

**Procedures to file a request to the**  
***Icelandic Patent Office (IPO)***  
**for the**  
**Patent Prosecution Highway**  
**Pilot Program between the**  
***Japan Patent Office (JPO)***  
**and the**  
***Icelandic Patent Office (IPO)***

## **Request to the IPO**

An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the IPO by submitting a letter requesting accelerated examination under the PPH accompanied by the relevant supporting documents, including completed PPH request form. The requirements for an application to the IPO for accelerated examination under the PPH are given in section 1 and relevant supporting documentation is discussed in section 2.

## **PPH pilot program at the IPO**

### **1 Requirements**

The application which is filed with the IPO and for which the applicant files a request for an accelerated examination under the PPH must satisfy the following requirements:

#### **1.1 The IPO application (including PCT national phase applications) must be:**

- (A) an application which validly claims priority under the Paris Convention to the JPO application(s) (examples are provided in Annex I, figure A, B, C, F, G and H), or
- (B) a PCT national phase application without priority claim (direct PCT applications) (examples are provided in Annex I, figure I and K), or

(C) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim (examples are provided in Annex I, figure J and L).

An IPO application which validly claims priority to multiple JPO or PCT applications, or which is a divisional application validly based on the originally filed application that is included in (A) to (C) above, is also eligible.

### **1.2 At least one corresponding JPO application has one or more claims that have been determined to be patentable by the JPO.**

Claims clearly identified to be patentable by the JPO in the latest office action at examination stage can form the basis of a request for an accelerated examination under the PPH pilot program. This is the case even though the JPO has not yet granted a patent for those claims if the JPO examiner has added the following routine expression in the “notice of reason for refusal”:

*“At present for invention concerning Claim\*, no reason for refusal is found. Any subsequently identified reasons for rejection will be notified accordingly.”*

### **1.3 Claim correspondence**

All claims on file 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 JPO.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the IPO are of the same or similar scope as the claims in the JPO, or the claims in the IPO are narrower in scope than the claims in the JPO.

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).

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

#### **1.4 The IPO has not begun examination of the application at the time of request for the PPH**

The request for the PPH shall be permitted only before the applicant receives the notification whose heading would be “Rannsókn einkaleyfisumsóknar” (Examination of patent application).

## **2 Documents to be submitted when filing a request for accelerated examination under the PPH**

The applicant must submit the following documents 2.1-2.4 attached to the request form (see Annex 2) when filing a request under PPH. All documents under this paragraph with exception for the cited documents have to be drawn up in or translated to Danish or English.

### **2.1 A copy of the office action(s) relating to the corresponding JPO application(s) and a translation hereof.**

The term “office actions” is here used about the correspondence sent to the applicant or the applicant’s representative from the JPO examiner. Translations can be filed in either Danish or English and machine translations are admissible. If an examination in the name of the IPO cannot be carried out as the examiner is not able to understand the translated office actions to a sufficient extent, the IPO can request the applicant to submit (or resubmit) translations.

### **2.2 A copy of the claims determined to be patentable by the JPO - including any subsequent amended claims found to be patentable by the JPO - and translations of the claims found to be patentable by the JPO.**

Both Danish and English are acceptable translation languages.

### **2.3 A completed claim correspondence table showing the relationship between the claims of the IPO application for accelerated examination under the PPH and the claims of the corresponding JPO application considered patentable by the JPO.**

Sufficient correspondence of claims occurs where the claims are of the same or similar scope as defined above in 1.3.

Where the claims applied for at the IPO are literal translations of the claims which the JPO has determined to be patentable, it will be sufficient to write “they are the same” in the table of correspondence. When the claims applied for at the IPO are not literal translations, it will be necessary to explain why there is a sufficient correspondence of each claim based on the criteria set out in 1.3 above.

#### **2.4 A copy of the references cited by the JPO examiner.**

If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the IPO. If the IPO does not have access to the relevant patent documents, the applicant must submit these documents at the request of the IPO. Non-patent literature must always be submitted.

Submission of translations of the references is not required. However, applicants will be free to file translations as part of the supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the citations if they so desire.

#### **2.5 Request form**

An applicant should submit a request form (See Annex 2) to the IPO for the accelerated examination under the PPH along with the documents referred to in paragraphs 2.1-2.4. The applicant need not provide further copies of documentation if they have already submitted the documents noted above to the IPO through simultaneous or past procedures.

### **Procedure for the accelerated examination under the PPH**

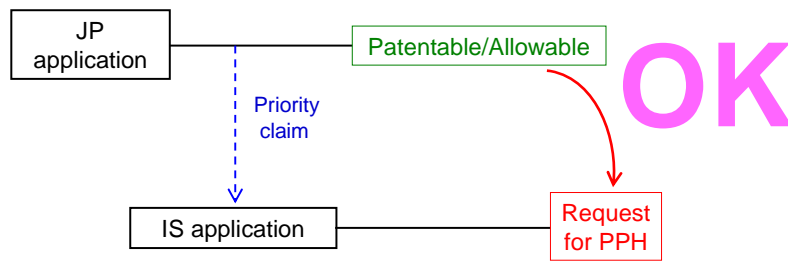
The applicant files a letter requesting accelerated examination under the PPH Pilot Program to the IPO, including the relevant supporting documents and a completed request form (see Annex 2).

If the request 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 opportunity to correct the request. If the defect(s) are not corrected, the applicant will be notified, and the application will await action in its regular turn. If an examination of the application has begun after the applicant has been notified of the defects in the request, any renewed request will be dismissed.

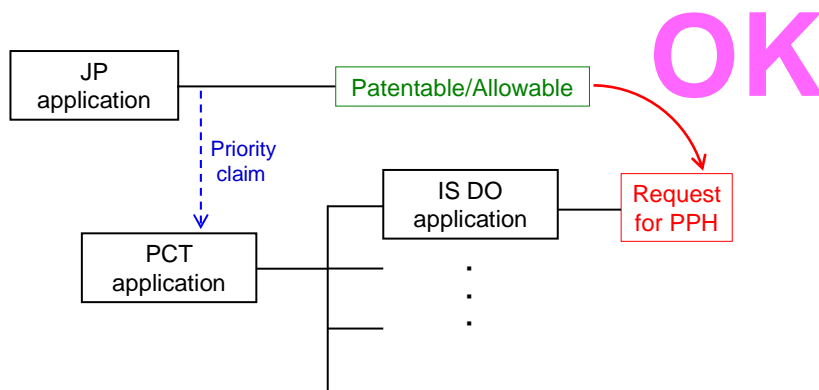
If the request for participation in the PPH pilot program meets all the requirements and examination has not begun, the IPO will decide whether a patent will be issued based on the search and examination carried out by the JPO or sent to the Danish Patent and Trademark Office (DKPTO) for examination, in accordance with a partnership agreement. If the application is sent to the DKPTO, their patent examiners will conduct the accelerated examination at the request of the IPO.

# Annex 1

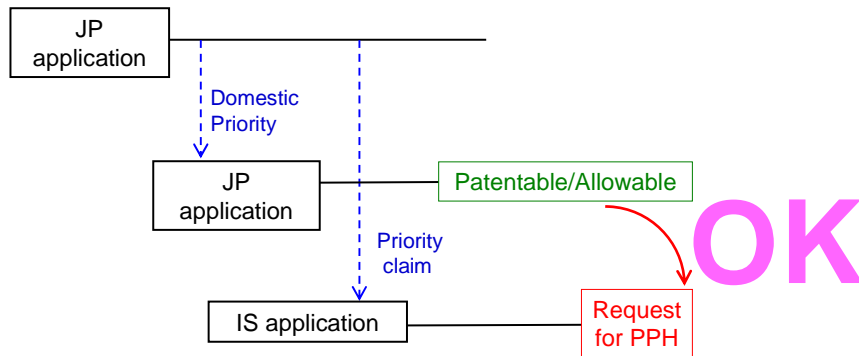
## A A case meeting requirement 1.1(A) - Paris route -



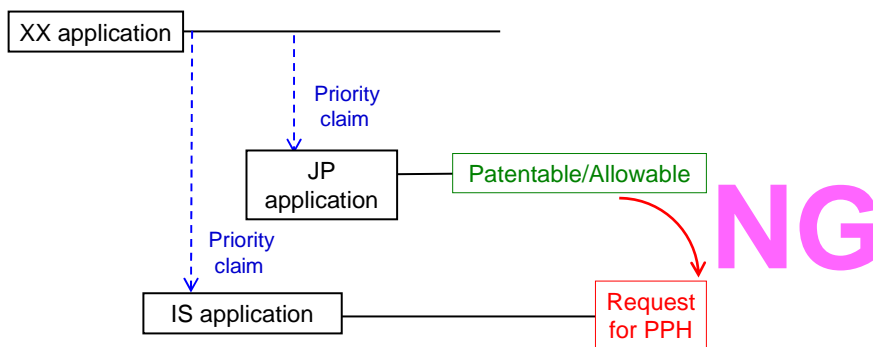
## B A case meeting requirement 1.1(A) - PCT route -



**C** A case meeting requirement 1.1(A)  
 - PCT route, Domestic priority -

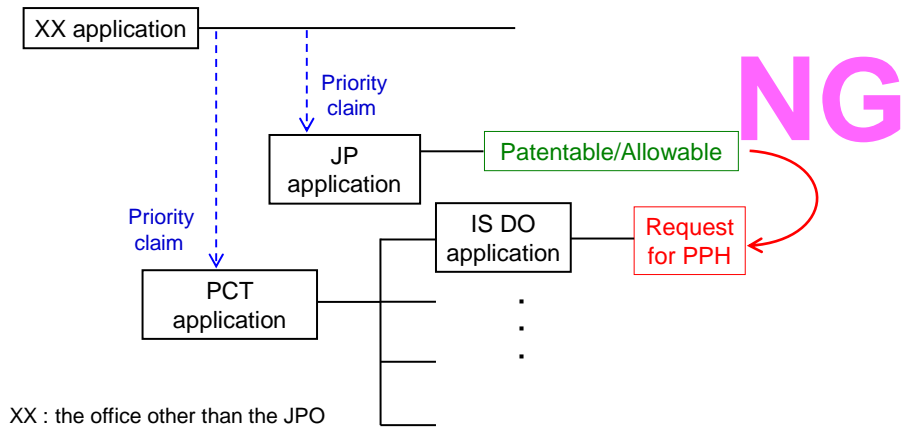


**D** A case not meeting requirement 1.1  
 - Paris route, but the first application is from the third country -

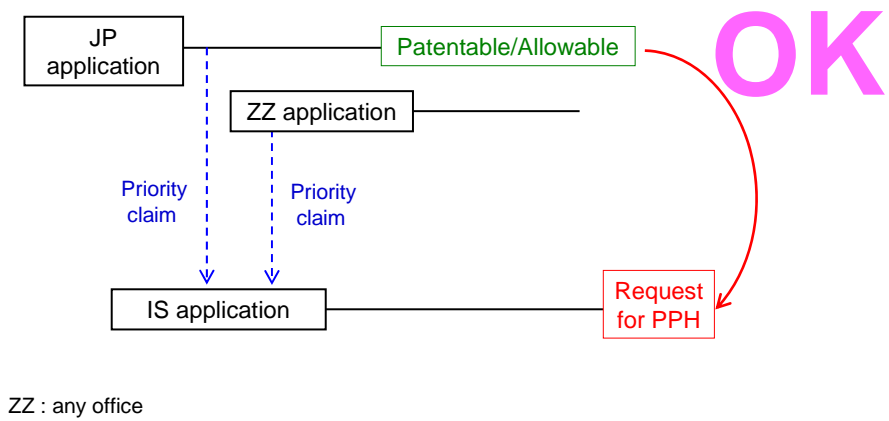


XX : the office other than the JPO

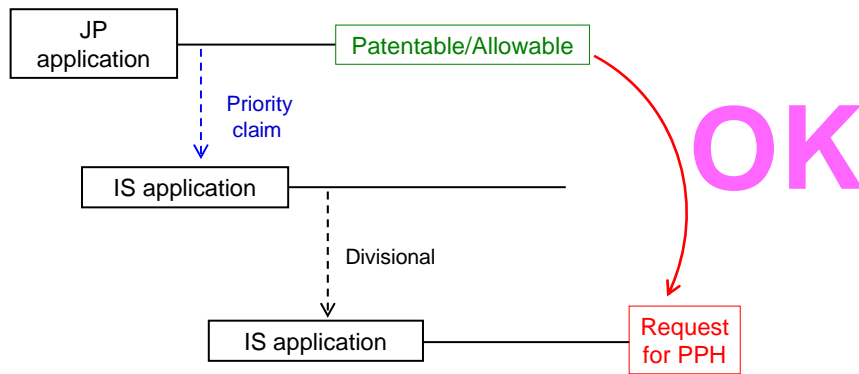
**E** A case not meeting requirement 1.1  
 - PCT route, but the first application is from the third country -



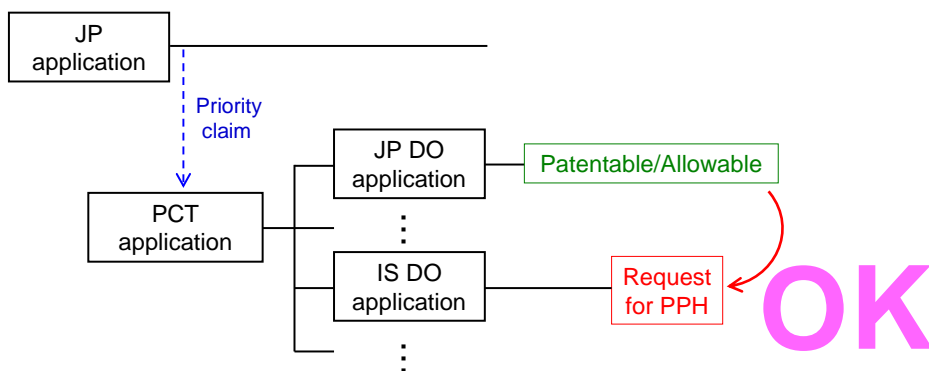
**F** A case meeting requirement 1.1(A)  
 - Paris route & Complex priority -



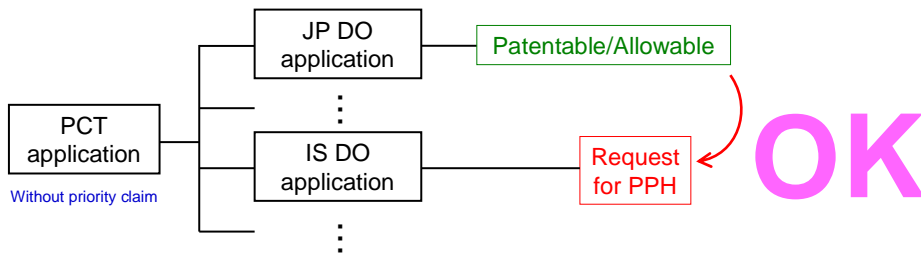
**G** A case meeting requirement 1.1(A)  
- Paris route & divisional application -



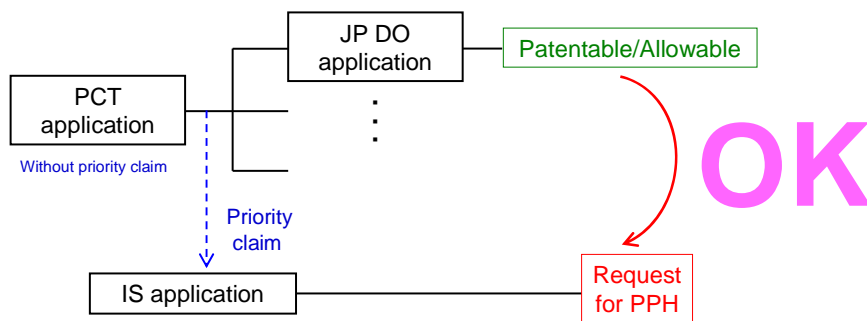
**H** A case meeting requirement 1.1(A)  
- PCT route -



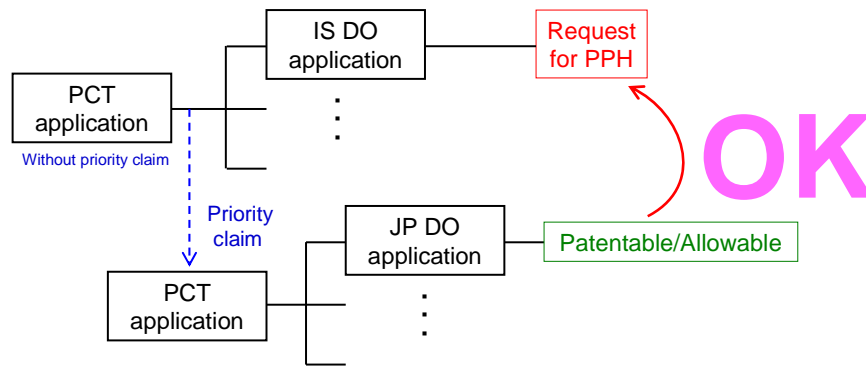
**I** A case meeting requirement 1.1(B)  
- Direct PCT route -



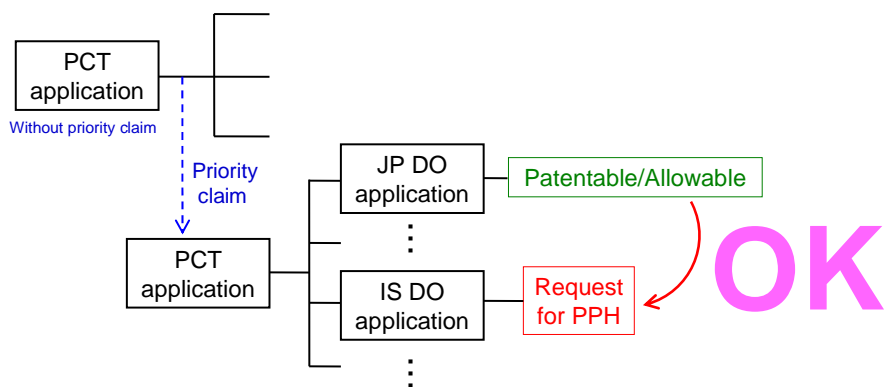
**J** A case meeting requirement 1.1(C)  
- Direct PCT & Paris route -



**K** A case meeting requirement 1.1(B)  
 - Direct PCT & PCT route -



**L** A case meeting requirement 1.1(C)  
 - Direct PCT & PCT route -



**ANNEX 2****PPH REQUEST****Request for Accelerated Examination at the IPO under the Patent Prosecution Highway Pilot Program between the IPO and the JPO**

- 1 IS application number:  
Corresponding JP application number(s):
- 2 **Either:**
- a) Copy of JPO office action(s) in Japanese attached   
**and**  
Copy of JPO office action(s) translated into English or Danish attached   
**or**
- b) JPO office action(s) on file from previous PPH request:   
IS application number:
- 3 **Either:**
- a) Copy of claims in Japanese of corresponding JP application attached:   
**and**  
Copy of JP claims translated to English or Danish attached:   
**or**
- b) JP application claims on file from previous PPH request:   
IS application number:
- 4 Claim correspondence table attached:
- 5 Copies of non-patent literature cited by JPO examiners attached:

**Please ensure that this is the uppermost document when requesting accelerated examination under the PPH.**

