

MyIPO and Japan Patent Office launch PPH Pilot Program

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Effective 01 October 2014, the Intellectual Property Corporation of Malaysia (MyIPO) and the Japan Patent Office (JPO) have commenced a Patent Prosecution Highway (PPH) pilot program. The program will initially run for a trial period of three years, followed by an evaluation to determine whether and how the program should be fully implemented thereafter.

Under this PPH program, an applicant that has a pending Malaysian patent application may request accelerated examination by MyIPO based on favourable examination by the JPO of a corresponding Japanese or PCT application (hereafter collectively called the "reference application"). In order to qualify for processing under the PPH program, the following conditions must be met:

- The Malaysian application and the reference application examined by the JPO must correspond – this is defined in terms of a priority relationship between the applications or a common PCT application.
- One or more claims of the reference application have been indicated as allowable by the JPO.
- The claims presented in the Malaysian application for examination under the PPH sufficiently correspond to such allowed claims.
- A request for normal examination has been filed with MyIPO (either previously, or with the PPH request).
- If the examination request was filed previously, MyIPO has not yet started the examination.

A request for PPH processing is made by submitting the following documents:

- An official request form.
- All relevant office actions issued by the JPO, or the Written Opinion or IPRP issued by the JPO for a PCT-based request.
- The claims determined to be allowable by the JPO.
- Any non-patent prior art references cited by the JPO examiner.
- A claim correspondence table that shows the relationship between the pending Malaysian claims and the claims deemed allowable by the JPO.
- English translations of the above documents if they are in Japanese - however, prior art citations do not need to be translated unless subsequently requested by the MyIPO examiner. A machine translation can be submitted initially, though an examiner may require a formal translation if the machine translation is inadequate.

- Documents and their translations do not need to be submitted if they are available to the MyIPO examiner through the JPO's Advanced Industrial Property Network (AIPN) or WIPO's PATENTSCOPE website.

The above description focuses on using the program to accelerate examination at MyIPO. In fact, the program is bi-directional in nature so that examination at the JPO can also potentially be accelerated based on favourable examination by MyIPO of a corresponding Malaysian application. This includes the application at MyIPO undergoing modified examination based on grant of a foreign patent by an office with which the JPO has an existing PPH agreement. Overall, the introduction of this program should be of interest and benefit to both our domestic and foreign clients.