



Patent Prosecution Today in Japan

30 July 2009

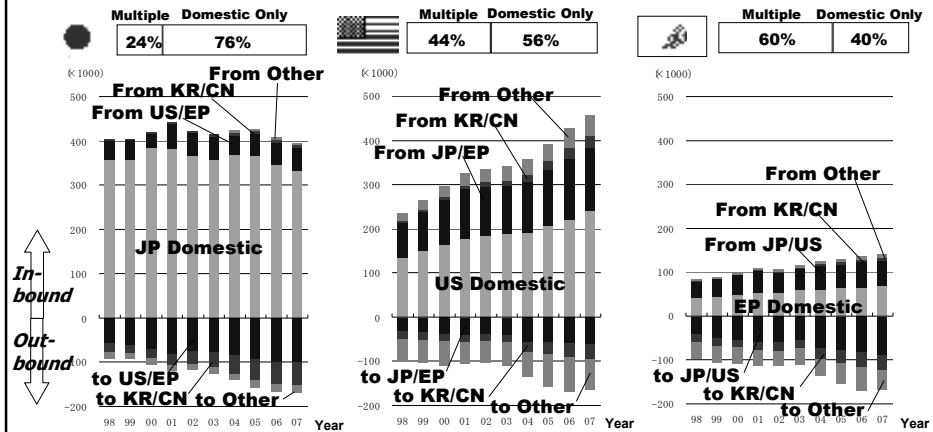
Koichi MINAMI
Deputy Commissioner
Japan Patent Office



Contents

- **Current Problems in Japan**
- **Supporting IP Management of Applicants**
- **Measures for Various Needs of Applicants**
- **Work-sharing among IP Offices**
- **Patent System Reform**

Domestic & International Filings



Japanese Filing Tendency

- ✓ Massive Number of Domestic Applications
- ✓ Low Percentage of Applications Filed in Multiple Countries (24%)

Many Inventions with no Protection in foreign countries

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Small R&D Expenditure per Application

R&D Budget and Domestic Applications

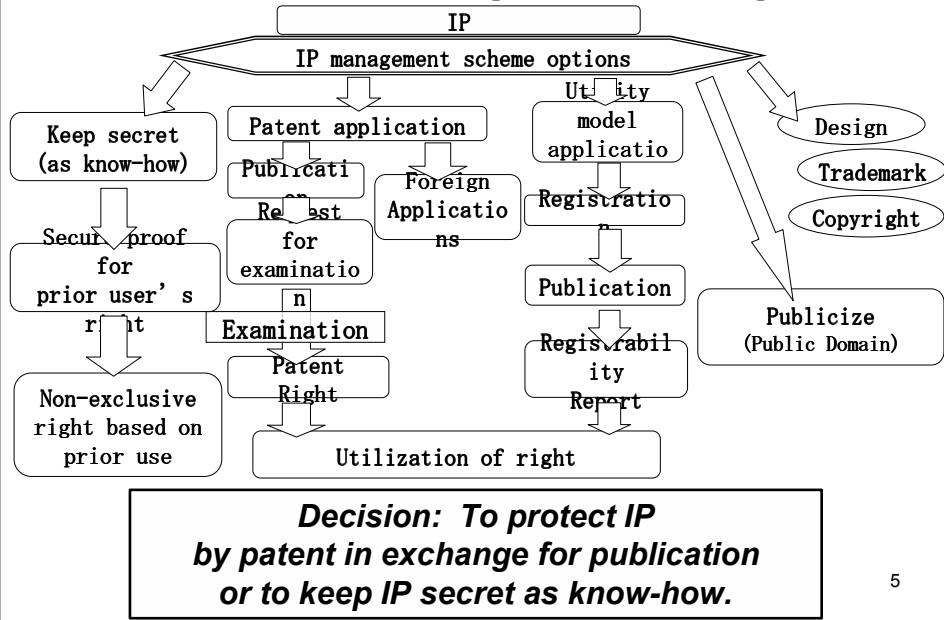
	JP	US	EP
R&D Budget in 2006 (A)	18.5 trillion (JPY)	42.8 trillion (JPY)	31.0 trillion (JPY)
Domestic Applications in 2007 (B)	333 thousand	241 thousand	68 thousand
R&D Budget Allocation per Application (A/B)	0.056 billion (JPY)	0.178 billion (JPY)	0.456 billion (JPY)



Extremely low R&D expenditure per patent application in Japan

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Promotion of Strategic IP Management



JPO Guides for Applicants

"Guide to Strategic IP Management"

April 2007

- ✓ Practical guide for strengthening corporate IP strategies
- ✓ Hearings of 150 companies from home and abroad
- ✓ Contains 600 cases including 100 failures

"Guide to Effective Use of Prior User's Rights"

June 2006

- ✓ Practical guide for securing Prior User's Rights when choosing to keep IP secret as know-how
- ✓ Based on an analysis of judicial precedents, expert opinions, business practices, etc.
- ✓ Explains notary system, electric time stamp, etc.

Portal Site for Supporting Corporate IP Strategy

- ✓ Collection of wide range of information for supporting strategic IP management of companies
- ✓ Customized patent filing profiles for self-analysis
- ✓ Data available for 10,000 corporate users

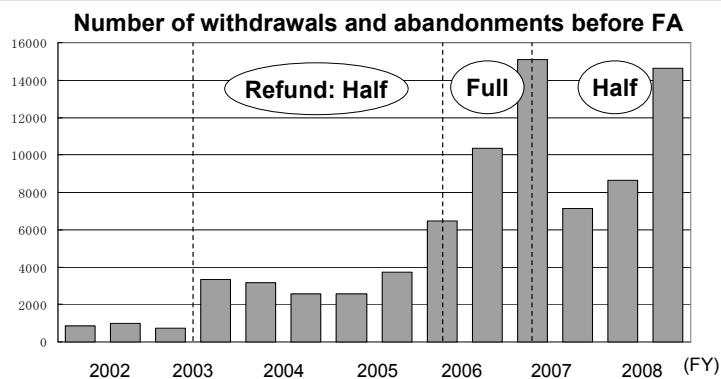
Sample Contents

1. Information about JPO measures on work-sharing with Foreign Patent Offices (ex. PPH, JP-FIRST, MSE, etc.)
2. Foreign Patent Laws and Rules
3. Information about JPO measures (e.g. Accelerated Examination, Encouraging Patent Licensing, etc.)
4. Inquiry of timing of First Action
5. Each Applicant's Specific and Statistical Data (e.g. Application Numbers, Percentage of Requests for Examination, Grant Rate, Examination Data, etc.) Downloadable
6. Information about Training Programs for Searchers

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Refund of Examination Request Fee

- ✓ Half of the examination request fee is refunded when:
 - An application is withdrawn or abandoned before FA, and
 - Request for a refund is made within 6 months(The entire amount of the examination request fee was refunded from Aug. 9, 2006 to Aug. 8, 2007)
- ✓ To promote reconsideration of the necessity to continue with the patent prosecution process



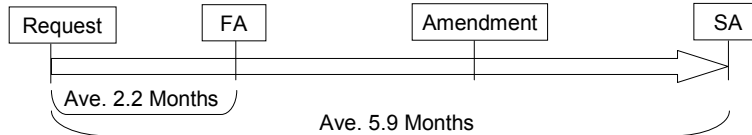
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- Measures for Various Needs of Applicants -

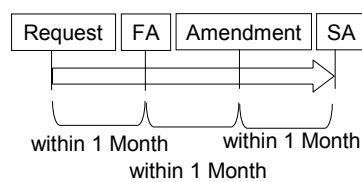
Accelerated / Super Accelerated Examination

- Accelerated Examination

Available for ✓ Applications for **working-related inventions**
 ✓ Applications filed **internationally**
 ✓ Applications filed by **SME, Individual or academy etc**



- Super Accelerated Examination



Available only for applications filed **internationally** for **working-related inventions**

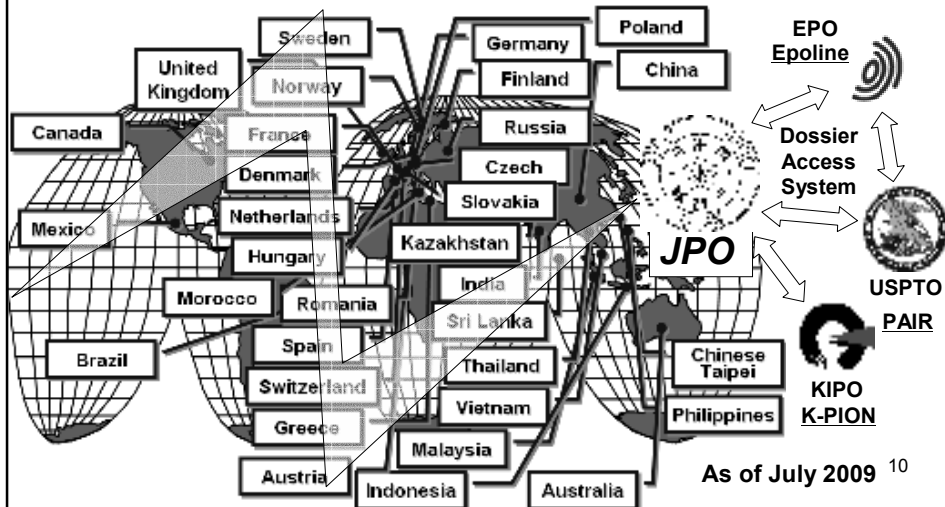
Further Shortening Period from Request to Final Decision

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- Work-sharing among IP Offices -

AIPN (Advanced Industrial Property Network)

36 patent offices have access to the JPO's file wrappers for the exploitation of search and examination results. (Japanese-English Machine Translation)

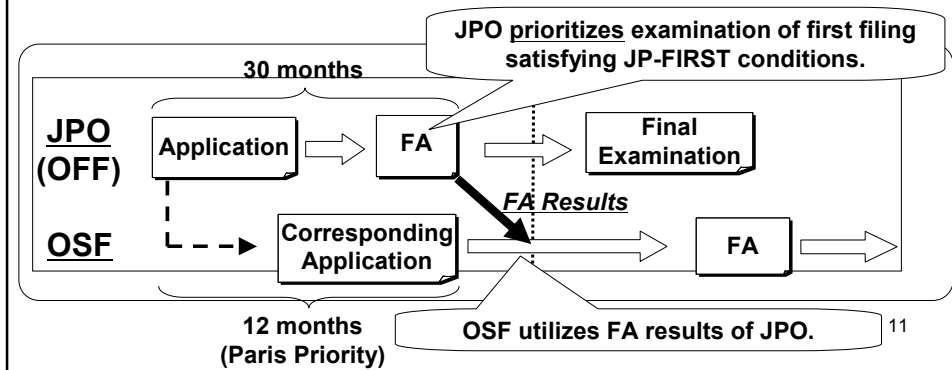


JP-FIRST (JP-Fast Information Release Strategy)

Introduced: April 2008

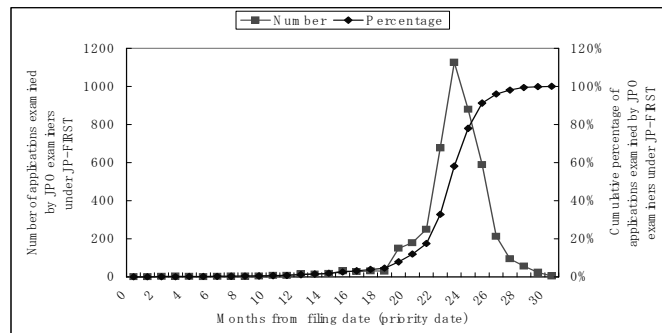
JPO provides FA results to the OSF before the OSF's examinations.

- JPO prioritizes examination of applications that satisfy certain conditions:
 - (i) First filed with JPO (and then filed via the Paris route with OSF) and
 - (ii) Examination is requested within two years of JPO filing date
- JPO provides examination results (FA) to applicants within 30 months of JPO filing date.



Analysis of JP-FIRST

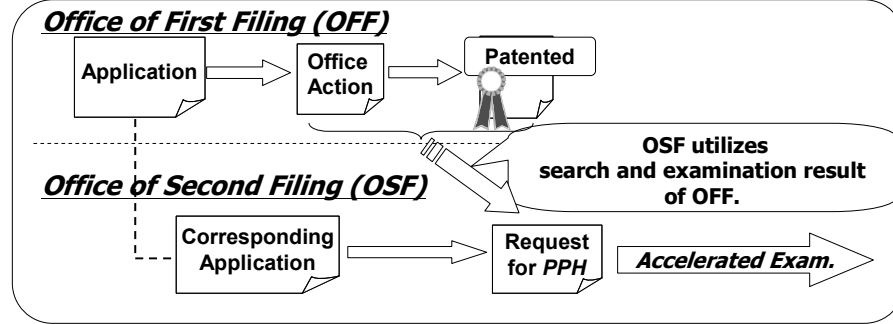
- 4441 applications were examined from April to September 2008 under JP-FIRST
- Average FA pendency period from filing date: 22 months.
- 3,488 were filed with USPTO.
 - 93% (3228/3488) were examined prior to FA of USPTO.
- 899 were filed with EPO.
 - 87% (781/899) were examined prior to EPO's first examination report.
 - 50% (446/899) were examined prior to EPO's search report.



A considerable quantity of FA of JPO can be provided to OSF prior to OSF examinations.

PPH (Patent Prosecution Highway)

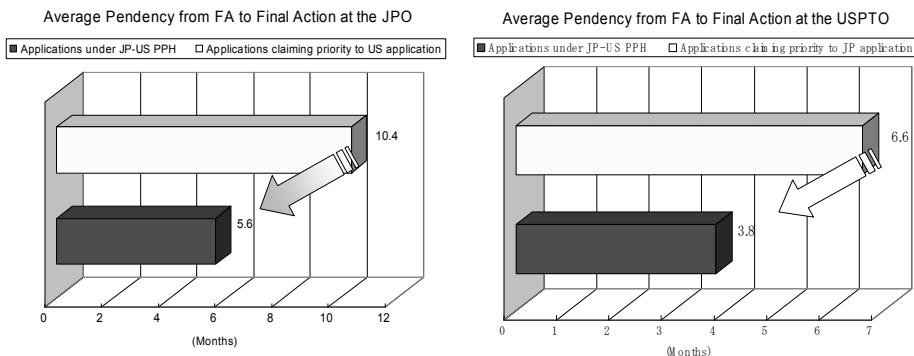
If a patent application has been determined to be patentable in the first filing office, the corresponding application is qualified for accelerated examination in second filing offices with a simple procedure.



Average Pendency from PPH Request to FA in the OSF: 2-3 months
 (As of the end of Apr. 2009 in the JPO and the USPTO)

Average Pendency from FA to Final Action

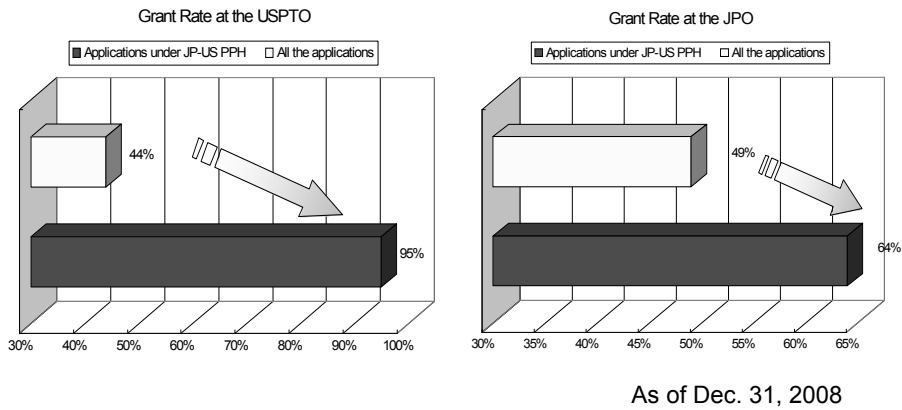
➤ **Expeditious examination and Cost savings are expected due to decreasing number of office actions.**



As of Dec. 31, 2008

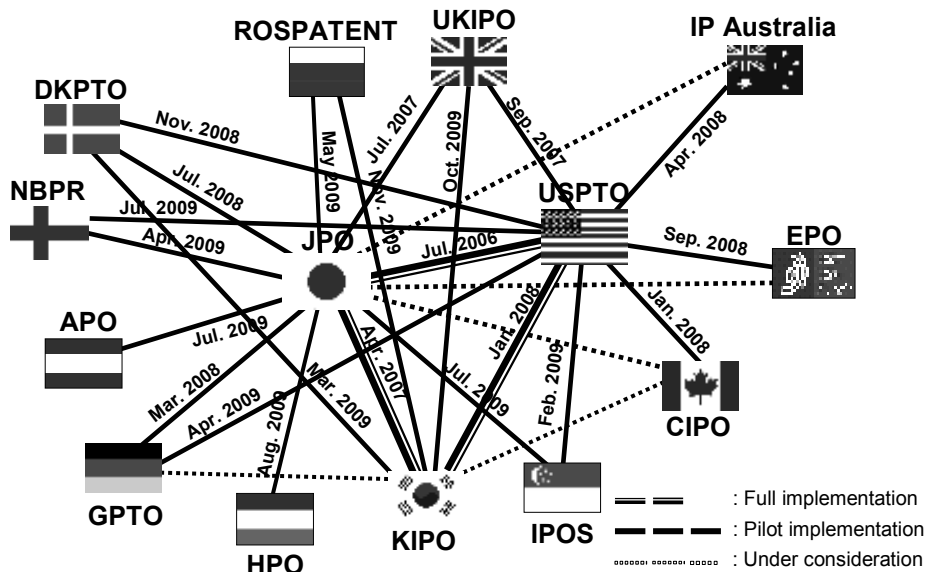
High Grant Rate

- High Grant Rate in the OSF
- High predictability of examination results in the OSF

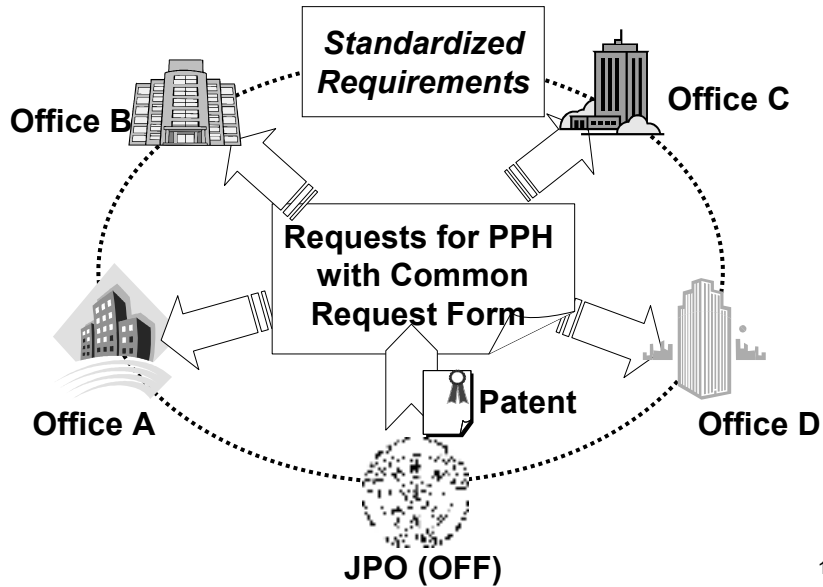


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Expanding PPH Network!



Plurilateral PPH Initiative



History of Patent System in Japan

Patent Monopoly Act (1885)



Current Patent Law (1959)

Several Partial Amendments

50 Years



Establishment of Patent Reform
Advisory Committee (Jan. 2009)

Review of Patent System for Pro-innovation!

Patent Reform Advisory Committee

✓ **Members**

- ◆ 14 experts from industry, academy, judicial community (judge, lawyer) and patent attorneys

✓ **Three viewpoints of patent system reform**

- ◆ Patent system for accelerating innovation
- ◆ Strong patent right that can be supported by patent offices and courts
- ◆ International harmonization for granting patent right quickly

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Thank you

<http://www.jpo.go.jp/index.htm>

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