

Accelerated Exam. cf. PPH in Japan



Aki Ryuka

Patent Attorney, Japan

Attorney at Law, California, USA

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Two options for expediting the examination:

A. Accelerated Examination

B. Patent Prosecution Highway (PPH)

Under either procedure, the first office action (OA) is typically issued in three to four months

Either way;

- **No office fee**
- OAs must be responded within three months to keep expediting the examination.
- The subsequent OA, if any, is also typically issued in three to four months

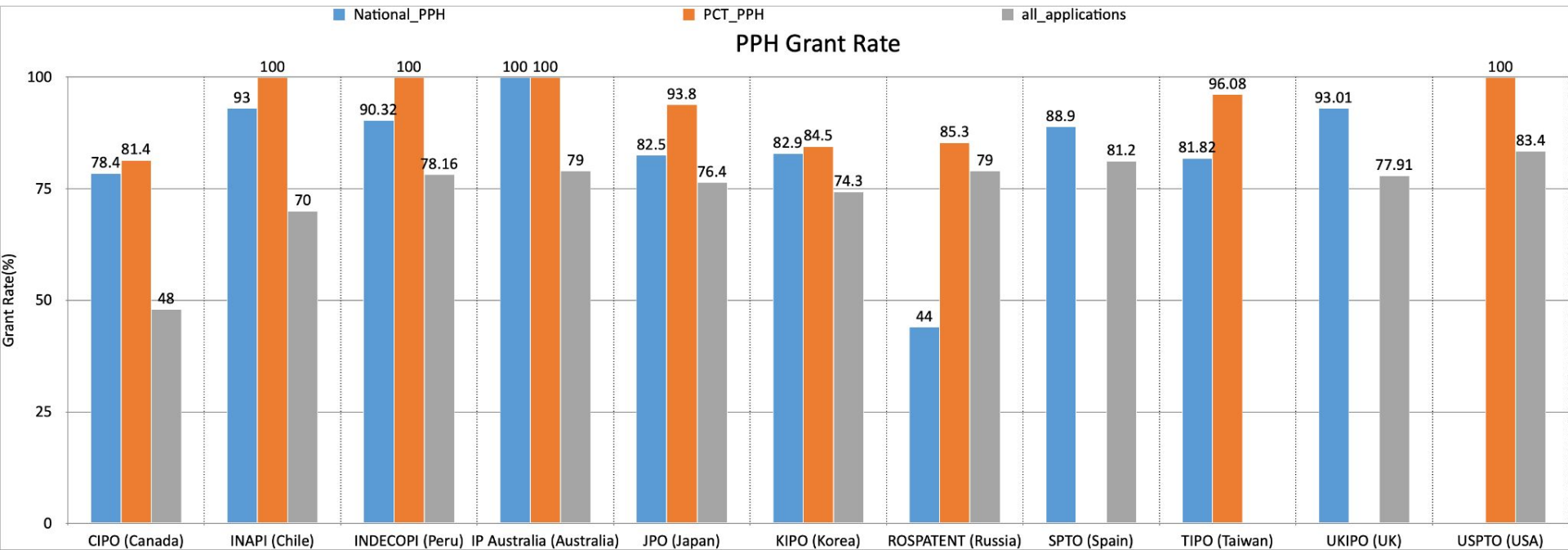
Patent Prosecution Highway (PPH) requires that:

1. A positive search report, examination result, or an allowance be issued for a counterpart patent application in a contracting country, and
2. Japanese claims be amended substantially the same as the claims which received the positive report, result or allowance.

PPH also requires:

- a. Copies of all Office Actions (OAs) issued by the patent office that made the positive report/results or allowance and translation of the OAs into Japanese or English;
- b. Allowed claims of the counterpart application and their translation into Japanese or English; and
- c. Copies of references cited in the OAs.

However, PPH does not largely increase the grant rate in Japan



Jan. 2022 to Dec. 2022

Data Source:

<https://www.jpo.go.jp/toppage/pph-portal-j/statistics.html>

The JPO does not treat PPH applications more favorably

The grant rate would have been 6.1% higher even without PPH, if the invention is allowed in a foreign country and the Japanese claims are amended before the examination.



PPH merely serves to accelerate examination in Japan.
Different from PPH practices in many other countries

We suggest “Accelerated Examination” over PPH, even if an allowance is already made in a foreign country.

Why?

Claims can be amended more liberally

- Program per-se claims can be added.
- Product-by-process claims should be modified to method claims or structural product claims.
- Dependencies should be added, because multiple layers of multiple dependencies are accepted with no office fee.
- Unique clearness requirements in Japan can also be addressed.

“Accelerated Examination” speeds the examination with less documents:

Prior art references

The applicant has no duty to disclose all known prior art. Showing two references is sufficient.

Accelerated examination requires concise explanation of the differences between claimed invention and prior art

This can be easily made in several sentences.

The concise explanation does not create prosecution history estoppel

- We copy independent claims and say that these combined features are not described in any reference.
- This is practically enough.

Our service fee is less for Accelerated Exam. than for PPH

Accelerated Exam. JPY 40,000

PPH JPY 69,000 to 120,000
depending on amendment

Because the acceleration is inexpensive, it can be used for requesting PPH in other countries.

Thank you

about us:

Celebrated 20th year in 2018.
39 attorneys, 120 in total

They say:

Rising Star in Japan IP, ILASA
Top 5 Japan Patent Firm, Asia IP
Top 10 Japan Trademark Firm, Asia IP
Top 20 Japan Patent Firm, MIP
Top 20 Japan Trademark Firm, MIP

We commit to proactive communication, which leads to deeper understanding of our clients and creative processes.

