Procedure Guideline

- Procedures and Requirements for Filing a Request to the Japan Patent Office (JPO) for Patent Prosecution Highway (PPH) Pilot Project between the National Institute of Industrial Property (INPI) and the JPO -

Background

The PPH Pilot Project was established so that, once the Office of Earlier Examination (OEE) has determined patentability of an application, the applicant may request the benefit of accelerated examination of the corresponding application at the Office of Later Examination (OLE), provided that the requirements set forth herein are fulfilled.

This document is intended to define in detail the necessary procedures and requirements for requesting application of the PPH Pilot Project between the INPI and the JPO.

This PPH Pilot Project commences on December 1st, 2021 for a trial period of 5 years. PCT-PPH described on Part II is effective from January 1st, 2022. The INPI and the JPO will evaluate the results of the pilot project to determine whether and how the project should be fully implemented after the trial period. The pilot project may be extended by mutual consent of the Offices.

The Offices can suspend or terminate the PPH INPI-JPO Pilot Project for any reason and at any time. When Office intends to suspend or terminate the PPH INPI-JPO Pilot Project before its completion date, it should endeavor to issue a written notice to the other Office at least thirty days prior to the date of suspension or termination.
Part I

PPH using the national work products from the INPI

1. Requirements for Filing Request to JPO for Patent Accelerated Examination under the PPH Pilot Project.

In order to be eligible to participate in the PPH accelerated examination, the following requirements shall be fulfilled:

(a) Both the JPO patent application on which PPH is requested and the INPI patent or utility model application being the basis of the PPH request shall be corresponding applications (See examples in ANNEX I) having the same earliest date (either a priority date or a filing date). The applications of Paris-Route and Direct-PCT-Route will be eligible.

Applicant shall submit the necessary information to determine the relationship between the application on which the accelerated examination is requested and the corresponding application(s) filed with the INPI.

The expression “corresponding patent applications” should not be necessarily construed as referred to the application on which a priority claim is based, but it could refer to the application derived from the application on which priority is claimed. For example, a divisional application of the application or an application claiming national priority of the application on which priority is claimed.

For example, the JPO application may be:

(Case I) an application which validly claims priority under the Paris Convention from the JPO application(s) (examples are provided in Figures A, B, C, H, I and J elaborated in Annex I), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the JPO application(s) (including PCT national phase application(s)) (examples are provided in Figures D and E in Annex I), or

(Case III) an application which shares a common priority document filed to the JPO/INPI with the JPO application(s) (including PCT national phase application(s)) (examples are provided in Figures F, G, L, M and N in Annex I), or

(Case IV) a PCT national phase application where both the JPO application and the INPI application(s) are derived from a common PCT international application having no priority claim (an example is provided in Figure K in Annex I).
(b) The corresponding application has been substantively examined by INPI and has one or more claims considered as allowable by the INPI

Claims considered allowable shall be expressly identified as such in the INPI’s “Decision to Grant” and they will be the basis for the request for participation in the PPH project.

(c) In order to be examined pursuant to PPH, all the application claims, either as originally filed or as amended, shall sufficiently correspond to one or more of those claims indicated as allowable by the INPI so that the JPO application may be then allowed for accelerated examination under the PPH framework.

Claims are considered to "sufficiently correspond" when, considering differences due to translation and/or claim format, the scope of claims in the JPO application is the same as or narrower than that of claims in the INPI application.

In this regard, a claim that is narrower in scope occurs when an INPI 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 application which introduces a new/different category of claims to those claims indicated as allowable by the INPI shall not be considered to sufficiently correspond. For example, where the INPI claims only contain claims on a process of manufacturing a product, then, if the JPO claims introduce product claims that are dependent on the corresponding process claims, the JPO claims shall not be considered to sufficiently correspond.

(d) The JPO has not begun substantive examination of the application at the time the PPH is requested. (an example is provided in Figure O in Annex I)

2. Documents to be submitted with JPO for Accelerated Examination under PPH Pilot Project.

The request form for JPO accelerated examination within the PPH pilot project shall include the following documents:

(a) Copies of all Office actions (relevant to substantive examination for patentability at the INPI), which were issued in the corresponding application by the INPI, and their translation.

(b) Copies of all claims determined as allowable by the INPI and their translation.

Either Japanese or English is acceptable as translation language
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 as relevant by the INPI examiner

If references are patent documents, the applicant does not have to submit them because they are generally available to the JPO. When a patent document is not available to the JPO examiner, the applicant must submit it at the examiner’s request. Non-patent literature must always be submitted and, if necessary, accompanied by their respective translation.

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

(d) Claim Correspondence Table.

The applicant requesting the PPH must submit a claim correspondence table, which will indicate how all claims in the JPO application sufficiently correspond to the allowable claims in the INPI application.

When claims are just a literal translation, the applicant may only indicate that “they are the same” in the table. When claims are not just a literal translation, the sufficient correspondence of each claim must be explained.

3. Procedure for the accelerated examination under the PPH pilot project

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

(1) Circumstances
When an applicant files a request for an accelerated examination under the PPH pilot project 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”\(^1\). The JPO will digitally accept the PPH requests. The applicant must indicate that the application is included in Case I to IV of 1. (a), and that the accelerated examination is requested under the PPH pilot project. The application number, publication number, or a patent number of the corresponding INPI 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 INPI application(s) included in Case I to IV of 1. (a) (for example, the divisional application of the INPI 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 “Form 2 for Accelerated Examination” for paper procedures.).

Part II
PPH using the PCT international work products from the INPI (PCT-PPH)

1. Requirements
The application which is filed with the JPO and on which the applicant files a request under the PCT-PPH must satisfy the following requirements:

(1) The latest work product in the international phase of a PCT application corresponding to the application ("international work product"), namely the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive steps and industrial applicability).

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the INPI, but, if priority is claimed, the priority claim can be to an application in any Office, see example (A') in Annex II (application ZZ can be any national application).

The applicant cannot file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation irrespective of whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in PCT-PPH program if the applicant does not explain why the claim(s) is/are not subject to the observation. In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

(2) The relationship between the application and the corresponding international application satisfies one of the following requirements:

(A) The application is a national phase application of the corresponding international application. (See Figures A, A', and A” in Annex II)

(B) The application is a national application as a basis of the priority claim of the corresponding international application. (See Figure B in Annex II)

(C) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)

(D) The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure D in Annex II)
(E) The application is the derivative application (divisional application and application claiming priority etc.) of the application which satisfies one of the above requirements (A) – (D). (See Figures E1 - E3 in Annex II)

(3) All claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated as allowable in the latest international work product of the corresponding international application. 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 indicated as allowable in the latest international work product, or the claims in the JPO are narrower in scope than the claims indicated as allowable in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated as allowable in the latest international work product 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 latest international work product is not considered to sufficiently correspond. For example, where the claims indicated as allowable in the latest international work product 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 PCT-PPH program must sufficiently correspond to the claims indicated as allowable in the latest international work product.

(4) Substantive examination of the JPO application for which participation in the PPH is requested has not begun.

2. Documents to be submitted

Documents (1) to (4) below must be submitted by attaching to the request form in filing a request under PPH.

Note that even when it is not needed to submit documents below, the name of the documents must be listed in the request form (Please refer to the Example form for the detail).
(1) A copy of the latest international work product which indicated the claims to be patentable/allowable and translations of them. Either Japanese or English is acceptable as translation language. If the copy of the latest international work product is available in English via "PATENTSCOPE (registered trademark)"\(^3\), an applicant need not submit these documents unless otherwise requested by the JPO (WO/ISA and IPRER are usually available as "IPRP Chapter I" and "IPRP Chapter II" respectively in 30 months after the priority date).

(2) A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and translations of them. Either Japanese or English is acceptable as translation language. If the copy of the set of claims which are indicated to be patentable/allowable is available in English via "PATENTSCOPE (registered trademark)" (e.g. the international Patent Gazette has been published), an applicant need not submit this document unless otherwise requested by the JPO.

(3) A copy of references cited in the latest international work product of the international application corresponding to the application. If the reference is a patent document, the applicant is not required to submit it. In case the JPO has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

(4) A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable. 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 explain the sufficient correspondence of each claim.

When an applicant has already submitted the above mentioned documents (1) - (4) to JPO the through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

\(^2\) 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.

\(^3\) \url{http://www.wipo.int/pctdb/en/index.jsp}
3. Example of “The Explanation of Circumstances Concerning Accelerated Examination” for filing request an accelerated examination under the PCT-PPH program

(1) Circumstances
The applicant must indicate that the application is included in (A) to (E) of 1. (2) in Part II, and that the accelerated examination is requested under the PCT-PPH program. The application number(s) of the corresponding international application(s) also must be written. In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation.

(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
Please refer to the example of the form of “The Explanation of Circumstances Concerning Accelerated Examination” for both on-line and paper procedures 4.


4. Procedure for the accelerated examination under the PCT-PPH program

The JPO decides whether the application can be entitled to the status for an accelerated examination under the PCT-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 PCT-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 PCT-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 PCT-PPH, the applicant can request the PCT-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)*

<table>
<thead>
<tr>
<th>Item</th>
<th>Details</th>
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<tbody>
<tr>
<td>【書類名】</td>
<td>早期審査に関する事情説明書</td>
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<td>【事件の表示】</td>
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<td>【出願番号】</td>
<td>特願2021-000000</td>
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<td>【提出者】</td>
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<td>【代理人】</td>
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<td>【早期審査の種別】</td>
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<td>【早期審査に関する事情説明】</td>
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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。
本出願はブラジル産業財産庁への出願（特許出願番号0000000000）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。当該ブラジル出願に対しては、ブラジル産業財産庁により特許査定が発行されている。

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 INPI application (the application number is 0000000000), and the Decision to Grant a Patent has been issued by the INPI.
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 to be submitted

(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 INPI on (date) 1
(The name of the document) Copy and translation of grant in the INPI 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 INPI 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.
<table>
<thead>
<tr>
<th>Section</th>
<th>Description</th>
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<tr>
<td>A.</td>
<td>Bibliographic Data</td>
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<td><strong>Application Number</strong></td>
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<td><strong>PPH2021-000000</strong></td>
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<td>B.</td>
<td>Request</td>
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<td></td>
<td>Applicants' request participation in the Patent Prosecution Highway (PPH) (pilot) program based on:</td>
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<td><strong>PPH</strong></td>
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<td><strong>Application Number</strong> (Including PCT application number)</td>
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<td><strong>Brazilian Patent Office (INPI)</strong></td>
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<td>C.</td>
<td>Required Documents</td>
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<td>I.</td>
<td>OEE Work Products and, if required, Translations</td>
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<td>1.</td>
<td>A copy of OEE work products is attached; or</td>
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<tr>
<td>2.</td>
<td>A translation of documents in 1 in a language accepted by the Office is attached; or</td>
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<td>II.</td>
<td>OEE and, if required, Translations</td>
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<td>3.</td>
<td>A copy of all claims determined to be patentable/allowable by OEE is attached; or</td>
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<td>4.</td>
<td>A translation of documents in 3 in a language accepted by the Office is attached; or</td>
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<tr>
<td>III.</td>
<td>Documents Cited in OEE Work Products (If Required)</td>
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<td>5.</td>
<td>A copy of all documents cited in OEE work products is attached (excluding patent documents); or</td>
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IV. 先の提出書類の援用の表示 (Previously submitted documents)

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| □ | 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前の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)

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| □ | (先行庁のオフィスアクションの写し、及び、その翻訳文)
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| □ | (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)
|   |   |

D. 請求項の対応関係 (Claims Correspondence)

- 先行庁の特許可能な全請求項と完全に一致する  
(All the claims in the application sufficiently correspond to the patentable/allowable claims in the OEE application; or)

□ 請求項の対応関係は、以下の表に記載 (Claims correspondence is explained in the following table)

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| □ | 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 (コメント欄の出願内容に対応する場合は、コメント欄に記載して下さい。)  
(Explanation regarding the correspondence)
|   |   |

E. 見解書、予備審査報告の核問題 (核問題に対する観明)  
(explaining any Box VIII observations of WO/ISA, WO/IEPA or IPER)

出願人又は代理人 (Name(s) of applicant(s) or representative(s))

提出日 (Date)

提出者 (Signature(e) of the applicant/representative)
【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 INPI on (date)
【内容】Attach the copy of the document.
【物件名】**年**月**日付の特許査定の写し及びその翻訳文
Copy and translation of grant in the INPI 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
Copy and translation of the claims indicated patentable in the report on the state of the art and written opinion in the INPI on (date)
【内容】Attach the copy of the document.
【物件名】引用非特許文献1
Cited non–patent literature 1
【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 case meeting requirement (a) (I)
- Paris route -

B case meeting requirement (a) (I)
- Paris route (PCT application) -
C  A case meeting requirement (a) (I)
- Paris route, Domestic priority -

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

F A case meeting requirement (a) (III) - Paris route, but the first application is from the third country -

XX : the office other than the INPI or the JPO
G A case meeting requirement (a) (III)
- Paris route (PCT application), but the first application is from the third country -

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

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

J

A case meeting requirement (a) (I)
- Paris route (PCT application) -
A case meeting requirement (a) (IV) - Direct PCT route -

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

M

N

A case meeting requirement (a) (III) - Direct PCT route -
A case not meeting requirement (d)
- Examination has begun before a request for PPH -
(A) The application is a national phase application of the corresponding international application.

(A') The application is a national phase application of the corresponding international application. (The corresponding international application claims priority from a national application.)
(A’”) The application is a national phase application of the corresponding international application.
(The corresponding international application claims priority from an international application.)

(B) The application is a national application as a basis of the priority claim of the corresponding international application.
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.

(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.
(E1) The application is a divisional application of an application which satisfies the requirement (A).

(E2) The application is an application claiming domestic priority from an application which satisfies the requirement (B).
(E3) The application is an application claiming priority from an application which satisfies the requirement (B).

ZZ : any office