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How to Short-Cut Patent Prosecution in ASEAN: Ways to Accelerate Grant of a Patent, as Seen From a Singapore Perspective

Martin Schweiger, Schweiger & Partners (Singapore)

Abstract

We all know that PPH is a useful tool for accelerating patent prosecution in ASEAN.

The ASEAN Patent Examination Co-operation (ASPEC) is an alternative to accelerate patent grant in Brunei, Cambodia, Indonesia, Laos, Malaysia, Philippines, Singapore (SG), Thailand, and Vietnam. Myanmar is an ASEAN country but NOT part of the ASPEC co-operation.

ASPEC is a very practical way to obtain expedited patent grants in ASEAN countries, with some delays to be expected in Thailand.

Most applicants for ASEAN patents chose a patent filing strategy that leverages the swift handling of patent applications by IPOS SG.

Detailed Evaluation



PPH

SG has Patent Prosecution Highway (PPH) bilateral agreements with the European Patent Office (EPO) and with the IP Offices of CN, MX and BR. SG is also part of the Global Patent Prosecution Highway (GPPH) pilot program, a network of 27 participating offices which includes WIPO (= PCT PPH).

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Here is some statistical data for ASEAN patent applications that rely on GPPH for the 6-months period from January 2021 to June 2021.

Singapore: A total of 153 PPH requests, with a grant rate of 100%. First action grant allowance rate: 54% (national PPH) and 49% (PCT PPH). That gives an average number of 0.5 office actions until grant. Average pendency from PPH request to first office action was 5.6 months (national PPH) and 7.2 months (PCT PPH), and 10 months (national PPH) and 11 months (PCT PPH) to final decision.

Malaysia: A total of 104 PPH requests, of which 61 were national PPH and 43 PCT PPH requests. Grant rate 100%. Average number of one (1) office action for both national PPH and PCT PPH. Average pendency from PPH request to first office action 3 months and 6 months to final decision. All PPH requests filed with MyIPO relied on the examination results of the China National Intellectual Property Administration (CNIPA). Guess why.

Philippines: A total of 134 PPH requests which were all PCT PPH requests. Average pendency from PPH request to first office action: 7.6 months, and 13 months to final decision.

Thailand: A total of 198 PPH requests, which were all national PPH requests. All the PPH requests that were filed with DIP relied on the examination results of the Japan Patent Office (JPO). Guess why.

ASPEC

As ASPEC operates in English, the applicant can submit all documents in English, despite some of the participating ASEAN Member States (AMS) IP Offices having different local languages. The ASPEC request can be made through the ASEAN IP online portal with no official fee for filing the request.

The ASPEC request can be filed in one participating AMS IP Office so long as a corresponding patent application in another participating AMS IP Office has at least one allowable claim. The ASPEC request can also be made based on a positive written opinion for all participating AMS IP Offices, except for the IP Office of Thailand, where final search and examination results are still required to be submitted in the ASPEC request.

There are some expedited programs, such as the ASPEC AIM program for Industry 4.0 patent applications and the PCT-ASPEC program which allows the applicant to rely on a PCT report established by an ASEAN International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA). But only IPOS and the IP Office of Philippines currently qualify as ISA or IPEA.



As of July 2021, a total number of 956 ASPEC requests had been submitted. Out of these ASPEC requests, 776 ASPEC requests were relying on a search and examination reports issued by IPOS SG, and there were only 3 PCT-ASPEC requests.

These are the remaining number of ASPEC requests relying on the examination results of the following ASEAN countries:

- Indonesia – 22
- Malaysia – 54
- Philippines – 36
- Thailand – 1
- Vietnam – 6

There is no ASPEC request relying on the examination results of Brunei, Cambodia or Laos, and no, the numbers do not tally. But this is the data that I have.

On average, a first office action will be issued within 8 months after the ASPEC request has been filed. The allowance rate is 95%.

Two Common and Proven Patent Filing Strategies in ASEAN

1. First filing a Singapore patent application under the 12MG or SG IP Fast program, followed by subsequent patent applications filed in the ASEAN countries (option: excluding Laos and Cambodia) claiming the priority of the earlier Singapore application.

Upon issuance of a written opinion or final search and examination report by IPOS, applicant files an ASPEC request to expedite grant in the other ASEAN countries.

There is a “mini-PPH” in place: submitting the final Search & Examination report issued by IPOS to MIH Laos or DIP Cambodia will expedite the grant of the Cambodia or Laos patent application.

Option: under the patent cooperation between IPOS SG and Ministry of Industry & Handicraft (MIH) of Cambodia and Department of Intellectual Property (DIP) of Laos, applicants are able to simply re-register their granted Singapore patents there.

2. The applicant files a PCT application, wherein a positive International Preliminary Examination Report (IPER) or an International Preliminary Report on Patentability (IPRP) being issued. Often, EPO is selected as ISA but it also works with other ISAs.

The applicant files PCT national phase entries in ASEAN countries, but excluding Laos and Cambodia, and (optional) a regional phase entry at EPO.

Applicant submits a PPH request based on the IPER or IPRP to expedite the examination of the SG patent application. Upon issuance of a positive final search and examination report by IPOS SG, applicant files an ASPEC request to expedite grant in the other ASEAN countries.



Upon grant of the SG patent, applicant can re-register the SG patent in Laos and Cambodia.

Alternative option for Cambodia: if an EP patent is granted, validate that EP patent in Cambodia.

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Resources

Intellectual Property Office of Singapore Website:

(Source: <https://www.ipos.gov.sg/about-ip/patents/how-to-register/acceleration-programmes>
(<https://www.ipos.gov.sg/about-ip/patents/how-to-register/acceleration-programmes>))

PPH Portal:

(Source: <https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html> (<https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html>))

Global PPH Portal:

(Source: <https://www.jpo.go.jp/e/toppage/pph-portal/globalpph.html> (<https://www.jpo.go.jp/e/toppage/pph-portal/globalpph.html>))

ASEAN Intellectual Property Portal:

(Source: <https://www.aseanip.org/Statistics/ASEAN-Patent-Examination-Cooperation-ASPEC-Statistics>
(<https://www.aseanip.org/Statistics/ASEAN-Patent-Examination-Cooperation-ASPEC-Statistics>))

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