

Procedures to file a request to the JPO (Japan Patent Office) for Patent Prosecution Highway Pilot Program between the JPO and the MOIC (Ministry of Industry and Commerce) of the Kingdom of Bahrain

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-MOIC Patent Prosecution Highway (PPH) pilot program based on the MOIC 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”.

This PPH pilot program will commence on January 1, 2026, and the pilot period of the program will be automatically extended every 3 years unless either the JPO or the MOIC notifies its intention to terminate the program.

1. Requirements

(a) *Both the JPO application on which PPH is requested and the MOIC 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).*²

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 MOIC application(s) (examples are provided in ANNEX, Figures A, B, C, H, I and J),

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

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

¹ <https://www.jpo.go.jp/e/system/patent/shinsa/jp-soki/document/index/guideline.pdf>

² The JPO application which corresponds to Korean utility model applications that have been subject to substantive examination under the New Act after 1st October 2006 also eligible for processing under the PPH.

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

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

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

Even if the corresponding MOIC application(s) has not been granted a patent, this requirement is satisfied if some claims are indicated as patentable in the “EXAMINATION REPORTS”.

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

Claims are considered to “sufficiently correspond” if, accounting for differences due to translations and claim format (independent / dependent claim), the claims in the JPO are of the same or similar scope as the claims in the MOIC, or the claims in the JPO are narrower in scope than the claims in the MOIC. In this regard, a claim at the JPO that is narrower in scope arises when the claim is amended to be further limited compared to the scope of the claim in the MOIC by an additional technical 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 MOIC is not considered to sufficiently correspond. For example, if the claims in the MOIC only contain claims to a process of manufacturing a product, the claims in the JPO are not considered to sufficiently correspond if the claims in the JPO 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 patentable/allowable in the MOIC 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 (e) 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 MOIC), which were sent for the corresponding application by the MOIC, and translations of them.

Either Japanese or English is acceptable as translation language. Machine translation will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action due to insufficient translation, the examiner can request the applicant to resubmit translations.

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

Either Japanese or English is acceptable as the translation language. Machine translations will be admissible; however, if it is impossible for the examiner to understand the outline of the translated claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

(c) Copies of references cited by the MOIC 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 MOIC 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).

(e) *A copy of the document that clearly states the filing date (and the priority date) of the corresponding MOIC application*

If the documents mentioned above (a) and (b) include a page that clearly states the filing date (and priority date) of the corresponding MOIC application(s), submission may be omitted.

If submission cannot be omitted, please submit, for example, a copy of the front page of the patent grant publication(s) for the corresponding application(s) from the MOIC. When submitting a copy of the cover page of the patent grant publication(s), a translation of that document is not required. When other documents are submitted, submission of a translation is not mandatory; however, if the examiner is unable to understand the content, a translation may be requested.

When the applicant has already submitted above documents (a) to (e) 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 for 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 (and, if exist, publication number and a patent number) of the corresponding MOIC application(s) also must be written.

*In the case the application which has one or more claims that are determined to be patentable/allowable is different from the MOIC application(s) included in (I) to (IV) of 1. (a) (for example, the divisional application of the basic application), the application number, publication

³ <https://www.jpo.go.jp/e/system/patent/shinsa/jp-soki/document/index/guideline.pdf>

PPH using national work products from the MOIC of the Kingdom of Bahrain

number, or a patent number of the application(s) which has claims determined to be patentable/allowable must be stated along with the relationship between those applications.

(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.

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.

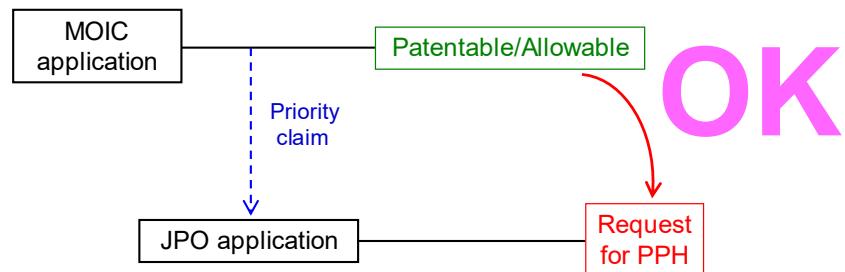
4. Procedure for the accelerated examination under the PPH pilot program

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.

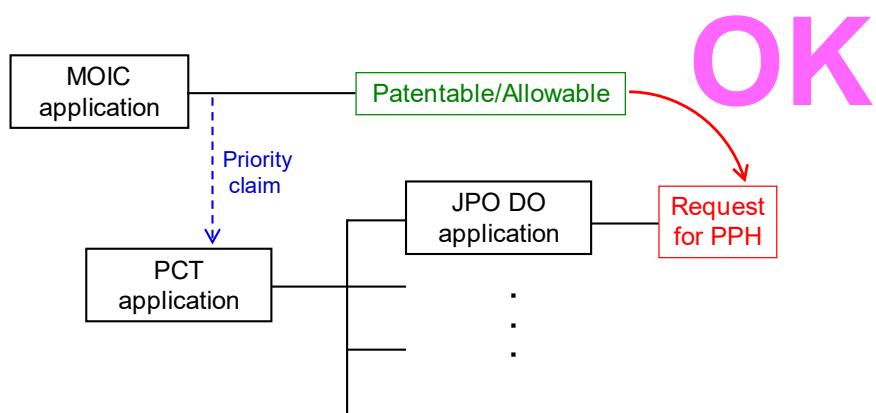
A

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



B

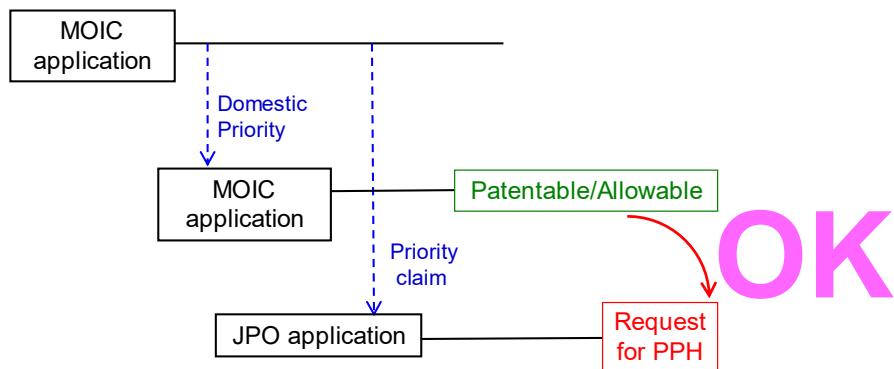
A case meeting requirement (a) (I)
- PCT route -



C

A case meeting requirement (a) (I)

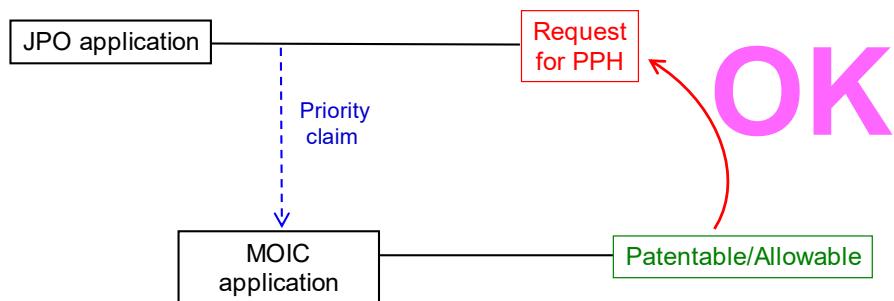
- PCT route, Domestic priority-



D

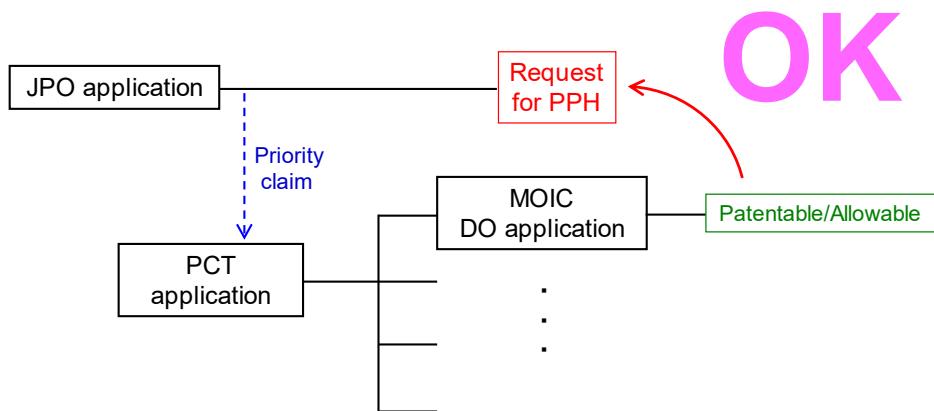
A case meeting requirement (a) (II)

- Paris route -



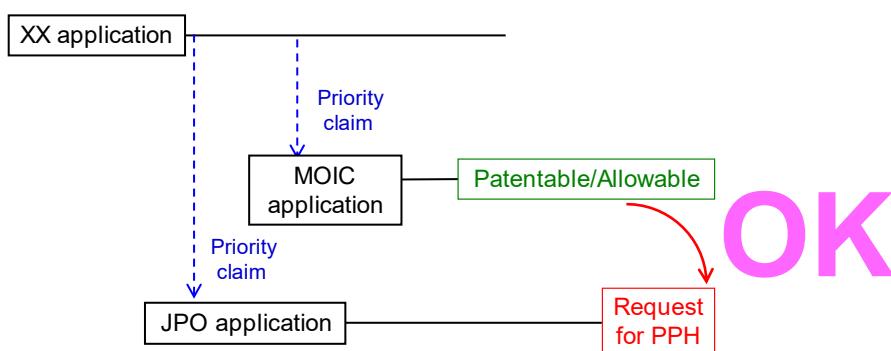
E

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



F

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

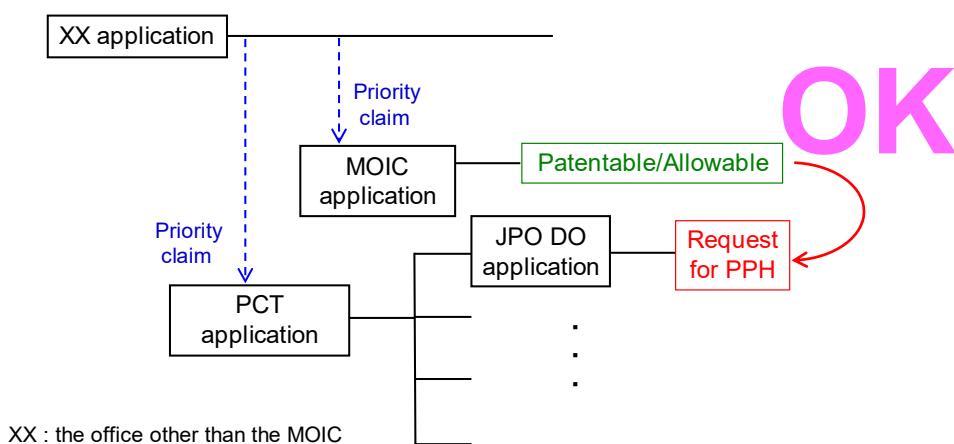


XX : the office other than the MOIC

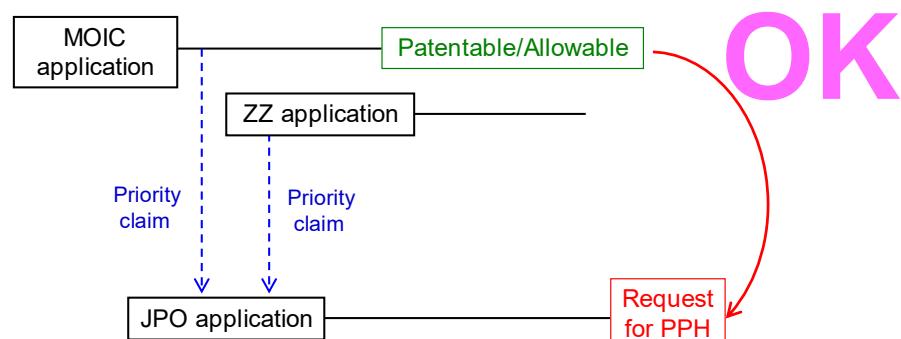
G

A case meeting requirement (a) (III)

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



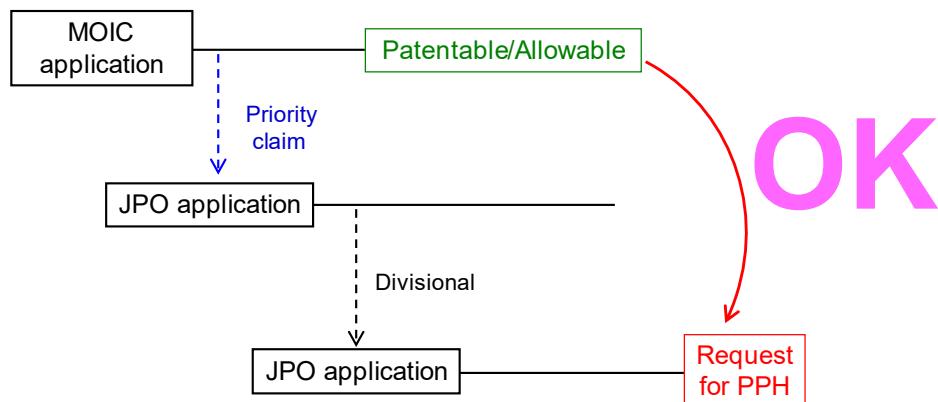
H

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

ZZ : any office

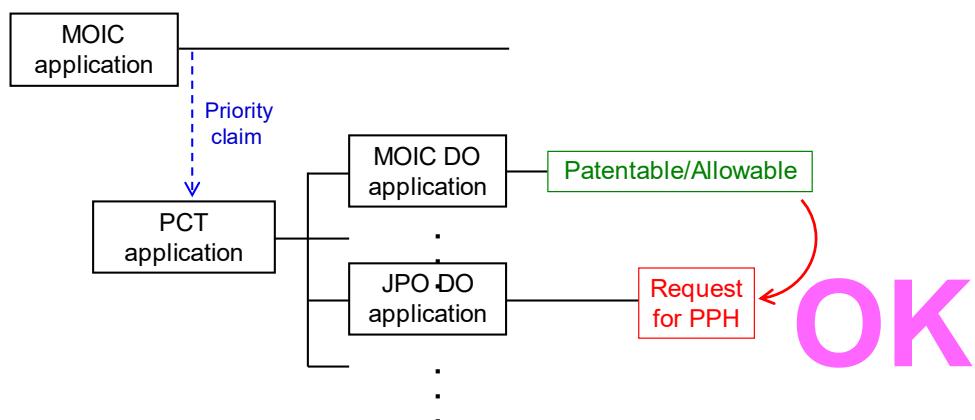
I

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



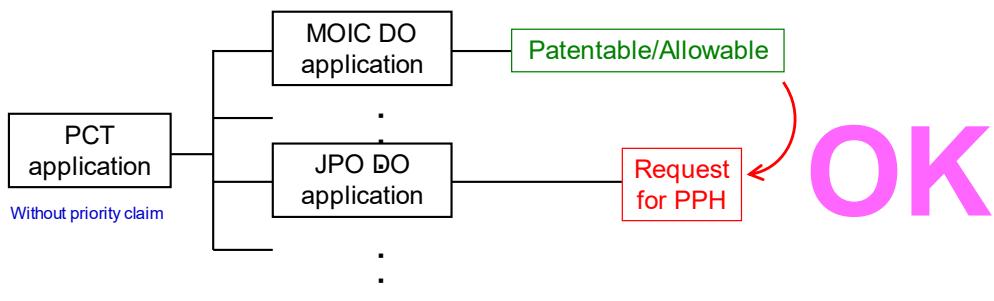
J

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



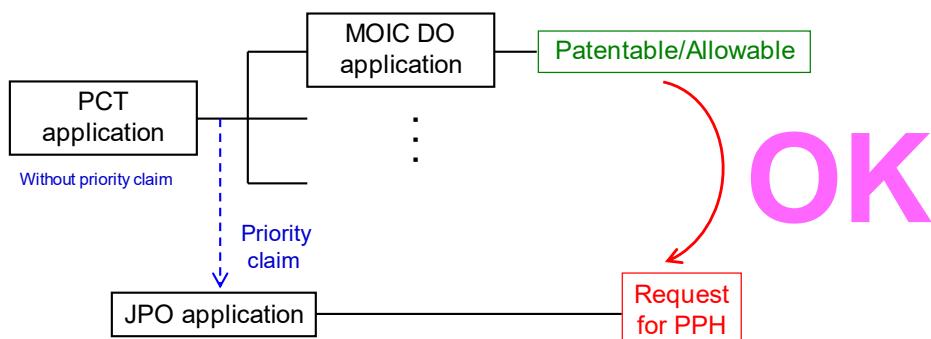
K

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



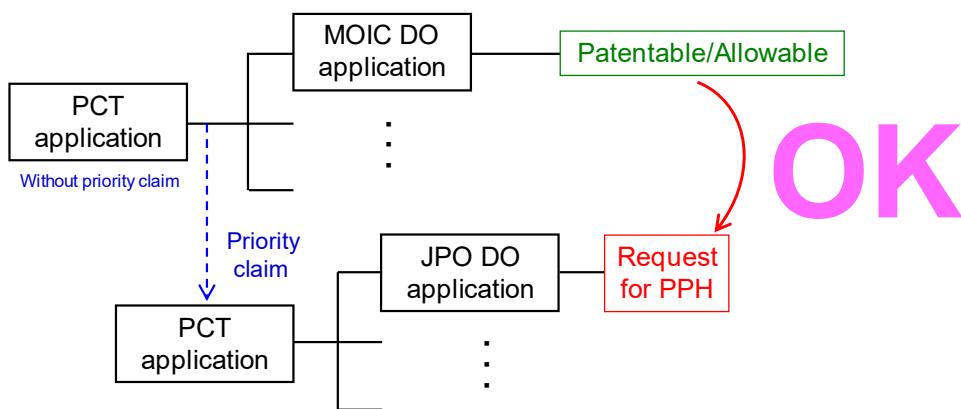
L

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



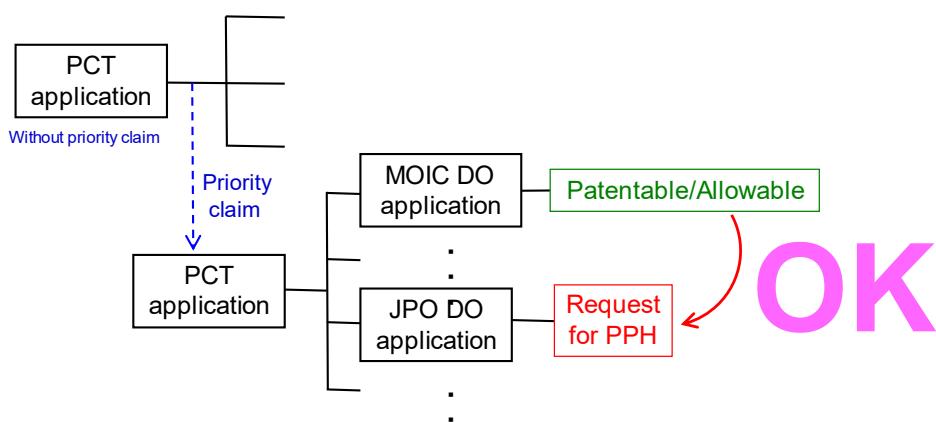
M

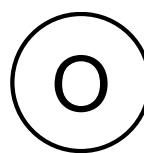
A case meeting requirement (a) (III)
 - Direct PCT & PCT route -



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 -

