Procedures to file a request to the JPO (Japan Patent Office) for Patent Prosecution Highway Pilot Program between the JPO and the OSIM (State Office for Inventions and Trademarks of Romania)

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-OSIM Patent Prosecution Highway pilot program based on the OSIM 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 OSIM will commence on July 1, 2023, for a trial period of 4 years. The JPO and OSIM 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 OSIM 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 OSIM application(s) (examples are provided in ANNEX, Figures A, B, C, H, I and J), or

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

(Case III) an application which shares a common priority document with the OSIM application(s) (including PCT national phase application(s)) (examples are provided in ANNEX, Figures F, G, L, M and N), or

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[1] https://www.jpo.go.jp/system/laws/rule/guideline/patent/document/index/guideline.pdf

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

The pilot program is not applicable on the basis of OSIM 'utility model' applications.

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

The corresponding application can be the application which forms the basis of the priority claim, an application which derived from the OSIM application which forms the basis of the priority claim (e.g. a divisional application of the OSIM application), or an OSIM national phase application of a PCT application.

Claims are "determined to be allowable/patentable" when the OSIM 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 Notification – indicating obstacles to granting a patent or a Notification of partially refusing a patent - indicating claim(s) and reasons

(iii) Intention of the granting a patent (according to Romanian procedure, before taking the decision of granting, the applicant is informed about the intention of granting)

(iv) Decision of the granting of a patent- means that the procedure is finished and the patent is granted. Is this acceptable to you? In this case we do not speak about an application anymore

(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 OSIM.

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 OSIM, or the claims in the JPO are narrower in scope than the claims in the OSIM.

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

(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 OSIM), which were sent for the corresponding application by the OSIM, and translations of them[2].

Either Japanese or English is acceptable as translation language.

(b) Copies of all claims determined to be patentable/allowable by the OSIM, and translations of them[2].

Either Japanese or English is acceptable as translation language.

(c) Copies of references cited by the OSIM 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

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[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.

indicates how all claims in the JPO application sufficiently correspond to the patentable/allowable claims in the OSIM 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 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 OSIM 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 OSIM 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.

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[3] https://www.jpo.go.jp/system/laws/rule/guideline/patent/document/index/guideline.pdf

(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.).

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

【書類名】　　　　早期審査に関する事情説明書
　　The name of this paper

【提出日】　　　　令和○○年○○月○○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 ○○○○－○○○○○○
　　Application number

【提出者】
　　【識別番号】　　○○○○○○○○○
　　【住所又は居所】　○○県○○市○丁目
　　【氏名又は名称】　○○○○○
　　The name and address of who submit this

【代理人】
　　【識別番号】　　○○○○○○○○○
　　【住所又は居所】　○○県○○市○丁目
　　【氏名又は名称】　○○　○○
　　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
　　特許審査ハイウェイに基づく早期審査の申請を行う。
　　本出願はルーマニア発明商標庁への出願（特許出願番号○○○○○○○○）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。当該ルーマニア出願に対しては、ルーマニア発明商標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 OSIM application (the application number is 000000000), and the Decision to Grant a Patent has been issued by the OSIM.

　　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】."

【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

(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 OSIM on (date)　1
(The name of the document) Copy and translation of grant in the OSIM 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 OSIM on (date)　1
(The name of the document) Cited non patent literature　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】

PPH申請書
(REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) (PILOT) PROGRAM)

A. 書誌事項　　　(Bibliographic　Data)	
出願番号　（Application Number)	特願0000-000000

B. 必要事項　　　　(Request)

出願人による以下に基づく特許審査ハイウェイの申請：
(Applicant　requests　participation　in the Patent　Prosecution　Highway (PPH) (pilot) program based on:)

先行庁 (国際調査機関又は国際予備審査機関を含む) (Office of Earlier Examination (OEE))	ルーマニア発明商標庁(OSIM)
先行庁の審査書類形式 (OEE Work Products Type)	■ 国内出願の審査結果を利用（PPH又はPPH　MOTTAINAI） (National/Regional Office Action(s)) □ PCT国際段階成果物を利用（PCT－PPH） (WO-ISA, WO-IPEA or IPER)
先行庁の対応出願番号(国際出願番号含む) (OEE Application　Number) (Incl. PCT Application　Number)	00000000

C. 必要書類 (Required Documents)

I. 先行庁のオフィスアクションの写し、及び、その翻訳文
(OEE Work Products and, if required, Translations)

1. ■ 先行庁のオフィスアクションの写しを添付する
(A copy of OEE work products is attached; or)
□ ドシエ・アクセス・システム又はPATENTSCOPEにおいて、オフィスアクションの情報が提供されている
(The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE)

2. ■ 上記1. の日本語又は英語の翻訳文を添付する
(A translation of documents in 1 in a language accepted by the Office is attached; or)
□ ドシエ・アクセス・システム又はPATENTSCOPEにおいて、上記1. の英語翻訳が提供されている
(The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE)

II. 先行庁における特許可能な請求項、及び、その翻訳文
(Patentable/Allowable Claims Determined by OEE and, if required, Translations)

3. ■ 先行庁出願において特許可能と判断された全請求項の写しを添付する
(A copy of all claims determined to be patentable/allowable by OEE is attached; or)
□ ドシエ・アクセス・システム又はPATENTSCOPEにおいて、特許可能と判断された全請求項の情報が提供されている
(The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE)

4. ■ 上記3. の日本語又は英語の翻訳文を添付する
(A translation of documents in 3 in a language accepted by the Office is attached; or)
□ ドシエ・アクセス・システム又はPATENTSCOPEにおいて、上記3. の英語翻訳が提供されている
(The office is requested to retrieve documents via the Dossier Access System or PATENTSCOPE)

III. 引用文献　　(Documents　Cited in OEE Work　Products　(if required))

5. ■ 引用非特許文献を添付する
(A copy of all documents cited in OEE work products is attached (excluding patent documents); or)
□ 引用非特許文献も引用特許文献もなし
(No references cited)

	IV. 先の提出書類の援用の表示 (Previously submitted documents)		
6.	□ 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)

■ 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)

☐ 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及びその翻訳文

Copy and translation of Notification of Reasons for Refusal in the OSIM 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**日付の特許査定およびその翻訳文

Copy and translation of grant in the OSIM 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 OSIM on (date)

【内容】 Attach the copy of the document.
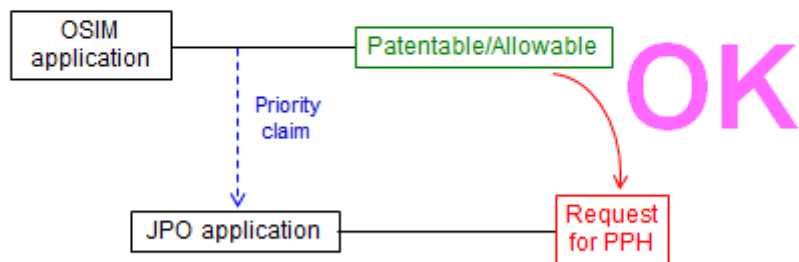
【物件名】 引用非特許文献1
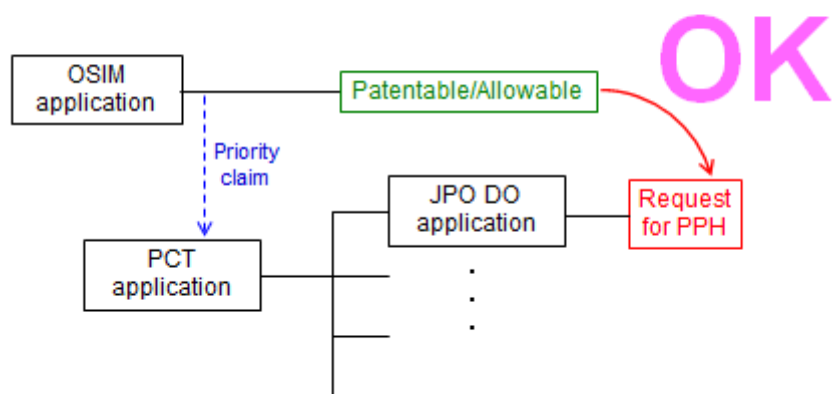
Cited non－patent literature1

【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.

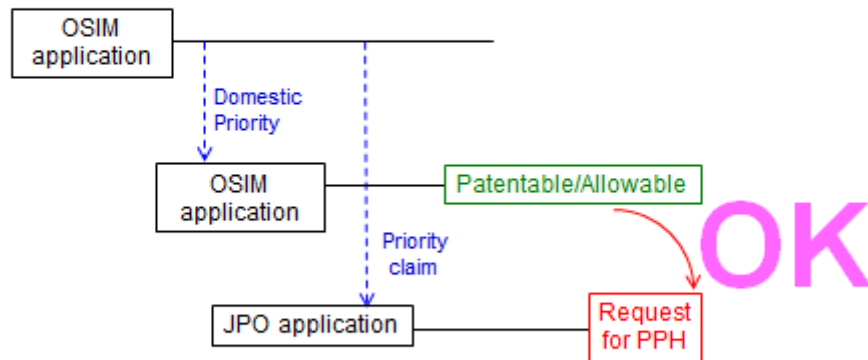**(A)** A case meeting requirement (a) (I)
- Paris route -

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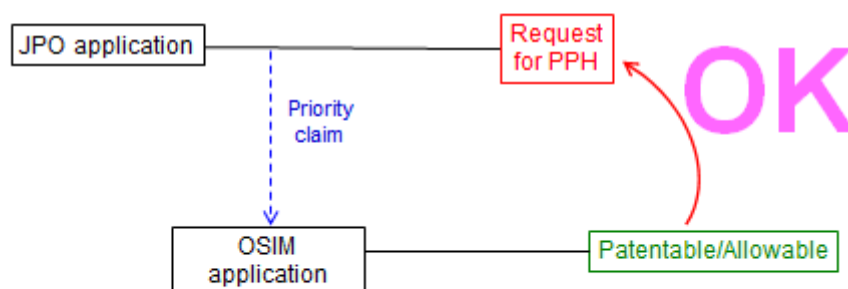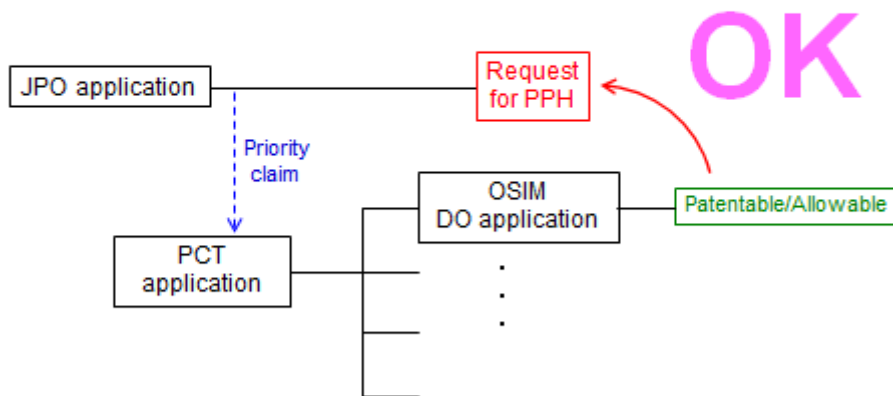- PCT route -

(C) A case meeting requirement (a) (I)

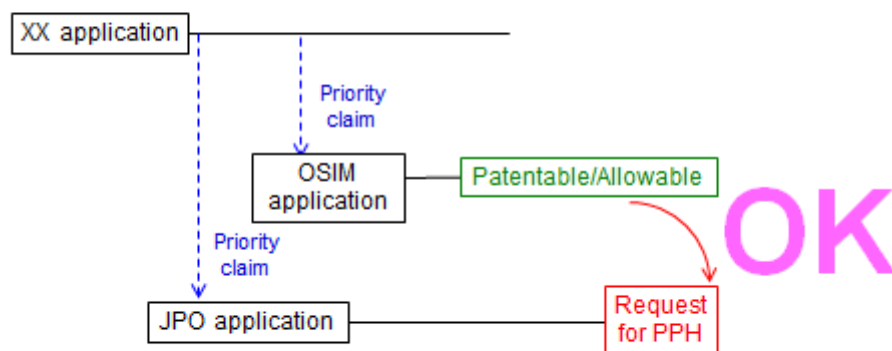## - PCT route, Domestic priority -

```
OSIM
application
   ┊ Domestic
   ┊ Priority
   ↓
         OSIM              ──── Patentable/Allowable
         application
              ┊ Priority
              ┊ claim
              ↓
         JPO application   ──── Request
                                for PPH      OK
```

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

```
JPO application ──────── Request
                         for PPH      OK
   ┊ Priority
   ┊ claim
   ↓
         OSIM          ──── Patentable/Allowable
         application
```

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

OK

JPO application → Request for PPH

Priority claim

PCT application

OSIM DO application → Patentable/Allowable

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

XX application

Priority claim

OSIM application → Patentable/Allowable

OK

Priority claim
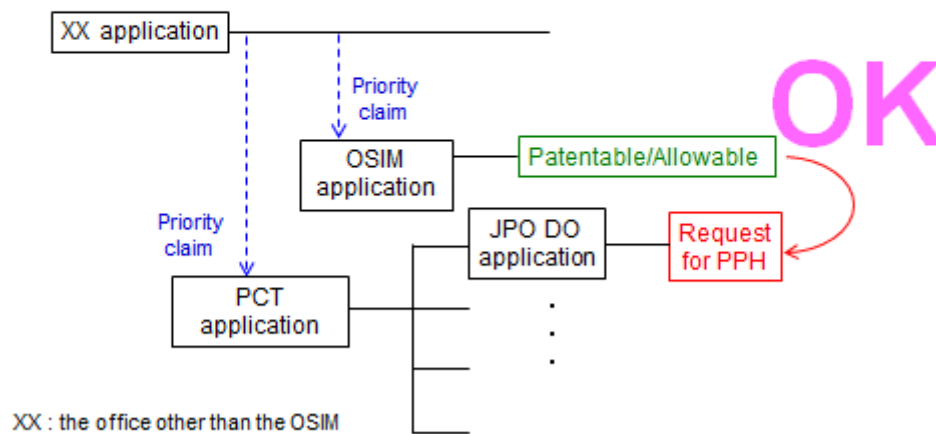
JPO application → Request for PPH

XX : the office other than the OSIM

(G) A case meeting requirement (a) (III)

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

XX application

Priority claim

OSIM application — Patentable/Allowable

OK

JPO DO application — Request for PPH

Priority claim
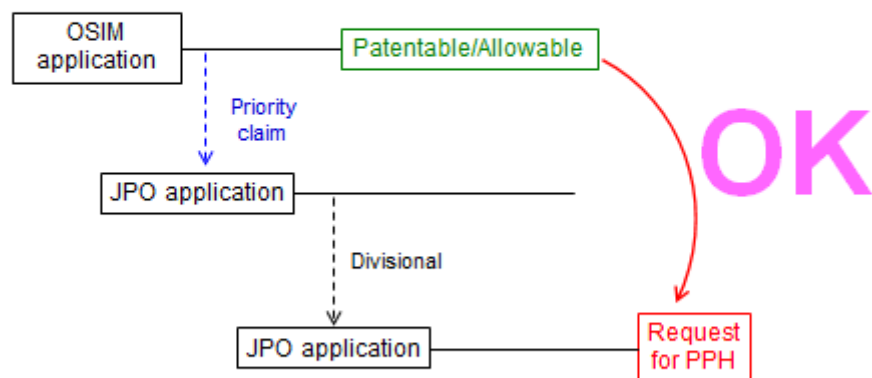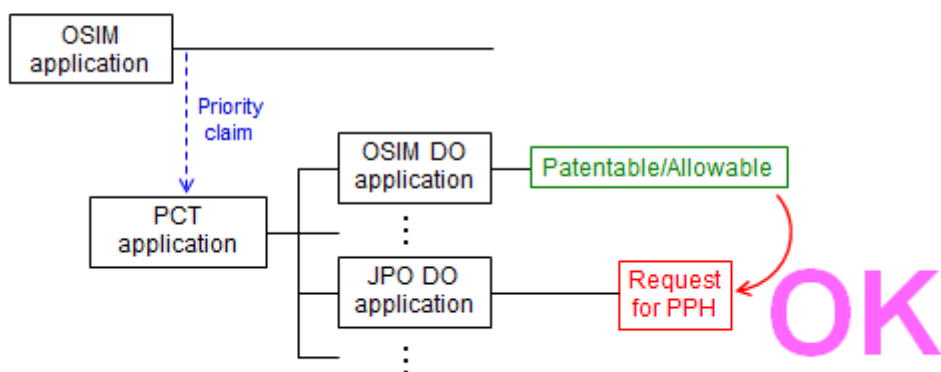
PCT application

XX : the office other than the OSIM

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

OSIM application — Patentable/Allowable

OK

ZZ application

Priority claim

Priority claim

JPO application — Request for PPH

ZZ : any office

15
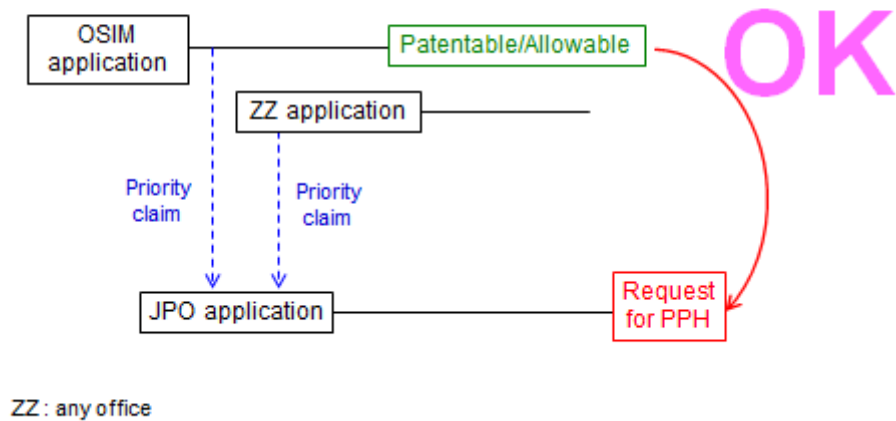
I **A case meeting requirement (a) (I)**
   - Paris route & divisional application -

OSIM application — Patentable/Allowable

Priority claim

JPO application

Divisional

JPO application — Request for PPH

OK

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

OSIM application

Priority claim

PCT application

OSIM DO application — Patentable/Allowable

JPO DO application — Request for PPH

OK

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

OSIM DO application → Patentable/Allowable

PCT application
Without priority claim

JPO DO application → Request for PPH

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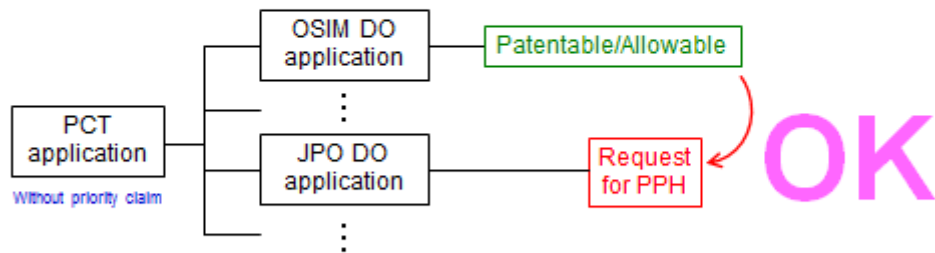
(L) A case meeting requirement (a) (III)
- Direct PCT & Paris route -

OSIM DO application → Patentable/Allowable

PCT application
Without priority claim

Priority claim
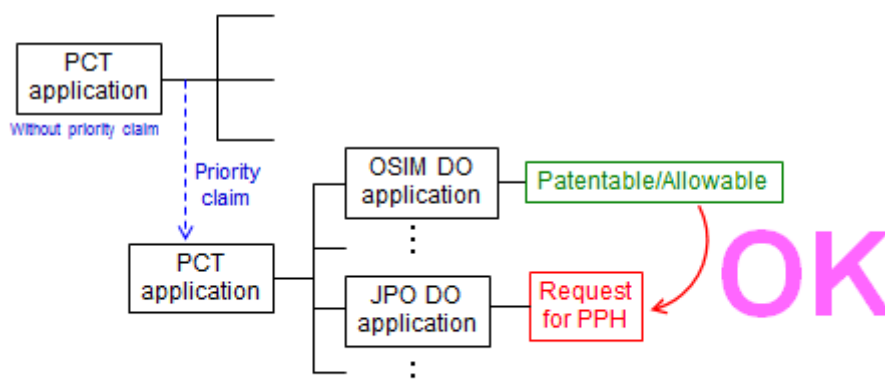
JPO application → Request for PPH

OK

17
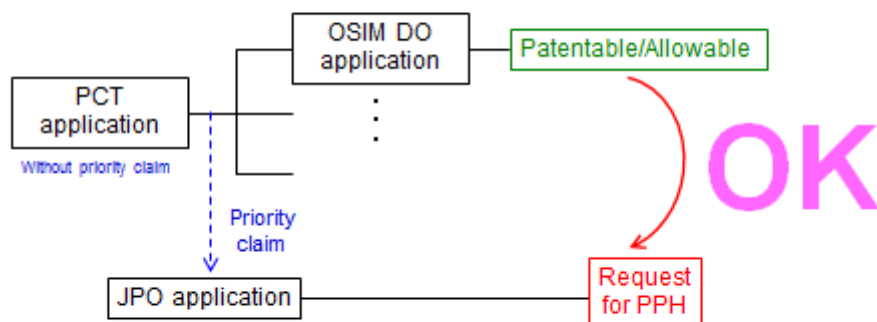
(M) A case meeting requirement (a) (III)
- Direct PCT & PCT route -
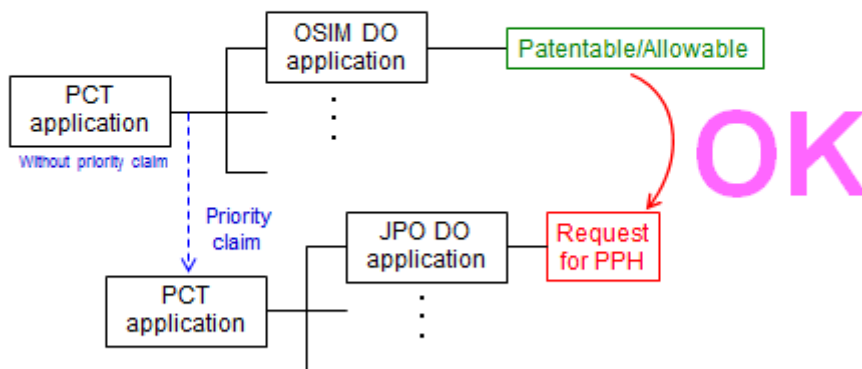
(N) A case meeting requirement (a) (III)
- Direct PCT & PCT route -

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