

Procedures to File a Request to the Intellectual Property Corporation of Malaysia (MyIPO) for Patent Prosecution Highway Pilot Program between MyIPO and the United States Patent and Trademark Office (USPTO)

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 pilot program between MyIPO and USPTO will be in effect for three years commencing on 02 March 2023 and will end on 01 March 2026 (trial period). The MyIPO and USPTO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period. The offices may terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason.

PPH using work products from the USPTO

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the MyIPO and satisfies the following requirements under the MyIPO-USPTO PPH pilot program.

A. Requirements

- 1) The MyIPO application (including PCT national phase application) is
 - (a) an application which validly claims priority under the Paris Convention to the USPTO application(s) (i.e. a USPTO national application or a PCT application for which the USPTO was the International Searching Authority (ISA) or the International Preliminary Examining Authority (IPEA)) (examples are provided in ANNEX I, Figures A, B, C, F, G and H), or
 - (b) a PCT national phase application without priority claim (example is provided in ANNEX I, Figure I), or
 - (c) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in ANNEX I, Figure J, K and L).

The MyIPO application, which validly claims priority to multiple USPTO or direct PCT applications, or which is the divisional application validly based on the originally filed application that is included in (a) to (c) above, is also eligible.

- 2) At least one corresponding application exists in the USPTO which has one or more claims that are determined to be patentable/allowable by the USPTO.

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the USPTO application which forms the basis of the priority claim (e.g., a divisional application of the USPTO application or an application which claims domestic priority to the USPTO application (see Figure C in Annex I)), or an USPTO national phase application of a PCT application (see Figures H, I, J, K and L in Annex I).

Claims are “determined to be allowable/patentable” when the USPTO examiner explicitly identified the claims to be “allowable/patentable” in the latest office action, even if the application has not been granted yet. A claim determined as novel, inventive, and industrially applicable by the ISA/US or IPEA/US has the meaning of “allowable/patentable” for the purposes of this program.

- 3) All claims in the MyIPO application (for which an accelerated examination under the PPH pilot program is requested), as originally filed or as amended, must sufficiently correspond to one or more of those claims indicated to be patentable/allowable in the USPTO.

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 USPTO claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims).

A claim in the MyIPO which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the USPTO is not considered to sufficiently correspond. For example, if the USPTO claims only contain claims to a process of manufacturing a product, then the claims in the MyIPO are not considered to sufficiently correspond if the MyIPO claims introduce product claims that are dependent on the corresponding process claims.

- 4) The MyIPO application must have been available for public inspection after 18 months.
- 5) A “Request for Substantive Examination” must have been filed at the MyIPO either at the time of the PPH request or previously.

- 6) The MyIPO has **not** begun examination of the application at the time of filing the PPH request.

B. Documents to be submitted

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

- 1) file a request for participation in the PPH Programme in the FORM PPH1 - “Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program”.
- 2) attaching the following documents with FORM PPH1:
 - (a) Copies of all office actions (which are relevant to substantial examination for patentability in the USPTO which were issued for the corresponding application by the USPTO);
 - (b) Copies of all claims determined to be patentable/allowable by the USPTO;
 - (c) Copies of references cited by the USPTO examiner; and

The documents to be submitted are those cited in the above 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 MyIPO 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.

- (d) Claim correspondence table.

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the MyIPO application sufficiently correspond to the patentable/allowable claims in the USPTO application.

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

If documents (c) and (d) are available via DAS (Dossier Access System) or Patent Scope, the applicant does not need to submit a copy thereof, but has to provide a list of the

documents to be retrieved. If the USPTO application(s) is (are) unpublished, the applicant must submit the documents identified in points (c) and (d) above upon filing the PPH request.

C. Procedure for the accelerated examination under the PPH pilot program

The MyIPO decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When the MyIPO decides that the request is acceptable, the application is assigned to PPH Task Force for an accelerated examination under the 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 may be given opportunity to correct certain specified defects.

If the request is not approved, the applicant may resubmit the request up to one time. If the resubmitted request is still not approved, the applicant will be notified and the application will await action in its regular turn (refer to ANNEX I: Figure N and O)



Request for participation in the Patent Prosecution Highway (PPH) Pilot Programme

A. Application Data

Application Number	:	
Filing Date	:	
Applicant	:	
Title of Invention	:	

B. Request

The applicant requests participation in the Patent Prosecution Highway (PPH) pilot program based on:

Office of Earlier Examination (OEE)	:	
OEE Application Number (National or PCT application number)	:	
OEE Work Products Type	:	
<input type="checkbox"/> National/Regional Office Action(s)		
<input type="checkbox"/> International Authority Action(s) (ISA, IPEA or IPER)		
OEE application filing/priority date	:	

C. Required documents

The following documents are attached:

1. A copy of OEE work products;
 Translation of the documents in English or Malay Language; or
 The office is requested to retrieve these documents via the Dossier Access System or PATENTSCOPE or AIPN (list to be provided)
2. Copies of all claims determined to be patentable/allowable by OEE;
 Translations of the documents in English or Malay Language; or
 The office is requested to retrieve these documents via the Dossier Access System or PATENTSCOPE or AIPN (list to be provided)
3. A copy of non-patent documents cited in OEE work products;
 Translations of the documents in English or Malay Language.
4. Claim Correspondence Table.
5. If any of the above mentioned documents have been submitted before, please specify application number and date of submission.

Application number : _____

Date of submission : _____

D. Name and Signature of applicant or agent:

Name and signature

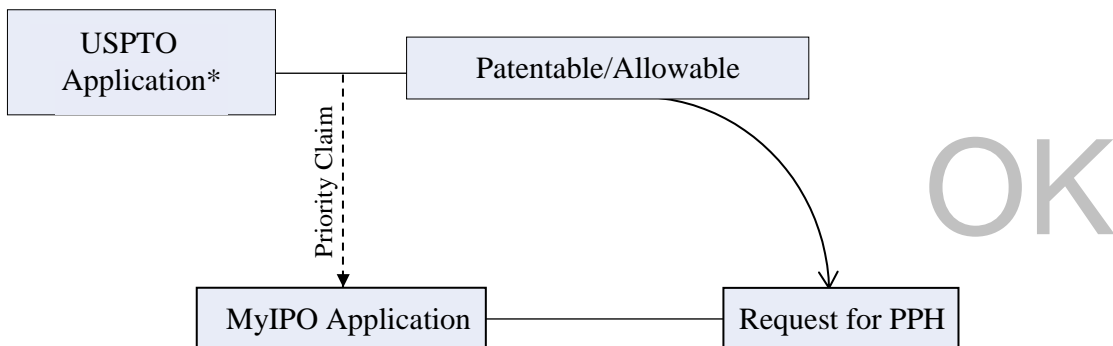
Date:

Claim Correspondence Table

The claim in the MyIPO application	The patentable claim in the OEE application	Remarks about the correspondence

A

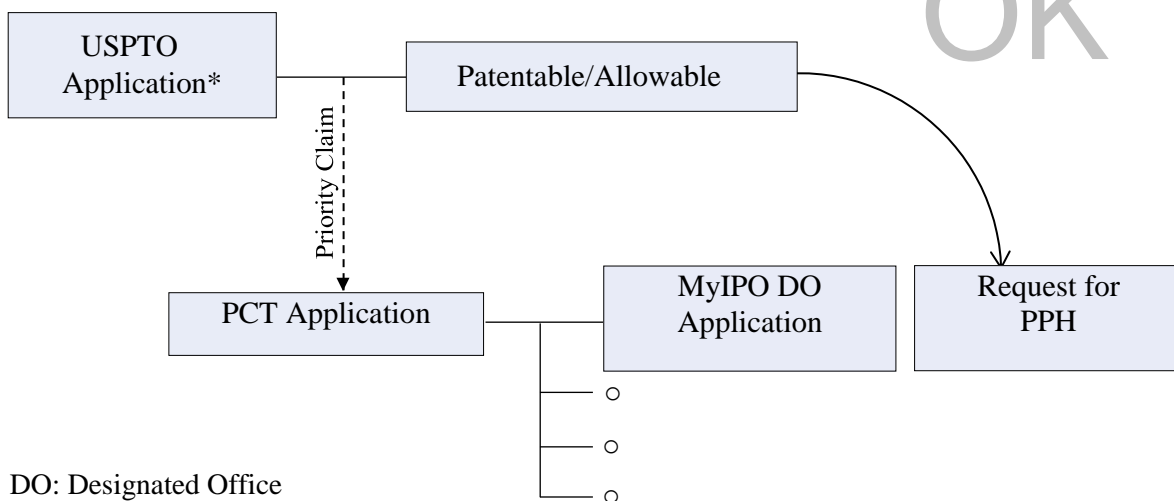
A case meeting requirement 1(a)
- Paris route -



* USPTO national application or PCT application for which the USPTO is the ISA or IPEA

B

A case meeting requirement 1(a)
- PCT route -



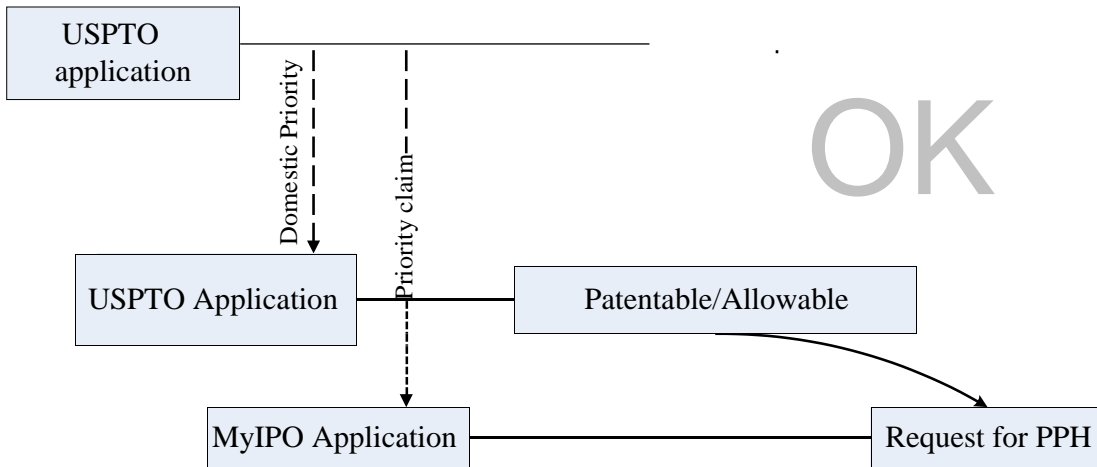
DO: Designated Office

* USPTO national application or PCT application for which the USPTO is the ISA or IPEA

C

A case meeting requirement 1(a)
- Paris route, Domestic priority -

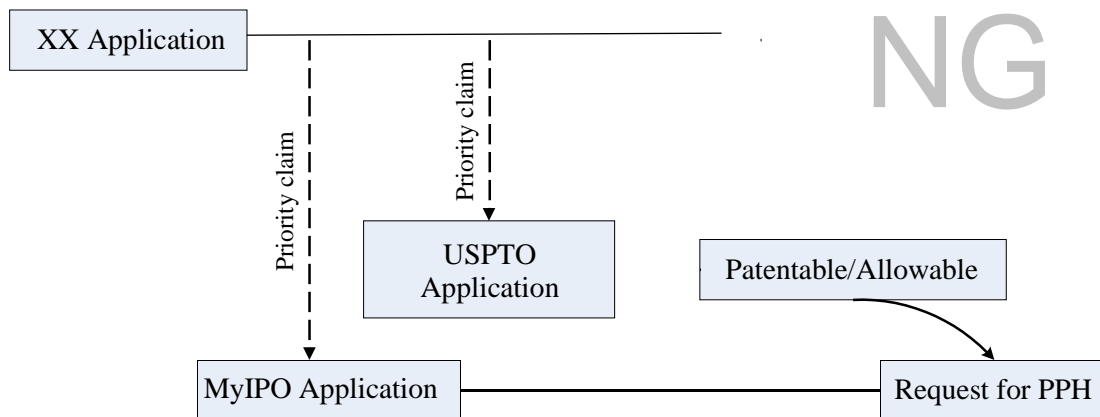
*



* USPTO national application or PCT application for which the USPTO is the ISA or IPEA

D

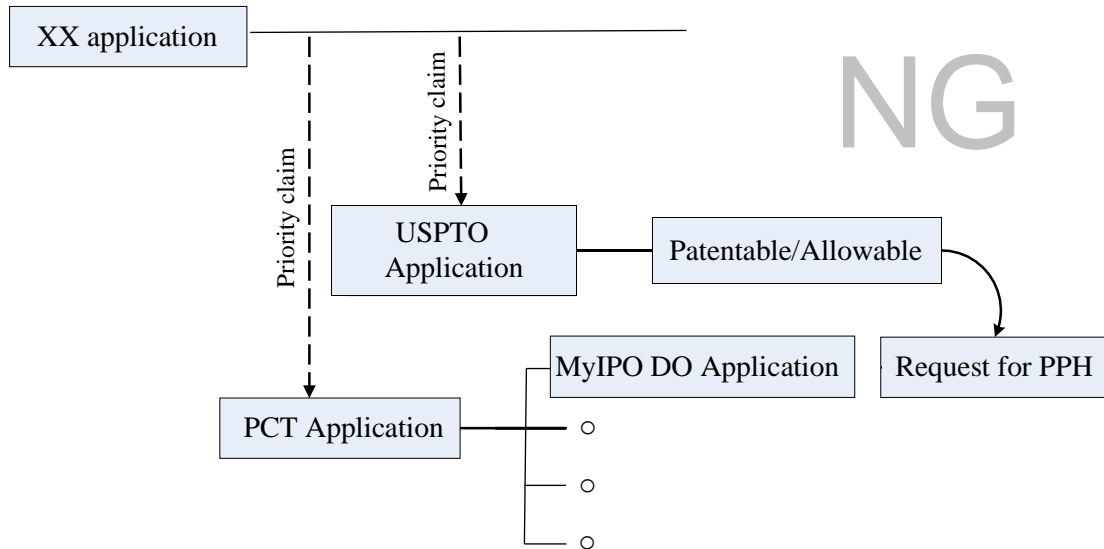
A case not meeting requirement (a)
- Paris route, but the first application is from the third country -



XX: the office other than the USPTO

E

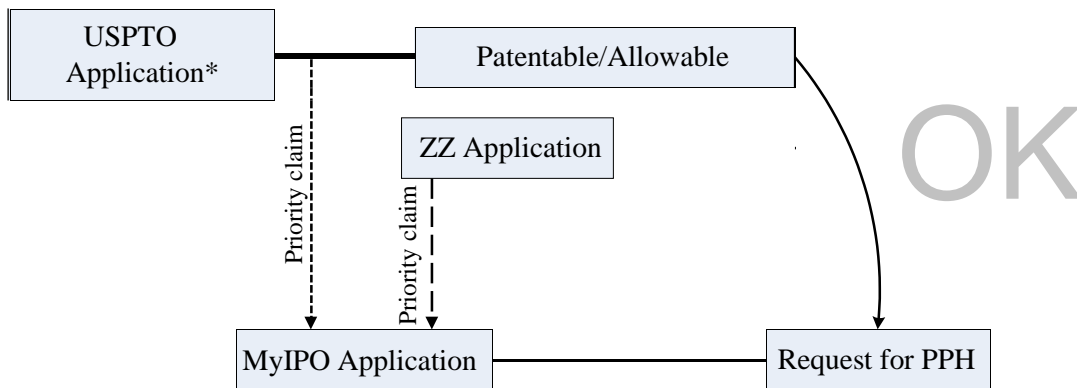
A case not meeting requirement (a)
- PCT route, but the first application is from the third country -



XX: the office other than the USPTO

F

A case meeting requirement 1(a)
- Paris route & complex priority -



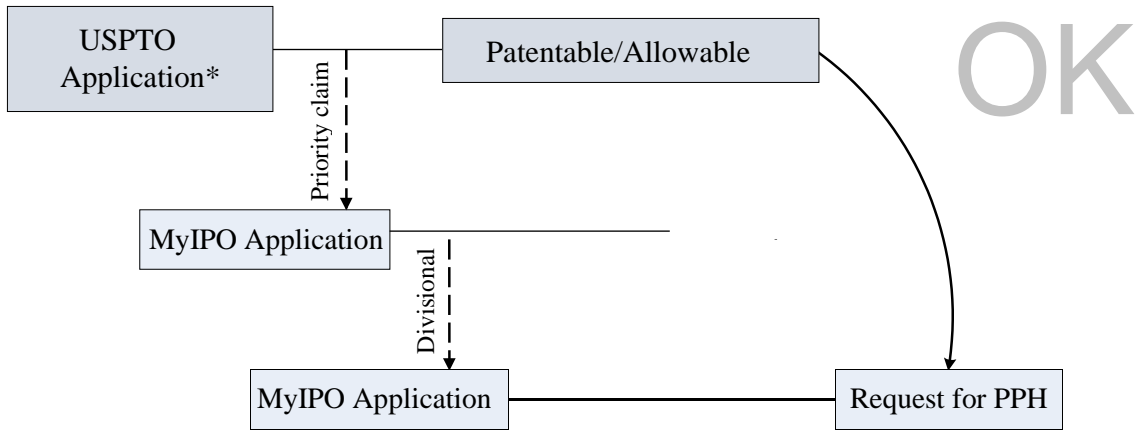
ZZ: any office

* USPTO national application or PCT application for which the USPTO is the ISA or IPEA

(The first application is from the USPTO)

G

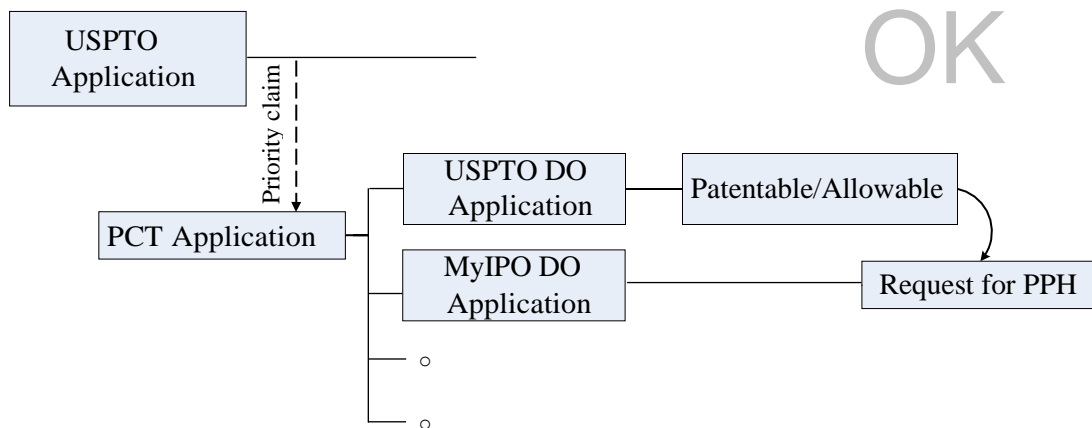
A case meeting requirement 1(a)
- Paris route & divisional application -



* USPTO national application or PCT application for which the USPTO is the ISA or IPEA

H

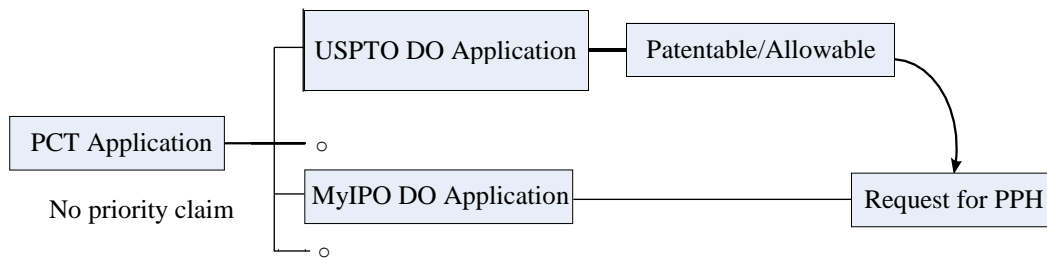
A case meeting requirement 1(a)
- PCT route -



I

A case meeting requirement 1(b)
- Direct PCT route -

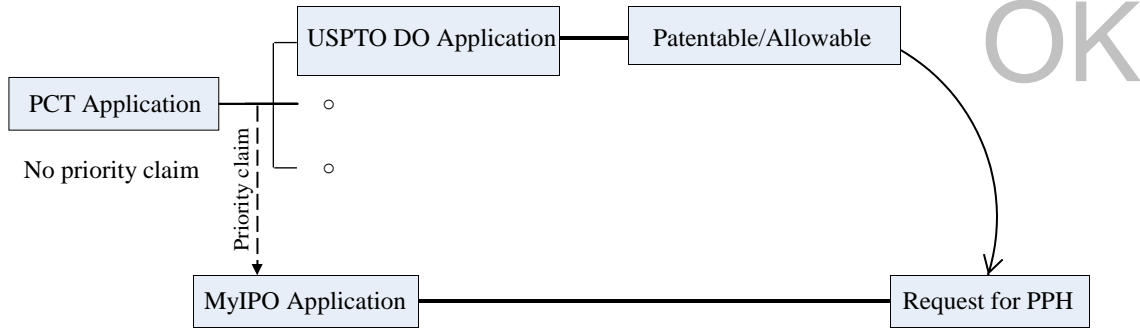
OK



J

A case meeting requirement 1(c)

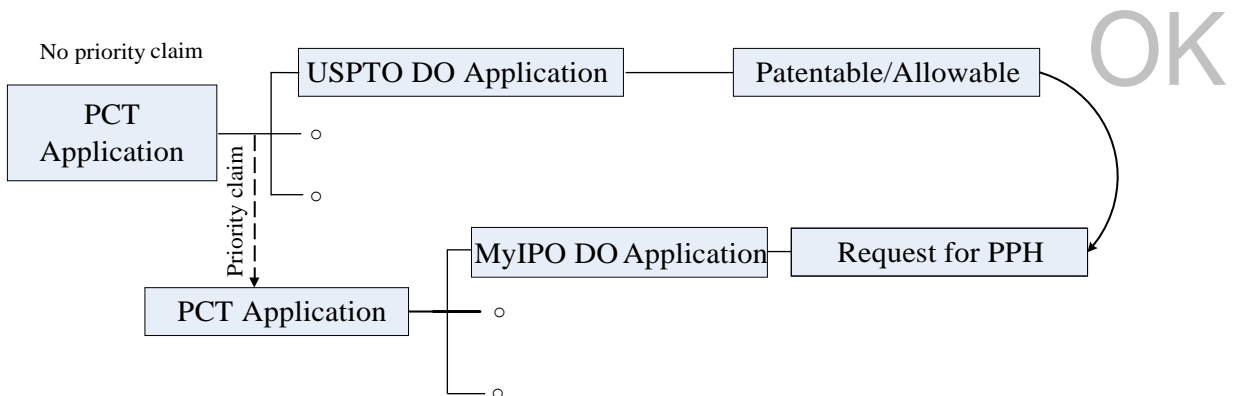
- Direct PCT & Paris route -



K

A case meeting requirement 1(c)

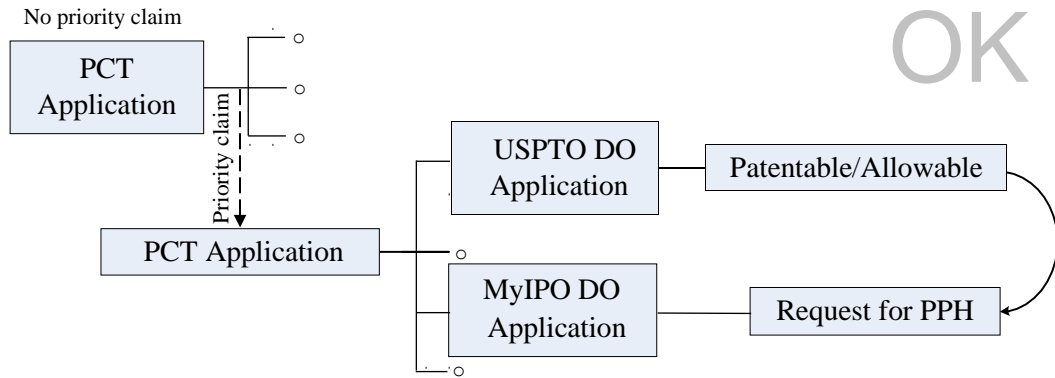
- Direct PCT & PCT route -



L

A case meeting requirement 1(c)

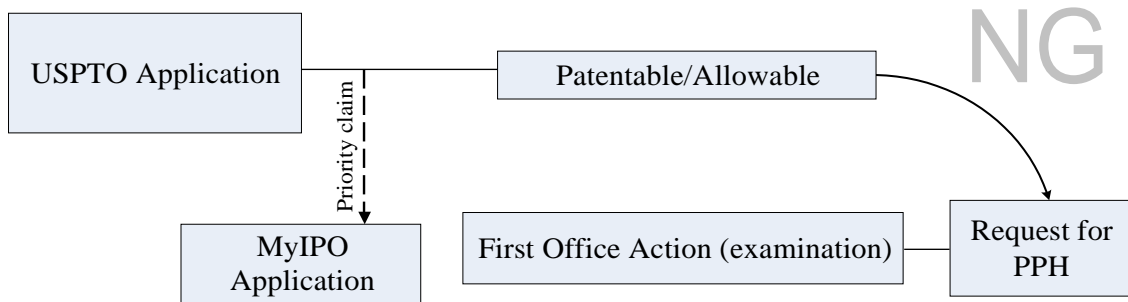
- Direct PCT & PCT route -



M

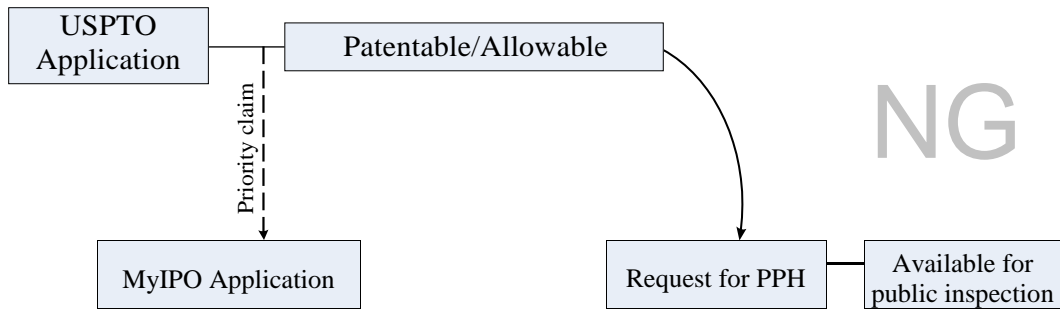
A case not meeting requirement 6

- Examination has begun before a request for PPH -



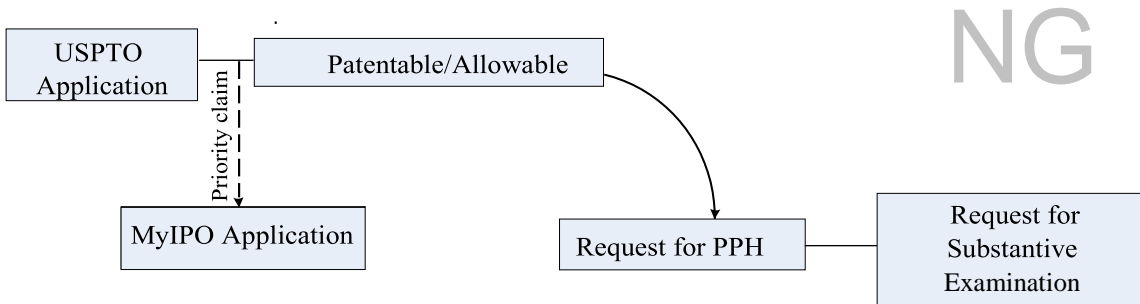
N

A case not meeting requirement 4
- The application has not been published at the time of request for PPH -



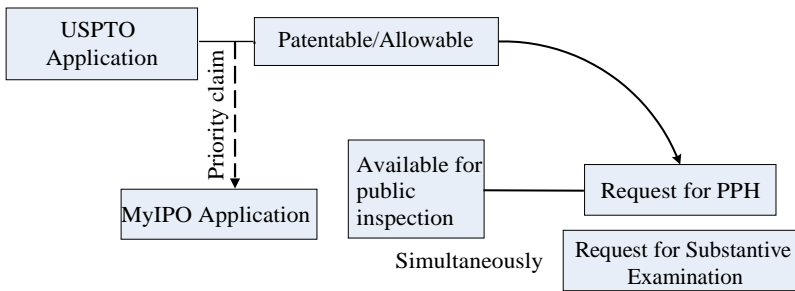
O

A case not meeting requirement 5
- The application has not entered into substantive examination stage at the time of request for PPH -





A case meeting requirement 5 (exception) - PPH request simultaneously with the Request for Substantive Examination –



OK