



Change in Japan Patent Office (“JPO”) System for Requests for Extension

The JPO recently announced it will change its procedures regarding Requests for Extension to the term to respond to Office Actions on April 1, 2007.

Currently, only a single Request for Extension is allowed to obtain a 3-month extension to the deadline to respond to an Office Action.

From April 1, 2007, a Request for Extension may be filed for a 1-month extension, and an applicant may file up to 3 Requests for a total extension of 3 months, the longest an applicant can extend the deadline to respond to an Office Action, which is unchanged from the current practice.

Under the new system, an applicant can file 3 Requests for Extension simultaneously before the original deadline to respond to an Office Action or 3 separate Requests as each deadline approaches. **Any Request for Extension must be filed before a given deadline as is the current practice.**

For more details, please refer to the JPO’s announcement that can be found at:
http://www.jpo.go.jp/torikumi_e/t_torikumi_e/Change_Extension_Period.htm

Indicating a Reason for Extension has not previously been requested, but under the amended procedures, the applicant must specify a “justifiable” reason for the extension. According to the JPO’s announcement, requiring time for translation would be an acceptable reason; thus, TMI Associates recommends indicating the need for time to translate relevant documents as the reason for requesting the extension.

If we do not receive specific instructions from the applicant, we will indicate the reason on the Request for Extension is for preparing translations.

Please be advised that the costs related to preparing and submitting Requests for Extension to the JPO are: Official Fees of JPY2,100 per month plus Attorney Fees of JPY12,000 per filing. Accordingly, if you would like to obtain a 3-month extension by filing 3 Requests for Extension simultaneously, the total costs would be JPY18,300. Alternatively, if you file 3 separate Requests for Extension each filed per months, the total costs would be JPY14,100 x 3 filings.

Lastly, this change to the JPO’s procedures will take effect from April 1, 2007. Even if the filing date of an application or the issuance date of a Notice of Reasons for Rejection is earlier, the new system will apply to any Request for Extension submitted after April 1, 2007, for all patent applications.

Please contact us if you have any questions regarding the above.