

Accelerated Examination and Accelerated Appeal Examination

The accelerated examination system and the accelerated appeal examination system permit an examination or appeal to be conducted more quickly than through the regular examination and appeal systems. Accelerated examination is available for any patent application for which there is a corresponding foreign application (in the same PCT family or by a claim for priority under the Paris Convention). The accelerated examination can be requested for most patent applications filed by foreign applicants. According to the Japan Patent Office (JPO), the first action (FA) will be issued within 3 (three) months from the request. Requesting an accelerated examination differs from using the Patent Prosecution Highway (PPH) in that the accelerated examination requires an explanation of the features distinguishing the invention of the present application over the prior art, and the claims need not be substantially identical to the claims found to be patentable by a foreign patent office.

The conditions for requesting an accelerated examination are:

- 1) A counterpart patent application has been filed in a country other than Japan.
- 2) A request for examination has been filed with the JPO.
- 3) A FA has not yet been issued by the JPO.

1. Advantages of requesting an accelerated examination or an accelerated appeal examination

Compared to the regular examination system, examination results are obtained more quickly through the accelerated system. The average pendency until the FA under the accelerated system was about 1.9 months, in 2012, which is much shorter than under the regular examination system.

In 2012, when an accelerated appeal examination was requested, the average time until an appeal decision was made and dispatched was 3.3 months from the date that the accelerated

appeal examination was requested.

2. Applications and Appeals eligible for the accelerated examination system

Currently, the system may be applied to the following six types of applications and appeals against an examiners' decision of refusal:

i) "Working-related applications"

An application filed by an applicant or a licensee who has already commercialized the invention or plans to commercialize the invention within 2 (two) years from the filing date of the request for an accelerated examination.

ii) "Internationally-filed applications"

a) An application that has been filed with both the JPO and at least one foreign IP office;

b) An application that has been filed with an IP office as the Receiving Office under the PCT and has entered into the national phase in Japan; and

c) An application that has been filed with the JPO as a domestic application and was also filed with the Receiving Office under the PCT.

iii) "Applications filed by Small and Medium-sized Enterprises (SMEs), individuals, universities, public research institutes etc."

Applicants, in whole or in part, who are SMEs, individuals, universities or public research institutes, or approved or authorized Technology Licensing Organizations (TLOs).

iv) "Green-related applications"

An application that seeks a patent for a "Green Invention" (an invention that has an energy-saving effect and contributes to CO₂ reduction).

v) "Earthquake Disaster Recovery Support-related applications"

An invention relating to patent applications, design registration applications, trademark registration applications or appeals against an examiner's rejection related with the aforementioned applications that fall under the following (a) or (b).

a) Applications and appeals against an examiner's rejection in which at least one of the applicants has an address or temporary residence in specified affected areas (http://www.meti.go.jp/english/press/2011/0728_02.html - this link has been expired) and applications by people affected by the Great East Japan Earthquake (Tohoku Earthquake) and related disasters of March 11, 2011.

b) An applicant who is an incorporated entity, and the incorporated entity's business establishment is in the specified affected areas which suffered damage from the Great East Japan Earthquake (Tohoku Earthquake) and related disasters of March 11, 2011, and the applicant intends to file an application for (1) an invention, (2) a design, or (3) a trademark related to the business operations of any of the business establishments listed below, or file an appeal against an examiner's rejection related to any of the above-mentioned applications.

(1) An invention created or licensed as a business operation of a business establishment;

(2) A design created or licensed as a business operation of a business establishment; or

(3) A trademark used as a business operation of a business establishment.

vi) "The Asian Business Location Law-related applications"

Applications relating to the technology invented as the result of research and development activities accredited by the Asian Business Location Law.

Please use the following link for an overview of the Asian

Business Location Law

(http://www.jetro.go.jp/en/invest/newsroom/pdf/2012/20120831_overview.pdf).

vii) Accelerated Appeal Examination only.

An appeal related to an application in which a person who is not an appellant (third party) has exploited or worked the invention as a business after the appeal case has been published and prior to the rendering of the appeal decision.

3. Applicants eligible for the accelerated examination/accelerated appeal examination

Any applicant (appellant) for the accelerated appeal examination who does not have an address nor domicile in Japan must perform the procedure through a representative who has an address or domicile in Japan (for example, a Japanese patent attorney). A third party may not request an accelerated appeal examination for another persons' application or appeal.

4. Procedures for the accelerated examination and accelerated appeal examination

The applicant shall submit:

1) The results of a prior art search performed by a foreign patent office or by the applicant. A copy of an information disclosure statement submitted to the USPTO is also acceptable.

2) A request for an accelerated appeal examination will be made by submitting a "Written explanation of the needs of the accelerated appeal examination". The circumstances related to the filing of an accelerated appeal examination must be described, the prior art documents must be disclosed, and an explanation of the similarities to the invention and the prior art, etc., must be provided in the "Written explanation of the needs of the accelerated appeal examination". The latter explanation may be omitted if the prior art and the distinguishing features of the invention are described in the specification.

There is no charge to file a request for an accelerated appeal examination.

Super Accelerated Examination

Outline of Accelerated Examination and Accelerated Appeal Examination

1. Introduction

The super accelerated examination system has been available since October 2008 and is designed such that the First Action (FA) will be issued within 1 (one) month from the request for a super accelerated examination (within 2 (two) months for Designated Office (DO) applications), and another examination will be performed within 1 (one) month from the submission of the written opinion/amendment (response to the FA by the applicant). This further reduces the time from the request for examination to the final decision compared to the regular accelerated examination system. High priority applications, which meet the requirements for "Internationally filed applications" or for "Working-related applications" of the regular accelerated examination system are the focus of the super accelerated examination system.

Unlike the normal accelerated examination, the super accelerated examination is only applicable to applications filed electronically, thus, PCT applications are excluded from super accelerated examination. Another difference is that the applicant must respond to an office action within 2 (two) months. This period may not be extended. Failure to respond within this time frame will cause the examination to be converted from a super accelerated examination to an accelerated examination as long as the conditions for accelerated examination are satisfied

There were about 400 requests for super accelerated examination in 2010. The average FA pendency of applications handled under the super accelerated examination system in 2010 was about 25 days from the date on which the super accelerated examination was requested.

Additionally, in 2010, the average period from the

request to the final decision was about 50 days, compared with an average of about 170 days under the regular accelerated examination system.

2. Super accelerated examination system basics

(A) Applications eligible for super accelerated examination

All applications including DO applications, which meet the requirements described in (1) to (5) below, are eligible for the super accelerated examination.

(1) A counterpart application has been filed in a foreign country.

(2) It is intended that the claimed invention will be used in Japan within 2 years.

(3) The application has not entered the Japanese national phase of a PCT application.

(4) A request for examination has been filed with the JPO.

(5) The FA has not yet been issued by the JPO.

(B) Internationally filed applications and Working-related applications

Highly important applications which meet the requirements both for Internationally filed applications (1) or for Working-related applications (2), are eligible for super accelerated examination.

(C) Applications for which all procedures have been performed online 4 weeks before the date of filing of the request for super accelerated examination.

(D) The application shall not be withdrawn under Article 42(1) of the Patent Act.

An applicant may request Super Accelerated Examination by submitting:

1) The results of a prior art search performed by a foreign patent office or by the applicant. A copy of an information disclosure

statement submitted to the USPTO is also acceptable.

2) An explanation of distinguishing features of the claimed invention over the prior art cited in the search report. This explanation may be omitted if the prior art and the distinguishing features are already described in the specification as submitted.

3) Evidence demonstrating that the claimed invention is intended for use in Japan within 2 (two) years.

(E) First action pendency

For normal domestic applications, FA pendency is 1 (one) month or less from the date that the request for super accelerated examination was filed. For DO applications, FA pendency is 2 (two) months or less from the date of filing the request for super accelerated examination. However, for DO applications, depending on the type of application and the filing timing, there may be a time delay in the processing of the documents at the WIPO. In such cases, the FA pendency might extend beyond 2 (two) months.

(F) Response Period for applicants

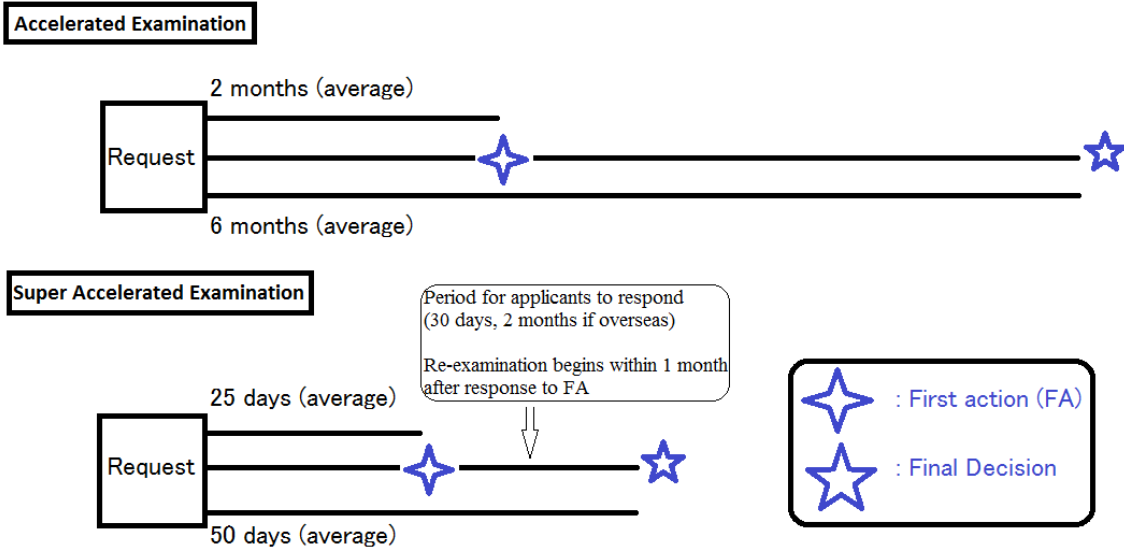
The period for applicants to respond is 30 (thirty) days from the date of sending the notification for reasons of refusal (two months for overseas applicants). Should the applicant not respond within 30 days of the sending of the FA, the application which was being handled under the super accelerated examination system shall be handled as a regular accelerated examination.

(G) Second or any subsequent action pendency period

The second or any subsequent action pendency will be 1 (one) month or less for all applications including DO applications. This has the effect of shortening the period of time to make a final decision.

As shown below, the super accelerated examination reaches a final conclusive decision faster than the regular accelerated examination.

[Comparison between the accelerated examination and the super accelerated examination]



(H) Exceptional handling during pendency

Should an examination be prolonged due to unavoidable reasons, the case shall be excluded from the list of eligible applications and shall be handled under the regular accelerated examination system.

Recently, there have been discussions at the JPO with regards to loosening the requirements in order to file applications using the Super Accelerated Examination program, but these changes which would more than likely eliminate the requirement of also having a corresponding foreign application filed, seem geared to assisting Japanese companies, particularly SMEs, use this system. As of July 2018, this had not progressed beyond the initial discussion stages at the JPO.

Preferred Examination

A preferred examination may be requested by the applicant or a third party if it is alleged that the third party is producing and/or using the invention for which a patent is sought. Upon accepting a request for preferred examination of an application, the examination of the application is made a priority.

The conditions for preferred examination are:

- (1) A third party is using the invention for which a patent is sought.
- (2) The patent application has been published.
- (3) A letter of warning has been sent notifying the third party that its action (production and/or use of the invention) falls within the scope of protection that would be provided by the claims if a patent is granted.
- (4) A request for examination has been filed with the JPO.
- (5) A patent has not yet been issued by the JPO.

The applicant may request preferred examination by submitting:

- (1) Evidence demonstrating that a product which would be covered if the claim(s) were granted is being produced and sold or a method(s) covered by the claim(s) is being used by a third party.
- (2) When the request is made by the applicant, an explanation of why the product being produced and sold or a method(s) being used by the third party is covered by the claim(s) of the application, and a copy of the warning letter.
- (3) When the request is made by the third party, an explanation of why the product being produced and sold or a method(s) being used is not covered by the claim(s) of the patent that may be granted.