

Patent Prosecution Highway pilot programme between the European Patent Office and the Japan Patent Office based on national work products

I. Background

The Patent Prosecution Highway pilot programme (PPH) between the European Patent Office (EPO) and the Japan Patent Office (JPO) based on national work products was launched on 29 January 2010.

The EPO and the JPO have agreed to revise the participation requirements and extend the trial period for the Patent Prosecution Highway Programme until 28 January 2014, with effect from 29 January 2012.

The Patent Prosecution Highway leverages fast-track patent examination procedures already available at both offices to allow applicants to obtain corresponding patents faster and more efficiently. It also permits each office to exploit the work previously done by the other office.

The present notice replaces that published in the OJ EPO 2010, 57 f.

II. Patent Prosecution Highway pilot programme using JPO national work products

The PPH enables an applicant whose claims have been determined to be patentable/allowable to have a corresponding application filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results.

Where the EP application contains claims that are determined to be patentable/allowable, the applicant may request accelerated examination at the JPO for the corresponding application filed with the JPO. The procedures and requirements for filing a request with the JPO for participation in the PPH pilot programme before the JPO are available from the JPO website at www.jpo.go.jp.

Where the JP application contains claims that are determined to be patentable/allowable, the applicant may request participation in the PPH pilot programme at the EPO for the corresponding application filed with the EPO.

With effect from 29 January 2012, the procedures and requirements for filing a request with the EPO for participation in the PPH pilot programme **on the basis of national work products established during the processing of a national application before the JPO or a PCT application that has entered the national phase before the JPO** are set forth below (B) and apply to PPH requests made on or after 29 January 2012.

With regard to the utilisation of PCT international phase work products (WO/ISA, WO/IPEA and IPER) established by the JPO in its capacity as ISA and/or IPEA, reference is made to the Trilateral PCT PPH pilot programme.

A. Trial period for the PPH pilot programme

The PPH pilot programme with the revised requirements will commence on 29 January 2012, for a period of two years ending on 28 January 2014. The revised requirements will apply to PPH requests filed with the EPO on or after 29 January 2012.

The EPO and the JPO will evaluate the results of the pilot programme to determine whether and how the programme should be fully implemented after the trial period. The offices may also terminate the PPH pilot programme early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if the PPH pilot programme is terminated before 28 January 2014.

B. Requirements for requesting participation in the PPH pilot programme at the EPO

In order to be eligible to participate in the PPH pilot programme at the EPO, the following requirements must be met:

(1) The EP application for which participation in the PPH pilot programme is requested and the corresponding JP application must have the same priority/filing date. In particular the EP application, including a Euro-PCT application:

(Case I) is an application that validly claims the priority of one or more applications filed with the JPO (see Annex, tables A, B, C and D);

or

(Case II) is an application which is the basis of a valid priority claim for the application filed with the JPO (see Annex, tables E, F and G);

or

(Case III) is an application which shares a common priority document with the application filed with the JPO (see Annex, tables H, I, J, K and L);

or

(Case IV) and the JP application are derived from a PCT international application having no priority claim (see Annex, table M).

(2) The corresponding JP application(s) has/have at least one claim indicated by the JPO to be patentable/allowable¹.

(3) The claims in the EP application for which a request for participation in the PPH pilot programme is made must sufficiently correspond or be amended to sufficiently correspond to the patentable/allowable claims in the corresponding JP application(s). Claims are considered to sufficiently correspond where, accounting for differences due to claim format requirements, the claims are of the same or a similar scope or the claims in the EP application are narrower in scope than the claims in the JP application(s). In this regard, a claim that is narrower in scope occurs when a JPO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). Additionally, a claim in the EP application which introduces a new/different category of claims than those indicated to be allowable/patentable by the JPO is not considered to sufficiently correspond. For example, where the JPO claims only contain claims to a process of manufacturing a product, then the claims in the EP application are not considered to sufficiently correspond if the EP claims introduce product claims that are dependent on the corresponding process claims. **The applicant is required to submit a declaration that the claim(s) sufficiently correspond between the EP and JP applications.**

¹ Claims are indicated to be allowable/patentable when the JPO examiner clearly identified the claims to be allowable/patentable in the latest office action. The office action includes:

- (a) Decision to Grant a Patent
- (b) Notification of Reasons for Refusal
- (c) Decision of Refusal
- (d) Appeal Decision.

If the following standard expression is described in the "Notification of Reasons for Refusal", those claims are clearly identified to be allowable/patentable:

"<Claim(s) which has (have) been found no reason for refusal>

At present for invention concerning Claim __, no reason for refusal is found."

(4) Examination of the EP application for which participation in the PPH pilot programme is requested has **not** begun.

C. Documents required for participation in the PPH pilot programme at the EPO

For participation in the PPH pilot programme at the EPO the applicant has to:

(1) file a request for participation in the PPH pilot programme. A request form (EPA/EPO/OEB 1009 JP) is available via the EPO website at *www.epo.org*;

(2) file a declaration of claims correspondence (tick the appropriate box in the PPH request form);

(3) submit a copy of all the office actions for the JP application(s) containing the patentable/allowable claims that are the basis for the request, and a translation thereof into one of the EPO official languages;

(4) submit a copy of the patentable/allowable claim(s) from the JP application(s) and a translation thereof into one of the EPO official languages;

(5) submit copies of all the documents other than patent documents cited in the JPO office action(s).

Where the request for participation in the PPH pilot programme is granted, the applicant will be notified and the EP application will be processed in an accelerated manner. In those instances where the request for participation in the PPH pilot programme 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 be given **one** opportunity to correct any deficiencies in the request. If the request is not corrected, the applicant will be notified.

If any of the documents identified in points (3) and (4) above

(a) have already been filed in the EP application prior to the request for participation in the PPH pilot programme, it will not be necessary for the applicant to resubmit these documents with the request for participation. The applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot programme when these documents were previously filed in the EP application.

(b) are available via AIPN (Advanced Industrial Property Network), the applicant does not need to submit a copy thereof, but has to provide a list of the documents to be retrieved. If the translation(s) of the document(s) provided via AIPN is (are) not sufficient, the OSF examiner can request the applicant to submit an accurate translation. If the JP application(s) is (are) unpublished, the applicant must submit the documents identified in points (3) and (4) above and a translation thereof upon filing the PPH request.

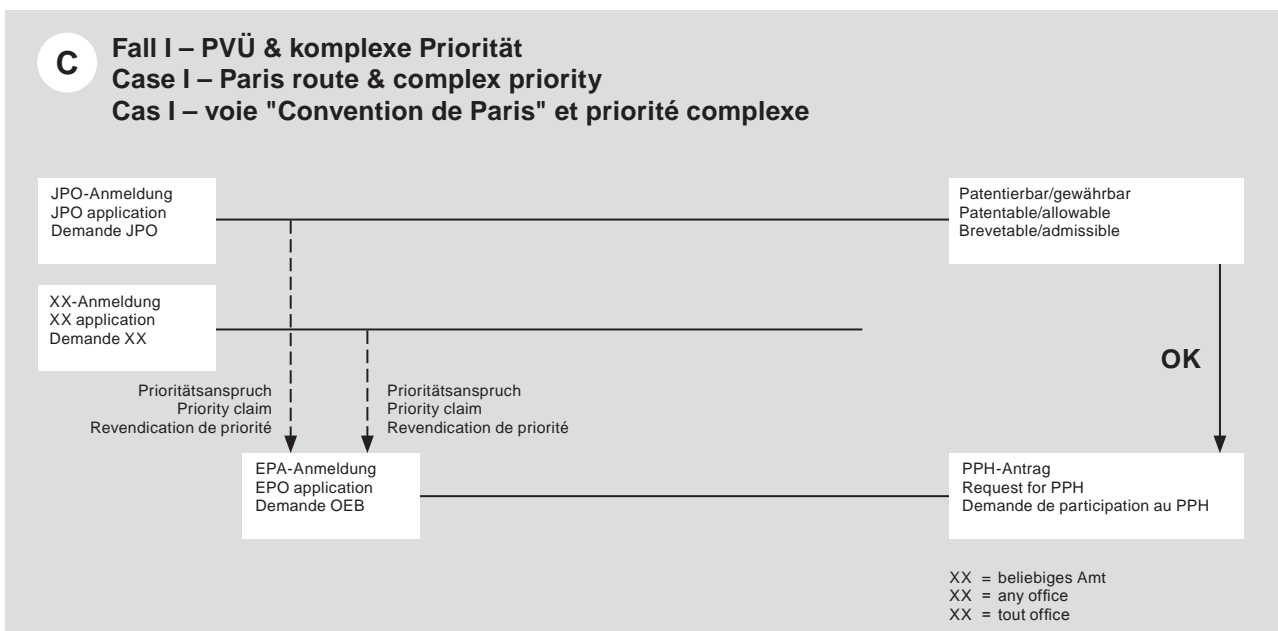
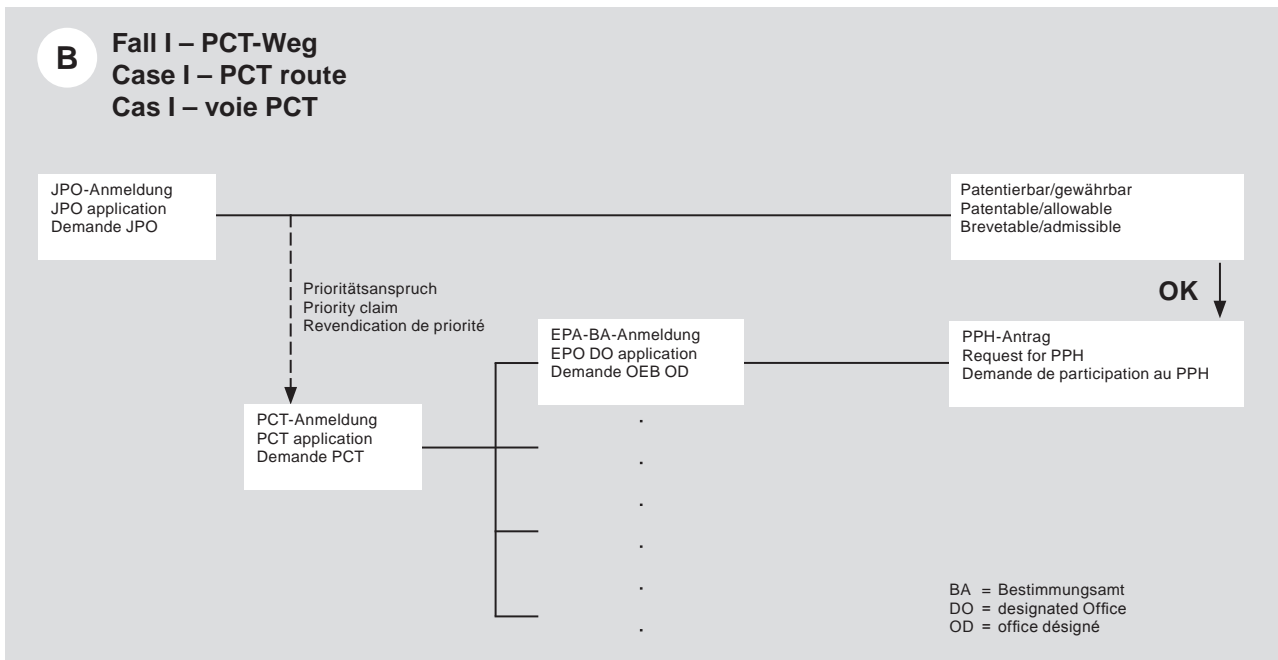
The EPO may request certified copies of the documents identified in points (3) and (4) above.

D. Prosecution under PACE

Once the request for participation in the PPH pilot programme has been granted, the EP application will be processed in an accelerated manner under PACE².

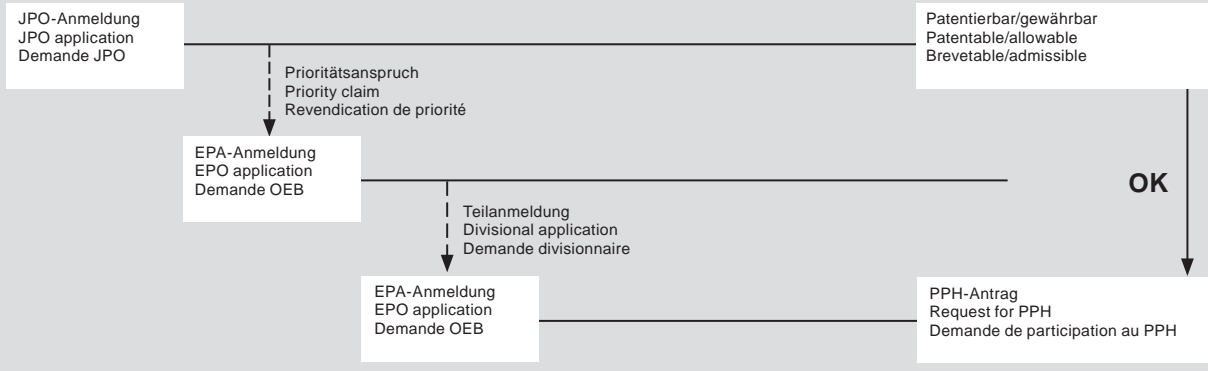
Any inquiries concerning this notice may be directed to Eugen Stohr, Director, International Legal Affairs, PCT, at *international_legal_affairs@epo.org*.

² Notice from the EPO dated 4 May 2010 concerning the programme for the accelerated prosecution of European patent applications - "PACE", OJ EPO 2010, 352.



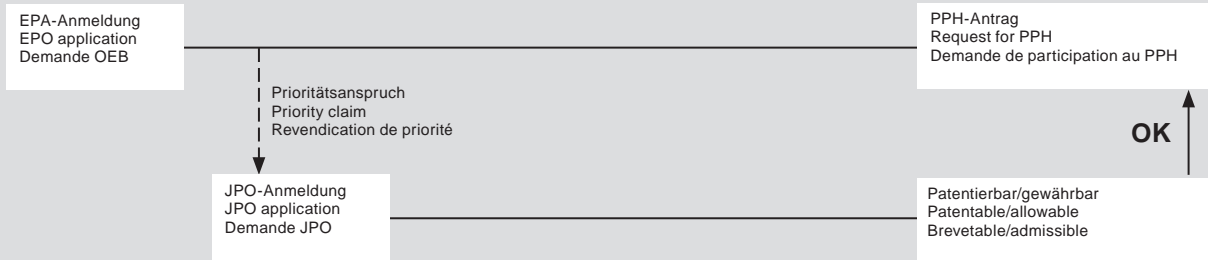
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Fall I – PVÜ & Teilanmeldung
Case I – Paris route & divisional application
Cas I – voie "Convention de Paris" et demande divisionnaire



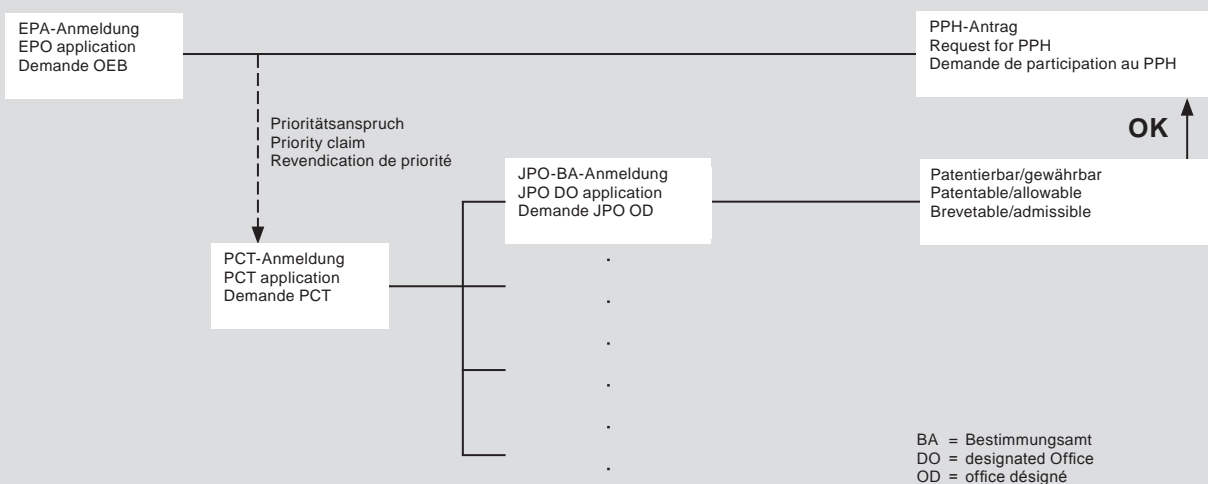
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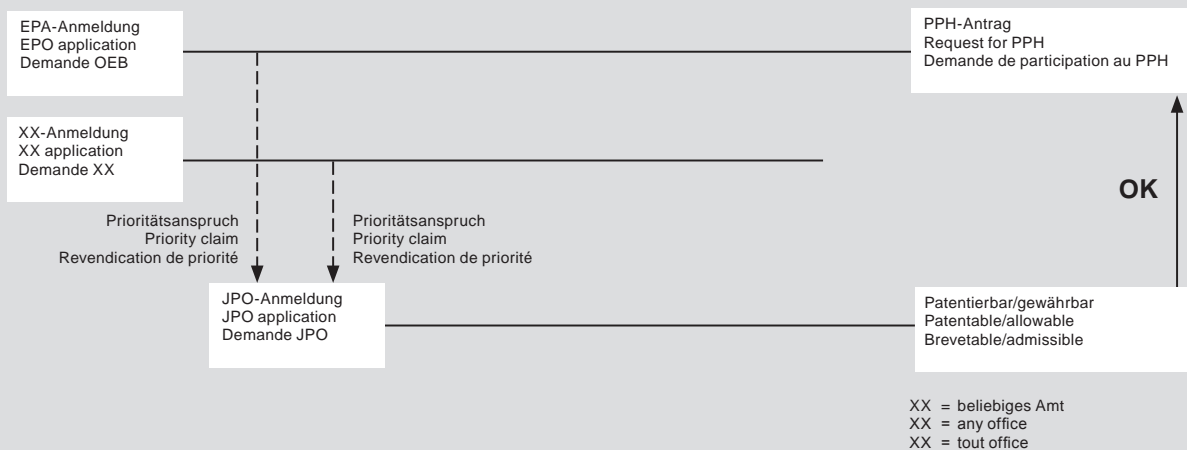
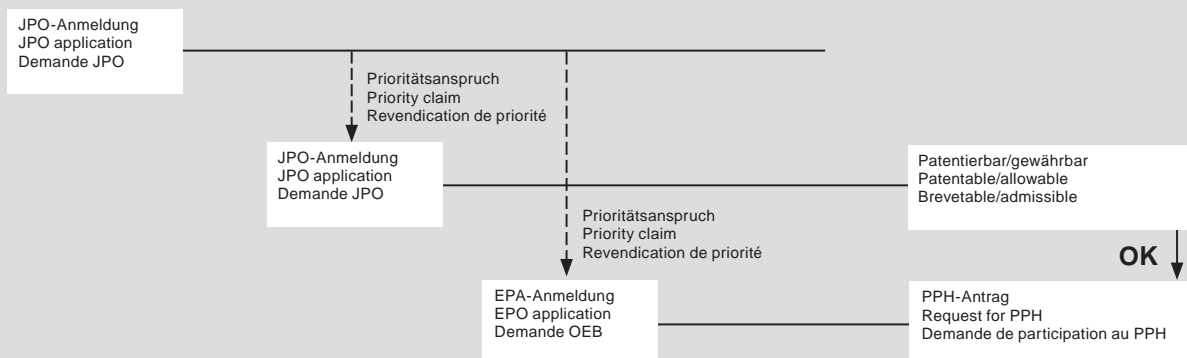
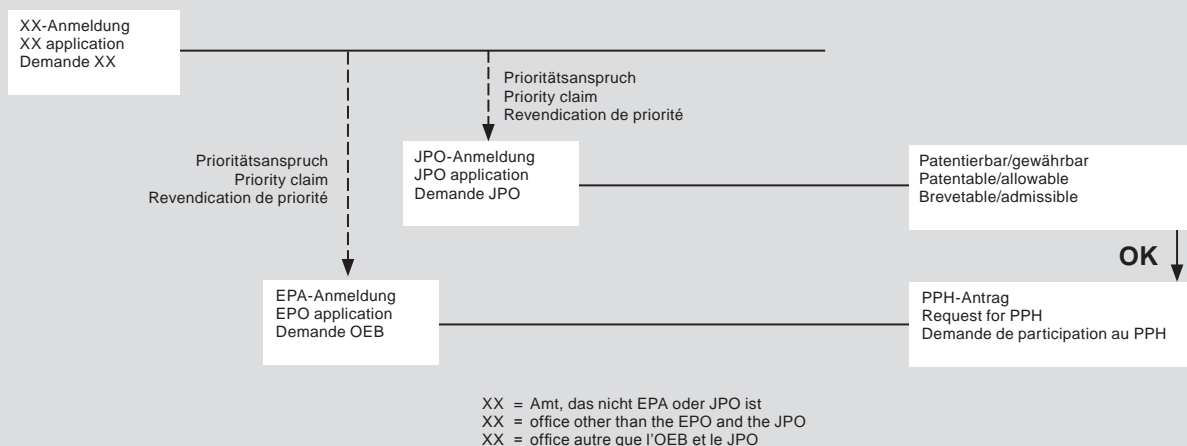
Fall II – PVÜ
Case II – Paris route
Cas II – voie "Convention de Paris"



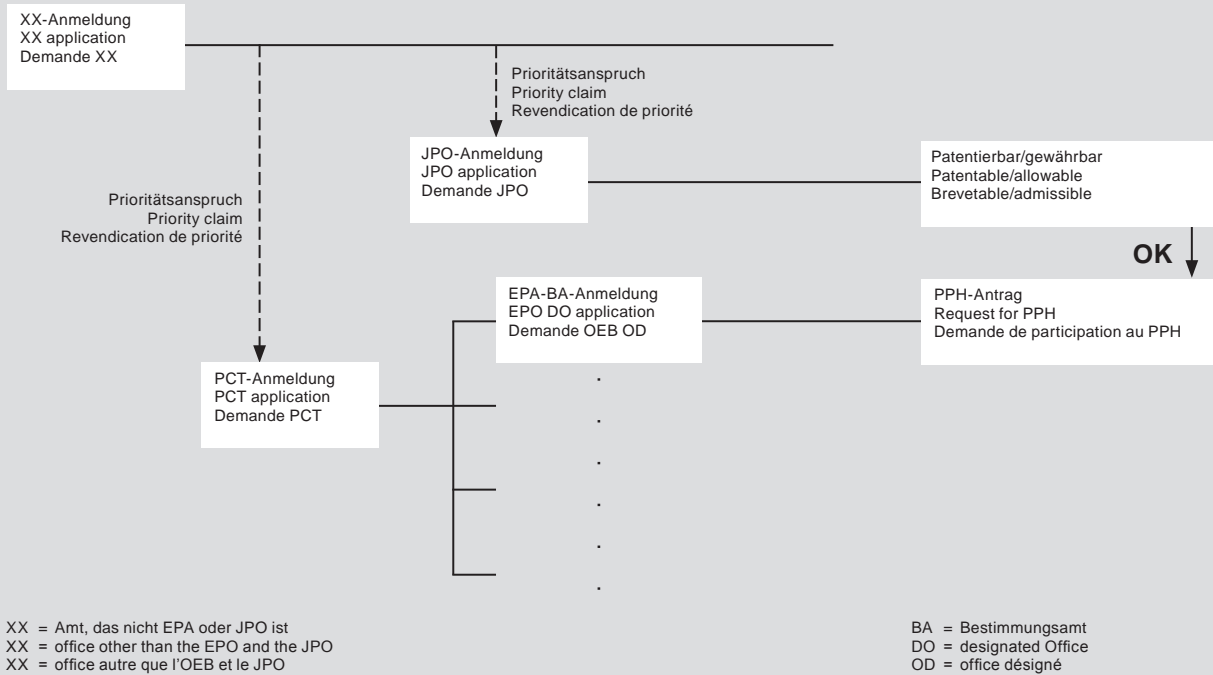
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Fall II – PCT-Weg
Case II – PCT route
Cas II – voie PCT

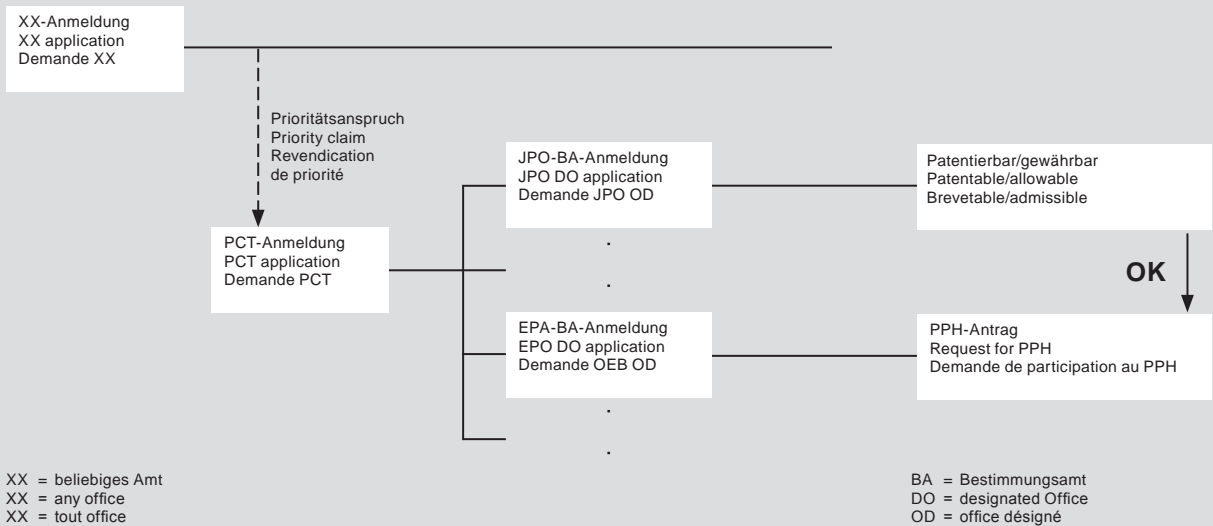


G**Fall II – PVÜ & komplexe Priorität****Case II – Paris route & complex priority****Cas II – voie "Convention de Paris" et priorité complexe****H****Fall III – PVÜ & innere Priorität****Case III – Paris route & internal priority****Cas III – voie "Convention de Paris" et priorité interne****I****Fall III – PVÜ, aber Erstanmeldung aus Drittland****Case III – Paris route, but first application is from third country****Cas III – voie "Convention de Paris" mais première demande provenant d'un pays tiers**

J Fall III – PCT-Weg, aber Erstanmeldung aus Drittland
Case III – PCT route, but first application is from third country
Cas III – voie PCT mais première demande provenant d'un pays tiers

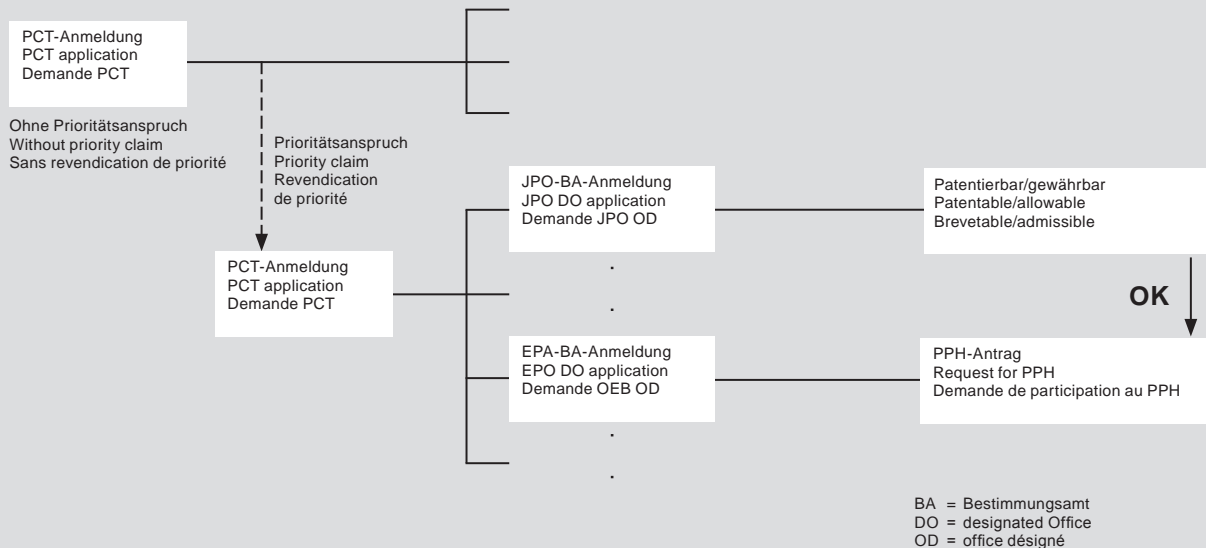


K Fall III – PCT-Weg
Case III – PCT route
Cas III – voie PCT

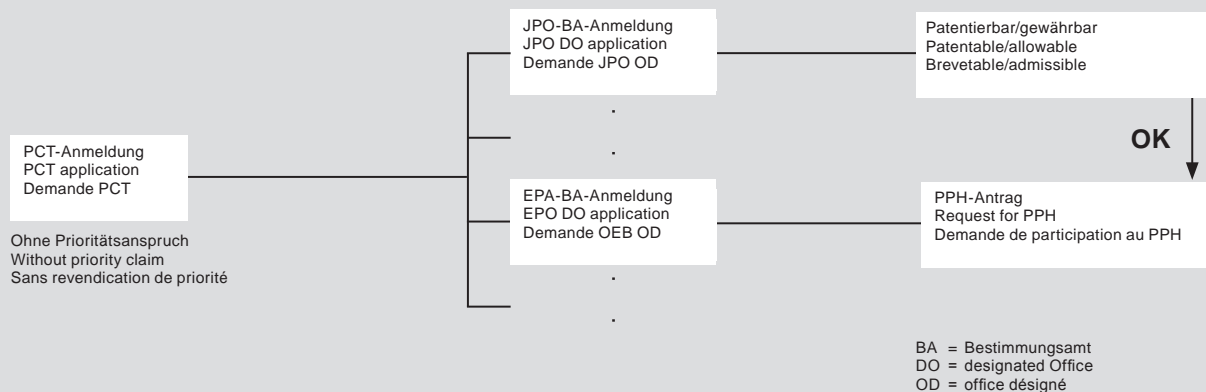


L

Fall III – PCT-Direktanmeldung & PCT-Weg
Case III – Direct PCT & PCT route
Cas III – dépôt PCT direct et voie PCT

**M**

Fall IV – PCT-Direktanmeldung
Case IV – Direct PCT route
Cas IV – voie PCT directe



Teilnahme am Pilotprogramm "Patent Prosecution Highway" (PPH) zwischen dem JPO und dem EPA auf der Grundlage nationaler Arbeitsergebnisse

Participation in the Patent Prosecution Highway (PPH) pilot programme between the JPO and the EPO based on national work products

Participation au programme pilote "Patent Prosecution Highway" (PPH) entre le JPO et l'OEB sur la base de produits résultant de travaux nationaux

Der Anmelder beantragt die Teilnahme am Pilotprogramm "Patent Prosecution Highway":
The applicant requests participation in the Patent Prosecution Highway pilot programme:
Le déposant demande à participer au programme pilote "Patent Prosecution Highway" :

Aktenzeichen der JP-Anmeldung
JP application number
Numéro de la demande JP

Anmeldetag der JP-Anmeldung
Filing date of JP application
Date de dépôt de la demande JP

Entsprechende EP-Anmeldenummer
Corresponding EP application number
Numéro de demande EP correspondant

Für eine Teilnahme am PPH sind zusammen mit diesem Formblatt folgende Unterlagen einzureichen/erforderlich:
For the purposes of participation in the PPH, the following documents should be attached/are required:
Pour une participation au PPH, les documents suivants doivent être joints/ont nécessaires :

- | | |
|--|--|
| <p><input type="checkbox"/> 1. Bescheid(e) des JPO in Kopie /
A copy of JPO office action(s) /
Copie de la ou des notification(s) du JPO</p> <p><input type="checkbox"/> 2. Antrag auf Übermittlung der unter 1 genannten Dokumente über das Aktenzugriffssystem /
Request to obtain documents in 1 via the Dossier Access System /
Requête afin d'obtenir les documents visés au point 1 via le système d'accès aux dossiers</p> <p><input type="checkbox"/> 3. Alle vom JPO für patentierbar/gewährbar befundenen Ansprüche in Kopie /
A copy of all claims determined to be patentable/allowable by the JPO /
Copie de toutes les revendications jugées brevetables/admissibles par le JPO</p> <p><input type="checkbox"/> 4. Antrag auf Übermittlung der unter 3 genannten Dokumente über das Aktenzugriffssystem /
Request to obtain documents in 3 via the Dossier Access System /
Requête afin d'obtenir les documents visés au point 3 via le système d'accès aux dossiers</p> | <p><input type="checkbox"/> 5. Übersetzung der vorstehend unter 1 und 3 genannten Dokumente in einer Amtssprache des EPA /
Translations of the documents in 1 and 3 above in one of the EPO official languages /
Traduction des documents visés aux points 1 et 3 dans l'une des langues officielles de l'OEB</p> <p><input type="checkbox"/> 6. Alle in den Bescheiden des JPO angeführten Dokumente in Kopie (außer Patentunterlagen) /
Copies of all documents cited in the JPO office action(s) (except for patent documents) /
Copie de tous les documents cités dans la ou les notification(s) du JPO (hors documents brevets)</p> <p><input type="checkbox"/> 7. Anspruchskorrespondenzerklärung
Der Unterzeichnete erklärt, dass die Ansprüche in der EP-Anmeldung und in der bzw. den JP-Anmeldungen einander in ausreichendem Maße entsprechen. /
Declaration of claims correspondence
The undersigned declares that the claims sufficiently correspond between the EP and the JP applications. /
Déclaration de concordance des revendications
Le soussigné déclare que les revendications des demandes EP et JP concordent suffisamment entre elles.</p> |
|--|--|

Ort/Place/Lieu

Datum/Date

Name(n) des (der) Unterzeichneten /
Name(s) of signatory/signatories /
Nom(s) du (des) soussigné(s)

Unterschrift des (der) Anmelders oder Vertreters /
Signature(s) of applicant(s) or representative(s) /
Signature(s) du (des) demandeur(s) ou du (des) mandataire(s)

Merkblatt für die Teilnahme am Pilotprogramm "Patent Prosecution Highway" (PPH) zwischen dem JPO und dem EPA auf der Grundlage nationaler Arbeitsergebnisse (Formblatt EPA/EPO/OEB 1009 JP)

Einleitung

Dieses Merkblatt erläutert das Ausfüllen des Formblatts EPA/EPO/OEB 1009 JP (Teilnahme am Pilotprogramm "Patent Prosecution Highway" zwischen dem JPO und dem EPA auf der Grundlage nationaler Arbeitsergebnisse). Das Formblatt ist beim EPA erhältlich.

Ausfüllen des Formblatts 1009 JP

Die einzelnen Abschnitte des Formblatts sind wie folgt auszufüllen:

- Aktenzeichen der JP-Anmeldung:
Geben Sie hier das Aktenzeichen ein, das der Patentanmeldung vom JPO zugewiesen wurde. Diese Anmeldung enthält mindestens einen Anspruch, der vom JPO für patentierbar/gewährbar befunden wurde.
- Anmeldetag der JP-Anmeldung:
Geben Sie hier den vom JPO zuerkannten Anmeldetag ein.
- Entsprechende EP-Anmeldenummer:
Geben Sie hier die Nummer der korrespondierenden europäischen Patentanmeldung ein, die im Rahmen des PPH bearbeitet werden soll.

1. Bescheid(e) des JPO in Kopie
2. Antrag auf Übermittlung der unter 1 genannten Dokumente über das Aktenzugriffssystem:
Sie können Ihrem Antrag auf Teilnahme am PPH entweder die Bescheide des JPO in Kopie beifügen oder beantragen, dass das EPA diese Unterlagen beim JPO anfordert, sofern sie über das AIPN abrufbar sind.
3. Alle vom JPO für patentierbar/gewährbar befundenen Ansprüche in Kopie
4. Antrag auf Übermittlung der unter 3 genannten Dokumente über das Aktenzugriffssystem:
Sie können Ihrem Antrag entweder alle vom JPO für patentierbar/gewährbar befundenen Ansprüche in Kopie beifügen oder beantragen, dass das EPA diese Unterlagen beim JPO anfordert, sofern sie über das AIPN abrufbar sind.
5. Übersetzung der vorstehend unter 1 und 3 genannten Dokumente in einer Amtssprache des EPA
6. Alle in den Bescheiden des JPO angeführten Dokumente in Kopie (außer Patentanmeldungen)

Notes on participation in the Patent Prosecution Highway (PPH) pilot programme between the JPO and the EPO based on national work products (Form EPA/EPO/OEB 1009 JP)

Introduction

These notes explain how to complete form EPA/EPO/OEB 1009 JP (Participation in the Patent Prosecution Highway pilot programme between the JPO and the EPO based on national work products). The form can be obtained from the EPO.

Filling in form 1009 JP

The sections of the form should be completed as follows:

- JP application number:
Enter the patent application number assigned by the JPO. This application has at least one claim indicated by the JPO to be patentable/allowable.
- Filing date of JP application:
Enter the filing date accorded by the JPO.
- Corresponding EP application number:
Enter the number of the corresponding European patent application which should be processed under the PPH.

1. A copy of JPO office action(s)
2. Request to obtain documents in 1 via the Dossier Access System:
Applicant can either provide a copy of the JPO office action(s) with the PPH request or request that the EPO obtain these documents from the JPO, provided these documents are available via AIPN.
3. A copy of all claims determined to be patentable/allowable by the JPO
4. Request to obtain documents in 3 via the Dossier Access System:
Applicant can either provide a copy of all claims determined to be patentable/allowable by the JPO with the PPH request or request that the EPO obtain these documents from the JPO, provided these documents are available via AIPN.
5. Translations of the documents in 1 and 3 above in one of the EPO official languages
6. Copies of all documents cited in the JPO office action(s) (except for patent documents)

Notice relative à la participation au programme pilote "Patent Prosecution Highway" (PPH) entre le JPO et l'OEB sur la base de produits résultant de travaux nationaux (Formulaire EPA/EPO/OEB 1009 JP)

Introduction

La présente notice explique comment remplir le formulaire EPA/EPO/OEB 1009 JP (Participation au programme pilote "Patent Prosecution Highway" entre le JPO et l'OEB sur la base de produits résultant de travaux nationaux). Le formulaire peut être obtenu auprès de l'OEB.

Remplir le formulaire 1009 JP

Les différentes parties du formulaire doivent être remplies de la manière suivante :

- Numéro de la demande JP :
Entrez le numéro attribué par le JPO à la demande de brevet. Cette demande a au moins une revendication indiquée comme brevetable/admissible par le JPO.
- Date de dépôt de la demande JP :
Entrez la date de dépôt attribuée par le JPO.
- Numéro de demande EP correspondant :
Entrez le numéro de la demande européenne correspondante à traiter dans le cadre du PPH.

1. Copie de la ou des notification(s) du JPO
2. Requête afin d'obtenir les documents visés au point 1 via le système d'accès aux dossiers :
Le demandeur peut soit fournir une copie de la (ou des) notification(s) du JPO en même temps que sa demande de participation au PPH, soit requérir que l'OEB se procure auprès du JPO ces documents s'ils sont disponibles via AIPN.
3. Copie de toutes les revendications jugées brevetables/admissibles par le JPO
4. Requête afin d'obtenir les documents visés au point 3 via le système d'accès aux dossiers :
Le demandeur peut soit fournir une copie de toutes les revendications jugées brevetables/admissibles par le JPO en même temps que sa demande de participation au PPH, soit requérir que l'OEB se procure auprès du JPO ces documents s'ils sont disponibles via AIPN.
5. Traduction des documents visés aux points 1 et 3 dans l'une des langues officielles de l'OEB
6. Copie de tous les documents cités dans la ou les notification(s) du JPO (hors documents brevets)

7. Anspruchskorrespondenzerklärung
Der Unterzeichnete erklärt, dass die Ansprüche in der EP-Anmeldung und in der bzw. den JP-Anmeldungen einander in ausreichendem Maße entsprechen.

- Ort:
Geben Sie hier den Ort ein, von dem aus Sie Formblatt 1009 JP einreichen.
- Datum:
Geben Sie hier das Datum ein, an dem Sie Formblatt 1009 JP einreichen.
- Name:
Geben Sie hier den Namen der unterschriftsberechtigten Person ein.
- Unterschrift:
Ist der Anmelder eine juristische Person, so ist das Formblatt zu unterzeichnen:
– entweder von einer Person, die nach Gesetz oder nach Statut der juristischen Person, ihrer Satzung oder dergleichen zur Unterschrift berechtigt ist, wobei ein Hinweis auf die Unterschriftsberechtigung des Unterzeichneten zu geben ist (z. B. Geschäftsführer, Prokurist, Handlungsbevollmächtigter) (Art. 133 (1) EPÜ); in diesem Fall braucht keine Vollmacht eingereicht zu werden;
– oder, sofern die juristische Person ihren Sitz in einem Vertragsstaat hat, von einem ihrer Angestellten (Art. 133 (3) Satz 1, Regel 152 (1) EPÜ); in diesem Fall ist eine Vollmacht einzureichen.

7. Declaration of claims correspondence
The applicant declares that the claims sufficiently correspond between the EP and JP applications.

- Place:
Enter the place of filing of form 1009 JP.
- Date:
Enter the date of filing of form 1009 JP.
- Name:
Enter the name of the person entitled to sign.
- Signature:
If the applicant is a legal person other than an individual, the form must be signed:
– either by a person entitled to sign under the law or the applicant's statute, articles of association or the like, with an indication of the capacity of the person doing so (e.g. chairman, director, company secretary) (Art. 133(1) EPC), in which case no authorisation need be filed
– or by another employee of the applicant, provided the latter's principal place of business is in a contracting state (Art. 133(3), first sentence, Rule 152(1) EPC), in which case an authorisation must be filed.

7. Déclaration de concordance des revendications
Le demandeur déclare que les revendications des demandes EP et JP concordent suffisamment entre elles.

- Lieu :
Indiquez le lieu où vous déposez le formulaire 1009 JP.
- Date :
Indiquez la date de dépôt du formulaire 1009 JP.
- Nom :
Indiquez le nom de la personne habilitée à signer.
- Signature :
Si le demandeur est une personne morale, le formulaire doit être signé :
– soit par une personne habilitée à signer en vertu des dispositions légales ou des statuts de la personne morale, en indiquant en quelle qualité cette personne est autorisée à le faire (président, directeur, fondé de pouvoir) (article 133(1) CBE) ; dans ce cas, il n'est pas nécessaire de déposer un pouvoir,
– soit par un autre employé du demandeur, à condition que ce dernier ait son siège dans un État contractant (article 133(3), première phrase, règle 152(1) CBE) ; dans ce cas, un pouvoir doit être déposé.