



Session

Patent prosecution practice in Japan Tips for obtaining a patent in Japan - Part I -

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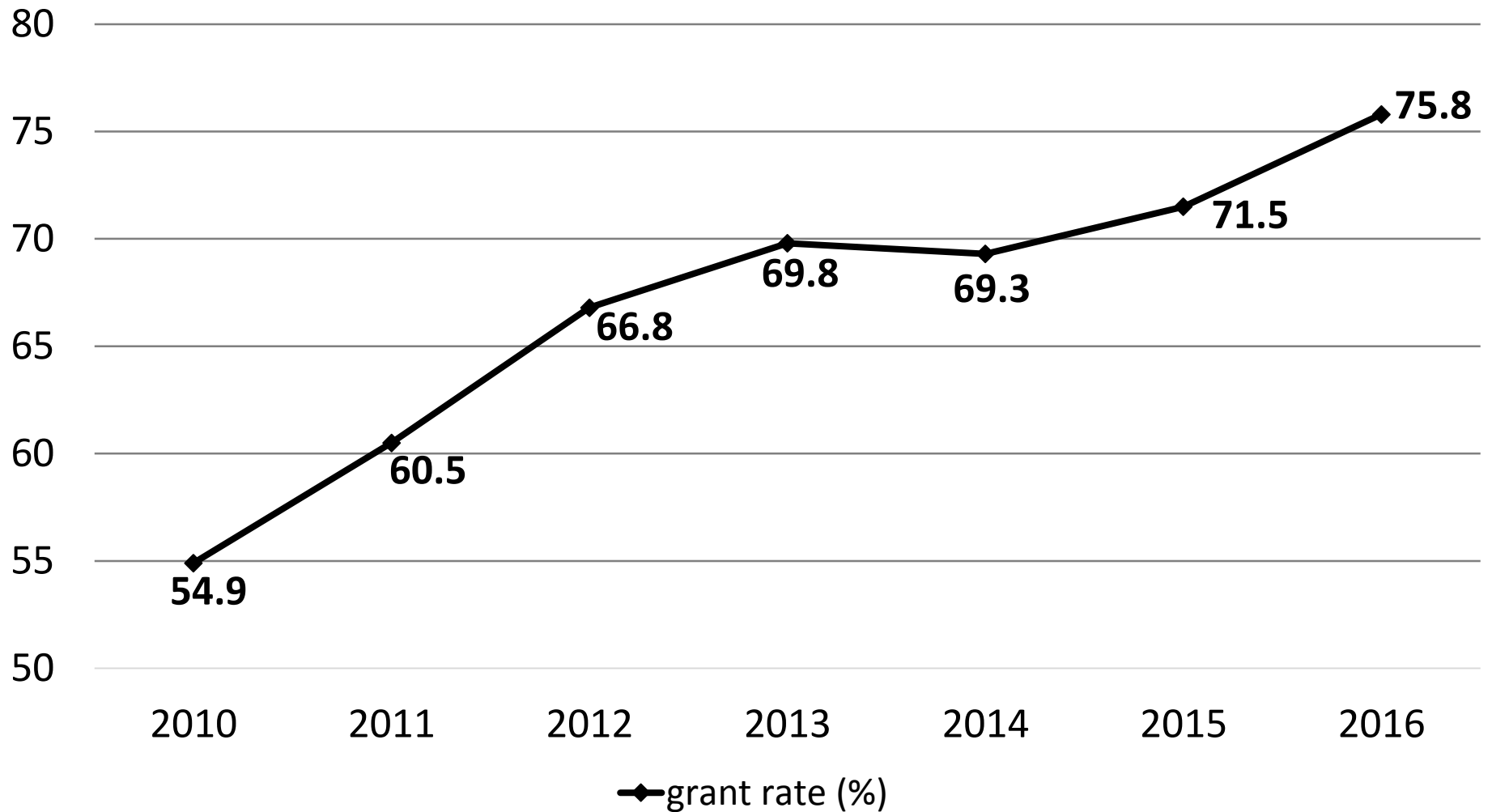
Japan Patent Attorneys Association
International Activities Center

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1. Statistical Data

Grant Rate of Patent Applications



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

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

2. Subject Matter of Patent Protection

◆ Computer-implemented invention

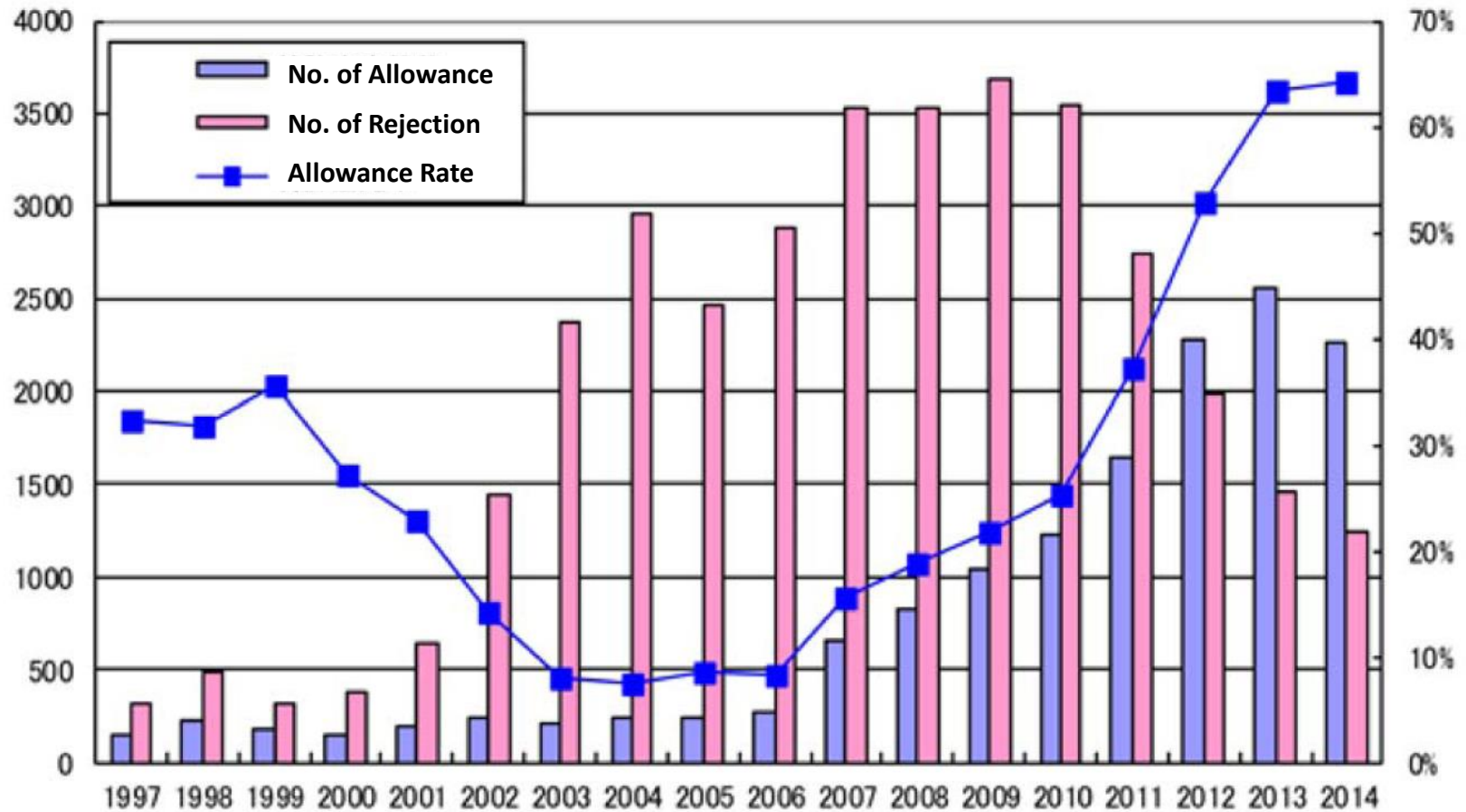
- Computer-implemented inventions, *a program, software*, can qualify as a “statutory invention” when

“the computer-implemented invention utilizes a law of nature.”

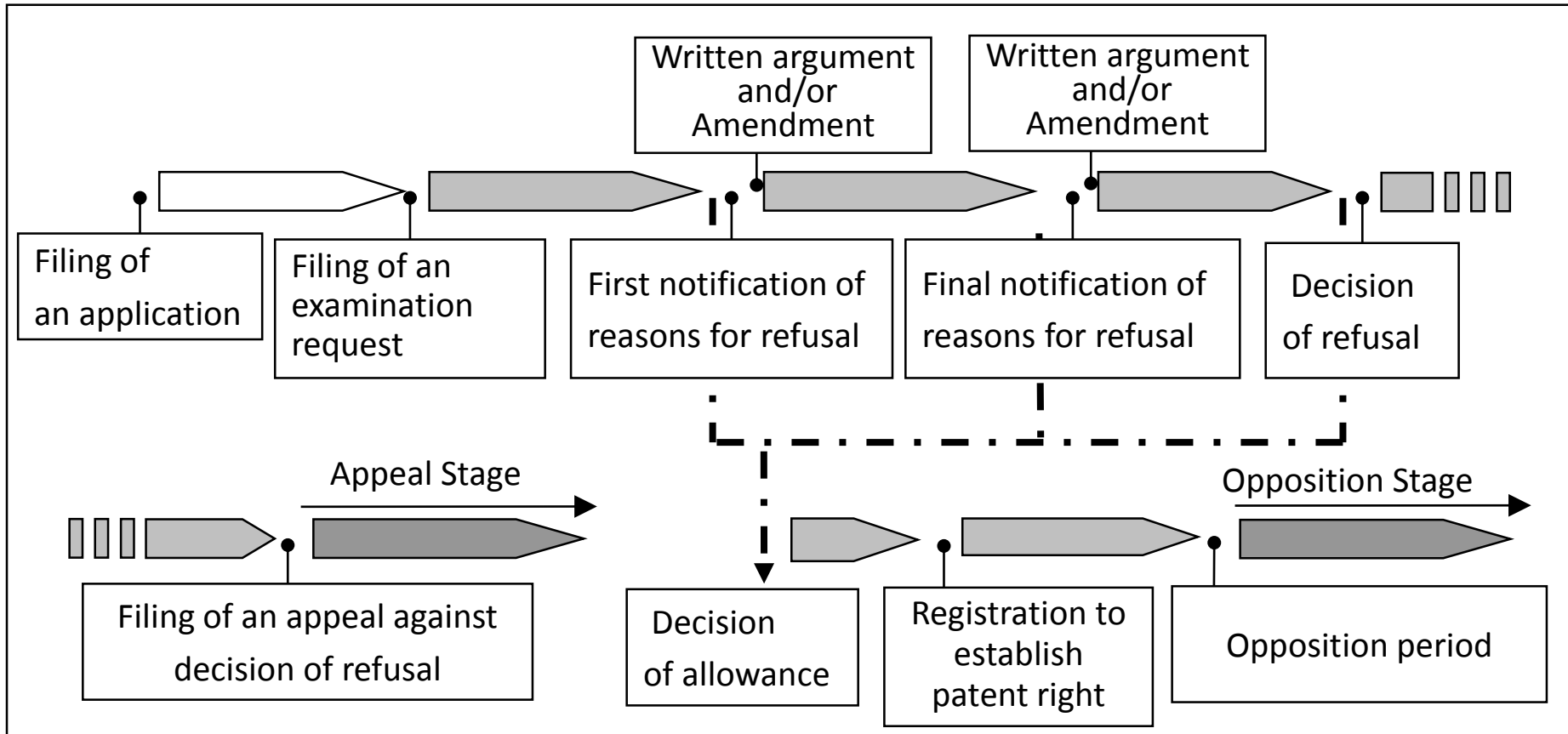
- What is “utilizing a law of nature” to a computer-implemented invention?

“Information processing by a software is concretely realized with a hardware resource”

2. Trends of Computer-implemented Invention



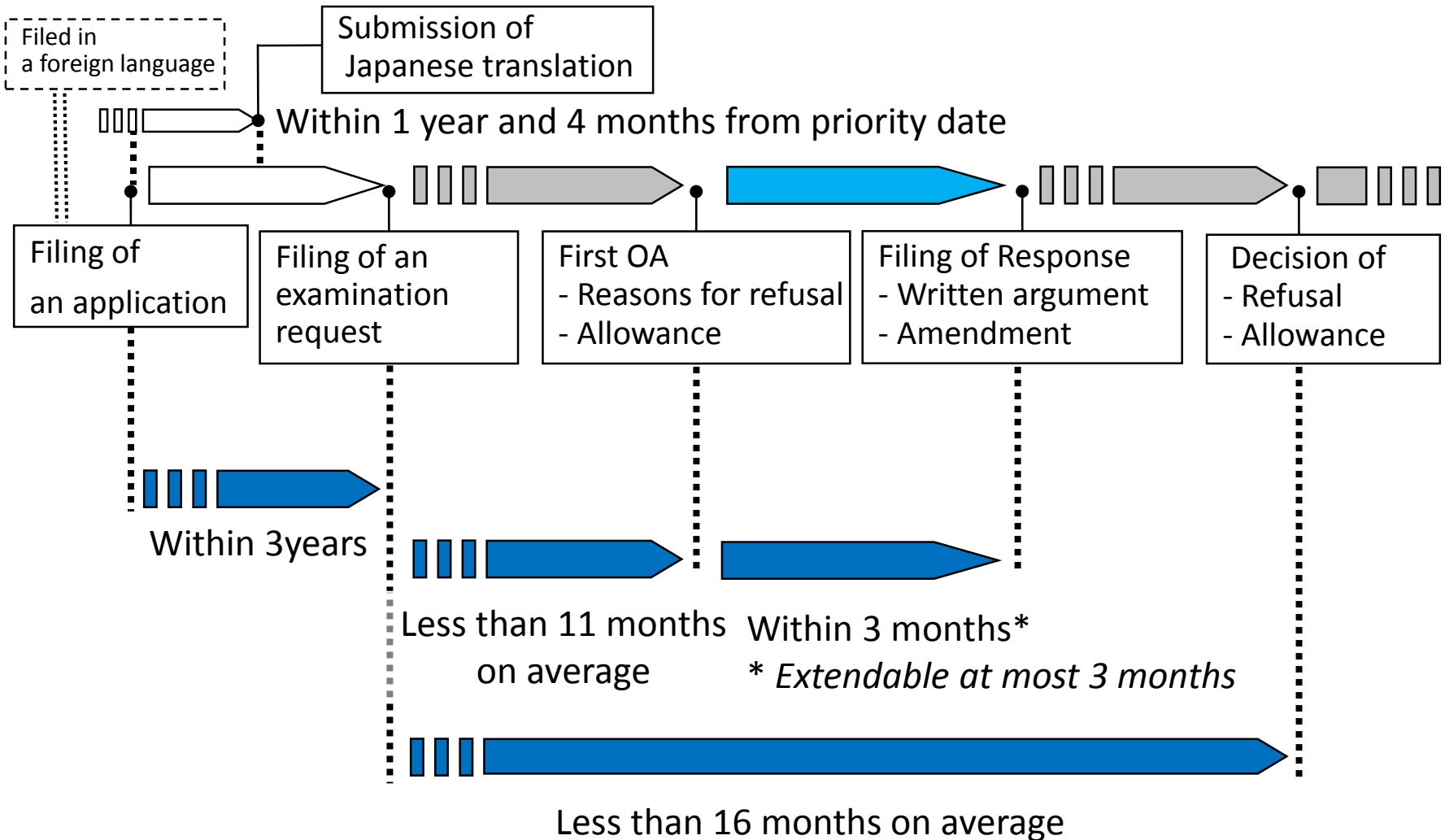
3. Typical Examination Procedure



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

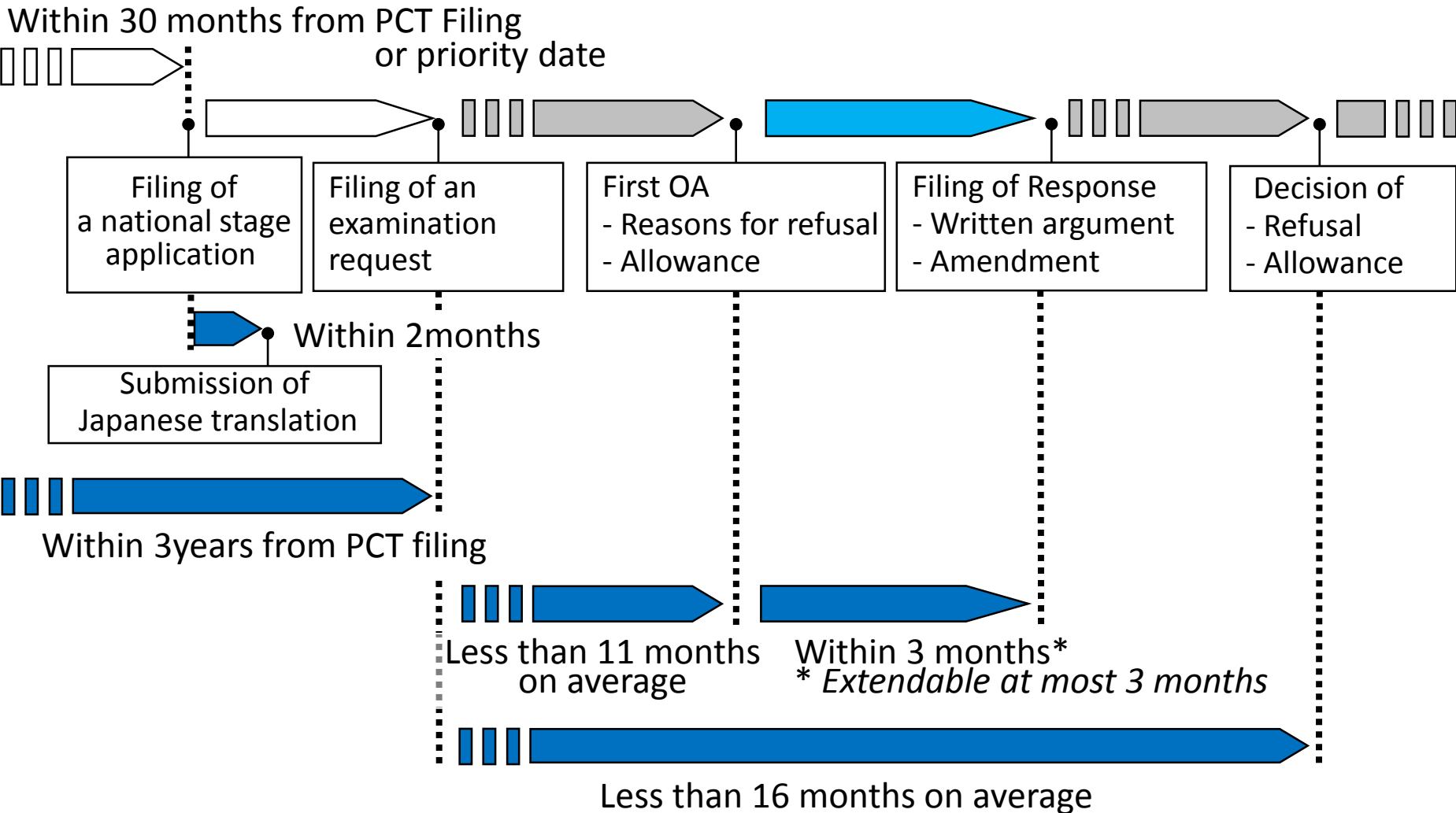
3. Timeline of Examination Procedure

◆ Convention application



3. Timeline of Examination Procedure

◆ PCT National Stage Application



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.

4. Divisional Application

◆ Conditions of Divisional Application

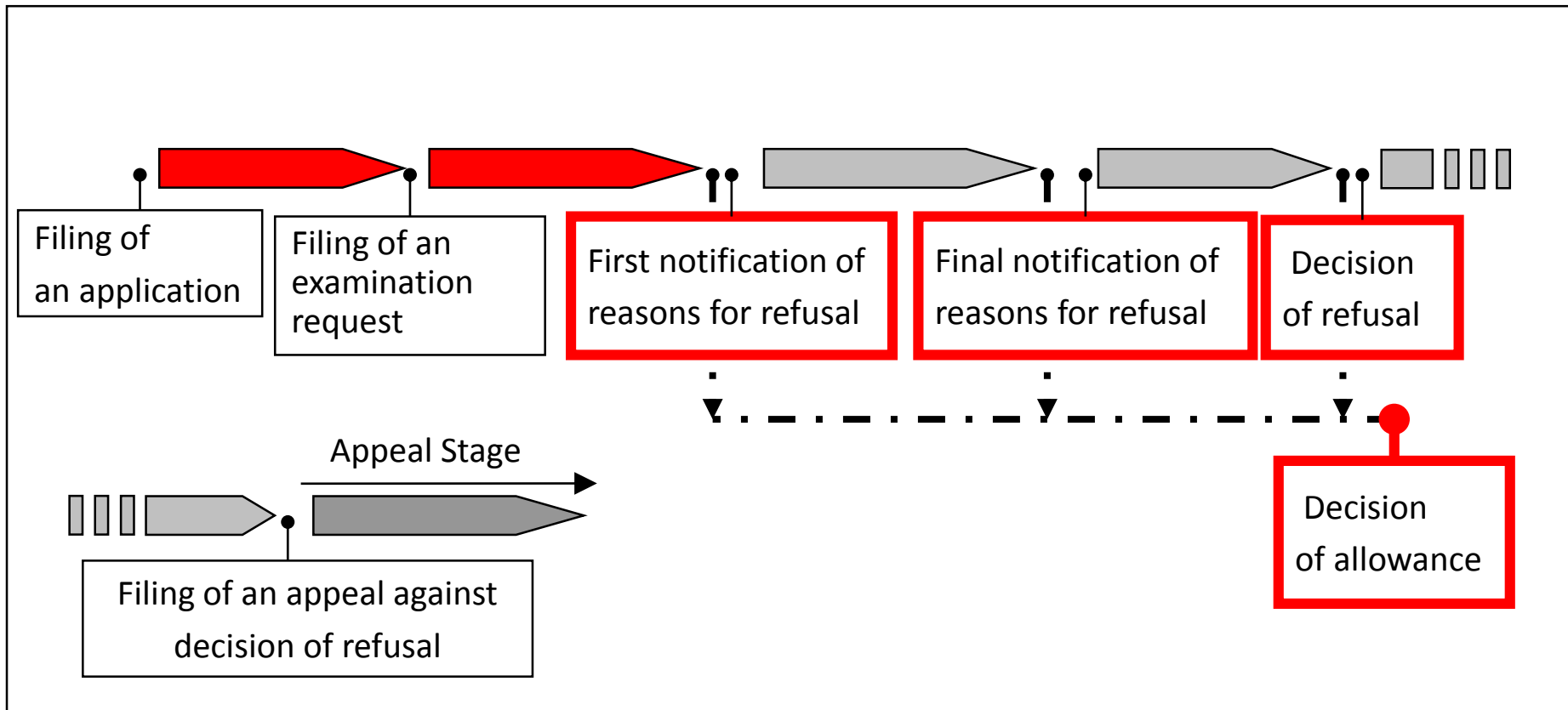
➤ Subject Matter Requirement

- ✓ 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.

4. Divisional Application



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

5. Expedite Examination

- ◆ Average regular examination period in 2015
 - Until first action : 9.7 months
(from request for substantive examination)
 - Until final decision : 15.0 months
(from request for substantive examination)

- ❖ The examination period can be shortened under either:
 - ✓ Patent Prosecution Highway (PPH) System
 - ✓ Accelerated Examination

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.

US patent application

Claim A : Allowed

Claim B : Allowed

International Search Report

Claim A : No prior art regarding
inventive step

Claim B : No prior art regarding
inventive step



Examination procedure of a corresponding JP patent application can be expedited.

5. Expedite Examination

◆ What is PPH (Patent Prosecution Highway) System?

US patent application

Claim A : Allowed
Claim B : Allowed

International Search Report

Claim A : No prior art regarding
inventive step
Claim B : No prior art regarding
inventive step

Corresponding JP patent application

Claim 1 : Same as Claim A
Claim 2 : Same as Claim B

Examination procedure can be expedited under the PPH system.

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).

5. Expedite Examination

◆ Accelerated Examination

➤ Advantageous Effects

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2 months (on average)

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Thank you for your attention