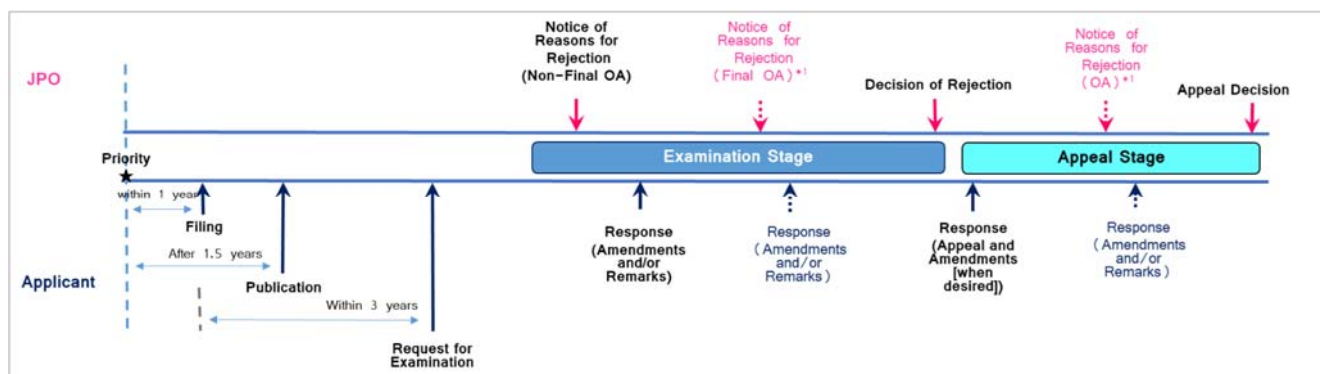
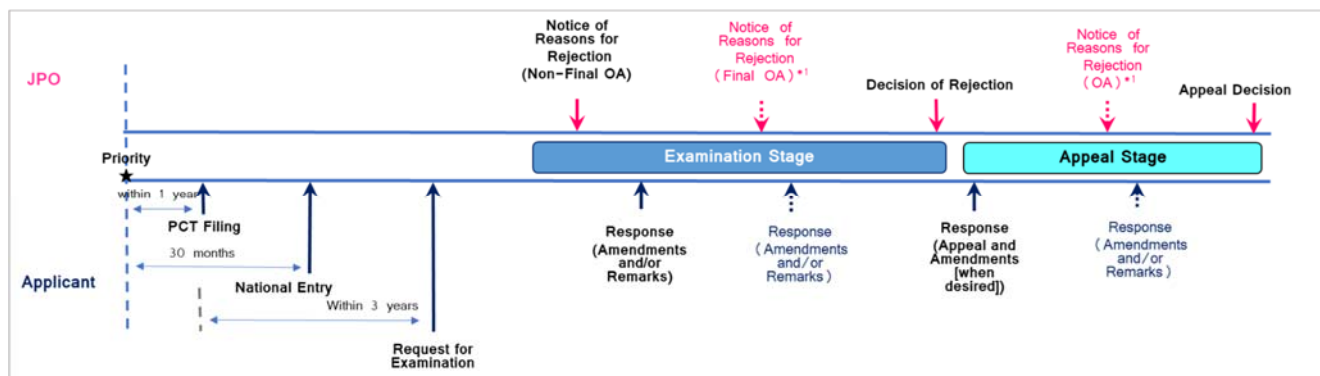


## OVERVIEW OF PATENT PROSECUTION

### ❖ FLOWCHART 1 JAPANESE PATENT FILINGS UNDER THE PARIS CONVENTION (FROM EXAMINATION STAGE TO APPEL STAGE)



### ❖ FLOWCHART 2 JAPANESE NATIONAL PHASE ENTRY BASED ON PCT APPLICATIONS (FROM EXAMINATION STAGE TO APPEL STAGE)



When considering patent obtainment in Japan, applicants are allowed to utilize the two procedures; examination (first stage) and appeal (second stage). In case that applicants are not able to obtain patents at examination stage, they are entitled to utilize the following procedures as alternatives:

- 1) Filing a request for appeal; and/or
- 2) Filing a request for divisional application

### ❖ PREPARING PATENT APPLICATIONS

#### Claims

- Two part form (preamble and body) is not required.
- Multiple-dependent claims, and multiple-dependent claims which are themselves dependent on multiple-dependent claims are allowed.
- Several categories of inventions can be included in a set of claims in one application, as long as the set of claims satisfies the requirement of unity of invention.

For example: product, method, method of producing a product

## OVERVIEW OF PATENT PROSECUTION

### ❖ PUBLICATION (FOR APPLICATIONS UNDER THE PARIS CONVENTION)

The content of a patent application is published by the JPO one year and six months after the priority date of the application. Please keep in mind that publication at an earlier stage is allowable if the applicant wishes to do so and files a request for patent publication.

### ❖ FILING A REQUEST FOR EXAMINATION

#### Due Date for Filing a Request for Substantive Examination

- Within 3 years from the filing date

[Definition of the "filing date"]

- Paris route (Direct application): Filing date at the JPO
- PCT: International filing date

#### Fee

The overall cost of an examination consists of a basic application fee and proportional surcharges based on the number of claims. For more detailed information, please visit the JPO website: <https://www.jpo.go.jp/english/faqs/fees.html>

#### Types of Examination

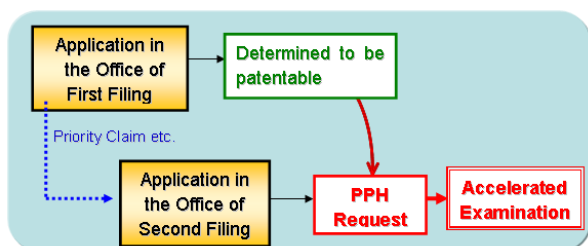
The JPO secures patent obtainment at an earlier stage by introducing the following examination systems aside from the regular procedure.

#### 1. Regular Accelerated Examination

Compared with regular examination/appeal procedures, accelerated examination/appeal enables applicants to receive the examination/appeal results at an earlier stage. The average duration between filing a request for accelerated examination and issuing a first Office Action is less than three months as of 2017, comparatively shortening the period from the regular examination/appeal procedure. Please keep in mind that applicants are required to submit information regarding prior art and comparisons between the prior art and the claimed invention.

#### 2. Patent Prosecution Highway (PPH)

The Patent Prosecution Highway (PPH) is a legal framework which allows applicants to apply for a simplified and accelerated examination process when they file a corresponding patent application to the Office of Second Filing after the Office of First Filing determines the claimed invention to be patentable. The PPH is carried out based on bilateral office agreements.



(The image above is excerpted from the JPO website)

The allowable usage of corresponding examination results for PPH is expanding.

For more detailed information, please refer to the JPO website; [https://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/patent\\_highway\\_e.htm](https://www.jpo.go.jp/torikumi_e/t_torikumi_e/patent_highway_e.htm)

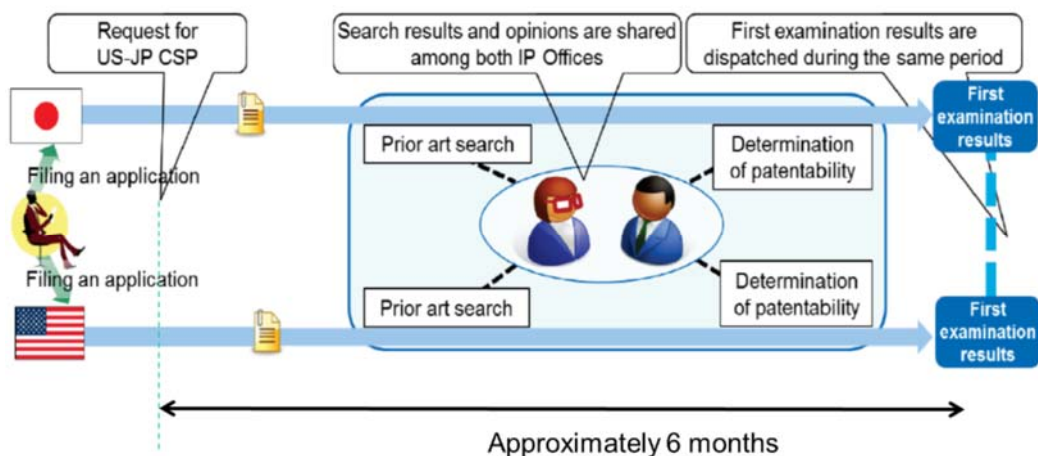
## OVERVIEW OF PATENT PROSECUTION

### 3. US-JP Collaborative Search Pilot Program (US-JP CSP)

The JPO and USPTO make joint efforts to enhance the quality of patent examination through collaboration between the JPO and USPTO examiners. On November 1, 2017 the JPO and USPTO commenced the US-JP Collaborative Search Pilot Program, which will last three years (until October 31, 2020).

[Advantages]

- The first Office Action may be obtained approximately six months after a request for the US-JP CSP
- May be able to obtain stronger and more stable rights through the two offices' collaborative searches



(The image above is excerpted from the JPO website)

For more detailed information, please refer to the JPO website; [https://www.jpo.go.jp/torikumi\\_e/torikumi\\_e/nichibei\\_e.htm](https://www.jpo.go.jp/torikumi_e/torikumi_e/nichibei_e.htm)

### ❖ VOLUNTARY AMENDMENTS

Voluntary Amendments are allowed at any time before the first OA is issued. Thereafter, the term for filing amendments is limited to the response time period following the issuance of an OA, etc. For more detailed information, please refer to our Practical Tips: Amendments.

### ❖ RESPONSE TO OFFICE ACTIONS (OAs) AT THE EXAMINATION STAGE

Response period:

- Three months for foreign applicants

Extension (during Examination Stage):

- A two month extension is available upon request. Furthermore, an additional one month extension is available upon request.
- Please refer to the JPO website for the official fee for extension. [http://www.jpo.go.jp/tetuzuki\\_e/ryoukin\\_e/ryokine.htm](http://www.jpo.go.jp/tetuzuki_e/ryoukin_e/ryokine.htm)

## OVERVIEW OF PATENT PROSECUTION

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Other:

- In the examination stage, the average number of Office Actions was 1.1 in 2017, and amendments can be filed as a response to each Office Action.
- Major reasons for the OAs: violation of inventive step, violation of novelty, lack of description requirements, and lack of unity of invention

With respect to requirements for filing a request for amendment in response to the OAs, please refer to our Practical Tips: Amendments.

### ❖ DIVISIONAL APPLICATIONS

An applicant is eligible to file new patent applications based on a patent application (original application) containing two or more inventions. For more information, please refer to our Practical Tips: Divisional Applications.

### ❖ FILING A REQUEST FOR APPEAL

An applicant is eligible to file a request for Appeal in the case that the applicant is not satisfied with the Decision at the examination stage.

Response period:

- Four months for foreign applicants

Extension:

- An extension is NOT available upon request.

Other:

- A request for Appeal can be filed simultaneously with amendments
- Reasons for filing a request for Appeal (or Appeal Brief) are able to be submitted after the request.
- Office Action after filing an Appeal is NOT always issued. An Office Action is necessarily issued after filing a request for Appeal. If a divisional application is required, the period to file an Appeal will be the last opportunity.
- If Office Action is issued during Appeal stage, three times one-month extension is available upon request.