

# **Adjust JP OA Timing for Valid US and/or JP Patents**



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## **Issues Addressed**

JPO does not well find English prior arts.  
USPTO does not well find Japanese prior arts.  
Both English and Japanese prior arts are a lot.

→ Patents Are Often Invalid.  
Not Best Worded

Q1. Is IDS possible in JP?



## **YES. Prior Arts Can Be Informed to JPO**

No Duty, No Specific Procedure, But:  
The List of Prior Arts Can Be Added to the Spec.

- List Prior Arts Cited or Submitted in the US.
- Let Examiner Consider Them.
- Solid Patents



## **Which Should Be Examined First, US or JP?**

Examined in US First → Solid JP Patent

Examined in JP First → Solid US Patent

Q2. Can we choose which?



## **YES. OA Timing Is Adjustable in JP**

3 Years to Request for Examination from JP Filing Date  
2 More Years for the First OA (Typically)

When Accelerated ... 2 to 6 Months to the First OA  
Acceleration Fee ... Only About \$500 (50,000 JPY)\*

\* If any search report or official action is available.  
Request for Examination is About \$1500 to \$2500.



## **Suggestion 1 : For Solid US Patents**

**JP** File Earlier.  
| Accelerate Examination.  
↓  
**US** Submit Prior Arts Found in JP.



## **Suggestion 2 : For Solid JP Patents**

**US** If PCT, Nationalize Earlier For Earlier OA.



**JP** File Later

Defer Examination Until US OA.

List Prior Arts Cited or Submitted in US.

Accelerate Examination, If Necessary.

Q3. Can we make both US & JP solid?



## **YES. Suggestion 3: For Solid US and JP Patents**

**JP** Accelerate Examination.



If Allowed Before US OA, File Divisional (New Law\*).



**US** Submit Prior Arts Found in JP



**JP** Defer Examination of Divisional.

Submit Prior Arts Found in US to JP Divisional.

Further Examination and Issuance.

\* Likely effective for the applications filed after April 1, 2007



## Suggestion 4: For Solid US and JP Patents

**US** If PCT, Nationalize Earlier For Earlier OA



**JP** File Later

| Defer Request for Exam. Until US OA.

| List Prior Arts Cited or Submitted in US.

| Amend Claims by Preliminary Amendment. (Following Slides)

| Accelerate Examination.



**US** After the OA(s), Delay the Issuance Until JP OA.  
Submit Prior Arts Found in JP.

More Cost Effective than Suggestion 3



## Preliminary Amendment For Better Synchronization

Vague Claims, Broad Claims

→ Less Relevant Citation

→ Important Citation After Amended



Preliminary Amendment For Better Synchronization.

Q4. What should be covered by preliminary amendment?



## **Preliminary Amendment Addresses Stricter Claim Requirements in JP**

Inventive Step...Stricter than US Non-Obviousness

→ Claims ... More Often Rejected

∴ Effect of Invention is Investigated.

→ Add Narrower Claims Securing Effects.

Claim Clarity...Stricter than US

→ Add Narrower, but Clearer Claims.



## **Programs Are Directly Claimed in JP**

Software Medium Claims → Program Claims

Selling Programs Over Internet

.... Directly Infringe Program Claims.

.... Not Directly Infringe Software Medium Claims.



## **Amendment May Also Cover Typical Alternatives**

CPU Feature ↔ BIOS/OS Feature

Hardware Feature ↔ Software Feature

Transmitter Feature ↔ Receiver Feature

Memory Feature ↔ Calibration/Initialization Feature



## **Specification Requirements Addressed by Preliminary Amendment**

1. Claims Must Be Described in the Spec.  
→ Copy Claim Languages to the Spec.
2. Incorporation By Reference  
→ Must Be Deleted in Japan



## **Impact of Patent Law Amendment**

First OA Not Overcome → Decision of Rejection

2006 No RCE, No Divisional  
No More Amendment Unless Appealed  
→ Less Challengeable Against OA

2007 Divisional OK, After Decision of Rejection\*  
→ Limit Less Against OA

\* Likely effective for the applications filed after April 1, 2007



## **CONCLUSION**

**Adjust JP OA Timing to Obtain  
Valid US and/or JP Patents, Utilizing:**

Deferral of the Examination,  
Information Listing,  
Preliminary Amendment, and  
Acceleration of the Examination.

We would welcome your comments.  
Thank you.

