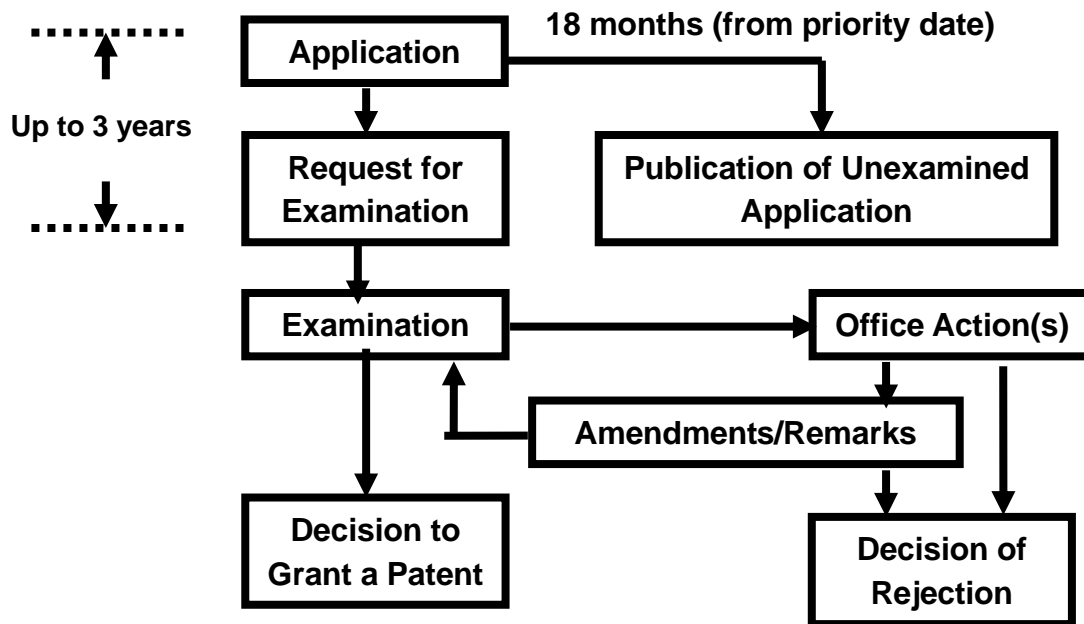


Japanese Patent Prosecution

We will be introducing various aspects of Japanese patent practice in the next few issues of Shiga IP News. In this article, we feature Japanese patent prosecution procedures from the filing of a patent application through prosecution at the Japanese Patent Office (JPO).

Fig. 1 Overview from Filing an Application through Prosecution



1 Patent Application

1-1 Direct Application

Due Date: An application claiming priority under the Paris Convention must be filed within one year from the priority date. The claims, specification, etc., must be written either in Japanese or in English. The JPO does not accept any direct applications written in foreign languages other than English. If an application is filed in English, a Japanese translation of the claims, specification, and drawings must be submitted within fourteen months from the priority date.

Correction of Mistranslation: For a patent application written in English, mistranslations in the Japanese specification, etc. can be corrected based on the English specification.

Application Filing Date: The application filing date in Japan will be the filing date at the JPO.

1-2 Application Based on a PCT Application

Due Date: A PCT application can be entered into the National Phase in Japan within thirty months after the priority date. A Japanese translation must be submitted within two months after the date of entering the National Phase in Japan.

Correction of Mistranslation: Mistranslations in the Japanese specification can be corrected based on the PCT application.

Filing Date: The application filing date in Japan will be the international filing date.

1-3 Claims

Multiply-dependent claims, and multiply-dependent claims which are themselves dependent on multiply-dependent claims, are allowed. Several categories of invention, for example, product, method, and method of producing a product, can be included in the set of claims in a single application, as long as the set of claims satisfies the requirement of unity of invention.

2 Request for Substantive Examination

Period for Filing a Request for Examination: Within three years from the application filing date.

3 Publication of Unexamined Patent Application

In the case of a direct application claiming priority, the unexamined Japanese patent application will be published one year and six months from the priority date. In the case of an application based on a PCT application, the Japanese translation will be published by the JPO sometime after one year and six months have passed from the priority date.

4 Voluntary Amendments

Voluntary Amendments may be filed at any time before the first Office Action (Notice of Reasons for Rejection) is issued. Addition of new matter by Voluntary Amendments is not allowed.

5 Office Action (Notice of Reasons for Rejection) and Response to Office Action

If the claimed inventions do not satisfy the patentability requirements, the Examiner will issue an Office Action (OA). The JPO does not issue any search reports; the search results are shown in the OAs.

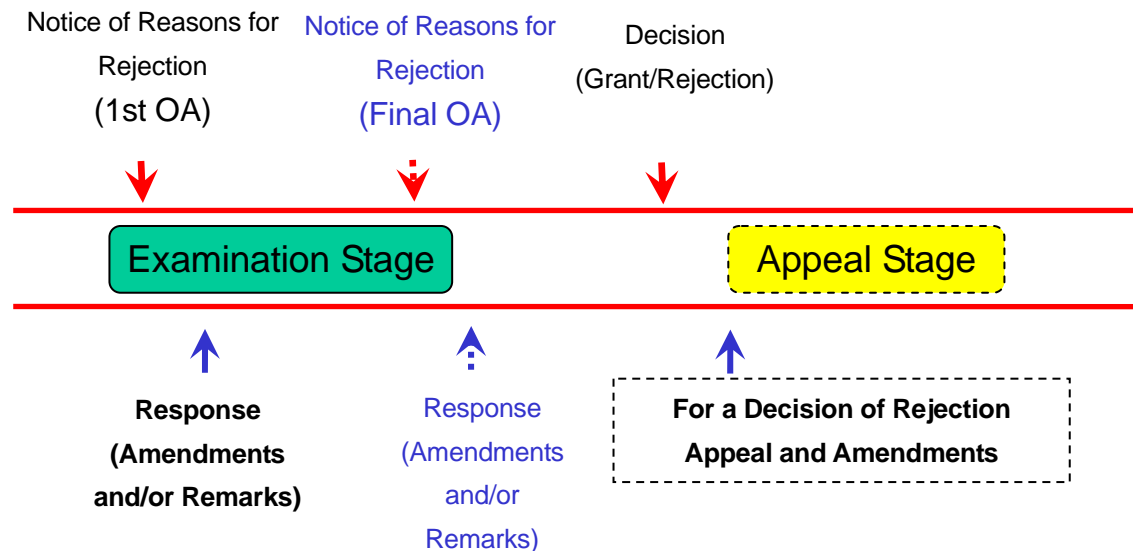
Even if the applicant files a response to an OA which overcomes the reasons for rejection, if another reason for rejection is newly found only as a result of an amendment made in response to the OA, the JPO will issue what is called a “final” OA in order to prevent an unending cycle of OAs and responses. The allowable scope of amendments for a final OA in Japan is further restricted so as to avoid the necessity for an additional prior art search. A final OA in Japan is not the same as a final OA in the U.S., for example. If the response to an OA does not overcome the reasons for rejection, the JPO will issue a Decision of Rejection which would require the filing of an appeal if the applicant wishes to continue pursuit of a patent.

5-1 Response Period

The period for responding to an OA is three months for foreign applicants. Up to three one-month extensions of the response due date (a maximum extension of three months) are

available upon request prior to the response due date with the payment of a fee (2,100 yen/month).

Fig. 2 Overview of Examination Procedure



5-2 Allowable Scope of Amendments

[OA other than a final OA]

The allowable scope of amendments when responding to an OA other than a final OA is subject to the following requirements:

(Application Filing Date: Before April 1, 2007)

- The amendments must be within the scope of the disclosure of the original specification.
- Adding new matter is not allowed.

(Application Filing Date: On or after April 1, 2007)

- In addition to the above, claims before and after amendments must satisfy *the requirement of unity of invention*.

(If the amendments do not satisfy the above requirements, such amendments will constitute *reasons for rejection*.)

[Final OA]

The allowable scope of amendments for a final OA or when filing an appeal is further restricted as follows:

Allowed $A+B+C \Rightarrow A+B'+C$
 (Limitation of existing features in the claims)

Not Allowed $A+B+C \Rightarrow A+B+C+D$
 (Introduction of new features into the claims)

6 Final Decision

Upon completion of the substantive examination, the JPO will issue a final decision: either a Decision to Grant a Patent or a Decision of Rejection.

6-1 Decision to Grant a Patent

An applicant must pay the first three-years' maintenance fees (annuities) as the registration fee within thirty days after the issuance of the Decision to Grant a Patent.

6-2 Decision of Rejection

If a Decision of Rejection is issued, the applicant may file a Request for Appeal against the Decision of Rejection at the JPO.

Period During which a Request for Appeal may be Filed: If a foreign applicant receives a Decision of Rejection, a Request for Appeal may be filed within four months from the issue date of the Decision of Rejection. However, please keep in mind that no extension of the due date is available.

Amendments: Amendments, when desired, must be filed simultaneously with the Request for Appeal. The allowable scope of amendments is the same as that for a final OA.

Appeal Brief: An Appeal Brief does not have to be submitted simultaneously with the Request for Appeal. If the Appeal Brief is not submitted by the applicant, the JPO will issue a Notice requesting the submission of an Appeal Brief. In that case, the applicant needs to submit the Appeal Brief within thirty days from the issue date of the Notice.