



Session 1

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

Japan Patent Attorneys Association
International Activities Center

S1 The Characters

US attorney: Houston : Yuichi Watanabe
San Diego: Mark Abumeri

JP Patent attorney ①: Hiroyasu Ninomiya

JP Patent attorney ②: Shusa Endoh

Narrator and Commentator: Toshinori Tanno

S2-1 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 were allowed.
- For the Japanese application, a request for PPH was filed with the US allowed claims and the JP application was also granted.

S2-2 Outline

- 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 the 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 “nano-cellulose fiber Ink ballpoint” that is distributed.



S4 E-mail from Harvey

Subject: Inquiry – US and JP patent application

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

Fr: Harvey@*****

1. The features of invention are the following;
 - 1) aqueous ink composition contains nano-cellulose fiber.
2. Sales schedule
 - US : in one month
 - JP : in a few years, depending on sales forecasts
3. Tell me the procedure for filing JP patent application.
4. Tell me official fee and attorney fee.
5. Tell me the patent registration official fee and annuity fee.

S5 Nino IP firm in Japan



S6 You got a mail



S7 E-mail from US attorney

Subject: Inquiry – JP patent application

To : Nino@*****

Fr: US@*****

Hi Mr. Ninomiya and Ms. Endoh,

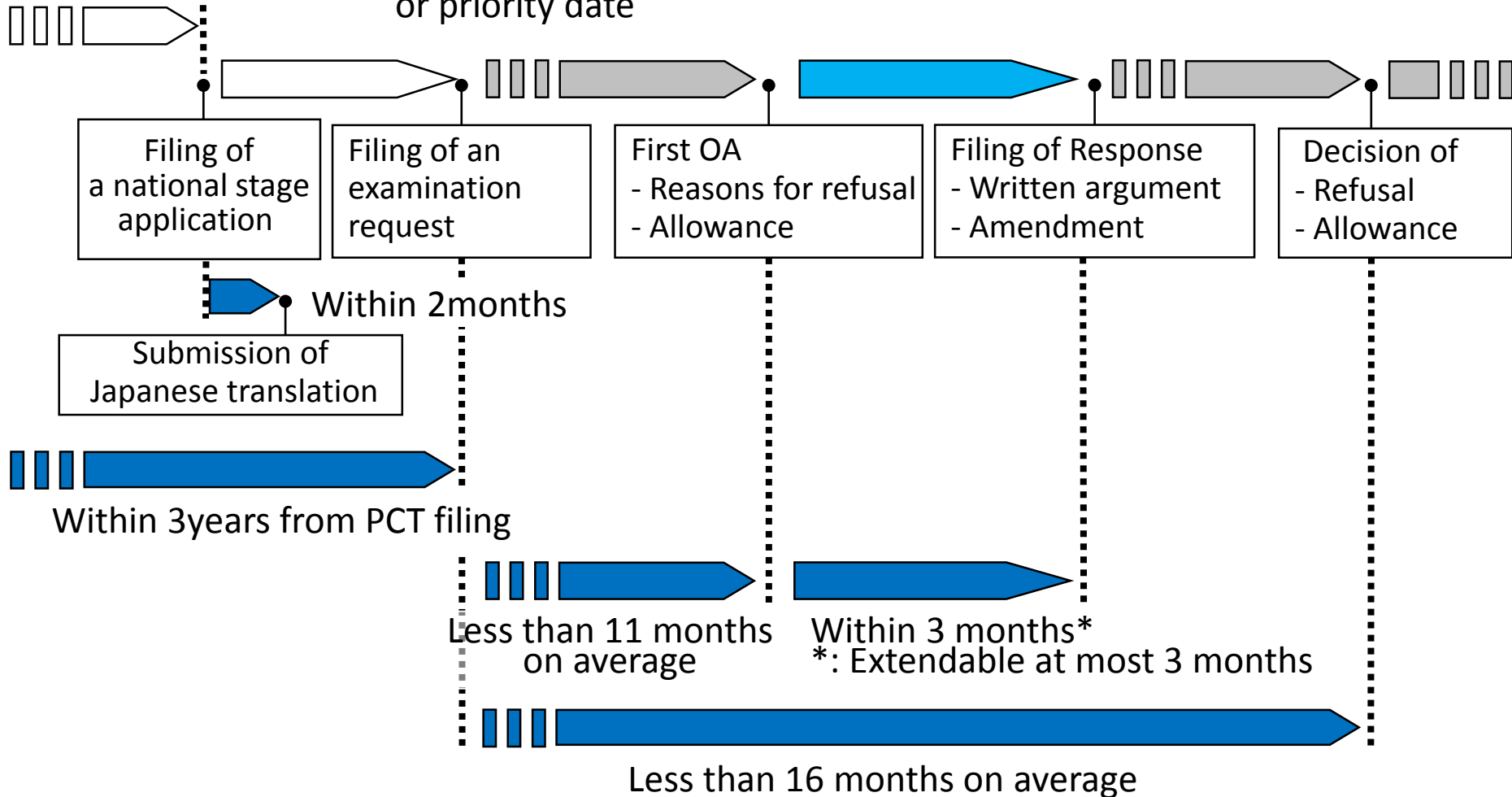
Mr. Harvey Reginald Specter who founded his corporate empire based on inventions is interested in filing a patent application in Japan. Please send me the following information.

1. The procedure for filing a JP patent application.
2. Official fee and attorney fee.
3. The patent registration fee and annuity fee.

S8-1 Timeline of Examination Procedure

◆ PCT National Stage Application

Within 30 months from PCT Filing or priority date



S8-2. 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.

S9 Costs to Obtain Patent

- ◆ Cost to file a patent application
 - USD124 (≒JPY 14,000)
 - USD195 (≒JPY 22,000) for foreign language application
- ◆ Cost to file an examination request
 - Convention application(Direct application)
USD1,044(≒JPY118,000)+USD35(≒JPY4,000) × Number of claims
 - PCT National Stage Application(National phase entry in Japan)
USD938(≒JPY 106,000)+USD 32(≒JPY 3,600) × Number of claims
- ◆ Typical attorney service fee for filing a JP patent application

USD 3,000 to USD 6,000

The translation fee increases depending on the number of words in the application.

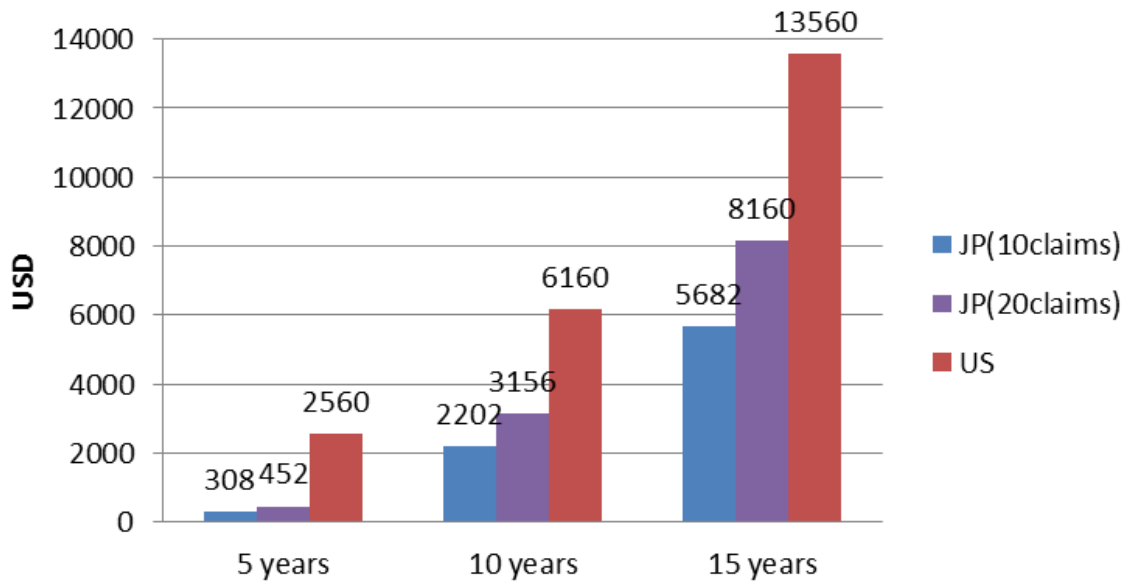
In case of Bio or ICT invention, USD 5,000 to USD 12,000 because of many words.

S10 Official fees of patent registration and maintenance

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

S11 Comparison of the maintenance fees between USPTO and JPO

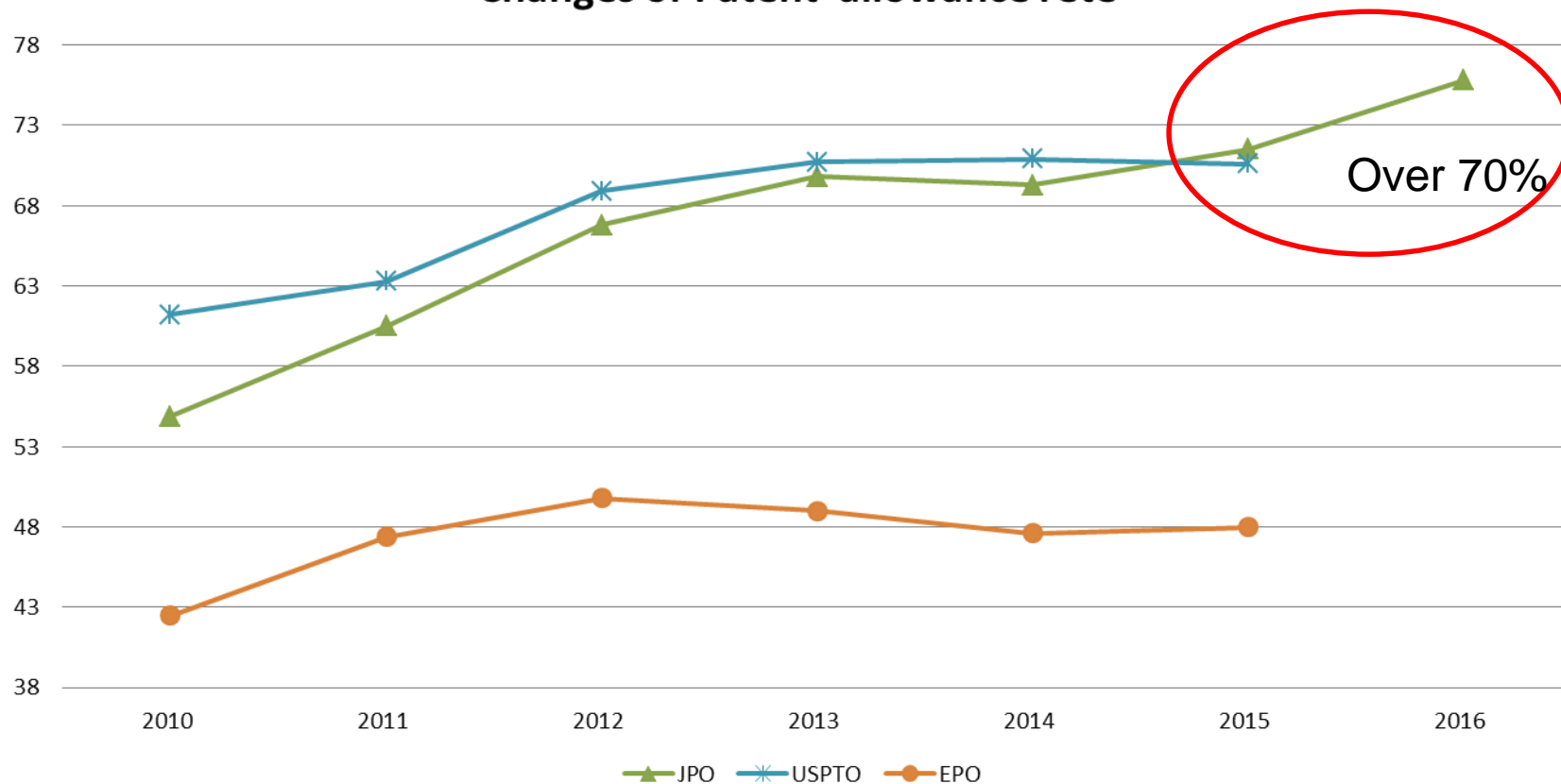
Comparison of Maintenance fees



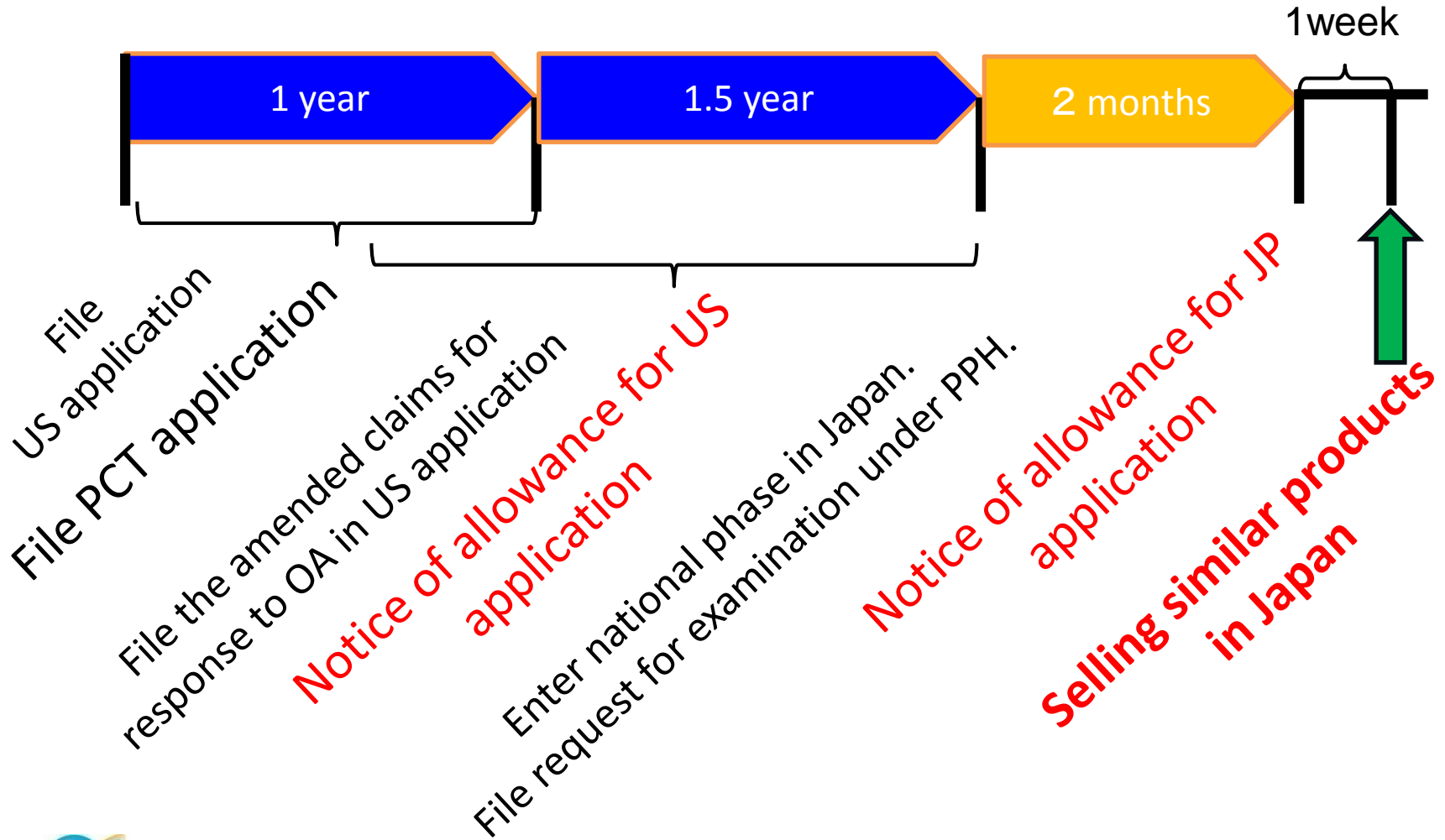
USPTO	Maintenance fees
Registration fee	USD 960
Due at 3.5 years	USD 1,600
Due at 7.5 years	USD 3,600
Due at 11.5 years	USD 7,400

S12 Allowance rate of US, JP, and EPO

Changes of Patent allowance rete



S13



S14-1 E-mail from US attorney

Subject: **Urgent** Inquiry – Divisional application

To : Nino@*****

Fr: US@*****

Hi Mr. Ninomiya and Ms. Endoh

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.

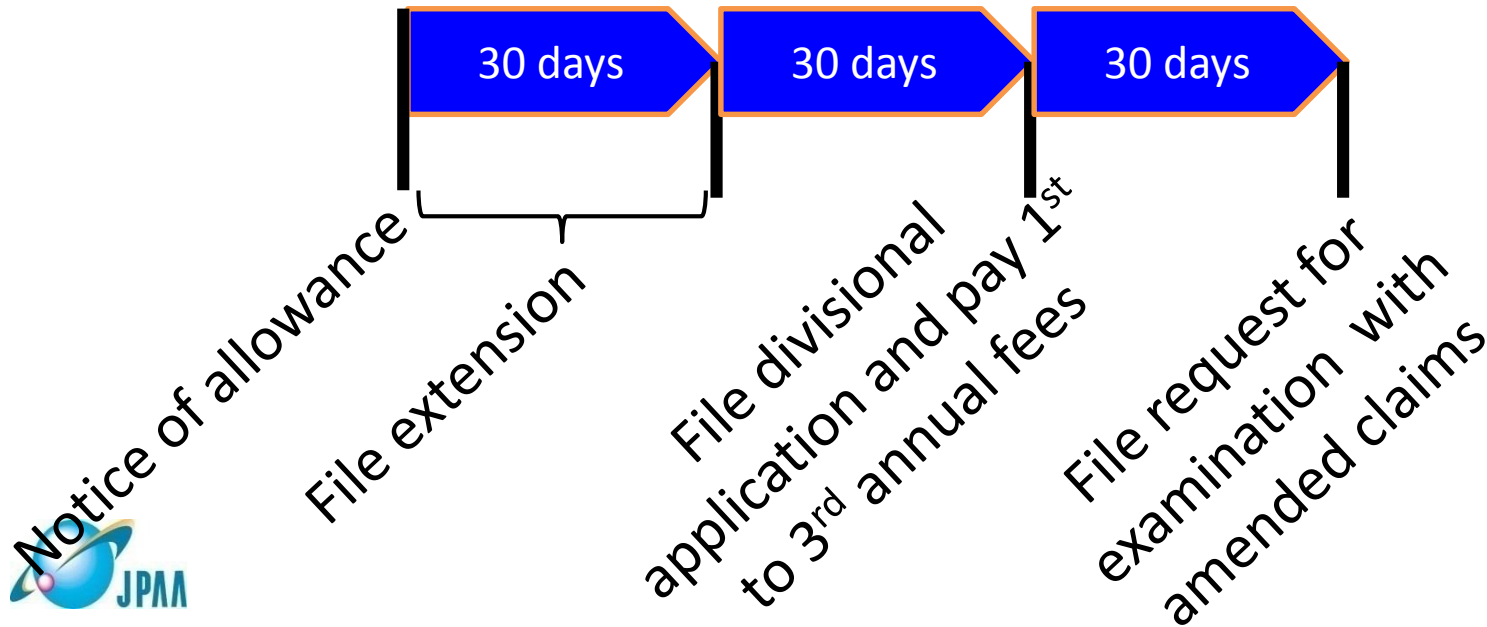
What can we do? **Is there something similar to a continuation application in Japan to obtain additional patent coverage?**

S14-2 You got a mail



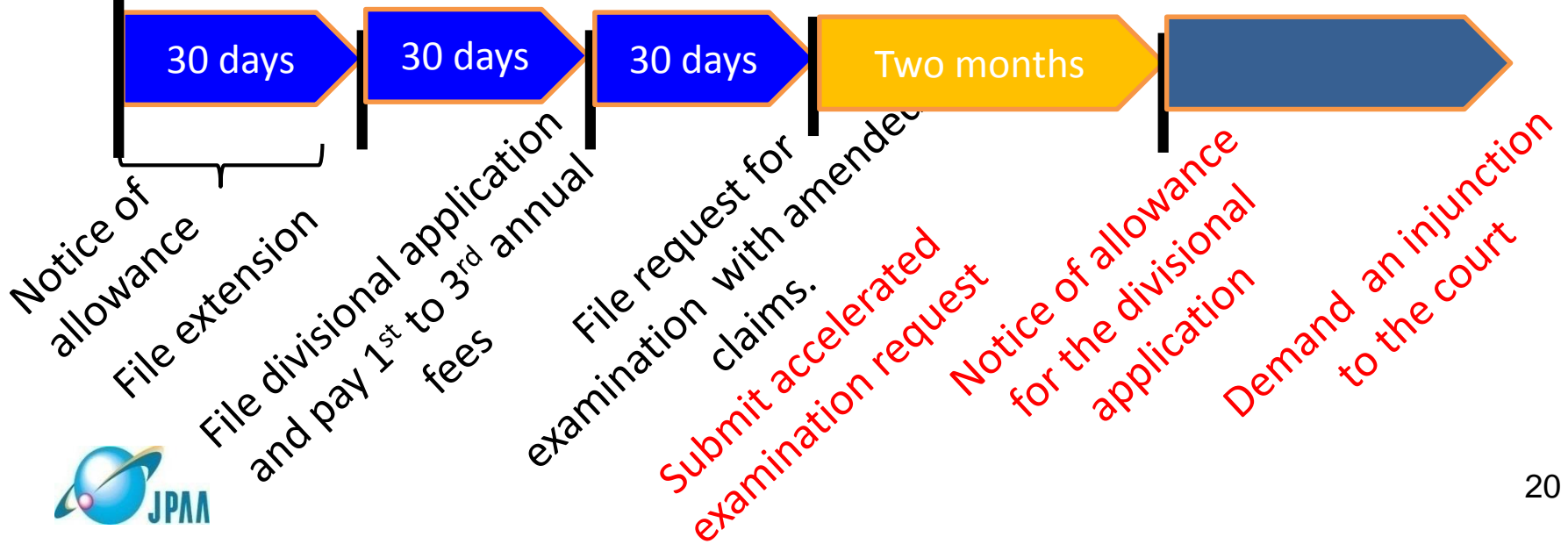
S15

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 accelerating examination **can be submitted (1stOA: 2mos)**



S16 about going from filing the divisional application to grant and injunction.

- 1. Request for 30 days extension was filed within 30 days from the allowance.
- 2. Divisional application with the original claims was filed within 60 days from the allowance.
- 3. Request for examination was **made** 30 days from the filing of the divisional application. Also, **the request for accelerating examination** was submitted at the same time. The claims were amended so as to include the similar products in the scope of patent claims when filing the request for examination.
- 4. The divisional application was allowed.
- 5. Filed **before** a court an injunction forbidding the competitor selling the products.
- 6. Excluded the infringing products from the Japanese market



S17 Summary: Key Points

- Allowance Rate in Japan is **over 70%** , in 2015 to 2016
- PPH is available based on the US allowed claims (Allowance Rate: more than 80%, 1stOA: 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 in Japan is low

Please see JPAA web site

- JPAA Home page site in English

<http://www.jpaa.or.jp/old/?cat=546>

- Japanese Patent Law

<http://www.jpaa.or.jp/old/?cat=666>

- Individual Question for Japanese Patent Law

http://www.jpaa.or.jp/old/?p=22559%20target=_blank



Thank you for your attention

We very appreciate to fill out the survey !!