

Procedures to file a request to the JPO (Japan Patent Office) for Patent Prosecution Highway Pilot Program between the JPO and the IPO-CZ (Industrial Property Office of the Czech Republic)

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the JPO and satisfies the following requirements under the JPO-IPO-CZ Patent Prosecution Highway pilot program based on the IPO-CZ application.

When filing a request for the PPH pilot program, 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".

The PPH pilot program between JPO and IPO-CZ will commence on April 1, 2015, for a trial period of 3 years. The JPO and IPO-CZ will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period. The offices may terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex ante notice will be published if the PPH pilot program is terminated.

1. Requirements

(a) Both the JPO application on which PPH is requested and the IPO-CZ 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 IPO-CZ application(s) (examples are provided in ANNEX, Figures A, B, G, H and I), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the IPO-CZ application(s) (including PCT national phase application(s)) (examples are provided in ANNEX, Figures C and D), or

(Case III) an application which shares a common priority document with the IPO-CZ application(s) (including PCT national phase application(s)) (examples are provided in ANNEX, Figures E, F, K, L and M), or

(Case IV) a PCT national phase application where both the JPO application and the

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

IPO-CZ application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX, Figure J).

The pilot program is not applicable on the basis of IPO-CZ 'utility model' applications.

(b) At least one corresponding application exists in the IPO-CZ and has one or more claims that are determined to be patentable/allowable by the IPO-CZ.

The corresponding application can be an application which provides the basis of the priority claim under the Paris Convention for the JPO application, an application which derived from the IPO-CZ application which forms the basis of the priority claim (e.g. a divisional application of the IPO-CZ application), or an IPO-CZ national phase application of a PCT application.

Claims are "determined to be allowable/patentable" when the IPO-CZ examiner clearly identifies the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet. The office action may be either:

- (i) Search Report - indicating documents which are relevant ("X" – destroying novelty, "Y" – destroying inventive step for claim no "n")
- (ii) First Substantive Examination Report – indicating obstacles to granting a patent
- (iii) Decision of partially refusing a patent - indicating claim(s) and reasons
- (iv) Decision of granting a patent
- (v) Appeal Decision

(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 IPO-CZ.

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 IPO-CZ, or the claims in the JPO are narrower in scope than the claims in the IPO-CZ.

In this regard, a claim that is narrower in scope occurs when an IPO-CZ 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 IPO-CZ is not considered to sufficiently correspond. For example, where the IPO-CZ 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.

Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in

the IPO-CZ application.

(d) The JPO has not begun examination of the application at the time of request for the PPH (an example is provided in ANNEX, figure N).

(e) A “Request for Substantive Examination” must have been filed at the JPO either at the time of the PPH request or previously.

2. Documents to be submitted

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 (which are relevant to substantial examination for patentability in the IPO-CZ), which were sent for the corresponding application by the IPO-CZ, and translations of them².

Either Japanese or English is acceptable as translation language.

(b) Copies of all claims determined to be patentable/allowable by the IPO-CZ, and translations of them².

Either Japanese or English is acceptable as translation language.

(c) Copies of references cited by the IPO-CZ examiner

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

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the JPO application sufficiently correspond to the patentable/allowable claims in the IPO-CZ application.

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

² 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.

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.

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

(1) Circumstances

When an applicant files a request for an accelerated examination under the 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”³.

The applicant must indicate that the application is included in (i) to (iv) of 1. (a), and that the accelerated examination is requested under the PPH pilot program. The application number, publication number, or a patent number of the corresponding IPO-CZ application(s) also must be written.

*In the case that the application which has one or more claims that are determined to be patentable/allowable is different from the IPO-CZ application(s) included in (i) to (iv) 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/allowable and the relationship between those applications also must be written.

(2) Documents to be submitted

The applicant must list all required documents mentioned above 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

³ http://www.jpo.go.jp/torikumi/t_torikumi/souki/pdf/v3souki/guideline.pdf

“Form 2 for Accelerated Examination” for paper procedures.).

4. Procedure for the accelerated examination under the PPH pilot program

The JPO decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above.

When the JPO decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH.

In those instances where 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. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again.

Example form of on-line procedures

(Example of the request based on the claims indicated patentable/allowable in the written opinion of the report on the state of the art)

<p>【書類名】 早期審査に関する事情説明書 The name of this paper</p>	<div style="border: 1px solid orange; padding: 5px; display: inline-block;">Bibliographical items</div>
<p>【提出日】 平成00年00月00日 Date of filing</p>	
<p>【あて先】 特許庁長官殿 Destination</p>	
<p>【事件の表示】 【出願番号】 特願 0000-000000 Application number</p>	
<p>【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</p>	
<p>【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</p>	
<p>【早期審査に関する事情説明】 The explanation of circumstances concerning accelerated examination</p>	
<p>1. 事情 特許審査ハイウェイに基づく早期審査の申請を行う。 本出願はチェコ産業財産庁への出願(特許出願番号00000000)をパリ条約に基づく優先権の基礎出願とする出願である。当該チェコ出願に対しては、チェコ産業財産庁により特許査定が発行されている。</p>	
<p>1. Circumstances The accelerated examination is requested under the PPH program. This application is an application validly claiming the priority under the Paris Convention to the corresponding IPO-CZ application (the application number is 000000000), and the Decision to Grant a Patent has been issued by the IPO-CZ.</p>	
<p>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。</p>	
<p>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.”</p>	
<div style="border: 1px solid orange; padding: 10px;"> <p>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】.”</p> </div>	

【提出物件の目録】 ← List up the documents to be submitted

The list of submitted documents

【物件名】 PPH 申請書 1
【物件名】 **年**月**日付の拒絶理由通知書の写し及びその翻訳文 1
【物件名】 **年**月**日付の特許査定書の写し及びその翻訳文 1
【物件名】 特許可能と判断された請求項の写し及びその翻訳文 1
【物件名】 引用非特許文献1 1

(The name of the document) PPH request form 1
(The name of the document) Copy and translation of Notification of Reasons for Refusal in the IPO-CZ on (date) 1
(The name of the document) Copy and translation of grant in the IPO-CZ on (date) 1
(The name of the document) Copy and translation of the claims indicated patentable in the report on the state of the art and written opinion in the IPO-CZ on (date) 1
(The name of the document) Cited non patent literature1 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】 PPH 申請書
PPH request form

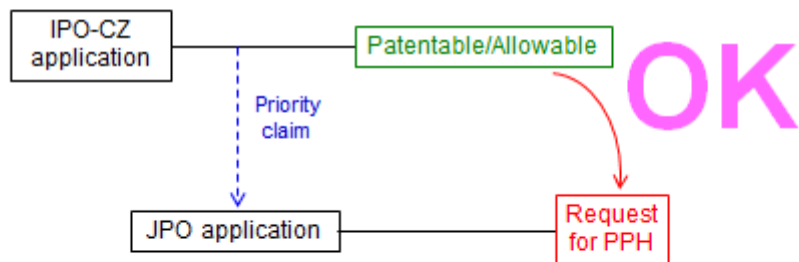
【内容】

IV. 先の提出書類の援用の表示 (Previously submitted documents)			
6. <input type="checkbox"/> 上記において「添付する」とチェックした書類のうち、先に提出した書類を援用する (If any of the above mentioned documents have been submitted before, please specify:)			
		(先行庁のオフィスアクションの写し、及び、その翻訳文)	
		(先行庁における特許可能な請求項、及び、その翻訳文)	
		(引用非特許文献)	
V. 提出物件 (援用する物件は除く) (List of names of documents submitted) 早期審査に関する事情説明書に記載のとおり。			
VI. 提出を省略する物件 (List of names of documents omitted for submission)			
		(先行庁のオフィスアクションの写し、及び、その翻訳文)	
		(先行庁における特許可能な請求項、及び、その翻訳文)	
		(引用特許文献)	
		米国特許第0000000号公報	
		ドイツ出願公開第00 0000 000 000.0号公報	
D. 請求項の対応関係 (Claims Correspondence)			
<input checked="" type="checkbox"/> 先行庁の特許可能な全請求項と完全に一致する (請求項の削除、追加、並び替えが無く、請求項の文言が完全に一致する) (All the claims in the application sufficiently correspond to the patentable/allowable claims in the OEE application; or)			
<input type="checkbox"/> 請求項の対応関係は、以下の表に記載 (Claims correspondence is explained in the following table)			
	本出願の請求項 (Application Claims)	先行庁の対応請求項 (Corresponding OEE claims)	対応関係に関するコメント (複数の出願と対応する場合は、コメント欄に対応する出願番号も記載して下さい。) (Explanation regarding the correspondence)
E. 見解書、予備審査報告の第VIII欄 (国際出願に対する意見) に対する釈明 (explaining any Box VIII observations of WO/ISA, WO/IPEA or IPER)			
出願人又は代理人 (Name(s) of applicant(s) or representative(s)) 早期審査に関する事情説明書に記載のとおり。			
提出日 (Date) 早期審査に関する事情説明書に記載のとおり。			
提出者 (Signature(e) of the applicant/representative) 早期審査に関する事情説明書に記載のとおり。			

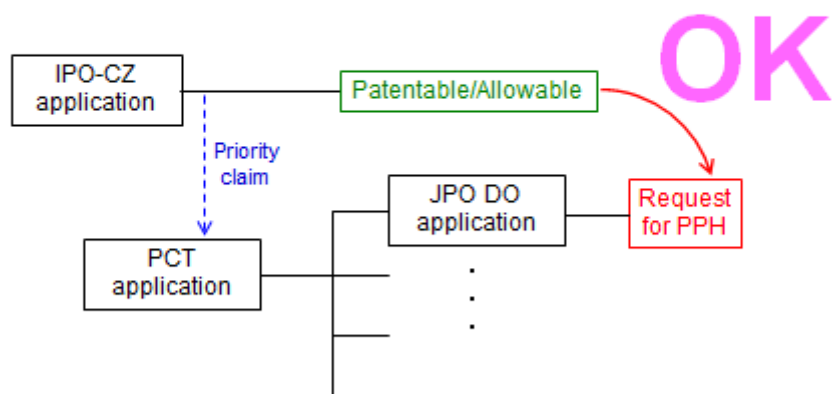
【物件名】 **年**月**日付の拒絶理由通知書の写し及びその翻訳文
Copy and translation of Notification of Reasons for Refusal in the IPO-CZ on (date)
【内容】 Attach the copy of the document.
Use the same name as “【物件名】” under “【提出物件の目録】.”
【物件名】 **年**月**日付の特許査定書の写し及びその翻訳文 1
Copy and translation of grant in the IPO-CZ on (date)
【内容】 Attach the copy of the document.
【物件名】 特許可能と判断された請求項の写し及びその翻訳文 1
Copy and translation of the claims indicated patentable in the report on the state of the art and written opinion in the IPO-CZ on (date)
【内容】 Attach the copy of the document.
【物件名】 引用非特許文献 1
Cited non-patent literature1
【内容】 Attach the copy of the document.

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.

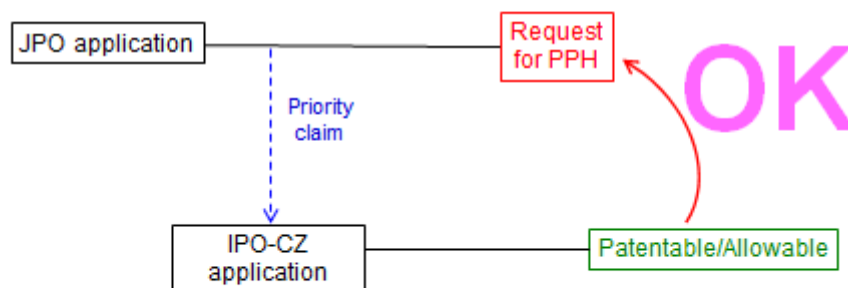
A A case meeting requirement (a) (I)
- Paris route -



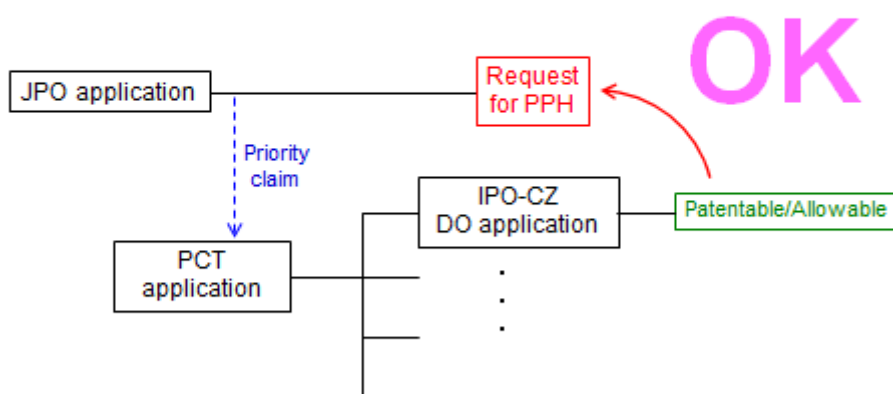
B A case meeting requirement (a) (I)
- PCT route -



C A case meeting requirement (a) (II)
- Paris route -



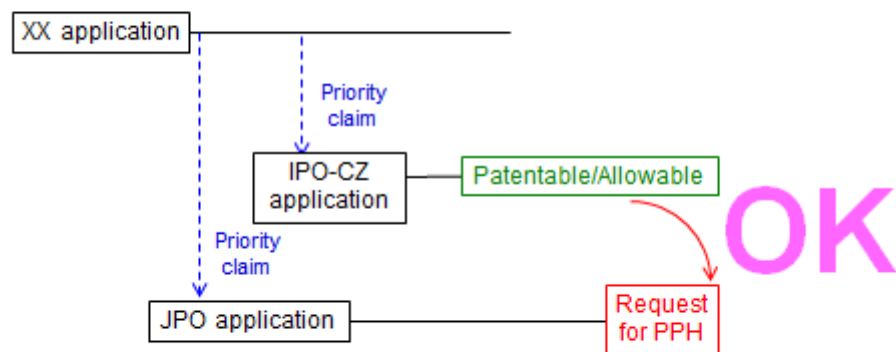
D A case meeting requirement (a) (II)
- PCT route -



E

A case meeting requirement (a) (III)

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

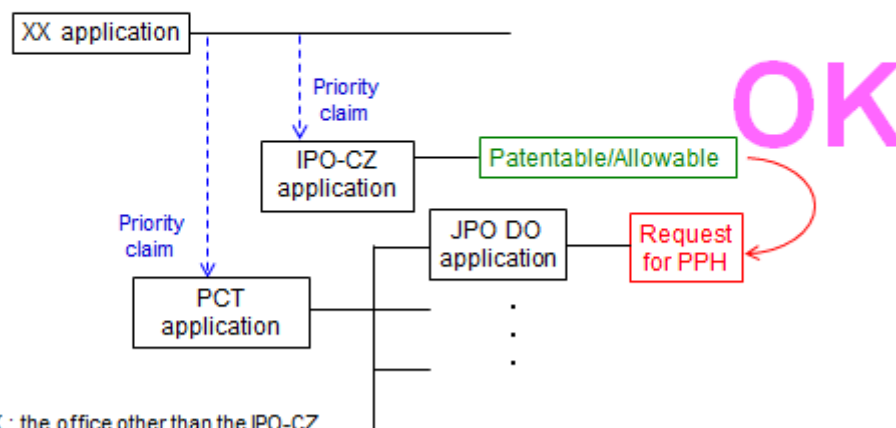


XX : the office other than the IPO-CZ

F

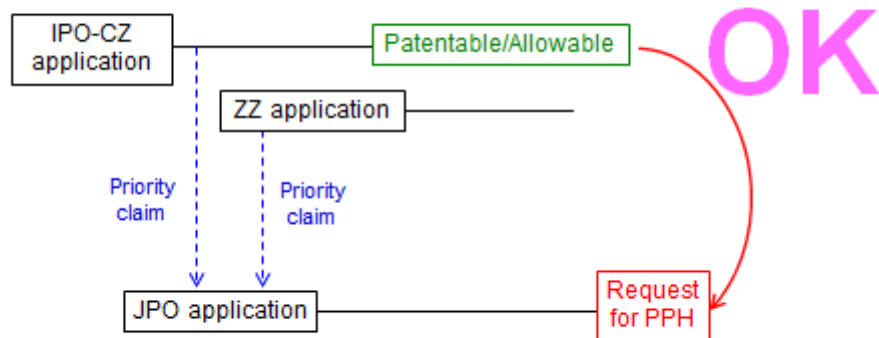
A case meeting requirement (a) (III)

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



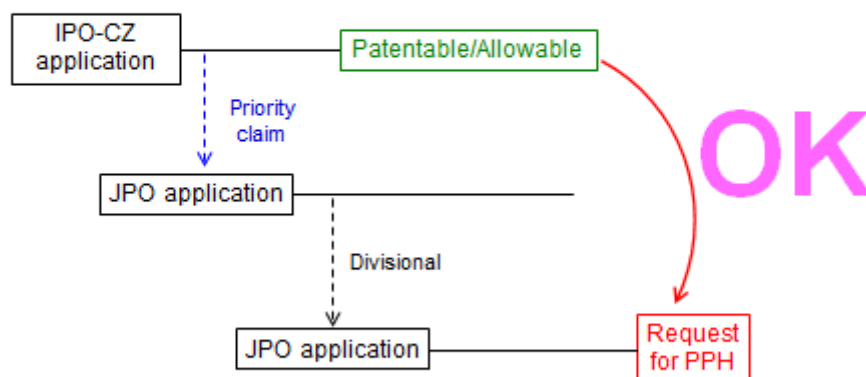
XX : the office other than the IPO-CZ

G A case meeting requirement (a) (I)
- Paris route & Complex priority -

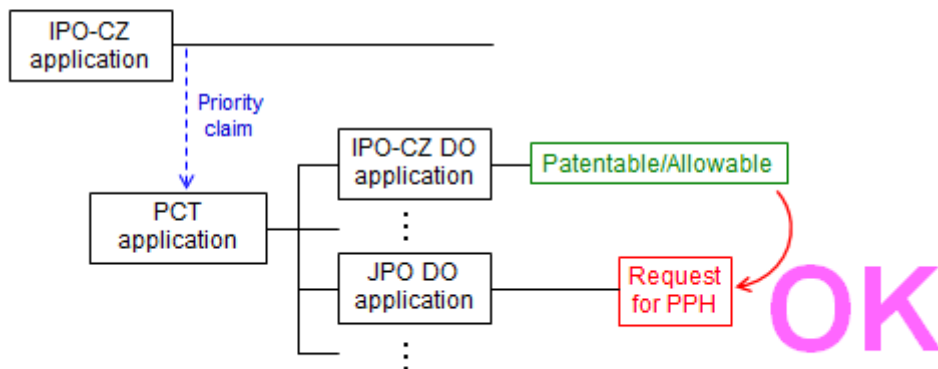


ZZ : any office

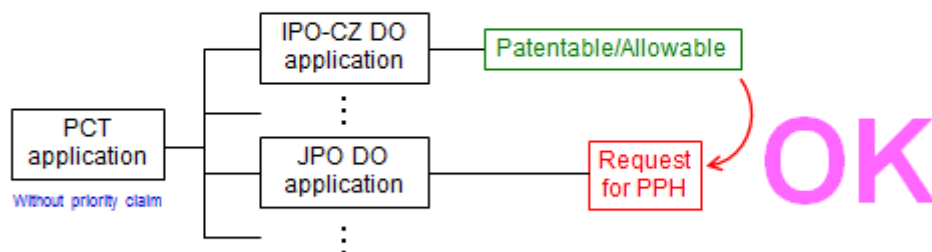
H A case meeting requirement (a) (I)
- Paris route & divisional application -



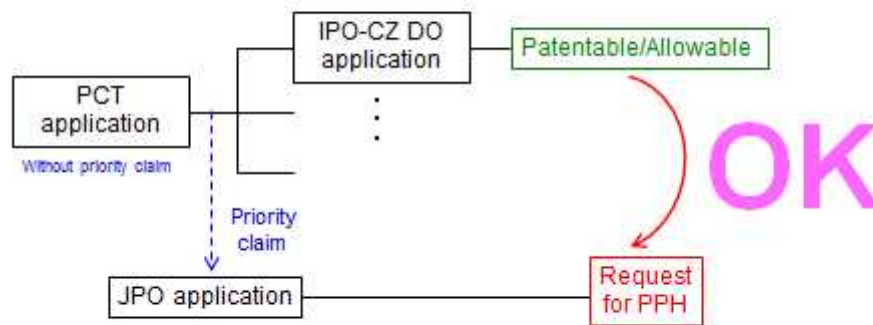
I A case meeting requirement (a) (I)
- PCT route -



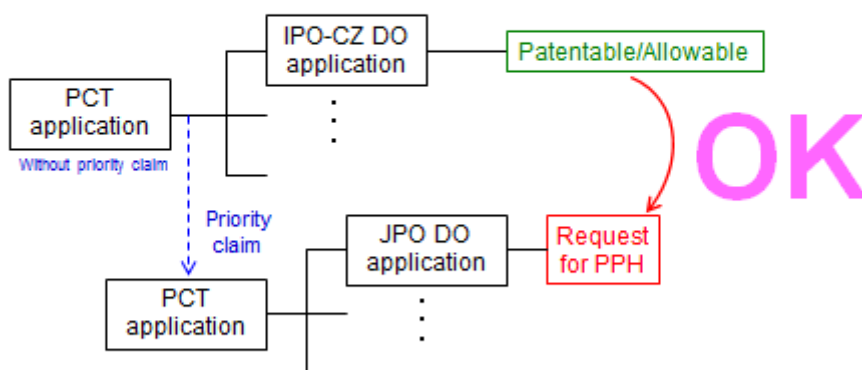
J A case meeting requirement (a) (IV)
- Direct PCT route -



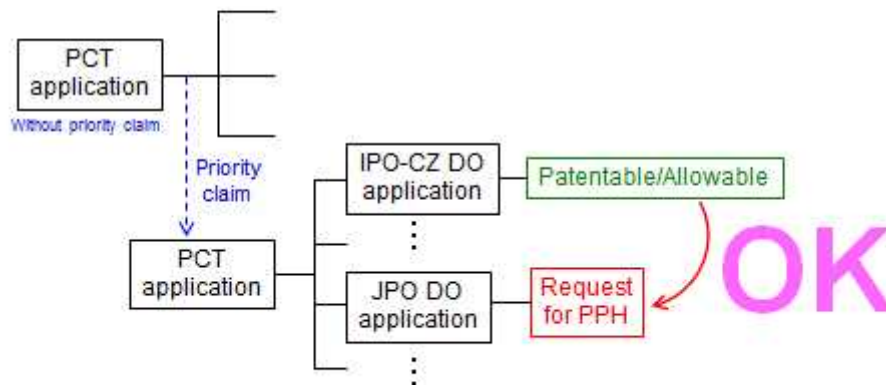
K A case meeting requirement (a) (III)
- Direct PCT & Paris route -



L A case meeting requirement (a) (III)
- Direct PCT & PCT route -



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



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

