



Patent Prosecution Practice in Japan

- Tips for Obtaining a Patent in Japan -

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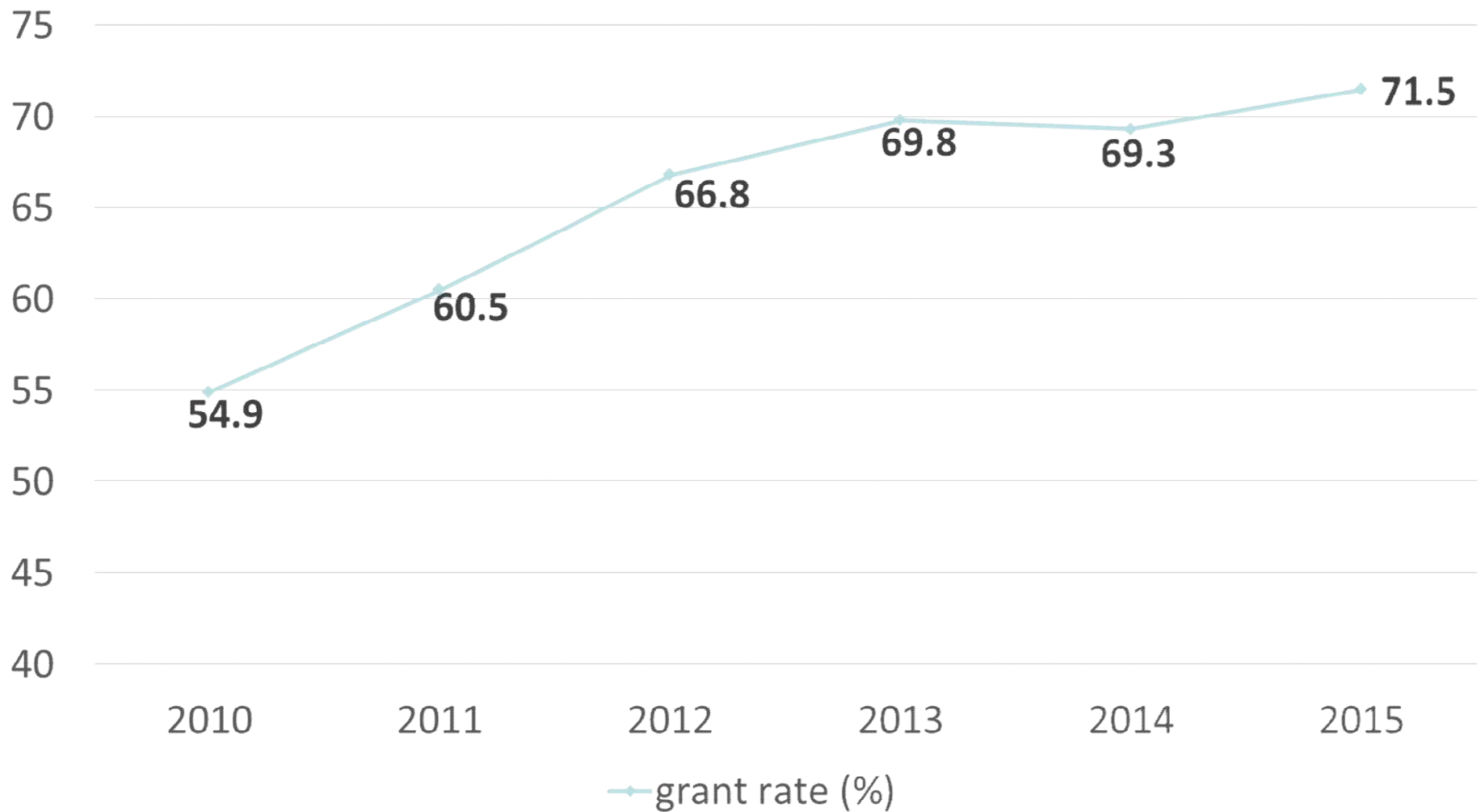
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Statistical Data

Grant Rate of Patent Applications



Subject Matter of Patent Protection

◆ Definition of Invention of the Patent Law (JP Patent Law Art. 2, Par. 1)

*“Highly advanced creation of technical idea
utilizing the laws of nature.”*

➤ The statutory invention includes:

- ✓ Products
- ✓ Methods
- ✓ Process for producing products

➤ The Invention **does not** include:

- ✓ Technique
- ✓ Medical procedure
- ✓ Artificial Rule

Subject Matter of Patent Protection

- ◆ The statutory invention **does not** include, for example:
 - ✓ A law of nature as such (e.g., a law of preservation of energy)
 - ✓ Mere discoveries and not creations (e.g., discovery of natural phenomena)
 - ✓ Those contrary to the law of nature (e.g., so-called “perpetual motion”)
 - ✓ Those in which a law of nature is not utilized (e.g., a rule for paying a game)
 - ✓ Those not regarded as technical ideas (e.g., personal skills)
 - ✓ Those for which it is clearly impossible to solve the problem by any means presented in a claim

are excluded from “Creation of technical ideas utilizing the law of nature.”

Subject Matter of Patent Protection

- JP Patent Law Art. 29: “any person who has made an invention which is **industrially applicable** may obtain a patent therefor”
 - ✓ Inventions of methods of surgery, therapy or diagnosis of humans
 - ✓ Commercially inapplicable inventions (only applicable for personal use, or for academic or experimental purposes)
 - ✓ Obviously impracticable inventions**are excluded from industrially applicable inventions.**

Subject Matter of Patent Protection

◆ Computer Software Related Invention

- Computer Software Related Invention could be a statutory invention when

“the computer software related invention utilizing a law of nature.”

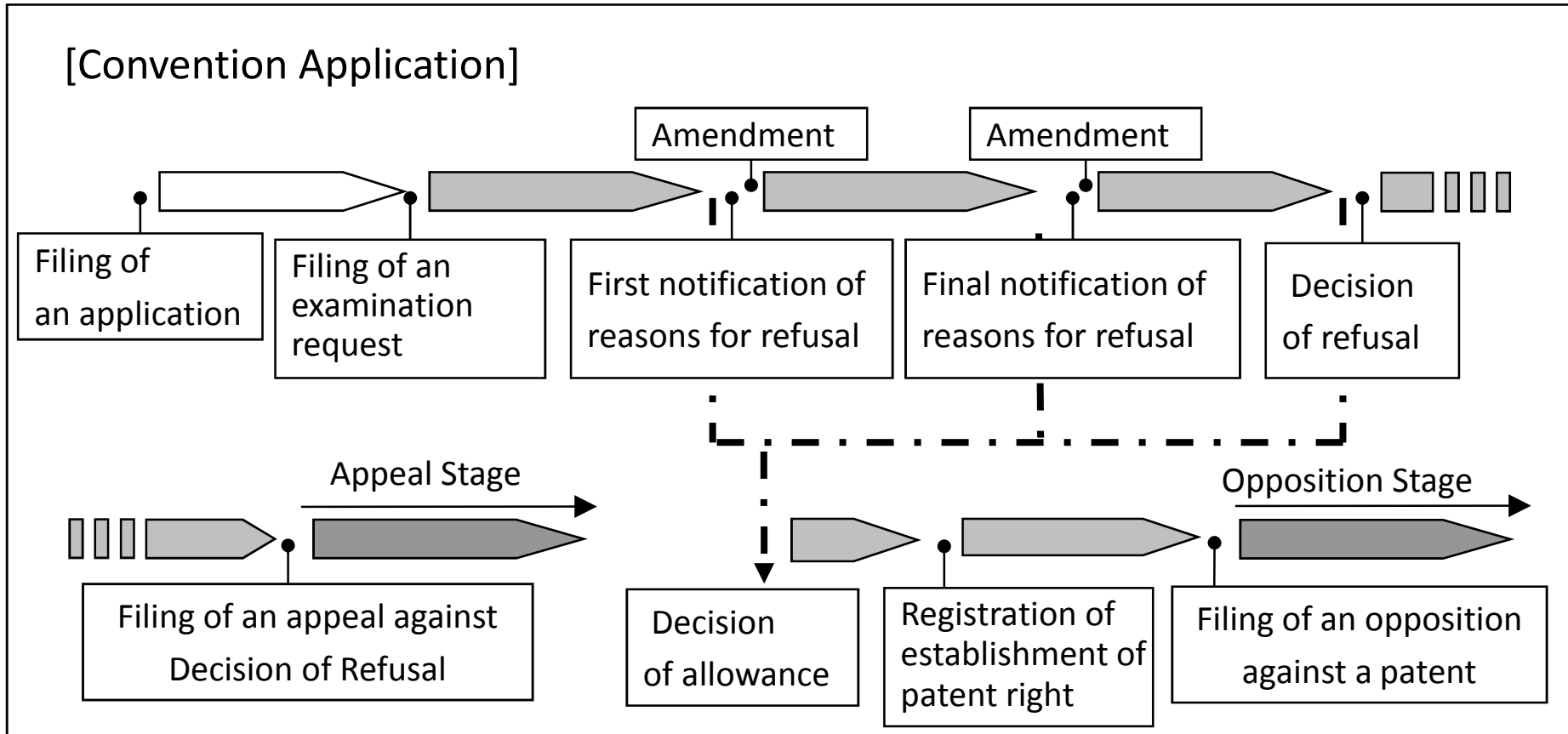
- What is “utilizing a law of nature” in the context of a computer software related invention?

“Information processing by a software is concretely realized with a hardware resource”

- ❖ A computer software related invention could be protected by a patent if

“the computer software related invention works in connection with a hardware.”

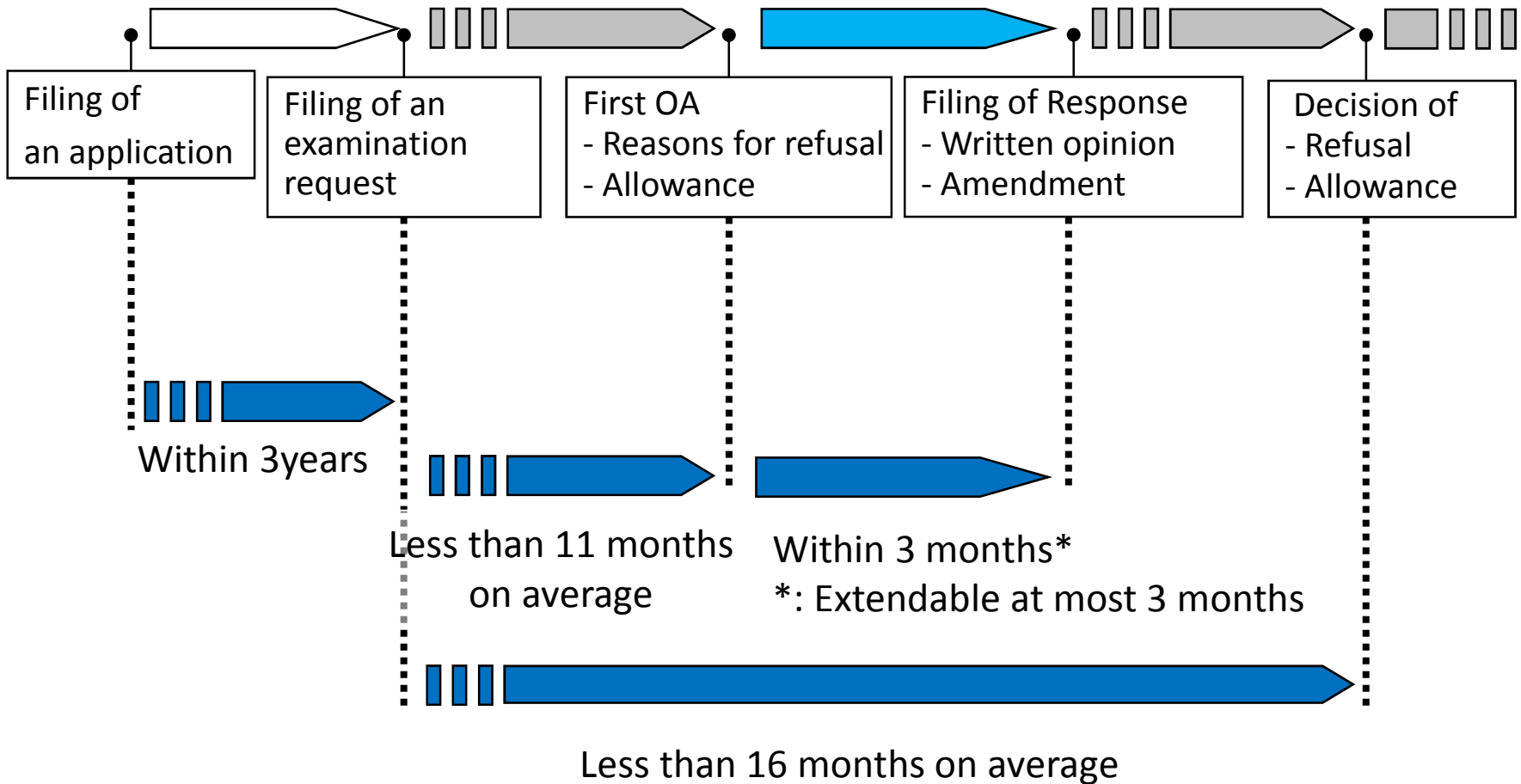
Typical Examination Procedure



In general, reasons for refusal will not be issued more than twice in the examination stage.

Timeline of Examination Procedure

2 years on average



Divisional Application

◆ What is a “Divisional Application”?

An invention not claimed in the original application can be claimed in a divisional application. Different from U.S. divisional application in that no restriction requirement needs to be issued in the original application.

◆ When to consider filing a divisional application?

- When the original application was rejected for including more than one invention.
- Allowed claims of the original application do not cover your product.
- Allowed claims do not cover other’s products similar to yours.

Divisional Application

◆ Conditions of Divisional Application

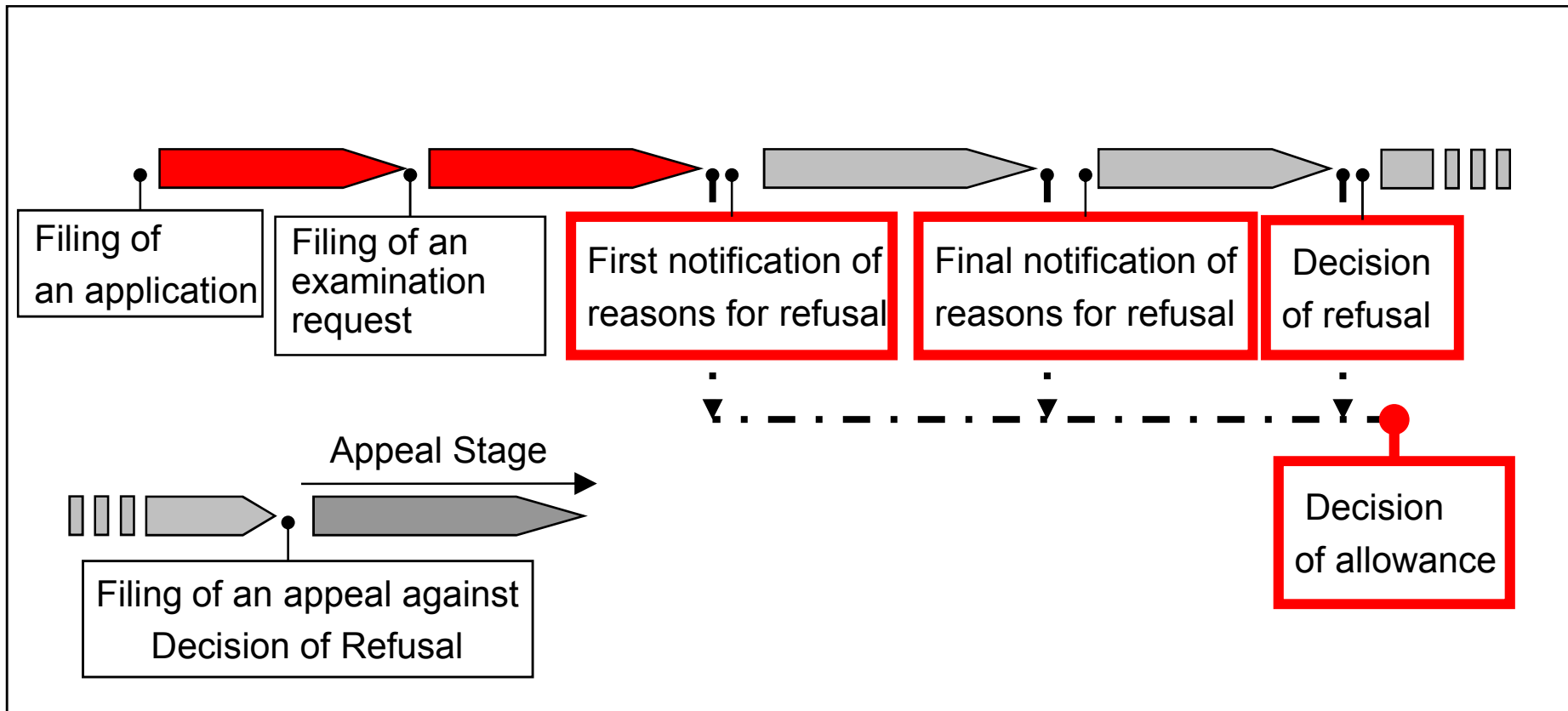
➤ Subject Matter Requirement

- ✓ A claimed invention in a divisional application has to be disclosed in the original application.
- ✓ A claim in a divisional application must not be identical to any claims in the original application.

➤ Timing Requirement

- ✓ Any time before a first office action is issued.
- ✓ Within 3 months from the date of the Notification of Reasons for Rejection is issued.
- ✓ Within 30 days from the mailing date of a Notice of Allowance.
- ✓ Within 4 months from the mailing date of the Decision of Rejection.

Divisional Application



Periods in red indicate times when a divisional application can be filed.

Expedite Examination

- ◆ Average Examination Period for regular applications in 2014
 - First action : 9.3 months
(from the request of substantive examination)
 - Final decision : 15.2 months
(from the request of substantive examination)

- ❖ The examination period can be shortened using the following procedures:
 - ✓ Patent Prosecution Highway (PPH)
 - ✓ Accelerated Examination

Expedited Examination

◆ What is Patent Prosecution Highway?

- You can use your positive result regarding a claimed invention of a patent application in the US or a PCT application to expedite examination procedure of a Japanese patent application.

US patent application

Claim A : Allowed

Claim B : Allowed

International Search Report

Claim A : No prior art regarding
inventive step

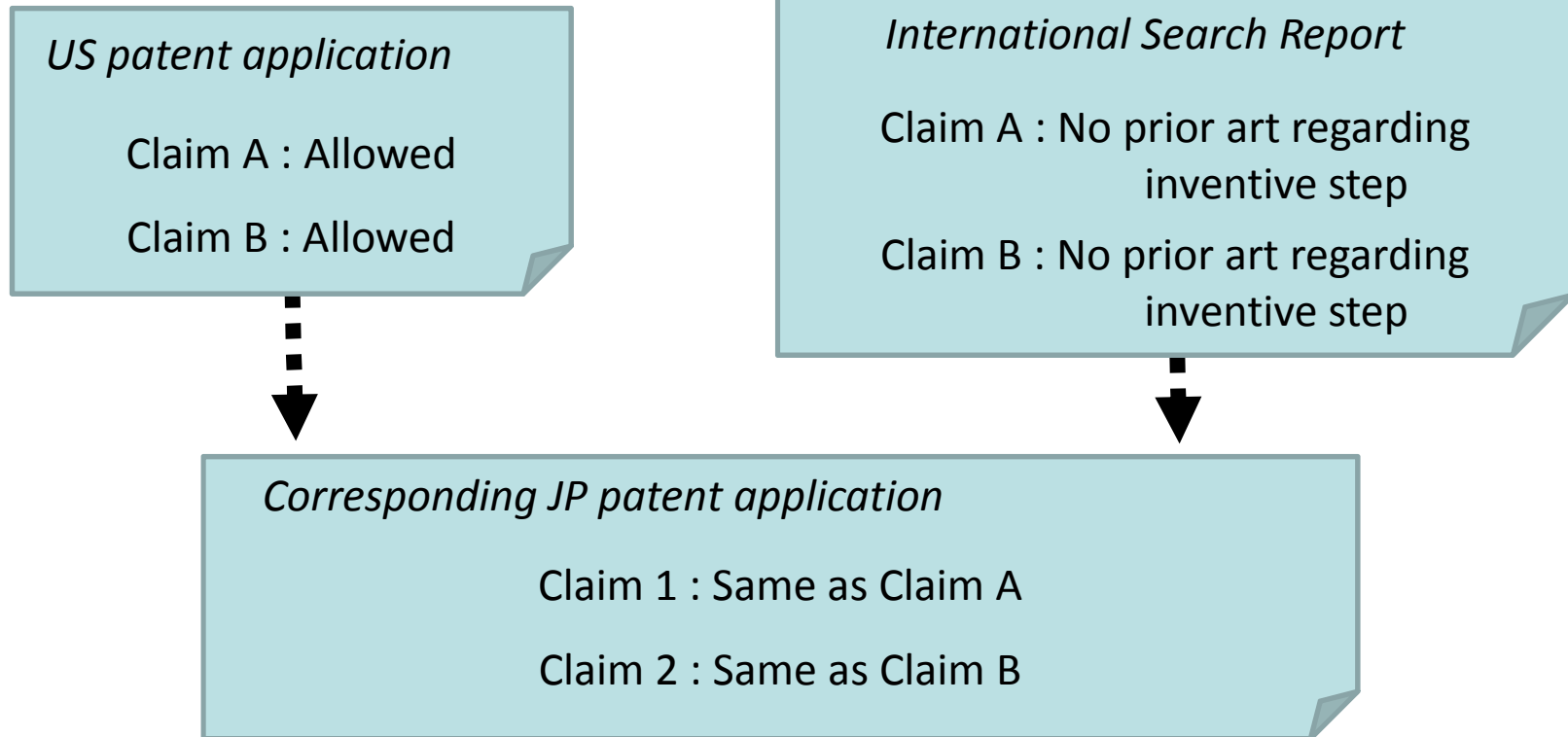
Claim B : No prior art regarding
inventive step



Examination procedure of a corresponding JP patent application can be expedited.

Expedited Examination

◆ What is PPH (Patent Prosecution Highway)?



Examination procedure can be expedited under the PPH system.

Expedite Examination

◆ PPH (Patent Prosecution Highway) System

➤ Advantage

✓ Shortens an examination period to:

2.4 months (on average, as of June 2015)

➔ Reduces the examination period by about 7 months comparing to 9.3 months of the regular examination period.

➔ Reduces the total examination period comparing to 15.2 months of the regular total examination period.

✓ Increase grant rate to:

86.3% (on average as of June 2015 not including PCT-PPH)

➔ Makes a grant rate higher than that of a regular application without PPH (71.5% on average in 2015).

Expedite Examination

◆ Accelerated Examination

➤ Advantage

✓ To shorten the examination period by:

2 months on average

➔ Reduces the examination period by about 7 months comparing to 9.3 months of the regular examination period.

➔ Reduces the total examination period comparing to 15.2 months of the regular total examination period.

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 arts*.

*Prior arts search result must be provided by the applicant.



PPH is much easier.

Costs to Obtain Patent

◆ File a patent application

- JPY 14,000 (≐ USD 124)
- JPY 22,000 (≐ USD 195) for foreign language application

◆ File an examination request

➤ Convention application:

JPY 118,000 (≐ USD 1,044) + JPY 4,000 (≐ USD 35) for each additional claim

➤ PCT National Stage Application

JPY 106,000 (≐ USD 937) + JPY 3,600 (≐ USD 32) for each additional claim



Thank you for your attention

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