



Trilateral Offices and Users Working Level Meeting
13 April 2012

Progress in PPH

Japan Patent Office



Contents

1. Current Status of PPH
2. Current Status of PCT-PPH
3. Expanding PPH network
4. PPH MOTTAINAI
5. PPH Outreach
6. PPH Portal Website
7. PPH Policy



Contents

1. **Current Status of PPH**
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Number of Requests

➤ OEE: USPTO, OLE: JPO

PILOT: July 3, 2006 - January 3, 2008
FULL IMPLEMENTATION: January 4, 2008 –
PPH MOTTAINAI: July 15, 2011 –

As of February 29, 2012

✓ The JPO has received 1540 requests
including 20 PPH MOTTAINAI requests.

1458 were eligible.

23 were not eligible

- 11 did not sufficiently correspond to the allowable/patentable claims of the corresponding US application.
- 10 did not have a corresponding US application.
- 2 were not eligible since the JPO has already begun examination of the application.

59 are still not examined.



Number of Requests

➤ OEE: EPO, OLE: JPO

PILOT: January 29, 2010 –
PPH MOTTAINAI: January 29, 2012 –

As of February 29, 2012

✓ The JPO has received 55 requests
including 13 PPH MOTTAINAI requests.

{ 48 were eligible.
1 was not eligible. (It did not have a corresponding EP application.)
6 was still not examined.



First Action(1/2)

➤ **OEE: USPTO, OLE: JPO**

As of February 29, 2012

✓ First actions have been completed on **1425** applications.

| | |
|--------------------------------------|--------------------|
| Decisions to grant a patent | <u>185</u> |
| Notifications of reasons for refusal | <u>1240</u> |

| Applied provision | Number of applications |
|---|------------------------|
| Description requirement (Section 36) | <u>972</u> |
| Novelty (Section 29(1)) or Inventive step (Section 29(2)) | <u>825</u> |
| Unity (Section 37) | <u>172</u> |
| Inventiveness and industrial applicability (Body of section 29(1)) | <u>101</u> |
| Addition of new matter (Section 17bis(3), 49vi) | <u>82</u> |
| Secret prior art (Section 29bis) | <u>44</u> |
| Double patenting (Section 39) | <u>24</u> |

✓ Average pendency from request to first action: **1.7 months**(2011CY)⁶



First Action(2/2)

➤ OEE: EPO, OLE: JPO

As of February 29, 2012

✓ First actions have been completed on **39** applications.

| | |
|--------------------------------------|------------------|
| Decisions to grant a patent | <u>9</u> |
| Notifications of reasons for refusal | <u>30</u> |

| Applied provision | Number of applications |
|---|------------------------|
| Description requirement (Section 36) | <u>21</u> |
| Novelty (Section 29(1)) or Inventive step (Section 29(2)) | <u>21</u> |
| Unity (Section 37) | <u>0</u> |
| Inventiveness and industrial applicability (Body of section 29(1)) | <u>2</u> |
| Addition of new matter (Section 17bis(3), 49vi) | <u>0</u> |
| Secret prior art (Section 29bis) | <u>0</u> |
| Double patenting (Section 39) | <u>0</u> |



Final Action(1/2)

➤ OEE: USPTO, OLE: JPO

As of February 29, 2012

✓ Final actions have been completed on 1201 applications.

- 809 decisions to grant a patent.
- 389 decisions of refusal.
- 3 were withdrawn.

✓ Average pendency from first action to final action:
5.5 months(2011CY)

✓ First action allowance rate: 20.4% (2011CY)

✓ Grant rate: 72.4% (2011CY)

| | 2009CY | 2010CY | 2011CY |
|----------------|--------|--------|--------|
| Grant rate (%) | 59.6 | 67.2 | 72.4 |



Final Action(2/2)

As of February 29, 2012

➤ OEE: EPO, OLE: JPO

✓ Final actions have been completed on 28 applications.

- { 24 decisions to grant a patent.
- { 4 decisions of refusal.



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Trilateral PCT-PPH pilot program

- Started on 29 January 2010
- The trial has extended for two years ending on 28 January 2014 since 29 January 2012





Number of Requests

As of February 29, 2012

➤ ISA / IPEA: EPO, Office of Filing: JPO

✓ The JPO has received 377 requests.

346 were eligible.

2 were not eligible

- 1 did not sufficiently correspond to the allowable/patentable claims of the corresponding EP international work product.

- 1 did not have a corresponding EP international work product.

29 were still not examined.

➤ ISA / IPEA: USPTO, Office of Filing: JPO

✓ The JPO has received 13 requests.

10 were eligible.

3 were still not examined.



Number of Requests

As of February 29, 2012

➤ ISA / IPEA: JPO, Office of Filing: JPO

✓ The JPO has received 910 requests.

829 were eligible.

3 were not eligible

- 2 did not sufficiently correspond to the allowable/patentable claims of the corresponding JP international work product.

- 1 did not explain which claims are allowable/patentable concerning Box VIII of the JP international work product.

78 were still not examined.



First Action (1/3)

As of February 29, 2012

ISA / IPEA: **EPO**, Office of Filing: **JPO**

✓ First actions have been completed on **336** applications.

| | |
|--------------------------------------|-------------------|
| Decisions to grant a patent | <u>54</u> |
| Notifications of reasons for refusal | <u>282</u> |

| Applied provision | Number of applications |
|--|------------------------|
| Description requirement (Section 36) | <u>229</u> |
| Novelty (Section 29(1)) or Inventive step (Section 29(2)) | <u>159</u> |
| Unity (Section 37) | <u>12</u> |
| Inventiveness and industrial applicability (Body of section 29(1)) | <u>11</u> |
| Addition of new matter (Section 17bis(3), 49vi) | <u>5</u> |
| Secret prior art (Section 29bis) | <u>10</u> |
| Double patenting (Section 39) | <u>0</u> |

✓ Average pendency from request to first action: **2.2 months**(2011CY)¹⁴



First Action (2/3)

As of February 29, 2012

➤ ISA / IPEA: USPTO, Office of Filing: JPO

✓ First actions have been completed on 9 applications.

| | |
|--------------------------------------|----------|
| Decisions to grant a patent | <u>1</u> |
| Notifications of reasons for refusal | <u>8</u> |

| Applied provision | Number of applications |
|--|------------------------|
| Description requirement (Section 36) | <u>6</u> |
| Novelty (Section 29(1)) or Inventive step (Section 29(2)) | <u>7</u> |
| Unity (Section 37) | <u>4</u> |
| Inventiveness and industrial applicability (Body of section 29(1)) | <u>0</u> |
| Addition of new matter (Section 17bis(3), 49vi) | <u>0</u> |
| Secret prior art (Section 29bis) | <u>0</u> |
| Double patenting (Section 39) | <u>0</u> |



First Action (3/3)

As of February 29, 2012

➤ ISA / IPEA: JPO, Office of Filing: JPO

✓ First actions have been completed on **800** applications.

| | |
|--------------------------------------|-------------------|
| Decisions to grant a patent | <u>550</u> |
| Notifications of reasons for refusal | <u>250</u> |

| Applied provision | Number of applications |
|--|------------------------|
| Description requirement (Section 36) | <u>200</u> |
| Novelty (Section 29(1)) or Inventive step (Section 29(2)) | <u>68</u> |
| Unity (Section 37) | <u>10</u> |
| Inventiveness and industrial applicability (Body of section 29(1)) | <u>3</u> |
| Addition of new matter (Section 17bis(3), 49vi) | <u>1</u> |
| Secret prior art (Section 29bis) | <u>10</u> |
| Double patenting (Section 39) | <u>8</u> |

✓ Average pendency from request to first action: **1.8 months**(2011CY)



Final Action

As of February 29, 2012

➤ ISA / IPEA: EPO, Office of Filing: JPO

✓ Final actions have been completed on 265 applications.

- ✓ 220 decisions to grant a patent.
- ✓ 42 decisions of refusal.
- ✓ 3 were withdrawn.

✓ Average pendency from first action to final action:
4.2 months(2011CY)

✓ First action allowance rate: 19.8% (2011CY)

✓ Grant rate: 83.5% (2011CY)

➤ ISA / IPEA: USPTO, Office of Filing: JPO

2 decisions to grant a patent.

2 decision of refusal.



Final Action

As of February 29, 2012

➤ ISA / IPEA: JPO, Office of Filing: JPO

✓ Final actions have been completed on 724 applications.

{ 706 decisions to grant a patent.
 18 decisions of refusal.

✓ Average pendency from first action to final action:
0.9 months(2011CY)

✓ First action allowance rate: 71.0% (2011CY)

✓ Grant rate: 98.0% (2011CY)



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Recent new PPH of JPO

SIPO (China): PPH and PCT-PPH since 1 Nov 2011

NIPO (Norway): PPH and PCT-PPH since 1 Dec 2011

IPO (Iceland): PPH and PCT-PPH since 1 Dec 2011

ILPO (Israel): PPH since 1 Mar 2012

IPOPHIL (Philippines): PPH and PCT-PPH since 12 Mar 2012

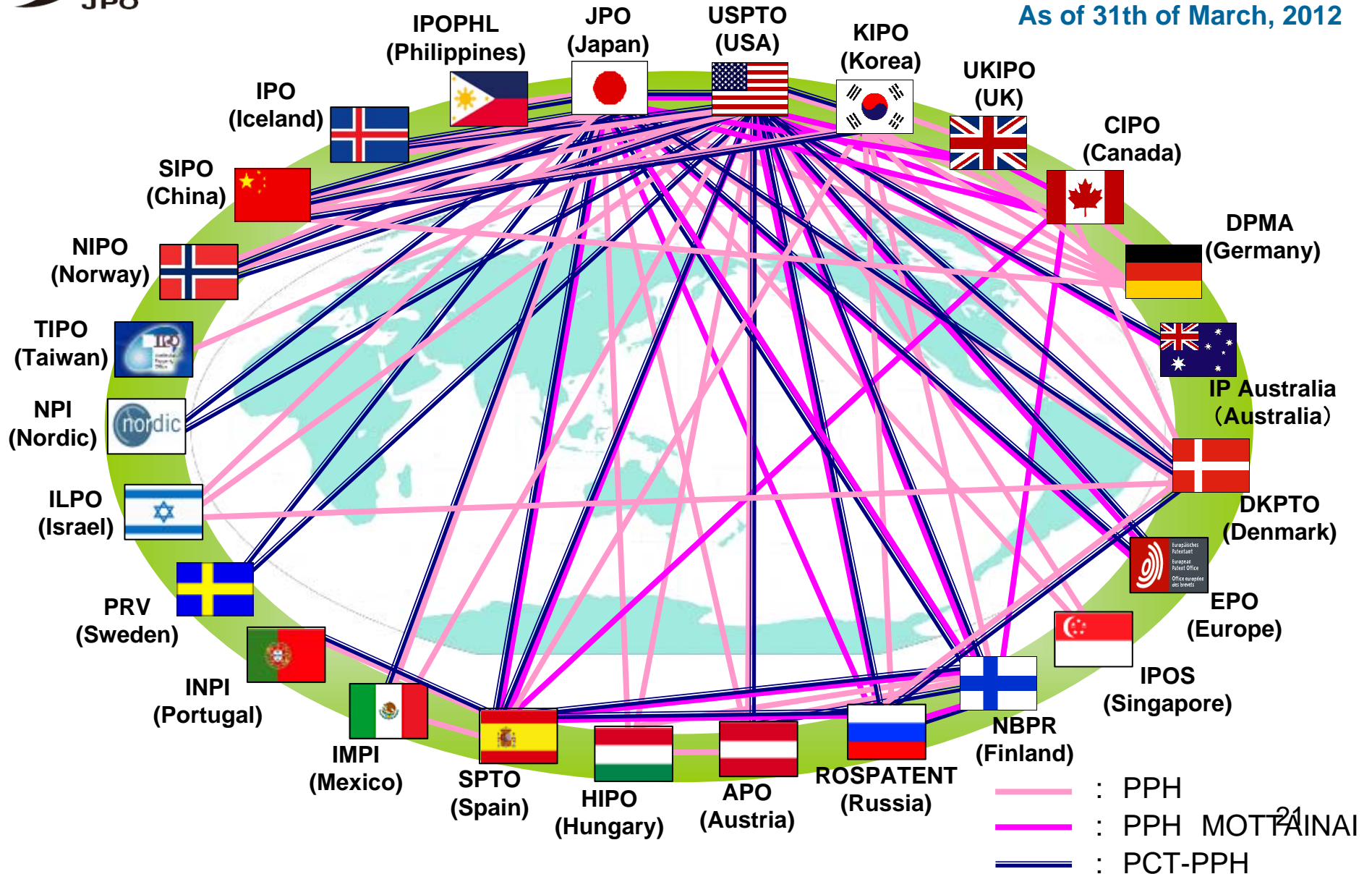
INPI (Portugal): PPH and PCT-PPH since 18 April 2012

TIPO (Taiwan): PPH since 1 May 2012



Expanding PPH network

As of 31th of March, 2012





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Relaxing the PPH requirements

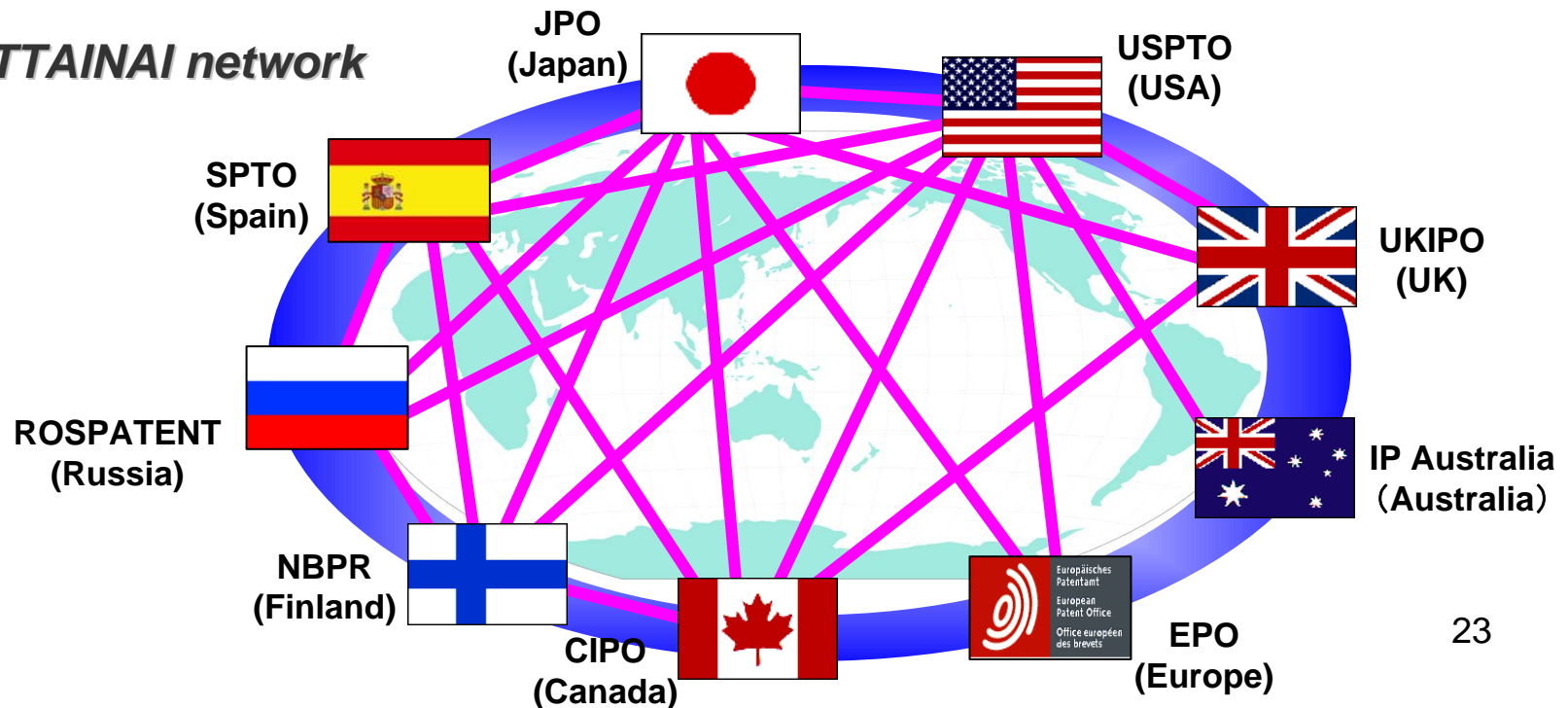
PPH MOTTAINAI pilot program

15 July 2011: 8 Offices (JPO, USPTO, UKIPO, CIPO, IP Australia, NBPR, ROSPATENT and SPTO) first commenced the pilot.

29 January 2012: EPO has commenced the pilot with JPO and USPTO.

As of 31th of March, 2012

PPH MOTTAINAI network





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PPH User Seminar in Tokyo on February 23, 2012

- About 200 IP experts from companies and patent attorneys' offices participated in this seminar.



JPO: Overview of PPH and New Topics



USPTO: The Benefits of the Patent Prosecution Highway



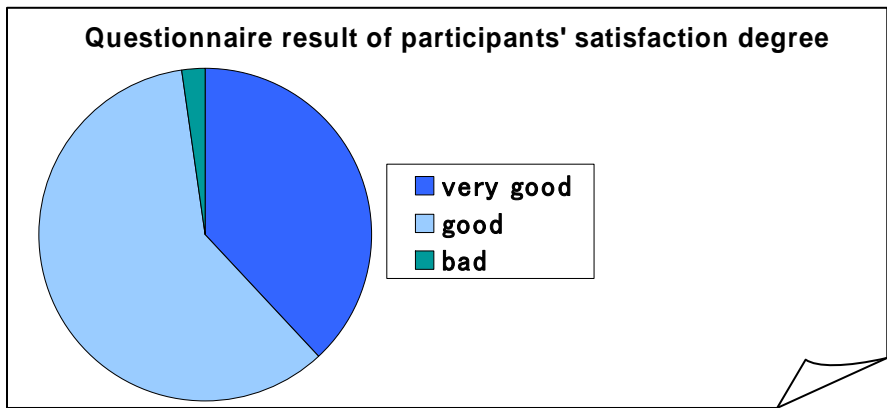
PPH User Seminar in Tokyo on February 23, 2012



SIPO: Patent Prosecution Highway: Views from the SIPO



JIPA: Patent Prosecution Highway: Users' View





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PPH Portal Website (1/3)

- JPO administrates the [PPH Portal Website](#), which provides the **latest information regarding PPH**, the **guidelines** and the **request forms** of different countries.

The screenshot shows the 'Patent Prosecution Highway Portal Site' with a navigation menu including 'Top Booklet', 'About PPH Statistics', and 'PPH MOTTAINAI Links'. A world map highlights participating countries. A 'Notification' table lists recent program commencements:

| Date | Event |
|-----------------|---------------------------------|
| 1 February 2012 | New PPH/DKPTO Program commenced |
| 31 January 2012 | New PPH/MOTTAINAI commenced |
| 29 January 2012 | New PPH/MOTTAINAI commenced |
| 2012 | New PPH/SIPO commenced |
| 2012 | New PPH/LPO commenced |
| 2011 | New PPH/JPO commenced |
| 2011 | New PPH/JPO commenced |
| 2011 | New PPH/JPO commenced |

Provision of the latest information regarding PPH

Provision of the PPH guidelines and the request forms

The screenshot shows the 'Patent Prosecution Highway Portal Site' with a navigation menu including 'Top Booklet', 'About PPH Statistics', 'PPH MOTTAINAI Links', 'Guidelines Access to Dossier', and 'Request Forms Events'. A 'Booklet' section displays various country-specific PPH booklets:

- JPO, USPTO
- DKPTO
- CIPO
- UKIPO
- ROSPATENT

Provision of the booklets of PPH of different countries



PPH Portal Website (2/3)

- [PPH Portal Website](#) also provide the **PPH statistical data**.

Number of PPH(using the national products) Requests OSF/OLE

| | JP | US | KR | GB | CA | DE | AU | DK | EP | SG | FI | RU | AT | HU | ES | MX | TW |
|--------------|-------------|-------------|-------------|------------|------------|----------|----------|------------|----------|-------------|-----------|----------|----------|----------|----------|----------|----------|
| JP | 4703 | 1025 | 20(0) | 73 | 495 | - | 2 | 394 | 0 | 1(0) | 42 | 0 | 0 | 0 | 0 | 0 | 0 |
| US | 1438(12) | 475 | 36(1) | 1822 | 40 | 146(7) | - | - | - | - | - | - | - | - | - | - | - |
| KR | 180 | 851 | - | 4 | 5 | 1 | - | 0 | - | - | - | - | - | - | - | - | - |
| GB | 52(3) | 205 | 18 | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| CA | 2(2) | 107 | 1 | - | - | 0 | - | 0 | - | - | - | - | - | - | - | - | - |
| DE | 80 | 65 | 13 | - | 11 | - | - | - | - | - | - | - | - | - | - | - | - |
| AU | - | 109 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| DK | 7 | 90 | 4 | - | 1 | - | - | - | - | - | - | - | - | - | - | - | - |
| EP | 40 | 191 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| SG | 0 | 2 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| FI | 5(0) | 18 | 0 | - | 1 | - | - | - | - | - | - | - | - | - | - | - | - |
| RU | 3(0) | 8 | 0 | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| AT | 1 | 0 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| HU | 2 | 3 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| ES | 0(0) | 0 | 0 | - | 0 | - | - | - | - | - | - | - | - | - | - | - | - |
| MX | 0 | 0 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| PT | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| IL | - | 1 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| TW | - | 0 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| NO | 0 | 0 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| CN | 1 | 0 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| IS | 0 | 0 | - | - | - | - | - | - | - | - | - | - | - | - | - | - | - |
| Total | 1791 | 2030 | 2013 | 538 | 148 | 3 | 2 | 394 | 0 | 1(0) | 42 | 0 | 0 | 0 | 0 | 0 | 0 |

Provision of the number of PPH requests by Office

Provision of the PPH statistical data, such as **Grant Rate** and **Average Pendency from FA to Final Decision**.

PPH Statistical Data

Definitions:

(1) **Grant Rate** = (# of decisions to grant a patent) / ((# of decisions to grant a patent) + (# of decisions of refusal) + (# of withdrawal and abandonment after first office action))

(2) **First Action Allowance Rate** = (# of decision to grant a patent) / ((# of decision to grant a patent) + (# of decisions of refusal) + (# of withdrawal and abandonment after first office action))

(3) **Average Pendency from PPH Request to First Office Action** is the average pendency of application for which first office action was issued during the period.

(4) **Average Pendency from PPH Request to Final Decision** is the average pendency of application for which final decision was issued during the period.

(5) **Average Number of Office Actions** = (total # of office actions of all the applications for which final decision was issued during a period) / (# of application for which final decision was issued during the period)

*Final decisions are NOT counted as office actions.
**Decisions in appeals are not included.

PPH Statistical Data(NOT including PCT-PPH)

| | JP | US | KR | GB | CA | DE | AU | SG | FI | RU | HU | ES | MX | TW |
|--|-------------|-------------|----------------------------|------------|------------|-------|------------|------------|------------|------------|------------|------------|--------------------------|------------|
| Grant Rate (%) Graph click! | 76.6 (58.9) | 87 (49) | 90.3 (66.3) | 97.6 (0) | 91 (64) | - (-) | 100 (-) | 100 (-) | 100 (-) | 95 (80.2) | 24.4 (-) | - (-) | 81.8 ^{*2} (-) | 100 (57) |
| First Action Allowance Rate (%) Graph click! | 22.9 (11.2) | 26 (14) | 27.1 (10.1 ^{*1}) | 4.8 (-) | 42 (4.9) | - (-) | 44.4 (-) | 100 (12.3) | 66 (9.7) | 80 (9.7) | 0 (-) | 100 (12.3) | 81.8 ^{*2} (9.7) | 87.5 (9.2) |
| Average Pendency from PPH Request to First Office Action (months) Graph click! | 1.8 | 6.1 | 1.8 | 1.8 | 1.8 | - | 1.8 | 1.8 | 1.8 | 1.8 | 1.8 | 1.8 | 1.8 | 1.8 |
| Average Pendency from PPH Request to Final Decision (months) Graph click! | 7.1 (32.4) | 11.6 (33.8) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | - | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) |
| Average Number of Office Actions Graph click! | 1.06 (1.10) | 2.3 (2.6) | - (-) | 1.14 (-) | 1.14 (-) | - (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) |

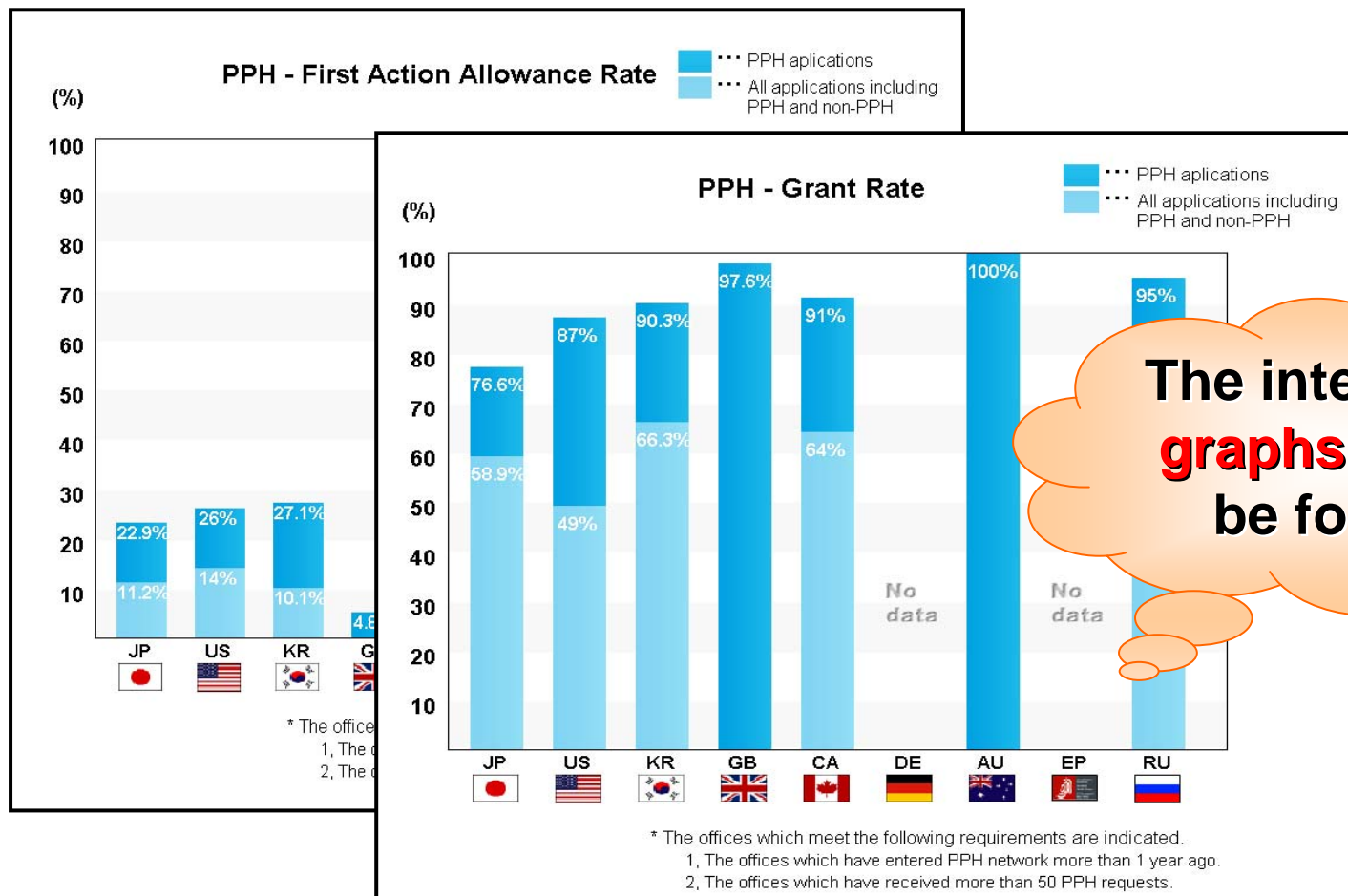
PPH Statistical Data(NOT including PCT-PPH)

| | JP | US | KR | GB | CA | DE | AU | SG | FI | RU | HU | ES | MX | TW |
|--|-------------|-------------|----------------------------|------------|------------|-------|------------|------------|------------|------------|------------|------------|--------------------------|------------|
| Grant Rate (%) Graph click! | 76.6 (58.9) | 87 (49) | 90.3 (66.3) | 97.6 (0) | 91 (64) | - (-) | 100 (-) | 100 (-) | 100 (-) | 95 (80.2) | 24.4 (-) | - (-) | 81.8 ^{*2} (-) | 100 (57) |
| First Action Allowance Rate (%) Graph click! | 22.9 (11.2) | 26 (14) | 27.1 (10.1 ^{*1}) | 4.8 (-) | 42 (4.9) | - (-) | 44.4 (-) | 100 (12.3) | 66 (9.7) | 80 (9.7) | 0 (-) | 100 (12.3) | 81.8 ^{*2} (9.7) | 87.5 (9.2) |
| Average Pendency from PPH Request to First Office Action (months) Graph click! | 1.8 | 6.1 | 1.8 | 1.8 | 1.8 | - | 1.8 | 1.8 | 1.8 | 1.8 | 1.8 | 1.8 | 1.8 | 1.8 |
| Average Pendency from PPH Request to Final Decision (months) Graph click! | 7.1 (32.4) | 11.6 (33.8) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | - | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) | 7.1 (32.4) |
| Average Number of Office Actions Graph click! | 1.06 (1.10) | 2.3 (2.6) | - (-) | 1.14 (-) | 1.14 (-) | - (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) | 1.14 (-) |

Clicking the icon "Graph"...



PPH Portal Website (3/3)



The intelligible **graphs** would be found!

•The Offices which meet the following requirements are indicated.
 1, The offices which have entered PPH network more than 1 year ago.
 2, The offices which have received more than 50 PPH requests.



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In the light of the PPH scheme, the fundamental expectations for PPH are cited as follows;

- Predictable fast acquisition of patent rights (in view of applicants).
- Mitigation of workloads via work-sharing among patent offices (in view of patent offices)

JPO suggest policies to be followed by PPH participating offices as PPH Policy

Each office participating in PPH should endorse and realize the following policies at their maximum extent to promote transparency and effectiveness of PPH.



(draft)

- (1) Offices of Earlier Examination (OEEs) should maximize their efforts to improve examination quality, providing reliable work products, so that Offices of Later Examination (OLEs) could maximize the use of the work products by OEEs and minimize the prior art search.
- (2) OLEs should be expected to make maximum use of search/examination-related information of OEEs and minimize prior art search within the framework of existing own system such as laws, examination rules and IT systems of each office, considering the claims of OLE are sufficiently correspond to the claims determined to be allowable in an OEE. This results in not only work-sharing among offices and quality improvement but also faster acquisition of patent for applicants. However, the independence of examiners must always be kept.
- (3) OLEs should make every effort to reduce the total number of office actions for PPH applications, improving allowance rate (especially first allowance rate) and fast grant of patent within the framework of the existing system. Interview at the examination stage and suggestion for amendment would enhance communication between examiners and applicants. OLE examiners should utilize an interview (especially interview before first action) and make any suggestion of amendment.



(draft)

- (4) Examination for an application for which PPH request is approved should be expedited throughout its examination stage. Therefore, not only the First Action (FA) pendency from PPH request but also the period from FA to final decision (e.g. decision to grant a patent) of PPH applications should be reduced compare to those of non-PPH applications.
- (5) Transparent system for PPH will enhance predictability and availability for applicants. PPH participating patent offices should ensure publication of PPH related data (such as Grant Rate, Average Pendency from PPH request to First Office Action, Average Pendency from First Office Action to Final Decision, etc).
- (6) Each patent office should endeavor to make a guideline according to the above policies and disseminate it to examiners of each office as well as to public.



Trilateral Offices and Users Working Level Meeting
13 April 2012

Thank you !