has begun or not, provided that there has been no first office action issued at the time of the PPH request being filed.

1.6 Examination of the requested application for accelerated examination under the PPH program must have been requested by the applicant

A request for accelerated examination under the PPH program must be accompanied by, or preceded by a request for examination.

2. Documents Required to be Submitted to File a Request for Accelerated Examination under the PPH Pilot Program

An applicant must submit “A Request Form for Accelerated Examination” and “The Explanation of a Request for Accelerated Examination under the PPH Program”, accompanied by the documents 2.1 to 2.4 below (Refer to ANNEX III for “A Request Form for Accelerated Examination” and “The Explanation of a Request for Accelerated Examination under the PPH Program”).

2.1 A copy and translation of all claims determined to be patentable/allowable by the DGIP

(1) An applicant who files a request to participate in the PPH program is required to submit the copy of the claims determined to be patentable/allowable by the DGIP.

The copy of the claims determined to be patentable/allowable by the DGIP might be either:

i) a copy of claims submitted at the time of the filing of the DGIP application, where the DGIP application is determined to be patentable/allowable by the DGIP without amendment of the claims, or

ii) a copy of the amendment of the claims, where the amendment of the claims is determined to be patentable/allowable by the DGIP, or

iii) a copy of the DGIP's publication of the granted patent

(2) Korean or English is acceptable as a translation language. If it is impossible for the examiner to understand the translated claims due to inadequate translation, the examiner can request the applicant to resubmit translations. It should be noted that a request for the PPH program is not rejected on the basis that the translation is not sufficient to understand the scope of the claims.

2.2 Copies and translations of all office actions issued by the DGIP

(1) An applicant who files a request to participate in the PPH program is required to submit copies of the office actions issued by the DGIP.

“Office actions” means documents which relate to substantive examination and which were sent to an applicant from the DGIP examiner.

The office actions issued by the DGIP are communications of the examiner such as the final decision to grant a patent, or the most recent non-final office action or a decision of rejection issued on the patent application, however, which indicates that any claim or claims are allowable.

(2) Korean or English is acceptable as a translation language. If it is impossible for

the examiner to understand the translated office actions due to inadequate translation, the examiner can request the applicant to resubmit translations. It should be noted that a request for the PPH program is not rejected on the basis that the translation is not sufficient to understand the office actions.

2.3 Documents cited by the DGIP examiner

(1) The documents to be submitted are those cited by the DGIP in the office action for the reason of refusal. Documents which are only referred to as references and consequently do not take part of the reason for refusal do not have to be submitted.

(2) If the citation is a patent document, an applicant does not have to submit it because it is usually available to KIPO. However, if the citation is a non-patent literature, an applicant has to submit it.

In case where the KIPO examiner has a difficulty in obtaining a citation, he or she can ask the applicant to submit it. On the one hand, translation(s) of the citation(s) is not required to be submitted.

2.4 Claims correspondence table

(1) An applicant must submit a claims correspondence table to explain the correspondence between claims determined to be patentable/allowable by the DGIP and all claims in the KIPO application.

(2) An applicant must explain how all claims in the KIPO application sufficiently correspond to the patentable/allowable claims in the DGIP application in the table for each KIPO claim based on the criteria in "III.1.3 All claims in the KIPO application

must sufficiently correspond to one or more of those claims determined to be patentable/allowable by the DGIP" (Refer to Annex II for the cases of claims correspondence).

3. Fee for Participation in the PPH program

An applicant must pay the fee for accelerated examination under the PPH program, which is the same as for other requests for accelerated examination.

4. Notes on Examination Procedures

KIPO decides whether the application is eligible for accelerated examination under the PPH when it receives the request along with the documents stated above. When KIPO decides that the request is acceptable, the application is assigned a special status for accelerated examination under the PPH program.

KIPO does not notify the applicant of the acceptance of a request for accelerated examination under the PPH program. Instead, the applicant can recognize the process of the accelerated examination upon the receipt of office action(s) issued by KIPO in the examination process.

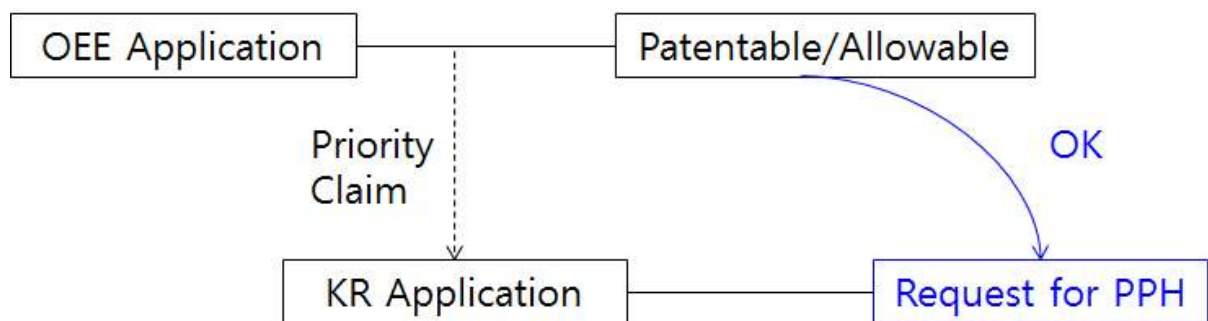
Where the request does not meet all the requirements set forth above, the applicant is notified thereof and identifies the defects in the request. The applicant may be given an opportunity to perfect the request or may be invited to submit a new request. If the PPH request is rejected, the applicant will be notified thereof and the application will await examination in its regular turn.

ANNEX I

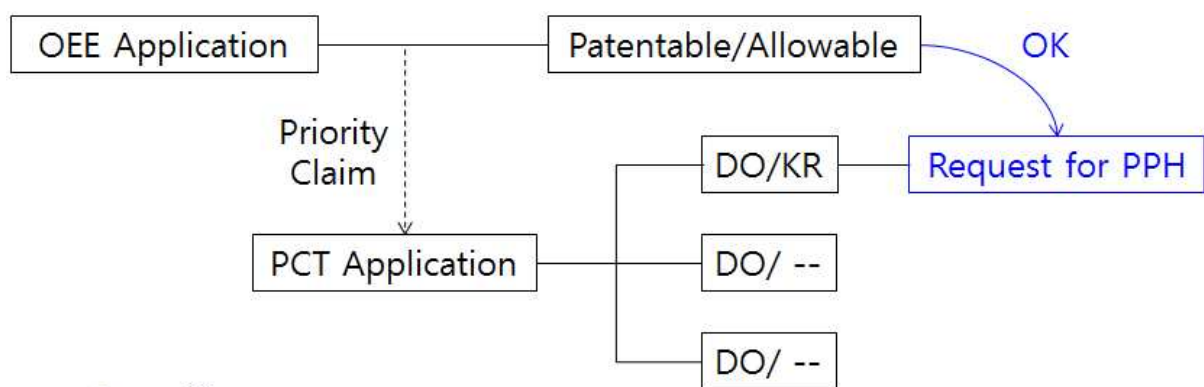
Examples of KIPO Application Eligible for the PPH Program

CASE I (Figures A, B, C and D)

KIPO application which validly claims priority under the Paris Convention from the OEE application(s).

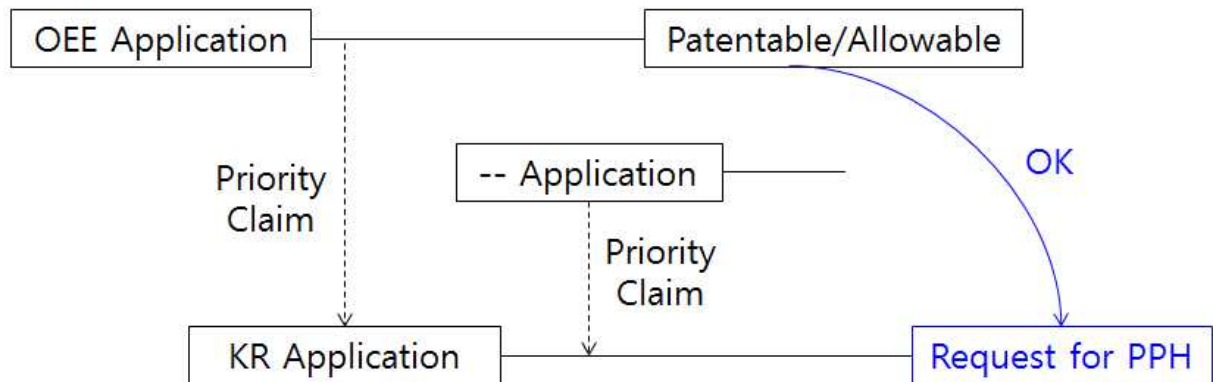


(A) Paris route



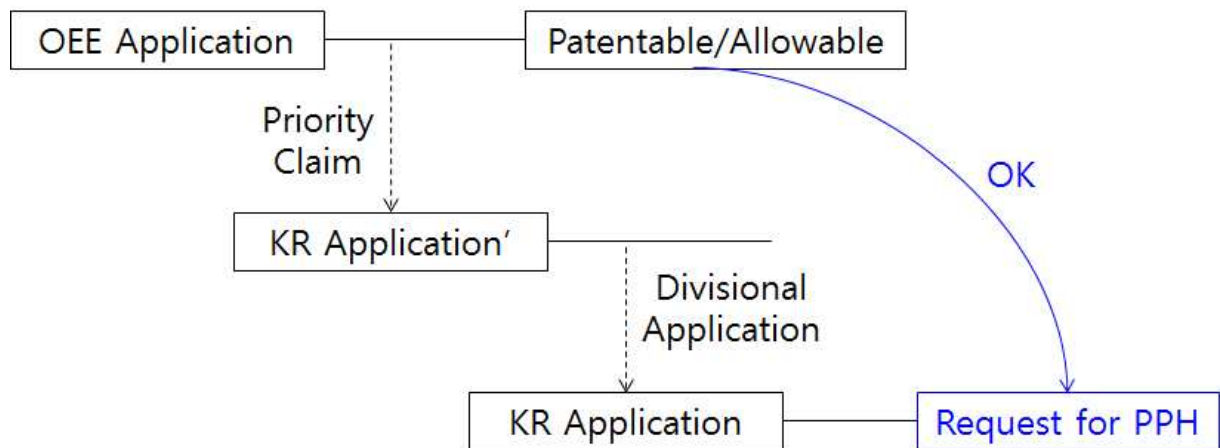
-- : Any office

(B) Paris route and PCT route



-- : Any office

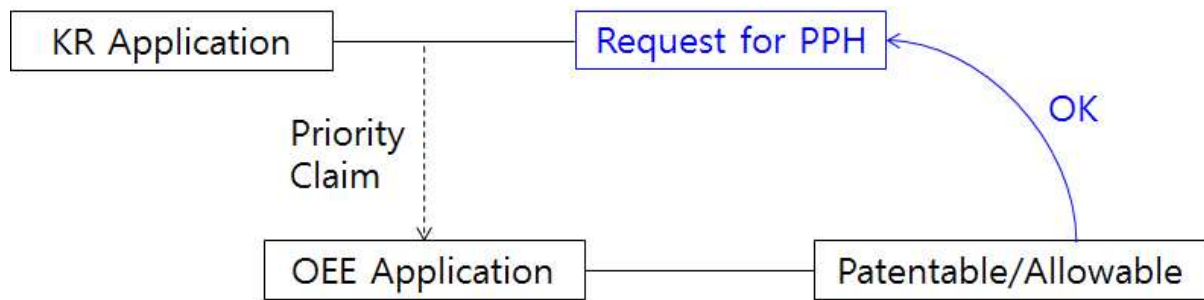
(C) Paris route and complex priority



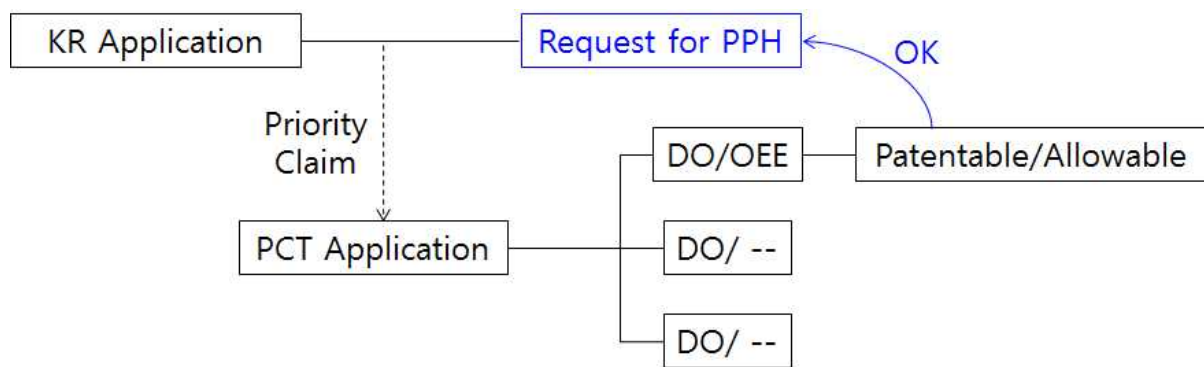
(D) Paris route and divisional application

CASE II (Figures E and F)

KIPOO application which provides the basis of a valid priority claim under the Paris Convention for the OEE application(s) (including PCT national phase application(s)).



(E) Paris route

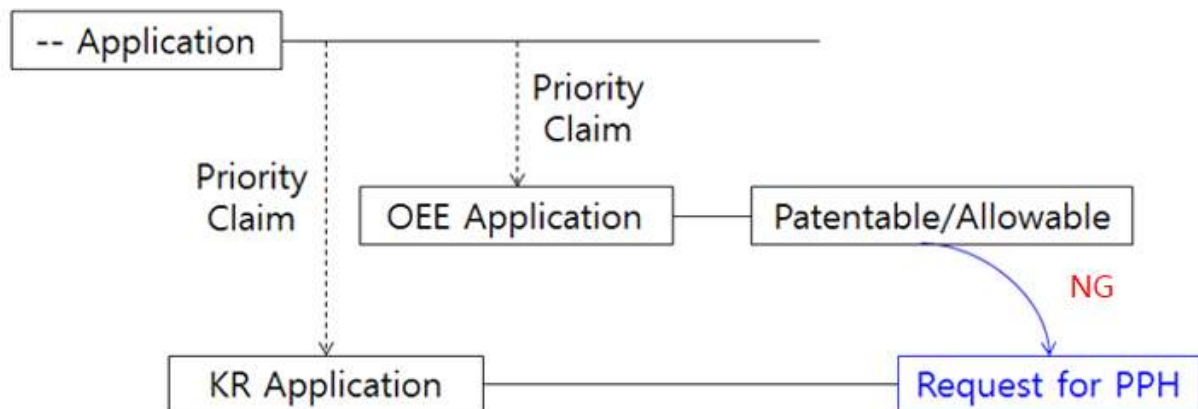


-- : Any office

(F) Paris route and PCT route

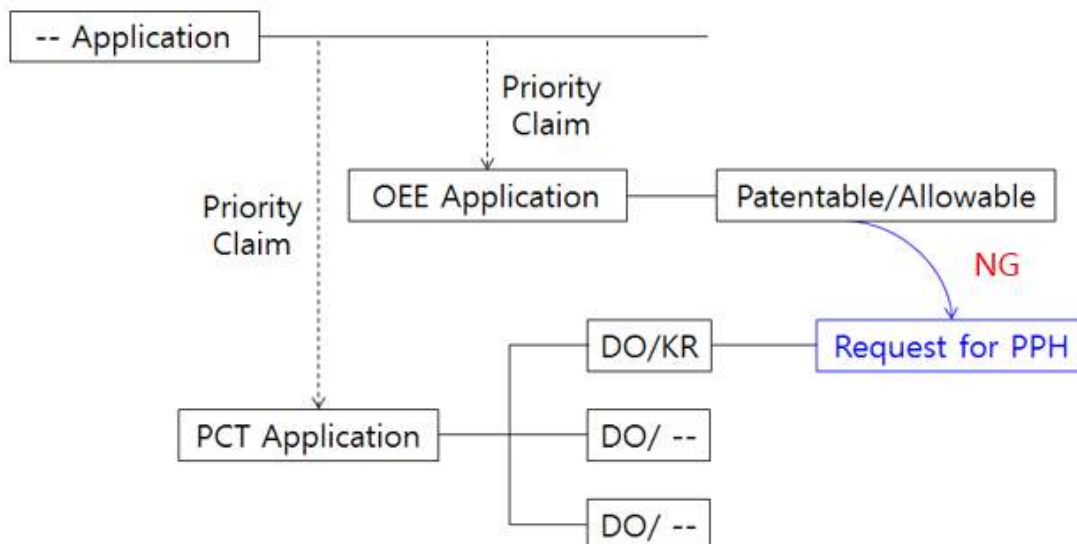
CASE III (Figures G, H, I, J, K and L)

KIPO application which shares a common priority document with the OEE application(s) (including PCT national phase application(s)).



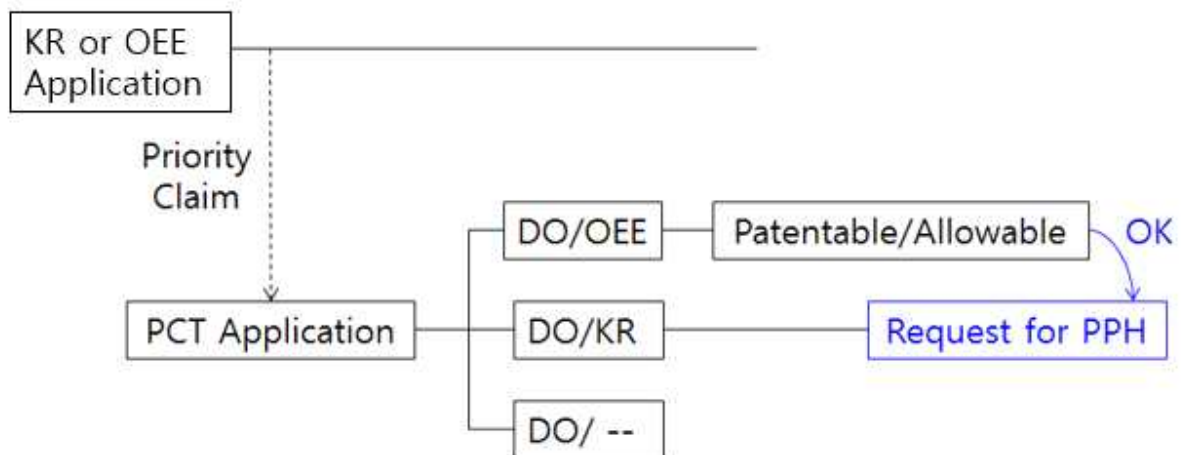
XX : the office other than the KIPO or OEE

(G) Paris route, but the first application is from the third country

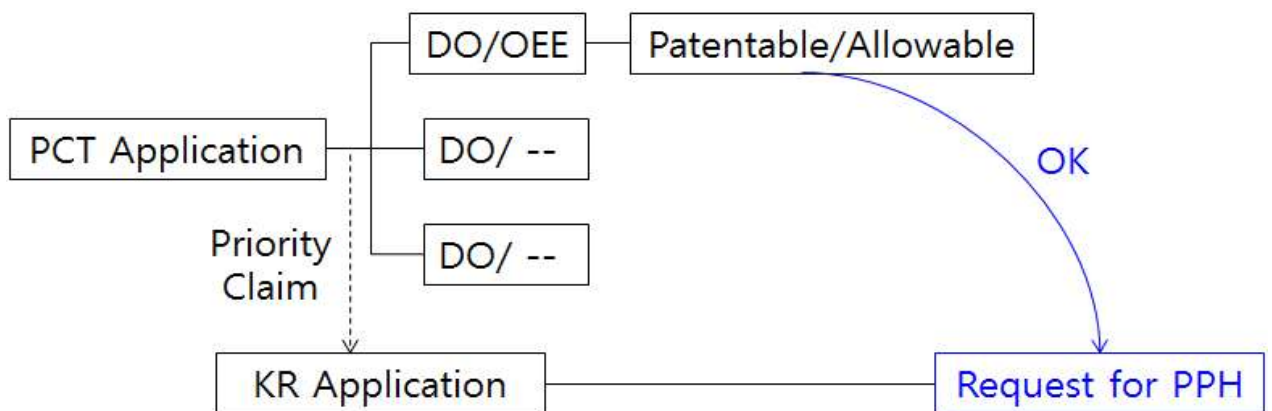


XX : the office other than the KIPO or OEE

(H) Paris route and PCT route, but the first application is from the third country.

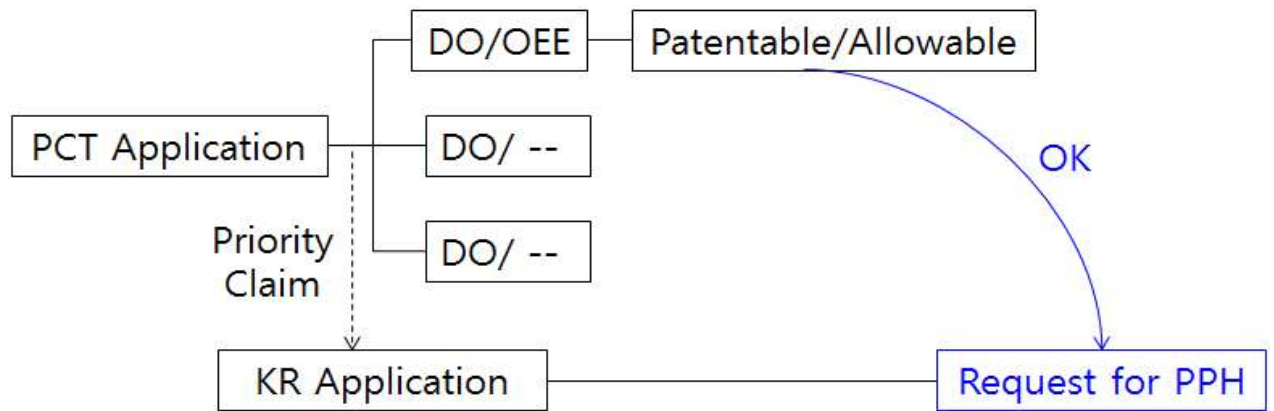


(I) PCT route



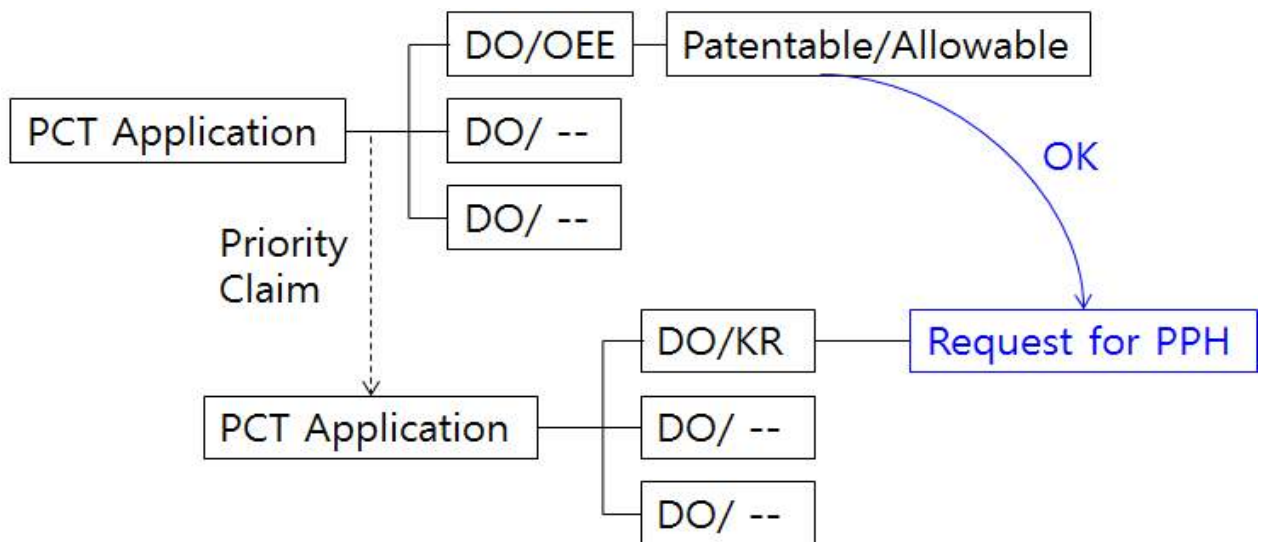
-- : Any office

(J) Direct PCT route and PCT route



-- : Any office

(K) Direct PCT route and Paris route

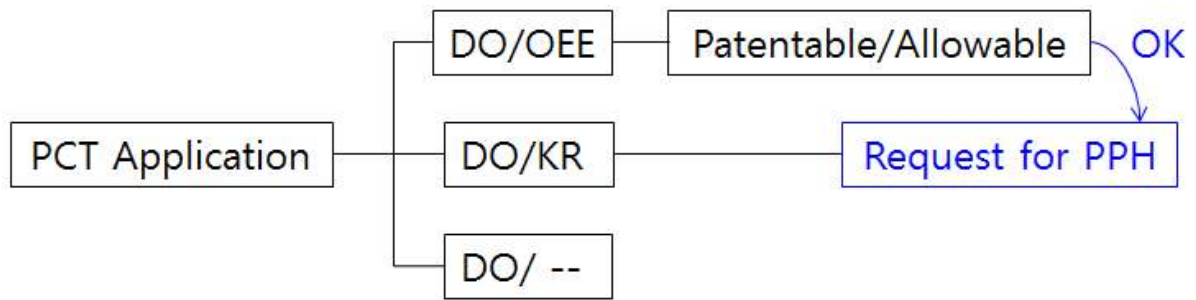


-- : Any office

(L) Direct PCT route and PCT route

CASE IV (Figure M)

A PCT national phase application where both the KIPO application and the OEE application(s) are derived from a common PCT international application with no priority claim.



-- : Any office

(M) Direct PCT route

ANNEX II

Cases for Claims Correspondence

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

Case	DGIP claim(s)		KIPO claim(s)		Claims correspondence
	Claim	Subject matter	Claim	Subject matter	
Case 1	1	A	1	A	Correspondence
Case 2	1	A	1 2	A A+a	Correspondence Claim 2 of the KIPO application adds a technical feature “a” to claim 1 of the DGIP application.
Case 3	1	A	1	A	Correspondence
	2	A+a	2	A+b	Correspondence except for the formats of the claims
	3	A+b	3	A+a	Correspondence except for the formats of the claims
Case 4	1	A	1	A+a	Claim 1 of the KIPO application adds a technical feature “a” to claim 1 of the DGIP application.

** 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 (cases 5 and 6) are NOT considered to “sufficiently correspond” to each other.

Case	DGIP claim(s)		KIPO claim(s)		Correspondence
	Claim	Subject matter	Claim	Subject matter	
Case 5	1	A system	1	A' method	The subject matter of the KIPO application is a method, whereas the subject matter of the DGIP application is a system. (The technical features in the DGIP claim are the same as those in the KIPO claim, but categories of both inventions are different)
Case 6	1	A+B	1	A+C	Claim of the KIPO application is different from the one of the DGIP application in technical features.

ANNEX III

“A Request Form for Accelerated Examination under the PPH Program”

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

【구분】 우선심사신청 (A 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 A Request for Accelerated Examination under the Patent Prosecution Highway Program)

【서류명】 특허심사하이웨이(PPH)에 의한 우선심사신청설명서

(Explanation of A Request for Accelerated Examination under the Patent Prosecution Highway Program)

【대상국가등】 (Office of Earlier Examination; OEE)

【본원출원번호】 (Application Number)

【대응출원번호】 (Application Number of Corresponding Application)

【본원출원과 대응출원의 관계】 (Relationship between the Present Application and the Corresponding Application)

【제출서류】 (Required Documents)

【특허가능하다고 판단된 특허청구범위】 (Patentable Claims in OEE)

【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)

【심사관련통지서】 (Office Action in OEE)

【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)

【심사단계에서 인용된 선행기술문헌】 (Prior Arts cited in the Office Action of OFF)

【명칭】 (Title)

【제출여부】 (Submit, Y/N)

【제출생략 이유】 (Reasons of Exemption)

【청구항간 대응관계설명표】 (Claims Correspondence Table)

본원출원의 청구항 번호 (Claim Number)	대응출원에서 특허가능하다고 판단한 청구항 번호 (Claim Number of OEE)	대응관계 설명 (Correspondence)