

Procedures to file a request to the DPMA for Patent Prosecution Highway (“PPH”) Pilot Program between the DPMA and the SIPO

The pilot period of this PPH pilot program will commence on 23 January 2012 for a duration of two years, ending on 22 January 2014. The pilot period may be extended if necessary until the SIPO and the DPMA have received a 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.

1. The outline of the Patent Prosecution Highway Pilot Program

The PPH pilot program enables an application whose claims have been determined to be patentable in the Office of First Filing (OFF) to undergo an accelerated examination in the Office of Second Filing (OSF) with a simple procedure according to a request from an applicant.

2. Request to the DPMA as OSF

An applicant has to file a request for accelerated examination under the PPH to the DPMA as OSF in German language by submitting a request form for accelerated examination under the PPH pilot program accompanied by the relevant supporting documents. The requirements for a request for accelerated examination under the PPH at the DPMA are given in the following section (paragraph 3). Relevant supporting documentation is discussed in a later section (paragraph 4) as is the general DPMA application procedure envisaged at this time (paragraph 5).

3. Requirements for requesting accelerated examination under the PPH Pilot Program at the DPMA

There are four requirements for requesting accelerated examination under the PPH pilot program at the DPMA as OSF. These are:

- a) **The DPMA application (including PCT national phase application in Germany)
either:**

- i) validly claims priority under the Paris Convention from either a single corresponding SIPO application or multiple SIPO applications (examples are provided in Annex, figures A, B, G, H and J); or
 - ii) is a PCT application in the national phase without Chinese priority claim for which the national phase was initiated in China either without priority claim (an example is provided in Annex, figure K) or claiming priority from the prior PCT application (an example is provided in Annex, figure M); or
 - iii) validly claims priority under the Paris Convention from a PCT application the national phase of which was initiated in China (an example is provided in Annex, figure L) or
 - iv) is a PCT application in the national phase for which the national phase was initiated in China and the relevant PCT application for the national phase in China and Germany validly claims priority under the Paris convention from a prior PCT application (an example is provided in Annex, figure N), or
 - v) is a divisional application based on the originally filed application that is included in the above i), ii), iii) or iv).
- b) **At least one corresponding SIPO application has one or more claims that have been determined to be patentable by the SIPO.**

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 a patent has not yet been granted in respect of this application.

The office actions include:

- (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 it is not explicitly stated in a SIPO office action that a particular claim is allowable/patentable, the applicant must include an explanation accompanying the request for participation in the PPH pilot program stating that no reason for rejection had been given in the SIPO office action in relation to a claim and that this claim is therefore deemed to be allowable/patentable by the SIPO.

For example, claims not mentioned by the SIPO in the "First Notice of the Opinion on Examination (第一次审查意见通知书)" under item "6. the Opinion on the Conclusion of Examination (审查的结论性意见)" about "Claims (权利要求书)" or in the "Second/Third/ or any further Notice of the Opinion on Examination(第 次审查意见通知书)" under item "5. the Opinion on the Conclusion of Examination (审查的结论性意见)" about "Claims (权利要求书)" may be deemed to be implicitly identified to be allowable/patentable. In this case the applicant must include (provide) the above explanation.

- c) **All claims in the DPMA application for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as patentable in the SIPO application.**

Claims shall be considered to sufficiently correspond where the claims are of the same scope. This means that the claims in the DPMA application have a common technical feature with the claims in the SIPO application which makes the claims allowable over the prior art in the corresponding SIPO application.

Where amended claims have been determined to be patentable by the SIPO, the claims of the DPMA application should be such that they correspond to the amended claims of the SIPO application.

Claims of the DPMA application which are appended to earlier claims of the DPMA application corresponding to claims that are indicated as patentable by the SIPO will also be considered where such claims fall within the scope of the claims indicated as patentable by the SIPO.

- d) **The DPMA has not begun substantive examination of the application yet.**

4. Required documents for accelerated examination under the PPH Pilot Program at the DPMA

The following documentation will be needed to support a request for accelerated examination under the PPH pilot program at the DPMA:

- a) **A copy of all office actions on the corresponding SIPO application(s) and translation thereof.**

Both German and English are acceptable as translation languages.

No paper copy and corresponding translation of the office actions need be supplied if the office actions are available by way of online file inspection. However, if the available (machine) translation is insufficient, the DPMA examiner may request an additional translation from the applicant.

- b) **A copy of the claims examined by the SIPO and copies of subsequent amended claims found to be patentable by the SIPO where appropriate and translation of them.**

Both German and English are acceptable as translation languages.

No paper copy or translation of the claims need be supplied if the claims are available by way of online file inspection. However, if the available (machine) translation is insufficient, the DPMA examiner may request an additional translation from the applicant.

- c) **A completed claim correspondence table in German language showing the relationship between the claims of the DPMA application for accelerated examination under the PPH and the claims of the corresponding SIPO application considered patentable by the SIPO.**

Sufficient correspondence of claims occurs where the claims are of the same scope as defined above in 3c).

When claims are just literal translation, the applicant can just write down that "sind

gleich" ("they are 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 above in 3c).

d) A copy of the document(s) cited by the SIPO examiner

If the cited document is a patent document it does not have to be submitted as it is generally available to the DPMA either via DEPATIS or EPOQUE. Where the DPMA has difficulty in obtaining a patent document the Office will ask the applicant to submit it. As a rule, cited documents need not be translated.

The applicant has to provide the relevant information for accelerated examination under the PPH by completing a PPH request form which will be made available for download from the DPMA website. The form should be sent to the DPMA along with the relevant supporting documentation.

If the applicant has already submitted the above documents a) to d) to the DPMA through simultaneous or past procedures, the applicant can incorporate the documents by reference and does not have to attach them.

5. Procedure for accelerated examination under the PPH Pilot Program at the DPMA

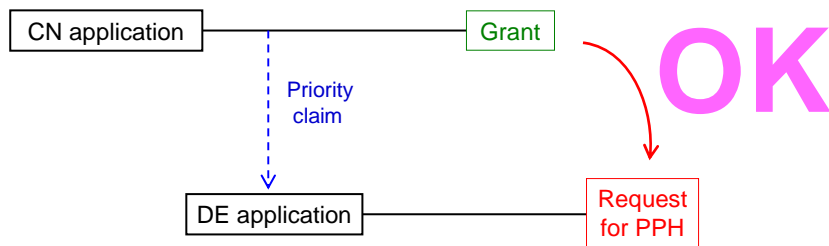
The applicant files a request form for accelerated examination under the PPH pilot program to the DPMA, including the relevant supporting documents.

- a) If the requirements are met, the DPMA will conduct the accelerated examination.
- b) If the application does not qualify for participation in the PPH project, the applicant will be informed accordingly and the application will be further processed under the standard DPMA examination procedure, without acceleration.

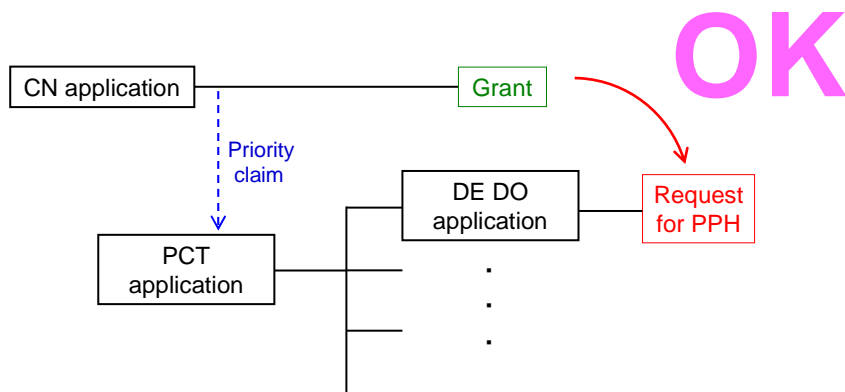
Information: In those instances where the request does not meet all the requirements, the applicant may correct defects and resubmit the PPH request. Before the issuing of the notification of not approving accelerated examination under the PPH, the applicant may submit missing documents. Even after the issuing of the notification of not approving accelerated examination under the PPH, the applicant can request the PPH again so long as the request is filed before the issuing of the first office action ("Erstbescheid").

Annexes:

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

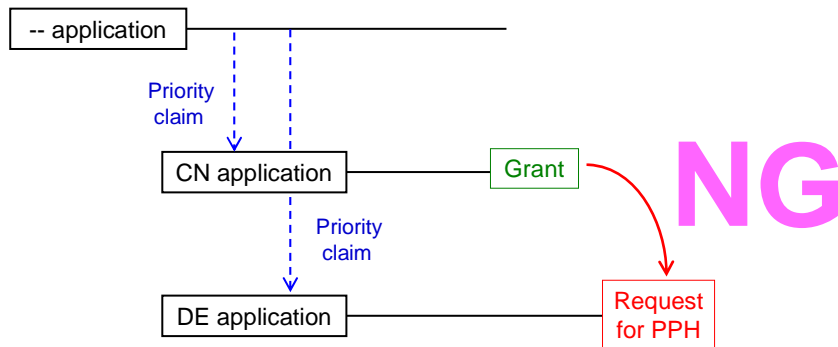


B A case meeting requirement (a) (i)
- PCT route -



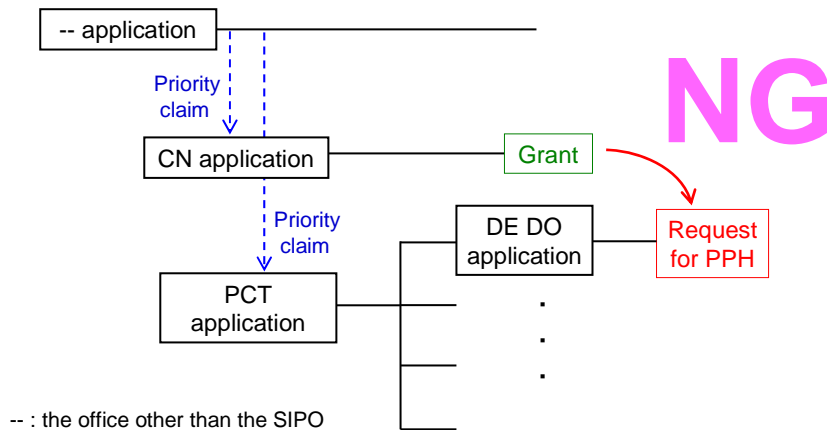
C A case not meeting requirement (a)

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

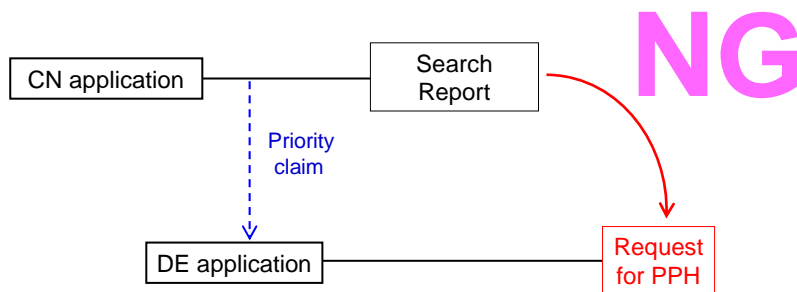


D A case not meeting requirement (a)

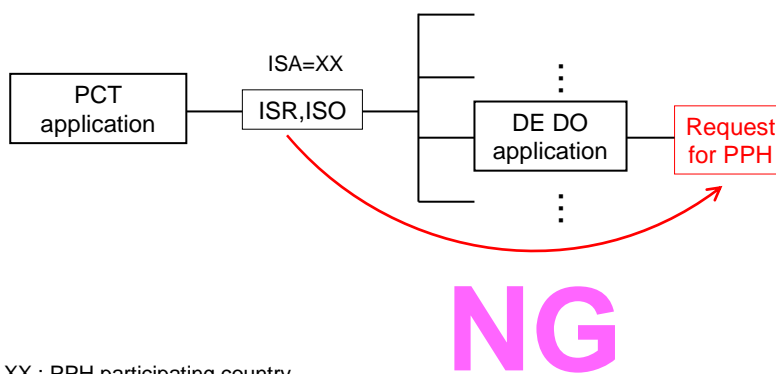
- PCT route, but the first application is from the third country -



E A case not meeting requirement (b)
- Search Report -

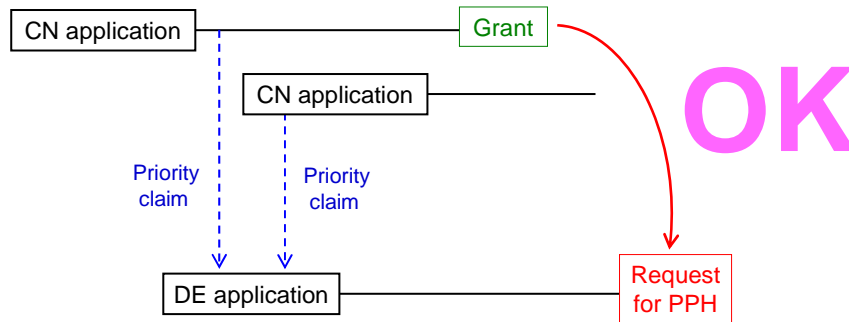


F A case not meeting requirement (b)
- ISR, ISO -

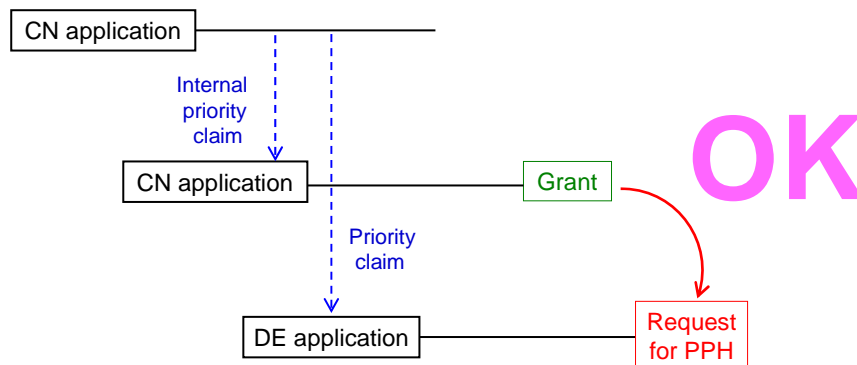


XX : PPH participating country

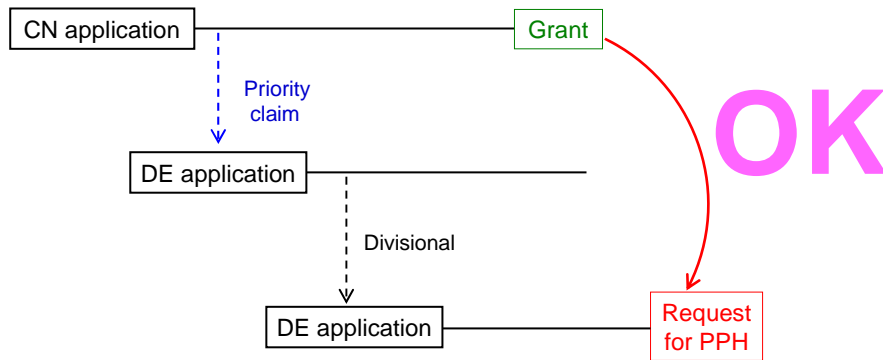
G A case meeting requirement (a) (i)
- Paris route & Complex priority -



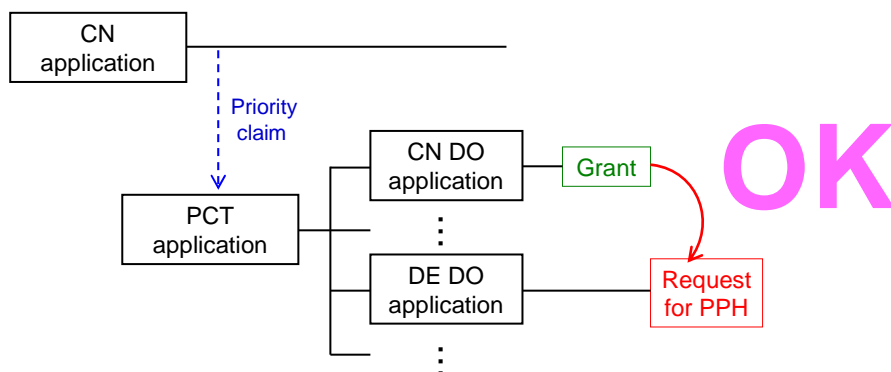
H A case meeting requirement (a) (i)
- Paris route & Internal priority -



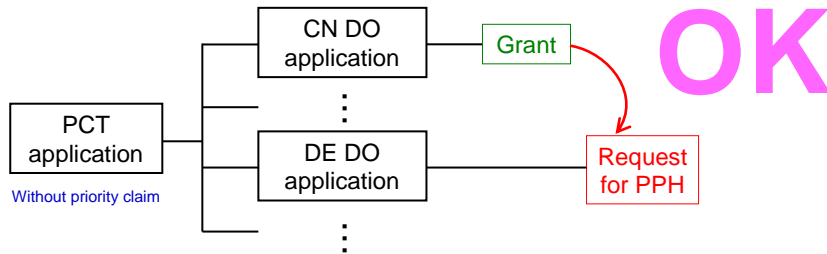
I A case meeting requirement (a) (i)
- Paris route & divisional application -



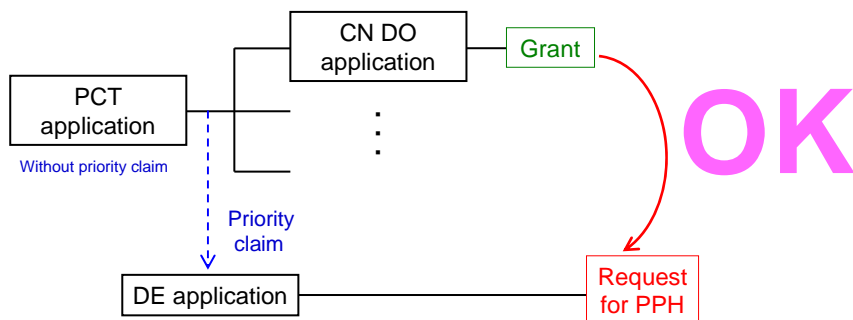
J A case meeting requirement (a) (i)
- PCT route -



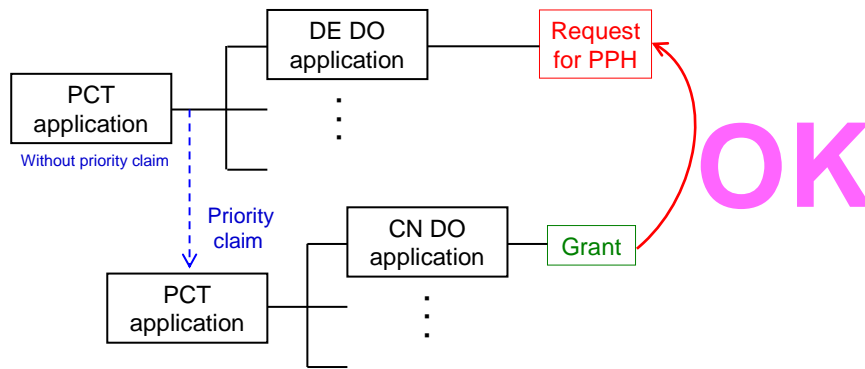
K A case meeting requirement (a) (ii)
- Direct PCT route -



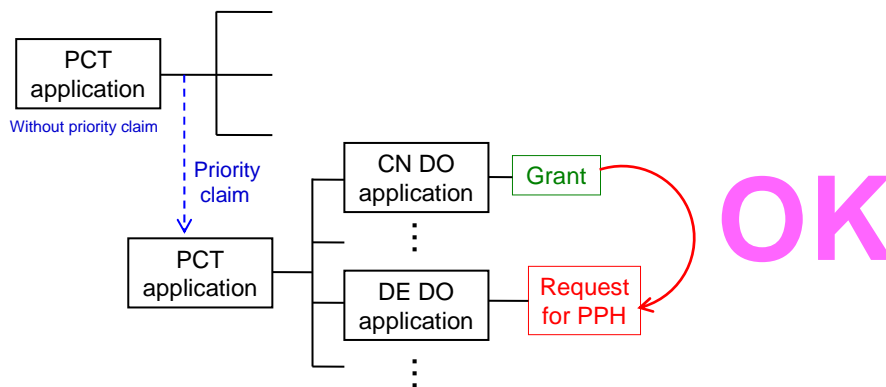
L A case meeting requirement (a) (iii)
- Direct PCT & Paris route -



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



N A case meeting requirement (a) (iv)
- Direct PCT & PCT route -



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

