



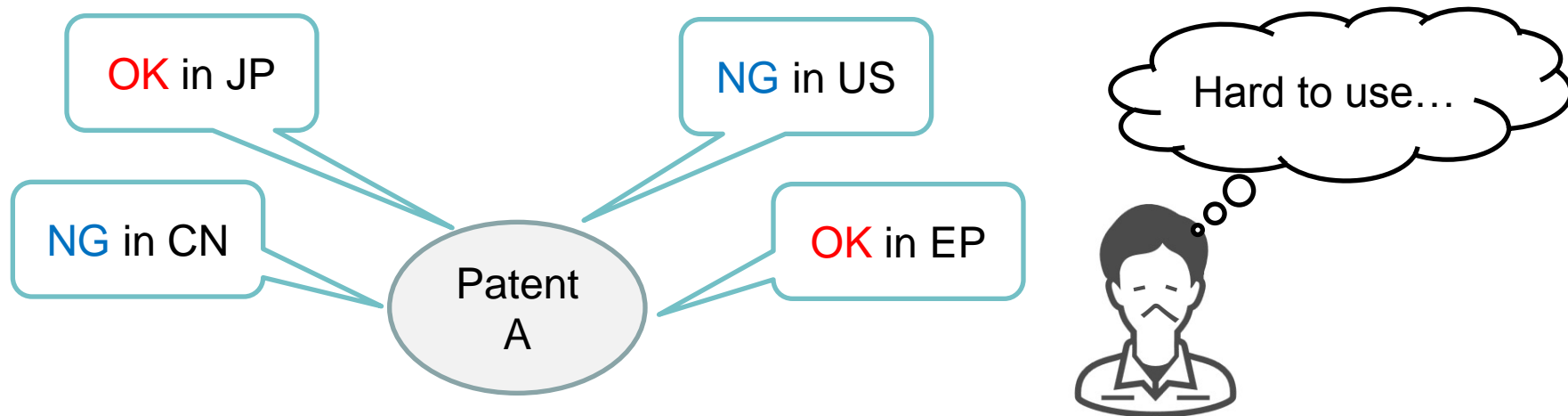
High-Quality Patents

*from the Study about JP-US Collaborative
Search Pilot Program (JP-US CSP)*

JIPA 1st Patent Committee, 1st patent subcommittee
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introduction

Corporate capital in patent strategies is gained by globally effective patent rights



“High-quality patent” from the user’s viewpoint is...
“Patent with strong global validity”

◆ Subcommittee’s activities in 2016

From the factual study of JP-US Collaborative Search Pilot Program,
to allow realization of “Patent with strong validity”,
possibility of harmonization of international substantive
examination was found

introduction

■ JP-US CSP: Collaborative Search Pilot Program

In accelerating globalization of business activities in recent years, there is a growing need for obtaining patent rights in foreign countries.

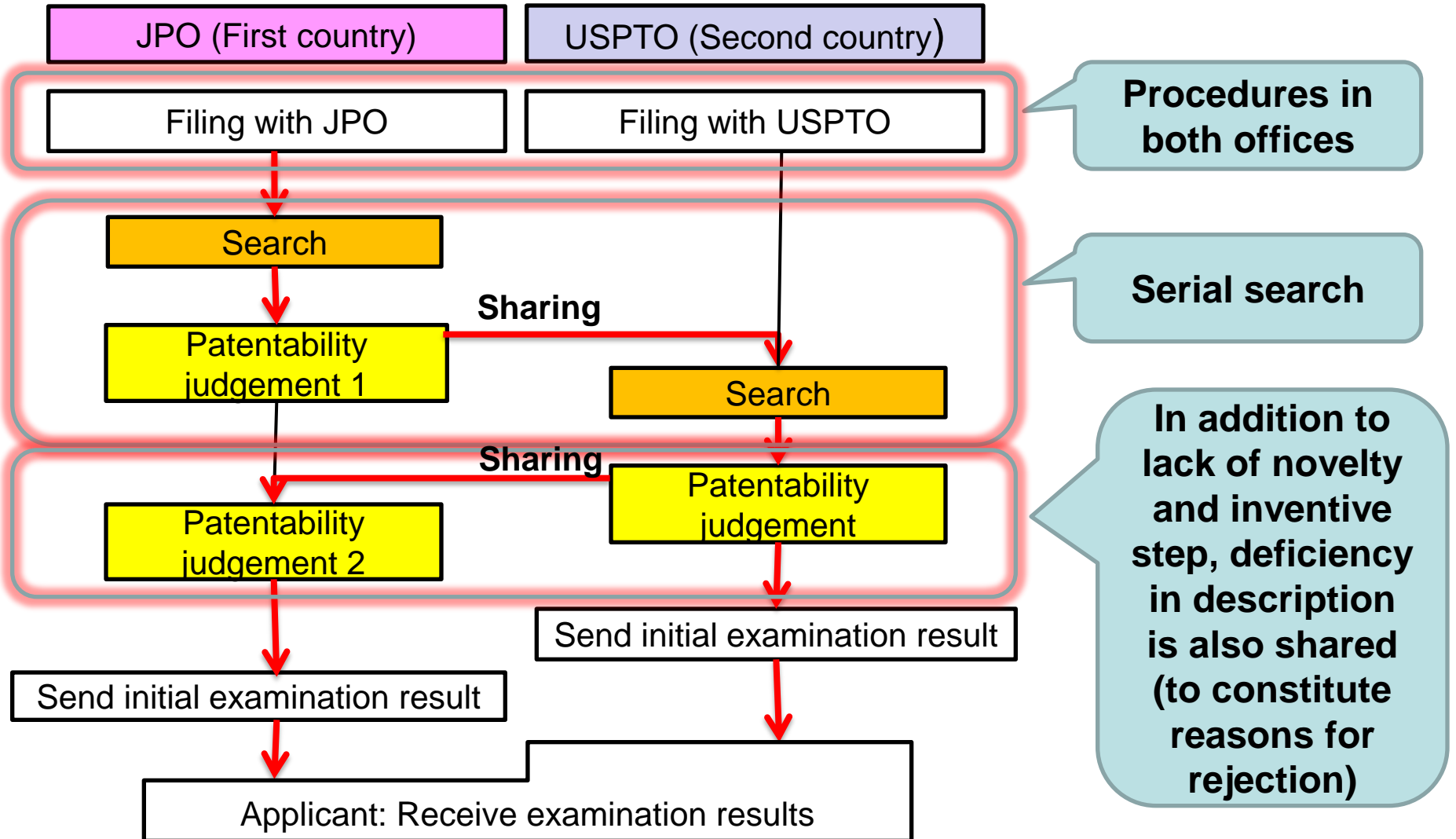


“CSP” commenced as enforcement program on August 1, 2015!

➡ Enforcement program for both JPO and USPTO to conduct [prior art search](#), share search results and [patentability judgement](#) based on the result, and send initial examination results from both offices around the same time.



Process Flows of CSP

■ Procedure of JP-US Collaborative Search



Outline of JP-US Collaborative Search

■ Requirements for requesting JP-US collaborative search

Item	Japan 	US 
Number of claims	Up to 20 claims (3 independent claims) for each application	
Correspondence	Containing corresponding independent claim(s)	
Period of accepting request	Before commence of examination (the requirement of having been published was cancelled in August 2016)	
	(Request for examination of application is required)	(Request for expedited examination is required)
Identity of priority date	Corresponding independent claims relate to the identical earliest priority date	
Filing date, etc.	Priority date/filing date fall on or after March 16, 2013 for all applications	
Unit of accepting request	A group of technically relevant applications (up to 5 applications)	1 application
No duplication with other requests	On condition that requests for have not been made: - Collective examination corresponding to business strategies - Expedited examination - Super expedited examination	-
Unity	Unity of invention is satisfied	
Upper limit of requests	About 10 requests annually for each applicant	

Features (advantages) of JP-US Collaborative Search

■ Advantages of utilizing JP-US collaborative search (considered in light of PPH)

Time requirement

Allowed to file a request at an early stage without waiting for an examination result from one office

Number/unit of requests

Allowed to file a request collectively for a group of technically relevant applications

Search to Examination

Facilitate **stabilization of the right** while suppressing accidentally finding a prior art

Submission of IDS

Reduce a burden of submission of IDS by the applicant before examination in Japan

Possibility of amendment

Allowed to freely make an amendment after the first examination in both JP and US



“stabilization of the right” needs to be verified

Approach to study about JP-US CSP

- (I) We collected the 40 cases with non-CSP (JP-US), for comparison. (we selected them considering applicant and examination date related to the following case.)
- (II) We collected the 33 cases with CSP(JP-US).

- We study about consistency of novelty and non-obviousness for (I) and (II).
- We study about matching rate of the references regarding novelty and non-obviousness for (I) and (II).

Analysis of non-CSP cases as reference

Novelty Rejection			Non-Obviousness Rejection			No Rejection		
J P	U S	Number of cases	J P	U S	Number of cases	JP	US	Number of cases
None	None	15	None	None	8	Allowed with no rejection		2
None	Rejection	7	None	Rejection	1			
Rejection	None	4	Rejection	None	23			
Rejection	Rejection	14	Rejection	Rejection	8			
Total		40	Total		40			

- Consistency of Novelty Judgement : $(15+14) / 40 = 73\%$
 *Matching rate of the cited Reference : $2 / 14 = 14\%$
- Consistency of Non-obviousness judgement : $(8+8) / 40 = 40\%$
 *Matching rate of the main cited References : $0 / 8 = 0\%$

Analysis of JP-US CSP cases

Novelty Rejection			Non-Obviousness Rejection			No Rejection		
J P	U S	Number of cases	J P	U S	Number of cases	JP	US	Number of cases
None	None	22	None	None	9	Allowed with no rejection		4
None	Rejection	3	None	Rejection	7			
Rejection	None	0	Rejection	None	11			
Rejection	Rejection	8	Rejection	Rejection	6			
Total		33	Total		33			

- Consistency of Novelty Judgement : $(22+8) / 33 = 91\%$
 *Matching rate of the cited Reference : $7 / 8 = 88\%$
- Consistency of Non-obviousness judgement : $(9+6) / 33 = 45\%$
 *Matching rate of the main cited References : $4 / 6 = 67\%$

Table of CSP VS non-CSP

	CSP	non-CSP
Consistency of Novelty Judgement	91% Improvement	73%
*Matching rate of the cited Reference	88% Remarkable Improvement	14%
Consistency of Non-obviousness judgement	45%	40%
*Matching rate of the main cited References	67% Remarkable Improvement	0%

<Comments>

High Matching rate of References regarding Novelty & Non-obviousness. Consistency of Non-obviousness judgement is less than expectation. 10

Conclusion of JP-US CSP

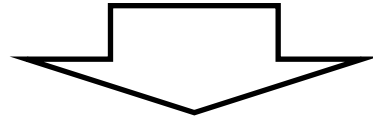
- Consistency of Novelty judgement improve,
if we submit the CSP.
- Matching rate of the references improve,
if we submit the CSP.

Users probably could consider JP and US OA
in the same response policy.

**CSP is so beneficial program for users to
handle the prosecution between JP and US**

Analysis of result about JP-US CSP

CSP is a program that allows sharing prior references searched at both offices



CSP realized improvement of matching rate of cited references for denial of novelty and also improvement of matching rate of novelty judgements

From the above ...

CSP is the system directly connected to improvement of matching rate of novelty judgements among countries
or

it was confirmed that CSP suppresses accidentally finding a prior art relevant to novelty judgement and contributes to stabilization of the right

Analysis of result about JP-US CSP

Discrepancy factors in novelty judgements between JP and US under Non-CSP

- 1) Difference in claim interpretation
- 2) Difference in identification of cited reference
- 3) Difference in the extent of search of cited reference

Though setting international harmonization for novelty judgement has been considered difficult ...

-- Consideration --

- From the substantive research and analysis of CSP, it was found that improvement of matching rate of cited references for denial of novelty also contributes to improvement of matching rate of novelty judgements.
- **If it is possible to internationally harmonize cited references for denial of novelty, it may be possible to realize international harmonization of novelty judgement.**

Analysis of result about JP-US CSP

- In order to achieve a patent with strong global validity, **global harmonization of substantive examination including inventive step judgement is required**
- However, there are too many elements to be clarified for harmonization of substantive examination including inventive step judgement (e.g. standards for handling hindrance of combination, types of effect to be referenced, definition of those skilled in the art, standards for prior art judgement, how to handle the object, and so on.)

- If we aim at harmonizing novelty judgement, **one element required for the harmonization of substantive examination will be eliminated** to give a course for the harmonization.
- Some scenarios supposed to accelerate harmonization of novelty judgement are introduced.

A scheme of harmonization of novelty judgement

Step 1 : Improvement of search circumstance

(If cited references are consistent, opinions on novelty are highly likely consistent)

- Establish rules to resolve discrepancy in patent classifications imparted among countries
 - Reduce the risk of oversight in the search based on patent classifications

- Develop a global search system beyond language barriers
 - Allow accurate search of publications written in languages other than the mother tongue
(Development of translation technology by AI is expected)

A scheme of harmonization of novelty judgement

Step 2 : Share prior references for denial of novelty in a standardized format

(Share the result of the prior reference search harmonized in Step 1)

- Display matching states of prior references for denial of novelty among offices as follows:

	JP	US	EP	CN	KR
Reference A	○	○	×	×	×
Reference B	×	×	○	×	○
Reference C	×	×	×	○	×

- Provide the information by utilizing the “List of references cited by examiner” column in CCD, GDS and OA
→ Can be realized without changing current operation and easily confirmed

A scheme of harmonization of novelty judgement

Step 3: Harmonize novelty rejection logics

- Share rejection logics rendered by each office
- Discuss specific process to be taken by each office at international conferences, etc.

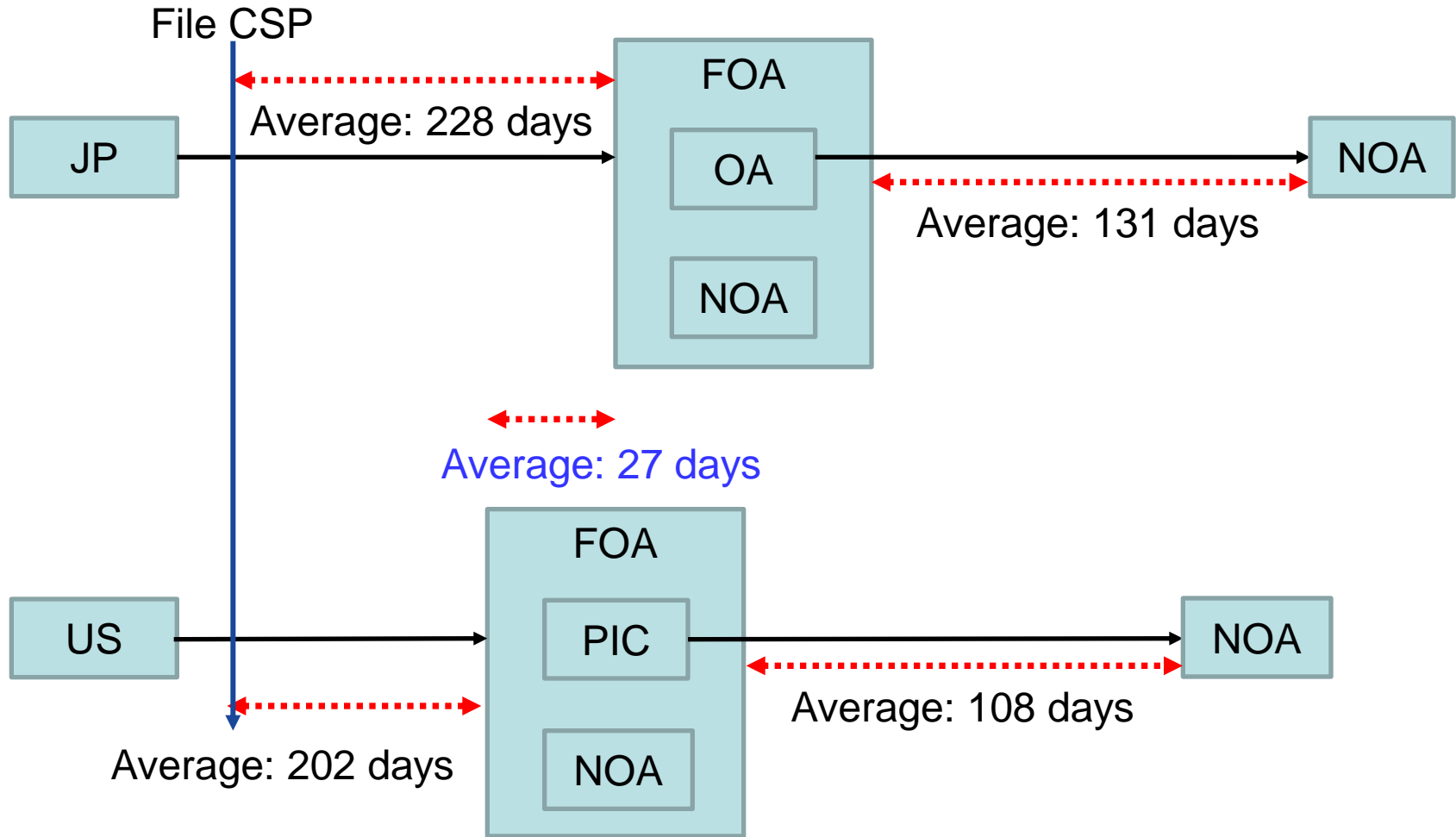
Through these measures, advance global harmonization of novelty requirement and further advance harmonization of substantive examination including inventive step judgement.



Realization of **patent with strong global validity** is expected.

One more thing ...

Analysis of sending period of US-JP CSP



We can receive the JP and US FOA around the same time. This means we can respond to the JP and US FOA **at the same time.**

Message for you

- Aim to achieve best examination all over the world. (ex. Quality, Speed...anything OK.)
(Your examination quality will be better,
Other office examination will be better to follow.
→Big benefit for users because realize the
patent with strong global validity.
(Global means not only particular region of the
world but whole of the world.)