

Procedures to file a request to the Patent Office of the Republic of Poland (PPO) under the Patent Prosecution Highway (PPH) Pilot Program between the PPO and the State Intellectual Property Office of the People's Republic of China (SIPO)

The pilot period of this PPH pilot program will commence on 1 July, 2013 for duration of two years and end on 30 June, 2015. The pilot period may be extended if necessary until the SIPO and PPO receive the sufficient number of PPH requests to adequately assess the feasibility of PPH program.

The Offices may also terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.

Part I

PPH using the national work products from the SIPO

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the PPO and satisfies the following requirements under the PPO-SIPO PPH pilot program based on the SIPO application.

When filing a request for the PPH pilot program, an applicant must submit a request form "Request for Participation in the Patent Prosecution Highway Program" to the PPO.

1. Requirements

- (a) *The PPO application (including PCT national phase application) is*
- i) *an application which validly claims priority under the Paris Convention to the SIPO application(s) (examples are provided in ANNEX I, Figure A, B, C, F, G and H), or*
 - ii) *a PCT national phase application without priority claim (examples are provided in Annex I, Figure I and K), or*
 - iii) *an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in ANNEX I, Figure J and L).*

The PPO application, which validly claims priority to multiple SIPO or direct PCT applications, or which is the divisional application validly based on the originally filed

application that is included in (i) to (iii) above, is also eligible.

- (b) *At least one corresponding application exists in the SIPO and has one or more claims that are determined to be patentable/allowable by the SIPO.***

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the SIPO application which forms the basis of the priority claim (e.g., a divisional application of the SIPO application or an application which claims domestic priority to the SIPO application (see Figure C in Annex I)), or a SIPO national phase application of a PCT application (see Figures H, I, J, K and L in Annex I).

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 claims in the PPO application (for which an accelerated examination under the PPH pilot program is requested), as originally filed or as amended, must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the SIPO.***

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

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

A claim in the PPO which introduces a new/different category of claims to those claims determined to be patentable/allowable in the SIPO is not considered to sufficiently correspond. For example, the SIPO claims only contain claims to a process of manufacturing a product, then the claims in the PPO are not considered to sufficiently correspond if the PPO 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 SIPO in an application in the PPO (the deletion of claims is allowable). For example, in the case where an application in the SIPO contains 5 claims determined to be patentable/allowable, the application in the PPO may contain only 3 of these 5 claims.

Any claims amended or added after the grant of the request for participation in the PPH pilot program need to sufficiently correspond to the claims indicated as patentable/allowable in the SIPO application when applicants have not received any office action related to substantive examination. 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 when applicants need to amend claims in order to overcome the reasons for refusal raised by examiners. Any amendment outside of the claim correspondence requirement is subject to examiners’ discretion.

Note that any applicant to the PPO may amend the application before the grant of the request for participation in the PPH pilot program including its claims on its or his own initiative but claims in the PPO application must correspond to the claims determined to be patentable/allowable in the SIPO.

(d) *The PPO has not begun examination of the application at the time of request for the PPH.*

The applicant should have not received any office action issued from the substantive examination departments in the PPO before or when filing the PPH request.

(e) *The PPO application may be electronic or paper patent application.*

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to “Request for Participation in the Patent Prosecution Highway Program”.

Note that even when it is not needed to submit certain documents below, the name of the documents must be listed in the “Request for Participation in the Patent Prosecution Highway Program”.

(a) Copies of all office actions (which are relevant to substantive examination for patentability in the SIPO) which were issued for the corresponding application by the SIPO, and translations of them.

Either Polish or English is acceptable as translation language. If it is impossible for the examiner to understand the translated office action, the examiner can request the applicant to resubmit translations.

(b) Copies of all claims determined to be patentable/allowable by the SIPO, and translations of them.

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

(c) Copies of references cited by the SIPO examiner

The documents to be submitted are those cited in the above-mentioned office actions. 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 references are patent documents, the applicant does not have to submit them¹. When the PPO does not possess the patent document, the applicant has to submit the patent document at the examiner’s request. Non-patent literature must always be submitted. The translations of the references are unnecessary.

(d) Claim correspondence table

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the PPO application sufficiently correspond to the patentable/allowable claims in the SIPO application.

When claims are just literal translation, the applicant can just write down that “they are the same” in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim based on the criteria 1.(c).

¹ Note that even when it is not needed to submit copies of references, the name of the references must be listed in the “Request for Participation in the Patent Prosecution Highway Pilot Program”.

When the applicant has already submitted above documents (a) to (d) to the PPO through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

3. “Request for Participation in the Patent Prosecution Highway Program” for filing request of an accelerated examination under the PPH pilot program

(a) Circumstances

When an applicant files a request for an accelerated examination under the PPH pilot program to the PPO, the applicant must submit a request form “Request for Participation in the Patent Prosecution Highway Program”.

The applicant must indicate that the application is included in (i) to (iii) of 1.(a), and that the accelerated examination is requested under the PPH pilot program. The application number, publication number, or a patent number of the corresponding SIPO application(s) also must be written.

In the case that the application which has one or more claims that are determined to be patentable/allowable is different from the SIPO application(s) included in (i) to (iii) of 1.(a) (for example, the divisional application of the basic application), the application number, publication number, or a patent number of the application(s) which has claims determined to be patentable/allowable and the relationship between those applications also must be explained.

(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 can file the “Request for Participation in the Patent Prosecution Highway Program” to the PPO either on-line or in paper.

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

The PPO 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 PPO 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 may be

given opportunity, one time only, to correct certain specified defects. If the request is not approved, the applicant may resubmit the request up to one time. If the resubmitted request is still not approved, the applicant will be notified and the application will await action under regular procedure.

If the request for accelerated examination is granted, PPO will send an acceptance notification to the applicant.

Part II

PPH using the PCT international work products from the SIPO

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the PPO and satisfies the following requirements under the PPO-SIPO Patent Prosecution Highway pilot program based on PCT international work products (PCT-PPH pilot program).

When filing a request for the PCT-PPH pilot program, an applicant must submit a request form "Request for Participation in the Patent Prosecution Highway Pilot Program" to the PPO.

1. Requirements

The application which is filed with the PPO and on which the applicant files a request under the PCT-PPH must satisfy the following requirements:

- (1) 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 the SIPO, but, if priority is claimed, the priority claim can be to an application in any Office, see example A' in Annex II (application ZZ can be any national application). The applicant cannot file a request under 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 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.

- (2) The relationship between the application and the corresponding international application satisfies one of the following requirements:**
- (A) The application is a national phase application of the corresponding international application. (See Figures A, A', and A'' in Annex II)**
 - (B) The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex II)**
 - (C) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)**
 - (D) The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure D in Annex II)**
 - (E) The application is the derivative application (divisional application and application claiming domestic priority etc.) of the application which satisfies one of the above requirements (A) – (D). (See Figures E1 and E2 in Annex II)**
- (3) 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 necessary to include “all” claims determined to be patentable/allowable in the corresponding international application in an application in the PPO (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 in the PPO may contain only 3 of these 5 claims.

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program need to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product when applicants have not received any office action related to substantive examination. 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 work product when applicants need to amend claims in order to overcome the reasons for refusal raised by examiners. Any amendment outside of the claim correspondence requirement is subject to examiners’ discretion.

Note that any applicant to the PPO may amend the application including its claims on its or his own initiative.

(4) The PPO has not begun examination of the application at the time of request for the PCT-PPH.

The applicant should have not received any office action issued from the substantive examination departments in the PPO before, or when, filing the PCT-PPH request.

(5) The application filed in PPO may be either electronic or paper patent application.

2. Documents to be submitted

The applicant must submit the following documents attached to the request form in filing a request under PCT-PPH. Some of the documents may not be required to submit in certain cases.

Note that even when it is not needed to submit certain documents below, the name of the documents must be listed in the “Request for Participation in the Patent Prosecution Highway Pilot Program”.

(1) A copy of the latest international work product which indicated the claims to be patentable/allowable and their Polish or English translations.

In case the application satisfies the relationship 1.(2)(A), the applicant need not 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 application². In addition, if the copy of the latest international work product and the copy of the translation are available via “PATENTSCOPE (registered trademark)”³, an applicant need not submit these documents, unless otherwise requested by the PPO.

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

If it is impossible for the examiner to understand the translated international work product, the examiner can request the applicant to resubmit translations.

(2) A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their Polish or English translations.

If the copy of the set of claims which are indicated to be patentable/allowable is available via “PATENTSCOPE (registered trademark)”⁴ (e.g., the international Patent Gazette has been published), an applicant need not submit this document unless otherwise requested by the PPO. Where the set of claims is written in Chinese, the translations thereof must be still submitted by an applicant.

If it is impossible for the examiner to understand the translated claims, the examiner can request the applicant to resubmit translations.

(3) A copy of references cited in the latest international work product of the international application corresponding to the application.

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 reference is a patent document, the applicant is not required to submit it⁵. In case the PPO 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.

² Note that even when it is not needed for the applicant to submit copies of the latest international work product and their translation, the name of the document must be listed in the “Request for Participation in the Patent Prosecution Highway Pilot Program”.

³ <http://www.wipo.int/pctdb/en/index.jsp>

⁴ <http://www.wipo.int/pctdb/en/index.jsp>

⁵ Note that even when it is not needed to submit copies of references, the name of the references must be listed in the “Request for Participation in the Patent Prosecution Highway Pilot Program”.

(4) A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable.

When claims are just literal translation, the applicant can just write down that “they are the same” in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim based on the criteria 1.(3).

When an applicant has already submitted the above mentioned documents (1) - (4) to the PPO through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

3. “Request for Participation in the Patent Prosecution Highway Pilot Program” for filing request of an accelerated examination under the PCT-PPH pilot program

(1) Circumstances

The applicant must indicate that the application is included in (A) to (E) of 1.(2), 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.

(2) Documents to be submitted

The applicant must list all required documents mentioned above 2. in an identifiable way, even when applicant omits to submit certain documents.

(3) Notice

An applicant can file the “Request for Participation in the Patent Prosecution Highway Program” to the PPO either on-line or in paper.

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

The PPO 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 the PPO 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 may be given opportunity, one time only, to correct certain specified defects. If the request is not approved, the applicant may resubmit the request up to one time. If the resubmitted request is still not

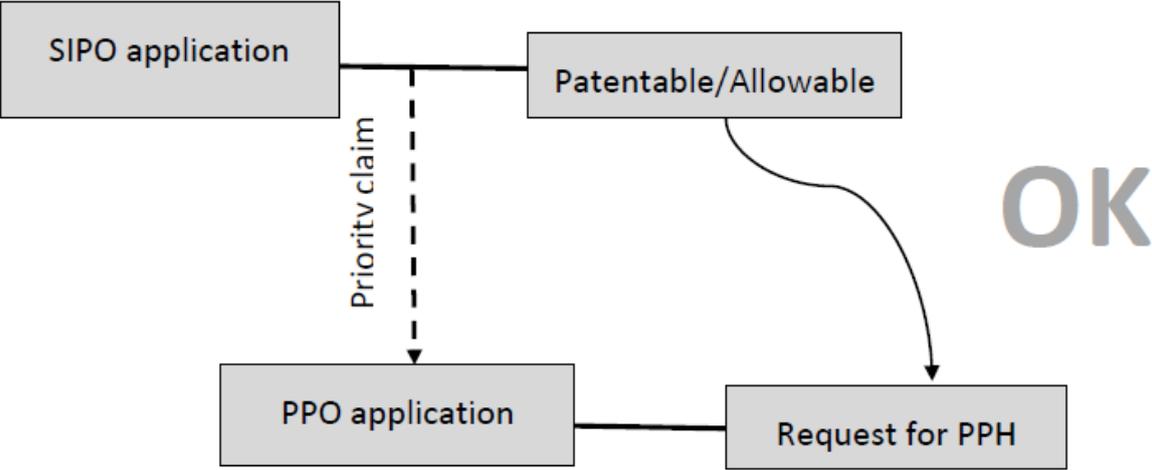
approved, the applicant will be notified and the application will await action in its regular turn. If the request for accelerated examination is granted, PPO will send an acceptance notification to the applicant.

ANNEX I

A

A case meeting requirement (a) (i)

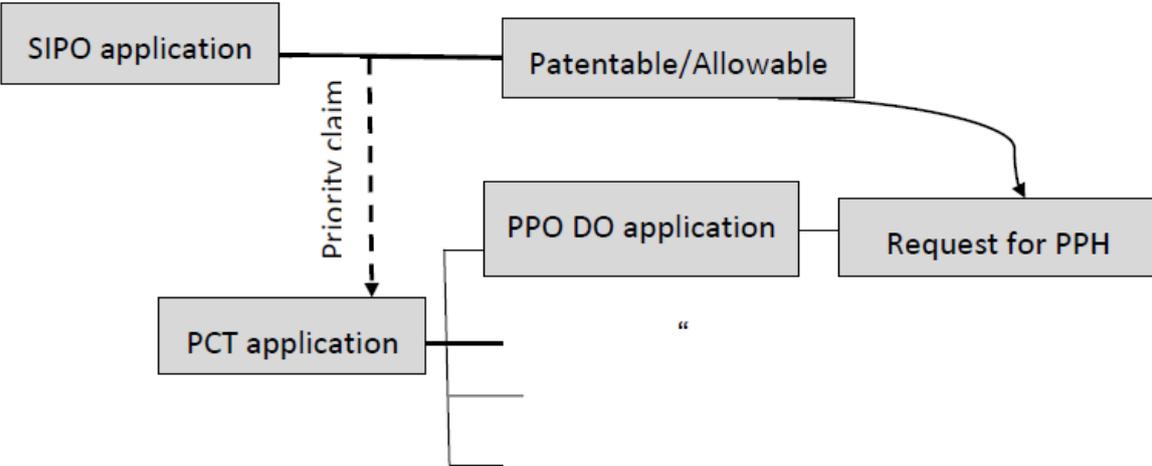
- Paris route -



B

A case meeting requirement (a) (i)

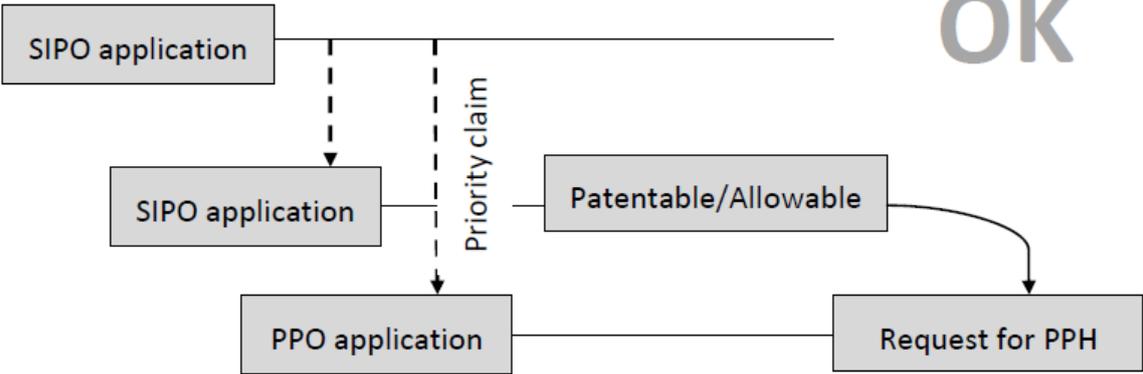
- PCT route -



ANNEX I

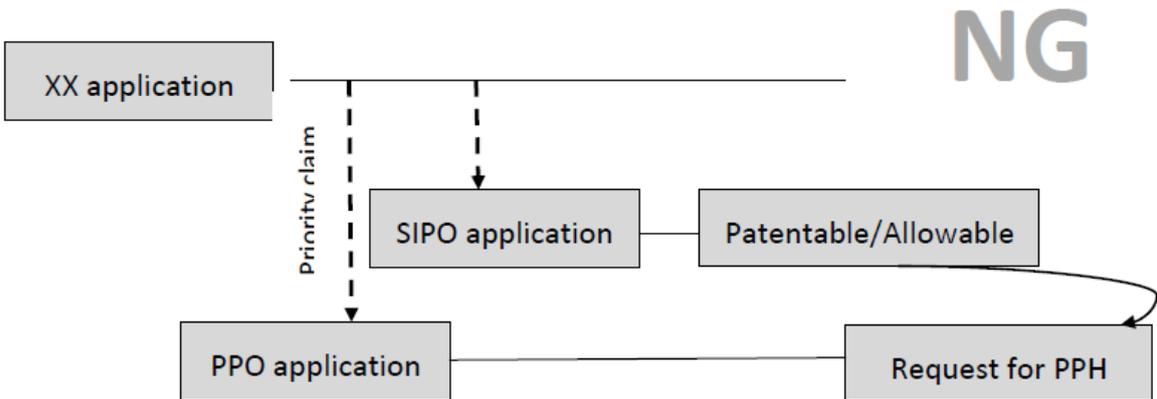
C

A case meeting requirement (a) (i)
- Paris route, Domestic priority -



D

A case not meeting requirement (a)
- Paris route, but the first application is from the third country -



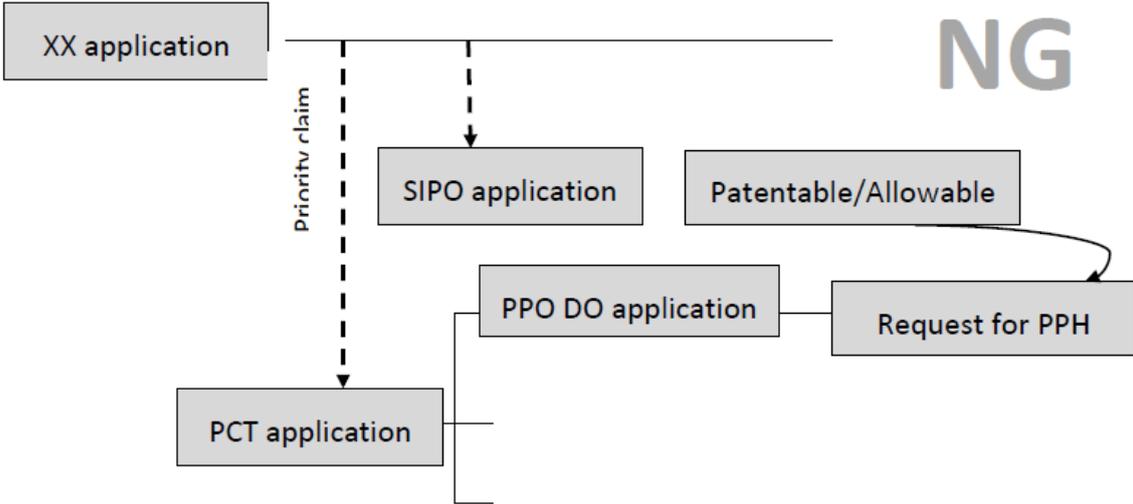
XX: the office other than the SIPO

ANNEX I

E

A case not meeting requirement (a)

- PCT route, but the first application is from the third country -

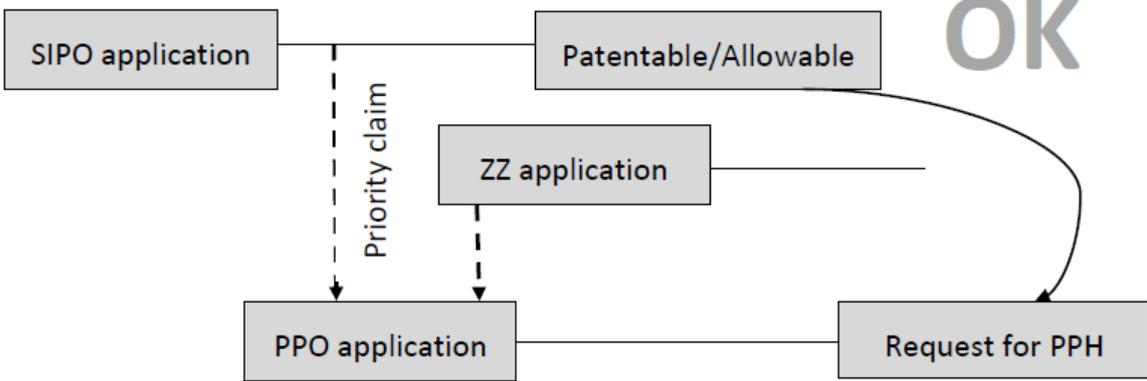


XX: the office other than the SIPO

F

A case meeting requirement (a) (i)

- Paris route & complex priority -



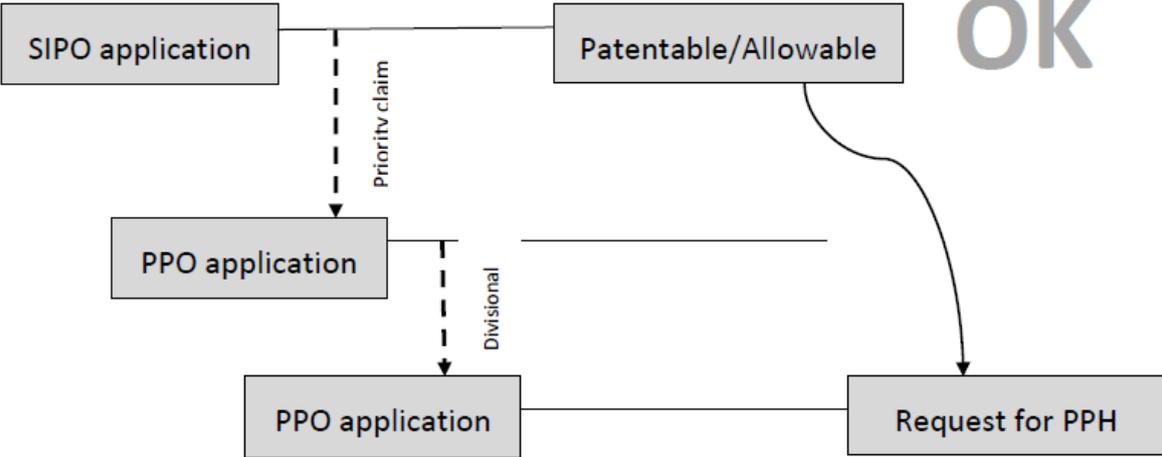
ZZ: any office

ANNEX I

G

A case meeting requirement (a) (i)

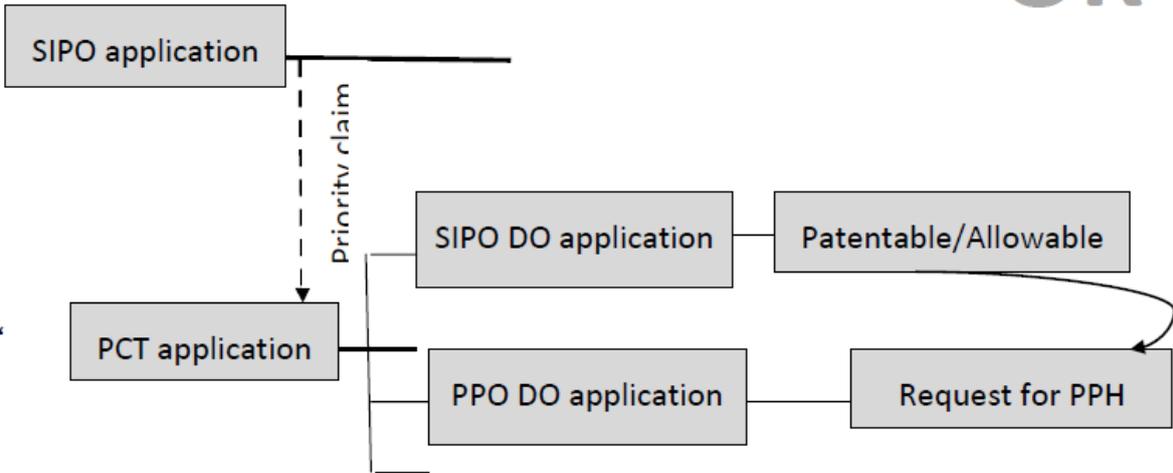
- Paris route & divisional application -



H

A case meeting requirement (a) (i)

- PCT route -



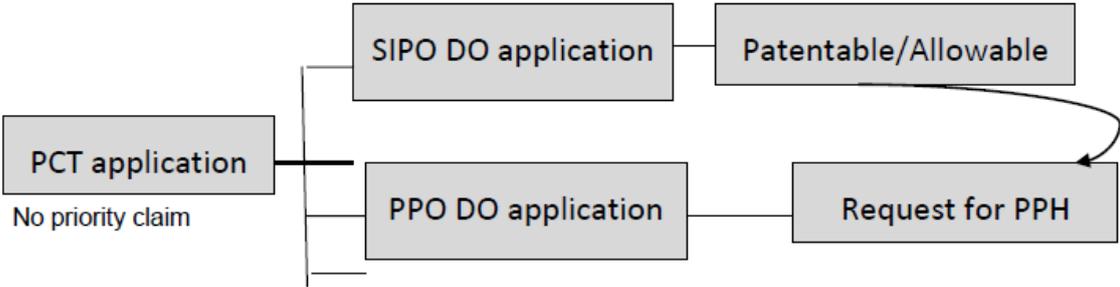
ANNEX I

I

A case meeting requirement (a) (ii)

- Direct PCT route -

OK

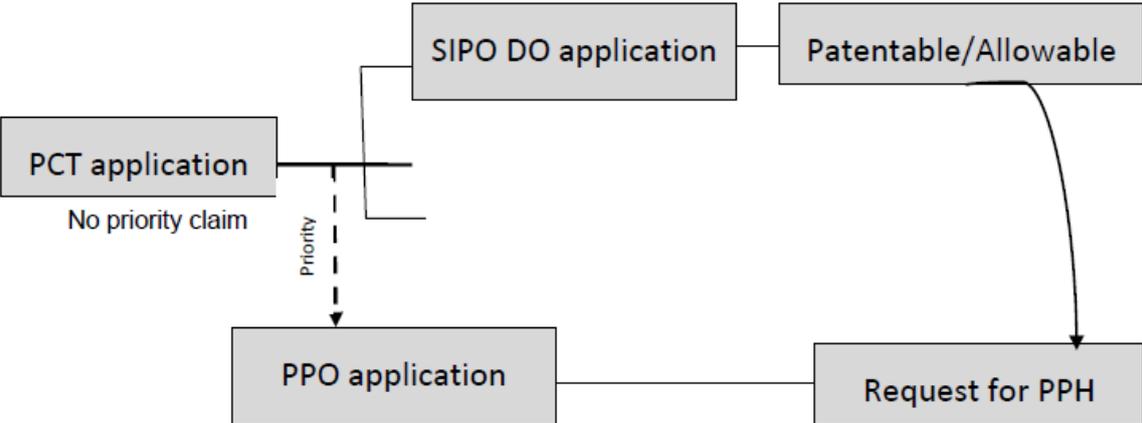


J

A case meeting requirement (a) (iii)

- Direct PCT & Paris route -

OK



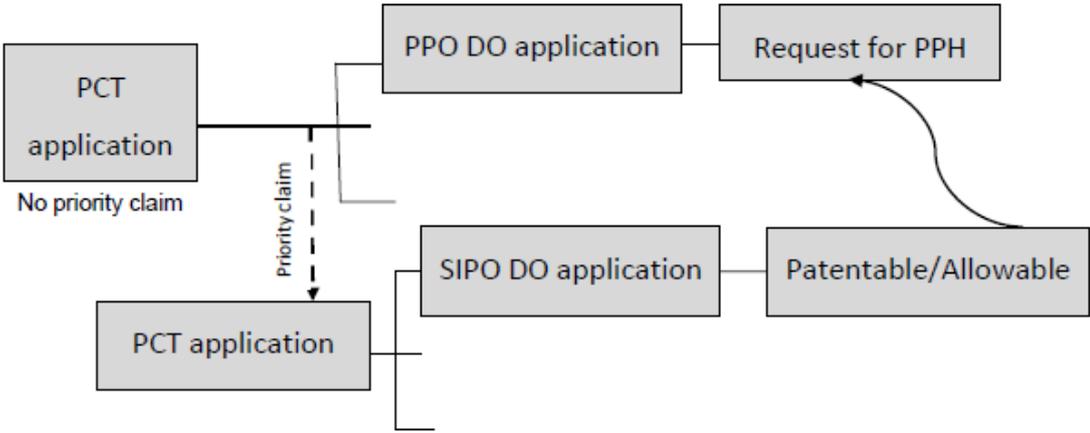
ANNEX I

K

A case meeting requirement (a) (ii)

- Direct PCT & PCT route -

OK

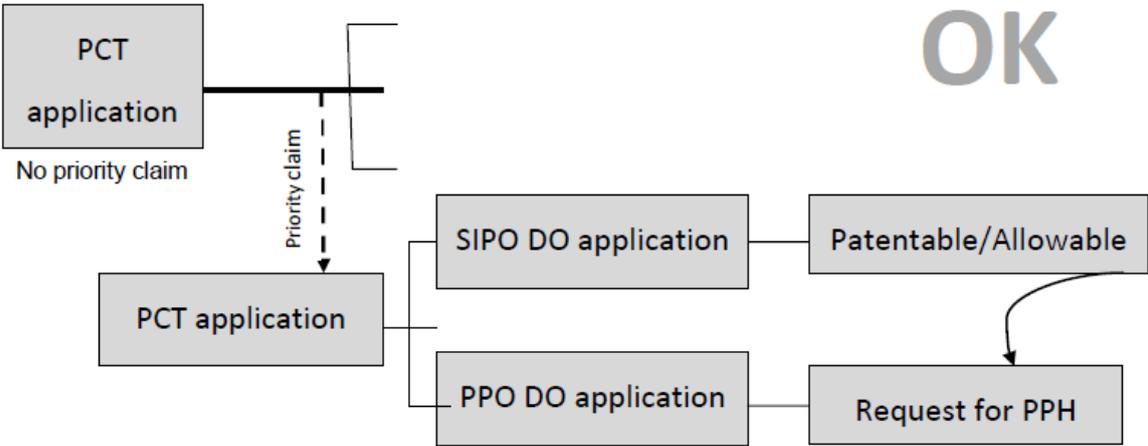


L

A case meeting requirement (a) (iii)

- Direct PCT & PCT route -

OK

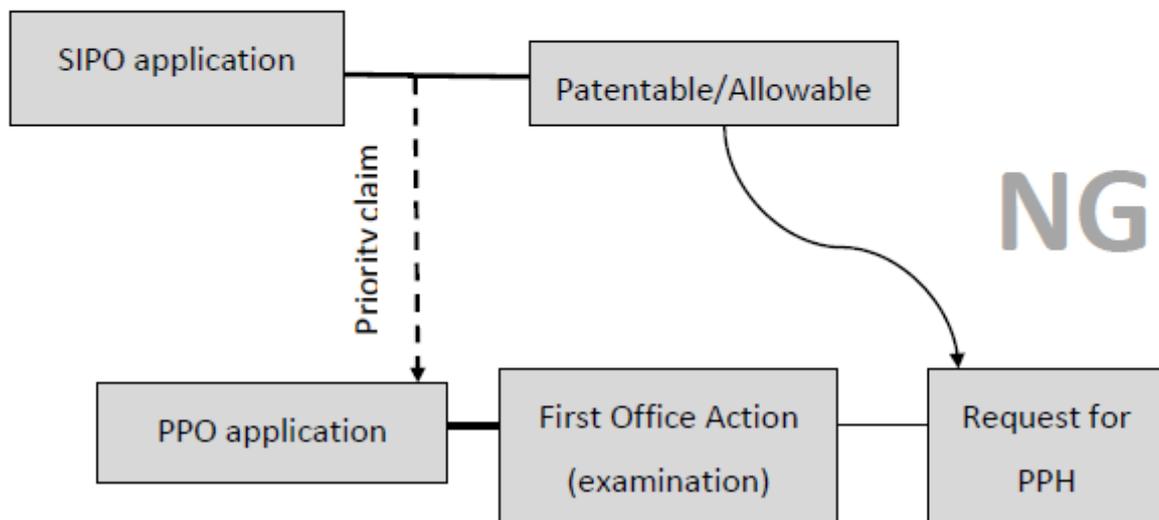


ANNEX I

M

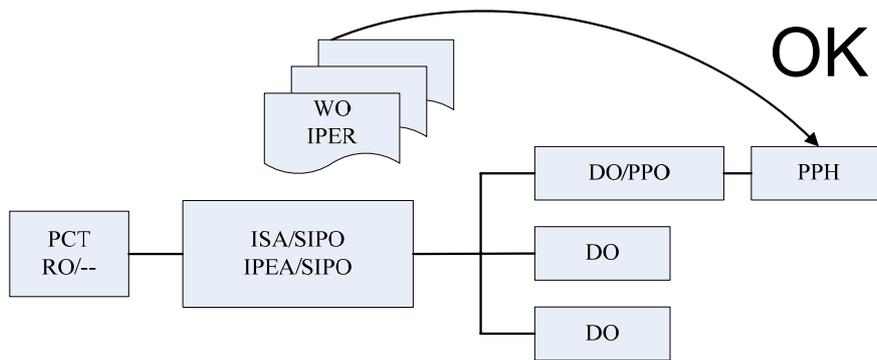
A case not meeting requirement (d)

- Examination has begun before a request for PPH –

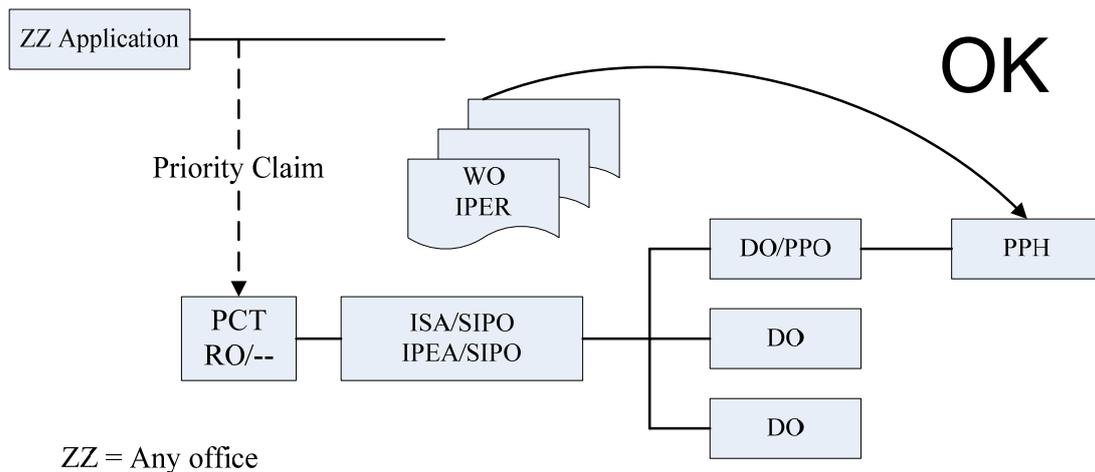


ANNEX II

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

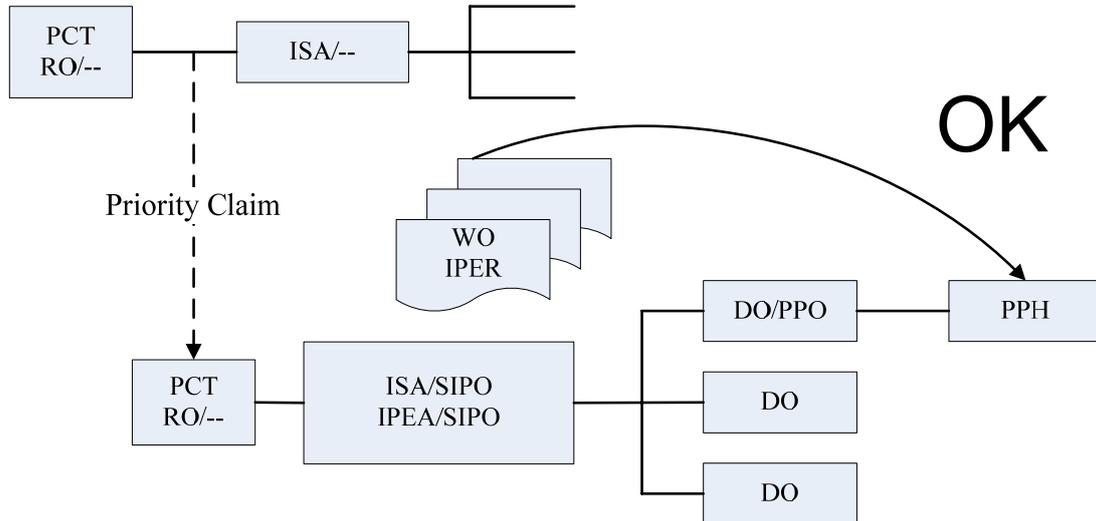


(A') The application is a national phase application of the corresponding international application. (The corresponding international application claims priority from a national application.)

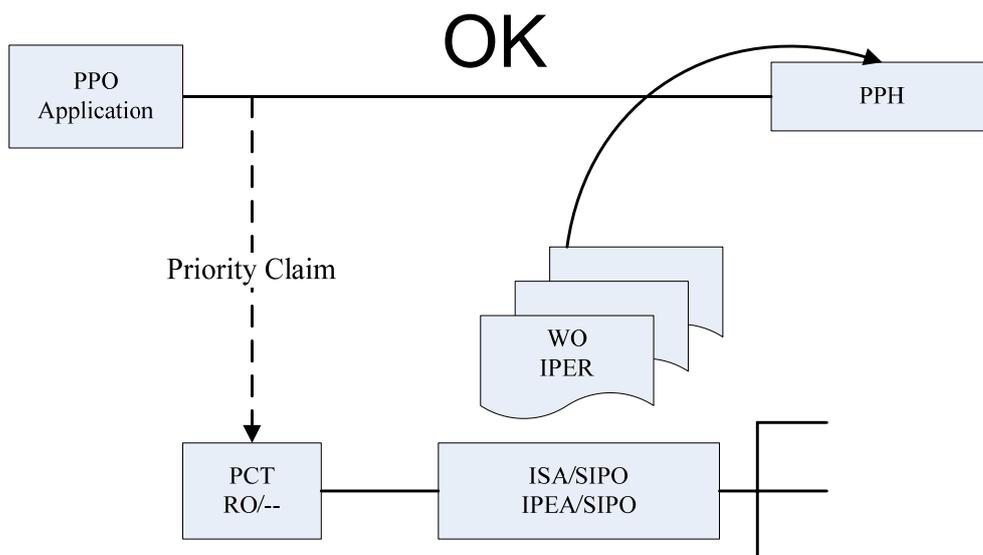


ANNEX II

(A'') The application is a national phase application of the corresponding international application.
 (The corresponding international application claims priority from an international application.)

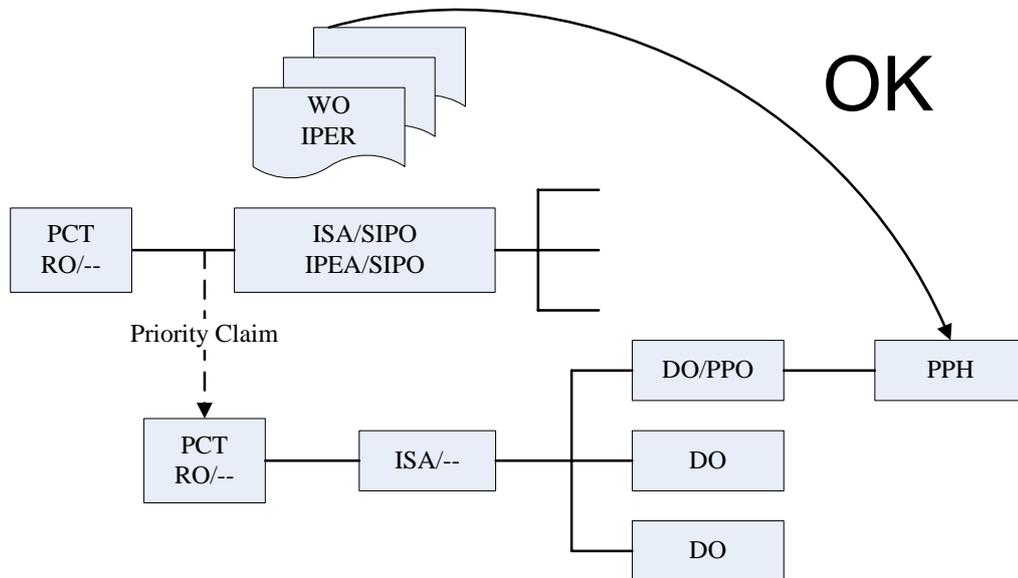


(B) The application is a national application as a basis of the priority claim of the corresponding international application.

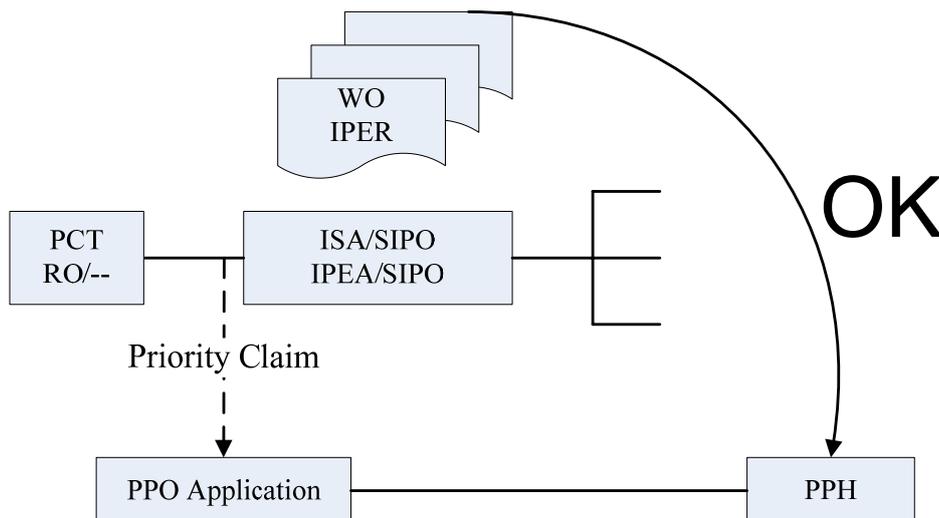


ANNEX II

(C) The application is a national phase application of an international application claiming priority from the corresponding international application.

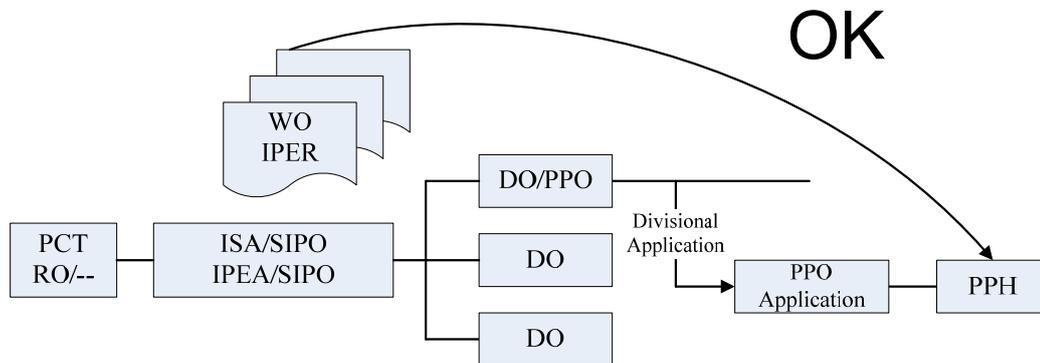


(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



ANNEX II

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



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

