

Patent Prosecution Highway Pilot Programme between the Intellectual Property Office of Singapore and the Korean Intellectual Property Office

1. Background

To obtain patent protection for an invention in several countries usually requires the invention to be searched and examined in each of the countries. If the patent authorities in these countries were to share the results of their search and/or examination with each other, the opportunity for a patent office to make reference to earlier work done could have several potential benefits:

- Reduced work – Reference to the earlier work done could reduce or even eliminate the need for subsequent search and examination work.
- Faster prosecution – The reduced work could generally lead to a faster prosecution of the patent application.
- Better search and examination – The other patent authorities might have access to databases unavailable (eg specific technical databases, local databases, databases in other languages) to the examiner, therefore the opportunity to refer to these search and examination results could provide the examiner with information on and assessment of prior art that he or she would otherwise not have access to.

2. Patent Prosecution Highway Programme

2.1 The Patent Prosecution Highway (PPH) programme between the Intellectual Property Office of Singapore (IPOS) and the Korean Intellectual Property Office (KIPO) is one way for the two offices to share their search and examination results with each other.

2.2 Where IPOS is the Office of First Filing (OFF) and the Singapore (SG) application contains claims that are determined to be allowable/patentable, the applicant may request accelerated examination at the KIPO for the corresponding application filed with the KIPO as the Office of Second Filing (OSF). The requirements and procedures for filing a request with the KIPO for participation in the PPH pilot programme are available from the KIPO website at:

http://www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=100016&catmenu=e_k02_02_03

2.3 Where the KIPO is the OFF and the final results of the search and examination or the patent grant of the Korea (KR) application are available, the applicant may request accelerated prosecution of the corresponding application filed with IPOS as the OSF by furnishing certain prescribed information of the KR application as set out in the procedures and requirements below. For the avoidance of doubt, the applicant is required to provide all necessary documents to IPOS, and not request that IPOS obtain documents from the Dossier Access System (DAS) of KIPO, K-PION: <http://k-pion.kipo.go.kr>

3. **Pilot Period for the PPH programme**

The PPH pilot programme commences on 1 January 2013, for a period of 2 years ending on 1 January 2015. This period may be extended for up to an additional year if necessary to adequately assess the feasibility of the PPH programme. IPOS and the KIPO will evaluate the results of the pilot programme to determine whether and how the programme should be fully implemented after the pilot period. The Offices may also terminate the PPH pilot programme early if the volume of participation exceeds manageable level, or for any other reason. Notice will be published if the PPH pilot programme will be terminated before 1 January 2015.

4. **Requirements and procedures for requesting accelerated prosecution of a Singapore patent application**

4.1 **Requirement 1**

The following are the scenarios in which a request for accelerated prosecution of a Singapore application under the PPH pilot programme at IPOS can be made:

- (1) The SG application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from the KR application being relied upon for the PPH request. **[See Diagram 1]**
- (2) The SG application is a divisional application of the SG application referred to in (1) above, and the said divisional application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from the KR application being relied upon for the PPH request. **[See Diagram 2]**
- (3) The SG application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from a KR application, and the KR application being relied upon for the PPH request also validly claims priority under KR law from the said earlier KR application. **[See Diagram 3]**
- (4) The SG application is a divisional application of the SG application referred to in (3) above, and the said divisional application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from a KR application, and the KR application being relied upon for the PPH request also validly claims priority under KR law from the said earlier KR application. **[See Diagram 4]**
- (5) The SG application is a national phase entry of a PCT application, and the SG application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from a KR national application, and it is this KR national application that is being relied on for the PPH request. **[See Diagram 5]**
- (6) The SG application is a national phase entry of a PCT application, and the SG application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from a KR national application. The KR application being relied upon for the PPH request is a national phase entry of the same PCT application, and the KR application being relied upon for the PPH request validly claims priority under KR law from said KR national application. **[See Diagram 6]**

- (7) There is a first PCT application. There is a second PCT application validly claiming priority from the first PCT application. The SG application is a national phase entry of the second PCT application, and the SG application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from the first PCT application. The KR application being relied upon for the PPH request is a national phase entry of the second PCT application, and the KR application validly claims priority under KR law from the first PCT application. **[See Diagram 7]**

4.2 Diagrams depicting the above scenarios are in the Annex.

4.3 **Requirement 2**

The SG application has not had a valid Patents Form 11C (Notice of Intention to Rely on International Preliminary Report on Patentability) filed, or has not been issued an examination report or a search and examination report pursuant to a Patents Form 12/12(2004) (Request for an Examination Report) filed or a Patents Form 11/11(2004) (Request for a Search and Examination Report) filed, respectively¹.

4.4 **The Procedures**

- (1) File duly completed Patents Form 11B/11B (Furnishing of Prescribed Information) and Patents Form 14/14(2004)² (Payment of Fee for Grant of a Patent). These forms can be found at:

<http://www.ipos.gov.sg/Services/FilingandRegistration/FormsandFees/Patents.aspx>

- (2) The Patents Form 11B/11B(2004) must be accompanied by either:

- a. a copy of the granted patent of the KR application being relied upon, duly certified by the KIPO or otherwise acceptable to the Registrar; or
- b. documents setting out the final results of the search and examination as to substance and a copy of the patent claims referred to in the final results of the KR application being relied upon.

- (3) If the forms are submitted electronically (whether online or on electronic media), the phrase "IPOS-KIPO PPH acceleration requested" must be inserted in the "Remarks" box of the forms.

- (4) If the forms are submitted on paper via the Service Bureau, a cover letter must be submitted with the forms. The cover letter must contain in its title, the phrase "IPOS-KIPO PPH acceleration requested".

- (5) All subsequent correspondences with IPOS must be similarly marked with the phrase "IPOS-KIPO PPH acceleration requested".

4.5 Singapore applications which request accelerated prosecution under the PPH pilot programme will be processed in accordance with the Singapore Patents Act (Cap. 221)

¹ The non "2004" forms are to be used for Singapore applications with a date of filing before 1 July 2004. The "2004" forms are to be used for Singapore applications with a date of filing on or after 1 July 2004.

² Ibid

and the Singapore Patents Rules. The legislations can be found at: <http://www.ipos.gov.sg/AboutIP/IPLegislation.aspx>

- 4.6 Applicants should seek professional advice on patent matters in Singapore, in particular, with reference to section 30 (Grant of patent) and section 69 (Restrictions on relief for infringement) of the Singapore Patents Act (Cap. 221).

5. Enquiries

For enquiries relating to the Patent Prosecution Highway pilot programme between IPOS and the KIPO, please contact Ms Linda Bernadatte Mitchell of IPOS via telephone (65) 63308 609 or email linda_bernadatte_mitchell@ipos.gov.sg with the subject heading "IPOS-KIPO PPH".

INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
DATE: 1 January 2013

Diagrams of SG applications that fall under Scenario (1):

Diagram 1: The SG application validly claims priority under section 17 of the Singapore Patents Act (Cap. 221) from the KR application being relied upon for the PPH request.

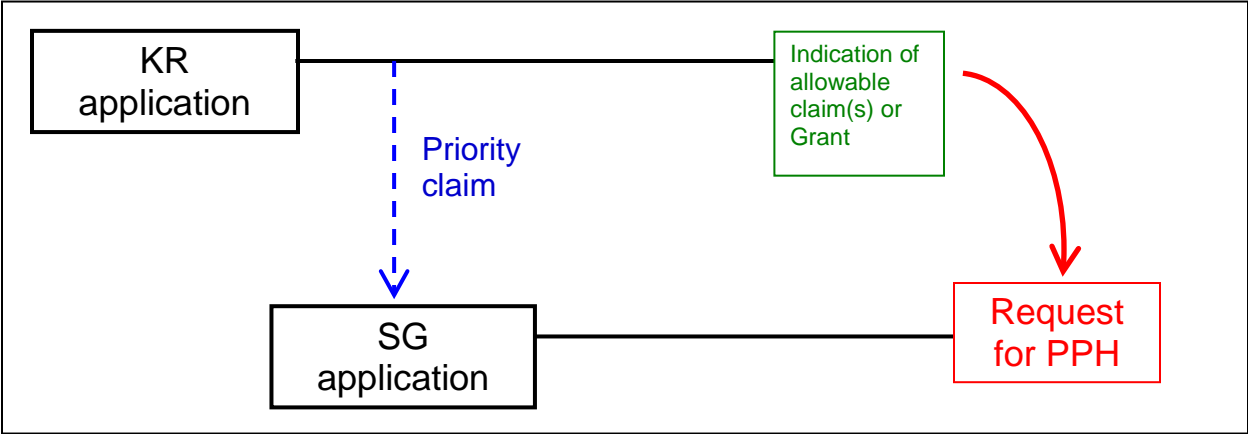


Diagram of SG applications that fall under Scenario (2):

Diagram 2: The SG application is a divisional application of the SG application referred to in (1) above, and said divisional application validly claims priority under section 17 of the Singapore Patents Act (Cap.221) from the KR application being relied upon for the PPH request.

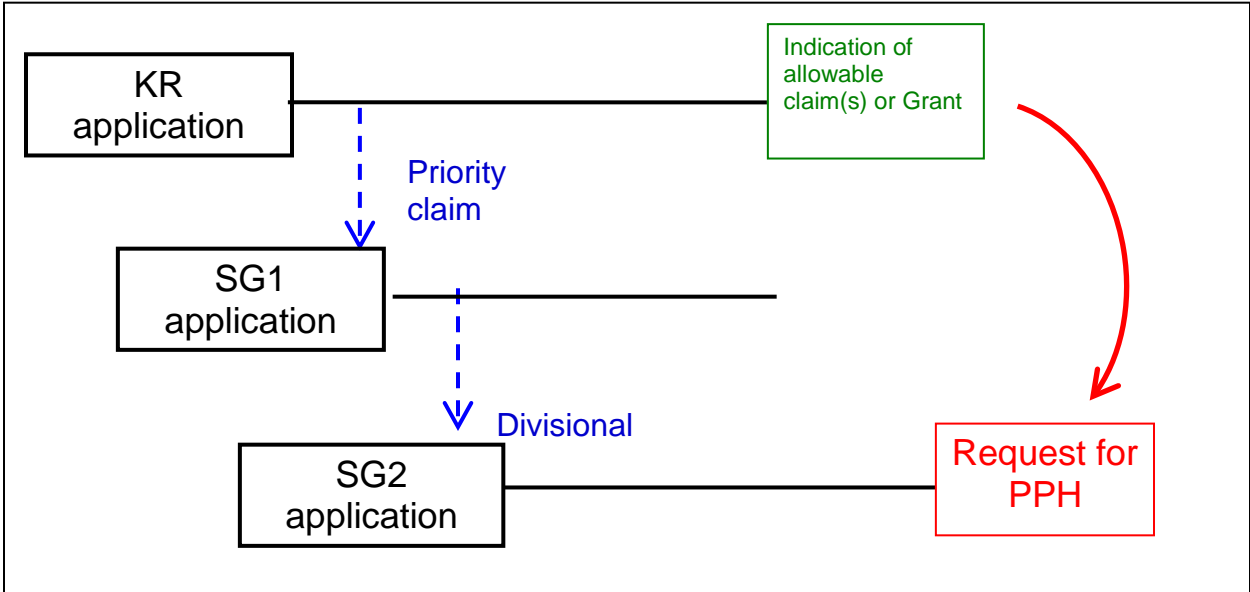


Diagram of SG applications that fall under Scenario (3):

Diagram 3: The SG application validly claims priority under section 17 of the Singapore Patents Act (Cap.221) from a KR application, and the KR application being relied upon for the PPH request also validly claims priority under KR law from said earlier KR application.

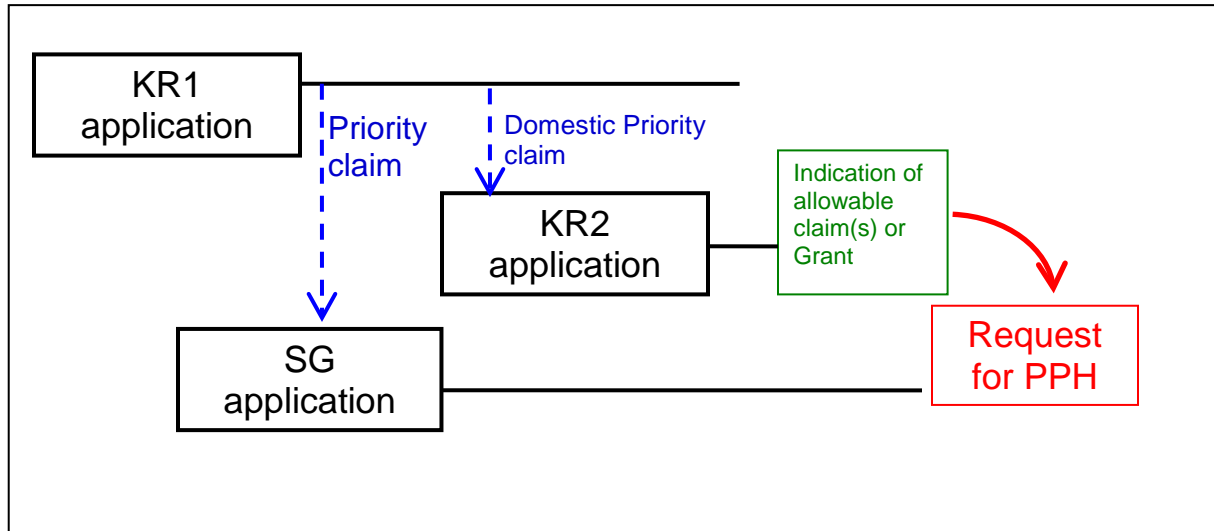


Diagram of SG applications that fall under Scenario (4):

Diagram 4: The SG application is a divisional application of the SG application referred to in (3) above, and said divisional application validly claims priority under section 17 of the Singapore Patents Act (Cap.221) from a KR application, and the KR application being relied upon for the PPH request also validly claims priority under KR law from said earlier KR application.

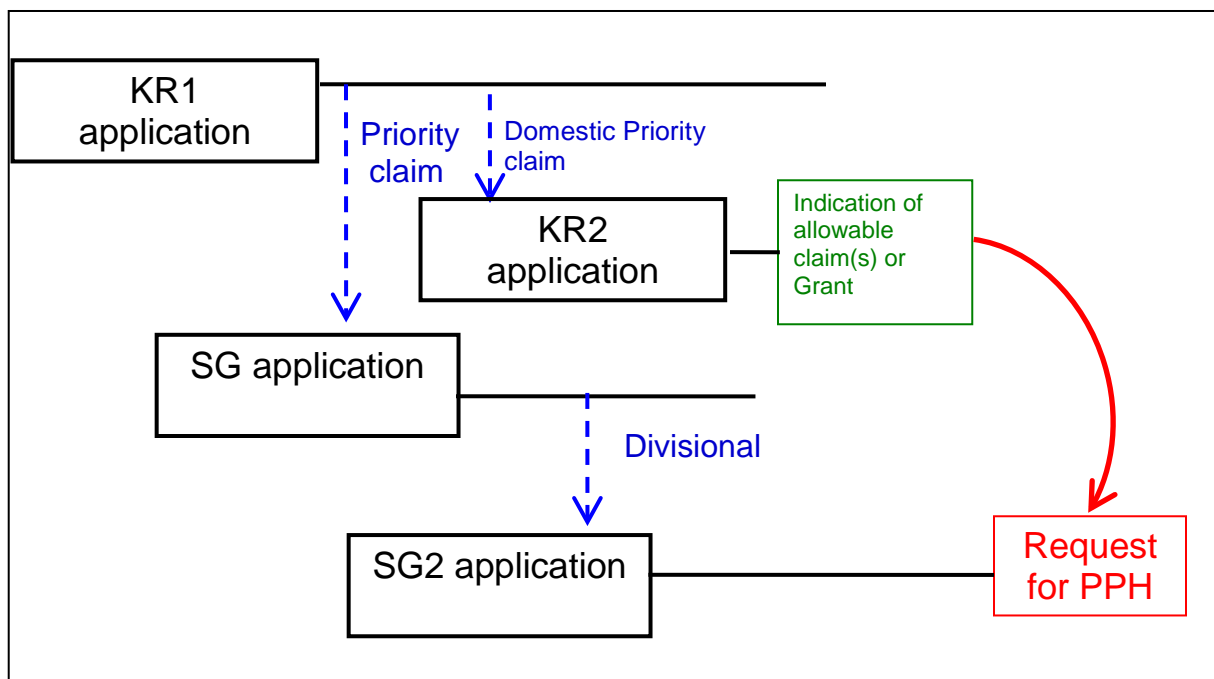


Diagram of SG applications that fall under Scenario (5):

Diagram 5: The SG application is a national phase entry of a PCT application, and the SG application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from a KR national application, and it is this KR national application that is being relied on for the PPH request.

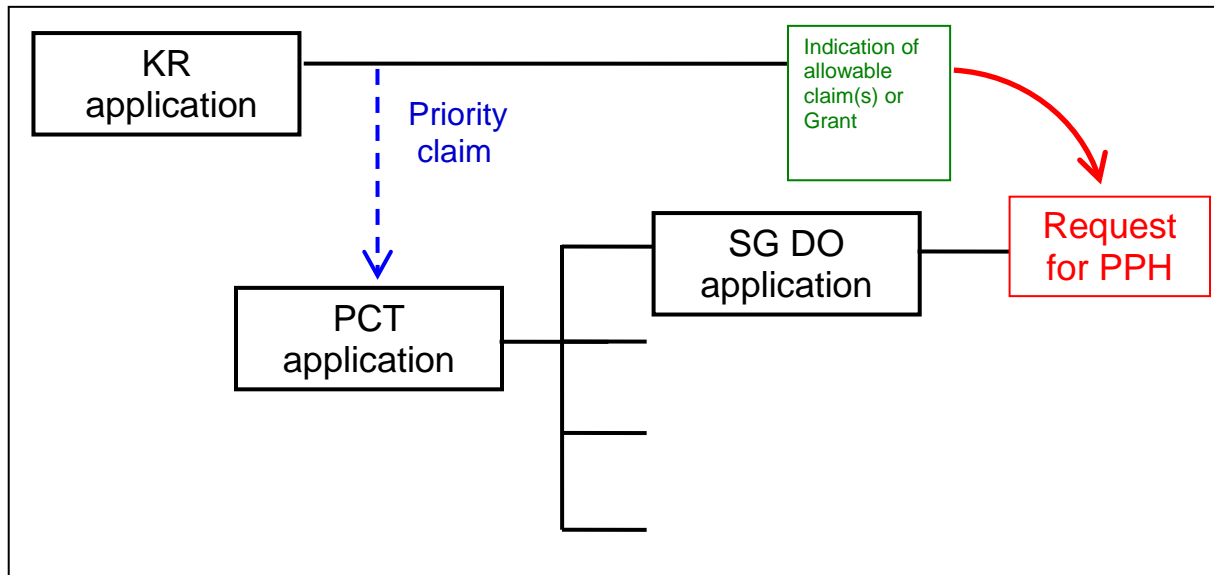


Diagram of SG applications that fall under Scenario (6):

Diagram 6: The SG application is a national phase entry of a PCT application, and the SG application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from a KR national application. The KR application being relied upon for the PPH request is a national phase entry of the same PCT application, and the KR application being relied upon for the PPH request validly claims priority under KR law from said KR national application.

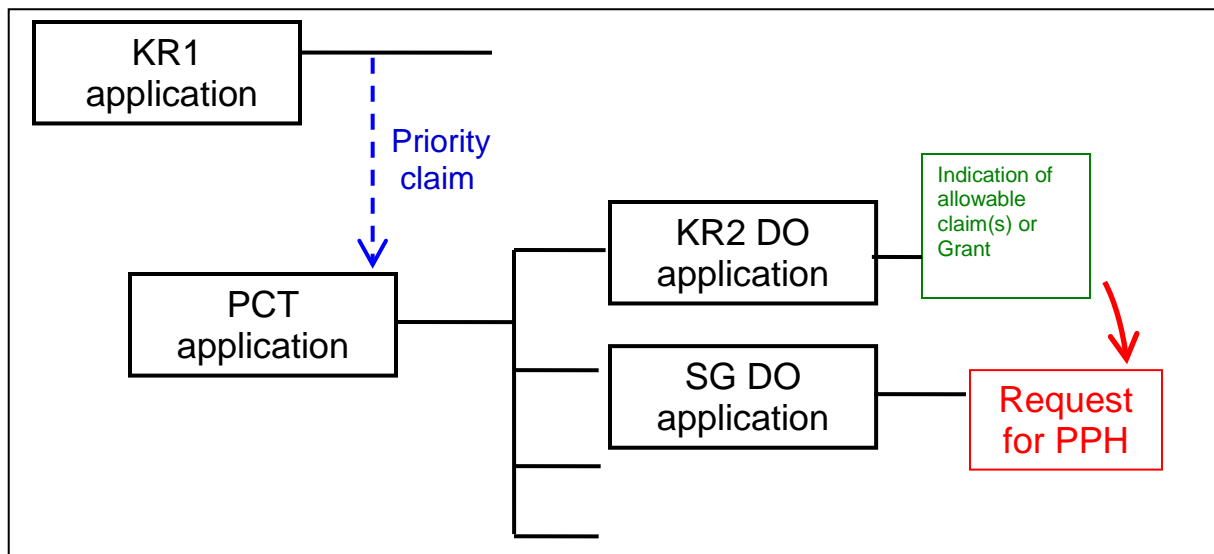


Diagram of SG applications that fall under Scenario (7):

Diagram 7: There is a first PCT application. There is a second PCT application validly claiming priority from the first PCT application. The SG application is a national phase entry of the second PCT application, and the SG application validly claims priority under section 17 and section 87 of the Singapore Patents Act (Cap. 221) from the first PCT application. The KR application being relied upon for the PPH request is a national phase entry of the second PCT application, and the KR application validly claims priority under KR law from the first PCT application.

