“The Industrial Property Rights System in Japan”

Chapter 2. The Patent System and Utility Model System

In this chapter we’ll introduce the Japanese Patent System.

Article 1 stipulates that the purpose of the Patent Law is to encourage inventions, and thereby to contribute to the development of industry through promoting the protection and utilization of inventions.

The Patent System aims to contribute to industrial development by, on the one hand, protecting inventions by granting the inventor the exclusive right of a patent for a certain period of time, and, on the other, by disclosing the invention, preventing others from conducting research and development of the same invention and encouraging improvements to be developed.

Under the Patent Law, inventions are broadly divided into the two categories of “Products” and “Methods”. They have to meet certain conditions.

Utilization of the laws of nature

Technical ideas

Creation

Highly advanced

Even if an application is filed for an invention that is a highly advanced creation of technical ideas utilizing the laws of nature, it may not necessarily obtain a patent right.

The granting of a patent right to a technology that is already publicly known or an invention that is not industrially applicable is not regarded as useful for industrial development.

In addition, there is concern that the granting of a patent right to a similar invention will not maintain the stability of an exclusive right and may lead to frequent dispute.

Therefore, before a patent right can be granted, an examination is required to check whether the application fully satisfies the patent requirements.

This is called a “substantive examination”.

Now, let’s look at the major patent requirements.

First-to-file system

There are two international systems: “first-to-file” and “first-to-invent”. In many countries, including Japan, the “first-to-file system” is adopted because it ensures more stable rights than “first–to-invent”. The application filed first to the Patent Office is granted priority.

Industrial applicability

Being “industrially applicable” means that the invention, even if not directly connected to industry, is regarded as capable of contributing to the development of industry through its manufacture or sales.

As this table indicates, patent rights for medical practices, such as surgery and treatment, as well as diagnostic methods, differ in each country.

In Japan, new medical devices and medical products are not regarded as “medical practices”. They are considered as “inventions of products” which are “industrially applicable”, which means they can be patented.

Novelty

Inventions must be new. Patent rights are not granted to technologies that people are already familiar with. Inventions that are "publicly known" and "publicly used", as stipulated in Article 29 Clause 1, are considered to lack “novelty”.

Regarding an invention that has already been published in a thesis, for example, an exception to the “lack of novelty” restriction can be made if it was published under specific conditions and the designated application procedures are carried out within six months from the publication date.

Inventive Step

An invention that can easily be conceived by a person with ordinary knowledge in the same technical field is not considered to represent an “inventive step”.

For example, inventions that are simply an aggregation of other publicly known inventions, feature just slight structural modifications with no advantageous effect, or that could easily be created by anyone, are regarded as lacking an inventive step and will not be granted patent rights. The

“Inventive step” is an important examination requirement.

Now let’s consider some test cases.

A yacht and a motorboat are publicly known products. Can a “motor yacht” that combines those two technologies be regarded as an “inventive step”?

In this case, it’s regarded as *not* having an “inventive step” because it’s just an aggregation of publicly known technologies.

Well then, what about the invention of a motor yacht which has a digital anemometer installed that automatically changes between use of the sail and the motor according to the wind speed?

If the same technical idea cannot be found in existing technologies, then this can be considered to involve an “inventive step”.

How about the case in which switching between use of the sail and the motor of a motor yacht is not controlled *automatically* but *manually* by a person observing a digital anemometer?

In this case, the examiners could make two possible decisions regarding its validity as an “inventive step”.

Some examiners might determine that it *does* involve an “inventive step” because no existing technology has included the installation of a digital anemometer.

Other examiners might determine that it does *not* involve an “inventive step” because anyone could come up with the idea of switching between use of a motor yacht’s sail and motor manually by observing a digital anemometer.

We’ve included these examples to help you understand the concept of an “inventive step”. As you have seen, the presence of an inventive step cannot be determined unconditionally. The point is that the examination should be carried out by comparing the scope of claims of an invention with the existing technologies.

For that purpose, examiners need to possess a wide range of expertise, including the ability to fully comprehend the substance of the invention under examination and the ability to compare it with existing technologies.

It’s important to foster such expertise in order to carry out examinations appropriately.

A “formality examination” checks whether or not an application document fulfills the necessary procedural and formal requirements. A “substantive examination” checks the specific technical content of the application as well as whether it fulfills the patentability requirements, and determines whether there are any reasons for refusal.

If an examiner finds reasons for refusal, a notification of this result is sent to the applicant.

An applicant can subsequently submit a written opinion describing how the invention does in fact differ from existing technologies, referred to as “prior art”, issue an amendment providing further description, or amend, for example, the scope of the claims. If the reasons for the initial refusal are deemed to have been eliminated, then the examiner may make the decision to grant a patent.

The duration of a patent right generally expires 20 years after the filing date of the application.

If the examiner determines that the reasons for refusal have not been eliminated through the amendments, another decision of refusal will be made. If dissatisfied with the decision, the applicant has the right to appeal against it.

For a variety of reasons, some applications require the speedy granting of a patent. In order to respond to such needs, the Japan Patent Office will carry out expedited examinations that are faster than usual if the applications satisfy certain requirements.

As of 2012, the period of first action in the case of normal applications for examination is about 20 months from the date of request. Expedited examinations, however, take only two months on average.

A comparison of the invention with “prior art” is essential for patent examinations.

To avoid the “unwanted results” of free text searches, patent classification search is possible using the “International Patent Classification” (IPC), or Japan’s unique “FI” (File Index) or “F-term”. This makes it possible to systematically search features of technologies that are difficult to express in words, such as shapes and structures.

Text searches using keywords enable searches with fewer failures.

Since the examination of “prior art” requires efficient searches with fewer “unwanted results” and less search failure, it is carried out by combining a patent classification search and a text search.

Regarding the search for Japanese patent documents, use of the FI or F-term searches is more efficient than using an IPC search.

Here we can see the relationship between IPC, FI and F-term.

The Official Gazette of the Japan Patent Office containing information on patents, utility models, designs and trademarks has been issued since the Meiji era which started in 1868. In addition, there is the Industrial Property Digital Library, or IPDL, which offers the public Internet access to information such as the progress of examinations included in the IP Gazettes of the Japan Patent Office.

PAJ (Patent Abstracts of Japan) and FI or F-term searches are possible in English, so overseas examiners can use these for reference regarding patent applications and registrations from Japan.

Let's take the example of "an umbrella with LED lights installed at the end of the ribs to improve safety at night". Now we'll try an FI search.

The FI for this invention is somewhere in the Main Group of "A45B Umbrellas". Using the Patent Map Guidance System, or PMGS, we make an inquiry in the Main Group of target A45B.

Searching for related FI from the viewpoints of "lighting device" and "the end of umbrella ribs", we find A45B3/04@C and A45B25/10.

Using FI search, we now search for the theme of 3B104 with A45B3/04@C and A45B25/10 (A45B3/04@C*A45B25/10).

A similar official report can be found in the Gazette.

Advanced Industrial Property Network (AIPN)

The Advanced Industrial Property Network, or AIPN, is the system whereby examiners in IP Offices overseas can obtain patent examination information from the JPO.

The purpose of the AIPN is to reduce the workload in IP offices overseas, thereby enabling Japanese applicants to obtain patents in other countries more quickly.

Via the Internet, it's possible to obtain patent applications, their legal status, cited documents, examination information for granted claims, and the patent family of a patent application filed with the JPO.

The JPO registers the global IP addresses of the computers used in each IP office overseas, which

makes it possible to use the AIPN without having to input an ID or a password.

As economic globalization advances, many growing companies are applying for patents in other countries.

Here are the ways to apply for a patent overseas.

The Paris Convention Route

Within 12 months from the date of filing of the first patent application in the first member country of the Paris Convention, it's possible to apply for a patent in each of the other member countries. Under the Paris Convention, a person who has filed a patent application in one of the member countries will receive priority when filing in other member countries.

The PCT Route

Under the Patent Cooperation Treaty, or PCT, you can gain the same effect as applying simultaneously to all PCT member countries by submitting a single international patent application to the Patent Office of your own PCT member country.

Today, along with the increase in the number of international patent applications, applications are increasingly being made to more than one country. As it's inefficient, both in terms of the labor and time involved, to carry out an examination for the same patent in each country, efforts are now being made for international work sharing of patent examinations.

One of these is the Patent Prosecution Highway, or PPH.

The PPH tracks work sharing to enable international patent applications to undergo an accelerated examination.

Based on bilateral office agreements, the PPH makes it possible for an application whose claims have been determined to be patentable in the Office of First Filing, or OFF, to undergo an accelerated examination in the Office of Second Filing, or OSF. There is just a simple procedure upon request from the applicant. This considerably reduces the examination waiting period.

In addition, introducing work sharing for "prior art" examinations and their results enables the OSFs to avoid duplicated examinations and reduces the burden on the examiners.

As of March 2013, Japan is carrying out the PPH with 29 IP Offices.

We would now like to explain about the Utility Model System.

The purpose of the Utility Model Law is to contribute to the development of industry in the same way as the Patent Law by promoting the protection and utilization of devices relating to the shape or structure of items or a combination of items.

To facilitate an applicant’s prompt acquisition of a patent, there is no system of request for examination regarding applications for utility model registration. There is only a conventional formality check.

Because the right is granted without examination and abuse of that right could hinder industrial development, stricter responsibility and care is required in the exercise of the right.

The Report of Utility Model Technical Opinion evaluates the validity of the application.

Japan Patent Office examiners carry out an assessment of the novelty, inventive step, and so on, of a utility model application and report the results to the applicant.

A holder of a utility model right may not exercise that right unless he or she has given warning regarding the Report of Utility Model Technical Opinion.

End of Chapter 2