



Webinar for NYIPLA  
May 29, 2025

# Overview of Japanese Patent Prosecution

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**International Activity Center**

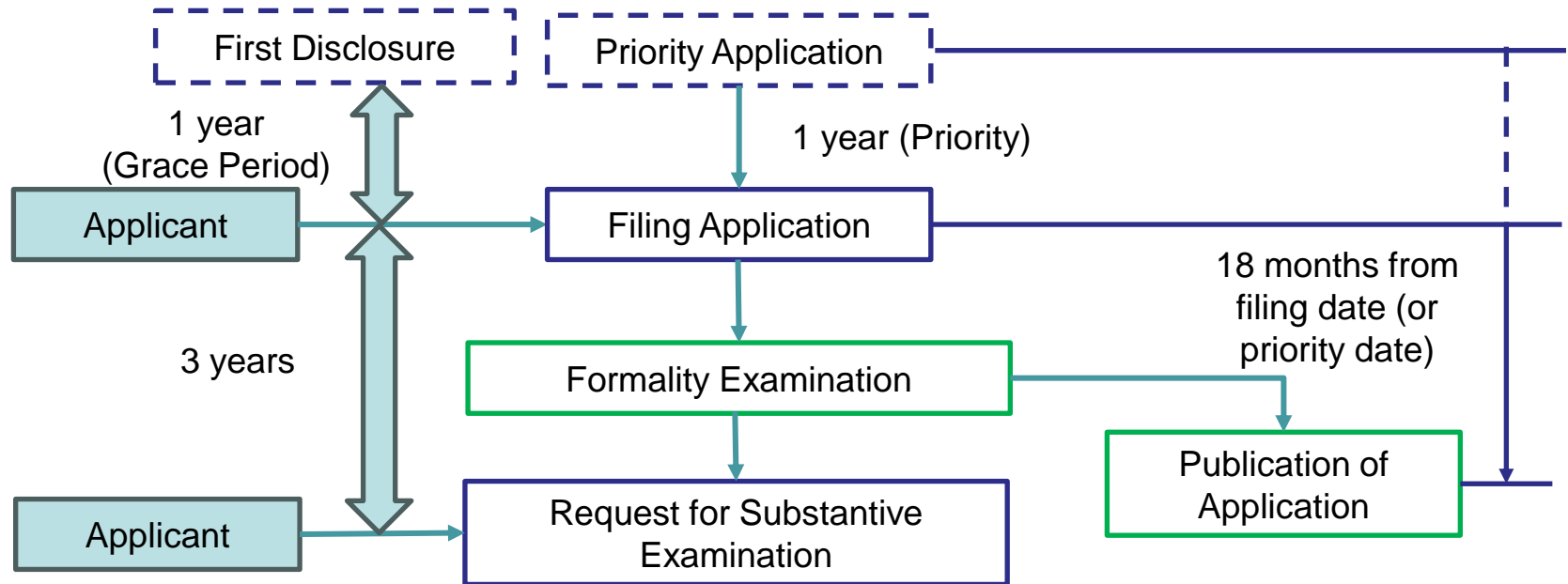
# Topics

- Overview of Patent Prosecution in Japan
- In-Depth Analysis
- Statistics and Trends in Japan

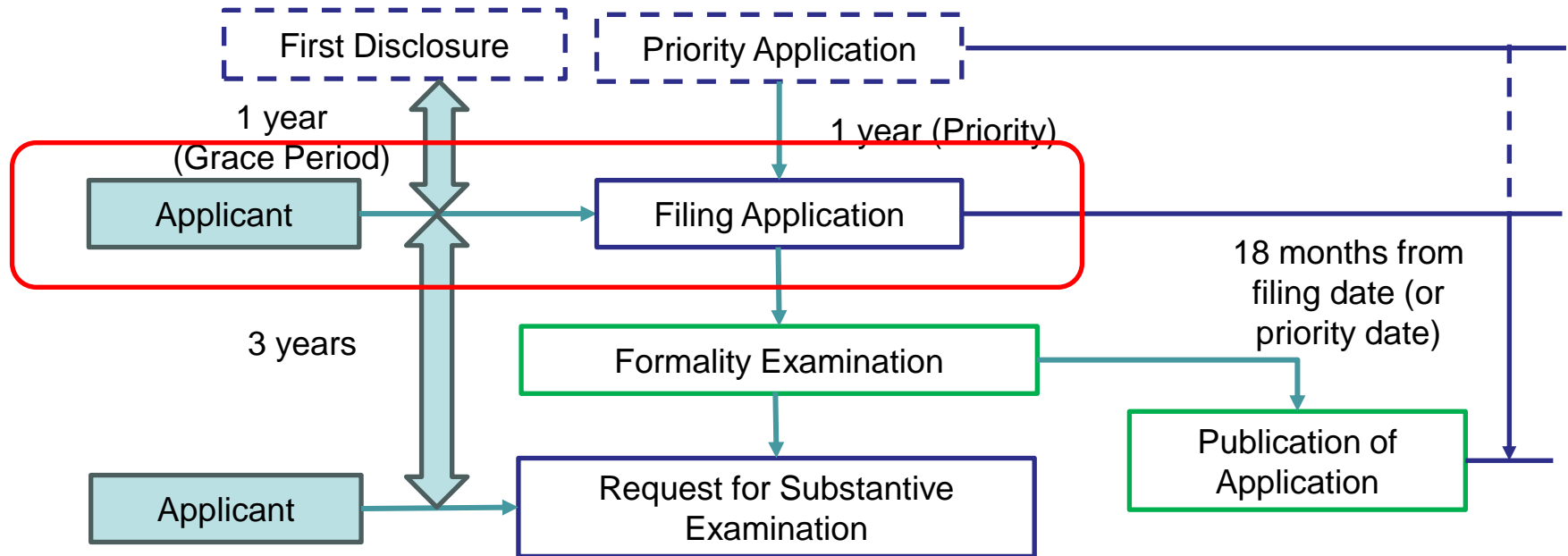
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# A. Filing



# Filing an Application

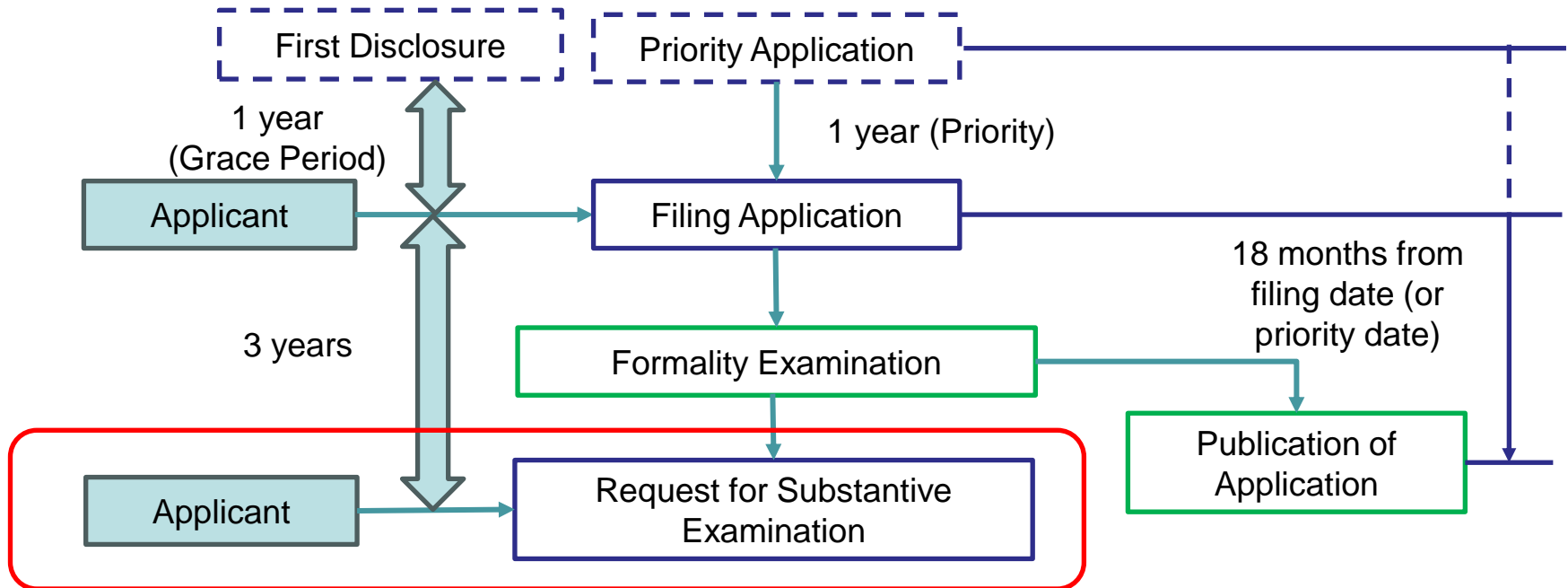


You can file by:

- PCT National Phase Entry: JPY 14,000. Japanese translation due within 2 months of entry.
- Direct Filing in Japanese (with Priority Claim): JPY 14,000.
- Direct Filing in Foreign Language (with Priority Claim): JPY 21,000. Japanese translation due within 4 months of filing.

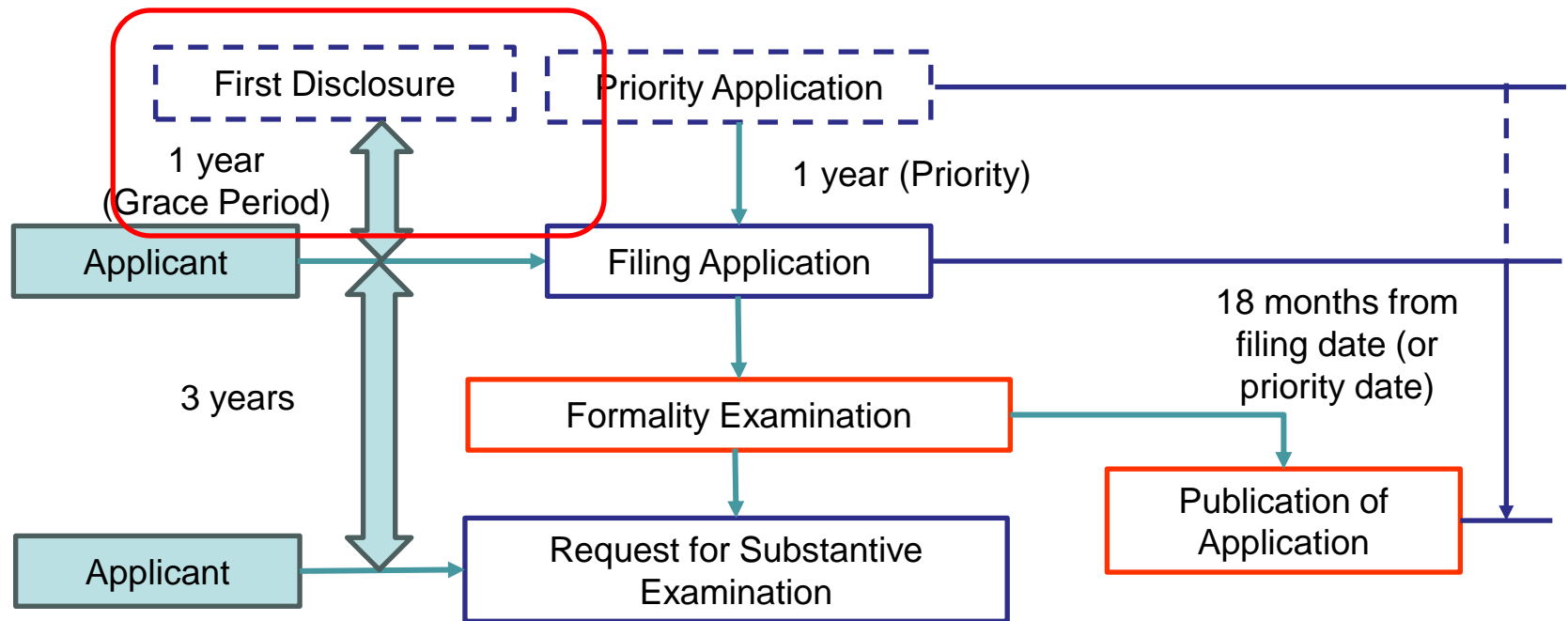
Note: No signed documents required at filing for these procedures.

# Request for Examination



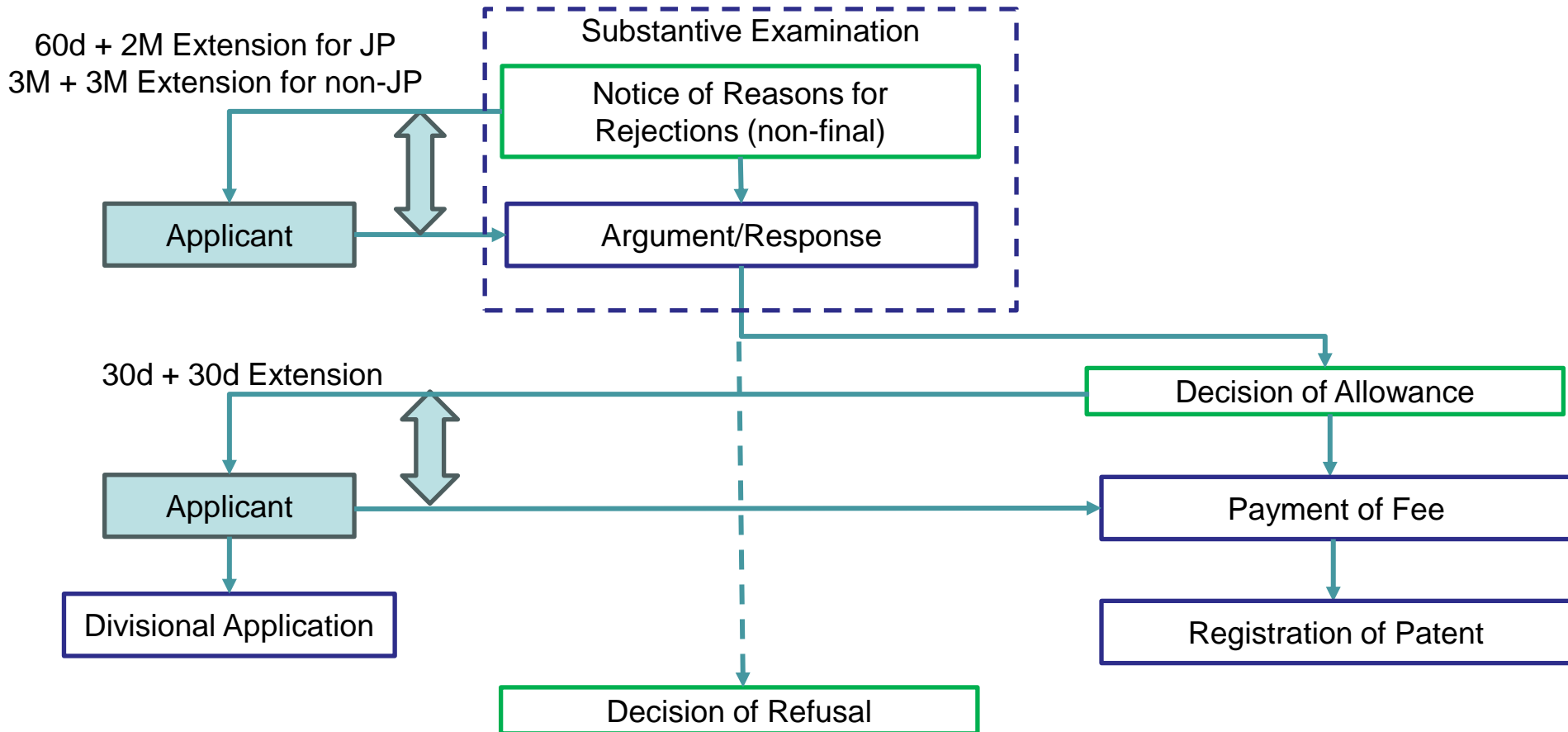
- Examination Request: Must be filed within 3 years of the filing date.
- Claims: No limit on independent claims. Official Fee increases are based solely on the total number of claims.
- Official Fee Discounts: SMEs and universities may receive a 1/3 or 1/2 reduction.
- Accelerated Examination: Program is generally easy to use and has no official fee.

# Grace Period



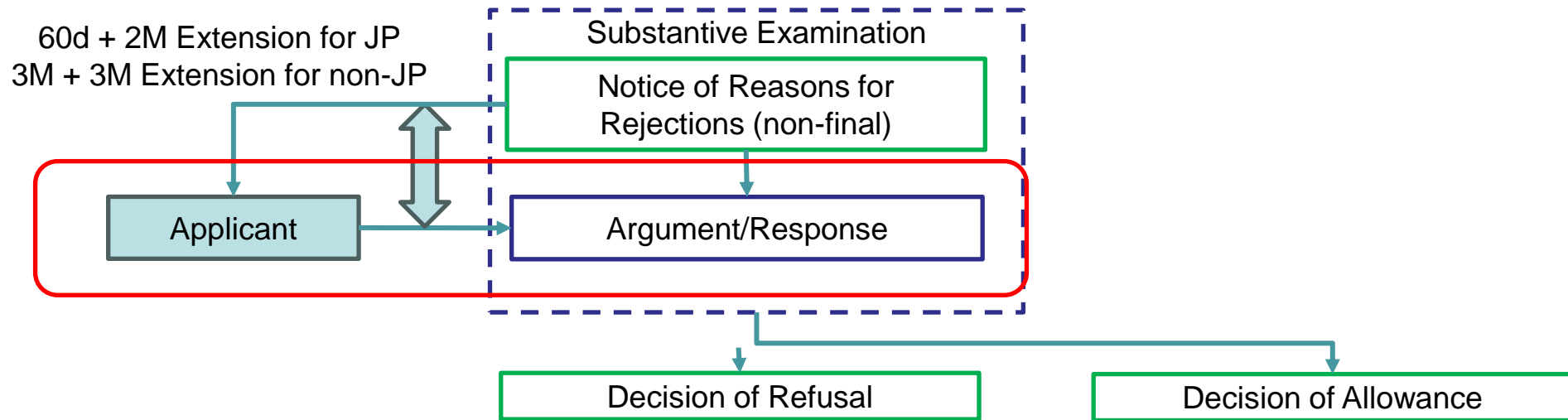
- Grace Period Claim: Must be made at the time of filing.
- Evidence Submission: Within 30 days of the filing date.
- Application Filing (for Grace Period): Within 1 year from the first disclosure (not the priority date).

# B. Examination



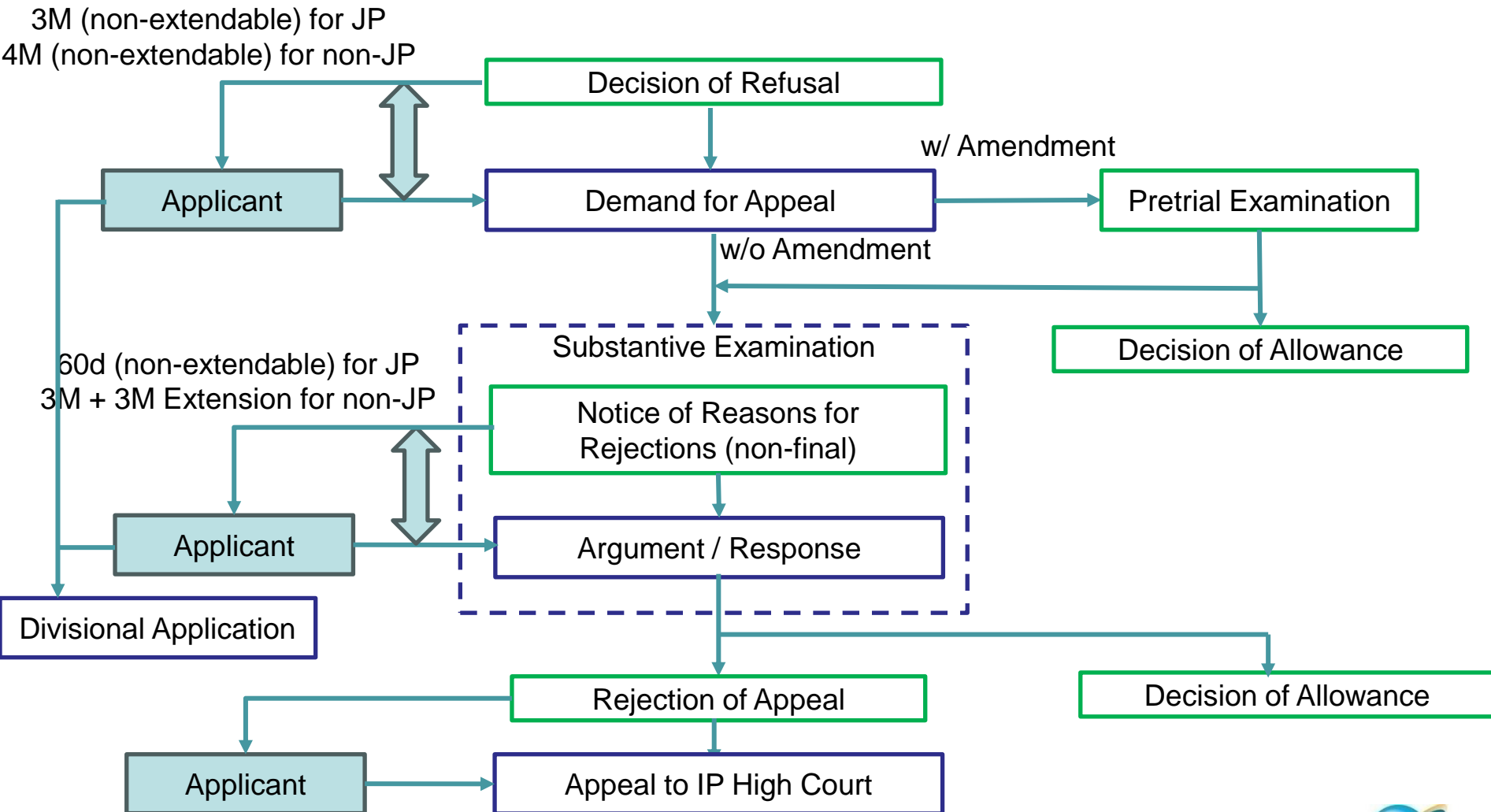


# Response



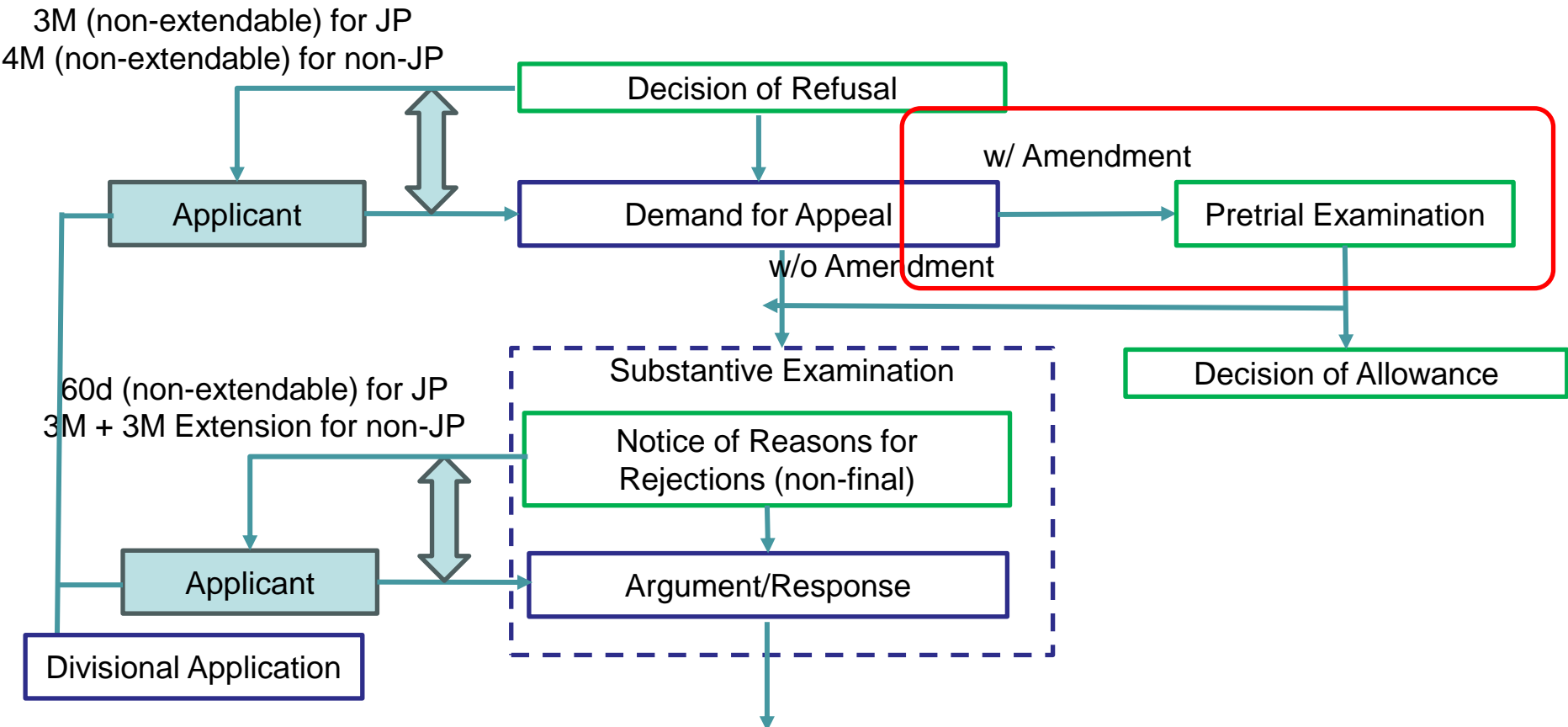
- Amendments (Before 1st Office Action): Can be filed anytime.
- Amendments (After Office Action): Can be filed during the response period.
- Time Extension Request: Possible after deadline, but with a significantly higher official fee.
- Examiner Interview: Requestable; foreign applicants can participate.
- Information Disclosure Statement (IDS): Japan has no IDS-related system.

# C. Appeal



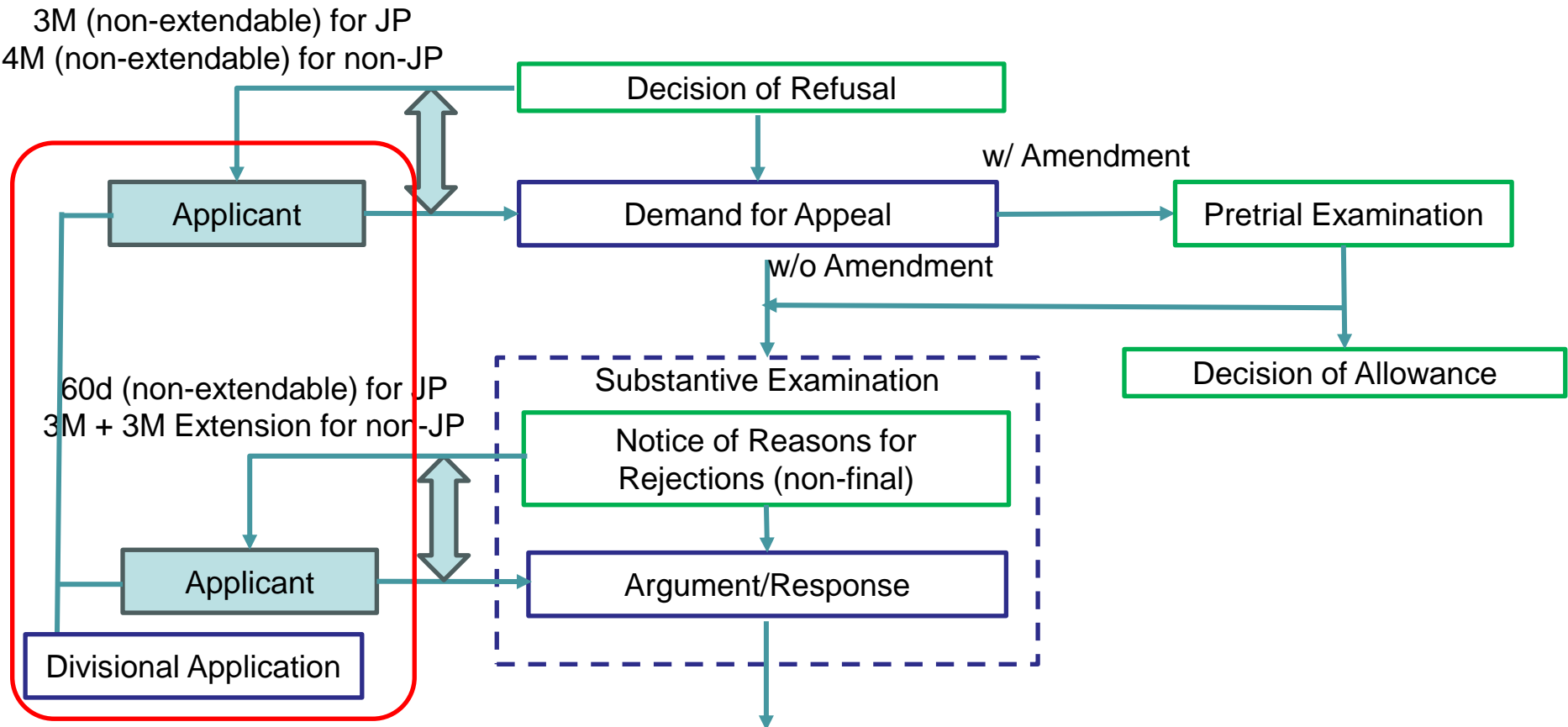
- <sup>10</sup> Power of Attorney: Required for appeals.

# Amendment



- Filing Amendment with Appeal: Possible to file simultaneously.
- Pre-trial Examination: Original examiner reviews amendments filed with an appeal.
- Contacting Original Examiner: Possible before filing an appeal.

# Divisional Applications

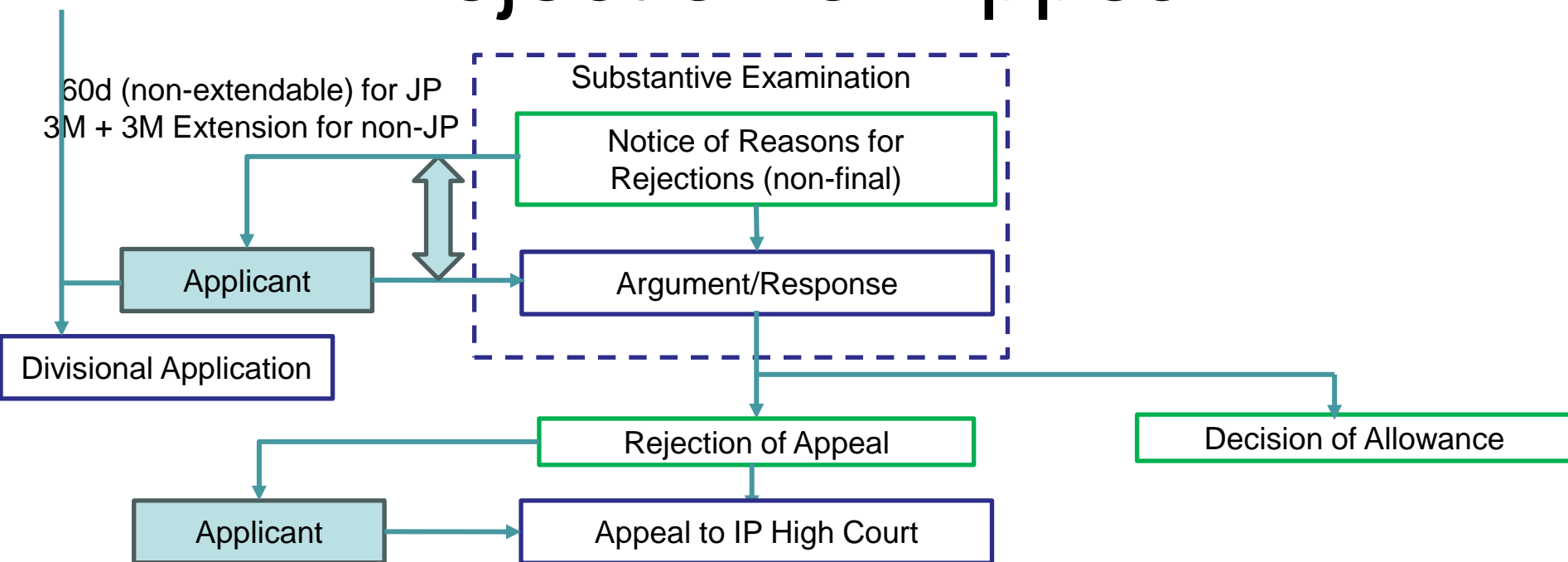


- Next Slide

# Divisional Applications

- Last Opportunities to File:
  - ✓ After Notice of Allowance (NOA): During registration fee payment period (except for an NOA resulting from an appeal).
  - ✓ After Decision of Refusal: Within appeal filing period.  
Note (During Appeal): May also be possible if further refusal reasons are issued.
- Basis of Support:
  - ✓ The original application as filed.
  - ✓ The application as it stands immediately before division, if filed with an appeal.
- Note for Related Systems:
  - ✓ Request for Continued Examination (RCE): Japan has no RCE-related system.

# Rejection of Appeal



- JPO Appeal Success Rate: Approximately 80%.
- Appealing to IP High Court (against JPO's appeal decision): Must be filed within 120 days from the date of the decision.

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# Software

- Claiming Software: It is advisable to clearly demonstrate the use of computer hardware resources.
- Eligibility: No specific eligibility rules are set for software; GUI and business model software are patentable.
- Protectable Claims: Various types of claims are available in Japan.

	Apparatus/ System	Method	Program	Computer readable media	Data structure
US	✓	✓	-	✓	-
JP	✓	✓	✓	✓	✓



# AI

- Software/AI & Business Methods: Generally unpatentable if deemed a "pure business method." Patentable if implemented using specific technical means (e.g., software, hardware).
- Patentable AI Examples: Includes AI algorithms, AI-powered systems/methods for specific problem-solving, AI learning processes, and pre-trained model architectures.
- AI as Inventor: Not permitted.

# Pharma - Prosecution

- Japan:
  - Method of Treatment Claims: Generally not patentable (considered non-statutory).
  - Use-Limited Product Claims: Patentable (e.g., "Composition X for use in treating disease Y").
  - New Medical Compounds: Patentable as substance claims.
- US (Reference):
  - Method of Treatment Claims: Patentable.
  - Product Claims (Compounds): Patentability based on the compound itself; use limitations typically don't make a known compound patentable.

# Pharma - Regulation

- Japan:
  - Patents on New Drugs: No official public listing (like that of the US Orange Book).
  - Generic Drug Approval: Exclusive authority of MHLW/PMDA; approval criteria can be unclear/opaque.
  - Generic Approval Disputes: No specific litigation pathway (like that of the US ANDA litigation).

# Challenging Granted Patents - Opposition/Invalidation

- Post-Grant Opposition
  - ✓ Who Files: Anonymous third party.
  - ✓ Deadline: Within 3 months of the patent's (grant) publication.
  - ✓ JPO Process:
    - JPO reviews the filed opposition.
    - The patentee is given an opportunity to respond and/or amend claims.
    - The opponent's direct involvement is generally limited after the initial filing.
- Invalidation Trial
  - ✓ Who Files: Interested party (cannot be anonymous).
  - ✓ Deadline: Anytime after the patent grant.
  - ✓ Nature: Full inter partes proceeding (i.e., a trial-like procedure with active participation from both sides).
- General Outcome Note
  - ✓ The rate of patent revocation through both opposition and invalidation trials in Japan has been observed to be relatively modest.

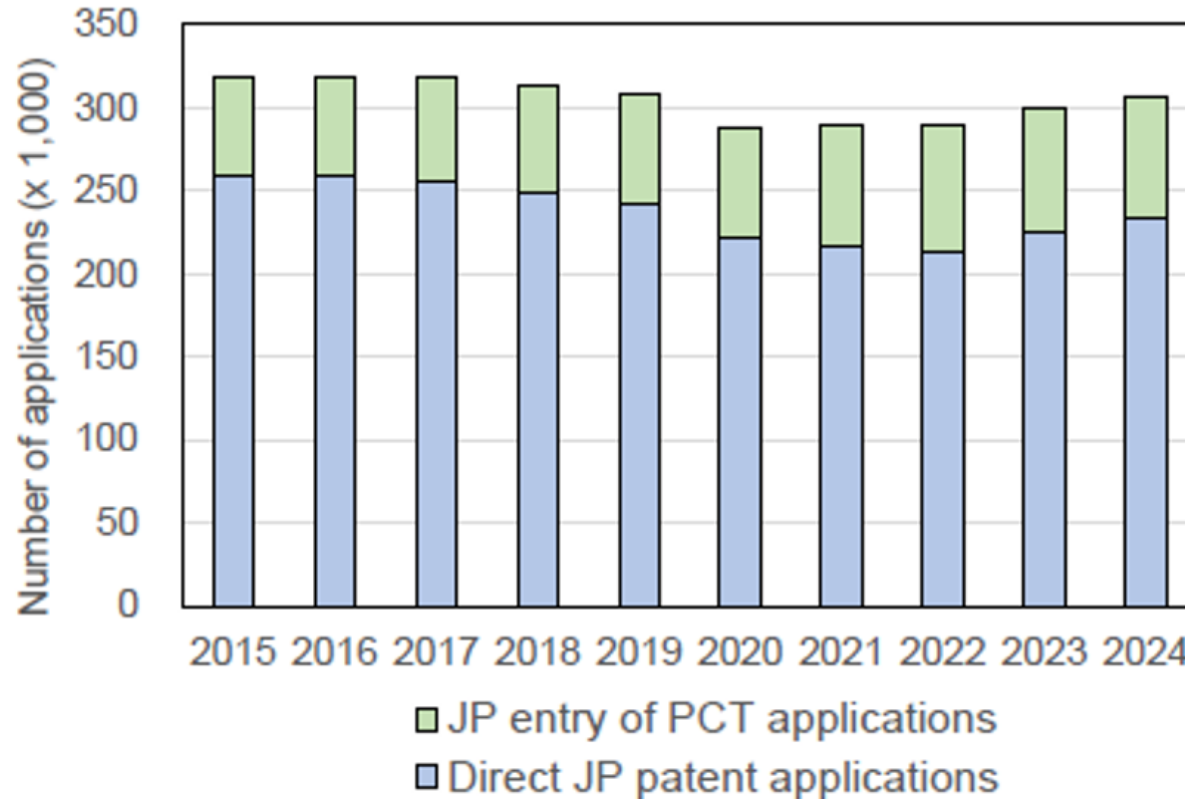
# Others

- Reinstatement of Lapsed Rights
  - Recovery Period: A 1-year period is generally provided for certain missed deadlines (e.g., national phase entry, examination request, annuity payment).
  - Cost for Reinstatement: JPY 212,100.
- Patent Term Extension
  - Due to Examination Delay: May be available for significant delays in the JPO examination process.
  - For Medical/Agricultural Products (Due to Regulatory Approval Delay):
    - Available if patent implementation was delayed by necessary regulatory approvals.
    - Enforcement during the extended term is limited to the specific approved product and its approved use.

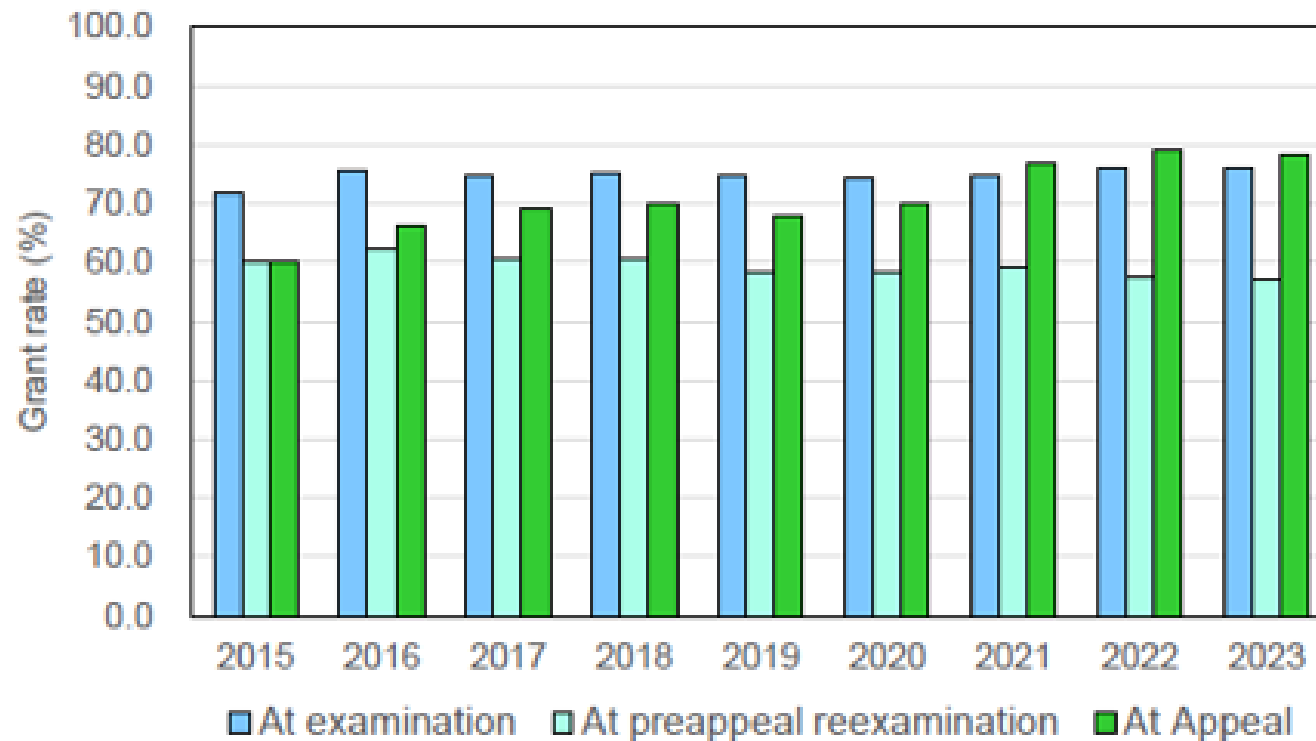
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# Number of Applications

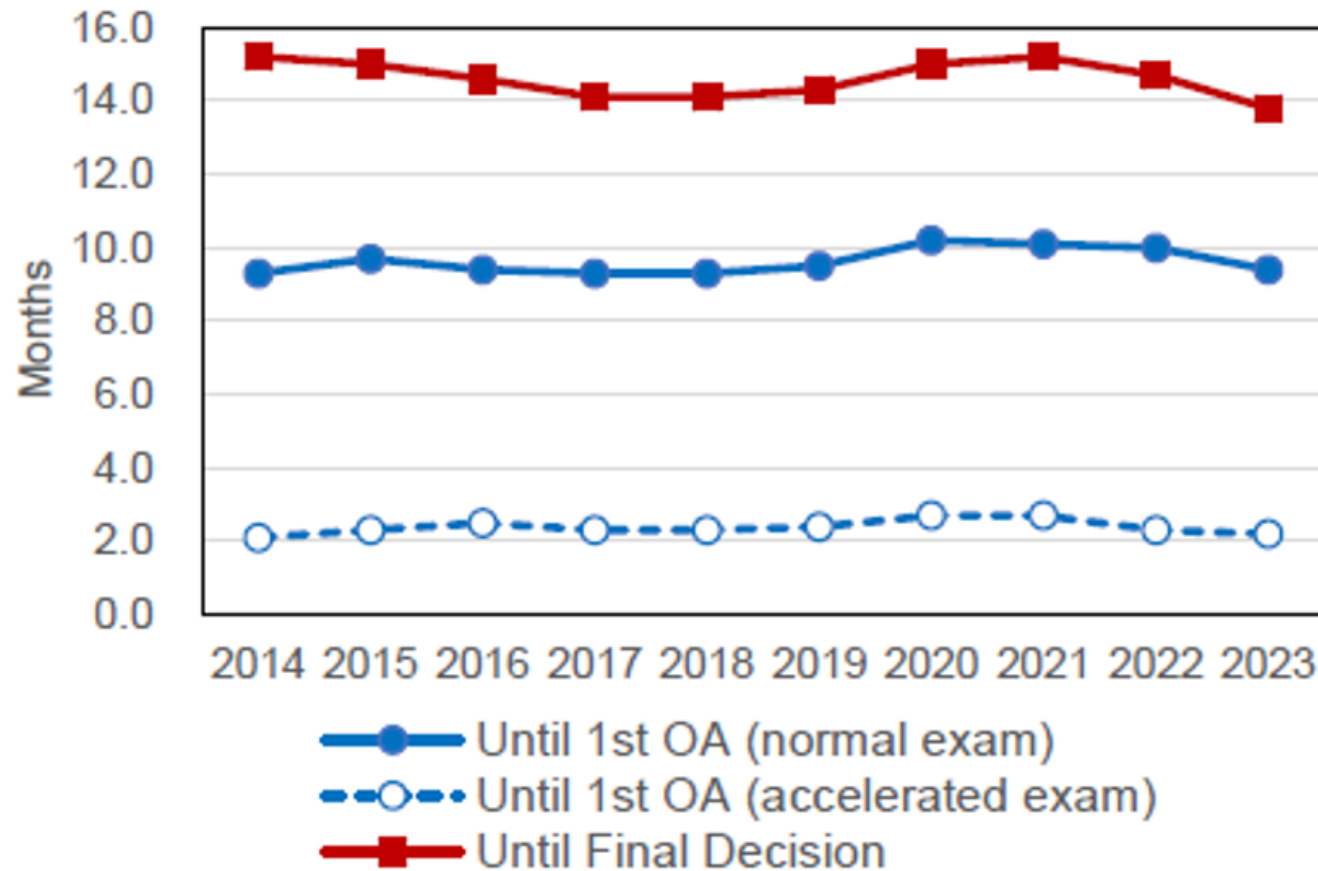


# Grant Rate

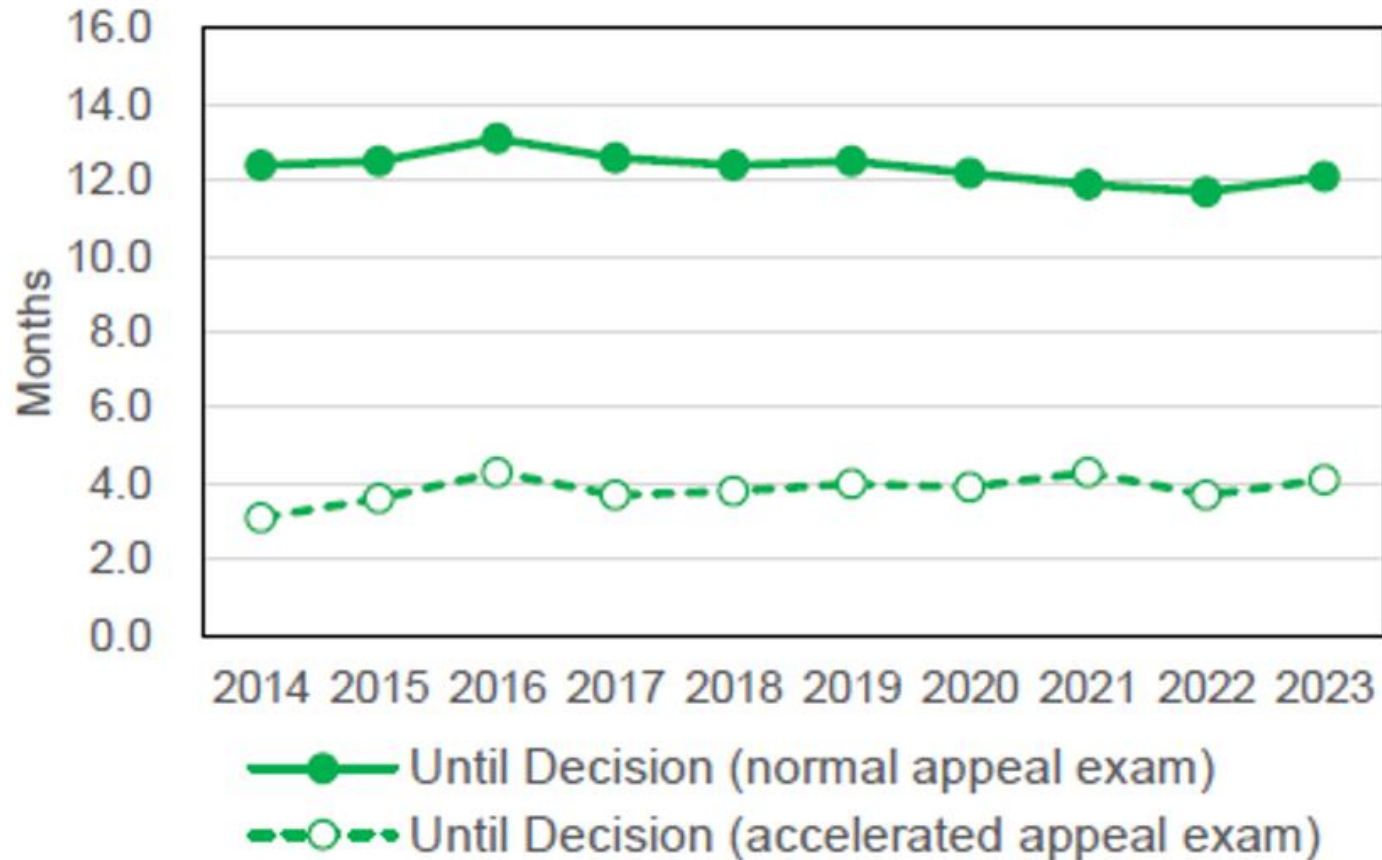




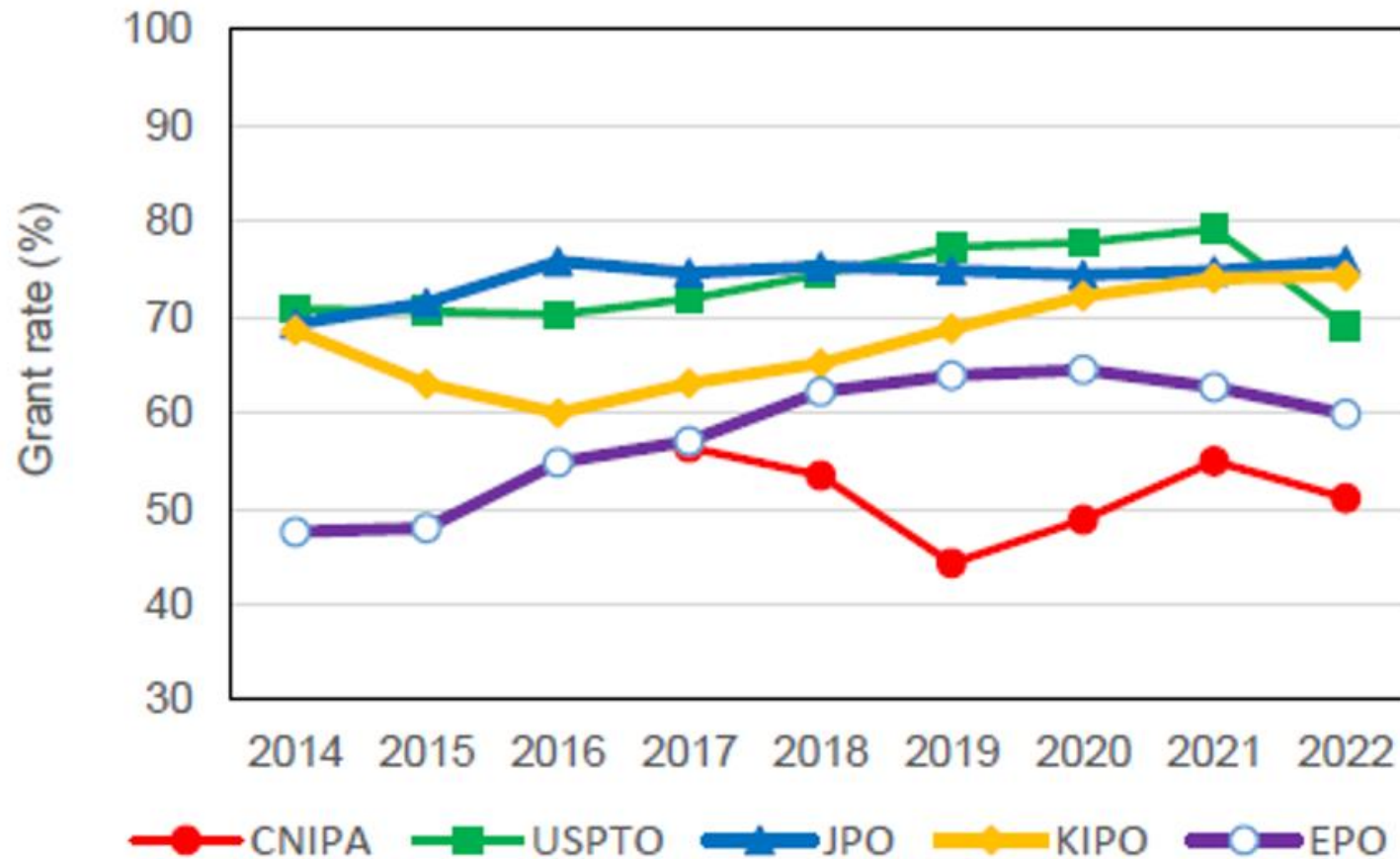
# Average Pendency from Request for Examination



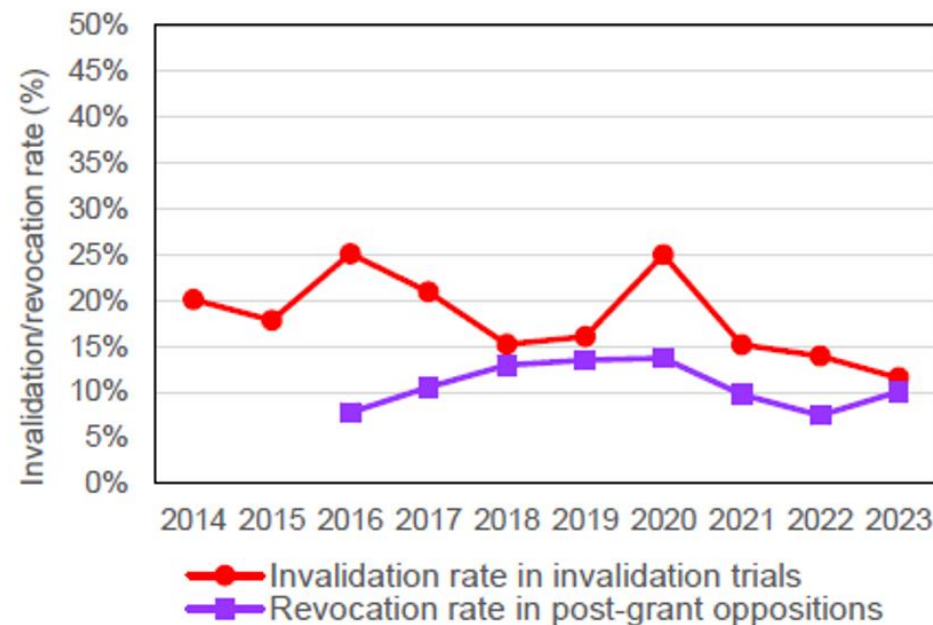
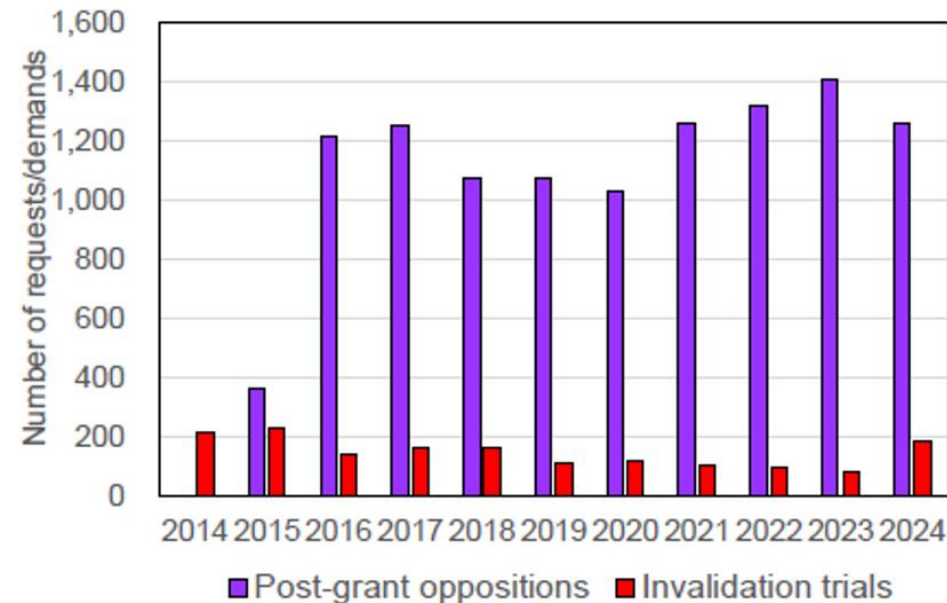
# Average Pendency from Demand for Appeal



# Patent Grant Rate at IP5

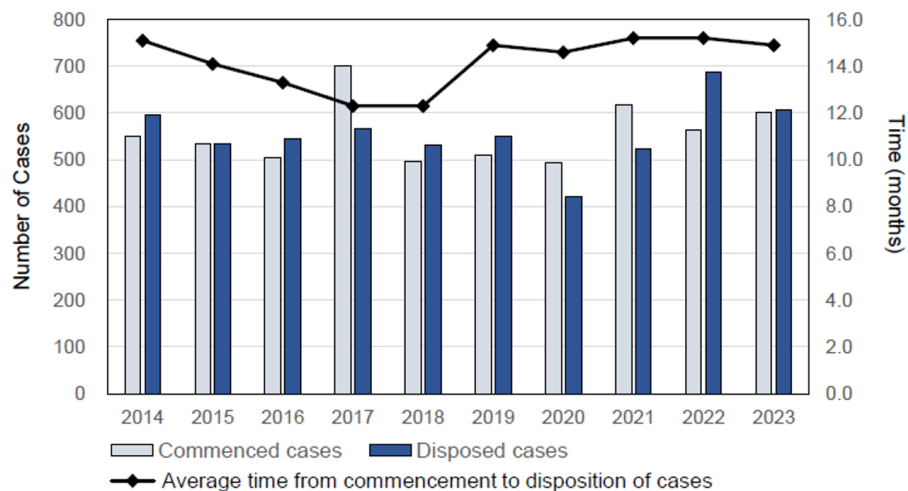


# Post-Grant Opposition / Invalidation Trials

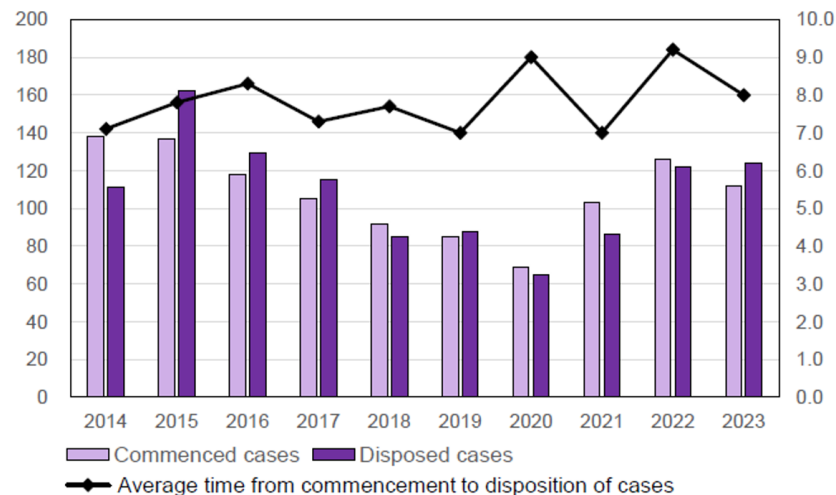


# Litigations

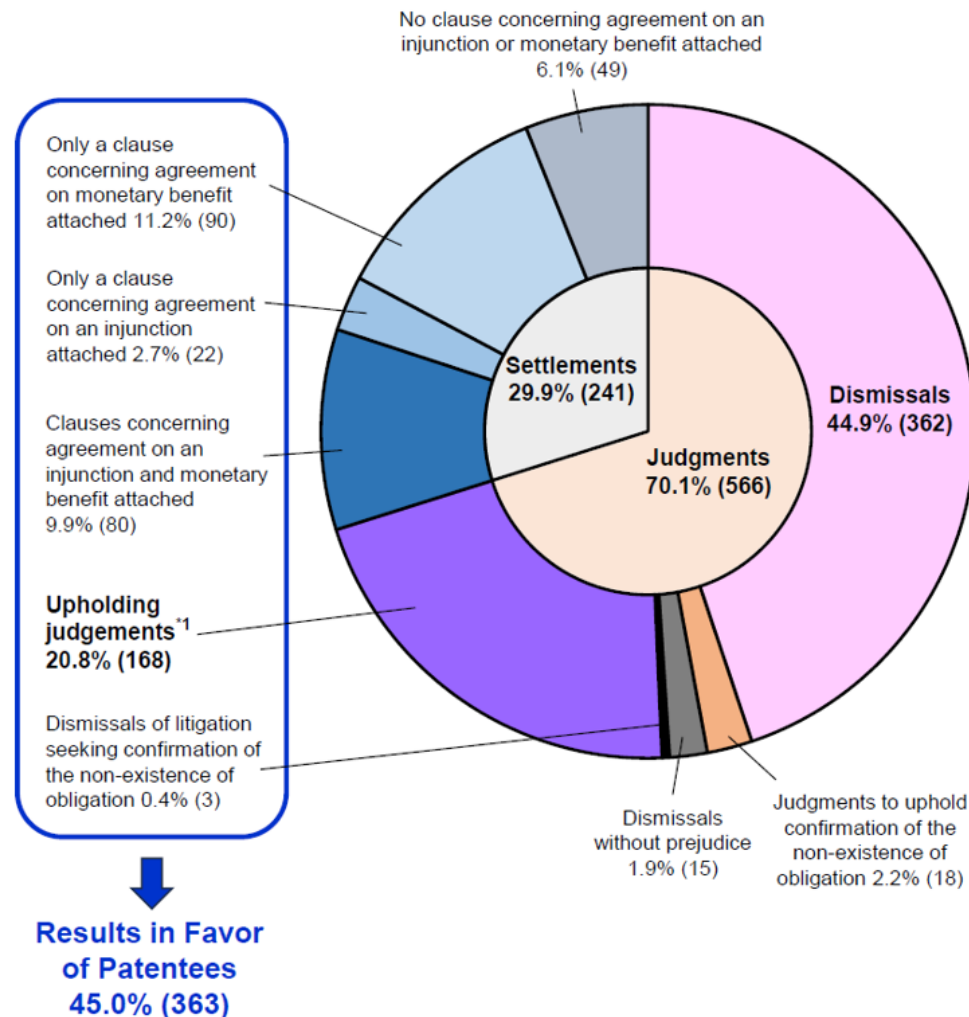
IP-related civil cases filed  
before all district courts



IP-related civil cases filed  
before the IP High Court



# Breakdown of the Results of Patent Infringement Suites at Tokyo and Osaka District Courts



# Thank you!

# Any Questions?

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