

## **Technical Guidelines of PPH Pilot Project between INPI and SIPO**

The Technical Guidelines established under the Memorandum of Understanding signed between the State Intellectual Property Office of the People's Republic of China (SIPO) and the National Institute of Industrial Property of Brazil (INPI) on November 13 2017, about the PPH INPI-SIPO Pilot Project are as follows:

### **Requirements for requesting participation in the PPH INPI-SIPO Pilot Project**

1. In order to be eligible to participate in the PPH INPI-SIPO Pilot Project, the following requirements must be met:

1.1. The CN or BR application for which participation in the PPH INPI-SIPO Pilot Project is requested and the corresponding application filed with the other Office must meet the requirements specified in the Offices' respective Procedures Guidelines.

1.2. The application for which participation in the PPH INPI-SIPO Pilot Project is requested and the corresponding application filed in the other Office must have the same earliest date, either the priority or filing date – belonging to the same patent family. All patent applications linked are acceptable.

1.3. The earliest patent application of the patent family must have been filed under the Paris Convention at the INPI or the SIPO or, under the PCT, at the INPI or the SIPO as Receiving Office.

1.4. Patent applications are eligible for the requests the PPH at SIPO; and patent applications and utility model applications are eligible for request PPH at INPI.

1.5 For an application to be valid as the basis of a request for participation in the PPH INPI-SIPO Pilot Project, it must have been substantively examined, including for novelty and inventive step, by the Office of Earlier Examination (OEE). It means that the results of the patent applications issue by SIPO can be used as basis for request PPH at INPI; and the results of patent applications and the results of utility modes issue by INPI can be used as basis for request PPH at SIPO.

1.6 The examination work product accepted as the basis of request for the PPH at the Office of Later Examination (OLE) is the “*Decision to Grant a Patent*” issued by SIPO

or the “*decisão de deferimento*” issued by INPI for a patent application of the same patent family examined by the Office of Earlier Examination (OEE). It must have the explicit indication that the patent application will be granted.

1.7. All claims in the application for which a request for participation in the PPH INPI-SIPO Pilot Project is made must sufficiently correspond to the patentable/allowable claims in the corresponding application(s). Claims are considered to sufficiently correspond when, accounting for differences due to claim format requirements, the claims in the application for which PPH is requested have the same or narrower scope that the claims in the corresponding application(s).

1.8. Substantive examination of the OLE application for which participation in the PPH INPI-SIPO Pilot Project is requested should not have begun.

1.9. The OLE application is open to the public.

### **Limitations**

2. The INPI-SIPO PPH Pilot Project has the following limitations:

2.1. The number of requests for the PPH in each Office will be respectively limited to 200 (two hundred) cases, 20 of these requirements can use the PPH Mottainai framework.

2.2. The SIPO intends to accept all applications containing claims of any classification. The INPI intends to accept all applications containing claims directed to information technology inventions, packaging technology industry, measuring technology, as well as chemistry technology. In any case, the pharmaceutical applications are excluded from the PPH INPI-SIPO Pilot Project. Applications for which participation in the PPH INPI-SIPO Pilot Project is requested must be classified by INPI in any of the International Patent Classification codes specified in the Annex, or any subdivisions thereunder.

2.3. Divisional patent applications will not be accepted, unless (i) they are directly divided from the original application, as well as (ii) the division of the application has been required in the Office of Earlier Examination (OEE).

### **Documents required for participation in the PPH INPI-SIPO Pilot Project**

3. Each Office will decide the necessary documentation that should be submitted in order to meet the requirements of the PPH INPI-SIPO Pilot Project. The documents will be determined in the OLE’s Procedure Guidelines. The documents may include, among others:

3.1. A request for participation in the PPH INPI-SIPO Pilot Project;

3.2. The claims in a sufficient way to correspond to claims which were considered to be patentable/allowable at the OEE. Claims should have the same or narrower scope;

3.3. A claim correspondence table that shows the relationship between the claims of the OLE application and those of the OEE application that were considered patentable/allowable; or, when applicable, a declaration that the claims are merely translation from the OEE claims considered patentable/allowable;

3.4. Copies of the work products (search reports and substantive examination reports) issued by the OEE in relation to the OEE application, and translations if necessary.

3.5. Copy of the “decisão de deferimento” or the “Decision to Grant a Patent” containing the patentable/allowable claims that are the basis for the PPH request;

3.6. Copy of the patentable/allowable claim(s) from the OEE application(s);

3.7. Copies of all non-patent documents cited in the office action(s) identified in point 3.4 above. If the cited document is a patent document, the applicant is not required to submit it, unless the Offices have difficulty in obtaining it, in which case the applicant may be asked to submit it.

3.8. If the documents from the items 3.4, 3.5, 3.6 or 3.7 are not in English or in the country’s language, the applicant must file a translation of them.

## **Procedures**

4. Once received a PPH request, the Offices will follow the procedures bellow:

4.1. The Offices will endeavor to evaluate quickly the requests for participation in the PPH INPI-SIPO Pilot Project.

4.2. If the request for participation in the PPH INPI-SIPO Pilot Project is accepted, the application will be processed in a priority manner.

4.3. If the request for participation in the PPH INPI-SIPO Pilot Project 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 have at least one opportunity to correct the identified deficiencies in the request within the time limits provided under the applicable national law. If the request is not corrected in due time, the application will be removed from the PPH INPI-SIPO Pilot Project and the applicant will be notified.

4.4. Each Office will decide how to use the OEE’s work products.

4.5. The Offices can, if they wish, develop specific procedures, for example, to better adjust to its own terminology or legal process, and adopt additional flexibilities beyond the requirements set in these Technical Guidelines.

### **Evaluation and Modification**

5. The offices can evaluate and modify these Technical Guidelines as following:

5.1. The Offices may perform an intermediate evaluation of the PPH INPI-SIPO Pilot Project at any time and in accordance with their own criteria.

5.2. The Offices may exchange information about the intermediary evaluation of the PPH INPI-SIPO Pilot Project and consider publishing the intermediate evaluation results at any time.

5.3. The Offices may modify the conditions, procedures or requirements of the PPH INPI-SIPO Pilot Project by request of either Office and by mutual consent, in writing, based on the evaluation results.

5.4. If the conditions applicable to the PPH INPI-SIPO Pilot Project are modified, these Technical Guidelines and the Offices' respective Procedures Guidelines will be amended and published by each Office accordingly.

5.5. The PPH INPI-SIPO Pilot Project will be evaluated in terms of efficiency and usefulness, once all the patent applications accepted in the project have been processed.

## ANNEX

The patent applications classified at the following International Patent Classification (IPC) codes can participate at the PPH INPI-SIPO Pilot Project at INPI. In any case, applications related to pharmaceutical area, understood as those classified as A61K in the main or secondary classification, are excluded from the PPH INPI-SIPO Pilot Project.

### I. Information Technology

	Technical Field	IPC Codes
1	Machinery and electrical appliances, energy	F21#, H01B, H01C, H01F, H01G, H01H, H01J, H01K, H01M, H01R, H01T, H02#, H05B, H05C, H05F, H99Z
2	Audiovisual technology	G09F, G09G, G11B, H05K
3	Telecommunications	G08C, H01P, H01Q,
4	Electric Communication Technique	H04#
5	Basic Communication processes	H03#
6	Computer technology	G06# (not including G06Q), G11C, G10L
7	Methods of information technology for management	G06Q
8	Semiconductors	H01L
9	Miscellaneous	B61#, B60K, B60L, B60W, B62D, B62J, F02D, G02B, G02F, G03G, G08G, H01S, H05H

### II. Packaging Technology

	Technical Field	IPC Codes
1	Machines or methods of packaging / unpacking Labelling or tagging machines or processes	B65B, B65C
2	Containers for storage or transport of articles or materials/packaging elements/ packages	B65D

### III. Measuring Technology: G01V, G01S

### IV. Chemistry Technology: B01J, C08#, C07#