



## Session 1

# Patent prosecution practice in Japan Tips for obtaining a patent in Japan

Japan Patent Attorneys Association  
International Activities Center

The logo for the Discover IP JAPAN Conference 2017 is located in the bottom left corner. It features a stylized globe with red, yellow, and blue segments, and a red banner at the bottom with the text 'Discover IP JAPAN Conference 2017' in white.

**Discover IP JAPAN  
Conference 2017**

# Scenario Characters

US Patent attorney : Seattle: Robert J.M.Lee  
Palo Alto: David Ahn

JP Patent attorney ①: Hiroyasu Ninomiya

JP Patent attorney ②: Toshinori Tanno

Narrator and Commentator: Takeo Nasu

# Act 1 - Invention consultation-

## NC : Introduce of Characters and Summary (P4)

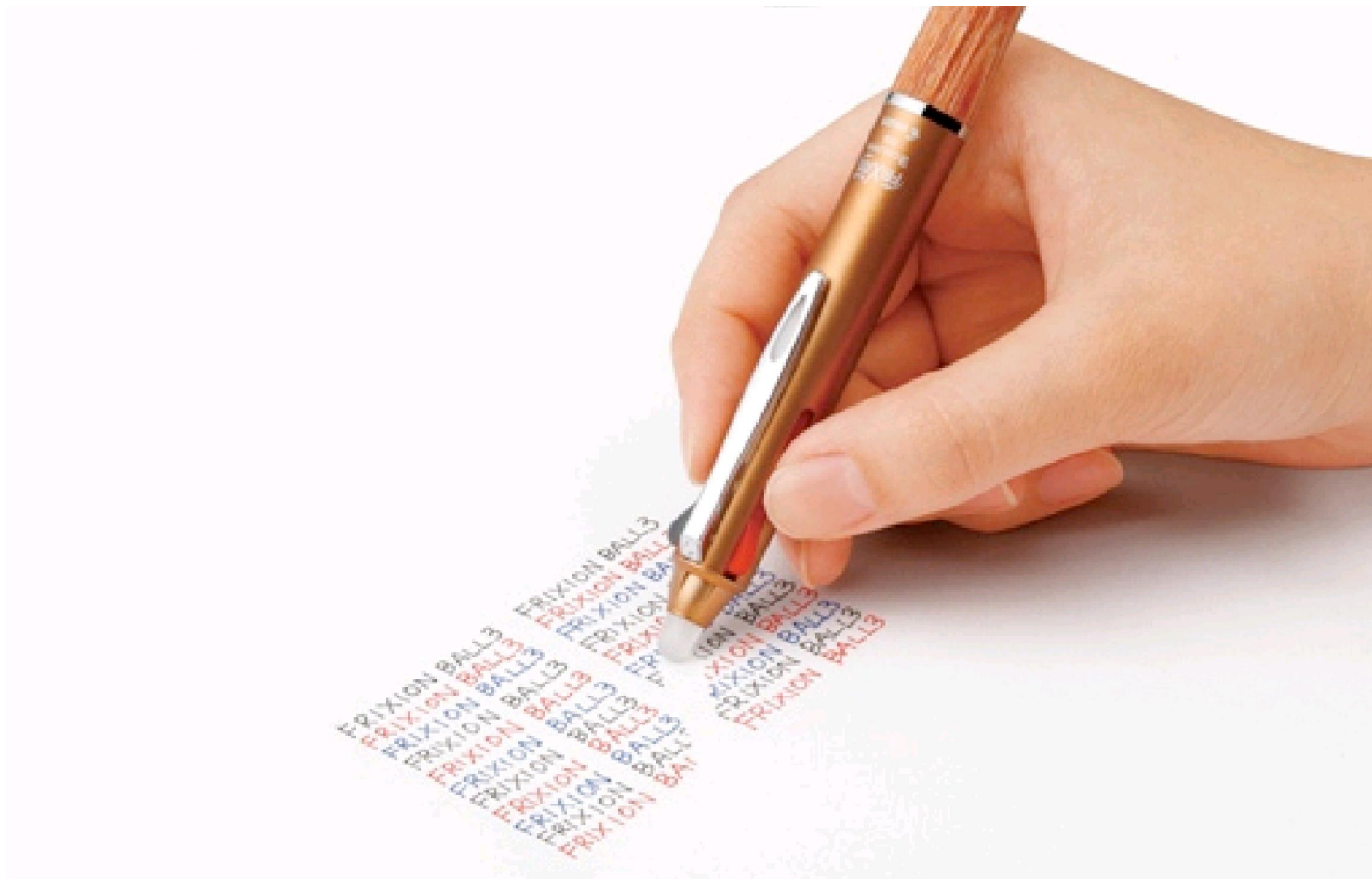
### Summary of Scenario

- A U.S. patent application was filed first followed by a PCT application claiming priority to the U.S. patent application and then a JP national phase application.
- PPH was used to expedite examination during JP application, using allowed US claims.
- However, before the JP patent was granted, the applicant found out that similar Chinese products were now being sold in Japan. These Chinese products were not covered by the allowed claims.
- A divisional application using an accelerated examination was filed within 30 days from the mailing date of the notice of allowance, with modified claims to obtain **additional coverage** on the Chinese products.
- Division application was also granted, and an import suspension and/or an injunctive action were successfully instituted against the Chinese products.

Let's get going with the scenario.



# Erasable Ballpoint Pen



## E-mail from Mr. Drump

Subject: Inquiry – US and JP patent applications

To : \*\*\*\*\*@\*\*\*\*\*

Fr: Drump@\*\*\*\*\*

1. The feature of invention is that the ink is erasable by frictional heat.
2. Given growing business in JP, would like to consider filing this and future applications in Japan. Please advise if you agree.
3. Sales schedule of this invention
  - US : one month later
  - JP : several years later, depending how the product fairs in the market
4. Not family with JP patenting process. Please advise on the following:
  - Procedure for JP patent application.
  - Official fees from filing to grant in JP.
  - Fees for maintaining a patent in JP.

## E-mail from US patent attorney

Subject: Inquiry – JP patent application

To : Nino@\*\*\*\*\*

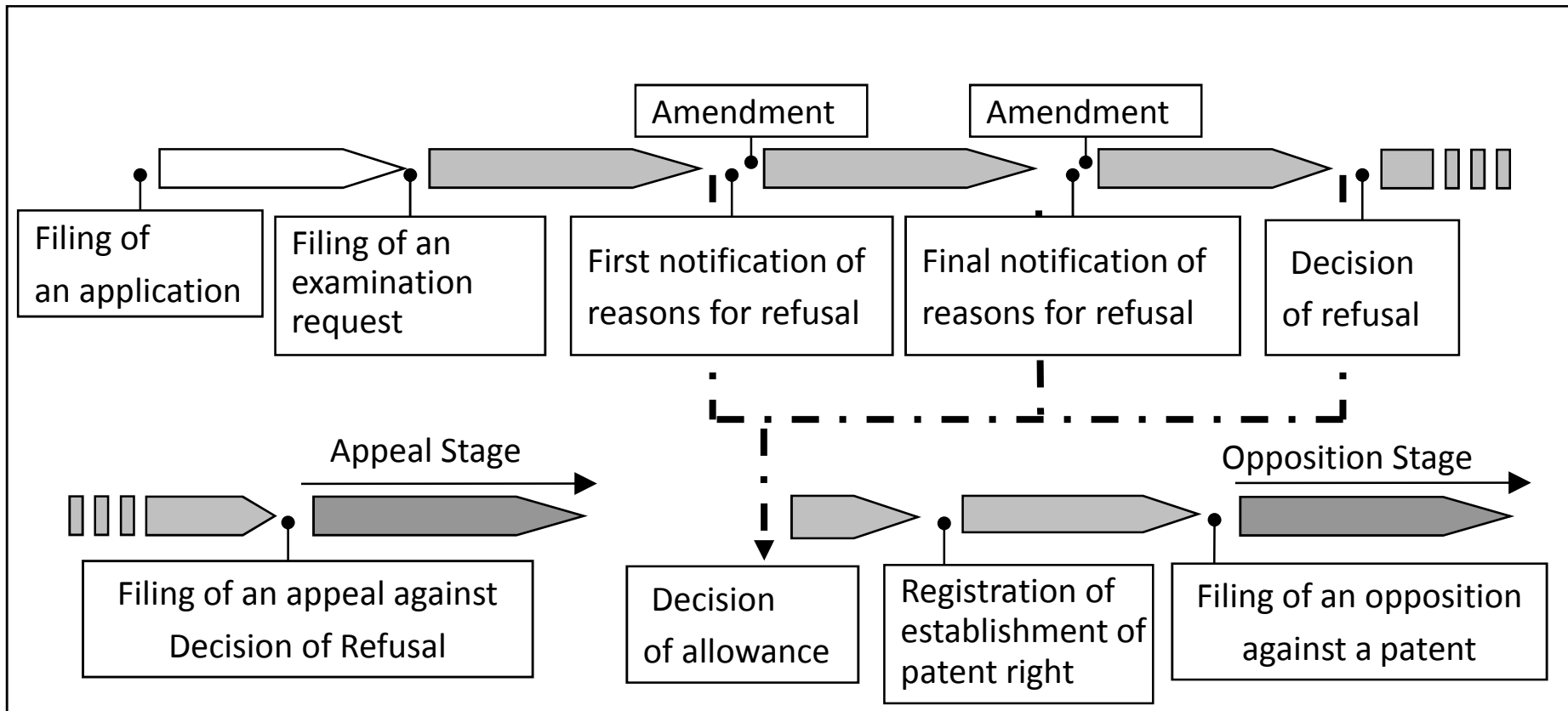
Fr: US@\*\*\*\*\*

Hi Nino and Mr. Tan,

Mr. Drump who **founded his corporate empire based on inventions** is interested in filing patent applications in Japan. Please send me the following information:

1. The overall procedure for obtaining a JP patent application.
2. Official fee from filing to grant.
3. The maintenance fee after grant.

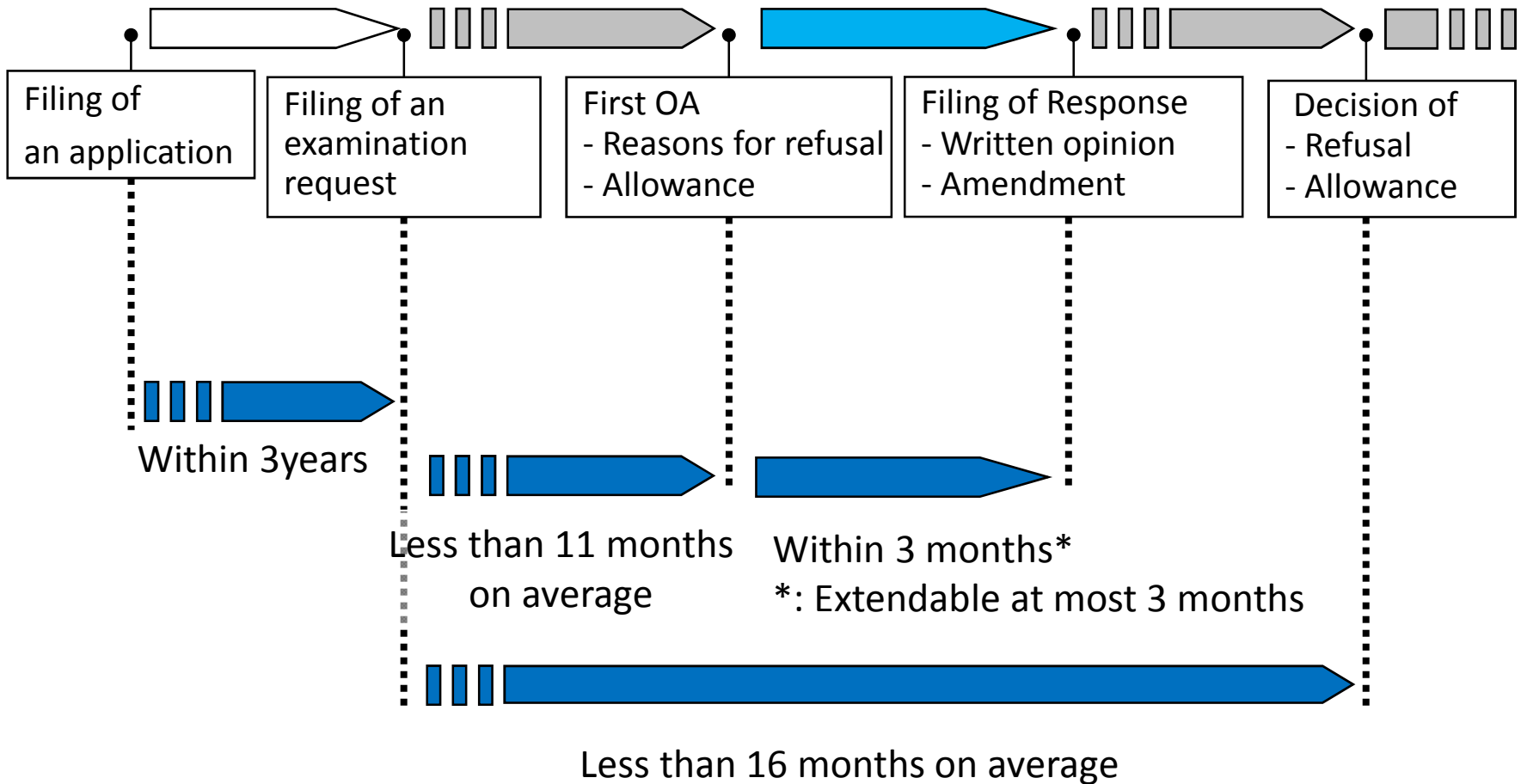
# Typical Examination Procedure



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

# Timeline of Examination Procedure

2 years on average





# Costs to Obtain Patent

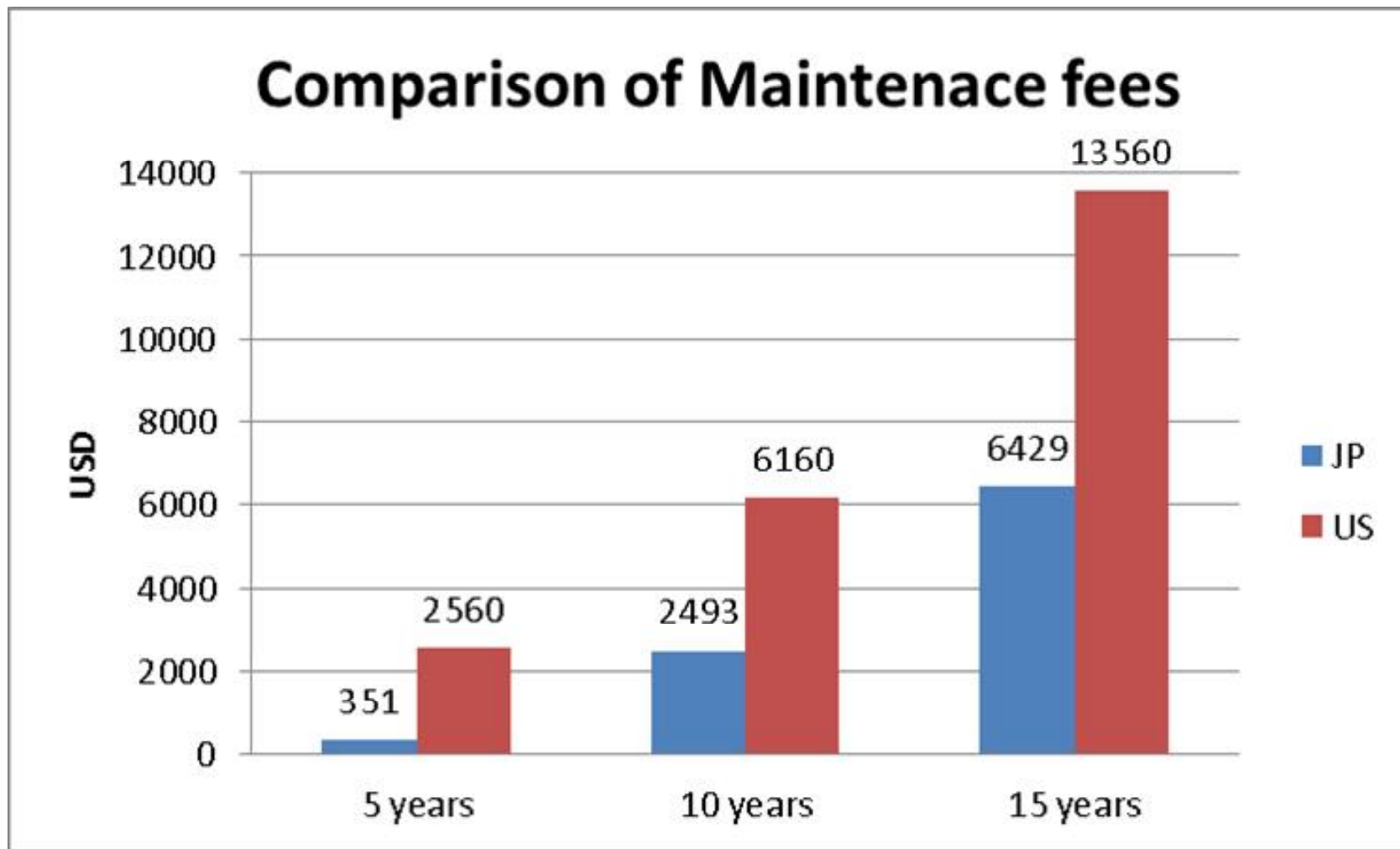
- ◆ File a patent application
  - JPY 14,000
  - JPY 22,000 for foreign language application
  
- ◆ File an examination request
  - Convention application:
    - JPY 118,000 + JPY 4,000 for each additional claim
  - PCT National Stage Application
    - JPY 106,000 + JPY 3,600 for each additional claim

## JP②: The patent registration fee and maintenance fees

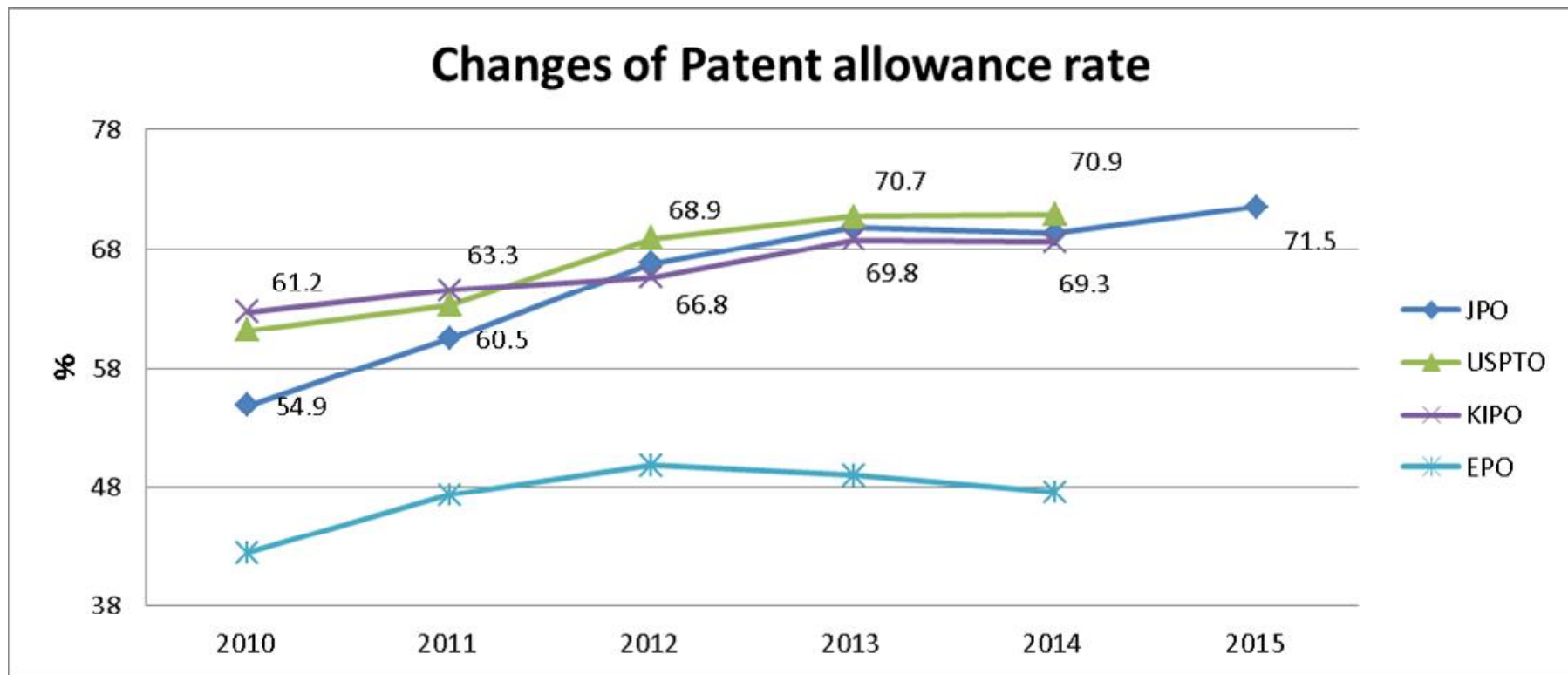
JPO	Maintenance fees	Example ( 10 claims)
1 <sup>st</sup> to 3 <sup>rd</sup>	2100 + 200 × number of claims per every year	4100 *USD1/YEN100= USD 41 per every year but should be payed at once 1st to 3 <sup>rd</sup> years
4 <sup>th</sup> to 6 <sup>th</sup>	6400 + 500 × number of claims per every year	11400*USD1/YEN100=USD 114 per every year
7 <sup>th</sup> to 9 <sup>th</sup>	19300 + 1500 × number of claims per every year	34800*USD1/YEN100=USD 348 per every year
10 <sup>th</sup> to 25 <sup>th</sup>	55400 + 4300 × number of claims per every year	98400*USD1/YEN100=USD 984 per every year

USPTO	Maintenance fees
Registration fee	USD 960
Due at 3.5 years	USD 1,600
Due at 7.5 years	USD 3,600
Due at 11.5 years	USD 7,400

## JP②: The patent registration fee and maintenance fees



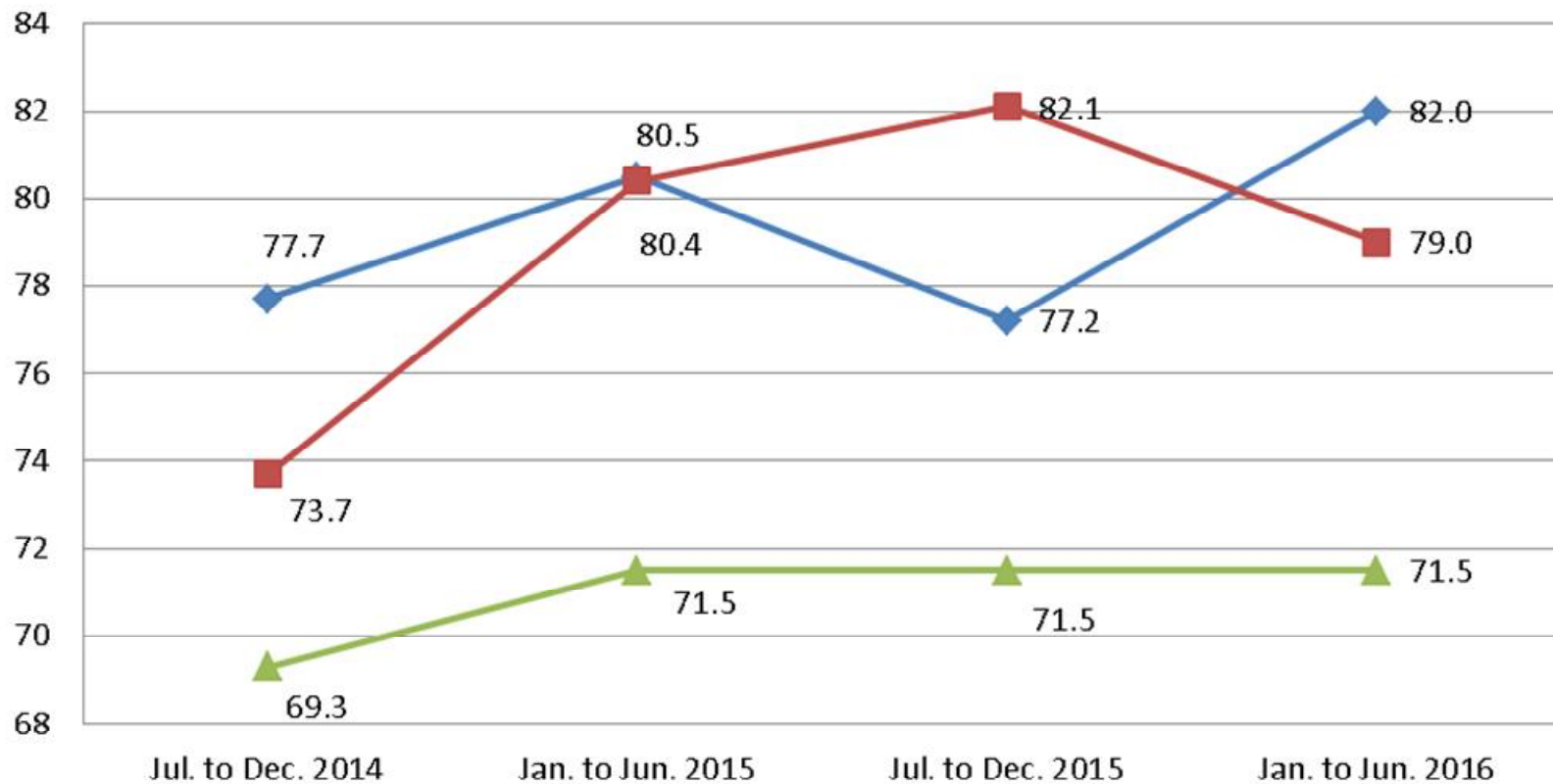
## JP②: Patent allowance rate

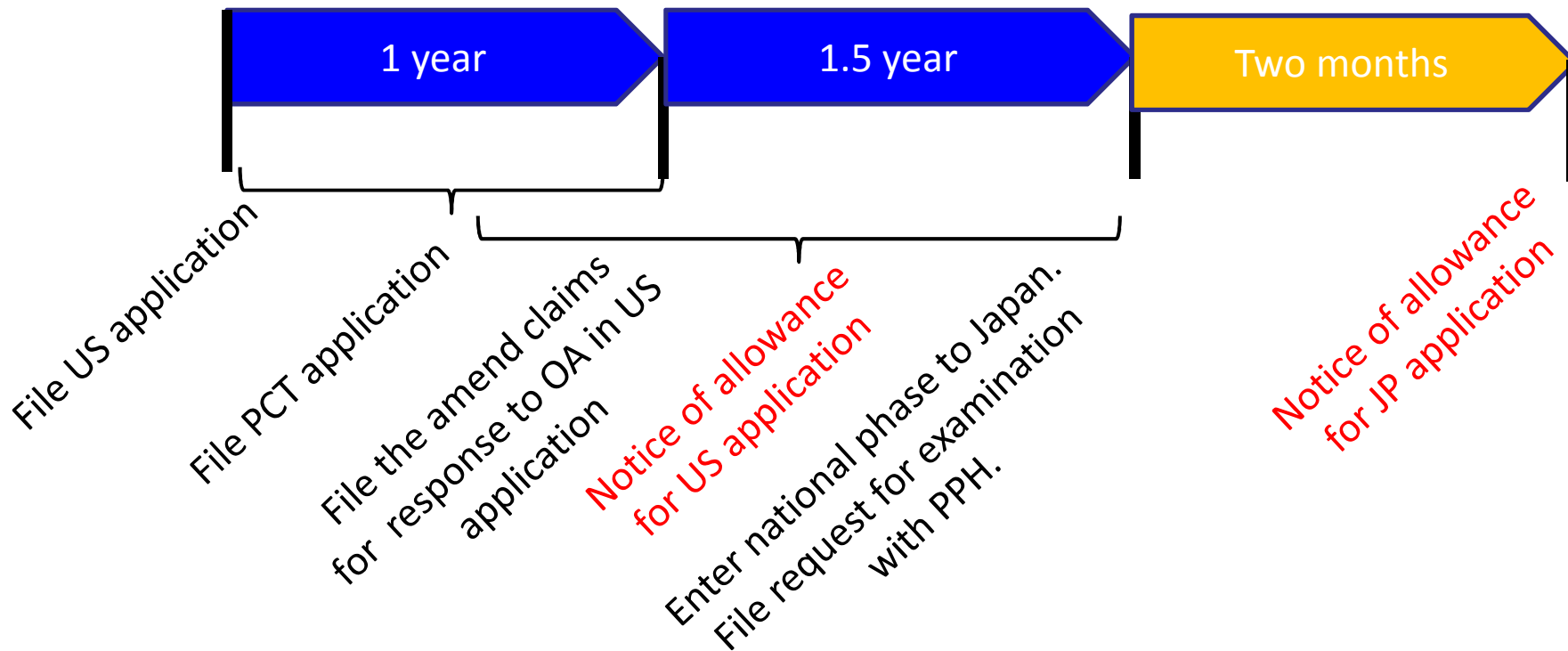


# JP②: Patent allowance rate

## Patent Grant Rate

%    ◆ PPH (NOT including PCT-PPH)    ■ PCT- PPH    ▲ All applications (Allowance Rate)





## E-mail from US patent attorney

Subject: **Urgent** Inquiry – Divisional application

To : Nino@\*\*\*\*\*

Fr: US@\*\*\*\*\*

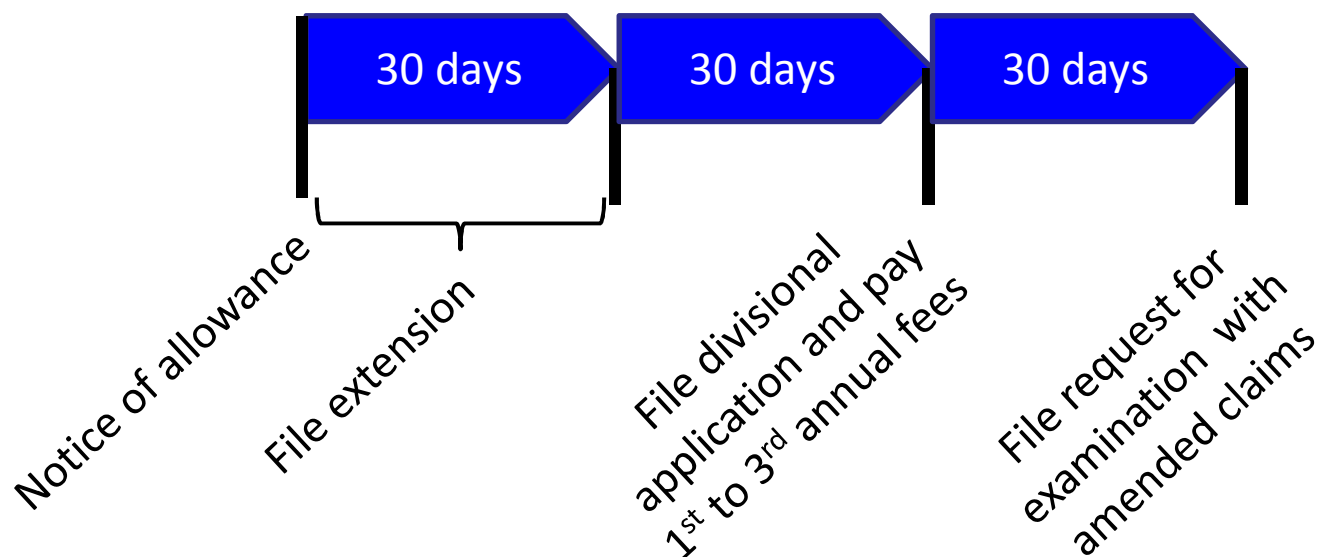
Hi, Nino and Mr. Tan:

Thank you for sending notice of the patent allowance. Please proceed with the payment of registration fee for 1-3 years within 30 days.

But we also have a major issue. Similar products are being made in China are being sold in Japan. However, the claims allowed in Japan does not cover these similar products.

**Is there something similar to a continuation application in Japan to obtain additional patent coverage?**

1. The divisional application can be filed within 30 days from the notice of patent allowance.
2. The request for examination must be made within 30 days from the filing date of the divisional application.
3. Claims can be amended when filing the request for examination.
4. The request for accelerated examination can be submitted when requesting the examination. The time to receive the first office action is an average of two months from the date the examination is requested.





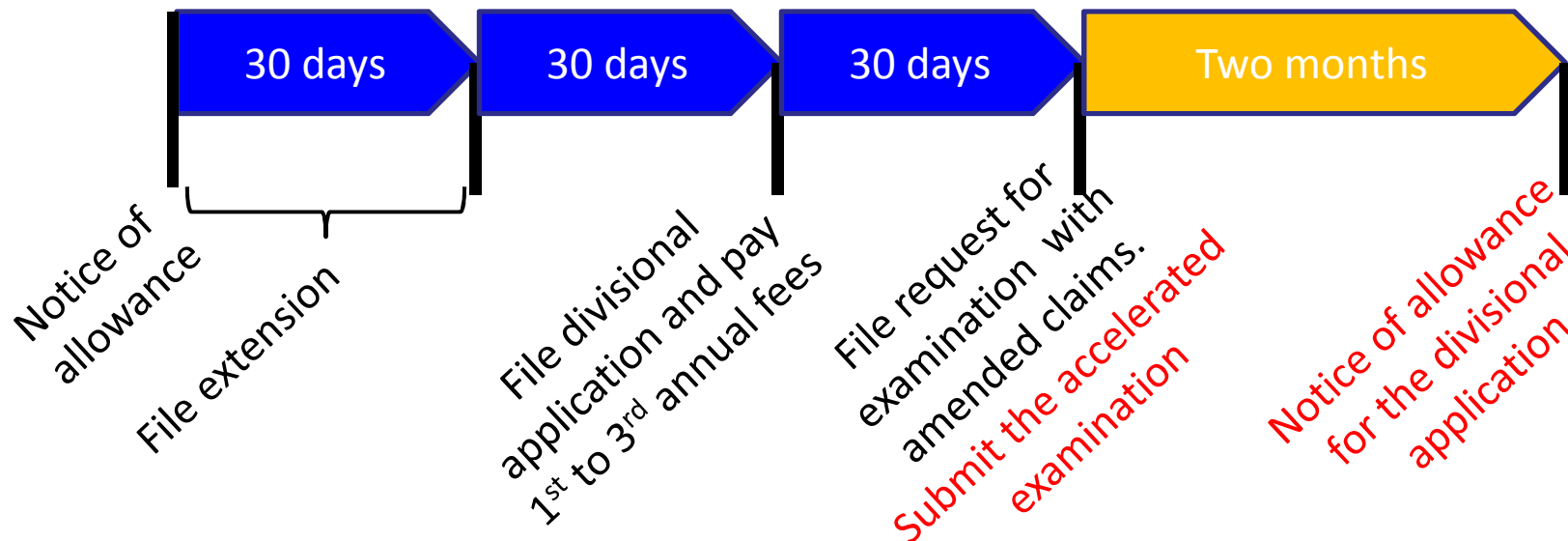
1. First, the divisional application was filed with the original claims within 30 days from the notice of patent allowance.

2. Second, the request for examination was made 30 days from the filing date of the divisional application with the request for accelerated examination.

When filing the request for examination, claims were amended to cover the Chinese products.

3. Third, a patent was issued on the divisional application.

4. We can now proceed to civil/criminal/administration action against the Chinese products.



## Key point on session 1

- PPH can be used for obtaining patent right with claims that is the same as the claims of the earlier granted U.S. patent.
- The divisional application can be used after the notice of allowance.
- We can file divisional application at the time the following:
  - Before first office action
  - within the period for response to office action
  - within the period for response to final office action



Thank you for your attention