

Procedures to file a request to the SPTO for Patent Prosecution Highway Pilot Program between the SPTO (Spanish Patent and Trademark Office) and the JPO (Japan Patent Office)

Part I- PPH using national work products from the JPO

Request to the SPTO

[0001] An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to the SPTO by submitting an application requesting accelerated examination under the PPH accompanied by the relevant supporting documents. The requirements for an application to the SPTO for accelerated examination under the PPH are given in the following sections. Relevant supporting documentation is discussed in a later section (paragraphs [0003] to [0005]) as is the general SPTO application procedure envisaged at this time (paragraph [0006]).

Requirements for requesting an accelerated examination under the PPH Pilot Program at the SPTO

[0002] The requirements for requesting accelerated examination under the PPH pilot program at the SPTO are:

- (a) *Both the SPTO application on which PPH is requested and the JPO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).***

For example, the SPTO application (including PCT national phase application) may be either:

- (Case I) an application which validly claims priority under the Paris Convention from the JPO application(s) (examples are provided in ANNEX I, Figure A, B, C, and D), or
- (Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the JPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figure E, F and G), or
- (Case III) an application which shares a common priority document with the JPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figure H, I, J, K and L), or
- (Case IV) a PCT national phase application where both the SPTO application and the JPO application(s) are derived from a common PCT international application having no priority claim

(an example is provided in ANNEX I, Figure M).

(b) At least one corresponding application exists in the JPO and has one or more claims that are determined to be patentable/allowable by the JPO.

(c) All claims on file, as originally filed or as amended for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the JPO.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the SPTO are of the same or similar scope as the claims in the JPO, or the claims in the SPTO are narrower in scope than the claims in the JPO.

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

Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in the JPO application.

(d) It is possible to participate in the PPH not only when the SPTO examination has not begun, but also when examination has already begun. But if examination of the application is finished, it is not possible to participate in the PPH.

Required documents for accelerated examination under the PPH Pilot Program at the SPTO

[0003] The following documentation will be needed to support a request for accelerated examination under the PPH pilot program at the SPTO:

a) a copy of all the office actions (which are relevant to the patentability) in the corresponding JPO application(s), and translations of them. Office actions are documents which relate to substantive examination and which were sent to the applicant by the JPO examiner. The applicant can either provide these with the request for acceleration under the PPH or request that the SPTO obtain the documents required through the AIPN system.

Both Spanish and English are acceptable as translation language. Machine translations are 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.

- b) a copy of the claims found to be patentable/allowable by the JPO and translations of them. The applicant can either provide these with the request for acceleration under the PPH or request that the SPTO obtain the documents required through the AIPN system. Both Spanish and English are acceptable as translation language. The indications provided in the requirement [0003](a) above regarding machine translations also apply to this requirement [0003](b).
- c) a complete claim correspondence table showing the relationship between the claims of the SPTO application for accelerated examination under the PPH and the claims of the corresponding JPO application considered patentable/allowable by the JPO. Sufficient correspondence of claims occurs where claims are of the same or similar scope.

The claims correspondence table must indicate how the claims in the SPTO application correspond to the patentable/allowable claims in the JPO application. The claim correspondence table must be written in Spanish or English.

- d) copies of the references cited by the JPO examiner. If the references are patent documents, it will not be necessary to submit these documents, as they will usually be available to the SPTO. If the SPTO does not have access to relevant patent documents, the applicant must submit these documents at the request of the SPTO. Non-patent literature must always be submitted.

[0004] The relevant information is obtained from the applicant by filling out the form for requesting accelerated examination under the PPH Pilot Program (see Annex 3) which is available on the SPTO web site. The relevant supporting documentation should be attached.

[0005] The applicant need not provide further copies of documentation if they have already been submitted to the SPTO through simultaneous or past procedures.

Procedure for accelerated examination under the PPH Pilot Program at the SPTO

[0006] The applicant fills out the form requesting accelerated examination under the PPH Pilot Program available on the SPTO web page and includes all the relevant supporting documents. The PPH Administrator, who will be an SPTO patent examiner, will consider the request. Where all the requirements for accelerated examination under the PPH have not been met, the PPH Administrator will notify the applicant that the application has not been allowed entry on to the PPH and will provide an explanation as to why entry on to the PPH was not possible. The applicant is free to take any possible correcting action necessary and again requesting acceleration under the PPH.

Where all of the requirements for accelerated examination under the PPH have been met, the PPH Administrator will notify the applicant that the application has been allowed entry on to the PPH. The PPH Administrator will notify the relevant examining group that the application has qualified for entry to the PPH and the relevant examiner will then conduct an accelerated examination of the application.

If the request for accelerated examination is not granted, the applicant will be notified that the application will await action in its regular turn.

Part II- PPH using the PCT international work products from the JPO

Request to the SPTO

[0001] An applicant can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the SPTO and satisfies the following requirements under the SPTO-JPO Patent Prosecution Highway Pilot Program based on PCT international work products (PCT-PPH Pilot Program).

The Offices may terminate the PCT-PPH Pilot Program early if the volume of participation exceeds manageable levels, or for any other reason. Notice will be published if the PCT-PPH Pilot Program is terminated.

Requirements for requesting an accelerated examination under the PCT-PPH Pilot Program at the SPTO

[0002] The application which is filed with the SPTO and on which the applicant files a request under the PCT-PPH must satisfy the following requirements:

- a) The latest work product in the international phase of a PCT application corresponding to the application ('international work product'), namely Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Examination Authority (WO/IPEA) or the Preliminary Examination Report (IPER), indicates at least one claim is patentable/allowable.

Note that the ISA and the IPEA which produce the WO/ISA, WO/IPEA and the IPER are limited to the JPO, but if priority is claimed, the priority claim can be referred to an application in any Office (see example A' in Annex II: Application ZZ can be any national application).

The applicant cannot file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation, irrespective of the fact that an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in the PCT-PPH Pilot Program if the applicant does not explain why the claim(s) is/are not subject to the observation. In this regard, however, it will not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation in Box VIII.

- b) the relationship between the application and the corresponding international application satisfies one of the following requirements:
- i) the application is a national phase application of the corresponding international application (see figures A, A' and A'' in Annex 2)
 - ii) the application is a national application as a basis of the priority claim of the corresponding international application (see figure B in Annex 2)
 - iii) the application is a national phase application of an international application claiming priority from the corresponding international application (see figure C in Annex 2).
 - iv) The application is a national application claiming priority from the corresponding international application (See figure D in Annex 2)
 - v) The application is the derivate application (divisional application etc) of the application with satisfies one of the above requirements (i)-(iv) (See figure E in Annex 2).
- c) all claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated to be allowable in the JPO as ISA/IPEA.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the JPO are of the same or similar scope as the claims in the SPTO, or the claims in the JPO are narrower in scope than the claims in the SPTO.

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

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in the latest international work product.

Required documents for accelerated examination under the PCT-PPH Pilot Program at the SPTO

[0003] The following documentation will be needed to support a request for accelerated examination under the PCT-PPH Pilot Program at the SPTO:

- a) a copy of the latest international work product which indicated the claims to be patentable/allowable and their Spanish or English translations if they are not in English.

In case the application satisfies the relationship [0002](b)(i), the applicant need not to submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via 'PATENTSCOPE®', an applicant need not to submit these documents, unless otherwise requested by the SPTO.

(WO/ISA and IPER are usually available as 'IPRP Chapter I' and 'IPRP Chapter II' respectively in 30 months after the priority date).

- b) a copy of the set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their Spanish or English translations if they are not in Spanish.

If the copy of the set of claims which are indicated to be patentable/allowable is available via 'PATENTSCOPE®'¹, e.g. the international Patent Gazette has been published, the applicant need not submit this document unless otherwise requested by the SPTO. Where the set of claims is written in Japanese, the translations thereof must be still provided by the applicant.

- c) a copy of the references cited in the latest international work product of the international application corresponding to the application.

If the reference is a patent document, the applicant is not required to submit it. In case the SPTO has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations cited references are unnecessary.

- d) a complete claim correspondence table showing the relationship between the claims of the SPTO application for accelerated examination under the PCT-PPH and the claims indicated to be patentable/allowable.

When claims are just a literal translation, the applicant can just write down 'they are the same' in the table. When claims are just not a literal translation, it is necessary to explain the sufficient correspondence of each claim based on the criteria [0002](c).

[0004] When an applicant has already submitted the above mentioned documents (a)-(d) to the SPTO through simultaneous or past procedures, the

¹ <http://www.wipo.int/pctdb/en/search-adv.jsp>

applicant may incorporate the documents by reference and is thus not required to attached the documents.

Procedure for accelerated examination under the PCT-PPH Pilot Program at the SPTO

[0005] The applicant fills out the form requesting accelerated examination under the PCT-PPH Pilot Program (see Annex 4) available on the SPTO web page and includes all the relevant supporting documents. The PCT-PPH Administrator, who will be an SPTO patent examiner, will consider the request. Where all the requirements for accelerated examination under the PCT-PPH have not been met, the PCT-PPH Administrator will notify the applicant that the application has not been allowed entry on to the PCT-PPH and will provide an explanation as to why entry on to the PCT-PPH was not possible. The applicant is free to take any possible correcting action necessary and again requesting acceleration under the PCT-PPH.

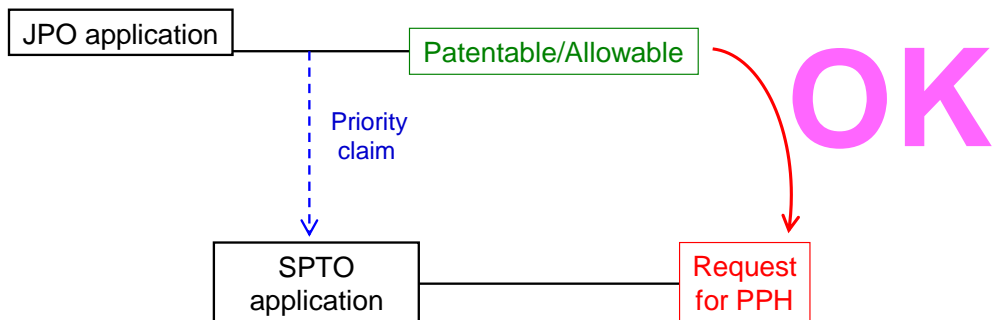
Where all of the requirements for accelerated examination under the PCT-PPH have been met, the PCT-PPH Administrator will notify the applicant that the application has been allowed entry on to the PCT-PPH. The PCT-PPH Administrator will notify the relevant examining group that the application has qualified for entry to the PCT-PPH and the relevant examiner will then conduct an accelerated examination of the application.

If the request for accelerated examination is not granted, the applicant will be notified that the application will await action in its regular turn.

ANNEX 1

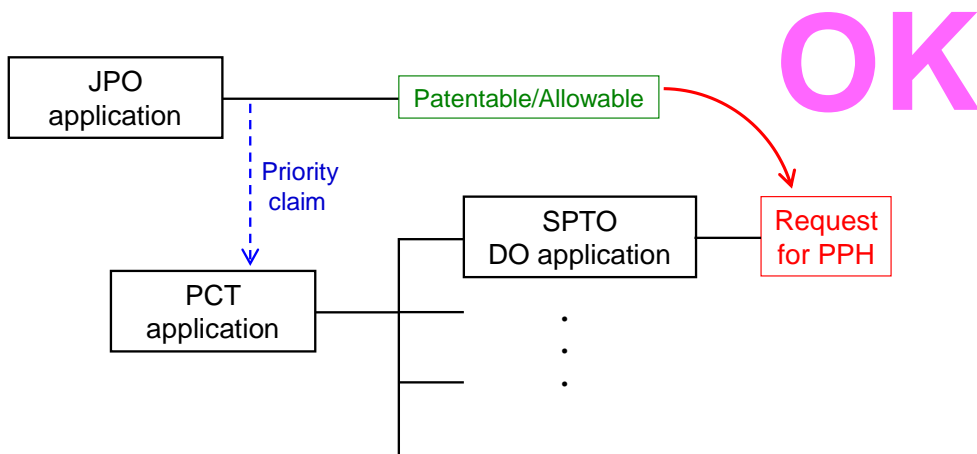
A

(Case I)
- Paris route -



B

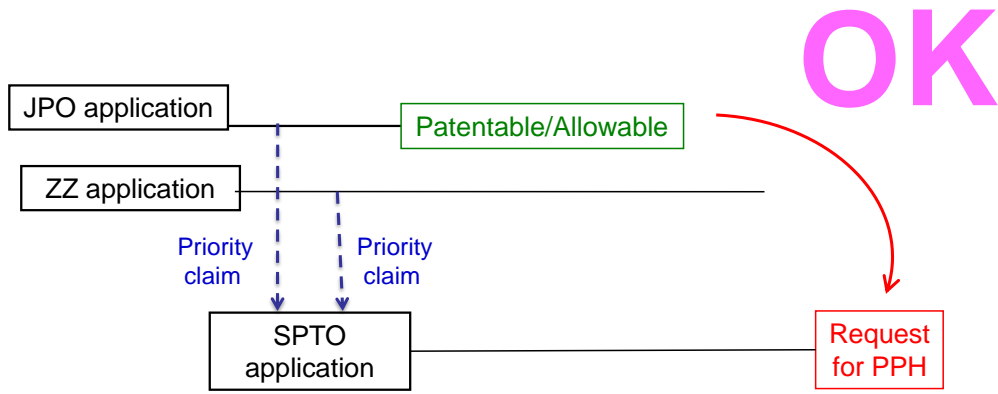
(Case I)
- PCT route -



C

(Case I)

- Paris route and Complex priority -

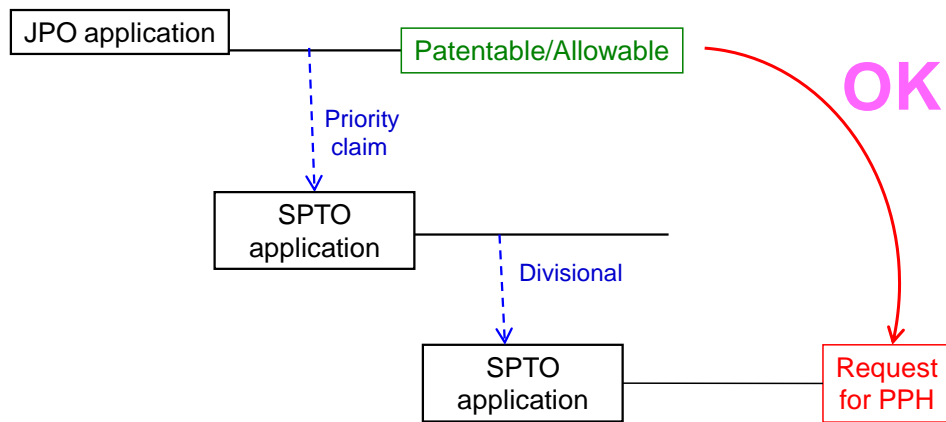


ZZ= Any office

D

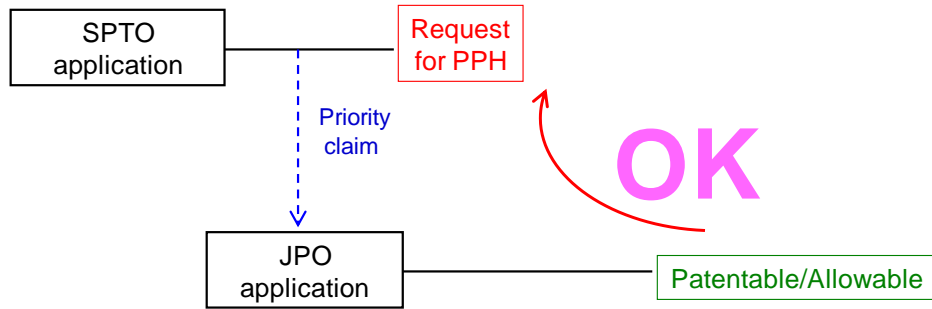
(Case I)

- Paris route & divisional application -



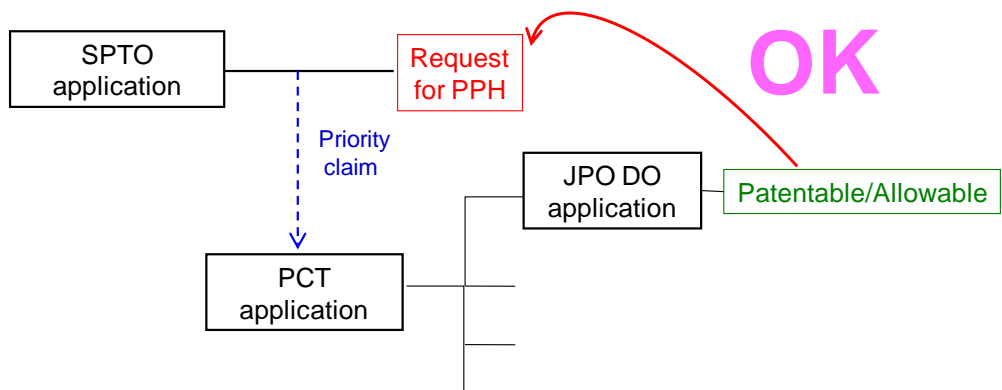
E

(Case II)
- Paris route -



F

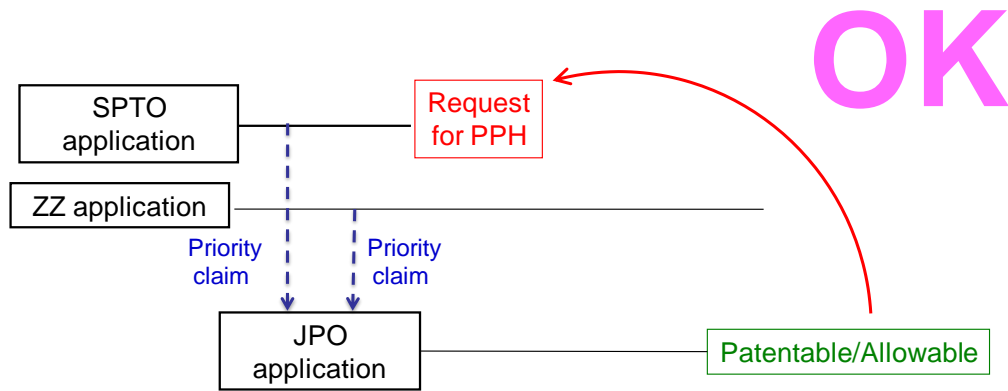
(Case II)
- PCT route -



G

(Case II)

- Paris route and Complex priority -

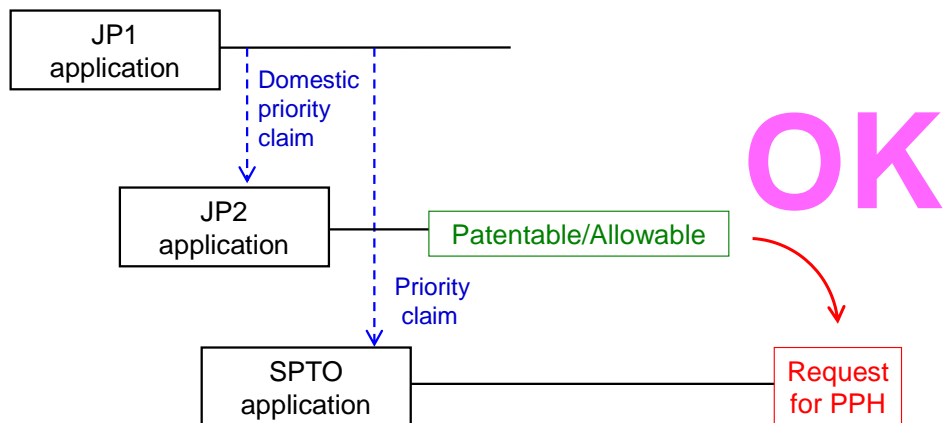


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(Case III)

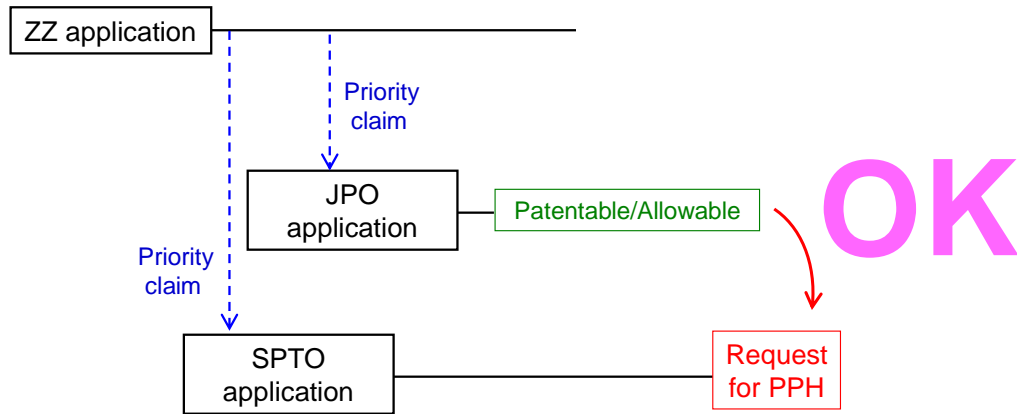
- Paris route, domestic priority -



I

(Case III)

- Paris route, but the first application is from the third country -

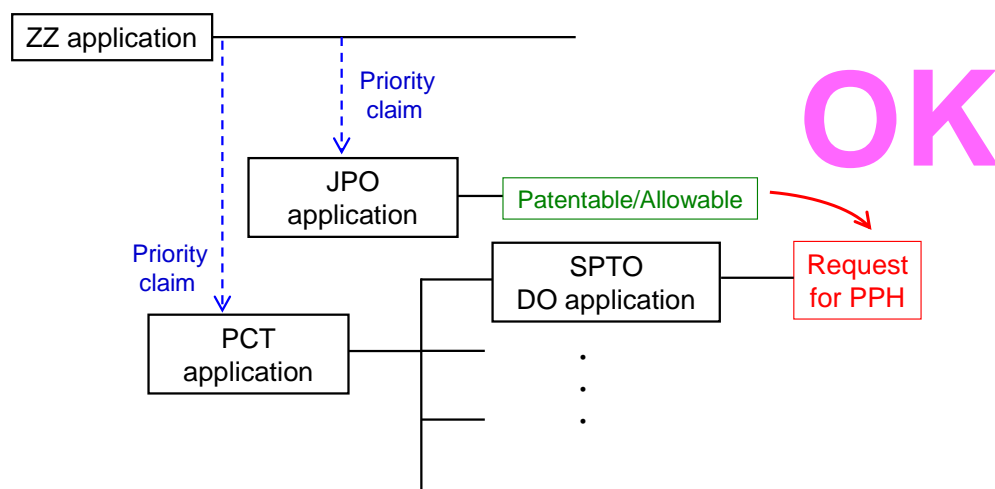


ZZ : the office other than the SPTO and the JPO

J

(Case III)

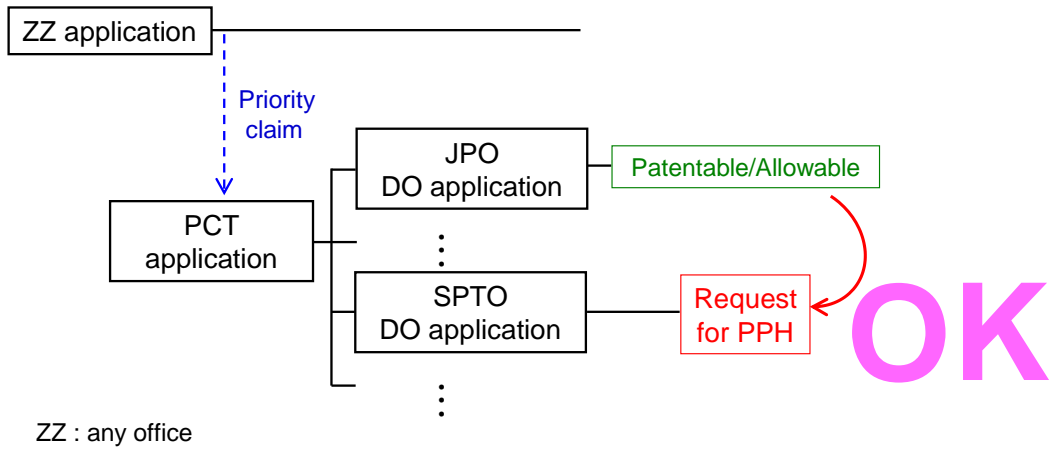
- PCT route, but the first application is from the third country -



ZZ : the office other than the SPTO and the JPO

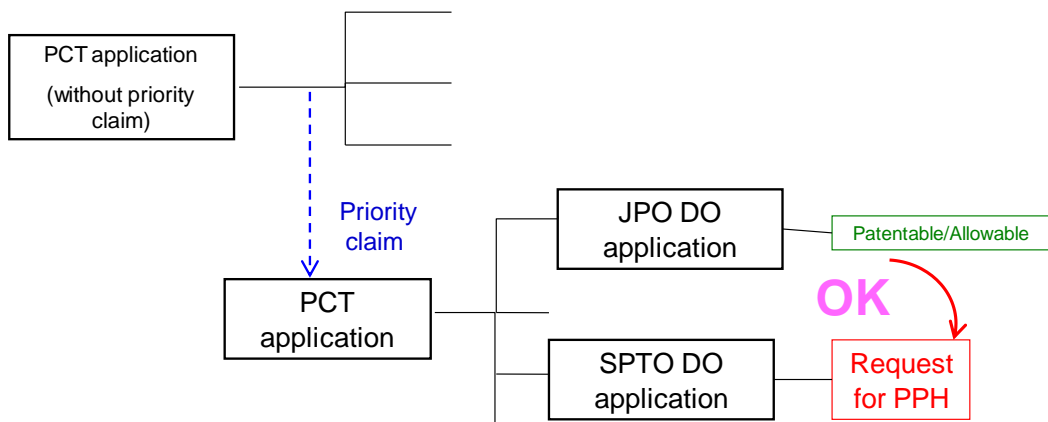
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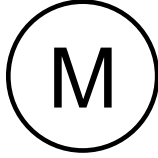
(Case III)
- PCT route -



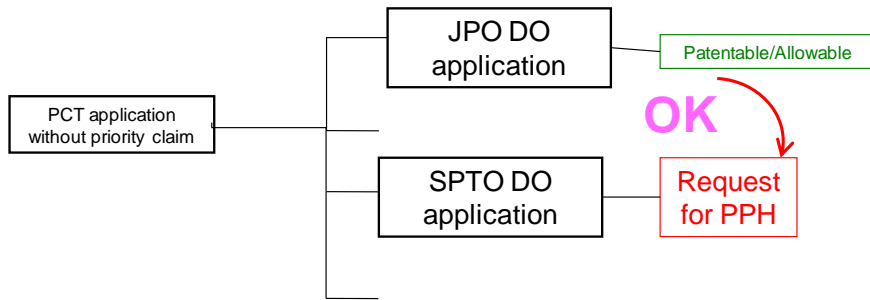
L

(Case III)
- Direct PCT & PCT route-



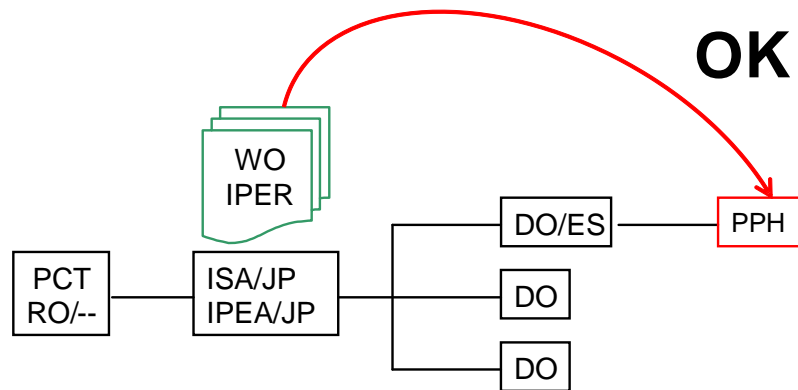


(Case IV)
- Direct PCT route-

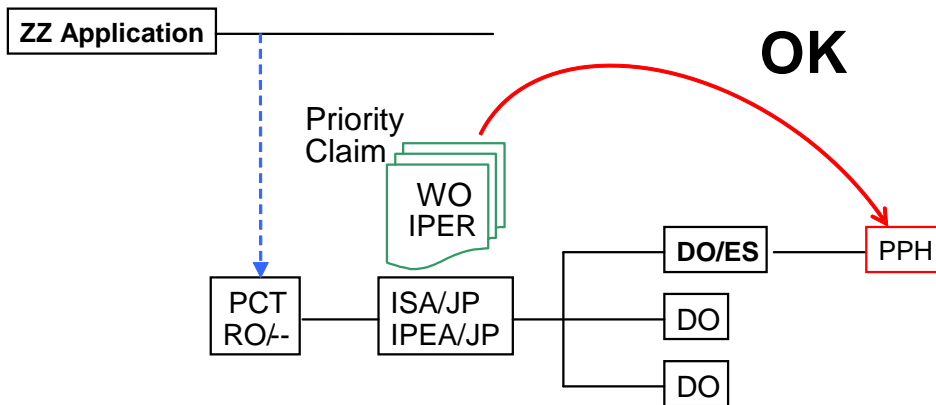


ANNEX 2

(A) The application is a national phase application of the corresponding international application.

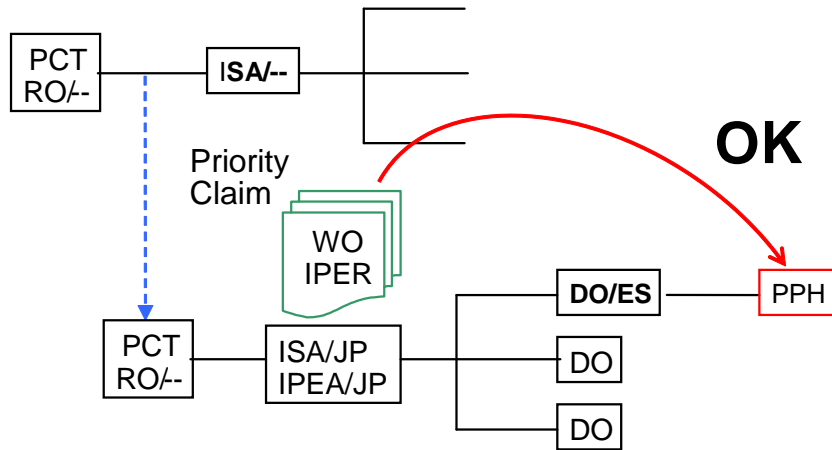


(A') The application is a national phase application of the corresponding international application (The corresponding international application claims priority from a national application.)

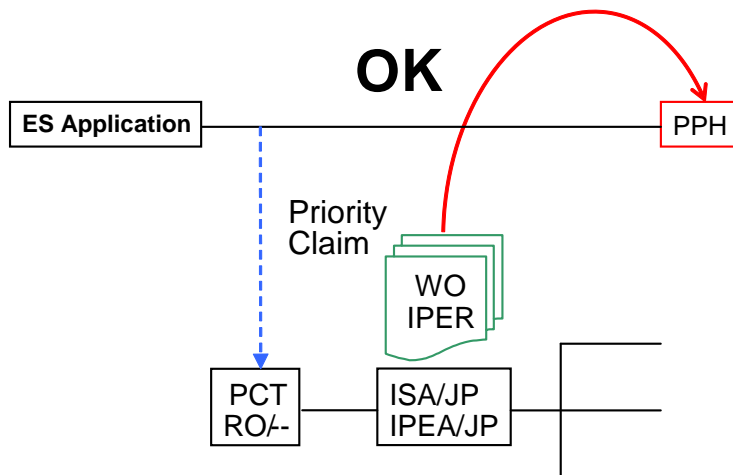


ZZ=any office

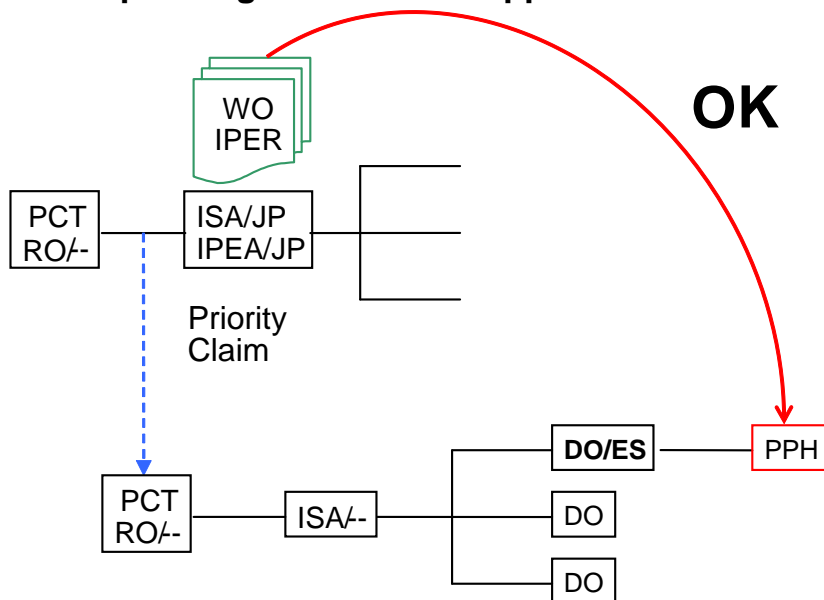
(A'') The application is a national phase application of the corresponding international application
 (The corresponding international application claims priority from an international application.)



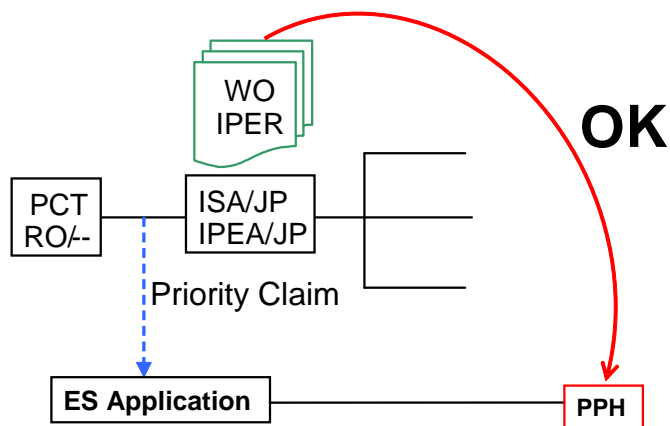
(B) The application is a national application as a basis of the priority claim of the corresponding international application.



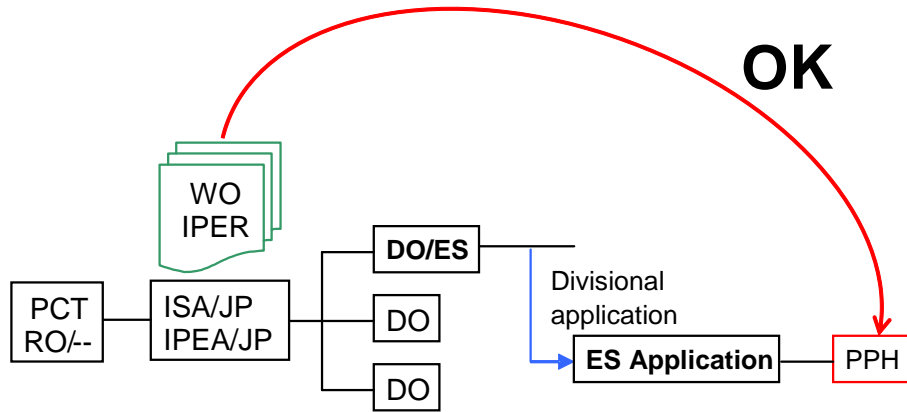
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



(D) The application is a national application claiming priority from the corresponding international application.



(E) The application is a divisional application of an application which satisfies the requirement (A).



ANNEX 3

PPH REQUEST

Request for Accelerated Examination at the Spanish Patent and Trademark Office (SPTO) under the Patent Prosecution Highway Pilot Program. PPH using national work products.

Application information

SPTO application number:

Office of Earlier Examination (hereinafter OEE):

Corresponding OEE application or publication number(s):

Relevant supporting documents

List of Required Documents. Please, tick the boxes below:

1. Either:

1.1. A copy of all the office actions (which are relevant to the patentability) in the above-identified OEE application(s) is attached.

or

1.2. SPTO to obtain the office actions from the OEE data base, where there exists such a data base.

2. Either:

2.1. A copy of all claims which were determined to be patentable/allowable by the OEE in the above-identified OEE application(s) is attached.

or

2.2. SPTO to obtain the set of patentable/allowable claims from the OEE data base, where there exists such a data base.

3. Either:

3.1. Translations into Spanish or English of the documents in 1 and 2 are attached.

or

3.2. SPTO to obtain the translations from the OEE data base, where there exists such a data base.

4. Copies of the documents referred by the OEE Examiner are attached. Patent literature is not necessary to be submitted. Non-patent literature must always be submitted.

□

5. Incorporation by reference. If you want to incorporate any of the above mentioned documents please provide now all the necessary data:

□

.....

Claim correspondence table completed

Claim correspondence table

SPTO claims	Corresponding OEE claims	Comments explaining the correspondence

The applicant does request, if applicable to the circumstances of the present case, the early publication of the patent application according to Article 32(3) Spanish Patent Law.

ANNEX 4

PPH-PCT REQUEST

Request for Accelerated Examination at the Spanish Patent and Trademark Office (SPTO) under the Patent Prosecution Highway-PCT Pilot Program. PPH using the PCT international work products.

Application information

The corresponding PCT application number(s) is/are:

The international date of the corresponding PCT application number(s) is/are:

PPH request for using the PCT international work products from:

JPO USPTO

Relevant supporting documents

List of Required Documents. Please, tick the boxes below:

1. Either:

1.1. A copy of the latest international work product (WO/ISA, WO/IPEA or IPER) in the above-identified PCT application(s) is attached.

or

1.2. SPTO to obtain that document from 'PATENTSCOPE®'.

2. Either:

2.1. A copy of all claims which were determined to be patentable/allowable in the above-identified PCT application(s) is attached.

or

2.2. SPTO to obtain the set of patentable/allowable claims 'PATENTSCOPE®'.

3. Either:

3.1. Translations into Spanish or English of the document in item 1 are attached.

or

3.2. SPTO to obtain the translations from PATENTSCOPE®.

4. Either:

4.1. Translations into Spanish or English of the document in item 2 are attached.

or

4.2. SPTO to obtain the translations from PATENTSCOPE®.

5. Copies of the documents cited in the international work products (ISR, WO/ISA, WO/IPEA or IPER) of the corresponding PCT application are attached. Patent literature is not necessary to be submitted. Non-patent literature must always be submitted.

6. Incorporation by reference. If you want to incorporate any of the above mentioned documents please provide now all the necessary data:

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Claim correspondence table completed

Claim correspondence table

SPTO claims	Corresponding PCT application claims	Comments explaining the correspondence

The applicant does request, if applicable to the circumstances of the present case, the early publication of the patent application according to Article 32(3) Spanish Patent Law.