

# Appeal Procedure is Advantageous at the Japan Patent Office



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# Appeal fee is less than the fee for a divisional application

## Appeal

Office fee US\$ 450 + 50 x claims<sup>\*1</sup>

No office fee for interview or oral hearing

Service fee US\$1,550 to 2,550

Total **US\$2,000 to 3,000 + 50 x claims**

## Divisional and its examination

Office fee US\$1,300 + 36 x claims<sup>\*2</sup>

Service fee US\$1,500 to 2,000

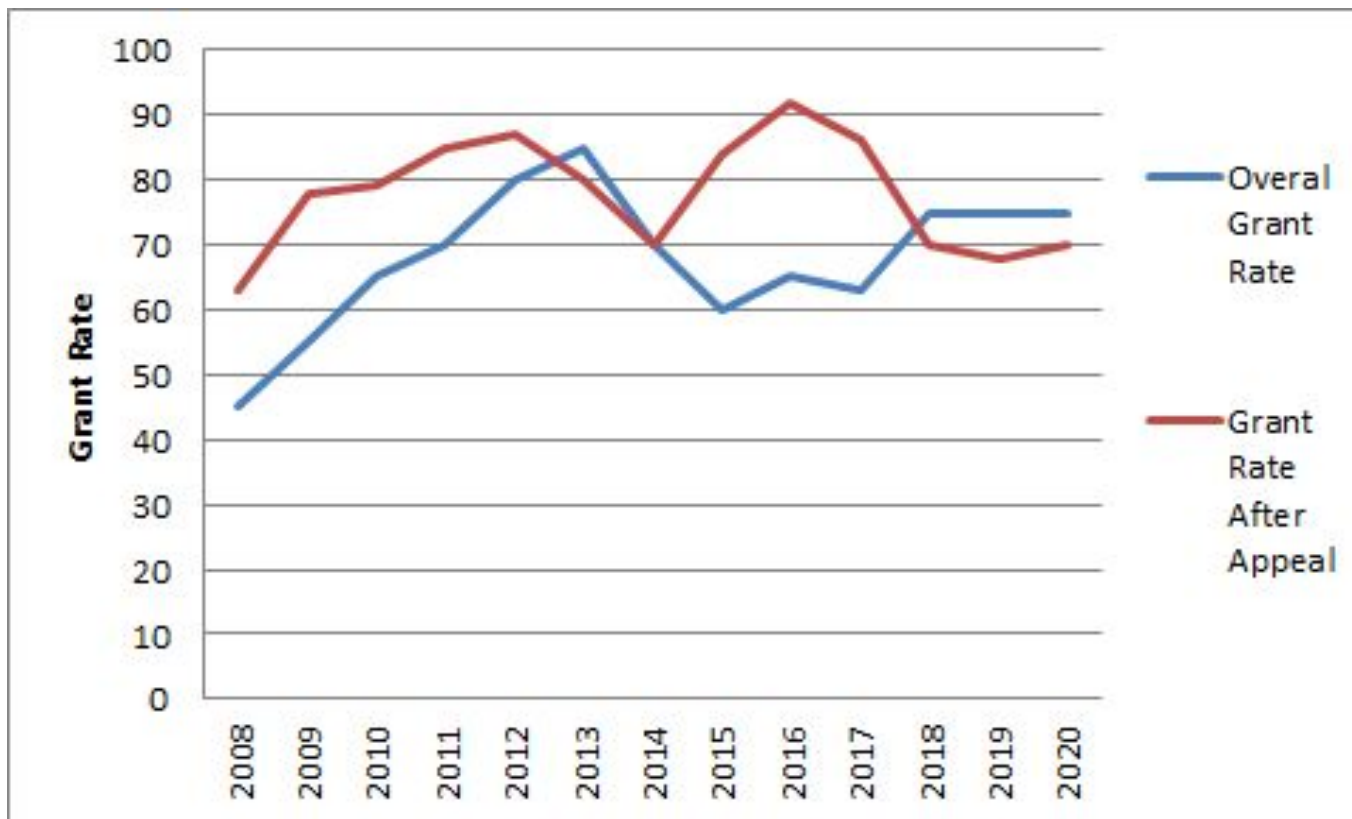
Total **US\$2,800 to 4,300 + 36 x claims**

\*1 JPY 49,500 + 5,500 x claims

\*2 JPY 140,000 + 4,000 x claims  
(If 1US\$ = JPY110)

# 70 percent of the appealed cases are allowed at the JPO

(%)



# You can amend claims when and after appealing the decision

Step 1: Case appealed to Board with amendment

Step 2: Original examiner re-examines the application

Step 3: If amended claims are not allowable,  
examiner typically accepts an **interview** where  
we can propose a further **amendment**

Step 4: If proposed amendment is accepted,  
a supplemental Office action is issued so that  
amendment is formally entered and the case is allowed

# Board examiners are less strict in entering amendments

If the original examiner maintains the rejection, the case is transferred to the Board.

- Interview opportunity to propose an amendment
- Examiners have much discretion to enter amendments, and try to settle the case for avoiding the appeal to the court.
- Board examiners are willing to enter amendment, especially at the interview.
- Even when they do not agree with the proposed amendment,
  - they often suggest allowable alternatives.

# Inventive step standard is lower at the Board of Appeals

- In the last five years, the IP High Court reversed many Board decisions.
  - Inventive step standard has been lowered
- Still, some first-level examiners don't apply recent court decisions and maintain higher inventive step standard.
- Therefore, the inventive step standard is generally lower at the Board than in the first-level examination.
  - Wider protection