

Procedures to file a request to the IMPI for Patent Prosecution Highway Pilot Program between the IMPI (Instituto Mexicano de la Propiedad Industrial) and the KIPO (Korean Intellectual Property Office)

Part I

PPH using the national work products from the KIPO

The trial period of this Patent Prosecution Highway (PPH) pilot program will commence on July 1, 2012 and will end on June 30, 2014. The trial period may be extended if necessary until the Korean Intellectual Property Office (KIPO) and the Mexican Institute of Industrial Property (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 terminated.

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 KIPO-IMPI PPH pilot program.

When a request for participation in the PPH pilot program is presented, the applicant must file a free style writing to 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 the KIPO 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), 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, K and L).**

The IMPI application, which validly claims priority to multiple KIPO 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.

If there is an application firstly filed in the third country and having priority linkage to the IMPI and/or KIPO application(s), the IMPI application is not eligible for PPH request (see Figure D

and E in ANNEX I).

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

The corresponding application(s) can be an application which forms the basis of the priority claim, an application which derived from the same (e.g., a divisional application of the KIPO application or an application which claims domestic priority to the KIPO application (see Figure C in Annex I)), or an KIPO 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, even if the application is not granted for a patent yet.

The office action includes:

- (a) Granted Patent
- (b) Decision to Grant a Patent
- (c) Notification of Reasons for Refusal
- (d) Decision of Refusal
- (e) Appeal Decision

Claims are also “determined to be patentable/allowable” in the following circumstances: If the KIPO office action does not explicitly state that a particular claim is patentable/allowable, the applicant must include an explanation accompanying the request for participation in the PPH pilot program that no rejection has been made in the KIPO office action regarding that claim, and therefore, the claim is deemed to be patentable/allowable by KIPO.

(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 the KIPO.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the IMPI are of the same or similar scope as the claims in the KIPO, or the claims in the IMPI are narrower in scope than the claims in the KIPO. (e.g.) a claim that is narrower in scope occurs when a KIPO 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 KIPO is not considered to sufficiently correspond. For example, the KIPO claims only contain claims to a process of manufacturing a product, then the claims in IMPI are not considered to sufficiently correspond if the 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 KIPO (the deletion of claims is allowable). For example, in the case where an application in KIPO contains 5 claims determined to be patentable/allowable, the application in IMPI may contain only 3 of these 5 claims.

Refer to ANNEX II for the cases which are considered to "sufficiently correspond" and the cases which are not considered to "sufficiently correspond".

Any claims amended or added 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 KIPO application. However, if any amended claim does not satisfy the claim correspondence, the application is treated as the usual application (i.e. it gets out of Fast Track).

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

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching 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 "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 the KIPO) which were issued for the corresponding application by the KIPO, 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 via Dossier Access System (DAS) of KIPO: K-PION (<http://k-pion.kipo.go.kr/>).

(b) Copies of all claims determined to be patentable/allowable by the KIPO, and
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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 via Dossier Access System (DAS) of KIPO: K-PION (<http://k-pion.kipo.go.kr/>).

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

If the references are patent documents, the applicant does not have to submit them because the 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.

Reference documents which are not relevant to the reasons for refusal stated in the office action are not required to 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 KIPO 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 "Request for Accelerated Examination under the Patent Prosecution Highway" for filing request of an accelerated examination under the PPH pilot program

1) *Circumstances*

When an applicant files a request for participation in the PPH pilot program to IMPI, an applicant must submit a request form "Request for Accelerated Examination under the Patent Prosecution Highway".

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 correspondent patent of the corresponding KIPO application must be written as well.

In the case where an KIPO application which has one or more claims that are determined to be patentable/allowable does not directly belongs 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, or correspondent patent of the KIPO application which has claims determined to be patentable/allowable and the relationship between those applications must be written.

(2) 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.

(3) Sample of free style writing

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/ / / dentro del Programa Piloto del PPH correspondiente a la solicitud de patente japonesa KR XXXXXX y que cumple con la relación prevista en el inciso (X) del punto 1 (a) (explique la razón por qué 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 DAS (Sistema de consulta de expedientes de KIPO) 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 KIPO, que fueron emitidas para la solicitud KIPO correspondiente y, en su caso, su traducción son:

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

2. ...

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

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

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

1. KRXXXXX (no se anexa por ser documento de patente)

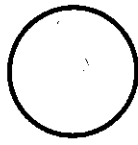
2.

(d) Tabla de correspondencia de reivindicaciones:

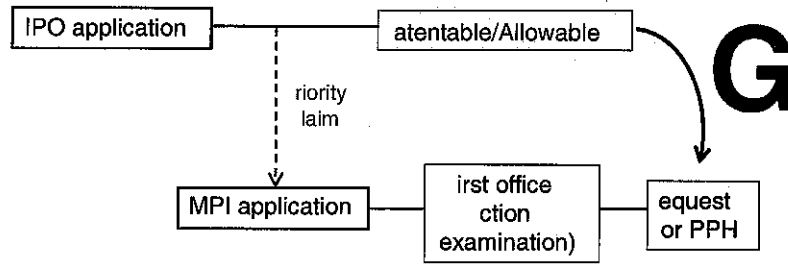
Tabla de correspondencia de reivindicaciones		
Reivindicaciones en la solicitud en el IMPI	Reivindicaciones otorgables en la solicitud KIPO	Explicación sobre la suficiente correspondencia
XXX	XXX	Son lo mismo
YYY	XYZ	Justificación de la suficiente correspondencia
...

Nombre y firma del solicitante o apoderado.

PPH using the national work products from KIPO



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



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PPH using the national work products from KIPO

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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.)