

EXAMINATION GUIDELINES ON WORK-SHARING PROGRAMS (2022)

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PATENT PROSECUTION HIGHWAY

I. INTRODUCTION

The Patent Prosecution Highway (PPH) is an examination cooperation program between two IP Offices that allows the applicant to request accelerated examination by the second IP Office (OLE: Office of Later Examination) following a simple procedure, provided a corresponding application has been found allowable/ patentable by the first IP Office (OEE: Office of Earlier Examination).¹ It promotes and institutionalizes accelerated examination by using partner IP Offices' work products as additional references in patent examination. In this way, the usage of work products is maximized without prejudice to IPOPHL's national IP laws. It must be noted that allowance by the OEE does not automatically ensure allowance and grant by the OLE. The application must still comply, and overcome, the territorial patent laws of the OLE.

In 2012, the IPOPHL joined the Patent Prosecution Highway network by signing an agreement with the Japan Patent Office. IPOPHL became the 22nd member of the growing PPH Network, the second in ASEAN to do so.

At present, IPOPHL has bilateral PPH agreements with the Japan Patent Office, United States Patent and Trademark Office (2012), Korea Intellectual Property Office (2014), and the European Patent Office (2016). All of IPOPHL's existing PPH Agreements have been extended indefinitely. IPOPHL's existing bilateral PPH Agreements are aligned with the Global Patent Prosecution Highway (GPPH) which is a plurilateral PPH being observed among other members of the PPH Network.

¹ Patent Prosecution Highway Portal

II. GENERAL CONCEPTS

A. Accelerated Examination under PPH only applies to PH patent applications that have corresponding applications in IPOPHL's PPH Partner Offices

The accelerated examination benefit of Patent Prosecution Highway applies to IP Offices that have entered into a bilateral or multilateral cooperation program. It allows the applicant to request for an accelerated examination to the Office of Later Examination (OLE) if a corresponding earlier- filed application has already been found allowable/ patentable, or has already been granted patents in an Office of Earlier Examination (OEE).

The benefit of accelerated examination only applies to those IP Offices that have existing PPH programs with the IPOPHL. To date, the IPOPHL has four (4) PPH programs, namely: JPO, USPTO, KIPO, and EPO. Applicants requesting for an accelerated examination on the basis of corresponding applications other than the enumerated IP Offices shall be automatically denied accelerated examination and shall be treated as a regular application.

CASE 1	<p>Patent Application A has a corresponding application with the USPTO. Applicant filed a PPH Request before IPOPHL under IPOPHL- USPTO PPH, however using corresponding IP Australia application which is already deemed allowable/ patentable by the IP Australia Examiner.</p> <p><i><u>Patent Application A does not qualify for an accelerated examination under PPH. The basis of the Philippine claims corresponds not with the USPTO claims where IPOPHL has an existing and valid PPH agreement with, but with IP Australia which is not a party to the PPH. Said application shall be treated as a regular application.</u></i></p>
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CASE 2	<p>Patent Application X has a corresponding application with the EPO. Applicant filed a PPH Request before IPOPHL under IPOPHL-EPO PPH. EPO Examiner already issued an office action acknowledging the claims of the corresponding EP claims as allowable.</p> <p><i><u>Patent Application X qualifies for an accelerated examination under PPH.</u></i></p>

B. Foreign work-products are to be used only as additional references in patent examination

One of the requirements² in filing for a PPH Request is the submission of all the work products issued by the OEE. This includes the references cited, both Patent documents and non-patent literature. These documents shall be used as additional references by the PH Patent Examiner in examining the application.

It is important to stress that the findings of the foreign examiners reflected in these work products are not binding in the Philippines. Ultimately, Philippine IP laws, rules, guidelines, and jurisprudence shall apply in the determination of the patentability of a patent application.

² Applicant may forego of this requirement if the office actions by the OEE are accessible in the IP Office's Dossier System

C. Entry to the Patent Prosecution Highway does not guarantee grant of patents

One of the most common misconceptions about PPH is that all applications coursed through it shall automatically be allowable and granted Letters Patent. This view is incorrect. As earlier stated, the corresponding patent applications with the OEE's work products shall only serve as an additional reference for the PH Patent Examiner. As to how these shall be considered by the Examiner is up to their sound judgment, with the IP Code, patent examination guidelines, and jurisprudence as primary bases in determining as to whether or not a patent application is patentable.

III. ELIGIBILITY

- A. The PH Patent Application shall have the same earliest date (whether priority date or filing date) with the corresponding application in the OEE³**
- B. There must be at least one (1) claim common in both the applications filed in the OEE and OLE**
- C. PH Patent Application claims must “sufficiently correspond” to the claims of the corresponding OEE application**

PPH requires that the application filed before the OLE must not only have the same earliest date with the corresponding application filed before the OEE, but both claims must also sufficiently correspond with one another. It is important to stress that the guidelines do not require a word for word correspondence. Sufficient correspondence shall suffice.

CASE 1	OEE Claims	OLE Claims
	1. An anti- cancer composition	1. An anti- cancer composition which

³ See Annexes

	<p>comprising substance X, substance Y, and substance Z, for use in treating retinoblastoma among infants.</p>	<p>consists substance X.</p> <p>2. The anti- cancer composition in claim 1 which further consists of substance Y.</p> <p>3. The anti- cancer composition in claims 1 or 2 which further consists of substance Z.</p> <p>4. The anti- cancer composition according to any of claims 1 to 3 for use in treating retinoblastoma among infants</p>
	<p><u>Both the OEE and OLE claims sufficiently correspond with each other.</u></p>	

CASE 2	OEE Claims	OLE Claims
	<p>1. A soldering method characterized in that the soldering method comprises:</p> <p>a first step of applying solder paste in which a</p>	<p>1. A soldering method characterized in that the soldering method comprises:</p> <p>a first step of applying solder paste in which a</p>

	<p>solder alloy is mixed with residue-free flux to a soldering portion on a circuit board, and mounting an electronic part on the solder paste;</p> <p>a second step of volatilizing the residue-free flux contained in the solder paste by heating the circuit board in a furnace set to be a vacuum state and a first temperature and putting into a residue-free state (an amount of flux residue is equal to or less than 1 mass % in the flux);</p> <p>a third step of removing an oxide film on at least the soldering portion by heating the circuit board in the furnace set to be a reducing atmospheric state and a second temperature; and</p> <p>a fourth step of melting solder contained in the solder paste by heating the circuit board in the furnace set to be a vacuum state and a third temperature which is higher than the second temperature.</p>	<p>a solder alloy is mixed with residue-free flux to a soldering portion on a circuit board, and mounting an electronic part on the solder paste;</p> <p>a second step of volatilizing the residue-free flux contained in the solder paste by heating the circuit board in a furnace set to be a vacuum state and a first temperature;</p> <p>a third step of removing an oxide film on at least the soldering portion by heating the circuit board in the furnace set to be a reducing atmospheric state and a second temperature; and</p> <p>a fourth step of melting solder contained in the solder by heating the circuit board in the furnace set to be a vacuum state and a third temperature which is higher than the second temperature.</p>
2. The soldering method according to Claim 1	2. The soldering method according to Claim 1	

	<p>characterized in that in the first step, the solder paste is applied to the soldering portion on the circuit board with the use of a metal mask having an opening that is open at area corresponding to the soldering portion on the circuit board.</p> <p>3. The soldering method according to Claim 1 or 2 characterized in that the solder alloy has tensile strength which is equal to or more than 55 MPa, percentage elongation which is equal to or less than 40%, and 0.2% yield strength which is equal to or more than 40 MPa.</p>	<p>characterized in that in the first step, the solder paste is applied to the soldering portion on the circuit board with the use of a metal mask having an opening that is open at area corresponding to the soldering portion on the circuit board.</p> <p>3. The soldering method according to Claim 1 or 2 characterized in that the solder alloy has tensile strength which is equal to or more than 55 MPa, percentage elongation which is equal to or less than 40%, and 0.2% yield strength which is equal to or more than 40 MPa</p>
	<p><u>Both the OEE and OLE claims sufficiently correspond with each other.</u></p>	

CASE 3	OEE Claims	OLE Claims
	<p>1. A method, performed by an apparatus for allocating a job, of allocating a job to a user: the method comprising:</p> <p>receiving an allocation request signal from a terminal of the user;</p>	<p>1. A method of allocating a job to a user: the method comprising: receiving an allocation request signal from a terminal of the user;</p> <p>determining job processing information related to a job processed by the user;</p>

	<p>determining job processing information related to a job processed by the user;</p> <p>determining a job opening end time associated with at least one of a plurality of jobs;</p> <p>allocating at least one job among a plurality of jobs to the user based on a difference between the job opening end time and the time at which the allocation request signal is received and the job processing information; and</p> <p>transmitting allocation information indicating the allocated at least one job to the terminal in response to the reception of the allocation request signal.</p>	<p>allocating at least one job among a plurality of jobs to the user based on the job processing information; and transmitting allocation information indicating the allocated at least one job to the terminal in response to the reception of the allocation request signal.</p>
2.	<p>The method of claim 1, wherein the determining job processing information related to a job processed by the user comprises:</p> <p>determining a first score for each of the plurality of jobs based on the job processing information including job throughput units per hour for a job processed by the user</p>	<p>2. The method of claim 1, wherein the determining job processing information related to a job processed by the user comprises:</p> <p>determining a first score for each of the plurality of jobs based on the job processing information including job throughput units per hour for a job processed by the user</p>

	among the plurality of jobs.	among the plurality of jobs.
	<u>Both the OEE and OLE claims sufficiently correspond with each other.</u>	

D. Patent Examination on the merits of the PH Patent Application has not yet commenced

PPH prohibits entry of patent applications which has already undergone patent examination on the merits in the OLE. In other words, once a PH Patent Application has undergone substantive examination tackling on its merits, said application is no longer eligible for PPH.

- i. Issuance of a First Substantive Examination Report by the PH Examiner does not automatically make the PH Patent Application ineligible for PPH⁴

The PPH specifically provides that only those Patent Applications that has already undergone substantive examination **on the merits** are ineligible for PPH. If the First Substantive Examination issued by the Patent Examiner only raises issues pertaining to unity of invention, full disclosure, and formality, then applicant is still eligible for PPH.

CASE 1	PH Patent Examiner issued First Substantive Examination Report on PH Patent Application A. Examiner rejected the claims of the application for lacking unity of invention ⁵ <i>a priori</i> .
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⁴ Not applicable to IPOPHL-USPTO PPH; said program requires that the application has not been subjected to Substantive Examination

⁵ Also applies to lack of unity *a posteriori* objections

	<p><u>Applicant may still file for a Request for PPH since unity of invention objection is still in the formality stage and does not contain discussions on the merits of the Patent Application.</u></p>
CASE 2	<p>Same Patent Application A as with CASE 1, the applicant submitted a response to the First Substantive Examination Report amending the claims. However, upon examination, PH Patent Examiner noticed that the amended claims were not fully- disclosed in the Description.</p> <p>PH Patent Examiner issued a Subsequent Substantive Examination Report rejecting all claims for insufficiency of disclosure.</p> <p><u>Applicant may still file for a Request for PPH since the issued Subsequent Substantive Examination Report does not contain discussions on the merits of the Patent Application.</u></p>
CASE 3	<p>Applicant filed a Request for PPH upon filing of the PH Patent Application.</p> <p><u>PH Patent Application is eligible for PPH since no substantive examination report has been issued.</u></p>
CASE 4	<p>PH Patent Examiner issued a First Substantive Examination Report rejecting all the claims of the PH Patent Application for lack of novelty in the light of the cited prior art document.</p> <p><u>Applicant may no longer file for a Request for PPH since a substantive examination on the merits has already been issued by</u></p>

	<i>the PH Patent Examiner. The application shall be treated as a regular patent application.</i>
CASE 5	<p>PH Patent Examiner issued a First Substantive Examination Report requiring the Applicant to submit copies of the non- patent literature cited in the International Search Report.</p> <p><i>Applicant may still file for a Request for PPH since the issued Subsequent Substantive Examination Report does not contain discussions on the merits of the Patent Application.</i></p>

E. PPH makes use of National Work Products and those issued by IP Offices in its capacity as an ISA/IPEA

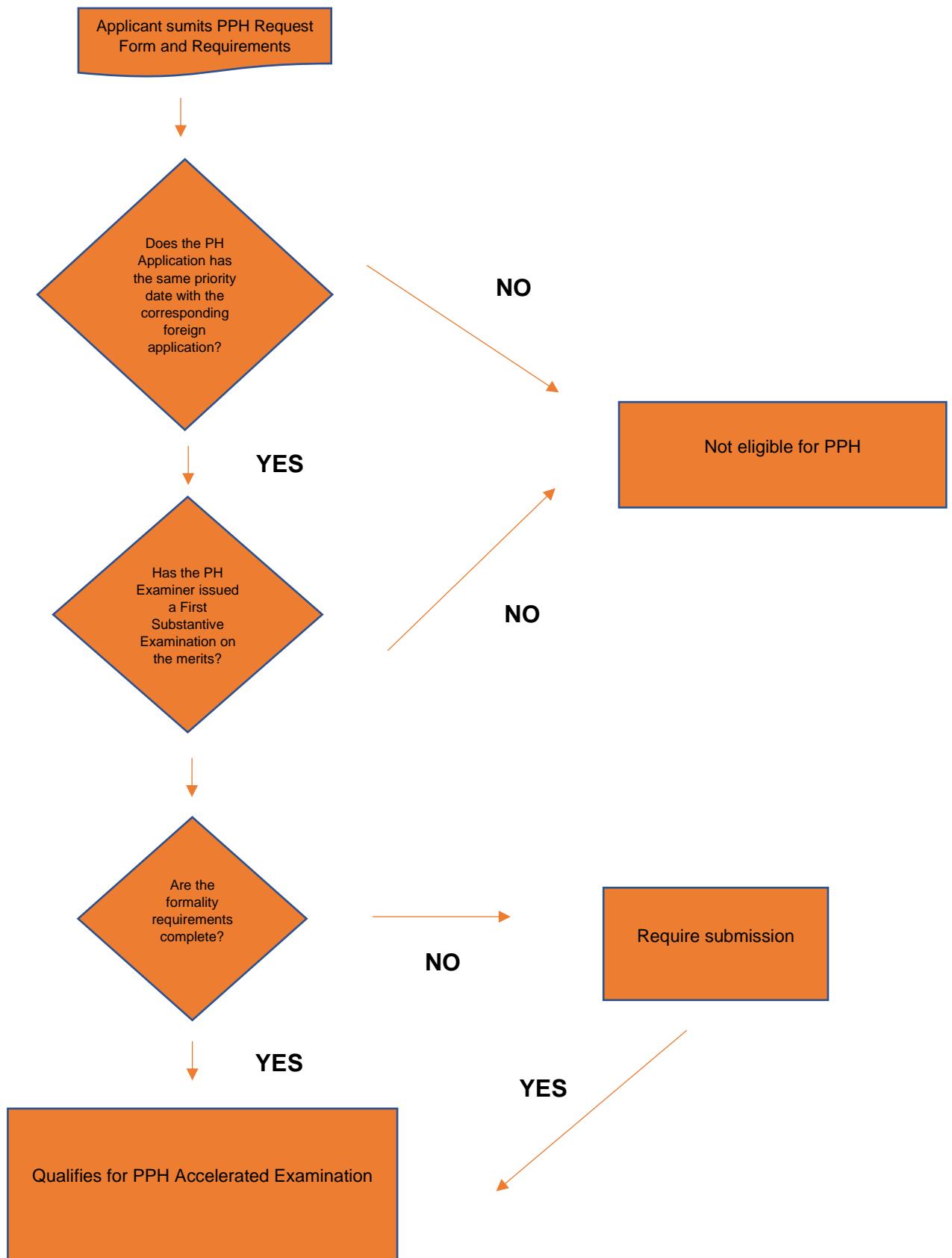
Aside from the national work products (Office Actions issued by PPH Partner IP Offices in its capacity as a National IP Office), PPH can also use work products issued by said IP Offices in its capacity as an International Searching Authority and International Patent Examining Authority. This is referred to as PCT-PPH.

PPH AND ASPEC COMPARATIVE MATRIX

Criteria	IPOPHL- JPO PPH	IPOPHL- USPTO PPH	IPOPHL-KIPO PPH	IPOPHL- EPO PPH	ASPEC
TERM	Indefinite	Indefinite	Indefinite	Indefinite	Continuous (must be reviewed regularly)
CORRESPONDING FOREIGN APPLICATIONS	JPO Applications	USPTO Applications	KIPO Applications	EPO Applications	ASEAN Member States (AMS)
REQUIREMENT OF AT LEAST ONE ALLOWABLE CLAIM PRESENT TO PROCEED	Required	Required	Required	Required	Required
REQUIREMENT OF A CLAIM CORRESPONDENCE TABLE	Required	Required	Required	Required	Optional
DEADLINE OF FILING	Before First Action on the Merits	Before Substantive Examination	Before First Action on the Merits	Before Substantive Examination	Can be filed at any stage of examination
FEES	Gratis	Gratis	Gratis	Gratis	Gratis
LIMIT OF APPLICATIONS TO BE RECEIVED BY IPOPHL	Unlimited	Two Hundred (200) Applications annually, divided into one hundred (100) applications per semester	Unlimited	Unlimited	Unlimited
DOCUMENTS TO BE SUBMITTED	<ul style="list-style-type: none"> • Request Form • Claim Correspondence Table • Work Products (if not accessible via Dossier) • Non-patent literature 	<ul style="list-style-type: none"> • Request Form • Claim Correspondence Table • Information Disclosure Statement • Work Products (if not accessible via Dossier) • Non-patent literature 	<ul style="list-style-type: none"> • Request Form • Claim Correspondence Table • Work Products (if not accessible via Dossier) • Non-patent literature 	<ul style="list-style-type: none"> • Request Form • Claim Correspondence Table • Work Products (if not accessible via Dossier) • Non-patent literature 	<ul style="list-style-type: none"> • Request Form • Claim Correspondence Table • Work Products (if not accessible via Dossier) • Non-patent literature

TRANSLATIONS	ENGLISH Machine Translation is accepted	N/A	ENGLISH Machine Translation is accepted	N/A	ENGLISH Machine Translation is accepted
PREFERENTIAL EXAMINATION	YES	YES	YES	YES	YES
EFFECT OF NON-COMPLIANCE WITH REQUIREMENTS	Require Submission	Require Submission	Require Submission	Require Submission	Require Submission

PPH WORKFLOW



IPOPHL- JPO PPH

I. ELIGIBILITY REQUIREMENTS

- A. Both the IPOPHL application and the corresponding JPO application must have the same earliest date (whether this be a priority date or filing date)⁶
- B. There must at least be one (1) claim that is determined to be patentable/allowable by the JPO
- C. The claims of the PH Patent Application must correspond or sufficiently correspond to at least one or more claims indicated as allowable by the JPO

Non- compliance with the eligibility requirements automatically makes a PH Patent Application ineligible for PPH

II. FORMALITY REQUIREMENTS

- A. Copies of all relevant office actions issued by the JPO and their corresponding translations if not accessible via Dossier

- i. *Non- submission of documents is not an essential requirement for PPH eligibility*

Applicant's non- submission of the relevant office actions and cited references shall not mean an automatic ineligibility for PPH. PH Patent Examiner may require the applicant to submit all relevant documents at any stage of the examination.

- ii. *Filipino or English translation is acceptable*

The IP Code requires any patent application filed before IPOPHL to be in either Filipino or English languages upon filing.

- iii. *Machine translation is acceptable*

PPH allows machine translation of the texts submitted using the Japanese language. The PH Patent Examiner cannot enjoin the applicant to avail of a costly human translation of the submitted documents to Filipino or English.

⁶ See Annexes

- iv. *Submission of physical/ electronic copies of all relevant office actions issued by the JPO may be forgone with if said actions are accessible via AIPN or J-Plat-Pat or any other Dossier system*

Ideally, applicants are encouraged to submit all the required documents all at once for convenience. However, should the applicant fail to submit copies of all the relevant office actions issued by the JPO upon filing of the PPH Request, the PH Patent Examiner has the option to view the file history of the application in AIPN or J-Plat-Pat.

B. Copies of all claims determined to be patentable/ allowable by the JPO and their corresponding English translations

- i. *The corresponding JP Patent Application must not necessarily be granted patents in Japan. Mere determination that the claims are patentable/ allowable shall suffice*

In order for the PH Patent Examiner to determine that the claims as filed or as amended are deemed patentable/ allowable by the JPO Patent Examiner, an explicit statement in the JP work products stating that the claims (which sufficiently correspond to the claims PH Patent Application) are patentable/ allowable shall suffice. There is no need to wait for the grant of patent.

C. Copies of all the references cited by the JPO Patent Examiner

- i. *Copies of Patent Documents may be forgone with, unless the patent document has no patent family in the English Language*

In such case, the PH Patent Examiner may require the applicant to submit the Patent Document and its corresponding translation. Machine translation shall suffice. If there is no patent family in English, PH Patent Examiner may require for its submission in the English language.

- ii. *Copies of non- patent literature must be submitted if not accessible*

Applicant is required to submit copies of all non- patent literature and their Filipino or English translation used as references by the JPO Patent Examiner. Should the applicant fail to submit copies of the non-patent literature upon filing of the PPH Request, the PH Patent Examiner may require the applicant for its submission if the former does not have full access of the cited texts.

D. Claim Correspondence Table

i. see II. A. i.

E. Work products include International Work Products issued by the JPO

i. *Work products is not limited to national work products issued by the JPO*

For PCT-PPH Patent Applications, Written Opinion, International Preliminary Report on Patentability, and International Search Reports issued by the JPO in its capacity as an International Searching Authority and International Preliminary Examining Authority under PCT is deemed included in the term “work products.” Thus, the determination that the claim/s is/are patentable/ allowable in any of the foregoing documents shall suffice.

III. MISCELLANEOUS PROVISIONS

A. Prioritization of PPH applications

Part of IPOPHL’s commitment in entering into bilateral PPH agreements is that it will prioritize the processing of PPH applications without prejudice to existing national IP laws and regulations. Thus, it is imperative upon the PH Patent Examiner to commence processing of PPH Patent Application upon its assignment.

B. PPH is free- of- charge

Under the existing PPH programs, PPH remains to be free-of-charge.

This is to be distinguished from a Request of Accelerated Examination where IPOPHL charges a certain fee for applicants who would like to avail of an accelerated examination outside of PPH.

All applications eligible and coursed through PPH shall not be charged any additional fee for accelerated examination.

IPOPHIL-USPTO PPH

I. ELIGIBILITY REQUIREMENTS

- A. The PH Patent Application for which participation in the PPH program is requested and the corresponding USPTO Patent Application must have the same priority date.
 - i. *Provisional applications, plant applications, design applications, reissue applications, re-examination proceedings and applications subject to a secrecy order are excluded and not subject to participation in PPH*
 - ii. *See Annexes*
- B. At least one (1) claim was determined by the USPTO to be allowable or patentable
 - i. *An explicit statement by the USPTO Examiner stating that the claim/s is/are allowable/ patentable shall suffice*
 - ii. *If an explicit statement is not found, the applicant must include a statement together with the request that no rejection has been made in the USPTO regarding that claim*

Absence of any statement rejecting the claim/s is deemed to be allowable by the USPTO. PH Patent Examiner is required to check the file wrapper history in cases of non-final rejection.
- C. All claims on file, as originally filed or as amended, must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO
 - i. Claims originally filed in the PH Patent Application must sufficiently correspond to one or more of those claims indicated as or deemed as allowable/ patentable by the USPTO
 - ii. Amended claims must still sufficiently correspond to one or more of those claims indicated as, or deemed, as allowable/ patentable by the USPTO

If, after amendment, none of the claims sufficiently correspond to any of those claims indicated as, or deemed, as allowable or patentable by the USPTO, said claims should be objected by the PH Patent

Examiner in an office action. If, after said objection, the claims still do not sufficiently correspond to any of the claims in the USPTO Patent Application, the PH Patent Application shall no longer be considered as a PPH application.

D. **Examination of the PH Patent Application has not begun**

- i. *PH Patent Application that has already commenced examination shall no longer be eligible for IPOPHL- USPTO PPH*

IPOPHL-USPTO PPH Request must be filed **before first substantive examination report** is issued by the PH Patent Examiner. Should a PH Patent Application already commence patent examination (whether or not on the merits), it shall no longer be eligible to enter into IPOPHL- USPTO PPH.

Non- compliance with the eligibility requirements automatically makes a PH Patent Application ineligible for PPH

II. FORMALITY REQUIREMENTS

A. **Copies of all relevant office actions issued by the USPTO**

- i. *Non- submission of documents is not an essential requirement for PPH eligibility*

Applicant's non- submission of the relevant office actions and cited references shall not mean an automatic ineligibility for PPH. PH Patent Examiner may require the applicant to submit all relevant documents at any stage of the examination.

- ii. *Submission of physical/ electronic copies of all relevant office actions issued by the USPTO may be forgone with if said actions are accessible via USPTO PAIR*

Ideally, applicants are encouraged to submit all the required documents all at once for convenience. However, should the applicant fail to submit copies of all the relevant office actions issued by the USPTO upon filing of the PPH Request, the PH Patent Examiner has the option to view the file history of the application in USPTO PAIR.

B. **Information Disclosure Statement**

- i. *Copies of all the references cited by the USPTO Patent Examiner*

Copies of Patent Documents may be forgone with, unless the patent document has no patent family in the English language.

ii. Copies of non-patent literature must be submitted

Applicant is required to submit copies of all non-patent literature and their Filipino or English translation used as references by the USPTO Patent Examiner. Should the applicant fail to submit copies of the non-patent literature upon filing of the PPH Request, the PH Patent Examiner may require the applicant for its submission if the former does not have full access of the cited texts.

C. Claim Correspondence Table

ii. See II. A. i.

III. MISCELLANEOUS PROVISIONS

A. Prioritization of PPH applications

Part of IPOPHL's commitment in entering into bilateral PPH agreements is that it will prioritize the processing of PPH applications without prejudice to existing national IP laws and regulations. Thus, it is imperative upon the PH Patent Examiner to immediately start processing the PPH Patent Application upon its assignment.

B. PPH between USPTO shall have a cap of one hundred (100) PPH Requests per semester

C. PPH is free-of-charge

Under existing PPH Programs, PPH remains to be free-of-charge

This is to be distinguished from a Request of Accelerated Examination where IPOPHL charges a certain fee for applicants who would like to avail of an accelerated examination outside of PPH.

All applications eligible and coursed through PPH shall not be charged with any additional fee for accelerated examination.

IPOPHL- KIPO PPH

I. ELIGIBILITY REQUIREMENTS

- A. Both the IPOPHL application and the corresponding KIPO application must have the same earliest date (whether this be a priority date or filing date)⁷
- B. There must at least be one (1) corresponding application which exists in KIPO, and has one or more claims that are determined to be patentable/allowable by the KIPO
- C. All claims on file, as originally filed or as amended for examination under the PPH must correspond or sufficiently correspond to at least one or more claims indicated as allowable in the KIPO

Non- compliance with the eligibility requirements automatically makes a PH Patent Application ineligible for PPH

II. FORMALITY REQUIREMENTS

- A. Copies of all relevant office actions issued by the KIPO and their corresponding translations

- i. *Non- submission of documents is not an essential requirement for PPH eligibility*

Applicant's non- submission of the relevant office actions and cited references shall not mean an automatic ineligibility for PPH. PH Patent Examiner may require the applicant to submit all relevant documents at any stage of the examination.

- ii. *Filipino or English translation is acceptable*

The IP Code requires any patent application filed before IPOPHL to be in either Filipino or English languages upon filing.

- iii. *Machine translation is acceptable*

PPH allows machine translation of the texts submitted using the Korean language. The PH Patent Examiner cannot enjoin the

⁷ See Annexes

applicant to avail of a costly human translation of the submitted documents to Filipino or English.

- iv. *Submission of physical/ electronic copies of all relevant office actions issued by KIPO may be forgone with if said actions are accessible via K-PION.*

Ideally, applicants are encouraged to submit all the required documents all at once for convenience. However, should the applicant fail to submit copies of all the relevant office actions issued by KIPO upon filing of the PPH Request, the PH Patent Examiner has the option to view the file history of the application in K-PION.

B. Copies of all claims determined to be patentable/ allowable by KIPO, and their corresponding translations

- i. *The corresponding KR application must not be necessarily granted patents in Korea. Mere determination that the claims are patentable/ allowable shall suffice*

In order for the PH Patent Examiner to determine that the claims as filed or as amended are deemed patentable/ allowable by the KIPO Patent Examiner, an explicit statement in the KR work products stating that the claims (which sufficiently correspond to the claims PH Patent Application) are patentable/ allowable shall suffice. There is no need to wait for the grant of patent.

C. Copies of all the references cited by the KIPO Patent Examiner

- i. *Copies of Patent Documents may be forgone with, unless the patent document has no patent family in the English Language*

In such case, the PH Patent Examiner shall require the applicant to submit the Patent Document and its corresponding translation. Machine translation shall suffice.

- ii. *Copies of non- patent literature must be submitted*

Applicant is required to submit copies of all non- patent literature and their Filipino or English translation used as references by the KIPO Patent Examiner. Should the applicant fail to submit copies of the non-patent literature upon filing of the PPH Request, the PH Patent Examiner may require the applicant for its submission if the former does not have full access of the cited texts.

D. Claim Correspondence Table

- i. see II. A. i.

E. Work products include International Work Products issued by KIPO

- i. *Work products is not limited to national work products issued by the KIPO*

For PCT-PPH Patent Applications, Written Opinion, International Preliminary Report on Patentability, and International Search Reports issued by KIPO in its capacity as an International Searching Authority and International Preliminary Examining Authority under PCT is deemed included in the term “work products.” Thus, the determination that the claim/s is/are patentable/ allowable in any of the foregoing documents shall suffice.

III. MISCELLANEOUS PROVISIONS

A. Prioritization of PPH applications

Part of IPOPHL’s commitment in entering into bilateral PPH agreements is that it will prioritize the processing of PPH applications without prejudice to existing national IP laws and regulations. Thus, it is imperative upon the PH Patent Examiner to immediately start processing of PPH Patent Application upon its assignment.

B. Applicants who wish to have their applications coursed through IPOPHL-KIPO PPH may do so **before the substantive examination on the merits has begun**

C. PPH is free- of- charge

Under existing PPH programs, PPH remains to be free-of-charge.

This is to be distinguished from a Request of Accelerated Examination where IPOPHL charges a certain fee for applicants who would like to avail of an accelerated examination outside of PPH.

All applications eligible and coursed through PPH shall not be charged with any additional fee for accelerated examination.

IPOPHL- EPO PPH

I. ELIGIBILITY REQUIREMENTS

- A. The PH application for which participation in the PPH pilot program is requested and the corresponding EPO application must have the same earliest date whether this be a priority or filing date.
- B. The corresponding application/s must have at least one (1) claim indicated by the EPO as patentable/ allowable. The claim/s determined as novel, inventive, and industrially applicable has/have the same meaning of patentable/ allowable for purposes of PPH.
- C. All claims in the application for which a request for participation in PPH is made must correspond or sufficiently correspond to the patentable/ allowable claims in the corresponding application/s.

Non- compliance with the eligibility requirements automatically makes a PH Patent Application ineligible for PPH

II. FORMALITY REQUIREMENTS

- A. Copies of all relevant office actions issued by the EPO

i. Non- submission of documents is not an essential requirement for PPH eligibility

Applicant's non- submission of the relevant office actions and cited references shall not mean an automatic ineligibility for PPH. PH Patent Examiner may require the applicant to submit all relevant documents at any stage of the examination.

ii. Submission of physical/ electronic copies of all relevant office actions issued by the EPO may be forgone with if said actions are accessible via ESPACENET Dossier.

Ideally, applicants are encouraged to submit all the required documents all at once for convenience. However, should the applicant fail to submit copies of all the relevant office actions issued by the EPO upon filing of the PPH Request, the PH Patent Examiner has the option to view the file history of the application in ESPACENET.

B. Copies of all claims determined to be patentable/ allowable by EPO

C. Copies of all the references cited by the EPO Patent Examiner

- i. *Copies of Patent Documents may be forgone with, unless the patent document has no patent family in the English Language*

In such case, the PH Patent Examiner shall require the applicant to submit the Patent Document and its corresponding translation. Machine translation shall suffice.

- ii. *Copies of non-patent literature must be submitted*

Applicant is required to submit copies of all non-patent literature and their Filipino or English translation used as references by the EPO Patent Examiner. Should the applicant fail to submit copies of the non-patent literature upon filing of the PPH Request, the PH Patent Examiner may require the applicant for its submission if the former does not have full access of the cited texts.

D. Claim Correspondence Table

- i. *see II. A. i.*

- iii. *In the absence of a claim correspondence table, the applicant may, in lieu of such, submit a declaration of claims correspondence*

A declaration of claims correspondence is an attestation that the claims filed in the PH sufficiently corresponds with that of the corresponding EPO application.

E. Work products include International Work Products issued by EPO

- i. *Work products is not limited to national work products issued by the EPO*

For PCT-PPH Patent Applications, Written Opinion, International Preliminary Report on Patentability, and International Search Reports issued by EPO in its capacity as an International Searching Authority and International Preliminary Examining Authority under PCT is deemed included in the term “work products.” Thus, the determination that the claim/s is/are patentable/ allowable in any of the foregoing documents shall suffice.

III. MISCELLANEOUS PROVISIONS

A. Prioritization of PPH applications

Part of IPOPHL's commitment in entering into bilateral PPH agreements is that it will prioritize the processing of PPH applications without prejudice to existing national IP laws and regulations. Thus, it is imperative upon the PH Patent Examiner to immediately start processing of PPH Patent Application upon its assignment.

B. Applicants who wish to have their applications coursed through IPOPHL-EPO PPH may do so *before substantive examination has begun*

C. PPH is free- of- charge

Under existing PPH programs, PPH remains to be free-of-charge.

This is to be distinguished from a Request of Accelerated Examination where IPOPHL charges a certain fee for applicants who would like to avail of an accelerated examination outside of PPH.

All applications eligible and coursed through PPH shall not be charged of any additional fee for accelerated examination.

ASEAN PATENT EXAMINATION COOPERATION

I. INTRODUCTION

The ASEAN Patent Examination Cooperation (ASPEC) is the first regional patent cooperation project established on 15 June 2009 by the ASEAN Member States (AMS). ASPEC is a program for participating AMS to utilize other members' Search & Examination (S&E) results as reference in its own S&E work. ASPEC aims to reduce duplication of S&E work, ease the workload of examiners, reduce turnaround time, and generate better quality S&E results. As a result, applicants can obtain corresponding quality patents faster and more efficiently in any AMS IP Office.

In 2019, two new features under ASPEC have been introduced, namely: ASPEC Acceleration for Industry 4.0 Infrastructure and Manufacturing (ASPEC AIM) up to 26 August 2023, and the Patent Cooperation Treaty-ASPEC (PCT-ASPEC) up to 26 August 2025. ASPEC AIM was launched to expedite Industry 4.0 patent applications with a committed turnaround time of 6 months for the issuance of first office action. PCT ASPEC allows patent applicants to use a PCT report established by an ASEAN International Searching and Preliminary Examining Authority (ISA/IPEA) as basis for requesting accelerated examination through the program. Presently, the Intellectual Property Office of the Philippines (IPOPHL) and the Intellectual Property Office of Singapore (IPOS) are operating as ISA/IPEA in the Region.

All ASPEC requests remain *gratis* and guarantees accelerated examination among applicants who avail of the service. However, entry into ASPEC does not automatically assure grant of the patent.

Currently, there are ten (10) participating AMS IP Office, namely: Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Myanmar, Malaysia, the Philippines, Singapore, Thailand, and Viet Nam.

I. ELIGIBILITY REQUIREMENTS

A patent application in a participating AMS IP Office where the ASPEC Request Form is filed (“second IP Office”) is required to be a corresponding patent application in the other participating AMS IP Office (“first IP Office”).

- A. A patent application in the first IP Office is a corresponding application if it is linked by a Paris Convention priority claim to the patent application in the second IP Office, and vice versa
- B. The patent applications in both the first IP Office and second IP Office have the same priority claim from another member of Paris Convention or World Trade Organization
- C. The patent applications in both the first IP Office and Second IP Office are national phase entry applications from the same Patent Cooperation Treaty (“PCT”) application

Non- compliance with the essential requirements automatically makes a PH patent application ineligible for ASPEC

II. FORMALITY REQUIREMENTS

A. ASPEC Request Form

- i. *An e- ASPEC Request made on the ASEAN IP Portal could replace the need for a separate ASPEC Request Form*

The Request Form can be filed electronically through IPOPHL’s Digital Filing System. For e-ASPEC Requests made via the ASEAN IP Portal, the applicant’s local patent agent/ representative should validate the request and subsequently inform IPOPHL about said filing.

B. A copy of the Search and Examination (S&E) report or the Examination report (“minimum documents”) of a corresponding application from the first IP Office

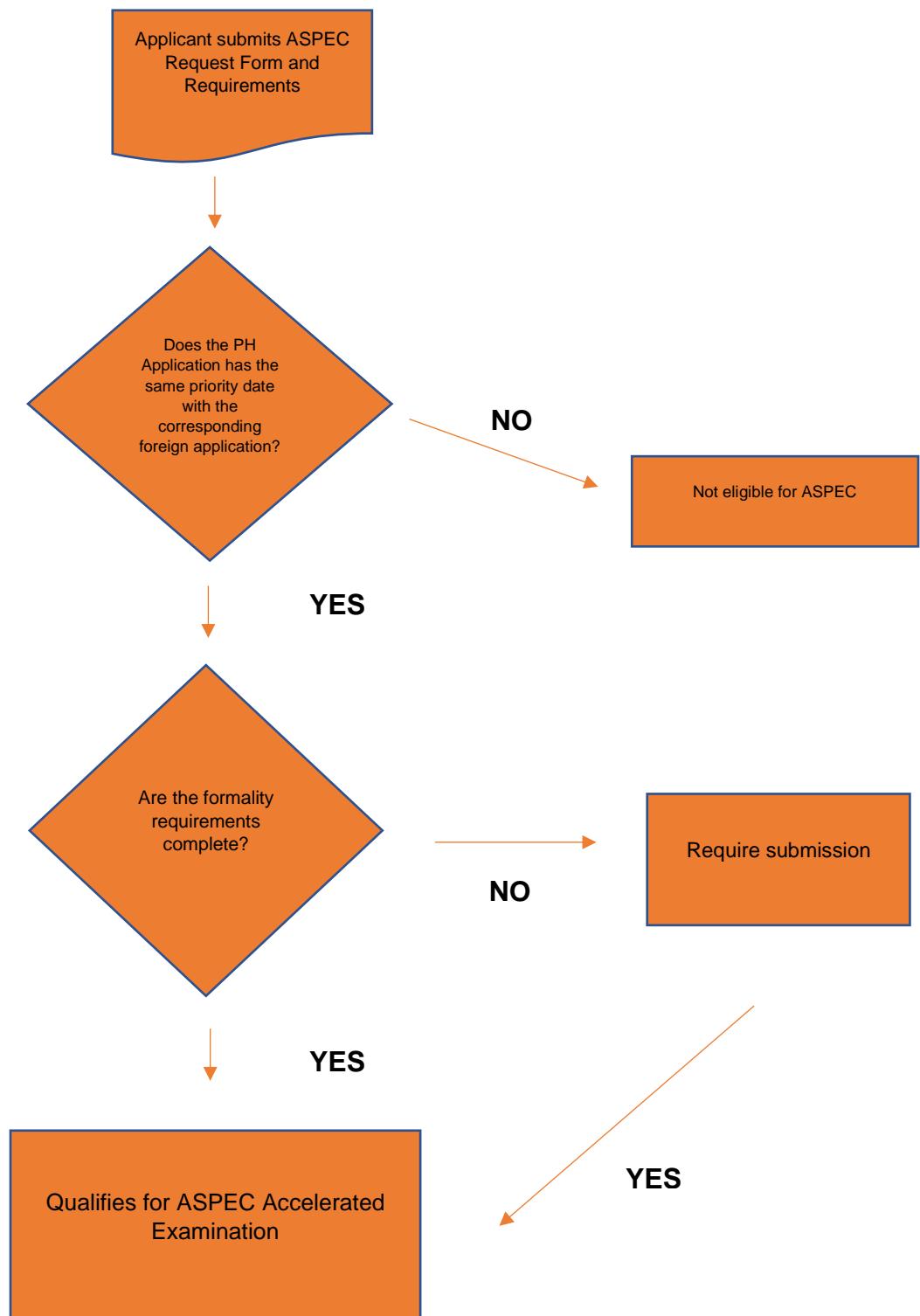
- i. *The copy of the S&E report must be in English*

It is required that all relevant documents submitted are in English. Machine translation is acceptable.

- ii. ASPEC Accelerated Examination would begin only when all the required documents are submitted to the second IP Office*
 - iii. Hard copies of the Request Form and S&E Documents are no longer required with the digitalization of IPOPHL*
 - C. A copy of the claims referred to in the minimum documents submitted, with at least one claim determined by the first IP Office to be allowable/patentable
 - i. Claim Correspondence Table is optional*

A claim correspondence table is not required. However, applicant may opt to submit a claim correspondence table for ease of reference. The PH patent examiner may also request for the submission of a claim correspondence table.
- III. MISCELLANEOUS PROVISIONS**
- A. Usage of local registered agent/ representative is mandatory for ASPEC request
 - B. All AMS part of ASPEC have a timeline commitment of 6 to 9 months in processing of ASPEC applications
 - C. Under the existing ASPEC program, ASPEC remains to be free-of-charge

ASPEC WORKFLOW



ANNEXES
PPH AND ASPEC GUIDELINES

Procedures to file a request to the IPOPHL (Intellectual Property Office of the Philippines) for Patent Prosecution Highway Program between the IPOPHL and the JPO (Japan Patent Office)

Part I **PPH using the national work products from the JPO**

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

When filing a request for the PPH program, an applicant must submit a request form to the IPOPHL.

The Offices may terminate the PPH program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH program is terminated.

The PPH program was commenced on a trial basis on March 12, 2012 and will be fully implemented on a permanent basis on March 12, 2021.

1. Requirements

(a) Both the IPOPHL application on which PPH is requested and the JPO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).

For example, the IPOPHL application (including PCT national phase application) may be either:
(Case I) an application which validly claims priority under the Paris Convention from the JPO application(s) (examples are provided in ANNEX I, Figures A, B, C, H, I and J), or
(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the JPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures D and E), or
(Case III) an application which shares a common priority document with the JPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures F, G, L, M and N), or
(Case IV) a PCT national phase application where both the JPO application and the IPOPHL application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX I, Figure K).

(b) At least one corresponding application exists in the JPO and has one or more claims that are determined to be patentable/allowable by the JPO.

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the JPO application which forms the basis

of the priority claim (e.g., a divisional application of the JPO application or an application which claims domestic priority to the JPO application (see Figure C in Annex I)), or an JPO national phase application of a PCT application (see Figures J, K, L, M and N in Annex I). Claims are “determined to be allowable/patentable” when the JPO examiner clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet.

The office action includes:

- (a) Decision to Grant a Patent
- (b) Notification of Reasons for Refusal
- (c) Decision of Refusal
- (d) Appeal Decision

For example, if the following routine expression is described in the “Notification of Reason for Refusal” of the JPO, those claims are clearly identified to be allowable/patentable.

“<Claims which has been found no reason for refusal>

At present for invention concerning Claim____, no reason for refusal is found.”

- (c) All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the JPO.**

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

A claim in the IPOPHL which introduces a new/different category of claims to those claims indicated as allowable in the JPO is not considered to sufficiently correspond. For example, where the JPO claims only contain claims to a process of manufacturing a product, then the claims in the IPOPHL are not considered to sufficiently correspond if the IPOPHL claims introduce product claims that are dependent on the corresponding process claims. Any claims amended or added after the grant of the request for participation in the PPH program need not to sufficiently correspond to the claims indicated as allowable in the JPO application.

- (d)** A request for PPH may be submitted even during the substantive examination stage, provided that, examination on the merits of the application has not been made.

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to the PPH request.

- (a) ***Copies of all office actions (which are relevant to substantial examination for patentability in the JPO) which were issued for the corresponding application by the JPO, and translations of them¹.***

Either Filipino or English is acceptable as translation language. The applicant does not have to submit a copy of JPO office actions and translations of them when those documents are provided via JPO's dossier access system because the office actions and their machine translations are available for the IPOPHL examiner via the JPO's dossier access system. If they cannot be obtained by the IPOPHL examiner via the JPO's dossier access system, the applicant may be notified and requested to provide the necessary documents.

- (b) ***Copies of all claims determined to be patentable/allowable by the JPO, and translations of them.***

Either Filipino or English is acceptable as translation language. The applicant does not have to submit a copy of claims indicated to be allowable/patentable in the JPO, and translations thereof when the documents are provided via JPO's dossier access system because they are available for the IPOPHL examiner via the JPO's dossier access system. If they cannot be obtained by the IPOPHL examiner via the JPO's dossier access system, the applicant may be notified and requested to provide the necessary documents.

- (c) ***Copies of references cited by the JPO examiner***

If the references are patent documents, the applicant doesn't have to submit them because the IPOPHL usually possesses them. When the IPOPHL does not possess the patent document, the applicant has to submit the patent document at the examiner's request. Non-patent literature must always be submitted.

The translations of the references are unnecessary.

- (d) ***Claim correspondence table***

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the IPOPHL application sufficiently correspond to the patentable/allowable claims in the JPO application.

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

¹ Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

same” in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim.

When the applicant has already submitted above documents (a) to (d) to the IPOPHL through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

3. Procedure for the accelerated examination under the PPH program

The IPOPHL decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When the IPOPHL decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again.

4. PPH request form

Subject: Request for an accelerated examination under the PPH program

Date of filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

This application is an application validly claiming the priority under the Paris Convention to the corresponding JPO application (the application number is _____), and the accelerated examination is requested under the PPH program. For this purpose, the following documents are attached:

- Copies of all office actions (which are relevant to substantial examination for patentability in the JPO) which were issued for the corresponding application by the JPO and
 translations of them

- Copies of all claims determined to be patentable/allowable by the JPO and
 translations of them

- Copies of references cited by the JPO examiner

- Claim correspondence table

Part I PPH using the national work products from the JPO

Claim correspondence table

The claim in the IPOPHL	The patentable claim in the JPO	Comments about the correspondence

(Documents to be omitted to submit)

Part II

PPH using the PCT international work products from the JPO

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

When filing a request for the PCT-PPH program, an applicant must submit a request form to the IPOPHL.

The Offices may terminate the PCT-PPH program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PCT-PPH program is terminated.

The PCT-PPH program was commenced on a trial basis on March 12, 2012 and will be fully implemented on a permanent basis on March 12, 2021.

1. Requirements

The application which is filed with the IPOPHL 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 Examination 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 JPO, 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 request under PCT-PPH 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 national phase application of the corresponding international application. (See Figures A, A', and A" in Annex II)
 - (B) The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex II)
 - (C) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)
 - (D) The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure D in Annex II)
 - (E) The application is the derivative application (divisional application and application claiming domestic 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 IPOPHL are of the same or similar scope as the claims indicated as allowable in the latest international work product, or the claims in the IPOPHL 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 IPOPHL 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 IPOPHL are not considered to sufficiently correspond if the IPOPHL claims introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the grant of the request for participation in the PCT-PPH program need not to sufficiently correspond to the claims indicated as allowable in the latest international work product.

- (4) A request for PPH may be submitted even during the substantive examination stage, provided that, examination on the merits of the application has not been made.**

2. Documents to be submitted

The applicant must submit the following documents attached to the request form in filing a request under PCT-PPH. 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 Filipino 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)²”, an applicant need not submit these documents, unless otherwise requested by the IPOPHL.

(WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date.)

(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 Filipino 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 IPOPHL. Where the set of claims is written in Japanese, the translations thereof must be still submitted by an applicant.

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

If the reference is a patent document, the applicant is not required to submit it. In case the IPOPHL has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

(4) A claims correspondence table which indicates how all claims in the application

² <http://www.wipo.int/pctdb/en/index.jsp>

sufficiently correspond to the claims indicated to be patentable/allowable.

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 based on the criteria 1. (3) (Please refer to the Example form below).

When an applicant has already submitted the above mentioned documents (1) - (4) to the IPOPHL 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 the accelerated examination under the PPH program

The IPOPHL decides whether the application can be entitled to the status for an accelerated examination under the PCT-PPH when it receives a request with the documents stated above.

When the IPOPHL decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PCT-PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PCT-PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PCT-PPH, the applicant can request the PCT-PPH again.

4. PCT-PPH request form

Subject: Request for an accelerated examination under the PCT-PPH program

Date of filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

This application is a national phase application of a PCT international application (the application number is _____), and the accelerated examination is requested under the PCT-PPH program. For this purpose, the following documents are attached:

- A copy of the latest international work product which indicated the claims to be patentable/allowable and
 - their Filipino or English translations if they are not in English
-
- 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 Filipino or English translations if they are not in English
-
- A copy of references cited in the latest international work product of the international application corresponding to the application
-
- A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable

Part II PPH using the PCT international work products from the JPO

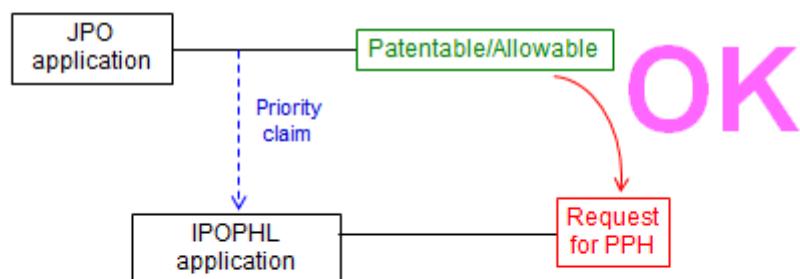
Claim correspondence table

The claim in the IPOPHL	The patentable claim in the international phase	Comments about the correspondence

(Documents to be omitted to submit)

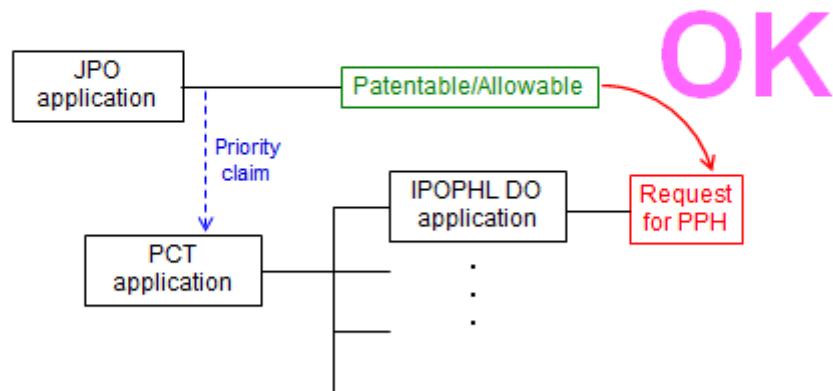
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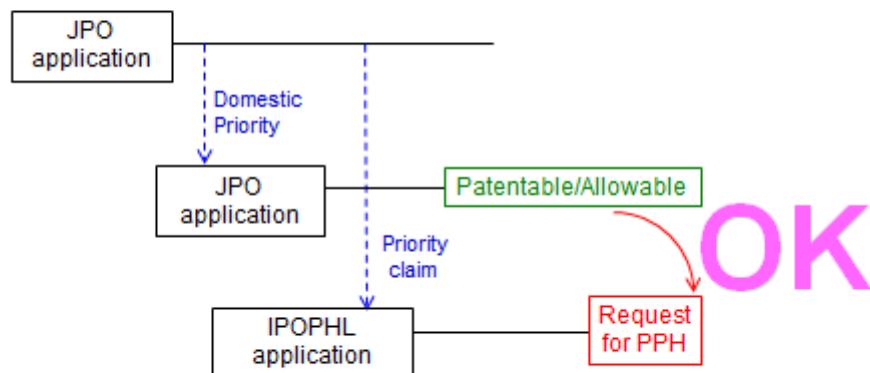
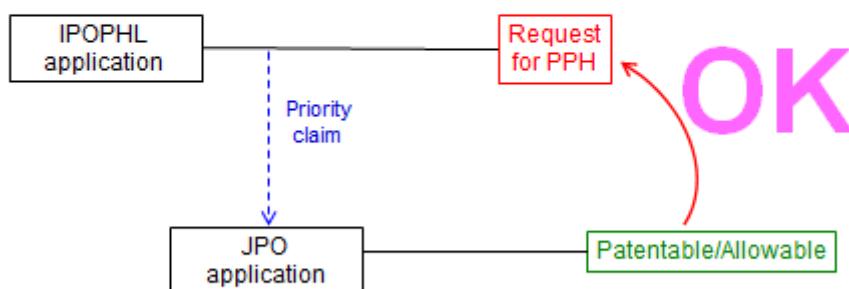
A case meeting requirement (a) (I)
- Paris route -



B

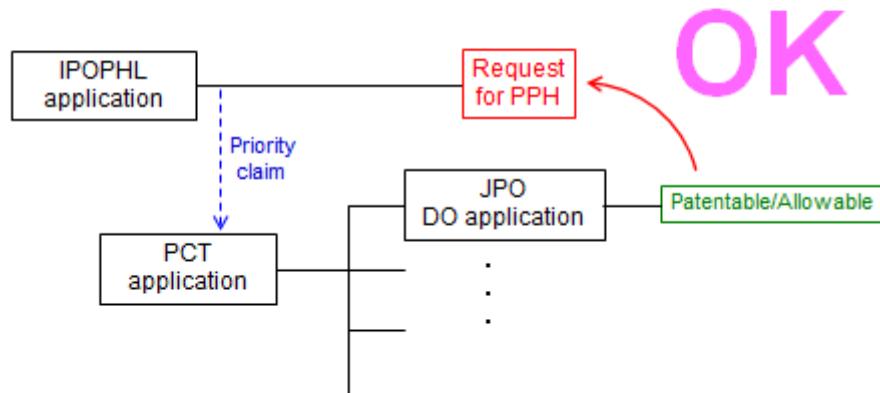
A case meeting requirement (a) (I)
- PCT route -



C**A case meeting requirement (a) (I)****- PCT route, Domestic priority -****D****A case meeting requirement (a) (II)****- Paris route -**

E

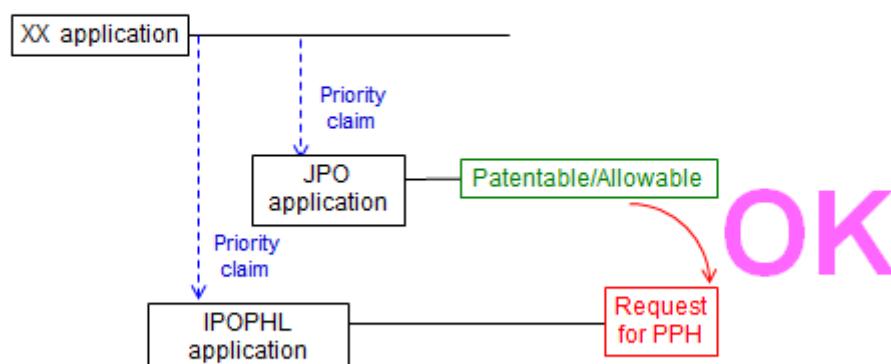
A case meeting requirement (a) (II)
- PCT route -



OK

F

A case meeting requirement (a) (III)
- Paris route, but the first application is from the third country -



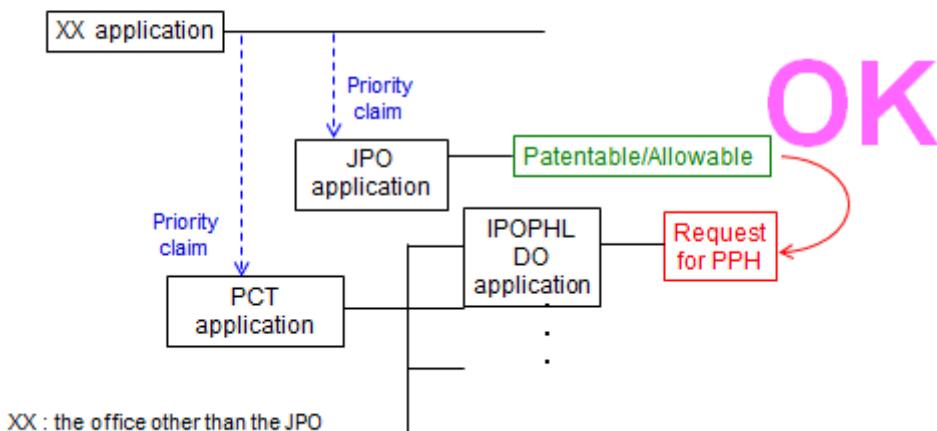
OK

XX : the office other than the JPO

G

A case meeting requirement (a) (III)

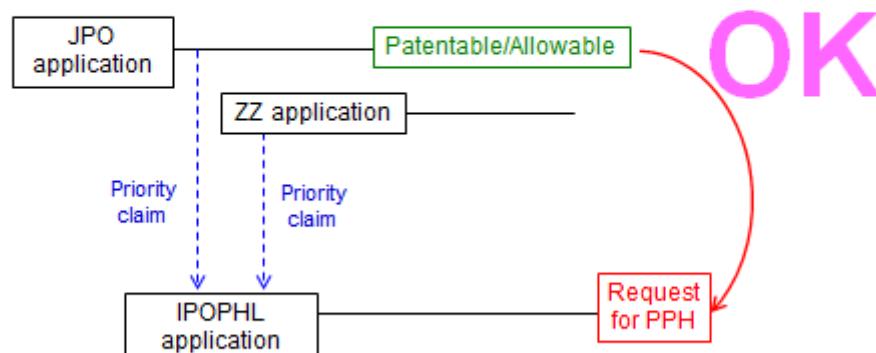
- PCT route, but the first application is from the third country -



H

A case meeting requirement (a) (I)

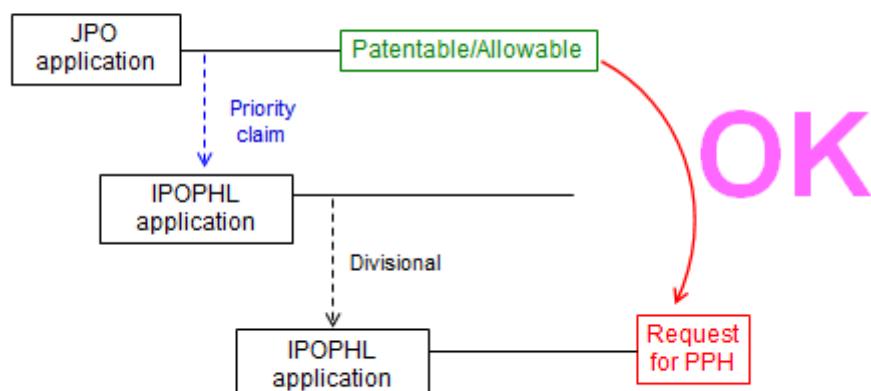
- Paris route & Complex priority -



ZZ: any office

I

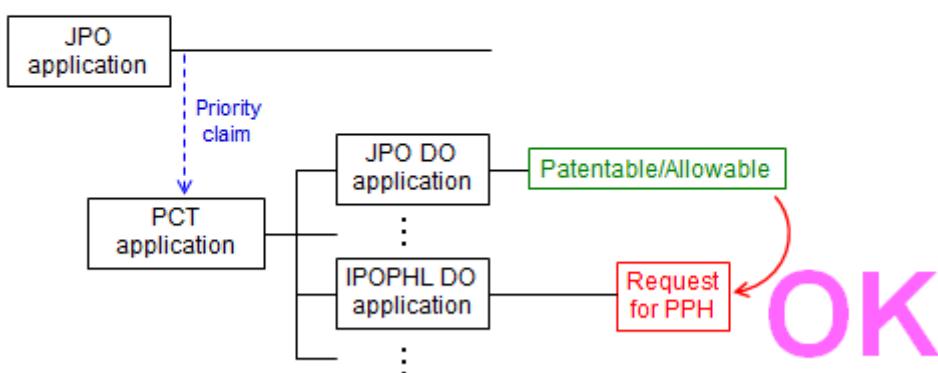
A case meeting requirement (a) (I)
- Paris route & divisional application -



OK

J

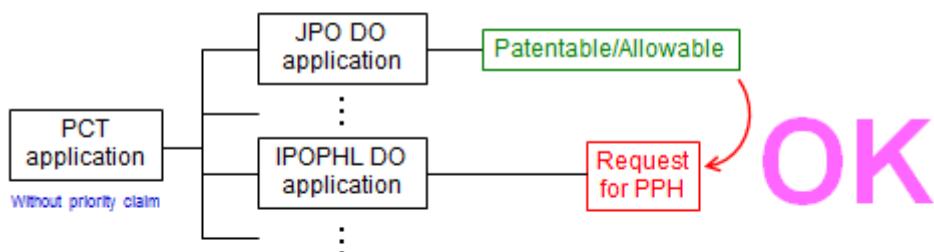
A case meeting requirement (a) (I)
- PCT route -



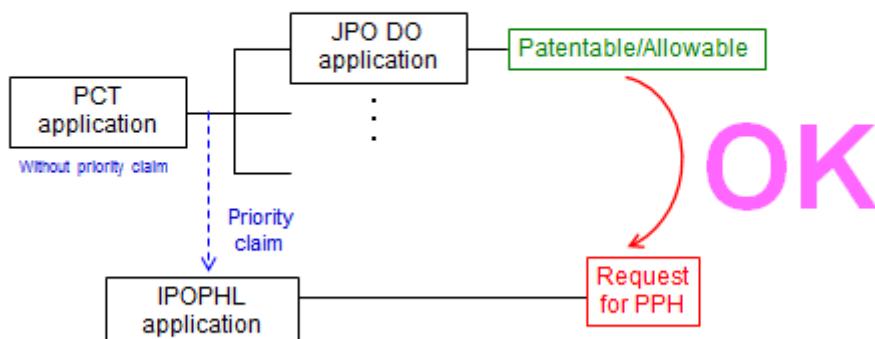
OK

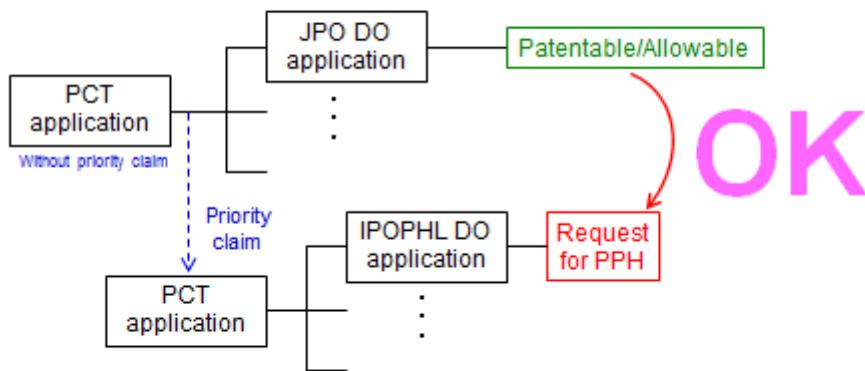
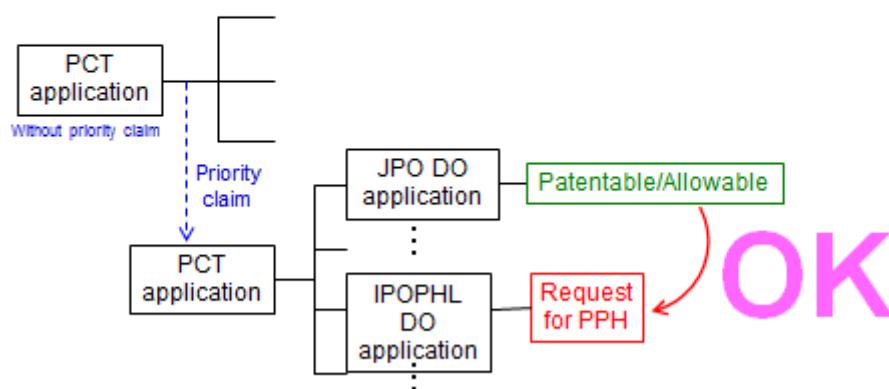
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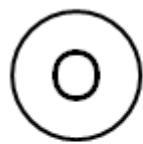
A case meeting requirement (a) (IV)
- Direct PCT route -

**L**

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

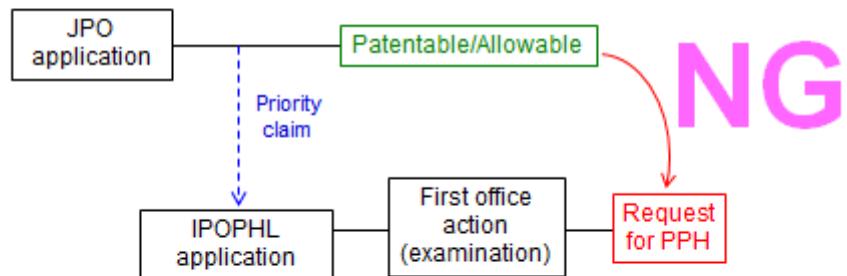


M**A case meeting requirement (a) (III)**
- Direct PCT & PCT route -**N****A case meeting requirement (a) (III)**
- Direct PCT & PCT route -

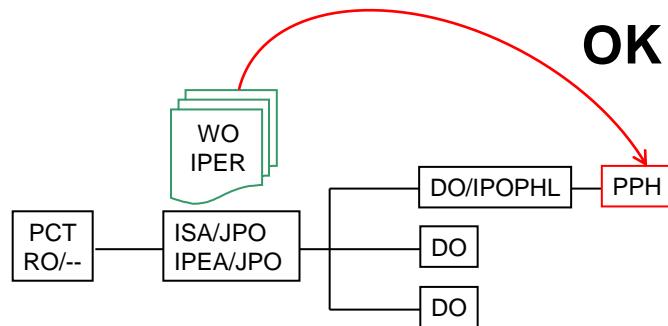


A case not meeting requirement (d)

- Examination has begun before a request for PPH -

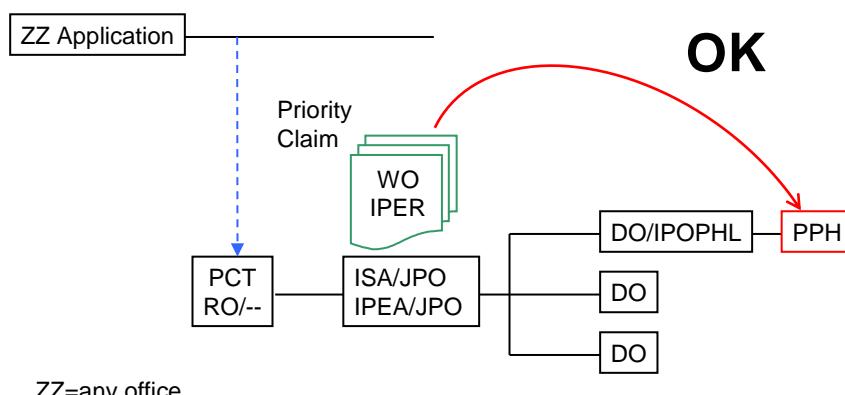


(A) The application is a national phase application of the corresponding international application.



(A') The application is a national phase application of the corresponding international application.

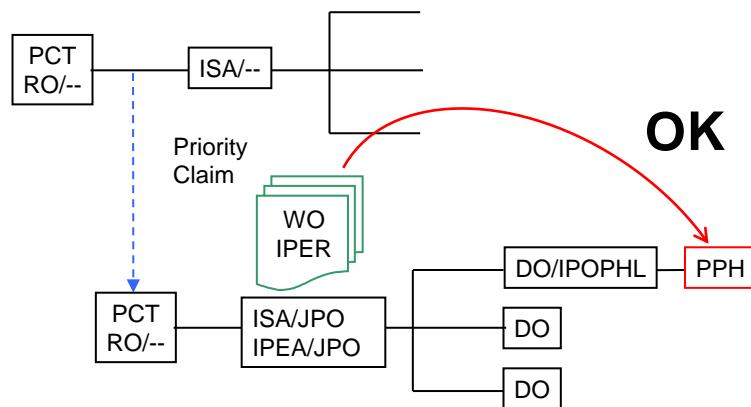
(The corresponding international application claims priority from a national application.)



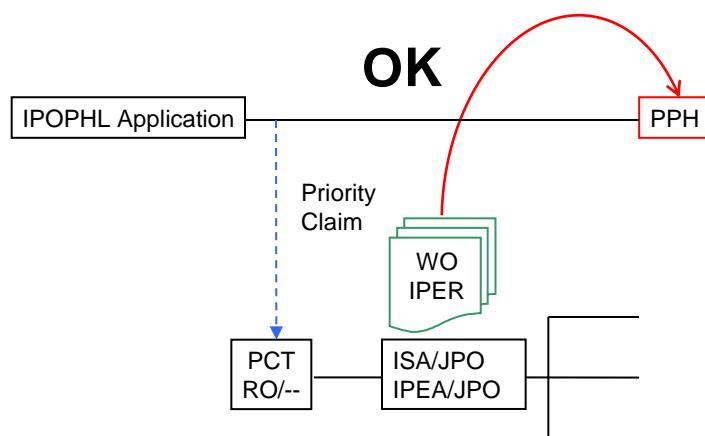
ZZ=any office

(A'') The application is a national phase application of the corresponding international application.

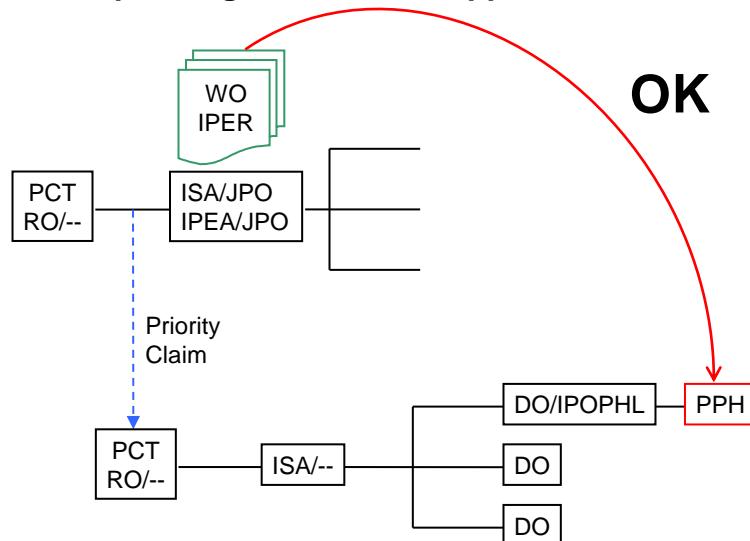
(The corresponding international application claims priority from an international application.)



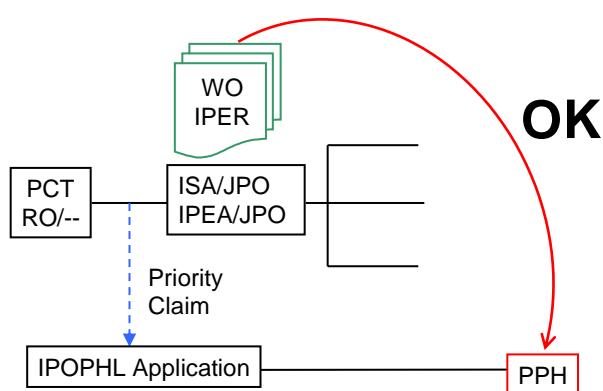
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



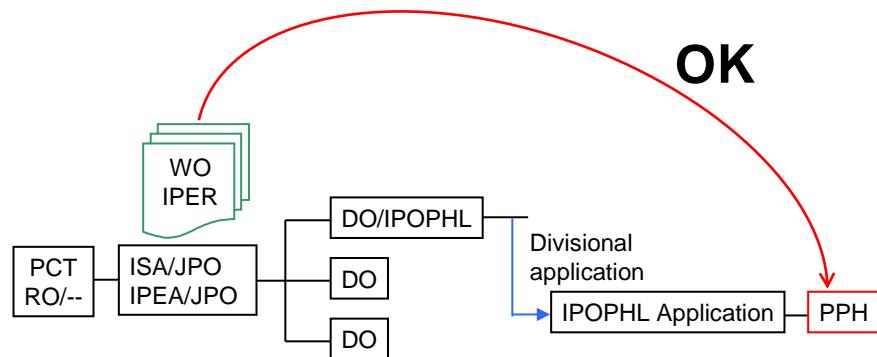
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



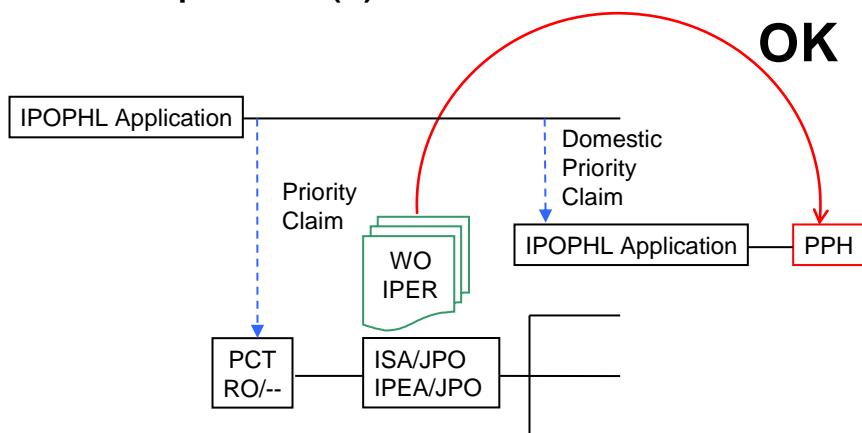
(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



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



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





17 January 2013

OFFICE ORDER NO. 13-10
Series of 2013

**Subject: AMENDMENT ON IPOPHL-USPTO PATENT PROSECUTION
HIGHWAY 2.0 PROGRAM**

The Intellectual Property Office of the Philippines (IPOPHL) and the United States Patent and Trademark Office (USPTO) have agreed to implement an amended Patent Prosecution Highway Program and shall refer therein as PPH 2.0. Said PPH 2.0 shall take effect on January 29, 2013 up to January 28, 2014.

Applications to be prosecuted under PPH 2.0 shall be subject to the amended PPH 2.0 guidelines marked as Annex A herein.

Applicants and agents who wish to avail of PPH 2.0 shall duly accomplish the Request Form attached herein as Annex B, and seasonably file the same.

Under the IPOPHL- USPTO PPH 2.0, IPOPHL applications with corresponding USPTO applications shall be given priority by means of an advanced-out-of-turn examination. Furthermore, USPTO work products shall serve as additional references for IPOPHL examiners.

All IPOPHL applications that were filed following the earlier PPH Agreement shall not be prejudiced and shall be accorded with PPH 2.0.

For guidance.

A handwritten signature in blue ink, appearing to read "PL AP".

Atty. RICARDO R. BLANCAFLOR
Director General

IPO PHIL 13JAN2013 0:47
RECEIVED BY *[Signature]*

ANNEX A

Revised Requirements for the Implementation of the IPOPHL-USPTO PPH 2.0 Program

I. Background

Since July 15, 2011, the United States Patent and Trademark Office (USPTO) and seven other offices (i.e., IP Australia (IPAU), Canada (CIPO), Finland (NBPR), Japan (JPO), Russia (ROSPATENT), Spain (SPTO) and United Kingdom (UKIPO)) have participated in an enhanced PPH pilot program called "MOTTAINAI". Under MOTTAINAI, participation in the PPH may be requested on the basis of search and examination results from any patent family application from any participating office, regardless of whether the participating office was the office of first filing. To implement the MOTTAINAI pilot, the USPTO revised its PPH requirements. See for example the notice available at <http://www.uspto.gov/web/offices/com/sol/og/2011/week33/TOC.htm#ref13>.

On January 29, 2012, the USPTO implemented PPH 2.0 with respect to the seven MOTTAINAI participating offices along with the European Patent Office (EPO) in order to further enhance the PPH program and to encourage greater usage of, and participation in, the PPH program. PPH 2.0 simplifies the PPH requirements and procedures in a consolidated and user-friendly framework, while at the same time ensuring that work sharing benefits to the offices are not diminished.

The IPOPHL is implementing PPH 2.0 with respect to USPTO.

II. Trial Period for the PPH 2.0 Program

The PPH 2.0 program will commence with respect to the USPTO on January 29, 2013 and will terminate on January 28, 2014. The trial period may be extended if necessary to adequately assess the feasibility of the PPH 2.0 program. The IPOPHL and the USPTO will evaluate the results of the PPH 2.0 program to determine whether and how the program should be implemented after the trial period. The offices may also terminate the PPH 2.0 program early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if the PPH 2.0 program will be terminated with respect to the USPTO before the January 28, 2014 date.

III. Requirements for Requesting Participation in the PPH 2.0 Program in the IPOPHL

In order to be eligible to participate in the PPH 2.0 Pilot Program, the following conditions must be met:

- (1) The IPOPHIL application for which participation in the PPH program is requested and the corresponding USPTO application must have the same priority date.
 - i) An application that validly claims priority (ANNEX Figures A,B,C and D);
 - ii) An application which is the basis of a valid priority claim under the Paris Convention for the application filed with IPOPHIL (Annex Figures E, F and G);
 - iii) An application which shares a common priority document with the application files in IPOPHIL (Annex Figures H, I, J, K and L);
 - iv) IPOPHIL application derived from/ related to a PCT application having no priority claim (Annex Figure M).

Provisional applications, plant applications, design applications, reissue applications, re-examination proceedings and applications subject to a secrecy order are excluded and not subject to participation in the PPH 2.0.

- (2) At least one (1) claim was determined by USPTO to be allowable/ patentable. The applicant must submit a copy of the allowable/ patentable claims from the USPTO application. If the USPTO office action does not explicitly state that a particular claim is allowable, the applicant must include a statement in the request for participation in the PPH 2.0 program or in the transmittal letter accompanying the request for participation that no rejection has been made in the USPTO office action regarding that claim, and therefore, the claim is deemed to be allowable by the USPTO.
- (3) All claims on file, as originally- filed or as amended, for examination under PPH 2.0 must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the IPOPHIL are of the same or similar scope as the claims in the USPTO. In this regard, a claim that is narrower in scope occurs when a USPTO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). A claim in the IPOPHIL which introduces a new/different category of claims to those claims indicated as allowable in the USPTO is not considered to sufficiently correspond. For example, if the USPTO claims only contain claims to a process of manufacturing a product, then the claims in the IPOPHIL are not considered to sufficiently correspond if the IPOPHIL claims introduce product claims that are dependent on the corresponding process claims.

The additional limitation that makes the claims in the PH application narrower in scope than the allowable/patentable claims in the USPTO application must have support in the written description of the PH application and the additional limitation must be presented in dependent form. The applicant is required to submit a claims correspondence table. The claims correspondence table must indicate how all the claims in the PH application correspond to the allowable/patentable claims in the USPTO application/s. The dependent claims with the additional limitations must be clearly identified in the claims correspondence table.

- (4) Examination of the PH application for which participation in the PPH 2.0 program is requested has not begun.
- (5) The applicant must file a request for participation in the PPH 2.0 program and a request that the PH application be advanced out of turn for examination by order of the Director. *Provided, That a Request for Early Publication pursuant to Rule 800.1 of the Implementing Rules and Regulations for Patents, as amended will be submitted for Direct Route applications. Provided, further, That this rule shall only apply to the first two- hundred (200) PPH applications annually which will be divided to one hundred (100) applications per semester to maintain manageable levels.*

The maximum number of PPH applications to be considered shall be reviewed annually and may be modified based on the number of filings, number of examiners and etc.

- (6) The applicant must submit a copy of the office action from the USPTO application just prior to the "Decision to Grant a Patent" (e.g. the latest "Notification for Reasons for Refusal") from each of the USPTO application(s) containing the allowable/ patentable claims that are the basis for the request. It will not be necessary for applicant to submit a copy of the "Decision to Grant a Patent." If the USPTO application is a first action allowance, i.e., there is no office action just prior to the "Decision to Grant a Patent," then applicant should indicate on the request form that no office action from the USPTO application is submitted since the USPTO application was a first action allowance.

The applicant must submit copies of any office actions (which are relevant to patentability) from the USPTO application(s) issued after the grant of the request for participation in the PPH 2.0 program in the IPOPHIL (especially where USPTO might have reversed prior holding of allowability).

- (7) The applicant must submit an information disclosure statement (IDS) listing the documents cited by the USPTO examiner in the USPTO office action (unless such IDS has already been filed in the IPOPHIL application). The applicant must submit copies of all the documents cited in the USPTO office action (unless the copies have already been filed in the PH application) except PH patents or PH patent application publications.

The request for participation in the PPH 2.0 program and all the supporting documents must be submitted to the IPOPHIL.

Where the request for participation in the PPH 2.0 program and special status are granted, the applicant will be notified and the PH application will be advanced out of turn for examination. In those instances where the request for participation in the PPH program does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given one opportunity to perfect

the request in a renewed request for participation. Note that action on the application by the examiner will NOT be suspended awaiting a reply by the applicant to perfect the request in a renewed request for participation. That is, if the application is picked up for examination by the examiner after the applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, the request and special status will be granted, the applicant will be notified and the PH application will be advanced out of turn for examination. If not perfected, the applicant will be notified and the application will await action in its regular turn.

- (8) Request for participation in the PPH program and special status granted in a parent application will not carry over to divisional application(s). The applicant must fulfil all the conditions set forth above in order for special status to be granted in the divisional application.

The Manual for Substantive Examination Procedure, as amended, defines divisional application as a non-elected application which is not elected after a requirement for restriction and can be subject of a new application. Rule 604 (b) of the Implementing Rules and Regulations on Inventions, as amended further provides that a later application filed for an invention divided out shall be considered as having been filed on the same day as the first application.

If any of the documents identified in items (6) and (7) above have already been filed in the PH application prior to the request for participation in the PPH program, it will not be necessary for the applicant to resubmit these documents with the request for participation. The applicant may simply refer to these documents and indicate in the request for participation in the PPH program when these documents were previously filed in the PPH application.

IV. Special Examining Procedures

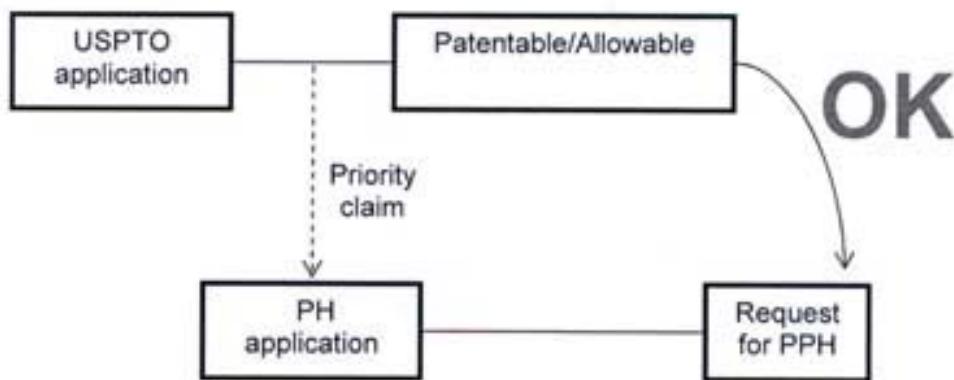
Once the request for participation in the PPH program and special status have been granted to the PH application, the PH application will be taken up for examination by the PH examiner before all categories of application except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination." *Provided,* That such applications make it to the first one hundred (100) PPH applications per semester.

Any claims amended or added after the grant of the request for participation in the PPH program must sufficiently correspond to one or more allowable/patentable claims in the USPTO application(s). The applicant is required to submit a claims correspondence table along with the amendment. If the amended or newly- added claims do not sufficiently correspond to the allowable/patentable claims in the USPTO application(s), the amendment will not be entered and will be treated as a non- responsive reply.

ANNEX

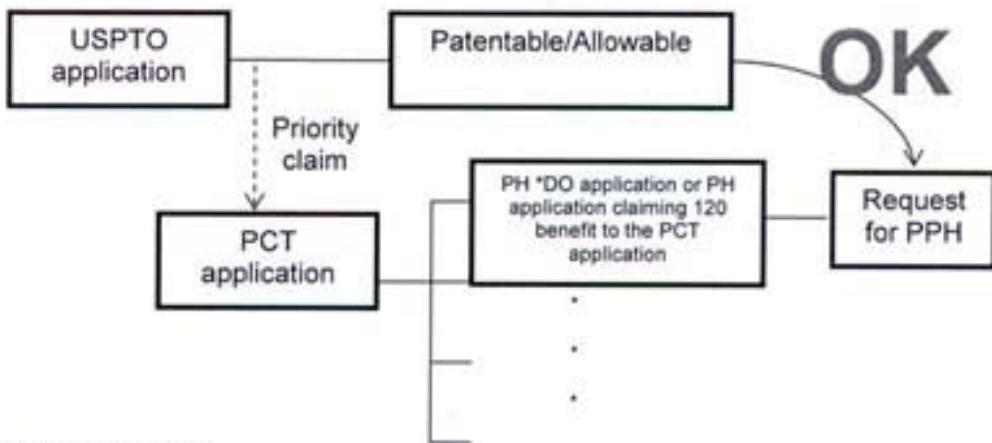
(Case I)
- Paris route -

A



(Case I)
- PCT route -

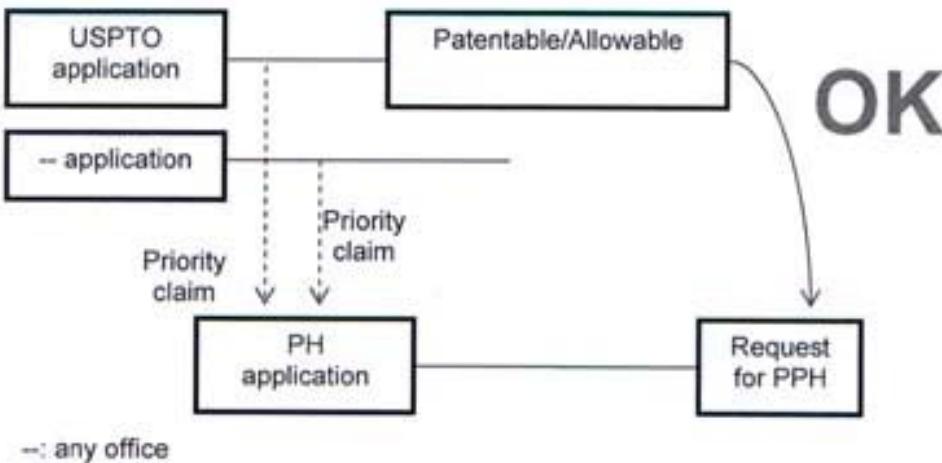
B



*DO – designated office

C

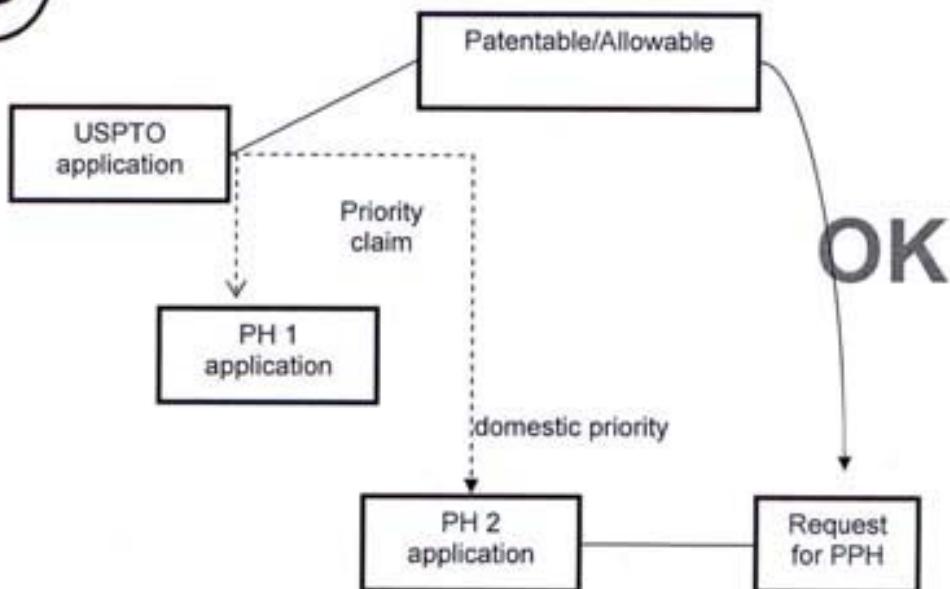
(Case I)
- Paris route & Complex priority -



--: any office

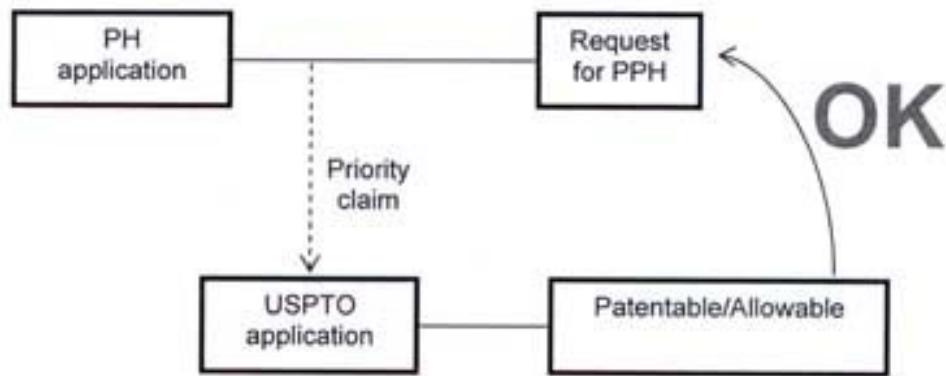
D

(Case I)
- Paris route & divisional application -



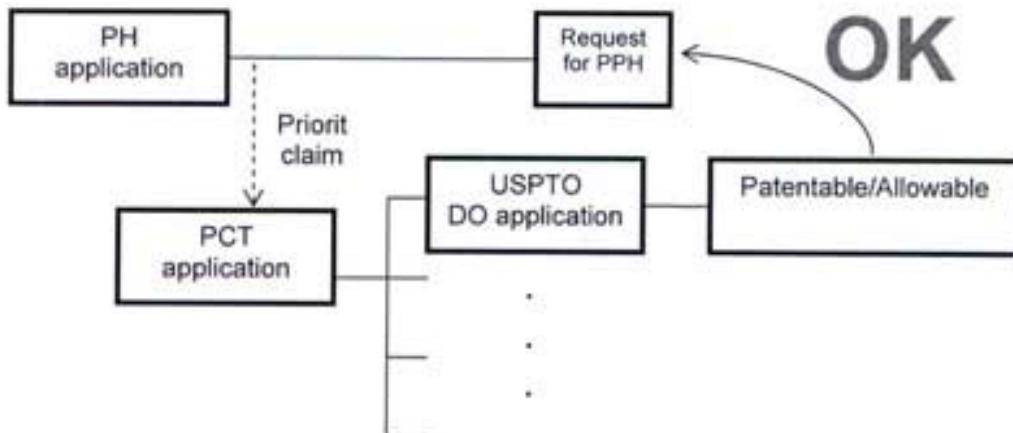
E

(Case II)
- Paris route -



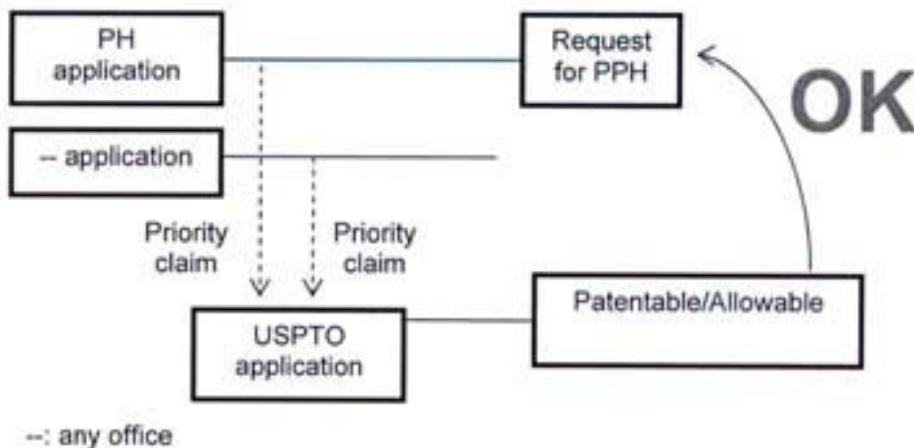
F

(Case II)
- PCT route -



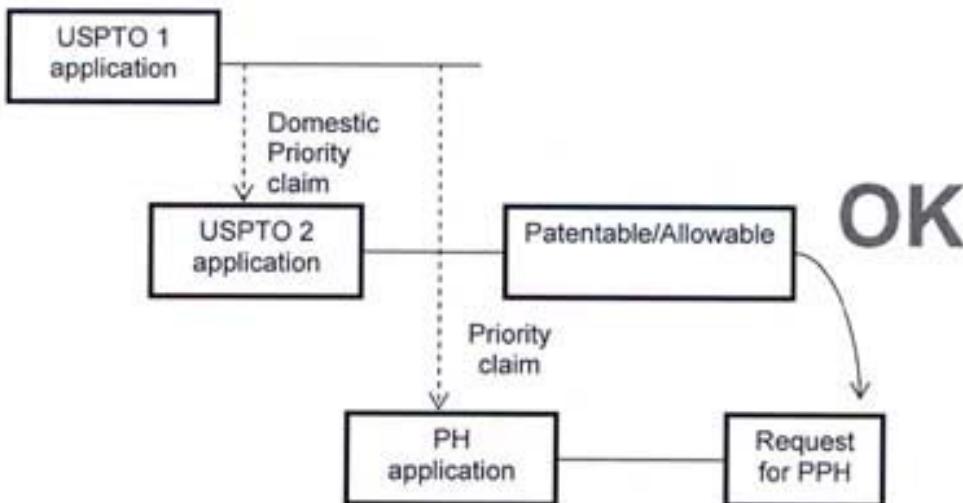
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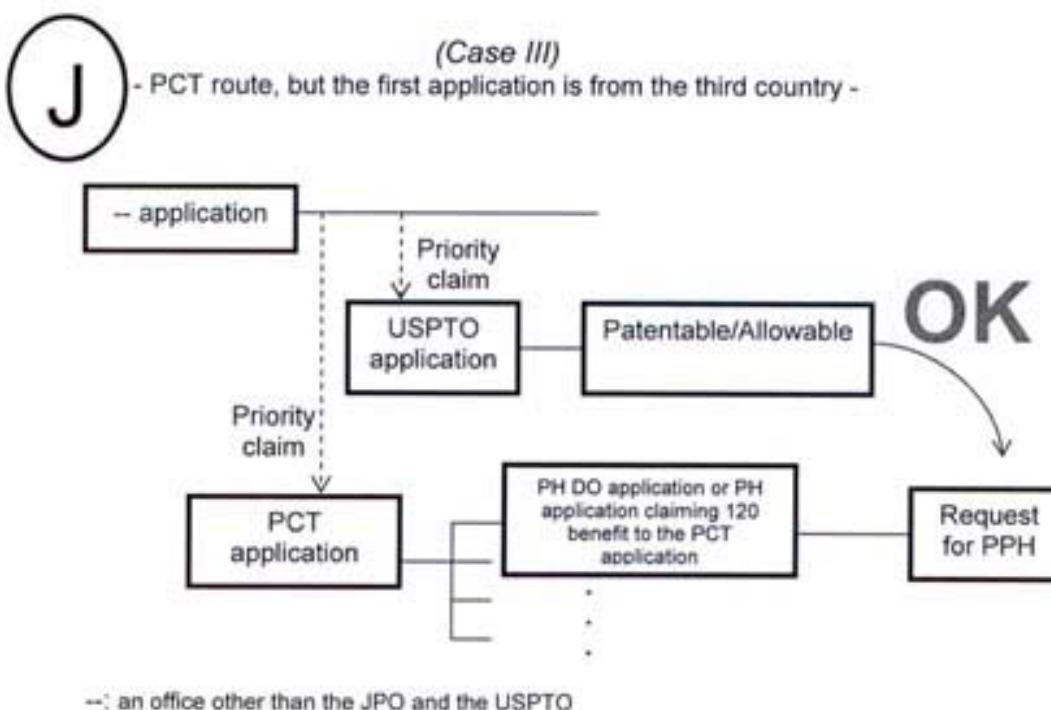
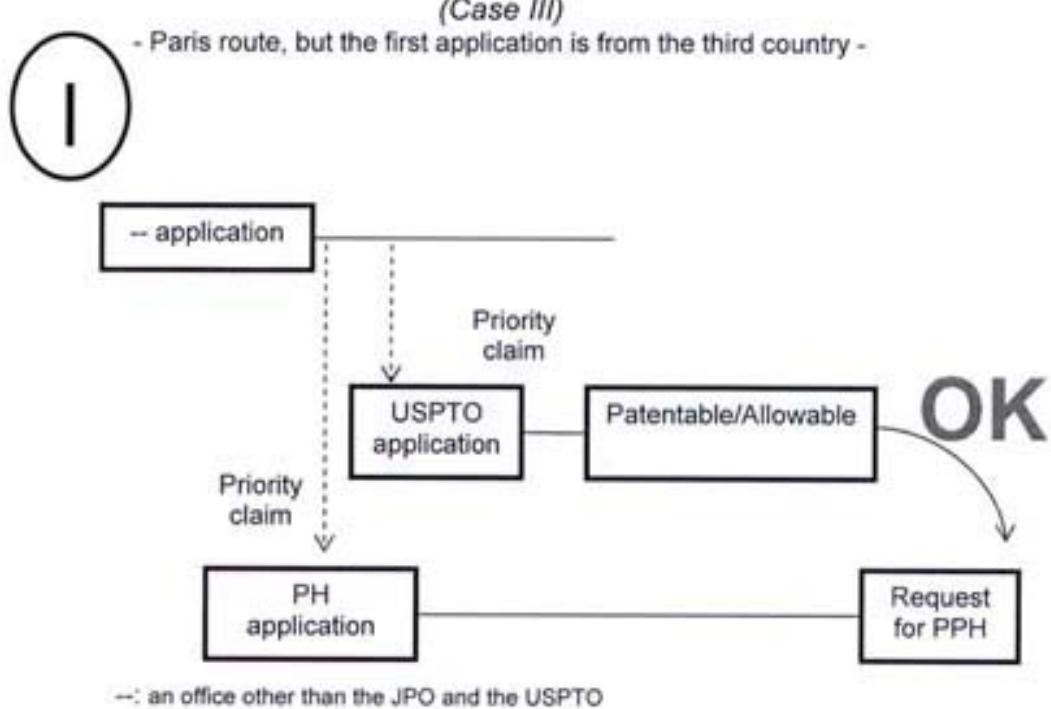
(Case II)
- Paris route & Complex priority -



H

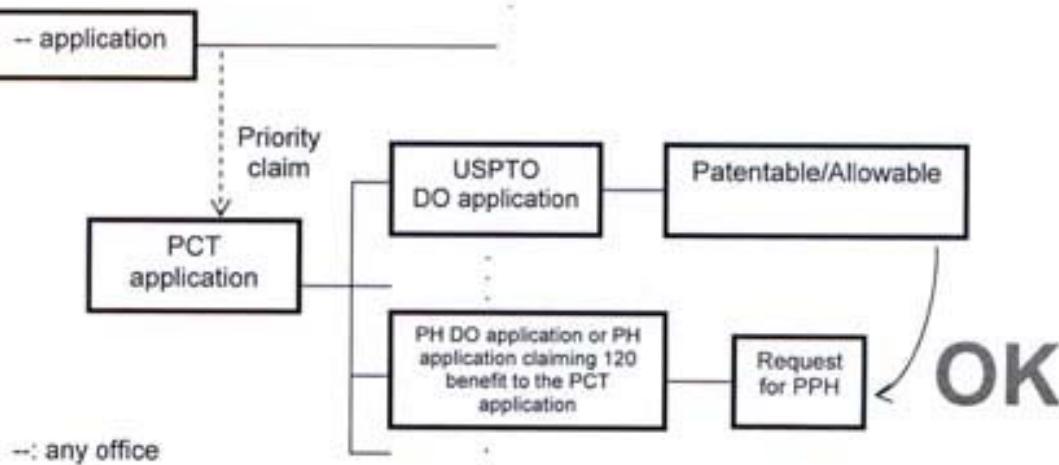
(Case III)
- Paris route, Domestic priority -





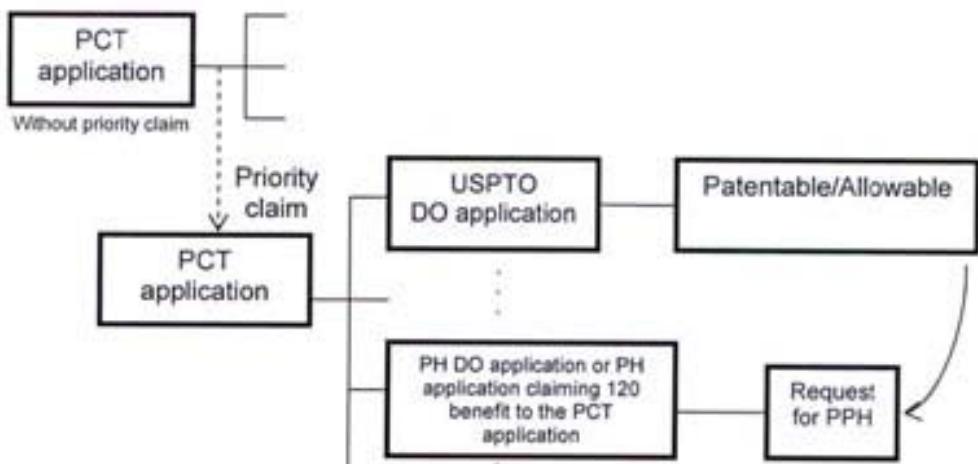
K

(Case III)
- PCT route -



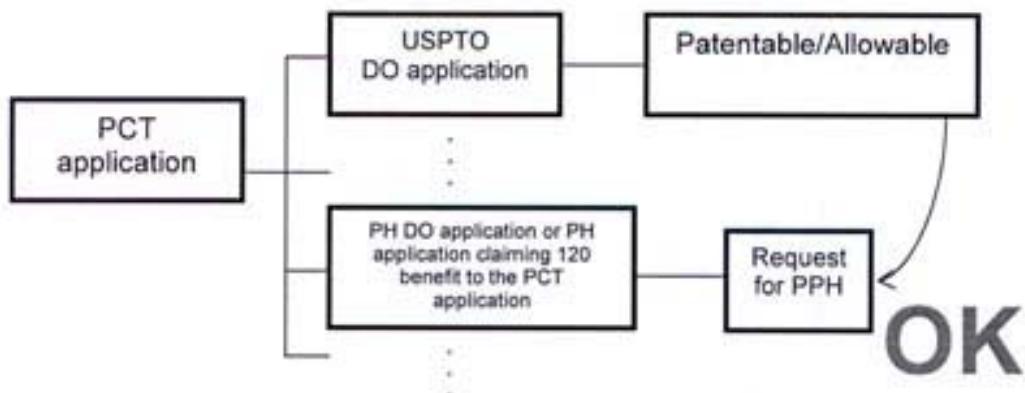
L

(Case III)
- Direct PCT & PCT route -



M

(Case IV)
- Direct PCT route -



USPTO- IPOPHL PATENT PROSECUTION HIGHWAY (PPH) REQUEST FORM

APPLICATION NO.	
TITLE OF THE INVENTION	
APPLICANT	
CORRESPONDING USPTO APPLICATION NO.	
DOCUMENTS SUBMITTED	<ul style="list-style-type: none"> <input type="checkbox"/> Copies of all office actions <input type="checkbox"/> Copies of all claims determined to be patentable/ allowable by the USPTO <input type="checkbox"/> Information Disclosure Statement (IDS) <input type="checkbox"/> Claim Correspondence Table <input type="checkbox"/> Request for an Advanced-out-of-turn Examination
SIGNATURE/ DATE	
<i>For authorized receiving officer of IPOPHL only</i>	
RECEIVING OFFICER	
DATE RECEIVED	

ANNEX B

CLAIM CORRESPONDENCE TABLE

USPTO- IPOPHL PCT- PATENT PROSECUTION HIGHWAY (PPH) REQUEST FORM

APPLICATION NO.	
TITLE OF THE INVENTION	
APPLICANT	
CORRESPONDING USPTO APPLICATION NO.	
DOCUMENTS SUBMITTED	<ul style="list-style-type: none"> <input type="radio"/> Copies of all office actions <input type="radio"/> Copies of all claims determined to be patentable/ allowable by the USPTO <input type="radio"/> Information Disclosure Statement (IDS) <input type="radio"/> Claim Correspondence Table <input type="radio"/> Request for an Advanced-out-of-turn Examination
SIGNATURE/ DATE	<p><i>For authorized receiving officer of IPOPHL only</i></p>
RECEIVING OFFICER	
DATE RECEIVED	

ANNEX B

**Procedures to file a request to the IPOPHL
(Intellectual Property Office of the Philippines) for Patent
Prosecution Highway Pilot Program between the IPOPHL and the
KIPO (Korean Intellectual Property Office)**

Part I

PPH using the national work products from the KIPO

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

When filing a request for the PPH pilot program, an applicant must submit a request form to the IPOPHL.

The Offices may 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.

The PPH pilot program will be in effect for two (2) years commencing on May 1, 2015 and will end on 30 June 2017. However, the program may be extended after a joint IPOPHL-KIPO review and assessment of the program implementation.

1. Requirements

(a) Both the IPOPHL application on which PPH is requested and the KIPO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).

For example, the IPOPHL application (including PCT national phase application) may be either:

(Case I) an application which validly claims priority under the Paris Convention from the KIPO application(s) (examples are provided in ANNEX I, Figures A, B, C, H, I and J), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the KIPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures D and E), or

(Case III) an application which shares a common priority document with the KIPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures F, G, L, M and N), or

(Case IV) a PCT national phase application where both the KIPO application and the IPOPHL application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX I, Figure K).

(b) At least one corresponding application exists in the KIPO and has one or more claims that are determined to be patentable/allowable by the KIPO.

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the KIPO application which forms the basis of the priority claim (e.g., a divisional application of the KIPO application or an application which claims domestic priority to the KIPO application (see Figure C in Annex I)), or a KIPO national phase application of a PCT application (see Figures J, K, L, M and N in Annex I).

Claims are “determined to be allowable/patentable” when the KIPO clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet.

(c) All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the KIPO.

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

A claim in the IPOPHL which introduces a new/different category of claims to those claims indicated as allowable in the KIPO is not considered to sufficiently correspond. For example, where the KIPO claims only contain claims to a process of manufacturing a product, then the claims in the IPOPHL are not considered to sufficiently correspond if the IPOPHL claims introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in the KIPO application.

(d) A request for PPH may be submitted even during the substantive examination stage,

provided that, examination on the merits of the application has not been made or issued yet.

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to the PPH request.

- (a) ***Copies of all office actions (which are relevant to substantial examination for patentability in the KIPO) which were issued for the corresponding application by the KIPO, and translations of them¹.***

Either Filipino or English is acceptable as translation language. The applicant does not have to submit a copy of KIPO office actions and translations of them when those documents are provided via [K-PION \(<http://k-pion.kipo.go.kr/>\)](http://k-pion.kipo.go.kr/) (KIPO's dossier access system) because the office actions and their machine translations are available for the IPOPHL examiner via the [K-PION](#). If they cannot be obtained by the IPOPHL examiner via the [K-PION](#), the applicant may be notified and requested to provide the necessary documents.

- (b) ***Copies of all claims determined to be patentable/allowable by the KIPO, and translations of them.***

Either Filipino or English is acceptable as translation language. The applicant does not have to submit a copy of claims indicated to be allowable/patentable in the KIPO, and translations thereof when the documents are provided via [K-PION \(<http://k-pion.kipo.go.kr/>\)](http://k-pion.kipo.go.kr/) (KIPO's dossier access system) because they are available for the IPOPHL examiner via the [K-PION](#). If they cannot be obtained by the IPOPHL examiner via the [K-PION](#), the applicant may be notified and requested to provide the necessary documents.

- (c) ***Copies of references cited by the KIPO examiner***

If the references are patent documents, the applicant doesn't have to submit them because the IPOPHL usually possesses them. When the IPOPHL does not possess the patent document, the applicant has to submit the patent document at the examiner's request. Non-patent literature must always be submitted. The translations of the references are unnecessary.

- (d) ***Claim correspondence table***

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the IPOPHL application sufficiently correspond to the

¹ Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

patentable/allowable claims in the KIPO application.

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

3. Procedure for the accelerated examination under the PPH pilot program

The IPOPHL decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When the IPOPHL decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again.

4. PPH request form

Subject: Request for an accelerated examination under the PPH pilot program

Date of filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

This application is an application validly claiming the priority under the Paris Convention to the corresponding KIPO application (the application number is _____), and the accelerated examination is requested under the PPH pilot program. For this purpose, the following documents are attached:

- Copies of all office actions (which are relevant to substantial examination for patentability in the KIPO) which were issued for the corresponding application by the KIPO and
 - translations of them
- Copies of all claims determined to be patentable/allowable by the KIPO and
 - translations of them
- Copies of references cited by the KIPO examiner
- Claim correspondence table

Part I PPH using the national work products from the KIPO

Claim correspondence table

The claim in the IPOPHL	The patentable claim in the KIPO	Comments about the correspondence

(Documents to be omitted to submit)

Part II

PPH using the PCT international work products from the KIPO

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

When filing a request for the PCT-PPH pilot program, an applicant must submit a request form to the IPOPHL.

The Offices may terminate the PCT-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.

The PPH pilot program will be in effect for two (2) years commencing on May 1, 2015 and will end on 30 June 2017. However, the program may be extended after a joint IPOPHL-KIPO review and assessment of the program implementation.

1. Requirements

The application which is filed with the IPOPHL 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 Examination 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 KIPO, 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 request under PCT-PPH 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 pilot 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 national phase application of the corresponding international application. (See Figures A, A', and A" in Annex II)
- (B) The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex II)
- (C) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)
- (D) The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure D in Annex II)
- (E) The application is the derivative application (divisional application and application claiming domestic 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 IPOPHL are of the same or similar scope as the claims indicated as allowable in the latest international work product, or the claims in the IPOPHL 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 IPOPHL 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 IPOPHL are not considered to sufficiently correspond if the IPOPHL claims introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in the latest international work product.

- (4) A request for PPH may be submitted even during the substantive examination stage, provided that, examination on the merits of the application has not been made or issued yet.**

2. Documents to be submitted

The applicant must submit the following documents attached to the request form in filing a request under PCT-PPH. 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 Filipino 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®”², an applicant need not submit these documents, unless otherwise requested by the IPOPHL.

(WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date.)

- (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 Filipino 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®” (e.g. the international Patent Gazette has been published), an applicant need not submit this document unless otherwise requested by the IPOPHL. Where the set of claims is written in Korean language, the translations thereof must be still submitted by an applicant.

² <http://www.wipo.int/pctdb/en/index.jsp>

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

If the reference is a patent document, the applicant is not required to submit it. In case the IPOPHL has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

(4) A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable.

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 based on the criteria 1. (3) (Please refer to the Example form below).

When an applicant has already submitted the above mentioned documents (1) - (4) to the IPOPHL 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 the accelerated examination under the PPH pilot program

The IPOPHL decides whether the application can be entitled to the status for an accelerated examination under the PCT-PPH when it receives a request with the documents stated above.

When the IPOPHL decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PCT-PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PCT-PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PCT-PPH, the applicant can request the PCT-PPH again.

4. PCT-PPH request form

Subject: Request for an accelerated examination under the PCT-PPH pilot program

Date of filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

This application is a national phase application of a PCT international application (the application number is _____), and the accelerated examination is requested under the PCT-PPH pilot program. For this purpose, the following documents are attached:

- A copy of the latest international work product which indicated the claims to be patentable/allowable and
 - their Filipino or English translations if they are not in English
- 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 Filipino or English translations if they are not in English
- A copy of references cited in the latest international work product of the international application corresponding to the application
- A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable

Claim correspondence table

The claim in the IPOPHL	The patentable claim in the international phase	Comments about the correspondence

(Documents to be omitted to submit)

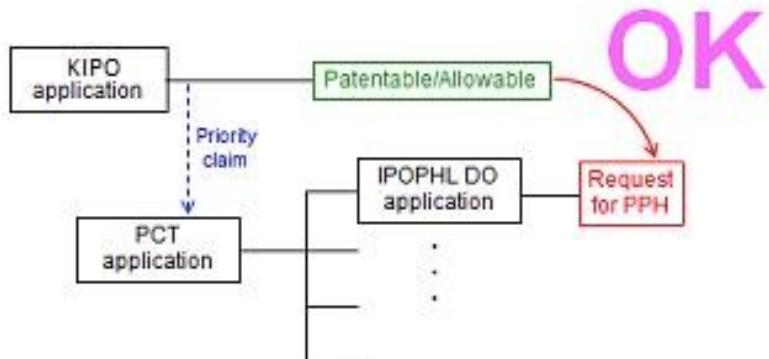
A

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



B

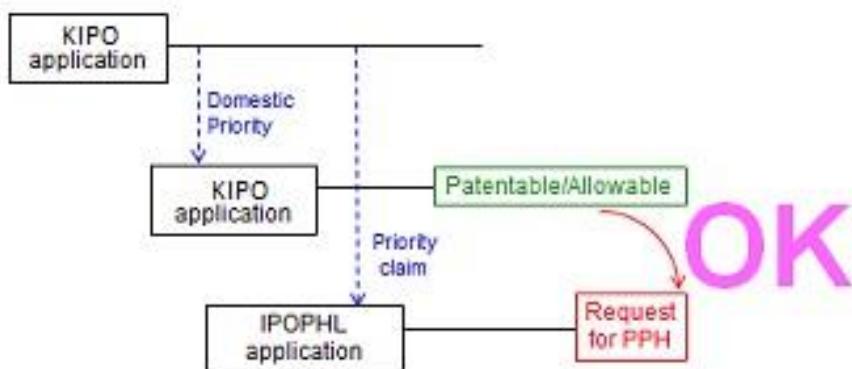
A case meeting requirement (a) (I)
- PCT route -



C

A case meeting requirement (a) (I)

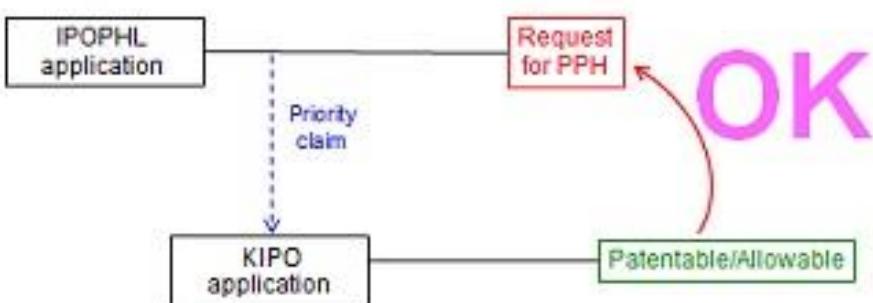
- PCT route, Domestic priority -



D

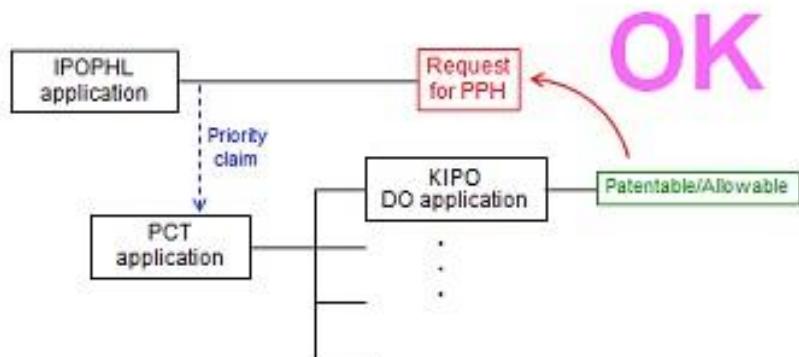
A case meeting requirement (a) (II)

- Paris route -



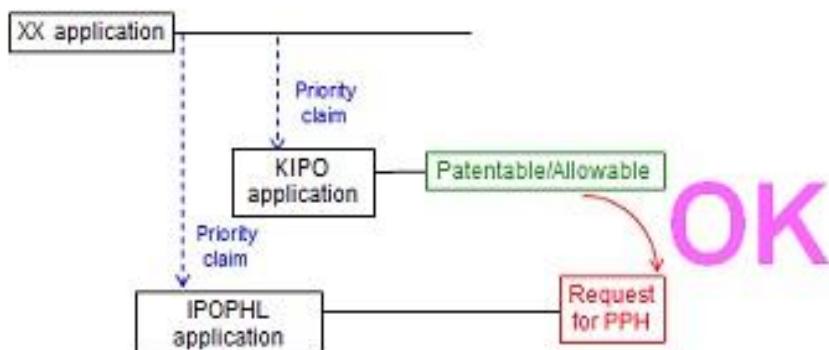
E

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



F

A case meeting requirement (a) (III)
 - Paris route, but the first application is from the third country -

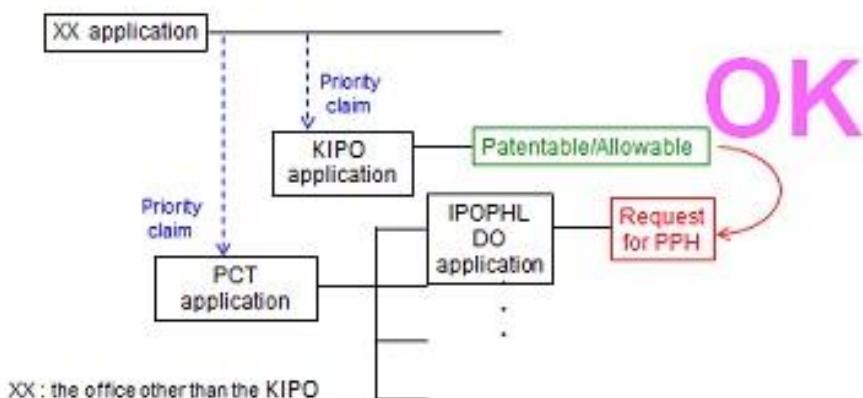


XX : the office other than the KIPO

G

A case meeting requirement (a) (III)

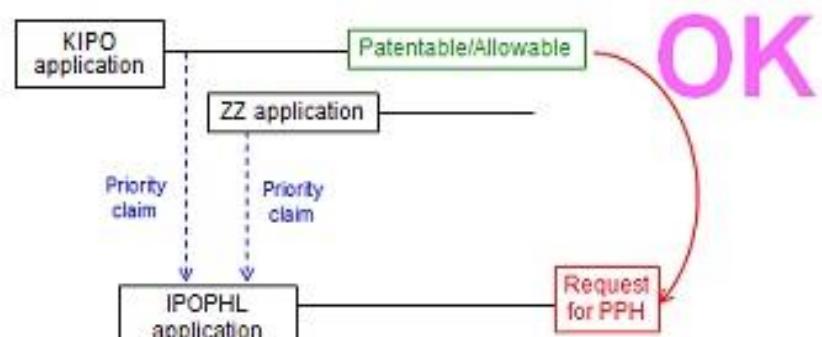
- PCT route, but the first application is from the third country -



H

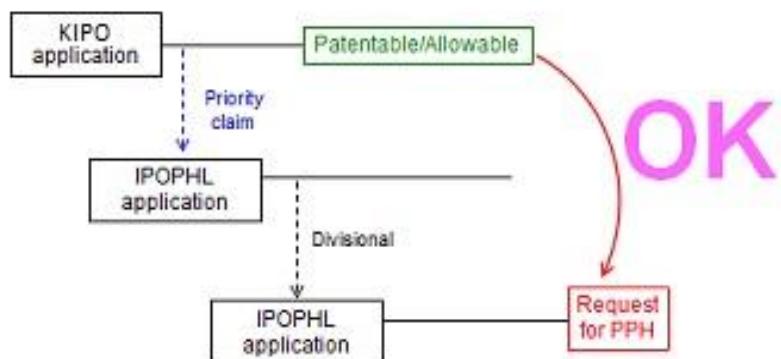
A case meeting requirement (a) (I)

- Paris route & Complex priority -

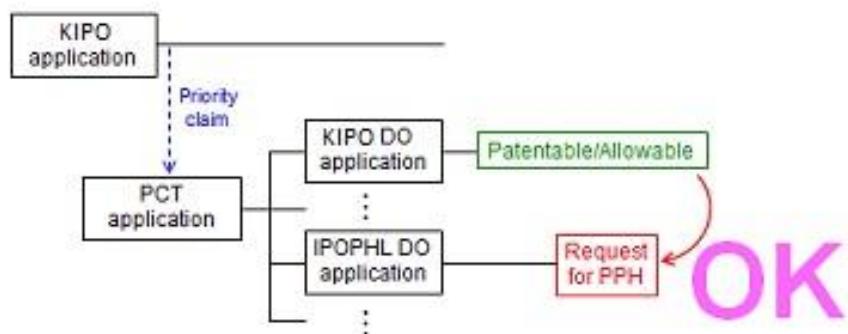


ZZ : any office

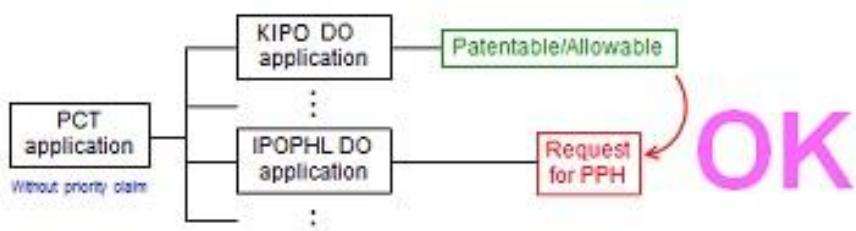
I A case meeting requirement (a) (I)
- Paris route & divisional application -



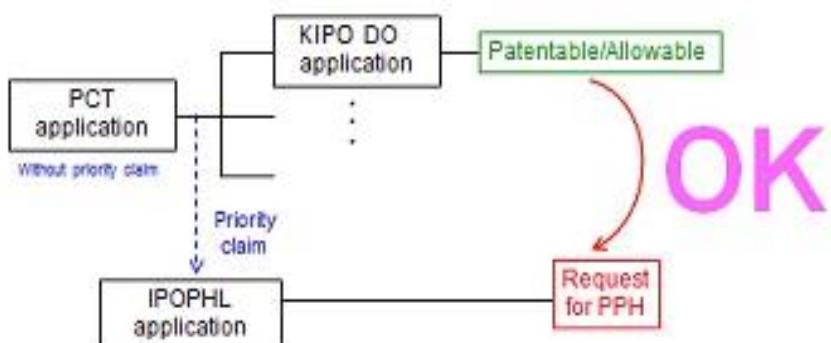
J A case meeting requirement (a) (I)
- PCT route -



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

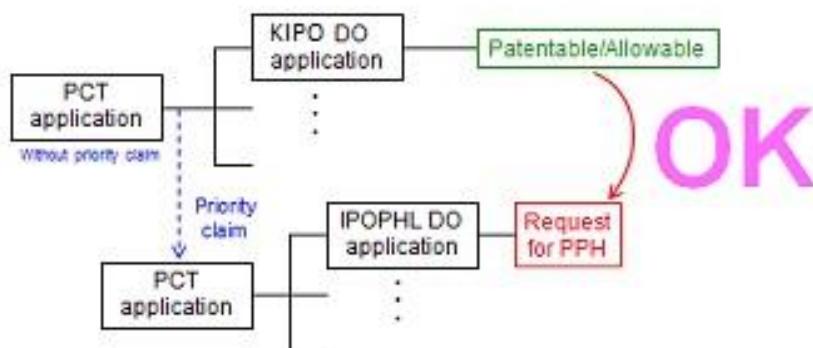


L A case meeting requirement (a) (III)
- Direct PCT & Paris route -

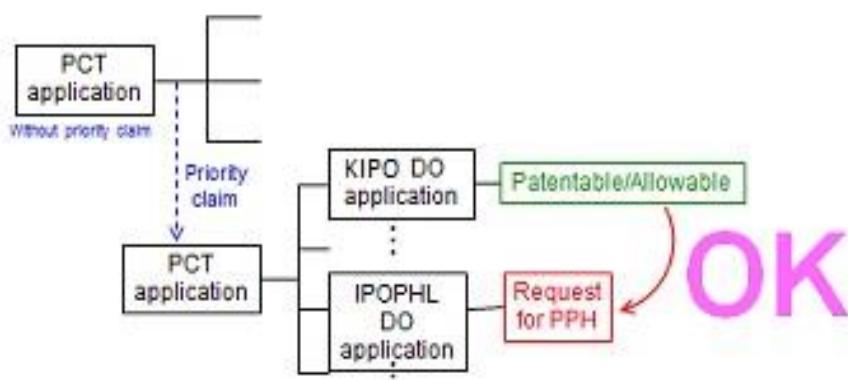


M

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

**N**

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



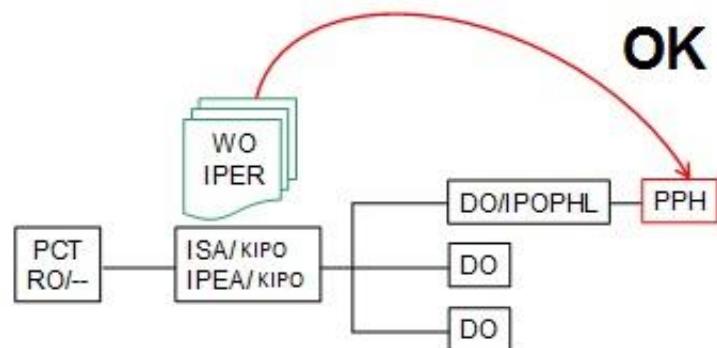


A case not meeting requirement (d)

- Examination has begun before a request for PPH -

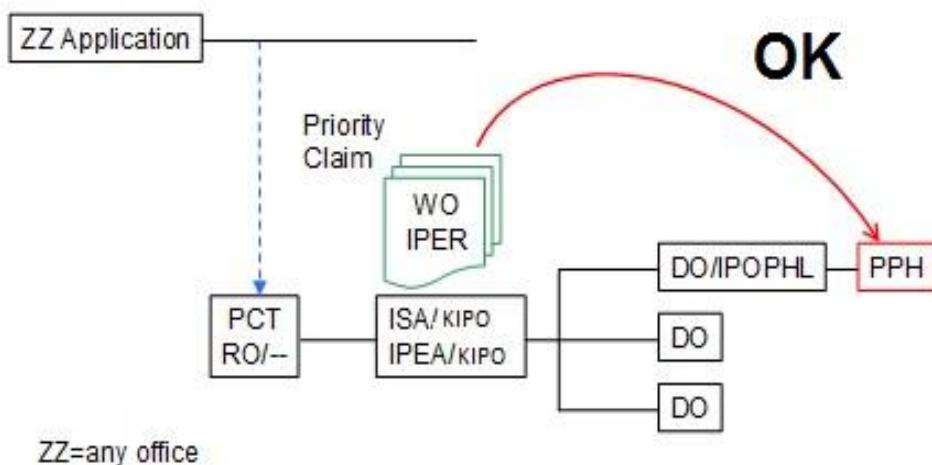


(A) The application is a national phase application of the corresponding international application.



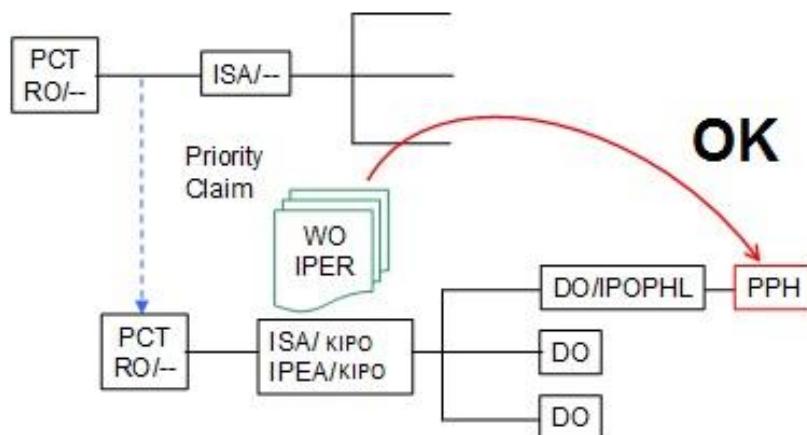
(A') The application is a national phase application of the corresponding international application.

(The corresponding international application claims priority from a national application.)

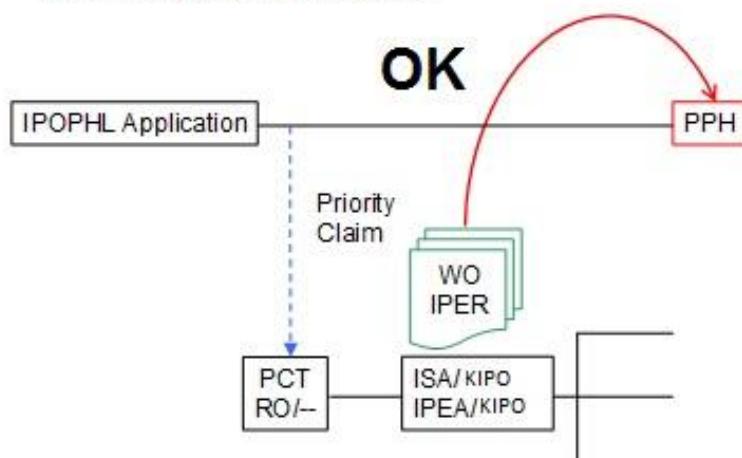


(A'') The application is a national phase application of the corresponding international application.

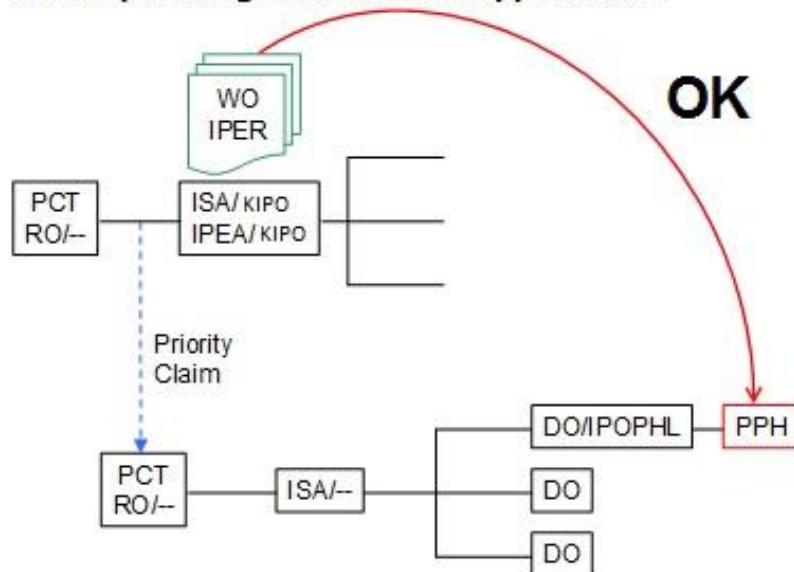
(The corresponding international application claims priority from an international application.)



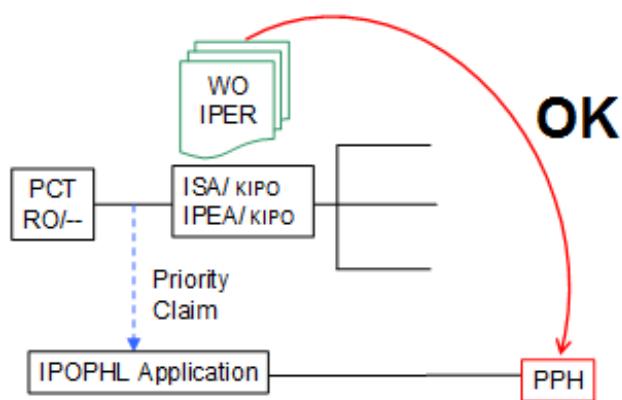
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



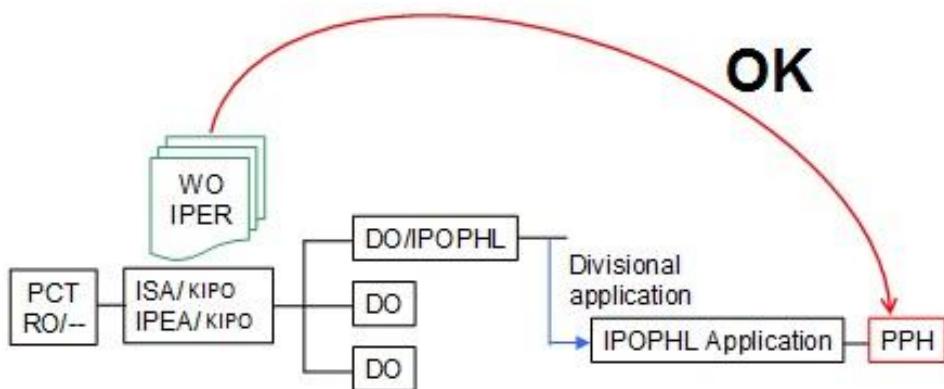
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



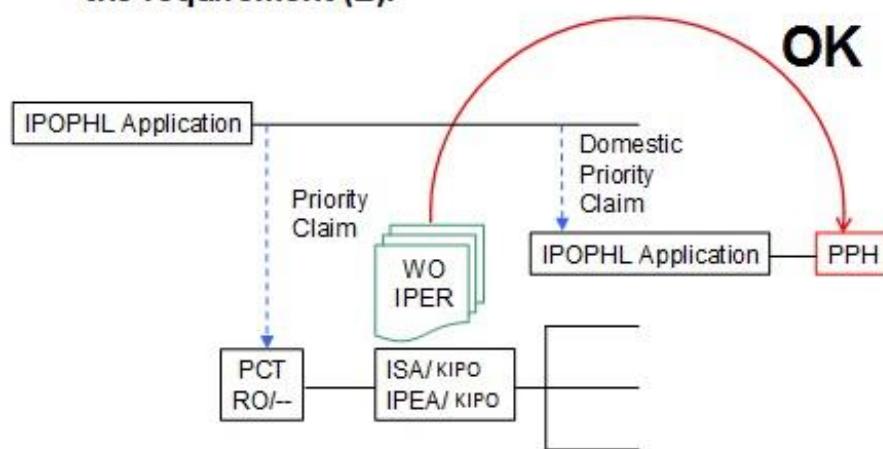
(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



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



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



Annex A

Patent Prosecution Highway pilot programme between the EPO and IPOPHL based on PCT and national work products

The Patent Prosecution Highway (PPH) leverages fast-track patent examination procedures already available at the offices to allow applicants to obtain corresponding patents faster and more efficiently. It also permits each office to exploit the search and examination work previously done by the other office. The PPH pilot programme reproduces the participation conditions and requirements currently applicable to PPH programmes operational worldwide, in particular the IP5 and the Global PPH (GPPH) programmes. It also reflects the so-called PPH Global Principles as developed in the framework of the PPH Working Group.

Participation in the programme will be possible: (a) before IPOPHL and the EPO on the basis of national work products established respectively by IPOPHL and the EPO, and (b) before IPOPHL and the EPO on the basis of international work products, i.e. the WO-ISA, or where a demand under Chapter II has been filed, the WO-IPEA or the IPER, established by the IPOPHL and EPO in their capacity as ISA and/or IPEA under the PCT.

For IPOPHL, this rule shall only apply to the first two- hundred (200) PPH applications annually which will be divided to one hundred (100) applications per semester to maintain manageable levels. The maximum number of PPH applications to be considered shall be reviewed periodically, and may be modified based on the number of filings, number of examiners, etc.

A. Requirements for requesting participation in the PPH pilot programme IPOPHL

In order to be eligible to participate in the PPH pilot programme at the IPOPHL, the following requirements must be met:

- (1) The PH application for which participation in the PPH pilot programme is requested and the corresponding national application filed with the other Office or a corresponding PCT international application for which one of the Offices has been ISA and/or IPEA must have the same earliest date whether this be the priority or filing date.
- (2) The corresponding application(s) has/have at least one claim indicated by the Office of Earlier Examination (OEE) in its capacity as a national or regional Office, ISA and/or IPEA, to be patentable/allowable. The claim(s) determined as novel, inventive and industrially applicable by the ISA and/or IPEA has/have the meaning of patentable/allowable for the purposes of this document.
- (3) All claims in the application for which a request for participation in the PPH pilot programme is made must sufficiently correspond to the patentable/allowable claims in the corresponding application(s). Claims are considered to sufficiently correspond where, accounting for differences due to claim format requirements, the claims are of the same or a similar scope or the claims in the application for which PPH is requested are narrower in scope than the claims in the corresponding application(s). In this regard, a claim that is narrower in scope occurs when an OEE claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). Additionally, a claim in the Office of Later Examination (OLE) application which introduces a new/different category of claims than those indicated to be patentable/allowable by the OEE is not



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

considered to sufficiently correspond, unless national/regional laws permit such claim types. For example, where the OLE claims only contain claims to a process of manufacturing a product, then the claims in the OLE application are not considered to sufficiently correspond if the OLE claims introduce product claims that are dependent on the corresponding process claims.

(4) Substantive examination of the OLE application for which participation in the PPH pilot programme is requested has **not** begun.

B. Documents required for participation in the PPH pilot programme

For participation in the PPH pilot programme at the IPOPHL the applicant has to:

(1) file a request for participation in the PPH pilot programme. A request form is available via the IPOPHL website, specifically @ <https://www.ipophil.gov.ph/patent-prosecution-highway-pph/>;

(2) file a claims correspondence table

or

where applicable, a declaration of claims correspondence;

(3) submit a copy of

either all the office actions or, where applicable, the latest office action for the OEE corresponding application(s) containing the patentable/allowable claims that are the basis for the PPH request and a translation thereof in one of the acceptable languages at the IPOPHL,

or

the latest work product in the international phase of a PCT application, the WO-ISA or, where a demand under PCT Chapter II has been filed, the WO-IPEA or the IPER, and a translation thereof in one of the acceptable languages at the IPOPHL.

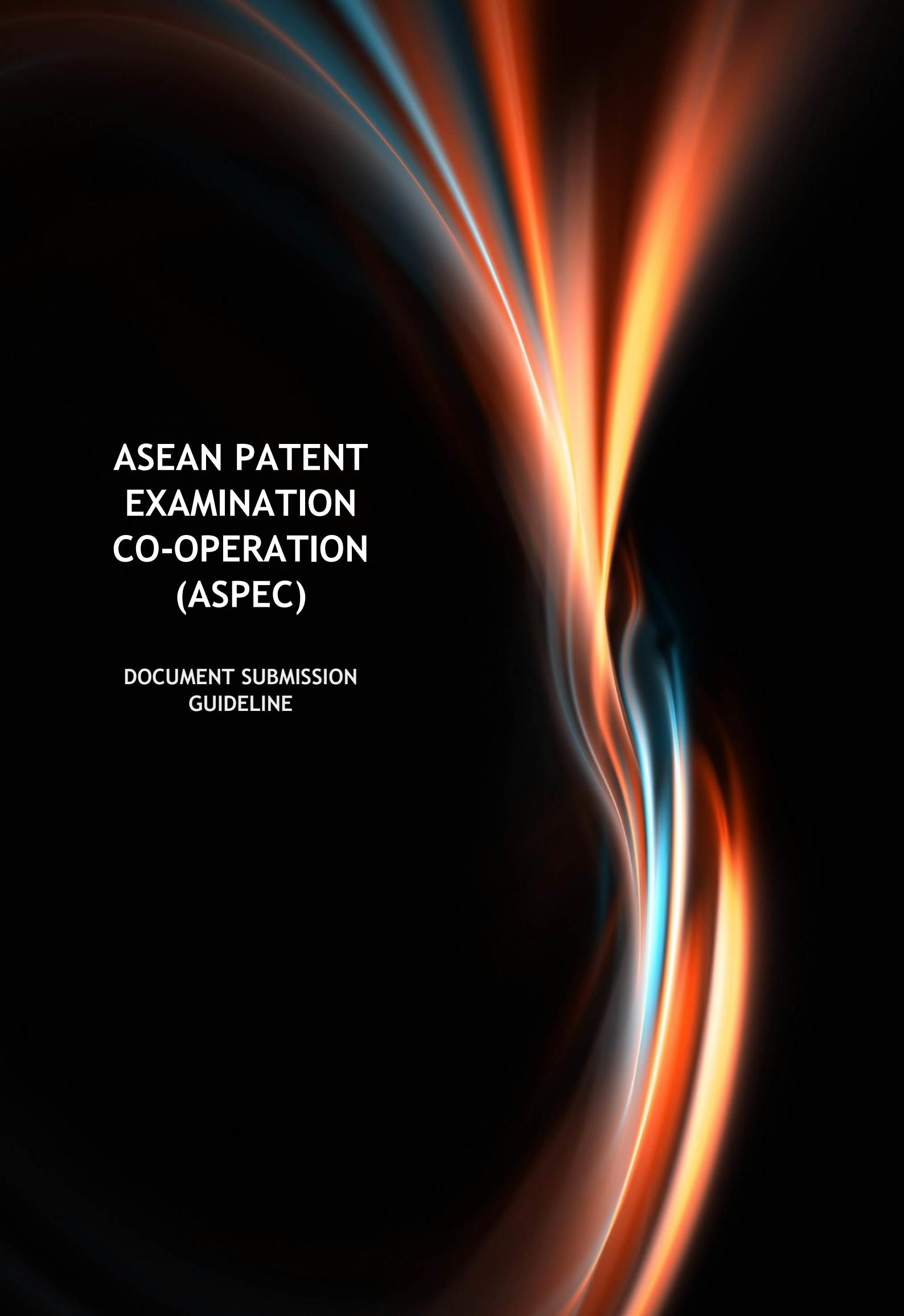
(4) submit a copy of the patentable/allowable claim(s) from the OEE application(s) and a translation thereof in one of the acceptable languages of the IPOPHL.

(5) submit copies of all the documents cited in the office action(s) or the PCT work product identified in point (3) above. If the cited document is a patent document, the applicant is not required to submit it, unless the IPOPHL has difficulty in obtaining it, in which case the applicant may be asked to submit it.

Where the request for participation in the PPH pilot programme is granted, the PH application will be processed in an accelerated manner. In those instances where the request for participation in the PPH pilot programme does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. The applicant will be given at least **one** opportunity to correct deficiencies identified in the request. If the request is not corrected, the application will be taken out of the PPH programme and the applicant will be notified.

If any of the documents identified in points (3) and (4) above

- (a) have already been filed in the PH application prior to the request for participation in the PPH pilot programme, it will not be necessary for the applicant to resubmit these documents with the PPH request. The applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot programme when these documents were previously filed in the PH application.
- (b) are available via DAS (Dossier Access System) or Patentscope, the applicant does not need to submit a copy thereof, but has to provide a list of the documents to be retrieved. Machine translations will be admissible for the documents identified in points (3) and (4). The IPOPHL can request applicants to submit an accurate translation, if the machine translation is insufficient. If the OEE application(s) is (are) unpublished, the applicant must submit the documents identified in points (3) and (4) above upon filing the PPH request.



ASEAN PATENT EXAMINATION CO-OPERATION (ASPEC)

**DOCUMENT SUBMISSION
GUIDELINE**

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4	Enquiries.....	5

ASEAN Patent Examination Co-operation (ASPEC) Guideline

1 Introduction

1.1 The ASEAN Patent Examination Co-operation (ASPEC) Programme is the first regional patent cooperation project. The programme commenced on 15 June 2009. ASPEC enables IP Offices from participating ASEAN member states (“AMS”) to utilise the search and examination (“S&E”) results from another participating AMS IP Office as reference in its own S&E work.

1.2 There are 9 participating AMS IP Offices: Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand and Viet Nam.

1.3 The participating AMS IP Office may consider the S&E documents it receives under the ASPEC programme. It is not obliged to adopt any of the findings or conclusions reached by the other IP Office. It will proceed with and conclude its S&E work as well as decide on whether to grant the patent in the manner that is in accordance with its national laws.

1.4 For patent applicants, when an ASPEC request is filed at a participating AMS IP Office in accordance with the requirements at that Office, the applicant will be able to benefit from expedited processes from the time of filing the ASPEC request until grant.

1.5 Starting on 27 August 2019, 2 new features under ASPEC have been introduced:

1.6 ASPEC Acceleration for Industry 4.0 Infrastructure and Manufacturing (ASPEC AIM)

- Benefits to applicant: turnaround time of 6 months¹ to receive the first office action if an ASPEC request is made for Industry 4.0 patent applications
- Duration: Initial pilot period of 2 years starting from 27 August 2019 with a further extension of 2 years till 26 August 2023
- Capacity: Up to 50 eligible applications per year

1.7 Patent Cooperation Treaty ASPEC (PCT-ASPEC)

- Benefits to applicant: additional choice of relying on a Patent Cooperation Treaty (PCT) reports issued from an ASEAN International

¹ Computation of turnaround time starts from the ASPEC AIM request date, the publication end date, or the S&E request date; whichever is the latest.

Searching Authority/International Preliminary Examining Authority (ISA/IPEA)²

- Duration: Initial pilot period of 3 years starting from 27 August 2019 with a further extension of 3 years till 26 August 2025
- Capacity: Up to 100 applications per year

1.8 With effect from 15 June 2021, applicant can also utilise written opinion³ established by another participating AMS IP Office⁴.

2 Requirements for requesting ASPEC, ASPEC AIM and PCT-ASPEC

2.1 A patent application in a participating AMS IP Office where the ASPEC Request Form is filed (“second IP Office”) must be a corresponding patent application of the other participating AMS IP Office (“first IP Office”). The ASPEC Request must be supported by S&E documents of the corresponding application from the first IP Office.

2.2 All claims filed in subsequent IP Offices must sufficiently correspond to allowable/patentable claims referred to in the S&E documents from the first IP Office.

2.3 To qualify for PCT-ASPEC and ASPEC AIM, the following eligibility criteria are required:

- **PCT-ASPEC**: The basis to be relied upon for examination should be an international preliminary examination report or a written opinion issued by an ASEAN ISA/IPEA as the first IP Office.
- **ASPEC AIM**: The first IP Office indicates at least one IPC code from [Appendix 1](#) in the report.

2.4 A patent application in the first IP Office is a corresponding application if it is:

1. linked by a Paris Convention priority claim to the patent application in the second IP Office, and vice-versa, or
2. the patent applications in both the first IP Office and second IP Office have the same priority claim from another member of Paris Convention or World Trade Organization, or

² Currently, ASEAN ISA/IPEA refers to the IP Offices of Singapore and the Philippines.

³ Written opinion refers to a non-final assessment of the novelty, inventive step and industrial applicability of the claimed invention that is issued by participating AMS IP Offices. Examples of names of “written opinion” used in AMS are “written opinion” in Brunei, Singapore and the Philippines, and “adverse report” in Malaysia.

⁴ Written opinion is an acceptable S&E result for all participating AMS IP Offices except the IP Office of Thailand.

3. the patent applications in both the first IP Office and second IP Office are national phase entry applications from the same Patent Cooperation Treaty (“PCT”) application.

3 Procedures for requesting ASPEC, ASPEC AIM & PCT-ASPEC

Requesting ASPEC & ASPEC AIM

3.1 The applicant is required to file a duly completed ASPEC Request Form in the second IP Office. (Note: The ASPEC Request Form is not required to be filed in the first IP Office.) The ASPEC Request Form shall be accompanied by the following documents⁵:

1. a copy of the written opinion or the Examination report (“minimum documents”) of a corresponding application from the first IP Office, and
2. a copy of the claims referred to in the minimum documents submitted, with at least one claim determined by the first IP Office to be allowable/patentable.

3.2 The submission by the applicant of the S&E results issued by an AMS for an unpublished application to another AMS Office is consent for the other AMS to use the S&E results.⁶

3.3 The applicant can submit more than 1 written opinion from participating AMS IP Offices if the written opinions support the scope of the patent application.

3.4 For ASPEC AIM request, applicants should indicate that the request is for ASPEC AIM in the ASPEC form under Remarks. In addition, applicants are also required to email the monitoring authority (aspec@ipos.gov.sg) and respective ASPEC AIM focal point listed in 4.1. Information that needs to be provided include:

- i. Application no. from first IP Office;
- ii. Desired second IP Office and application no. in the Second IP Office;
- iii. Date of request
- iv. Reliance on written opinion or Examination report; and
- v. Applicant.

3.5 For ASPEC request which relies on a written opinion or written opinions, applicants are required to email the monitoring authority (aspec@ipos.gov.sg) and

⁵ Documents submitted should include a copy of (i) a search report, (ii) a written opinion or an examination report, and (iii) claims referred to in the written opinion or the examination report. A claim correspondence table is optional.

⁶ For unpublished applications, the S&E results issued by the IP Office of the Philippines in this regard constitute a waiver of confidentiality.

respective ASPEC focal point listed in 4.1. Information that needs to be provided include:

- i. Application no. from first IP Office;
- ii. Desired second IP Office and application no. in the Second IP Office;
- iii. Date of request
- iv. Reliance on written opinion or written opinions; and
- v. Applicant.

Requesting PCT-ASPEC

3.6 For PCT ASPEC request, applicants should indicate that the request is for PCT ASPEC in the ASPEC form under Remarks. For AMS IP offices where submission of an ASPEC Request Form is not mandatory, a cover letter indicating the request for PCT-ASPEC with the second IP Office should be submitted. The duly completed ASPEC request form shall be submitted together with the following documents:

1. a copy of the written opinion/international preliminary examination report (“WO/ISA, WO/IPEA or IPER”) established by an ASEAN International Searching Authority/International Preliminary Examining Authority (ASEAN ISA/IPEA) (“minimum documents”) relating to a corresponding application from the first IP Office; and
2. a copy of the claims referred to in the minimum documents submitted, with at least one claim determined by the first IP Office to be allowable/patentable.

3.7 For PCT-ASPEC request, please indicate that it is a PCT-ASPEC request in the ASPEC form. In addition, applicants are also required to email the monitoring authority (aspec@ipos.gov.sg) and respective PCT-ASPEC focal point listed in 4.1. Information that needs to be provided include:

- i. PCT application no;
- ii. Desired second IP Office and application no. in the second IP Office;
- iii. Date of request; and
- iv. Applicant.

3.8 It is possible to make a PCT-ASPEC request at the second IP Office even if the second IP Office is also an ASEAN ISA/IPEA.

3.9 It is also possible to make a PCT-ASPEC request and an ASPEC AIM request simultaneously at the second IP Office. There can be a written opinion/international preliminary examination report established by an ASEAN ISA/IPEA and the patent application contains at least one IPC code that matches with the IPC codes provided in Appendix 1. Please indicate that this is a PCT-ASPEC and ASPEC AIM request in the ASPEC form.

Other information

3.10 All documents for the purposes of ASPEC must be in English. An English translation of documents submitted need not be verified by a translator or by the patent agent unless requested for by the AMS IP Office.

3.11 The ASPEC Request Form and the documents referred to in the above may be filed at any time before the final decision of grant or refusal.

3.12 Subject to the requirements of the AMS IP Office (“second IP Office”), an e-ASPEC request made on the [ASEAN IP Portal](#) may replace the need for a separate ASPEC Request Form (**Annex A**).

3.13 Mandatory requirements for filing an ASPEC application are summarized in the Table in **Annex B**. ASPEC acceleration would begin only when all requisite documents are submitted to the AMS IP Office (“second IP Office”).

3.14 A list of non-exhaustive common mistakes in making ASPEC request is also found in **Annex C**.

4 Enquiries

4.1 For further enquiries relating to the ASPEC programme in the respective countries, kindly contact the following:

Country	Email
Brunei Darussalam	nuralain.abdullah@agc.gov.bn zunaidah.ramli@agc.gov.bn yvonne.lim@agc.gov.bn muiz.ramlee@bruipo.gov.bn
Cambodia	chheanpiseth@yahoo.com rein_bbu@yahoo.com
Indonesia	miayusanti@yahoo.com.au masnugroho@yahoo.com nandie93@yahoo.com thomy_ryan@yahoo.com
Lao PDR	aphivath@yahoo.com s.solasin@gmail.com dip.laopdr@gmail.com sooraphonhkongsap@yahoo.com
Malaysia	aspec@myipo.gov.my
Philippines	aspec@ipophil.gov.ph

Singapore	aspec@ipos.gov.sg
Thailand	aspec@ipthailand.go.th s.vairaphai@gmail.com putchakan2@gmail.com toranin@gmail.com (ASPEC AIM only) napapatchai@gmail.com (PCT-ASPEC only) paphitchaya.dip@gmail.com
Viet Nam	thuha_tran@ipvietnam.gov.vn thanhnoip@gmail.com khoanguyen76@gmail.com huongdl@ipvietnam.gov.vn

ASEAN Patent Examination Co-operation (ASPEC)

Request Form

1. Name of Applicant(s) (Further applicants are to be indicated on an additional sheet)

2. Utilisation of ASPEC

Participating ASEAN Member State (AMS)	ASPEC Documents From 1 st AMS IP Office			ASPEC Documents To 2 nd AMS IP Office	
	Documents ⁷ From	Corresponding Patent Application ⁸ Number of the 1 st AMS IP Office	Priority Patent Application Number ⁹ (where applicable)	Documents To Be Used In	Patent Application Number of the 2 nd AMS IP Office (where ASPEC is requested)
Brunei Darussalam					
Cambodia					
Indonesia					
Lao PDR					
Malaysia					
The Philippines					
Singapore					
Thailand					
Viet Nam					

3. Request for PCT-ASPEC or ASPEC AIM pilot programme (Please check against the box if applicable)

- The applicant is relying on Patent Cooperation Treaty (PCT) work products¹⁰ from an ASEAN International Searching Authority/International Preliminary Examination Authority ("ISA/IPEA").
- The applicant wishes to apply for the ASPEC Acceleration for Industry 4.0 Infrastructure and Manufacturing (ASPEC AIM) pilot.

4. Remarks

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5. Name and Signature of Applicant or Agent/Attorney

Name and Signature

Date

⁷ Documents submitted should include a copy of (i) a search report, (ii) a written opinion or an examination report, and (iii) claims referred to in the written opinion or the examination report. A claim correspondence table is optional.

⁸A patent application from another ASPEC participating ASEAN country is a corresponding patent application if it is linked by a Paris Convention priority claim to the patent application of which ASPEC is requested for, and vice versa, or it shares the same priority claim with the patent application of which ASPEC is requested for, from another patent application of a Paris Convention member country.

⁹ Please indicate the patent application number which the corresponding patent application claims priority from, where applicable.

¹⁰ Written opinion of the International Search Authority (ISA), Written opinion of the International Preliminary Examining Authority (IPEA), or International Preliminary Examination Report issued within the PCT framework. An international search report should also be provided where applicable.



Mandatory requirement for making ASPEC request at AMS IP Office (“Second IP Office”)

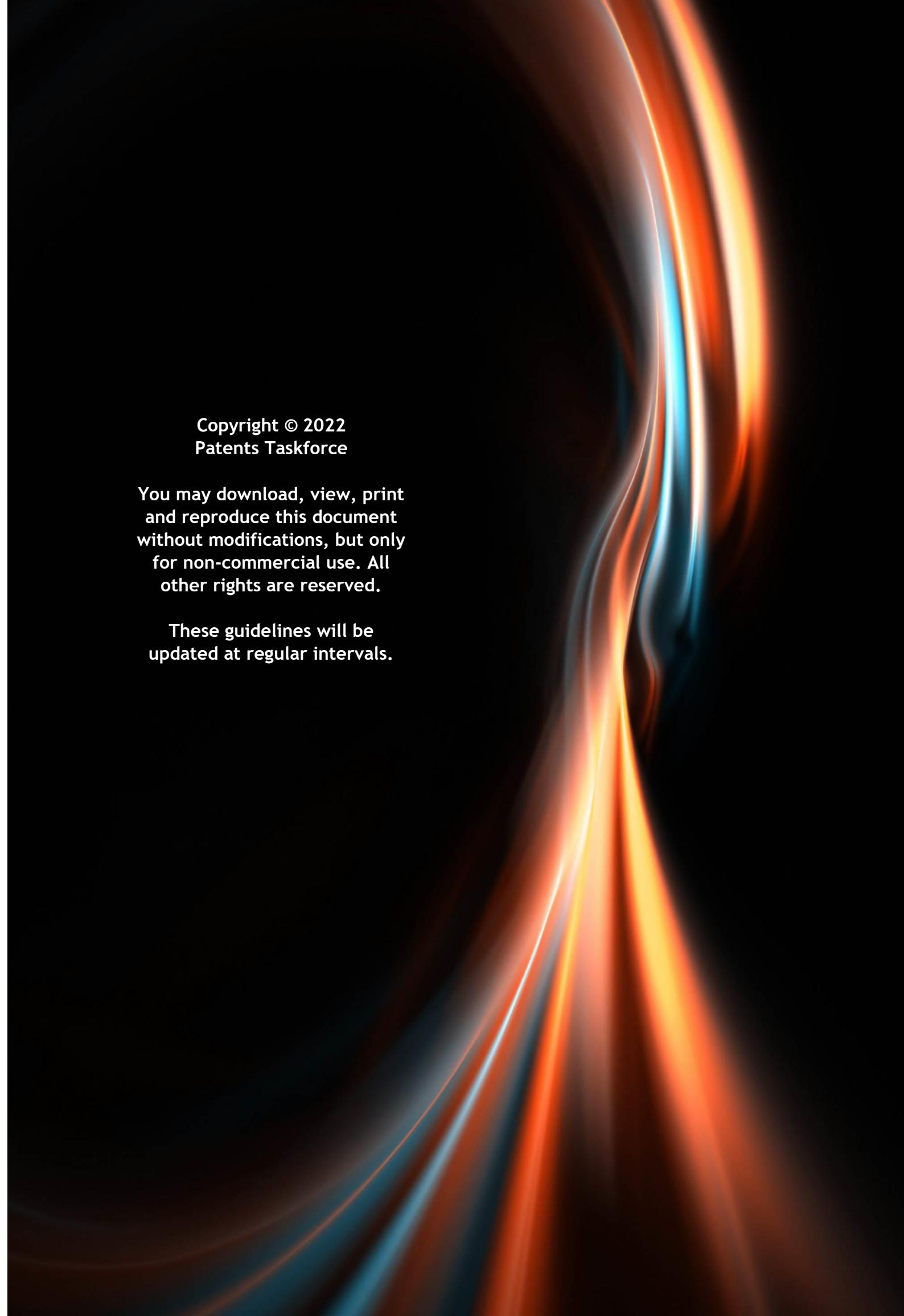
AMS (Second IP Office)	Is the usage of local registered agent mandatory for ASPEC request?	Must the Written Opinion⁴, Search and Examination or Examination report from the first AMS IP Office be enclosed for the ASPEC request to be valid?	Must a Claims Correspondence Table be enclosed for the ASPEC request to be valid?	Is a hardcopy of the ASPEC request Form Required?	Can an E-ASPEC request via ASEAN IP Portal be made?
Brunei Darussalam	Yes, must be filed by a local agent	Yes	Yes	Yes	Not at the moment
Cambodia	Yes, the ASPEC request can only be filed by the agent or representatives on behalf of the applicant in case the applicant has no local contact in Cambodia	Yes	Yes	Yes	Yes. The request should be made by local agent or representatives
Indonesia	Yes, must be filed by a local agent	Yes	Yes	Yes	Not yet
Lao PDR.	Yes	Yes	Yes	Yes	Yes. Requester must be local agent

Malaysia	<p>Yes, an ASPEC request can be filed by the agent on behalf of the applicant if the applicant has neither domicile nor residence in Malaysia.</p> <p>Nevertheless, the applicant himself can file an ASPEC request if the applicant is the national of Malaysia</p>	Yes	Yes	Yes. No indication for ASPEC/PPH request in the patents' forms	Yes, the request should be made by local agent.
Philippines	Yes	Yes	<p>No</p> <p>The basis for this is the ASPEC request form for Philippines, we have this in the footnote</p> <p>“Documents submitted should include a copy of (i) a search report, (ii) an examination report and (iii) claims referred to in the examination report.</p> <p>A claim correspondence table is optional</p>	Yes	Yes, provided that the request is filed by the local agent/representative

Singapore	Yes. Alternatively, the ASPEC request could also be made by the applicant with a valid local address for service	Yes	Yes	No. The applicant could select the ASPEC/PPH request checkbox in the Patents Form 11 or 12	Yes
Thailand	Yes, according to Ministerial Regulation No. 21 clause 13, the applicant has not domicile nor residence in Thailand shall appoint registered attorney (Who was registered by DIP Director General registration) for filling application	Yes, according to DIP Notification Re. request for utilize ASEAN Patent Search and Examination Results on substantive examination clause 3.	Yes, according to DIP Notification Re. request for utilize ASEAN Patent Search and Examination Result on substantive examination clause 2	Yes, according to DIP Notification Re. request for utilize ASEAN Patent Search and Examination Results on substantive examination clause 2	No, because every e-filing system shall comply with Regulation and Method of Government Electronic Transactions Decree
Viet Nam	Yes. The ASPEC request could also be filed applicants themselves if there is no patent agent on behalf of them	Yes	Yes	No	Yes. But the request must be filed by a patent agent or applicants themselves if there is no patent agent on behalf of them

Common mistakes in making ASPEC request

1. ASPEC requests were filed with patent granted by the first IP Office, but without S&E reports; or
2. ASPEC requests were filed with modified examination report from a non-AMS office and without S&E report made by the first IP Office; or
3. ASPEC requests were filed with PCT S&E report, but without S&E report made by the first IP Office; or
4. ASPEC requests were filed without S&E report; or
5. ASPEC requests were filed with search report, but without examination report (including citations and patentability analysis).



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