

Part I PPH using the national work products from the SIPO

Procedure for filing a request with IMPI regarding the Patent Prosecution Highway Pilot Program between IMPI (Mexican Institute of Industrial Property) and SIPO (State Intellectual Property Office of the P. R. China)

The trial period of this Patent Prosecution Highway (PPH) pilot program will commence on March 1st, 2013 and will end on February 28th, 2014.

The trial period may be extended if necessary until SIPO and IMPI receive the sufficient number of PPH requests to adequately assess the feasibility of the 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 to be terminated.

Part I

PPH using the national work products from SIPO

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

When a request for participation in the PPH pilot program is presented, the applicant must file a free style writing with IMPI. (See section 3)

1. Requirements

- (a) The IMPI application (including a PCT national phase application) is:**
- (i) an application which validly claims priority under the Paris Convention to 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, 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 IMPI 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 for PPH request.

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If there is an application firstly filed in the third country and having priority linkage to the IMPI and/or SIPO application(s), the IMPI application shall not be eligible for PPH request (see Figure D and E in ANNEX I).

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

The corresponding application(s) can be an 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 they are explicitly identified to be patentable/allowable in the latest office action of SIPO, even if the application is not granted for a 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 allowable/patentable” in the following circumstances: If the SIPO office action does not explicitly state that a particular claim is allowable/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 allowable/patentable by SIPO. The explanation must include a comparative analysis between the claims of the invention and the conclusion on patentability in the office action of 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 SIPO, those claims may be deemed to be implicitly identified to be allowable/patentable and then

the applicant must include the above explanation.)

- (c) All claims in the IMPI 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 claims determined to be patentable/allowable in SIPO.**

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in IMPI are of the same or similar scope as the claims in SIPO, or the claims in IMPI are narrower in scope than the claims in SIPO. For example, 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 by the specification at IMPI (description and/or claims).

A claim of IMPI which introduces a new/different category of claims to those claims determined to be patentable/allowable in SIPO is not considered to sufficiently correspond. For example, SIPO claims only contain claims to a process of manufacturing a product, then the claims in IMPI are not considered to sufficiently correspond if IMPI claims introduce product claims that are dependent on the corresponding process claims.

It is not required to include “all” claims determined to be patentable/allowable by SIPO (the deletion of claims is allowable). For example, in the case where an application in SIPO contains 5 claims determined to be patentable/allowable, the application in IMPI may contain only 3 of these 5 claims.

Refer to ANNEX III for the cases which are considered to “sufficiently correspond” and the cases which are not considered to “sufficiently correspond”.

Any claims amended or added after the grant of the request for participation in the PPH pilot program but before the first IMPI action must sufficiently correspond to the claims indicated as patentable/allowable in the SIPO application. Any claims amended or added after the first IMPI action need not to sufficiently correspond to the claims indicated as patentable/allowable in SIPO in order to overcome the reasons for refusal raised by IMPI examiners.

- (d) The IMPI application must have been published.**

The publication in the gazette must have taken effect, and the period of time stated for receiving third parties observations must have lapsed.

If the PPH request is filed before the expiration of the period of time indicated above, IMPI

shall determine whether the application can be entitled to the status for an accelerated examination under the PPH until this period expires.

(e) *IMPI has not begun examination of the application at the time of request for the PPH. (See example contained on ANNEX I, Figure M)*

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

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching them to the PPH request.

Note that even when it is not required to submit documents below, the name of the documents must be listed in the request for Accelerated Examination under the Patent Prosecution Highway (Please refer to the example of free style writing below for the detail).

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

Machine translations will be admissible.

But if it is impossible for the examiner to understand the translated office actions, the examiner may request the applicant to resubmit translations.

It is not required to submit the office actions and translations thereof when those documents are available in English via Dossier Access System (DAS)¹ of SIPO.

(b) *Copies of all claims determined to be patentable/allowable by SIPO and their translations.*

Machine translations will be admissible.

But if it is impossible for the examiner to understand the translated claims, the examiner may request the applicant to resubmit translations.

It is not required to submit the claims determined to be patentable/allowable by SIPO and translations thereof when those documents are available in English via Dossier Access System (DAS²) of SIPO.

(c) *Copies of references cited by the SIPO examiner*

¹<http://cpquery.sipo.gov.cn/>

²[http:// cpquery.sipo.gov.cn/](http://cpquery.sipo.gov.cn/)

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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 them because IMPI usually possesses them. When the patent document is not available to the IMPI examiner the applicant must 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 PPH applicant must submit a claim correspondence table, which indicates how all claims in the IMPI 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) (Please refer to the example of the free style writing below and ANNEX III).

3. Example of free style writing for requesting Accelerated Examination under the Patent Prosecution Highway under the PPH pilot program.

a) Circumstances

When an applicant files a request for participation in the PPH pilot program with IMPI, the applicant must submit a free style writing requesting Accelerated Examination under the Patent Prosecution Highway, explaining the circumstances for its participation, according to the guidelines described in this document.

The applicant must indicate that the application belongs to any of the categories (i) to (iii) of 1.(a), and that the accelerated examination is requested under the PPH pilot program. The application number, publication or patent number of the corresponding SIPO application must be written as well.

In the case where a SIPO application, which has one or more claims that are determined to be patentable/allowable does not directly belong to any of the categories (i) to (iii) of 1.(a) (for example, the divisional application of the basic application that belongs to any of the categories (i) to (iii) of 1.(a)), the application number, publication number, or

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correspondent patent of the SIPO application which has claims determined to be patentable/allowable and the relationship between those applications must be written down.

b) Documents to be submitted

The applicant must list all required documents mentioned in section 2, on an identifiable way, even when the applicant is exempted to submit certain documents.

c) Sample of free style writing (Spanish)

Lugar y Fecha

Asunto: Petición para participar en el Programa Piloto PPH

Número de solicitud ante el IMPI

Fecha de presentación

Título de la invención

Solicitante

Apoderado, representante legal o mandatario

Domicilio para oír y recibir notificaciones

Instituto Mexicano de la Propiedad Industrial

Dirección Divisional de Patentes

PRESENTE

Por este conducto, se solicita la inclusión de la solicitud de patente con número de expediente MX/a/ XXXX/XXXXXX dentro del **Programa Piloto del PPH** correspondiente a la solicitud de patente China CN XXXXXX y que cumple con la relación prevista en el inciso (X) del punto 1 (a) (explique la razón por la que cumple con esa relación).

Para efecto de lo anterior, se enlistan los documentos que se anexan y los que no se anexan por estar disponibles a través del DAS (Sistema de consulta de expedientes de SIPO) o ser documentos de patente.

(a) Copia de todas las acciones oficiales que fueron relevantes para determinar la patentabilidad de la solicitud de patente en SIPO, que fueron emitidas para la solicitud SIPO correspondiente y, en su caso, su traducción, a saber:

1. Acción oficial 1 (no se anexa por estar disponible en DAS)

2. ...

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(b) Copia de todas las reivindicaciones que han sido indicadas como otorgables por SIPO y, en su caso, su traducción:

1. Las reivindicaciones otorgables son las originalmente presentadas ante SIPO. (no se anexan por estar disponibles en DAS)

(c) Copia de todas las referencias citadas por el examinador de SIPO:

1. CN XXXXX (no se anexa por ser documento de patente)
2. US ...
3. EP... etc.

(d) Tabla de correspondencia de reivindicaciones:

Tabla de correspondencia de reivindicaciones		
Reivindicaciones en la solicitud en el IMPI	Reivindicaciones patentables/otorgables en la solicitud SIPO	Explicación sobre la suficiente correspondencia
XXX	XXX	Son lo mismo
YYY	XYZ	Justificación de la suficiente correspondencia
...

Nombre y firma del solicitante o apoderado

Sample of free style writing (English)

Place and Date

Subject: Request of participation in the PPH Pilot Program IMPI-SIPO

Application number before IMPI

Filing Date

Title of the Invention:

Applicant

Attorney or legal representative

Mexican Institute of Industrial Property
Patent Division

Through this means, we request the inclusion of the application with file number MX/a/xxxx/xxxxxx/ into the **PPH Pilot Program IMPI-SIPO** corresponding to the application CN XXXXXX filed before the SIPO and which has met the conditions provided in subsection (X) of paragraph 1 (a) or (b) (*explain the reasons why it complies with these conditions*) and, for this purpose, we attach a list of the following documents: (submission of such documents is omitted because they are available in the SIPO Dossier Access System)

(a) Copy of all SIPO Office Actions which were relevant to patentability in the above-identified SIPO application(s) (*and where appropriate, their translation*).

1. Office Action 1 (not annexed, is available in DAS)
2. ...

(b) Copy of all claims which were determined to be patentable/allowable by the SIPO in the above-identified SIPO application(s) (*and where appropriate, their translation*).

1. The claims as originally filed and determined patentable allowable by SIPO. (not annexed, as they are available in DAS)

(c) References cited by SIPO, not annexed, as they are patent documents.

1. CN XXXXXX
2. US ...
3. EP... etc.

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(d) Claims correspondence Table

Claims in the MX application	Claims in the SIPO application	Explanation regarding the sufficient correspondence
XXX	XXX	They are the same
XYX	XYZ	Z Justification of sufficient correspondence

Name and signature of applicant or patent attorney

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

IMPI 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 IMPI decides that the request is acceptable, the application is assigned 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. If the request is not approved, the applicant may resubmit the request up to one time, given the applicant the opportunity, only once, to correct certain specified defects.

If the resubmitted request is still not approved, the applicant will be notified and the application will await action in its regular turn.

IMPI will not notify the applicant of the acceptance for assigning a special status for accelerated examination under the PPH, but instead the applicant will be aware by the reception of an office action of substantive examination procedure resulting from accelerated examination.

Utility model and industrial design applications, as well as patent claims which contain material covered by articles 4, 16 and 19 of the Mexican Industrial Property Law (LPI) are excluded and not subject to participation in the PPH pilot program.

If the PPH request is filed before the expiration of the period of time established in article 52 bis of the LPI, IMPI shall determine whether the application can be entitled to the status for an accelerated examination under the PPH until this period expires .

Where the request for participation in the PPH pilot program is accepted, MX application shall be advanced out of turn for examination, as long as it complies with the publication established in article 52 of the LPI and upon expiration of the period for third party observations prescribed in article 52 bis of the LPI.

The acceptance of a participation request in the PPH pilot program in a parent application will not carry over to a divisional application. The applicant must submit a new request of participation in the PPH pilot program for the divisional application and fulfill all the conditions set forth above in order to be accepted.

If any of the documents identified in 2 (a) to 2 (d) above has already been filed in the MX application, prior to the request for participation in the PPH pilot program, it will not be necessary for the applicant to resubmit these documents with the request for participation. The applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot program when these documents were previously filed in the MX application.

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The PPH program does not absolve applicants of all their duties under the Industrial Property Law and applicable legislation. Applicants must act in good faith, including the submission of information known by them to IMPI, which is relevant to determine the patentability of the invention.

Part II

PPH using the PCT international work products from SIPO

Applicants may request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with IMPI and satisfies the following requirements under the IMPI-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 free style writing before the IMPI. (See section 3).

1. Requirements

The application which is filed with IMPI and on which the applicant files a request under 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 SIPO, but, if priority is claimed, the priority claim can refer 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, this 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 II)
- ii. The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex II)
- iii. The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)
- iv. The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure D in Annex II)
- 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 II)

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" when, considering the differences arising from the translation and/or claims format, the claims of the application are of the same or similar scope as the claims indicated as patentable/granted in the latest international work product or the claims of the application are narrower in scope than the claims in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated as patentable/allowable in the latest international work product is amended to be further limited by an additional technical feature that is supported in the Mexican specification originally presented (description and/or claims).

A claim of the application before IMPI, which introduces a new/different category of claims to those claims indicated as patentable/allowable in the latest international work product is not considered to sufficiently correspond. For example, the claims indicated as patentable/allowable in the latest international work product only contain claims to a process of manufacturing a product, therefore the claims of the application presented before IMPI are not

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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 by SIPO (the deletion of claims is allowable). For example, in the case where an application with SIPO contains 5 claims determined to be patentable/allowable, the application at IMPI may contain only 3 of these 5 claims.

Refer to ANNEX III for the cases which are considered to “sufficiently correspond” and the cases which are not considered to “sufficiently correspond”.

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program but before the first IMPI action must sufficiently correspond to the claims indicated as patentable/allowable in the in the latest work product. Any claims amended or added after the first IMPI action need not to sufficiently correspond to the claims indicated as patentable/allowable in the latest work product in order to overcome the reasons for refusal raised by IMPI examiners.

d) The IMPI application must have been published.

The publication in the gazette must have taken effect, and the period of time stated for receiving third parties observations must have lapsed.

If the PPH request is filed before the expiration of the period of time indicated above, IMPI shall determine whether the application can be entitled to the status for an accelerated examination under the PCT-PPH until this period expires .

e) IMPI has not begun examination of the application at the time of request under PCT-PPH (See Figure F in Annex II).

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

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to the PCT-PPH request.

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

(a) A copy of the latest international work product which indicates the claims to be patentable/allowable and their translations.

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In case the application satisfies the relationship 1.(b)(i), the applicant does not need to submit a copy of the International Preliminary Report on Patentability (IPRP) or any translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via "PATENTSCOPE ®"³, there is no need for an applicant to submit these documents, unless otherwise requested by IMPI.

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

- (b) **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 translations.**

If the copy of the set of claims which are indicated to be patentable/allowable is available via "PATENTSCOPE®" (e.g. the international Patent Gazette has been published), there is no need for the applicant to submit this document unless otherwise requested by IMPI. Where the set of claims is written in Chinese, the translations thereof must be still submitted by the applicant.

- (c) **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 reference and consequently do not consist of the reasons for refusal do not have to be submitted.

If the reference is a patent document, and it is not available to IMPI, it may be requested to the applicant. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

- (d) **A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable in the latest international work product.**

When claims are just literal translation, the applicant can 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) (Please refer to the Example of the free style writing below and Annex III).

3. Example of a free style writing for requesting Accelerated Examination under

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

the PCT-Patent Prosecution Highway under the PCT-PPH pilot program.

a) Circumstances

When an applicant files a request for participation in the PCT-PPH pilot program with IMPI, the applicant must submit a free style writing requesting Accelerated Examination under the Patent Prosecution Highway, explaining the circumstances for its participation, according to the guidelines described in this document.

The applicant must indicate that the application belongs to any of the subparagraphs (i) to (v) of section 1 (b), and that the accelerated examination is requested under the PCT-PPH pilot program. The international application number or international publication must be indicated as well.

In the case where an application that has one or more claims that are determined to be patentable/allowable does not directly belong to any of the subparagraphs (i) to (v) of section 1 (b) (for example, the divisional application of the basic application that belongs to any of the subparagraphs (i) to (v) of section 1 (b)), the international application number, or international publication number of the international application which has claims determined to be patentable/allowable and the relationship between those applications must be indicated.

(b) Documents to be submitted

The applicant must list all required documents in number 2, on an identifiable way, even if the applicant is exempted to submit certain documents.

(c) Sample of free style writing (Spanish)

Lugar y Fecha

Asunto: Petición para participar en el Programa Piloto PCT-PPH

Número de solicitud ante el IMPI

Fecha de presentación

Título de la invención

Solicitante

Apoderado, representante legal o mandatario

Domicilio para oír y recibir notificaciones

Instituto Mexicano de la Propiedad Industrial

Dirección Divisional de Patentes

PRESENTE

Por este conducto, se solicita la inclusión de la solicitud de patente con número de expediente MX/a/XXXX /XXXXXX dentro del Programa Piloto del PCT-PPH correspondiente a la solicitud internacional XXXXXX, misma que cumple con la relación prevista en el inciso (X) del punto 1 (b) (explique la razón por la que cumple con esa relación).

Para efectos de lo anterior, se enlistan los documentos que se anexan y los que no se anexan por estar disponibles a través del PATENTSCOPE® o por ser documentos de patente.

(a) Copia del último resultado de la fase internacional que indica las reivindicaciones que son patentables/otorgables y, en su caso, su traducción (no se anexa por estar disponible en PATENTSCOPE®).

(b) Copia del capítulo reivindicatorio que, de acuerdo con el último resultado de la fase internacional de la solicitud PCT correspondiente, se indica como patentable/otorgable y, en su caso, su traducción (no se anexa por estar disponible en PATENTSCOPE®).

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(c) Copia de todas las referencias citadas en el último resultado de la fase internacional de la solicitud PCT correspondiente a la solicitud.

1. CN XXXXXX (no se anexa por ser documento de patente)
2. US ...
3. EP... etc.

(d) Tabla de correspondencia de reivindicaciones:

Tabla de correspondencia de reivindicaciones		
Reivindicaciones en la solicitud en el IMPI	Reivindicaciones patentables/otorgables en la solicitud internacional	Explicación sobre la suficiente correspondencia
XXX	XXX	Son lo mismo
YYY	XYZ	Justificación de la suficiente correspondencia
...

Nombre y firma del solicitante o apoderado

Sample of free style writing (English)

Place and Date

Subject: Request of participation in the PCT-PPH Pilot Program IMPI-SIPO

Application number before IMPI

Filing Date

Title of the Invention:

Applicant

Attorney or legal representative

Mexican Institute of Industrial Property
Patent Division

Through this means, we request the inclusion of the application with file number MX/a/xxxx/xxxxxx/ into the **PCT-PPH Pilot Program IMPI-SIPO** corresponding to the international application XXXXXX filed before SIPO, which has met the conditions provided in subsection (X) of paragraph 1 (a) or (b) (*explain the reasons why it complies with this conditions*) and for this purpose we attach and list the following documents. (Submission of such documents is omitted because they are available in PATENTSCOPE®.)

(a) Copy of the latest international work product which determines the patentability/allowability of some claims in the above identified international application(s) (*and where appropriate, its translation*).

1. International work Product 1 (not annexed, as it is available in PATENTSCOPE®)
2. ...

(b) Copy of all claims which were determined to be patentable/allowable in the latest international work product in the above identified International application(s) (*and where appropriate, its translation*).

1. The claims as originally filed and determined patentable allowable by SIPO in the latest international work product. (not annexed, as it is available in PATENTSCOPE®)

(c) References cited by SIPO in the latest international work product in the above identified International application(s), not annexed as they are patent documents.

1. CN XXXXXX

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- 2. US ...
- 3. EP... etc.

(d) Claims correspondence Table

Claims correspondence Table		
Claims in MX application	Claims patentable/allowable in the international application	Explanation regarding the sufficient correspondence
XXX	XXX	They are the same
XYX	XYZ	Z Justification of sufficient correspondence

Name and signature of applicant or patent attorney

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

IMPI decides whether the application can be entitled for an accelerated examination under the PCT-PPH when it receives a request with the documents stated above. If IMPI decides that the request is acceptable, the application is assigned 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. If the request is not approved, the applicant may resubmit the request up to one time, given the applicant the opportunity, one time only, to correct certain specified defects.

If the resubmitted request is still not approved, the applicant will be notified and the application will await action in its regular turn.

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

Utility model and industrial design applications, as well as patent claims which contain material covered by articles 4, 16 and 19 of the LPI are excluded and not subject to participation in the PCT-PPH pilot program.

If the PPH request is filed before the expiration of the period of time established in article 52 bis of the LPI, IMPI shall determine whether the application can be entitled for an accelerated examination under the PCT-PPH until said period expires.

Where the request for participation in the PCT-PPH pilot program is accepted, MX application will be advanced out of turn for examination, as long as it complies with the publication established in article 52 of the LPI and upon expiration of the period for third parties observations prescribed in article 52 bis of the LPI.

The acceptance of a participation request in the PCT-PPH pilot program in a parent application will not carry over to a divisional application. The applicant must submit a new request of participation in the PCT-PPH pilot program for the divisional application and fulfill all the conditions set forth above in order to be accepted.

If any of the documents identified in 2 (a) to 2 (d) above have already been filed in the MX application, prior to the request for participation in the PCT-PPH pilot program, it will not be

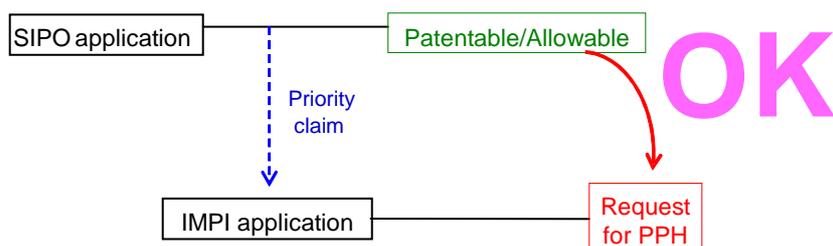
Part II PPH using the PCT international work products from the SIPO

necessary that the applicant resubmit these documents with the request for participation. The applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot program that these documents were previously filed in the MX application.

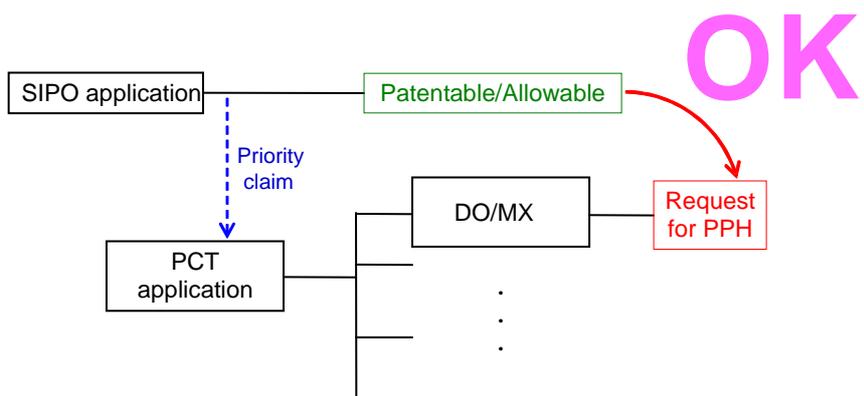
The PCT-PPH program does not absolve applicants of all their duties under the Industrial Property Law and applicable legislation. Applicants must act in good faith, including the submission of information known by them to IMPI, which is relevant to determine the patentability of the invention.

PPH using the national work products from SIPO

A A case meeting requirement (a) (i)
-Paris route-



B A case meeting requirement (a) (i)
-Paris Route and PCT route-



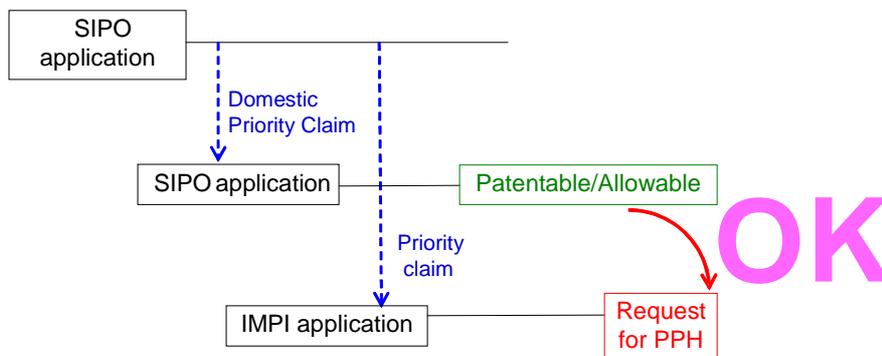
DO: Designated office

PPH using the national work products from SIPO

C

A case meeting requirement (a) (i)

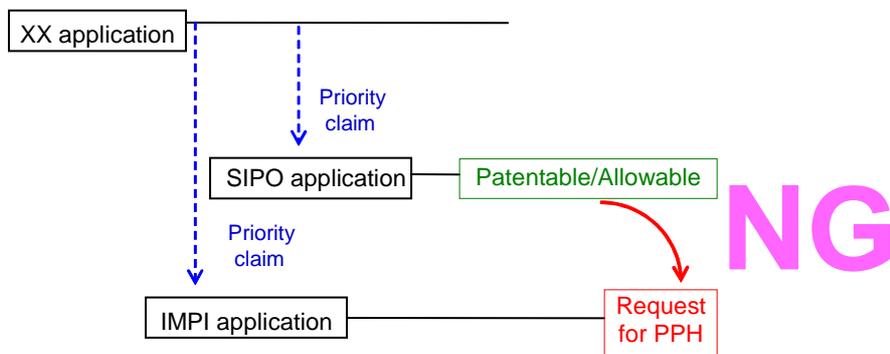
-Paris route and Domestic priority-



D

A case not meeting requirement (a) (i)

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

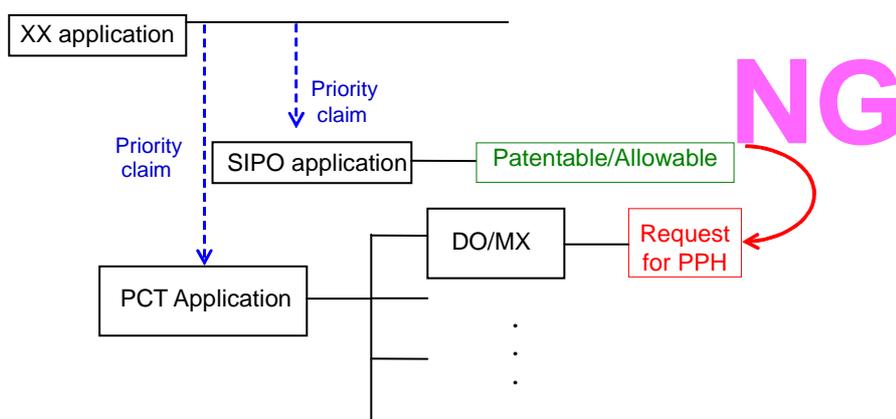


XX: the office other than the SIPO

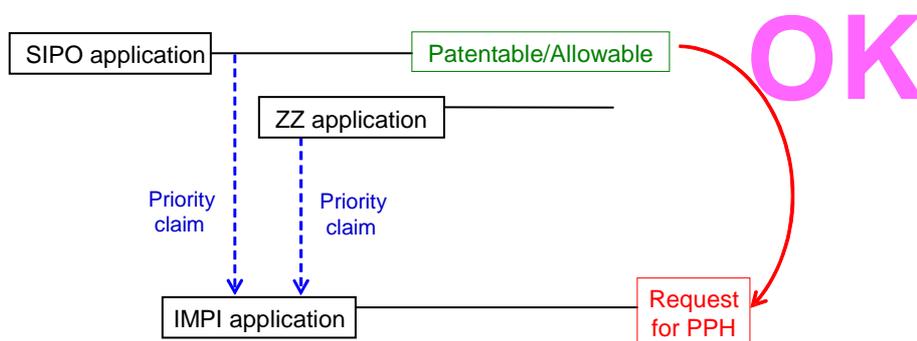
NG: Not granted

PPH using the national work products from SIPO

- E** A case not meeting requirement (a) (i)
-Paris route and PCT route, but the first application is from the third country (XX)-



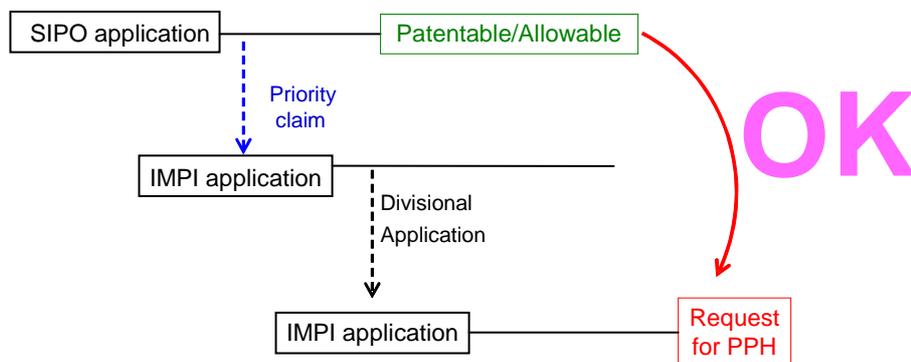
- F** A case meeting requirement (a) (i)
-Paris route and Complex priority from any office (ZZ)-



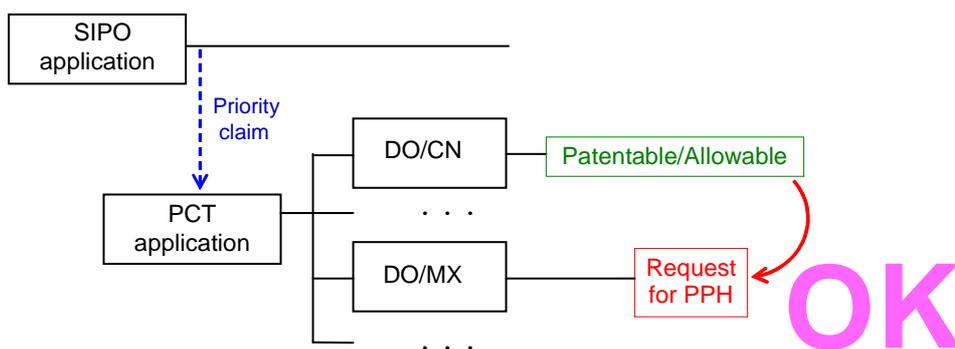
ZZ : any office

PPH using the national work products from SIPO

G A case meeting requirement (a) (i) -Paris route and divisional application-



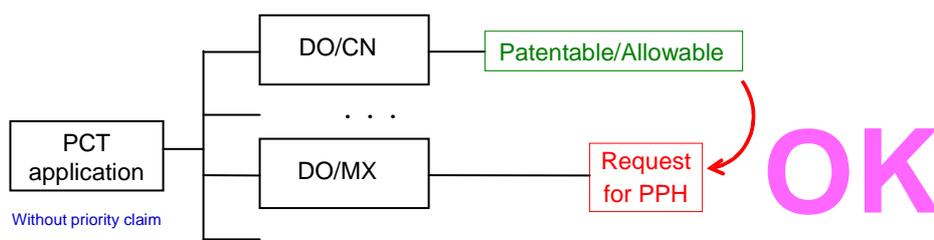
H A case meeting requirement (a) (i) -Paris route and PCT route-



PPH using the national work products from SIPO

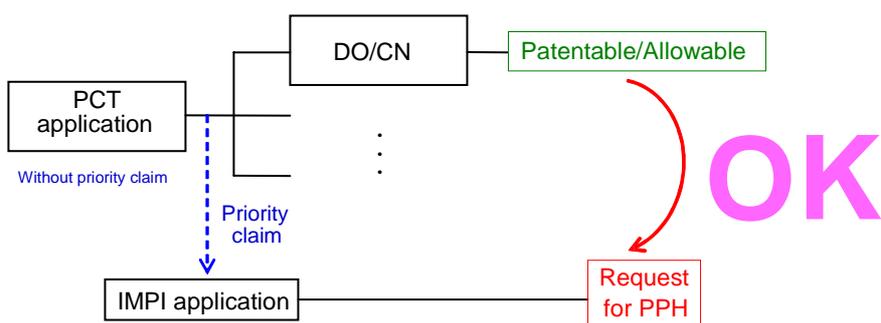
I

A case meeting requirement (a) (ii)
-Direct PCT route-



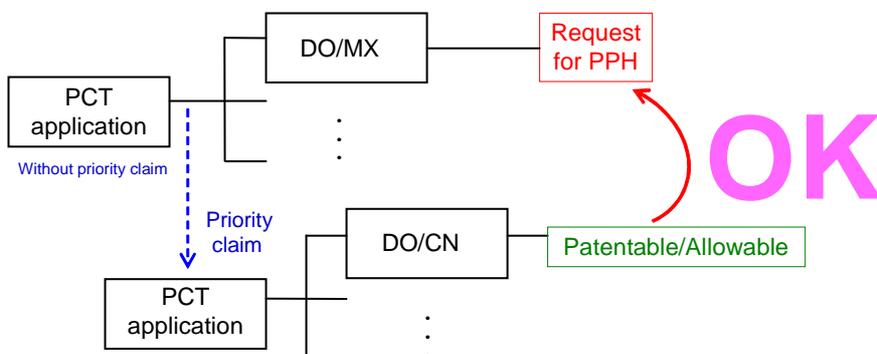
J

A case meeting requirement (a) (iii)
-Direct PCT and Paris route-

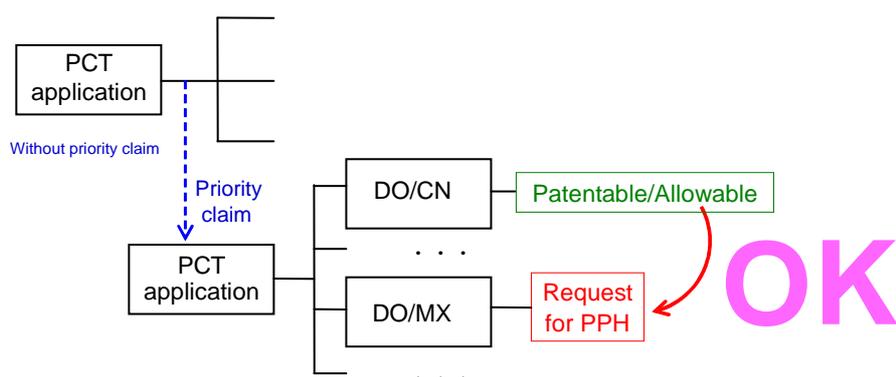


PPH using the national work products from SIPO

K A case meeting requirement (a) (ii)
-Direct PCT and PCT route-

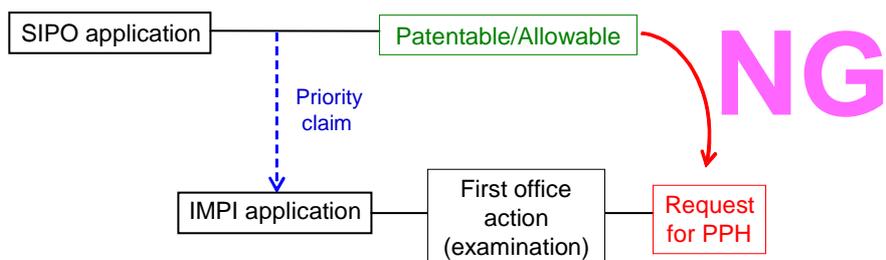


L A case meeting requirement (a) (iii)
-Direct PCT and PCT route-



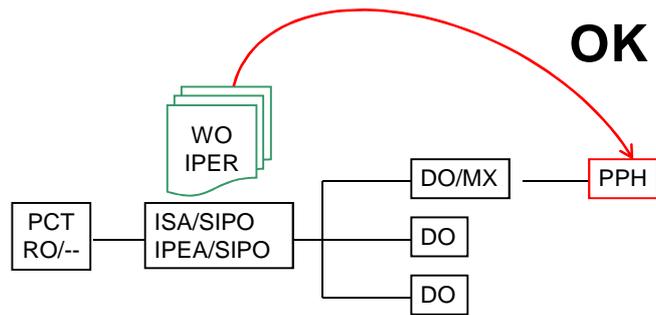
PPH using the national work products from SIPO

M A case not meeting requirement (d)
-Examination has begun before a request for PPH-



PPH using the PCT international work products from SIPO

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

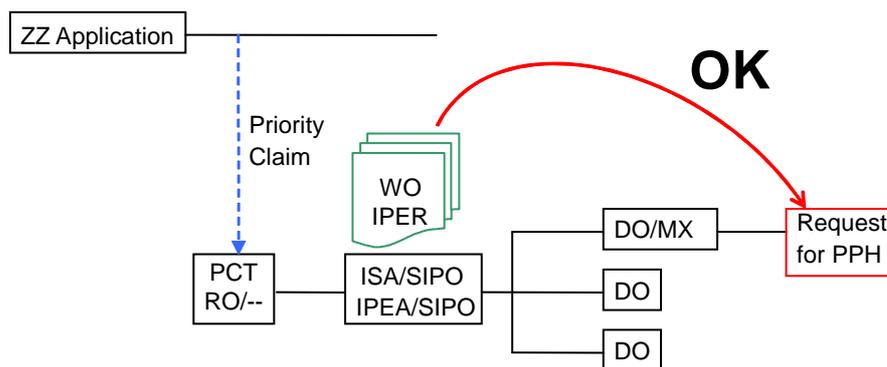


RO: Receiving Office

DO: Designated Office

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

(The corresponding international application claims priority from a national application.)

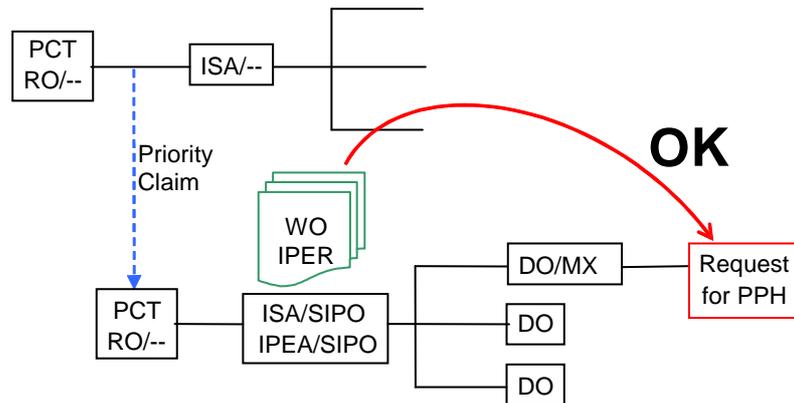


ZZ=any office

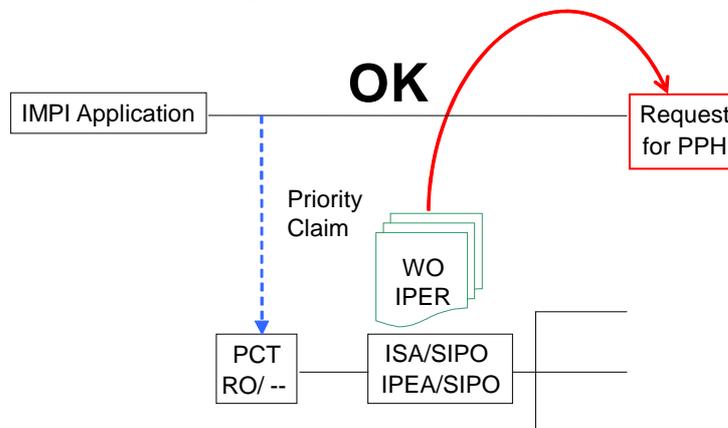
PPH using the PCT international work products from SIPO

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

(The corresponding international application claims priority from an international application.)

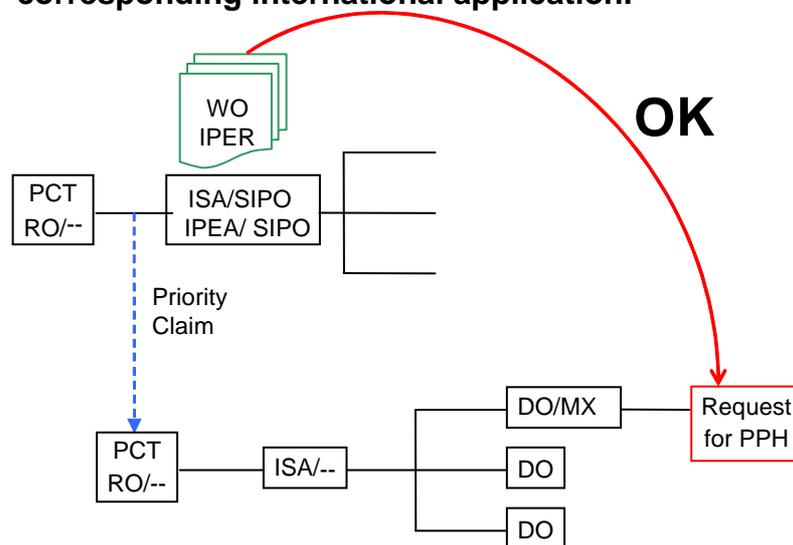


(B) The application is a national application as a basis of the priority claim of the corresponding international application.

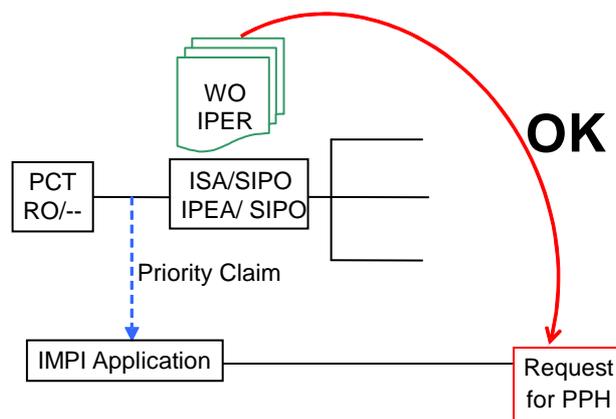


PPH using the PCT international work products from SIPO

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

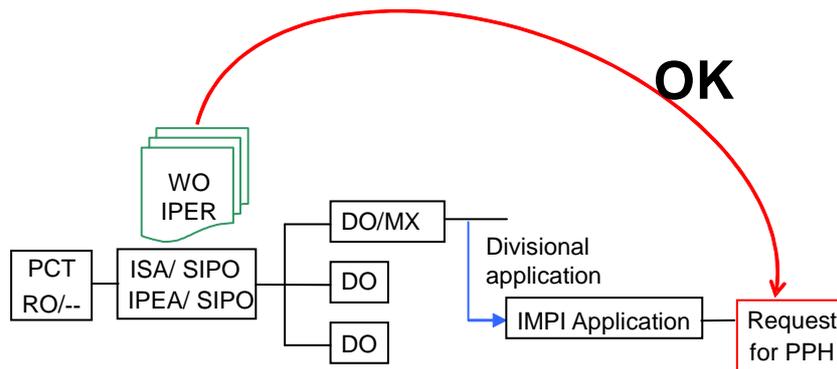


(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.

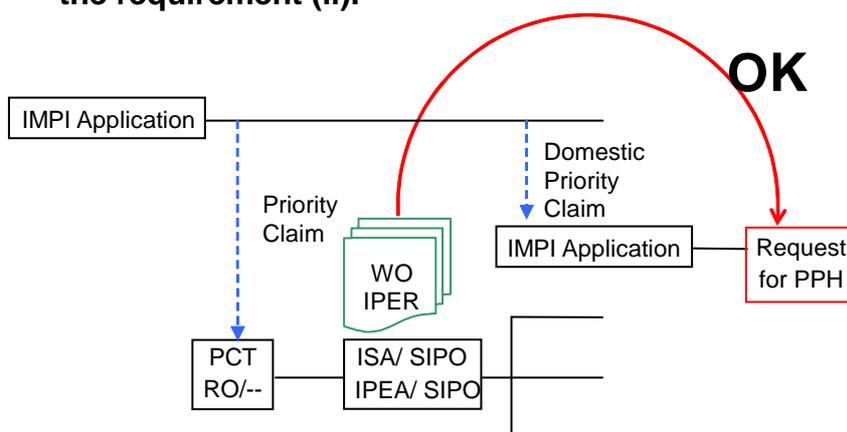


PPH using the PCT international work products from SIPO

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

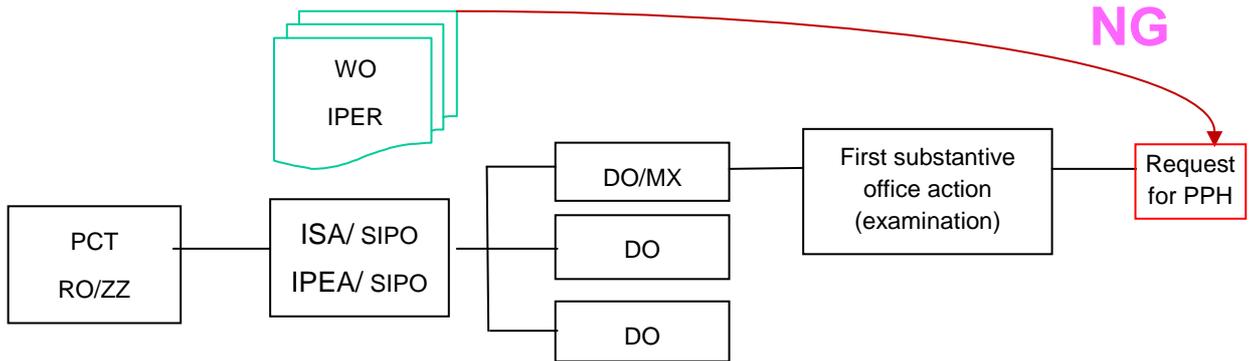


(E2) The application is an application claiming domestic priority from an application which satisfies the requirement (ii).



PPH using the PCT international work products from SIPO

(F) A case not meeting with requirement 1 (d)



Example of Claim Correspondence Table

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.)