

Procedure to file a request to the JPO for the US-JP Collaborative Search Pilot Program

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ADMINISTRATIVE DIVISION

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I. Introduction

In recent years, as business activities have become increasingly global, companies including those of Japan have a growing need to obtain patent rights in foreign countries where manufacturing hubs and customers are located. (The number of foreign patent applications filed by Japanese companies in 2019 was approximately 208,000.)

In order to assist global Japanese companies in obtaining patent rights in foreign countries, the Japan Patent Office (JPO) has been enhancing examination cooperation with the United States Patent and Trademark Office (USPTO). For example, as one of the world's leading IP Offices, the JPO started the world's first Patent Prosecution Highway (PPH) program with the USPTO in 2006.

At the same time, the JPO has been committed to the "world's fastest and highest quality patent examination" and needs to make further efforts to establish an Intellectual Property (IP) system that will "enable a patent granted by the JPO to be granted by other IP Offices with a certainty."

In light of this situation, the JPO and the USPTO agreed in principle to cooperate in patent examination on June 6, 2014 in Busan, Republic of Korea, with a view to pursuing improvement in the quality of examination through collaborative efforts between JPO and USPTO examiners.

The JPO and the USPTO signed a Memorandum of Cooperation (MOC) in Suzhou, China on May 21, 2015 to launch a US-JP Collaborative Search Pilot Program (hereinafter called the "US-JP CSP") on August 1, 2015. After completing a two-year pilot program as the first phase, the two Offices implemented a three-year pilot program as the second phase under a new operation scheme starting November 1, 2017. The Offices then implemented a two-year pilot as the third phase under the same scheme from November 1, 2020 and have agreed to extend this pilot until October 31, 2024.

The US-JP CSP is a program in which JPO and USPTO examiners respectively conduct a prior art search for cross-filed patent applications to share search results along with opinions and respectively provide initial examination results to the applicant early and around the same time. In order to qualify for the program, The applications must satisfy all of the request requirements mandated by the respective Offices.

The JPO and the USPTO eased the request requirements on August 1, 2016 by accepting unpublished applications into the US-JP CSP, making the program more accessible.

Only applications satisfying the request requirements are examined under the US-JP CSP while applications not satisfying the request requirements are subjected to regular examination.

The summary workflow of the US-JP CSP is as follows.

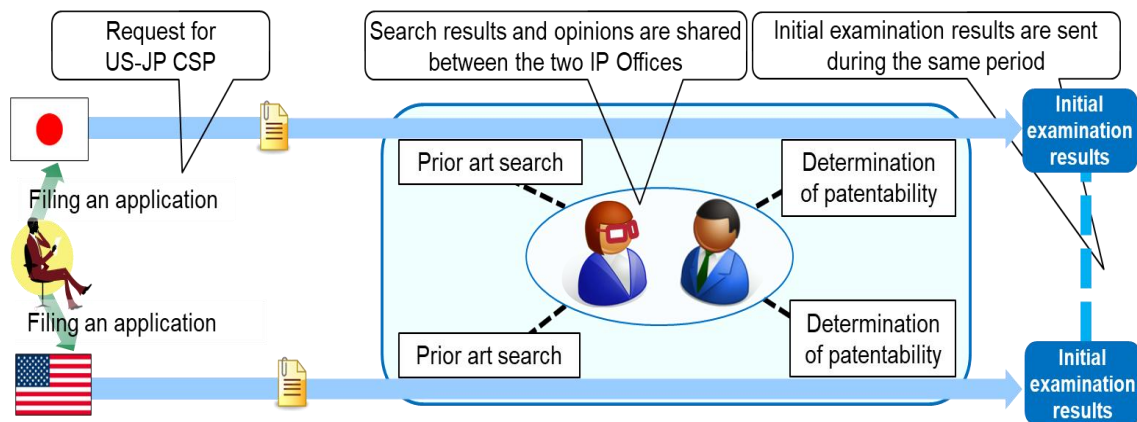


Fig. 1: US-JP CSP Summary Workflow

The US-JP CSP enables Japanese companies to better predict the timing of examination and patent grant for applications cross-filed with the two Offices and obtain more stable and stronger patents in both countries earlier and around the same time based on the examination results provided by JPO and USPTO examiners, encouraging Japanese companies to expand global business.

Furthermore, for a group of technically related applications filed together, the examiners of the two Offices will respectively provide initial examination results in the same time period, allowing the applicant to receive the examination results of those applications during the same time period.

<Benefits of the US-JP CSP>

- Applicants can better predict the timing of examination and grant of patent rights because JPO and USPTO examiners respectively send examination results early and around the same time for a group of technically related applications filed together.
- Applicants can obtain stronger and more stable rights because JPO and USPTO examiners conduct collaborative prior art searches for a group of applications having common themes.
- USPTO examiners can develop confidence in JPO's examination results by fully understanding the search and examination techniques adopted by JPO examiners, and JPO examiners can improve the quality of searches and examination by

understanding the search and examination techniques adopted by USPTO examiners.

- Applicants can have more freedom in establishing the scope of right because the US-JP CSP allows freely amending applications after the notification of initial examination results. Under the PPH, claims in a corresponding application filed with the Office of Later Examination (OLE) need to correspond to claims in an application filed with the Office of Earlier Examination (OEE) and considered to be patentable by the OEE.
- Applicants do not need to submit to the USPTO an IDS listing prior art documents that JPO examiners cited in initial examination results.

The US-JP CSP contributes to the JPO's commitment to the "world's fastest and highest quality patent examination" while supporting companies with global business development and helping to foster innovation.

II. Applications eligible for the US-JP CSP

Any application filed with the JPO (hereinafter called "JP application") can participate in the US-JP CSP if it has a corresponding application filed with the USPTO (hereinafter called "US application") and satisfies all the requirements mandated by the JPO. The US application must also satisfy the [requirements mandated by the USPTO](#).

Request Requirements:

- 1) The JP application must contain three or fewer independent claims and twenty or fewer total claims.
- 2) Each independent claim in the JP application must substantially correspond to independent claims in the US application. A decision as to whether the corresponding independent claims of the two applications substantially correspond to each other will be made on a case-by-case basis, and they are considered to "substantially correspond" when an independent claim in the JP application has substantially the same scope as that in the US application.
- 3) The JP application must be ready for substantive examination and it must not have begun. If the JP application is unpublished at the time of request for the program, a copy of the claims in the US application must be submitted to the JPO. If the JP application is not ready to be examined, the JPO will contact the applicant. The

applicant can check the status of the application by either:

- (6) making an online request to the JPO (paid services); or
- (ii) accessing J-PlatPat on the JPO website (available for published applications only).

The applicant can also contact the Examination Policy Planning Office, Administrative Affairs Division at 03-3581-1101, ext. 3103.

“Substantive examination has not begun” means that none of the notices listed below issued either by the Commissioner or an examiner of the JPO has not been received by the applicant.

- Notice of Reasons for Refusal (Article 50 of the Patent Act)
- Certified Copy of an Examiner’s Decision (Article 52 (2) of the Patent Act)
- Notice of Failure to Disclose Prior Art in the Patent Description (Article 48-7 of the Patent Act)
- Order for Consultation in a case where two or more patent applications were filed for the identical invention(s) on the same date (Article 39 (6) of the Patent Act)

- 4) Corresponding independent claims in the JP and US applications must have the same earliest priority date.
- 5) Both the JP and US applications must have the earliest priority or filing date no earlier than March 16, 2013¹.
- 6) A request for substantive examination must have already been filed. (The program and examination can be requested at the same time.)
- 7) A request for the program must be filed per application. However, a group of five or less technically related applications can be filed together with the JPO only when the request is filed with both Offices according to a procedure specified in the next section.
- 8) Any request must not have been made for collective examination for IP portfolio supporting business strategy, accelerated examination, or super-accelerated examination. When such a request has been made, the application qualifies for the program if the request is withdrawn.

III. Requesting the US-JP CSP

1. How to request the US-JP CSP

¹Only applications filed after the implementation of the US AIA (America Invents Act) shall qualify for the US-JP CSP.

The applicant can choose from two ways to file a request: (i) file with one Office; (ii) file with both Offices. In either case, filing is free of charge at both Offices.

(i) File a request with one Office

The applicant submits a combined request form to only the JPO or the USPTO (See Fig: 2-1).

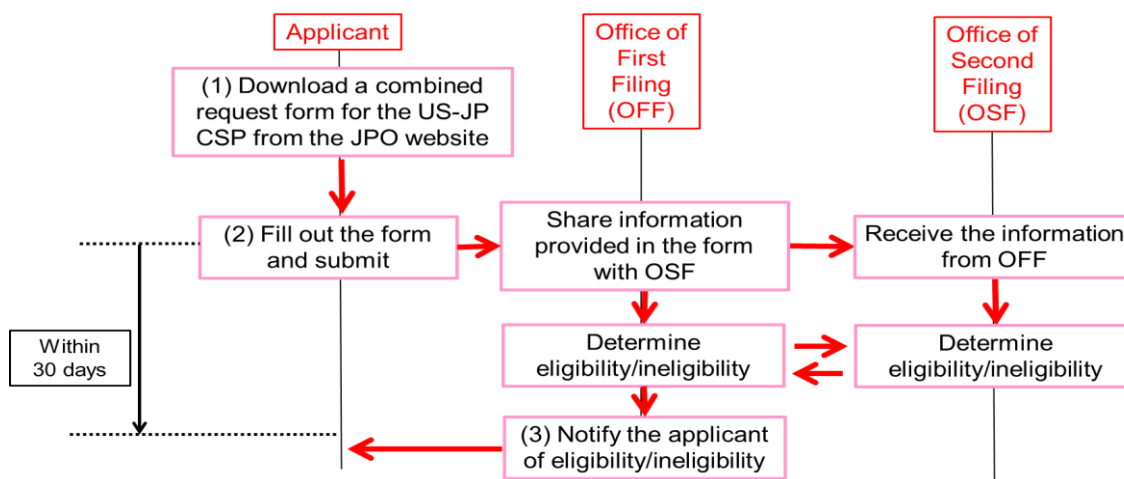


Fig 2-1: Request procedure when filing with one Office

(1) Preparation and submission of a request form

The applicant downloads a combined request form from [the JPO website](#), fills out the form and submits it to the Office of First Filing. When submitting to the JPO, please password-protect the form and send it to the Administrative Affairs Division at PA2260@jpo.go.jp. If the CSP is requested for an unpublished application, please attach an English translation of all claims of the application as of the request date. Make sure to password-protect the translation of the claims since it includes unpublished information.

The applicant needs to separately email the password(s) to the Office of First Filing. Submission to the USPTO can be made via EFS-Web or Patent Center.

(2) Notification of eligibility

The JPO will check the submitted request form for any deficiencies and inform the USPTO whether the JPO grants the request. If the application is eligible for the program, the JPO will notify the applicant of such eligibility determination within 30 days of the submission of the request form.

If the application is not eligible based on the information provided in the request form, the JPO will notify the applicant of such ineligibility determination.

(ii) File a request with both Offices

The applicant submits a request form to one Office and, within 15 days, submits another request form to the other Office (See Fig: 2-2).

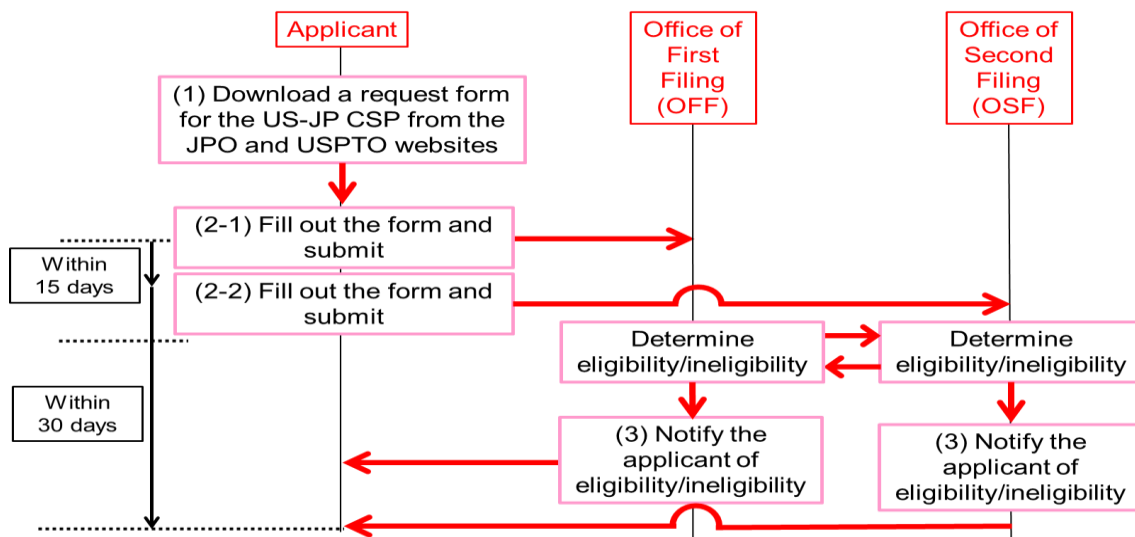


Fig 2-2: Request procedure when filing with both Offices

(1) Preparation and submission of a request form

The applicant downloads a request form from [the JPO website](#), fills out the form and submits it to the Office of First Filing. When submitting to the JPO, please password-protect the form and send it to the Administrative Affairs Division at PA2260@jpo.go.jp. The applicant needs to submit another request form to the USPTO within 15 days from the submission to the JPO.

For the submission to the JPO, if the CSP is requested for an unpublished application, please attach a copy of the claims of the US application as of the request date. Make sure to password-protect the copy of the claims since they include unpublished information.

The applicant needs to separately email the password(s) to the Office of First Filing. Submission to the USPTO can be made via EFS-Web or Patent Center.

(2) Notification of eligibility

The JPO will check the submitted request form for any deficiencies and inform the

USPTO whether the JPO grants the request. If the application is eligible for the program, the JPO will notify the applicant of such eligibility determination within 30 days of the submission of the request form.

If the application is not eligible based on the information provided in the request form, the JPO will notify the applicant of such ineligibility determination.

2. Eligibility determination for the US-JP CSP

After the submission of the request form, the JPO will promptly check the request for any deficiencies (e.g. incorrect application number) and see if the application satisfies the request requirements. For any correctable deficiencies in the request, the JPO will ask the applicant for correction.

The JPO will determine if the application satisfies the request requirements and inform the USPTO of its determination. At a later date, the JPO will notify the applicant by email whether the application is eligible or ineligible taking into account the determination made by the USPTO.

3. Things to keep in mind before filing a CSP request

- When requesting the CSP for a group of technically related applications, please mark the checkbox on your request form indicating that the request is for “grouped applications,” provide any number identifying the grouped applications, and explain technical relationships among the applications.
- Applications filed for collective examination for IP portfolio supporting business strategy, accelerated examination, or super-accelerated examination are not eligible. When any of these examinations has been requested, applications become eligible if such a request is withdrawn.
- The program requires that the US and JP applications have substantially corresponding independent claims; the applications are not eligible if they are amended prior to a CSP request and the claims in the two applications no longer correspond to each other. Even if amendments are made prior to the request, applications will still qualify as long as the claims correspond to each other.
- The two Offices grant up to 400 applications per year. The Offices will stop receiving requests once the limit is reached. The updated figure is available on the [USPTO's Collaborative Search Pilot Program \(CSP\) website](#).
- There are no restrictions on the technical fields examined under the US-JP CSP.
- If the application is unpublished at the time of request, the applicant is required to submit a request form to the JPO by email with a password-protected copy of

corresponding claims in the US application. And when filing with the USPTO, the applicant is required to submit an English translation of corresponding claims in the JP application (machine translation is acceptable). For further information about the USPTO's procedure, please visit [USPTO's Collaborative Search Pilot Program \(CSP\) website](#).

IV. Workflow of the US-JP CSP

The workflow of the US-JP CSP after the JPO notifies the applicant of its eligibility determination is shown below:

(This workflow applies to both cases of JPO as the Office of First Filing and USPTO as the Office of First Filing.)

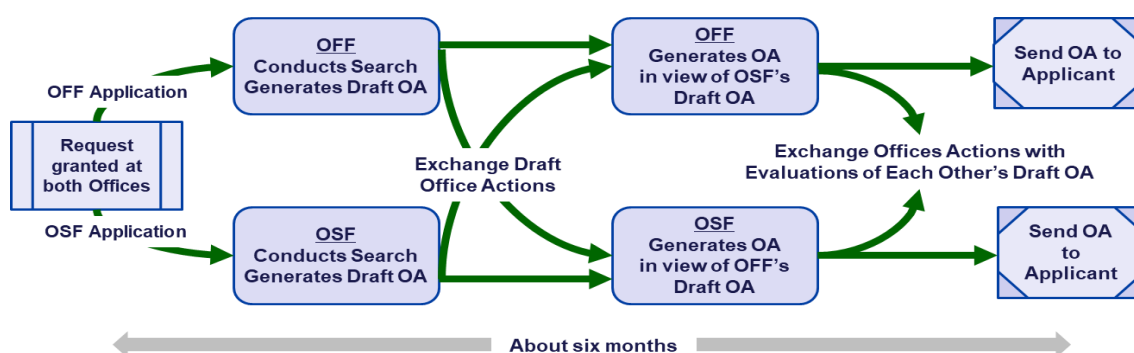


Fig. 4. Workflow of the US-JP CSP

- 1) The JPO and the USPTO each conduct a prior art search and determine the patentability of the application. The two Offices then exchange their draft office actions (draft first actions (FAs)).
- 2) The two Offices each conduct a prior art search and determine the patentability of the application in view of each other's draft FAs. In this stage, the Offices closely check each other's patentability determination to generate their respective FAs as initial examination results.
- 3) The two Offices each send their FA to the applicant within about six months of the CSP request.
- 4) The JPO sends a first Notice of Reasons for Refusal or a Decision to Grant a Patent as FA and the USPTO sends a regular office action as FA instead of a Pre-Interview Communication (PIC). Please refer to the [USPTO's Collaborative Search Pilot](#)

[Program \(CSP\) website](#) for more details related to the procedure at the USPTO.

- 5) If the USPTO is unable to send the JPO its draft FA containing search results and opinions for some reason, the JPO sends a first Notice of Reasons for Refusal that only contains the JPO's search results in about four months since the date of grant of the CSP request.
- 6) The process following the sending of FAs will not be carried out under the US-JP CSP, and the applications will be examined in accordance with the regular examination procedure of each Office. This allows the applicant to consider the scope of right appropriate for each country based on the FAs and make necessary amendments to each application.

V. Other things to keep in mind

1. Information Management

The US-JP CSP requires, from a request to the completion of examination, a great deal of caution and consideration to manage filed information and examination documents as applications contain sensitive information related to the international business development of applicants.

For example, applicants are advised to ensure that any filed information sent to the JPO by email is properly protected, such as by encrypting the information with a password. If the application is unpublished at the time of the request, make sure to password-protect the copy of corresponding claims in the US application since they include unpublished information.

2. Notice in case four months have passed since the date of granting a request for the US-JP CSP

As a general rule, the two Offices exchange draft FAs within four months of granting a request for the US-JP CSP. However, if the USPTO's draft FA is unavailable within that period for some reason, the JPO will send the applicant a notice that says "four months have passed since the JPO granted your request for the US-JP CSP, but we have not received search results from the USPTO as of today. We thus send you our initial examination results only based on our search results."

3. User satisfaction survey about the US-JP CSP

To further improve the US-JP CSP, the JPO will conduct a user satisfaction survey after the sending of FAs. We will appreciate your kind cooperation.

4. Contact Information

Please contact the following for all inquiries related to the US-JP CSP.

Examination Policy Planning Office, Administrative Affairs Division,
Patent and Design Examination Department, Japan Patent Office
Phone: 03-3581-1101 (Extension 3103)
e-mail: PA2260@jpo.go.jp

You can also contact the USPTO directly at the following. In that case, please include the JPO e-mail address (PA2260@jpo.go.jp) in CC.

International Work Sharing, Planning, and Implementation
U.S. Patent and Trademark Office
Phone: +1-571-272-8050
e-mail: csp@uspto.gov