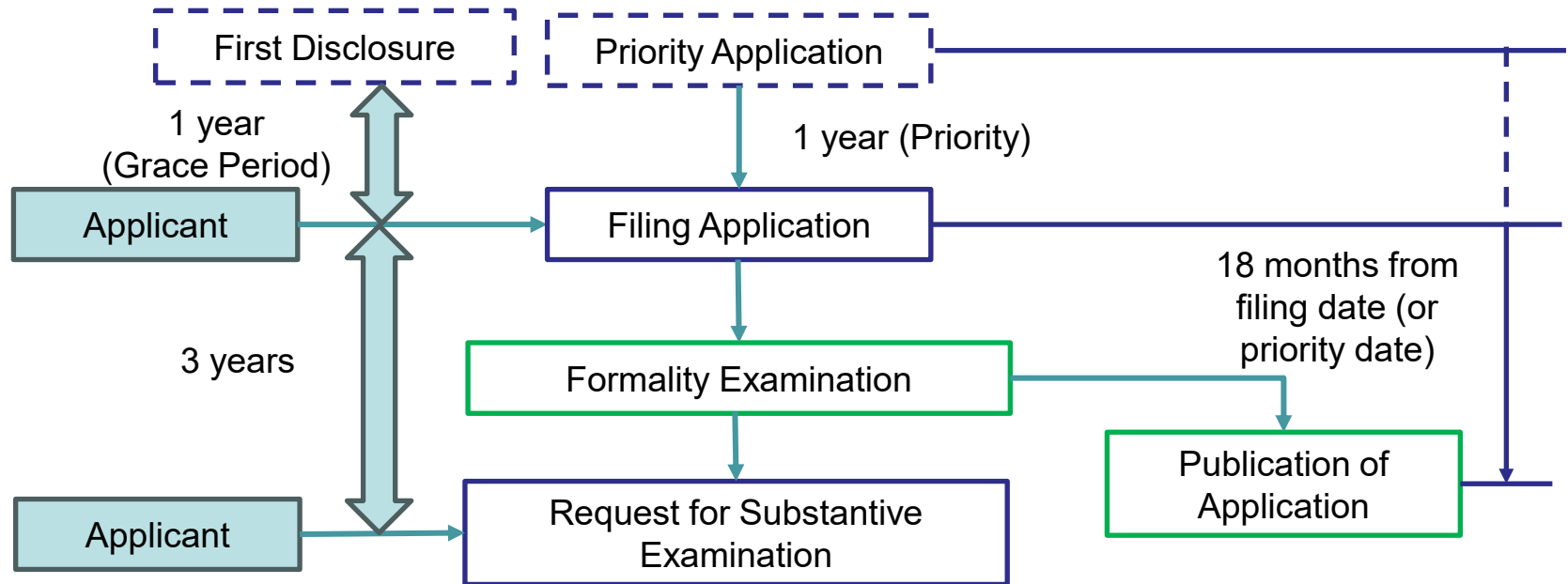


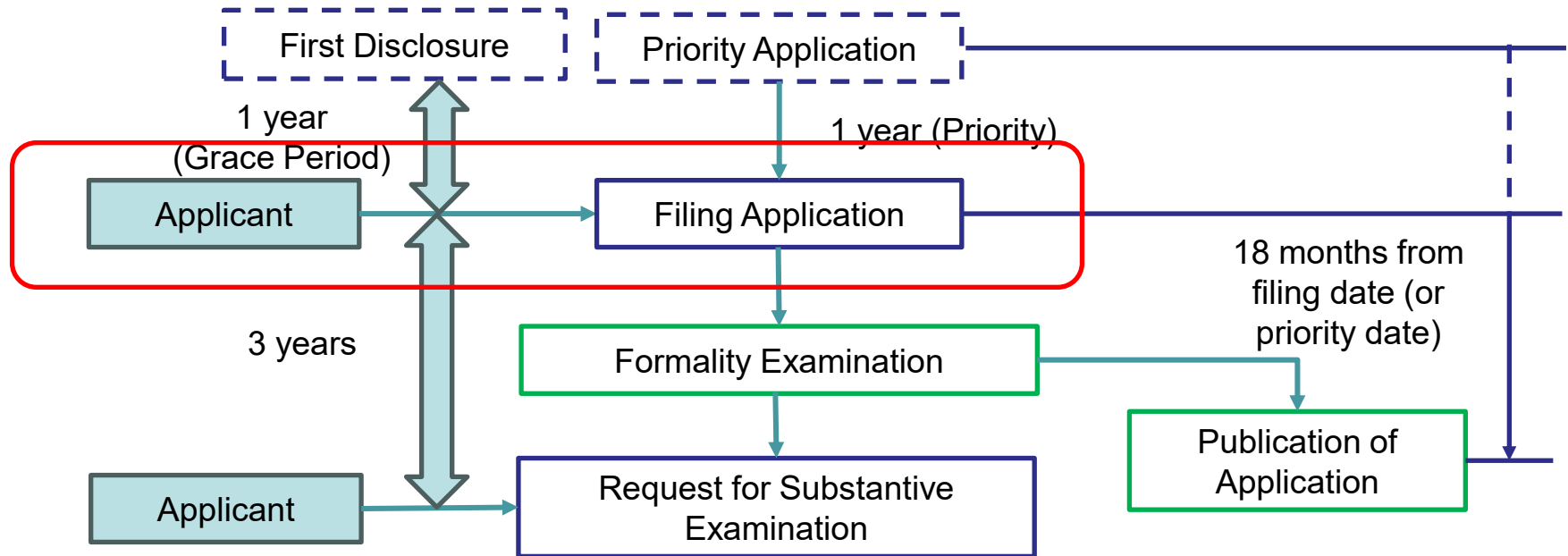


# **Overview of Japanese Patent Prosecution**

# A. Filing



# Filing an Application

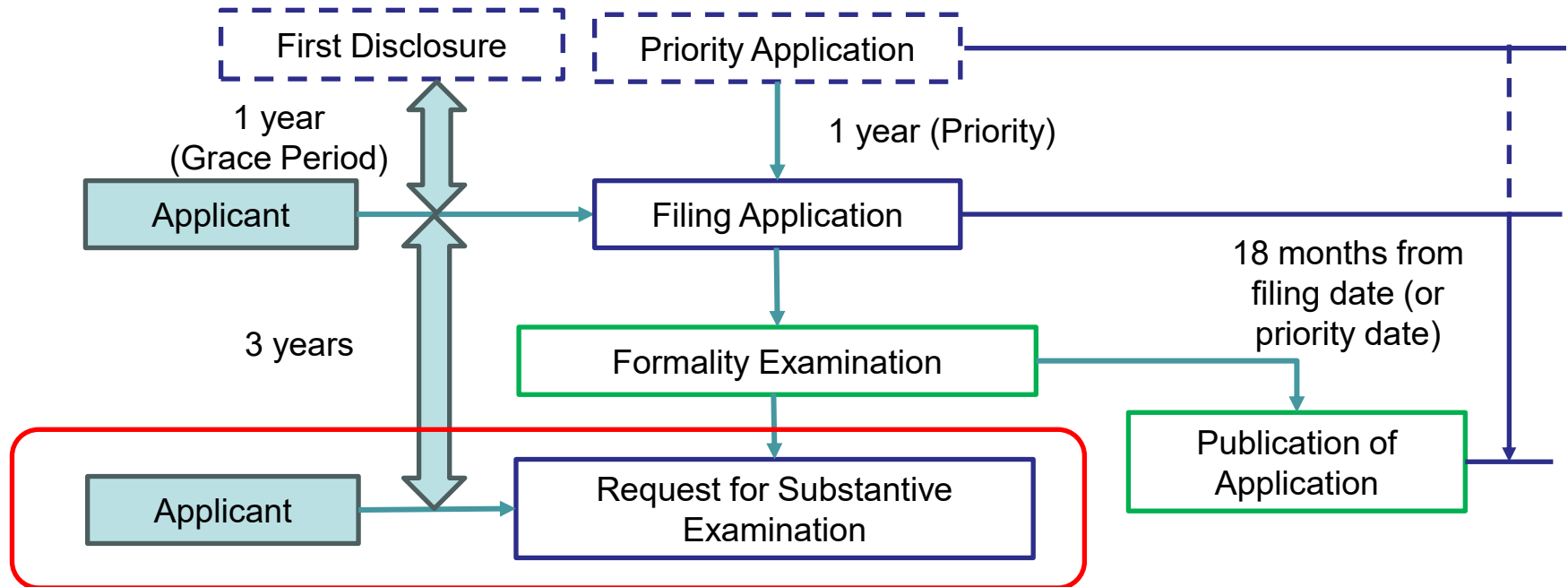


You can file by:

- 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 22,000. Japanese translation due within 1 year and 4 months from the priority date.

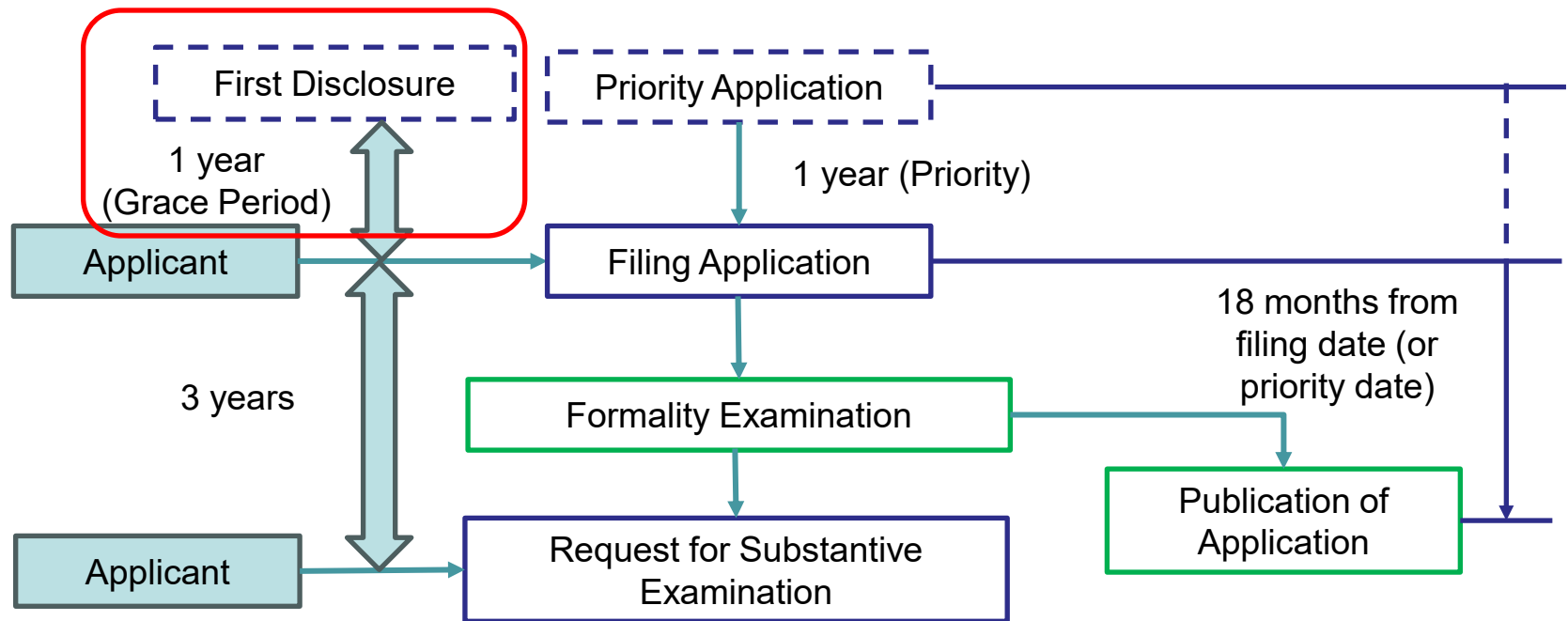
Note: No signed documents required at filing for these procedures.

# Request for Examination



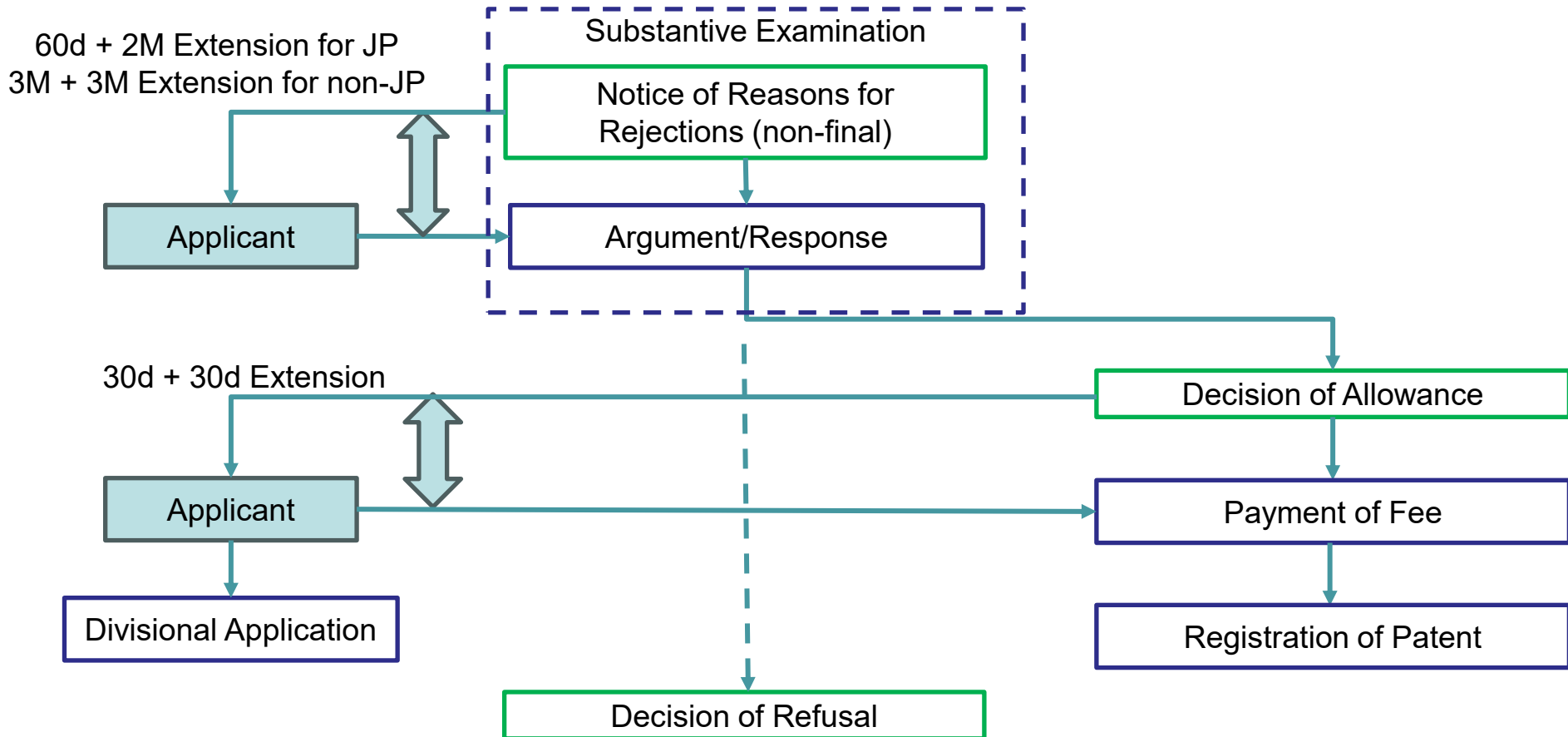
- Examination Request: Must be filed within 3 years of the filing date.
- Claims: No limit on independent claims. Official Fee increases are based solely on the total number of claims.
- Official Fee Discounts: SMEs and universities may receive a 1/3 or 1/2 reduction.
- Accelerated Examination: Program is generally easy to use and has no official<sup>4</sup> fee.

# Grace Period

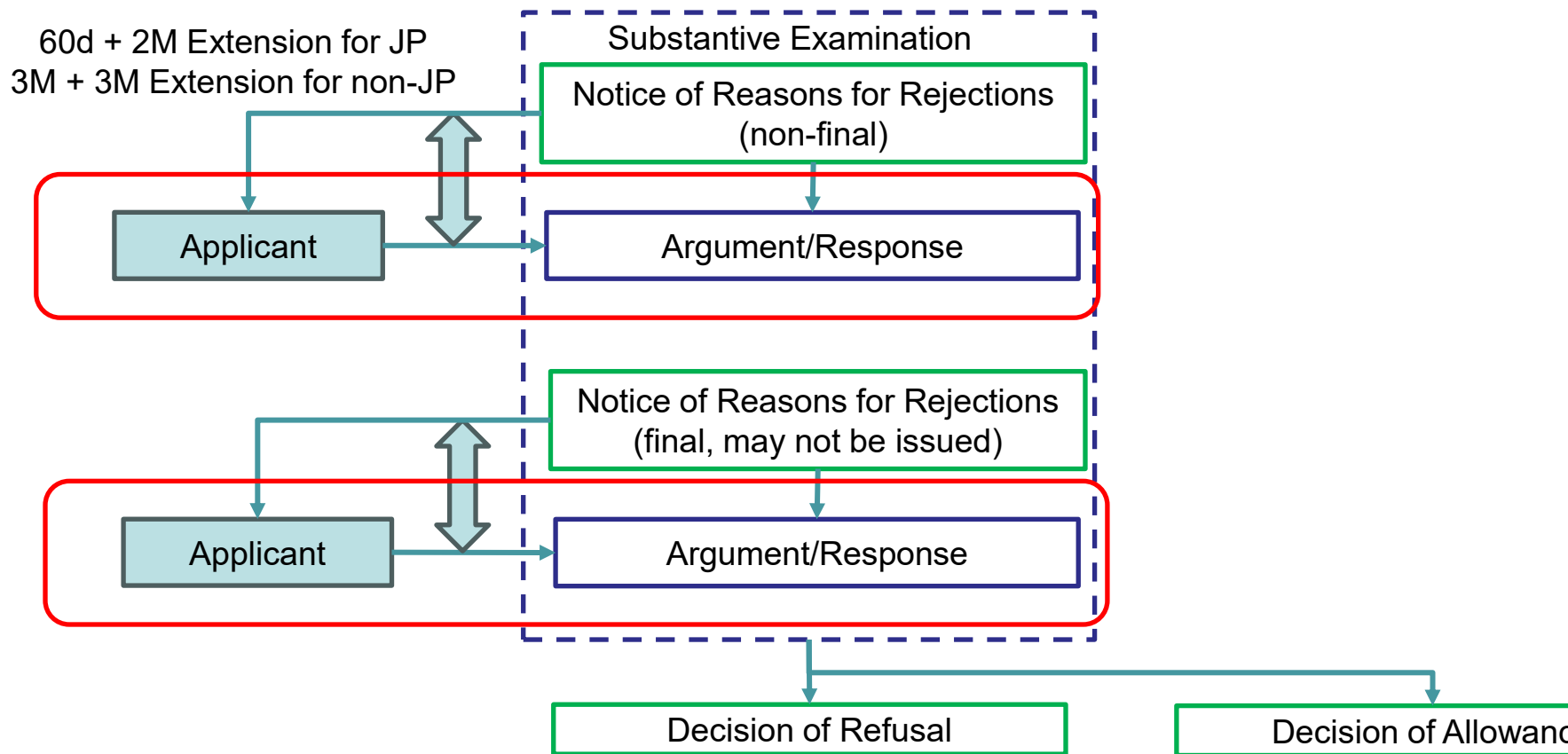


- Grace Period Claim: Must be made at the time of filing.
- Evidence Submission: Within 30 days of the filing date.
- Application Filing (for Grace Period): Within 1 year from the first disclosure (not the priority date).

# B. Examination

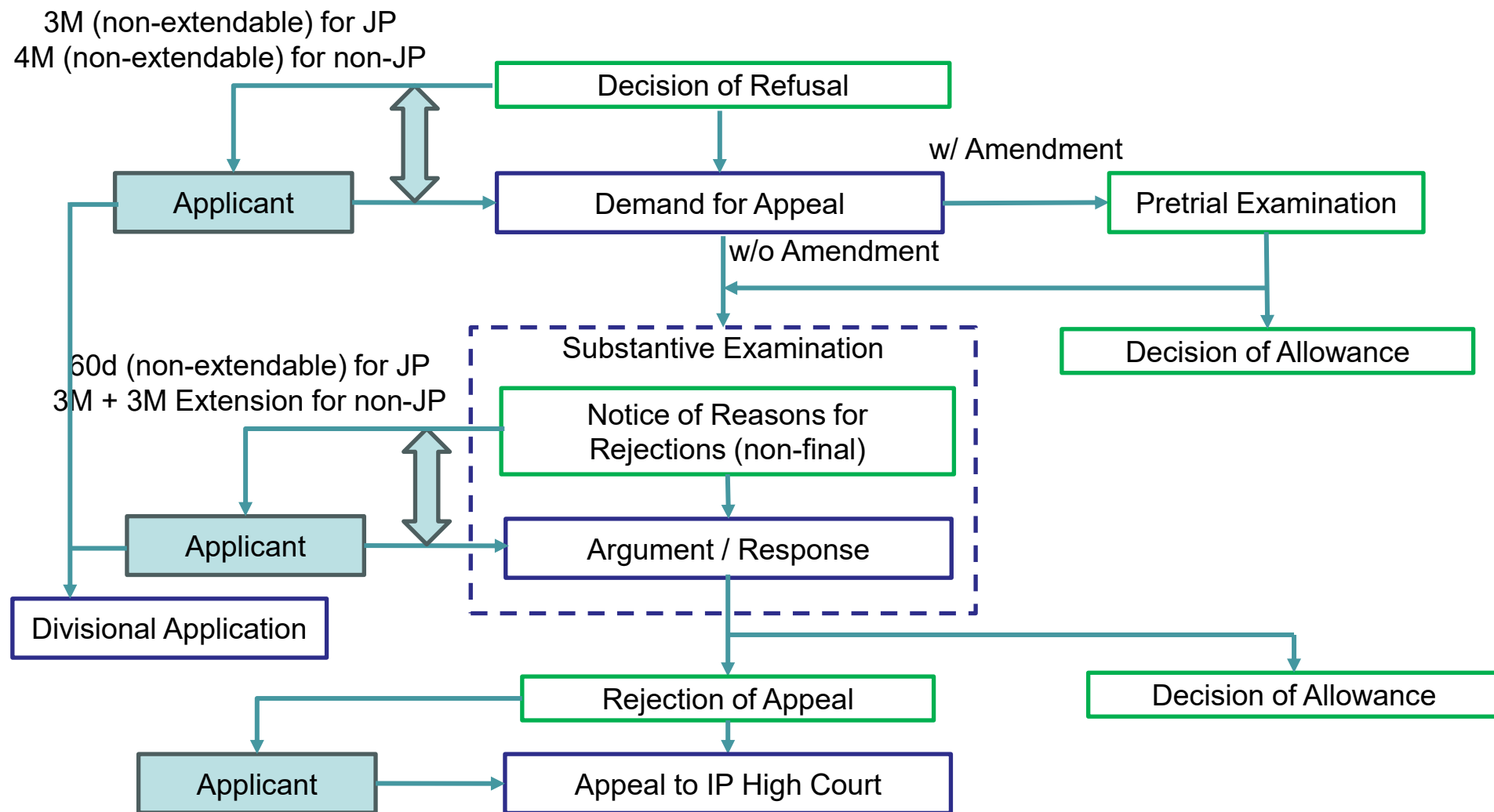


# Response & Amendment



- 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.

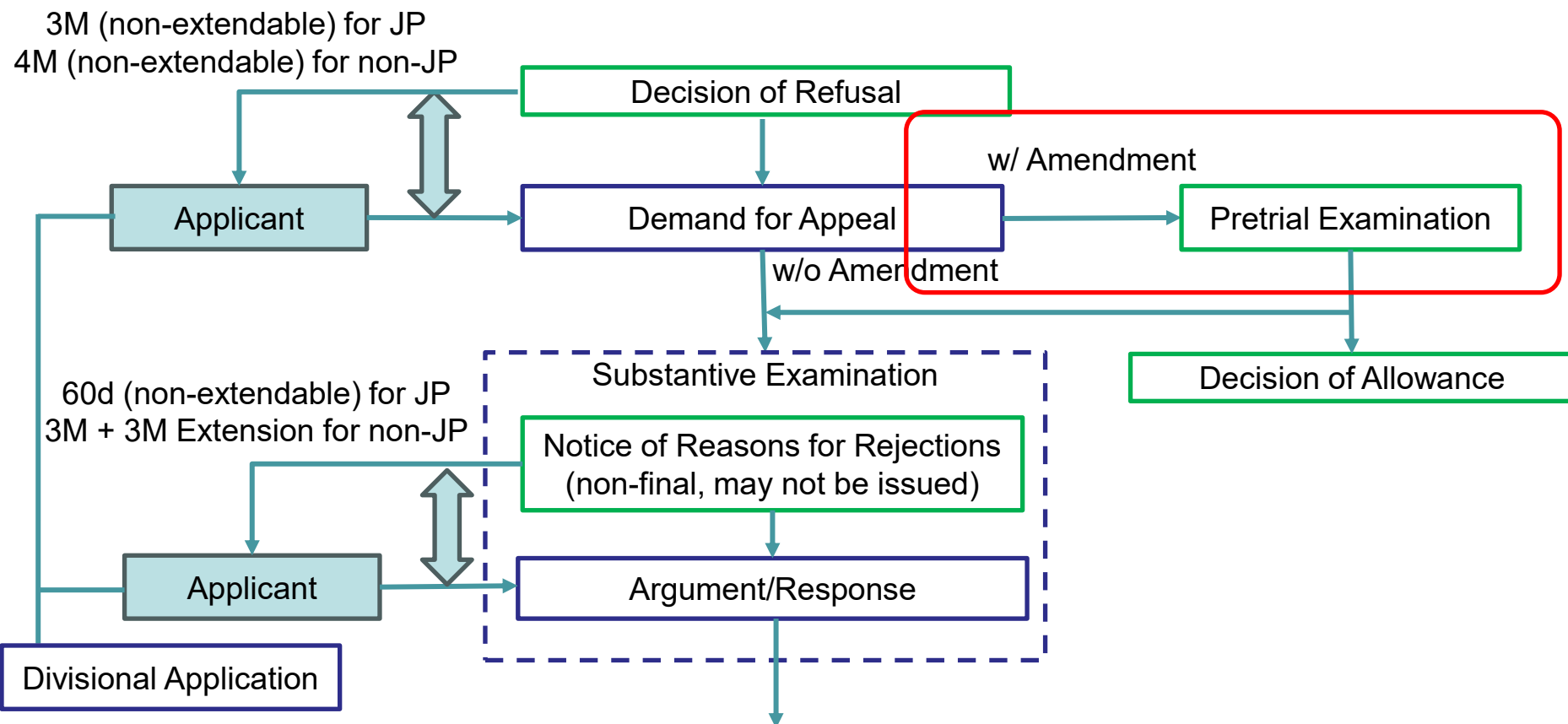
# C. Appeal



- **Power of Attorney: Required for appeals.**

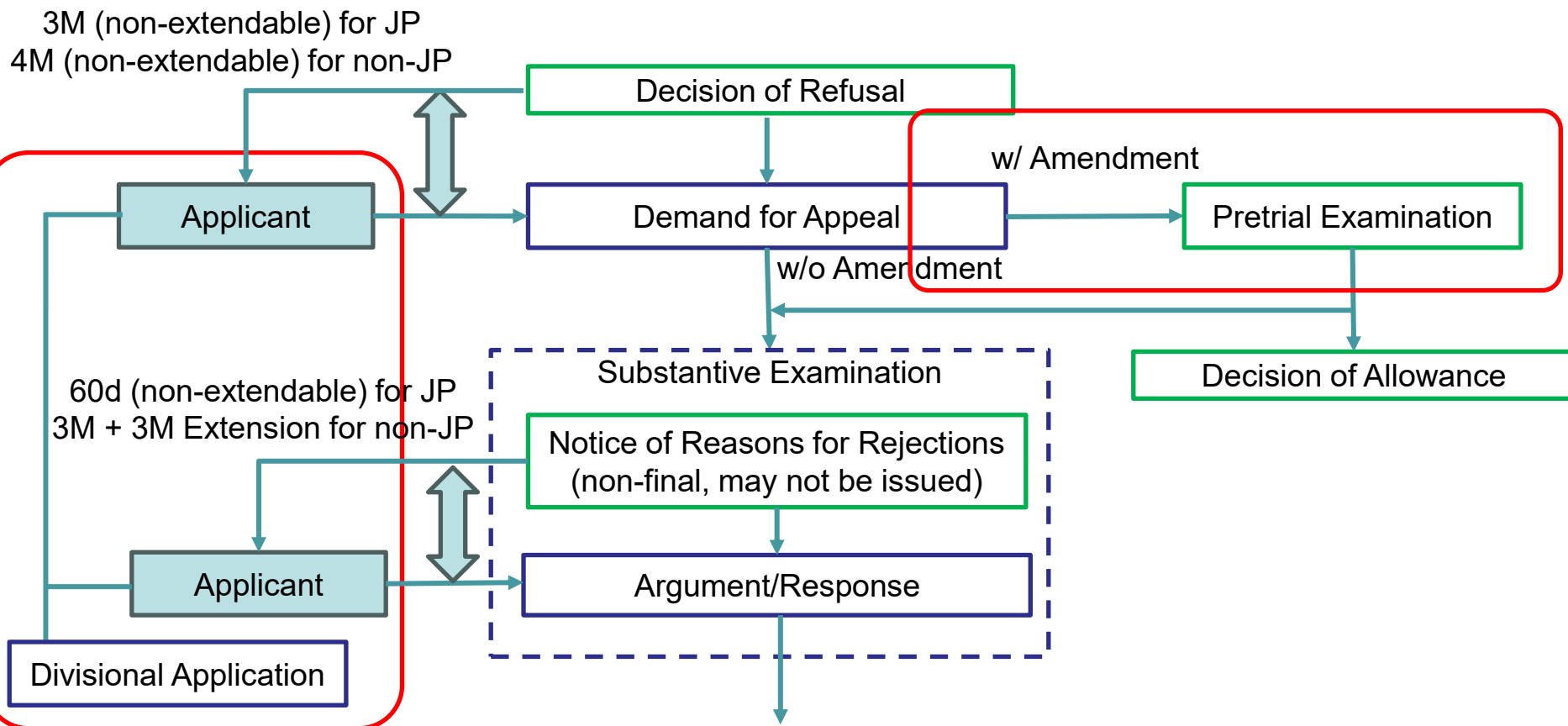


# Response & Amendment



- 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.
- Notice of Reasons for Rejections is not always issued at Appeal.

# Divisional Applications

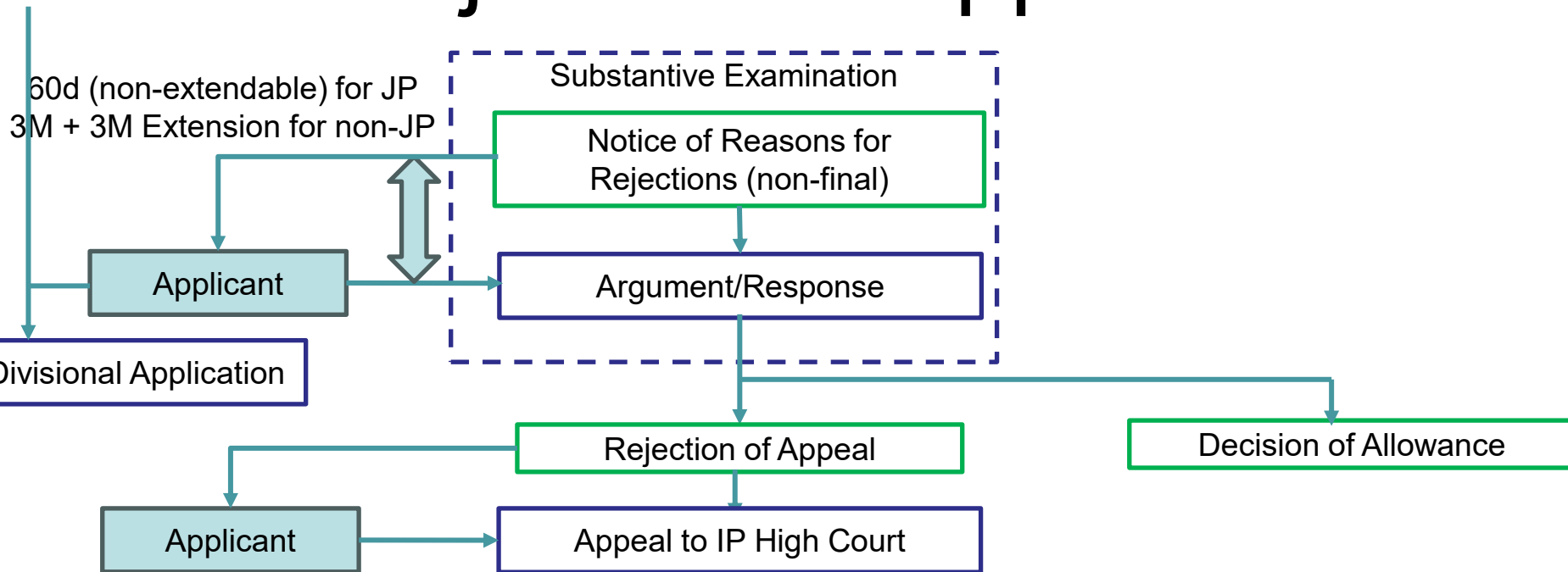


- Next Slide

# 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.



# **In-Depth Analysis for Prosecution and Cancellation**

Software, Pharma, Cancellation and Others

# 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	✓	✓	✓	✓	✓

# Pharma Claim

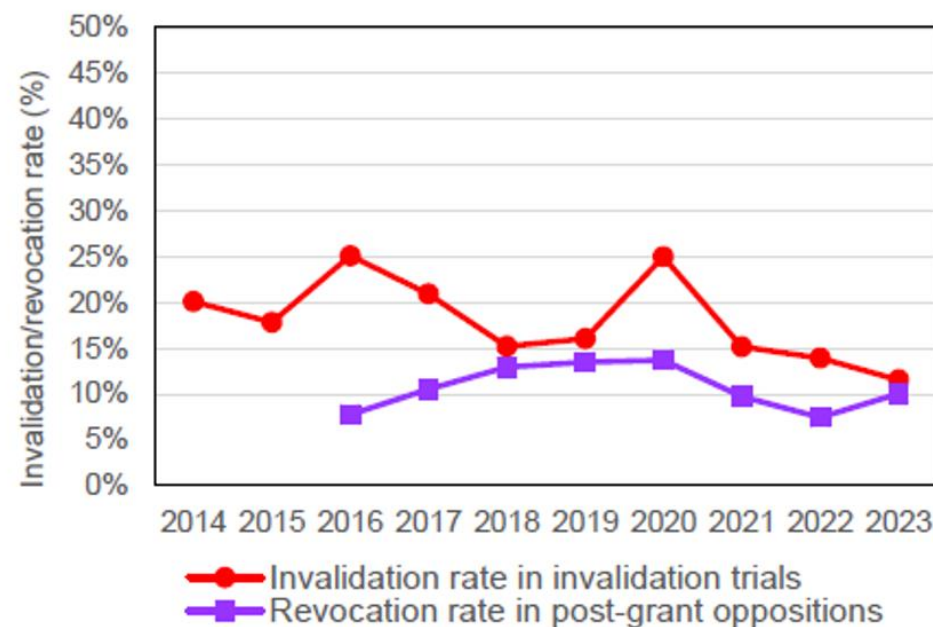
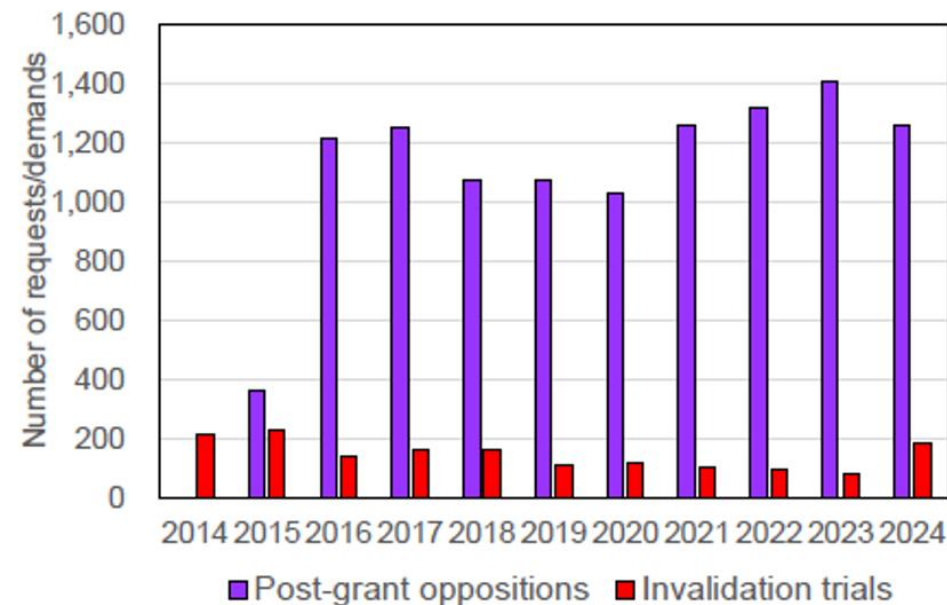
- Japan:
  - Method of Treatment Claims: Generally not patentable (considered non-statutory).
  - Use-Limited Product Claims: Patentable (e.g., "Composition X for use in treating disease Y").
  - New Medical Compounds: Patentable as substance claims.
- US (Reference):
  - Method of Treatment Claims: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

# Challenging Granted Patents - Opposition/Invalidation

- Post-Grant Opposition
  - ✓ Who Files: Anyone (Scarecrow)
  - ✓ Deadline: Within 6 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.



# Post-Grant Opposition / Invalidation Trials



# 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.

# Disclaimer

The materials prepared and presented here reflect the personal views of the author and do not necessarily represent any other individuals or entities. The materials prepared and presented here reflect the personal views of the author and do not necessarily represent any other individuals or entities.

It is understood that each case is fact specific and the materials are not intended to be a source of legal advice. It is understood that each case is fact specific and the materials are not intended to be a source of legal advice.

The author and the Japan Patent Attorneys Association cannot be bound to the statements given in these materials. However, every attempt was made to ensure that these materials are accurate, errors or omissions may be contained herein and any liability is disclaimed.

# Thank you!

# Any Questions?

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