

Trilateral Offices and Users Conference 2006

November 16, 2006

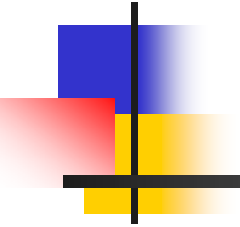
Domestic and International Initiatives of the JPO on the Worldwide Trend in Increasing Patent Applications



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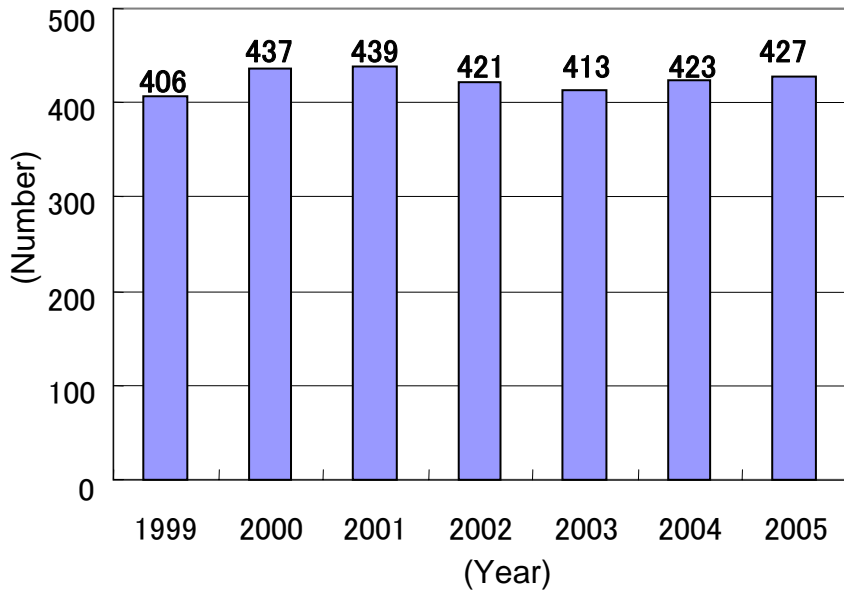
1. Domestic Initiatives

- Expeditious and Efficient Patent Examination -



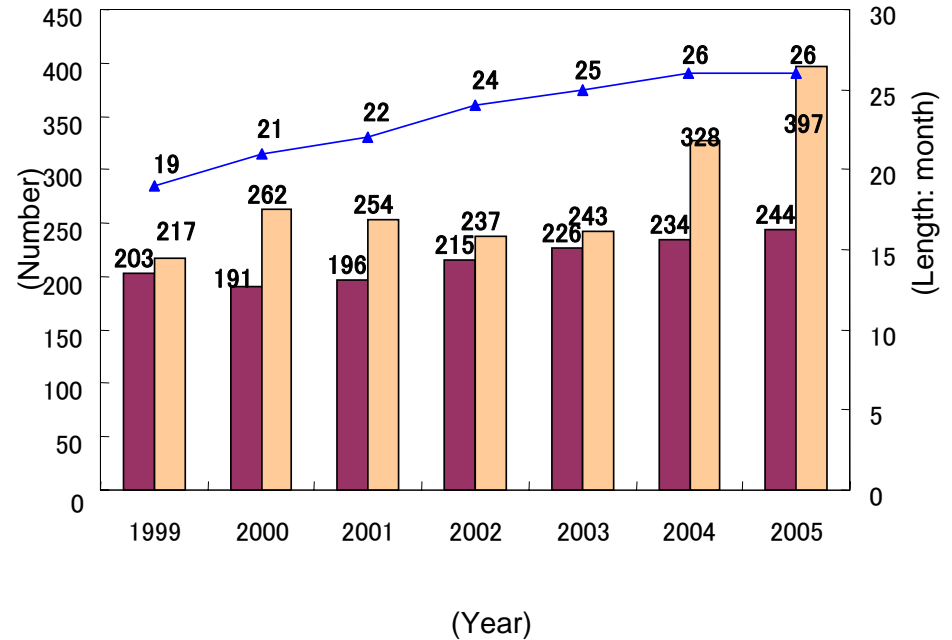
(1) Statistical Data

Number of applications



■ Number of applications (unit:1,000)

Trends in the number of examination requests, number of first actions, and examination waiting period



■ Number of first actions (unit: 1,000)

■ Number of requests (unit: 1,000)

▲ Examination waiting period

(2) Increase in the number of examiners including fixed-term examiners

Under government's policy to decrease the number of officials, 500 10-year fixed-term examiners in total to be recruited over 5 years(FY2004-2008)

Trends in number of patent examiners (fixed-term examiners)

FY2005		FY2006		FY2007(requested)
1,358	⇒	1,468	⇒	1,617
(196)		(294)		(394)

(3) Increase in outsourcing of prior-art searches

Trends in the number of prior-art searches outsourced

FY2005		FY2006		FY2007(requested)
187,000	⇒	192,000	⇒	226,000

There are 4 registered search organizations with appr. 1400 searchers. Trainings are required to be a qualified searcher. Searchers have the same duty of confidentiality as a government official.

(4) Deepening of Companies' Intellectual Property Strategies

- a. **Thorough pre-filing / pre-request check of contents of applications (20% reduction in examination requests of unpatentable applications)**
 - Enhancing the functions of the Industrial Property Digital Library (IPDL)
 - Publicizing the Patent Search Guidebook and holding search expert training programs for people engaged in patent business so as to disclose and pass on examiners' know-how to them
 - One year temporary legislation for full refund of examination request fee for withdrawal of app.

- b. **Application filing strategies with an eye to global markets (Targeting ratio of applications filed abroad: 30%)**
 - Japan is top-ranking in the world in terms of the total number of applications filed abroad by its nationals.
 - Unlike Europe and the USA, the proportion of domestic applications relative to applications filed abroad is outstandingly large in Japan.

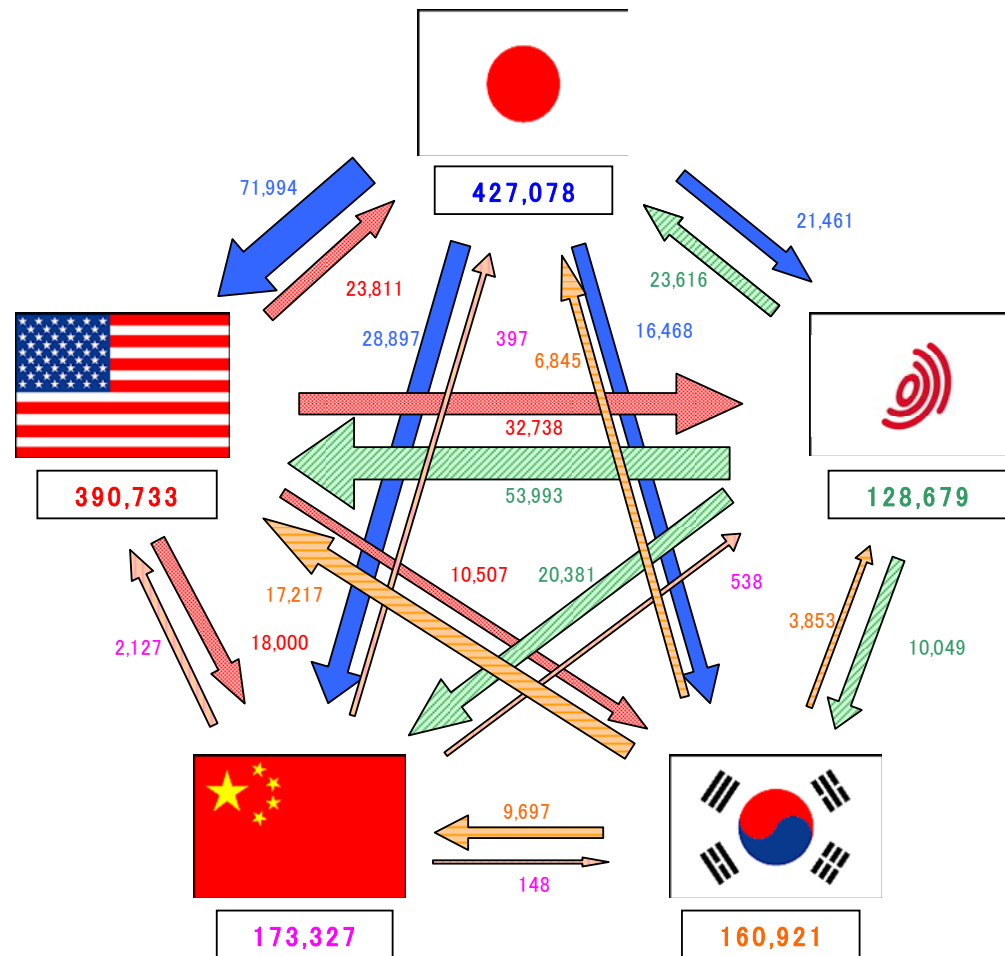
- c. **Installation of a responsible officer who manages all patent-related matters in a consolidated manner**
 - Strengthening IP-related organizations of companies by encouraging the management to participate in decision-making process on IP activities, and appointing persons responsible for implementing IP strategy such as a Chief Patent Officer (CPO) and Chief Intellectual Property Officer (CIPO), vested with centralized authority

2. International Initiatives

- Support for Global-Scale Acquisition of Patent -

(1) Patent Applications in Quint-laterals (Japan, United States, Europe, China, and South Korea)

(In 2005)



		Country/Region where applications were filed				
		Japan	United States	Europe	China	South Korea
Nationality of applicants	Japan	367,960	71,994	21,461	28,897	16,468
	United States	23,811	207,867	32,738	18,000	10,507
	Europe	23,616	53,993	63,650	20,381	10,049
	China	397	2,127	538	93,485	148
	South Korea	6,845	17,217	3,853	9,697	122,188

Note: The number of applications from Europe is the number of applications filed from 31 EPC member countries as of 2005. As to the number of applications to Europe, only the number of applications filed with the EPO is reported, excluding those filed with national patent offices of EPC member countries.

Source: Annual reports and websites of relevant patent offices

-The number of patent applications filed worldwide is nearly 1.6 million in 2004, and “Big 5” offices account for about 75%.

- The number of patent applications filed at the “Big 5” offices is nearly 1.3 million in 2005. The number of patent applications filed mutually between the “Big 5” offices are nearly 0.4 million (About 30%).

(2) Outline of Standard Format

<Objective>

Establishment of Standard Format

<Effects>

Improve efficiency for applicants and the TOs

<Background>

Request by users → WG established

< Basic Principles >

1. Based on the PCT format.
2. It is a long term goal to accept applications in text-based XML.
3. Applications in standard format shall be accepted.

An application made by an applicant

Present Formats

PCT Format

JPO Format

EPO Format

USPTO Format

Standardized

Standard Format

<明細書の項目>

[発明の名称]
[技術分野]
[背景技術]
[発明の開示]
...

Translation

<Section Titles>

[Title of the Invention]
[Technical Field]
[Background Art]
[Disclosure of Invention]
...

Acceptance by Trilateral Offices

Short-term Goal



Shift from paper form to XML form

Long-term Goal



<Road map>

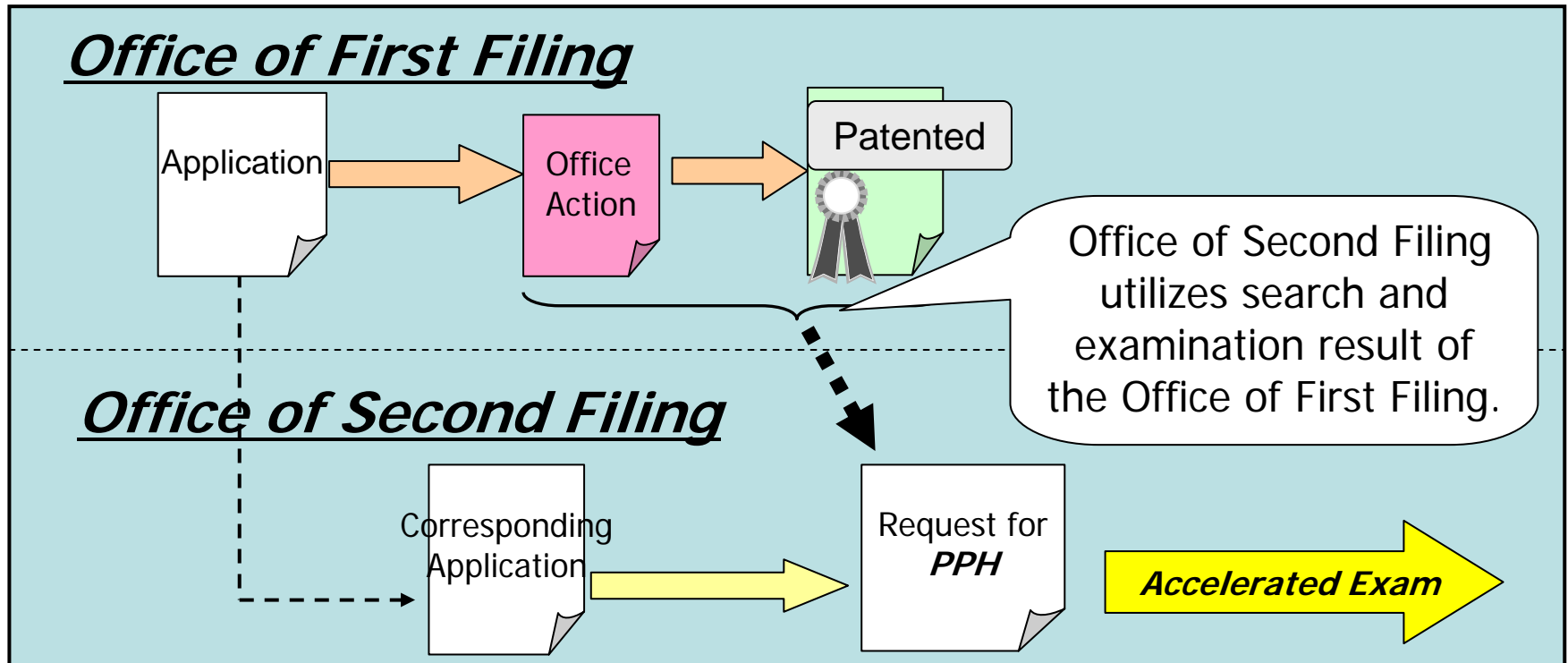
November 2006: agree on std. format → 2007: Pilot Project → after 2008: modify national/regional/ PCT rules

(3) Patent Prosecution Highway

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

Benefits to applicants!

- Quick patent obtainment in foreign countries (FA in max 9 months from the request)
 - High quality examination



The PPH between the JPO and the USPTO

The JPO and the USPTO started the one-year PPH pilot program on July 3, 2006. The both offices are now accepting requests for the PPH.

Future prospects of the PPH

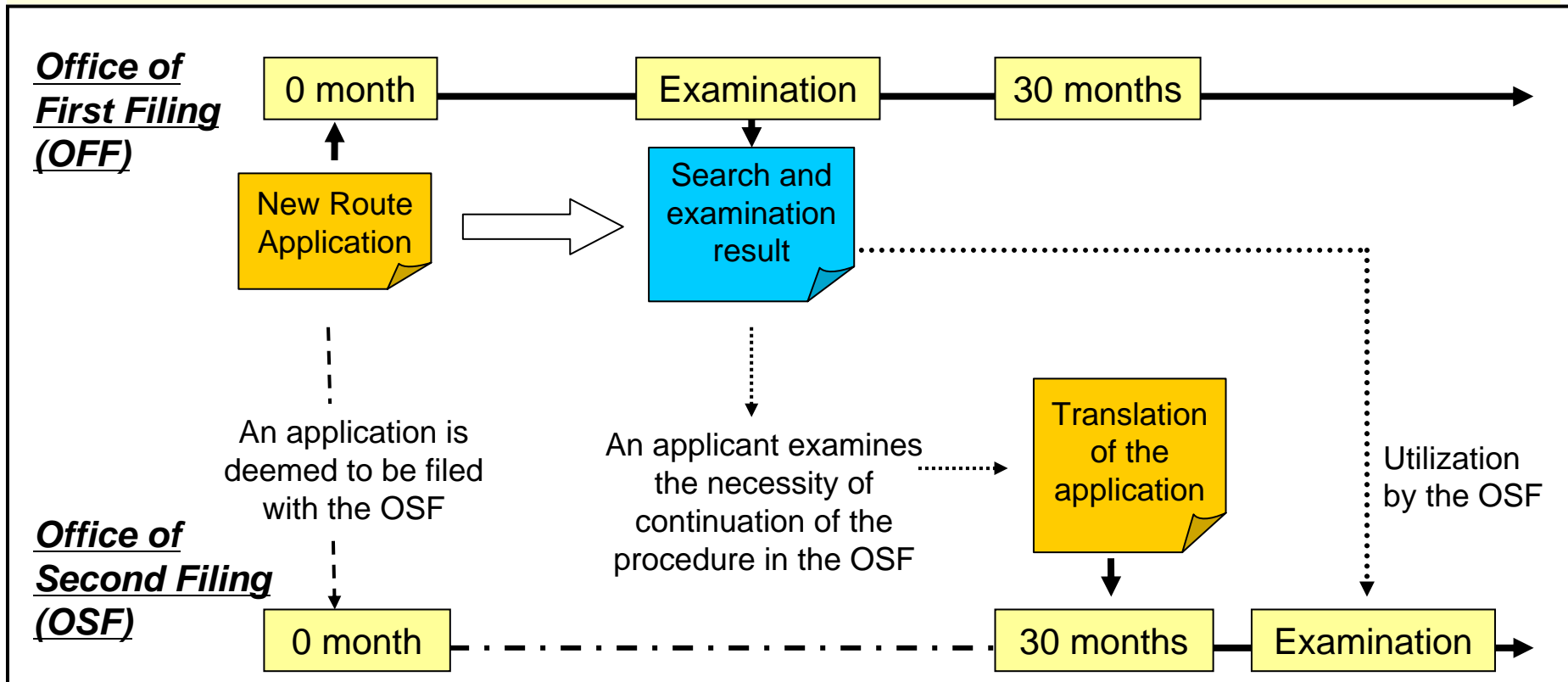
- The JPO and the USPTO aim at full implementation of the PPH after the evaluation of the pilot program.
- The EPO has been considering possible participation in the PPH pilot program.
- The JPO has already reached an agreement with the KIPO on the PPH, and the two Offices will start the PPH in spring in 2007.
- The JPO has also officially started discussing the PPH with other Offices in developed countries.

(4) Guidelines for the Use of Search/Examination Results of Foreign Patent Offices

The JPO will develop the “Guidelines for the Use of Search/Examination Results of Foreign Patent Offices” (tentative name) by the end of FY2006, so as to promote the internal use of search/examination results provided by foreign patent offices.

(5) "New Route" Proposal

- An application filed with the OFF through the New Route is deemed to have been filed with the OSF on the filing date in the OFF. -> Reduction of applicant's cost
- A timeframe which enables the second office to utilize the results of examinations by the first office is legally established. -> Reduction of the redundant search and examination and the cost of applicant's procedure
- 30-month moratorium for submitting translations with the OSF during which an applicant examines the necessity of continuation of the procedure in the OSF. -> Reduction of the unnecessary translation cost



(6) Proposal for Establishment of a Working Group on Enhanced Work-Sharing

- Towards the next stage of the mutual exploitation, the JPO proposed Establishment of a Working Group on Enhanced Work-Sharing
- Now discussing on the establishment of a working group to study problems and solutions for further progress in work-sharing.

(7) Comparative Study on Examination Practice

- The Trilateral Offices will conduct comparative study of examination practices regarding the description requirement and the inventive step/Non-obviousness requirement, using hypothetical cases, and disseminate the study results to applicants and attorneys, thereby supporting them in preparing high quality patent applications in line with the examination practices concerned.
- This comparative study was proposed by the JPO at the Trilateral Technical Meeting in May 2006. The Trilateral Offices will start the study in March 2007.

(8) Harmonization of Patent Systems

World Intellectual Property Organization (WIPO)

Discussion at WIPO on Substantive Patent Law Treaty (SPLT) has been stalled due to the conflict between developed countries and developing countries.

Meeting of developed countries on harmonization of patent systems (Group B+ meeting)

Group B+ consists of 41 countries, most of which are developed countries, with two international organizations.

The members discuss important issues such as “definition of prior art,” “grace period,” “novelty,” and “inventive step/nonobviousness,” which is related to mutual exploitation of search/examination results

At the meeting in Geneva on September 24, the members agreed (1) to turn the compromise package into more formal “treaty language.” (2) to make every effort to reach an agreement at the meeting in Tokyo in November at the earliest.

The next meeting will be held in Tokyo on November 20 (Monday) and 21 (Tuesday), 2006.



Thank you!
