

Patent Prosecution Practice in Japan  
- Tips for Obtaining a Patent in Japan -  
「日本特許出願実務 ー特許取得への助言ー」

【作成者】

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【概要】

米国の企業や発明者が日本に特許を出願する意義を見出せるよう、主として出願時の有用な手続及び統計データを紹介するための資料を作成し、この資料に基づいてこれら手続や統計データを、“Discover IP Japan Conference 2017” の Session 1 にて紹介した。具体的には以下の手続・統計データに紹介内容を絞った。

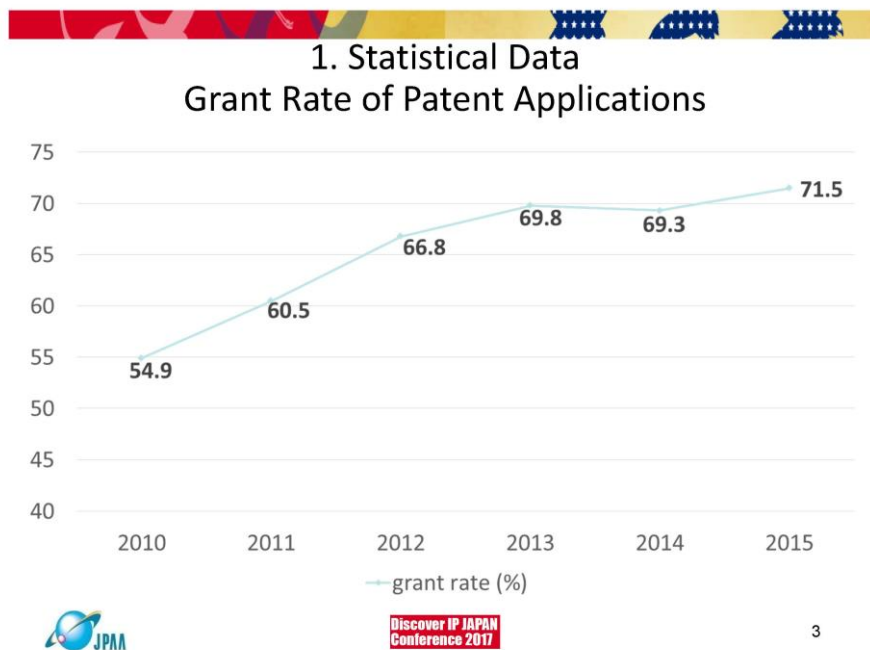
- ・ 日本の近年の特許率
- ・ 特許法の保護対象
- ・ 特許出願手続
- ・ 分割出願
- ・ 早期審査制度（PPH 及び早期審査請求）
- ・ 特許維持年金

Session の題名は“Patent Prosecution Practice in Japan - Tips for Obtaining a Patent in Japan -”とし、Session は 2 部構成とした。第 1 部では、上記の項目についての講義を行った。第 2 部では、米国出願人が日本へ特許出願をする架空の話を作り小劇を行い、この話を通じて第 1 部の講義の内容をより具体的に理解できるようにした。第 2 部においては、ナレーター、日本弁理士 2 名、米国弁理士 1 名の役を設け、実際の米国弁理士が米国弁理士役を演じた。

## 1. Session 1 第1部


## 1-1. 日本の近年の特許率

近年の日本の特許率を示すスライドである。





## 1ー2. 特許法の保護対象

発明の定義（法上の発明）を説明するスライドである。




## 2. Subject Matter of Patent Protection

- ◆ Definition of Invention ( JP Patent Law Art. 2, Par. 1)
  - “Highly advanced creation of technical idea  
utilizing the laws of nature.”*
- Statutory inventions include:
  - ✓ Products
  - ✓ Methods
  - ✓ Process for producing products
- Inventions **do not** include:
  - ✓ Techniques
  - ✓ Medical procedures
  - ✓ Artificial rules





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法上の発明に当たらない発明を例示するスライドである。



## 2. Subject Matter of Patent Protection

- ◆ The following, for example, are **excluded** from the definition of “statutory inventions” because they are not “the creation of technical ideas utilizing the law of nature” :
  - ✓ A law of nature as such (*e.g.*, a law of preservation of energy)
  - ✓ Mere discoveries and not creations (*e.g.*, discovery of natural phenomena)
  - ✓ “Inventions” contrary to the law of nature (*e.g.*, so-called “perpetual motion”)
  - ✓ “Inventions” in which a law of nature is not utilized (*e.g.*, a rule for playing a game)
  - ✓ “Inventions” not regarded as technical ideas (*e.g.*, personal skills)
  - ✓ “Inventions” for which it is clearly impossible to solve the problem to be solved by any means presented in a claim



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法上の発明に対する「産業上の利用可能性」の要件を説明するスライドである。



## 2. Subject Matter of Patent Protection

- JP Patent Law Art. 29: “Any person who has made an invention which is **industrially applicable** may obtain a patent therefor”
- The following, for example, are **excluded** from the definition of “industrially applicable”:
  - ✓ Inventions of methods of surgery, therapy or diagnosis of humans
  - ✓ Commercially inapplicable inventions (only applicable for personal use, or for academic or experimental purposes)
  - ✓ Obviously impracticable inventions



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コンピュータ利用発明の発明該当性を説明するスライドである。



## 2. Subject Matter of Patent Protection

- ◆ Computer-implemented invention
  - Computer-implemented inventions can qualify as a “statutory invention” when  
“the computer-implemented invention utilizes a law of nature.”
  - What is “utilizing a law of nature” to a computer-implemented invention?  
“Information processing by a software is concretely realized with a hardware resource”

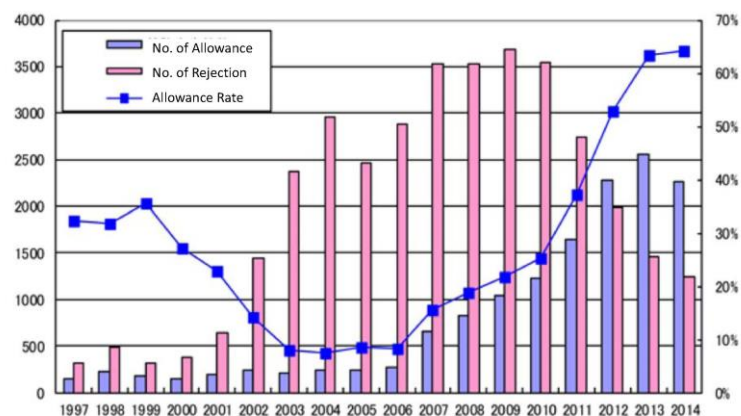


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コンピュータ利用発明に係る特許出願の特許率を示すスライドである。

## 2. Trends of Computer-implemented Invention

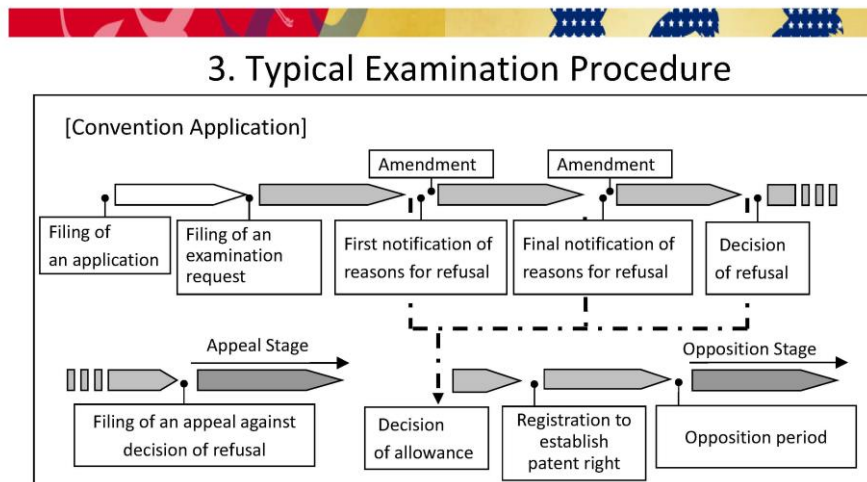


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## 1-3. 特許出願手続

典型的出願手続を示すスライドである。



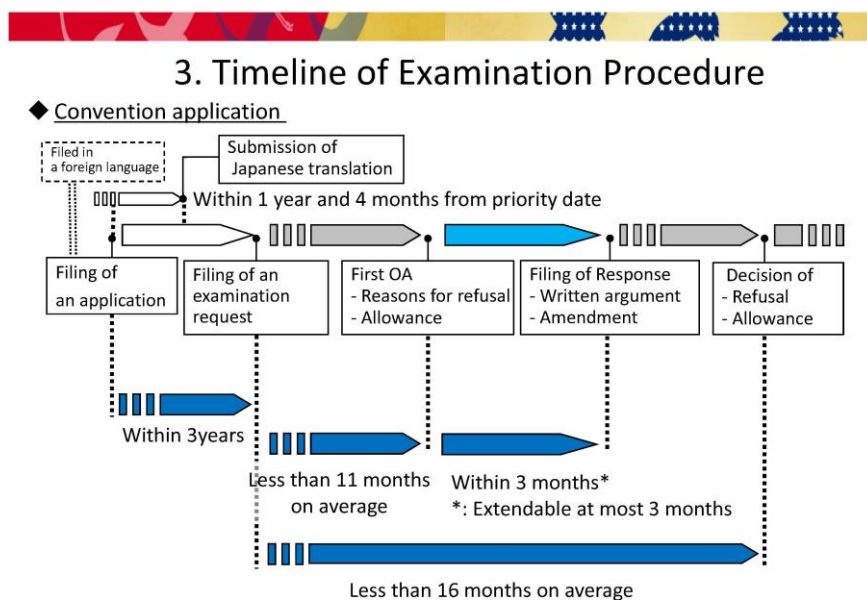
In principle, the same reason for refusal twice will result in a final notification.



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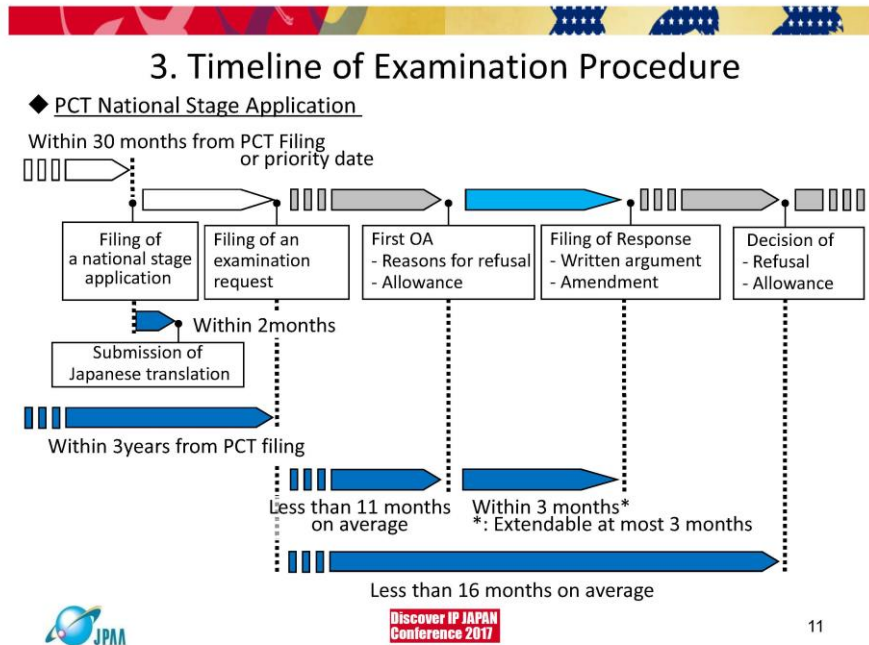
パリルート日本出願の各手続期間を説明するスライドである。



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PCT出願に基づく日本出願の各手続期間を説明するスライドである。



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## 1-4. 分割出願

分割出願について、用件や出願の機会等を説明するスライドである。内容を複雑にしないために、拒絶査定不服審判前の審査段階での手続を説明している。



## 4. Divisional Application

- ◆What is a “divisional application”?
  - An invention which is not claimed in the original application but is supported by the specification can be claimed in a divisional application.
- ◆When to consider filing a divisional application?
  - A claimed invention of the original application does not cover your product.
  - Allowed claims do not cover other’s products similar to yours.



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## 4. Divisional Application

- ◆Conditions of Divisional Application
  - Subject Matter Requirement
    - ✓ A claimed invention in a divisional application is disclosed in the original application.
    - ✓ The invention claimed in the divisional application is not identical to the invention claimed in the original application.
  - Timing Requirement
    - ✓ Any time before a first office action issues;
    - ✓ Within 3 months from the Notification of Reasons for Refusal;
    - ✓ Within 30 days from the Notice of Allowance; or
    - ✓ Within 4 months from the Decision of Rejection.

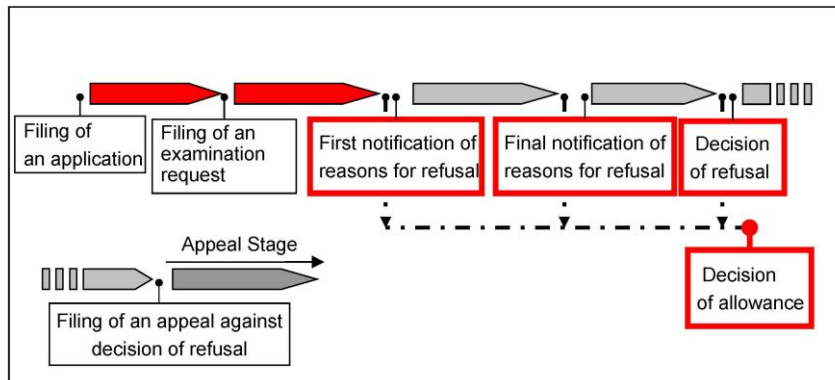


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#### 4. Divisional Application



Within the red periods, a divisional application can be filed.

## 1-5. 早期審査制度（PPH 及び早期審査請求）

平均審査期間を示すスライドである。



## 5. Expedite Examination

- ◆ Average regular examination period in 2014
  - Until first action : 9.3 months  
(from request for substantive examination)
  - Until final decision : 15.2 months  
(from request for substantive examination)
- ❖ The examination period can be shortened under either:
  - ✓ Patent Prosecution Highway (PPH) System
  - ✓ Accelerated Examination



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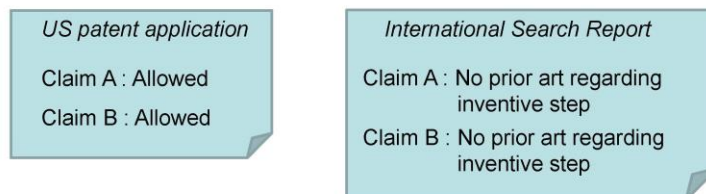
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審査期間を短くする制度として PPH を紹介するスライドである。



## 5. Expedite Examination

- ◆ What is PPH (Patent Prosecution Highway) System?
  - You can use your positive result regarding an invention claimed in a US or PCT application to expedite examination of a Japanese patent application.

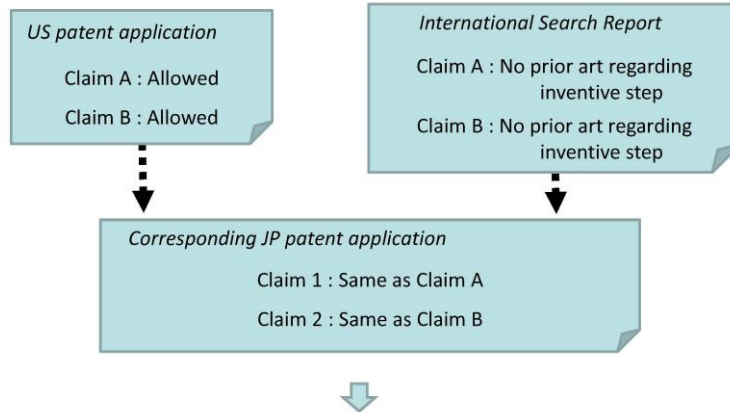


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## 5. Expedite Examination

### ◆ What is PPH (Patent Prosecution Highway) System?



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## 5. Expedite Examination

### ◆ PPH (Patent Prosecution Highway) System

#### ➤ Advantageous Effects

- ✓ Shortens the examination period to:
  - 2.4 months** (on average as of June 2015)
  - ➔ Shortens the examination period (First Action pendency) compared to that of a regular examination (9.3 months) by about 7 months.
  - ➔ Makes the total examination period shorter than that of a regular examination (15.2 months).
- ✓ Higher grant rate:
  - 86.3% (on average as of June 2015 not including PCT-PPH)
  - ➔ Grant rate of the normal procedure: 71.5% on average in 2015.



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審査期間を短くする制度として通常の早期審査手続を紹介するスライドである。

## 5. Expedite Examination

### ◆ Accelerated Examination

#### ➤ Advantageous Effects

✓ Shortens the examination period to

**2 months** (on average)

➔ Shortens the examination period (First Action pendency) compared to that of a regular examination (9.3 months) by about 7 months.

➔ Makes the total examination period shorter than that of a regular examination (15.2 months).



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PPHと早期審査手続との比較をするスライドである。

## 5. Expedite Examination

### ◆ Application Procedure PPH vs Accelerated Examination

#### □ PPH Application Document

✓ Formal information of the original US or PCT application.

#### □ Accelerated Examination Application Document

✓ Formal information of the applicant or an invention.

✓ Explanation about difference between the patent application and prior art\*.

\*Prior art: searched by the applicant.



PPH application procedure is much easier.



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## 2. Session 1 第2部

第1部の講義の内容を下記の架空の米国からの出願の話しに当てはめ、聴衆の更なる理解を図った。また、ここでは、日本での特許に係わる費用を示すため、特許出願費用、特許維持費用を紹介するようにした。

架空の出願の話は、米国の発明者から日本での特許出願の依頼を受けた米国弁理士と日本弁理士との間の日本での特許出願手続をめぐる話である。あらすじを以下に示す。

### 【あらすじ】

米国の発明者は、発明品を米国と日本で販売したいと考えており、米国と日本で特許を取りたいと考えている。

この発明品の日本での発売予定は米国での発売よりも数年後である。

このため、先ず米国特許出願が行われ、その後、この米国出願に対する優先権を主張したPCT出願がなされた。そして、日本での発明品の販売タイミングに合わせるべく国際出願の日本へ国内移行が行なわれた。

米国特許出願に対しては、クレーム発明が進歩性を有していないため拒絶されたが、クレームの減縮補正が行われ、米国特許出願に対しては特許が付与された。

日本特許出願に対しては、米国での特許クレームに基づくPPHの請求がなされ、特許が付与された。

一方、発明者は、発明品の日本で発売前に、中国製の類似品の発売に気が付いた。この類似品は、上記日本特許クレームの保護範囲に含まれていなかった。

そこで、この類似品も権利保護すべく、特許査定後の分割出願制度を利用し、分割出願を行った。この分割出願では早期審査を申請した。

この分割出願に対しても特許査定がなされ、類似品をマーケットから排除することができた。

以下、第2部に用いたスライドを示す。

## S1 The Characters

US attorney:           Seattle: Robert J.M.Lee  
                                  Palo Alto: David Ahn

JP Patent attorney ①: Hiroyasu Ninomiya

JP Patent attorney ②: Toshinori Tanno

**Narrator and Commentator: Takeo Nasu**



## S2 Outline

- The inventor wanted to sell his invention in the US and JP. He wanted to obtain patent right in the US and Japan. The Japanese product launch was several years after the US launch.
- For that reason, the US patent application was filed, followed by a PCT application claiming priority based on the US application. JP national phase application was filed when the Japanese business was launched.
- The US application was allowed.
- For the Japanese application, a request for PPH was filed with the US allowed claims and the JP application was also granted.
- However, before selling his patented products in Japan, a competitor began selling in Japan similar products made in China. Those Similar products were not within the scope of the claims.
- In order to catch the competitor's products, a divisional application was filed within 30 days from the date of notice of allowance.
- An allowance was issued for the divisional application as well, and the competitor's products were excluded from the Japanese market.



S3 Please look at the "erasable ballpoint pen" that is distributed.



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S4 E-mail from Mr. Drump

Subject: Inquiry – US and JP patent application

To : \*\*\*\*\*@\*\*\*\*\*

Fr: Drump@\*\*\*\*\*

1. The features of invention are the following;
  - 1) Ink is erasable by frictional heat.
2. Sales schedule
  - US : in one month
  - JP : in a few years, depending on sales forecasts
3. Tell me the procedure for filing a JP patent application.
4. Tell me official fees from filing to grant.
5. Tell me the patent registration fee and annuity fee.



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## S5 Nino-Tan IP firm in Japan



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## S6 You got a mail



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### S7 E-mail from US attorney

Subject: Inquiry – JP patent application  
 To : Nino@\*\*\*\*\*  
 Fr: US@\*\*\*\*\*

Hi Nino and Mr. Tan,

Mr. Drump who founded his corporate empire based on inventions is interested in filing a patent application in Japan. Please send me the following information.

1. The procedure for filing a JP patent application.
2. Official fees from filing to grant.
3. The patent registration fee and annuity fees.

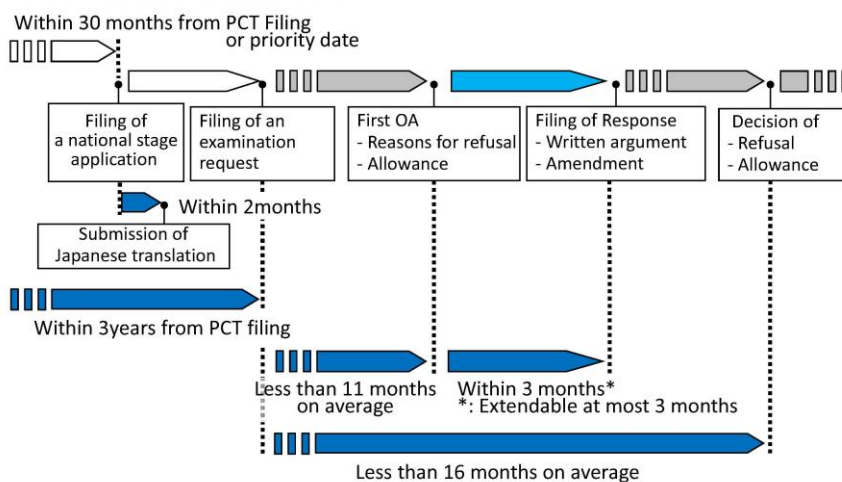


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### S8 Timeline of Examination Procedure

#### ◆ PCT National Stage Application



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## S9 Costs to Obtain Patent

- ◆ Cost to file a patent application
  - USD 124 (≒ JPY 14,000 )
  - USD 195 (≒ JPY 22,000 ) for foreign language application (non-Japanese language)
- ◆ Cost to file an examination request
  - Convention application:  
USD 1,044(≒ JPY 118,000) + USD 35(≒ JPY 4,000) for each additional claim
  - PCT National Stage Application  
USD 937(≒ JPY 106,000) + USD 32(≒ JPY 3,600) for each additional claim
- ◆ Typical service fee for filing a JP patent application (including JP translation)  
**USD 4,000 to USD 6,000**



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## S10 Official fees of patent registration and maintenance

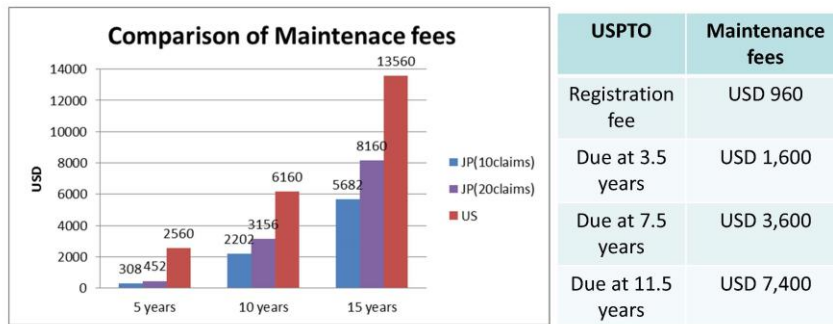
Years	Maintenance fees	Example ( 10 claims)
1 <sup>st</sup> to 3 <sup>rd</sup>	2100 + 200 × number of claims per year	4100 *USD1/YEN113 = <b>USD 108</b> The fee must be paid at once.
4 <sup>th</sup> to 6 <sup>th</sup>	6400 + 500 × number of claims per year	11400*USD1/YEN113= <b>USD 100 per year</b>
7 <sup>th</sup> to 9 <sup>th</sup>	19300 + 1500 × number of claims per every year	34800*USD1/YEN113= <b>USD 308 per year</b>
10 <sup>th</sup> to 25 <sup>th</sup>	55400 + 4300 × number of claims per year	98400*USD1/YEN113= <b>USD 870 per year</b>



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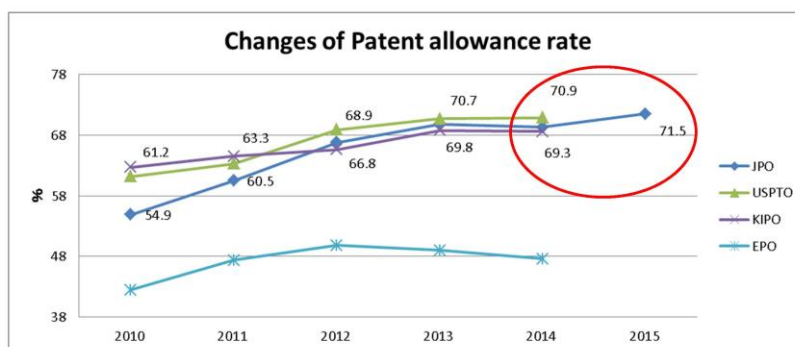
### S11 Comparison of the maintenance fees between USPTO and JPO



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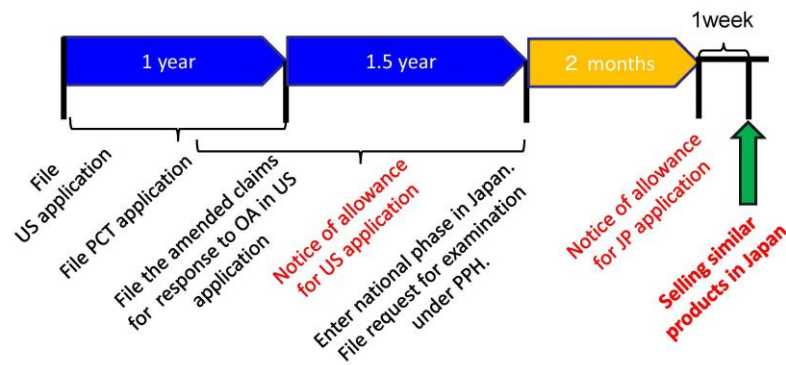
### S12 Allowance rate of major patent offices



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S13

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S14 E-mail from US attorney

Subject: Urgent Inquiry – Divisional application  
 To : Nino@\*\*\*\*\*  
 Fr: US@\*\*\*\*\*

Hi Nino and Mr. Tan

Thank you for sending the notice of the patent allowance. I would like to pay registration fee for 1-3 years within 30 days. In addition, I just learned of a big problem. A competitor in Japan is selling similar products made in China. However, the scope of the patent claims does not cover these competing products.

What can we do? Is there something similar to a continuation application in Japan to obtain additional patent coverage?

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## S You got a mail

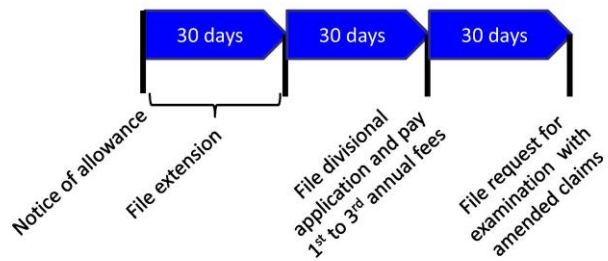


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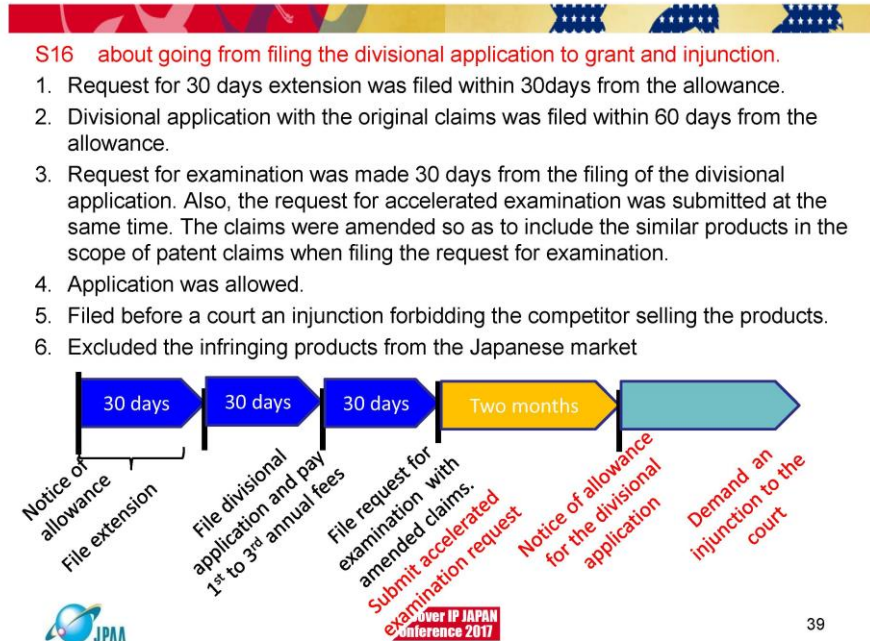
### S15

1. Divisional application **can be filed within 30 days** from the notice of patent allowance.
2. 30 days extension is available by filing a request for extension
3. Request for examination **should be filed within 30 days** from the filing date of the divisional application.
4. Claims **can be amended** when filing the request for examination.
5. Request for accelerated examination **can be submitted (1<sup>st</sup> OA: 2mos)**.



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### S17 Summary: Key Points

- Allowance Rate in Japan is over 70%
- PPH is available based on the US allowed claims (Allowance Rate: more than 80%, 1<sup>st</sup> OA: 2mos.)
- A divisional application can be filed
  - before first office action
  - within the period for response to office action
  - 30 days (extensible) from a notice of allowance
- Eligibility & Allowance Rate for computer-implemented Invention
  - Information processing by a software is concretely realized with a hardware resource
  - Allowance Rate is over 60%
- Cost for filing and maintaining patent is low



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以上