

TOKYO - JAPAN

NAKAMURA & PARTNERS

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OUTLINE OF PATENT PROSECUTION IN JAPAN

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1. Application

(1) National Phase of International Application under PCT

The international application under PCT must be entered into the national phase within **30 months from the earliest priority date** of the international application. The Japanese translation of the international application must be filed at the time of entering into the national phase or optionally within 2 months from the entry into the national phase.

(2) Conventional Non-PCT Application (Application in Japanese)

If the applicant files a non-PCT application claiming Paris Convention priority, the application must be filed within 12 months from the earliest filing date of the foreign prior application on which the priority is claimed. The non-PCT application can be filed with a specification, claim(s), and drawings in **Japanese, English or other foreign languages**. If the application is filed in foreign language, the Japanese translation of the specification, claim(s), and drawings must be filed within 2 months from the filing date of the application.

(3) Documents and Information Required for Filing Application

Please see the paragraph 13 of this Outline.

(4) A Case Where an Invention Was Disclosed to Public Before Filing a PCT Application

If the novelty of an invention was lost as a result of disclosure to the public via, for example, a scientific article, TV or newspaper, before the filing a PCT application, the applicant can apply for **an exception to lack of novelty (Article 30)** under a certain condition. In order to meet the condition, the PCT application must be filed **within 6 months** from the date of publication or disclosure. Further, (i) a document for application of Article 30 and (ii) a document proving that the invention lost the novelty must be filed within 30 days from the date of entering into the Japanese national phase.

2. Laying Open to Public

(1) Official Gazette

As for a PCT application, the submitted Japanese translation of a specification, claim(s), and drawings is laid open to the public in the Official Gazette after the expiration of 30 months from the earliest priority date. As for a non-PCT

application, the specification, claim(s), and drawings are laid open to the public in the Official Gazette after the expiration of 18 months from the earliest priority date.

(2) Right to Demand Compensation

After the application has been laid open to the public, the applicant has the right to demand compensation from any person who works the claimed invention. To demand compensation, the applicant must first send a warning letter to said person. However, the compensation can be obtained only after the application has been patented.

3. Request for Examination

As the Japanese Patent Law adopts the deferred examination principle, an application is not substantively examined unless a request for examination is filed within 3 years from the filing date. The due date for requesting examination can never be extended. If a request for examination is not filed by the due date, the patent application will be deemed to have been withdrawn. It should be noted that the official fee for requesting examination depends upon the number of the claim(s) to be examined. When there is a reasonable ground for failing to file a request for examination by the due date, it is possible to file the request within 2 months from the date on which the ground ceased and within 1 year after the due date.

The duration between a request for examination and an issuance of the first Office Action has recently been shortened, averaging approximately less than one year.

4. Substantive Examination

(1) Examination Process

In the examination, the claimed invention is examined for patentability such as patent eligibility, novelty, non-obviousness, and double patenting. When the Examiner finds a ground for rejection in the examination, he or she issues an Office Action, a reason(s) for rejection.

(2) Accelerated Examination

If the applicant wants to expedite an examination procedure in the JPO, the applicant can request accelerated examination using one of the following systems (i) to (iii):

(i) PPH (Patent Prosecution Highway): a result of examination of first-filed application or PCT search report (PCT-PPH) can be used to apply for a PPH request. The following documents are necessary:

- (a) claims correspondence Table;
- (b) a copy of all claims and its translations;

- (c) a copy of the office actions issued in the Office of first filing or PCT search report and its translation; and
- (d) Copies of all cited documents.

*In many cases, documents (b)-(d) can be omitted.

(ii) Accelerated examination or preferential examination: the accelerated examination can be requested for a "foreign-related application" of which corresponding application has been filed in a foreign country. To request accelerated examination, the applicant must submit the result of a prior art search such as an EPO Search Report and a written opinion on patentability of the claimed invention over the closest prior art found in the search.

(iii) Super accelerated examination: it can be applied to an application which meets the conditions for both "foreign-related application" and a "working-related applications".

The outcome (a first Office Action or an allowance) of the accelerated examination systems (i)-(iii) described above will come in about 2.5 months (average in 2016) (but please note that JPO may take more time (about 5 month if a PCT application does not satisfy certain conditions)).

5. Office Action and Response

(1) Notification of Reason(s) for Rejection

When the Examiner finds ground(s) for rejection as a result of the substantive examination, he or she issues an Office Action, that is, a notification of reason(s) for rejection.

The applicant can respond to a notification of the reason(s) for rejection by filing an argument and/or an amendment within 3 months from the receipt of the notification of the reason(s) for rejection. This term can be extended up to 3 months (first 2 months and then 1 more month) upon request. It is possible to request the extension of the time even after the expiration of the term, but not later than 2 months. It should be noted that the amendment must be made within the original disclosure. In the response, it is preferable to specify which descriptions in the specification support the amended claim(s).

A divisional application can be filed within the above term for response.

(2) Final Notification of Reason(s) for Rejection

If the Examiner determines that all the previously notified grounds for rejection have been overcome but the other ground(s) for rejection has been caused by the amendment, then he or she issues another Office Action, that is, a "final" notification of reason(s) for rejection.

The applicant can respond to a final notification of the reason(s) for rejection similarly to a notification of the reason(s) for rejection as mentioned above. However, with regard to an amendment in response to a “final” notification of the reason(s) for rejection, it should be further noted that an amendment to the claim(s) shall be further limited to the following items (i)-(iv):

- (i) cancellation of the claim(s);
- (ii) restriction of the claim(s) (only those restrictions of all or some of the matters necessary to define the invention (or the current constituent elements) claimed in the claim(s), and after which restrictions are made, the industrial applicability of and the problem to be solved by the invention claimed in the amended claim(s) should be the same as those of the invention claimed in the claim(s) prior to the amendment);
- (iii) correction of errors in the description; and
- (iv) clarification of ambiguous descriptions (only those amendments with respect to the matters mentioned in the reason(s) for rejection).

6. Decision for Grant and Issue Fee

When the Examiner finds no ground for rejection or all the grounds for rejection notified have been overcome, he or she issues a decision for grant. To register the patent, the applicant has to pay an issue fee to the JPO within 30 days from the receipt of decision for grant. The issue fee includes the first three years' annuities. If the issue fee is not paid within the term, the patent application will be deemed to have been withdrawn. After the patent is registered, the Letters Patent will be issued, then the Official Gazette of the patent will be published. The patent right becomes effective from the date of the registration of the patent, and the patent right expires after the expiration of 20 years from the filing date of the application.

7. Decision of Rejection

If, as a result of the examination after filing an argument and/or an amendment, the Examiner still considers that the grounds for rejection notified has not been overcome, he or she issues a decision of rejection. The applicant can file an appeal with the JPO within 4 months from the receipt of the decision of rejection. This 4-month period cannot be extended.

8. Appeal and Reconsideration by Examiner before Appeal

(1) Amendment

The applicant may file an amendment simultaneously with the filing of a notice of appeal, and may file a divisional application at the same time. Under Japanese patent practices, this is most likely the last opportunity to file an amendment. It should be noted that an amendment to the claim(s) shall be

limited to the items (i)-(iv) mentioned in connection with a final notification of reason(s) for rejection.

(2) Appeal Brief

After filing a notice of appeal, the applicant must file an appeal brief to argue against the final rejection by the due date which will be later set by the JPO and is usually within a period of about two months from the filing of a notice of appeal. The applicant can file an appeal brief at the same time of filing a notice of appeal.

(3) Reconsideration by Examiner

When an amendment is filed, the application is reconsidered by the Examiner who issued the final rejection. If the Examiner considers that the ground for rejection still remains in spite of such an amendment, he or she transfers the application to the Appeal Board. On the other hand, if the Examiner considers that the ground for rejection has been overcome, he or she issues a decision for grant.

(4) Examination by Appeal Board

The application is examined by the Appeal Board consisting of three Appeal Examiners. If the Appeal Board considers that the ground for rejection is overcome, the Board issues a decision for grant. On the other hand, if the Appeal Board considers that the ground for rejection still remains, the Board issues a decision of rejection. The applicant may subsequently bring a suit before Intellectual Property High Court ("IP High Court") within 120 days from the date of receipt of the decision. This period cannot be extended. It should be noted that the applicant cannot amend application documents in a suit.

9. Opposition

Oppositions can be filed against any registered patent published in the patent publication on or after April 1, 2015.

An opposition can be filed within six months from the date on which the patent is published on the patent publication. Any person can file an opposition, including individuals, businesses, and legal entities. Substantive requirements for registration of a patent, such as "novelty" and "inventive step" of an invention and the description requirements for the claims and specification, are the primary grounds for an opposition.

A board of three trial examiners will examine the opposition and issue a decision on the opposition. The patentee has at most two opportunities to make corrections to the claims and specification, first in response to the first notice of reasons for

revocation and again in response to the second notice of reasons for revocation (preliminary announcement of decision of revocation). The opponent can file a counterargument against the patentee's request for corrections. The examination is entirely document based, and there is no oral hearing.

If a decision to revoke the patent is issued, the patentee can appeal the decision to the IP High Court. If a decision to maintain the patent is issued, the opponent cannot appeal the decision. However, where appropriate, the opponent can file an invalidation trial.

10. Invalidation Trial

Invalidation trials can be filed at any time during the life of a patent, and even after the expiration of the patent under certain circumstances. Only an interested party can institute an invalidation trial. Grounds for invalidation trial are the same as grounds for opposition, except for a usurped application (an application by a non-entitled person) and/or non-compliance with the joint application requirement, both of which relate to private interests and therefore also constitute valid grounds for invalidation trial.

An invalidation trial is conducted by a trial board consisting of three trial examiners. The procedure of the invalidation trial is an inter parte proceeding between the challenger and the patentee. The patentee may correct the claims, the specification or the drawings under strict requirements.

Either party may appeal from the decision of the trial board to the IP High Court. The decision of invalidating a patent has retroactive effect; namely, the patent is generally deemed as if it did not exist from the beginning.

11. Third Party Observation

A third party observation can be used to prevent a pending patent application from being established as a patent by a submission of relevant prior art. A third party observation can be filed anonymously. A third party observation is a very simple measure for a company to prevent competitors from acquiring patents on technologies which may interfere with the company's business in the future.

12. Miscellaneous

(1) Chances for Amendment and Divisional Application

An amendment can be filed only before a decision of grant is issued as a result of the examination. Once a notification of reason(s) for rejection is issued, the chance for filing an amendment is limited to the following:

- (i) during the period for a response to a notification of reason(s) for rejection issued during the examination, which is basically 3 months from the receipt of the notification and can be extended by 3 months upon request.
- (ii) at the time of the filing of a notice of appeal to lodge an appeal.

A divisional application can be filed during a period during which an amendment can be filed. In addition to said period, it is now allowed to file a divisional application during the periods specified below:

- (i) within 30 days from the receiving date of an allowance (except an allowance as a result of an appeal examination made after receiving a decision of rejection).
- (ii) within 4 months from the receiving date of a decision of rejection even if an appeal is not filed thereagainst.

(2) Abandonment and Withdrawal

The application can be abandoned or withdrawn at any time. However, when it is abandoned or withdrawn before being laid open to the public, it does not stand as a prior application with respect to a later application. The applicant can also make an application substantially withdrawn by not responding to a notification of reason(s) for rejection.

13. Documents and Information Required for Patent Application

(1) Information

- (i) Applicant's name, address and nationality.
- (ii) Inventor's name and address.
- (iii) Specification, claims and abstract.
- (iv) Drawings, if any.
- (v) If priority is claimed, a statement to this effect must be given in the application, together with the date of priority, the name of the country where the basic application was filed and, preferably, the serial number of the basic application.

(2) Documents

- (i) Certified copy of the basic application, if Convention Priority is claimed for a non-PCT application. The copy may be filed later, but it must be filed within 16 months from the filing date of the basic application. This period cannot be extended.
- (ii) Power of Attorney. Power of Attorney will be requested by the JPO at a certain stage of a prosecution such as abandonment, withdrawal, and

demanding an appeal. When Power of Attorney is necessary, we will provide you with a blank form.

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