

(1) Efforts for the construction of a global patent acquisition system

[1] Present situation

Economic globalization has advanced, creating an age of "mega competition". The necessity of acquiring patents in respect of numerous countries has increased along with the number of patent applications filed in multiple countries. Respective countries, however, basically construct and operate their own systems. Therefore, as the necessity of acquiring patents in many countries increases, the following problems are emerging: ① procedures and requirements for patentability are different from country to country, ② multiple searches and examinations are made in respective countries, ③ procedures are complicated, and ④ the cost of acquiring patents is high. Consequently there is demand for constructing a system in which stable patent rights for the same invention can be globally acquired simultaneously via simple, low-cost procedures.

[2] Efforts for constructing a global patent acquisition system

① Approach for mutually exploiting and recognizing the results of searches and examinations

To cope with the aforementioned problems involved in the acquisition of patents in many different countries, it would first be effective to decrease search (prior art document search) and examination activities duplicated in patent Offices of each respective country. For many years, Japan has proposed the mutual exploitation of the results of searches and examinations in respective countries as well as mutual recognition of patents in the future. This is an approach for constructing a bilateral or multilateral practical scheme in which a patent Office of a particular country makes the maximum exploitation of the results of search and examination made in another country for the same application.

② Harmonization of the patent systems of respective countries

Discussion at WIPO on the worldwide substantive harmonization of patent laws had been frozen since January 1994, when the US restated its preference for the first-to-invent system. However, with the Patent Law Treaty (PLT) for harmonizing the

formalities of patent laws being adopted in June 2000, discussion was resumed the following November.

In the fourth session of the Standing Committee on the Law of Patents (SCP), held in November 2000, it was virtually agreed that the target and direction of the new substantive harmonization, and the matters to be harmonized in future efforts, should be as follows:

- i) For the benefit of applicants who seek worldwide patent protection, lowering of the application costs and improving the predictability of patent acquisition
- ii) To assist in decreasing the workload of patent Offices affected by the worldwide increase in applications, allowing the results of searches and examinations to be exploited mutually under work-sharing provisions
- iii) For above purposes, several requirements essential for deciding whether or not patents can be granted will be highlighted for discussion, and detailed specifications for matters of practice ("deep harmonization") will also be pursued.
- iv) In view of the excessive number of exemptions permitted in the previous agreement, no country should be granted exemptions under the new agreement in principle.

The above i) through iv) will contribute to the construction of a patent system in which stable patent rights for the same invention can be acquired easily, at low cost, simultaneously, and anywhere in the world. They will also accelerate the advance toward such a system as ①. Consequently Japan is taking a positive role in the discussion.

The fifth session of the SCP, held in May 2001, discussed point by point the first draft treaty and regulations proposed by the secretariat. The sixth session of the SCP, held in November 2001, discussed the second proposed draft treaty and regulations.

③ Reform of the PCT (Patent Cooperation Treaty)

The PCT (Patent Cooperation Treaty), with a history of more than 20 years as an international patent filing system, is also expected to develop as a future platform for acquiring patents on a worldwide scale, as can be seen from the remarkable growth in the number of applications. On the other hand, both the system users and government Offices strongly demand the improvement of the present PCT system due to complexity of procedures in the international phase and essential inefficiency created by the duplicated work between the international and national phases.

The PCT Assembly held in September 2000 discussed the establishment of a special

body for discussing the concept of proposals for PCT Reform, particularly focusing on the US proposal submitted for improving the efficiency of the PCT system. The assembly also discussed how to particularly deal with the matter. The results being taken into account, in May 2001 the first meeting of the Committee on Reform of the PCT was held to brainstorm possible ideas for reform in line with the above-mentioned US proposal.

The Committee agreed on twelve basic targets including system simplification with procedural rationalization, cost reduction for applicants, workload reduction for patent Offices, and avoidance of duplication. Methods to realize these targets will be deliberated by a working group (WG) established for the purpose. The subjects to be discussed at the WG for the time being were decided as (a) "setting the time limit for entering into the national phase uniformly at 30 months", (b) "improving coordination of international search and international preliminary examination", (c) "improving operation of the designation system", and (d) "ensuring compliance with the Patent Law Treaty".

The subsequent PCT Assembly, held in September 2001, modified the PCT in anticipation of discussion at the WG concerning the aforementioned item (a), "setting the time limit for entering into the national phase uniformly at 30 months". In the first meeting of the WG, held in November 2001, the other items were discussed, with particular progress on item (b), "improving cooperation of international search and international preliminary examination".

④ Modified Substantive Examination (MSE) system

One appropriate measure to reduce duplicated search and examination workload while maintaining the patent system of respective countries is the effective utilization of the Modified Substantive Examination (MSE) system.

In this respect, in June 2001, JPO was designated as an elected offices described in the Patent Law of the Republic of Croatia. This enables an applicant to file a request for the grant of a Croatian patent on the basis of the submitted result of the substantive examination of a corresponding patent application filed with JPO for the same invention as in the Croatian patent application.

[3] Efforts accompanying revision of domestic laws

① Institutional modifications

From the viewpoint of promoting international harmonization and facilitating office

work in respective applications, the JPO has decided to review its application style by July 2003 in order to separate claims from specifications.

Furthermore, to reflect an October 2001 PCT Assembly decision, consideration is being given to extending the time limit for the national phase entry from 20 months to a uniform 30 months, even under PCT Chapter 1 procedure. To secure the time to prepare a translation for an international application filed in a foreign language, consideration is also being given to allowing, in cases where the national entry form is submitted before the expiration of the time limit for entering the national phase, the translation of the international application to be submitted within two months from the date of submission of the national entry form.

② Future intentions

Review of application formality was discussed at the Intellectual Property Policy Committee of the Industrial Structure Council, and recommendations were presented. It is planned to submit Patent Law bills to an ordinary session of the Diet in 2002.