



Patent Practices in Japan

Tatsuya Hanasaka
Japan Patent Attorneys Association
International Activities Center



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Patent Practices in Japan

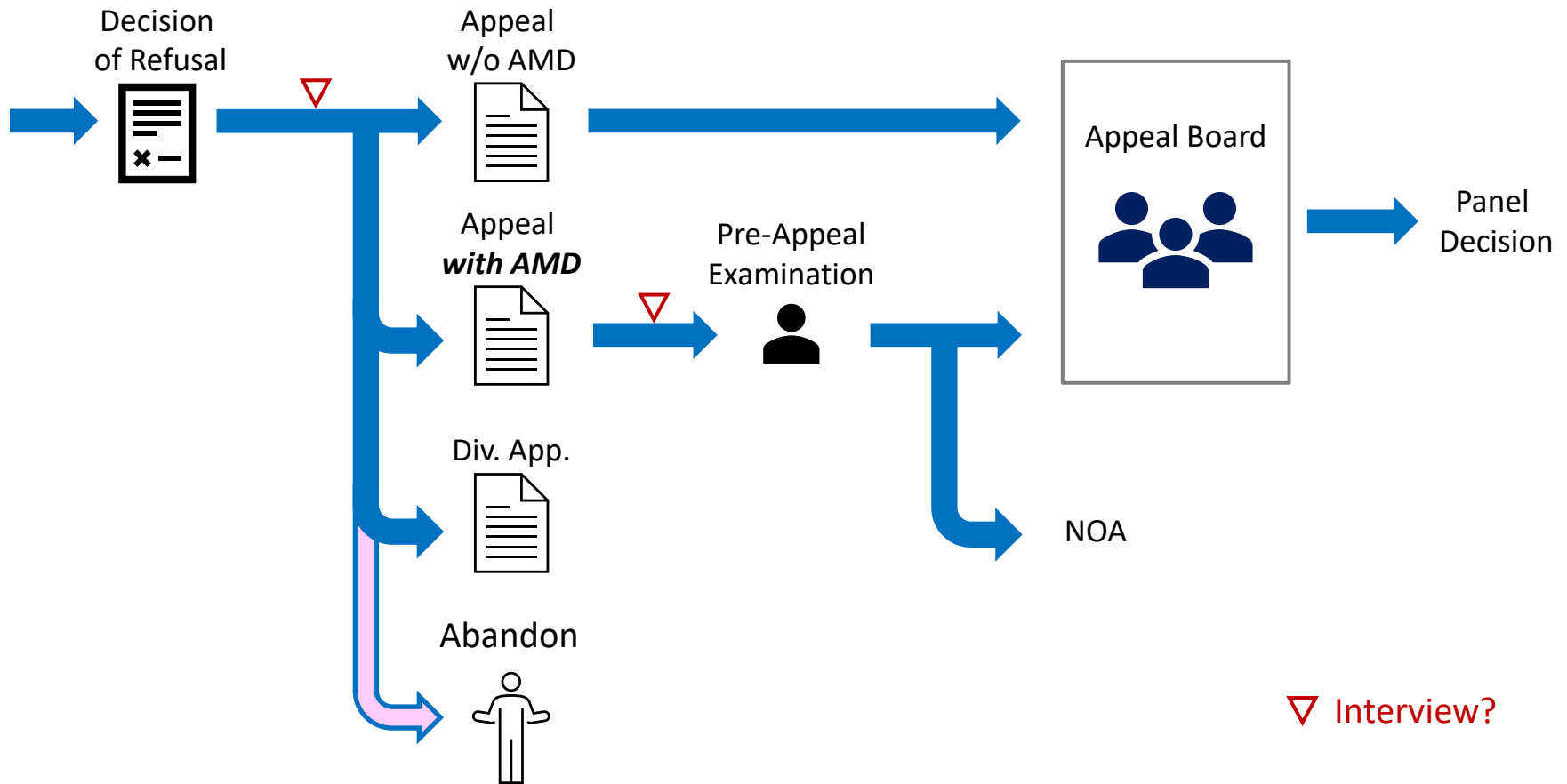
Overview

1. General Appeal Procedures
2. Recent Changes in Practice

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2. Recent Changes in Practice

General Appeal Procedures



General Appeal Procedures

The purpose of claim amendments after a decision of refusal must fall within one of the following:

- (1) Canceling claims
- (2) Narrowing claims in a limited way
- (3) Correcting errors
- (4) Clarifying alleged ambiguous recitations

Patent Act Art. 17-2(5); Ex. GL. Part I Ch. 2 Sec. 6, 3.1.3.

- 👉 A program like an RCE is **not** available in Japan.
- 👉 A response to a final OA can be critical.
- 👉 Consider conducting an examiner interview
- 👉 A divisional application may be an option to reset the prosecution.

General Appeal Procedures

- (1) Canceling claims
 - (2) Narrowing claims in a limited way
 - (3) Correcting errors
 - (4) Clarifying alleged ambiguous recitations
- Is it possible to submit an amendment that substantially increases the number of claims, as long as the amendment does not expand or change the scope of claims for patent?

General Appeal Procedures

No!

- An amendment which divides an invention recited in a single claim into multiple claims and adds new claims **does not** correspond to the “restriction of the scope of claims for patents.” (Even if the amendment as a whole restricts matters specifying the invention recited in one claim.)

Exceptions:

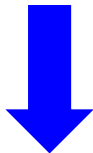
- A single claim recited in multiple dependent form is made into a claim in independent form with cited claims reduced.
- A single claim whose components are recited as alternatives is made into multiple claims with each of the alternative components restricted.

General Appeal Procedures

NG

Claim 1: A pen comprising A.

Claim 2: A pen according to claim 1, further comprising B and C.



Claim 1: A pen comprising **A and B**.

Claim 2: A pen comprising **A and C**.

General Appeal Procedures

OK

Claim 1: A pen comprising A.

Claim 2: A pen according to claim 1, further comprising B.

Claim 3: A pen according to claim 1 or 2, further comprising C.



Claim 1: A pen comprising A.

Claim 2: A pen according to claim 1, further comprising B.

Claim 3: A pen according to claim 2, further comprising C.

Claim 4: A pen comprising A and C.

General Appeal Procedures

Also OK

Claim 1: A pen comprising A.

Claim 2: A pen according to claim 1, further comprising B.

Claim 3: A pen according to claim 1 or 2, further comprising C.



Claim 1: A pen comprising A.

Claim 2: A pen according to claim 1, further comprising B.

Claim 3: A pen according to claim 1, further comprising C.

Claim 4: A pen according to claim 2, further comprising C.

General Appeal Procedures

- When can amendments associated with a request for appeal against a decision of refusal and divisional application be filed?

General Appeal Procedures

Amendments

- At the time of requesting an appeal against an examiner's decision of refusal, it is possible to amend the description, the scope of claims for patent, or drawings attached to the patent application, at the same time as the request for an appeal.

Divisional Application

- Regardless of the request for an appeal, a divisional application can be made within 3 months from the decision of refusal.

General Appeal Procedures

- Is it possible to receive an extension of the period for filing a request for an appeal examination?

General Appeal Procedure

No!

- A request for the extension of the period **will not** be approved.
- For overseas applicants, the appeal period against a refusal decision is automatically extended to within 4 months from the delivery date of the examiner's decision of refusal.*
* Some exceptions apply
- You do not have to submit a written request for the extension of the period.

Overview

1. General Appeal Procedures
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Suspension of Examination

Situation:

A patent application was subjected to Decision of Refusal.

1. Appeal against the Decision of Refusal is filed.
2. Divisional application is also filed.

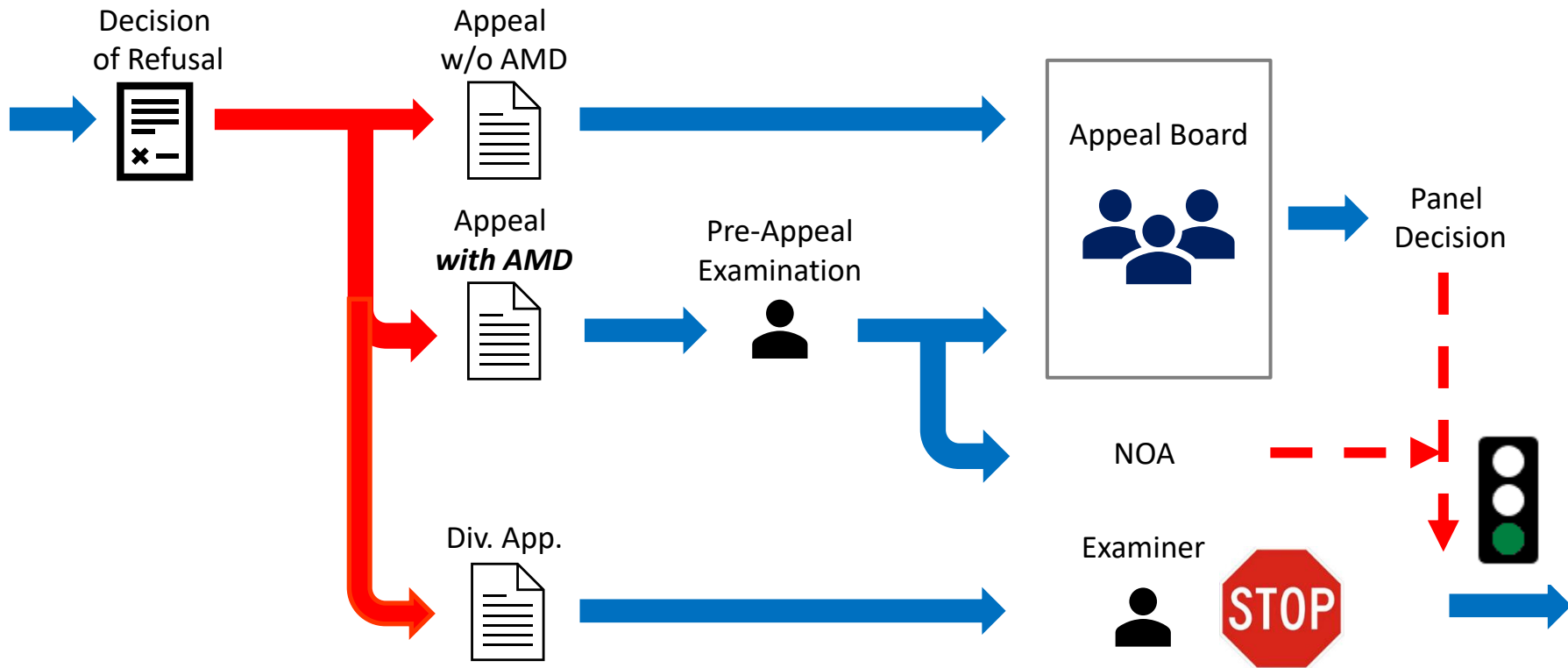
Suspension of Examination

It may be preferable for the examination of divisional application to be suspended until the appeal case is concluded.

The applicant will have the flexibility to consider:

- The optimal claim scope for the divisional application at a later stage.
- Even choose to abandon the divisional application if necessary.

Suspension of Examination



Suspension of Examination

Conditions:

- The examination of divisional application has not yet been started.
- The divisional application was filed after Decision of Refusal made to the “parent” application.
- Appeal against the Decision of Refusal to the “parent“ application was filed, and the “parent” application is pending to the appeal or pre-appeal.
- It is considered convenient to wait for the outcome of the appeal case.
- Request for examination for the divisional application was filed on or later than April 1st, 2023

Suspension of Examination

How to Request:

- A First Statement through a regular JPO filing system (or by post), and
- A Second Statement through a special form found on a JPO website.

- The first statement and second statement are for explaining why the examination for divisional application should be suspended.
- It is necessary to request the suspension within 5 working days from the date of request for examination for the divisional application.

Suspension of Examination

Period of Suspension:

- The examination will be suspended by the day that falls upon 3 months later than any of the following is made with respect to the parent application:
 - (1) Notice of allowance is issued by the examiner at the pre-appeal stage and sent to the applicant.
 - (2) Appeal decision is firstly made and served to the applicant.
 - (3) Appeal is withdrawn or dismissed.

Relief Measures

- The acceptance rate for applications for restoration of rights is over 90% in countries that adopt an “unintentional” standard, and over 60% in countries that adopt a “reasonable care” standard.
- The acceptance rate for restoration in Japan, which had adopted a “legitimate reasons” standard was around 10-20%.



Relief Measures

- The requirements for relief after the lapse of the period have been relaxed from the “legitimate reason” standard to an “unintentional” standard.”
- Procedures that have lapsed after the enforcement date of April 1, 2023, will be subject to the “unintentional” standard.
- A restoration fee is required.

Relief Measures

Procedures Eligible for Relief based on Unintentional Standard

- Translation of an international patent application made in a foreign language.
- Translation of a foreign language written application.
- Claim of priority according to the Paris Convention.
- Request for examination.
- Restoration of patent rights by additional payment of patent fees.



Thank you for your attention!!



Tatsuya Hanasaka

tatsuya.hanasaka@eikoh-patent.gr.jp

Eikoh, P.C.