

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

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 Paris Convention application which validly claims priority to the corresponding USPTO application(s). (PCT applications shall be excluded.) The JPO application, which validly claims priority to multiple USPTO applications, or the divisional application based on the originally filed application in the JPO, that claims priority to the USPTO application(s) is also eligible.

b) At least one corresponding USPTO application has one or more claims that are determined to be allowable/patentable by the USPTO.

The allowable/patentable claims are

1. the claims shown in the item of “The allowed claim(s) is/are___” in “Notice of Allowability”
2. the claims shown in the item of “Claim(s) ___ is/are allowed” in “Office Action Summary” of “Non-Final Rejection” or “Final Rejection”.
3. the claims¹ shown in the item of “Claim(s) ___ is/are objected to” in “Office Action Summary” of “Non-Final Rejection” or “Final Rejection” and the USPTO examiner indicates that the claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of

¹ When a claim is rejected and the USPTO examiner indicates in the Office action that certain features of the patentable invention have not been claimed and if properly claimed such claim may be given favorable consideration, the suggested and hypothetical claims are not regarded as patentable in this program.

the base claim and any intervening claims.

(Please refer to the Annex 1 for the detail.)

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 allowable/patentable in the USPTO.

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 USPTO application.

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

(Please refer to the Annex 2 for the detail.)

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 USPTO², which were sent for the corresponding application by the USPTO.

If these documents are available from Patent Application Information Retrieval (<http://portal.uspto.gov/external/portal/pair>), the applicant does not have to attach them by indicating that. The translations of the office actions are unnecessary.

The Japanese translation of office actions is basically unnecessary.

However, when the request is filed based on the U.S. claims shown in the item of “Claim(s) ___ is/are objected to”, it is required to submit translation of “Allowable Subject Matter” of the office action that shows claims are allowable except objection.

b. Copies of all claims determined to be allowable/patentable by the USPTO.

There is no need to attach a copy of claims, if they are available from PAIR. The translations of them are unnecessary.

c. Copies of references cited by USPTO examiner

All of references cited in “Detailed Action” or “Reason for Allowance”(Please refer to the

² Office actions in the USPTO mean “Non-Final Rejection”, “Final Rejection”, and “Notice of Allowability”.

Annex 1 for the detail) should be attached. If the references are available from IPDL of the JPO, the applicant doesn't have to attach them by indicating that.

d. The explanation table of sufficiently corresponding claims

Applicant should attach an explanation table to explain how the claims indicated as allowable/patentable in the USPTO 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).

Please refer to the Annex 3 for the example of the table.

When the applicant has already submitted above documents (a. to d.) to the JPO through 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). The applicant can make a correction to the request form "The Explanation of Circumstances Concerning Accelerated Examination" only once.

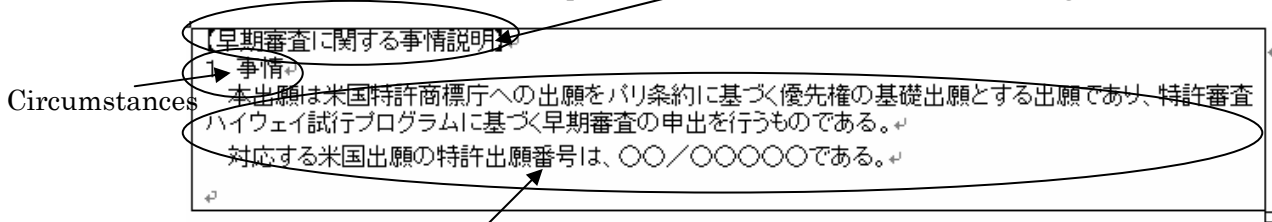
2. Example of "The Explanation of Circumstances Concerning Accelerated Examination" for filing request accelerated examination under PPH

Example of [1.Circumstances]

The applicant should indicate that the application is Paris Convention application and validly claiming the priority to the corresponding USPTO 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.

(Example)

“The Explanation of Circumstances Concerning Accelerated Examination”



This application is Paris Convention application and validly claiming the priority to the corresponding USPTO application, and the applicant request accelerated examination under the PPH pilot program. And the application number of the corresponding application(s) is ***** (please include the patent number if available).

[2. the disclosure of prior arts and comparison between the claimed invention and prior art]

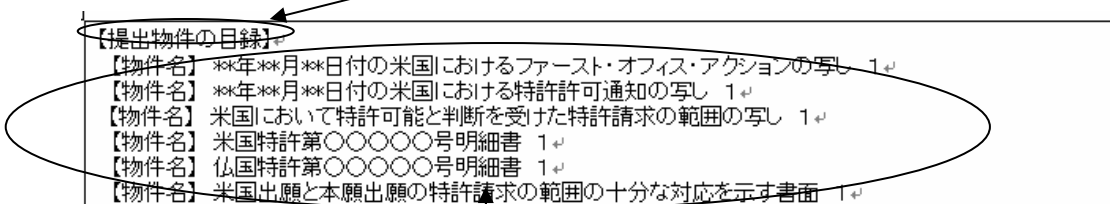
Applicants can omit [2. the disclosure of prior arts and comparison between the claimed invention and prior art] under the PPH.

[The list of the submitted documents]

The applicant should list all required documents mentioned above(2), even if the applicant doesn't have to attach the documents themselves.

(Example)

The list of submitted documents



[The name of document] Copy of first office action in the U.S. on (date) 1
[The name of document] Copy of “the notice of allowability” in the U.S. on (date) 1
[The name of document] Copy of Claims which determined to be patentable in the U.S. 1
[The name of document] United States Patent (Patent number *****) 1
[The name of document] France Patent (Patent number *****) 1
[The name of document] The table to explain how the claims indicated as allowable in the USPTO sufficiently correspond to the claims in the JPO application.

(Example) [the submitted document] [the name of document]

【添付物件】
 【物件名】 **年**月**日付の米国におけるファースト・オフィス・アクションの写し
 【内容】 PAIR より入手可能なため省略
 【物件名】 **年**月**日付の米国における特許許可通知の写し
 【内容】 PAIR より入手可能なため省略
 【物件名】 米国において特許可能と判断を受けた特許請求の範囲の写し
 (クレーム1~2:**年**月**日付補正書、クレーム3:出願当初明細書)
 【内容】 PAIR より入手可能なため省略
 【物件名】 米国特許第○○○○○号明細書
 【援用の表示】 特願平○年○○○号、上申書、○年○月○日
 【物件名】 仏国特許第○○○○○号明細書
 【内容】 添付を要しないため省略

Identify the application document(s) submitted to the USPTO which contains the claims determined to be patentable.

[contents] Attach the document here as image file. If the applicants can omit to attach the documents, the applicant should write the reason of omission. (e.g. This document is available from PAIR.)

The table to explain how the patentable claims in the USPTO sufficiently correspond to the claims in the JPO

(Example) [the explanation table]

【物件名】 米国出願と本願出願の特許請求の範囲の十分な対応を示す書面
 【内容】

本出願の請求項	米国で特許可能とされた請求項	対応に関するコメント
1	1	両クレームは、同一である
2	2	//
3	3	//
4	1	両クレームは、記載形式を除いて実質的に同一である
5	2	//
6	3	//
7	1	請求項 7 は、米国の請求項 1 に A という構成を付加したものである。
8	2	請求項 8 は、米国の請求項 2 に B という構成を付加したものである。

An applicant can't omit the table.

Please refer to the **Annex 3** for the format and contents of the table.

When applicant submit Japanese translation of office action.

[The name of document] Translation of [Allowable Subject Matter] of first office action in the U.S. on (date)

【物件名】 **年**月**日付の米国におけるファースト・オフィス・アクションの「Allowable Subject Matter」の翻訳

【内容】
特許可能な主題。
請求項は、拒絶されている基礎クレームに従属しているという不備があるが、基礎クレームと中間のクレームの全ての限定を含むように独立形式で書き直せば特許可能であろう。

Japanese translation of [Allowable Subject Matter]

3. The evaluation of the Patent Prosecution Highway Pilot Program

As part of our ongoing efforts to improve this framework and for consideration to expand to other Offices in the future, the JPO needs feedback from applicant's side.

When an applicant files the request for the PPH, the JPO will send an evaluation form after the notice that request is not accepted or examiner's office action is sent. We would appreciate if applicants could take time to complete the evaluation form.

Thank you for your cooperation.

If “Reasons for Allowance” is also notified with “Notice of Allowability”, then the applicant also should attach it.

Application/Control Number:	Page 2
Art Unit:	
REASONS FOR ALLOWANCE	
The following is an examiner's statement of reasons for allowance:	
Claim 3 is allowable because the prior art fails to teach or suggest a	

...

And the applicant also should attach the references cited in “Reasons for Allowance”

2) "Non-Final Rejection", "Final Rejection"

The claims that are determined to be allowable/patentable by the USPTO means the claims which are shown in "5.Claim(s) ___ is/are allowed." of "Disposition of Claims" in "Office Action Summary" or

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Art Unit	

-- The MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____ .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) ___ is/are pending in the application.

4a) Of the above claim(s) ___ is/are withdrawn from consideration.

5) Claim(s) ___ is/are allowed.

6) Claim(s) ___ is/are rejected.

7) Claim(s) ___ is/are objected to.

8) Claim(s) ___ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on ___ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on ___ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

The claims that are determined to be allowable/patentable, when the claims are shown in "7. Claim(s) ___ is/are objected to" of "Disposition of Claims" in "Office Action Summary" and the USPTO examiner indicates that the claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicant also should attach “DETAILED ACTION” with “Office Action Summary”.

Page 2

Application/Control Number:
Art Unit:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

**** (U. S. Pat. *****) in view of (*****) et al. (U. S. Pat. *****)

...

And the applicant also should attach the references cited in “DETAILED ACTION”.

Allowable Subject Matter

15. Claims 18 and 19 appear to avoid the prior art of record and be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. Claims 27-29 are objected to as being dependent upon a rejected base claim, but would appear to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

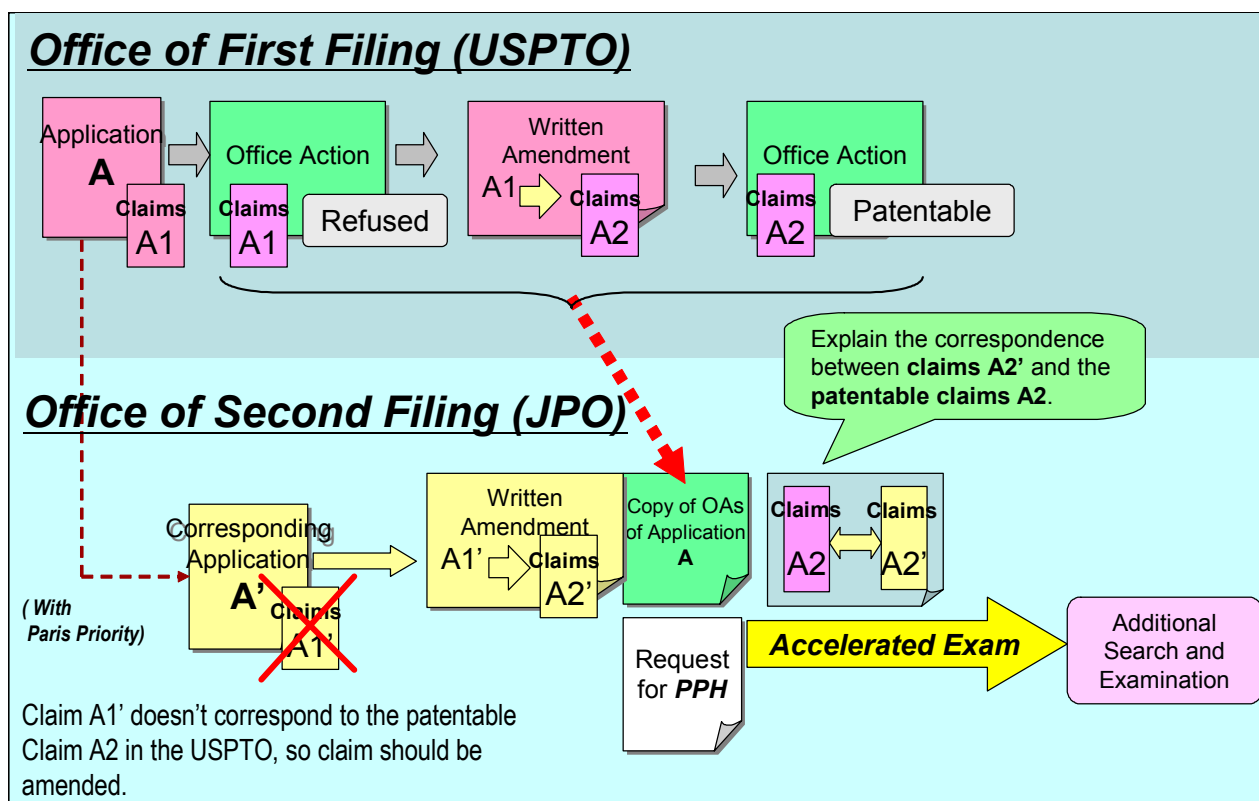
The Japanese translation of office actions is basically unnecessary. However, when the request is filed based on the U.S. claims shown in the item of “Claim(s) ___ is/are objected to”, it is required to submit translation of “Allowable Subject Matter” of the office action that shows claims are allowable except objection.

Sufficient correspondence between all claims in the JPO application and allowable or patentable claim in the USPTO application

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 allowable/patentable in the USPTO.

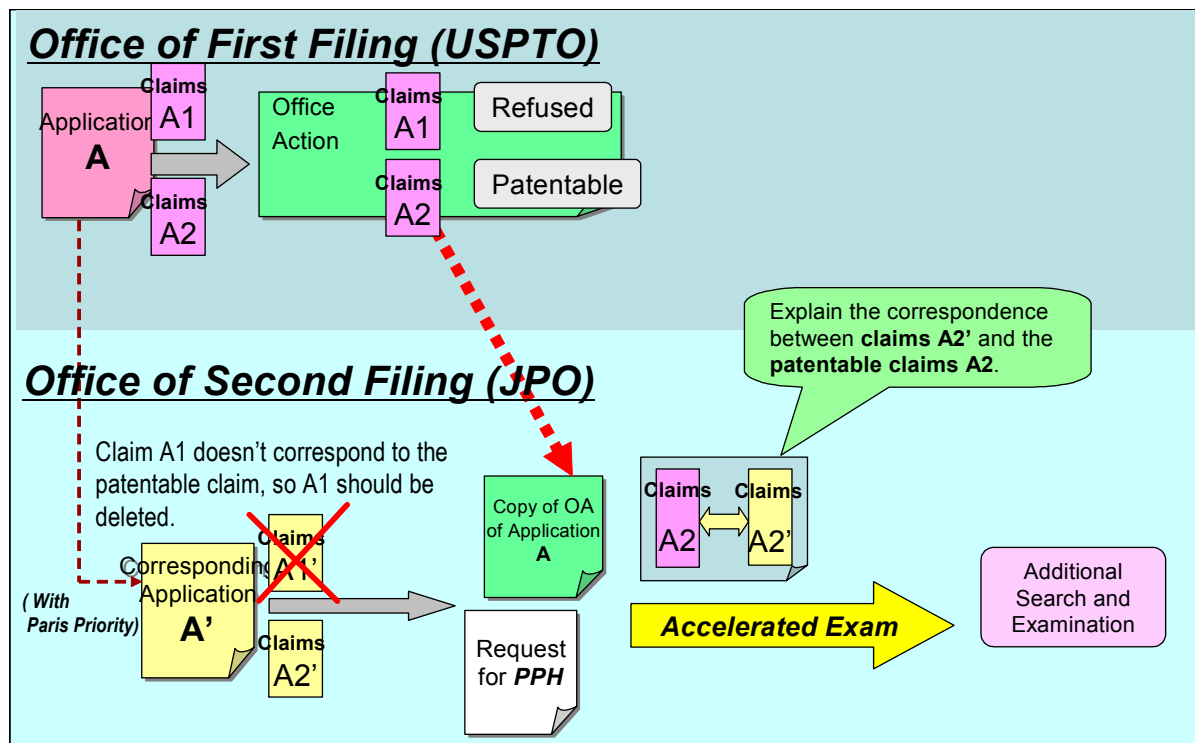
These are examples that how the claims in JPO makes corresponding to the patentable claims in the USPTO.

Example 1. The case that claims are determined to be patentable because of the amendment in the USPTO.



When claims are determined to be allowable/patentable by the USPTO because of the amendment, the claims in the JPO also should be amended similar way to be sufficiently correspond to the allowable/patentable claims in the USPTO application.

Example 2. The case that a part of claims are determined to be patentable in the USPTO.



When only certain claims are determined to be patentable and the rest of the claims are not patentable in the USPTO, the applicant should amend to make all of claims in JPO application corresponding to the patentable claims in the USPTO.

All claims in the JPO application should sufficiently correspond to allowable/patentable claims in the USPTO. The JPO application must not include any claims that do not sufficiently correspond to the allowable/patentable claims.

The table to explain sufficient correspondence

An applicant should explain how the claims in the application sufficiently correspond to the claims indicated as patentable in the USPTO based on the following form.

The claims in the JPO	The patentable claims in the USPTO	Comment about the correspondence
1	1	Both claims are same.
2	2	Same as above
3	3	Same as above
4	1	Both claims are same except the claim format.
5	2	Same as above
6	3	Same as above
7	1	The claim7 in JPO adds the composition A to Claim 1 in USPTO.
8	2	The claim8 in JPO adds the composition B to Claim 2 in USPTO