

The Docketing Excellence Webinar Series



Understanding Docketing For the Appeal Process In China, Korea, And Japan



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Understanding Docketing For the Appeal Process In China, Korea, And Japan

- **Presenters and panelists:**
 - Ann McCrackin, President, Black Hills IP, LLC
 - Jennifer Bommentre, Foreign Filing Paralegal, Schwegman, Lundberg & Woessner, P.A.
 - Kristi Wheeler, Foreign Filing Paralegal, Schwegman, Lundberg & Woessner, P.A.

Topics

1. Appeal Process in China (“Reexamination”)
2. Appeal Process in Korea (“Reconsideration”)
3. Appeal Process in Japan
4. Comparison of the Appeal Process in the Three Countries

1. Chinese Appeal Process

- Decision of Rejection (Final Rejection)
- Notification of Reexamination
- Decision of Reexamination
 - Reexamination Decision Revoking the Decision of Rejection
 - Reexamination Decision Upholding the Decision of Rejection

Docketing Chinese “Decision of Rejection”

- Chinese "Decision of Rejection" is equivalent to U.S. Final Office Action
- Typically follows a response to an Office Action
- How to docket?
 - Docket a deadline to file “Request for Reexamination”
 - Due 3 months from Decision of Rejection
 - 15 day mailing period applies
- Extensions available?
 - Deadline to file Request for Reexamination is **NOT** extendable

Docketing “Reexamination Decision” – Revoking of Decision of Rejection

- Chinese “Reexamination Decision Revoking the Final Rejection”
- Application is forwarded back to the original examiner by the PRB (Patent Review Board)
 - The examiner may do the following
 - Issue an Office Action (continue prosecution)
 - Issue a Notice of Allowance
- How to docket?
 - No deadlines for the Applicant at this point

Docketing “Notification of Reexamination”

- PRB (Patent Review Board) maintains the rejection and issues a Notification of Reexamination
 - The “Reexamination” process in China is equivalent to the Appeal process in the US
- How to docket?
 - Period for filing a response is 1 month
 - 15 day mailing period applies
- Extensions available?
 - One-time request for extension of 1 or 2 months

■ Docketing “Decision of Reexamination” – Maintaining Decision of Rejection

- Chinese “Decision of Reexamination – Maintaining Decision of Rejection”
- Typically follows response filed after the Notification of Reexamination communication
- How to docket?
 - Deadline to “File Divisional a Application”
 - Due 3 months from date of receipt of notification (15 day mailing period applies)
 - Deadline to “File Appeal in the Intellectual Property Court of Beijing Municipality of the PRC” (this is a law suit)
 - Due 3 months from date of receipt of notification (NO 15 day mailing period available)
- Extensions available?
 - Deadline is NOT extendable

2. Korean Appeal Process

- Notice of Final Rejection
- Notice of 2nd Final Rejection
- Appeal Decision Received

Korean Notice of Final Rejection

- “Notice of Final Rejection” received from the Korean Intellectual Property Office (“KIPO”)
 - Decision by the Examiner; Like a final OA in the US
- How to Docket?
 - Docket three items each due 30 days from receipt date of Notification of Final Rejection
 - Request for Reconsideration with Amendments (Returned to Examiner)
 - Notice of Appeal (No amendments; No “reconsideration” by the Examiner; Goes to the Intellectual Property Trial and Appeal Board “IPTAB”)
 - Divisional Application (Last chance if rejection is upheld)
- Extensions available?
 - Can be extended once for 60 days

Korean Notice of 2nd Final Rejection

- “Notice of 2nd Final Rejection” received from KIPO
 - Sort of like a final OA in the US, but the 2nd time you have more limited options on what you can do
- What to docket:
 - Notice of Appeal to the 2nd Final Rejection
 - Due 30 days from Notification of 2nd Final Rejection-extendable by 60 days from the initial due date of the Final Rejection)
 - Appeal brief due 4 – 6 weeks after filing Notice of Appeal
 - IPTAB sets the deadline after the Notice of Appeal is filed
 - Deadline to File Divisional
 - Due 30 days from Notification of 2nd Final Rejection
- Extensions available?
 - Can be extended once for 60 days

Korean Appeal Decision Received

- Appeal Decision received from KIPO maintaining the rejection
- What to docket:
 - Deadline to Appeal to Patent Court
 - Due 30 days from Appeal Decision Received
 - Can be extended once for 30 days
 - No divisional applications can be filed at this time.

3. Japan Reexamination Process

- Examiners Decision of Final Refusal (Decision of Rejection)
- Reexamination by Original Examiner (ZENCHI Examination)
 - Acceptance or Rejection
- Review by Board of Appeals
 - Acceptance or Rejection

Japanese Examiner's Decision of Rejection

- “Decision of Rejection” (also called Decision of Final Refusal) received from the Japanese Patent Office (JPO)
 - Decision by the Examiner; Like a final OA in the US
- How to Docket?
 - Docket three things 4 months (**3 months) from Decision of Rejection
 - Notice of Appeal to the Board of Appeals
 - Arguments and/or Voluntary Amendments
 - Precautionary Divisional Application
 - Extensions available?
 - No extensions available

Japanese Examiners Decision of Final Refusal (Decision of Rejection)

Domestic Applicant (Japanese **)

- Respond to Final Refusal (3 months from Decision of Final Refusal)
 - Appeal Final Refusal
 - File Voluntary Amendments/Arguments
- Deadline to File Precautionary Divisional
- Non-extendable

Overseas Applicant (Non-Japanese)

- Respond to Final Refusal (4 months from Decision of Final Refusal)
 - Appeal Final Refusal
 - File Voluntary Amendments/Arguments
- Deadline to File Precautionary Divisional
- Non-extendable

Japanese Reexamination by Original Examiner

- If there are amendments, the case is reconsidered by the Original Examiner
 - This is called “Zenchi Examination”
 - How to docket?
 - No deadlines to docket
- The Original Examiner may allow the application or may maintain the rejection
 - If allowed, then you receive a Notice of Allowance
 - Need to docket issue fees/annuities
 - A divisional application can be filed at this point.
 - If rejected, then the application goes back to the Board of Appeals to decide the Appeal.

Japanese Review by Board of Appeals

- The Appeal Board may issue its own Office Action (at the discretion of the Appeal Board)
 - How to Docket?
 - Docket a 3 month deadline for response.
- The Appeal Board issues a Decision of Appeal
 - Decision to Grant
 - Application goes to Allowance (No Official Notification of Allowance Received)
 - Applicant pays Issue Fees/Annuities
 - Cannot file a divisional application at this point
 - Decision of Rejection
 - Need to docket a 120 day deadline for the following:
 - File an suit with Japan's Intellectual Property High Court (law suit)
 - Power of Attorney due
 - Notarized copy of corporate certificate
 - Cannot file a divisional application at this point

4. Comparisons of Appeal Processes

- **Similarities between CN, KR and JP**
 - All three countries have an appeal board within the Patent Office that can review an Examiner's final rejection
 - All three allow an appeal to the appropriate court for a patent case if the appeal board upholds the Examiner's rejection
- **Differences between CN, KR and JP**
 - KR and JP limit when a divisional application can be filed
 - Terminology
 - Timelines

Comparison of When to Docket a Notice of Appeal

China

- After the Examiner's "Decision of Rejection"
- Docket 3-month deadline to file the "Request for Reexamination"

Korea

- After Examiner's "Final Examiners Rejection" or "Second Final Examiner's Rejection"
- Docket 30-day deadline to file "Notice of Appeal"

Japan

- After Examiner's "Decision of Rejection"
- Docket 3 or 4 month deadline to file "Notice of Appeal" (depending on location of the applicant)

Questions

- Questions on Today's Program
 - Please submitted your questions using the Q&A button on the control bar on your screen.
- If you have questions regarding Black Hills IP's services or processes, please contact:
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April 12, 2017 at 1:00 PM Central