

Procedures to file a request to the JPO for Patent Prosecution Highway Pilot Program between the JPO and the Rospatent

(27/02/2009)

1. Request to the JPO

When an applicant files a request for an accelerated examination under the Patent Prosecution Highway Pilot Program to the Japan Patent Office (JPO), an applicant must submit the request form "The Explanation of Circumstances Concerning Accelerated Examination" based on the procedure prescribed in "the Guidelines of the Accelerated Examination and Appeal". (Please see http://www.jpo.go.jp/torikumi/t_torikumi/souki/exe/v3souki/guideline.exe (Japanese only). "The Explanation of Circumstances Concerning Accelerated Examination" is described on page 27-29.)

Under the Patent Prosecution Highway Pilot Program, an applicant is not required to fill in section 2 (the disclosure of prior arts and comparison between the claimed invention and the prior art) in "The Explanation of Circumstances Concerning Accelerated Examination", if the application, filed at the JPO, satisfies the following conditions (1) and the applicant attaches the following documents (2) to "The Explanation of Circumstances Concerning Accelerated Examination".

(1) Requirements for requesting an accelerated examination under the PPH pilot program at the JPO

(a) *The JPO patent application (including PCT national phase application) is:*

- (i) an application which validly claims priority under the Paris Convention to the application(s) filed at the Rospatent as the OFF. Examples are provided in the annex to this guideline (hereafter "the Annex") (figure A to F, J to L), or
- (ii) an PCT national phase application without priority claim. Examples are provided in the Annex (figure G and M), or
- (iii) an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim. Examples are provided in Annex (figure H and N).

A JPO application, which validly claims priority to multiple Rospatent or PCT applications, or which is a divisional application validly based on the originally filed application that is included in (i) to (iii) above, is also eligible (figure E and F).

(b) *At least one corresponding patent application exists in the Rospatent which has one or more claims that have been determined to be patentable by the Rospatent.*

The claims are determined to be patentable by the Rospatent when the Decision on the Grant of a Patent (Решение о выдаче патента) is notified. Even if the positive opinion has

been shown in the ISR by the Rospatent as the ISA, the claims shall not be determined to be patentable (figure I).

“Corresponding patent application” should not be necessarily interpreted as the application which forms the basis of the priority, but might be the application which derived from the application which forms the basis of the priority or the PCT application which has no priority claim; e.g., a divisional application of the application, an application which claims internal priority to the application or a PCT national phase application which claims priority to the application (figure J to N).

It is noted that the application is NOT eligible for this program in case where the examination was conducted in the Eurasian Patent Office and the patent right was validated in Russia as a designated state.

- (c) All claims in the JPO patent 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 by the Rospatent.**

Claims are considered to sufficiently correspond where both claims have a common technical feature which made the claims in the Rospatent application patentable over the prior art. In this regard, a claim which has an additional component on the claim determined to be patentable by the Rospatent, or which is the same - except for the claim format - as the claim determined to be patentable by the Rospatent, will be considered to sufficiently correspond.

It is noted that when claims have been determined to be patentable by the Rospatent after making amendments to the claims, the claims filed at the JPO must usually be amended in a similar way to sufficiently correspond to the patentable claims in the Rospatent application.

- (d) The JPO has not begun examination of the patent application.** (figure O)

(2) Documents to be submitted

Documents (a) to (d) below must be submitted by attaching them to “The Explanation of Circumstances Concerning Accelerated Examination”. It is noted that even when it is not needed to submit the documents mentioned below, the name of the documents must be listed in “The Explanation of Circumstances Concerning Accelerated Examination”. Please refer to the Example Form below for a more detailed guidance.

- (a) **Copies of all office actions¹ from the Rospatent, which were sent in regard to the corresponding patent application filed at the Rospatent, and translations of these office actions².**

Both Japanese and English are acceptable as a translation language.

- (b) **Copies of all claims determined to be patentable by the Rospatent, and translations of them³.**

Both Japanese and English are acceptable as a translation language.

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

If the references are patent documents, the applicant is not required to submit them, because the JPO usually possesses them. If the JPO does not possess such a patent document, the applicant must submit the patent document at the JPO examiner's request. Non-patent literature must always be submitted. It is unnecessary to submit translations of the references or to submit the documents.

- (d) **Claim correspondence table**

Applicants must submit a claim correspondence table which indicates how all claims in the JPO application sufficiently correspond to the claims determined to be patentable by the Rospatent.

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).

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

If the application does not fulfill the requirements (1) and (2) above, the request for accelerated examination will not be accepted. In that case, the JPO will notify the applicant (or the representative) hereof and inform of the reasons why the request for the accelerated examination is dismissed.

¹ Office actions are documents, which relate to substantive patent examination, such as Decision on the Refusal of the Grant of a Patent (Решение об отказе в выдаче патента) and Decision on the Grant of a Patent (Решение о выдаче патента).

² Machine translations are admissible, but if it is impossible for the examiner to understand the outline of the translated office action(s) or the patent claim(s), due to insufficient translation, the JPO examiner can request the applicant to resubmit translations.

2. Way to fill out the request form “The Explanation of Circumstances Concerning Accelerated Examination” when requesting accelerated examination at the JPO under the PPH pilot program

(1) Circumstances

The applicant must indicate that the application falls within the eligible applications as defined in (i) to (iii) of requirement (1) (a) above and that accelerated examination is requested under the PPH pilot program. In addition, the applicant must also write the application number, the publication number or the patent number of the corresponding Rospatent application(s).

If the application (which has one or more claims that have been determined to be patentable by the Rospatent) is different from the application that fulfills the requirements laid down in (i) to (iii) of (1) (a) (for example, a divisional application of the basic application), the applicant must also write the application number, the publication number, or the patent number of the application(s) which has claims that have been determined to be patentable by the Rospatent. The applicant must also specify in writing the relationship between those applications.

(2) Documents to be submitted

The applicant must list all required documents mentioned above in requirement 1(2) (a) to (d) in an identifiable way, even when the applicant are allowed to omit the submission of certain documents according to these requirements 1(2) (a) to (d).

(3) Notice

The forms for “The Explanation of Circumstances Concerning Accelerated Examination” are different depending on if the applicant makes use of the on-line filing procedure or of the paper filing procedure. Please refer to the available application forms: “Form 1 for Accelerated Examination” for on-line procedures and “Form 2 for Accelerated Examination” for paper procedures. (Please see http://www.jpo.go.jp/torikumi/t_torikumi/souki/exe/v3souki/guideline.exe (Japanese only). “Form 1 for Accelerated Examination” is described on page 27 and “Form 2 for Accelerated Examination” is described on page 28-29).

Example Form for the on-line PPH filing procedure

【書類名】 早期審査に関する事情説明書

The name of this paper

【提出日】 平成00年00月00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 0000-000000

Application number

【提出者】

【識別番号】 000000000

【住所又は居所】 〇〇県〇〇市〇丁目

【氏名又は名称】 〇〇〇〇

The name and address of the submitter

【代理人】

【識別番号】 000000000

【住所又は居所】 〇〇県〇〇市〇丁目

【氏名又は名称】 〇〇 〇〇

The name and address of the attorney

Bibliographical items

【早期審査に関する事情説明】

The explanation of circumstances concerning accelerated examination

1. 事情

本出願はロシア特許庁への出願(特許出願番号0000000)をパリ条約に基づく優先権の基礎出願とする出願であり、特許審査ハイウェイ試行プログラムに基づく早期審査の申請を行うものである。

1. Circumstances

This application validly claims priority under the Paris Convention to the corresponding Rospatent application (the application number is 0000000) and the accelerated examination is requested under the PPH pilot program.

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 50 letters), it is impossible to write it down directly to the column “【物件名】”. In this case, 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】 ロシア出願と本出願の請求項の対応関係を示す書面 1
- 【物件名】 **年**月**日付の対応ロシア出願に対する拒絶理由通知の写し 1
- 【物件名】 **年**月**日付の対応ロシア出願に対する特許査定 of 写し 1
- 【物件名】 対応ロシア出願の特許公報であるロシア特許第000000号公報 1
- 【物件名】 対応ロシア出願に対して引用された米国特許第000000号明細書 1
- 【物件名】 対応ロシア出願に対して引用された特開0000-000000号公報 1
- 【物件名】 引用非特許文献1 1

(The name of the document) The table explaining how the claims in the JPO application sufficiently correspond to the claims determined to be patentable by the Rospatent 1

(The name of the document) Copy of the Notification of Reasons for Refusal from the Rospatent on (date) 1

(The name of the document) Copy of the Decision to Grant a Patent from the Rospatent on (date) 1

(The name of the document) The publication of the granted patent of the corresponding Rospatent application: Russian Patent number 0000000 1

(The name of the document) Cited reference of the corresponding Rospatent application: US 0000000 A 1

(The name of the document) Cited reference of the corresponding Rospatent application: JP 0000-000000 A 1

(The name of the document) Cited non-patent literature1 1

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

【添付物件】

The list of attached documents

【物件名】 ロシア出願と本出願の請求項の対応関係を示す書面

The table explaining how the claims in the JPO application sufficiently correspond to the claims determined to be patentable by the Rospatent

Attach the document here as image file or text.

【内容】

| 本出願の請求項 The claim filed to the JPO | ロシアで特許可能とされた請求項 The claim determined to be patentable in the Rospatent | 対応関係に関するコメント Comments about the correspondence |
|---------------------------------------|---|---|
| 1 | 1 | 両クレームは同一である。 Both claims are the same. |
| 2 | 2 | " |
| 3 | 1 | 両クレームは、記載形式を除き同一である。 Both claims are the same except the claim format. |
| 4 | 2 | " |
| 5 | 1 | 請求項5は、ロシアの請求項1にAという発明特定事項を付加したものである。 Claim 5 in the JPO application adds composition A to claim 1 of the Rospatent application |

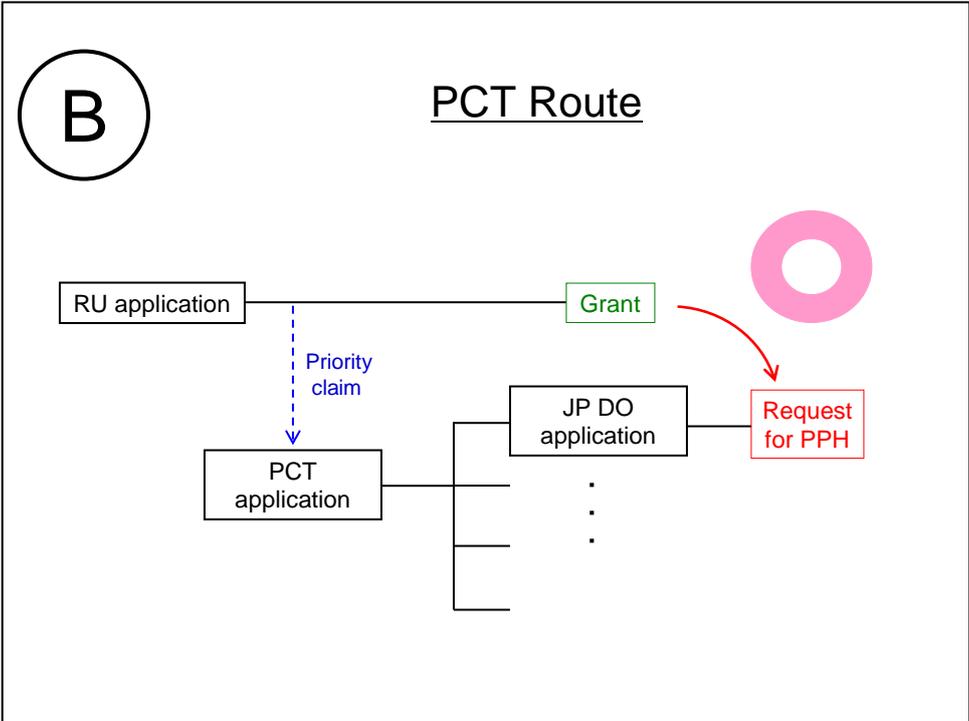
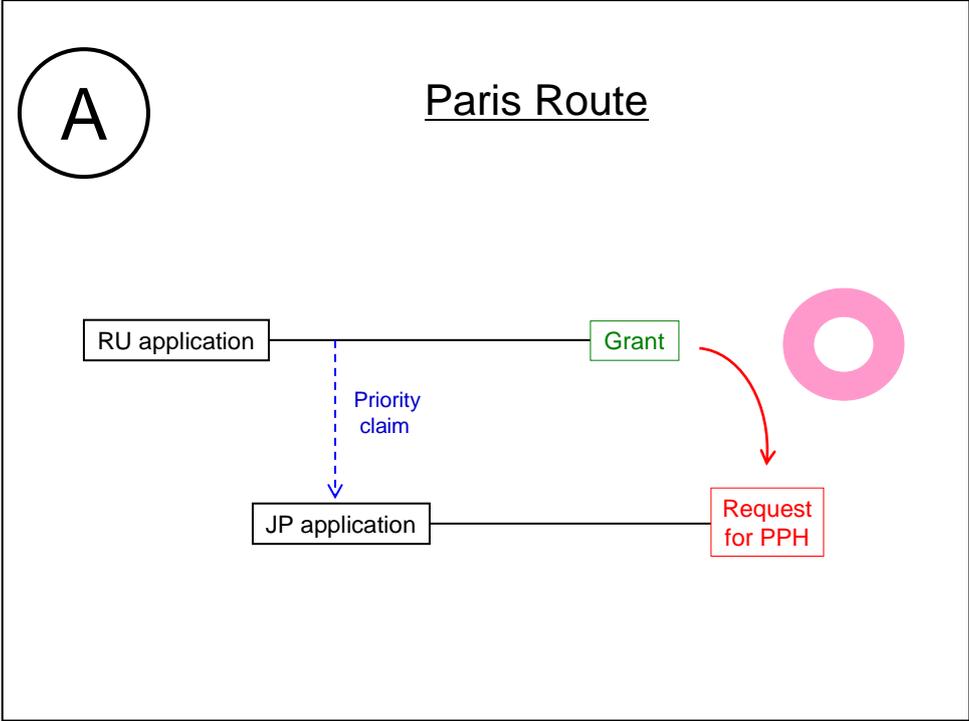
【物件名】 引用非特許文献1

Cited non-patent literature1

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

【内容】

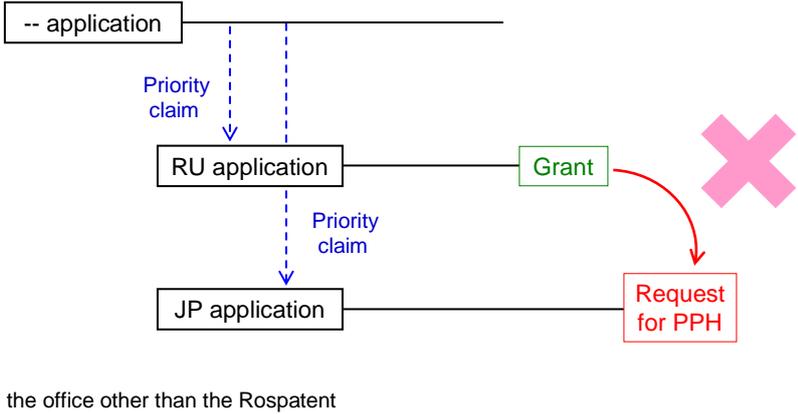
Attach the copy of the document.



C

Paris Route

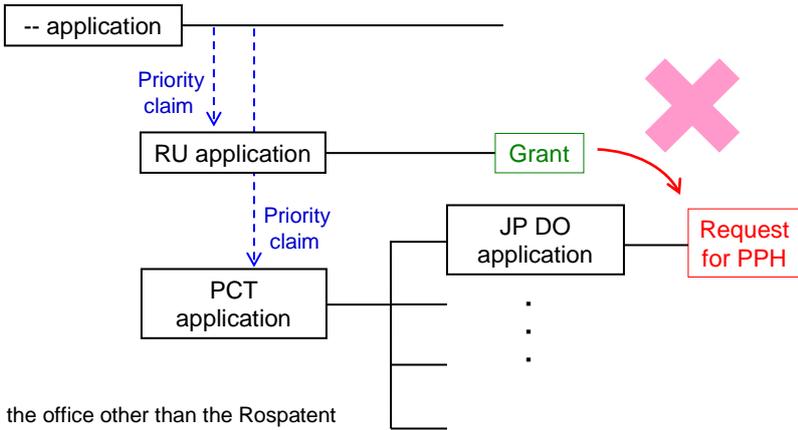
in case the first application is filed at the office other than the Rospatent
- not meeting requirement (a) -



D

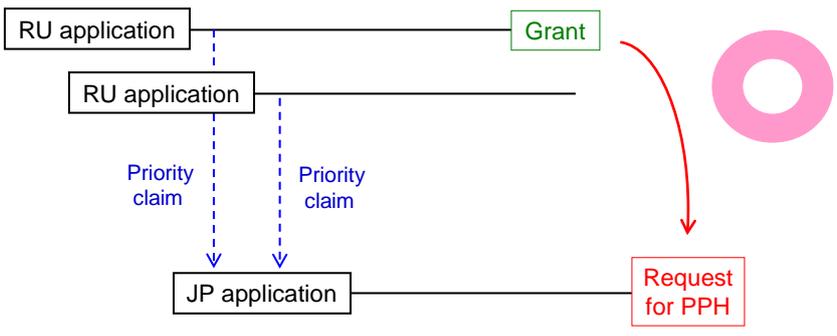
PCT Route

in case the first application is filed at the office other than the Rospatent
- not meeting requirement (a) -



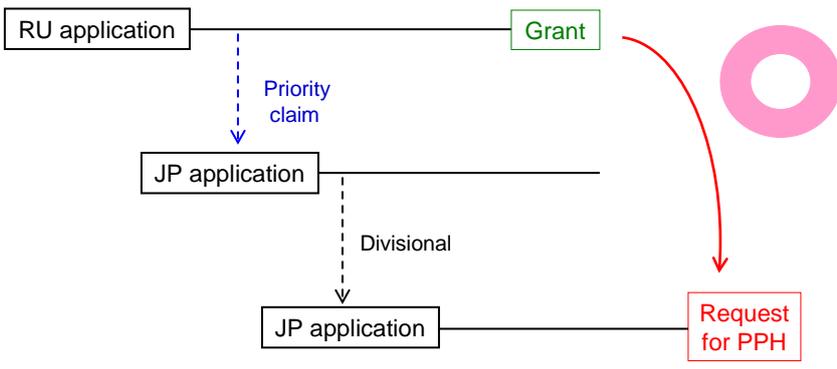
E

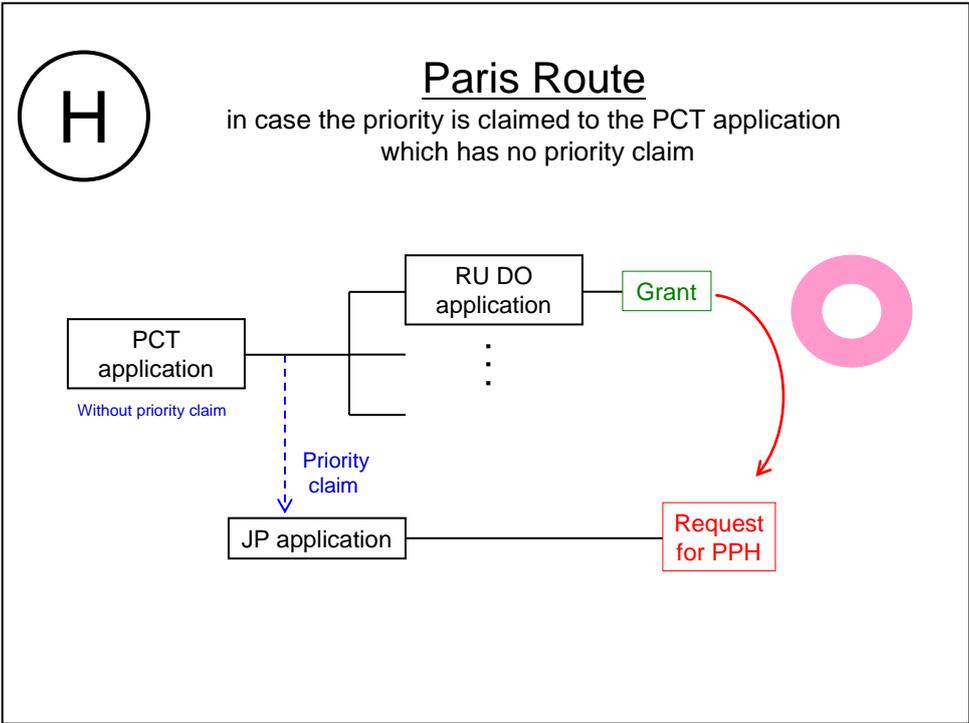
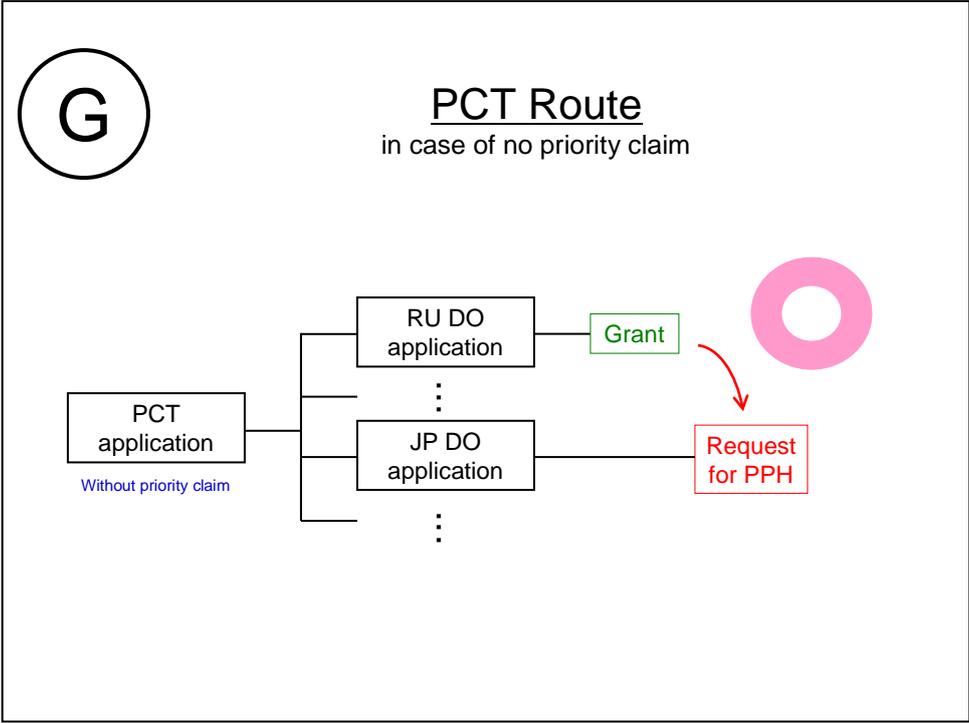
Paris Route & Complex Priorities



F

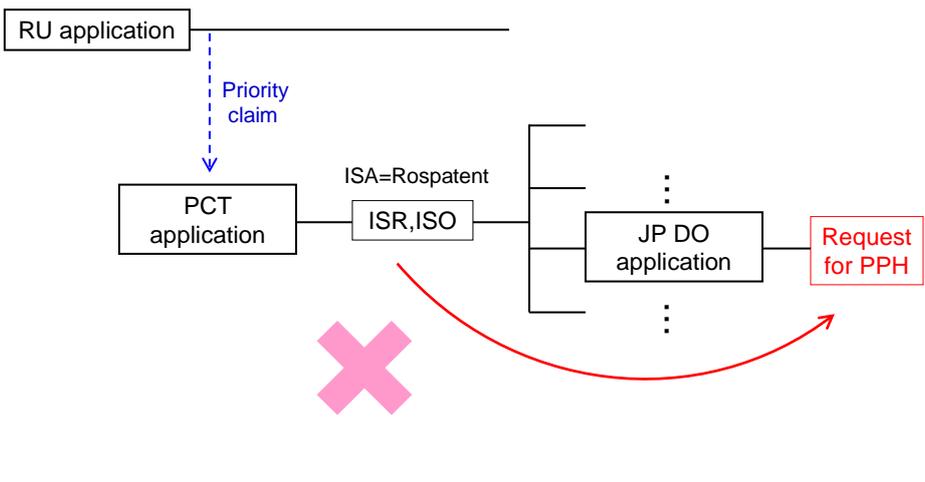
Paris Route & Divisional Application





I

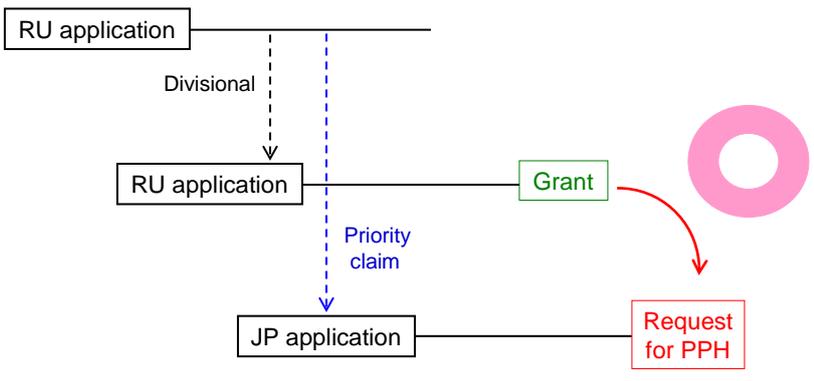
ISR, ISO (International Search Report/Opinion)
- not meeting requirement (b) -



J

Paris Route & Divisional Application

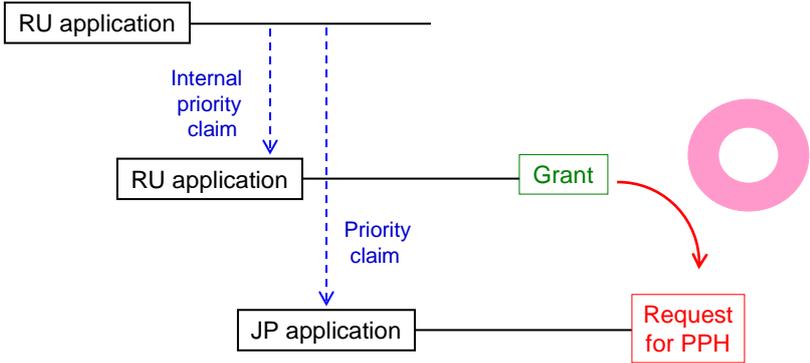
in case the application whose claim(s) has been determined to be patentable derives from the application which forms the basis of the priority



K

Paris Route & Internal Priority

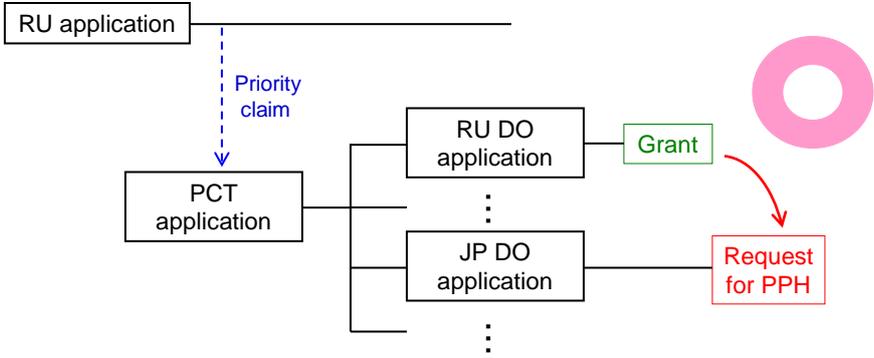
in case the application whose claim(s) has been determined to be patentable derives from the application which forms the basis of the priority



L

PCT Route

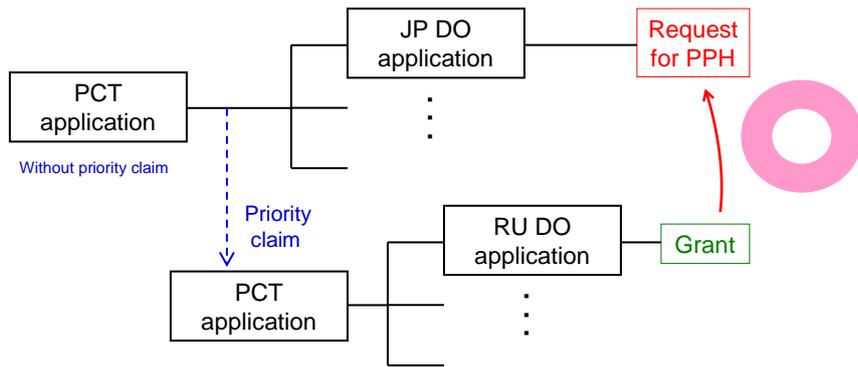
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M

PCT Route

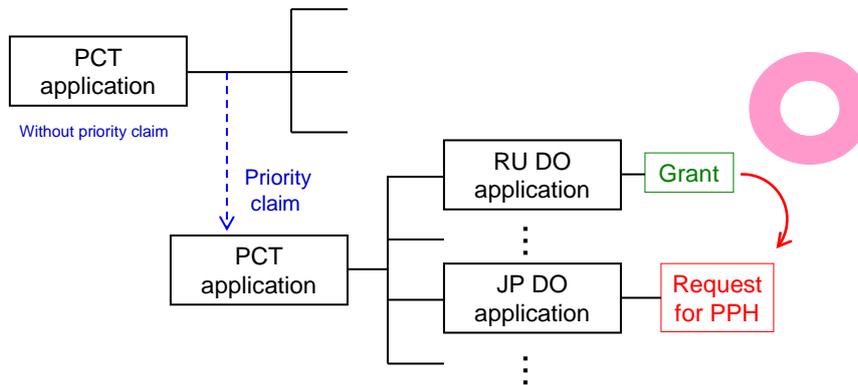
in case the application whose claim(s) has been determined to be patentable derives from the application which forms the basis of the priority

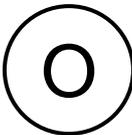


N

PCT Route

in case the application whose claim(s) has been determined to be patentable derives from the application which forms the basis of the priority





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

