

KEY TAKEAWAYS

Patent Prosecution: Latest Trends and Best Practices in Asia

Kilpatrick Townsend partners [Hitoshi Akiba](#), [Charles Gray](#), and [Kris Reed](#) recently presented on the latest trends and best practices in Asia patent prosecution.

Key takeaways concerning patent prosecution in China, include:

1

On April 1, with its recent guideline changes, the Chinese Patent Office lowered the bar of patentability for software and business method patents. Previously, the guidelines stated that “[i]f a claim concerns only rules and methods for mental activities, it shall not be granted a patent right”; however, as of April 1st, the guidelines now state that “[i]f a claim relating to a business model includes not only business rules or methods, but also a technical feature, it should not be excluded from being patentable”. The door to software and business method patents is now open in China. Prior to April 1, such inventions were very difficult, if not impossible, to have patented.

Chinese patent enforcement has become more sophisticated. In recent years, a number of patent-specific courts have been organized in China increasing significantly the ability for foreign companies to prevail. We recommend that foreign companies take advantage of this change by utilizing the Chinese patent court system. For example, file Chinese invention and utility model patents directed to your competitor’s products (even if the foreign company does not have any plans to do business in China). Then, if the foreign company ends up in litigation or license negotiations with the Chinese company, they have leverage against the Chinese company in China.

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Choosing quality Chinese counsel can be difficult — in particular, if you do not read Chinese. Since the Chinese patent bar is relatively new, there are significant disparities in the quality and experience of Chinese patent attorneys and firms. We recommend that you rely on someone you trust, with Chinese language skills, and deep relationships with Chinese firms and their management.

The concept of guanxi (or roughly translated as deep relationships) is extremely important to all of your dealings in China. Guanxi will be the difference between success and failure. We recommend that prior to doing business in China, you leverage those with already established guanxi as well as spend time developing guanxi of your own.

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Key takeaways concerning patent prosecution in Japan, include:

1

The Japanese Patent Office (JPO) is getting more flexible and quicker about patent examinations. The allowance rate is getting higher every year and examination period is getting shorter.

In addition to the Patent Prosecution Highway, Accelerated Examination and Super Accelerated Examination are available before the JPO. First office action will be issued within 2.5 months for Accelerated Examination and within one month for Super Accelerated Examination.

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Now, the JPO is very proactive about offering interview examinations. Don’t hesitate pursuing this option.

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