

PATENT ABSTRACTS OF JAPAN NEWS

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The JPO's Efforts for applicant's acquisition of stable patent and International Work sharing (Patent Prosecution Highway & JP-FIRST)

<Introduction>

Following the global increase of patent applications against the background of the ongoing globalization of economy, the number of so-called duplicate applications, which refers to applications that claim the same inventions and are filed to multiple offices, has also been increasing and this has enlarged the examination workload of each office. Under such a situation, aiming at the establishment of a more substantial framework of international cooperation - a Virtual Global Patent Office - in which one invention can be efficiently and reliably examined and in which the applicant can protect the one invention efficiently and globally as an intellectual property, the JPO is enhancing work sharing in patent examination with various patent offices.

More specifically, with the objective of achieving work sharing on a global scale and enabling applicants to obtain rights efficiently and at low cost, the JPO

implements various measures, centering on the Patent Prosecution Highway and JP-FIRST(JP-Fast Information Release STRategy).

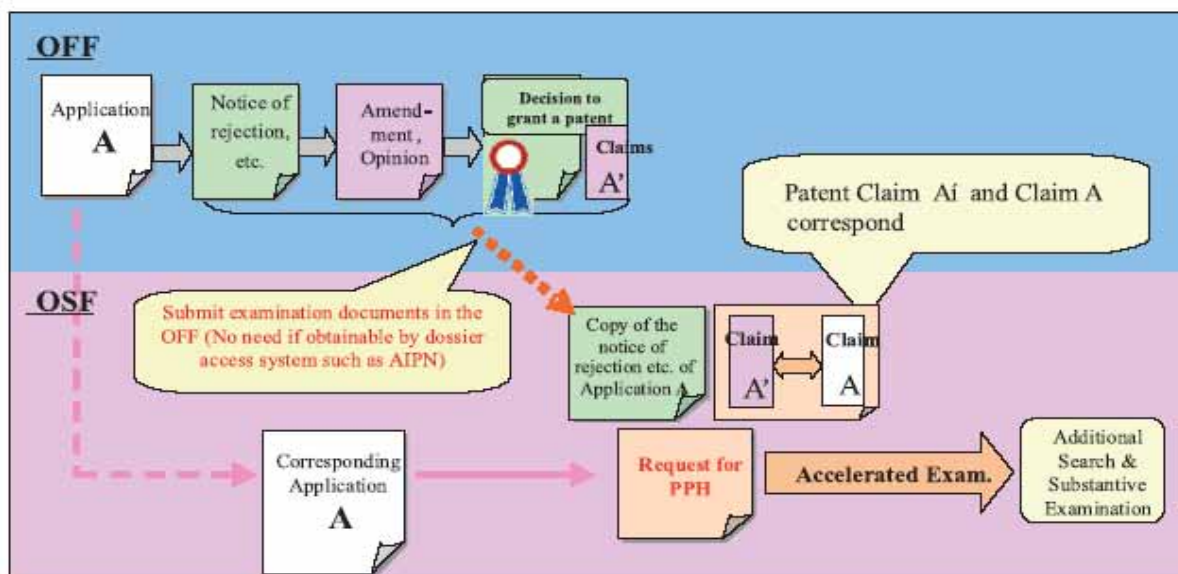
The sections below give details of these core projects, the Patent Prosecution Highway and JP-FIRST.

<Patent Prosecution Highway>

The Patent Prosecution Highway (PPH) is a framework for allowing, on request by the applicant, accelerated examination in the Office of Second Filing (OSF) with simplified procedures, with respect to the application whose claims are determined to be patentable in the Office of First Filing (OFF). The patent offices participating in this program can make use of search and examination results obtained by other offices, thereby reducing their examination workload and improving the quality of examination.

The PPH supports applicants in obtaining stable and strong patents in multiple countries efficiently, while reducing the duplicate tasks required of the patent offices through work sharing.

[Outline of the Patent Prosecution Highway]

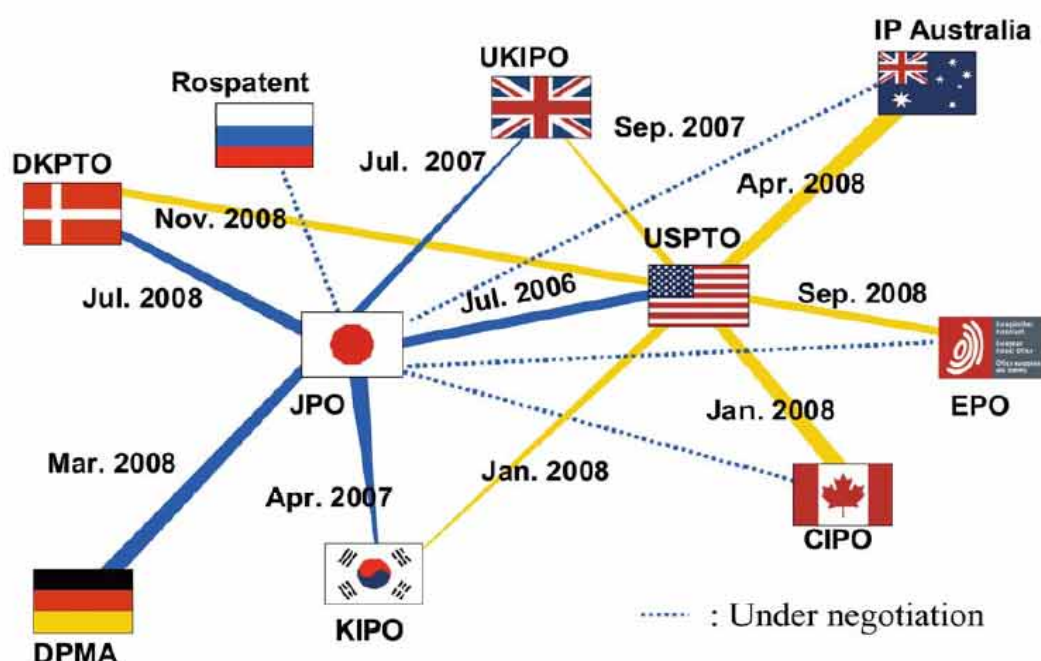


(1) Expansion of PPH Network

The JPO launched the PPH Pilot Program with the United States Patent and Trademark Office (USPTO) in July 2006 and since then it has expanded the PPH Network. At present, the JPO implements the PPH with the USPTO and the Korean Industrial Property Office (KIPO) on a permanent basis, and is working on pilot

programs with the United Kingdom Intellectual Property Office (UKIPO), the German Patent and Trademark Office (GPTO/DPMA) and the Danish Patent and Trademark Office (DKPTO). In the efforts to expand the PPH Network the JPO is in negotiation with Canada (CIPO), Russia (ROSPATENT) and European Patent Office (EPO). The USPTO currently implements the PPH with six offices in total, including the JPO and the KIPO, on a permanent basis or on trial basis, and the KIPO, CIPO and UKIPO are also considering increasing their PPH partners. By expanding the PPH network, we aim to achieve efficiency in obtaining stable rights worldwide.

[Expansion of the PPH network]



(2) JPO-USPTO PPH

The results of the implementation of the JPO-USPTO PPH, the first PPH launched in the world, can be analyzed as follows. The grant rate for applications filed by applicants in Japan to the USPTO with PPH requests was 96% (overall grant rate at the USPTO (latest): 44%)*¹, and the grant rate for applications filed by applicants in the United States to the JPO with PPH requests was 65% (overall grant rate at the JPO in 2007: 49%)*²(both excluding applications pending at the examination stage).

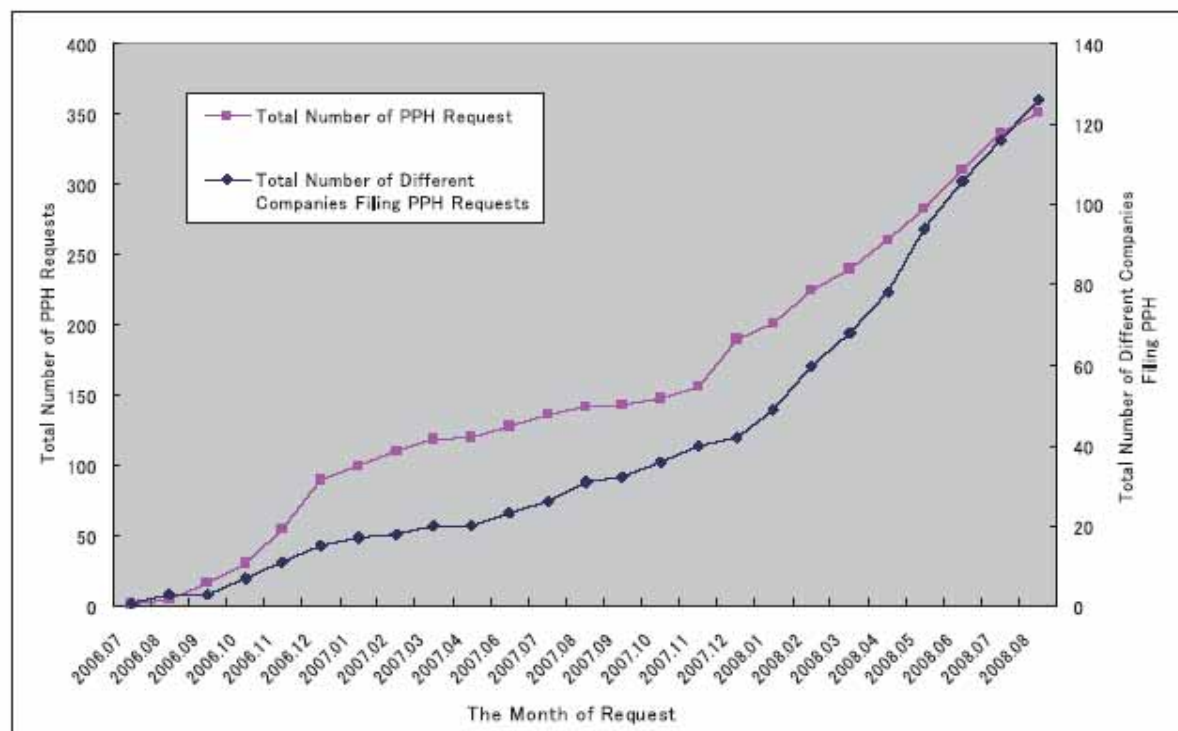
*¹ Grant rate = the number of allowances / (the number of allowances + abandonment)

*² Grant rate = the number of decisions to grant / (the number of decisions to grant + the number of decisions of refusal + the number of withdrawals/abandonment after the first action)

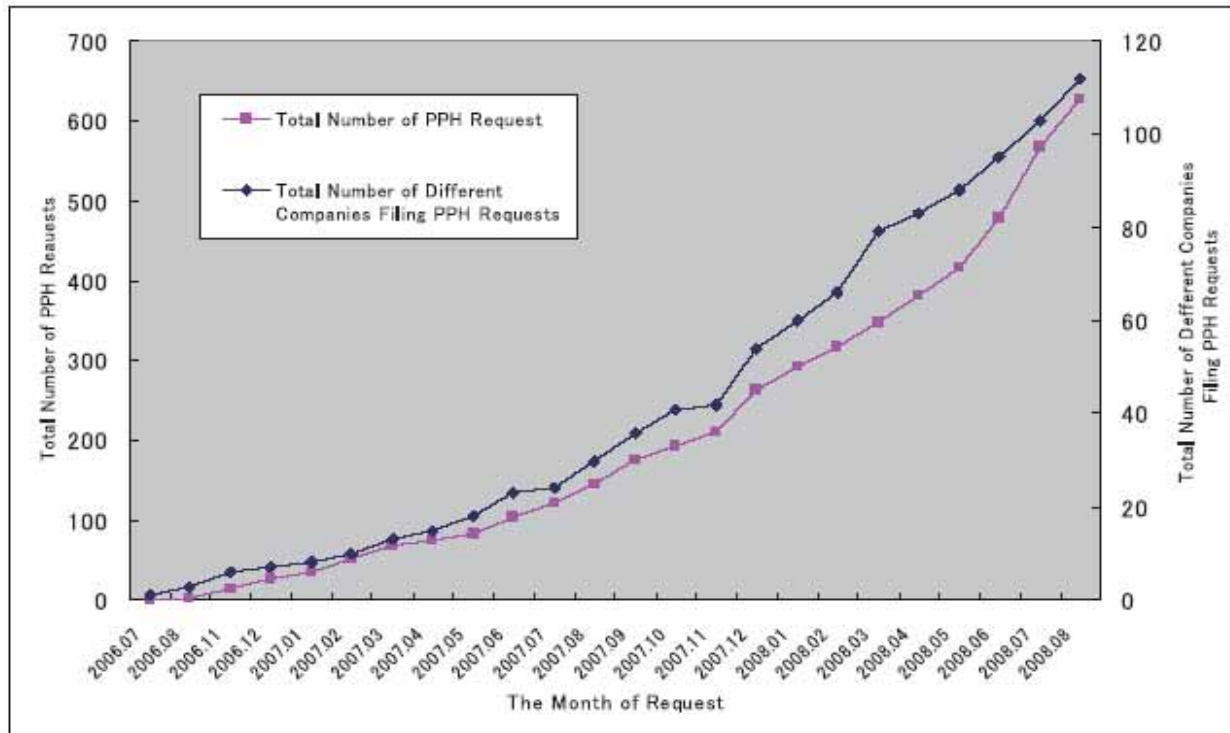
The average period of pendency from the request for the PPH in JPO (the grant of PPH request in USPTO) to the First action (FA) is two or three months both at the JPO and the USPTO, which shows that the examination is commenced under the PPH far more promptly than the ordinary procedure. Positive opinions regarding the PPH have been heard both from PPH users and patent examiners, such as: "we successfully reduced costs by using the PPH because we received fewer office actions from the OSF that we should respond to" (user), and "we were able to clearly identify the points on which we had to conduct additional search in the examination process, and in this respect, the PPH reduced our workload" (examiner).

Thus, the number of PPH users has been increasing steadily as its advantage is recognized widely.

[Increasing Number of PPH requests under the JP-US PPH (from Japan to US)]



(from US to Japan)



In order to make the PPH more convenient, the JPO will carry out initiatives for the standardization of the PPH requirements through cooperation among PPH partner offices.

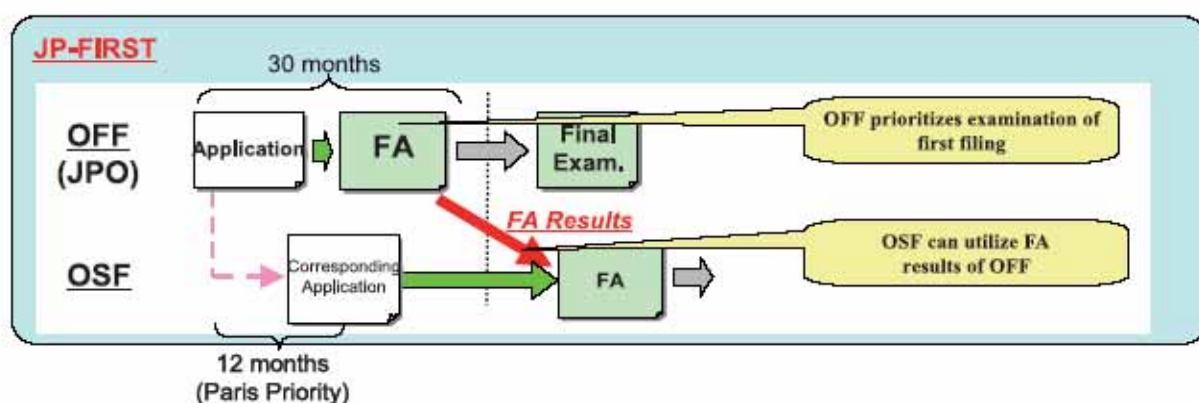
<For more information on the Patent Prosecution Highway>

http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.htm

<JP-FIRST (JP-Fast Information Release Strategy) >

The JP-FIRST (JP-Fast Information Release Strategy) is a framework which aims to provide the applicants with the results of the first examination of their applications at an early stage, while releasing the examination results made by the JPO and making them available in the examination process at other patent offices. Through these efforts, examiners at overseas offices can make use of the examination results of the JPO, which is conducive to reducing their workload. JP-FIRST is also beneficial to Japanese applicants, for it will secure high quality in the examination at overseas offices and enable them to obtain stable and strong rights overseas. The JPO has been implementing this strategy since April 2008.

[Outline of the preferential examination at the OFF and the utilization of the first examination results]



Under the framework of JP-FIRST, the JPO prioritizes examinations of applications satisfying both (i) & (ii).

- (i) First filed at the JPO and then filed via the Paris route with the OSF(s).
- (ii) Examination of application is requested within 2 years from the JPO filing date.

The JPO provides examination results (first office actions) to applicants within 30 months or less from the JPO filing date.

The JP-FIRST does not apply to those applications that are the basis of PCT applications.

With regard to the applications that have been subject to JP-FIRST thus far, analysis was made as to the timing of the commencement of the examination of corresponding applications at OSF.

The JPO analyzed 4441 applications satisfying the JP-FIRST conditions that were examined from April to September in 2008. Of these 4441 applications, 3488 were filed at the USPTO, 899 were filed at the EPO and 811 were filed at the KIPO.

93% (3228 of 3488) were examined in the JPO before the USPTO provides the first office actions.

87% (781 of 899) were examined in the JPO before the EPO provides the first examination reports.

50% (446 of 899) were examined in the JPO before the EPO provides the search report.

79% (640 of 811) were examined in the JPO before the KIPO provides the first office actions.

These results suggest the successful implementation of this strategy.

Even in the case of those applications that have entered the examination process after they were published (18 months after the filing date), the commencement of examination at the JPO for most of such applications is in time for overseas offices to commence substantive examination, which means overseas examiners can utilize the examination results provided by the JPO as references.

All examination related information including office actions of the JPO are translated by a machine translation system and made available for real-time inspection via the Advanced Industrial Property Network (AIPN), which are exclusive to examiners.

When the overseas office (as OSF) examines an application filed with the priority claim under the Paris Convention based on a Japanese application, examiners of OSF first access the AIPN to confirm whether or not any examination results are provided by the JPO, and if they find available examination result, it can be utilized at their own examination and reduce duplicate examination work.

Applicants can also enjoy the benefit of JP-FIRST which secures high quality in the examination at overseas offices and enables them to obtain stable and strong patents overseas.

<For more information on JP-FIRST>

http://www.meti.go.jp/english/newtopics/data/nBackIssue20071228_01.html

Above efforts also enable updating examination related information promptly for the public users via PAJ Legal Status.

<PAJ Legal Status (IPDL website)>

http://www.ipdlinpit.go.jp/homepg_e.ipdl