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The Accelerated Examination Practice in Japan

Information Disclosure System in Japan

**REVISION OF JAPAN PATENT LAW** 4**OUR OFFICE CONTACT** 4**FOCUS/TRENDS IN PATENT LAW****The Accelerated Examination Practice in Japan: The fastest of its kind in the world**

Japanese patent law requires for an applicant to file a request for an examination, which has to be filed with the Japan Patent Office (JPO) within seven years from the international filing date. Even though the request for an examination is filed immediately after the filing date, it usually takes more than two years before the first action or the notice of allowance is issued by the JPO.

As one way to obtain a patent in Japan in a quick and cost-effective manner, an applicant can request an accelerated examination. The first office action or the notice of allowance from the JPO is usually received within three months from the date of the request for an accelerated examination. This is considered the fastest examination system in the world.

**I. Overview**

- 1) In Japan, a patent application will not be examined unless a request for a substantial examination is filed.
- 2) After a request is filed, it usually takes more than two years for a case to be examined.
- 3) The accelerated examination system is exceptions to this normal procedure.
- 4) An applicant can obtain the result within three to four months from the request date. This is considered the fastest examination system in the world.
- 5) An accelerated examination reaches a result faster especially if the application in question has been positively approved as "patentable" as a result of the International Preliminary Examination, or if the case has already been patented in the United States or any countries other than Japan.
- 6) An applicant can also acquire the right to claim compensation (royalty) for infringement without waiting for a translation to be published (see section VI below).



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## **IP LINKS**

**Japan Patent Office**  
<http://www.jpo.go.jp/index.htm>

**Industrial Property Digital Library**  
[http://www.ipdl.jpo.go.jp/homepg\\_e.ipdl](http://www.ipdl.jpo.go.jp/homepg_e.ipdl)

**Japan Patent Attorneys Association (JPAA)**  
[http://www.jpaa.or.jp/english/e\\_index.html](http://www.jpaa.or.jp/english/e_index.html)

**International Association for the Protection of Intellectual Property (AIPPI)**  
<http://www.aippi.org>

**Supreme Court of Japan**  
<http://www.courts.go.jp/english/ehome.htm>

**Institute of Intellectual Property (IIP)**  
<http://www.iip.or.jp/e/index.html>

**Japan Intellectual Property Association (JIPA)**  
<http://www.jipa.or.jp/english/index.html>

## **II. Qualified Applications**

*An application must meet one of the following requirements:*

### **(A) International Applications**

- 1) A patent application must be filed not only at the Japan Patent Office but also at other offices.
- 2) Both an application claiming the convention priority right based on foreign patent application and a PCT international patent application fall into this category.

### **(B) Work-related Applications (Commercial Use Invention)**

- 1) The invention in question must be already exploited.
- 2) In case of the application from a non-Japanese client, the case usually fulfills the above requirement (A); therefore, an application does not have to satisfy this requirement (B).

## **III. Request Deadline**

- 1) An applicant can request an accelerated examination after a request for a regular examination.
- 2) A request for a regular examination must be filed within three years of the international filing date (or seven years for the patent application filed before October 1, 2001).
- 3) A request for an accelerated examination is usually filed simultaneously with a request for a regular examination.

## **IV. Required Documents for Requesting an Accelerated Examination**

### **(A) The results of the prior art search**

- 1) The search report prepared by an applicant him/herself
- 2) The PCT International Search Report
- 3) The PCT International Preliminary Examination Report

- 4) The results of the patent examination by the USPTO, etc.

### **(B) Comments comparing the invention in question from the results of the prior art search**

- 1) An applicant can quote comments from the International Preliminary Examination Report or the approved results from the U.S. patent examination.

## **V. Procedures**

Upon requesting an accelerated examination, the examination begins immediately. Within three to four months from the request, the applicant can receive the first office action or a notice of allowance.

## **VI. The Right to Claim Royalty for Infringement**

- 1) It generally takes more than one year or sometimes more than two years for a translated application to be published after entering into the Japanese national phase.
- 2) This means that an applicant's provisional right to claim compensation (royalty) for infringement does not accrue until one or two years later because the right is obtained only after a translation is published.
- 3) Accelerated examination could be a solution to this problem.
- 4) Instead of waiting for years until the translated application gets published, the accelerated examination system allows an applicant to obtain a patent and acquire the right to claim compensation (royalty) from infringers.

## **VII. Fees**

- 1) There is no official fee for the Japan Patent Office.

- 2) A patent attorney fee for this examination, which includes the argument and preliminary amendments, usually costs \$1,500 to \$2,000, if an additional search is not required due to the fact that the examination has been already completed in the United States or that the international preliminary examination has been completed.
- 3) This accelerated system leads an applicant to save one official action; therefore, per cost effectiveness is high.

## Information Disclosure System in Japan

### I. Overview

- 1) The prior art information disclosure system was introduced in September 2002.
- 2) All patent applications filed after September 2002 are required to disclose the prior art information.
- 3) However, the effect of a violation is so minimal that an application once patented will not become invalidated.

### II. The IDS requirement applies to the following applications:

- 1) All Japanese domestic applications and all international applications filed after September 1, 2002.
- 2) In case of a PCT application entering into the Japanese national phase, an IDS system is required only for applications whose international filing date falls after September 1, 2002.
- 3) In case of a divisional application, an IDS system is required if the parent application was filed after September 1, 2002.

### III. Methods for the information disclosure

- 1) At least one publication should be listed in "Background" section of a patent specification.
- 2) Only publication or literature is acceptable, including electronically formatted Web documents available online.
- 3) If an applicant has a number of prior arts, an applicant can disclose only the major ones that are most relevant.
- 4) If a prior art is a patent publication, the following information has to be provided: its application number, publication number or patent number.
- 5) For a non-patent publication, including a dissertation, a thesis or any kind of electronically formatted non-patent document, the following information is required: the name of the document, name of the organization published, publisher, date of presentation, published date, volume, number, cited page number(s), and/or URL address and online published date.
- 6) An applicant does not have to submit the original or duplicate copies of publications. However, depending on the case, the examiner sometimes asks for the documents for examination purposes. Only in this case, an applicant is required to submit copies of publications about prior arts.
- 7) If there are no prior arts to disclose, an applicant must state the reason in the patent specification.

### IV. Effects of Disclosure

- 1) If a specification does not include any information on prior arts nor a reason for not including the prior

Japan Patent Information Organization (JAPIO)  
<http://www.japio.or.jp>

Licensing Executives Society Japan (LES)  
<http://www.lesj.org>

Japan Institute of Invention and Innovation (JIII)  
<http://www.jiii.or.jp/english/e.htm>

Asia-Pacific Industrial Property Center (APIC)  
<http://www.apic.jiii.or.jp>



### **About Omori & Yaguchi**

Omori & Yaguchi is a Tokyo-based intellectual property law firm, offering a full range of contentious and non-contentious legal services in Japanese intellectual property law, including patent, trademark, trade secrets and technology licensing.

Omori & Yaguchi serves a wide variety of clients internationally ranging from universities and venture companies to large global businesses. In order to communicate well with clients in the United States without barriers of language, culture, physical distance as well as the time differences, Omori & Yaguchi established its liaison office in Philadelphia in 2000.

Japanese Patents and Trademarks  
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Instant estimate for filing patent and trademark applications in Japan

- For entering the Japanese national phase for PCT patent applications.
- For filing a Japanese translation within two months from the date of entry.
- For filing a Japanese trademark application with a corresponding foreign application.
- Formal online estimate is also available.

arts, an official action will be issued from the JPO. Upon receiving the official action, the applicant can file an amendment according to the examiner's request.

- 2) Failure in disclosure could result in the rejection by examiners but will not invalidate the patent after issued. In other words, negligence of the duty has no effect on the validity of the patent right.
- 3) Therefore, even if the fact that a patentee, who had known the availability
- 4) However, a patentee knowingly neglecting to follow this system may face indirect disadvantages when attempting to enforce his/her rights.

## REVISION OF JAPAN PATENT LAW

*(Effective January 1, 2004)*

### The JPO to lower a patent application fee

- Both application official fees and patent annuity fees will be reduced.
- The examination official fee is to increase.
- Overall cost per prosecuting and maintaining patent will be lowered.

### The examination fee refund system

- The entire examination official fee will be refunded if an applicant chooses to withdraw the application prior to the receipt of a first official action by the JPO.

### Opposition and Trial for Invalidity

- The opposition system will not be available after January 1, 2004. Only a trial for invalidity will be available to invalidate the patent.
- According to the revised trial for invalidity, any application can anonymously request for a trial for invalidity.
- As compared with the present trial system, the new trial system is expected to be faster to obtain a result.

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