

## **Procedures and Requirements for Filing a Request for Patent Prosecution Highway Pilot Program (PPH) at the Japan Patent Office (JPO).**

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### **Background**

These presents are subscribed by the parties within the scope of the PPH Pilot Program agreed upon by and between the National Institute of Industrial Property of the Argentine Republic (INPI) and the Japan Patent Office (JPO) pursuant to the “Joint Statement of Intent for Cooperation in Patent Prosecution Procedures” signed in Geneva on October 5, 2016 by the representatives of the above mentioned entities.

The PPH Pilot Program was established so that, once the Office of Earlier Examination (OEE) has determined patentability of an application, the applicant may request the benefit of accelerated examination of the corresponding application at the Office of Later Examination (OLE), provided that the requirements set forth herein are fulfilled.

The Offices intend that only utility patent applications be subject of or basis for any request for participation in the PPH pilot program in either Office.

This document is intended to define in detail the necessary procedures and requirements for requesting application of the PPH Pilot Program between JPO and INPI.

The JPO and INPI will publish this guideline as well as the necessary forms for requesting participation in the PPH Pilot Program.

The PPH Pilot Program between the INPI and the JPO shall become effective on (month/day/year) for a trial period of 3 years. The INPI and the JPO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period.

Participating offices may terminate the PPH pilot program if the participation volume exceeds the manageable level or for any other reason. Prior notice shall be published when the PPH pilot program is terminated.

This pilot program does not create any legally binding rights or obligations under national or international law.

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### **Requirements for Filing Request to JPO for Patent Accelerated Examination under the PPH Pilot Program.**

In order to be eligible to participate in the PPH accelerated examination, the following requirements shall be fulfilled:

- ***Both the JPO application on which PPH is requested and the INPI application being the basis of the PPH request shall be corresponding applications (See examples in ANNEX I) having the same earliest date (either a priority date or a filing date).***

Applicant shall submit the necessary information to determine the relationship between the application on which the accelerated examination is requested and the corresponding application(s) filed with the INPI.

The expression “corresponding patent applications” should not be necessarily construed

as referred to the application on which a priority claim is based, but it could refer to the application derived from the application on which priority is claimed. For example, a divisional application of the application or an application claiming national priority of the application on which priority is claimed.

For example, the JPO application may be:

(Case I) an application which validly claims priority under the Paris Convention based on the INPI application(s), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the INPI application(s), or

(Case III) an application which shares a common priority document with the INPI application(s).

The pilot program is not applicable on the basis of INPI applications for "utility model".-

***(b) The corresponding application has been substantively examined by INPI and has one or more claims considered as patentable/allowable by the INPI***

Claims considered patentable/allowable shall be expressly identified as such in the granted patent or in the Office action issued by INPI and they will be the basis for the request for participation in the PPH program. Notwithstanding, the fact that the application including the mentioned claims have not yet been granted. The Office action may be:

(i) Decision to Grant a Patent

***(c) In order to be examined pursuant to PPH, all the application claims, either as originally filed or as amended, shall sufficiently correspond to one or more of those claims indicated as allowable/patentable by the INPI so that the JPO application may be then allowed for accelerated examination under the PPH framework.***

Claims are considered to "sufficiently correspond" when, considering differences due to translation and/or claim format, the scope of claims in the JPO application are the same as or narrower than that of claims in the INPI application.

In this regard, a claim that is narrower in scope occurs when an INPI 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 application which introduces a new/different category of claims to those claims indicated as patentable by the INPI shall not be considered to sufficiently correspond. For example, where the INPI claims only contain claims on a process of manufacturing a product, then, if the JPO claims introduce product claims that are dependent on the corresponding process claims, the JPO claims shall not be considered to sufficiently correspond.

Any claims amended or added after the request for participation in the PPH pilot program is allowed but Examiner must sufficiently correspond to the claims indicated as patentable/allowable by the INPI in order to benefit from the PPH accelerated examination.

***(d) The JPO has not begun substantive examination of the application at the time the PPH is requested.***

## **2. Documents to be submitted with JPO for Accelerated Examination under PPH Pilot Program.**

The request form for JPO accelerated examination within the PPH pilot program shall include the following documents:

***(a) Copies of all Office actions (relevant to substantive examination for patentability at the INPI), which were issued in the corresponding application by the INPI, and their translation.***

***(b) Copies of all claims determined as patentable/allowable by the INPI and their translation.***

Either Japanese or English is acceptable as translation language

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.

***(c) Copies of references cited as relevant by the INPI examiner***

If references are patent documents, the applicant should not submit them because they are generally available to the JPO. When a patent document is not available to the JPO examiner, the applicant must submit it at the examiner's request. Non-patent literature must always be submitted and, if necessary, accompanied by their respective translation. When the applicant has already submitted above documents (a) to (c) to the JPO through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

***(d) Claim Correspondence Table.***

The applicant requesting the PPH must submit a claim correspondence table, which will indicate how all claims in the JPO application sufficiently correspond to the patentable/allowable claims in the INPI application.

When claims are just a literal translation, the applicant may only indicate that "they are the same" in the table. When claims are not just a literal translation, the sufficient correspondence of each claim must be explained.

## **3. 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.

#### **4. National Law and Regulation**

The decision regarding patentability of patent applications remains on each Office criteria, in line with its own national legislation.

#### **5. 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”.
- The applicant must indicate that the application is included in 1. (a) – (d), and that the accelerated examination is requested under the PPH pilot program. The application number, publication number, or a patent number of the corresponding INPI 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 INPI application(s) included in 1. (a) – (d) (for example, the divisional application of the INPI 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**

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.).

## Example form of on-line procedures

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

【書類名】 早期審査に関する事情説明書

【提出日】 平成00年00月00日

【あて先】 特許庁長官殿

【事件の表示】

【出願番号】 特願 00000-000000

【提出者】

【識別番号】 000000000

【住所又は居所】 ○○県○○市○丁目

【氏名又は名称】 ○○○○

【代理人】

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【氏名又は名称】 ○○ ○○

【早期審査に関する事情説明】

### 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。

本出願はブラジル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る。当該ブラジル出願に対しては、ブラジル知的財産庁により特許査定が発行されている。

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。

**【提出物件の目録】**

- 【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\*\*日付の特許査定書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

**【添付物件】**

- 【物件名】 PPH申請書

**【内容】**



PPH申請書 (REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) (PILOT) PROGRAM)							
<b>A. 書誌事項 (Bibliographic Data)</b>							
出願番号 (Application Number)	特願0000-000000						
<b>B. 必要事項 (Request)</b>							
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))	コロンビア商工監督局(SIC)						
先行庁の審査書類形式 (OEE Work Products Type)	<input checked="" type="checkbox"/> 国内出願の審査結果を利用 (PPH又はPPH MOTTAINAI) (National/Regional Office Action(s))						
	<input type="checkbox"/> 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)	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 20px;"></td> <td style="width: 20px;"></td> <td style="width: 60px; text-align: center;">00000000</td> </tr> <tr> <td></td> <td></td> <td></td> </tr> </table>			00000000			
		00000000					
<b>C. 必要書類 (Required Documents)</b>							
<b>I. 先行庁のオフィスのアクションの写し、及び、その翻訳文 (OEE Work Products and, if required, Translations)</b>							
1. <input checked="" type="checkbox"/> 先行庁のオフィスのアクションの写しを添付する (A copy of OEE work products is attached; or) <input type="checkbox"/> ドシエ・アクセス・システム又はPATENTSCOPEにおいて、オフィスの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. <input checked="" type="checkbox"/> 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) <input type="checkbox"/> 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)							
<b>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)</b>							
3. <input checked="" type="checkbox"/> 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) <input type="checkbox"/> 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. <input checked="" type="checkbox"/> 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) <input type="checkbox"/> 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)							
<b>III. 引用文献 (Documents Cited in OEE Work Products (if required))</b>							
5. <input checked="" type="checkbox"/> 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) <input type="checkbox"/> 引用非特許文献も引用特許文献もなし (No references cited)							



**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。

**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:)

	(先行庁のオフィリアクションの写し、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)**

	(先行庁のオフィリアクションの写し、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

【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

【内容】

【物件名】 \*\*年\*\*月\*\*日付の特許査定書の写し及びその翻訳文

【内容】

【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

【内容】

【物件名】 引用非特許文献 1

【内容】

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.

## ANNEX I

**Examples of Argentine Patent Applications for which Accelerated Examination can be requested under the PPH Pilot Program.**

The following examples refer to the INPI y JPO (this latter being the office to which participation in PPH pilot program is requested.)

**Example A, Paris Route**

**Example B, Paris Route and Divisional Application.**

**Example C, Paris Route.**

**Example D, Paris Route.**

**Example E, Paris Rout, but First Application is from a Third Country.**

**Example F, Paris route and via PCT**

## ANNEX II

### Examples of Cases considered to “Sufficiently Correspond” and Cases not considered to “Sufficiently Correspond”.

1. Claims in the following cases (case 1 to 4) are considered to “sufficiently correspond”:

Case	“Patentable/Allowable” Claims		JPO Claims		Comment
	No.	Content	No.	Content	
Case 1	1	A	1	A	Claim 1 in JPO application is the same as the “patentable/allowable” claim 1.
Case 2	1	A	1 2	A A+a	Claim 1 in JPO application is the same as “patentable/allowable” claim 1.  Claim 2 in JPO application is created by adding a technical feature described in the specification to “patentable/allowable” claim 1.
Case 3	1 2 3	A A+a A+b	1 2 3	A A+b A+a	Claim 1 in JPO application is the same as “patentable/allowable” claim 1.  Claims 2, 3 in JPO application are the same as “patentable/allowable” claims 3, 2, respectively.
Case 4	1	A	1	A+a	Claim 1 in JPO application has an additional technical feature “a” described in the specification.

2. Claims in the following cases (cases 5 and 7) are NOT considered to “sufficiently correspond”:

Case	“Patentable/Allowable” Claim(s)		Claim(s) in JPO application		Comment
	No.	Content	No.	Content	
Case 5	1	A Product	1	A' Method	Claim 1 in JPO application defines a method while “patentable/allowable” claim 1 defines a product. The technical feature of the “patentable/allowable claim” is the same as in the JPO claim but they have different categories.
Case 6	1	A+B	1	A+C	Claim 1 in JPO application is different from “patentable/allowable” claim 1 as to a component of the invention claimed. The JPO claim is created by changing part of the technical features of the “patentable/allowable” claim.
Case 7	1	A+b	1	A	Claim 1 in JPO application is different from “patentable/allowable” claim 1 as to a component of the invention claimed. The JPO claim is broader than the “patentable/allowable” claim.