
Topic 8:

Utilizing Claims of Granted Patents:

PPH and JPO Practices in Utilizing Granted Claims

Aug.2014

JAPAN PATENT OFFICE

- I. Background
- II. The Scheme of the PPH
- III. The Merit of the PPH
- IV. How to examine the PPH application

I. Background

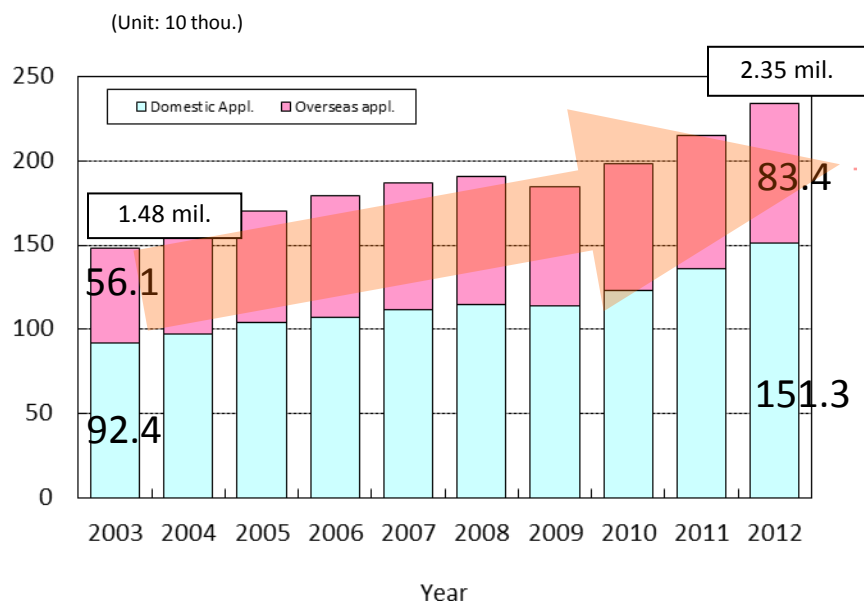
II. The Scheme of the PPH

III. The Merit of the PPH

IV. How to examine the PPH application

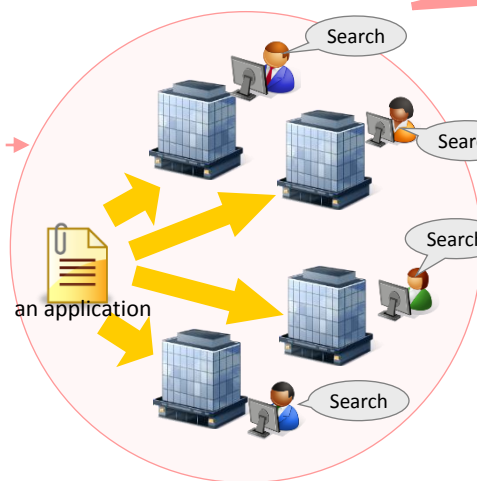
Growing Demand for Work Sharing

Changes in Patent Appl. Filed in the Whole World



Source: WIPO Industrial Property Statistics

The number of applications filed in many offices is increasing.

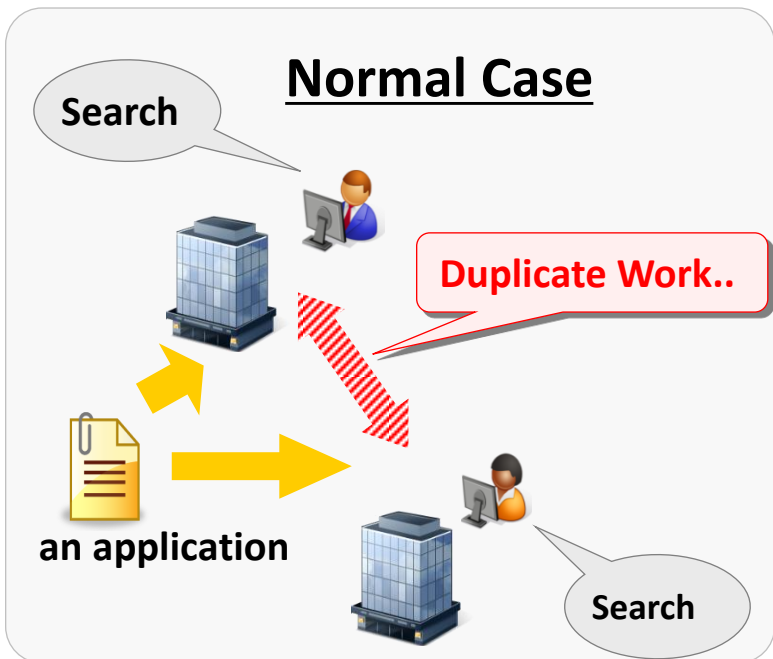


Increasing duplicate work!

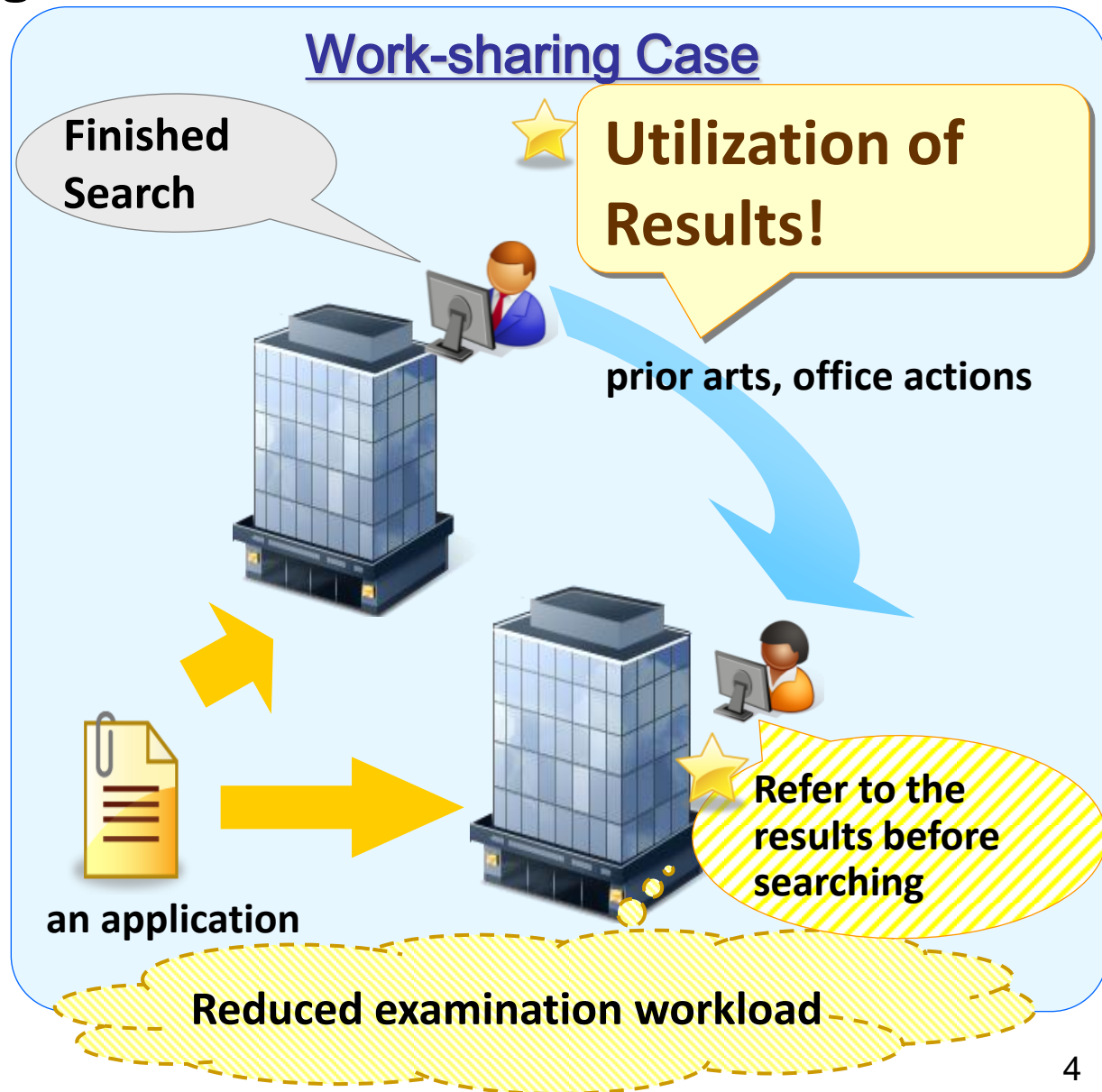
Growing Demand for Work Sharing

Efficiency of Work sharing

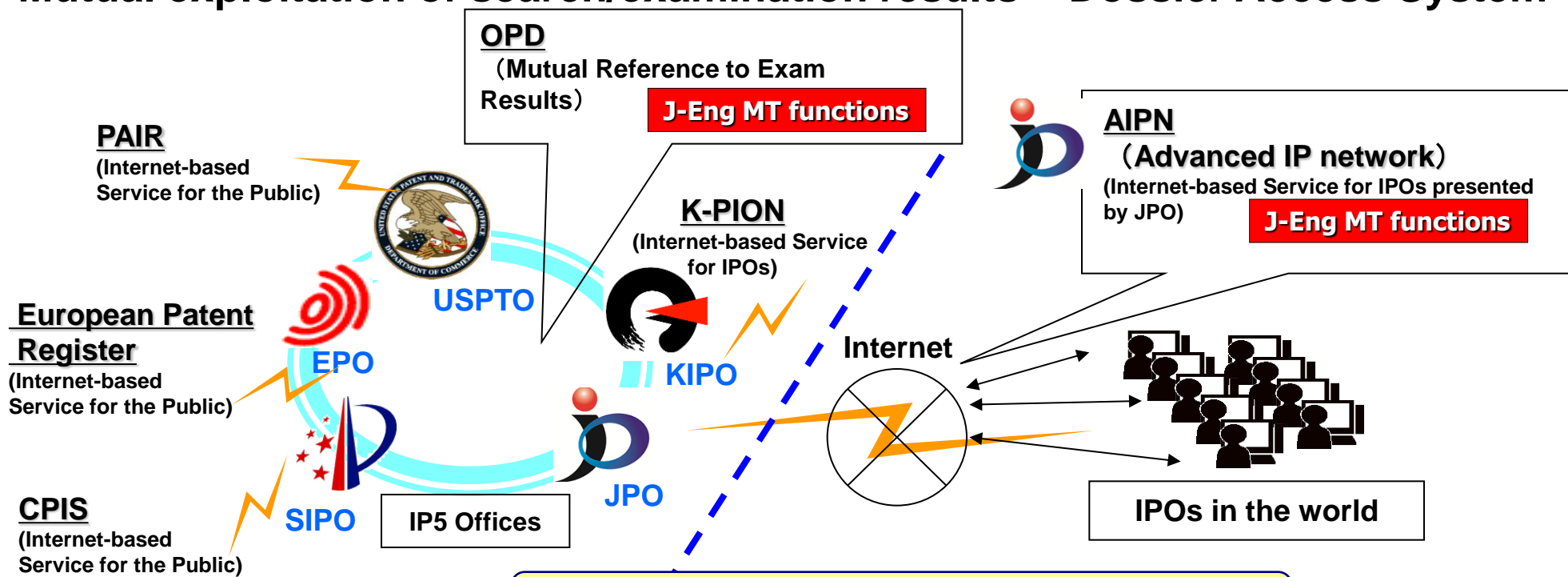
Normal Case



Work-sharing Case



Mutual exploitation of search/examination results - Dossier Access System-



- (1) Reduce workload in examination at IPOs
- (2) Obtain IP rights overseas quickly and properly

OPD(One Portal Dossier)

enable to mutually refer to results of search and examination in real time among IP5 Offices

Sharing results enables to reduce workload and to quicken examination

AIPN

(providing exam info via J-Eng MT)

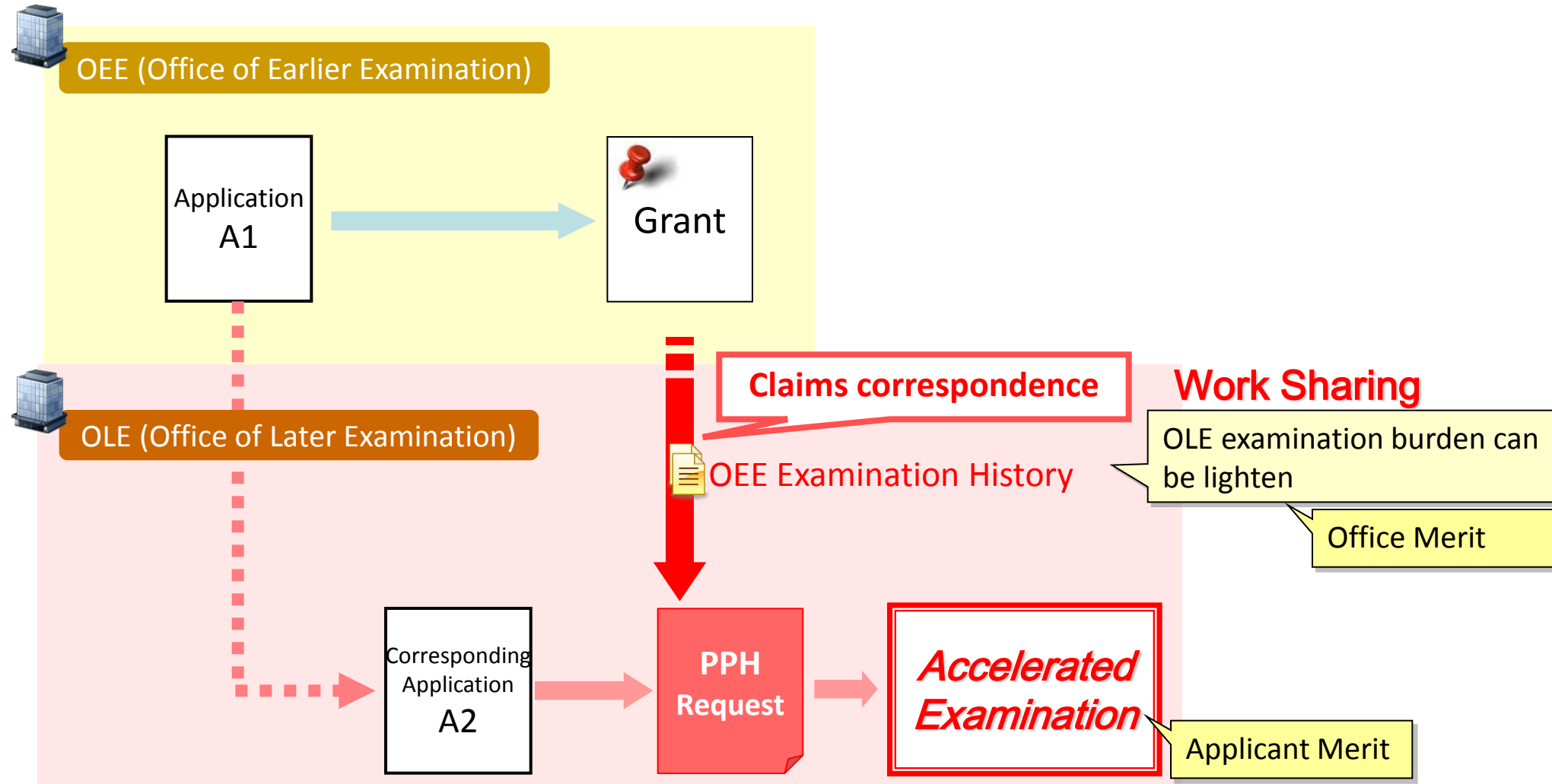
Quick release of examination results

International contribution to other countries

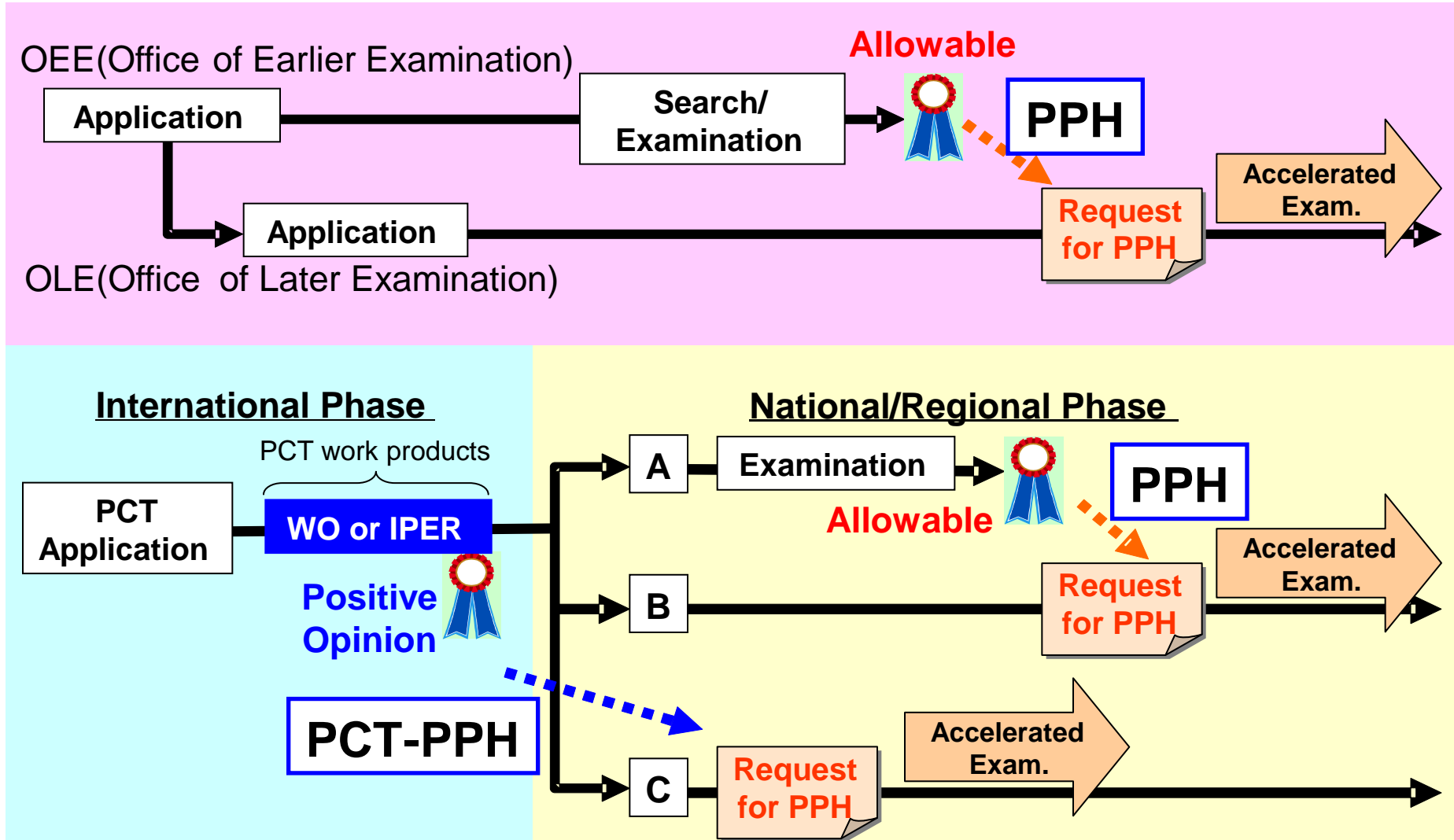
- I. Background
- II. **The Scheme of the PPH**
- III. The Merit of the PPH
- IV. How to examine the PPH application

The Scheme of the Patent Prosecution Highway

The **PPH** is a framework in which an application determined to be patentable in the Office of Earlier Examination (OEE) is eligible to have ***an accelerated examination*** in the Office of Later Examination (OLE) with a simple procedure upon an applicant's request.

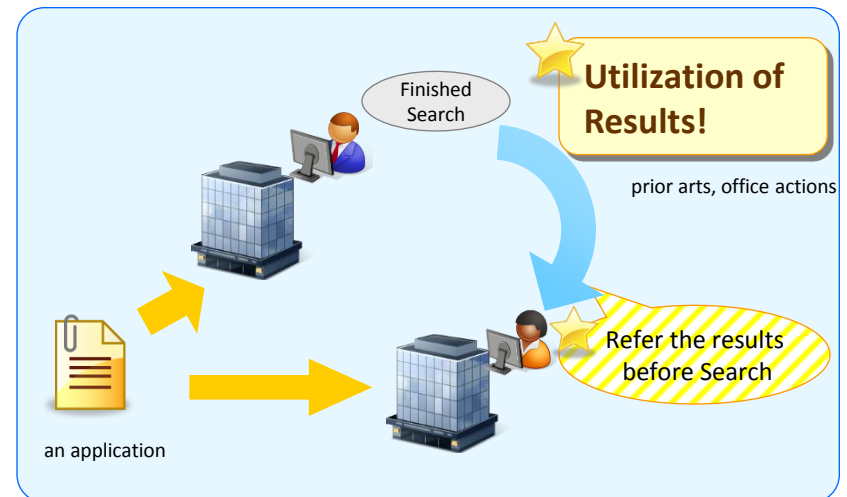
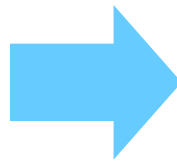
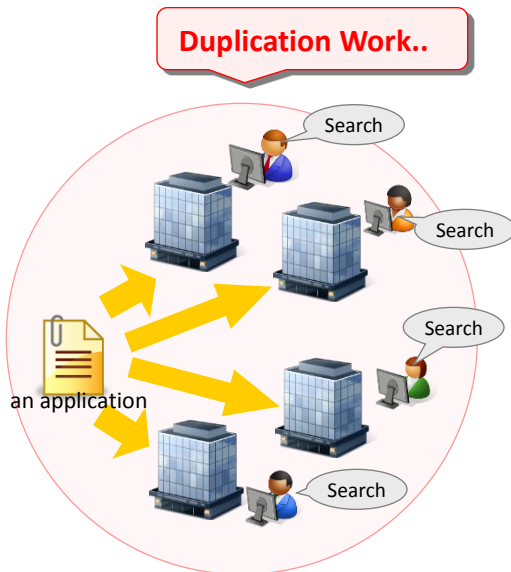


The Scheme of the Patent Prosecution Highway



- I. Background
- II. The Scheme of the PPH
- III. The Merit of the PPH**
- IV. How to examine the PPH application

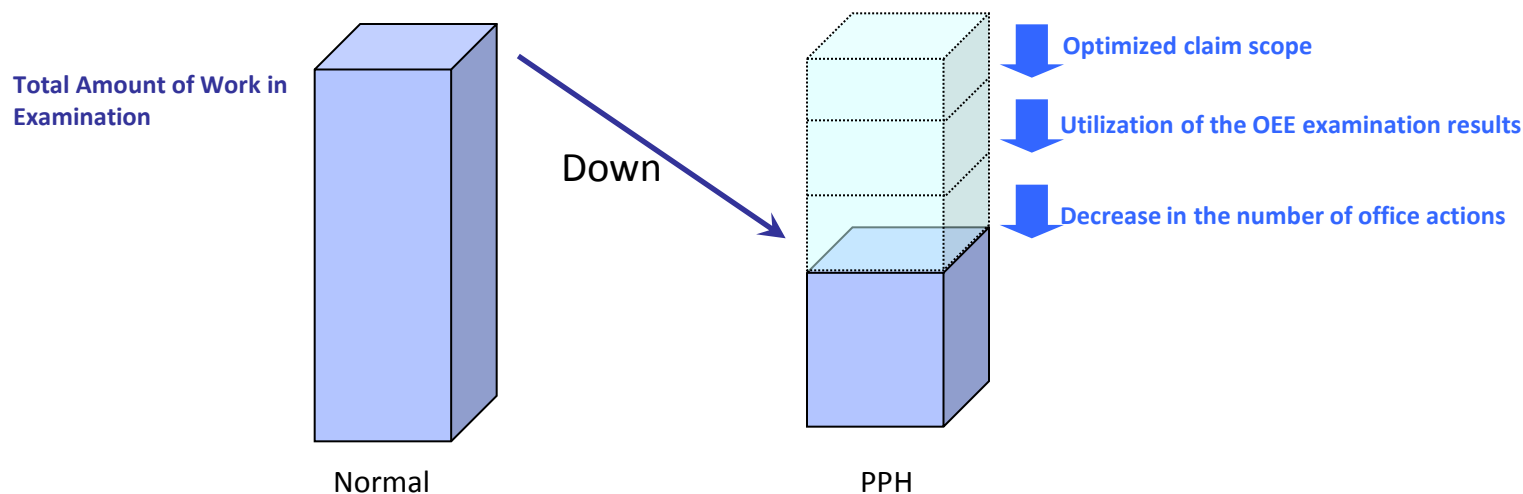
The Merit of the PPH for Patent Offices



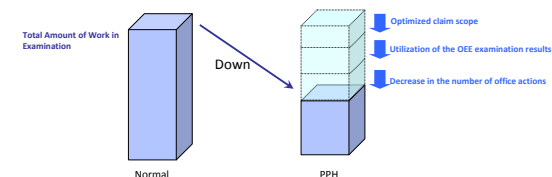
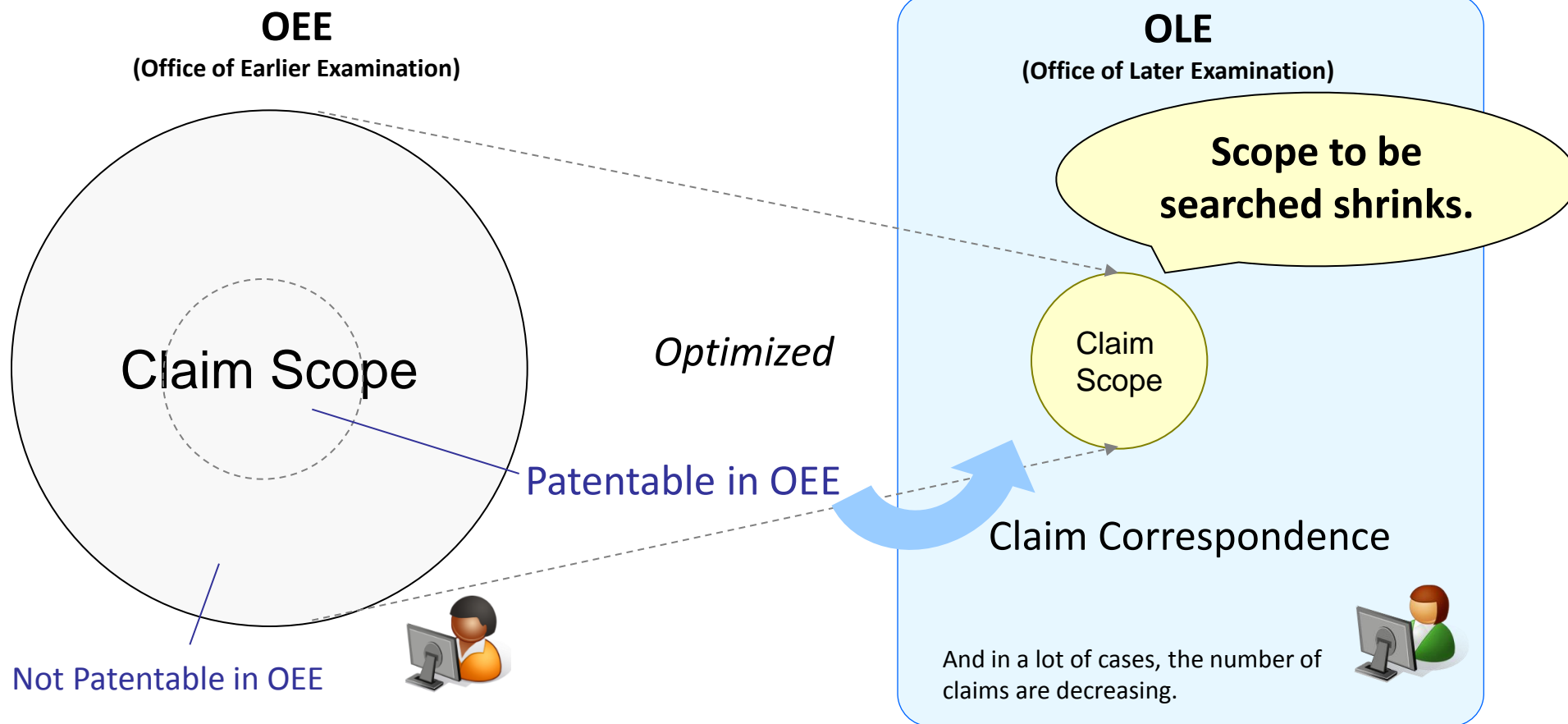


Easing Examination Burden

- A. Optimized claim scope
- B. Utilization of OEE search/examination history
- C. Decrease in the number of office actions



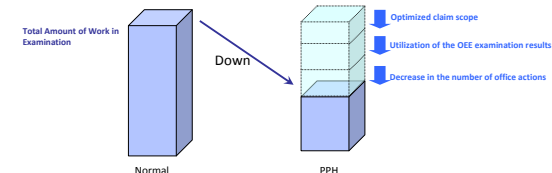
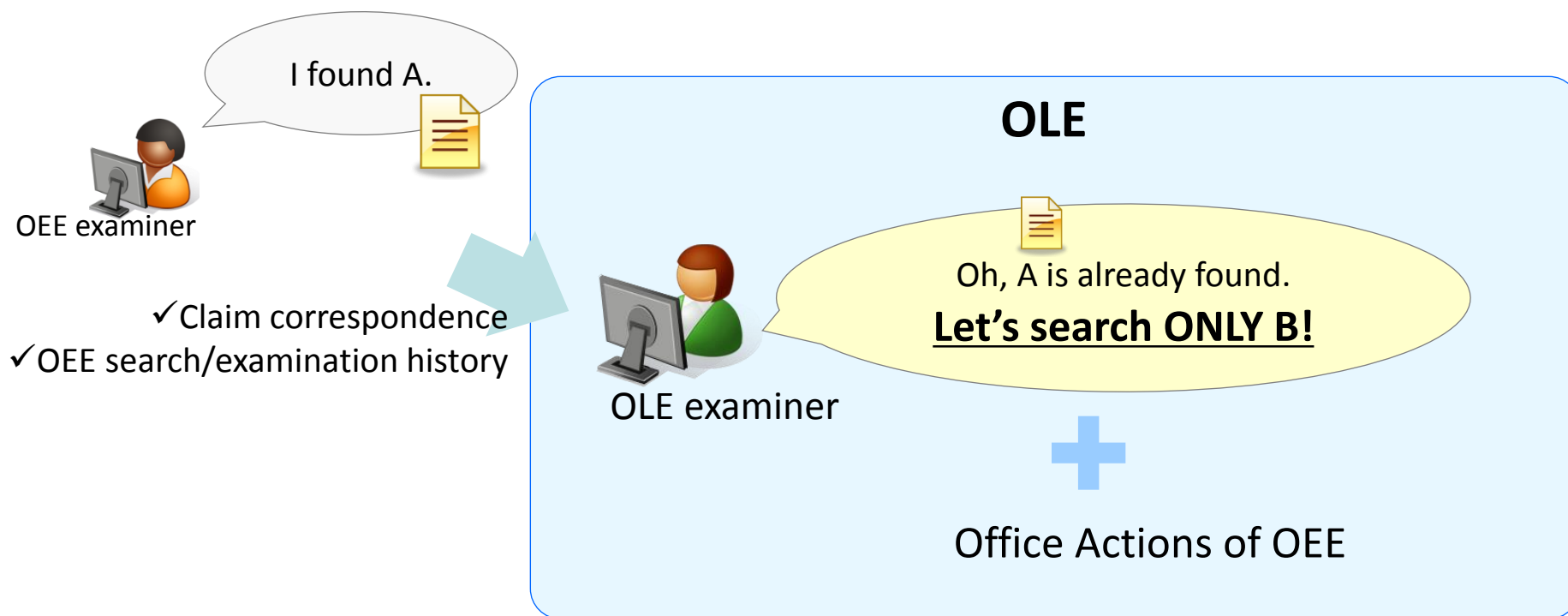
A. Optimized claim scope



B. Utilization of OEE search/examination history



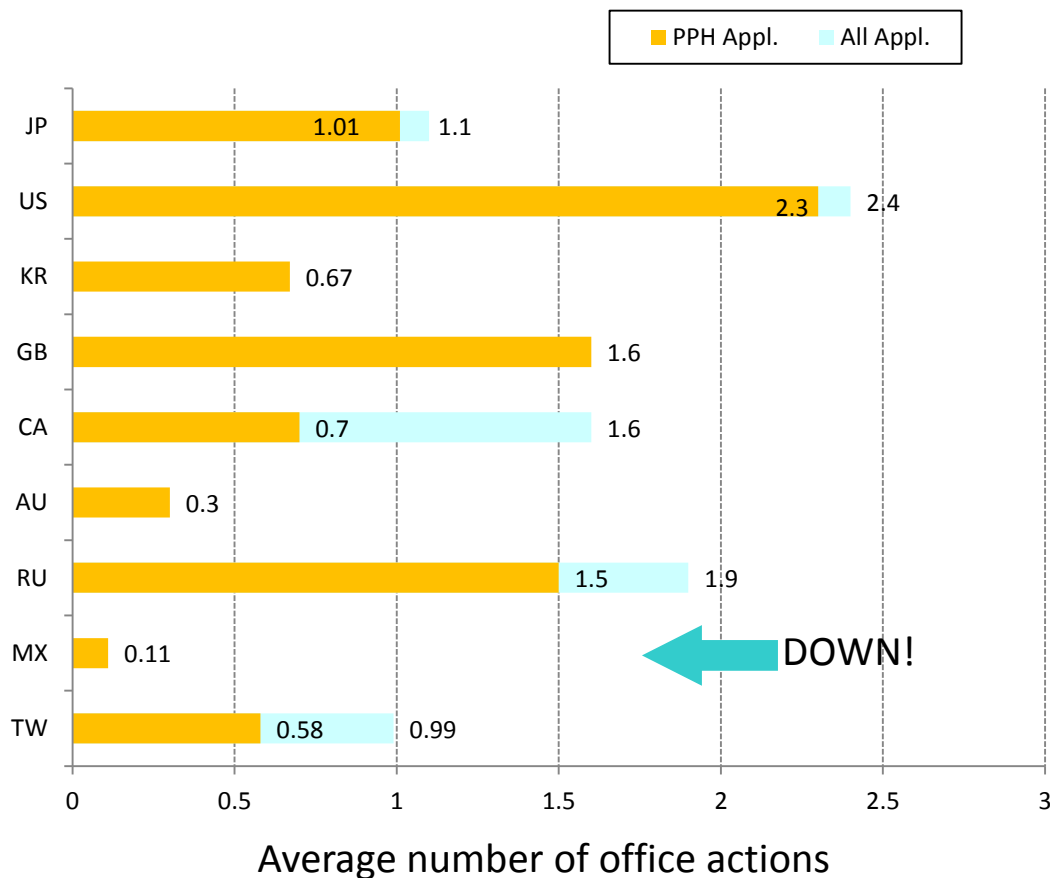
Example: Claims consists of parts A and B.





C. Decrease in the number of office actions

PPH - Average number of office actions

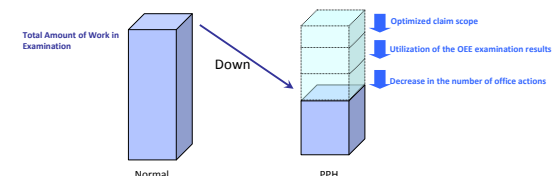


PPH applications tend to be efficiently judged in the OLE because OLE examiners can refer examination history of the OEE.

*US PPH Appl.: cumulative from July 2006-December 2011

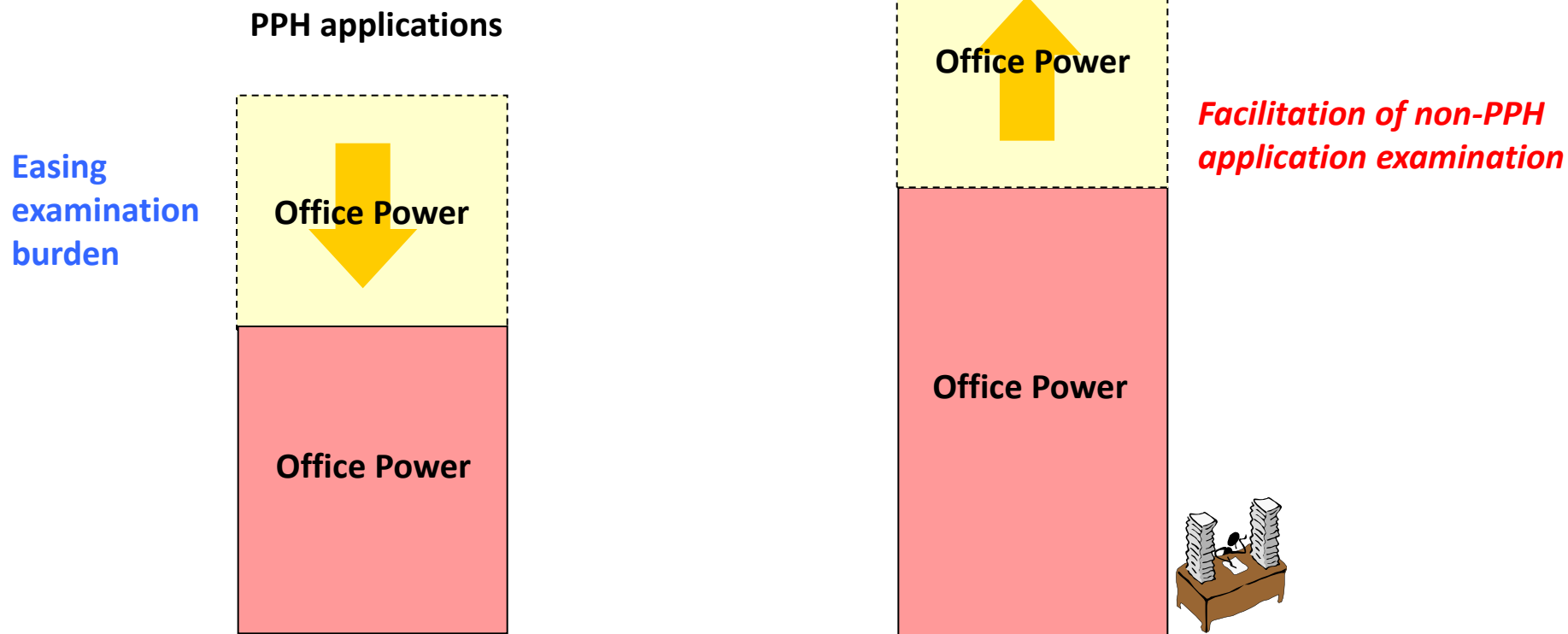
(PPH is NOT an agreement concerning substantive examination.)

Period: Jul-Dec 2013





Offices can facilitate all application examinations.



The Merit of Work Sharing for Applicants: High speed, Low cost, High predictability

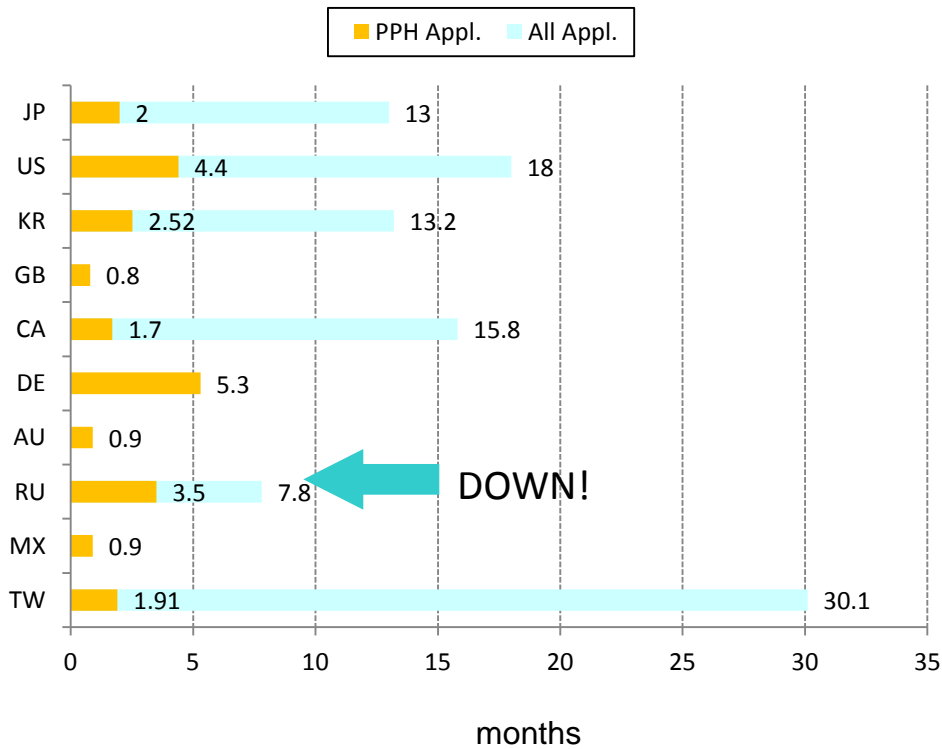


The Merit for Applicants

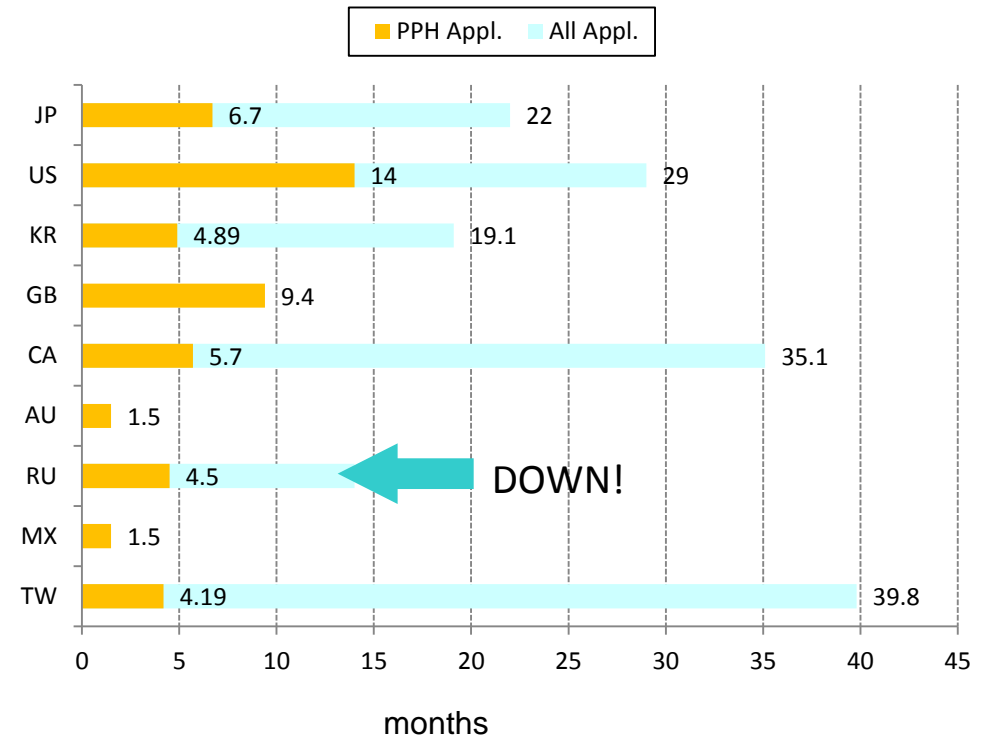
High Speed

Accelerated Examination

Average pendency from PPH or examination request to First Office Action



Average pendency from PPH or examination request to Final Decision



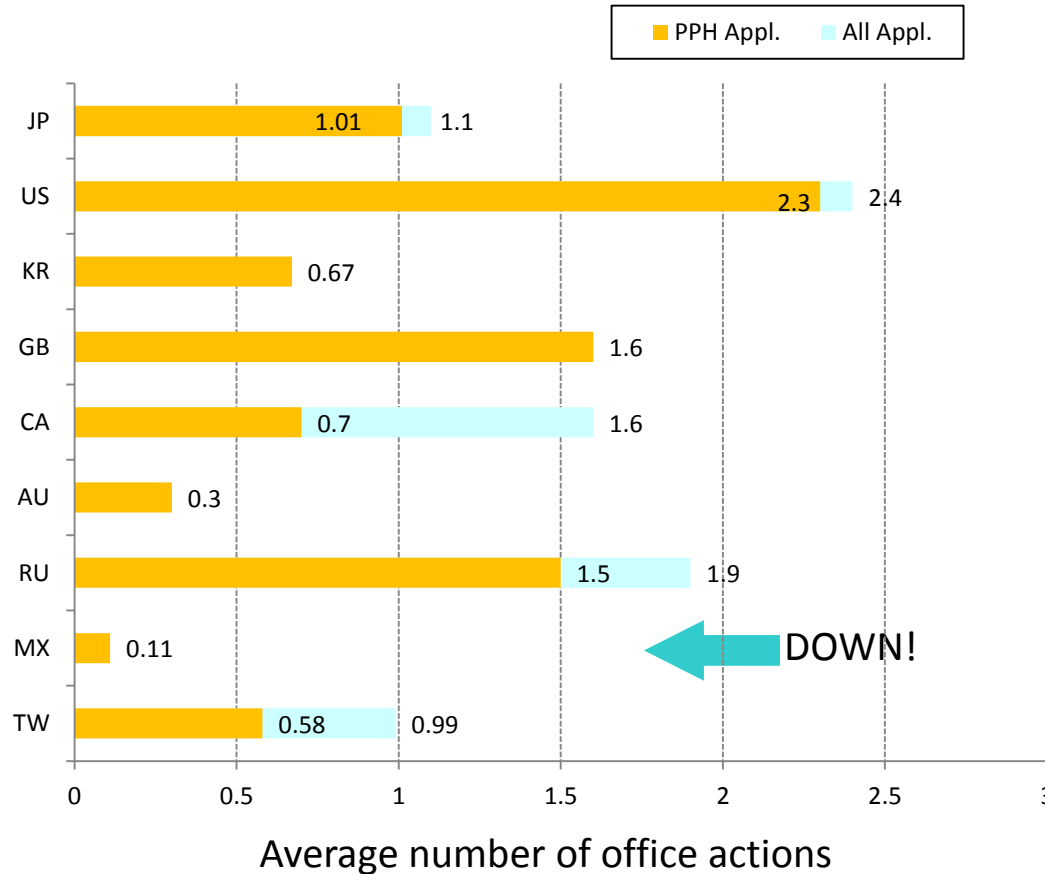
Period: Jul-Dec 2013



Low Cost

Decrease in the number of office actions

PPH - Average number of office actions



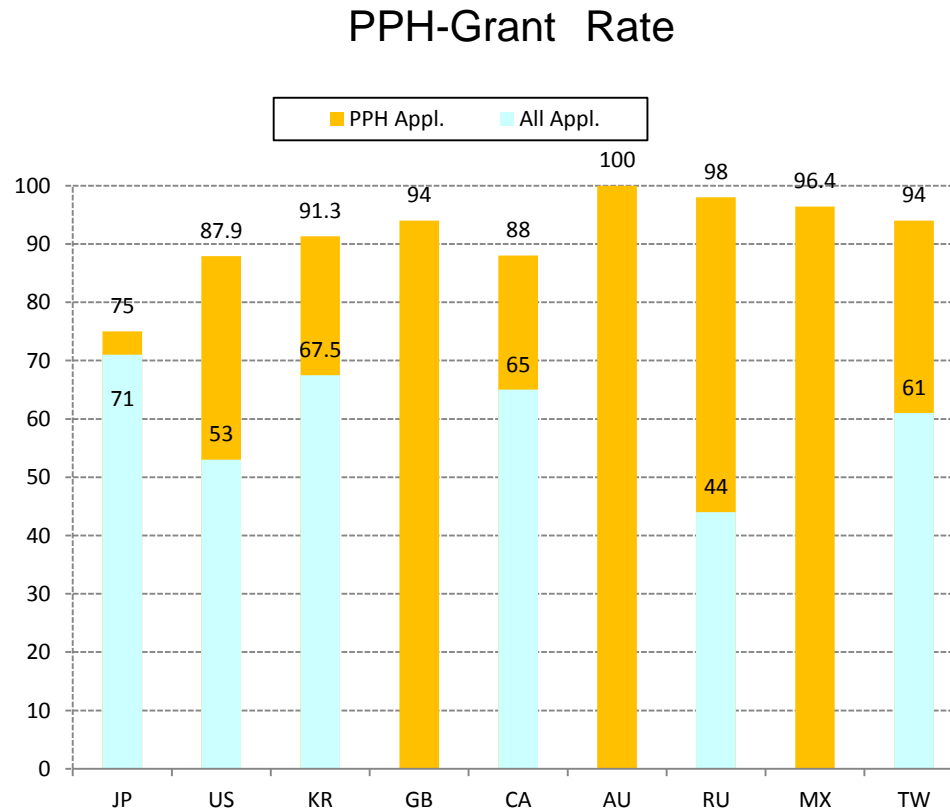
Decrease in the number of office actions reduces applicant *cost* (e.g. attorney and translation fee).

*US PPH Appl.: cumulative from July 2006-December 2011



High Predictability

Increase in Grant Rate



Period: Jul-Dec 2013



- PPH applications tend to be granted in the OLE because they were already judged to be patentable in the OEE.
- However, grant rates do not equal 100% because patent laws and practices differs in countries and regions and new prior arts are found by the OLE examiner due to difference of search DBs.

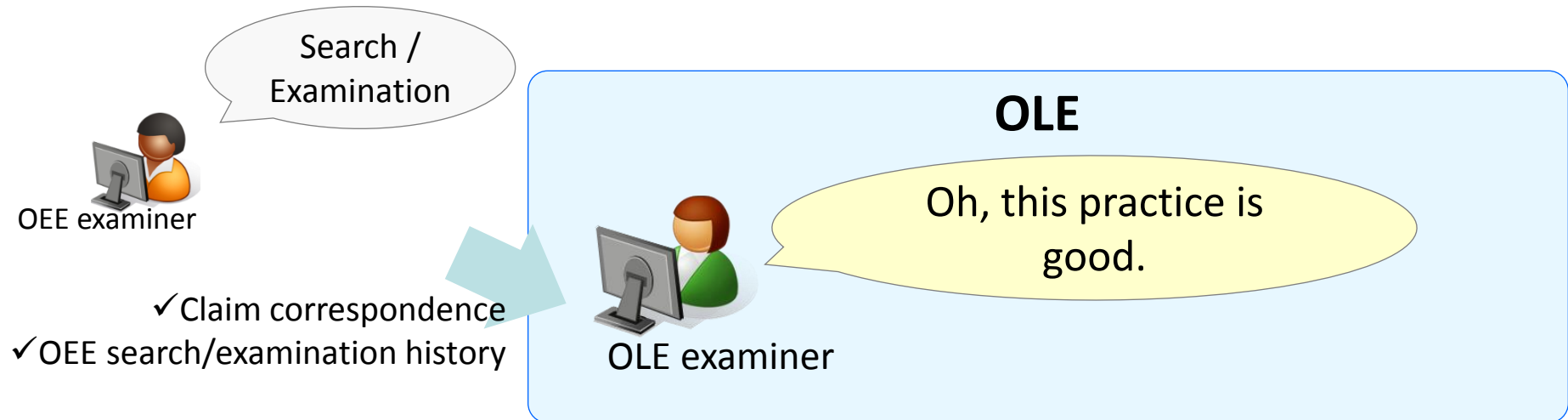


The Merit of the PPH for both Offices and Applicants : **Quality Improvement**

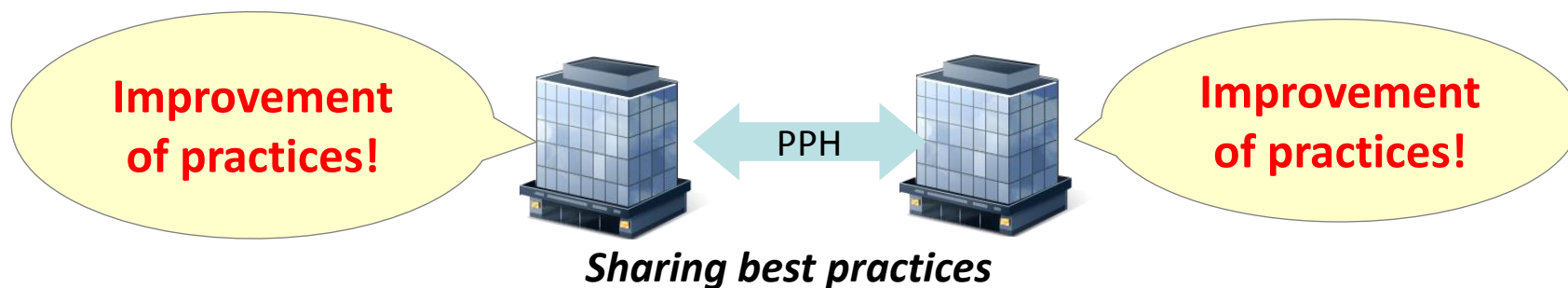


Quality Improvement

- ✓ In PPH scheme, the examination quality of the OLE is guaranteed for at least the OEE level.
- ✓ In addition, the OLE examiners can learn the OEE examination/search practices via submitted OAs and cited prior arts.
+ “Claim correspondence” makes understanding easy.



✓ In this sense, the PPH scheme is a sort of examiner exchange program.

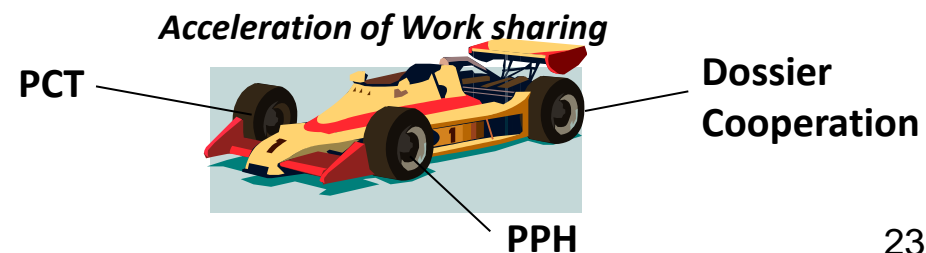


What are differences between PPH and other approaches?

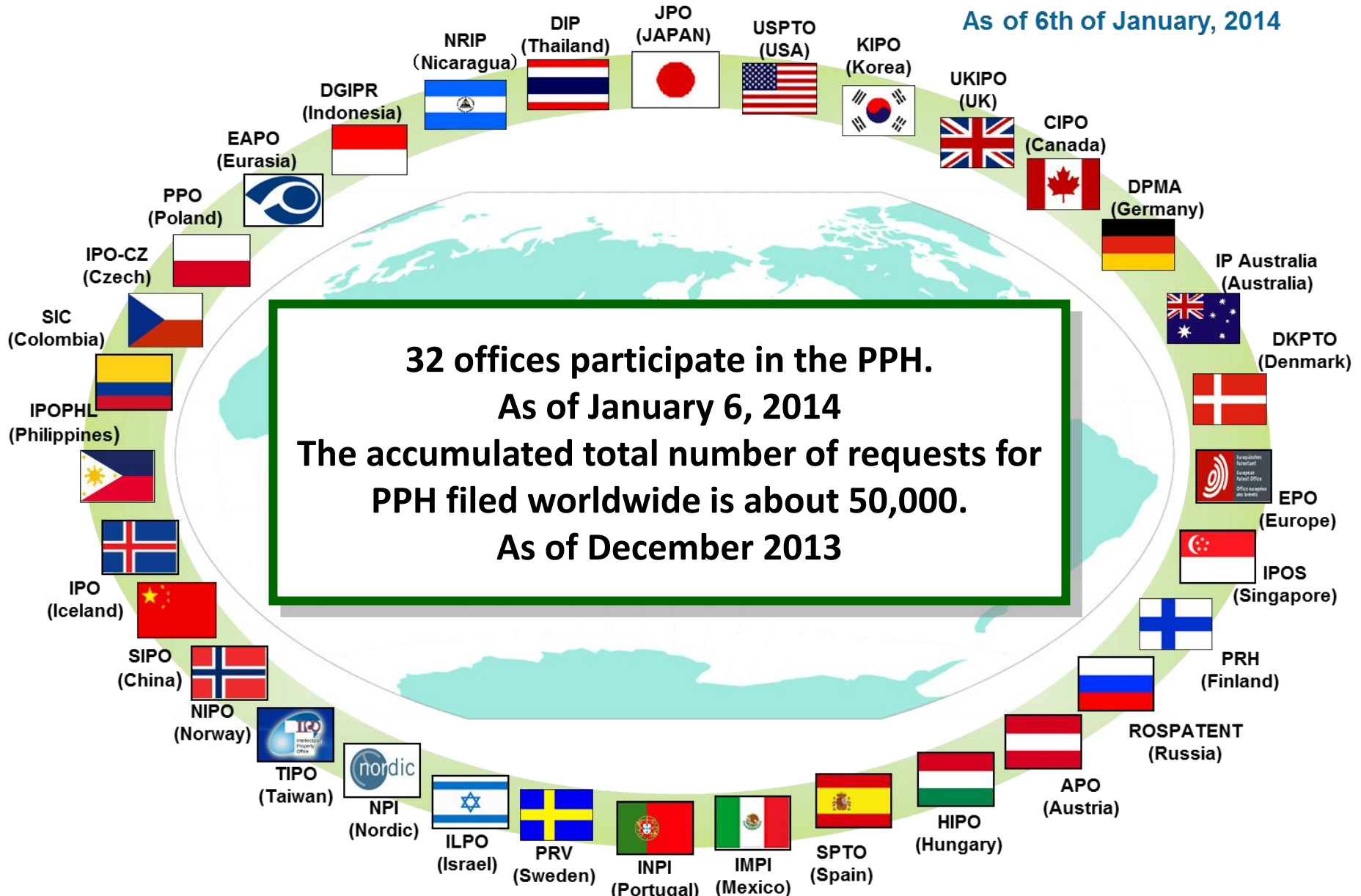


| | PCT | PPH | Dossier Cooperation (AIPN, European Patent Register, US Pair...) |
|-----------------------------------|-------------|-------------|---|
| Type | User driven | User driven | Offices cooperation |
| Referring to other office results | Yes | Yes | Yes |
| Claim correspondence obligation | No | Yes | No |
| Accelerated examination | No | Yes | No |

PPH has more **work sharing merits** than PCT and Dossier cooperation because PPH has **claims correspondence** obligation.



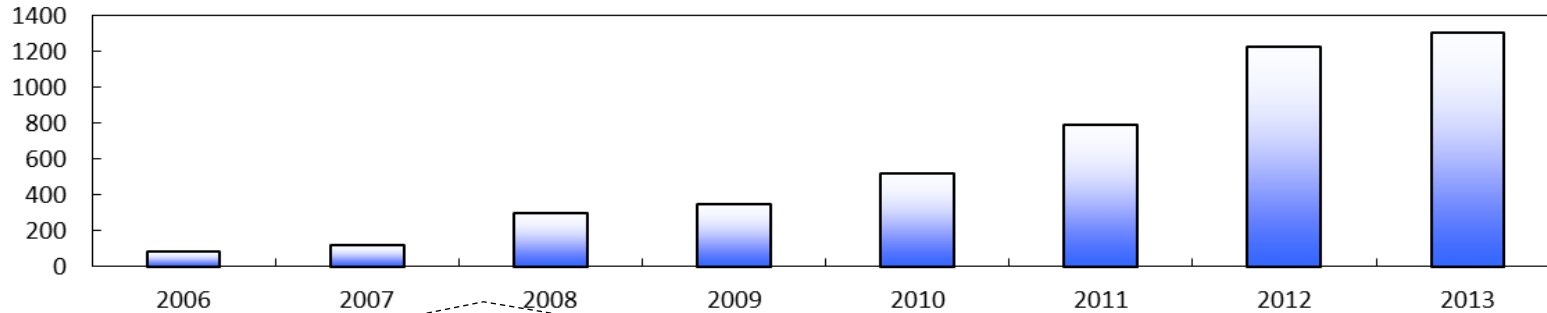
Expanding PPH Network



Number of PPH Requests (received by JPO)



(Except JPO-JPO PCT-PPH)



Breakdown

Bilateral PPH

| OEE | Number of PPH Requests | OEE | Number of PPH Requests |
|-----|------------------------|-----|------------------------|
| US | 2898 | ES | 0 |
| KR | 288 | MX | 0 |
| GB | 117 | PT | 0 |
| CA | 18 | IL | 0 |
| DE | 144 | TW | 3 |
| DK | 25 | NO | 1 |
| EP | 256 | CN | 23 |
| SG | 3 | IS | 0 |
| FI | 11 | PH | 0 |
| RU | 6 | PL | 1 |
| AT | 3 | EA | 0 |
| HU | 2 | ID | 0 |

PCT-PPH

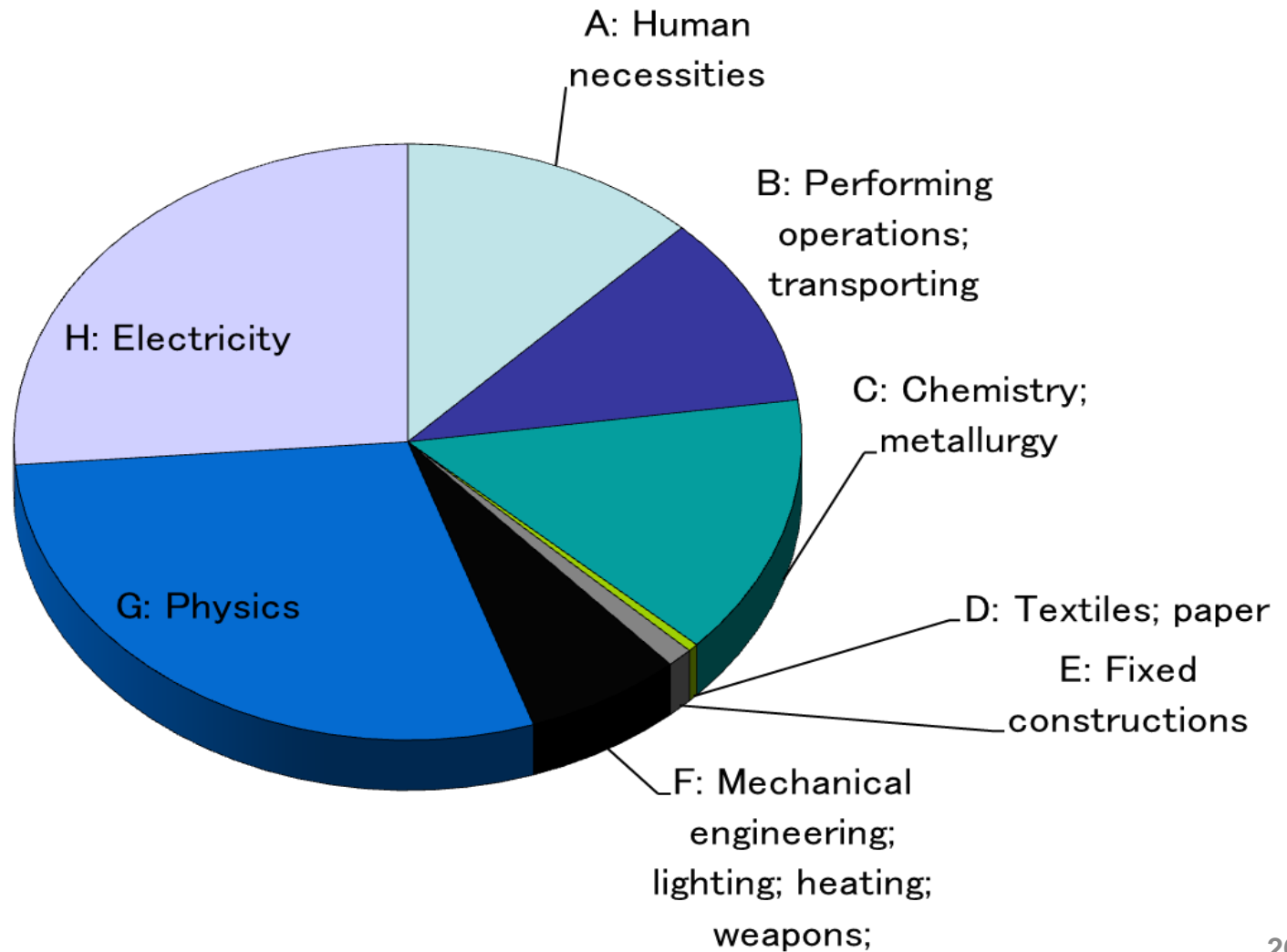
| OEE | Number of PPH Requests |
|-----|------------------------|
| US | 33 |
| EP | 748 |
| KR | 56 |
| FI | 2 |
| ES | 2 |
| SE | 23 |
| XN | 8 |
| CN | 48 |
| RU | 1 |
| IL | 1 |

JPO-JPO PCT-PPH: 2486

Number of PPH Requests by IPC Sections

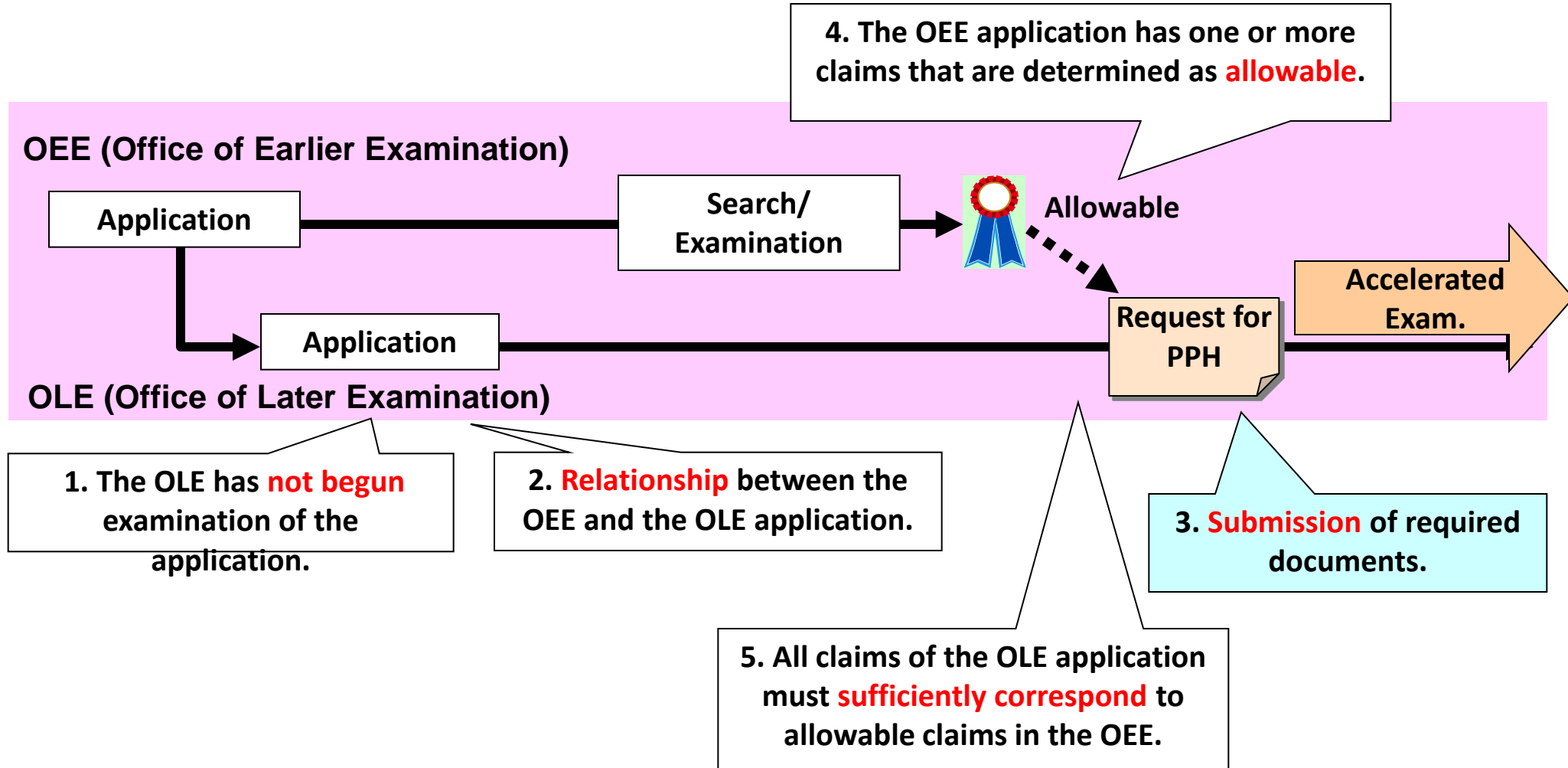


(Except JPO-JPO PCT-PPH)

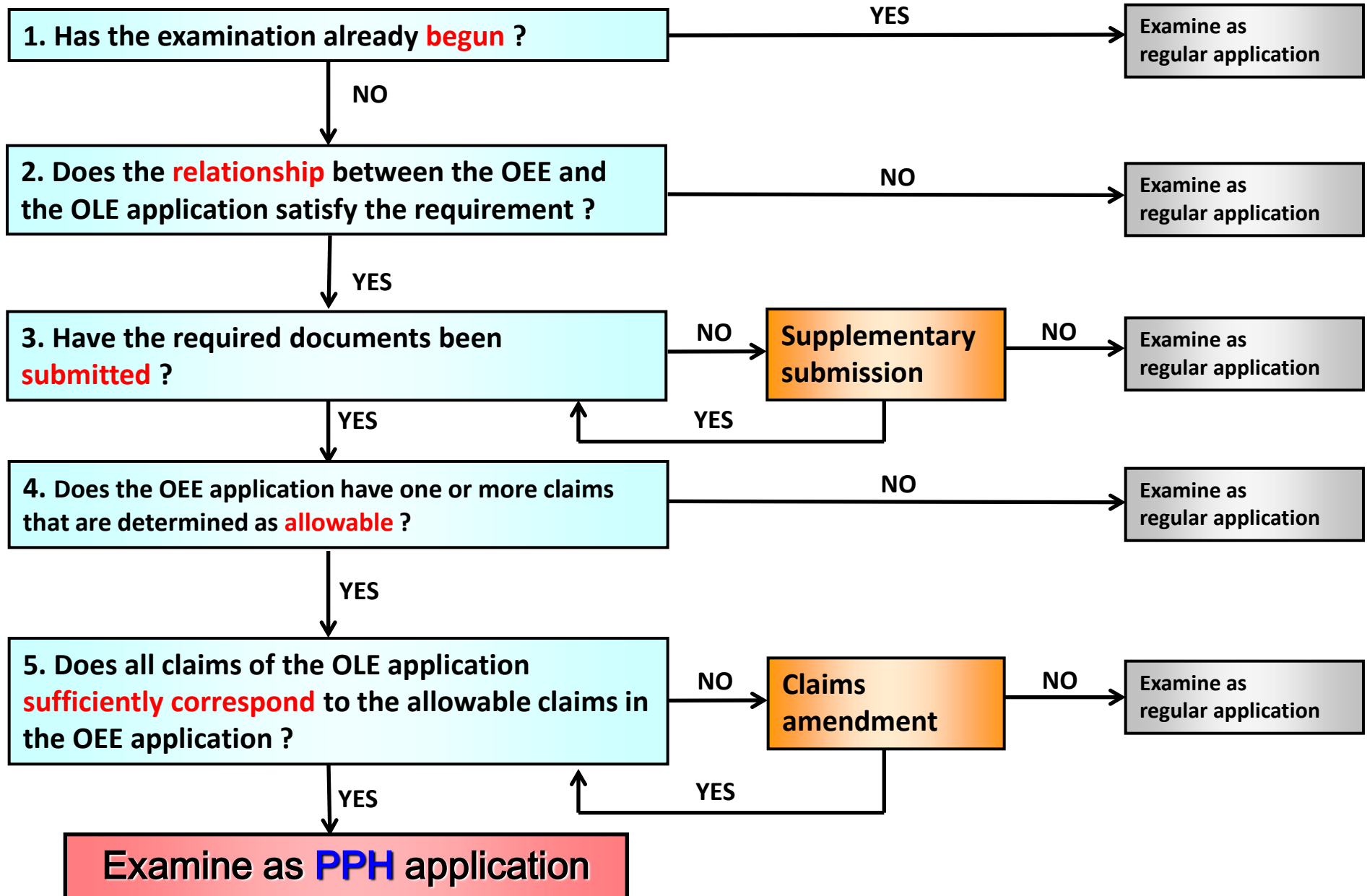


- I. Background
- II. The Scheme of the PPH
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- IV. How to examine the PPH application**

Requirements for PPH request



How to examine the PPH application



How to examine the PPH application

➤ Check whether all necessary information has been provided

PPH request form

Subject: Request for an accelerated examination under the PPH pilot program

Date of filing: **Date of filing PPH request**

Application number: **Application number of OLE application**

Title of the invention: _____

Applicant: _____

Corresponding JPO Application number: **Corresponding OEE application number**

Documents submitted:

Copies of all **office actions** (which are relevant to substantial examination for patentability in the JPO) which were issued for the corresponding application by the JPO

and

translations of them

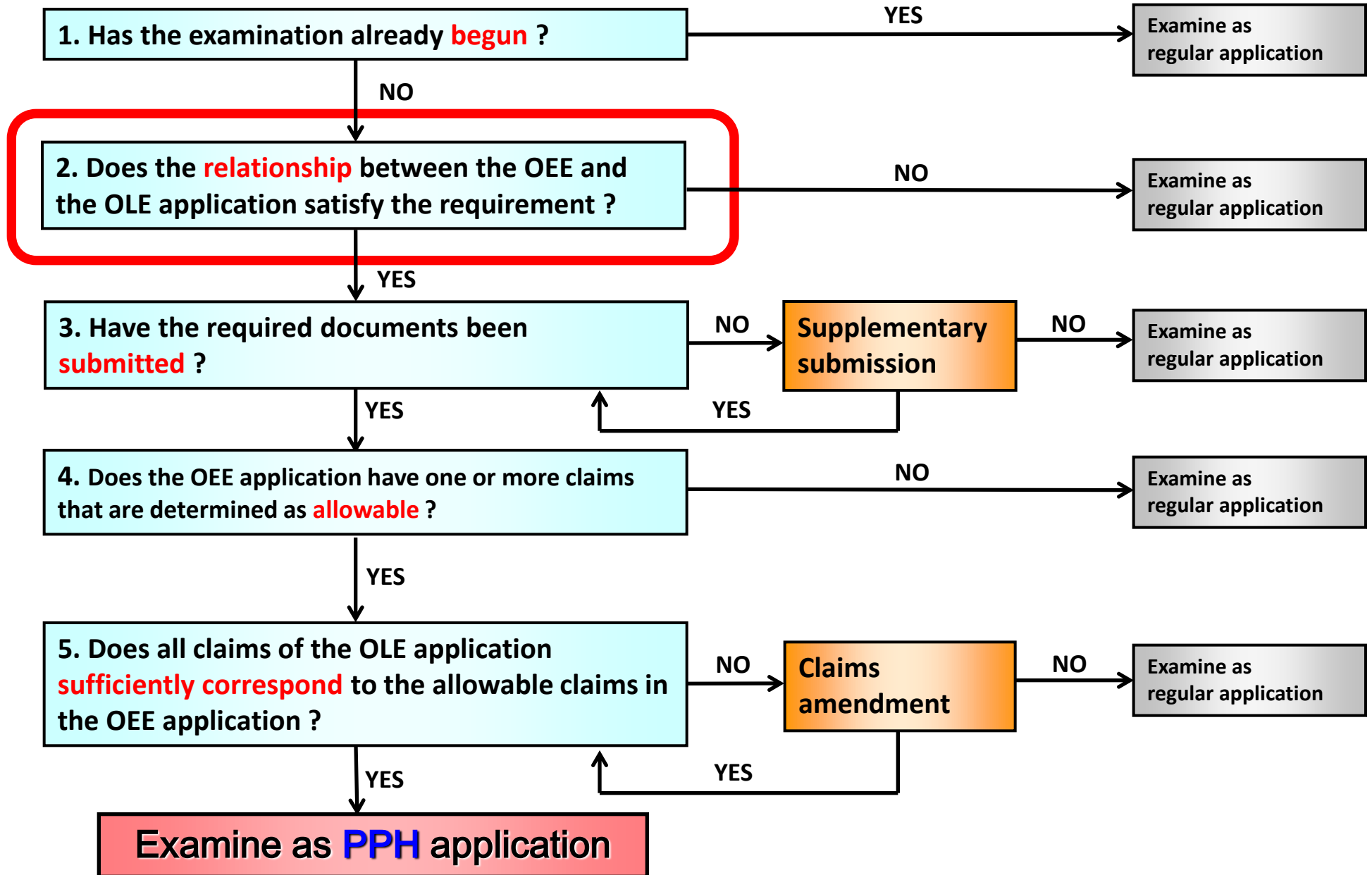
Copies of all **claims** determined to be patentable/allowable by the JPO and

translations of them

Copies of **references** cited by the JPO examiner

Claim correspondence table

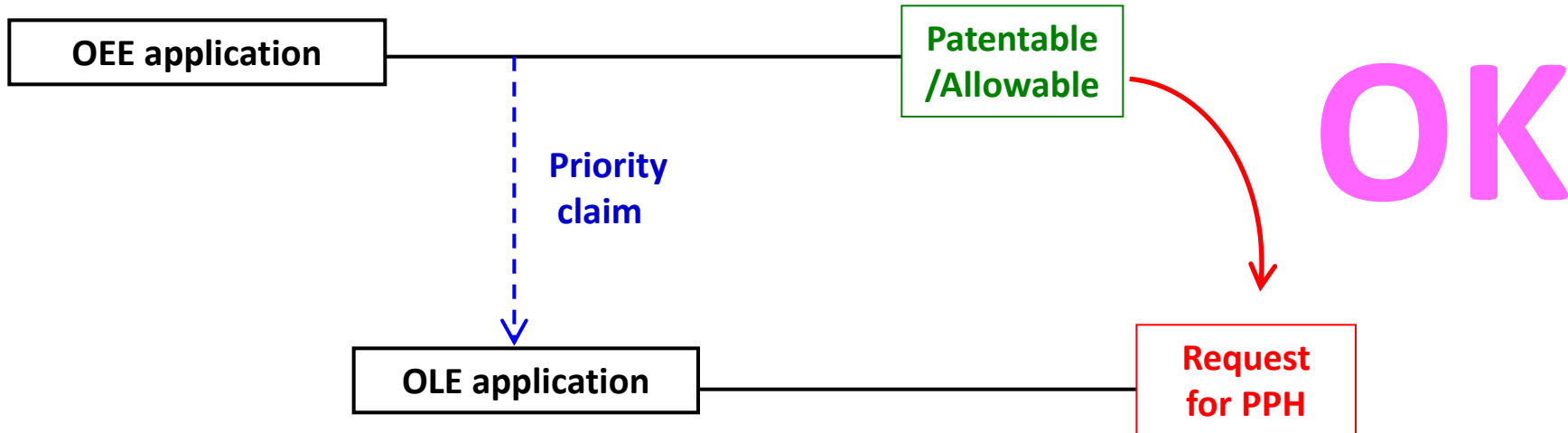
How to examine the PPH application



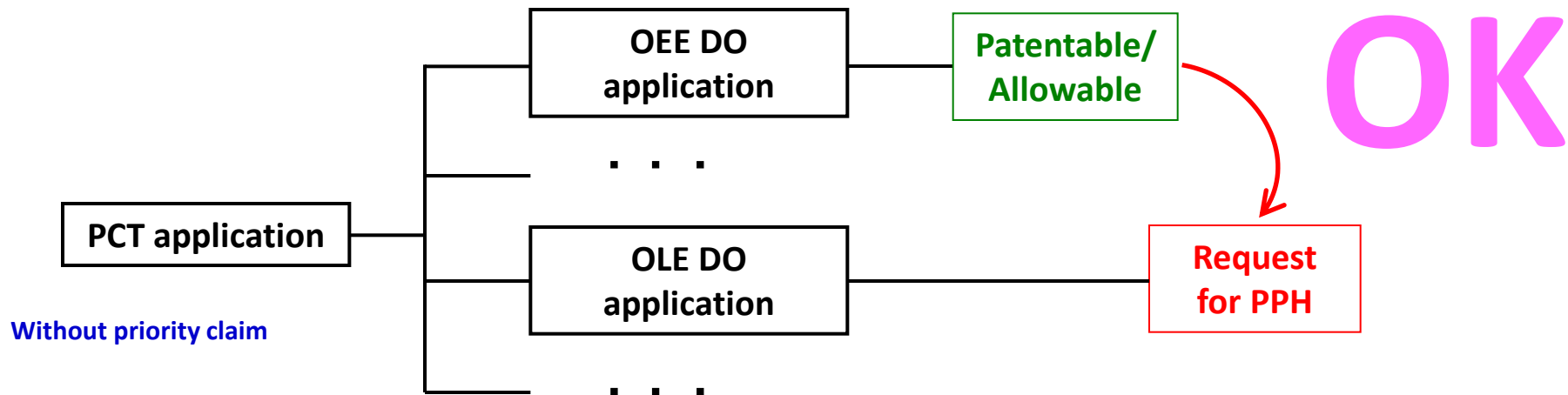
Relationship between the OEE and the OLE application

- **The OLE application should be in a particular relationship with the OEE application.**
- **Generally, the particular relationship is as follows.
(see next slide)**
- **The OLE application is:**

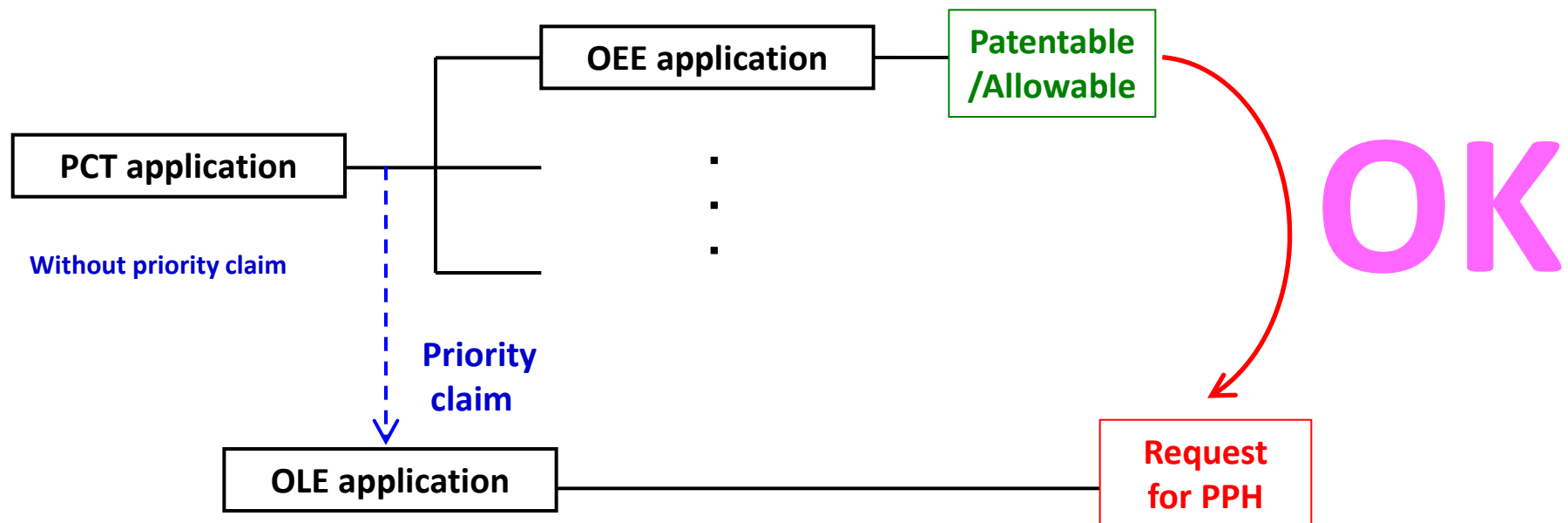
(1) an application which validly claims priority under the Paris Convention to the corresponding OEE application,



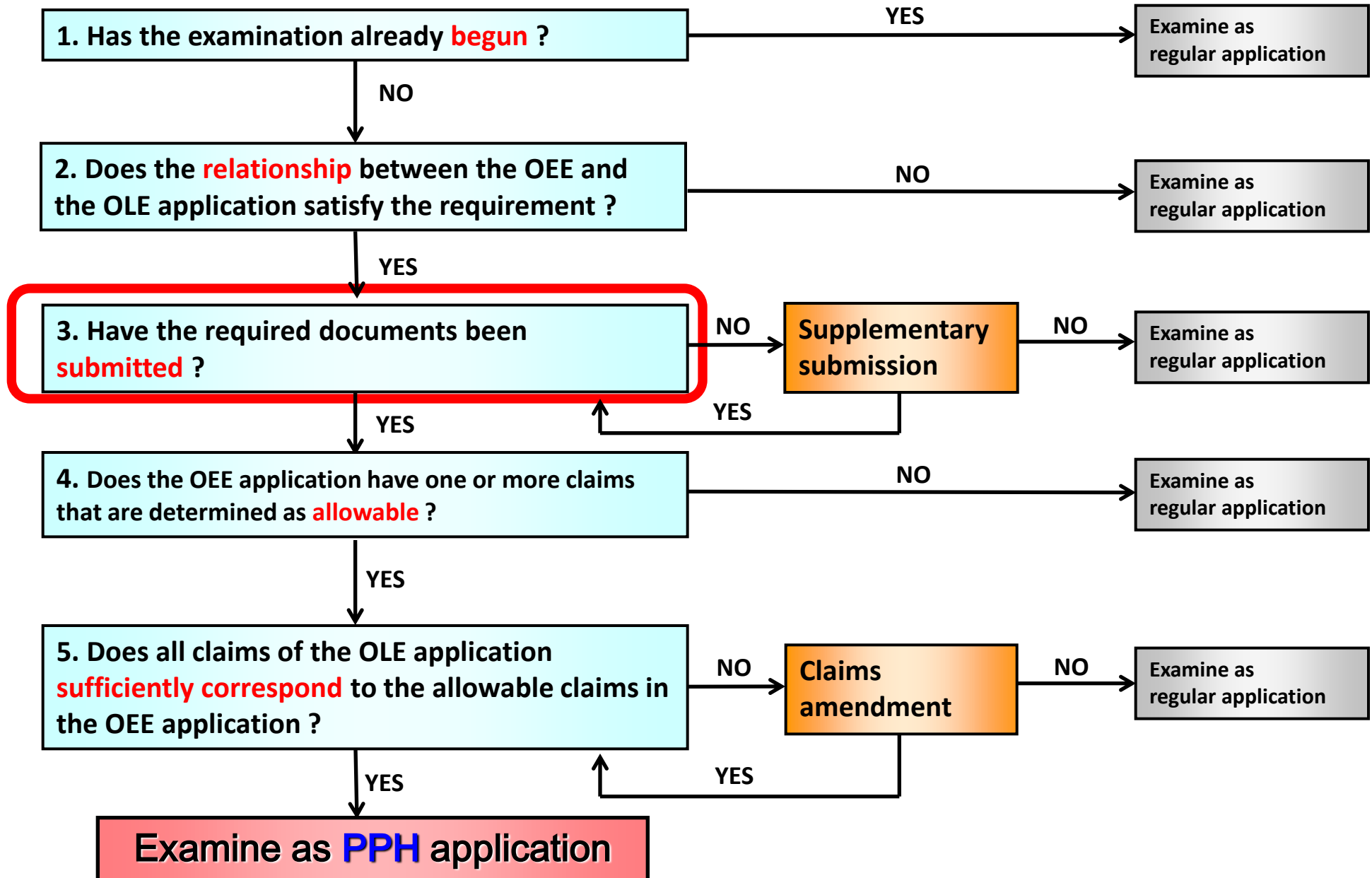
(2) a PCT national phase application without priority claim (direct PCT application),



(3)an application which validly claims priority under the Paris Convention to the PCT application(s) without priority claim.



How to examine the PPH application



Required documents

(1) A copy of all claims determined to be allowable by the OEE, and its translation.

*The applicant does not have to submit the copy if it is available via the dossier access system.

(2) Copies of all office actions of the OEE, and their translations.

*The applicant does not have to submit copies if they are available via the dossier access system.

Required documents

(3) Documents cited by the OEE examiner.

- If a cited document is a patent document, the applicant does not have to submit them.

(4) A claims correspondence table

| The claim filed to the OLE | The claim determined to be allowable in the OEE | Comments about the correspondence |
|-----------------------------------|--|--|
| 1 | 1 | Both claims are the same. |
| 2 | 2 | Both claims are the same except the claim format. |
| 3 | 1 | Claim 3 in the OLE application adds composition A to claim 1 filed at the OEE. |



**A copy of all claims
and its translation**



**Copies of all OEE
office actions and
their translations**

**No need to submit these
documents, if they are
available via the OEE's
dossier access system.**



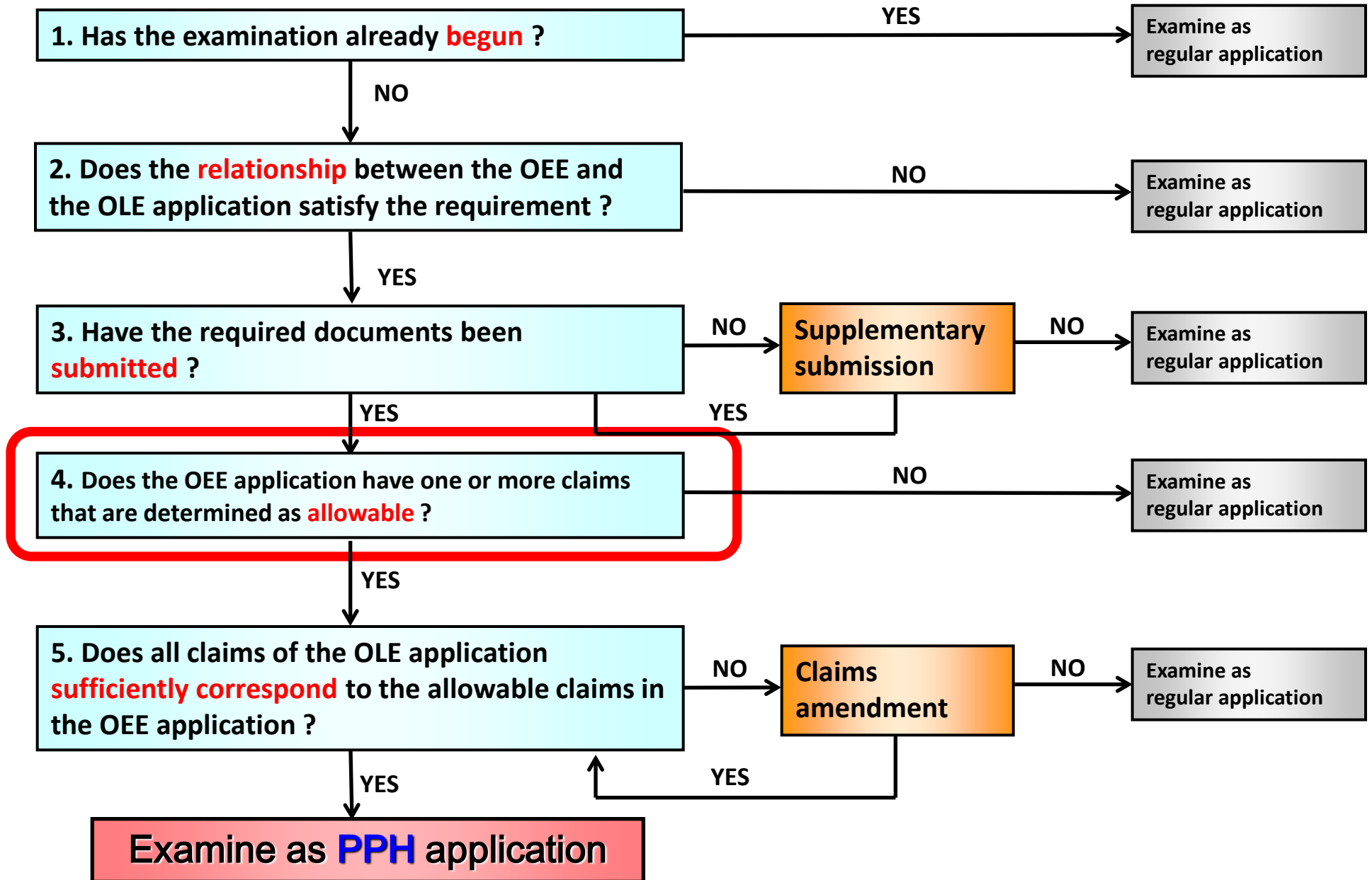
**Copies of
references**



**Claim correspondence
table**

**No need to submit the
copies of references, if they
are patent document.**

How to examine the PPH application



Determined as patentable/allowable

- At least one corresponding application must exist in the OEE and must have one or more claims that are determined to be **patentable/allowable** in the latest office action by the OEE.
- ✓ Claims that are determined to be patentable/allowable in the latest office action by the OEE are indicated in the Claims correspondence table.

| The claim filed to the OLE | The claim determined to be allowable in the OEE | Comments about the correspondence |
|----------------------------|---|--|
| 1 | 1 | Both claims are the same. |
| 2 | 2 | Both claims are the same except the claim format. |
| 3 | 1 | Claim 3 in the OLE application adds composition A to claim 1 filed at the OEE. |

Determined as patentable/allowable

- The office action should not always have to be the “Decision to grant a patent” . For example, the office action of the JPO includes:

- (1) Decision to grant a patent
- (2) Notification of reason for refusal

If the following standard expression is described in the “Notification of reason for refusal”, those claims are clearly identified to be allowable/ patentable:

“At present for invention concerning Claim _ , no reason for refusal is found.”

- (3) Decision of refusal
- (4) Appeal decision

(1) Decision to Grant a Patent

Decision to Grant a Patent

Bibliographic data

Application number: The application for patent **2005-090000**

Date of Drafting: Heisei 20(2008) October 15

Patent examiner: **Tokkyo, Taro**

Title of invention: An information processing method, a computer program, and an information processor

The number of claims: 5

Applicant: **AAA** LIMITED

Representative: **DAIRI, Nin**

About this application, since no reason for refusal is found, Decision to Grant a Patent is rendered.

(2) Notification of Reasons for Refusal

Notification of Reasons for Refusal

Bibliographic data

Application number: The application for patent **2008-203000**

Date of Drafting: Heisei 20(2008) December 19

Patent examiner: **Tokkyo, Taro**

Representative/Applicant:

Applied Provisions: Patent Law Section 29(2)

Conclusion / Time Limit of Response

This application should refuse for the following Reason. If there is an opinion about this, please submit Written Argument within **60 days** after a day of dispatch of this notice.

Time Limit of Response

Reason

The claimed invention(s) in the each claim listed below of this patent application should not be granted a patent under the provision of Patent Law **Section 29 (2)** for the reason that the claimed invention(s) could have easily been made by persons who have common knowledge in the technical field to which the claimed invention(s) pertains, on the basis of the invention(s) described in the distributed publication(s) listed below in Japan or other foreign countries prior to the filing of the patent application.

Article 29(2)
Non-Inventive Step

(2) Notification of Reasons for Refusal

Account

Account

(Please refer to "The list of cited documents etc." for cited documents etc.)

- Claim: 4
- Cited documents 1 and 2
- Remarks:

[Cited documents 1 (refer to [0040]-[0048] and [0051])] Picture image data is inputted from a video camera, characteristic quantity of each frame of inputted picture image data is computed, characteristic quantity of each frame and characteristic quantity of a previous frame are measured, and storing a video section of a frame group which fulfills predetermined conditions as a dynamic image file is indicated.

[Cited documents 2 (refer to [0013]-[0015])] A picture picturized with a television camera etc. is inputted, an inputted picture is memorized, characteristic quantity is extracted from an object in a picture, extracted characteristic quantity is memorized and matching an object of a previous frame and a present frame with characteristic quantity of an object of each frame is indicated.

<Claim(s) which has been found no reason for refusal>
At present for an invention concerning **Claims 1-3**, no reason for refusal is found. Any subsequently identified reasons for rejection will be notified accordingly.

Cited Parts

Contents of Document 1

Contents of Document 2

Allowable claims

(2) Notification of Reasons for Refusal

List of Cited Documents

The list of cited documents etc.

1. JP,H6-266774,A
2. JP,H8-315150,A

Documents of category "X" or "Y"

Record of the Result of Prior Art Search

A Record of the result of prior art search

- Technical fields to be searched
IPC G06F17/30H04N 5/765/80-5/9079/04-9/11
DB name JSTPlus (JDream2)
- Prior art documents

- JP,H9-44639,A
- JP,H7-46517,A

Documents of category "A"

(3) Decision of Refusal

Decision of Refusal

Bibliographic data

Application number: 2005-090000

Date of Drafting: Heisei 20(2008) November

Patent examiner: Tokkyo, Taro

Title of invention: Peripheral processing unit which realizes a disposal method of a recognition impossible character, and a disposal method for the same

Applicant: AAA

Representative: DAIRI, Nin (besides one person)

Conclusion

About this application, it should refuse by the [Reason 3] written in the Notification of Reasons for Refusal as of Heisei 20(2008) June 6.

Although the contents of Written Argument and the Written Amendment were examined, the antecedent basis which is sufficient for reversing reasons for refusal cannot be found out.

(3) Decision of Refusal

Account

Remarks

Examiner's Opinion

Cited Parts

[however the constitution (refer to [0020] and [0027]) of the invention indicated to cited document 1 which it supposes "it is an abnormal condition when a recognition result is with / of three or more characters / a reject"] It corresponds with the constitution of the invention concerning Claim 1 of an application concerned judged as "There are more predetermined signs after the end of character reading and recognition operation than a predetermined number", [what an abnormal termination step is performed for in the case of an abnormal condition (error)] Considering it as the invention which has composition which performs an abnormal termination step when there are more predetermined signs than a predetermined number, and relates to Claim 1 of an application concerned after the end of character reading and recognition operation is that the person skilled in the art could accomplish easily. About the invention concerning the Claims 2-10 of an application concerned as well as above-mentioned Claim 1, a person skilled in the art can invent easily.

Rejected Claims

When "For invention concerning the claims ○-△, no reason for refusal is found" is written clearly, the claims ○-△ are allowable.

(3) Decision of Refusal

List of Cited Documents

The list of cited documents etc.

1. JP,H6-15149,U
2. JP,H7-296102,A

Documents of category "X" or "Y"

Time Limit of Response

Time Limit of Response

When this final decision has an appeal, a Commissioner of the Patent Office can be asked for a referee within **30 days** after a day with delivery of the copy of this final decision (if a resident abroad has, it is less than **90 days**) (Patent Law Article 121(1)). (Instruction based on Administrative Case Litigation Law Article 46(2))

To this final decision, a revocation suit can be raised only to the trial decision to the demand for trial about this final decision (Patent Law Article 178(6)).

(4) Appeal Decision

Appeal decision

Bibliographic data

Appeal 2006-090000

Appeal number

3-4-3, Kasumigaseki, Chiyoda-ku, Tokyo

AAA LIMITED

Application number

A trial decision is rendered as follows about an application-for-patent **2001-140140** "character recognition method, program, and recording-medium" Decision-of-Refusal appeal appeal case [number of Heisei 14(2002) July 19 publication of unexamined application, JP,2002-203207,A, and claims (5)].

Conclusion

Conclusion The original decision is canceled. This invention shall be patented.

(4) Appeal Decision

Reason

Account

An application concerned is Heisei 13(2001). It is application on May 10 (claim-of-priority Heisei 12(2000) November one day), and it is admitted that the invention concerning the claim is a thing as the matter indicated to the claim of Claims specifies.

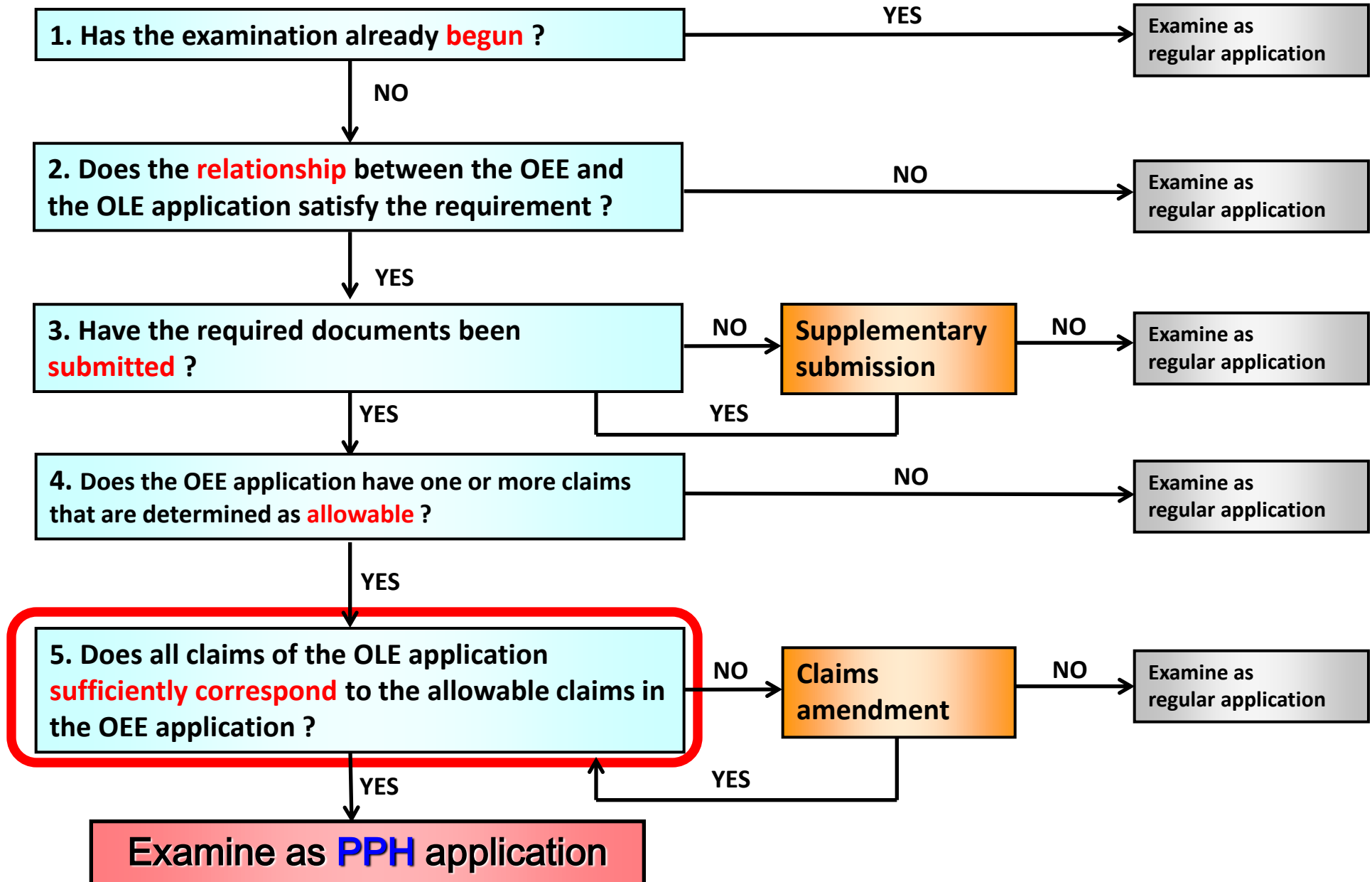
And about an application concerned, even if it examines reasons for refusal of the original decision, it shall not refuse for the Reason.

No Reason for otherwise refusing an application concerned is found.

Therefore, a trial decision is rendered as Conclusion.

Heisei 23(2011) February 18

How to examine the PPH application



Claims sufficiently correspond

- ✓ Claims correspondence table indicates how all claims sufficiently correspond to the for claim allowable/patentable claims in the OEE application.

| The claim filed to the OLE | The claim determined to be allowable in the OEE | Comments about the correspondence |
|----------------------------|---|--|
| 1 | 1 | Both claims are the same. |
| 2 | 2 | Both claims are the same except the claim format. |
| 3 | 1 | Claim 3 in the OLE application adds composition A to claim 1 filed at the OEE. |

Claims sufficiently correspond

All claims on file for examination under the PPH must “sufficiently correspond” to one or more of those claims determined to be allowable/patentable in the latest office action of the corresponding application.

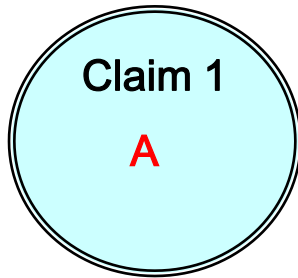
Claims are considered to “sufficiently correspond” where,

- (1) accounting for differences due to translations and claim format, the claims of the OLE application are of the **same or similar** scope as the claims determined as patentable/allowable in the latest office action, or
- (2) the claims of the OLE application are **narrower** in scope than the claims determined as patentable/allowable in the latest office action

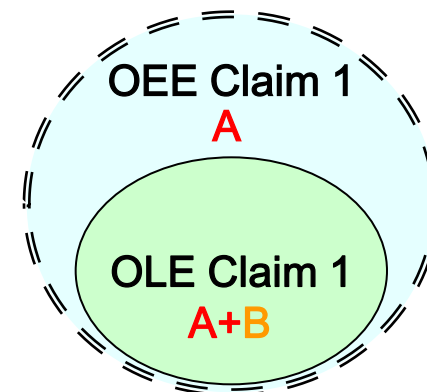
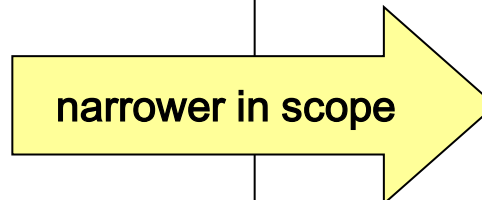
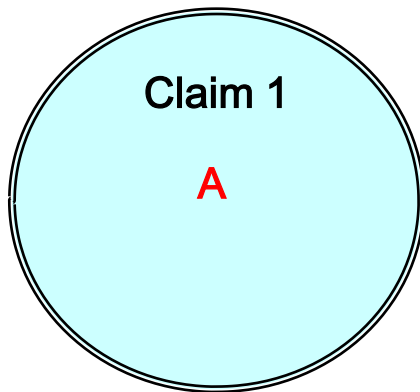
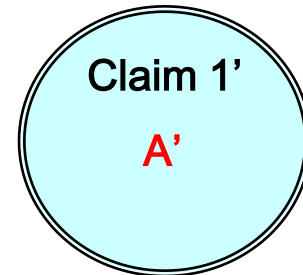
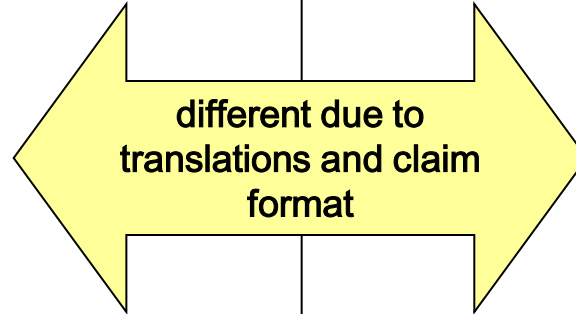
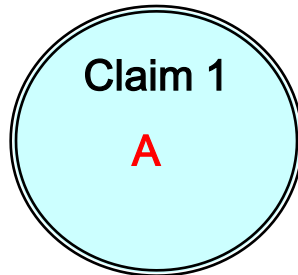
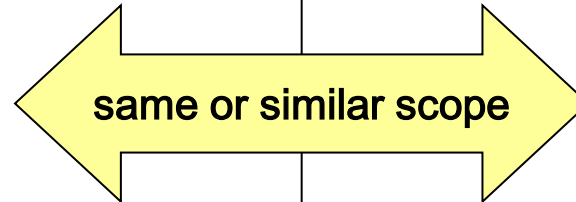
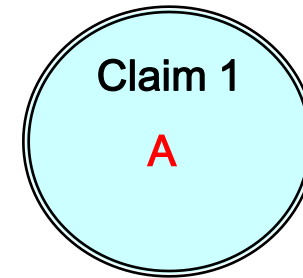
A claim which introduces a new/different category of claims to those claims determined as patentable/allowable in the latest office action is NOT considered to sufficiently correspond. (e.g. product claim vs. process claim)

How to examine the PPH application

OEE Claim(s)

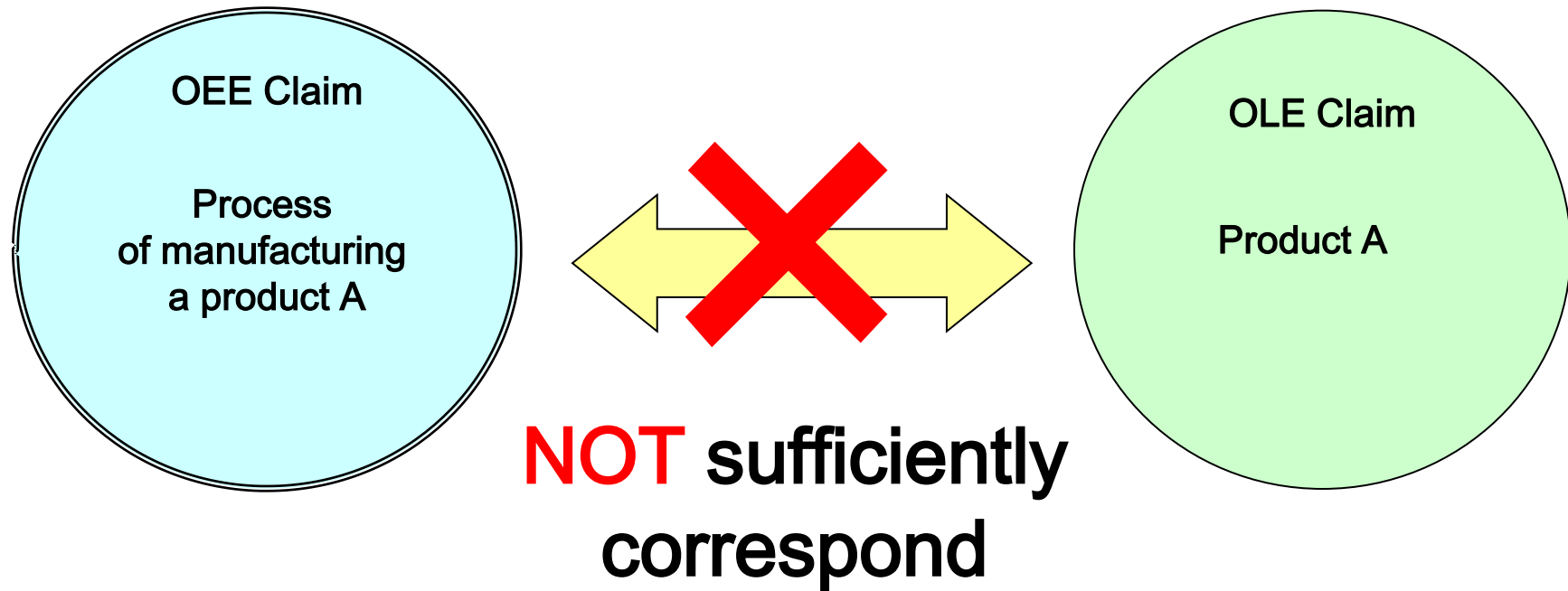


OLE Claim(s)



B is a technical feature
which is supported in the specification
(description and/or claims)

Example of not "sufficiently correspond"
~different category of claims~



Requirements, required documents

| | |
|----------------------------|--|
| Requirements | <ol style="list-style-type: none">1. The examination has not begun in the OLE.2. The OLE application is in particular relationship with the OEE application.4. The OLE application has at least one claim that was determined by the OEE to be allowable.5. All the claims in OLE application sufficiently correspond or are amended to sufficiently correspond to the allowable/patentable claims in OEE application. |
| List of Required Documents | <ol style="list-style-type: none">3-1. A copy of all claims and its translation3-2. Copies of the OEE office actions and their translations3-3. Copies of all cited documents3-4. Claims Correspondence Table |

***Thank you
for your attention!***