

Overview of the Patent Prosecution Process in Japan

A patent application filed within 12 (twelve) months in any country that is a signatory of TRIPS or the Paris Convention may be used as the basis for a claim of priority in Japan. A priority document must be filed within 16 (sixteen) months from the priority date of the priority application. If priority is based upon a US, EPO or KIPO application, the priority document may be omitted, as these offices share information through an electronic transfer system. Note that, a power of attorney is not necessary in order to file a patent application in Japan. A power of attorney is necessary when undertaking an appeal of a rejection or decision, or when the patent application is granted or rejected. Ariga will provide all relevant documents relating to power of attorney to the client.

Proceedings at the JPO are in Japanese, however, the initial patent application may be in English. A Japanese translation, along with an additional fee, must be filed within 14 (fourteen) months after the priority date. The English specification may not be amended during the examination procedure.

Basic Points to Consider

1. The JPO will conduct a formality examination to determine whether the essential formal requirements have been met. If they have not been properly met, an invitation for correction will be offered in order to supply or correct the missing documents or sections.
2. The JPO will publish the application in the Official Gazette 18 (eighteen) months after the priority date. The applicant may request the application be published sooner, and such an accelerated publication usually occurs 3 (three) months after the filing of such a request.
3. The applicant or a third party must file a request for substantial examination (examination on the merit) and pay the examination fees before an application can be examined. If no request for examination is filed within 3 (three) years from the filing date, the application is deemed to be withdrawn and generally cannot be revived. However, the application can be revived in the case where the applicant has reasonable grounds for failing to file a request for examination.
4. While the number of claims is not specifically limited, additional fees are required for the substantive examination and registration of a patent grant based on the number of claims.
5. As the specification may be amended during the national phase, it is not required that all amendments made for PCT applications under Article 19 and Article 34 be filed when entering the national phase. The original application may enter the national phase and later be amended in Japan on the basis of prosecution results in the US, the EU, etc.
6. The deadline for entering the national phase in Japan is 30 (thirty) months from the priority date.
7. An accelerated examination may be requested for any Japanese application having a

corresponding foreign application. A copy of a search report must be submitted at the time of the request for an accelerated examination. Generally, the first Office Action is issued within 4 (four) months for an accelerated examination, while it generally requires more than a year for applications examined under normal conditions.

The Substantive Examination (Examination on the merit)

An examiner at the JPO will investigate whether the application satisfies the following requirements for registration:

Is the claimed invention based on a technical idea which utilizes a law of nature? (Eligible Subject Matter)

Is the claimed invention industrially applicable? (Eligible Subject Matter)

Did the technical idea exist before the filing of the current application? (Anticipation/Novelty)

Could the claimed invention have been easily invented by a person skilled in the art? Non-obviousness/Inventive Step)

Is the application the first to be filed? (Double Patent)

Is the claimed invention liable to contravene public order and morality?

Do the descriptions in the specification conform exactly with the patentability requirements?

Notification of Reasons for Refusal (Office Action), and subsequent Remarks (Argument), and Amendments

The Examiner shall notify the applicant of the reasons that the application for which patent is sought is thought to be unpatentable.

Working with the applicant, Ariga International Patent Office will craft remarks (argument) and amend the application in order to overcome the Examiner's reason(s) for refusal, taking steps necessary to avoid the introduction of a new matter to the application.

When the Examiner is satisfied that the reason(s) for refusal has (have) been overcome by the remarks (argument) and amendment, a decision of grant shall be issued to the applicant. The patent, upon registration by payment of at least the 1st to 3rd annuities shall be published in the Patent Gazette and a Certificate of Patent shall be sent to the applicant.

Generally, an applicant not residing in Japan has 3 (three) months to respond to an Office Action, however, a 3 (three) month extension is usually easy to obtain even if the extension is filed after the date by which the response was to be made.

However, if the Examiner deems that the reason(s) for refusal has (have) not been overcome, a Decision for Refusal (Final Rejection) shall be issued. The applicant may file a request for a trial against a Decision of Refusal, so that the application maybe examined by a collegial body of three to five Examiners. The collegial body of Examiners will determine whether there is sufficient reason to overcome the Decision of Refusal or not.

The applicant has 120 (one hundred twenty) days from issuance of the Final

Rejection to file a Notice of Appeal simultaneously with amendments to the application.

Post Grant Opposition System (from 2015)

Anyone may file a post grant opposition within 6 (six) months of patent issuance. During this, the patent owner can narrow the claims or rewrite dependent claims as independent claims in an amendment. The opposing party is notified of any amendments and provided an opportunity to respond to the amendment. The examination is limited to submitted documents, the oral proceedings portion has been eliminated.

An Invalidation Trial may be requested at any time after patent issuance, but only by an interested party (3rd party) which has a vested or commercial interest in the patent in question. The owner of the patent is permitted to restrict the scope of the claims during the trial in order to eliminate prior art being used to invalidate the entire patent.