

# Procedures to file a request to the JPO for Patent Prosecution Highway Pilot Program between the JPO and the APO (Austrian Patent Office)

## **1. Request to the JPO**

When an applicant files a request for an accelerated examination under the Patent Prosecution Highway Pilot Program to the Japan Patent Office (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”. (Please access to [http://www.jpo.go.jp/torikumi/t\\_torikumi/souki/exe/v3souki/guideline.exe](http://www.jpo.go.jp/torikumi/t_torikumi/souki/exe/v3souki/guideline.exe) (Japanese only). “The Explanation of Circumstances Concerning Accelerated Examination” is described in p.27-29.)

Under the Patent Prosecution Highway 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 following conditions (1) and the applicant attaches following documents (2) to “The Explanation of Circumstances Concerning Accelerated Examination”.

### **(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 APO 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 APO 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 APO and has one or more claims that are determined to be patentable by the APO.***

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 program, even if the application, which includes those claims is not granted for patent

yet. The following case will fall within this interpretation: When an APO examiner sends a notification specifying the APO's intention to grant. The headings for such notifications will be 'Erteilungsbeschluss' (which means 'decision to grant a patent').

**(c) All claims in the JPO application (for which an accelerated examination under the PPH pilot program is requested) must sufficiently correspond to one or more of those claims determined to be patentable in the APO.**

Claims are considered to sufficiently correspond where both claims have a common technical feature, which made the claims patentable over the prior art in the APO application. In this regard, a claim which has additional component on the claim determined to be patentable in the APO or which is the same except for claim format as the claim determined to be patentable in the APO will be considered to sufficiently correspond.

Note that when claims are determined to be patentable by the APO by making amendment to claims, the claims in the JPO also must be amended similar way to sufficiently correspond to the allowable/patentable claims in the APO 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 actions<sup>1</sup> in the APO, which were sent for the corresponding application by the APO, and translations of them<sup>2</sup>.**

Both Japanese and English are acceptable as translation language.

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

Both Japanese and English are acceptable as translation language.

---

<sup>1</sup> Office actions are documents which relate to substantive examination.

<sup>2</sup> 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.

**(c) Copies of references cited by APO 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 APO 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**).

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.

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 an 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 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, publication number, or a patent number of the corresponding APO 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, publication number, or a patent 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 an 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 in JPO

【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

本出願はオーストリア特許庁への出願(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 APO application (the application number is 0000000), and the accelerated examination is requested under the PPH pilot program.

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, 2<sup>nd</sup> 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】

List up the documents to be submitted

The list of submitted documents

- 【物件名】 オーストリア出願と本出願の請求項の対応関係を示す書面 1
- 【物件名】 \*\*年\*\*月\*\*日付の対応オーストリア出願に対する調査報告書の写し 1
- 【物件名】 \*\*年\*\*月\*\*日付の対応オーストリア出願に対する拒絶理由通知書の写し 1
- 【物件名】 \*\*年\*\*月\*\*日付の対応オーストリア出願に対する特許査定書の写し 1
- 【物件名】 引用非特許文献1 1

(The name of the document) The table to explain how the claims indicated as allowable in the APO sufficiently correspond to the claims in the JPO application 1  
 (The name of the document) Copy of search report in the APO on (date) 1  
 (The name of the document) Copy of examination report in the APO on (date) 1  
 (The name of the document) Copy of notification of grant in the APO on (date) 1  
 (The name of the document) Cited non patent literature 1 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】 オーストリア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 APO sufficiently correspond to the claims in the JPO application

【内容】

本出願の請求項	オーストリアで特許可能とされた請求項	対応関係に関するコメント
The claim in the JPO	The patentable claim in the APO	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、オーストリアの請求項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 APO

【物件名】引用非特許文献1

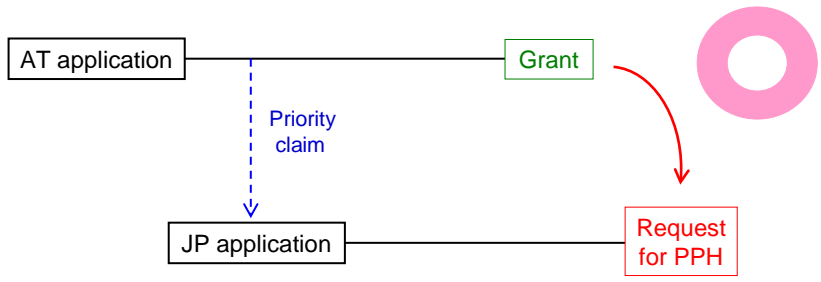
Non-patent literature1

【内容】

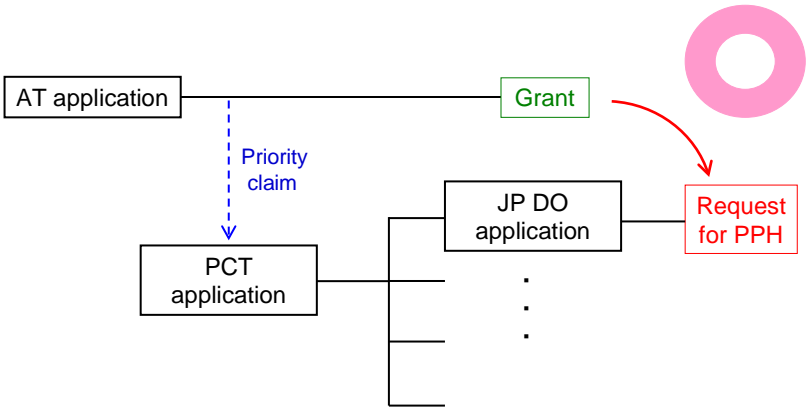
Attach the copy of the document.

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

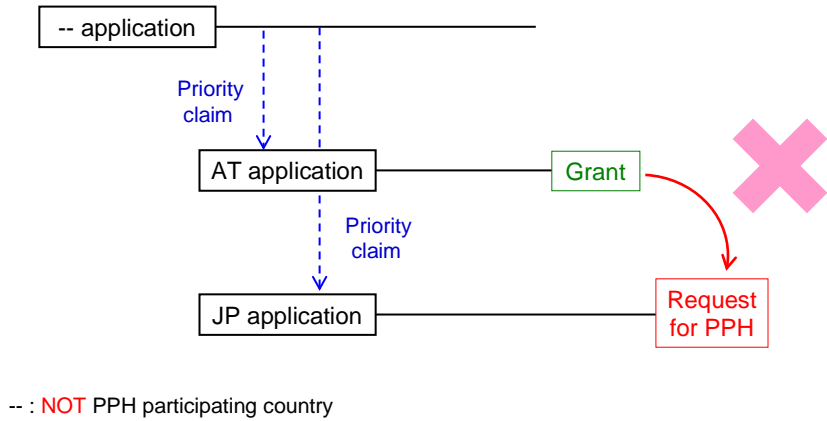
**A** A case meeting requirement (a) (i)  
- Paris route -



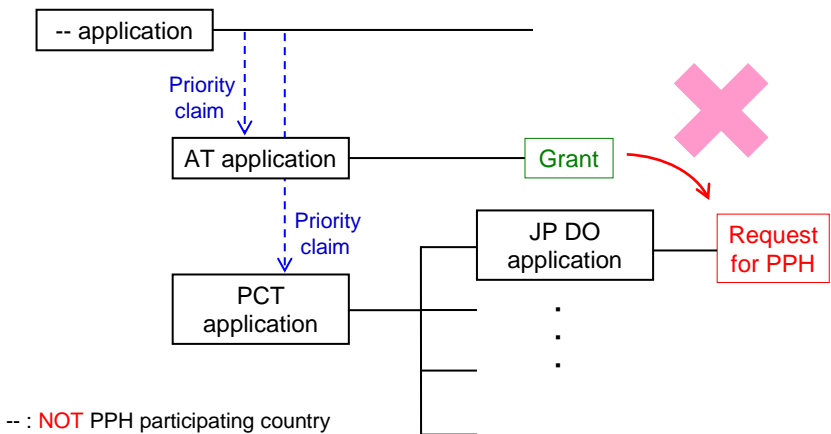
**B** A case meeting requirement (a) (i)  
- PCT route -



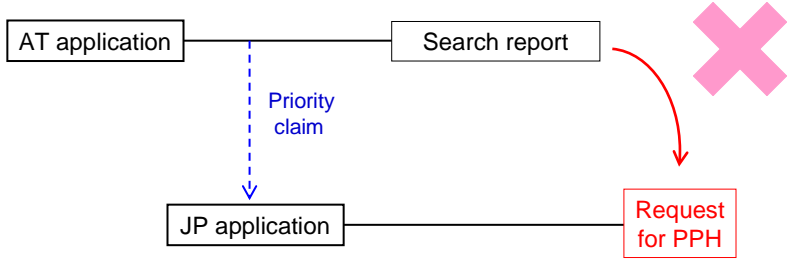
**C** A case not meeting requirement (a)  
- Paris route, but the first application is from the third country -



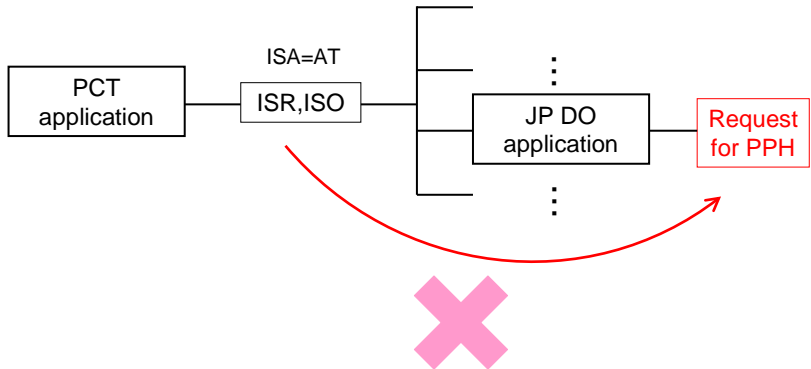
**D** A case not meeting requirement (a)  
- PCT route, but the first application is from the third country -



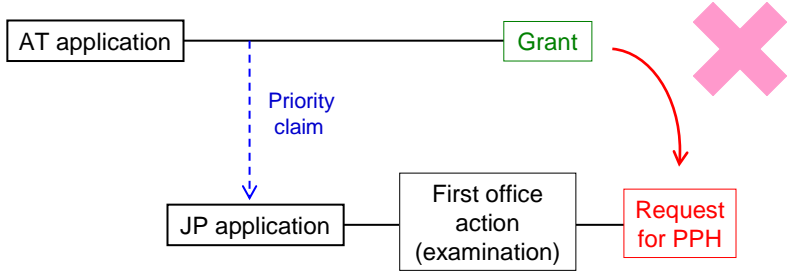
**E** A case not meeting requirement (b)  
- Search report -



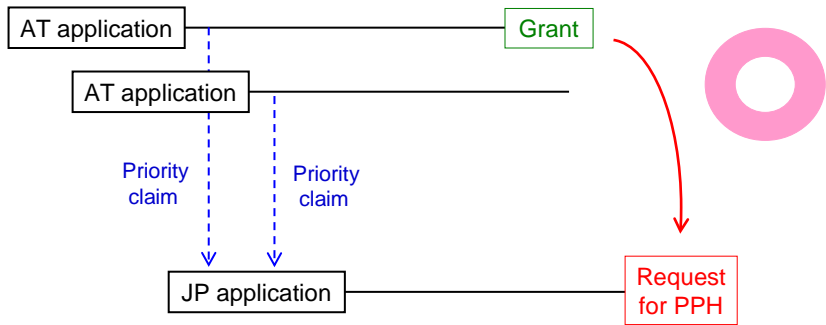
**F** A case not meeting requirement (b)  
- ISR, ISO -



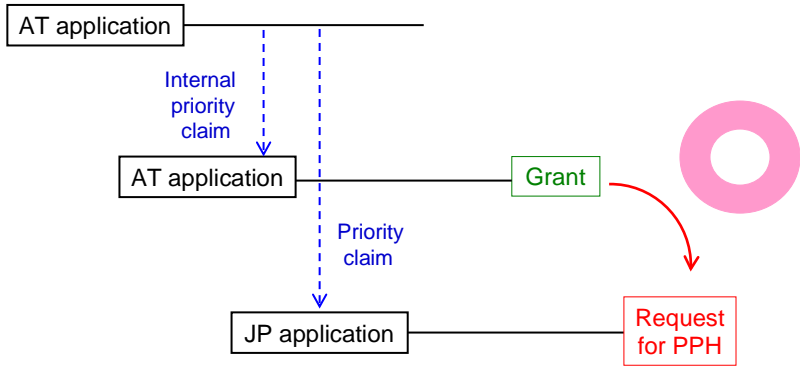
**G** A case not meeting requirement (d)  
- Examination has begun before a request for PPH -



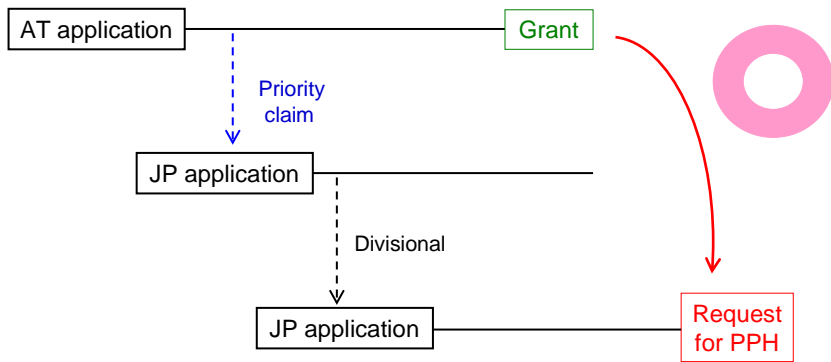
**H** A case meeting requirement (a) (i)  
- Paris route & Complex priority -



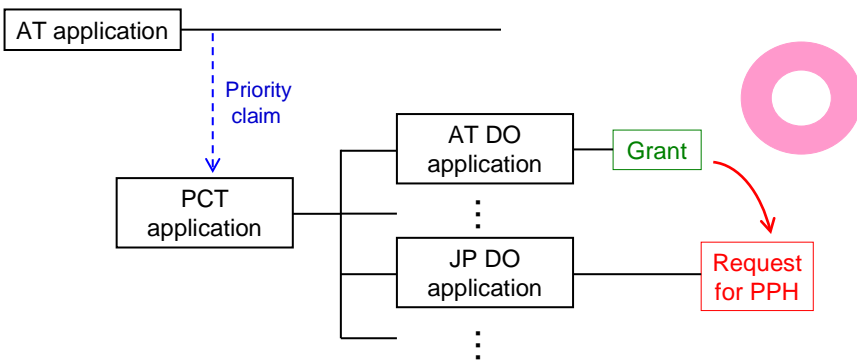
I A case meeting requirement (a) (i)  
- Paris route & Internal priority -



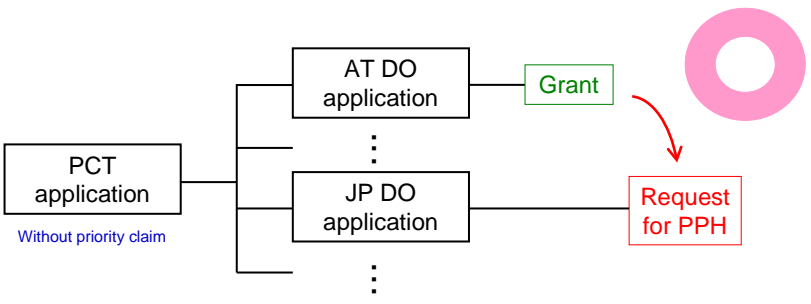
J A case meeting requirement (a) (i)  
- Paris route & divisional application -



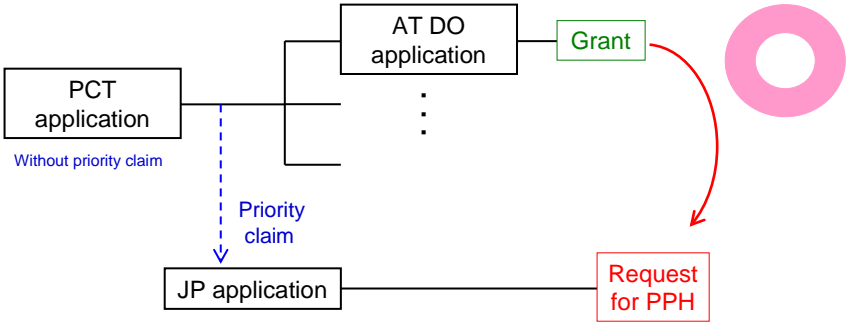
**K** A case meeting requirement (a) (i)  
- PCT route -



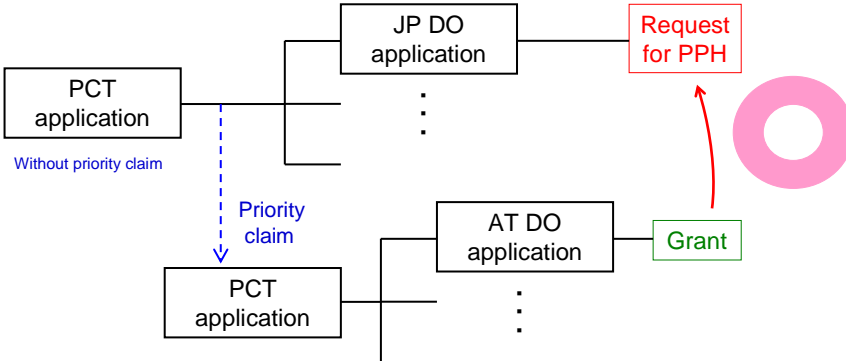
**L** A case meeting requirement (a) (ii)  
- Direct PCT route -



**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 -

