

# Plain packaging

the-counter sales may not only include 'grey imports' but also counterfeits, which could be packed with dangerous chemicals such as higher levels of toxic heavy metals than those found in legitimate cigarettes.

To really help more people stop smoking (and fewer people start smoking), we should make nicotine replacement products such as gum, mints, inhalers and the like available in all the places cigarettes are (and were) available, such as in newsagents and pubs. That way, should a person who is trying to give up run out of nicotine replacement on a night out, they will be able to obtain further nicotine replacement. When I gave up, such products were only available in chemists and large supermarkets in the chemists section; thus one had to plan in advance how many 'replacements' one might need. If one were to run out on a night out, alcohol would inevitably cause one to crack and a ten pack of cigarettes would be purchased. The problem is that if one did not smoke them all that night or throw away the half smoked packet then there would be further temptation first thing in the morning, which could result in a full day of smoking and falling off the wagon completely. It might be suggested that alcohol be avoided whilst giving up smoking – however, try doing that in our profession with the ample supplies of 'free' wine after lectures and a Northern persuasion! Thus the other thing that could be done is to make tobacco

products only available in a combination of expensive single cigarettes (rather like cigars) for a short evening fall off the wagon and expensive large quantity packets to make people think: 'do I really want to buy that many cigarettes?' before purchasing.

I believe if we, as a country, wish to quit smoking then tobacco should be made illegal, with nicotine made available on the NHS. It rather frustrates me that none of the measures regarding the restriction of trade mark use and branding that have been or are planned to be introduced would have had any impact on me as a smoker other than further entrench me in my brand of choice, and there are much more effective measures that could be introduced without setting dangerous precedents eroding trade marks. One worries what might be attacked next as alcohol packaging is already starting to go the way of tobacco products with written health warnings, and confectioners are considering incorporating health warnings onto their packaging to avoid future damages claims from overweight consumers of the products. One really does worry that plain packaging may be the beginning of a very slippery slope and that all we will be left with are 'victory cigarettes' and 'victory gin'.

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## Patent prosecution highway in China



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The purpose of the patent prosecution highway is to ease the examination workload of patent offices around the world. The underlying principle is to share examination results among various offices in order to speed up patent prosecution.

China has had the highest number of patent applications in the last few years. The number of invention patent applications, the kind of patent applications that require substantive examination in China, increased from about 390,000 in 2010 to about 650,000 in 2012. Although China is the perfect candidate for the patent prosecution highway (PPH), China only recently launched a PPH pilot programme. This article gives a glimpse of how PPH will be implemented in China in the future.

As in other countries, a PPH request in China incurs no official fee.

### Pilot phase

PPH in China is still in the pilot phase. The pilot programme was started on 1 November 2012 and is supposed to end on 31 October 2013, but may be extended to receive a sufficient number of cases to evaluate the feasibility of the PPH programme. However,

the pilot programme could be stopped at any time, for example if the volume of PPH requests filed is beyond a manageable level.

### Basic requirements on Chinese application filing for PPH requests

The subject Chinese application must fulfill all of the following requirements for acceptance of the PPH request:

- The subject Chinese application must be filed online; PPH requests for applications filed on paper will not be accepted.
- The subject Chinese application must have entered the substantive examination stage, i.e. a Notice of Entrance into Substantive Examination Stage has already been issued. This Notice will only be issued after the subject Chinese application is published and a request for examination is filed.

## Countries signed up for the PPH pilot programme in China

For the PPH pilot programme started in 2012, these are the “seven PPH-CN-2012 countries”:

- Japan
- US
- Germany
- South Korea
- Russia
- Denmark
- Finland

- No office action (i.e. examination report) has been issued before the PPH request is filed.
- All of the claims in the subject Chinese application must substantially correspond to the foreign application on which the PPH request is relied (the “substantial correspondence” requirement). Whether the two sets of claims “substantially correspond” to each other is mainly determined by the types and/or the number of claims included. For example, if the foreign application contains only apparatus claims and the Chinese application contains apparatus claims and method of manufacturing claims, then The State Intellectual Property Office of the People’s Republic of China (SIPO) will consider that the two sets of claims do not substantially correspond to each other. On the other hand, the SIPO accepts PPH requests in which the Chinese application contains less types and/or number of claims than the foreign application.

Because of the “substantial correspondence” requirement, it is advisable to amend the Chinese application, if necessary, to bring the claims of the Chinese and foreign applications in line. The best opportunity is during the three-month period after the Notice of Entrance into Substantive Examination Stage, during which voluntary amendments can be entered, and the PPH request can be filed with the voluntary amendments simultaneously.

## PCT PPH

Other than the above, the following requirements must be fulfilled if search / examination results of a PCT application on which a Chinese application is based are to be used for the PPH request:

- The international search authority (ISA) and/or the international preliminary examination authority (IPEA) must be one of the seven PPH-CN-2012 countries, i.e. Japan, US, Germany, South Korea, Russia, Denmark or Finland.

- Only the written opinion (WO), international preliminary report on patentability (IPRP) or international preliminary examination report (IPER) can be used, i.e., if only an international search report (ISR) is issued, then the SIPO will not accept the PPH request.

- Box No. VIII of WO/IPER (certain observations on the international application on clarity and/or support) must not have any opinion.

Whether the receiving office (RO) is one of the seven PPH-CN-2012 countries is irrelevant to whether the PPH request would be accepted in China.

## Normal or non-PCT PPH

Here, normal or non-PCT PPH refers to use of prosecution results from non-PCT applications, for example from a Japanese or US application.

Other than the basic requirements outlined above, the following requirements must be fulfilled for a normal PPH request:

- The subject Chinese application must either: (a) claim priority from a patent application filed in any of the seven PPH-CN-2012 countries; or (b) be based on a PCT application claiming no priority, i.e. Chinese national phase entry of the PCT application, or a Chinese application claiming priority from this PCT application. In the case of (b), naturally the PCT application must have a corresponding application in one of the seven PPH-CN-2012 countries.
- The foreign application must have at least one notification clearly indicating at least one claim is patentable, for example in the form “no reason to refuse the grant of claim XXX is found” or “claim XXX is found to be allowable”. The notification can be any one of: decision to grant; decision of rejection; appeal decision; or examination report. Therefore, an examination report that only raises objections without clearly indicating what claims are allowable cannot be used to file a PPH request in China.

## PPH request is applicable to divisionals

Naturally, a PPH request is applicable to divisional applications. However, the “substantial correspondence” of the claims requirement still holds and should be observed.

## Materials needed for a PPH request in China

The followings are required:

- a. Identification of the relationship of the subject Chinese application and the foreign application, for example in the form “this application claims priority from US

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application no. XX/XXX,XXX” or “this application is the Chinese national phase entry of PCT/XXXXXX/XXXXXX”.

- b. Copies of all relevant prosecution documents of the foreign application, which include all search reports, examination reports, rejection decision, WO, IPRP, IPER, and so on, and their Chinese or English translations if these are not available in Chinese or English. At least one of these documents must clearly indicate that at least one claim in the foreign application is patentable. This usually would not be an issue for WO, IPRP and IPER, which typically identify patentable claims positively if applicable.
- c. Copies of all non-patent references cited in the prosecution documents of b) above. It is *not* necessary to submit Chinese or English translations of such references to the SIPO.
- d. Identification showing the correspondence between the claims of the subject Chinese application and the foreign application, for example in the form of a table as below:

Claims in this CN application	Claims in the foreign application	Correspondence
1	1	Exactly the same
2	-	Deleted
3	1	Based on claim 1 of foreign application with added features X from line Y page Z of the specification

## Exceptions with regard to b)

Some patent offices provide their prosecution documents in English online. For example the Japanese Patent Office does so through Advanced Industrial Property Network (AIPN, not accessible to the public but accessible to the examiners at the SIPO, which provides machine English translations of Japanese prosecution histories), and the USPTO does so through a much more convenient and accessible Patent Application Information Retrieval (PAIR) system. In such a case, it is not necessary to submit all relevant prosecution documents. However, it is still required to submit the prosecution document clearly indicating that at least one claim in the foreign application is patentable.

Naturally, the SIPO can ask for submission of documents that are later found to be not available, and/or where the

available Chinese/English translations are deemed to be incomprehensible, including any prosecution documents and their Chinese or English translations, and patent references.

## Effect of the PPH request

After acceptance of the PPH request, the subject Chinese application will still go through full examination. Therefore, any one of the following objections could be raised during examination in China:

- New references against novelty and/or inventiveness of the claims may be found and cited.
- Objections against subject-matter (particularly likely for US-based applications), support, sufficiency, and/or clarity may be raised.
- The Chinese examiner may disagree with the opinions in the foreign application, and raise novelty/obviousness objections using the same references cited therein, for example due to different standards of prior art base.

Therefore, it appears that a PPH request in China would only result in the subject Chinese application being examined earlier, i.e. being put in the front of the examination queue.

However, according to the writer’s firm’s experiences, the acceleration is very significant. In one case, the SIPO issued a notification accepting the PPH request in 12 days. Then a first office action was issued in about six weeks after the issuance of the notification. In comparison, for a Chinese invention patent application with no PPH request, a first office action would be issued in 12 to 16 months after entrance into the substantive examination procedure. As such, the PPH mechanism can significantly reduce the pending time of a Chinese application.

## The road ahead

If the PPH mechanism in China can run as smoothly as the pilot programme, and more countries are involved, then it is hoped that applicants could use PPH in China to reduce prosecution time by almost 12 months. If the SIPO adopts a reasonable and more pragmatic approach regarding translations of prosecution documents by allowing use of English translations, this would significantly reduce translation costs involved in filing PPH requests in China. Accordingly, patent offices operating in English – including the UK’s IPO, the EPO, the Canadian Intellectual Property Office, IP Australia – are encouraged to join the PPH programme in China, allowing more applicants to benefit from the mechanism.

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