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## Newsletter

As we have received many inquiries regarding the following items, we have provided you with a summary, for your reference. Featured are:

- Accelerated Examinations and the Patent Prosecution Highway in Japan
- The Timing for Filing a Divisional Application in Japan
- Madrid Protocol Applications Designating Japan

Also, in this issue we introduce a recent trend in proposed amendments to the law.

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## 1 Accelerated Examinations and the Patent Prosecution Highway in Japan

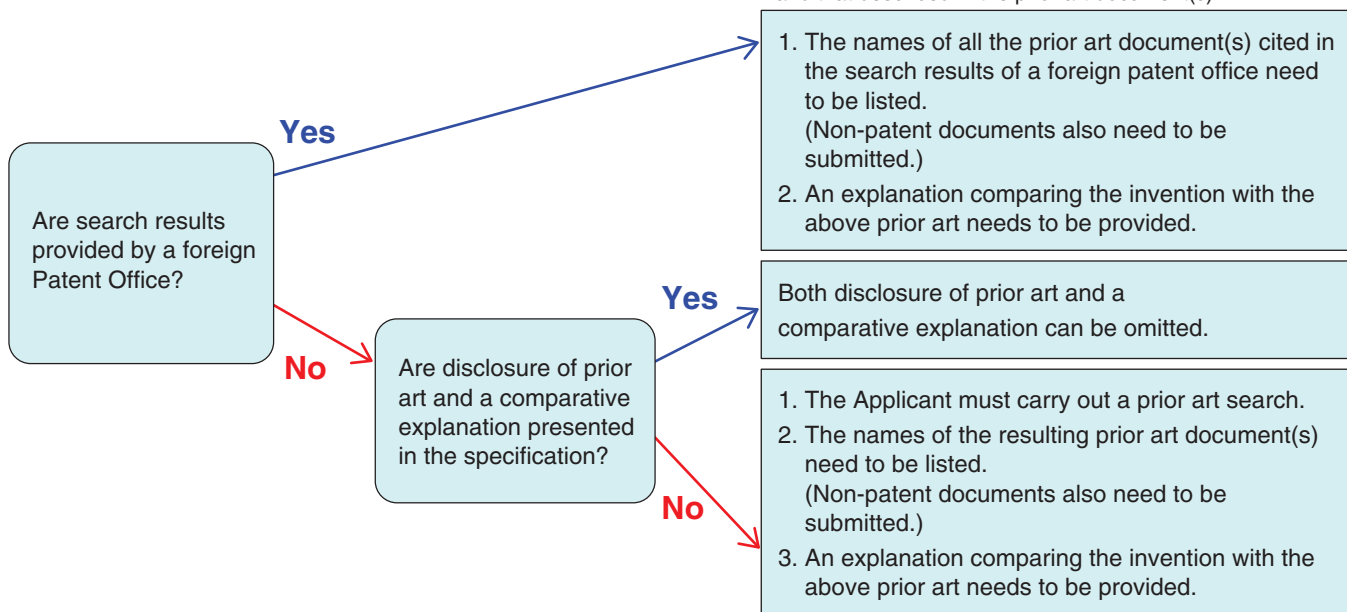
The major characteristics are as follows.

|  |  | Accelerated Examination   | Patent Prosecution Highway   |
|--|--|---|--|
| Patentability of corresponding foreign applications                                    |  | Not Required <sup>1</sup>   | The application filed at the Office of First Filing (OFF) must have at least one claim that was determined by the OFF to be patentable <sup>2</sup> .                  |
| Correspondence of claims between corresponding foreign applications and JP application |  | Not Required  | All the claims in the JP application must sufficiently correspond to any of the patentable claim(s) in the OFF application <sup>3</sup> .                              |
| Required documents   | Claims correspondence table <sup>4</sup>   | Not Required  | Required   |
|  | A copy of claim(s) that were determined by the OFF to be patentable, with Japanese/English translation | Not Required  | Required<br>(when the claim(s) is(are) available online and in English, the submission of a copy of the claim(s) and a translation thereof can often be omitted.)      |
|  | A copy of the office action(s) (OA(s)) of the OFF, with Japanese/English translation                   | Not Required  | Required<br>(when the OA(s) of the OFF is(are) available online and in English, the submission of a copy of the OA(s) and a translation thereof can often be omitted.) |
|  | Disclosure of prior art  | The applicant must carry out a prior art search, based on the results of which a list of the prior art document(s) needs to be provided.<br><br>(Non-patent documents need to be submitted. In principle, patent documents need not be submitted.)<br><br>A prior art search by the applicant can, however, be often omitted <sup>5</sup> . | The documents cited in the OFF need to be submitted.<br><br>(Non-patent documents need to be submitted. In principle, patent documents need not be submitted.)         |
|  | Comparative explanation  | An explanation comparing the invention with the prior art disclosed in the above document(s) needs to be provided. This can, however, be omitted in some cases <sup>5</sup> .   | Not Required   |

- \*1 The Accelerated Examination can be applied to (a) applications that have been filed with both the JPO and at least one foreign patent office, (b) applications that have been filed with a patent office as the receiving office under the PCT and then entered into the National Phase in Japan, and (c) applications that have been filed with the JPO as domestic applications and also filed with a receiving office under the PCT, without any relation to their patentability.
- \*2 Please keep in mind that the Patent Prosecution Highway system does not guarantee the same examination results as those provided by the OFF for a JP application.
- \*3 In cases where there is no correspondence, the claims in the JP application must be amended so as to sufficiently correspond to any of the patentable claim(s) in the OFF application.
- \*4 A table indicating how all the claims in the JP application correspond to the respective patentable claim(s) in the OFF application needs to be submitted.
- \*5 Depending on the conditions shown below, the necessity of the search for prior art and/or the disclosure of prior art/a comparative explanation can change.

### Disclosure of prior art documents and comparative explanation

A comparative explanation needs to briefly describe a comparison between the invention in the JP application and that described in the prior art document(s).



As is apparent from the above Table, unlike the Patent Prosecution Highway system, the Accelerated Examination system neither requires corresponding foreign applications to be determined as being patentable in advance, nor claims of the JP application to be conformed to claims of corresponding foreign applications. Also, when search results of a corresponding foreign application by a foreign patent office are available, or even in the absence of such search results, as long as the specification of the JP application contains disclosure of the prior art document(s) and explanations of the comparison of the invention with the prior art, an Accelerated Examination can be requested with a simple procedure.

Even when the application does not meet the requirements for the Patent Prosecution Highway system, it may meet the requirements for the Accelerated Examination system (or vice versa). Therefore, if you wish to have a faster examination, we recommend that you make use of the Patent Prosecution Highway or Accelerated Examination systems, after considering both of them. (In many cases, the prosecution process can be made simpler if an Accelerated Examination is requested.)

### 2011 Examination Period Statistics (Published on the website of the JPO)

|                           | Normal Examination | Accelerated Examination | Patent Prosecution Highway |
|---------------------------|--------------------|-------------------------|----------------------------|
| Waiting time for first OA | 25.9 months        | 1.8 months              | 1.8 months                 |

## 2 The Timing for Filing a Divisional Application in Japan

The time period during which a divisional application can be filed starting from the parent application varies depending on whether the parent application was filed before April 1, or on or after April 1, 2007.

(However, in the case of a divisional application from an existing divisional application, the filing date of the original parent application serves as the basis for the decision).

The time period during which a divisional application can be filed is as follows:

### Parent patent applications filed **before April 1, 2007**

1. At any time before the first communication from the Japan Patent Office (JPO) occurred as a result of the substantive examination, i.e., before the JPO dispatches a Notice of Decision of Grant, and before applicants first receive a Notice of Reasons for Rejection;
2. Within the designated time limit for responding to a Notice of Reasons for Rejection;
3. Simultaneously with filing an Appeal against a Decision of Rejection.

### Parent patent applications filed **on or after April 1, 2007**

1. *Same as the above item 1*
2. *Same as the above item 2*
3. *Same as the above item 3*
4. Within 4 months after the dispatch of a Decision of Rejection, and without having to file an Appeal against said Decision;
5. Within 30 days after the dispatch of a Decision of Grant, but before the registration of the establishment of a patent right, provided that the Decision of Grant is issued without going through Appeal trial proceedings.

After filing an Appeal against a Decision of Rejection, the opportunity to file a divisional application is only restricted to such cases where a further Notice of Reasons for Rejection is issued during the appeal proceedings. The issuance of said further Notice of Reasons for Rejection during appeal proceedings does not occur so frequently. Therefore, once a Decision of Rejection is issued, the time period set forth under Item 3 (patent applications filed before April 1, 2007), or Item 3 or 4 (patent applications filed on or after April 1, 2007) would be practically the last chance to file a divisional application.

The following are flow charts including some typical examination proceeding procedures, simplified for easy reference, where the **solid bold lines (blue)** indicate the time periods during which a divisional application can be filed.

In the flowcharts, the time periods during which amendments can be filed are also indicated with **solid lines (green)**.

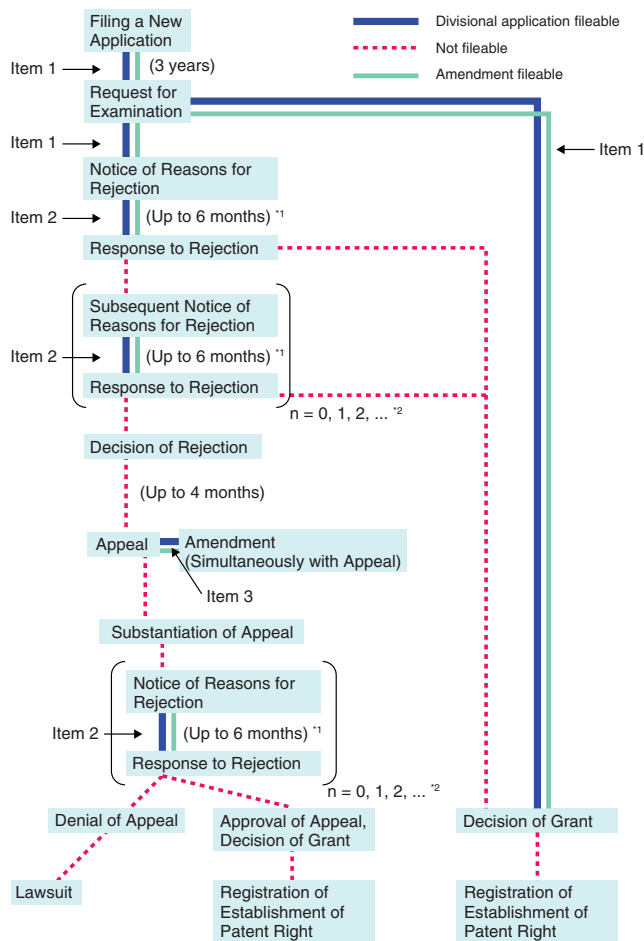
[Please note that claim amendments permitted during the term for responding to the Final Notice of Reasons for Rejection or when filing an appeal are limited to: (i) canceling claim(s); (ii) making the scope of claim(s) smaller, by restricting the element(s), which already pertain(s) to the definition of the existing claim(s), further provided that the industrial applicability and the problem to be solved by the invention defined by the amended claim(s) must be the same as those of the invention defined in the claims before the amendment; (iii) correcting typographical errors; and (iv) clarifying an ambiguous description (only limited to clarification relating to the Reasons for Rejection).]

### Notice:

When filing a divisional application, it is required by the JPO to accompany it with a paper which explains that:

- i) the divisional application complies with the following requirements (a) and (b):
    - (a) no new matter has been introduced into the divisional application compared to the matters described in the parent application; and
    - (b) the claimed subject matter of the divisional application is part of the subject matter described in the parent application;
  - ii) the claimed subject matter claimed in the divisional application is distinguishable from that of the parent application; and
- Only for parent applications filed on or after April 1, 2007:
- iii) the divisional application is already free from the Examiner's rejection indicated in respect to the parent application.

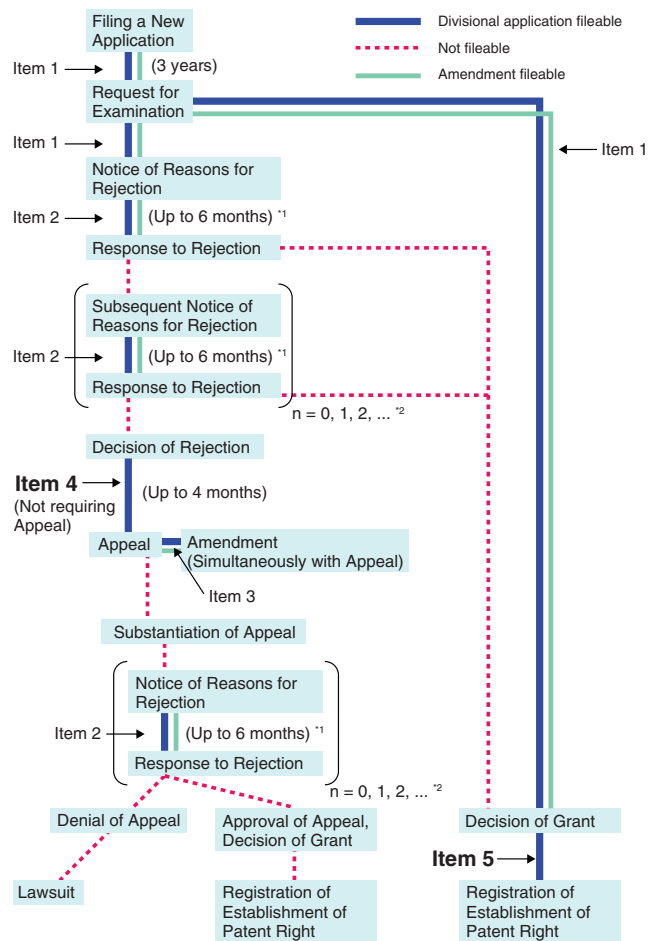
### Flow Chart Regarding Filing of Divisional Application (Parent patent applications filed before April 1, 2007)



\*1. After the initial 3-month term, it is possible to receive a subsequent extension of up to 3 months.

\*2. "n" indicates the number of received Notices of Reasons for Rejection.

### Flow Chart Regarding Filing of Divisional Application (Parent patent applications filed on or after April 1, 2007)



\*1. After the initial 3-month term, it is possible to receive a subsequent extension of up to 3 months.

\*2. "n" indicates the number of received Notices of Reasons for Rejection.

## 3 Madrid Protocol Applications Designating Japan – How It Differs from Domestic Applications

As you know, there are many advantages in using the Madrid System to obtain protection of trademarks worldwide, including lower costs, simplified formalities, and easy maintenance.

On the other hand, when designating Japan, there are several points one should take into consideration.

First of all, an international registration (IR) designating Japan under the Madrid System is regarded as a Japanese trademark application. Therefore, basically, said IR is examined in the same manner as a domestic Japanese trademark application.

However, the Examination practice concerning an IR designating Japan differs from that of a domestic Japanese trademark application in a few ways, as follows:

- (1) It is not possible to change the classes to which the goods/services belong in the case of an IR.
- (2) The amendment of goods/services is only possible within three months from the date of pronouncement of the Notification of Provisional Refusal (plus the extended term of one month, upon request) for an IR.

The aforementioned two points become a concern especially when an applicant receives a vague/broad description ground of refusal, which, we believe, is the most common ground of refusal received by applicants. When the application is filed as a domestic trademark application, an applicant may make necessary amendments at any time, as long as the application is in the examination stage. This means that we have more time to review the intended goods/services, and more time to communicate with the applicant, as well as the Examiner. Further, the applicant of a domestic application may change the class from one to another in the case of misclassification. Therefore, for a domestic application, we can take more flexible measures against a vague/broad description ground of refusal.

### **(3) The examination concerning the vagueness/broadness of designated goods/services appears to be more relaxed with IRs.**

Though the vague/broad description ground of refusal is the most common ground of refusal for IRs, the examination concerning the vagueness/broadness of designated goods/services for an IR appears to be more relaxed than that for a domestic application. This may be because, under Japanese practice, examination of the description of goods/services has traditionally been very strict for domestic applications, while the JPO cannot apply the same examination standards for an IR which specifies goods/services in English, and is completely free from said traditional examination standards from the beginning.

One may consider this as an advantage of using the Madrid System, because if the IR does not receive any grounds of refusal, it would go straight to registration, which could save time and expense. However, is this always an advantage?

The problem is that it is sometimes revealed later on that the designated goods/services of an IR do not exactly cover the intended goods/services of the applicant.

For example, so-called “dietary supplements for humans” now clearly belongs to class 5 after the adoption of the 10th edition of the Nice Classification, but before that, it was covered in class 29 or 30, depending on the main ingredients of said dietary supplements, under Japanese practice. This is because “dietary supplements” was regarded more as “food”. However, we noticed in several IR cases that the descriptions for which, in our opinion, “dietary supplements” were probably meant, were allowed in class 5, under the group heading of “pharmaceutical preparations”.

For your information, in the 10th edition of said classification, “dietary supplements” has come to belong to class 5. However, one has to keep in mind that said goods, “dietetic food adapted for medical purposes”, and “pharmaceutical, veterinary and sanitary preparations” in class 5 are deemed not similar to each other, under Japanese practice. Further, “dietary supplements”, which now belongs to class 5, is deemed similar to those which were registered under the previous editions in classes 29 and 30.

With domestic applications, we can provide our clients with the type of advice as stated above before the time of filing the application, but in the case of an IR, we do not have this opportunity.

Given said circumstances, we believe it is best to file trademark applications in Japan using the Madrid System, if the designated goods/services are very traditional, typical, and straightforward. On the other hand, we suggest filing a domestic application, in such case that the designated goods/services are rather newly introduced to the market, or are classified into different classes depending on each specific country.

### **(4) It is not possible to divide the IR.**

For domestic applications, if they have a ground of refusal only concerning certain goods/services, and all the other goods/services are free from the ground of refusal, the applicant may divide the application, in order to expedite the registration with reference to the designated goods/services which do not have the ground of refusal. However, with IRs, we cannot take this approach, and must wait for all the problems to be resolved.

### **(5) The second part of the individual fee must be paid to the International Bureau (IB) directly, within the subscribed period on the Notice.**

Unlike most other countries, the second part of the individual fee must be paid to the IB, in order to have the IR registered in Japan. This second part of the individual fee is equivalent to the registration fee for a domestic application, but one should keep in mind that the applicant (or their Attorney) must pay the fee to the IB directly.

We hope the information above is helpful for you to decide which route to choose when seeking trademark protection in Japan.

## **4 Information on Amendments to the Law**

Below, we introduce information on proposed amendments to the law. Please note that all of the revisions introduced below are still under discussion, and the specific content of the revisions will be revealed in the future.

### **Patent**

#### **System to Review a Patent Right After its Grant**

We are often asked, “What kind of procedures are available in Japan to invalidate the granted patent right (e.g., of a competitor)?”

Previously there were two systems available in Japan by which the validity of a patent right is re-examined after its grant. One is the opposition to the patent, and the other is the patent invalidation trial.

But, with the revision of the Patent Law in 2003, the system of opposition to the patent was merged into that of the patent invalidation trial.

As a consequence, only the patent invalidation trial is left as an effective approach. There also exists a third-party information submission after the grant of a patent, which is however less practical.

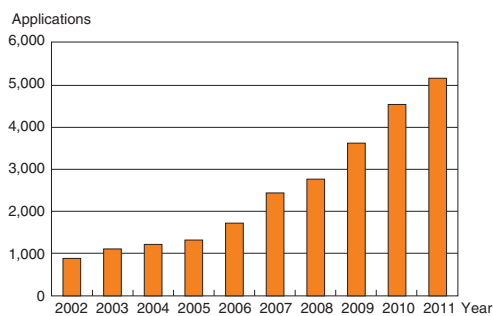
However, in light of the following background, it is under discussion whether some particular system, which is similar to the former opposition system, should be restored, in order to review the patent right after its grant.

### Background

- A set up target, so-called “FA11(First Office Action in 11 months)” for the quick first Office Action is being promoted. The number of requests to accelerate the examination has increased. As a result of this, a greater number of patent applications are being granted a patent before they are published.
- The third-party submission of information before the grant of a patent is contributing to the improvement of the quality of patent examinations. But, as a result of the above, the total available opportunities to submit information before the grant of a patent have been decreased.
- It has been necessary to re-introduce a system to review the content of the patent right, in order to attain a “strong patent” while promoting quick examinations.

In response to the above, the Japan Patent Attorneys Association established a division in the Patent Committee for studying the system of new opposition after the grant of a patent and has implemented an opinion-gathering process.

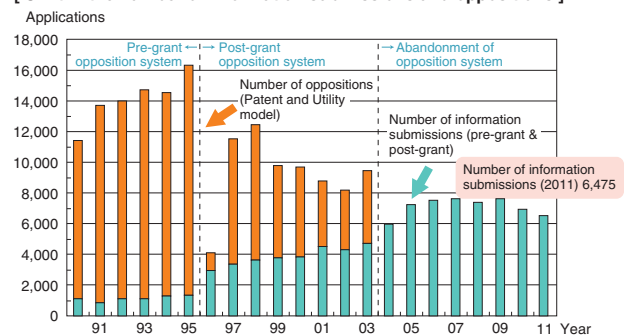
[ Shift in number of decisions to grant a patent before publication ]



(Source) prepared by JPO

Excerpts from materials of the 18th Meeting of the Industrial Policy Division of the Industrial Structure Council, on the JPO website

[ Shift in the number of information submissions and oppositions ]



In 72% of the applications for which information was submitted, the documents submitted as a source of information were cited in the Notice of Reasons for Rejection. (Source) Website of JPO

## Design

1. Japan’s accession to the Geneva Act of the Hague Agreement is under consideration. It is anticipated that doing so will have several advantages, such as (1) the simplification of the application procedure, (2) a reduction in the cost of filing, (3) unified management of international registration, and (4) making it possible to foresee the validity of right within a certain time period.
2. Previous amendments to the law and the Design Examination Standard have achieved the protection of screen designs, but such protection is limited to designs which fulfill the following requirements: (1) The image must be integrated to the article at the time of creation, trade, and use of the image, and (2) The image must be a “displayed image” (an image displaying things that are necessary to enable the article to perform its function) or an “operational image” (an image that is provided for use in operations carried out in order to enable the article to perform its function). Because of these requirements, screen designs used in computer operating systems, handheld video games, webpage designs, etc., which are protected in the EU, US, and elsewhere, are not yet subject to protection. In light of the above, discussions are currently underway to also make such images subject to protection, with the aim of enhancing the protection of screen designs.

## Trademark

Discussion is now going on to include motion marks, hologram marks, color marks without delineated contours, position marks, sound marks, scent or smell marks, etc. as new types of trademarks within the marks subject to protection.

Where possible, the above revision of the law will be submitted to the regular session of the Diet next year.