

# **Procedures to File a Request to the African Regional Intellectual Property Organization (ARIPO) for Participation in the Patent Prosecution Highway Pilot Program between ARIPO and China National Intellectual Property Administration (CNIPA)**

## **1. Background**

The Patent Prosecution Highway (PPH) Pilot Program (hereinafter referred to as “the Program”) was agreed upon between the African Regional Intellectual Property Organization (ARIPO) and the China National Intellectual Property Administration (CNIPA) in a “Joint Statement of Intent for Cooperation in the Field of Patent Prosecution Highway (PPH)” signed in Geneva on 2<sup>nd</sup> October, 2017 by the representatives of the two Offices.

The aim of the Program is to enable an application whose claim(s) have been determined to be patentable by the CNIPA as Office of Earlier Examination (OEE) to undergo an accelerated examination at the ARIPO as Office of Later Examination (OLE) upon request from an applicant, provided that the requirements set forth are fulfilled.

This document is intended to define in detail the necessary procedures and requirements for requesting accelerated examination under the Program between ARIPO and CNIPA.

The Program shall become effective on 8<sup>th</sup> June 2024 for a trial period of five (5) years. The pilot period may be extended by ARIPO and CNIPA if deemed necessary. The Program may be terminated upon 90 days written notice without cause or penalty by either party. Termination of the Program shall be published.

## **2. Request to ARIPO**

An applicant has to file a request for accelerated examination under the Program to ARIPO in English language by submitting a request form (i.e. Request for accelerated examination under the Program - Form 13B) accompanied by all relevant supporting documents. This form is available for download from the ARIPO website.

The request for accelerated examination under the Program must also be accompanied by, or preceded by, a request for substantive examination.

ARIPO will treat a request for accelerated examination under the Program as a request for expedited/accelerated examination under the Harare Protocol. Examination of ARIPO

patent applications that satisfy the requirements for accelerated examination under the Program will take into account the work performed previously by the CNIPA.

The ARIPO patent applications under the Program will be examined in accordance with the Harare Protocol and the Implementing Regulation as well as the Guidelines for Examination at ARIPO.

## **Part I**

### **PPH using the national work products from the CNIPA**

#### **1. Requirements for requesting accelerated examination under the Program at ARIPO**

In order for the application to be eligible for requesting accelerated examination under the Program at ARIPO, the following requirements shall be fulfilled:

- (a) Both the ARIPO application(s) for which the request under the Program is made and the CNIPA application(s) forming the basis of the Program request shall be corresponding applications having the same earliest date (whether this be a priority date or a filing date)**

The applicant shall submit the necessary information to determine the relationship between the application(s) on which the accelerated examination under the Program is requested and corresponding application(s) filed with CNIPA.

The expression “corresponding applications” should not be necessarily construed as referring to the application on which a priority claim is based, but it could refer to the application derived from the application on which priority is claimed. For instance, a divisional application of the application or an application claiming national priority of the application on which priority is claimed.

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

- Case I:** an application which validly claims priority under the Paris Convention from the CNIPA application(s) (examples are provided in Annex I, figures A, B, G and H),

or

**Case II:** an application which provides the basis of a valid priority claim under the Paris Convention for the CNIPA application(s) (including PCT national phase application(s)) (examples are provided in Annex I, figures C and D),

or

**Case III:** an application which shares a common priority document with the CNIPA application(s) (including PCT national phase application(s)) (examples are provided in Annex I, figures E, F, I, J, K and L),

or

**Case IV:** a PCT national phase application where both the ARIPO application and the CNIPA application(s) are derived from a common PCT international application having no priority claim (example is provided in Annex I, figure M).

**(b) At least one corresponding CNIPA application has one or more claims that have been determined to be patentable by the CNIPA**

Claims are "determined to be allowable/patentable" when the CNIPA examiner explicitly identified the claims to be allowable/patentable in the latest office action, even if a patent has not yet been granted in respect of this application.

Office actions mentioned above are:

- i) Decision to Grant a Patent;
- ii) First/Second/Third/...Office action;
- iii) Decision of Refusal;
- iv) Re-examination Decision;
- v) Invalidation Decision.

Claims are also "determined to be patentable" in the following circumstance: If the CNIPA office action does not clearly state that a particular claim is patentable, the applicant must include an explanation accompanying the request for participation in the PPH pilot program that no rejection has been made in the CNIPA office action regarding that claim, and therefore, the claim is deemed to be patentable by the CNIPA.

**(c) All claims in the ARIPO application, as originally filed or as amended, must sufficiently correspond to one or more of those claims indicated as allowable(patentable) by the CNIPA**

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the ARIPO Application are of the same or similar scope as the claims in the CNIPA application, or the claims in the ARIPO application are narrower in scope than the claims in the CNIPA application (examples are provided in Annex III, Table I).

Claim(s) are of the same scope if the claims in the ARIPO application present the same technical features as the claims in the CNIPA application, which have made the claims allowable over prior art in the corresponding CNIPA application.

Claim(s) are of the narrower scope if the CNIPA claim is amended to further limitation by an additional feature that is supported in the specification (description and/or claims).

A claim in the ARIPO application which introduces a new/different category of claims to those claims indicated as allowable by the CNIPA is not considered to sufficiently correspond. For example, where the CNIPA claims only contain claims to a process of manufacturing a product, then the claims in the ARIPO application are not considered to sufficiently correspond if the ARIPO claims introduce product claims that are dependent on the corresponding process claims (examples are provided in the Annex III, Table II).

**(d) The ARIPO application must have been published**

Before, or at the time of filing request under the program, the ARIPO application should have been published in the ARIPO Journal.

**(e) The ARIPO application must have entered into substantive examination**

Before, or at the time of filing the request under the Program, the ARIPO application should have met formality requirement (Form 13) and the applicant should have requested for substantive examination (Form 13A).

Note that the applicant may file a request under the Program simultaneously with the request for substantive examination.

**(f) ARIPO has not begun substantive examination of the application yet**

At the time of filing a request under the program, ARIPO should have not begun substantive examination of the application yet. This means that ARIPO has not yet sent a first office action to the applicant.

**2. Required documents for requesting accelerated examination under the PPH pilot program at ARIPO**

The request for accelerated examination under the Program to ARIPO shall include the following documents:

**(a) Copies of all office actions relevant to substantive examination which were issued for the corresponding application by CNIPA, and their translations**

Only English is acceptable as translation language. If it is impossible for the examiner to understand the translated office action due to insufficient translation, the examiner can request the applicant to resubmit translation.

**(b) Copies of all claims found to be patentable/allowable by the CNIPA, and their translations**

Only English is acceptable as translation language. If it is impossible for the examiner to understand the translated claims, the examiner can request the applicant to resubmit translations.

**(c) Copies of references cited by CNIPA examiner**

The documents to be submitted are those cited in the above-mentioned office actions. Documents which are only referred to as references and consequently do not constitute reason for refusal do not have to be submitted.

If the references are patent documents, the applicant does not have to submit them. When the ARIPO 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. If it is not possible for the ARIPO examiner to understand the reference, the applicant may be notified and requested to provide the necessary translation.

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

**(d) Claim(s) Correspondence Table**

The applicant requesting the accelerated examination under the Program at ARIPO must submit a claim corresponding table showing how all claims in the ARIPO application sufficiently correspond to the patentable/allowable claims in the CNIPA application.

When claims are just literally translated, the applicant can just indicate that "they are the same" in the table. When claims are not just literally translated, the applicant is allowed to explain the sufficient correspondence of each claim based on the criteria under paragraph (1c).

**3. Procedure for requesting accelerated examination under the Program at ARIPO**

The applicant files a request for accelerated examination under the Program to ARIPO (Form 13B), including all relevant supporting documents.

If the application meets the requirements for accelerated examination under the Program, ARIPO will conduct an accelerated examination.

If the application does not meet the requirements for accelerated examination under the Program, the applicant will be notified and the defect(s) in the request will be identified. The applicant may be given opportunity, to correct specified defect(s) and resubmit the request. If the re-submitted request is still not qualified, the applicant will be notified and application will be processed under the standard ARIPO examination procedure, without acceleration.

**4. Example of Request for accelerated examination under the Program**

**(a) Circumstances**

When an applicant files a request for accelerated examination under the Program to ARIPO, the applicant must submit a request Form (i.e. Form 13B).

The applicant must indicate that the application is included in cases (I) to (IV) of paragraph 1(a), and that accelerated examination is requested under the Program. The

application number, publication number, or a patent number of the corresponding ARIPO application(s) must also be indicated.

Where the application with one or more claims determined to be patentable/allowable is different from the ARIPO application(s) included in cases (I) to (IV) of paragraph 1(a) (for example, the divisional application of the basic application), the application number, publication number, or a patent number of the application(s) which has claims determined to be patentable/allowable and the relationship between those applications must also be explained.

**(b) Documents to be submitted**

The applicant requesting the accelerated examination under the Program must list all required documents mentioned in item 4 above in an identifiable way, even when the applicant is exempted from submitting certain documents.

**(c) Claim correspondence**

The applicant requesting the accelerated examination under the Program must indicate in the Form (i.e. Form 13B) how all claims in the ARIPO application sufficiently correspond to the patentable/allowable claims in the CNIPA application.

## Part II

### PPH using the PCT international work products from the CNIPA

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the ARIPO and satisfies the following requirements under the ARIPO-CNIPA 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 (i.e. Request for accelerated examination under the Program - Form 13B) to the ARIPO.

#### **1. Requirements**

The application which is filed with the ARIPO 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 step and industrial applicability).**

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the CNIPA, but, if priority is claimed, the priority claim can be to an application in any Office, see example A’ in Annex II (application ZZ can be any national application). The applicant cannot file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

- (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 to be patentable/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 of the application are of the same or similar scope as the claims indicated to be patentable/allowable in the latest international work product, or the claims of the application are narrower in scope than the claims indicated to be patentable/allowable in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated to be patentable/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) of the application.

A claim of the application which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the latest international work product is not considered to sufficiently correspond. For example, if the claims indicated to be patentable/allowable in the latest international work product only contain claims to a process of manufacturing a product, then the claims of the application are not considered to sufficiently correspond if the claims of the application 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) ARIPO has not begun examination of the application at the time of request for the PCT-PPH.**

## **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 be submitted in certain cases.

**(1) A copy of the latest international work product which indicated the claims to be patentable/allowable and their English translations.**

If the copy of the latest international work product and the copy of the translation are available via “PATENTSCOPE (registered trademark)”<sup>1</sup>, an applicant need not submit these documents, unless otherwise requested by the ARIPO.

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

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

**(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 English translations.**

If the copy of the set of claims which are indicated to be patentable/allowable is available via “PATENTSCOPE (registered trademark)”<sup>2</sup>, an applicant need not submit this document unless otherwise requested by the ARIPO.

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

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

If the reference is a patent document, the applicant is not required to submit it. In case the ARIPO 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.

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<sup>1</sup><http://www.wipo.int/pctdb/en/index.jsp>

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

When an applicant has already submitted the above mentioned documents (1) - (3) to ARIPO through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

#### **(4) Claim correspondence**

The applicant requesting PCT-PPH must indicate in the request form (i.e. Request for accelerated examination under the Program - Form 13B) how all claims in the ARIPO application sufficiently correspond to the patentable/allowable claims in the latest international work product.

When claims are just literal translations of each other, the applicant can just enter “they are the same” in the table. When claims are not just literal translations, it is necessary to explain the sufficient correspondence of each claim based on the criteria 1.(3).

### **3. Procedure for the accelerated examination under the PCT-PPH pilot program**

The applicant files a request for accelerated examination under the PCT-PPH pilot program to the ARIPO, including the relevant supporting documents and a completed request form.

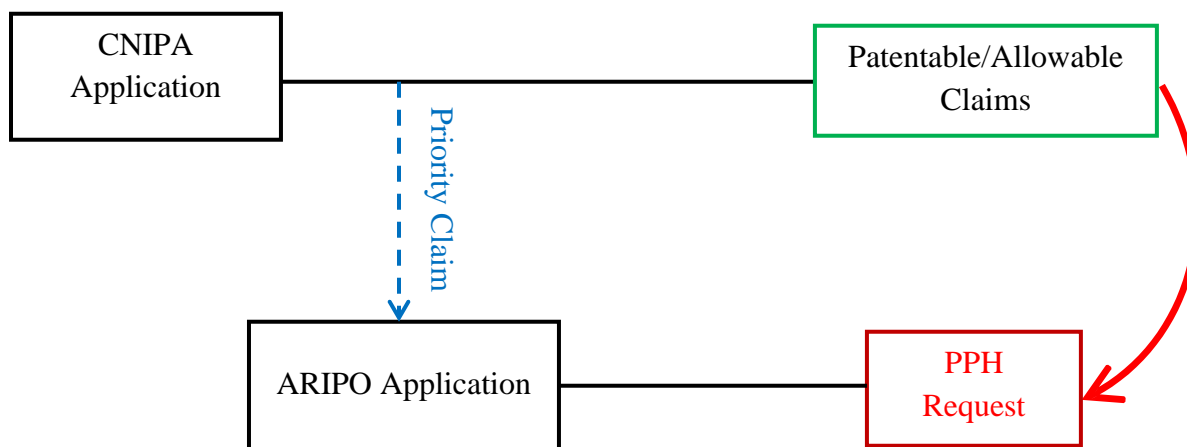
The ARIPO decides whether the application can be entitled to the status for an accelerated examination under the PCT-PPH when it receives a request with the documents stated above. When the ARIPO decides that the request is acceptable, the application is assigned a special status for an accelerated examination 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. The applicant will be given opportunity to correct certain specified defects. If the resubmitted request is still not approved, the applicant will be notified and the application will await action in its regular turn.

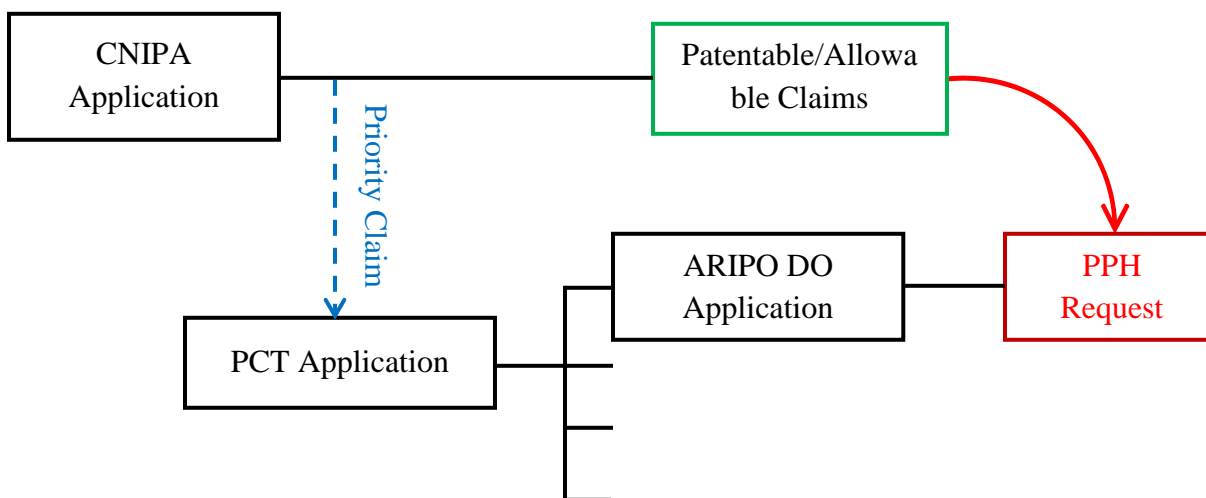
**ANNEX I**

**The following Figures Show the Examples of CNIPA Patent Applications for which Accelerated Examination can be requested under the PPH Pilot Program at the ARIPO.**

**Figure A: Paris Route**

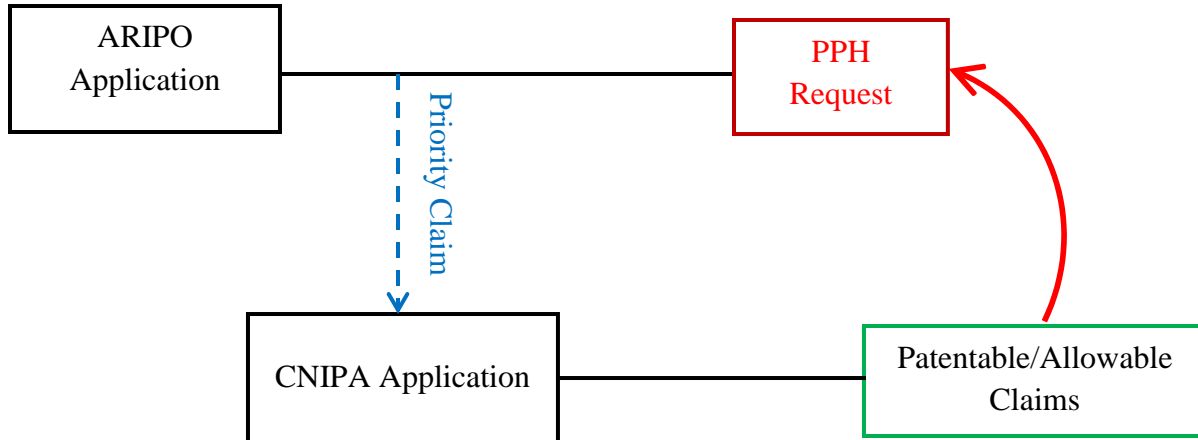


**Figure B: PCT Route**

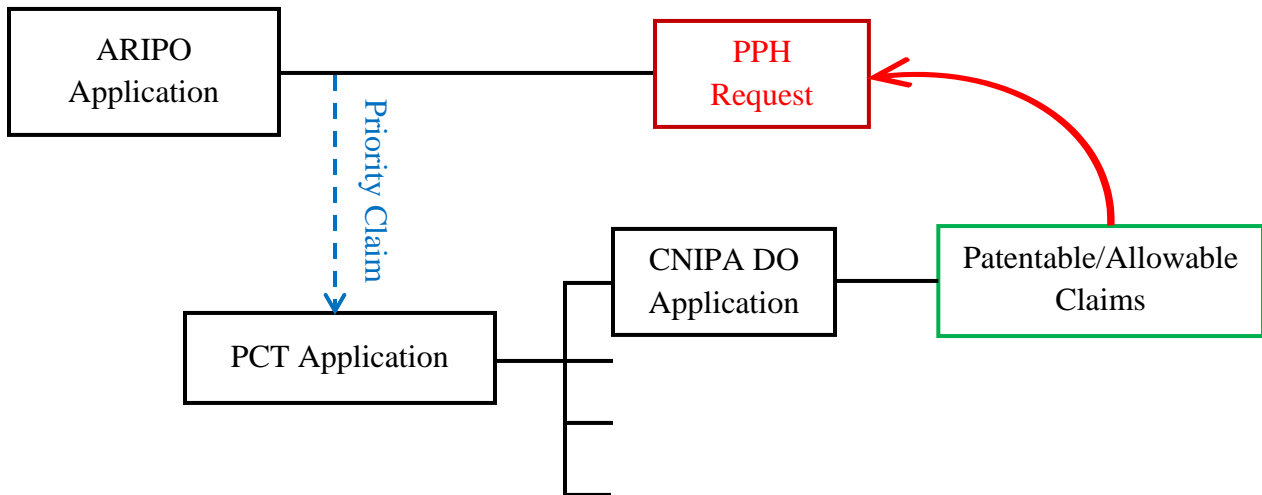


Note: DO is Designated Office.

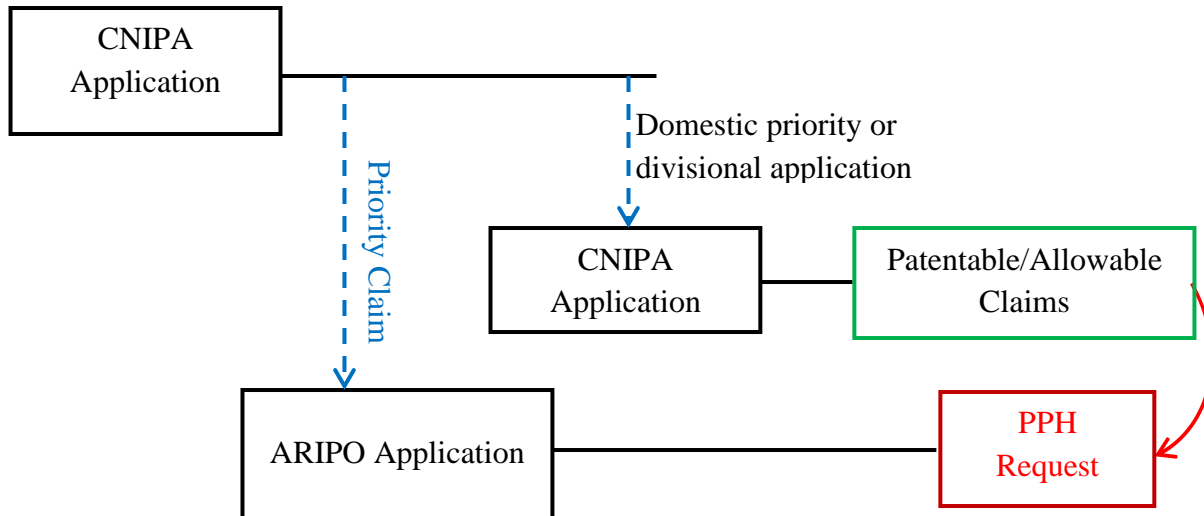
**Figure C: Paris Route**



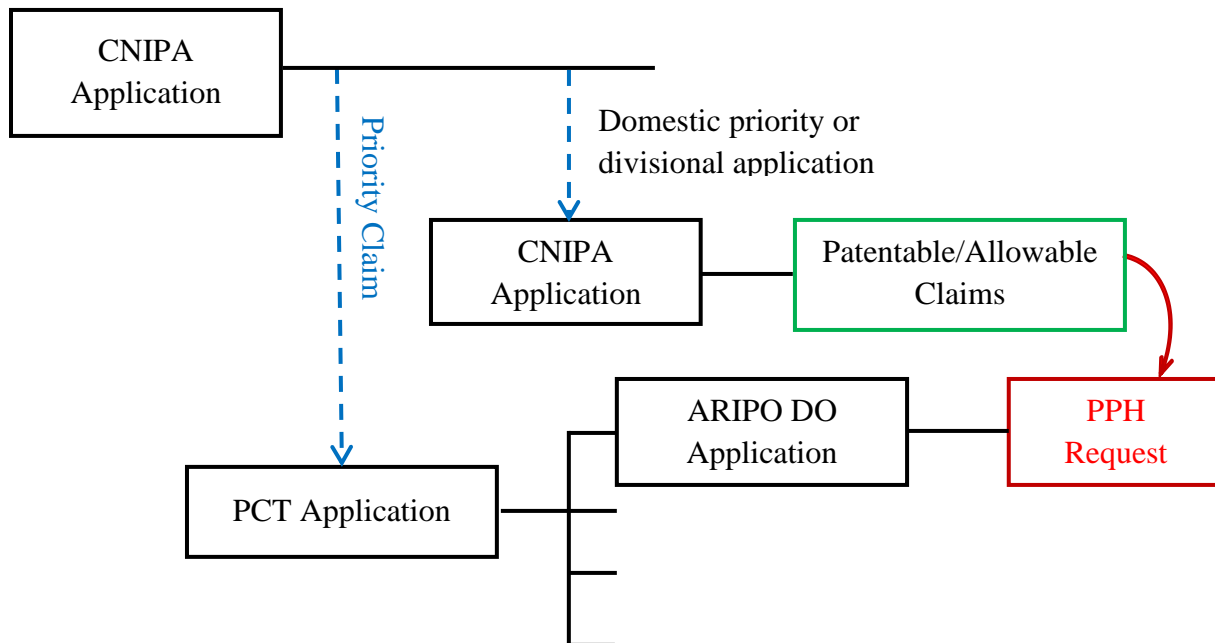
**Figure D: PCT Route**



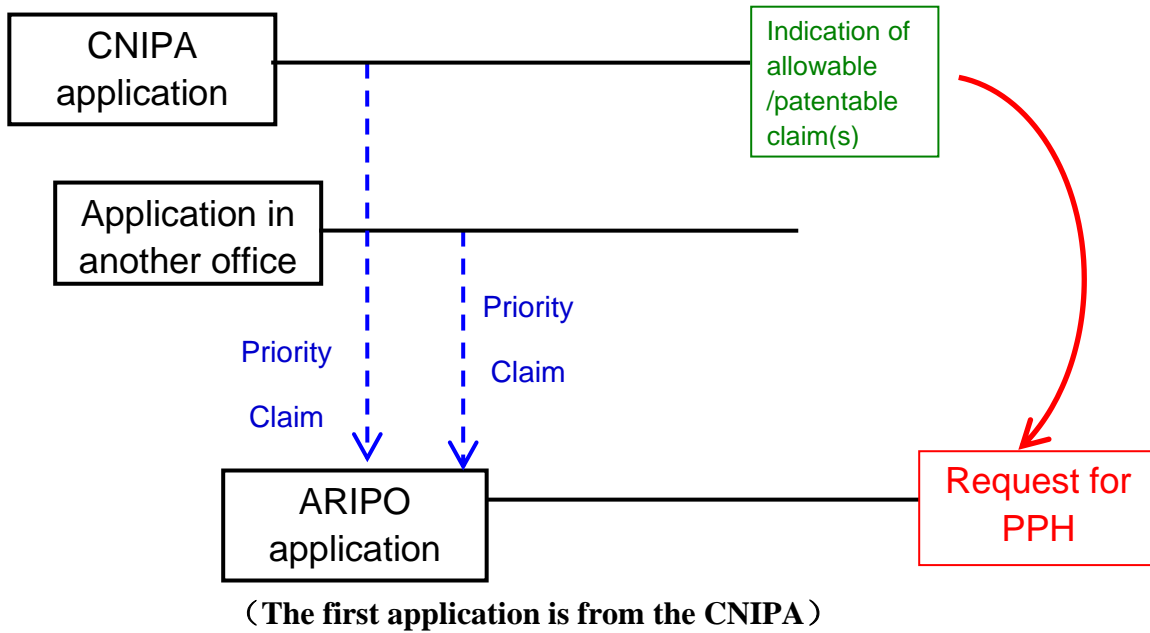
**Figure E: Paris Route & Domestic Priority or Divisional Application**



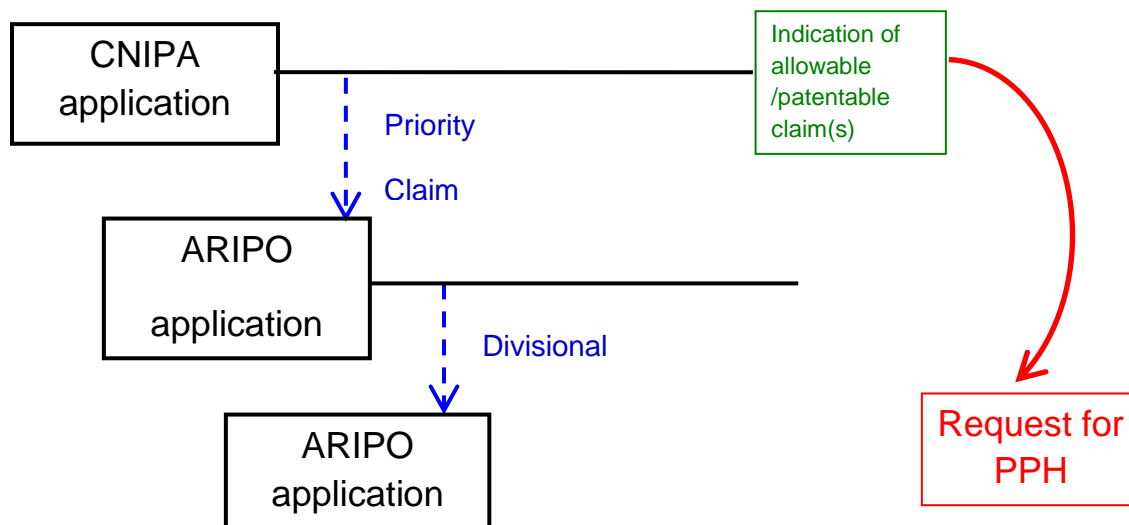
**Figure F: PCT Route & Domestic Priority or Divisional Application**



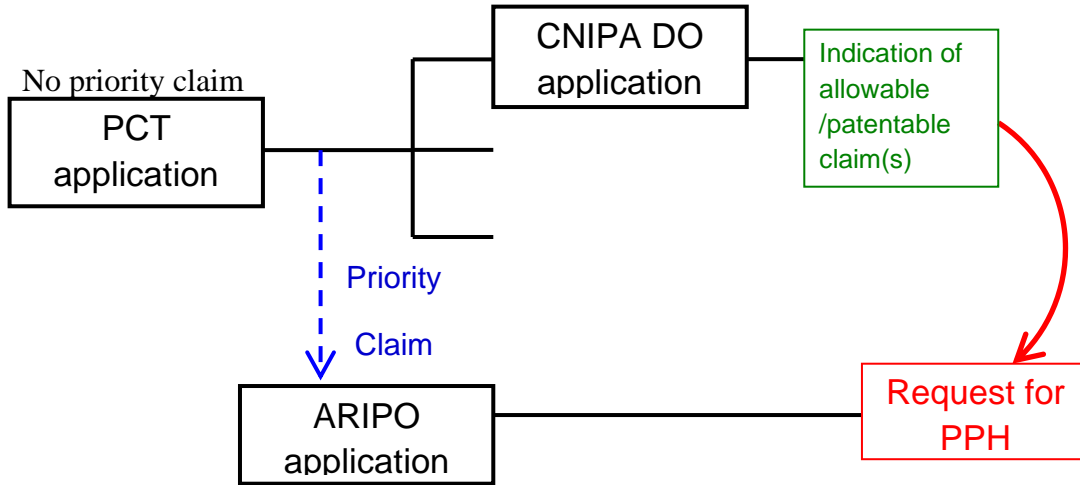
**Figure G : Paris Route & Complex Priority**



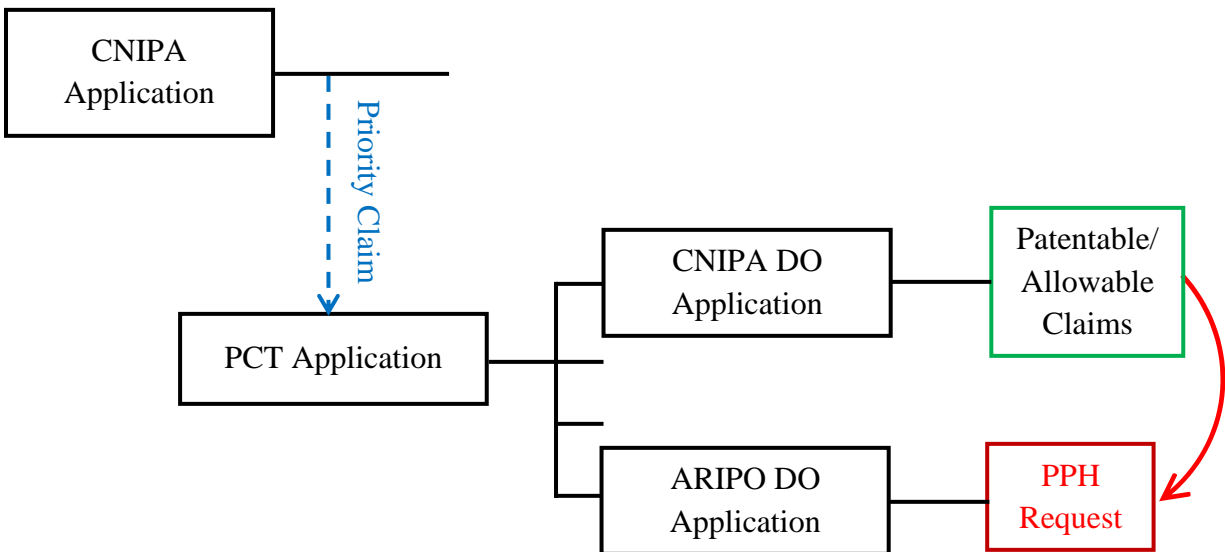
**Figure H : Paris Route & Divisional Application**



**Figure I: Direct PCT & Paris Route**

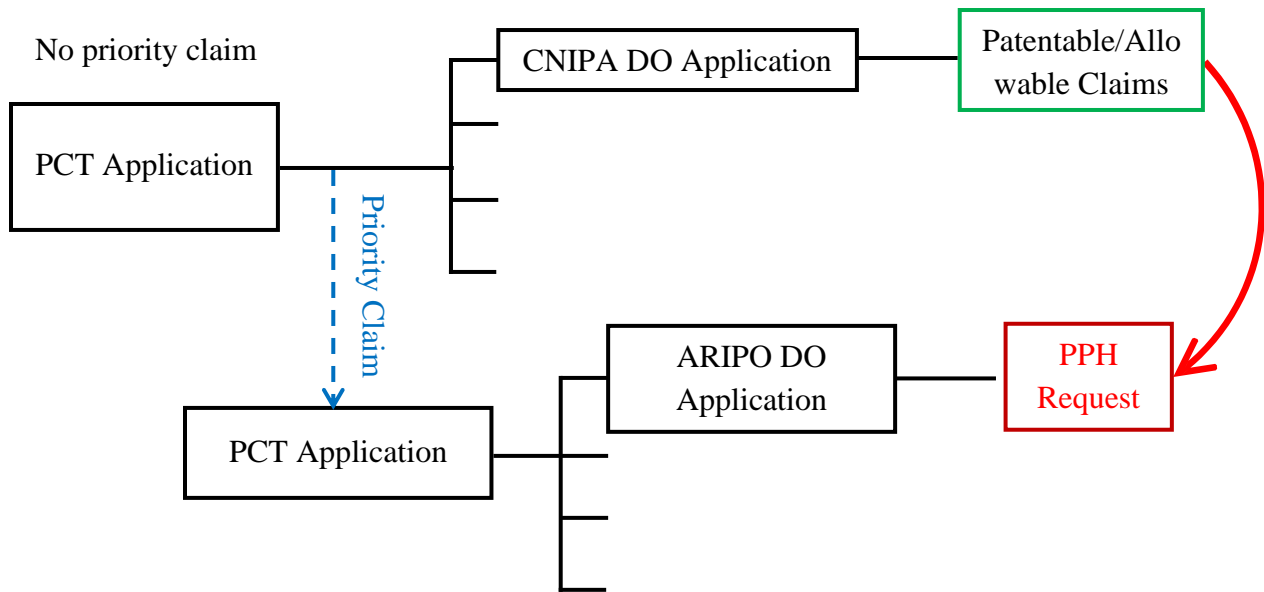


**Figure J: PCT Route**

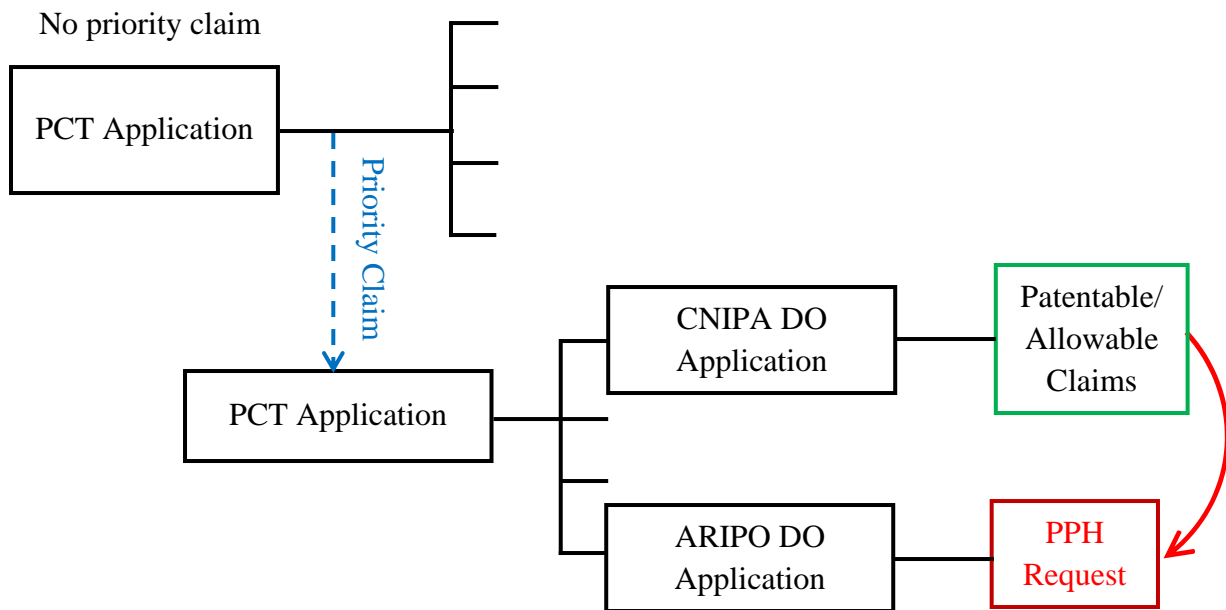




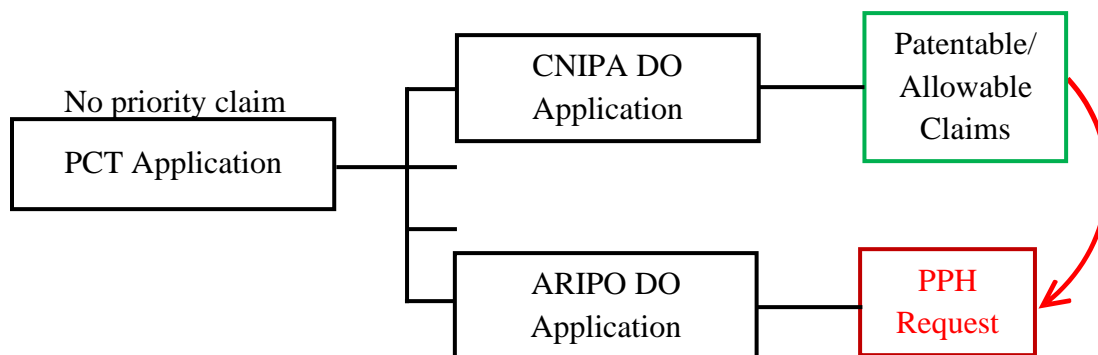
**Figure K: Direct PCT Route & PCT Route**



**Figure L: Direct PCT Route & PCT Route**

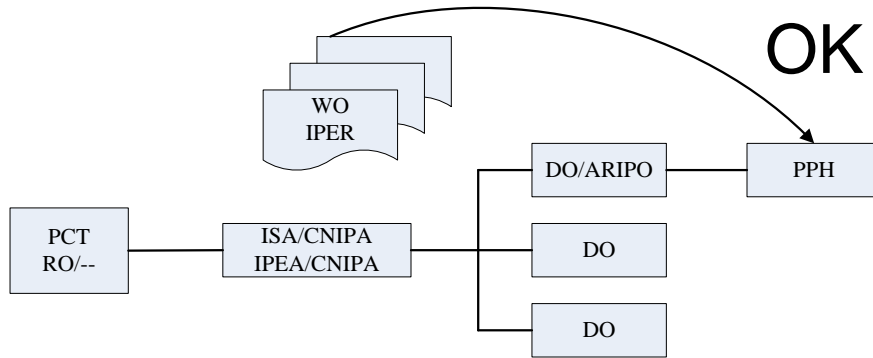


**Figure M: Direct PCT Route**

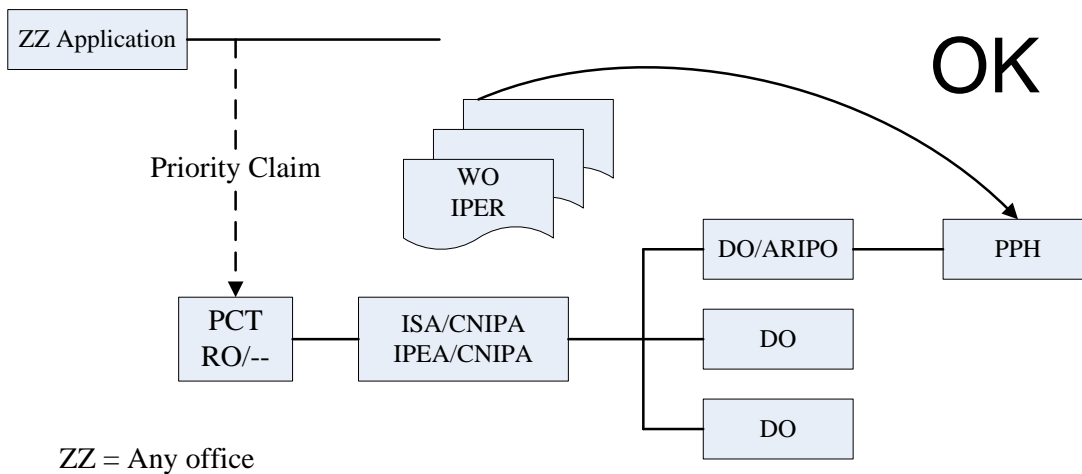


## ANNEX II

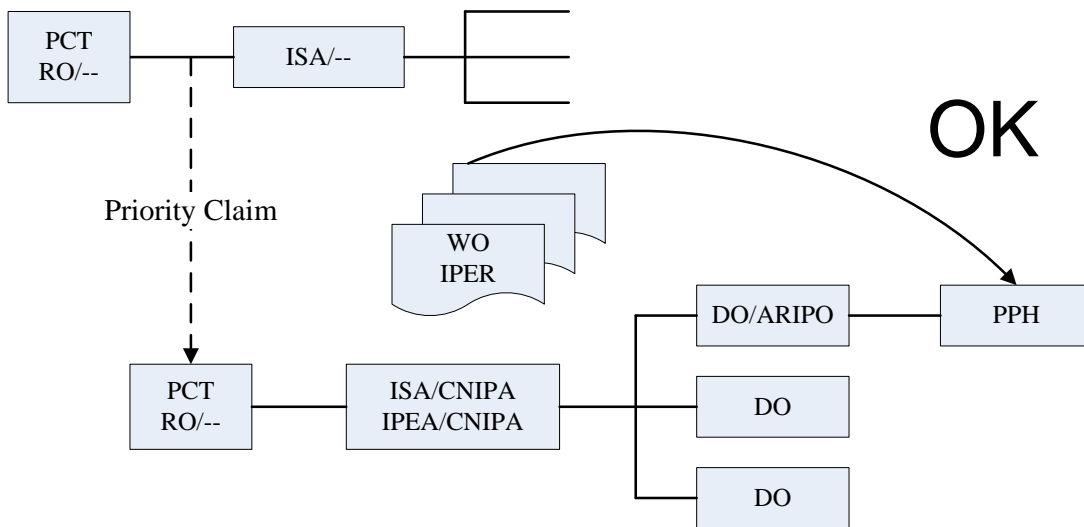
**(A) The application is a national phase application of the corresponding international application.**



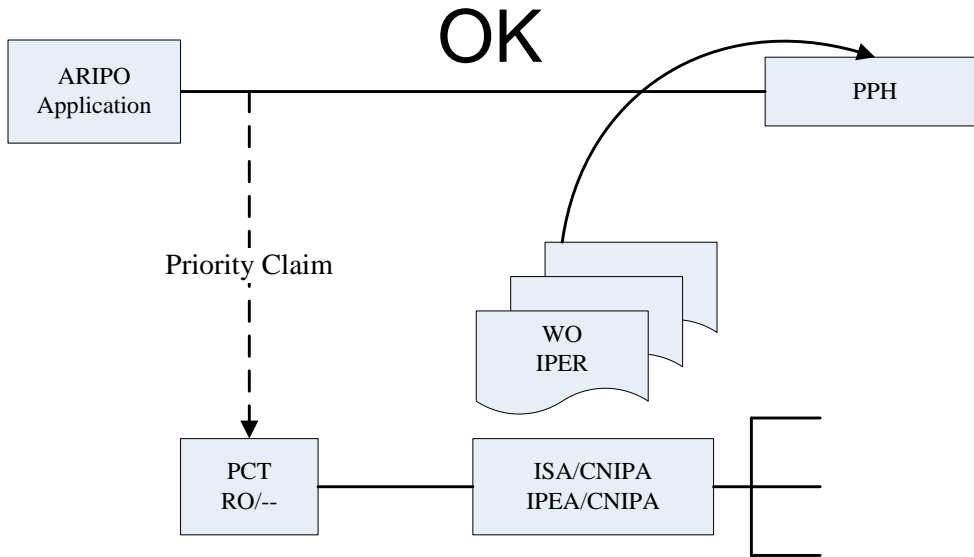
**(A') The application is a national phase application of the corresponding international application.  
(The corresponding international application claims priority from a national application.)**



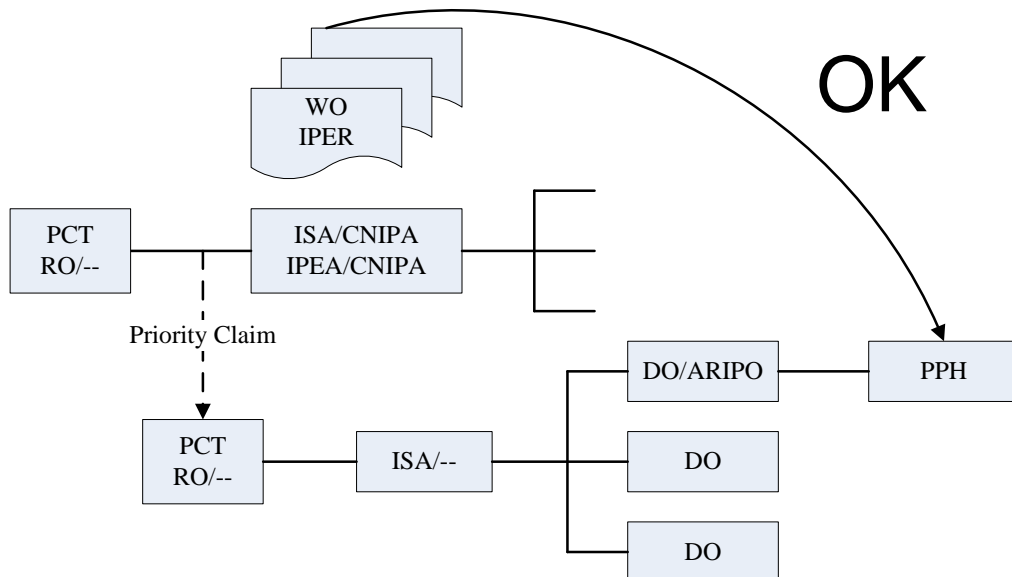
**(A'') The application is a national phase application of the corresponding international application.  
(The corresponding international application claims priority from an international application.)**



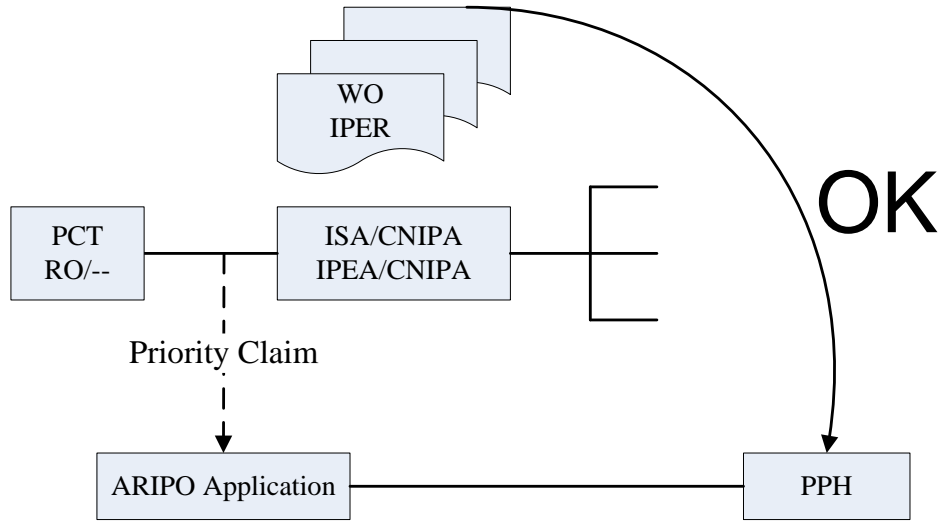
**(B) The application is a national application as a basis of the priority claim of the corresponding international application.**



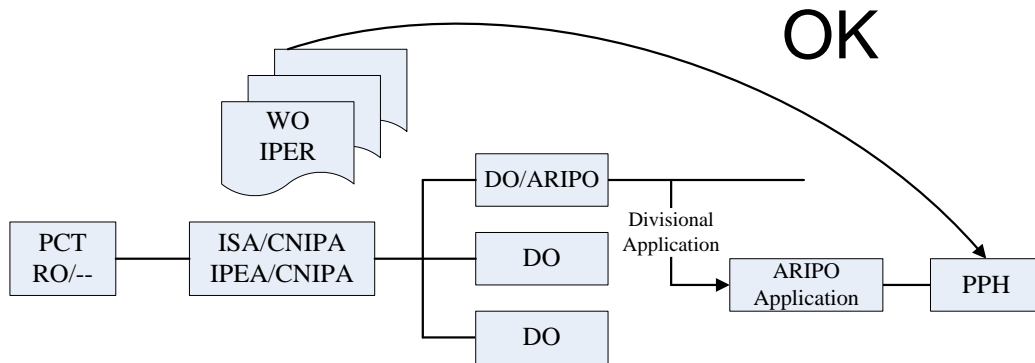
**(C) The application is a national phase application of an international application claiming priority from the corresponding international application.**



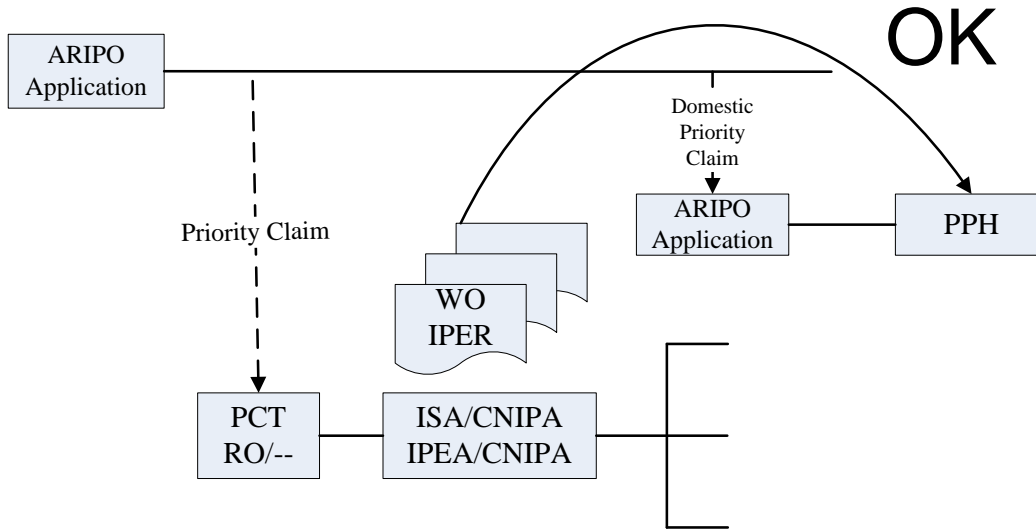
**(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.**



**(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 III**

**The following Tables Show Examples of Cases Considered to “Sufficiently Correspond” and Cases not Considered to “Sufficiently Correspond”.**

**Table I: Claims in the following cases (case 1 to 4) are considered to “sufficiently correspond”**

Case	Patentable/Allowable Claims at CNIPA		ARIPO Claims		Comment
	No.	Content	No.	Content	
Case 1	1	A	1	A	Claim 1 in the ARIPO application is the same as the “patentable/allowable” claim 1 in the CNIPA application.
Case 2	1	A	1 2	A A+a	Claim 1 in the ARIPO application is the same as “patentable/allowable” claim 1 in the CNIPA application.  Claim 2 in the ARIPO application is created by adding a technical feature described in the specification to “patentable/allowable” claim 1 in the CNIPA application.
Case 3	1 2 3	A A+a A+b	1 2 3	A A+b A+a	Claim 1 in the ARIPO application is the same as “patentable/allowable” claim 1 in the CNIPA application.  Claims 2, 3 in the ARIPO application are the same as “patentable/allowable” claims 3, 2, respectively in the CNIPA application.
Case 4	1	A	1	A+a	Claim 1 in the ARIPO application has an additional technical feature “a” described in the specification.



**Table II: Claims in the following cases (case 5 to 7) are NOT considered to “sufficiently correspond”**

Case	Patentable/Allowable Claims at CNIPA		ARIPO Claims		Comment
	No.	Content	No.	Content	
Case 5	1	A Product	1	A' Process/ Method	Claim 1 in the ARIPO application defines a process/method while “patentable/allowable” claim 1 in the CNIPA application defines a product.  The technical feature of the “patentable/allowable claim” in the CNIPA application is the same as in the ARIPO claim but they have different categories.
Case 6	1	A+B	1	A+C	Claim 1 in the ARIPO application is different from “patentable/allowable” claim 1 in the CNIPA application as to a component of the invention claimed.  The ARIPO claim is created by changing part of the technical features of the “patentable/allowable” claim in the CNIPA application.
Case 7	1	A+b	1	A	Claim 1 in the ARIPO application is different from “patentable/allowable” claim 1 in the CNIPA application as to a component of the invention claimed.  The ARIPO claim is broader than the “patentable/allowable” claim in the CNIPA application.