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Riding the patent highway to fast-track SIPO examinations

The term “patent prosecution highway” (PPH) means that if at least one or more of the claims of the application have been determined to be patentable/allowable by the Office of First Filing (OFF), as long as the relevant second application satisfies certain conditions, the applicant may, on the basis of OFF work products, request that the office of second filing (OSF) fast-track the examination.

Usually the PPH will take one of two forms – the conventional PPH or Patent Co-operation Treaty PPH (PCT-PPH). The conventional PPH is a request made to the OSF on the basis of the work products of the OFF, e.g. the examination opinion notice, grant decision, etc. PCT-PPH is a PPH request made to the OSF on the basis of the work products at the PCT international phase, namely the written opinion of the International Searching Authority, written opinion of the International Preliminary Examining Authority, or an international preliminary examination report.

The PPH is carried out on the basis of a bilateral or multilateral agreement. China’s State Intellectual Property Office (SIPO) is currently carrying out a PPH pilot programme with Japan and several other countries. The five offices – the European Patent Office, Japan Patent Office, Korean Intellectual Property Office, SIPO and the US Patent and Trademark Office – commenced the three-year PPH pilot programme on 6 January 2014.

The countries mentioned may apply for either a conventional PPH or PCT-PPH in China under the pilot projects between China and such countries as Japan, the US, South Korea, Russia, Finland, Austria and Spain. But they may only apply for a conventional PPH under pilot projects with such countries as Germany, Denmark, Mexico, Poland, Singapore, Canada, Portugal, and the UK. Under the above-mentioned programme that commenced in January, they may apply either for a conventional PPH or PCT-PPH in China.

Application conditions

Pursuant to the procedures for submitting a PPH request to SIPO, an application for submitting a



PPH request must satisfy the following conditions:

- a. The corresponding relationship between the corresponding application and the SIPO application falls within those specified; the SIPO procedures in the PPH pilot projects between China and the various countries lists the circumstances under which the corresponding relationships comply with those specified;
- b. In the corresponding application, there are one or more claims determined to be patentable/allowable, even though a patent has not yet been granted for such application;
- c. All of the claims in the SIPO application, whether original or revised, must fully correspond with one or more of the claims determined to be patentable/ allowable;
- d. The SIPO application must have been published;
- e. The SIPO application must have entered the substantive examination stage; one permitted exception is the situation where an applicant submits a PPH request simultaneously with a request for substantive examination; however, even if such special provision is employed, other conditions must be satisfied, e.g. when submitting the request for substantive examination, if the SIPO application has not been published, the PPH request may not be submitted; and
- f. Before and at the time of submission of the PPH request, SIPO has not conducted an examination of the application, namely it has not received any office action issued from its examination department.

Pursuant to the SIPO procedures, when submitting the PPH request, the following documents must be submitted with the request for participation in the PPH pilot programme:

- a. Copies of all examination opinion notices rendered in respect of the corresponding application and its Chinese or English translations;
- b. Copies of all claims determined to be patentable/allowable, as well as Chinese or English translations;
- c. Copies of the documents cited by the examiner (translations not needed); cited documents that are solely for reference purposes and do not constitute grounds for rejection need not be



submitted; patent literature need not be submitted, however, if SIPO does not have certain patent documents, the applicant must provide these at the request of the examiner; furthermore, non-patent documents must be submitted, however, documents that need not be submitted must be indicated on the request; and

d. A claim correspondence table explaining how all of the claims in the SIPO application fully correspond with the patentable/allowable claims in the corresponding application; the following three circumstances may be deemed full correspondence: (1) complete identity; (2) revision of the citation relationship between the claims of the SIPO application and of the corresponding application; or (3) the claims in the SIPO application are obtained by incorporating certain technical features from the description into the claims of the corresponding application.

Approval decision

After SIPO has received a PPH request and the accompanying documents, it will decide whether examination of the application can be fast-tracked. If SIPO decides to approve the request, the application will be fast tracked under PPH.

If the PPH request does not fully conform with the above-mentioned requirements, the applicant will be informed of the result, and the defects in the request. Depending on the circumstances, SIPO will give the applicant one opportunity to correct the situation. If the first PPH request is rejected, the applicant may file a second PPH request, but no further request is allowed.

In practice, if there is a defect in a PPH request, the examiner will generally not offer an opportunity to correct the situation and will directly issue a decision notice denying fast-tracking. With respect to defects, very few are substantive defects, most of them being formal defects, e.g. the Chinese translation of the title of a notice is not consistent with the translated title recognised by the examiner; although the claims substantively correspond, the formulation recognised by the examiner was not used; the request omits an examination opinion notice or cited document; an examination opinion notice was not attached, etc.

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