

Procedures to file a request to the JPO for Patent Prosecution Highway Pilot Program between the JPO and the UK-IPO

1. Request to the JPO

When an applicant files a request for an accelerated examination under the Patent Prosecution Highway to the Japan Patent Office, an applicant should 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 Patent Prosecution Highway, 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 following conditions (1) and the applicant attaches following documents (2) to it.

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

a) Both the JPO application on which PPH is requested and the UK-IPO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).

For example, the JPO application (including PCT national phase application) may be either:

(Case I) an application which validly claims priority under the Paris Convention from the UK-IPO application(s) (examples are provided in ANNEX, Figure A, B, C and D), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the UK-IPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX, Figure E, F and G), or

(Case III) an application which shares a common priority document with the UK-IPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX, Figure H, I, J, K and L), or

(Case IV) a PCT national phase application where both the JPO application and the UK-IPO application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX, Figure M).

b) At least one corresponding UK-IPO application has one or more claims that are determined to be patentable by the UK-IPO².

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 31-33.

² This is the case where the UK-IPO patent examiner clearly identifies those claims to be patentable. The JPO will ask the UK-IPO PPH administrator about patentability of claims if the UK-IPO patent examiner does not clearly identify those claims to be patentable.

c) 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 UK-IPO. 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 UK-IPO, or the claims in the JPO are narrower in scope than the claims in the UK-IPO.

In this regard, a claim that is narrower in scope occurs when an UK-IPO 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 JPO which introduces a new/different category of claims to those claims indicated as allowable in the UK-IPO is not considered to sufficiently correspond. For example, where the UK-IPO 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.

d) The JPO has not begun examination of the application. (an example is provided in ANNEX, Figure N)

(2) The documents that the applicant should attach to “The Explanation of Circumstances Concerning Accelerated Examination”.

a) Copies of all office actions in the UK-IPO³, which were sent for the corresponding application by the UK-IPO.

Paper copies need not be supplied if the applicant would prefer the JPO to obtain them directly from the UK-IPO. In this case, the applicant should clearly express the intent in “The explanation of circumstances concerning accelerated examination” as (*) in example form. (Please refer to the Example form for the detail.) Translations of office actions are not needed.

b) Copies of all claims determined to be patentable by the UK-IPO.

Paper copies need not be supplied if the applicant would prefer the JPO to obtain them directly from the UK-IPO. In this case, the applicant should clearly express the intent in “The explanation of circumstances concerning accelerated examination” as (*) in example form. (Please refer to the Example form for the detail.) Translations of them are not needed.

c) Copies of references cited by UK-IPO examiner

Copies of patent documents cited by the UK-IPO will not be needed where they are freely

³ Office actions in the UK-IPO mean “search report”, “examination report” and “notification of grant”.

available on the JPO's patent databases. In the case that the JPO doesn't possess the patent documents, examiners may require the submission of the patent documents. Non-patent literature must always be submitted. Any translation of cited documents is not needed.

d) The explanation table of sufficiently corresponding claims

Applicant should attach an explanation table to explain how the claims indicated as patentable in the UK-IPO sufficiently correspond to the claims in the JPO 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 sufficient correspondence of each claim based on the criteria (1)c). (Please refer to the Example form for the detail.)

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

When the application doesn't fulfill the requirement of (1) and (2), then the applicant cannot omit to fill in the section [2. the disclosure of prior arts and comparison between the claimed invention and prior art] and the request of accelerated examination is not accepted. In that case, the JPO will notify that and the reason for it to the applicant (or the representative).

2. Example of "The Explanation of Circumstances Concerning Accelerated Examination" for filing request accelerated examination under PPH

(1) Circumstances

Please indicate the relationship between the JPO application on which PPH is requested and the corresponding UK-IPO application(s) from the aspect of the above Requirement 1.(1)a), and state that an accelerated examination is requested under the PPH program. The application number(s) of the corresponding UK-IPO application(s) must be specified. If the application requested for the PPH or the corresponding UK-IPO application(s) is a derived application (e.g., the UK-IPO application that is indicated to be allowable/patentable is a divisional application of a UK-IPO application which forms the basis of the priority claim of the JPO application), please indicate the application number of its basic application.

(2) The submitted documents

The applicant should list all required documents mentioned above 1.(2) in an identifiable way, even if the applicant prefer the JPO to obtain them directly from the UK-IPO and doesn't attach the documents themselves.

(3) Notice

Forms of "The Explanation of Circumstances Concerning Accelerated Examination" are different between on-line procedure and paper procedure. So please refer to the examples of forms when filling in ("Accelerated Examination form1" for on-line procedures, and "Accelerated Examination form2" 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	Bibliographical items
	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	
	The name and address of who submit this	
【代理人】		List up the documents which can be omitted to submit
【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	
【早期審査に関する事情説明】	The explanation of circumstances concerning accelerated examination	
1. 事情	本出願と英国知的財産庁への対応出願(出願番号00/000000)は、共に、米国特許商標庁への一つの出願(出願番号00/000000)に対してパリ条約に基づく優先権を有効に主張する出願であり、特許審査ハイウェイに基づく早期審査の申請を行うものである。	
1. Circumstances	Both this application and the corresponding UK-IPO application (the application number is 00/000000) validly claim priority under the Paris Convention to a USPTO application (the application number is 00/000000), and the accelerated examination is requested under the PPH program.	
(提出を省略する物件)		
(物件名)	**年**月**日付の対応英国出願に対する調査報告書の写し (日本国特許庁が英国知的財産庁から直接入手することを希望する。)	
(物件名)	**年**月**日付の対応英国出願に対する拒絶理由通知書の写し (日本国特許庁が英国知的財産庁から直接入手することを希望する。)	
(物件名)	**年**月**日付の対応英国出願に対する特許査定書の写し (日本国特許庁が英国知的財産庁から直接入手することを希望する。)	
(物件名)	対応英国出願の特許公報である英国公告第00000号公報	
(物件名)	対応英国出願に対して引用された英国出願公開00000号公報	
(物件名)	対応英国出願に対して引用された日本国特許第00000号公報	

(Documents to be omitted to submit)
 (The name of the document) Copy of search report in the UK-IPO on (date)
 (I prefer the JPO to obtain this directly from the UK-IPO)(*)
 (The name of the document) Copy of examination report in the UK-IPO on (date)
 (I prefer the JPO to obtain this directly from the UK-IPO)(*)
 (The name of the document) Copy of notification of grant in the UK-IPO on (date)
 (I prefer the JPO to obtain this directly from the UK-IPO)(*)
 (The name of the document) Corresponding application's patent publication:
 United Kingdom Patent number 0000000
 (The name of the document) Cited reference of the corresponding UK-IPO
 application: United Kingdom Publication of application 0000000
 (The name of the document) Cited reference of the corresponding UK-IPO
 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.”

【提出物件の目録】

The list of submitted documents

【物件名】 英国出願と本出願の請求項の対応関係を示す書面 1

The table to explain how the claims indicated as allowable in the UK-IPO sufficiently correspond to the claims in the JPO application 1

【物件名】 引用非特許文献1 1

Non-patent literature1 1

List up the documents to be submitted

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】.”

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】 英国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 UK-IPO sufficiently correspond to the claims in the JPO application

【内容】

本出願の請求項 The claim in the JPO	英国で特許可能とされた請求項 The patentable claim in the UK-IPO	対応関係に関するコメント 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、英国の請求項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 UK-IPO

【物件名】 引用非特許文献1

Non-patent literature1

【内容】

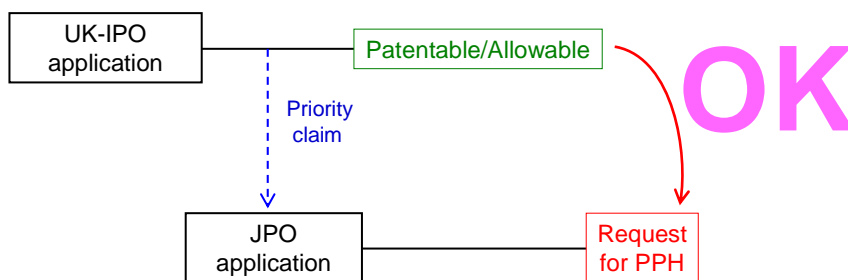
Attach the copy of the document.

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

Note that in the case of paper procedure, the pendency period (the period between the request for PPH and the first office action) tends to be longer than on-line procedure.

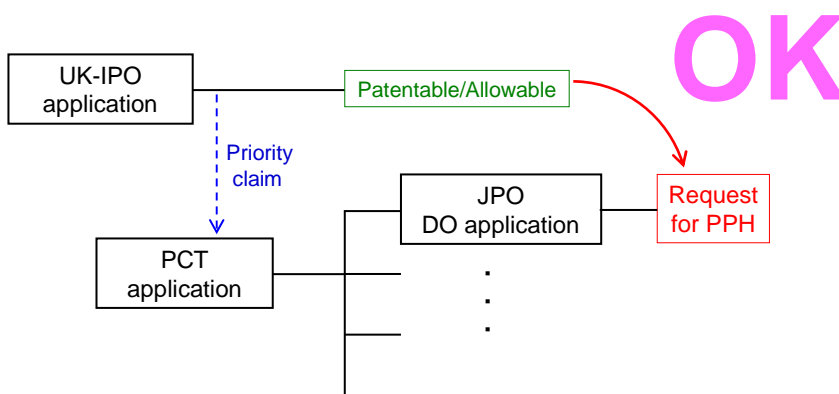
A

(Case I)
- Paris route -



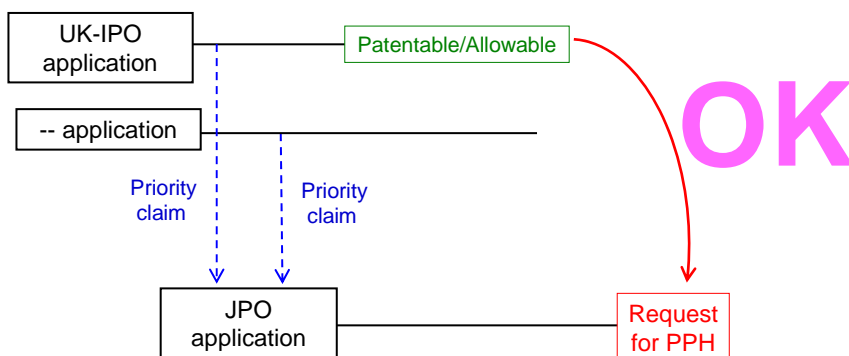
B

(Case I)
- PCT route -



C

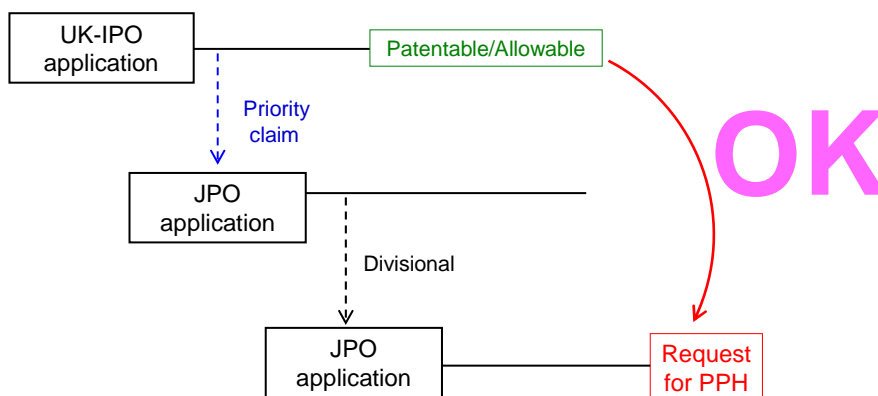
(Case I)
- Paris route & Complex priority -



-- : any office

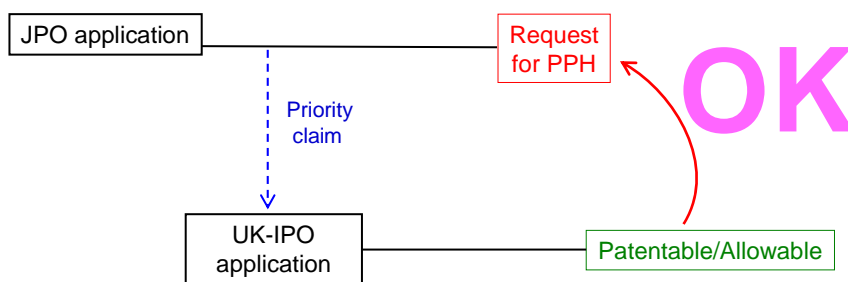
D

(Case I)
- Paris route & divisional application -



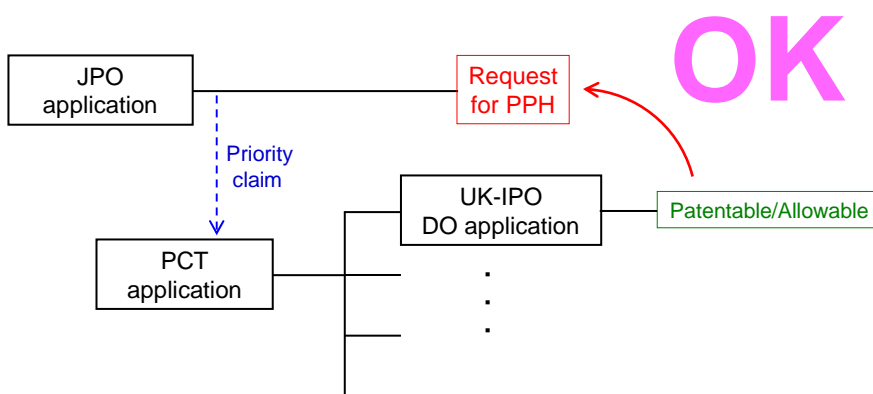
E

(Case II)
- Paris route -



F

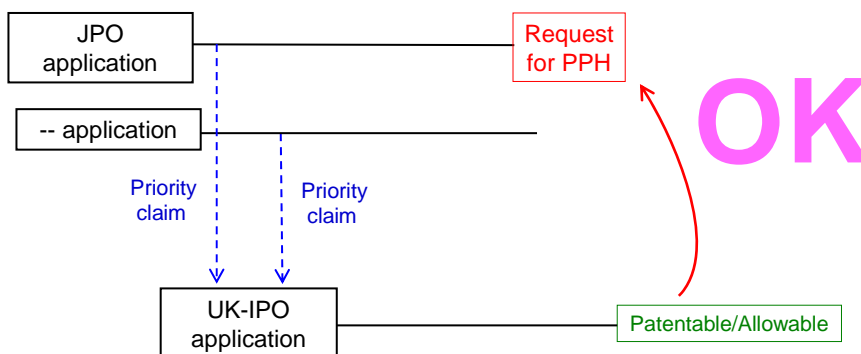
(Case II)
- PCT route -



G

(Case II)

- Paris route & Complex priority -

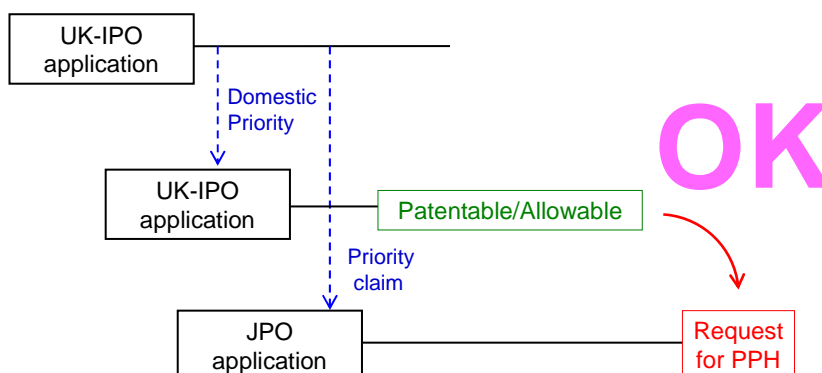


-- : any office

H

(Case III)

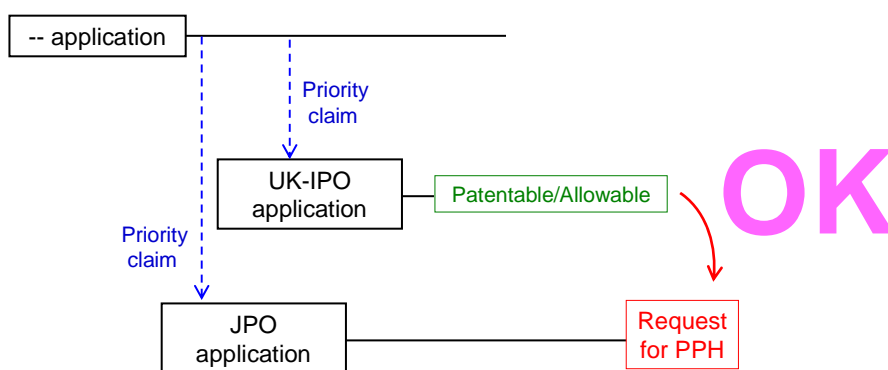
- Paris route, Domestic priority -



I

(Case III)

- Paris route, but the first application is from the third country -

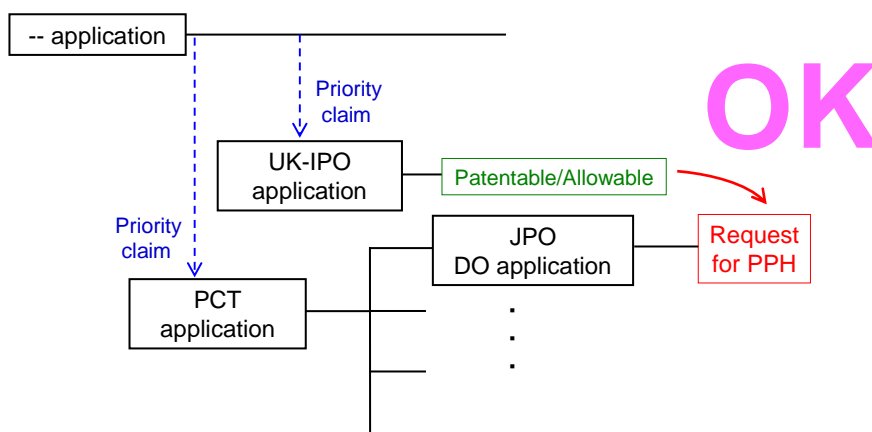


-- : the office other than the JPO and the UK-IPO

J

(Case III)

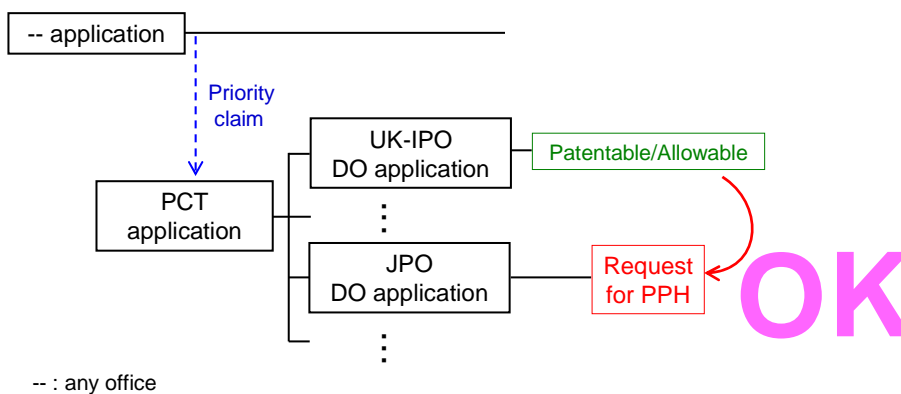
- PCT route, but the first application is from the third country -



-- : the office other than the JPO and the UK-IPO

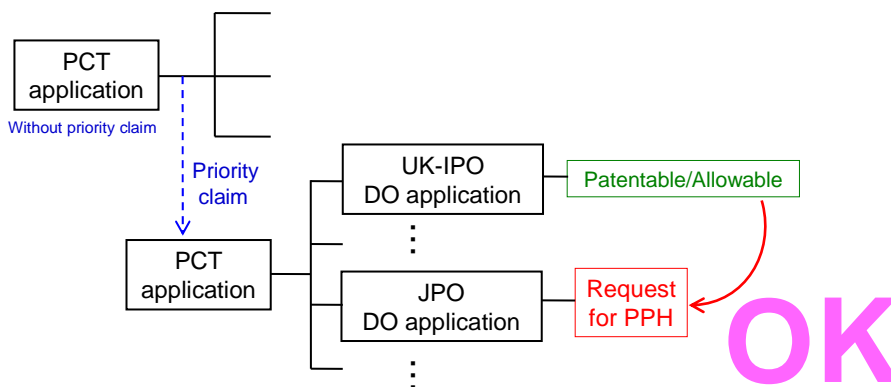
K

(Case III)
- PCT route -



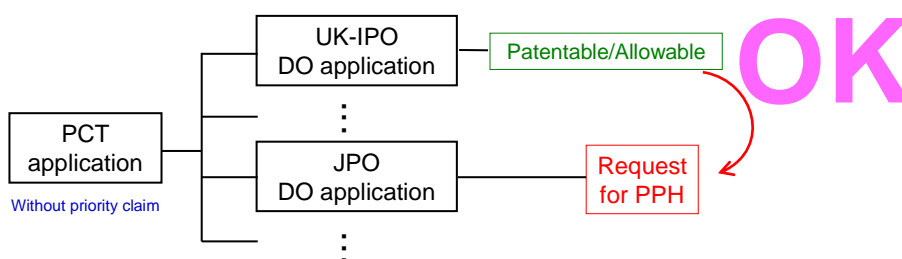
L

(Case III)
- Direct PCT & PCT route -



M

(Case IV)
- Direct PCT route -



N

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

