

Procedures to file a request to the Japan Patent Office (JPO) for the Patent Prosecution Highway Pilot Program between the JPO and the Intellectual Property Office of Singapore (IPOS)

1. Request to the JPO

When an applicant files a request for an accelerated examination under the Patent Prosecution Highway (hereinafter called “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.”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,” if the application, filed to the JPO, satisfies all the conditions prescribed in the following item (1) and the applicant attaches, to “The Explanation of Circumstances Concerning Accelerated Examination,” the documents specified in the following item (2).

(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 corresponding IPOS application(s) (examples are provided in Annex, figures A, B, E, F, G and H), or
- (ii)** a PCT national phase application without priority claim (an example is provided in Annex, figure I), 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, figures J, K and L).

Only in the case where the corresponding IPOS application used the all-foreign approach, the requirements of OFF and OSF are removed. In other words, if an IPOS application has adopted examination results from the KIPO, the UK-IPO or the USPTO as a prescribed office, the JPO application which validly claims priority under the Paris Convention to the IPOS application is eligible for PPH request (examples are provided in Annex, figures C’ and D’). or

¹ http://www.jpo.go.jp/torikumi/t_torikumi/souki/exe/v3souki/guideline.exe (Japanese only)
“The Explanation of Circumstances Concerning Accelerated Examination” is described on pages 27-29.

the JPO application which validly claims priority under the Paris Convention to the prescribed office application is eligible for PPH request based on the IPOS application which claims priority to the prescribed office application (examples are provided in Annex, figures C” and D”).

The JPO application, which validly claims priority to multiple IPOS or PCT applications, or which is the divisional application validly based on the originally filed application that falls into any of the categories (i) to (iii) above, is also eligible.

- (b) At least one corresponding application exists in IPOS and has one or more claims that has/have been determined by IPOS to be allowable/patentable in a substantive examination carried out in the name of IPOS or based on examination results adopted by IPOS from the KIPO, the UK-IPO or the USPTO as a prescribed patent office referred to in the Singapore patent legislation.**

Claims clearly identified to be allowable/patentable in the latest examination report can form the basis for a request for an accelerated examination under the PPH Pilot Program, even if the application which includes those claims is not granted a patent yet.

- (c) Each of the claims in the JPO application (for which an accelerated examination under the PPH Pilot Program is requested) must or be amended to sufficiently correspond to one or more claims that has/have been determined by IPOS to be allowable/patentable in a substantive examination carried out in the name of IPOS or based on examination results adopted by IPOS from the KIPO, the UK-IPO or the USPTO as a prescribed patent office referred to in the Singapore patent legislation.**

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 IPOS, or the claims in the JPO are narrower in scope than the claims in IPOS. In this regard, a claim that is narrower in scope occurs when an IPOS claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims). Preferably, the claim should be presented in dependent form. A claim in the JPO which introduces a new/different category of claims to those claims indicated as allowable in IPOS is not considered to sufficiently correspond. For example, the IPOS 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.

Where the application of IPOS used the all-local approach or the combination approach in IPOS, the aforementioned phrase “one or more claims that has/have been determined by IPOS to be allowable/patentable” should be interpreted to mean one or more claims determined to be allowable/patentable in the examination report made in the name of

IPOS. For the sake of clarity, the claims referred to in the aforementioned phrase do NOT mean those that have been amended after the examination report was prepared and thus were not subject to the assessment of allowability/patentability in the examination report.

(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 them to “The Explanation of Circumstances Concerning Accelerated Examination.”

“The Explanation of Circumstances Concerning Accelerated Examination” must be entered not in English but in Japanese.

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 office actions*

(i) *Where the application of IPOS used the all-local approach or the combination approach in IPOS, copies of all office actions² which have been sent for the corresponding application in its examination in the name of IPOS.*

(ii) *Where the application of IPOS used the all-foreign approach in IPOS, copies of all office actions which have been issued by the prescribed patent office referred to in the Singapore patent legislation for the corresponding application filed at the KIPO, the UK-IPO or the USPTO as the prescribed patent office referred to in the Singapore patent legislation.*

In the case where the prescribed patent office is the KIPO or the USPTO, there is no need to submit copies of office actions if they are available from the Dossier Access Systems (PAIR and K-PION).

In the case where the prescribed patent office is the KIPO, translations of copies of office actions are also required unless they are available from the K-PION. Both Japanese and English are acceptable as translation languages.

(b) *Copies of allowable/patentable claims*

(i) *Where the application of IPOS used the all-local approach or the combination approach in IPOS, copies of all claims that have been determined by IPOS to be allowable/patentable in a substantive examination carried out in the name of IPOS.*

(ii) *Where the application of IPOS used the all foreign approach in IPOS, copies of all*

² Office actions are documents which relate to substantive examination.

claims that have been granted a patent by IPOS on the basis of examination results adopted by IPOS from at the KIPO, the UK-IPO or the USPTO as the prescribed patent office referred to in the Singapore patent legislation, and copies of all prescribed information relating to the corresponding application filed at the aforementioned prescribed patent office referred to in the Singapore patent legislation.

In the case where the prescribed patent office is the KIPO or the USPTO, there is no need to submit copies of allowable/patentable claims if they are available from the Dossier Access Systems (PAIR and K-PION).

In the case where the prescribed patent office is the KIPO, the translation of copies of allowable/patentable claims are also required unless they are available from the K-PION, Both Japanese and English are acceptable as translation languages.

(c) *Copies of references cited by the examiner*

If the references are patent documents, the applicant does not have to submit them, as the JPO usually possesses them. When the JPO does not possess any patent document cited by the examiner, 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 must submit a claim correspondence table, which indicates how all claims in the JPO application sufficiently correspond to the allowable/patentable claims of the IPOS application. If the IPOS application used the all-foreign approach, the applicant must also submit a claim correspondence table which indicates how all claims in the JPO application correspond to the allowable/patentable claims of the prescribed patent office application referred to in the Singapore patent legislation.

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 above criteria (1) (c). (Please refer to the **Example form**.)

Both Japanese and English are acceptable as the language used in the claim correspondence table.

When the applicant has already submitted the above documents (a) to (d) to the JPO through simultaneous or past procedures, the applicant may incorporate the documents by reference by stating so in the PPH request form and does not have to attach them.

When the application does not fulfill the above requirements (1) and (2), the PPH request, i.e. the request for an accelerated examination, will be denied.

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 a request for an accelerated examination under the PPH Pilot Program

(1) Circumstances

The applicant must indicate that the JPO application falls into any of the categories (i) to (iii) of the aforementioned item (1) (a), and that accelerated examination is requested under the PPH Pilot Program. Furthermore, the application number of the corresponding IPOS application(s) also must be written.

Where the application of IPOS used the all-foreign approach in IPOS, the applicant must indicate the application number of the corresponding application filed at the KIPO, the UK-IPO or the USPTO as the prescribed patent office referred to in the Singapore patent legislation.

In the case where the application which has one or more claims that has/have been determined to be allowable/patentable is different from the one falling into (i) to (iii) of (1) (a) (for example, the divisional application of the basic application) the application number of the application(s) which has claims determined to be allowable/patentable and the relationship between those applications also must be written.

(2) Documents to be submitted

The applicant must list all the required documents mentioned in the above item 1 (2) in an identifiable way, even when he/she omits to submit certain documents.

(3) Notice

Forms of “The Explanation of Circumstances Concerning Accelerated Examination” are different between the on-line procedure and the paper procedure. Please refer to the examples of forms when filling in (“Form 1 for Accelerated Examination” for the on-line procedure is described on page 27, and “Form 2 for Accelerated Examination” for the paper procedure is described on page 28-29 in “the Guidelines of the Accelerated Examination and Appeal”).

The Example forms of on-line procedures are shown below.

Example form of on-line procedures (in the case of all-local approach or combination approach)

<p>【書類名】 早期審査に関する事情説明書 The name of this paper</p>	
<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】 0000000000 【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】 0000000000 【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 本出願はシンガポール知的財産庁への出願(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。</p>	
<p>1. Circumstances This application is an application validly claiming the priority under the Paris Convention to the corresponding IPOS application (application number: 00000000), and the accelerated examination is requested under the PPH pilot program.</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。

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."

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】."

List up the documents which can be omitted to submit

(提出を省略する物件)

- (物件名) 対応シンガポール出願の特許公報であるシンガポール特許第000000号公報
- (物件名) 対応シンガポール出願に対して引用されたドイツ出願公開000000号公報
- (物件名) 対応シンガポール出願に対して引用された日本国特許第000000号公報

(Documents to be omitted to submit)
(The name of the document) Corresponding IPOS application's patent gazette: Publication number 0000000
(The name of the document) Cited reference of the corresponding IPOS application: German Publication of application 0000000
(The name of the document) Cited reference of the corresponding IPOS application: Japanese Patent publication of application 0000000

List up the documents to be submitted

【提出物件の目録】

The list of submitted documents

- 【物件名】 シンガポール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**日付の対応シンガポール出願に対する調査報告書の写し 1
- 【物件名】 **年**月**日付の対応シンガポール出願に対する審査報告書の写し 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 IPOS sufficiently correspond to the claims in the JPO application 1
(The name of the document) Copy of search report in IPOS on (date) 1
(The name of the document) Copy of examination report in IPOS 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】.”

【添付物件】

The list of attached documents

Attach the document here as image file or text.

【物件名】 シンガポール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 IPOS sufficiently correspond to the claims in the JPO application

【内容】

本出願の請求項	シンガポール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 IPOS	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、シンガポールの請求項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 IPOS

【物件名】 引用非特許文献1

Cited non-patent literature1

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

【内容】

Attach the copy of the document.

Example form of on-line procedures (in the case of all-foreign approach)

<p>【書類名】 早期審査に関する事情説明書 The name of this paper</p>	<p>Bibliographical items</p>
<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 本出願はシンガポール知的財産庁への出願(特許出願番号0000000)をパリ条約に基づき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。そして、当該シンガポール出願は、所定庁である米国特許商標庁への出願(出願番号00/000000)の審査結果に基づき特許が付与されている。</p>	
<p>1. Circumstances This application is an application validly claiming the priority under the Paris Convention to the corresponding IPOS application (application number: 0000000), and the accelerated examination is requested under the PPH pilot program. IPOS application has adopted the examination results of the application (application number: 00/000000) filed in the USPTO as a prescribed patent office referred to in the Singapore patent legislation.</p>	
<p>Where the application of IPOS used the all-foreign approach in IPOS, the applicant must indicate the application number of the corresponding application filed at the KIPO, the UK-IPO or the USPTO as the prescribed patent office referred to in the Singapore patent legislation.</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。

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."

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】."

List up the documents which can be omitted to submit

(提出を省略する物件)

- (物件名)**年**月**日付の対応米国出願に対するファースト・オフィス・アクションの写し
- (物件名)**年**月**日付の対応米国出願に対する特許許可通知の写し
- (物件名)**年**月**日付の対応米国出願の特許請求の範囲の補正書の写し
- (物件名)対応米国出願に対して引用された米国特許第0000000号公報
- (物件名)対応米国出願に対して引用された日本国特許第0000000号公報

(Documents to be omitted to submit)
(The name of the document) Copy of the first office action in the USPTO on (date)
(The name of the document) Copy of notice of allowance in the USPTO on (date)
(The name of the document) Copy of the amendment of the claims in the USPTO on (date)
(The name of the document) Cited reference of the corresponding USPTO application: United States Publication of application 0000000
(The name of the document) Cited reference of the corresponding USPTO application: Japan Patent publication of application 0000000

List up the documents to be submitted

【提出物件の目録】

The list of submitted documents

- 【物件名】 シンガポール出願と本出願の請求項の対応関係を示す書面 1
- 【物件名】 所定庁出願と本出願の請求項の対応関係を示す書面 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 IPOS sufficiently correspond to the claims in the JPO application 1
(The name of the document) The table to explain how the claims indicated as allowable in the prescribed patent office sufficiently correspond to the claims in the JPO application 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】.”

【添付物件】

The list of attached documents

Attach the document here as image file or text.

【物件名】 シンガポール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 IPOS sufficiently correspond to the claims in the JPO application

【内容】

本出願の請求項	シンガポール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 IPOS	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、シンガポールの請求項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 IPOS

【物件名】 引用非特許文献1

Cited non-patent literature1

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

【内容】

Attach the copy of the document.

If the IPOS application was filed in the prescribed route, the applicant must also submit a claim correspondence table which indicates how all claims in the JPO application correspond to the allowable/patentable claims of the prescribed patent office application.

【物件名】 所定庁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 prescribed patent office sufficiently correspond to the claims in the JPO application

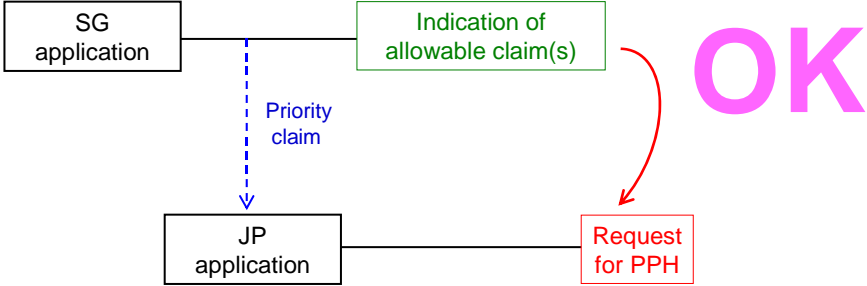
【内容】

本出願の請求項 The claim in the JPO	所定庁で特許可能とされた請求項 The patentable claim in a prescribed Office	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、所定庁の請求項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 prescribed Office.

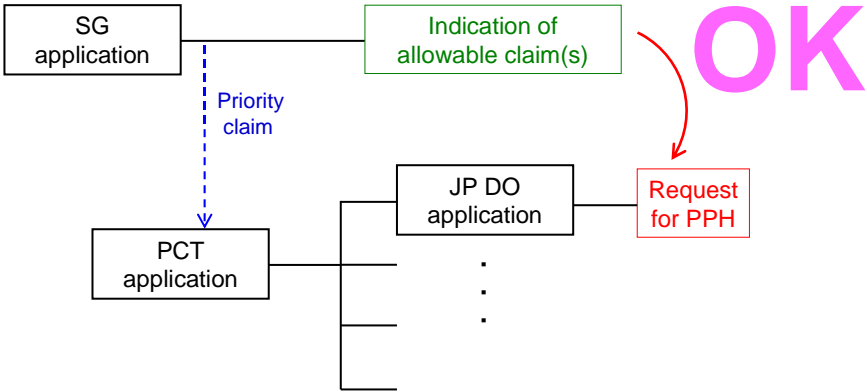
Note:

All SG (DO) applications in the following examples mean the applications which have one or more claims determined by IPOS to be allowable/patentable in a substantive examination carried out in the name of IPOS or based on examination results adopted by IPOS from the KIPO, the UK-IPO or the USPTO as the prescribed patent office referred to in the Singapore patent legislation.

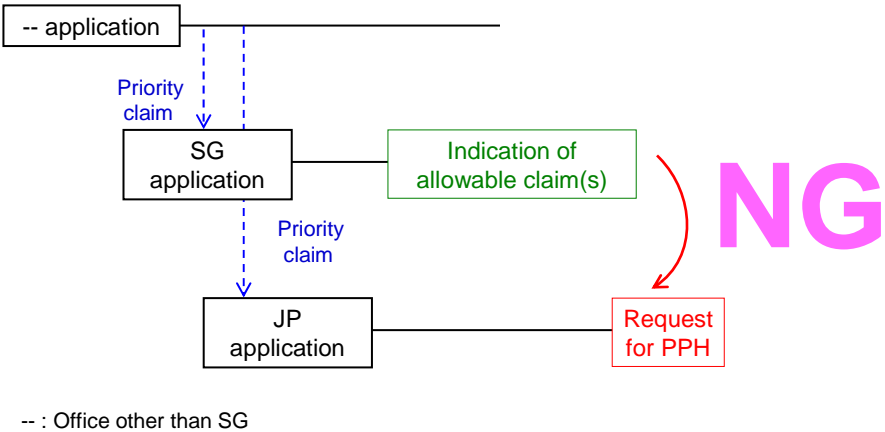
A A case meeting requirement (a) (i)
- Paris route -



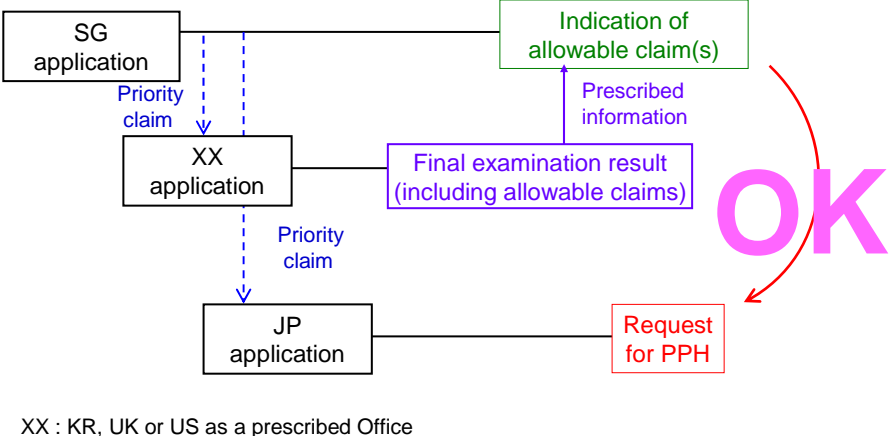
B A case meeting requirement (a) (i)
- PCT route -



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



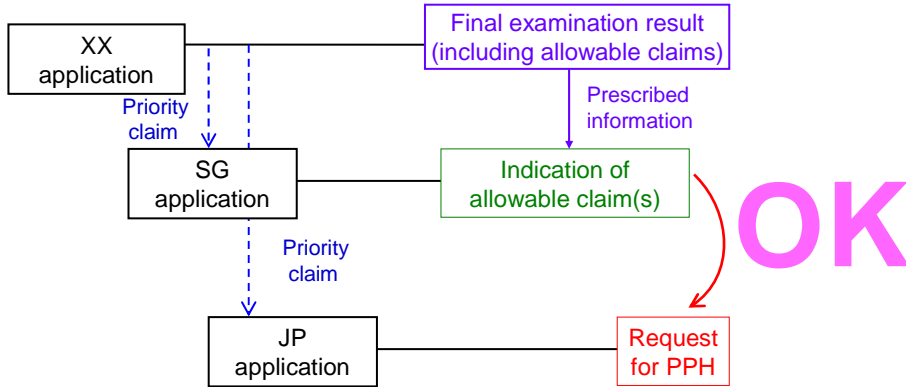
C' A case meeting requirement (a) (i)
- SG application has adopted examination results from the KIPO, the UK-IPO or the USPTO as a prescribed office. -



C”

A case meeting requirement (a) (i)

- SG application has adopted examination results from the KIPO, the UK-IPO or the USPTO as a prescribed office. -

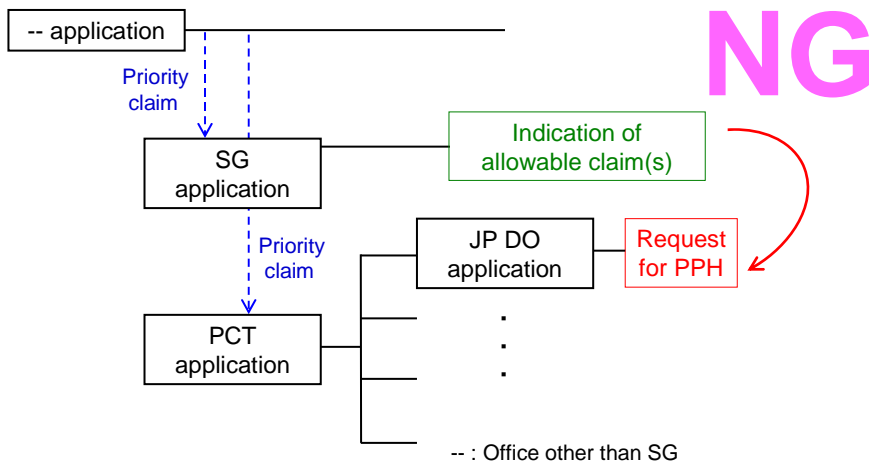


XX : KR, UK or US as a prescribed Office

D

A case not meeting requirement (a) (i)

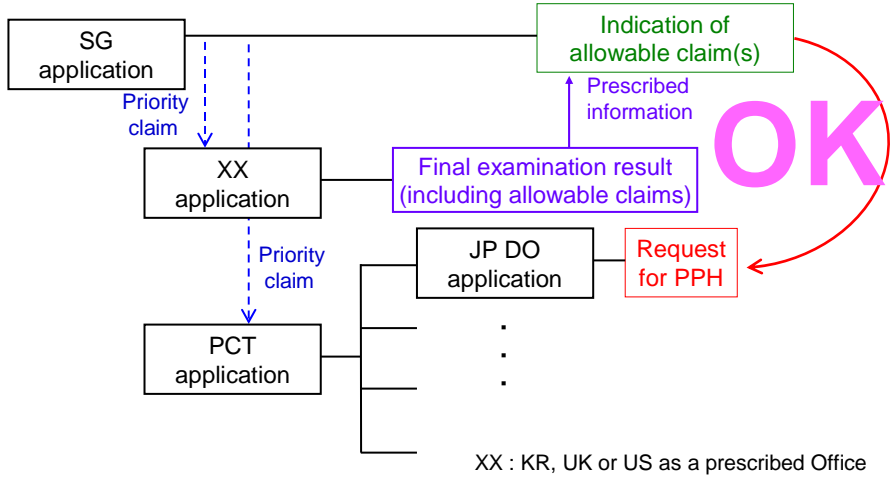
- PCT route, but the first application is from the third country -



D'

A case meeting requirement (a) (i)

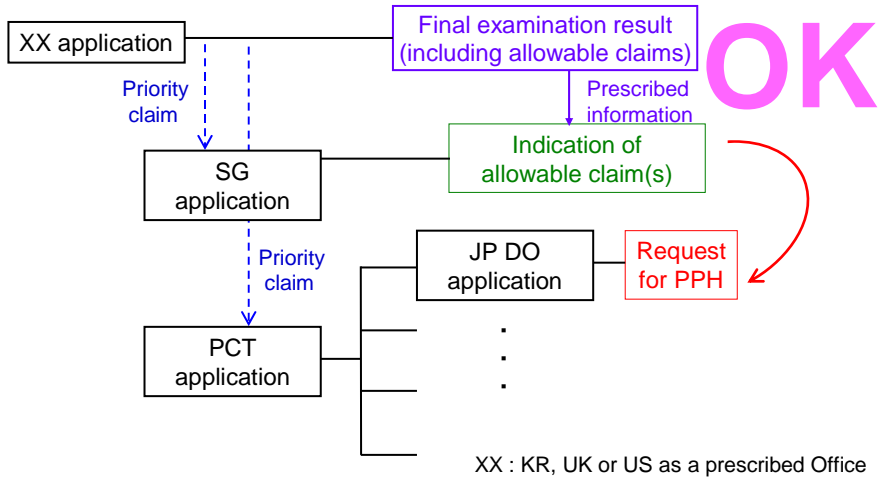
- SG application has adopted examination results from the KIPO, the UK-IPO or the USPTO as a prescribed office. -



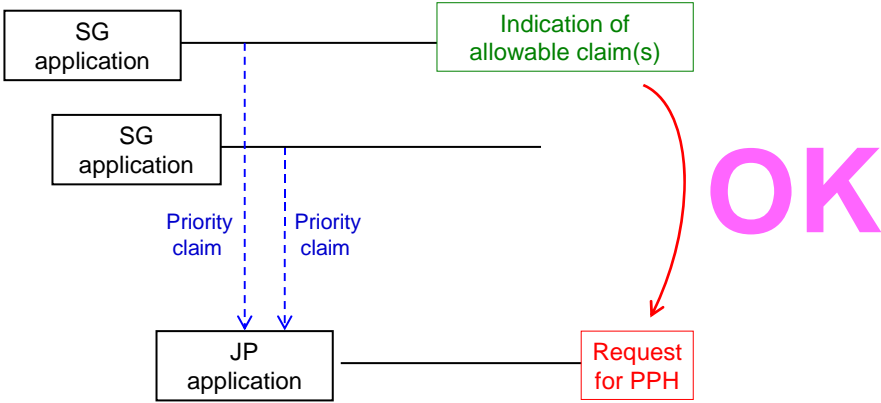
D''

A case meeting requirement (a) (i)

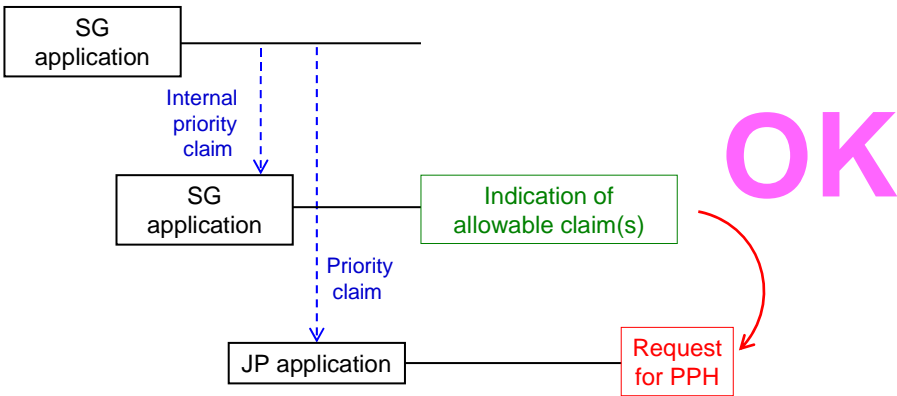
- SG application has adopted examination results from the KIPO, the UK-IPO or the USPTO as a prescribed office. -



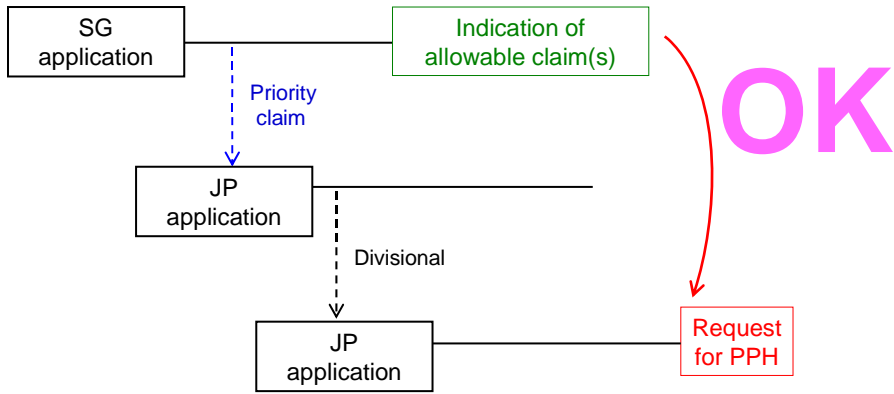
E A case meeting requirement (a) (i)
- Paris route & Complex priority -



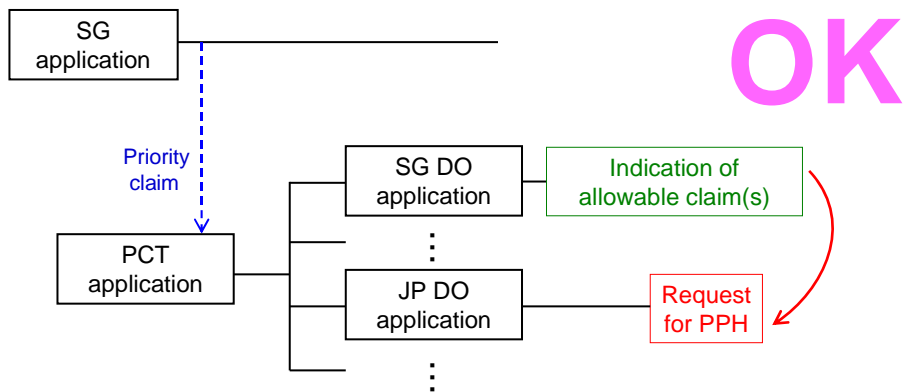
F A case meeting requirement (a) (i)
- Paris route & Internal priority -



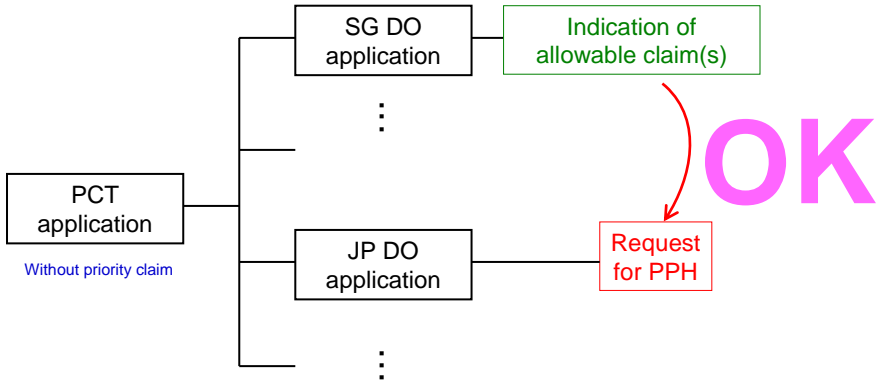
G A case meeting requirement (a) (i)
- Paris route & divisional application -



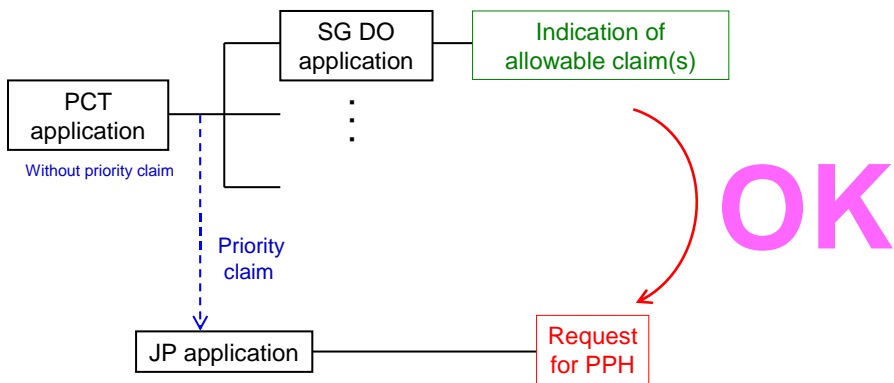
H A case meeting requirement (a) (i)
- PCT route -



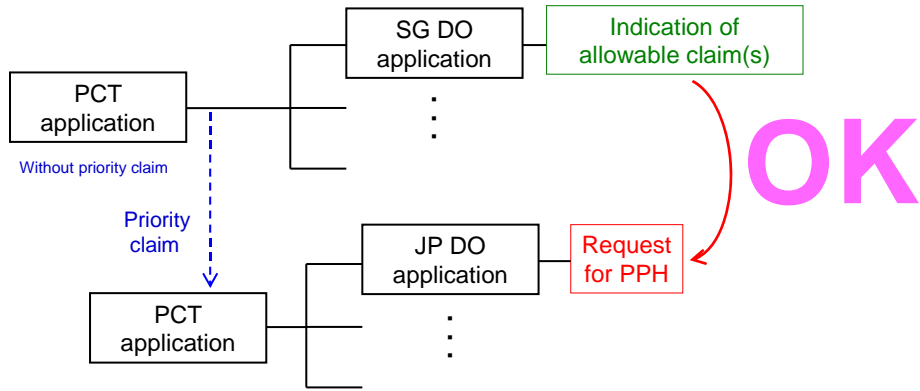
I A case meeting requirement (a) (ii)
- Direct PCT route -



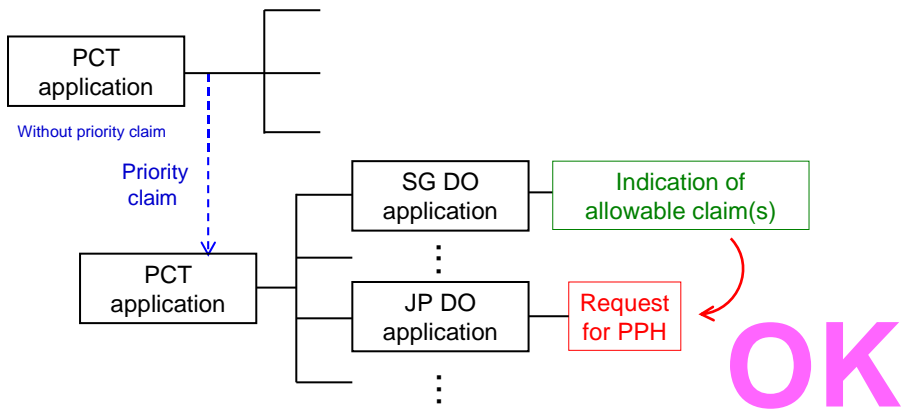
J A case meeting requirement (a) (iii)
- Direct PCT & Paris route -



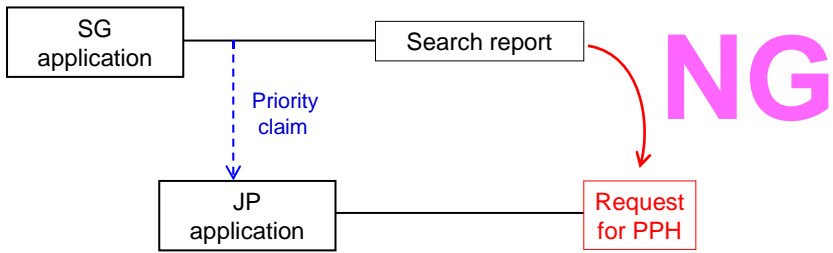
K A case meeting requirement (a) (iii)
- Direct PCT & PCT route -



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



M A case not meeting requirement (b)
- Search report -



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

