

INTELLECTUAL PROPERTY UPDATE

18 December 2014

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.

Updates to the PPH in Singapore are discussed below.

GLOBAL PATENT PROSECUTION HIGHWAY (“GPPH”)

With effect from 1 November 2014, the Intellectual Property Office of Singapore (“IPOS”) joined the GPPH network and became a participating office of the GPPH pilot programme.

Under the GPPH programme, a request for accelerated examination of a Singapore patent application (“SG application”) can be made by relying on the following which are established by any of the other GPPH participating offices, known as Offices of Earlier Examination (“OEE”):

- (a) patent search and examination results; or
- (b) international search and/or examination results under the Patent Cooperation Treaty (“PCT”),

For the PCT option, the GPPH participating office must also act as an International Searching

Authority and International Preliminary Examining Authority under the PCT.

The GPPH pilot programme replaces the bilateral PPH pilot programmes between IPOS and the United States Patent and Trademark Office, the Japan Patent Office, and the Korean Intellectual Property Office since the aforementioned offices are also GPPH participating offices.

The GPPH pilot programme does not replace the existing PPH pilot programmes between IPOS and the State Intellectual Property Office (“SIPO”) of the People’s Republic of China, the Mexican Institute of Industrial Property (“IMPI”) of the United Mexican States, and the German Patent and Trade Mark Office (“DPMA”).

Applicability of accelerated examination

The GPPH pilot programme is only applicable to search and examination options with substantive examination.

The table below sets out the search and examination options for which accelerated examination with GPPH 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 	<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

	Application from which the Singapore Application is derived	
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 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

The GPPH pilot programme 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 based on the IPRP of the PCT International Application from which the Singapore Application is derived. 	<ul style="list-style-type: none"> Request for supplementary examination based on the grant/allowance of a corresponding application or a corresponding international application.
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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 examination is requested and the OEE application(s) forming the basis of the GPPH request must have the same earliest date (whether this is a priority date or a filing date);
- (b) the OEE application must have at least one claim that is determined to be allowable/patentable by the OEE, and all claims in the SG application must be either identical or narrower in scope (“related”) than the allowed/patentable claims in the OEE application;
- (c) examination has not begun on the SG application.

Necessary documents for requesting accelerated examination

In order to request for an accelerated examination of an SG application, we will require the following:

- (a) a copy of all office actions of the OEE 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 OEE Dossier Access System, the said documents need not be filed. A list of the available Dossier Access Systems can be found in Annex IV of the GGPH Guidelines available on the IPOS website.

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.

BILATERAL PPH PILOT PROGRAMMES

The existing bilateral PPH pilot programmes between IPOS and the following offices remain unchanged:

- (a) SIPO;
- (b) IMPI;
- (c) DPMA.

Applicability of accelerated prosecution

Similar to the GPPH pilot programme, the bilateral PPH pilot programmes between IPOS and SIPO/IMPI/DPMA are 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 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. • Request for examination based on the international search report of the PCT International 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.

	from which the Singapore Application is derived.	
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Requirement for requesting accelerated prosecution

In order to request an accelerated prosecution, the following requirements must be met:

The bilateral PPH pilot programmes between IPOS and SIPO/IMPI/DPMA are 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 based on the IPRP of the PCT International Application from which the Singapore Application is derived. 	<ul style="list-style-type: none"> Request for supplementary examination based on the grant/allowance of a corresponding application or a corresponding international application.

- (a) both the SG application for which accelerated prosecution is requested and the SIPO/IMPI/DPMA application forming the basis of the PPH request must have the same earliest date (whether this is a priority date or a filing date); and
- (b) the SIPO/IMPI/DPMA application must have at least one claim that is determined to be allowable/patentable by SIPO/IMPI/DPMA respectively, and all claims in the SG application must be either identical or narrower in scope than the allowed/patentable claims in the SIPO/IMPI/DPMA application respectively.

The following additional requirements also apply:

- (a) For IPOS-SIPO, the SG application must not have a valid Patents Form 10 (Request for Search Report or Supplementary Search Report) filed.
- (b) For IPOS-IMPI, the SG application must not have a valid Patents Form 12A (Request for Supplementary Examination Report) filed.
- (c) For IPOS-DPMA, examination must not have begun for the SG application.

Necessary documents for requesting accelerated prosecution

The documents required for the request are the same as that for the GPPH programme.

REFERENCES

Please click on the following links to access the documents.

1. **GGPH Guidelines for filing a Request at IPOS relying on the National Search and Examination results from other offices**
2. **GGPH Guidelines for filing a Request at IPOS relying on the International Search and/or Examination Results under the Patent Cooperation Treaty**



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