

How to Save Money Prosecuting US Patent Applications

米国特許出願後登録に至るまでの手続き費用を抑える方法



by Dennis Hubbs

HEA at a Glance

- 3 U.S. Patent Attorneys 米国特許弁護士3名
- 1 U.S. Attorney 米国弁護士1名
- Native Japanese Support Staff 日本人スタッフ
- Offices located in Roppongi, Tokyo and McLean, Virginia (Washington DC-area) 東京の六本木とアメリカのバージニア州マクリーンに事務所を構える
- HEA is the first Japan based US Intellectual Property Law Firm to be registered as a gaikokuho jimusho bengoshi houjin and only the second registered foreign houjin law firm in Japan.

HEAは国内初、外国法事務弁護士法人として登録された、日本に拠点を置く米国特許事務所であり、日本では2番目に登録された外国弁護士法人である。



Efficient Prosecution Strategies

- Using Big Data to Review Examiner History
 - US Practice Focused Arguments
 - Dependent Claims
 - Examiner Interviews
 - IDS Practice
 - After Final Consideration Pilot (AFCP 2.0)
 - High Quality Translations
-

効率的な出願戦略

- ビックデータを用いた審査官の過去の審査履歴を分析
- 米国特許実務に則った意見書作成
- 従属クレーム
- 審査官との(電話)面接
- 情報開示陳述書(IDS) 提出
- 最終拒絶理由通知(Final OA)後の補正要件緩和・再審査申請(AFCP 2.0)
- 高品質の翻訳



Review Examiner History - Big Data

- Problem – How does an Applicant better determine when it would be most cost effective to file an RCE vs. a Continuation vs. an Appeal?
 - Solution – Big Data in the form of an analysis of an Examiner’s cumulative allowance/rejection history may provide insight on a proper response strategy.
 - Big Data
 - Certain companies have been mining the USPTO’s public PAIR database (the database that shows each paper filed with the USPTO or sent from the USPTO).
 - This compiled data allows a user to determine if a pattern can be determined from the examiner’s rejection/allowance history.
 - If an examiner has a very low allowance rate or frequently requires multiple RCEs before allowance, this may indicate that filing additional responses may not be the best approach. The Applicant can determine that it may be more cost effective to delay prosecution (through a continuation or Appeal) as the law on a relevant issue settles. Alternatively, the data may indicate that an application should be removed from an examiner’s review as quickly as possible (through filing an Appeal).
 - Benefit – Saving money from reduced response and RCE fees.
-

審査官の過去の審査履歴の分析ービッグデータ

- 問題...出願人はRCE(継続審査請求)、Continuation (拒絶査定後の再考)、Appeal(審判請求)のどれを、いつ申請をするのが最も費用対効果が高いか、決めねばならない
- 解決策...審査官の過去の許可/拒絶の履歴が蓄積されたビッグデータの分析が適切な応答戦略への手がかり

Patent Advisor Examiner Statistics

EXAMINER SEARCH RESULTS FOR

John Smith

GROUP ART UNIT 2454

審査部門コード



CHECK OUT OUR NEW FILTERS!

Filters



ETA **11.7**
ETA **11.7** RELATIVE TO AU: 2454

41.2%

ALLOWANCE RATE
審査官の特許許可率

78.1%

AU 2454 ALLOWANCE RATE (CURRENT AU)
審査部門コード2454 特許許可率

TOTAL NUMBER OF APPLICATIONS

101

TOTAL

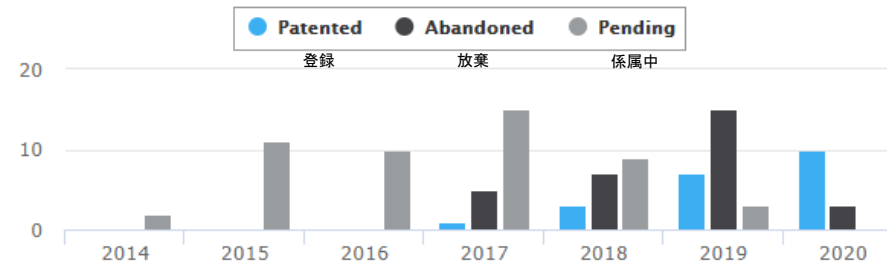
21 PATENTED APPLICATIONS

30 ABANDONED APPLICATIONS

50 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.
[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME



Granted/abandoned shown in year granted/abandoned.
Pending shown in year filed.



Patent Advisor Examiner Statistics

EXAMINER SEARCH RESULTS FOR

Dave Duncan

GROUP ART UNITS 3621, 3688
審査部門コード



CHECK OUT OUR NEW FILTERS!

Filters



ETA ⁱ RELATIVE TO AU: 3621 ⁱ

12.1%

ALLOWANCE RATE
審査官の特許許可率

35.2%

AU 3621 ALLOWANCE RATE (CURRENT AU)
審査部門コード3621 特許許可率

TOTAL NUMBER OF APPLICATIONS

317

TOTAL ⁱ

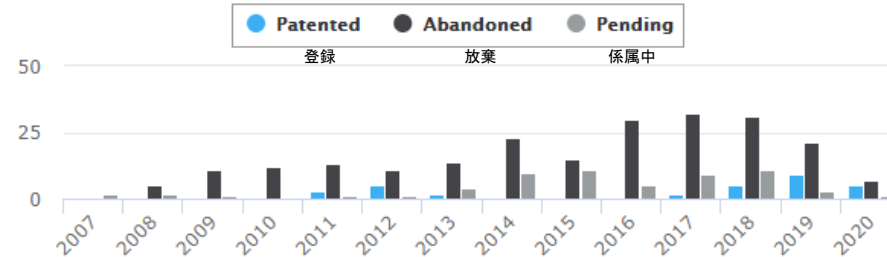
31 PATENTED APPLICATIONS

225 ABANDONED APPLICATIONS

61 PENDING APPLICATIONS

This page is limited to patent applications with electronic file histories that were filed on or after 11/29/00.
[Click here to include all known published applications.](#)

TOTAL NUMBER OF APPLICATIONS - OVER TIME

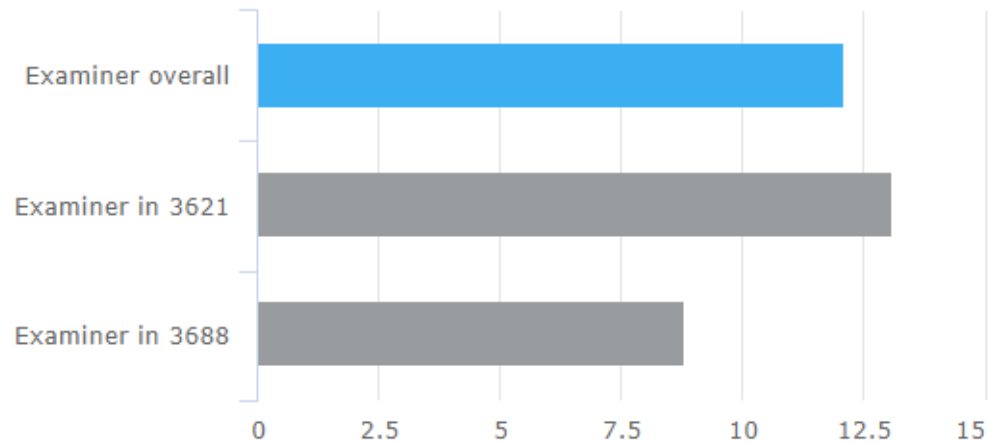


Granted/abandoned shown in year granted/abandoned.
Pending shown in year filed.



Patent Advisor Examiner Statistics

ALLOWANCE RATES ^



ART UNIT 3621'S ALLOWANCE RATES, BY TOP EXAMINERS:

上位審査官別、審査部門コード3621の特許許可率

Allowance rate	Name	Total	Patented	Abandoned	Pending
36.9%	JACOB C COPPOLA	444	164	280	0
60.5%	JAMES A REAGAN	426	257	168	1
69.7%	PIERRE E ELISCA	364	253	110	1
23%	TAREK ELCHANTI	331	56	187	88
22%	CHRYSTINA E ZELASKIEWICZ	304	56	199	49
11.4%	MONICA A MANDEL	298	26	203	69
22.9%	JAMES M DETWEILER	276	50	168	58
13.1%	Dave Duncan	260	26	173	61
49.6%	EVENS J AUGUSTIN	250	124	126	0
20.2%	COLLEEN A HOAR	248	41	162	45

Other Tips to Reduce Cost

- Use artificial intelligence (*Patent Optimizer*) to review claims/specification
 - Use AI to review claims (and specification) before filing
 - Can help identify antecedent basis issues and support issues
-

費用削減に係るその他の助言

- パテント・オプティマイザー／人工知能によるクレーム及び明細書のレビュー
 - ・出願前に、人工知能(AI)を使用してクレーム(及び明細書)をレビューする。
 - ・先行詞問題やサポート問題の確認に活用できる

Best Way to Format Argument for USPTO

- Most US attorney's are taught this method – 3 steps:
 1. Quote **claimed feature** you wish to distinguish.
 - a) Focus only on claimed features.
 - b) If a feature is not in the claims, don't mention it.
 2. Quote or closely paraphrase what is recited in reference.
 3. Explain why the reference is distinguished from the **claimed feature**.
 - a) Arguments should be only on what the prior art does not disclose or teach.
 - b) Arguments/Comments on Applicant's invention and claims should be minimal or nonexistent.
 4. Close with the exact claimed feature.
 - Try to focus on a specific and narrow feature and not a long passage of the claims
 - Usually technical arguments are more persuasive than legal arguments
-

USPTO(米国特許商標庁)に対する最適な意見書

- 米国特許弁護士が行うこと.....3ステップ
 1. クレームに記載の特徴のみを引用する
 2. 引例の記載を引用する
 3. 引例とクレームの特徴との差異を明確に説明
 - a. 引例に記載されていないものにのみ言及する
 - b. 本願発明とクレームへの言及は最小限に
 4. 締めくくりにはクレームの特徴を正確にもう一度。

Best Way to Format Argument for USPTO

- This method is what examiners are used to seeing
 - Easy to understand
 - Limits prosecution history estoppel
-

- USPTO(米国特許商標庁)に対する最適な意見書
- 前頁の意見書は審査官が見慣れているもの
- 理解しやすい
- 審査経過に基づく禁反言を制限

Utilize Dependent Claims More Effectively

- Utilize Dependent Claims Effectively
 - What is the purpose of a dependent claim?
 1. In case the independent claim is found to be invalid in litigation
 2. To aid in efficient prosecution
 - Regarding point 2 above:
 - This issue is fundamental to lowering costs and is sometimes under-utilized
 - This could help to reduce the number of office actions and RCE's
- より効果的な実務のためには様々な戦略がある
- 従属クレームの効果的な活用
 - 従属クレームの目的は？
 1. 訴訟において独立クレームが無効とされたときへの備え
 2. 効率的な出願手続となる
 - 上記2、目的の2つ目について
 - コスト削減のための基本であるが、十分活用されないこともしばしば
 - これによりオフィスアクションの数やRCEの回数を減らすことが可能に

Utilize Dependent Claims More Effectively

- What do we mean by utilizing dependent claims effectively?
 - When responding to office actions, it may help to present more than one argument/amendment.
 - The second/third/fourth argument/amendment serves two main purposes:
 1. A backup position in case the first position does not convince the examiner;
 2. Convince the examiner that a new search is needed anyway, thereby reducing bad rejections
- 従属クレームの効果的な活用法とは？
 - オフィスアクションへの応答の際は、1つ以上の意見／補正の提出が有効なことも
 - 2つ目、3つ目、4つ目の意見／補正には主に2つの目的がある
 1. 1つ目の意見によって審査官を説得できなかったときの予備用(バックアップ)
 2. 審査官に新しいサーチが必要と確信させ、それにより意味の無い拒絶を避ける

Examiner Interviews

- Problem –
 - Examiners often do not read an Applicant's specification and may misinterpret an Applicant's claim language. It may take 2-3 responses before an Examiner understands the distinction in the claims or specification over cited prior art.
 - Examiners issue 101 rejections, but resolving these rejections is ad-hoc and inconsistent.
 - Solution – Examiner Interviews
 - Benefits –
 - Reduce the number of responses and RCE fees to obtain an allowance.
 - Quickly explain specific benefits of the invention to the examiner (reducing the amount of time the examiner must spend reading the application). This also avoids putting unwanted information on the record.
 - Allows the examiner to better explain the reasons for a rejection.
-

審査官面接

なぜ行う？

- ・審査官が明細書を精読せず、クレームの文言が正しく理解されないことがあり、審査官が先行技術とクレームや明細書との差異を理解するのに2、3回の応答が必要になることも
- ・特許法101条による拒絶は、審査官により対応を変える必要がある

行うことによる利点

- ・応答回数やRCE(継続審査請求)の費用を減らすことができる
- ・本願発明の利点を審査官に迅速に伝え、また不要な情報が記録に残るのを防ぐことができる

Examiner Interviews

- Senior examiners often give feedback on how to address cited art that was not provided in a rejection and/or provide a preview of a new rejection based on art not yet applied in a rejection.
 - Provide a proposed amended claim set in advance for the Examiner's review. Some Examiners may allow additional email exchanges to find allowable claims.
 - Provide a brief description of the arguments to be presented and allow the Examiner to respond why such arguments will or will not work in a formal response.
 - Determine how to address a 101 rejection because this is often treated differently depending on the examiner and the art unit. Examiners are often willing to provide explicit directions on how to overcome a 101 rejection for his/her purposes. If not, the Examiner may indicate that an appeal is the only remaining course of action, which would save money over filing additional responses.
 - Examiners are motivated to conduct an interview because interviews count towards an examiner's bi-monthly work requirement.
-

審査官面接

- 補正や意見書の内容を審査官に事前に伝え、審査官の意見を聞くことができる。その後E-mailのやり取りを許す審査官も
- 審査官や技術分野により特許法第 101 条の取り扱いが異なるが、これに対する応答方針を決めることができる。審査官は、出願人に対し特許法第 101 条に基づく拒絶を回避するための明確な指示を与えることが多い。これ以外の場合では、審査官は審判請求しか対応手段はないと示唆することもあり、これが更なる応答費用の節減につながる

Examiner Interviews

- First Action Interview Pilot Program

- (<https://www.uspto.gov/patent/initiatives/first-action-interview/full-first-action-interview-pilot-program>)
- Allows interview to occur *before* an office action is issued
- Good for important applications, technically difficult applications
 - Requirements include: 3 or fewer independent claims; 20 or fewer total claims; claims directed toward single invention (i.e. no restriction issues); before first office action

- ファーストアクション・インタビュー・パイロット・プログラム (FAI)

- ・第1回目の拒絶理由通知が発行される前に、審査官面接を行える。
- ・重要な出願や技術的に難しい出願に対し有用。

- ・要件： 独立クレーム数が3項またはそれ以下である。総クレーム数が20項またはそれ以下である。クレームは単一の発明を請求している(例えば、限定要求されることがない)。第1回目の拒絶理由通知の前である。

IDS Practice

- Problems –
 - Failure to disclose all art cited in an application family could result in higher USPTO fees and attorney fees later in the application.
 - Once an application is in active prosecution, not identifying whether cited art is “first cited” within a three month period.
 - Failure to cite the art could render the patent unenforceable.
 - Selectively determining what art to cite from a foreign family takes more time than citing everything from a foreign family member.
 - Solution – For all art cited in a foreign application family member, submit each one of such references regardless of its strength/status (i.e., “X”, “Y”, or “A”). The art was likely cited for some level of materiality to the claims.
-

情報開示陳述書(IDS) 提出

- ファミリーとなる外国出願に対する引用文献は、関連性等(X、Y、A)に関らず全て提出する。引用文献はクレームの特許性判断につき、何らかの重要性(materiality)を持つ可能性が高い

IDS Practice

- Benefit –

- Reduce the potential for unnecessary RCE or late certification fees.
 - Reduce attorney time and potential delays in citing prior art.
 - Create less room for a defendant to challenge a patent's validity due to a patentee's failure to cite material prior art.
-

情報開示陳述書(IDS) 提出

- 適切なIDS提出で不要なRCEと庁費用が節約できることも

IDS Practice – QPIDS

- Quick Path Information Disclosure Statement – Use after issue fee has been paid
 - In the past, would need to file an RCE and Petition to Withdraw from Issue
 - Now, the USPTO will usually consider the IDS without needing an RCE or petition*
 - Must make a 3 month certification (e.g. reference(s) were first cited within the last 3 months)
 - We do not need a QPIDS if application is allowed and issue fee is not paid
-

情報開示陳述書 (IDS) の提出 – QPIDS

- クイックパス情報開示陳述書 (QPIDS) – 特許料金の支払後に利用
 - ・以前は、継続審査請求 (RCE) 及び特許発行の取り下げ申請の手続きが必要であった。
 - ・現在、USPTO (米国特許商標庁) は、通常、継続審査請求 (RCE) や上記申請の必要なしに情報開示陳述書 (IDS) を考慮する。

After Final Continuation Pilot (AFCP 2.0)

- **Problem - After a final rejection, an applicant is generally not entitled to further consideration of the application without filing an RCE.** Thus, amendments submitted after finally are generally not given much weight or examination.
 - **Solution –**
 - **Under the AFCP 2.0 program, an examiner is provided with additional time to review an applicant' response and amendment when filed after a final rejection.**
 - If an applicant's submission meets the requirements of an AFCP 2.0 program (including any EOT fees), then the examiner may consider the response under the AFCP 2.0 program.
 - **This may help avoid the expense of filing an RCE to have the examiner review and search the same amendments.**
 - Currently available through September 30, 2020. This program has been renewed in the past and we are hopeful it will be renewed again.
-

最終拒絶後の補正要件緩和・再審査申請(AFCP 2.0)

- 問題点...最終拒絶後は、一般にRCE(継続審査請求)なく継続審査は認められない
- 解決策
 - ・AFCP 2.0によると、審査官に対し、最終拒絶後に出願人の意見書や補正を再考する時間が付与される
 - ・同内容の意見書や補正を審査官に再考させるための、RCE申請の費用を節約できる

High Quality Translations

- **Problem –**
 - While many translations may be technically correct, many translations still render specifications and claims difficult to read and understand.
 - This could cause an Examiner to misinterpret the claims and issue a bad rejection.
 - This could also cause the claims to be interpreted with the wrong scope (narrowing the scope of protection) or cause a patent to be declared invalid.
 - **Solution – Have a native language speakers perform additional reviews prior to filing.**
 - We currently spend approximately an hour reviewing newly translated claims and attempt to spot issues for revisions.
 - Additional time/money can be devoted to revising the specification and claims to place the application in better US form. An extra few hundred dollars spent in the beginning could shave \$1000s off the cost of an application.
 - Alternatively, consider devoting more resources to more valuable applications (when the portfolio is too large to support such a review for every application).
 - **Benefits –**
 - Enable the examiner to understand the claimed invention in a shorter period of time and potentially reduce one or more response cycles.
 - Reduce Section 112 rejections and interpretations.
 - Reduce chance that claim are misinterpreted or rendered invalid.
-

翻訳について

- 問題点...明細書やクレームは技術的には正しく翻訳されていても、読みづらく理解しにくいものが多い
- 解決策...出願前にネイティブが内容を再確認する
- 効果...審査官が短時間でクレームの発明を理解でき、応答回数を減らすことができる

Other Tips to Reduce Cost

- File Complete Application
 - With Declaration to avoid \$160 USPTO Fee (and attorney fee)
 - Pre-Appeal Brief Request for Review
 - “free” review of 5 page response/arguments after a final rejection – used in conjunction with a notice of appeal
 - (No claim amendments possible – just arguments traversing the rejection)
-

費用削減に係るその他の助言

- 全て揃った状態の出願書類を提出する。
 - 宣言書と同時に提出することで、160ドルの庁費用(さらに特許弁護士費用)を節約できる。
- Pre-Appeal Brief Request for Review (審判請求理由書前のレビュー請求)
 - 最終拒絶後に「無料」で5ページの応答書／意見書をレビュー (審判請求を同時に提出)
 - (クレーム補正は認められていない – 最終拒絶理由を否認する意見書のみ認められている)

Questions/Contact Information

- Dennis M. Hubbs is a US Patent Attorney / Registered Foreign Attorney in Japan and a founding partner of HEA. Dennis works in the Tokyo office in Roppongi 7-chome.
- 米国特許弁護士 デニス・ハブス
- Email: dennis@hea-ip.com
- Phone: 03-5843-1939
- Website: www.hea-ip.com