

US-JP Collaborative Search Project

Since August 1, 2015, both the Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO) have undertaken a two-year pilot program with the aim of sharing results obtained by sharing information for examinations of applications filed in both countries. Under this system, examiners at the USPTO and examiners at the JPO conduct separate searches and transmit their search results and opinions to each other. This should result in the earlier presentation of search results to applicants.

This system should allow for applicants to better anticipate when their applications filed at both offices may be granted and should result in a greater stabilization and strengthening of rights granted.

Applications belonging to a group of technically-related inventions may also be examined through this system in order to simultaneously obtain initial examination results from both the JPO and the USPTO.

In November 2017, the USPTO, the JPO, and the KIPO expanded the collaborative search program for an additional three years (until 11/2020) and made a few changes to the existing pilot program which should facilitate an even greater interest in the program and provide more benefits to applicants wishing to use this program.

Requesting a Collaborative Search

There are numerous requirements which must be satisfied for both the JPO and the USPTO to accept an application(s) for this pilot program, and in some cases the phrasing is somewhat ambiguous. If you have questions as to whether your application or your client's application(s) may qualify for this program, please feel free contact us.

- A) The application may have a maximum of three (3) independent claims and a maximum of twenty (20) in total all of which

are directed to a single invention

- B) Each independent claim in the US application must "substantially" correspond to the independent claim of the Japanese application. The respective patent offices will determine whether the claims "substantially" correspond to each other. While somewhat ambiguous, it is assumed that both patent offices will deem that this requirement is satisfied if the scopes of the independent claims in the two applications are substantially the same ("substantially consistent"). A claim correspondence table must also be provided.
- C) The application is published, but has not been previously examined. This means that no Office Actions (Notice of Reasons for Refusal, Certified Copy of Examiner's Decision, etc) have been received or issued from either patent office. No request has been made for a Collective Examination for an IP Portfolio, an Accelerated Examination, or a Super-Accelerated Examination, or in the case when such a request has been made, the request is subsequently withdrawn.
- D) Both applications have the same priority date.
- E) The application date and the priority date for both applications must be later than March 16, 2013.
- F) A request for examination is submitted simultaneously or prior to the request for the US-JP Collaborative Search Project.
- G) A request may be made for up to five (5) applications comprising a group of technically-related inventions.

The application forms for the respective patent offices must be submitted within 15 days of each other, and both offices will notify each other of whether the applications satisfy the above requirements, and in turn, will notify the applicant thereof. The patent office which receives the application with the earlier application date shall be deemed to be the Office of First Search, and the other is deemed to be the Office of Second

Search.

The US-JP Collaborative Search Project Petition Form may be obtained at [sb0437jp.pdf](#).

Should both the JPO and the USPTO grant the applicant's petition for entry into the Collaborative Search Project, the applicant will be notified of the request results within three (3) months. Should there exist simple procedural irregularities in the request forms, an officer from either patent office will contact the applicant, and the applicant may be offered an opportunity to correct such errors.

It is anticipated that the time from when the initial request was made until the applicant receives notification of the initial examination will be about six (6) months. For this expanded pilot program, the JPO and the USPTO have limited the number of applications to be accepted to 400 applications per year. There are no additional fees for requesting the collaborative search program.

Notes:

Should an amendment be made to one application which causes an independent claim in one application to differ from the "substantially" corresponding claim in the other application, the applications do not meet the requirements for the US-JP Collaborative Search Project. Amendments made before the request, as long as the claims remain "substantially consistent" between the two applications are permitted.

US-JP Collaborative Search Project Detailed Design

(refer to Fig. 1 below)

- 1) The patent office which receives the application with the earlier application date (Office of First Search) shall determine the patentability through a prior art search. The results of this search shall be sent to the Office of Second Search. The Office of Second Search shall

determine the patentability through a prior art search after receiving the patentability report from the Office of First Search. The Office of Second Search will also use the report issued by the Office of First Search in making their own judgment. The Office of Second Search's determination of patentability will be sent to the Office of First Search.

- 2) The Office of First Search will pool both offices' decisions and reach an initial examination result. The applicant will receive examination results from both offices within six (6) months of submission of the application.
- 3) The examination results sent by the Office of First Search will also include a Notice of Reasons for Refusal or a Decision to Grant. The Office of Second Search will provide their initial examination results in a Pre-Interview Communication (PIC).
- 4) Should the Office of Second Search not provide their initial examination results, the Office of First Search will provide a Notice of Reasons for Refusal containing only the Office of First Search's examination results about eight (8) months after the examination request was made.



FIG. 1 US-JP Collaborative Search Pilot Project (diagram from Japan Patent Office Website http://www.jpo.go.jp/torikumi_e/torikumi_e/nichibei_e.htm)

Any questions and all submissions should be made to:
 Japan Patent Office Patent and Design Examination Department
 Administrative Affairs Division Examination Policy Planning
 Office
 Phone: +81-03-3581-1101 (extension 3103)
 e-mail: PA2260@jpo.go.jp

International Work Sharing, Planning, and Implementation
 U.S. Patent and Trademark Office
 email: csp@uspto.gov