



EFFECTIVE WAYS TO OBTAIN JAPANESE PATENTS

The Japan Patent Office (JPO) strives to continually improve the patent system to better serve the needs of patent applicants and the public in view of globalisation and growing innovation. This underlying policy has been a catalyst behind various changes to the Japanese patent system. Kenji Sugimura and Takahiro Yamazaki explain.

In order to seize the full commercial potential of a Japanese patent, it is important to capitalise on all protective avenues provided by the JPO. Understanding the technical scope and application of patent laws and regulations is essential to avoid unnecessary restraints, narrowed patent rights and slow, costly prosecution.

Patent Prosecution Highway programme

The JPO continues to implement Patent Prosecution Highway (PPH) programmes with an ever-expanding list of countries. The PPH allows an applicant who is issued a patent from the patent office where the application was first filed to request that another patent office accelerate the examination of that patent. The office of second filing can utilise the search and examination results of the office of first filing. This process avoids duplicating work and expedites the second examination processes. Applicants benefit from an increased probability of patent issuance, a shorter wait period and cost reduction. This year, Japan implemented pilot PPH programmes with China, Sweden and Mexico. This brings Japan's list of countries involved in its PPH programme to 16.

On January 29, 2010, the JPO expanded the PPH programme to permit PPH eligibility for national and regional phase applications under the Patent Cooperation Treaty (PCT) on the basis of positive results in the PCT international phase. The PCT-PPH originally launched between Japan, the US and Europe, but has since been expanded to include Korea, Australia, Austria, Finland, Russia and Spain.

As of July 15, 2011, a new pilot programme known as the PPH MOTTAINAI Pilot, was implemented to test a framework that enhances the former PPH system. Under the original PPH plan, eligibility was limited to the reuse of search and examination results from a participating office of first filing. Under this enhanced PPH framework, participation may be requested on the basis of results available from any office participating in this pilot, regardless of whether it was the office where the application was first filed. The new model also incorporates additional improvements to the basic PPH

framework, including a new definition of claim correspondence, which will make the system more flexible and user-friendly without compromising efficiency or quality. Countries participating in the programme include Australia, Canada, Finland, Japan, Russia, Spain, the UK, and the US.

Use of these PPH schemes results in fewer office actions and faster patent granting. After filing a request for examination, the patent examiner will either grant the patent or issue a notification of reasons for rejection (notification of rejection). The applicant can then respond by filing amendments to and arguments for the application. This process of notification and amendment may repeat two or three times. The duration from the time of filing an examination request to time of the first office action for a non-PPH application is roughly 29 months. In contrast, the average waiting time for first office actions in PPH examination is less than two months, nearly a 10th of the time of a non-PPH application. This clearly demonstrates the time-saving benefits of the PPH system. Moreover, decreased pendency periods correlate with decreased costs in patent prosecution.

The average number of notifications of rejection in non-PPH applications is roughly 1.25 as opposed to 1.09 in PPH applications. When comparing the number of notifications of rejection based on the inventive step requirement, it is 0.96 for non-PPH applications and 0.69 for PPH applications. This illustrates other benefits of the PPH system: the increased probability of patent approval and the decreased number of office actions. Again, fewer office actions also correlate with lower prosecution costs. However, the average number of notifications of rejection based on the description requirement remains the same for both non-PPH applications and PPH applications. This statistic implies that the JPO interpretation of the description requirement is more stringent than that of the US Patent and Trademark Office. This description requirement must be overcome in order to take full advantage of the expedited patent application process provided by the PPH system. In order to ensure that the description requirement is fulfilled

during examination, it is important to carefully craft claims in light of the JPO interpretation of the description requirement.

Active use of divisional applications

Patent applicants who have a patent pending with the JPO may take portions of that patent and submit them as a divisional application for another patent. The benefit of this arrangement is that the new application, or divisional application, will be backdated. Divisional applications will be held to have the same filing date as the original application. Moreover, the allowable time period for filing divisional applications was recently extended by the 2008 revised Patent Act. Prior to the revision, divisional applications could only be filed during the period in which amendments were allowed. The revision now allows divisional applications to be filed within 30 days of the service date of the examiner's decision to grant the patent. Of course, care must be given when perusing this course of action, as divisional applications are not allowed after the original patent has been registered. Thus, it is important to file divisional applications prior to paying the registration fees of the original patent. This creates a significant advantage for patent applicants, especially when used in conjunction with the PPH programmes. Applicants can now obtain narrowly tailored patents for critical time-sensitive inventions via the PPH programme, and later on, pursue broader protection through a divisional application. In this way, active use of divisional applications can circumvent the limiting factor of the PPH system, where only claims that 'sufficiently correspond' to the claims indicated as patentable by the PPH-participating state are allowed. In capitalising on this, the patent applicant can achieve strategic business advantage and maximise the commercial potential of their invention.

Strategies addressing the prohibition of scope-shifting amendments

So-called 'scope-shifting amendments' are amendments to claims that change the special technical feature (STF) of an invention so that they no longer have the same or corresponding STFs as the original claimed invention. Scope-shifting

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amendments are prohibited under the Patent Act Article 17bis(4) for violating the requirement of unity in relation to the already examined invention. To determine whether an amendment changes the STFs of the original invention, the JPO compares all the inventions in the claims that were already examined prior to the amendment to all the inventions in the claims after the amendment to see if they meet the requirements of unity of invention. This process of determination can result in damaging consequences if claims are not carefully drafted. For example, if two claims are rejected for lack of unity as each contains a different STF and the applicant wishes to dismiss the first claim and resubmit only a reiteration of the second claim as the amended claim, the amended claim will be rejected because it does not have unity with the first claim. Another precarious situation occurs when the claims prior to amendment do not contain an STF. In such a situation, the JPO assesses the existence of an STF by selecting the claim with the smallest claim containing an STF. Only those claims that were previously examined for the existence of STFs and those claims that embody that STF will be the subject of the examination; all other claims will be rejected for lack of unity. This may lead to cases where unnecessary claim restrictions have to be made in subsequent amendments, simply because of the order of claims. In order to avoid such a situation, it is important to refrain from reciting overly broad claims that do not contain STFs independently, assign small claim numbers to important claims and craft those claims narrowly enough to contain STFs. ■

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Takahiro Yamazaki joined Sugimura International Patent & Trademark Attorneys in 2006, and qualified as a Japanese Patent Attorney. Yamazaki works for a number of clients in the tire, packaging, sports equipment, machine tool and automotive fields. He serves as client manager assisting several American clients and European clients to meet their needs.