

**Synchronize responses to
counterpart office actions.**



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Patents are often invalid.

USPTO and EPO do not often find
good **Japanese or Korean** prior art.

JPO and KIPO do not often find
good **English** prior art.

After a patent is issued, more relevant prior art is
found by other PTOs.

A valid patent can be obtained, if it is examined later.

Examined in US first

Valid JP/KR patent

Examined in JP/KR first

Valid US patent

Two Options for Valid Patents

Limiting the Scope **After** Patented

Limiting the Scope **Before** Patented

Limiting the Scope After Patented:

Leaves More Freedom of Limitation

Incurs Additional Fees

Consumes Patent Life

Limiting the Scope Before Patented:

Saves “Cost / Valid Patent”

Less Time Consuming

For valid US patents:

JP/KR Accelerate the examination.

US Consider prior art found in JP/KR.

Acceleration is easy and effective.

Official fee JP: zero (0)
 KR: about \$170

Attorney fee JP/KR: about \$400*

Office Action is issued in 2 to 3 months (typically)

* If any search report or official action is available.

For valid JP/KR patents:

US Examined.

JP/KR Defer request for examination.
Consider prior art found in the US.

Examination can be deferred in JP/KR.

JP: Up to 3 years from JP filing date

KR: Up to 5 years from KR filing date

For valid US, JP, KR patents:

- | | |
|--------------|---|
| JP/KR | Defer the request for examination. |
| US | OA is issued. |
| JP/KR | Accelerate the examination. |
| US | Delay the response (up to 6 months). |
| JP/KR | OAs are issued (2 to 3 months). |
| All | Respond to all office actions
considering all citations.
“Synchronized Responses” |

Synchronized Responses:

Achieve valid patents.

Save attorney fee for responding to multiple OAs.

Save in-house human resources for multiple OAs.

Make responses consistent.

Let examiners work efficiently with standard fees.

If allowed in the US:

US Allowance

JP/KR Accelerate the examination.

US Delay the payment (up to 3 months).

JP/KR OAs are issued (2 to 3 months).

US Submit IDS to the USPTO before payment.

All “Synchronized Responses”

PP Highway may allow synchronizing responses among more countries.

US	Allowance
JP/KR	Accelerate the examination.
GB/DE/etc.	<u>Accelerate the examination by PPH.</u> (Claims must be amended as in the U.S.)
US	Delay the payment (up to 3 months).
JP/KR	OAs are typically issued before US payment.
GB/DE/etc.	OAs are <u>hopefully</u> issued before US <u>grant</u> .

Prior art can be disclosed to JPO/KIPO.

No duty / No dedicated procedure

A list of prior art can be submitted to the PTO by a petition.

Inform PTOs of citations from other countries and let the examiners consider them in order to obtain solid patents.

Problem: More relevant citations are found after the first responses.

US/JP/KR “Synchronized Responses”

US/JP/KR Second OAs with more relevant citations.
... Asynchronous

File a preliminary amendment to improve the synchronization.

US OA is issued.

JP/KR Accelerate the examination.
File a preliminary amendment.
Inform PTOs of the citations from the USPTO.

US Delay the response.

JP/KR OAs are issued with more relevant citation.

All “Synchronized responses”

CONCLUSION

**Synchronize responses to counterpart
OAs to obtain valid patents, by
utilizing:**

Acceleration of the examination,
Deferral of the examination,
Preliminary amendment, and
Submission of citations from other countries.

I will welcome your comments at akihiro@ryuka.com.
Thank you.



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