

Procedures to file a request with the Taiwan Intellectual Property Office (TIPO) for Patent Prosecution Highway (PPH) Program between TIPO and the United States Patent and Trademark Office (USPTO) Acting as the Designated Representatives of the Taipei Economic and Cultural Representative Office in the US (TECRO) and the American Institute in Taiwan (AIT)

Amended and enacted on April 1, 2016

The Patent Prosecution Highway (PPH) was established to enable an applicant, whose claims are determined to be allowable/patentable in the Office of First Filing (OFF), to have the corresponding application filed in the Office of Second Filing (OSF) advanced out of turn for examination while at the same time allowing the OSF to exploit the search and examination results of OFF.

The PPH pilot program between TIPO and USPTO acting as the designated representatives of the Taipei Economic and Cultural Representative Office in the United States (TECRO) and the American Institute in Taiwan (AIT) that commenced on September 1, 2011, for a trial period of one year ends 31 August 2012. Evaluations of the pilot program shows that it is effective in expediting patent filing while at the same time significantly reduces administrative costs at the OSF. It is therefore agreed upon by TIPO and USPTO acting as the designated representatives of the Taipei Economic and Cultural Representative Office in the United States (TECRO) and the American Institute in Taiwan (AIT) that this PPH program be a permanent cooperation between the two offices; the official launching date will be on September 1, 2012. Though permanent, the content of the program is subject to change as needed with the development of PPH.

1. Request with TIPO for accelerated examination under PPH

An applicant should file a request for accelerated examination under the PPH with TIPO by submitting a completed “Request for Acceleration Examination Under TIPO-USPTO PPH Program” request form accompanied by the relevant supporting documents. The requirements for filing accelerated examination with TIPO under the PPH are given in paragraph 2. Relevant supporting documentations (paragraph 3) and the procedure for accelerated examination under the PPH program at TIPO is discussed under paragraph 4. The PPH request form is available on TIPO’s web site, <http://www.tipo.gov.tw/pph>.

2. Requirements for requesting accelerated examination under the PPH Program at TIPO

There are four requirements for requesting accelerated examination under the PPH program at TIPO. These are:

(a) The TW application is:

- (i) an application which has validly claimed priority under Taiwan's Patent Act §28 to the US application(s) (Figure A and B in Annex 1 for examples), or
- (ii) an application which has validly claimed priority under Taiwan's Patent Act §28 to the PCT application(s) without priority claim (Figure C in Annex 1 for example).

The TW application which has validly claimed priority to multiple US or PCT applications (Figure D and E in Annex 1 for example), or which is a divisional application validly based on the originally filed application that is included in (i) and (ii) above, is also eligible. (Figure F and G in Annex 1 for examples).

The program is not applicable to utility model applications and design applications.

b) At least one corresponding US application has one or more claims that have been determined to be patentable by the USPTO.

The allowable/patentable claims are (Annex 2 for examples) :

- (i) claims indicated in the item "The allowed claim(s) is/are ___" in the "Notice of Allowability";
- (ii) claims indicated in the item "Claim(s) ___ is/are allowed" in "Office Action Summary" of either a "Non-final Rejection" or a "Final Rejection".
- (iii) claims indicated in the item "Claim(s) ___ is/are objected to" in "Office Action Summary" of either a "Non-final Rejection" or a "Final Rejection" and where the USPTO examiner indicates that the claims "are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims". Note that when a claim is rejected and the USPTO examiner indicates in the office action that certain features of the allowable/patentable invention have not been claimed and if properly claimed such claim may be given favorable consideration, the suggested and hypothetical claims are not regarded as allowable/patentable in this program.
- (iv) claims indicated in the item "Claim(s) ___ is/are objected to" in "Office Action Summary" of an "Ex parte Quayle Office Action" and where the USPTO examiner indicates that the claims "would be allowable if rewritten or amended to overcome the objection set forth in this office action".

c) All claims on file, as originally filed or as amended, for accelerated examination

under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO.

Claims shall be considered sufficiently corresponding where the claims on file are of the same or similar scope as the claims in the USPTO, or the claims on file are narrower in scope than the claims in the USPTO. In this regard, a claim on file that is narrower in scope occurs when a USPTO claim is amended to be further limited by an additional technical feature that is supported in the specification (and/or claims). When possible, the claim on file should be presented in dependent form.

d) The applicant has been notified that a substantive examination will begin shortly. And TIPO has not issued a first examination report on the application.

3. Documents to be submitted for accelerated examination under the PPH program:

Documents (a) to (d) below should be submitted by attaching to “Request for Acceleration Examination under TIPO-USPTO PPH Program”. The request form is in Annex 3.

a) Copies of all office action(s) relating to the corresponding USPTO application(s).

The applicant can either provide the office actions with the request for accelerated examination under the PPH program or request that TIPO obtains the documents from the USPTO Public PAIR. The applicant must clearly identify the relevant information (document name and date) of the office actions to be retrieved in the PPH request form. It is noted that applicants must also submit copies of any office action(s) (which are relevant to patentability) from the USPTO application(s) issued after the grant of the request for participation in the PPH program in the TIPO (especially where USPTO might have reversed a prior holding of allowability/patentability). A translation of the office action(s) is not required.

b) A copy of the claims determined to be allowable/patentable by the USPTO.

The claims determined to be allowable/patentable in the USPTO might be either the amendments, or the document submitted at filing, which includes claims determined to be allowable/patentable, or a copy of the USPTO’s publication of the granted patent. The applicant can either provide the claims together with the request for acceleration under the PPH or request that TIPO obtains the claims from the USPTO Public PAIR system.

A translation of the allowable/patentable claims is not required; however, the applicant is free to submit translation of the allowable/patentable claims as part of the supporting documentation when requesting accelerated examination under the PPH to allow prompt consideration of the office actions if they so desire.

c) Copies of the references cited by the USPTO examiner

All references cited in “Detailed Action” or “Reason for Allowance” as basis for refusal or allowability/patentability should be provided. However, if the cited reference is a patent document, then submission is not necessary, as they are usually available to TIPO. If TIPO does not access to the relevant patent documents, the applicant must submit these documents at the request of TIPO. If the cited reference is a non-patent literature, the applicant has to submit it.

A translation of the references is not required. TIPO examiner may request translation of cited references using the standard examination procedure when a translation of a cited reference is necessary.

d) A claim correspondence table

The applicant must submit a claim correspondence table which explains the sufficient correspondence of the claims determined to be allowable/patentable by the USPTO and the claims of the TIPO application for accelerated examination under the PPH program.

If the claims on file do not sufficiently correspond to one or more claims determined to be allowable/patentable by the USPTO, but the applicant would like to amend the claims to sufficiently correspond to the allowable/patentable claims in the US application(s), the applicant should amend the claims to fully comply with the corresponding terms at the same time as the request for expedited examination under PPH program. The claim correspondence table is given in Annex 4.

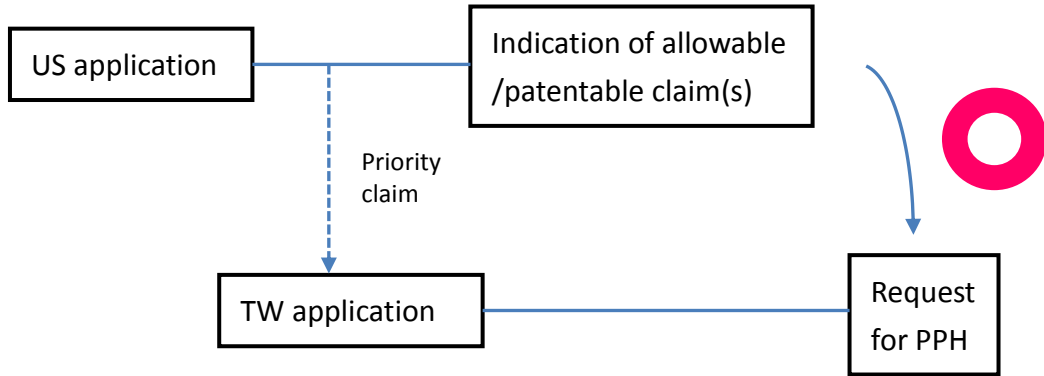
4. Procedure for accelerated examination under the PPH Program at TIPO

The applicant files a form requesting accelerated examination under the PPH program with TIPO, including relevant supporting documents. If the requirements are met, TIPO will conduct the accelerated examination. If the application does not qualify for participation in the PPH program, the applicant will be notified accordingly and given opportunity to perfect the request. If not perfected, the application will be notified and the application will await action in its regular turn.

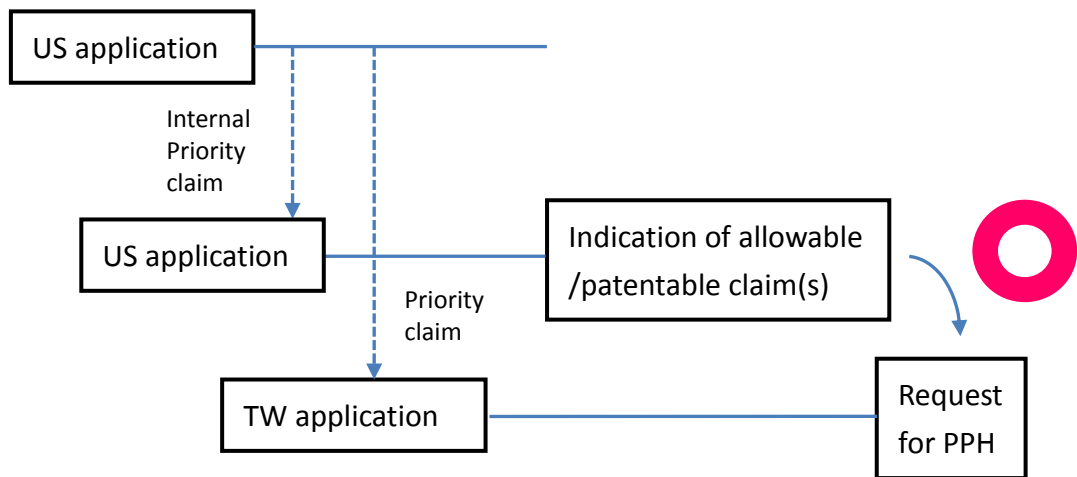
The applicant must use the “Amendment Request Form under the PPH Program” (Annex 5) to make amendments during and after the request for expedited examination under the PPH program. Other relevant documents must also be specified in terms of their connection to the request for PPH to ensure prompt and proper processing by TIPO.

Annex 1

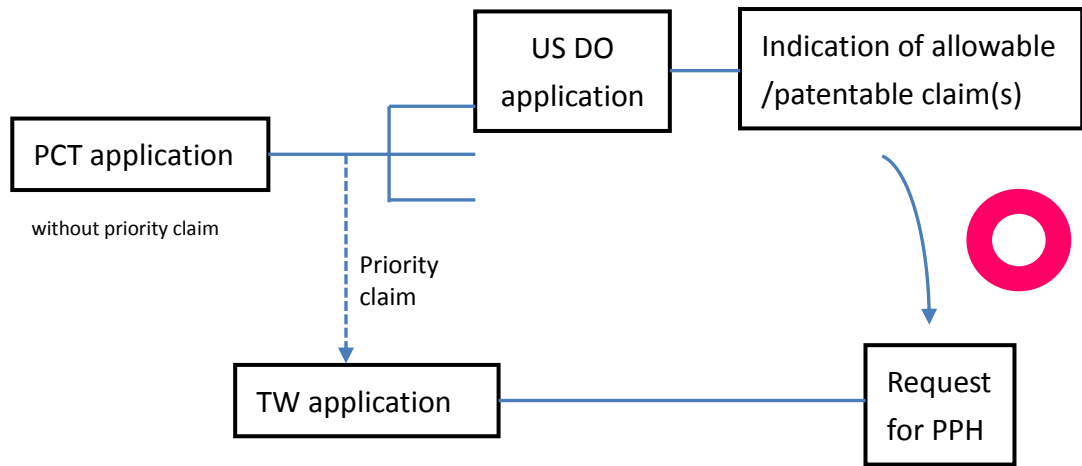
A. A case meeting requirement (a)(i)



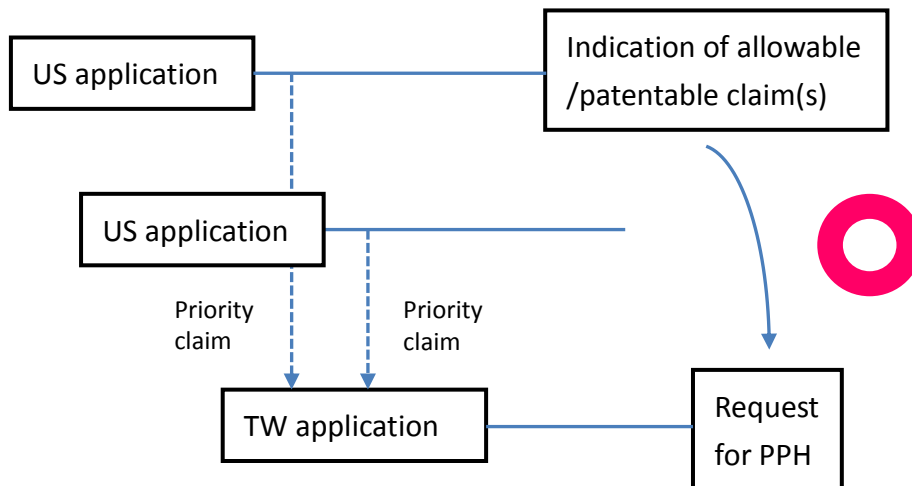
B. A case meeting requirement (a)(i)



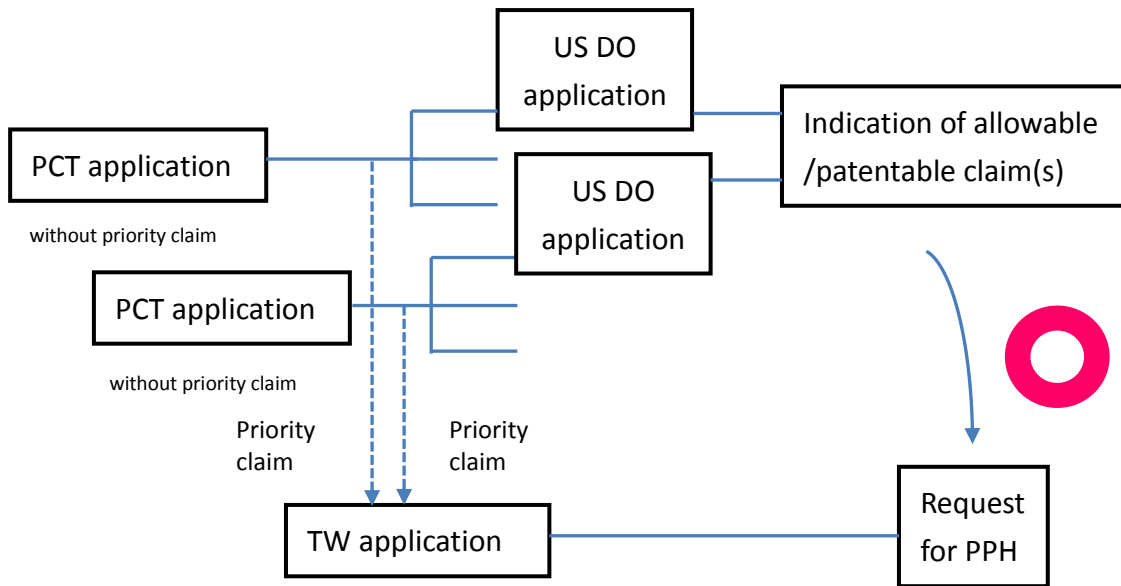
C. A case meeting requirement (a)(ii)



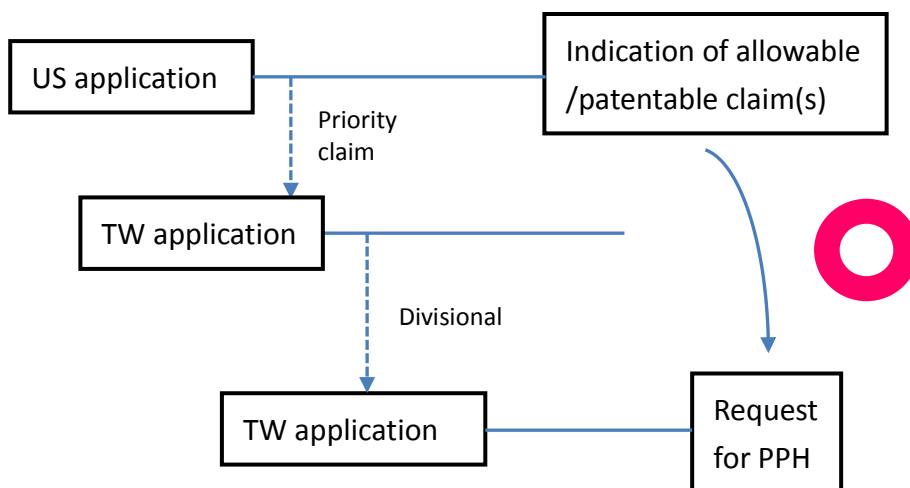
D. A case meeting requirement (a)(i)



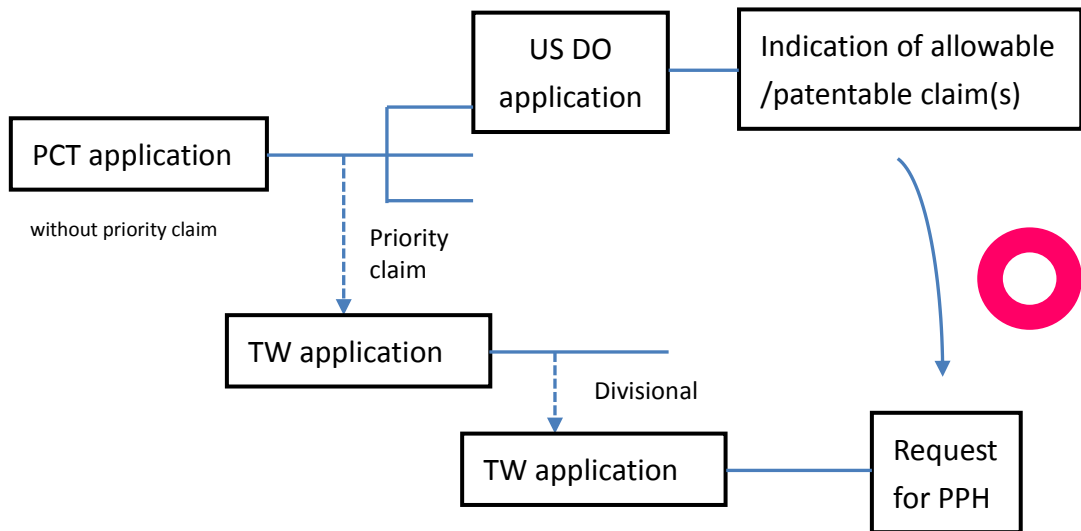
E. A case meeting requirement (a)(ii)



F. A case for divisional application meeting requirement (a)(i)



G. A case for divisional application meeting requirement (a)(ii)



Annex 2

(1) claims indicated in the field “The allowed claim(s) is/are ___” in the Notice of Allowability.

Notice of Allowability	Application No.	Applicant(s)	
	Examiner	Art Unit	
<p>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--</p> <p>All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.</p> <p>1. <input checked="" type="checkbox"/> This communication is responsive to <u>the amendment filed on 02/14/05.</u></p> <p>2. <input checked="" type="checkbox"/> The allowed claim(s) is/are <u>1-3 and 5-30.</u></p> <p>3. <input checked="" type="checkbox"/> The drawings filed on <u>12/19/02</u> are accepted by the Examiner.</p>			

(2) claims indicated in the field “Claim(s) ___ is/are allowed” in “Office Action Summary” of either a Non-Final Rejection or a Final Rejection.

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Art Unit	
<p>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</p> <p>Period for Reply</p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). <p>Status</p> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>06/25/04.</u></p> <p>2a) <input checked="" type="checkbox"/> This action is FINAL. 2b) <input type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p> <p>Disposition of Claims</p> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-3 and 6-30</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input checked="" type="checkbox"/> Claim(s) <u>1-3 and 13-30</u> is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>6-12</u> is/are rejected.</p> <p>7) <input checked="" type="checkbox"/> Claim(s) <u>5</u> is/are objected to.</p> <p>8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>			

(3) claims indicated in the field “Claim(s) ___ is/are objected to” in “Office Action Summary” of either a Non-Final Rejection or Final Rejection and where the USPTO examiner indicates that the claims “are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims”.

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Art Unit	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) Claim(s) ____ is/are allowed.

6) Claim(s) 1-16, 18-25, 27, 28 and 30 is/are rejected.

7) Claim(s) 17, 26 and 29 is/are objected to.

8) Claim(s) ____ are subject to restriction and/or election requirement.

(4) claims indicated in the field “Claim(s) ___ is/are objected to” in “Office Action Summary” of an Ex parte Quayle office action and where the USPTO examiner indicates that the claims “would be allowable if rewritten or amended to overcome the objection set forth in this Office action”.

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Art Unit	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11-13 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) Claim(s) ____ is/are allowed.

6) Claim(s) ____ is/are rejected.

7) Claim(s) 11-13 is/are objected to.

8) Claim(s) ____ are subject to restriction and/or election requirement.

Annex 3

發明專利 PPH 審查申請書

(本申請書格式、順序，請勿任意更動，※記號部分請勿填寫)

申請案號： ※案 由：24714

一併申請 PPH 修正 一併申請誤譯訂正

一、發明名稱：

二、申請人：(共 人) (多位申請人時，應將本欄位完整複製後依序填寫，姓名或名稱欄視身分種類填寫，不須填寫的部分可自行刪除)

國 籍： 中華民國 大陸地區 (大陸、 香港、 澳門)
 外國籍：_____

身分種類： 自然人 法人、公司、機關、學校

ID：

姓名： 姓： 名：

Last name : First name :

(簽章)

名稱： (中文)

(英文)

(簽章)

代表人：(中文)

(英文)

(簽章)

地址： (中文)

(英文)

聯絡電話及分機：

◎代理人：(多位代理人時，應將本欄位完整複製後依序填寫)

ID：

姓名：

(簽章)

證書字號：

地址：

聯絡電話及分機：

三、對應之美國日本西班牙韓國申請案：

【格式請依：申請案號、公開編號、公告編號 順序註記，惟如尚未取得公開編號或公告編號者，得不註記】

1.

四、附送書件:

(* 個人資料保護注意事項：

申請人已詳閱申請須知所定個人資料保護注意事項，並已確認所檢附之說明書、申請專利範圍、圖式、修正說明書、修正理由書、申復書及其附件(除委任書外)，不包含應予保密之個人資料；其載有個人資料者，同意智慧財產局提供任何人以自動化或非自動化之方式閱覽、抄錄、攝影或影印。)

1、所有審查意見書影本(含中譯本或英譯本)。

1-1 審查意見書請經由 USPTO Public PAIR 系統取得(台美 PPH)。

文件名稱	日期

1-2 審查意見書及英譯本請經由 JPO AIPN 系統取得(台日 PPH)。

文件名稱	日期

1-3 審查意見書請經由 SPTO Expedientes Digitalizados 系統取得(台西 PPH)。
(勾選此項時，仍應檢附審查意見書之翻譯本)

文件名稱	日期

1-4 審查意見書及英譯本請經由 KIPO K-PION 系統取得(台韓 PPH)。

文件名稱	日期

2、審查達到可核准之申請專利範圍影本(含中譯本或英譯本)。

2-1 申請專利範圍請經由 USPTO Public PAIR 系統取得(台美 PPH)

文件名稱	日期

2-2 申請專利範圍及英譯本請經由 JPO AIPN 系統取得(台日 PPH)。

文件名稱	日期

2-3 申請專利範圍請經由 SPTO Expedientes Digitalizados 系統取得(台西 PPH)。(勾選此項時，仍應檢附申請專利範圍之翻譯本)

文件名稱	日期

2-4 申請專利範圍及英譯本請經由 KIPO K-PION 系統取得(台韓 PPH)。

文件名稱	日期

3、引用作為專利准、駁判斷依據之引證文獻。

(※ 引證文獻屬專利文獻無需檢送。)

4、申請專利範圍對應表。

- 5、其他有利於本局 PPH 審查之文件。(請敘明)
- 6、發明專利 PPH 修正申請書。(發明專利 PPH 修正申請書之一、二項基本資料，可註明「同發明專利 PPH 審查申請書」而不須重複填寫。)
- 7、專利誤譯訂正申請書。(專利誤譯訂正申請書之一、二項基本資料，可註明「同發明專利 PPH 審查申請書」而不須重複填寫。)

Annex 5

發明專利PPH修正申請書

(本申請書格式、順序，請勿任意更動，※記號部分請勿填寫)

申請案號： ※案 由：24716

依據： 年 月 日 () 智專 字第 號函辦理。

一、發明名稱：(中文/英文)

二、申請人：(共 人) (多位申請人時，應將本欄位完整複製後依序填寫，姓名
或名稱欄視身分種類填寫，不須填寫的部分可自行刪除)

(第1申請人)

國 籍： 中華民國 大陸地區 (大陸、香港、澳門)
外國籍： _____

身分種類： 自然人 法人、公司、機關、學校

ID：

姓名： 姓： 名：

Last
name

First
name

(簽章)

名稱： (中文)

(英文)

(簽章)

代表人：(中文)

(英文)

(簽章)

地址： (中文)

(英文)

聯絡電話及分機：

◎代理人：(多位代理人時，應將本欄位完整複製後依序填寫)

ID：

姓名： 姓： 名：

(簽章)

證書字號：

地址：

聯絡電話及分機：

三、修正事項：

(請於所勾選修正說明事項之後，敘明修正理由或說明，如字數過多者，請另以 A4 紙張直式橫書繕打，以附件標示並備具一式 2 份，俾利審查。)

說明書修正之頁數、段落編號及行數及修正理由：

申請專利範圍修正之項號及修正理由：

(99 年 1 月 1 日起提出之發明申請案，請再填寫 * 申請專利範圍請求項及規費之說明)

圖式修正之圖號及修正理由：

其他說明事項如附件：

四、附送書件：(不須填寫的部分可自行刪除)

(* 個人資料保護注意事項：

申請人已詳閱申請須知所定個人資料保護注意事項，並已確認檢附之修正說明書、修正申請專利範圍、修正圖式、申復書及其附件(除委任書外)，不包含應予保密之個人資料；其載有個人資料者，同意智慧財產局提供任何人以自動化或非自動化之方式閱覽、抄錄、攝影或影印。)

1、發明專利 PPH 修正申請書一式 2 份。

2、發明專利修正部分劃線之說明書或申請專利範圍修正頁一式 2 份。(請於每頁右上角註記送件申請修正之日期)

(如為刪除原說明書內容者，應劃線貫穿於刪除之文字上；如為增加說明書內容者，應劃線於新增文字下方。各次修正應劃線註記之部分，均以原說明書為基礎；申請專利範圍之請求項項次改變者，其後之項次均應調整)

3、發明專利修正後無劃線之說明書或申請專利範圍或圖式替換頁(審查意見通知送達前一式 3 份，審查意見通知送達後一式 2 份)；如修正後致原說明書或申請專利範圍或圖式頁數不連續者，應檢附修正後之全份說明

書或申請專利範圍或圖式(審查意見通知送達前一式3份，審查意見通知送達後一式2份)(請於每頁右上角註記送件申請修正之日期)。

- 4、委任書1份。
- 5、申復書一式2份。
- 6、申請專利範圍對應表1份。
- 7、其他：

* 申請專利範圍請求項及規費之說明：

(本欄位僅為99年1月1日起提出之發明專利申請案適用。)

(一) 申請案發給第一次審查意見通知前，提出本次修正申請專利範圍者：

本案已提出實體審查申請，本次僅修正請求項，未有新增或刪除請求項之情事，應繳規費不變。

本案已提出實體審查申請，本次有新增或刪除請求項者：

新增()項，刪除()項，修正後共計()項。

本次應加收或退還規費共計新台幣()元整。

(二) 申請案發給第一次審查意見通知後，提出本次修正申請專利範圍者：

本次僅修正或刪除請求項，未有新增請求項之情事，應繳規費不變。

本次有新增請求項者：

新增()項，修正後共計()項。

本次應加收規費共計新台幣()元整。