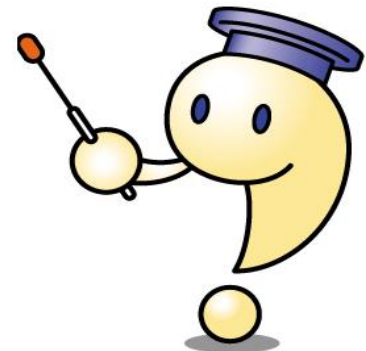




Japan Patent Attorneys Association

Overview of Japanese Patent Prosecution including Recent Updates and Practical Tips

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Agenda



1. General flow

- from Filing to Decision of Grant/Refusal

2. Updates and Tips - Filing to 1st OA

3. Updates and Tips - Response to OA

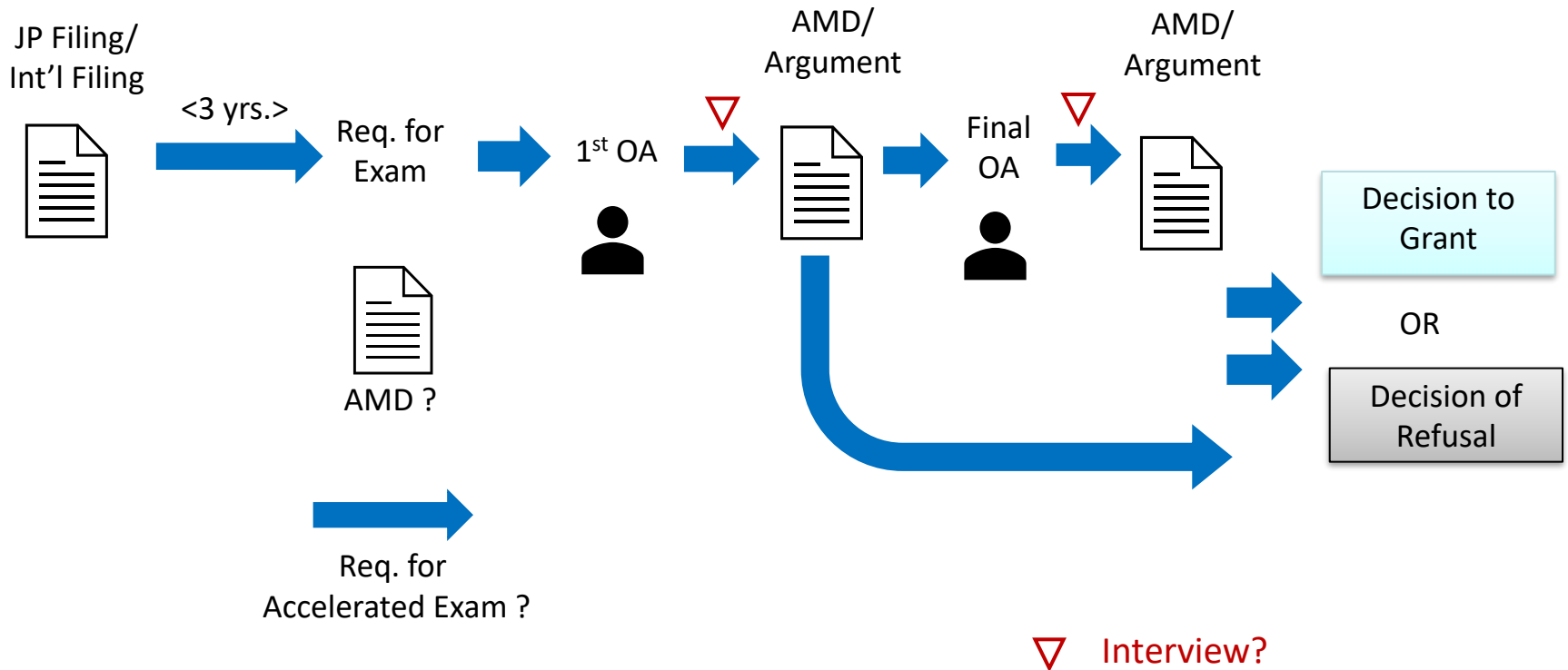
4. General flow - after Decision of Refusal

5. Updates and Tips

- Suspension of Examination of Divisional

1. General flow

from Filing to Decision of Grant/Refusal



Agenda



1. General flow

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2. Updates and Tips - Filing to 1st OA

– Request for Examination–

Topic A: Official fee Reduction



<For those qualified>

- ◆ Official fee reduction/exemption program for SME's (Small & Medium Enterprises), universities, etc.



No
proofs
needed

- 👉 Don't forget to report the applicant's status to the local attorney

https://www.jpo.go.jp/system/process/tesuryo/genmen/genmen20190401/document/index/leaflet_e.pdf

2. Updates and Tips - Filing to 1st OA

– Request for Examination–

Topic A:

Official fee Reduction

Examination Fee
= basic fee + additional
fee/claim

Tip 2

<For Anyone>



Use multiple dependent claims,
even across different categories

1. A composition comprising A, B and C.
2. The composition as claimed in Claim 1, further comprising D.
3. The composition as claimed in Claim 1, further comprising E.
4. A process for manufacturing the composition as claimed in any one of Claims 1 to 3, comprising a step...
5. A method for using the composition as claimed in any one of Claims 1 to 3 as anti-fouling paints for ship bottoms.

2. Updates and Tips

Update 1

Caution!

👉 A multiple dependent claim, dependent from a multiple dependent claim (multi-multi), will not be subjected to a substantive examination (from the application filed on or after April 1, 2022) (Art. 36(6)(iv))

👉 An amendment to remove multi-multi dependency as a response to OA will lead to a final office action.

<https://www.jpo.go.jp/e/system/patent/shinsa/multimulticlaims.html>

2. Updates and Tips – Filing to 1st OA

– Voluntary Amendment ? –

Topic B: “Computer program”

- ◆ “Computer program” is an eligible product invention, even if it is not stored in a medium (since 2002)
- ◆ “Computer software,” “Data structure,” etc., are as well (products considered equivalent to a computer program)

Patent Eligible Inventions:

- “Product”
- “Process” (so-called “simple method”)
- “Process for producing a product”

2. Updates and Tips - Filing to 1st OA

–Voluntary Amendment ? –

Topic C: Limitation of use (i.e., intended use)

Prior Art

....a fishing hook
in the form of ..

Present Inv.

....a crane hook
in the form of
..

⇒ the examiner recognizes that the crane hook has a structure suitable as a crane hook (e.g., proper size and strength), and is structurally different from a fishing hook.

2. Updates and Tips - Filing to 1st OA

–Voluntary Amendment ? –

Tip 3

👉 Consider a voluntary amendment of:

- a computer software claim
- a limitation with intended use

👉 Voluntary amendment can be filed before 1st OA

◆ Examination guidelines amended in 2016 for the use claims especially of Foods

⇒ improved the chances of grant.

2. Updates and Tips - Filing to 1st OA

Topic D: Accelerated Examinations

First Action (FA) pendency on average (as of 2022)
- a period from request for exam. to first OA -

All Patent Applications	10.1 months (as of 2021)
PPH	2.3 months
Accelerated Examination	2.3 months
Super Accelerated Examination	0.6 months *1.4 months for PCT JP national phase

2. Updates and Tips - Filing to 1st OA

Requirement to be eligible for accelerated examinations:

Accelerated examination	Super accelerated examination
<p>Either Any one of (1) to (6) is required:</p> <ul style="list-style-type: none">(1) Already commercialized or to be commercialized within 2 years(2) A foreign counterpart existing(3) Applications filed by SMEs, etc.(4) Green-technology related applications(5) Earthquake Disaster Recovery Support-related applications(6) The Asian Business Location Law-related applications	<p>All (1) to (3) are required:</p> <ul style="list-style-type: none">(1) Already commercialized or to be commercialized within 2 years(2)<ul style="list-style-type: none">(2a) A foreign counterpart existing, or(2b) filed by startups.(3) all filing procedures have been performed “online” at least for the most recent 4 weeks

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3. Updates and Tips - Response to OA

Topic E: Support Requirement

“A claimed invention shall be disclosed in the description” (Article 36(6)(i))

- ◆ The examiner will compare the claimed invention with the invention disclosed in the description to determine whether the support requirement is satisfied.
- ◆ “Substantial” support for the claimed invention should be found in the description.
- ◆ The object of the invention is considered for comparing the claimed invention with the disclosure.

3. Updates and Tips - Response to OA

Four types of Violation of Support Requirement

- (1) No statement or implication of claimed elements in the description
- (2) Unclear correspondence of terms used in the claims and the description
- (3) Over-broad or over-generalized claims
- (4) No recitation of elements necessary for solving the problems discussed in the specification

https://www.ipo.go.jp/e/system/laws/rule/guideline/patent/tukujitu_kijun/document/index/02_0202_e.pdf

3. Updates and Tips - Response to OA

<Example of Type (3)>

- ◆ The claim recites many types of compound R.
- ◆ The description discloses no specific examples other than novel compounds R1, R2, and R3 (species of Compound R.) Specific chemical structures and effects are written only for Compound R1, R2, and R3.

**Do we need to limit
Compound R to
R1, R2 and R3 ???**

3. Updates and Tips - Response to OA

<Example of type (4)>

◆ The claim recites

“...a force adjusting unit that adjusts the force required to operate an acceleration mechanism...”

◆ The description only discloses a mechanism that increases the force needed to push the accelerator pedal further as speed increases.

[Object of the Invention]

To prevent an automobile from exceeding the speed limit.

3. Updates and Tips - Response to OA

Tip 4

For responding to type (3)/(4) rejection:

◆ Amendment to the embodiment might be reasonable for some cases, BUT before that,

👉 Consider an argument for explaining that the discussion in the specification can be generalized to the scope of the claimed invention, in light of common general knowledge at the time of filing (priority date).

👉 Consider the submission of experimental results.

3. Updates and Tips - Response to OA

Tip 5

Topic F: Clarity Requirement

“A claimed invention for which a patent is sought shall be clear” (Article 36(6)(ii))

👉 Terms such as “about,” “approximately,” “substantially,” “essentially,” “especially,” “for example,” “etc.,” “preferably,” and “suitably” would be rejected.

👉 **Please use SI units** (International System of Units), such as “m,” “km,” “g,” “kg.”

“inch,” “feet,” “yard,” “pound,” “ounce” etc. will be rejected.

3. Updates and Tips - Response to OA



So kind♥

Topic G: Interview with the Examiner



Tip 6

JPO examiners are open to:

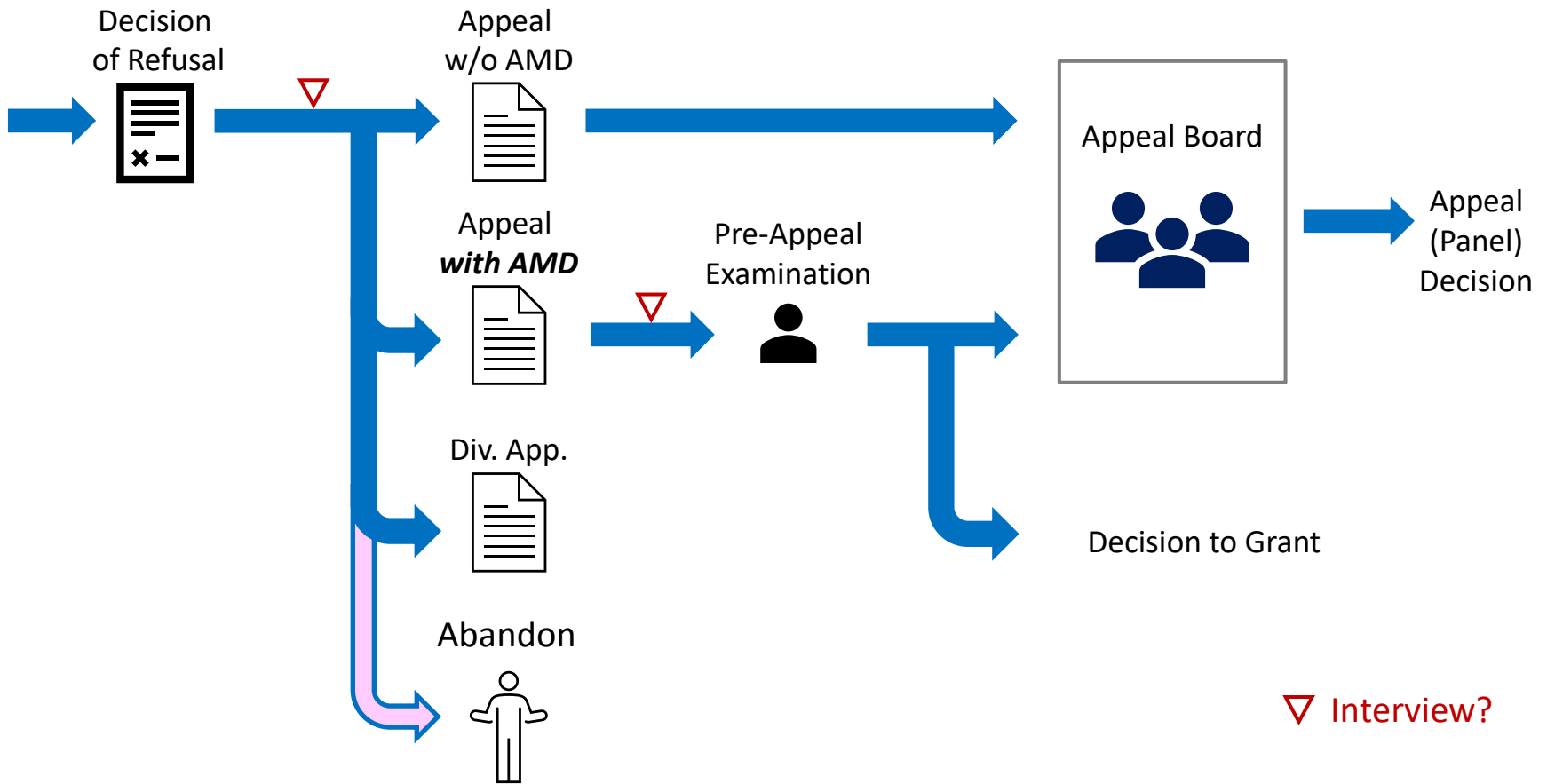
- (1) hold an interview at the JPO building
 - (2) hold an on-site interview (examiner travels to the applicant's location to conduct an interview upon request, beneficial for showing the product or factory to the examiner)
 - (3) online interview (Telephone/Web Meeting)
- ◆ Examiners may provide you with a good hint on how to amend a claim.

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5. Updates and Tips
 - Suspension of Examination for Divisional

4. General flow after Decision of Refusal



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5. Updates and Tips – After Appeal

Update 2

Topic H: Suspension of Examination

- ◆ When both an appeal request and divisional application are filed, the examination of the divisional application can be suspended, upon request.
 - ◆ Suspension will be maintained until 3 months after the service date of decision of the pre-/appeal, etc.
-
- ◆ Useful to decide the strategy for the divisional application, after the conclusion of the appeal case.
 - ◆ If the divisional application becomes unnecessary, withdraw it quickly to request the refund of the examination fee.

Tip 7

5. Updates and Tips - After Appeal

Conditions:

- (i) request for examination for the divisional application was filed on or later than April 1st, 2023,
- (ii) the examination for the divisional application has not yet been started,
- (iii) the divisional application was filed after Decision of Refusal made to the “parent” application
- (iv) the “parent” application is pending to the appeal or pre-appeal, and
- (v) it is considered convenient to wait for the outcome of the appeal.



Thank you!!



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