

INTELLECTUAL PROPERTY UPDATE

16 January 2015

PATENT PROSECUTION HIGHWAY

INTRODUCTION

The Patent Prosecution Highway (“PPH”) is a programme that allows for the sharing of search and examination results between participating patent offices. The goal is to allow applicants in participating countries to obtain corresponding patents quickly.

With effect from 6 January 2015, the European Patent Office (“EPO”) has entered into a PPH arrangement that is similar to the existing PPH arrangements that the Intellectual Property Office of Singapore (“IPOS”) has with the State Intellectual Property Office of the People’s Republic of China (“SIPO”), the Mexican Institute of Industrial Property of the United Mexican States (“IMPI”), and the German Patent and Trade Mark Office (“DPMA”).

The bilateral PPH pilot programme between IPOS and the EPO is for a period of 3 years until 5 January 2018.

Applicability of accelerated examination

The bilateral PPH pilot programme between IPOS and the EPO is only applicable to search and examination options with substantive examination.

The table below sets out the search and examination options for which accelerated prosecution with the PPH can be requested.

	PCT National Phase Applications	Direct National Applications
For applications filed before 14 February 2014	<ul style="list-style-type: none"> Request for substantive Search and Examination. Request for examination based on the foreign search report of a corresponding application or a corresponding international application. Request for examination based on the international search report of the PCT International Application from which the Singapore Application is derived. 	<ul style="list-style-type: none"> Request for substantive Search and Examination. Request for examination based on the foreign search report of a corresponding application or a corresponding international application.
For applications filed on or after 14 February 2014	<ul style="list-style-type: none"> Request for substantive Search and Examination. Request for examination based on the foreign search report of a corresponding application, a corresponding international application, or a related national phase application. 	<ul style="list-style-type: none"> Request for substantive Search and Examination. Request for examination based on the foreign search report of a corresponding application or a corresponding international application.

	PCT National Phase Applications	Direct National Applications
For applications filed on or after 14 February 2014	<ul style="list-style-type: none"> Request for examination based on the international search report of the PCT International Application from which the Singapore Application is derived. 	

The bilateral PPH pilot programme between IPOS and the EPO is NOT applicable to the following search and examination options.

	PCT National Phase Applications	Direct National Applications
For applications filed before 14 February 2014	<ul style="list-style-type: none"> Filing a notice to rely on the grant/allowance of a corresponding application or a corresponding international application. Filing a Notice of Intention to rely on the IPRP. 	<ul style="list-style-type: none"> Filing a notice to rely on the grant/allowance of a corresponding application or a corresponding international application.
For applications filed on or after 14 February 2014	<ul style="list-style-type: none"> Request for supplementary examination based on the grant/allowance of a corresponding application, a corresponding international application, or a related national phase application. Request for supplementary examination 	<ul style="list-style-type: none"> Request for supplementary examination based on the grant/allowance of a corresponding application or a corresponding international application.

	PCT National Phase Applications	Direct National Applications
	based on the IPRP of the PCT International Application from which the Singapore Application is derived.	

Requirements for requesting accelerated examination

In order to request for an accelerated examination, the requirements set out below must be met:

- (a) both the SG application for which accelerated prosecution is requested and the EPO application forming the basis of the PPH request must have the same earliest date (whether this is a priority date or a filing date);
- (b) the EPO application must have at least one claim that is determined to be allowable/patentable by the EPO respectively, and all claims in the SG application must be either identical or narrower in scope (“related”) than the allowed/patentable claims in the EPO application respectively;
- (c) examination must not yet have begun for the SG application.

Necessary documents for requesting accelerated examination

In order to request for an accelerated examination of an SG application, the following documents are required:

- (a) a copy of all office actions of the EPO application being relied upon;
- (b) a copy of the allowable/patentable patent claims referred to in (a); and

- (c) a table setting out how each claim in the SG application is related to the claims in (b).

If the documents in (a) and (b) above are available in the EPO Dossier Access System or the WIPO PATENTSCOPE System, the said documents need not be filed.

If any of the documents in (a) and (b) above are not in English, then an English translation of the document will be required to be submitted together with the document.



Gerald Koh
Director, Intellectual Property
T: +65 6531 2559
E: gerald.koh@drewnapier.com

If you have any questions or comments on this article, please contact:



Dedar Singh Gill
Managing Director, Intellectual Property
T: +65 6531 2506
E: dedar.singh@drewnapier.com



Cecelia Girvin
Deputy Managing Director, Intellectual Property
T: +65 6531 2570
E: cecelia.girvin@drewnapier.com

The content of this article does not constitute legal advice and should not be relied on as such. Specific advice should be sought about your specific circumstances. Copyright in this publication is owned by Drew & Napier LLC. This publication may not be reproduced or transmitted in any form or by any means, in whole or in part, without prior written approval.

Drew & Napier LLC
10 Collyer Quay
#10-01 Ocean Financial Centre
Singapore 049315

www.drewnapier.com

T : +65 6535 0733
T : +65 9726 0573 (After Hours)
F : +65 6535 4906