

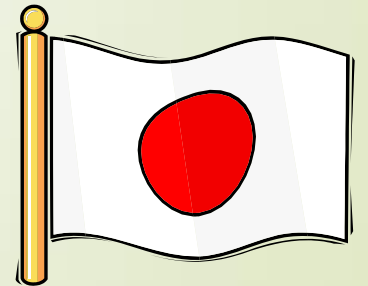
# Pitfalls in Divisional Practice and Recent Developments in Japan

May 23, 2014

Cairns, Annual Meeting

The Institute of Patent and Trade Mark Attorneys of Australia

Dr. Shoichi Okuyama  
Okuyama & Sasajima  
Tokyo, Japan



# Today's Topics



- Divisional Practice in Japan and its **Pitfalls**
- Recent Changes concerning the **Unity Requirement and Shift Amendments**
- Grace Period Provisions with **Broader Applicability**
- **Four Basic IP Laws were Amended**
  - Revival of the post-grant opposition procedure
- Patent Application **Backlog Reduced** and Another Ambitious Goal Set
- **Dramatic Reversal** of Trends in Finding **Inventive Step**

# Divisional Practice

- ▶ What is a divisional application in Japan?
  - ▶ A divisional application in Japan plays a combined role of:
    - ▶ RCE in the U.S.,
    - ▶ Continuation Application in the U.S., and
    - ▶ Divisional Application in the U.S.
- ▶ Unlike the U.S., Japan does not have RCE, continuing applications, and reissue application



# Timing is limited



- ▶ The **timing** for filing a divisional application is **limited**
- ▶ When we can file an amendment, we can also file a divisional
  - ▶ Anytime up to the issuance of a first official action
  - ▶ When an office action is issued
  - ▶ When we file an appeal against a Decision of Rejection
- ▶ Also recently added two opportunities (for applications filed on or after April 1, 2007)
  - ▶ After a Decision of Rejection
    - ▶ Without filing an appeal (w/o spending extra money), a divisional application can be filed
  - ▶ When a notice of allowance is issued

# Pitfalls



- ▶ It may **not** be possible to file a divisional **during the appeal proceedings** as a matter of right
  - ▶ Against a Decision of Rejection, we can file an appeal or a divisional or both
  - ▶ After filing an appeal, it is possible to ask an Examiner or a panel of Appeal Examiners to issue a *pro forma* office action to gain an extra opportunity, but it is totally discretionary and we should not count on it
  - ▶ As a backup or insurance, it may be necessary to file a divisional after a Decision of Rejection
- ▶ **Double patenting** rejection
  - ▶ If a second patent will not be granted on **substantially the same** subject matter
    - ▶ The basic idea is **not to give two administrative registrations which result in monopoly on the same thing**
    - ▶ **CAUTION NEEDED**

# Double patenting rejection

## - “substantially the same”

- ▶ According to the Examination Guidelines published by the JPO, two claims are “the same” for the purpose of Article 39, which prohibits double patenting, if:
  - ▶ They are really the same
  - ▶ **Even if they are different**, differences amount only to the addition, deletion, or conversion of **well-known or common technology**
  - ▶ They are **different only in terms of claim categories** (method/use v. product, etc) as a matter of expression
- ▶ Official study for the purpose of removing double patenting rejection on divisional applications was commissioned in FY 2005 by the JPO

# Comparative Example - EPO

- ▶ T 1780/12 (Cancer treatment/BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM) of 30.1.2014
  - ▶ (Parent, patented in 2004) 1. Use of a composition comprising a biologically effective amount of an anti-aminophospholipid antibody, or antigen-binding region thereof, in the manufacture of a medicament for the treatment of cancer by killing tumor vascular endothelial cells of a vascularised tumor.
  - ▶ (Divisional) 1. A composition comprising a biologically effective amount of an anti-aminophospholipid antibody, or antigen-binding region thereof, for the treatment of cancer by killing tumor vascular endothelial cells of a vascularised tumor, inducing coagulation in tumor vasculature or destroying tumor vasculature.
- ▶ According to the appealed decision of examining division
  - ▶ It is established practice of the EPO first instance departments not to allow that two applications (or a granted patent and an application) from the same applicant claim the same subject-matter. This means not only that the conflicting applications must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words. The difference between the claimed subject-matter of the two applications must be clearly distinguishable (Guidelines for Examination, C-VI, 9.1.6 and C-IV, 7.4)
- ▶ Technical Board of Appeal said the claims are different in their scope
  - ▶ “The board concludes that the grant of a patent on the basis of present claim 1 would not lead to double patenting. The appeal is thus allowable.”

# Eased Unity Requirement



- ▶ Revised Examination Guidelines were published and became **effective July 1, 2013**
- ▶ To state the simple conclusion, the unity requirement was practically **relaxed beyond the literal reading of the relevant statutes** in the Patent Law as amended in 2006
- ▶ Also, practically speaking, **restrictions against “shift amendments” are gone**
  - ▶ The JPO yielded under pressure from user and patent attorney communities
- ▶ Claim requirements in Japan – a reminder
  - ▶ Not limit for the number of independent claims
  - ▶ Multiple dependency is OK without any extra fees, and multi-on-multi is also OK
  - ▶ Fees are dependent on the total number of claims alone



# Grace Period with **Broader Applicability**

- ▶ Statutory provisions were amended in **2011**
- ▶ **Six months** from the Japanese filing date or PCT international filing date
- ▶ **Any disclosure** made by inventor or assignee
  - ▶ **Used to be limited to** disclosure: (1) due to experiment, (2) in publication, (3) at an academic meeting organized by a designated organization, (4) against will, and (5) at an international exposition (Art. 11, Paris Convention)
- ▶ Upon filing a Japanese application, **the use of grace period must be declared**
  - ▶ Support documents have to be filed within 30 days from the filing
- ▶ Result:
  - ▶ The use of the grace period provisions **has doubled**



# Four Basic Laws Were Amended



- ▶ The **Patent, Utility Model, Design and Trademark Laws** were amended last month
  - ▶ A bill covering these laws and the Patent Attorney Law passed the Diet in April 2014 and published this month. Major items included in the bill are as follows:
- ▶ The **post-grant opposition** procedure will be revived for patents.
- ▶ Japan will accede to the **Hague Agreement** for international registration of industrial designs.
- ▶ **New types of trademarks**, such as for colors and sounds, will become registrable.
  
- ▶ The new laws are expected to become applicable in **April 2015** except Hague international design registrations

# Check Points in the New System



- ▶ The revived post-grant opposition procedure
  - ▶ It will be **document-based, without hearings and witness testimony**
  - ▶ The opponent will be able to intervene during the procedure after filing an opposition brief **only if claims are amended**.
  - ▶ The period for filing an opposition will be **six months**, not 9 months, from the date of publication of a patent.
- ▶ Rules for Hague design registration will become clear soon, and they will be important
- ▶ As for "new" trademarks, smells and scents will not yet be registrable.

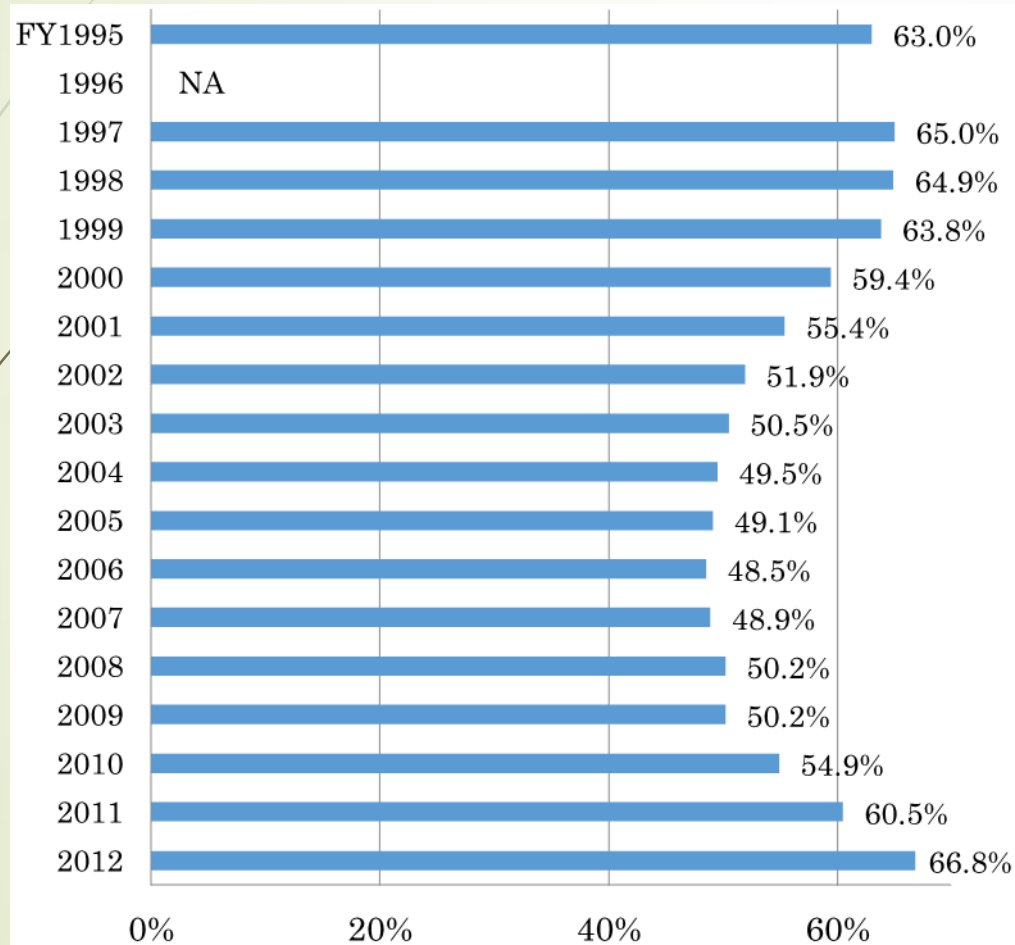
# Examination Backlog Reduced



- ▶ **FA11 goal is reached** in FY 2013 ending March 2014
  - ▶ FA11: a first action within 11 months from requesting examination
  - ▶ The Japan Patent Office has been saying that by the end of FY 2013, i.e., by the end of March 2014, the average period from the filing of a request for examination to the issue of a first action will be reduced to 11 months.
- ▶ The JPO announced a **new goal** in March 2014
  - ▶ Average time between requesting examination and disposal will be reduced **from 29.6 months to 14 months by FY 2023**

# Inventive Step in Japan

## Changes in Patent Rate over 18 Years



Before 2001: Patents Granted / Final Disposals

After 2002: Patents Granted / (Final Disposals + Post-FA Withdrawals or Abandonments)

- 65% in 1997 down to 48.5% in 2006
- And back to 66.8% in 2012
  
- Problems with support requirement have also dealt with
  
- Tough examination practice is a **story of past**
- JPO has transformed itself to be **pro-applicant**
  - While some issues remain, of course

Thank you, and any questions?

or send me an email at  
[okuyama@quon-ip.jp](mailto:okuyama@quon-ip.jp)

**Thank you**

