

## Accelerated Examination/Appeal Examination of Patent Applications\*

FY2005 The First Subcommittee,  
The First Patent Committee

### (Abstract)

Among the systems that can be used for effective acquisition of patents, which were mentioned in the September 2005 issue of this journal (Journal of JIPA, Vol.6, No.1, p.42 (2006)), the accelerated examination and accelerated appeal examination systems are particularly familiar systems for users (see "CHIZAI KANRI" (Intellectual Property Management), Vol. 55, No. 10, pp. 1463-1471 (2005)). This article introduces the key points of practices related to the accelerated examination and accelerated appeal examination systems from the viewpoint of increasing the convenience for users.

**Q1.** What kind of system is the accelerated examination system?

**A1.** In the accelerated examination system, if an applicant requests an accelerated examination for his or her patent application and the application is found to satisfy the specified requirements, the Japan Patent Office (JPO) starts the substantial examination of the said application earlier than that of ordinary applications without any requests for an accelerated examination, and carries out the examination so as to complete the accelerated examination procedure without undue delay.

There is a similar accelerated appeal examination system for the procedure of appeal against an examiner's decision of refusal for patent applications.

The current "Guidelines on Accelerated Examination and Accelerated Appeal Examination" (hereinafter referred to as the "Guidelines" in this article) have been implemented since July 1, 2004.

**Q2.** What is the average period to the first Office Action for accelerated examinations?

**A2.** According to last year's results released by the JPO, the average period from the applicant's request for an accelerated examination until the first Office Action by the examiner

(the first action pendency) was 2.7 months in 2002, 2.5 months in 2003, and 2.6 months in 2004 (based on "Japan Patent Office Annual Report 2005" on the JPO website [Reference Room]).

Incidentally, as for regular examination system for the ordinary applications, the average period from the applicant's request for an examination normally until the first Office Action by the examiner (the first action pendency) was 24 months in 2002, 25 months in 2003, and 26 months in 2004 (based on the same source).

In this manner, examination under the accelerated examination system commences about ten times faster than one for the ordinary application.

**Q3.** What types of applications are qualified for accelerated examinations?

**A3.** Patent applications for which an examination has been requested and which correspond to any of the following four types of applications are qualified for accelerated examinations. The request for accelerated examination can also be filed at the same time as the request for examination.

(1) Working invention-related applications

These are patent applications for inventions that are worked by the applicants them-

\* "CHIZAI KANRI" (Intellectual Property Management), Vol. 56, No.6, pp. 919-923 (2006)

selves or by persons who have received a license from the applicants (including cases in which the applicants or licensees plan to work the inventions within two years from the date of submission of the later-mentioned Explanation of Circumstances Concerning Accelerated Examination).

In the pharmaceutical field, if a clinical trial notification has been submitted for the invention, the application is treated as a working invention-related application, but if such notification is scheduled to be submitted within two years, the application is not treated as a working invention-related application (see "Outline of Accelerated Examination and Accelerated Appeal Examination" on the JPO website [Activities JPO]).

(2) Internationally-filed applications

These are patent applications which the applicants have also filed overseas or filed as international applications under the Patent Cooperation Treaty (PCT).

(3) Academic institutes-related applications

These are patent applications where all or some of the applicants are specified universities, public research institutes, or Technology Licensing Organizations (TLO).

(4) Applications filed by small and medium-sized enterprises (SMEs)

These are patent applications where all or some of the applicants are specified SMEs or individuals.

**Q4.** How can a request for accelerated examination be made?

**A4.** The applicant submits an Explanation of Circumstances Concerning Accelerated Examination (hereinafter referred to as the "Explanation of Circumstances" in this article) to the JPO for each patent application in order to request accelerated examination. There is no need to pay any additional fee to the JPO.

**Q5.** What should be written in the Explanation of Circumstances?

**A5.** The Explanation of Circumstances should contain bibliographic items, such as the application number and the name of the submitter, as well as an explanation of circum-

stances concerning accelerated examination. The explanation of circumstances is particularly important, and it should include (1) the circumstances and (2) disclosure of and comparison to prior art.

It should be noted that the Explanation of Circumstances is subject to public inspection (see Q12).

**Q6.** How should "(1) the circumstances" in A5 be described?

**A6.** The matters to be described in "(1) the circumstances" differ among the four types of applications from (1) through (4) explained in A3.

(1) Working invention-related applications

The applicants should describe that the invention is being worked or is scheduled to be worked (see the description example in the Guidelines).

It is possible to omit detailed explanations such as the status of working. Descriptions as to the place where the invention is worked/scheduled to be worked, the time of starting to work the invention, and the embodiment of the invention are not mandatory (see "Q&A on Accelerated Examination and Accelerated Appeal Examination (Patent Applications)" (2004) on the JPO website [Activities JPO]).

(2) Internationally-filed applications

The applicants should describe the fact that an application for the invention has also been filed overseas, indicating the application number and the gazette number given by the foreign country (organization) or the international application number. Submission of copies of the filed documents can be omitted.

If none of the above numbers have been given yet, the applicants can, instead of describing the above numbers, describe the relevant foreign country (organization) and the filing date and attach a copy of the request that has been submitted upon filing the foreign application.

(3) Academic institutes-related applications

The applicants should describe the fact that all or some of the applicants are specified universities, public research institutes, or TLOs.

**(4) Applications filed by SMEs**

The applicants should describe the fact that all or some of the applicants are specified SMEs or individuals.

**Q7.** How should “(2) disclosure of and comparison to prior art” in A5 be described?

**A7.** The matters to be described in “(2) disclosure of and comparison to prior art” do not differ among the four types of applications from (1) through (4) explained in A3, but differ according to the prior art to be disclosed.

- i) Where there are prior art search results of a foreign patent office or other relevant organization

The applicants can describe the documents that have been cited as search results of the foreign patent office or other relevant organization.

The “comparison to prior art” should be described by comparing the claimed invention and the content of the prior art.

If the applicants have obtained a written opinion of an international searching authority or an international preliminary examination report written in the Japanese language, they can omit description of the “comparison to prior art” by attaching the opinion or report to the Explanation of Circumstances.

- ii) Where search results of prior art or related art are disclosed in the specification

If the search results are sufficient and the comparison to prior art is sufficiently made in the specification by indicating the names and gazette numbers of the relevant documents, it is enough to specify the relevant part of the specification that described such matters.

If the search results are sufficient but the comparison is insufficient, the applicants need to specify the relevant part of the specification as well as sufficiently describe the comparison to prior art.

- iii) Cases other than i) and ii) above

The applicants should describe the prior art search results as well as the comparison to prior art. In addition, they should describe the scope of the prior art search by indicating the search means, such as the Industrial Property

Digital Library (IPDL), and the keywords used for the search. If no prior art was found, the applicants should describe the art most relevant to the invention.

**Q8.** Is it possible to request an accelerated examination based on a draft amendment without submitting a written amendment?

**A8.** Yes, it is possible. The applicants can present a draft amendment in the Explanation of Circumstances and describe the “disclosure of and comparison to prior art” based on this draft amendment.

**Q9.** How does the JPO determine whether or not to conduct an accelerated examination of an application for which such request has been made?

**A9.** The Directors of the respective examination divisions determine whether or not to conduct an accelerated examination of a certain application. The main criteria for the determination are as follows:

- Whether the application meets the requirements mentioned in A3 above
- Whether prior art is precisely disclosed

**Q10.** Does the JPO notify the requester of its determination on whether or not to conduct an accelerated examination of the application?

**A10.** Only when the JPO decides not to conduct an accelerated examination of the application, does it notify the applicant(s) (or the patent attorney) by a postcard together with the reasons therefor.

Even if the JPO has decided not to conduct an accelerated examination, the applicant(s) can request an accelerated examination of the application again.

**Q11.** Is there any way that third parties can learn that an accelerated examination is being or has been conducted for a certain application?

**A11.** Yes, there is. Third parties can learn that an accelerated examination is being or has been conducted for a certain application by checking the following:

- The status information in the IPDL
- The front page of the patent gazette
- The file wrapper

(see “Q&A on Accelerated Examination and Accelerated Appeal Examination (Patent Applications)” (2004) on the JPO website [Activities JPO])

**Q12.** Are Explanations of Circumstances available for public inspection?

**A12.** Yes, they are. Irrespective of the JPO’s decision to conduct an accelerated examination of the relevant application, Explanations of Circumstances are made available for public inspection, similarly to the filed documents.

**Q13.** Is there any way to acquire information on the total number of accelerated examinations or the number of accelerated examinations for a certain company?

**A13.** Yes, there is. There are commercial databases that allow searches for such information.

**Q14.** What kind of system is the accelerated appeal examination system?

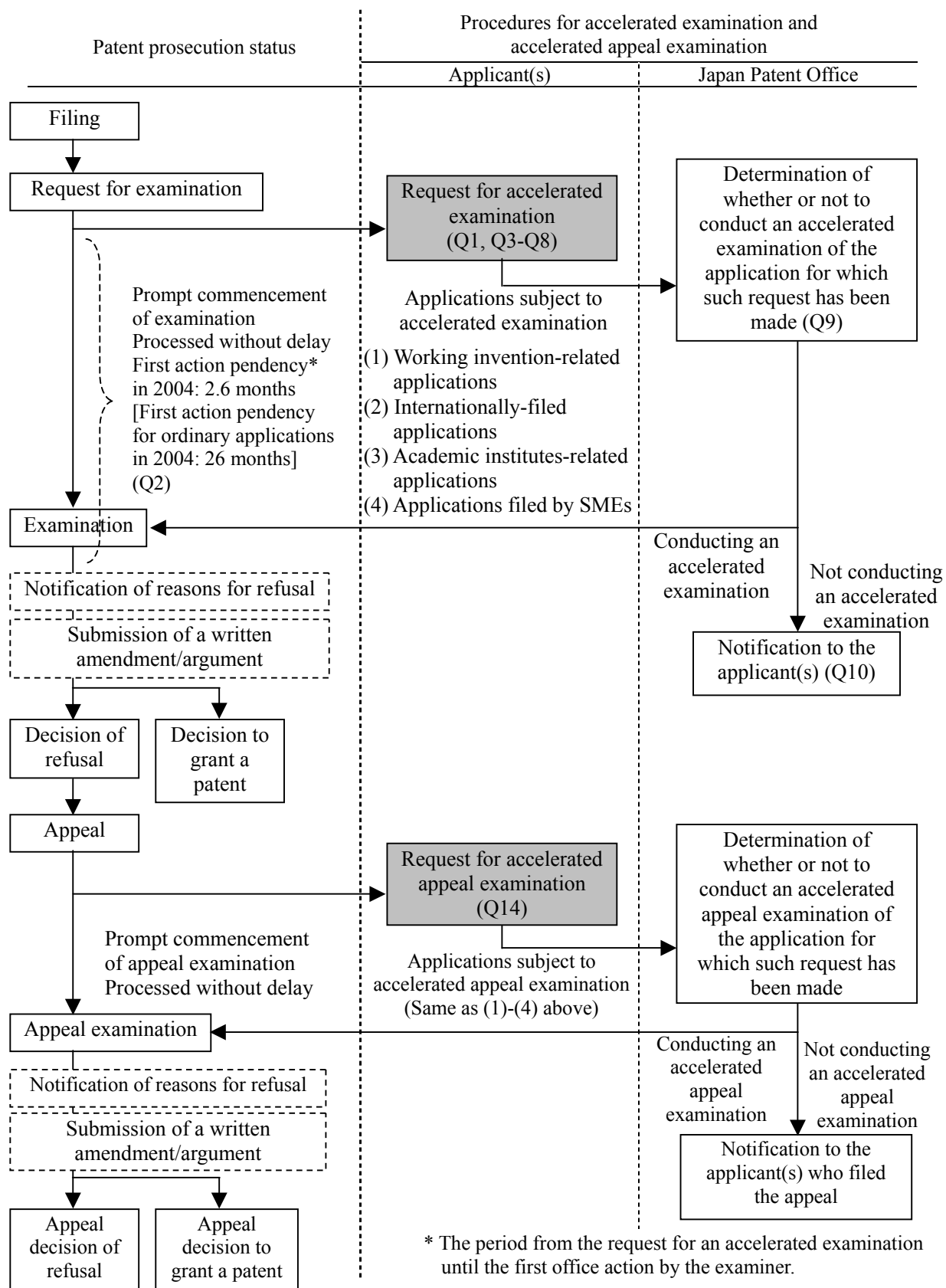
**A14.** Similar to the case of the accelerated examination system, in the accelerated appeal examination system, if an applicant requests an accelerated appeal examination for his or her application and the application is found to satisfy the specified requirements, the Japanese

Patent Office (JPO) starts the appeal examination of the said application earlier than ordinary applications, and carries out the appeal examination so as to give a disposition without delay.

This system is only applicable to appeals against an examiner’s decision of refusal. Even if the application is already subject to accelerated examination, the applicants need to file a separate request for accelerated appeal examination.

The procedure is more or less the same as that for the accelerated examination, but there is no need to describe the “disclosure of and comparison to prior art” in the Explanation of Circumstances. If the application is already subject to accelerated examination, the applicants only need to write, “Same as the descriptions in the Explanation of Circumstances Concerning Accelerated Examination,” in the “Explanation of circumstances concerning accelerated appeal examination” column.

The following chart shows the flow of procedures taken by the applicants and the JPO under the accelerated examination and accelerated appeal examination systems in chronological order, along with the patent prosecution status. The numbered Qs in the chart correspond to those of the Q&A above.



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