

Patent Prosecution Highway Pilot Program between the Israel Patent Office (ILPO) and the Japan Patent Office (JPO)

Part I – PPH using national work products from JPO

1. Background

Since March 1, 2012, the ILPO has conducted a Patent Prosecution Highway (PPH) pilot program with the JPO.

In general, this PPH pilot program permitted an applicant who received a determination from one office that at least one claim is allowable/patentable, to request that a corresponding application in another office be accorded special status and advanced out of turn for examination. This PPH pilot program is limited to the utilization of search and examination results of national applications between cross filings under the Paris Convention.

In order to expand the potential of the PPH program, the ILPO and the JPO decided to extend the PPH pilot for another year and to include a new pilot program based on Patent Cooperation Treaty (PCT) work products (PCT-PPH pilot program). The ILPO and the JPO agreed that consistency between PCT-PPH pilot programs should be maintained to the extent possible, to avoid creating burdens on applicants and offices, and to ensure maximum work-sharing potential.

2. Brief Overview

The PPH was established to enable an applicant whose claims are determined to be allowable/patentable in the Office of first filing (OFF) to have the corresponding application filed in the Office of second filing (OSF) advanced out of turn for examination while at the same time allowing the OSF to exploit the search and examination results of the OFF.

Where the ILPO is the OFF and the Israeli application contains claims that are determined to be allowable/patentable, the applicant may request accelerated examination at the JPO for the corresponding application filed with the JPO as the OSF.

The procedures and requirements for filing a request with the JPO for participation in the PPH pilot program have been made available on March 1 2012, from the JPO Web site:

http://www.jpo.go.jp/torikumi_e/t_torikumi_e/japan_israel_highway_e.htm
http://www.jpo.go.jp/torikumi/t_torikumi/souki/pdf/v3souki/guideline.pdf

Where the ILPO is the OSF and the corresponding application filed with the JPO as the OFF contains claims that are determined to be allowable/patentable, the applicant may request participation in the PPH pilot program in the ILPO and request that the Israeli application be advanced out of turn for examination under the PPH pilot program.

The procedures and requirements for filing a request in the ILPO for participation in the PPH pilot program are set forth below.

A. Trial Period for the PPH Pilot Program

The PPH pilot program commenced on March 1, 2012, and will end on February 28, 2013. The Trial Period will be extended for an additional, from March 1, 2013 to February 28, 2014. The trial Period may be extended for an additional year if necessary to adequately assess the feasibility of the PPH program. The JPO and the ILPO will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the Trial Period. The Offices may also terminate the PPH pilot program early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published should the PPH pilot program be terminated before February 28, 2014.

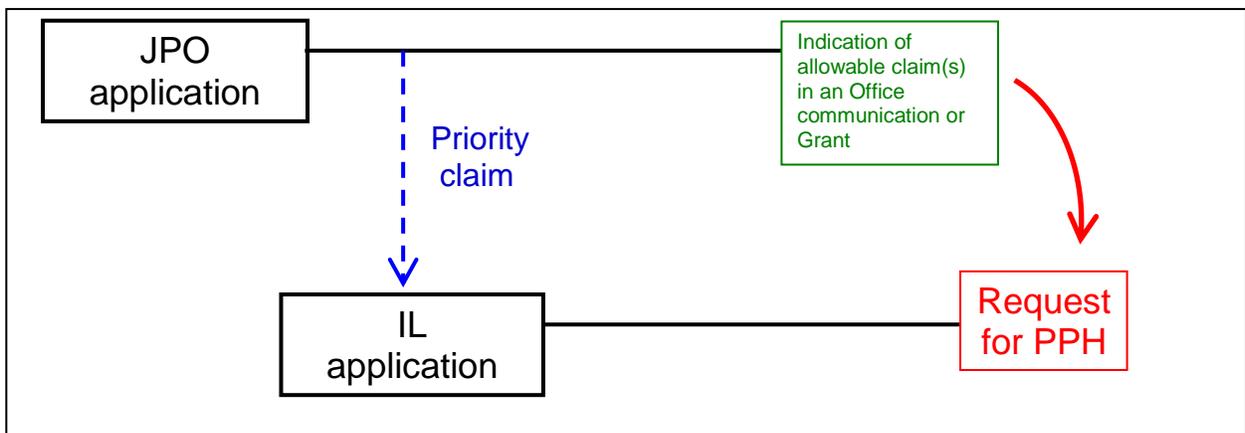
B. Requirements for Requesting Participation in the PPH Pilot Program in the ILPO

In order to be eligible to participate in the PPH pilot program, the following conditions must be met:

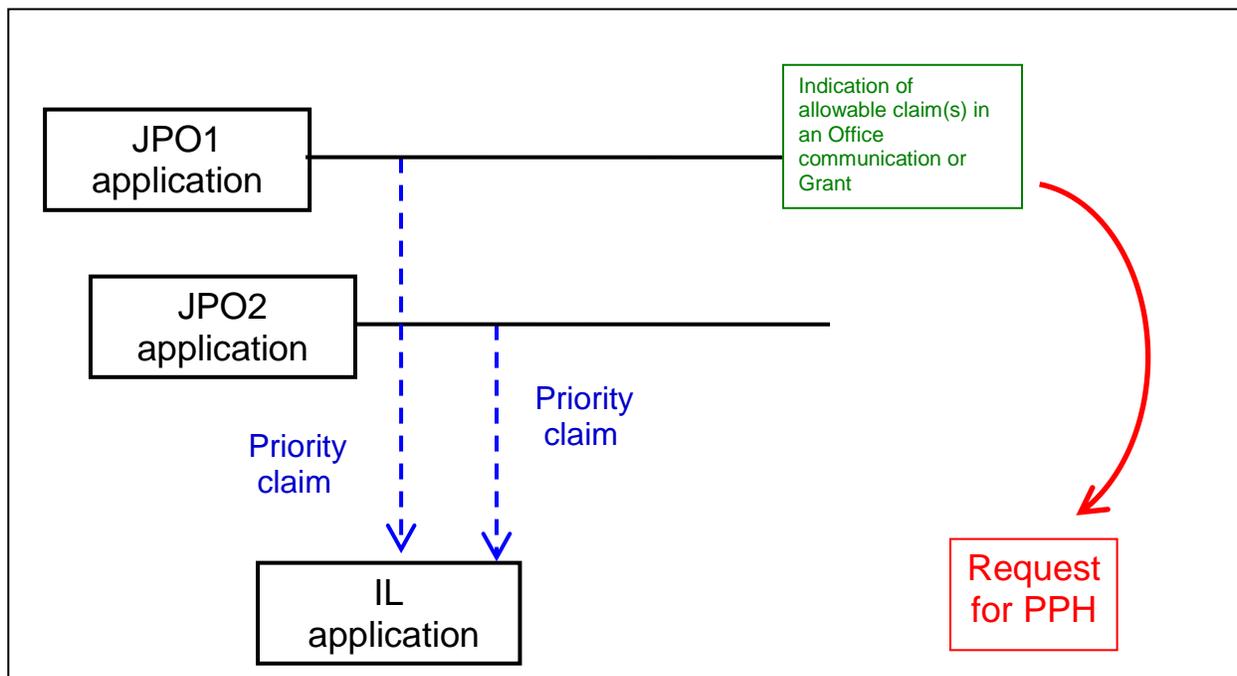
The Israeli (IL) application is a Paris Convention application which validly claims priority under section 10 of the Israeli Patents Law, to one or more applications filed with the JPO.

Examples of Israeli applications that fall under this requirement are:

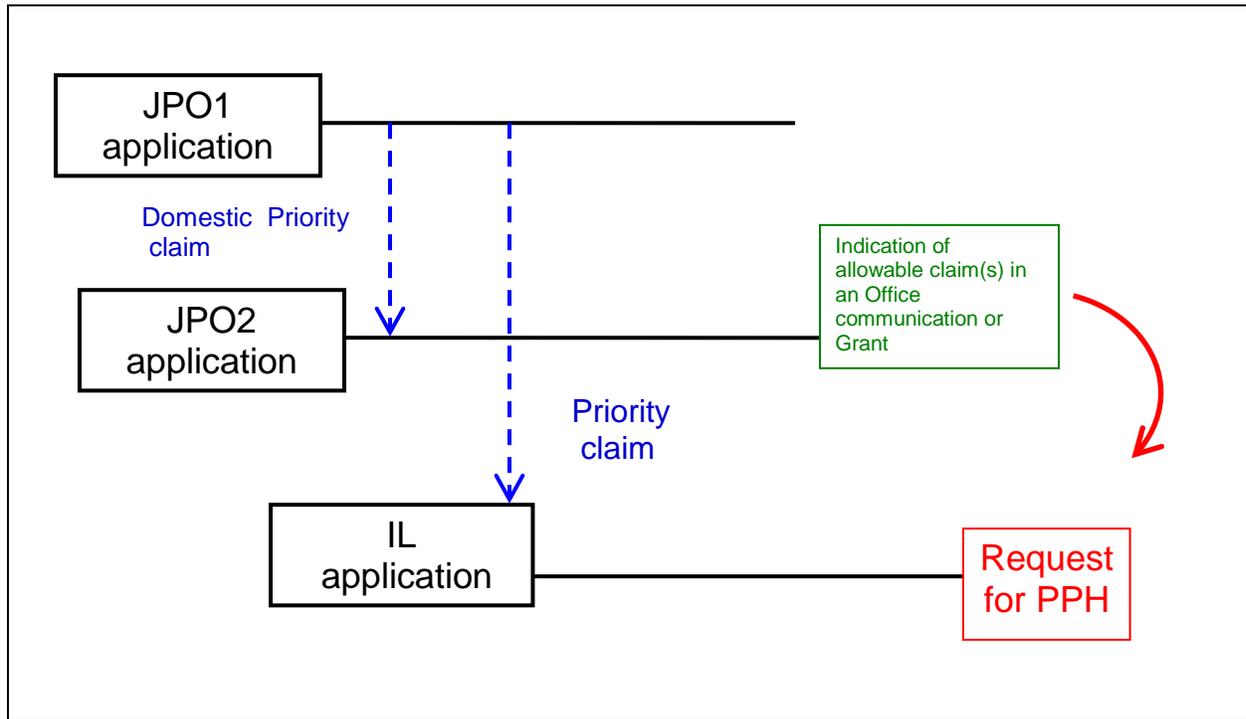
- (A) An IL application with single Paris Convention priority claim to an application filed at the JPO



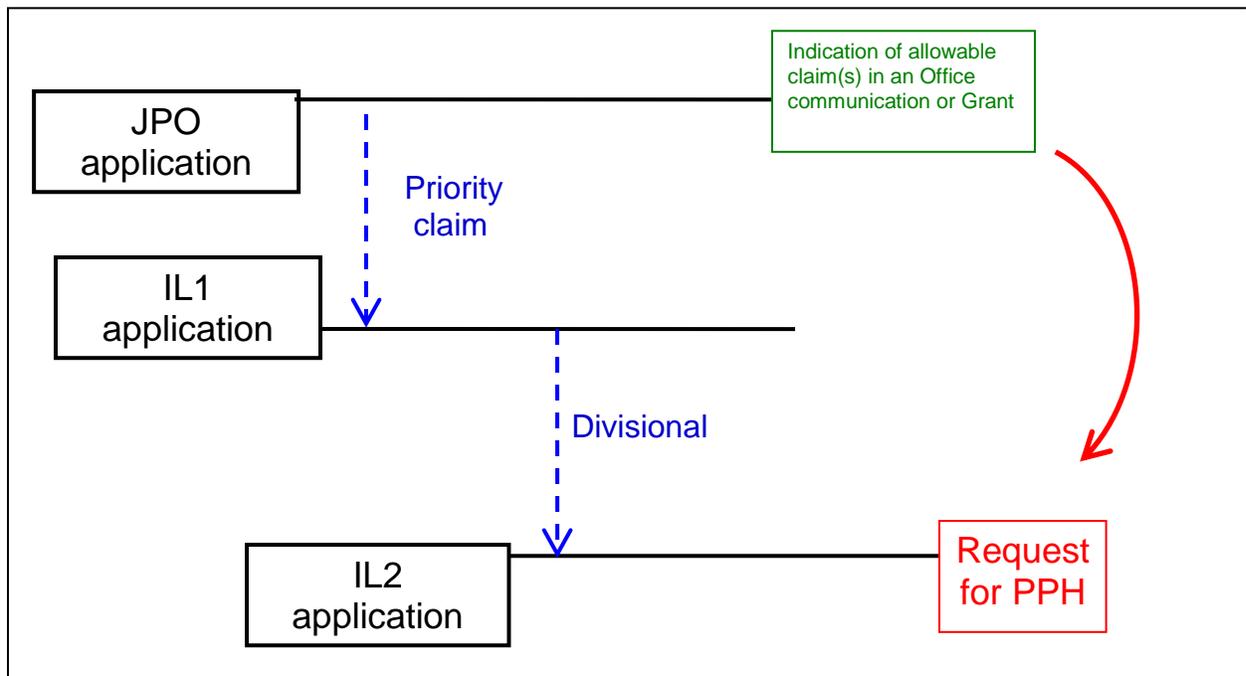
- (B) An IL application with multiple Paris Convention priority claims to JPO Applications



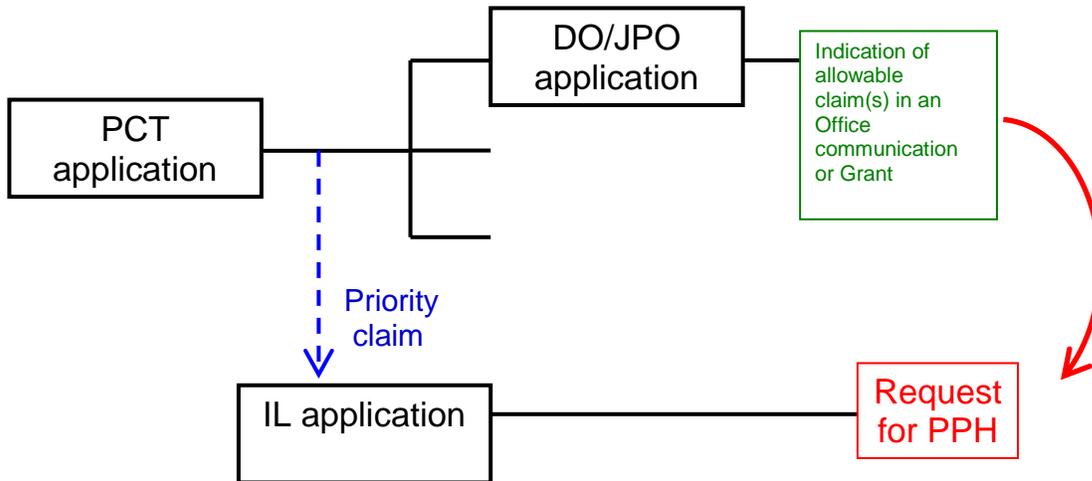
- (C) Paris Convention route and domestic priority



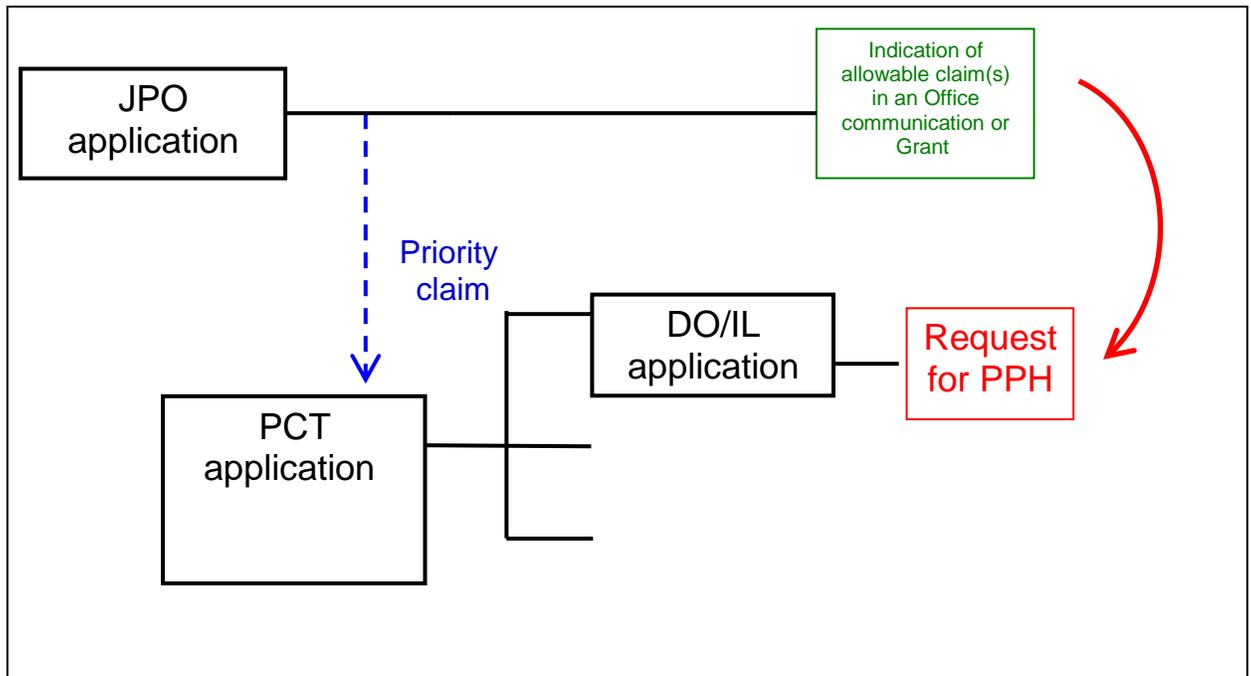
- (D) Paris Convention route and divisional applications



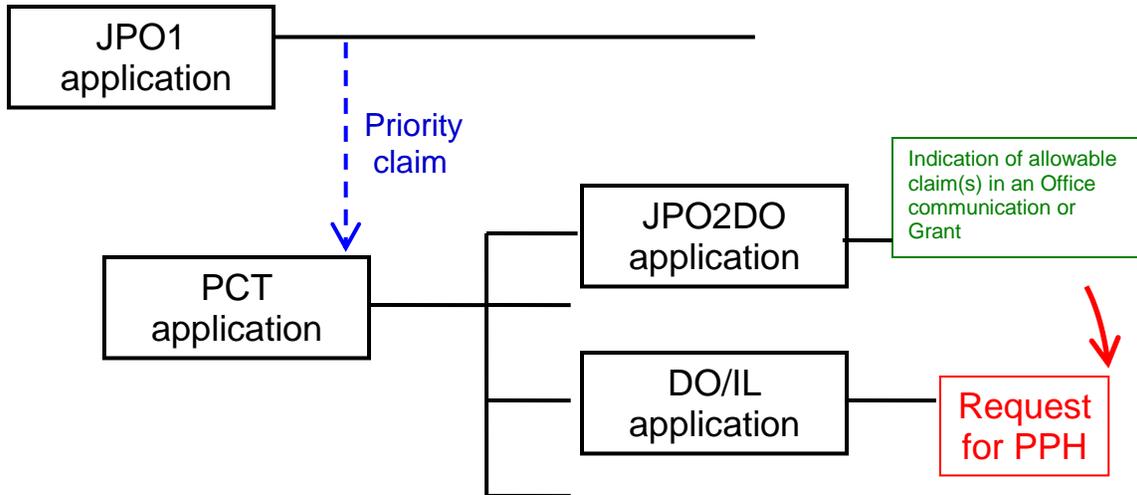
(E) - ILPO application claims Paris Convention priority to a PCT application



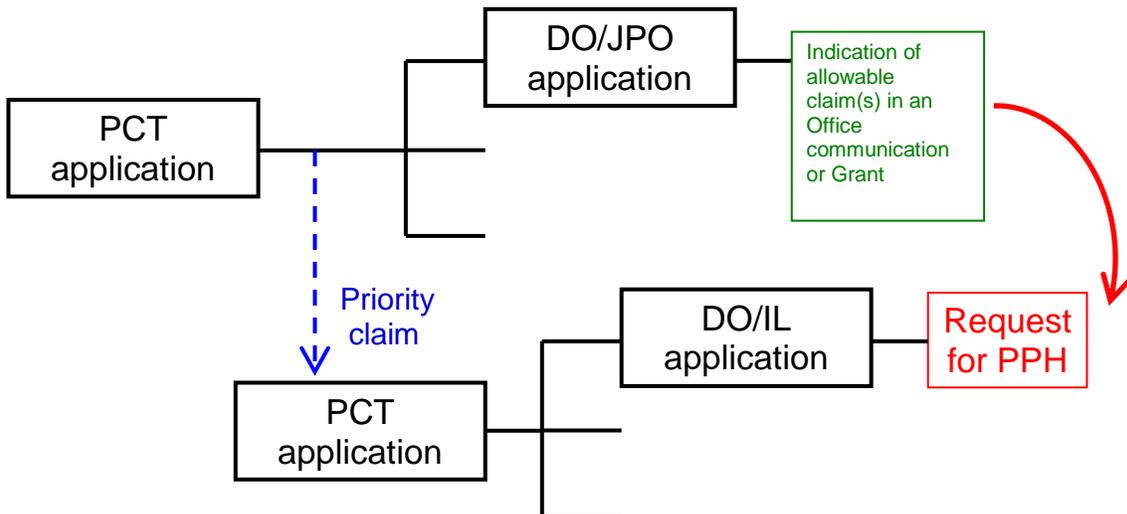
(F) - ILPO application is a national stage of a PCT application claiming Paris Convention priority to a JPO application



(G) – PCT Route

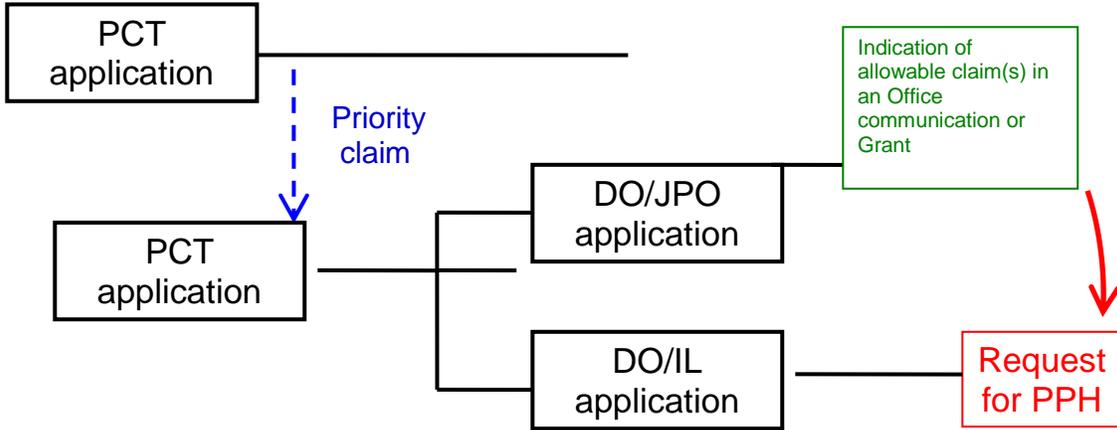


(H) - IL application is a national stage of a PCT application which claims Paris Convention priority to another PCT application

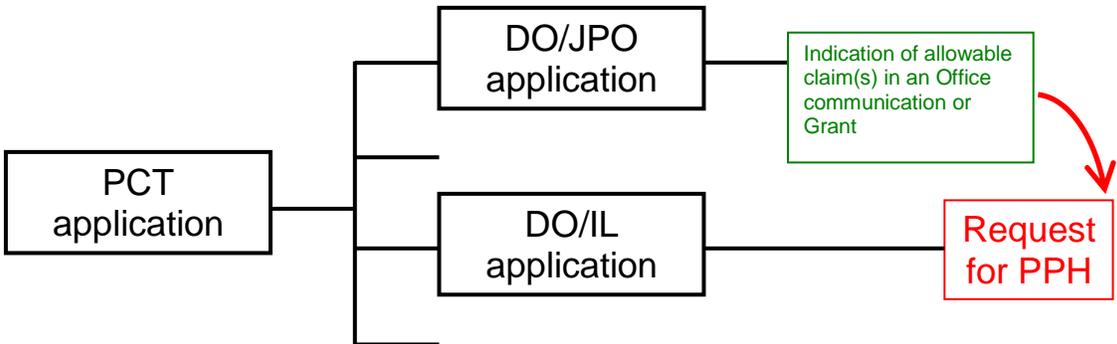


(I) - Direct PCT and PCT Route

Without priority claim



J- IL application is a national stage of a PCT application without priority claim



(1) The JPO application whose claims are determined to be allowable/patentable does not have to be the application for which priority is claimed in the IL application (the basic application). The JPO application can be an application explicitly derived from the basic application, e.g., a divisional application of the basic application. Note that where the JPO application that contains the allowable/patentable claims is not the same application for which priority is claimed in the IL application, applicant must identify the relationship between the JPO application that contains the allowable/patentable claims and the JPO priority application claimed in the IL application (e.g., JPO application X that contains the allowable/patentable claims is a divisional application of JPO application Y, which is the priority application claimed in the IL application).

(2) The JPO application(s) has at least one claim that was determined by the JPO to be allowable/patentable. The applicant does not have to submit a copy of the allowable/patentable claims from the JPO application(s) and the translation when they are provided via AIPN (JPO's dossier access system). However, if the ILPO examiner is not able to obtain them via the AIPN or understand the translated claims, the ILPO examiner may request the applicant to provide the necessary documents.

If the JPO Office action does not explicitly state that a particular claim is allowable, applicant must include a statement in the request for participation in the PPH pilot program or in the transmittal letter accompanying the request for participation that no rejection has been made in the JPO Office action regarding that claim, and therefore, the claim is deemed allowable by the JPO.

(3) All the claims in each IL application for which a request for participation in the PPH pilot program is made must sufficiently correspond to or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s).

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 ILPO are of the same or similar scope as the claims in the JPO, or the claims in the ILPO 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 ILPO 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, should the JPO claims only contain claims to a process of manufacturing a product, then the claims in the ILPO are not considered to sufficiently correspond if the ILPO claims introduce product claims that are dependent on the corresponding process claims.

It is not necessary to include all claims determined to be patentable in the JPO in the application to the ILPO, as the deletion of claims is allowable. In a case where an application to the JPO contains 5 claims which are determined to be allowable, the corresponding application to the ILPO may contain only 3 of those 5 claims.

Applicant is also required to submit a claims correspondence table in English. The claims correspondence table must indicate how all the claims in the IL application correspond to the allowable/patentable claims in the JPO application(s).

(4) Examination of the IL application for which participation in the PPH pilot program is requested has not begun.

(5) Applicant must file a request for participation in the PPH pilot program and a request that the IL application be advanced out of turn for examination. A sample request form is available from the ILPO Web site at: <http://index.justice.gov.il/Units/RashamHaptentim/Units/patent/Madrichim/Pages/PPH.aspx>

(6) The applicant does not have to submit a copy of all the Office actions (which are relevant to patentability) from the JPO application(s) and the translation when they are provided via AIPN (JPO's dossier access system). However, if the ILPO examiner is not able to obtain them via the AIPN or understand the translated claims, the ILPO examiner may request the applicant to provide the necessary documents.

Office actions should be in either English or translated into English. Machine translation is admissible. However, if the ILPO examiner is not able to understand the translated office actions to a sufficient extent, the ILPO examiner may request the applicant to submit a professional translation.

(7) Applicant must comply with section 18 of the Israeli Patents Law, 5727-1967 and submit a list of the documents cited by the JPO examiner in the JPO Office action.

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

The request for participation in the PPH pilot program and all the supporting documents must be submitted to the ILPO and indexed with the following document description: "Petition to make special under Patent Prosecution Highway." Any preliminary amendments submitted with the PPH documents must be separately indexed as a preliminary amendment, respectively.

Where the request for participation in the PPH pilot program and special status are granted, applicant will be notified and the IL application will be advanced out of turn for examination. In those instances where the request for participation in the PPH pilot program does not meet all the requirements set forth above, applicant will be notified and the defects in the request will be identified. Applicant will be given one opportunity to perfect the request in a renewed request for participation (which must be submitted as noted above). Note that action on the application by the examiner will NOT be suspended awaiting a reply by the applicant to perfect the request in a renewed request for participation. This is relevant in cases where the application has reached its regular

turn. That is, if the application is picked up for examination by the examiner after applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, the request and special status will be granted, applicant will be notified and the IL application will be advanced out of turn for examination. If not perfected, applicant will be notified and the application will await action in its regular turn.

(8) Request for participation in the PPH pilot program and special status granted in a parent application will not carry over to a divisional application. Applicant must fulfill all the conditions set forth above in order for special status to be granted in the divisional application.

If any of the documents identified in items (2), (6) and (7) above have already been filed in the IL application prior to the request for participation in the PPH pilot program, it will not be necessary for applicant to resubmit these documents with the request for participation. Applicant may simply refer to these documents and indicate in the request for participation in the PPH pilot program when these documents were previously filed in the IL application.

C. Special Examining Procedures

Once the request for participation in the PPH pilot program and special status have been granted to the IL application, the IL application will be taken up for examination by the IL examiner before all other categories of applications except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination."

Any claims amended or added after the grant of the request for participation in the PPH pilot program must sufficiently correspond to one or more allowable/patentable claims in the JPO application(s). Applicant is required to submit a claims correspondence table along with the amendment (see B (3) above). If the amended or newly added claims do not sufficiently correspond to the allowable/patentable claims in the JPO application(s), the amendment will not be entered and will be treated as a non-responsive reply under the PPH track and therefore will be processed as a regular application.

The PPH program does not absolve applicants of all their duties under the Israeli Patents Law, 5727-1967. By complying with requirements B (6) and (7) identified above, as well as all requirements set forth under section 18 of the Israeli Patents Law, 5727-1967 and official circular M.N.51, applicants would be considered to have complied with their duties to bring to the attention of the ILPO any material prior art cited in the corresponding foreign application(s) (see section 18 of the Israel Patents Law, 5727-1967).

Any inquiries concerning this notice may be directed to pph@justice.gov.il

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

PCT-PPH Pilot Program

The PCT-PPH pilot program was established to enable an applicant, who has received

- (1) a Written Opinion from an International Searching Authority (WO/ISA) (ISA must be the JPO), or
- (2) a Written Opinion from an International Preliminary Examining Authority (WO/IPEA) (IPEA must be the JPO), or
- (3) an International Preliminary Examination Report (IPER) from an International Preliminary Examining Authority (IPEA must be the JPO), that indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability, to file a request to participate in the PCT-PPH pilot program in a corresponding Israel application and petition to make the Israel application special under the PCT-PPH pilot program. The procedures and requirements for filing a request in the ILPO for participation in the PCT-PPH pilot program are set forth below.

A. Trial Period for the PCT-PPH Pilot Program

The ILPO and the JPO agreed that the PCT-PPH pilot program will commence on March 1, 2013 for a period of one year ending on February 28, 2014. The Trial Period may be extended if necessary to adequately assess the feasibility of the PCT-PPH pilot program. The ILPO and the JPO may also terminate the PCT-PPH pilot program early if the volume of participation exceeds a manageable level, or for any other reasons. Notice will be published if the PCT-PPH pilot program will be terminated before February 28, 2014.

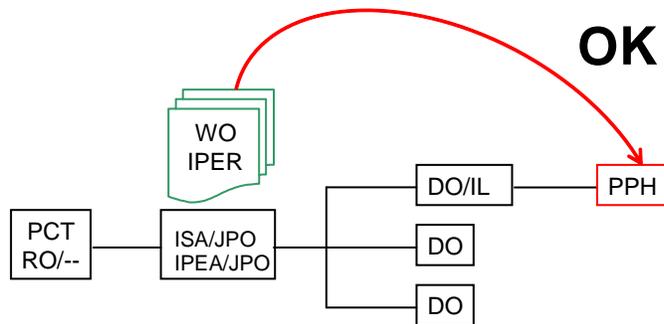
B. Requirements for Requesting Participation in the PCT-PPH Pilot Program in the ILPO

In order to be eligible to participate in the PCT-PPH pilot program, the following conditions must be met:

(1) The relationship between the corresponding Israel application for which participation in the PCT-PPH pilot program is requested and the PCT application satisfies one of the following requirements (note that RO/-- as used in the diagrams below refers to an international application filed under the PCT in any competent receiving office):

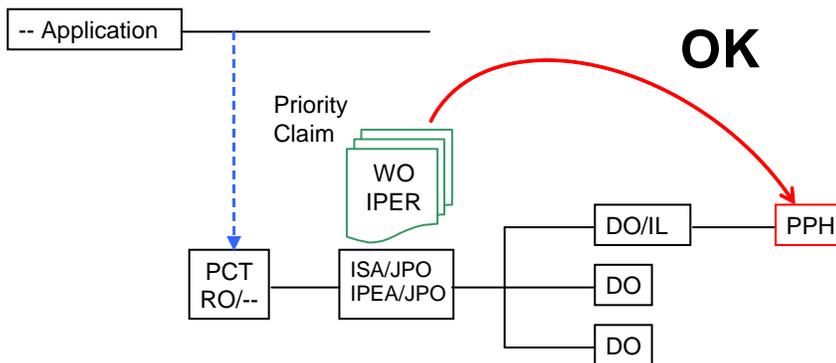
(a) The Israel application is a national stage entry of the corresponding PCT application. See diagrams (A), (A') and (A'') below.

(A) The Israel application is a national stage entry of the corresponding PCT application.

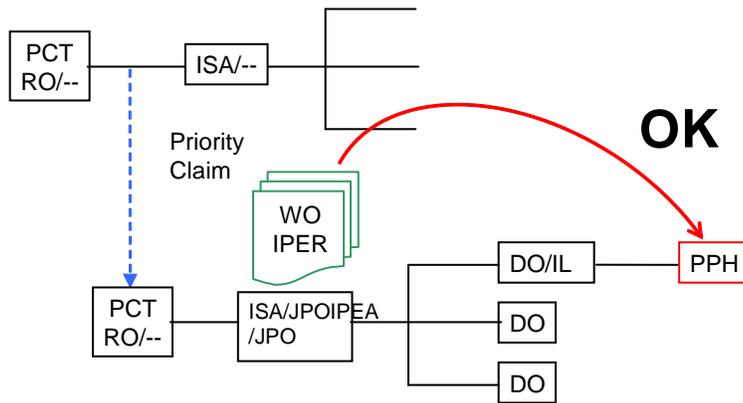


(A') The Israel application is a national stage entry of the corresponding PCT application.

(The corresponding PCT application claims priority to a national application filed anywhere.)

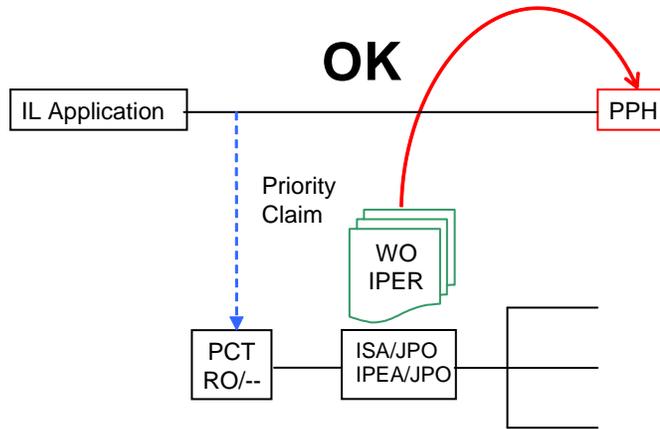


**(A'') The Israel application is a national stage entry of the corresponding PCT application.
(The corresponding PCT application claims priority from another PCT application.)**



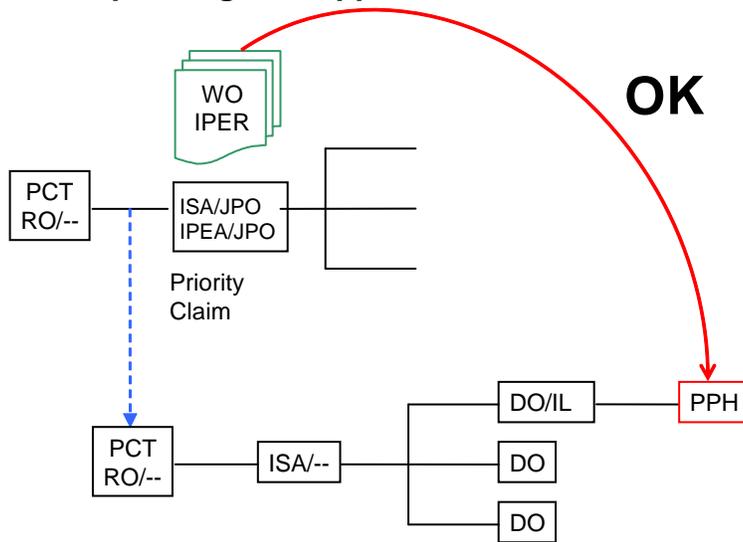
(b) The Israel application is a national application which forms the basis for the priority claim in the corresponding PCT application. See diagram (B) below.

(B) The Israel application is a national application which forms the basis for the priority claim in the corresponding PCT application.



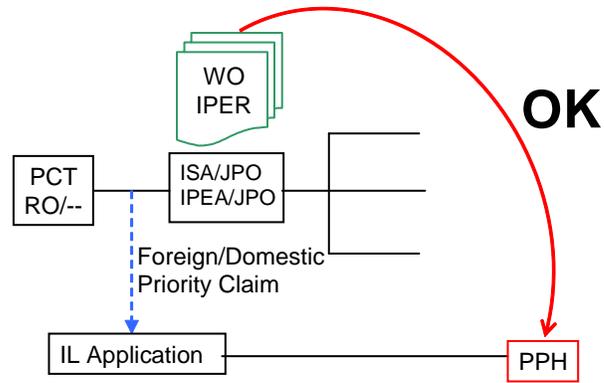
(c) The Israel application is a national stage entry of another PCT application (which can be filed in any competent receiving office) which claims priority to the corresponding PCT application. See diagram (C) below.

(C) The Israel application is a national stage entry of a PCT application which claims priority from the corresponding PCT application.



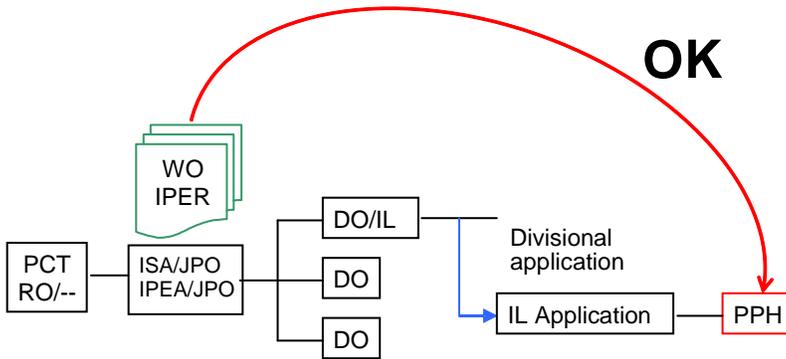
(d) The Israel application is a national application claiming foreign/domestic priority to the corresponding PCT application. See diagram (D) below.

(D) The Israel application is a national application claiming foreign/domestic priority from the corresponding PCT application.

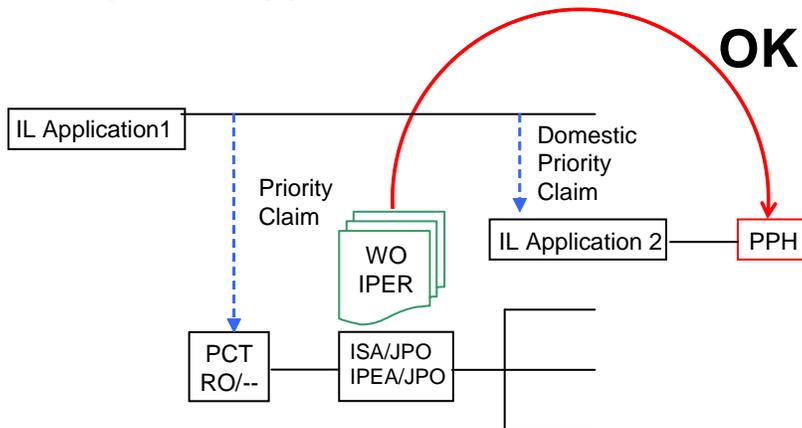


(e) The Israel application is a divisional application of the Israel application which satisfies one of the above (a) through (d) scenarios. See diagrams (E1) and (E2) below.

(E1) The Israel application is a divisional application of an application which satisfies requirement (a).



(E2) The Israel application (IL2) is an application claiming domestic priority to an application (IL1) which satisfies requirement (b).



(2) The latest work product in the international phase of the PCT application corresponding to the Israel application, namely, the WO/ISA, WO/IPEA, or the IPER, indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability. In case any observation is described in Box VIII of the WO/ISA, WO/IPEA, or IPER which forms the basis for the PCT-PPH request, applicant must identify and explain why the claim(s) is/are not subject to any observation described in Box VIII irrespective of whether an amendment is submitted to correct the observation described in Box VIII. The Israel application will not be eligible to participate in the PCT-PPH pilot program if applicant does not identify and explain why the claim(s) is/are not subject to the observation described in Box VIII.

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the JPO.

Applicant may not file a request to participate in the PCT-PPH pilot program on the basis of an International Search Report (ISR) only.

(3) Claim Correspondence

(a) All of the claims in each Israel application for which a request for participation in the PCT-PPH pilot program is made must sufficiently correspond to or be amended to sufficiently correspond to one or more of those claims indicated as having novelty, inventive step and industrial applicability and be free of any observation described in Box VIII in the latest work product of the corresponding PCT application.

(b) Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format requirements, the claims in the Israel application are of the same or similar scope as the claims indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application, or the claims in the Israel application are narrower in scope than the claims indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application.

(c) In this regard, a claim that is narrower in scope occurs when a claim indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application is amended to be further limited by an additional feature that is supported in the written description of the Israel application. The claim(s) with the narrower scope must be written in dependent form in the Israel application for which participation in the PCT-PPH pilot program is requested.

(4) Substantive examination of the Israel application for which participation in the PCT-PPH pilot program is requested has not begun.

(5) Applicant must file a request for participation in the PCT-PPH pilot program and a request that the Israel application be advanced out of turn for examination. A sample request form will be available from the ILPO Web site at "<http://index.justice.gov.il/Units/RashamHaptentim/Units/patent/Madrichim/Pages/PPH.aspx>" on March 1, 2013.

(6) In case the application satisfies the relationship B.(1)(a), the applicant need not submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof when a copy of these documents is available online. An applicant need not submit these documents, unless otherwise requested by the ILPO.

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

(7) If the copy of the set of claims which are indicated to be patentable/allowable is available online, an applicant need not submit this document unless otherwise requested by the ILPO. Where the set of claims is written in Japanese, the translations thereof must be still submitted by an applicant.

(8) Applicant is required to submit a claims correspondence table in English. The claims correspondence table must indicate how all the claims in the Israel application sufficiently correspond to the claims indicated as having novelty, inventive step and industrial applicability in the latest international work product.

(9) Applicant must submit a listing according to Section 18 of the Israel Patents Law, 5727-1967 ("the Law"), of the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the PCT application corresponding to the Israel application for which participation in the PCT-PPH pilot program is requested (unless such a listing has already been filed in the Israel application, in which case applicant may simply refer to the previously filed listing and indicate in the request for participation in the PCT-PPH pilot program when the listing was previously filed in the Israel application). If the reference is a patent document available online, the applicant is not required to submit it. In case the patent examiner has difficulty in obtaining the document, however, the applicant may be asked to submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

(10) The request for participation in the PCT-PPH pilot program and all the supporting documents can either be submitted to the ILPO by mail to: Israel Patent Office, 1 Agudat Sport Hapoel St. Technology Garden, Building No. 5, Jerusalem, 9695101, Israel; or via the following email address: pph@justice.gov.il. Any preliminary amendments and Section 18 of the Law listings submitted with the PCT-PPH documents must be separately indexed as a preliminary amendment and Section 18 of the Law listing, respectively.

Where the request for participation in the PCT-PPH pilot program and special status are granted, applicant will be notified and the Israel application will be advanced out of turn for examination. In those instances where the request for participation in the PCT-PPH pilot program does not meet all the requirements set forth above, applicant will be

notified and the defects in the request will be identified. Applicant will be given one opportunity to perfect the request in a renewed request for participation (which must be submitted and indexed accordingly as noted above). Note that action on the application by the examiner will NOT be suspended awaiting a reply by the applicant to perfect the request in a renewed request for participation. That is, if the application is picked up for examination by the examiner after applicant has been notified of the defects in the request, any renewed request will be dismissed. If the renewed request is perfected and examination has not begun, the request and special status will be granted, applicant will be notified and the Israel application will be advanced out of turn for examination. If not perfected, applicant will be notified and the application will await action in its regular turn.

Request for participation in the PCT-PPH pilot program and special status granted in a parent application will not carry over to a divisional application. Applicant must fulfill all the conditions set forth above in order for special status to be granted in the divisional application.

C. Special Examining Procedures

Once the request for participation in the PCT-PPH pilot program and special status have been granted to the Israel application, the Israel application will be taken up for examination by the Israel examiner before all other categories of applications except those clearly in condition for allowance, those with set time limits, such as examiner's answers, and those that have been granted special status for "accelerated examination."

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program must "sufficiently correspond" to the claims indicated as having novelty, inventive step and industrial applicability in the latest work product of the corresponding PCT application. See the definition of "sufficient correspondence" in II.B.(3) above. Applicant is required to submit a claims correspondence table along with the amendment (see II.B.(8) above). If the amended or newly added claims do not sufficiently correspond to the claims indicated as having novelty, inventive step and industrial applicability in the latest work product of the corresponding PCT application, the amendment will not be entered and will be treated as a non-responsive reply.

This PCT-PPH program does not absolve applicants of all their duties under the Israel Patents Law, 5727-1967. By complying with requirements II.B.(6) and (9) identified above, as well as all requirements set forth under section 18 of the Israeli Patents Law, 5727-1967 and public circular M.N.51, applicants would be considered to have complied with their duties to bring to the attention of the ILPO any prior art cited in corresponding foreign application(s) (see section 18 of the Israel Patents Law, 5727-1967).

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