

Co-published Feature:

Synchronize responses to world Official Actions for valid patents

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Patents are often invalid because prior arts are not fully discovered in the examination. The Japanese patent office (JPO) is not best suited for finding out prior arts of foreign languages, while other patent offices do not find Japanese prior arts very well. Since both Japanese and foreign language prior arts are abundant, patents are often invalid for prior arts found in other countries. In practice, we often face with a strong citation after an invention is already patented in another country.

When the patent owner enforces his or her patent, the counterparty searches citations of all counterpart applications. Having a strong citation in one country makes it difficult to utilize the patents in other countries. This problem can be solved to a good extent by synchronizing responses to official actions (OAs) of different countries.

Which should be examined first, Japanese or other applications?

Example 1: US → JP

Let us consider a typical case, where the invention was examined and patented first in the US and then examined in Japan. US claims would be amended considering a reference cited by the USPTO. The corresponding Japanese claims would be amended considering one or more references cited by the United States Patent and Trademark Office (USPTO) and the JPO. The more solid patent would be obtained in Japan, rather than in the US.

Example 2: JP → US

If the invention were patented first in Japan and then examined in the US, the more solid patent would be obtained in the US.

The order of the examinations should be determined depending upon the importance of the patent in the respective country. If a US patent is more important than a Japanese patent, it should be examined in Japan first.

How to choose the order of the examinations

The timing of an OA issuance is adjustable in Japan, by utilizing Deferral of Examination and Acceleration of Examination. The request for the examination can be deferred up to three years from a Japanese filing date. After filing the request for the examination, it takes two to three more years until the first OA is issued. Within the total period of five to six years, if a request for accelerating the examination is filed, however, an OA is typically issued within two months. Before the period of five to six years from the filing date, the timing of the first OA can be controlled by filing a request for accelerating the examination.

There is no official fee for the acceleration. The service fee for the acceleration varies firm by firm, but it is relatively small (about US\$500 at Ryuka, for example). Here are two suggestions for obtaining a valid patent:

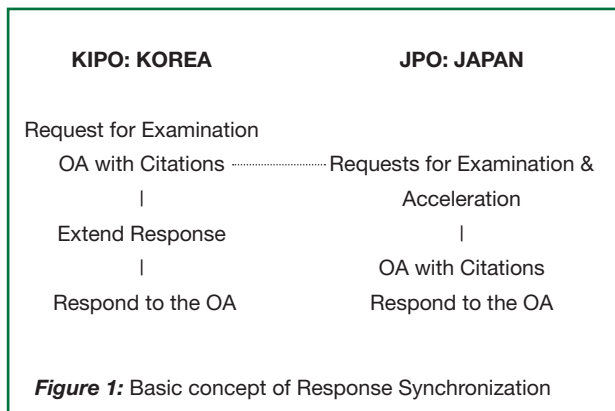
- (i) To obtain a valid patent in other countries than Japan, accelerate the examination in Japan. If the

invention was filed as a Patent Cooperation Treaty (PCT) application, nationalize the same in Japan and file a request for the examination earlier than in other countries.

- (ii) To obtain a valid patent in Japan, defer the request for the examination in Japan. For this purpose, it is also good to file a Japanese patent application late in a priority period, since the period for filing a request for the examination is calculated from a Japanese filing date. If the invention was filed as a PCT application, nationalize the same to other countries and request their examinations earlier.

Can we obtain solid patents in both Japan and other countries?

The answer is yes with the Response Synchronization. Let us assume that the applications were filed in Korea and Japan. First, defer the request for the examination in Japan. Upon receiving an OA from the Korean Intellectual Property Office (KIPO), as illustrated in figure 1, file the requests for the examination and acceleration in Japan. Extend the period for the response to the Korean OA, until another OA is issued from the JPO.



With the Response Synchronization, each response to the pending two OAs can consider citations from both of the countries. Service fees by the patent firms can also be saved, since similar responses to the pending two OAs are drafted simultaneously.

Between the US and Japan, the Response Synchronization could be looser, since the USPTO considers citations from the JPO that are submitted to the USPTO with an Information Disclosure Statement, even after the response to the US official action was already made. In this case, however, another OA might be issued from the USPTO, which increases the prosecution fee and delays the issuance of the US patent. Response Synchronization is still suggested between the US and Japan.

File a preliminary amendment for better synchronization

In figure 1, a preliminary amendment may be filed in Japan considering citations from KIPO with a request for the examination. If the claim language is too broad or vague, less relevant prior arts are found and more relevant ones come out only after the claims are limited. Therefore, for presenting the better claims in the synchronized first responses, it is beneficial to file the preliminary amendment.

If an allowance is made in Japan, however, no more amendment opportunity is given to the applicant. Even when a more relevant citation comes out in Korea later, it can not be considered in Japan. To avoid this, the applicant may add one claim that is clearly non-allowable to the end of the claim set, in the preliminary amendment.

Response Synchronization of the later OAs

Invalid patents can be significantly avoided by Response Synchronization to the first OAs. For synchronizing the responses to the second OAs from different countries, a response to the earlier second OA can be delayed; however, this does not always synchronize the responses since the extension period is limited in most countries including Japan.

If the responses cannot be synchronized, the pendency of the application should be kept in the more important country until corresponding applications are well examined. The pendency can be kept by adding a non-allowable claim or filing a continuation or a divisional application.

Should we submit prior arts to the JPO?

Disclosing prior arts is not a duty in Japan. However, it is generally suggested to inform the JPO of the citations from other patent offices for two reasons.

First, whenever a patent owner tries to license or enforce his/her patent, the counterparty or defendant searches citations of all foreign corresponding applications. If a citation found by another patent office was not considered in Japan, the counterparty will be most likely to argue validities of the Japanese patent. The fact that a citation from another patent office was not considered strengthens a position of the counterparty in negotiation. Therefore, the JPO should be informed of citations from other patent offices. For the same reason, the JPO should be informed of prior arts submitted and recorded before any other patent office.

Second, even when some citations from other patent offices were neither submitted nor considered by the JPO, the applicant still needs to consider them in combination with other prior arts for obtaining a valid patent. Informing prior arts does not necessarily increase attorney fees or limit the scope of the invention. Informing the JPO of prior arts, however, may lead to a more difficult OA, which tends to cause more prosecution estoppels. To minimize the prosecution estoppels, it is also beneficial to conduct an interview with the examiner.

Prior arts should be submitted only at the time or after the request for the examination is filed. There is no specific procedure for informing the JPO of prior arts. Still, the prior arts can be informed by amending the Background of the Invention section of the specification, or by a petition.

What about among other countries?

The request for the examination can be deferred in most countries. The applicant should also consider the timing for filing of a request for the examination in those countries, to synchronize the responses as best as they can do, or to have the application examined later in a more important country.

In conclusion, it is recommended to synchronize responses to the world OAs, utilizing deferral and acceleration of the examination, extension of response period, preliminary amendment, and information listing.

The author would welcome your questions and comments.

About the author



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