

Guidelines for the Use of Prior Art Search Results and Examination Results Provided by Foreign Patent Offices

1. Basic policy

In the examination of overseas-related applications*1, in order to reduce the examination workload and to improve the quality of the examination, it is important to effectively use prior art search results and examination results provided by foreign patent offices.

In particular, with regard to the applications for which an accelerated examination has been requested under the Patent Prosecution Highway (PPH)*2, one must make best use of the prior art search results and examination results provided by foreign patent offices while in the process of conducting an examination, because the PPH program aims to make it easier for applicants to obtain patent rights overseas quickly, and also aims to enable the patent offices to reduce the examination workload by using prior art search results and examination results provided by the patent office of first filing, while improving the quality of the examination.

Therefore, in the examination of overseas-related applications, the JPO shall use prior art search results and examination results provided by foreign patent offices in the following procedure.

*1: An “overseas-related application” means a patent application of which the applicant has also filed applications with patent offices or intergovernmental organization other than the JPO or filed international applications with regard to the same invention (e.g., domestic applications based on which priority is claimed for international applications; international applications that have entered into the national phase).

*2: Under the Patent Prosecution Highway (PPH), an application for which the office of first filing (OFF) has decided to grant a patent is eligible for an accelerated examination through the simple procedure at the office of second filing (OSF). Where the applicant desires a normal accelerated examination through the ordinary procedure at the JPO or the USPTO, he is required to carry out a prior art search and describe the comparison between the prior art and the claimed invention, thereby explaining the patentability of the claimed invention to the OSF. Under the PPH, the applicant can omit to these requirements by submitting to the OSF the claims to which the OFF has granted a patent and the office actions that have been given by the OFF (see “Patent Prosecution Highway Pilot Program between the JPO and the USPTO”).

2. Procedure of Examination

(1) Prior art search

Where search results provided by a registered search agency are unavailable in the examination of an overseas-related application, the examiner shall carry out a prior art search through the following procedure.

- i) The examiner shall refer to the prior art search results and examination results concerning the corresponding foreign application that have been provided by the foreign patent office. The examiner is not required to carry out an additional prior art search

himself/herself if he/she considers it possible, based on his/her knowledge and experience, to conduct an examination precisely and efficiently by using such search results.

- ii) The examiner shall carry out an additional prior art search himself/herself where he/she considers it impossible, based on his/her knowledge and experience, to conduct an examination precisely and efficiently by using only prior art search results or examination results concerning the corresponding foreign application, which have been provided by the foreign patent office*3. In this case, unless the examiner considers it highly probable, based on his/her knowledge and experience, to find more significant prior art documents in the scope already searched by the examiner of the foreign patent office, the scope already searched by the foreign patent office shall be excluded from the scope of the additional search.

(For instance, where the JPO examiner uses prior art document search results provided by the USPTO, the US patent bulletins or publications of US patent applications shall be excluded from the scope of the additional search unless it is considered highly probable to find more significant prior art documents from among these US documents.)

*3: With regard to the applications for which an accelerated examination has been requested under the PPH, the JPO can use the examination results indicating that patents have been granted to the corresponding foreign applications.

- iii) Where the examiner considers it possible, based on his/her knowledge and experience, to find relevant prior art documents more efficiently by carrying out a prior art search himself/herself rather than referring to the prior art search results provided by the foreign patent office, he may carry out an additional prior art search before referring to the prior art search results concerning the corresponding foreign application, which have been provided by the foreign patent office.

Where search results provided by a registered search agency are available in the examination of an overseas-related application, the examiner shall carry out an additional prior art search through the procedure described in above i) to iii) if, having referred to the search results provided by the registered search agency, he/she considers it impossible, based on his knowledge and experience, to conduct an examination by using only such search results.

(2) Examination of prior art documents, etc.

Where the highly relevant prior art documents obtained through the above-mentioned procedure are included in the scope of the prior art search results provided by the foreign patent office, the examiner shall take into account the prosecution history and examination results (finding of cited invention, rationale of the reason for refusal, final result of examination, description of the claim granted a patent) at the foreign patent office to judge whether any of the contents of the prior art documents gives a reason for refusal of the claimed invention in terms of novelty or inventive step. In this case, the examiner should take notice of the difference between the Japanese examination system and practice and those of the foreign country.

(3) Examination on other reason for refusal

When considering the existence of a reason for refusal in terms of the deficiency in descriptions or claims, the examiner shall also take into account the prosecution history and examination results (content of the notice of reasons for refusal, final result of examination, description of the claim granted a patent) at the foreign patent office, while taking notice of the differences between the Japanese examination system and practice and those of the foreign country.