

Procedures to file a request to the JPO for Patent Prosecution Highway Pilot Program between the JPO and the HPO

1. Request to the JPO

When an applicant files a request for an accelerated examination under the Patent Prosecution Highway (hereinafter called “PPH”) Pilot Program to the JPO, an applicant must submit a request form “The Explanation of Circumstances Concerning Accelerated Examination” based on the procedure prescribed in “the Guidelines of the Accelerated Examination and Appeal.”¹ Under the PPH Pilot Program, an applicant is not required to fill in the section “2. the disclosure of prior arts and comparison between the claimed invention and prior art” in “The Explanation of Circumstances Concerning Accelerated Examination”, if the application filed to the JPO satisfies all the conditions prescribed in the following item (1) and the applicant attaches to “The Explanation of Circumstances Concerning Accelerated Examination” the documents specified in the following item (2).

(1) Requirements for requesting an accelerated examination under the PPH pilot program at the JPO

(a) *The JPO application (including PCT national phase application) is*

- (i) an application which validly claims priority under the Paris Convention to the HPO application(s) (examples are provided in Annex, figure A, B, H, I, J and K), or
- (ii) a PCT national phase application without priority claim (examples are provided in Annex, figure L), or
- (iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in Annex, figure M, N and O).

The JPO application, which validly claims priority to multiple HPO or PCT applications, or which is the divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible.

(b) *At least one corresponding application exists in the HPO and has one or more claims that are determined to be patentable by the HPO.*

Claims clearly identified to be patentable in the latest office action at examination stage are able to be a base of a request for an accelerated examination under the PPH pilot

¹ http://www.jpo.go.jp/torikumi/t_torikumi/souki/pdf/v3souki/guideline.pdf

“The Explanation of Circumstances Concerning Accelerated Examination” is described on pages 27-29.

program, even if the application, which includes those claims is not granted for patent yet. The following case will fall within this interpretation: When a HPO examiner sends a notification specifying the HPO's intention to grant. The headings for such notifications will be "Communication of Approval" (The heading of the communication is "*Felhívás nyilatkozattételre és megadási díj megfizetésére*").

- (c) ***All claims on file in the JPO, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the HPO.***

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the JPO are of the same or similar scope as the claims in the HPO, or the claims in the JPO are narrower in scope than the claims in the HPO. In this regard, a claim that is narrower in scope occurs when a HPO claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims). Preferably, the claim should be presented in dependent form.

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

Note that if claims have been determined to be patentable by the HPO after making amendments to the claims, claims filed with the JPO usually need to be amended in a similar way to sufficiently correspond to the allowable/patentable claims in the HPO application.

- (d) ***The JPO has not begun examination of the application.***

(2) Documents to be submitted by applicant

Documents (a) to (d) below must be submitted by attaching to "The Explanation of Circumstances Concerning Accelerated Examination".

Note that even when it is not needed to submit documents below, the name of the documents must be listed in "The Explanation of Circumstances Concerning Accelerated Examination" (Please refer to the Example form for the detail).

- (a) ***Copies of all office actions¹ in the HPO, which were sent for the corresponding***

¹ Office actions are documents which relate to substantive examination.

application by the HPO, and translations of them¹.

Both Japanese and English are acceptable as translation language.²

If the applicant would prefer, they can request the JPO to obtain electronic copies of all office actions directly from the HPO. In this case, the applicant should clearly express the intent in “The explanation of circumstances concerning accelerated examination” as (*) in example form. Please note that translations and paper copies of the office actions cannot be requested directly from the HPO. (Please refer to the **Example form** for the detail.)

(b) *Copies of all claims determined to be patentable by the HPO, and translations of them.*

Both Japanese and English are acceptable as translation language³.

If the applicant would prefer they can request the JPO to obtain electronic copies of all claims determined to be patentable by the HPO directly from the HPO. In this case, the applicant should clearly express the intent in “The explanation of circumstances concerning accelerated examination” as (*) in example form. Please note that translations and paper copies of the claims cannot be requested directly from the HPO. (Please refer to the **Example form** for the detail.)

(c) *Copies of references cited by HPO examiner*

If the references are patent documents, the applicant doesn't have to submit them because the JPO usually possess them. When the JPO 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.

The translations of the references are unnecessary.

(d) *Claim correspondence table*

Applicant must submit a claim correspondence table, which indicates how all claims in the JP application sufficiently correspond to the allowable/patentable claims in the HPO application.

When claims are just literal translation, the applicant can just write down that “they are same” in the table. When claims are not just literal translation, it is necessary to explain the

¹ Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

² As soon as HPO's dossier access system becomes operational and copies and translations of all office actions are available for the JPO via this system, an applicant will not have to submit them to the JPO.

³ As soon as HPO's dossier access system becomes operational and copies and translations of all allowable claims are available for the JPO via this system, an applicant will not have to submit them to the JPO.

sufficient correspondence of each claim based on the criteria (1) (c) (Please refer to the **Example form**).

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

2. Example of “The Explanation of Circumstances Concerning Accelerated Examination” for filing request an accelerated examination under the PPH pilot program

(1) Circumstances

The applicant must indicate that the application is included in (i) to (iii) of (1) (a), and the accelerated examination is requested under the PPH pilot program. And the application number of the corresponding HPO application(s) also must be written.

*In the case that the application which has one or more claims that are determined to be patentable is different from the one included in (i) to (iii) of (1) (a) (for example, the divisional application of the basic application), the application number of the application(s) which has claims determined to be patentable and the relationship between those applications also must be written.

(2) Documents to be submitted

The applicant must list all required documents mentioned above 1(2) in an identifiable way, even when applicant omits to submit certain documents.

(3) Notice

Forms of “The Explanation of Circumstances Concerning Accelerated Examination” are different between on-line procedure and paper procedure. Please refer to the examples of forms when filling in (“Form 1 for Accelerated Examination” for on-line procedures, and “Form 2 for Accelerated Examination” for paper procedures.).

Example form of on-line procedures

【書類名】 早期審査に関する事情説明書

The name of this paper

【提出日】 平成00年00月00日

Date of filing

【あて先】 特許庁長官殿

Destination

【事件の表示】

【出願番号】 特願 0000-000000

Application number

【提出者】

【識別番号】 000000000

【住所又は居所】 〇〇県〇〇市〇丁目

【氏名又は名称】 〇〇〇〇〇

The name and address of who submit this

【代理人】

【識別番号】 000000000

【住所又は居所】 〇〇県〇〇市〇丁目

【氏名又は名称】 〇〇 〇〇

The name and address of the attorney

Bibliographical items

【早期審査に関する事情説明】

The explanation of circumstances concerning accelerated examination

1. 事情

本出願はハンガリー特許登録庁への出願(特許出願番号0000000)をパリ条約に基づく優先権の基礎出願とする出願であり、特許審査ハイウェイ試行プログラムに基づく早期審査の申請を行うものである。

1. Circumstances

This application is an application validly claiming the priority under the Paris Convention to the corresponding HPO application (the application number is 0000000), and the accelerated examination is requested under the PPH pilot program.

(提出を省略する物件)

(物件名) **年**月**日付の対応ハンガリー出願に対する調査報告書の写し

(日本国特許庁がハンガリー特許庁から直接入手することを希望する。)

(物件名) **年**月**日付の対応ハンガリー出願に対する拒絶理由通知書の写し

(日本国特許庁がハンガリー特許庁から直接入手することを希望する。)

(物件名) **年**月**日付の対応ハンガリー出願に対する特許査定書の写し

(日本国特許庁がハンガリー特許庁から直接入手することを希望する。)

(物件名) 対応ハンガリー出願の特許公報であるハンガリー特許第000000号公報

(物件名) 対応ハンガリー出願に対して引用されたドイツ出願公開000000号公報

(物件名) 対応ハンガリー出願に対して引用された日本国特許第000000号公報

(Documents to be omitted to submit)

(The name of the document) Copy of search report in the HPO on (date)

(I prefer the JPO to obtain this directly from the HPO)(*)

(The name of the document) Copy of examination report in the HPO on (date)

(I prefer the JPO to obtain this directly from the HPO)(*)

(The name of the document) Copy of notification of grant in the HPO on (date)

(I prefer the JPO to obtain this directly from the HPO)(*)

(The name of the document) Corresponding application's patent publication:
Hungary Patent number 0000000

(The name of the document) Cited reference of the corresponding HPO application:
Germany Publication of application 0000000

(The name of the document) Cited reference of the corresponding HPO application:
Japan Patent publication of application 0000000

以下において、「引用非特許文献1」とは、「村岡洋一著、「コンピュータサイエンス大学講座(第11巻) コンピュータ・アーキテクチャ」、第2版、株式会社近代科学者、1985年11月、p.123-127」である。

In what follows, “non-patent literature1” is “Yoichi Muraoka, Lecture of Computer Science (vol.11) computer architecture, 2nd edition, Scientist com, Nov. 1985, p.123-127.”

If the name of the document is long (over than 50 letters), it is impossible to write it down directly to the column “【物件名】.” Please write down the full name of the document in the column “【早期審査に関する事情説明】” and name it properly. Then write the name in the column “【物件名】.”

【提出物件の目録】

The list of submitted documents

List up the documents to be submitted

【物件名】 ハンガリー出願と本出願の請求項の対応関係を示す書面 1

(The name of the document) The table to explain how the claims indicated as allowable in the HPO sufficiently correspond to the claims in the JPO application

【物件名】 引用非特許文献 1

(The name of the document) Cited non patent literature 1

【物件名】**年**月**日付の対応ハンガリー出願に対する調査報告書の和訳 1

(The name of the document) Japanese translation of search report in the HPO on (date) 1

【物件名】**年**月**日付の対応ハンガリー出願に対する拒絶理由通知書の和訳 1

(The name of the document) Japanese translation of examination report in the HPO on (date) 1

【物件名】**年**月**日付の対応ハンガリー出願に対する特許査定書の和訳 1

(The name of the document) Japanese translation of notification of grant in the HPO on (date) 1

Use the same name as “【物件名】” under “【提出物件の目録】.”

Attach the document here as image file or text.

【添付物件】

The list of attached documents

【物件名】 ハンガリー出願と本出願の請求項の対応関係を示す書面

The table to explain how the claims indicated as allowable in the HPO sufficiently correspond to the claims in the JPO application

【内容】

| 本出願の請求項 | ハンガリーで特許可能とされた請求 | 対応関係に関するコメント |
|----------------------|---------------------------------|---|
| The claim in the JPO | The patentable claim in the HPO | Comments about the correspondence |
| 1 | 1 | 両クレームは同一である。 Both claims are the same. |
| 2 | 2 | ” |
| 3 | 1 | 両クレームは、記載形式を除き同一である。 Both claims are the same except the claim format. |
| 4 | 2 | ” |
| 5 | 1 | 請求項5は、ハンガリーの請求項1にAという構成を付加したものである。 The claim 5 in the JPO adds the composition A to the Claim 1 in the HPO |

【物件名】 引用非特許文献1

Non-patent literature1

Use the same name as “【物件名】” under “【提出物件の目録】.”

【内容】

Attach the copy of the document.

【物件名】**年**月**日付の対応ハンガリー出願に対する調査報告書の和訳 1

Japanese translation of search report in the HPO on (date) 1

【内容】

Attach the copy of the document.

【物件名】**年**月**日付の対応ハンガリー出願に対する拒絶理由通知書の和訳 1

Japanese translation of examination report in the HPO on (date) 1

【内容】

Attach the copy of the document.

【物件名】**年**月**日付の対応ハンガリー出願に対する特許査定書の和訳 1

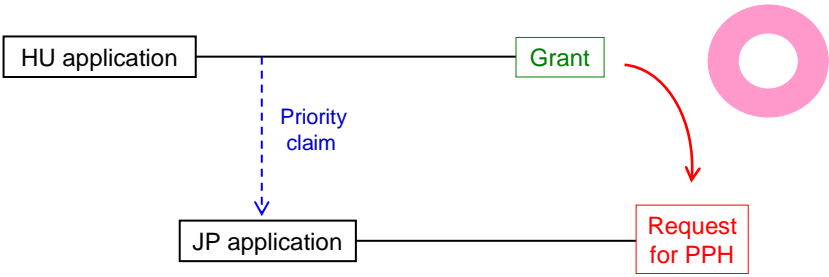
Japanese translation of notification of grant in the HPO on (date) 1

【内容】

Attach the copy of the document.

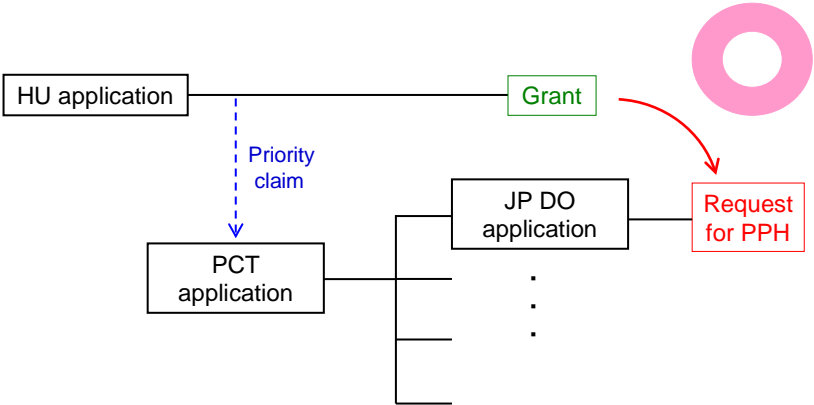
A

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

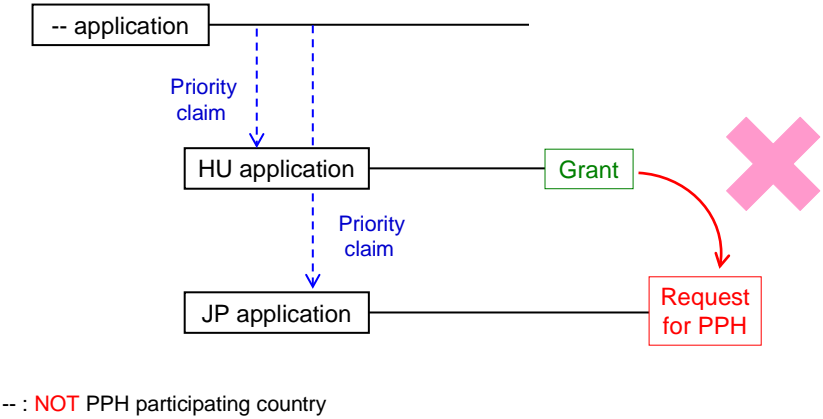


B

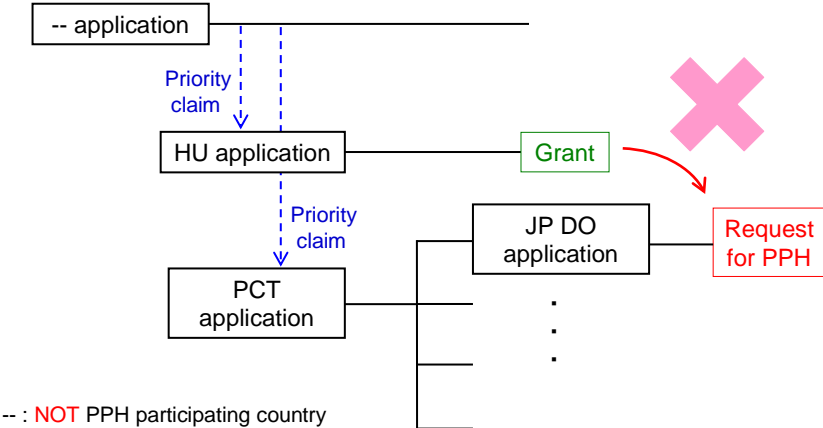
A case meeting requirement (a) (i)
- PCT route -



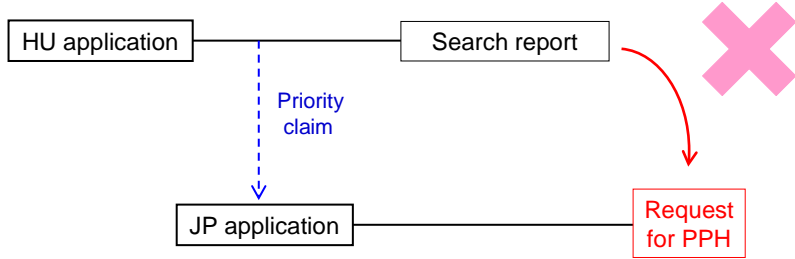
C A case not meeting requirement (a)
- Paris route, but the first application is from the third country -



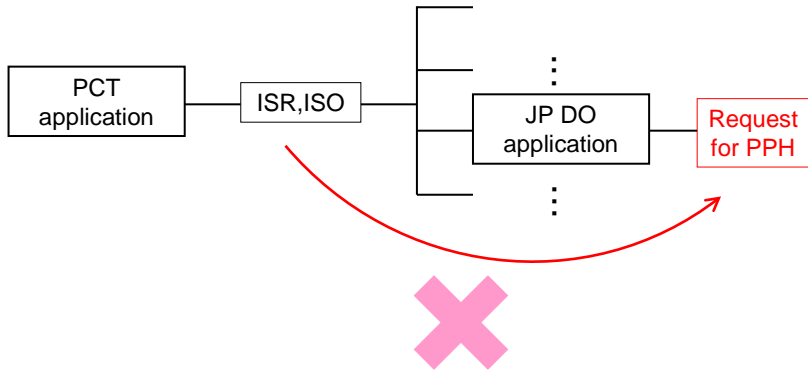
D A case not meeting requirement (a)
- PCT route, but the first application is from the third country -



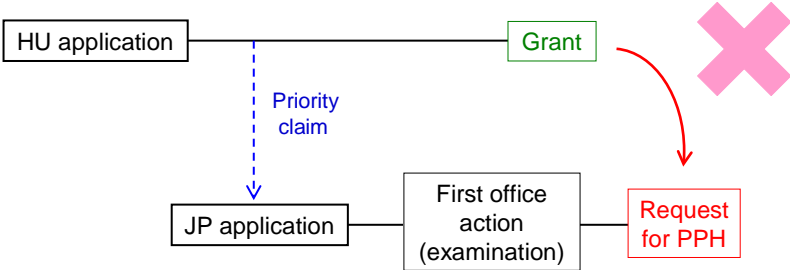
E A case not meeting requirement (b)
- Search report -



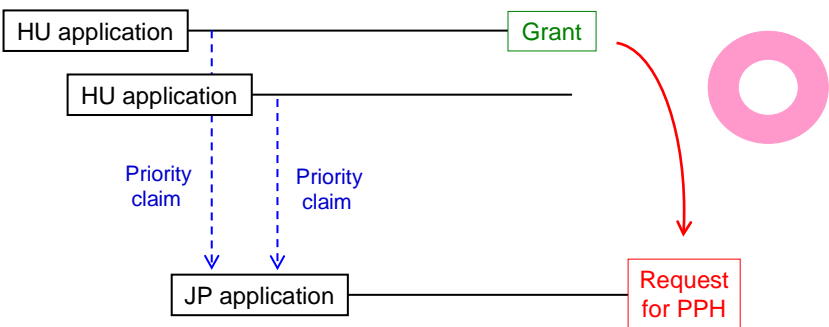
F A case not meeting requirement (b)
- ISR, ISO -



G A case not meeting requirement (d)
- Examination has begun before a request for PPH -

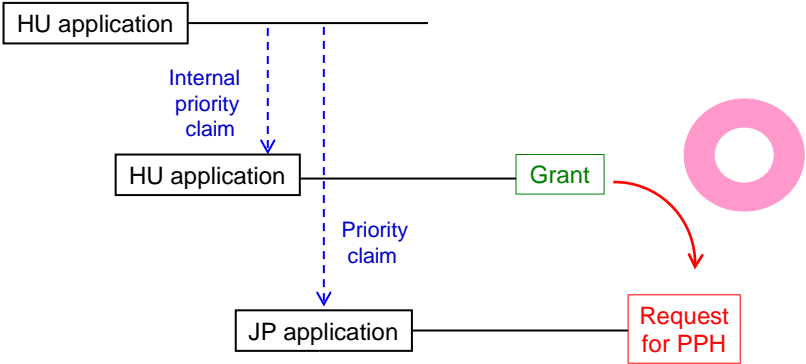


H A case meeting requirement (a) (i)
- Paris route & Complex priority -



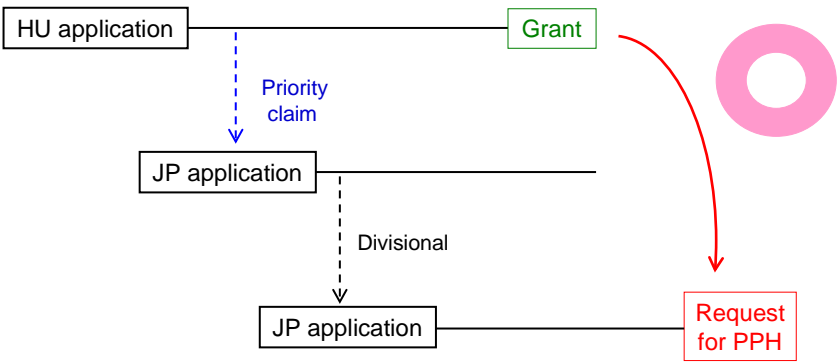
I

A case meeting requirement (a) (i)
- Paris route & Internal priority -



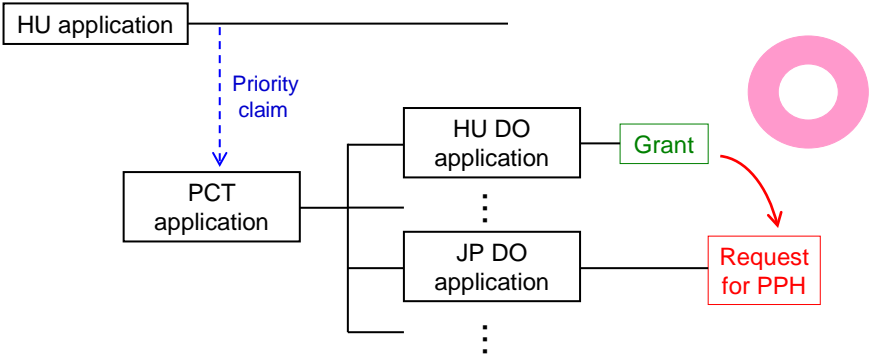
J

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



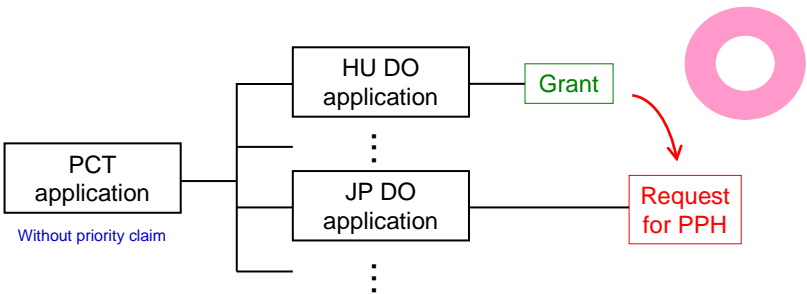
K

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

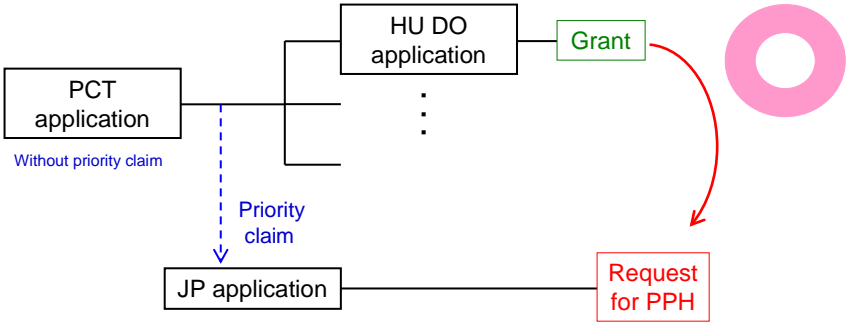


L

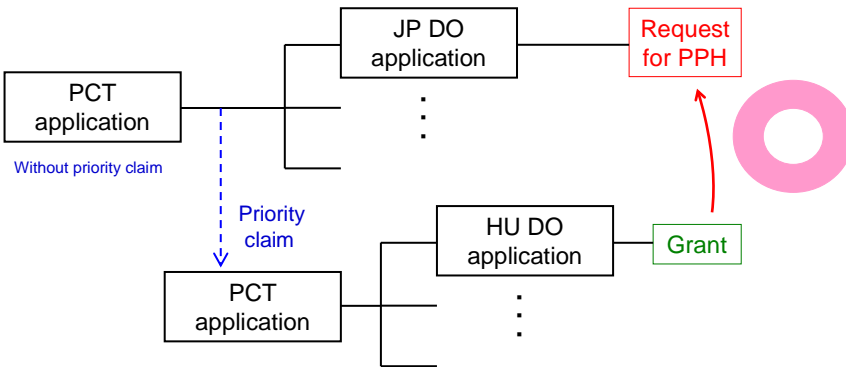
A case meeting requirement (a) (ii)
- Direct PCT route -



M A case meeting requirement (a) (iii)
- Direct PCT & Paris route -



N A case meeting requirement (a) (iii)
- Direct PCT & PCT route -



O A case meeting requirement (a) (iii)
- Direct PCT & PCT route -

