

Part 2

Government Efforts in Intellectual Property Activities



Chapter 1

Efforts for Overall Intellectual Property



1. Current Status of Intellectual Property Strategies in Recent Years

The society and the economy are changing drastically in recent years due to the advanced informatization, the economic globalization, and advanced and sophisticated technologies. Under such circumstances, intellectual property such as patents is a key to the growth that creates innovation and intellectual property strategies toward the future are becoming more and more important for Japan.

The “new growth strategy (basic policy) decided by the Cabinet on December 30, 2009 mentions the importance of intellectual property. In particular, “Science and Technology”, one of the six strategic fields in the strategy, cites “institutional and regulatory reforms to create innovation and appropriate protection and utilization of intellectual property” as a top priority.

In addition, “The Intellectual Property Promotion Plan 2010” established by “The Intellectual Property Policy Headquarters,” headed by the Prime Minister, states the three main strategies: 1) Acquisition of international standard in specific strategic fields, 2) Growth strategy with the strengthening of content as its core and 3) Measures for enhancing intellectual property policy from a cross-industrial point of view. Among them, 3) Improvement measures of intellectual property from a cross-industrial point of view cites, in particular, the enhancement of support measures for venture and SME businesses, the construction of a place for industry-government-academia joint creation, the improvement of cooperation of universities with the industry, and the promotion of international harmonization of the patent system as a particular measure.

Under these circumstances, the Japan Patent Office (JPO) held the Intellectual Property Policy Meeting under the Industrial Structure Council in March 2010 for the first time in two years and started a discussion on the future course of intellectual property policy in order to establish a more timely intellectual property system. To be more specific, the JPO is considering a system friendly to SME businesses and universities where intellectual property has not been used to the fullest extent as well as to the existing users.

The JPO is also strengthening and expanding its international network of the intellectual property system by enhancing a cooperative relationship with other countries, so that Japanese companies can operate seamlessly taking into account the situation that Japanese companies are under severe competition in the global market.

Chapter 2

Efforts Related to Patents

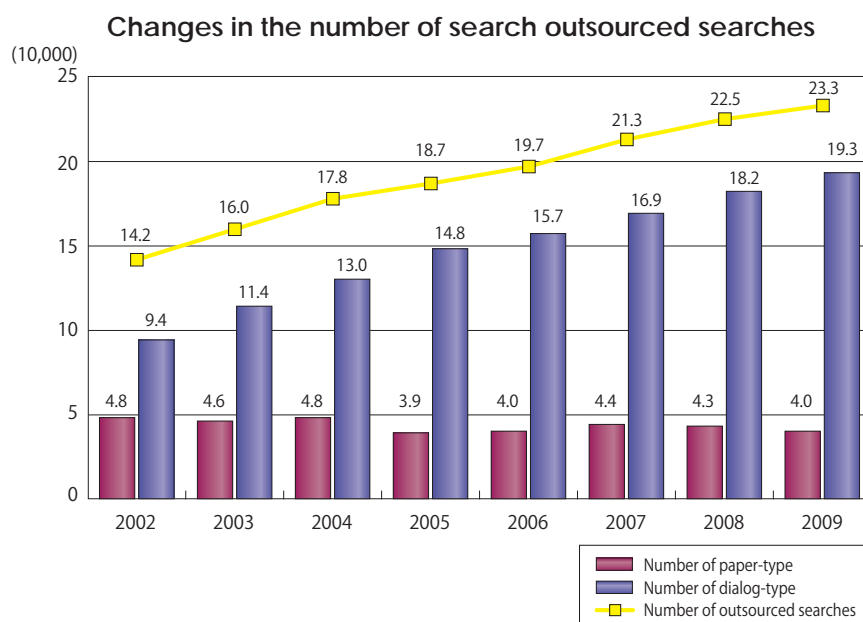


1. Promotion of Acceleration of Patent Examination

(1) Expansion in Volume of the Outsourcing of Prior Art Document Searches

The number of prior art document searches outsourced increased in FY2009 by 3.6% from FY2008 to 233,000 of which the dialogue-type outsourcing with high examination efficiency¹ accounted for 83% of the total number of prior art searches outsourced to 193,000, achieving the expanded outsourcing to private sectors and improvement of efficiency.

This expansion of outsourcing of prior art document searches is mainly due to the commencement of operation of registered search organizations in the other technical field, the recruitment of searchers of the existing registered search organizations and increase in their processing capacity.



Note:

“Paper-type” is an outsourcing method in which the results of the search are reported by the search report.

¹ “Dialogue-type outsourcing” is an outsourcing method in which the patent examiner receives the report of the prior art search result from the searcher together with the oral presentation of the searcher and on the basis of this report, to improve the understanding of the examiner on content of the invention and prior art documents.

Furthermore, for the purpose of further expansion of the number of registered search organizations in charge of prior art document searches, the JPO also strived to publicize the registered search organization system in FY2009, such as consultations with prospective new entrants. Among the existing organizations, Techno Search, Inc. has started operations in field 10 (automatic control) since May 2009, Technology Transfer Service Corp. in field 3 (material analysis) since October 2009, and Pasona Group Inc. in field 29 (plastics engineering) since October 2009. Moreover, Pasona Group Inc. has been additionally registered in field 3 (material analysis) and Advanced Intellectual Property Research Institute Co., Ltd. has been additionally registered in field 4 (applied optics) and field 6 (business equipment), respectively to further utilize the power of the private sector.

It is expected that the new entry of registered search organizations and the registration of the additional technical field of the existing organizations would increase in the future.

Registered search organization list (as of April 2010)

Name of registered search organization	Registered technical field	Number of searchers
(General incorporated foundation) Industrial Property Cooperation Center	All fields	1,635
Techno Search, Inc.	10(automatic control), 11(motive machinery), 12(transportation), 13(general machinery), 14(production machinery), 15(logistics and assembly), 19(heating refrigerating)	100
(Aggregate corporation) Japan Association for International Chemical Information	30 (organic compound)	23
Technology Transfer Service Corp.	3(material analysis), 8(amusement), 19(welfare and service apparatus)	39
Advanced Intellectual Property Research Institute Co., Ltd.	4(applied optics), 5 (opto device), 6(business machinery)	45
Patent Online Search Corp.	8 (amusement)	26
Pasona Group Inc.	3(material analysis), 10(automatic control), 29(plastic engineering)	59
Koga Research Institute Inc.	23 (semiconductor device)	15

(2) Securing a Necessary Number of Examiners

The JPO has established, ahead of other countries, a paperless system for the procedures, from the filing of an application to the examiner's decision, and actively promoted the World's first outsourcing of prior art searches to private sectors. As a result, the examination efficiency in the JPO has already enhanced to a considerable degree, as seen in the fact that the examination capability of the JPO is about 2.5 times as much as that of the USPTO and about 4.5 times as much as that of the EPO.

While the JPO will inevitably strive to promote examination efficiency, it will be necessary to increase the number of patent examiners in order to greatly enhance its examination

capability. The JPO has achieved the significant increase in the number of examiners including hiring about 500 fixed-term examiners in five years from FY2004 to FY2008. Moreover, since FY2009, the fixed-term examiners who completed the term (five years) have been reemployed to maintain the JPO's examination capability.

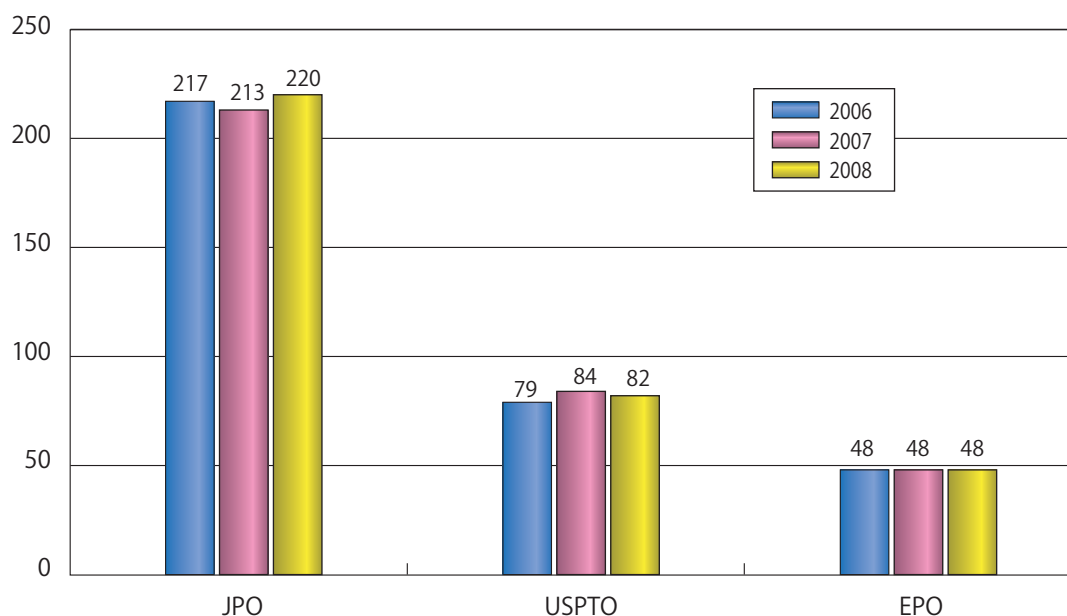
Although the increase in examiners has not been easy under the current government's policy of decreasing the number of public officers, it is necessary for the JPO to maintain and enhance the examination capability by continually striving to secure the necessary number of examiners in FY2010 onwards for the purpose of shortening the examination pendency.

Increase in the Number of Patent Examiners

FY	2006	2007	2008	2009	2010
Regular examiners	1174(+12)	1175(+1)	1190(+15)	1202(+12)	1213(+11)
Fixed-term examiners	294(+98)	392(+98)	490(+98)	490	490
Total	1468(+110)	1567(+99)	1680(+113)	1692(+12)	1703(+11)

Note: The numbers in the brackets indicate the increase and decrease from a previous year.

Number of Applications Examined per Examiner



Note:

Number of applications examined is equal to the number of first actions (the number of search reports in the case of the EPO) plus the number of international search reports.

Sources:

Trilateral Statistical Report and Four Offices Statistical Report

2. Efforts for Maintenance/Improvement of the Quality of Patent Examination

(1) Trends in the Quality of Patent Examination

Securing the accuracy of patent examination is an essential requirement for preventing unnecessary ex-post disputes and unnecessary application competition and to maintain the sound patent system. In fact, a social demand for accelerating the patent examination and maintaining and improving the quality and accuracy of patent examination is very strong.

High quality patent examination is a precondition of utilizing results of prior art searches searched and examination conducted by other Offices for the purpose of promoting international work sharing. It is a common problem at each Office to improve a framework and procedures for realizing such high quality patent examination. The quality of patent examination has been discussed at the Trilateral Office Meeting (the JPO, the USPTO and the EPO) and the Five IP Office Meeting (the SIPO and the KIPO in addition to the trilateral offices).

In addition, with regard to PCT applications, Chapter 21 of “the PCT International Search and Preliminary Examination Guidelines (hereinafter referred to as “the PCT Guidelines”) includes the provision on the quality framework. It requires all International Searching Authorities and International Preliminary Examination Authorities, including the JPO to implement high quality international search and preliminary examination by monitoring and measuring the compatibility with the PCT Guidelines, improving it continuously, and establishing “the quality management system” including searches on customers. This quality framework has been discussed continuously between the organizations (offices).

(2) Efforts Concerning Examination Standard

In the “Report on Intellectual Property Strategy” by The Expert Panel on Management of Intellectual Properties, Council for Science and Technology Policy, on May 18, 2007, a suggestion was made to establish and publish a digest for clarifying the necessity of deposit to obtain a patent of inventions concerning microorganisms (including animal cells and plant cells). In response to this, “the Digest Regarding the Necessity of Microorganism Deposits” was established and published in January 2009 (See Part 2, Chapter 2-3. (1)) through deliberations in the first explanatory committee on the patent microorganism deposit system and the first expert committee on examination standard of the Patent System Subcommittee of the Intellectual Property Policy Committee, the Industrial Structure Council.

In May 2009, “Patent Protection in Field of Advanced Medical Technologies” was established by Advanced Medical Patents Committee, Panel on Enhancement of Competitiveness through Intellectual Policy, Intellectual Property Strategy Headquarters, and suggestions were made to clarify the subject to patent and review the scope of patent in the Examination Guidelines. Based on this suggestion, the revised Examination Guidelines on “Industrially Applicable Inventions” and the revised Examination Guidelines on “Medicinal Inventions” were established and published in October 2009 through deliberations at the third meeting of the Expert Committee on Examination Standard (See the column in Part 2, Chapter

2-3).

In November 2009, hyper texts of the Examination Guidelines were made, and links based on the reference relationship between each item of the Examination Guidelines, and links to related information on the Examination Guidelines such as all texts of posted court decisions and the relevant texts on the website of the legal data provision system were established. They are published on the JPO website as the HTML-version "Examination Guidelines for Patent and Utility Model."

In November 2009, the trilateral Offices conducted a comparative study and a case study of legislations and Examination Guidelines on novelty in order to support the establishment of high quality application documents following to studies on the requirements for description and claims (2007, 2008) and on the inventive step (2008). A comparative study in examination work by the trilateral Offices entitled "The Comparative Study Report on Novelty" was published.

In December 2009, "the Guidelines for the Presentation of Nucleotide and Amino Acid Sequence Listing in Patent Applications" was revised to respond to the revision of the PCT Administrative Instructions and the WIPO Standard ST.25 for unifying the notation of sequence in establishing descriptions, etc. concerning applications including nucleotide sequence or amino-acid sequence.

In January 2010, the fourth meeting of the Expert Committee on Examination Standards deliberated on revision of the Examination Guidelines for new matters. It has agreed to revise for clarifying the Examination Guidelines in line with the outline for Examination Guidelines revision, so that the Examination Guidelines are in conformity with the Grand Panel decision of Heisei 18 (Gyo-ke) 10563 issued by Intellectual Property High Court on May 30, 2008. In March 2010, public comments were solicited concerning draft revisions of the Examination Guidelines of new matters.

In January 2010, the fourth meeting of the Expert Committee on Examination Standards also deliberated on inventive step and agreed not to revise the Examination Guidelines at this time from a viewpoint of legal stability and to clarify the Examination Guidelines by publishing "Case Study on ""Inventive Step,""" a digest of court decisions on inventive step. In February 2010, the said "Case Study on ""Inventive Step"" was provided by linking it to each item on the HTML-version Examination Guidelines for patent and utility model.

(3) Promotion of Quality Management of Patent Examination

The JPO has maintained and improved the quality of patent examination through both 1) "Quality Control" performed for each patent application at each Art Unit and 2) "Quality Management" exercised from a cross-sectional point of view.

1) "Quality Control" of Examination for Each Patent Application

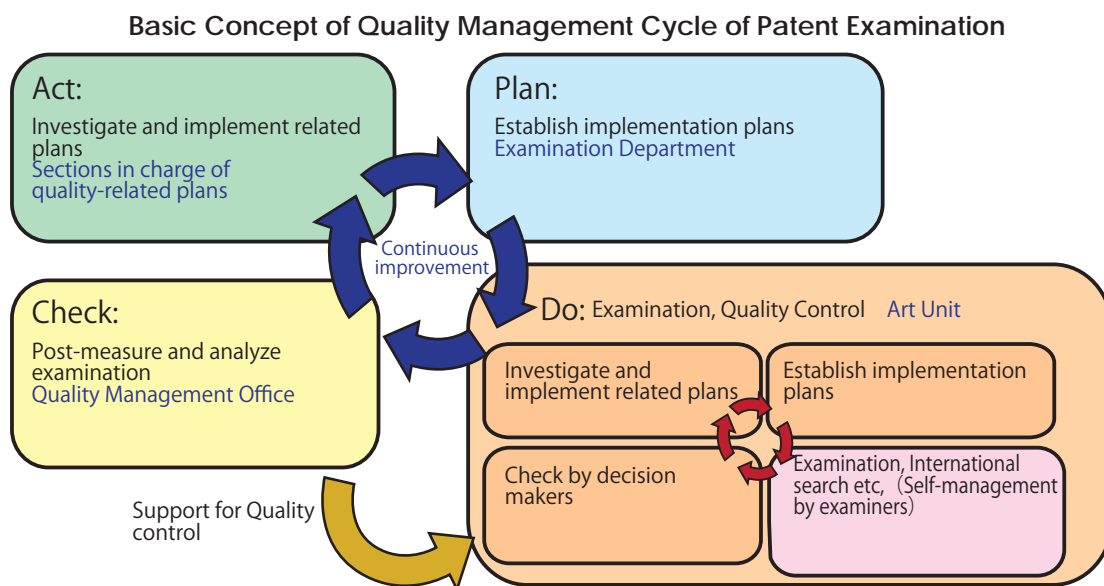
Each Art Unit at which applications of each technical field are examined strives to perform the "Quality Control" of examinations for proper examinations of individual cases based on the Examination Guidelines by unifying application of the judgment standards between each

examiner through consultations between several examiners, checks of the content by a director, etc.

2) Cross-sectional “Quality Management”

Furthermore, the JPO sets a quality management system to continuously improve the examination quality based on a concept of the quality management cycle (PDCA cycle²) of patent examination. Under this concept, examination results are post-measured and analyzed objectively, and then the results are reflected on the implementation plan to maintain and improve examination quality. In April 2010, the JPO established “Quality Management Section” in the Administrative Affairs Division, and the quality management system was enhanced further.

To be specific, the Quality Management Section conducts the internal review on individual case by the third party in the JPO, collects user reviews, and analyzes related statistical information. In addition, these results of the analyses are utilized for considerations on measures to improve examination quality by related sections, and the feedback is given to the Art Units for supporting the Quality Control at each Art Unit.



² Management cycle to maintain and improve the quality and promote the improvement of works suggested by Dr. Deming, an American statistician, in the 1950's: The process of Plan, Do, Check and Act is implemented in order for continuously improving a system by utilizing the results of Check.

3. Efforts Concerning Protection of Advanced Technology Fields

(1) Publication of the digest concerning the necessity of microorganism deposit

In Japan, in a case of an invention relating to microorganism and a person skilled in the art cannot obtain the said microorganism easily, the applicant shall guarantee the enablement requirement by attaching a document that proves that the said microorganism has been deposited to an international depositary authority under the Budapest Treaty (hereinafter referred to as "the international depositary authority") or an organization designated by the Commissioner of the Japan Patent Office (hereinafter referred to as "the designated organization") to the request, allowing the international depositary authority or the designated organization to furnish a third party with a sample of the said microorganism under certain requirements.

Concerning the deposit of microorganism, it is not necessarily clear in what case the deposit is required. Therefore, it was necessary to establish a specific standard for judgment for a smooth operation of the system. From such point of view, a proposal was made to establish and publish a digest for clarifying the necessity of deposit for obtaining a patent in the case of applications relating to microorganisms (including animal and plant cells) through the "Report on Intellectual Property Policy" issued at May 18, 2007 at the Expert Panel on Management of Intellectual Property, Council for Science and Technology Policy.

Under these situations, the JPO deliberated on the matter in FY2007 and established the "Digest concerning the Necessity of Deposit of Microorganisms (draft)." To be specific, judgment on whether or not the deposit of bacteria, antibodies, cells and animals before the application is necessary is presented with its reasons based on the cases.

The first meeting of the Explanatory Committee on the Patent Organism Deposit System (June 23, 2008) deliberated on this Digest (draft) as a part of the review of the patent microorganism deposit system and agreed to publish it as a part of the digest of the Examination Guidelines.

After the first meeting of the Committee on Examination Standards of the Patent System Subcommittee of the Intellectual Property Policy Committee, the Industrial Structure Council (November 5, 2008) approved this digest, public opinions on this digest (draft) were solicited. Based on the opinions submitted, "Digest concerning the Necessity of Deposit of Microorganisms" was published in January 2009 as an additional case of Part VII, Chapter 2 "Biological Inventions" of the Examination Guidelines for patent and utility model. The outline of this digest is as follows:

- 1) It explains the judgment on whether or not microorganisms need to be deposited before the application based on particular cases.
- 2) It consists of the total of ten cases (four cases that require the deposit and six cases that do not), inventions relating to bacteria (three cases), inventions relating to antibodies (three cases), inventions relating to cells (two cases) and inventions relating to animals (two cases).

(2) Deliberations on the Extension System of Term of Patent Right

1) Establishment of the Working Group on Extension System of Term of Patent Right

The extension system of term of patent right was introduced as a result of the revision of the Patent Act in 1987, and medicines under the Pharmaceutical Affairs Act and agricultural chemicals under the Agricultural Chemicals Regulation Law were designated as its target by the Cabinet Order.

The target of the extension system has not changed since then including the revision in 1999.³ Twenty years have passed since the introduction of the system, and innovative new technologies such as genetically-modified organisms and DDS (drug delivery system)⁴ using the nanotechnology have been developed. In the report entitled "For the Development of Intellectual Property Frontier" (intellectual property strategy by each field) established by the Panel on Enhancement of Competitiveness through Intellectual Property of the Intellectual Property Strategy Headquarters, a suggestion was made that "although unnecessary extension of term of patent right may inhibit the free use of technologies," "it may be necessary to allow the right holder to recover the investment costs in a case where it takes much time to receive an administrative disposition so that the term of patent right is substantially reduced" and "it is necessary to research and deliberate on this point."

Under such a situation, "Intellectual Property Strategic Program 2008" published by the Intellectual Property Strategy Headquarters on June 18, 2008 recommends to comprehensively deliberate on the overall system including a review of the target of the extension system of term of patent right, taking into account the international trends. The Plan provides that "such deliberation shall start immediately and be concluded in FY2008." Thus, the Working Group on the Extension System of Term of Patent Right was established under the Patent System Subcommittee of the Intellectual Property Policy Committee, the Industrial Structure Council to comprehensively deliberate on matters such as a) expansion of regulation subject to the target of extension, b) a point of view to judge whether the disposition is first (especially DDS), and c) overall system of the number of patent rights that can be extended per disposition, taking into account the international trends.

2) Publication of Interim Report

At the fifth meeting of the Working Group on the Extension System of Term of Patent Right held on July 16, 2009, an interim report (draft) was suggested with regard to the concluded conditions for regulation subject to the target of the extension system among the points mentioned in the Intellectual Property Strategic Program 2008. Public opinions on the interim report (draft) were solicited and the interim report was published in September 2009 based on the submitted opinions.

³ At the beginning of the introduction of the system, there was a requirement that "if there is a term when the patented invention cannot be worked more than two year." However, this requirement was deleted at the revision of the Patent Act in 1999.

⁴ DDS is a medical technology that enables to efficiently carry a drug to an affected site using a nano-size capsule, etc. so that it exercises its efficacy only at the affected site.

The interim report states that careful deliberations should be made on whether the following conditions are met as a condition for including in the target of the extension system.

a. Preconditions based on the purpose of the system

- Disposition by regulation prohibits the working of patented invention as a business
- There is an inevitable examination term of regulation as an overall target of the relevant regulation and the reduction in the relevant term is also limited from a point of securing the safety
- It requires same term for examination of safety as medicines and agricultural chemicals

b. Conditions from a viewpoint of policy

- Consider the balance between a patent right holder and a third party relevant to the disposition
- Consider whether or not it contributes to the progress of innovation
- Consider the international trends

As a result of particular deliberations on transgenic organisms, medical equipment, quasi drugs, food additives and food for specified health use, no reason was found to newly include them in the target of the extension system at the moment.

(3) Holding of Examination Guidelines Seminars in the Field of Life Science

In the “Report on Intellectual Property Strategy” issued by the Expert Panel on Management of Intellectual Properties, Council for Science and Technology Policy, on May 18, 2007, it was suggested that “explanatory meetings using the Examination Guidelines and cases of patents in the field of life science should be held for researchers of universities and parties concerned in intellectual property.” In “the Intellectual Property Strategic Program 2009” published by the Intellectual Property Strategy Headquarters in June 2009, it is also suggested that “more efforts will be made by holding explanatory meetings on the Examination Guidelines in the field of life science for universities and research institutions since FY2009 in order to familiarize universities and research institutions with the content of the revised Examination Guidelines.”

In response to this, the JPO has held the explanatory meeting on the Examination Guidelines in the field of science field nationwide for researchers and engineers of universities and public research institutions since FY2007 for contributing to better understanding of researchers of universities and parties concerned in intellectual property on the judgment on patentability of patents in the field of life science. It was held in 11 places in FY2007, in 14 places in FY2008 and in 13 places in FY2009. Materials used in the explanatory meeting on the Examination Guidelines are posted on the JPO’s website.

(4) Revision of Examination Guidelines for Expanding the Protection Target in the Field of Advanced Medical Technology

1) Background to the revision

In recent years there has been increasingly fierce competition over the acquisition of intellectual property rights for advanced medicine, accompanying the intense global research competition for the realization of advanced medicine, such as with the progress of research into iPS cells. In response to this situation, in June 2008 the Intellectual Property Strategy Headquarters decided to make an investigation into appropriate patent protection in the field of advanced medicine, incorporating iPS cell-related technologies, in our IP Strategic Program 2008. Following this decision, in November 2008 an "Advanced Medical Patents Committee" was formed under the Panel on Enhancement of Competitiveness through Intellectual Property of the Intellectual Property Strategy Headquarters. Investigations were then begun into appropriate patent protection for advanced medicine. As a result, on May 29, 2009, a report "Patent Protection in Field of Advanced Medical Technologies"(Intellectual Property Strategy Headquarters)" was issued by the Advanced Medical Patent Exploratory Committee under the Expert Study Group on Enhancement of Competitiveness through Intellectual Property, the Intellectual Property Strategy Headquarters, which was reported to the 23rd meeting of Strategic Council on Intellectual Property on June 24. The contents of the report are as follows;

In order to protect the medicinal inventions with new dosage and administration, as inventions of "products," which show the effect exceeding beyond the expectation of the person skilled in the art, Examination Guidelines should be revised, (adding the concrete examples)

In order to newly add "the methods for gathering data from the human body for assisting the conclusive diagnosis"(mechanisms or principles of tomographic imaging by MRI or X-ray CT etc.) to patentable subject matter, Examination Guidelines should be revised, (adding the patentable and non-patentable examples)

Recommended by the report, the JPO decided to revise the Examination Guidelines for Patent and Utility model and the principle for establishing the revised Examination Guidelines was approved by the third meeting of the Committee on Examination Standards of the Patent System Subcommittee of the Intellectual Property Policy Committee, the Industrial Structure Council held in June 30, 2009. Then, the Draft Revision of Examination Guidelines of "Part II, Chapter 1 Industrially Applicable Inventions" and the Draft Revision of Examination Guidelines of "Part VII, Chapter 3 Medicinal Inventions" were published on August 6, and we invited interested parties to submit written comments on them. Considering the submitted public comments, these guidelines were published on October 23, 2009.

These revised guidelines have been applied to the applications that are examined on and after November 1, 2009.

2) The outlines of the Revised Examination Guidelines

a. Regarding Part II, Chapter 1 "Industrially Applicable Inventions"

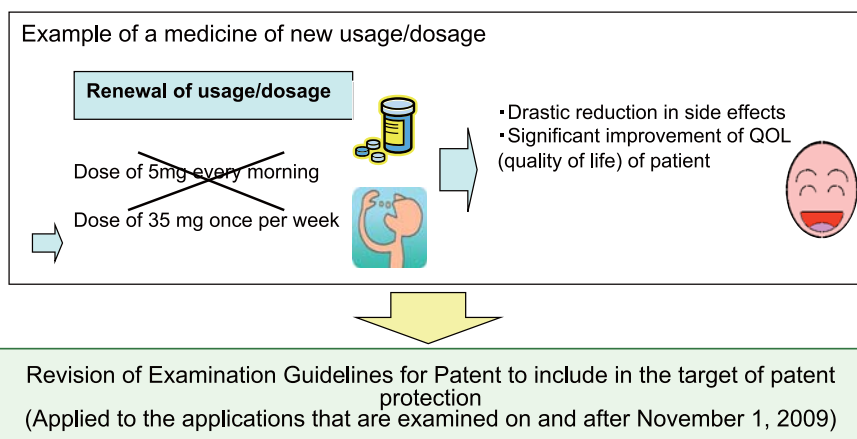
- a-1. The methods of gathering data from the human body is made not considered to be "methods of diagnosis of humans," as long as it does not contain the surgical or therapeutic steps or the steps of judging the condition of diseases etc. of human for medical purposes.
- a-2. The examples of the inventions related to the combinations of products (combination of physical means and biochemical means, combination of tissue-derived materials and scaffolding materials, and combination of tissue-derived materials and medicine etc.) are added.
- a-3. It is made clear that the methods of inducing differentiation of cells etc. are not "methods of surgery, therapy or diagnosis of humans," and the examples of the inventions of related arts are added.
- a-4. The examples of the inventions of arts related to assisting devices are added.

b. Regarding Part VII, Chapter 3 "Medicinal Inventions"

- b-1. In medicinal inventions, the invention is novel when there is difference between the invention and the conventional medicine in medicinal use of applying to a specific disease with a specific dosage and administration⁵.
- b-2. The examples of the inventions characterized in the medicinal use of tissue-derived materials (cells etc.) are added.
- b-3. The examples of the inventions characterized in the medicinal use of cells specified by manufacturing process are added.

Revision of Examination Guidelines in the Field of Advanced Medical Technology

(1) Measuring method for diagnosis (Methods for gathering data from the human body)
 (2) Medicinal inventions with new dosage and administration
 Decided to expand the patent protection in the fields mentioned above (May 2009/ Intellectual Property Strategy Headquarters)



⁵ The EPO Enlarged Board of Appeal also handed down its decision (G2/08) that inventions solely distinguished by a dosage regime may be patented on February 19, 2010.

3) Promulgation of the Revised Examination Guidelines

The revised Examination Guidelines were also presented in "Examination Guidelines for Patent and Procedure of Examination" at the 2009 Explanatory Meeting on Intellectual Property Right System (for specialists) (held at 17 places nationwide) and at the 2009 Examination Guidelines seminar in the field of life science (held at 13 places nationwide) for further promulgation.

4. Efforts to Realize Patent Examination that Meet the Needs of Applicants

Under the circumstances that applicants have various needs, such as acquiring patent rights regarding multiple aspects of products, acquiring patent rights rapidly, and acquiring patents rights strategically from the global perspective, the JPO has implemented the following measures of patent examinations to support applicants' IP strategies.

(1) Promotion of Use of the Accelerated Examination System

In an effort to support global economic activities and utilization of R&D results at an early stage, the JPO has already conducted accelerated examination in response to the submission of "a written explanation of the needs of the accelerated examination" with respect to (a) applications relating to inventions that have already been put into practice or planned to be put into practice within two years (working related applications), (b) applications which have foreign patent families (internationally filed applications), (c) applications filed by SMEs and venture businesses, or (d) applications filed by universities/TLOs and public research institutions which are expected to return their results to the society.

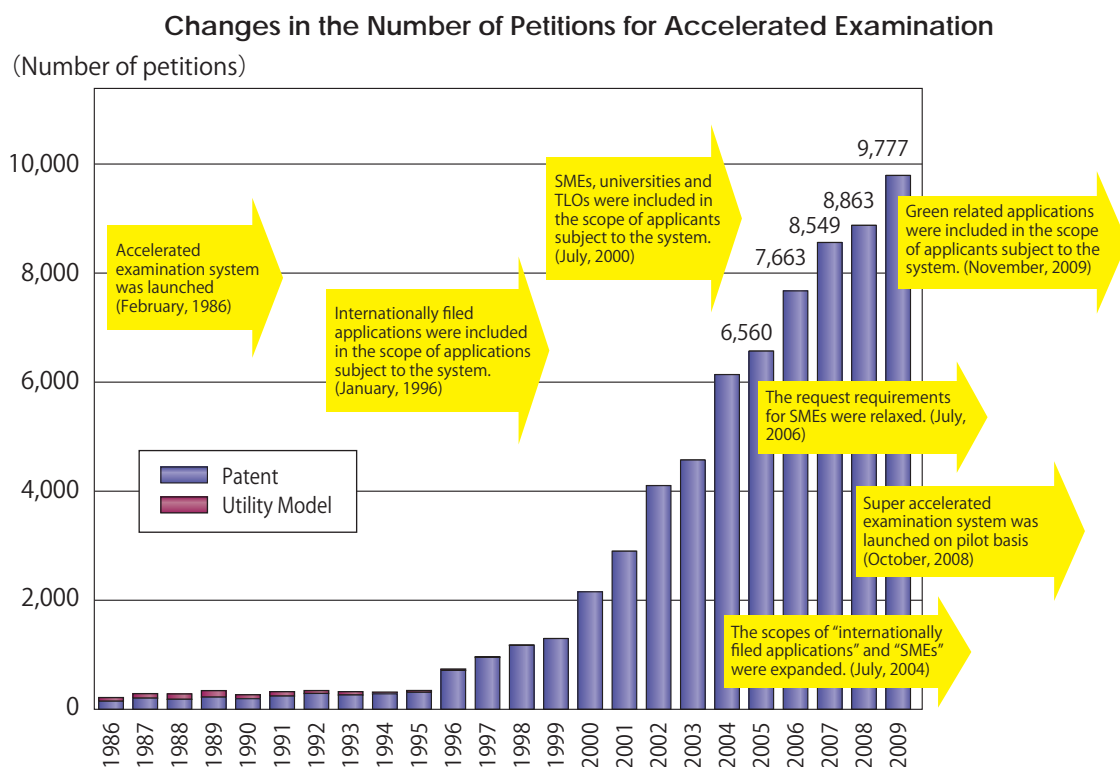
The JPO has been striving to improve the convenience of the system through the following measures: (a) expanding the scope of "internationally filed applications" and the scope of "SMEs" in 2004,⁶ (b) reducing the burden of prior art search in the case of applications from SME applicants, and revising the guideline to clarify the requirements for prior art search in the case of joint applications filed by large-scale business and SMEs, in July 2006.⁷ As a result of these efforts, the number of petitions for accelerated examination has been increasing every year. Applications concerning environmental technologies (green related applications) newly made eligible for accelerated examination and the pilot program had started, in November 2009.⁸

⁶ The scope of applications subject to "internationally filed applications" was expanded to include the corresponding national applications of PCT applications in the international phase. The scope of SMEs was expanded to the same extent as the scope of SMEs subject to the "Patent Prior Art Search Support System."

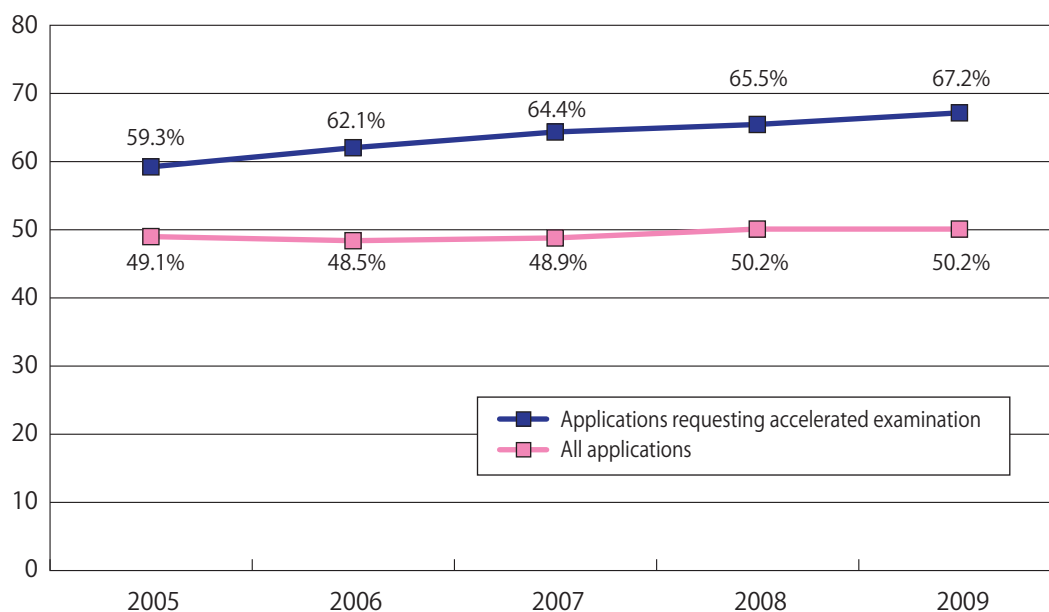
⁷ The guidelines were revised so that the system does not necessarily require SMEs to conduct prior art searches for disclosure of information on prior art, but only requires SMEs to fill out prior art documents they know when filing a request. This is also applicable in the case of joint applications filed along with a large-scale business if certain requirements are satisfied.

⁸ See Part2, Chapter 2, 4(3).

In 2009, the average first action pendency for applications under the accelerated examination system was about 1.8 months from the applications for accelerated examination, much shorter than the average for ordinary applications. The rate of decisions to grant a patent of the applications under the system has hovered more than 10% higher than that of whole applications. This seems to be attributable to the fact that applicants carefully selected their applications when petitioning for accelerated examination, as the target of the system includes working related applications and the system requires applicants to conduct prior art search before petitioning.



Changes in the Rate of Decisions to Grant a Patent under the Accelerated Examination System



(2) Super Accelerated Examination System

From the perspective of accommodating the applicants' various needs, the JPO established the "Super Accelerated Examination System" under which applications are examined more rapidly than under the conventional accelerated examination system. This system was launched in October 2008 as a pilot program. At the beginning of the pilot program, international applications based on the Patent Cooperation Treaty transferred to the national phase (DO applications) were not subject to this new system, because it was difficult to reduce the period required for administrative processing. However, DO applications have been added to the scope of the super accelerated examination system since October 2009, as the period for administrative processing of DO applications was reduced because of the improvement of the administrative processing system. The pilot program has been in practice by expanding its scope.

The basic outlines of the super accelerated examination system are that first action is finished within one month from the petition for super accelerated examination (within two months in principle for DO applications), and a subsequent examination⁹ is also finished within one month from the submission of written opinion/amendment, thereby reducing the period from the petition to the final decision compared to the conventional accelerated examination system.

In the pilot phase, the system targets more important applications, which meet both the requirements for "working related" applications and the requirements for "internationally filed" applications out of the requirements for the conventional accelerated examination system.

The number of petitions for super accelerated examination was 310 in 2009. The average first action pendency of applications under the super accelerated examination system in 2009 was about 25 days from the petition for super accelerated examination.

(3) Green Accelerated Examination System

In order to protect the achievements of R&D concerning environmental technologies as fast as possible and to promote further R&D, "green-related applications" were newly made eligible for accelerated examination. This system was launched in November 2009 as a pilot program.

"Green-related applications" refer to patent applications that intend to obtain a patent of "green invention (inventions that have an energy-saving effect and contribute to the reduction in CO₂)."⁹ "Green inventions" are interpreted in a broad sense from a viewpoint of widely including inventions that contribute to the environment in the target of accelerated examination. Therefore, not only inventions that contribute to energy conservation and the reduction in CO₂, but also those that have an effect on resource saving and the reduction in environmental burden are included in the green inventions.

The application for green accelerated examination is from November 1, 2009 to March 31, 2010 and 47 applications were made. The JPO will strive to publicize the green accelerated

⁹ Subsequent examination is conducted based on a written opinion or a written amendment when an applicant submit it against the notice of reasons for refusal.

examination system and to promote its expansion.

(4) Promotion of Interview Examination

In order to communicate smoothly between the examiner and the applicant or the attorney to contribute to the efficiency promotion of the examination procedure, the interview examination is conducted within the JPO.

Since FY1996, for SMEs, venture businesses, universities and TLOs in provincial areas, the JPO has implemented circuit interview examinations under which examiners visit the interview sites placed nationwide in provincial areas, and meet the applicants directly to consult on the application and the technical content. In 2009, the JPO conducted the total of 1,198 circuit examinations.

(5) Steady Implementation of Consolidated Examination Program for Relevant Applications

The JPO has implemented consolidated examination program for relevant applications, where the examiner systematically grasps the technical contents through technical explanation/interview, regarding the groups of applications which have technical relevance, and examines them collectively. By appropriately reviewing the consolidated examination program for relevant applications to better suit needs, the JPO will continue to support applicants for the strategic acquisitions of patent rights.

(6) Provision of Predicted Period for Starting Patent Examination

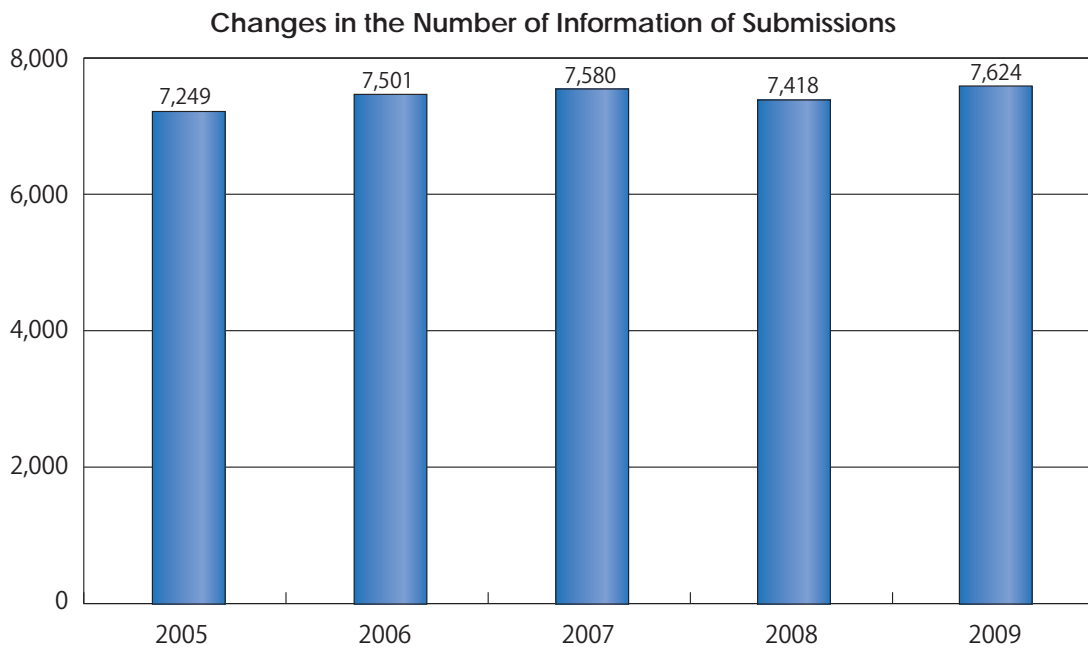
In order to support the strategic patent management of the applicant and the attorney, the JPO has provided the predicted period for starting the examination for the application of which examination has not yet started (except the application before the publication thereof) per an applicant or an attorney since October 2003 through "Inquiry of predicted period for starting patent examination" on the JPO's website. In addition, since May 2007, its function has been extended so that the third party also can see the above predicted period.

By the provision of predicted period for starting patent examination, JPO promotes discussion on necessity, etc. of right reservation by applicant and assists applicant to use systems of accelerated examination, interview examination, information provision and refund of request for examination, as needed.

(7) Submission of Information by Third Parties

For enhancing the accuracy and promptness of the examination, the JPO accepts widely a submission of information. The submission of information accepts the information useful for the examination such as that the invention related to the patent applications does not have novelty or inventive step, or that the invention does not fulfill the requirements for the description (Ordinance for Enforcement of the Patent Act Article 13-2), and 76% of the provided information has been utilized for notice of reasons for refusal.

The information provision has become possible through online since January 2009.



5. Promotion of International Cooperation for Patent Examination

Following the global increase of the patent applications under the background of ongoing globalization of the market and business activities, the number of duplicate applications which mean that the same invention is filed in multiple offices is increasing. In addition, the examination load of each office has been increasing in line with the increased importance of intellectual property. Under such a situation, the JPO is promoting the work sharing of the patent examination with various Patent Offices using the framework of international cooperation to improve the accuracy and efficiency of examinations in the worldwide Patent Offices and to provide options to efficiently protect intellectual property at a global scale.

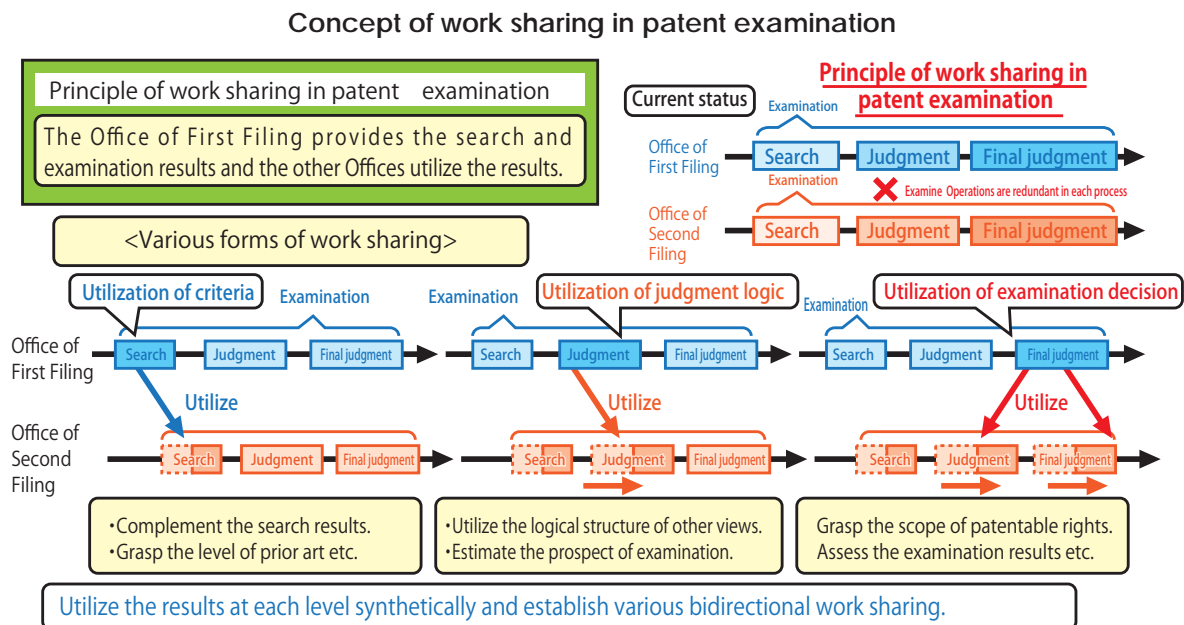
(1) International Work Sharing in Patent Examination

The principle of work sharing of the patent examination is that the Office at which the application was filed first (Office of First Filing) releases the results of the search and examination first and the other Offices utilize the results in the examination.

Here, the work sharing for making use of the search and examination results includes those of various levels such as (a) that making use of only the search results, (b) that making use of the logic of the judgment for the patentability in addition to the search results, and (c) that making use of all examination results including the final decision. The degree of usefulness of them in the examination differs from each other. However, it is possible not only to promote the efficiency of the examination but also to make the examination results to be more appropriate by considering the validity of the examination results of the Office of First Filing at any level so that a valid part can eliminate the duplicate work. The Office of Second Filing complementally searches and examines an invalid part.

Thus, it is important for the Office of First Filing to release the search and examination results at an early stage so that the Office of Second Filing can make use of the search and examination results of the Office of First Filing at the most appropriate level in order to promote

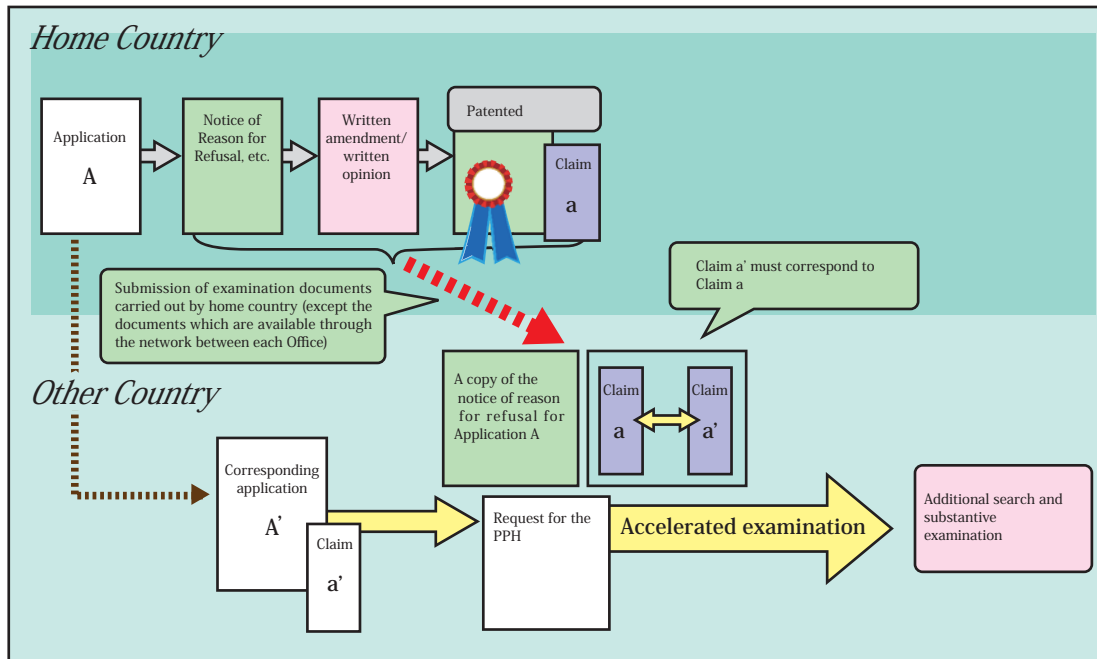
the bidirectional work sharing at various levels. The JPO has implemented the following efforts 1) to 4) in cooperation with worldwide Patent Offices.



1) Patent Prosecution Highway

The Patent Prosecution Highway (PPH) is a framework for allowing, on request by the applicant, accelerated examination in the Office of Second Filing with simplified procedures, with respect to the application which was determined to be patentable in the Office of First Filing. This framework supports an efficient acquisition of a stable and strong patent right in multiple Offices through making use at the above level (c), that is, making use of all examination results including the final decision in the Office of Second Filing.

Outline of the Patent Prosecution Highway



The applicant for the PPH can receive three major benefits.

The first benefit is the improvement of patent quality. The grant rate of applications from the USPTO to the JPO is usually 37%, while the grant rate of applications using the PPH is as high as 59% (2009). The predictability of acquisition of a patent becomes higher for the applicant and it is possible to acquire a more stable right as examiners in the JPO and the USPTO examine the application based on the same claims in principle.

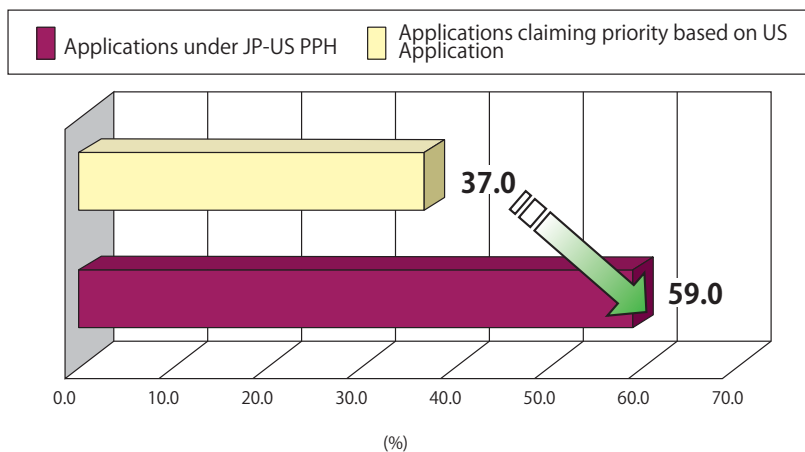
The second benefit is acceleration of examinations. For example, in the USPTO, the average examination pendency from the filing of an application to the commencement of examination is usually about 29.1 months in 2009, while the examination pendency of the PPH applications from the acceptance of the PPH request to the commencement of the examination is reduced to about 1.9 months in 2009. In addition, the average pendency from the commencement of examination to the final decision is usually about 10.5 months for applications filed preferentially in the USPTO to the JPO, while that of applications using the PPH is reduced to about 6.4 months (2009).

The third benefit is cost reduction for acquiring a right. It can be assumed that a reason for refusal already notified at the Office of First Filing has been solved through the examination by the Office of First Filing, so that it is not notified redundantly in the Office of Second Filing. As a result, the number of communications between the examiner and the applicant are reduced, thereby reducing the cost. This enables the applicant to save the costs for acquiring a patent and invest the saved costs in further R&D.

On the other hand, examiners can examine applications using the examination results of other Offices so that it is possible to reduce the work load and to dedicate the examination capacity to other applications.

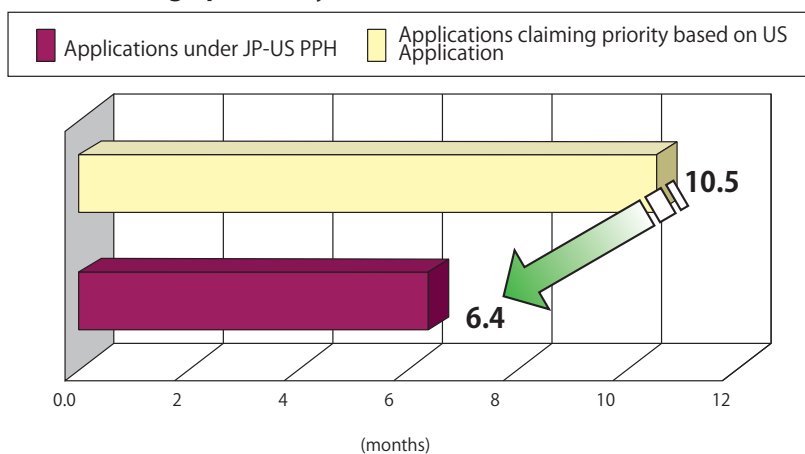
Merit of Use of the PPH (Grant rate) (2009)

Grant Rate at the JPO



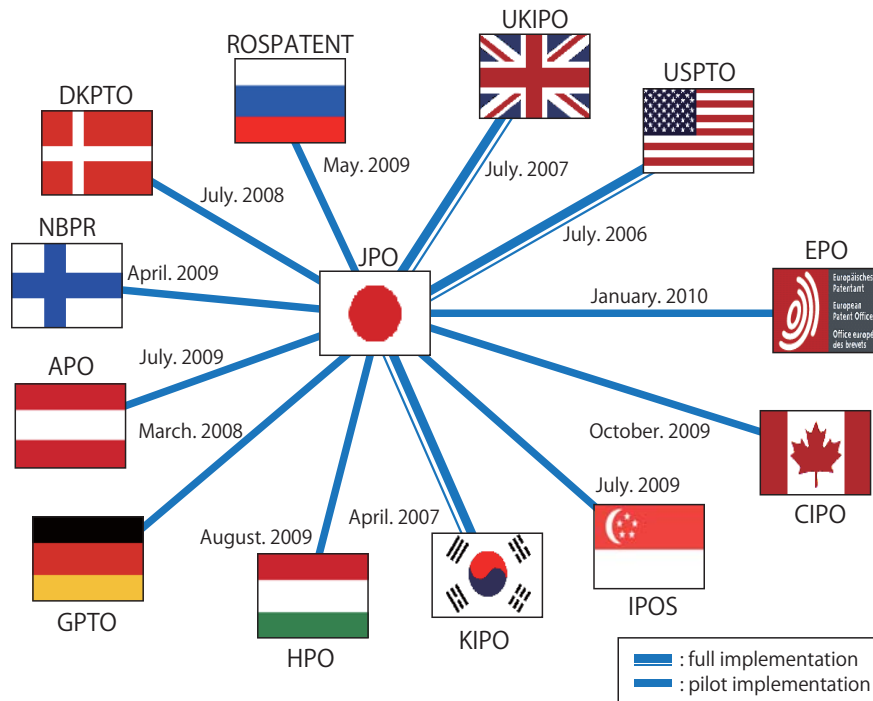
Average Pendency from FA to Final Action(2009)

Average pendency from FA to final action at the JPO



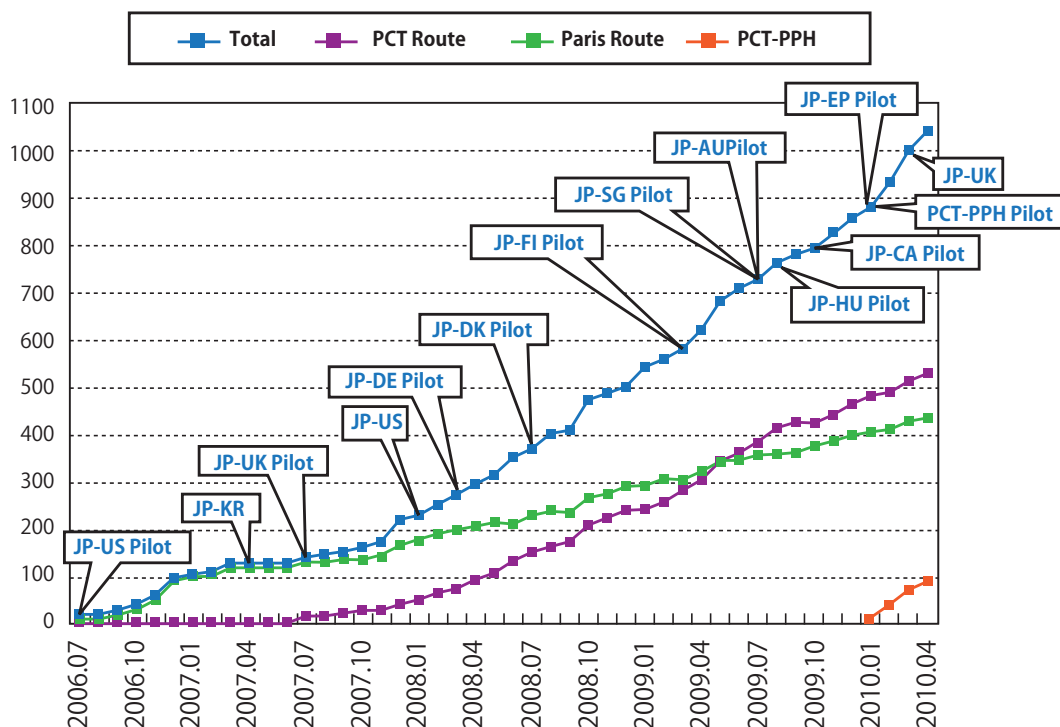
As of the end of April 2010, the full or pilot implementations of the PPH programs between JPO-USPTO, JPO-KIPO, JPO-UKIPO, JPO-GPTO, JPO-DKPTO, JPO-NBPR, JPO-ROSPATENT, JPO-APO, JPO-IPOS, JPO-HPO, JPO-CIPO and JPO-EPO have been conducted.

Network of the PPH between the JPO and other Offices



The number of applications filed using the PPH is steadily increasing. As of the end of March 2010, 2,040 requests to the USPTO and 777 requests to the JPO have been filed in the US-JP PPH, while 371 requests to the KIPO and 93 requests to the JPO have been filed in the KR-JP PPH.

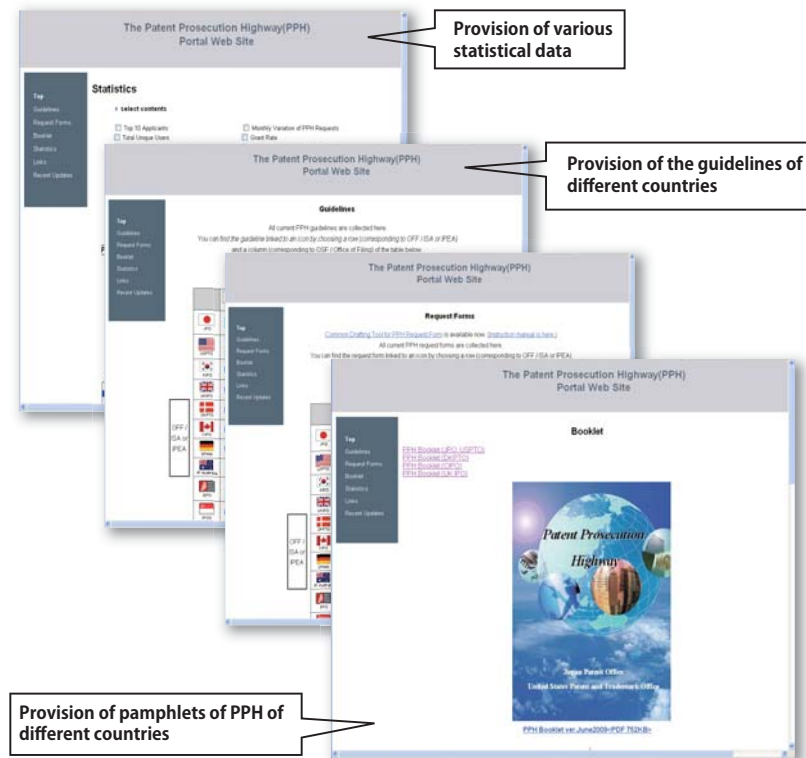
Number of applications for the PPH (at the time of April 2010)



In order for the PPH to be more user-friendly, the first Plurilateral Patent Prosecution Highway Heads of Office Meeting and Plurilateral Patent Prosecution Highway Working-level Meeting were held in February 2009. Based on the results of the first meetings, the second Plurilateral Patent Prosecution Highway Working-level Meeting was held in Tokyo in May 2009. On September 24, 2009, the second Plurilateral Patent Prosecution Highway Heads of Office Meeting was held with the Patent Offices and organizations from 22 countries/regions in order to enforce each matter considered in the second working-level meeting upon the agreement and approval of the Heads of Office of the worldwide Offices.

In second Plurilateral Patent Prosecution Highway Heads of Office Meeting, it was agreed that information on the PPH in each contracting country should be provided in an orderly manner in line with the increase in countries that conclude the PPH, and that a portal site should be established where related information on the PPH can be obtained in an integrated manner as a part of the PPH promulgation activity. The JPO has opened the PPH portal site based on this agreement.

PPH Portal Site

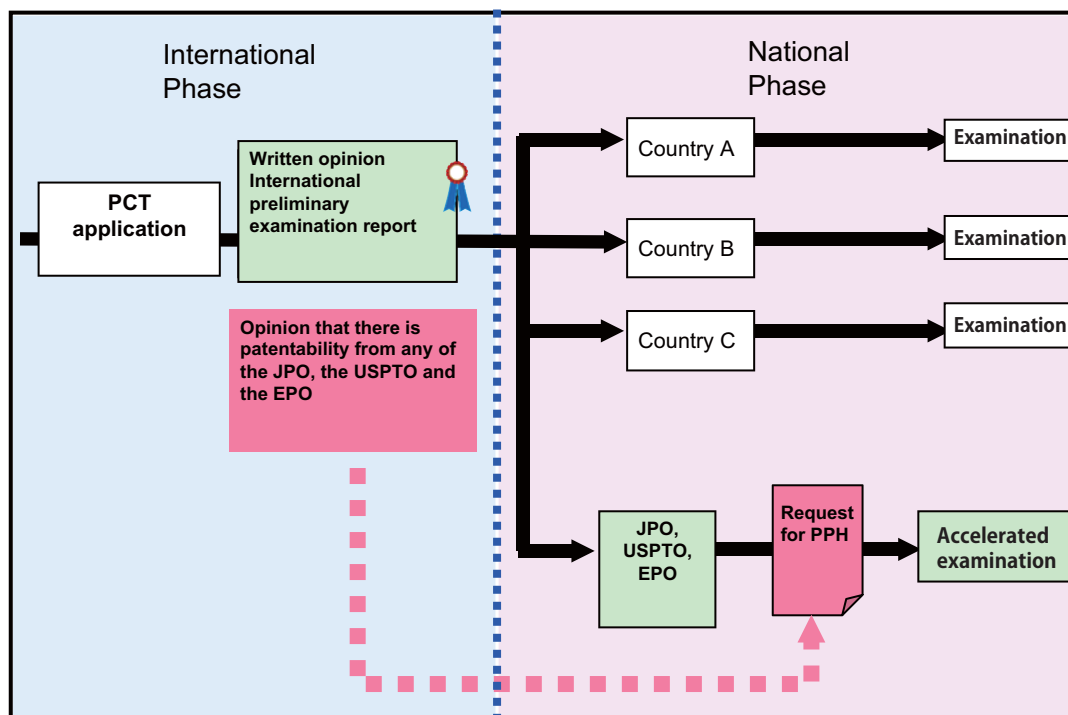


In second Plurilateral Patent Prosecution Highway Heads of Office Meeting, it was agreed that machine translation is in principle permitted for translations of office action of the Office of First Filing. Based on this agreement, the submission of translations of office action of the Office of First Filing can be, in principle, omitted between the JPO and countries/organizations that concluded the PPH agreement if office action is provided through the Dossier Access System¹⁰ (however, the submission of office action of the JPO (Office of First Filing) cannot be omitted for the application for the PPH to the USPTO as of the end of April 2010). On the other hand, many expresses the negative opinion about the permission of machine translation for translating the claims, as translations are a basis for judging the consistency of claims so that the matter was left for further consideration taking into account the future progress of the machine translation technology.

In the Trilateral Heads of Office Meeting held in November 2009, it was agreed that the PPH (PCT-PPH) pilot program that allows accelerated examination of corresponding national applications would start among the three Offices (JPO, USPTO, EPO) in the case where international applications under the Patent Cooperation Treaty (PCT) are judged to have a patentability in the international phase. This program has started since January 29, 2010.

¹⁰ See Part 2, Chapter 3, 3.

Outline of the PCT-PPH Pilot Program



2) JP-FIRST (JP-Fast Information Release Strategy)

As described above, the principle of the patent examination work sharing is that the Office at which the applications was filed (Office of First Filing) releases the results of the search and examination first and the other Offices utilize the results in the examination. However, due to the prolonged examination pendency in the JPO, examination results of first action of applications whose Office of First Filing is the JPO could not be provided before the initiation of examination in the Office of Second Filing so that the utilization at the above level (b), that is, the making use of the search and examination results to the examination judgment could not be achieved.

JP-FIRST has been implemented since April 2008 in order to solve the above problem, taking into consideration the patent system of the JPO such as the examination request system and a framework of PCT for conducting the international search.

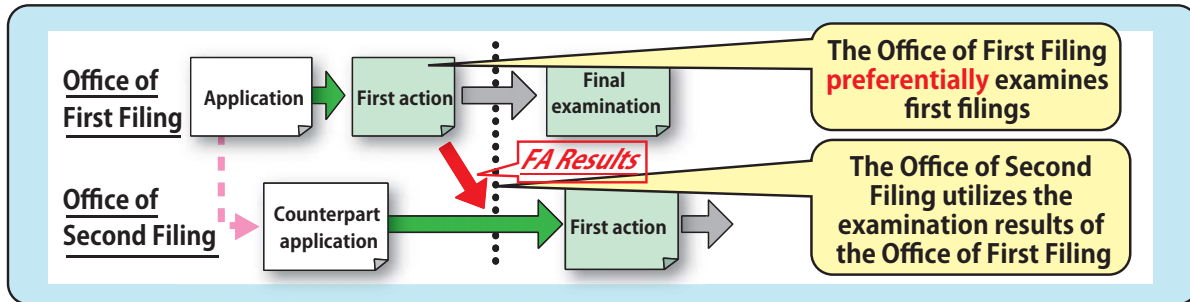
JP-FIRST is a framework in which:

The JPO prioritizes the examination of patent applications for which the examination has been requested within two years from the filing date among the patent applications which are the bases for priority under the Paris Convention (applications which are the bases for the PCT applications are not subject to JP-FIRST).

The JPO conducts the examination in principle within six months from the later date of the examination request date and the publication date, and no later than 30 months after the filing date.

It is expected to support an appropriate patent acquisition of the Japanese applicants in the foreign Offices and to alleviate the whole examination load in various Offices as a whole by providing the results of the first action of the JPO at an early stage to promote the utilization of these results in the foreign Offices.

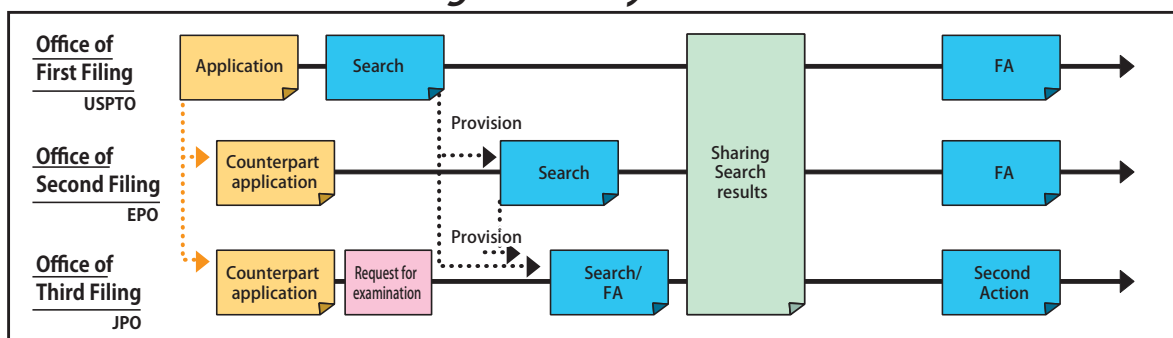
Outline of JP-FIRST



3) Triway

Triway is a system in which the Offices of Second and Third Filing promptly search and examine utilizing the search results of the Office of First Filing. Redundant work among Offices can be eliminated and the applicant can obtain the search results and examination results of three Offices almost at the same time, allowing him or her to respond to each Office (amendments, etc.) taking those results into consideration. The trial of Triway started on July 28, 2008 among the JPO, the EPO and the USPTO and continued for one year. Applications subject to the Triway are those filed with the USPTO as the Office of First Filing and filed or to be filed to the EPO or the JPO through the Paris route, where the claims of each Office are sufficiently corresponding and the applicant wishes to participate in the trial.

~ Image of Triway ~



4) Simultaneous Processing of International Search and National Examination of PCT Applications

The PCT is a framework in which a designated Office can make use of the content of the international search at the national phase for search and examination by conducting the international search at the international phase. Through the discussion on a possibility of fusing the international phase procedures and the national phase procedures at the maximum level in a long term view, the written opinion would be made together with the international search report for the applications filed after January 2004.

The JPO has been conducting the measure in which the PCT international search and the examination of the national application are processed simultaneously in the case where the same invention is filed nationally prior to the PCT application and the national application is being requested for examination. In addition, the JPO is making efforts for enabling the nearly simultaneous processing of the PCT international search and the examination of the national application by encouraging not only the early entry into the national phase but also the request for accelerated examination with respect to PCT international applications filed with the JPO as the receiving Office. Concerning the former measure, the efficiency of the examination in the JPO is enhanced significantly, so that the JPO refunds the international search fee partially to alleviate the burden of applicants' cost for PCT international application.

(2) Efforts for Promoting Work Sharing of Patent Examination

1) International Examiner Exchange Program

In order to promote the work sharing of the patent examination, it is important to build the mutual trust for the search and examination of each Office, to harmonize the quality of examinations at a high level, to enhance the mutual understanding of the search DB/tools for prior arts, and to harmonize the patent classification. In recent years, the number of opportunities for the JPO to utilize the examination results of other Offices and for examiners of other Offices to refer to the examination results of the JPO has been increasing due to the implementation of PPH and the development of the network between the JPO and other Offices. In this regard, the role the international examiner exchange program plays is becoming more important because the program allows examiners to directly interact.

In FY2009, the JPO held the bilateral examiner exchange programs with the EPO (dispatched 8 persons), the GPTO (dispatched 4 persons, accepted 4 persons), the KIPO (dispatched 2 persons, accepted 3 persons), the SIPO (accepted 4 persons) to conduct the researches on the environment of search/examination and examination system. The JPO has also started the bilateral examiner exchange program with the UKIPO, the CIPO and the ROSPATENT (dispatched 2 persons, respectively) that have implemented the PPH with the JPO. In addition, the JPO held the Trilateral Examiner Exchange, where examiners from the Trilateral Offices gathered and discussed the matters concerning patent examination (dispatched 4 persons) and participated in the Five Offices Examiner Workshop (dispatched 3 persons) where examiners from the JPO, the EPO, the USPTO, the SIPO and the KIPO grasped each other's search/examination methods and shared the best practices. Also, the JPO held the harmony visit to consider the patent classification harmonization (dispatched 3 persons, accepted 2 persons).

2) Comparative Study on Examination Practice

Unless the each Office's examination quality including the examination judgment and Examination Guidelines are harmonized, the utilization of the search and examination results of other Offices is limited and the work sharing does not effectively function. Therefore, it is important to compare the examination practice on the inventive step, description requirements and search methods, etc.

The Trilateral Offices (the JPO, the USPTO and the EPO) are conducting comparative studies on such examination practices. In December 2009, the Trilateral Offices conducted the comparative studies and case studies on the legislation and Examination Guidelines for the novelty, following the studies for the description requirements (2007 and 2008) and the inventive step (2008) in order to support the establishment of high-quality application documents. The Trilateral Offices published "The Comparative Study Report on Novelty" as a result of the comparative studies of the Trilateral Offices in the examination practice.

3) Cooperation for Enhancement of Quality of Patent Examination

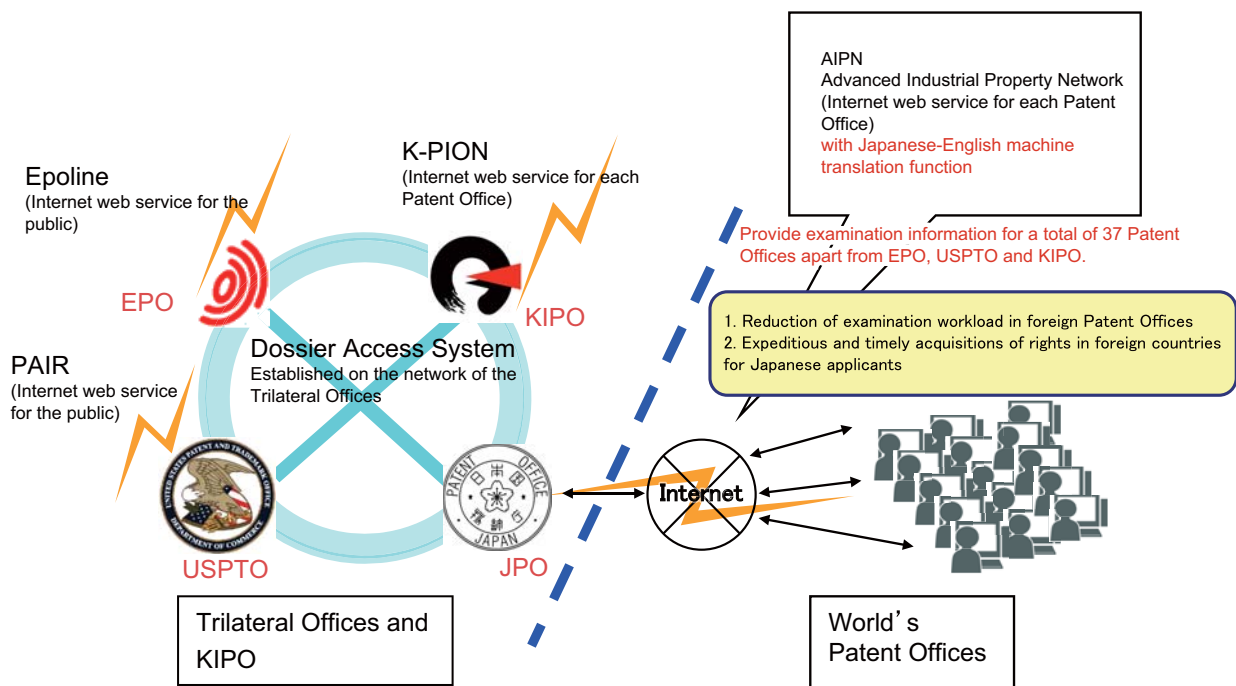
In order to enhance the quality of the patent examination, the Trilateral Offices or the Five IP Offices are discussing on the measures of the quality management of the patent examination and the measures for improving the application quality by the applicant at each Office.

4) Improvement of the Dossier Access System

In order to utilize the results of search and examination of other Offices, the JPO is making efforts for improving the Dossier Access System which enables examiners in each Office to access online to the examination-related information (e.g. documents submitted by applicants and notices of reasons for refusal) of the other Offices.

As of April 2010, the examination-related information of the JPO is provided to 37 foreign Offices via the dedicated network or the Internet, as well as the examiners of the JPO can access online to the examination-related information of the USPTO, the EPO and the KIPO via the dedicated network.

Outline of Dossier Access System



Chapter 3

Efforts Related to Design



1. Clarification of the Details of the Determination in Design Examination

In order to respond to demands from design registration system users to “clarify the contents of the determination in examinations,” the JPO has been striving for clarification of examination contents by conducting a trial practice to describe the additional brief reasons for determination of similarity on a part of the notice of reasons for refusal for applied designs and cited designs (based on Article 9(1) (prior application) of the Design Act from October 2004).

Since FY2007, as another trial practice, the JPO has further expanded the target of notices of reasons for refusal on which reasons for judgment are described and started to notify of reasons for refusal based on Article 3(1) (iii) of the Design Act (novelty) in order to clarify the content of examination by describing the reason for determination of similarity on the notice of reasons for refusal.

2. Provision of Design-related Information

(1) Publication of Design Examination Schedules

The JPO has made available “the Design Examination Schedule” on its website so that the design registration system users can consult it for planning to develop their products.

The Design Examination Schedule provides applicants with a rough indication of date to receive examination results for their applications for design registration, allowing the design registration system users to utilize the information for the purpose of their business activities.

This Table indicates expected examination schedules for applications for design registration filed on a particular date, and is updated every quarter year by adding information on finalized examinations.

(2) Provision of Similar Design Information

In order to provide useful information for the determination of similarity of designs, on March 27, 2006, the “similar design information” service was launched in the Industrial Property Digital Library (IPDL), through which a user can easily search the relationship between a principal design and a similar or related design.

The service allows users to refer cases registered as a similar design or a related design

in the relevant field of the Japanese Design Classification. The service helps users grasp the determination standards, such as what sort of designs are considered similar in examination.

(3) Publication of Publicly Known Design Materials

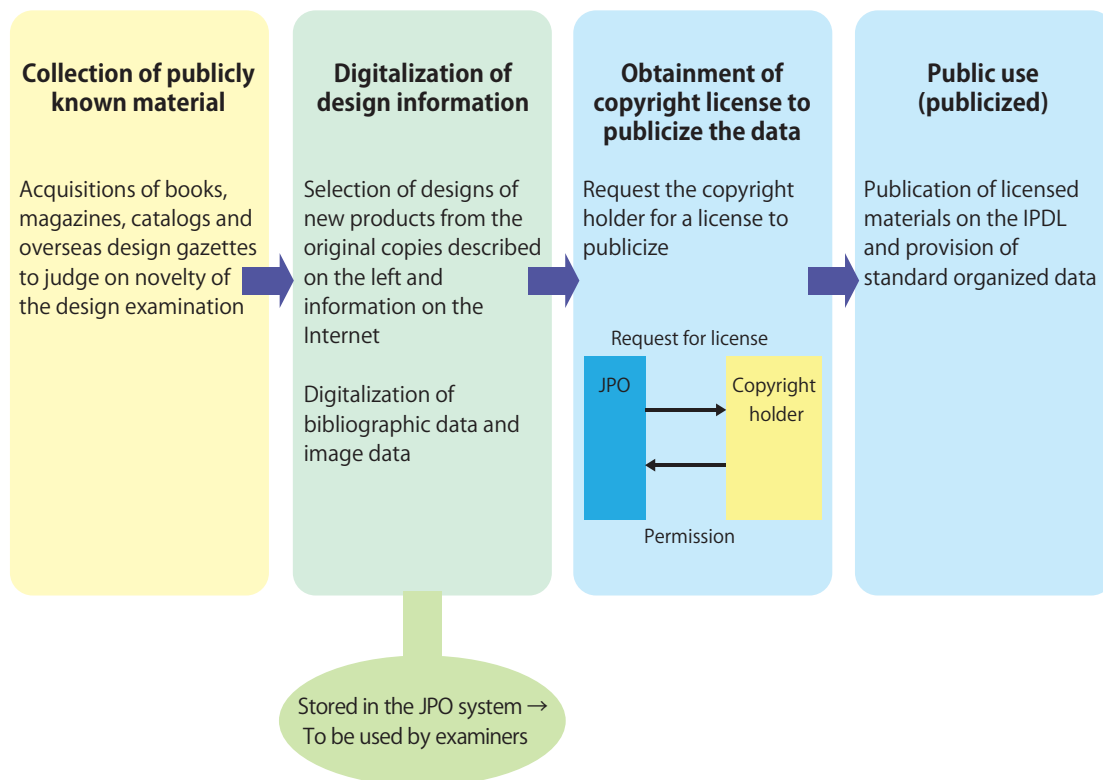
For the purpose of determining novelty and creativity in the design examination, the JPO has collected and selected designs of new products from national and international books, magazines, catalogs and the Internet, and digitalized bibliographic data and photos or figures of those products as major examination materials.

Publication of the publicly known design data allows companies to utilize it for design development as well as for prior design search and design right search, which is expected to promote creation of further creative and value-added designs in Japan.

For that purpose, the JPO started a program to obtain copyright licenses for the publicly known design data to be digitalized by the JPO in April 2007. Once licensed, the publicly known data will be made available through the IPDL, etc.

In March 2006, the “publicly known design inquiry” service was launched in the IPDL to allow users to view, based on publicly known data serial number, bibliographic data and images of publicly known designs. Since October 2009, the “publicly known design material text search” service which allows users to search by name of articles and Japanese design classification has also been offered.

Outline of Collection and Publication of Publicly Known Design Materials



3. Accelerated Examination for Anti-Counterfeiting Measures

The accelerated examination system for designs was introduced on December 15, 1987. Under this system, the accelerated design examination is conducted for 1) an application for design registration with an urgent need to register the design and 2) an application which contains a design that has also been filed overseas.

However, with the increasing importance of design rights as a countermeasure against counterfeiting in recent years, the “accelerated examination system for responding to anti-counterfeiting measures” was introduced in April 2005 in order to further enhance the effectiveness of design right against counterfeiting.

Under this system, if counterfeiting occurs, a first notice of examination results (first action) will be made within one month from the request for accelerated examination, as long as no deficiency has been found in the application.

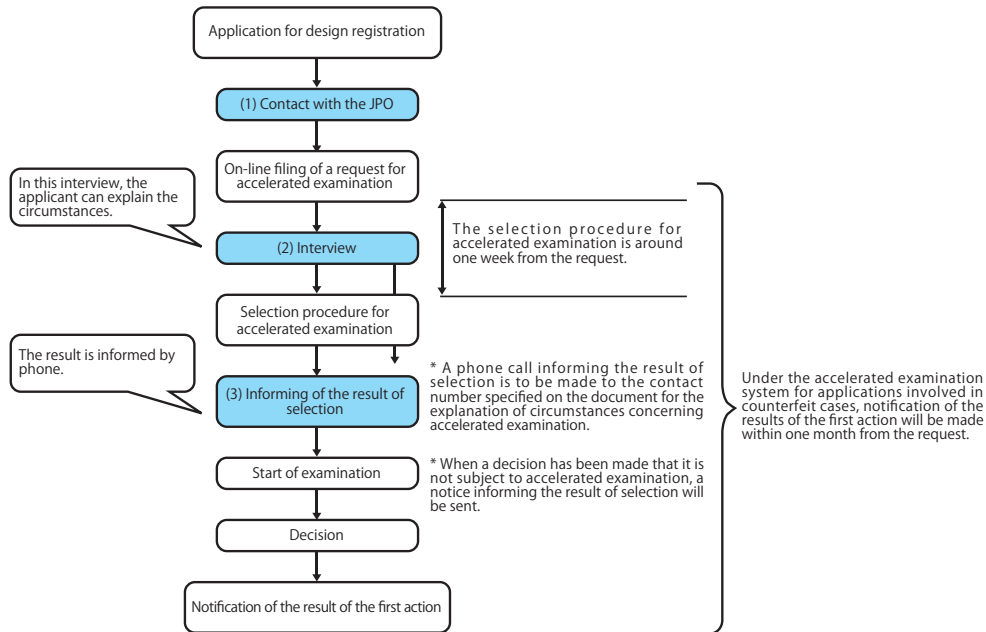
A design application is deemed to be subject to this system “if it is an application for exploited design (exploited by the applicant) with an urgent need for registering the design, and a third party is apparently using or is making preparations to a significant degree to use, without the consent of the applicant or a licensee, a design identical with or similar to the design in the application.”

Thirteen requests were made for the accelerated examination for responding to anti-counterfeiting measures¹¹ in 2009, and the average period from the request for the accelerated examination to the dispatch of the first action was 0.9 months.

Regarding the other accelerated examination, 107 requests were made, and the average period from the request for the accelerated examination to the dispatch of the notice of the first action was 2.0 months.

¹¹ See Part 2, Chapter 3, 3.

Outline of the Accelerated Examination System for Responding to Anti-Counterfeiting Measure



4. Amendments to Examination Standards on Design Applications

The “Intellectual Property Strategic Program 2009” states that “In order to clarify the scope of design rights (the scope of similarity of registered designs and the scope of rights to partial designs) and to build an infrastructure for designers’ creative activities, the GOJ will further clarify the design examination guidelines. Furthermore, the GOJ will discuss measures to promote the disclosure of the JPO’s database on publicly known designs and form a conclusion by the end of FY2009.” (Intellectual Property Strategy Headquarters, “Intellectual Property Strategic Program 2009”). The clarification of the examination standards was required.

One of the roles the design examination standards can play in clarifying the scope of similarity of designs is that the overall judgment process of design examination is described and published. Clear statement of a method of prior design searches and the record of search results (record of references) that directly leads into the judgment on similarity seems to contribute to the clarification of the scope of design similarity.

Therefore, the “Examination Procedures” was established, which clearly describes the overall judgment process of design examination, methods of prior design searches and the record of search results (record of references). As a result, it became clear how examiners make a judgment in each process of the design examination and to what points in the design examination standards to be referred in each process of the procedure by describing in line with the actual examination and clarifying the relevant point in the design examination standards.

In establishing the “Examination Procedures,” discussions were held at the Working Group for the Design Examination Standards under the Design System Sub-committee, Intellectual Property Policy Committee, Industrial Structure Council by its members twice. The resulting “Examination Procedures” were included in the design examination standards as Part 11 thereof.

Chapter 4

Efforts Related to Trademarks

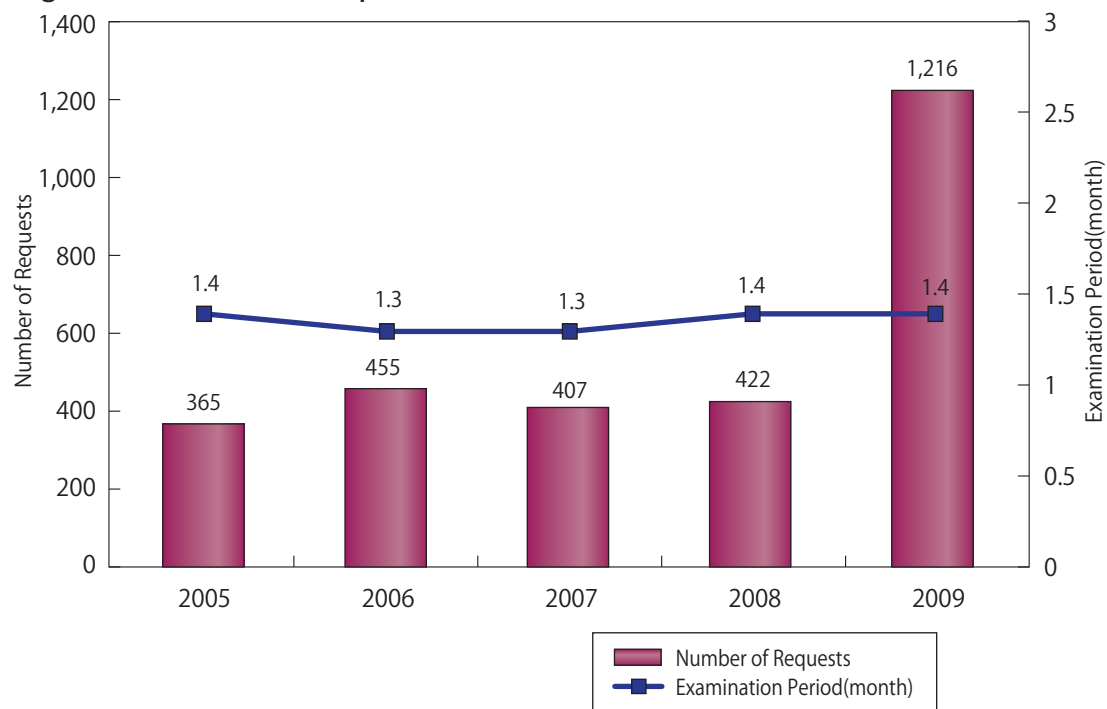


1. Implementation of Accelerated Examination Based on Applicants' Needs

In response to the needs for accelerated examination of applications that are involved in counterfeiting and infringement cases and to the globalization of economic activities, the JPO has implemented an accelerated examination system in September 1997. Under this system, applications which meet the prescribed requirements are examined upon the applicants request prior to regular examination.

The accelerated examination system used to target only the applications an applicant or a licensee uses the filed trademark with regard to the designated good/service or has prepared for its use to a significant degree and there is an urgent need for the registration. The scope of applications subject to accelerated examination was expanded in February 2009 to applications that only designate goods/services the applicant or licensee has already used the filed trademark or has prepared for use to a significant degree in order to expand the further use and respond to the demands for early acquisition of a registration. As a result of the expansion of the scope of accelerated examination, the number of requests in 2009 came to 1,216, increasing by 188% from the previous year. Among them, applications based on the new requirement for scope, account for about 60%. The average period from the request to the date when the notice of the first examination result is dispatched was 1.4 months.

Changes in the Number of Requests for Accelerated Examination and Examination Period



Note: Examination period: Period from the date of request for the accelerated examination until the first action

2. Efforts Related to Regionally-Based Collective Trademarks

(1) Introduction of Regionally-Based Collective Trademark System

In order to provide appropriate protection for regional brands that combine the region name and the goods (service) name as a trademark right, the Trademark Act was partially amended in 2005, and the regionally-based collective trademark system was introduced in April 2006.

This system has been introduced with the aim of stimulating local economies through active use of this system by local trade associations.

This system enables to (i) allow a trademark that combines a region name and a goods (service) name to be registered more quickly and eliminate free riding of the trademark; and (ii) provide an incentive for business operators intending to conduct regional branding activities to register their trademarks, and lead to invigorating the region. Further, (iii) by utilizing effectively the registered regionally-based collective trademark and by managing the brand thoroughly etc., it is expected that a regional brand in a developing stage gains national eminence.

(2) Status of Applications and Registrations for Regionally-Based Collective Trademark

1) Status of Applications

Having started accepting applications for regionally-based collective trademarks on April 1, 2006, the JPO has accepted 933 applications as of the end of March 2010. Looking at the number of applications by field, agricultural products were dominant, followed by industrial products, processed food (including confectioneries and noodles), and others include liquors and hot springs.

By region, 40 from Hokkaido, 75 from Tohoku, 88 from Kanto, 63 from Koshinetsu, 69 from Hokuriku, 116 from Tokai, 256 from Kinki, 57 from Chugoku, 31 from Shikoku, 96 from Kyushu, 38 from Okinawa and 4 from overseas.

2) Status of Registrations

The JPO dispatched notices of its decision to grant registration with respect to 449 applications by the end of March 2010.

(3) Publicity Activities for the Regionally-Based Collective Trademark System

As an effort to publicize the regionally-based collective trademark system, since FY2005, the JPO held explanatory seminars nationwide to outline the system and examination practices. Besides them, with the aim of publicizing and promoting the use of the system, it also distributed an easy-to-understand pamphlet on filing procedures and registration requirements for regionally-based collective trademarks.

In addition, in order to promote the further spread of the regionally-based collective trademark system, the JPO published in June, 2009, a booklet entitled, "Regionally-based collective trademark 2009" introducing the contents of 425 products or services for which the trademarks has been registered until the end of FY2008.

(4) Brand Strategy of the Regionally-Based Collective Trademark

Even if the right of the regionally-based collective trademark is acquired, there are some cases where the right is not effectively utilized. Although there are various reasons for that, the major reason is that the regionally-based collective trademark was filed without having sufficient discussions on the regional brand strategy in many cases.

In filing a regionally-based collective trademark, it is desirable that not only parties concerned of the association but also various organizations and associations which involve in the stimulation of the local economy deliberate on filing of the regionally-based collective trademark as a part of the regional brand strategy.

It is necessary to reconfirm the concept of the regional brand strategy among various regional parties concerned and continue discussions even after the registration of the regionally-based collective trademark.

In addition, in order to nurture the regional brand with the aim of stimulating the local economy, it is important to acquire trust and reliability of the regionally-based collective trademark as a “brand” and maintain them. Thus, management of the regionally-based collective trademark and management of the quality of products and services are essential. It is desirable to construct a structure that the regionally-based collective trademarks and the regional brands are managed in an integrated way. Assignment of personnel in charge and management by organizations such as committees and councils are thought to be useful.

As a specific management method, formulation of the management standards on the use of regionally-based collective trademarks or the quality standards of goods (services), and thorough compliance with them is recommended. Creation and distribution of seals, stickers and posters indicating the registration of the “regionally-based collective trademark,” are also thought to be effective.

3. Handling of Applications for Trademark Registration comprising/including a Name of a Historical Figure (Name of famous/well-known person who are deceased)

(1)Background

1) Provisions on Examination of Names of Historical Figures

When a name of a historical figure was applied for trademark, the examination has been conducted with care taking into account his fame regardless of the fact that in the Trademark Act, there is no express provision for prohibiting the registration of a trademark comprising/including the name of a historical figure other than the names of the living. For example, Article 4 (1) (8) of the Trademark Act is a requirement for the trademark registration of names of persons, but it is for protecting the personal right and limited to the purpose of protecting the living.

2) Various Conditions Concerning Names of Historical Figures

Because names of well-known/famous historical figures have a strong attraction of customers derived from his fame, quite a few people wish to use it as a trademark.

In particular, in a home town or a place where a person has a strong tie, the person is treated with respect and affection as a hero by its residents, for example, a memorial hall is operated to commemorate his achievements and his name is used as a trademark to promote the regional economy and tourism as a symbol of the region.

However, it has been pointed out that trademark registration by a third party that has no relationship with the historical person may have an adverse effect on the regional industries in the hometown.

3) Trends of Recent Judgments and Trial Decisions

In recent years, with regard to the application of the provision of the violation against public order and morality (Article 4 (1)(7) of the Trademark Act), trademarks filed with the intention of taking advantage of a famous person, knowing his reputation was judged to go against public order and morality, and if trademark registrations are judged to be used to obtain illegal profits abusing the fame of other organizations, it was judged to disturb the order of business dealings and go against the said provision even if the trademark itself does not violate public order and morality.

(2) Deliberations on Future Course of Trademark Examination of Names of Historical Figures

Under such circumstance, the Trademark System Sub-Committee, Intellectual Property Policy Committee, Industrial Structure Council deliberated on “the future course of trademark examination of names of historical figures” at its nineteenth session (June 10, 2008). After conducting the public comment by the JPO, the Sub-Committee deliberated it again at its twentieth session (October 5, 2009). As a result, the JPO revised the trademark examination manual to add “42.107.04 Handling of Applications for Trademark Registration of Names of Historical Figures (Names of famous/well-known persons who deceased)” on October 21, 2009. This revision was made for the purpose of establishing the principle of examination of applications for trademark registration which includes a name of a historical figure, improving the predictability for applicants, and controlling inappropriate applications. The outline of the added manual is shown in (3), below.

(3) Outline of the Added Trademark Examination Guideline

Manual Serial Number 42.107.04

Handling of Applications for Trademark Registration of Names of Historical Figures (Names of famous/well-known persons who are deceased) (Extract)

1. In the examination of an application for trademark registration comprising/including a name of a historical figure, a special care should be taken if the use and registration of the trademark go against public and social interests or general social moral, it may fall under the Article 4(1)(7) of the Trademark Act, even if the constitution of the trademark does not go against the public and social interests. In that case, the application is judged to whether or not fall under the said Article taking into account the following points comprehensively.

- (1) The degree of recognition and fame on the relevant historical figure
- (2) The degree of recognition of the nation or local residents on the name of the relevant historical figure
- (3) Status of use of the name of the relevant historical figure
- (4) Relationship between status of use of the name of the relevant historical figure and designated goods/services
- (5) Background, purposes and reasons for application
- (6) Relationship between the relevant historical figure and the applicant

2. In the examination in line with the said 1., if the application is recognized to be “an application for trademark registration filed with the intention of monopolizing the profits, knowing that the application results in free ride of public measures using a name of a historical figure, inhibition of their implementation, and loss of public interests,” it shall be judged to fall under the Article 4(1)(7) of the Trademark Act, because it inhibits a fair competition order and goes against social and public interests.

Chapter 5

Efforts Related to Appeals and Trials



1. Efforts to Improve the Quality of Proceedings

Since precise examination is required in appeals and trials, the JPO makes efforts to further improve the quality of proceedings by reviewing the judgments in lawsuits against Appeals Department's decisions and those related to the validity of rights in infringement lawsuits, and by giving consideration in invalidation trials to the evidentiary materials alleging nullity of rights submitted in infringement lawsuits, which are acquired by exchanging information with the party concerned and courts.

The JPO also ensures better communication with the appellants through active use of interviews, and conducts oral proceedings in principle in order to raise credibility of the party concerned in a invalidation trial, sort out the issues in an expeditious way, and conduct accurate proceedings. Further, in the appeal against an examiner's decision of refusal, the so-called "examiner's reconsideration report before appeal proceeding" has been dispatched since FY2005 as a measure for inviting the appellant to give his/her opinion on the report formulated by the original instance examiner.¹² As a measure for ensuring smooth communications between the appellant and the appeals examiner and for contributing to the improvement of the quality of the proceedings, all reconsideration reports have been to be dispatched in principle since FY2008.

In addition, with the aim of clarifying the judgment standards with regard to the inventive step and the description requirements of an invention, the JPO, collaborating with industries and patent practitioners, held the "Patentability Meeting" to conduct case studies, and summarized and published the results thereof.

In addition to those efforts mentioned, since the end of FY2007, the JPO has recruited experienced former judges as "legal advisors of Appeals Department", who advises on complicated judicial issues and serves as an instructor for the training etc. In addition, the "legal advisors meeting of Appeals Department" is held to suggest the future role of the appeal and trial system and its operation, so that the operation in Appeals Department will be more appropriated.

¹² An examiner who made a decision of refusal subject to request for the appeal against examiner's decision of refusal.

2. Efforts for Expeditious Proceedings

The JPO preferentially examines post-grant trials, such as trials for invalidation, to other trials, as there is a social demand to ensure the effectiveness of the protection by quickly settling disputes over the validity of industrial property rights. In 2009, the average period for the proceeding of invalidation trial was about 9 months for patents, about 8 months for designs, and about 11 months for trademarks.

For the purpose of further reduction of the average proceeding period and improvement of Invalidation trials, “the proceeding improvement committee” consisting of patent users has been held since 2009. The JPO has implemented efforts for expeditious trials for invalidation taking into account advices given by the members.

In the case of appeals against an examiner's decision of refusal, it is beneficial for the applicant or the third party that the consequences of the appeals could be promptly provided. In order to respond to the increasing number of examinations, the JPO is, in particular, aiming to achieve efficient appeal proceeding by implementing an “appeal proceeding in a batch” of related cases of the same appellant and by utilizing the assistant for the appeal examiner's work with a central focus on appeals against an examiner's decision of refusal. In addition, by confirming the appellant's intention of maintaining the appeal proceeding through the “questioning with dispatch of examiner's reconsideration report” mentioned in above 1, the JPO, aiming at the efficient processing of appeal, urges appellant's to withdraw the appeal which are no longer necessary.

With regard to appeals against an examiner's decision of refusal that satisfy specific requirements,¹³ the JPO implements an accelerated proceeding system in which it conducts the proceeding preferentially upon request. In 2009, 307 requests were made for patent, 3 requests for design and 10 requests for trademark. Among them, for all requests for patent, the dispatch of appeal decision within 10 months which was set as one of the JPO's official targets in FY2009, has been achieved as of the end of FY 2009.

3. Efforts to Reform the Structure of Appeals in the Patent System

Following the increase in the number of the patent applications to be examined, it is concerned that the pendency period becomes long-term. Under such a situation, if an invention essentially patentable is not granted in the examination phase and is transferred to the appeals, it not only is a demerit for the applicant, but also leads to the disadvantage for the whole users, including other applicants and the third party, who have the burden of watching more patent applications related to the own business.

¹³ Appeals against an examiner's decision of refusal for patents that satisfy any of the following requirements are subject to this system: 1) License related applications whose appellant has already worked the invention, 2) Foreign applications filed also in a foreign Patent Office, 3) The appellant is either SME, individual, university, TLO or public research institution, 4) A person who is not the appellant (third party) has worked the invention as a business after laying open of the patent application of the proceeding case, 5) Patent applications for green invention (inventions which have an effect such as energy saving and CO₂ reduction). Appeals against an examiner's decision of refusal which satisfy the same requirements for accelerated examination are subject to this system for designs and trademarks.

Therefore, the Appeals Department aims at decreasing the number of appeals against an examiner's decision of refusal through the following measures by increasing the grant rate by the end of the examiner's reconsideration before appeal proceedings to promote an expeditious and accurate proceeding.

(1) Proceedings Having High Foreseeability

In order to enable to make a sharp distinction between requesting or not requesting the appeal examination, it is important to enhance the credibility and the foreseeability of the result of the appeal examination. The Appeals Department will aim to conduct stricter and high-quality appeal examination based on court rulings relating to patentability, such as the level of inventive step required, in lawsuits against the JPO Appeals Department's decisions.

(2) Unifying Judgment Standards of Examination and Appeal Examination

After making strict and improving the appeal examination as described above, the unification of the judgment standards of the examination and appeal examination will be promoted through an appropriate feed back on the results of the appeal examination in the Appeals Department to the Examination Department. This makes it possible that an application for which the decision of refusal cannot be maintained in the appeal examination will be patented by the end of the examiner's reconsideration before appeal proceeding, so that the invention having patentability will be promptly granted and the number of cases transferred into the Appeals Department will decrease.

(3) Strict Appeal Procedures

In order to establish practices that would fix the grant or refusal as much as possible at the examination phase, adequate counterarguments and amendments by the applicant are necessary to be made before the appeal at the latest.

Thus, based on the efforts shown in the above (1) and (2), in the case where an applicant has not made adequate counterarguments and amendments at the phase before the appeal, the Appeals Department imposes strict rules on the appeal examination, such as imposing restrictions on the applicant's opportunity to make amendments at the appeal phase, and aims to achieve fair appeal examinations. Such practices would promote the accelerated granting of rights for essentially patentable inventions, which is expected to reduce both the burden and costs to the applicants and the JPO.

(4) Publicity of Appeal Examination Policy of the Appeals Department

The JPO aims to publicize the appeal examination policies of the above (1) to (3) of the Appeals Department in FY2009 to users such as applicants using opportunities such as interviews, consultation with private businesses and public guidance for practitioners.

(5) Publicity of “Patentability Report”

Since FY2006, the JPO has held the “Inventive-Step Meeting” consisting of patent practitioners such as staff of the intellectual property department in companies, patent attorneys and appeal examiners to consider and clarify the standard of court rulings and appeal decision focusing on the novelty and the inventive step by analyzing individual case. The discussion results are prepared as a report and publicized on the JPO website. Since FY2008, the description requirements have become subject to consideration, and it was changed to the “Patentability Meeting.”

In FY2009, the completion of inventions relating to computer software have become subject to consideration.

By the efforts of above (1) to (5), 1) the granting rate at the phase of the examiner's reconsideration before appeal proceeding has increased gradually (while in 2005, it was 44%, in 2009, it was 50%¹⁴). In addition, 2) the appeal denial rate¹⁵ tends to increase (while in 2000, it was 31%, in 2009, it was 52%), and 3) the rate of maintaining the appeal decision in the lawsuit against appeal decision was 67% in 2009.

4. Improvement of Customer Service

The JPO has been making efforts to improve customer service of the Appeals Department in order to respond promptly and accurately to various inquiries and opinions on appeals and trials from users and to grasp the external needs. In FY2010, the JPO will continue to reflect opinions from users on the operation and measures of the Appeals Department appropriately with the aim of providing high-quality services responding to the users' needs in line with the “Vision for the Future Course of the Japan Patent Office.”¹⁶

¹⁴ Excluding the part where the reconsideration by examiner before appeal has not been completed.

¹⁵ See Part 1, Chapter 1, 5. (1) 2).

¹⁶ A vision of the JPO formulated as an action guideline with regard to a desirable organization based on the organization mission, “leads the international discussions and contributes to the structure of the global intellectual property system in order to respond to the environmental change in the intellectual property right and provides high-quality services responding to the users' needs.”

Chapter 6

Efforts for the Enhanced Use of Information Technology



1. Efforts for the enhanced use of IT by the JPO

(1) Development of the JPO's System

The JPO, ahead of other countries, formulated the "Paperless Project" in 1984 that aims at comprehensive computerization of the overall patent administration and creation of database and has introduced systems that utilize information technology in various functions such as the introduction of the world's first electronic filing System in 1990.¹⁷

The JPO's system has been continuously improved in order to realize efficient and improved examination processing in response to a large number of applications remained at a high level in the world because of the thriving technological development and economic activities in Japan, which advocates the nation-building on the basis of science and technology, enhanced and complicated technological contents, increase in the examination/processing load due to the restriction on recruitments in line with the increase in examination materials and the administrative and financial reforms. Today, the system plays a vital role in establishing the position as a leading country of e-government and supporting the patent administration as a platform.

1) Electronic filing System

After the JPO introduced the electronic filing System for the procedures of patents and utility models (using the dedicated terminal) in December 1990, it approved electronic filing through personal computers in April 1998, and started to accept electronic applications for designs, trademarks, appeal procedures and procedures in the national phase of PCT applications in January 2000, and PCT international applications in April 2004. The Japanese government expressed its aim to realize the online usage rate over 50% in the overall procedures subject to promotion of use in the "IT New Reform Strategy" (January 2006) and the "Action Plan for Online Usage Expansion" (September 2008). The electronic filing rate has been high, for example in 2009, it was 97% for patents/utility models, 92% for designs, 81% for trademarks, 99% for appeals, 99% for PCT in the national phase, and 90% for PCT applications.

¹⁷ The KIPO introduced the electronic filing System in 1999 and the EPO and the USPTO introduced it in 2000.

In addition, in October 2005, the JPO has started to accept electronic applications 24 hours a day, 365 days a year, and started the internet filing for patents/utility models, designs, trademarks, appeals, PCT applications in the national phase as well as the conventional electronic filing via the ISDN line. The JPO started accepting electronic filing for PCT applications via the Internet in January 2007. In the Internet filing system, the certification by the electronic certification system based on the commercial registration (for corporations) and the certification by electronic certificate of the Public Certification Service for Individuals / some public certificate offices (for personal users) have been used. In January 2010, a government office certificate of the government public key infrastructure (GPKI) and a business certificate of the local government public key infrastructure (LGPKI) became available so that government offices and local government are able to file an application.

Moreover, in April 2010, the electronic filing via the ISDN line was abolished and the electronic filing was integrated to the Internet filing for the purpose of solving overlapped investments in the maintenance of the two different electronic filing Systems and realizing services using large-capacity and high-speed communications in the trend that the number of ISDN subscribers is decreasing due to the expansion of the Internet.

2) Administrative System

The administrative system is roughly divided into the “administrative processing system” for electronic administrative procedures of file wrapper from the applications to the publication of applications and the “peripheral examination assistance system” for substantive examinations.

The administrative processing system for patent wrapper started to operate in 1990, same as the said electronic filing System. This system consists of the filing system that receives application data/receipts online, the formality check system that conducts automatic formality checks and manual formality checks, the electronic management system for file wrapper that stores and manages the application data, the management system of assignment of classification that assigns a classification for publication of applications and checks improper summaries, etc. This system has been improved as necessary, such as the change from main frame to server and the realization of flow-system operations.

The peripheral examination assistance system is to support examiner’s duties such as management of cases subject to examination, draft, approval and support for examination. This system started to operate in July 1993 for patents/utility models and in January 2001 for designs and trademarks. At the beginning, the peripheral examination assistance system was operated by the dedicated work station. However, the system became possible to operate on OA personal computers to improve the efficiency in July 2007, and the search system mentioned below became possible to operate on OA personal computers in March 2005 to achieve an all-in-one system. The system is strengthened by collaborating with the peripheral examination assistance system and the search system.

3) Search System

In conducting duties related to examination for patents, trademarks and designs at the JPO, search duties of prior arts and gazettes are necessary. The F-term search system is used for patents, which allows search by search key such as F-term, FI and free word assigned to examination materials such as gazettes according to a technical characteristic, a name of the applicant, a name of the inventor, a title of the invention and full text. In March 2010, the search function by the IPC 8th edition and the search function of patent gazettes of the KIPO and the SIPO were realized. Moreover, for the examination of designs, the design search system that searches by D term that segmentalizes the design classification by plural points of view, for the examination of trademarks, the phonetic search system, the character string search, the figure trademark examination system that searches by classification (figure term, Vienna classification(since April 2004)) and similar group code, and construction of the well-known / famous trademarks database and the search system have been used. In the Appeal/Trial duties, the search system of the decision cases has been used for duties, which searches by J terms and texts assigned to computerized gazettes of trial decisions and judgments.

(2) Construction of the JPO new comprehensive information system

1) Background

As mentioned in the section above, the JPO has actively promoted the computerization, and realized efficient processing, and prompt and accurate examination/proceedings. On the other hand, as an effort to realize simple and efficient administrative management, the government summarized the “e-Government Building Program (decided at the Chief Information Officer (CIO) Council in July 2003, and partially revised in June 2004). Based on the plan, the JPO formulated the “Plan for Optimization of JPO Operations and Systems” (hereinafter referred to as “the Optimization Plan”) in October 2004 with the aim of optimizing its operations and the whole system. Then, the JPO has considered further clarification of the content of the plan and details of its schedule, and revised it in August 2005, and started the system’s designing process from December 2006. The plan was further revised in October 2008 in order to respond to an environmental change surrounding the system and an environmental change of intellectual property such as the globalization of intellectual property and the diversification of users’ needs. The revised plan calls the whole new system consisting of “the JPO administrative information system and “the JPO new search system” as “the JPO new comprehensive information system,” as a basic system to support the JPO’s duties related to examination and appeals/trials operations and administration. It was also revised in October 2009 based on a subsequent progress.

2) JPO new administrative information system

The JPO new administrative information system aims at 1) response to the globalization of intellectual property (response to the international examination work sharing and international

harmonization of systems, information provision for overseas, etc.), 2) response to diversified needs of users (construction of a flexible examination system according to various needs of users, formation of transparent and visual examination process, formation of system of notices, etc.) 3) realization of improved work efficiency (continuous improvement of the work process, response to items in the system revision made after the publication of the optimization plan), 4) improvement of convenience of users (interactive application function, real-time provision of data owned by the JPO).

In order to realize these purposes continuously, the JPO aims at a system that is able to respond to the demands of the present age by reviewing the conventional system structure gradually developed by work such as the acceptance of applications and substantive examination and to integrate databases.

3) JPO new search system

The JPO new search system aims at 1) construction of the state-of-the-art IT environment for the world-class expeditious and accurate examination (improved access to overseas patent documents of non-English-speaking countries (including China and Korea), introduction of new technologies such as conceptual search and machine translation, construction of an advanced examination environment where the accumulated examination knowledge is used in the JPO), 2) construction of an patent information use environment that contributes to R&D and management strategies of corporations and universities (provision of the search function same level for examiners, construction of an environment where literature information and patent information can be accessed seamlessly), 3) the more economical and streamlined search system and reduction in the operations costs in response to the explosive increase of information (integrated intra-office data, standardization of the system structure), 4) measures for safety and reliability.

2. Efforts for the Global Computerization

(1) Response to International Standardization

It is necessary for formats of electronic data in the JPO's systems to fully respond to the international standardization from a viewpoint of an efficient and unified use and distribution of information in electronic data exchange with other countries and the search system for information provision service of various industrial property rights. The international standard in the industrial property field is standardized by the World Intellectual Property Organization (WIPO) taking into account the trends of major countries (see "Outline of WIPO standards"). Moreover, the standard set as Annex F of the PCT Administrative Instructions for computerization of PCT international applications has been used not only for PCT electronic filing but also national electronic filing in the JPO and the EPO, etc. as a standard for electronic patent applications.

Outline of WIPO standards

category	Explanation	Number of standard	examples
Group (a)	Standards of a general Nature, common to Information and Documentation	3	ST.3: Two-letter codes for the representation of states, other entities and organizations
Group (b)	Standards relating to Patent Information and Documentation	40	ST.9: Bibliographic data on and relating to patents and SPCs ST.36: Processing of patent information using XML
Group (c)	Standards relating to Trademark Information and Documentation	6	ST.60: Bibliographic data relating to marks ST.66: Processing of trademark information using XML
Group (d)	Standards relating to Industrial Design Information and Documentation	3	ST.80: Bibliographic data relating to industrial designs ST.86: Processing of industrial design information using XML

Source: WIPO PCT Treaty, Regulations and Administrative Instructions

1) International Standardization of Electronic filing Format for Patents and Utility Models

The JPO's electronic filing format for patents and utility models has been specific format (X format) based on the international standards in the communication field since the commencement of its operation in 1990. However, the format in Japan was changed to be in conformity with XML, and the JPO started to accept XML applications as of July 2003, because XML was adopted by the document format for PCT electronic filing, an international standard for online patent procedures.

In addition, the format for publication of unexamined patent applications, published Japanese translations of PCT international publication for patent applications, domestic re-publication of PCT international publication for patent applications and publication of registered utility model applications was changed to XML format in January 2004 and for patent gazettes in July 2004. The provision format was also changed from CD-ROM to DVD-ROM. In December 2004, the Trilateral Offices and the WIPO played a central role in formulating the WIPO Standard ST.36, a recommended technical standard for online patent application documents in XML format for all countries and published it.

The Trilateral Offices started to deliberate on a format which allows applicants to file patent applications to the three Offices in 2005, and agreed on the common application format (CAF) in November 2007. In 2008, the Trilateral Office suggested a revision of the XML definition of descriptions provided in Annex F of the PCT Administrative Instructions based on the common application format and also suggested a revision of the WIPO Standard ST.36. Both of the suggestions were agreed. Through those preparations, the JPO has started to accept

electronic filing using the common application format since January 2009, ahead of other countries.

Moreover, the JPO has made efforts for spreading the XML format at an international level by modifying an XML creation software provided for national applications and PCT applications in Japan to operate in an English environment and providing the general public with the software free of cost since April 2009.

2) Standards for Data Exchange through the Trilateral Network

The Trilateral network opened in October 1998 has been for online exchange of priority documents among the Trilateral Offices and reference to the examination information (Dossier information) of other Offices, etc. In the beginning, the frame relay network was used as a communication line, but a system which defines various services in XML for use was adopted in 2003 when the network was changed to the Internet. In November 2005, the Trilateral Offices agreed to use a format called Trilateral Document Access as a format which allows refer to the examination information of other Offices. The importance of TDA has been elevated as a standard for data exchange among the Trilateral Offices by revising to conform to priority document exchange and to the WIPO Digital Access Service (DAS) in March 2008.¹⁸

(2) Promotion of International Cooperation Utilizing IT

1) Priority Document Exchange

The JPO progresses an online mutual exchange project of priority documents among Offices in cooperation with Patent Offices in other countries. Under this project, the Office of First Filing, instead of the applicant, sends priority documents directly to Offices of other countries. This system alleviates significantly the burden and costs related to submission procedures of the applicant as well as the burden related to issuance procedures of priority documents to the applicant by each Office. This effort started between the JPO and the EPO in January 1999, between the JPO and the KIPO in July 2001 and between the JPO and the USPTO in July 2007. Moreover, it became possible to accept not only data of priority documents digitized in a country where documents were issued (first country) but also data of priority documents digitized in another country (second country) or the WIPO in 2008.

Furthermore, in addition to the efforts of the Trilateral Offices and the KIPO, the establishment of DAS was approved at the WIPO General Assembly in 2006 and online exchange of priority documents using DAS started in 2009. In response, the JPO established an environment to use this service in April 2009 before other countries. In addition, the number of participating countries in this system has increased and started in the United States in April 2009, in Korea in July 2009, in the United Kingdom and Spain in October 2009, and in Australia in December 2009, and further expansion is expected in the future.

¹⁸ A framework to exchange priority documents online worldwide through the WIPO International Bureau

2) Foreign File Wrapper Reference

In order to respond to the globalization of intellectual property activities, examination cooperation such as mutual use of examination results or prior art search results is required. Under such circumstance, the JPO has made efforts for establishing a system to refer to examination related information owned by the worldwide Offices in order to establish an environment where examiners are able to refer to search/examination results and information on history of Offices in other countries spontaneity using IT. Based on the suggestion made by JPO in 2005, the Trilateral Offices constructed the system (Dossier Access System) to mutually provide examiners of each Office with examination related information of each office through the Trilateral Network in 2006.

In 2007, mutual reference of examination related information has started using this system with the KIPO. If such examination related information is in Japanese, it will be translated into English by machine translation and provided to each Office. Although only three years have passed since the commencement of system operation, for example, the examiners of the JPO spontaneity accessed to other offices the total of 190,000 times a year, in order to use examination results. The establishment of infrastructure for examination cooperation secures the efficiency, improves the quality of examination, and improves the predictability of obtaining a right in each country.

The JPO translates information on search/examination results in Japan into English by machine translation and provide 37 Patent Offices with the information (as of March 2010) through the "Advanced Industrial Property Network (AIPN)" using the Internet. When the PPH is used, referring to the examination history of applications filed in the JPO in the examination at a foreign Patent Office encourages the improvement of the examination efficiency in the relevant country and the examination quality. It is also expected to contribute to appropriate obtainment of a right of Japanese applicants and smooth economic activities.

In addition, JPO leads discussions on the realization of "One Portal Dossier" that collectively displays the examination information of related applications at each Office using the international standard format (XML) in the IP five Office foundation project formulated in the IP5 Heads Meeting held in October 2008, with setting "common access to search and examination results" as one of the foundation projects.

3) Advanced Search Environment

In the examination for patents, etc., "absolute novelty" is adopted as a standard for judging the novelty in almost all major countries. Therefore, it is necessary to investigate document not only of own country but also of all around the world. To achieve this, it is necessary to aim at an advanced prior art search environment that contributes to international work sharing by promoting examination cooperation and collaborating document databases and search tools owned by worldwide Offices.

In order to solve this issue, in addition to the efforts made by the Trilateral Offices, discussions have been held with regard to "common search and examination support tool"

(a project in which examiners of each Office establish a common examination/search tool environment where the similar search result is realized for the same case) and “common document database” (a project to define common data set for prior search by making mutual access to databases owned by each Office smooth by mutually setting the document scope to be searched by each Office) in the said five Office foundation project.

4) Efforts for Supporting Developing Countries¹⁹

In developing countries including Asian countries that are becoming more important for Japan as a growing market and a manufacturing base, not only the request for problems concerning intellectual property these countries have such as counterfeiting and pirated but also the establishment of infrastructure for intellectual property protection is important. The JPO makes gradual efforts for constructing an intra-office database and an information transmission environment such as IPDL, and establishing information infrastructures such as the construction of an electronic filing environment for the Southeast Asian nations that have a strong economical and cultural tie with Japan as “cooperation for informatization” in addition to human resource development cooperation and examination cooperation.

¹⁹ See Part 4, Chapter 4, 2. (3).