

# **Procedures to file a request to the JPO for Patent Prosecution Highway Pilot Program between the JPO and the UK-IPO**

## **1. Request to the JPO**

When an applicant files a request for an accelerated examination under the Patent Prosecution Highway to the Japan Patent Office, an applicant should 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 Patent Prosecution Highway, 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”, if the application, filed to the JPO, satisfies following conditions (1) and the applicant attaches following documents (2) to it.

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

a) The JPO application is an application which validly claims priority under the Paris Convention to the corresponding UK-IPO application(s). The JPO application may include a PCT national phase application. In such case, the PCT international application must have validly claimed priority to the corresponding UK-IPO application(s) (non-PCT application(s)).

The JPO application, which validly claims priority to multiple UK-IPO applications, or the divisional application based on the originally filed application in the JPO, that claims priority to the UK-IPO application(s) is also eligible.

b) At least one corresponding UK-IPO application has one or more claims that are determined to be patentable by the UK-IPO<sup>1</sup>.

c) All claims in the JPO application for which accelerated examination under the PPH is requested must sufficiently correspond to one or more of those claims indicated as patentable in the UK-IPO.

Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope. For the purposes of the JPO, “claims are of the same or similar scope” means that the claims must have a common technical feature which made the claims allowable over the prior art in the UK-IPO application.

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<sup>1</sup> This is the case where the UK-IPO patent examiner clearly identifies those claims to be patentable. The JPO will ask the UK-IPO PPH administrator about patentability of claims if the UK-IPO patent examiner does not clearly identify those claims to be patentable.

Please note that when claims are determined to be patentable by the UK-IPO by making amendment to claims, the claims in the JPO also should be amended similar way to sufficiently correspond to the patentable claims in the UK-IPO application.

d) The JPO has not begun examination of the application.

**(2) The documents that the applicant should attach to “The Explanation of Circumstances Concerning Accelerated Examination”.**

a. Copies of all office actions in the UK-IPO<sup>2</sup>, which were sent for the corresponding application by the UK-IPO.

Paper copies need not be supplied if the applicant would prefer the JPO to obtain them directly from the UK-IPO. In this case, the applicant should clearly express the intent in “The explanation of circumstances concerning accelerated examination” as (\*) in example form (Please see p.5). Translations of office actions are not needed.

b. Copies of all claims determined to be patentable by the UK-IPO.

Paper copies need not be supplied if the applicant would prefer the JPO to obtain them directly from the UK-IPO. In this case, the applicant should clearly express the intent in “The explanation of circumstances concerning accelerated examination” as (\*) in example form (Please see p.5). Translations of office actions are not needed.

c. Copies of references cited by UK-IPO examiner

Copies of patent documents cited by the UK-IPO will not be needed where they are freely available on the JPO’s patent databases. In the case that the JPO doesn’t possess the patent documents, examiners may require the submission of the patent documents. Any translation of cited documents is not needed.

d. The explanation table of sufficiently corresponding claims

Applicant should attach an explanation table to explain how the claims indicated as patentable in the UK-IPO sufficiently correspond to the claims in the JPO application.

When claims are just literal translation, the applicant can just write down that “they are 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 the applicant has already submitted above documents (a. to d.) to the JPO through

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<sup>2</sup> Office actions in the UK-IPO mean “search report”, “examination report” and “notification of grant”.

simultaneous or past procedures, the applicant can incorporate the documents by reference and does not have to attach them.

When the application doesn't fulfill the requirement of (1) and (2), then the applicant cannot omit to fill in the section [2. the disclosure of prior arts and comparison between the claimed invention and prior art] and the request of accelerated examination is not accepted. In that case, the JPO will notify that and the reason for it to the applicant (or the representative).

## **2. Example of “The Explanation of Circumstances Concerning Accelerated Examination” for filing request accelerated examination under PPH**

### **(1) Circumstances**

The applicant should indicate that the application (including PCT national phase application) is an application validly claiming the priority under Paris Convention to the corresponding UK-IPO application, and the accelerated examination is requested under the PPH pilot program here. And the application number of the corresponding application(s), publication number, or a patent number also should be written.

\*In the case that the application which has one or more claims that are determined to be patentable is different from the one that is a base of the priority (for example, the divisional application of the basic application), the application number, publication number, or a patent number of the application(s) that is a base of the priority also should be written.

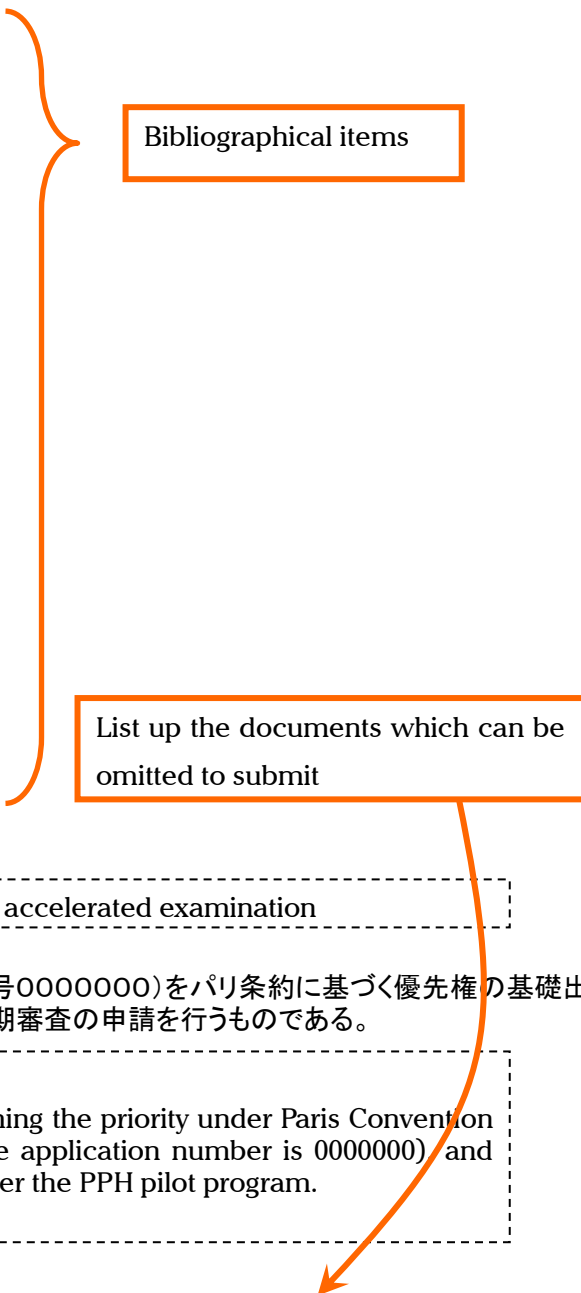
### **(2) The submitted documents**

The applicant should list all required documents mentioned above 1.(2) in an identifiable way, even if the applicant prefer the JPO to obtain them directly from the UK-IPO and doesn't attach the documents themselves.

### **(3) Notice**

Forms of “The Explanation of Circumstances Concerning Accelerated Examination” are different between on-line procedure and paper procedure. So please refer to the examples of forms when filling in (“Accelerated Examination form1” for on-line procedures, and “Accelerated Examination form2” for paper procedures.).

## 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】	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 who submit this	
【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	
【早期審査に関する事情説明】		
	The explanation of circumstances concerning accelerated examination	
1. 事情		
	本出願は英国知的財産庁への出願(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に基づく早期審査の申請を行うものである。	
	1. Circumstances	
	This application is an application validly claiming the priority under Paris Convention to the corresponding UK-IPO application (the application number is 0000000) and the accelerated examination is requested under the PPH pilot program.	
(提出を省略する物件)		
	(物件名)**年**月**日付の対応英国出願に対する調査報告書の写し (日本国特許庁が英国知的財産庁から直接入手することを希望する。)	
	(物件名)**年**月**日付の対応英国出願に対する拒絶理由通知書の写し (日本国特許庁が英国知的財産庁から直接入手することを希望する。)	
	(物件名)**年**月**日付の対応英国出願に対する特許査定書の写し (日本国特許庁が英国知的財産庁から直接入手することを希望する。)	
	(物件名)対応英国出願の特許公報である英国公告第00000号公報	
	(物件名)対応英国出願に対して引用された英国出願公開00000号公報	
	(物件名)対応英国出願に対して引用された日本国特許第00000号公報	

(Documents to be omitted to submit)  
 (The name of the document) Copy of search report in the UK-IPO on (date)  
 (I prefer the JPO to obtain this directly from the UK-IPO)(\*)  
 (The name of the document) Copy of examination report in the UK-IPO on (date)  
 (I prefer the JPO to obtain this directly from the UK-IPO)(\*)  
 (The name of the document) Copy of notification of grant in the UK-IPO on (date)  
 (I prefer the JPO to obtain this directly from the UK-IPO)(\*)  
 (The name of the document) Corresponding application's patent publication: United Kingdom Patent number 0000000  
 (The name of the document) Cited reference of the corresponding UK-IPO application: United Kingdom Publication of application 0000000  
 (The name of the document) Cited reference of the corresponding UK-IPO application: Japan Patent publication of application 0000000

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, 2<sup>nd</sup> edition, Scientist com, Nov. 1985, p.123-127.”

【提出物件の目録】

The list of submitted documents

【物件名】 英国出願と本出願の請求項の対応関係を示す書面 1

The table to explain how the claims indicated as allowable in the UK-IPO sufficiently correspond to the claims in the JPO application 1

【物件名】 引用非特許文献1 1

Non-patent literature1 1

List up the documents to be submitted

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】.”

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】 英国出願と本出願の請求項の対応関係を示す書面

The table to explain how the claims indicated as allowable in the UK-IPO sufficiently correspond to the claims in the JPO application

【内容】

本出願の請求項	英国で特許可能とされた請求項	対応関係に関するコメント
The claim in the JPO	The patentable claim in the UK-IPO	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、英国の請求項1にAという構成を付加したものである。 The claim 5 in the JPO adds the composition A to the Claim 1 in the UK-IPO

【物件名】 引用非特許文献1

Non-patent literature1

【内容】

Attach the copy of the document.

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

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.