

Adjusting the Order of Multi-National Prosecutions for Obtaining Valid US Patents

유효한 미국특허를 획득하기 위한 패밀리 출원 권리화절차의 진행 방법



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February 8, 2017

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Recently, most of the US patents are found invalid by Inter Partes Review

최근, 상당수의 US 특허가 당사자계 리뷰 절차에 의해 무효로 판정되고 있음

What is the problem?

무엇이 문제인가?

**Problem: Examiners search
prior art mainly in one language**
**문제: 심사관은 단지 하나의 언어로
선행기술을 조사함**

USPTO cannot find **Japanese / Korean** prior art well.
USPTO는 일본/한국 선행기술을 발견할 수 없음.

JPO cannot find **Korean / Chinese** prior art well.
JPO은 한국/중국 선행기술을 발견할 수 없음.

After a patent is issued, **new prior art** is often found
in a country having **different languages**.

특허가 등록된 후, **새로운 선행기술**이 종종 다른 언어를 사용하는
외국의 특허청에 의해 발견됨.

Later examined patents tend to be valid more (ex. JP v. US)

나중에 심사된 특허가 유효성이 더 높은 경향

Examined in Japan (JP) first **일본 (JP) 먼저 심사**

→ References in JP are discovered **일본에서 인용문헌이 발견됨**

→ US claims are amended, considering references in JP

일본 인용문헌을 참조하여 US 청구항이 보정됨

→ **Valid US patent 유효인 US 특허**

→ Later references in the US were not considered in JP

일본에서는 US 영어 문헌이 고려되지 않았음

→ **Invalid JP patent 무효인 JP 특허**

Same in vice versa, if examined in the US first.

미국 (US) 심사 먼저 시, 마찬가지로 결과

Order of the Examination is Important **심사의 순서가 중요함**

Ex. To obtain valid US patent:

예. 유효한 US 특허 획득하기

JP, KR, TW or EP

Accelerating the examination



심사를 촉진

Foreign or PCT

Drafting claims considering
the first examination result

Filing



첫번째 심사결과를 고려하여 클레임 작성

Other Countries

Acceleration or early PCT entries



신속한 개별국 진입

US

Preliminary amendment or a response to OA,
considering references cited in other countries

타국에서 인용된 선행문헌을 고려하여 자진 보정 또는 OA대응

-- or ---

Leave a US continuation until foreign applications are examined.

타국 출원이 심사될때까지 US 계속출원을 유지

Accelerations are easy and effective in JP, KR, EP, TW even without PPH

PPH가 아니더라도 JP, KR, EP, TW에서 심사촉진은
용이하고 효과적임

	Typical Attny Fees 통상의 대리인 수수료 (US\$)	Office Fees 관납료 (US\$)	Typical Periods to the First OA 1차 OA까지의 통상의 기간
JP	400 if prior art is available	0	2 months
KR	300	200 + 660 for foreign applicants for search	3 months + 1 m for foreign applicants for search
EP	200 (PACE) (10-15% applications)	0	3 months
TW	200	0 with any exam result	6 months
Cf. US	200 (Track 1)	4,000	2 to 3 months

On the other hand: To obtain valid patent in JP, TW, KR or DE

JP, TW, KR, 또는 DE에서 유효한 특허 획득하기

JP, TW, KR or DE

Defer the request for examination



심사청구를 연기

Other countries

Examined



심사

JP, TW, KR

Preliminary amending claims or responding to OA, considering the references cited in other countries

CA, DE or AU

다른 국가에서 인용된 선행문헌을 고려하여, 청구항을 자진 보정 또는 OA 대응

Request for examination

can be deferred:

심사청구는 연기될 수 있음:

	Up to (Years) 언제까지	From 언제부터
CN	3	Priority date
JP, TW	3	Local or PCT filing date
KR	5 (3 from 3/2017)	
DE	7	

We have covered:

- Order of the exams. is important, and
- It is adjustable.

지금까지 살펴본 사항:

- 심사의 순서는 중요함, 그리고
- 그것은 조정 가능함.

Then, how to decide the order?

그렇다면, 그 순서를 어떻게 결정할 것인가?

How to decide the order of the examination? 심사의 순서를 어떻게 결정할 것인가?

ex. Valid JP Patent (JP exam. at the end) or
Valid US Patent (US exam. at the end)?

ex. 유효한 JP 특허 (마지막으로 JP 심사) or
유효한 US 특허 (마지막으로 US 심사)?

We need to consider 고려 사항:

- flexibilities for **amending issued patents**
등록 특허의 보정에 대한 유연성
- **importance** of the validity in each country
각 국에서의 특허의 유효성의 **중요성**
- importance of **pendency** **처리기간의 중요성**
- whether leaving a **continuation/divisional**
계속출원/분할출원의 유지 여부

Patented claims can be relatively easily limited in JP (& TW and KR)

일본 (및 대만, 한국)에서 특허된 청구항은 상대적으로 용이하게 한정보정 가능함

	Procedure at the PTO 특허청에서의 절차	Limitations From the Specification 명세서로부터의 한정보정	Period 기간	Attorney & Office Fees (US\$) 대리인비용 및 관납료	Damages go back to 손해배상의 소급 :
JP	Correction Trial	○ 98% in 2013	○ 3 mos.	○ 1K to 3K (office: 1.4K*)	○ Original Issue Date
TW		△ 70-90% agent's experiences	△ 4 to 8 mos.	○ 1K to 2K (office: 0.1K)	
KR		△ often denied ∴ new objects	△ 6 to 12 mos.	○ 1K to 2K (office: 0.5K)	
CN	In nullity action	× Difficult			
EP	Central Limitation	× Difficult as in the exam.	△ 4 to 6 mos.	○ 1K to 2K (office: ??)	
US	Ex Parte Re-Exam.	○ Same as examination	× >2 years	× 20K to 80K (office: 12K*)	

Having **JP** (or TW, KR) application examined **first**

JP (or TW, KR) 출원을 **처음에** 심사

Possibly invalid, but
broad JP (TW, KR) patent
무효 가능성 높지만,
넓은 범위의 JP (TW, KR) 특허

Valid patents in
other countries
다른 국가들에서 유효한
특허

Wider base for limitation
한정보정 가능한 범위가 넓음

Limit JP (TW, KR) patents after
knowing infringing products
침해품을 인정한 후 JP (TW, KR) 특허를 한정보정

AIA has changed the importance of U.S. patent validities

AIA는 US특허 유효성의 중요성을 변화시켰음

	Pre AIA	Under AIA
Invalidation	Re-examination: Long	IPR: Quick
Courts	Not wait for re-examination results	Wait for IPR results
Standard for invalidity	Courts: Higher	IPR: Lower
Patent validities	Assumed valid and infringement was affirmed	Entirely invalidated in 70 % of initiated cases
Valuable patents	Broad patent	Valid patent
Later found citations	Less important	Crucial
US examinations should be	Prior to other examinations	After other examinations

Having **US** (continuation) application

examined at the **end**

US (계속) 출원을 **마지막에** 심사시키기

JP, TW or KR

Accelerate the examination w/o PPH

PPH 없이 심사 촉진

- Broad patent for future limitation

추후 한정정보정 위한 넓은 특허

- Allowance enables PPH 등록되면 PPH 가능해짐

PCT

Drafting claims considering the exam. result

심사결과를 고려하여 청구항을 작성

Other
countries

Accelerations (by PPH) or **Early PCT entries**

(PPH로) 심사촉진 또는 신속한 PCT 진입

- References are discovered 선행문헌이 발견됨

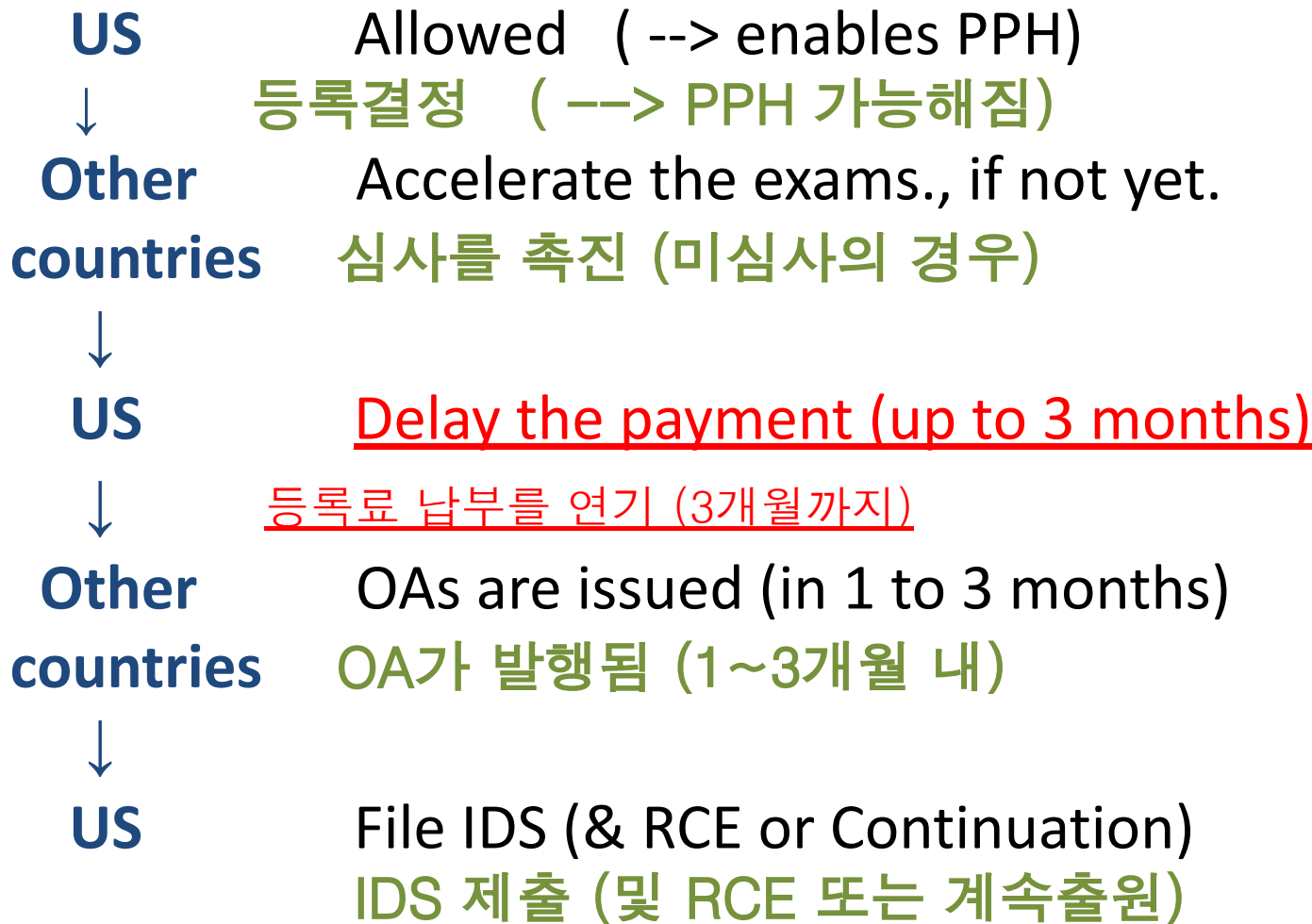
US
(continuation)

Examined at the end **마지막으로** 심사

- Valid USP **유효한 미국 특허**

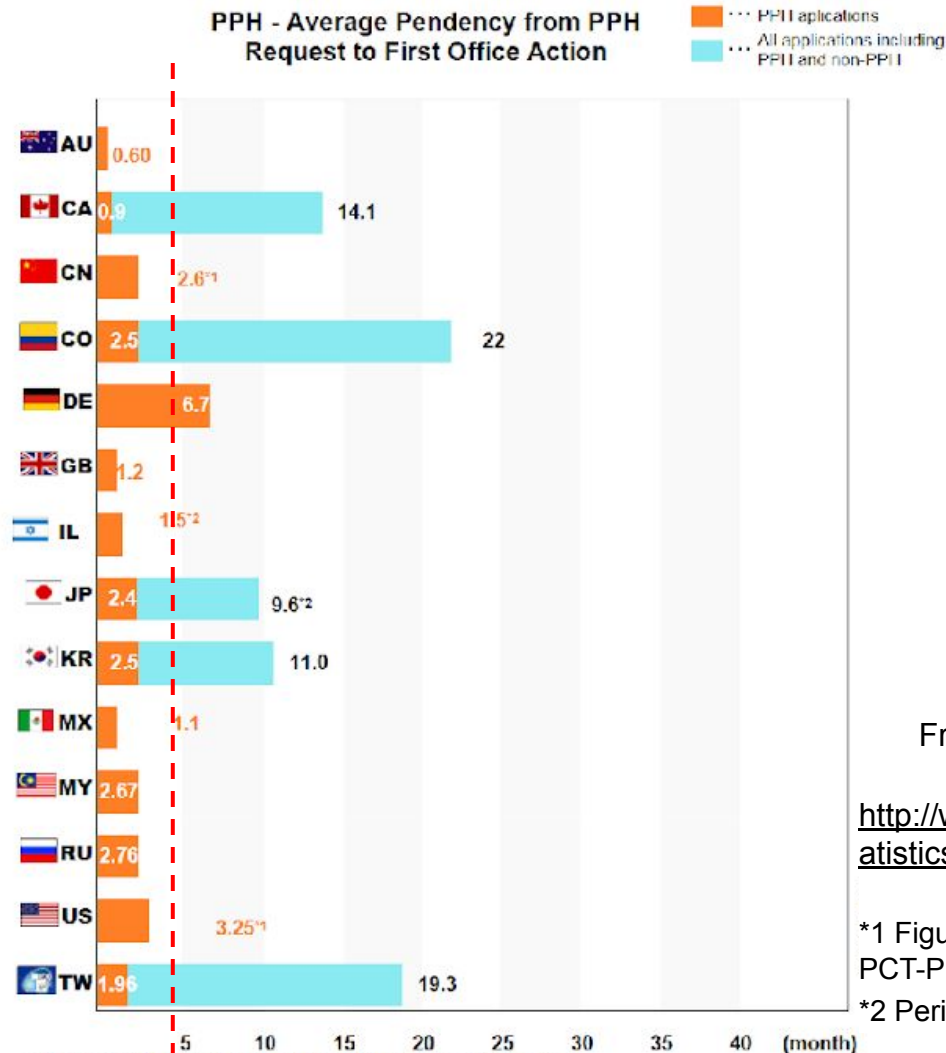
If US application is allowed earlier?

만약 US 출원이 먼저 등록되면?



If allowed in the US, prosecutions in more countries can be accelerated by PPH

미국에서 등록결정되면, PPH에 의해 더 많은 국가에서 심사절차가 촉진 가능



From Jan. 2015 to Jun 2015

<http://www.jpo.go.jp/ppph-portal/statistics.htm>

*1 Figures: Including the number of PCT-PPH

*2 Period: Jan.-Dec. 2014

When filing via PCT, how shall we
adjust the order of the examination?

PCT 출원의 경우, 어떻게 할 수
있는가?

Major countries except EP complete exams. before the US first OA, if earlier entered

신속히 진입한다면, EP를 제외한 주요국은 미국 첫번째 OA 전에 심사를 완료

		Average Months 평균 개월수			
	Req. for Exam. to Allowance 심사청구부터 등록결정까지	Adjustment for receiving allowance prior to US 1 st OA. 미국 첫번째 OA에 앞서 등록결정을 받기 위한 조정기간	Source 출처		
JP	20	- 8 m. early entry = 12	https://www.ipoj.go.jp/english/reference_room/statusreport/pdf/status2015/all.pdf		2015
KR	19	- 7 m. early entry = 12	http://www.fiveipoffices.org/statistics/statisticsreports/2013edition/chapter4.pdf (Table 4.2)		2013
CN	22	- 10 m. early entry = 12			
EP	44	Utilizing Int'l Search	Same above + Rule 161/162 period (7-8 months)		
TW	30	-18 m. early (Paris rt.) = 12	https://www.tipo.gov.tw/ct.asp?xItem=547188&ctNode=6687&mp=2		2014
DE	33	- 21 m. early entry = 12	No official statistics have been found. Practical experiences of two German Attorneys		2013
US	18 to 1 st OA	25 to allowance w/o RCE	http://www.uspto.gov/dashboards/patents/main.dashxml		2015

(Supplemental) International Search is substantially free at EPO, if entering EP

EP 진입의 경우, EPO에서의 (보조) 국제조사는 실질적으로 무료

Int'l Search Authority 국제 조사 기관 (ISA)	Offices Receiving in English 영어로 수리하는 관청	PCT Search Fee in English 영어의 경우 조사비용 (A)	Reduction in National Phase compared with via other four ISAs 다른 4개의 ISA 대비 국내 단계에서의 감액 (B)	Reduction of annuity + agent fee 연차료 + 대리인 비용의 감액 (C)	PCT Search Substantial Fee if entering the ISA country ISA 국가 진입시 PCT 조사 실제 비용 (A - B - C)
EP	EP, US, JP	2,100	1,000 in EP	1,100	0
Supplemental Int'l (EP)	Any of left				
JP	JP, US	600	400 in JP	0	200
KR	KR, US	1,100	200 in KR	0	900
cf. US	US	2,100	400 in US	0	1,700

Rounded at US\$100

Assuming: 15 claims (3 ind.), Large Entity

As of April 1, 2015 when: 1US\$=JPY120, KWN1100, EU0.93, CNY6.2, CHF 1 = EUR 0.956

(US\$)

Utilizing EPO International Search and early entries for valid US patents

유효한 US특허를 위해 EPO 국제조사 및 신속한 진입 이용

JP, TW or KR

Accelerate the examination w/o PPH

PPH 없이 심사 촉진

- Broad patent for future limitation

- 추후 한정보정 위한 넓은 특허

- Allowance enables PPH 등록되면 PPH 가능해짐

PCT

Drafting claims considering the exam. Result

심사결과를 고려하여 청구항을 작성

Int'l Search in EP EP에서 국제조사

Other Countries

Early entries with preliminary amendments

자진보정과 함께 신속한 진입

- References are discovered 선행문헌이 발견됨

Enter at 30 months due: Examined at the end

30개월 경과 후 진입: 마지막으로 심사

- Valid USP 유효한 US특허

US

Is it impossible at all to obtain
valid patents in multiple countries?
여러 국가에서 유효한 특허를 획득하는
것은 불가능한 것인가?

For valid US, JP, and KR patents

⇒ Synchronize Prosecution

유효한 US, JP, 및 KR 특허를 위해 ⇒ 출원절차 동기화

JP, KR

Defer the examination

↓

심사를 연기

US

OA is issued

↓

OA가 발행

JP, KR

Accelerate the examinations

↓

심사를 촉진

US

Delay the response (up to 6 months)

↓

응답을 연기 (6개월까지)

JP, KR

OAs are issued (in 2 to 3 months)

↓

OA가 발행 (2 내지 3개월 내)

All PTOs

Respond to all OAs considering all references

모든 선행문헌을 고려하여 모든 OA에 대응

Effects of the Synchronized Prosecution

동기화된 권리화절차의 효과

- Strong patents that are difficult to invalidate
강한 특허는 무효되기 어려움
- Time and money are saved, because multiple responses are made by a single analysis
여러개의 응답이 하나의 분석에 의해 수행되므로, 시간과 비용이 절약됨
- Improved consistencies of responses and claims
응답 및 청구항의 일관성이 향상됨

Closer prior art references might be found in later OAs

강력한 선행문헌이 늦게 발행되는 OA에서
발견될 수 있음

Synchronized Prosecution 동기화된 출원절차



Patent is issued in country A 국가 A에서 특허가 등록



More relevant citation is found in country B
국가 B에서 보다 강한 인용문헌이 발견



Patent in A can be still invalid
A에서의 특허는 무효일 수 있음

Filing a preliminary amendment for improving the quality of the first OA

1차 OA의 품질을 향상시키기 위한 자진 보정서 제출

US OA is issued **OA가 발행**



JP, KR Accelerate the examination with the least preliminary amendment 최소한의 자진 보정으로 심사 촉진



US Delay the response (up to 6 months)



응답을 지연 (6 개월까지)

JP, KR OAs with more relevant references



보다 관련된 인용문헌으로 OA

All Respond to all office actions considering all references

모든 인용문헌을 고려하여 모든 OA에 대응

What about the “patent minor countries”*
that find much fewer “new” prior art
references?

*Those other than JP, DE and some others
depending on technological fields

Prosecution strategies prior to Global Dossier

글로벌 도시에 이전의 권리화 전략

Patent Offices	Influential search/examination results
Thailand, Malaysia, Vietnam, Indonesia	Japan, Singapore (when using ASPEC)
India	Japan, EPO, those as ISA *1 or IPEA *2 *1 International Search Authority *2 International Preliminary Examination Authority
Canada, Mexico, Australia, Philippine	US
Brazil	EPO, EPO as ISA or IPEA

If: the application is allowed by the right side authority,
claims are amended in left as allowed in right, and
that fact is explained to the left, then

출원이 우측 기관에 의해 등록결정되고,
이 등록된 청구항대로 좌측 특허청에서 청구항이 보정되고,
또한 이 사실이 좌측에 설명된 경우,

⇒ **The number of office actions were significantly reduced in left**

좌측 특허청에서 OA의 발행횟수는 현저하게 감소되었음

Global Dossier is changing the examination trend in those countries

글로벌 도씨에가 전략을 변화시킴

Global dossier: Prosecution histories and citations in IP5 (KR, US, CN, EP, JP) can be viewed at a single Website in English

글로벌 도씨에: IP5(JP, US, CN, EP, KR)에서의 출원경과 및 선행문헌이 하나의 웹사이트에서 영어로 열람 가능

Global Dossier changed our prosecution

글로벌 도사에가 전략을 변화시킴

Exemplary Effects 예시적인 효과

① Malaysian claims were amended as allowed in Japan.

It was explained to the Malaysian Patent Office.

말레이시아 청구항이 일본 등록결정된 청구항으로 보정되고 특허청에 설명



② USPTO found new reference and claims were more limited.

미국특허청이 새로운 선행문헌을 찾고 청구항이 한정보정.



③ Malaysian Patent Office rejected claims using the US citation.

말레이시아 특허청이 미국 선행문헌을 근거로 청구항을 거절.

We need a new solution. 새로운 전략이 필요

Strategies for Global Dossier

Examiners around the world will review Global Dossier.
전세계 심사관이 글로벌 도씨에를 볼 것임.

→ More, same office actions

→ More, same responses (**waste of money**)

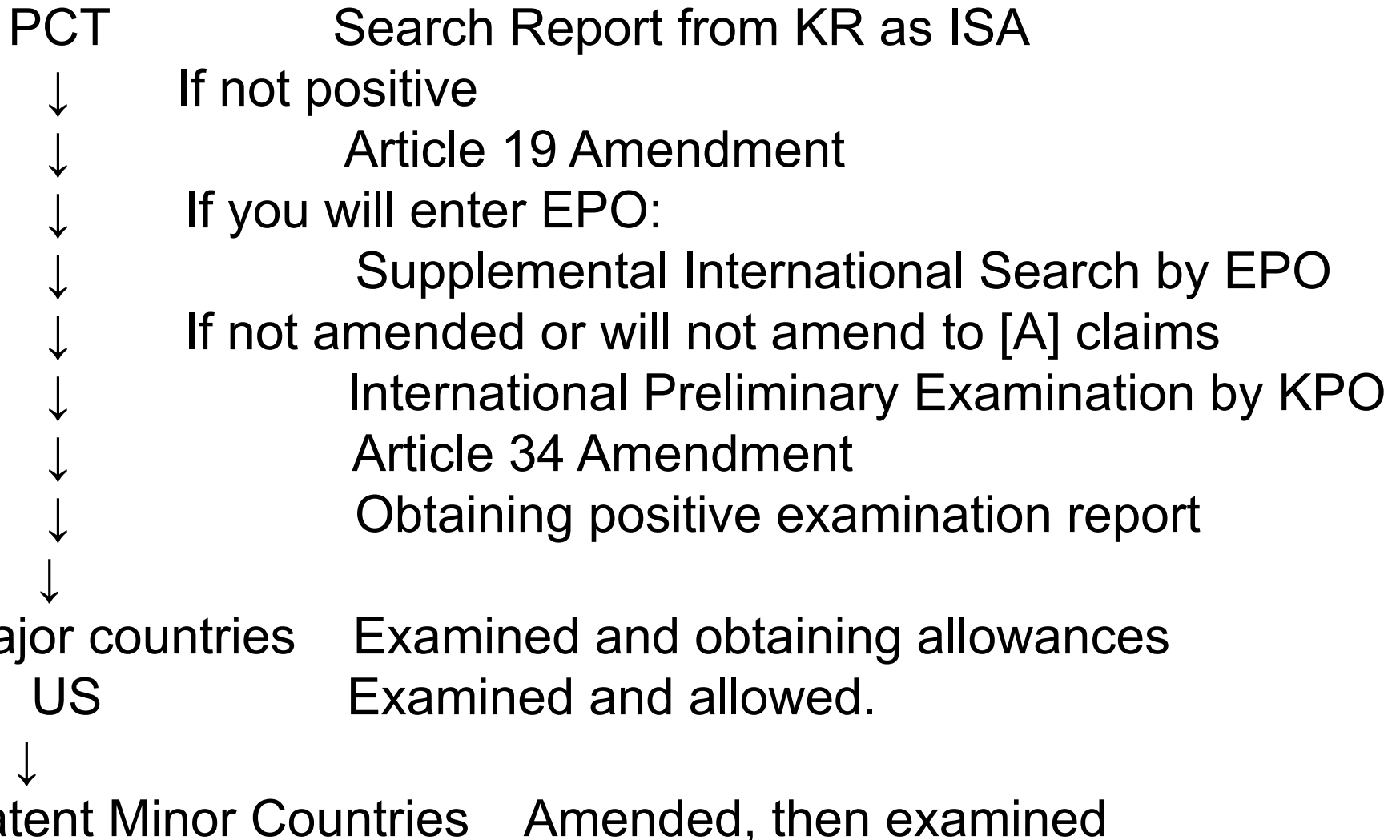
For saving fees:

Completing IP5 examinations by utilizing PCT stage



Examining in patent minor counties:

Utilizing PCT stage for saving fees (1): If KR is not must and disclosure is sufficient



Utilizing PCT stage for saving fees (2): If KR is must or disclosure may be insufficient

KR

Accelerated Examination



Obtaining allowance



Deciding whether to file in foreign countries



PCT

Claims and specification are improved, then filed

- Same as previous slide -



(Can be filed in JP or US in English for obtaining



ISR from JP or US, if having JP/US branch)



Major countries

Examined and obtaining allowances

US

Examined and allowed.



Patent Minor Countries

Amended, then examined

Conclusion

결론

CONCLUSION

For obtaining broad JP and valid US patents:

넓은 JP 특허 및 유효한 US 특허를 획득하기 위해:

First, accelerate the JP examination

Second, accelerate non US/JP examinations

Have the US (continuation) examined later

첫째, JP 심사를 촉진시킬 것

둘째, US/JP 이외 국가의 심사를 촉진시킬 것

US (계속출원)을 나중에 심사되도록 할 것

For obtaining valid US and JP patents.

유효한 US 및 JP 특허를 획득하기 위해:

Synchronize prosecutions, by utilizing:

Deferral of the examination in Japan

Acceleration of the examination in Japan/PPH

출원절차를 동기화할 것, 이때 다음을 이용:

일본에서의 심사를 연기

일본에서의 심사를 촉진 / PPH

Your comments are welcome at info@ryuka.com. Thank you.

www.ryuka.com

Office Fee Calculation 관납료 계산

(Local Currencies)

ISA	PCT Search Fees in English 영어로 PCT 조사 비용 (A)	National Search & Exam Fees via Same PTO as ISA ISA 관청을 통한 국내 조사 및 심사 비용 (NS)	National Search & Exam Fees via other four ISA 다른 4개의 ISA를 통한 국내 조사 및 심사 비용 (NO)	Reduction in National Phase 국내 단계 감액 (B = NO - NS)	PCT Search Substantial Fee, if entering the ISA country ISA 국가 진입시, PCT 조사 실제 비용 (A - B(- C))
JP	70K in 2015 140K(?) in 2016	107K (71,000 + 2,400/claim)	160K (106,000 + 3,600/claim)	53K in JP 9,677 in CN	87K(?) in 2016
EP	EUR 1,875	EUR 1,805 (0 search + 1805 exam)	EUR 2,715 ((1,285 - 190) search + 1620 exam)	910 in EP 68 in KR 75 in CN	EUR 5 -168, if entering EP, KR, and CN
EP-SISA	CHF 1958 (EUR 1815)			910 in EP	EUR -55
cf. US	2,080	840 (120 search + 720 exam)	1,200 (480 search + 720 exam)	360 in US	1,720
cf. KR	1,300K	562K (143K + 4K/claim) x 0.7	803K (*0.9 via EP-ISA) (143K + 44K/claim)	241K in KR	1,059K
cf. CN	2,100	2,500	2,500 (x 0.8 via EP,JP-ISA)	0	2,100

As of April-August, 2015,
Assuming:
15 claims (3 ind.), Large Entity

Sources: www.wipo.int/export/sites/www/pct/en/fees.pdf, pg. 4-5
pct/guide/en/gdvol2/annexes/ep.pdf pg.4-5
pct/guide/en/gdvol2/annexes/kr.pdf pg.3-4
pct/guide/en/gdvol2/annexes/jp.pdf pg.3 & AnnexJP.1,pg.1
pct/guide/en/gdvol2/annexes/us.pdf pg.4-5
pct/guide/en/gdvol2/annexes/cn.pdf pg.4

	Average Period for disposition 처분까지의 평균 소요기간	Additional Period in PCT Stage PCT 단계에서의 추가 소요기간	Total Period 총 소요기간	5th Annuity 5년차 연차료	Typical Agent Fee for Annuity 연차료에 대한 평균 대리인 비용	Total for 5 th Year 5년차의 총 비용 (C)
EP	3 years	1.5 years	4.5 years (5th Year)	810	150	960

Assuming 30 month entry waiving Rule 161/162 EPC Source: <http://www.epo.org/law-practice/legal-texts/html/epc/2013/e/article2.html#2>

Office Fee Calculation

Patent Offices	Language	Transmittal Fee (A)	International Search Fee (B)	Preliminary Examination Fee (C)
KR	Korean	KRW 45,000	USD 386	KRW 677,000
	English		USD 1,114	
KR (Filing) / JP (Search)	Japanese	JPY 10,000	USD 616	JPY 46,900
JP	English		USD 1,372	JPY 78,900

from 1.3.17

Same in International Filing Fee USD 1367

Assuming 1USD = JPY110 = KRW1150

Source: <http://www.wipo.int/export/sites/www/pct/en/fees.pdf>

about RYUKA

We have only 19 year history with about 100 people,
but 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 us to a deeper understanding of our clients and creative processes.

We will strive to lean more for the future contribution to our valued clients and society.