

*Introduction to **PCT-Patent Prosecution Highway***

November 28, 2013

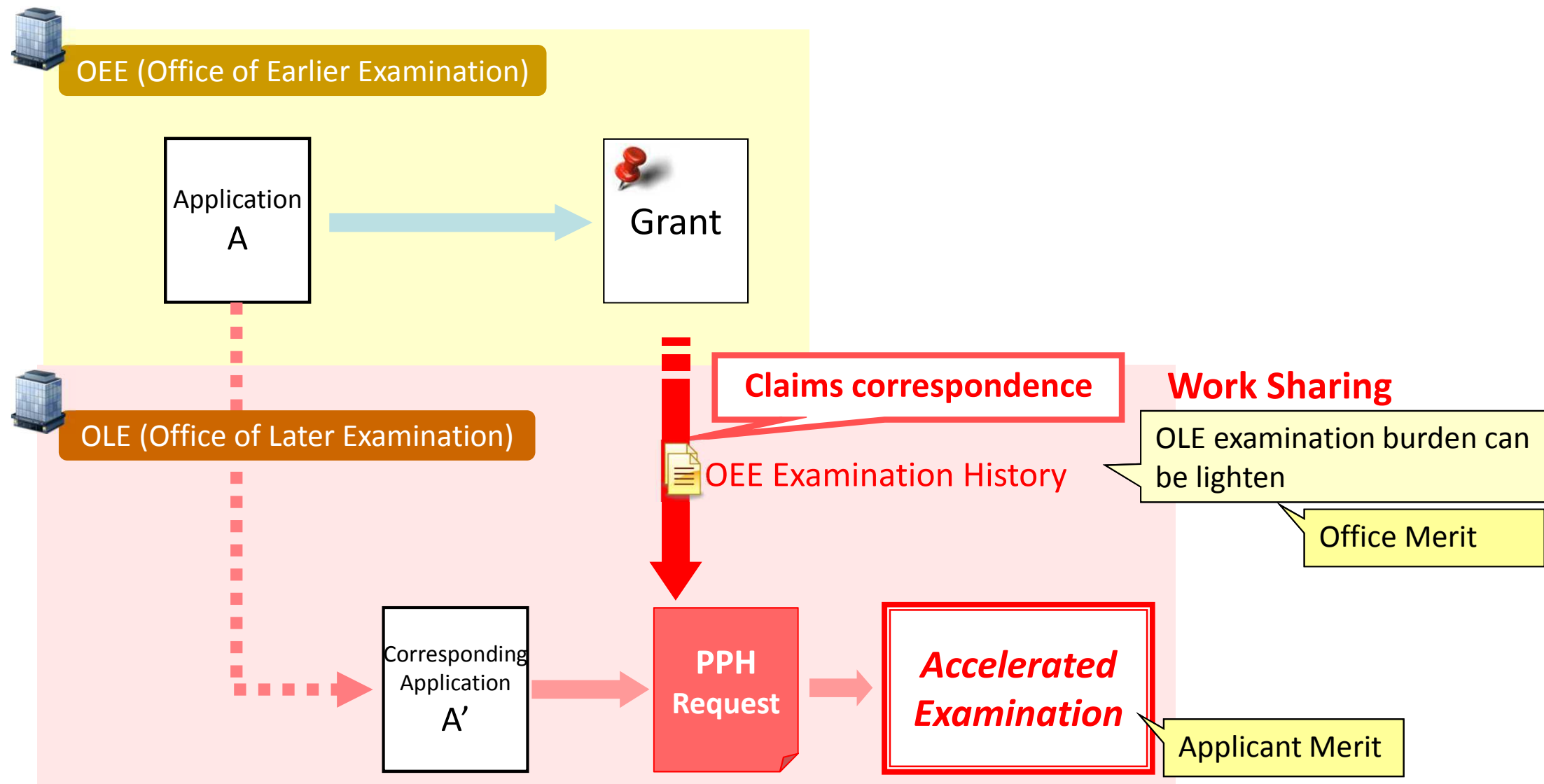
JAPAN PATENT OFFICE

What is PCT-PPH?



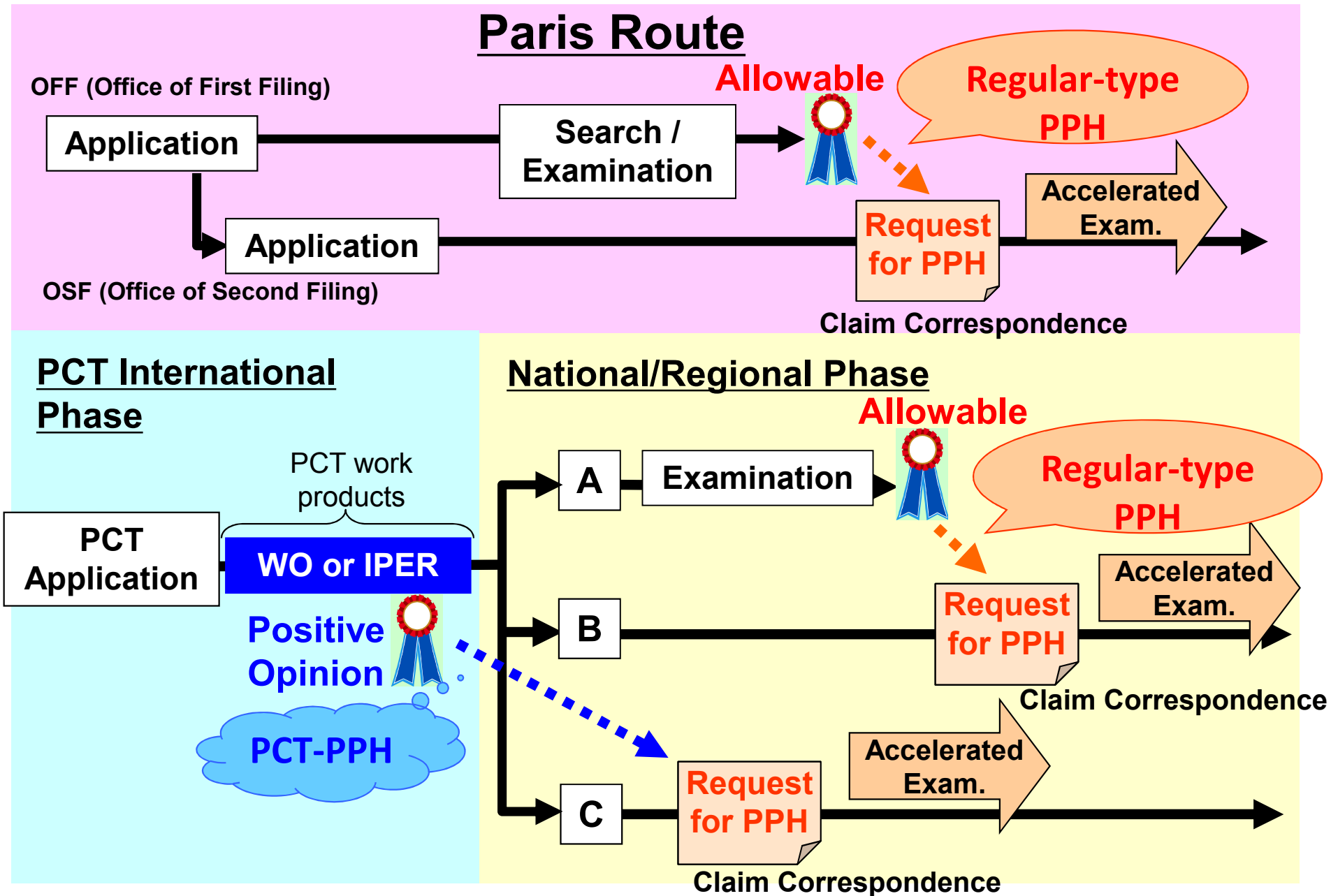
The Scheme of Patent Prosecution Highway

PPH is a framework in which an application determined to be patentable in the Office of Earlier Examination is eligible to have ***an accelerated examination*** in the Office of Later Examination with a simple procedure upon an applicant's request

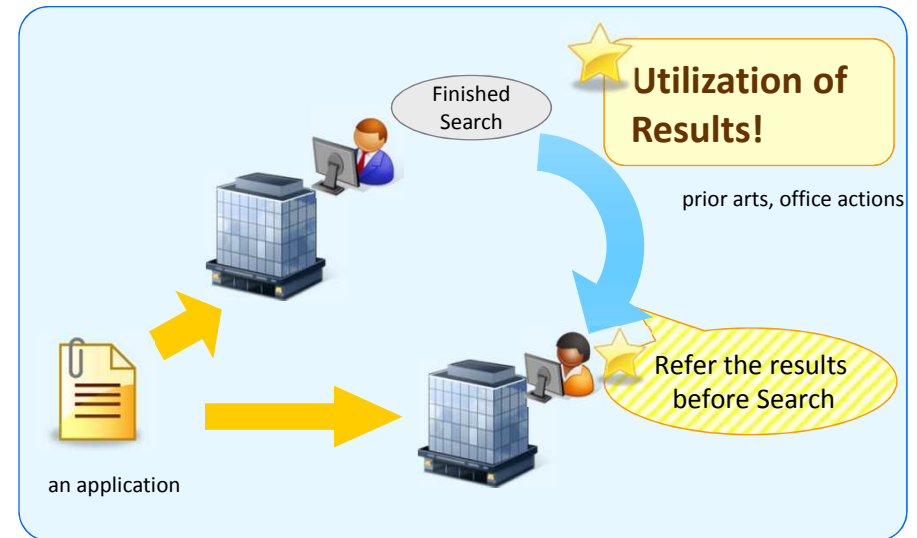
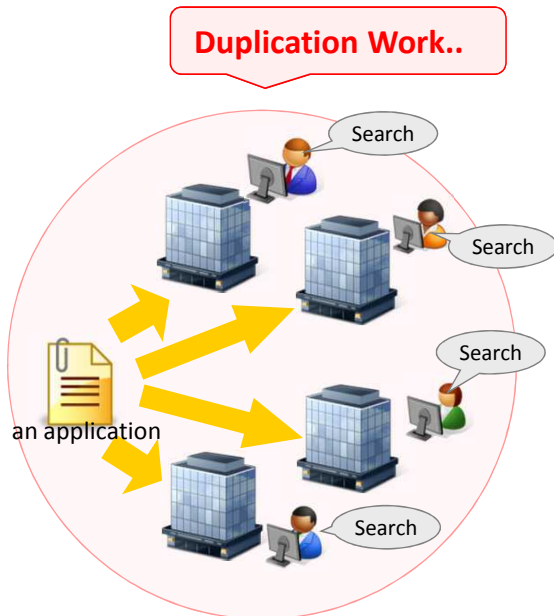


Regular-type PPH

PCT-PPH



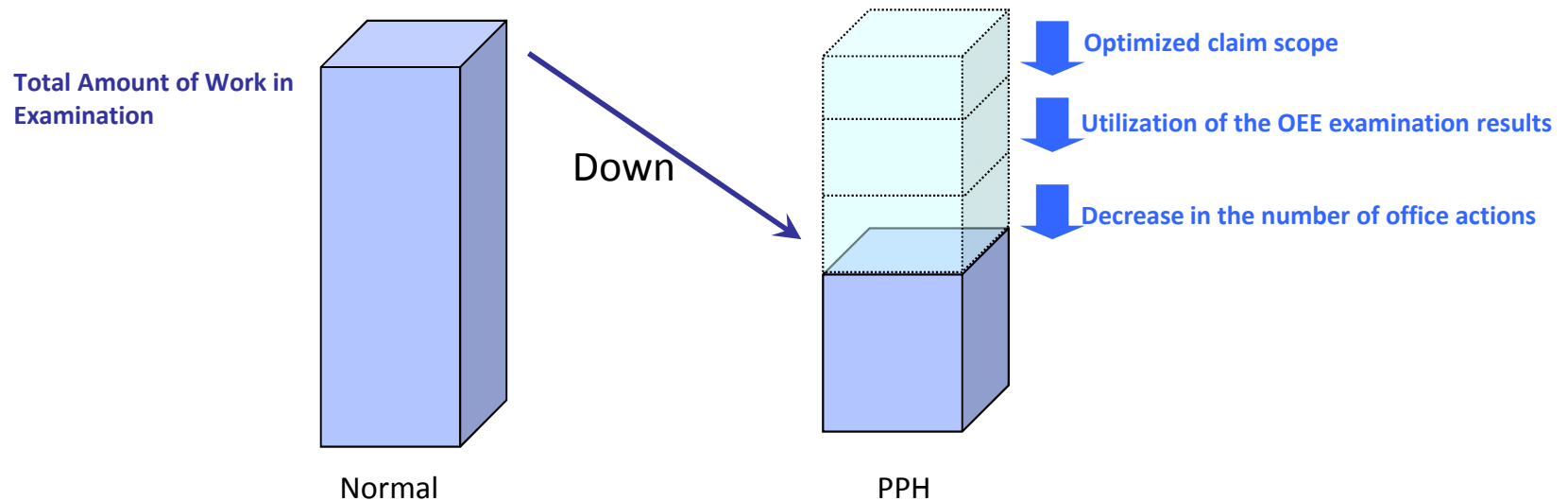
Merit for the Patent Offices: **Work Sharing effect**





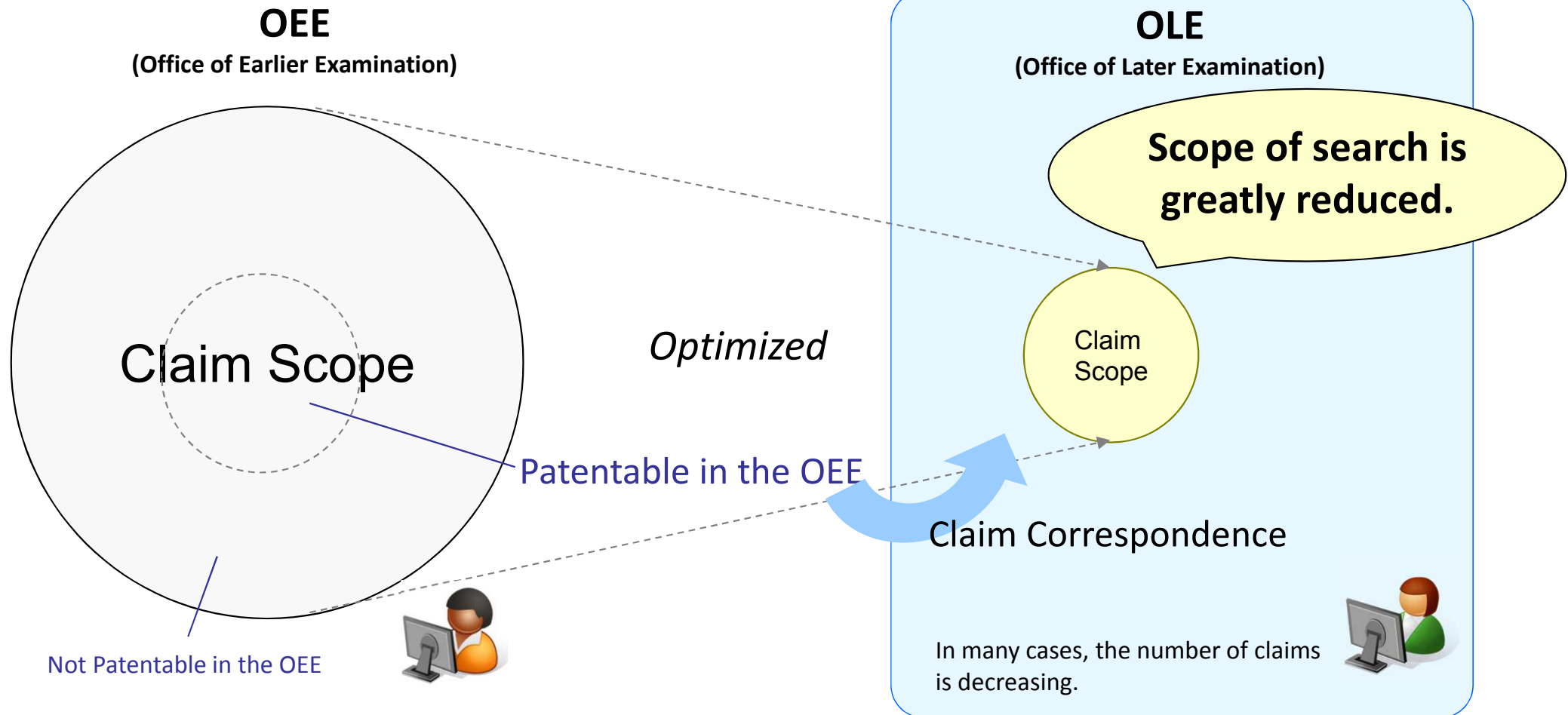
Work Sharing Effect: Easing Examination Burden

1. Optimized claim scope
2. Utilization of OEE search/examination result
3. Decrease in the number of office actions





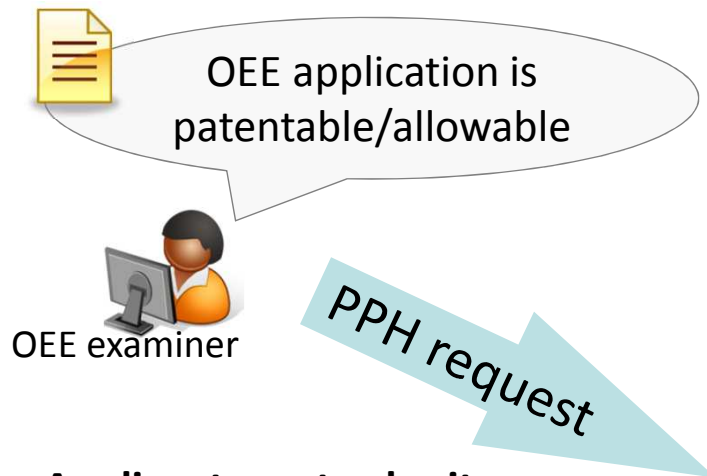
Optimized claim scope



To request for the PPH, the OLE application's claim scope must be **sufficiently corresponded** to OEE application's claim scope which was determined to be patentable/allowable by the OEE



Utilization of OEE search/examination results







Applicant must submit;

- ✓ Copies of all OEE Office Actions
- ✓ Copies of all claims determined to be patentable/allowable
- ✓ Copies of all cited documents
- ✓ Claim correspondence table

OLE

OLE examiner can refer;



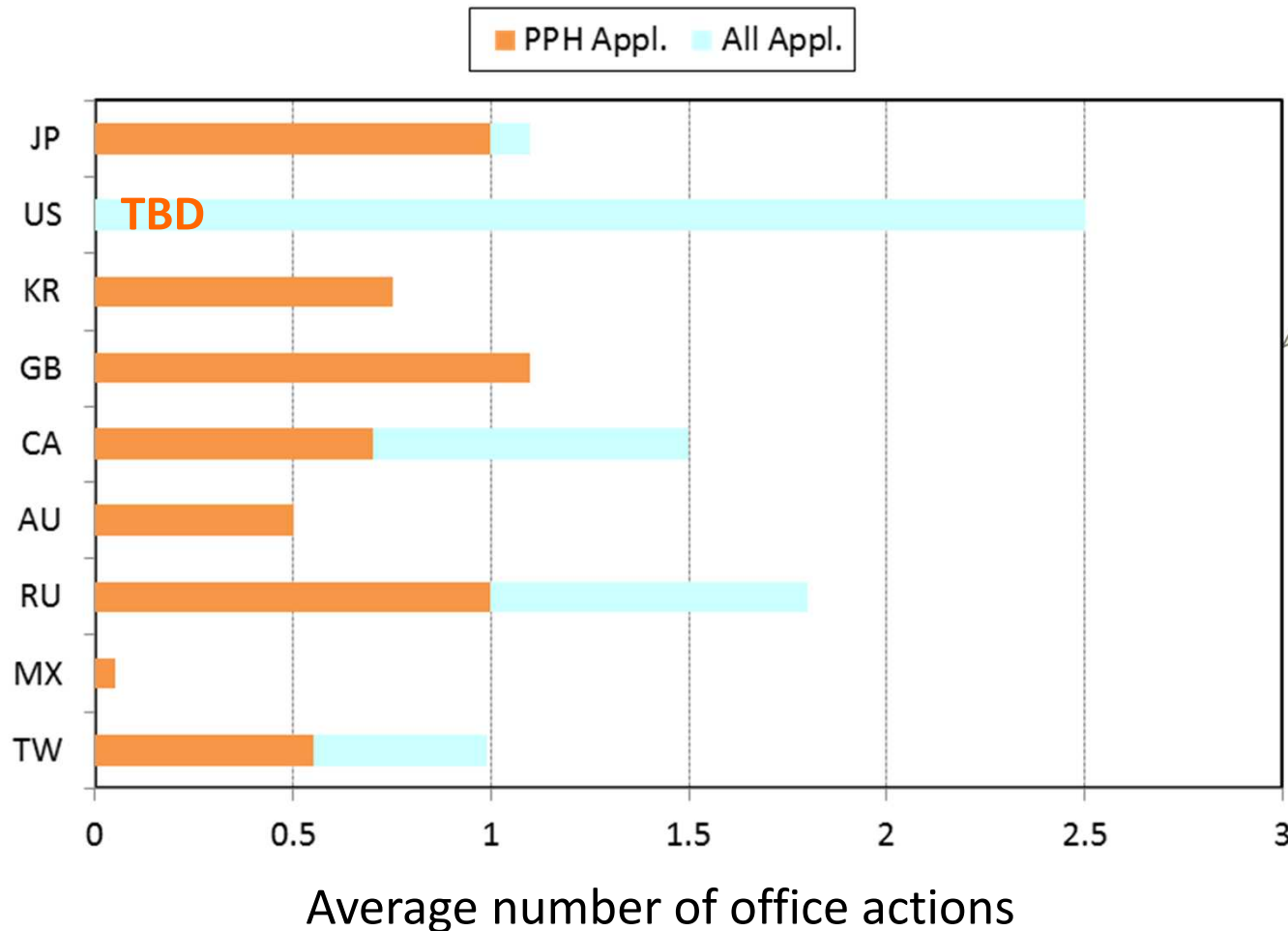
-  OEE Office Actions
-  Copies of all claims determined to be patentable/allowable by the OEE
-  Copies of all cited documents
-  Claim correspondence table



OLE application's claim scope must sufficiently correspond to OEE application's claim scope

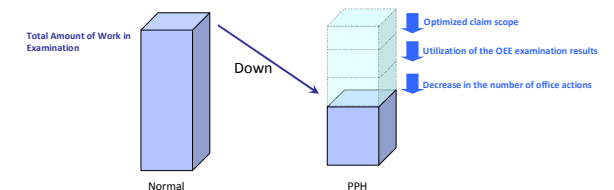


Decrease in the number of office actions



PPH applications tend to be efficiently judged in the OLE because OLE examiners can refer examination history of the OEE.

Period: Jan - Jun 2013 TBD: To Be Determined



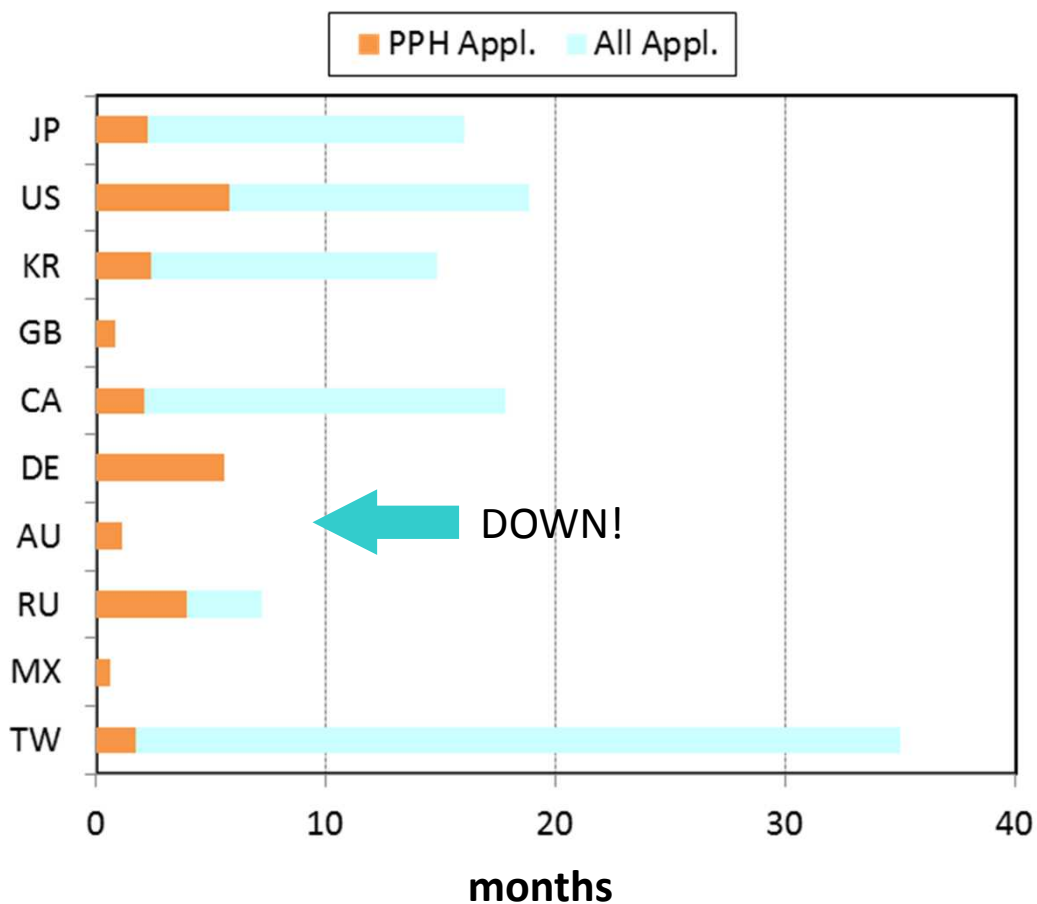
Merit for the Applicants:

High speed, Cost saving, High predictability

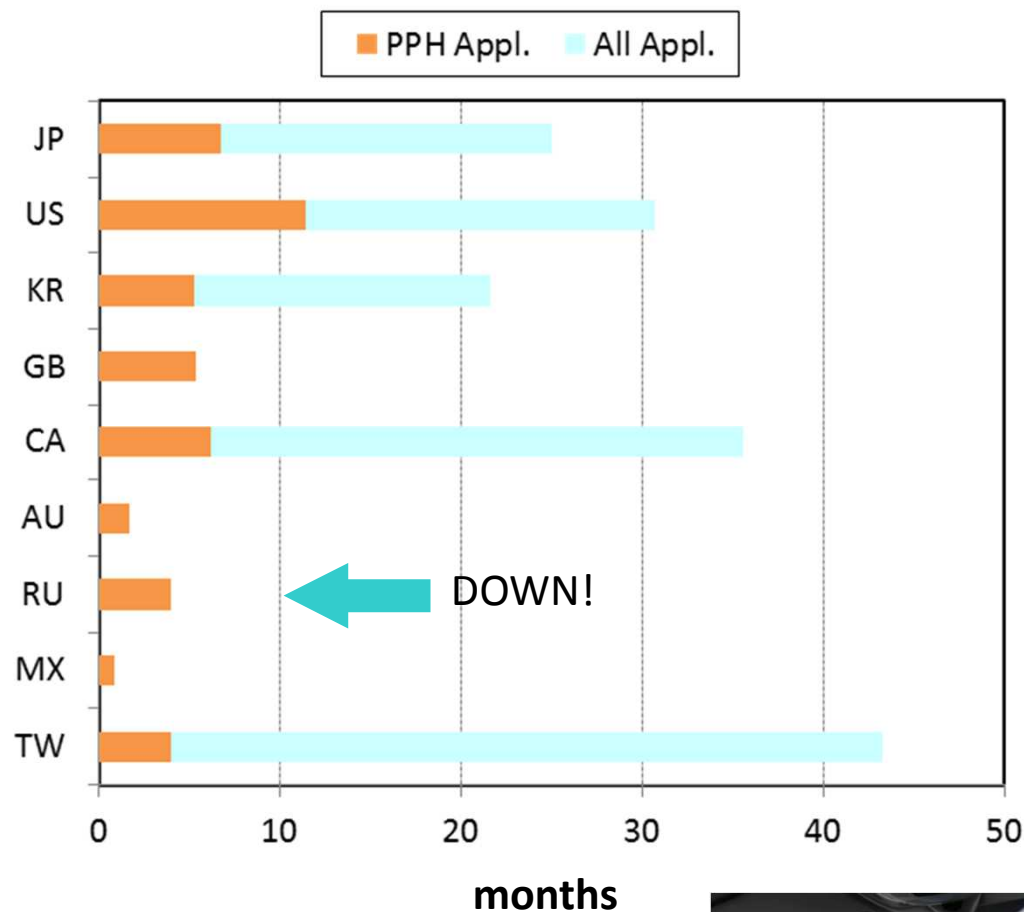


Accelerated Examination

PPH – Average pendency from PPH request to First Office Action



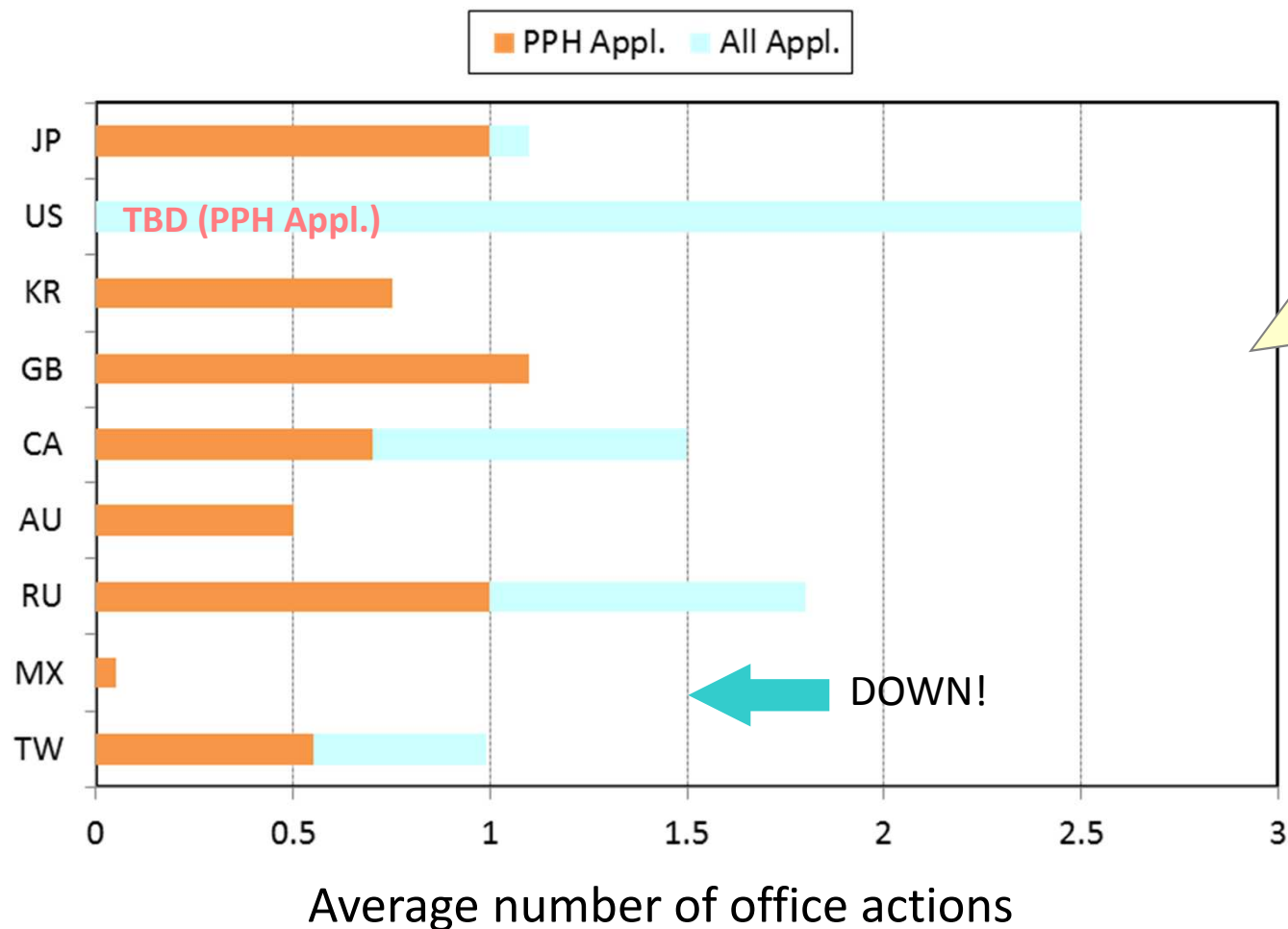
PPH – Average pendency from PPH request to Final Decision



Period: Jan - Jun 2013



Decrease in the number of office actions

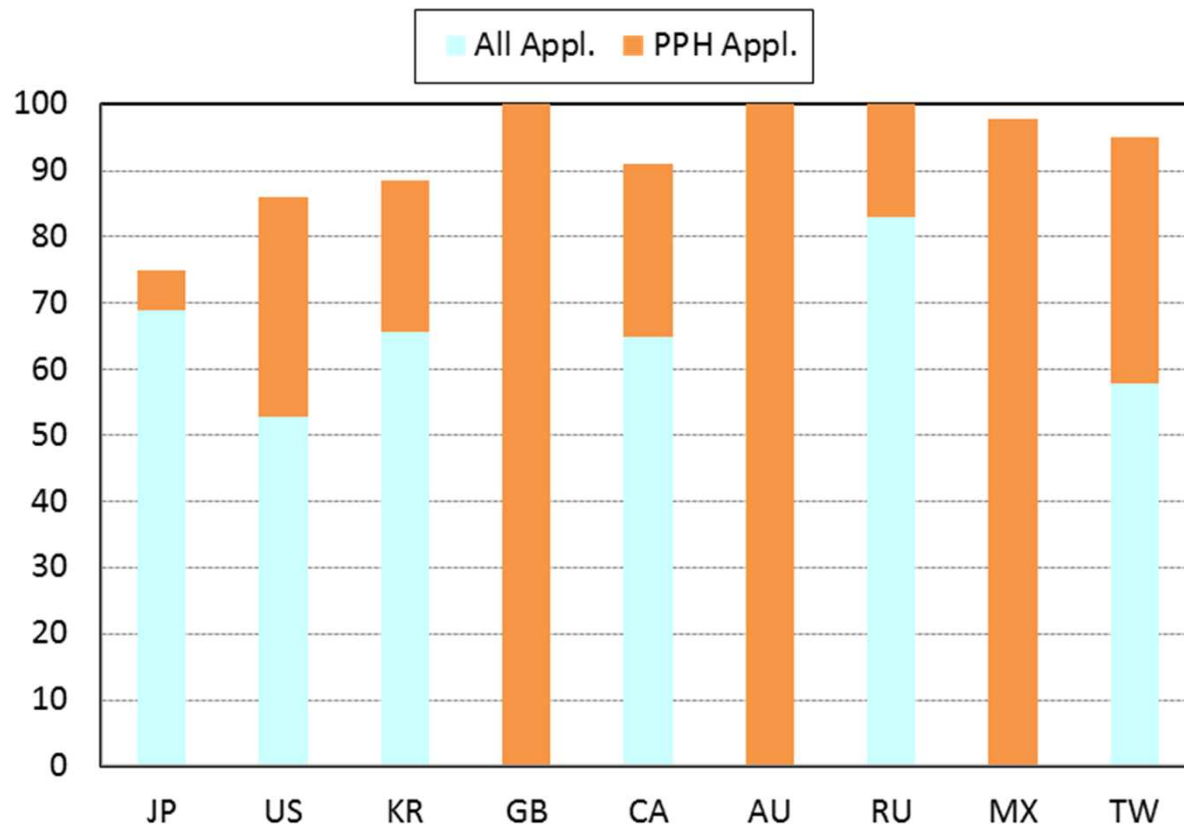


Decrease in the number of office actions reduces applicant **costs** (e.g. attorney and translation fees).



Increase in Grant Rate

PPH-Grant Rate



UP!

• PPH applications tend to be granted by the OLE because they were already judged to be patentable by the OEE.

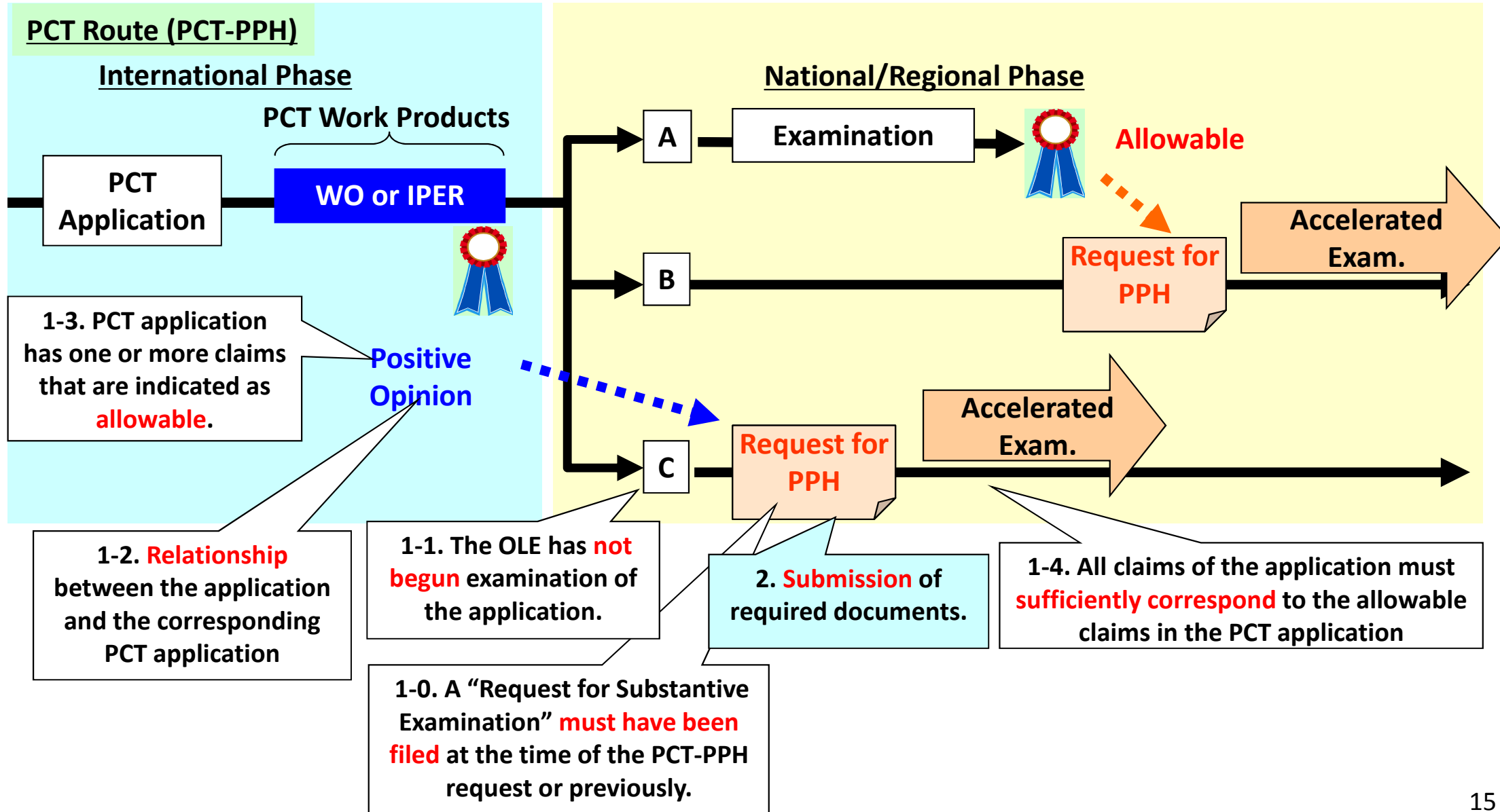
Period: Jan - Jun 2013



Requirements for PCT-PPH request

Requirements	<p>1-0. A “Request for Substantive Examination” must have been filed at the OLE either at the time of the PPH request or previously.</p> <p>1-1. The examination has not begun in the Office of filing.</p> <p>1-2. The application is in particular relationship with the PCT application. Ex.) The application is a national phase application of the corresponding international application.</p> <p>1-3. The application has at least one claim that was indicated by the ISA/IPEA to be allowable.</p> <p>1-4. All the claims in the application sufficiently correspond or are amended to sufficiently correspond to the allowable/patentable claims in PCT applications.</p>
List of Required Documents	<ol style="list-style-type: none">1. A copy of all claims*¹ and its translations2. A copy of the latest international work product*¹ and its translation*¹3. Copies of all cited documents*²4. Claims Correspondence Table <p>*¹ Applicants do not have to submit these documents, if the these documents are available via “PATENTSCOPE (registered trademark)”</p> <p>*² Applicants do not have to submit these documents, if the documents are patent document.</p>

Requirements for PCT-PPH request

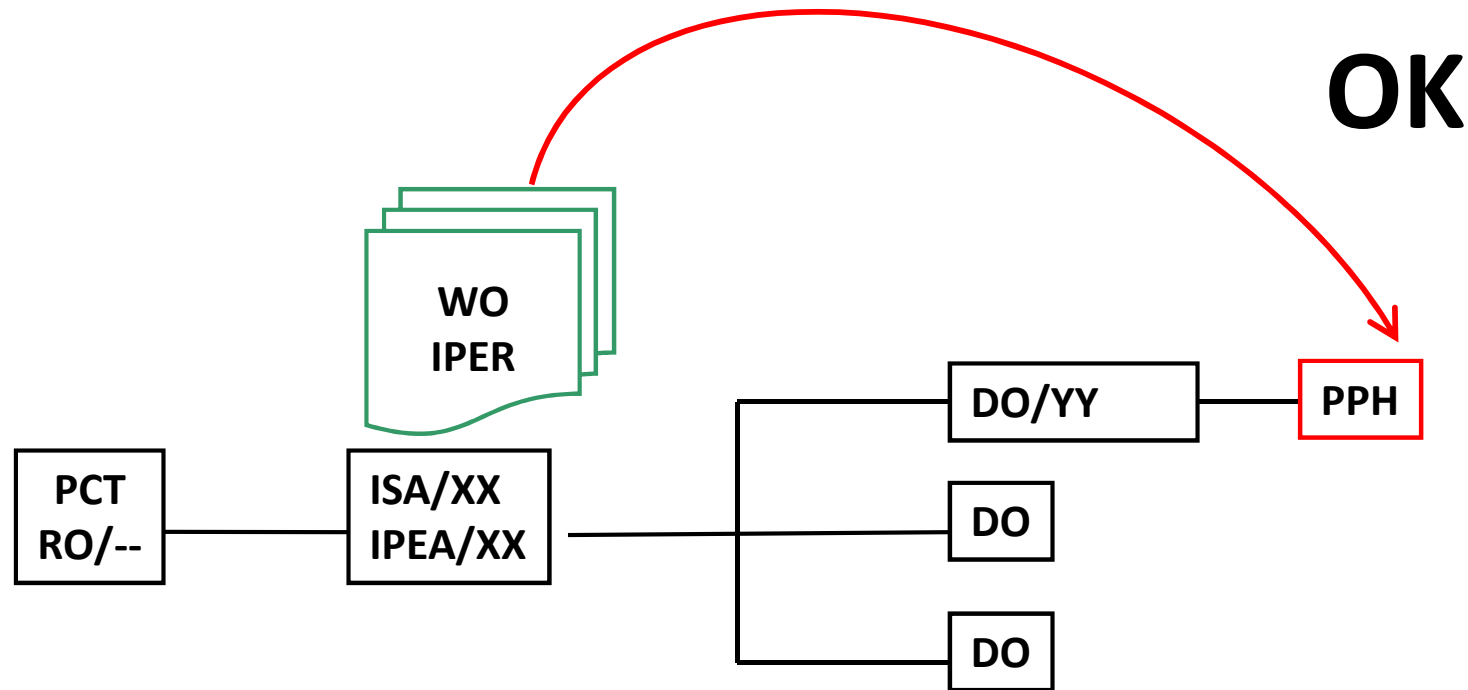


- A “Request for Substantive Examination” must have been filed either at the time of the PCT-PPH request or previously.

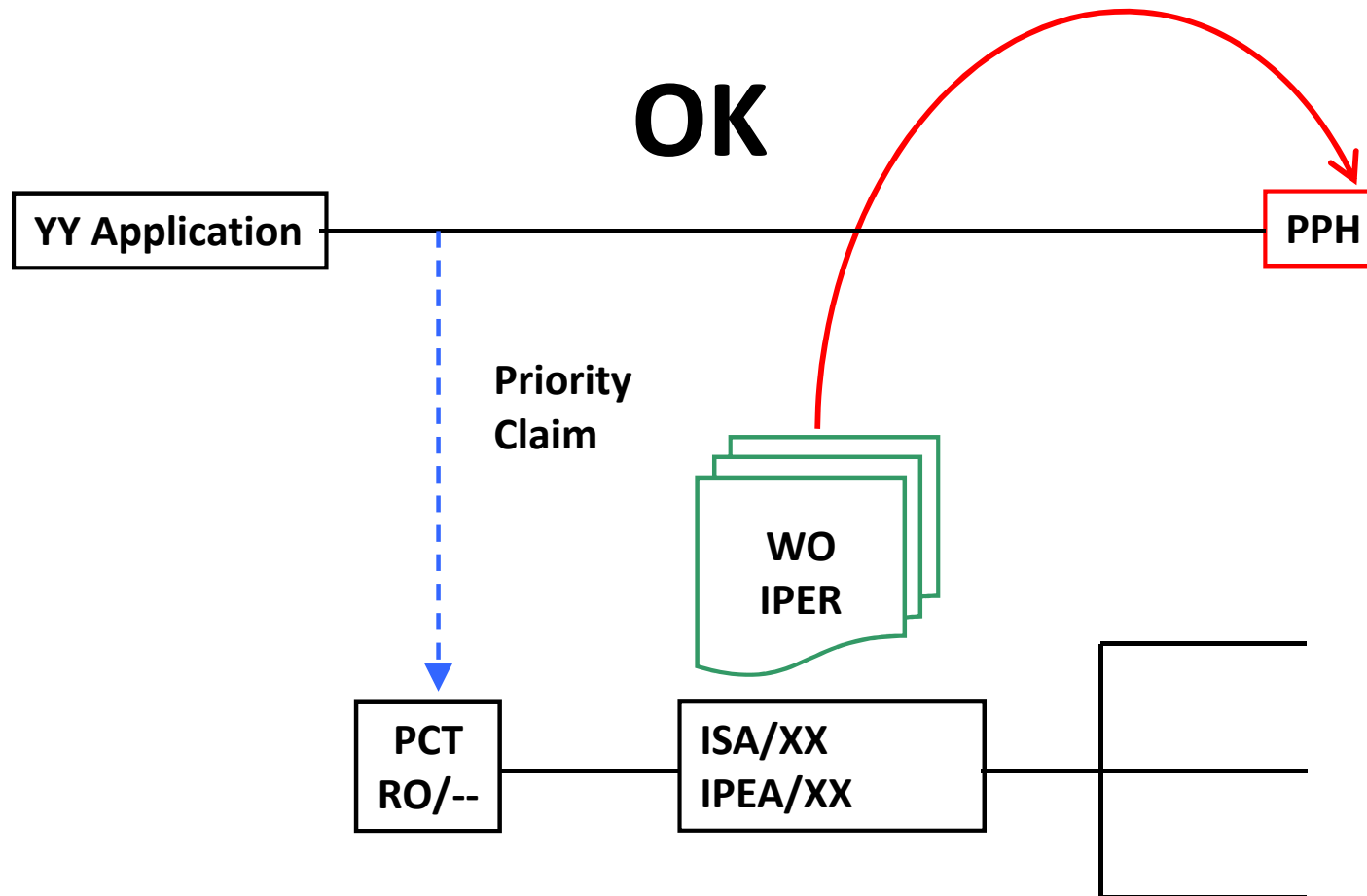
- **Substantive examination of the application for which PPH is requested must not have begun.**

- **The application should be in a particular relationship with the PCT application.**
- **Generally, the particular relationship is as follows:
(see next slide)**

The application is a national phase application of the corresponding international application.



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



Claims that are indicated as having novelty, inventive step and industrial applicability in the latest international work product, namely;

- **Written Opinion of the International Searching Authority (WO/ISA)**
- **Written Opinion of the International Preliminary Examining Authority (WO/IPEA) or**
- **International Preliminary Examination Report (IPER).**

Example of a Positive Opinion (PCT/ISA/237)

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2013/999999

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-7	YES
	Claims		NO
Inventive step (IS)	Claims	1-7	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-7	YES
	Claims		NO

2. Citations and explanations:

D1: JP 2010-987654 A (PCT SYSTEM CORP)
2010.10.07, paragraphs [0026]-[0030]
& US 6543210 A, column 5, lines 5-30

D2: JP 2009-111111 A (INDUSTRIAL PROPERTY INC)
2009.09.28, Claim 1, Figure 1
& WO 2007/222222 A1

D3: JP 4321567 B2 (PATEMARU COMPANY)
2006.02.20, the whole document
(Family: none)

The subject matters of claim 1-7 are neither disclosed in any of the documents cited in the ISR nor obvious to a person skilled in the art. None of the prior art documents cited in the ISR describes [...A...], and it was not obvious for the person skilled in the art to employ that the technical feature [...A...], which presents advantageous effects in that [...B...].

Claim 1-7 are indicated as having novelty, inventive step and industrial applicability

All claims on file for examination under the PPH must “sufficiently correspond” to one or more of those claims determined to be allowable/patentable in the latest international work product of the corresponding PCT application.

Claims are considered to “sufficiently correspond” where,

- (1) accounting for differences due to translations and claim format, the claims of the application are of the **same or similar** scope as the claims determined as patentable/allowable in the latest international work product, or
- (2) the claims of the application are **narrower** in scope than the claims determined as patentable/allowable in the latest international work product

A claim which introduces a new/different category of claims to those claims determined as patentable/allowable in the latest international work product is NOT considered to sufficiently correspond. (e.g. product claim vs. process claim)

2. Required documents(1)

The following documents are required to submit along with a PCT-PPH request form.

- (1) A **copy of the claims**^{*1} from the corresponding PCT application which are indicated as patentable/allowable, and a **translation** thereof if they are not in English

- (2) **WO/ISA, WO/IPEA or IPER**^{*1} which forms the basis for the PCT-PPH request and a **translation**^{*1} thereof if there are not in English

^{*1} Applicants do not have to submit these documents, if the these documents are available via “PATENTSCOPE (registered trademark)”

2. Required documents(2)

(3) Documents cited by the OEE examiner.

- * If a cited document is a patent document, the applicant does not have to submit it. In case the OLE has difficulty in obtaining the document, however, the applicant may be asked to submit it. If a cited document is non-patent literature, the applicant always has to submit it. Translations of cited documents are unnecessary.

(4) A claims correspondence table

The claim filed to the OLE	The patentable claim in the international phase	Comments about the correspondence
1	1	Both claims are the same.
2	2	Both claims are the same except the claim format.
3	1	Claim 3 in the OLE application adds composition A to claim 1 filed at the OEE.



Copies of latest international work product and translations of them



Copies of all claims and translations of them

No need to submit these documents, if they are available via “PATENTSCOPE” (registered trademark)



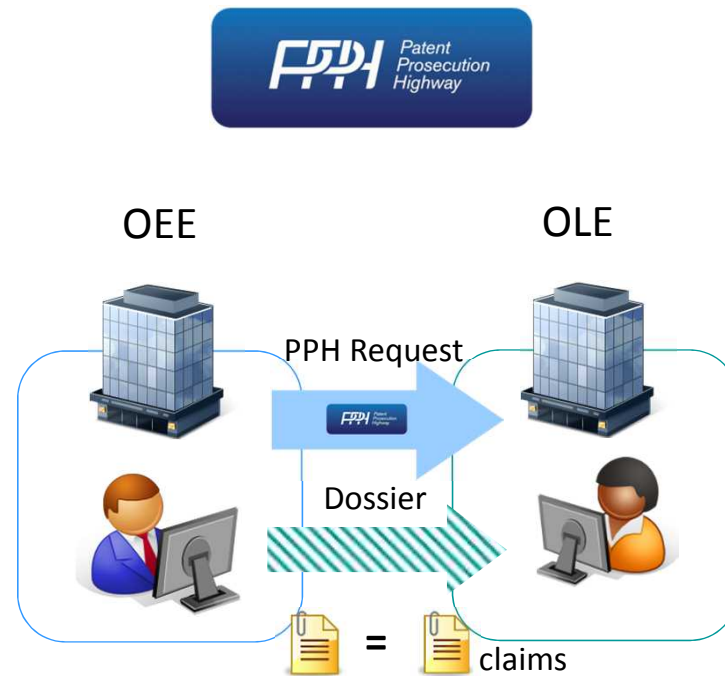
Copies of references



Claim correspondence table

No need to submit the copies of references , if they are patent document.

How to examine PCT-PPH application?



PCT-PPH request form

Subject: Request for an accelerated examination under the PCT-PPH pilot program

Date of filing: **Date of filing PCT-PPH request**

Application number: **Application number of OLE application**

Title of the invention:

Applicant:

Corresponding PCT international application number:

Corresponding PCT international application number

Documents submitted:

A copy of the latest **international work product** which indicated the claims to be patentable/allowable and

their **OLE language** or English translations if they are not in English

A copy of a set of **claims** which the latest international work product of the corresponding international application indicated to be patentable/allowable and

their **OLE language** or English translations if they are not in English

A copy of **references** cited in the latest international work product of the international application corresponding to the application

A **claims correspondence table** which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable

Claim correspondence table

The claim in the OLE	The patentable claim in the international phase	Comments about the correspondence
1	1	Both claims are the same.
2	2	Both claims are the same.
3	3	Both claims are the same except the claim format.

(Documents to be omitted to submit)

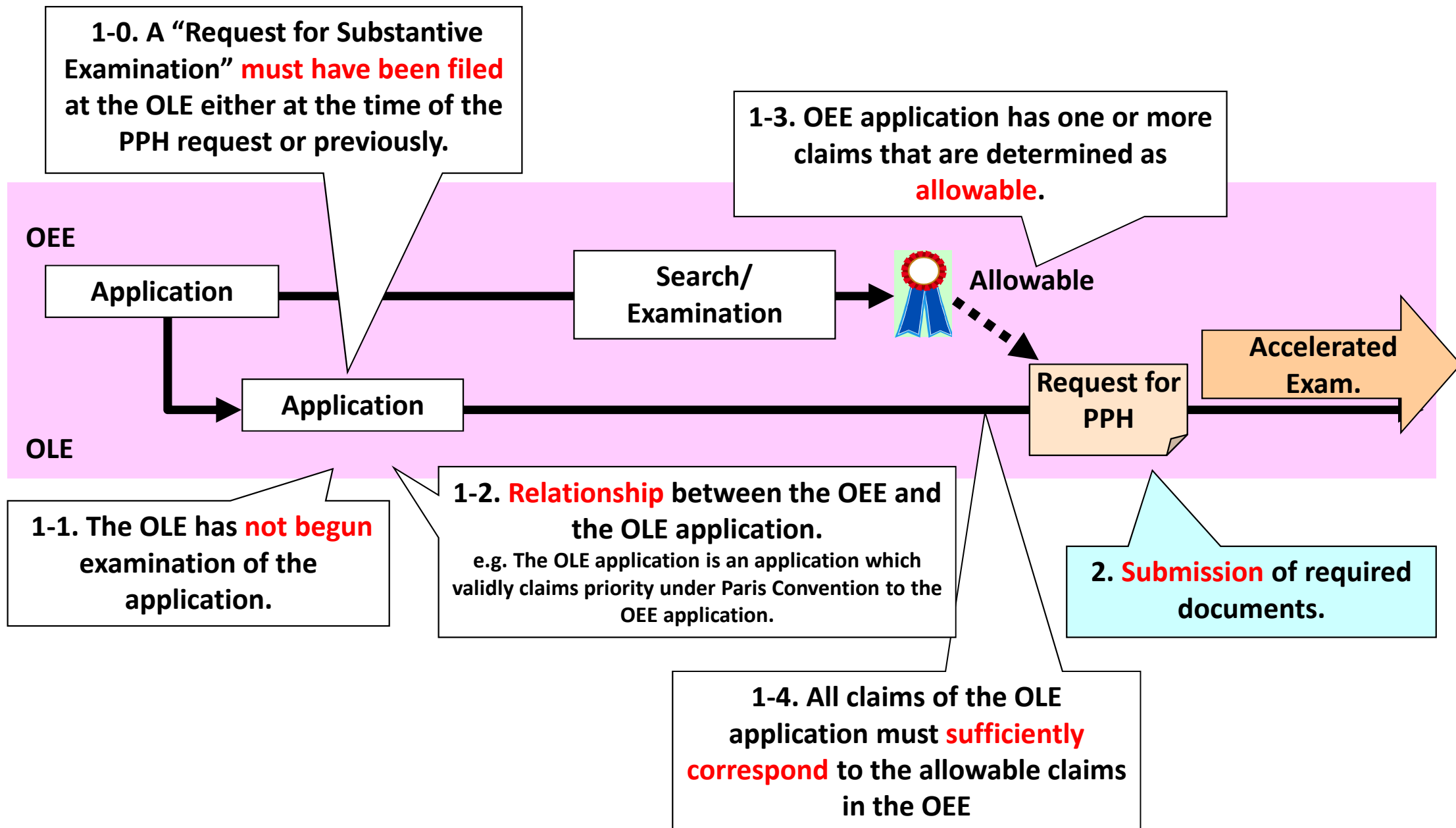
Requirements and Required Documents

- PPH



<p>Requirements</p>	<p>1-0. A “Request for Substantive Examination” must have been filed at the OLE either at the time of the PPH request or previously.</p> <p>1-1. The examination has not begun in the OLE.</p> <p>1-2. The OLE application is in particular relationship with the OEE application.</p> <p>Ex.) The OLE application is an application which validly claims priority under Paris Convention to the OEE application.</p> <p>1-3. OEE application has at least one claim that was determined by the OEE to be allowable.</p> <p>1-4. All the claims in OLE application sufficiently correspond or are amended to sufficiently correspond to the allowable/patentable claims in OEE applications.</p>
<p>List of Required Documents</p>	<p>2-1. A copy of all claims and its translations*1</p> <p>2-2. A copy of the OEE office actions and its translation*1</p> <p>2-3. Copies of all cited documents*2</p> <p>2-4. Claims Correspondence Table</p> <p>*1 Applicants do not have to submit these documents, if the OLE can obtain these documents by Dossier Access System (AIPN).</p> <p>*2 Applicants do not have to submit these documents, if the documents are patent document.</p>
<p>PPH petition fee</p>	<p>Free in most offices.</p>

Requirements for PPH request



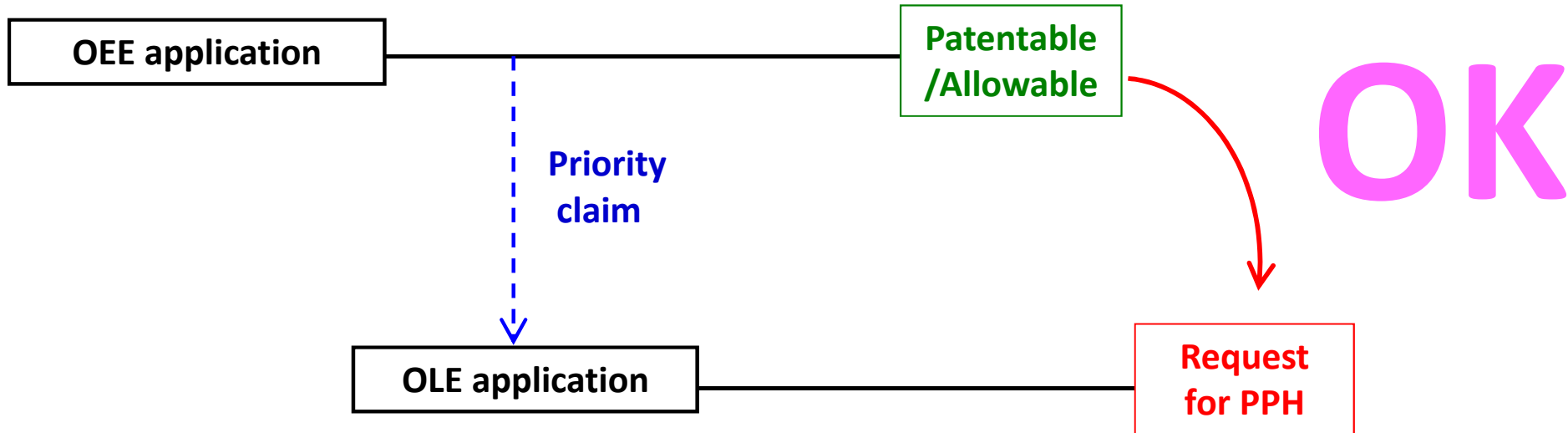
- A “Request for Substantive Examination” must have been filed at the OLE either at the time of the PPH request or previously.

- **Substantive examination of the application for which PPH is requested must not have begun.**

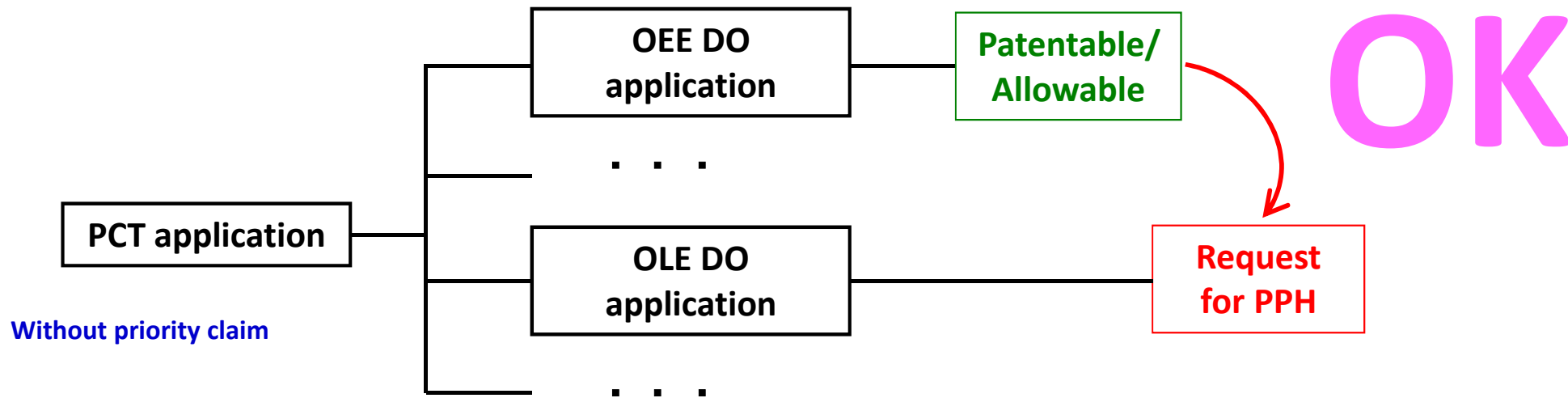
- **The OLE application should be in a particular relationship with the OEE application.**
- **Generally, the particular relationship is as follows.**
- **The OLE application is:**

(see next slide)

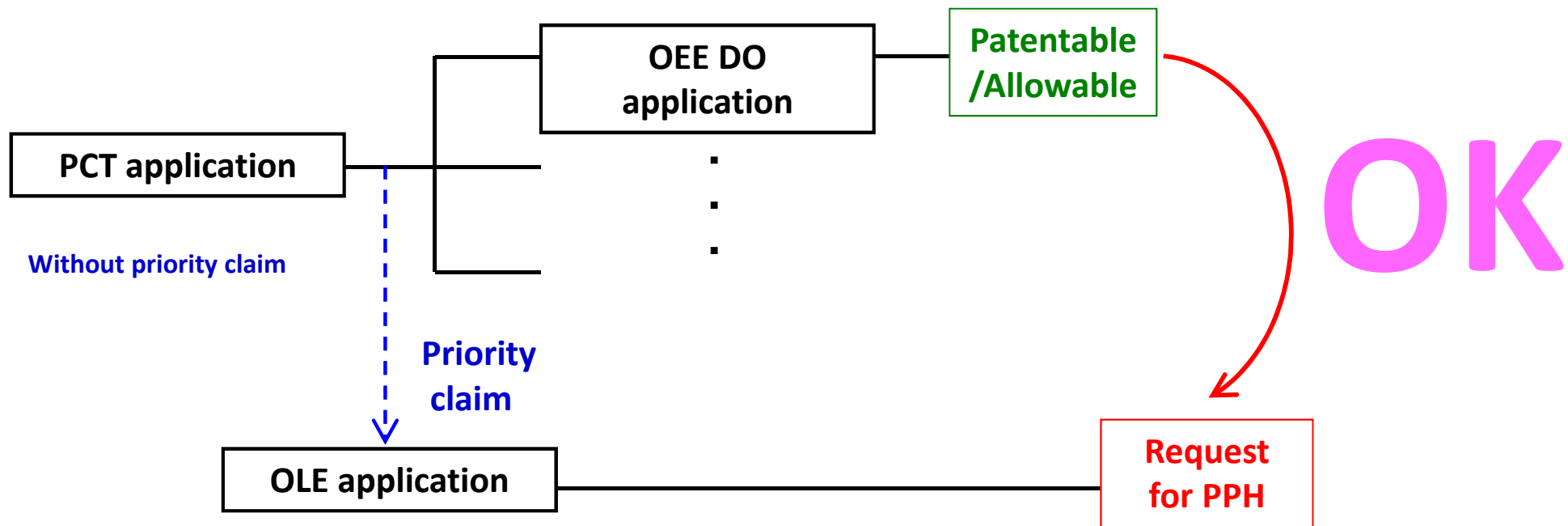
(1)an application which validly claims priority under the Paris Convention to the corresponding OEE application(s),



(2) a PCT national phase application without priority claim
(direct PCT application),



(3)an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim.



- At least one corresponding application must exist in the OEE and must have one or more claims that are determined to be **patentable/allowable** in the latest office action by the OEE.

- **The office action should not always have to be the “Decision to grant a patent” . For example, the office action of the OEE includes:**
 - (1) Decision to grant a patent**
 - (2) Notification of reason for refusal**
 - (3) Decision of refusal**
 - (4) Appeal decision**

1-4. Claims sufficiently correspond

All claims on file for examination under the PPH must “sufficiently correspond” to one or more of those claims determined to be allowable/patentable in the latest office action of the corresponding application.

Claims are considered to “sufficiently correspond” where,

- (1) accounting for differences due to translations and claim format, the claims of the application are of the **same or similar** scope as the claims determined as patentable/allowable in the latest office action, or
- (2) the claims of the application are **narrower** in scope than the claims determined as patentable/allowable in the latest office action

A claim which introduces a new/different category of claims to those claims determined as patentable/allowable in the latest office action is NOT considered to sufficiently correspond.
(e.g. product claim vs. process claim)

2. Required documents(1)

- The following documents are required to submit along with a PPH request form.

(1)A copy of all claims determined to be allowable by the OEE, and their translations.

*The applicant does not have to submit the copy if they are available via the OEE dossier access system.

(2)A copy of all office actions of the OEE, and their translations.

*The applicant does not have to submit the copy if they are available via the OEE dossier access system.

(see next slide)

2. Required documents(2)

(3) Documents cited by the OEE examiner.

- * If a cited document is a patent document, the applicant does not have to submit it. In case the OLE has difficulty in obtaining the document, however, the applicant may be asked to submit it. If a cited document is non-patent literature, the applicant always has to submit it. Translations of cited documents are unnecessary.

(4) A claims correspondence table

The claim filed to the OLE	The claim determined to be allowable in the OEE	Comments about the correspondence
1	1	Both claims are the same.
2	2	Both claims are the same except the claim format.
3	1	Claim 3 in the OLE application adds composition A to claim 1 filed at the OEE.



Copies of all OEE office action and translation of them



Copies of all claims and translation of them

No need to submit these documents, if they are available via the OEE's dossier access system.



Copies of references



Claim correspondence table

No need to submit the copies of references , if they are patent document.

How to examine PPH application?



- **Corresponding OEE application is Granted by the OEE examiner**
Claim 1-3 are determined to be patentable/allowable by the OEE examiner

PPH request form

Subject: Request for an accelerated examination under the PPH pilot program

Date of filing: **Date of filing PPH request**

Application number: **Application number of OLE application**

Title of the invention: _____

Applicant: _____

Corresponding JPO Application number: _____

Documents submitted:

- Copies of all **office actions** (which are relevant to substantial examination for patentability in the JPO) which were issued for the corresponding application by the JPO and
- translations of them
- Copies of all **claims** determined to be patentable/allowable by the JPO and
- translations of them
- Copies of **references** cited by the JPO examiner
- Claim correspondence table**

Corresponding OEE application number

Claim correspondence table

The claim in the OLE	The patentable claim in the OEE	Comments about the correspondence
1	1	Both claims are the same.
2	2	Both claims are the same.
3	3	Both claims are the same except the claim format.

(Documents to be omitted to submit)

Copy and translation of Notification of Reasons for Refusal in the OEE

Copy and translation of grant in the OEE

Copy and translation of the claims indicated patentable in the OEE

Cited reference of the corresponding OEE application: Japan

Publication of application 0000000

- The AIPN is the Web based Service **only for Examiners** in the Foreign IP Offices.
- The AIPN provides **Dossier Information** and **Legal status** of applications examined by JPO.
- Almost all Information is translated into English by **Japanese-English Machine Translation**.
- The AIPN is the Useful Tool for **Utilizing Examination Results done by JPO**.

The AIPN started on 12 October 2004, now it is used more than **60 IPOs** all over the world.



<http://www.jpo.go.jp/ppph-portal/>

Patent Prosecution Highway
Portal Site

Top Booklet	About PPH Statistics	PPH MOTTAINAI Access to Dossier	★ Procedures Events
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Procedures

All PPH Procedure Information

Patent Prosecution Highway
Portal Site

Top Booklet	About PPH Statistics	PPH MOTTAINAI Access to Dossier	★ Procedures Events
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Statistics

PPH Statistics

OFF/OEE/ISA or IPEA

	JP	US	KR	GB
JP	→	→	→	→
US	→	→	→	→
KR	→	→	→	→
GB	→	→	→	→
CA	→	→	→	→
DE	→	→	→	→
AU	→	→	→	→
DK	→	→	→	→
EP	→	→	→	→
SG	→	→	→	→

Latest PPH Information in the world

Number of PPH(using the nation)

	JP	US	KR	GB
JP	5520	1395	24(0)	11
US	1772(44)	627	49(1)	24
KR	202	957	6	
GB	70(4)	294	27	1
CA	4(4)	152	1	0(0)
DE	93	80	19	0
AU	-	153	-	-
DK	10	107	4	-
EP	110(55)	281	-	-
SG	0	2	-	-
FI	6	26	0	-
RU	3(0)	10	0	-
AT	1	1	-	-
HU	2	3	-	-
ES	0	0	0	-

Patent Prosecution Highway
Portal Site

Top Booklet	About PPH Statistics	PPH MOTTAINAI Access to Dossier	★ Procedures Events
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Expanding PPH Network

As of 1st of November, 2012

Legend:
 - PPH (red line)
 - PPH MOTTAINAI (green line)
 - PCT-PPH (blue line)

Notification

1 November 2012	New PPH(CIPO→ILPO) Program commenced
15 October 2012	New PPH(NBPR→ILPO), New PCT-PPH(NBPR→ILPO) Program commenced
1 October 2012	New PPH(USPTO→IPO-CZ) Program commenced

Thank you !