Procedures to file a request to the JPO (Japan Patent Office) for Patent Prosecution Highway Pilot Program between the JPO and the EGYPO (Egyptian Patent Office)

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-EGYPO Patent Prosecution Highway pilot program based on the EGYPO application (Part I) or PCT international work products (Part II).

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." 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 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.

The PPH pilot program will be in effect for three years commencing on June 1, 2023 and will end on May 31, 2026. However, the program may be extended after a joint EGYPO-JPO review and assessment of the program implementation.

1

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

Part I PPH using the national work products from the EGYPO

1. Requirements

- (a) Both the JPO application on which PPH is requested and the EGYPO 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:
 - (i) an application which validly claims priority under the Paris Convention from the EGYPO application(s) (examples are provided in ANNEX I, Figures A, B, C, H, I and J), or
 - (ii) an application which provides the basis of a valid priority claim under the Paris Convention for the EGYPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures D and E), or
 - (iii) an application which shares a common priority document with the EGYPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures F, G, L, M and N), or
 - (iv) a PCT national phase application where both the JPO application and the EGYPO application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX I, Figure K).

The JPO application, which validly claims priority to multiple EGYPO or direct PCT applications, or which is the divisional application validly based on the originally filed application that is included in (i) to (iv) above, is also eligible.

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

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

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

Claims are "determined to be allowable/patentable" when the EGYPO 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 includes one of the following:

- (i) Decision of grant a patent
- (ii) Notification of reasons for amendment

- (iii) Decision of conversion to the ministries concerned
- (iv) Decision of Appeal

(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 EGYPO.

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

In this regard, a claim that is narrower in scope occurs when an EGYPO 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 EGYPO is not considered to sufficiently correspond. For example, where the EGYPO 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 EGYPO 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 I, 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 EGYPO), which were sent for the corresponding application by

the EGYPO, and translations of them².

Either Japanese or English is acceptable as translation language.

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

Either Japanese or English is acceptable as translation language.

(c) Copies of references cited by the EGYPO 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 EGYPO 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

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.

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 EGYPO 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 EGYPO application(s) included in (i) to (iv) of 1. (a) (for example, the divisional application of the basic application), the application number, publication number, or a patent number of the application(s) which has claims determined to be patentable/allowable and the relationship between those applications also must be written.

(2) Documents to be submitted

The applicant must list all required documents mentioned above 2. in an identifiable way, even when applicant omits to submit certain documents.

(3) Notice

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

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

Part II

PPH using the PCT international work products from the EGYPO (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 EGYPO, 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 pilot 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 pilot program need not to 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 PPH 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 PPH 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 them⁴.

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)"⁵, an applicant need not submit these documents unless otherwise requested by the JPO (WO/ISA and IPER 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.

⁴ 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.

⁵ http://www.wipo.int/pctdb/en/index.jsp

3. Example of PPH request form 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" 6.

The applicant must indicate that the application is included in (A) to (E) of 1. (2), and that the accelerated examination is requested under the PPH pilot program. The application number, publication number, or a patent number of the corresponding EGYPO application(s) 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

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

⁶ https://www.jpo.go.jp/system/laws/rule/guideline/patent/document/index/guideline.pdf

Example form of the Explanation of Circumstances Concerning Accelerated Examination

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

The name of 【提出日】	ms paper 令和00年00月00日	-¦ -,	Bibliographical items
Date of filing			5 1
【あて先】	特許庁長官殿		
Destination		_;	
【事件の表示】 【出願番号】 	特願 0000-00000	-,	
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The name an	d address of who submit this		
【代理人】 【識別番号】 【住所又は居 【氏名又は名	000000000 所】 〇〇県〇〇市〇丁目 称】 〇〇 〇〇	-,	
The name an	d address of the attorney	.:! /	
【早期審査に関す	る事情説明】		,
The explanat	ion of circumstances concern	ing accele	erated examination
本出願はエジフ		号00000	0000)をパリ条約に基づく優先権の ロジプト特許庁により特許査定が発行

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 EGYPO application (the application number is 0000000000), and the Decision of Grant a Patent has been issued by the EGYPO.

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 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 EGYPO on (date) 1

(The name of the document) Copy and translation of grant in the EGYPO 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 EGYPO 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】."

【添付物件】

The list of attached documents

【物件名】 PPH 申請書

PPH request form

【内容】

(REQUEST FOR PARTICIPATIO	Attach the document here as image file text.				
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 (Applicant requests participation in t	「ウェイの申請: he 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))	エジプト特許庁(EGPYO)				
先行庁の審査書類形式	■ 国内出願の審査結果を利用(PPH又はPPH MOTTAINAI) (National/Regional Office Action(s))				
(OEE Work Products Type)	□ PCT国際段階成果物を利用(PCTー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)	000000000				
(OEE Work Products and, if require 1. ■ 先行庁のオフィスアクションの写しる (A copy of OEE work products is att ロドシェ昭会▼ (土PATENTSCOPE)					
(The office is requested to retrieve of the Line of	documents via the Dossier Access System or PATENTSCOPE) 文を添付する I language accepted by the Office is attached; or) において、上記1. の英語翻訳が提供されている documents via the Dossier Access System or PATENTSCOPE)				
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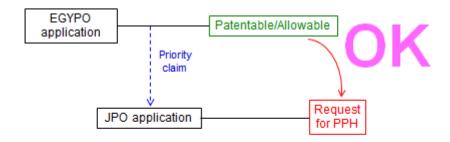
IV. 先の提出書類の援用の表示 (Previously submitted documents)
6. □ 上記において「添付する」とチェックした書類のうち、先に提出した書類を援用する (If any of the above mentioned documents have been submitted before, please specify:)
(先行庁のオフィスアクションの写し、及び、その翻訳文)
(先行庁における特許可能な請求項、及び、その翻訳文)
(引用非特許文献)
V. 提出物件(援用する物件は除く)(List of names of documents submitted) 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)
ドイツ出願公開第0000000号公報
日本国特許第00000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)
E. 見解書、予備審査報告の第唖欄(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)
texplaining any box viii observations of WO/15A, WO/1FEA of IFER)
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。

【内容】	Attach the copy of the do	cument.	Use the same name as "【物件名】" und "【提出物件の目録】"
	】**年**月**日付の特許査 and translation of grant in		,
【内容】	Attach the copy of the do	ocument.	
	特許可能と判断された請求		
	ind translation of the claim itten opinion in the EGYPC		ntable in the report on the state of the art
【内容】			
【内容】	Attach the copy of the doo	cument.	
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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.

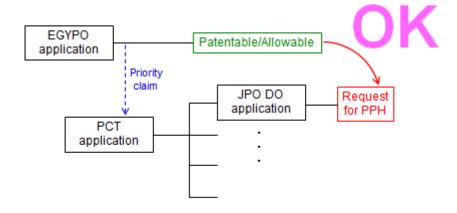


A case meeting requirement (a) (i) - Paris route -



(B)

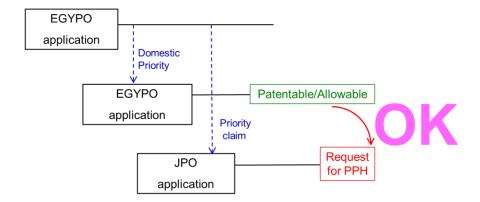
A case meeting requirement (a) (i) - PCT route -





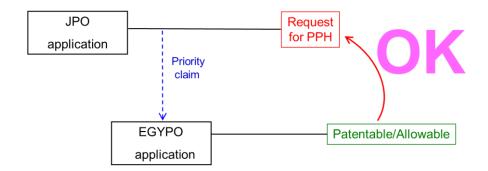
A case meeting requirement (a) (i)

- PCT route, Domestic priority -



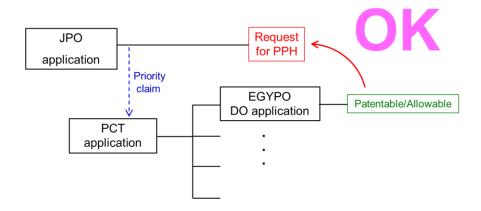


A case meeting requirement (a) (ii) - Paris route -

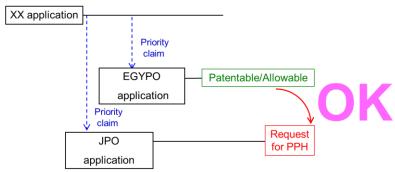




A case meeting requirement (a) (ii) - PCT route -



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

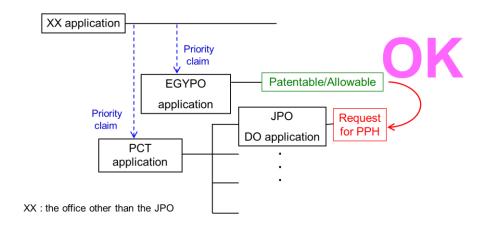


XX : the office other than the JPO



A case meeting requirement (a) (iii)

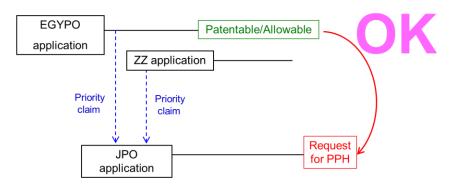
- PCT route, but the first application is from the third country -



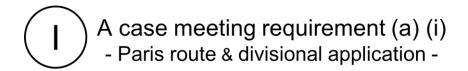


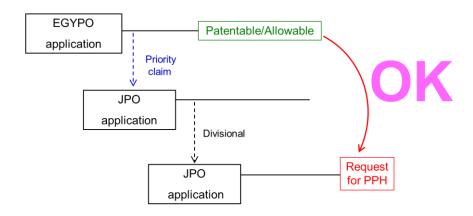
A case meeting requirement (a) (i)

- Paris route & Complex priority -

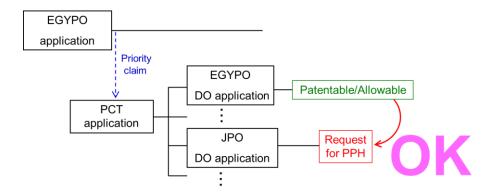


ZZ : any office





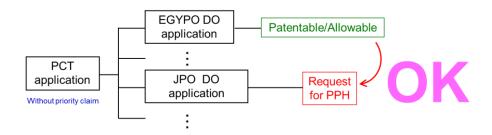
J A case meeting requirement (a) (i) - PCT route -



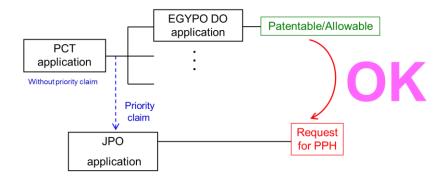




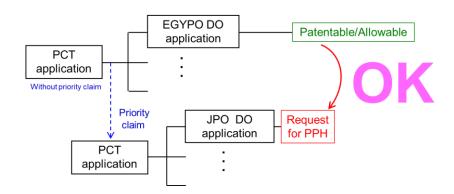
A case meeting requirement (a) (iv) - Direct PCT route -



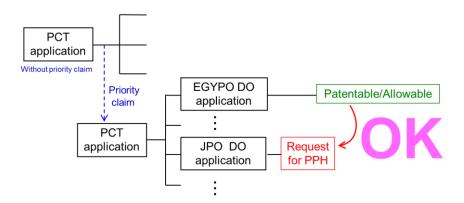
A case meeting requirement (a) (iii) - Direct PCT & Paris route -



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

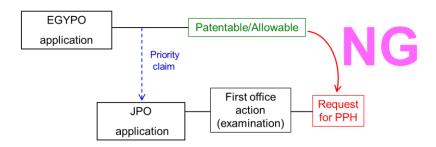


N A case meeting requirement (a) (iii) - Direct PCT & PCT route -

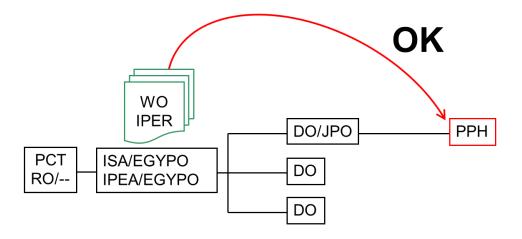




A case not meeting requirement (d) - Examination has begun before a request for PPH -

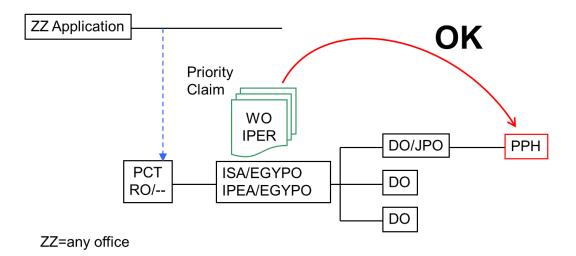


(A) The application is a national phase application of the corresponding international application.



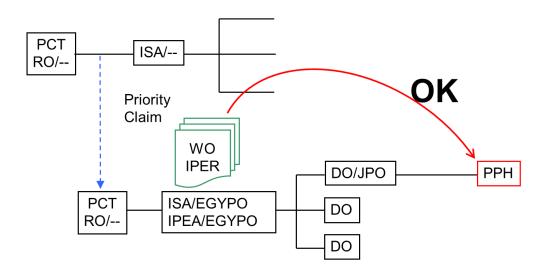
(A') The application is a national phase application of the corresponding international application.

(The corresponding international application claims priority from a national application.)

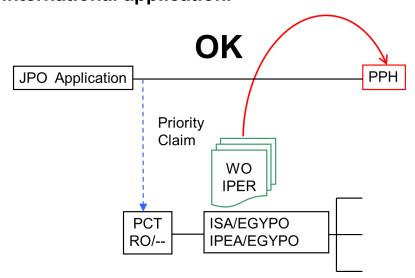


(A") The application is a national phase application of the corresponding international application.

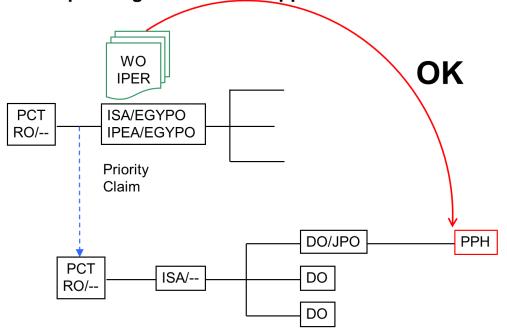
(The corresponding international application claims priority from an international application.)



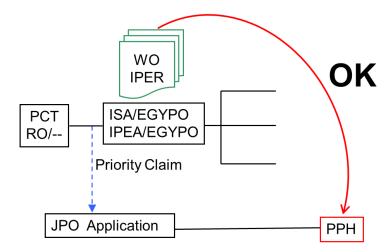
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



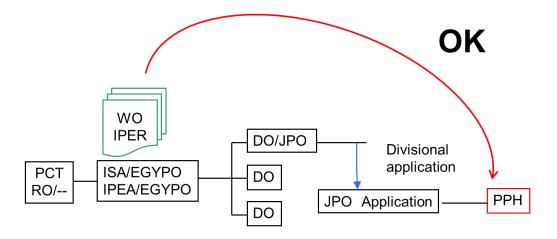
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



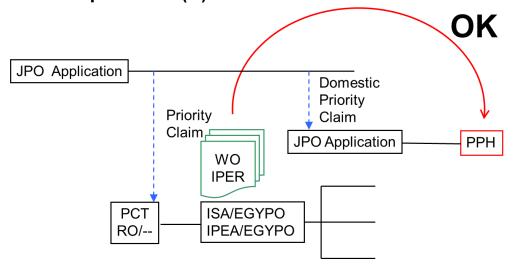
(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.



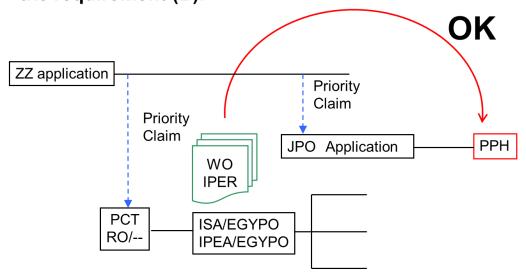
(E1) The application is a divisional application of an application which satisfies the requirement (A).



(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