

Analysis Results of the US-JP Collaborative Search Pilot Program Phase 2

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ADMINISTRATIVE AFFAIRS DIVISION

The US-JP Collaborative Search Pilot Program (herein after referred to as the US-JP CSP) is the framework in order to support users to obtain more robust and stable patent rights through accelerated process.

In this program, examiners of the Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO) independently conduct their own prior art searches for an invention of a patent application filed in both Japan and the U.S., and after sharing search results and opinions with each other, the two Offices respectively send their first examination results to the applicant early and simultaneously.

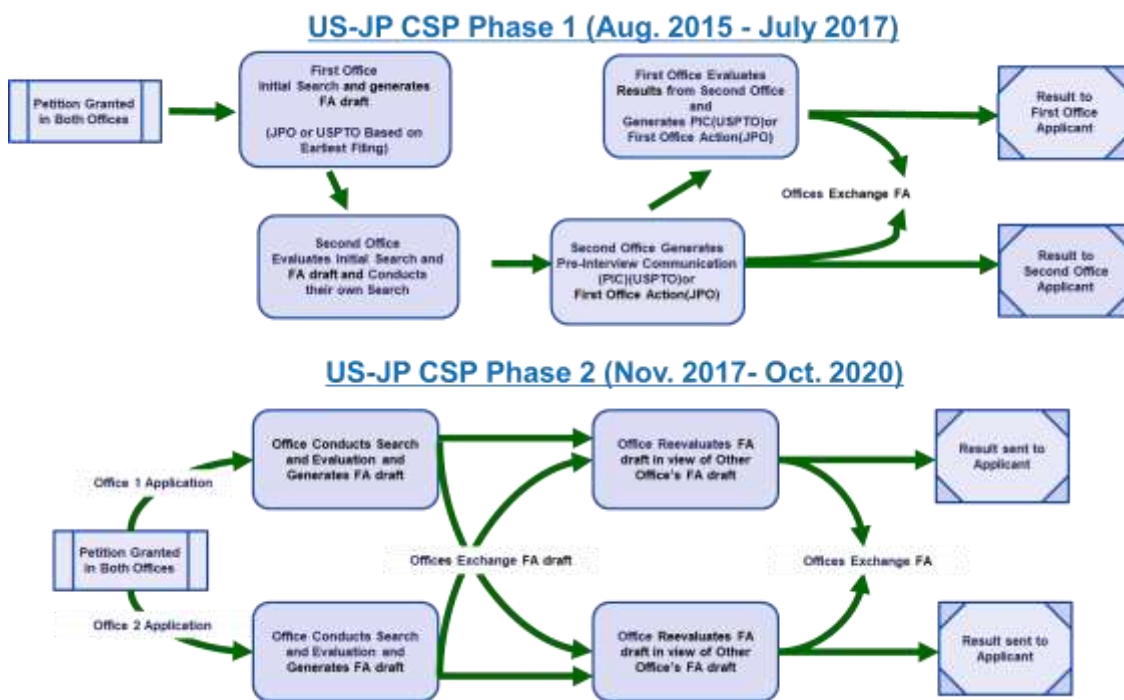
Following Phase 1¹ of the US-JP CSP, which ran for two years from August 2015 to the end of July 2017, Phase 2 ran for three years from November 2017 to the end of October 2020, and the JPO has now analyzed the results of Phase 2.

1. Changes in Phase 2

In Phase 1, a serial scheme was adopted, where the second Office had to wait for the FA draft prepared by the first Office and then prepared its FA draft.

In Phase 2, a parallel scheme was adopted, where both Offices prepared each FA draft independently and simultaneously aiming to notify the initial examination results to the applicant earlier than the previous scheme by eliminating the waiting period of the second Office to prepare its FA draft.

¹ For the Phase 1 analysis results, see [“Analysis Results of US-JP Collaborative Search Pilot Program Phase 1”\(PDF:223KB\)](#)



2. Distribution of Request

The following tables show the distribution of technical fields granted for the US-JP CSP.

	Number of Request granted
Phase 1	64 (in 2 years)
Phase 2	79 (in 3 years)

IPC Section	A	B	C	D	E	F	G	H
Phase 1	7	3	13	0	0	2	31	8
Phase 2	5	11	7	0	0	0	23	33

3. Analysis of Determinations by both Offices

(1) Analysis results of Novelty/Inventive Step Determination in FA by both Offices

Table 1 shows the analysis results of Novelty/Inventive Step Determination of the cases in Phase 2 of the US-JP CSP.

Note that these analysis results are based on the Initial Examination Results (FA²).

² As for the Phase 1 at the USPTO, “Pre-Interview Communication (PIC)” in First Action Interview System was used as the initial examination results (FA), instead of a usual Office action.

Regarding "Determination for Novelty/Inventive Step", "Different Determination for Novelty/Inventive Step" is applied if the case has at least one independent claim having a different Novelty/Inventive Step Determination. As for the "cited documents," "Same documents" is applied if at least one cited document is commonly used by both Offices to the independent claims in the case, regardless of whether it is a primary or secondary cited document, or a document indicating well-known technology.

Number of cases granted for the US-JP CSP (Phase 2)					
	<u>Same</u> Determination for Novelty/Inventive Step in both Offices				<u>Different</u> Determination for Novelty/Inventive Step in both Offices
	<u>YES</u> for Novelty/Inventive Step	<u>NO</u> for Novelty/Inventive Step			
		<u>Same</u> documents	<u>Different</u> documents		
79	67	4	23	40	12

Table 1: Analysis results of Novelty/Inventive Step Determination for the US-JP CSP

The analysis results of Novelty/Inventive Step Determination in Phase 2 show that the concordance rate in determination between both Offices is 80% (67 out of 79 cases), which is almost the same rate as in Phase 1.

27 cases out of those 79 cases, including those determined as having Novelty/Inventive Step (4 cases) and those determined as having no Novelty/Inventive Step (23 cases) in which the "Same documents" were used, were found to be consistent in their determinations and cited documents.

While both Offices share the same determination of "No for Novelty/Inventive Step", there were 40 cases where the cited documents used as Reasons for Refusal were different, which is a significant increase compared to Phase 1 (33% in Phase 1 and 51% in Phase 2). In 36 of these cases, the same documents were not cited, but at least one of the Offices indicated that the documents presented by the other Office could also construct Reasons for Refusal.

This indicates that the reason for the increase in the percentage of the cases using different documents as Reasons for Refusal in Phase 2 could be due to the scheme change from a serial scheme to a parallel scheme in Phase 2. That is because in Phase 1, it is conceivable that the Second Office did not need to cite additional documents if the documents presented in the FA draft already presented by the First Office were equivalent to the documents presented by the Second Office.

Furthermore, in the cases where both Offices have made different determinations, there is a case that the USPTO has rejected using a document that the JPO has not identified as a cited document because of a different publication date from that of the USPTO.

(2) Analysis results of additional documents by the other office

There were 10 cases in which the JPO added some documents to the documents presented by the USPTO in generating a FA draft. On the other hand, there were 4 cases, in which the USPTO added some documents to the documents presented by the JPO.

The above findings confirm that the concordance rate in determination between both Offices has not changed compared to Phase 1 and although the concordance rate for the cited documents has decreased, each Office notifies the applicant the initial examination results after considering the documents presented by the other Office.

4. Examination Period

The period from the acceptance of requests to the dispatch of FA is summarized as follows.

	At the JPO: from Acceptance of Request to Dispatch of FA (days)	At the USPTO: from Acceptance of Request to Dispatch of FA (days)	Time lag between both Offices to dispatch FA (days)
Phase 1	169	133	41
Phase 2	96	109	29

Compared to Phase 1, the period from the acceptance of requests to the dispatch of FA of each Office and the time lag between both Offices to dispatch FA was shortened. Therefore, it can be concluded that the goal of sending the initial examination results to the applicant early (within 6 months) and simultaneously (within 1 month time lag between both Offices to dispatch FA) were achieved in many cases through the US-JP CSP.

This may be because the parallel scheme was adopted in Phase 2 instead of the serial scheme in Phase 1, which eliminated the waiting period of the Second Office to receive the FA draft from the First Office. The above results suggest that the scheme change in Phase 2 was effective in that the applicant who cross-files patent rights in the U.S. and Japan can obtain the initial examination results early and simultaneously.

5. User Feedback

Benefits using the US-JP CSP from user evaluation:

- The US-JP CSP is easy to use in terms of quick process from filing an application to obtaining the initial examination results and less burden of IDS submission.
- “I’ve been able to obtain the initial examination results from both Offices at around the same timing (less than a month time lag), which allows me to respond to both Offices in the same manner”.

6. Conclusion and discussion of Phase 2 analysis results

The US-JP CSP is aiming to provide users with robust and stable rights as early as possible. Based on the analysis results above, the JPO believes that Phase 2 pilot has achieved certain goals in the following aspects:

- Despite the concern of dropping the concordance rate in determination due to the scheme change in Phase 2, there was almost no change in the rate.
- Though the concordance rate for the cited documents between both Offices dropped due to the scheme change in Phase 2, there were a certain number of cases where the Office added the cited documents presented by the other Office for the initial examination results. In such cases, it was found that the determinations resulted from the cross-referenced cited documents by both Offices.
- The Phase 2 scheme change allowed both Offices to provide the initial examination results to the applicant earlier than Phase 1 scheme.

It is recommended for applicants who file their patent applications both in Japan and the U.S. to utilize the US-JP CSP.