



PATENT PROSECUTION HIGHWAY (PPH) A PILOT PROGRAM BETWEEN JPO AND VIETNAM'S NOIP

Overview

In the ASEAN region, Vietnam will be the sixth country that have concluded a PPH with JPO, following Singapore, Philippines, Indonesia, Thailand, and Malaysia, on the basis of bilateral office agreements dated October 2015.

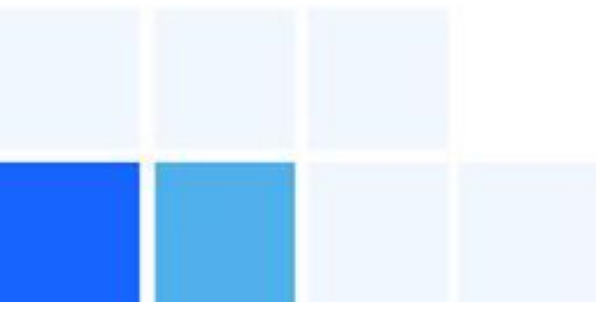
The PPH Pilot Program thereby will be launch on April 1, 2016 and initially, there will be a trial of 100 patent applications to test it out.

The PPH is a framework whereby a patent application whose claims have been determined to be patentable by the Office of First Filing (OFF) (an earlier examination), through a simple procedure upon request from an applicant, to undergo an accelerated examination in the Office of Second Filing (OSF). In other words, through PPH, an applicant with a corresponding Japan patent may speed up examination after it is submitted to NOIP.

Although there are two accelerated examination systems in Vietnam, including the NOIP's faster examination system and the new ASPEC system for ASEAN's jurisdiction, they have not been widely used. The reasons derived from such systems is still dependent on the NOIPs discretion and interest to speed a particular patent up; besides, the ASPEC system has only actually worked with corresponding patent application in Singapore. Therefore, with PPH, it is hopefully that will improve the current situation.

Purpose of the PPH

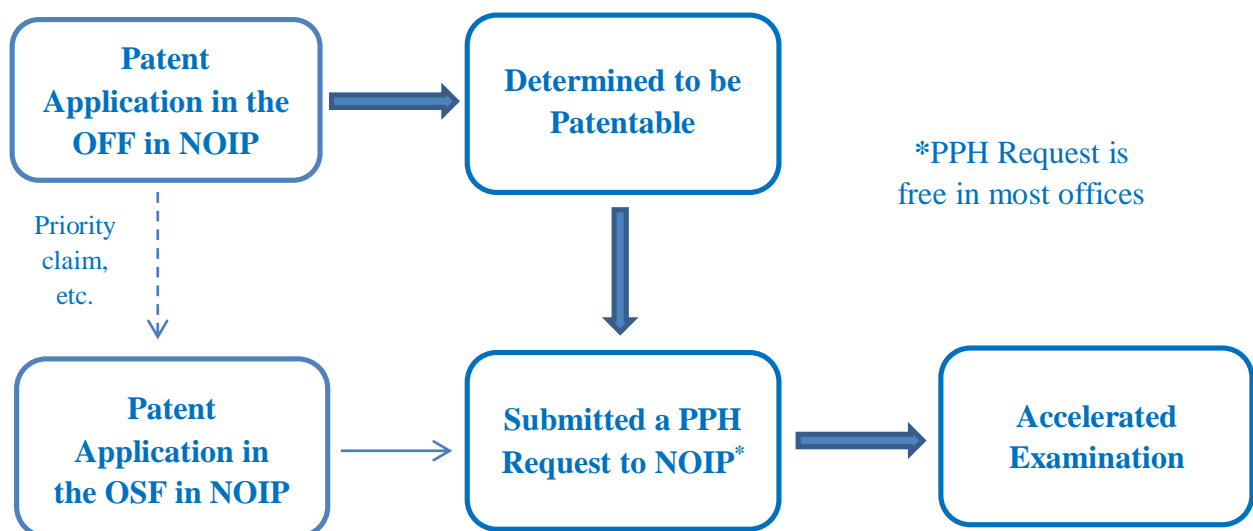
Through the PPH system, both National IP Offices desire to ensure that the high-quality patent protection, effective and inexpensive examination procedure will be applied and integrated with the patent prosecution highway programs in other jurisdictions, as Global PPH and IP5 Pilot Programs.



In particular, the purpose of the PPH is to enhance the utilization of the prior art search and examination results between two IP Offices, then to reduce the burden of examination.

Simultaneously, in Vietnam, the cooperation between PPH and ASPEC would not only improve its examination ability, but also promote a more expeditious and inexpensive patent protection process where workloads and unnecessary duplication of works are reduced significantly.

PPH Pilot Program's Outline

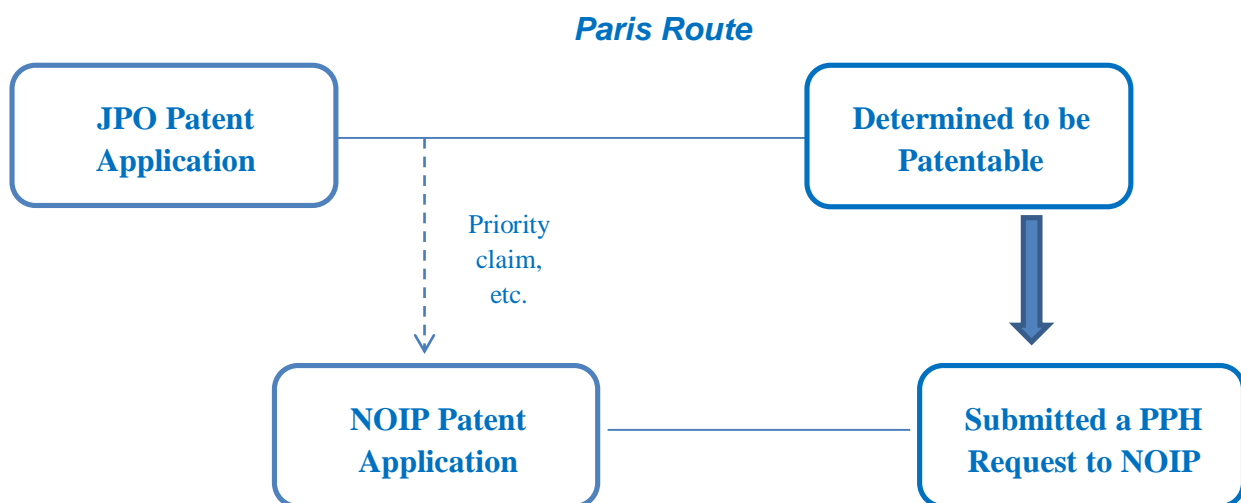


Requirements & Example scenario for PPH

Applications that are eligible to request for PPH are applications, which have not undergone substantive examination and filed to NOIP with a corresponding with JPO, for example:

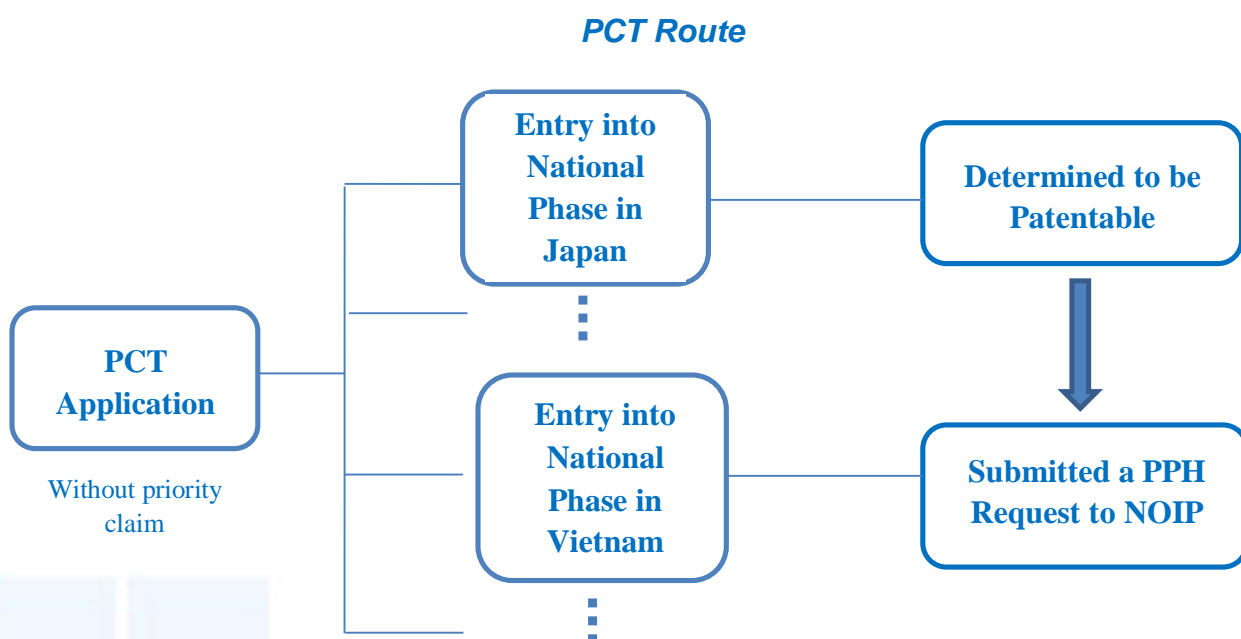
- The application validly claims priority under the Paris Convention to the corresponding JPO application(s);

Example scenario 1:



- The application is a PCT national phase application without priority claim (direct PCT application);

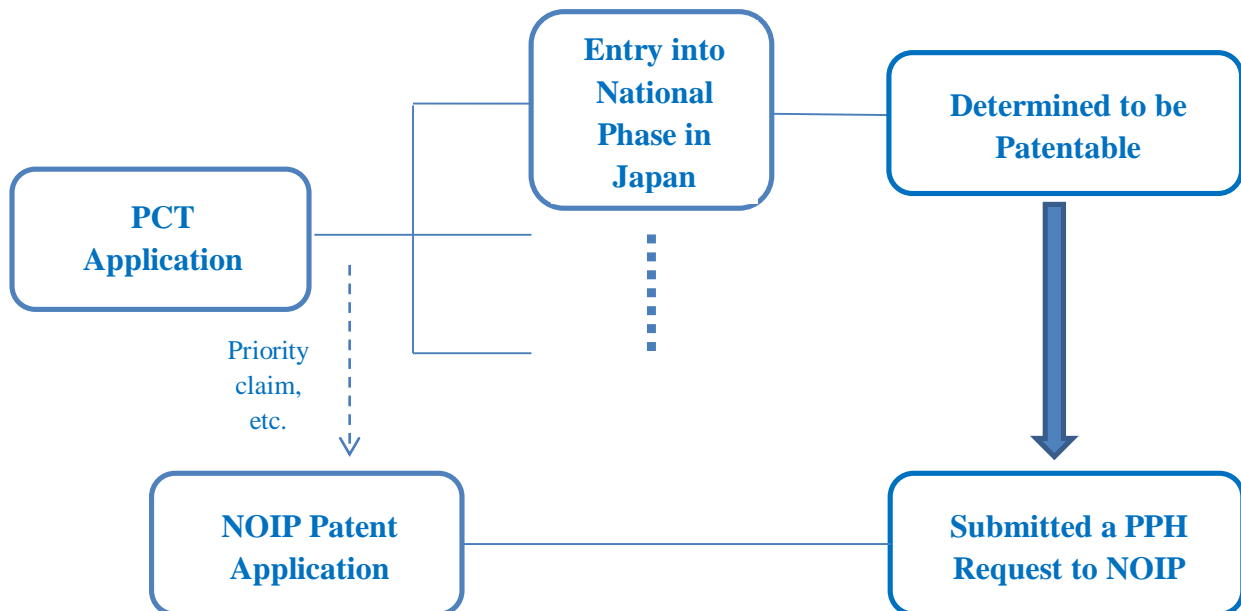
Example scenario 2:



- The application validly claims priority under the Paris Convention to the PCT application(s) without priority claim.

Example scenario 3:

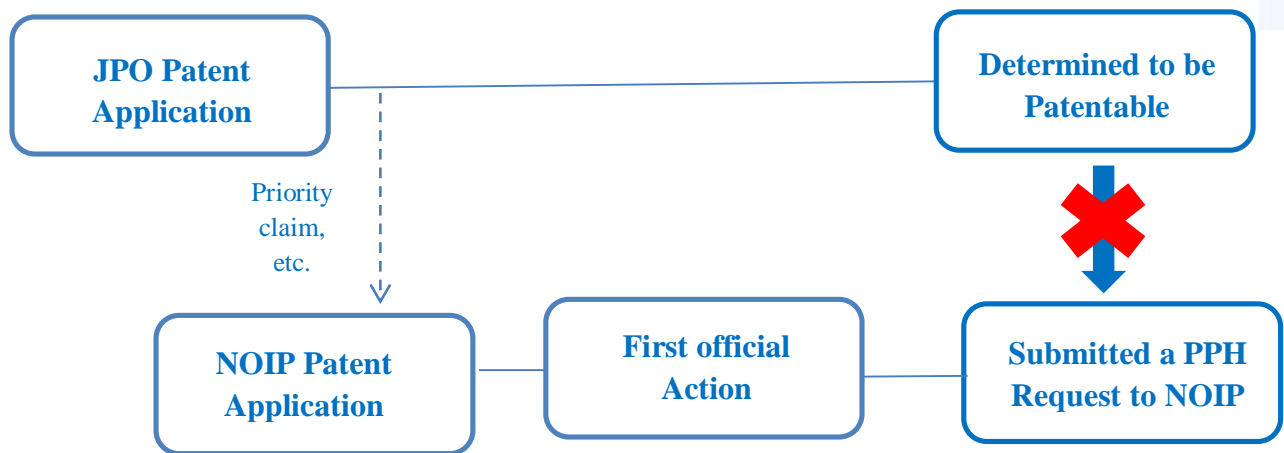
Direct PCT & Paris Route



- The applications shall also be determined as patentable, where at least one corresponding application must exist in the JPO and must have one or more claims that are determined to be allowable/ patentable in the latest office action by JPO.
- Furthermore, 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 JPO.

- NOIP has not begun examination of the application at the time of request for the PPH

Example scenario 4:



Required Documents

Along with a PPH Request Form, the following documents are required to be submitted as below:

- (i) A copy of all claims determined to be patentable by the JPO, and translations thereof (not required if these are available via the JPO dossier access system);
- (ii) A copy of all office actions of the JPO, and translations thereof (not required if available via the JPO dossier access system);
- (iii) Copies of all documents cited by the JPO examiner; and
- (iv) Claims correspondence table, listing all claims filed to NOIP and JPO with comments in terms how they correspond to each other.

Comparison between PCT, PPH & ASPEC

	PCT	PPH*	ASPEC
S & E Report	S&E by examiners at the NOIP; ISA; IPEA	S&E Report from the Office of first filing (bilateral agreement)	S&E Report(s) from any participating IP Office (multi-agreement)
Quality of S & E Report	A lot of limited and shortcomings	Improved quality since the references help examiners to develop their search criteria or strategy more quickly, reducing searching and/or assist they to understand the claimed invention faster	Improved quality since the references help examiners to develop their search criteria or strategy more quickly, reducing searching and/or assist they to understand the claimed invention faster
Expedited Examination	Up to 18 months	Expedited examination of PPH applications – advanced out of turn	Expedited S&E work as an IP Office can refer to the S&E work of another participating IP Office – advanced out of turn until grant
First Office Action (OA)	1.5 – 2 years	6 months	6 months
Grant Certificate	3 – 4 years	Grant certificate will be processed and issued faster than normal	Grant certificate will be processed and issued in shortened within the normal timeframe

	PCT	PPH*	ASPEC
Examination request term	Examination request shall be submitted within 42 months counted from the filing date or the date of priority	PPH request is required to be filed at a specific point in time	ASPEC request can be filed at any time before a final determination of grant or refusal
Language	Vietnamese	English	English

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FAQS

WHAT

What is PPH?

The PPH is a framework whereby a patent application whose claims have been determined to be patentable by the Office of First Filing, through a simple procedure upon request from an applicant, to undergo an accelerated examination in the Office of Second Filing.

What is the PPH between JPO and Vietnam's NOIP?

The PPH Pilot Program between JPO and the NOIP is on the basis of bilateral office agreements dated October 2015 and will be launch on April 1, 2016. Initially, there will be a trial of 100 patents to test it out.

HOW

How PPH is useful?

Through the PPH system, it is desired to ensure that the high-quality patent protection, effective examination procedure will be applied and integrated with the PPH programs in other jurisdictions; as well as to promote a more expeditious and inexpensive process where workloads

and unnecessary duplication of works are reduced significantly.

How do I enter PPH at the NOIP?

In order to file a PPH request at the NOIP, you must meet all the criteria (see Required Documents above) along with a PPH Request Form.

How much does it cost for submitting a PPH request?

Normally, a PPH request does not cost anything. Currently, only the Korean patent office charges a handling fee.

How much time can be saved with PPH request filed at the NOIP?

The PPH request is generally decided within 04 months from the filling of the PPH request. If the PPH request is granted, the examiner will generally examine the application within 02 – 03 months from the grant of the PPH request. Therefore, it will take about 06 – 08 months for completing all its pre-exam processing and is ready for examination.

WHICH

Which languages could the documents to be submitted in the NOIP?

Either Vietnamese or English is acceptable for submitting in the NOIP

as translation language. Aside from, the JPO and the NOIP have decided to begin the exchange of data on patent information. Based on this information, the JPO will make an advance research on machine translation, which will lead to improvements in the accuracy of Japanese-Vietnamese machine translation.

WHEN

When can I file a PPH request?

A PPH request could be filed at any time during an application procedure. If there are allowable claims in your priority application, a PPH can be filed at the filing date of second application. Normally, a PPH should be filed before the IP Office has started its examination.

CAN

Can a application be surely granted without examination if an application is recognized as eligible for the PPH?

No. Substantive examination under the PPH is still conducted according to the Vietnamese law in the same way as non-PPH application. However, with PPH, the application will be considered in the higher allowance rates, fewer office actions and reduced appeal rates than non-PPH application.

