

Patent Prosecution Highway programme between the European Patent Office (EPO) and Intellectual Property Corporation of Malaysia (MyIPO) based on PCT and national work products

A. PPH Programme

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 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.

The PPH enables an applicant whose claims have been determined to be patentable/allowable to have a corresponding application filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results.

Under the PPH programme a PPH request can be based,

either on the latest PCT work product (written opinion of the ISA (WO-ISA) or international preliminary examination report (IPER)) established by one of the participating offices as ISA or IPEA,

or on the national work product established during the processing of a national application or a PCT application that has entered the national phase before one of the participating offices,

where this work product determines one or more claims to be patentable/ allowable.

With effect from **1 July 2020** the PPH programme between the MyIPO and EPO is extended for an **indefinite period**. The requirements laid forth below will apply to PPH requests filed with the MyIPO on or after 1 July 2020

B. Requirements for requesting participation in the PPH Programme

In order to be eligible to participate in the PPH Programme at MyIPO, the following requirements must be met:

(1) The European (EP) application for which participation in the PPH 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 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 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 Programme is requested has **not** begun.

C. Documents required for participation in the PPH Programme

For participation in the PPH Programme at MyIPO, the applicant has to:

(1) file a request for participation in the PPH Programme. A request form (FORM PPH1) is available via the MyIPO website at <http://www.myipo.gov.my/en/apply-for-patentutility-innovation/?lang=en%2F#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 English or Bahasa Malaysia; 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 English or Bahasa Malaysia.

(4) submit a copy of the patentable/allowable claim(s) from the OEE application(s) and a translation thereof in English or Bahasa Malaysia.

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

Where the request for participation in the PPH Programme is granted, the EP application will be processed in an accelerated manner. In those instances where the request for participation in the PPH 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 EP application prior to the request for participation in the PPH 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 Programme when these documents were previously filed in the EP 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). MyIPO 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.