



# **For better quality of Patent Examination**

**- Based on our Experiences -**

**Workshop on Patent Examination Quality Administration**

**Tokyo, June 21, 2017**

**Masahiko FUKUMOTO**

**(URL: <http://fintpat.com>)**

**from International Activity Center  
of Japan Patent Attorneys Association (JPAA)**

# Topics

- 1. Introduction**
- 2. Phone Interview with Examiner**
- 3. PPH (Patent Prosecution Highway)**
- 4. Machine Translation**
- 5. Continuous Training Program for JP Patent Attorneys**
- 6. Voluntary Training Activities**
- 7. Voluntary Research Activities**
- 8. Message**

# 1. Introduction (1)

- For better quality of Examination, JPO provides various services, such as:
  - On-site Interview with Examiner
  - Phone interview with Examiner
  - Accelerated Examination
  - PPH (Patent Prosecution Highway)
  - Meeting for exchange of views with Patent Attorneys and Businesses
  - Provision of patent publication search system usable in English
  - Provision of machine English translation of patent publication available on search system

# 1. Introduction (2)

- For better quality of Examination, JP Patent Attorneys also perform various activities, such as:
  - Continuous Training for JP Patent Attorneys
  - Voluntary Training
  - Voluntary Research
- Some topics will be shown based on our own experiences

## **2. Phone Interview with Examiner (1)**

- **JPO Examiner accepts request for preview of Response to OA.**
  - **We can send draft Response to Examiner by facsimile and later conduct phone interview.**
  - **Examiner examines draft Response without further conducting prior art search.**
  - **Many of Examiners accept request twice or three times for one OA.**

## 2. Phone Interview with Examiner (2)

### Advantages (1):

- **Next OA is highly possibly Notice of Allowance,**
  - **because all reasons for rejection can be eliminated before formal filing of Response.**
  - **Resulting in lower costs shouldered by Applicant.**

## **2. Phone Interview with Examiner (3)**

### **Advantages (2):**

- **Adequate scope of claimed invention can be patented,**
  - **because draft Response can be revised based on Examiner's preview, in many cases, twice or three times.**
  - **because first OA allows Applicant to amend claims without restriction as long as new matter is not added.**

## **2. Phone Interview with Examiner (4)**

**We hope:**

- **Overseas IP Office Examiners also accept request for preview of Response to OA and phone interview before formal filing.**

**Related Topic:**

- **On-site Interview with Examiner is to be more frequently available in Osaka from July 2017.**



# 3. PPH (1)

**Our recent experience:**

- **JP Applicant filed US continuation application based on its PCT application with amendments to claims and request for PPH.**
- **Amendments adjusted claims into JP claims already allowed.**
- **Correspondence table between two claim sets was also submitted.**

# 3. PPH (2)

## Example:

Correspondence of Claims between the present US application and Japan Patent already issued

Claims of the present application (US Claim)	Claims of JP Patent issued (JP Claim)	Comments
1	1	US claim is changed from JP claim in formality to comply with US practice.
2	2	US claim is changed from JP claim in formality to comply with US practice.
3	3	No difference.
4	4	No difference.
5	5	No difference.
6	6	US claim only depends on claim 4.

## **3. PPH (3)**

- **Five months later, we received Notice of Allowance without rejection of any of claims.**

### **Advantages of PPH:**

- **First Office Action will, in higher possibility, be Notice of Allowance.**
- **Examination is performed in an accelerated manner without additional official fee (in most nations).**

## **3. PPH (4)**

### **Advantages of PPH (cont):**

- **Voluntary prior-art search is not required.**
- **All those result in drastic reduction in attorney's fee, which is beneficial for Applicant.**

### **We hope:**

- **All overseas IP Offices join PPH program.**

## 4. Machine Translation (1)

- **JPO provides mechanical translation of application and patent publications.**
  - **Abstract is hand made.**
  - **All other parts are machine-aided.**
- **Person skilled in the art can well infer what translation says.**
- **Can be used for translation of publication cited by JP Examiner in Office Action (OA).**

## 4. Machine Translation (2)

- **Only partial translation should be prepared by hand upon overseas attorney's request if any.**
- **Only OA should be translated by hand fully and accurately.**
- **Machine translation can be filed as IDS (Information Disclosure Statements) with USPTO.**

## 4. Machine Translation (3)

### Advantages:

- **Overseas attorney can prepare adequate Response to OA with drastic reduction in JP attorney's fee.**
- **High quality of examination can be maintained with lower costs charged to overseas applicant.**

# 4. Machine Translation (4)

**We hope:**

- **Overseas IP Offices also provide machine translation of application and patent publications.**
- **Examiner provide detailed reasoning for rejection on a claim-to-claim basis in all Office Actions to allow Applicant/Attorney to prepare adequate Response to OA.**



# 5. Continuous Training for JP Patent Attorneys (1)

- **Continuous Training is prescribed in Patent Attorneys Act.**
- **JP attorney must take Continuous Training for 70 hours every 5 years.**
- **Topics are wide-ranged, including domestic and overseas ones.**
- **Some topics (Re. revision of Acts, attorney's moral, etc) are compulsory, most are optional.**

# 5. Continuous Training for JP Patent Attorneys (2)

- **Head office and local branches of JPAA provide Continuous Training.**
- **Head office of JPAA also provides Continuous Training via e-learning (online learning) system:**
  - **available anywhere and anytime.**

# 5. Continuous Training for JP Patent Attorneys (3)

- **Kinki branch (incl. Osaka, Kyoto)- provides:**
  - **63 topics in fiscal 2016**
  - **incl. 6 on Asian IP (2 on CN, 4 on ASEAN), 7 on US, 8 on EP, 3 on DE, 1 on UK**

## 6. Voluntary Training

- **Many of Patent Attorneys voluntarily provide and take training.**
- **Ex. “Kansai Patent Study Group” consists of around a half of patent attorneys in Kinki area (around Osaka, Kyoto).**
  - **provides about 60 topics a year**
- **There are also small groups of patent attorneys for voluntary training throughout Japan.**
- **JP patent attorneys are studious.**

# 7. Voluntary Research Activities (1)

- **Head office and branches of JPAA have organizations for research activities.**
- **Patent attorneys voluntarily join the organizations, conduct research and provide the results to all patent attorneys.**
- **In relation to oversea IP issues, head office has “International Activity Center,”**  
**Kinki branch has “International Information Committee.”**

## 7. Voluntary Research Activities (2)

- **Ex. “International Activity Center” of head office has “Oversea Nations Information Section,”**
  - **divided into Asia-Oceania, US, and EP subsections.**
  - **consisting of about 70 members,**
  - **collecting IP-related information,**
  - **providing collected information to all member attorneys.**

# 7. Voluntary Research Activities (3)

- **Ex. “International Information Committee” of Kinki branch**
  - **dispatches delegates to one nation in South-Eastern Asia every year,**
  - **conducts interview with attorneys and governmental officials, collecting information on IP issues,**
  - **compiles a booklet,**
  - **distributes the booklet to branch member attorneys and businesses in the area.**

# 7. Research Activities (3)

## Booklets issued by Kinki branch

- (TH) (VN) (IN)





# 7. Research Activities (4)

## Booklets issued by Kinki branch

(ID)

(MY)

(SG)



## 8. Message

- **Quality is improved by users and IP offices working together in a cooperating manner.**
- **We hope IP offices listen to users' voices.**