



Trilateral Users Meeting
November 8, 2007

Patent Office Insights on the Trilateral Process

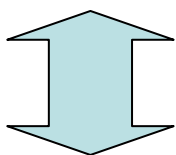
-Past Successes and Future Challenges-

Masahiro KOEZUKA
Commissioner
Japan Patent Office

Outline of Today's Topics

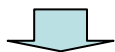
1. Global Increase of Patent Applications

- Among Trilateral Offices
- Rapid Increase in Developing Countries

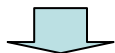


5. Change of Social/Economical Environment

- Advancement/Complication of Technology
- Change of Product Structure (Module)
- Change of Industrial Structure (from Vertical Integration to Horizontal Specialization)



- Unbundling R&D from Manufacturing
- Activating Open Innovation
- Liquidating IP and Unifying with Finance



Rapid Change of Players and Rules of Games Surrounding IP

Needs/
Measures
to
improve
“Quality”
and
“Quantity”
together

2. Improve “Quality”

- **Harmonization of Substantive Law**
 - Advancement of SPLT (B+ Group)
- **Study on Examination Practice**
 - Study among Trilateral Offices

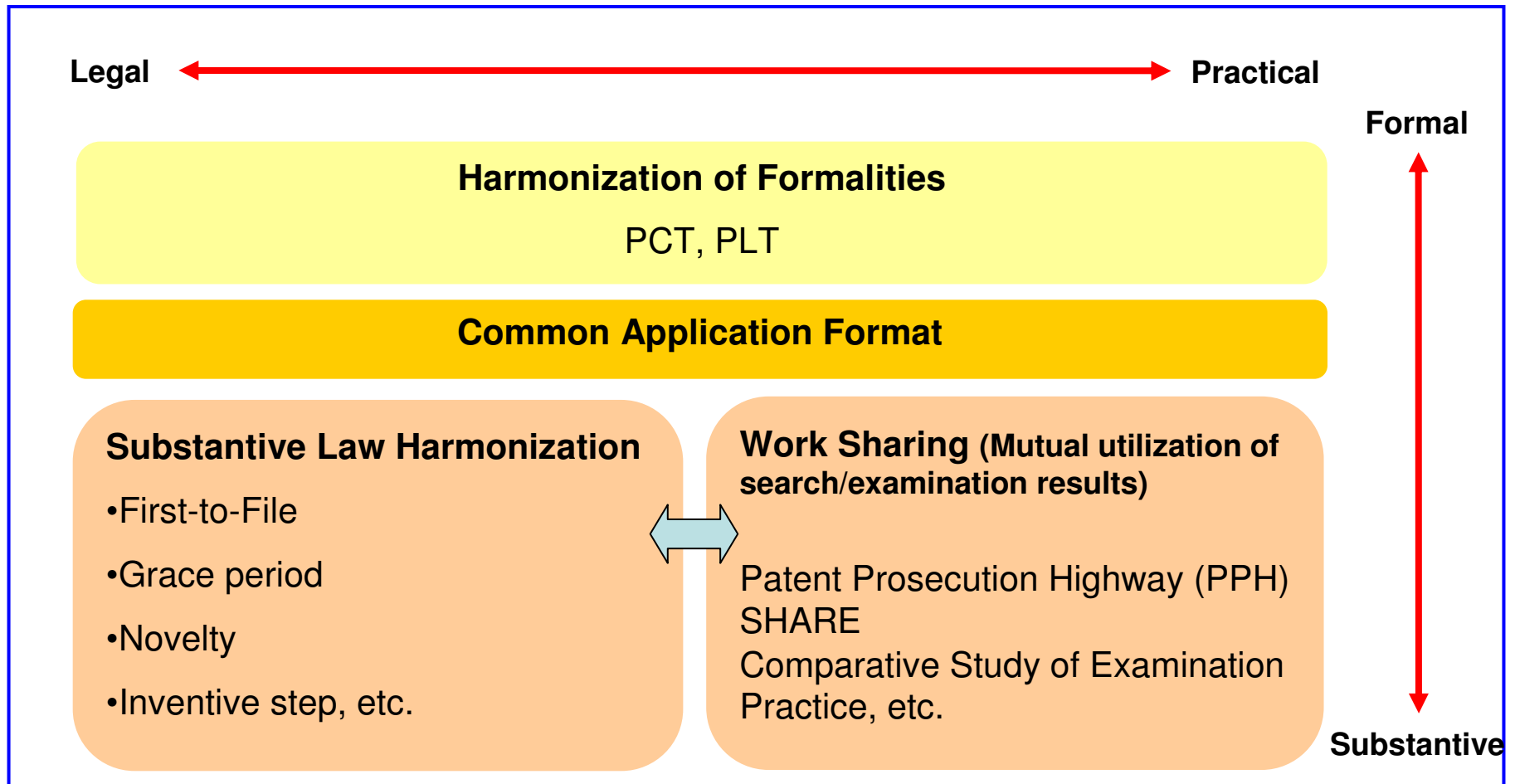
3. Manage “Quantity”

- **Work Sharing Framework Based on Institutional Varieties of Offices**
 - Utilization Resources
 - Search (TriWAY, SIS)
 - First Action (SHARE, New Route)
 - Decision to Grant (PPH)

4. Trilateral Infrastructure

- **IT Network Infrastructure**
 - Priority Document Exchange
 - Dossier Access System
- **Harmonization of Formalities**
 - Common Application Format 1

Outlook on Development of Global Framework



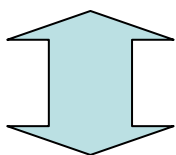
Realization of Global Framework

- One invention is efficiently protected as a patent worldwide -

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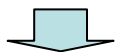
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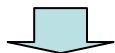


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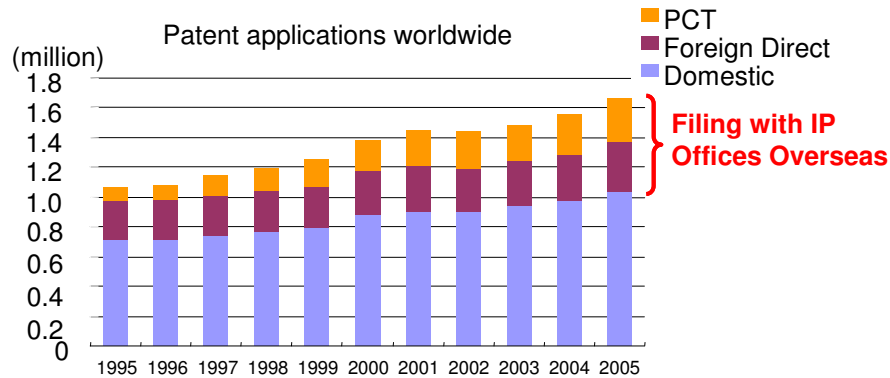
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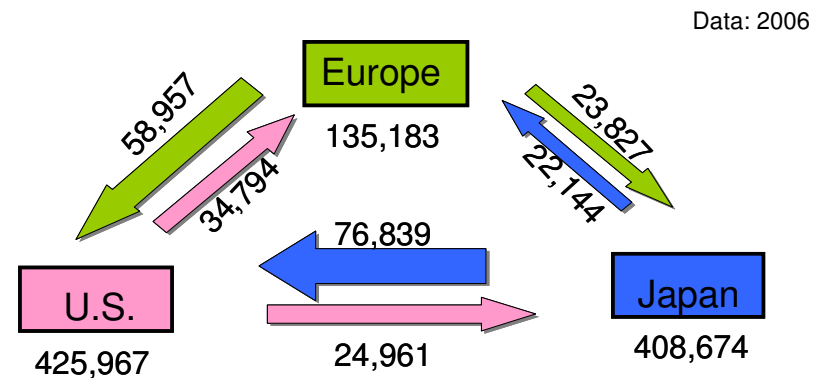
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1-1. Growing Demand for Harmonization & Work Sharing due to Globalization

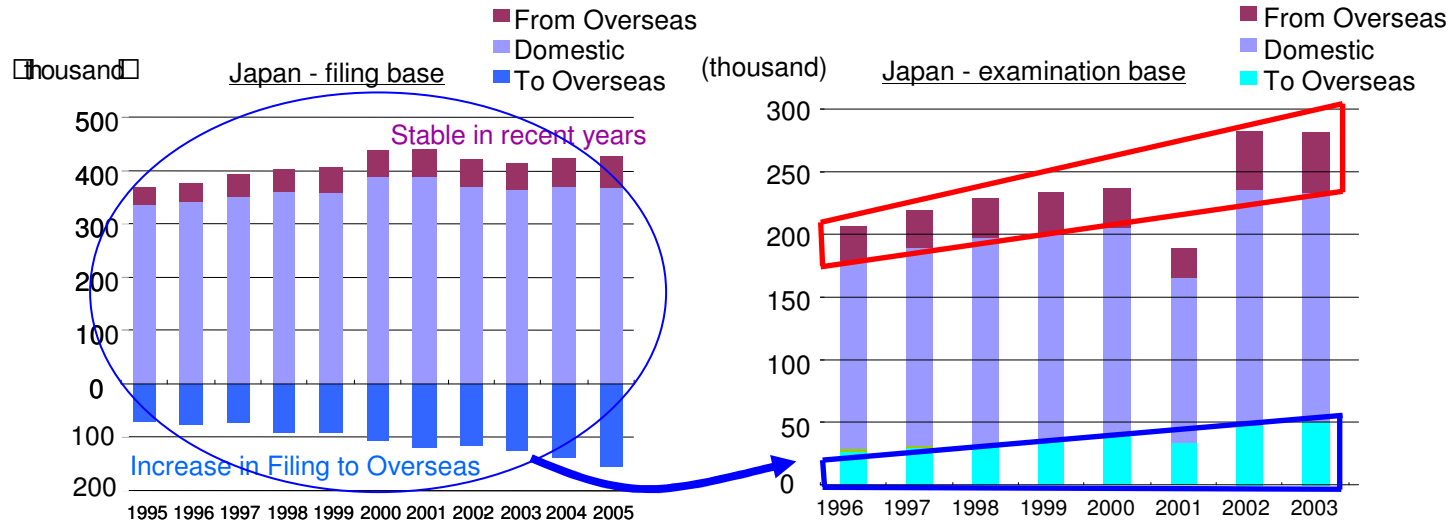
Global filing trend - Doubled after TRIPS



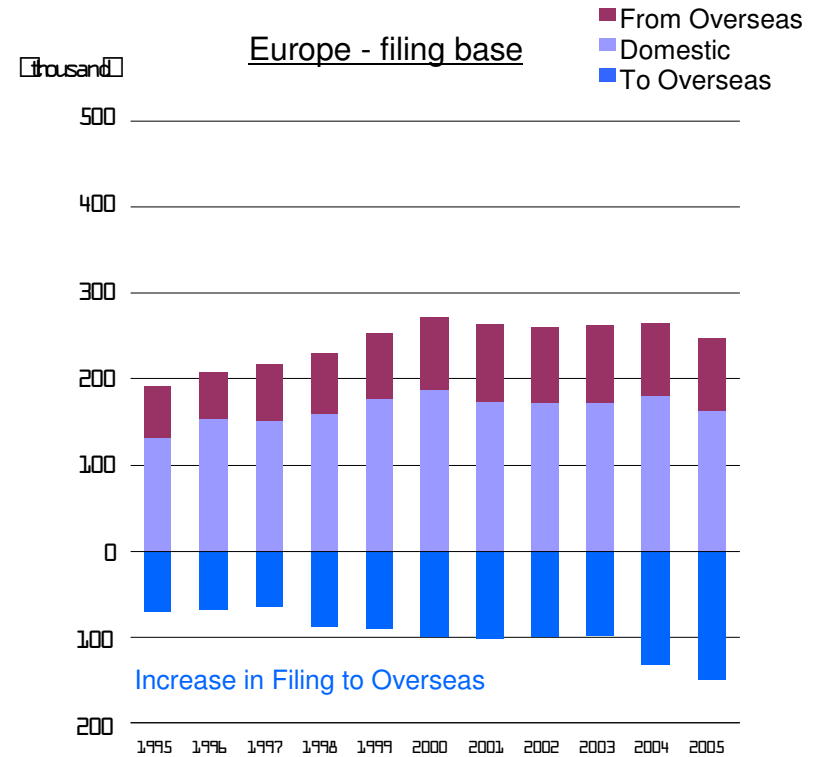
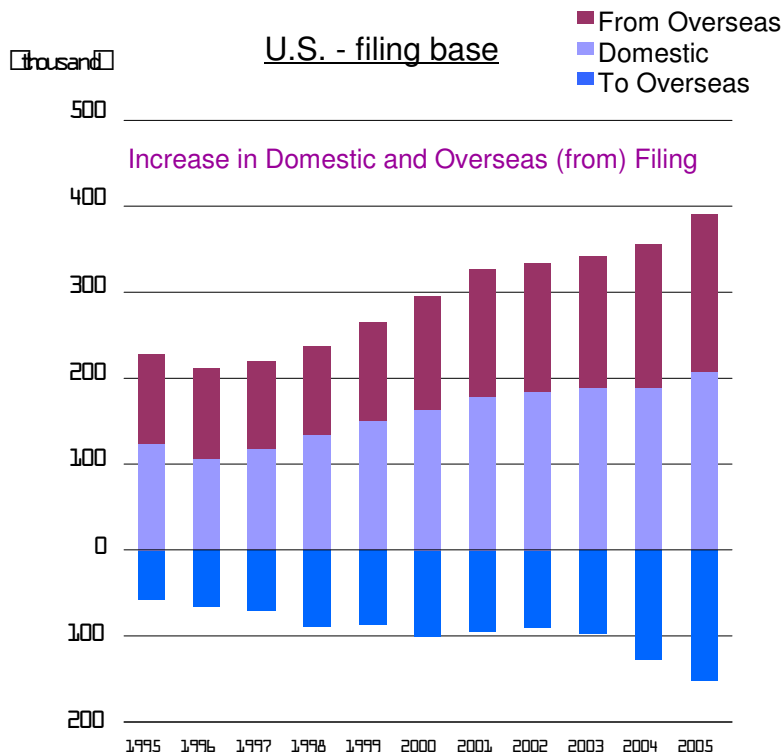
970,000 Received by Trilateral Offices, 240,000 Duplicated



Upward trend in Overseas Filing in Japan



1-2. Growing Demand for Harmonization & Work Sharing due to Globalization



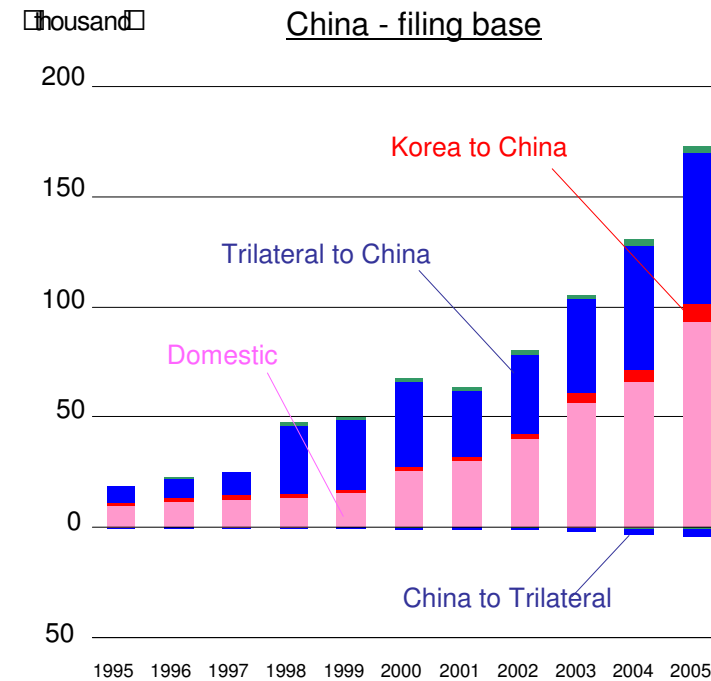
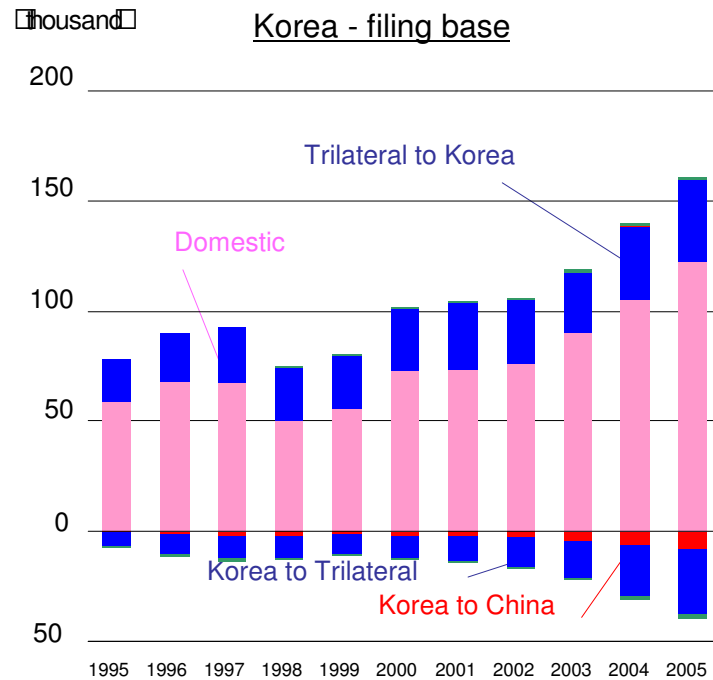
Innovation is being developed in the world.
Globalization enhances needs for obtaining patents abroad.



Increase applications all over the world.
Increase in duplicative applications.

- Different protection levels under different IP systems.
- To increase predictability of patent obtainment abroad, **International Harmonization of Patent System** is essential.
- Inefficiency and unnecessary cost generated by duplicate examinations.
- To reduce cost and improve efficiency, **Work-Sharing** is essential.

1-3. Growing Demand for Harmonization & Work Sharing due to Globalization

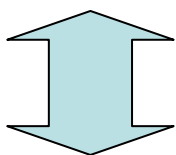


- Globalization also enhances needs for obtaining patents not only Trilateral regions but also developing countries.
- Rapid increase of patent filing in China and other developing countries.
- ➔ **A global framework and infrastructure for developing countries are also important for the Trilateral Offices.**

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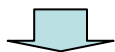
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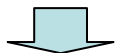


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2-1. Harmonization of Substantive Patent Systems

- Since 2005, the First Package*¹ has been discussed among developed countries. (B+ meeting)
 - ☐☐ Novelty, Inventive Step, First-to-File & Grace Period, etc.
- At the B+ meeting, issues, such as First-to-File and Grace Period, are major topics to achieve international substantive patent law harmonization.

Realization of harmonization is long-awaited and urged from political and business sectors.

<Current Sketch>

Issues	Europe* ²	Japan	U.S.
•First-to-File			First-Inventor-to-File
•Elimination of the Hilmer doctrine			Hilmer Doctrine
•12-month grace period (GP) with no formal declaration	Declaration / 6 month (Limited (e.g. Expo))	Declaration / 6 month (publication, etc.)	
•Third party rights (Prior user rights)	Derivation from inventor	Independent only	Business method only
•The abstract does not form part of the “whole contents”			Form “whole contents”
•GP covers only erroneously published patent applications			All published applications
•PCT applications apply as secret prior art	Limited	Limited	Limited
•Other			

*² Each EU nations has its own mandate for negotiation.

US Patent Reform Act of 2007

The U.S. is positive to go along with world's majority principle.

- ☐ Transition to First-Inventor-to-File
- ☐ Elimination of the Hilmer doctrine, etc

2-2. Practical Measures for Work Sharing (Trilateral Comparative Study)

- Practical Study for Global Standard of Application and Examination -

➤ Objectives

- ✓ Harmonization of Trilateral Patent Examination Practices
- ✓ Guidance for High-quality Application Documents
- ✓ Improvement of Patent Quality

➤ Theme

- ✓ Description Requirements (Disclosure of Invention and Claim)
 - Comparison of Laws and Practical Guidelines of each Office
 - Case Study

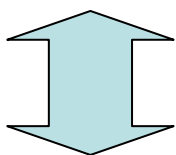
To be published after analyzing the result of comparative study
- ✓ Inventive Step / Non-obviousness
 - To start after completion of the study on description requirements

- PPH also contributes to Harmonization of Patent Examination Practices -

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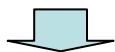
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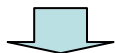


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3-1. Work Sharing based on Information Sharing

Priority Document Exchange

- **Priority Document Exchange** (among Trilateral Offices, between JPO/KIPO)
Second Filing Office (OSF) receives the priority document issued by First Filing Office (OFF) electronically.
- **Digital Access Service of priority document (Under discussion for implementation at WIPO)**

Dossier Access System

Search Results

- **Utilization of ISR in PCT**
- **EPO:** Prioritizes search for first filings.

FA results

- **SHARE Proposal (by USPTO)**
OFF prioritize search/examination for first filings. OSF utilizes search/examination results of the OFF.
- **JPO: Prioritize First Action for first filings (planned).**

Final Examination Results

- **Patent Prosecution Highway (PPH)**
The framework in which an application determined to be patentable in the OFF is eligible to have accelerated examination in the OSF by offering the examination results of the OFF.
 - JPO:USPTO(Jul. 2006), KIPO(Apr. 2007), UKIPO(Jul. 2007), GPTO (planned in Mar. 2008)
 - USPTO: UKIPO(Sep. 2007), KIPO (planned in 2008)

Each type of work sharing contributes to an increase in the efficiency of the patent examination of global applications.¹¹

Application

Search

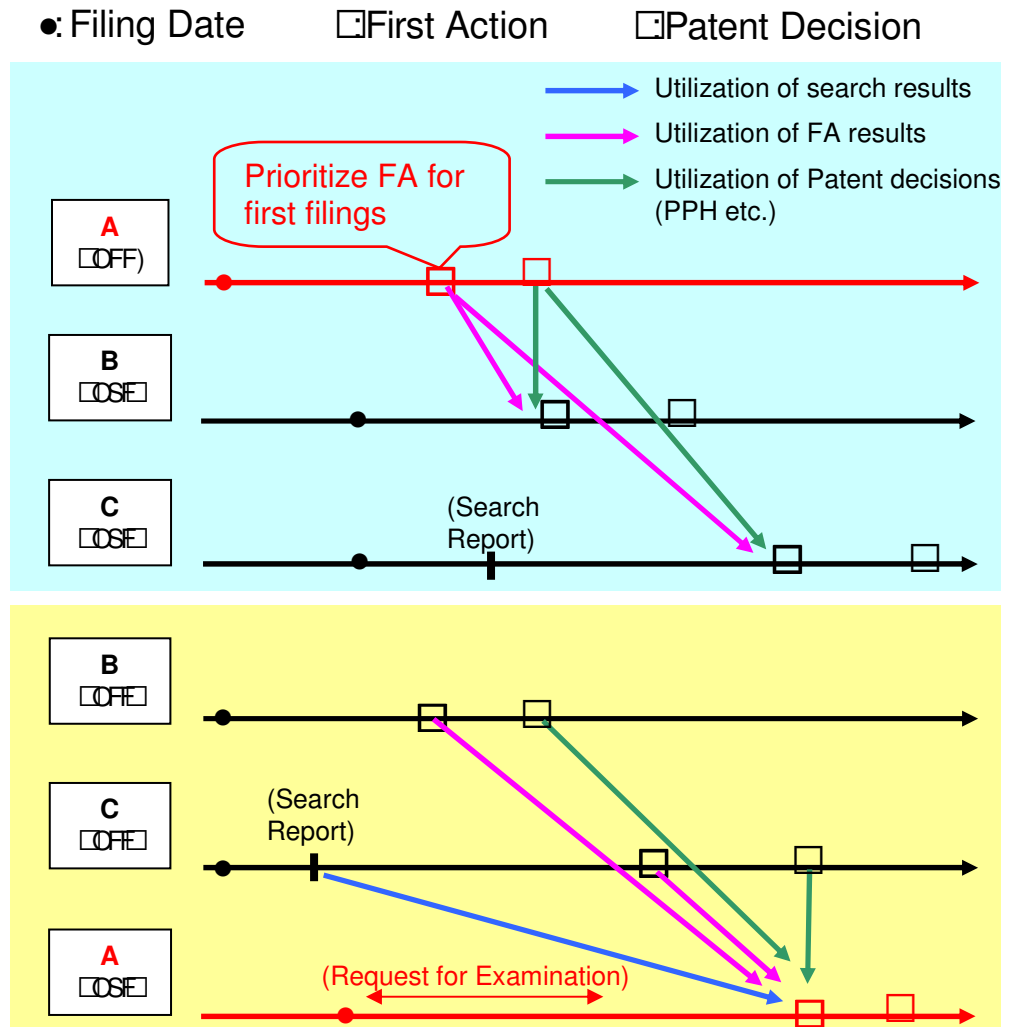
First Action

Grant

3-2. Work Sharing Frameworks

Promote work-sharing with utilizing various resources – Search, First Action (FA), Decision to Grant
➔ Improve work-sharing efficiency to the maximum extent by combining various resources while taking into account the institutional varieties among offices.

Resource	Search Results	FA Results	Patent Decisions
Effectiveness for Decision by OSF	□ fair	○ effective	□ most effective
Usability	Depend on institutional varieties by each office		
Typical Measures (Paris route etc.)	TriWAY	New Route SHARE	PPH
Typical Measures □PCT route	PCT-ISR SIS		PPH



3-3. Mutual Utilization of FA Results

Utilizing FA results among offices will reduce workload and cost, improve patent quality, and expedite patent granting.

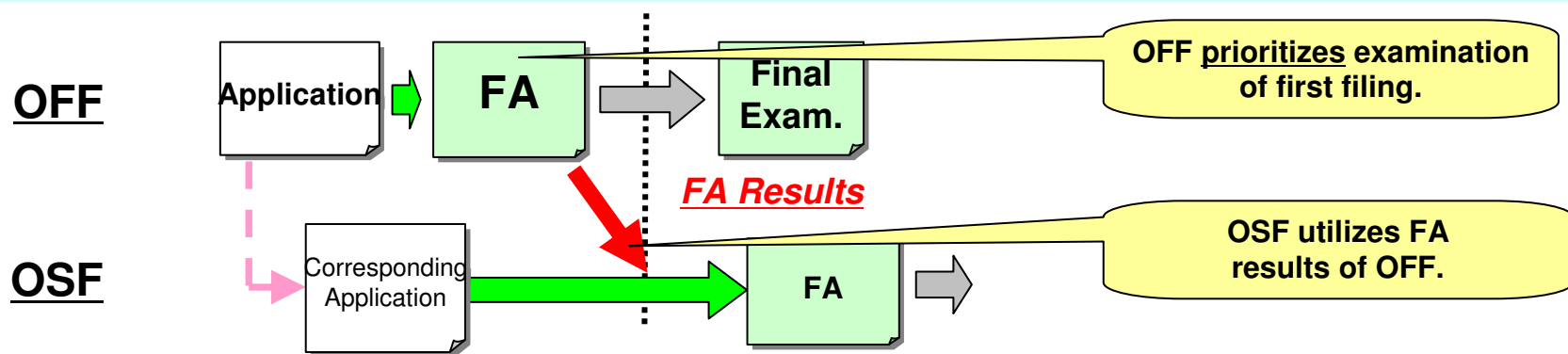
Japan □ Prioritize examination of first filing. (planned)

↳ Applications with “exam-request within certain period” assigned higher priority.

↳ Improve efficiency and quality of patent.

U.S. □ **SHARE Proposal** (Strategic Handling of Applications for Rapid Examination)

Mutual Utilization of FA Results (Image)



3-4. Mutual Utilization of FA Results ~ New Route Proposal~

➤ **First filing with OFF to be considered “simultaneous filing” with IP offices of other countries.**

➤ Filing cost reduced.

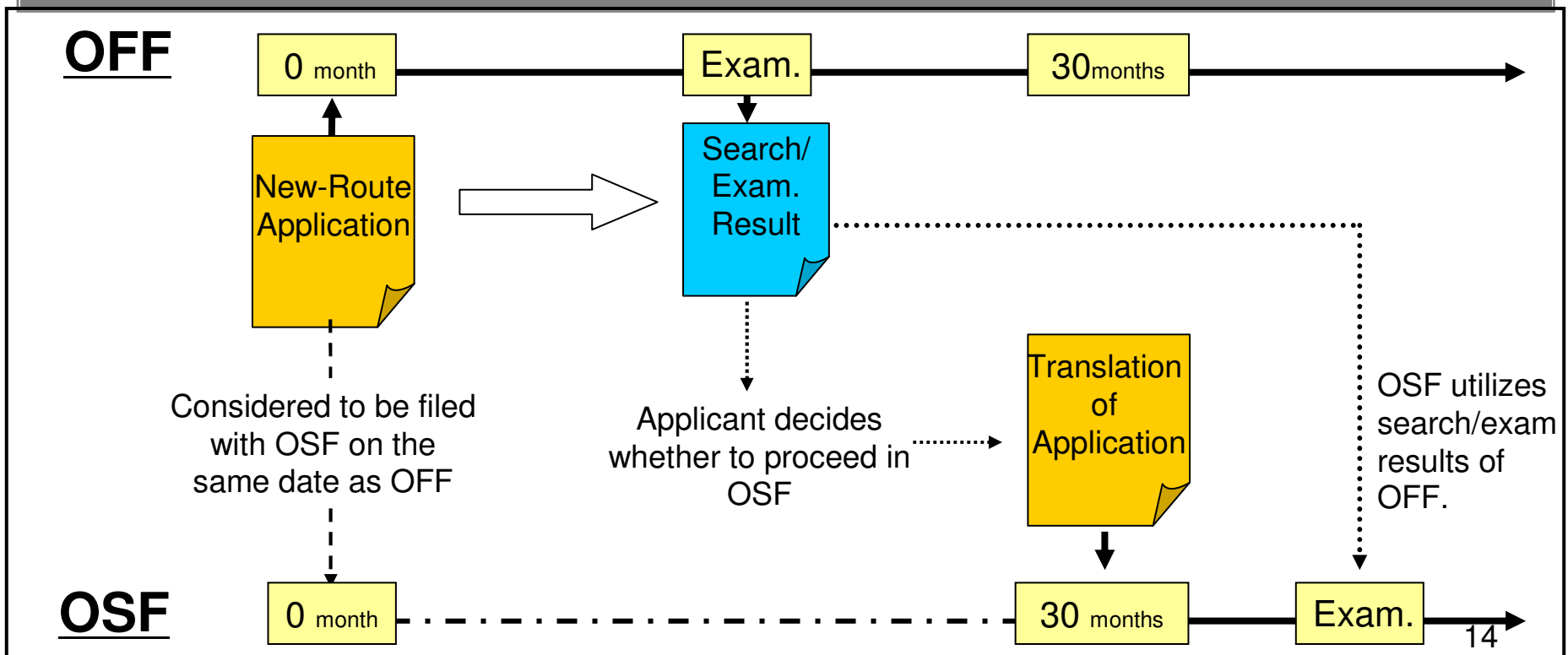
➤ **Legal timeframe: OFF examines first. Then, OSF utilizes search and examination results of OFF.**

➤ Duplication of search/examination avoided, and the applicant’s procedural cost reduced.

➤ **Applicant defers submission of translation to OSF until exam results of OFF have been produced.**

➤ No unnecessary cost of translation.

➤ **In early 2008, an analogous pilot project is due to start between the JPO and the USPTO.**



3-5. Mutual Utilization of Patent Decisions ~ Patent Prosecution Highway (PPH)~

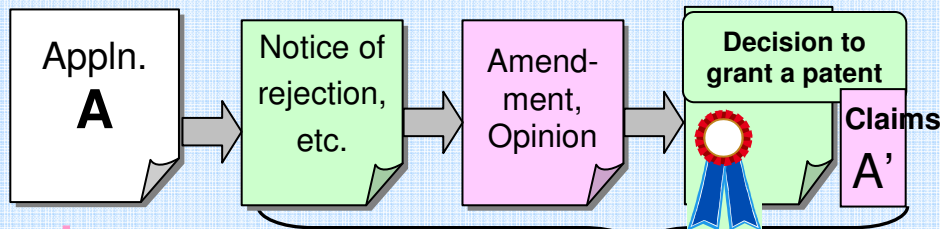
If a patent application has been determined to be patentable in the OFF, the corresponding application is qualified for accelerated examination in the OSF. **PCT applications are also eligible.**

➔ **Quick patent obtainment abroad / Reduce workload in IP offices / Enhance examination quality**

JPO-USPTO, UKIPO, KIPO: In Practice JPO-GPTO: Planned (March 2008)

JPO plans to expand PPH with other offices.

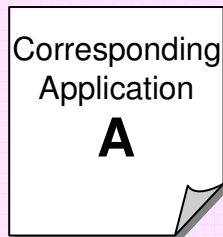
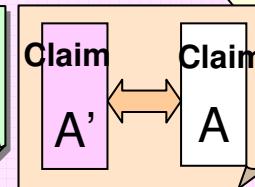
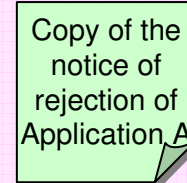
OFF



Patent Claim A' and Claim A correspond.

OSF

Submit examination documents in the OFF (No need if obtainable by dossier access system.)



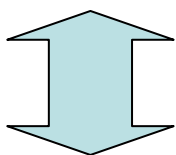
Accelerated Exam.

Additional Search & Substantive Exam.

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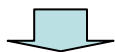
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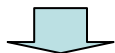


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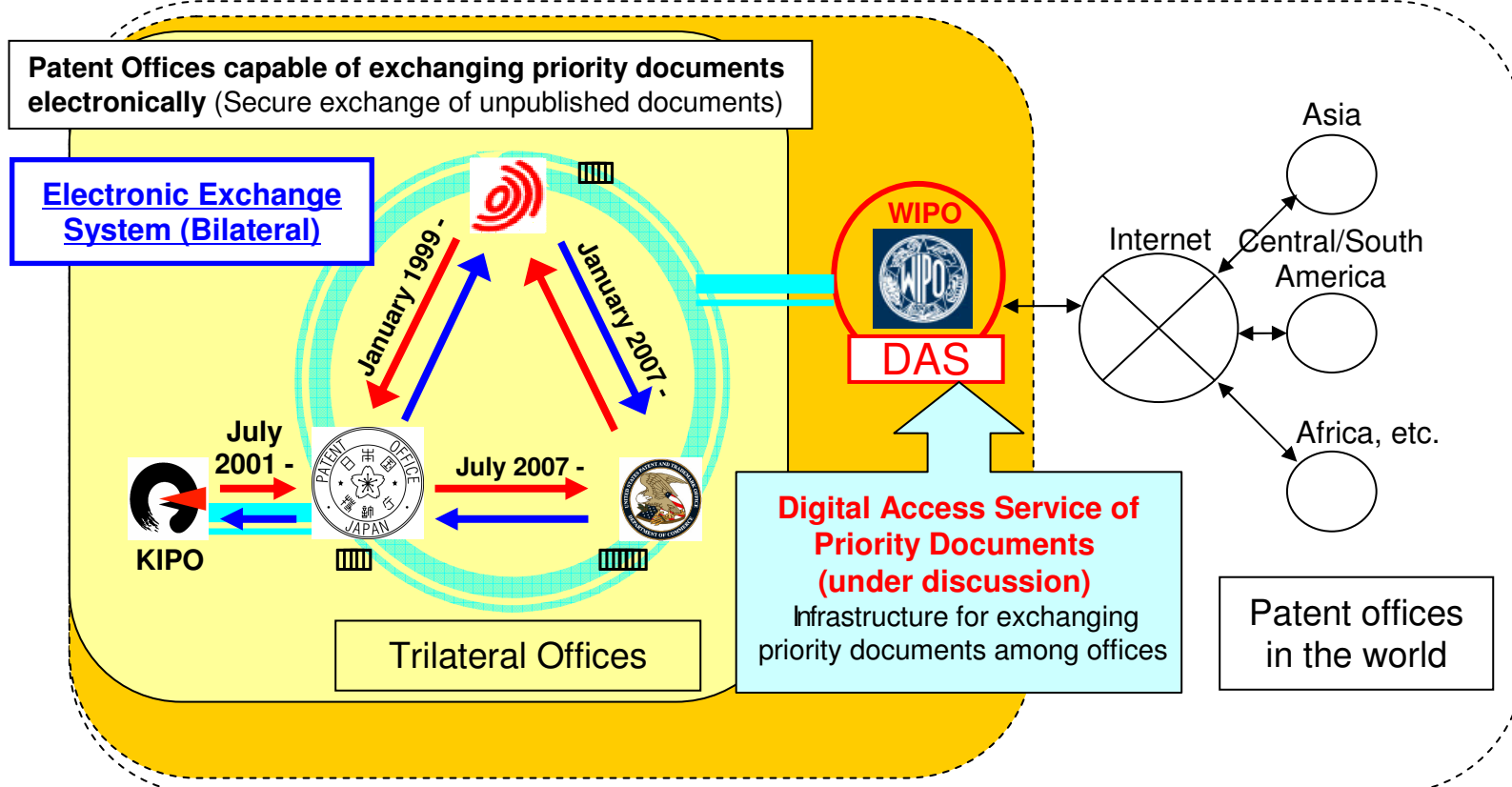
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4-1. Information Network Supporting Work Sharing (PDX)



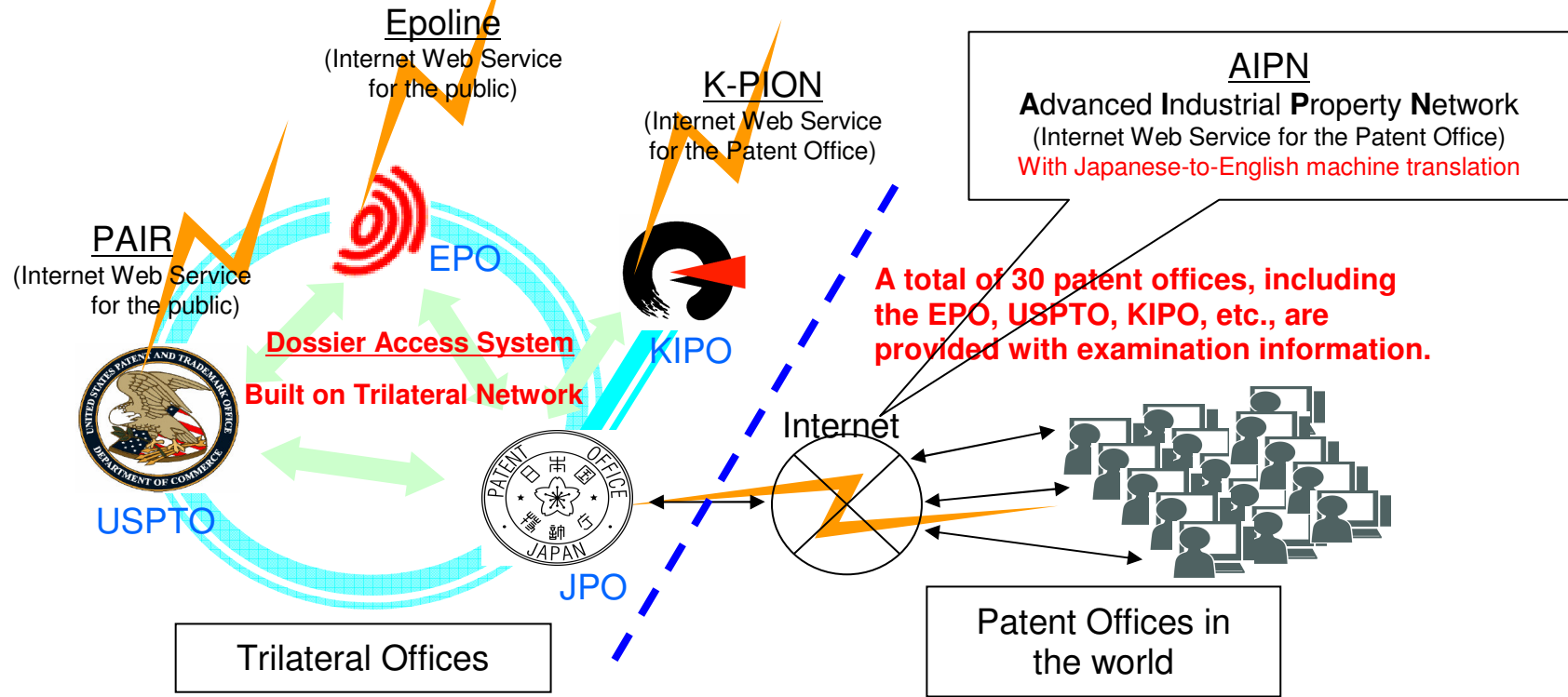
{ Conventional situation: An applicant must obtain a priority document from the OFF and submit it to the OSF. }

Advantage of Priority Document Exchange

- Reduction of procedural/financial burdens of applicants
- Reduction of administrative burdens of patent offices
- Easy to identify applications to overseas for OFF to prioritize examination, where requested priority documents from the OSF

4-2. Information Network Supporting Work Sharing

Dossier Access System of the JPO (Tool for accessing examination information)



Dossier Access System

Mutual reference to the search/examination results of each of Trilateral Offices, JPO and KIPO

↓

Contributes to shortening examination pendency while reducing workload by avoiding duplicate searches.

AIPN

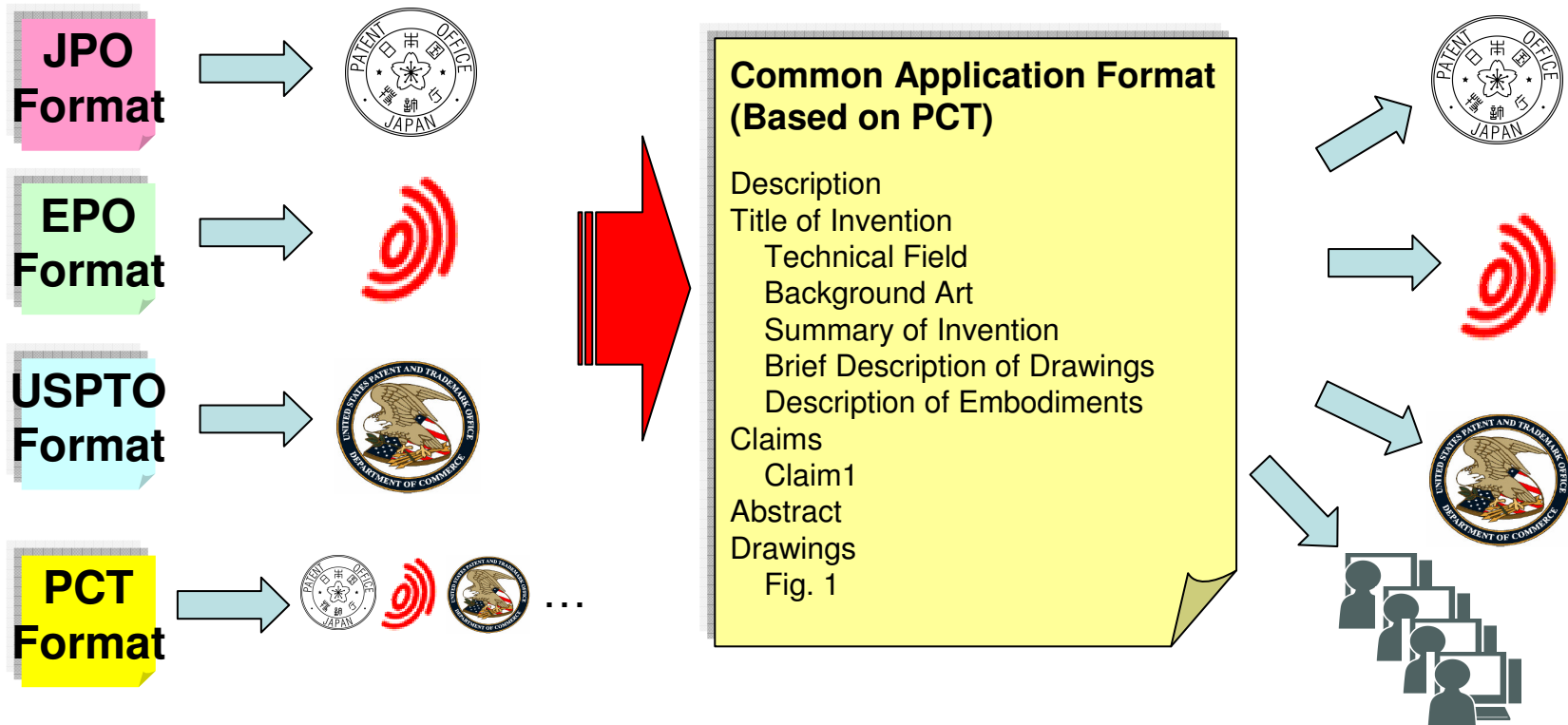
Examination results sent from Japan to foreign countries

↓

Contributes to developing countries

4-3. Common Application Format

- Standardizing Patent Application Format (incl. PCT)
- The applicants can reduce the burden for re-drafting according to different formats among the offices.

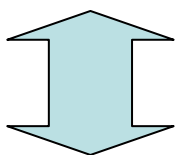


- The revision of PCT Administrative Instructions will be proposed at the earliest opportunity.
- Trilateral Offices will start operations when prepared.
The JPO is aiming at starting operations in April, 2009.

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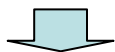
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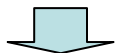


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5. Patent System in Changing Paradigm

Change of Social/Economical Environment

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- **Need for Sustainable Patent System**
- **Enhance Usability of Patents for Innovation**

Expectations to the Industry

- **Take an ambitious step forward to construct the global system.**
- **Seek the early realization of harmonization by supporting its positive progress through government-and-private cooperation.**
- **Promote cooperation between Patent Offices and users that is essential for efficient Work Sharing.**
- **Examine measures in response to environmental change surrounding economical society. (e.g. open innovation.)**
 - Open review will be introduced on a trial basis in Japan.
- **Recognize the importance of Trilateral Offices, together with WIPO.**

Thank you for your attention.

www.jpo.go.jp