

Akihiro Ryuka and Stephen Hamon of Ryuka IP Law Firm explain how patent applicants can synchronise their applications to improve the validity of their patents while saving time and money

Synchronising prosecution to obtain stronger patents

Not all patents are equally effective at protecting IP. Beyond merely obtaining a registration, it is vital to obtain a strong patent that can stand up to validity attacks and survive litigation. To this end, it is important to consider as many relevant prior art documents as possible when limiting claims. Although perhaps the most economical option, relying largely on the patent office to uncover relevant prior art documents has the inherent problem that foreign language references are not adequately searched.

For example, the USPTO is not as good at finding relevant Japanese prior art as the JPO. As a result, when a patent practitioner prosecuting a US patent has the benefit of being able to study Japanese prior art previously uncovered by the JPO during the prosecution of a family patent, a stronger US patent will be granted. The same is true in reverse: if Japanese prosecution follows US prosecution, the USPTO prior art search will yield relevant English language patents and a stronger Japanese patent will be granted. This is useful to keep in mind if there is a jurisdiction where litigation is foreseeable. One strategy would be to always prosecute the patent in the most important jurisdiction last. However, the question remains: Is it possible to obtain strong patents in all jurisdictions? This article provides a potential solution to the above problem and demonstrates that, by synchronising prosecution, it is possible to obtain strong patents in all jurisdictions.

The tools of synchronisation

The Japan Patent Office (JPO) and the Korean Intellectual Property Office (KIPO) both provide applicants with the two tools that make synchronising prosecution possible. First, they are both jurisdictions in which a request for examination must be made separately from the filing of the application. By simply waiting and not submitting a request for examination, examination can be deferred three years from the filing date in Japan and five years from the filing date in Korea. Second, both the JPO and KIPO allow accelerated examination. In Japan there is no official fee for accelerated examination and in Korea the official fee is about \$170. In both countries, an additional cost of about \$400 in attorney fees can be expected. The filing of an application in another Paris Convention member country is a sufficient reason for acceleration and any prior art known at the time of the request must be submitted. The first office action will typically be issued two to three months after the request for accelerated examination is made.

A step by step guide

Using these tools, prosecution in the US, Japan and Korea can be synchronised as follows. With applications filed in all three jurisdictions, Japanese examination and Korean examination are deferred. In other words, no request for examination is made. Sometime within three years, a US office action is received. According to the USPTO's fiscal year 2009 statistics, the first office action takes 25.8 months on average, so the three year maximum deferral period in Japan should generally

Akihiro Ryuka



In 1987, Akihiro Ryuka received his bachelor of engineering from Tohoku University and his masters of engineering from Tokyo University. He became a Japanese patent attorney (*Benrishi*) in 1993. Akihiro's experience includes working for a firm in the US between 1995 and 1998 and passing the US patent bar examination in 1997. Since 2004, Akihiro has been admitted to stand before all Japanese courts in IP litigation.

Akihiro founded Ryuka IP Law Firm in 1998 and his practice includes patent prosecution specialising in the fields of computer software, data communication, radio communication, semiconductors and electronics, as well as design patents, trade marks, licensing, litigation and opinions. He is an active member of the Japan Patent Attorneys Association (JPAA) and the Japan Intellectual Property Association (JIPA).

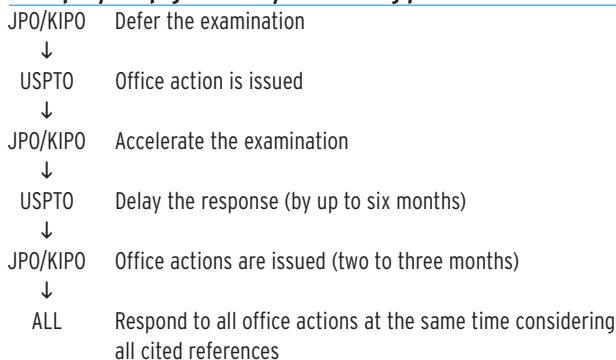
Stephen Hamon



Stephen attended Stanford University as an undergraduate, where he received a bachelor of arts and science with majors in physics and music. After graduating in 2004, he attended UCLA School of Law, where he received a *Juris Doctor* and was admitted to the California Bar in 2007.

In 2008, Stephen joined Ryuka IP Law Firm. He is engaged in the prosecution of US patent applications, including drafting amendments and remarks in response to US office actions. Stephen also drafts infringement and validity opinions and assists in conducting clearance searches.

A step-by-step guide to synchronising prosecution



not be a problem. As quickly as possible upon receiving the US office action, a request for examination along with a request for accelerated examination is made in Japan and Korea. At this point, while it will only take about two to three months for the Japanese and Korean office actions to issue, the deadline for responding to the pending US office action can be extended up to six months. Once the Japanese and Korean office actions issue, prior art found by all three patent offices can be studied when deciding how to respond to each office action. All three responses can be made with the same information and at the same time. Thus, prosecution in three jurisdictions has been synchronised.

Pros and cons

In addition to its primary purpose of providing a more complete picture of the prior art to take into consideration when crafting amendments and arguments, synchronising prosecution has other benefits as well. Most notably, it saves costs. Without synchronising prosecution, there can be months or even years between when a Japanese attorney examines and responds to an office action issued by the JPO and when the same attorney assists an American attorney in responding to an office action issued by the USPTO regarding the same invention. Having studied many other inventions in the meantime, it is not hard to see why the Japanese attorney might forget a thing or two. In practice, the time it takes for an attorney to familiarise himself with an old case can translate into additional costs. The same is true of in-house IP counsel and engineers. By allowing the various people responsible for a family of applications to respond to the office actions within a shorter time frame, valuable hours can be saved and needlessly duplicated work can be avoided.

Another benefit of synchronising prosecution is improved consistency of responses and claims. During litigation, it is far more likely that inconsistencies among a family of patents will hurt rather than help the patentee. A term used differently in two sets of claims or differing arguments made in two responses can be seized upon by an opponent intent on winning a narrow construction of the claims. At worst, such inconsistencies can lead to a finding of no infringement. Short of that, inconsistencies make it difficult to manage prosecution across multiple jurisdictions and increase the chances that damaging mistakes will be made. Therefore, not only does synchronising prosecution make it possible to obtain strong, valid patents in multiple jurisdictions, but it is generally a more cost-effective and safer strategy for managing patent prosecution across the globe.

Perhaps the biggest drawback of synchronising prosecution is that it requires an increased degree of care when it comes to

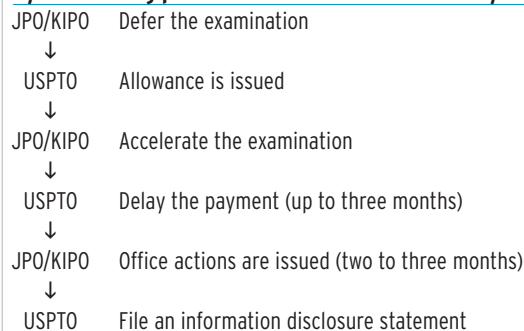
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timing responses and meeting deadlines. For example, in order to maximise the opportunity for responding to the JPO and KIPO office actions before running out of time in the US, requests for examination and accelerated examination must be made in those jurisdictions immediately upon issuance of the US office action. Therefore, a reliable system must be in place and understood by all parties involved. Creating and maintaining such a system can generate new costs, but if it is well run, the benefits of synchronising prosecution outweigh these costs.

Dealing with an early allowance

The strategy discussed above assumes that an office action issues in the US. In some cases, however, the first communication from the USPTO is a notice of allowance. Although the exact same steps of synchronising prosecution cannot be used in this situation, the underlying principles still apply and the following modified procedure can be used.

Synchronising prosecution in the event of early allowance



Having deferred examination in Japan and Korea, this time a notice of allowance is issued in the US. First, just like before, requests for examination and accelerated examination are made in Japan and Korea as quickly as possible. Whereas, before, the deadline for response in the US was extendible up to six months, the due date for payment of the issue fee after receiving a notice of allowance is three months and is not extendible. When the office actions issue from the JPO and KIPO after about two to three months, an information disclosure statement (IDS) is filed in the US, providing the USPTO with the more relevant foreign language references cited in the foreign office actions. If the IDS is filed before payment of the issue fee, the USPTO must consider the new references. If, on the other hand, the foreign office actions issue too late, it is still possible to file an IDS after payment of the issue fee but before the patent issues. In this case, the USPTO will consider the new references if a request for continued examination (RCE) is filed. Using this modified synchronisation strategy can result in a stronger patent even in the case of early allowance.

The problem with first office actions

There is a fundamental problem with the strategies outlined above. The truth is that, in practice, first office actions often do not contain the most relevant references. In many cases, it is the second office action, after rejections have been once addressed or claims have been narrowed once, that contains the more relevant references. This means that even if the responses to the first office actions are synchronised, the more relevant references cited in the second office actions of each jurisdiction will not necessarily be available for consideration at the same time. One possible solution to

this problem is to make use of two more tools available to applicants in Japan and Korea, preliminary amendments and voluntary disclosure.

When the first office action issues in the US, rather than simply requesting an accelerated examination in Japan and Korea, the prior art cited in the US can be studied and a preliminary amendment narrowing the claims as necessary can be filed in Japan and Korea. In addition, the prior art cited in the US can be submitted voluntarily in those jurisdictions.

If preliminary amendments and voluntary disclosure are used, the claims will already be narrowed in consideration of the English references and the JPO and KIPO will have more references to consider. Therefore, the first office actions issued in Japan and Korea will cite more relevant references. As a result, there will be more valuable information available to the applicant when it comes time to respond to the USPTO, JPO and KIPO office actions and a stronger patent can be obtained.

Although making voluntary disclosures to the JPO and KIPO is fairly simple and not time-consuming, filing preliminary amendments can be more difficult. There is a trade-off between, on the one hand, spending enough time studying the references cited in the US office action to carefully craft preliminary amendments, and, on the other hand, requesting an accelerated examination in Japan and Korea as early as possible after the US office action issues. The importance of drafting preliminary amendments with care is particularly apparent when one considers the dangers of file wrapper estoppel. Not only can hastily filed amendments make the claims unnecessarily narrow, but they also have the potential to preclude application of the doctrine of equivalents.

In view of this, an applicant using the above strategy would be wise to err on the side of caution. For example, if a preliminary amendment must be filed quickly, a rule of always choosing the amendment option that preserves the broadest claims (the option that is least likely to succeed) can be followed. After all, there are no rejections to overcome at this stage and the only goal is to generate office actions that cite more relevant prior art. If appropriate care is taken, the use of

preliminary amendments and voluntary disclosure in Japan and Korea can help to overcome the problem that first office actions typically do not cite the most relevant references. The benefits of synchronised prosecution can therefore be enhanced.

Increasing opportunities

In this article, we have presented a strategy for obtaining strong, valid patents in multiple jurisdictions. The only jurisdictions discussed in detail were the US, Japan and Korea,

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primarily because Japan and Korea have very simple and effective systems of accelerated examination. It is important to note, however, that the principles described above are not limited to application in these countries and that synchronising prosecution is adaptable to other jurisdictions as well. Right now, many jurisdictions, including, for example, the UK, Germany, and Europe, have Patent Prosecution Highway (PPH) pilot programmes. In the future, as these initiatives develop, there will be more opportunities throughout the world for accelerated examination. This means that there will probably be more opportunities for synchronising prosecution. Therefore, understanding the principles and advantages of synchronising prosecution and incorporating these ideas into your global prosecution strategy is a valuable investment for the future.

RYUKA IP LAW FIRM

ADDRESS:

6-22-1 Nishi-shinjuku, Shinjuku Square Tower 5F,
Shinjuku-ku, Tokyo, 163-1105, JAPAN

TEL: +81-3-5339-6800

FAX: +81-3-5339-7790

TEAM: Ryuka currently has 62 employees, including 14 attorneys.

Specialty:

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“Proactive Communication”

Despite the world recession, RYUKA represented a record number of patent applications in 2009. 264 patent applications in total were transferred to us from various major law firms during the course of the year. The reason for this is our commitment to proactive communication. Proactive communication leads us to a deeper understanding of our clients, our own proposals, and our creative processes.

In 2009, Akihiro Ryuka was invited by the Korean Intellectual Property Office (KIPO), and the Shenzhen Local Patent Office of China to speak about his patent strategy of “How to build a patent portfolio of future products.” Concurrently with AIPLA, he also made a presentation on “How to obtain valid patents by adjusting timings of office actions among different countries,” in Washington DC.

RYUKA will strive to learn more for further contribution to our valued clients and society.

