

Procedure to file a Request to the Eurasian Patent Office of the Eurasian Patent Organization for accelerated prosecution of patent application in accordance with the Patent Prosecution Highway Pilot Program between the Eurasian Patent Office of the Eurasian Patent Organization and the China National Intellectual Property Administration

The Patent Prosecution Highway Pilot Program (PPH) between Eurasian Patent Office of the Eurasian Patent Organization and the China National Intellectual Property Administration (PPH Pilot Program) will be extended for an indefinite time period, starting on 1 April 2023.

The Offices may terminate the PPH pilot program if the volume of participation exceeds manageable level. Ex Ante notice will be published if the PPH pilot program is terminated.

I. PPH using the national work products from CNIPA

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the EAPO (EAPO application) and satisfies the following requirements under the EAPO-CNIPA Patent Prosecution Highway (PPH) pilot program based on the CNIPA application.

When filing a request for the PPH pilot program, an applicant must submit a request form “Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program” (PPH request) to the EAPO.

1. Requirements

(a) The EAPO application (included the PCT application entered into regional phase at the EAPO) for which participation in the PPH Pilot Program is requested and the corresponding application on the basis of which the request on participation in PPH (PPH Request) is filed shall have the same date of priority or the same date of filing.

The EAPO application (including PCT regional phase application) may be:

(i) an application which validly claims priority under the Paris Convention to the CNIPA application(s) (examples are provided in Annex I, Figures A, B, C, F, G and H), or

(ii) a PCT regional phase application without priority claim (an example is provided in Annex I, Figures 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, Figures J, K and L).

The EAPO application, which validly claims priority to multiple CNIPA 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.

(b) At least one corresponding application exists in the CNIPA which has one or more claims that are determined to be patentable/allowable by the CNIPA. The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the CNIPA application which forms the basis of the priority claim (e.g., a divisional application of the CNIPA application or an application which claims domestic priority to the CNIPA application (see Figure C in Annex I)), or a CNIPA 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 the CNIPA examiner explicitly identified the claims to be “allowable/patentable” in the latest office action, even if the application has not been granted yet.

CNIPA Office actions mentioned above are:

- (a) Decision to Grant a Patent,
- (b) First/Second/Third/...Office Action,
- (c) Decision of Refusal,
- (d) Reexamination Decision,
- (e) Invalidation Decision.

(c) All claims in the EAPO 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 of those claims determined to be patentable/allowable in the CNIPA.

Claims are considered to “sufficiently correspond” where, aside from differences due to translations and claim format, the claims in the EAPO application are of the same or similar scope as the claims in the CNIPA application, or the claims in the EAPO are narrower in scope than the claims in the CNIPA.

In this regard, a claim that is narrower in scope occurs when CNIPA claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims).

A claim in the EAPO application which introduces a new/different category of claims to those claims determined to be patentable/allowable in the CNIPA is not considered to sufficiently correspond. For example, if the CNIPA claims only contain claims to a process of manufacturing a product, then the claims in the EAPO are not considered to sufficiently correspond if the EAPO claims introduce product claims that are dependent on the corresponding process claims.

It is not necessary to include “all” claims determined to be patentable/allowable in the CNIPA in an application in the EAPO (the deletion of claims is allowable).

Any claims amended or added after the grant of the request for participation in

the PPH pilot program must sufficiently correspond to the claims indicated as patentable/allowable in the CNIPA application.

(d) Substantive examination of the application has not begun at the moment of filing the request for the PPH with the EAPO.

(e) For the EAPO application, applicant must request for the substantive examination and pay the fees prescribed for substantive examination.

2. Documents to be submitted

To qualify for participation in the PPH Pilot Program an applicant shall submit:

a) the PPH Request to the EAPO. The PPH Request Form is available at www.eapo.org in the section Documents/electronic forms (Annex III);

b) copies of all office actions (which are relevant to substantial examination for patentability in CNIPA) which were issued for the corresponding application, and Russian or English translations thereof;

(c) copies of all claims indicated as patentable in CNIPA and Russian or English translation thereof;

(d) copies of documents cited by CNIPA examiner.

If the cited document is a patent document the applicant needs not present it as this kind of documents are usually accessible for the EAPO. In case the EAPO does not possess the required document the applicant must submit this patent document at the request of the examiner. Non-patent literature shall always be submitted.

Submission of translation of the cited documents is required if their translation into Russian or English is not available;

(e) a table of claims correspondence.

The applicant submitting PPH request must submit a table of the claims correspondence that explains the correspondence of the claims in the EAPO application to the claims that are recognized as patentable in the CNIPA application.

If the claims are translated literally the applicant may write in the table "claims are identical". If the claims are not a literal translation, the table should explain the conformity of each claim.

If the applicant has already submitted to the EAPO the documents specified in subparagraphs (b) to (e) during simultaneous or previous procedures, he can include them by referring to them, without attaching the documents themselves. For the documents specified in subparagraphs (b) and (c), the use of machine translation is permissible. In case of poor quality of machine translation, the EAPO may ask the applicant to provide an accurate translation. If CNIPA application is not published, then the applicant must submit the documents specified in subparagraphs (b) and (c) above when applying for the PPH application.

3. Procedure for considering the request for the PPH pilot program

The decision to satisfy the PPH request is made subject to the fulfillment of all the requirements specified in paragraphs 1 and 2 of this Procedure, which the applicant is notified about.

If all the requirements necessary to satisfy the PPH request are not complied with by the applicant and which can be eliminated by the applicant, the EAPO shall notify the applicant about the need to correct the identified deficiencies within the time specified in the notification.

If the applicant does not eliminate these shortcomings, the EAPO will inform the applicant of the refusal to satisfy the request. In this case, the EAPO application is subject to examination in the order of priority within the framework of the EAPO procedure.

II. PPH using the PCT international work products from the CNIPA

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the EAPO and satisfies the following requirements under the EAPO-CNIPA Patent Prosecution Highway pilot program based on PCT international work products (PCT-PPH pilot program).

When filing a request for the PCT-PPH program, an applicant must submit a request form “Request for Participation in the PCT-PPH Pilot Program” (PCT-PPH request) to the EAPO.

1. Requirements

The application which is filed with the EAPO and on which the applicant files a request under the PCT-PPH must satisfy the following requirements:

1) The latest work product in the international phase of a PCT application corresponding to the application (international work product), namely the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examining Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive steps and industrial applicability).

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the CNIPA, but, if priority is claimed, the priority claim can be to an application in any Office, see example A' in Annex II (application ZZ can be any national application).

The applicant cannot file a PCT-PPH request on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation irrespective of whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in PCT-PPH program if the applicant does not explain why the claim(s) is/are not subject to the observation.

In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

2) The relationship between the application and the corresponding international application satisfies one of the following requirements:

- (a) The application is a regional phase application of the corresponding international application. (See Figures A, A', and A'' in Annex II)
- (b) The application is an EAPO application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex II)
- (c) The application is a regional phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)
- (d) The application is an EAPO application claiming priority from the corresponding international application. (See Figure D in Annex II)
- (e) The application is the derivative application (divisional application and application claiming Eurasian priority etc.) of the application which satisfies one of the above requirements (A) – (D). (See Figures E1 and E2 in Annex II)

3) All claims on file as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated as allowable in the latest international work product of the corresponding international application.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the EAPO are of the same or similar scope as the claims indicated as allowable in the latest international work product, or the claims in the EAPO are narrower in scope than the claims indicated as allowable in the latest international work product. In this regard, a claim that is narrower in scope occurs when a claim indicated as allowable in the latest international work product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims).

A claim in the EAPO application which introduces a new/different category of claims to those claims indicated as allowable in the latest international work product is not considered to sufficiently correspond. For example, where the claims indicated as allowable in the latest international work product only

contain claims to a process of manufacturing a product, then the claims in the EAPO application are not considered to sufficiently correspond if the EAPO claims introduce product claims that are dependent on the corresponding process claims.

It is not necessary to include “all” claims determined to be patentable/allowable in the corresponding international application in the EAPO application (the deletion of claims is allowable). For example, in the case where the corresponding international application contains 5 claims determined to be patentable/allowable, the EAPO application may contain only 3 of these 5 claims.

Any claims amended or added after the grant of the PCT-PPH request but before the first office action need to sufficiently correspond to the claims indicated as allowable in the latest international work product.

Any claims amended or added after the first office action need not to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product when applicants need to amend claims in order to overcome the reasons for refusal raised by examiners. Any amendment outside of the claim correspondence requirement is subject to examiners’ discretion.

4) The EAPO has not begun examination of the application at the time of PCT-PPH request.

2. Documents to be submitted

The applicant must submit the following documents attached to the request form in filing a PCT-PPH request. Some of the documents may not be required to submit in certain cases.

(1) A copy of the latest international work product which indicated the claims to be patentable/allowable and their Russian or English translations if they are not in English.

In case the application satisfies the relationship 1.(2)(A), the applicant need not submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via “PATENTSCOPE (registered trademark)”, an applicant need not submit these documents, unless otherwise requested by the EAPO. (WO/ISA and IPRP are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date.)

If it is impossible for the examiner to understand the translated international work product, the examiner can request the applicant to resubmit translation.

(2) A copy of a set of claims which the latest international work product of

the corresponding international application indicated to be patentable/allowable and their Russian or English translations if they are not in English.

If the copy of the set of claims which are indicated to be patentable/allowable is available via “PATENTSCOPE (registered trademark)” (e.g. the international Patent Gazette has been published), an applicant need not submit this document unless otherwise requested by the EAPO.

If it is impossible for the examiner to understand the translated claims, the examiner can request the applicant to resubmit translations.

(3) A copy of references cited in the latest international work product of the international application corresponding to the application.

Documents which are only referred to as references and consequently do not constitute reason for refusal do not have to be submitted.

If the references are patent documents, the applicant does not have to submit them. In case the EAPO has difficulty in obtaining such patent document, however, the applicant has to submit the patent document at the examiner’s request.

Non-patent literature must always be submitted. Translations of cited references are unnecessary.

However, when submitting a request for PPH, applicant may submit their translations as part of the supporting documentation, in order to accelerate the consideration of the cited references.

(4) A claims correspondence table

The applicant requesting the PCT-PPH must submit a claim correspondence table explaining how the claims in the EAPO application correspond to the claims indicated as patentable/allowable in the latest international work product.

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.

When an applicant has already submitted the above mentioned documents (1) - (4) to the EAPO through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

3. Procedure for considering the request for the PPH pilot program

The decision to satisfy the PCT-PPH request is made subject to the fulfillment of all the requirements specified in paragraphs 1 and 2 of this Procedure, which the applicant is notified about.

If all the requirements necessary to satisfy the PPH request are not complied with by the applicant and which can be eliminated by the applicant, the EAPO shall notify the applicant about the need to correct the identified deficiencies

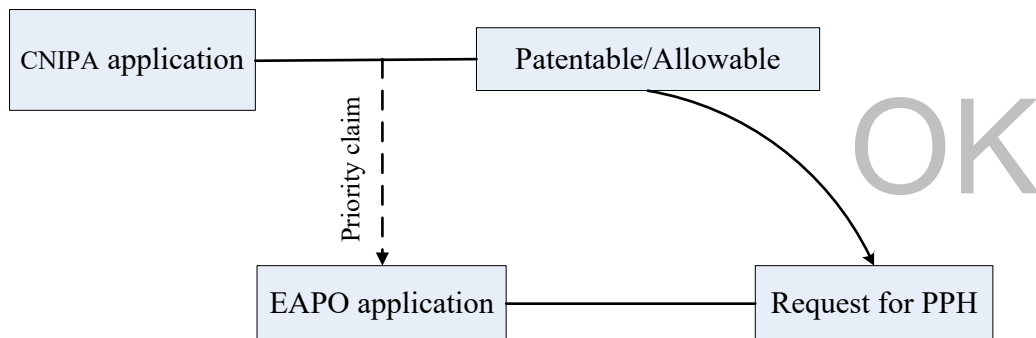
within the time specified in the notification.

If the applicant does not eliminate these shortcomings, the EAPO will inform the applicant of the refusal to satisfy the request. In this case, the EAPO application is subject to examination in the order of priority within the framework of the EAPO procedure.

ANNEX I

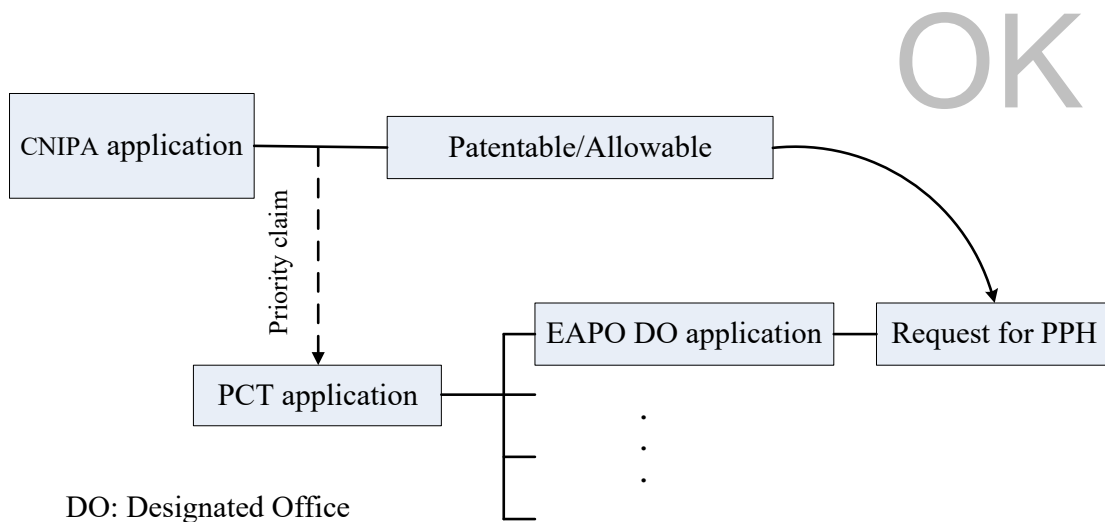
A

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



B

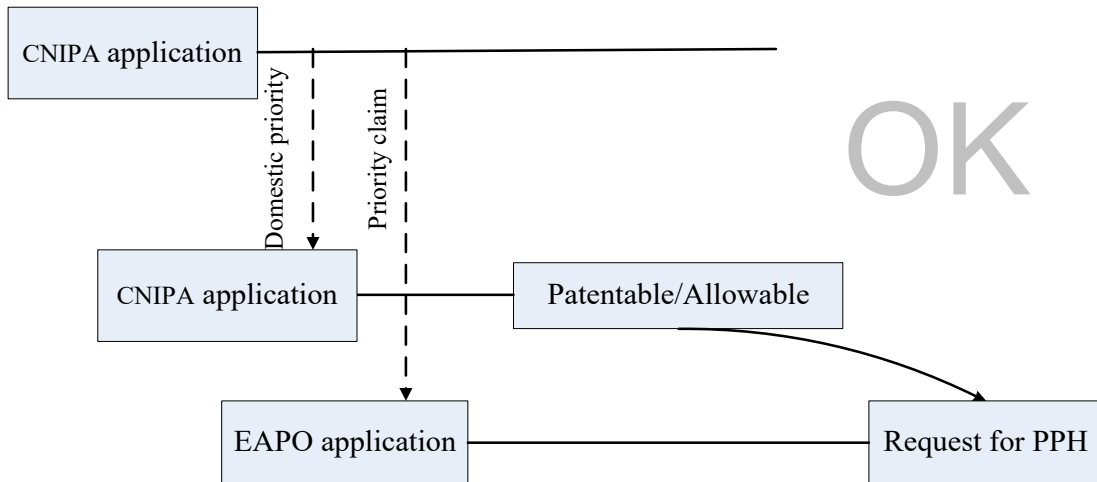
A case meeting requirement (a) (i)
- PCT route -



C

A case meeting requirement (a) (i)

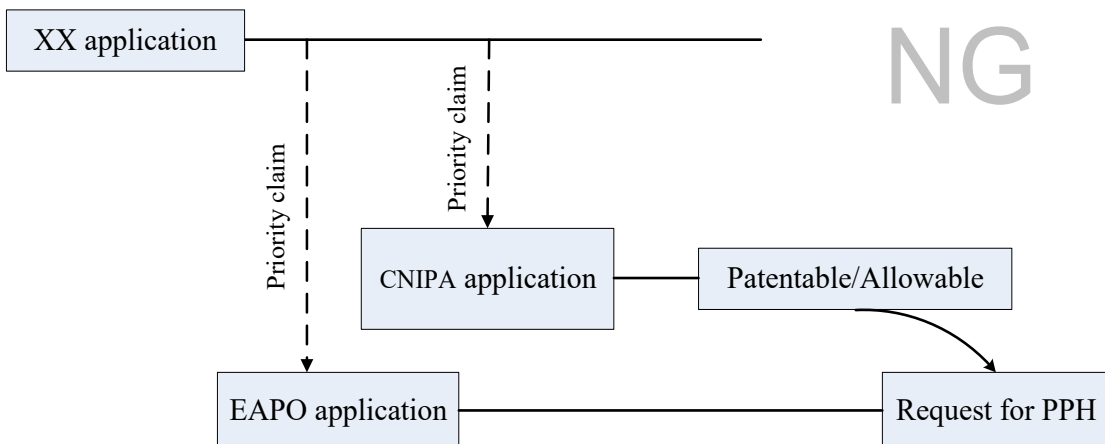
- Paris route, Domestic priority -



D

A case not meeting requirement (a)

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

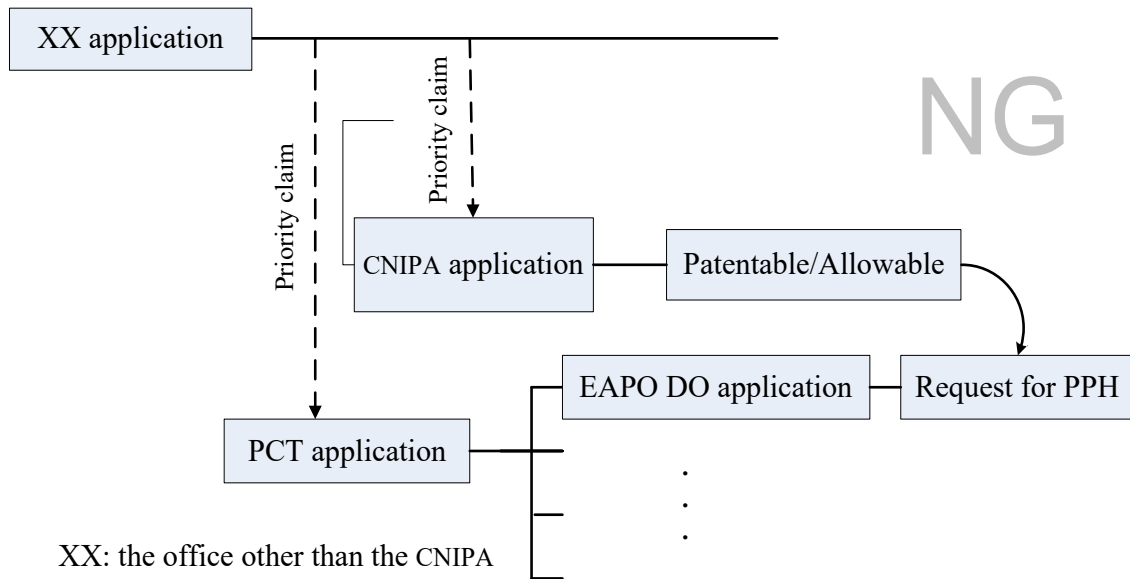


XX: the office other than the CNIPA

E

A case not meeting requirement (a)

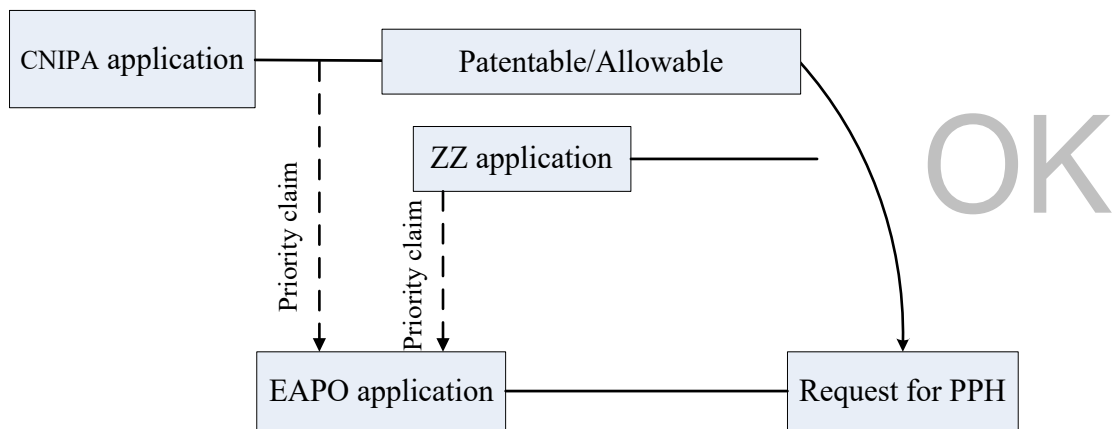
- PCT route, but the first application is from the third country -



F

A case meeting requirement (a) (i)

- Paris route & complex priority -

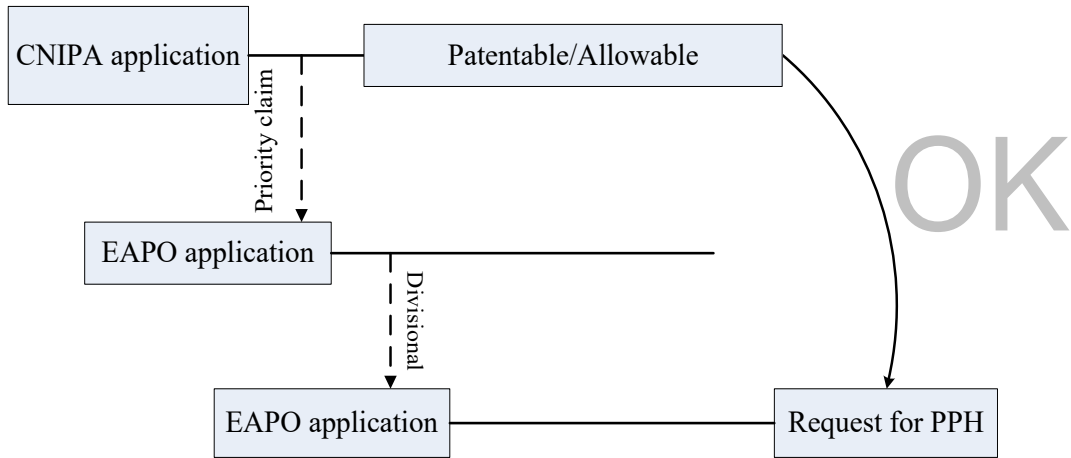


ZZ: any office

(The first application is from CNIPA)

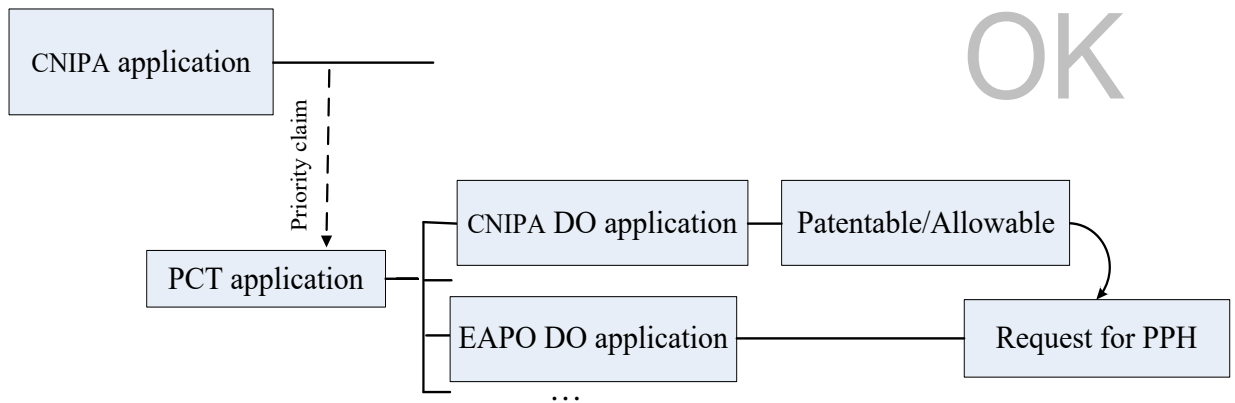
G

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



H

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

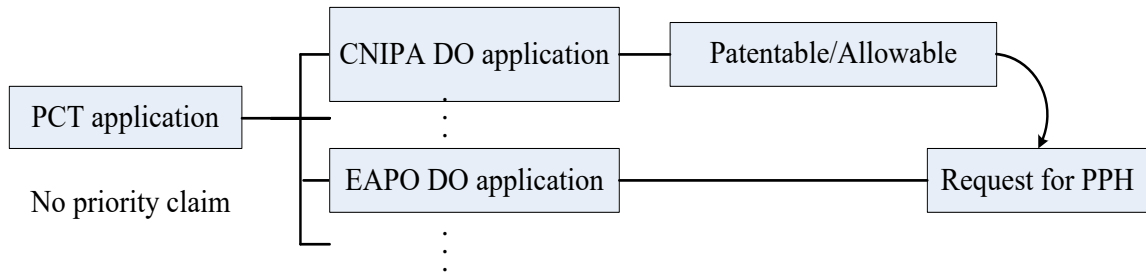


I

A case meeting requirement (a) (ii)

- Direct PCT route -

OK

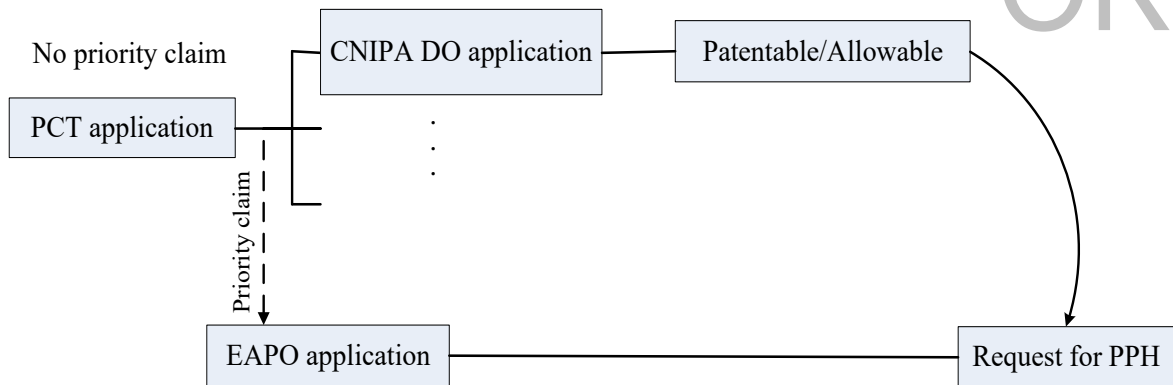


J

A case meeting requirement (a) (iii)

- Direct PCT & Paris route -

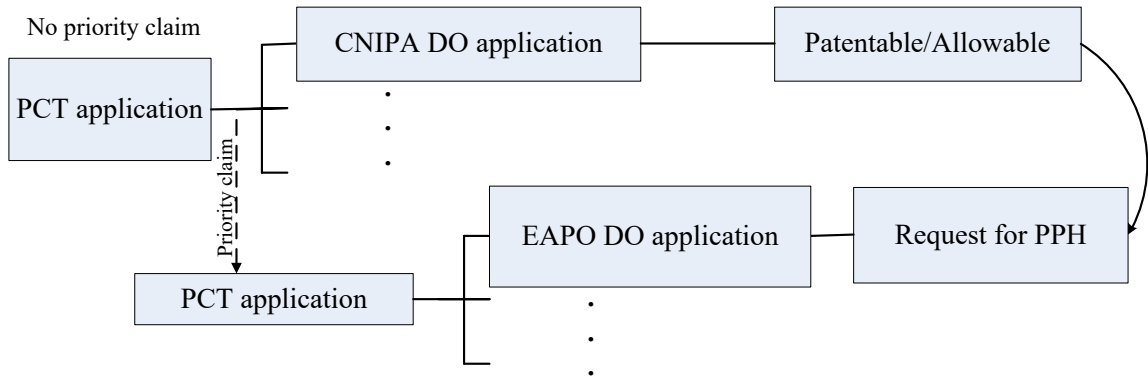
OK



K

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

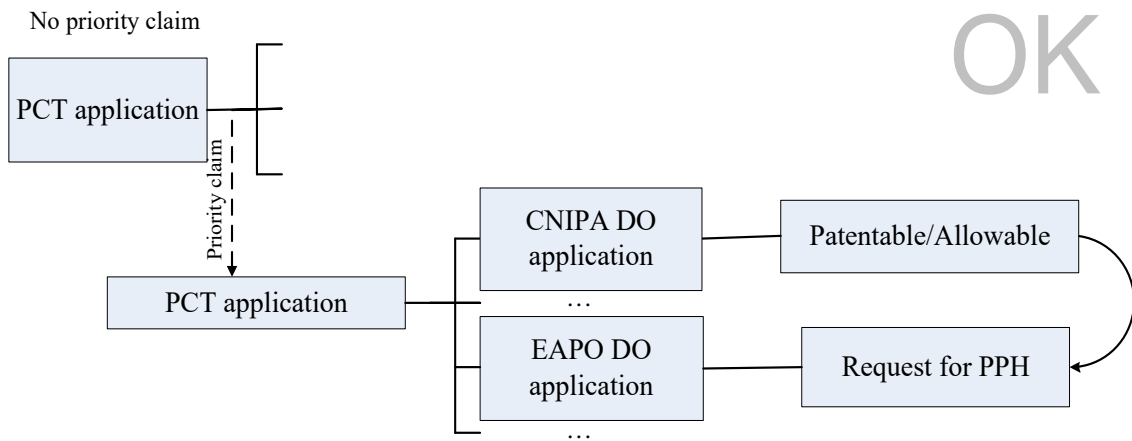
OK



L

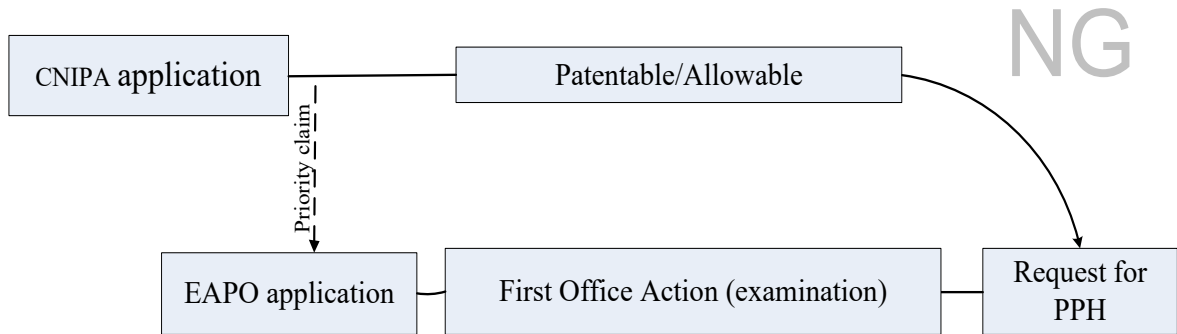
A case meeting requirement (a) (iii)
- Direct PCT & PCT route -

OK



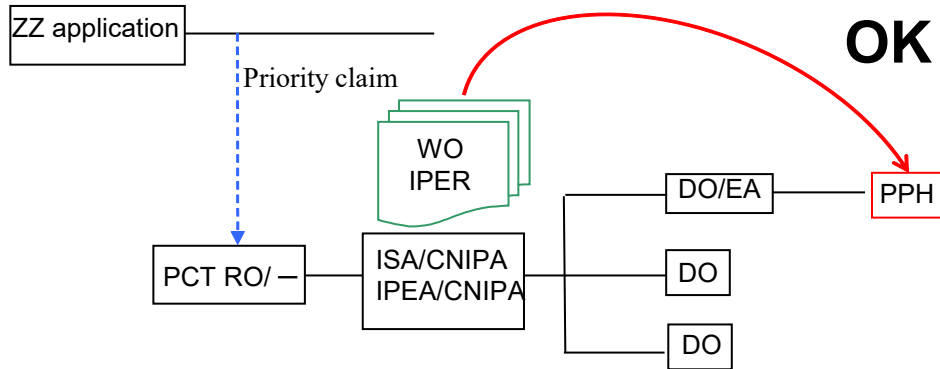
M

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



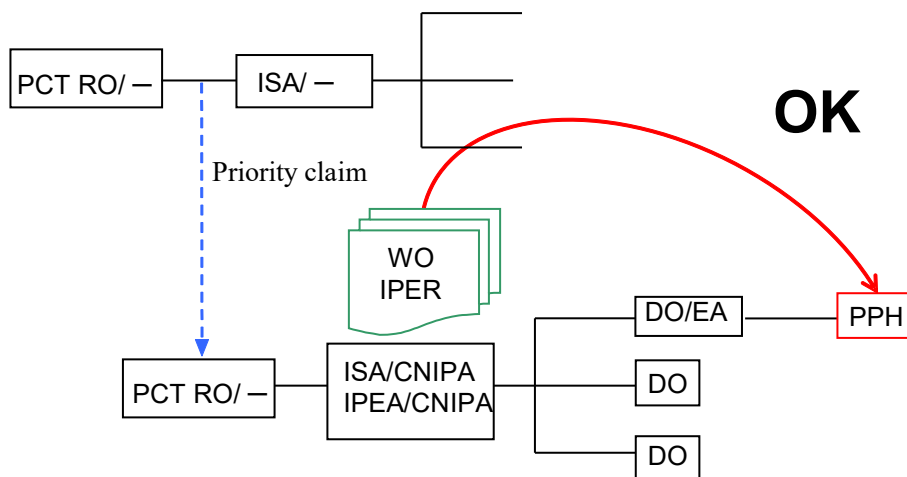
ANNEX II

(A') The application is a regional phase application
of the corresponding international application
(The corresponding international application claims priority
From a national application)

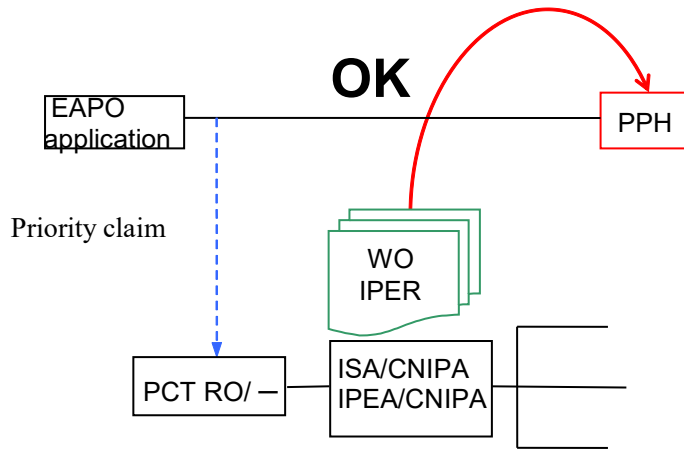


ZZ – any office

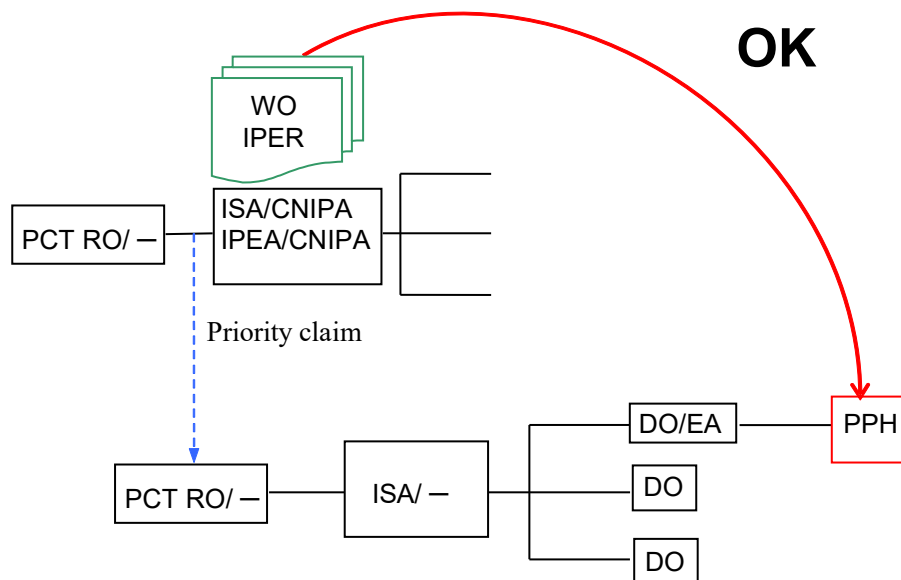
(A'') The application is a regional phase application
of the corresponding international application
(The corresponding international application claims priority
from an international application)



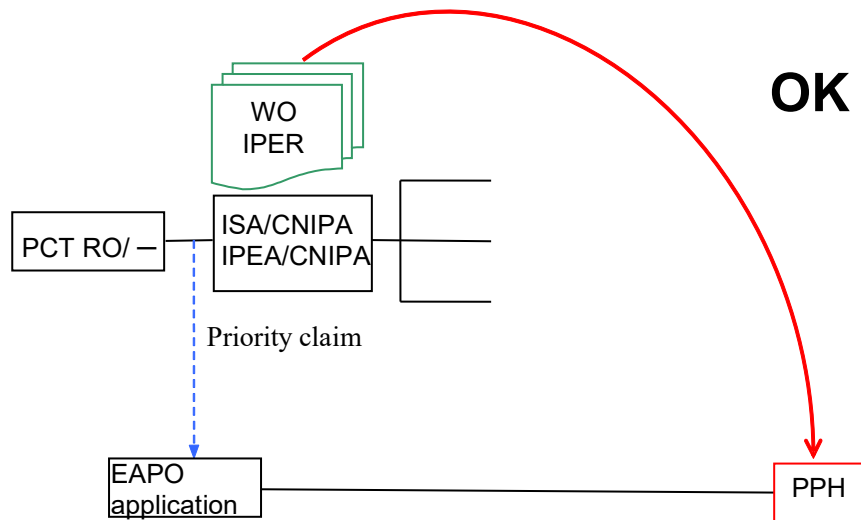
(B) The application is a Eurasian application as a basis of the priority claim of the corresponding international application



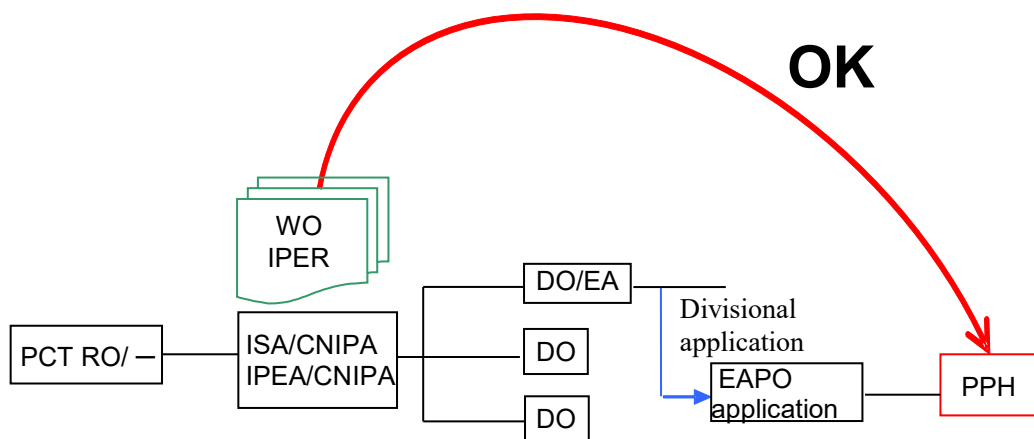
(C) The application is a regional phase application of an international application claiming priority from the corresponding international application



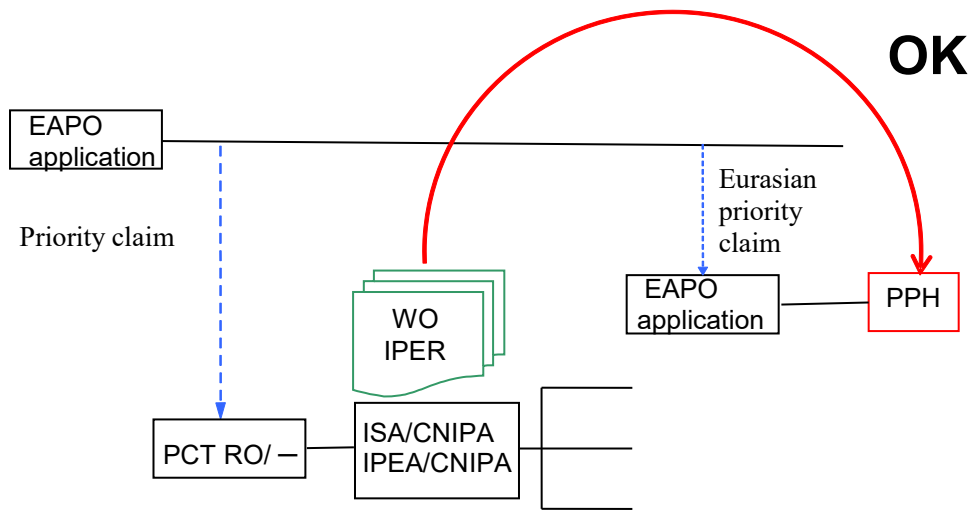
(D) The application is a Eurasian application claiming foreign/Eurasian priority from the corresponding international application



(E1) The application is a divisional application of an application which satisfies the requirement (A)



(E2) The application is an application claiming Eurasian priority from an application which satisfies the requirement (B)



ANNEX III

REQUEST

for accelerated patent prosecution in accordance with the Patent Prosecution Highway Pilot Program between the Eurasian Patent Office (EAPO) of the Eurasian Patent Organization and the China National Intellectual Property Administration (CNIPA)

Eurasian application number	
Applicant	
Hereby the applicant requests accelerated patent prosecution referring to this Eurasian application in accordance with the Patent Prosecution Highway Programme between EAPO and CNIPA (hereinafter referred to as Pilot Program)	
Attached documents:	Number of pages
<input type="checkbox"/> Claims correspondence table between this EAPO application and the CNIPA application for which a positive decision on patentability (novelty, inventive step and industrial applicability) is made by CNIPA.	
A copy and the Russian or English translation of the document confirming the claims patentability of the corresponding application <input type="checkbox"/> CNIPA Office actions <input type="checkbox"/> Written Opinion prepared by CNIPA as International Searching Authority (WO/ISA) <input type="checkbox"/> International Preliminary Examination Report prepared by CNIPA as an International Preliminary Examining Authority (IPER/IPEA) <input type="checkbox"/> Russian or English translation of the above documents	
<input type="checkbox"/> a copy of non-patent literature to which references are made in CNIPA Office actions or the CNIPA WO/ISA or IPER/IPEA acting as an ISA or as an IPEA <input type="checkbox"/> Russian or English translation thereof	

Date

Signature