LIVE AT 10:00 (CEST) / 16.00 (SGT)

WEBINAR: HOW TO TAKE ADVANTAGE OF INTERNATIONAL TREATIES WHEN APPLYING FOR A PATENT IN SOUTH-EAST ASIA?
Welcome to the Webinar

**Moderator:**

Marta Bettinazzi
IP Business Advisor
South-East Asia IPR SME Helpdesk
Webinar Interaction Tool

Webinar 24 hour technical support number: http://support.gotomeeting.com 'Contact Us' section
## Overview (CEST)

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<thead>
<tr>
<th>TIME</th>
<th>OVERVIEW</th>
<th>SPEAKER(s)</th>
</tr>
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<tbody>
<tr>
<td>10:00 – 10:10</td>
<td>Introduction to the South-East Asia IPR SME Helpdesk &amp; its Core Services</td>
<td>Marta Bettinazzi, SEA IPR SME Helpdesk</td>
</tr>
<tr>
<td>10:10 – 10:30</td>
<td>How to take advantage of international treaties when applying for a Patent in South-East Asia?</td>
<td>Wai Yeng Chan, External Expert</td>
</tr>
<tr>
<td>10:30 – 10:45</td>
<td>Q&amp;A session</td>
<td>All speakers</td>
</tr>
<tr>
<td>10:45</td>
<td>Closing</td>
<td>Marta Bettinazzi, SEA IPR SME Helpdesk</td>
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Core Services – What We Offer

Enquiry Helpline

Webinars and E-learning modules

Website & Blog Newsletter, E-Bulletin

Training Workshops

Guides and factsheets

SOUTH-EAST ASIA IPR SME HELPDESK

Speaker’s Bio

Name: Wai Yeng Chan
Firm: Taylor Vinters Via LLC
Location: Singapore

Wai Yeng has over 10 years of experience in Intellectual Property. Prior to joining Taylor Vinters Via, Wai Yeng worked in the IP department of a number of law firms in Singapore and acquired significant experience in patent work including drafting of patent specifications, patent registrations and advising clients in relation to patent infringement.

In addition to handling the patent practice of Taylor Vinters Via, Wai Yeng heads their Brands Practice, working closely with Taylor Vinters in the UK in ensuring that their clients’ brands are protected not only locally but also on a regional and worldwide level.

Wai Yeng has extensive experience in building and protecting brands in emerging markets. In her last role, she headed the IP practice of the largest foreign law firm in Myanmar that supported rights owners in relation to the enforcement, border control, due diligence and protection of trade mark rights.
Agenda

- Overview of standard patent examination process
- Patent Prosecution Highway (PPH)
- ASEAN Patent Examination Cooperation (ASPEC)
- Other solutions to expedite substantive examination
Standard Examination Process

The patent office is responsible for examining patent applications to determine if they satisfy the requirements for patentability.

- Is invention **new**?
- Is invention **not obvious** (inventive)?
- Is invention **useful/industrially applicable**?
The patent office is responsible for examining patent applications to determine if they satisfy the requirement for patentability.
EPO - Average time taken to grant a patent was 44.3 months.
Patents are territorial rights.

Due to globalisation of trade, patent applications for the same invention are being filed in multiple offices.

Duplication work among each patent offices
Inventions with global market potential
The Patent Prosecution Highway (PPH)

Implemented based on a bilateral agreement between two patent offices and allows one patent office to accelerate examination, at the applicant's request, if a corresponding application has been found allowable/patentable by the counterpart patent office.

The PPH is expected to increase the patent grant rate and reduce patenting costs.
The Patent Prosecution Highway (PPH)
Poll Question 1

Question: How many South East Asian countries offer PPH accelerated examination?

A. 6 countries
B. 8 countries
C. 10 countries
Availability of Patent Prosecution Highway (PPH) in South East Asia

<table>
<thead>
<tr>
<th>Country</th>
<th>Established PPH agreements with</th>
</tr>
</thead>
<tbody>
<tr>
<td>Indonesia</td>
<td>JPO</td>
</tr>
<tr>
<td>Malaysia</td>
<td>CNIPA, EPO, JPO</td>
</tr>
<tr>
<td>Philippines</td>
<td>EPO, JPO, KIPO, USPTO</td>
</tr>
<tr>
<td>Singapore</td>
<td>INPI, CNIPA, IMPI, EPO + 26 offices under the GPPH which includes UKIPO, DPMA</td>
</tr>
<tr>
<td>Thailand</td>
<td>JPO</td>
</tr>
<tr>
<td>Vietnam</td>
<td>JPO, KIPO</td>
</tr>
</tbody>
</table>

PPH is not yet available for Brunei, Cambodia, Laos and Myanmar
Basic requirements for requesting PPH

- Patent application for the same invention filed in two patent offices
- One or more claims determined to be patentable/allowable by Office of Earlier Examination (OEE)
- Claims of the application in the Office of Later Examination (OLE) corresponds to claims determined to be patentable/allowable by the OEE
- Request for PPH filed at the same time of requesting examination or if request for examination has been filed, examination has not yet commenced at OLE
Benefits to applicants

**Faster patent grant** - The applicant can obtain patents faster around the world to build a global portfolio quickly.

**Higher grant rate** - PPH applications have been granted at higher rates than non-PPH applications.

**Lower costs** - Fewer number of negative office actions issued for PPH applications have resulted in lower filing costs.
Poll Question 2

Question: What is the current grant rate of Malaysia and Thailand patent applications when PPH is requested?

A. 70% of applications proceed to grant
B. 80% of applications proceed to grant
C. 100% of applications proceed to grant
PPH statistics

Grant Rate

From July to December 2019

- all_applications
- National_PPH
- PCT_PPH

Grant Rate (%)
ASEAN Patent Examination Cooperation (ASPEC)

Sharing of search and examination results between nine (9) participating offices Brunei, Cambodia, Indonesia, Laos, Malaysia, the Philippines, Singapore, Thailand and Vietnam.
ASEAN Patent Examination Cooperation (ASPEC)

✓ May be requested any time before final decision to grant/refusal
✓ Operates in English language
✓ One common form with no additional fee
✓ ASPEC-AIM, PCT-ASPEC

Average pendency rate between request for ASPEC and first office action: 8.1 months
Allowance rate at final decision: 100%
**ASEAN Patent Examination Cooperation (ASPEC)**

ASPEC requests filed predominantly using IPOS as 1\textsuperscript{st} AMS

<table>
<thead>
<tr>
<th>1st AMS</th>
<th>2nd AMS</th>
</tr>
</thead>
<tbody>
<tr>
<td>BN</td>
<td>KH</td>
</tr>
<tr>
<td>BN</td>
<td></td>
</tr>
<tr>
<td>KH</td>
<td>8</td>
</tr>
<tr>
<td>ID</td>
<td>8</td>
</tr>
<tr>
<td>LA</td>
<td>4</td>
</tr>
<tr>
<td>MY</td>
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<tr>
<td>PH</td>
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</tr>
<tr>
<td>SG</td>
<td>69</td>
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<tr>
<td>TH</td>
<td>1</td>
</tr>
<tr>
<td>VN</td>
<td></td>
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</table>

Accelerated patent examination for **Industry 4.0 (Infrastructure and Manufacturing)**

- 2 year pilot running from 27 Aug 2019 to 26 Aug 2021
- First office action to be issued within **6 months**
- Prioritise Industry 4.0 patent applications
- Applicable if the first IP Office determines that the invention is related to Industry 4.0
- Cap of 50 applications per year
- Use of same ASPEC Form
PCT-ASPEC

Broaden the use of ASPEC to rely on PCT examination reports issued from an ASEAN ISA/IPEA

✓ 3 year pilot running from 27 Aug 2019 to 26 Aug 2022
✓ Applicable to PCT examination reports established by ASEAN ISA/IPEA (SG, PH)
✓ Cap of 100 applications per year
✓ Use of same ASPEC Form
Other solutions to expedite/obtain patent grant

<table>
<thead>
<tr>
<th>Country</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>Brunei</td>
<td>PPH+ (JP)</td>
</tr>
<tr>
<td>Cambodia</td>
<td>Accelerated decision (KR, JP), Direct grant (SG, EPO, CN)</td>
</tr>
<tr>
<td>Laos</td>
<td>Accelerated decision (JP, CN), Direct grant (SG)</td>
</tr>
<tr>
<td>Myanmar</td>
<td>Declaration of patent ownership</td>
</tr>
<tr>
<td>Malaysia</td>
<td>Modified Examination (AU, UK, JP, KR, US, EPO)</td>
</tr>
<tr>
<td></td>
<td>Expedited Examination</td>
</tr>
<tr>
<td>Singapore</td>
<td>Supplementary Examination (NZ, CA, KR, EPO, UK, AU, US, JP)</td>
</tr>
<tr>
<td></td>
<td>Accelerated patent examination (SG Patent FT Program, 12 Months File-to-Grant)</td>
</tr>
<tr>
<td>Thailand</td>
<td>Submit grant foreign patents (e.g. US, UK, EP, AU, KR, CN) to aid with substantive examination</td>
</tr>
</tbody>
</table>
## Summary – options to expedite patent grant

<table>
<thead>
<tr>
<th>Country</th>
<th>PPH</th>
<th>ASPEC</th>
<th>Others</th>
</tr>
</thead>
<tbody>
<tr>
<td>Brunei</td>
<td>❌</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Cambodia</td>
<td>❌</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Indonesia</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
</tr>
<tr>
<td>Laos</td>
<td>❌</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Malaysia</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Myanmar</td>
<td>❌</td>
<td>❌</td>
<td>✓</td>
</tr>
<tr>
<td>Philippines</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
</tr>
<tr>
<td>Singapore</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Thailand</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Vietnam</td>
<td>✓</td>
<td>✓</td>
<td>✗</td>
</tr>
</tbody>
</table>
**Case study – Expediting patent grant in Singapore using PPH**

<table>
<thead>
<tr>
<th>Singapore patent application no.</th>
<th>Applicant nationality/invention</th>
<th>OEE</th>
<th>PPH Examination requested</th>
<th>Examination report issued</th>
<th>Results</th>
</tr>
</thead>
<tbody>
<tr>
<td>11201904988S</td>
<td>AU/ promoting hair growth</td>
<td>AUIPO</td>
<td>24 Dec 2019</td>
<td>11 Jun 2020</td>
<td>Objections, examination ongoing</td>
</tr>
</tbody>
</table>

**Diagram:**
- **US/EP/AU application**
- **Allowed claims/Granted patent**
- **PPH**
- **Singapore application**
Statistics – PPH for Singapore applications

Statistics available as of July 2018

- Grant rate: 97.7%
- Average pendency to first response from IPOS: 2.9 months
- Average pendency to grant of patent: 6.8 months
- First action grant allowance rate: 52.3%
- 193 requests made till date
- Average number of office actions to grant of patent: 0.65 months

Statistics are for the cumulative number of PPH requests made at IPOS as of 2 July 2018. *Includes time taken by applicants to respond to office action(s).
## Case study

<table>
<thead>
<tr>
<th>Patent application no.</th>
<th>Applicant nationality / invention</th>
</tr>
</thead>
<tbody>
<tr>
<td>11202001300T</td>
<td>A FIREARM WITH INTERCHANGEABLE SIGHTING DEVICE SYSTEM</td>
</tr>
</tbody>
</table>

- **US application**
- **EP application**
- **Canada application**
- **Korea application**
- **PCT application**
- **Singapore application**
- **Australia patent**
- **Brazil application**

**SOUTH-EAST ASIA IPR SME HELPDESK**

Example – Expediting patent grant based on EP application

- EP application
- Allowed claims/Granted patent
- PPH to Philippines patent
- PPH to Singapore patent
- PPH to Malaysia patent
- Direct grant to Cambodia patent
- Direct grant to Laos patent
Thanks for your attention

Questions?
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<thead>
<tr>
<th>Date</th>
<th>Upcoming Webinar</th>
<th>Speaker</th>
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</table>
| Tue 8 Sep | **What to know about Smart Cities in South-East Asia: Opportunities and Risks** | - Marianne Tan  
Regional Director, Singapore Economic Development Board (EDB)  
- James Kinnaird  
External Expert, SEA IPR SME Helpdesk.  
Partner, Marks & Clerk Singapore LLP. |
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